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Symposium: Diamond Anniversary: 75 Years of the Lanham Act

Jessica Litman

University of Michigan Law School, jdilitman@umich.edu

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Recommended Citation

Litman, Jessica D. "Symposium: Diamond Anniversary: 75 Years of the Lanham Act." *Cardozo Arts and Entertainment Journal* 39, no. 3 (2021): 855-873.

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CARDOZO ARTS & ENTERTAINMENT LAW
JOURNAL SPRING SYMPOSIUM 2021

KEYNOTE ADDRESS♦

JESSICA LITMAN*

Thank you so much for inviting me. I think this is my fifth or sixth event with the *Arts and Entertainment Law Journal*. It's always lots of fun, and I learn a lot. I've been spending the last couple of months doing a deep dive into everything Edward Sidney Rogers with no real agenda. I'm exploring what's there, to see if there are any interesting stories I might tell. I found a few, so this afternoon I'll tell one of them.

I want to start with the mundane observation that intellectual property and intellectual property law are global. We've seen an especially crucial illustration in the recent weeks of the so-far unsuccessful efforts to cause the owners of patent rights in vaccines to waive their patent rights so that other countries can manufacture the COVID vaccine.

As you know, for many years the United States did everything its own way, which mostly was the way that England used to do things way back when, before it learned from its neighbors. The U.S. was pretty resistant to changing its IP laws to make them more like the IP laws of other countries. But eventually, we came to the conclusion that global commerce works better when everyone is following a consistent set of rules, and so the United States has made, I think, significant progress in amending its copyright and patent laws to more nearly align them with international norms and with the laws of our major trading partners.

♦ This edited Keynote Address was given by the Author at the Benjamin N. Cardozo School of Law on March 24, 2021, at the *Cardozo Arts & Entertainment Law Journal* Spring 2021 Symposium, Diamond Anniversary: 75 Years of the Lanham Act. Permission is hereby granted for non-commercial reproduction of this Keynote Address in whole or in part for education or research purposes, including the making of multiple copies for classroom use, subject only to the condition that the name of the author, a complete citation, and this grant of permission be included in all copies.

* John F. Nickoll Professor of Law, University of Michigan Law School. This keynote speech was adapted from a longer research project, which currently bears the working title *Edward S. Rogers, the Lanham Act, and the Common Law*, and which will be published in ROBERT G. BONE & LIONEL BENTLEY, *RESEARCH HANDBOOK ON THE HISTORY OF TRADEMARK LAW* (forthcoming 2023). I want to thank the librarians and research assistants at the University of Michigan Law Library who helped me to find many unfindable documents.

American trademark law, on the other hand, remains stubbornly use-based. Whose fault is that? I blame this guy. Edward Sidney Rogers is the man who actually wrote the language of the bill that Fritz Lanham introduced as H.R. 1654 and Congress enacted as the Lanham Act.

Congress has amended the Lanham Act significantly in the last seventy-five years. The common law use-centric basis for the law is so deeply embedded in its provisions that it's hard to imagine a way to change them.

We call the law the Lanham Act, as you know, because the House bill that became the law was sponsored by Congressman Fritz Lanham. I don't want to minimize his contributions to getting the law enacted. He sponsored seven different versions of the bill. He held a bunch of House hearings, and he engaged in a lot of political logrolling necessary to cause the bills to be reported out of the committee multiple times, passed by the House, and ultimately, enacted and signed.

But he didn't conceive of the law or write its language, and he never claimed to have done so. In fact, before the bill that became the Lanham Act got introduced as the Lanham Bill, its predecessors were introduced as the Ernst Bill, the Lampert Bill, the Shipstead Bill, the Vestal Bill, the Walsh Bill, the Hebert Bill, and the Bone Bill. All in all, nineteen bills over the course of more than twenty years.

Edward Rogers is the guy who wrote all of them. I first learned about Edward Rogers forty years ago. I was a law student. I was writing a note about trade dress infringement. The fashion in those days, before Nikola Tesla invented electricity, was to construe the language of any statute by figuring out what the legislature had intended. One was supposed to figure out what the legislature intended by looking at the statute's legislative history.

I went into the stacks of the Columbia Law Library, and I pulled the hardbound hearing transcripts and the House and Senate reports off the shelves and started reading. There Edward Rogers was, back in 1925, explaining the bill he had drafted. He came back year after year and so did a regular cast of trademark lawyers who supported or opposed various provisions of the bill.

Fritz Lanham was already there in 1925. He was then a very junior member of the House Committee on Patents. Every year he got a little more senior, until finally it was his turn to be chairman.

I still have my handwritten notes from 1981. They're only marginally useful, since they're all about trade dress infringement, but they gave me a place to start.

