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Victor Memo Campos

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## **Who Says There's No Disclosure Requirement For All Intellectual Property Law Subjects: The Case For The Existence Of Disclosure Requirements in Copyright and Trademark Law?**

### **I. Introduction**

Intellectual property is different from tangible, real property, and possession of intellectual property is easily disseminated. Thomas Jefferson explained the ease by which intellectual property can spread. Jefferson said in his writings:

“an individual may exclusively possess [an idea] as long as he keeps it to himself; but the moment it is divulged, it forces itself into the possession of everyone, and the receiver cannot dispossess himself of it. Its peculiar character, too, is that no one possesses the less, because every other possesses the whole of it. ... That ideas should freely spread from one to another over the globe, for the moral and mutual instruction of man, and improvement of his condition, seems to have been peculiarly and benevolently designed by nature, when she made them, like fire, expansible over all space, without lessening their density in any point.”<sup>1</sup>

Since intellectual property spreads so easily, others are able to use and build upon this knowledge. People are more apt to create intellectual property if they are incentivized, and, therefore, they seek protection for their rights in their intellectual property.

The founding fathers appreciated the benefit that increased access to knowledge has on the greater society.<sup>2</sup> They recognized that the spread of intellectual property creates innovation and advances in society.<sup>3</sup> They agreed with Jefferson's theory and believed that intellectual property can spread and promote progress and knowledge.<sup>4</sup> In order to incentivize creators, they granted rights to creators in the Constitution. Article I, Section 8 of the Constitution states that:

The Congress shall have Power ... [3] To regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes; ... [8] To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.<sup>5</sup>

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<sup>1</sup> THOMAS JEFFERSON, VI WRITINGS OF THOMAS JEFFERSON 180-81 (Washington ed.).

<sup>2</sup> Adam Macluckie, *United States v. Microsoft: A Look at the Balancing Act Between Copyright Protection for Software, Intellectual Property Rights and the Sherman Antitrust Act*, 2 Hous. Bus. & Tax L. J. 415, 464 (2002) (noting that the Founding Fathers recognized the increase in knowledge as essential to the development of the country). See also Bruce W. Bugbee, *Genesis of American Patent and Copyright Law*, 128-30 (1967) (arguing that the founding fathers saw intellectual property rights as “inherent”); *id.* at 130-31 (quoting Madison as suggesting that one reason for his support of the clause was the “dread[] that the few will be unnecessarily sacrificed to the many”).

<sup>3</sup> Xuan-Thao Nguyen & Jeffrey A. Maine, *Equity and Efficiency in Intellectual Property Taxation*, 76 Brook. L. Rev. 1, 10 (2010) (noting that the Founding Fathers clearly sought to award authors exclusive rights to their works--based on the belief that a reward-based system would advance society).

<sup>4</sup> *Id.*

<sup>5</sup> U.S. Const. art. I, § 8, cl. 3, 8.

Patent and copyright protection derives from clause 8, while clause 3 allows for protection of trademarks through Congress' authority to regulate interstate commerce. Clause 8 provides patent protection through the phrase "To promote the Progress of **the useful Arts**, by securing for limited Times to **Inventors** the exclusive Right to their respective **Discoveries**." Clause 3 also provides the copyright protection by using the phrase "To promote the Progress of **Science**, by securing for limited Times to **Authors** the exclusive Right to their respective **Writings**." Clause 3, which provides Congress power "to regulate **Commerce** with foreign Nations, and among the several States, and with the Indian Tribes," enables the protection of trademarks, as codified in the Lanham Act.<sup>6</sup>

The substance of the creator's right in his intellectual property is limited, however. The limit and extent of the creation must be specifically known in order for protection to be granted. The creator's rights will be limited to the extent to which the creator discloses his creation to the public. This disclosure sets forth the metes and bounds of the covered, protectable subject matter.

This paper discusses the quid pro quo of disclosure in exchange for a creator's exclusive rights in his intellectual property. There is an underappreciated disclosure requirement among legal scholars and the courts for all intellectual property subjects (copyright, trademark, and patent). Legal scholars and courts readily agree that there is a disclosure requirement for patents, but they do not find a corresponding disclosure requirement in either copyright or trademark law.

This paper argues that scholars and courts should recognize a disclosure requirement in copyright law and trademark law, in addition to the already accepted disclosure requirement in patent law. Part II of this paper will discuss the disclosure requirement in patent law. Part III will demonstrate that there is a disclosure requirement in copyright law. Part IV will demonstrate that there is a disclosure requirement in trademark law.

## **II. Patent Disclosure Requirements**

In exchange for exclusive rights in a patent, the patent owner must disclose his invention to the public. In order to receive the exclusive, protectable rights in his patent (for a limited time), the inventor must meet the disclosure requirements set forth in 35 U.S.C. § 112: 1) written description, 2) enablement requirement, 3) best mode requirement, and 4) the requirement that the patent applicant particularly point out and distinctly claim the invention. The Supreme Court and lower courts have solidified this requirement for attaining patent rights. Therefore, courts are solidly in agreement that in order to attain exclusive rights in a patent, the inventor must provide public disclosure.

When one receives a patent, the rights he obtains are "a grant to the patentee, his heirs or assigns, of the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States."<sup>7</sup> The extent and limit of the protection in the patent is disclosed in the patent specification. The rights in a patent are significant because an inventor receives the exclusive, protectable rights in his patent for twenty years.<sup>8</sup>

The disclosure requirement sets out the exact invention for which the applicant wants exclusive rights. In exchange for these exclusive rights, the information is publicly disclosed, so that others may use this patented material in the future in order to promote progress in the useful arts. The United States Supreme Court stated that:

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<sup>6</sup> 15 U.S.C. § 1051 (2002).

<sup>7</sup> 35 U.S.C. § 154 (2012).

<sup>8</sup> *Id.*

“[t]he limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public. Otherwise, a zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field, and the public would be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights.”<sup>9</sup>

The patent specification specifies four distinct disclosure requirements for obtaining a patent: (1) written description, (2) enablement requirement, (3) best mode requirement, and (4) that the applicant particularly point out and distinctly claim the invention.<sup>10</sup> The patent’s disclosure establishes the scope and limit of the patent’s claimed subject matter. Each requirement within the patent specification is designed to provide notice to the public of the invention for which the inventor seeks protectable rights.

