

THE "USE IN COMMERCE" REQUIREMENT FOR TRADEMARK REGISTRATION AFTER LARRY HARMON PICTURES

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A. Introduction

In order to obtain the maximum protection available from federal trademark law, a trademark owner must register the mark with the United States Patent and Trademark Office (PTO) per the requirements of 15 U.S.C.S. § § 1051 et seq. (1991), commonly known as the Lanham Act. Included in the registration application requirements is "a verified statement that the mark is in use in commerce." [n.1] Along with this statement, the applicant must specify the date the mark was first used in commerce, or the applicant must have a bona fide intention to use the mark in commerce. [n.2] Since the enactment of the Lanham Act in 1947, a recurring issue with federal trademark registration is what constitutes "use in commerce."

At first glance, this issue may seem superficial. Section 45 of the Lanham Act defines "commerce" as it is used in the statute as follows: "The word 'commerce' means all commerce which may lawfully be regulated by Congress." [n.3] The extent to which Congress may lawfully regulate commerce is defined in the U.S. Constitution: "Congress shall have Power. . . . To regulate Commerce with foreign Nations, and *328 among the several States." [n.4] While it appears as though the Lanham Act requirement mirrors the commerce clause of the Constitution, the PTO has historically not viewed it this way. The PTO's conflicting interpretation of the commerce requirement for trademark registration has created an issue which places PTO decisions in contrast to Constitutional law cases.

However, the PTO's interpretation of what constitutes interstate commerce is not arbitrary. It has an historical foundation that supports a reasonable policy position. Similarly, the interstate commerce doctrine as developed through the courts is well settled and should arguably apply to trademark law. This conflict in policies and principles was addressed recently by the U.S. Court of Appeals for the Federal Circuit (CAFC) in *Larry Harmon Pictures Corp. v. The Williams Restaurant Corp.*, [n.5] which denied an opposition to the application for registration of the defendant's trademark based solely on the issue of whether the commerce requirement was satisfied. This article will discuss the decision and the commerce requirement from an historical context and with respect to the conflicting viewpoints that shape the issue.

B. The Interstate Commerce Doctrine

The first interpretation of the word "commerce" in the Constitution's commerce clause came from the Supreme Court in 1824 in *Gibbons v. Ogden*. [n.6] In that case, the court held that New York could not regulate steamship services that traveled between states because the commerce clause grants Congress the exclusive power to regulate trade among the states and trade that affects the states generally, i.e. interstate commerce. The modern expansion of Congress' control over interstate commerce began with the Supreme Court's response to the many New Deal programs and regulations of the 1930's. In *A.L.A. Schechter Poultry Corp. v. U.S.*, [n.7] the court struck down federal regulatory control over local chicken markets because the commerce clause required a "close and substantial" relationship with interstate commerce. [n.8] However, one year later the court changed its course (without overruling *Schechter*) in *329 *National Labor Relations Board v. Jones and Laughlin Steel Corp.* [n.9] giving Congress the power to enact "all appropriate legislation" for the protection and advancement of interstate commerce. [n.10]

The extent to which Congress could control activities that indirectly affected interstate commerce was enhanced in 1941 in *U.S. v. Darby* [n.11] which held that Congress may regulate any activity that has a substantial impact on interstate commerce even if it is not a direct impact. This new rule was tested to its logical extreme one year later in *Wickard v. Filburn* [n.12] in which the Supreme Court held that wheat grown for personal use can be federally regulated because it removes a customer from the interstate wheat market. This rule is known as the "drop in the bucket" doctrine, i.e. a small, indirect effect on interstate commerce is within the commerce clause as long as the cumulative effects impact commerce.