Rogers is not an obscure figure. Most trademark scholars know he wrote the Lanham Act. He also litigated many of the famous iconic trademark cases of the first half of the twentieth century, so the *Shredded*

Wheat case, the *Aunt Jemima* case, *Bayer Aspirin v. United Drug*, the *Webster's Dictionary* cases, *Coca-Cola v. Coke*, and, indeed, all of the Coca-Cola cases were Edward Rogers's cases.

But he isn't really famous, or at least not as famous as I think he should be. He has no Wikipedia page. There's an Edward Rogers with a Wikipedia page, but it's a completely different guy. He has never been inducted into any IP hall of fame. I can't find anything about him at all on the PTO website. When I started teaching at Michigan, I discovered that Rogers was in fact a graduate of the Michigan Law School and had been a member of the law school's adjunct faculty for fifteen years, but nobody still at the law school had ever heard of him.

If you do a Google search for Edward Sidney Rogers, you'll discover that the Pattishall McAuliffe law firm claims Edward Rogers in its origin story. Indeed, the Pattishall law firm is the direct descendent of Rogers's first law firm, Reed & Rogers. Beverly Pattishall, in fact, joined the firm while Rogers was still practicing and actually worked with Rogers on a couple of cases.

If you check out the Pattishall website—let me give you a larger version of this text:

The . . . law firm began in a thunderstorm. The decisive moment came in 1898, when Edward S. Rogers, a third year at the University of Michigan law school, ducked into a classroom to get out of the down-pour. At the lectern was Frank F. Reed, the leading trademark and copyright lawyer from Chicago.¹

As the story goes, Rogers became so interested in the lecture, which was on the law of trademarks and unfair competition, that he stayed for the lecture and attended the remaining lectures. When he graduated that spring, he called on Mr. Reed and asked him for a job.²

Like many origin stories, I'm sure there's truth in this, but the details are wrong. If a fateful thunderstorm caused Edward Rogers to duck into a lecture hall to stay dry, it didn't happen in 1898, since Rogers had already graduated three years earlier. Whenever this thunderstorm happened, Rogers wasn't a third-year student because back in the day, the University of Michigan Law School LLB program was a two-year undergraduate program. So, Edward Rogers graduated from high school. His high school was the Michigan Military Academy. As an eighteen-year-old in 1893, he immediately enrolled in the University of Michigan Law School and he earned his LLB two years later in 1895.

¹ David C. Hilliard, *Our History*, PATTISHALL MCAULIFFE, <https://www.pattishall.com/firmhistory.aspx> [<https://perma.cc/2EXY-6WJ2>] (last visited Aug. 6, 2021).

² *Id.*

Frank Reed was not yet a leading trademark and copyright lawyer. Reed was a partner in the Chicago law firm of Aldridge, Reed, Foster & Allen, doing general business litigation. It was a general business litigation law firm. Reed had in fact been involved in a couple of cases that raised copyright issues, but most of his practice was business contracts, debts, and mortgages.

Reed was himself a Michigan alumnus, something that I would never have known without this project. He hadn't attended the law school. He did play on the University's very first intercollegiate football team back in 1879.

More significantly, at least to me, the lectures that Reed delivered were not on the law of trademarks and unfair competition. Michigan Law School hired Frank Reed to give six nonresident lectures on copyright law. Copyright law is what he taught. He was, in fact, the very first person to teach copyright law at the University of Michigan.

Parenthetically, ten years later in 1905, Frank Reed finally got Michigan to hire him to give a series of nonresident lectures about trademark law. He did that by persuading Michigan Law School to hire his partner and fellow alumnus Richard Rogers to take over the copyright lectures so that Reed could lecture on trademark law instead.

In any event, I think it's a pretty good bet that Rogers attended Reed's lectures on copyright law because immediately after graduation, Rogers moved to Chicago and went to work at Aldridge, Reed, Foster & Allen. Four years later in 1899-ish, Reed and Rogers decided to leave Aldridge and open a specialty law firm, covering patents, trademarks, and copyrights.

Most of their cases came from referrals from other lawyers in general practice, so in order to drum up business, both of them gave speeches at the Law Club of Chicago and taught trademark and copyright law at several law schools, not only Michigan, but University of Chicago and Chicago-Kent. They became active in national bar associations, and they published law review and bar journal articles.

The strategy proved pretty effective. The firm ultimately attracted an A-list of clients. They 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.

Because Rogers was such a prolific writer, we know a lot about his views on trademark law. He published articles on common law unfair trade, trademark history, the psychology of trademark infringement, predatory price cutting, and international trademark agreements, as well

as copyright, copyright subject matter, copyright history, and dramatic copyright.

