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In Search of the Trade-Mark Cases: The Nascent Treaty Power and the Turbulent Origins of Federal Trademark Law

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IN SEARCH OF THE *TRADE-MARK CASES*: THE NASCENT TREATY POWER AND THE TURBULENT ORIGINS OF FEDERAL TRADEMARK LAW

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For the past hundred and thirty years, the Supreme Court's unanimous opinion in the *Trade-Mark Cases*[1]—which invalidated the federal trademark laws enacted from 1870 through 1876 on constitutional grounds—has stood as one of the few cases to opine on the scope of the Intellectual Property Clause of the United States Constitution.[2] The Court held that congressional

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[1] 100 U.S. 82 (1879). The case is also referred to as *Steffens v. United States*. The short, practical name "Trade-Mark Cases" was part of the trend towards shorter and more useful case names begun during John William Wallace's tenure as Reporter of Decisions. Preface to 68 U.S. (1 Wall.) xiii–xiv (1863). The trend stemmed from his desire to prevent case names from becoming unwieldy since the case name "is only designed for facility of reference." *Id.* Wallace's practice in this area and others stood in stark contrast to the reporters who had preceded him, and his methodology was largely criticized. MORRIS L. COHEN & SHARON HAMBY O'CONNOR, A GUIDE TO THE EARLY REPORTS OF THE SUPREME COURT OF THE UNITED STATES 110–12 (1995). Many of Wallace's practices were followed by his successor William Tod Otto, who served as reporter for this case. It is general custom to address the case as "the *Trade-Mark Cases*." *See* John T. Cross, *The Lingering Legacy of* Trade-Mark Cases, 2008 MICH. ST. L. REV. 367, 367 n.1 (2008). While the definite article "the" is not part of the title, it is an indispensable way of regarding the decision, avoiding confusion as to whether one is discussing cases regarding trademarks more generally. As for the hyphenated form "Trade-Mark," the term seems to have generally been hyphenated in that day or written as two words, unhyphenated.

[2] *See Trade-Mark Cases*, 100 U.S. at 96; *see also* U.S. CONST. art. 1, § 8, cl. 8 ("[The Congress shall have Power To] promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."). The Clause is also "known variously as

regulation of both interstate and intrastate trademarks was impermissible on the grounds of both the Intellectual Property Clause and the Commerce Clause of the United States Constitution.[3] The generally accepted story of this case has been fairly straightforward—this opinion, arising out of several obscure criminal prosecutions, was a shock both to the nascent trademark community and to the broader legal world. Taken aback, Congress rushed into action a deeply inadequate trademark law premised on the incorrect belief that the Supreme Court had held that the Commerce Clause did not grant the power to regulate interstate trademarks, and thus regulated only trademarks used in commerce with foreign nations or the Indian tribes.

This story is deeply flawed in two respects. Firstly, it fails to consider the importance of the opinion of the Circuit Court for the Eastern District of Wisconsin in *Leidersdorf v. Flint*[4] a year before, as well as other less-known cases. That decision received national attention, not least because (the elder) Justice Harlan concurred with the opinion in that case and touched off a national debate among the scholars of the day about whether the trademark laws were constitutional. The issue was perhaps the most important for those concerned with trademark law in the year prior to the decision, thus making the Supreme Court's decision a less than total surprise.

More importantly, the standard history completely fails to consider the importance of foreign treaty obligations to the legislation before and after the *Trade-Mark Cases*. Attempts to establish a federal trademark law for domestic reasons failed to gain any traction in the years prior to the 1870 Act. By contrast, the 1870 Act was a result of bills introduced specifically to call into effect trademark treaties executed with foreign powers, and it quickly became law.[5] While it is reasonable to believe that a constitutional justification was an oversight once the trademark bills were folded into the then-pending omnibus IP act, it is likely

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'the Patent Clause' or 'the Copyright Clause' depending upon one's perspective and clientele." Anne H. Chasser, *A Historical Perspective: The International Trademark Association and the United States Patent and Trademark Office*, 93 TRADEMARK REP. 35, 38 (2003).

[3] *See Trade-Mark Cases*, 82 U.S. at 90.

[4] 15 F. Cas. 260 (C.C.E.D. Wis. 1878) (No. 8,219), *aff'd*, 100 U.S. 82 (1879).

[5] The 1870 Act was an omnibus act including copyright and patent revisions as well, but the origins of the trademark sections arose in independent bills.

that even beforehand, the constitutional rationale behind the bills that led to the 1870 trademark laws was that the Congress was simply calling into effect the treaties. The same rationale was clearly on display during the lengthy deliberations over what would become the 1881 Act—just like the 1870 Act, the 1881 legislation was enacted to call into effect the treaty obligations of the United States regarding trademarks, not to create a domestic trademark system.

The previous literature on trademark law in this era has yielded some insight, but an in-depth look at the history and meaning of the case and its milieu has not previously been done, and documentation of the early history of American federal trademark law is surprisingly sparse. Over one hundred years after it was written, the richest secondary source on the early history of the federal trademark law remains the report and (especially) the dissenting opinion of the commissioners authorized to study a modification of the nation's trademark and patent laws, issued in 1902.[6] While this report was written by men who had been present for many of the events described in this Article, it almost entirely limits its sources to the *Congressional Record* and other official publications. The seminal work on the history of American trademark law—Schechter's *The Historical Foundations of the Law Relating to Trade-Marks*—does not even go into as much detail as is presented in the report; it focuses more on even earlier history.[7] In the past few years, although several other works have explored history of trademark law in this era, they have had other focuses and did not go significantly beyond the account in the 1902 report.[8] While the decision and congressional

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[6] FRANCIS FORBES ET AL., REPORT OF THE COMMISSIONERS APPOINTED TO REVISE THE STATUTES RELATING TO PATENTS, TRADE AND OTHER MARKS, AND TRADE AND COMMERCIAL NAMES, S. Doc. No. 20 (2d Sess. 1902).

[7] FRANK I. SCHECHTER, THE HISTORICAL FOUNDATIONS OF THE LAW RELATING TO TRADE-MARKS (1925). In fact, Schechter mistakenly states that the 1876 Trademark Act was the replacement act, rather than the 1881 one. *Id.* at 140.

[8] Professor Cross, for example, provides a close reading of the Court's decision and was the first to seriously explore the role of the treaty power; his article focuses on what would have happened if the case was decided differently. *See* Cross, *supra* note 1, at 368. Professor Abdel-Khalik wrote an article primarily about scandalous marks, but she nonetheless provides useful historical background by noting the bill proposed in 1860. *See* Jasmine Abdel-Khalik, *To Live in In-"Fame"-y: Reconceiving Scandalous Marks as Analogous to Famous Marks*, 25 CARDOZO ARTS & ENT. L.J. 173, 181–82 (2007).

publications are important sources, a broader investigation is necessary to understand the early development of American trademark law.

The question that I seek to answer in this research is what exactly is the meaning of the *Trade-Mark Cases* in American history? In search of the meaning of the *Trade-Mark Cases* and the legislation that brackets it, questions far broader than the procedural history of the cases came to the fore. This Article delves into the first two decades of federal trademark law in America, starting with the first trademark bill in 1860 and proceeding to Congress's final reaction to the Supreme Court's decision in 1882. The procedural history of the cases and several other cases that examined the issue are also addressed, as well as the scholarly responses to them. Finally, entering the modern era, attempts to overrule the *Trade-Mark Cases* by constitutional amendment, both immediately after the holding and as late as 1955, are examined.

I. THE ORIGINS OF THE *TRADE-MARK CASES*

The very first discussion of a federal trademark law was surprisingly early—in 1791.[9] A Boston sailmaker named George Breck petitioned to be allowed to register his trademark with the new federal government, and the matter was sent to the Secretary of State Thomas Jefferson.[10] Jefferson produced a report advocating that a trademark law be passed by the federal government,[11] but nothing came of it, and a trademark law would

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[9] Edward S. Rogers, *Some Historical Matter Concerning Trade-Marks*, 9 MICH L. REV. 29 (1910), *reprinted in* 62 TRADEMARK REP. 239, 251 (1972).

[10] *Id.*

[11] THOMAS JEFFERSON, *Report on the policy of securing particular marks to Manufacturers, by Law*, *in* 3 THE WRITINGS OF THOMAS JEFFERSON 156, 156–57 (Andrew A. Lipscomb ed., 1905). The report reads:

> The Secretary of State, to whom was referred by the House of Representatives the petition of Samuel Breck and others, proprietors of a sail-cloth manufactory in Boston, praying that they may have the exclusive privilege of using particular marks for designating the sail-cloth of their manufactory, has had the same under consideration, and thereupon
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> Reports, That it would, in his opinion, contribute to fidelity in the execution of manufacturers, to secure to every manufactory an exclusive right to some mark on its wares, proper to itself.
>
> That this should be done by general laws, extending equal right to every case to which the authority of the legislature should be competent.
>
> That these cases are of divided jurisdiction: Manufactures made and consumed within a State being subject to State legislation, while those

not be contemplated by the federal government for nearly seventy years.

In the first half of the nineteenth century, the common law tort of fraud and deceit developed into common law protection for trademarks, and "[b]y the 1850s, common law rules against passing off and trademark infringement were well-accepted."[12] As the common law of trademarks began to coalesce, states also began to enact statutes clarifying civil remedies, as well as providing criminal remedies in some cases. In 1845, New York was the first state to pass a trademark law, providing for both criminal and civil remedies[13] but would hardly be the last; prior to 1870, eleven other states would also enact statutes respecting trademarks.[14]

For many legislators, these common law and state statutory protections for trademarks would be more than sufficient, while others would feel that protection was needed on a federal level. The argument that a federal statute was needed to protect domestic trademark holders would prove insufficient though, and only the need to execute treaties signed with foreign nations regarding trademarks would there be sufficient support for a federal trademark law.

> which are exported to foreign nations, or to another State, or into the Indian Territory, are alone within the legislation of the General Government.
>
> That it will, therefore, be reasonable for the General Government to provide in this behalf by law for those cases of manufacture generally, and those only which relate to commerce with foreign nations, and among the several States, and with the Indian Tribes.
>
> And that this may be done by permitting the owner of every manufactory, to enter in the records of the court of the district wherein his manufactory is, the name with which he chooses to mark or designate his wares, and rendering it penal in others to put the same mark to any other wares.

Id.

[12] J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 5:2 (4th ed. 2009).

[13] 1845 N.Y. Laws 304–05; Arthur W. Barber, *The Constitution and Trade-Marks*, 5 LAW. & BANKER & BENCH & B. REV. 210, 211 (1912).

[14] Forbes, *supra* note 6, at 91–92. The other states were Connecticut (1847); Pennsylvania (1847); Massachussetts (1850); Ohio (1859); Iowa (1860); Michigan (1863); Oregon (1864); Nevada (1865); Kansas (1866); Maine (1866); Missouri (1866). *Id.* Of these laws, eight provided for criminal remedies, two provided for civil and criminal remedies, and two provided civil remedies only. *Id.* Those states only providing criminal remedies presumably meant to complement the civil common-law trademark law.

A. *Early Lobbying and Failed Bills*

While 1860 was a year fraught with tensions, it was also a year of firsts for trademark law. Not only was the first American trademark treatise published,[15] but the first federal trademark bill was proposed.[16] On March 12, 1860, two representatives from Pittsburgh announced their intent to introduce a trademark bill,[17] and two days later, one of them, Rep. James K. Moorhead, did so; the bill was reported to the Committee on Commerce.[18] The bill was followed by petitions to both Houses: to the House, a petition from citizens of Lowell, Massachusetts[19] and from citizens of St. Louis, Missouri;[20] to both the House and the Senate, a petition from citizens of Pittsburgh, Pennsylvania.[21] Rep. Moorhead, had a commercial background[22] and would prove himself the prime exponent of a federal trademark law through the decade. His efforts would not be particularly successful.

The content of the bill was straightforward. "[A]ny person or persons who shall knowingly and wilfully forge or counterfeit" a mark with intent to pass it off as the product or mark of another "shall be deemed guilty of a misdemeanor, and be liable to indictment therefor, and, upon conviction thereof, shall be imprisoned for a period of not exceeding twelve months, and fined not exceeding three thousand dollars."[23] The same punishment would be available for an individual in possession of plates or molds, or otherwise in possession of illicitly marked

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[15] *See* FRANCIS H. UPTON, A TREATISE ON THE LAW OF TRADE MARKS (1860); Kristine M. Boylan, *The Corporate Right of Publicity in Federal Dilution Legislation*, 82 J. PAT. & TRADEMARK OFF. SOC'Y 5, 6 (2000).

[16] H.R. 330, 36th Cong. (1st Sess. 1860).

[17] *See* 56 HOUSE J. 504 (Mar. 12, 1860).

[18] CONG. GLOBE, 36th Cong., 1st Sess., 1147 (1860). Rep. Moorhead attempted to introduce the bill the previous day but was rebuffed by the Speaker. *Id.* at 1131.

[19] *See* 56 HOUSE J. 649 (Apr. 3, 1860) (introduced by Rep. Train). The writing on the back of the petition states that House Bill 330 was related to this petition, but the bill was introduced prior to the entry of this petition. *See* H.R. 330, 36th Cong. (1860). A copy of this petition is on file with the author.

[20] *See* 56 HOUSE J. 846 (May 16, 1860) (introduced by Rep. Barrett).

[21] 56 HOUSE J. 565 (Mar. 22, 1860) (introduced by Rep. Moorhead); 51 SEN. J. 375 (Apr. 10, 1860) (introduced by Sen. Cameron).

[22] *James Kennedy Moorhead*, 2 MAG. W. HIST. 478, 478–90 (1885).

[23] H.R. 330, 36th Cong. § 1 (1st Sess. 1860). The punishments given were less draconian in an earlier version of the bill at the National Archives, but since the House Journals say the bill was reported back without amendment, it is assumed that this earlier version and its changes date prior to the bill's introduction.

goods for distribution.[24] The bill was reported back to the House on May 18, 1860, without amendments,[25] accompanied by a report in favor of the measure.[26] The report argued for a federal trademark law but did not specify what constitutional provision it should be based on, referring to both the "encouragement of useful arts" and "just protection of trade" as being the duty of Congress.[27] Nonetheless, it was implied that trademark regulation was akin to patent regulation, and thus, the exercise of congressional power would flow from the same clause of the Constitution.[28]

Following the report, the bill was recommitted to the Committee on the Whole House on the State of the Union.[29] It would not be able to leave, as members of Congress would have doubts regarding its constitutionality in the second session of the Thirty-sixth Congress and refuse to allow a vote of the full House. On January 31, 1861, Rep. Noell objected to the bill's consideration, noting that he would "have no objection to it if the General Government had any power over this subject."[30] When Rep. Moorhead made the same motion the following week, Rep. Burnett made a similar objection, asserting that he could not withdraw his objection on these grounds "until the form of our Government is changed."[31] As such, came and went the only constitutionally based objections to federal trademark protection in Congress. No one arose again until after the *Trade-Mark Cases*.

The trademark bill would not be heard from again in the Thirty-sixth Congress. Rep. Moorhead introduced a trademark bill again in the Thirty-seventh Congress that was referred to the Judiciary Committee, but it went nowhere and no copy survives.[32] From 1866 to 1867, Rep. Moorhead once again made a concerted effort for a trademark act. Petitions once again arrived from Rep. Moorhead's home city to both the House and

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[24] *Id.* § 2. The same comment also applies.

[25] 56 HOUSE J. 863 (May 18, 1860).

[26] H.R. REP. NO. 36-527, at 1 (1st Sess. 1860).

[27] *Id.* at 2.

[28] *See id.*

[29] 56 HOUSE J. 863 (May 16, 1860).

[30] CONG. GLOBE, 36th Cong., 2d Sess. 670 (1861).

[31] *Id.* at 798.

[32] H.R. 235, 37th Cong. (2d Sess. 1862); 59 HOUSE J. 207 (Jan. 20, 1862). No copy of this bill exists in the National Archives or Library of Congress.

the Senate,[33] and shortly thereafter, a trademark bill was proposed.[34] The bill was referred to the Committee on Patents, not printed, and not heard from again.

All of these bills were, so far as can be told from the record, concerned primarily with protecting American trademarks within the borders of the United States. The Lowell Petition is explicit about this,[35] and in all other congressional materials relating to trademark reform until 1867, foreign marks were never mentioned. The fact that Congress was uninterested in these bills for both constitutional and normative reasons strongly contrasts with the reception afforded to international trademark treaties.

B. International Treaties

In the 1850s and 1860s, European nations began to pass trademark laws.[36] Belgium and Germany, among others, began to tighten their policies on patents to exclude trademarks from protection.[37] In these years, the press in the U.S. also took occasional notice of what were becoming increasingly frequent international trademark disputes.[38] By 1865, foreign nations

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[33] 59 SEN. J. 121 (Jan. 21, 1867) (introduced by Sen. Cowan); 64 HOUSE J. 182 (Jan. 17, 1867). The handwritten petitions appear to be the same for the two bodies and make a straightforward claim that they operated under a disadvantage due to the lack of federal trademark protection. This is followed by a request that Congress extend copyright law to encompass trademarks. 59 SEN. J. 121; 64 HOUSE J. 182. The Senate petition was initially referred to the Committee on Patents and the Patent Office, but it was moved to the Committee on Manufactures. 59 SEN. J. 121 (Jan. 31, 1867). There was also a petition the previous year from bottlers in the District of Columbia for trademark protection, but it does not seem to have been related. 58 SEN. J. 332 (Apr. 12, 1866) (introduced by Sen. Morril and referred to the Committee on the District of Columbia) (all petitions on file with author). Either way, a law limited to the District of Columbia would be free of the constitutional constraints dealt with in the *Trade-Mark Cases*.

[34] H.R. 1008, 39th Cong. (1st Sess. 1867); 64 HOUSE J. 197 (Jan. 17, 1867). No copy of this bill exists in the National Archives or the Library of Congress.

[35] Petition from the Citizens of Lowell, Mass., in Support of Bill 330 (Apr. 3, 1860) (on file with the author).

[36] WILLIAM HENRY BROWNE, A TREATISE ON THE LAW OF TRADE-MARKS 57–58 (1873).

[37] *See id.* at 21.

[38] Paul DuGuid, *French Connections: The International Propagation of Trademarks in the Nineteenth Century*, 10 ENTERPRISE & SOC'Y 1, 13–14 (2009) (discussing American opinion in an article on the development of French trademark law).

were inquiring about the status of trademark law in the U.S.;[39] it would not be long before this curiosity morphed into negotiation. The first trademark treaty was signed with Russia in 1868,[40] followed shortly thereafter by treaties with Belgium[41] and France.[42] With each of these treaties, a question would linger as to whether they were self-executing or whether their enactment required affirmative legislation by congress.

In September 1867, the U.S. expressed interest in a trademark treaty with Russia, and Russia indicated its willingness to do so in late 1867, proposing that it be drawn along the lines of article 22 of its Treaty of Commerce with France.[43] The treaty was negotiated during January 1868 in Washington, D.C.[44] and signed on January 27.[45] It was transmitted to the Senate on the following day,[46] and ratification was advised that summer.[47] The treaty read, in pertinent part:

> The High Contracting Parties, desiring to secure complete and efficient protection to the manufacturing industry of their respective citizens and subjects, agree that any counterfeiting in one of the two countries of the trade marks affixed in the other on merchandize to show its origin and quality, shall be strictly prohibited and repressed, and shall give ground for an action of damages in favor of the injured party, to be prosecuted in the courts of the country in which the counterfeit shall be proven.
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> The trade marks in which the citizens or subjects of one of the two countries may wish to secure the right of property in the other, must be lodged exclusively, to wit, the marks of citizens

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[39] 11 Op. Att'y Gen. 352 (1865) (responding to a letter from the Austrian Minister inquiring about trademark protections in the United States).

[40] Additional Article to Treaty of Commerce, 1832. Trade-Marks., U.S.-Russ., Jan. 27, 1868, *reprinted in* 2 TREATIES, CONVENTIONS, INTERNATIONAL ACTS, PROTOCOLS AND AGREEMENTS BETWEEN THE UNITED STATES AND OTHER POWERS 1524 (William H. Malloy ed. 1910) [hereinafter MALLOY].

[41] Additional Article to Treaty of July 17, 1858, Concerning Trade-Marks, U.S.-Belg., Dec. 20, 1868, *reprinted in* 1 MALLOY, *supra* note 40, at 86.

[42] Trade-Mark Convention, U.S.-Fr., Apr. 16, 1869, *reprinted in* 1 MALLOY, *supra* note 40, at 534. It has been argued that the French treaty was the most important in spurring the drafting of the 1870 Act. Duguid, *supra* note 38, at 28–29.

[43] Letter from the Chancellor of the Empire of Russ. to the U.S. to William Seward, Sec'y of State (Dec. 1, 1867) (on file with Dept. of State Papers, Nat'l Archives, College Park, Md.).

[44] Message of the President for the Third Session of the 40th Congress, 65 HOUSE J. 39 (Dec. 10, 1868).

[45] 16 SEN. EXEC. J. 157 (1868).

[46] *Id.*

[47] *Id.* at 371–72.

