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Learned Hand's Trademark Jurisprudence: Legal Positivism and the Myth of the Prophet

Kenneth L. Port*

"I hate justice, which means that I know that if a man begins to talk about that, for one reason or another he is shirking thinking in legal terms."¹

I. INTRODUCTION

Learned Hand is considered by nearly all to be one of the most respected jurists in American legal history. The literature is replete with references to Hand, depicting him in superlative terms as one of the most accomplished and respected judges to sit on any United States court.² Most recently, two of the people most qualified to make the determination have concluded that Hand was a "great judge." Gerald Gunther in his biography on Hand (and in subsequent spin-off

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1. THE MIND AND FAITH OF JUSTICE HOLMES 435 (Max Learned ed., 1943). This is actually a quotation of Justice Holmes. Learned Hand was apparently very fond of this statement as epitomizing the role of judges. See Comments of Whitney North Seymour, 264 F.2d 31, 33 (2d Cir. 1959) (containing the record of a special session of the Second Circuit to praise Hand's fifty years of judicial service). Harry Shriver describes an instance where Learned Hand purposefully set up Justice Holmes to utter this quotation. Hand apparently told Holmes on departing one another's company, "Go do justice." Holmes apparently responded to Hand's delight and expectation, "That is not my job. I only play the game according to the rules." HARRY SHRIVER, WHAT GUSTO 10 (1970). As will be made apparent, this, as well as any other quotation, accurately summarizes Hand's judicial perspective in trademark cases.

2. See, e.g., CHARLES WYZANSKI, JR., LEARNED HAND, THE BILL OF RIGHTS at v (1974) (calling Hand "the greatest living judge in the English speaking world"); P. HAMBURGER, THE GREAT JUDGE (1946); Gerald Gunther, *Learned Hand*, in 2 ENCYCLOPEDIA OF THE AMERICAN CONSTITUTION 895 (1986) (stating that "Hand is widely viewed, with Oliver Wendell Holmes, Louis D. Brandeis, and Benjamin N. Cardozo, as [being] among the leading American judges of the twentieth century"); Richard Posner, *The Material Basis of Jurisprudence*, 69 IND. L.J. 1, 31 (1993) (arguing that Hand is "the greatest judge in history of the federal courts of appeals"); Joseph L. Rauh, Jr., *An Unabashed Liberal Looks at a Half-Century of the Supreme Court*, 69 N.C. L. REV. 213, 224 (1990); Bernard Schwartz, *Chief Justice Warren and 1984*, 35 HASTINGS L.J. 975, 989 (1984) (referring to Hand as "one of the greatest modern jurists"). For further deification of Hand, see Jerome N. Frank, *Some Reflections on Judge Learned Hand*, 24 U. CHI. L. REV. 666 (1957); Felix Frankfurter, *Learned Hand*, 75 HARV. L. REV. 1 (1961); George W. Pepper, *The Literary Style of Learned Hand*, 60 HARV. L. REV. 333 (1947). For an interesting assessment of this "homage" to Hand, see Carl Landauer, *Scholar, Craftsman, and Priest: Learned Hand's Self-Imaging*, 3 YALE J.L. & HUMAN. 231 (1991).

articles)³ relied on his personal affinity for Hand to conclude that Hand was a "great judge."⁴ Also, Judge Richard Posner, based almost exclusively on a quantitative analysis of the number of times Hand's opinions have been cited in various courts, concluded that Hand was a great judge.⁵

Even though Hand never was promoted to the Supreme Court,⁶ in his fifty-plus years as a judge (sitting first in the district court and then in the circuit court), very few other judges have been canonized as much as Hand.⁷ In fact, in 1959 the Second Circuit held a special session to praise Hand's fifty years of judicial service. These comments were placed on the record and are reported in the Federal Reporter.⁸ No other judge in American history had received such an honor.

A lawyer, judge or law student who formed his or her entire opinion of Learned Hand's opinions based on such canonization might expect each decision he wrote to be a masterpiece, each area of law he touched to be clarified, and each opinion to be consistent, true, and somehow objectively and normatively a "correct" statement of the law. Or, at least, these people might expect that his decisions were still good law today. As this article argues, however, as applied to Hand's substantive trademark jurisprudence, this is often not the case.⁹

3. Gerald Gunther, *Learned Hand: Outstanding Copyright Judge*, 41 J. COPYRIGHT SOC'Y U.S.A. 315 (1994); Gerald Gunther, *Reflections on Judicial Administration in the Second Circuit, From the Perspective of Learned Hand's Days*, 60 BROOK. L. REV. 505 (1994).

4. GERALD GUNTHER, *LEARNED HAND: THE MAN AND THE JUDGE* at xviii (1994); see *id.* (emoting that "[Hand] remains my idol still"). For a rather extensive review, see James A. Thomson, *Learned Hand: Evaluating a Federal Judge*, 22 N. KY. U. L. REV. 763 (1995).

5. Richard A. Posner, *Book Review: The Learned Hand Biography and the Question of Judicial Greatness*, 104 YALE L. J. 511, 534-40 (1994) [hereinafter Posner, *Book Review*]. Nevertheless, Posner criticizes Gunther for being too emotionally attached to the subject of his biography and not focusing on a substantive review of Hand's contribution. Posner himself draws his conclusion of "judicial greatness" based almost exclusively on the number of times Hand was cited and not on any substantive analysis of those cases. See also Richard A. Posner, *The Jurisprudence of Skepticism*, 86 MICH. L. REV. 827, 879-91 (1988) [hereinafter Posner, *Jurisprudence*] (arguing that a definition of law comes down to the activities of judges).

6. However, the mass media referred to Learned Hand as the Tenth Justice. WYZANSKI, *supra* note 2, at v. For a thorough discussion of Hand's frustrations with potential appointment to the Supreme Court, see Michael A. Kahn, *The Politics of the Appointment Process: An Analysis of Why Learned Hand was Never Appointed to the Supreme Court*, 25 STAN. L. REV. 251 (1973).

7. "[Hand] is often described as one of the greatest judges our country has produced." Comments of Whitney North Seymour, 264 F.2d 31, 32 (2d Cir. 1959).

8. Fifty Years of Federal Judicial Service, 264 F.2d 5-38 (2d Cir. 1959).

9. Not having closely analyzed any specific area of the law other than Hand's trademark opinions, I make no representation as to whether my thesis is proven or disproven in Hand's opinions on other substantive areas of the law. Although such a study would be of utmost importance and interest to many, it is beyond the scope of this article. However, it is important to note that people such as Judge Richard Posner have characterized Hand's impact on constitutional law as "slight" and "unexciting." Posner, *Book Review, supra* note 5, at 520; see also MARVIN SCHICK, *LEARNED HAND'S COURT* 12 n.23 (1970) (arguing that Hand's reputation as a judge is mostly a myth, unsupported by a close examination of his judicial writings). In fact, one of the other extremely respected jurists in this country, Charles Wyzanski of the First Circuit Court of Appeals, wrote in an introduction to *The Bill of Rights* that if the book were taken seriously, democratic government as we know it in this country would cease to exist. WYZANSKI, *supra* note 2, at viii. In *The Bill of Rights*, Hand argues that the courts do not have the authority to review the constitutionality of legislation.

Whether a judge is worthy of the type of praise Hand has received should be evaluated, as Richard Posner claims, by analyzing the contribution that a particular judge's decisions have had on the formulation and development of the law on any given subject.¹⁰ I accept this standard as axiomatic in this determination. Based on this standard, it is difficult to see how anyone could claim that Learned Hand was a great trademark judge.

Learned Hand's trademark jurisprudence, taken as a distinct unit, exhibits a rather amazing conservatism. Hand's judicial philosophy in trademark cases was to give extreme deference to the common law as he learned it in the 1920s. He was extremely resistant to change. This is perhaps explained by what appears to be Hand's understanding of legal positivism—that law is a statement of the will of the sovereign and judges are not free to create law without a clear statement of authority from the State. This judicial philosophy by Hand actually had an extremely restrictive¹¹ impact on the development of trademark law. Although Hand is given much credit for shaping the law in this area,¹² substantially all of his discourse on the subject has a remarkably conservative tone. This conservatism seems to be informed by the legal positivists' notion of law and the role of lawyers.

Because trademark law was in such a formative stage of development while Hand was judging these cases, and because trademark law has historically been a right derived at common law,¹³ he actually had a negative impact on the expansion of rights granted to holders¹⁴ of trademarks. In fact, Hand spent thirty years attempting to discredit the one case for which he is most often cited and on which much of his trademark jurisprudence fame is based.¹⁵

LEARNED HAND, THE BILL OF RIGHTS 73-77 (1958) [hereinafter HAND, BILL OF RIGHTS].

Hand has, of course, been vastly influential in other areas of the law. *See, e.g.*, *United States v. Carroll Towing Co.*, 159 F.2d 169, 173 (2d Cir. 1947) (creating the "Hand formula" for determining negligence); *United States v. Aluminum Co. of Am.*, 148 F.2d 416 (2d Cir.1945) (representing one of the most relied upon antitrust cases).

10. *See* Posner, *Book Review*, *supra* note 5, at 523.

11. I intend to use this word in an objective, neutral sense. I do not mean that it is necessarily negative or positive that Hand was restrictive of trademark rights. Whether trademark rights normatively should be as constrained as Hand wanted is beyond the scope of this article.

12. *See* Louis H. Pollak, *In Praise of Friendly*, 133 U. PA. L. REV. 39, 39 (1984) (stating that Hand had a "[d]ecisive influence on the development of American law"); John T. Noonan, Jr., *Choice of a Profession*, 21 PEPP. L. REV. 381, 382 (1994) (noting that, for Hand, "law was a craft"); *see also* Frank M. Coffin, *Reclaiming A Great Judge's Legacy*, 46 ME. L. REV. 377 (1994) (reviewing GERALD GUNTHER, *LEARNED HAND: THE MAN AND THE JUDGE* (1994)).

13. *See* Douglas G. Baird, *Common Law Intellectual Property and the Legacy of International News Service v. Associated Press*, 50 U. CHI. L. REV. 411, 418 (1983).

14. I refer to these entities as "holders" rather than "owners," because I think it is wrong to use property rhetoric to describe so-called "owners" of intellectual "property." *See* Kenneth L. Port, *The Illegitimacy of Trademark Incontestability*, 26 IND. L. REV. 519, 552-68 (1993).

15. *Yale Elec. Corp. v. Robertson*, 26 F.2d 972 (2d Cir. 1928). *See infra* notes 160-70 and accompanying text.

This article, then, is a systematic study of all twenty-five opinions (either majority or dissenting)¹⁶ regarding substantive trademark law that Learned Hand wrote while on the Second Circuit Court of Appeals.¹⁷ Part II introduces the law of trademarks.¹⁸ Part III introduces legal positivism, which I believe strongly influenced Hand's perspective on the role of a judge in our system of justice.¹⁹ Part IV describes Hand's peculiar interest and attraction to intellectual property opinions in general.²⁰ Part V consists of a systematic analysis of Hand's trademark cases.²¹

The article concludes that Hand was a rather rigid legal positivist and that this philosophical perspective strongly influenced the manner in which Hand viewed his role as a judge in trademark cases, thereby dictating and explaining the outcomes of his trademark cases. Furthermore, Hand's legal positivist perspective explains the difference between his opinions and various otherwise irreconcilable cases by other courts—including the Supreme Court—and resulted in greatly restricting the development of trademark law.

Finally, this article concludes that Hand's superlative reputation in the area of substantive trademark law is not only unearned, but is based on complete myth. Very few Learned Hand trademark decisions should be cited today as controlling

16. All 25 cases are as follows: *Artype, Inc. v. Zappulla*, 228 F.2d 695 (2d Cir. 1956); *American Chiclet Co. v. Topps Chewing Gum Inc.*, 208 F.2d 560 (2d Cir. 1953); *American Auto Ass'n v. Spiegel*, 205 F.2d 771 (2d Cir. 1953), *cert. denied*, 346 U.S. 887 (1953); *Federal Television Corp. & Radio Corp. v. Federal TV*, 180 F.2d 250 (2d Cir. 1950); *S.C. Johnson & Son v. Johnson*, 175 F.2d 176 (2d Cir. 1949), *cert. denied*, 338 U.S. 860 (1949); *G.H. Mumm Champagne v. Easter Wine Corp.* 142 F.2d 499 (2d Cir. 1944), *cert. denied*, 323 U.S. 715 (1944); *Adolph Kastor & Bros. v. F.T.C.*, 138 F.2d 824 (2d Cir. 1943); *Durable Toy & Novelty Corp. v. J. Chein & Co.*, 133 F.2d 853 (2d Cir. 1943), *cert. denied*, 320 U.S. 211 (1943); *Dwinell-Wright Co. v. White House Milk Co.*, 132 F.2d 822 (2d Cir. 1943); *American Brake Shoe & Foundry Co. v. Alltex Prod. Corp.*, 117 F.2d 983 (2d Cir. 1941), *cert. denied*, 314 U.S. 631 (1941); *S.C. Johnson & Son v. Johnson*, 116 F.2d 427 (2d Cir. 1940); *Emerson Elec. Mfg. Co. v. Emerson Radio & Phonograph Corp.*, 105 F.2d 908 (2d Cir. 1939), *cert. denied*, 308 U.S. 616 (1939); *Landers, Frary & Clark v. Universal Cooler Corp.*, 85 F.2d 46 (2d Cir. 1936); *American Medicinal Spirits Co. v. United Distillers, Ltd.*, 76 F.2d 124 (2d Cir. 1935); *L.E. Waterman Co. v. Gordon*, 72 F.2d 272 (2d Cir. 1934); *My-T Fine Corp. v. Samuels*, 69 F.2d 76 (2d Cir. 1934); *Mulhens & Kropff, Inc. v. Ferd. Muelhens, Inc.*, 43 F.2d 937, 940 (2d Cir. 1930) (Hand, J., dissenting), *cert. denied*, 282 U.S. 881 (1930); *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279 (2d Cir. 1929), *cert. denied*, 281 U.S. 728 (1930); *Yale Elec. Corp. v. Robertson*, 26 F.2d 972 (2d Cir. 1928); *Oakland Chem. Co. v. Bookman*, 22 F.2d 930 (2d Cir. 1927); *Caron Corp. v. Vivaudou, Inc.*, 4 F.2d 995 (2d Cir. 1925); *Shredded Wheat Co. v. Humphrey Cornell Co.*, 250 F. 960 (2d Cir. 1918); *Aunt Jemima Mills Co. v. Rigney & Co.*, 247 F. 407, 412 (2d Cir. 1917) (Hand, J., concurring), *cert. denied*, 245 U.S. 672 (1918); *Crescent Tool Co. v. Kilborn & Bishop Co.*, 247 F. 299 (2d Cir. 1917).

17. Hand sat on the Second Circuit often even while he was still a member of the district court. He apparently made a name for himself in that capacity and this is what distinguished him in the minds of his would-be peers on the Second Circuit. See GUNTHER, *supra* note 4, at 270. To limit the volume of material, I have chosen to review and comment systematically on those opinions written while Hand sat in the capacity of an appellate judge. I am confident, however, that the conclusions in this article can also be applied to Hand's opinions while sitting as a district judge.