In 1914, he collected a bunch of his previously published articles and speeches and adapted them into a book, *Good Will, Trade-Marks and Unfair Trading*,³ which he pitched to a general lay audience.

In 1870, Congress had enacted a trademark statute. Nine years later in the *Trade-Mark Cases*, the Supreme Court had held the statute to be unconstitutional. Rogers read that decision to hold that Congress lacked the power to enact substantive trademark law. He appeared to believe that was a correct and wise decision. Trademarks were, and should be, fundamentally creatures of common law.

Let me digress for a second to say that the common law of trademarks was not the sort of common law that we're used to, where the judges of fifty different states are free to devise fifty different solutions to the same problem. In 1842, the Supreme Court had held in a case named *Swift v. Tyson* that federal courts exercising diversity jurisdiction should apply the general common law rather than relying on the local decisions of any court. For the next ninety-six years, until the Supreme Court had decided it had been wrong about that, federal courts deciding trademark and unfair competition cases had developed a national common law of trademarks and unfair competition. Lawyers described that body of law as both uniform across different courts and remarkably stable. Then, as now, ownership of trademarks derived from actual use in the course of trade.

The common law of trademarks had some doctrinal quirks and limitations that look strange to twenty-first century eyes, so let me just mention a couple. Trademarks were words or symbols used in connection with the sale of tangible goods. What we would call service marks or trade names or collective marks or certification marks were not valid trademarks.

Only inherently distinctive marks could be valid trademarks. What we might think of as marks that had acquired secondary meaning, didn't count as trademarks. Trade dress wasn't a trademark. Advertising slogans were not trademarks. Surnames were not trademarks. Trademarks had to be physically attached to the goods. If they were used in advertising the goods but not attached to them, they weren't trademarks.

That meant that a whole host of deceptive trade practices that didn't involve the copying of a technical trademark was not trademark infringement. Nonetheless, they were actionable and enjoined as unfair competition.

³ EDWARD S. ROGERS, *GOODWILL, TRADEMARKS AND UNFAIR TRADING* (1914).

Lawyers often fall into the trap of assuming the law they learned in law school, whatever it was, made pretty good sense. Edward Rogers graduated from law school in 1895. He started a practice that specialized in trademark law only a few years later. He came to this body of law in the thick of the *Swift v. Tyson* federal general common law of trademarks era, and he thought it made an enormous amount of sense.

Rogers argued that people who thought trademarks were property, the way copyrights or patents were property, were simply committing a category error.⁴ Trademarks were not property; rather products and businesses build up on good will and that good will was the property.⁵ Trademarks were simply symbols of the good will. If a competitor encroached on that good will 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.

Indeed, much of Rogers's trademark litigation practice involved seeking injunctions to stop competitors from doing things that didn't count as technical trademark infringement either because the marks didn't qualify as technical trademarks—they were descriptive, they were surnames—or because the behavior the client was complaining of didn't involve copying of a mark.

In response to the *Trade-Mark Cases*, Congress had enacted a couple of laws that encouraged the registration of trademarks used in interstate or foreign commerce but didn't confer any substantive rights. The

⁴ Rogers put it this way in his book:

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 trademark 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.

Id. at 52–53 (1914).

⁵ Rogers wrote:

A trade-mark does not exist as an extrinsic thing and hence is not, in any sense, property when so considered. It is never property dissociated from a business because when so separated it cannot indicate a commercial source. It becomes endowed with certain attributes of property when affixed to merchandise, because it here represents the good will of the producer of the merchandise to which it is affixed. . . . It is the good will or reputation that is the property and not the means as a separate thing by which it is symbolized.

Id. at 100.

Supreme Court had held in a couple of decisions that those registration statutes did not give registrants rights beyond what they were entitled to under the common law.

In 1914, the same year his book came out, Rogers published an article in the *Michigan Law Review* that argued that the then-current trademark registration law, which had been enacted in 1905, was worse than useless.⁶ He called it a “slovenly piece of legislation.”⁷ He argued that the statute was based on the wrong principle. Since U.S. trademarks were based on common law and 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.

Rogers argued 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.⁸ Everyone who used a trademark in interstate commerce should be required to file a record of that mark with the bureau, which would then make the records available to people who wanted to search them.

The article led to an invitation to give a speech to the American Bar Association Section on Patent Trade-Mark and Copyright Law at its 1920 annual meeting on the topic of what a modern trademark statute ought to look like.⁹ By the time that meeting happened, six years passed. Congress had enacted an additional trademark registration statute designed to allow the registration of trademarks on products designed for export, even if those marks wouldn’t qualify as technical trademarks under U.S. law.

