



SECTION 43(A) OF THE SHAKESPEARE CANON
OF STATUTORY CONSTRUCTION:
THE BEVERLY W. PATTISHALL INAUGURAL
LECTURE IN TRADEMARK LAW

JOHN PAUL STEVENS

Abstract

Beverly Pattishall is a name that has secondary meaning for law students, for veteran trial lawyers—especially those seeking a more courteous and collegial bar—and for bar associations at the local, the national, and indeed the international level. It is fitting that a lecture series be dedicated to a quintessential “scholar and gentleman.” The Shakespeare Canon of Statutory Construction, like all of Shakespeare’s plays, contains five parts: Read the statute; read the entire statute; read the statute in its contemporary context; if necessary, consult the legislative history; and, finally, use your common sense. Section 43(a) of the Lanham Act has required judges to write a number of opinions that rely much more heavily on common sense than on the text of that statute.

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LECTURE IN TRADEMARK LAW

JOHN PAUL STEVENS*

The invitation to deliver the first Pattishall Lecture on Trademark Law was particularly welcome for several reasons. First, the mere act of accepting the invitation gave me an easy and effective means of registering my high regard for an outstanding leader of our profession. Beverly Pattishall is a name that has secondary meaning for law students, for veteran trial lawyers—especially those seeking a more courteous and collegial bar—and for bar associations at the local, the national, and indeed the international level. It is fitting that a lecture series be dedicated to a quintessential “scholar and gentleman.” Second, because one function of an introductory talk is to raise questions for others to answer, it is permissible to reminisce about ancient anecdotes without attempting to provide any definitive interpretations of modern legislation such as the Anticybersquatting Consumer Protection Act¹ or the Digital Millennium Copyright Act.² Third, by allowing me to focus on interpretations of section 43(a) of a familiar statute, the lecture gives me the opportunity to shed a little light on how “conservative” federal judges respond to litigants’ requests for judicial lawmaking. And finally, this venue has provided me with a captive audience that must listen to my speculation about the validity of the proposition that a rose by any other name would smell as sweet. Would the works in the Shakespeare Canon have the same appeal if it turned out that their true source was a nobleman educated in the classics and the law at Oxford, Cambridge, and Grays Inn, rather than a townsman with little, if any, training in Latin or Greek?

Before I begin, let me give a brief explanation of the title of my talk. About a decade ago I discussed what I called the Shakespeare Canon of Statutory Construction in the Max Rosenn Lecture at Wilkes University.³ Like all of Shakespeare’s plays, the Canon contains five parts: Read the statute; read the entire statute; read the statute in its contemporary context; if necessary, consult the legislative history; and, finally, use your common sense—interpretations that produce absurd results are probably wrong, because it is unreasonable to believe that legislatures intended such results. There are judges and scholars who argue that only the first two parts of the canon are fully consistent with the judicial task of interpreting the law; the judge’s duty to avoid lawmaking requires close attention to statutory text and the avoidance of making rules not set forth in language drafted by legislators. Section 43(a) of the Lanham Act has, however, required judges to write a

* Associate Justice, Supreme Court of the United States. This Essay is based on an address given as the Beverly W. Pattishall Inaugural Lecture in Trademark Law at the John Marshall Law School in Chicago, Illinois on Oct. 17, 2001.

¹ Pub. L. No. 106-113, 113 Stat. 1536 (1999) (codified in scattered sections of 15 U.S.C.).

² Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified in scattered sections of 17 U.S.C.).

³ John Paul Stevens, *The Shakespeare Canon of Statutory Construction*, 140 U. PA. L. REV. 1373 (1992).

number of opinions that rely much more heavily on common sense than on the text of that statute.

I

When Beverly Pattishall graduated from the Virginia Law School in 1941, Coca Cola was sold in distinctive six-ounce glass containers at a retail price of five cents a bottle. A few years later he was one of the lawyers retained to defend the Coca Cola Company against a creative and amorphous charge that its policy of maintaining such a low price for such a popular product, coupled with its ownership of a valuable trademark, somehow added up to a violation of the Sherman Act. The case had no merit, but it produced what I have always regarded as a great benefit. Because Bev was working with the acknowledged leader of the trademark bar, William Woodson, and I was then working for one of Chicago's truly great trial lawyers, Edward R. Johnston, who was retained to defend the Coca Cola Bottling Company of Chicago, the case provided me with the opportunity to meet and begin a friendship and a growing admiration for the lawyer to whom these lectures are appropriately dedicated. It is, however, an even earlier personal reminiscence that I have selected for the purpose of introducing my comments today.

