

102D CONGRESS
2D SESSION

S. 759

IN THE HOUSE OF REPRESENTATIVES

JUNE 15, 1992

Referred to the Committee on the Judiciary

AN ACT

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

1 be considered to be made to a section or other provision
2 of the Act entitled “An Act to provide for the registration
3 and protection of trademarks used in commerce, to carry
4 out the provisions of certain international conventions,
5 and for other purposes”, approved July 5, 1946 (15
6 U.S.C. 1051 et seq.) (commonly referred to as the Trade-
7 mark Act of 1946).

8 **SEC. 3. LIABILITY OF STATES, INSTRUMENTALITIES OF**
9 **STATES, AND STATE OFFICIALS.**

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

13 “As used in this subsection, the term ‘any person’
14 includes any State, any instrumentality of a State, and
15 any officer or employee of a State or instrumentality of
16 a State acting in his or her official capacity. Any State,
17 and any such instrumentality, officer, or employee, shall
18 be subject to the provisions of this Act in the same manner
19 and to the same extent as any nongovernmental entity.”.

20 (b) **LIABILITY OF STATES, INSTRUMENTALITIES OF**
21 **STATES, AND STATE OFFICIALS.**—The Act is amended by
22 inserting after section 39 (15 U.S.C. 1121) the following
23 new section:

24 “SEC. 40. (a) Any State, instrumentality of a State
25 or any officer or employee of a State or instrumentality

1 of a State acting in his or her official capacity, shall not
2 be immune, under the eleventh amendment of the Con-
3 stitution of the United States or under any other doctrine
4 of sovereign immunity, from suit in Federal court by any
5 person, including any governmental or nongovernmental
6 entity for any violation under this Act.

7 “(b) In a suit described in subsection (a) for a vio-
8 lation described in that subsection, remedies (including
9 remedies both at law and in equity) are available for the
10 violation to the same extent as such remedies are available
11 for such a violation in a suit against any person other than
12 a State, instrumentality of a State, or officer or employee
13 of a State or instrumentality of a State acting in his or
14 her official capacity. Such remedies include injunctive re-
15 lief under section 34, actual damages, profits, costs and
16 attorney’s fees under section 35, destruction of infringing
17 articles under section 36, the remedies provided for under
18 sections 32, 37, 38, 42 and 43, and for any other remedies
19 provided under this Act.”

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

23 (1) by redesignating paragraphs (1) and (2) as
24 subparagraphs (A) and (B), respectively;

25 (2) by inserting “(1)” after “(a)”; and

1 (3) by adding at the end thereof:

2 “(2) As used in this subsection, the term ‘any person’
3 includes any State, instrumentality of a State or employee
4 of a State or instrumentality of a State acting in his or
5 her official capacity. Any State, and any such instrumen-
6 tality, officer, or employee, shall be subject to the provi-
7 sions of this Act in the same manner and to the same
8 extent as any nongovernmental entity.”.

9 (d) DEFINITION.—Section 45 of the Act (15 U.S.C.
10 1127) is amended by inserting after the fourth undesig-
11 nated paragraph the following:

12 “The term ‘person’ also includes any State, any in-
13 strumentality of a State, and any officer or employee of
14 a State or instrumentality of a State acting in his or her
15 official capacity. Any State, and any such instrumentality,
16 officer, or employee, shall be subject to the provisions of
17 this Act in the same manner and to the same extent as
18 any nongovernmental entity.”.

19 **SEC. 4. EFFECTIVE DATE.**

20 The amendments made by this Act shall take effect
21 with respect to violations that occur on or after the date
22 of the enactment of this Act.

Passed the Senate June 12 (legislative day, March
26), 1992.

Attest:

WALTER J. STEWART,

Secretary.