First, the written description establishes the invention’s boundaries for two reasons: (1) to notify third parties, so that they are able to develop improvements and obtain protection for their inventions that build upon the inventor’s patent, and (2) to limit the inventor’s ability to seek patent protection for broader subject matter than that which he disclosed.<sup>11</sup> The United States Court of Appeals for the Federal Circuit stated that “the applicant must also convey with reasonable clarity to those skilled in the art that ... he or she was in possession of the invention.”<sup>12</sup> The Federal Circuit also stated that drawings alone may satisfy the written requirement, as long as the drawings were sufficient to notify an ordinary person skilled in the art as to what the invention is.<sup>13</sup>

Second, the enablement requirement discloses to the public how to make and use the invention, so that others are able to improve upon the invention, as well as make and use the invention after the patent expires.<sup>14</sup> By meeting the enablement requirement, the applicant also demonstrates that he was in possession of the invention at the time of filing.<sup>15</sup> The enablement requirement requires that enough information be given in order for an ordinary person skilled in the art to make and use the invention to its full scope.<sup>16</sup>

Third, the best mode requirement adds an additional level of transparency to the disclosure requirement: not only how to make and use the invention, but also the best way to do so. In determining the best mode requirement, the Federal Circuit created a two part test: (1) whether at the time of the filing, the inventor knew of a mode of practicing his invention that he

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<sup>9</sup> Markman v. Westview Instruments, Inc., 517 U.S. 370, 390, 116 S. Ct. 1384, 1396, 134 L. Ed. 2d 577 (1996) (internal citations omitted).

<sup>10</sup> 35 U.S.C. § 112 (2012): **(a) In general.**--The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

**(b) Conclusion.**--The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

<sup>11</sup> Regents of the Univ. of California v. Eli Lilly & Co., 119 F.3d 1559 (Fed. Cir. 1997).

<sup>12</sup> Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1564 (Fed. Cir. 1991).

<sup>13</sup> *Id.* at 1567.

<sup>14</sup> Grant v. Raymond, 31 U.S. (6 Pet.) 218 (1832).

<sup>15</sup> *Id.*

<sup>16</sup> CFMT, Inc. v. Yieldup Int'l Corp., 349 F.3d 1333, 1338 (Fed. Cir. 2003).

considered to be better than any other, and (2) if the inventor disclosed that which he knew to be the best mode.<sup>17</sup> The Federal Circuit explained that the best mode does not have to be the actual best way to do something, assuming there is one, but rather only that which is “contemplated by the inventor.”<sup>18</sup>

Fourth, the disclosure requirement for patents requires that the applicant must particularly point out and distinctly claim the invention. This requirement establishes the limits of the claim and prevents the inventor from seeking protection for inventions broader than he discloses. The Federal Circuit explained that “the primary purpose of the requirement is “to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their [respective] rights.”<sup>19</sup>

Therefore, the four distinct disclosure requirements (written description, enablement requirement, best mode, and particularly point out and distinctly claim) are the quid pro quo for an inventor to receive exclusive, protectable rights for his invention for twenty years. An inventor can receive the exclusive rights in his invention, but he must share the invention with the public, in order to promote the progress of the useful arts.

In 1974, the Supreme Court explained the disclosure requirement.<sup>20</sup> In *Kewanee Oil*, the plaintiffs sued defendants for misappropriation of trade secrets.<sup>21</sup> Defendants were former employees of one of the plaintiff’s subsidiaries.<sup>22</sup> While working for the plaintiff’s subsidiary, the defendants developed processes for the growth and encapsulation of synthetic crystals, eventually growing, for the first time, a 17-inch crystal for detecting ionizing radiation.<sup>23</sup> While at the subsidiary, defendants signed non-disclosure agreements for any confidential information or trade secrets acquired. Several defendants left the subsidiary to form Bicon Corporation, and others joined Bicon later as employees. Soon after Bicon was created, it successfully grew a 17-inch crystal of its own.<sup>24</sup> The Supreme Court granted certiorari to review whether state trade secret protection is pre-empted by federal patent law. In so doing, the Court analyzed the disclosure requirement for patent law. The Court stated that “the patent laws impose upon the inventor a requirement of disclosure.”<sup>25</sup> The Court reasoned that disclosure was necessary “[t]o ensure adequate and full disclosure[,] so that upon the expiration of the 17-year period, the knowledge of the invention enures to the people, who are thus enabled without restriction to practice it and profit by its use.”<sup>26</sup> The Court explained that the patent laws promote the “Progress of Science and the useful Arts by offering a right of exclusion for a limited period of time as an incentive to inventors to risk the often enormous costs in terms of time, research, and development.”<sup>27</sup> The Court characterized the quid pro quo as the “reward for inventions,”<sup>28</sup> and in order for an inventor to attain the quid pro quo, the patent law requires disclosure of the invention.

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<sup>17</sup> *Chemcast Corp. v. Arco Industries Corp. Inc.*, 913 F.2d 923, 927 (Fed. Cir. 1990).

<sup>18</sup> *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1049 (Fed. Cir. 1995).

<sup>19</sup> *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1581 (Fed. Cir. 1996) (quoting *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938)).

<sup>20</sup> *Kewanee Oil Co. v. Bicon Corp.*, 416 U.S. 470, 480-81 (1974).

<sup>21</sup> *Id.* at 470.

<sup>22</sup> *Id.* at 473.

<sup>23</sup> *Id.*

<sup>24</sup> *Id.*

<sup>25</sup> *Id.* at 480.

<sup>26</sup> *Id.* at 481.