In 1964 the interstate commerce doctrine was fully extended to empower Congress to regulate all aspects of commerce, independent of motive, as long as the regulation was constitutional. In two cases decided concurrently, *Heart of Atlanta Motel, Inc. v. U.S.* [n.13] and *Katzenbach v. McClung*, [n.14] the Supreme Court allowed Congress to use the commerce clause to address social wrongs. In *Heart of Atlanta*, a single motel located on interstate highways in Atlanta was found to impact interstate commerce because it served customers from out of state. However, in *Katzenbach*, a small diner in Birmingham, Alabama, which admittedly served no out of state customers, was also found to impact interstate commerce because a substantial portion of the food which it served had moved in interstate commerce. At this point it is clear that Congress has unquestioned power to further any constitutional goal via the commerce clause. As the court put it in *Heart of Atlanta*, "if it is interstate commerce that feels the pinch, it does not matter how local the operation which applies the squeeze." [n.15]

*330 C. Application of the Interstate Commerce Doctrine to Trademark Registration

The requirement for use in interstate commerce in federal trademark law traces its roots back to the first act providing for federal trademark registration passed in 1870. That legislation provided that "[a]ny person or firm domiciled in the United States. . . may by registration obtain protection for his trade-mark." [n.16] There was no requirement that the trademark be used in the kind of commerce which Congress could regulate. In the so called Trademark Cases [n.17] of 1879, the Supreme Court found that the sole constitutional source of Congress' power to regulate trademarks is the commerce clause, therefore the 1870 trademark law was unconstitutional because it failed to limit the scope of trademark regulation to those used in interstate commerce. [n.18] The court found that "there still remains a very large amount of commerce, perhaps the largest, which. . . is beyond the control of commerce." [n.19] While this may no longer be true, the case has never been overturned. Subsequent trademark legislation, most notably the Lanham Act of 1946, was expressly limited to those marks used in commerce that the Constitution grants Congress the power to regulate.

When the Lanham Act requires "use in commerce" for federal trademark registration, it expressly includes all commerce which Congress may lawfully regulate. [n.20] However, judicial attempts to interpret the Lanham Act's scope of regulation over interstate commerce has resulted in inconsistent and confusing applications. Ten years after the Lanham Act took effect in 1947, the U.S. Court of Customs and Patent Appeals (CCPA) in *Application of Bookbinder's Restaurant* [n.21] decided that a single restaurant in Philadelphia was not involved in interstate commerce within the meaning of the Act. The court in *Bookbinder's* *331 acknowledged that "commerce" referred to that which Congress can lawfully regulate, but it based its decision only on the *Schechter Poultry* case decided 20 years prior. Federal registration was denied because no direct effect on interstate commerce by the single restaurant in Philadelphia was found. A federal district court, using the same analysis four months later in *Peter Pan Restaurants v. Peter Pan Diner*, [n.22] denied injunctive relief against a single restaurant in Rhode Island because it did not engage in interstate commerce, even though it was "located on a main highway." [n.23]

These holdings are unexpected because they both fail to consider interstate commerce cases decided since *Schechter Poultry* that established the plenary powers of Congress to control almost all aspects of commerce in the United States. *U.S. v. Darby and Wickard v. Filburn*, decided in 1941 and 1942 respectively, established that Congress could regulate activities that had even minor and indirect effects on interstate commerce. Given these findings, it would not seem unusual for a court to find that the restaurant in *Peter Pan*, located on a highway in a state only 35 miles wide, had at least a small, indirect effect on interstate commerce. Instead, these cases are only typical of the independent interpretation of the commerce clause seen in trademark cases until most recently.

The CCPA made a weak attempt to undermine this trend in *Application of Gastown, Inc.*, [n.24] a 1964 case in which the court held that a chain of service stations on federal highways in Ohio were engaging in interstate commerce. This holding, which reversed the PTO Trademark Trial and Appeal Board (TTAB), was based on distinguishing the specific facts from those in *Bookbinder's*. However, just before the close of the opinion,

the court said it was mindful that "it would seem that in the Lanham Trade Mark Act of 1946, the Congress intended to regulate interstate and foreign commerce to the full extent of its constitutional powers." [n.25]

In 1975, in *In re Cook, United, Inc.*, [n.26] the TTAB found that the ruling in *Gastown* had "drastically changed" the Lanham Act's "in commerce" requirement. [n.27] Characterizing this area of law as "vague and indefinite," *332 it proceeded to hold that a sausage retailer within a few miles of a state border that had many out of state customers was not engaged in interstate commerce for the purposes of registering its trademark. [n.28] Of course, the PTO's position in *In re Cook* was especially remarkable given the Supreme Court's decisions in *Heart of Atlanta* and *Katzenbach* which had been law for 11 years. If the Supreme Court was willing to find that a single restaurant that served no out of state customers dealt in interstate commerce, the PTO's finding that a retailer with out of state customers does not engage in interstate commerce means that the PTO was operating under a different standard.