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 registrations in foreign jurisdictions, which typically required a domestic certificate of registration, but which might have less-exacting standards about what qualified as a technical trademark.

We have six more years of law. We have a new statute. The text of the speech that Rogers gave to the ABA section in 1920 about what was wrong with current law was seventy-five percent the same as the text of the 1914 *Michigan Law Review* article.¹⁰ Here’s a side-by-side comparison:

⁶ Edward S. Rogers, *Expensive Futility of the United States Trade-Mark Statute*, 12 MICH. L. REV. 660 (1914) [hereinafter Rogers, *Expensive Futility*].

⁷ *Id.* at 665.

⁸ *Id.* at 675.

⁹ See Edward S. Rogers, *Some Suggestions Concerning a Trade-Mark Registration Act*, 43 A.B.A. ANNU. REP. 412 (1920) [hereinafter Rogers, *Some Suggestions*].

¹⁰ Compare Rogers, *Expensive Futility*, *supra* note 6, at 660, with Rogers, *Some Suggestions*, *supra* note 9, at 412.

<p>Every lawyer of much experience knows the client who tiptoes into his office, closes the door carefully, and with a great show of secrecy announces that he has discovered or invented the best name for a soda cracker, a patent medicine, a soft drink, or what not, that human ingenuity ever conceived. He wants it protected before any one can steal it from him. He wants it "Copyrighted." This is the expression most commonly used. He seems to be under the impression that some incantation can be performed by means of which he will be able to secure to himself the exclusive use of his new name for crackers or whatever it may be. His lawyer is probably under some similar delusion and sets about to find a way to endow his client with his discovery, enormous secrecy being religiously maintained all the while. He too has a hazy notion that he can copyright something whereby his client can exclude the world—all of which is due to a very general ignorance of what a trade-mark is and how the right to one is acquired.</p>	<p>Every lawyer knows the client who tiptoes into his office, closes the door carefully and, with a great show of secrecy, announces that he has hit upon the best name for a soda cracker, a patent medicine, a soft drink, or what not, that human ingenuity ever conceived. He wants it protected before any one can steal it from him. He wants it "Copyrighted." This is the expression most commonly used. He seems to be under the impression that some incantation can be performed by means of which he will be able to secure himself in its exclusive use. His lawyer, and I have known such, may be under some similar delusion. Enormous secrecy is religiously maintained all the while. This is not burlesque, it is happening all the time and is due to a very general ignorance of what a trade-mark is and how the right to one is acquired.</p>
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Basically, the same words. 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. Rogers was, unquestionably, in the second category. Here's another pair of quotes from the same two publications¹¹:

¹¹ Compare Rogers, *Expensive Futility*, *supra* note 6, at 673 (citations omitted), with Rogers, *Some Suggestions*, *supra* note 9, at 418.

The conditions are not the fault of the officials of the Patent Office; a more efficient and conscientious set of public servants it would be difficult to find. It is the statute itself that is responsible.

And what is it all about? The right to register a trade-mark. And when the trade-mark is registered what then? Then the statute provides that the person in whose name the trade-mark is registered is *prima facie* the owner, which liberally translated means that he claims to be the owner and it looks as if he might be. Not that he is. The defeated party to the proceeding can go right ahead using the mark which the Patent Office has held that the other party has the better right to, and if the victor wishes to put a stop to this use he must sue for an injunction in a court, and then before he can succeed he will probably have to duplicate the taking of testimony and argue the thing all over again before a judge who is quite likely to pay no attention to the decision of the Patent Office. Finally it may happen that some third party was the first to adopt and use the mark and that the registrant has not even a color of right to it. And since registration creates only a presumption of ownership, it can always be rebutted and a showing of prior use is of course enough to do it.

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And what is it all about? The right to register a trade-mark. And when the trade-mark is registered, what then? Then the statute provides that the person in whose name the trade-mark is registered is *prima facie* the owner, which liberally translated means that he claims to be the owner and it looks as if he might be, not that he is. The defeated party to the proceeding can go right ahead using the mark which the Patent Office has held that the other party has the better right to, and if the victor wishes to put a stop to this use, he must sue for an injunction in a court, and then before he can succeed he will probably have to duplicate the taking of testimony and argue the thing all over again before a judge who is quite likely to pay no attention to the decision of the Patent Office. Finally, it may happen that some third party was the first to adopt and use the mark and that the registrant has not even a color of right to it. And since registration creates only a presumption of ownership, it can always be rebutted and a showing of prior use is, of course, enough to do it.

Why am I bothering with this? It was a career-long habit. You could find language from Rogers's publications in the 1910s repeated in his speeches and articles in the 1930s and the 1940s, so I'm just going to give you one further example.