<sup>27</sup> *Id.*

<sup>28</sup> *Id.*

The Supreme Court again explained the disclosure requirement in 1998.<sup>29</sup> In *Pfaff*, the plaintiff was asked by Texas Instruments to develop a socket device for mounting and removing semi-conductor chip carriers.<sup>30</sup> Plaintiff prepared detailed engineering drawings in order to make the socket, and reduced his invention to practice.<sup>31</sup> After the patent issued, plaintiff sued Wells Electronics for patent infringement.<sup>32</sup> The Court explained the disclosure requirement by stating that “the patent system represents a carefully crafted bargain that encourages both the creation and the public disclosure of new and useful advances in technology.”<sup>33</sup> The Court reasoned that disclosure furthers the progress of science by granting to the inventor exclusive, protectable rights in his invention. The Court stated that “the exclusive right and liberty to make and use and vend to others to be used [in] their own inventions, ... and as matter of compensation to the inventors for their labor, toil, and expense in making the inventions, and reducing the same to practice for the public benefit, as contemplated by the Constitution and sanctioned by the laws of Congress.”<sup>34</sup>

The Federal Circuit also explained the disclosure requirement needed in order for an inventor to achieve exclusive rights in his patent.<sup>35</sup> In *Ariad Pharmaceuticals*, plaintiffs brought a patent infringement action. The Federal Circuit explained that a “separate requirement to describe one’s invention is basic to patent law.”<sup>36</sup> The Federal Circuit explained that the quid pro quo for exclusive, protectable rights in a patent is the written disclosure of the patent.<sup>37</sup> The Federal Circuit reasoned that written disclosure “allows the United States Patent and Trademark Office (“PTO”) to examine applications effectively; courts to understand the invention, determine compliance with the statute, and to construe the claims; and the public to understand and improve upon the invention and to avoid the claimed boundaries of the patentee’s exclusive rights.”<sup>38</sup>

The Federal Circuit later explained that the disclosure requirement is needed in order for an inventor to receive the quid pro quo of exclusive rights in patent law.<sup>39</sup> In *Pozen*, the plaintiff developed a method for treating migraine headaches by combining two drugs into a single tablet.<sup>40</sup> Plaintiff acquired three patents for the new drug, Treximet.<sup>41</sup> Plaintiff sued defendants, generic pharmaceutical manufacturers, for marketing generic versions of Treximet prior to the expiration of Pozen’s patents.<sup>42</sup> In reviewing Pozen’s infringement claim, the Federal Circuit explained the written description requirement necessary to achieve the quid pro quo of exclusive rights in the patent. The Federal Circuit explained that in order to achieve exclusive rights, the inventor must fully disclose his invention, in order to promote the progress of science.<sup>43</sup> The Federal Circuit explained that the written description is a requirement, so that the specification

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<sup>29</sup> *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55 (1998).

<sup>30</sup> *Id.* at 58.

<sup>31</sup> *Id.*

<sup>32</sup> *Id.* at 59.

<sup>33</sup> *Id.* at 63.

<sup>34</sup> *Id.* at 64 (quoting *Seymour v. Osborne*, 11 Wall. 516, 533-534 (1870)).

<sup>35</sup> *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*, 598 F.3d 1336 (Fed. Cir. 2010).

<sup>36</sup> *Id.* at 1345.

<sup>37</sup> *Id.*

<sup>38</sup> *Id.*

<sup>39</sup> *Pozen Inc. v. Par Pharm., Inc.*, 696 F.3d 1151 (Fed. Cir. 2012).

<sup>40</sup> *Id.* at 1156.

<sup>41</sup> *Id.* at 1157.

<sup>42</sup> *Id.*

<sup>43</sup> *Id.* at 1167.

adequately describes an invention, such that it reasonably conveys to a person of ordinary skill in the art that the inventor had possession of the claimed invention.<sup>44</sup> In return for the disclosure, the inventor will achieve the exclusive rights of the patent.

It is undisputed that there is a disclosure requirement in patent law. Courts have solidified that the specification requirements laid out in 35 U.S.C. § 112 are needed in order for an inventor to receive exclusive rights in his invention. By providing the written description, enablement requirement, best mode requirement, and particularly pointing out and distinctly claiming the invention, the inventor meets the disclosure requirement. The disclosure requirements in § 112 are the quid pro quo needed for the exclusive rights.

### **III. Case for Copyright Disclosure Requirements**

There is an overall misunderstanding that copyright law does not have a disclosure requirement. I argue that there is an underappreciated disclosure requirement in copyright law: Copyright registration. Scholarship is full of criticism contrary to the existence of a public disclosure requirement for copyrights. However, just as in patent law, the purpose of the disclosure requirement is to establish the metes and bounds of the protection requested by the creator for his copyrighted work. The protection granted will enable others to build upon the works, and after the protection expires, to use the work itself. Additionally, fixation in a tangible medium of expression does not meet the level of disclosure needed to receive exclusive rights in one's copyrightable work. Fixation merely makes something copyrightable. Therefore, I argue that in order for the author to receive exclusive rights in copyright, his quid pro quo for disclosure is to have his work registered in the Copyright Office.

The owner of copyrighted material has the following rights in his copyrighted work:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and
- (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.<sup>45</sup>

The duration of the rights is even more significant than for patent protection. The exclusive rights for a copyright owner extend for the life of the author, plus 70 years.<sup>46</sup>

In order for an author to have a copyright in his work, the only requirements are fixation in a tangible medium of expression.<sup>47</sup> Once an author has fixed his expression of an idea onto a tangible medium of expression, even for a transitory time, his work is copyrightable. However,

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<sup>44</sup> *Id.*

<sup>45</sup> 17 U.S.C. § 106 (2002).

<sup>46</sup> 17 U.S.C. § 302 (1998).

<sup>47</sup> 17 U.S.C. § 102(a) (1990).

if an author wants to enforce his rights in his copyrighted work as to against all others (his quid pro quo), his work must be registered. Therefore, an author may technically have a copyright once the expression is fixed in a tangible medium of expression; however, he has no enforceable rights in the copyright until the copyright has been registered. Hence, the quid pro quo for exclusive rights in his copyrighted work is disclosure, and the disclosure requirement of copyrighted works is the registration of the copyright.

