

INTRODUCTION

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The Lanham Act, passed in 1946 after nearly a decade of enactment effort, will reach its sixtieth anniversary in less than two years.¹ The Lanham Act's transformation of the law of trademarks and unfair competition in the United States was followed in 1949 by *Law and Contemporary Problems'* symposium issue, *Trade-Marks in Transition*.² The issue's twelve authors, many of whom were instrumental in bringing the Lanham Act to fruition, contemplated the many futures, possibilities, and hazards of the modern era inaugurated by the Act.³

In this tradition, the *Houston Law Review* and the Institute for Intellectual Property & Information Law (IPIL) at the University of Houston Law Center (UHLC) are proud to present a group of current-day luminaries of the law of trademarks and unfair competition at a time when the law is undergoing transformation. The 2004 IPIL/Houston Santa Fe Conference: *Trademark in Transition*, which was held in early June 2004, brought together six leading commentators in the field. Their

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1. Lanham Act, Pub. L. No. 79-489, 60 Stat. 427 (1946) (codified as amended at 15 U.S.C. §§ 1051-1127 (2000)). See generally Edward S. Rogers, *The Lanham Act and the Social Function of Trade-Marks*, 14 LAW & CONTEMP. PROBS. 173 (1949) (describing the enactment history of the Lanham Act).

2. Symposium, *Trade-Marks in Transition*, 14 LAW & CONTEMP. PROBS. 171 (1949).

3. *Id.*

commentary and analysis during the conference and in the resulting articles in this issue of the *Houston Law Review* shed important light on today's trademark law and its affiliated questions of doctrine and policy.

The forces currently reshaping trademark are well-recognized. They include the emergence of the dilution right; the development of markets for marks and brands as products in and of themselves; the contorting influence of computer and communications technology, best exemplified by the Internet, on both policy and doctrine; and the ever-increasing internationalization of commerce and intellectual property law. While this list is perhaps conventional, what is unusual about *Trademark in Transition*, like its kindred symposium from fifty-five years ago, is the stature of the contributors. Both then and now, the law of trademarks stood at a juncture formed by various forces. Both then and now, an elite group of commentators gauged the implications.

In this spirit, the foreword to the *Law and Contemporary Problems'* symposium issue still resonates today:

To the casual observer, a trade-mark infringement suit is a "private dispute between hucksters," involving the public welfare only in the sense that the public has an interest in rudimentary commercial honesty and in preventing the deception of consumers through one trader's "passing off" his goods as those of another. To many specialists in trade-mark law and to some economists it has seemed that much more is involved: the struggle to gain increasingly comprehensive and effective protection for trade symbols has been pictured as one to secure the very bulwarks of competition.⁴

Mark-supported competition has no doubt changed since these words were written in 1949. Its mode, scope, and reach reflect technological progression, heightened business complexity, and greater internationalization. Even so, today's issues parallel those lurking when the Lanham Act debuted. The articles in this issue illustrate the parallel effect and the timeless importance of the law of trademarks.

In *Proving a Trademark Has Been Diluted: Theories or Facts?*, Professor J. Thomas McCarthy articulates optimal proof requirements for the dilution right that entered federal trademark law in 1995 with the Federal Trademark Dilution Act

4. Brainerd Currie, *Foreword*, 14 LAW & CONTEMP. PROBS. 171, 171 (1949) (footnotes omitted).

(FTDA).⁵ Focusing on the “blurring” form of dilution in the wake of the Supreme Court’s first pronouncements about the dilution right in *Moseley v. V Secret Catalogue, Inc.*,⁶ Professor McCarthy notes the possibility of legislative response to the *Moseley* case and crafts his argument to address either the current statute or the most likely legislative response.⁷ Moreover, his paper provides a comparative international perspective for the dilution right. His international focus signals a trend: several of the conference papers treat trademark and unfair competition issues from an international perspective.

While an international perspective is one way to find greater context, Professor William M. Landes’s contribution to the Santa Fe Conference provides another. In *An Empirical Analysis of Intellectual Property Litigation: Some Preliminary Results*, Professor Landes analyzes decades of intellectual property litigation, dicing the data among patent, copyright, and trademark cases and correlating it through an economic model to several measures that might influence the frequency and characteristics of intellectual property litigation. His analysis provides an invaluable comparison of trademark litigation activity and civil litigation activity generally, and other intellectual property litigation activity specifically. Thus, Professor Landes’s analysis contributes both to the trademark literature as well as to the burgeoning empirically based intellectual property literature.

