

The Trademark Reporter®



The Law Journal of the International Trademark Association

Dedicated to Miles J. Alexander 1931–2025

In Memoriam: Miles J. Alexander (1931–2025)
Daniel Bereskin, C.M., K.C.

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Miles J. Alexander and Daniel R. Bereskin

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Reference Guide*. Gregory J. Battersby and Danny Simon.**
Kathleen E. Brennan

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The TMR (ISSN 0041-056X) is published electronically six times a year by INTA, 733 Third Avenue, 19th Floor, Suite 1950, New York, NY 10017 USA. INTA, the INTA logo, INTERNATIONAL TRADEMARK ASSOCIATION, THE TRADEMARK REPORTER, and inta.org are trademarks, service marks, and/or registered trademarks of the International Trademark Association in the United States and certain other jurisdictions.

The Trademark Reporter®

(USPS 636-080)

Vol. 115

July–August, 2025

No. 4

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The Trademark Reporter®

EDITOR'S NOTE

We dedicate this issue of *The Trademark Reporter* (TMR) to Miles J. Alexander (1931–2025). Miles served as Editor-in-Chief of the TMR from 1978 to 1980 and then stayed on as a member of its Advisory Board until his passing. In his honor, we are publishing an “In Memoriam” note by Daniel Bereskin—Miles’s longtime friend, colleague, and fellow TMR member—and reprinting the article “History of The Trademark Reporter®,”¹ which Miles and Dan co-wrote for the TMR issue celebrating INTA’s 125th anniversary in 2003.²

The trademark bar lost one of its icons and leaders when Miles passed away. I have been a trademark lawyer for twenty-five years, and Miles was always there, still taking the time to attend the TMR Committee Meeting at the Annual Meeting well past his time as Editor-in-Chief and always free with advice and ideas. I looked up to him as someone who had a lifelong passion for the practice of law, still actively engaged long after he could have retired. He showed the newly admitted, not-so-sure me that this is a profession and a field worth being passionate about. Only now, upon his passing, did I learn that his passion, caring, and activism also extended well beyond trademark law into civil rights and community action. I will continue to think of Miles’s example whenever I need to be reminded that one person can do a lot of good in this world.

Pamela Chestek
Editor-in-Chief

¹ 93 Trademark Rep. 52 (2003).

² Miles’s other contributions to the TMR include *Bona Fide Intent to Use in the United States and Canada*, 100 Trademark Rep. 709 (2010) (with Dan Bereskin and Nadine Jacobson), *Geographic Rights in Trademarks and Service Marks*, 68 Trademark Rep. 101 (1978) (with James H. Coil, III); and *The Impact of New State Unfair Trade Practices Acts on the Field of Unfair Competition*, 67 Trademark Rep. 625 (1977) (with James H. Coil, III).

IN MEMORIAM

Miles J. Alexander*By Daniel Bereskin, C.M., K.C.*

The Trademark Reporter (“TMR”) dedicates this issue to Miles J. Alexander (1931–2025), who served as the TMR’s Editor-in-Chief from 1978 to 1980, as a Member of INTA’s Board of Directors from 1980 to 1982, and as INTA Legal Counsel from 1997 to 2000.

Miles was a leading member of INTA’s Trademark Review Commission, whose work led to the enactment of the Trademark Law Revision Act of 1988. He received INTA’s President’s Award in 2002 for his numerous contributions to the Association. In addition to his articles in the TMR, Miles wrote extensively for many other scholarly journals. He served on INTA’s Panel of Neutrals (and on its successor, the Panel of Trademark Mediators), having been a staunch advocate of alternative dispute resolution.

Miles was a member of Phi Beta Kappa, a Life Member of The American Law Institute (“ALI”), and a member of ALI’s Advisory Committee on the *Restatement of the Law (Third) of Unfair Competition*. He was a Fellow of the American Bar Foundation, American College of Trial Lawyers, Chair of the Antitrust Section of the State Bar of Georgia, and Chairman of the Board of the Atlanta City Club. He also co-founded the Georgia Academy of Mediators and Arbitrators. He was inducted into the IAM IP Hall of

Fame in 2013 and received *World Trademark Review's* Lifetime Achievement Award in 2014. Miles undoubtedly was one of the world's leading trademark lawyers and was so recognized for decades.

Miles graduated from Emory University with honors in 1952, became a debate champion and the President of TEPHI (formally Tau Epsilon Phi), a fraternity initially formed by a group of Jewish men who were excluded from other fraternities due to their faith. He graduated *cum laude* in law from Harvard University in 1955 and served as a teaching fellow at Harvard from 1957 to 1958, one of his students being Justice Antonin Scalia. He joined Kilpatrick & Stockton, Atlanta, as an associate in 1958, later becoming a partner and, thereafter, Chairman of the firm, now called Kilpatrick Townsend Stockton LLP.

Miles was not only a brilliant lawyer, but he was also respected for his honest approach to resolving difficult and contentious legal issues. When a client indicated their intention to sue, he counselled them carefully, stressing both the strengths and weaknesses of their case, and how their adversary would likely react to litigation. In short, he encouraged clients to see their situation from the perspective of their adversary. It is therefore no wonder that he was highly successful in achieving sensible resolutions to complex legal conflicts, a quality that earned him well-deserved respect among all lawyers who were privileged to know him.

In addition to his exceptional legal career, Miles was dedicated to safeguarding the rights of persons suffering from discrimination. As early as 1949 when he was a sophomore at Emory, in a campus-wide debate tournament, he and his best friend Elliott Levitas argued and won the affirmative of the resolution: "Resolved that Emory University should admit Negroes to the Emory Graduate School." Levitas subsequently became a member of the United States House of Representatives for five consecutive terms. Miles's subsequent career was characterized by his profound commitment to social justice.

Miles and two of his Kilpatrick partners, Laurel Lucey and Michael Tyler, represented three Ethiopian women who had been tortured in Ethiopia by Kelbessa Negewo, an official of the regime then in power. The women emigrated to the United States and found that Negewo was living and working in Atlanta. They won their case against Negewo, who later was deported to Ethiopia and imprisoned there for life for these and other horrific crimes.

In the Jewish community, Miles served as the top lay leader of both the American Jewish Community and the Anti-Defamation League. He worked as a close advisor to his friend and Atlanta's first Black mayor, Maynard Jackson. The two referred to each other as "My brother." Miles also led the effort to integrate and bring women into Atlanta's Commerce Club and the Lawyers Club of Atlanta, as

well as his own law firm. He was inducted into the historic Gate City Bar Association Hall of Fame, one of only two White lawyers to have been so honored. He served as Chair of the Atlanta License Review Board and as a Member of the Atlanta Board of Ethics from 1980 to 1992.

As important as his partnership at Kilpatrick was to Miles, he valued his 70-year partnership with his beloved wife Elaine far more. Elaine herself has been a powerful force for social justice in Georgia and beyond. Together they, along with their entire family, exemplify the qualities that serve as an inspiration to all privileged to know them.



HISTORY OF THE TRADEMARK REPORTER®†

By *Miles J. Alexander** and
*Daniel R. Bereskin***



The Trademark Reporter® (TMR) traces its roots to November 1, 1887, with the first publication of “The Bulletin” of the United States Trade-Mark Association (USTA).¹ Priced at 10 cents, the first number comprised 22 pages, and reproduced the United Kingdom “Merchandise Marks Act, 1887,”² and “The International Convention for the Protection of Industrial Property.”³ The following “cable-gram” from London, England appeared in Volume 1, No. 2, page 32:

American manufacturers exporting goods to England would do well to study the Merchandise Marks Act which recently became a law here. The English Custom-house is showing great activity in stopping goods which bear the slightest

† Originally published in 2003 in Volume 93, Issue 1, of *The Trademark Reporter*. This article should be cited as Miles J. Alexander & Daniel R. Bereskin, *History of the Trademark Reporter*®, 93 Trademark Rep. 52 (2003).

* Chairman of Kilpatrick Stockton LLP, Atlanta, Georgia, Associate Member of the International Trademark Association, and senior partner in its IP practice. Mr. Alexander has served as Chair of the Publications Committee, Editor-in-Chief of the TMR, member of the Trademark Law Revision Committee and on INTA’s Board of Directors, as well as Counsel to INTA (1997-2000). In 2002, he received the INTA President’s Award for dedicated and distinguished service to INTA. Mr. Alexander was an Advisor to the ALI Restatement of the Law of Unfair Competition and currently Chairs the Trademark Public Advisory Committee to the USPTO. He is a member of the Advisory Board of the TMR as well as the INTA/CPR Panel of Neutrals.

** One of the co-founders of Bereskin & Parr, Toronto, Canada, Associate Member of the International Trademark Association. Mr. Bereskin was called to the Bar in Ontario in 1964, and has practiced exclusively in the intellectual property law field since that time. He was appointed Queen’s Counsel in 1982. Mr. Bereskin currently serves as Legal Counsel to INTA and has served on the Board of Directors of INTA as well as on the Board of Governors of the Brand Names Education Foundation. He is Editor-in-Chief of *Intellectual Property*, published by Federated Press, and is a member of the Editorial Board of the TMR’s International Annual Review and also serves on the INTA/CPR Panel of Neutrals for Canada. A frequent contributor to the TMR, Mr. Bereskin is the author of more than fifty articles on trademark topics.

¹ The name United States Trademark Association was changed to International Trademark Association in 1993. See William A. Finkelstein, *Reflections on the Birth of “INTA”* infra at 89.

² 50 & 51 Vict., Ch. 28.

³ The Paris Convention as cited in the article: “Convention for the protection of industrial property made at Paris, March 20, 1883, between Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia and Switzerland.”

appearance of being designed to imitate the goods of the English firms. At the ports of London, Hull, and elsewhere, enormous quantities of foreign goods have been seized recently under this act. Ostensibly the act is designed to prevent the fraudulent imitation of English trade-marks; but the authorities, urged by English manufacturers, carry it out in such a way as to hamper foreign manufacturers, and thus give virtually a limited [sic] amount of protection. As an instance of its injurious effect to foreigners, I may mention that an English firm ordered a large number of bottles made for them in Germany, the makers to stamp the name of their customers on each bottle. These bottles were seized at the Custom-house on the ground that the Germany manufacturers had no right to stamp the English name on the goods. The English firm thereupon ordered a supply from some English glass-works.

Plus ça change, plus c'est la meme chose . . .

The first volume of the Bulletin comprised individual numbers published irregularly over a span of fifteen years (1887-1902). This first series of the Bulletin is referred to as the "Old Series." Apparently, there was not then a sufficient stream of trademark information to justify regular publication. By 1904, no longer was there any dearth of steady material, and from then the Bulletin became a regular monthly publication. This continued until 1940, when publication was suddenly terminated, as discussed below. Issues of the Bulletin published from 1904 onwards are referred to as the "New Series."

The Bulletin was described⁴ as:

[A]n epitome of trade-mark legislation, judicial decisions and other matters of interest to trade-mark owners. It aims to cover the subject, not alone for the United States, but for foreign countries, and to furnish to subscribers all information requisite or desirable for the complete protection of their trade-marks in commerce. While it has proven its usefulness to lawyers and to students, it is edited with a view to the needs of the business man and seeks, therefore, to present only what is of practical importance and to present that clearly and concisely. It affects no jokes, runs no advertisements, and is never padded with lengthy statutes or verbose decisions.

The Bulletin is essentially of private circulation, being primarily intended as a medium for the distribution of information to the subscribers of the Association. Nevertheless, it has acquired a wide, if not an extensive

⁴ Volume 6, No. 1, page 13 (1910).

circulation, being cordially received and honorably regarded as an authority of trade-mark matters throughout the world. It has on its exchange list, the official trade-mark publications of Australia, Belgium, Brazil, Canada, Cuba, Great Britain, Hungary, Mexico, Netherlands, Norway, Portugal, Switzerland and the International Union for the Protection of Industrial Property. It has, within the last five years been widely quoted in the periodical publications both of this and of foreign countries, and its articles translated into the principle languages of Europe. It has been cited by foreign writers on industrial property as authority on the trade-mark law, not only of the United States, but of other countries. It has received most flattering commendation from trade-mark counsel in the United States, and—what is perhaps of chief importance—it has seemed to satisfy the wants of business men, by supplying them with needed information in a form that it does not require a legal training to understand. One of our readers has said of it, “It is the most ably edited of anything I have ever seen. The information and decisions that have been contained in these Bulletins have been of the greatest value to me, and I would not be without it for anything.”

In light of such complimentary language, it is perhaps surprising that in the early days, the names of the editorial staff were conspicuous by their absence. Finally in 1910, an issue of the Bulletin identified the editor as Arthur Wm. Barber, who at the time was Secretary of the USTA. In addition, associate editors were named, representing the Argentine republic; Austria; Belgium; Chili [sic]; Cuba; Denmark; Dominican Republic; Germany; Great Britain; Italy; Luxembourg; Netherlands; Orange River Colony (now part of the Republic of South Africa); Portugal; Salvador; Spain; Switzerland; Uruguay and Venezuela. The foreign associate editors were lawyers or professors residing in these various countries. It appears that it fell to the Secretary of USTA to fulfill the duties of Editor of the Bulletin.⁵

In addition to publishing information of a general nature of interest to trademark owners and practitioners, from the early 1900s the Bulletin began to publish learned articles on various subjects of trademark law. For example, Volume 7, No. 1 of the Bulletin (1911) contains an article entitled “Power of Congress under the Constitution to Legislate in Matters of Trade-Mark.” Surprisingly, the author is not identified; presumably it was the modest Arthur Wm. Barber. In the next issue, Volume 7, No. 2, the Bulletin commences with an article by M. Albert Capitaine entitled

⁵ Arthur Wm. Barber was succeeded as Editor in 1931 by Leon Ernest Daniels, who was also the Secretary of the Association.

"The Selection of a Trade-Mark." In Volume 7, No. 6, there appears an article called "The Psychology of Trade-Marks," which was a reprint of an address by Arthur Wm. Barber, given before the Proprietary Association of America at the Hotel Astor, New York City, May 25, 1911.

One is struck by the degree of space devoted to international trademark law, even from the earliest days. Volume 2 (1905 and 1906) contains articles with the following titles: "Pirating Trade-Marks in Cuba"; "Trade-Marks for the Chinese Trade"; "Registration at Home as a Condition of Foreign Protection"; "Registration of Initials in England"; "Unfair Competition in Switzerland"; "Trade-Mark Protection in South Africa"; "Trade-Mark Situation in Germany"; "Protection of Foreign Marks in France"; "The Marking of Labels in Mexico"; "Deceptive Trade-Marks in the Argentine"; "A Warning from Panama"; "Federal Trade-Mark Law in Australia"; "'Pink Pills' Trade-Mark in Cape Colony"; "Status of Trade-Mark in the Canal Zone"; "Chinese Trade-Mark Regulations"; "Penalty for Infringement in the Argentine"; "Uniformity in the Use of Trade-Marks for China"; "New British Trade-Mark Law"; "The Awakening of China"; "Treaty Regulations for the Protection of Trade-Marks in China"; "Trade-Mark in the Shape of a Bottle" (commenting on a Norwegian case); "Trade-Marks in Uruguay"; "Unfair Competition in Italy"; "The English Doctrine of 'Passing Off'" among others.

The title, *The Trade-Mark Reporter*, was used for the first time in June 1911 to identify a sister publication of the *Bulletin*. As its name implies, the early TMR was a law report restricted to trademark cases, and, like the *Bulletin*, was published monthly. Thus, for almost thirty years following the launch of the TMR, publication of the *Bulletin* and the TMR continued in parallel, the *Bulletin* containing learned articles and other information of interest to "business men" and practitioners, and the TMR devoted to case reports. Like the *Bulletin*, the TMR was published by the USTA.

Volume 1 of the TMR included a Convention relating to trademarks adopted by the "Fourth International Congress of American States" that met in Buenos Aires June 9 to August 13, 1910; an amendment made to United States trademark law; an amendment to California trademark law; and reports of various trademark cases, the first one of which was a decision of the Supreme Court of the United States, *Standard Paint Company v. Trinidad Asphalt Manufacturing Company*.⁶ In all, 97 cases were reported in full in this first volume, which comprised 348 pages of statute and case reports, plus 32 pages of index, digest and table of cases. Interestingly, although it is apparent that a great deal of

⁶ 165 O.G., 971, April 10, 1911.

effort was involved in the production of this first issue of the TMR, the names of the people who were associated with the project were not mentioned. Also, it is a little hard to imagine, but true, that 97 trademark cases were reported in full in a single volume. The cases reported in the 1911 edition of the TMR are a model of clarity and conciseness. One cannot escape the feeling that writers in those days were forced by circumstance to write concisely, clearly and with sharp focus on relevance, qualities that our great technological progress has done little to advance.

Thus, originally the TMR essentially was a law report, whereas the Bulletin contained learned articles, announcements and other information of interest to trademark owners and practitioners, rather like the TMR of today. This situation continued until 1940, by which time Leon Ernest Daniels had become the Editor, having succeeded Arthur Wm. Barber in 1931. Dr. Walter J. Derenberg, was named as Assistant Editor in 1935.

Readers of this journal who are accustomed to a mannered, orderly transition of editorial control of the TMR may be startled to learn that this was not always so. A calamitous event occurred in 1940, which unquestionably shaped the future development of the TMR. The USTA Board decided to suspend further publication of the Bulletin, and to recast the TMR as an amalgam of the Bulletin and what had up to then been the TMR. Moreover, the Board replaced the Editor, L.E. Daniels with Walter Derenberg (who at the time was Assistant Editor). Undoubtedly, Walter Derenberg had by then impressed the Board with his greatness as a scholar and lawyer. As a result of the shake-up, Walter Derenberg became the Editor-in-Chief, and L.E. Daniels was demoted to Managing Editor. At the time, Eberhard Faber was President of the USTA. In a foreword to Volume 31 of the TMR, Mr. Faber wrote:

A reappraisal of all the existing literature and periodicals in this field, as well as a recognition of an ever-increasing desire on the part of trade-mark owners generally to have available in one monthly periodical all the material, legal and economic, domestic and foreign, which was hitherto published in our two publications, have led the Board of Directors to the conclusion that a merger of the Bulletin and the Reporter into a single publication would fill a need for one comprehensive, authoritative periodical in this field. Where similar attempts have been made before, they were not limited to the field of trade-mark law and unfair competition.

The new Trade-Mark Reporter will devote all available space to current problems and court decisions relating to trade-mark protection and unfair trading. To this end readers will observe that the Reporter has been divided into two parts—the first part devoted to articles and editorial notes and

comments on current developments in the trade-mark field, here and abroad; the second part devoted to the textual publication of all important trade-mark decisions, judicial as well as administrative, in substantially the same form in which such material has been published for the past thirty years in the Reporter. Part II will be arranged in such a way that those desiring to do so may at the end of each year have the material removed and bound in separate volumes for the libraries, as in the past.

Mr. Daniels' disappointment in the decision of the USTA Board is evident from the following note appearing in the last edition of the Bulletin,⁷ under the heading "Special Notice To Our Subscribers":

We regret to announce that, pursuant to a recent decision of the Board of Directors of this Association, publication of the Bulletin will be temporarily suspended after the next issue. Any comment from our readers on this step or on the value of the Bulletin to them in the past would be welcome. —Editor.

Plainly, Mr. Daniels was engaged in wishful thinking, although the Bulletin eventually did reappear, albeit with a totally different format.⁸

The first issue⁹ of The Trade-Mark Reporter after the demise of the Bulletin contained, for the first time in the TMR, learned articles on the subject of trademark law, as well as case reports. The Editorial Board of the TMR in 1941 consisted of Eberhard Faber, Chairman; Arthur R. Wendell, Vice-Chairman; Walter J. Derenberg, Editor-in-Chief; Stephen P. Ladas, Associate Editor and Leon E. Daniels, Managing Editor. Contributing Editors were James L. Brown; Isaac W. Digges; John F.X. Finn; David E. Grant; Milton Handler; A.E. Johnston; Herbert Langner; Ellis W. Leavenworth; Sylvester J. Liddy; H.M. McLarin; Harry Meixell; Hugo Mock; Chesterfield S. Oppenheim; John C. Pemberton; Edward S. Rogers; Edmund Dill Scotty; Harry Shulman; Stewart L. Wittman and John Wolff.

The first issue of The Trade-Mark Reporter in the "modern" era (post-1940) contained an article by Stephen P. Ladas entitled "The Self-Executing Character of International Conventions on Industrial Property and Their Effects on Substantive Rights." Other articles published soon thereafter were "Trade-Marks—An Aid to Trade with Latin America" by James L. Brown, and "Drug Trade-Marks in Danger" by Walter J. Derenberg. The first volume of the new TMR comprised 656 pages, including Parts I and II, but not including the index and table of citations—a rather thick book. In

⁷ Volume 35, No. 11, page 372 (1940).

⁸ See Diane Donnelly, *Evolution/Revolution: A History of the Bulletin* infra at 65.

⁹ Volume 31, No. 1, January 1941.

1943, Stephen Ladas replaced Walter Derenberg as Editor-in-Chief; Leon A. Daniels remained Managing Editor. Walter Derenberg continued on the TMR Editorial Board, and was a frequent contributor to the TMR.

Henry B. King replaced Stephen P. Ladas as Editor in 1946, but like Walter Derenberg, Stephen Ladas continued his association with the TMR as a Contributing Editor, along with many other talented writers and scholars. In the immediate years following the coming into force of the Lanham Act in 1947, the Editorial Board of the TMR consisted of one, two or three members, with a Chairman, Editor and Associate Editor in 1947 and 1948 (Wm. G. Warner, Henry B. King and Walter J. Halliday, respectively). In 1949, Walter J. Halliday served as Editor and John J. Horn as Assistant Editor, followed by Walter J. Halliday serving alone as Editor in 1950, 1951 and 1952.

It was not until 1953, at the urging of Walter J. Derenberg, that Doris K. Meyerhoff was hired by the Association and designated as “Editor” (1953-1957) and as “Administrative Assistant” (1958-1959) in order to help relieve the publishing burdens placed on volunteer lawyers. From 1953 through 1959, she filled this role with an Editorial Board as small as five and as many as eleven in number.

Throughout the years, the contributing Editors of the TMR and its predecessor have been a Who’s Who list of trademark lawyers, including, among others, Edward S. Rogers, Frank Schechter, Stephen P. Ladas, Walter J. Derenberg, Milton Handler, Rudolph Callmann, Harry Shulman, Herbert Langner, Beverly W. Pattishall, Siegrid H. Pederson, George E. Middleton, Isaac Diggs, Alfred Lee, Julius Lunsford and Lenore B. Stoughton. In addition, there was a distinguished group of over twenty counsel and firms from around the world who between 1947 and 1952 were listed as “Foreign Collaborators.”

The one name that stands out as inextricably connected with the TMR every year from 1935 to 1975 is that of Walter Derenberg, who succeeded Walter Halliday as Chairman of the Editorial Board in 1953 and remained in that position until 1958, when he became the first Editor-in-Chief of The Trademark Reporter in the post-Lanham Act years. He remained Editor-in-Chief until he was succeeded by Arthur A. March in 1960¹⁰ and 1961, and Gilbert H. Weil and Sidney Diamond in 1962.

The current era of The Trademark Reporter is widely recognized as beginning with the arrival of a young woman, Charlotte Jones, who in 1962 became “Staff Assistant” and later “Managing Editor” of the TMR. She was destined over the next four decades to

¹⁰ In 1960, Volume 50 of The Trademark Reporter (which had then become a registered trademark and identified as such) continued to be divided: Part I, Articles and Reports, and Part II, the Case Notes Section, containing full case reports, as well as summarized case reports.

personify the quality, integrity, heart and soul of what has become widely recognized as the world's leading publication in the trademark field. Charlotte, of course, is the first to pay tribute to her mentors, Walter Derenberg, who tutored her on substantive trademark law, and Sidney Diamond, her first Editor, who was unsurpassed in his meticulous attention to accuracy and clarity in writing. From these giants in the trademark field, Charlotte became the quintessential example of the axiom that "the devil is in the details."

The group of icons who engaged in scholarly publication prior to 1962 remained active supporters and contributors of the TMR. However, a new generation of then young dedicated Editors-in-Chief and Editorial Board members were nurtured by Charlotte and by her mentors. This continuity of the old and new is best reflected by Walter Derenberg's annual review of cases and developments in trademark law commemorating each anniversary of the Lanham Act, commencing in 1948 at 38 TMR 628 with the publication of "The Annual Review of the First Year of Administration of the Lanham Act of 1946," and continuing until his death in 1975 with the 28th year of its publication in 65 TMR 373.

This Annual Report was conceived of and written for twenty-five years by Professor Walter J. Derenberg. After the "Twenty-Fifth Report," Professor Derenberg justifiably felt that the labor of love had become too arduous and he announced his intention to discontinue it. However, the Editorial Board of THE TRADEMARK REPORTER® was of the opinion that this work was too valuable to the profession to simply disappear and a Committee was formed to do the writing, have it preliminarily edited, and then submitted to the Professor for final editing as he saw fit. . . . We note here that these Reports will continue into the indefinite future as one of several living memorials to Professor Derenberg. . . .¹¹

From 1975 through 1980, the Annual Report continued as a Committee effort of dedicated volunteers. Arthur Greenbaum was one of those taking the lead as named Editor of the project in 1978 and 1979, with the help of young lawyers in his firm, including F. Carol Simkin and Baila H. Celedonia, and such luminaries as Mitchell A. Frank, Anthony Fletcher, Albert Robin, Alan Zelnick and Paul B. Morofsky, among others. The Annual Review during this period grew from 87 pages in 1975 to 173 pages in 1980.

In 1981, the Annual Review returned to a project in which one or two named volunteer authors undertook the enormous task that had been borne by Professor Derenberg during the first twenty-five years of its publication. Thus, this major issue of each volume of the TMR was edited by Kenneth B. Germain from 1981 through 1984,

¹¹ Introduction to the 28th Annual Report, 65 TMR 373-74 (1975).

with Stephen M. Weinberg as co-author in 1983 and 1984. In 1985, Anthony L. Fletcher became the co-author and established his own wit and style that characterized the Annual Review for the next fourteen years. In 1985, Tony Fletcher's co-author was Stephen Weinberg, in 1986 and 1987 Jane Shay Wall, and in 1988 and 1989 Robert Kunststadt. From 1990 through 1999, David Kera and Anthony Fletcher established a decade-long partnership that divided the Annual Review into separate sections covered by each, a practice that David Kera has continued with his current co-author, Theodore Davis, commencing with the January-February issue of *The Trademark Reporter*, 90 TMR 1, entitled "The Fifty-Second Year of Administration of the Lanham Trademark Act of 1946." There is little doubt that Walter Derenberg would glow with pride at the quality and comprehensiveness of the work of his successors in perpetuating his legacy.

