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Fifty Years of the Lanham Act: A Retrospective of Section 43(a)

Ethan Horwitz*
Benjamin Levi**

INTRODUCTION

The Trademark Act of 1946¹ (“Lanham Act”) marks its fiftieth anniversary² with a much broader scope than originally envisioned by Congress. The expanded reach of the Lanham Act rests, in part, upon the growing prominence of its section 43(a) (“section 43(a”).³ Section 43(a) was initially interpreted as forbidding only “passing-off,”⁴ or the infringement or unau-

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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. The Lanham Act—named for Texas Congressman Fritz G. Lanham—was signed into law on July 5, 1946, and became effective exactly one year later. *Id.*

3. Section 43(a) states, in relevant part:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is likely to be damaged by such act.

15 U.S.C.A. § 1125(a)(1) (West Supp. 1996).

4. The early common law of trademark prevented only “passing off”—defined then as palming off one producer’s goods as those of another. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 cmt. d (1995). The term “pass-

thorized use of a trademark. Nonetheless, a half-century of expansive judicial interpretation and congressional amendment have enlarged section 43(a) into a vehicle for prohibiting infringement of common law marks, trade dress infringement, false advertising—including trade libel and product disparagement—and other practices falling within the rubric “unfair competition.”⁵

This Essay highlights key areas in which section 43(a) has expanded.⁶ Part I briefly discusses the various trademark acts in effect before the Lanham Act, and the factors which led to the wholesale rewriting of the trademark statutes. Part II surveys the legislative history of the Lanham Act, including section 43(a), and traces the expansion of section 43(a) over the years. This Essay concludes that the ongoing debate over the scope of section 43(a) will not diminish its importance in litigation related to unfair competition.

I. PRE-LANHAM ACT

Prior to the Lanham Act, federal trademark statutes were largely ineffective and had limited success. Although marks to distinguish merchandise had long been protected under the common law and state statutes,⁷ Congress did not enact the

ing off” is now used more broadly to describe any situation in which the conduct of a seller creates a likelihood that prospective purchasers will be confused as to the source of the goods or services. *Id.* § 4 & cmt. b.

5. The law of unfair competition has its roots in the common-law tort of deceit; it generally was concerned with protecting consumers, and subsequently sellers also, from misrepresentation as to the source of goods or services. *Id.* § 9; *see also* *Crescent Tool Co. v. Kilborn & Bishop Co.*, 247 F. 299, 301 (2d Cir. 1917) (Hand, J.) (“[T]he plaintiff has the right not to lose his customers through false representations The defendant . . . may copy plaintiff’s goods slavishly down to the minutest detail; but he may not represent himself as the plaintiff in their sale.”).

6. This Essay makes no attempt to present a comprehensive survey of the many and varied aspects of growth of Section 43(a); such a presentation would fill volumes.

7. *See* *Trade-Mark Cases*, 100 U.S. 82, 92 (1879) (“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 long been recognized by the common law”); *Coffeen v. Brunton*, 5 F. Cas. 1184 (C.C.D. Ind. 1849) (No. 2,946) (holding that the law prevents the adoption of another’s mark or label when it prevents the public from distinguishing between competitors’ prod-

first federal trademark statute until 1870.⁸ That first foray into trademark protection proved unsuccessful; in the *Trade-Mark Cases*,⁹ the Supreme Court declared the 1870 statute unconstitutional because it rested on the wrong congressional power.¹⁰ The Court held that Congress had erred by basing the 1870 statute on the Patent and Copyright Clause,¹¹ because trademarks are materially different from patents and copyrights.¹² The Court stated that Congress could have based the 1870 statute on the Commerce Clause,¹³ but had failed to do so.¹⁴

Although Congress grounded subsequent trademark acts on the Commerce Clause, those pre-Lanham Act statutes were not completely successful or effective. The first statute to follow the *Trade-Mark Cases* was an 1881 act that limited federal trademark registration to marks used in commerce with foreign nations or the Indian tribes.¹⁵ That was followed by another trademark law in 1905¹⁶ and by a somewhat broader statute in 1920 (“1920 Act”).¹⁷ Section 3 of the 1920 Act prohibited willful or intentional misrepresentation of the source of merchandise¹⁸—a prohibition that proved too restrictive to be

ucts); *see, e.g.*, *Walton v. Crowley*, 29 F. Cas. 138 (C.C.S.D.N.Y. 1856) (No. 17,133) (preventing the sale of sewing needles packaged under counterfeit replicas of a competitor’s labels); *Taylor v. Carpenter*, 23 F. Cas. 744 (C.C.D. Mass. 1846) (No. 13,785) (preventing the sale of thread bearing counterfeit replicas of a competitor’s trademarks).