The scholarship is ripe with examples rebuking the notion that copyright law contains no disclosure requirement. Professor John Cady stated that “unlike patent law, copyright law does not have a disclosure requirement.”<sup>48</sup> Professor Richard Zerbe explained that “[copyright rights] are granted without a disclosure requirement because copyright protection attaches once the work is fixed in a tangible medium of expression.”<sup>49</sup> He also explained that “this missing disclosure requirement is an aberration of the copyright law.”<sup>50</sup> Professor Sharon Sandeen added that “the Copyright Act does not require authors to publicly disclose their works.”<sup>51</sup> David Luetgen explained that “copyright law does not need disclosure requirements because of the very fact that the subject matter of copyright is communicative.”<sup>52</sup> Stephen Davidson added that “unlike the patent laws, the objective of the copyright laws is not disclosure, but rather the reduction of ideas to original forms of expression.”<sup>53</sup> Further, Brett Frischmann and Dan Moylan added that there is an “absence of an explicit disclosure requirement in copyright law.”<sup>54</sup>

This belief is not quite correct. If the owner of a copyrighted work wants protection for his copyrighted works, he must publicly disclose that for which he wants protection. This requirement is no different than the requirement for patent protection. In order for an inventor to receive rights in his patent, he must disclose the limits and scope of the invention.<sup>55</sup> This would be analogous to an inventor who did not disclose his patent, according to the requirements of the patent law, attempting to later claim patent rights on another’s invention after that other’s work has been created. The inventor attempting to enforce rights would be barred from claiming he had patent protection, since he did not meet the disclosure requirements of 35 U.S.C. § 112. The same bar applies for copyrighted works. The owner of a copyrighted work must have made public disclosure of the subject matter for which he wants protection. That public disclosure is given through the registration requirement for copyrights.

Congress has made it clear that there is a public disclosure requirement for copyrighted work. The Copyright Act states that “no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title.”<sup>56</sup> This requirement bars anyone who has not met the public

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<sup>48</sup> John Cady, *Copyrighting Computer Programs: Distinguishing Expression from Ideas*, 22 Temp. Envtl. L. & Tech. J. 15, 35 (2003).

<sup>49</sup> Lawrence D. Graham & Richard O. Zerbe, Jr., *Economically Efficient Treatment of Computer Software: Reverse Engineering, Protection, and Disclosure*, 22 Rutgers Computer & Tech. L.J. 61, 108 (1996).

<sup>50</sup> *Id.* at 124.

<sup>51</sup> Sharon K. Sandeen, *Kewanee Revisited: Returning to First Principles of Intellectual Property Law to Determine the Issue of Federal Preemption*, 12 Marq. Intell. Prop. L. Rev. 299, 347 (2008).

<sup>52</sup> David G. Luetgen, *Functional Usefulness vs. Communicative Usefulness: Thin Copyright Protection for the Nonliteral Elements of Computer Programs*, 4 Tex. Intell. Prop. L.J. 233, 271 (1996).

<sup>53</sup> Stephen J. Davidson, *Reverse Engineering and the Development of Compatible and Competitive Products Under United States Law*, 5 COMPUTER & HIGH TECH. L.J. 401, 419 (1989).

<sup>54</sup> Brett Frischmann & Dan Moylan, *The Evolving Common Law Doctrine of Copyright Misuse: A Unified Theory and Its Application to Software*, 15 Berkeley Tech. L.J. 865, 877 (2000).

<sup>55</sup> 35 U.S.C. § 112 (2012).

<sup>56</sup> 17 U.S.C. § 411 (2008).

disclosure requirement from bringing an action against another for rights in the copyright, further strengthening the quid pro quo of exclusive rights with disclosure.

Court after court has solidified the registration requirement. The Supreme Court has held that a precondition to enforcing an owner's rights in copyright (by filing a copyright infringement claim) is the Copyright Act's registration requirement.<sup>57</sup> Circuit courts have followed this precedent, with the First, Seventh, Ninth, and Eleventh Circuits further reinforcing the registration requirement.<sup>58</sup>

Therefore, it is undisputable that there is a disclosure requirement in copyright law in order for a copyright owner to attain the quid pro quo of exclusive rights in his copyrighted work: Copyright registration. Just as in patent law, an author can receive exclusive rights in his copyrighted work, but he must first share the work with the public, in order to promote the progress of science.

In order for an author to have his work registered, he must have fixed his expression in a tangible medium for longer than a transitory duration. Hence, while his work may be copyrightable once it is fixed in a tangible medium, the author does not attain exclusive, protectable rights in his copyright until the copyrighted work is registered.

The Supreme Court has set forth the pre-condition of registration, prior to an author obtaining protectable copyright rights.<sup>59</sup> In *Reed Elsevier*, the plaintiffs were freelance authors who sued defendant publishers for infringement because the publishers had electronically printed their works without prior permission.<sup>60</sup> While some of the works were registered, there were works that were not registered.<sup>61</sup> The Court explained that Congress is given power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors ... the exclusive Right to ... their ... Writings.” Art. I, § 8, cl. 8.”<sup>62</sup> The Court cited Section 411(a) of the Copyright Act by stating that “no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title.”<sup>63</sup> The Court went on to hold that Section 411(a) imposes a precondition to filing a claim.<sup>64</sup>

The Seventh Circuit also weighed in on the fact that registration is required prior to an author attaining rights in a copyrightable work.<sup>65</sup> In *Johnson*, plaintiff was a singer-songwriter who sued defendants that used a portion of his song in their own song.<sup>66</sup> Plaintiff, however, never

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<sup>57</sup> *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010).

<sup>58</sup> See *Airframe Sys., Inc. v. L-3 Communications Corp.*, 658 F.3d 100, 105 (1st Cir. 2011) (“proof of registration of the allegedly infringed work remains an element[ ] of a cause of action for copyright infringement” (internal citations omitted)); *Johnson v. Cypress Hill*, 641 F.3d 867, 873 (7th Cir. 2011) (“the copyright registration requirement of 17 U.S.C. § 411(a) is a precondition to filing a claim”); *Cosmetic Ideas, Inc. v. IAC/Interactivecorp.*, 606 F.3d 612, 615 (9th Cir. 2010) *cert. denied* 131 S. Ct. 686 (U.S. 2010) (“[s]ection 411(a)'s registration requirement is a pre-condition to filing a claim”); and *Kernel Records Oy v. Mosley*, 694 F.3d 1294 (11th Cir. 2012) (“although registration is not a condition of copyright protection, registration or a refusal of registration of a United States work is a prerequisite for bringing an action for copyright infringement. 17 U.S.C.A. § 408(a).”).

<sup>59</sup> *Id.* at 1247.

<sup>60</sup> *Id.* at 1242.

<sup>61</sup> *Id.*

<sup>62</sup> *Id.* at 1241.

<sup>63</sup> *Id.* at 1245.

<sup>64</sup> *Id.* at 1247.

<sup>65</sup> *Johnson v. Cypress Hill*, 641 F.3d 867 (7th Cir. 2011).