During this period, the TMR has been true to its roots as an international publication with learned articles each year from trademark practitioners and academics around the world, reflecting both the diversity and similarity of international trademark issues. Thus, it was only fitting that in 1993 the First Annual International Review of Trademark Jurisprudence was published, with George Cooper as Chair and Lanning Bryer and Theodore Max as Editors of the Special TMR Task Force, which was charged with launching this impressive project. This initial effort in which 38 jurisdictions were reported rapidly grew to the extent that the IAR now contains reports from almost 100 countries around the world.

During the last four decades, as case reports have become more widely available, the TMR moved from reprinting and summarizing cases in the '60s to an emphasis on articles and landmark cases. Traditional features have been retained in areas such as book reviews, listing of articles from other publications and tabulation of cases involving likelihood of confusion of similar marks. Additional summaries of dilution cases have been added to this practice in the mid-90s. As the need for textual reporting became obsolete, the TMR also moved from twelve issues a year in the '60s to a bimonthly publication in the '70s, with special issues published from time to time. In addition to book reviews and listing of articles, both domestic and international, the TMR under various Editors published Tips from the TTAB, Notes from the PTO, Notes from Other Nations, reviews of trademark articles from other publications and special theme issues that sometimes encompassed the entire monthly issues of the TMR.

Thus, the current era of the TMR included a wide range of subjects involving the scope of the interests of the trademark bar, including such topics as: *The Exploitation, Assignment and Licensing of Trademarks in Selected Latin American Countries*, 50 TMR 503; *The Trademark Registration Treaty*, 63 TMR 421 (whole

issue); Proposed Intent to Use Legislation, 53 TMR 963; The Madrid Agreement and related issues, 56 TMR 289 and 60 TMR 129; The Historical Development of Trademarks, 65 TMR 265; The Use of Survey Evidence in Trademark Cases, 67 TMR 37; Building as Trademarks, 69 TMR 229; French Language Requirements in Quebec, 70 TMR 339; Disclaimer Practice, 71 TMR 215; Japanese Language Trademarks, 71 TMR 570; Trademark Counterfeiting, 73 TMR 536; The Trademark Law Revision Act of 1988 and the work of the prestigious Trademark Review Commission chaired by Dolores Hanna and led by Jerome Gilson as Reporter, 77 TMR 375 (whole issue), 78 TMR 71, and 79 TMR 219 (whole issue); World Trademark Symposium, 82 TMR 824 (whole issue); Fiftieth Anniversary of the Lanham Act, 86 TMR 353 (whole issue); A Comparison of NAFTA and TRIPS, 83 TMR 1; a myriad of articles debating the merits of dilution laws, both before and after the passage of the Federal Trademark Dilution Act, including 83 TMR 107, 86 TMR 485, and 87 TMR 490; and an issue devoted to the Internet, 87 TMR 525, among many others.

During this period, the TMR also has focused on special U.S. Supreme Court cases and published comprehensive discussions of the following cases: *Ives*, 72 TMR 1; *Park 'N Fly*, 75 TMR 1115; *Qualitex*, 84 TMR 379; *Wal-Mart*, 90 TMR 56; *TraFFix*, 91 TMR 622; and a variety of other innovative undertakings.

These articles are but a small sample of subjects comprehensively dealt with in the TMR. Indeed, anyone thumbing through back issues during the last half century will find a true treasure trove of penetrating analysis that often is as fresh and challenging today as when the articles were written. In picking up any volume of the TMR during the last half century, one cannot help but be in awe of the challenging ideas and scholarly research consistently found within its covers.

The era under Charlotte Jones' leadership of the TMR also established a continuing link between the present and the past by celebrating the lives and works of some of the great trademark lawyers who have left their indelible stamp on trademark law and the TMR. This has been accomplished through tributes and memorial issues of the TMR, which should some day be separately bound to introduce subsequent generations to the pillars of Trademark Scholarship. The Memorial issues contain the writing of and tributes to: Edward S. Rogers, 62 TMR 177; Walter J. Derenberg, 68 TMR 215; Daphne Robert Leeds, 72 TMR 437; Sidney A. Diamond, 73 TMR 219; and Milton Handler, 88 TMR 417. Additional memoriam tributes can be found honoring Fritz G. Lanham, 55 TMR 609 (see also 86 TMR 355, 50th Anniversary of the Lanham Act); Harold Fox, 60 TMR 483; James Hoge, 62 TMR 503; Christopher Robinson, 64 TMR 245; Stephen P. Ladas, 66 TMR

95; Rudolph Callmann, 66 TMR 96; Arthur A. March, 76 TMR 269; Paul B. Morofsky, 76 TMR 269; and Alvin Fross, 92 TMR 1013.

Issues have also been dedicated during this era to Charlotte Jones, 77 TMR 1; Gerald E. Murphy, 77 TMR 377; Saul Lefkowitz, 80 TMR 195; Robert B. Whittredge, 84 TMR 635; Mario Arrigucci, 86 TMR 809; Walter A. Hamburger, 87 TMR 920; and Anthony L. Fletcher, 89 TMR 1.

1975 was a particularly poignant year in the life of this publication, marking the end of an era when three great contributors to its success throughout the middle of the last century died within months of each other. In addition to having in common prolific writings of uniquely high quality in the trademark field and selfless contributions to *The Trademark Reporter*, Walter J. Derenberg (1903-1975), Stephen P. Ladas (1898-1976) and Rudolph Callmann (1892-1976) shared something else in common. They were all men who came to the United States after being educated in their native land, where, had they stayed, the rise of Nazi Germany could have deprived them and us of their great careers. They were welcomed with open arms by members of a collegial international trademark bar who became their colleagues and friends. Through their contributions they repaid to their profession many times over for the welcoming kindnesses provided to them. Through the TMR, their writings and force of personality, they provided us with the quintessential example of creative communication among scholars around the world. We have seen the torch passed from them and their generation to the men and women who they mentored and upon whom they left their indelible stamp that continues to this day.

By the late '70s, the Editorial Board of the TMR had been restructured along the lines of most prestigious law reviews, with a recognition that there was a need for different Editors to take primary responsibility for book reviews, published articles, original articles, international original articles, special issues, and a myriad of other assignments that involves the active participation of members of a large Editorial Board. Membership on this Board, which, with its Advisory Board of former Editors-in-Chief, now approaching one hundred in number, reflects the fact that it is one of the most sought after assignments within INTA. Each new member of the Editorial Board has the ability to become a future leader in the growth of the publication, as well as using it as a training ground for other leadership positions within INTA.

During the past forty years, one abiding principle and one common bond has governed each Editor-in-Chief and Editorial Board of the TMR. The abiding principle has been that this publication would always retain its intellectual integrity and welcome conflicting views on all subjects, without respect to the specific interests of any entity or individual, no matter how powerful or important. The common bond has been established by

experiencing a long constructive internship under the tutelage of Charlotte Jones and her protégés who have risen to positions of editorial leadership on *The Trademark Reporter*. All knew and appreciated that it was Charlotte who demanded the best out of each of them. To Editors, be they junior or senior to her in age, it was their forlorn hope that they could edit an issue of the TMR in a manner such that Charlotte's thoroughness and keen eye did not add a myriad of relevant citations and/or corrections. Whether converting the production process to new electronic printing, making the TMR available on the Internet, or initiating innovative new features in the TMR, each Editor-in-Chief's vision was developed under Charlotte with the freedom and the goal of continually improving the quality of the publication.

Each Editor-in-Chief¹² can look back on their two-year term and point to articles that made an enduring contribution to the trademark bar in countries throughout the world. All left their individual mark on the TMR, with concepts that were carefully filtered and tested by Charlotte's unwritten rule that constructive changes in the publication were always needed, but change for the sake of change could undermine the solid foundation upon which the publication had been built.

The special issue of *The Trademark Reporter* on November 9, 2001, dedicated to Charlotte finds no dearth of positive adjectives to describe her unique contributions and the seamless transition of leadership between Editors and Editorial Boards that has made and continues to make *The Trademark Reporter* the great publication that it is today. Charlotte was described in that issue as "the midwife for serious trademark scholarship for forty years." In that role, she had the foresight to help select for the TMR an outstanding successor, Managing Editor Randi Mustello, and a new generation of Editorial Board members led by the current Editor-in-Chief, Susan Reiss, who will provide the legacy for continued success in the 21st Century. The common bond that exists among those who have labored to make the TMR what it is today is perhaps well characterized in the Editor's Note of the issue dedicated to Charlotte Jones, where, to paraphrase Shakespeare:

¹² TMR Editors-in-Chief Who Served Under Charlotte Jones: Sidney A. Diamond, May 1962-May 1964; Hayes N. Johnson, June 1964-April 1966; Werner Janssen, Jr., May 1966-May 1968; Robert B. Whittredge, June 1968-April 1970; Arthur J. Greenbaum, May 1970-April 1972; Paul B. Morofsky, May 1972-April 1974; Allan Zelnick, May 1974-April 1976; Alvin Fross, May 1976-April 1978; Miles J. Alexander, May 1978-April 1980; William M. Borchard, May 1980-April 1982; Anthony L. Fletcher, May 1982-April 1984; John B. Pegram, May 1984-April 1986; Vincent N. Palladino, May 1986-April 1988; Jerre B. Swann, Sr., May 1988-April 1990; Allan S. Pilson, May 1990-April 1992; Robert L. Raskopf, May 1992-April 1994; Steven M. Weinberg, May 1994-April 1996; Pasquale A. Razzano, May 1996-April 1998; Howard J. Shire, May 1998-April 2000; Theodore C. Max, May 2000-December 2001.

We few, we happy few, we band of brothers and sisters; for he and she today that works to publish The Trademark Reporter shall be my colleagues and friends forever.

As this brief history demonstrates, the TMR has been blessed from its very beginnings, with a succession of highly able editors and writers, including many doyens of the trademark bar. That the TMR has always been able to attract people of such ability is a tribute to the vision of the INTA Board, in deciding, over 100 years ago, that only the highest standards of legal analysis and writing were good enough for the TMR. In short, the TMR is what it is today as the direct result of careful planning of people who lived generations ago, who were able to attract the best minds to shape the character and quality of The Trademark Reporter.

EDWARD S. ROGERS, THE LANHAM ACT,
AND THE COMMON LAW[†]

*By Jessica Litman*¹

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¹ I could not have written this chapter without the assistance of Shay Elbaum, Virginia Neisler, Keith Ketola, Ally Milam, and Keith Lacy, of the University of Michigan Law Library, who helped me to find unfindable documents and learn deeply buried facts. Jon Weinberg made enormously helpful comments on earlier versions of the chapter. I’m also grateful to Laura Harlow for her help, to Barton Beebe, Christine Farley, Tom McCarthy, and Sharon Sandeen for insightful feedback, and to Jason Dumont, who generously shared newspaper articles he had collected about Daphne Leeds.

Most people assume that a trade-mark is something which is intrinsically susceptible of ownership, that it exists as a separate and independent thing, and that it can be valued in money — that a trade-mark is a piece of wizardry which in some mysterious manner has created a great business. These notions are wholly erroneous. A trade-mark in and by itself is not the subject of legal property and has no value. A name, symbol or device as an abstract thing is not capable of ownership. A trade-mark is not a talisman which measures success. It is rather the result of success. If a trade-mark has value it is because it means something, because it indicates to the purchaser that certain goods have a certain commercial origin, and if the fact of their having this origin makes them desirable and more readily accepted by the public than goods having a different origin, then the trade-mark is of value exactly as the information it conveys is of value. It is a sign that the article to which it is applied is the one which the consumer by faith or experience believes to be good. It is a name, symbol or device which distinguishes the merchandise of one producer from that of others.

— Edward S. Rogers (1914)²

Edward Sidney Rogers presented his first draft of a distinctly American trademark statute at the American Bar Association meeting in August 1920 in St. Louis.³ Rogers's proposed statute was short. It would have required the owners of what 21st century lawyers would call trademarks or service marks⁴ to deposit copies of those marks, accompanied by information about their owners and use, in the Patent Office, and it would have prohibited trademark infringement suits on behalf of marks that had not yet been deposited. The draft bill said nothing about how one might come to own a mark, what would count as an invasion of the trademark owner's rights, or what the remedies for infringement might be.⁵ In Rogers's view, all of those matters were the domain of the common law and Congress was powerless to regulate them.⁶ What Congress could and should do was to set up a comprehensive registry of all marks and trade-names, and require all merchants to record them.

² E. S. Rogers, *Good Will, Trade-Marks And Unfair Trading* (Chicago 1914) 52–53.

³ E. S. Rogers, "Some Suggestions Concerning a Trade-Mark Registration Statute", Report of the 43d Annual Meeting of the American Bar Association (Baltimore 1920) 412, reprinted in (1921) 16 *Bulletin of the U.S. Trademark Association* 45.

⁴ The language in the draft was "all trade or identifying marks, names, labels or devices attached to or used in connection with any commodity or in the business of any person, firm corporation, or association, in commerce among the several states of the United States, with foreign nations, or with Indian tribes . . .". *Ibid.*, 421–422.

⁵ *Ibid.*, 421–422.

⁶ *Ibid.*, 419.

This effort, the first of what would be many drafts, all of them written by Rogers, eventually culminated in Congress's enactment of the Lanham Trademark Protection Act.⁷

During the intervening 26 years, the commercial and legal landscapes underwent enormous change. Local product markets coalesced into national markets and global markets. Courts' understanding of the scope of Congress's commerce power evolved significantly. Judges' conception of the nature of the common law transformed from one rooted in natural law to one derived, instead, from the power of state courts. Nonetheless, the goals of Rogers's successive draft bills stayed the same. Rogers's aims were twofold. First, he wanted the law to induce all businesses to register their marks. Second, and more importantly, he sought to preserve the extant common law of trademarks and unfair competition. The law that Congress ultimately enacted has been only somewhat successful at encouraging registration, but the common law doctrines of trademark and unfair competition have come through largely unscathed.

I.

A trade-mark then is not the result of a monopoly but quite the contrary. A trade-mark precludes the idea of monopoly. It is a means of distinguishing one product from another; it follows therefore that there must be others to distinguish from. If there are others there is no monopoly, and if there is a monopoly there is no need for any distinguishing. If all the watches in the world were produced by one company and could be produced only by it, there would be no advantage in placing the maker's name or mark upon them. There would be no advantage in distinguishing them from watches made by others. There would be no others.

— Edward S. Rogers (1914)⁸

Edward S. Rogers is not famous. As of this writing, he has no Wikipedia page. His alma mater, the University of Michigan (where he earned three law degrees and was a member of the adjunct faculty for 18 years), doesn't remember him.⁹ But Rogers litigated some of the most famous trademark cases decided in the first half of the 20th century. Rogers was the lawyer for Bayer Aspirin in *Bayer*

⁷ Pub. L. 79-489, 60 Stat. 427 (1946), codified as amended at 15 U.S.C. §§ 1051–1141n (2018).

⁸ Rogers, *Good Will*, 52.

⁹ In 2009, the University of Michigan Law School posted a “History and Traditions” project on its website. The primary focus of the project was the origin and donors of the law school buildings, but the site also contained profiles of faculty and alumni. Rogers was one of the alumni profiled. When the law school posted a spiffy new website in 2021, the alumni profiles were removed.

v. United Drug.¹⁰ He represented Kellogg's in the court of appeals in the *Shredded Wheat* case,¹¹ and Aunt Jemima Mills in the *Aunt Jemima* case.¹² Rogers represented Coca Cola in *Coca Cola v. Koke*,¹³ and in a slew of other trademark cases as the Coca Cola company sought to protect its word mark, its color, and its flavor against multiple competitors.¹⁴ He represented the Merriam Webster Dictionary Company in the company's efforts to preserve the Webster's Dictionary mark from genericide.¹⁵ He chaired the American Bar Association's section of Patent, Trade-Mark and Copyright Law, and served as a delegate for the United States to the Inter-American Trademark Conference.¹⁶ Rogers co-founded two law firms, Reed & Rogers in Chicago and Rogers, Ramsay & Hoge in New York City, and he practiced trademark law with both firms simultaneously.¹⁷ Rogers owned homes in Winnetka, Illinois,

¹⁰ *Bayer Co. v. United Drug*, 272 F. 505 (S.D.N.Y. 1921). Judge Learned Hand's opinion held that the ASPIRIN mark for acetyl salicylic acid was generic to the general consuming public, but still retained its trademark significance to pharmacists. Judge Hand entered an injunction constraining the use of the word on wholesale packaging but permitting it on retail packaging. 272 F. at 515–16.

¹¹ *Kellogg Company v. National Biscuit*, 91 F.2d 150 (3d Cir. 1937), *rev'd* 305 US 111 (1938). Nabisco sued Kellogg Company for making shredded wheat cereal and calling it Shredded Wheat. Justice Brandeis's Supreme Court opinion is famous for holding that the Shredded Wheat mark was generic and that the shape of the product had been dedicated to the public upon the expiration of Nabisco's patent. Rogers represented Kellogg unsuccessfully in the lower courts and filed the successful cert. petition but appears not to have been involved in the Supreme Court brief or oral argument.

¹² *Aunt Jemima Mills v. Rigney & Co.*, 247 F. 407 (2d Cir. 1917). Plaintiff produced Aunt Jemima brand flour. Defendant sold Aunt Jemima brand pancake syrup. Even though the products did not compete, the Court of Appeals for the Second Circuit held that Rogers's client was entitled to an injunction because consumers would conclude that the syrup was made by the flour company. Later courts referred to this principle as the "*Aunt Jemima doctrine*". See, e.g., *Triumph Hosiery Mills v. Triumph International*, 308 F.2d 196, 198 (2d Cir. 1962).

¹³ *Coca Cola v. Koke Co. of America*, 254 US 143 (1920). Koke argued, unsuccessfully, that the Coca Cola mark was fraudulent because the soda no longer contained cocaine. Justice Holmes's opinion for a unanimous Court held that the Coca Cola name may once have been descriptive, but that it had acquired secondary meaning and now signified the drink rather than its ingredients.

¹⁴ See, e.g., *Coca-Cola Co. v. Chero-Cola Co.*, 273 F. 755 (D.C. Cir. 1921); *Coca-Cola Co. v. Old Dominion Beverage Corp.*, 271 F. 600 (4th Cir. 1921); *Coca-Cola Co. v. Stevenson*, 276 F. 1010 (S.D. Ill. 1920); *Coca-Cola Co. v. Duberstein*, 249 F. 763 (S.D. Ohio 1918).

¹⁵ See, e.g., *G. & C. Merriam Co. v. Saalfeld*, 190 F. 927 (6th Cir. 1911); *G. & C. Merriam v. Ogilvie*, 170 F. 167 (1st Cir. 1909); see also *United Dictionary v. Merriam Company*, 208 U.S. 260 (1908) (copyright in dictionary not invalidated by failure to insert notice in foreign editions).

¹⁶ See C. H. Farley, "The Lost Unfair Competition Law" (2020) 110 Trademark Reporter 739, 758–771 (2020); "E.S. Rogers, Expert on Patent Law, 74", New York Times, 23 May 1949, p. 23.

¹⁷ The Chicago law firm Pattishall McAuliffe is the direct descendant of Reed & Rogers, the law firm Rogers co-founded at the turn of the 20th century, and it does include some Edward Rogers lore in its origin story. See Pattishall McAuliffe, Our History: The Early Years at <https://www.pattishall.com/firmhistory.aspx> (visited July 8, 2021).

Greenwich, Connecticut, and Castine, Maine, and he rented rooms from the New York City Drake Hotel.¹⁸ He belonged to the Sons of the Revolution and the Society of Colonial Wars.¹⁹ His 1918 draft registration card notes that he was tall, and had brown hair and eyes.²⁰ He apparently attended the Universalist Church,²¹ voted Republican,²² and enjoyed golf and boating.²³ Rogers's study of the history of trademarks led him to develop an interest in medieval heraldic devices.²⁴ Upon discovering that the University of Michigan had no coat of arms, Rogers commissioned artists to design one.²⁵ His friends called him Ned and everyone else seems to have called him "Mr. Rogers".²⁶ Trademark scholars know Edward Rogers as the individual who drafted the text of the Lanham Trademark Protection Act.²⁷

This chapter is a deep dive into the story of Rogers's authorship of the legislation that became the Lanham Act. Along the way we learn that because Rogers believed that Congress lacked the power to alter the substantive law of trademark and unfair competition, he crafted draft legislation that focused on registration and other procedural details rather than rights and defenses. Rogers represented both drug companies and food companies, and he therefore became familiar with the Pure Food and Drug Act of 1906. The Supreme Court had upheld the constitutionality of the Pure Food and Drug Act as within Congress's Commerce Clause power in 1911,²⁸ and had in 1916 blessed the government's prosecution under that statute of Rogers's client Coca Cola for adding caffeine to its syrup.²⁹ When Rogers sought to include a section in his bill that would augment merchants' abilities to combat deceptive marketing,

¹⁸ See W. T. Woodson, "A Profile of Edward S. Rogers" (1972) 62 Trademark Reporter 177, 187 (1972).

¹⁹ See "E.S. Rogers, Expert on Patent Law, 74", p. 23.

²⁰ See Edward Sidney Rogers Draft Registration card, serial number 503 (12 September 1918), available on MyHeritage.com at <https://www.myheritage.com/research/record-10513-18364549/edward-sidney-rogers-in-united-states-world-war-i-draft-registrations> (visited July 12, 2021).

²¹ See Chicago Tribune, 24 September 1901, p. 9 (wedding announcement).

²² See "Edward Sidney Rogers" in (1895) *University of Michigan Res Gestae: 1895 Senior Law Class* 37, 217.

²³ See Woodson, "A Profile", 177–178.

²⁴ See Rogers, *Good Will*, 45–47; E. S. Rogers, "Heraldic Devices and Trade-Marks" (1910) (November) 1(4) Trade-Mark News 12.

²⁵ See "A University Coat of Arms" (1931) 35 Michigansian 167.

²⁶ See Woodson, "A Profile", 188.

²⁷ See, e.g., Farley, "The Lost Unfair Competition Law" 755; W. J. Derenberg, "The Contributions of Edward S. Rogers to the Trademark Act of 1946 in Historical Perspective" (1972) 62 Trademark Reporter 189.

²⁸ See *Hipolite Egg Co. v. United States*, 220 U.S. 45, 57–58 (1911).

²⁹ See *United States v. Coca Cola*, 241 U.S. 265 (1916).

he drew the inspiration for the provision from the Pure Food and Drug Act.³⁰ We learn that both the supporters and the opponents of the bills that Rogers drafted expressed deep affection for the extant common law of trademarks and unfair competition. For most of the witnesses testifying before Congress, the key driver of the positions that they expressed on the bills was their sense of how the legislation would affect established common law doctrine. Finally, and most surprisingly to a 21st century audience, both the supporters and the opponents of the legislation appear to have assumed that the statute would supplement the common law rather than replace it. Except to the extent that the statute expressly abrogated common law doctrine, most members of the trademark bar believed that even after the statute's effective date, common law rules would continue to control most determinations.

II.

For many years I have followed the trail of the ordinary purchaser. In cases involving Pillsbury's Best and Washburn-Crosby's Gold Medal brands I have haunted grocery stores and watched him (or usually her) buy flour. I have stood by the hour in jewelry stores to see how people ask for and identify Big Ben clocks, in general stores in the South, and watched men buy Schnapps Plug or Lorillard's Good Smoke, in the North, Union Leader and Tuxedo cut plug, Pall Mall cigarettes and Manuel Garcia cigars. I have studied the buyers of dozens of other articles, Fairbank's scales, Quaker Oats, Baker's Cocoa, Ingersoll watches, Holeproof hosiery, Paine's Celery Compound, Coca-Cola, Cascarets and so on. It is an exceedingly interesting study as a matter of human nature and practical psychology, and a useful thing in examining and cross-examining trade witnesses and participating in cases concerning the products.

— Edward S. Rogers (1912)³¹

Rogers was born in Castine, Maine. As a child, he contracted and recovered from polio. His family moved to Michigan when his father, a coast guard captain, took command of a revenue cutter headquartered in Detroit.³² Rogers attended the Orchard Lake Military Academy, a high school run by his uncle in a Detroit

³⁰ See Section III below. Rogers included that provision in his early draft bills and almost every subsequent version. It became section 43(a) of the Lanham Act, 15 USC § 1125(a).

³¹ E. S. Rogers, "What Sort of Person is the Consumer?" (26 September, 1912) 80(13) *Printers Ink*, A Journal for Advertisers 3.

³² See J. F. Hoge, "Edward S. Rogers – A Memoriam" (1949) 39 *Trademark Reporter* 372, 372; "Capt. Rogers Passes Away", *Detroit Free Press*, 3 October 1901, p. 5.

suburb.³³ He graduated first in his class in 1893,³⁴ and enrolled in the University of Michigan Law School.

The Michigan law school L.L.B. in the early 1890s was still a two year undergraduate program.³⁵ Each year, the students attended lectures in ten core subjects.³⁶ Students were advised to select a seat in the lecture hall upon paying their tuition, and were expected to occupy that seat for the entire semester.³⁷ In 1895, the law school enriched its curriculum by hiring four non-resident lecturers to deliver lectures on specialized subjects.³⁸ Frank Fremont Reed, an 1880 graduate of the University (but not of the law school) and a member of the University's first football team,³⁹ became the law school's first lecturer on the subject of copyright law.⁴⁰ Reed was at the time a partner in the Chicago law firm of Aldrich, Reed, Foster & Allen, a general business litigation firm that had not yet developed a significant copyright or trademark practice. Although the majority of his practice involved commercial debts and contracts, Reed had represented theatrical producers sued for copyright infringement over an infringing production of the operetta *Erminie*,⁴¹ the owner of a plow patent in an infringement suit against an infringing plow coupling,⁴² and the Pillsbury flour company in an unfair competition suit against a flour purveyor named L.F. Pillsbury.⁴³ Rogers attended the lectures, and upon graduating later that year, went to work for Reed's law firm in Chicago.⁴⁴ With Rogers's assistance, Reed began to develop a trademark practice.⁴⁵

³³ See Woodson, "A Profile".

³⁴ "Cadets Graduate", 69(25) Ann Arbor Argus, 23 June 1893, p. 7.

³⁵ University of Michigan, Law Department 1893–94 Annual Announcement 9 (1893).

³⁶ Juniors attended lectures on Pleading and Practice, Personal Property, Fixtures and Easements, Equity Pleading and Procedure, Bailments, Contracts, Domestic Relations, Torts, Agency, and Partnerships. Ibid, 12. Seniors attended lectures on Jurisprudence, Evidence, Real Property, Equity Jurisprudence, Criminal Law, Criminal Procedure, Wills, Decedents' Estates, Corporations, and Constitutional Law. Ibid. The law school also offered optional classes on elocution and oratory. Ibid., 14. See generally E. Gaspar Brown, *Legal Education at Michigan 1859–1959* (Ann Arbor 1959) 98–109.

