THE LINGERING LEGACY OF *TRADE-MARK CASES*

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INTRODUCTION

More than one hundred and twenty-five years have passed since the Supreme Court's 1879 decision in *Trade-mark Cases.*[1] Despite its age, the case remains a staple of American Constitutional Law casebooks. Most casebooks admittedly treat the decision as a historical detour on the road leading to the modern, expansive interpretation of the Commerce Clause.[2] The Court in *Trade-mark Cases* interpreted Congress's powers under that clause very narrowly, concluding that nothing in the clause empowered

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1. 100 U.S. 82 (1879). In most discussions, the case is referred to as "*The* Trade-mark Cases." However, the actual caption (including the hyphenation) is that set out in the text. This Article will use the historical term.

2. U.S. CONST. art. I, § 8, cl. 2.

Congress to regulate marks used in connection with intrastate sales.[3] Within a few decades, however, the Court would reverse course, rejecting this strained interpretation and upholding a variety of federal laws under the clause even though those laws had only the most tenuous connection with commerce.[4] Thus, while *Trade-mark Cases* has not been forgotten, to most it is an odd relic representing an outdated view of the world.

Of course, *Trade-mark Cases* involved more than the Commerce Clause. Intellectual property scholars know the case as a cornerstone of the modern view of federal authority to grant patents and copyrights. And unlike its narrow view of the Commerce Clause, the Court's teachings about federal intellectual property remain vitally important today. *Trade-mark Cases* established a basic model of federal intellectual property that would prove to dictate the outcome in several important decisions rendered during the past half-century, most notably *Graham v. John Deere Co. of Kansas City*,[5] *Eldred v. Ashcroft*,[6] and especially, *Feist Publications, Inc. v. Rural Telephone Service Co*.[7]

This Article explores the legacy of *Trade-mark Cases* in the field of intellectual property law. But it explores that legacy from a somewhat unorthodox perspective; namely, by imagining what might have happened had the Court decided the case the opposite way. Opening that imaginary door reveals some interesting possibilities. At the very least, a different result in *Trade-mark Cases* would have dramatically altered the course of United States trademark law. In addition, depending on the reasoning the Court employed to reach a contrary holding, much of federal intellectual property law might look quite different than it does today.

Part I reviews the decision in *Trade-mark Cases*, together with the immediate aftermath of that decision. Although a reader familiar with the case itself might be tempted to skip this section, the discussion in this Part is useful because it discloses some interesting facts and puts the decision into a broader historical context. Part II discusses how *Trade-mark Cases* fundamentally altered the course of federal trademark law in the United States. The statute held unconstitutional in that decision was actually fairly radical, not only by the standards of the late nineteenth century, but even by today's

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3. The Court's rationale for its Commerce Clause ruling is set out *infra* text accompanying notes 27-35.

4. The Court began to reverse its position in *NLRB v. Jones & Laughlin Steel Corp.*, 301 U.S. 1 (1937) (holding that Congress can use its Commerce Clause powers to regulate collective bargaining in the steel industry), *United States v. Darby*, 312 U.S. 100 (1941) (upholding federal minimum wage laws), and *Wickard v. Filburn*, 317 U.S. 111 (1942) (upholding laws setting maximum for wheat production as applied to a purely local farm).

5. 383 U.S. 1 (1966).

6. 537 U.S. 186 (2003).

7. 499 U.S. 340 (1991).

standards. Had the Court upheld that early trademark statute, United States trademark law today might well have looked much like the law in the rest of the world, instead of being the misfit it currently is.

Part III focuses on how *Trade-mark Cases* affected the broader issue of Congress's powers under the Intellectual Property Clause.[8] The Court held in that portion of its opinion that Congress could rely on the Intellectual Property Clause to protect only novel or original creations.[9] That axiom of creativity remains the law today. The Court's reasoning is flawed, however, in at least two respects. First, even if originality is a *sine qua non* of the Intellectual Property Clause, trademark laws almost invariably satisfy that standard. Second, and more fundamentally, the structure and development of the Intellectual Property Clause demonstrate that creativity is not a constitutional requirement. Part III then applies this thinking to one current issue that has proven difficult because of the lingering legacy of *Trade-mark Cases*; namely, the notion that originality is the *sine qua non* of federal copyright law. As with Part II, Part III demonstrates that the case had a tremendous influence on the development of United States intellectual property law, even in areas outside of trademark.

I. THE *TRADE-MARK CASES* LITIGATION

A. The Decision in *Trade-mark Cases*

Trade-mark Cases arose out of the United States's first comprehensive trademark legislation. Two separate laws were actually involved. The first, enacted in 1870, was a civil statute that established a federal registration scheme and provided a private cause of action for infringement of marks registered under that scheme.[10] The second, enacted six years later, imposed criminal sanctions against those who, with the intent to defraud, infringed any marks registered under the 1870 Act.[11]

The litigation itself involved three separate criminal prosecutions under the 1876 Act. The defendants in all three cases were charged with possessing or selling counterfeit alcoholic beverages.[12] The defendants argued that the statute was unconstitutional because Congress lacked the authority to enact a general trademark law.[13] The defendants' arguments applied with

8. U.S. CONST. art. I, § 8, cl. 8.

9. The Court's discussion of the Intellectual Property Clause is discussed in more depth *infra* text accompanying notes 22-26.

10. Act of July 8, 1870, ch. 230, 16 Stat. 198 (revising, consolidating, and amending the statutes relating to patents and copyrights).

11. Act of Aug. 14, 1876, ch. 274, 19 Stat. 141 (punishing the counterfeiting of trade-mark goods and the sale or dealing in of counterfeit trade-mark goods).

12. Trade-mark Cases, 100 U.S. 82, 82-83 (1879).

13. *Id.* at 84-85.

equal force to both the criminal statute and the underlying 1870 registration statute on which the criminal law was based. The lower courts split on the question of constitutionality, and the cases were consolidated for review in the United States Supreme Court.[14]

The debate in the lower courts focused almost exclusively on whether the Intellectual Property Clause of Article I, Section 8 of the United States Constitution could serve as a source of congressional authority.[15] The Attorney General of the United States, however, opted for a new strategy in the Supreme Court, raising—apparently for the first time—the argument that the Commerce Clause of Article I, Section 8, could also give legislative jurisdiction.[16] Viewed through a modern lens, it may seem somewhat peculiar that no one prior to the Attorney General thought it worthwhile to invoke the Commerce Clause to support a trademark law. But given the circumstances at the time, it is not at all surprising. First, there is strong evidence that Congress itself thought it was relying on the Intellectual Property Clause when it enacted the new federal trademark scheme. The 1870 Act was not a separate and discrete trademark law. Instead, it was part of a large and comprehensive revision of federal patent and copyright law. The title of the statute—"An act to revise, consolidate, and amend the statutes relating to patents and copyrights"—makes no reference to trademarks. The trademark provisions are tucked into the middle of the law, and are overall a relatively small part of the total package.[17] Thus, Congress apparently thought the entire package fell within its Intellectual Property power.

