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BOOK REVIEW

STATE TRADEMARK AND UNFAIR COMPETITION LAW

by The United States Trademark Association

Clark Boardman Company, Ltd.

New York, New York, 1987, 1989, 1990.

Reviewed by Jeffrey E. Jacobson*

How do you review a book where there are no comparables? In the field of state trademark and unfair competition law, to my knowledge no other single volume nor set of books compiles the same amount of information as efficiently as the loose leaf volume *State Trademark and Unfair Competition Law* by the United States Trademark Association.

Through use of this volume and its revisions, any individual who has a basic intellectual property background will be able to understand any particular state's unique approach to trademark¹ and servicemark regulation as well as unfair competition laws. Each pertinent statute is broken down into basic components, and the applicable case law (including citations) is interwoven into each section providing for thorough coverage of any issue. *State Trademark and Unfair Competition Law*, together with its updates, is the most current "authority" on state trademark law.

The United States Trademark Association produced this encyclopedic volume and must be commended for this valuable tool.² The U.S.T.A. used various intellectual property law firms to author particular chapters. The book's success turns on the fact that each contributing firm has addressed the law of its respective state, territory, or, as in the case of Puerto Rico, commonwealth. This brings realistic practical experience to an area too often monopolized by publications emanating from scholarly theorists. Pragmatic questions and vital areas are addressed in a clear and concise manner.

Most importantly, this book is written in plain English rather than "legalese" and eliminates any confusion that may exist within a poorly worded statute or in an ambiguous opinion. The insight of each local author and/or group of authors facilitates practical comprehension of local variations and practice. The local intellectual

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1. A trademark is a mark (symbol, logo, phrase, name, series of sounds, series of colors, and similar identifying codes) which designates the origin of goods. A servicemark is similar, but identifies the originators of services.

2. The only source containing similar information is in the United States Law Digest volume of the Martindale-Hubbell series.

property practitioners emphasize the key provisions and variations of each territory. The result is clear and detailed articulation of the state rules for practitioners.

The book is a useful tool because it includes practical information such as registration fees, important telephone numbers and addresses, as well as complete details as to what documentation is necessary for each registration. Of course, each state's term of trademark registration, qualification for servicemark applications, and renewal procedures are included as well. Local variations on certification marks and collective mark registrations are also addressed. The book also includes the procedural requirements of each state to reserve a name, for corporate purposes. The fees and length of time for such reservations are clearly spelled out. Additionally, the local fictitious name statutes are dissected and explained. Such information is extremely useful to the arts attorney. For example, an east coast lawyer can easily discern the west coast laws and variations in order to successfully and rapidly analyze a west coast situation.

Every chapter is uniformly structured, thus permitting the practitioner to compare easily and index the various approaches of different jurisdictions to one issue of the law. This outline format allows rapid cross-referencing of variations in local rules and regulations. The convenience and time saved due to these inclusions are obvious to attorneys, especially to those in this field. This is especially useful when confronted with an agreement for your client governed by another jurisdiction's laws. In that case, this reference book can quickly answer practical questions.

Each chapter focuses upon a state of the union (Puerto Rico and Washington, D.C. are also covered). The Chapters are broken up into specific subject areas, with further subdivisions. The most important areas are: a) State Trademark Registration Statute; b) Dilution; c) Unfair Business Practices Acts (popularly known as the "Little F.T.C. Acts"); d) Uniform Deceptive Trade Practices Act; e) Trademark Counterfeiting; f) Corporate Name Reservation Prior to Incorporation; g) State Statutory and/or Common Law Unfair Competition or Passing Off Provisions; and h) Franchising or Business Opportunity Statutes.³ The explanations of each area's unfair business and uniform deceptive trade practice acts are a jewel for an advertising company counsel's library. Beyond trademarks, the information compiled on state variations in fictitious name registration, franchising, and corporate formalities is quite useful as a desk book for these areas. The listings disparagement, publicity, and unfair competition are a boon to the litigator. Local variations in these

3. Also included are False Advertising, Trade Name Registration (Fictitious Name Statutes), Statute of Special Application and Personal Name Statutes, Right of Publicity, Criminal Statutes, and Trade Disparagement or Trade Libel.

common law areas are so tremendous that a reference volume such as the one here examined pays for itself at the first instance of use. This makes this tome a valuable starting point for pre-suit litigation analysis. Moreover, since localities have significant variations, the information, indexed in this form, is extremely valuable.

