

# Edward S. Rogers, the Lanham Act, and the Common Law

—Jessica Litman

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## Abstract

This book chapter is a deep dive into the story of Edward Sidney Rogers's authorship of the legislation that became the Lanham Act. 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 substantive rights and defenses. He sought to advance two incompatible goals: he hoped to preserve the robust common law of unfair competition while requiring, or at least encouraging, all trademark owners to register their marks. 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. They appear to have assumed that the statute would supplement the common law rather than replacing 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.

Along the way, the chapter recounts other interesting if not-very-consequential details. For example, Rogers's representation of drug companies at the turn of the century familiarized him with the 1906 Pure Food and Drug Act. When he wanted to include a provision in his legislation that enabled recovery for false representation, he turned to the Pure Food and Drug Act for a model. When Representative William Sirovich, then one of only ten Jews in Congress, assumed the chairmanship of the House Patent Committee in 1931, he decided that instead of continuing to rely on Rogers and the ABA for trademark legislation, he would ask Frank Schechter to draft an alternative bill. Part of the reason may have been the ABA's efforts in the early 20<sup>th</sup> century to block Jews from practicing law. Finally, the notion that federal law controlled infringement of registered trademarks but state law controlled unfair competition arose in the 1940s in the wake of the Supreme Court's decision in *Erie Railroad v. Tompkins*. Before that, trademark lawyers agreed that the two sorts of actions arose from a single body of law.

## Edward S. Rogers, the Lanham Act, and the Common Law

—Jessica Litman\*

*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.*

—Edward S. Rogers (1914)<sup>1</sup>

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.<sup>2</sup> Rogers's

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1 EDWARD S. ROGERS, GOOD WILL, TRADE-MARKS AND UNFAIR TRADING 52-53 (1914) [hereinafter Rogers, *Good Will*].

2 Edward S. Rogers, *Some Suggestions Concerning a Trade-Mark Registration Statute*, Report of the 43d Annual Meeting of the American Bar Association 412 (1920), reprinted in 16 Bulletin of the U.S. Trademark Association 45 (March 2021) [hereinafter Rogers, *Suggestions*].

proposed statute was short. It required the owners of what 21<sup>st</sup> century lawyers would call trademarks or service marks<sup>3</sup> to deposit copies of those marks, accompanied by information about their owners and use, in the Patent Office, and it 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.<sup>4</sup> In Rogers's view, all of those matters were the domain of the common law and Congress was powerless to regulate them.<sup>5</sup> 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. 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.<sup>6</sup>

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.*

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3 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...” *Id.* at 421-22.

4 *See id.* at 421-22.

5 *Id.* at 419.

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

—Edward S. Rogers (1914)<sup>7</sup>

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.<sup>8</sup> But Rogers litigated some of the most famous trademark cases decided in the first half of the 20<sup>th</sup> century. Rogers was the lawyer for Bayer Aspirin in *Bayer v. United Drug*.<sup>9</sup> He represented Kellogg's in the court of appeals in the *Shredded Wheat* case,<sup>10</sup> and Aunt Jemima Mills in the *Aunt Jemima* case.<sup>11</sup> Rogers represented Coca Cola in *Coca Cola v. Koke*,<sup>12</sup> 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.<sup>13</sup> He represented the Merriam Webster Dictionary Company in the company's efforts to preserve the Webster's Dictionary mark from genericide.<sup>14</sup> He chaired the American Bar Association's section of Patent, Trade-Mark and Copyright Law, and served

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7 Rogers, *Good Will*, *supra* note 1, at 52.

8 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.

9 *Bayer Co. v. United Drug*, 272 F. 505 (SDNY 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.

10 *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.

11 *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).

12 *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.

13 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).

14 See, e.g., *G. & C. Merriam Co. v. Saalfield*, 190 F. 927 (6th Cir. 1911); *G. & C. Merriam v. Ogilvie*, 170 F. 167 (1<sup>st</sup> 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).

as a delegate for the United States to the Inter-American Trademark Conference.<sup>15</sup> 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.<sup>16</sup> Rogers owned homes in Winnetka, Illinois, Greenwich, Connecticut, and Castine, Maine, and he rented rooms from the New York City Drake Hotel.<sup>17</sup> He belonged to the Sons of the Revolution and the Society of Colonial Wars.<sup>18</sup> His 1918 draft registration card notes that he was tall, and had brown hair and eyes.<sup>19</sup> He apparently attended the Universalist Church,<sup>20</sup> voted Republican,<sup>21</sup> and enjoyed golf and boating.<sup>22</sup> Rogers's study of the history of trademarks led him to develop an interest in medieval heraldic devices.<sup>23</sup> Upon discovering that the University of Michigan had no coat of arms, Rogers commissioned artists to design one.<sup>24</sup> His friends called him Ned and everyone else seems to have called him "Mr. Rogers."<sup>25</sup> Trademark scholars know Edward Rogers as the individual who drafted the text of the Lanham Trademark Protection Act.<sup>26</sup>

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

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15 See Christine Haight Farley, *The Lost Unfair Competition Law*, 110 TMR 739, 758-71 (2020); *E.S. Rogers, Expert on Patent Law*, 74, NY Times, May 23, 1949, at 23.

16 The Chicago law firm Pattishall McAuliffe is the direct descendant of Reed & Rogers, the law firm Rogers co-founded at the turn of the 20<sup>th</sup> 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).

17 See William T. Woodson, *A Profile of Edward S. Rogers*, 62 T.M.R. 177, 187 (1972).

18 See *E.S. Rogers, Expert on Patent Law*, 74, NY Times, May 23, 1949, at 23.

19 See Edward Sidney Rogers Draft Registration card, serial number 503 (Sept. 12, 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).

20 See Chicago Tribune, Sept. 24, 1901, at 9 (wedding announcement).

21 See *Edward Sidney Rogers*, UNIVERSITY OF MICHIGAN RES GESTAE: 1895 SENIOR LAW CLASS 37, 217 (1895).

22 See Woodson, *supra* note 17, at 177-178.

23 See Rogers, *Good Will*, *supra* note 1, at 45-47; Edward S. Rogers, *Heraldic Devices and Trade-Marks*, 1 Trade-Mark News #4, November 1910 at 12.

24 See *A University Coat of Arms*, 35 Michigansian (1931).

25 See Woodson, *supra* note 17, at 178, 188.

26 See, e.g., Farley, *supra* note 15, at 755; Walter J. Derenberg, *The Contributions of Edward S. Rogers to the Trademark Act of 1946 in Historical Perspective*, 62 TMR 189 (1972).

Clause power in 1911,<sup>27</sup> and had in 1916 blessed the government's prosecution under that statute of Rogers's client Coca Cola for adding caffeine to its syrup.<sup>28</sup> When Rogers sought to include a section in his bill that would augment merchants' abilities to combat deceptive marketing, he drew the inspiration for the provision from the Pure Food and Drug Act.<sup>29</sup> 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 21<sup>st</sup> 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)<sup>30</sup>

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

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

29 See *infra* notes 115-127 and accompanying text. 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).

30 Edward S. Rogers, *What Sort of Person is the Consumer?*, 80 *Printers Ink* # 13, Sept. 26, 1912, at 3.

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.<sup>31</sup> Rogers attended the Orchard Lake Military Academy, a high school run by his uncle in a Detroit suburb.<sup>32</sup> He graduated first in his class in 1893,<sup>33</sup> 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.<sup>34</sup> Each year, the students attended lectures in ten core subjects.<sup>35</sup> 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.<sup>36</sup> In 1895, the law school enriched its curriculum by hiring four non-resident lecturers to deliver lectures on specialized subjects.<sup>37</sup> 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,<sup>38</sup> became the law school's first lecturer on the subject of copyright law.<sup>39</sup> 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*,<sup>40</sup> the owner of a plow patent in an infringement suit against an infringing plow coupling,<sup>41</sup> and the Pillsbury flour company in an unfair competition suit against a flour purveyor named L.F. Pillsbury.<sup>42</sup> Rogers attended the lectures, and upon graduating later that year, went to work for Reed's law firm in Chicago.<sup>43</sup> With Rogers's assistance, Reed began to develop a trademark

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31 See James F. Hoge, *Edward S. Rogers – A Memoriam*, 39 T.M.R. 372, 372 (1949); *Capt. Rogers Passes Away*, Detroit Free Press, Oct. 3, 1901 at 5.