8. Act of July 8, 1870, ch. 230, 16 Stat. 198.

9. 100 U.S. 82 (1879).

10. *Id.* at 97-99.

11. U.S. CONST. art. I, § 8, cl. 8 (stating that Congress shall have the power “[t]o promote the Progress of Science and the useful Arts, by securing for limited Times, to Authors and Inventors, the exclusive Right to their respective Writings and Discoveries”).

12. *Trade-Mark Cases*, 100 U.S. at 97-99.

13. U.S. CONST. art. I, § 8, cl. 3 (stating that Congress shall have the power “[t]o regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes”).

14. *Trade-Mark Cases*, 100 U.S. at 97-99 (declining to find that the law was based on the Commerce Clause absent any suggestion that Congress had intended the law to regulate commerce among the states).

15. Act of Mar. 3, 1881, ch. 138, 21 Stat. 502 (repealed 1946).

16. Act of Feb. 20, 1905, ch. 592, 33 Stat. 724 (repealed 1946).

17. Act of Mar. 19, 1920 (“1920 Act”), ch. 104, 41 Stat. 533 (repealed 1946).

18. Section 3 of the 1920 Act stated:

Any person who shall willfully and with intent to deceive, affix, apply,

of much use to litigants,¹⁹ but which did serve as the precursor to section 43(a) of the Lanham Act.²⁰

The pre-Lanham Act statutes presented several problems for trademark holders, for those seeking to prevent unfair business practices, and for practitioners. For example, the many separate acts combined to present a rather confusing amalgam of law; the statutes also failed to address adequately the protection of service marks; and trademark registrations did not expire—even where registrants did nothing to preserve their marks. Moreover, the pre-Lanham Act statutes allowed a competitor to obtain relief in only a few situations: (1) when the cause of action involved the tort of “passing-off;”²¹ (2) when a competitor could demonstrate that his business was

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, including words or other symbols, tending to falsely identify the origin of the merchandise, and shall then cause such merchandise to enter into interstate or foreign commerce, . . . shall be liable to an action at law for damages and to an action 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

Id. § 3, at 534.

19. Joseph P. Bauer, *A Federal Law of Unfair Competition: What Should Be the Reach of Section 43(a) of the Lanham Act?*, 31 U.C.L.A. L. REV. 671, 679-80 (1984).

20. As enacted, and until amended in 1988, section 43(a) stated that:

Any person who shall affix, apply, or annex, or use in connection with any goods or services, or any container or containers for goods, a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause such goods or services to enter into commerce, and any person who shall with knowledge of the falsity of such designation of origin or description or representation cause or procure the same to be transported or used in commerce . . . shall be liable to a civil action by any person doing business in the locality falsely indicated as that of origin . . . or by any person who believes that he is or is likely to be damaged by the use of any such false description or representation.

15 U.S.C. § 1125 (1988), amended by Federal Trademark Dilution Act Of 1995, Pub. L. No. 104-98, § 3(a), 109 Stat. 985 (effective Jan. 16, 1996); Trademark Remedy Clarification Act, Pub. L. No. 102-542, § 3(c), 106 Stat. 3567, 3568 (Oct. 27, 1992); Trademark Law Revision Act of 1988, Pub. L. No. 100-667, Title I, sec. 132, § 43(a), 102 Stat. 3935, 3946 (effective Nov. 16, 1989).