During the World's Fairs that celebrated Chicago's Century of Progress in 1933 and 1934, my father had the restaurant concession in the English Village. That village was especially popular because it included a replica of the Globe Theater where a talented company of actors performed most of the plays in the Shakespeare Canon. Incidentally, during a visit a few years ago the late Sam Wanamaker—who was the driving force behind the rebuilding of the modern Globe theater in London—told me that he was initially captivated by Shakespeare while attending those plays at the Chicago Fair. Two rather mundane facts about my father's employment practices in operating the restaurant concession in that village may help to illuminate the meaning of section 43(a) of the Lanham Act. First, his unabashed policy of nepotism enabled me to secure a position as a strolling vendor of Banbury Tarts. Second, in an attempt to recreate an appropriate Elizabethan ambience in the Red Lion Inn—the principal restaurant in the Village—he imposed a flagrantly discriminatory condition of employment on his waitresses: as a mark of respect for Queen Elizabeth the First, only women with red hair were allowed to work in the Red Lion Inn.

Because of the remote possibility that some of you may never have savored the taste of a Banbury Tart, I shall explain the source of its name. About halfway between Stratford-on-Avon and Oxford there is a town named Banbury. According to the unimpeachable testimony of my father—who was a self-styled expert in such matters—during Elizabeth's reign, the town was noted for its unique tarts, consisting of some sort of raisin-mix sandwiched, taco-style, between two dry crusts of pastry. While I have only the dimmest memory of their taste, I vividly recall that a tray piled high with Banbury tarts was extremely heavy. I have often wondered whether the secondary meaning that no doubt was associated with the name "Banbury Tart" was a consequence of the taste or the weight of the product. In all events, I have always firmly believed that the bakers of Banbury could have brought some sort of infringement action against Oxfordian or Stratfordian bakers who had the gall to

market their tarts under a Banbury label. Indeed, when the Lanham Act was enacted during my tenure as a law student at Northwestern, I am quite sure that I concluded that Congress intended section 43(a) of that Act to codify rules that had been developed in such litigation between English bakers. For as I recall, I was taught that it was a dispute between English bakers named Mitchel and Reynolds that provided us with the original rule of reason that is central to interpretation of the Sherman Act.⁴

As enacted, the text of section 43(a) provided in part that any person who uses or transports in commerce goods bearing either a “false designation of origin, or any false description or representation,” shall be civilly liable to “any person doing business in the locality falsely indicated as that of origin or in the region in which said locality is situated, or by any person who believes that he is or is likely to be damaged by the use of any such false description or representation.”⁵ The text of section 43(a) would unquestionably have provided a Banbury baker—and perhaps even the Banbury Chamber of Commerce—with a right of action against Stratfordian or Oxfordian merchants selling locally baked tarts under a label indicating that they had been baked in Banbury. It is less clear, however, that the statutory remedy would have been available if the nonresident bakers had merely copied the recipe and the appearance of the Banbury tarts and sold them under Stratfordian or Oxfordian labels. If they copied the triangular design of the tarts, or perhaps the colorful bags in which they were delivered, would they have made a “false description or representation” within the meaning of the statute? Perhaps the answer would be “yes” if the design or the packaging were well known throughout England as identifying Banbury as the source of the product. But what if those distinctive features had no secondary meaning whatsoever?

A few years ago the United States Supreme Court confronted a similar question in a dispute between operators of fast food restaurants specializing in the sale of Mexican food. The narrow issue presented in the case known as *Two Pesos, Inc. v. Taco-Cabana, Inc.*,⁶ was whether the trade dress of a restaurant may be protected under section 43(a) based on a finding of inherent distinctiveness without proof that the trade dress has secondary meaning. The plaintiff, Taco Cabana, Inc., opened its first restaurant in San Antonio in 1978, and by 1985 it was operating five more similar restaurants in that city. Those restaurants featured “a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals.”⁷ There was a jury finding that the atmosphere

⁴ See *Mitchel v. Reynolds*, 1 P. Wms. 181, 24 Eng. Rep. 347 (1711); *Nat’l Soc’y of Prof’l Eng’rs v. United States*, 435 U.S. 679, 688-89 (1978).