Second, it would have been risky to invoke the Commerce Clause as a basis of authority. There was relatively little precedent in the 1870s defining the reach of that clause. Indeed, the Court's ruling on the Commerce Clause issue in *Trade-mark Cases* was to establish important precedent on the issue—precedent that would stand largely untouched until the Court reversed course during the New Deal. For some reason, however, the Attorney General thought it worthwhile to test the waters, and argued to the Court that the trademark law could be justified under both the Intellectual Property and Commerce Clauses.

The Supreme Court held the statute unconstitutional. Before tackling the issue of whether either the Intellectual Property Clause or the Commerce Clause could be used to sustain the statute, however, the Court made a quick comment on the nature of trademark law:

> The right to adopt and use a symbol or a device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all

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14. *Id.*
15. *Id.* at 85.
16. *Id.* at 86.
17. Act of July 8, 1870, ch. 230, §§ 77-84, 16 Stat. 198 (revising, consolidating, and amending the statutes relating to patents and copyrights).

> other persons, has been long recognized by the common law and the chancery courts of England and of this country, and by the statutes of some of the States. It is a property right for the violation of which damages may be recovered in an action at law, and the continued violation of it will be enjoined by a court of equity, with compensation for past infringement. This exclusive right was not created by the act of Congress, and does not now depend upon it for its enforcement. The whole system of trade-mark property and the civil remedies for its protection existed long anterior to that act, and have remained in full force since its passage.[18]

To the Court, establishing that the origin of trademark rights lay in state law[19] was a crucial first step. Had trademarks stemmed from federal law or the Constitution itself, Congress would ostensibly have the inherent power to regulate them, just as Congress can regulate other types of federal personal property.[20] Because trademarks originated in state law, however, Congress could regulate them only by invoking some specific grant of legislative jurisdiction:

> As the property in trade-marks and the right to their exclusive use rest on the laws of the States, and, like the great body of the rights of person and of property, depend on them for security and protection, the power of Congress to legislate on the subject, to establish the conditions on which these rights shall be enjoyed and exercised, the period of their duration, and the legal remedies for their enforcement, if such power exist[s] at all, must be found in the Constitution of the United States, which is the source of all the powers that Congress can lawfully exercise.[21]

Following this exposition of what the Court viewed as "black letter" law, the Court turned to the issue of whether the Constitution provided any authority for federal trademark law. Its opinion dealt with the Intellectual Property Clause first, probably because that was the source Congress thought most directly applied.

1. *Intellectual Property Clause*

In a passage of only a few sentences, the Court found the Intellectual Property Clause inapposite to the 1870 trademark law.[22] That clause specifically mentions two types of laws that fall within its ambit; namely, patent and copyright laws. Without specifically so stating, the Court's analysis

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18. *Trade-mark Cases*, 100 U.S. at 92.

19. It is interesting to note that the Court specified that the origin was *state* law, not some form of pre-*Erie* "general common law." Indeed, the case is one of many in the late 1800s that emphasize that a particular issue of common law was a question of state law. In some respects, the Court's later decision in *Erie* overstated the prevalence of "general common law" in the federal courts, setting up what might be deemed a sort of straw-man argument.

20. U.S. CONST. art. IV, § 3, cl. 2, provides that "Congress shall have Power to dispose of and make all needful Rules and Regulations respecting the Territory or other Property belonging to the United States."

21. *Trade-mark Cases*, 100 U.S. at 93.

22. *Id.* at 93-94.

in this section assumes that these specific references help define the scope of the general grant of authority under the Intellectual Property Clause. In other words, unless a law bears the essential hallmarks of a patent law or a copyright law, it falls without Congress's authority under the Intellectual Property Clause.

To the Court, the hallmark of patents and copyrights is *creativity*. Patents and copyrights, the Court surmised, provide protection for "the fruits of intellectual labor."[23] Measured by this standard, the Court found that the federal trademark law clearly fell short. The Court correctly noted that trademark rights can exist not only in coined words and symbols—what we would today call "fanciful" marks—but also in common words and symbols adopted by a seller as her mark.[24] Rights in trademarks exist not because of the owner's genius, but instead merely because the owner elected to use the term in connection with the sale of a particular good or service. Therefore, unlike a patentable invention, a decision to use a particular mark involves "neither originality, invention, discovery, science, nor art."[25] And although the Court acknowledged that there is a facial similarity between a word or symbol mark and a work of authorship protected by copyright, it found an important difference between the two. Copyrights, the Court reasoned, are available only when the author produces something original.[26] Borrowing an existing word or symbol as a mark, by contrast, does not involve the creation of something new. Therefore, because trademark protection could exist without regard to whether the mark itself was creative, the Court concluded that trademark law must fall outside the scope of the Intellectual Property Clause.

2. *Commerce Clause*

The Court devoted considerably more space to the Commerce Clause argument.[27] Establishing a basic approach to the Commerce Clause that would survive for approximately sixty years, the Court concluded that the trademark laws in question fell outside of Congress's Commerce Clause jurisdiction as well. The Court noted that that clause allowed Congress to act only when the specific commerce it was regulating was interstate, international, or with the Indian tribes.[28] Thus, "there still remains a very large amount of commerce, perhaps the largest, which, being trade or traffic be-

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23. *Id.* at 94 (emphasis omitted).

24. "The trade-mark may be, and generally is, the adoption of something already in existence as the distinctive symbol of the party using it." *Id.*

25. *Id.*

26. *Id.*

27. *Id.* at 94-98.

28. *Id.* at 96.

tween citizens of the same State, is beyond the control of Congress."[29] Neither the 1870 nor the 1876 trademark statutes explicitly limited their coverage to situations involving interstate, international, or tribal dealings.[30] Because the statutes would have applied to marks used solely in intrastate transactions, the Court found that they exceeded Congress's Commerce Clause jurisdiction.