32 See Woodson, *supra* note 17.

33 *Cadets Graduate*, 69 Ann Arbor Argus #25, June 23, 1893, at 7.

34 University of Michigan, Law Department 1893-94 Annual Announcement 9 (1893).

35 Juniors attended lectures on Pleading and Practice, Personal Property, Fixtures and Easements, Equity Pleading and Procedure, Bailments, Contracts, Domestic Relations, Torts, Agency, and Partnerships. *Id.* at 12. Seniors attended lectures on Jurisprudence, Evidence, Real Property, Equity Jurisprudence, Criminal Law, Criminal Procedure, Wills, Decedents' Estates, Corporations, and Constitutional Law. *Id.* The law school also offered optional classes on elocution and oratory. *Id.* at 14. See generally ELIZABETH GASPARD BROWN, LEGAL EDUCATION AT MICHIGAN 1859-1959 98-109(1959).

36 1893 Law Department Annual Announcement, *supra* note 34, at 11-12.

37 University of Michigan, Law Department 1895-96 Annual Announcement 9 (1895).

38 See 1879 Michigan Wolverines Football Team, Wikipedia, [https://en.wikipedia.org/wiki/1879\\_Michigan\\_Wolverines\\_football\\_team](https://en.wikipedia.org/wiki/1879_Michigan_Wolverines_football_team) (visited May 4, 2021).

39 1895 Law Department Annual Announcement, *supra* note 37, at 8.

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

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

42 *Pillsbury v. Pillsbury-Washburn Co.*, 64 F. 841 (7<sup>th</sup> Cir. 1894).

43 University of Michigan Law Department, Law Class Directory, Class of '95, University of Michigan (William

practice.<sup>44</sup>

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.<sup>45</sup> Their early trademark clients included Sterling Remedy, maker of Cascarets Candy Cathartic laxative tablets,<sup>46</sup> Wells & Richardson, the producer of Paine's Celery Compound,<sup>47</sup> Dr. Miles Medical Company, the maker of Nervine Tonic,<sup>48</sup> and the Hole-Proof hosiery company.<sup>49</sup> Over the next twenty seven years, they represented Coca Cola,<sup>50</sup> Quaker Oats,<sup>51</sup> Postum Cereal,<sup>52</sup> West Publishing,<sup>53</sup> Underwriters Laboratories, Standard Oil, and the McIlhenny Tabasco sauce company.<sup>54</sup>

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;<sup>55</sup> and published articles in bar journals, trade magazines, and law reviews.<sup>56</sup> Rogers authored articles on unfair trade law, trademark history, the psychology of trademark

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C. Michaels, compiler) 19 (1897).

44 See *Stuart v. F.G. Stewart Co.*, 91 F. 243 (7<sup>th</sup> Cir. 1899); *Pillsbury-Washburn Flour Mills Co. v. Eagle*, 86 F. 608 (7<sup>th</sup> Cir. 1898); *Kathreiner's Malzkafee v. Pastor Kneipp Medicine Co.*, 82 F. 321 (7<sup>th</sup> Cir. 1898); *American Cereal v. Eli Pettijohn Cereal Co.*, 76 F. 372 (7<sup>th</sup> Cir. 1896).

45 See *Woodson*, *supra* note 17, at 177.

46 See *Sterling Remedy v. Gorey*, 110 F. 372 (CC ND Ohio 1901); *Rogers, Good Will*, *supra* note 1, at 134, 178-182, 200.

47 See *Wells & Richardson Co. v. Abraham*, 146 F. 190 (EDNY 1906); *Rogers, Good Will*, *supra* note 1, at 134, 171, 177-78. Paine's Celery Compound contained 21% alcohol by volume as well as cocaine. See William H. Post & John H. McGrath, III, *Patents and Potions: Precursors to Modern Drug Use and Abuse*, 2 *Journal of Drug Issues* 50, 54 (Winter 1972).

48 See *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.

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

50 See, e.g., *Coca-Cola Co. v. Old Dominion Beverage Corp.*, 271 F. 600 (4<sup>th</sup> Cir. 1921); *Rogers, Good Will*, *supra* note 1, at 201.

51 See, e.g., *Kellogg Toasted Corn Flakes v. Quaker Oats*, 235 F. 657 (6<sup>th</sup> Cir 1916).

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

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

54 See *Trappey v. McIlhenny*, 281 F. 23 (5<sup>th</sup> Cir. 1922).

55 See *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 May 9, 2021).

56 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*.

infringement, predatory price cutting, and international trademark agreements, as well as copyright, copyright subject matter, and copyright history.<sup>57</sup> He contributed regular columns to *Printers Ink*, a monthly periodical for the emerging advertising industry.<sup>58</sup> 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.<sup>59</sup>

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.<sup>60</sup> After a series of muckraking exposes of the patent medicine business,<sup>61</sup> Congress enacted the Pure Food and Drug Act,<sup>62</sup> imposing modest truth-in-labelling requirements for the packages of non-prescription drugs.<sup>63</sup> In 1909, the Neuragylene Company (producer of Neuralgine pain medication) purchased Sterling Remedy (the Cascarets Candy Cathartic laxative company), but retained both the Sterling name<sup>64</sup> and its trademark counsel, Reed & Rogers. In 1917, the United States Government confiscated the patents, trademarks and U.S. facilities of the German Bayer

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57 See, e.g., Edward S. Rogers, *The Law of Dramatic Copyright*, 1 Mich. L. Rev. 102 (1902); Edward S. Rogers, *Some Historical Matter Concerning Literary Property*, 7 Mich. L. Rev. 101 (1908); Edward S. Rogers, *Comments on the Modern Law of Unfair Trade*, 3 Ill. L. Rev. 551 (1910); Edward S. Rogers, *Heraldic Devices and Trade Marks*, 1 The Trade Mark News 12 (August 1910).

58 See, e.g., Edward S. Rogers, *How to Prove Your Trade Mark Rights*, 80 Printers' Ink No. 7 (Aug. 15, 1912) at 3; Edward S. Rogers, *One Way to Stop the Foreign Good Will Pirate*, 81 Printers' Ink (Oct. 17, 1912) at 36; Edward S. Rogers, *The Legal Protection of Advertising Ideas*, 81 Printers' Ink (October 31, 1912) at 51.

59 Rogers, *Good Will*, *supra* note 1.

60 Coca Cola replaced the cocaine with caffeine in 1903. See FREDERICK ALLEN, *SECRET FORMULA* 44-47 (1994); Douglas H. Boucher, *Cocaine and the Coca Plant*, 41 Bioscience, No. 2, Feb. 1991, at 72, 74.