> of the United States, in the Department of Manufactures and Inland Commerce, at St. Petersburg, and the marks of Russian subjects, at the Patent Office in Washington.[48]

This treaty's provisions created, for the first time, a registry at the Patent Office (then in the Department of the Interior) for trademarks.[49] They also created a civil cause of action for damages, although whether injunctive relief would likewise be permitted is less clear.[50]

The next trademark treaty was with Belgium, later in 1868. Following up on an "intimation" from the minister to Belgium, the Secretary of State authorized him to conclude a trademark convention along the lines of the one concluded with Russia.[51] The Belgian government objected to the phrase "and repressed" in the Russian treaty, feeling that it suggested criminal jurisdiction and also insisted on additional language about marks in the public domain.[52] Aside from these changes, the treaty was substantially identical to the Russian treaty in verbiage and was advised on by the Senate in much shorter order than the Russian treaty.[53]

With these two treaties signed and ratified, the ball began rolling for treaties with major commercial powers; France was the first. The Emperor, Napoleon III, noted the trademark treaties in his 1869 address and specifically asserted that France was prepared for such an arrangement.[54] Such an arrangement was concluded April 16, 1869, and ratified in short order.[55] In

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[48] Additional Article to Treaty of Commerce, 1832. Trade-Marks., U.S.-Russ., Jan. 27, 1868, *reprinted in* 2 MALLOY, *supra* note 40, at 1524.

[49] *Id.*

[50] *Id.*

[51] Letter from William Seward, Sec'y of State, to Henry Sanford, Ambassador to Belg. (Nov. 17, 1868) (on file with author).

[52] Letter from Henry Sanford, Ambassador to Belg. to William Seward, Sec'y of State (Dec. 20, 1868) (on file with author). This letter also transmitted the proposed treaty and noted that the problem was mostly of American trademarks being infringed in Belgium. Belgium also wanted protections for designs and models, where the situation was the reverse, but the ambassador did not feel that his instructions from the Secretary of State included such authorization. Letter from the Belgian Dept. of Interior to Henry Sanford, Ambassador to Belg. (Dec. 11, 1868); Letter from Henry Sanford, Ambassador to Belg. to William Seward, Sec'y of State.

[53] 16 SEN. EXEC. J. 463–64 (1869).

[54] Napoleon III, Report on the Conditions of the Empire, for 1869, made to the Senate and Legislative Assembly of France (1869) (translation on file with state department). The handwritten translation in the State Department papers says this alludes specifically to the treaty with Russia.

[55] 17 SEN. EXEC. J. 219 (1869).

substance, it was similar to the Belgian treaty—save that it fixed that this arrangement was limited by the duration normally given to trademarks in the relevant country. Other treaties would be made throughout the 1870s and beyond, but a question quickly reared its head—need domestic legislation be passed in America as a result of these treaties?

That treaties are the "supreme Law of the Land," on par with statutes, is set forth in the Constitution.[56] Arising out of the Louisiana Purchase and annexation of Florida, the Supreme Court's opinion in *Foster v. Neilson*[57] was the definitive word at the time regarding whether a treaty is self-executing. In pertinent part, it said:

> A treaty is in its nature a contract between two nations, not a legislative act. It does not generally effect of itself the object to be accomplished, especially so far as its operation is infra-territorial, but is carried into execution by the sovereign power of the respective parties to the instrument.
>
> In the United States a different principle is established. Our constitution declares a treaty to be the law of the land. It is consequently to be regarded in courts of justice as equivalent to an act of the legislature, whenever it operates of itself without the aid of any legislative provision. But when the terms of the stipulation import a contract, when either of the parties engages to perform a particular act, the treaty addresses itself to the political, not the judicial department; and the legislature must execute the contract before it can become a rule for the Court.[58]

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[56] U.S. CONST. art. VI, cl. 2; *see also* United States v. Schooner Peggy, 5 U.S. (1 Cranch) 103, 109–10 (1801). To wit:

> The constitution of the United States declares a treaty to be the supreme law of the land. Of consequence its obligation on the courts of the United States must be admitted. It is certainly true that the execution of a contract between nations is to be demanded from, and, in the general, superintended by the executive of each nation, and therefore, whatever the decision of this court may be relative to the rights of parties litigating before it, the claim upon the nation is unsatisfied, may still be asserted. But yet where a treaty is the law of the land, and as such affects the rights of parties litigating in court, that treaty as much binds those rights and is as much to be regarded by the court as an act of congress.

Schooner Peggy, 5 U.S. (1 Cranch) at 109–10.

[57] 27 U.S. (2 Pet.) 253 (1829).

[58] *Id.* at 254.

Over forty years after the decision in *Foster*, it was still one of the few pronouncements on this issue.[59] All of the trademark treaties specifically gave a cause of action in the courts of each nation, and thus, were most likely self-executing. Even if causes of action had not been specifically mentioned in the treaties, the Supreme Court addressed the question of whether a treaty could provide jurisdiction for a cause of action when a treaty did not specifically create a cause of action, leading to the possible inference that such a treaty need not specifically enact a cause of action to be self-executing.[60] Nonetheless, it would only be prudent to put legislation in Congress, both to ensure the execution of the treaties and to put greater detail into the procedure of their enforcement.

This leads to the second question: Under what authority could Congress pass executory legislation generally? In the 1920 case *Missouri v. Holland*,[61] the Supreme Court held that the making of a treaty gave Congress the power to enforce its provisions even if Congress would otherwise lack the power to enact the legislation.[62] However, that case was still a half-century away in 1870, and it is unclear to what degree such a power was recognized at the time. The primary tension with such a power is the Tenth Amendment, with its reservation of powers not enumerated to the states.[63] Some have argued that until *Missouri v. Holland*, the treaty power only permitted Congress to legislate up to the limits of its enumerated powers.[64] Others have argued that the treaty power extended further at the time and permitted Congress to act even in areas where such action would otherwise be prohibited.[65] While arguments for both sides are compelling, it does not seem that Congress or the courts took the latter, "nationalist," view of the treaty power in 1870. 1880 would be less clear.

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[59] Leslie Henry, *When is a Treaty Self-Executing*, 27 MICH. L. REV. 776, 777 (1929).

[60] United States v. Ferreira, 54 U.S. (13 How.) 40, 43 (1852).

[61] 252 U.S. 416 (1920).

[62] *Id.* at 432–35.

[63] *See* U.S. CONST. amend. X.

[64] *See* Curtis A. Bradley, *The Treaty Power and American Federalism*, 97 MICH. L. REV. 390, 419–22 (1998).

[65] *See* David M. Golove, *Treaty-Making and the Nation: The Historical Foundations of the Nationalist Conception of the Treaty Power*, 98 MICH. L. REV. 1075, 1239–44 (2000).

C. The 1870 Act

While no record survives, it seems that trademarks were deposited in the Patent Office under these treaties even prior to any formal enactment executing these treaties.[66] This gave the matter a certain urgency, and, apropos of these treaties, two separate bills were introduced as Senate Bills 264 and 265 on April 7, 1869.[67] The former bill assumed that the civil remedies of the Russian treaty were self-executing and provided criminal remedies for the infringement of Russian trademarks.[68] The latter bill, by contrast, was proposed simply to execute the treaties that had just been concluded; specifically, it was proposed to "carry into effect the stipulations" of trademark treaties more generally.[69] The bills were referred to different committees, and both were referred back and debated on the same day, two weeks later.[70] On that day, Senator Trumbull noted that the introduction of both bills had been a mistake and asked that his bill (Senate Bill 264) be withdrawn in favor of Senate Bill 265.[71] There was some debate over whether the bill added anything to the law, and Senator Sumner said that the purpose of the bill was simply to effectuate the three treaties already signed.[72] Without much more debate, the bill was passed by the Senate.[73] Concurrence was requested from the House,[74] but the House did not take a straightforward approach in concurring with this bill.

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[66] *See* Letter from Mr. J.E.W. Bowen, Exam'r of Trademarks, to Rep. N.J. Hammond, Member of the House of Representatives (Feb. 23, 1880) [hereinafter *Bowen Letter*] (on file with the House Committee on the Judiciary in the National Archives). Apparently they were not registered, and no record was kept—this was simply his recollection. *See id.*

[67] *See* 63 SEN. J. 133 (Apr. 7, 1869).

[68] *See* S. 264, 41st Cong. (1st Sess. 1869).

[69] S. 265, 41st Cong. (1st Sess. 1869). Indeed, the treaty would be sent to the Senate by the President a week later and consented to three days after that. 17 SEN. EXEC. J. 219 (1869); 17 SEN. EXEC. J. 196 (1869).

[70] *See* CONG. GLOBE, 41st Cong., 2d Sess. 2894 (1869). Senate Bill 264 was referred to the Committee on the Judiciary, while Senate Bill 265 was referred to the Committee on Foreign Relations. *See* 63 SEN. J. 133 (Apr. 7, 1869).

[71] CONG. GLOBE, 41st Cong., 2d Sess. 2894.

[72] *Id.* The argument in the contrary was simply that foreigners could already sue in the federal courts to enforce their common law trademark rights. *See id.* at 2894–95.

[73] *See id.* at 2895.

[74] *See id.* at 2932.

Less than a year later, in the second session of the Forty-first Congress, a slew of bills would be introduced on the subject of foreign trademarks. The first was introduced by Senator Trumbull (who had also introduced Senate Report 264) as Senate Report 501 on February 7, 1870 and referred to the Committee on the Judiciary.[75] Entitled "A Bill [m]ore effectually to provide for the execution of treaties for the protection of the owners of trade marks," it would effectuate trademark treaties by granting the circuit courts jurisdiction to hear cases under trademark treaties.[76] The second was introduced in the House as House Bill 1824 on April 19, 1870, and doubled the tariff on imported goods bearing a false trademark of American goods.[77] The final one was fairly limited, introduced two days later, and dealt solely with imported watches.[78]

This myriad of bills from the second session were ultimately distractions. Rather than taking a simple position on concurring with the Senate Bill, the House took a much more ambitious approach and combined the trademark bill with the full revision of the nation's intellectual property laws then occupying the Committee on Patents.[79] House Bill 1714 started out as a patent revision and then had copyrights added to it.[80] As it came towards completion, trademarks would be added as well.[81]

Representative Thomas B. Jenckes first brought up this development to the whole Congress on April 14, 1870, in a lengthy explanation of the omnibus bill. The trademark bill received limited mention; he noted that it simply provided an

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[75] *See* 64 SEN. J. 209 (Feb. 7, 1870).

[76] S. 501, 41st Cong. (2d Sess. 1869).

[77] *See* H.R. 1824, 41st Cong. (1870); 69 HOUSE J. 640 (Dec. 6, 1869).

[78] *See* S. 829, 41st Cong. (2d Sess. 1870); 64 SEN. J. 529 (Apr. 21, 1870). This bill was sent to the Committee on Finance and reported with minor amendments a week later. 64 SEN. J. 566 (Apr. 28, 1870). Apparently this bill was meant to address the specific problem of foreign counterfeiting of American watches, which were then imported to the U.S. and sold at lower prices. *See A Needed "Protection,"* CHI. TRIB., June 14, 1870, at 2; *see also* Editorial, N.Y. TRIB., Oct. 29, 1870, at 4 (noting that watch importers had threatened to spend a large sum of money to defeat the bill).

[79] *See* H.R. 1714, 41st Cong. (2d Sess. 1870). The history of the bill more generally can be found at WILLIAM F. PATRY, 1 PATRY ON COPYRIGHT § 1:33 (2009).

[80] *See* PATRY, *supra* note 79.

[81] *Id.* Unfortunately, there is no documentation of when trademarks were added to the bill or the motivation for including them in the omnibus bill—what evidence there is of the committee's deliberations does not include such detail.

alternative to state protection and did not go beyond the contours of common law trademark protection.[82] He then explained the reasons for introducing a federal trademark law at that time:

> Concerning trade-marks, we are at present in an anomalous condition, which perhaps is not understood by the House generally. By certain treaties or conventions with Belgium, France, and Russia, we have agreed to recognize the validity of the trade-marks of those countries upon their being registered in the Patent Office of the United States, and to give them the same effect throughout the United States that they have in the country where they originated; and trade-marks recognized by the law of this country have the same effect throughout those European countries as the trademarks secured by the citizens or subjects of those countries. Thus by treaties, which are a part of the supreme law of the land, we have secured to subjects of those three nations rights which are not by national law secured to citizens of the United States. The right, which it is proposed to protect by registration of trademarks are not greater in any sense than those which are secured to citizens of foreign countries. In fact, these provisions are substantially those of the continental nations, and also those of the trade-marks statute of Great Britain, with which country I believe we are also engaged in negotiations for a similar treaty. The desirableness of these provisions I have not heard questioned by any one.[83]

Although discussion of technical aspects of the trademark bill would continue for some time, discussions of whether such a trademark law was truly necessary were more or less over. Perhaps even more surprisingly, given the reaction to the trademark bill offered a decade earlier, whether the trademark law was constitutional never came up. Not only is there no discussion of it in the record, but it seems that there was no discussion of the power of Congress in this area at all.[84] Rep. Orestes Cleveland, one of the members of the Committee on Patents in the House at the time, recalled that "no question was raised on the power of Congress, under the Constitution, to

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[82] *See* CONG. GLOBE, 41st Cong., 2d Sess. 2683 (1869).

[83] *Id.*

[84] *See The Federal Trade-Mark Statutes*, 19 ALB. L.J. 5, 7 (1879).

legislate on that subject. My own Impression is that the power of Congress was considered beyond question—taken for granted in fact. Nobody, so far as we knew, having ever raised the point."[85]

While one reason for the lack of questions regarding the Act's constitutionality was that the bill was conceived for and focused on other areas of intellectual property law, there was more to it than that—the Act became law with the main purpose of the trademark sections being to call into effect the treaties that had and would be made with foreign powers. Not only are the aforementioned circumstances strong evidence of that purpose, but the truth of this matter was obvious to contemporary observers.[86] While domestic trademarks were, perhaps, not absent from the consideration of the 1870 Act, they were neither the impetus for the law nor the prime reason for its passage and seem to have been of no more than evanescent concern. Given this, the reason for the lack of concern for the constitutionality of the bill becomes apparent—Congress saw itself as simply executing international treaties. This foreign focus in trademark legislation, however, would not last long, as the lobbying for the next bill would demonstrate.

D. The Criminal Trademark Act

Following the trademark act, Congress's next action was to pass legislation moving labels to the patent office,[87] but despite some confusion and early legislative history to the contrary, this was not a trademark law.[88] In 1876, however, Congress did amend the trademark laws directly and passed a law

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[85] *Id.*

[86] *Id.* at 6 ("In order to give full effect to the treaties with Russia, Belgium and France, which were negotiated in aid and encouragement of the commercial relations between the countries mentioned and the United States, Congress enacted the registration act of July, 1870."); BROWNE, *supra* note 36 at v ("[T]he principal object that [the 1870 Act] had in view, it must be confessed, was the matter of reciprocity.").

[87] Act of June 18, 1874, ch. 301, § 3, 18 Stat. 78, 78–79 (1874).

[88] *See generally* Fargo Mercantile v. Brechet & Richter Co., 295 F. 823 (8th Cir. 1924) (discussing how Congress did not intend the labels to be trademarks); PATRY, *supra* note 79, § 1:35 (citing the author's work-in-progress "The Unwanted Copyrights") (discussing the early implementation of the Act). The original conception of this law had specifically classified labels and prints as trademarks, but the final version specified that labels and prints were not. *Fargo*, 295 F. at 826; PATRY, *supra* note 79, § 1:35. Nonetheless, there was some confusion, and some courts held that prints and labels were, in fact, trademarks. Schumacher v. Wogram, 35 F. 210 (C.C.S.D.N.Y. 1888).

substantially expanding the penalties for trademark infringement, making trademark infringement a criminal act under federal law.[89] The prosecutions at issue in the *Trade-Mark Cases* would be under the 1876 Act.

Only a few years after it was passed, this Act was denigrated at length on the floor of the House. Explaining why it should not be reenacted after the *Trade-Mark Cases*, the author of the 1881 Act stated that:

> The bill was introduced into the Senate and passed there without discussion. It was so carelessly written that the language covered commerce wholly within the States, as well as without. It was so hastily gotten up that its short title is ungrammatical and the Supreme Court did not know what Congress intended to express by the act.[90]

While certainly dramatic, this misrepresents the bill's actual history. In fact, the 1876 Act was debated rather extensively, going back and forth between Houses with differing amendments multiple times. The 1876 Act represented the victory of more moderate elements in the House of Representatives as compared to the more severe bill, which the Senate advocated.

The origins of the 1876 Act were largely borne of concerns of domestic commerce, unlike the 1870 Act it supplemented.[91] By 1876, twenty-two states provided for criminal remedies for trademark infringement,[92] but such remedies could be difficult to enforce, and a need was seen for uniformity. The bill was introduced by Sen. Roscoe Conkling as Senate Bill 846 of the Forty-fourth Congress, and petitions soon flooded into Congress from manufacturers in New York, Massachusetts, and Pennsylvania.[93] The main lobbyist for this bill was Edward

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[89] Act of Aug. 14, 1876, ch. 273–74, 19 Stat. 141, 141 (1876).

[90] 10 CONG. REC. 2704 (1880).

[91] Whilst making available the same remedies in America as those abroad was mentioned, reciprocity does not seem to have been the primary motivation.

[92] Letter from Edward W. West, Of Counsel, N.Y. Merchs., to Hon. Geo. F. Edmunds. Chairman of the Judiciary Comm. (May 11, 1876) (on file with the author). The states included all those with any trademark law prior to 1870, along with: Arizona, California, Illinois, Indiana, Mississippi, Montana, Nebraska, New Jersey, North Carolina, and Wisconsin. Twenty-one other states did not have such a provision in their criminal laws. *Id.*

[93] Petition from the Merchants, Bankers, Manufacturers, Traders, and Others of Mass. to the Senate and House of Representatives (June 24, 1876) (on file with author); Petition from the Merchants, Bankers, Traders, Manufacturers, and Others of N.Y. to the Senate and House of Representatives (May 22, 1876) (on file with

West, a New York lawyer who represented the "New York Merchants."[94] Mr. West presented a series of points supporting the bill to Congress, alleging that the existing remedies at law were "tedious, unsatisfactory, and cost much more than any damages recovered," in part because the specific amount of damages had to be proven—a difficult task.[95] Furthermore, an injunction was easily ignored, as the pirate's brother or friend would simply take over the business, requiring a new proceeding to get a new injunction.[96] West then noted that in France, trademark counterfeiting was already a crime and that America should give the same options to trademark holders in foreign countries that it had treaties with as they had in their home country.[97] These points were then reprinted as a pamphlet, along with the text of the bills, the petitions, and op-eds from the *New York Times* and *New York Commercial Journal* (calling the proposed criminal penalties "really too light") in favor of the bill.[98]

While the merchants financed this campaign in favor of a federal law criminalizing trademark infringement, Congress was substantially less eager. On May 18, 1876, the bill was introduced in the Senate and referred to the Committee on the Judiciary.[99] It was referred back with amendments on June 26th,[100] and debate was commenced on June 29th, which was opened by Mr. Conkling explaining how the Committee had dramatically lengthened the prison terms from the original bill.[101]

Following the reading of the various agreed-to amendments, Senator Dawes asked if the bill was meant to also allow for a cause of action against those manufacturing goods that are quite

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author); Petition from the Merchants, Bankers, Manufacturers, Traders, and Others of Penn. to the Senate and House of Representatives (June 8, 1876) (on file with author).

[94] *See* West, *supra* note 92.

[95] *Id.* at 2.

[96] *Id.* at 2–3.

[97] *Id.* at 3.

[98] Pamphlet on Trademarks, In the matter of the petitions of the Merchants, Bankers, Traders, Manufacturers, Corporations, and others of New York, Boston, Philadelphia, and Other Cities to Congress that Senate Bill No. 846, be made law (on file with author).

[99] 4 CONG. REC. 3146 (1876).

[100] *Id.* at 4133.

[101] *Id.* at 4234.

similar to trademarked goods—for instance clothing of similar design—to which Senator Conkling answered in the negative; it was simply meant to punish knowing trademark infringement.[102] After this short discussion, the Senate passed the bill on June 29, 1876.[103] The House then proceeded towards consideration of the bill, but after the clerk began to read the bill, Rep. Cox advised that it be referred to the House Committee on Patents instead, and it subsequently was.[104]

In July of 1876, the House Committee on Patents returned with an amended version of the Senate bill.[105] The Committee's changes were generally aimed at softening the bill's bite in three critical respects: the state would have the burden of proof to prove willful intent to defraud with counterfeit marks; money paid in damages would return to the government, since the civil cause of action would remain; and the forfeiture of counterfeit goods would not be required.[106] After several minor amendments from Rep. Conger were likewise added, the House passed the bill as amended.[107]

This was not, however, the end of the matter. On July 31, the Senate disagreed with the amendments of the House and resolved to create a conference of the two Houses to resolve the disagreement.[108] On August 11, 1876, the House took up the Conference Report, which offered a compromise between the House and Senate versions, launching a heated debate on the matter.[109] Rep. Hewitt noted that the New York City Junk Dealer's Association objected to the bill on the grounds that many times "cast-off articles" such as bottles would still bear the trademark of the former manufacturer; he asserted that the bill had not been given the necessary attention to allow for it to be passed.[110] Rep. Sampson rejected the assertion that the bill had been hastily considered and also noted that Rep. Hewitt had previously introduced a bill calling for even stiffer penalties

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[102] *Id.* at 4234–35.

[103] *Id.* at 4235.

[104] *Id.* at 4493.

[105] *Id.* at 4775.