In an interesting and often overlooked passage, the Court also raised some doubt about whether a trademark law would survive a Commerce Clause challenge even if it was explicitly limited to interstate, international, or tribal commerce. The Court suggested a distinction could be drawn between the regulation of commerce itself—regulation clearly authorized by the clause—and the regulation of property used in connection with commerce.[31] People do not buy marks. They instead buy the goods or services to which those marks are attached. Congress's authority over commerce, the Court noted, does not extend to regulation of the "barrels and casks, the bottles and boxes in which alone certain articles of commerce are kept . . . ."[32] To the extent that regulation of trademarks was analogous to the regulation of property used in commerce, the Court suggested, it might too fall without Congress's commerce power.[33] However, because there was a narrower basis to hold the law unconstitutional—namely, Congress's failure to restrict the statute on its face to interstate, international, and tribal commerce—the Court expressly declined to rule on the broader issue of whether any regulation of trademarks qualified as regulation of commerce.[34]

Trade-mark Cases is, of course, best known for its narrow interpretation of Congress's commerce power. It is not this author's purpose to rehash that issue, or to discuss whether the Court's modern and far more expansive definition of interstate commerce is a truer reading of the text or somehow preferable as a matter of policy. But before leaving the Commerce Clause question, consider one small observation. The Commerce Clause discussion in *Trade-mark Cases* is today largely viewed as a quaint anachronism—a reflection of the Court's failure to predict how railroads and corporations would soon establish a national economy in which the lines between local and interstate commerce would be hopelessly blurred. It cannot be denied, however, that the Court's bright-line test, allowing Congress to govern only when there is a transaction crossing state lines, is a

29. *Id.*

30. Act of July 8, 1870, ch. 230, § 77, 16 Stat. 198 (revising, consolidating, and amending the statutes relating to patents and copyrights); Act of Aug. 14, 1876, ch. 274, §§ 2-6, 19 Stat. 141 (punishing the counterfeiting of trade-mark goods and the sale or dealing in of counterfeit trade-mark goods).

31. Trade-mark Cases, 100 U.S. 82, 95 (1879).

32. *Id.*

33. *Id.*

34. *Id.*

logical way to interpret the commerce power. Indeed, the rule of *Trademark Cases* closely resembles the current rule in Canada, which, like the United States, allows Parliament to regulate interprovincial commerce.[35] The United States Supreme Court's modern view of the American provision may (or may not) be preferable as a matter of federal policy, but it is only one of several possible interpretations of the language itself.

3. *The Treaty Power as an Unexplored Alternative*

As noted above, the Attorney General's arguments in support of the federal trademark laws relied exclusively on the Intellectual Property and Commerce Clauses. Accordingly, the Court had no occasion to consider whether other constitutional grants of authority might have sustained those laws. And here lay a missed opportunity, for there was at least one other possible source of congressional power. The mid-1800s was an active period for development in trademark law throughout the industrialized world. Like the United States, many nations were adopting domestic trademark laws during this period. The United States had also entered into treaties with a number of these other nations.[36] All of these treaties obligated the United States to afford foreign trademark owners certain rights within the United States, including the right to register their marks with the federal government.

Because of these treaties, Congress arguably could have relied on its "Treaty Power" as a source of authority for both the 1870 registration law and the 1876 criminal statute. The Treaty Power enables Congress to pass laws to enforce the terms of federal treaties.[37] Although the parameters of

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35. Section 91(2) of the 1867 Constitution Act of Canada gives the Parliament the power to regulate "Trade and Commerce." PETER W. HOGG, 1 CONSTITUTIONAL LAW OF CANADA 20-1 (5th ed. 2007) (citing Constitution Act, 1867, 30 & 31 Vict. Ch. 3 (U.K.), *as reprinted in* R.S.C., No. 5 (Appendix 1985)). Although on its face not restricted to interprovincial dealings, the Privy Council quickly interpreted section 91(2) to apply only to (i) interprovincial trade, and (ii) a very narrow category of "general regulation of trade affecting the whole Dominion." *Id.* at 20-11 (citing Citizens' Insurance Co. v. Parsons, [1881] 7 App. Cas. 96, 113 (P.C.)).

36. *See, e.g.*, Convention between the United States and the Austro-Hungarian Empire, U.S.-Austria-Hung., Nov. 25, 1871, 17 Stat. 917. Similar treaties were ratified during this period with Belgium, Brazil, Denmark, France, Germany, Great Britain, Italy, Japan, Russia, Serbia, and Spain. S. REP. NO. 58-3278, at 3 (1905).

37. Nothing in the Constitution explicitly gives Congress authority to enact laws to enforce the provisions of a treaty. Indeed, the only explicit provision dealing with congressional power over treaties is Article 2, Section 2, which gives the Senate the power to *ratify* treaties negotiated by the President. Nevertheless, the Supreme Court decision in *Missouri v. Holland*, 252 U.S. 416 (1920), clearly establishes that Congress has the additional authority to enact laws to enforce treaties. This power derives from the Necessary and Proper Clause of Article I, Section 8. *Holland*, 252 U.S. at 432. That provision gives Congress the power to pass any law deemed necessary and proper to carry out other powers granted to the federal

the Treaty Power have been the subject of extensive criticism from several sources,[38] the basic power clearly exists.[39] Given the several trademark treaties in force at the time, Congress could have tried to justify the federal legislation as a law designed to carry into effect the terms of those existing treaties. Because no one had argued the issue, however, the Court specifically refused to address it.[40]

Whether the 1870 and 1876 acts would have been sustained under a treaty power argument is an interesting and by no means certain question. The treaty power ends when it encroaches on any other explicit limit on Congress's power, such as the Bill of Rights.[41] Congress's grant of trademark rights under the 1870 and 1876 trademark statutes, however, did not violate any other explicit limitations on federal authority. Therefore, as Congress was not attempting to circumvent other limitations on federal power, the treaty power would arguably have been available. However, it is unclear whether the Court, given its 1870 mindset, would have sustained the actual laws in question as provisions "necessary and proper" to carry out the treaties. The treaties in place at that time required the United States to grant certain rights to foreign trademark owners. As written, however, the 1870 Act applied with equal force to both foreign and domestic registrants. It accordingly seems likely that the Court, if faced with an argument based on

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government. Note that the authority of Article I, Section 8 applies not only to powers granted to Congress, but to any powers granted to any branch of the federal government. Therefore, because the federal government has the power to treat, the Necessary and Proper Clause gives Congress the power to pass laws intended to enforce those treaties.

38. For a good review of the various arguments, see Nicholas Quinn Rosenkranz, *Executing the Treaty Power*, 118 HARV. L. REV. 1867 (2005).

39. *Holland* explicitly establishes that Congress may rely on the treaty power to enact laws that would otherwise fall without its legislative jurisdiction. *See supra* note 37. Although *Reid v. Covert*, discussed below, recognizes an important limit on this power, it does not question this basic premise. *See infra* note 41.