³⁷ Ibid. 1893 Law Department Annual Announcement, 11–12.

³⁸ University of Michigan, Law Department 1895–96 Annual Announcement 9 (1895).

³⁹ See 1879 Michigan Wolverines Football Team, Wikipedia, https://en.wikipedia.org/wiki/1879_Michigan_Wolverines_football_team (visited 4 May 2021).

⁴⁰ 1895 Law Department Annual Announcement, 8.

⁴¹ *Aronson v. Fleckenstein*, 28 F. 75 (C.C. N.D. Ill. 1886).

⁴² *O'Brien Bros Mfg. Co. v. Peoria Plow Co.*, 34 F. 786 (C.C. N. D. Ill. 1888).

⁴³ *Pillsbury v. Pillsbury-Washburn Co.*, 64 F. 841 (7th Cir. 1894).

⁴⁴ University of Michigan Law Department, Law Class Directory, Class of '95, University of Michigan (William C. Michaels, compiler) 19 (1897).

⁴⁵ *Stuart v. F.G. Stewart Co.*, 91 F. 243 (7th Cir. 1899); *Pillsbury-Washburn Flour Mills Co. v. Eagle*, 86 F. 608 (7th Cir. 1898); *Kathreiner's Malzkafee v. Pastor Kneipp Medicine Co.*,

After a few years, Frank Reed and Edward Rogers decided to leave the Aldrich firm and open their own law firm, specializing in trademark and copyright law.⁴⁶ Their early trademark clients included Sterling Remedy, maker of “Cascarets Candy Cathartic laxative tablets”,⁴⁷ Wells & Richardson, the producer of “Paine’s Celery Compound”,⁴⁸ Dr. Miles Medical Company, the maker of “Nervine Tonic”,⁴⁹ and the Hole-Proof hosiery company.⁵⁰ Over the next 27 years, they represented Coca Cola,⁵¹ Quaker Oats,⁵² Postum Cereal,⁵³ West Publishing,⁵⁴ Underwriters Laboratories, Standard Oil, and the McIlhenny Tabasco sauce company.⁵⁵

To drum up referral business, Reed and Rogers became active in local, state, and national bar associations; taught at the University of Michigan and the University of Chicago;⁵⁶ and published articles in bar journals, trade magazines, and law reviews.⁵⁷ Rogers authored articles on unfair trade law, trademark history, the psychology of trademark infringement, predatory price cutting, and international trademark agreements, as well as copyright, copyright subject matter, and copyright history.⁵⁸ He contributed

82 F. 321 (7th Cir. 1898); *American Cereal v. Eli Pettijohn Cereal Co.*, 76 F. 372 (7th Cir. 1896).

⁴⁶ Woodson, “A Profile”, at 177.

⁴⁷ *Sterling Remedy v. Gorey*, 110 F. 372 (C.C. N.D. Ohio 1901); Rogers, *Good Will*, 134, 178–182, 200.

⁴⁸ *Wells & Richardson Co. v. Abraham*, 146 F. 190 (E.D.N.Y. 1906); Rogers, *Good Will*, 134, 171, 177–178. Paine’s Celery Compound contained 21% alcohol by volume as well as cocaine. See W. H. Post and J. H. McGrath, III, “Patents and Potions: Precursors to Modern Drug Use and Abuse” (1972) 2 *Journal of Drug Issues* 50, 54.

⁴⁹ *Dr. Miles Medical Company v. John D. Park & Sons Co.*, 220 U.S. 373 (1911). Dr Miles Medical Company was the precursor of Miles Laboratories.

⁵⁰ *Holeproof Hosiery Co. v. Fitts*, 167 F. 378 (D. N.J. 1908).

⁵¹ See, e.g., *Coca-Cola Co. v. Old Dominion Beverage Corp.*, 271 F. 600 (4th Cir. 1921); Rogers, *Good Will*, 201.

⁵² See, e.g., *Kellogg Toasted Corn Flakes v. Quaker Oats*, 235 F. 657 (6th Cir. 1916).

⁵³ *Postum Cereal Co. v. California Fig Nut Co.*, 272 U.S. 693 (1927).

⁵⁴ *Hughes v. West Publishing*, 225 Ill. App. 58 (Ct. App. Ill. 1922).

⁵⁵ *Trappey v. McIlhenny*, 281 F. 23 (5th Cir. 1922); *Standard Oil Co. v. Independent Oil Men of America*, 58 App. D.C. 372 (D.C. App. 1929).

⁵⁶ University of Chicago, 7 *University Record* #2 (June 1902) at 41; University of Michigan Law Department 1906–07 Annual Announcement 6 (1906); Lawyers Club of Chicago, *Speakers and Papers Read Before the Club* (and its predecessor clubs), <https://lawyersclubchicago.org/events/past-speakers/speakers-archive/> (visited 9 May 2021).

⁵⁷ The firm ultimately attracted an “A” list of clients, and argued a number of cases to the Supreme Court. Reed and Rogers each sent their sons off to the University of Michigan Law school, and then invited them to join the firm. Frank Reed died in 1926. Rogers carried on as senior partner in the Chicago firm, now named Rogers & Woodson, and also opened up a second law firm in New York City, Rogers & Ramsay.

⁵⁸ See, e.g., E. S. Rogers, “The Law of Dramatic Copyright” (1902) 1 *Mich. L. Rev.* 102; E. S. Rogers, “Some Historical Matter Concerning Literary Property” (1908) 7 *Mich. L. Rev.*

regular columns to *Printers Ink*, a monthly periodical for the emerging advertising industry.⁵⁹ In 1914, he collected some of his previously published work and adapted it into a book, *Good Will, Trade-Marks and Unfair Trading*, pitched to a general lay audience.⁶⁰

As the century progressed, the firm's once-sketchy pharmaceutical clients became steadily more respectable. Both Coca-Cola and Wells & Richardson replaced the cocaine in their product formulations with less toxic stimulants.⁶¹ After a series of muckraking exposes of the patent medicine business,⁶² Congress enacted the Pure Food and Drug Act,⁶³ imposing modest truth-in-labelling requirements for the packages of non-prescription drugs.⁶⁴ In 1909, the Neuragyline Company (producer of Neuralgine pain medication) purchased Sterling Remedy (the Cascarets Candy Cathartic laxative company), but retained both the Sterling name⁶⁵ and its trademark counsel, Reed & Rogers. In 1917, the United States Government confiscated the patents, trademarks and U.S.

101; E. S. Rogers, "Comments on the Modern Law of Unfair Trade" (1910) 3 Illinois Law Review 551; E. S. Rogers, "Heraldic Devices and Trade Marks!" (1910) (August) 1 The Trade Mark News 12.

⁵⁹ See, e.g., E. S. Rogers, "How to Prove Your Trade Mark Rights" (15 August 1912) 80(7) Printers' Ink, 3; E. S. Rogers, "One Way to Stop the Foreign Good Will Pirate" (17 October 1912) 81 Printers' Ink, 36; E. S. Rogers, "The Legal Protection of Advertising Ideas" (31 October 1912) 81 Printers' Ink, 1912, p51.

⁶⁰ Rogers, *Good Will*.

⁶¹ Coca Cola replaced the cocaine with caffeine in 1903. See F. Allen, *Secret Formula* (New York 1994) 44–47; D. H. Boucher, "Cocaine and the Coca Plant" (1991) (February) 41(2) Bioscience 72, 74.

⁶² See, e.g., S. Hopkins Adams, "The Great American Fraud" Collier's, 7 October 1905, p. 14. See generally B. Denham, "Magazine Journalism in the Golden Age of Muckraking: Patent Medicine Exposures Before and After the Pure Food and Drug Act of 1906" (2020) 22 Journalism & Communication Monographs 100.

⁶³ Act of June 30, 1906, for Preventing the Manufacture, Sale, or Transportation of Adulterated or Misbranded or Poisonous or Deleterious Foods, Drugs, Medicines, and Liquors, and for Regulating Traffic Therein, and for Other Purposes, Pub. L. 59-384, 34 Stat. 768. See C.C. Regier, "The Struggle for Federal Food and Drugs Legislation" (1933) 1 Law and Contemporary Problems 3.

⁶⁴ Drugs were deemed misbranded if their labels failed to disclose that they contained "any alcohol, morphine, opium, cocaine, heroin, alpha or beta eucaine, chloroform, cannabis indica, chloral hydrate, or acetanilide," or if their package or label bore "any statement, design, or device regarding such article, or the ingredients or substances contained therein which shall be false or misleading in any particular. . .". Making, transporting or selling a misbranded drug in interstate or foreign commerce was a misdemeanor, and enforcement was delegated in the first instance to the Department of Agriculture's Bureau of Chemistry.

⁶⁵ Between 1902 and 1917 Neuralgyline purchased several small drug companies in addition to Sterling, acquiring a variety of laxatives, diuretics, and tonics. In 1917, the company adopted the name Sterling Products, Inc. See Sterling Drug, Inc., *The Sterling Story* (New York 1958) 7–8; M. A. Goldstein, "Sterling Remedy Co, On Beyond Holcombe: Companies Using Proprietary Battleship Revenues", at <https://onbeyondholcombe.wordpress.com/2018/02/22/sterling-remedy-co-iii-1/> (visited 29 July 2021).

facilities of the German Bayer corporation under the Trading with the Enemy Act.⁶⁶ Sterling purchased the assets of the company at auction from the Alien Property Custodian, and began to market Bayer Aspirin, Luminal (phenobarbital), and Novocaine.⁶⁷ The company continued its buying spree, acquiring the companies that made Philips Milk of Magnesia, Andrews Liver Salt, Fletcher Castoria, Haley's M-O, Energine Cleaning Fluid, Z.B.T. Baby Powder, and Dr. Lyon's Tooth Powder.⁶⁸ Dr Miles Medical Company (which made Nervine) eventually grew up to be Miles Laboratories, the company responsible for AlkaSeltzer and One-A-Day multiple vitamins.

Trademark law at the time that Reed and Rogers opened their law firm was entirely a product of the common law.⁶⁹ Most nations had adopted a registration-based trademark system,⁷⁰ but American trademark law was judge-made, and the judges had long held that trademark rights derived from attaching a trademark to tangible merchandise and selling that merchandise to the public.⁷¹ In 1870, Congress had sought to enact a substantive, federal, registration-based trademark statute in conjunction with its revision of the copyright and patent statutes.⁷² Nine years later, however, the Supreme Court had held that statute to be unconstitutional. The Court concluded that the trademark provisions exceeded Congress's enumerated powers.⁷³ Neither the copyright and patent power in clause 8, nor the interstate commerce power in clause 3, the Court explained, empowered Congress to regulate trademarks.⁷⁴

⁶⁶ Act of Oct. 6, 1917, Ch. 106, 40 Stat. 411.

⁶⁷ See Sterling, *The Sterling Story*, 8–11.

⁶⁸ *Ibid.*, 11–12.

⁶⁹ Trademark lawyers and courts viewed the law of trademarks and unfair competition as part of the “general common law” of the United States. See F. Forbes, P. Stenger Grosscup, and A. P. Greeley, *Report of the Commissioners Appointed to Revise the Statutes Relating to Patents, Trade and Other Marks, and Trade and Commercial Names Under Act of Congress Approved June 4, 1898*, S. Doc. No. 20, 56 Cong. 120–123 (1900).

⁷⁰ See, e.g., W. D. Shoemaker, “Foreign Registration of American Trademarks” (1921) 4 *Journal of the Patent Office Society* 140 (1921); see generally J. H. Ruege & W.B. Graham, *Trade Mark Laws of the World* (New York 1922).

⁷¹ *McLean v. Fleming*, 96 US 245, 254 (1877); *Derringer v. Plate*, 29 Cal. 293 (1865). See generally F. H. Upton, *A Treatise on the Law of Trade Marks with a Digest and Review of the English and American Authorities* (Albany 1860) 46–52.

⁷² An Act to Revise, Consolidate and Amend the Statutes Relating to Patents and Copyrights, §§ 77–84, 16 Stat. 198, 210 (July 8, 1870).

⁷³ Trade-Mark Cases, 100 U.S. 82, 94–95 (1879).

⁷⁴ Justice Miller's opinion explained:

The right to adopt and use a symbol or a device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons, has been long recognized by the common law and the chancery courts of England and of this country, and by the statutes of some of the States. It is a property right for the violation of which damages may be

That was an awkward result from the vantage point of the country's international relations.⁷⁵ Following the Civil War, the United States had signed bilateral trademark treaties with Austria-Hungary, Belgium, Brazil, France, Russia, and the United Kingdom, entitling citizens of signatory countries to protection for trademarks on condition of registration.⁷⁶ Under the treaties and in reliance on the 1870 statute, both domestic and foreign companies had registered their marks in the U.S. Patent Office. In response to the Supreme Court's decision, Congress enacted a series of trademark registration statutes based on its treaty and interstate commerce powers that permitted both domestic and foreign owners of trademarks to register the marks in the Patent Office, but conferred no substantive rights.⁷⁷ In subsequent cases well into the 20th century, the Supreme Court affirmed that Congress lacked the

recovered in an action at law, and the continued violation of it will be enjoined by a court of equity, with compensation for past infringement. This exclusive right was not created by the act of Congress, and does not now depend upon it for its enforcement. The whole system of trade-mark property and the civil remedies for its protection existed long anterior to that act, and have remained in full force since its passage.

These propositions are so well understood as to require neither the citation of authorities nor an elaborate argument to prove them.

Ibid., 94. The Court declined to resolve the question whether a trademark law would be constitutional if it had explicitly limited its application to interstate or foreign commerce, noting that even if the interstate and foreign commerce powers were construed liberally, "there still remains a very large amount of commerce, perhaps the largest, which, being trade or traffic between citizens of the same State, is beyond the control of Congress." *Ibid.*, 96. The Court continued:

When, therefore, Congress undertakes to enact a law, which can only be valid as a regulation of commerce, it is reasonable to expect to find on the face of the law, or from its essential nature, that it is a regulation of commerce with foreign nations, or among the several States, or with the Indian tribes. If not so limited, it is in excess of the power of Congress. If its main purpose be to establish a regulation applicable to all trade, to commerce at all points, especially if it be apparent that it is designed to govern the commerce wholly between citizens of the same State, it is obviously the exercise of a power not confided to Congress.

Ibid., 96–97.

⁷⁵ Forbes, Grosscup, & Greeley, *Report*, 103–104 (dissenting Report of Arthur P. Greeley).

⁷⁶ Z. Rosen, "Federal Trademark Law From Its Beginnings" (2019) 11 ABA *Landslide* 34. See Trademarks, US-Austro-Hungary, 25 November 1871, 17 Stat. 917; Trademarks, US-Belgium, 20 December 1868, 16 Stat. 765; Trademarks, US-Brazil, 24 September 1878, 21 Stat. 659; Trademarks, US-France, 16 April 1869, 16 Stat. 771; Trademarks, US-Russia, 27 January 1868, 16 Stat. 725; Trademarks, US-U.K., 24 October 1877, 20 Stat. 703.

⁷⁷ Act of March 3, 1881, ch. 138; Act of February 20, 1905, ch. 592, Pub. L. No. 58-84, 34 Stat. 724; see also Act of March 19, 1920, ch. 104, Pub. L. No. 66-163, 41 Stat. 533. See generally Forbes, Grosscup, & Greeley, *Report*, 41–54 (majority Report on Trade or Other Marks and Trade or Commercial Names); *ibid.*, 95–104 (dissenting Report of Arthur P. Greeley).

power to enact substantive trademark law.⁷⁸ The federal registration statutes, however, conferred jurisdiction over common law infringement actions and actions in equity involving federally registered trademarks on federal courts.⁷⁹

Rogers read the Supreme Court's opinions to hold that Congress lacked the power to enact substantive trademark law, and he appeared to believe that that was an appropriate rule.⁸⁰ Trademarks were, and should be, fundamentally creatures of the common law.⁸¹ Rogers argued that people who thought that trademarks were property, the way copyrights or patents were property, were making a conceptual mistake. Trademarks were not property; rather, products and businesses built up goodwill, and that goodwill was the property. Trademarks were simply symbols of the goodwill.⁸² If a competitor encroached on that goodwill in an effort to divert the business's trade, that was and should be actionable whether the encroachment involved copying a trademark or something else. The common law of unfair competition, Rogers insisted, protected merchants' goodwill from diversion of trade whether or not that goodwill was embodied in a trademark.⁸³

⁷⁸ See, e.g., *American Trading Co. v. H.E. Heacock*, 285 U.S. 247, 256 (1932); *American Steel Foundries v. Robertson*, 269 U.S. 372, 381(1926); *United Drugs v. Rectanus*, 248 U.S. 90, 98 (1918). Common law trademark rights arose from initial adoption and use of a mark, which was typically an intrastate event, and therefore beyond the scope of Congress's commerce power as it was then understood. Similarly, many infringement disputes arose within the borders of a single state.

⁷⁹ Act of February 20, 1905, ch. 592, Pub. L. No. 58-84 § 17, 33 Stat. 724, 728; Act of March 19, 1920, ch.104, Pub. L. No. 66-163 § 6, 41 Stat. 533, 535.

⁸⁰ E. S. Rogers, "Protection of Industrial Property" (1929) 27 Mich. L. Rev. 491.

⁸¹ See, e.g., E. S. Rogers, "The Expensive Futility of the U.S. Trademark Statute" (1914) 12 Mich. L. Rev. 660, 674-675.

⁸² Rogers, *Good Will*, 100. Later, Rogers's views on this question evolved. By 1938, he had come around to the view that trademarks were themselves property and trademark infringement should be understood as a trespass upon property. See Trade-Marks: Hearings on H.R. 9041 Before the Subcomm. on Trade-Marks of the House Comm. On Patents, 75th Cong. 53 (1938) (testimony of Edward S. Rogers). Rogers testified:

I think my own view is that a trade-mark is property, although the extent of the property, as Mr. Justice Holmes points out, and its infringement, can only be determined when you consider it as a trespass on that property. And I may say that this bill is prepared with the idea that a trade-mark is property and should be considered property.

⁸³ See, e.g., Rogers, *Good Will*, 127:

It seems to be assumed by many that there is some radical distinction between a case involving trade-mark infringement and one of unfair trading. . . . I believe the that the distinction is wholly unsound and that there is no real difference except in the matter of evidence between a case of unfair competition and a technical trademark; that all trade-mark cases are in fact cases of unfair competition and the law of trade-marks is a part only of the broader subject of unfair trade; that unfair trade is the genus; trade-mark infringement is a species.

The early 20th century common law of trademarks was not the sort of common law we're used to today, where the judges of 50 different states are free to devise 50 different solutions to the same problem. Because the trademark registration acts gave federal courts jurisdiction over disputes involving registered trademarks regardless of diversity of citizenship or the amount in controversy, most trademark and unfair competition disputes were filed in federal courts. Section 34 of the Judiciary Act of 1789 instructed federal courts to apply state law as the rules of decision in common law trials.⁸⁴ In 1842, the Supreme Court had held, in *Swift v. Tyson*,⁸⁵ that federal courts exercising diversity jurisdiction could apply general common law principles rather than relying on the local decisions of any court. For the next 96 years, until the Supreme Court decided that it had been wrong about that,⁸⁶ federal courts deciding trademark and unfair competition cases had developed a national general common law of trademark and unfair competition.⁸⁷ Lawyers described that body of law as both uniform across different courts and remarkably stable.⁸⁸

The common law trademark of the 19th and early 20th century would strike a 21st century trademark lawyer as unexpectedly narrow. The common law defined trademarks as arbitrary or fanciful terms or symbols that were physically affixed to tangible goods at the point of sale.⁸⁹ These were known as “technical trademarks”.⁹⁰ Other source-designating words, symbols, or designs

⁸⁴ Judiciary Act of 1789, ch. 20, § 34, 1 Stat. 73 (codified as amended at 28 U.S.C. s. 1652).

⁸⁵ 41 U.S. 1 (1842).

⁸⁶ In *Erie R.R. Co. v. Tompkins*, 304 U.S. 64 (1938), the Supreme Court repudiated *Swift v. Tyson*, insisting that federal courts must apply state law, as enacted by state legislatures and articulated by state courts, to common law questions, because there was no federal general common law. See 304 U.S. at 78. Seven months after releasing its decision in *Erie*, the Supreme Court decided *Kellogg v. National Biscuit*, 305 U.S. 111 (1938). Justice Brandeis's opinion noted that as a case in federal court because of diversity, it should be governed by state law, but then proceeded to apply general common law anyway. See 305 U.S. at 113 n.1.

⁸⁷ The common law that federal courts followed was not, strictly speaking, *federal* common law; the Supreme Court had made it clear that there was no federal common law of the United States. See, e.g., *Wheaton v. Peters*, 33 U.S. 591, 658 (1834). Rather federal courts deciding trademark cases followed the national, general common law of trademarks and unfair competition, which was independent of and untethered to the law of any state. See, generally, W. A. Fletcher, “General Common Law and Section 34 of the Judiciary Act of 1789: The Example of Marine Insurance” (1984) 97 Harv. L. Rev 1513, 1516–1538.

⁸⁸ See, e.g., 1938 House Hearings, 36–48 (testimony of Harrison F. Lyman, Boston Patent Law Association); see generally H. D. Nims, *The Law of Unfair Competition and Trade-Marks*, 2d ed. (New York 1917); A. C. Paul, *The Law of Trade-Marks Including Trade Names and Unfair Competition* (St. Paul 1903).

⁸⁹ See, e.g., *Gray v. Armand Co.*, 24 F.2d 878 (D.C. App. 1928); see, generally, M. McKenna, “Property and Equity in Trademark Law” (2019) 23 Marquette Intellectual Property Law Review 117, 119–123.

⁹⁰ See generally W. J. Derenberg, *Trade-Mark Protection and Unfair Trading* (Albany 1936), 220–324; M. Barrett, “Finding Trademark Use: The Historical Foundation for

were not technical trademarks, and were not entitled to be protected as trademarks. Descriptive or geographical terms that had acquired secondary meaning did not qualify as common law trademarks.⁹¹ Surnames were ineligible to be technical trademarks.⁹² Service marks and tradenames were not trademarks. Trade dress or packaging did not qualify as a trademark.⁹³ Advertisements that were not physically attached to tangible products were not trademarks.⁹⁴ Commercial copying of a technical trademark was actionable in a common law action for damages. Other commercial acts that diverted trade didn't count as common law trademark infringement. Those acts nonetheless could be and were routinely enjoined by courts sitting in equity.⁹⁵ Indeed, a majority of the reported cases litigated by Reed and Rogers sought injunctive relief for behavior that did not qualify as trademark infringement.⁹⁶

In *Holeproof Hosiery v. Fitts*,⁹⁷ for example, the firm's client sold HOLEPROOF hosiery in packages containing a guarantee that the stockings in the package would remain free of holes for six months. The defendant sold its competing hosiery under the mark NO HOLE, in a similar box with a very similar guarantee card. The court ruled that Holeproof had failed to show infringement of its trademark, but that the copying of the packaging and guarantee card was actionable as unfair competition. "If they had intended to carry on a bona fide business, they certainly would not in so many important respects have copied or closely imitated the complainant's name and methods". The court enjoined the defendant from using the phrase NO HOLE and from using a guarantee card "like or similar to that of the complainant".⁹⁸

In *Elgin National Watch Co. v. Loveland*,⁹⁹ the Elgin National Watch Company, located in Elgin, Illinois, claimed that it had since 1890 stamped the word ELGIN on the dials of its watches. The company sought to enjoin Loveland from doing business as the Elgin Jewelry Company or selling watches under the ELGIN name. The

Limiting Infringement Liability to Uses in the Manner of a Mark" (2008) 43 Wake Forest Law Review 893, 904–932.

⁹¹ See, e.g., *Canal Co. v. Clark*, 80 U.S. 311 (1871).

⁹² See, e.g., *Meneely v. Meneely*, 62 N.Y. 427 (1875).

⁹³ Barrett, "Finding Trademark Use", 903–911.

⁹⁴ *Ibid.*, 909.

⁹⁵ See, e.g., *McLean v. Fleming*, 96 U.S. 245, 254 (1877); see Nims, *The Law of Unfair Competition*, 26–30; E. S. Rogers, "Note and Comment: The Doctrine of Unfair Trade" (1908–09) 7 Mich. L. Rev. 409.

⁹⁶ See, e.g., *Sterling Remedy v. Gorey*, 110 F. 372 (C.C.N.D. Ohio 1901); Rogers, *Good Will*, 146–234.

⁹⁷ 167 F. 378 (C.C.D. NJ 1908).

⁹⁸ 167 F. at 379–380. See also *Holeproof Hosiery v. Wallach*, 192 F. 534 (2d Cir. 1911); *Holeproof Hosiery Co. v. Richmond Hosiery Mills*, 167 F. 381 (C.C.N.D. Ga. 1908).

⁹⁹ 132 F. 41 (C.C.N.D. Iowa 1904).

court agreed that because Elgin was the name of a geographic location, the watch company was not entitled to claim an exclusive right to use it. It concluded, however, that the name had acquired secondary meaning and that Loveland had adopted the Elgin name in order to exploit that secondary meaning and deceive potential customers. The court therefore enjoined Loveland from using the Elgin name in connection with the sale of watches.¹⁰⁰

As idiosyncratic as the common law doctrines may seem to 21st century eyes, contemporary trademark lawyers appear to have approved of them. The general common law of unfair competition and trademarks was consistent across different courts.¹⁰¹ The common law doctrine was flexible, plaintiff-friendly, predictable, and, once a lawyer learned its quirks, intuitive.¹⁰²

In the 1920s and 1930s, elite sectors of the legal profession debated the relative advantages and disadvantages of judge-made and statutory law. Those conversations accompanied fundamental shifts in American legal institutions.¹⁰³ In 1923, distinguished admirers of the general common law founded the American Law Institute, with the goal of protecting the general common law of the United States from modern conditions that might increase

¹⁰⁰ 132 F. at 52; *see, generally*, Rogers, *Good Will*, 146–157 (explaining actions for deceptive use of place names).

¹⁰¹ M. McKenna, “Trademark’s Faux Federalism” in S. Balganesch (ed.), *Intellectual Property and the Common Law* (Cambridge 2013) 288, 290–296. *See* 1928 Hearings, 15 (testimony of Edward S. Rogers); 1939 Hearings at 33 (testimony of Stewart L. Whitman, Nims & Verdi); Report of the Committee on Federal and State Trade-Mark Legislation, 1940 ABA Sec. Pat. Trademark & Copyright L. Comm. Rep. 44, 57 (1940) (Minority Report of Wallace H. Martin).

