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# REGISTRATION AND FEDERALIZATION: 75 YEARS OF THE LANHAM ACT[♦]

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## INTRODUCTION

Any conference designed around the anniversary of a statute is meant, at least in part, to consider the extent to which the statute has been successful. Success can be defined in many ways, but one important measure is how well the statute has met the drafters' goals. Assessing the Lanham Act's success in that way is a complicated task because the statute's drafters had several different goals. But two motivations stand out for Edward Rogers, who was widely recognized as the primary draftsman of the Lanham Act and all of its preceding draft bills. Specifically, Rogers was keenly focused on improving the quality of notice provided by the federal register and maintaining the substantive uniformity of trademark and unfair competition law.

In our view, the statute has only been a partial success in terms of notice. Federal law has come to dominate the field, but not primarily because registration became more significant, as the drafters expected. Instead, federal law displaced common law trademark and unfair competition law because courts interpreted the Lanham Act to provide a federal cause of action for infringement of *unregistered* marks. That interpretation assured continued substantive uniformity, addressing



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Rogers's other primary concern, but it undermined the statute's incentives to register and therefore probably came at the expense of better notice.

## I. NOTICE AND DISUNIFORMITY

As Jessica Litman's keynote demonstrated in detail, one of Rogers's most significant concerns about the pre-Lanham Act state of affairs was the inability of traders considering adopting a new trademark to learn whether that mark was already the subject of a legitimate claim of rights.[1] The primary reason for the lack of notice was the incompleteness of the then-existing federal register.[2]

Prior to the Lanham Act, it was common ground that *use* and not registration created trademark rights. Indeed, pre-Lanham Act federal statutes were understood to be entirely procedural, meaning that federal law played no substantive role in creating or defining trademark rights. The prevailing statutes merely provided a means for recording those rights (federal registration) and for enforcing federally-registered marks in federal court. As the Eighth Circuit said,

> Mere registration under the Federal Act does not create a trade-mark and confers no new rights to the mark claimed, nor, indeed, any greater rights than already existed at common law without registration. Registration is a method of recording for the protection of dealers, the public, and owners of trade-marks. It is notice of the claims of the owner affecting his right to the mark. But the right to such a trade-mark must have accrued from actual use, because such right is not created by registration of the mark.[3]

Indeed, in the views of many, including the Supreme Court, it was not just that Congress had chosen not to create substantive federal trademark rights prior to the Lanham Act; Congress *lacked the power* to legislate on the substantive law of trademarks.[4]

[1] Jessica Litman, John F. Nickoll Professor of Law, Univ. of Mich., Keynote Address at Cardozo Arts & Entertainment Law Journal Symposium, Diamond Anniversary: 75 Years of the Lanham Act (Mar. 24, 2021), *in* 39 CARDOZO ARTS & ENT. L.J. 855 (2021).
[2] *Id.*
[3] Walgreen Drug Stores v. Obear-Nester Glass Co., 113 F.2d 956, 960 (8th Cir. 1940) (internal citations omitted). *See also* Am. Trading Co. v. H.E. Heacock Co., 285 U.S. 247, 258 (1932) ("[T]he Federal statute did not attempt to create exclusive substantive rights in marks, or to afford a refuge for piracy through registration under the Act, but to provide appropriate procedure and to give the described protection and remedies where property rights existed. The acquisition of such property rights in trade-marks rested upon the laws of the several States."); Est. of P.D. Beckwith, Inc. v. Comm'r of Pats., 252 U.S. 538, 543 (1920) ("The Registration Act of 1905, without changing the substantive law of trade-marks, provided, in the manner prescribed, for the registration of marks (subject to special exceptions) which, without the statute, would be entitled to legal and equitable protection." (internal citation omitted)).
[4] *See, e.g.*, Am. Steel Foundries v. Robertson, 269 U.S. 372, 381 (1926) ("[S]ince [Congress] has

The fact that trademark rights were created by use and not registration meant the federal register was extremely underinclusive—while some trademark owners went to the trouble of registering their marks, there was "no place where a search [could] be made that [would] disclose even any substantial part of the trade-marks in use."[5] And if parties could not discover a substantial part of the marks in use, they could not discover even a substantial part of the actually-existing legal rights. That problem was so evident to Rogers that, more than twenty years before the Lanham Act was passed, he proposed a new federal statute that would, like its predecessors, have been entirely procedural, but that would have *required* federal registration.[6]

A second major theme for Rogers and other proponents of the Lanham Act was the need for uniform federal law in the face of increasingly national commerce. There were two concerns here. One was about proposals for new state trademark statutes, and especially statutes that would have required state registration and stripped common law rights from those who failed to register existing marks.[7] Some of the proposed statutes would have required registration within six months of their effective dates; marks that were not registered in that timeframe would have become available for anyone to appropriate and register as their own, no matter how long that mark had previously been in use by another party.[8] Those state statutes, if passed, would have required the owners of marks used in interstate commerce to register quickly in many states,[9] which would have been burdensome and expensive.[10]

been given no power to legislate upon the substantive law of trade-marks, it reasonably may be assumed, also, that to the extent the contrary does not appear from the statute, the intention was to allow the registration of such marks as that law, and the general law of unfair competition of which it is a part, recognized as legitimate.").