40. Trade-mark Cases, 100 U.S. 82, 99 (1879).

41. In *Reid v. Covert*, 354 U.S. 1, 16-19 (1957), the Court held a federal statute enacted under the treaty power invalid because the statute violated the jury trial and grand jury rights of the affected individuals. In other words, the treaty power cannot be used by Congress to evade an explicit constitutional restriction on its authority. As the Court in *Reid* noted, however, its ruling is in no way inconsistent with *Holland*. *Holland* dealt with Congress's power to regulate migratory birds. The State of Missouri argued that Congress had no power to regulate migratory birds because regulation of wild animals was a matter reserved to the states. However, nothing in the Constitution explicitly gives states power over wildlife. Therefore, because the treaty in question did not violate any specific limitation on federal authority, it was not inconsistent with the Constitution. The situation in *Trade-mark Cases* is much like that in *Holland*. Although states certainly have the power to regulate trademarks—and indeed *had* been regulating them before Congress passed the 1870 Act—nothing in the Constitution makes trademark law a matter of *exclusive* state concern. Nor did the trademark laws violate any civil rights of the accused infringers. Although trademark laws can run afoul of the right of free speech, the right of free speech does not include the right to lie about the source of goods one is selling.

the treaty power, would nevertheless have held the statute unconstitutional under the same basic argument it employed when dealing with the Commerce Clause. In other words, just as a law must (in the Court's opinion) be expressly limited to the enumerated categories of commerce in order to fit within the commerce power, so too must a law be limited to foreign applicants—the only parties protected by the treaty—to fall within the treaty power. Although this limited view of the treaty power is no longer valid today, it would have fit perfectly into the Court's limited view of federal legislative power.

B. The Aftermath of the Decision

The holding in *Trade-mark Cases* struck down both the 1870 registration provisions and the 1876 criminal statute.[42] This result left the United States without a federal trademark law, and accordingly in violation of its treaty obligations. Congress acted quickly to remedy this situation. Several legislators proposed a constitutional amendment to grant Congress the specific authority to enact federal trademark legislation.[43] Although this proposal apparently gained some purchase at first, Congress eventually opted for a less drastic alternative. In 1881, it adopted a greatly circumscribed version of the prior law. The 1881 Trademark Act applied only to marks that were actually used in foreign commerce or commerce with the Indian tribes[44]—marks used in interstate commerce were no longer included.

The legislative history for the 1881 statute demonstrates that Congress took the Court's opinion in *Trade-mark Cases* quite seriously. Although the Court had expressly reserved judgment on the issue, Congress concluded that the interstate commerce power did not cover the regulation of trademarks, even under a law limited to marks used in interstate commerce.[45] Marks were a mere "convenience of commerce," and though they might indicate the source of a good sold in commerce, they were not *themselves* the subject of purchase or sale.[46] Because marks were not a necessary inci-

42. The Attorney General argued that the statute should be upheld insofar as it applied to transactions involving interstate commerce. However, the Court declined to limit the statute in this fashion, indicating that it had no way of knowing whether Congress would be content with a system that allowed for federal protection of interstate and international marks, while leaving intrastate marks with less protection. *Trade-mark Cases*, 100 U.S. at 98.

43. H.R. REP. NO. 46-561, at 5 (1880). The proposal would have added the following as the Sixteenth Amendment: "Congress, for promotion of trade and manufacture, and to carry into effect international treaties, shall have the power to grant, protect, and regulate the exclusive right to adopt and use trade-marks." *Id.*

44. Act of Mar. 3, 1881, ch. 138, 21 Stat. 502 (authorizing the registration of trademarks and protecting same).

45. H.R. REP. NO. 46-561, at 5.

46. *Id.*

dent of commerce, regulation of marks did not fall within the Commerce Power. This narrow interpretation of the meaning of commerce was to prove quite resilient; Congress would not extend federal registration to trademarks used in interstate commerce until 1905.[47]

On the other hand, Congress did in the 1881 Act conclude that it had the authority to regulate marks used in *foreign* commerce and commerce with the Indian tribes. Legislative jurisdiction over these categories of marks, the House Report indicates, stems from the *treaty* power, not from the Commerce Clause.[48] Given that the United States had existing treaties with both foreign nations and tribes, Congress concluded that a federal law protecting trademarks used in foreign and tribal commerce was "necessary and proper" to effect these treaty obligations. Of course, because international and tribal trade comprised a fairly small portion of total commerce, this limitation greatly reduced the reach of federal trademark law.

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The immediate impact of the ruling in *Trade-mark Cases* is obvious—it set back, for over twenty-five years, the adoption of a federal trademark system for domestic marks, and quite possibly delayed the realization of Congress's full Commerce Clause power for an even longer period. If that were its only effect, however, the case would be little more than an asterisk in the annals of constitutional history. In reality, the case had several other important effects, leaving a significant legacy in the field of intellectual property law. These effects remain with us even today; subtle but important shadings of the American view of intellectual property. *Trade-mark Cases* affects not only how we view trademarks, but also establishes core principles of other forms of intellectual property.

The remainder of this Article explores the long-term implications of *Trade-mark Cases*. Part II explores how the law today might have been different had the Court upheld the 1870 and 1876 statutes. Part III explores how the Court's underlying principles create a certain paradigm of intellectual property law that pervades United States intellectual property law even today.

II. THE LEGACY OF *TRADE-MARK CASES* IN TRADEMARK LAW

Understanding how *Trade-mark Cases* fundamentally shaped the development of United States trademark law requires a closer look at the ac-

47. Act of Feb. 20, 1905, ch. 592, 33 Stat. 724 (authorizing the registration of trademarks used in commerce with foreign nations or among the several States or with Indian tribes, and protecting the same). Section 1 of this act extends federal protection to marks used in interstate commerce. *Id.* § 1.

48. H.R. REP. NO. 46-561, at 6.

tual statute at issue in that case. Like all federal trademark laws since, the 1870 law allowed marks to be registered in a federal registry.[49] Although a national registry is quite useful, there was nothing terribly radical about that aspect of the law. But a careful reading of the provisions governing *when* a party could register a mark reveals a more revolutionary concept. Under state law as it existed at the time (and still exists today), a party could not claim legal protection for a mark unless he actually *used* the mark in connection with the sale of goods or services. The 1870 Act, by contrast, allowed those "who *intend* to adopt and use any trade-mark for exclusive use within the United States" to register the mark with the federal government.[50] Another provision of the Act allowed a registrant to sue for infringement without any showing of actual use.[51]

In light of these explicit provisions, the Court's previously quoted statement about the nature of trademark law seems somewhat curious.[52] The Court suggested that *state* law creates the basic trademark right, while Congress merely facilitates protection of that state-law right by providing a federal registry for state-law marks. In truth, however, it seems that Congress intended something completely different; namely, federal trademark rights existed and could be enforced *without regard to rights based on use under state law*. To put it simply, Congress meant to allow for federal trademarks.