Two years after *In re Cook*, the CCPA responded in *Matter of Application of Silenus Wines, Inc.*, [n.29] and this time it was more direct in its admonition of the PTO:

On its face, the Lanham Act provides a clear and unambiguous definition of federal trademark jurisdiction in terms of general Constitutional law as interpreted by the Supreme Court. . . . However, the Patent and Trademark Office has historically taken the position that statements made at the hearings on the Lanham Act contradict and overshadow this statutory definition of commerce. . . . [The PTO] stated that "commerce" did not cover intrastate transactions regardless of affect on interstate and foreign commerce. . . . We reject the PTO position. [n.30]

The TTAB challenged the application of these cases to the Lanham Act (and the CCPA's remarks in *Silenus Wines*) one year later in *In re U.S. Home Corp. of Texas* [n.31] in which it found that advertising a home building service on interstate highways is not interstate commerce as required in the Lanham Act for trademark registration. To arrive at this holding, the court first found that the Supreme Court's interpretation of the commerce clause only applied to "acts of social legislation" and not strictly economic statutes like the Lanham Act. [n.32] This incredible notion was supported by *U.S. v. American Building Maintenance *333 Ind.*, [n.33] a 1975 Supreme Court case which held that "the phrase 'in commerce' does not, of course, necessarily have a uniform meaning whenever used by Congress." [n.34] Although it was the Clayton Act, [n.35] not the Lanham Act, in which the Supreme Court found that "Congress retained the narrower 'in commerce' formulation," this case gave the PTO an open door to interpret the Lanham Act's commerce clause in its favor. [n.36]

However, as of March of 1991, the new US Court of Appeals, Federal Circuit (CAFC), the successor to the CCPA, has had the latest word. In *Larry Harmon Pictures Corp. v. The Williams Restaurant Corp.*, the court reaffirms *Gastown* and *Silenus Wines* by finding that "the definition of commerce in the Lanham Act means exactly what the statute says, i.e. 'all commerce which may lawfully be regulated by Congress.'" [n.37] Ironically (but perhaps not coincidentally), the facts in this case are nearly identical to

those in *Bookbinders* and *Peter Pan*, except here the court holds that a single restaurant 50 minutes from Memphis must be found to be engaged in interstate commerce to be consistent with the Supreme Court in *Heart of Atlanta* and *Katzenbach*. As done in prior CCPA cases, the CAFC supports its conclusion by distinguishing contrary cases and invoking *stare decisis* when applicable. However, there is no question that the new court plans to interpret the plain language of the statute in concert with the contemporary view of the commerce clause. The court strengthens this position by noting that " t his court does not have the power to narrow or restrict the unambiguous language of the statute." [n.38] Perhaps by using a case that implicitly overrules the old restaurant cases that initiated the separate interpretations, the relatively new CAFC is taking a firm stand that they, unlike the former CCPA, will not allow any interpretation of "in commerce" in the Lanham Act that is inconsistent with that of the Supreme Court's interpretation.

D. The CAFC vs. the PTO

The PTO's insistence on a limited interpretation of what constitutes interstate commerce for the purposes of trademark registration is neither arbitrary, a case of nonacquiescence, nor based on mere arrogance. Judge *334 Newman's lengthy dissent in *Larry Harmon Pictures* acknowledges and discusses much of the foundation for the PTO's position. Nevertheless, it is a dissenting opinion. The majority opinion squarely rejects the PTO's position in favor of strict adherence to the Supreme Court's interpretation of the commerce clause when applied to federal trademark registration.

1. Case Precedents

First, Judge Newman points out in her dissent in *Larry Harmon Pictures* that there is no reason to depart from the "balances, safeguards, and reasoned jurisprudence" that have been developed by case law. [n.39] Referring to the extent of interstate commerce that satisfies the Lanham Act requirements, Judge Newman notes that " a useful body of decisional law has developed, providing legal analysis and guidance in the context of statutory intent and public policy." [n.40] She then goes on to cite the string of cases on this issue discussed above and offers cases that find no interstate commerce as precedent (e.g. *Bookbinder's*) while she distinguishes contrary cases on their facts (e.g. *Gastown*).