⁵ “Any person who shall affix, apply, or annex, or use in connection with any goods or services, or any container or containers for goods, a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause such goods or services to enter into commerce, and any person who shall with knowledge of the falsity of such designation of origin or description or representation cause or procure the same to be transported or used in commerce or deliver the same to any carrier to be transported or used, shall be liable to a civil action by any person doing business in the locality falsely indicated as that of origin or in the region in which said locality is situated, or by any person who believes that he is or is likely to be damaged by the use of any such false description or representation.” 15 U.S.C. § 1125(a) (1982).

⁶ 505 U.S. 763 (1992).

⁷ *Id.* at 765 (quotations omitted).

constituted a distinctive trade dress. Because the finding was not challenged, it was not necessary for our Court to decide just what features of the total ambience are essential to establish the distinctiveness of a restaurant's trade dress. I shall therefore assume that the finding really rested on evidence that all of the waiters and waitresses had red hair.

In any event, in 1985 and 1986 the defendant, Two Pesos, Inc., opened restaurants in Houston that adopted a motif similar to that used in Taco-Cabana's San Antonio restaurants. Even though Taco-Cabana had no restaurants in Houston, and even though its distinctive trade dress did not have a secondary meaning, it brought suit for trade dress infringement under section 43(a) and won in the District Court and the Court of Appeals. Our Court granted certiorari and affirmed. Our conclusion that a distinctive trade dress may be protected under section 43(a) despite the absence of evidence that it has secondary meaning was unanimous, but the three opinions explaining that conclusion followed different paths.

Writing for the Court, Justice White started from the premise that the general principles applicable to the qualification of a trademark for registration under section 2 of the Act are "for the most part" applicable to the protection of unregistered trade dress under section 43(a).⁸ Since section 2 authorizes the registration of inherently distinctive marks without evidence of secondary meaning, and since there is no "textual basis in § 43(a) for treating inherently distinctive verbal or symbolic trademarks differently from inherently distinctive trade dress,"⁹ there was no reason to engraft a secondary meaning requirement onto that section.

Justice Thomas and I each wrote a separate opinion concurring in the Court's judgment. My opinion noted that the Court's conclusion, though consistent with the purposes of the statute, marked a departure from its text, which does not mention trademarks or trade dress, and which was originally intended just to reach false designations or representations as to the geographic origins of products, as well as the common-law tort of passing off. I concurred because I was convinced that the Court's holding agreed with a well-developed consensus in the decisions of the courts of appeals and because Congress had endorsed their views in the Trademark Law Revision Act of 1988.¹⁰ In other words, I believed that deciding the case correctly required the use of all five of the Shakespeare Canons of Statutory Construction, rather than just the initial ones of reading the statute.

An over-simplification of the facts of the *Two Pesos* case will explain why its holding is unsupported by the text of section 43(a). Assume that the distinctiveness of the Taco Cabana trade dress was simply its employment of red-headed waiters and waitresses in its San Antonio restaurants. When Two Pesos opened a similar restaurant in Houston, its employment of similar staff surely could not be described as either a "false designation of origin" or a "false description or representation" about the identity of the restaurant without evidence that Houston consumers had some understanding of the message that red-headedness might convey. In the fourth edition of their casebook on Trademarks and Unfair Competition, Messrs. Pattishall, Hilliard, and Welch made a similar point in this language:

⁸ *Id.* at 768.

⁹ *Id.* at 774.

¹⁰ Pub. L. No. 100-667, 102 Stat. 3935 (1988) (codified as amended in scattered sections of 15 U.S.C.).

Did the Supreme Court in *Taco Cabana* correctly assume that whatever is ‘inherently distinctive’ also indicates source? An inherently distinctive trade dress perhaps may come to indicate source sooner than other subject matter through its use in commerce. But until a trade dress has come to signify source by virtue of use that has penetrated the consciousness of an appreciable number of relevant persons, there can be no deception.¹¹

In his separate opinion, Justice Thomas faulted the Court for its reliance on principles applicable to registrations under section 2 of the Act, and faulted me for relying on reasons akin to *stare decisis*, because in his view “the language of § 43(a)” itself dictated the proper result.¹² His opinion explains why—ironically in light of the common law which section 43(a) codified rather than the text of the provision itself—“the first user of an arbitrary package, like the first user of an arbitrary word, should be entitled to a presumption that his package represents him without having to show that it does so in fact.”¹³ The opinion does not, however, explain why a *second* person’s use of the arbitrary package in a market where the first use is unknown fits any dictionary definition of a “false description or representation” of anything. His opinion is an excellent example of the latitude that the “plain meaning” approach to questions of statutory construction affords to textualist judges.¹⁴