21. See *supra* note 4 (defining “passing off”); see also *American Washboard Co. v. Saginaw Mfg. Co.*, 103 F. 281 (6th Cir. 1900) (beginning a line of cases that made “palming off” essential to any recovery).

the “single source” of goods which were alleged to have been falsely advertised;²² or (3) when a competitor joined with others similarly affected to protest the misuse of a designation of geographical origin.²³

Those and other problems with the many trademark acts of the time fueled a movement to completely rewrite the trademark laws. Consequently, after many years of delay, Congress passed the Lanham Act on July 5, 1946, repealing the acts of 1881, 1905, and 1920.

II. THE LANHAM ACT

A. Legislative History

Although the legislative history of section 43(a) is limited and “inconclusive,”²⁴ the record is complete enough to reveal the congressional intent behind the steady expansion of section 43(a). For example, comparison of the statutory language of section 43(a) with that of its 1920 predecessor²⁵ shows that Congress intended to eliminate a showing of willfulness or intent to deceive as a prerequisite for winning a trademark protection action.²⁶ Congress also provided a cause of action for false advertising by inserting into section 43(a) the words “any false description or representation,”²⁷ whereas its predecessor,

22. See, e.g., *Coca-Cola Co. v. Koke Co. of America*, 254 U.S. 143, 146 (1920) (Holmes, J.) (“[Coca-Cola] means a single thing coming from a single source, and well known to the community. It hardly would be too much to say that the drink characterizes the name as much as the name the drink.”); *DuPont Cellophane Co. v. Waxed Products Co.*, 6 F. Supp. 859, 884 (E.D.N.Y. 1934) (“The name ‘Cellophane’ characterizes a single thing coming from a single source, and is a trademark, even if . . . the identity of the producer was unknown.”), *modified*, 85 F.2d 75 (2d Cir.), *cert denied*, 299 U.S. 601 (1936).

23. Kenneth B. Germain, *Unfair Trade Practices Under Section 43(a) of the Lanham Act: You’ve Come A Long Way, Baby—Too Far, Maybe?* 49 IND. L.J. 84 (1973), *reprinted in* 64 TRADEMARK REP. 193 (1974).

24. *Colligan v. Activities Club of New York, Ltd.*, 442 F.2d 686, 690 (2d Cir.), *cert. denied*, 404 U.S. 1004 (1971).

25. See *supra* notes 18, 20 (quoting section 3 of the 1920 Act and section 43(a) as enacted).

26. See *Parkway Baking Co. v. Freihofer Baking Co.*, 255 F.2d 641, 648 & n.7 (3d Cir. 1958) (noting that the willfulness and intent provisions of the 1920 Act were purposefully excluded from the Lanham Act).

27. See *supra* note 20 (quoting section 43(a) as enacted).

section 3 of the 1920 Act,²⁸ was limited to false designations of origin. The Lanham Act also was intended to re-introduce a general federal law of unfair competition in response to the seminal case of *Erie Railroad Co. v. Tompkins*,²⁹ which effectively wiped out the existing body of federal common law pertaining to unfair competition.³⁰

B. *Initial Years*

Section 43(a) initially played a small role in litigation related to unfair competition.³¹ Nonetheless, section 43(a) has grown to take a leading position in enforcing rights encompassed within the term “unfair competition.”

During its first seven years, section 43(a) generally was construed as a codification of pre-Lanham Act law. Consequently, the application of section 43(a) was restricted to actions for “passing-off” or actions which “include only such false descriptions or representations as are of substantially the same economic nature as those which involve infringement or other improper use of trade-marks.”³² That limited application

28. See *supra* note 18 (quoting section 3 of the 1920 Act).

29. 304 U.S. 64 (1938).

30. See *Skil Corp. v. Rockwell Int'l Corp.*, 375 F. Supp. 777, 782 (N.D. Ill. 1974) (“Congress undoubtedly recognized and intended to remedy the destructive effect that *Erie v. Tompkins* had upon the development of a uniform federal common law of unfair competition which was essential in a nation where interstate commerce was dominant.”) (citation omitted). After *Erie*, litigants could still seek protection under state laws regulating unfair competition and unfair trade practices; state laws remain an option for trademark litigants today. See 28 U.S.C. § 1338(a) (1994) (reserving exclusive federal jurisdiction over patents and copyrights, but not over trademark protection); *Union Mfg. Co. v. Han Baek Trading Co.*, 763 F.2d 42, 46 (2d Cir. 1985) (“[T]he jurisdiction of federal district courts over unfair trade practice and trademark cases is not exclusive.”).

