

A BRIEF HISTORY OF TRADEMARK LAW IN THE USA

The first Federal Trademark law was enacted after the Civil War in 1870. It came as a response to the rapid growth of trade that followed the period of Reconstruction and the need of manufacturers for trade identity and better protection from infringement. However, the law was amended in 1878, and shortly thereafter was held to be unconstitutional by the U.S. Supreme Court on grounds that it was based improperly on the Patent and Copyright Clause of the Constitution.

This led manufacturers to found the International Trademark Association (INTA) on November 21, 1878. The Association helped to expedite enactment of the Trade-Mark Act of 1881. Then, in 1898, the President of INTA, Mr. Francis Forbes, was named to head a commission to revise the statutes relating to patents and trademarks. This commission's report to Congress in 1900 made recommendations that formed the basis of the Trade-Mark Act of 1905. The Inter-American Convention of 1910 for the Protection of Industrial Property led to further changes implemented by the Trade-Mark Act of 1920.

Post World War II, economic boom fueled an explosion of trademark activity and brought about the need to educate the public about trademark law. On January 22, 1945, Congressman Fritz Lanham of Texas addressed this need by introducing a bill intended to encourage registration and protect marks from unfair competition. The bill defined a trademark as "any word, name, symbol, device or any combination thereof adopted by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others." The bill also expanded the concept of infringement, allowed for registration of service marks, provided incontestability for marks in continuous use for five years, and made federal registration of a trademark "constructive notice of the registrant's claim of ownership." The bill was signed into law by President Harry S. Truman on July 5, 1946 and became known as the Lanham Act.

The spread of television in the 1950's led to public awareness of countless products on the market, resulting in an enormous increase in the amount of trademark applications at the Patent Office and a backlog of appeals at the Patent Office. This led to the creation of the Trademark Trial and Appeal Board (TTAB) in 1958. Then, in 1962, a few minor changes were made to the Lanham Act, including the broadening of the "likelihood of confusion" test.

The Lanham Act did not expressly authorize an award of attorney's fees to prevailing parties until, in 1975, Congress amended the Act to allow for attorneys' fees in exceptional cases. That same year, the Patent Office became the Patent and Trademark Office.

After an enormous growth in Trademark counterfeiting, Congress passed the Trademark Counterfeiting Act of 1984. Remedies included new civil actions with virtually mandatory awards of treble damages and attorneys' fees. The Trademark Clarification Act was also passed in 1984 in response to the Ninth Circuit's decision in Anti-Monopoly, Inc. v. General Mills Fun Group, Inc. which held that purchaser motivation in buying a product was the crucial test in determining if a trademark was generic. The new act made it clear that the question is to be determined by the primary significance of the term to the public, not purchaser motivation.

The Trademark Law Revision Act was passed in 1988 to bring U.S. Trademark Law more in line with the global market. The Lanham Act required a mark to be used in interstate commerce before application for registration. This was not required in most countries and led to "token use" or mock shipments across state lines to meet the requirement. Under the Revision, applicants had the choice of applying on the basis of use in commerce or on the basis of a bona fide intention to use the mark in commerce in the future. Duration and renewal periods were also reduced from twenty years to ten years and filing of an application would now be considered "constructive use", subject to the mark being registered.

Congress passed the Trademark Remedy Clarification Act in 1992 to allow states and state employees to be held liable in infringement suits to the same extent as private businesses.

The Federal Trademark and Dilution Act of 1995 provides owners of famous trademarks with a federal cause of action against those who lessen the distinctiveness of such marks by the use of the same or similar trademarks on similar or dissimilar products or services. It does not require that there be a likelihood of consumer confusion.

The Anti-Counterfeiting Consumer Protection Act of 1996 allows greater involvement of law enforcement at all levels and provides stronger penalties, including civil fines based on the value of the genuine goods and statutory damage awards of up to one million dollars per mark.

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