

AN EMPIRICAL STUDY OF THE USE OF LEGAL SCHOLARSHIP IN SUPREME COURT TRADEMARK JURISPRUDENCE

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Although the usefulness of law review and law journal articles to the decisional lawmaking process is a topic that has captured the imagination of jurists, reporters, and legal academics like few others, very little is actually known about how and why courts use such legal scholarship. This Article addresses that lack of knowledge. It reports an empirical study of the Supreme Court's use of legal scholarship in its trademark jurisprudence that spans the years 1949–2011. Among its contributions are: (1) the identification of Supreme Court trademark cases using and not using legal scholarship, including the identification of the pieces of legal scholarship used in each case; (2) a quantitative description of the use of legal scholarship in Supreme Court trademark jurisprudence, including a comparison to other areas of the Court's jurisprudence; and (3) an analysis and discussion of the Court's qualitative use of legal scholarship in trademark opinions. In connection with this last contribution, the Article offers a preliminary taxonomy useful for descriptively categorizing the various sorts of uses of legal scholarship observed, and further, argues that much of the Court's use of legal scholarship is of the low quality, perfunctory variety. It also discusses the significance of these and other observations to current debates about legal scholarship. This Article should thus be of interest to researchers curious about how and why courts use legal scholarship, to legal scholars who have aspirations of being cited in Supreme Court opinions, to practitioners who are curious about the role of legal scholarship in advocacy, and of course to those legal scholars

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interested in the High Court's intellectual property, and particularly trademark, jurisprudence.

TABLE OF CONTENTS

INTRODUCTION	933
I. METHODOLOGY	939
A. Definitions	939
B. Data	941
II. RESULTS	943
A. Supreme Court Trademark Jurisprudence	943
B. The Use of Legal Scholarship in Supreme Court Trademark Jurisprudence	946
C. Trademark Jurisprudence Compared to Other Jurisprudence	950
D. The Qualitative Use of Legal Scholarship in Trademark Opinions	952
1. The Unnecessary FYI	954
2. Acknowledging Different Views About an Issue	956
3. The Law/Policy Is	958
4. Persuasive Background	962
5. The Law/Policy Should Be	964
6. Supporting Claims to the Existence of Historical Facts	966
7. Legal Scholarship as Fact—Black-Boxing Arguments	968
III. ADDITIONAL IMPLICATIONS	969
A. The Low Quality of Judicial Use of Scholarship	969
1. Law Professors Should Not Overly Covet Citation in Judicial Opinions	970
2. Judges and Justices Seem Not to Be Professionally Interested in Legal Scholarship	971
3. Law Professors Should Probably Not Write with the Idea That Judges and Justices Will Use Legal Scholarship to Inform a Decision	972
B. The Paradox of Perfunctory Use	973
C. Why So Much Use of Legal Scholarship in Trademark Opinions	976
CONCLUSION	977
APPENDIX A: CODING INSTRUCTIONS	978
APPENDIX B: CASE CITATIONS TO SCHOLARSHIP	979

INTRODUCTION

Legal scholarship has been making headlines recently, although perhaps not in a good way.¹ The Chief Justice of the U.S. Supreme Court has been particularly expressive, characterizing legal scholarship as not “particularly helpful for practitioners and judges[,]”² and as “largely of no use or interest to people who actually practice law.”³ Nor is the Chief Justice alone in his concerns. They echo those expressed by other notable judges such as Harry T. Edwards of the D.C. Circuit⁴ and Chief Judge Dennis G. Jacobs of the Second Circuit,⁵ as well as others.⁶

The view that legal scholarship offers little utility to the bench and bar is, moreover, not limited to jurists. The MacCrate Report—a product of an American Bar Association study examining legal

¹ See Walter Olson, *Abolish the Law Reviews!*, THE ATLANTIC (July 5, 2012, 12:40 PM), <http://www.theatlantic.com/national/archive/2012/07/abolish-the-law-reviews/259389>.

² Jess Bravin, *Chief Justice Roberts on Obama, Justice Stevens, Law Reviews, More*, WALL ST. J. L. BLOG (Apr. 7, 2010, 7:20 PM), <http://blogs.wsj.com/law/2010/04/07/chief-justice-roberts-on-obama-justice-stevens-law-reviews-more> (internal quotation marks omitted) (reporting Chief Justice Roberts’ comments).

³ Adam Liptak, *Supreme Court Memo: Keep Those Briefs Brief, Literary Justices Advise*, N.Y. TIMES, May 21, 2011, at A12 (internal quotation marks omitted); see also David Segal, *What They Don’t Teach Law Students: Lawyering*, N.Y. TIMES, Nov. 20, 2011, at A1 (quoting Chief Justice Roberts: “Pick up a copy of any law review that you see . . . and the first article is likely to be, you know, the influence of Immanuel Kant on evidentiary approaches in 18th-century Bulgaria, or something, which I’m sure was of great interest to the academic that wrote it, but isn’t of much help to the bar,” and Supreme Court Justice Stephen Breyer: “There is evidence that law review articles have left terra firma to soar into outer space . . .” (internal quotation marks omitted)).

⁴ Harry T. Edwards, *The Growing Disjunction Between Legal Education and the Legal Profession*, 91 MICH. L. REV. 34, 35 (1992) (“[J]udges, administrators, legislators, and practitioners have little use for much of the scholarship . . . produced by members of the academy.”).

⁵ Adam Liptak, *When Rendering Decisions, Judges Are Finding Law Reviews Irrelevant*, N.Y. TIMES, Mar. 19, 2007, at A8 (quoting Chief Judge Dennis G. Jacobs: “I haven’t opened up a law review in years No one speaks of them. No one relies on them.” (internal quotation marks omitted)).

⁶ Thomas L. Ambro, *Citing Legal Articles in Judicial Opinions: A Sympathetic Antipathy*, 80 AM. BANKR. L.J. 547, 549 (2006) (“When we [judges] do read the occasional article, we find it often not only unpersuasive, but even at times at odds with accepted means of analysis.”); Judith S. Kaye, *One Judge’s View of Academic Law Review Writing*, 39 J. LEGAL EDUC. 313, 319–20 (1989) (“Prominent law reviews are increasingly dedicated to abstract, theoretical subjects . . . and less and less to practice and professional issues I am disappointed not to find more in the law reviews that is of value and pertinence to our cases.”); but see (Judge) John Minor Wisdom, *Wisdom’s Idiosyncrasies*, 109 YALE L.J. 1273, 1278 (2000) (directing law clerks: “Do not, however, be so brief that you neglect to do a thorough job of research, including research of the law reviews. I like a good article, comment, or note in point”); Alex Kozinski, Judge, Ninth Circuit Court of Appeals, Address at the University of Houston Law Center Fourth Annual Frankel Lecture: Who Gives a Hoot About Legal Scholarship?, in 37 HOUS. L. REV. 295, 295 (2000) (joking in his remarks, “Good morning, ladies and gentlemen. I am pleased to be here . . . to speak on the relevance of legal scholarship to the judiciary. I note that whoever came up with the topic did not add the qualifier ‘if any,’ which shows a commendable degree of confidence.”).

education and professional development—claims that: “[p]ractitioners tend to view much academic scholarship as increasingly irrelevant to their day-to-day concerns.”⁷ Law professors, too, have sharply criticized legal scholarship. In one particularly notable example, a law professor published an Article in the *Journal of Legal Education* having as its sole text, “This is it,”⁸ and including the footnote:

A reader suggested to me that this article has insufficient legal content, that “Res ipsa loquitur” (or some other pompously legal slogan) would serve my purposes better. But it’s been decades since law review articles had to have anything to do with the law. For that matter, it’s been a long time since law review articles had to have anything to do with anything. This article has as much content as the other stuff in this issue, doesn’t it?⁹

Given the fascination of reporters, judges and justices, legal scholars, and bar associations with the academic output of law professors—not to mention the accompanying rhetoric—it should come as little surprise that studies have attempted to examine courts’ use of legal scholarship. The most prominent of such studies have been very heavily concerned with counting citations.¹⁰ In such studies, citation counts typically form the basis (explicitly or implicitly) of a claim about the utility of legal scholarship to the bench and bar. The claim, again typically, is that the utility of legal scholarship is low¹¹ or trending downward.¹² As noted, however, not all prior work reaches this

⁷ See AM. BAR ASS’N SECTION OF LEGAL EDUC. & ADMISSIONS TO THE BAR, TASK FORCE ON LAW SCH. & THE PROFESSION: NARROWING THE GAP, LEGAL EDUCATION AND PROFESSIONAL DEVELOPMENT—AN EDUCATIONAL CONTINUUM 5 (1992); *id.* (“[M]any practicing lawyers believe law professors are more interested in pursuing their own intellectual interests than in helping the legal profession address matters of important current concern.”).

⁸ Erik M. Jensen, *The Shortest Article in Law Review History*, 50 J. LEGAL EDUC. 156 (2000).

⁹ *Id.* at n.1; see also David Hricik & Victoria S. Salzmänn, *Why There Should Be Fewer Articles Like This One: Law Professors Should Write More for Legal Decision-Makers and Less for Themselves*, 38 SUFFOLK U. L. REV. 761 (2005) (arguing from the position that law professors write too much for themselves and should write more for judges); accord Aaron D. Twerski, *Remarks upon Receiving the Robert C. McKay Law Professor Award*, MARQUETTE LAW. 55–56 (2009), available at <http://law.marquette.edu/assets/marquette-lawyers/pdf/marquette-lawyer/2009-spring/Spring09pp55-57.pdf> (noting that prestigious law reviews appear less interested in publishing traditional doctrinal scholarship).

¹⁰ For a bibliography including other types of studies concerning judicial and academic citation to legal scholarship, see Schwartz & Petherbridge, *The Use of Legal Scholarship*, *infra* note 18, at 1349–52, and accompanying notes.

¹¹ See, e.g., Louis J. Sirico, Jr. & Beth A. Drew, *The Citing of Law Reviews by the United States Courts of Appeals: An Empirical Analysis*, 45 U. MIAMI L. REV. 1051, 1052 (1991) (counting scholarship usage in 1200 opinions issued in 1989 and claiming that “the federal circuit courts cite law reviews infrequently”).

¹² See, e.g., Michael D. McClintock, *The Declining Use of Legal Scholarship by Courts: An Empirical Study*, 51 OKLA. L. REV. 659, 660 (1998) (“This survey reveals a 47.35% decline in the use of legal scholarship by courts over the past two decades, the most notable decline occurring in the past ten years.”); Louis J. Sirico, Jr., *The Citing of Law Reviews by the Supreme Court: 1971–1999*, 75 IND. L.J. 1009, 1010 (2000) (counting and claiming “a continuing decline in [the]

conclusion. Some studies have found an increase in the use of scholarship,¹³ and others have reported levels of use of legal scholarship in judicial opinions that many would consider impressive.¹⁴

The aforementioned studies are, however, largely unhelpful for understanding how and why courts use legal scholarship. Perhaps the most significant reason the studies are largely unhelpful is that they were not really designed to provide much information about such topics.¹⁵

But the situation is changing. Several recent studies, using sounder designs and methods, such as random sampling¹⁶ or the gathering of entire populations,¹⁷ have focused more on the topics of how and why judges use legal scholarship.¹⁸ As a result, researchers are finally

number of times the Court cited legal periodicals”); Louis J. Sirico, Jr. & Jeffrey B. Margulies, *The Citing of Law Reviews by the Supreme Court: An Empirical Study*, 34 UCLA L. REV. 131, 134 (1986) (counting use of scholarship across two three-year periods and finding a “substantial” decline in citations to legal periodicals by the Supreme Court); *see also* Hricik & Salzman, *supra* note 9 (empirically evaluating a single term to test the trend that justices infrequently use scholarship). *But see* Whit D. Pierce & Anne E. Reuben, *The Law Review is Dead; Long Live the Law Review: A Closer Look at the Declining Judicial Citation of Legal Scholarship*, 45 WAKE FOREST L. REV. 1185 (2010).

¹³ *See, e.g.*, Lawrence M. Friedman et al., *State Supreme Courts: A Century of Style and Citation*, 33 STAN. L. REV. 773, 812 (1981) (reporting an 8% increase in citation to legal scholarship by state supreme courts between 1945–55 and 1960–70).

¹⁴ *See, e.g.*, Gregory Scott Crespi, *The Influence of a Decade of Statutory Interpretation Scholarship on Judicial Rulings: An Empirical Analysis*, 53 SMU L. REV. 9, 11 (2000) (observing that “almost half of the statutory interpretation articles published between 1988 and 1995 have been cited in at least one judicial opinion”); Brent E. Newton, *Law Review Scholarship in the Eyes of the Twenty-First-Century Supreme Court Justices: An Empirical Analysis*, 4 DREXEL L. REV. 399, 404 (2012) (“During the first decade of the twenty-first century . . . Justices cited articles in their opinions in 37.1% of the Court’s cases.”); Petherbridge & Schwartz, *An Empirical Assessment*, *infra* note 18 (observing use in over 32% of cases).

¹⁵ They also use a variety of methodological approaches that make generalization difficult. *See* Schwartz & Petherbridge, *The Use of Legal Scholarship*, *infra* note 18, at 1350–51 (noting the variation in methodological approaches employed, emphasis on “elite law reviews, particular articles, small samples, and nonrandom samples”).

