



# THE TIPSHEET

State Bar of Texas Intellectual Property Law Section

Vol. 15 No. 3

## MESSAGE FROM THE CHAIR



*by Leisa Talbert Peschel*

In this newsletter, we highlight how the IP Law Section and other intellectual property organizations are recognizing the 75<sup>th</sup> Anniversary of the Lanham Act. Texas had a tremendous impact on trademark law, and we especially want to celebrate the contributions of Weatherford, Texas Congressman Fritz Lanham on this historic occasion. This edition includes an article from Mary Boney Denison entitled “Why Trademarks Matter” that is the foreword to the commemorative book “Fritz Garland Lanham—Father of American Trademark Protection.” The article also includes a link for IP Law Section members to receive a discount on the purchase of that book. Also included in this edition is an article focusing on Fritz Lanham and his contributions to trademark law. For more information on events celebrating the 75<sup>th</sup> anniversary of the Lanham Act, please see : <https://texasbariplaw.org/celebrating-the-75th-anniversary-of-the-lanham-act/>.

Best Regards,

Leisa Talbert Peschel, Chair

Intellectual Property Law Section

State Bar of Texas

## THE LIFE AND LEGACY OF FRITZ LANHAM



Photo credit: University of Texas Arlington Digital Gallery

Frederick "Fritz" G. Lanham (1880-1965)

Texan, Author, Editor, Playwright, Lawyer, Congressman

This is a portrait of Frederick of "Fritz" Garland Lanham, one of the most notable U.S. Congressmen and lawyers you have likely never come across unless you are a practicing attorney in the field of trademark law. Even today, regular IP practitioners are just now learning about the significant impact this individual had on the current federal trademark statute and primary vehicle brand owners continue use today to secure protection and enforce their rights 75 years after the statute was enacted. Even if intellectual property is not your primary practice area, as an in-house lawyer you have undoubtedly handled or come across a trademark issue on behalf of your company. The importance of trademark protection for companies and brand owners cannot be understated. It provides the consuming public with confidence and assurance that the goods and services being sought are genuine, of a high-quality and have emanated from the legitimate source identified by the trademark or service mark. Recent figures place the value of intangible assets and goodwill at an estimated 84% of the S&P 500's total value, or more than \$20 Trillion Dollars in value. Trademarks are the chief representation and embodiment of a company's reputation and serve to create a powerful emotional relationship between brand owners and consumers. Quite literally, without trademarks and trademark protection our economy and the ability to effectively and efficiently market and sell goods and services would not be possible.

Although a significant contributor across a wide scope of federal legislation and other notable projects, Fritz Lanham is most known for his influence in the field of United States federal trademark law, the primary statute of which bears his name, the “Lanham Act”, which Congressman Lanham championed for 18 years as a U.S. Congressman until its adoption in 1946. 2021 marks the 75th anniversary of this significant piece of legislation that governs the way in which trademarks and the legal rights of brand owners are uniformly protected in our country under federal law. The Lanham Act governs federal trademark registration, trademark infringement, trademark dilution, and false advertising in the United States. This landmark piece of legislation enables consumers to confidently identify and differentiate between the hundreds of thousands of brands inundating the marketplace every day and to distinguish, with confidence, as to the nature and quality associated with the products and services we enjoy in our daily lives. The Act was signed into law by President Harry Truman in 1946 and took effect on July 5, 1947. Today the U.S. Trademark Office receives more than 500,000 applications annually and issues on average about 350,000 federal registrations each year. Since its enactment, the Lanham Act has been cited by the United States Supreme Court in 57 decisions and by federal and state courts across the country in over 34,000 decisions.

Before his illustrious career as a U.S. Congressman, Lanham earned a B.A. from the University of Texas in 1900 and pursued graduate studies in law at the University until 1903. Although he never completed his law degree, Lanham was admitted to the Texas Bar in 1909, where he practiced in his hometown of Weatherford. While at Texas, Lanham was more than just a student; he became the first editor of *The Texan*, the school newspaper (now known as *The Daily Texan*) beginning in the fall of 1900 and held the job until early 1901. In his first editorial, Fritz said the paper’s goal should be, “ultimately to please the student body.” While he acknowledged there were always two sides to every issue, he said *The Texan* should present only “the proper one.” Lanham wrote most frequently about the extracurricular topic that was most important to the University community – football. Congressman Lanham wore many hats throughout his successful life as a student and alumnus. He was an author, newspaper editor, playwright and founder of *The Alcalde*, the alumni publication of the University of Texas, one of the most successful and widely circulated publications of its kinds today.