II

The *Two Pesos* case indicates that the trade dress of a Banbury tart is protectible under section 43(a) without a showing of secondary meaning, but the decision did not reach the question whether distinctive packaging and distinctive product design have an equally strong claim to trade dress protection, or the question whether the functionality of the distinctive feature might preclude protection. Although it may be difficult to find the answer to either of those questions in the text of section 43(a), the Court has been unanimous in answering, and in explaining its answer, to both.

As a preface to commenting on those answers, it is appropriate to note that the concept of functionality provides the principal check against the untethered growth of trademark and trade dress protection. In a 1993 case which bears Shakespeare’s name, but which actually involved an infringement of a registered trademark for fishing rods that have a “whitish, translucent” tip and a contrasting opaque shaft, Judge Niemeyer of the Fourth Circuit made this comment:

The doctrine of functionality is an extra-statutory doctrine, neither defined nor limited by the express provisions of the Lanham Trademark

¹¹ BEVERLY W. PATTISHAL ET AL., *TRADEMARKS AND UNFAIR COMPETITION* 465 (4th ed. 1998).

¹² *Two Pesos*, 505 U.S. at 785 (Thomas, J., concurring in judgment).

¹³ *Id.* at 787.

¹⁴ See *Circuit City Stores, Inc. v. Adams*, 532 U.S. 105, 133 (2001) (Stevens, J., dissenting) (“[T]he ‘minimalist’ judge ‘who holds that the purpose of the statute may be learned only from its language’ has more discretion than the judge ‘who will seek guidance from every reliable source.’”) (quoting AHARON BARAK, *JUDICIAL DISCRETION* 62 (Y. Kaufmann transl. 1989)).

Act, which denies a perpetual monopoly of that which is functional. . . . The doctrine of functionality is a public policy trump card that may be played against an otherwise valid trademark, not an element to be considered in determining a mark's validity.¹⁵

Although this venerable doctrine is the work product of judges implementing the public interest in furthering free competition, Congress ultimately codified it in 1998 as an affirmative defense to a charge of infringement of an incontestable mark.¹⁶ It was again given statutory recognition in the trade dress context the following year when Congress amended section 43(a) of the Lanham Act to place the burden of proving nonfunctionality on a plaintiff asserting trade dress infringement (thereby resolving a circuit conflict).¹⁷

The doctrine of functionality is a cousin, if not a direct descendent, of opinions by Justices Holmes,¹⁸ Brandeis,¹⁹ Black,²⁰ and O'Connor,²¹ protecting the right to copy unpatented products such as bitter well water, cereal biscuits, pole lamps, and fiberglass boat hulls. As Justice Holmes explained in the bitter water case, the monopoly of a trademark does not extend to the product itself, and there is neither unfair competition nor fraud in copying or in truthful advertising describing it. Unlike the temporary monopoly privileges afforded by patents and copyrights, the duration of trademark protection is unlimited. Without the limitations provided by the functionality doctrine, protection of trade dress could therefore upset the balance between private incentive and public disclosure that is at the heart of the patent system. Common sense suggests that an unjustified expansion of trade dress protection might stifle the imitative innovation that plays an important role in technological progress. Our unanimous decision last term in *Traffix Devices, Inc. v. Marketing Displays, Inc.*,²² addressed this potential conflict between patent and trademark law.

In *Traffix*, we granted certiorari to resolve a conflict among the courts of appeals concerning the proper extent of the functionality doctrine in trademark law. I think there were two explanations for the confusion in the lower courts. First, notwithstanding the clarity of the legal right to copy the unpatented work product of a competitor, the copyist is often viewed as an unethical participant in the market; he is comparable to the price-cutting competitor who is applauded in our antitrust jurisprudence, but often viewed with disdain by leaders of the industry. In a close case, that attitude might tip the scales in favor of a finding that the copied feature was not functional. Second, language in our earlier decision in *Qualitex Co. v.*

¹⁵ *Shakespeare Co. v. Silstar Corp. of Am., Inc.*, 9 F.3d 1091, 1099 (4th Cir. 1993) (Niemeyer, J., dissenting).