31. Section 43(a) was initially overshadowed, in part, by section 44(b), (h), and (i) of the Lanham Act, 15 U.S.C. § 1126(b), (h), (i) (“section 44”), which was originally interpreted as creating a substantive federal law of unfair competition in interstate commerce. See *Stauffer v. Exley*, 184 F.2d 962, 964, 966 (9th Cir. 1950) (stating that 15 U.S.C. § 1126(b), (h), and (i) granted federal jurisdiction over unfair competition and trademark protection in interstate commerce). That view of section 44 did not prevail, due, in part, to the subsequent expansion of the applicability of section 43(a). See *L’Aiglon Apparel, Inc. v. Lana Lobell, Inc.*, 214 F.2d 649 (3d Cir. 1954) (beginning a line of cases that expanded the scope of section 43(a)).

32. *Samson Crane Co. v. Union Nat’l Sales, Inc.*, 87 F. Supp. 218, 222 (D. Mass. 1949) (“[Section 43(a)] should not be interpreted so as to bring within its scope any

began to expand with the landmark case of *L'Aiglon Apparel, Inc. v. Lana Lobell, Inc.*,³³ which broadened the scope of section 43(a) by finding that it created a new, statutory tort.³⁴

Although the *L'Aiglon Apparel* view of section 43(a) soon found adherents,³⁵ some courts were not yet ready to accept change. For example, in *Maternally Yours, Inc. v. Your Maternity Shop, Inc.*,³⁶ the influential United States Court of Appeals for the Second Circuit avoided considering whether section 43(a) created a federal law of unfair competition,³⁷ and instead ruled that 28 U.S.C. § 1338(b) had conferred pendant jurisdiction over the unfair competition claim.³⁸ Chief Judge Clark concurred in the decision, but nonetheless lamented that the legal profession had so far failed to perceive the full potential of section 43(a).³⁹ As Judge Clark predicted, section 43(a) has

kind of undesirable business practice which involves deception, when such practices are outside the field of the trade-mark laws, and especially when such undesirable practices are already the subject of other Congressional legislation . . ."), *aff'd per curiam*, 180 F.2d 896 (1st Cir. 1950).

33. 214 F.2d 649 (3d Cir. 1954).

34. The *L'Aiglon Apparel* court stated:

We find nothing in the legislative history of the Lanham Act to justify the view that [section 43(a)] is merely declarative of existing law. Indeed, because we find no ambiguity in the relevant language in the statute we would doubt the propriety of resort to legislative history even if that history suggested that Congress intended less than it said. It seems to us that Congress has defined a statutory civil wrong of false representation of goods in commerce and has given a broad class of suitors injured or likely to be injured by such wrong the right to relief in the federal courts. This statutory tort is defined in language which differentiates it in some particulars from similar wrongs which have developed and have become defined in the judge made law of unfair competition.

Id. at 651.

35. See *Gold Seal Co. v. Weeks*, 129 F. Supp. 928, 940 (D.D.C. 1955) (stating that section 43(a) creates a federal statutory tort, *sui generis*), *aff'd sub nom.* *S.C. Johnson & Son, Inc. v. Gold Seal Co.*, 230 F.2d 832 (D.C. Cir.), *cert. denied*, 352 U.S. 829 (1956); *Mutation Mink Breeders Ass'n v. Lou Nierenberg Corp.*, 23 F.R.D. 155, 161 (S.D.N.Y. 1959) (stating that section 43(a) does not merely codify the common law principles of unfair competition).

36. 234 F.2d 538 (2d Cir. 1956).

37. *Id.* at 540 n.1.

38. *Id.* at 543.

39. In predicting that section 43(a) would have a major impact on litigation related to unfair competition, Judge Clark stated:

become an effective tool to remedy many acts of unfair competition.