Fritz had deep ties to Texas history and politics. He was one of eight children of Samuel and Sara Lanham. His father, Samuel Lanham, served as the 22<sup>nd</sup> Governor of the State of Texas and as a United States Congressman from Texas. It was Fritz’s father, while serving as Texas governor, who convinced him to take a year off prior to attending law school and serve as the governor’s personal secretary. It was Fritz’s introduction into the world of politics.

In 1919, Lanham won a special election to Congress in Texas’s 12th congressional district (encompassing Fort Worth and Weatherford), succeeding fellow Democrat James Clifton Wilson, who resigned to accept a federal judgeship on the U.S. District Court for the Northern District of Texas. Lanham would go on to serve in Congress from 1919-1947. Congressman Lanham was a strong supporter of President Franklin D. Roosevelt and the New Deal. While in Congress, Lanham served on several committees, including the Committee on Patents. By the time he retired, not only had Lanham left an indelible mark on American commerce, he simultaneously oversaw the construction of numerous federal buildings across the country, including participating on the planning committee for the design and construction of the U.S. Supreme Court Building.

Although Fritz never practiced trademark law, he became convinced during his time in Congress that the nation's trademark laws needed to be modernized and expanded to provide stronger protection for brand owners. Rep. Lanham introduced HR 9041 in 1938, and over the next eight years he worked tirelessly to accomplish what was called the "Herculean task" of convincing Congress to broaden trademark protection through passage of what we now call the Lanham Act—an effort that was strongly opposed by the Antitrust Division of the Department of Justice.

The Lanham Act resulted in the repealing of the previously enacted acts of 1881 (narrowly protecting federal trademark registrations of foreign nations and Indian tribes) and the acts of 1905 and 1920 (prohibiting willful or intentional misrepresentation of trademarks but often considered too restrictive to be useful), is named in honor of its champion Congressman Lanham. Passed on July 5, 1946 and effective one year later, this federal statute (now codified under Title 15 of the United States Code) has served as the primary vehicle by which brand owners have a federal right to more broadly and effectively protect their trademarks. The statute also sets out the actions and remedies available for registered and unregistered trademark infringement under. In addition, this federal statute prohibits the importation of goods that infringe federally registered trademarks, the use of false designations of origin and trademark dilution, which protects brands with significant notoriety and fame. Most significantly, the Lanham Act allowed for additional causes of action for owners of unregistered marks. In addition, the Act eliminated the requirement of "willfulness" or "intent to deceive" as a necessary element to prevail in a trademark action under federal law.

Shortly after his seminal accomplishment, Rep. Lanham retired from Congress and returned to Texas to live out his life doing the things he loved to do – reading, writing poetry, preaching on Sundays as a lay minister in the Methodist Church, and entertaining children with magic tricks. By the time he retired, not only had Lanham left an indelible mark on American commerce, he had simultaneously overseen the construction of numerous federal buildings across the country, including participating on the planning committee for the design and construction of the U.S. Supreme Court Building.

Congressman Lanham was reelected thirteen times and served with distinction until his retirement in 1946. His congressional papers are maintained at the Dolph Briscoe Center for American History at the University of Texas. After his retirement from Congress, Lanham remained in Washington to work as a lobbyist for the National Patent Council. Congressman Lanham died on July 31, 1965 at Seton Hospital in Austin, Texas. He is buried at City Greenwood Cemetery in Weatherford, Texas (due west of Fort Worth).