5 Edward S. Rogers, *Some Suggestions Concerning a Trade-Mark Registration Act*, BULL. U.S. TRADEMARK ASS'N, Mar. 1921, at 45, 49 [hereinafter Rogers I].

6 *Id.* at 54, 56. Rogers specifically proposed that no "action or proceeding [could] be maintained for infringement of any trade or identifying mark, name, label or device required by [the proposed] act to be deposited until the provisions hereof with respect to deposit shall have been complied with." *Id*. at 56. Although he did not explicitly address preemption, a registration "requirement" could only have been meaningful if it prohibited parties that did not register their registrable marks from enforcing the unregistered marks at common law. Pre-Lanham Act statutes only provided a federal cause of action to registered trademarks, so registration was already a condition of arising under jurisdiction.

7 Edward S. Rogers, *The Lanham Act and the Social Function of Trade-Marks*, 14 L. & CONTEMP. PROBS. 173, 177–84 (1949) [hereinafter Rogers II] (reporting proposed state legislation that would have required registration of marks to maintain validity). Courts have identified that concern as a motivator for the Lanham Act. *See* Kohler Co. v. Moen Inc., 12 F.3d 632, 640 n.10 (7th Cir. 1993) (citing Rogers II, *supra*, at 177–84) (claiming that the "Lanham Act was drafted in *reaction* to draconian state trademark legislation that threatened to interfere with interstate commerce").

8 Rogers II, *supra* note 7, at 178.

9 *Id.* at 178 ("[U]nless there was a strong federal act, protecting marks used in interstate commerce, the states would step in and there might be forty-eight different state laws which would have to be complied with if trade-mark rights were to be secured.").

10 *Id.* ("The fees proposed for local registration were substantial; in the case of a non-resident

The Lanham Act's drafters were also concerned about the potential for disuniformity in decisional law following the Supreme Court's decision in *Erie v. Tompkins*.[11] As we noted, pre-Lanham Act statutes were purely procedural, meaning that they did not create legal rights or the substantive law regarding their enforcement.[12] Trademark law's substance came from the common law, and that was true even for registered marks.[13] All of the rules for determining what counted as a trademark and what it meant to infringe those marks were developed by courts.

In the pre-*Erie* era, it was reasonably clear that the common law in this area was general law. Notwithstanding debate about the technical status of the general law, trademark and unfair competition law were substantially uniform across jurisdictions (federal and state),[14] and federal courts did not face hard questions about when they might have been obligated to defer to state court decisions.[15]

After *Erie*, however, several courts concluded that common law trademark and unfair competition claims were based on state law,[16] and

concern owning, as many do, a large number of trade-marks, the tax in the aggregate would be intolerably burdensome.").

11 Erie R.R. v. Tompkins, 304 U.S. 64 (1938).

12 *See supra* notes 2–4 and accompanying text.

13 *See* Emerson Elec. Mfg. Co. v. Emerson Radio & Phonograph Corp., 105 F.2d 908, 910 (2d Cir. 1939) ("We may start by at once laying aside the plaintiff's registration of its name. That did not enlarge its substantive rights at all; all it did was to confer jurisdiction on the court and give the registrant certain procedural advantages."); Cal. Prune & Apricot Growers Ass'n v. H.R. Nicholson Co., 59 U.S.P.Q. (BL) 402 (Cal. Super. Ct. Nov. 9, 1943), *aff'd*, 69 Cal. App. 2d 207 (1945) (registered trademark served public notice that it must not be used without permission but gave creator no new rights in its adoption).

14 Federal courts sitting in diversity decided many trademark and unfair competition cases before *Erie*, but their decisions did not refer to the laws of any particular state, let alone suggest that courts were bound by the decisions of any state's supreme court. Moreover, the relatively fewer state court decisions from this era were substantively indistinguishable from federal court decisions. *See, e.g.*, Alff v. Radam, 14 S.W. 164 (Tex. 1890) (deciding a common law trademark infringement claim without reference to particular state law and relying extensively on Mfg. Co. v. Trainer, 101 U.S. 51 (1879), a Supreme Court decision on a common law trademark infringement claim, which itself made no reference to the law of any state); Amoskeag Mfg. Co. v. Spear & Ripley, 2 Sand. 599 (N.Y. Super. Ct. 1849) (deciding a common law trademark infringement action without reference to the law of any state).