18. See *infra* notes 26-53 and accompanying text.

19. See *infra* notes 54-71 and accompanying text.

20. See *infra* notes 72-83 and accompanying text.

21. See *infra* notes 84-239 and accompanying text.

law. This is not a great legacy for “the greatest judge in the history of the federal courts of appeals.”²²

By analyzing Hand’s trademark opinions and categorizing him as a legal positivist, it is hoped that more discussion and close scrutiny of Hand’s opinions will be initiated. In this effort, it is important to note, the role of legal theory is to allow for such group structuring.²³ Deliberate group structuring facilitates the understanding of specific bodies of information. Most importantly, my use of theory in this article is intended to be causal, not just descriptive.²⁴ When theory is used causally as well as descriptively, one comes to understand and appreciate the constraints and the perspective under which specific jurists operated.²⁵

II. TRADEMARK LAW GENERALLY²⁶

Trademark jurisprudence, although well established today, has a rather peculiar origin and has developed over considerable time. The cause of action, as initially conceived, was grounded in the common law tort of deceit.²⁷ As such, only consumers—those who were deceived—had standing to bring suit.²⁸ It was not until 1905 that trademark law was codified in this country.²⁹

The first use of a mark to identify the source of a product actually began at least 3500 years ago when potters made scratchings on the bottom of their

22. Richard A. Posner, *The Material Basis of Jurisprudence*, 69 *IND. L.J.* 1, 31 (1993).

23. SAMUEL SHUMAN, *LEGAL POSITIVISM: ITS SCOPE AND LIMITATIONS* 35 (1963).

24. See *id.* (arguing that theory should be used only descriptively and not causally). Causal use of theory implies that outcomes can be determined and predicted based on a specific conceptual approach to jurisprudence. Descriptive use of theory implies that outcomes of specific cases can be grouped and described after the fact, but not predicted.

25. Occasionally, what seems at first to have little practical relevance can, by creating new perspectives to conceptualize methodologies, play a significant role in understanding judicial trends. See, e.g., William H. Page, *Legal Realism and the Shaping of Modern Antitrust*, 44 *EMORY L.J.* 1 (1995); Michael Wells, *Positivism and Antipositivism in Federal Courts Law*, 29 *GA. L. REV.* 655 (1995).

26. See generally RUDOLPH CALLMANN, *THE LAW OF UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES* (Louis Altman ed., 3d ed. 1981); JEROME GILSON, *TRADEMARK PROTECTION AND PRACTICE* (1991); J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* (3d ed. 1995); Port, *supra* note 14.

27. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 145-57 (1989); see also Kenneth R. Pierce, *The Trademark Law Revision Act: Origins of the Use Requirement and an Overview of the New Federal Trademark Law*, 64 *FLA. BUS. J.* 35 (May 1990). See generally *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403 (1916) and *McLean v. Fleming*, 96 U.S. 245 (1877) (discussing the beginnings of trademark law in the United States); MCCARTHY, *supra* note 26, § 5.02 (citing *Perry v. Truefit*, 6 *Beav.* 66, 49 *Eng. Rep.* 749 (1842), and discussing the origins of trademark law).

28. *Pierce*, *supra* note 27, at 37.

29. Act of February 20, 1905, ch. 592, 33 Stat. 724. This Act allowed registration of marks used in interstate commerce for a period of 20 years with an unlimited right of renewal. Registration constituted *prima facie* evidence of ownership of the mark, accorded the owner access to federal courts, and provided certain remedies for infringement. However, the deficiencies in the Act, which were not satisfied despite numerous amendments, led to its repeal in 1947 by the Lanham Act.

creations to identify the source.³⁰ The first judicial recognition of trademarks did not come, however, until 1618 in *Southern v. How*³¹ when an English common pleas judge made an obscure reference to a mark used on cloth.³² There are various renditions of how the subject of trademarks arose in *Southern v. How* because the reference is actually to a prior unreported case that denied trademark rights.³³ The notion of protecting a commercially viable indication of source, therefore, had a rather murky beginning,³⁴ but it soon became a well accepted judicial notion in England that a mark deserved protection at common law when it indicated the source or origin of goods.³⁵

The United States Supreme Court stated in 1879 that trademarks do not “depend upon novelty, invention, discovery, or any work of the brain. It requires no fancy or imagination, no genius, no laborious thought. [Trademarks are] simply founded on priority of appropriation.”³⁶

In 1905, Congress enacted the Act of 1905 which attempted to create a national trademark registration system. However, as a “slovenly piece of legislation, characterized by awkward phraseology, bad grammar and involved sentences [whose] draftsman had a talent for obscurity amounting to genius,”³⁷ the Act was not well received. In fact, the Act was closely circumscribed by

30. See generally EDWARD S. ROGERS, GOOD WILL, TRADE-MARKS AND UNFAIR TRADING 34-39 (1919) (discussing the history of the trademark); Benjamin G. Paster, *Trademarks—Their Early History*, 59 TRADEMARK REP. 551 (1969); Gerald Ruston, *On the Origin of Trademarks*, 45 TRADEMARK REP. 127 (1955); Abraham S. Greenberg, *The Ancient Lineage of Trade-Marks*, 33 J. PAT. [& TRADEMARK] OFF. SOC'Y 876 (1951); Edward S. Rogers, *Some Historical Matter Concerning Trade-Marks*, 9 MICH. L. REV. 29 (1910); GILSON, *supra* note 26, § 1.02[1]; WILLIAM H. BROWNE, A TREATISE ON THE LAW OF TRADEMARKS 1-14 (1885) (tracing the use of trademarks back several millennia to China, India, Persia, Egypt, Rome, and Greece, and citing marks used during the time of the Old Testament); *id.* at 8 (stating that the blocks of stone used to build the temple of Solomon bore quarry marks so the “mechanics” could “prov[e] their claims to wages”); *id.* at 10 (stating that Abraham paid for the cave in which he buried Sarah with coins bearing a mark of authentication).

31. 79 Eng. Rep. 1243 (1618).

32. *Id.* at 1244.

33. See generally FRANK I. SCHECTER, THE HISTORICAL FOUNDATIONS OF THE LAW RELATING TO TRADEMARKS (1925); Pierce, *supra* note 27, at 35.

34. See *Blanchard v. Hill*, 26 Eng. Rep. 692, 694 (1742) (refusing to grant an injunction against an alleged infringer because the injunction would give the plaintiff a monopoly in sales of the relevant product—playing cards).

35. See, e.g., *Sykes v. Sykes*, 107 Eng. Rep. 834, 835 (1824). The court regarded trademark protection as well established and awarded an injunction to the plaintiff in a situation where the defendant had used the plaintiff's mark, “SYKES PATENT,” on inferior shot-belts and powder flasks and passed them off as products of the plaintiff. Another case still relied on by many courts is *Millington v. Fox*, 40 Eng. Rep. 956 (1838), where the plaintiff sued in equity to enjoin the use of his mark. The court, in awarding the injunction, stated that the plaintiff had a right to enforce title to its mark and that an injunction was appropriate even though there was no direct proof of defendant's intent to defraud and that defendant may not have even known of plaintiff's mark. *Id.* at 960-61. The United States Supreme Court has adopted this case as controlling. *Saxlehner v. Siegel-Cooper Co.*, 179 U.S. 42, 43 (1900).

36. Trade-Mark Cases, 100 U.S. 82, 94 (1879).

37. Edward S. Rogers, *The Expensive Futility of the United States Trade-Mark Statute*, 12 MICH. L. REV. 660, 665 (1914).

courts that determined it granted no substantive trademark rights whatsoever and amounted to nothing more than a registration statute and a codification of existing common law.³⁸

By 1917, the year of Hand's first trademark case, trademark protection was based exclusively on the common law which, at the time, was based on the principles of property.³⁹ Therefore, trademarks were protected from being copied only if they were used by the holder of the mark and only to the extent they were used. At the time, one could copy a mark as well as a product "slavishly," but if there was no diversion of trade or no intent to divert trade, there was no action in trademark law.

Furthermore, when Hand first entered the trademark field in 1917, none of the concepts of trade dress, dilution, or likelihood of confusion existed. As the Supreme Court stated in 1879, it was merely an issue of who adopted and used the mark first.⁴⁰

Today, as well as when Hand was first called upon to adjudicate trademark cases, a trademark is protectable only if it is inherently distinctive⁴¹ or has attained secondary meaning.⁴² Secondary meaning today refers to the notion that descriptive trademarks (which are not protectable) may attain a dual function.⁴³ One function is to operate as the word was originally intended: in a descriptive sense. The other is to operate as a source-indicating entity. Therefore, secondary meaning refers to a mark that once may have been descriptive but, through use, has come to identify a single source for a good or service in the minds of the relevant purchasing public.⁴⁴

Under the Lanham Act,⁴⁵ trademarks are defined as any "word, name, symbol, or device or any combination thereof . . . used . . . to indicate the source

38. See, e.g., *American Trading Co. v. H.E. Heacock Co.*, 285 U.S. 247, 258-59 (1932) (giving priority over subsequent trademark registration in the Philippines because Congress had express authority to create trademark rights in the Philippines but not in the United States); *American Steel Foundries v. Robertson*, 269 U.S. 372 (1926); *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 99 (1918) (recognizing that "registration of the [petitioner's] trademark under . . . the act of Congress [did not have] the effect of enlarging the rights of [petitioner] beyond what they would be under common-law principles"). *But cf.* *Philco Corp. v. Phillips Mfg. Co.*, 133 F.2d 663, 668 (7th Cir. 1943) (finding that Congress had the authority to create substantive trademark rights and did so in the Act of 1905).

39. *Port*, *supra* note 14, at 562-67.

40. See *Trade-Mark Cases*, 100 U.S. at 94.

41. *MCCARTHY*, *supra* note 26, § 11.02.

42. *Id.* § 11.09.

43. *Id.*

44. *Gear, Inc. v. L.A. Gear California, Inc.*, 670 F. Supp. 508, 515 (S.D.N.Y. 1987). The court in *L.A. Gear* identified the following factors that contribute to the analysis of whether or not a specific mark has attained secondary meaning: (1) attempts to imitate the mark, (2) advertising expenditures, (3) sales success, (4) consumer studies linking the mark to a source, (5) unsolicited media coverage of the product and the mark, and (6) length and exclusivity of the mark's use. *Id.*

45. 15 U.S.C.A. §§ 1051-1127 (West 1976 & Supp. 1995).

of the goods . . . ”⁴⁶ Trademark protection has been drastically expanded over what it was in the early 1900s.⁴⁷ Trademark protection extends to trade dress even if the dress has no secondary meaning (provided that it is inherently distinctive),⁴⁸ extends to protect a mark from dilution in some states,⁴⁹ and even extends to protect the color of the product.⁵⁰ In keeping with this perspective, effective January 16, 1996, the Lanham Act was amended to allow holders of famous trademarks to enjoin alleged dilution of their marks.⁵¹

Trade dress is defined as the overall visual impression of a product or provision of services.⁵² Most recently, the Supreme Court has found even the inside of a Mexican restaurant to be inherently distinctive and the appropriate subject of rather strong trademark protection.⁵³

46. 15 U.S.C.A. § 1127 (West 1988). See also *Towers v. Advent Software, Inc.*, 913 F.2d 942, 945 (Fed. Cir. 1990); *Hughes v. Design Look Inc.*, 693 F. Supp. 1500, 1505 (S.D.N.Y. 1988).

47. Kenneth L. Port, *The "Unnatural" Expansion of Trademark Rights: Is a Federal Dilution Statute Necessary?*, 18 SETON HALL LEGIS. J. 433, 437-47 (1994).

48. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S. Ct. 2753, 2757-58 (1992). This is a rather new development and constitutes a drastic expansion of the common law of trademarks. For a review of the common law as it applied to trade dress prior to *Taco Cabana*, see Port, *supra* note 47, at 483-84 nn.257-58.

49. Twenty-five states now have trademark dilution statutes. ALA. CODE § 8-12-17 (1993); ARK. CODE ANN. § 14-71-113 (Michie 1991); CAL. BUS. & PROF. CODE § 14330 (West Supp. 1996); CONN. GEN. STAT. ANN. § 35-11i(c) (West Supp. 1995); DEL. CODE ANN. tit. 6, § 3313 (1993); FLA. STAT. ANN. § 495.151 (West 1988); GA. CODE ANN. § 10-1-451(b) (Michie 1994); IDAHO CODE § 48-512 (1977); ILL. ANN. STAT. ch. 765, para. 1035/15 (Smith-Hurd 1993); IOWA CODE ANN. § 548.11(2) (West 1987); LA. REV. STAT. ANN. § 51:223.1 (West 1987); ME. REV. STAT. ANN. tit. 10, § 1530 (West 1980); MASS. GEN. LAWS ANN. ch. 110B, § 12 (1990); MO. ANN. STAT. § 417.061 (Vernon Supp. 1996); MONT. CODE ANN. § 30-13-334 (1995); NEB. REV. STAT. § 87-122 (1994); N.H. REV. STAT. ANN. § 350-A:12 (1995); N.M. STAT. ANN. § 57-3-10 (Michie 1995); N.Y. GEN. BUS. LAW § 368-d (McKinney 1984); OR. REV. STAT. § 647.107 (1995); PA. STAT. ANN. tit. 54, § 1124 (Supp. 1996); R.I. GEN. LAWS § 6-2-12 (1992); TENN. CODE ANN. § 47-25-512 (1995); TEX. BUS. & COM. CODE ANN. § 16.29 (West Supp. 1996); WASH. REV. CODE ANN. § 19.77.160 (West Supp. 1996). Three states are considered to be common law dilution jurisdictions: Michigan, New Jersey and Ohio. See *Koffler Stores, Ltd. v. Shoppers Drug Mart, Inc.*, 434 F. Supp. 697, 704 (E.D. Mich. 1976); *OM Scott & Sons Co. v. Surowitz et al.*, 209 F. Supp. 59, 61 (E.D. Mich. 1962); *Consolidated Freightways, Inc. v. Central Transp., Inc.*, 201 U.S.P.Q. 524, 530 (E.D. Mich. 1978); *Chanel, Inc. v. Casa Flora Co.*, 241 A.2d 24, 27 (N.J. 1968), *cert. denied*, 242 A.2d 381 (1968). *But cf.* *Great Atl. & Pac. Tea Co. v. A & P Trucking Corp.*, 149 A.2d 595, 599 (N.J. 1959) (issuing an injunction even though there was no competition; however, the court required and found a reasonable likelihood of confusion). Therefore, it is also quite unlikely that a plaintiff would prevail under New Jersey Common Law in a pure dilution cause of action. See *Caesars World, Inc. v. Caesar's Palace*, 490 F. Supp. 818, 828 (D.N.J. 1980). Ohio also appears to recognize a common law cause of action for dilution. See *Ameritech, Inc. v. American Info. Tech. Corp.*, 811 F.2d 960, 965 (6th Cir. 1987).

50. See *Qualitex Co. v. Jacobson Prods. Co.*, 115 S. Ct. 1300, 1308 (1995).

51. Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 104 Stat. 985; see *id.* (amending 15 U.S.C.A. § 1125).

52. See *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 613 (9th Cir. 1989); *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 935 (7th Cir. 1989), *cert. denied*, 493 U.S. 1075 (1990). Courts have traditionally held that labels, packages, and product designs may all constitute trade dress. See, e.g., *Ambrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1535 (11th Cir. 1986); *Freixenet S.A. v. Admiral Wine & Liquor Co.*, 731 F.2d 148, 153 (3d Cir. 1984); *T.G.I. Friday's Inc. v. Int'l Restaurant Group, Inc.*, 405 F. Supp. 698, 708 (M.D. La. 1975), *aff'd*, 569 F.2d 895, 899 (5th Cir. 1978).

53. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S. Ct. 2753 (1992).

III. HAND'S LEGAL POSITIVISM

Legal positivism has a variety of forms and meanings. For purposes of this article, I shall define what I believe Learned Hand understood as legal positivism and then demonstrate how this legal theory informed and directed Hand's judicial theory.

At its core, legal positivism is the notion that all law is the product of the will of the state⁵⁴ and that law is divorced from morals.⁵⁵ In other words, a legal positivist is mostly concerned with what the law is in order to determine the will of the state.⁵⁶ The legal positivist is not concerned with whether the moral propositions upon which the laws are based are normatively true or false.⁵⁷

Legal positivism began as an English philosophical response to the natural law proponents and was the first modern attempt at a coherent theory of law.⁵⁸ In response to natural law proponents such as John Locke, John Austin, a disciple of Jeremy Bentham,⁵⁹ proposed a detailed theory of the law of a nation-state. Both Bentham and Austin—generally considered the founders of legal positivism⁶⁰—were concerned that if the natural law proponents' concepts were put

54. See KEEKOK LEE, *THE POSITIVIST SCIENCE OF LAW* 2 (1989); Roberto Ago, *Positive Law and International Law*, 51 AM. J. INT'L L. 691, 700 (1957). For the proposition that only positive law is the true set of obligations that are entitled to be called "law"—another view espoused by most legal positivists—see P. SOPER, *A THEORY OF LAW* 102 (1984).

55. See H.L.A. HART, *THE CONCEPT OF LAW* 181-207 (1961); JOHN M. LIGHTWOOD, *THE NATURE OF POSITIVE LAW* 362-90 (1982); SHUMAN, *supra* note 23, at 15.

56. See RAYMOND FRANCIS BEGIN, *NATURAL LAW AND POSITIVE LAW* 94-138 (1959).

57. See Herbert Hovenkamp, *Positivism in Law & Economics*, 78 CAL. L. REV. 815, 818 (1990).

58. See R.W.M. DIAS, *JURISPRUDENCE* 451 (4th ed. 1976).

59. It is not widely known but extremely provocative that not only were Bentham, Austin and John Stewart Mill contemporaries, they were also close neighbors in Queen Square, London, in the early Nineteenth Century. See DIAS, *supra* note 58, at 460.

60. LIGHTWOOD, *supra* note 55, at 1. Other major theorists in this field include JALES L. COLEMAN, *MARKETS MORALS AND THE LAW* 3-27 (1988); JOSEPH RAZ, *THE CONCEPT OF A LEGAL SYSTEM* (2d ed. 1970); SHUMAN, *supra* note 23; SOPER, *supra* note 54; Roberto Ago, *Positive Law and International Law*, 51 AM. J. INT'L L. 691 (1957); Robert Ago, *Authority, Law and Morality*, 68 MONIST 295 (1985); Hans Kelson, *The Pure Theory of Law*, 50 L.Q. REV. 474 (1934); Ken Kress, *Legal Indeterminacy*, 77 CAL. L. REV. 283 (1989). Although all of these theorists can appropriately be labeled "legal positivists," it is endemic to the nature of legal positivism that they do not necessarily agree with one another's perceptions of the subject matter. The most vigorous debate in this regard has arisen between H.L.A. Hart (and his supporters) and Ronald Dworkin (and his supporters). Hart and Dworkin have a long history of doing battle over what legal positivism is or is not. Compare HART, *supra* note 55 with RONALD DWORKIN, *TAKING RIGHTS SERIOUSLY* 14-45 (1977); compare H.L.A. HART, *ESSAYS ON BENTHAM: STUDIES IN JURISPRUDENCE AND POLITICAL THEORY* (1982) and H.L.A. Hart, *Comment in ISSUES IN CONTEMPORARY LEGAL PHILOSOPHY* (R. Gavison ed., 1987) with RONALD DWORKIN, *LAW'S EMPIRE* (1986). Some of the more helpful overviews of this dispute include FREDERICK SCHAUER, *PLAYING BY THE RULES: A PHILOSOPHICAL EXAMINATION OF RULE-BASED DECISION-MAKING IN LAW AND IN LIFE* 199 (1991); Kenneth Kress, *Legal Reasoning and Coherence Theories: Dworkin's Rights Thesis, Retroactivity, and the Linear Order of Decisions*, 72 CAL. L. REV. 369, 371 (1984); E. Philip Soper, *Legal Theory and the Obligation of the Judge: The Hart/Dworkin Dispute*, 75 MICH. L. REV. 473 (1977). Some purport to have resolved the conflicts between legal positive theorists. See, e.g., W. J. WALUCHOW, *INCLUSIVE LEGAL POSITIVISM* (1994).

into effect, chaos would result. Therefore, both Bentham and Austin clearly delineated that what the law *is* was distinct from what the law *ought to be*.⁶¹ Whereas natural rights theorists purported that only those laws that conformed to morality were binding,⁶² legal positivists held that laws, as an expression of the will of the state, were binding whether or not they comported with morality.⁶³

This is the form of legal positivism that Hand espoused in virtually all of his writings.⁶⁴ As a moral skeptic,⁶⁵ Hand clearly subscribed to the notion that one's morality should be kept distinct from how one judges and applies the law. In various instances, Hand wrote that "man, and man alone creates the universe of good and evil,"⁶⁶ that values "admit to no reduction below themselves; you may prefer Dante to Shakespeare, or claret to champagne, but that ends it;"⁶⁷ and "[w]e see what you are driving at, but you have not said it, and therefore we shall go on as before."⁶⁸ Most telling, Hand explained his understanding of his role as a judge as follows: It is not "desirable for a lower court to embrace the exhilarating opportunity of anticipating a doctrine which may be in the womb of time, but whose birth is distant."⁶⁹

Hand's understanding of his role as a judge was to "obey clear commands" of his superiors and bow to precedent, but to continue to express criticism of the prevailing law.⁷⁰ This manner of thought process seems consistent with a judicial theory that is heavily imbued with legal positivism.

Hand's adherence to moral skepticism as derived from legal positivism gave him a jurisprudential justification to harshly confine the expansion of trademark

61. HART, *supra* note 55, at 206.

62. CHARLES COVELL, *THE DEFENSE OF NATURAL LAW* 7 (1992); HART, *supra* note 55, at 182; JOHN LOCKE, *QUESTIONS CONCERNING THE LAW OF NATURE* 97 (1990).

63. HART, *supra* note 55, at 181.

64. This is especially true in *The Bill of Rights*, in which Hand advocated the position that only legislative acts that were totally unreasonable should be reviewed by the judiciary and that most constitutional issues should be nonjusticiable because the Constitution does not expressly state that federal judges have the power of judicial review. See HAND, *BILL OF RIGHTS*, *supra* note 9, at 73-77.

65. See Michael Moore, *Moral Reality*, 1982 WIS. L. REV. 1061, 1066. As a moral skeptic, Hand had "additional motive" to be a legal positivist. *Id.* at 1066 n.10.

66. LEARNED HAND, *THE SPIRIT OF LIBERTY* 93 (1959).

67. *Id.* at 198.

68. HAND, *BILL OF RIGHTS*, *supra* note 9, at 19 (citing *Johnson v. United States*, 163 F. 30, 32 (1st Cir. 1908) (Holmes, J.)). Hand was an avid supporter and disciple of Holmes. Because Holmes was such a clear legal positivist and because Hand was so fond of Holmes, it is understandable how Hand became a moral skeptic and legal positivist himself. See *Southern Pac. Co. v. Jensen*, 244 U.S. 205, 222 (1916) (Holmes, J., dissenting) (stating that the common law must be "the articulate voice of some sovereign . . . that can be identified"); see also GRANT GILMORE, *THE AGES OF AMERICAN LAW* (1978); O.W. HOLMES, *THE COMMON LAW* (M. Howe ed., 1963).

69. *Spector Motor Serv., Inc. v. Walsh*, 139 F.2d 809, 823 (2d Cir. 1944) (L. Hand, J., dissenting), *vacated sub nom.*, *Spector Motor Serv., Inc. v. McLaughlin*, 323 U.S. 101 (1944).

70. GUNTHER, *supra* note 4, at 149.

rights—rights that were based on common law and therefore very susceptible to the judicial philosophy of a particular judge.⁷¹

IV. HAND AND TRADEMARKS

Billings Learned Hand was born in Albany, New York in 1872.⁷² Hand was the son of an Albany lawyer in a family of lawyers.⁷³ However, Hand's first love was not the law. In fact, Hand was not exactly a resounding success as a practicing lawyer.⁷⁴ In his early days at the bar, Hand worked in several different firms and never made a real impression on any of his employers as a star practitioner.⁷⁵

Hand actually wanted to study, learn, and then teach philosophy,⁷⁶ his original motivating intellectual inquiry. In fact, Hand clearly would have pursued a career in philosophy if he had possessed the personal strength and confidence to oppose his father's visions for him.⁷⁷

Although generally viewed as a pillar of intellectual strength, Hand was emotionally rather troubled.⁷⁸ He was forever insecure in his position as a judge; he never spoke of his role as one of the most famous judges of his time in anything more than extremely modest asides. At the commemoration of Hand's fifty years of judicial service, Hand said, "I confess when I look at my service it seems to have been for the most part trivial. It amounted to a good deal to the people at the moment, but when one takes it in bulk, it does not seem to have been much."⁷⁹

Extreme modesty or extreme insecurity seem to be the best explanations for this apparent low self-image. This seems rather harsh self-criticism for one of the "greatest jurists to have ever lived."⁸⁰ However, rather than merely an expression of Hand's self-doubt, these modest expressions are more indicative of Hand's true love—philosophy. Hand was extremely philosophical about his role as a judge and his role in life in general.⁸¹

Trademark cases were particularly well suited for Hand's philosophical excursions. As much as anything else, Hand's personal affinity toward

71. For the argument that the *political* affiliation of individual judges does not affect the substantive outcome of their assigned cases today, see Orley Ashenfelter et al., *Politics and The Judiciary: The Influence of Judicial Background on Case Outcomes*, 24 J. LEGAL STUD. 257 (1995).

72. GUNTHER, *supra* note 4, at 3.

73. *Id.*

74. *Id.* at 59-61.

75. *Id.*

76. *Id.* at 33, 40.

77. *Id.* at 42, 54.

78. *Id.* at 4.

79. Fifty Years of Federal Judicial Service, 264 F.2d 5, 27 (2d Cir. 1959).

80. See *supra* note 2 and sources cited therein.

81. GUNTHER, *supra* note 4, at 42.

philosophy attracted him to intellectual property law cases.⁸² Because he approached the trademark law cases based on his interest in philosophy, it is not surprising that a particular school of philosophy—legal positivism—greatly affected not only the manner in which Hand approached his job but also the actual outcome of his cases. In Hand's trademark cases, his judicial philosophy was clearly affected by his philosophical interests. Rather than expand the law of trademarks—an achievement for which Hand is generally given credit—without a clear “positive policy”⁸³ dictating in clear terms that a plaintiff possessed some right, Hand was extremely reticent to create one.

V. HAND'S TRADEMARK OPINIONS

Learned Hand's trademark opinions can all be categorized as addressing three rather narrow issues. It is surprising that after all the credit given to Hand for influencing the field, all of his twenty-five opinions actually address so few trademark issues. The three areas Hand addressed were trade dress, the unrelated goods doctrine,⁸⁴ and the so-called Hand Doctrine.

Trade dress refers to protection for the shape, style, or design of packaging or overall business image. The unrelated goods doctrine generally holds that infringement may still be found even if the goods of the defendant and the goods of the plaintiff are not identical, providing that the goods of the defendant are similar enough that consumers might come to believe they emanate from the plaintiff. As we shall see, the Hand Doctrine referred first to the expanded version of the unrelated goods doctrine, but soon came to mean that Hand would sustain an infringement cause of action only if there was actual confusion or intention to misdirect consumers.

In each of Hand's trademark opinions, his clear struggle with separating what he believed the outcome ought to be from what he saw as the confining precedent at the time is obvious. Even in the rare instance when the “ought” prevailed, Hand carefully circumscribed the expansion of new trademark rights.⁸⁵ Hand became famous in trademark discourse⁸⁶ for these expansive cases even though they

82. *Id.* at 328.

83. *Oakland Chem. Co. v. Bookman*, 22 F.2d 930, 931 (2d Cir. 1927).

84. This is also known as the “*Aunt Jemima* Doctrine,” so named because of the Second Circuit's decision in *Aunt Jemima Mills Co. v. Gigney & Co.*, 247 F. 407 (2d Cir. 1917). *See infra* notes 148-79 and accompanying text (discussing the *Aunt Jemima* Doctrine).

85. *See infra* notes 134-47 and accompanying text.

86. *See General Motors Corp. v. Cadillac Marine & Boat Co.*, 226 F. Supp. 716 (W.D. Mich. 1964); *see also* Miles J. Alexander, *Dilution—A Blessing or a Curse?: What is it? How Do You Prove it? How Does it Fit in with Traditional Trademark Law?*, 251 PLI/PAT 297 (1988) (relying on Hand's “powerful prose” in the *Yale Electric* opinion for substantive trademark law); Lillian R. BeVier, *Competitor Suits for False Advertising Under 43(a) of the Lanham Act: A Puzzle in the Law of Deception*, 78 VA. L. REV. 1, 19 (1992); Robert Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 164 n.25 (recognizing both Hand's expansion and

represent a small fraction of his trademark opinions and even though Hand subsequently spent the rest of his life confining their application. Virtually all of Hand's trademark opinions are extremely restrictive of a trademark holder's rights because he felt confined by what he considered to be the "Law and the Prophets" on the subject in 1928—that "one merchant shall not divert customers from another by representing what he sells as emanating from the second,"⁸⁷ Hand was extremely resistant to change.

A. *Trade Dress Opinions*

Hand's resistance to change can be seen as early as his first trademark opinion in 1917.⁸⁸ In *Crescent Tool Co. v. Kilborn & Bishop Co.*,⁸⁹ in a one page opinion, Hand held that even though the plaintiff's adjustable wrench was new in shape and very pleasing to the public, and even though there was actual confusion in the minds of the purchasing public, the shape of the wrench was functional because it had not attained a secondary meaning.⁹⁰

Although Hand cites only one case in the entire opinion,⁹¹ he claims that the cases all stand for the proposition that the second comer's article must be an "exact" copy and that the second comer must have intended the deception before the plaintiff can prevail.⁹² Hand further stated that the final question is always whether the public actually was "moved in any degree to buy the article because of its source and what are the features by which it distinguishes that source."⁹³

retraction of trademark rights); Mary H. Reed, *Trademarks in the Sale of Part of a Business: Concurrent Use and Licensing*, 361 PLIPAT 113 n.10 (1993) (citing Hand specifically as being responsible for the *Yale Electric* ruling); Timothy R.M. Bryant, Comment, *Trademark Infringement: The Irrelevance of Evidence of Copying to Secondary Meaning*, 83 NW. U.L. REV. 473, 482 (1988) (referring to Hand's ruling in *Yale Electric* as a "principle canon of trademark law"); Mary A. Rinney, Note, *Levi Strauss and Co. v. Blue Bell Inc.: Limiting the Protection of Inherently Nondistinctive Trademarks*, 36 DEPAUL L. REV. 159, 164 (1986) (citing Hand for his rejection of the restrictive wording of the 1905 Trademark Act in his *Yale Electric* opinion expanding protection to include related, yet noncompeting goods).