C. Growth of Section 43(a)

Since its initial expansion in *L'Aiglon Apparel*, section 43(a) has continued to grow in scope. Courts have extended the reach of section 43(a) to include infringement of common law marks and trade dress infringement. The courts also have interpreted “false advertising” broadly enough to apply to false claims about the claimant’s products. Moreover, Congress amended section 43(a) in 1988 to include trade libel and product disparagement—defined as false claims about a competitor’s product. The 1988 amendments also codified previous judicial interpretations of the statute. The remainder of this Essay discusses those significant areas of judicial expansion and the 1988 amendments.

1. False Designations of Origin

Section 43(a) protects both registered⁴⁰ and unregistered⁴¹ trademarks. The unregistered or common law trademarks were first held to be within the scope of section 43(a) in *Joshua Meier Co. v. Albany Novelty Manufacturing Co.*⁴² There, the Second Circuit stated that a defendant’s use of common law or unregistered trademarks may constitute a false designation of origin and a false description and representation in violation of

I do not see how we can avoid the clear federal jurisdiction arising under the new and quite extensive provision covering the false description or representation of goods introduced into commerce. By the broad and liberal construction properly given this remedial legislation . . . the relief here granted would be supported under federal law. I think we must consider the applicability of this statute, and cannot avoid it, even though counsel does not cite it; for we are bound by the law of the land Indeed, there is indication here and elsewhere that the bar has not yet realized the potential impact of this statutory provision

Id. at 546 (Clark, C.J., concurring) (citations omitted).

40. See, e.g., *Guess? v. Mai-Tai Boutique*, 7 U.S.P.Q.2d (BNA) 1387 (S.D.N.Y. 1988) (protecting the registered trademarks of Guess? clothing).

41. *Two Pesos, Inc. v. Taco Cabana, Inc.* 505 U.S. 763, 768 (1992) (“[Section] 43(a) protects qualifying unregistered trademarks”); see also *Boston Prof’l Hockey Ass’n v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1010 (5th Cir.) (“Under [section 43(a)], the registration of a mark is not a prerequisite of recovery”), *cert. denied*, 423 U.S. 868 (1975).

42. 236 F.2d 144 (2d Cir. 1956).

section 43(a), provided:

[T]he alleged unregistered trademarks used by the plaintiff are so associated with its goods that the use of the same or similar marks by another company constitutes a representation that its goods come from the same source. [Section 43(a)] requires at least that the defendant be guilty of a false representation. If the expressions used here by the defendant are not uniquely associated with the plaintiff's goods there is no such false representation.⁴³

Since *Joshua Meier*, other courts have applied section 43(a) to protect a variety of unregistered or common law marks or trade names,⁴⁴ including marks created under state law if used in interstate commerce,⁴⁵ abandoned marks that are reused,⁴⁶ marks that have been denied registration,⁴⁷ marks whose registrability is pending at time of litigation,⁴⁸ and unregistered

43. *Id.* at 147.

44. *See, e.g.*, *Scarves by Vera, Inc. v. United Merchants and Mfrs., Inc.*, 173 F. Supp. 625 (S.D.N.Y. 1959) (granting section 43(a) protection to "Jollitop" women's blouses because that brand name had become widely known as the plaintiff's exclusive trademark).

45. *See, e.g.*, *Tally-Ho, Inc. v. Coast Community College Dist.*, 889 F.2d 1018 (11th Cir. 1989) (enjoining competing use of a trademark registered under Florida's trademark law); *see also* *La Societe Anonyme des Parfums Le Galion v. Jean Patou, Inc.*, 495 F.2d 1265, 1271 & n.5 (2d Cir. 1974) (recognizing that "choice of law presents no real problems, since trademark use is accepted as a general common-law requirement [for trademark protection], with no discernible modulations from jurisdiction to jurisdiction").

46. *See, e.g.*, *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1131-33 (S.D.N.Y. 1993) (holding that reuse does not cure abandonment of a trademark, but instead generates new, albeit limited, trademark rights from the date of reuse), *vacated pursuant to settlement*, 859 F. Supp. 80 (S.D.N.Y. 1994), *cited in* *L. & J.G. Stickley, Inc. v. Canal Dover Furniture Co.*, 79 F.3d 258 (2d Cir. 1996); *Sutton Cosmetics (P.R.), Inc. v. Lander Co.*, 455 F.2d 285, 288 (2d Cir. 1972) (stating that the first bona fide user of an abandoned mark acquires trademark rights in the areas in which he uses the mark).