[106] *See id.*

[107] *See id.*

[108] *See id.* at 5014. The conference was comprised of Reps. Bagley, Hartzell, and Sampson, as well as Senators Conkling, Frelinghuysen, and Stevenson. *Id.* at 5478.

[109] *See id.*

[110] *Id.*

against trademark violators.[111] The House then voted and rejected the Conference Report.[112] With precious little time left in the session and with some reservations, Sen. Conkling decided that the House bill was "better than no bill at all," and on his recommendation, the Senate receded from its disagreement with the House.[113]

While there was some haste in the bill's passage, the situation was far from being that of a punitive bill passed with little or no debate. Rather, as a result of the delay arising out of substantial debate and consideration, the far more moderate version of the bill prevailed.

II. THE PATH TO THE *TRADE-MARK CASES*

For a short period of time, federal trademark law bloomed. Following the passage of the 1870 Act, additional trademark treaties were entered into, including treaties with Austria-Hungary,[114] Germany,[115] Great Britain,[116] and Brazil.[117] The constitutionality of the federal trademark was not immediately questioned by the courts or lawyers, and these laws were applied repeatedly, most famously by the Supreme Court in *McLean v. Fleming*.[118] After the criminal trademark act raised the stakes for trademark infringement, however, both judges and lawyers began to question the constitutionality of the federal trademark laws.

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[111] *Id.* at 5478–79. Rep. Hewitt asserted that he had introduced that bill at the request of his constituents but did not personally agree with the bill. *Id.* at 5479. There is no record of Rep. Hewitt introducing such a bill in the Forty-fourth Congress.

[112] *Id.*

[113] *Id.* at 5453.

[114] *See* Trade-Mark Convention, U.S.-Austria-Hung., Nov. 25, 1871, 17 Stat. 917.

[115] *See* Consular Convention, U.S.-German Empire, Dec. 11, 1871, 17 Stat. 921.

[116] *See* Declaration Affording Reciprocal Protection to Trade-Marks, U.S.-Gr. Brit., Oct. 24, 1877, 20 Stat. 703.

[117] *See* Agreement Concerning Trade-Marks, U.S.-Braz., Sept. 24, 1878, 21 Stat. 659.

[118] *See* 96 U.S. 245, 254 (1877) (describing the federal common law definition of trademark as "consist[ing] of a name, symbol, figure, letter, form, or device, if adopted and used by a manufacturer or merchant in order to designate the goods he manufactures or sells to distinguish the same from those manufactured or sold by another").

A. Duwell v. Bohmer

The first reported case on the constitutionality of the trademark acts, *Duwell v. Bohmer*,[119] has frequently been characterized as opining that the Intellectual Property Clause of the Constitution did encompass trademarks. This characterization is not quite accurate, but the case did come to stand for such a holding, and it led directly to the commentary that led to *Leidersdorf* and then the *Trade-Mark Cases* themselves.

Duwell was reported from oral proceedings by William Searcy Flippin, and the background of the case is not discussed beyond a statement that this was a civil case for infringement of a mark that had been registered under the federal law.[120] Counsel for the alleged infringer filed a demurrer, arguing that the court had no jurisdiction to hear the case as there was no statute giving the court jurisdiction over the defendant, never mentioning the Constitution.[121] Rather, the statute granting jurisdiction in the federal courts in intellectual property matters only mentioned copyrights and patents,[122] which the infringer's counsel took to mean that Congress had meant jurisdiction in trademark matters to lie in the state courts, as it had before the 1870 Act, thus barring subject-matter jurisdiction.[123] Counsel for the alleged infringed party responded that there had always been jurisdiction over copyright and patent claims under the federal laws, that the trademark laws were part of the copyright laws (to which it was numbered consecutively as part of one integrated act), and that the entire Act was enacted pursuant to Congress's

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[119] 8 F. Cas. 181 (S.D. Ohio 1878) (No. 4,213).

[120] Unfortunately, the files of the Southern District of Ohio for this period are in some disarray, and the original case file could not be located.

[121] *Duwell*, 8 F. Cas. at 181. A demurrer is a "pleading stating that although the facts alleged in a complaint may be true, they are insufficient for the plaintiff to state a claim for relief and for the defendant to frame an answer." BLACK'S LAW DICTIONARY 465 (8th ed. 2004). In most jurisdictions this has been replaced by the motion to dismiss. *Id.*

[122] U.S. REV. STAT. § 629. The statute states that "The circuit courts shall have original jurisdiction [of] all suits at law or in equity arising under the patent or copyright laws of the United States." *Id.* The 1870 Act specifically provides for federal jurisdiction for both patent and copyright cases, with no such section for trademarks. Act of July 8, 1870, ch. 230, 16 Stat. 206, 215. As the trademark sections were added last to the bill, it is most likely that the failure to amend this section for trademarks was simply an oversight, but it is within the realm of possibility that it was intentional.

[123] *See Duwell*, 8 F. Cas. at 181.

power under the Intellectual Property Clause.[124] It was further noted that federal courts had ruled on trademark matters in the past where both parties were from the same state and where jurisdiction had not been questioned.[125]

As such, the question raised by the demurrer was *not* whether Congress had the power under the Copyright Clause to enact the 1870 Act—the parties were in agreement that Congress held the power. The reason the citizenship of the parties was relevant was because the infringer argued that the court had no jurisdiction because the statute giving the federal courts jurisdiction in the 1870 Act only mentioned copyrights and patents, and there was neither diversity of citizenship nor the minimal amount ($500 at the time) in controversy.[126]

The question in *Duwell* was one of statutory interpretation, not of constitutional law: Did the jurisdictional section of the 1870 Act include trademarks? If it did, then neither diversity nor $500 was at issue since subject matter jurisdiction existed due to the statute. Judge Swing, like both parties in the case, did not question that the trademark laws were validly enacted under Article I, Section 8 of the Constitution.[127] Regarding the question that was raised, he found little guidance from other authorities,[128] but since Bump's Treatise, *The Law of Patents, Trade-Marks, and Copy-Rights*, took it as a given that the circuit courts had jurisdiction, and the headings of the law make it clear that the Act was meant to encompass all three forms of intellectual property, the court held that it had jurisdiction to hear the case.[129]

While the case itself did not address the general constitutionality of the trademark laws, there can be no question that Judge Swing's statement that "[t]he copyright and trade mark laws all come from the same source. So if the trade mark act of 1870 be a copyright law, then the court has jurisdiction"[130]

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[124] *See id.* at 181–82.

[125] *See id.* at 182.

[126] *See id.* at 181–82.

[127] *See id.*

[128] *Id.* at 183 ("I have looked into every book and in all reported decisions, and have been unable to find anything in which the question has been determined.").

[129] *Id.* (citing ORLANDO F. BUMP, THE LAW OF PATENTS, TRADE-MARKS AND COPYRIGHTS 13 (1st ed. 1877)).

[130] *Id.* at 182.

practically invites the question of whether the Trademark Act of 1870 was, in fact, a copyright law for constitutional purposes. It would be raised directly before the courts soon enough.

B. Leidersdorf v. Flint

Setting the stage for the *Trade-Mark Cases* decided one year later, the U.S. Circuit Court for the Southern District of Wisconsin found the trademark laws unconstitutional in a written opinion by Judge Charles E. Dyer.[131] The underlying dispute was between Bernhard Leidersdorf and Henry Mendel, purveyors of tobacco under a singularly offensive name with the image of an African individual, and John G. Flint, purveyor of tobacco under a marginally less offensive name with the image of a Native American individual. The plaintiffs sought an injunction on the grounds that Flint's trademark constituted an infringement of the Leidersdorf trademark.[132] Both parties were from and doing business in Milwaukee, and there was no evidence that Flint's product was sold outside Wisconsin. Although the marks seem rather different from this description, the colors of the trademarks, their composition, the ways the letters are formed, and their general appearance are not so different.[133] Furthermore, the complainant provided evidence of actual confusion on the part of consumers[134] and evidence that the Flint trademark was intended to fool consumers.[135]

Roughly a month and a half later, Flint's counsel responded to the allegations with a general demurrer, alleging that the federal court was without jurisdiction in this matter.[136] The demurrer does not specify which arguments were raised as to jurisdiction, nor has a record of the oral argument before District Judge Dyer and (Supreme Court) Justice Harlan survived.

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[131] Leidersdorf v. Flint, 15 F. Cas. 260 (C.C.E.D. Wis. 1878) (No. 8,219).

[132] *Id.*; *see also* Rosemary J. Coombe, *Marking Difference in American Commerce: Trademarks and Alterity at Century's Ends*, 10 CAN. J.L. & SOC'Y 119, 126 (1995).

[133] Affidavit of Bernhard Leidersdorf, *Leidersdorf*, 15 F. Cas. 260 (No. 8,219) (referencing Exhibits A and B) (on file with author).

[134] Affidavit of John Acker at 2, *Leidersdorf*, 15 F. Cas. 260 (No. 8,219) (on file with author).

[135] Affidavit of George Richards at 1, *Leidersdorf*, 15 F. Cas. 260 (No. 8,219) (on file with author) (arguing that the Flint trademark was made using the same typeface as the Leidersdorf trademark); Affidavit of John Marr at 1–2, *Leidersdorf*, 15 F. Cas. 260 (No. 8,219) (on file with author) (same argument).

[136] *Leidersdorf*, 15 F. Cas. at 260.

Judge Dyer's opinion—with the concurrence of Justice Harlan—speaks for itself though, at least regarding the Intellectual Property Clause of the Constitution.

The court did not concern itself with the technical question involved in *Duwell*, implicitly accepting the holding of that case and not disputing statutory standing. Rather, the court turned directly to subject matter jurisdiction under the Constitution, noting that "[t]he only clause in the constitution from which it can be well claimed congress derives its power to legislate upon the subject is [the Intellectual Property Clause]."[137] The court then noted that in order for trademarks to fall under that clause of the Constitution, "it must be necessarily assumed that the maker of a trade mark is an author or inventor, and that a trade mark is a writing or discovery within the meaning of that clause."[138] Judge Dyer then immediately stated that "[a]rgument can hardly be needed to demonstrate that a law regulating trade marks is not, in any just sense, a copyright law."[139] He explained, building around the concept of authorship core to the copyright provisions of the clause:

> The general meaning of the term copyright, is an author's exclusive right of property in the work which he produces. It includes the right of the citizen who is an author of any book or writing, any literary, dramatic or musical composition, any engraving, painting, drawing, map, chart or print, and of models or designs intended as works of art. It is something which appertains to authors who, by their writings and designs, promote the advancement of literature, science and the useful arts. An author, by standard definition is one who produces, creates or brings into being; the beginner, former or first mover of anything; hence, the efficient cause of a thing. The term is appropriately applied to one who composes or writes a book or writing, and in a more general sense to one whose occupation is to compose and write books or writings.[140]

With this fairly narrow view of authorship as its standard, the court then applied a similarly high standard for inventorship, noting that: "[s]o, too, invention implies originality. Originality, not mere mechanical dexterity, is the test of invention. . . . To entitle one to the character of an inventor, he must himself have

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[137] *Id.* at 261.

[138] *Id.*

[139] *Id.*

[140] *Id.* (internal quotation marks omitted).

conceived the idea embodied in his improvement. It must be the product of his own mind and genius."[141]

The court looked to trademarks and found that:

> The dissimilar characteristics of trade marks, and copyrights, and inventions for which patents may be granted, have been pointed out or illustrated in various adjudicated cases. A trade mark has been very well defined as one's commercial signature to his goods. It may consist of a name, symbol, figure, letter, form or device, if adopted and used by a manufacturer or merchant in order to designate the goods he manufactures or sells, to distinguish the same from those manufactured or sold by another, so that the goods may be known in the market as his, and to enable him to secure such profits as result from his reputation for skill, industry and fidelity.
>
> The basis of a trade mark right is primarily the encouragement of trade.[142]

Under this analysis, it was already clear that a trademark was not included under the Intellectual Property Clause, but the court did not stop there, noting that "[t]he name, word, mark, device, or symbol constituting a trade mark may be devoid of novelty, originality, and of anything partaking of the nature of invention."[143] Beyond that, the court observed that the right to trademarks existed at common law, whereas the right to copyrights and patents existed only in the Constitution, and the "limitation in time [for their duration] is imposed by the constitutional provision itself."[144] Furthermore, an inventor receives consideration for his registration of the patent, and in return for the protections of the patent laws, the inventor "make[s] his invention known and available to others, and ultimately . . . give[s] it to the public."[145] While that argument has some resonance in copyright law as well, it is especially true in terms of inventions, where they could simply be kept a trade secret. Closing its analysis, the court concluded that:

> A copyright is limited by time, a trade mark is not. A copyright is limited territorially, but a trade mark acknowledges no boundaries. They are unlike in their natures.

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[141] *Id.* (internal citations omitted).

[142] *Id.* (internal citations omitted).

[143] *Id.*

[144] *Id.* at 262.

[145] *Id.*

> In every aspect suggested, and in other respects which might be suggested, it would seem that the analogy between property in the use of a trade mark and a patent for an invention, and between a trade mark right and a copyright fails. Property in a trade mark exists independently of statute. It is otherwise with inventions and discoveries.[146]

With this in mind, the court came to the conclusion that "[t]he maker of a trade mark is neither an author nor an inventor, and a trade mark is neither a writing nor a discovery within the meaning and intent of the constitutional clause in question."[147] In its analysis, the court effectively conflated the two pertinent questions—whether a trademark was a copyright or patent and whether, even if not a copyright or patent, a trademark nonetheless falls within the Intellectual Property Clause, which does not limit itself by its own language to copyrights and patents. Rather, it treated them as one and the same, regarding a copyright as the conduit for authorship and a patent as the conduit for inventorship and considering a trademark a plausible subspecies of either.

The opinion then concluded, in cursory fashion, that neither the Commerce Clause nor any other grant of power to Congress authorized the Trademark Act of 1870.[148] This was unsurprising given the purely intrastate nature of the matter and the more limited view of the Commerce Clause prior to the 1930s. Likewise, the treaty power went unaddressed, and it does not seem likely that it was even argued.

As discussed above, the grant of the demurrer in this case was covered extensively in the news sources of the day and prompted a great deal of contemplation in the legal journals. The newspapers likewise chimed in, with the *New York Times* asserting that "[n]o recent judicial decision will attract more general attention in legal, and especially commercial circles."[149] The *Times* noted that the decision would at least "unsettle" the

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[146] *Id.*

[147] *Id.*

[148] *Id.* Interestingly, it is not clear that Justice Harlan agreed on this point. During the oral argument at the Supreme Court, he commented that the "'commerce' point had not therein been considered." William H. Browne, *Correspondence: Has Congress the Authority To Legislate on Trade-Marks*, 14 AM. L. REV. 156 (1880).

[149] *The Constitutionality of the Trade-Mark Law*, N.Y. TIMES, Nov. 27, 1878, at 4.

law regarding the Act's constitutionality and that the decision was given "still greater" importance because Justice Harlan concurred in the judgment.[150] The *Times* felt it likely that the next court to rule on this issue would be the Supreme Court. The next day, the *Times* printed a letter noting the "obvious astonishment and alarm of the mercantile community" at the decision but admitting that Judge Dyer's opinion was conclusive on the point of whether the trademark laws could be justified under the Intellectual Property Clause, and that even before the opinion, few felt to the contrary.[151] However, he asserted that "the real pith of the subject [was] elbowed into a corner and dismissed with such scanty consideration"—the Commerce Clause.[152] Both pieces in the *Times* also noted that common law trademark rights remain.

Leidersdorf and his counsel appealed the ruling to the Supreme Court in a filing with the circuit court in Milwaukee November 11, 1879.[153] However, the decision in the *Trade-Mark Cases* came down less than a week later—making the appeal moot—and counsel for Leidersdorf asked that the clerk of the circuit court refrain from transmitting the appeal to the Supreme Court.[154] With the argument over the federal statutes now over, Leidersdorf turned to the state courts in Wisconsin, and the matter was pending through at least 1880.[155]

C. Unreported Cases

While the above reported cases came to the fore, scores of unreported cases involving trademark law were likewise ongoing, as others accused of trademark violations in federal court came to realize they might not even need to contest the facts of their case to escape the charge. Most of these cases have faded into the woodwork of history, but some record has survived of two of

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[150] *Id.*

[151] Henry P. Wells, Letter to the Editor, *The United States Trade-Mark Law*, N.Y. TIMES, Nov. 28, 1878, at 4.

[152] *Id.*

[153] Appeal, *Leidersdorf*, 15 F.Cas. 260 (No. 8,219) (copy on file with author).

[154] Letter from Carpenter and Smith, to Edward Kurtz, Clerk of the Circuit Court (Nov. 18, 1879) (copy on file with author).

[155] Leidersdorf v. Flint, 7 N.W. 252 (Wis. 1880). This whole matter (and several other trademark issues) would later be lampooned as being a fairly ridiculous question. Irving Browne, *Monkey or Man*, 3 GREEN BAG 513 (1891).

them: the decision of the Maryland District Court in *United States v. Ryder*,[156] and the decision of the Pennsylvania District Court in *Day v. Walls*.[157]

In the *Ryder* case, the defendant was charged with violating a trademark described as a "red color" on kerosene lamp oil, which had been registered as a trademark the previous year by an individual in Philadelphia.[158] This was a question of interstate commerce, and in any case, Judge Giles denied his request for a demurrer, explaining that while he personally had doubts as to the act's constitutionality, "a lower court should never hold an act of Congress void." Besides, that trademark act had already been amended by Congress in 1876 and applied many times by lower courts and even the Supreme Court in *McLean v. Fleming*.[159] This argument for deference would not find many adherents, although it may have had it been published.

On the same page in which it reported *Leidersdorf*, the Philadelphia legal newspaper reported that Judge Cadwalader, in the district court in Philadelphia, had agreed with that case's holding in the case of *Day v. Walls*. The case involved labels for soap, for which the defendant's attorney filed a demurrer arguing that the 1876 Act was beyond the powers of Congress.[160] As was the case in *Leidersdorf*, the parties were all citizens of the same state.[161] Judge Cadwalader's specific rationale was not discussed beyond that he was in agreement with the holding in *Leidersdorf*, and the demurrer was granted.[162]

D. The Law Journals

Simultaneously, a lively debate on this subject was taking place in various law journals. While in recent years there has

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[156] United States v. Ryder, No. 4616 (D. Md. July 11, 1878) (case on file with National Archives, Southeastern Div., Morrow, GA).

[157] 7 F. Cas. 278 (E.D. Pa. 1878).

[158] *Ryder*, No. 4616 at 2.

[159] *The Federal Trade-Mark Statutes*, 19 ALB. L.J. 5, 7 (1879).

[160] *Another Adverse Trade-Mark Decision*, SCI. AM., Dec. 28, 1978, at 401. The mark in question was the word "bleacher" or "bleaching" together with a picture of scales or other symbols. *Id.* Presumably the other case referred to is *Leidersdorf*. *Id.* The demurrer also made the same argument as in *Duwell*—that the court lacked jurisdiction under the text of the statute. The demurrer in the case is on file with the author.

[161] Hugh Weightman, *Trade-Marks*, 29 AM. L. REG. 304, 305 (1881).

[162] *Walls*, 7 F. Cas. at 278.

been much hand-wringing over the lack of influence of law reviews,[163] it is difficult to underestimate their importance here. Perhaps even more significantly for modern purposes, they demonstrate that the court decisions in *Leidersdorf* and the *Trade-Mark Cases* were not isolated or hugely surprising at the time.

The debate was kicked off by the publication of a two-part article in the *Central Law Journal* by Wm. Ritchie shortly after the publication of the decision in *Duwell*, on August 23rd and 30th, 1878.[164] In the first installment of the article, Mr. Ritchie simply made the case that a trademark is neither a copyright nor a patent, while in the second, he made the case that trademarks are not covered within the text and spirit of any reasonable construction of the Intellectual Property Clause of the Constitution.[165] Far more than the decision in *Duwell* itself (which does not seem to have been widely known before these publications), these articles did much to raise controversy about whether the trademark laws were constitutional.

In response to this article, a Nashville lawyer named R. McP. Smith penned a letter to the *Central Law Journal*, asserting that he had discussed the constitutional bases of the trademark laws with the trademark department at the Patent Office in Washington. According to Mr. Smith, the trademark department felt that the trademark law was based not on the Intellectual Property Clause of the Constitution but rather on the Commerce Clause—it "disclaimed [the Intellectual Property Clause] as the basis for [the trademark act]."[166] Mr. Smith felt that the assertion that trademarks do not fit within the Intellectual Property Clause "required no argument," and the articles that would follow revealed that this sentiment was nearly universal among the legal minds of that period.[167]

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[163] *See, e.g.*, Harry T. Edwards, *The Growing Disjunction Between Legal Education and the Legal Profession*, 91 MICH. L. REV. 34, 36 (1992); Adam Liptak, *When Rendering Decisions, Judges Are Finding Law Reviews Irrelevant*, N.Y. TIMES, Mar. 19, 2007, at A8.

[164] Wm. Ritchie, *Jurisdiction of Federal Courts in Trade-Mark Cases I*, 7 CENT. L.J. 143 (1878) [hereinafter Ritchie I]; Wm. Ritchie, *Jurisdiction of Federal Courts in Trade-Mark Cases II*, 7 CENT. L.J. 163 (1878) [hereinafter Ritchie II].

[165] *See* Ritchie I, *supra* note 164, at 145; Ritchie II, *supra* note 164, at 164.