87. *Yale Elec. Corp. v. Robertson*, 26 F.2d 972, 973 (2d Cir. 1928).

88. GUNTHER, *supra* note 4, at 270; *see id.* (noting that although Hand was still a district court judge, he was often asked to sit with the Second Circuit Court of Appeals).

89. 247 F. 299 (2d Cir. 1917).

90. *Id.* at 301.

91. *See Enterprise Mfg. Co. v. Landers*, 131 F. 240 (2d Cir. 1904) (upholding in a one-page opinion an injunction against the defendant who had copied the plaintiff's mills whenever it was convenient and profitable so that the resultant mill manufactured by the defendant looked exactly like the plaintiff's mill).

92. *Crescent Tool Co. v. Kilborn & Bishop Co.*, 247 F. 299, 300 (2d Cir. 1917); *see id.* ("The plaintiff has the right not to lose his customers through false representations that those are his wares which in fact are not, but he may not monopolize any design or pattern, however trifling. The defendant, on the other hand, may copy the plaintiff's goods slavishly down to the minutest detail; but he may not represent himself as the plaintiff in their sale"). Even at this early stage, Hand was taking rather remarkable liberties with precedent. For example, *Enterprise Mfg. Co. v. Landers*, actually holds that "proof [of consumer deception] is hardly needed." 131 F. at 241.

93. *Crescent Tool Co.*, 247 F. at 299.

Hand, however, does not sound as though he had convinced himself, let alone the reader. In the last paragraph of the opinion, Hand essentially confined his own opinion to the exact facts presented and thereby limited its precedential value. Hand stated that this case did not address the limits of the plaintiff's rights—only that purchasers must be motivated to buy the goods because of the shape of the product before that shape can be protected.

As with many of Hand's opinions, *Crescent Tool* seems to have attained a life of its own merely because Learned Hand wrote the opinion, not because the opinion itself was particularly enlightening. In fact, it has been difficult to find any other single Hand opinion that has been as misquoted and misconstrued as *Crescent Tool*. One set of commentators even relied on *Crescent Tool* in 1993 as "still apropos"⁹⁴ for the proposition that secondary meaning is absolutely required before any trade dress can be protected. This resulted even though in 1992 the United States Supreme Court, in *Two Pesos, Inc. v. Taco Cabana, Inc.*,⁹⁵ noted that the Second Circuit's requirement for secondary meaning in all trade dress cases was overly restrictive.⁹⁶

Crescent Tool quickly became representative of a new theory of trade dress cases known as "source motivation."⁹⁷ That is, *Crescent Tool* stood for Hand's notion that the trade dress must distinguish a product as coming from a particular source and that the consumer was motivated to buy it because of that source.⁹⁸

Both elements of Hand's test as articulated in *Crescent Tool* have been completely repudiated. It is now axiomatic that the first element of Hand's test is inappropriate. That is, no court requires that the purchaser know "the" source of a product. It is perfectly adequate that the purchaser know that the product comes from "a" source even if that source is anonymous.⁹⁹ Additionally, in 1984, Congress passed the Trademark Clarification Act of 1984.¹⁰⁰ One of its principal purposes was to clarify that "purchaser motivation" should not be used in determining the validity of trademarks. The legislative history is clear: "[T]he 'purchaser motivation' test exceeds the bounds of merely an impropriety test; rather, it shows a disregard for the basic purposes of trademark protection."¹⁰¹

94. Lawrence E. Evans, Jr. & Elizabeth A. Hoover, *Protection of Product Configurations Under the Lanham Act*, 1 U. BALT. INTELL. PROP. L.J. 126, 139 (1993).

95. 112 S. Ct. 2753 (1992).

96. *Id.* at 2764 n.14 (Stevens, J., concurring).

97. See A. Samuel Oddi, *Consumer Motivation in Trademark and Unfair Competition Law: On the Importance of Source*, 31 VILL. L. REV. 1, 27 n.117 (1986).

98. *Id.* at 28.

99. *Id.* at 75.

100. Trademark Clarification Act of 1984, Pub. L. No. 98-620, 98 Stat. 3335 (codified at 15 U.S.C.A. § 1064(3) (West 1993)).

101. Trademark Clarification Act of 1984, Pub. L. No. 98-620, 1984 U.S.C.C.A.N. (98 Stat.) 5726.

Even the Second Circuit has repudiated the source motivation theory in trade dress cases. In *Warner Brothers, Inc. v. Gay Tools, Inc.*,¹⁰² the court rejected the source motivation theory from *Crescent Tool* as well as all the subsequent cases that depended upon it.¹⁰³

Therefore, the general theory of *Crescent Tool* has been expressly rejected by the Supreme Court, one element has been expressly rejected by the United States Congress, and the final element has been expressly repudiated by the Second Circuit itself. This makes statements that the case is “still apropos” even more difficult to understand. Of course, it also makes canonization of the judge that wrote the opinion rather suspect, as well.

Crescent Tool's legacy went even further than this. In *Crescent Tool*, Hand held that in order to prevail on a trade dress type claim, the plaintiff must show that the design was nonfunctional. According to Hand, nonfunctionality is proven by the existence of secondary meaning. Furthermore, Hand concluded that secondary meaning is established when the plaintiff shows that purchasers knew the product emanated from the plaintiff and that they bought the product because it emanated from the plaintiff. That is, according to the actual language in *Crescent Tool*, Hand believed that the functionality of a trade dress was intertwined with whether the mark had secondary meaning. According to the exact language in *Crescent Tool*, if the mark had secondary meaning, it was not functional and therefore protectable.

Once again, however, this Hand opinion has taken on a life of its own. A surprising number of courts have relied on *Crescent Tool* for the proposition that trade dress requires a bifurcated analysis even though the language of *Crescent Tool* simply does not say that.¹⁰⁴ Today, in order to prevail, a plaintiff must show

102. 724 F.2d 327 (2d Cir. 1983).

103. See Oddi, *supra* note 97, at 30.

104. See, e.g., *Ives Laboratories, Inc., v. Darby Drug Co.*, 601 F.2d 631, 642-43 (2d Cir. 1979) (citing *Crescent Tool* for the proposition that “[i]mitation of the physical details and designs of a competitor’s product may be actionable, if the particular features imitated are ‘nonfunctional’ and have acquired a secondary meaning”); *Le Sportsac, Inc. v. Dockside Research, Inc.*, 478 F. Supp. 602, 606 (S.D.N.Y. 1979) (referring to the *Crescent Tool* passage discussing “nonfunctional” imitation of a competitor-product’s features); *Wembley, Inc. v. Diplomat Tie Co.*, 216 F. Supp. 565, 587 (D. Md. 1963) (finding that even where the fabric label was held to be a non-functional feature, one may copy such a feature unless it has acquired a secondary meaning); *Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670, 677 (S.D.N.Y. 1963) (quoting the passage from *Crescent Tool* where Hand claims that nonfunctionality is defined by whether or not the mark has secondary meaning and relying on that quotation for the now dated proposition that first a court must find confusion and then grant relief only if the copied item is nonfunctional); *Silvers v. Russell*, 113 F. Supp. 119, 123 (S.D. Cal. 1953) (stating the same proposition). Some courts have come closer to what Hand was saying in *Crescent Tool* but still seem to overstate Hand’s language. See, e.g., *Kingsway, Inc. v. Ray Werner*, 233 F. Supp 102, 104 (E.D. Mo. 1964) (“A person could legally copy a nonfunctional part of an article unless the originator proved two things: First, that a certain feature of the originator’s product had acquired a ‘secondary meaning,’ thereupon identifying the source of the product to prospective buyers; second, that buyers are likely to confuse the imitation with the original”). Although the law today does require a bifurcated analysis—first determining whether the trade dress is inherently distinctive or has secondary meaning and second, if the mark

that the trade dress has secondary meaning¹⁰⁵ (or is inherently distinctive) and that the trade dress is not functional.¹⁰⁶ Although this is now the “Law and the Prophets” on this subject according to the Supreme Court,¹⁰⁷ the concept did not come from Hand in *Crescent Tool* and any such reliance is misplaced.

Crescent Tool is actually most significant because it marks the beginning of Hand’s restrictive view of trademark rights. Although often given credit for developing the law of intellectual property, in trademark jurisprudence, from his very first trademark opinion while on the Second Circuit, Hand became a formidable obstacle to the expansion of trademark rights in the United States.¹⁰⁸

The next trademark opinion by Hand was also a trade dress case. In *Shredded Wheat Co. v. Humphrey Cornell Co.*,¹⁰⁹ Hand found that the shape of the shredded wheat biscuit was protectable trade dress and enjoined the defendant from copying the biscuit’s shape without marking it in some manner to identify it as separate from the plaintiff’s product. In Hand’s terms, the level of secondary meaning required was “the long monopoly of the plaintiff.”¹¹⁰

Although the outcome is different than *Crescent Tool*, Hand’s reasoning was the same. In fact, *Shredded Wheat* is an example of a case where Hand was able to apply his source motivation theory to a specific case in which the plaintiff prevailed.¹¹¹ According to Hand’s source motivation theory, the plaintiff will prevail only if it can show that the trade dress had secondary meaning and secondary meaning is determined by the motivation of the purchaser. In *Shredded Wheat*, Hand defined secondary meaning as a near monopoly on the design recognized by nearly everyone in the industry as emanating from the plaintiff.

is functional—it did not come from the actual language of *Crescent Tool*.

105. Secondary meaning is shown when the trade dress signifies a single source in the minds of the relevant purchaser. See *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Bonito Boats v. Thundercraft Boats*, 489 U.S. 141 (1989); *In re Mogen David Wine Corp.*, 372 F.2d 539 (C.C.P.A. 1967).

106. A trade dress can be functional, and therefore not deserving of protection, in two ways: mechanically functional or aesthetically functional. Mechanical functionality exists when the design gives the manufacturer a competitive advantage, the design provides a cheap pricing advantage, alternatives are not available, or the feature consists of the product itself. See *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332 (C.C.P.A. 1982) (holding that a spray bottle design is registrable); *In re Weber-Stephen Prods. Co.*, 3 U.S.P.Q.2d 1659 (T.T.A.B. 1987) (holding that a grill design is registrable); *Merchant & Evans, Inc. v. Roosevelt Bldg. Prods. Co.*, 963 F.2d 628 (3d Cir. 1992) (holding that a metal roofing system design is not registrable). A trade dress is aesthetically functional and therefore not protectable when the aspect is significant to the product, others need the aspect in order to compete, or a company is granted a perpetual monopoly on an unpatented aspect of the product via such recognition. See *Keene Corp. v. Paraflex Industries*, 653 F.2d 822 (3d Cir. 1981); *Pagliari v. Wallace China Co.*, 198 F.2d 339 (9th Cir. 1952); see also JANE GINSBURG ET AL., TRADEMARK AND UNFAIR COMPETITION LAW (1991).

107. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S. Ct. 2753 (1992).

108. Even though *Crescent Tool* should be read as a restriction on the expansion of trademark rights, Hand further confined its application in his last trademark opinion. See *American-Marietta Co. v. Krigsman*, 275 F.2d 287, 289 n.2 (2d Cir. 1960).

109. 250 F. 960 (2d Cir. 1918).

110. *Id.* at 963.

111. See Oddi, *supra* note 97, at 28.

This is still extremely restrictive rhetoric. Very few trade dresses possess this level of secondary meaning.¹¹²

Shredded Wheat has not been well received. This point, of course, has been lost to those that contribute to the canonization of Hand. Some judges and commentators revel in pointing out how rarely the Supreme Court overturned a Hand decision.¹¹³ However, when addressing the same issue Hand faced in *Shredded Wheat*—whether the shredded wheat biscuit was protectable trade dress—the Supreme Court held that the biscuit was generic and therefore improper for trademark protection.¹¹⁴ In fact, Justice Brandeis' opinion in *Kellogg Co. v. Nabisco* specifically criticizes the plaintiff's attempt to extend the life of a design patent by resorting to trade dress law—precisely Hand's reasoning on the subject.

Furthermore, even the Second Circuit overruled this case *sub silentio*.¹¹⁵ Therefore, to argue that a judge's cases were rarely overturned by the Supreme Court does not necessarily mean that that judge's opinions are all applicable, relevant, or even good law today.

For example, one of the most restrictive opinions that Hand wrote came less than a year after *Yale Electric Corp. v. Robertson*—one of his most expansive. In *Cheney Bros. v. Doris Silk Corp.*,¹¹⁶ Hand refused to recognize what today would easily be called the plaintiff's trade dress. In *Doris Silk*, the plaintiff manufactured silk scarves. The specific patterns it chose came to represent the plaintiff. The plaintiff argued that the patterns on the silk acted as a trade dress that was owned by the plaintiff and that the plaintiff, therefore, should be able to enjoin the use by others of the same designs.

Hand vehemently opposed such a possibility. Because he could find no positive law mandating that he grant protection to the owner of the silk, Hand concluded the exact opposite: "In the absence of some recognized right at common law, or under the statutes—and the plaintiff claims neither—a man's property is limited to the chattels which embody his invention."¹¹⁷ This statement is one of many clear examples of how legal positivism shaped Hand's judicial theory, and thereby restricted the development of trademark rights.

In *Doris Silk*, the plaintiff relied upon *INS v. AP*.¹¹⁸ In *INS*, the Supreme Court held that there was a property right to be free from competition and dissemination of the news for a limited period of time, and that that right was infringed if a competitor copied an East-coast news story and broadcast it on the

112. See, e.g., *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S. Ct. 2753, 2761 (1992).

113. See, e.g., WYZANSKI, *supra* note 2.

114. *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938).

115. See *Warner Brothers, Inc. v. Gay Tools, Inc.*, 724 F.2d 327 (2d Cir. 1983); see also Oddi, *supra* note 97, at 31.

116. 35 F.2d 279 (2d Cir. 1929).

117. *Id.* at 280.

118. 248 U.S. 215 (1918).

West coast before the owner of the original story could do so.¹¹⁹ The Supreme Court found that the plaintiff had a property right to be free of unfair competition. Analogously, the plaintiff in *Doris Silk* argued that if there was a property right to be free from unfair competition when assembling and disseminating the news, then there was certainly a property right to be free of unfair competition when the defendant copied the patterns of silk that had come to represent the plaintiff. In fact, Hand, in a memorandum to the other judges on this case, admitted:

I confess that the Associated Press Case is somewhat of a stumbling block, but I do not believe that the five justices who united in Pitney, J's opinion meant to lay down a general rule that a man is entitled to "property" in the form of whatever he makes with his labor and money, so as to prevent others from copying it. To do so would be to short-circuit the Patent Office and throw upon courts the winnowing out of all such designs that might be presented. While I agree that on principle it is hard to distinguish, and that the language applies, I cannot suppose that any principle of such far-reaching consequence was intended. It will make patent cases an exception; it will give to State courts jurisdiction over inventions; it will overthrow the practice of centuries.¹²⁰

In the memorandum regarding *Doris Silk*, Hand is clearly obsessed with protecting the patent laws from being preempted by what has now become known as trade dress protection. It appears that the language in the first sentence of the quotation above, regarding labor as a justification for property, is a rather thinly veiled statement regarding Locke's labor theory as a natural rights justification for property. Hand's fear of the potentially broad-reaching effects of such a conclusion is very similar to the fears as expressed by some of the famous legal positivists in response to natural law philosophy.¹²¹

In *Doris Silk*, however, one does not really get a sense that Hand was at all troubled by *INS*, although his private writings clearly show that he was. Rather, Hand artfully limited *INS* to its facts and even criticized it. Hand argued that to understand it otherwise would mean that the Supreme Court intended to create a common law patent or copyright for the reasons of justice.¹²² This, Hand argues,

119. *Id.* at 239-40.

