INTA—
125 Years
of
Excellence
A HISTORICAL PERSPECTIVE: THE INTERNATIONAL TRADEMARK ASSOCIATION AND THE UNITED STATES PATENT AND TRADEMARK OFFICE

By Anne H. Chasser

Since 1878, INTA’s members have labored tirelessly “to promote the right of owners of trade-marks, to secure useful legislation and treaties and to give aid and encouragement to all efforts for the advancement and observance of trade-mark rights.”1 As both past president of INTA and current Commissioner for Trademarks at the United States Patent and Trademark Office (USPTO), I am proud to commemorate the 125th anniversary of INTA.

The contributions made by INTA to trademark owners worldwide, particularly through interaction with the USPTO, are too well known to need repetition. However, there is a story that is not so well known, which serves to remind us just how much U.S. trademark law and administration have advanced in 125 years.

The story begins in a dark corner of the lower recesses of the Herbert Hoover Building, the “Main Commerce” building in downtown Washington, D.C. Quite by accident, one day several years ago, a USPTO employee discovered a dusty, folio-size ledger book in the basement of the Main Commerce building. The significance of the ledger was not immediately obvious, but the

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beautiful penmanship, heavy paper, and the date “July 1870” clearly indicated that this was an old and important document.

How the folio came to the basement will make a fascinating research project for the historian. Why it was not destroyed is a wonderful accident of history. What we do know is that, in the first year of the new millennium, the book was brought to the USPTO where astounded officials gazed upon the very first United States Trademark Register.

Reproduced here, for what is believed to be the first time, is Page 1 of the first federal trademark register in the United States, based on the Act of July 20, 1870.
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*September, 1870.*
Obviously, the 1870 Act met a long-felt need among trademark owners for within eight days, on July 28, 1870, the very first application was received. Attorney David A. Burr was the first one to the Office, on July 28, 1870, representing J.J. Turner & Co., who sought to protect “EXCELSIOR No. 1 Peruvian Guano” for use in connection with fertilizer. The Turner application was the only one received in July 1870, but business was booming. In August, fourteen more applications poured in to the Office, followed by twenty more in September. Some of these applications were for marks described simply as “elaborate” or “complex design.” Some were for products described simply as “dry goods” or “medicine.”

As an interesting historical note, although the J.J. Turner & Co. application was filed on July 28, 1870, it was not issued the very first trademark registration. That distinction belongs to the Averill Chemical Paint Company which, on August 30, 1870, filed an application for a design mark depicting an eagle with a ribbon together with the words “Economical, Beautiful” for liquid paint. U.S. Trademark Registration No. 1 was, according to the notation in the historic ledger, issued on October 25, 1870.

OUR SHARED PAST

Not surprisingly, on the first page of the ledger is the name Eberhard Faber, an attendee of INTA’s founding meeting in 1878,2 and father of INTA’s longest-serving President.3 While Mr. Faber’s application was among the first to be filed with the Office, Eberhard Faber had to wait until December 27, 1870, for issuance of registration number 117 for “A.W. Faber” for use in conjunction with lead pencils.4

That first meeting of INTA in 1878 came not a moment too soon. Only a few months later, the Trademark Law of 1870 was found by the United States Supreme Court to be unconstitutional, with the Court holding that it was not based upon commerce between the several states, or with foreign nations and Indian tribes.5 Instead, the Court found the 1870 Act to be based on an overly broad reading of Article 1, Section 8, Clause 8 of the Constitution, known variously as “the Patent Clause,” or “the Copyright Clause” depending upon one’s perspective and clientele.

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2. The first meeting of the INTA was held at 99 Nassau Street in New York City, November 21, 1878. Seventeen leading merchants and manufacturers were in attendance. Id.

3. The junior Eberhard Faber served INTA continuously for over five decades, including more than forty years as President of the organization (1904-1945). Id. at 5.

4. The application for the trademark A.W. FABER was filed August 9, 1870. It was the fifth trademark application received by the Patent Office. Faber was granted registration number 117 on December 27, 1870.

5. Daniels, supra n.1, at 3-4.
INTA’s first order of business became the facilitation of the passage of the Trademark Act of 1881.6

By the beginning of the 20th Century, it was apparent that yet another revision of the Trademark Act was needed. The Trademark Act of 1881 provided for registration of trademarks used in commerce with foreign nations and Indian tribes, but not in commerce amongst the several states.7 This limited the value of the 1881 Act. Requested by President William McKinley to provide recommendations for improvements to the 1881 Act, INTA was integral in the development of a new trademark law, which became the Trademark Act of 1905.8 At the helm as President of INTA when that Act was passed was the aforementioned (junior) Eberhard Faber.