<sup>66</sup> *Id.* at 869.

registered the copyright of his song.<sup>67</sup> The Seventh Circuit explained that in order for a song to be entitled to copyright protection, the copyright must be registered.<sup>68</sup> The Seventh Circuit explained that a necessary precondition to filing a copyright infringement claim is that the copyright be registered in accordance with 17 U.S.C. § 411(a).<sup>69</sup>

The Eleventh Circuit also reviewed the requirement of copyright registration in order for a copyright owner to have rights in the copyrighted work.<sup>70</sup> In *Oravec*, the copyright owner sued architects and several developers for copyright infringement.<sup>71</sup> The Eleventh Circuit explained that the goal of copyright protection is to encourage creation of original works, while promoting the free flow of ideas and information.<sup>72</sup> Further, the Eleventh Circuit held that registration is a prerequisite for an infringement action.<sup>73</sup>

Protection is provided for authors, in order to promote the Constitutional goal of the progress of science. Therefore, in order for one to attain protectable, enforceable rights in his copyrightable work, there is a quid pro quo requirement that his work must be registered. Registration discloses to the world that the specific work that is requested to be protected under copyright law. Hence, just as in patent law, there is a disclosure requirement for copyright, even though scholars disagree.

Therefore, I argue that copyright registration is an underappreciated disclosure requirement in copyright law. Although scholarship decries the existence of a public disclosure requirement for copyrights, the courts' holdings state otherwise. If a copyright owner wants to receive exclusive rights in his work, he must dictate the metes and bounds of his work, so that others may build upon the work and use the work itself after the protection expires. Further, fixation in a tangible medium of expression does not meet the level of disclosure needed to receive exclusive rights in one's copyrightable work. Thus, in order for the owner of a copyrightable work to receive exclusive rights in copyright, his quid pro quo for disclosure is to have his work registered in the Copyright Office.

#### **IV. Case for Trademark Disclosure Requirements**

Similarly to copyright law, there is lack of appreciation that trademark law has a disclosure requirement. I argue that the quid pro quo disclosure requirement needed to receive exclusive rights in a trademark is actual use in interstate commerce. Protection of trademark rights derives from the Commerce Clause of the Constitution. The scholarly belief is that trademark law contains no disclosure requirement. Once again, just as in copyright and patent law, the purpose of the disclosure requirement is to establish the metes and bounds of the protection requested by the creator for his mark. The disclosure of the mark to the public occurs when the mark is used in interstate commerce. The requirement that an applicant have a duty of candor to the Patent and Trademark Office does not meet the disclosure requirement of actual use. Additionally, although trademarks are able to be registered, registration does not meet the required level of public disclosure needed to receive protectable, exclusive rights. Thus, in trademark law, the quid pro quo for exclusive, protectable rights in trademark is the actual use of the mark in interstate commerce.

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<sup>67</sup> *Id.* at 870.

<sup>68</sup> *Id.* at 873.

<sup>69</sup> *Id.*

<sup>70</sup> *Oravec v. Sunny Isles Luxury Ventures, L.C.*, 527 F.3d 1218 (11th Cir. 2008).

<sup>71</sup> *Id.* at 1220.

<sup>72</sup> *Id.* at 1225.

<sup>73</sup> *Id.* at 1229.

Trademark protection is given through the Congress' power to regulate Commerce among the several States.<sup>74</sup> The Lanham Act gives owners of trademarks exclusive, protectable rights for protection against the unauthorized use of their trademarks. The pertinent text reads

(1) Any person who shall, without the consent of the registrant--

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive,

shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

15 U.S.C. § 1114.

The jurisdictional hook of interstate commerce was incorporated in the language of the Lanham Act. Congress explained that “[t]he word “commerce” means all commerce which may lawfully be regulated by Congress.”<sup>75</sup> Therefore, the ability for a trademark owner to attain exclusive rights in his mark derives from Art. I, Sec. 8, cl. 3 of the Constitution.

The duration of the rights in trademarks is potentially the longest of any intellectual property subject matter. The exclusive rights for a trademark owner could possibly extend to perpetuity.<sup>76</sup> In order to attain these rights, the quid pro quo of disclosure is required. For trademark law, the disclosure requirement is actual use in interstate commerce.

As in copyright law, the scholarly belief is that there is no disclosure requirement for trademarks. There is a large amount of scholarly criticism that trademark law does not have a disclosure requirement. In stating that there was no disclosure requirement for trademarks, Vincent Palladino argued for a disclosure requirement for trademarks.<sup>77</sup> Michael Weicher also

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<sup>74</sup> U.S. Const. art. I, § 8, cl. 3.

<sup>75</sup> 15 U.S.C. § 1127 (2006).

<sup>76</sup> Subject to maintaining the continuous validity of the mark. *See e.g.* Lanham Trademark Act § 45, 15 U.S.C. § 1127 (abandonment, owner's lack of reasonable control of its mark); *See also* Five Platters, Inc. v. Purdie, 419 F.Supp 372 (D.Md. 1976) and Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4 (2d Cir. 1976) (genericism, misrepresentation of mark); *See also* Green River Bottling Co. v. Green River Corp., 997 F.2d 359 (7<sup>th</sup> Cir. 1993) (naked license); *See also* Sweetheart Plastics, Inc. v. Detroit Forming, Inc., 743 F.2d 1039 (4<sup>th</sup> Cir. 1984) (laches); *See Also* Quaker State Oil Refining Corp. v. Kooltone, Inc. 217 USPQ 11 (2d Cir. 1981) (acquiescence of use).

<sup>77</sup> Vincent N. Palladino, *Gray Market Goods: The United States Trademark Owners' View*, 79 TRADEMARK REP. 158, 199 (1989) (arguing for an explicit requirement that sellers explicitly disclose their mark in order to inform consumers of the source of their goods).

suggested for a disclosure requirement for trademarks.<sup>78</sup> In hearings before Senate, it was suggested that a disclosure requirement be added to the Lanham Act.<sup>79</sup> Also, Brian Peterman proposed a disclosure requirement for trademark protection.<sup>80</sup> Palladino, Weicher, and Peterman argue that trademarks should be disclosed to the public, so that consumers are able to identify the source of the goods and services. They argue that this disclosure will lead consumers to not be confused in the marketplace. However, actual use in interstate commerce already serves the purpose of identifying the source of goods and services.