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

62 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*, 1 L. & Contemp. Probs. 3 (1933).

63 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.

64 Between 1902 and 1917 Neuragylene 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* 7-8 (1958); Malcolm 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 July 29, 2021).

corporation under the Trading with the Enemy Act.<sup>65</sup> Sterling purchased the assets of the company at auction from the Alien Property Custodian, and began to market Bayer Aspirin, Luminal (phenobarbital), and Novocaine.<sup>66</sup> 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.<sup>67</sup> 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.<sup>68</sup> Most nations had adopted a registration-based trademark system,<sup>69</sup> 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.<sup>70</sup> 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.<sup>71</sup> 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.<sup>72</sup> 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.<sup>73</sup>

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

66 See *The Sterling Story*, *supra* note 64, at 8-11.

67 See *id.* at 11-12.

68 Trademark lawyers and courts viewed the law of trademarks and unfair competition as part of the "general common law" of the United States. See Francis Forbes, Peter Stenger Grosscup, & Arthur 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. 120-23 (1900); *infra* notes 85-104 and accompanying text.

69 See, e.g., William D Shoemaker, *Foreign Registration of American Trademarks*, 4 J.Pat. Offc Soc'y 140 (1921); see generally JOHN H. RUEGE & W.B.GRAHAM, *TRADE MARK LAWS OF THE WORLD* (1922).

70 *McLean v. Fleming*, 96 US 245, 254 (1877); *Derringer v. Plate*, 29 Cal. 293 (1865). See generally FRANCIS H. UPTON, *A TREATISE ON THE LAW OF TRADE MARKS WITH A DIGEST AND REVIEW OF THE ENGLISH AND AMERICAN AUTHORITIES* 46-52 (1860).

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

72 *Trade-Mark Cases*, 100 U.S. 82, 94-95 (1879).

73 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 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

That was an awkward result from the vantage point of the country's international relations.<sup>74</sup> 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.<sup>75</sup> 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.<sup>76</sup> In subsequent cases well into the 20<sup>th</sup> Century, the Supreme Court affirmed that Congress lacked the power to enact substantive trademark law.<sup>77</sup> The federal registration statutes,

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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.

*Id.* at 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.” *Id.* at 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.

*Id.* at 96-97.

74 See Forbes, Grosscup, & Greeley, *supra* note 68, at 103-04 (dissenting Report of Arthur P. Greeley).

75 Zvi Rosen, *Federal Trademark Law From Its Beginnings*, 11 ABA *Landslide* 34 (2019). See Trademarks, US-AH, Nov. 25, 1871, 17 Stat. 917; Trademarks, US-Belg., Dec. 20, 1868, 16 Stat. 765; Trademarks, US-Braz., Sept. 24, 1878, 21 Stat. 659; Trademarks, US-Fr., Apr. 16, 1869, 16 Stat. 771; Trademarks, US-Russ., Jan. 27, 1868, 16 Stat. 725; Trademarks, US-U.K., Oct. 24, 1877, 20 Stat. 703.

76 See 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, *supra* note 68, at 41-54 (majority Report on Trade or Other Marks and Trade or Commercial Names); *id.* at 95-104 (dissenting Report of Arthur P. Greeley).

77 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. See *supra* note 73. Similarly, many infringement disputes arose within the borders of a single state.

however, conferred jurisdiction over common law infringement actions and actions in equity involving federally registered trademarks on federal courts.<sup>78</sup>

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.<sup>79</sup> Trademarks were, and should be, fundamentally creatures of the common law.<sup>80</sup> Rogers argued that people who thought that trademarks were property, the way copyrights or patents were property, were simply 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.<sup>81</sup> 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.<sup>82</sup>

The early 20<sup>th</sup> 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

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78 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.

79 See Edward S. Rogers, *Protection of Industrial Property*, 27 Mich. L. Rev. 491 (1929).

80 See, e.g., Edward S. Rogers, *The Expensive Futility of the U.S. Trademark Statute*, 12 Mich. L. Rev. 660, 674-75 (1914) [hereinafter Rogers, *Futility*].

81 Rogers, *Good Will*, *supra* note 1, at 100. Later on, 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*, 75<sup>th</sup> Cong. 53 (1938) [hereinafter *1938 House Hearings*] (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.

82 E.g., Rogers, *Good Will*, *supra* note 1, at 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.

to apply state law as the rules of decision in common law trials.<sup>83</sup> In 1842, the Supreme Court had held, in *Swift v Tyson*,<sup>84</sup> 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,<sup>85</sup> federal courts deciding trademark and unfair competition cases had developed a national general common law of trademark and unfair competition.<sup>86</sup> Lawyers described that body of law as both uniform across different courts and remarkably stable.<sup>87</sup>

The common law trademark of the 19<sup>th</sup> and early 20<sup>th</sup> century would strike a 21<sup>st</sup> 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.<sup>88</sup> These were known as “technical trademarks.”<sup>89</sup> Other source-designating words, symbols, or designs 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.<sup>90</sup> Surnames were ineligible to be technical trademarks.<sup>91</sup> Service marks and tradenames were not trademarks. Trade dress or packaging did not qualify as a trademark.<sup>92</sup> Advertisements that were not physically

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

84 41 U.S.1 (1842).

85 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; *infra* note 223 and accompanying text.

86 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. 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 William A. Fletcher, *General Common Law and Section 34 of the Judiciary Act of 1789: The Example of Marine Insurance*, 97 Harv. L. Rev 1513, 1516-38 (1984).

87 See, e.g., 1938 House Hearings, *supra* note 81, at 36-48 (testimony of Harrison F. Lyman, Boston Patent Law Association); see generally HARRY D. NIMS, *THE LAW OF UNFAIR COMPETITION AND TRADE-MARKS* (2d ed. 1917); AMASA C. PAUL, *THE LAW OF TRADE-MARKS INCLUDING TRADE NAMES AND UNFAIR COMPETITION* (1903).

88 See, e.g., *Gray v. Armand Co.*, 24 F.2d 878 (D.C. App. 1928); see generally Mark McKenna, *Property and Equity in Trademark Law*, 23 Marquette Intl. Prop. L. Rev. 117, 119-23 (2019).

89 See generally WALTER J. DERENBERG, *TRADE-MARK PROTECTION AND UNFAIR TRADING* 220-324 (1934); Margreth Barrett, *Finding Trademark Use: The Historical Foundation for Limiting Infringement Liability to Uses in the Manner of a Mark*, 43 Wake Forest L. Rev. 893, 904-32 (2008).

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

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

92 See Barrett, *supra* note 89, at 903-11.

attached to tangible products were not trademarks.<sup>93</sup> 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.<sup>94</sup> Indeed, a majority of the reported cases litigated by Reed and Rogers sought injunctive relief for behavior that did not qualify as trademark infringement.<sup>95</sup>

In *Holeproof Hosiery v. Fitts*,<sup>96</sup> 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. 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 defendant from using the phrase NO HOLE and from using a guarantee card "like or similar to that of the complainant."<sup>97</sup>

In *Elgin National Watch Co. v. Loveland*,<sup>98</sup> 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 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.<sup>99</sup>

As idiosyncratic as the common law doctrines may seem to 21<sup>st</sup> 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.<sup>100</sup> The

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93 *See id.* at 909.

94 *E.g.*, *McLean v. Fleming*, 96 U.S. 245, 254 (1877); *see Nims, supra* note 87, at 26-30; Edward S. Rogers, *Note and Comment: The Doctrine of Unfair Trade*, 7 Mich. L. Rev. 409 (1908-09).