¹⁰² *See* E. S. Rogers, *Outline of Lectures on the Law of Trade Marks and Unfair Trading* (Ann Arbor 1939) 5 (available in HathiTrust Digital Library at <https://hdl.handle.net/2027/mdp.35112102486745>):

Since a trade mark is nothing but a symbol of business good will, the good will is the substantial thing which the law protects against invasion. The recent development of the law is in the direction of protecting business good will however it may be represented. Good will can be and is symbolized in other ways than by technical trade marks, by names which according to accepted definitions are not trade marks, by labels, by the dress or get up of goods, by the form of the goods themselves or the style of the enclosing package, in short, by the numberless ways in which a purchaser is enabled to recognize the particular article he wants. . . . The principle of law has been reduced to a single sentence— No one has any right to represent his goods as the goods of another. . .

Rogers told a story about a law student who, after attending Rogers’s lectures summed up the common law of unfair competition as “the efforts of courts to keep people from playing dirty tricks on each other”. Rogers commented, “really you might look through the books a long while and not find a better definition than that”. Trade-Marks: Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the House Comm. On Patents, 76th Cong. 166 (1939) (testimony of Edward S. Rogers).

¹⁰³ *See* W. J. Novak, *New Democracy: The Creation of the Modern American State* (Cambridge, MA 2022), 83–107, 113–124 (2022); E. A. Purcell, *Brandeis and the Progressive Constitution* (New Haven 2000), 11–114.

inconsistency and confusion and “force the abandonment of our common-law system of expressing and developing law through judicial application of existing rules to new fact combinations and the adoption in its place of rigid legislative codes”.¹⁰⁴ Meanwhile, influential legal scholars published law review articles that questioned the legitimacy of judicial lawmaking.¹⁰⁵

If these concerns penetrated the discussions surrounding trademark legislation, they don’t appear to have received much attention. Trademark lawyers reported few complaints with the substantive judge-made law of trademarks and unfair competition. The rules surrounding trademark registration, in contrast, were statutory, and attracted significant criticism.¹⁰⁶ Registration involved a lot of effort for a record that conferred no substantive rights.¹⁰⁷ Businesses seeking to export their products needed a federal registration certificate in order to secure trademark protection abroad.¹⁰⁸ For businesses interested only in domestic sales, there was little incentive to register their marks.¹⁰⁹

III.

“The present trade-mark act is, in my judgment, wrong in principle. As long as the common law prevails in this country the right to a trade-mark can depend only upon priority of adoption followed by open, notorious and continuous use. The important inquiry to be made when the adoption of a new mark is under consideration is, is the mark in use? Has some one else a prior right to it? There is no way at present of answering this question. There is no place where a search

¹⁰⁴ W.D. Lewis, “Introduction”, *Restatement of the Law of Torts* (St. Paul 1934), Vol. 1, vii–ix; A. L. Corbin, “The Restatement of the Common Law by the American Law Institute” (1929) 15 *Iowa Law Review* 19. The ALI included the common law of unfair competition and trademarks in its first Restatement of Torts. See *Restatement of Torts*, §§ 708–756.

¹⁰⁵ See, e.g., F. S. Cohen, “Transcendental Nonsense and the Functional Approach” (1935) 35 *Colum. L. Rev.* 809; A. M. Dobie, “Seven Implications of *Swift v. Tyson*” (1930) 16 *Vanderbilt Law Review* 225; J. Frank, “What Courts Do In Fact” (1931–32) 26 *Illinois Law Review* 645, 761.

¹⁰⁶ See, e.g., *Registration of Trademarks: Joint Hearings Before the Comms. On Patents*, 68th Cong. 137–142 (1925) [hereinafter *1925 Joint Hearings*] (testimony of Robert Watson, Washington DC); *ibid.* at 148 (testimony of Arthur Greeley, former member of the 1898 Congressional Commission to Revise the Patent and Trade-Mark Laws); C. P. Carter, “Trademark Interferences: A Proceeding Peculiar to this Country and of Doubtful Utility” (1923) 5 *Journal of the Patent Office Society* 320 (1923); H. C. Thomson, “The Trademark File of the US Patent Office; Its 2 Vital Defects and their Correction” (1921) 4 *Journal of the Patent Office Society* 74, 125.

¹⁰⁷ See, e.g., 1925 *Joint Hearings*, 78–80 (testimony of Otto Barnett, Chicago trademark lawyer).

¹⁰⁸ See, e.g., *Amendment of Trade-Mark Statutes: Hearing before the House Comm. on Patents*, 64th Cong. 17–21 (1916) (colloquy).

¹⁰⁹ See, e.g., Carter, “Trademark Interferences”, 320. Registration did give trade-mark owners the ability to sue in federal court. See Section II above.

can be made that will disclose even any substantial part of the trade-marks in use.”

— Edward S. Rogers (1914)¹¹⁰

In 1914, Rogers published an article in the *Michigan Law Review* that argued that the then-current trademark registration law, enacted in 1905, was worse than useless. Rogers called the 1905 Act “a slovenly piece of legislation, characterized by awkward phraseology, bad grammar and involved sentences. Its draftsmen had a talent for obscurity amounting to genius”.¹¹¹ He argued that the statute was based on the wrong principle. Since U.S. trademark rights arose under the common law from priority of use, the important thing was for there to be a way to figure out whether a mark was in use. Nothing in the 1905 Act enabled that to happen.¹¹² Instead, the statute set forth registration and examination procedures that were expensive and cumbersome, notwithstanding that registration gave trademark owners no enforceable legal rights.¹¹³ Rogers argued that Congress should repeal the 1905 trademark statute and replace it with a law that set up a trademark recording bureau in the Commerce Department whose only job was to record trademarks, without any examination. Everyone who used a trademark in interstate commerce should be required to file a record of that mark with the bureau, which should make the records available to people who wanted to search them.¹¹⁴ There was no need for the federal trademark statute to provide remedies for infringement, because the common law already supplied adequate relief.¹¹⁵ If more muscular protection were desired, Rogers suggested, Congress could extend the approach of the 1906 Pure Food and Drugs Act and make the use in commerce of infringing marks or labels a misdemeanor.¹¹⁶

¹¹⁰ Rogers, “Futility”, 674.

¹¹¹ *Ibid.*, 665.

¹¹² *Ibid.*, 672.

¹¹³ *Ibid.*, 672–674.

¹¹⁴ *Ibid.*, 675.

¹¹⁵ *Ibid.*, 676.

¹¹⁶ *Ibid.*, 675. The Food and Drug Act would have been familiar to Rogers because it constrained the labels of many of his clients. Rogers also cited the model of the British Merchandise Marks Act of 1887, 50 & 51 Vict. c. 28, which prohibited the use of forged trademarks, deceptive trademarks, and false trade descriptions:

[T]he Food and Drugs Act of June 30, 1906, could be extended to apply to merchandise generally along the lines of the English Merchandise Marks Act, and trade-mark infringement treated as misbranding—as in fact it is. The reasons which have made the marks and labels used in interstate and foreign commerce upon foods and drugs the subject of a Federal penal statute apply equally to the marks and labels used in such commerce, upon merchandise generally. Statutes along the lines suggested would furnish information as to trade-marks in use, which is the only matter of consequence, and would make infringement a misdemeanor as it ought to be. The only people to suffer

This article led to an invitation to give a speech to the American Bar Association section on Patent, Trademark and Copyright Law at its 1920 annual meeting, on the topic of what a modern trademark statute ought to look like.¹¹⁷ By then, the 1905 trademark registration Act had been amended and augmented by a 1920 supplemental registration statute designed to comply with treaty obligations and to facilitate foreign registration for American merchants.¹¹⁸ Rogers's 1920 speech was an only slightly revised version of his 1914 essay,¹¹⁹ but he also presented both the outline and the text of a new trademark registration statute that would satisfy the objectives he described. He argued the United States should throw out its current statutes and start with a clean slate. Congress should, Rogers urged, begin with the premise that substantive trademark law is and should be a matter of common law rather than statute.¹²⁰ The most important job a statute could do,

would be infringers, who now seek to profit by preying on the trade-marks of more successful traders, and lawyers of a certain type properly classed with trade-mark pirates, who now make a living by fostering the abuses made possible by our present trade-mark registration statute.

Ibid., 675.

¹¹⁷ See Rogers, "Suggestions".

¹¹⁸ Act of March 19, 1920, ch. 104, Pub. L. 66-163, 41 Stat. 533. The 1920 Act permitted the quick registration of marks that did not qualify as trademarks under U.S. law but would be protectible under the law of U.S. treaty partners, in order to facilitate export of American products. Like the 1905 Act, the 1920 Act didn't give registrants any substantive rights. The idea was to make it easier for American businesses to secure registration in foreign jurisdictions, which typically required a domestic certificate of registration, but which might have less exacting standards about what qualified as a trademark. The current supplemental register, *see* 15 USC § 23, is the direct descendant of the registry established by the 1920 Act. In addition, the Tariff Act, the 1916 Act chartering the Boy Scouts of America, and the 1905 Act establishing the Red Cross had their own trademark registration provisions. The early editions of the United States Code did not include the trademark statutes, so the various laws were not all in one place. Eventually the US Patent Office published a compilation of all extant trademark laws. *See 1938 House Hearings*, 23 (colloquy).

¹¹⁹ Despite the enactment of a new registration statute in the interim, the text of Rogers's speech to the ABA section in 1920 about what was wrong with current law was essentially the same as the text of the 1914 Michigan Law Review article. There are people who write new words for every paper, speech or brief and there are people who make efficient reuse of words they've already used elsewhere. Edward Rogers was definitely in the second category. In fact, this was a career-long habit. You can find language from Rogers's publications from the 1910s reappearing in his speeches and articles in the 1930s and 1940s. Compare, e.g., E. S. Rogers, "New Directions in the Law of Unfair Competition" (1940) 74 New York Law Review 317, 326 with E. S. Rogers, "The Unwary Purchaser" (1910) 8 Mich. L. Rev. 613, 615-616.

¹²⁰ See Rogers, "Suggestions", 420-421:

If a trade-mark act in a common-law country is to be of any value to the trade-mark owner or to the commercial community, all marks ought to be registered under it so that any person desiring to adopt a trade-mark can have somewhere where he can go and find out what marks are actually in use, and upon what goods. . . .

he suggested, would be to make it easy to figure out whether a given mark was in use and therefore subject to common law protection. Rogers's draft statute would have required anyone who used a trademark in commerce to deposit that mark in the Patent and Trademark Office. Failure to deposit would be punishable by a \$100 fine.¹²¹ Wallace Lane, the chair of the ABA section, invited Rogers to return the following year with a draft bill that could be considered by the section and potentially by the full American Bar Association.¹²²

The next year, Rogers brought a draft of a bill that would consolidate the extant trademark laws into a single statute and clean up some of what Rogers had argued were the worst of its ambiguities and contradictions.¹²³ Rogers's bill was more modest than the draft he had presented in connection with his speech. The bill did not require anyone to register or deposit anything. It retained the cumbersome examination and challenge procedures that he had criticized as pointless.¹²⁴ Most of its language was drawn directly from one of the trademark statutes then on the books. Rogers replaced a few of the phrases that he had attacked with the greatest scorn with wording that he believed to be more straightforward expression of the same principles.¹²⁵ Rogers's draft

A statute along the lines suggested would furnish information as to trademarks in use, which is the only matter of consequence, and would make infringement a misdemeanor, as it ought to be.

¹²¹ The deposit would include the name of the owner, identification of all goods on which the mark was used, the dates of use, and 20 specimens of the mark as actually used; failure to deposit would be punishable by a \$100 fine; and deposit would be a prerequisite to an infringement action. *Ibid.*, 422.

¹²² See "Preliminary Draft of a Trade-Mark Act" (1921) 16 *Bulletin of the U.S. Trade-Mark Association* 195, 195. The Editor of the *Bulletin of the U.S. Trade-Mark Association* explained that the *Bulletin* was reprinting Roger's full draft for the information of its readers. An Editor's note following the draft bill reported that after the *Bulletin's* version of the draft was printed, "a revised draft has been submitted which, however, follows in the main, the provisions of the one here given". *Ibid.*, 207.

¹²³ *Ibid.*, 195–207.

¹²⁴ Compare *ibid.*, § 10, at 200–01 with Act of February 20, 1905, ch. 592, Pub. L. No. 58-84, §§ 6, 7, 13, 34 Stat. 724, 726, 728.

¹²⁵ The 1905 Act prohibited the registration of any trademark that "so nearly resemble[s] a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers . . ." and defined infringement as the use of a counterfeit or colorable imitation of the mark "in connection with merchandise of substantially the same descriptive properties as those set forth in the registration". Act of February 20, 1905, ch. 592, Pub. L. No. 58-84 §§ 5(b), 16, 34 Stat. 724, 726, 728. In his 1914 essay and his 1920 speech, Rogers had singled out the phrase "same descriptive properties" for particular scorn:

When is merchandise of "substantially the same descriptive properties"? What are the descriptive properties of merchandise? The nearest synonym of properties is attributes or, loosely, qualities or characteristics. Then what are *descriptive* attributes, or qualities or characteristics? If an imitated mark, to infringe, must be used upon goods of substantially the same qualities or

would have made two notable substantive changes to extant law. First, the draft expanded the category of registrable trademarks to include previously unregistrable personal name and descriptive marks, so long as they had acquired secondary meaning.¹²⁶ This change would have allowed the registration of marks that were not technical trademarks, but were, nonetheless, commonly protected by federal courts in actions for unfair competition. Second, the draft inserted language creating a civil action for the willful use of any “false trade description”.¹²⁷ (This section was the precursor of the

characteristics, well and good, but why *descriptive* and why *descriptive properties* in one part of the act and *substantially the same descriptive properties* in another?

Possibly the whole thing was intended as a practical joke.

Rogers, “Suggestions” 416–417 (emphasis in original); “Futility”, 669 (emphasis in original).

Rogers’s 1921 draft deleted any reference to merchandise of the same descriptive properties. It would have prohibited registration of a mark that “so nearly resembles a registered or known trade-mark owned and in use by another as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers as to the source or origin of the goods in connection with which such mark is used” and defined infringement as “Any person who shall, without the consent of the owner thereof, counterfeit, copy or colorably imitate any trade-mark registered under this act, or make any infringing use thereof, shall be liable—” See Preliminary Draft, §§ 2(f), 15, at 197, 202.

¹²⁶ Section 5(b) of the 1905 Act had barred the registration of a mark consisting of “the name of an individual, firm, corporation, or association” except insofar as it was written in a distinctive logo, as well as “words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term.” Rogers’s tentative draft deleted those bars, and added a provision permitting the registration of trademarks that had come to identify the source of the registrant’s goods: “Except as above expressly excluded, nothing herein shall prevent the registration of any mark used by the applicant in commerce with foreign nations, or among the several states, or with the Indian tribes, which in fact identifies his goods.” See Preliminary Draft, §§ 2(f), 197.

¹²⁷ Preliminary Draft, § 27, 205–206:

That any person who shall willfully and with intent to deceive, affix, apply, or annex, or use in connection with any article or articles of merchandise, or any container or containers of the same, a false designation of origin, or any false trade description, including words or other symbols, tending falsely to identify the origin or trade description of the merchandise, and shall then cause such merchandise to enter into interstate or foreign commerce, and any person who shall knowingly cause or procure the same to be transported in interstate or foreign commerce or commerce with Indian tribes, or shall knowingly deliver the same to any carrier to be so transported, shall be liable to an action at law for damages and to a suit in equity for an injunction, at the suit of any person, firm or corporation doing business in the locality falsely indicated as that of origin, or in the region in which said locality is situated, or who is or is likely to be damaged in his trade or business by any false trade description, or at the suit of any association of such persons, firms, or corporations, and any article marked or labeled in contravention of the provisions of this section shall not be imported into the United States, or admitted to entry at any custom house of the United States.

language enacted many years later as section 43(a) of the Lanham Act.) This was a significant departure from extant common law authority: federal courts had so far declined to allow recovery for a competitor's materially misdescribing its goods.¹²⁸

Rogers presented his draft to the Section of Patent, Trade-Mark and Copyright Law at the annual meeting in Cincinnati, and the section voted to appoint a seven-man¹²⁹ committee, chaired by Rogers, to refine the draft and report back the following year.¹³⁰ Most of the changes made in committee were word-smithing—the committee replaced some of the language in the draft bill for clarity and substituted other language in order to incorporate more familiar words and phrases used by courts.¹³¹ The committee draft further broadened the scope of marks subject to registration to include both trademarks that were not physically affixed to goods and “names or devices used by any person, firm, corporation, union, agricultural or other association, club, fraternal society, institution or organization in commerce.”¹³² The committee draft also introduced a new procedure for depositing unregistered marks in the Patent Office, based on Rogers's original proposal.¹³³ In contrast

Rogers borrowed the “false trade description” language from the British Merchandise Marks Act 1887.

¹²⁸ See, e.g., *American Washboard Co. v. Saginaw Mfg. Co.*, 103 F. 281 (6th Cir. 1900). See also *Mosler Safe v. Ely Norris Safe Co.*, 273 U.S. 132 (1927).

¹²⁹ The Section of Patent, Trade-Mark and Copyright Law had no woman members until Daphne Robert joined the section in 1939.

¹³⁰ See Report of the 44th Annual Meeting of the American Bar Association (1921) 582.

¹³¹ See E. S. Rogers, “The Vestal Trade-Mark Bill – Evolution of the “Secondary Meaning” Clause” (1932) 27 Bulletin of the U.S. Trade-Mark Association 307, 307–308.

¹³² American Bar Association Section of Patent, Trade-Mark and Copyright Law, Report of the Committee on Revision of Trade-Mark Act 17–18, 33–34 (1922?). (The printed report is undated. See <https://find.library.duke.edu/catalog/DUKE002807596>.) The committee report explained:

Section 24 is new. It aims to permit the registration of trade names and devices used in commerce which are not trade-marks in the technical sense that they are not physically attached to merchandise. Under the present act nothing can be registered as a trade-mark unless it is affixed to goods. This excludes marks indicative of services rather than merchandise, such as union labels, marks used by cooperative marketing groups, agricultural societies and the like, community marks, railroad names, marks used by transportation companies in general, hotels, laundries, colleges, societies, and clubs. We have endeavored in this section to place such marks as these on a parity with technical trademarks used on goods. The security of these marks should be protected. They are entitled to the same encouragement, since they represent good will in exactly the same fashion as marks used on goods, and ought to be accorded the same protection.

Ibid., 18.

¹³³ *Ibid.*, 13:

Section 5 is a departure. It provides for the deposit of all marks used in interstate commerce. The object is to have available for inspection as complete a file as possible of existing marks, whether registered or not, so that a person

to the provision Rogers had presented two years earlier, the committee draft made deposit optional rather than mandatory, but provided that no infringement suit could be brought on behalf of a mark that was not yet registered or deposited.¹³⁴ The committee draft also included a mildly revised version of the section providing a civil action for false designations of origins, false descriptions, or false representations.¹³⁵ The committee report explained:

Under the present act the only misbrandings forbidden are false indications of geographic origin. We can see no reason why one particular variety of false marking should be penalized and others permitted, and we have added a provision prohibiting not only false designations of origin, but any false description or representation. We realize that if this were included in a penal statute it would require an enormous sum for its enforcement. We have therefore adopted the method in vogue for many years in several European countries, of merely creating a cause of action and providing that anyone injured by the falsehood or any association of such persons may sue at law for damages, and in equity for an injunction to stop its continuance.¹³⁶

Rogers presented his committee's revised draft at the 1922 ABA annual meeting in San Francisco.¹³⁷ The Section adopted an amendment to the bill's definition of "trade-mark", and voted to approve the bill and to seek the ABA's endorsement of it.¹³⁸ The following day, the full ABA voted to endorse the bill, apparently without debate.¹³⁹

The ABA section then took the draft on tour, seeking comments from the New York Patent Association, the American Patent Law Association, the Chicago Patent Law Association, and the

desiring to adopt a new mark can have some place to go where he is reasonably sure of finding the marks which his competitors are using, and thus be enabled to avoid infringing existing rights. Under the present law there is no place in this country where such a search can be made, and with the best intention in the world and after exhausting all available means of information, no one can be sure, in getting up a new mark, that he is free of the charge of infringement. The result of this provision will be to gather together so as to be readily accessible, marks which are in use, with particulars as to the goods upon which they are used. We all agree that such a provision is important and will be useful.

¹³⁴ Ibid., 23 (Committee Draft § 5).

¹³⁵ Ibid., 35 (Committee Draft § 30).

¹³⁶ Ibid., 19–20.

¹³⁷ Report of the 45th Annual Meeting of the American Bar Association 505 (1922).

¹³⁸ Ibid., 505. The committee draft had defined trade-mark as including "any mark which is entitled to registration under the terms of this act whether registered or not". The ABA section substituted the definition "any mark used for the purpose of identifying any merchandise or business."

¹³⁹ Ibid., 40.

Pittsburgh Patent Law Association, the Philadelphia Patent Law Association, and the U.S. Patent Office.¹⁴⁰ Rogers revised the bill and revised it again in response to comments and complaints.¹⁴¹ Some of the individuals asked to review the bill expressed a preference for old familiar language, and with each iteration, some of the words and phrases Rogers had replaced returned to the draft.

IV.

A number of years ago I was asked to read a paper before the American Bar Association and I chose trade-marks and I took occasion to criticize the rather jumbled condition of the statutes. As I say, there are seven or eight of them all scattered through the different books. I got exactly what I earned. I was appointed chairman of a committee to make suggestions along the lines of improvements, on the same theory that a man in any club who kicks about the food is put on the house committee. The committee was appointed, consisting of about 10 men, and we got all the information we could from all sorts of sources, patent lawyers, patent-law associations, manufacturers' associations, the Merchants Association of New York, and all that sort of thing, and we drafted a bill which was submitted to the association the next year. There was a great deal of discussion and it was referred back for further changes. It was finally drafted and submitted to the Bar Association and had its approval.

— Edward S. Rogers (1932)¹⁴²

In 1924, the ABA persuaded Senator Richard Ernst, Republican of Kentucky, and Representative Florian Lampert, Republican of Wisconsin, to introduce the text of Rogers's bill in Congress.¹⁴³ At a joint House-Senate Patent Committee hearing, Rogers described the bill, section by section, and answered the lawmakers' questions.¹⁴⁴ He explained that because Congress's authority to regulate

¹⁴⁰ See Rogers, "Secondary Meaning", 308–310; 1925 Joint Hearings, 6 (further statement of the ABA Section of Patent, Trade-Mark, and Copyright Law); *ibid.*, 17–18 (testimony of A.C. Paul, American Bar Association); *ibid.*, 56–57 (testimony of Arthur C. Fraser, N.Y. Patent Law Assn.).

¹⁴¹ 1925 Joint Hearings, 18 (testimony of A.C. Paul, ABA: "Now, Mr. Rogers has had more to do with this bill, in fact he drafted the original bill, and the changes have been made largely by him in connection with the different organizations"). The provision barring the registration of geographic terms or surnames reappeared during these revisions. *Ibid.*, 19. (S. 2679, § 2(e)). The provision barring suits on behalf of marks not yet deposited or registered was eliminated. *Ibid.*, 33 (colloquy).

¹⁴² *Trademarks: Hearings Before the House Comm. On Patents*, 72d Cong. 65 (Feb. 8 & 9, 1932) (testimony of Edward S. Rogers).

¹⁴³ S. 2679, 68th Cong. (1924); H.R. 8637, 68th Cong. (1924).

¹⁴⁴ 1925 Joint Hearings, 30–54, 61–64, 70–74, 160–63 (testimony of Edward S. Rogers).

trademarks was constrained by the Constitution, Congress lacked the power to enact a law creating trademark rights. Rather, any legislation must be “procedural”, in the sense that it helped owners of preexisting common law trademark rights to enforce them.¹⁴⁵ Representatives of patent law associations and members of the trademark bar complimented Rogers and the ABA on the careful work that had gone into the bill, and suggested modest modifications that would more reliably signal an intent to preserve the extant common law.¹⁴⁶ Some raised concerns that changes to the wording in the current statutes might unsettle established common law doctrine;¹⁴⁷ others urged Congress to take the opportunity to abolish or reduce contested patent office proceedings, which had been copied from the patent law and made little sense in connection with trademarks.¹⁴⁸ In general, though, the bill appeared to be well-received by the trademark bar. Rogers rewrote the bill after the hearing to incorporate suggestions from some of the witnesses. The Senate committee reported the revised bill favorably,¹⁴⁹ but it failed to reach a vote on the Senate floor.

The following year, Representative Albert Vestal, Republican of Indiana and the new chairman of the House Patents Committee, introduced a modestly revised version of the bill as H.R. 6248.¹⁵⁰ This time, there was fierce opposition. Henry Thomson, a Boston inventor and patent agent, had responded to the absence of a central directory of trademarks by building his own catalogue of both registered and unregistered marks in use, and launched Thomson Trade-Mark Research Service, which offered trademark searches to the bar. Thomson’s collection of marks was widely acknowledged to be the most comprehensive source available. A federal registry of all trademarks in use posed an obvious threat to Thomson’s business model, so he mounted an incendiary propaganda campaign against

¹⁴⁵ Ibid., 30–31 (testimony of Edward S. Rogers).

¹⁴⁶ Ibid., at 54–56 (testimony of James T. Newton, American Patent Law Association); *ibid.*, 56–77 (testimony of Arthur C. Fraser, New York Patent Law Association); *ibid.*, 119–134 (testimony of Arthur William Barber, U.S. Trade-Mark Assn.).

¹⁴⁷ Ibid., 130–132 (testimony of Arthur William Barber, U.S. Trade-Mark Assn.).

¹⁴⁸ Ibid., 78–84 (testimony of Otto Barnett, Chicago trademark lawyer); *ibid.*, 134–137 (testimony of Robert Watson, Washington DC); *ibid.*, 146–148 (testimony of Arthur F. Greeley, former member of the 1898 Congressional Commission to Revise the Patent and Trade-Mark Laws); *ibid.*, 150–151 (testimony of E.L. Rice).

¹⁴⁹ S. Rep. No. 1067, 68th Cong. (1925).