47. *See, e.g.*, *Sweetheart Plastics, Inc. v. Detroit Forming, Inc.*, 743 F.2d 1039 (4th Cir. 1984) (allowing a plastics manufacturer to claim trademark protection for its banana split and ice cream sundae dishes, even though trademark registration had been denied).

48. *See, e.g.*, *Marvel Comics, Ltd. v. Defiant*, 837 F. Supp. 546, 548-49 (S.D.N.Y. 1993) (allowing a comic book publisher to claim trademark protection for its new superhero while its trademark registration application was still pending).

trade names⁴⁹—notwithstanding the fact that Congress did not explicitly include those types of false designations within the scope of section 43(a).

Courts also have applied section 43(a) to common law marks other than trademarks. For example, *Iding v. Anaston*⁵⁰ held common law service marks to be within the scope of section 43(a). The *Iding* court affirmed that section 43(a) had created “a new federal remedy . . . subject to certain express limitations, which does not require ownership of a United States [trademark] registration.”⁵¹ Accordingly, the court found that “infringement of a common law service mark is cognizable under [section] 43(a) . . . where the mark or goods are in some way caused to enter into interstate commerce.”⁵² It also has been held that section 43(a) applies to common law certification marks.⁵³

Trade dress was held protectable under section 43(a) in *Eastman Kodak Co. v. Royal-Pioneer Paper Box Manufacturing*

49. See, e.g., *Perini Corp. v. Perini Constr., Inc.*, 915 F.2d 121, 124 (4th Cir. 1990) (“Section 43(a) of the Lanham Act . . . generally has been construed to protect against trademark, service mark, and *trade name* infringement even though the mark or name has not been federally registered.”) (emphasis added); *Accuride Int’l, Inc. v. Accuride Corp.*, 871 F.2d 1531, 1534 (9th Cir. 1989) (stating that trade names are protected by section 43(a), even though they cannot be registered like trademarks).

50. 266 F. Supp. 1015 (N.D. Ill. 1967).

51. *Id.* at 1017-18.

52. *Id.* at 1019. Although the *Iding* court stressed that section 43(a) applied to service marks only in interstate commerce, it now appears clear that likelihood of confusion is sufficient to bring even an intrastate use of a service mark within the scope of section 43(a), provided such use has a substantial effect on interstate commerce. *World Carpets, Inc. v. Dick Littrell’s New World Carpets*, 438 F.2d 482, 488-89 (5th Cir. 1971); see generally 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 27.06[3] (3d ed. 1992 & Supp. 1995) (discussing the Lanham Act amendments, effective in 1989, which shifted the focus from a requirement that goods or services themselves have an effect on interstate commerce to a requirement that designation or advertisement of the goods have an effect on interstate commerce).

53. *Florida v. Real Juices, Inc.*, 330 F. Supp. 428, 431 (M.D. Fla. 1971) (finding the scope of section 43(a) sufficiently broad to protect unregistered common law certification marks). Section 45 of the Lanham Act defines a certification mark as “any word, name, symbol, or device . . . used [or intended to be used] by a person other than its owner . . . to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of . . . goods or services.” 15 U.S.C.A. § 1127 (West Supp. 1996).

Co.⁵⁴ There, plaintiff Eastman Kodak sought to enjoin defendant from the manufacture and sale of photographic film boxes. The court granted injunctive relief under section 43(a), stating that “[d]efendant’s packages . . . constitute an unfair use of [plaintiff’s] trade dress.”⁵⁵ Since *Eastman Kodak*, other cases have also held trade dress to be protectable under section 43(a).⁵⁶

The judicial interpretations of section 43(a) with respect to false designations of origin finally became so widespread and accepted that Congress codified them in the Trademark Law Revision Act of 1988 (“Trademark Revision Act”).⁵⁷

2. False or Misleading Descriptions or Representations

Although the 1988 redrafting of section 43(a) provided statutory language protecting both registered and unregistered marks, a more precise description of section 43(a)’s scope would be that it protects *without regard* to trademark rights.⁵⁸ That is, section 43(a) not only prohibits trademark infringement, but also casts its wide net around any “false or misleading description of fact, or false or misleading representation of fact, which . . . in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities.”⁵⁹ That prong of section 43(a), also writ-

54. 197 F. Supp. 132 (E.D. Pa. 1961).