120. Memorandum from L. Hand to Manton and Swan (Oct. 8, 1929) (copy on file with the *Pacific Law Journal*). Original Hand Memoranda are located at the Harvard University Law Library.

121. See, e.g., HART, *supra* note 55, at 206.

122. Not all courts have agreed. In *Santa's Workshop, Inc. v. Sterling*, 122 N.Y.S.2d 488, 489 (N.Y. Sup. Ct. 1953), the court relied upon *INS* for the proposition that the law of unfair competition no longer requires that a plaintiff's business and advertising acquire secondary meaning. Although this was true after *Taco Cabana* provided that trade dress is inherently distinctive, it was not true in the Second Circuit at the time. Rather, *Santa's Workshop* identifies the worries that Hand and others had of the natural rights justification of intellectual property if applied expansively.

“would flagrantly conflict with the scheme which Congress has for more than a century devised to cover the subject matter.”¹²³

Hand was, naturally, correct and not misleading when he stated it would be unconstitutional for the Supreme Court to legislate. Hand was quite successful in restricting the application of *INS* in subsequent cases in the Second Circuit¹²⁴ and by reference in other circuits as well.¹²⁵

However, the fact remains that *INS* probably should have dictated a different result in *Doris Silk*, as Hand recognized. Merely artfully saying that a specific Supreme Court opinion is limited to its facts begs the question of whether it dictates a different outcome. And, more importantly, why was it that Hand was so afraid of applying *INS* expansively, granting the plaintiff in *Doris Silk* an injunction and recognizing a property interest in the silk designs?

Juxtaposing these two cases makes Hand's philosophical orientation even more obvious. Hand clearly took issue with the natural rights concepts prevalent in *INS*.¹²⁶ To Hand, unless there was some clear “positive policy”¹²⁷ on the subject, he could not create new trademark rights no matter what he was morally inclined to do.

In taking an extreme natural rights perspective in *INS*, the Supreme Court potentially greatly expanded the subject matter. To the Supreme Court in *INS*, regardless of what the law on the subject was, it was morally wrong to allow AP to continue to steal *INS*'s news before *INS* could disseminate it. Therefore, the Supreme Court used a natural rights theory of intellectual property protection to justify the grant of the injunction. *INS* owned the news merely because “they got

123. *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279, 280 (2d Cir. 1929).

124. *See, e.g., RCA Mfg. Co. v. Whiteman*, 114 F.2d 86 (2d Cir. 1940), *cert. denied*, 311 U.S. 712 (1940).

125. Baird, *supra* note 13, at 411-23.

126. *See id.* at 420. In restricting the application of *INS*, Hand is in good company. There has been a glut of scholarship recently criticizing *INS* from a variety of perspectives. *See, e.g., Wendy J. Gordon, On Owning Information: Intellectual Property and the Restitutory Impulse*, 78 VA. L. REV. 149, 178 (1992) (asserting that the natural rights justification for intellectual property where the misappropriation doctrine as stated in *INS* prohibited the defendant from reaping where it has not sown—that there are quasi-property rights in information—is so poorly reasoned that response is difficult); Baird, *supra* note 13, at 411 (creating new common law rights in intellectual property, as *INS* did, forces judges to assess and confront first principles—common law judges are not equipped to face first principles; therefore, cases such as *INS* open the door to granting irrational rights following a natural rights concept of fairness rather than the economic incentive theories of intellectual property); James Boyle, *A Theory of Law and Information: Copyright, Spleens, Blackmail, and Insider Trading*, 80 CAL. L. REV. 1413, 1446-47 (1992) (asserting that the economic incentives theories justifying copyright protection are wrong, and that the economic theories of *INS* could convert the public domain into a fallow landscape of private plots); Pamela Samuelson, *Information as Property: Do Ruckelshaus and Carpenter Signal a Changing Direction in Intellectual Property Law?*, 38 CATH. U. L. REV. 365, 388-89 (1989) (finding *INS* worthy of study “because the majority’s struggle to articulate its property theory is impossible to untangle from its unfair competition analysis”). For an extensive analysis of Hand’s treatment of *INS*, see Paul Goldstein, *Federal System Ordering of the Copyright Interest*, 69 COLUM. L. REV. 49 (1969).

127. *Oakland Chem. Co. v. Bookman*, 22 F.2d 930, 931 (2d Cir. 1927).

there first” and because they exerted some effort in getting and disseminating that news. The right to enjoin AP was created because any other outcome was morally wrong. That is, morality prevailed in *INS*.¹²⁸

This is the polar extreme of Hand’s personal philosophy regarding the role of a judge. As a legal positivist, Hand believed that one’s personal morality should be kept completely separate of the equation. The judge should look at the existing law. If the law dictated an injunction, it should be granted; if not, it would be inexcusable to insert one’s arbitrary morality to determine the outcome. How a judge felt the outcome “should” be had to be kept separate from what the law dictated.

Therefore, as a legal positivist, Hand felt he was bound to the law as it existed and stated as an expression of the will of the state. Because he found no remedy for the plaintiff in *Doris Silk*, he apparently felt powerless to generate one merely for the sake of justice. *INS* may be a rather extreme example of the natural rights view of intellectual property protection, but *Doris Silk* is a rather extreme example of how legal positivism influenced Hand’s decision-making process and the actual outcome of the case.

Doris Silk is an example of the worst-case scenario for Hand as the legal positivist. Confronted with an opinion from the highest court in the land, which he was bound by *stare decisis* to follow, and with which he personally disagreed, this case represented a real conceptual problem for Hand. Hand resolved the dilemma by merely concluding that the facts of *INS* were distinguishable. In subsequent cases where *INS* may have dictated a different outcome, Hand cited himself for the proposition that *INS* should be construed narrowly and only applied to identical facts.¹²⁹ In fact, following Hand’s lead, the entire Second Circuit appears to have attempted to do its best to circumscribe the application of *INS*.¹³⁰

Contrary to Hand’s deepest fears about the results of granting trade dress protection, extremely expansive protection of trade dress has not made patent cases an exception, has not given the States jurisdiction over inventions, nor has it specifically overthrown the practice of centuries. Once again, subsequent common law regarding trademark jurisprudence has not borne out Hand’s concerns.

A further example of this legal positivism in a Hand trade dress case was *My-T Fine Corp. v. Samuels*.¹³¹ There Hand found the trade dress of the plaintiff valid

128. See Baird, *supra* note 13, at 419-20.

129. See, e.g., *RCA Mfg. Co. v. Whiteman*, 114 F.2d 86, 90 (2d Cir. 1940), *cert. denied*, 311 U.S. 712 (1940).

130. *United States Golf Ass’n v. St. Andrews Sys.*, 749 F.2d 1028, 1036 (3d Cir. 1984); *G. Ricordi & Co. v. Haendler*, 194 F.2d 914, 916 (2d Cir. 1952); *Millinery Creators’ Guild, Inc. v. FTC*, 109 F.2d 175 (2d Cir. 1940), *aff’d*, 312 U.S. 469 (1941).

131. 69 F.2d 76 (2d Cir. 1934).

and infringed when the defendant intentionally copied the plaintiff's dress. When the defendant "had not the slightest original interest in the [trade dress] chosen and their distribution, [defendant] could only have meant to cause confusion, out of which they might profit by diverting the plaintiff's customers."¹³² That is, once again Hand rigidly adhered to what he referred to as "the Law and the Prophets" on the subject¹³³—unless trade is actually diverted or the defendant clearly intends such a diversion, no injunction will issue.

This is further evidenced by Hand's trade dress opinion in *American Chiclé Co. v. Topps Chewing Gum*.¹³⁴ There, even though there was evidence of some actual confusion, Hand said that confusion alone did not justify the injunction. Rather, the "patent effort to catch [careless] buyers"¹³⁵ justified the injunction. And, of course, the converse seems to be implied: unless the plaintiff can show such a patent effort, the injunction is unlikely to issue.

This is supported by Hand's memorandum to the other judges sitting on the *American Chiclé* case. In the memorandum, Hand admits that "[i]t is quite true that I am fishing in a pool of mere probability; but why not, in cases like this? I would go far to protect a defendant in his use of any make-up that had importance to him of [sic] itself; but that is not this case . . . is there really any sound reason for letting this defendant poach along the border of the plaintiff's mark?"¹³⁶

In his opinion, Hand articulates his perspective on trademark infringement quite clearly. Hand examines the fact that the Lanham Act requires only a "likelihood of confusion" to support a finding of infringement.¹³⁷ However, Hand rejects the statute as being restrictive and not to be read "*tabula rasa*"¹³⁸ and claims to "construe [the Lanham Act] in the background of the law as it existed in 1946."¹³⁹ For support of this proposition, Hand cites his own opinion in *S.C. Johnson & Sons v. Johnson*.¹⁴⁰ According to Hand, the law prior to the Lanham Act defined infringement "less literally,"¹⁴¹ and therefore he was permitted to do so in *American Chiclé* as well.

Hand's analysis in *American Chiclé* demonstrates a surprising disregard for the clear language of the Lanham Act and a presumption of the supremacy of judge-made law over the codified law. This is surprising in light of Hand's pining

132. *Id.* at 77.

133. *Yale Elec. Corp. v. Roberston*, 26 F.2d 972, 973 (2d Cir. 1928).

134. 208 F.2d 560 (2d Cir. 1953).

135. *Id.* at 563.

136. Memorandum from L. Hand to Swan and A. Hand, at 2 (Oct. 28, 1953) (copy on file with the *Pacific Law Journal*).

137. 15 U.S.C.A. § 1114 (West 1995).

138. *American Chiclé Co.*, 208 F.2d at 562.

139. *Id.*

140. *Id.* n.3; see *S.C. Johnson & Son v. Johnson*, 175 F.2d 176 (2d Cir. 1949).

141. *Id.*

for positive policy in this area of the law. When the law was clearly stated by the legislature, Hand chose to disregard it.

Hand's apparent contempt for the Lanham Act is really quite gratuitous in the *American Chicle* case. Clearly, the "likelihood of confusion" test as conceived of in the Lanham Act is intended to be less, rather than more, literal as Hand claimed. That is, the outcome Hand arrived at in *American Chicle* would have been more easily supported by a simple "likelihood of confusion" analysis as courts apply today. Rather, Hand went on to require, in addition to a likelihood of confusion, a balance of the plaintiff's and the defendant's interests. In *American Chicle*, this balancing was manifested by a requirement that a showing be made that the defendant intentionally attempted to "bring in" plaintiff's buyers.

Perhaps only Hand could apply this analysis and succeed in getting people to believe that he was being "less literal" than the Lanham Act when in fact he was doing precisely the opposite. Hand's additional requirement to make a plaintiff show that defendant's use of the plaintiff's mark was an attempt to "bring in" plaintiff's buyers was not the law in 1953 and it is not the law today. To call this analysis "less literal" than the Lanham Act is really quite amazing.¹⁴²

Furthermore, in *Caron Corp. v. Vivaudou, Inc.*,¹⁴³ Hand refused to uphold an injunction where the defendant had allegedly copied the black packaging of perfume used by the plaintiff. The plaintiff manufactured a perfume called "Narcisse Noir" or Black Narcissu. The plaintiff sold the scent in bottles with black stoppers and these bottles were sold in black boxes. The defendant sold an indistinguishable perfume called "Yellow Narcissus" in boxes covered with a floral pattern. The defendant did use an appreciable amount of black on its boxes and in its depiction of a yellow narcissus on the boxes. Hand described these facts in his memorandum to the other judges on this case as "a question so largely of the eye that I can scarcely deal with it in words."¹⁴⁴

The unanimous court found no infringement. In the court's opinion, Hand wrote that "we have no disposition to lay down the limits to a field which is

142. However, it is a fact that in their memoranda to Learned Hand on the *American Chicle* case, both Swan and Augustus Hand voted against Learned Hand to reverse the lower court's finding of infringement. Swan was convinced that the defendant's use of the word "TOPPS" in addition to its use of package designs similar to the plaintiff's would obviate any likelihood of confusion. Swan concluded that the defendant had copied the plaintiff's box "as closely as he dared, but . . . [had] not infringed." Memorandum from Swan to L. Hand and A. Hand (Oct. 26, 1953) (copy on file with the *Pacific Law Journal*). Augustus Hand went even further, stating, in a one paragraph memorandum, that he could see "no basis in this situation for claiming confusion or unfair competition under the Lanham Act." Memorandum from A. Hand to L. Hand and Swan (Oct. 23, 1953) (copy on file with the *Pacific Law Journal*). This is interesting because neither dissented in the final judgment as written by Learned Hand. Therefore, Hand somehow succeeded in convincing them to change their votes in this case. This is especially remarkable because of the extreme position both had taken in their memoranda with regard to the infringement claim.

143. 4 F.2d 995 (2d Cir. 1925).

144. Memorandum from L. Hand to Rogers and Manton (1924, no further date provided in original) (copy on file with the *Pacific Law Journal*).

inevitably vague, beyond observing that it must be a clear case” and that “[i]f there were proof of actual confusion, we could correct our naive impressions.”¹⁴⁵ Not convinced of any actual confusion and apparently swayed by Judge Manton’s argument as articulated in his Memorandum to Hand and Rogers that there was “nothing indicating an intent to pawn off [plaintiff’s] goods,”¹⁴⁶ Hand voted with the majority and reversed the injunction. The language of this case, strongly persuaded perhaps by Manton’s harsh treatment of the plaintiff’s claim, resulted in an overly restrictive treatment of the plaintiff’s rights. Again, Hand required a clear showing of intentionally trading off of the plaintiff’s goodwill before he would support an injunction. This case was decided just one year before *Yale Electric*—the case that would make Hand famous for his expansive view of trademarks.

Once again, subsequent common law has actually been very unkind to Learned Hand. Every court in the United States after 1947 and the passage of the Lanham Act now recognizes that such actual “patent effort” or actual confusion by consumers is not necessary to obtain relief; rather, a plaintiff needs only to demonstrate a likelihood of confusion. Hand’s restrictive notion of requiring a “patent effort” has been completely abandoned and ignored. Furthermore, Hand’s refusal to recognize trademark rights in trade dress has also been dismissed or expressly found to be overly restrictive by various courts.¹⁴⁷

B. *The Aunt Jemima Doctrine*

In 1917, Hand was a member of a three judge panel that heard the appeal of *Aunt Jemima Mills Co. v. Rigney & Co.*¹⁴⁸ This case became famous in the Second Circuit as well as in other circuits for the “*Aunt Jemima Doctrine*.”¹⁴⁹ This doctrine expanded the common law notion of trademarks. Until the *Aunt Jemima Doctrine*, confusion, and therefore infringement, was only possible when the defendant was selling exactly or nearly exactly the same goods on which the plaintiff used the mark. In *Aunt Jemima*, the Second Circuit held that the plaintiff’s rights included the right to enjoin use of the same mark on products that might be expected to come from the plaintiff even if the plaintiff never produced them. “[W]e think that the goods, though different, may be so related

145. *Caron Corp.*, 4 F.2d at 997.

146. Memorandum from Manton to L. Hand and Rogers (1924, no further date provided in original) (copy on file with the *Pacific Law Journal*).