¹⁵⁰ H.R. 6248, 69th Cong. (1926). Senator Ernst reintroduced the Senate version as S. 2547. This version also included a provision, inserted at the suggestion of the Patent Office, to allow merchants who intended to adopt trademarks to preregister them in order to complete the examination process before actual use. H.R. 6248 § 1 (“Whoever purposes to adopt a trade-mark for use in commerce may apply to register such trade-mark, paying a fee of \$10”). That provision proved to be highly controversial, and was eliminated in subsequent versions of the legislation. *See Trade-Marks: Hearings on H.R. 13486 Before the House Comm. On Patents*, 69th Cong. 1 (1927) (testimony of Edward S. Rogers).

the bill. Thomson sent out hundreds of postcards and handbills alleging that the results of enacting the bill would be catastrophic. Because the new deposit provision would allow easy, no-fuss deposit of any mark without patent office examination, Thomson insisted, merchants could make bad faith deposits that could fatally undermine the vested rights of the owners of legitimate registered marks.¹⁵¹ Thomson's campaign persuaded the newly established Boston Patent Law Association to testify in opposition to the bill.¹⁵² Thomson also reached out to the Association of National Advertisers and the National Confectioners Association and secured their opposition.¹⁵³ The American Patent Law Association reconsidered its earlier endorsement of the legislation and administered a detailed referendum on the bill to its members: the results showed deep division, but the majority of the voting members indicated that they opposed major changes to the current trademark laws.¹⁵⁴

Henry Thomson's fear-mongering about the bill was both self-serving and wildly exaggerated. It was nonetheless effective, because it forced proponents of the bill to confront the essential contradiction in their goals. Rogers sought to craft legislation that would simultaneously preserve the generous common law protection against unfair competition that courts afforded to trademarks and other indicia of source, while encouraging the owners of unregistered marks to deposit their marks in a federal registry. But any meaningful inducement to deposit unregistered marks, whether framed as a penalty or a benefit, would necessarily affect vested common law trademark rights.

Thomson broadened his attack, arguing that everywhere the proposed legislation altered extant statutory language it might unsettle longstanding common law interpretation. A number of other witnesses voiced similar concerns, and suggested that the current common law regime was entirely satisfactory, and a new trademark statute would risk destabilizing it.¹⁵⁵

Meanwhile, a different group of lawyers insisted that Rogers had misread the Supreme Court's decisions. The commerce clause, they insisted, was capacious enough to support substantive trademark regulation, and Congress should bite the bullet and enact a modern substantive trademark statute.¹⁵⁶ Karl Fenning, formerly the

¹⁵¹ *Trade-Marks, Hearings on H.R. 6428 Before the House Comm. On Patents*, 69th Cong. 12–20, 37–45 (1926). (testimony of Henry C. Thomson).

¹⁵² *Ibid.*, 87–100 (testimony of Harrison F. Lyman, Boston Patent Law Assn.).

¹⁵³ *Ibid.*, 53–59 (testimony of Robert K. Leavitt, Assn. of Nat. Advertisers); *ibid.*, 73–78 (testimony of Walter Hughes, National Confectionary Assn.).

¹⁵⁴ *Ibid.*, 124–127 (colloquy).

¹⁵⁵ *See, e.g.*, *ibid.*, 106–112 (testimony of A.W. Barber, American Trade-Mark Assn.); *ibid.* at 131–152 (testimony of Robert Watson).

¹⁵⁶ *Ibid.*, 127–129 (testimony of Karl Fenning); *id.* at 164–165 (testimony of Arthur Fraser).

Assistant Commissioner of Patents, had worked on the Rogers bill while in the Patent Office. Now in private practice, he felt free to express his personal views, which were scathing: “My impression is that the present registration trade-mark law is ineffective, inefficient, and almost useless. I am satisfied that this revision of the law will make matters much worse”.¹⁵⁷ Fenning argued that Congress’s commerce clause power was unquestionably robust enough to support substantive trademark legislation. He proposed that Congress enact a law requiring registration of any trademark as a condition of using it in interstate commerce.¹⁵⁸

On December 6, 1926, Representative Vestal introduced the next version of the bill. Rogers had incorporated a number of suggestions made by the Boston Patent Law Association,¹⁵⁹ but retained the same overall strategy. As compared with then-current law, the bill further broadened the definition of trademarks entitled to registration, established a depository that permitted cheap and easy deposit of unregistered marks to enable the patent office to create a searchable directory of marks in use, and contained multiple statements insisting that nothing in the bill derogated from the common law.¹⁶⁰ The revisions did not mollify Henry Thomson. Thomson sent hundreds of postcards to businesses warning them that the trademark bill before the House and Senate Committees would allow strangers to file secret claims that would put a cloud on the title of legitimate owners of trademarks, and that the only way to discover whether someone had done so would be to pay a trademark lawyer a million dollars to monitor patent office records. In response, between 50 and a hundred recipients sent letters and telegrams to Congress protesting the legislation.¹⁶¹

Despite new language purporting to limit the legal effect of depositing unregistered marks, witnesses continued to protest that the deposit provisions might impair the rights of the owners of registered trademarks. Rogers argued that since trademark rights arose exclusively under the common law on the basis of use, neither registration nor deposit conferred any substantive rights whatsoever. Therefore, he insisted, the trademark depository could have no legal effect on any trademark owner’s rights.¹⁶² Still, witnesses objected to language that seemed to them to pose a danger

¹⁵⁷ Ibid., 127.

¹⁵⁸ Ibid., 127–131. See also K. Fenning, “Trade Mark Law Desirable” (1926) 8 *Journal of the Patent Office Society* 573.

¹⁵⁹ H.R. 13486, 69th Cong. (1926). See “The Vestal Bill: H.R. 6683 – H.R. 11938” (1928) 23 *Bulletin of the U.S. Trade-Mark Association* [hereinafter “The Vestal Bill”]; Rogers, “Secondary Meaning”, 310–311.

¹⁶⁰ 1927 House Hearings, 2–3 (testimony of Edward S. Rogers); “The Vestal Bill”, 44–50.

¹⁶¹ 1927 House Hearings, 25–28 (testimony of Henry C. Thomson).

¹⁶² See *Registration of Trademarks: Hearing on S. 4811 Before the Senate Comm. On Patents*, 69th Cong. 13–14 (1927) (testimony of Edward S. Rogers).

of changing or undermining common law doctrine.¹⁶³ Despite the strong opposition, both the House and Senate Committees reported the bill favorably with only modest amendments. The House passed the bill, but the Senate did not.¹⁶⁴

Between 1926 and 1932, Representative Vestal introduced seven versions of the bill.¹⁶⁵ Rogers was the principal drafter of all of them. Where the original bill had replaced ambiguous language, opponents argued that the new language could disrupt the common-law meaning of phrases that might have been ambiguous when enacted but had since been construed by scores of courts.¹⁶⁶ In response to those critiques, old statutory language crept back into the legislation.¹⁶⁷ The shape of the depository for unregistered marks got blurrier as the drafters added more limitations and constraints. Most of the changes, though, were tinkering at the edges. The overall strategy and approach of the legislation remained the same.¹⁶⁸ Both the House and Senate passed versions of the bill, but never at the same time.¹⁶⁹

Throughout this series of hearings, Rogers kept control of the working draft. If the House or Senate committee concluded that a provision ought to be changed, they relied on Rogers to figure out the new wording and report back with a revised draft.¹⁷⁰

Then, in 1931, Republicans lost control of Congress. William Sirovich, Democrat of New York, and one of only ten Jewish Congressmen, assumed the chairmanship of the House Patent Committee.¹⁷¹ As a Jew and a Democrat, Sirovich had little reason to trust the American Bar Association, which had routinely opposed progressive legislation, and had expended significant resources to exclude Jews from the practice of law.¹⁷² Instead of proceeding with the ABA-backed Rogers bill, Chairman Sirovich decided to start

¹⁶³ Ibid., 19–22 (testimony of Karl Fenning, American Patent Law Assn.); *ibid.* at 26–28 (testimony of William S. Greene, Jr., U.S. Trade-Mark Assn.); *ibid.*, 46–50 (testimony of Robert Watson).

¹⁶⁴ S. Rep. 1576, 69th Cong. (1927); H.R. Rep. 2203, 69th Cong. (1927); 60 Cong. Rec. 5148 (Feb. 28, 1927).

¹⁶⁵ H.R. 7118, 72d Cong. (1932); H.R. 2828, 71st Cong. (1929); H.R. 13109, 70th Cong. (1928); H.R. 11988, 70th Cong. (1928); H.R. 6683, 70th Cong. (1927); H.R. 13486, 69th Cong. (1926); H.R. 6249, 69th Cong. (1926).

¹⁶⁶ See, e.g., 1926 House Hearings, 64–65 (colloquy).

¹⁶⁷ Compare, e.g., H.R. 8637, 68th Cong. §2 (d) (1924) with H.R. 13486, 69th Cong. §2 (d) (1926).

¹⁶⁸ W. Fawcett, “Reexamining the Basis of Trademark Revision” (1932) 27 Bulletin of the U.S. Trade-Mark Association 65, 67.

¹⁶⁹ D. Robert, *The New Trade-Mark Manual* (Washington 1947) 228–237.

¹⁷⁰ See, e.g., 1927 House Hearings, 35 (testimony of Edward S. Rogers).

¹⁷¹ K. F. Stone, *The Jews of Capitol Hill: A Compendium of Jewish Congressional Members* (Lanham MD 2011) 217–220, 998.

¹⁷² See, e.g., J. S. Auerbach, “From Rags to Robes: The Legal Profession, Social Mobility, and the American Jewish Experience” (1976) 66 Jewish Historical Quarterly 249.

fresh.¹⁷³ He invited trademark scholar and lawyer Frank Schechter,¹⁷⁴ a fellow alumnus of Columbia University and the son of the late Solomon Schechter, a prominent Jewish leader, to educate the committee on the history and nature of trademark law.¹⁷⁵ Schechter took a much more expansive view of the scope of Congress's commerce clause authority. He argued that Rogers's characterization of the extant statutes as procedural rather than substantive was simply mistaken, because the courts had construed the laws to confer substantive legal rights on the owners of trademark registrations. Given the importance of trademarks, Schechter argued, Congress should go much further. Sirovich asked Schechter to draft a new trademark revision bill for the committee's consideration.¹⁷⁶

¹⁷³ W. Fawcett, "Patent Committee Shake-ups Reset the Legislative Scene" (1932) 27 Bulletin of the U.S. Trade-Mark Association 1, 3.

¹⁷⁴ In the 1920s and 1930s, Jewish lawyers and Gentile lawyers tended to occupy distinct professional and social spheres. *See, generally*, Auerbach, "From Rags". The borders were not completely impermeable. Frank Schechter was never a member of the ABA, but both he and Rogers were members of the Association of the Bar of the City of New York and they served together on its Committee on Trade-Marks and Unfair Competition: "New Officers of N.Y. City Bar" (1933) 5 New York State Bar Association Bulletin 465, 467. Rogers, Ramsay & Hoge hired a lawyer in 1937, Jerome L. Issacs, who appears to have been Jewish. Issacs worked with Rogers on *Bacardi Corp. of America v. Domenech*, 311 U.S. 150 (1940), a constitutional challenge by Bacardi to a Puerto Rican law that regulated the use of trademarks on distilled spirits. As far as the research librarians at the University of Michigan law library can determine, Issacs appears to be the only Jewish lawyer to work at either of Rogers's law firms during his tenure. Issacs left the firm in 1944.

¹⁷⁵ 1932 House Hearings. On the first day of the Hearings, Frank Schechter held forth. *Ibid.*, 1–34. On the second day, Rogers was invited to testify. *Ibid.*, 35–76. Henry Thomson also attended the 1932 House Hearings, and spoke with passion in opposition to the current version of the Rogers Bill. *See* 1932 House Hearings, 51–61 (testimony of Henry C. Thomson).

¹⁷⁶ 1932 House Hearings, 32. *See* W. Fawcett, "Reexamining the Basis of Trademark Revision" (1932) 27 Bulletin of the U.S. Trade-Mark Association 65. Fawcett reported that Sirovich planned to jettison the perennial Rogers bill in favor of a bill to be drafted by Schechter, and that Schechter had explained to him the ways in which his legislation would differ from the Rogers Bill:

The foundation of all reform in this subject must be the very learned work of Mr. E. S. Rogers and his associates, who have labored for so many years on this task. The main points in which I have differed from the Vestal Bill originate from my belief, first, that it does not perhaps, in some respects, quite sufficiently reflect the functional necessities of trade-mark protection today; secondly, that it is predicated upon the belief that Congress cannot, under the commerce clause of the Constitution, enact substantive trade-mark legislation.

My amendments will attempt to deal, in the main, with the following: (1) The broadening of the enumeration of marks that shall be denied registration; (2) the consequent broadening of the remedy of injunction to coincide with the protection to trade-mark owners implied above; (3) the registration of service trade-marks as such and not merely the registration of devices or trade-names, as has been proposed; (4) making trade-mark infringement a misdemeanor, as under the copyright law; (5) providing for a reasonable attorney's fee to be awarded to the plaintiff in trade-mark

Schechter drafted a bill that used the current version of Rogers's legislation as a template, but inserted his own innovations. First, rather than including a separate section allowing the registration of service marks and collective marks on the same terms and with the same effect as trademark registration,¹⁷⁷ Schechter deleted that section and drafted a definition of trademark that was broad enough to encompass service marks and collective marks.¹⁷⁸ Second, the bill prohibited the registration of any mark that was likely to "injure the good will, reputation, business, credit or securities" of the owner of a "coined or invented or fanciful or arbitrary mark".¹⁷⁹ Third, Schechter's bill made willful trademark infringement a misdemeanor.¹⁸⁰ Fourth, the bill provided for a new civil action for fraudulent representations made before the Patent Office in connection with trademark registration, opposition or cancellation. Finally, the bill allowed the recovery of attorneys' fees in all civil actions.¹⁸¹ Representative Perkins introduced Schechter's bill as H.R. 11592 on April 25, 1932.¹⁸²

Chairman Sirovich had planned to see whether he and Albert Vestal could come up with a compromise bill.¹⁸³ Vestal, who had already introduced the latest version of the Rogers bill on January 6,¹⁸⁴ died suddenly on April 1, and none of the trademark bills pending before Congress advanced.

In the 1932 presidential election, Franklin D. Roosevelt defeated Herbert Hoover in a landslide. Roosevelt had campaigned on a

infringement cases, as in actions under the Sherman Anti-Trust Law; (6) restoration of the perjury provision which appeared in H. R. 2828 but has, for some reason or other, seemingly been omitted in the present H. R. 7118.

Ibid., 71 (quoting Frank Schechter).

¹⁷⁷ H.R. 7118, 72d Cong., § 23 (1932).

¹⁷⁸ See H.R. 11592 § 30 ("The term 'trade-mark' includes any mark, device, trade name, slogan, collective mark, or mark of association so used as to distinguish the source or origin of the users' goods or services, and a trade-mark shall be deemed to be applied to an article or services when it is placed in any manner in or upon the article itself or upon the receptacle or package or upon the envelope or upon the vehicle or other thing in, by, through, or with which the goods are packed or inclosed or otherwise prepared for sale or distribution, or when it is placed upon the vehicle, instrument, container, envelope, wrapping, or other means of distribution, delivery, or transmission in, by, through, or with which the service is rendered or conveyed to the purchaser or consumer.").

¹⁷⁹ *Ibid.*, § 2.

¹⁸⁰ *Ibid.*, § 26.

¹⁸¹ *Ibid.*, § 18, 25, 26.

¹⁸² H.R. 11592, 72d Cong. (1932).

¹⁸³ W. Fawcett, "Service Marks' – The Key to Trade-Mark Revision" (1932) 27 *Bulletin of the U.S. Trade-Mark Association* 79, 87–88.

¹⁸⁴ H.R. 7118, 72d Cong. (1932). Senator Hebert had introduced the Senate version as S. 2679, 72d Cong. (1932).

promise of “a new deal for the American people”.¹⁸⁵ The 73rd Congress devoted all of its energy to New Deal economic legislation; the House Patent Committee apparently didn’t meet at all.

Meanwhile, the members of the ABA trademark committee had lost their enthusiasm for Rogers’s legislation.¹⁸⁶ The 1933 Committee Report explained that a majority of the committee’s members no longer supported Rogers’s bill. Rather than pressing on with efforts at comprehensive revision, the committee suggested that the ABA pursue a few targeted amendments to the current statutes to solve particular concrete problems. Rogers initially dissented from the majority view,¹⁸⁷ but eventually agreed to endorse this piecemeal but less controversial approach. The 1935 ABA Section Committee report reported that the much-criticized trademark statutes had in fact “worked surprisingly well”, and recommended that the ABA seek a few specific amendments to make them work even better.¹⁸⁸

Frank Schechter’s response to the ABA’s committee’s retrenchment was caustic.¹⁸⁹ In an article published in the *Columbia Law Review* and excerpted the following month in the *Bulletin of the United States Trade-Mark Association*, Schechter first mocked Edward Rogers for renouncing his earlier trenchant

¹⁸⁵ “Text of Governor Roosevelt’s Speech at the Convention Accepting the Nomination”, *New York Times*, 2 July 1932, p. 8; “Roosevelt Asks Votes for ‘New Deal’”, *New York Times*, November 8, 1932, p. 1.

¹⁸⁶ See Report of the Trade Mark Committee, 1933 ABA Sec. Pat. Trademark & Copyright L. Comm. Rep. 5 (1933)(“The committee has considered the bill which has been introduced in Congress in previous sessions and a majority believe that, before it is again introduced, it should be changed in various important particulars”); Report of the Committee on Trademarks, 1934 ABA Sec. Pat. Trademark & Copyright L. Comm. Rep. 26 (1934)(“The last report of the committee indicated that the majority of it are of the opinion that the bill as now drawn is not one which the committee can recommend to the Section. That situation has not changed”).

¹⁸⁷ See 1933 ABA Sec. Pat. Trademark & Copyright L. Comm. Rep. 6 (“Mr. Edward S. Rogers does not agree with the foregoing report because he considers the Canadian statute unwise, and he points out that its constitutionality and practicability are questioned by competent members of the Canadian Bar. He also thinks that piecemeal legislation regarding trademarks would be a mistake, and that the Vestal bill, having had the careful scrutiny and general approval of this section, should not be discarded”).

¹⁸⁸ See Report of the Committee on Federal and State Trade-Mark Legislation, 1935 ABA Sec. Pat. Trademark & Copyright L. Comm. Rep. 9–10 (1935):

Thirty years’ experience with the present statutes has shown that as a whole they have worked surprisingly well. While certain language in them was originally obscure, it has been clarified by judicial interpretation. We have come to the conclusion, therefore, that the ideally perfect had better give way to the practically attainable. Accordingly, we submit for your consideration, certain amendments to the existing statutes, which are in the direction of progress and of making trade-mark property more secure.

¹⁸⁹ F. I. Schechter, “Fog and Fiction in Trade-Mark Protection” (1936) 36 *Colum. L. Rev.* 60 (“The members of the Committee on Trade-Mark Legislation of the American Bar Association have recently done themselves a grave injustice”).

critique of the trademark statute,¹⁹⁰ and then explained why Congress had ample authority under the commerce clause to enact substantive trademark legislation:¹⁹¹

We have seen that, from the standpoint of actual commercial realities, commerce in the United States today is, or is consistently striving to become, national or interstate and not intrastate. If this be so, the mere fact that in the past trade-mark rights have emanated from the several States, should not, under a realistic system of trade-mark protection, permit whatever trade-marks of wholly intrastate businesses and whatever purely intrastate trade-mark rights have existed in the past, to prevent an adequate and effective federal trade-mark statute from operating effectively, even though, in the course of operation of such Congressional legislation intrastate trade-marks or rights may incidentally be affected.¹⁹²

The practical problem with a piecemeal amendment strategy that addressed complaints with the federal registration process and left the common law undisturbed was that state legislatures had always had the power to enact state statutes that derogated from the common law and, in the 1930s, states began to flex their muscles. State legislators introduced legislation that would amend their state trademark statutes to award in-state ownership of a trademark to the first state registrant, or to condition use of a trademark within the state on state registration.¹⁹³ Furious lobbying by the trademark bar defeated bills in New York and Rhode Island, and persuaded the governor of Nevada to veto the trademark bill passed by his state legislature,¹⁹⁴ but the trend alarmed Rogers. Frank Schechter's view that Congress's commerce

¹⁹⁰ Ibid., 60–61.

¹⁹¹ Ibid., 67–79; F. I. Schechter, "Congressional Power with Regard to Trade-Mark Protection" (1936) 31 Bulletin of the U.S. Trade-Mark Association 27.

¹⁹² Schechter, "Fog and Fiction", 79.

¹⁹³ See Report of the Committee on Federal and State Trade-Mark Legislation, 1935 ABA Sec. Pat. Trademark & Copyright L. Comm. Rep. 9, 13–18 (1935). In 1937, the ABA Section Committee reported that "the epidemic of compulsory state registration statutes seemed to be getting worse". The Report continued, "The menace of such legislation to the rights of trade-mark owners is, of course, apparent. If, as a condition of ownership, there must be registration in forty-eight states, an oppressive burden is placed on trade-mark property". Report of The Committee On Federal And State Trade-Mark Legislation, 1937 ABA Sec. Pat. Trademark & Copyright L. Comm. Rep. 23 (1937). Over the next several years, the threat that state legislatures might enact statutes that abrogated common law rights or conditioned them on state registration blunted much of the opposition to federal legislation.

¹⁹⁴ See Report of The Committee on Federal And State Trade-Mark Legislation, 1935 ABA Sec. Pat. Trademark & Copyright L. Comm. Rep. 9, 13–19 (1935); Report of The Committee On Federal And State Trade-Mark Legislation, 1937 ABA Sec. Pat. Trademark & Copyright L. Comm. Rep. 23 (1937).

power was more capacious than previously thought looked more and more attractive, or at least expedient.¹⁹⁵

In what was probably a face-saving move, Rogers suggested that the ABA Patent section poll its members to find whether they believed that Congress had the power to enact a substantive trademark law, and, if so, whether they supported proposals that it do so.¹⁹⁶ The following year, Rogers reported that after a careful study, his subcommittee had concluded that a federal statute that conferred substantive trademark rights as well as providing for registration would be both constitutional and desirable. He recommended that Congress appoint a commission of experts to draft an appropriate bill,¹⁹⁷ but also appended a draft of one possible such bill to his subcommittee's report.¹⁹⁸ The draft, titled "An Act to prevent fraud in the sale of goods or services in commerce, to extend to American nationals the benefits given to nationals of foreign countries under International Conventions and for other purposes", began with a substantive declaration:

¹⁹⁵ Frank Schechter died of pneumonia in September 1937: "Frank Schechter, Lawyer, Dies At 47: Trademark Law Authority and Writer of Many Legal Articles Stricken Here", *New York Times*, 27 September 1937, p. 21.

¹⁹⁶ See Report of the Committee on Federal and State Trade-Mark Legislation, 1936 ABA Sec. Pat. Trademark & Copyright L. Comm. Rep. 17, 17–18 (1936):

We believe, however, that the time has about arrived when serious consideration should be given to the proposal many times hesitatingly made that Congress should exert its full authority under the commerce clause and the treaty-making power to enact a statute which will give to trade-mark owners substantive rights and not merely procedural advantages.

With this in view, we recommend that the Trade Mark Committee of this Section proceed with an inquiry, by way of a questionnaire among the members of the Section and through such other channels as the Journal of the American Bar Association, or otherwise, as may be available, to determine whether the profession and industry generally desire a completely revised Federal Trade Mark Act dealing with the substantive law of trade marks in commerce over which Congress has control and, whether it is desired or not, what changes in or additions to the existing statutory law should be made; and that the Committee consider the various suggestions and views submitted and report thereon, together with its own recommendations, to the next meeting of this Section. (See the illuminating article by Frank I. Schechter, "Fog and Fiction in Trade-Mark Protection", *Columbia Law Review*, January, 1936; Excerpts in Bulletin U. S. Trade Mark Association, February, 1936.)

I can find no record of any questionnaire's actually being sent out. Instead, Rogers reported at the next year's annual meeting that the answer to both questions was yes.

¹⁹⁷ Report Of The Committee On Federal And State Trade-Mark Legislation, 1937 ABA Sec. Pat. Trademark & Copyright L. Comm. Rep. 23, 24 (1937); Secretary's Digest of the Proceedings of the Section of Patent, Trade-Mark and Copyright Law – Kansas City, Missouri, September 27, 28, 1937, 1937 A.B.A. Sec. Pat. Trademark & Copyright L. Proc. 5, 7–8 (1937).

¹⁹⁸ 1937 Committee on Legislation Report, 24; Report of the Sub-Committee to the Joint Meeting of the Committees on Trade-Mark Law, 1937 ABA Sec. Pat. Trademark & Copyright L. Comm. Rep. 26, 29–35 (1937).

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

It shall be unlawful (1) to transport in commerce any copy, counterfeit, or colorable imitation of any trade mark registered under this Act (2) to use in commerce such copy, counterfeit or colorable imitation upon or in connection with the merchandise set forth in the certificate of registration or merchandise of such a character that the use of the copy counterfeit or colorable imitation thereon is likely to cause confusion or mistake or to deceive purchasers.

Said acts are each declared to be unlawful and shall be actionable at the suit of any person injured.¹⁹⁹

Like earlier versions of the Rogers bill, the draft incorporated a very broad scope of potentially registrable marks, including service marks, collective marks, and descriptive marks that had acquired secondary meaning, and provided that registration should be notice to all persons of the registrant's claim. To induce trademark owners to register their marks, the draft borrowed the British concept of incontestability. After five years, a trademark registration would no longer be subject to cancellation.²⁰⁰ In another departure from the common law, the draft would have made trademarks assignable in gross, "either in connection with the goodwill of the business or not".²⁰¹ It also would have authorized the Commissioner of Patents to assemble a collection of unregistered marks used in commerce for search purposes, invited users of any marks to deposit them in the collection, and added teeth to the invitation by making it "unlawful to use any mark in interstate commerce unless and until such mark has been deposited. . .".²⁰² Finally, the draft imposed criminal penalties for counterfeiting.²⁰³ The ABA section did not approve the

¹⁹⁹ 1937 Sub-Committee Report, 29.

²⁰⁰ 1937 Sub-Committee Report, 26, 31 ("After the period for cancellation of the registration of a trade mark has expired the exclusive right of the registrant to his trade mark shall be incontestable.").

²⁰¹ *Ibid.*, § 14 at 32.

²⁰² *Ibid.*, §§ 26–28, 31, at 33–34. Although section 31 of the draft declared that use of an undeposited mark was unlawful, the draft included no enforcement provision for that declaration. The draft also provided that deposited marks would be deemed cancelled if not renewed every five years and that deposit would have no legal effect except as evidence that the depositor claimed a right to use the mark. §§ 29–30, *ibid.*, 34. The draft did not include a false designation and false representation section, did not make any provision for export marks previously registered under the 1920 Act, and did not refer to any international agreements.