15 *See* Caleb Nelson, *A Critical Guide to* Erie Railroad Co. v. Tompkins, 54 WM. & MARY L. REV. 921, 977 (2013) (discussing the role of general law in promoting national uniformity); *see also* Arthur John Keeffe, John J. Gilhooley, George H. Bailey & Donald S. Day, *Weary Erie*, 34 CORNELL L.Q. 494, 504 (1949) (concluding that the Supreme Court's decisions about the content of general law "did promote uniformity to a substantial degree . . . .").

16 *See, e.g.*, Philco Corp. v. Phillips Mfg. Co., 133 F.2d 663, 665–66 (7th Cir. 1943) ("In the field of trade-mark infringement and unfair competition it has long been recognized that all rights originally existed by virtue of the common law of the several States. Thus, in one sense, there has not been thought to be a federal general common law in the field. But in another sense, there has been a federal general common law and cases have been 'governed by federal law' within the meaning of the Erie doctrine, for federal courts have exercised independent judgment as to what 'the common law' was in all cases in the field. The instant case requires us to draw the line between those cases still 'governed by federal law' (federal courts make an independent determination of the law) and those 'governed by State law' (federal courts are bound by the views of a particular State court)." (citation omitted)).

logic and structure would have suggested that state law *also* controlled on questions of validity and infringement in cases involving registered trademarks. The Supreme Court even accepted certiorari in *Pecheur Lozenge Co. v. National Candy Co.* in order "to determine whether local law or federal law should have been applied in a suit for infringement of a trademark registered under the Trade-Mark Act of 1905."[17] Unfortunately, the Court never ruled on that question because further examination of the record revealed that the registration referred to was a copyright registration rather than a trademark registration.[18] Since the petitioner did not allege copyright infringement and did not have a federal trademark registration, "[t]he only cause of action that [the] record could possibly [have] support[ed] [was] for unfair competition and common law 'trademark infringement,' to which local law applie[d]."[19]

Not having received a definitive answer from the Supreme Court about the source of law in cases involving registered marks, some lower courts "solved" the problem of potential disuniformity by insisting that federal law applied[20]—though they reached that conclusion by claiming, in flat contradiction of controlling Supreme Court precedent and widespread understanding, that Congress *had*, in fact, created substantive trademark rights in the 1905 Act.[21] The conclusion that federal law applied in cases involving registered trademarks meant that those cases would stand in contrast with common law trademark and unfair competition cases, in which *Pecheur Lozenge* and many other cases made clear that state law applied.[22] The difference in source of law worried Rogers and other prominent trademark practitioners, who wondered about the continuing precedential value of the many pre-*Erie* decisions

[17] Pecheur Lozenge Co. v. Nat'l Candy Co., 315 U.S. 666, 666–67 (1942) (asking counsel to express their views as to "whether State law govern[ed] and, if so, what the applicable State law [was]"). The Court asked for those views because it believed the suit was "not founded upon a trademark registered under the 1905 Act," which the "complaint had ma[de] it appear." *Id.* at 667.
[18] *Id.* at 667.
[19] *Id.*
[20] *Philco Corp.*, 133 F.2d at 667 ("We believe that all such questions [relating to registrability, infringement, defenses, remedies, and validity] arising under the Act of 1905 are governed by federal law, since they involve the interpretation and application of a federal statute.").
[21] *Id*. at 668 ("It is our opinion that Congress did create substantive rights in trade-marks by the passage of the Act of 1905."). That conclusion was transparently an attempt to avoid the consequences of the *Erie* decision in the context of registered marks. *See id*. ("If it were held that Congress created no substantive rights but only procedural rights, the *Erie* doctrine would require that State law govern substantive questions of trade-mark law, just as that doctrine would have required if it had been applied before the Act was passed.").
[22] *Pecheur Lozenge*, 315 U.S. at 667. *See also* Sergei S. Zlinkoff, Erie v. Tompkins*: In Relation to the Law of Trade-Marks and Unfair Competition*, 42 COLUM. L. REV. 955, 960 (1942) ("The basic policy underlying these decisions makes it clear that one class of trade-mark and unfair competition cases unmistakably comes within their scope, namely, the ordinary common law trade-mark and unfair competition action, wherein the jurisdiction of the federal court is predicated upon diversity of citizenship.").

issued by federal courts.[23] Indeed, for those like Rogers who never accepted that unfair competition law was really state law in any meaningful sense, *Erie* injected unnecessary uncertainty, and the Lanham Act was an important guarantee of the law's continued stability.[24]

With the benefit of hindsight, the drafters' fears of disuniformity were probably unfounded. Federal courts called on to decide unfair competition cases after *Erie* needed to look somewhere for the substantive rules. Previous federal court decisions had developed a general law of unfair competition, and the few state court decisions that existed largely relied on federal precedents. Thus, courts looking for a rule of decision faced a landscape devoid of state-specific law, and, as a result, state and federal courts alike continued to apply the general law of unfair competition.[25] But regardless of the validity of the drafters' disuniformity concerns, in fact those concerns played a prominent role in the case for the Lanham Act.