At the same time, however, the majority was able to factually distinguish the cases on which the dissent relied and vice versa, which illustrates the emptiness of this argument. There is ample case law to support either position, so the existence of judicial precedence does not by itself support an otherwise unprincipled position. The conflicting use of prior decisions by the majority and dissent in *Larry Harmon Pictures* is typical of the line of cases that preceded it. These cases attempt to draw some line, based only on facts, between when an activity is and is not engaged in interstate commerce so as to qualify for federal trademark registration. This line is inherently inconsistent and confusing and is much more difficult to determine than that chosen by the Supreme Court to determine whether an activity is subject to regulation. While the PTO is forced to distinguish minor

facts such as distance from state lines, access to highways, number of shops, extent of advertising, etc., the Supreme Court shies away from any judicial interpretation of the commerce clause and grants plenary power to Congress as long as the Act is rational and constitutional.

Oddly, the PTO's own "rule book," the Trademark Manual of Examination Procedure, instructs examining attorneys to follow the Supreme Court's guidelines. The manual states that "the scope of Federal trademark jurisdiction is all commerce which may lawfully be *335 regulated by Congress," then goes on to cite CCPA and TTAB decisions which found sufficient commerce to satisfy the requirement. [n.41] None of the TTAB opinions which favored the restrictive view are cited. This is consistent with the notion that it's easier for an administrative agency to rely on the Supreme Court's interpretation of "incommerce" than to develop an independent one built on a weak foundation of inconsistent case law.

2. Statutory Purpose

The second argument for the PTO's position is that a broad definition of interstate commerce is simply inconsistent with the purposes of the Lanham Act and that the statutory use of "in commerce" is not inherently identical to that which regulates Congress' control of commerce by the Constitution. Judge Newman argues:

These are different issues, and the issue of applicability of the Lanham Act turns on whether Congress intended to authorize nation-wide registration of the service marks of local restaurants when Congress used the phrase 'service. . . rendered in commerce'; not whether it has the power to do so under the Constitution. [n.42]

She then repeats the reasoning that is the basis for the finding in U.S. Home Corp. of Texas, i.e. the Supreme Court in U.S. v. American Building allows different interpretations of the phrase "in commerce," and because the Lanham Act is not social legislation, Heart of Atlanta and Katze nbach need not be followed. Judge Newman believes the court in U.S. Home Corp. "correctly held" that the Supreme Court's interpretation of "in commerce" does not apply to the Lanham Act. [n.43]

This argument is obviously rejected by the majority in Larry Harmon Pictures. The CAFC ruled that "the Lanham Act by its terms extends to all commerce which Congress may regulate. This court does not have the power to narrow or restrict the unambiguous language of the statute." [n.44] Clearly, the majority declines to extend to the Lanham Act the application of American Building, which held that "commerce" as used in the Clayton Act need not parallel the scope of the Constitution's commerce clause. While not articulated in the opinion, this finding is solidly based on the wording of the individual statutes. While the Lanham Act simply defines commerce as "all commerce which may *336 lawfully be regulated by Congress," [n.45] the Clayton Act offers this awkward definition:

"Commerce" as used herein, means trade or commerce among the several States and with foreign nations, or between the District of Columbia or any Territory of the United

States and any State, Territory or foreign nation, or between any insular possession or other places under the jurisdiction of the United States, or between any such possession or place and any State or Territory of the United States or the District of Columbia or any foreign nation, or within the District of Columbia or any Territory or any insular possession or other place under the jurisdiction of the United States: Provided, That nothing in this Act contained shall apply to the Philippine Islands. [n.46]

The focus of the Clayton Act's definition is on which jurisdictions must be involved, which roughly parallels the structure of the Constitutional definition. It is not difficult to understand why the Supreme Court in *American Building* was willing to find this definition a substitution for the Constitution's because of its similar phraseology. Conversely, there is no such similarity to the Lanham Act's definition of commerce. The Lanham Act, unlike the Clayton Act, does not attempt to redefine what "use in commerce" entails, but merely incorporates that which Congress has the power to regulate as provided by the Constitution as interpreted by the Supreme Court. Quite simply, the holding in *Home Corp. of Texas* is erroneous because the reasoning in *American Building* cannot apply to the Lanham Act given the differences in the definitions included in each statute.