[166] R. McP. Smith, Letter to the Editor, *Jurisdiction of Federal Courts in Trade-Mark Cases*, 7 CENT. L.J. 198, 198 (1878).

[167] *Id.*

The decision in *Leidersdorf* cited the Ritchie articles and mentioned that they had been written with "evident care."[168] After the *Leidersdorf* decision, several more articles would appear in legal journals, giving the issue substantial visibility as the Supreme Court's intervention came to seem inevitable.

The leading trademark authority of the day, William Henry Browne, weighed in on the *Leidersdorf* decision in a popular newspaper—the *New York Tribune*.[169] He did not take issue with the holding that a trademark is not a copyright or patent, viewing this as self-evident to a layman.[170] Rather, he took issue with the assertion that a trademark was not commerce under the terms of the Constitution. Nonetheless, he had no issue with the assertion that a purely intrastate trademark was not covered by the Commerce Clause—instead, he felt that this was not the case in *Leidersdorf*.[171] The same argument would be made some two weeks later in the *Albany Law Journal*, where a lengthy article on the subject would agree that a trademark was not included under the Intellectual Property Clause but assert that intrastate commerce was incidental to interstate commerce, and thus the trademark laws were constitutional.[172]

Additionally, some began to argue that the power to enact the trademark law emanated not from the Commerce Clause but from the power to execute treaties. In an article in the *New York Tribune,* the anonymous author noted that "[f]riends of the law contend that the National Government may make treaties. And treaties may properly stipulate for mutual protection of trade-marks of subjects of one government within the dominion of another, and therefore, Congress may pass a general trade-mark law as incidental to enforcement of treaties."[173] Although this argument was generally not the primary argument used by proponents of the Act, it would come to prominence later, as the usefulness of the Commerce Clause in this matter would become clouded.

Thus, the prognosis was fairly grim for the argument that the power to legislate on trademarks arose from the Intellectual

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[168] Leidersdorf v. Flint, 15 F. Cas. 260, 262 (C.C.E.D. Wis. 1878) (No. 8,219).

[169] William Henry Browne, *Constitutionality of Federal Legislation as to Trade-Marks*, 7 CENT. L.J. 495 (1878) (reprinted from the *New York Tribune*).

[170] *Id.* at 496.

[171] *Id.*

[172] *The Federal Trade-Mark Statutes*, *supra* note 159.

[173] *Trade-Mark Quandry*, N.Y. TRIB., Dec. 30, 1878, at 4.

Property Clause of the Constitution. Aside from the frequently criticized *Duwell* case and the unreported *Ryder* decision, both the bench and bar were of the opinion that the key question in regard to the trademark statute's constitutionality was whether intrastate trademark use was incidental to interstate commerce or something more; the argument that a trademark was a copyright or patent was seen as a losing one. The fact that the argument that the power to enact a federal trademark law emanated from the Intellectual Property Clause was dismissed by every subsequent observer was doubtless an important factor in the government's decision not to argue this before the Supreme Court.

III. THE *TRADE-MARK CASES*

A group of prosecutions against knock-off champagne and whiskey sellers would comprise the unlikely genesis of one of the most important cases to deal with the Constitution and intellectual property in American history.

A. The Prosecutions

The *Trade-Mark Cases* originated in criminal prosecutions in both New York and Ohio for the sale of spirits with illicit trademarks, but in many ways, the similarities ended there.

1. The New York Cases

It had long been the "prevalent opinion" that a majority of the champagne with foreign labels sold in New York was actually manufactured domestically and given a counterfeit label.[174] As part of the effort to fight this, numerous prosecutions were brought against sellers of champagne in New York who were engaging in such practices.

On May 7, 1878, Emil Steffens was charged with possessing and selling counterfeit trademarks of G. H. Mumm & Co., a maker of champagne from Rheims, France.[175] On the same day, Adolph Wittemann was charged with possessing and selling counterfeit trademarks of Kunkelmann & Co, also a maker of

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[174] *A Case of Champagne*, N.Y. TIMES, Feb. 20, 1878, at 3 (describing a different prosecution).

[175] Transcript of Record at 1, Trade-Mark Cases, 100 U.S. 82 (1879) (No. 705).

champagne from Rheims, France.[176] Neither Steffens nor Wittemann were actually selling counterfeit champagne, but they were label makers whose counterfeit labels were attached to American sparkling wine.[177] The two prosecutions were intertwined and would be so regarded throughout their pendency. The defendants retained the same counsel, who plead a general demurrer in both cases on May 13, 1878, asserting simply that the indictments were "not sufficient in law."[178] The demurrer was argued before Judge Charles L. Benedict in the circuit court on May 29, 1878. [179] Thereafter, the U.S. Attorney for the district took over (the case was a private complaint at first, although there was coordination with the U.S. Attorney), and the demurrer was reargued in mid-October of that year before Judge Benedict and Judge Samuel Blatchford.[180] The judges were unable to agree so they filed a Certificate of Division of Opinion with the U.S. Supreme Court regarding the question: "Can the [1876 Trademark Act], under which this indictment is found, be upheld, wholly or in part, as a law necessary and proper for carrying into execution any of the powers vested in the Congress by the Constitution of the United States?"[181] This certificate was filed on January 8, 1879.[182]

Thus, the majority of the *Trade-Mark Cases* came to the Supreme Court. They were ideal cases for the proponents of the Act, involving foreign trademark holders protected by the 1869 Treaty with France and by their registrations with the Patent Office under that treaty. The connection with international

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[176] Transcript of Record at 1, *Trade-Mark Cases*, 100 U.S. 82 (No. 711).

[177] *The Trademark Law*, N.Y. EVENING POST, Nov. 19, 1879, at 4 [hereinafter *NY Post Trademark Article*] (calling the accused "label makers"). The *Post* is one of the few sources from that time to use the modern spelling. A small irony of this case is that both Steffens and Wittemann later became highly successful. Emil Steffens became a rich man in New York as owner of one of the largest lithographing establishments in the country. *Drugged for Evidence*, N.Y. TIMES, Sept. 8, 1895, at 14 (regarding the divorce of his son). Adolph Wittemann went on to even greater success and fame as the co-owner of the Albertype Company, which produced many postcards and view books. Finding Aid, Collection V-18: The Albertype Company, The Historical Society of Pennsylvania (2004).

[178] Transcript of Record, *supra* note 175.

[179] *Id.*

[180] Letter from Coudert Bros. to Stewart L. Woodford, U.S. Dist. Attorney (June 22, 1878) (on file with the National Archives, Northeast Division, U.S. Attorney Correspondence).

[181] Transcript of Record, *supra* note 175.

[182] *Id.*

commerce and treaty obligations of the original Act would have been difficult to dispute and were made more prominent. Had the Ohio case not been joined, the outcome may well have been completely different.

2. The Ohio Case

On August 28, 1878, arrests were made of W. W. Johnson, T. E. McNamara, and N. S. Reeder.[183] They stood accused of seven slightly varying charges of violating the trademark of Charles F. O'Donnell and his assigns for whiskey with a label reading "O.K."[184] The defendants were successors in interest to one S.N. Pike and manufacturers of spirits in Cincinnati.[185] Johnson claimed that Pike had used the mark and had continued to do so but never registered it, rather relying on common law protection.[186] On December 10, 1878, criminal charges were formally brought for violations of the 1876 Trademark Act in the Southern District of Ohio.[187] The defendants then filed a demurrer, arguing that the court was without jurisdiction to hear the case and that the claims were "insufficient in law to constitute an offense."[188] Judges John Baxter and Phillip B. Swing (the same Judge as in *Duwell*) could not reach an agreement as to whether the Act was constitutional, and thus sent the question to the U.S. Supreme Court on February 20,

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[183] *Something New in the Whiskey Trade*, CINCINNATI COM., Aug. 29, 1878, at 8.

[184] Transcript of Record, *supra* note 175, at 2.

[185] Johnson v. Schenck, 13 F. Cas. 831, 833 (C.C.D. La. 1877) (No. 7,412) (holding that W.W. Johnson and Co. held the exclusive right to Pike's trademarks).

[186] *The Law of Trademarks,* CINCINNATI GAZETTE, Nov. 20, 1879 (talk with W.W. Johnson). Johnson seems to have been rather voluble with the press, and immediately after his arrest fired off a letter to the *Cincinnati Commercial* asserting that O'Donnell was a troublemaker, pointing to his low reputation in Cincinnati and several instances where he took money and never fulfilled his end of the bargain. *Those Counterfeited Trade-Marks—Card from W.W. Johnson*, CINCINNATI COM., Aug. 30, 1878. Interestingly, "O.K." stands for "Old Kentucky." *Id.*

[187] Certificate of Div. in Opinion between the Judges of the Circuit Court of the U.S. for the S. Dist. of Ohio, *Trade-Mark Cases*, 100 U.S. 82 (1879) (No. 719).

[188] Transcript of Record, *supra* note 175, at 5. The first argument was a strange one to make because it was precisely the argument that this same court ruled against in *Duwell*. A local lawyer asserted that he had argued the constitutionality of the trademark laws in a case shortly before these, but after that case was decided on other grounds, the defendants in this case took it up. *Law of Trademarks*, *supra* note 186 (talk with L.M. Hosea).

1879, on Certificate of Division of Opinion.[189] In April 1879, the Attorney General requested that all pending trademark cases be consolidated and heard together, thus joining this case with the New York cases.[190]

In terms of the statutes in question, this case was not any different than the others. In practice though, the cases were entirely different if the copyright clause would prove insufficient, as would prove the situation at the Supreme Court. The fact that the defendants and plaintiffs were from the same state and that the commerce was primarily local would make this a hard case for advocates of the law[191] and quite akin to the facts in *Leidersdorf*. The plaintiffs in this case also made a wise choice in retaining as their counsel one of the top lawyers in Cincinnati, George Hoadly, who was already twice offered a position on the Ohio Supreme Court and became the state's governor in 1883.[192] Knowing that the Ohio prosecutions offered them a stronger case, the New York defendants declined to argue separately before the Supreme Court, forcing the Act's defenders to focus on the Ohio prosecutions in this consolidated matter. This consolidation more than anything would influence the Court's decision on the Commerce Clause.

B. The Briefs

Although the government's argument before the Court is reproduced in the published version of the *Trade-Mark Cases*, the best guide to all the arguments raised before the Court can be found in the briefs submitted by the various parties.

As has been seen, the Intellectual Property Clause of the Constitution was already roundly rejected by the legal community as a rationale for trademark legislation. The Attorney General recognized this, and although the argument was not rejected in his brief against Wittemann and Steffens, it was not argued seriously. Rather, the Justices were simply provided with the *Duwell* opinion, and no further argument was

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[189] Transcript of Record, *supra* note 175, at 5. Unsurprisingly, Judge Swing remained on the side of the Act's constitutionality. *Law of Trademarks*, *supra* note 186 (talk with W.W. Johnson).

[190] Motion to Advance, *Trade-Mark Cases*, 100 U.S. 82 (Nos. 1070, 1084).

[191] Transcript of Record at 1, *Trade-Mark Cases*, 100 U.S. 82 (No. 719).

[192] *Id.* at 5; Ohio History Central, George Hoadly, http://www.ohiohistorycentral.org/entry.php?rec=180 (last visited Aug. 30, 2009).

made on this point.[193] Rowland Cox, in his brief for G. H. Mumm against Emil Steffens, went much further and "conceded that the power to legislate upon the subject of trade-marks is not deducible from that clause of the Constitution, which provides for the granting of patents and copyrights. It must be sustained, if at all, under the commercial clause and those of a cognate nature."[194]

The brief of Coudert Brothers on behalf of the Kunkelmann & Co. against Wittemann did not even mention the Intellectual Property Clause, effectively dismissing it out of hand.[195] Rather, like the Mumm Brief, it argued for the Commerce Clause—and the treaty power.[196] It has been asserted that the treaty power was not argued before the Supreme Court,[197] but this is manifestly untrue—both the Mumm and Kunkelman briefs made this argument.

These briefs show clearly both that the argument later approved in *Missouri v. Holland* was not inconceivable in 1879 but, equally, how little precedent there was for the notion. In the Mumm Brief, counsel was forced to make the naked argument that

> Is it possible to reason that the Government of the United States is without power to make a treaty with Great Britain whereby it may protect the trade-marks of its people within British jurisdiction?

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[193] *See* Certificate of Div. in Opinion between the Judges of the Circuit Court of the U.S. for the S. Dist. of Ohio at 5, *Trade-Mark Cases*, 100 U.S. 82 (Nos. 705, 711). Indeed, the Attorney General asserted immediately thereafter that "We maintain the constitutionality of the statute upon . . . the commerce clause of the Constitution." *Id.* The direct implication is that this is the only argument the government put its faith in.

[194] Argument on Behalf of the U.S. at 3, *Trade-Mark Cases*, 100 U.S. 82 (No. 705) [hereinafter Mumm Brief]. Cox was the attorney for G.H. Mumm and Co., representing them from the original criminal action. He was already an authority on trademark law and would be one of the key advocates in the coming debate leading to the 1881 Act. *See, e.g.*, *History of the Bench and Bar of the Greater New York, Rowland Cox*, 5 AM. LAW. 345, 353 (1897). Interestingly, Rowland Cox was the grandfather of Archibald Cox, Jr., of Watergate fame. KEN GORMLEY, ARCHIBALD COX: CONSCIENCE OF A NATION 4 (1997).

[195] *See* Brief on the Part of Kunkelmann & Co. at 11–13, *Trade-Mark Cases*, 100 U.S. 82 (No. 711).

[196] *See id.*

[197] *See, e.g.*, Cross, *supra* note 1, at 375.

> If the Government of the United States has that power, it has the power *to afford reciprocal protection by legislation*. It has the power to provide for the registration of foreign trademarks. I do not attempt to locate the power. *If the United States are a nation, it exists*.[198]

This argument was essentially rhetoric, and no support was given in favor of it. The Kunkelman Brief treated the issue more extensively and more in line with the modern scholarly arguments in favor of a robust treaty power, looking back to the writings of the Founding Fathers.[199] Nonetheless, it too could not find any case law in favor of its proposition, rather relying on a fairly similar appeal to logic:

> [I]f the Statute of 1876 carries out and puts into operation and effect the treaty with France, the power to enact such a law, as the one more immediately under consideration, is clear, unless the treaty be a dead letter, and the obligations incurred by the United States be without any binding force or effect.[200]

Interestingly, a paragraph asserting that the commerce power was sufficient to enact these statutes in relation to the discussion of the treaty power was crossed out of the Kunkelman Brief, indicating that it meant to argue for an independent treaty power, not one powered by the Commerce Clause.[201]

The briefs for the Attorney General, Mumm, and Kunkelman against Wittemann and Steffens all made a similar argument at their core—that the Commerce Clause permits regulation of not only interstate commerce, but also of the instrumentalities therof.[202] The Attorney General and Mumm briefs further asserted that if intrastate activity was incidental to interstate commerce, the regulation could still be upheld.[203]

For all parties, it was necessary to prove that use of a trademark fell under the rubric of "commerce" in the Constitution. The case turned to by the prosecution's briefs to

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[198] Mumm Brief, *supra* note 194, at 12–13 (italics in the original).

[199] *See* Brief on the Part of Kunkelmann & Co., *supra* note 195, at 11–12.

[200] *Id.* at 12.

[201] *See id.* at 25–26.

[202] *See* Brief on the Part of Kunkelmann & Co., *supra* note 195, at 26 (quoting Welton v. Missouri, 91 U.S. 275, 279–80 (1875)); Certificate of Div. in Opinion between the Judges of the Circuit Court of the U.S. for the S. Dist. of Ohio, *supra* note 193, at 6–7; Mumm Brief, *supra* note 194, at 21–22.

[203] *See* Mumm Brief, *supra* note 194, at 21–22; Certificate of Div. in Opinion between the Judges of the Circuit Court of the U.S. for the S. Dist. of Ohio, *supra* note 193, at 15 (quoting Wheeling Bridge Case, 59 U.S. (18 How.) 421, 433 (1856)).

argue this point was the Supreme Court's fairly recent decision in *Welton v. Missouri*.[204] In that case, a peddler was accused of selling goods without a license, as was required by Missouri statute.[205] Justice Field's opinion provided an expansive vision of the commerce power that the proponents of the law hung their hat on:

> Commerce is a term of the largest import. It comprehends intercourse for the purposes of trade in any and all its forms, including the transportation, purchase, sale, and exchange of commodities between the citizens of our country and the citizens or subjects of other countries, and between the citizens of different States. The power to regulate it embraces all the instruments by which such commerce may be conducted. So far as some of these instruments are concerned, and some subjects which are local in their operation, it has been held that the States may provide regulations until Congress acts with reference to them; but where the subject to which the power applies is national in its character, or of such a nature as to admit of uniformity of regulation, the power is exclusive of all State authority.
>
> It will not be denied that that portion of commerce with foreign countries and between the States which consists in the transportation and exchange of commodities is of national importance, and admits and requires uniformity of regulation.[206]

The argument of the proponents of the law went steadily along these lines, specifically, that trademarks were "instruments by which . . . commerce may be conducted."[207]

The Attorney General was the only one forced to argue that purely intrastate commerce incidental to interstate commerce nonetheless fell within the scope of the federal commerce power, although the Mumm and Kunkelman briefs gamely helped as well. The case turned to for this matter was the landmark case of *Gibbons v. Ogden*,[208] and its assertion that "[t]he power of Congress, then, comprehends navigation, within the limits of every State in the Union; so far as that navigation may be, in any manner, connected with commerce with foreign nations, or

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[204] 91 U.S. 275 (1875).
[205] *Id.* at 275.
[206] *Id.* at 280.
[207] *Id.*
[208] 22 U.S. (9 Wheat.) 1, 197 (1824).

among the several States, or with the Indian tribes."[209] This line of thinking was continued in the *Wheeling Bridge Case*,[210] in which the Court noted that "[i]t will not do to say that the exercise of an admitted power of congress conferred by the constitution is to be withheld, if it appears, or can be shown, that the effect and operation of the law may incidentally extend beyond the limitation of the power."[211] The proponents of the law put forth a direct analogy that purely intrastate trademark use was merely incidental to interstate and international trademark use.

However, the Kunkelman and Mumm Briefs were ambivalent about this argument regarding purely intrastate commerce. Both recognized that the facts of their cases were stronger than those of the Ohio case, and thus made vigorous arguments that the statute need not be found unconstitutional in whole even if it was found unconstitutional with respect to parties from the same state.[212] The Kunkelman Brief was substantially more detailed in its argument and citations, but neither cited a case in which a federal statute had been found unconstitutional under the positive meaning of the Commerce Clause and been divided to apply only to interstate commerce.

Although one source asserts that Wittemann and Steffens filed briefs with the Court, these do not survive.[213] As such, the only direct evidence of the arguments made against the law is the brief of George Hoadly on behalf of the Ohio defendants.

Regarding the Copyright Clause, the core of the defendants' argument was to ask, "[h]ow can a trade-mark be said to promote the progress of science and the useful arts,"[214] and to answer:

> This is the controlling purpose for which the power was granted. If an invention do not subserve this end, but is frivolous and useless, or not novel, it is equally valueless in law.
>
> The clause, read distributively, as it should be, grants power, but only within this stated purpose, to secure the exclusive right

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[209] *Id.* at 75.

[210] 59 U.S. (18 How.) 421 (1855).

[211] *Id.* at 433–34.

[212] Brief on the Part of Kunkelmann & Co., *supra* note 195, at 27–29; Mumm Brief, *supra* note 194, at 14.

[213] Browne, *supra* note 148, at 157 (asserting that counsel for Steffens and Wittemann filed briefs but did not make oral argument).

[214] Argument for Defendants at 9, *Trade-Mark Cases*, 100 U.S. 82 (1879) (No. 719) (internal quotation marks omitted).

> for limited terms to authors for their writings, and inventors for their discoveries.
>
> But the purpose, thus stated, enables us easily to perceive, that if the power of Congress, to legislate upon the subject of trade-marks, is to be established, it must be by reference to some other clause of the Constitution. A trade-mark, like a bill of exchange or policy of insurance, may be valuable as a tool, an implement of commerce, an adjunct of commercial transactions. It affects the *use* of nothing; it merely facilitates the *sale* of something. And the foundation of title to a trade-mark is priority of adoption and actual use in trade.
>
> Except in case of loan or sale, a trade-mark has no function. It is only in a case of commerce, where minds meet *(cum)* for the disposal of merchandise *(merx)* that the trade-mark has any part to play in the world. Among savages and nations without commerce, the trade-mark is unknown; it began with commerce, and exists only for its assistance, whereas, discoveries were made in the rudest ages, and are the successive steps by which civilization ascends.[215]

This argument would prevail at the Supreme Court and echo the opinions of others at the time. As noted, this argument went largely unopposed.

The brief for the Ohio Defendants then discussed the Commerce Clause, prefaced by a jocular introduction asserting that there was nothing in the record indicating use of the trademark outside of Ohio.[216] Following that, Hoadly noted that

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[215] *Id.* at 9–10 (citations omitted) (internal quotations marks omitted).