## II. WHITHER REGISTRATION?

Notice and uniformity were not the Lanham Act's drafters' only concerns. Rogers, for example, had long complained about the infringement standard of the 1905 Act, which required that the defendant use the registered mark for goods "of the same descriptive properties" as those for which the mark was registered.[26] One problem was that the 1905 Act was somewhat inconsistent in its terminology. Part of the Act referred to goods of "the same descriptive properties"[27] while another referred to goods of "substantially the same descriptive properties,"[28] and it was unclear whether the slight difference was meaningful. Rogers was also unimpressed by administrative and judicial interpretations of the "same descriptive properties" standard, which often involved "incompetent testimony, supposition and surmise, long-winded objections, stump

23 *See* Edward S. Rogers, *Introduction* to DAPHNE ROBERT, THE NEW TRADE-MARK MANUAL: A HANDBOOK ON PROTECTION OF TRADE-MARKS IN INTERSTATE COMMERCE, at xi, xvi–xxi (1947) [hereinafter Rogers III] (arguing that *Erie* displaced what practitioners had assumed was federal common law).

24 The concern about disuniformity in decisional law was reflected in the House and Senate Reports accompanying the Lanham Act. *See* S. REP. NO. 79-1333, at 5 (1946) ("Many years ago the Supreme Court held and has recently repeated that there is no Federal common law. It is obvious that the States can change the common law with respect to trade-marks and many of them have, with the possible result that there may be as many different varieties of common law as there are States. A man's rights in his trade-mark in one State may differ widely from the rights which he enjoys in another. However, trade is no longer local, but is national.").

25 *See* Mark P. McKenna, *Trademark Law's Faux Federalism*, *in* INTELLECTUAL PROPERTY AND THE COMMON LAW 288, 298 (Shyamkrishna Balganesh ed., 2013).

26 Rogers I, *supra* note 5, at 49 ("The phrase, 'descriptive properties' has been the trouble maker. A virtuoso in vagueness must have conceived it.").

27 Trade-Mark Act of 1905, ch. 592, §§ 5(b), 7, 33 Stat. 724, *repealed by* Lanham Act, ch. 540, § 46(a), 60 Stat. 427, 444 (1946).

28 Rogers I, *supra* note 5, at 49; Trade-Mark Act of 1905, § 16.

speeches and altercations between council" rather than a sharp focus on the relationship between the parties' goods.[29]

Rogers and others also were interested in liberalizing registration for so-called "secondary meaning marks," which they accomplished by creating section 2(f) of the Lanham Act. That section permits registration of descriptive and geographically descriptive terms, among other signs, when they have become distinctive of the applicant's goods or services (developed "secondary meaning").[30] It also empowers the Trademark Office to accept evidence of five years of substantially exclusive use of the purported mark as prima facie evidence that the mark has become distinctive.[31] Section 2(f) was significant because it broadened the range of signs that qualify for federal registration and therefore benefit from all of the presumptions afforded to registered marks.[32]

Whatever progress the Lanham Act made with respect to those other priorities, given the drafters' emphasis on notice and national uniformity, it is striking that the statute did not require registration or preempt state law. Indeed, the Lanham Act did not even explicitly provide that federal law applied in infringement cases involving registered trademarks.

Regarding registration, the statute used carrots rather than sticks, giving mark owners incentives to register but not making registration mandatory. To be sure, the benefits of registration were (and are) meaningful.[33] Most significantly, the new statute gave registrants nationwide priority[34] and the chance for their registrations to become incontestable.[35]

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29 Rogers I, *supra* note 5, at 51.

30 15 U.S.C. § 1052(f).

31 *Id.*

32 *See* Graeme B. Dinwoodie, Trademarks and Commercial Reality 15 n.62 (Sept. 21, 2015) (unpublished manuscript) (on file with authors) (noting that "[t]he 1920 statute sought to liberalize registration with respect to descriptive terms, but it failed to do so effectively because of the lack of any useful presumption flowing from a 1920 Act registration," leaving them "permanently open to the challenge of descriptiveness"); *see also* 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 5:3, Westlaw (5th ed., database updated June 2021). For a discussion of the effects of registration under the 1920 Act, *see* Armstrong Paint & Varnish Works v. Nu-Enamel Corp., 305 U.S. 315 (1938). Under the Lanham Act, a certificate of registration serves as prima facie evidence of the validity of the registered mark, and a registered mark cannot be challenged on descriptiveness grounds once the registration becomes incontestable. 15 U.S.C. §§ 1057, 1065.

33 *Cf.* B&B Hardware, Inc. v. Hargis Indus., Inc., 575 U.S. 138, 142 (2015) ("Registration is significant.").