3. Legislative History

In her third point of support for the PTO's position, Judge Newman relies on the legislative history of the Lanham Act to show that the intended scope of the commerce requirement was not that which resulted once the law was finally passed. The first of the series of bills introduced to amend and codify the trademark laws was introduced in early 1938 by a subcommittee chaired by Representative Lanham. According to the Senate Report, "many hours of time were devoted to the perfecting of this legislation. . . [and] various committees studied and debated the various bills and presented their conclusions for official consideration at various times" as noted in a House Report in November, 1941. However, numerous understandable deferments and delays followed, pushing final passage of the new trademark law to 1946. During this interval, *U.S. v. Darby* and *Wickard v. Filburn* were decided and the *337 scope of the phrase "in commerce" was greatly enhanced. Arguably, the scope of the Lanham Act as written and intended in 1938 was not that which resulted when the legislation finally passed. Judge Newman in her dissent in *Larry Harmon Pictures* alludes to this argument when she cites legislative history as another the basis for her position. She quotes an exchange between Senator Claude Pepper of the Subcommittee of the Senate Committee on Patents with a witness from the Federal Trade Commission that the Lanham Act will "only apply to commerce among the States." [n.47]

Legislative history is often used to support a proffered opinion because there is almost always some language in the record that supports almost any position of original intent. This is also precisely why legislative history provides only weak support at best. Referring to what was to become the Lanham Act's definition of "commerce," the following conclusions were made:

Mr. MARTIN: [. . .]

In view of that language there can be no question that the intent of this act is to regulate trade-marks insofar as Congress has the power to do so.

Now, to add a [proposed] second sentence to protect registered marks used in such commerce from interference by State and Territorial legislation does not add a thing because the intent shows congress has intended to exercise all the power it has.

Mr. LANHAM: It could not be any more than surplusage. [n.48]

In an article on the status of this issue after *Silenus Wines*, Carol V. Calhoun reviews uncited legislative history and concludes:

If Congress had wished to exclude "Mom and Pop" stores [entirely intrastate businesses], it could have retained the language of the 1905 Act, which restricted registration to marks used in interstate or foreign commerce, or commerce with the Indian tribes. That it did not indicates that it was not acting to exclude local commerce, but rather to include all trademark which it could legally regulate. [n.49]

The same article reflects on the relative value of legislative history on this subject: "The legislative history of a statute should not be considered unless the language of the statute is unclear, and the statute here is *338 perfectly clear. Even if the legislative history is considered, at worst it is ambiguous, and at best it supports an expansive definition of 'commerce.'" [n.50]

4. State Trademark Law

The final basis for the PTO's position, alluded to in the closing paragraphs of Judge Newman's dissent, is that State trademark law is designed to fill the void left by a restrictive view of the use in commerce requirement. Most states have statutes that in some form supplement or duplicate some aspects of federal trademark law. While these statutes are mostly founded on laws created before federal preemption, there is also a body of state common law that is still used to interpret and apply trademark law in the state courts. The perceived function of state trademark law was mentioned in Judge Newman's dissent: "The Lanham Act does not and need not apply to predominately local services. The state trademark registrations of fifty states are designed for this purpose." [n.51] Thus, in their interpretation of the scope of the Lanham Act, the PTO relies on an active and modern body of trademark law in each state to accommodate those trademarks that do not qualify for federal registration.

However, case law has weakened the rights granted by State trademark law so that federal registration all but preempts state registration. [n.52] In *Burger King of Florida, Inc. v. Hoots*, [n.53] a local restaurant unaffiliated with the national Burger King franchises registered its "Burger King" mark on the Illinois trademark register. Subsequently, Burger King, Inc. registered a similar mark on the federal register and proceeded to expand into Illinois. When the local restaurant also attempted to expand within Illinois, with the assumption that its trademark was protected within the state by the state registration, Burger King, Inc. sued in federal court for infringement of its

