

consider “all relevant factors” in addition to prescribed conditions set forth in the print, including the duration, extent, and geographic reach of advertising and publicity of the mark.

Fourth, H.R. 683 clarifies the definition of dilution by blurring, as well as by tarnishment.

Fifth, the bill enumerates specific defenses to a dilution action: comparative commercial advertising or promotion to identify competing goods; all forms of news reporting and news commentary; and traditional fair uses pertaining to parody, criticism, and commentary.

Sixth and finally, other than an action based on dilution by blurring, the owner of a famous mark is only entitled to injunctive relief under H.R. 683 if the defendant willfully intended to trade on the famous mark’s recognition; or in an action based on dilution by tarnishment, the defendant willfully intended to trade on the famous mark’s reputation.

In either case, the owner may seek damages, costs, and attorneys’ fees as well as the destruction of the infringing articles under separate Lanham Act provisions.

In sum, this bill will provide greater guidance for courts when they adjudicate dilution cases and businesses that use trademarks. It is a good complement to the dilution statute that received more than 2 years of subcommittee process.

Mr. Speaker, I urge Members to support this legislation.

Mr. Speaker, I reserve the balance of my time.

Mr. BERMAN. Mr. Speaker, I yield myself such time as I may consume.

I rise in support of House passage of H.R. 683. This bill makes important changes designed to protect famous trademark owners against the use of similar marks that might harm a company’s reputation or confuse consumers. It also manages to balance trademark law with first amendment concerns.

In 1995, the Federal Trademark Dilution Act was passed in order to “protect famous trademarks from subsequent uses that blur the distinctiveness of the mark or tarnish or disparage it.” The purpose of the act was to bring uniformity and consistency to the protection of famous marks, a goal that had been complicated by differing State dilution laws.

However, since 1995, a significant split had developed among the courts in the interpretation of key elements of the dilution act. The Supreme Court eventually took a step to resolve the controversy in its recent decision in *Moseley v. V Secret Catalogue, the Victoria’s Secret case*, where it interpreted the words “cause dilution” in the act to require a demonstration of actual dilution.

As a result of this decision, trademark holders are now required to wait until the injury happens before bringing suit. Victims of dilution have as-

serted that the injury caused by dilution constitutes the gradual diminution or whittling away at the value of the famous mark. They analogize the effects of dilution to 100 bee stings, where significant injury is caused by the cumulative effect, not just by one.

Section 2(c)(1) of this bill addresses this problem by changing the standard to “likelihood of dilution.” By lowering the standard, proof of actual harm would no longer be a prerequisite to injunctive relief, and therefore extensive damage cannot be done before relief can be sought. Furthermore, the bill includes a clear reference to dilution by tarnishment. This allows the trademark owner to protect his mark from associations which harm the reputation of the famous trademark. The bill narrows the reach of a dilution cause of action. It tightens the definition of fame by providing a specific list of factors, and eliminates the protection for marks that are famous only in niche markets.

While not universally supported, this bill has now garnered the support of the ACLU for accommodating its first amendment concerns. In section 2(c)(3), the bill addresses the balance between the rights of trademark holders and the first amendment by providing an exemption for purposes of identifying and parodying, criticizing or commenting on the famous mark. The trade groups representing intellectual property owners, AIPLA, INTA and IPO, have all endorsed this bill.

H.R. 683 achieves an important balance in the protection of intellectual property. I encourage my colleagues to support it.

Mr. Speaker, I reserve the balance of my time.

Mr. SENSENBRENNER. Mr. Speaker, I yield 4 minutes to the gentleman from Texas (Mr. SMITH).

Mr. SMITH of Texas. Mr. Speaker, I thank the chairman of the Committee on the Judiciary for yielding me this time.

Mr. Speaker, trademark law is relevant to the life of every consumer in America. Trademarks give customers assurance that the goods or services they are buying are what customers think they are. If a customer has purchased items in the past from a particular company that bears a specific mark or logo, the customer has an impression, favorable or not, of that company and the goods or services it produces. So trademark law empowers consumers by giving them information that is often critical to their purchasing decisions.

Dilution alters the public perception of a trademarked product or service by diminishing its uniqueness over time.

The idea of protecting famous trademarks from dilution surfaced in the 1920s. Since then, roughly half of the States have enacted dilution statutes while Congress passed the Federal Trademark Dilution Act nearly a decade ago.

As the gentleman from Wisconsin noted, the Federal dilution statute is

being amended for two main reasons. First, a 2003 Supreme Court decision involving *Victoria’s Secret* ruled that the standard of harm in dilution cases is actual harm. Based on testimony taken at our two Intellectual Property Subcommittee hearings, this is contrary to what Congress intended when it passed the dilution statute and is at odds with the concept of dilution. Diluting needs to be stopped at the outset because actual damage can only be proven over time, after which the good will of a mark cannot be restored.