Faber began his service to INTA in 1890, as a Director, and became President in 1904. Over a dedicated career that spanned more than fifty years, Faber oversaw INTA’s efforts in the development of the outstanding milestone in U.S. trademark law, the Lanham Act of 1946.9

While Fritz Lanham,10 Faber and INTA’s Assistant Secretary and Counsel, Walter Derenberg,11 left indelible marks upon the Lanham Act, the subsequent task of interpreting the provisions of the Act fell largely upon the Assistant Commissioner of the Patent Office, Mrs. Robert W. (Daphne) Leeds.12 It was Daphne Leeds whose “thoughtful and incisive opinions guided implementation of the Act through its birth and infancy.”13 The opinions of Assistant Commissioner Leeds marked a departure from the traditional, legalistic, “patent-oriented” view of trademarks, and recognized also the marketing and advertising functions of trademarks and service marks.14

6. Id.
7. Id. at 4-5.
8. Id.
11. Mr. Derenberg was Assistant Secretary and Counsel for INTA in the early 1940s, and worked extensively on the development of the Lanham Act.
12. Ms. Leeds was the first woman appointed Assistant Commissioner of the Patent Office, on August 11, 1953.
14. “In determining that the question of whether or not a given mark is merely descriptive, one is not required to go through mental gymnastics. Marks should not be denied registration simply because there are dictionary definitions of the words which, after remote and roundabout reasoning, might possibly be deemed to be descriptive of the involved goods or services. The statute provides for refusal only when the mark is merely descriptive as applied to the applicant’s goods or services.” Ex parte Colvin, Mendelhall & Co., 98 U.S.P.Q. 415, 416 (Comr. 1953) (emphasis added).
Assistant Commissioner Leeds' attitude towards trademarks as a vital economic force was apparent not only through her interpretation of the Lanham Act, but in her approach to trademark operations at the USPTO as well. Prior to her arrival, the prevailing attitude at the USPTO was that “what was good for the Patent Examining Operations must necessarily be equally good for the Trademark Operations.” When Ms. Leeds arrived at the USPTO, a long-standing practice was a first instance hearing by the Examiner of Interferences, with recourse of appeal to the Assistant Commissioner for hearing of oppositions, cancellations, interferences and ex parte application appeals. The volume of work generated under the Lanham Act was more than such a system could handle. Her response, perhaps the “most important result of her government tenure,” was the creation of the Trademark Trial and Appeal Board (TTAB).

Assistant Commissioner Leeds was very active in INTA before, during and after her tenure at USPTO. In the 1950s, she asserted to INTA that in order to stay vital and grow, INTA would need to service the trademark community by recognizing and encouraging the “role of trademarks in marketing, export and advertising.” History will bear out the fact that INTA has charted precisely this course, and it has served to enhance and strengthen its reputation worldwide.

WE SHAPED THE PRESENT TOGETHER

The marketing, export and advertising functions of trademarks were fully acknowledged by INTA and the USPTO with the development of the Trademark Law Revision Act of 1988 (TLRA). In tune with the concepts articulated by Assistant Commissioner Leeds, the TTAB was created by act of Congress on August 8, 1958.

“A trademark is a trademark only if it is used in trade. When it is used in trade it must have some impact upon the purchasing public, and it is that impact or impression which should be evaluated in determining whether or not the primary significance of a word when applied to a product is a surname significance. . . . It seems to me that the test to be applied in the administration of this provision in the Act is not the rarity of the name, nor whether it is applicant's name, nor whether it appears in one or more telephone directories, nor whether it is coupled with the baptismal name or initials. The test should be: What is its primary significance to the purchasing public.” Ex parte Rivera Watch Corp., 106 U.S.P.Q. 145, 149 (Comr. 1955).

17. Id.
19. The TTAB was created by act of Congress on August 8, 1958.
20. Fey, supra n.18, at 455.
21. Id.
22. Id.
Commissioner Leeds 30 years earlier, the TLRA showed careful consideration for modern marketing practices, while also bringing U.S. law into greater conformity with that of international trading partners.

The TLRA had its beginnings four years earlier when, in 1984, INTA realized that global pressures and changing economic realities demanded new trademark laws to fit the times. To examine the issue in more detail, in 1985 INTA chartered a special committee to bring its resources and expertise to bear on the problem in the hope of developing thoughtful and meaningful proposals. The special committee was called the Trademark Review Commission (TRC). The TRC was composed of prominent members of the trademark establishment: Dolores K. Hanna, Chairperson; John C. McDonald, Vice Chairperson; Jerome Gilson, Reporter; and Arthur J. Greenbaum, Associate Reporter. USPTO employees specially acknowledged by the TRC included Commissioner of Patents and Trademarks, Donald J. Quigg, Assistant Commissioner for External Affairs, Michael K. Kirk, and Assistant Commissioner for Trademarks, Margaret M. Laurence.