55. *Id.* at 133.

56. *Two Pesos Inc.*, 505 U.S. at 769, 774 (finding that inherently distinctive trade dress is protectable under section 43(a) without proof of secondary meaning); see *L.A. Gear, Inc. v. Thom McAn Shoe, Inc.*, 988 F.2d 1117 (Fed. Cir.) (finding that trade dress involving the total image of a product is protectable under section 43(a), under liberal principles of construction, provided that the trade dress is non-functional and is distinctive or has otherwise acquired secondary meaning), *cert. denied*, 510 U.S. 908 (1993).

57. Trademark Law Revision Act of 1988, Pub. L. No. 100-667, 102 Stat. 3935 (effective Nov. 16, 1989).

58. See *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992) (“[S]imple claims of false representations in advertising are actionable under section 43(a) when brought by competitors of the wrongdoer, even though they do not involve misuse of a trademark.”), *cert. denied*, 506 U.S. 1080 (1993).

59. 15 U.S.C.A. § 1125(a)(1).

ten into law as part of the Trademark Revision Act, was intended to codify judicial interpretations given section 43(a) before the 1988 amendments.⁶⁰

Because the terms “false or misleading description of fact” and “false or misleading representation of fact” were new to section 43(a), they were originally open to judicial interpretation. Nonetheless, it is generally accepted that this second prong of section 43(a) covers statements which are literally false, as well as statements which, although literally true, create false impressions.⁶¹ That interpretation is consistent with interpretations given section 43(a) before the 1988 amendments. For example, in *American Home Products Corp. v. Johnson & Johnson*,⁶² the court reasoned that limiting the reach of section 43(a) to literal falsehoods would allow false advertisers to circumvent the statute by finding clever ways to mislead.⁶³

60. See *ALPO Petfoods, Inc. v. Ralston Purina Co.*, 913 F.2d 958, 964 & n.6 (D.C. Cir. 1990) (noting that the Trademark Law Revision Act of 1988 sharpened section 43(a)’s focus on “false and deceptive advertising” regarding designation of origin).

61. *S.C. Johnson & Son, Inc. v. Clorox Co.*, 930 F. Supp. 753, 779 (E.D.N.Y. 1996) (stating that section 43(a) covers either advertisements that are literally false, or though literally true, are likely to mislead and confuse). For example, even though it is literally true to say that the winner of a two-person race finished “next to last,” such a statement is clearly misleading; it creates a false impression if no other information is given from which one could determine that the person who finished “next to last” also finished in first place. See *Mutation Mink Breeders Ass’n*, 23 F.R.D. at 162 (stating that the likelihood of public deception is an issue of fact to be resolved by considering all relevant circumstances).

62. 577 F.2d 160 (2d Cir. 1978)

63. The *American Home Products* court stated:

That [s]ection 43(a) of the Lanham Act encompasses more than literal falsehoods cannot be questioned. Were it otherwise, clever use of innuendo, indirect intimations, and ambiguous suggestions could shield the advertisement from scrutiny precisely when protection against such sophisticated deception is most needed. . . .

If a statement is actually false, relief can be granted . . . without reference to the reaction of the buyer or consumer of the product. . . . [But where] a statement acknowledged to be *literally true and grammatically correct nevertheless has a tendency to mislead, confuse or deceive*. . . . ‘[T]he public’s reaction to [the] advertisement will be the starting point in any discussion of the likelihood of deception.’

Id. at 165 (quoting *American Brands, Inc. v. R. J. Reynolds Co.*, 413 F. Supp. 1352, 1356-57 (S.D.N.Y. 1976)) (alterations in original) (citations omitted).