The area of state trademark registrations has had an astonishingly minimal amount of attention. Little to no case law can be found exposing the value of these registrations.⁴ It is simple business that most disputes would involve federally registered marks. Any controversies that justify significant legal fees would generally also merit the extra expense of federal registration.⁵ Therefore, most situations of any consequence do not involve solely a state registration.⁶ This means that the odds of state registration issues meriting judicial scrutiny are slim. The odds lose the financial test. Yet, a mark which is not utilized in interstate commerce may not generally be registered by the United States Patent and Trademark Office. Consequently, situations involving only state registration are rare. There are few reported decisions which even discuss state and federal regulations.⁷

Even though Congress, through 15 U.S.C. sec. 1127 (the "Lanham Act"), has established the policy of prohibiting the interference of states with those rights afforded to federally registered trademarks,⁸ there are still many unanswered questions. Despite the incorporation and federalization of state trademark law by the Lanham Act, questions such as the full implications of state registered marks remain untested and unknown. Unfortunately, it is the economic realities which result in most trademark controversies involving marks on the federal principal or secondary register. It is the exception rather than the rule to meet a mark with state registration without a pending federal application in at least one category of goods.

In the past, the Supreme Court has clarified that the federal patent law preempts state trademark protection on industrial designs.⁹ The preemption of some unfair competition by copyright laws is also established by a significant amount of precedent. The Lanham Act

4. See, e.g., *Fotomat Corp. v. Interstate Mail Film Service, Inc.*, 15 F.R. Serv. 2d 614 (N.D. Ind. 1971); *Creager v. Russ Togs, Inc.*, 218 U.S.P.Q. 582 (C.D. Cal. 1982).

5. See generally *Fletcher, Joint Registration of Trademarks and the Economic Value of a Trademark System*, 36 U. Miami L. Rev. 297 (1981).

6. See generally *Lee and Livingston, The Road Less Traveled: State Court Resolution of Patent, Trademark, or Copyright Disputes*, 19 St. Mary's L.J. 703 (1988).

7. See *Davidoff Extension S.A. v. Davidoff Comercio E Industria Ltda.*, 747 F. Supp. 122 (D.C.P.R. 1990).

8. *Burger King of Florida, Inc. v. Hoots*, 403 F.2d 904 (7th Cir. 1968).

9. See generally *Dratler, Trademark Protection for Industrial Designs*, 1988 U. Ill. L. Rev. 887.

incorporates and federalizes these state trademark laws.¹⁰

There have been many proposals in this area. One meriting scrutiny is the suggestion of having federally registered regional marks.¹¹ Such a system would be an interesting compromise between the federal and state systems.

Since the federal trademark filing fee has increased from \$35.00 to \$175.00 in just a few years, state registrations have become more widely utilized.

Since a state trademark registration is relatively simple and inexpensive as well as often being obtainable for a relatively non-distinctive mark, it may have some value to local distributors of goods if only in the fact that possible infringers may accord the existence of such a registration greater legal right than that to which it is entitled. National distributors generally will find the cost of numerous state registrations more than offsets their value, particularly in instances in which a federal registration can be obtained.¹²

In the past, it was easier and less expensive to apply for a federal registration. However, increased costs and the complexity inherent to federal regulations have induced many individuals to utilize the comparative ease and availability of state registration procedures which are inexpensive alternatives, despite their minimal protection. This change in costs and filing fees has resulted in increased interest in state regulation schemes and makes *State Trademark and Unfair Competition Law* a necessary authority and addition for every practicing intellectual property attorney's library.

10. See, e.g., *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 915-17 (9th Cir. 1980). See also Davis, *Death of a Salesman's Doctrine: A Critical Look At Trademark Use*, 19 Ga. L. Rev. 233, 246 (1985).

11. Carter, *The Trouble with Trademark*, 99 Yale L.J. 759, 796-99 (1990).

12. E.C. VANDENBURGH, *TRADEMARK LAW AND PROCEDURE*, at 63 (2d ed. 1968).