¹⁶ Trademark Law Treaty Implementation Act, Pub. L. No. 105-330, § 201(a)(9), 112 Stat. 3064, 3070 (1998) (codified as amended at 15 U.S.C. § 1115(b)(8) (2000)).

¹⁷ Trademark Amendment Act of 1999, Pub. L. No. 106-43, § 5, 113 Stat. 218, 219, (codified as amended at 15 U.S.C. § 1125(a)(3) (2000)).

¹⁸ *Saxlehner v. Wagner*, 216 U.S. 375 (1910).

¹⁹ *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111 (1938).

²⁰ *Sears Roebuck & Co. v Stiffel Co.*, 376 U.S. 225 (1964).

²¹ *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989).

²² 532 U.S. 23 (2001).

Jacobson Products Co.,²³ was misunderstood. In that case we held that just as a shape, a sound, or a fragrance may act as a symbol qualifying for registration as a trademark, so also may pure color if it has secondary meaning. Our opinion rejected the argument that the green-gold color of the dry-cleaning pads at issue in that case was “functional.” We relied on the definition of functionality that we had used in *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*,²⁴ a case involving the use by generic drug manufacturers of capsules that copied the coloring and appearance of trademarked drugs. In *Inwood* we had noted that generally “a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.”²⁵ In *Qualitex*, however, we added the observation that the functionality doctrine “forbids the use of a product’s feature as a trademark where doing so will put a competitor at a significant disadvantage” because it is essential to the article’s use or purpose or affects its cost or quality.²⁶

Focusing on the reference to competitive disadvantage, rather than the quotation from the *Inwood* opinion, several courts of appeals (including the Sixth Circuit in the *TrafFix* case) concluded that a product feature was *only* functional if giving it trade dress protection would put competitors at a commercial disadvantage. This limitation had the effect of narrowing the functionality doctrine and thereby broadening trade dress protection to include product features that were clearly functional under a normal understanding of that word. The product in *TrafFix* is a good example. In that case, the Sixth Circuit, applying its narrow “competitive necessity” definition of functionality, held that a dual-spring mechanism designed by the respondent Marketing Displays, Inc. to keep traffic signs from falling over in high winds—a mechanism which was itself the subject of an expired utility patent—was not functional for the purposes of trade dress analysis. The Court of Appeals reached this counter-intuitive conclusion by reasoning that, because a host of alternative designs were available to competing manufacturers, those manufacturers suffered no competitive disadvantage by Marketing Displays’ acquisition of a monopoly of unlimited duration over the dual-spring design.

We unanimously rejected the Sixth Circuit’s overly restrictive definition of functionality. As Justice Kennedy pointed out in his opinion for the Court, our focus in *Qualitex* on competitive effects resulted, not from our adoption of an exceedingly narrow functionality doctrine, but merely from the fact that, in that case, we were considering a limited subcategory of functionality known as “esthetic functionality.” That is, we were considering the question whether, in some specialized circumstances, color by itself could be a functional product feature such that allowing trade dress protection over the product’s color would be inappropriate. Such a situation might arise, for example, if the product color in question were the orange color of a brand of orange-flavored soda. When addressing the quite unique category of esthetic functionality, questions of competitive disadvantage naturally come to the forefront as a useful means of separating the wheat from the chaff. But in *TrafFix*, we reasserted that such competitive questions do not define the outer limits of the functionality doctrine. Rather, any feature that affects the cost or quality of a product is a functional feature and

²³ 514 U.S. 159 (1995).

²⁴ 456 U.S. 844 (1982).

²⁵ *Id.* at 850 n.10.

²⁶ *Qualitex*, 514 U.S. at 169.

therefore not the proper subject of trade dress protection. That broad definition—though not set forth in the text of any statute—serves the common sense purpose of preventing trade dress protection from spinning out of control and supplanting patent law as the principal source of intellectual property rights over useful product features. Thus, the doctrine of functionality, as developed by the courts, has embodied the fifth of Shakespeare’s Canons of Statutory Construction.

III

The question whether the trade dress protection accorded by section 43(a) applies equally to distinctive product design and distinctive packaging was also answered by sound judicial reasoning rather than by the study of dictionary definitions of any statutory terms. The respondent in *Wal-Mart Stores v. Samara Brothers*²⁷ claimed that its product’s design was distinctive, and therefore protectible, in an action for infringement of unregistered trade dress under section 43(a). Samara had designed and manufactured a line of children’s clothing, including spring/summer one-piece seersucker outfits decorated with appliques of hearts, fruits, and the like. The line was marketed in a number of chain stores, not including the petitioner, Wal-Mart Stores. Instead of buying the product from Samara, Wal-Mart contracted with another supplier to manufacture outfits based on photographs of Samara garments, which were copied with only minor modifications, and sold them for lower prices. Samara sued for infringement of unregistered trade dress under section 43(a).