Lanham was truly loved by those who knew him – a consummate gentleman; a man of uncompromising standards and ethics; and a gifted politician. After Lanham's death, the Fort Worth Star-Telegram, in a lead editorial entitled "Lanham, Gentleman of the Golden Age," wrote: "Classically educated, courtly, urbane and eloquent, Mr. Lanham was so much the gentleman that many thought this a handicap to his political career. It never appeared to be. He was a highly effective legislator and had a rare influence with his colleagues, who knew him to be unswervingly a man of his word." Those who knew him are in complete agreement that Fritz Lanham was always a gentleman. The federal building in Fort Worth now bears his name to honor Congressman Lanham's remarkable influence and legacy.

This year we take time to reflect and remember Lanham's legacy and his great effort and support of this important milestone in trademark history and recognize the role and influence Fritz had

on directly shaping federal trademark law that still serves us today. Although the landscape in 2021 certainly has changed since the 1940s and Fritz could never have imagined how the economy and commerce would be impacted by the internet and the tiny hand-held devices we carry with us throughout the day, it is a great testament to the elected officials who crafted a strong backbone of laws that still serve us well today in our globally-connected and digitally-driven economic universe.

Inspired by the 75th Anniversary of the Lanham Act, and to help celebrate Lanham's contributions and honor his legacy, a group of Texas lawyers recently founded a new nonprofit known as the Texas Intellectual Property Law Foundation. The aim of the Foundation is to undertake initiatives and activities not permitted by the traditional section under the current rules and procedures of the Texas Bar (submitting amicus briefs, advocating for legislative changes and awarding diversity scholarships).

The anniversary will be celebrated at the State Bar of Texas Annual Meeting (June 17-18, 2021) in Fort Worth, where the legislation's namesake, Fritz Lanham served as a Congressman in the 12<sup>th</sup> District from 1931 – 1946. Please also visit the State Bar of Texas Intellectual Property Section's website to catch up on all upcoming events occurring in 2021 to celebrate this milestone: <https://texasbariplaw.org/celebrating-the-75th-anniversary-of-the-lanham-act/>

*This article was adapted from an article previously published in the International Trademark Association's Bulletin in January 2021.*

## **WHY TRADEMARKS MATTER**

By Mary Boney Denison

U.S. Commissioner for Trademarks (2015-2019)

United States Patent and Trademark Office

### **From the Foreword to FRITZ GARLAND LANHAM—FATHER OF AMERICAN TRADEMARK PROTECTION by Joe Cleveland**

This year marks the 75th anniversary of the Lanham Trademark Act. During his decades of service in the U.S. Congress, Congressman Fritz G. Lanham worked tirelessly and spent enormous political capital championing a new trademark bill for the modern era. The Lanham Act—named in honor of its chief proponent—not only protects American consumers, it protects the goods and services produced by America’s businesses. To appreciate Congressman Lanham’s extraordinary gift to our country, one must first understand the history of trademark protection and the significance of trademarks to all Americans and to our national economy.

Today, it seems obvious that a business’s trademarks deserve protection under a nationwide trademark schema. But that has not always been the case. Before Congress enacted any federal trademark legislation, the right to adopt and use a symbol to distinguish a business’s goods and services was only recognized by American common law and by the statutes of some states. Indeed, the whole system of common law trademarks and the civil and equitable remedies for their protection existed long before any federal trademark legislation enacted by Congress and remains in full force today. This exclusive right to a trademark was not created by any act of Congress and does not depend upon any federal legislation for its enforcement.

As the United States embarked upon the industrial revolution at the turn of the century, Congress passed several federal trademark registration laws, but none was adequate to the task. In 1870 and again in 1905, Congress sought to enact uniform trademark laws, which provided for the registration of trademarks and remedies for their infringement. But these civil remedies proved insufficient to prevent pirating a business’s trademarks. Additionally, while patents are specifically mentioned in the Constitution, trademarks are not. After all, trademarks recognized by the common law were generally based on use, rather than the notion of a new or novel invention. It was only after the United States Supreme Court held that the Congress could enact trademark protection under the Commerce Clause that the path to nationwide trademark protection became clear.

Meanwhile, state legislatures began considering trademark bills, which featured costly compulsory registration and significant ramifications to trademark owners for failure to register their marks in each state. With the prospect of various states enacting a patchwork of onerous state trademark laws, the American Bar Association (ABA) began to study a new nationwide law for trademark protection but was unable to obtain adequate legislative support.