Here's a paragraph from an article that Rogers published in the *Michigan Law Review* in 1910 about courts' definitions of potentially confused consumers:

The setting of the stage upon which the unwary purchaser performs is a proper subject of judicial inquiry, therefore evidence of the customary manner of exposing the goods in question for sale, is competent. The names and manner of familiar identification of the article, and evidence of the characteristics of the unwary purchaser himself will be received, whether he is intelligent or the reverse, educated or illiterate, what may be his age, whether a child or mature and his station in life. Objectively the unwary purchaser is pretty comprehensively investigated. Subjectively, however, he seems to have been wholly neglected, and I believe that the irreconcilable conflict among the decisions is due to this neglect.¹²

....

Courts cannot help endowing the unwary purchaser with a part of their own intellectuality and regard with impatience evidence which seeks to credit him with less.¹³

Here's a paragraph from an article published thirty years later in the *New York Law Review*, which was adapted from the text of a speech Rogers gave to the Association of the Bar of the City of New York in 1940.

The setting of the stage upon which the "unwary purchaser" performs is also inquired into. Evidence of the customary manner of exposing the goods in question for sale is competent. The names and manner of familiar identification of the article and, last of all, evidence of the characteristics of the "unwary purchaser" himself will be received, whether he is intelligent or the reverse, educated or illiterate, whether he is a child or a servant. But, however much they may try, the courts cannot help endowing the "unwary purchaser" with a part of their own intelligence and regard with impatience evidence which seeks to credit him with less.¹⁴

I don't want to oversell the observation. I'm not suggesting for a minute that it's deceptive or skuzzy for an author to repurpose his own prose. I probably would not even have noticed this habit if Rogers's language were less memorable or if I weren't reading every single article the man published in quick succession. I think, though, that it tells us something true about how Rogers worked, and I'm going to claim in a few

¹² Edward S. Rogers, *The Unwary Purchaser*, 8 MICH. L. REV. 613, 615–16 (1910) (citations omitted).

¹³ *Id.* at 617.

¹⁴ Edward S. Rogers, *New Directions in the Law of Unfair Competition*, 74 N.Y. L. REV. 317, 326 (1940) (citations omitted).

minutes that that habit made a difference in how the final version of the Lanham Act was worded.

Let me go back to the 1920 ABA speech. In addition to rehashing the complaints he had made in 1914, Rogers came armed with the text of a new trademark registration statute that would meet the objectives he outlined. He argued we should throw out the current statutes and start with a completely clean slate, and that we should begin with the premise that substantive trademark law is, should be, and must be, a matter of common law rather than statute. If we start there, he suggested, the most important job a statute could do is to make it easy to figure out whether a given mark is in use and, therefore, subject to common law protection.

He brought a statute. His draft statute, first of all, would have required everyone who used a trademark in commerce to deposit that mark in the Patent and Trademark Office (PTO). The deposit would need to include who owned it, what goods it was used on, dates of use, and 20 specimens or copies. Failure to deposit would be punishable by a \$100 fine, and the deposit would be a prerequisite to an infringement action and would expire and need to be repeated every five years.

He also argued in his speech that trademark infringement should be punishable as a misdemeanor, I guess on the theory that if we're having a statute, why not add some criminal penalties? But he didn't in fact put that in his draft statute.

The speech was a hit. The Section immediately voted to appoint a committee to draft a trademark statute along the lines Rogers had suggested. They made Rogers the committee chair. The committee generated a text of a bill, which is to say Edward Rogers wrote a bill. He presented it at the next ABA Annual Meeting where lots of people made suggestions and objections. Then the committee took it on tour, seeking comments from city patent associations and all sorts of associations, manufacturer groups, and revised the bill accordingly.

Then in 1924, the ABA persuaded Senator Richard Ernst, Republican of Kentucky, and Representative Florian Lampert, Republican of Wisconsin, to introduce the text of the bill in Congress.¹⁵ (Everyone in this story except for Fritz Lanham appears to have been a Republican, including Edward Rogers.)

The bill that was actually introduced in Congress was different in significant ways from the proposal Rogers had made in 1921. It shared the same goals. It wanted to preserve all of the common law rights and remedies that the courts had devised. It wanted to provide for this directory of every trademark that was subject to common law protection.

¹⁵ S. 2679, 68th Cong. (1924); H.R. 8637, 68th Cong. (1924).

The bill didn't require anyone to register anything. It allowed the owner of a mark used in commerce to register it with the same examination process the PTO had been using forever, and it also allowed the user of a mark to just deposit it in the patent office and skip any PTO examination. Section 5 of the bill provided for the patent office to put together a searchable collection of marks that included every registered mark, every deposited mark, and every mark the patent office knew to be in actual use.