Samara won in the District Court, and the Second Circuit affirmed. The Supreme Court, however, unanimously reversed the Second Circuit’s decision, and held that product design, like color, was not inherently distinctive, and that, as a result, product design was entitled to protection as unregistered trade dress only if it had acquired secondary meaning. In a unanimous opinion written by Justice Scalia, the Court distinguished its earlier decision in *Two Pesos* because the trade dress at issue in *Two Pesos*, namely, the décor of a restaurant, seemed not to constitute product design, but rather product packaging “or else some *tertium quid* that is akin to product packaging and has no bearing on the present case.”²⁸

Portions of the convincing exposition for according lesser protection to the triangular design of a Banbury Tart than to its packaging merit quotation. At the outset, Justice Scalia acknowledged that “[t]he text of section 43(a) provides little guidance as to the circumstances under which unregistered trade dress may be protected.”²⁹ But he then reasoned:

It seems to us that design, like color, is not inherently distinctive. . . . In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs—such as a cocktail shaker shaped like a

²⁷ 529 U.S. 205 (2000).

²⁸ *Id.* at 215.

²⁹ *Id.* at 210.

penguin—is intended not to identify the source, but to render the product itself more useful or more appealing.

The fact that product design almost invariably serves purposes other than source identification not only renders inherent distinctiveness problematic; it also renders application of an inherent-distinctiveness principle more harmful to other consumer interests. Consumers should not be deprived of the benefits of competition with regard to the utilitarian and esthetic purposes that product design ordinarily serves by a rule of law that facilitates plausible threats of suit against new entrants based upon alleged inherent distinctiveness.³⁰

Justice Scalia, again relying on utilitarian common sense rather than statutory text, responded to the objection that the Court’s holding would force courts to draw difficult lines between product design and product packaging. He states:

We believe, however, that the frequency and the difficulty of having to distinguish between product design and product packaging will be much less than the frequency and the difficulty of having to decide when a product design is inherently distinctive. To the extent there are close cases, we believe that courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning. The very closeness will suggest the existence of relatively small utility in adopting an inherent-distinctiveness principle, and relatively great consumer benefit in requiring a demonstration of secondary meaning.³¹

I have quoted at length from Justice Scalia’s opinion to illustrate how judicial reasoning, unaided by statutory text, can provide a solid foundation for a rule of law. His opinion is an outstanding application of the fifth rule in the Shakespeare Canon of Statutory Construction.

IV

With your indulgence, I propose now to comment briefly on the question whether a rose would really be as attractive under an entirely different name. In the early days of my law practice, I occasionally was required to consider whether an advertised brand of a product such as milk, that commanded a higher retail price than an unadvertised brand of the identical product, was a good “of like grade and quality” within the meaning of the Robinson-Patman Act. A straightforward application of Juliet’s observation about roses provides us with an easy answer, but I have often wondered whether trademark lawyers or economists might have a different view.

³⁰ *Id.* at 212-13.

³¹ *Id.* at 215.

Consider names like Desdemona, Ophelia, Rosalind, Maryan, or Romeo, on the one hand, and names like Iago, Shylock, Caliban, Anselmo, or Bottom, on the other. Is it merely the secondary meaning derived from knowledge about those characters that produces the different reaction to the sound of their names, or do the sounds themselves have independent significance? Some authors not only pick the names of their characters with special care, but also create special names for themselves. Do the names Mark Twain, O. Henry, or George Eliot convey the same message as the names Samuel Clemens, William Sidney Porter, or Mary Anne Evans? Rather than identifying the true source of a written work, a pseudonym may conceal the author's identity but nevertheless provide some distinctive assurance about the quality of the work. We know what a Coca Cola will taste like even if we know nothing about the company that produces it.

The fact that a play or a poem was written by William Shakespeare gives rise to a presumption that it is worth reading. Would that presumption be equally strong if we were persuaded that the true author of the Shakespeare Canon was Edward de Vere, the 17th Earl of Oxford, who elected to write under another name? I suppose Juliet would say that the same presumption would prevail, but it is at least possible that more knowledge about the true author might lessen—or indeed, it might strengthen—that presumption.