147. See *supra* notes 88-108 and accompanying text.

148. 247 F. 407 (2d Cir. 1917), *cert. denied*, 245 U.S. 672 (1918).

149. See, e.g., *Quality Inns Int’l Inc. v. McDonald’s Corp.*, 695 F. Supp. 198, 210-11 (D. Md. 1988); *General Controls Co. v. Hi-G, Inc.*, 212 F. Supp. 152, 159 (D. Conn. 1962); *S. C. Johnson & Son, Inc. v. Johnson*, 175 F.2d 176, 179 (2d Cir. 1949), *cert. denied*, 338 U.S. 860 (1949); RESTATEMENT OF TORTS §§ 730-731 (1934); Quentin R. Wittrock, Note, *Use of Personal Names in Noncompeting Businesses—Doctrines of Unfair Competition, Trademark Infringement, and Dilution*, 70 IOWA L. REV. 995, 1000 (1985).

as to fall within the mischief which equity should prevent.”¹⁵⁰ Therefore, the court held that use of “AUNT JEMIMA” on syrup infringed the plaintiff’s use on flour.

Aunt Jemima was the most important and most expansive new grant of trademark rights known at the time. Particularly significant is the fact that Hand actually dissented in *Aunt Jemima*,¹⁵¹ although he is often given credit for conceiving the doctrine.¹⁵² Hand felt that Aunt Jemima Mills, the first to use and register the mark “AUNT JEMIMA” for use on flour, had acquiesced in the defendant’s use on syrup. The plaintiff had actually written a letter to the defendant prior to litigation that stated that the plaintiff presumed the defendant could use the mark on syrup without violating any law.¹⁵³

Hand dissented based on his understanding of acquiescence in trademark jurisprudence. Hand cited the leading trademark acquiescence case, *Menendez v. Holt*,¹⁵⁴ but dismissed it saying it did “not support a contrary doctrine.”¹⁵⁵ Hand felt that because Aunt Jemima Mills had actually written to the defendant saying it was Aunt Jemima Mills’ belief that the defendant’s use on syrup did not infringe the plaintiff’s rights, “it surely is wrong to say that . . . the defendant commits a fraud by going on.”¹⁵⁶

Hand’s dissent is significant here for several reasons. First, Hand misrepresents or misstates the law regarding acquiescence. In trademark law, a plaintiff then and today is considered to have acquiesced to the defendant’s use only when “it has been continued so long, and under such circumstances, as to defeat the right itself . . . Acquiescence to avail must be such as to create a new right in the defendant.”¹⁵⁷ It is difficult to see how one letter, early on in the encounter, could completely defeat any rights the plaintiff had in the mark. Clearly, that was not the law then and it is not the law today.

Furthermore, Hand’s dissent is unique in his trademark opinions because it is the rare instance when he allowed his own morality to dictate his proffered

150. *Aunt Jemima Mills Co.*, 247 F. at 409-10.

151. *Aunt Jemima Mills Co.*, 247 F. at 412. This confusion may have resulted from a typographical error in the reporter. Even though Hand’s vote in the case is in dissent, the substantive comments in his dissent are opposite those of the majority, and the reporter lists Hand as dissenting, the caption of the case still labels Hand’s opinion as “concurring.” *Id.* at 413. Mundane as it may appear, this is yet another example of Hand’s reputation outliving and outgrowing what he actually did or said.

152. *See, e.g.*, *General Motors Corp. v. Cadillac Marine & Boat Co.*, 226 F. Supp. 716, 729 (W.D. Mich. 1964) (“[Hand] further found that after the 1905 amendment the Circuit Court of Appeals for the Second Circuit extended the trade-mark act’s umbrella of protection in the case of *Aunt Jemima Mills Co. v. Rigney & Co.* [cite omitted]”).

153. *Id.* at 408.

154. 128 U.S. 514 (1888).

155. *Aunt Jemima Mills Co.*, 247 F. at 412.

156. *Id.*

157. *Menendez v. Holt*, 128 U.S. at 523-24. Today, these facts would never rise to a level of acquiescence. *See, e.g.*, MCCARTHY, *supra* note 26, § 23.24 (citing *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1362 (C.C.P.A. 1973), for the proposition that a “naked consent” carries little weight in rising to acquiescence).

outcome in the case. Hand strictly construed his role as a judge to mean that he must apply the law and not apply his own emotions. His dissent in *Aunt Jemima* is a rare instance where he crossed this line.

The common law at the time would have allowed Hand (a young and unknown district court judge at the time) to quietly agree with the majority at least on the issue of acquiescence. However, Hand chose to take the position that it was just “wrong”¹⁵⁸ to allow a plaintiff that originally signals a defendant that it does not consider the defendant’s conduct to be an infringement to then change course and call the defendant’s conduct a fraud. This even though *Menendez* and other cases would allow for such a distinction provided the plaintiff subsequently reasserted its trademark rights in some way (as the plaintiff did in *Aunt Jemima*).

Therefore, dissenting in *Aunt Jemima*, Hand took the rare stance that the law as written is basically wrong and the plaintiff, morally speaking, should not be allowed to prevail. He further emphasized that the focus of his dissent was on the plaintiff’s moral conduct because he ended with an express statement that he dissented only because he felt the facts compelled a denial of the plaintiff’s motion based upon acquiescence, and reserved comment on the plaintiff’s original trademark rights.¹⁵⁹

Hand further expanded the *Aunt Jemima* Doctrine—even though he had dissented in that case—into what became known as the Hand Doctrine in 1928 in *Yale Electric Corp. v. Robertson*.¹⁶⁰ As originally conceived, the Hand Doctrine stood for the principle that if an article bearing a copied symbol was a product that may be understood to have emanated from the plaintiff, the defendant’s use of such a mark should be enjoined.¹⁶¹ As we shall shortly see, the Hand Doctrine soon came to stand for the exact opposite proposition.¹⁶²

Oddly enough, Hand’s reputation in trademark jurisprudence largely stems from *Yale Electric*; however, after writing the opinion, Hand spent the rest of his judicial career confining its application.

In *Yale Electric*, a rather tortured opinion that stands out in his trademark cases, Hand affirmed the dismissal of a bill in equity to compel the Commissioner of Patents to register the mark “YALE” as used on flashlights and batteries because of the prior use of the identical mark by Yale & Towne Manufacturing Co. on locks and keys. Hand held that “it has come to be recognized that, unless the borrower’s use is so foreign to the owner’s as to insure against any

158. See *Aunt Jemima Mills Co.*, 247 F. at 412.

159. *Id.* at 413.

160. 26 F.2d 972 (2d Cir. 1928).

161. Julius R. Lunsford, Jr., *Trademark Infringement and Confusion of Source: Need For Supreme Court Action*, 35 VA. L. REV. 214, 217 (1949).

162. See *infra* notes 180-97 and accompanying text.

identification of the two, it is unlawful.”¹⁶³ Hand cited *Aunt Jemima* as well as a host of other cases from other circuits as controlling.¹⁶⁴

Under the Trademark Act of 1905, a registration would be refused if the mark was used on goods of the same descriptive properties as that of a prior user.¹⁶⁵ Therefore, the inquiry in *Yale Electric* was whether flashlights and batteries were of the same descriptive properties as locks and keys. Hand stated that the “heart of the matter”¹⁶⁶ on this subject was what the trade believed despite the language of the 1905 Act. Therefore, even though Hand clearly did not believe that locks and keys were of the same descriptive property as flashlights and batteries,¹⁶⁷ because the trade apparently had come to believe that they were, Hand felt compelled to “do some violence to the language” of the 1905 Act, and refuse the registration.¹⁶⁸

In fact, once again, this case is quite instructive of Hand’s judicial philosophy. Even though he obviously felt that use of a mark on locks and keys *should not* be grounds for preventing use of the same mark on flashlights and batteries, he was constrained by the positive law on the subject. The law, at the time, was dictated by the Second Circuit’s opinion in *Aunt Jemima*, which he felt bound to follow, even though he had dissented.

That is, even though Hand clearly would have preferred the opposite outcome in *Yale Electric*, he separated his own moral feelings from the inquiry and made his determination based on existing law. In the process, he even felt he was doing “violence” to the language of the 1905 Act, but even that did not allow him to escape the quandary of interpreting the statute as being opposed to the common law. After all, the 1905 Act was supposed to be a codification of the common law.¹⁶⁹ Therefore, placed between the two, Hand refused to apply his morals and instead applied the law from his Circuit.

163. *Yale Elec. Corp.*, 26 F.2d at 974.

164. *Id.*

165. Act of Feb. 20, 1905, ch. 592, § 7, 33 Stat. 724, 726.

166. *Yale Elec. Corp.*, 26 F.2d at 974.

167. *See id.* (“[F]or the fact that flash-lights and locks are made of metal does not appear to us to give them the same descriptive properties . . .”).

168. *Id.*

169. *See, e.g., American Trading Co. v. H.E. Heacock Co.*, 285 U.S. 247, 256-57 (1932) (giving priority to subsequent trademark registration in the Philippines because Congress had the express authority to create trademark rights there and not in the United States); *American Steel Foundries v. Robertson*, 269 U.S. 372, 381 (1926); *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 99 (1918) (“registration of the [petitioner’s] trade-mark under . . . the act of Congress [did not have] the effect of enlarging the rights of [petitioner] beyond what they would be under common-law principles”). *But cf. Philco Corp. v. Phillips Mfg. Co.*, 133 F.2d 663, 668 (7th Cir. 1943) (stating that Congress had the authority to create substantive trademark rights and did so in the Act of 1905); Theodore H. Davis, Jr., *Lever Bros. v. United States and the Legality of Gray Market Imports: A New Shield for United States Trademark Owners in Transactional Markets*, 28 WAKE FOREST L. REV. 571, 575 (1993) (“Congress augmented the protection afforded to mark owners under the common law by passing the Trademark Act of 1905”); Port, *supra* note 14, at 527-28.

This is a contrary result to the same dilemma Hand faced when deciding *Doris Silk* in light of the contrary precedent from the Supreme Court in *INS*. In that instance, Hand artfully dodged the Supreme Court's precedent. Here, however, Hand accepted as controlling the Second Circuit's precedent in *Aunt Jemima*. This conceptual flip-flop makes the study of Hand's trademark jurisprudence admittedly slippery. However, one thing is certain. In Hand's later cases, it became quite clear that Hand wanted to revert trademark jurisprudence to the form in which it existed prior to *Yale Electric*. After *Yale Electric*, and especially in his later trademark cases, Hand was convinced that there was no positive policy that had changed the law of trademarks and that a trademark owner could only recover if it could prove an actual loss of sales or an actual intent to divert sales.

Although commonly cited in casebooks as well as by other commentators as typical of Hand's expansive thinking on the subject of trademark law,¹⁷⁰ *Yale Electric* actually stands out as an anomaly when compared to the rest of Hand's trademark jurisprudence. No other Hand opinion goes so far in the application of the related goods doctrine.

Its closest rival is *L. E. Waterman Co. v. Gordon*.¹⁷¹ In that case, Hand held that it was "wanton" infringement for the defendant to use the mark "WATERMAN" on pens when the plaintiff was a well-established manufacturer of WATERMAN razor blades. In *Waterman*, Hand again cited *Aunt Jemima* and his own *Yale Electric* as controlling authority for the proposition that the firstcomer to a mark may enjoin other uses provided such other uses "might naturally be supposed to come from him."¹⁷² Even though Hand held in favor of the expansive view of the related goods doctrine in *Waterman*, he intentionally restricted its application and foreshadowed things to come when he stated that the case rested on the theory that second-comers may not tarnish the reputation of the firstcomer, and may not interfere with the natural expansion of the firstcomer's use.¹⁷³

The *Aunt Jemima* Doctrine was also addressed in *Emerson Electric Mfg. Co. v. Emerson Radio & Phonograph Corp.*¹⁷⁴ There Hand stated that it had become "settled" that if one merchant establishes a business under a mark used on specific goods, a second merchant may not use the same mark in selling other goods if the goods are so like the first merchant's that the public will believe the first

170. See GINSBURG ET AL., *supra* note 106, at 44.

171. 72 F.2d 272 (2d Cir. 1934).

172. *Id.* at 273.

173. *Id.* at 274.

174. 105 F.2d 908 (2d Cir. 1939), *cert. denied*, 308 U.S. 616 (1939).

merchant was selling them.¹⁷⁵ *Emerson* is often cited as supporting the proposition that Hand believed in this expansive view of trademarks.¹⁷⁶

In *Emerson*, the plaintiff had been selling electric motors and related hardware in the electricity industry for many years. The defendant originally made phonographs and records. The dispute arose when the defendant expanded its business to include radios. Unbeknownst to the defendant, the plaintiff had also attempted to enter the radio field but had apparently not been successful. The plaintiff never actually marketed any radios but only sold a generator to supply power to a radio transmitter.

Those that cite *Emerson* in the canonization of Learned Hand fail to point out that the plaintiff there actually failed and was harshly criticized by Hand. The summary of the Hand Doctrine that Hand proffers in the opinion—that is so often cited and quoted—is very obviously dicta. The entire discussion follows the introductory clause, “The doctrine upon which the plaintiff must rely” Following that dictum, Hand then ridiculed the plaintiff’s position and concluded that it was “peculiarly without merit”¹⁷⁷ because the defendant could not have known of the plaintiff’s intent to expand into the radio field.

Emerson was an opportunity to apply the *Aunt Jemima* Doctrine literally. The original user of the mark was now expanding its use of the mark to related goods. A newcomer had interfered. If flashlights and batteries were sufficiently similar to locks, then clearly radios could be called similar enough to the generators that supplied electricity to power the radio. Hand, however, declined the invitation to apply *Aunt Jemima* when he found that no infringement existed in *Emerson*.

Therefore, it is wrong to conclude that *Emerson* is in any way supportive of the *Aunt Jemima* Doctrine. In fact, even though the facts clearly allowed for its application, Hand’s refusal to do so should rather be read as foreshadowing things to come. And it did.

After *Waterman*, however, it appears that Hand drew the line. Subsequent cases by Hand regarding trademark infringement all take a remarkable shift and become extremely restrictive. *Waterman* was the last case where Hand applied the *Aunt Jemima* Doctrine to the benefit of the plaintiff. Since 1940, Hand refused to

175. *Id.* at 910.

176. *See, e.g.,* Freedom Savings & Loan Ass’n v. Way, 583 F. Supp. 544, 551-52 (M.D. Fla 1984) (citing Hand for his *Emerson* ruling and applicability of the “Doctrine of Expansion”), *aff’d*, 757 F.2d 1176 (11th Cir. 1985), *cert. denied*, 474 U.S. 845 (1985); Artcraft Novelties Corp. v. Baxter Lane Co. of Amarillo, 685 F.2d 988, 990-91 (5th Cir. 1982) (quoting a statement in Hand’s *Emerson* opinion in reference to the “expansion of business” doctrine); Palmer v. Gulf Pub. Co., 79 F. Supp. 731, 733-34 (S.D. Cal. 1948); Stardust, Inc. v. Weiss, 79 F. Supp. 274, 278 (S.D.N.Y. 1948) (explaining the application of Hand’s extended protection ruling in *Emerson*).