34 Under the Lanham Act as originally passed, registration served as constructive notice and constructive nationwide use. Lanham Act, Pub. L. No. 489, § 22, 60 Stat. 427, 435 (1946) (current version at 15 U.S.C. §§ 1051 *et seq.* (2018)) ("Registration of a mark on the principal register provided by this Act . . . shall be constructive notice of the registrant's claim of ownership thereof."). As of November 16, 1989, the effective date of the Trademark Law Revision Act, contingent on registration, the application date serves as the constructive notice and constructive use date. Trademark Law Revision Act of 1988, Pub. L. No. 100-667, sec. 109, § 7, 102 Stat. 3935, 3938–39 (current version at 15 U.S.C. § 1057(c) (2018)).

35 15 U.S.C. § 1065 (2018). More recent amendments that provided for civil and criminal

But the Lanham Act did not break from trademark law's historic focus on use and therefore did not fundamentally change trademark law at the conceptual level. As originally passed (and indeed until 1989), the statute required use of a mark as a condition of application to register,[36] and even today it remains clear that use, and not registration, creates trademark rights.[37] Constructive use and incontestability are partial substantive modifications to common law rights, but those rules continue to respect pre-existing common law uses.[38] Overall, it is hard to escape the conclusion that the Lanham Act merely bolted a few substantive features onto a registration system that remains fundamentally procedural.

For many commentators, the statute's continued attachment to a use-based conception of trademark rights is at least part of the reason registration plays a complementary role in American trademark law.[39] And there is unquestionably something to that view. It is, however, not the whole story. Rogers was clearly committed to the use-based system, and yet he had been pushing mandatory registration for *decades* before the Lanham Act.[40] So there is no reason to believe we couldn't have had a more robust registration system even within the framework of a use-based system. In terms of notice, the Lanham Act's continued use of optional registration was a missed opportunity.

There were, however, reasons for the drafters of the Lanham Act to have believed that the system they created would be more registration-based than it has turned out to be. Specifically, the drafters could

counterfeiting remedies, both of which are available only for federally registered marks, have made registration even more significant. *See id.* § 1117(b) (providing enhanced damages for civil counterfeiting); 18 U.S.C. § 2320(b) (creating criminal penalties for counterfeiting).

36 In 1988, Congress amended the Lanham Act to allow applications on the basis of an intent to use the mark. Trademark Law Revision Act of 1988, sec. 102, § 1, 102 Stat. at 3935 (current version at 15 U.S.C. § 1051(b) (2018)). That amendment became effective in 1989. *Id.* § 206, 102 Stat. at 3960. But even that was not an abandonment of the use-based conception of trademarks—though a party can apply to register its mark before making use, the registration will not issue unless and until the applicant can prove it has made use. 15 U.S.C. § 1051(d).

37 *See, e.g.*, *In re* Deister Concentrator Co., 289 F.2d 496, 501 (C.C.P.A. 1961) ("The Lanham Act does not create trademarks. While it may create some new substantive rights in trademarks, unless trademarks pre-exist there is nothing to be registered. Neither does it create ownership, but only evidence thereof."). Mere registration of a trademark does not in itself confer any greater rights than existed at common law without registration. U.S. Jaycees v. S.F. Junior Chamber of Com., 354 F. Supp. 61 (N.D. Cal. 1972) (quoting Griesedieck W. Brewery Co. v. Peoples Brewing Co., 149 F.2d 1019, 1022 (8th Cir. 1945)), *aff'd*, 513 F.2d 1226 (9th Cir. 1975).

38 *See* 15 U.S.C. § 1065 (making incontestability subject to the "extent, if any, to which the use of a mark registered on the principal register infringes a valid right acquired under the law of any State or Territory by use of a mark or trade name continuing from a date prior to the date of registration under this chapter of such registered mark"); *see also id.* § 1115(b)(5) (making it a defense to incontestability that "the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant's prior use and has been continuously used by such party or those in privity with him from a date prior to [the constructive use date of the mark]").

39 *See, e.g.*, Rebecca Tushnet, *Registering Disagreement: Registration in Modern American Trademark Law*, 130 HARV. L. REV. 867 (2017).

40 *See supra* note 6.

reasonably have expected that the benefits of registration would be even more attractive than they have been.

Every federal trademark statute prior to the Lanham Act made enforcement in federal court contingent on federal registration.[41] Though the drafters meant to liberalize registration with respect to secondary meaning marks, they did *not* believe they were changing the rules regarding enforceability. So while the Lanham Act would make a broader range of signs eligible for registration, only registered marks would be enforceable in federal court—just as had been true under previous statutes.[42] Indeed, the fact that only registered marks would be enforceable in federal court was an important reason the drafters were motivated to expand eligibility for registration.