Second, the regional circuits have split as to the meaning of what constitutes a famous mark, distinctiveness, blurring and tarnishment. The bill more distinctly defines these terms. This will clarify rights and eliminate unnecessary litigation, an outcome that especially benefits small businesses that cannot afford to have a misunderstanding of what is permissible under the Federal dilution statute.

Finally, amendments developed at the subcommittee level will more clearly protect traditional first amendment uses, such as parody and criticism. These amendments provide balance to the law by strengthening traditional fair-use defenses.

Mr. Speaker, in sum, H.R. 683 clarifies a muddled legal landscape and enables the Federal Trademark Dilution Act to operate as Congress intended.

Mr. BERMAN. Mr. Speaker, I yield back the balance of my time.

Mr. SENSENBRENNER. Mr. Speaker, I yield back the balance of my time.

The SPEAKER pro tempore (Mr. BISHOP of Utah). The question is on the motion offered by the gentleman from Wisconsin (Mr. SENSENBRENNER) that the House suspend the rules and pass the bill, H.R. 683, as amended.

The question was taken.

The SPEAKER pro tempore. In the opinion of the Chair, two-thirds of those present have voted in the affirmative.

Mr. SENSENBRENNER. Mr. Speaker, on that I demand the yeas and nays.

The yeas and nays were ordered.

The SPEAKER pro tempore. Pursuant to clause 8 of rule XX and the Chair’s prior announcement, further proceedings on this motion will be postponed.

#### PROVIDING FOR APPOINTMENT OF SHIRLEY ANN JACKSON TO BOARD OF REGENTS OF SMITHSONIAN INSTITUTION

Mr. NEY. Mr. Speaker, I move to suspend the rules and pass the joint resolution (H.J. Res. 19) providing for the appointment of Shirley Ann Jackson as a citizen regent of the Board of Regents of the Smithsonian Institution.

The Clerk read as follows:

H.J. RES. 19

*Resolved by the Senate and House of Representatives of the United States of America in Congress assembled, That in accordance with section 5581 of the Revised Statutes of the*

United States (20 U.S.C. 43), the vacancy on the Board of Regents of the Smithsonian Institution, in the class other than Members of Congress, occurring by reason of the expiration of the term of Hanna H. Gray of Illinois on April 13, 2005, is filled by the appointment of Shirley Ann Jackson of New York. The appointment is for a term of 6 years, beginning on the later of April 14, 2005, or the date of the enactment of this joint resolution.

The SPEAKER pro tempore. Pursuant to the rule, the gentleman from Ohio (Mr. NEY) and the gentleman from New York (Mr. McNULTY) each will control 20 minutes.

The Chair recognizes the gentleman from Ohio (Mr. NEY).

Mr. NEY. Mr. Speaker, I yield myself such time as I may consume.

Mr. Speaker, I rise today in support of House Joint Resolution 19. I am pleased to be here on the floor with my distinguished colleague from New York to talk about the appointment of Shirley Ann Jackson as a citizen regent of the Smithsonian Institution's Board of Regents.

The Smithsonian's governing board is comprised of 17 members. These members include the Chief Justice of the Supreme Court, the Vice President of the United States, six Members of Congress, and nine citizens who are nominated by the board and approved jointly in a resolution of Congress. The nine citizen members serve for a term of 6 years each and are eligible for reappointment to one additional term.

Shirley Ann Jackson will fill a vacancy on the board being created with the departure of Hanna Gray. Shirley Ann Jackson is the 18th president of Rensselaer Polytechnic Institute and the first African American woman to lead a national research university.

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Dr. Jackson has been a pioneer in many of her other endeavors as well. She is the first African American woman to receive a doctorate from MIT, the first African American to become a commissioner and chairman of the U.S. Nuclear Regulatory Commission, and the first African American woman elected to the National Academy of Engineering.

Her accomplishments in the field of physics and her leadership as the head of a national research university provide her with tremendous experience that will benefit the Smithsonian's board.

Dr. Jackson is currently President of the American Association for the Advancement of Science, and she was named one of seven 2004 Fellows of the Association for Women in Science.

In addition to her experience, Dr. Jackson has received the Golden Torch Award for Lifetime Achievement in Academia from the National Society of Black Engineers. She has been inducted into the National Women's Hall of Fame, and she has been recognized in such publications as *Discover* and *Industry Week* magazines and the *Esence* book, 50 of The Most Inspiring African Americans.

I could go on and on because I have merely scratched the surface of Dr. Jackson's numerous achievements, as well as the honors and awards she has received. But I will conclude by saying that it should be very clear that Dr. Shirley Ann Jackson would be a tremendous addition to the Smithsonian Institution's governing board. It will be an honor and pleasure to have her serve on that board, and I ask my colleagues to support House Joint Resolution 19.