There are, of course, two parts to the debate about the authorship of the Shakespeare Canon: First, did the man from Stratford-on-Avon really write those plays; second, if not, who did? I shall not repeat the comments that I made about those two questions in my lecture on the Shakespeare Canon of Statutory Construction, but I will add a few thoughts about each.

A paragraph in David McCullough's biography of John Adams reminded me of my first visit to Stratford, when I first learned that there is no evidence, either presently available in that neighborhood, or anywhere else for that matter, that William Shaksper (as the man from Stratford spelled his name) ever had a library, or indeed that he even owned any books, or ever wrote or received any personal letters. The paragraph describes an incident in April of 1786, when Thomas Jefferson and John Adams were together in England. On a brief vacation touring the Cotswalds, the two of them visited Stratford. McCullough's account of that visit states:

If Stowe was the ultimate in fashionable private splendor, the Shakespeare house in Stratford-on-Avon, the next stop, was as humble as could be imagined. Told that an old wooden chair in a corner by the chimney was where the bard himself had sat, the two American tourists cut off souvenir chips, this 'according to custom,' as Adams was quick to note. But he was distressed by how little evidence remained of Shakespeare, either of the man or the miracle of his mind. 'There is nothing preserved of this great genius . . . which might inform us what education, what company, what accident turned his mind to letters and drama,' Adams lamented. Jefferson noted only that he paid a shilling to see Shakespeare's house and grave.³²

The absence of books or letters must have seemed especially significant to those two learned men, given the size of their respective libraries and the volume of their

³² DAVID MCCULLOUGH, JOHN ADAMS 358-59 (2001).

correspondence. Each of them wrote thousands of personal letters, and McCullough tells us that Adams' library included 3,200 volumes, containing hundreds of marginal notes. Jefferson sold his personal library to the federal government to replace the Congressional library that was destroyed by the British when they burned the Capitol. A total of 6,707 volumes were shipped from Monticello to Washington in 1815.

Today, in the Folger Library next door to the Library of Congress, there is an unusually interesting volume that may shed important light on the authorship of the Shakespeare Canon. It is a Bible, containing marginal notes and underlined passages, many of which parallel comments in Shakespeare's plays and poems. The Bible was purchased for Edward de Vere, the 17th Earl of Oxford, in 1570; a handwriting expert has concluded "that it is highly probable" that he was the author of those notes.³³ The relevance and significance of specific notes is the subject of scholarly debate,³⁴ but at the very least they demonstrate that de Vere's extensive familiarity with relatively obscure passages in the Bible was coextensive with that of the author of the Shakespeare Canon.

Edward de Vere was a brilliant, well-educated and well-traveled nobleman, a patron of acting companies and a favorite of Queen Elizabeth. In 1562, when he was 12 years old, his father (the 16th Earl of Oxford) died and Edward moved to London to become a ward of the Crown. He resided with William Cecil, Queen Elizabeth's principal adviser. Nine years later Cecil became Lord Burghley and de Vere married his daughter, Anne. The ceremony was performed in Westminster Abbey and attended by the Queen.

Most scholars agree that the character Polonius, the King's principal adviser in *Hamlet*, is a caricature of Burghley. If we assume that Hamlet represented the author, it is only a small step to think of Polonius' daughter Ophelia as representing Anne. One more step would find an analogy between Polonius' employment of Reynaldo to spy on his son Laertes in Paris, and Burghley's use of a spy to learn about his own son's Parisian vices. This scenario suggests that a better understanding of the Burghley household, and the extent of the Stratford man's relationship to it, may shed more light on the authorship controversy.

The earliest of the plays now attributed to William Shakespeare were originally published without naming their author. The first work using that name to designate its author was the poem *Venus and Adonis*. The preface to the poem is a dedication to Henry Wriothesley, the third Earl of Southampton, signed by "William Shakespeare" and referring to the poem as "the first heir of my invention."³⁵ Whether the word "invention" refers to the *nom de plume* of the author or to the work itself is not entirely clear, but it is clear that the identity of the dedicatee is significant. For, apart from the dedication itself, and a comparable dedication to

³³ Forensic Report of Emily Will, M.A., Certified Document Examiner (Apr. 20, 2000), *reprinted in* Roger A. Stritmatter, *The Marginalia of Edward de Vere's Geneva Bible* app. 1, at 468 (2001) (unpublished Ph.D. dissertation, U. Mass. Amherst) (on file with author).