Some may argue that the requirement in the Patent and Trademark Office (PTO) that applicants have complete candor constitutes a disclosure requirement. The case usually cited as establishing a duty of candor in the PTO is *T.A.D. Avanti, Inc. v. Phone-Mate, Inc.*, 199 U.S.P.Q. 648 (C.D. Cal. 1978). In *T.A.D. Avanti*, the court explained that the plaintiff's president could not have vouched for the mark in his registration, and therefore, the court invalidated the registration. The court explained the following:

“[a]n applicant for registration of a trademark is required to exercise uncompromising candor in his communications with the United States Patent and Trademark Office, lest any registration he obtains will be invalid and/or unenforceable. He must not only refrain from making false representations to the United States Patent and Trademark Office, but must make full disclosure of all facts to his knowledge which might bear in any way on the Office's decision to grant the registration sought.”

*Id.* at 655.

The court made clear that the duty of candor only refers to knowledge which might bear on the PTO's registration decision. The duty of candor, though, does not create an affirmative disclosure requirement for content of the trademark sought.

The duty to candor to the PTO, therefore, would not rise to the level of disclosure necessary to constitute public disclosure. Professor Susan Richey explained the fallacy that the duty of candor could rise to the level of a disclosure requirement.<sup>81</sup> Professor Richey explained that the applicant's duty of candor does not equate to an affirmative duty to disclose facts material to registration proceedings before the United States Patent and Trademark Office.<sup>82</sup> Professor Richey further explained that the Lanham Act is silent on the issue of disclosure.<sup>83</sup> She concluded that “the obligation not to lie is different than an affirmative obligation to produce

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<sup>78</sup> Michael B. Weicher, *K Mart Corp. v. Cartier, Inc.: A Black Decision for the Gray Market*, 388 AM.U.L.REV. 463 (1989) (stating that a disclosure requirement could be added to existing federal law in order to protect the consumer and trademark owner).

<sup>79</sup> Legislation to Amend the Lanham Trademark Act Regarding Gray Market Goods: Hearings on S.626 Before the Subcomm. on Patents, Copyrights and Trademarks of the Senate Committee on the Judiciary, 101st Cong., 2d Sess. 111-12 (1990) (oral and written statement of Hon. Warren Rudman, a U.S. Senator from the State of New Hampshire).

<sup>80</sup> Brian W. Peterman, *The Gray Market Solution: An Allocation of Economic Rights*, 28 Tex. Int'l L.J. 159 (1993) (arguing for a Lanham Act equivalent to statutes in California and New York).

<sup>81</sup> Susan M. Richey, *The Second Kind of Sin: Making the Case for A Duty to Disclose Facts Related to Genericism and Functionality in the Trademark Office*, 67 Wash. & Lee L. Rev. 137 (2010).

<sup>82</sup> *Id.* at 139. (noting that any duty to disclose would need to arise out of Section 1(a) of the Lanham Act, in particular, and that provision only requires that the applicant refrain from making knowingly false or misleading statements in the verified declaration accompanying the application).

<sup>83</sup> *Id.*

relevant information.”<sup>84</sup> Additionally, Professor Richey provided numerous examples where case law explained that the duty of candor is not equivalent to public disclosure of the trademark.<sup>85</sup>

Another argument that may be made is that trademark registration could meet the public disclosure requirement. Like copyrights, trademarks are able to be registered.<sup>86</sup> However, trademark registration is not a public disclosure requirement; rather, registration merely provides the presumption of validity of a trademark.<sup>87</sup> The Fifth Circuit explained this concept.<sup>88</sup> In *Amazing Spaces*, the plaintiff brought an action for trade dress infringement for defendant’s use of the mark.<sup>89</sup> The Fifth Circuit explained that “proof of the registration of a mark with the PTO constitutes prima facie evidence that the mark is valid and that the registrant has the exclusive right to use the registered mark in commerce with respect to the specified goods or services.”<sup>90</sup> The Ninth Circuit expanded on the presumption.<sup>91</sup> In *Zobmondo*, the Ninth Circuit explained that the presumption of validity is a “strong one.”<sup>92</sup>

Besides there existing a strong presumption of validity, trademark registration also provides benefits for registration. The Court of Customs and Patent Appeals explained the benefits of registration.<sup>93</sup> In *In re McGinley*, the Court of Customs and Patent Appeals stated that the benefits of registration:

“include public notice of the mark in an official government publication and in official records which are distributed throughout the world, maintenance of permanent public records concerning the mark,

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<sup>84</sup> *Id.* at 208.

<sup>85</sup> *Id.* (citing *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 877 (8th Cir. 1994) (noting that an applicant for a trademark owes a duty of candor to the United States Patent and Trademark Office); *Orient Express Trading Co. v. Federated Dep’t Stores, Inc.*, 842 F.2d 650, 653 (2d Cir. 1988) (“[A]ppellants’ statements to the PTO had not reflected the ‘uncompromising candor’ that is required of applicants before that agency. The allegedly fraudulent statements may not be the product of mere error or inadvertence, but must indicate a ‘deliberate attempt to mislead the [PTO].’”); *Daesang Corp. v. Rhee Bros.*, 77 U.S.P.Q.2d 1753, 1760 (D. Md. 2005) (“It is well established that an applicant for a registration of a trademark has a duty of candor in his communications with the PTO.”); *Deflecta-Shield Corp. v. Kar-Rite Corp.*, 229 U.S.P.Q. 743, 747 (N.D. Ill. 1986) (noting that an applicant has a “duty to disclose the fact that a term is generic, and failure to do so will result in a denial of all relief for trademark infringement to the plaintiff”); *T.A.D. Avanti, Inc. v. Phone-Mate, Inc.*, 199 U.S.P.Q. 648, 655-56 (C.D. Cal. 1978) (noting an applicant is required to exercise “uncompromising candor” in his communications with the PTO); *Citibank N.A. v. Citibanc Group, Inc.*, 215 U.S.P.Q. 884, 903 (N.D. Ala. 1982) (“‘[F]alse’ and ‘fraudulent’ as used in 15 U.S.C. § 1120 are not synonymous, and that damages are recoverable thereunder where the registration is procured either by a declaration which was incorrect or by a declaration which was a willful attempt to mislead and injury has resulted as a consequence thereof.”), *aff’d*, 724 F.2d 1540 (11th Cir. 1984); *Contra Citibank*, 215 U.S.P.Q. at 899 (declining to endorse a broad affirmative duty of disclosure and noting that the only support for the quoted language from *T.A.D. Avanti* is Section 38 of the Lanham Act).

