

July 31, 2012

The Honorable Lamar Smith
Chairman
Committee on the Judiciary
U.S. House of Representatives
2138 Rayburn House Office Building
Washington, D.C. 20515

The Honorable John Conyers, Jr.
Ranking Member
Committee on the Judiciary
U.S. House of Representatives
B-351 Rayburn House Office Building
Washington, D.C. 20515

RE: H.R. 6215, To amend the Trademark Act of 1946 to correct an error in the provisions relating to remedies for dilution

Dear Chairman Smith and Ranking Member Conyers:

I am writing on behalf of the American Intellectual Property Law Association (AIPLA) to express our support for H.R. 6215. This bill corrects a problem in the Lanham Act that may hinder the ability of trademark owners to enforce their rights against diluting marks.

AIPLA is a U.S.-based national bar association with approximately 14,000 members who are primarily lawyers in private and corporate practice, government service, and the academic community. AIPLA represents a diverse spectrum of individuals, companies, and institutions involved directly and indirectly in the practice of patent, trademark, copyright, unfair competition, and trade secret law, as well as other fields of law affecting intellectual property. Our members practice or are otherwise involved in trademark law and other areas of intellectual property law in the United States and in jurisdictions throughout the world.

During consideration of the Trademark Dilution Revision Act of 2006, the section providing a federal registration defense to a dilution action was reorganized, producing an unexpected and unintended change in the substance of the provision. As currently drafted, Section 43(c)(6) of the Lanham Act, 15 U.S.C. § 1125(c)(6), states that a federal trademark registration will bar an action against the owner of that registration (1) that is brought by another under common law or state law to prevent dilution by blurring or dilution by tarnishment; or (2) that asserts a claim of actual or likely damage or harm to the distinctiveness or reputation of a mark.

This drafting revision produced the inadvertent effect of making the federal registration defense available not only to state dilution claims, but also apparently to federal dilution claims as well under the second prong of Section 43(c)(6). The legislative history makes it clear that Congress never intended to allow a federal registration to bar a federal dilution action, but rather only dilution claims under state or common law. This is a error that requires a correction by Congress before Section 43(c)(6) is used to undermine the distinctiveness of famous marks.

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Page 2

H.R. 6215 provides an amendment to the Lanham Act that effectively fixes this error and would bring the language in line with the intent of Congress, clear up any uncertainty in the statute, and remove incentives for the registration of diluting trademarks to harm famous marks.

We support H.R. 6215 and thank you for your interest in ensuring protection for famous trademarks by correcting this error. We appreciate your efforts and stand willing to assist you in any way we can.

Sincerely,

A handwritten signature in black ink, reading "William G. Barber". The signature is written in a cursive style with a long, sweeping underline that extends to the right.

William G. Barber
President
American Intellectual Property Law Association