[216] *Id.* at 11. The introduction continues:

> We have the right, for aught that appears, to hold our high opinion of our clients and their goods, and to believe that in the general rush for the very superior article they manufacture and sell under this trade-mark, no Kentuckian, deserting his inferior home-made drink, will ever be in season to buy any, or if he do, to conclude that the temptation for immediate consumption will be too strong for resistance, and that he will drink it before reaching the bridge or ferry. Doubtless, in this generation, all good things originate in Ohio, as in the reign of James the First all deserving persons came from Scotland, but then they required exportation, whereas the highly cultivated and thirsty people of Ohio furnish a sufficient home market, at least for whisky, and are even open to the suspicion of assuaging their thirst with imported liquor also. And however desirable it may be that liquor of our client's manufacture should be substituted for the vile article which has decimated the Indian tribes, the record furnishes no suggestion that any "O.K." or "Seal and Ribbon" whisky has ever reached, or is likely to reach, the parched throat of the red man. Ohio, we may believe, has not yet more than enough for the uses of her own sons and daughters.

Id. at 12.

Gibbons was clear about purely intrastate commerce; it only permitted regulation with a connection to interstate commerce.[217] The brief then noted the previous holding in *United States v. DeWitt*,[218] which had found unconstitutional a federal statute setting standards for the sale of lamp oil without requiring that it be in interstate commerce,[219] and it cited additional cases that discuss the limitations of the commerce power.[220] The brief then noted that some counts of the information did not even contemplate trade but simply charged the Ohio defendants with counterfeiting without any commercial actions, and that such obviously could not fall within the Commerce Clause.[221] Finally, the brief noted that the Act of 1876 was unconstitutional as applied since it was being applied without any evidence of interstate trade.[222]

This is the only direct evidence of the argument for the defendants, but the brief is surprisingly limited. Nowhere is it argued that a trademark is not used in commerce for purposes of the Commerce Clause, but only that the commerce must be interstate. In addition, there was no opposition to the Treaty Clause argument. The Supreme Court's opinion limited itself to the same issues as the Hoadly Brief.

C. *The Argument*

The cases were argued on October 22, 1879,[223] pursuant to a motion to advance the hearing filed by the Attorney General the previous March.[224] The motion was granted March 31, 1879, with

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[217] *Id.* at 13 (quoting Gibbons v. Ogden, 22 U.S. (9 Wheat.) 1, 194–95 (1824)).

[218] 76 U.S. (9 Wall.) 41 (1869).

[219] *See id.* at 44–45.

[220] *Id.* at 45 & n.4.

[221] Argument for Defendants, *supra* note 214, at 20–22 (internal quotations marks omitted).

[222] *Id.* at 22–23.

[223] *Forged Trade-Marks*, WASH. POST, Oct. 23, 1879, at 4.

[224] Motion to Advance, *supra* note 190. The motion itself requests a hearing on April 21, 1879, but this was not to be. The motion mentions the interest of the Secretary of State, but this came at the request of the French Minister. The French Ministry took quite an interest in the case, as its domestic industries were affected both by the specific suits and more general question raised, and as such, asked the Supreme Court for a copy of the decision as soon as it was issued. Letter from Sec. of State on behalf of French Minister to D.W. Middleton, Clerk of the Supreme Court (Nov. 22, 1879) (on file with author). The U.S. Patent Office made a similar request. Letter from Comm'r of Patents to McKinney Requesting the Decision (Nov. 17, 1879) (on file with author).

the hearing to be on the second day of the October Term of 1879. Counsel for Wittemann and Steffens chose not to make oral argument,[225] and no transcript exists of George Hoadly's argument on behalf of the Ohio defendants. However, William Henry Browne did record a few tidbits from the argument, including that in response to a question from the Court, Hoadly expressly admitted that Congress had the power to regulate trademarks under the Commerce Clause—it was simply a question of how much it could encompass.[226]

In contrast, the reporter for this case included the Attorney General's argument along with the published opinion. The Attorney General's argument was the first to note that the Act had previously been commented on by the Court in *McLean v. Fleming*[227] and that the Court had thus implicitly given the Act its imprimatur.[228] His argument then turned briefly to the argument under the Intellectual Property Clause, saying that it "demands careful consideration. Undoubtedly, in the legislative mind they were kindred subjects, and it was thought that the power of Congress over them might be derived from the same source."[229] Rather than giving this argument a full exposition, however, he chose "not [to] dwell upon this view of the question."[230] While this was likely a sensible decision given the general consensus on the merits of the argument under the Intellectual Property Clause, it was nonetheless fateful in that it left the forceful arguments of *Leidersdorf* and the Hoadly Brief as the only significant arguments regarding the Intellectual Property Clause—pro or con. The result that the Court wholeheartedly adopted these arguments is thus unsurprising.

The Attorney General then turned to the Commerce Clause, generally following the contours of his brief that trademarks were instruments of commerce.[231] It is significant that the Attorney General felt the need to note that the law's "constitutionality in its application to the trade-marks of the *subjects of foreign countries* is the question presented by the

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[225] Browne, *supra* note 148, at 157.
[226] *Id.*
[227] 96 U.S. 245 (1877).
[228] *Trade-Mark Cases*, 100 U.S. 85 (1879).
[229] *Id.* at 86.
[230] *Id.*
[231] *Id.* at 86–87.

indictments."[232] While this was not accurate with regard to the Ohio defendants, it was a direct effort to remind the Justices that the case was not *just* about the Ohio defendants; the majority of the cases involved the infringement of marks that were used in international commerce.

The Attorney General's argument then turned to an argument under the embryonic treaty power, couching it at times in terms of a regulation of international commerce.[233] The Attorney General did not, however, specifically argue that the treaty power went beyond the constraints of the Commerce Clause. His argument then shifted back to the Commerce Clause, once again following his brief's argument that incidental regulation of purely intrastate commerce was permissible.[234] His argument closed with a brief assertion that even if the Act was unconstitutional regardng purely intrastate commerce, it could still be saved regarding interstate and international commerce.[235]

D. The Decision

The Supreme Court's unanimous decision in the *Trade-Mark Cases* was announced November 17, 1879, less than a month after the argument.[236] The Court opened with a short discussion of the procedural history of the cases and of trademark law in general[237] and then addressed the Intellectual Property Clause head-on. The Court noted that "[i]t may also be safely assumed that until a critical examination of the subject in the courts became necessary, it was mainly if not wholly to [the intellectual property] clause that the advocates of the [trademark] law looked for its support."[238] No doubt, the hearts of the advocates of the law began to sink when they read the Court assert that "the effort [to defend the law on these grounds] is surrounded with insurmountable difficulties."[239] What followed was perhaps the

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[232] *Id.* at 88.

[233] *Id.* ("The purpose and the natural and reasonable effect of the acts are to . . . carry out in good faith and enforce our treaty stipulations on the subject. The act is a regulation of foreign commerce.").

[234] *Id.* at 89–91.

[235] *Id.* at 91.

[236] *See infra* Part III.E.

[237] *See Trade-Mark Cases*, 100 U.S. at 92.

[238] *Id.* at 93. As has been noted, this was not accurate according to some prior accounts. *See* Smith, *supra* note 166, at 198–99.

[239] *Trade-Mark Cases*, 100 U.S. at 93–94.

Court's most substantive commentary on the scope of the Intellectual Property Clause in the nineteenth century and possibly its most influential ever:

> The ordinary trade-mark has no necessary relation to invention or discovery. The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident rather than design, and when under the act of Congress it is sought to establish it by registration, neither originality, invention, discovery, science, nor art is in any way essential to the right conferred by that act. If we should endeavor to classify it under the head of writings of authors, the objections are equally strong. In this, as in regard to inventions, originality is required. And while the word *writings* may be liberally construed, as it has been, to include original designs for engravings, prints &c., it is only such as are *original*, and are founded in the creative powers of the mind. The writings which are to be protected are *the fruits of intellectual labor*, embodied in the form of books, prints, engravings, and the like. The trade-mark may be, and generally is, the adoption of something already in existence as the distinctive symbol of the party using it. At common law the exclusive right to it grows out of its *use*, and not its mere adoption. By the act of Congress this exclusive right attaches upon registration. But in neither case does it depend upon novelty, invention, discovery, or any work of the brain. It requires no fancy or imagination, no genius, no laborious thought. It is simply founded on priority of appropriation. We look in vain in the statute for any other qualification or condition. If the symbol, however plain, simple, old, or well-known, has been first appropriated by the claimant as his distinctive trade-mark, he may by registration secure the right to its exclusive use. While such legislation may be a judicious aid to the common law on the subject of trade-marks, and may be within the competency of legislatures whose general powers embrace that class of subjects, we are unable to see any such power in the constitutional provision concerning authors and inventors, and their writings and discoveries.[240]

The thrust of this holding is simple yet powerful; the Constitution's Intellectual Property Clause specifically imposes a requirement that a copyright be a fruit "of intellectual labor,

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[240] *Id.* at 94. (Emphasis added).

embodied in the form of books, prints, engravings, and the like," which is "original" and "founded in the creative powers of the mind."[241] A patent need only fill the lower threshold of "originality," but it must also be an "invention," a significantly more restrictive term than "writing." The argument can be made that this holding was not the necessary holding based on a sensible reading of the Intellectual Property Clause, and this is correct. This reading, however was hardly novel and, as has been demonstrated, represented the dominant strain of thought regarding the Intellectual Property Clause at the time.

The Court then turned to the Commerce Clause as an issue and was faced with a more problematic question.[242] Not only was there strong authority on both sides, but the merits of this argument were starkly different among the different defendants in the consolidated matter. The Court attempted to deal with this in exactly the manner the defendants had hoped they would—it found a resolution, which would apply to all defendants equally, relying on a technicality rather than facing the issue head-on.[243]

In dicta, however, the Court indicated that it was not at all clear that trademarks were valid instruments of commerce within the meaning of *Welton*.[244] The Court noted that "[e]very species of property which is the subject of commerce, or which is used or even essential in commerce, is not brought by this clause within the control of Congress," and proceeded to cite several examples of its decisions regarding this matter that were analogous to trademarks, including bottles, an insurance policy, and a stamp duty, which were held to not be instruments of commerce.[245] The counterexample of the case of *Almy v.*

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[241] *Id.* (emphasis omitted).

[242] *Id.* at 95–96.

[243] *Id.* at 97–98.

[244] *Id.* at 95.

[245] *Id.* Interestingly, the Court's sources for these examples were dubious—the cases cited do not stand for the stated propositions regarding the Commerce Clause. *Nathan v. Louisiana*, 49 U.S. (8 How.) 73 (1850), was cited for the proposition that "barrels and casks, the bottles and boxes in which alone certain articles of commerce are kept for safety and by which their contents are transferred from the seller to the buyer, do not thereby become subjects of congressional legislation more than other property." *Trade-Mark Cases*, 100 U.S. at 95. In fact, that case stands for the proposition that a state may legitimately tax a foreign bill of exchange even though it is an instrument of commerce and is specific to the taxing power. *Nathan*, 49 U.S. (8 How.) at 74. *Paul v. Virginia*, 75 U.S. (8 Wall.) 168 (1868), simply asserts that an

California[246] was also noted by the Court, where a stamp duty had been held to be unconstitutional.[247]

The Court did not actually make such a move, however. Rather, the Court held, without citing authority for the proposition, that a statute premised on the Commerce Clause *must* limit itself, by its own terms, to interstate commerce.[248] This holding continues to echo nowadays,[249] but it is not clear what the basis for this ruling is; it does not seem to have been argued or even mentioned by any of the parties. What is clear is that the ruling neatly addressed the central problem of the Court regarding the Commerce Clause—the differences between the parties.[250] By looking solely at the statute on its face, the Court was able to avoid discussing whether its ruling would only apply to certain parties or all of them, and avoid a precedent that would say that Congress could regulate intrastate commerce or could not regulate international commerce.

Finally, the Court turned to the question of whether the statute could only be found partially unconstitutional and held that it could not for two reasons. The first reason given was that there was no evidence that the trademarks in question were used in interstate or foreign commerce.[251] This assertion is somewhat perverse in light of the fact that the Kunkelman and Mumm trademarks at issue in the New York prosecutions were specifically described as being French in origin, and as such, the simplest explanation is that the Court was focusing on the Ohio

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insurance policy is merely a contract and not an instrument of commerce, an argument which does not seem terribly relevant here—no one could argue that a trademark is a contract. *Id.* at 183, *superseded by statute*, 15 U.S.C. §§ 1011–12 (2006), *as recognized in* City of Charleston v. Gov't Employees Ins. Co., 869 F. Supp. 378 (D.S.C. 1994).

[246] 65 U.S. (24 How.) 169 (1860).

[247] *Trade-Mark Cases*, 100 U.S. at 95; *Almy*, 65 U.S. (24 How.) at 173.

[248] *Trade-Mark Cases*, 100 U.S. at 96.

> When, therefore, Congress undertakes to enact a law, which can only be valid as a regulation of commerce, it is reasonable to expect to find on the face of the law, or from its essential nature, that it is a regulation of commerce with foreign nations, or among the several States, or with the Indian tribes. If not so limited, it is in excess of the power of Congress.

Id.

[249] *See infra* Part V.

[250] *See Trade-Mark Cases*, 100 U.S. at 95–98.

[251] *Id.* at 98 ("First, the indictments in these cases do not show that the trade-marks which are wrongfully used were trade-marks used in that kind of commerce.").

defendants. The second argument was that the Court cannot read words into a law to limit it and make it constitutional; it can only excise them.[252] Since limiting the statute to commerce would add words to the statute, it was beyond the Court's power.

The Court briefly noted that it "wish[ed] to be understood as leaving untouched the whole question of the treaty-making power over trade-marks, and of the duty of Congress to pass any laws necessary to carry treaties into effect."[253] The Court concluded by stating that since the Registration Act of 1870 was unconstitutional, the 1876 criminal act that the cases were brought under was likewise unconstitutional.[254]

The decision was certified to the lower courts, and America entered a new era of trademark law.

E. The Reaction

While the result in the *Trade-Mark Cases* could have been anticipated by contemporary attorneys, the decision still took the public at large as a surprise. It even accomplished the rare feat of giving trademark law more than token coverage in the newspapers.

Initial reports of the decision hit the newspapers the day after the case was decided on November 18, 1879.[255] These articles consisted chiefly of summaries of the decision and speculation as to its effects, noting that there had already been some 8,000 trademark registrations, and 200 more were pending before the Patent Office.[256] The law also brought some $10,000

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[252] *Id.* at 98–99. Although it is not cited, this follows the doctrine was set forth by the Court three years previously. United States v. Reese, 92 U.S. 214, 221 (U.S. 1876).

[253] *Trade-Mark Cases*, 100 U.S. at 99.

[254] *Id.*

[255] *See, e.g.*, *An Unconstitutional Law*, WASH. POST, Nov. 18, 1879, at 1; *Supreme Court*, CHIC. TRIB., Nov. 18, 1879, at 6; *The Trade-Mark Laws Invalid*, N.Y. TIMES, Nov. 18, 1879, at 1; *The Validity of Trade Marks*, ATLANTA DAILY CONST., Nov. 18, 1879, at 1.

[256] *The Trade-Mark Law Swept Away*, N.Y. TIMES, Nov. 19, 1879, at 4. This number was later clarified; there had been 7,777 registrations from the law's enactment to November 11, 1879. Untitled Editorial, N.Y. TIMES, Nov. 21, 1879, at 4. There had been 2,150 trademarks registered from 1870 to the beginning of 1875; 1,138 in 1875; 959 in 1876; 1,216 in 1877; 1,577 in 1878; and 859 thus far in 1879. *Id.* This amounted to nearly $200,000 in fees paid to the government in return for a thirty-year registration. *Id.* By the end of 1879, there had been another fifteen registrations, making the total amount 7,792, for a total of $211,960.00 in fees. Letter from H.E. Paine, Comm'r of Patents, to Rep. Armfield (Jan. 9, 1880) (on file at

in revenue to the Patent Office annually.[257] In response to the decision, the Patent Office released a circular on November 22, announcing that all registrations would be suspended pending further action from the applicants.[258] Further registrations would only be permitted if the person had full knowledge and understanding of the Supreme Court's decision.[259] However, fees could not be refunded absent a specific act from Congress to that effect.[260] Apparently, many trademark holders had immediately written to the Patent Office asking for their fees to be refunded, and one went even further and sued the federal government for breach of contract and requested that the registration fee be returned.[261] The Court of Claims denied the request, holding that "[i]t was for him to determine, before paying the fee, whether it was under the statute worth $25 to him to have his trade-mark registered," taking into account the risk that the registration statute could be unconstitutional.[262] Of course, this rationale did not mollify those who had paid the registration fee. The Comissioner of Patents, himself, was fairly distressed regarding the decision, feeling that "many business interests would suffer" due to this decision.[263]

Those in favor of a limited federal government were greatly pleased by the descision. For example, the *New York Post* published an editorial when word of the decision came down praising the Court for its limitation on congressional power and hoping that "we shall hear less henceforth about Congressional regulation of railroad and insurance companies and the like."[264]

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the National Archives). Another forty were registered in the first two months of 1880. *See Bowen Letter*, *supra* note 66.

[257] *The Trademark Decision*, ATLANTA DAILY CONST., Nov. 22, 1879, at 1 [hereinafter *Atlanta Daily Const. Trademark Article*].

[258] *Registration of Trade-Marks*, N.Y. TIMES, Nov. 23, 1879, at 12.

[259] *Id.*

[260] *Id.* This was, in part, because the contingent fund of the patent office was not large enough to meet the demand for refunded fees. *See Atlanta Daily Const. Trademark Article*, *supra* note 257.

[261] *See* Woodman v. United States (Woodman's Case), 15 Ct. Cl. 541, 541 (1879).

[262] *Id.* at 545.

[263] *Trade Marks*, CINCINNATI COM., Nov. 19, 1879.

[264] *Conservative Views of the Constitution*, N.Y. EVENING POST, Nov. 19, 1879, at 2.

The newspapers also reported that this decision would be a "surprise to many lawyers, as well as a disappointment to the mercantile community."[265] While it may have been unnerving, disappointment soon abated as many began to openly assert that for domestic trademarks, common law rights were sufficient. For instance, the *New York Tribune* published "A Talk with a Patent Lawyer," in which it was noted that the property right in trademarks remained, the only difference was the right to sue in federal court.[266] Large corporations like Procter & Gamble were likewise nonplussed, concerned mostly about getting back their registration fees.[267] At a meeting of the United States Trademark Association ("USTA") on the afternoon of November 24, Orestes Cleveland, the group's president, asserted that the effects of the decision were not dramatic; the main value of the law had been the existence of a registry for trademarks that was useful for proving priority in court.[268] After further discussion among the members of the USTA, it was agreed that new legislation was needed, if solely to provide for the registration of foreign trademarks.[269] While there is little mention in the news of excessive worry on the part of domestic merchants, proprietors of foreign marks were concerned—French merchants in New York had already written their ambassador in Washington, asking that he push to enact a new law to enforce the 1869 treaty.[270] The gears of government were already grinding in this direction.

IV. IN THE SHADOW OF THE *TRADE-MARK CASES*

At a cabinet meeting on November 18, 1879, it was decided to recommend to Congress that an act to protect foreign trademarks be passed.[271] Domestic trademarks were

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[265] *The Trade-Mark Law Swept Away*, *supra* note 256.

[266] *No Cause for Alarm—A Talk with a Patent Lawyer*, N.Y. TRIB., Nov. 22, 1879, at 8. The *Post* published a similar article but the interviewee asserted that the effects of the decision would be more negative, as the 1870 Act had a positive effect on the level of trademark piracy. *NY Post Trademark Article*, *supra* note 177.

[267] *Law of Trademarks*, *supra* note 186 (talk with Procter & Gamble).

[268] *The Trade-Mark Decision*, N.Y. TIMES, Nov. 25, 1879, at 8.

[269] *Id.* This was necessary since other countries such as France would only recognize American marks in their courts if American courts offered French trademark owners recourse.

[270] *Trade-Marks, A Discussion in This City*, N.Y. TRIB., Nov. 25, 1879, at 2.

[271] *See A Replevin Imbroglio, The Trade-Mark Matter in Cabinet*, THE WASH. POST, Nov. 19, 1879, at 2; *From Washington, Meeting of the Cabinet*, THE BOSTON

conspicuously absent from this recommendation, but nonetheless legislative proposals would include an act purely for foreign trademarks—an act based on the Commerce Clause to protect interstate trademarks as well—or a constitutional amendment that would allow for the revival of the old Act, which protected even intrastate trademarks.

A. The Immediate Legislative Response

Only two weeks had passed before Congress made its first response to the Supreme Court's decision, in the form of a proposed constitutional amendment from Rep. Moses A. McCoid of Iowa on December 2, 1879.[272] The amendment specified that "Congress, for promotion of trade and manufactures, and to carry into effect international treaties, shall have the power to grant, protect, and regulate the exclusive right to adopt and use trademarks."[273] Standard practice was for a proposed constitutional amendment to be sent to the Judiciary Committee, but this proposed amendment was committed to the Committee on Manufactures (which Rep. McCoid sat on) instead, which took up the matter in a subcommittee (which Rep. McCoid also sat on).[274] William Henry Browne was invited to discuss the proposed measure at a committee hearing. He stated that the language of the amendment was not optimal and proposed alternative phraseology, but his recommendations were not adopted.[275] At the meeting on December 8, the clerk was directed to furnish copies of the decision to other members of the Committee,[276] and the bill was reported without amendment three days later, on December 11.[277] This was an extraordinarily fast turnaround time, especially considering that most of the Committee had not even read the decision until the 8th, which suggests that Rep.

GLOBE, Nov. 19, 1879, at 1. The matter was apparently discussed again by the cabinet a week later. *See Trade-Marks: The Recent Decision*, N.Y. TRIB., Nov. 25, 1879, at 2.