federally registered mark. Despite the fact that the Illinois company had registered its mark first, albeit under state law, the court held that "Congress intended the Lanham Act to afford nationwide protection to federally- registered marks, and that once the certificate had issued, no person can acquire any additional rights superior to those obtained by *339 the federal registrant. [n.54] At this point, the only value of the state registration was to protect use of the mark where there was offsetting prior use of the mark. [n.55] Two years later, in Application of Beatrice Foods, Co., [n.56] the CCPA clarified its position on the overriding importance of obtaining federal registration: " I t would be illogical and inconsistent with the objectives of the Lanham Act, not to provide for nationwide coverage where there is more than one registration" [n.57] Because of the minimal protection offered by a state trademark registration against a prior or subsequent federal registration, even a small, intrastate trademark owner requires the advantages granted by federal registration. To insist that federal trademark law must be supplemented by state law is to interfere with the preemptive force of the Lanham Act and the case law that interprets it.

5. Public Policy

Beyond the arguments against the PTO's position, a broad interpretation of the commerce requirement for federal trademark registration is supported by public policy arguments. First, as observed by Calhoun in her article on Silenus Wines, the PTO is unlikely to be flooded with registration applications from small, mostly intrastate, "Mom and Pop" businesses. Trademark owners such as these usually have no reason to be concerned about out of state infringement, and would probably do little to challenge a geographically remote trademark use due to the improbability of confusion. Given the cost of a prior use search and federal registration, few of the businesses the PTO would otherwise deny will find a justification for the trouble and expense. Of course, those that have a legitimate need for such protection should be able to take advantage of federal registration rather than be rejected for only historical reasons.

Second, following a less restrictive interpretation of the use in commerce requirement would be good policy for the PTO. The trademark owner's existing burden of proving that their product "affects" or is "in" interstate commerce requires an otherwise unnecessary use of both the applicant's and the PTO's time and money. The cumbersome and unnatural factual distinctions made by the PTO as to whether a specific *340 business meets its test for use in commerce is inherently less efficient than following the broad brush approach of the Supreme Court. As Calhoun exclaimed, "the expenditure of so much effort by trademark owners, their attorneys, and the Patent and Trademark Office, in order to screen out the few cases of purely local commerce, is the height of administrative inefficiency." [n.58]

Finally, some commentators see this ruling as the precursor to a simplification of the Lanham Act that would unequivocally allow federal jurisdiction over all trademark registrations. In a year-end summary of significant cases in trademark law, Anthony L. Fletcher and David J. Kera conclude their review of Larry Harmon Pictures as follows:

[P]erhaps the time has come to recognize that virtually all commercial activity has interstate implications so that it may now be constitutionally possible to amend the Act to provide for the registration of any mark that is used for products or for services without worrying about whether the use falls within the increasingly broad interpretation of what is use in commerce. [n.59]

Given the Lanham Act's broad definition of "commerce," such an amendment may not actually be necessary, but the comment indicates that there is some need for a simplification of the "use in commerce" requirement for trademark registration. General recognition of the principles underlying the finding in *Larry Harmon Pictures*, combined with the practical need for a workable concept of scope of the Lanham Act, may finally end the debate over the meaning of the commerce requirement in favor of the CAFC.

E. Conclusion

It remains to be seen whether *Larry Harmon Pictures Corp. v. The Williams Restaurant Corp.* is only the latest salvo in the conflict between the Patent and Trademark Office and the courts that review its decisions, or whether the case settles the proper role of the "use in commerce" requirement for federal trademark registration. While the courts have maintained that a literal reading of the Lanham Act requires an interpretation consistent with the Supreme Court's interstate commerce doctrine, the PTO continues to find many businesses that are otherwise subject to federal regulation purely intrastate businesses for the purposes of trademark law.

It is clear from the TTAB cases and the pro-PTO dissent in *Larry Harmon* that the single underlying basis for the PTO position is *341 historical. The PTO offers prior case law, Congress' original intent, documented legislative history, and state trademark law as evidence that this administrative agency is justified in preserving its historical interpretation of what constitutes interstate commerce. However, the reviewing courts have been able to counter these arguments with case law and legislative history that supports a more modern-approach to determining which activities can be regulated by the trademark statute.