Prior to the Trademark Revision Act, courts held that false statements claiming patent or copyright protection for a product or item constituted false advertising that is actionable under section 43(a).⁶⁴ It is important to note, however, that section 43(a) has been held not to prohibit false claims of trademark rights.⁶⁵ Pre-1988 judicial interpretations of section 43(a) also limited actionable false statements to claims about one's own goods or services; consequently section 43(a) did not provide a cause of action for false statements or representations about a competitor's goods or services.⁶⁶ The Trademark Revision Act changed that by expanding section 43(a) to include trade libel and product disparagement.⁶⁷

64. *John Wright, Inc. v. Casper Corp.*, 419 F. Supp. 292 (E.D. Pa. 1976), *rev'd in part on other grounds sub nom. Donsco, Inc. v. Casper Corp.*, 587 F.2d 602 (3d Cir. 1978); *Kuddle Toy, Inc. v. Pussycat-Toy Co.*, 183 U.S.P.Q. (BNA) 642, 665 (E.D.N.Y. 1974) (rejecting plaintiff's claim that section 43(a) ought to be limited to the trademark context, stating that "the language of section 43(a) will not accept that sort of reading"). In *John Wright*, the court concluded that an advertising brochure violated section 43(a) by subtly, but falsely, suggesting that the defendant held patents on both the original and reproductions of penny banks. The court described the falsehood as "a material misrepresentation of quality which tends to deceive an ordinary purchaser in the exercise of ordinary care . . ." 419 F. Supp at 327.

65. See *La Societe Anonyme des Parfums Le Galion*, 495 F.2d at 1270 n.6 (stating that section 43(a) is intended to reach false advertising violations, not false registration claims); *Computer Assoc. Int'l, Inc. v. Computer Automation, Inc.*, 678 F. Supp. 424, 429 (S.D.N.Y. 1987) (holding that false claim of trademark rights provided no cause of action under section 43(a), where the false representation was not made in connection with goods or services that entered into commerce, nor achieved any unfairly competitive effect).

66. See, e.g., *Bernard Food Indus., Inc. v. Dietene Co.*, 415 F.2d 1279, 1283 (7th Cir. 1969) (holding that false advertising or representations made by a defendant about a plaintiff's product are not covered by section 43(a)), *cert. denied*, 397 U.S. 912 (1970). But see *Skil Corp. v. Rockwell Int'l Corp.*, 375 F. Supp. 777, 782 n.10 (N.D. Ill. 1974) (following the holding in *Bernard Food*, but nevertheless declaring that it was illogical not to enforce section 43(a) where one makes false representations against a competitor, because the buying public would still tend to be misled about the relative merits and qualities of the products).

67. 15 U.S.C.A. 1125(a)(1) ("Any person who . . . uses . . . false or misleading representation of fact, which . . . misrepresents the nature . . . of his or her or another person's goods . . . shall be liable . . .") (emphasis added); see also *Gordon & Breach Science Publishers, S.A. v. American Inst. of Physics*, 859 F. Supp. 1521, 1530 (S.D.N.Y. 1994) (noting that trade libel and product disparagement became actionable under the 1988 amendments to section 43(a)).

CONCLUSION

Once interpreted as prohibiting only “passing-off,” section 43(a) of the Lanham Act has increased in scope to include infringement of common law marks, trade dress infringement, and false advertising—including trade libel and product disparagement. Nonetheless, section 43(a)’s considerable expansion during the past fifty years has yet to transform it into a catch-all statute covering all causes of action related to unfair competition. For example, section 43(a) does not provide a cause of action for trade secret violations. Contractual disputes also remain generally outside the scope of section 43(a), as do false claims of trademark rights.

Whether section 43(a) ought to expand or contract in scope has been a much debated issue. Many factors may influence the future reach of section 43(a), including the Supreme Court’s interpretation of “interstate commerce,” the interpretation that the courts place on the new amendment, effective in 1996, extending section 43(a)’s protection of trademark dilution, and the ingenuity of practitioners to argue for either the broadening or narrowing of the section. Whatever the future scope of section 43(a), at least one thing is certain; section 43(a) promises to remain at the forefront of unfair competition related litigation.