95 *See, e.g.*, *Sterling Remedy v. Gorey*, 110 F. 372 (C.C.N.D. OH 1901); Rogers, *Good Will, supra* note 1, at 146-234.

96 167 F. 378 (C.C.D. NJ 1908).

97 167 F. at 379-80. *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).

98 132 F. 41 (C.C.N.D. IA 1904).

99 132 F. at 52; *see generally* Rogers, *Good Will, supra* note 1, at 146-57 (explaining actions for deceptive use of place names).

100 Mark McKenna, *Trademark's Faux Federalism*, in *INTELLECTUAL PROPERTY AND THE COMMON LAW* 288, 290-96 (Shyamkrishna Balganesh, Ed., 2013). <sup>^</sup>See 1928 Hearings at 15 (testimony of Edward S. Rogers); 1939

common law doctrine was flexible, plaintiff-friendly, predictable, and, once a lawyer learned its quirks, intuitive.<sup>101</sup>

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.<sup>102</sup> 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 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.”<sup>103</sup> Meanwhile, influential legal scholars published law review articles that questioned the legitimacy of judicial lawmaking.<sup>104</sup>

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.<sup>105</sup> Registration involved a lot of effort for a record that conferred no substantive

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Hearings at 33 (testimony of Stewart L. Whitman, Nims & Verdi).

101 See EDWARD S. ROGERS, *OUTLINE OF LECTURES ON THE LAW OF TRADE MARKS AND UNFAIR TRADING* 5 (1939) (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*, 76<sup>th</sup> Cong. 166 (1939) [hereinafter *1939 House Hearings*] (testimony of Edward S. Rogers).

102 See WILLIAM J. NOVAK, *THE CREATION OF THE MODERN AMERICAN STATE* 83-107, 113-124 (2022); EDWARD A. PURCELL, *BRANDEIS AND THE PROGRESSIVE CONSTITUTION* 11-114 (2000).

103 Introduction to the Restatement of Torts viii-ix (1934); Arthur L. Corbin, *The Restatement of the Common Law by the American Law Institute*, 15 Iowa L. Rev. 19 (1929). The ALI included the common law of unfair competition and trademarks in its first Restatement of Torts. See Restatement of Torts §§ 708-756.

104 See, e.g., Felix S. Cohen, *Transcendental Nonsense and the Functional Approach*, 35 Colum. L. Rev. 809 (1935); Armistead M. Dobie, *Seven Implications of Swift v. Tyson*, 16 Va. L. Rev. 225 (1930); Jerome Frank, *What Courts Do In Fact*, 26 Ill. L. Rev. 645, 761(1931-32).

105 See, e.g., *Registration of Trademarks: Joint Hearings Before the Comms. On Patents*, 68<sup>th</sup> Cong. 137-42 (1925)

rights.<sup>106</sup> Businesses seeking to export their products needed a federal registration certificate in order to secure trademark protection abroad.<sup>107</sup> For businesses interested only in domestic sales, there was little incentive to register their marks.<sup>108</sup>

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

—Edward S. Rogers (1914)<sup>109</sup>

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.”<sup>110</sup> 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.<sup>111</sup> Instead, the statute set forth registration and examination procedures that were expensive and cumbersome, notwithstanding that registration gave trademark owners no

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[hereinafter *1925 Joint Hearings*] (testimony of Robert Watson, Washington DC); *id.* at 148 (testimony of Arthur Greeley, former member of the 1898 Congressional Commission to Revise the Patent and Trade-Mark Laws); Chauncey P. Carter, *Trademark Interferences: A Proceeding Peculiar to this Country and of Doubtful Utility*, 5 J. Pat. Off. Soc’y 320 (1923); Henry Charles Thomson, *The Trademark File of the US Patent Office; Its 2 Vital Defects and their Correction*, 4 J. Pat Off. Soc’y 74, 125 (1921).

106 See, e.g., 1925 Joint Hearings, *supra* note 105, at 78-80 (testimony of Otto Barnett, Chicago trademark lawyer);

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

108 See, e.g., Carter, *supra* note 105, at 320. Registration did give trade-mark owners the ability to sue in federal court. See *supra* note 78 and accompanying text.

109 Rogers, *Futility*, *supra* note 80, at 674.

110 *Id.* at 665.

111 *Id.* at 672.

enforceable legal rights.<sup>112</sup> 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.<sup>113</sup> There was no need for the federal trademark statute to provide remedies for infringement, because the common law already supplied adequate relief.<sup>114</sup> 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.<sup>115</sup>

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.<sup>116</sup> 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

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112 *Id.* at 672-74.

113 *Id.* at 675.

114 *Id.* at 676.

115 *Id.* at 675. The Food and Drug Act, *see supra* notes 62-63 and accompanying text, 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 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 .

Rogers, *Futility*, *supra* note 80, at 675.

116 *See Rogers, Suggestions*, *supra* note 2.

merchants.<sup>117</sup> Rogers's 1920 speech was an only slightly revised version of his 1914 essay,<sup>118</sup> 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.<sup>119</sup> The most important job a statute could do, 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.<sup>120</sup> 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.<sup>121</sup>

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117 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 our 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, supra* note 81, at 23 (colloquy).

118 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 19-teens reappearing in his speeches and articles in the 1930s and 1940s. *Compare, e.g.,* Edward S. Rogers, *New Directions in the Law of Unfair Competition*, 74 N.Y.L.Rev. 317, 326 (1940) with Edward S. Rogers, *The Unwary Purchaser*, 8 Mich. L. Rev. 613, 615-16 (1910).

119 *See* Rogers, *Suggestions, supra* note 2, at 420-21:

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.

...

A statute 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.

120 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 and, deposit would be a prerequisite to an infringement action. *See id.* at 422.

121 *See Preliminary Draft of a Trade-Mark Act*, 16 Bull. U.S. Trade-Mark Assn. 195, 195 (1921) [hereinafter *Preliminary Draft*]. 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

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.<sup>122</sup> 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.<sup>123</sup> 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.<sup>124</sup> Rogers's draft 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.<sup>125</sup> This change would have allowed the

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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." *Id.* at 207.

122 *See id.* at 195-207.

123 *Compare id.* § 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.

124 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 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.

*Suggestions, supra* note 2, at 416-17 (emphasis in original); *Futility, supra* note 80, at 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, *supra* note 121, at 197, 202.

125 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

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.”<sup>126</sup> (This section was the precursor of the 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.<sup>127</sup>

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-man<sup>128</sup> committee, chaired by Rogers, to refine the draft and report back the following year.<sup>129</sup> 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.<sup>130</sup> 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

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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), *supra* note 121, at 197.

126 *Preliminary Draft* § 27, *supra* note 121, at 205-06:

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.

Rogers borrowed the “false trade description” language from the British Merchandise Marks Act. *See supra* note 115.

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

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

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

130 *See Edward S. Rogers, The Vestal Trade-Mark Bill – Evolution of the “Secondary Meaning” Clause*, 27 Bull. U.S. Trade-Mark Assn. 307, 307-08 (1932) [hereinafter Rogers, *Secondary Meaning*].

commerce.”<sup>131</sup> The committee draft also introduced a new procedure for depositing unregistered marks in the Patent Office, based on Rogers's original proposal.<sup>132</sup> In contrast 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.<sup>133</sup> 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.<sup>134</sup> 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

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131 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.

*Id.* at 18.

132 *See Id.* at 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 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.

133 *Id.* at 23 (Committee Draft § 5).