³⁴ See generally Stritmatter, *supra* note 30. Faculty of the Department of Comparative Literature of the Graduate School of the University of Massachusetts Amherst accepted Stritmatter's dissertation as partial fulfillment of the requirements for his Ph.D. degree.

³⁵ William Shakespeare, *preface to Venus and Adonis* (1593), available at http://web.uvic.ca/shakespeare/Library/Texts/Poems/Ven/Ven_QT/Ven_Q.html. I have modernized spelling here and in subsequent quotations of works in the Shakespeare Canon.

Southampton of the later poem, *The Rape of Lucrece*, there is no evidence that the man from Stratford ever met, or had any connection whatsoever with, Southampton.

There is, however, abundant evidence of a close relationship between de Vere and Southampton, beginning in 1581, when Southampton—as de Vere had some years earlier—became a royal ward under the care of Lord Burghley. Ten years later, when “SHAKE-SPEARE” penned the sonnets urging his reader to “Make thee another self for love of me,”³⁶ de Vere, with the assistance of his father-in-law, Lord Burghley, was trying to persuade Southampton to marry de Vere’s oldest daughter. And finally, when the author of the Sonnets warned the youthful reader that “forty winters shall besiege thy brow,/And dig deep trenches in thy beauty’s field,”³⁷ de Vere was in his early forties while Shaksper and Southampton were both closer to twenty.

Whether these facts will increase or decrease the likelihood of confusion over the identity of the author of the Shakespeare Canon; whether a different, but nonetheless distinctive, name will come to be associated with that venerable body of work; and whether the Canon will remain as sweet if that is the case, are questions that I will leave in the more capable hands of literary scholars, trademark lawyers, and, perhaps, future lecturers in this series.³⁸

V

For now, suffice it to say, far more than forty winters have besieged both my brow and the brow of Beverly Pattishall since the Coca Cola antitrust litigation caused our paths to cross. The countless writings that he has produced during those years include briefs, treatises, articles, memorials, protocols and bar association position papers. Even though other lawyers have contributed to that work product, his name has consistently provided the reader with a solid guarantee of accuracy and high quality. His writing may not equal Shakespeare’s, but we can be certain that if he has given an opinion that it is lawful to copy not only the recipe, but also the design and the packaging of Banbury Tarts, it is safe to do so.

³⁶ *Sonnet 10*, in SHAKE-SPEARES, SONNETS (1609) (hereinafter SONNETS), available at http://web.uvic.ca/shakespeare/Library/Texts/Poems/Son/imagePagesS/Son_b3rS.html.

³⁷ *Sonnet 2*, in SONNETS, available at http://web.uvic.ca/shakespeare/Library/Texts/Poems/Son/imagePagesS/Son_b1rS.html.

³⁸ For those new to the Shakespeare authorship debate, the Internet currently provides a lively introduction. See, e.g., *The Authorship “Problem,”* at <http://shakespeare.palomar.edu/life.htm#Authorship> (collecting links) (last modified Apr. 30, 2002). For the Oxfordian view, see, for example, Tom Bethell, *The Case for Oxford*, THE ATLANTIC MONTHLY, Oct. 1991, at 45-61, available at <http://www.theatlantic.com/unbound/flashbks/shakes/beth.htm>; *Shakespeare Oxford Society Home Page*, at <http://www.shakespeare-oxford.com> (last visited Apr. 1, 2002). For the Stratfordian view see, for example, Irving Matus, *The Case for Shakespeare*, THE ATLANTIC MONTHLY, Oct. 1991, at 64-72, available at <http://www.theatlantic.com/unbound/flashbks/shakes/matus.htm>; *The Shakespeare Authorship Page*, at <http://www.clark.net/pub/tross/ws/will.html> (last visited Aug. 1, 2001). For more extended offline exposition of the Oxfordian theory of authorship, see, for example, THOMAS J. LOONEY, “SHAKESPEARE” IDENTIFIED IN EDWARD DE VERE, SEVENTEENTH EARL OF OXFORD (1920); CHARLTON OBGURN, JR., THE MYSTERIOUS WILLIAM SHAKESPEARE (1984); RICHARD WHALEN, SHAKESPEARE—WHO WAS HE? (1994).