The TRC’s exhaustive review of the interplay between industries, nations and laws resulted in a comprehensive and brilliant roadmap to reform, called the “Report and Recommendations on the United States Trademark System and the Lanham Act.” The Report was published in The Trademark Reporter in August of 1987 and adopted shortly thereafter by INTA’s Board of Directors. The well-considered report served the dual purposes of demonstrating the overwhelming need for reform and providing a roadmap for legislative action, should lawmakers accept the challenge of trademark-law reform. Congress would eventually rely heavily upon the recommendations of the Commission when drafting the final version of the legislation. When all was said and done, more than half of INTA’s proposals were included in the TLRA.

The TLRA contained a number of significant reforms. The most significant of these was the provision for an application based on an intent-to-use the mark in commerce. The brilliance of the “intent-to-use” provision lay in the fact that it permitted applicants to provide commercial notice of their intention to use a mark, while still discouraging “hoarding” and other potential abuses. Another important change was the reduction of duration and renewal periods from twenty to ten years, in order to clean out the “deadwood” of abandoned or inactive marks. The concept of “constructive use” priority also was introduced. It provided that,

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23. For further discussion of the TRC, see Dolores K. Hanna, Personal Recollections: The Trademark Review Commission, infra at 42.

subject to a mark being registered, the filing of an application would constitute nationwide priority against all parties in most cases.

While INTA led the cause of reform, the USPTO turned concepts into reality. Under the leadership of Jeffrey M. Samuels, Assistant Commissioner for Trademarks from October 1987 to January 1993, and with the assistance of numerous dedicated career trademark employees, the provisions of the TLRA were implemented quickly and effectively. It is a tribute to the fundamental scholarship and vision of both the TRC and USPTO that intent-to-use applications now constitute the majority of applications filed with the Office.

It is clear that, without INTA’s leadership, innovation and persistence, there would have been no TLRA. INTA walked a long road with lawmakers and administration officials, but at the end of the journey its objectives were achieved. In working together to bring about passage of the TLRA, INTA and the USPTO again teamed to deliver quality service to meet the evolving needs of their shared constituency.

OUR BRIGHT FUTURE TOGETHER

Concurrently with the development of the TLRA came the development of another concept aimed at delivering the highest quality service to trademark right holders while addressing contemporary business concerns: automation of the Trademark Operations. This movement towards e-Government, initiated under the aegis of Commissioner Gerald Mossinghoff and Assistant Commissioner for Trademarks Margaret Laurence,25 advanced closer than ever to becoming a reality under the guidance of Commissioner Bruce Lehman and Under Secretary for Commerce and Director of the United States Patent and Trademark Office, Q. Todd Dickinson. In 2002 and beyond, our customers will see the USPTO progress quickly into the 21st century through the vision and commitment of Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, James E. Rogan.

Through our Trademark Electronic Application System (TEAS), applicants enter their own information, reducing the risk of error due to transcribing or data entry. Through the Trademark Electronic Search System (TESS), the USPTO’s entire database of trademarks can be searched from anywhere on Earth where there is Internet access. TEAS allows applicants or their attorneys to fill out a form and check it for completeness over the Internet.

25. See, The Thirty-Sixth Year of Administration of the Lanham Trademark Act of 1946, 73 TMR 577, 577 (1983) (“Other PTO activities included the submission to Congress of the PTO automation plan, which would fully automate Trademark Operations. . . .”).
TEAS, applicants or their representatives can submit the form directly to the USPTO over the Internet, making an official filing on-line. Using PrinTEAS, anyone can print out the completed form for mailing to the USPTO.

The success of the TEAS program has fostered the USPTO’s transformation into an effective e-Government agency. The efficiency and effectiveness of these electronic systems are being improved continually through the use of cutting edge technology.

The United States Patent and Trademark Office has and continues to solicit information and suggestions concerning upgrades to TEAS from the trademark community. This effort is and will be reflected in our implementation of improvements such as enabling the e-Signature/pen-and-ink signature options to all forms, providing a means for changing the applicant’s correspondence address, and extending the period for obtaining an e-signature from 72 hours to 2 weeks. Also, application forms for Certification marks, Collective Trademark/Service marks, Collective Membership marks and Supplemental Register registration will be introduced in the near future. Finally, all forms will soon be capable of accepting multiple images as attachments, in order to facilitate showing more than one specimen within the same class of goods or services.