¹⁶ *See* Lee Epstein & Gary King, *The Rules of Inference*, 69 U. CHI. L. REV. 1, 108 (2002) (stating that random sampling is a preferred approach).

¹⁷ *See* Hume, *infra* note 18 (sample of circuit court opinions, 1971–2000); Petherbridge & Schwartz, *An Empirical Assessment*, *infra* note 18 (population of Supreme Court opinions, 1949–2009); Schwartz & Petherbridge, *The Use of Legal Scholarship*, *infra* note 18 (population of circuit court opinions, 1950–2008); West-Faulcon & Petherbridge, *infra* note 18 (population of Supreme Court opinions, 1949–2011).

¹⁸ *See, e.g.*, Robert J. Hume, *Strategic-Instrument Theory and the Use of Non-Authoritative Sources by Federal Judges: Explaining References to Law Review Articles*, 31 JUST. SYS. J. 291, 299 (2010); Lee Petherbridge & David L. Schwartz, *An Empirical Assessment of the Supreme Court’s Use of Legal Scholarship*, 106 NW. U. L. REV. 995 (2012) [hereinafter Petherbridge & Schwartz, *An Empirical Assessment*]; David L. Schwartz & Lee Petherbridge, *The Use of Legal Scholarship by the Federal Courts of Appeals: An Empirical Study*, 96 CORNELL L. REV. 1345, 1351–54 (2011) [hereinafter Schwartz & Petherbridge, *The Use of Legal Scholarship*]; *See* Kimberly West-Faulcon & Lee Petherbridge, *Legal Scholarship in Supreme Court Constitutional Decisionmaking: An Empirical Examination* (July 12, 2012) (unpublished manuscript), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2110347.

beginning to develop an understanding of some of the factors that affect the use of legal scholarship by courts.¹⁹ This has, in turn, allowed for the development of observation-based hypotheses and theories meant to explain judicial use of legal scholarship.²⁰

One such theory is the theory of strategic use. The idea of strategic use, stated broadly, holds that judges and justices will select opinion content with the expectation that choices made can have an impact on the perceptions of consumers of the opinion.²¹ A more concrete application of this theory is that judges and justices decide to cite *vel non* cases, statutory language, legal scholarship, or other supporting documentary instruments depending on whether they believe doing so is helpful to winning support for an opinion. The recent studies just mentioned are quite consistent with, and perhaps manifestly supportive of, the idea that judges and justices behave in this way.

While these advances in understanding cannot be understated, there is still a tremendous amount of knowledge about the judicial use of legal scholarship that has remained elusive. One important frontier, which has received little attention from legal academics, is the difficult problem of what can be called “qualitative” use.

Qualitative use is concerned with the technical function performed by a specific reference. What, if anything, is the influence of the cited legal scholarship on the substantive legal analysis offered in an opinion? Thus, while qualitative use is easily seen to overlap in some ways with strategic use, it can be conceptually distinguished in that rather than focusing on judicial expectations about consumer perceptions, qualitative use focuses on the substantive legal contribution of the cited legal scholarship.

To elaborate on what we mean by qualitative use, consider two possible poles that might establish a crude continuum along which the quality of judicial use of legal scholarship can be arrayed. At one pole, an opinion writer references legal scholarship in a manner that suggests it genuinely informed the analysis. One might call these sorts of uses “high quality” or genuinely “substantive” uses. At the other pole, a reference is made much more as a matter of form, without much effort, interest, or attention to the relationship between the legal scholarship and the opinion’s analysis. One might call these sorts of uses “low quality” or “perfunctory” uses.

¹⁹ See *supra* note 18.

²⁰ *Id.*

²¹ See, e.g., Hume, *supra* note 18, at 291–92 (discussing the idea and collecting references to the generalized theory); West-Faulcon & Petherbridge, *supra* note 18 (analyzing Supreme Court constitutional jurisprudence with this hypothesis).

An example of the former might be found in *Brandir International v. Cascade Pacific Lumber Co.*²² In *Brandir*, the Second Circuit, grappling with the question of how to define the extent of copyrightable subject matter in useful articles,²³ cites and discusses at length an Article by Professor Denicola, entitled: *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*.²⁴ The court ultimately adopts the teachings of the law review Article:

Perhaps the differences between the majority and the dissent in *Carol Barnhart* might have been resolved had they had before them the Denicola article on *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, *supra*. There, Professor Denicola points out

We believe that Professor Denicola's approach provides the best test for conceptual separability and, accordingly, adopt it here for several reasons.²⁵

An example of the latter—of low quality or perfunctory use—might be found in *Inwood Laboratories v. Ives Laboratories*,²⁶ a case addressing contributory trademark infringement by a generic drug manufacturer. The relevant text occurs in Part I of the opinion. There, describing the background of the case, the Supreme Court explains that the branded drug company involved employs the marketing strategy of convincing physicians that a generic drug should not be substituted for its branded drug.²⁷ The reference to legal scholarship, an Article entitled *Consumer Protection and Prescription Drugs: The Generic Drug Substitution Laws*,²⁸ occurs in a note, appended to this text, the purpose of which appears to be to provide support for the at best tangential proposition that: "Since the early 1970's, most States have enacted laws allowing pharmacists to substitute generic drugs for brand name drugs under certain conditions."²⁹

²² 834 F.2d 1142 (2d Cir. 1987).

²³ *Id.* The court interpreted 17 U.S.C. § 101 (2012): "[T]he design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article."

²⁴ Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707 (1983).

²⁵ *Brandir*, 834 F.2d at 1145.

²⁶ 456 U.S. 844 (1982).

²⁷ *Id.* at 847 ("Now that its patent has expired and generic manufacturers have entered the market, Ives concentrates on convincing physicians to indicate on prescriptions that a generic drug cannot be substituted for CYCLOSPASMOL.").

²⁸ Jillena A. Warner, Note, *Consumer Protection and Prescription Drugs: The Generic Drug Substitution Laws*, 67 KY. L.J. 384 (1978–79).

²⁹ *Inwood Labs.*, 456 U.S. at 847 n.4.

That states have statutes implementing a policy of allowing, even encouraging, generic substitution is useful for understanding the real world context of the branded-generic conflict, and so it may serve the purpose of helping to describe the commercial and political stage on which the legal dispute is being played out. But the Court does not appear to make its holding—that the Second Circuit violated Rule 52(a) by setting aside findings of the district court that were not clearly erroneous³⁰—depend on, or even relate to, either the branded company's marketing strategy, or the information taken from the authority cited to support the Court's description of the strategy, viz. "most States have enacted laws allowing pharmacists to substitute generic drugs for brand name drugs under certain conditions."³¹ Erasing the reference, and the proposition that it is expressly used to support, seems to have no impact on the legal substance of the opinion. The lack of analytical connection between the reference and the reasoning in the opinion makes the reference seem more perfunctory.

The foregoing discussion sets the stage for one of the central contributions of this Article: The presentation of data describing the qualitative use of legal scholarship. In that presentation, we also introduce a descriptive vocabulary that may be helpful to other researchers. This Article makes two additional significant contributions. The first is the identification of Supreme Court trademark cases using and not using legal scholarship, including the identification of the pieces of legal scholarship used in each case. The second is a quantitative description of the use of legal scholarship in Supreme Court trademark jurisprudence.

We have selected Supreme Court trademark jurisprudence as a model system for several reasons. Perhaps first among them is that both of us share a special interest in trademark law. We know that others share this interest and are convinced they will welcome a systematic empirical study that explores how legal scholarship interacts with jurisprudence in this area. Beyond that, the Supreme Court's pragmatic supremacy in this area of federal law, and its discretionary control over its docket, suggests that the Court should be likely to hear cases that are broadly meaningful. A fact that, if true, could mean that trademark issues most deserving of scholarly treatment will be concentrated in Supreme Court trademark cases. By designing a study that focuses on such cases we have hopefully selected a sample most likely to produce robust observations of judicial interaction with scholarship. Finally, the Supreme Court has issued relatively few trademark decisions over the

³⁰ 456 U.S. at 858.

³¹ 456 U.S. at 847 n.4.

last sixty-three years. That fact makes what is a difficult data analysis task more manageable and reasonable.³²

Our main goal in this Article is simply to present and analyze our data—to describe the use of legal scholarship in Supreme Court trademark jurisprudence quantitatively and qualitatively. But we also endeavor to discuss some possible implications of our findings and to relate them, where reasonable, to continuing debates about the use of legal scholarship in case law. This Article should ultimately be of interest to researchers curious about how and why courts use legal scholarship, to legal scholars who have aspirations of being cited in Supreme Court opinions, to practitioners who are curious about the role of legal scholarship in advocacy, and of course to those legal scholars and practitioners interested in the High Court's intellectual property, and particularly trademark, jurisprudence.

The Article is organized as follows. Part I sets forth the methodological approach and the evidence for the reliability of the coding rubric, so that those interested in testing our methods or observations will have clear guidance on how to do so. Part II presents the results of the study. It describes our data and tests some hypotheses. It also considers some possible explanations and implications. Part III explores some additional implications. The Article finishes with a brief conclusion.

I. METHODOLOGY

A. Definitions

With one exception, or unless it is clearly otherwise, when used in this Article, “legal scholarship” means law review or law journal articles. The definition emphasizes student run academic law reviews and journals. We thus, for example, exclude the *National Law Journal* but include the *University of Pennsylvania Law Review* and the *Harvard Law Review*.³³ The one exception is that when it comes to trademark cases,³⁴

³² Our design was developed with the expectation that it will offer a good chance to make qualitative observations about how the Court interacts with legal scholarship. But it should be clear that by making the design choices we have made to service that end, we have been forced to sacrifice empirical arguments about the generalizability of our observations to other courts and other areas of law. More work will need to be performed before it is known if what we observe in this study will hold for other contexts.

³³ We additionally exclude from the definition of “legal scholarship” works like treatises, hornbooks, casebooks, and other books, for the reason that the strident criticisms aimed at legal scholarship do not usually encompass those forms of writings.

³⁴ Our intuition is that the Supreme Court does not use legal scholarship from the *Trademark Reporter* much in its nontrademark jurisprudence. We have, moreover, a very large dataset, so a small number of uses of legal scholarship from the *Reporter* in the Court's

we have included in the definition of legal scholarship law review-style articles from the *Trademark Reporter*. An example of such an article—one that we characterize as legal scholarship—is William Landes and Richard Posner’s, *The Economics of Trademark Law*,³⁵ which endeavors to use economics to explain the structure of trademark law. Not all articles in the *Reporter* are in this style. It publishes other types of writings, like committee reports. An example of a non law review-style article—and thus one we did not include in our definition of legal scholarship—is *The United States Trademark Association Trademark Review Commission Report and Recommendations to USTA President and Board of Directors*.³⁶

Unless otherwise defined, when discussing the reference to legal scholarship in Supreme Court opinions we use the terms “citation” and “use” interchangeably. We recognize that for some analytical purposes, equating citation to use may be logically imperfect; for example, courts almost certainly use more scholarship than they cite in opinions.³⁷ We proceed nonetheless. First, equating citation with use is conventional in the field. Second, while use can happen without citation, citation is unlikely to happen without use (as reasonably defined).³⁸ The risk presented by relying on citations is therefore pretty clearly defined. It underestimates judicial use. Third, equating citation with use has pragmatic advantages. It promotes ease and reliability of measurement.³⁹ Fourth, because we cannot know what justices are thinking when they decide to include or exclude reference to legal scholarship in an opinion, perfect measurement of use of scholarship is impossible. We have, however, a very rich dataset that allows us to observe what justices decide to do when crafting opinions.⁴⁰ If we were to let the above mentioned concerns stop us from sharing an analysis of

nontrademark jurisprudence should have a de minimus impact on the quantitative observations we report.

³⁵ William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, 78 TRADEMARK REP. 267 (1988).

³⁶ *The United States Trademark Association Trademark Review Commission Report and Recommendations to USTA President and Board of Directors*, 77 TRADEMARK REP. 375 (1987).

³⁷ See Petherbridge & Schwartz, *An Empirical Assessment*, *supra* note 18, at 999–1000 (discussing this likelihood); Schwartz & Petherbridge, *The Use of Legal Scholarship*, *supra* note 18, at 1352–54 (same).

³⁸ Petherbridge & Schwartz, *An Empirical Assessment*, *supra* note 18, at 1000 (explaining why “citation” is properly understood as “use” most of the time).

³⁹ Schwartz & Petherbridge, *The Use of Legal Scholarship*, *supra* note 18, at 1354 (discussing this value).

⁴⁰ Including of course what their clerks do in this capacity, and for which Justices are, at the bottom of things, responsible. See Petherbridge & Schwartz, *An Empirical Assessment*, *supra* note 18, at 1000 n.12. For that reason, in the context of this study, we treat the distinction between a clerk inserting scholarship into an opinion and a Justice using it as a distinction without a difference. That means when we say things like “justices’ use of scholarship,” we do not distinguish a clerk’s role in that use.

these data, it would be to let the ideal of the perfect defeat the presentation of interesting and valuable information.