Even if the PTO's historical perspective is accurate, it is not necessarily appropriate nor correct for modern applications. As times and technologies change, so do the attitudes and needs of the law. While a state based trademark system may have been reasonable and even intended when the Lanham Act was passed in 1946, the increasingly federalist regulatory environment that has developed since then requires a different approach. Fortunately, the words of the Lanham Act in its definition of "commerce" expressly allow for such an approach. Thus, given the latest case on the issue of use in commerce required for trademark registration, not only is the PTO's perspective no longer appropriate nor correct, it is no longer the law.

[n.a1]. Peter C. Christensen and Teresa C. Tucker are Juris Doctor candidates at Franklin Pierce Law Center in Concord, NH. The authors would like to thank Thomas G. Field, Jr., Professor of Law at Franklin Pierce Law Center, for the insight and encouragement required to complete this paper. (c) 1992 Peter C. Christensen and Teresa C. Tucker.

[n.1]. 15 U.S.C.S. § 1051(d) (1991).

[n.2]. 15 U.S.C.S. § 1051(a), (b) (1991).

[n.3]. 15 U.S.C.S. § 1127 (1991).

[n.4]. U.S. Const. art. I, § 8, cl. 3.

[n.5]. 929 F.2d 662, 18 U.S.P.Q.2d (BNA) 1292 (Fed. Cir.1991), cert. denied, 60 USLW 3258 (1991).

[n.6]. 22 U.S. (9 Wheat.) 1, 6 L.Ed. 23 (1824).

[n.7]. 295 U.S. 495, 55 S.Ct. 837, 79 L.Ed. 1570 (1935).

[n.8]. *Schechter Poultry*, 295 U.S. at 544, 55 S.Ct. at 849, 79 L.Ed. at 1588.

[n.9]. 301 U.S. 1, 57 S.Ct. 615, 81 L.Ed. 893 (1937).

[n.10]. *Jones and Laughlin*, 301 U.S. at 37, 57 S.Ct. at 624, 81 L.Ed. at 911.

[n.11]. 312 U.S. 100, 61 S.Ct. 451, 85 L.Ed. 609 (1941).

[n.12]. 317 U.S. 111, 63 S.Ct. 82, 87 L.Ed. 122 (1942).

[n.13]. 379 U.S. 241, 85 S.Ct. 348, 13 L.Ed.2d 258 (1964).

[n.14]. 379 U.S. 294, 85 S.Ct. 377, 13 L.Ed.2d 290 (1964).

[n.15]. Heart of Atlanta, 379 U.S. at 258, 85 S.Ct. at 358, 13 L.Ed.2d at 269.

[n.16]. An Act to Revise, Consolidate and Amend the Statutes Relating to Patents and Copyrights, § § 77-84, 16 Stat. 198 (1870), quoted in Trademark Cases, 100 U.S. 82, 97, 25 L.Ed. 550, 553 (1879).

[n.17]. The Trademark Cases are U.S. v. Steffens, U.S. v. Wittemann, and U.S. v. Johnson, 100 U.S. 82, 25 L.Ed. 550 (1879).

[n.18]. The other constitutional foundation for the trademark legislation considered by the court was Article I, Section 8, Clause 8, "to promote the progress of science and the useful arts." U.S. Const. art. I, § 8, cl. 8. This clause, considered the foundation of patent and copyright law, was rejected as a source of Congressional control of trademarks.

[n.19]. Trademark Cases, 100 U.S. at 96, 25 L.Ed. at 552.

[n.20]. 15 U.S.C.S. § 1127 (1991).

[n.21]. 240 F.2d 365, 112 U.S.P.Q. (BNA) 326 (C.C.P.A. 1957).

[n.22]. 150 F.Supp. 534, 113 U.S.P.Q. (BNA) 481 (D.R.I. 1957).

[n.23]. Peter Pan, 150 F.Supp. at 536, 113 U.S.P.Q. at 483.

[n.24]. 326 F.2d 780, 140 U.S.P.Q. (BNA) 216 (C.C.P.A. 1964).

[n.25]. Gastown, 326 F.2d at 784, 140 U.S.P.Q. at 218.

[n.26]. 188 U.S.P.Q. (BNA) 284 (T.T.A.B. 1975).

[n.27]. Cook, 188 U.S.P.Q. at 286.