177. *Emerson Elec. Mfg. Co.*, 105 F.2d at 911.

apply the *Aunt Jemima* Doctrine¹⁷⁸ and, in fact, worked very diligently the rest of his judicial career restricting and circumscribing its application.¹⁷⁹

C. *The Real Hand Doctrine*

Prior to 1940, the so-called “Hand Doctrine” stood for the ideas expressed by Hand in *Yale Electric*—that is, if an article bearing a copied trademark was a product that may be understood to have emanated from the plaintiff, the defendant’s use would be enjoined. Subsequent to 1940, however, the Hand Doctrine came to identify those cases in which Hand required that actual confusion or deceit be shown before the plaintiff could prevail. Therefore, Hand came full circle. Very artfully and with no debate or comment, the Hand Doctrine after 1940 came to stand for the near opposite proposition—that is, actual confusion must be shown by the plaintiff to prevail.¹⁸⁰

After 1940, Hand found in favor of the plaintiff in only four of the twelve trademark opinions he wrote.¹⁸¹ In all of those cases, the infringement was obvious and wanton—precisely satisfying the real Hand Doctrine. After 1940, a trademark owner had very little chance of success before Learned Hand.

This is not to imply that Hand was not hostile to trademark owners’ rights prior to 1940. In fact, excluding *Yale Electric*, *Waterman* and his apparent support of the *Aunt Jemima* Doctrine early in his career, Hand continually allowed legal positivism to influence his perspective on the role of a judge and thereby restrict the outcome of his trademark cases.

178. Hand refused to apply the *Aunt Jemima* Doctrine except in the case of *Adolph Kastor & Bros., Inc. v. F.T.C.*, 138 F.2d 824, 826 (2d Cir. 1943), which enjoined a defendant from using “SCOUT KNIFE” on knives in light of the plaintiff’s established secondary meaning. In *Adolph Kastor*, Hand found that there was evidence to support the finding that the defendant was purposefully “misleading others into supposing that its goods were countenanced or authorized by the Boy Scouts.” Memorandum from L. Hand to Swan and Frank, at 2 (Oct. 21, 1943) (copy on file with the *Pacific Law Journal*). Furthermore, Hand states, “[n]obody has challenged the statute; so why should we?” *Id.*

179. See *S.C. Johnson & Son v. Johnson*, 175 F.2d 176, 179 (2d Cir. 1949) (containing Hand’s express statement that it was imperative that the *Aunt Jemima* Doctrine be “circumscribed”).

180. Hereinafter this concept is referred to as the “Real Hand Doctrine” to distinguish it from the Hand Doctrine that at one point meant the holding in *Yale Electric*.

181. *Artype, Inc. v. Zappulla*, 228 F.2d 695, 696-97 (2d Cir. 1956) (holding that the trademark “ARTYPE” as used for acetate sheets containing letters and symbols to be cut and used in preparing advertising copy was valid and infringed by the user of “ART-TYPE” in direct competition); *American Chiclé Co. v. Topps Chewing Gum*, 208 F.2d 560, 562-63 (2d Cir. 1953) (holding that even though actual confusion exists, an injunction issues because of a patent effort to catch unsuspecting purchasers); *G.H. Mumm Champagne v. Eastern Wine Corp.*, 142 F.2d 499, 500-01 (2d Cir. 1944) (deciding an injunction should issue upon facts showing that the plaintiff used a red stripe across its label on its bottle of imported champagne and the defendant did the same on domestic champagne using the same color, essentially imitating the plaintiff’s label), *cert. denied*, 323 U.S. 715 (1944); *Adolph Kastor & Bros., Inc. v. F.T.C.*, 138 F.2d 824, 825 (2d Cir. 1943) (containing Hand’s conclusion that the term “SCOUT” as used on pocket knives was a word of common speech which all are *prima facie* entitled to use, but because the Boy Scouts had attained secondary meaning in the mark, they could prevent the use of SCOUT on pocket knives).

For example, as early as 1927, the year before he wrote the now famous *Yale Electric* opinion, Hand refused to allow an injunction in *Oakland Chemical Co. v. Bookman*.¹⁸² There, Hand took the unusual position that a mark may be both suggestive and yet still describe the attribute of the good on which it is used because “there is no positive policy that forbids the combination.”¹⁸³ Hand’s concern was that he could “see no reason why a man who wants a trade name should be allowed to come just as near as he can to monopolizing the tongue and then say that he only partly succeeded in describing, that he has only half-described, his goods.”¹⁸⁴ Once again, Hand felt constrained by a lack of what he perceived of as a “positive policy” that would have allowed him to decide an issue differently.

Even in cases where the plaintiff prevailed, such as *American Medicinal Spirits Co. v. United Distillers, Ltd.*,¹⁸⁵ there were foreshadowings of the more restrictive Learned Hand. There, Hand affirmed an injunction against a defendant for infringing “BOURBON DE LUXE” as used in connection with the sale of whiskey. The defendant, Hand argued, had committed “brazen” infringement and was “trying to prey upon the plaintiff’s business.”¹⁸⁶ As such, this was an easy case for Hand. There was plenty of positive policy to justify an injunction in such circumstances.

By 1936, Hand was strictly construing any rights that might be granted a trademark holder. In *Landers, Frary & Clark v. Universal Cooler Corp.*,¹⁸⁷ Hand refused to issue an injunction against the defendant that purposefully used the plaintiff’s mark “UNIVERSAL” on its refrigerators (provided it added “COOLER” to the mark) because the plaintiff had been in negotiations for eight years to get the defendant to either jointly manufacture the products or cease use. Hand said “Equity will not upset what has been founded upon such solid ground”¹⁸⁸ Therefore the plaintiff was estopped from asserting its trademark rights.

However, Hand later confessed that his handling of the plaintiff’s trademark rights “was a rather vigorous handling of the words of the statute, I confess, but I am not disposed to go back on it, perhaps because it was my own baby.”¹⁸⁹ This remark is surprising because he never mentioned a statute in the *Landers* opinion, but seemed to rely exclusively on the acquiescence argument found at common

182. 22 F.2d 930 (2d Cir. 1927).

183. *Id.* at 931.

184. Memorandum from L. Hand to Manton and Swan, at 1 (Nov. 17, 1927) (copy on file with the *Pacific Law Journal*).

185. 76 F.2d 124 (2d Cir. 1935).

186. *Id.* at 125.

187. 85 F.2d 46 (2d Cir. 1936).

188. *Id.* at 49.

189. Memorandum from L. Hand to Chase and Clark, at 2 (Nov. 18, 1940) (copy on file with the *Pacific Law Journal*).

law. Furthermore, he seems to be implying that he was wrong in *Landers* and that some other result may have been appropriate, but that selfish concerns prevailed.

These three cases, however, were just the prelude. After decisively rejecting the *Aunt Jemima* Doctrine in *S.C. Johnson*, Hand reasserted what he believed was “the Law and the Prophets” on the subject. In *American Brake Shoe & Foundry Co. v. Alltex Products Corp.*,¹⁹⁰ Hand held that the plaintiff must be able to show actual confusion before it can prevail. In *American Brake Shoe*, the defendant used the mark “NATIONAL BRAKE BLOCK” for brake linings. The plaintiff argued that this infringed its mark, “AMERICAN BRAKE BLOCK” for the same product. In fact, there was evidence in the record that unscrupulous repair shops would substitute the defendant’s brake shoes on purpose when the customers believed they were getting the plaintiff’s product.

Hand determined that there was no infringement in this case because the *dealers* were getting what *they* expected. Because the dealers knew of the deception and were not confused, there could be no infringement because there was no confusion. Hand stated, “The use of the name can injure the plaintiff only in so far as it results in mistaken buying by the last buyer who accepts the goods because of their name and the [automobile] owner is not such a buyer. To succeed, the plaintiff was therefore bound to show that repair shops or service stations were deceived, and that it failed to do.”¹⁹¹

American Brake Shoe is an excellent example of the “Real Hand Doctrine”—to require actual confusion in the minds of the end user and to circumscribe and avoid the plaintiff’s trademark rights based on “the Law and the Prophets” of the subject as it existed in 1928.

Even in *Dwinell-Wright Co. v. White House Milk Co., Inc.*,¹⁹² where Hand refused to enjoin the mark “WHITE HOUSE” as used on evaporated milk in favor of the plaintiff who used the same mark on coffee and tea, Hand’s legal positivism and hostility toward trademark owners is apparent in dicta. Even though Hand recognized that the defendant had copied the plaintiff’s picture of the “White House” on the label “down to the minutest detail [such] that it [was] impossible to doubt that . . . it copied the original,”¹⁹³ he still refused to issue the injunction because the plaintiff had not pleaded a cause of action for copyright infringement. Given the case law in existence at the time, such conduct was clearly actionable as unfair competition.¹⁹⁴

190. 117 F.2d 983 (2d Cir. 1941), *cert. denied*, 314 U.S. 631 (1941).

191. *Id.* at 984-85.

192. 132 F.2d 822 (2d Cir. 1943).

193. *Id.* at 826.

194. *See, e.g.*, *Grocers Baking Co. v. Siegler*, 132 F.2d 498, 501 (6th Cir. 1942); *Rytex Co. v. Ryan*, 126 F.2d 952, 953-54 (7th Cir. 1942); *Sutter Packing Co. v. Piggley Wiggly Corp.*, 64 F.2d 1006, 1007 (C.C.P.A. 1933).

Hand's opinion in *Durable Toy & Novelty Corp. v. J. Chein & Co.*¹⁹⁵ also stands out as a strange misstatement of the law of trademarks. There, Hand held that in order for the plaintiff to protect its trademark "UNCLE SAM'S," it had to acquire some monopoly in the word, not because the defendant stole customers by masquerading under the plaintiff's name. And, Hand admits, obtaining monopoly interests in the word would run counter to the whole basis of the law on the subject because trademark law never gives property protection to words.

Under this analysis, a trademark owner could never prevail. That is, Hand claims that in order to prevail, the plaintiff must have a monopoly; however, monopolies are contrary to the subject of trademarks and abhorred by courts. Either this is a gross misstatement on behalf of the "greatest judge in the English speaking world," or Hand himself was confused about "the Law and the Prophets" on the subject. According to Hand himself, only when a plaintiff shows that the defendant stole customers by masquerading as the plaintiff can the plaintiff prevail.¹⁹⁶ This is a rather large role reversal for the judge that held that use on locks and keys of one mark precluded registration of the same mark for use on flashlights and batteries because these products had the same descriptive properties.¹⁹⁷

D. The Schizophrenic Second Circuit

Largely based on Hand's judicial philosophy, heavily imbued with legal positivist rhetoric and Hand's intention of restricting the application of the *Aunt Jemima* Doctrine and thereby furthering the Real Hand Doctrine, a substantial split emerged within the Second Circuit after 1940 that has been described by one commentator as "judicial schizophrenia."¹⁹⁸ Hand ultimately became the leader of the faction in the Second Circuit that strongly believed that trademark protection should be very carefully circumscribed. Others, such as Hand's cousin,

195. 133 F.2d 853 (2d Cir. 1943), *cert. denied*, 320 U.S. 211 (1943).

196. *Id.* at 854.

197. *Yale Elec. Corp. v. Robertson*, 26 F.2d 972, 974 (2d Cir. 1928).

198. MCCARTHY, *supra* note 26, § 24.09; *see also*, DONALD S. CHISUM & MICHAEL A. JACOBS, UNDERSTANDING INTELLECTUAL PROPERTY LAW § 5E[3][a] (1992); *cf.* *Hyde Park Clothes, Inc. v. Hyde Park Fashions, Inc.*, 204 F.2d 223, 224 (2d Cir. 1953) (finding that "HYDE PARK" as used on women's clothing did not infringe "HYDE PARK" as used on men's clothing), *cert. denied*, 346 U.S. 827 (1953); *Triangle Publications, Inc. v. Rohrlich*, 167 F.2d 969, 972 (2d Cir. 1948) (ruling that "MISS SEVENTEEN" as used on girdles infringes "SEVENTEEN" as used on magazines); *Standard Brands, Inc. v. Smidler*, 151 F.2d 34, 35-37 (2d Cir. 1945) (holding that the expression "V-8" used on vitamins infringes the "V-8" used on vegetable juice).

Augustus Hand, and Clark, believed in much more liberal application of the *Aunt Jemima Doctrine*,¹⁹⁹ as well as other trademark doctrines.²⁰⁰

In 1940, Hand backed away from a common sense application of the related goods doctrine in *S.C. Johnson & Son, Inc. v. Johnson*.²⁰¹ In *S.C. Johnson*, the plaintiff clearly showed that it had an established market share in floor cleaners, varnishes, enamels, brushes, lacquers, waxes, and furniture polish. The defendant used its own name, which happened to be “Johnson” on its fabric cleaner. Hand upheld the district court’s injunction but drastically limited it to read only that the defendant could not use “JOHNSON” on its products except in combination with the word “cleaner,” or if it included a legend that was equally conspicuous that said “JOHNSON PRODUCT CO. NEW YORK.” Hand admitted that the result may not be the best for the plaintiff but stated that any other remedy would be “too drastic.”²⁰²

Hand analyzed the case in the following manner. The first justification for granting relief under the related goods doctrine was not satisfied. There was no evidence that the defendant’s use tarnished the plaintiff’s reputation in any manner. Any such damage was future oriented and therefore too speculative to warrant relief.

The second justification for granting relief under the related goods doctrine was also unsatisfied. According to Hand, there was no evidence that the plaintiff was likely to expand into fabric cleaners. He considered this interest “less palpable.” Because S.C. Johnson had no specific intention to expand from furniture polish to furniture fabric cleaner, Hand refused the injunction because the goods were too distinct even though he admitted that some confusion might exist from such use. However, it was Hand’s belief that even if such confusion exists, no one appointed the plaintiff in this action to be their “vicarious champion.”

Finally, Hand concluded, if a plaintiff adopts a name as common as “Johnson” for use on its products, it must run the risk that another “Johnson” will come along and will validly, without any attempted unfair competition, want to put its name on its products.

The absurdity of this result is apparent when immediately juxtaposed with Hand’s prior related goods doctrine cases. That is, even though Hand found flashlights and batteries to have the same descriptive properties as locks and keys, and even though he also found razor blades to have the same descriptive properties as pens, he also found that furniture cleaner was distinct enough from

199. MCCARTHY, *supra* note 26, § 24.09[2].

200. *See id.* (containing an excellent description of this feud). This may be an example of why the slogan “Quote Learned, but follow Gus” became popular. *See* Thomson, *supra* note 4, at 764 n.3 (assessing the origins of this slogan).

201. 116 F.2d 427 (2d Cir. 1940).

202. *Id.* at 430.

furniture polish that an injunction would not issue even if the public was deceived.

This factual result was pointed out to Hand while the judges were deliberating the case. In his memorandum to Hand and Chase, Clark clearly argued that *Yale Electric* was “authority for affirming on infringement.”²⁰³ Hand makes no mention of *Yale Electric* in his opinion and does not seem to agree that it dictated a contrary result here, as Clark felt, even though he did not vote that way. It is clear, however, that Clark was not convinced that this was the correct outcome. Upon plaintiff’s petition for rehearing, Clark wrote to Hand and Chase to say that he was “a little nervous about the result here, whether it was not giving the plaintiff more or less a gold brick.”²⁰⁴

For whatever reason, Hand either changed his mind regarding the related goods doctrine, as one commentator has suggested,²⁰⁵ or decided to assert himself in what he perceived as the positive common law on the subject. After all, it was Hand’s opinion that the entire “Law and the Prophets” on the subject of trademarks was simply that one should not represent one’s goods as emanating from another.²⁰⁶ As the expansive view of the related goods doctrine violated that rule, Hand was not prepared to endorse it.