B. Data

A single dataset was constructed to supply the data necessary for this study.⁴¹ The dataset includes observations of the use of legal scholarship in all areas of the High Court's jurisprudence, and includes all opinions for decisions published, or scheduled for publication, in the United States Reporter from June 27, 1949 (vol. 338) (1948 term) until July 7, 2011 (2011 U.S. LEXIS 5019) (2010 term). The cases were located using The Supreme Court Database, which contains substantial information about each Supreme Court decision.⁴² Information concerning the Court's use of legal scholarship was obtained by executing two very similar queries against the Lexis Nexis U.S. Supreme Court Cases (USLED) database.⁴³ Decisions were human coded for use of legal scholarship. Coders were asked to determine whether opinions for a case used legal scholarship, as well as the number of distinct articles used in each opinion. The coding rubric is reproduced in Appendix A. Intercoder agreement was tested using Cohen's kappa (k),

⁴¹ The methods are substantially those used in Petherbridge & Schwartz, *An Empirical Assessment*, *supra* note 18, and West-Faulcon & Petherbridge, *supra* note 18.

⁴² Current Dataset, SUPREME COURT DATABASE, <http://scdb.wustl.edu/data.php> (last visited Jan. 5, 2014). We used: Case Centered Data, Cases Organized by Supreme Court Citation. The database is also sometimes known as the Spaeth Database, and is considered the gold standard in political science literature. Lee Epstein et al., *The Political (Science) Context of Judging*, 47 ST. LOUIS U. L.J. 783, 812 (2003) (noting the importance of the database). The *Supreme Court Database* website indicates that the coding of the variables is regularly subjected to reliability checks. See *The Genesis of the Database*, SUPREME COURT DATABASE, <http://scdb.wustl.edu/about.php?s=1> (last visited Jan. 5, 2014). A codebook for the database is available. See *Online Code Book: Introduction*, SUPREME COURT DATABASE, <http://scdb.wustl.edu/documentation.php> (last visited Jan. 5, 2014).

⁴³ The first spans the period June 27, 1949 (vol. 338 United States Reporter) to September 2007 (vol. 551), and is identical to that used in Petherbridge & Schwartz, *An Empirical Assessment*, *supra* note 18. The query used was:

CITES(XXX pre/1 "U.S.") and ((("L.J." or "L. J." or "L. REV." or "L.REV." or "J.L." or "LAW REVIEW" or "Ct.Rev." or "Ct. Rev.") w/15 (20** or 19** or 18**)) and not ((("J.L." w/4 V.) or name((J. w/2 L.) or LJ or JL or "L.J." or "J.L.") or (counsel(LJ or JL or "L.J." or "J.L.)) or ("NAT! L.J." or "NATIONAL LAW JOURNAL"))

"XXX" refers to the volume of the United States Reporter. The query logic has received favorable reviews. Accord Iantha Haight, *Court Citation of Legal Scholarship on the Rise?*, THE COMPETITIVE EDGE (Aug. 17, 2010, 3:10 PM), <http://blog.law.cornell.edu/library/2010/08/17/court-citation-of-legal-scholarship-on-the-rise> (noting that the search query was impressive and is "about as close [to perfect] as you can reasonably get"). The second uses the same database, and spans the period from September 2007 (vol. 552) to July 2011. It is identical to that used in West-Faulcon & Petherbridge, *supra* note 18. It differs from that of Petherbridge & Schwartz in that it uses the "U.S. LEXIS" citation for cases instead of the "U.S." citation. A model of this query is reproduced in Appendix A.

a statistical argument that measures intercoder agreement for categorical observations along a 0–1 interval, with values closer to 1 representing greater agreement.⁴⁴ Across the fourteen coders, *k*-values ranged from 0.890 to 1.000 for binary measurements of whether an opinion in a case uses legal scholarship. This represents a range of agreement from nearly perfect, to perfect. For this coding, the average *k*-value was 0.973. The *k*-values ranged from 0.843–0.915 for counts of numbers of distinct articles used, which represents similarly excellent intercoder agreement. For this coding, the average *k*-value was 0.882. Overall, the dataset includes 7,961 Supreme Court decisions, about a third of which use legal scholarship. To identify trademark cases, four separate coders were independently assigned the task of identifying all Supreme Court trademark cases issued between 1949 and 2011. The results from all four coders were synthesized, disparities investigated, and a final list of trademark decisions determined.

The study we report here provides information both describing the use of legal scholarship in trademark jurisprudence, and comparing the use of legal scholarship in trademark jurisprudence to that in other areas of the Court's jurisprudence. The analysis thus combines the variables we coded with the variables coded by the coders for The Supreme Court Database. The number of variables used is not especially high, and the variables are not particularly difficult to understand. We therefore describe variables when we introduce them in the discussion in the following Part.

⁴⁴ See generally Jacob Cohen, *A Coefficient of Agreement for Nominal Scales*, 20 EDUC. & PSYCHOL. MEASUREMENT 37 (1960) (describing its logic of the statistical argument and defending its merits). Cohen's kappa (*k*) has the merit of taking into account agreement that occurs by chance but also tends to underestimate agreement when a category is very commonly present. It is thus, generally speaking, considered to be a conservative measure of agreement. The closer the kappa statistic is to 1.00, the greater the level of agreement. While there is no set *k*-value that signifies "good enough" agreement, magnitude guidelines have been suggested. Richard Landis and Gary Koch suggest that *k*-values of 0.00–0.20 reflect "slight" agreement; 0.21–0.40 reflect "fair" agreement; 0.41–0.60 reflect "moderate" agreement; 0.61–0.80 reflect "substantial" agreement; and 0.81–1.00 reflect "almost" perfect agreement. See J. Richard Landis & Gary G. Koch, *The Measurement of Observer Agreement for Categorical Data*, 33 BIOMETRICS 159, 165 (1977); see also JOSEPH L. FLEISS ET AL., *STATISTICAL METHODS FOR RATES AND PROPORTIONS* 604 (3d ed. 2003) (describing 0.40–0.75 as fair-to-good and over 0.75 as excellent). In this study, approximately 30% of the measurements were coded by multiple coders to establish reliability. See also Lee Petherbridge & R. Polk Wagner, *The Federal Circuit and Patentability: An Empirical Assessment of the Law of Obviousness*, 85 TEX. L. REV. 2051, 2074 & n.118 (2007) (using a 25% sample and noting literature that suggests using at least a 10% sample).

II. RESULTS

In this Part, we present the results of the study. As noted above, our main goal in this Article is simply to present and analyze our data—to describe the use of legal scholarship in Supreme Court trademark jurisprudence quantitatively and qualitatively. It is in this Part that we do so. We also discuss some possible explanations for and implications of the observations, although we focus more directly on implications in Part III.

A. *Supreme Court Trademark Jurisprudence*

Let us begin with Supreme Court trademark jurisprudence generally. How much is there? Are cases more or less frequent at different points in the Court's history? Figure 1 shows that the Court's trademark jurisprudence is distributed somewhat unevenly over the last sixty-three years. From 1948 to 1980, only two terms contain a trademark decision. The remainder of the Supreme Court's trademark jurisprudence occurs after 1980. This suggests the possibility of a trend in the Court's trademark jurisprudence. Namely, that it has increased in prevalence over time.

Figure 1. The Distribution of Trademark Cases
Supreme Court Cases (1949-2011)

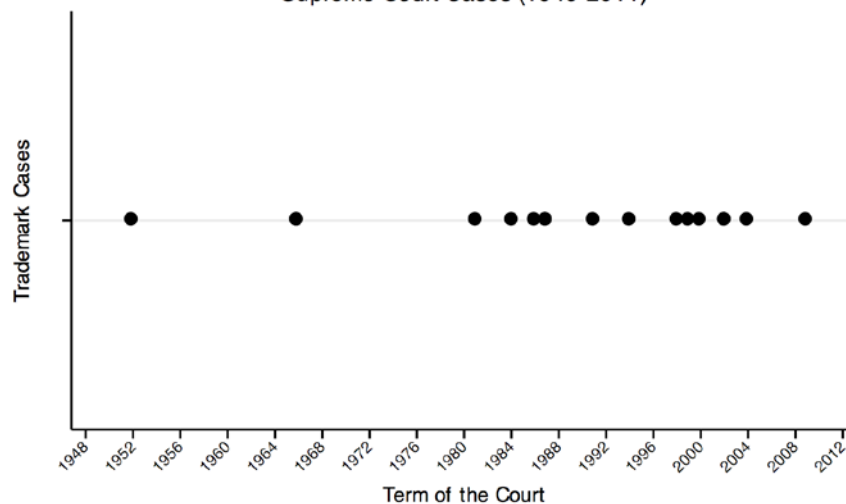


Figure 1. Depicts the Terms having a least one trademark case.

Our data include the entire population of Supreme Court decisions for the period studied, and the results are for that reason arguably

statistically significant by definition.⁴⁵ Readers who accept this may conclude from visual inspection alone that an upward trend in the frequency of trademark cases is apparent.

For those who prefer not to see this data set as a population, and for those who might find that inferential statistics provide some additional insight into the importance of differences (whether or not a population is measured), we considered whether, if our data represented a sample, the difference Figure 1 shows in the temporal distribution of trademark cases is due to chance. Our null hypothesis was that the likelihood of a trademark decision does not depend on term. We tested the hypothesis using logistic regression.

Table 1. Increases in Term Predict Increases in TM Cases⁴⁶

Trademark	Odds Ratio	Rob. Std. Err.	z	p	95% Conf. Interval
term	1.045	0.017	2.81	0.005	1.014 1.078
_cons	9.36E-42	3.03E-40	-3	0.003	1.5e-686.3e-15

Table 1 indicates that trademark cases have become more frequent in recent terms.⁴⁷ The trend does not appear to be a consequence of the Court deciding more cases in recent terms, however. An inspection of the number of cases the Court decided per term indicates that the Court has, generally speaking, been deciding fewer cases in recent terms than it was around 1980.⁴⁸ So it looks like trademark cases are going up, while the Court's caseload is going down.

It is hard to know precisely why this might be, and it is tempting to finger zeitgeist as an explanation. A common historical narrative is that by the 1970s, the United States was experiencing a concerning decline in industrial innovation and economic growth, and troubling levels of unemployment.⁴⁹ A domestic policy review undertaken by the Carter administration suggested that one approach to relieve the nation's "malaise" was to encourage innovation.⁵⁰

A sense of the times, it seems, was that intellectual property laws could help play a role in encouraging innovation and thus in recovering U.S. economic competitiveness. Some indication that this was so can be

⁴⁵ As we make no claim about other periods of time.

⁴⁶ The dependent variable, Trademark, is "1" if a term has a trademark case, and "0" if it does not. Wald $\chi^2(1) = 7.91$, $p > \chi^2 = 0.005$, pseudo $R^2 = 0.034$.

⁴⁷ The *term* coefficient is significant and above 1.

⁴⁸ Data not shown.

⁴⁹ See Lee Petherbridge, *On the Development of Patent Law*, 43 LOY. L.A. L. REV. 893, 895 (2010) (noting this narrative and providing references).

⁵⁰ *Id.*

seen in a number of pieces of legislation considered in the late 1970s and enacted in the early 1980s that were generally considered to be innovation friendly. The Bayh-Dole Act of 1980,⁵¹ for example, attempted to clarify the rules surrounding intellectual property developed in the course of federally funded research. The Stevenson-Wydler Technology Innovation Act of 1980,⁵² also addressing intellectual property, was enacted “[t]o promote the United States technological innovation for the achievement of national economic, environmental, and social goals, and for other purposes.” And the Federal Courts Improvement Act of 1982,⁵³ created the United States Court of Appeals for the Federal Circuit, for, among other reasons, to bring consistency to patent law and restore the incentive for industrial innovation.⁵⁴

The flourishing of intellectual property legislation at this time might reflect a growing belief in the importance of intellectual property laws. And if a favoritism toward intellectual property laws is characteristic of the socio-political times following 1980 it might stand to reason that trademark law, which as noted above is normally considered a form of intellectual property law, was caught up in the spirit of things.

Nor is this idea particularly undercut by the fact that much of the intellectual property legislation mentioned above is directed toward industrial innovation. The label “intellectual property” may have hegemonic power. If the spirit of the times was to view intellectual property favorably, that spirit might encompass all its forms, no matter how connected to the underlying social concerns one form or another of intellectual property might be. Trademark law, moreover, can be understood theoretically as not only helpful for distinguishing goods in the market place, it can also be understood as providing an innovation incentive. To the extent an innovation incentive theory of trademark law was influential, it would have located trademark law in the same territory as other forms of intellectual property that may have moved into legislative and social favor in the late 1970s and early 1980s.

If a zeitgeist favoring intellectual property law originated in the late 1970s or early 1980s, it could cause the Supreme Court to take up more trademark cases. The social enthusiasm for the subject alone might encourage the Court to use its discretion to grant certiorari in more

⁵¹ Pub. L. No. 96-517, 94 Stat. 3019 (1980) (codified at 35 U.S.C. §§ 200–212 (2012)).

⁵² Pub. L. No. 96-480, 94 Stat. 2311 (1980) (codified at 15 U.S.C. § 3701).

⁵³ Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25 (codified as amended in scattered sections of 28 U.S.C.).