Among the four forces described above as reshaping the law of marks,⁸ the Internet’s influence on trademark law is Professors Mark A. Lemley and Stacey L. Dogan’s focus. In *Trademarks and Consumer Search Costs on the Internet*, they criticize courts’ tendency to overprotect marks presented on the Internet.

5. Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (1996) (codified at 15 U.S.C. §§ 1125(c), 1127 (2000)).

6. 537 U.S. 418 (2003).

7. As Professor McCarthy notes, one of the most highly touted post-*Moseley* proposals for revision of the dilution right is “to change the statutory requirement from proof of actual dilution to proof that dilution is ‘likely.’” J. Thomas McCarthy, *Proving a Trademark Has Been Diluted: Theories or Facts?*, 41 HOUS. L. REV. 713, 717 (2004).

While the dilution right was not present in the statute at the time of *Trade-Marks in Transition*, one of the symposium’s commentators compared a dilution remedy to the traditional likelihood-of-confusion test for mark infringement and analyzed the propensity and possibility of courts to protect dilution of a mark. See Rudolf Callmann, *Trade-Mark Infringement and Unfair Competition*, 14 LAW & CONTEMP. PROBS. 185, 188-90 (1949).

8. In brief, the four trademark-reshaping forces identified above are dilution, branding, the Internet, and internationalization. Refer to paras. 2-3 *supra*.

Professors Lemley and Dogan call for a renewed policy emphasis on consumer search costs to counterbalance this tendency.⁹

In *When We Say US™, We Mean It!*, Professor A. Michael Froomkin examines the branding power of marks in an international and Internet setting, leading to a fascinating story that raises a unique issue—an issue regarding a country trying to apply trademark-like protection to its name, especially online. The issue raises related concerns with implications for international trademark law; Internet governance, in particular ICANN's role in protecting country names online; nation-state use of country names and naming continuity; and virtual cultural property rights of developing countries. Professor Froomkin ultimately determines that trademark-like protection of country names does not exist in public international law and concludes that the arguments to extend such protection are unpersuasive.

Finally, in another Santa Fe Conference paper with an international focus, Professor Graeme B. Dinwoodie in *Trademarks and Territory: Detaching Trademark Law from the Nation-State*, provides a multipoint critique of the territoriality principle underlying international trademark law. Descriptively, Professor Dinwoodie illustrates the impact of nuanced waxing and waning of the territoriality effect on trademark law.¹⁰ Prescriptively, he considers how international trademark law should revisit the territoriality principle, including the extent to which such revisiting should encompass overlapping the territoriality of markets and market-based goodwill with the territory of nation-states.¹¹

With these articles, the 2004 IPIL/Houston Santa Fe Conference: *Trademark in Transition* contributes to ongoing and vital scholarship concerning the primary forces shaping

9. While the Internet was not a factor at the time of *Trade-Marks in Transition*, one commentator's article focused on nontrademark mechanisms to facilitate consumer searches and product evaluation. Carl A. Auerbach, *Quality Standards, Informative Labeling, and Grade Labeling as Guides to Consumer Buying*, 14 LAW & CONTEMP. PROBS. 362, 363-66 (1949) (questioning the effectiveness of brand-name advertising as an information-providing device and proposing standardized quality, labeling, and grading as an alternative). See also Rogers, *supra* note 1, at 173-76 (discussing the information-providing function of marks in historical and then-contemporary settings).

10. Graeme B. Dinwoodie, *Trademarks and Territory: Detaching Trademark Law from the Nation-State*, 41 HOUS. L. REV. 885, 887 (2004) ("Territorial philosophies separately affect rules regarding the scope of rights, applicable legal norms, and the acquisition and enforcement of rights.").

11. As one might expect, international trade effects on the law of marks were also an important factor at the time of *Trade-Marks in Transition*. See Stephen P. Ladas, *The Lanham Act and International Trade*, 14 LAW & CONTEMP. PROBS. 269, 269-70, 282-284 (1949) (describing the importance of adequate trademark protection for international trade and for United States' own interests).

2004]

INTRODUCTION

711

trademark today: dilution, branding, the Internet, and the internationalization of commerce and intellectual property law. Given the quality and stature of its authors and this resulting *Houston Law Review* issue of groundbreaking papers, the Santa Fe Conference is not likely to be confused with *Law and Contemporary Problems*' kindred symposium published more than five decades earlier. In this context, however, kindred affiliation is not confusion. The IPIL Institute is proud to sponsor this new scholarship on today's transformation of trademark under the revived symposium title that the 2004 IPIL/Houston Santa Fe Conference shares with its illustrious predecessor from the early years of the Lanham Act.