The bill retained the requirement that no suit for infringement of a mark could be brought unless the owner had either registered or deposited the mark, and it also incorporated a more modest \$30 fine for not depositing promptly.

The bill also had a couple of other innovations. It expanded the field of registrable marks to include descriptive marks that had acquired secondary meaning and to include trade names (defined as what we would today call service marks), and collective marks. I mean, the courts had been giving these designations protection all along, even though they weren't technical trademarks, but because they weren't technical trademarks, they couldn't be registered anywhere, and so they couldn't be looked up.

The bill also included the precursor of the current Section 43(a) of the Lanham Act. Rogers explained he had taken language from the current tariff act and expanded it to make any false description or representation actionable. The deal here was that while common law courts had been pretty generous in enjoining a wide range of unfair trade practices, they had been mostly unresponsive to false representations. Section 30 of the bill was designed to correct that.

Finally, the bill had a section explicitly preserving all common law rights and remedies with the sole exclusion of the prohibition on infringement suits over marks that had been neither registered nor deposited. The idea was, first, to preserve the common law system of trademark protection and remedies for unfair trade; second, to make it possible for the PTO to assemble as complete as possible a directory of trademarks subject to common law protection, whether registered or not; and finally, to plug a few holes that the common law courts had refused to fill.

Opposition to the bill was about what you might have expected. One faction opposed Congress's passing any trademark legislation at all. The leader of this faction, or at least its most visible representative, was a Boston patent and trademark lawyer named Henry Thompson. Henry Thompson was a very flamboyant, in-your-face kind of guy. He had created a terrific, near-authoritative directory of trademarks in use that combined marks on the federal register, marks on state registers, marks in nationwide use that nobody had registered, and he was, understandably,

concerned that creating a new federal registry would ruin his business model. So, he sent out hundreds of alarmist postcards, claiming that the deposit provisions of the bill would cause major disasters and abrogate all extant trademark licensing agreements.

On the other side were lawyers who didn't read the Supreme Court's *Trade-Mark Cases* decision the way that Rogers did and did not believe that it precluded Congress's regulating trademarks under the Commerce Clause. If you remember that decision, the Court didn't hold that the Commerce Clause couldn't support trademark legislation but that it didn't support *that* trademark legislation, which didn't purport to be limited to interstate or foreign commerce. These lawyers argued trademarks were the essence of commerce. Commerce should just bite the bullet and replace the outmoded, old-fashioned common law edifice with a modern twentieth century substantive trademark law.

Senator Ernst and Representative Lambert held hearings on the bills. After the hearings, Rogers and the other members of the ABA committee revised the text of the bill. Senator Ernst and now Representative Vestal, Republican from Indiana, introduced the revised version in the next session of Congress.¹⁶ Rinse and repeat.

In successive versions of the bill, the non-examination deposit provisions evolved into the Supplemental Register. In order to persuade trademark owners to register their marks, the bill eventually copied the idea of incontestable registration from British law. The details of what changed between one year's bill and the next year's bill are interesting to ardent trademark nerds, but I'm not going to bore you with them today.

I do want to make a couple of observations at a slightly higher level of generality. First, when critics of whatever bill was before Congress objected to any substantive provision, Rogers often insisted that the provision either repeated the language of one of the current registration statutes or simply restated the common law rule. That was basically true, although Rogers had chosen which statutory language to repurpose and which common law rules to restate to embody a particular conception of how a trademark ought to work.

Second, and very unusual, I think, Rogers kept control of the working draft. If Representative Vestal's committee concluded that a provision ought to be changed, they relied on Edward Rogers to figure out the new wording and report back with a revised draft. When Representative Lanham became the Chair of the House Committee's Subcommittee on Trade-Marks, he decided to restart the trademark revision process after a couple of fallow years. He could easily have gone back to the last bill that

¹⁶ S. 2547, 69th Cong. (1925); H.R. 6248, 69th Cong. (1926).

had been successfully reported out of the committee. Instead, he went to Edward Rogers and asked for Rogers's current draft of his bill.

During the hearings he held, Lanham deferred to Rogers's decisions about whether particular objections or suggestions ought to be incorporated into the bill, and he asked Rogers to come up with or approve of the right wording.

Second, a section that became Section 43(a) of the Lanham Act sort of slid in under the radar because it was at the end of the bill. Originally, it attracted a lot of controversy because it seemed to confer expansive new rights the common law courts had rejected, but Rogers kept the language in the draft more or less as-is as the bill went through different iterations. Fritz Lanham's preferred way of holding hearings was to discuss the bill section by section, starting with Section 1 and moving on to Section 2. By the time they reached Section 30 or 43 or 44, everybody was tired and wanted to go home.