134 *Id.* at 35 (Committee Draft § 30).

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.<sup>135</sup>

Rogers presented his committee's revised draft at the 1922 ABA annual meeting in San Francisco.<sup>136</sup> 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.<sup>137</sup> The following day, the full ABA voted to endorse the bill, apparently without debate.<sup>138</sup>

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 Pittsburgh Patent Law Association, the Philadelphia Patent Law Association, and the U.S. Patent Office.<sup>139</sup> Rogers revised the bill and revised it again in response to comments and complaints.<sup>140</sup> 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*

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135 *Id.* at 19-20.

136 Report of the 45<sup>th</sup> Annual Meeting of the American Bar Association 505 (1922).

137 *Id.* at 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."

138 *Id.* at 40.

139 See Rogers, *Secondary Meaning*, *supra* note 130, at 308-310; 1925 *Joint Hearings*, *supra* note 105, at 6 (further statement of the ABA Section of Patent, Trade-Mark, and Copyright Law); *id.* at 17-18 (testimony of A.C. Paul, American Bar Association); *id.* at 56- (testimony of Arthur C. Fraser, N.Y Patent Law Assn.).

140 1925 *Joint Hearings*, *supra* note 105, at 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. See *id.* at 19. (S. 2679 § 2(e)). The provision barring suits on behalf of marks not yet deposited or registered was eliminated. See *id.* at 33 (colloquy).

*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)<sup>141</sup>

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.<sup>142</sup> At a joint House-Senate Patent Committee hearing, Rogers described the bill, section by section, and answered the lawmakers' questions.<sup>143</sup> He explained that because Congress's authority to regulate 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.<sup>144</sup> 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.<sup>145</sup> Some raised concerns that changes to the wording in the current statutes might unsettle established common law doctrine;<sup>146</sup> 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.<sup>147</sup> 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,<sup>148</sup> 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

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

142 S. 2679, 68<sup>th</sup> Cong. (1924); H.R. 8637, 68<sup>th</sup> Cong. (1924).

143 *See 1925 Joint Hearings, supra* note 105, at 30-54, 61-64, 70-74, 160-63 (testimony of Edward S. Rogers).

144 *Id.* at 30-31 (testimony of Edward S. Rogers).

145 *See id.* at 54-56 (testimony of James T. Newton, American Patent Law Association); *id.* at 56-77 (testimony of Arthur C. Fraser, New York Patent Law Association); *id.* at 119-34 (testimony of Arthur William Barber, U.S. Trade-Mark Assn.).

146 *See, e.g., id.* at 130-32 (testimony of Arthur William Barber, U.S. Trade-Mark Assn.)

147 *See, e.g., id.* at 78-84 (testimony of Otto Barnett, Chicago trademark lawyer); *id.* at 134-37 (testimony of Robert Watson, Washington DC); *id.* at 146-48 (testimony of Arthur F. Greeley, former member of the 1898 Congressional Commission to Revise the Patent and Trade-Mark Laws); *id.* at 150-51 (testimony of E.L. Rice).

148 *See* S. Rep. No. 1067, 68<sup>th</sup> Cong. (1925).

as H.R. 6248.<sup>149</sup> 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 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.<sup>150</sup> Thomson's campaign persuaded the newly established Boston Patent Law Association to testify in opposition to the bill.<sup>151</sup> Thomson also reached out to the Association of National Advertisers and the National Confectioners Association and secured their opposition.<sup>152</sup> 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.<sup>153</sup>

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

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149 H.R. 6248, 69<sup>th</sup> 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*, 69<sup>th</sup> Cong. 1 (1927) [hereinafter *1927 House Hearings*](testimony of Edward S. Rogers).

150 See *Trade-Marks, Hearings on H.R. 6428 Before the House Comm. On Patents*, 69<sup>th</sup> Cong. 12-20, 37-45 (1926). [hereinafter *1926 House Hearings*] (testimony of Henry C. Thomson).

151 See *id.* at 87-100 (testimony of Harrison F. Lyman, Boston Patent Law Assn.).

152 See *id.* at 53-59 (testimony of Robert K. Leavitt, Assn. of Nat. Advertisers); *id.* at 73-78 (testimony of Walter Hughes, National Confectionary Assn.).

153 *Id.* at 124-27 (colloquy).

common law regime was entirely satisfactory, and a new trademark statute would risk destabilizing it.<sup>154</sup>

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.<sup>155</sup> Karl Fenning, formerly the 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.<sup>156</sup>

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.<sup>157</sup>

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,<sup>158</sup> 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.<sup>159</sup> 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 to telegrams to Congress protesting the legislation.<sup>160</sup>

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

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154 *Eg. id.* at 106-112 (testimony of A.W. Barber, American Trade-Mark Assn.); *id.* at 131-52 (testimony of Robert Watson).

155 *See id.* at 127-29 (testimony of Karl Fenning); *id.* at 164-65 (testimony of Arthur Fraser).

156 *Id.* at 127.

157 *Id.* at 127-31. *See also* Karl Fenning, *Trade Mark Law Desirable*, 8 J. Pat. Off. Soc'y 573 (1926).

158 H.R. 13486, 69<sup>th</sup> Cong. (1926). *See The Vestal Bill: H.R. 6683 – H.R. 11938*, 23 Bull. U.S. Trade-Mark Assn. 43 (1928) [hereinafter *The Vestal Bill*]; Rogers, *Secondary Meaning*, *supra* note 130, at 310-11.

159 *See 1927 House Hearings*, *supra* note 149, at 2-3 (testimony of Edward S. Rogers); *The Vestal Bill*, *supra* note 158, at 44-50.

160 *See 1927 House Hearings*, *supra* note 149, at 25-28 (testimony of Henry C. Thomson).

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.<sup>161</sup> Still, witnesses objected to language that seemed to them to pose a danger of changing or undermining common law doctrine.<sup>162</sup> 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.<sup>163</sup>

Between 1926 and 1932, Representative Vestal introduced seven versions of the bill.<sup>164</sup> 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.<sup>165</sup> In response to those critiques, old language crept back into the legislation.<sup>166</sup> 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.<sup>167</sup> Both the House and Senate passed versions of the bill, but never at the same time.<sup>168</sup>

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.<sup>169</sup>

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.<sup>170</sup> As a Jew and a Democrat, Sirovich had little reason to trust the American Bar Association, which had routinely opposed progressive legislation, and had

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161 See *Registration of Trademarks: Hearing on S. 4811 Before the Senate Comm. On Patents*, 69<sup>th</sup> Cong. 13-14 (1927) (testimony of Edward S. Rogers).

162 See, e.g., *id.*, at 19-22 (testimony of Karl Fenning, American Patent Law Assn.); *id.* at 26-28 (testimony of William S. Greene, Jr., U.S. Trade-Mark Assn.); *id.* at 46-50 (testimony of Robert Watson).

163 See S. Rep. 1576, 69<sup>th</sup> Cong. (1927); H.R. Rep. 2203, 69<sup>th</sup> Cong. (1927); 60 Cong. Rec. 5148 (Feb. 28, 1927).

