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FOREWORD

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How satisfying it would be to claim credit for the very idea of this symposium: *A Festschrift* for the Lanham Act on the Occasion of its Fiftieth Birthday! But in truth the credit belongs to John Christopher Carroway,¹ then the student editor in chief of *Law and Contemporary Problems*, who suggested it one day in the fall of 1994 as we brushed by each other in the Law School mail room.

Would it make sense, he wondered, to gather a few important articles on trademark and unfair competition law with the thought of publishing them in the summer of 1996 so as to coincide with the golden anniversary of the Lanham Act's passage? And would I consider acting as Special Editor of the Symposium? To which questions the answers were yes and yes, the former given easily enough, and the latter blurted out, as it were, against my better judgment, given the demands it would impose upon an already crowded schedule.

In retrospect I realize now that Chris must have counted on these responses. He had been a student in my intellectual property class the previous semester; knowing the degree to which I consider trademark and unfair competition law a fascinating but troublesome presence among the more settled IP doctrines, he could have anticipated my utter inability to resist an enterprise of such promise. Our conversation in the mail room, then, though cleverly disguised as chance encounter, was in fact no doubt a cunning ambush in the service of his own agenda at least twice over: first, to enlist the assistance of a normally wary faculty member in the necessary business of constructing yet another entry in the unending procession of symposiums the Journal's on-going business requires; and second (perhaps indeed it may have been first) to celebrate the advancing

fortunes of doctrines in which, truth to tell as I recall it, he was more approvingly invested than I.²

No matter. The symposium was a brilliant idea; Chris was right to suggest it. And though there may have been one or two moments along the way, as editorial deadlines came and went, when it seemed that the Lanham Act's diamond anniversary would offer a more realistic target date for publication than the gold, still in the end what the Journal offers here are works admirably suited to a celebration of maturity in any year.

The contributors (I exclude myself from this encomium) have been drawn from among the true luminaries in the field; the work they have produced befits their stature. Their articles have been published in an order that implicitly acknowledges certain thematic considerations. Indeed, they can be read as though they were organized explicitly into three sections, arrayed as follows.

The first section affords a theoretical and historical overview into how the field of trademarks and unfair competition has grown. In the service of this endeavor, Professor Milton Handler's valuable personal remembrance of things past³ is echoed by an updated history penned by Daniel McClure,⁴ now in practice with Fulbright & Jaworski in Houston, but in 1979, while still a student at Harvard Law School, the author of what many consider the finest short historical introduction to the subject ever written.⁵ J. Thomas McCarthy, whose extraordinary multi-volume treatise⁶ is a necessary guide to both theory and practice, has written a definitive account of the awakening of Lanham Act Section 43(a), a provision of the law which has proved to be the source of its most intriguing expansion during the first half-century of the Act's existence.⁷ Meanwhile, Professor Robert Denicola, one of two Reporters for the ALI's recently published *Restatement (Third) on Unfair Competition*,⁸ has prepared a thoughtful set of observations on the larger course of federal legislation in the field, including the Trademark Dilution Act of 1995.⁹

The second section (do please remember that the organization I suggest here is hypothetical) includes articles aimed at some more immediate challenges in practice and some doctrinal anomalies worthy of particular note. Miles

2. Carraway went on to clerk for Judge Bryson in the Federal Circuit. He is now in practice with the law firm of Michael Best & Friedrich in Milwaukee.

3. Milton Handler, *A Personal Note on Trademark and Unfair Competition Law Before the Lanham Act*, 59 LAW & CONTEMP. PROBS. 5 (Spring 1996).

4. Daniel M. McClure, *Trademarks and Competition: The Recent History*, 59 LAW & CONTEMP. PROBS. 13 (Spring 1996).

5. Daniel M. McClure, *Trademarks and Unfair Competition: A Critical History of Legal Thought*, 69 *Trademark Rep.* 305 (1979).

6. J. Thomas McCarthy, TRADEMARKS AND UNFAIR COMPETITION (3d ed. 1992).

7. J. Thomas McCarthy, *Lanham Act § 43(a): The Sleeping Giant is Now Wide Awake*, 59 LAW & CONTEMP. PROBS. 45 (Spring 1996).