Third, Rogers's views on the appropriate nature and scope of trademark law evolved over the course of his career. He was, after all, the trademark lawyer for Coca-Cola, Quaker Oats, and Big Pharma. By the late 1930s, he had come around to the view that trademarks were, in fact, property. He favored extremely robust protection against unfair competition. He lost much of his sympathy for the little guy who had earned common law rights by adopting a mark and using it only locally. After the Supreme Court decision in *Erie Railroad v. Tompkins* threw out the federal general common law of trademarks, Rogers came around to the view that Congress should act to give trademark owners even stronger substantive rights than they enjoyed under common law doctrine.

Even though his views had evolved, Rogers never sat down and said—as he had said in 1920—“Let's take a fresh look at this whole thing. Let's redesign it from the ground up to make sense now.” Any language that hadn't attracted controversy in prior iterations stayed the same. Any revised provisions simply got incorporated into the original structure. Because most of that language had been drafted in the early 1920s when Rogers believed that trademark law was essentially, and necessarily, a common law creature, a lot of the language carried forward not only a use-based version of trademark rights but some common law quirks.

Why, for example, in 2021 does the statute still require that use of a trademark in commerce involves attaching the mark to the product? Because that was the old common law rule. In *Gray v. Armand Company*, for example, a 1928 case about cold cream and face powder, the mark was a picture attached to a box containing powder and cold cream free samples, but the picture wasn't attached to the retail packages. The court held that's not the sort of use that earns trademark rights:

It is settled law that the office of a trade-mark is to distinctly point out the origin or ownership of the article to which the mark is attached. It follows, therefore, that, to establish a right to the registration of a trade-mark, two things are necessary: That it must have been actually applied to vendible goods, and that the goods have been sold in interstate commerce.¹⁷

Because the picture was not affixed to the retail packages, the company had earned no trademark rights.

As enacted, the Lanham Act repeated the affixation requirement.¹⁸ When Congress amended the definition in 1988, it didn't see fit to get rid of it, even though it doesn't make a lot of sense in today's world. Here is the current version:

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, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.¹⁹

Now, I'm personally a big fan of use as a basis for trademark rights, although I have to acknowledge that, as I said, people tend to think the law they learned in law school makes more sense than it does. This is certainly the law that was enforced back when I was in law school.

¹⁷ Gray v. Armand Co., 24 F.2d 878, 878 (D.C. Cir. 1928).

¹⁸ The Lanham Act states:

For the purposes of this Act a mark shall be deemed to be used in commerce (a) on goods when 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 and the goods are sold or transported in commerce and (b) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce.

Lanham Act, ch. 540, § 45, 60 Stat. 427, 444 (1946) (codified as amended at 15 U.S.C. § 1127).

¹⁹ 15 U.S.C. § 1127.

I think use is an essential tool to deal with what Barton Beebe and Jeanne Fromer have identified as a trademark congestion crisis.²⁰ It also seems clear that without a robust use as a trademark requirement, people try to use trademark registration to claim very broad property rights to exclude others from using commercially useful words and phrases, and tying use to affixation is an administrable line.

The problem is that in today's world, whether a mark is attached to a tangible object is not a very good proxy for the sort of uses we are trying to include or exclude. But the fact that it's so firmly embedded in the trademark statute seems to me to be the result of basically path dependence and one man's writing habits. Rogers built his bill around actual use in the 1920s, as defined in the 1920s, because he believed the Supreme Court required it. He changed his mind about that—and he made a number of amendments and adjustments to the bill—but he didn't go back and re-conceive the statute from scratch. As a result, it is use-based to its core.

Okay, I offered to take questions until we run out of time if there are questions.

PROFESSOR FELIX WU: We've got the first question here from Rebecca Tushnet, who writes: "So, how would you rewrite use?"

PROFESSOR LITMAN: I'm not being normative here. I'm being thoroughly descriptive. I love use. I do think that we can get rid of affixation. We do it fine with services, with advertising in connection with the sale of services. I think even with our current affixation requirement, we're obviously having to rely on an ever-more robust failure-to-function exclusion to get rid of the people who are trying to get trademark rights in "LETTUCE TURNIP THE BEET," to pick one example. But I think advertising in connection with the sale of a product, whether it's attached or not, works today. It wouldn't have worked back in 1920, where everybody thought that trademarks were forever. You adopted a trademark, and it was different from an advertising slogan used for a season. It was what your customers called your product forever after.