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

165 See, e.g., *1926 House Hearings*, *supra* note 150, at 64-65 (colloquy).

166 Compare, e.g., H.R. 8637, 68<sup>th</sup> Cong. §2(d) (1924) with H.R. 13486, 69<sup>th</sup> Cong. §2(d) (1926).

167 See Waldon Fawcett, *Reexamining the Basis of Trademark Revision*, 27 Bull. U.S. Trade-Mark Assn. 65, 67 (1932).

168 See DAPHNE ROBERT, *THE NEW TRADE-MARK MANUAL* 228-37 (1947).

169 See, e.g., *1927 House Hearings*, *supra* note 149, at 35 (testimony of Edward S. Rogers)

170 See KURT F. STONE, *THE JEWS OF CAPITOL HILL: A COMPENDIUM OF JEWISH CONGRESSIONAL MEMBERS* 217-220, 998 (2011).

expended significant resources to exclude Jews from the practice of law.<sup>171</sup> Instead of proceeding with the ABA-backed Rogers bill, Chairman Sirovich decided to start fresh.<sup>172</sup> He invited trademark scholar and lawyer Frank Schechter,<sup>173</sup> 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.<sup>174</sup> 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.<sup>175</sup>

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

172 See Waldon Fawcett, *Patent Committee Shake-ups Reset the Legislative Scene*, 27 *Bull. U.S. Trade-Mark Assn.* 1, 3 (1932).

173 In the 1920s and 1930s, Jewish lawyers and Gentile lawyers tended to occupy distinct professional and social spheres. See generally Auerbach, *supra* note 171. 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. See *New Officers of N.Y. City Bar*, 5 *N.Y. St. B.A. Bull.* 465, 467 (1933). 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.

174 See *1932 House Hearings*, *supra* note 141. On the first day of the Hearings, Frank Schechter held forth. *Id.* at 1-34. On the second day, Rogers was invited to testify. *Id.* at 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*, *supra* note 141, at 51-61 (testimony of Henry C. Thomson).

175 *1932 House Hearings*, *supra* note 141, at 32. See Waldon Fawcett, *Reexamining the Basis of Trademark Revision*, 27 *Bull. U.S. Trade-Mark Assn.* 65, (1932). Fawcett reported that Sirovich planned to jettison the perennial Rogers bill in favor of the 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 infringement cases, as in actions under the Sherman Anti-Trust Law; (6) restoration of the perjury provision which

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,<sup>176</sup> Schechter deleted that section and drafted a definition of trademark that was broad enough to encompass service marks and collective marks.<sup>177</sup> 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.”<sup>178</sup> Third, Schechter's bill made willful trademark infringement a misdemeanor.<sup>179</sup> 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.<sup>180</sup> Representative Perkins introduced Schechter's bill as H.R. 11592 on April 25, 1932.<sup>181</sup>

Chairman Sirovich had planned to see whether he and Albert Vestal could come up with a compromise bill.<sup>182</sup> Vestal, who had already introduced the latest version of the Rogers bill on January 6,<sup>183</sup> 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 promise of “a new deal for the American people.”<sup>184</sup> The 73<sup>rd</sup> Congress devoted all of its energy to New Deal economic legislation; the House Patent Committee apparently didn't meet at all.

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appeared in H. R. 2828 but has, for some reason or other, seemingly been omitted in the present H. R. 7118.

*Id.* at 71 (quoting Frank Schechter).

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

177 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.”).

178 See *id.* § 2.

179 See *id.* § 26.

180 See *id.* §§ 18, 25, 26.

181 H.R. 11592, 72d Cong. (1932).

182 See Waldon Fawcett, “Service Marks” – *The Key to Trade-Mark Revision*, 27 Bull. U.S. Trade-Mark Assn. 79, 87-88 (1932).

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

184 See *Text of Governor Roosevelt's Speech at the Convention Accepting the Nomination*, NY Times, July 2, 1932,

Meanwhile, the members of the ABA trademark committee had lost their enthusiasm for Rogers's legislation.<sup>185</sup> 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,<sup>186</sup> 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.<sup>187</sup>

Frank Schechter's response to the ABA's committee's retrenchment was caustic.<sup>188</sup> 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 critique of the trademark statute,<sup>189</sup> and then explained why Congress had ample authority under the commerce clause to enact substantive trademark legislation:<sup>190</sup>

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at 8; *Roosevelt Asks Votes for "New Deal,"* NY Times, Nov. 8, 1932, at 1.

185 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").

186 See 1933 ABA Sec. Pat. Trademark & Copyright L. Comm. Rep, *supra* note 185, at 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.").

187 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.

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

189 See *id.* at 60-61.

190 See *id.* at 67-79; Frank I. Schechter, *Congressional Power with Regard to Trade-Mark Protection*, 31 Bull. U.S. Trade-Mark Assn. 27 (1936).

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.<sup>191</sup>

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.<sup>192</sup> 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,<sup>193</sup> but the trend alarmed Rogers. Frank Schechter's view that Congress's commerce power was more capacious than previously thought looked more and more attractive, or at least expedient.<sup>194</sup>

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.<sup>195</sup>

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191 Schechter, *supra* note 188, at 79.

192 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).

193 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).

194 Frank Schechter died of pneumonia in September 1937. See *Frank Schechter, Lawyer, Dies At 47: Trademark Law Authority and Writer of Many Legal Articles Stricken Here*, NY Times, September 27, 1937, at 21.

195 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

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,<sup>196</sup> but also appended a draft of one possible such bill to his subcommittee's report.<sup>197</sup> 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:

*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

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full authority under the commerce clause and the treat), 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.

196 Report Of The Committee On Federal And State Trade-Mark Legislation, 1937 ABA Sec. Pat. Trademark & Copyright L. Comm. Rep. 23, 24 (1937) [hereinafter *1937 Committee on Legislation Report*]; 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).

197 *1937 Committee on Legislation Report*, supra note 196, at 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) [hereinafter *1937 Sub-Committee Report*].

of any person injured.<sup>198</sup>

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.<sup>199</sup> 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."<sup>200</sup> 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..."<sup>201</sup> Finally, the draft imposed criminal penalties for counterfeiting.<sup>202</sup> The ABA section did not approve the 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.<sup>203</sup>

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

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198 *1937 Sub-Committee Report*, supra note 197, at 29.

199 *1937 Sub-Committee Report*, supra note 197, at 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.").

200 *Id.* § 14 at 32.

201 *Id.* §§ 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, *id.* at 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.

202 *Id.* at 29, 32 ("Sec. 32. The making of any copy, counterfeit or colorable imitation of any registered trademark 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.

203 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).

happened to have brought a draft of a possible statute with him to the meeting.<sup>204</sup> 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)<sup>205</sup>

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 designation/false representation section),<sup>206</sup> and inserted new language that Rogers had written and not yet shared with his ABA colleagues.<sup>207</sup>

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.

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204 See Edward S. Rogers, *The Lanham Act and the Social Function of Trademarks*, 14 Law & Contemp. Probs. 173, 180 (1949).

205 Edward S Rogers, *Unfair Competition*, 35 Trademark Rep. 126, 129 (1945).

206 See H.R. 9041 § 41, 75<sup>th</sup> Cong. (1938).

207 Indeed, the ABA section adopted a resolution disapproving of the bill because the members hadn't seen it before its introduction and hadn't been involved in the revision. See Report of the Section of Patent, Trade-Mark and Copyright Law, 65 ANNU. REP. A.B.A. 361, 362-3 (1940). 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.

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.<sup>208</sup>

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.

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.<sup>209</sup> 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.<sup>210</sup> 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

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208 *1938 House Hearings, supra* note 81, at 13 (testimony of Edward Rogers).

209 *See 1938 House Hearings, supra* note 81, at 51-62 (colloquy); *id.* at 68-71 (colloquy).