The Court's misreading of the 1870 Act continues to shape trademark law today. Consider the Court's focus on use. The principle that use is a precondition to trademark rights is today deemed one of the defining features of United States trademark law. That rule unfortunately also creates a great divide between the United States and much of the rest of the world. Most other nations allow a party to obtain rights in a mark simply by registering that mark, regardless of whether the mark is used.[53] This difference has caused significant problems for the United States under the Paris Con-

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49. Act of July 8, 1870, ch. 230, § 77, 16 Stat. 198 (revising, consolidating, and amending the statutes relating to patents and copyrights).

50. *Id*. This conclusion is underscored by a later clause in the same section providing that an applicant must indicate "[t]he length of time, *if any*, during which the trade-mark has been used." *Id*. (emphasis added).

51. *Id.* § 79.

52. *See supra* text accompanying note 18.

53. For a recent list of use requirements in many nations, see INT'L TRADEMARK ASS'N, EMERGING ISSUES COMM., USE-BASED SYS. SUBCOMM., REPORT AND RECOMMENDATION: USE-RELATED REQUIREMENTS FOR ISSUANCE AND MAINTENANCE OF TRADEMARK REGISTRATIONS, app. C (2005). According to this report, only Argentina, Canada, Indonesia, Mexico, the Philippines, and the United States require that the mark be used before obtaining rights. *Id.* Moreover, in Argentina, Indonesia, and Mexico, a showing of use is required only for *renewal* of a registration, not for the initial registration. *Id.*

vention[54] and other international treaties affecting trademarks.[55] In response, Congress adopted a compromise solution in 1988, amending the trademark laws to allow a party to file an application for a trademark merely by asserting an intention to use the mark.[56] In other words, it took Congress almost 120 years to restore the basic "intent to use" concept set out in the 1870 Act. And in fact, in some ways the current regime does not go as far as the 1870 Act. For example, while the 1870 Act allowed a registrant to sue based on registration alone, without regard to use,[57] the current law requires a party to use a mark before he can sue for infringement.[58] *Trade-mark Cases* accordingly set back certain crucial aspects of United States trademark law by well over a century. It also ensured that the United States would be an outcast, while the industrialized nations were trying to implement international recognition of foreign marks. The United States's reluctance to abandon its use-based rules has significantly hindered attempts to create such a regime.

The Court's error in *Trade-mark Cases* also left a second legacy in United States trademark law involving the question of the legal source of basic trademark rights. The Court's opinion proceeded from the premise that trademark rights were at their core creatures of *state* law.[59] State law defined what could be protected as a mark, and determined who owned the mark. Federal law merely served to provide a national registration system and a federal cause of action for infringement.

This basic notion that United States trademark law is a hybrid of rights stemming from state law dominates our thinking even today. Unlike the patent and copyright statutes, the federal trademark statute contains no explicit rules governing key concepts. For example, nothing in the statute

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54. Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, as last revised July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305, *available at* http://www.wipo.int-/treaties/en/ip/paris/pdf/trtdocs_wo020.pdf.

55. For other major treaties that have affected trademarks, see Madrid Agreement Concerning the International Registration of Marks of Apr. 14, 1891 (as amended Sept. 28, 1979), *available at* http://www.wipo.int/madrid/en/legal_texts/trtdocs_wo015.html; Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, June 20, 1989, *available at* http://www.wipo.int/madrid/en/legal_texts/pdf/madrid_protocol.pdf; and the Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, 1869 U.N.T.S. 299, *available at* http://www.wto.org/english/docs_e/legal_e/27-trips.pdf.

56. Trademark Law Revision Act of 1988, Pub. L. No. 100-667 (the intent-to-use provisions are codified as amended at 15 U.S.C. § 1051(b)).

57. Act of July 8, 1870, ch. 230, § 79, 16 Stat. 198 (revising, consolidating, and amending the statutes relating to patents and copyrights). Of course, if the party had not yet used the mark, damages would be minimal.

58. 15 U.S.C. § 1114 allows a party to sue for infringement of a registered mark. Under 15 U.S.C. § 1051(d), however, filing the intent-to-use application does not itself result in registration. Instead, an applicant must file an actual affidavit of use within a designated period of time in order to receive a registration. Thus, use is still required before a party obtains enforceable rights.

59. *See supra* discussion at text accompanying notes 18-21.

defines who qualifies as the "owner" of a mark, even though the statute makes use of that term in several places. Similarly, although the statute lists a number of objections to a mark—such as the fact that a mark is scandalous[60] or consists of any nation's flag or coat of arms[61]—those objections are technically only objections to *registering* the mark on the principal register, not objections to a mark's underlying validity and enforceability.[62] Section 43(a), which creates a cause of action for infringement of unregistered marks, follows the same basic pattern.[63] Indeed, nothing in that section specifies that only a *senior* user is entitled to recover when there are competing uses of similar marks. Courts nevertheless assume that only senior users may sue because only senior users have rights under state trademark law. Viewed literally, then, the Lanham Act borrows from external law—usually state law—to determine such key issues as whether a mark is valid and protected, and who owns rights in the mark.[64]

But this paradigm of a hybrid trademark law ignores reality. In truth, courts do not "look to" state law in any meaningful sense when dealing with questions of validity and ownership. Instead, they look to some form of *national* law to resolve these issues.[65] Virtually all of the precedent cited is from the federal courts, without regard to the law of the state in which the federal court sits. There is little doubt, for example, that the Court's rulings in cases like *TrafFix Devices, Inc. v. Marketing Displays, Inc.*[66] and *Wal-*

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60. 15 U.S.C. § 1052(a) (2000).

61. 15 U.S.C. § 1052(b) (2000).

62. The introductory language to § 1052 provides: "No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration . . . ." 15 U.S.C. § 1052. Moreover, some of the leading United States Supreme Court decisions dealing with questions of trademark validity technically deal only with whether the mark can be registered, not whether it is enforceable at common law. *See, e.g.*, Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159 (1995) (framing the issue as whether the Lanham Act "permits the registration" of color).

63. 15 U.S.C. § 1125(a) (2000).

64. *See* Jamie K. Neal, *Federal Trademark Protection: Rebutting the Myth That a Trademark Must Stem From a Pre-existing State Common-Law Right*, 38 BRANDEIS L.J. 597 (2000).