8. RESTATEMENT (THIRD) OF UNFAIR COMPETITION (1995). In addition, five of the authors in this symposium (Alexander, Handler, Keller, McCarthy, and Lange) served as members of the Restatement Board of Advisers to the Reporter.

9. Robert C. Denicola, *Some Thoughts on the Dynamics of Federal Trademark Legislation and the Trademark Dilution Act of 1995*, 59 LAW & CONTEMP. PROBS. 75 (Spring 1996).

Alexander, Chairman of the firm of Kilpatrick & Stockton and next Counsel to the International Trademark Association (“INTA”), and his coauthor and Kilpatrick associate (and Duke Law graduate) Michael Heilbronner, have written closely (not for the first time¹⁰) on the implications in Lanham Act Section 43(c),¹¹ a new provision which may yet challenge Section 43(a) for supremacy as the most protean provision in the law. Bruce Keller, a member of the firm of Debevoise & Plimpton and present Counsel to the INTA, contemplates the continuing growth of advertising litigation under the Lanham Act.¹² Traci Jones, member of the Duke Law School Class of 1997, who worked closely with noted trademark practitioner and treatise writer Jerome Gilson¹³ even before entering law school and who will clerk with Justice Sandra Day O’Connor upon graduation, has written a penetrating analysis of the intent-to-use sections added to the Lanham Act by the 1988 amendments.¹⁴ And Professor Gary Myers, a member of the University of Mississippi law faculty and coauthor of a forthcoming West casebook on intellectual property,¹⁵ considers parody in trademark law from the perspective of the Supreme Court’s copyright decision in the case of *Two Live Crew*.¹⁶

Finally, in an explicit acknowledgment and critical appreciation of two valuable recent articles published elsewhere on the role the Intellectual Property Clause should play in the continuing development of trade dress law,¹⁷ I have offered some additional suggestions as to why the constitution may be newly important as a constraining force after more than two centuries of dormancy.¹⁸

The nine articles collected here cannot do entire justice to the object of our celebration, to be sure; law under the Lanham Act is too vast and too fast-moving to find its reflection in any single symposium. But these works may still suggest something of the richness of the subject matter and something as well of its importance to the larger development of intellectual property in our time.

10. See, e.g., Miles J. Alexander & Michael K. Heilbronner, *An Analysis of the Dilution Section of the Restatement (Third) of Unfair Competition*, 47 S.C. L. REV. 629 (1996).

11. Miles J. Alexander & Michael K. Heilbronner, *Dilution under Section 43(c) of the Lanham Act*, 59 *LAW & CONTEMP. PROBS.* 93 (Spring 1996).

12. Bruce P. Keller, “It Keeps Going and Going and Going”: *The Expansion of False Advertising Litigation under the Lanham Act*, 59 *LAW & CONTEMP. PROBS.* 131 (Spring 1996).

13. JEROME GILSON, *TRADEMARK PROTECTION AND PRACTICE* (1974-current).

14. Traci L. Jones, *Remedy Holes and Bottomless Rights: A Critique of the Intent-to-Use System of Trademark Registration*, 59 *LAW & CONTEMP. PROBS.* 159 (Spring 1996).

15. DAVID LANGE, MARY LAFRANCE & GARY MYERS, *CASES AND MATERIALS ON INTELLECTUAL PROPERTY* (forthcoming 1997).

16. Gary Myers, *Trademark Parody: Lessons from the Copyright Decision in Campbell v. Acuff-Rose Music, Inc.*, 59 *LAW & CONTEMP. PROBS.* 181 (Spring 1996); see *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

17. Theodore H. Davis, *Copying in the Shadow of the Constitution: The Rational Limits of Trade Dress Protection*, 80 *MINN. L. REV.* 595 (1996); Malla Pollack, *Unconstitutional Incontestability? The Intersection of the Intellectual Property and Commerce Clauses of the Constitution: Beyond a Critique of Shakespeare Co. v. Silstar Corp.*, 18 *PUGET SOUND L. REV.* 259 (1995).

18. David L. Lange, *The Intellectual Property Clause in Contemporary Trademark Law: An Appreciation of Two Recent Essays and Some Thoughts about Why We Ought to Care*, 59 *LAW & CONTEMP. PROBS.* 213 (Spring 1996).

I hope and trust that Chris Carraway will find them worthy of his original idea. I am pleased and grateful to have played a small role in their appearance here.