210 *See 1938 House Hearings, supra* note 81, at 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 had. Rather than mailing inflammatory postcards, Earl and Arthur joined the American Bar Association, and became active in the ABA's efforts to persuade Congress to enact a trademark statute. By 1940, Earl Thomson had joined the ABA Section committee on Trade-Marks. *See Report of the Committee on Federal and State Trade-Mark Legislation, 1940 ABA Sec. Pat. Trademark & Copyright L. Comm. Rep. 44, 51 (1940) (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, 127-29. (testimony of Earl Thomson).

opponents argued that the changes were pernicious because they would — or might — abrogate the relevant common law doctrine.<sup>211</sup>

From a 21<sup>st</sup> 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 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.<sup>212</sup>

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.<sup>213</sup> The 1939 version of the bill looked much like the Lanham Act that Congress would enact 7 years later.

Rogers drafted and Lanham introduced further iterations of the legislation in 1939<sup>214</sup> and 1941.<sup>215</sup> 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.<sup>216</sup> Later, section members objected to the incontestability and assignment

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211 See, e.g., 1938 House Hearings, *supra* note 81, at 36-48 (testimony of Harrison F. Lyman, Boston Patent Law Association); *see also*, e.g., 1939 House Hearings *supra* note 101, at 21-22 (testimony of Mansfield C. Fuldner, General Foods ); *id.* at 29-31 (testimony of H.J. Savage, National Biscuit Co.).

212 See, e.g., 1938 House Hearings, *supra* note 81, at; 1939 House Hearings, *supra* note 101, at 47(colloquy); *id.* at 70-72 (colloquy).

213 See H.R. 4744, 76<sup>th</sup> Cong. (1939).

214 See H.R. 6618, 76<sup>th</sup> Cong. (1939).

215 See H.R. 102, 77<sup>th</sup> Cong. (1941); H.R. 5461, 77<sup>th</sup> Cong. (1941).

216 See 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

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 trademark law conform to the common law.”<sup>217</sup> A series of informal meetings brokered by Senators Bone, Danaher and Lucas persuaded proponents and opponents of the bill to agree on a grand compromise that required trademark assignments to be accompanied by goodwill, and that tempered the incontestability provisions with enumerated common law defenses.<sup>218</sup>

Meanwhile, the Supreme Court had handed down its decision in *Erie Railroad v. Tompkins*,<sup>219</sup> 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,<sup>220</sup> and it may have been, but, as Mark McKenna and Chris Farley have noted, the decision made little immediate difference in how federal courts decided trademark cases.<sup>221</sup> Rogers would later describe the decision as having caused chaos and uncertainty,<sup>222</sup> but at the time, it didn't seem to worry either Rogers or other members of the trademark bar. Witnesses before Congress didn't refer to the decision as game-changing, and the ABA patent section didn't 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

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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).

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

218 See Report of the Committee on Federal and State Trade-Mark Legislation, 1940 ABA Sec. Pat. Trademark & Copyright L. Comm. Rep. 44, 50 (1940); 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, 77<sup>th</sup> 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*, 77<sup>th</sup> Cong. 58-63 (1941); id. at 69-73 (colloquy).

219 304 U.S. 64 (1938).

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

221 See Farley, *supra* note 15, at 772-75; McKenna, *supra* note 100, at 296-99. See, e.g., *J.C. Penney Co. v. H.D. Lee Mercantile Co.*, 120 F.2d 949, 952n.1 (8<sup>th</sup> Cir. 1941).

222 See Rogers, *Introduction to Robert*, *supra* note 168, at 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.

competition decision brought under diversity jurisdiction. The Court predicated its decision on federal general common law, noting that,

“Most 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.”<sup>223</sup>

Later cases, though, insisted that the lower courts had erred by failing to ascertain the local law.<sup>224</sup> 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.<sup>225</sup> 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.<sup>226</sup> 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.<sup>227</sup> 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.<sup>228</sup> The government ousted Sterling's management, and asked Rogers to take over the company as chairman of the board. Rogers,

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

224 *See 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* Sergei Zlinkoff, *Erie v. Tompkins: In Relation to the Law of Trade-Marks and Unfair Competition*, 42 Colum. L. Rev. 955 (1942).

225 *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, *supra* note 100, at 302.

226 *See, e.g., Dwinell-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 trade-marks 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, *supra* note 100, at 296-99.

227 *See* Zlinkoff, *supra* note 224.

228 *See Drug Trust's Tie With Reich is Cut*, NY Times, Sept. 6, 1941, at 1, 8; *United States v Bayer Co.*, 135 F. Supp. 65 (S.D.N.Y. 1955).

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 section,<sup>229</sup> took over Rogers's duties as the ABA section's custodian of the trademark bill and the designated explainer of its provisions.<sup>230</sup> By then, however, the contours of the bill were set, and only small changes were left to be made.

It's 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 21<sup>st</sup> 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-20<sup>th</sup> century trademark bar would not have recognized that picture.

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229 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*, *supra* note 168, 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 Creighton Peet, *Marks of a Lady*, *New York Herald Tribune*, Nov. 6, 1955, at 25. Professor Glynn Lunney credits (or blames) Commissioner Leeds for allowing the registration of trade dress on the Principal Register. See Glynn S. Lunney, Jr., *The Trade Dress Emperor's New Clothes: Why Trade Dress Does Not Belong on the Principal Register*, 51 *Hastings L.J.* 1131, 1155-62 (2000). Leeds also served briefly as the Reporter for the trademark and unfair competition sections of the Second Restatement of Torts. See *infra* note 239.

230 See, e.g., *Trade-Marks: Hearings on H.R. 82 Before a Subcomm. of the House Patent Comm.*, 78<sup>th</sup> 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.

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.<sup>231</sup> 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,<sup>232</sup> Congress finally enacted the Lanham Act in 1946.<sup>233</sup>

## 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)<sup>234</sup>

Edward Sidney Rogers died at his home in Greenwich Connecticut on May 22, 1949. He was 74 years old.<sup>235</sup> 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.<sup>236</sup> The Court of Appeals for the Ninth Circuit initially

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231 See, e.g., *Trade-Marks: Hearing on S. 895 Before a Subcomm. Of the Senate Patents Comm.*, 77<sup>th</sup> Cong. 12-18 (1942) (testimony of W.H. Martin, trademark lawyer and ABA section member); *1925 Joint Hearings*, *supra* note 105, at 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.")

232 See Walter J. Derenberg, *The Lanham Trade-Mark Act and Its Impact on the Drug Industry*, 29 J. Patent Off. Socy 469, 473-79 (1947).

233 Pub. L. 79-489 (1946), 60 Stat. 427 (codified as amended at 15 USC §§ 1052-1141n). See Robert, *supra* note 168, at 235-37.

234 Edward S. Rogers, *Introduction* to Robert, *supra* note 168, at xii.

235 See *E.S. Rogers, Expert on Patent Law*, 74, NY Times, May 23, 1949, at 23.

236 Edward S. Rogers, *New Concepts of Unfair Competition Under the Lanham Act*, 38 Trademark Rep. 259 (1948); see Farley, *supra* note 15. Section 44, embodied Title IX of the Act, entitled INTERNATIONAL CONVENTIONS. Subsections h and i provided:

(h) Any person designated in paragraph (b) of this section as entitled to the

adopted this view, but other courts of appeals found the Ninth Circuit's analysis unpersuasive.<sup>237</sup> Federal courts continued to decide common law unfair competition cases, purporting to apply their interpretations of what state courts would decide.<sup>238</sup> The putative state law of unfair competition as divined by federal judges grew more robust and expansive,<sup>239</sup> until, in 1964, the Supreme Court held that state unfair competition law was constrained by federal preemption.<sup>240</sup> Justice Black's broadly worded decisions appeared to mow down much of the once-federal, now state unfair competition law.<sup>241</sup> That sent lawyers

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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, supra* note 101, at 166-67 (testimony of Edward Rogers).