²⁰³ *Ibid.*, §§ 29, 32 ("Sec. 32. The making of any copy, counterfeit or colorable imitation of any registered trade-mark or knowingly to sell or dispose of any goods bearing such copy, counterfeit or colorable imitation shall be a misdemeanor punishable by a fine not exceeding One Thousand Dollars or imprisonment not exceeding six months, or both such fine and imprisonment"). The draft did not include a false designation or false description provision.

text of the draft, but it voted to recommend that the full ABA approve a resolution encouraging Congress to appoint a commission to draft a revised trademark law.²⁰⁴

Meanwhile, in Washington, Chairman Sirovich asked Representative Fritz Lanham, Democrat of Texas, to head a trademark law subcommittee. Lanham had been a member of the House Patent Committee since 1921, and had attended most of the hearings of successive ABA-backed trademark bills. Lanham sat down with Conway Coe, the Commissioner of Patents, and asked his advice. Coe arranged a meeting between Lanham and Rogers to discuss trademark legislation. As Rogers later told the story, Lanham expressed concern that piecemeal amendments would make the trademark law even more confusing, and asked whether anyone had put together a draft of a complete new trademark statute. Rogers just happened to have brought a draft of a possible statute with him to the meeting.²⁰⁵ Lanham introduced that draft, without change, as H.R. 9041.

V.

A business-man has a right to the reasonable expectation of future custom without interference by fraud, by misrepresentation, by force, by threats, by defamation, by disparagement, by the enticement of his employees, the betrayal of confidential information, commercial bribery and interference with his contracts. All these acts are species of the genus unfair trading, as the term is now understood. Under the modern law as it is now applied, unfair competition includes any act, not necessarily fraudulent, which artificially interferes with the normal course of trade to the disadvantage of another.

— Edward S. Rogers (1945)²⁰⁶

Rogers's new draft shared the skeleton of the draft his subcommittee had presented to the ABA that summer. It began with the same clause declaring infringement of registered trademarks unlawful, and included the incontestability provision, the deposit provisions, and the assignment without goodwill section. Rogers had added back language drawn from some of the prior bills (including the false

²⁰⁴ See Secretary's Digest of the Proceedings of the Section of Patent, Trade-Mark and Copyright Law – Kansas City, Missouri, September 27, 28, 1937, 1937 A.B.A. Sec. Pat. Trademark & Copyright L. Proc. 5, 8–9 (1937); Report of the Section of Patent, Trade-Mark and Copyright Law, 62 Annu. Rep. A.B.A. 999, 1005 (1937).

²⁰⁵ See E. S. Rogers, "The Lanham Act and the Social Function of Trademarks" (1949) 14 Law and Contemporary Problems 173, 180.

²⁰⁶ E. S. Rogers, "Unfair Competition" (1945) 35 Trademark Rep. 126, 129.

designation/false representation section),²⁰⁷ and inserted new language that Rogers had written and not yet shared with his ABA colleagues.²⁰⁸

Rogers described the new bill as taking a different approach from that taken by prior bills:

The present bill is worked out on the theory that Congress, under the commerce clause, has more power over trade-marks than it has heretofore exercised and that it should exercise that power because commerce, in these days, is not a local matter, it is Nation-wide. Trade-marks are valuable instrumentalities of commerce, because they enable anyone easily to pick out the goods he wants to buy and to avoid the goods he does not want to buy. Trade-marks are merely an identifying means.

Now, there is this enormous field that cannot be covered by common law—that is, the field of interstate commerce—that, must be covered by Federal statute; otherwise we are going to have an intolerable mess, because we have 48 separate sovereignties to deal with, each legislating as it sees fit with respect to marks within its borders regardless of where those marks originate.

This bill, frankly, is based on the theory that there is a legitimate and proper field for congressional action in that commerce over which Congress has control.²⁰⁹

In fact, large swathes of the bill's language had been copied directly from earlier versions. Rogers had not sat down and written a new bill from scratch. Rather, he had inserted new provisions to reinforce the rights of trademark registrants and encourage widespread registration. And while some of the new language, like the invocation of likelihood of confusion, was drawn from the common law, the draft took much of the common law of trademarks for granted, and did not attempt to restate it. There was, for example, no effort to capture the common law doctrines relevant to ownership or priority nor any mention of well-established common law defenses like genericism, abandonment, or functionality.

²⁰⁷ H.R. 9041 § 41, 75th Cong. (1938).

²⁰⁸ Indeed, the ABA section adopted a resolution disapproving of the bill because the members had not seen it before its introduction and had not been involved in the revision. See "Report of the Section of Patent, Trade-Mark and Copyright Law" (1940) 65 Annual Report of the American Bar Association 361, 362–363. One innovation that showed up for the first time in the 1938 version of the bill was a division of registration between a principal register and a supplemental register. The supplemental register was designed to replace the 1920 Act's registration for export marks.

²⁰⁹ See Trade-Marks: Hearings on H.R. 9041 Before the Subcomm. on Trade-Marks of the House Comm. On Patents, 75th Cong. 13 (1938) (testimony of Edward Rogers).

Lanham held very orderly hearings on the bill, beginning with the initial section and proceeding, section-by-section, to the end. As a result, the provisions at the beginning of the bill received much more discussion than those at the end. The initial clause of the bill declared it unlawful to introduce, receive, or use in commerce any copy, counterfeit, or colorable imitation of any registered trademark, and incorporated a likelihood of confusion or deception standard drawn from the case law. Witnesses objected that that provision transformed a trademark from a right earned under the common law from use in the course of trade to a right conferred by the federal government regardless of whether it had been earned.²¹⁰ If the bill was intended to prevent states from enacting laws that predicated in-state trademark rights on state registration, they complained, nothing in the language seemed designed to achieve that.²¹¹ To the extent that the bill conformed to extant common law, opponents insisted that those provisions were unnecessary because the common law already offered ample protection. Where the bill diverged from common law, the same opponents argued that the changes were pernicious because they would—or might—abrogate the relevant common law doctrine.²¹²

From a 21st century vantage point, it can be hard to appreciate the general perception, shared by the bill's proponents and opponents, of the permanence of the common law of trademarks and unfair competition. As the Supreme Court had noted in the *Trade-Mark Cases*, courts had elaborated the common law well before Congress had considered adopting trademark legislation. Witnesses were confident that unless a statute sought to prevent it, courts would continue to apply the common law long after they had retired. Rogers seemed to assume that with the limited exceptions of the innovations he had included in the bill, federal courts would continue to vindicate the same rights they always had, using the same standards to yield the same remedies. The bill purported to repeal the prior statutes, but everyone agreed that the substantive trademark rights possessed by merchants under the law of

²¹⁰ Ibid., 51–62 (colloquy); *ibid.*, 68–71 (colloquy).

²¹¹ Ibid., 23 (testimony of Earl Thomson). Henry C. Thomson died in June of 1932. His sons, Earl and Arthur Thomson, renamed the firm Thomson & Thomson, and took up the cudgels in opposition to the enactment of a trademark statute, although with less flamboyance than their father. Rather than mailing inflammatory postcards, Earl and Arthur joined the American Bar Association, and became active in the ABA's efforts to draft a federal trademark statute. By 1940, Earl Thomson had joined the ABA Section committee on Trade-Marks. See 1940 Report of the Committee on Federal and State Trade-Mark Legislation, 51 (minority report by Earl H. Thomson). In 1944, Thomson announced that he was prepared to support the current version of the bill as a good compromise. See 1944 House Hearings at 121, 127–129. (testimony of Earl Thomson).

²¹² See, e.g., 1938 House Hearings, 36–48 (testimony of Harrison F. Lyman, Boston Patent Law Association); see also, e.g., 1939 House Hearings, 21–22 (testimony of Mansfield C. Fuldner, General Foods); *ibid.*, 29–31 (testimony of H.J. Savage, National Biscuit Co.).

trademark and unfair competition did not derive from any of those statutes. The modern notion that enactment of the statute would somehow supersede the common law and cause settled doctrine to evaporate was simply unimaginable in 1938.

During the hearings on the bill, Lanham deferred to Rogers on decisions whether particular objections or suggestions should be incorporated into the bill, and asked Rogers to come up with or approve of the right wording.²¹³

After the hearings, Rogers trimmed the draft of its most controversial provisions. For the version of the bill introduced in March of 1939, Rogers finally gave up his trademark deposit plan, omitting it entirely from the bill. The draft retained the incontestability provisions, and permitted assignment without goodwill, but eliminated the initial section declaring it unlawful to introduce, receive, or use in commerce any copy, counterfeit, or colorable imitation of any registered trademark.²¹⁴ The 1939 version of the bill looked much like the Lanham Act that Congress would enact seven years later.

Rogers drafted and Lanham introduced further iterations of the legislation in 1939²¹⁵ and 1941.²¹⁶ Initially, the ABA section adopted a resolution disapproving the bill on the ground that it hadn't been involved in the drafting of it and had been given insufficient time to review it.²¹⁷ Later, section members objected to the incontestability and assignment without goodwill provisions on the ground that they would abrogate important common law doctrines. The ABA proposed amendments to the bill "intended to make the statutory trade-mark law conform to the common law".²¹⁸ A series of informal meetings brokered by Senators Bone, Danaher, and Lucas persuaded proponents and opponents of the bill to agree on a grand

²¹³ See, e.g., 1938 House Hearings, 141–143 (colloquy); 1939 House Hearings, at 47 (colloquy); *ibid.*, 70–72 (colloquy).

²¹⁴ H.R. 4744, 76th Cong. (1939).

²¹⁵ H.R. 6618, 76th Cong. (1939).

²¹⁶ H.R. 102, 77th Cong. (1941); H.R. 5461, 77th Cong. (1941).

²¹⁷ Digest of Proceedings of the Section of Patent, Trade-Mark and Copyright Law at Philadelphia, Pennsylvania, September 9–10, 1940, 1940 A.B.A. Sec. Pat. Trademark & Copyright L. Proc. 7, 17–18 (1940). Otto Barnett, a long-time member of the section who had testified in many of the past Congressional hearings, drafted his own variation omitting the assignment in gross and incontestability provisions that he found objectionable, deleting the provisions covering patent office examination, and restoring the unregistered trademark deposit plan. (The bill, thus, adhered to Rogers's original proposal more closely than any of the bills Rogers actually drafted.) Barnett persuaded Representative Paddock to introduce it as H.R. 1424. See Digest of Proceedings of the Section of Patent, Trade-Mark and Copyright Law at Indianapolis, Indiana, September 29–30, 1941, 1941 A.B.A. Sec. Pat. Trademark & Copyright L. Proc. 9, 17–18 (1941); Report of the Committee on Federal and State Trade-Mark Legislation, 1941 ABA Sec. Pat. Trademark & Copyright L. Comm. Rep. 26 (1941).

²¹⁸ Report of the Committee on Federal and State Trade-Mark Legislation, 1941 ABA Sec. Pat. Trademark & Copyright L. Comm. Rep. 26, 26 (1941).

compromise that required trademark assignments to be accompanied by goodwill, and that tempered the incontestability provisions with enumerated common law defenses.²¹⁹

Meanwhile, the Supreme Court had handed down its decision in *Erie Railroad v. Tompkins*,²²⁰ holding definitively that there was no federal general common law. Some scholars have identified the *Erie* decision as the impetus for the enactment of the Lanham Act,²²¹ and it may have been, but, as Mark McKenna and Christine Haight Farley have noted, the decision made little immediate difference in how federal courts decided trademark cases.²²² Rogers would later describe the decision as having caused chaos and uncertainty,²²³ but at the time, it didn't seem to worry either Rogers or other members of the trademark bar. Witnesses before Congress did not refer to the decision as game-changing, and the ABA patent section did not note it as an urgent problem in its published reports or proceedings.

The contours of the problems caused by the *Erie* decision emerged gradually. Six months after *Erie*, the Supreme Court decided *Kellogg v. National Biscuit*, an unfair competition decision brought under diversity jurisdiction. The Court predicated its decision on federal general common law, noting that, “[m]ost of the issues in the case involve questions of common law and hence are within the scope of *Erie R. Co. v. Tompkins*, 304 U.S. 64 (1938). But no claim has been made that the local law is any different from the general law on the subject, and both parties have relied almost entirely on federal precedents”.²²⁴ Later cases, though, insisted that

²¹⁹ 1940 Report of the Committee on Federal and State Trade-Mark Legislation, *supra* note 211, at 50; Digest of Proceedings of the Section of Patent, Trade-Mark and Copyright Law, 1941 A.B.A. Sec. Pat. Trademark & Copyright L. Proc. 9 (1941); H.R. 5461, 77th Cong., §§ 10, 14(c), 15, 33(b) (1941); *Trade-Marks: Hearings on H.R. 102, H.R. 5461, and S. 895 Before the Subcomm. On Trade-Marks of the House Comm. On Patents*, 77th Cong. 58–63 (1941); *ibid.* at 69–73 (colloquy). *See also* L. B. Stoughton, “A Review of the New Trade-Mark Manual” (1947) 45 Mich. L. Rev. 865, 870 (“Safeguards against too broad a grant were thought to be necessary. Unfortunately the safeguards which were finally deemed ‘adequate’ seem to have destroyed most of the substance of incontestability”).

²²⁰ 304 U.S. 64 (1938).

²²¹ *See, e.g.*, J. T. McCarthy, “Lanham Act § 43(a): The Sleeping Giant is Now Awake” (1996) 59 L. & Contemp. Probs. 45, 48.

²²² Farley, “Lost Unfair Competition Law”, 772–775; McKenna, “Trademark’s Faux Federalism”, 296–299. *See, e.g.*, *J.C. Penney Co. v. H.D. Lee Mercantile Co.*, 120 F.2d 949, 952n.1 (8th Cir. 1941).

²²³ *See* Rogers, *Introduction to Robert, New Trade-Mark Manual*, xvi:

Then came *Erie Railway v. Tompkins*, 304 U.S. 64, which required the Federal Courts to apply only the law of the State in which they sit, and there was chaos. There were forty-eight different sovereignties, the decisions of whose courts were the only law. The body of Federal decisions which had been fifty years evolving was not binding either on the State or Federal Courts. Nobody knew what the law was.

²²⁴ *Kellogg Co. v. National Biscuit*, 305 U.S. 111, 113n.1 (1938).

the lower courts had erred by failing to ascertain the local law.²²⁵ Some federal courts followed the example set in *Kellogg*: they consulted the available local law and concluded that the law of the state in which they sat was the same as federal law.²²⁶ Other federal courts concluded that even though the extant trademark registration statutes did not confer substantive rights, federal law should continue to control disputes involving federally registered trademarks, while local law should control actions for unfair competition and infringement of unregistered marks.²²⁷ For the first time, then, courts understood the law of registered trademark infringement and the law of unfair competition as emanating from different sources of authority, controlled by different sovereigns.²²⁸ By that time, though, Edward Rogers had left the building.

In the spring of 1941, as the United States pondered whether and when it might have to involve itself in World War II, the Department of Justice launched an investigation into Rogers's longtime client, Sterling Drugs, and its subsidiary Bayer. The company, it transpired, had in the 1920s entered into an illegal profit-sharing agreement with the German Bayer company, and was continuing to operate by its terms. The U.S. government charged the company and two of its officers under the Sherman Act. Sterling and its officers agreed to the entry of a consent decree that admitted the agreements were unlawful and that enjoined the company from continuing to honor them.²²⁹ The government ousted Sterling's management, and asked Rogers to take over the company as chairman of the board. Rogers, then 66 years old, accepted the job and officially retired from the active practice of law at both of his law firms. Although he retained his membership in the American Bar Association, he ceased participating in the work of the ABA Patent Section or testifying on the Lanham Bills. Daphne Robert, a new member of the ABA and the first woman to join its patent

²²⁵ *Pecheur Lozenge Co. v. National Candy Co.*, 315 U.S. 666, 667 (1942) ("The only cause of action that this record could possibly support is for unfair competition and common law 'trademark infringement,' to which local law applies"). See generally S. Zlinkoff, "Erie v. Tompkins: In Relation to the Law of Trade-Marks and Unfair Competition" (1942) 42 Colum. L. Rev. 955.

²²⁶ See, e.g., *Gum, Inc. v. Gumakers of America*, 136 F.2d 957 (3d Cir. 1943); *The Best Foods v. General Mills*, 59 F. Supp. 201 (D. Del. 1945); *Skinner Mfg. Co. v. General Foods Sales Co.*, 52 F. Supp. 432 (D. Neb. 1943), *aff'd* 143 F.2d 895 (8th Cir. 1945); *Coca Cola v. Busch*, 44 F. Supp. 405 (E.D. Penna. 1942); McKenna, "Faux Federalism", 302.

²²⁷ See, e.g., *Dwinneil-Wright Co. v. National Fruit Prod. Co.*, 140 F. 2d 618 (1st Cir. 1944) ("The court below concluded that on the question of infringement of registered trademarks the applicable law is federal statutory law, and where that is ambiguous or silent, federal case law, and we agree"); *Philco Corp. v. Phillips Mfg.*, 133 F.2d 663 (7th Cir. 1943); McKenna, "Faux Federalism", 296–299.

²²⁸ Zlinkoff, "Erie", 225.

²²⁹ "Drug Trust's Tie With Reich is Cut", New York Times, 6 September 1941, p. 1, 8; *United States v. Bayer Co.*, 135 F. Supp. 65 (S.D.N.Y. 1955).

section,²³⁰ took over Rogers's duties as the ABA section's custodian of the trademark bill and the designated explainer of its provisions.²³¹ By then, however, the contours of the bill were set, and only small changes were left to be made.

It is worth attending to the fact that before the *Erie* decision came down, Rogers's bill spent almost all of its ink on procedural issues related to registration and litigation and did not speak to some crucial issues of substantive trademark law: how, for example, a trademark owner came to own trademark rights in a mark, or what the scope of those rights might be. Indeed, most of the language of the bills drafted to be introduced by Fritz Lanham came directly from bills previously introduced by Albert Vestal, when the legislation was not supposed to be substantive at all. After the *Erie* decision was announced, Edward Rogers did not go back and rethink the language, structure, or approach of his bill.

In the 21st century, we imagine that once Congress adopted what was pitched as a comprehensive statute, the codified law superseded the common law and any common law doctrine that wasn't expressly incorporated in the statutory text simply ceased to operate. The members of the mid-20th century trademark bar would

²³⁰ Daphne Hammond McConnell Robert Leeds was the first woman member of the ABA Patent section and went on to become the first woman Assistant Commissioner of Patents under President Eisenhower. While she was Assistant Commissioner, Leeds invented the Trademark Trial and Appeal Board. She claimed to have earned her law degree from the University of Illinois, but the University has no record of her ever having attended. Born Daphne Hammond in Martinsville Illinois, she graduated from Martinsville High School in 1924 and attended Eastern Illinois State Teachers College. She left Illinois before graduation to move to Arizona for unspecified medical reasons, and then settled in Orlando, Florida, where she taught science at Memorial Junior High School. She married Robert Lee McConnell in 1930, but the marriage proved to be short lived. By 1932, she had moved to Atlanta and separated from her husband. She taught, first in the S.N. Inman School and then in the Morningside School. She married Roy Robert, and started working as a secretary for J. Ira Harrelson, an Atlanta lawyer who was also the school board president. In 1937, she sat for and passed the Georgia Bar exam. She went to work for Coca Cola, apparently initially as a stenographer, but eventually as a lawyer in the trademark department of the General Counsel's Office. By 1940, she and Robert had divorced, and she went by "Miss Robert" until her remarriage, in 1947, to hotel magnate Robert Leeds. Robert authored *The New Trademark Manual*, which explained the new Act for the benefit of the trademark bar. She also claimed to be responsible for removing the hyphen from the official spelling of the term "Trade-Mark." See C. Peet, "Marks of a Lady", New York Herald Tribune, 6 November 1955, p. 25. Professor Glynn Lunney credits (or blames) Commissioner Leeds for allowing the registration of trade dress on the Principal Register. See G. S. Lunney, Jr., "The Trade Dress Emperor's New Clothes: Why Trade Dress Does Not Belong on the Principal Register" (2000) 51 Hastings Law Journal 1131, 1155–1162. Leeds also served briefly as the Reporter for the trademark and unfair competition sections of the Second Restatement of Torts. See *infra* note 240.

²³¹ See, e.g., *Trade-Marks: Hearings on H.R. 82 Before a Subcomm. of the House Patent Comm.*, 78th Cong. 23–26, 109–115 (1944) (testimony of Daphne Robert, ABA). Did Rogers continue to monitor the progress of the legislation behind the scenes, or contribute unofficial suggestions as it moved toward enactment? It seems likely that he would have, but I have found no mention of it in any of the sources I've found.

not have recognized that picture. Throughout the congressional hearings, witnesses insisted that the common law would continue to control the results in cases except where the new statute expressly or implicitly abrogated settled common law doctrine. That, they explained, was the reason everyone was fighting over the precise wording of various provisions.²³² The common law of unfair competition was a durable thing. It had governed trademark law since before any of that generation's trademark lawyers were born, and most trademark lawyers could no more imagine a world without it than imagine the sudden suspension of the law of gravity.

After a flurry of last-minute compromises to assuage the antitrust concerns of the federal Department of Justice,²³³ Congress finally enacted the Lanham Act in 1946.²³⁴

VI.

Identification means individual responsibility. There can be none without it. Trade-marks are a handy device to indicate where goods come from. If people cannot tell where goods come from, they cannot fix responsibility for their quality or kind. People cannot buy again the goods they like or avoid the ones they do not like, unless they can tell them apart. It is this ability to identify, distinguish, and discriminate that makes freedom of choice possible.

— Edward S. Rogers (1946)²³⁵

Edward Sidney Rogers died at his home in Greenwich Connecticut on May 22, 1949. He was 74 years old.²³⁶ Shortly before his death, he argued that if the law of unfair competition needed a federal statutory hook, the federal courts could find one in subsections h and i of section 44 of the Lanham Act.²³⁷ The Court of Appeals for

²³² See, e.g., *Trade-Marks: Hearing on S. 895 Before a Subcomm. Of the Senate Patents Comm.*, 77th Cong. 12–18 (1942) (testimony of W.H. Martin, trademark lawyer and ABA section member); *1925 Joint Hearings*, 57 (testimony of Arthur C Fraser, NY Patent Law Assn.: “In our work on this bill in collaboration with American Bar Association, our committee was extremely solicitous that the bill should be put into such a form as would leave no doubt that all common law trademark rights, remedies, and defenses should be preserved”).

²³³ See W. J. Derenberg, “The Lanham Trade-Mark Act and Its Impact on the Drug Industry” (1947) 29 *Journal of the Patent Office Society* 469, 473–479.

²³⁴ Pub. L. 79-489 (1946), 60 Stat. 427 (codified as amended at 15 USC §§ 1052–1141n). See Robert, *The New Trade-Mark Manual*, at 235–237.

²³⁵ E. S. Rogers, “Introduction” to Robert, *New Trade-Mark Manual*, xii.

²³⁶ “E.S. Rogers, Expert on Patent Law, 74”, *New York Times*, 23 May 1949, p. 23.

²³⁷ E. S. Rogers, “New Concepts of Unfair Competition Under the Lanham Act” (1948) 38 *Trademark Reporter* 259; see Farley, “Lost Unfair Competition Law”. Section 44, embodied Title IX of the Act, entitled INTERNATIONAL CONVENTIONS. Subsections h and i provided:

the Ninth Circuit initially adopted this view, but other courts of appeals found the Ninth Circuit's analysis unpersuasive.²³⁸ Federal courts continued to decide common law unfair competition cases, purporting to apply their interpretations of what state courts would decide.²³⁹ The putative state law of unfair competition as divined by federal judges grew more robust and expansive,²⁴⁰ until, in 1964, the Supreme Court held that state unfair competition law was constrained by federal preemption.²⁴¹ Justice Black's broadly

(h) Any person designated in paragraph (b) of this section as entitled to the benefits and subject to the provisions of this Act shall be entitled to effective protection against unfair competition, and the remedies provided herein for infringement of marks shall be available so far as they may be appropriate in repressing acts of unfair competition.

(i) Citizens or residents of the United States shall have the same benefits as are granted by this section to persons described in paragraph (b) hereof.

Rogers's testimony in the 1939 House Hearings supports an inference that he expected that these provisions would vest federal courts with jurisdiction to hear unfair competition claims brought by foreign or domestic suitors, and that the members of Congress in attendance found the idea unobjectionable. *See* 1939 House Hearings, 166–167 (testimony of Edward Rogers).

²³⁸ The 9th Circuit initially held that section 44 vested federal courts with jurisdiction over unfair competition claims brought by both foreign and domestic suitors, regardless of diversity of citizenship. *See Stauffer v. Exley*, 184 F.2d 962, 967 (9th Cir. 1950). Other circuits, though, declined to follow the 9th Circuit's lead. *See, e.g., American Auto Ass'n v. Spiegel*, 205 F.2d 771, 775 (2d Cir. 1953); *L'Aiglon Apparel, Inc. v. Lana Lobell, Inc.*, 214 F.2d 649, 651–654 (3d Cir. 1954). *See generally* W. J. Derenberg, "Federal Unfair Competition Law at the End of the First Decade of the Lanham Act: Prologue or Epilogue" (1957) 32 New York University Law Review 1029, 1031; S. K. Sandeen, "The Erie/Sears/Compco Squeeze: Erie's Effects on Unfair Competition and Trade Secret Law" (2018) 52 Akron Law Review 423, 437–438.

²³⁹ *See generally* Note, "Unfair Competition and the Doctrine of Functionality" (1964) 64 Colum. L. Rev. 544.

²⁴⁰ *See, e.g., Audio Fidelity, Inc. v. High Fidelity Recordings, Inc.*, 283 F.2d 551 (9th Cir. 1960); *Tas-T-Nut Co. v. Variety Nut & Date Co.*, 245 F.2d 3 (6th Cir. 1957); *Mastercrafters Clock and Radio Co. v. Vacheron & Constantin Le Coultre Watches, Inc.*, 221 F.2d 464 (2d Cir. 1955). *See generally* E. H. Pollack, "Unfair Trading by Product Simulation: Rule or Rankle" (1962) 23 Ohio State Law Journal 74 (1962); J. M. Treece, "Copying Methods of Product Differentiation: Fair or Unfair Competition" (1964) 54 Trademark Reporter 12; Note, "The Choice of Law in Multistate Unfair Competition: A Legal Industrial Enigma" (1947) 60 Harv. L. Rev. 1315, 1315.