In addition, most of the Lanham Act's proponents, and even courts interpreting the new statute in the years immediately after its passage, came to believe that the statute would supply the substantive law in cases involving enforcement of registered marks. That conclusion was not inevitable. Because the Lanham Act maintained trademark law's traditional focus on use, courts continued to recognize after the statute was passed that registration did not create trademark rights.[43] If the statute did not create rights, those rights must have been created under some other law, and after *Erie* the only other choice was state law. But perhaps because most proponents of the statute came to believe that Congress *could* and *should* create substantive trademark law, few were motivated to ask whether Congress *did so* when it passed the Lanham Act.[44]

41 Act of March 19, 1920, ch. 104, 41 Stat. 533, *repealed by* Lanham Act, ch. 540, § 46(a), 60 Stat. 427, 444 (1946); Trade-Mark Act of 1905, ch. 592, § 16, 33 Stat. 724, 728 (creating a cause of action for infringement of registered marks), *repealed by* Lanham Act, ch. 540, § 46(a), 60 Stat. 427, 444 (1946); *see also id.* § 17 (granting federal courts jurisdiction in cases involving use of a registered mark in interstate commerce).

42 *See* McKenna, *supra* note 25, at 297–98.

43 *See, e.g.*, Ercona Corp. v. Rogers, 120 U.S.P.Q. (BL) 100, 105 (D.D.C. Dec. 8, 1958) ("Ownership and rights to exclusive use of a trademark derive from its adoption and use, not from its registration."), *aff'd sub nom.* Rogers v. Ercona Camera Corp., 277 F.2d 94 (D.C. Cir. 1960); Proxite Prods., Inc. v. Bonnie Brite Prods. Corp., 206 F. Supp. 511, 514 (S.D.N.Y. 1962) ("Registration of a trademark is not essential to the acquisition of a protectable interest in the mark, and registration of a mark under the Lanham Act does not of itself create trademark rights. It is the priority of use in commerce on the owner's goods as a designation of origin which gives the owner the right to a mark. The exclusive right to the use of a trademark has always rested and still rests on the common law." (citation omitted)).

44 *See* Rogers II, *supra* note 7, at 179 (explaining that the drafters intended to "give substantive rights in trade-marks to the owners of them on the theory that a trade-mark is an instrumentality of commerce and is within the plenary power of Congress to regulate interstate and foreign commerce."); *see also* Time, Inc. v. T.I.M.E. Inc., 123 F. Supp. 446, 451 (S.D. Cal. 1954) ("[A]pplication of diverse state laws to federally-registered trade-marks would seriously hinder the effectiveness of [the Lanham Act] and largely defeat accomplishment of purpose of federal trade-mark registration. . . . [I]t was the Congressional will to occupy the field of claims arising from infringement of and unfair competition in the use of registered trade-marks and other marks defined in the Act, as well as trade names and commercial names, to the extent of federal power under the Commerce Clause [of the Constitution] . . . ." (citations omitted)).

In a world in which only registered marks could be enforced under federal law and the Lanham Act would supply the substantive law in cases involving registered marks, the drafters likely believed that registration would be pretty important, particularly as commerce grew increasingly national. Registration ensured that the registrant could enforce its mark in federal court and that federal law would apply. Significantly, many believed the applicable federal law in those cases would draw heavily on the uniform common law that had developed before *Erie*.[45] Federal law would not apply in cases that did not involve registered marks, and that left a lot of uncertainty about the content of the law that would apply in those cases. In addition to the benefits of constructive nationwide use and incontestability, the Lanham Act's expected enforceability benefits must have made registration seem too good to turn down.

But the drafters underestimated courts. Motivated by their own concerns about disuniformity and eager to expand trademark subject matter, courts in the decades after the Lanham Act was passed interpreted section 43(a) of the statute to provide a cause of action for infringement of unregistered marks.[46] Doing so required some creativity. In particular, courts had to interpret the term "origin" in the statute's "false designation of origin" language to refer to the commercial origin of goods or services. As the Supreme Court has occasionally noted, that interpretation was probably disingenuous—"origin" was meant to refer to geographic origin—but everyone now seems to have accepted the conclusion that section 43(a) provides a cause of action for infringement of unregistered marks.[47]

45 *See, e.g.*, S.C. Johnson & Son, Inc. v. Johnson, 175 F.2d 176, 178 (2d Cir. 1949) ("[A]lthough it is no longer open to doubt that the [Lanham Act] created rights uniform throughout the Union, in the interpretation of which [courts] are not limited by local law, it does not follow that, in determining what these are, [courts are] not to be guided by the existing common-law, especially in regard to issues as to which that law was well settled in 1946.").

46 Professor McCarthy suggests that this trend took root in the 1970s, and he attributes the expansion to the decision in *Federal-Mogul-Bower Bearings, Inc.* v. *Azoff*, 313 F.2d 405 (6th Cir. 1963). *See* 5 MCCARTHY, *supra* note 32, § 27:7. *Federal-Mogul-Bower* might have the most explicit construction of the statute along these lines, but several earlier cases allowed claims under section 43(a) for infringement of unregistered trademarks. *See, e.g.*, Scarves by Vera, Inc. v. United Merchants & Mfrs., Inc., 173 F. Supp. 625 (S.D.N.Y. 1959); Catalina, Inc. v. Gem Swimwear, Inc., 162 F. Supp. 911 (S.D.N.Y. 1958).

