

## ***Trademark Dilution Revision Act of 2005.***

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DATE: April 19, 2005

Trademark Dilution Revision Act of 2005.

(Engrossed as Agreed to or Passed by House)

109th CONGRESS

1st Session

H. R. 683

AN ACT

To amend the Trademark Act of 1946 with respect to dilution by blurring or tarnishment.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,

### **SECTION 1. SHORT TITLE.** ➡

(a) Short Title- This Act may be cited as the `Trademark Dilution Revision Act of 2005'.

(b) References- Any reference in this Act to the Trademark Act of 1946 shall be a reference to the Act entitled `An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes', approved July 5, 1946 (15 U.S.C. 1051 et seq.).

### **SEC. 2. DILUTION BY BLURRING; DILUTION BY TARNISHMENT.** ➡

Section 43 of the Trademark Act of 1946 (15 U.S.C. 1125) is amended--

(1) by striking subsection (c) and inserting the following:

`(c) Dilution by Blurring; Dilution by Tarnishment-

`(1) INJUNCTIVE RELIEF- Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an

injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

`(2) DEFINITIONS- (A) For purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

`(i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.

`(ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.

`(iii) The extent of actual recognition of the mark.

`(B) For purposes of paragraph (1), `dilution by blurring' is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

`(i) The degree of similarity between the mark or trade name and the famous mark.

`(ii) The degree of inherent or acquired distinctiveness of the famous mark.

`(iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.

`(iv) The degree of recognition of the famous mark.

`(v) Whether the user of the mark or trade name intended to create an association with the famous mark.

`(vi) Any actual association between the mark or trade name and the famous mark.

`(C) For purposes of paragraph (1), `dilution by tarnishment' is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

`(3) EXCLUSIONS- The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

`(A) Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.

`(B) Fair use of a famous mark by another person, other than as a designation of source for the person's goods or services, including for purposes of identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

`(C) All forms of news reporting and news commentary.

`(4) ADDITIONAL REMEDIES- In an action brought under this subsection, the owner of the famous mark shall be entitled only to injunctive relief as set forth in section 34, except that, if--

`(A) the person against whom the injunction is sought did not use in commerce, prior to the date of the enactment of the Trademark Dilution Revision Act of 2005, the mark or trade name that is likely to cause dilution by blurring or dilution by tarnishment, and

`(B) in a claim arising under this subsection--

`(i) by reason of dilution by blurring, the person against whom the injunction is sought willfully intended to trade on the recognition of the famous mark, or

`(ii) by reason of dilution by tarnishment, the person against whom the injunction is sought willfully intended to harm the reputation of the famous mark,

the owner of the famous mark shall also be entitled to the remedies set forth in sections 35(a) and 36, subject to the discretion of the court and the principles of equity.

`(5) OWNERSHIP OF VALID REGISTRATION A COMPLETE BAR TO ACTION- The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register under this Act shall be a complete bar to an action against that person, with respect to that mark, that is brought by another person under the common law or a statute of a State and that seeks to prevent dilution by blurring or dilution by tarnishment, or that asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark, label, or form of advertisement.'; and

(2) in subsection (d)(1)(B)(i)(IX), by striking `(c)(1) of section 43' and inserting `(c)'.

### **SEC. 3. CONFORMING AMENDMENTS.** ➔

(a) Marks Registrable on the Principal Register- Section 2(f) of the Trademark Act of 1946 (15 U.S.C. 1052(f)) is amended--

(1) by striking the last two sentences; and

(2) by adding at the end the following: `A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 43(c), may be refused registration only pursuant to a proceeding brought under section 13. A registration for a mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 43(c), may be canceled pursuant to a proceeding brought under either section 14 or section 24.'.

(b) Opposition- Section 13(a) of the Trademark Act of 1946 (15 U.S.C. 1063(a)) is amended in the first sentence by striking `as a result of dilution' and inserting `the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment'.

(c) Cancellation- Section 14 of the Trademark Act of 1946 (15 U.S.C. 1064) is amended, in the matter preceding paragraph (1)--

(1) by striking ` , including as a result of dilution under section 43(c),'; and

(2) by inserting `(A) for which the constructive use date is after the date on which the petitioner's mark became famous and which would be likely to cause dilution by blurring or dilution by tarnishment under section 43(c), or (B) on grounds other than dilution by blurring or dilution by tarnishment' after `February 20, 1905'.

(d) Marks for the Supplemental Register- The second sentence of section 24 of the Trademark Act of 1946 (15 U.S.C. 1092) is amended to read as follows: `Whenever any person believes that such person is or will be damaged by the registration of a mark on the supplemental register--

`(1) for which the effective filing date is after the date on which such person's mark became famous and which would be likely to cause dilution by blurring or dilution by tarnishment under section 43(c), or

`(2) on grounds other than dilution by blurring or dilution by tarnishment,

such person may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Director to cancel such registration.'.

(e) Definitions- Section 45 of the Trademark Act of 1946 (15 U.S.C. 1127) is amended by striking the definition relating to `dilution'.

Passed the House of Representatives April 19, 2005.

Attest:

Clerk.