PROFESSOR BARTON BEEBE: Jessica, thanks so much for this wonderful history. I can't wait to see it in print because, already, you're explaining things that have been great mysteries, at least for me, for quite a while, especially the quirks of Rogers repeating old language, Lanham's

²⁰ Barton Beebe & Jeanne C. Fromer, *Are We Running Out of Trademarks? An Empirical Study of Trademark Depletion and Congestion*, 131 HARV. L. REV. 945 (2018).

habit of proceeding in order of sections. It starts to clarify so many things about how the Act, at least as we have it now, seems almost a breakdown over time and becomes more and more whimsical or weird over time.

I guess I have a sort of ardent trademark nerd's kind of question, which is to ask if you had any sense of how Rogers conceived of the concept of trademark dilution? Because as you were speaking, I was looking through HeinOnline all of Rogers's work to see if he ever referenced Frank Schechter. My own sort of intuition is maybe they didn't get along particularly well.

PROFESSOR LITMAN: During the fallow years—the years between 1933 and 1938—Democrats gained control of the House of Representatives and Democrat William Sirovich became the chairman of the House Patent Committee. Sirovich was the kind of guy who thought that letting other people write statutes was just not what anyone had elected him to Congress to do. He at that time tried to write a new copyright statute to replace the Vestal bill that had been pending. He tried to write a new trademark statute.

He invited Frank Schechter to come and testify at a hearing about what the trademark law should do. Schechter came and gave his spiel. Sirovich invited him to draft a different trademark statute. Both Schechter and Rogers favored strong trademark protection, but they didn't favor the same sorts of strong protection.

Rogers and Schechter both belonged to the Association of the Bar of the City of New York and worked together on its trademark committee. They cited each other's work infrequently but respectfully.²¹ They were not members of one another's social or professional circles, but I have not found any indication that they disliked one another.

PROFESSOR WU: Question from the audience. To what extent, if at all, did Rogers address the issue of well-known marks and dilution, and, by extension, marks outside the United States that are not used in the United States but which enjoy reputation in the United States?

PROFESSOR LITMAN: Not so much. He was very concerned about international trade and international treaties. He believed that our treaties obliged us to offer strong unfair competition protection to foreigners domestically, but he didn't specifically address the question of extraterritorial use, except to the extent that early on he said, because

²¹ See, e.g., Frank I. Schechter, *Fog and Fiction in Trade-Mark Protection*, 36 COLUM. L. REV. 60, 61 (1936); *Report of the Committee on Federal and State Trade-Mark Legislation*, 1936 ABA SEC. PAT. TRADEMARK & COPYRIGHT L. COMM. REP. 17, 18.

other countries require registration first and won't register marks without a certificate of registration, and because we can't do that here—the Supreme Court has said we can't do that here—we need a quick and easy way to get them certificates of registration where they don't have to wait a year.

PROFESSOR WU: I had one question. In looking at some of the history of what became Section 43, I was curious about the—you sort of hinted at this—extent to which false advertising was explicitly part of the idea here or was part of the concept?

PROFESSOR LITMAN: It was explicitly part of the idea here. I mean, the examples he used were people who sold blankets that they said were made of wool when they were made of cotton or perfume imported from France that was made in New Jersey. But he absolutely expected that to be actionable, and it was unlike the other stuff, where mostly he had managed to get an injunction for a wide range of stuff that wasn't trademark infringement, like naming your product after the host of the show who promoted Rogers's client's project, which, yes, is an effort to fool people but not very straightforward. On this one, the courts were not with him, and he was taking the opportunity to change the law.

PROFESSOR WU: Great. With the example that you just raised, something like even false endorsement kind of things.

PROFESSOR LITMAN: I mean, because it was common law-y, it didn't go in these categories. His argument was just, "Why would you do that, given that our product is known to be promoted by this very famous radio host, unless you were trying to help yourself to our goodwill and divert trade from our sales? There's no other good explanation, so we want an injunction." And they got it.²²

PROFESSOR WU: An additional question has come in. How do trademark scholars such as McCarthy and Gilson view Rogers on use?

PROFESSOR LITMAN: I don't know the answer. I'm in 1948, and anything that happened after 1948, I haven't gotten to yet. Rogers died in 1949, so I may never get there, but I'm not there now.

²² See *Premier-Pabst Corp. v. Elm City Brewing Co.*, 9 F. Supp. 754 (D. Conn. 1935).

PROFESSOR WU: Thanks so much, Jessica, for this presentation. As Barton was saying, super interesting. Super interesting to see the ways in which all the things that we see, the law today, had a kind of origins story, had at least some ideas about where we ended up and why we ended up here. I think it will set up very nicely some of the panels that will be following in terms of thinking more about what some of these things look like.