⁵⁴ See generally Charles W. Adams, *The Court of Appeals for the Federal Circuit: More Than a National Patent Court*, 49 MO. L. REV. 43 (1984) (describing the creation of the Federal Circuit); Rochelle Cooper Dreyfuss, *The Federal Circuit: A Case Study in Specialized Courts*, 64 N.Y.U. L. REV. 1 (1989); see also S. REP. NO. 97-275, at 5–7 (1981).

trademark cases. Justices tend, after all, to be Washington insiders; they are likely to be aware of the issues of the moment, and it seems obvious that they might be affected by such knowledge when deciding what cases to hear. A zeitgeist could provide complementary forces as well. Social enthusiasm for trademark law could encourage business people to attempt more vigorously to use it to achieve competitive advantage, and could encourage attention from academics and public intellectuals. This sort of interest and attention might produce more exotic theories of enforcement and more debate and discussion about the merits and limits of such laws. Factors like these might also encourage greater Supreme Court participation in trademark cases.

To get a sense of whether our observations might be explained by a zeitgeist favoring intellectual property arising around 1980, we created an indicator variable *after_innovationlaw*, setting it to zero for the 1980 term, and all terms earlier; and setting it to 1 for terms 1981–2010. Treating our data as a sample, we then tested the hypothesis that there is no difference in the likelihood of a trademark case in either period. Table 2 shows the results of the test, and indicates that the prevalence of trademark cases post-1980 is not likely due to chance. There appear to be significantly more Supreme Court trademark cases in terms 1981–2010⁵⁵ than there are in terms 1948⁵⁶–1980. We do not mean to make too much of this observation, for there might be other reasons such an association could develop, but it is consistent with what one might expect if intellectual property became culturally prominent starting around the late 1970s or early 1980s.

Table 2. TM Cases Are More Likely After Innovation Law⁵⁷

Trademark	Odds Ratio	Rob. Std. Err.	z	p	95% Conf. Interval
<i>after_innovationlaw</i>	5.865	3.734	2.78	0.005	1.684 20.426
<i>_cons</i>	.000	.000	-12.63	0.000	.000 .002

B. *The Use of Legal Scholarship in Supreme Court Trademark Jurisprudence*

Having described the appearance of trademark cases in Supreme Court jurisprudence, we turn here to the use of legal scholarship in

⁵⁵ Through the part of the 2010 term for which we have data.

⁵⁶ Including the part of the 1948 term for which we have data.

⁵⁷ Wald chi2(1) = 7.72, p>chi2 = 0.005, pseudo R2 = 0.043.

trademark opinions. Figure 2 depicts Supreme Court trademark cases and indicates whether they contain an opinion citing legal scholarship. Like Figure 1, it shows that most trademark cases happen in more recent court terms. Figure 2 further shows that most of the use of legal scholarship in Supreme Court trademark opinions has occurred after 1980. This observation is consistent with the earlier observation that most of the Supreme Court's trademark cases happened after 1980, and from that perspective is not particularly surprising.

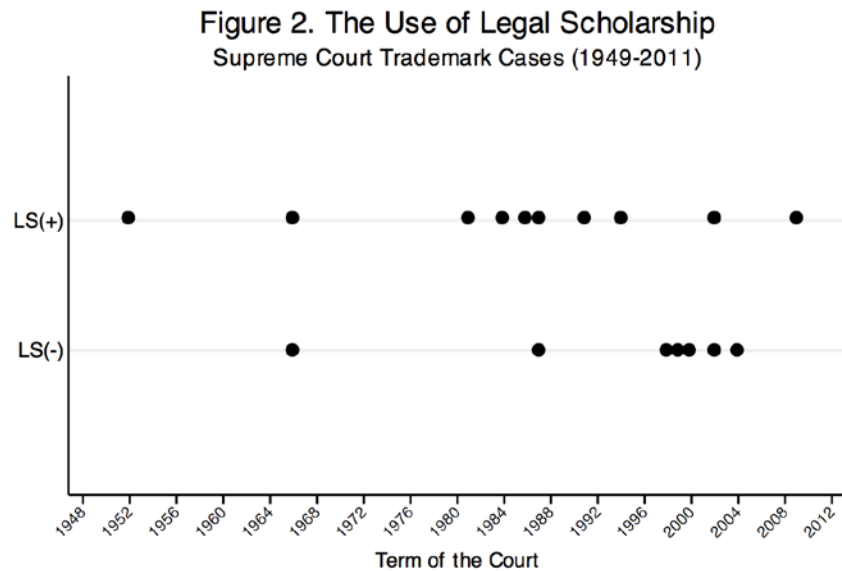


Figure 2. Supreme Court trademark cases using (LS(+)) and not using (LS(-)) legal scholarship.

To determine whether there is a difference in the number of trademark cases using legal scholarship that depends on time, we compared the number of trademark cases using legal scholarship for the periods before and after 1980.

Table 3 shows no evidence that the rate of use of legal scholarship depends on being in the period before 1980 or the period after 1980. Having failed to find evidence suitable for rejecting the null hypothesis—no difference between periods—we are left to conclude that if there was something special happening around 1980 that encouraged the Court to hear more trademark cases, there is no indication that it affected the likelihood of the Court to use legal scholarship in its trademark opinions.

Table 3. Rate of Use of Scholarship in TM Cases Has Not Changed⁵⁸

Term	LS(-)	LS(+)	
1948-1980	1/33.33%	2/66.67%	3/100%
1981-2010	6/42.86%	8/57.14%	14/100%
Fisher's exact p = 1.000			

To get another perspective on the Court's use of legal scholarship in its trademark opinions, we next considered the distribution of the actual number of articles cited in trademark cases. Figure 3 shows that the number of distinct citations—counting a citation to a piece of legal scholarship only once per opinion in a case—ranges from a high of six to a low of zero.

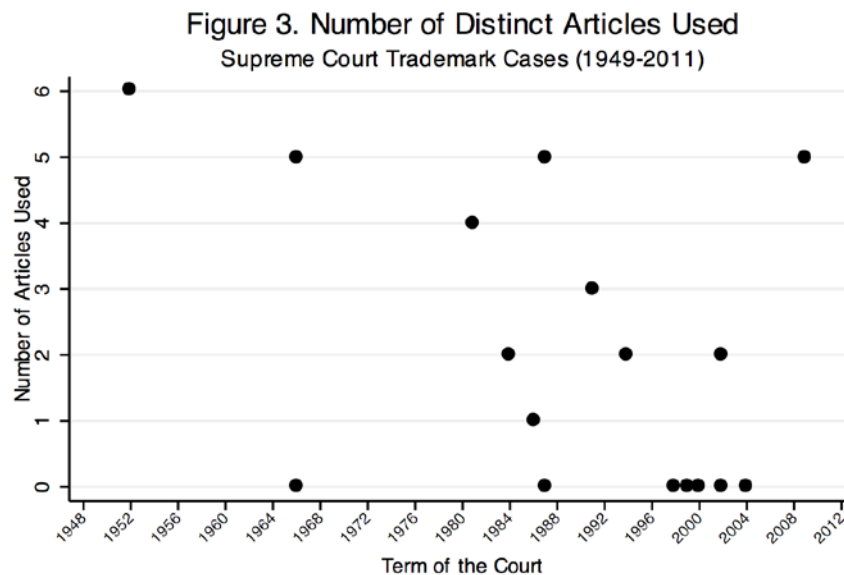


Figure 3. Depicts the number of articles used per case. An article was counted only once per opinion.

The total number of distinct usages in trademark opinions was thirty-five, making the average number of distinct usages 2.06 per trademark case. If one considers only the cases that used legal scholarship, the average number of distinct usages per case is 3.5. A visual inspection of the graph suggests the possibility that there has been a decrease in the number of articles used per case in more recent times. To get a sense of whether there was statistical evidence for a trend we

⁵⁸ We used a Fisher's exact test primarily because of the low number of positives; ten cases out of seventeen. We did check using logistic regression, however, and similarly found no evidence of other than chance differences (data not shown). As before LS(-) means the trademark case did not use legal scholarship, while LS(+) means it did.

tested the null hypothesis: The number of articles used does not depend on term. The Spearman test, which allows us to examine nonparametric correlation, showed no evidence of a significant relationship between term and the distinct number of articles used when we considered all trademark cases,⁵⁹ and when we considered only trademark cases that used legal scholarship.⁶⁰

Looking at the use of legal scholarship in the before and after innovation law periods, there was some modest evidence of a difference in use that depends on being in one period or the other. Excluding trademark cases that fail to use legal scholarship,⁶¹ the average number of articles cited per case in the terms before 1980—before innovation law—was 5.5. In the terms from 1981–2010, the average number of articles cited was three. Although the resulting numbers are quite small, viz. ten cases, eleven total articles used in two cases in the before innovation law period, and twenty-four articles used in eight cases in the after innovation law period, the differences are marginally significant.⁶² Not too much should be read into this finding,⁶³ but it suggests the possibility that the Supreme Court may have cited legal scholarship just a bit more intensely in trademark opinions for cases issued in the period before and including the 1980 term. Table 4 summarizes the basic quantitative data describing the Supreme Court's use of legal scholarship from 1949–2011.⁶⁴

⁵⁹ We examined the correlation between number of distinct articles cited and term. Spearman's rho = -0.0373, p = 0.140, n = 17.

⁶⁰ We examined the correlation between number of distinct articles cited and term. Spearman's rho = -0.342, p = 0.334, n = 10.

⁶¹ If they are included there is no evidence of a difference. The average number of articles cited per case in the terms before 1980—before innovation law—was 3.667. In the terms from 1981–2010, the average number of articles used was 1.714. These differences were not significant, however. Wilcoxon rank-sum (Mann-Whitney), $z = 1.181$, $p = 0.237$.

⁶² Wilcoxon rank-sum (Mann-Whitney), $z = 1.874$, $p = 0.061$.

⁶³ There are several reasons why one should not read too much into it. First, the n is low. Second, in contrast to earlier, when we were considering the appearance of trademark cases in Supreme Court jurisprudence, we do not have as good a theoretical reason for making the split around 1980 in this analysis. While cutting the data in half provides a cruder way to get a sense of a change over time—it allows for the aggregation of large amounts of data—it is harder to see why changes in innovation laws should affect the intensity of use of legal scholarship in trademark cases, especially if, as the analysis suggests, the trend is modestly downward. Although it is possible that trademark scholarship got worse (or otherwise less appealing to Justices) after 1980, a more intuitive explanation might be that the Court is using scholarship less intensely across its jurisprudence after 1980, and the observations we have from trademark cases may just be symptomatic.

⁶⁴ Recall, terms 1948–2010.

Table 4. Summary of Legal Scholarship Use in Supreme Court Trademark Cases⁶⁵

term	Trademark Decisions	LS(+)	LS(-)	# Distinct Articles Used	Mean # Distinct Articles Used
1952	1	1	0	6	6
1966	2	1	1	5	2.5
1981	1	1	0	4	4
1984	1	1	0	2	2
1986	1	1	0	1	1
1987	2	1	1	5	2.5
1991	1	1	0	3	3
1994	1	1	0	2	2
1998	1	0	1	0	0
1999	1	0	1	0	0
2000	1	0	1	0	0
2002	2	1	1	2	1
2004	1	0	1	0	0
2009	1	1	0	5	5
Total	17	10	7	35	2.06

C. Trademark Jurisprudence Compared to Other Jurisprudence

Table 5 reveals that trademark opinions are more likely to use legal scholarship than nontrademark opinions. During the sixty-three-year period we studied, 58.82% of trademark cases had opinions using legal scholarship as compared to just 32.25% of nontrademark cases. The Court also used significantly more articles per trademark case, 2.06, than it used per nontrademark case, 1.06, as Table 6 shows. Table 6 also shows that a difference in the number of distinct articles used persists—with trademark cases using 3.50 articles to 3.29 articles in nontrademark cases—even when one examines only cases that use at least one law review or law journal article. This difference is more modest, however, and does not appear to be significant if we eschew the notion that we are dealing with a population and treat the data as if it represents a sample of a larger population.⁶⁶

⁶⁵ LS(-) means the trademark case did not use legal scholarship, while LS(+) means it did. The summary identifying the cases and Articles cited is in Appendix B.

⁶⁶ Wilcoxon rank-sum (Mann-Whitney), $p = 0.118$.