In the fall of 1937, Edward S. Rogers, the dean of the trademark bar, and Congressman Fritz Lanham, chair of House Subcommittee on Trademarks, met in Washington, D.C. to discuss the problem. As they discussed a potential solution, Mr. Rogers presented Congressman Lanham his draft notes from ABA meetings that had been ongoing to address the need for federal trademark legislation. After their meeting, Congressman Lanham undertook the momentous effort to craft and enact nationwide trademark legislation.

Although interrupted by World War II and a variety of other challenges, Congressman Lanham persisted. On July 5, 1946, President Harry S. Truman signed the Lanham Trademark Act into law, almost nine years after Congressman Lanham took up his gavel to begin championing the legislation in Congress.

Over the past seventy-five years, the Lanham Act has stood the test of time. Since its enactment in 1946, it has been repeatedly challenged and reviewed by all levels of the federal judiciary, including the United States Supreme Court. It has been amended more than 20 times, and parts have been declared unconstitutional. Still, the Lanham Act remains the primary source of statutory protection for trademarks in this country.

From a practical standpoint, trademarks are critical to the day-to-day lives of each and every American. Trademarks play a vital role in helping consumers differentiate goods and services in commerce in the United States and indeed the entire world. Studies show that children recognize brands incredibly early in their childhood development. From my own personal experience, I know that to be true. My daughter—when she was only two years old—pointed to a VISA® trademark and to my surprise uttered the word VISA. She could not read; she could not use a credit card, but she knew the VISA® trademark and recognized its source. From early childhood until our twilight years, brands serve the essential role of helping us identify the source of goods and services. Trademarks permit us to distinguish quality and to understand what we are buying. And they protect us. They help us identify the goods and services we want, and they help us avoid fake or dangerous products or fraudulent services we don't want.

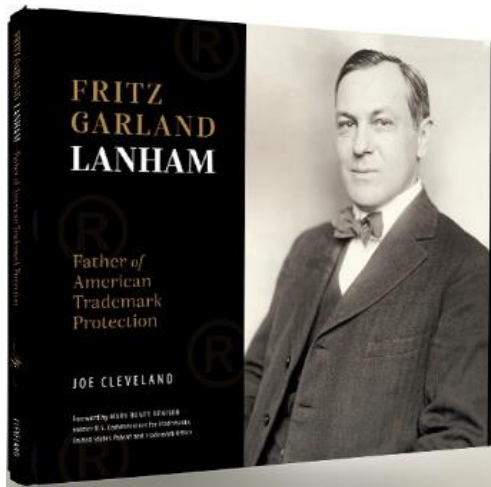
Counterfeiting has become an enormous global problem with a significant impact on the economy and the health and safety of all Americans. In addition, the sale of counterfeit products results in lost revenues to businesses and lost tax revenues to governments while generating enormous profits to traffickers who sell counterfeit goods. Frequently, these traffickers are associated with organized crime and terrorist groups. Trademarks protect the health and safety of the American consumer by helping them identify counterfeit products such as fake medicines, faulty airbags, self-igniting lithium-ion batteries, adulterated cosmetics, and a great many other dangerous products introduced into this country's stream of commerce.

Trademarks also have a significant economic impact. The United States Department of Commerce has studied the impact of intellectual property on U.S. jobs. The study found that in 2014 almost 24 million U.S. jobs were in trademark-intensive industries. Including supply-chain jobs, the number of jobs related to trademark-intensive industries surpass 40 million. Further, according to the study, the average weekly wage premium of workers in trademark intensive industries was close to 40% higher than those in non-intellectual property intensive industries.

Trademarks matter. They provide clear guideposts to consumers. They protect consumers and American businesses. And they promote the national economy.

Every American owes an enormous debt of gratitude to Congressman Lanham. He used old fashioned charm and persistence to usher into law a landmark bill we now know as the Lanham Act. Because of Congressman Lanham's tenacity and perseverance, American consumers, American businesses and American commerce have vital protections as we move forward into the twenty-first century.

## CELEBRATING THE 75<sup>th</sup> ANNIVERSARY OF THE LANHAM ACT



On July 5, 1946, President Harry S Truman signed the Lanham Trademark Act, the law that guides and informs so much of the work we intellectual property lawyers do every day to protect the brands and reputations of American businesses in Texas, in this country and around the globe.