On March 29, 2000, the American Inventors Protection Act, Title VI, Subtitle G—“The Patent and Trademark Office Efficiency Act,” established the USPTO as a performance-based organization. This legislation re-defined the position of Assistant Commissioner for Trademarks as not only the Commissioner for Trademarks, but also the Chief Operating Officer for Trademarks. The characterization of the head of the Trademark Office as a Chief Operating Officer represents an important departure from the traditional role of civil servant as steward and emphasizes the dynamic nature of government in the 21st century.

The USPTO is in the vanguard of e-government operation thanks to employees, past and present, who have defined their careers as guides to a better future. I find it significant that our current Deputy Commissioner for Trademark Operations, Robert “Bob” Anderson, crafted a “Concept of Operations” in 1994, which led directly to the first trademark application ever filed over the Internet, on November 30, 1997. Finally, on October 17, 2002, the Madrid Protocol accession documents were given advice and consent by the Senate and Madrid Protocol became a reality. (The United States Senate passed the legislation, HR 2155, on October 3, 2002.) INTA and the USPTO worked together on this important legislation that will provide one-stop-registration for trademark owners. The Madrid Protocol is a trademark filing treaty with 56 member countries. When the United States joins the treaty, a U.S. trademark owner will be able to file a single application with the
USPTO, in English, pay the appropriate fees in U.S. dollars, and potentially have its mark protected in any or all of the countries that are Protocol members. Lynne G. Beresford, the Deputy Commissioner for Trademark Examination Policy, who was part of the U.S. team that negotiated the regulations for the Madrid Protocol and also provided input on the legislation that implements the Protocol, HR 2155, will be charged with writing the regulations that govern Protocol filings at the USPTO. Following the clear directions of USPTO Director James E. Rogan, the USPTO is committed to full electronic implementation of the Protocol and full service for U.S. trademark owners and U.S. businesses. The implementing legislation provides that the Protocol will become effective in the United States on the later of one year from the date of enactment of the legislation or from when the instruments of accession are deposited.

Throughout its history, the USPTO has attracted to its ranks some of the leading contributors in the field of trademark law and administration. These employees have, without a doubt, contributed to the productive, synergistic relationship between the Office and INTA which continues to enhance the world of trademarks.

CONCLUSION

Hearken back to 1870, and the handwritten ledger of 36 marks filed in the first three months. Not only were the entries handwritten, but the marks were “described” in the ledger as well (one of which was actually deemed “too elaborate to describe”). What if you wanted to conduct a trademark search? The search might be easy—although try writing a clearance opinion over a mark “too elaborate to describe”—but getting to Washington to peruse the registry was difficult.

Now, consider the realities of today. In fiscal year 2002, the USPTO received over 258,873 trademark applications and issued 133,225 certificates of registration. At the end of fiscal year 2002, over 1,100,000 trademark registrations were active. Over 230,900 trademark applications have been filed via the Internet. So many marks now exist, that some practitioners consider it bad faith to file an application without first conducting a proper trademark search.

Who in the 1870s could have conceived that the trademark field would grow so exponentially? Even more imagination would have been required to predict the technological advances that will

26. Application number 31, on September 23, 1870, on behalf of Elkannah Myers for use in connection with “Candy.” Applicant received registration number 44 on November 1, 1870.
us to continue to provide the highest quality service to the trademark community, in an efficient and expedient manner.

Much has changed over the past 125 years. Yet much has stayed the same. I drafted this paper on a laptop computer, but I edited the draft with a FABER-CASTELL-brand lead pencil. In 125 years, INTA has grown from 12 companies to more than 4200 members. In 125 years, INTA has evolved from representing companies from New York to representing members from over 160 countries. The change in focus, from local to global, was formally recognized when INTA changed its name in 1993. In 125 years, INTA has expanded from representing manufacturers to representing everyone affected by trademarks: corporations, advertising agencies, professional and trade associations, and law firms practicing trademark law. What has not changed is INTA’s continuing commitment to the promotion of the rights of trademark owners. As a former president of INTA, I am grateful for the work that this fine organization has done on behalf of trademark owners in the 125 years since its founding.

What will the world of trademarks look like 125 years from now? I believe it will be a world in which Madrid Protocol filings are as common as national trademark filings. I believe it will be a world in which geographical indications and trademarks are treated as equal rights, consistent with INTA’s 1997 Board Resolution on “First in time, First in Right” priority. I believe it will be a world in which three-dimensional marks and sound marks are no longer considered “non-traditional” marks. I am confident that INTA will continue to be a formidable voice in shaping the direction of trademark law and practice. And, I am certain that the Commissioner for Trademarks in 2128 will be as thankful for the constructive participation of INTA as I am today.