Mr. Speaker, I reserve the balance of my time.

Mr. McNULTY. Mr. Speaker, I yield myself such time as I may consume.

Mr. Speaker, I consider it a great honor to come to the floor today to nominate my friend Shirley Ann Jackson for the position of member of the Board of Regents of the Smithsonian Institution.

As the chairman pointed out, Dr. Jackson is the 18th President of Rensselaer Polytechnic Institute, a leading national research university, which I am proud to say is located in my congressional district in the great city of Troy, New York, and I am also proud to say that Shirley Ann Jackson is a constituent.

Dr. Jackson is widely recognized for her intelligent, compassionate problem-solving abilities and her promotion of women and minorities in science. Dr. Jackson is currently the President of the American Association for the Advancement of Science and is a director of many major corporations, including FedEx and AT&T.

She is also a member of the New York Stock Exchange Board of Directors, the Council on Foreign Relations, the National Academy of Engineering, the National Advisory Council on Biomedical Imaging and Bioengineering at NIH, the U.S. Comptroller-General's Advisory Committee for the GAO, and the Executive Committee of the Council on Competitiveness.

She is also a Fellow at the American Academy of Arts & Sciences and is a trustee of Georgetown University, Rockefeller University, Emma Willard School, and the Brookings Institution.

As the chairman pointed out, she is the recipient of many awards and honors, including life membership on the MIT Board of Trustees.

A native of Washington, D.C., Dr. Jackson received both her B.S. in physics and her Ph.D. in theoretical elementary particle physics from MIT. Dr. Jackson also holds 32 honorary doctoral degrees.

Mr. Speaker, as the chairman pointed out, Dr. Jackson is uniquely qualified for this position, and I urge adoption of the joint resolution.

Mr. Speaker, I reserve the balance of my time.

Mr. NEY. Mr. Speaker, I yield back the balance of my time.

Mr. McNULTY. Mr. Speaker, I yield myself such time as I may consume.

I am delighted again to refer this resolution to my colleagues for their con-

sideration and support. Dr. Jackson is a great friend. She is a constituent. She is an outstanding American and a great humanitarian, and I urge adoption of the joint resolution.

Mr. Speaker, I yield back the balance of my time.

The SPEAKER pro tempore (Mr. BISHOP of Utah). The question is on the motion offered by the gentleman from Ohio (Mr. NEY) that the House suspend the rules and pass the joint resolution, H.J. Res. 19.

The question was taken.

The SPEAKER pro tempore. In the opinion of the Chair, two-thirds of those present have voted in the affirmative.

Mr. NEY. Mr. Speaker, on that I demand the yeas and nays.

The yeas and nays were ordered.

The SPEAKER pro tempore. Pursuant to clause 8 of rule XX and the Chair's prior announcement, further proceedings on this motion will be postponed.

#### GENERAL LEAVE

Mr. NEY. Mr. Speaker, I ask unanimous consent that all Members may have 5 legislative days within which to revise and extend their remarks and include extraneous material on the subject of the joint resolution, H.J. Res. 19.

The SPEAKER pro tempore. Is there objection to the request of the gentleman from Ohio?

There was no objection.

#### PROVIDING FOR APPOINTMENT OF ROBERT P. KOGOD TO BOARD OF REGENTS OF SMITHSONIAN INSTITUTION

Mr. NEY. Mr. Speaker, I move to suspend the rules and pass the joint resolution (H.J. Res. 20) providing for the appointment of Robert P. Kogod as a citizen regent of the Board of Regents of the Smithsonian Institution.

The Clerk read as follows:

H.J. RES. 20

*Resolved by the Senate and House of Representatives of the United States of America in Congress assembled.* That, in accordance with section 5581 of the Revised Statutes of the United States (20 U.S.C. 43), the vacancy on the Board of Regents of the Smithsonian Institution, in the class other than Members of Congress, occurring by reason of the expiration of the term of Wesley S. Williams, Jr. of the District of Columbia, on April 13, 2005, is filled by the appointment of Robert P. Kogod of the District of Columbia. The appointment is for a term of 6 years, beginning on the later of April 14, 2005, or the date of the enactment of this joint resolution.

The SPEAKER pro tempore. Pursuant to the rule, the gentleman from Ohio (Mr. NEY) and the gentleman from New York (Mr. McNULTY) each will control 20 minutes.

The Chair recognizes the gentleman from Ohio (Mr. NEY).

Mr. NEY. Mr. Speaker, I yield myself such time as I may consume.

Again, Mr. Speaker, it is a pleasure to be here with my friend and colleague