

Calendar No. 462

102D CONGRESS
1ST SESSION

S. 759

[Report No. 102-280]

To amend certain trademark laws to clarify that States, instrumentalities of States, and officers and employees of States acting in their official capacity, are subject to suit in Federal court by any person for infringement of trademarks, and that all the remedies can be obtained in such suit that can be obtained in a suit against a private entity.

IN THE SENATE OF THE UNITED STATES

MARCH 21 (legislative day, FEBRUARY 6), 1991

Mr. DECONCINI (for himself and Mr. HATCH) introduced the following bill; which was read twice and referred to the Committee on the Judiciary

MAY 12, (legislative day, MARCH 26), 1992

Reported by Mr. BIDEN, without amendment

A BILL

To amend certain trademark laws to clarify that States, instrumentalities of States, and officers and employees of States acting in their official capacity, are subject to suit in Federal court by any person for infringement of trademarks, and that all the remedies can be obtained in such suit that can be obtained in a suit against a private entity.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4 This Act may be cited as the “Trademark Remedy
5 Clarification Act”.

6 **SEC. 2. REFERENCE TO THE TRADEMARK ACT OF 1946.**

7 Except as otherwise expressly provided, whenever in
8 this Act an amendment is expressed in terms of an amend-
9 ment to a section or other provision, the reference shall
10 be considered to be made to a section or other provision
11 of the Act entitled “An Act to provide for the registration
12 and protection of trademarks used in commerce, to carry
13 out the provisions of certain international conventions,
14 and for other purposes”, approved July 5, 1946 (15
15 U.S.C. 1051 et seq.) (commonly referred to as the Trade-
16 mark Act of 1946).

17 **SEC. 3. LIABILITY OF STATES, INSTRUMENTALITIES OF**
18 **STATES, AND STATE OFFICIALS.**

19 (a) **LIABILITY AND REMEDIES.**—Section 32(1) of the
20 Act (15 U.S.C. 1114(1)) is amended by adding at the end
21 thereof the following:

22 “As used in this subsection, the term ‘any person’
23 includes any State, any instrumentality of a State, and
24 any officer or employee of a State or instrumentality of
25 a State acting in his or her official capacity. Any State,

1 and any such instrumentality, officer, or employee, shall
2 be subject to the provisions of this Act in the same manner
3 and to the same extent as any nongovernmental entity.”.

4 (b) LIABILITY OF STATES, INSTRUMENTALITIES OF
5 STATES, AND STATE OFFICIALS.—The Act is amended by
6 inserting after section 39 (15 U.S.C. 1121) the following
7 new section:

8 “SEC. 40. (a) Any State, instrumentality of a State
9 or any officer or employee of a State or instrumentality
10 of a State acting in his or her official capacity, shall not
11 be immune, under the eleventh amendment of the Con-
12 stitution of the United States or under any other doctrine
13 of sovereign immunity, from suit in Federal court by any
14 person, including any governmental or nongovernmental
15 entity for any violation under this Act.

16 “(b) In a suit described in subsection (a) for a vio-
17 lation described in that subsection, remedies (including
18 remedies both at law and in equity) are available for the
19 violation to the same extent as such remedies are available
20 for such a violation in a suit against any person other than
21 a State, instrumentality of a State, or officer or employee
22 of a State or instrumentality of a State acting in his or
23 her official capacity. Such remedies include injunctive re-
24 lief under section 34, actual damages, profits, costs and
25 attorney’s fees under section 35, destruction of infringing

1 articles under section 36, the remedies provided for under
2 sections 32, 37, 38, 42 and 43, and for any other remedies
3 provided under this Act.”.

4 (c) FALSE DESIGNATION OF ORIGIN AND FALSE DE-
5 SCRIPTIONS FORBIDDEN.—Section 43(a) of the Act (15
6 U.S.C. 1125(a)) is amended—

7 (1) by inserting “(1)” after “(a)”; and

8 (2) by adding at the end thereof:

9 “(2) As used in this subsection, the term ‘any person’
10 includes any State, instrumentality of a State or employee
11 of a State or instrumentality of a State acting in his or
12 her official capacity. Any State, and any such instrumen-
13 tality, officer, or employee, shall be subject to the provi-
14 sions of this Act in the same manner and to the same
15 extent as any nongovernmental entity.”.

16 (d) DEFINITION.—Section 45 of the Act (15 U.S.C.
17 1127) is amended by inserting after the fourth undesig-
18 nated paragraph the following:

19 “The term ‘person’ also includes any State, any in-
20 strumentality of a State, and any officer or employee of
21 a State or instrumentality of a State acting in his or her
22 official capacity. Any State, and any such instrumentality,
23 officer, or employee, shall be subject to the provisions of
24 this Act in the same manner and to the same extent as
25 any nongovernmental entity.”.

1 SEC. 4. EFFECTIVE DATE.

2 The amendments made by this Act shall take effect
3 with respect to violations that occur on or after the date
4 of the enactment of this Act.

Calendar No. 462

102^D CONGRESS
2^D SESSION

S. 759

[Report No. 102-280]

A BILL

To amend certain trademark laws to clarify that States, instrumentalities of States, and officers and employees of States acting in their official capacity, are subject to suit in Federal court by any person for infringement of trademarks, and that all the remedies can be obtained in such suit that can be obtained in a suit against a private entity.

MAY 12, (legislative day, MARCH 26), 1992

Reported without amendment