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ESSAYS

Foreword

Half a Century of Federal Trademark Protection: The Lanham Act Turns Fifty

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A fiftieth anniversary is always special: on such an occasion, spouses might renew their wedding vows; an employee might receive a gold watch; or a birthday celebrant might fall victim to a surprise party, complete with champagne and good-natured ribbing. Among other events, 1996 marks the fiftieth anniversary of the Lanham Act.¹ Ordinarily, few would be so endeared as to acknowledge the half-century mark of a statute; then again, few would suggest that the Lanham Act is an ordinary law.

The Lanham Act is a comprehensive federal statute governing trademark law, the purpose of which is most commonly stated as guarding the trademark owner against trademark infringement and unfair competition, and the public against confusion and inaccurate information.² The

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1. Trademark Act of 1946 ("Lanham Act"), ch. 540, 60 Stat. 427 (codified as amended at 15 U.S.C.A. §§ 1051-1127 (West. Supp. 1996)).

2. See, e.g., *Wallace & Co. v. Repetti, Inc.*, 266 F. 307, 309 (2d Cir. 1920), *cert. denied*, 254 U.S. 639 (1920) ("In addition to the benefit accorded the owner of a trade-mark, it is the purpose of the trade-mark law to confer a benefit upon the ultimate consumer."); *Birthright v. Birthright Inc.*, 827 F. Supp. 1114, 1133 (D.N.J.

Act thus serves to balance the interests of a consuming public, the business community, and fair competition.³ In passing the Lanham Act, Congress assured United States citizens, for the very first time, national protection against exposure to confusingly similar trademarks;⁴ Congress also secured to a trade-

1993) (stating that trademark law as embodied in the Lanham Act serves both the public interest “by protecting consumers from false and misleading representations concerning source, identity, or quality of product service” and the trademark owner by protecting “his or her product or service identified by a distinct name or label”); *Mechanical Plastics Corp. v. Titan Technologies, Inc.*, 823 F. Supp. 1137, 1143 (S.D.N.Y. 1993), *aff’d*, 33 F.3d 50 (2d Cir. 1994) (“Trademark laws are designed, in part, to protect marketer who owns trademark, but the overriding concern has always been to protect the purchasing public from confusing the product it desires to purchase with a similar product from a different source.”) (citation omitted); *Windsor, Inc. v. Intravco Travel Centers, Inc.*, 799 F. Supp. 1513 (S.D.N.Y. 1992). The *Windsor* court noted:

The purpose of trademark law is to protect three different interests: (1) the trademark owner’s interest in not having the good reputation associated with its mark from being tarnished by inferior merchandise of another user, (2) the owner’s interest in being able to enter a related field at some future time, and (3) the public’s interest in not being misled by confusingly similar marks.

799 F. Supp. at 1520 (citing *Scarves By Vera, Inc. v. Todo Imports, Ltd.*, 544 F.2d 1167, 1172 (2d Cir. 1976)).

3. See S. REP. NO. 1333, 79th Cong., 2d Sess. 4 (1946), *reprinted in* 1946 U.S.C.C.A.N. 1274, 1275 (“To protect trade-marks, therefore, is to protect the public from deceit, to foster fair competition, and to secure to the business community the advantages of reputation and good will by preventing their diversion from those who have created them to those who have not.”).

4. Edward S. Rogers, *Introduction*, in DAPHNE ROBERT, *THE NEW TRADE-MARK MANUAL* xvi-xvii (1947); see S. REP. NO. 1333, *supra* note 3, at 1, *reprinted in* 1946 U.S.C.C.A.N. at 1274 (explaining the goal of the Lanham Act as “protect[ing] the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get”).

The Lanham Act sought to remedy the problems arising from the inconsistency in state law and the lack of a uniform federal trademark law which resulted in, among other things, business persons having differing trademark rights in the varying states. See Patrick E. Boland, *Wrongful Assault on the Trademark System*, 1987 COLUM. BUS. L. REV. 153, 156 (1987) (“Prior to the passage of the Lanham Act, there was much frustration in the business community regarding the lack of uniformity in enforcing trademark rights throughout the United States.”). This lack of uniformity among the states in protecting trademark owners’ rights was the result of the Supreme Court’s decision in *Erie Rail Road v. Tompkins*, 304 U.S. 64 (1938), which held that there is no federal common law, and therefore required federal courts to apply the law of the state in which they sat in state law diversity actions. *Id.* The Senate Committee report on the

mark's owner the goodwill associated with its mark,⁵ and prevented diversion of trade through commercial misrepresentations. Above all, the Lanham Act is lauded for this balance of trademark law policies: "consumer protection, property rights, economic efficiency and universal concepts of justice"⁶

The Lanham Act has never had the opportunity to grow stale. Revisions began in 1948,⁷ only two years after the Act was passed, and have continued throughout the past fifty years, the most recent being an amendment passed in July, 1996.⁸ The purpose of amending the Lanham Act has often been "to create comity with non-U.S. trademark laws in the context of trade negotiations."⁹ Regardless of the particular purpose, though, the result of such amendments has always been the same: an effective expansion of the Act to meet changing societal needs.

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Lanham Act notes a related reason for, and expresses the import of, passing a national trademark law:

[T]rade is no longer local, but is national. Marks used in interstate commerce are properly the subject of Federal regulation. It would seem as if national legislation along national lines securing to the owners of trade-marks in interstate commerce definite rights should be enacted and should be enacted now.