Table 5. Trademark Opinions Use Significantly More Legal Scholarship than Nontrademark Opinions

	LS(-)	LS(+)	
Nontrademark	5382/67.75%	2563/32.25%	7944/100%
Trademark	7/41.18%	10/58.82%	17/100%
chi2(1) = 5.477, p<.019			

Table 6. Trademark Cases Use More Articles⁶⁷

	obs	mean	Std. dev.	min	max
Nontrademark	7944	1.064	2.643	0	46
Trademark	17	2.059**	2.193	0	6
<i>use at least one</i>					
Nontrademark	2562	3.297	3.778	1	46
Trademark	10	3.5	1.716	1	6

That trademark opinions are more likely to use legal scholarship than nontrademark opinions is a very interesting observation. It is also, however, very general. Perhaps, for example, within the Supreme Court's docket is a large genus of cases that do not provoke much use of scholarship, like criminal procedure cases or some-such. If so, then perhaps the Supreme Court's very high use of scholarship in trademark cases might be less impressive. Perhaps it would really look a lot like the use of legal scholarship in tax cases, or federalism cases, or cases addressing economic activity, but the similarity is masked by the generality of Tables 5 and 6. To get a sense of how trademark jurisprudence stacks up against other genera, we utilized the *issueArea* variable from The Supreme Court database.⁶⁸ The *issueArea* variable divides Supreme court jurisprudence into fourteen genera. We coded an additional genus, trademark, and then examined the frequency with which the Supreme Court uses legal scholarship in the various genera. The observations are striking. At a rate of use of 58.82%, the Supreme Court is much more likely to use legal scholarship in a trademark case

⁶⁷ Table 6. Summary statistics for the number of distinct Articles used in Supreme Court opinions for trademark and nontrademark cases. Averages are reported to aid readers' comprehension. The statistical test used to whether there are differences between the sets of cases, however, is the Wilcoxon rank-sum (Mann-Whitney) test. We thus do not assume that the number of distinct Articles used is a normally distributed interval variable. Significance is indicated using the normal conventions, viz. (†), $p \leq 0.1$; (*), $p \leq 0.05$; (**), $p \leq 0.01$; and (***), $p \leq 0.001$.

⁶⁸ *Online Code Book: Issue Area*, SUPREME COURT DATABASE, <http://scdb.wustl.edu/documentation.php?var=issueArea> (last visited Jan. 5, 2014).

than it is in nearly any of the other areas of its jurisprudence. Trademark cases, it seems, are something of a high-flying outlier.

**Figure 4. Rate of Use of Legal Scholarship
in Trademark and Other Areas**
Supreme Court Cass (1949-2011)

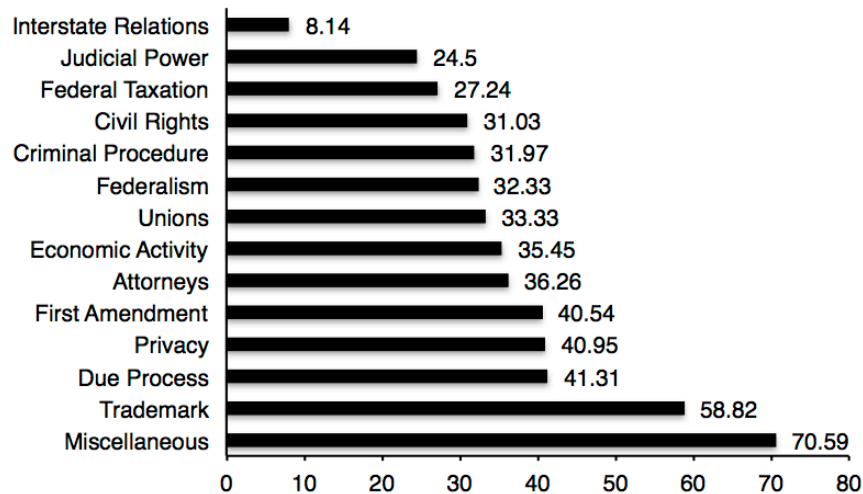


Figure 4. The Rate of Use of Scholarship in Supreme Court Decisions 1949–2011. Except for Trademark, the Decision types correspond to *issueArea* categorizations in The Supreme Court Database. Rates were determined by binary counts, viz. did a case in the genus use at least one piece of legal scholarship. Miscellaneous $n=17$; Trademark $n=17$; Privacy $n=105$; Due Process $n=305$; First Amendment $n=634$; Attorneys $n=91$; Economic Activity $n=1478$; Unions $n=318$; Federalism $n=365$; Criminal Procedure $n=1811$; Civil Rights $n=1315$; Federal Taxation $n=279$; Judicial Power $n=1106$; Interstate Relations $n=86$. One genus, entitled Private Action, is omitted; it contains only one case.

D. *The Qualitative Use of Legal Scholarship in Trademark Opinions*

In this Part, we move from a quantitative description of the Supreme Court's use of legal scholarship in trademark cases, and embark on a qualitative description. The qualitative description departs from the use of charts and statistical arguments that characterized the earlier parts of the results, and instead attempts to develop a preliminary taxonomy useful for descriptively categorizing the forms of use we have observed.

As noted earlier, the qualitative concern is what, if anything, is a reference to legal scholarship substantively adding to an opinion? Earlier we set out two possible poles: At one pole, an opinion writer might reference legal scholarship in a manner that suggests it genuinely informed the analysis (earlier we called these sorts of uses "high quality"

uses, or genuinely “substantive” uses). The example we gave of this sort of use was *Brandir International v. Cascade Pacific Lumber Co.*⁶⁹ There, the Second Circuit adopts a law review Article’s recommendation for the proper legal standard to apply in the case.⁷⁰

At the other pole is “low quality” or “perfunctory” use of legal scholarship. This sort of use of legal scholarship is characterized by references that appear to be off-handed, inattentive to the arguments or reasoning of the cited legal scholarship, or otherwise artifacts of a drafting process. References that, for example, appear inexplicable or unnecessary from the perspective of the substance of an opinion’s legal analysis, or references that seem to be made as a matter of form, without much effort or interest in the substantive analytical content of the Article cited. The example we gave of this sort of use comes from a Supreme Court trademark case, *Inwood Laboratories v. Ives Laboratories*.⁷¹ There, addressing contributory trademark infringement by a generic drug manufacturer, the Court cites an Article to support a claim to an historical fact: That states have statutes implementing a policy of substituting generic pharmaceuticals for branded ones.⁷² A review of the opinion indicates that the Article receives little attention, and the historical fact gleaned from the Article does not play a role in the reasons the opinion gives for reaching the decision that it does.⁷³

The order we impose on the uses of legal scholarship made by the Supreme Court in trademark cases will attempt to locate all uses between these two poles. We want to be upfront. This task is difficult. In our view, some uses of legal scholarship could have been placed in categories other than, or in addition to, the one in which we placed them. Our taxonomy and categorization, too, represent our efforts to harness and give order to what is a difficult to summarize array of information. It is possible that some readers might not agree with our choices and would have done things differently. To compensate for that concern, and to assuage whatever anxiety might be provoked in readers by the choices, we have included a summary of our observations and categorization decisions in Appendix B.

To give the reader a sense of where the following analysis is heading, although we distinguish at least seven forms of use of legal scholarship, we ultimately conclude that the overwhelming majority of the uses we observe are of the low quality, perfunctory variety. It appears to us to be rare that the Court relies on legal scholarship to inform the reasoning of an analysis articulated in an opinion (or at a

⁶⁹ 834 F.2d 1142 (2d Cir. 1987).

⁷⁰ *Id.* at 1145.

⁷¹ 456 U.S. 844 (1982).

⁷² *Id.* at 847.

⁷³ *Id.*

minimum very rare that an opinion evinces such reliance). Most often, it appears that the Court uses legal scholarship to support claims about topics tangential to, or even off point from, the legal analysis in which the legal scholarship is referenced, and as support for claims to empirical quality historical facts, viz. that the real world is or was a particular way.

1. The Unnecessary FYI

In our observations, one of the most common purposes for citing to law review and law journal articles was to highlight additional sources of information about topics an opinion mentions, but does not address. We have labeled this category of use the “unnecessary for-your-information,” and it is entirely perfunctory from the perspective of adding to the reasoning expressed in an opinion.

A nice example of this form of use can be seen in *Steele v. Bulova Watch Co.*,⁷⁴ which decides whether a cause of action exists under the Lanham Act against a U.S. citizen who manufactures goods marked with another’s trademark in a foreign country.⁷⁵ Early in its analysis, the Court observes: “we do not pass on the merits of Bulova’s claim, [so] we need not now explore every facet of this complex and controversial Act.”⁷⁶ The Court appends footnotes to both “complex” and “controversial.” The references in both notes serve the same for-your-information purpose. The note appended to the word “complex” states:

For able Court of Appeals discussions of the impact of *Erie R. Co. v. Tompkins*, on the law prior and subsequent to the Lanham Act, see [cases]. And see Zlinkoff, *Erie v. Tompkins: In Relation to the Law of Trade-Marks and Unfair Competition*, 42 Col. L. Rev. 955 (1942); Bunn, *The National Law of Unfair Competition*, 62 Harv. L. Rev. 987 (1949).⁷⁷

The note appended to the word “controversial” states:

See, e.g., Timberg, *Trade-Marks, Monopoly, and the Restraints of Competition*, 14 Law & Contemp. Probs. 323 (1949); cf. Brown, *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 Yale L.J. 1165 (1948). Compare, e.g., Pattishall, *Trade-Marks and the Monopoly Phobia*, 50 Mich. L. Rev. 967 (1952); Rogers, *The Lanham Act and the Social Function of Trade-Marks*, 14 Law & Contemp. Probs. 173 (1949).⁷⁸

⁷⁴ 344 U.S. 280 (1952).

⁷⁵ *Id.* at 281.

⁷⁶ *Id.* at 283 (footnotes omitted).

⁷⁷ *Id.* at 283 n.6 (case citations omitted).

⁷⁸ *Id.* at 283 n.7.

As the Court promises in the text of the opinion, its analysis plumbs none of these articles, the complexity imposed by *Erie v. Tompkins*, or any of the controversy reflected in the legal scholarship it cites.

Another example of the unnecessary for-your-information use can be seen in *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*,⁷⁹ which addresses a challenge to incontestable status. Responding to the respondent's and dissent's suggestion that principles of equity might establish theories for challenging an incontestable mark on the ground that it lacks secondary meaning, Justice O'Connor, writing for the Court has this to say:

The Lanham Act, as the dissent notes, *post*, at 673–674, authorizes courts to grant injunctions “according to principles of equity.” § 34, 15 U.S.C. § 1116. Neither respondent nor the opinion of the Court of Appeals relies on this provision to support the holding below. Whatever the precise boundaries of the courts’ equitable power, we do not believe that it encompasses a substantive challenge to the validity of an incontestable mark on the grounds that it lacks secondary meaning. To conclude otherwise would expand the meaning of “equity” to the point of vitiating the more specific provisions of the Lanham Act. Similarly, the power of the courts to cancel registrations and “to otherwise rectify the register,” § 37, 15 U.S.C. § 1119, must be subject to the specific provisions concerning incontestability.⁸⁰

The legal scholarship is referenced in footnote 7, appended to the second appearance of “Lanham Act.” The note states: “We note, however, that we need not address in this case whether traditional equitable defenses such as estoppel or laches are available in an action to enforce an incontestable mark. See generally Comment, Incontestable Trademark Rights and Equitable Defenses in Infringement Litigation, 66 Minn. L. Rev. 1067 (1982).”⁸¹ The text of the opinion—“Neither respondent nor the opinion of the Court of Appeals relies on this provision to support the holding below.”—indicates that whether the “principles of equity” language in the remedy provision of the Lanham Act authorizes a substantive challenge to an incontestable mark on the grounds that it lacks secondary meaning is not really at issue in the case. The text of the note, moreover,—“we need not address in this case whether traditional equitable defenses such as estoppel or laches are available in an action to enforce an incontestable mark,”—informs that the case is not concerned with the availability of equitable defenses in an action for trademark infringement, a topic, according to the “see generally” signal, about which the Comment presents helpful

⁷⁹ 469 U.S. 189 (1985).

⁸⁰ *Id.* at 202–03 (footnote omitted).

⁸¹ *Id.* at 203 n.7.

background material. Taken together, it seems that the use the Court makes of the legal scholarship is to offer it as a source of background information about a topic not addressed, much less decided, by *Park 'N Fly*, for those who might be interested in knowing more about it.

2. Acknowledging Different Views About an Issue

In the cases we examined, the Court sometimes uses legal scholarship to acknowledge that there are different views about an issue. This form of use is quite similar to the unnecessary for-your-information discussed above, and as we observed it, is similarly perfunctory. In no instance did the Court set up the competing views and analyze them; or, for that matter, even discuss them at all.

A good example of this form of use can be observed in *Fleischmann Distilling Corp. v. Maier Brewing Co.*,⁸² a case that addresses whether attorney fees can be awarded in trademark infringement cases where deliberate infringement is established.⁸³ After setting out the facts and procedural history, the opinion for the Court embarks on a very short history of the law of attorney fee awards, contending that the award of fees to successful plaintiffs has long been the law in England, and then stating: "Although some American commentators have urged adoption of the English practice in this country, our courts have generally resisted any movement in that direction."⁸⁴ From that sentence, and specifically from "country," in the clause, "Although some American commentators have urged adoption of the English practice in this country," the opinion for the Court drops a note:

Ehrenzweig, Reimbursement of Counsel Fees and the Great Society, 54 Calif. L. Rev. 792 (1966); McCormick, Counsel Fees and Other Expenses of Litigation as an Element of Damages, 15 Minn. L. Rev. 619 (1931); Stoebuck, Counsel Fees Included in Costs: A Logical Development, 38 Colo. L. Rev. 202 (1966); Note, 65 Mich. L. Rev. 593 (1967).⁸⁵

A review of the articles cited indicates that they either advocate for, or analyze fairly favorably, the award of attorney fees to successful plaintiffs. This reference thus acknowledges a view on the award of attorney fees that differs from that taken by American courts, which, according to the opinion, have "generally resisted any movement in that direction."⁸⁶ After acknowledging this differing view, the opinion does

⁸² 386 U.S. 714 (1967).