65. *Id.* at 611 (suggesting that the underlying law is federal common law—more precisely, the federal common law that results when a court fills the interstices in a federal statute). On the other hand, the governing law could be some form of "super-state" law—a general law whose particular terms do not necessarily incorporate the provisions of local state law. *Id.* This latter view certainly receives some support by analogy to copyright law, where the courts do not always use state law when filling in the gaps in the statute. *See, e.g.*, Cmty. for Creative Non-Violence v. Reid, 490 U.S. 730 (1989) (looking to the "general law" of agency rather than a particular state law when defining "employer," "employee," and "scope of employment").

66. 532 U.S. 23 (2001) (holding that trademark law does not protect a product feature if that feature was previously protected by a utility patent).

Mart Stores, Inc. v. Samara Bros., Inc.[67] apply to all claims under the Lanham Act seeking to protect product design as a mark, even if state law might actually provide to the contrary. In addition, although parties almost always assert state claims in conjunction with their claims under the Lanham Act, the federal courts typically pay short shrift to these claims, either finding it unnecessary to rule on them, or simply concluding that the law governing the state claim is the same as that governing the Lanham Act claim.[68] Even state courts dealing with state-law claims assume that the state rule is the same as the federal rule.[69] Thus, there really is no longer any meaningful state law governing basic issues in trademark law. The Lanham Act has become much more than a federal registration system for state law marks. The Act itself, augmented by the significant judicial gloss defining trademarks and ownership thereof, is effectively *the* national law of trademarks. Even if the basic paradigm of trademark law envisioned in *Trade-mark Cases* was once the law, it no longer reflects the actual state of things.

III. LEGACY OF *TRADE-MARK CASES* FOR INTELLECTUAL PROPERTY LAW

The legacy of *Trade-mark Cases* is not limited to trademark—the decision also established a particular view of the proper role for federal intellectual property protection. That view, which continues even today, has influenced several watershed decisions dealing not only with trademark law, but also with patent and copyright law.

This part of the case's legacy stems from the Court's brief discussion of Congress's powers under the Intellectual Property Clause.[70] To the Court, the core requirement of that Clause was some form of "creativity." In arriving at this conclusion, the Court pointed out that the Clause specifically mentions both copyright and patent. However, the Court did not assume that the Clause authorized *only* these two forms of intellectual property rights. Instead, it was willing to consider whether Congress might also use the Clause to enact trademark laws. Even with this open-minded approach, the Court nevertheless concluded that the specific enumeration of patents and copyrights in the Clause was a key to interpreting the full scope

67. 529 U.S. 205 (2000) (holding that a product design cannot be protected as a trademark without a showing of secondary meaning).

68. Twentieth Century Fox Film Corp. v. Dastar Corp., No. CV98-07189FMC(EX), 2003 WL 22669587 (C.D. Cal. Oct. 14, 2003) (rejecting a claim for reverse passing off under the Lanham Act for failing to give credit for a film, finding that state law was essentially parallel to the Lanham Act).

69. *See, e.g.*, Mid S. Bldg. Supply of Md., Inc. v. Guardian Door & Window, Inc., 847 A.2d 463 (Md. Ct. Spec. App. 2004) (treating claims under both the Lanham Act and state law by using the same legal principles).

70. Trade-mark Cases, 100 U.S. 82, 93-94 (1879).

of the Clause. According to the language of the Intellectual Property Clause, patents are available for discoveries.[71] The term "discovery," of course, connotes a sense of "newness." Reading the entire Intellectual Property Clause *in pari materia*, the Court concluded that the Clause's specific enumeration of "Writings" as the proper subject of copyright included a similar requirement of newness.[72] In short, the Court concluded that Congress could invoke its power under the Intellectual Property Clause only when the object of protection was the result of some degree of creativity. Therefore, if trademarks were to be grounded in the Intellectual Property Clause, they would be available only in cases where the holder exhibited a level of creativity akin to that required for patent or copyright. Because the 1870 trademark law (like all trademark laws) allowed protection even when the party had borrowed an existing word or symbol created by another as its mark, the statute failed to satisfy the constitutional mandate of creativity.[73]

This reasoning is vulnerable to two separate lines of attack. First, the Court demonstrated a profound lack of understanding of the nature of trademarks—a mistake that later courts would admittedly repeat again and again. Contrary to the Court's conclusion, the adoption of a successful trademark actually *does* involve a significant amount of creativity, and therefore could easily satisfy the Court's own standard for applying the Intellectual Property Clause. Take the situation that bothered the Court—that is, where a party borrows an existing word as a mark for its goods or services, e.g., APPLE for computers or FOUNDATION for legal publishing services. True, the adopter would exercise little of "the creative powers of the mind"[74] in adopting that word or symbol. But selecting the mark is only a first step. If the adopter proceeds to use that term in connection with its product, consumers will soon realize that all goods or services bearing the selected mark come from the same source. Once they realize that, they can make use of the source's reputation to obtain additional information about the product, such as information about quality or post-sale service.[75] In essence, then, a party who borrows an existing word as a trademark does "create" something—the party's adoption and use of the mark *helps to create a new meaning for the existing word*, a meaning that applies only in the context of the goods or services sold using the mark.[76] The trademark adopter's

71. *Id.* at 93.

72. *Id.* at 94.

73. *Id.*

74. *Id.*

75. Although this sort of information is most valuable when the source has already developed a reputation, it also exists for the new entrant into the market. As soon as consumers buy, or even examine, the goods of the seller, they can begin to form an opinion as to the quality of those goods, thereby forming the seller's reputation.

76. The discussion in the text even applies to "descriptive" marks—that is, terms that describe some feature of the commodity. Trademark law allows descriptive words to be

act of creating this new meaning for an existing term is more than enough to satisfy any "creativity" requirement that might be imposed by Article I, Section 8. Therefore, if one understands how trademarks really work, it would be quite easy to fit trademark laws within the scope of the Intellectual Property Clause. Trademark laws involve creativity regardless of whether they grant protection for actual use or are based on mere adoption with intent to use.[77]

Moreover, using a trademark to send a new message satisfies another key limitation imposed by the Intellectual Property Clause. That clause does not allow Congress to grant patents and copyrights for any reason. Instead, the Clause requires that any grant of intellectual property rights be done in order "[t]o promote the Progress of Science and useful Arts . . . ."[78] Patent and copyright laws, at least in their current form, readily satisfy this requirement. However, trademark laws would satisfy this standard as well. As noted above, the use of trademarks conveys information to consumers about the product or service they have encountered in the market. Information about products or services certainly fits with the form of general knowledge inherent in the constitutional term "Science." Indeed, if product information were not within the scope of the Clause, consumer-oriented publications like *Consumer Reports* would not qualify for copyright.