<sup>86</sup> 15 U.S.C. § 1051 (2002) (Principal Register), 15 U.S.C. § 1091 (2002) (Supplemental Register).

<sup>87</sup> *Contour Chair-Lounge Co. v. Englander Co.*, 324 F.2d 186, 187-88 (C.C.P.A. 1963) (quoting Act of 1946 (15 U.S.C. § 1057(b)) which reads: “A certificate of registration of a mark upon the principal register provided by this Act shall be prima facie evidence of the validity of the registration, registrant’s ownership of the mark, and of registrant’s exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate, subject to any conditions and limitations stated therein.”).

<sup>88</sup> *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225 (5th Cir. 2010).

<sup>89</sup> *Id.*

<sup>90</sup> *Id.* at 237.

<sup>91</sup> *Zobmondo Entm’t, LLC v. Falls Media, LLC*, 602 F.3d 1108 (9th Cir. 2010).

<sup>92</sup> *Id.* at 1115.

<sup>93</sup> *In re Robert L. McGinley*, 660 F.2d 481 (CCPA 1981).

availability of Customs Service for blocking importation of infringing goods, access to federal courts where there is a presumption of validity of the registration ..., notices to the registrant concerning maintenance of the registration, and, to some extent, direct government protection of the mark in that the PTO searches its records and refuses registration to others of conflicting marks. Apart from nominal fees, these costs are underwritten by public funds.”

*In re Robert L. McGinley*, 660 F.2d 481, 486 (CCPA 1981).

The Fourth Circuit also explained some of the benefits conferred by trademark registration. The Fourth Circuit explained that “registration confers certain benefits on the owner, such as serving as prima facie evidence of the mark's validity and entitling the owner of the mark to proceed on an in rem basis under the Anticybersquatting Consumer Protection Act (ACPA).”<sup>94</sup> In light of the presumption of validity and the benefits that registration provides, registration is encouraged as one of the purposes of the Lanham Act.<sup>95</sup>

Although trademark registration provides a rebuttable presumption of validity, as well as numerous benefits, registration does not satisfy the disclosure that trademark protection requires. In order to attain the quid pro quo of exclusive, protectable rights in a trademark, the trademark owner must publicly disclose the trademark by actual use in commerce. The Fourth Circuit elaborated on this principle.<sup>96</sup> The Fourth Circuit explained that “it is the use of a mark, not its registration, that confers trademark protection.”<sup>97</sup>

Therefore, it follows that there is a disclosure requirement as a quid pro quo in exchange for exclusive rights for trademark protection: actual use the mark in interstate commerce. The level of usage must meet a statutory level: “the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.”<sup>98</sup> Congress explained its reasoning in the Lanham Act:

The intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.

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<sup>94</sup> *Id.*

<sup>95</sup> *See* Aluminum Fabricating Co. of Pittsburgh v. Season-All Window Corp., 259 F.2d 314, 316 (2d Cir. 1958) (stating that “one of the purposes of the Lanham Act was to encourage registration of trademarks and other marks.”). *See also* *In re Int'l Flavors & Fragrances, Inc.*, 183 F.3d 1361, 1367 (Fed. Cir. 1999) (stating that “one of the policies sought to be implemented by the Act was to encourage the presence on the register of trademarks of as many as possible of the marks in actual use so that they are available for search purposes.”). *See also Id.* at 1367 (stating that these additional protections are granted by the Lanham Act to encourage trademark owners to register their marks with the PTO.”).

<sup>96</sup> *Harrods Ltd. v. Sixty Internet Domain Names*, 302 F.3d 214 (4th Cir. 2002).

<sup>97</sup> *Id.*

<sup>98</sup> 15 U.S.C. § 1127 (2006).

15 U.S.C. § 1127.

The Second Circuit explained that protection for rights in trademark emanate from the mark's actual use in commerce.<sup>99</sup> In *United We Stand*, plaintiff brought a trademark infringement action against defendants for its mark.<sup>100</sup> The Second Circuit explained that “use in commerce” denotes Congress’ authority under the Commerce Clause, U.S. Const., Art. I, § 1, cl. 3, to regulate the use of trademarks.<sup>101</sup> The Second Circuit explained that in order for a trademark owner to obtain protectable, enforceable rights in his mark, the quid pro quo for protection required that the mark must be used in commerce.<sup>102</sup> In requiring an actual use in commerce, a trademark owner must publicly disclose to the public his trademark if he wishes to receive protection for the mark.

The Ninth Circuit also explained that use in commerce is a prerequisite to obtaining protectable rights in the mark.<sup>103</sup> In *Levi Strauss*, plaintiff brought a trademark infringement action against defendant for its stitching design.<sup>104</sup> The Ninth Circuit explained that “[t]he owner of a famous mark shall be entitled ... to an injunction against another person's commercial use in commerce of a mark or trade name, 15 U.S.C. § 1125(c) (2005).”<sup>105</sup> The Ninth Circuit explained that a trademark owner obtains protectable rights in his mark through actual use in commerce.<sup>106</sup> The owner’s ability to attain protectable rights apply only after the mark has been used in commerce, or publicly disclosed.

Another Ninth Circuit case describes the use in commerce requirement for obtaining the quid pro quo of protectable rights under trademark law.<sup>107</sup> In *Karl Storz Endoscopy*, the manufacturer of rigid endoscopes brought a trademark infringement suit against a repair company.<sup>108</sup> In evaluating the plaintiff’s right in his trademark, the Ninth Circuit stated that in order for a mark to be protectable, it must have been used in interstate commerce.<sup>109</sup> The Ninth Circuit even went on to describe what constitutes “use in commerce.”<sup>110</sup> The Ninth Circuit stated that “a mark is used in commerce when (1) the mark has been placed on the goods or their containers, labels or the documents associated with the goods or their sale, and (2) the goods are ‘sold or transported in commerce.’ 15 U.S.C. § 1127.”<sup>111</sup> The reason that a mark must be used in commerce in order to attain protectable rights is that the mark must be disclosed to the public through actual use in commerce.