[272] H.R.J. Res. 125, 46th Cong. (2d Sess. 1879).

[273] *Id.* § I. The remainder was boilerplate for a proposed amendment.

[274] The other members of the subcommittee were Reps. Hall and Beale. *At the National Capital, In the Committee Rooms*, N.Y. TRIB., Dec. 12, 1879, at 1.

[275] *See* Browne, *supra* note 148, at 159. He later observed that "we may deduce a lesson of warning from what might have resulted in great perplexity [owing to the awkward language of the proposed amendment], in thus playing with the edge-tools of hasty legislation." *Id.*

[276] *More Money Recommendations in Congress*, WASH. POST, Dec. 9, 1879, at 1.

[277] 10 CONG. REC. 78 (1879).

McCoid was essentially operating on his own with the Committee rubber-stamping it. Unsurprisingly, the report was submitted by Rep. McCoid for the committee and it laid out the reasons for the proposed amendment of "great and immediate importance."[278] The report went through the number of trademarks registered, the fees received for their legislation, the various trademark treaties which had been concluded, and other background material on the issue.[279] The report then turned to the two questions the Committee felt it had to answer: whether this issue warranted a constitutional amendment and whether the existing state common law would be sufficient. It determined that federal control under a constitutional amendment was necessary. The argument made was that trademarks were increasingly important in the world,[280] that national control was particularly necessary because of the natural constraints of state control,[281] and because national control was required to carry out the provisions of treaties.[282] Perhaps overly optimistically, the report then urged that the measure be passed (and submitted to the states) before the upcoming adjournment for the holidays in a scant few weeks.[283] The entire House was less receptive to Rep. McCoid than the Committee on Manufacturess, however, as other forces were in motion.[284]

On December 9, 1879, Rep. Robert F. Armfield, a lawyer from North Carolina, introduced his own proposal to remedy the damage done by the Supreme Court in the form of a standard bill.[285] This bill created a registry in Washington for marks used in commerce with foreign nations, Indian tribes, or between states[286] and allowed for both damages and equitable remedies against infringers of trademarks.[287] The Register of Trademarks

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[278] *Id.*

[279] *Id.* This report gave an updated tally on fees received as of December 9, 1879, at $211,750. *Id.*

[280] *Id.*

[281] *Id.*

[282] *Id.*

[283] *Id.*

[284] Press reaction to the amendment was generally negative. For instance, one paper ran an editorial lambasting the amendment as a flippant move to modify the design of the Constitution regarding federalism. *See Tinkering the Constitution*, HARTFORD COURANT, Dec. 11, 1879, at 2.

[285] H.R. 2573, 46th Cong. (2d Sess. 1879).

[286] *Id.* § 2.

[287] *Id.* § 8.

would be empowered to decide among claimants regarding who held the valid mark, with the decision reviewable to the en banc Supreme Court for the District of Columbia.[288] The bill was then committed to the Committee on Commerce.[289] The bill grew substantially after its first introduction, going through thirteen to twenty-seven sections, and incorporating a modified version of the 1876 criminal trademark legislation.[290]

Although the House of Representatives heard the report on the proposed amendment on December 11, 1879, it was not discussed further that day.[291] The report was once again read on December 17, 1879, [292] and discussion followed.[293] The initial reaction was of surprise that a constitutional amendment was being offered that had not been vetted by the Committee on the Judiciary.[294] A motion to recommit the amendment to the said committee was made, but it did not immediately pass, and Rep. McCoid was adamantly against such an action.[295] He explained that the subcommittee and full Committee on Manufactures had given the measure serious consideration, and furthermore, that legislatures in twenty-one states would be meeting the coming winter and then not again for two more years, giving the amending process additional urgency.[296] Finally, he noted the importance of international trademark treaties and how the amendment was needed to effectuate them.[297]

Rep. Armfield then stood up and argued that a constitutional amendment was not needed to regulate trademarks since they were covered by the Commerce Clause and noted that his bill accomplished this very purpose.[298] To this, Rep. McCoid asked whether the Supreme Court's decision had precluded regulation under the Commerce Clause, to which Rep. Armfield answered in

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[288] *Id.* § 4. This is the modern-day Court of Appeals for the D.C. Circuit.

[289] 10 CONG. REC. 38 (1879).

[290] *See* Memorandum to H.R. 2573, § 19 (1879) (on file with author).

[291] *See* 10 CONG. REC. 78.

[292] *Id.* at 145.

[293] *Id.* at 146–48.

[294] *See id.* at 146.

[295] *See id.* at 146–47. Apparently the measure faced strong opposition from the Democratic side of the aisle. *The Trade-Mark Article Considered*, N.Y. TRIB., Dec. 18, 1880, at 2.

[296] *See* 10 CONG. REC. 147.

[297] *See id.*

[298] *Id.*

the negative.[299] At this point, Mr. Cox joined in and argued that both measures should be sent to the Committee on the Judiciary to determine which course was most prudent. He recalled that the 1870 Act "passed without much discussion" and felt that this matter deserved greater scrutiny.[300] He also felt that the extent of the treaty power regarding trademarks needed to be examined.[301] To this, Rep. Horr from the Committee on Manufactures, half-jokingly, asked to keep the bill in the Committee on Manufactures since the Committee had nothing else to do and, resultantly, had lavished much attention on the bill.[302]

Rep. McCoid then made the argument in response to Rep. Armfield that, in fact, a trademark was not an article of commerce,[303] but the battle to pass the amendment quickly was over; it was "very manifest" that the amendment could not get the requisite two-thirds majority necessary for a constitutional amendment.[304] Both the amendment and the Armfield Bill were recommitted to the Committee on the Judiciary.[305]

B. The Treaty Power Ascendant

A few days prior to the debates in Congress, the *New York Tribune* ran an editorial inquiring into the extent to which Congress could legislate based solely on the empowerment of a treaty.[306] It noted that a national law was required to effectuate the treaties America had entered into but felt that "it will be a new discovery in constitutional law that the President and Senate can, by making a treaty, enlarge the power of Congress to legislate affecting internal affairs."[307] This prospect was considered risible, and "any legislation which rests on treaties

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[299] *Id.* As noted supra, this is a debatable point. The Court did not hold this but implied it. *See supra* text accompanying note 251.

[300] 10 CONG. REC. 147.

[301] *Id.* at 147–48.

[302] *Id.* at 148 ("When I came here, I had an exceeding desire that I might get on a committee that should sound big and have little to do; and if our Speaker had the powers of a modern clairvoyant he could not have hit my case better than he did."). This was met with laughter. *Id.*

[303] *Id.*

[304] *Tending Towards Debate, In the House*, WASH. POST, Dec. 18, 1879, at 1.

[305] *Id.*

[306] Editorial, *Trade Trademark Treaties*, N.Y. TRIB., Dec. 8, 1879, at 4.

[307] *Id.*

must run within very narrow limits."[308] The *Tribune* proposed that the solution was to permit Congress to legislate regarding only foreign marks.

The House Judiciary Committee first took up the trademark issue on December 18, 1879, and heard from William Henry Browne for fifty-two minutes on the issue.[309] Following the holiday break, Mr. Browne and Rowland Cox, among others, addressed the Committee on January 14, 1880.[310] On February 4, 1880, a lawyer from New York by the name of Ayres spoke before the Committee, arguing against the amendment on the grounds that it would take too long, and that more immediate relief was needed.[311] On February 6, a subcommittee of Representatives Nathaniel Hammond, Edward Robertson, and Frank Hurd was appointed to draft appropriate legislation on the matter.[312] An additional hearing was held before the full Committee on February 12, 1880, at which Mr. McCoid presented his views.[313] His argument was essentially the same as before, when he argued that his amendment simply presented what would have been the intent of the framers all along and that no other solution was adequate to the problem at hand, including a bill based on the Commerce Clause.[314]

While the Committee deliberated, individuals in foreign countries, especially England and France, fretted about the state of their trademarks in America.[315] Although only 317 of the nearly 8,000 trademark registrations had been to residents of foreign countries,[316] it stands to reason that a foreign entity

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[308] *Id.*

[309] Minutes of the Committee on the Judiciary, 46th Cong., House of Representatives, at 48 (Dec. 18, 1879).

[310] *Id.* at 54.

[311] *The Proposition To Create a Department of Agriculture Favorably Received*, WASH. POST, Feb. 5, 1880, at 1. William Henry Browne also submitted a memorandum of the relevant trademark treaties that day and testified. Memorandum, *A Trade-Mark Belongs to Commerce*, from William H. Browne to the House of Representatives Judiciary Comm. (Feb. 2, 1880) (on file with the House Judiciary Committee at the National Archives); Minutes of the Committee on the Judiciary, 46th Cong., at 75, U.S. House of Representatives (Feb. 4, 1880).

[312] *Work in the Committees: The Proposition To Create a Department of Agriculture Favorably Received*, WASH. POST, Feb. 7, 1880, at 1.

[313] *The Trade Marks Question*, N.Y. HERALD, Feb. 13, 1879, at 5.

[314] *Id.*

[315] *Foreign Trade-Marks*, N.Y. TIMES, Feb. 14, 1880, at 4.

[316] Letter from Mr. Bowen, Exam'r of TradeMarks, to Rep. Hammond (Mar. 6, 1880) (on file with the House Committee on the Judiciary in the National Archives).

would have to be of substantial size and import to have their trademarks used across the oceans. Likewise worried were American owners of trademarks abroad, whose marks would only receive reciprocal protection. Since foreign owners currently had no protection, they held the same measure of safety in their marks.[317] This gave an added urgency to the push for legislation for foreign trademarks, while protection for domestic trademarks would seem far less pressing. This was reflected in the testimony of Mr. Rowland Cox before the House Committee on the Judiciary, encouraging a law protecting foreign marks but declining to comment on protection for domestic trademarks.[318] Nearly one hundred firms, representing some $200 million in trade (in 1880 dollars) and including many companies with active principals in the USTA, had sent in form petitions requesting that Congress take action regarding foreign trademarks in the U.S. in order to protect American interests abroad.[319] Domestic trademarks were not commented on once, following the policy the USTA had decided on shortly after the Supreme Court's decision.

Within the subcommittee, Rep. Hammond took the lead.[320] He asked the Trademark Examiner several questions, including whether any marks had been registered prior to the passage of the Act of 1870,[321] what states and industries were most highly represented in terms of trademark registrations,[322] and whether

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[317] *Id.*

[318] *Observations of Mr. Rowland Cox of New York: Hearing on National Legislation To Protect Trade-Marks Before the Comm. on the Judiciary* [hereinafter Cox Testimony] (prepared testimony of Rowland Cox). The testimony is not dated, but it was likely given a number of days after the petitions, which were dated around January 12, 1880. *See, e.g.*, Petition from the Singer Co., to the U.S. Cong. on the State of Trade-Mark Protection (Jan. 12, 1880) (on file with the National Archives). There is no mention of Mr. Cox speaking at any hearing in the newspapers.

[319] Cox Testimony, *supra* note 318, at 1.

[320] Nathaniel J. Hammond was the former Attorney General of Georgia and was regarded
as one of that state's "chief authorities" on constitutional law. THOMAS WALTER REED, HISTORY OF THE UNIVERSITY OF GEORGIA 556 (1949), *available at* http://dlg.galileo.usg.edu/cgi-bin/ebind2html.pl/reed_c05?seq=83.

[321] *See Bowen Letter*, *supra* note 66. As noted, while there had been no actual registrations, there were several marks deposited by foreign nationals pursuant to the treaties. *Id.* at 2.

[322] *Id.* at 3. Medicines, tobbaco, and whiskey were the most frequent registrations—about one third of the total amount—so it was suggested that states in which these industries were prominent would be states with the most registrations. *Id.*

the trademark office was profitable.[323] He was also the likely hand behind an unsigned memorandum found in the files of the Committee on the Judiciary, laying out how the treaty power provided sufficient authority for a new trademark act.[324]

The fact that the treaty power was regarded as nebulous and ill-defined at best, and nonexistent at its worst, formed a major obstacle to legislation based primarily on it. In this memorandum, the Committee laid out what would become its argument—both in the report it would issue and in subsequent debate—over the applicability of the treaty power to a new trademark law. It was noted that the framers of the Constitution had countenanced the treaty power at the very time of the founding, such as the 1790 Treaty with the Cree and the Jay Treaty.[325] Various other historical cases were considered, as well as the case law in the Supreme Court regarding treaties, before the memorandum noted the naked core of the argument—that the treaties had imposed an obligation for Congress to act, and Congress must, therefore, have that power.[326]

By early March of 1880, the subcommittee had finished their work and the House Judiciary Committee agreed to proceed with a bill rather than the constitutional amendment.[327] Three days later, the Committee approved a new bill based on the treaty power and ordered it presented to the full House.[328] At that same meeting, the Committee decided that Congress did not have the authority to legislate regarding interstate trademarks—the Commerce Clause was out.[329]

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[323] *Id.* at 4. Apparently, it was only costing in administrative expenses one third of what it received in fees.

[324] *See* Memorandum to the House Comm. on Patents, 46th Cong. (no date) (unpublished draft).

[325] *See id.* at 1.

[326] *See id.* at 5.

[327] *See Capital Notes*, WASH. POST, Mar. 10, 1880, at 1 (noting that the Armfield Bill had been adopted on March 9th). It is likely that there was more a general discussion, choosing to proceed with a bill rather than the amendment and that a draft of the new bill was distributed that day. The committee felt that "the subject was not invested with sufficient importance to warrant a constitutional amendment." *See The UTE Agreement-Wrongs of the Poncas-A Trade-Mark Bill*, N.Y. TIMES, Mar. 13, 1880, at 5.

[328] *See Capital Notes*, WASH. POST, Mar. 13, 1880, at 1.

[329] *See id.*

On the same day, the new bill and accompanying report were presented to Congress.[330] The new bill, House Bill 5088, did not differ much from the Armfield Bill (or the 1870 Act), save for one critical fact—it applied only to trademarks used in commerce with foreign nations or Indian tribes.[331] The report that accompanied the bill went into some detail about why this was so, explaining the bill's basis in the treaty power.[332] The report explained that the Committee had engaged in careful consideration as to whether the Commerce Clause empowered Congress to legislate regarding trademarks—and had determined that it did not.[333] It was felt that a trademark was simply a manufacturer's guarantee, which is not necessary to commerce.[334] However, the Necessary and Proper Clause of the Constitution did give Congress the power to enact legislation executing treaties validly made by the executive branch with the Senate's consent.[335] The Committee's only stated authority for this proposition was *United States v. Coombs*,[336] a case that seems inapposite. In that case, Justice Story found that the Commerce Clause extended to acts committed entirely above the high-water mark in a single state (specifically the salvage of goods from a sinking vessel) because they implicated questions of navigation, and thus commerce, and that Congress may make "all laws necessary and proper to execute their delegated constitutional powers."[337] This uncontroversial statement does not mean that Congress may make all laws necessary and proper to execute powers *not* specifically delegated, but it comprised the sole justification for the treaty power given by the Committee. The report then noted that trademarks on patented goods were also validly protected under the existing patent law, and thus

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[330] *See* 10 CONG. REC. 2701 (1880).

[331] *See* H.R. 5088, 46th Cong. (2d Sess. 1880). As subsequently noted, the criminal trademark act had already been added, and there were additional technical changes to the bill from the version which was introduced.

[332] *See* H.R. REP. NO. 46–561, at 6 (2d Sess. 1880).

[333] *See id.* at 5 (the first four pages of the report are the Supreme Court's decision).

[334] *See id.* It was also noted that only 8,000 trademarks were in use the in the United States at the time, *see id.*, but this is clearly erroneous. There were only 8,000 *registrations* of trademarks; it is unknown how many marks were unregistered and protected by common law.

[335] *See id.* at 6.

[336] *See* 37 U.S. (12 Pet.) 72 (1838).

[337] *See id.* at 78–79.

interstate (and presumably intrastate) trademarks were already protected.[338] Regarding trademarks on unpatented goods, the report concluded that the existing common law protections were sufficient.[339] The report then briefly covered the changes the bill made to the original Armfield Bill, such as the addition of the criminal trademark provisions, the removal of the appeal process and the new office, and other small changes.[340] It resembled the pre-1879 trademark law "almost *verbatim*," save for the change in scope.[341]

The bill was not discussed for reasons of parliamentary procedure on March 12[342] and not heard from again until April 23.[343] In the interim, the Secretary of State was apparently in active discussions with Mr. Hammond, urging him to press the bill, which he did that day.[344] After the bill was read, Rep. Hammond provided some background and revealed that the Committee had unanimously felt that trademarks could not be regulated under the Commerce Clause.[345] He went through the relevant cases, many of which had been mentioned by the Supreme Court, regarding whether a trademark was used in commerce and concluded that, either way, Congress should refrain from exercising power where it was in doubt:

> But valuable as are the opinions of the Supreme Court they should not be the measure of the power we shall exercise in Congress. They pass upon State laws said to conflict with the supreme law, and may give the benefit of doubts in favor of the Federal power or the States as they like. But Congress is co-ordinate with the court and the legislative body of the Government, whose ermine they wear. They must therefore hold Congressional legislation valid unless manifestly and plainly unconstitutional. The only safety, then, is for Congress to solve its doubts against the exercise of power. If it will not, the result is Congress can do all things not plainly forbidden. This is at war with the plan of our fathers. That plan restricted

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[338] *See* H.R. REP. NO. 46–561, at 6.
[339] *See id.* at 6–7.
[340] *See id.* at 7.
[341] *See id.*
[342] 10 CONG. REC. 1514 (1880).
[343] *See id.* at 2701.
[344] *See In the Capital*, ATLANTA CONST., Apr. 27, 1880, at 1.
[345] 10 CONG. REC. 2702 (1880).

> Congress to the exercise of certain delegated powers. One of them was regulating commerce. That power was delegated to the United States that the States might not cripple commerce.[346]

With such an approach in mind, it was clear that not only did the Committee on the Judiciary not feel that it had the power to legislate interstate commerce, it also felt that it *should not* have such a power out of a concern for federalism. Under such a view, the Committee's looking askance at the McCoid Amendment makes perfect sense; if the right to legislate regarding domestic trademarks is inappropriate, then likewise, an amendment to grant such a right to the federal government is inappropriate.

Rep. Hammond then turned to the question of foreign trademarks and went through the arguments made in the report as well as the various relevant trademark treaties.[347] He noted that "[m]any foreign trade-marks were lodged [in the Patent Office] before the act of 1870 was passed" and that "[i]t is plain from the debates that [the 1870 Act] never could have passed had it not been thought important in aid of those treaties."[348] Of the petitions the Committee had received, all but one dealt only with the request for an act to uphold America's treaty obligations.[349]

Here, Rep. Hammond diverted—with the Committee's apparent approval—from the bill and moved to strike the criminal sections of the bill.[350] In the process, he lambasted the 1876 Act, arguing that "[n]o treaty obligation demanded this act of 1876" and that the act's provenance was severely flawed.[351] He

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[346] *Id.* at 2703.

[347] *Id.* at 2703–04.

[348] *Id.* at 2704.

[349] *Id.* Apparently, there was one from Boston in favor of the McCoid Amendment. *Id.*

[350] *Id.*

[351] *Id.* His comments continued:

> The bill was introduced into the Senate and passed there without discussion. It was so carelessly written that the language covered commerce wholly within the States, as well as without. It was so hastily gotten up that its short title is ungrammatical and the Supreme Court did not know what Congress intended to express by the act. One of its friends sought to pass it in the House without a reference, claiming it was a bill to protect honest merchants and manufacturers. It was referred, not to a law committee, but to the Committee on Patents, who had nothing to do with crimes. They reported it back saying four hundred manufacturers, merchants, and dealers, in New York, Boston, and Philadelphia, had petitioned for its passage. They gave no other reason therefor, but called

further noted that jail time for trademark infringement seemed perverse, and, in any case, it was unwise to increase the criminal jurisdiction of the federal courts without good reason.[352] Furthermore, there were not many federal penitentiaries, so conviction and imprisonment would frequently be far from home for the infringer and pose an inappropriately onerous burden.[353] He concluded, "[t]he advocates of the bill would invoke the majesty of the United States to frighten citizens. No such spirit breathes from the Constitution. If you would not have laws despised, pass none which you will not enforce. Make laws to provoke love, not to excite terror."[354]

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the previous question. At the last moment Mr. Hewitt of New York tried to protest for the thousands of small dealers in New York who might be entrapped by its provisions, but it was forced through. It is not strange that a creature of such hasty and violent birth languished, and, languishing, died in less than three years. The eight eminent doctors [(the conference committee)] who tried to save its life said they know not what was its ailment except that it was stuffed with incongruous food, and that it might have died anyhow even if it bad not swallowed the States.

Shall we resurrect the corpse? Shall we give to those owners of trade-marks, protected by treaties which pledged only such protection as our own citizens have for theirs, this high right which our citizens cannot enjoy in this country? It would be at least decent to wait till we could put our own citizens on the same plane with foreigners and Indians. Wait till the McCoid amendment becomes a part of the Constitution—you who urge its passage. Do not enact this and then urge McCoid's amendment because the foreigner and Indian is better protected than our citizen, amend the Constitution to make it fit a statute.

Id. (citations and internal quotation marks omitted).