47 *See* Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 29–30 (2003) ("Although a case can be made that a proper reading of § 43(a), as originally enacted, would treat the word 'origin' as referring only to the geographic location in which the goods originated, the Courts of Appeals considering the issue, beginning with the Sixth Circuit, unanimously concluded that it does not merely refer to geographical origin, but also to origin of source or manufacture, thereby creating a federal cause of action for traditional trademark infringement of unregistered marks." (citations omitted) (internal quotation marks omitted)); Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768 (1992) ("[T]he general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a).").

At the same time courts were reinterpreting the Lanham Act's false designation of origin language, they and the Trademark Office began recognizing a much broader range of signs as trademark subject matter. That subject matter expansion went far beyond the secondary meaning marks the drafters meant to make registrable under section 2(f) and included product packaging and design, colors, sounds, and even scents.[48] None of those kinds of signs would previously have been considered trademarks, and as a result, their use by third parties would have been remediable only through common law unfair competition claims.[49]

By expanding the range of signs that could qualify as trademarks and interpreting section 43(a) to allow claims for infringement of unregistered marks, courts significantly expanded trademark law's footprint.[50] That expansion undermined the Lanham Act's drafters' assumptions about the value of registration as a way of securing federal jurisdiction and the application of substantive federal law, and as a result, they changed the calculus about pursuing registration considerably. Rather than encouraging claimants to register so that they could enforce their marks in federal court and under federal law, courts ensured that federal law would apply *regardless* of registration (and therefore that registration was not essential to federal courts' jurisdiction).[51] The result was a significant federalization of the field, but not because of increased incentive to register and thus without improving (and possibly exacerbating) the notice problem that so concerned Rogers and other drafters.[52]

There is one other way that courts' evolution of trademark law after the Lanham Act de-centered registration, and that has to do with the

48 *See, e.g.*, Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205 (2000) (holding that product design is protectable only with evidence of secondary meaning); Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159 (1995) (holding that colors are capable of protection when they have secondary meaning); *Two Pesos*, 505 U.S. 763 (holding that inherently distinctive, nonfunctional trade dress is protectable without evidence of secondary meaning); *In re* Clarke, 17 U.S.P.Q.2d (BL) 1238 (T.T.A.B. 1990) (holding that a scent is capable of serving as a trademark and is therefore registrable when shown to be distinctive); *In re* Gen. Elec. Broad. Co., 199 U.S.P.Q. (BL) 560 (T.T.A.B. 1978) (finding the sound of a series of bells capable of functioning as a service mark and registrable with evidence of secondary meaning).

49 McKenna, *supra* note 25, at 300–01.

50 *Id.*

51 It is worth mentioning here that, after passage of the Lanham Act, Rogers developed the view that section 44 of the statute, and not section 43, could be interpreted broadly to create a federal law of unfair competition. *See* Rogers III, *supra* note 23, at xvi-xxi (arguing that section 44(h) of the statute should be understood to give courts the ability to develop a uniform body of federal unfair competition law). That view was not widely shared, and notwithstanding a few early decisions taking the approach Rogers advocated, it was not readily accepted by courts. *See, e.g.*, Stauffer v. Exley, 184 F.2d 962 (9th Cir. 1950); Pagliero v. Wallace China Co., 198 F.2d 339 (9th Cir. 1952). To the extent his interpretation would have prevailed and included unregistered trademarks, it would have been in tension with his longstanding interest in a complete register.

52 *See* Jeanne C. Fromer & Mark P. McKenna, *Claiming Design*, 167 U. PENN. L. REV. 123 (2018) (describing a number of notice problems with modern trademark law, some of which are a consequence of recognizing unregistered rights).

expansion of the concept of likelihood of confusion. Under the 1905 Act, use of a mark was deemed infringing if the defendant used the mark for goods of "substantially the same descriptive properties" as those for which the mark was registered.[53] As we noted, Rogers disliked that language, which he found unclear and possibly too restrictive. He wanted a likelihood of confusion standard.

But whatever its flaws, the language of the 1905 Act had the virtue of making the registration the starting point of the analysis: evaluation of infringement required a comparison of the defendant's use to the goods for which the plaintiff's mark was *registered*. It's true that, even before the Lanham Act was passed, courts were starting to expand likelihood of confusion beyond directly competing goods, so they weren't always demanding identity.[54] But they had to admit they were doing "some violence" to the language of the statute to find infringement when the goods were different,[55] and that frequently kept them tethered more closely to the registration.[56]

The Lanham Act's presumptions of ownership and exclusive right to use extended only to the goods and services listed in the registration, and in the early years of the statute, courts sometimes focused on those presumptions in ways that continued to limit infringement actions.[57] Still, there is little question that the trend since the Act's passage has been

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53 Trade-Mark Act of 1905, ch. 592, § 16, 33 Stat. 724, 728, *repealed by* Lanham Act, ch. 540, § 46(a), 60 Stat. 427, 444 (1946).