When the American Law Institute began work on the Second Restatement of Torts, it planned to include the common law of trademarks and unfair competition in the revision. The ALI appointed Daphne Robert Leeds, who had recently resigned as Assistant Commissioner of Patents, as the Reporter for that part of the Restatement, but did not invite her to become a member of the ALI. At the 1963 Annual Meeting, the members of the ALI approved Leeds's drafts of sections 711 through 756. *See* Restatement 2d of Torts tentative Draft 8 (1963); Thursday Morning Session, May 23, 1963, 40 A.L.I. Proc. 138 (1963); Friday Afternoon Session, May 24, 1963, 40 ALI Proc. 321 (1963). The ALI Council later voted to remove the topic from the Second Restatement of Torts. *See* Restatement 2d Torts vii–viii (1979).

²⁴¹ *Sears, Roebuck & Co. v. Stiffel*, 376 US 225 (1964); *Compco v. Day-Brite Lighting*, 376 US 234 (1964). *See generally* D. R. Leeds, M. Handler, W. J. Derenberg, R. S. Brown and P. Bender, "Symposium: Product Simulation: A Right or a Wrong" (1964) 64 Colum. L. Rev. 1178 (1964); Sandeen, 238, 440.

worded decisions appeared to mow down much of the once-federal, now state unfair competition law.²⁴² That sent lawyers and federal judges scurrying to section 43(a) of the Lanham Act,²⁴³ which soon grew to provide a capacious and well-appointed home for unfair competition claims of all sorts.²⁴⁴ In 1992, in a case involving Tex-Mex restaurants, the Supreme Court held that section 43(a) of the Lanham Act protects unregistered marks under much the same terms and conditions as the statute protects registered marks, thus restoring unfair competition to the same federal sovereign as trademark law.²⁴⁵

Following that decision, the federal courts saw an explosion of cases brought under section 43(a) claiming infringement of unregistered product features.²⁴⁶ Courts responded by affording more expansive protection under 43(a) to unregistered marks than had previously been available to registered marks.²⁴⁷ The robust protection available for unregistered marks has given potential litigants ample strategic reason to skip the bother of registration.

²⁴² See, e.g., *Spangler Candy v. Crystal Pure Candy Co.*, 353 F.2d 641, 645–646 (7th Cir. 1965); Sandeen, 238, 440–441.

²⁴³ See, e.g., W. J. Derenberg, “The Twentieth Year of Administration of the Lanham Trademark Act of 1946: Section 43(a) of the Lanham Act” (1967) 57 Trademark Reporter 729; W. J. Derenberg, “The Twenty-Third Year of Administration of the Lanham Trademark Act of 1946: Section 43(a) of the Lanham Act” (1970) 60 Trademark Reporter 459; Annual Review Committee, “The Thirtieth Year of Administration of the Lanham Trademark Act of 1946: Section 43(a) of the Lanham Act” (1977) 67 Trademark Reporter 534; D. M. Springs and T. Arnold, “The Law of Unfair Competition: The Impact of Lanham Act Section 43(a)” (1967) 49 Journal of the Patent Office Society 348.

²⁴⁴ See, e.g., McCarthy, “The Sleeping Giant”; McKenna, “Property and Equity”, 124–133.

²⁴⁵ *Two Pesos v. Taco Cabana*, 505 U.S. 763 (1992) (holding that unregistered but inherently distinctive trade dress is protectable as a mark under section 43(a) of the Lanham Act without a showing of secondary meaning). Taco Cabana had opened a chain of Tex-Mex restaurants in San Antonio. Two Pesos opened Tex-Mex restaurants in Houston, 200 miles away, that allegedly copied plaintiff’s restaurants’ distinctive trade dress. The jury was instructed that Two Pesos infringed Taco Cabana’s trade dress if there were a likelihood that ordinary consumers would be confused and if Taco Cabana’s trade dress had secondary meaning in the Texas market at the time that Two Pesos opened its restaurants, or if the Taco Cabana Trade dress were inherently distinctive. The jury found that Taco Cabana’s trade dress did not have secondary meaning, but that it was inherently distinctive, and that there was a likelihood of confusion. *Ibid.*, 765–766. The trial court entered an injunction and awarded damages; the Fifth Circuit affirmed. *Ibid.* Even though Taco Cabana was the junior user of the trade dress in the Houston area and had not secured nationwide priority by registering its trade dress as a service mark on the principal register, it was able to recover for infringement against the senior user of the trade dress in the Houston market by persuading the jury that its trade dress was inherently distinctive. The Supreme Court held that if an unregistered mark would be eligible for registration, it was entitled to protection under section 43(a) without a showing of secondary meaning. *Ibid.*, 773–775.

²⁴⁶ G. B. Dinwoodie, “Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress” (1997) 75 N.C. L. Rev. 471, 478–479.

²⁴⁷ R. C. Denicola, “Freedom to Copy” (1999) 108 Yale L.J. 1661, 1670–1673; M. A. Lemley, “The Modern Lanham Act and the Death of Common Sense” (1999) 108 Yale L.J. 1687, 1700–1701.

Unregistered marks, of course, do not receive the benefits of incontestability. Did incontestability become a powerful inducement for registration, as Rogers had planned? Courts found incontestability confusing.²⁴⁸ They continue to find it bewildering, even after two Supreme Court attempts to clarify the law.²⁴⁹ Trademark owners find it confusing. The Patent and Trademark Office appears not to take it very seriously.²⁵⁰ Between the various enumerated defenses and exceptions to incontestability included in the Lanham Act,²⁵¹ and the need for the owners of all registered marks, even incontestable ones, to prove likelihood of confusion to recover for trademark infringement,²⁵² the advantages provided by incontestability turn out to be useful for marks that are not, in fact, distinctive of the products they identify,²⁵³ and not so useful for anyone else. It seems unlikely, then, that incontestability has served as the strong incentive to encourage registration that Edward Rogers had hoped.²⁵⁴

VII. CONCLUSION

“Unfair competition” is a term that is pretty well understood. It is a compendious term. I recall very well, if I may digress a little, a student of mine, after listening stoically to a course of lectures on unfair competition, came up to ask me a question afterwards. I was wondering what he was getting out of this course, and I asked him what he understood by “unfair competition”. He said, “Well, it seems to me it is the efforts of the court to keep people from playing dirty tricks on each other”. And really you might look through the books a long while and not find a better definition than that. It is conduct which artificially interferes with the normal course of trade by misrepresentation, by disparagement, by trade bribery, and all that sort of stuff.

— Edward S. Rogers (1939)²⁵⁵

²⁴⁸ See, e.g., *Union Carbide v. Ever-Ready, Inc.*, 531 F.2d 366, 373–377 (7th Cir. 1975) (collecting cases). See generally R. Tushnet, “Fixing Incontestability: The Next Frontier” (2017) 23 Boston University Journal of Science and Technology Law 434, 440–449.

²⁴⁹ *Park N Fly v. Dollar Park and Fly*, 469 U.S. 189 (1985); *K.P. Permanent Make-Up v. Lasting Impressions*, 543 U.S. 111 (2004).

²⁵⁰ Tushnet, “Fixing Incontestability”, 449–450.

²⁵¹ 15 U.S.C. § 1115(b).

²⁵² See, e.g., *K. P. Permanent Makeup*, 543 US at 117–118.

²⁵³ Tushnet, “Fixing Incontestability”, 450.

²⁵⁴ In a world in which search engines are ubiquitous, the need for a comprehensive federal registry of trademarks in use seems less pressing. Cf. L. Larimore Ouellette, “The Google Shortcut to Trademark Law” (2014) 102 Cal. L. Rev. 351.

²⁵⁵ 1939 House Hearings, 166 (testimony of Edward S. Rogers).

Edward Rogers began the effort that culminated in the enactment of the Lanham Act with two primary goals. He hoped to achieve universal registration of marks and he hoped to preserve the generous legal protection offered by the common law of trademarks and unfair competition. The two goals were never compatible. An effective system to require or encourage registration of trademarks would necessarily undermine the common law protection afforded to unregistered marks; extensive legal protection for unregistered marks and other indicia of source would necessarily diminish the value of and need for registration. Over the long term, moreover, the common law of unfair competition proved itself to be well-nigh indestructible, surviving multiple apparent death blows from the U.S. Supreme Court. It may be that the impulse to seek recourse and to grant relief for a wide range of competitive conduct that seems abusive is unshelchable. If Edward Rogers had not been inspired by his clients' experience with the Pure Food and Drug Act to insert the language that became section 43(a) into his draft legislation, vigorous protection against unfair competition would probably have attached itself to a different clause of the statute.²⁵⁶

Congress has revisited and amended the Lanham Act 11 times in the years since 1946, but the common law of trademarks and unfair competition remains deeply embedded in the law emanating from the statute. Common law rules like the affixation-based definition of use on goods remain in the statutory text and still matter to courts.²⁵⁷ Key doctrines, like the scope of actionable likelihood of confusion, the nature of distinctiveness, and the scope of defenses, remain largely judge-made.²⁵⁸ Judges apparently feel

²⁵⁶ Christine Farley has argued that Rogers intended for § 44 of the Lanham Act to provide even broader protection against unfair competition than that now recognized by courts under § 43(a), and that Congress probably shared Rogers's intent. See Farley, "Lost Unfair Competition Law", 794–796.

²⁵⁷ See 15 USC § 1147:

Use in commerce. The term "use in commerce" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce —

(1) on goods when —

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce. . .

See, e.g., *In re Siny*, 920 F.3d 1331 (Fed. Cir. 2019); *In re Yarnell Ice Cream, LLC*, 2019 U.S.P.Q. 2d (BNA) 265039 (TTAB 2019); see generally Barrett, "Finding Trademark Use".

²⁵⁸ See, e.g., B. Beebe, "An Empirical Study of the Courts' Multifactor Tests for Trademark Infringement" (2006) 94 Cal. L. Rev. 1581; S. Dogan and M. Lemley, "Parody as Brand" (2013) 47 University of California, Davis Law Review 473; J. Sheff, "Veblen Brands" (2012) 96 Minnesota Law Review 769.

that the Lanham Act authorizes them to exercise wide discretion to punish dirty tricks or other unfairness wherever they believe that they see them, and they behave accordingly.²⁵⁹

Many scholars, myself included, have criticized judges for taking an overbroad view of the sorts of behavior that the Lanham Act invites them to enjoin.²⁶⁰ The expansive scope of unfair competition liability under the Lanham Act may reflect stupid public policy, but it was very much intended by the statute's principal drafter and the other members of the trademark bar who eventually agreed to support the legislation.²⁶¹

What do we learn from this story, beyond the answers to several small mysteries and a pocket full of tokens to bring to the next trademark nerd trivia game? For me, the most significant payoff has been the realization that the drafters, supporters, and opponents of the Lanham Act assumed that they were making a statute to accompany the common law of trademarks and unfair competition rather than to codify or replace it. Even after the Supreme Court's decision in *Erie*, they believed they were crafting procedural and substantive measures that would supplement enduring common law rules. And they turned out to be right about that. Through the twists and turns of *Erie* and *Sears/Compco*, the common law has — one way or the other — remained at the center of trademark law. In that regard, Edward Rogers realized at least one of his goals.

²⁵⁹ See, e.g., *Anheuser Busch v. Balducci Publications*, 28 F.3d 769 (8th Cir. 1994); *White v. Samsung Electronics America, Inc.*, 989 F.2d 1512 (9th Cir. 1992); *Malletier v. Hyundai*, 2012 LEXIS 42795 (S.D.N.Y. 2012); *Best Cellars v. Grape Finds at Dupont, Inc.*, 90 F. Supp. 431 (S.D.N.Y. 2000); *Toy Manufacturers of America, Inc. v. Helmsley-Spear, Inc.*, 960 F. Supp. 673 (S.D.N.Y. 1997).

²⁶⁰ See, e.g., R. G. Bone, "Taking the Confusion Out of Likelihood of Confusion: Toward a More Sensible Approach to Trademark Infringement" (2012) 106 *Northwestern University Law Review* 1307, 1336–1347; S. L. Dogan, "Principled Standards vs. Boundless Discretion: A Tale of Two Approaches to Intermediary Liability Online" (2014) 37 *Columbia Journal of Law and the Arts* 502; M. A. Lemley and M. McKenna, "Irrelevant Confusion" (2010) 62 *Stan. L. Rev.* 413, 438–443; J. Litman, "Breakfast with Batman: The Public Interest in the Advertising Age" (1999) 108 *Yale L.J.* 1717, 1721–1731; W. McGeveran & M. P. McKenna, "Confusion Isn't Everything" (2013) 89 *Notre Dame Law Review* 253.

²⁶¹ Accord McKenna, "Property and Equity".

COMMENTARY

WHY AIDED AWARENESS IS THE PROPER PRIMARY METHOD FOR ASSESSING FAME FOR DILUTION CLAIMS*

*By Hal Poret***

I. INTRODUCTION

Federal trademark law provides for causes of action for “dilution by blurring” where a challenged junior mark is likely to give rise to an association with a senior mark that impairs the distinctiveness of the senior mark.¹ In order to qualify for protection under federal dilution law, a senior mark must be “famous,” with “fame” defined as “widely recognized by the general consuming public. . . .”² As this indicates, the statute defines “fame” with respect to the extent of consumer “recognition” of a mark. Fame is often evidenced by consumer surveys, of which there are two main forms. Consumer surveys can measure *unaided* awareness levels of a mark (the extent to which consumers *recall* a mark from memory when prompted with a product/service category) or *aided* awareness levels of a mark (the extent to which consumers *recognize* a mark when exposed to it). The Trademark Trial and Appeal Board (“TTAB”) has expressed the view that a litigant may not rely heavily on *aided* awareness survey evidence, and that *unaided* awareness should be the primary standard for assessing fame,³ most recently rejecting survey data showing a 91.3% rate of aided awareness as a sufficient indicator of a mark’s fame in the absence of *unaided* awareness data.⁴ The TTAB’s insistence on *unaided* awareness data (showing consumer recall) and reluctance to give substantial weight to *aided*

* This commentary should be cited as Hal Poret, Commentary: *Why Aided Awareness Is the Proper Primary Method for Assessing Fame for Dilution Claims*, 115 Trademark Rep. 764 (2025).

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¹ Trademark Dilution Revision Act of 2006 (“TDRA”), 15 U.S.C. § 1125(c)(2)(B) (2006).

² *Id.* § 1125(c)(2)(A).

³ *Promark Brands Inc. v. GFA Brands, Inc.*, Opp. No. 91194974, 2015 WL 1646447, at *13 (T.T.A.B. Mar. 27, 2015) [hereinafter *Promark Brands*].

⁴ *Pumpnickel Assocs., LLC v. Ningbo Panera Lighting Co.*, Opposition No. 91272857, 2025 WL 985438, at *21–23 (T.T.A.B. Mar. 18, 2025) [hereinafter *Pumpnickel*] (non-precedential). This author performed the aided awareness fame survey on behalf of the party claiming a famous mark in *Pumpnickel*.

awareness data (showing consumer recognition) directly conflicts with the statutory definition of fame and contradicts the accepted literature on the topic of fame surveys from leading survey research authorities. The TTAB's position also fails to appreciate or account for critical aspects of unaided awareness methodologies that frequently render unaided awareness levels arbitrary and subjective (or sometimes even inapplicable entirely) as a primary barometer of fame, even if probative in some instances as a secondary measurement.

Part II of this article describes the unaided awareness and aided awareness survey methodologies and the TTAB's expressed position regarding these methodologies. Part III discusses how the TTAB's position conflicts with the statutory fame definition and the leading literature regarding surveys measuring fame. Part IV details additional aspects of unaided awareness methodologies that make unaided awareness inappropriate as the primary or required standard for fame.

II. THE TTAB'S POSITION ON UNAIDED AND AIDED AWARENESS

Unaided awareness and aided awareness are two commonly examined concepts in the field of market research.⁵ Unaided awareness is typically measured by prompting survey respondents with a product or service category and asking them to identify what products or services come to mind.⁶ Aided awareness, on the other hand, is typically measured by presenting respondents with a list or array of marks/brands and asking respondents to identify the ones of which they are aware.⁷ Accordingly, unaided awareness is well accepted to assess *recall* of a brand, that is, whether that brand comes to mind from memory without exposure to the brand, and aided awareness is well accepted to assess *recognition* of a brand, that is, whether consumers who are exposed to a brand recognize it as one they were previously aware of.⁸

⁵ Ipsos Encyclopedia—Awareness (May 20, 2024), <https://www.ipsos.com/en/ipsos-encyclopedia-awareness> (stating spontaneous or “unaided” awareness is distinct from a measurement of prompted or “aided” awareness).

⁶ *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, Opp. No. 91177415, 2010 WL 595586, at *14 n.57 (T.T.A.B. Feb. 17, 2010).

⁷ *Citigroup*, 2010 WL 595586, at *14 n.64. *See also* Shari Seidman Diamond, *Surveys in Dilution Cases*, in *Trademark and Deceptive Advertising Surveys: Law, Science, and Design*, 165 (Shari Seidman Diamond & Jerre B. Swann, eds., 2d. ed. 2022) [hereinafter “*Trademark and Deceptive Advertising Surveys*”] (noting fame can be tested for by providing a list of brands and asking which brands the respondent has heard of).

⁸ For some common market research cites discussing these concepts, *see* Francesca Nicasio, *Share of mind metrics: Aided and unaided brand awareness*, Tracksuit (July 4, 2024), <https://www.gotracksuit.com/blog/posts/aided-vs-unaided-brand-awareness> (“Aided awareness is when consumers recognize your brand after being prompted with a specific cue, while unaided awareness is when consumers recall your brand without any

Litigants in trademark cases involving dilution claims have frequently conducted aided awareness surveys to assess the level of fame of the senior mark.⁹ The TTAB, however, has on several occasions held that litigants should not rely on aided awareness survey data to establish fame, insisting on unaided awareness data. In a 2005 TTAB decision, the TTAB held that unaided awareness is the most significant measurement when it comes to assessing fame, and that parties “should not be permitted to so heavily rely on aided awareness . . . to show fame.”¹⁰ Later, in *Promark Brands*, the TTAB found that a survey assessing aided awareness levels of frozen meal products lacked significant evidentiary value on the question of fame, going as far as to say: “In general, the Board has discouraged heavy reliance on aided awareness to prove fame.”¹¹

More recently, in *Pumpernickel*, the board failed to give weight to a survey assessing the fame of a mark because the survey “tested ‘aided’ rather than ‘unaided’ awareness” for the mark at issue.¹² The TTAB cited several decisions in which unaided awareness survey data had been submitted to prove the fame of a mark, ultimately taking the position that “the Board has required a sufficiently high level of unaided awareness, either alone or coupled with aided awareness, to show dilution-level fame of a mark.”¹³

prompts.”); *The ultimate guide to brand awareness*, Qualtrics BrandXM, <https://www.qualtrics.com/experience-management/brand/what-is-brand-awareness/> (“Brand recognition is another way of saying ‘aided’ brand awareness. . . . Brand recall is another way of saying ‘unaided’ brand awareness. . . .”) (last visited June 16, 2025); *Unaided vs aided brand awareness survey questions: What do they tell you?*, SurveyMonkey, <https://www.surveymonkey.com/mp/unaided-vs-aided-brand-awareness-survey-questions/> (defining unaided awareness as “brand recall” and aided awareness as “brand recognition”) (last visited June 16, 2025).

⁹ Matthew G. Ezell & AnnaBelle Sartore, *Survey Percentages in Lanham Act Matters*, [hereinafter *Survey Percentages*] in *Trademark and Deceptive Advertising Surveys* 330–32 (identifying various cases where aided awareness surveys were conducted).

¹⁰ *Carefirst of Md., Inc. v. Firsthealth of the Carolinas, Inc.*, Opp. No. 91116355, 2005 WL 2451671, at *17 (T.T.A.B. Sept. 20, 2005), *aff’d*, 479 F.3d 825 (Fed. Cir. 2007)).

¹¹ *Promark Brands*, 2015 WL 1646447, at *13. The TTAB decision in *Promark Brands* states that the survey universe consisted of “individuals who had purchased a frozen meal from the frozen food section of a supermarket in the previous 30 days.” *Id.* Since the standard for fame is wide recognition among the “general consuming public,” 15 U.S.C. § 1125(c)(2)(A), limiting the survey universe to those who had recently purchased the type of product at issue could have been an independent flaw that rendered the results unreliable for proving fame among the general public.

¹² *Pumpernickel*, 2025 WL 985438, at *21. In its decision, the TTAB indicated that this author had performed other fame surveys that measured both unaided and aided awareness levels. *Id.* at *22. In particular, the TTAB cited a decision in which this author conducted a survey showing that the VAGISIL mark had a 38.7% unaided awareness level and 90% aided awareness level. *Id.* (citing *Combe Inc. v. Marke Enters., LLC*, Opp. No. 91214779, 2021 WL 1263059, at *15 (T.T.A.B. Mar. 31, 2021)).

¹³ *Id.* at *23 (citing *7-Eleven, Inc. v. Wechsler*, Opp. No. 91117739, 2007 WL 1431084, at *14 (T.T.A.B. May 15, 2007) [hereinafter *Wechsler*] (finding that 73% unaided awareness of the opposer’s BIG GULP mark among all consumers showed that the mark was famous); *Nike, Inc. v. Maher*, Opp. No. 91188789, 2011 WL 3828723, at *11 (T.T.A.B.

III. THE TTAB'S INSISTENCE ON UNAIDED AWARENESS DATA CONFLICTS WITH FEDERAL LAW AND ACCEPTED LITERATURE

The Trademark Dilution Revision Act (“TDRA”) explicitly defines “fame” in terms of a mark being widely *recognized*.¹⁴ As detailed above, *aided* awareness is well understood to be the survey research tool that measures *recognition* of a brand or mark, whereas unaided awareness measures *recall*. The equivalency of aided awareness and “recognition” is also consistent with the ordinary English definition of the word “recognition.” The act of recognition, by definition, involves the reaction one has when exposed to a specific stimulus—that is, whether one perceives that stimulus as something of which they were previously aware.¹⁵

The TDRA further emphasizes *recognition* in defining one of the factors relevant to the determination of fame as the “extent of actual recognition of the mark.”¹⁶ Consumer surveys are a primary way in which “actual recognition” is measured. In short, the federal statute explicitly invites evidence measuring the extent of recognition, which is what aided awareness surveys measure.

While unaided awareness surveys are useful in certain scenarios and can supplement aided awareness data,¹⁷ unaided awareness questions do *not* measure the extent of *recognition* of a mark. This is necessarily the case, as unaided awareness tells us only the percentage of respondents for whom a mark comes to mind based on recall, prompted by nothing other than the category. Unaided awareness data tells us nothing about whether all other respondents who fail to mention a mark on their own are *aware of* and *recognize* the mark. As an illustrative example of this, we can consider survey research data I published in a 2019 TMR article, *An Empirical Assessment of the Eveready Survey’s Ability to Detect Significant Confusion in Cases of Senior Marks That Are Not Top-*

Aug. 9, 2011) (stating that unaided awareness surveys showed broad recognition of the JUST DO IT mark)).

¹⁴ 15 U.S.C. § 1125(c)(2)(A).

¹⁵ *Recognize Definition*, Merriam-Webster Dictionary, <https://www.merriam-webster.com/dictionary/recognize> (defining “recognize” as “to perceive to be something or someone previously known” and providing the example “recognized the word”).

¹⁶ 15 U.S.C. § 1125(c)(2)(A)(iii).

¹⁷ A *high* unaided awareness rate can be sufficient on its own to establish fame. For instance, if respondents are asked to name social networking or social media services and a sufficiently high percentage name FACEBOOK, this would prove fame and make it unnecessary to examine aided awareness data to confirm the conclusion that FACEBOOK is a famous mark. The *failure* to achieve high unaided awareness levels, however, may indicate nothing about the level of actual consumer recognition of a mark.

of-Mind.¹⁸ *Empirical Assessment* discussed the results of survey research this author conducted concerning awareness levels of various brands. In an unaided awareness question asking respondents to identify breakfast cereals, only 13.0% of respondents identified RICE KRISPIES.¹⁹ In the follow-up aided awareness question, 96.3% of respondents answered that they are aware of the RICE KRISPIES mark/brand.²⁰ As this example demonstrates, the 13.0% unaided awareness level for RICE KRISPIES simply does not measure the extent of recognition of the mark. In fact, the unaided awareness percentage (13.0%) is at the opposite end of the spectrum from the actual recognition level (near universal recognition) and would be misleading if portrayed as the mark's recognition level.

Consistent with the plain language of the TDRA equating fame with recognition, the leading literature on the topic of fame surveys observes that *aided awareness* surveys are the proper primary standard for measuring fame because aided awareness surveys measure recognition. In addressing "fame surveys" in her chapter on surveys in dilution cases, Dr. Shari Seidman Diamond (author of the *Reference Guide on Survey Research* and co-editor of the *Trademark and Deceptive Advertising Surveys* treatise) explains why the statutory language calling for "recognition" of the mark to prove fame comports with a measurement of aided awareness (recognition) rather than unaided awareness (recall):

Note that the statutory language explicitly calls for recognition, rather than recall. The distinction is important, both because we are able to recognize more than we can recall and because the distinction between recognition and recall should guide the nature of an appropriate survey design. A typical recognition survey for assessing fame would show respondents a series of brand names in a so-called aided test (i.e., which of the following do you recognize?), while a typical recall survey would ask respondents to name (i.e., recall) the brands they can think of in a product category—an unaided test. Thus, the recognition survey enables a respondent to show familiarity with a brand name based on recognition, without requiring the respondent to recall the name.²¹

¹⁸ Hal Poret, *An Empirical Assessment of the Eveready Survey's Ability to Detect Significant Confusion in Cases of Senior Marks That Are Not Top-of-Mind*, 109 Trademark Rep. 935 (2019) [hereinafter *Empirical Assessment*].

¹⁹ Likewise, less than 20% identified FROSTED FLAKES, RAISIN BRAN, FROOT LOOPS, and other popular brands. *Empirical Assessment* at 947–48.

²⁰ In this author's follow-up aided awareness question, the results of which were not published in *Empirical Assessment*, 289 of 300 respondents answered that they are aware of RICE KRISPIES.

²¹ *Surveys in Dilution Cases*, at 164–65 (internal citations omitted).

Jerre B. Swann, Diamond's co-editor of the *Trademark and Deceptive Advertising Surveys* treatise, states the same in his own chapter on dilution surveys: "I agree totally with [Dr. Diamond's] remarks both as to substance and format: fame studies should be essentially aided awareness undertakings. . . ." ²²

As this makes clear, both Diamond and Swann explicitly identify *aided awareness* as the proper format for assessing recognition for fame purposes and reject a requirement of measuring *unaided awareness* (recall).

