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The Lanham Act: A Living Thing

Joseph D. Garon*

From its very inception, the Lanham Act (“Act”)¹ was hailed as a significant victory for everyday business. Commenting on the then recently passed Act, Edward S. Rogers,² in his introduction to Daphne Leeds’³ book, *The New Trade-Mark Manual*,⁴ stated that “[t]he Lanham Act is the embodiment of the purpose to secure to every businessman the advantage which public preference for his goods gives to him and to protect him in the exclusive right to the names and marks which perpetuate the good will which merit earns.”⁵

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1. Trademark Act of 1946 (“Lanham Act”), Pub. L. No. 79-489, 60 Stat. 427 (1946) (codified as amended at 15 U.S.C.A. §§ 1051-1127 (West Supp. 1996)). The Lanham Act is named after Fritz Garland Lanham, the congressman who introduced the legislation into Congress.

2. Mr. Rogers was Chairman of the Patent and Trade Mark Association of the American Bar Association (“ABA”), and was a member of the ABA Committee appointed to investigate alternatives to trademark legislation existing in the 1930s. John F. Hyland & Ted C. Lindquist, III, *Torts: White v. Samsung Electronics America, Inc.: The Wheels of Justice Take an Unfortunate Turn*, 23 GOLDEN GATE U.L. REV. 299, 310 (1993); Scott E. Baxendale, *Growing Pains For The Board Of Patent Appeals And Interferences: A Plan For Restoring Judicial Independence*, 29 J. MARSHALL L. REV. 171, 197 n.196 (1995). Mr. Rogers also drafted an early version of the Lanham Act and authored a classic 1914 text on trademarks. See Hyland & Lindquist, *supra*, at 310; see generally EDWARD S. ROGERS, GOOD WILL, TRADE-MARKS AND UNFAIR TRADING (1914).

3. Daphne Leeds (*née* Robert) was the Assistant Commissioner of Patents under Commissioner Robert Watson. See Hon. Giles S. Rich, *Reflections From a Federal Judge; Three Instrumental Contributors Lauded*, N.Y. L.J., Dec. 2, 1996, at S3. She was also a former member of the ABA Committee on Trade-Mark Legislation. See *Trademarks: Hearings on H.R. 82 Before the Subcomm. of the Senate Comm. on Patents*, 78th Cong., 2d Sess. 24 (1944).

4. DAPHNE ROBERT, *THE NEW TRADE-MARK MANUAL: A HANDBOOK ON PROTECTION OF TRADE-MARKS IN INTERSTATE COMMERCE* (1947). Ms. Leeds’ book has the distinction of being the first publication to discuss the Lanham Act. Rich, *supra* note 3, at S3.

5. Edward S. Rogers, *Introduction*, in *THE NEW TRADE-MARK MANUAL*, *supra*

As we look back over fifty years, we see how true a prophesy Mr. Rogers' words were.

The beauty of the Lanham Act, like the Constitution, is its ability to fit the times.⁶ Despite vast and unpredictable changes in society and, more particularly, the business world, the Act has provided a flexible legal framework within which to regulate competition in the marketplace. Just as the spelling of "trademark" has evolved,⁷ so too has the application of the Lanham Act. The Act's evolution has been measured, constructive and imaginative, and has reflected a growth in the function of trademarks to more accurately reflect modern society.⁸ Few in 1946, for example,

note 4, at xx-xxi.

6. Randy Lipsitz, *Judging by Appearance: How the Lanham Act Protects Product Shapes; Issue Continues to Confound Lawyers*, N.Y. L.J., Dec. 2, 1996, at S4 ("Like our U.S. Constitution which was drafted by the framers to be applicable and adaptable in any age, so too can the Lanham Act be interpreted to apply to current legal problems and to deal with changing political, economic and moral issues.").

7. "Trade-mark," as it appears in both the Lanham Act and the title of Ms. Leeds' work, has evolved to "trademark."

8. Historically, a trademark's sole function was to designate the source of the product. See 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3.03[1] (3d ed. 1992 & Supp. 1996); ROBERT, supra note 4, at 5; Thomas D. Drescher, *The Transformation and Evolution of Trademarks—From Signals to Symbols to Myth*, 82 TRADEMARK REP. 301, 309-20 (1992) (explaining that trademarks were originally developed by medieval European guilds to serve as indications of source and to protect against the diversion of trade or the invasion of the monopoly of the guild); *General Motors Corp. v. Cadillac Marine & Boat Co.*, 226 F. Supp. 716 (W.D. Mich. 1964) ("Law of trademarks was originally designed to protect the trademark owner from diversion of customers who otherwise would have purchased from him."). Nonetheless, with the growth of domestic and international trade, the function has expanded to include, in addition to identification of origin, both a guarantee of quality for the purchaser and a source of advertising for the manufacturer. See MCCARTHY, supra, §§ 3.04[1], 3.05. Discussing this changing nature of trademarks, Judge Posner has commented:

In an age when fashion-conscious consumers wear T-shirts emblazoned with the trademarks of consumer products and owners of Volkswagens buy conversion kits to enable them to put a Rolls Royce grill on their car, it is apparent that trade names, symbols, and design features often serve a dual purpose, one part of which is functional in the sense of making the product more attractive, and is distinct from identifying the manufacturer or his brand to the consumer.