[n.28]. Cook, 188 U.S.P. Q. at 287. This finding was partially based on the fact that the retailer did not fall under the jurisdiction of the Federal Meat Inspection Act, 21 U.S.C.S. § § 601 et seq. (1984), which regulates animal products that are "either in interstate or foreign commerce or substantially affect such commerce." 21 U.S.C.S. § 602 (1984). To prevent the TTAB from appearing to hold an anomalous position, it found no commerce under the Lanham Act. However, regardless of the validity of this argument, the applicability of the Meat Inspection Act is not dispositive. Because the court could have still held the other way in spite of how the Meat Inspection Act was enforced, the issue of the applicability of the Lanham Act remains.

[n.29]. 557 F.2d 806, 194 U.S.P.Q. (BNA) 261 (C.C.P.A. 1977).

[n.30]. Silenus Wines, 557 F.2d at 810-811, 194 U.S.P.Q. at 265-266 (emphasis added).

[n.31]. 199 U.S.P.Q. (BNA) 698 (T.T.A.B. 1978).

[n.32]. Home Corp., 199 U.S.P.Q. at 701.

[n.33]. 22 U.S. 271, 95 S.Ct. 2150, 45 L.Ed. 177 (1975).

[n.34]. American Building, 422 U.S. at 277, 95 S.Ct. at 2155, 45 L.Ed. at 184.

[n.35]. 15 U.S.C.S. § § 12-27 (1991).

[n.36]. American Building, 422 U.S. at 281, 95 S.Ct. at 2156, 45 L.Ed. at 186.

[n.37]. Larry Harmon Pictures, 929 F.2d at 666, 18 U.S.P.Q.2d at 1295.

[n.38]. Id.

[n.39]. Id., 929 F.2d at 667, 18 U.S.P.Q.2d at 1296.

[n.40]. *Id.*

[n.41]. T.M.E.P. § 1202.01 (1991).

[n.42]. *Larry Harmon Pictures*, 929 F.2d at 668, 18 U.S.P.Q.2d at 1297.

[n.43]. *Id.*

[n.44]. *Id.*, 929 F.2d at 666, 18 U.S.P.Q.2d at 1295.

[n.45]. 15 U.S.C.S. § 1127 (1991).

[n.46]. 15 U.S.C.S. § 12 (1991).

[n.47]. *The Lanham Act: Hearings on H.R. 82 Before a Subcomm. of the Senate Comm. on Patents, 78th Cong., 2d Sess. 133 (1944)* cited in *Larry Harmon Pictures*, 929 F.2d at 669, 18 U.S.P.Q.2d at 1298.

[n.48]. *The Lanham Act: Hearings on H.R. 102, H.R. 5461, and S. 895 Before the Subcomm. on Trademarks of the House Comm. on Patents, 77th Cong., 1st Sess. 124-129 (1941)* reprinted in 4 Jerome Gilson, *Trademark Protection and Practice* § 45-20 (1991) [emphasis added].

[n.49]. Carol V. Calhoun, *Use in Commerce After Silenus: What Does it Mean?*, 70 TMR 47, 56, (1980) [emphasis added].

[n.50]. *Id.*, 70 TMR at 55.

[n.51]. *Larry Harmon Pictures*, 929 F.2d at 670, 18 U.S.P.Q.2d at -----.

[n.52]. The federal preemption of state trademark law may also have a statutory foundation in 15 U.S.C.S. § 1121(b) (1991), given an appropriately broad interpretation.

[n.53]. 403 F.2d 904, 159 U.S.P.Q. 707 (7th Cir.1968).

[n.54]. Burger King, 403 F.2d at 908, 159 U.S.P.Q. at 709.

[n.55]. However, common law trademark rights provide this protection as well, resulting in arguably no advantage in obtaining state trademark registration. See Dawn Donut Co. v. Harts Food Stores, Inc., 267 F.2d 358, 121 U.S.P.Q. (BNA) 430 (2nd Cir.1959).

[n.56]. 429 F.2d 466, 166 U.S.P.Q. 431 (CCPA 1970).

[n.57]. Beatrice Foods, 429 F.2d at 473, 166 U.S.P.Q. at 436.

[n.58]. Calhoun, *supra* note 49, at 57.

[n.59]. Anthony L. Fletcher and David J. Kera, The Forty-Fourth Year of Administration of the Lanham Trademark Act of 1946, 81 TMR 601, 687 (1991).