The second line of attack on the reasoning in *Trade-mark Cases* is even more fundamental. The Court's entire discussion of Congress's Intellectual Property Clause power stems from one core premise: that "creativity" is the thread that ties the entire Clause together. That principle has become a mantra, which the Court now employs as a litmus test to determine compliance with the Clause. Later United States Supreme Court decisions—most notably *Graham v. John Deere Co.*[79] in the realm of patents, and *Feist Publications, Inc. v. Rural Telephone Service Co.*[80] and *Eldred v. Ashcroft*[81] in the realm of copyright—rely heavily on this concept of creativity when evaluating whether a particular exercise of congressional power falls within the scope of the Clause. *Feist* waxes perhaps most eloquent in this regard, referring to originality as, alternatively, the "*sine qua non*" of

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protected as trademarks if they acquire secondary meaning. 15 U.S.C. § 1052(f) (2000). In truth, secondary meaning is a *change* in the primary meaning of the term in a particular context. A seller who adopts and uses a descriptive mark is therefore beginning the process of redefining the meaning of that term.

77. An intent-to-use application must list the goods on which the applicant intends to use the mark. 15 U.S.C. § 1051(b)(2) (2000). Given that the allowance of the application is a public record, filing an intent-to-use application begins the creative act of defining or—in the case of an existing term—redefining the term.

78. U.S. CONST. art. I, § 8, cl. 8.

79. 383 U.S. 1 (1966).

80. 499 U.S. 340 (1991).

81. 537 U.S. 186 (2003).

copyright,[82] the "touchstone" of copyright protection,[83] and a "bedrock principle" of copyright.[84]

But this mantra ignores a rather inconvenient fact; namely, that neither creativity nor any synonym to that term appears anywhere in Article I, Section 8. Some notion of creativity is probably inherent in the patent side of the Clause, which speaks in terms of giving rights to "inventors" for their "discoveries." Both of these terms incorporate notions of novelty and creativity. However, on the copyright side, the picture is far less clear. All Article I actually tells us about copyrights is that they are granted to "authors" for their "writings." Neither of these terms necessarily incorporates originality. Admittedly, the romantic concept of the author that flourished during the nineteenth century equated authorship with heightened creativity, but there is no indication that the Constitution itself incorporated that concept. Viewed literally, and without the baggage of nineteenth century romanticism, an author is simply the person who happens to produce a writing. In addition, the very first Copyright Act contains evidence that Congress did not interpret the Intellectual Property Clause as requiring that the work be original. First, that statute granted copyrights in books, maps, and charts.[85] While books could be original, there is very little original, romantic authorship inherent in a map or chart. Second, both the original 1790 copyright law and the 1870 revision granted copyright not only to authors, but also to proprietors.[86] Even if there is some element of originality in authorship, there is nothing original in being a proprietor.

Thus, nothing in the text of the Constitution itself supports the Court's conclusion that originality is a requirement for the grant of a copyright.[87] Nor does anything in the meager legislative history behind the Clause support that conclusion. Although it may make sense as a matter of policy to grant exclusive rights only to authors who produce something new, there may be situations in which Congress might choose to grant a copyright to

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82. *Feist*, 499 U.S. at 345.

83. *Id.* at 347.

84. *Id.*

85. Copyright Act of 1790, ch.15, § 1, 1 Stat. 124.

86. *Id.*; Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198 (revising, consolidating, and amending the statutes relating to patents and copyrights).

87. Exactly why the Court seized on originality is not clear. The decision may simply have been a product of its time. *Trade-mark Cases* followed closely on the heels of the eighteenth-century development of the ideal of the romantic author. In addition, a philosophy touting the benefits of newness may have had double significance in a place like the United States, since the United States in the 1800s was still expanding. The future lay on the "frontier." Justice Miller, the author of the opinion in *Trade-mark Cases*, was the first Justice appointed from west of the Mississippi River, which of course lay close to the "frontier." During this period, progress was therefore inexorably tied to a notion of newness. These background influences may well have colored the Court's reading of the constitutional text.

non-original writings,[88] and it is arguably authorized to do so under the Intellectual Property Clause.

If originality is not the *sine qua non* of copyright, however, then what limits are there on Congress's ability to grant monopolies in books, music, and the arts to anyone who produces a "writing?"[89] The answer lies in the text of the Constitution itself. The Intellectual Property Clause is generally viewed today as a provision giving Congress the power to grant patents and copyrights. As Professor Walterscheid has convincingly demonstrated, however, that reading ignores both the language and the history surrounding that clause.[90] Consider the Intellectual Property Clause in context. All of the other grants of authority in Article I, Section 8, share a similar structure—that is, they give Congress the power to do something, e.g., "[t]o borrow Money on the credit of the United States,"[91] or "[t]o establish Post Of-

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88. This conclusion is admittedly at odds with those of a number of other well-regarded scholars. For example, Professors Heald and Sherry argue in their excellent and thought-provoking work on the Intellectual Property Clause that the Clause incorporates both a "Quid Pro Quo" and an "Authorship" principle. Paul J. Heald & Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress*, 2000 U. ILL. L. REV. 1119. Under both of these principles, copyrights can be granted only when the author produces an original work. However, this argument proceeds from an unproven assumption—that is, that the only acceptable "quo" that authors can provide is an "original" work (as that term is used in *Feist*). However, if the goal of the Intellectual Property Clause is to augment knowledge, an author could satisfy the quid pro quo in other ways, such as by agreeing to *disseminate* works—whether hers or others—to society. Professor Heald and Sherry's "Authorship Principle" is inextricably intertwined with the Quid Pro Quo principle. Certainly the Intellectual Property Clause does limit copyrights to authors. Again, however, the bald term authorship does not necessarily imply originality. It gains that gloss only when it is tied to the notion that the author must trade something to society in return for the exclusive rights associated with a copyright. Once it is recognized that the dissemination of non-original works may also augment knowledge—and thereby qualify as an adequate tradeoff—authorship loses its ties to originality. A scribe who correctly records another's idea and transmits it to society benefits society at least as much as the person who thought up the idea. Professor Walterscheid likewise concludes that originality is required by the Intellectual Property Clause, although he bases this on a textual argument. In his excellent book exploring the meaning of the Intellectual Property Clause, he notes that the linchpin of the Clause is the requirement that any act taken by Congress must serve the goal of promoting the "Progress of Science" (with Science equating to the level of knowledge). Because unoriginal works, he argues, do nothing to advance the state of knowledge, an author can only be rewarded if she produces something original. EDWARD C. WALTERSCHEID, THE NATURE OF THE INTELLECTUAL PROPERTY CLAUSE: A STUDY IN HISTORICAL PERSPECTIVE 387 (2002). That conclusion does not follow, however, since an author may advance knowledge either by writing down and disseminating her own ideas, or by recording and disseminating existing, as of yet undispersed, ideas.