District Courts have also added to the reasoning for the use in commerce requirement.<sup>112</sup> In *S Industries*, the Northern District of Illinois explained why use in commerce is required in order

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<sup>99</sup> *United We Stand Am., Inc. v. United We Stand, Am. New York, Inc.*, 128 F.3d 86 (2d Cir. 1997).

<sup>100</sup> *Id.* at 88.

<sup>101</sup> *Id.* at 92.

<sup>102</sup> *Id.* at 93.

<sup>103</sup> *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 633 F.3d 1158, 1166 (9th Cir. 2011).

<sup>104</sup> *Id.* at 1160.

<sup>105</sup> *Id.* at 1166.

<sup>106</sup> *Id.* at 1169.

<sup>107</sup> *Karl Storz Endoscopy Am., Inc. v. Surgical Technologies, Inc.*, 285 F.3d 848 (9th Cir. 2002).

<sup>108</sup> *Id.* at 852.

<sup>109</sup> *Id.* at 854.

<sup>110</sup> *Id.* at 855.

<sup>111</sup> *Id.*

<sup>112</sup> *S Indus., Inc. v. Stone Age Equip., Inc.*, 12 F. Supp. 2d 796, 805 (N.D. Ill. 1998). *DSMR, LLC v. Goldberg*, 02 C 5203, 2004 WL 609281 (N.D. Ill. Mar. 25, 2004).

for one to attain protectable rights in the mark.<sup>113</sup> The Northern District of Illinois stated that “[u]nder the common law, ownership is conferred on ‘the person who employs the first actual use of a mark in a genuine commercial transaction.’”<sup>114</sup> The reason for the first actual use is that in order for a trademark owner to attain protection in his mark, his mark must be publicly disclosed. The court in *DSMR*, further explained the requirement of use in commerce.<sup>115</sup> The court explained that in order for one to attain protectable rights in a mark, “one must win the race to the marketplace to establish exclusive use of the mark.”<sup>116</sup> Once again, the court stated this in order to reinforce the requirement that the mark be publicly disclosed in order to attain the quid pro quo of trademark protection.

Courts have further solidified that trademark protection derives from actual use in commerce. The granting of the exclusive rights in trademarks comes from actual use in interstate commerce. Courts and scholars have provided numerous examples demonstrating the fact that exclusive rights in trademark are allowable only after the mark has been used in interstate commerce.<sup>117</sup>

Protection is provided for trademark owners through Congress’ power to regulate interstate commerce. In order for a trademark owner to obtain that protection, he must publicly disclose his mark through the actual use of the mark in commerce. Use of the mark in commerce discloses to the world the work that subject matter which is requested to be protected. Hence, just as in patent law, there is a disclosure requirement for trademark law as well.

In conclusion, the quid pro quo disclosure requirement needed to receive exclusive rights in a trademark is actual use in interstate commerce. Even though the scholarly belief is that trademark law contains no disclosure requirement, I argue that in order for an owner of a trademark to obtain exclusive, protectable rights in his mark, he must use the mark in interstate commerce. The actual use establishes the metes and bounds of the protection requested by the creator for his mark and discloses the mark to the public. An applicant’s duty of candor to the Patent and Trademark Office does not satisfy the disclosure requirement of actual use. Additionally, trademark registration does not meet the necessary level of public disclosure needed to receive protectable, exclusive rights. Thus, in trademark law, the quid pro quo for exclusive, protectable rights in one’s trademark is the actual use of the mark in interstate commerce.

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<sup>113</sup> See *S Indus*, *supra* note 87.

<sup>114</sup> *Id.* at 805 (quoting *Allard Enterprises, Inc. v. Advanced Programming Resources, Inc.*, 146 F.3d 350 (6<sup>th</sup> Cir. 1998)).

<sup>115</sup> See *DSMR*, *supra* note 87.

<sup>116</sup> *Id.*

<sup>117</sup> See *Tally-Ho, Inc. v. Coast Community College Dist.*, 889 F.2d 1018, 1022 (11<sup>th</sup> Cir.1989) (stating that where, as here, neither party has registered a disputed trademark with the federal government, the parties must look to common law and state statutes to determine what protection they have); *United States v. Steffens*, 100 U.S. 82 (1879) (stating that under the common law, trademark rights are appropriated only through actual prior use in commerce); J. McCarthy, *Trademarks and Unfair Competition* § 16:1, at 720 (2d Ed.1984) (explaining that trademark ownership is always appurtenant to commercial activity. Thus, actual and continuous use is required to acquire and retain a protectible interest in a mark); *Elec. Communications, Inc. v. Elec. Components for Indus. Co.*, 443 F.2d 487, 492 (8<sup>th</sup> Cir. 1971) (stating that the right to a trademark is acquired by appropriation and use as such, and actual use in commerce in connection with the goods is necessary to the acquisition of any rights. The mere advertisement of words or symbols without application to the goods themselves is insufficient to constitute a trademark); *Crystal Entm't & Filmworks, Inc. v. Jurado*, 643 F.3d 1313, 1321 (11<sup>th</sup> Cir. 2011) (stating that common-law trademark rights are appropriated only through actual prior use in commerce); *United States v. Steffens*, 100 U.S. 82, 94 (1879) (stating that trademark rights, under the common law, are appropriated only through actual prior use in commerce); *In re Trade-Mark Cases*, 100 U.S. 82, 94 (1879) (explaining that at common law the exclusive right to trademark protection grows out of its use, and not its mere adoption).

## **V. Conclusion**

Scholars and courts are resolute in the belief that there is no disclosure requirement for copyright or trademark law. However, when one wishes to exercise his rights in his intellectual property, the scope of the protected material must be specified. The level of specification required is specified by the disclosure requirement. In order for someone to enforce his rights in his copyrighted work, he must register his copyright with the Copyright Office. Therefore, the disclosure requirement for copyright is copyright registration. Similarly, in order for someone to enforce his rights in his trademark, he must have used his mark in commerce. Hence, trademark protection is granted where a trademark owner has actually used his mark in interstate commerce. Analogously, in order for someone to enforce his rights in his patent, he must have disclosed his invention in accordance with 35 U.S.C. § 112. Therefore, copyright, trademark, and patent law all have the quid pro quo of disclosure in order to receive protection for the underlying intellectual property. The fact that there is a disclosure requirement in all subjects of intellectual property law is underappreciated, and scholars and courts should recognize the existence of disclosure requirements for each.