The TTAB's view of aided awareness data as unworthy of substantial weight also neglects to account for two key features of aided awareness surveys. First, aided awareness fame surveys are conducted among the *general consuming public*, not the subset of consumers of the relevant product. For instance, consider the case of the VAGISIL mark. The fact that VAGISIL showed a high level of aided awareness is all the more impressive considering that *most* respondents in the survey were *not* even purchasers of the relevant type of product and, in fact, roughly half of the universe was male. Second, aided awareness fame surveys can include *controls* to account for any tendency of an aided question to lead respondents to falsely report recognition. For instance, the fame survey regarding VAGISIL asked respondents about a *fictional* mark to assess the level of noise (guessing or spurious claiming of recognition) and to ensure that there is no respondent or survey error causing an unreliably high result for a non-famous mark.

Accordingly, the TTAB's insistence on unaided awareness data and reluctance to give substantial weight to aided awareness data is in direct conflict with both federal law and the explicit guidance in the fame survey literature from leading authorities on survey research. ²³

IV. OTHER ASPECTS OF UNAIDED AWARENESS RENDER IT POORLY SUITED AS THE PRIMARY STANDARD FOR ASSESSING FAME FOR DILUTION PURPOSES

Unaided awareness can constitute useful evidence on the topic of fame in some instances. The TTAB's position on unaided versus aided awareness, however, also neglects to consider and account for several aspects of unaided awareness methodologies that make it inappropriate to require such data to establish fame, as there would be no way to have any objective standard for determining whether unaided awareness levels weigh in favor of or against fame.

²² Jerre B. Swann, *Swann's Response to Diamond Re Dilution Surveys*, in *Trademark and Deceptive Advertising Surveys*, 175.

²³ See generally *Surveys in Dilution Cases*, 165–66 (discussing aided awareness fame surveys and the VAGISIL survey results).

***A. Unaided Awareness Percentages Are
Dependent on the Size of the Product Category***

Unaided awareness surveys elicit mentions of brands that first come to mind when respondents are prompted with a category of products or services. Survey respondents can be reasonably expected to recall and mention only a limited number of brands in response to a survey question. Accordingly, the unaided awareness rate for a brand can be significantly dependent on the number of other brands in its category. As a basic statistical proposition, a mark that is the only mark (or one of a small number of marks) in a category is far more likely to be mentioned in an unaided awareness survey than a mark that is one of many in its category, regardless of the extent of actual recognition of the mark.

For instance, consider the example of the famous UBER mark. At the time the UBER mark became famous, it was likely the *only* national brand in its category. Even as of the time of this article, the UBER mark is one of only two widely available national services in its category. The unaided awareness rate for UBER is undoubtedly exceedingly high (approaching its aided awareness rate), as the UBER mark is nearly universally known and is one of the only options that could possibly come to mind for consumers who are asked about its category.

On the other hand, consider categories such as breakfast cereals or candies, which include hundreds, if not thousands, of brands. In *Empirical Assessment*, I discussed the results of an unaided awareness survey in which respondents were asked to list all brands of breakfast cereals that they had ever seen or heard of.²⁴ Due to the large size of the category, only *one* cereal brand was named by 20% or more of respondents (CHEERIOS at 40.3%).²⁵ RICE KRISPIES, a brand proven by the data to be almost universally recognized (96.3% aided awareness), was named by only 13.0% of respondents.²⁶

We can then compare, for example, reported unaided awareness levels for the following brands that differ substantially in proportion to the size of their category:

²⁴ *Empirical Assessment*, at 947.

²⁵ *Id.* Three house marks—KELLOGG (46.3%), POST (28.0%), and GENERAL MILLS (22.0%)—also had results of over 20%, but no other brands of individual cereals.

²⁶ The highest cereal brand other than CHEERIOS was FROSTED FLAKES at 18.7% unaided awareness. Other popular brands, such as APPLE JACKS and COCOA PUFFS, were named unaided by only 5.7% of respondents. *Id.* at 947–48.

CATEGORY	MARK	UNAIDED AWARENESS
Fountain drinks	BIG GULP	73.0% ²⁷
Vaginal care products	VAGISIL	38.7%
Breakfast cereals	RICE KRISPIES	13.0%

It is evident that the substantially disparate unaided results for these three marks do not reflect substantially differing levels of consumer recognition of these marks. Rather, they reflect the size of the relevant categories. BIG GULP is one of only a few nationally known brands for a specific store's fountain sodas, whereas VAGISIL is part of a category with a handful of competitive products and RICE KRISPIES is part of a category of hundreds of products. The range of results from 13.0% to 38.7% to 73.0% unaided awareness reflects a substantial degree of arbitrariness attributable not to the renown of the brand, but to the size and nature of the category. Such numbers make it easy to see how unaided awareness simply does not measure recognition.

Given that RICE KRISPIES was recognized by close to 100% of the general public, it would be unreasonable to conclude based on this data that RICE KRISPIES is less famous than BIG GULP or that it is not famous at all. One must wonder, however, how the TTAB would respond to an unaided awareness level of 13.0% for RICE KRISPIES. In citing a requirement of "sufficiently high" levels of unaided awareness, the TTAB mentions the 73% result for BIG GULP and a result for CITIBANK that grew from 68% at one point in time to over 90%.²⁸ Would the TTAB have viewed a 13.0% unaided awareness result for RICE KRISPIES as so low as to undermine fame, or would the TTAB have considered 13.0% to be "sufficiently high" given the context that the category is so large? Either way, it is clear why unaided awareness cannot reliably serve as an objective standard for assessing fame, when results for widely recognized brands can vary from a RICE KRISPIES (13.0%) to a BIG GULP (73.0%) merely based on the size/narrowness of the category. Aided awareness, on the other hand, is not sensitive to the size of the category in a manner that can render the results arbitrary, as the ability to *recognize* the mark RICE KRISPIES when shown the mark is not greatly diminished by the size of the category.

²⁷ *Wechsler*, 2007 WL 1431084, at *14 (mentioning 73% BIG GULP result).

²⁸ *Pumpnickel*, 2025 WL 985438, at *23.

***B. Unaided Awareness Percentages Are
Dependent on the Description of the Product Category***

Unaided awareness surveys elicit mentions of brands that are responses to a prompt depicting a specific category. Accordingly, the unaided awareness rate for any brand can be significantly dependent on the choice of how to describe the relevant category.

Consider the case of the PANERA mark, which was shown to be widely recognized by the general consuming public (91.3% aided awareness) in the survey in *Pumpernickel*.²⁹ In order to satisfy the TTAB's demand for unaided awareness data, the relevant category for PANERA would have needed to be identified in an unaided awareness question. Consider the following options for identifying the category:

- Restaurants
- Chain restaurants
- Fast-casual restaurants
- Fast-casual chain restaurants
- Fast-casual chain restaurants featuring sandwiches and salads.

The choice of how broadly or narrowly to define the category would have substantially impacted the result of an unaided question. Asking respondents to identify “restaurants” that came to mind would certainly produce the *lowest* unaided awareness result, as “restaurants” includes countless thousands of brands and many substantially different types of restaurants. Narrowing the category to “fast-casual chain restaurants featuring sandwiches and salads” would certainly produce the *highest* unaided awareness result, as a more detailed and focused description would be more likely to prompt recall of a restaurant type fitting that description. A description such as “fast-casual restaurants” would produce a result in the middle, as it would narrow down the world of restaurants to some degree, but would still include burger, pizza, and other different types of restaurants that would cause many respondents to recall and name different types of restaurants. The choice of how to identify the category from broad to narrow would heavily impact the unaided awareness results. Aided awareness, on the other hand, is not so dependent on the category description, as respondents who are aware of a mark such as PANERA would likely be able to recognize it given the broader “restaurant” context or a narrower description.³⁰

²⁹ *Id.* at *20–21.

³⁰ In fact, one of the benefits of the aided awareness format is that the survey can use a broader category descriptor. In the PANERA survey for the *Pumpernickel* case, the use of an aided awareness format allowed the survey to depict the relevant category as broadly as possible: “restaurants.” Had the survey started with an unaided awareness

We can also consider the results of an unaided awareness survey that this author conducted on behalf of the owner of a mark in the candy category.³¹ Three groups of respondents were asked an unaided awareness question, with each group receiving a different description of the relevant category, ranging from broad to narrow, with the following results:

CATEGORY DESCRIPTION	UNAIDED AWARENESS
Candy	12%
Chewy candy	31%
Fruit-flavored chewy candy	54%

As shown above, because “candy” is such a broad category with so many candidates, the brand at issue was mentioned unaided by only 12% of respondents when the category was “candy.” The rate of mentioning the brand unaided rose dramatically when the category was narrowed significantly. As this demonstrates, the choice of how to describe the category (from broad to narrow) can have a substantial impact on unaided awareness results, which is another reason that unaided awareness is not actually measuring “recognition” of a mark and can produce results that are arbitrary if the goal is to assess recognition.

It is also worth considering the example of the BIG GULP mark, as this mark was cited by the TTAB as an example where sufficiently high unaided awareness supported a finding of fame. The 73.0% result relied on by the board was obtained by the survey providing respondents with the following introduction: “Some places have developed their own names for items they carry, like Burger King named it’s [sic] hamburger The Whopper. When you think of places that sell fountain soft drinks, what names for these fountain drinks can you think of?”³² This is an unusually detailed and focused introduction identifying a category. It is unclear whether BIG GULP would have received a “sufficiently high” unaided result had the survey used a more typical, general category description, and had not resorted to such a highly detailed and focused description.

question, it would have been necessary to use a narrower, more focused description of the relevant category to have a chance of producing meaningful results.

³¹ The particular brand is not identified because the survey was conducted for internal market research purposes and is confidential and proprietary to the brand owner.

³² *Wechsler*, 2007 WL 1431084, at *9 n.52.

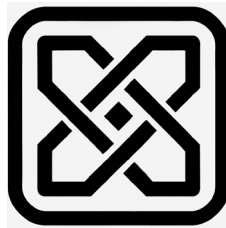
*C. Unaided Awareness Is Generally Not Applicable
for Design Marks or Trade Dress*

Not all trademarks are bare word marks. Many marks consist of visual and stylistic elements. Consider the following fictional stylized mark:³³



While an unaided awareness survey can certainly test the extent to which respondents identify a *word* mark, an unaided awareness survey typically cannot reliably test for recognition of a stylized design mark that is heavily visual in nature. In most cases, respondents cannot be expected to reliably describe or recreate on their own a visual/stylistic design, such as the one above, in order to evidence their awareness of the mark unaided by any stimulus.

Consider also the following fictional logo containing no words at all, such as the following:



Respondents in an unaided awareness study could not be reasonably expected to reliably describe or draw such a mark from memory. Nor would respondents volunteering the *name* of the company or brand that uses the logo demonstrate familiarity with the specific design that constitutes the mark.

Consider also the instance of trade dress consisting of the overall combination of various ornamental design elements, such as the following fictional design:

³³ The marks shown in this section were created using ChatGPT.



Respondents in an unaided awareness study could not be reasonably expected to reliably describe or draw this trade dress. Even if respondents volunteered the *name* of a company or brand and attempted to describe a design, such answers would not reliably prove recognition of the specific elements that constitute the trade dress.³⁴

Accordingly, unaided awareness is typically not feasible as an option for testing visual marks, such as stylized marks, logos, or trade dress.³⁵ Requiring unaided awareness data as a standard for proving fame would create conflicting standards for proving fame for word marks versus marks/trade dress that are significantly visual in nature.

V. CONCLUSION

While unaided awareness evidence can sometimes be useful as supplemental evidence (and high unaided awareness levels can be conclusive on their own), unaided awareness is not appropriate as a primary standard or requirement for proving fame by survey because:

- A requirement of unaided awareness data is inconsistent with the statutory standard defining fame as widely “recognized” and calling for evidence of the extent of actual

³⁴ See David T. Neal, *Psychological Considerations in Designing Trademark and False Advertising Survey Questionnaires*, in *Trademark and Deceptive Advertising Surveys*, 281 (explaining that respondents are typically not able to reliably identify or describe in response to open-ended questions what elements of trade dress cause respondents to recognize the trade dress or confuse it with another source); R. Charles Henn Jr., *Why Ask Why: A Critical Assessment of an Historical Artifact*, 113 *Trademark Rep.* 772, 780–81 (2023) (explaining that respondents’ attempts to explain their own perceptions are often unreliable or even misleading).

³⁵ In one reported case, survey respondents were asked to draw a CRAYOLA package from memory and were able to draw a green and yellow box. *Binney & Smith v. Rose Art. Indus.*, 60 U.S.P.Q.2d 2000, 2003 (E.D. Pa. 2001). Such a methodology may be feasible for demonstrating unaided awareness of certain elements, such as colors. However, it is also important to note that such a survey is not a true unaided awareness test, as the *brand* name CRAYOLA was provided to respondents. Accordingly, respondents did not think of the CRAYOLA box on their own.

“recognition,” as unaided awareness does not measure recognition.

- A requirement of unaided awareness data contradicts the explicit literature identifying aided awareness as the primary standard for measuring recognition/fame.
- Unaided awareness is not an objectively applicable or reliable standard for fame because unaided awareness results can vary arbitrarily based on category size as well as category description.
- Unaided awareness is not an objectively applicable, reliable standard for fame because it is typically feasible for word marks only and would require a separate and inconsistent standard for other types of marks with visual/stylistic elements.

The Board (and courts) should always consider and assign meaningful weight to properly designed and conducted aided awareness surveys on the topic of fame, as all such surveys are probative on the extent to which the tested mark is recognized. Unaided awareness data should not be required to prove fame. If offered, however, surveys showing a significant degree of unaided awareness should also be considered and assigned meaningful weight as support for fame, and high enough unaided awareness levels should, on their own, suffice to prove fame. High unaided awareness levels should also be considered to indicate a particularly high degree of strength when it comes to a dilution (or confusion) analysis.

BOOK REVIEW*

*By Leigha R. Santoro***

The Cambridge Handbook of Marketing and the Law.

Jacob E. Gersen and Joel H. Steckel, eds. 2023. Pp. 446. \$210 (hardback); electronic version available. Cambridge University Press, Shaftesbury Road, Cambridge CB2 8EA, United Kingdom.

Many areas of law overlap with various marketing theories, but individuals in one or the other profession may not necessarily realize the overlap because of different terminology used. In *The Cambridge Handbook of Marketing and the Law*, editors Jacob E. Gersen and Joel H. Steckel have compiled nineteen interconnected chapters with a focus on the many recurrent problems that arise in litigation over the marketing of products, including problems related to consumer confusion, valuation, and gaps between (i) consumers' expectations of the products they purchased compared to the actual products they received; and (ii) consumers' expectations of their legal protections and the remedies afforded to them when the actual products do not meet their expectations. Many of the chapters also address the application of marketing theories to litigation, such as class certification and evidence of consumer behavior.

The chapters are arranged into four parts: understanding consumer behavior, understanding marketing phenomena, methodological advances, and how the law protects marketing. Each chapter is written by a different author or authors, and the expertise of the individual authors is apparent throughout the text.

Part I, entitled "Understanding Consumer Behavior," begins with a discussion of the consumer buying path, ranging from the more traditional purchase funnel to the more modern purchasing loop that accounts for active empowered consumers. Laura O'Laughlin and Catherine Tucker (Chapter One), and Chad Hummel, Ben Mundel, and Jerry Wind (Chapter Two) analyze how the consumer decision-making process, or the consumer journey, can be used to inform fact finders in litigation matters, specifically in cases involving consumer protection, antitrust, and intellectual property claims.

* This book review should be cited as Leigha R. Santoro, Book Review, 115 Trademark Rep. 777 (2025) (reviewing *The Cambridge Handbook of Marketing and the Law* (Jacob E. Gersen & Joel H. Steckel eds., 2023)).

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The next two chapters discuss consumer behaviors related to various legal concepts that directly impact marketing. In Chapter Three, Cass R. Sunstein explores the costs and benefits of mandatory labeling, concluding that voluntary labeling is often sufficient to address market concerns, but noting that when there is no standardized format for providing information, mandatory disclosures may be necessary. In Chapter Four, Vildan Altuglu, Lorin M. Hitt, Samid Hussain, and Matteo Li Bergolis consider unauthorized access or misuse of consumer information in both invasion-of-privacy and data-breach settings. The authors highlight challenges in assessing and quantifying damages in these cases, specifying various factors related to consumer behavior that must be considered: the type of information accessed, the context in which that information was used, and the level of privacy consumers associate with such information.

Part II, entitled “Understanding Marketing Phenomena,” begins with a discussion on the persistence of the practice of false promotional pricing and an evaluation of the effect this practice has on industry, firm, and consumer welfare (Chapter Five). Yiting Deng, Richard Staelin, and Joel E. Urbany compare results from an analytical model with empirical marketing research in their analysis. Part II continues with a discussion of brands as company assets and methods that can help distinguish between brand and marketing contributions to firm revenue and profits (Chapter Six). Dominique M. Hanssens, Lorenzo Michelozzi, and Natalie Mizik discuss quantifying a brand’s contribution to the financial bottom line as it relates to royalty rates in legal disputes, noting how marketing expertise may be required to evaluate compensation for trademarks and other marketing intangible assets.

Part II then discusses various types of advertising and the intersection of advertising campaigns with the law. First, Rebecca Tushnet analyzes the concept of puffery and its use as a litigation management doctrine, noting that the question to ask when considering advertising disclosures is what factual message consumers will perceive from the claim and suggesting that a cost-benefit analysis can be used to identify the least deceptive version of a claim (Chapter Seven). Next, Chapter Eight considers the practice of trademark bidding with respect to search engine advertising. Anindya Ghose and Avigail Kifer focus the discussion on evaluations of consumer search queries and the intention behind them along with how marketing techniques can be used to evaluate whether, and to what extent, trademark bidding leads to consumer harm.

In Part III, entitled “Methodological Advances,” the various authors discuss marketing concepts that are, or should be, used in litigation matters. Joel H. Steckel, Rebecca Kirk Fair, Kristina Shampianier, and Anne Cai discuss assessment of consumer

behavior, rather than consumer thoughts, through conjoint surveys and simple choice experiments, rather than the more traditional surveys that contain implicit bias (Chapter Nine). Rene Befurt, Niall MacMenamin, and Aylar Pour Mohammad discuss the use of conjoint analysis in product liability, false advertising, class certification, data breach, and intellectual property matters, including suggestive tips for best practices when designing conjoint surveys because although these methods are commonly used in marketing, they are frequently rejected by courts due to concerns of validity or applicability (Chapter Ten). Saul Levmore compares the conjoint analysis in marketing research to component valuation in patent law and to comparative negligence of tort law, suggesting there is no one-size-fits-all approach when evaluating the impact variables have on consumer behavior (Chapter Eleven).

Part III also considers marketing concepts specifically related to consumer class action cases. Randolph E. Bucklin and Peter Simon consider how marketing techniques can be used to address issues such as establishing common harm and damages in class certification for both plaintiffs and defendants (Chapter Twelve). August T. Horvath further addresses how damages models in consumer class action cases have evolved in recent years, with a particular emphasis on false advertising cases, and how the conjoint-based techniques, like those discussed earlier in Part III, are commonly used in consumer class action false advertising cases to establish class certification but are rarely used in Lanham Act competitor false advertising cases because of the different approaches the respective plaintiffs take toward calculating damages—consumer cases focus on price premium while competitor cases focus on increased sales or profits (Chapter Thirteen). Although he suggests damages calculations are unlikely to change, the author concludes that a conjoint approach could be utilized in competitor cases to model market share.

Part III continues with a further discussion of the value of brands and specifically a look at the legal concept of secondary meaning from a marketing perspective (Chapter Fourteen). For marketing professionals who may be unfamiliar with the legal aspects involved in assessing secondary meaning, Peter N. Golder, Michael J. Schreck, and Aaron C. Yeater propose a framework to organize the various factors assessed by the twelve circuits, including a look at the marketing principles that align with each of the factors. Tom Wesson, Erich Schaeffer, Brenda Arnott-Wesson, Mark Pelofsky, David Heller, and Bree Glaviano continue with an analysis of social media posts and the benefits and challenges of using this type of evidence in commercial litigation (Chapter Fifteen). While suggesting that social media analyses are more persuasive and temporal than traditional opinion surveys, the

authors note there are many challenges inherent in the use of social media posts as evidence in any case.

Part IV of the book, entitled “How the Law Protects,” begins with a chapter discussing the results of a survey experiment based on the well-known trolley problem, wherein the survey respondents were told various facts about the law, such as whether the law required or forbade turning the train (Chapter Sixteen). Bert I. Huang discusses how the results of the survey indicate that knowledge of the law can impact moral intuitions even when the law does not expressly address the harm. Part IV also includes Shmuel I. Becher, Yuval Feldman, and Orly Lobel’s chapter focusing on the discussion on behavioral biases that can lead to over-borrowing and use of high-cost credit, the effect of poverty and scarcity on economic choices from a psychological perspective, and proposed policy ideas that could be adopted and implemented to improve the financial situations for those in poverty (Chapter Eighteen). While both chapters provide informative discussions on their respective subjects, in the abstract without the context of the surrounding chapters, it may not be immediately apparent to readers how these chapters fit into a discussion of the intersection of marketing and the law.

Part IV also contains Jacob E. Gersen and C. Scott Hemphill’s analysis of the interplay between intellectual property and branding by considering what is arguably the most famous example of trade dress protection—the Coca-Cola bottle—including the various intellectual property decisions made throughout the history of the design and the challenges faced along the way (Chapter Seventeen). In the final chapter of the book, Chapter Nineteen, Stephen Ansolabehere and Jacob E. Gersen discuss the intersection of the Lanham Act’s false-advertising cause of action with regulations in the food and beverage industry. Here, the authors seek to understand the reasonable consumer’s decision-making process and to clarify how courts and regulating agencies such as the Food and Drug Administration should adopt and apply this role in judicial decisions and legal regulations. The authors suggest courts and agencies do this by examining the results of experiments designed to observe whether labels can affect consumer preferences, what inferences consumers draw from labels, and how those inferences affect preferences to purchase products.

Each individual chapter of this book provides a detailed discussion of the relevant legal and/or marketing topics. But it is not necessarily clear that each chapter on its own relates to the intersection of marketing and the law, as one might expect from a book titled *The Cambridge Handbook of Marketing and the Law*. However, the editors have compiled the individual chapters into four parts in a way that, when read together, establishes this

connection and provides helpful insights to professionals in both disciplines.

BOOK REVIEW*

By Kathleen E. Brennan **

The Language of Licen\$ing: The Licensing Industry's Definitive Reference Guide.*** Gregory J. Battersby and Danny Simon, 2024. Pp 323. \$28.95 Kent Press, 6 Green Pastures Lane, Kent, CT 06757.

Licensing is big business and continues to grow. Understanding how to negotiate, draft, and interpret intellectual property (“IP”) licenses is a crucial part of a trademark attorney’s client service toolkit. To quote the authors of this book, “while the general concept of licensing is seemingly straightforward, the devil is always in the details, as with most things.”¹

Gregory J. Battersby’s and Danny Simon’s *The Language of Licensing: The Licensing Industry’s Definitive Reference Guide* is a useful desk reference for those who deal with licensing issues regularly (both attorneys and non-attorneys), and those who aspire to become more comfortable with and knowledgeable about licensing issues. While it contains basic resources, such as definitions of common licensing terms, it also provides more nuanced material, such as average royalty rates for fourteen different types of licensed properties in a variety of fields. (Those interested in a deeper dive into average royalty rates in different fields may look to Battersby’s work with Charles W. Grimes, *Licensing Royalty Rates* (2025 ed).)

The authors are licensing experts, having a combined more than ninety years of experience in the licensing industry. Greg Battersby has written more than sixty books on licensing topics and is the only practicing attorney to ever be inducted into the Licensing Industry Merchandisers’ Association (“LIMA”) Hall of Fame. Danny Simon is a media, film, and entertainment licensing veteran and a founding member of LIMA, and he regularly lectures and serves as an expert witness on licensing issues. Battersby and Simon have co-authored several other books on licensing, including *The Basics of Licensing*,

* This book review should be cited as Kathleen E. Brennan, Book Review, 115 Trademark Rep. 782 (2025) (reviewing Gregory J. Battersby & Danny Simon, *The Language of Licensing: The Licensing Industry’s Definitive Reference Guide* (2024)).

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*** The cover of this book uses a U.S. dollar sign (“\$”) in place of the “s” in “Licensing,” presumably to highlight the commercial significance of licensing.

¹ Gregory J. Battersby & Danny Simon, *The Language of Licensing: The Licensing Industry’s Definitive Reference Guide* (2024), Preface, at v.

The Business of Licensing, *Fundamentals of Licensing*, and *Licensee Survival Handbook* (the latter two marketed with *The Language of Licensing* as a “Licensing Trilogy” resource, available in paperback, hardcover, and e-book).

The Language of Licensing is intended to serve as a single source of “most of the relevant information needed to master the art of licensing.”² Chapter One describes different types of licenses, from celebrity licensing to software licensing. Some of the license types overlap—for example, content licensing and copyright licensing. As this book is intended as a desk reference, it can be helpful to have all manner of licenses defined, and easy to look up.

Chapter Two contains current information about the merchandise licensing industry. The top global licensors are listed according to 2024 retail sales and are also broken up into product categories, i.e., entertainment, toys and games, fashion, and the like. There is also a list of the top fifty global licensing agents. Unfortunately, several charts of licensed global sales revenues broken up by field and geographic area are largely unusable, because the text is blurry and the color-coded charts are difficult to read in a book printed in black and white.

Chapter Three constitutes the bulk of the book and contains 179 pages of licensing contract terminology. The authors have included very helpful examples of each defined term, as used in an actual license. The terms are listed alphabetically, so they will be easy to look up when drafting or reviewing a license agreement. Chapter Three also contains a chart of wholesale royalty rates, broken down by product category (e.g., leather goods, alcoholic beverages, etc.) and field (e.g., collegiate, fashion, etc.), as well as lists and definitions of channels of distribution for licensed goods, a breakdown of worldwide geographic territories of distribution, a sample royalty statement, and thirteen pages of intellectual property terms that might be used in an IP license.

Chapter Four contains an alphabetical listing of international licensing organizations, governmental agencies, licensing publications, and trade shows/events. And Chapter Five provides a list of U.S. and international laws and statutes relevant to the licensing industry.

Chapter Six provides a collection of sample licensing forms, including a Licensee Application, Deal Memo, Licensing Agent/Representative Agreement, Patent and Merchandising License Agreement, and a Mutual Non-Disclosure Agreement (or “NDA”). While there is no specific trademark license form, the Patent and Merchandising License form contains a trademark license, so the terms in that form will be helpful in trademark licensing.

² *Id.* at Preface, at v.

In summary, there is much to learn about licensing from this book, whether on its own or in conjunction with the other licensing books authored by Battersby and Simon. *The Language of Licensing* delivers valuable details and examples of terms in licensing contracts as well as interesting and useful information about licensing industry trends.

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