⁸³ *Id.*

⁸⁴ *Id.* at 717 (footnote omitted).

⁸⁵ *Id.* at 717 n.10.

⁸⁶ *Id.* at 717.

not dwell on it, and moves instead to a description of the exceptions to the American rule that “attorney’s fees are not ordinarily recoverable in the absence of a statute or enforceable contract providing therefor.”⁸⁷

After describing the exceptions to the American rule, the Court turns to the matter at hand, which is what Congress intended for the Lanham Act. There, the Court makes no analysis of whether the American rule should be discarded or modified in view of what the cited scholarship argues; it simply observes that the petitioners cannot fit within one of the American rule’s exceptions, and that judicially created compensatory remedies in addition to the express statutory remedies intended by Congress—as evinced in the Lanham Act—are inappropriate.⁸⁸

Justice Stevens’s concurrence in *Two Pesos, Inc. v. Taco Cabana, Inc.*⁸⁹ offers another example of this form of use. It takes the position that § 43(a) of the Lanham Act is a narrowly tailored piece of legislation that the federal courts have properly “transformed” to have a broader reach than the drafters intended.⁹⁰ This general argument is executed over three parts, the second of which describes and offers Justice Stevens’s support for the claim that “[o]ver time, the Circuits have expanded the categories of ‘false designation of origin’ and ‘false description or representation.’”⁹¹ After using treatises, and mentioning and describing some cases meant to be helpful to the cause, the opinion drops the sentence: “Although some have criticized the expansion as unwise, it is now ‘a firmly embedded reality.’”⁹² A footnote, dropped off of “unwise,” states:

See, e.g., Germain, *Unfair Trade Practices Under § 43(a) of the Lanham Act: You’ve Come a Long Way Baby—Too Far, Maybe?*, 64 *Trademark Rep.* 193, 194 (1974) (“It is submitted that the cases have applied Section 43(a) to situations it was not intended to cover and have used it in ways that it was not designed to function”).⁹³

The opinion does not significantly analyze whether there is merit to the claim that the expansion of § 43(a) is unwise, and does not evince reliance on the arguments offered in the cited law journal article. At best, the reference indirectly supports the opinion’s historical narrative that a judicial expansion of § 43(a) has taken place: If no expansion had happened, no unwise expansion could have happened. But read in the

⁸⁷ *Id.*

⁸⁸ *Id.* at 719–21.

⁸⁹ 505 U.S. 763 (1992).

⁹⁰ *Id.* at 776 (Stevens, J., concurring).

⁹¹ *Id.* at 779.

⁹² *Id.* at 779–80 (footnote omitted).

⁹³ *Id.* at 779 n.9.

context of support for the claim that a judicial expansion occurred,⁹⁴ one comes away thinking that the point of judicial expansion is already, and much more convincingly, illustrated directly through the treatises and cases that supposedly embody the expansion. Accordingly, very much like the use of legal scholarship to acknowledge a different view in *Fleischmann*, the use of legal scholarship to acknowledge of a different view in *Two Pesos* seems entirely perfunctory; a casual add on, or an artifact of the historical narrative offered in the opinion.

3. The Law/Policy Is

Opinions sometimes use legal scholarship to support descriptive claims about the content of law or policy. In these examples, typically, the text of the opinion sets out the opinion's statement of the relevant law or policy, marshaling its own cases and arguments. The notes tend to take the form of pointing out that someone else has made similar arguments or marshaled the relevant authorities in similar ways. The tenor is more often that the cited work agrees with the opinion than it is that the cited work revealed the relevant law or policy to the opinion writer. Put differently, in this category, law review and law journal articles are more often cited as additional votes for the opinion's interpretations than as teachings of the law.

In the trademark cases we observed, this form of use varied somewhat in its quality. Some uses appear perfunctory, others may be less so.

Some examples of this form of use of legal scholarship come from *American Needle, Inc. v. National Football League*,⁹⁵ which concluded that National Football League teams and National Football League

⁹⁴ Besides the cases and treatises cited, which themselves provides pretty strong-seeming support for the claim of a judicial expansion of § 43(a), the opinion also references a report which adds further support for the claim.

The United States Trade Association Trademark Review Commission noted this transformation with approval: "Section 43(a) is an enigma, but a very popular one. Narrowly drawn and intended to reach false designations or representations as to the geographical origin of products, the section has been widely interpreted to create, in essence, a federal law of unfair competition It has definitely eliminated a gap in unfair competition law, and its vitality is showing no signs of age."

Id. at 780 (alteration in original) (quoting *The United States Trademark Association Trademark Review Commission Report and Recommendations to USTA President and Board of Directors*, 77 TRADEMARK REP. 375, 426 (1987)).

⁹⁵ 560 U.S. 183 (2010). We realize that for some, *American Needle* might be a questionable inclusion as a trademark case; it might be seen as more of an antitrust case. Even so, it does have trademark dimensions, and can be understood as helping to define an intersection between trademark law and antitrust law. Moreover, as we are engaged in examining the use of legal scholarship in opinions, even if this case is at the margins of trademark law per se, little harm is done by including it in this analysis.

Properties—an entity created by the teams to market intellectual property—could not be considered single entities incapable of engaging in concerted activity within the meaning of the Sherman Act.⁹⁶ As part of the analysis set forth in the opinion in the case, the Court describes its own doctrine concerning concerted action under § 1 of the Sherman Act. That doctrine, according to the opinion, holds that whether concerted action exists does not turn simply on the point of whether the parties involved are distinct legal entities.⁹⁷

In support of this doctrinal claim, the opinion states that the Court has “repeatedly found instances in which members of a legally single entity violated § 1 when the entity was controlled by a group of competitors and served, in essence, as a vehicle for ongoing concerted activity.”⁹⁸ That claim is backed by reference to no fewer than six Supreme Court cases,⁹⁹ five of which exist in a stringcite that finishes with the citation: “see also [Edward B.] Rock, *Corporate Law Through an Antitrust Lens*, 92 Colum. L. Rev. 497, 506–510 (1992) (discussing cases).”¹⁰⁰

The “*see also*” signal indicates that Rock provides additional source material that supports the proposition that the list of cases support; namely that the Court has found formally distinct business organizations covered by § 1 of the Lanham Act. A review of the part of the Rock Article cited shows that it is discussing many of the same cases the opinion has just cited, and is giving them an interpretation similar to that which the opinion is giving them: that the Court has found concerted action even in the instance of legally single entities.¹⁰¹ In other words, the cases provide the direct support for the opinion’s claims about the Court’s § 1 doctrine; and if for some reason the opinion’s description of how the cases support that interpretation of the doctrine is unconvincing, note also that a law review Article has observed that the cases suggest such an interpretation.

Later the opinion describes the decline of the intraenterprise conspiracy doctrine and the rise of the Court’s contemporary functional approach to concerted action under § 1.¹⁰² It describes the decline as occurring across several cases, one of which is *United States v. Citizens & Southern National Bank*.¹⁰³ In discussing the doctrinal impact of

⁹⁶ *Id.* This allows for the legal possibility that the NFL parties engaged in an illegal restraint of trade.

⁹⁷ *Id.* at 190.

⁹⁸ *Id.* at 191.

⁹⁹ *Id.* at 192.

¹⁰⁰ *Id.*

¹⁰¹ Edward B. Rock, *Corporate Law Through an Antitrust Lens*, 92 COLUM. L. REV. 497, 506 (1992).

¹⁰² *American Needle*, 560 U.S. at 192–96.

¹⁰³ 422 U.S. 86 (1975).

Citizens, the *American Needle* opinion discusses *Citizens*, then quotes from the case, then quotes from a book discussing the Court's analysis in *Citizens*, then cites the *Citizens* case, and then, finally, cites a law review Article:

The Government challenged the cooperation between the banks. In our analysis, we observed that “corporate interrelationships . . . are not determinative,” *id.*, at 116, [citation omitted], “looked to economic substance,” and observed that “because the sponsored banks were not set up to be competitors, § 1 did not compel them to compete.” Areeda & Hovenkamp ¶ 1463, at 200–201; see also *Citizens & Southern*, 422 U.S., at 119–120, 95 S. Ct. 2099; Areeda, *Intraenterprise Conspiracy in Decline*, 97 Harv. L. Rev. 451, 461 (1983).¹⁰⁴

The “*see also*” signal indicates that Areeda (the *Harvard Law Review* Article) provides additional source material that supports the proposition set forth in the text. Perhaps unsurprisingly, a review of Areeda and the other references in the stringcite indicates that the case is the direct support for the proposition, and Areeda turns out to be cumulative to both the case and the Areeda & Hovenkamp book.¹⁰⁵ Here, the law review Article provides something like fourth level support. It is a quaternary reference. If you did not believe what the opinion said about the case, what the case itself says, or what the treatise says about the case, not to worry, a law review Article reaches the same conclusion.

Taken together, the opinion writer seems to be using Rock and Areeda to add suspenders to go along with the belt that the cases and other sources provide. If so, the citations seem to represent fairly perfunctory uses.

It might not be too much of an over read, however, to speculate that the opinion writer is using the cited law review articles to test or seek agreement with a description of the content of the doctrine. If so, legal scholarship might be performing the role of checking the basic legal research that one might imagine appears in a law clerk memo: case summaries, with some order imposed on them. If so, this suggests the possibility that the legal scholarship is serving a treatise-like purpose: an “objective” (viz. a non party) description of what the law is. Such use, if it accurately characterizes the observation, while perhaps not highly substantive, does suggest that the law review articles provided some assistance to the opinion writer’s legal analysis.

Finally, while it would almost certainly be an over read of the opinion in *American Needle*, in the sense that the presentation of

¹⁰⁴ *American Needle*, 560 U.S. at 193–94.

¹⁰⁵ 7 P. AREEDA & H. HOVENKAMP, ANTITRUST LAW ¶ 1463, at 200–01 (2d ed. 2003).

reasoning and form of citation does not readily admit it, it is at least possible that the opinion writer is relying on the cited law review articles as a primary source of the doctrinal interpretations the opinion announces. If so, there may be reasons why the presentation of reasoning and form of citation in the opinion does not readily admit that a law review article is the primary source of information about the content of the law. To begin with, law review articles are not authority and for this formal reason might not be so presented by an opinion writer. Opinion writers might have other reasons as well not to emphasize the importance of law review articles to an opinion's articulation of the law. Also, the bluebook directs that law review and law journal articles be cited after other sources, which might help to explain how they end up deep in stringcites with signals suggesting that they are not direct authority.

Another example of the Law/Policy Is form of use can be found in Justice Stevens's *Two Pesos* concurrence, which, as noted earlier, approvingly promotes the claim that the Lanham Act is a fairly narrowly tailored piece of legislation appropriately "transformed by the federal courts" to have a broader reach than the drafters articulated.¹⁰⁶ The opinion uses a law review article to help support its claim that judges have expanded the scope and meaning of the Lanham Act. It states:

Over time, the Circuits have expanded the categories of "false designation of origin" and "false description or representation." One treatise identified the Court of Appeals for the Sixth Circuit as the first to broaden the meaning of "origin" to include "origin of source or manufacture" in addition to geographic origin. Another early case, described as unique among the Circuit cases because it was so "forward-looking," interpreted the "false description or representation" language to mean more than mere "palming off." *L'Aiglon Apparel, Inc. v. Lana Lobell, Inc.*, 214 F.2d 649 (CA3 1954).¹⁰⁷

Note 8, attached to "forward-looking" in the third sentence of the above passage¹⁰⁸ references an Article by Walter J. Derenberg, titled *Federal Unfair Competition Law at the End of the First Decade of the Lanham Act: Prologue or Epilogue?*, from the *N.Y.U. Law Review*.¹⁰⁹ Professor Derenberg is the one who characterizes the *L'Aiglon Apparel* case as "forward-looking," and the section of Derenberg from which the reference was taken is entitled: *Section 43(a): A New and Enlarged*

¹⁰⁶ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 776 (1992) (Stevens, J., concurring).

¹⁰⁷ *Id.* at 779 (footnotes omitted).

¹⁰⁸ *Id.* at 779 n.8 (citing specifically as "32 N. Y. U. L. Rev. at 1047, 1049.").

¹⁰⁹ Walter J. Derenberg, *Federal Unfair Competition Law at the End of the First Decade of the Lanham Act: Prologue or Epilogue?*, 32 N.Y.U. L. REV. 1029, 1049 (1957).

Concept of a Federal Law of Unfair Competition.¹¹⁰ It traces the judicial treatment of § 43(a), and analyzes the judicial treatment as an expansion of the congressionally intended meaning, a view that as noted, the opinion endorses (or adopts).

In this sense, the use of Derenberg, and the decision to cite Derenberg's characterization of a case defining the judicial expansion of the Lanham Act as "forward-looking," suggests that Derenberg has been enlisted for two substantive purposes. First, to support a claim about what the law is, viz. it is broader than what the statutory language might at first indicate, and second to support the notion that the judicial expansion was acceptable or even normatively positive. That Justice Stevens's opinion was substantively informed by Professor Derenberg's Article is perhaps also suggested by a review of the Article. It seems possible that more of the Article's reasoning was incorporated into the opinion than the form of citation in the opinion makes out.