89. The requirement of a "writing" comes from the text of the Intellectual Property Clause. U.S. CONST. art. I, § 8, cl. 8. Although any such monopoly would have to be for a limited time, *Eldred* reminds us that a term of life of the author plus seventy years does not even approach the outer limits of that requirement.

90. WALTERSCHEID, *supra* note 88, at 4.

91. U.S. CONST. art. I, § 8, cl. 2.

fices and post Roads."[92] Read without the baggage of judicial interpretation, the Intellectual Property Clause shares the same structure—it gives Congress the power "to Promote the progress of Science and useful Arts . . . ." Thus, a literal reading of the Intellectual Property Clause suggests that it authorizes Congress to enact any measure designed to further the level of society's knowledge. The two specific means listed in the Clause—patents and copyrights—are merely two examples of ways in which Congress could choose to effect the broader goal of promoting knowledge and learning.[93] But other means are also possible. For example, Professor Walterscheid notes that part of the debate surrounding the Intellectual Property Clause was whether Congress should have the authority to establish a National University.[94] A broader reading of the Clause indicates that Congress clearly has that power. And yet, establishing a university is not original, at least as that term is used in cases like *Feist*. Using similar reasoning, even if one agrees that some "borrowed" trademarks are not original, Congress would still have the power to protect them under the Intellectual Property Clause.[95]

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92. *Id.* cl. 7.

93. WALTERSCHEID, *supra* note 88, at 4. Professor Walterscheid also has a convincing explanation for why the Framers chose to include the arguably redundant language specifically authorizing patents and copyrights. Given the disdain for monopolies of the period, and the tendency to treat intellectual property rights as a form of monopoly, the Framers deemed it necessary to make a specific reference to patents and copyrights to ensure that any grant of these rights would not be struck down under general antimonopoly principles. *Id.* at 90-91.

94. *Id.* at 173-74.

95. If trademark laws were enacted under the Intellectual Property Clause, the "limited Times" restriction of that clause could become an issue. However, it is not clear that the same restriction would apply to trademarks. As discussed in the text, patents and copyrights are particular means—but not the exclusive means—by which Congress can achieve the goal of furthering the progress of knowledge. The Constitution requires certain limits, including that the protection be for limited times. However, this does not mean that other laws designed to further knowledge would necessarily be subject to that same limitation. Under this reasoning, whether trademark laws would be subject to the limited times restriction turns on how closely they resemble patent and copyright laws. The key to patent and copyright is that they provide a form of exclusivity. Because of the fear of monopolies, the Constitution allows for this exclusivity, but only for a limited time. Trademark laws also provide exclusivity, although a much more limited form than patent and copyright. A person who "owns" a certain mark cannot always prevent others from using even the same mark. Instead, he can prevent others from using the mark only in situations where that use is likely either to confuse consumers or to cause dilution of the mark. Because the exclusivity associated with trademark protection is more limited, it would not necessarily be subject to the limited times requirement. Assuming for the sake of argument that the limited times restriction did apply, a trademark law enacted under the Intellectual Property Clause would need to incorporate a time limitation. Although a trademark registration is limited in time, that registration can generally be renewed for as long as a party can claim trademark protection. In addition, trademark protection usually exists for as long as a party continues to use a mark. Although "life of the author" is an indefinite term, it is by nature limited. Therefore, a trademark law

In short, then, originality is not the touchstone of the Intellectual Property Clause. Instead, the Clause gives Congress broad authority to further the level of knowledge. That general goal includes the power to grant copyrights in even non-original works, *provided that such a grant would further progress in knowledge*. Admittedly, granting exclusive rights in preexisting learning will often fail to meet this requirement. In some cases, however, a copyright would add to the level of knowledge.

This reasoning suggests that at least one of the Supreme Court's post-*Trade-mark Cases* opinions is incorrect—at least as a matter of constitutional law. In *Feist*, the Supreme Court held that a phone book white pages could not qualify for copyright because the collecting, sorting, and printing of subscriber information involved nothing original. But if "furthering knowledge" rather than originality is the Article I, Section 8 lodestar, the case comes out differently. The information contained in a telephone directory certainly adds to the storehouse of human knowledge. Giving a monopoly to the party that compiled that information creates a financial incentive for people to undertake such useful acts. In addition, since the party compiling the information was also the "author" of the "writing" (the directory), it would fall within the Article I grant of power for Congress to give that party a monopoly. Thus, telephone directories and other forms of databases are merely a few of the many types of non-original information that can be constitutionally protected by copyright.[96]

CONCLUSION

To paraphrase the author Mark Twain, the rumors of the death of *Trade-mark Cases* are greatly exaggerated. Admittedly, the decision has no lingering impact on the Commerce Clause. However, *Trade-mark Cases* has a continuing and powerful legacy in the realm of intellectual property law. First, the decision set back federal trademark law by over a century. In the law the Court struck down, Congress had established a non-use based registration system, which is the norm in the rest of the world. The Court's rejection of this system, coupled with its insistence that substantive trademark rights come from state law rather than federal law, created a chasm

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enacted under the Intellectual Property Clause might have to provide protection for only a limited time. After that time expired, the party could still claim protection under state law.

96. The discussion in the text focuses only on whether Article I, Section 8, gives the power. Even if Congress has that power, it is still bound by the First Amendment, including the Free Speech Clause. Some efforts to provide monopolies in speech might run afoul of that limitation. For example, consider a law that gives only one person the power to discuss Einstein's theory of relativity. That law would certainly further knowledge, as it ensures that the theory will be taught accurately. However, such a law would also present serious free speech issues.

between the United States and other nations that has not been fully spanned even today.

Second, the Court erred when it held that trademark protection fell without Congress's powers under the Intellectual Property Clause because trademarks were not necessarily original. Even if originality is required by that clause, adoption of a trademark *does* involve originality, regardless of whether the adopter coined a new word or symbol, or borrowed a well-known term. More fundamentally, the Court's insistence on originality unduly limited Congress's powers under the Intellectual Property Clause. Although originality may be required for the issuance of patents, nothing in the text or the background of the Clause indicates that it is required for copyrights or other forms of protection that Congress may decide to enact in order to promote the progress of human knowledge. The Court's narrow reading has prevented Congress from relying on the Clause as the source of authority for matters such as database protection. Thus, rather than the naïve but irrelevant decision that it is usually portrayed to be in Constitutional Law casebooks, *Trade-mark Cases* continues to guide the course of intellectual property law, for now and for the foreseeable future. Its somewhat misguided legacy remains with us to this day.