S. REP. NO. 1333, *supra* note 3, at 4, *reprinted in* 1946 U.S.C.C.A.N. at 1277.

5. *See id.* at 3-5, *reprinted in* 1946 U.S.C.C.A.N. at 1277 (stating that the purpose of the Lanham Act is to protect manufacturers' good will and prevent diversion of trade through misrepresentation).

6. 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2.01[2] (3d ed. 1992 & Supp. 1996).

7. *See* Act of June 25, 1948, ch. 646, § 46(c), 62 Stat. 869 (1949) (codified as amended at 15 U.S.C. § 1121) (substituting the language "court of appeals" with "circuit court of appeals").

8. *See* Anticounterfeiting Consumer Act of 1996, Pub. L. No. 104-153, 110 Stat. 1386 (1996) (to be codified at 15 U.S.C. §§ 1116(d)(9), 1117(c)) (permitting trademark owners to opt for judicially determined statutory damages in an anti-counterfeiting suit).

9. Anne Haring, *Principles of Trademark Law*, in UNDERSTANDING BASIC TRADEMARK LAW 1996, at 7, 11-12 (PLI in Pats., Copyrights, Trademarks, and Literary Prop. Course Handbook Series No. 451, 1996); *see also* S. REP. NO. 1333, *supra* note 3, at 4, *reprinted in* 1946 U.S.C.C.A.N. at 1277.

Law Journal is honored to present this collection of essays exploring issues of trademark law that surround the fiftieth anniversary of the Lanham Act. The anniversary inspires many to reflect upon a career devoted to intellectual property law and policy; it inspires others to recommend changes to the application of the Act, thereby ensuring the statute maintains its vigor and continues to address the changing face of global competition. As Professor Joseph Garon points out in the lead essay, *The Lanham Act: A Living Thing*,¹⁰ “[t]he beauty of the Lanham Act, like the Constitution, is its ability to fit the times.”¹¹ Professor Garon highlights the Act’s extraordinary ability to evolve in response to “vast and unpredictable changes in society”¹²

In *Fifty Years of the Lanham Act: A Retrospective of Section 43(a)*,¹³ Ethan Horwitz and Benjamin Levi highlight key areas in which section 43(a) of the Act (“section 43(a)”) ¹⁴ has expanded over the past half-century. Originally interpreted as forbidding only “passing off,” or the infringement or unauthorized use of a mark, section 43(a) has grown—by way of judicial interpretation and congressional amendment—to prohibit false advertising, including trade libel and product disparagement, and infringement of common law marks and trade dress. Messrs. Horwitz and Levi conclude that the continued debate over the scope of section 43(a) “will not diminish its importance in litigation related to unfair competition.”¹⁵

The remaining essays in this collection focus on current and developing challenges to the Lanham Act. Carl Opedahl’s essay, *Analysis and Suggestions Regarding NSI Do-*

10. Joseph D. Garon, *The Lanham Act: A Living Thing*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 55 (1996).

11. *Id.* at 56.

12. *Id.*

13. Ethan Horwitz & Benjamin Levi, *Fifty Years of the Lanham Act: A Retrospective of Section 43(a)*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 59 (1996).

14. 15 U.S.C.A. § 1125(a) (West Supp. 1996).

15. Horwitz & Levi, *supra* note 13, at 60.

main Name Trademark Dispute Policy,¹⁶ discusses the application of trademark law to the Internet—an exciting and rapidly advancing communication medium. As Mr. Oppedahl explains, traditional notions of trademark policy clash with technical limitations of the Internet. Mr. Oppedahl argues that the current regime for resolving the trademark disputes that inevitably follow from this fundamental conflict is inadequate, and offers numerous suggestions for resolving this issue.

In *The Federal Trademark Dilution Act of 1995: Substantial Likelihood of Confusion*,¹⁷ Eric Prager analyzes the new federal trademark dilution statute—one of the most recent amendments to the Lanham Act. Mr. Prager discusses the new requirements imposed by the federal dilution law over and above those of the state statutes, and concludes that there are substantial differences between the new federal statute and the existing state statutes of which courts and practitioners must be aware.

Finally, in *The Trademark Office as a Government Corporation*,¹⁸ Professors Jeffrey Samuels and Linda Samuels discuss the current organizational structure of the U.S. Patent and Trademark Office (“PTO”). Specifically, they examine whether the policies and objectives of trademark law might better be served, at least from an administrative standpoint, were Congress to remove Trademark Operations from the PTO and establish a government corporation wholly devoted to those operations. As Mr. and Mrs. Samuels argue persuasively, a government corporation would provide Trademark Operations with the regulative freedom “to respond to an ever-increasing workload and to function in a

16. Carl Oppedahl, *Analysis and Suggestions Regarding NSI Domain Name Trademark Dispute Policy*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 73 (1996).

17. Eric A. Prager, *The Federal Trademark Dilution Act of 1995: Substantial Likelihood of Confusion*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 121 (1996).

18. Jeffrey M. Samuels & Linda B. Samuels, *The Trademark Office as a Government Corporation*, 7 FORDHAM INTELL. PROPERTY, MEDIA & ENT. L.J. 137 (1996).

more business-like manner.”¹⁹

The Lanham Act has become a prominent feature of the topography of global intellectual property law. The *Journal* presents this collection of essays to highlight the fiftieth anniversary of the Act, and to foster continued debate as to the future of U.S. trademark law.

19. *Id.* at 137.