W.T. Roger Co. v. Keen, 778 F.2d 334, 340 (7th Cir. 1985).

could have envisioned the broad effect over the years of an expanded section 43 of the Lanham Act,⁹ which now covers a wide range of unfair competition.¹⁰

The Act has thus “evolved into a statute which enables the public to purchase products with confidence, protects trademark holders from misappropriation of their marks, and secures definitive rights to owners of trademarks involved in interstate commerce.”¹¹ This unique evolutionary ability and ubiquitous impact has inspired at least one commentator to analogize it to the human species: “[t]he Lanham Act . . . has human traits: the ability to adapt and the power to influence. It has adjusted to sweeping changes in

9. 15 U.S.C. § 1125 (1994). Section 43(a) of the Lanham Act generally proscribes two types of unfair competition: false association and false advertising. See 15 U.S.C. § 1125(a); see also *Rosenfeld v. W.B. Saunders*, 728 F. Supp. 236, 241-42 (S.D.N.Y. 1990) (discussing false association and false advertising); James S. Wrona, *False Advertising and Consumer Standing Under Section 43(a) of the Lanham Act: Broad Consumer Protection Legislation or a Narrow Pro-Competitive Measure?*, 47 RUTGERS L. REV. 1085, 1092 n.11 (1995) (explaining the above two types of unfair competition). The Federal Trademark Dilution Act of 1995 added a new subsection (c) to section 43 that protects against “the diminishment over time of the capacity of a distinctive trademark to identify the source of goods bearing that mark.” Eric A. Prager, *The Federal Trademark Dilution Act of 1995: Substantial Likelihood of Confusion*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 121, 123 (1996); see also Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (1996) (codified at U.S.C.A. § 1125(c) (West Supp. 1996)).

10. See generally 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).

11. Ted Curtis & Joel H. Stempler, *So What Do We Name the Team? Trademark Infringement, the Lanham Act and Sports Franchises*, 19 COLUM.-VLA J.L. & ARTS 23, 23 (1995); see George Russell Thill, *The 1988 Trademark Law Revision Act: Damage Awards for False Advertising and Consumer Standing Under Section 43(a)—Congress Drops the Ball Twice*, 6 DEPAUL BUS. L.J. 361, 361-62 (1994) (“[T]he Lanham Act has proven to be a particularly effective mechanism for promoting the various policies and functions that underlie trademarks.”); Daniel M. McClure, *Trademarks and Unfair Competition: A Critical History of Legal Thought*, 69 TRADEMARK REP. 305, 347 (1979) (“Under our system as established by the Lanham Act, trademarks encourage the production of better products by facilitating consumer recognition of higher quality brands.”). United States Trademark Ass’n, *Amicus Curiae Brief*, 69 TRADEMARK REP. 265, 270 (1979) (stating that trademark protection provided by United States law encourages the development of new products).

in global commerce, and has profoundly affected trademark owners, practitioners and the general public.”¹² In fact, the Act’s success in remaining true to its purpose—protecting trademarks from piracy and businesses from unfair competition—is due primarily to this remarkable and ingenious evolution.

While we are celebrating the Act, we should not forget the thousands of professionals who have embraced and shaped this law, and made it one of the preeminent intellectual property statutes in the world. Thousands of untold and unknown judges, attorneys, and Patent and Trademark Office personnel have helped to expand, modify, and refine the Lanham Act, thereby maintaining its vitality over the years. Congress, too, has played a significant role in amending the Act to meet current needs and an awakened sense of trade morality. Not the least of those involved in the early development of the Act was Daphne Leeds, herself. As Assistant Commissioner of Patents,¹³ her many thoughtful and incisive opinions guided implementation of the Act through its birth and infancy.

Here’s to the fiftieth anniversary of the Lanham Act—may the next fifty years be as sweet.

12. Jerome Gilson & Michael Heltzer, *The Lanham Act: Alive and Well; After 50 Years, Landmark Law Still Evolving*, N.Y. L.J., Dec. 2, 1996, at S1.

13. See *supra* note 3.