[352] *See id.* Rep Hammond again lapsed into colorful language:

On an American vessel in mid-ocean is a young girl returning home. In charge of the master, she has the right to be secure against even discourtesy. But forgetful of his duty as a man, despising his sacred trust, in the darkness of night he attacks her, alone, friendless, helpless, and with threats seduces and deflowers her. In Georgia we could put one at hard labor for twenty years for such a crime. Death would be too good for the scoundrel. But see that man at the bar of a United States court, convicted of thus violating section 5349 of the Revised Statutes, and hear the judge, burning with virtuous indignation, pronounce on him the extreme penalty of the law, a fine of $1,000 and imprisonment for twelve months. And imagine him adding, "I regret that you are not found guilty of fraudulently putting a false drink in a bottle having on it the trade-mark of LL whisky; for then I could punish you at least double as much as I can for this diabolical crime."

Id.

[353] *Id.*

[354] *Id.* at 2705. This speech is clear evidence that the 1876 Act was not revived by the 1881 Act, and an 1889 opinion put another nail in the coffin of the 1876 Act by holding that it "is as much a dead letter as the act of 1870, and was not vivified or

Turning to the McCoid Amendment, the Committee on the Judiciary was not persuaded by the reasons given in the report of the Committee on Manufactures.[355] It was felt that the cost passing a Constitutional Amendment was greater than just paying back the fees paid for trademark registrations, and that the notion that the President could enter into a treaty that Congress could not execute was absurd.[356] Furthermore, Rep. Hammond felt that the states were perfectly acceptable forums for resolving trademark disputes, even if a uniform law would be very convenient.[357] Ultimately, while Rep. McCoid felt that the omission of trademarks from the Constitution was simply a question of their coming about too late, Rep. Hammond disagreed vehemently, feeling that the point of copyrights and patents was to protect the artist and inventor for whom otherwise their toil would be for naught.[358] Such was not the case with trademarks, where they simply identified who had made a certain product.[359]

In closing his oration, Rep. Hammond noted that all amendments up to this time had limited the power of the federal government, not enhanced it, and that it was highly undesirable to have the power of the federal government enhanced.[360] It is impossible here to forget that Rep. Hammond was from Georgia, and it was only a decade and a half since the Civil War. It is likewise impossible to ignore that three amendments had just been passed over the opposition of the Southern states.[361] The time was simply wrong for any expansion of the federal government—implicit in Rep. Hammond's views was that the federal government was already too powerful.

Rep. Hammond's speech was well received by the House.[362] Rep. McCoid rose to respond, but the House recessed instead.[363] He was once again thwarted on the 26th.[364] On the 27th, the

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given operative force by the act of 1881." United States v. Koch, 40 F. 250, 252 (C.C.E.D. Mo. 1889). Despite all this, some were of the opinion that the 1876 Act was in force even after 1889. *See* Abdel-Khalik, *supra* note 8, at 184 n.50.

[355] 10 CONG. REC. 2705.

[356] *Id.*

[357] *Id.* at 2705–06.

[358] *Id.* at 2706.

[359] *Id.*

[360] *See id.*

[361] *See* U.S. CONST. amends. XIII–XV.

[362] *See In the Capital*, *supra* note 344.

[363] 10 CONG. REC. 2706–07.

[364] *Id.* at 2756–57.

House took up House Bill 5088, and despite some who wanted to argue its terms, went straight to a vote.[365] First, the requested amendments were approved (mainly striking out the criminal provisions) and then House Bill 5088 was passed.[366] Aside from Rep. Hammond's speech, for which no response was given, it had never been debated. Rep. McCoid then requested reconsideration of his amendment, which he considered to be consistent with the bill that had just been passed.[367] Rep. Hammond was not opposed, but, instead, the House adjourned.

The Senate received the bill on the 29th, and it was sent to the Committee on the Judiciary.[368] It may have seemed that the bill had considerable momentum, but instead it did not get out of that Committee in the second session of Congress.

C. In the Third Session

Shortly before the Forty-sixth Congress had adjourned its second session, another bill was sent to the Senate Committee on the Judiciary, which was already considering House Bill 5088. Senate Bill 1751[369] provided merely for registration and that such registration would be proof of ownership, as the Patent Office was already doing in the wake of the *Trade-Mark Cases*.[370] As such, there was no requirement that the mark be used in interstate or international commerce (although there were criminal sanctions for engaging in any falsehood in procuring registration).[371] While the question of a trademark law waited for Congress to start its third session, there remained occasional reminders of the difficulty of the situation, where the trademark law was now in limbo. Foreign manufacturers were leery of sending their goods to the 1883 World's Fair in New York, and the USTA created a committee to determine the best solution to this problem.[372] At the same time, the USTA remained fairly

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[365] *Id.* at 2795, 2808. Rep. Claflin wanted to ask whether an act, which only protected foreigners was proper but was informed that debate was out of order. *Id.* at 2808.

[366] *Id.*

[367] *Id.*

[368] *Id.* at 2860.

[369] S. 1751, 46th Cong. (2d Sess. 1880).

[370] *Id.* § 1–3.

[371] *Id.* § 9.

[372] *See, e.g.*, *City and Suburban News*, N.Y. TIMES, Jan. 29, 1881 at 8; *Foreign Trade Marks and the World's Fair*, N.Y. HERALD, Jan. 31, 1881, at 6; *The New*

indifferent to the effect of the *Trade-Mark Cases* on domestic marks, feeling that common law protections were generally sufficient.[373]

The third session of the Forty-sixth Congress began in early December of 1880, and later in the month the Senate Judiciary Committee took up consideration of both bills, assigning them to a subcommittee of Senators Conkling and Davis.[374] Slightly over two months later, the subcommittee reported favorably on House Bill 5088, while recommending that Senate Bill 1751 be indefinitely postponed.[375] The Forty-sixth Congress was about to end without a trademark law when the full Committee reported back House Bill 5088 favorably and without further amendment on the same day.[376] The following day, the bill passed the Senate without debate.[377] Two days after that, the President signed House Bill 5088 into law—on the very last day of the Forty-sixth Congress.[378] After one year of inaction, the Senate passed the bills with remarkable alacrity, but press coverage of the bill's passage was slight—it was mostly ignored in the face of the avalanche of other bills passed at the end of the session.

In the Forty-seventh Congress, Rep. McCoid again introduced a constitutional amendment for trademarks.[379] It was referred to the Committee on the Judiciary. and was never heard from again.[380] Meanwhile, the passage of the 1881 Act served to reassure foreign powers, and within two years of its enactment,

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Trade-Marks Law, N.Y. TIMES, Mar. 18, 1881, at 4 (discussing the applicability of the new 1881 Act to the fair); *Property in Trade Marks*, N.Y. HERALD, Jan. 29, 1881, at 10 (noting that Belgian manufacturers would not exhibit unless their trademarks were protected). The fair was never actually held. *See A World's Fair in 1892*, N.Y. TIMES, June 25, 1889, at 4 (recounting why the 1883 fair never occurred).

[373] *Trade-Mark Legislation*, N.Y. TIMES, Jan. 18, 1881, at 3; *Trade Mark Registry*, N.Y. HERALD, Jan. 18, 1881, at 11. The USTA also considered the possibility of applying to the New York legislature to make registrations on its own "with some legal effect and value." *Id.*

[374] 11 CONG. REC. 270 (1881).

[375] *Id.* at 2195.

[376] *Id.*

[377] *Id.* at 2284.

[378] *Id.* at 2467.

[379] H.R.J. Res. 9, 47th Cong. (1st Sess. 1881).

[380] *Id.*

trademark treaties were signed with Serbia,[381] Spain,[382] Italy,[383] and the Netherlands.[384] Not a single nation entered into a trademark treaty with the U.S. in 1879 or 1880.

D. The Regime of the Trade-Mark Cases

With the passage of the 1881 Act, the shadow of the *Trade-Mark Cases* at once grew shorter and stronger. There was once again a federal trademark law, but its coverage was exceedingly scant, pursuant to congressional understanding of the Supreme Court's opinion. With a new law finally in place, the federal government would paradoxically be able to register a far smaller number of marks than it had even a month prior. This drop is simple enough to explain: The practice of registering trademarks never actually ceased despite the fact that sixteen months passed with no trademark law. As noted, the Commissioner of Patents continued to accept registrations, provided the registrant was made aware of the problematic nature of the trademark laws.[385]

During June of 1880, the chief clerk of the Patent Office resigned to become the new Principal Examiner of Trademarks, and the question was again raised of what authority there was for continuing to have a trademark examiner.[386] The position was still provided for by Congress, and seventy-five trademarks had been registered in May 1880.[387] In December of 1880, the Attorney General recommended that the practice of registering trademarks be ceased until a new act was made. In allowing registrations, "the Commissioner must necessarily entertain jurisdiction to determine who is entitled to such registration, to declare interferences, and to decide questions arising under them."[388]

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[381] Convention of Commerce and Navigation, U.S.-Serb., art. XII, Nov. 15, 1882, *reprinted in* 2 MALLOY, *supra* note 40, at 1616–17 (stating that all aspects of the treaty were completed well after the 1881 Act was passed).

[382] Trade-Mark Convention, U.S.-Spain, Apr. 19, 1883, *reprinted in id.* at 1675.

[383] Declaration for the Reciprocal Protection of Marks of Manufacture and Trade, U.S.-Italy, *proclaimed* Mar. 19, 1884, *reprinted in* 1 *id.* at 984.

[384] *See* Letter from F. T. Frelinghuysen, Sec'y of State to G. De Weckherlin (Feb. 16, 1883), *reprinted in* 2 *id.* at 1265–66; Letter from G. De Weckherlin to F. T. Frelinghuysen, Sec'y of State (Feb. 10, 1883), *reprinted in id.* at 1265.

[385] *Registry of Trade-Marks*, N.Y. HERALD, June 20, 1880, at 8.

[386] *Id.*; *Notes from the Capital*, N.Y. TIMES, June 20, 1880, at 2.

[387] *Registry of Trade-Marks*, *supra* note 385.

[388] Registration of Trade-Marks, 16 Op. Att'y Gen. 586, 586–87 (1880).

In response to this, the House Committee on the Judiciary proposed a resolution asking the Secretary of the Interior to explain under what justification trademarks continued to be registered, no doubt in part because the new law would not provide for domestic registrations.[389] The resolution was passed immediately after it was proposed.[390] The Secretary of the Interior forwarded the letter of the Commissioner of Patents to the effect that the Patent Office had kept registering trademarks because, at a minimum, it provided evidence of their use, even if the remedies of the 1870 Act would not be available. The Commissioner of Patents assumed that if Congress meant for them to cease doing so, they would have cut off appropriations—which Congress had not done.[391]

On February 9, 1881, in the interference proceeding *Braun v. Blackwell*,[392] the Commissioner of Patents dissolved all trademark interference proceedings and announced that there would be no more of them.[393] Blackwell had moved to dissolve the interference on the grounds that the Commissioner lacked the authority to conduct the interference, and the motion was denied on the grounds that the Secretary of the Interior specifically authorized the proceeding in his letter issued shortly after the *Trade-Mark Cases*, allowing registrations to continue with the registrant's understanding of the situation.[394] Blackwell then petitioned the Secretary of the Interior to discontinue the proceeding, and the Secretary issued an opinion directing the annulment of the interference and directing that the Commissioner should do nothing more than conduct registrations—without opining on the validity of the mark.[395] On the Secretary's orders, all pending interferences regarding trademarks were annulled.[396]

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[389] 11 CONG. REC. 727 (1881).

[390] *Id.*

[391] H.R. EXEC. DOC. NO. 46-83, at 1–2 (1881).

[392] Braun v. Blackwell, 1881 Dec. Comm'r Pat. 10 (1881).

[393] *See* U.S. PATENT COMM'R, ANNUAL REPORT OF THE COMMISSIONER OF PATENTS FOR THE YEAR 1880, H.R. DOC. NO. 46-67, at vii (1881); *see also Important Trade-Mark Decision*, WASH. POST, Feb. 4, 1881, at 2.

[394] *Blackwell*, 1881 Dec. Comm'r Pat. at 10–11.

[395] *Id.*; *Suppression of One Class of Interferences*, SCI. AM., Mar. 12, 1881, at 161.

[396] *Blackwell*, 1881 Dec. Comm'r Pat. at 10–11.

Once the 1881 Act was passed, it was distributed by the Patent Office, but prospective registrants were to be informed that "until time has been taken for preparing regulations and forms appropriate for administering the law, no action can be taken by the office on applications, nor can information be given to correspondents; but persons interested are advised to wait, before forwarding papers, until rules can be prepared."[397] The public did not have to wait long, and new rules were promulgated within a month of the Act's passage.[398] The rules implemented a new requirement for registrants: They needed to declare that the trademark to be registered was used in commerce with foreign nations or Indian tribes.

Once registrations recommenced, it was clear that the Commissioner's authorities changed considerably. In the appeal of a registrant from the denial of an examiner, the Commissioner of Patents held that the examiner was correct—examiners should once again consider the legality of the trademark rather than just registering it mechanically.[399] Beyond the requirement that the trademark is in use in commerce with a foreign nation or Indian tribe, the criteria for registration were the same as they had been prior to the *Trade-Mark Cases*.[400]

In the following years, there would be repeated attempts to bring interstate trademarks within the coverage of the federal trademark laws—the first being in 1885.[401] In this case and in others thereafter, the House Committee on Patents would be in favor of such an act, but the House Committee on the Judiciary would be opposed.[402] In 1895, Rowland Cox, who had advocated that Congress content itself with legislating regarding foreign marks in early 1880, presented a paper advocating expanding

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[397] *Trademarks Again*, N.Y. TRIB., Mar. 14, 1881, at 4; *see also The New Trademark Law: Wherein It Differs from the Act Formerly in Force*, WASH. POST, Mar. 14, 1881, at 2.

[398] *See generally New Trade-Mark Law*, CHIC. TRIB., Mar. 23, 1881, at 3 (explaining the new rules and regulations adopted under the revised trademark law).

[399] *See* Strasburger & Co., Dec. Comm'r Pat. 23, 23 (1881).

[400] *See id.*

[401] COMM. ON PATENTS, REGISTRATION OF TRADEMARKS, H. REP. NO. 48-2376 (1885).

[402] Abdel-Khalik, *supra* note 8, at 183 n.44. For instance, in 1890, the House Judiciary Committee reported adversely on a bill to impose criminal penalties for trademark counterfeiting, noting that trademark regulation did not fall within the province of the Commerce Clause. H.R. REP. NO. 51-2539 (1890).

coverage of the federal law to include domestic marks, noting that both times and the understanding of the Commerce Clause had changed.[403] It would be another decade until this change occurred.

E. Later Efforts at Constitutional Amendment

Although never successful, the effort for a constitutional amendment to overrule the *Trade-Mark Cases* would continue long after the failure of the 1879 and 1881 amendments.[404] Even though the trademark law was amended to include interstate commerce in 1905[405] based on the Commerce Clause, this still did not give Congress the same latitude regarding trademarks as it held over copyrights and patents. Attempts to overrule the *Trade-Mark Cases* by constitutional amendment would continue through the 1950s.

1. The Kahn Amendments

Surprisingly, after 1881, there were no attempts to amend the Constitution to include trademarks until after the 1905 Act. The next proposed amendment was introduced by Rep. Julius Kahn in 1911[406] and again in 1913.[407] This amendment failed to gain traction, and, indeed, it is completely unmentioned in the archives of the committee to which it was sent. Aside from the usual enabling language, the text of the amendment was simple enough: "Congress, for the promotion of trade and manufacture and to carry into effect international treaties, shall have power to grant, protect, and regulate the exclusive right to adopt and use trade-marks."[408]

The question is why a congressman who, by his own admission unfamiliar with the law of patents.[409] and presumably trademarks as well, would find himself proposing such a change to the Constitution. One possibility is that Rep. Kahn was

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[403] Rowland Cox, *The Constitution of the United States and Its Relation to the Subject of Trade-Marks*, 51 ALBANY L.J. 118, 124 (1895).

[404] *See* Michael J. Lynch, *The Other Amendments: Constitutional Amendments That Failed*, 93 L. LIBR. J. 303, 303–09 (2001) (discussing potential constitutional amendments that subsequently did not pass).

[405] Act of Feb. 20, 1905, ch. 592, § 1, 33 Stat. 724.

[406] H.R.J. Res. 159, 62d Cong. (1911).

[407] H.R.J. Res. 18, 63d Cong. (1913).

[408] *Id.* (same language in both resolutions).

[409] *See The Kahn Act*, 9 BULL. U.S. TRADE-MARK ASSOC. 287, 307 (1913).

working in hand with the USTA, which simultaneously published an article by Arthur William Barber, advocating a constitutional amendment on the front page of its bulletin.[410] This is unlikely, however, as Barber does not mention Kahn, or his amendment, once in his article. Furthermore, Arthur William Barber was the Secretary of the USTA and likely the most influential advocate for trademarks in the day.[411] It is unlikely that an amendment being pushed by the USTA would have simply died in committee completely without any additional comment. The more likely interpretation is that these amendments came from an unlikely place, the Panama-Pacific Exhibition of 1915.

In 1915, a scant nine years after the devastating earthquake of 1906, San Francisco hosted a massive exhibition to celebrate the opening of the Panama Canal in August 1914 and the city's rebuilding from the calamity less than a decade before.[412] As a representative from San Francisco, Rep. Kahn was one of the exhibition's greatest boosters in Congress, and a centerpiece of his efforts was the so-called Kahn Act.[413] As had been an issue in 1883, foreign powers were reluctant to participate if their intellectual property was not protected.[414] At the urging of President Taft,[415] the Kahn Act provided protections for foreign intellectual property brought to the convention even if it had not been registered under normal protocols. The Act further established a branch patent and copyright office at the exhibition and allowed for "certificates of registration" for a wide

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[410] *See* Arthur Wm. Barber, *The Constitution and Trade-Marks*, 8 BULL. U.S. TRADE-MARK ASS'N. 119, 125–26 (1912).

[411] *See* L. E. Daniels, *The United States Trade-Mark Association*, 33 TRADEMARK REP. 3, 5 (1943) ("It has been said of Mr. Barber that, during the period of his incumbency, there was hardly an important amendment proposed in the trade-mark laws of the United States or of the South American republics that did not embody one or more wise provisions from his pen.").

[412] *See A Sense of Wonder: The 1915 San Francisco World's Fair*, MOAH.ORG, June 7–Sept. 22, 2002, http://www.moah.org/exhibits/archives/1915/.

[413] H.R. 7595, 63d Cong. (1913).

[414] *See Austrians Favor Exhibit*, N.Y. TIMES, Sept. 15, 1913, at 4. Other states were also concerned, particularly because California had just introduced a controversial state trademark law, which allowed for registration without prior use. *Want the State's Trade-Mark Law Amended*, S.F. CHRON., Mar. 2, 1911, at 1 (noting that this would be before the 1911 proposal for the amendment).

[415] *See* President William H. Taft, State of the Union Address (Dec. 19, 1912), http://stateoftheunion.onetwothree.net/texts/19121203.html; *see also The Kahn Act*, *supra* note 409 (reproducing Report of the House Committee on Ways and Means on the Kahn Bill).

variety of intellectual property, including trademarks, for which said certificate would function as "legal evidence of . . . proprietorship."[416] The Act was opposed on several grounds, but an important one was that the Kahn Act legislated regarding trademarks without requiring that they be used in commerce.[417] Given that these marks were being brought in for the sole purpose of the exhibition, and not sale, use in commerce was anything but a sure question at the time with a narrower reading of the Commerce Clause still in vogue.

Nonetheless, the amendments themselves died a quick and silent death before the Kahn Act could spring to life, uncommented on by the surviving records. The most likely reason is simply that the goal of protecting trademarks at an exhibition, no matter how prominent, hardly seemed commensurate with the enormity of the undertaking to amend the Constitution.

2. The Keogh Amendments

The only attempts at a constitutional amendment regarding trademarks in recent memory have been the four amendments proposed by Rep. Eugene J. Keogh between 1949 and 1955.[418] The wording of the four resolutions was identical, and, aside from the usual enabling language, these amendments merely stipulated that "[t]he Congress shall have power to regulate the use and ownership of trade-marks."[419] The language of the amendment does not seem to be based on any of the prior proposed amendments—which were mostly forgotten by that time. It was drawn, instead, following the advice of the amendment's advocates.[420]

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[416] H.R. 7596.

[417] *See* William H. Kenyon, *The Kahn Act: A Criticism*, 14 COLUM. L. REV. 52, 53–55 (1914). This viewpoint was disagreed with on the grounds that if the trademark would be copied domestically, it would inherently invoke a question of international commerce. *See* Charles E. Townsend, *The Protection of Intellectual Property at International Exhibitions*, 2 CAL. L. REV. 291, 305–06 (1914).

[418] H.R.J. Res. 3, 84th Cong. (1955); H.R.J. Res. 331, 83d Cong. (1954); H.R.J. Res. 27, 82d Cong. (1951); H.R.J. Res. 229, 81st Cong. (1949).

[419] *See, e.g.*, H.R.J. Res. 229.