But what many lawyers don't know is the Lanham Act was spearheaded by Texas lawyer and Fort Worth Congressman Fritz G. Lanham. By the time he retired in 1947, not only had Lanham left an indelible mark on American commerce, but he simultaneously oversaw the construction of numerous federal buildings across the country, including the United States Supreme Court building—on time and under budget.

In celebration of the 75th Anniversary of the Lanham Act, the Intellectual Property Section of the State Bar of Texas (IP Section), the United States Patent and Trademark Office (USPTO), the Texas Intellectual Property Law Foundation, and the International Trademark Association (INTA) are planning several nationwide events to commemorate Congressman Fritz Lanham and the law he championed during his years in office.



## FREE CLE and IP Section Annual Meeting

The first event celebrating the 75th anniversary of the Lanham Act is scheduled for June 17–18 during the IP Law Section's annual meeting **where all CLE will be offered virtually and free of charge.**

On Thursday, June 17, the IP Law Section in collaboration with the USPTO will present a virtual version of its Annual Trademark Bootcamp, *Nuts and Bolts of Trademark Law and TTAB Practice*. **The two-part session will be held virtually and will potentially feature live oral hearings and arguments before the Trademark Trial and Appeal Board.**

On Friday, June 18, the IP Law Section is planning a blockbuster CLE program. Over lunch, the IP Law Section will hold its virtual Annual Meeting where David Gooder, U.S. Commissioner for Trademarks, will be the IP Law Section's keynote speaker.

In addition, the IP Law Section will present the Tom Arnold Lifetime Achievement Award, the Inventor of the Year Award, and the newly-created Fritz Lanham Annual Trademark Award. Finally, the IP Law Section will present the world premiere of the Lanham documentary commissioned by the IP Law Section and the USPTO.

## Lanham Commemorative Book

The Texas Intellectual Property Law Foundation commissioned a beautiful commemorative limited edition book about this important milestone in trademark protection with all proceeds funding a diversity scholarship program in Congressman Lanham's honor. The IP Section is pleased to offer its members this commemorative book at a special discount price of \$38 plus shipping and handling.

Due to the book's limited edition, you are encouraged to pre-purchase the book now to distribute to your team, colleagues and clients. To order your copy now, please click [here](#). Books will be shipped after they have been printed, which is scheduled for late May 2021 just in time for the 75th anniversary celebration at the State Bar of Texas Annual Meeting in Fort Worth, Texas.

## INTA Annual Meeting

The International Trademark Association (INTA) is hosting its annual meeting in Houston, Texas from November 15-19. The IP Section is currently collaborating with INTA to create some programming around the Lanham Act and the 75th Anniversary.

We hope you will join us at these events in celebrating the 75<sup>th</sup> Anniversary of the Lanham

## 2020-2021 SECTION OFFICERS & COUNCIL

The officers and council members for the Section were elected at the Annual Meeting last summer. They are as follows:

	<b>Name</b>	<b>Firm</b>	<b>City</b>
<b>Chair</b>	Leisa Talbert Peschel	Jackson Walker	Houston
<b>Chair-Elect</b>	Michael Locklar	Adolph Locklar	Houston
<b>Immediate Past Chair</b>	Derrick Pizarro	Pizarro Allen PC	San Antonio
<b>Vice Chair</b>	Joe Cleveland	Brackett & Ellis, PC	Fort Worth
<b>Secretary</b>	Devika Kornbacher	Vinson & Elkins LLP	Houston
<b>Treasurer</b>	Thomas Kelton	Haynes & Boone	Richardson
<b>Newsletter Officer</b>	Michael Smith	Siebman, Forrest, Burg & Smith	Marshall
<b>Website Officer</b>	Austin Teng	Thompson & Knight	Dallas
<b>Council</b>			
Term ends 2021	Craig Stone	Phillips 66	Houston
	Nick Guinn	Gunn Lee & Cave	San Antonio
	Elise Selinger	Patterson + Sheridan	Dallas
Term ends 2022	David Cho	AT&T Services	Dallas
	Michele Connors	Cirrus Logic	Austin
	Kat Li	McKool Smith	Austin
Term ends 2023	Yocel Alonso	Alonso PLLC	Sugar Land
	Marylauren Ilagen	Mary Kay Inc.	Addison
	George W. Jordan, III	Norton Rose Fulbright US LLP	Houston