54 *See, e.g.*, Aunt Jemima Mills Co. v. Rigney & Co., 247 F. 407 (2d Cir. 1917) (finding defendant's use of Aunt Jemima for syrup infringing of plaintiff's rights in the mark for pancake flour); Dwinell-Wright Co. v. Nat'l Fruit Prod. Co., 140 F.2d 618, 622 (1st Cir. 1944) (noting that "in spite of the doubts which have been expressed," the court sees no reason why the doctrine of expansion should not "appl[y] to trade-mark infringement cases as well as to cases of unfair competition"). *See also* 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, 1316–20 (2012) (describing the somewhat halting expansion of confusion with respect to non-competing goods in the decades before the Lanham Act).

55 Yale Elec. Corp. v. Robertson, 26 F.2d 972, 974 (2d Cir. 1928) ("While we own that it does some violence to the language, it seems to us that the phrase ['same descriptive properties'] should be taken as no more than a recognition that there may be enough disparity in character between the goods of the first and second users as to insure against confusion.").

56 *See, e.g.*, Walgreen Drug Stores v. Obear-Nester Glass Co., 113 F.2d 956, 963 (8th Cir. 1940) ("It is doubtful whether the doctrine of expansion of trade is applicable in a case of alleged infringement of a technical registered trade-mark."); Peninsular Chem. Co. v. Levinson, 247 F. 658, 660 (6th Cir. 1917) (holding that the certificate of registration specifying use of trademark for "chemicals, medicines, and pharmaceutical preparations" did not embrace cigars).

57 *See, e.g.*, Maas & Waldstein Co. v. Am. Paint Corp., 178 F. Supp. 498, 501 (D. Minn. 1959) (noting that the field to which a registered trademark extends is limited by the nature of the goods specified in the certificate of registration and that "[t]he exclusive right to use the mark is limited to use on the class described in the application"; whatever was not claimed in the certificate is not included in or protected as part of the mark owner's rights), *aff'd*, 288 F.2d 306 (8th Cir. 1961); Mont-O-Min Sales Corp. v. Wyeth Inc., 92 F. Supp. 150, 153–54 (W.D. Mo. 1950) (noting that under the Lanham Act, the right to exclusive use of a registered trademark is "limited to the particular description of goods described in the application").

toward broader protection against non-competing goods.[58] Even if that trend was already underway in courts before the Lanham Act, the new statute's infringement language loosened the connection to the registration by focusing on uses that cause confusion without specifically referring to the goods for which the mark is registered.[59]

As courts expanded the concept of confusion, especially through the idea of "sponsorship or affiliation" confusion, they allowed claims against uses ever more distant from the plaintiff's.[60] In that way, even if registrations give notice of the existence of rights, as Graeme Dinwoodie has noted, they often don't provide much notice about the *content* of those rights.[61] The notice problem is even worse with respect to unregistered marks, since obviously there's not even a registration to consult in those cases. Modern cases, whether they involve registered or unregistered marks, compare the parties' *uses*.[62]

## CONCLUSION

In sum, the various compromises reflected in the Lanham Act made it unlikely the Lanham Act would succeed in addressing all of the concerns of the drafters. But post-Lanham Act developments, and especially courts' interpretations of the statute, undermined some of the drafters' reasonable assumptions and changed the character of trademark law in a way that made it much less clear what role registration plays. So, while our foundational attachment to a use-based system will always limit the significance of registration, there is an alternative history in which registration might have played a bigger role than it actually has. Perhaps ironically, courts ensured that we didn't need a more robust registration system to federalize trademark law. But federalization by extension of federal law to unregistered marks came at the expense of improved notice.

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58 *See* Bone, *supra* note 54; Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413 (2010).

59 Lanham Act, ch. 540, § 2(d), 60 Stat. 427, 428 (1946) (current version at 15 U.S.C. § 1052(d) (2018)).

60 Lemley & McKenna, *supra* note 58.

61 Dinwoodie, *supra* note 32, at 8 (distinguishing between notice of the existence of rights and notice of the content of those rights, and describing the difficulty of rivals determining the content of rights (the "metes and bounds of existing properties") as "an arguably more important notice concern in contemporary trademark law"); *see also* Fromer & McKenna, *supra* note 52, at 132; Mark A. Lemley & Mark P. McKenna, *Scope*, 57 WM. & MARY L. REV. 2197, 2243–59 (2016) (discussing trademark law's challenges limiting the scope of rights).

62 *See* Tushnet, *supra* note 39, at 872 (describing registration as an elaborate origami crane that does not matter).