[420] *See* Letter from Paul Struven, President, Trade-Mark Serv. Corp., to Rep. Eugene J. Keogh (Mar. 23, 1949) (regarding *Trade-Mark Amendment to the U.S. Constitution)* (on file with author) [hereinafter Struven Letter]; *see also* Memorandum from the U.S. House of Representatives Office of the Legislative

The impetus for the amendment was the lobbying of the Trademark Service Corporation, and, specifically, the organization's president Mr. Paul Struven.[421] Paul Struven had been lobbying Congress for this amendment at least ten years prior to when it was first proposed, repeatedly appearing in the long crawl towards the Lanham Act. The origins of his interest in the subject stem even further back—from his involvement in advocating mandatory state registration of trademarks, which would do away with the common law approach.[422] When it became apparent that arguing for mandatory registration in each state individually would be a herculean task, he turned his focus to securing a constitutional amendment that would allow the federal government to implement mandatory registration in one fell swoop. In this effort, he stood directly opposed to the USTA, which firmly opposed mandatory registration schemes and, in fact, had decades earlier urged a constitutional amendment specifically to preempt any state-level mandatory registration laws.[423]

During the March 15th to 18th hearings on trademarks in 1938, Mr. Struven was a witness and expressed his view near the close of the hearings that he believed the solution to all the problems of trademark law Congress was grappling with was a constitutional amendment.[424] This led to a sharp rejoinder from Edward S. Rogers stating that that he did not "believe there is any more chance of getting a constitutional amendment enacted . . . and we might as well give up any idea of thinking of

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Counsel to Rep. Eugene J. Keogh (including further unchanged draft of joint resolution text).

[421] After mergers and name changes, the company is now CT Corsearch. CT CORSEARCH, A HISTORY OF INNOVATION, https://www.ctcorsearch.com/CtcorsearchApps/ctcorsearch/About.aspx?SISD=5, (last visited Oct. 20, 2009). This company was formed in 1949—according to its own website. Prior to this, Mr. Struven identified himself as managing director of an organization called the Trade-Mark Sales Corporation. However, he also identified himself with the Trade-Mark Service Company as early as 1934. Paul Struven, Letter to the Editor, *Trade-Mark Procedure*, N.Y. TIMES, Jan. 4, 1935, at 20.

[422] *See* Paul Struven, *Case for State Registration of Trade Marks*, PRINTER'S INK, Oct. 31, 1935, at 81–83; *Trade-Mark Rule Argued at Albany*, N.Y. TIMES, Aug. 11, 1938, at 32.

[423] *See* Barber, *supra* note 410, at 140–43.

[424] *See Trade-Marks: Hearing on H.R. 9041 Before Subcomm. on Trade-Marks of the H. Comm. on Patents,* 75th Cong. 104, 176 (1938).

it."[425] Undeterred, Mr. Struven continued to send correspondence to be included in committee hearings despite not being invited again. A year afterwards, he sent a lengthy set of letters and memoranda advocating a constitutional amendment to the subcommittee, which were included in the printed hearing.[426] Mr. Struven would send another lengthy memorandum two years after this, but reaction at the time was minimal.[427] Nonetheless, these memoranda would form a basis for the arguments Struven presented that led to the introduction of a proposed amendment in 1949, the first in thirty-six years.

In a memorandum dated March 23, 1949, and sent to Rep. Eugene J. Keogh of New York, Mr. Struven gave six arguments for the amendment:

> 1. "To definitely fix the control of trade-marks within the United States Constitution."
> 2. To make moot the question of how far the Commerce Clause extends in regulating trademarks.
> 3. To make it easier to allow businesses to deduct trademark expenses for tax purposes.
> 4. To clarify the government's ability to enter international trademark treaties and conventions.
> 5. To provide a constitutional basis for amendments to fix the "inequities" of the Lanham Act.
> 6. To provide a vehicle for government coordination of existing trademark registration regimes.[428]

Mr. Struven then closed his letter with an appeal that would prove problematic in the future—that this amendment was needed to give trademark owners "a deed of title ownership to their trade-marks."[429] The view of a trademark as pure property

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[425] *Id.* Edward S. Rogers was a Chicago attorney and one of the fathers of the Lanham Act, having provided a draft bill that would be a first version to Rep. Fritz Lanham.

[426] *See Trade-Marks: Hearing on H.R. 4744 Before Subcomm. on Trade-Marks of the H. Comm. on Patents,* 76th Cong. 195–207 (1939) (letter of Paul Struven).

[427] *See Trade-Marks: Hearing on H.R. 102, H.R. 5461, and S. 895 Before Subcomm. on Trade-Marks of the H. Comm. on Patents*, 77th Cong. 243–50 (1941) (letter of Paul Struven).

[428] Struven Letter, *supra* note 420.

[429] *Id.*

interest would be called into question by opponents of the amendment.[430]

Roughly one month later, on April 26, 1949, Rep. Keogh introduced the amendment as House Resolution 229 in the first session of the Eighty-first Congress.[431] He made no statement when introducing the bill,[432] and it was referred to the Committee on the Judiciary, as is standard for proposed amendments.

In one of the few published comments on these amendments, Rep. Keogh explained that he wished to "protect trade-mark owners from the abuses that come from enforced state registration."[433] In private correspondence, though, he was more equivocal, saying that he hoped to "generate some discussion pro and con solely with the view of attempting to clarify the status of the trademarks."[434]

Outside opposition to the amendment was centralized around the USTA.[435] The organization was at the forefront of lobbying for trademark reform, but perhaps because so much had been invested in the current statutory regime (the recently passed Lanham Act), it was loath to tinker with the underlying constitutional dynamics of trademark law. At the USTA Annual Meeting in 1950, the Lawyers' Advisory Committee of the USTA unanimously opposed the amendment, asserting that its only supporter was Paul Struven.[436] At the same meeting, a "legislative update" was given and critically noted that "[t]o empower Congress to regulate the use and ownership of marks might well, in effect, result in compulsory federal trade-mark

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[430] *See generally* Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 561–75 (2006) (discussing the evolution of property and use theories of trademark law).

[431] H.R.J. Res. 229, 81st Cong. (1949).

[432] Letter from Rep. Eugene J. Keogh, to George Link Jr., Esq. (May 12, 1949) (on file with author).

[433] G. A. Nichols, *Inside Washington*, PRINTER'S INK, May 13, 1949, at 15, 16.

[434] Letter from Rep. Eugene J. Keogh to Daphne Robert, The Coca-Cola Co. (May 18, 1949) (on file with author).

[435] Currently the International Trademark Association. *See* INTA, History, http://www.inta.org/index.php?option=com_content&task=view&id=26&Itemid=122&getcontent=4 (last visited Apr. 2, 2009).

[436] *Report of the President*, 40 TRADE-MARK REP. 483, 485 (presented at the USTA annual meeting on June 6, 1950) ("Its only support has come from a so-called trade-mark specialist who in prior years has supported compulsory state trade-mark registration bills.").

registration."[437] On July 7, 1950, a meeting was held between Rep. Keogh and the president and secretary of the organization, along with other interested parties.[438] Apparently, the association and the congressman were not able to reach an agreement, and the association continued to oppose the amendment. The American Bar Association ("ABA") also opposed the amendment in a resolution agreed to by the House of Delegates at its annual meeting.[439] The reasons given were that the amendment was unnecessary and would have the negative effect of destroying the common law of trademarks.[440] As House Resolution 229 had failed to progress in the Eighty-first Congress, it was reintroduced as House Resolution 27 near the beginning of the Eigthy-second Congress.[441] Aside from another expression of disapproval by the ABA, however, not much was done with it.[442]

On October 28th 1953, the matter was revived when Mr. Struven notified Rep. Keogh that an ally of the amendment, Mr. I. Walton Bader, had been appointed to the ABA Committee on Trademarks and would push for the amendment.[443] Nothing happened in the ABA due to general lack of interest and fears that some trademark owners would be disadvantaged,[444] but the letter does seem to have pushed Rep. Keogh to reintroduce the amendment as House Resolution 331 near the beginning of the

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[437] Sylvester J. Liddy, *Legislative Update*, 40 TRADE-MARK REP. 644, 647 (presented at the USTA Annual Meeting June 6, 1950).

[438] Present were: Henry B. King, Secretary of the U.S. Trademark Association; Mr. Kenneth Perry, Vice President of Johnson & Johnson and President of the USTA; Mr. Kenneth Bonham, President of the Emerson Drug Company; and Mr. Sylvester J. Liddy. Letter from Henry B. King, Secretary, USTA to Rep. Eugene J. Keogh (June 30, 1950); Letter from Rep. Eugene J. Keogh to Henry B. King, Secretary, U.S. Trademark Assoc. (July 7, 1950).

[439] *See* Letter from Joseph D. Stecher, ABA Secretary, to Rep. Emanuel Celler, House Judiciary Comm. Chairman (Mar. 21, 1950). The letter indicates that the meeting where the resolution was passed was held from February 27 through 28, 1950. *Id.*

[440] *Id.*

[441] H.R.J. Res. 27, 82d Cong. (1951).

[442] *See* George Von Gehr, *Report of the Committee on Trade-Marks*, 1951 A.B.A. SEC. PAT., TRADEMARK & COPYRIGHT L. 40 (1951).

[443] Letter from Mr. Paul Struven to Rep. Eugene J. Keogh (Oct. 28, 1953).

[444] Telephone Interview with Mr. I. Walton Bader, Esq. (Oct. 25, 2006). More specifically, the concern was that certain businesses that had long used a mark but had never registered it would be disadvantaged by such an amendment. *Id.*

second session of the Eighty-third Congress.[445] Once again, his stated purpose was to "make uniform and clear the legislative control of the Congress over trademarks generally."[446] Once again, not much happened with the amendment in committee, although it did generate some opposition from the Bar.[447]

In late 1954, Mr. Struven sent Rep. Keogh a longer memorandum than before, once again making the case for a constitutional amendment.[448] The memo was also more pointed than before, focusing on the point that current trademark law under the Lanham Act gave the mark's user only the right to registration and not the right to title ownership or use of the mark.[449] It also made clear the necessity of directly overruling the *Trade-Mark Cases* and that this was a major purpose of the amendment.[450] Noting that it had been forty years since the previous proposed amendments (1913), the memo forcefully argued for title ownership for trademarks.[451] Rep. Keogh thereafter noted that he would be happy to continue this subject in the next Congress,[452] and after that year's election had been won, Rep. Keogh checked with Mr. Struven to make sure the text of the amendment was adequate. [453] That same day, Rep. Keogh notified former congressman Fritz Lanham of Lanham Act fame of his intent to introduce the bill and asked for comments—the question of the amendment's viability would finally be raised in earnest.[454]

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[445] H.R.J. Res. 331 83d Cong. (1954). Though, even before this, Rep. Keogh "probably" planned on reintroducing the amendment. Memorandum from Rep. Eugene J. Keogh to Agnes Mathisen, Sec'y (Oct. 13, 1953).

[446] Letter from Rep. Eugene J. Keogh to Mr. H. Hume Matthews, Chairman, Legislative Committee, N.J. Patent Law Assoc. (Feb. 19, 1954) (on file with author).

[447] *See* Letter from Comm. on Trade-Marks and Copyrights of the State Bar of Tex. to the House Judiciary Comm. (May 12, 1954) (on file with author).

[448] Memorandum, *Trade-Mark Amendment to United States Constitution Needed*, from Paul Struven (undated), *enclosed with* Letter from Paul Struven to Rep. Eugene J. Keogh (Sept. 15, 1954) (on file with author).

[449] *Id.* at 1.

[450] *Id.* at 2.

[451] *Id.* at 3–4.

[452] Letter from Rep. Eugene J. Keogh to Mr. Paul Struven (Oct. 7, 1954). The letter also thanked Mr. Struven for his efforts on his behalf in the electoral campaign that year. *Id.*

[453] Letter from Rep. Eugene J. Keogh to Mr. Paul Struven (Dec. 29, 1954).

[454] Letter from Rep. Eugene J. Keogh to Mr. Fritz Lanham (Dec. 29, 1954) (on file with author).

The amendment was introduced on the first day of the Eighty-fourth Congress as House Joint Resolution 3.[455] It was referred to the House Committee on the Judiciary.[456] Shortly thereafter, Rep. Keogh asked the Chair of the Committee to request reports from the appropriate executive departments.[457] Roughly one month later, Rep. Celler assigned the bill to a subcommittee[458] and requested the reports.[459]

While the subcommittee went about its business, the USTA came out against the amendment.[460] In a resolution unanimously adopted by its executive committee, it condemned the amendment "as being contrary to the long-established principle of common law that rights in marks are acquired by use and not by registration or grant. To empower Congress to regulate the use and ownership of marks will, in our opinion result in Compulsory Federal Trademark Registration."[461] This, of course, was exactly what the amendment was meant to do. Whatever the case, it is likely that the fact of this opposition's existence was likely at least as important as the substance of the objection, and local bar associations joined in opposing the amendment.[462]

Roughly one year after this, the reports from the executive departments came back, and they were uniformly negative. The Department of State was the most mild, in large part because it limited itself to its purview of foreign policy and determined that existing constitutional provisions were adequate for reciprocal trademark treaties.[463] The Department of Commerce, by contrast, directly recommended against passage of the amendment, noting that trademark law since 1881 had been

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[455] H.R.J. Res. 3, 84th Cong. (1955).

[456] Letter from Rep. Eugene G. Keogh to Rep. Emanuel Celler, Chairman, Comm. on the Judiciary (Jan. 10, 1955) (on file with author).

[457] *Id.*

[458] Letter from Rep. Emanuel Celler, Chairman, Comm. on the Judiciary, to Rep. Eugene J. Keogh (Feb. 4, 1955) (on file with author).

[459] Letter from Rep. Eugene J. Keogh to Rep. Emanuel Celler, Chairman, Comm. on the Judiciary (Jan. 10, 1955) (on file with author).

[460] Letter from Sherwood E. Silliman, President, USTA to Rep. Eugene J. Keogh (Mar. 7, 1955) (on file with author).

[461] *Id.*

[462] Letter from the Thomas F. McWilliams, Sec'y of the Patent Law Ass'n of Chi., to the Hon. Chairman of the Comm. on the Judiciary (May 3, 1955) (on file with author).

[463] Letter from Robert C. Hill, Assistant Sec'y of State to Emanuel Celler, Chairman, Comm. on the Judiciary, Report of the Dep't of State on H.J. Res. 3 (Apr. 26, 1956) (on file with author).

based on the Commerce Clause and was adequate.[464] As such, the amendment was unnecessary, and more than that, would be harmful since it would imply that Congress had been without authority up until this point to pass trademark laws and would be antithetical to the notions of common law and federalism central to American law.[465] The Department of Justice similarly questioned the necessity of the amendment but also noted that this amendment would lead to concerns about anticompetitive behavior.[466] Noting that the Lanham Act included explicit protections against anticompetitive uses of trademarks, the Department of Justice explained that "[t]o accord trade-marks the same constitutional sanction presently given to patents and copyrights, might create an environment even more susceptible to restraint of trade and injury to the public as a whole."[467] In the face of uniform opposition, the amendment died. Rep. Keogh never introduced the amendment again, nor has anyone else introduced a similar amendment to the United States Constitution since.

In truth, the driving rationale for a constitutional amendment had died out long before the last amendment failed. By 1905, the Commerce Clause was seen as broad enough to allow for domestic trademark regulation, and the reach of the Commerce Clause would continue to expand. The law still needed to require use in interstate commerce, but that became an incredibly broad mandate. It is not difficult to imagine that without this shift in our understanding of the Constitution, an amendment would have been required to give the Lanham Act the desired force.

V. IN SEARCH OF THE *TRADE-MARK CASES*

In taking the full measure of the *Trade-Mark Cases*, the language of the holding regarding the Commerce Clause is deceiving. The decision's cramped view of the Commerce Clause

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[464] Letter from Sinclair Weeks, Sec'y of Commerce to Emaunel Celler, Chairman, Comm. on the Judiciary, Report of the Sec'y of Commerce on H.J. Res. 3 (Apr. 25, 1956). As discussed, this is not quite accurate. *See supra* text accompanying notes 423–430.

[465] *See id.*

[466] Letter from William P. Rogers, Deputy Attorney Gen. to Emanuel Cellar, Chairman, Comm. on the Judiciary, Report of the Dep't of Justice on H.J. Res. 3 (May 15, 1956).

[467] *Id.*

is a "a quaint anachronism"[468] in the wake of *Wickard v. Filburn*[469] and its many cousins, leading all the way to *Gonzalez v. Raich*,[470] but to read any broad Commerce Clause *holding* into the decision is to mistake the decision's copious dicta for a holding. When one cuts away the dicta, one arrives at a simple holding—a statute that relies on the Commerce Clause must explicitly limit itself to Congress's powers under that clause.[471] This principle has been recognized by the Supreme Court in the last decade of the twentieth century[472] and the first decade of the twenty-first,[473] and indeed, is built into the Lanham Act's explicit requirement that trademarks be used in interstate commerce to fall within its ambit. While the case may have embodied a more cramped view of the Commerce Clause in its dicta which led Congress to adopt a similarly constrained view, the Court explicitly refused to decide the question of whether such legislation could be permitted under the Commerce Clause within the proper limitation of interstate commerce.[474]

Regarding the treaty power, the Court explicitly resisted the urge to comment on the power. In turn, Congress was forced to wrestle with the issue that while it could not find the power to enact legislation to execute treaties in the Constitution's text, such a power needed to exist in order to carry out the power to make treaties. The House Committee on the Judiciary wrestled with this problem and came to a determination that produced no

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[468] Cross, *supra* note 1, at 373.

[469] 317 U.S. 111 (1942).

[470] 500 F.3d 850 (9th Cir. 2003).

[471] *See Trade-Mark Cases*, 100 U.S. 82, 97–99 (1879).

[472] United States v. Lopez, 514 U.S. 549, 561–62 (1995), *superseded by statute*, Violent Crime and Law Enforcement Act of 1994, Pub. L. No. 103-332, § 320904, *as stated in* United States v. Tucker, 90 F.3d 1135 (6th Cir. 1996).

[473] United States v. Morrison, 529 U.S. 598, 611–12 (2000).

[474] Professor Cross has argued that the decision of the Court in the *Trade-Mark Cases* established a further important holding known as the "quaint anachronism"—that congressional authority under the Commerce Clause regarding trademarks is subject to the limitations of the Commerce Clause in that it only applies to commerce among the several states. Cross, *supra* note 1, at 372–73. While the Court did hold (really more state what it felt obvious) that this is the case, this very basic holding remains good law, even if the Court in 1879 and the Court today might not agree on the details of what "commerce among the several states" means. There is no question that the clause works some limitation in theory, even if there is no actual limitation due to the breadth of some definitions of "commerce among the several states." Any language beyond that saying that commerce between two citizens of the same state does not qualify as interstate commerce is dicta, as it is not relevant to the Court's holding. *Id.*

objection from any quarter. For purposes of the treaty power, the true adjudication would be in Congress, and in that inquiry, the treaty power began to take on powers it had never assumed before, leading to *Missouri v. Holland*[475] and its progeny one generation later and to the modern era of the treaty power.

Unlike the Commerce Clause, the Court did not pull any punches regarding the Intellectual Property Clause, issuing a sweeping decision that dramatically narrowed the scope of this Clause. It is hard to argue with Professor Cross's critique that the Court's requirement of creativity has no basis in the text of the Intellectual Property Clause.[476] And yet, looking back on the *Trade-Mark Cases*, the holding that a trademark cannot fall within the coverage of the Intellectual Property Clause of the Constitution was entirely uncontroversial at the time. It does not seem that anyone took the argument under the Intellectual Property Clause seriously, and the Attorney General of the United States was embarrassed to even present it to the Supreme Court.

That the Court enshrined this popular understanding of the Intellectual Property Clause into its jurisprudence is the greatest legacy of the decision. Unlike the Commerce Clause, which has been frequently ruled on and whose meaning has been completely changed in the twentieth century, the Intellectual Property Clause was barely commented on by the courts for nearly one hundred years after the decision in the *Trade-Mark Cases*. As a result, when the issue would begin to rear its head again in this new age of the information economy, the courts were faced with only one venerable decision squarely on point, whose holding was highly favorable to a more liberal intellectual property regime. In recent years, the *Trade-Mark Cases* have come before the Supreme Court several times, most notably in *Feist Publications, Inc. v. Rural Telephone Service Co.*[477] In that case, and countless others in the lower courts, the precedent of the Supreme Court from 1879 continues to limit the extent of patent and (especially) copyright claims over a wide variety of subject matters, which does not meet the additional constitutional requirements set forth by the *Trade-Mark Cases*.

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[475] 252 U.S. 416 (1920).
[476] Cross, *supra* note 1, at 383.
[477] 499 U.S. 340 (1991).

The opinions in *Leidersdorf* and then the *Trade-Mark Cases* also helped motivate the nascent American trademark community to mobilize and organize in support of its interests. Prior to the decision in *Leidersdorf*, there existed no organization to advocate for the rights of American trademark holders. Slightly over one week after the decision in *Leidersdorf*, the USTA met for the first time, and its advocacy helped shape the 1881 Trademark law.[478] The USTA is now the International Trademark Association, and over 125 years since its founding, it remains the preeminent advocate for the rights of trademark holders.

What one finds in searching the *Trade-Mark Cases* is Congress and the courts wrestling with the confines of three powers, none of which fit neatly into the issues brought on by the advance of technology. Trademarks, of course, were nothing new, but their wide use in a world being connected by steamers, railroads, and the telegraph was. None of these powers were quite the same after 1881, but perhaps the most changed was the power the Court refused to address—the treaty power. When the Supreme Court expressed the popular wisdom regarding the Intellectual Property Clause but elided the Commerce Clause, Congress developed the treaty power into a much more powerful instrument by using it as the basis of a commercial act, which would bind domestic and foreign parties alike. In the development of these now-antiquated statutes, we find the law marching ahead and becoming its modern self.

[478] L. E. Daniels, *supra* note 411.