4. Persuasive Background

In some instances, opinions use legal scholarship to provide persuasive background. This form of use is a for-your-information-type of use, but as opposed to the first category of use—the unnecessary for-your-information—this form of for-your-information-type use does not appear so unnecessary. It appears to contribute somewhat to the reasoning of the opinion, because it is offered to provide more understanding about a point of reasoning an opinion is actually making and tends therefore to be reasoning-supporting.

To put it slightly differently, uses exemplary of this category enlist a scholarly argument to add explanatory detail to an opinion. On the spectrum between contributing analytical substance to an opinion's reasoning, and being purely perfunctory, this species of use is less easily located near one pole or another. As we have observed it, however, the use appears less perfunctory and more connected to the substance of an analysis than most of the examples of the forms of use we have so far described.

An example comes from *Moseley v. V Secret Catalogue, Inc.*,¹¹¹ a case holding that objective proof of actual injury to the economic value of a famous mark is an element essential for relief under the Federal Trademark Dilution Act.¹¹² The opinion for the Court, after setting out

¹¹⁰ *Id.*

¹¹¹ 537 U.S. 418 (2003).

¹¹² *Moseley* has been superseded by statute. See *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 477 F.3d 765, 766 (2d Cir. 2007) ("The FTDA, as amended effective October 6, 2006, entitles the owner of a famous, distinctive mark to an injunction against the user of a mark that is 'likely to cause dilution' of the famous mark. 15 U.S.C. § 1125(c)(1) . . .").

the facts and procedural history of the case, describes the background of trademark dilution. After articulating the view that dilution was not a common law development, the opinion proceeds to state:

The seminal discussion of dilution is found in Frank Schechter's 1927 law review article concluding "that the preservation of the uniqueness of a trademark should constitute the only rational basis for its protection." *Rational Basis of Trademark Protection*, 40 Harv. L. Rev. 813, 831. Schechter supported his conclusion by referring to a German case protecting the owner of the well-known trademark "Odol" for mouthwash from use on various noncompeting steel products. That case, and indeed the principal focus of the Schechter article, involved an established arbitrary mark that had been "added to rather than withdrawn from the human vocabulary" and an infringement that made use of the identical mark. *Id.*, at 829.¹¹³

Notes 9 (appended to "steel products" in the second sentence) and 10 (appended to the end of the third sentence) discuss Schechter¹¹⁴ at length. In toto, the opinion devotes 481 words to discussing Schechter's analysis of the preservation of the uniqueness of established arbitrary marks. This represents both the largest—in terms of words—and the most detailed discussion of any piece of legal scholarship we observed in this study. The purpose of engaging in this analysis seems at least to be to provide a teaching about the topic at hand—trademark dilution. The analysis then moves to a description of state and federal legislative developments around dilution. The description set out in the opinion contrasts Schechter's views with state law developments, and contrasts state law developments with federal law developments, to reach the conclusion that under the Lanham Act, actual dilution must be established.¹¹⁵ It is therefore possible, although it might also be an over read, to imagine that the opinion also uses Schechter somewhat (along with the state and federal statutory language) as part of its reasoning: to support the conclusion that actual dilution need have occurred before relief may be granted.

American Needle offers another example. Recall that *American Needle* rejects the idea that concerted action, in the Sherman Act context, turns on the point of whether the parties involved are distinct legal entities.¹¹⁶ In rejecting to the NFL's argument that NFL Properties is a single entity (and so would be outside the cause of action), the opinion states:

¹¹³ *Moseley*, 537 U.S. at 429 (footnote omitted).

¹¹⁴ Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813 (1927).

¹¹⁵ *But see supra* note 112.

¹¹⁶ *American Needle*, 560 U.S. at 191.

The NFL respondents may be similar in some sense to a single enterprise that owns several pieces of intellectual property and licenses them jointly, but they are not similar in the relevant functional sense. Although NFL teams have common interests such as promoting the NFL brand, they are still separate, profit-maximizing entities, and their interests in licensing team trademarks are not necessarily aligned. See generally Hovenkamp, *Exclusive Joint Ventures and Antitrust Policy*, 1995 Colum. Bus. L. Rev. 1, 52–61 (1995); Shishido, *Conflicts of Interest and Fiduciary Duties in the Operation of a Joint Venture*, 39 Hastings L.J. 63, 69–81 (1987). Common interests in the NFL brand “*partially* unit[e] the economic interests of the parent firms,” Broadley, *Joint Ventures and Antitrust Policy*, 95 Harv. L. Rev. 1521, 1526 (1982) (emphasis added), but the teams still have distinct, potentially competing interests.¹¹⁷

The legal scholarship here appears to serve a couple of purposes. The first is relevant background. If the reader wants a better understanding of the point the opinion is attempting to make, he or she is invited to examine the more detailed arguments in the law review articles. A review of the scholarship cited shows that it does argue, in more descriptive detail than the opinion, that joint venturers have conflicted incentives. In this sense, it serves a second, and arguably even more substantive, purpose. It offers not only a better understanding of what the Court means when it claims that “interests . . . are not necessarily aligned,”¹¹⁸ it also offers substantive argument supporting the opinion’s factual claim that NFL teams really are “separate, profit-maximizing entities, and their interests in licensing team trademarks are not necessarily aligned.”¹¹⁹

5. The Law/Policy Should Be

A rare form of use—we observed it only once—is the Law/Policy Should Be form of use. We define this category of use as including instances where the opinion acknowledges that a piece of legal scholarship may have helped to reveal what the relevant law or policy should be in a particular instance. In other words, this category includes those instances where a normative suggestion about the development of the law made in a piece of legal scholarship seems to be referenced favorably by the Court.

The only example here comes from *Qualitex Co. v. Jacobson Products Co.*¹²⁰ The opinion enlists argument made in cited legal

¹¹⁷ *Id.* at 198.

¹¹⁸ *Id.*

¹¹⁹ *Id.*

¹²⁰ 514 U.S. 159 (1995).

scholarship to support a contention the opinion is asserting (without any other support), and also to suggest what the law might be. *Qualitex* involved the issue of whether color could be the subject matter of a trademark.¹²¹ According to the opinion, respondent Jacobsen Products Company contended that color alone should not be the subject matter of trademark, inter alia, because allowing colors alone to be trademarks would result in great uncertainty—“shade confusion”—concerning what colors competitors might lawfully use.¹²² Justice Breyer’s opinion responds to this contention by disbelieving that the analysis for determining whether confusing similarity exists for color marks is any more uncertain or difficult than the analysis for determining whether confusing similarity exists for other kinds of marks. The use of legal scholarship appears in this context:

We do not see why courts could not apply [existing] standards [for determining confusing similarity] to a color, replicating, if necessary, lighting conditions under which a colored product is normally sold. See [Lawrence B.] Ebert, *Trademark Protection in Color: Do It By the Numbers!* 84 T. M. Rep. 379, 405 (1994).¹²³

The part of Ebert to which the opinion cites is a section contending, and entitled: *Problems of ‘Shade Confusion’ Can Be Addressed*.¹²⁴ The specific citation lauds a so-called “numeric approach” for assessing confusing similarity across color marks and notes other approaches to handling the comparison.¹²⁵ It further suggests that the lighting conditions in which color marks are viewed by a consumer can be manipulated to facilitate analysis. The Court, which is adopting a position similar to that of Ebert, viz. that shade confusion does not present a problem sufficient to deny the possibility of marks in color, enlists Ebert’s general argument to that effect, and even points to Ebert’s suggestion that lighting conditions in which color marks are viewed by a consumer can be manipulated to facilitate analysis. In taking this final step, it appears that the opinion is signaling that the analytical approach argued for in Ebert might be correct.

The *Qualitex* opinion does not signal as openly as, say, the *Brandir* case noted earlier that it is adopting a prescriptive argument from legal scholarship. But upon a close read of the opinion, and the Article, we think it is fair to understand Justice Breyer’s opinion as doing so. This use, in any event, is the closest we saw in terms of an opinion

¹²¹ *Id.* at 160–61.

¹²² *Id.* at 166–68.

¹²³ *Id.* at 167–68.

¹²⁴ Lawrence B. Ebert, *Trademark Protection in Color: Do It By the Numbers!*, 84 TRADEMARK REP. 379, 402 (1994).

¹²⁵ *Id.* at 405.

acknowledging the merits of a prescription derived from legal scholarship.

6. Supporting Claims to the Existence of Historical Facts

The use of legal scholarship to support claims to historical fact is another for-your-information-type of use, but as opposed to some other examples of this sort of use, the category emphasizes the use of scholarship to support claims to empirical historical facts. On the range from perfunctory to highly substantive there is variation in this category. We hope to illustrate this with the examples we have selected.

Justice Stevens, concurring in *Two Pesos v. Taco Cabana*¹²⁶ drops a footnote from the “43(a)” in the sentence: “Section 43(a) provides a federal remedy for using either ‘a false designation of origin’ or a ‘false description or representation’ in connection with any goods or services.”¹²⁷ The footnote goes on to explain how § 43(a) “replaced and extended the coverage of § 3 of the Trademark Act of 1920,” which according to Justice Stevens’s opinion was “destined for oblivion largely because it referred only to false designation of origin, was limited to articles of merchandise, thus excluding services, and required a showing that the use of the false designation of origin occurred ‘willfully and with intent to deceive.’”¹²⁸

In the footnote, Justice Stevens tags on to the end of his argument about why § 3 was “replaced and extended” with § 43(a) of the Lanham Act one additional sentence, which is comprised substantially of a quote from a law review Article published in 1957—thirty-four years before the *Two Pesos* decision:

As a result, “[a]lmost no reported decision can be found in which relief was granted to either a United States or foreign party based on this newly created remedy.’ [Walter J.] Derenberg, *Federal Unfair Competition Law at the End of the First Decade of the Lanham Act: Prologue or Epilogue?*, 32 N.Y.U. L. Rev. 1029, 1034 (1957).¹²⁹

Derenberg is thus cited for an historical fact: that in the real world, as of 1957 or thereabouts, “[a]lmost no reported decision can be found in which relief was granted” under § 3 of the 1920 Act.¹³⁰

The purpose of citing this empirical claim is presumably to substantiate the opinion’s description of § 3 of the Trademark Act of

¹²⁶ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992) (Stevens, J., concurring) (footnote omitted).

¹²⁷ *Id.* at 777.

¹²⁸ *Id.* at 777 n.2.

¹²⁹ *Id.* (first alteration in original).

¹³⁰ Derenberg, *supra* note 109, at 1034.

1920 as hopelessly narrow, and thus “destined for oblivion.” The opinion does not closely tie the cited fact to its interpretation of § 43(a), and a review of the opinion suggests that the analysis would not have been substantially weakened if the cited fact had not been introduced. But it is nonetheless relevant to the historical description Justice Stevens provides and is internally supportive of the supposed problems of the earlier legislation discussed in the analysis, and so the cite can be understood as playing a reasoning-support role.

Another example of this form of use comes from *K Mart Corp. v. Cartier, Inc.*,¹³¹ addressing a challenge to customs regulations concerning the importation of marked gray market goods. The use seems more than perfunctory, even if an original analytic or empirical argument from the scholarship is not highlighted by the use. In a nutshell, the use of scholarship seems to be to support factual claims undergirding a descriptive historical narrative that appears important to the opinion’s analysis.

Until 1936, Treasury’s regulations merely tracked the language of § 526 For 17 years thereafter, the regulation remained unchanged, and the Customs Service permitted parallel importation so long as the manufacturer and the United States trademark holder were affiliated, including situations where the holder was the manufacturer’s subsidiary. See *In re Georg Jensen Inc.*, T. D. 52711, 86 Treas. Dec. 92 (1951); Derenberg, *The Impact of the Antitrust Laws on Trade-Marks in Foreign Commerce*, 27 N.Y.U. L. Rev. 414, 429 (1952).¹³²

This form of use might also be understood as a sort of “Law or Policy Was” form of use. It uses scholarship to establish a historical timeline of how the real world was. Another example, to the same effect—tying down the facts underlying a descriptive narrative—can be seen later in the case.

Not until the 1930’s did a trend develop approving of trademark licensing—so long as the licensor controlled the quality of the licensee’s products—on the theory that a trademark might also serve the function of identifying product quality for consumers. 1 McCarthy, *Trademarks and Unfair Competition*, at 827–829; see Grismore, 30 Mich. L. Rev., at 499. And not until the passage of the Lanham Trade-Mark Act in 1946 did that trend become the rule.¹³³

¹³¹ 486 U.S. 281 (1988).

¹³² *Id.* at 310 (Brennan, J., concurring).

¹³³ *Id.* at 314–15.

7. Legal Scholarship as Fact—Black-Boxing Arguments

In at least one instance, an opinion black-boxed a normative argument, turning it into and using it as fact. The example comes from *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee et. al.*¹³⁴ The case involved an athletics corporation that hoped to promote the “Gay Olympic Games,” and had been enjoined from using the word “Olympic” by the federal courts. The basis of the denial stemmed from § 110 of the Amateur Sports Act,¹³⁵ which granted respondent United States Olympic Committee the right to prohibit certain commercial and promotional uses of the word “Olympic” and various Olympic symbols.