This is supported by Hand’s memorandum to the other judges in this case. Although Hand was much more concerned with the plaintiff’s rights than he articulated in the final opinion,²⁰⁷ he did state in the memorandum that in *Johnson* the plaintiff must rely on the likelihood that the defendant would tarnish the plaintiff’s reputation and that if the plaintiff did decide to expand its business it would find it already occupied by the defendant. However, Hand concluded that “I think we may fairly anticipate that the Supreme Court in its present temper will tend rather to limit than to expand the remedies of merchants for such injuries; and in any case it is plain that the injury is more remote and that demands less drastic relief.”²⁰⁸

Therefore, because of an apparent fear of reversal by the Supreme Court, even though Hand felt that the plaintiff had “shown that confusion ha[d] already actually arisen”²⁰⁹ and “would say that the defendant ha[d] infringed the mark and

203. Memorandum from Clark to L. Hand and Chase, at 1 (Nov. 18, 1940) (copy on file with the *Pacific Law Journal*).

204. Memorandum from Clark to L. Hand and Chase, at 1 (Feb. 7, 1941) (copy on file with the *Pacific Law Journal*).

205. MCCARTHY, *supra* note 26, § 24.09[2].

206. *Yale Elec. Corp. v. Robertson*, 26 F.2d 972, 973 (2d Cir. 1928).

207. See Memorandum from L. Hand to Chase and Clark, at 1 (Nov. 18, 1940) (copy on file with the *Pacific Law Journal*) (“it is equally plain to my mind that the plaintiff has established a right to some kind of relief. Not only has it sown a situation in which confusion was likely to arise because of the near relation of its waxes, polishes, etc., and the defendant’s fabric cleaner; but it has shown that confusion has already actually arisen.”).

208. *Id.*

209. *Id.*

be [sic] guilty of unfair competition,"²¹⁰ Hand refused an outright prohibition even though such an outcome would not have been unprecedented.²¹¹

This is further made clear in Hand's 1950 opinion in *Federal Telephone & Radio Corp. v. Federal Television Corp.*²¹² There, he expressly stated that "[a]lthough there appears to be a persistent belief that the first use of a specific name or description gives a power to the first user to prevent its use by others, it is important to remember that no such doctrine exists."²¹³ Hand refused to enjoin the use of "FEDERAL" as used on televisions even though the plaintiff was well established in the market place for using the mark "FEDERAL" on radios. Hand believed that the purchasers of the respective goods were sophisticated enough that they would not be deceived as to the source of the products.²¹⁴ Therefore, relying on his own opinion from *S.C. Johnson*, Hand coolly dismissed the notion that the plaintiff might wish to extend its products to include televisions, found no actual confusion, and therefore no harm.

In 1949, two years after the Lanham Act was passed, Hand had the opportunity to revisit the *S.C. Johnson* case when the original plaintiff re-petitioned the court claiming that the defendant was in violation of Hand's 1940 opinion. Although Hand had refused an injunction in 1940, he did mandate that the defendant clearly show on its labels that the product was "Johnson's Cleaners" and "made by Johnson Products Company, Buffalo, N.Y."

In *S.C. Johnson II*,²¹⁵ Hand took the opportunity to very selectively review and circumscribe the related goods doctrine in light of the recently enacted Lanham Act. In that case, Hand purported to review the law on the subject in light of the Lanham Act. However, Hand selectively cited marginal cases of limited impact and concluded that Congress could not have meant to change his interpretation of trademark law because if they had, they "would have said so more clearly."²¹⁶

Hand first correctly identified that the Lanham Act changed the statutory language regarding the prerequisite for civil liability from one "affix[ing]" the registered mark "to merchandise of substantially the same descriptive properties," to "'any person who shall in commerce . . . use . . . any reproduction . . . of any registered mark' which 'use is likely to cause confusion or mistake or deceive purchasers as to the source or origin' of the goods."²¹⁷ He claimed that this

210. *Id.* at 2.

211. *Id.*; see Memorandum from Clark to L. Hand and Chase, at 1 (Nov. 18, 1940) (copy on file with the *Pacific Law Journal*); see also *id.* (citing *Thaddeus Davids Co. v. Davids Mfg. Co.*, 233 U.S. 461 (1914)).

212. 180 F.2d 250 (2d Cir. 1950).

213. *Id.* at 251.

214. *Id.*

215. *S. C. Johnson & Son, Inc. v. Johnson*, 175 F.2d 176 (1949) [hereinafter *Johnson II*].

216. *Id.* at 180.

217. *Id.* at 178 (citing the text of the Lanham Act, codified at 15 U.S.C. § 1114(a) (1963)).

changed the law and that the point of *S.C. Johnson II* was to clarify what that change was.²¹⁸

Unfortunately, Hand did not accomplish this task. Rather, he took the opportunity to rewrite history to make it appear as though his restrictive view—the Real Hand Doctrine—was the Law and the Prophets on the subject. Because Hand found no statutory guidance to the contrary, he felt fully justified in continuing to pursue his perspective on the issue.

Hand cited a long line of cases, starting from the 1880s, in an apparent attempt to establish what the common law of the subject was at the time.²¹⁹ The persuasiveness of this line of cases was undercut by Hand himself when he admitted that “the weight of the authority was the other way.”²²⁰

After characterizing the impact of the Lanham Act—which took over ten years to negotiate and enact—on the law of trademarks as a “change of diction,”²²¹ Hand reverted back to his own pre-Lanham Act cases and stated, as if nothing had changed, that the *Aunt Jemima* Doctrine must be carefully circumscribed as only allowing protection of related goods if there was actual tarnishing of the plaintiff’s good will, or if there were a possibility that at some time in the future the plaintiff would extend his market to include what the defendant had begun to exploit.²²²

Hand had an even more explicit opportunity to interpret and apply the Lanham Act in *American Auto Ass’n v. Spiegel*.²²³ In one of the most bizarre, tortured and simply incorrect applications the Lanham Act has ever suffered, Hand concluded that the Lanham Act did not give the federal district courts jurisdiction over cases of unfair competition when the charge of infringement was “too ‘unsubstantial.’”²²⁴

Hand’s analysis in *American Auto Ass’n* was first to determine if the infringement was “substantial.” Summarily concluding that it was not, Hand held that the court did not have jurisdiction under Section 1114(1)(a) of the Lanham Act. Hand then went hunting in Section 1121 for language that could justify giving district courts original jurisdiction in a case of a registered trademark. After a tortured analysis, Hand concluded that because the infringing conduct was not “interstate” but rather “intrastate,” the district court did not have jurisdiction. “[W]e should long hesitate to find in [the Lanham Act] warrant for so sweeping an assertion of Congressional power, adding to the jurisdiction of federal courts all instances of unfair competition”²²⁵

218. *Id.* at 177.

219. *Id.* at 178-79.

220. *Id.* at 179.

221. *Id.*

222. *Id.* at 180.

223. 205 F.2d 771 (2d Cir. 1953).

224. *Id.* at 774.

225. *Id.*

Hand concluded that “[w]e are forced to the conclusion that the Act does not give jurisdiction to the district courts over an action brought by any plaintiff with whose interstate commerce the defendant has unfairly competed.”²²⁶ This was Hand’s conclusion even though Section 1121 of the Lanham Act at that time read in its entirety as follows:

The district and territorial courts of the United States shall have original jurisdiction and the courts of appeal of the United States shall have appellate jurisdiction, of all actions arising under this chapter, without regard to the amount in controversy or to diversity or lack of diversity of the citizenship of the parties.²²⁷

Not surprisingly, even though Hand purported to be analyzing the Lanham Act, he does not quote this language in his opinion. Rather, in regard to Section 1121, Hand merely stated that when such clear language is found in the Act, “[b]efore yielding to the literal meaning of the words” the court should first look at the rest of the Act to determine if its intent is made clear elsewhere. When there is no ambiguity in the statutory language on its face, it is curious Hand would feel compelled to look elsewhere in the statute—unless he had a hidden agenda.

That hidden agenda was an attempt to keep the law of trademarks as it existed in 1928 when Hand concluded “the Law and Prophets” on the subject. Hand could find no express authority or positive policy at common law to expand federal jurisdiction in this manner. Even though other courts of other circuits had done so, Hand’s Second Circuit had expressly reserved comment on the subject.²²⁸ Hand had the opportunity in *American Auto Ass’n* to expand the law of trademarks and, predictably, he refused to do so as he was forever reticent to expand the law of trademarks without a clear positive mandate to do so.²²⁹

Furthermore, one year prior to Hand’s opinion in *American Auto Ass’n*, the Supreme Court expressly stated in no uncertain terms that the Lanham Act was intended to confer broad jurisdiction over registered trademarks to the federal courts.²³⁰ In *Steele v. Bulova Watch Co.*, the Supreme Court stated as follows: “The Lanham Act . . . confers broad jurisdictional powers upon the courts of the United States . . . The district courts of the United States are granted jurisdiction over all actions ‘arising under’ the Act”²³¹ Hand’s opinion, therefore, in

226. *Id.* at 775.

227. 15 U.S.C.A. § 1121 (West 1949).

228. *See* *Dad’s Root Beer Co. v. Doc’s Beverages Inc.*, 193 F.2d 77 (2d Cir. 1951).

229. It is, of course, somewhat surprising that Hand could not find that positive statement of policy in section 1121 of the Lanham Act as it read then. Hand seemed to be expressing a surprising lack of respect for the Act by looking at its plain language yet refusing to apply it as such because he could not find any case law in the Second Circuit that supported him.

230. *Steele v. Bulova Watch Co.*, 344 U.S. 280, 283 (1952).

231. *Id.*

American Auto Ass'n is even more striking because not only did he apparently completely misread the intent of Congress, he also ignored binding Supreme Court precedent on the precise issue he was addressing.

Hand's opinion in *American Auto Ass'n* has been harshly criticized.²³² However, no one mentions this when considering whether or not Hand was a great judge. Judge Clark, the lead proponent of the opposing trademark law faction within the Second Circuit in the 1950s, just three years later gratuitously stated that *American Auto Ass'n* had "destructive effects . . . upon useful and respected trade-marks" ²³³ Because of the "very restrictive holdings" ²³⁴ in *American Auto Ass'n*, Clark called for a re-examination of that case at least by some tribunal.

Once again, the subsequent course of the common law was not kind to Learned Hand. Once again, Hand's overly restrictive view of trademark jurisprudence has been criticized and ignored. Today, jurisdiction is liberally granted to unfair competition cases based on Section 1121 of the Lanham Act.

No one at the time and few since have been so hostile to the rights of trademark owners as was Hand.²³⁵ This is made clear by his dogged persistence in adhering to "the Law and the Prophets" on the subject of trademarks: injury only occurs when sales are intentionally directed away from the plaintiff and to the defendant.

Since Hand's death in 1961, the Second Circuit actually has become much more consistent in dealing with related goods doctrine cases.²³⁶ In fact, the Second Circuit, as well as most other courts, have returned to the *Aunt-Jemima*-Doctrine level of expansive reading, have greatly expanded the view of trade dress protection,²³⁷ have liberally granted federal jurisdiction,²³⁸ and have allowed a showing of a "likelihood of confusion" rather than the actual confusion Hand required under the Real Hand Doctrine.

In fact, after Hand's opinion in *Yale Electric* in 1928, his subsequent trademark opinions, in which he desperately tried to restrict the expansion of trademark rights, have been "ignored."²³⁹ Therefore, Hand's thirty-year attempt

232. See, e.g., B.H. LaLone, Jr., Note, *Trademarks, Trade Names and Unfair Competition: Federal Non-Diversity Jurisdiction in Actions for Unfair Competition Under the Lanham Trademark Act of 1946*; *American Automobile Association v. Spiegel*, 39 CORNELL L.Q. 351, 353 (1954) ("This narrow technical construction, suggesting that trademark rights can be infringed only by the use of the mark in connection with goods (i.e., as a 'trade-mark') and not in connection with services (i.e., as a 'service mark') greatly delimits the effectiveness of the Act").

233. *Maternally Yours v. Your Maternity Shop*, 234 F.2d 538, 546 (2d Cir. 1956).

234. *Id.*

235. *But see supra* note 82.

236. See MCCARTHY, *supra* note 26, § 24.09[3-4].

237. See, e.g., *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S. Ct. 2753, 2759-60 (1992).

238. Because so many cases make this rule plain, citation would be pedantic.

239. MCCARTHY, *supra* note 26, § 24.09[3].

to confine *Aunt Jemima* and otherwise restrict trademark rights appears to have failed.

Hand's judicial theory was heavily influenced by legal positivism. Unless he was clearly directed by positive policy to change the law as he saw it from 1928 and earlier, he would not accept the more expansive version of trademark rights. Because he never truly accepted the *Aunt Jemima* Doctrine nor the changes to trademark law that occurred over his fifty years on the bench, he apparently never moved beyond "the Law and the Prophets" of the subject as it existed in 1928. Therefore, Hand was actually one of the most hostile judges trademark owners could face.

VII. CONCLUSION

Learned Hand's trademark cases are really quite troubling. Before 1940, Hand was occasionally willing to expand the substantive area of the law; however, after 1940, he became more hostile to the rights of trademark owners.

Hand dissented from *Aunt Jemima*, the leading case in the related goods field, later applied and even expanded it in *Yale Electric*, but then spent the rest of his career circumscribing it. Hand harshly interpreted the test for infringement. Even though today a mere "likelihood of confusion" is sufficient, Hand believed that "the Law and the Prophets" on the subject required the plaintiff to show actual harm, actual loss of sales, or actual taking of customers. Hand also had a very narrow and restrictive view on granting liberal jurisdiction to the federal courts for trademark cases. All of the positions he took regarding substantive trademark jurisprudence are today criticized and are either not applied or just ignored. In fact, a litigant today must be very careful in citing Hand trademark cases because most are no longer good law.

The reason Hand was so restrictive of trademark rights appears to stem from the legal positivist rhetoric in his opinions. Most of his cases indicate that he would have arrived at a different outcome but for the fact that he felt constrained by "the Law and the Prophets" on the subject. If Hand were the great judge he is given credit for being, rather than be constrained by "the Law and the Prophets" from 1928, one would have expected him to grow and expand as United States trademark jurisprudence grew and expanded during Hand's tenure on the Second Circuit. Rather, American trademark jurisprudence grew and expanded without Hand—or may be in spite of him.

Without a clear positive policy statement from the legislature, Hand could not conceive of expanding trademark rights. Clearly, Hand felt that granting these new rights and creating new protections should come from somewhere else. Where that clear expression of positive policy should have come from is unclear.

When the Congress finally enacted the Lanham Act in 1946, Hand characterized the clear substantive changes it represented as a simple “change of diction.”²⁴⁰

This reluctance to create new law, to be innovative, and to expand trademark law is contrary to Hand’s general reputation. However, even though Hand’s perspective on these issues has long been abandoned and ignored as wrong and misguided, commentators still insist on the canonization of Hand. Clearly, Hand’s trademark opinions do not deserve such deference.

Returning to Posner’s test of contribution,²⁴¹ except for *Yale Electric*, one cannot say that Hand had any meaningful contribution to the development of trademark law except as an advocate of “the Law and Prophets” from 1928. Hand should not be quickly judged a great trademark judge because Hand himself spent over 30 subsequent years circumscribing *Yale Electric*—the very case that made him famous in the field.

240. *Johnson II*, 175 F.2d 176, 179 (1949).

241. See Posner, *supra* note 5.