237 The 9<sup>th</sup> 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 (9<sup>th</sup> Cir. 1950). Other circuits, though, declined to follow the 9<sup>th</sup> Circuit's lead. *See, e.g., American Auto Ass'n v. Spiegel*, 205 F.2d 771, 775 (2<sup>d</sup> Cir. 1953); *L'Aiglon Apparel, Inc. v. Lana Lobell, Inc.*, 214 F.2d 649, 651-54 (3<sup>d</sup> Cir. 1954). *See generally* Walter J. Derenberg, *Federal Unfair Competition Law at the End of the First Decade of the Lanham Act: Prologue or Epilogue*, 32 N.Y.U. L. REV. 1029, 1031 (1957); Sharon K. Sandeen, *The Erie/Sears/Compco Squeeze: Erie's Effects on Unfair Competition and Trade Secret Law*, 52 Akron L. Rev. 423, 437-38 (2018).

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

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

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).

240 *Sears, Roebuck & Co. v. Stiffel*, 376 US 225 (1964); *Compco v. Day-Brite Lighting*, 376 US 234 (1964). *See generally* Daphne R. Leeds, Milton Handler, Walter J. Derenberg, Ralph S. Brown & Paul Bender, *Symposium: Product Simulation: A Right or a Wrong*, 64 Colum. L. Rev. 1178 (1964); Sandeen, *supra* note 237, at 440.

241 *See, e.g.,* *Spangler Candy v. Crystal Pure Candy Co.*, 353 F.2d 641, 645-46 (7<sup>th</sup> Cir. 1965); Sandeen, *supra* note 237, at 440-41.

and federal judges scurrying to section 43(a) of the Lanham Act,<sup>242</sup> which soon grew to provide a capacious and well-appointed home for unfair competition claims of all sorts.<sup>243</sup> 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.<sup>244</sup>

Following that decision, the federal courts saw an explosion of cases brought under section 43(a) claiming infringement of unregistered product features.<sup>245</sup> Courts responded by affording more expansive protection under 43(a) to unregistered marks than had previously been available to registered marks.<sup>246</sup> The robust protection available for unregistered marks has given potential litigants ample strategic reason to skip the bother of registration.

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.<sup>247</sup> They continue to find it bewildering, even after

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242 See, e.g., Walter J. Derenberg, *The Twentieth Year of Administration of the Lanham Trademark Act of 1946: Section 43(a) of the Lanham Act*, 57 Trademark Rep. 729 (1967); Walter J. Derenberg, *The Twenty-Third Year of Administration of the Lanham Trademark Act of 1946: Section 43(a) of the Lanham Act*, 60 Trademark Rep. 459 (1970); Annual Review Committee, *The Thirtieth Year of Administration of the Lanham Trademark Act of 1946: Section 43(a) of the Lanham Act*, 67 Trademark Rep 534 (1977); Darryl M. Springs & Tom Arnold, *The Law of Unfair Competition: The Impact of Lanham Act Section 43(a)*, 49 J. Pat. Off. Soc'y 348 (1967).

243 See, e.g., McCarthy, *supra* note 220; McKenna, *supra* note 88, at 124-33.

244 *Two Pesos v. Taco Cabana*, 505 U.S. 763 (1992) (holding that unregistered but inherently distinctive trade dress is protectable as a mark under § 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 was 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. *Id.* at 765-66. The trial court entered an injunction and awarded damages; the Fifth Circuit affirmed. *Id.* 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. *Id.* at 773-75.

245 See Graeme B. Dinwoodie, *Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress*, 75 N.C. L. Rev. 471, 478-79 (1997).

246 See Robert C. Denicola, *Freedom to Copy*, 108 Yale L.J. 1661, 1670-73 (1999); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 Yale L.J. 1687, 1700-01 (1999).

247 See, e.g., *Union Carbide v. Ever-Ready, Inc.*, 531 F.2d 366, 373-77 (7<sup>th</sup> Cir. 1975) (collecting cases). See generally Rebecca Tushnet, *Fixing Incontestability: The Next Frontier*, 23 B.U. J. Sci. & Tech. L. 434, 440-449

two Supreme Court attempts to clarify the law.<sup>248</sup> Trademark owners find it confusing. The Patent and Trademark Office appears not to take it very seriously.<sup>249</sup> Between the various enumerated defenses and exceptions to incontestability included in the Lanham Act,<sup>250</sup> and the need for the owners of all registered marks, even incontestable ones, to prove likelihood of confusion to recover for trademark infringement,<sup>251</sup> the advantages provided by incontestability turn out to be useful for marks that are not, in fact, distinctive of the products they identify,<sup>252</sup> 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.<sup>253</sup>

## 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)<sup>254</sup>

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

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(2017).

248 See *Park N Fly v. Dollar Park and Fly*, 469 U.S. 189 (1985); *K.P. Permanent Makeup v. Lasting Impressions*, 543 U.S. 111 (2004).

249 See Tushnet, *supra* note 247, at 449-50.

250 See 15 U.S.C. § 1115(b).

251 See, e.g., *K. P. Permanent Makeup*, 543 US at 117-18.

252 See Tushnet, *supra* note 247, at 450.

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

254 1939 House Hearings, *supra* note 101, at 166 (testimony of Edward S Rogers).

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 unquenchable. 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.

Congress has revisited and amended the Lanham Act eleven 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.<sup>255</sup> Key doctrines, like the scope of actionable likelihood of confusion, the nature of distinctiveness, and the scope of defenses, remain largely judge-made.<sup>256</sup> Judges apparently feel 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.<sup>257</sup>

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.<sup>258</sup> The expansive scope

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255 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 USPQ 2d (BNA) 265039 (TTAB 2019); *see generally* Barrett, *supra* note 89.

256 *See, e.g.,* Barton Beebe, *An Empirical Study of the Courts' Multifactor Tests for Trademark Infringement*, 94 Cal. L. Rev. 1581 (2006); Stacey Dogan & Mark Lemley, *Parody as Brand*, 47 U.C. Davis L. Rev. 473 (2013); Jeremy Sheff, *Veblen Brands*, 96 Minn. L. Rev. 769 (2012).

257 *See, e.g.,* Anheuser Busch v. Balducci Publications, 28 F.3d 769 (8<sup>th</sup> Cir. 1994); White v. Samsung Electronics America, Inc., 989 F.2d 1512 (9<sup>th</sup> 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).

258 *See, e.g.,* Robert G. Bone, *Taking the Confusion Out of Likelihood of Confusion: Toward a More Sensible Approach to Trademark Infringement*, 106 NW. U. L. Rev. 1307, 1336-47 (2012); Stacey L. Dogan, *Principled Standards vs. Boundless Discretion: A Tale of Two Approaches to Intermediary Liability Online*, 37 Colum. J. L. & Arts 502 (2014); Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 Stan. L. Rev. 413, 438-43

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.<sup>259</sup>

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.

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(2010); Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 Yale L.J. 1717, 1721-31 (1999); William McGeeveran & Mark P. McKenna, *Confusion Isn't Everything*, 89 Notre Dame L. Rev. 253 (2013).

<sup>259</sup> *Accord* McKenna, *supra* note 88.