## IP SECTION COMMITTEES

Much of the Section's work is performed by committees, which help carry out its mission of educating, connecting and serving the Section's members. This year's committees and chairs are as follows:

<b>Activities</b>	<b>Committees</b>	<b>Committee Chairs/Officers</b>
<i>Educate:</i>	Copyright	Justen S. Barks
	Patent	Roshan Mansinghani
	Trademark	Mery Pimentel
	Trade Secret	Heath Coffman
	Newsletter	Michael Smith
	Advanced IP CLE	Mike Locklar
	Advanced Pat. Lit.	Kirby Drake
<i>Connect:</i>	Women in IP	Danielle "DJ" Healey
	Diversity	Chris Joe
	New Members	Jen Kuhn
	New Lawyers	Kristi Hubbard
<i>Serve:</i>	Pro Bono	Joe Cleveland
	Public Relations	Erin Choi
	Tex IP Law	J Mike Locklar
	TALA	Kirby Drake
	IP Legends	Herb Hammond

## 2021 SBOT IP Law Scholarship Announcement and Application Form

The Intellectual Property Law Section of the State Bar of Texas will award two \$5,000 scholarships to eligible law students. Any student enrolled in an ABA-accredited law school in Texas during any part of the application submission period may apply. Students who have been accepted to law school but have not yet started classes at the time the application is filed are not eligible. Students who have graduated at the time the scholarship is awarded are eligible.

The purpose of the scholarships is to encourage law students who have not traditionally been represented in the Intellectual Property practice to enter the Intellectual Property profession in Texas by providing financial assistance to help defray the expenses of a law-school education. Selection criteria for the scholarships include but are not limited to:

- Scholastic merit;
- Financial need;
- Membership in a socio-economic group traditionally under-represented in the practice;
- Demonstrated experience and interest in the practice;
- Texas roots;
- First generation in a family to go to college or law school;
- Science and engineering undergraduate education or experience;
- Contributions to or participation in minority or diversity programs;
- Disabilities;
- Community service; and
- Extracurricular activities both inside and outside law school, including legal externships or internships in the field of Intellectual Property.

This application should be completed and returned either by (1) mail to the IP Section's Diversity Scholarship Committee, c/o Chris Joe, Buether Joe & Carpenter, LLC, 1700 Pacific, Suite 4750, Dallas, TX 75201 or (2) email to Chris Joe at [Chris.Joe@BJCIPLaw.com](mailto:Chris.Joe@BJCIPLaw.com) (entire applications only (e.g., applications including the recommendations, essays, and transcripts)).

This application form is available online at [www.texasbariplaw.org](http://www.texasbariplaw.org) or from the student's law school's Financial Aid or Dean's office. **Applications must be postmarked or emailed by no later than May 1, 2021.** The scholarships will be awarded on or before June 2021. The recipients will be recognized at an IP Section event or at the IP Section's next Annual Meeting.

## CALL FOR SUBMISSIONS

The TIPSHEET welcomes the submission of articles for potential publication in upcoming issues, as well as any information regarding IP-related meetings and CLE events. If you are interested in submitting an article to be considered for publication or adding an event to the calendar, please email [michaelsmith@siebman.com](mailto:michaelsmith@siebman.com).

### *Article Submission Guidelines*

**STYLE:** Journalistic, such as a magazine article, in contrast to scholarly, such as a law review article. We want articles that are current, interesting, enjoyable to read, and based on your opinion or analysis.

**LENGTH:** We accept a wide range of articles, with most falling into the 500-2500 word range.

**FOOTNOTES AND ENDNOTES:** Please use internal citations.

**PERSONAL INFO:** Please provide a one-paragraph bio and a photograph, or approval to use a photo from your company or firm website.

If you have any questions, please email [michaelsmith@siebman.com](mailto:michaelsmith@siebman.com).