In addressing arguments raised against the effect of the statute, Justice Powell used legal scholarship to support a claim to a factual proposition: that dilution is a genuine harm that a trademark owner can experience.

The restrictions of § 110 are not broader than Congress reasonably could have determined to be necessary to further these interests. Section 110 primarily applies to all uses of the word “Olympic” to induce the sale of goods or services. Although the Lanham Act protects only against confusing uses, Congress’ judgment respecting a certain word is not so limited. Congress reasonably could conclude that most commercial uses of the Olympic words and symbols are likely to be confusing. It also could determine that unauthorized uses, even if not confusing, nevertheless may harm the USOC by lessening the distinctiveness and thus the commercial value of the marks. See Schechter, *The Rational Basis of Trademark Protection*, 40 Harv. L. Rev. 813, 825 (1927) (one injury to a trademark owner may be “the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name” by nonconfusing uses).¹³⁶

As the opinion makes clear, because dilution injury is a real world-enough fact—it is an injury that trademark owners may experience due to unauthorized uses of a mark—Congress could reasonably determine that even nonconfusing uses of the term “Olympic” could injure the objects and purposes of the United States Olympic Committee.

This is arguably a remarkably strong, transformative, and substantive use of a piece of legal scholarship. If dilution was impossible, highly unlikely, or not injurious to mark owners, the opinion’s argument that Congress could have reasonably acted to address the risk is weakened. By treating dilution injury as a *fact*—by black-boxing

¹³⁴ 483 U.S. 522 (1987).

¹³⁵ 36 U.S.C. § 380 (2012).

¹³⁶ *San Francisco Arts & Athletics, Inc.*, 483 U.S. at 539.

Schechter's arguments—the Court can then decide that Congress was reasonable in taking steps to address it.

III. ADDITIONAL IMPLICATIONS

In this Part, we explore some possible additional implications of our observations. We start by reemphasizing a methodological note made earlier: Because we attempted to observe the entire population of trademark cases in Supreme Court jurisprudence from June, 1949 to July, 2011, our results should be reliably descriptive of such cases. Trademark cases might be different than other kinds of cases, however, in ways that might affect the form of use of legal scholarship in opinions. We thus offer no empirical argument that the forms of use of legal scholarship we observed are necessarily generalizable to other areas of Supreme Court jurisprudence, to Supreme Court jurisprudence generally, or to the jurisprudence of other courts. The Article is therefore at its most speculative here.

A. *The Low Quality of Judicial Use of Scholarship*

On the spectrum we adopted for the purpose of describing the Court's use of legal scholarship, the majority of uses we observed fell into the low quality, perfunctory category. Opinions seem very rarely to use a piece of legal scholarship for any original analysis or ideas the scholarship has to offer,¹³⁷ and legal scholarship is rarely made to appear to influence substantive opinion content. Instead, with perhaps a few exceptions, opinions usually appear inattentive to the arguments or reasoning of cited legal scholarship, and many of the references to legal scholarship seem unnecessary from the perspective of the substance of an opinion's legal analysis.

One of the most common forms of legal scholarship usage, for example, is the for-your-information form of use. In such use, legal scholarship is typically cited as a source of information about a topic the opinion mentions, but does not even address. Another fairly common form of use of legal scholarship is the citation to legal scholarship to acknowledge that commentators hold alternative normative views about

¹³⁷ The two pretty clear exceptions to this include Frank Schechter's, *Rational Basis of Trademark Protection*, and Lawrence Ebert's, *Protection in Color: Do It By the Numbers!*. Some other references seem to have been enlisted to support substantive analytical points. The references to Hovenkamp, Shishido, and Brodely, in *American Needle*, referenced in *supra* Part II, in our opinion, offer an example of this. But mainly the uses we observed were not instances where an opinion was informed by original ideas or analysis presented in a piece of legal scholarship.

an issue. But when opinions do this, the alternative views have no apparent bearing on the analyses articulated in the opinions.

Sometimes opinions use legal scholarship in connection with descriptive claims about the content of law or policy, although in those instances, the reference to legal scholarship tends to come at the end of a stringcite that also contains references to the cases that impose or describe the relevant law or policy, and treatises that describe the cases as so doing. Here again, the lack of analysis of the content of the cited legal scholarship, and in some instances the use of “*see also*” signals indicating that the legal scholarship provides additional source material that supports the proposition that the primary references contribute, further suggests the limited significance of the legal scholarship to the analytical aspects of the opinion.

In some of these sorts of uses, opinions seem to be bolstering a descriptive claim about the content of doctrine by enlisting yet another “vote”—by pointing out another person that agrees with what the Court is claiming. The scholarship seems to be serving the purpose of an “objective,” or nonparty view of relevant doctrine—often case summaries, with some order imposed—the same sort of work product one might expect a law clerk to provide.

Another very common form of use of legal scholarship observed is the use of legal scholarship to support a claim to a real world “fact,” and sometimes, it seems, a fact can be a legislative-type fact argued for in a piece of legal scholarship. The majority of these uses also seem to be of the low quality, perfunctory sort, although as we discussed in the previous Part, not all of them.

So, if the majority of uses of legal scholarship are of the low quality, perfunctory variety, what might that imply? Below, we offer several ideas.

1. Law Professors Should Not Overly Covet Citation in Judicial Opinions

One implication of the high prevalence of low quality, perfunctory use may be that law professors should not, in most cases, be overly proud of the fact that the High Court cites their work in an opinion. The reasoning behind this point should be obvious: It appears that opinions do not use legal scholarship for the purpose it was written; opinions do not use it for its intellectual contributions to the understanding of law or the development of law.

To refresh, consider the following examples: first, the previously discussed Comment cited in *Inwood Laboratories*. Whatever the standards for academic legal scholarship on the 1970s, if the original contribution of a piece of legal scholarship today is that “Since the early

1970's, most States have enacted laws allowing pharmacists to substitute generic drugs for brand name drugs under certain conditions,"¹³⁸ the work would likely be seen—and correctly so in our opinion—as academically inadequate.

Second, and similarly, whatever the academic standards for legal scholarship in Professor Derenberg's time, if the sole contribution of a piece of legal scholarship today was that there are no reported cases granting relief under a statutory remedy—a reason it was cited in Justice Stevens's *Two Pesos* opinion—the work would likely be seen—again, correctly so—as academically inadequate. It may have been so in Professor Derenberg's time as well, for like the Comment from the previous example, his Article does substantially more than report this observation.

In sum, the high prevalence of low quality, perfunctory use implies that law professors should probably not, in most cases, be particularly proud of the fact that the High Court cites their work in an opinion.

2. Judges and Justices Seem Not to Be Professionally Interested in Legal Scholarship

Another potential implication of the observation that the majority of uses of legal scholarship are of the low quality, perfunctory variety might be that judges and justices are not particularly professionally interested in it as a source of information about the law. There could be a number of reasons why this might be so. To begin with, legal scholarship is not formal authority. The tradition of the law has been to emphasize cases and statutory language (and of course the Constitution where relevant) above legal scholarship. If judges and justices are interested in writing opinions that appear to flow naturally from accepted sources of law using conventional analytical steps,¹³⁹ it seems quite reasonable that they would eschew the use of legal scholarship. Their focus would naturally be elsewhere.

In addition, the burdens and obligations of their respective professional responsibilities may disjoin judges and justices from legal scholars.¹⁴⁰ The former by all accounts have a busy workload deciding cases, and so may be too busy doing that, while respecting precedent

¹³⁸ *Inwood Labs. Inc., v. Ives Labs. Inc.*, 456 U.S. 844, 847 n.4 (1982).

¹³⁹ See Edward L. Rubin, *The Concept of Law and the New Public Law Scholarship*, 89 MICH. L. REV. 792, 801 (1991) (arguing that an opinion author is primarily concerned with "justify[ing] her conclusion by showing that it proceeds from accepted sources by legitimate, properly argued steps").

¹⁴⁰ See generally RICHARD A. POSNER, *HOW JUDGES THINK* 204–29 (2008) (discussing factors that separate judges and justices from legal scholars).

and statutory text, to account for the implications that might follow from a new idea or perspective raised in a law review article.

The latter have the liberty and professional incentive to explore the consequences of legal institutions on human welfare, to examine how the law operates and develops in response to social circumstances, and to strip away—or at least attempt to strip away—the shroud that hides the reasons underlying judicial decision-making. While judges and justices admittedly may have the formal liberty to consider such matters, and some might at a personal level have a deep interest in these topics, professional and economic incentives could push against indulging such an interest in the performance of their professional responsibilities.

Examining the uses of legal scholarship in trademark cases, one comes away thinking that even if judges and justices had more time to examine legal scholarship in connection with the narrow process of deciding a case, it is unlikely they would do much more with legal scholarship than they currently do.

3. Law Professors Should Probably Not Write with the Idea That Judges and Justices Will Use Legal Scholarship to Inform a Decision

A possible normative implication from our observations, which follows closely from the previous two points, is that to the extent they do so, law professors should stop trying to write articles that they imagine judges or justices will use to inform a decision in a case. To begin with, such articles appear unnecessary—unless there is a lot of *sub silentio* use of legal scholarship—many cases are decided without reference to legal scholarship. Analyses in opinions we have seen, moreover, usually do not rely on the logic or reasoning of cited legal scholarship. More typically, when legal scholarship is used in an opinion, its use is not substantively important to the opinion's legal analysis.

Legal scholars should have much more socially useful ways of spending their time than attempting to collect perfunctory citations in court opinions. If legal scholars influence the law, and many agree that they do—consider for example the influence of law and economic thinking on the law¹⁴¹—their influence is likely felt through mechanisms other than a judge reading a law review article, being convinced by its normative advocacy, and transforming its arguments into doctrine.

To be clear, this implication is in sharp contradiction to a view that some commentators have attempted to stabilize as conventional wisdom: the view that law professors should attempt to write even more for judges and justices than they already do.¹⁴² The observations of this

¹⁴¹ See, e.g., *id.*, at 212.

¹⁴² Accord, e.g., *supra* notes 1–9.

Article hint that such an effort could be foolish, because courts may not do much with most of the writings of law professors, no matter what they are.

B. *The Paradox of Perfunctory Use*

Notwithstanding the seemingly low quality, perfunctory use of legal scholarship in Supreme Court cases, the Supreme Court does use legal scholarship in about one-third of its cases overall, and as shown in Part II, in over 58% of its trademark cases. This presents something of a paradox. The levels of use make it appear as though legal scholarship is very important to opinions,¹⁴³ while the forms of use appear to be low quality and perfunctory, conveying that opinions do not take much of importance from the legal scholarship that is used. How can this paradox be reconciled?

An answer might be found in the concept of strategic use. We introduced this concept earlier, and after introducing it were content to leave it in the theoretical background, so as to pursue clearly the question of qualitative use. In view of our observations, it is worth returning to the concept of strategic use for a moment. Recall that the idea behind strategic use is that judges and justices select opinion content with the expectation that the choices made will have an impact on the perceptions of consumers of the opinion. Applied to the use of legal scholarship in opinions, this suggests that opinion writers will use law review articles in opinions when they expect that doing so will encourage a positive reception for an opinion.

Much of what we observed is consistent with this idea. Many of the uses of legal scholarship we observed, for example, are arguably serving the strategy of conveying competence and knowledge about a topic. Take, for example, *Steele v. Bulova*, where the opinion states: “[W]e do not pass on the merits of Bulova’s claim, [so] we need not now explore every facet of this complex and controversial Act.”¹⁴⁴ As we described, *ante*, the Court appends footnotes to both “complex” and “controversial.” The footnote appended to “complex” states:

For able Court of Appeals discussions of the impact of *Erie R. Co. v. Tompkins*, 304 U.S. 64 [(1938)], on the law prior and subsequent to the Lanham Act, see [cases]. And see Zlinkoff, *Erie v. Tompkins: In Relation to the Law of Trade-Marks and Unfair Competition*, 42 Col.

¹⁴³ See, e.g., Petherbridge & Schwartz, *An Empirical Assessment*, *supra* note 18; accord Crespi, *supra* note 14; Newton, *supra* note 14.

¹⁴⁴ *Steele v. Bulova Watch Co.*, 344 U.S. 280, 283 (1952) (footnotes omitted).

L. Rev. 955 (1942); Bunn, *The National Law of Unfair Competition*, 62 Harv. L. Rev. 987 (1949).¹⁴⁵

The footnote appended to “controversial” is similar. A purpose of these references to legal scholarship—the contents of which did not appear to inform the opinion’s analysis—might be to convince readers that the Court was broadly knowledgeable about the issues raised by the Lanham Act. Good knowledge about the issues raised by the Lanham Act indirectly implies competence in addressing the Act, and suggests that the Court made a sort of big picture accounting of such issues when reaching its decision in the case.

A strategy complementing that of conveying competence and knowledge of the topic seems to be pacification. In the statement to which the Court appends the legal scholarship it seems to be saying, “don’t worry, we understand that the Lanham Act presents a lot of thorny issues, but what we are going to decide in this opinion mostly avoids them.” Partisanship, it is suggested, concerning the complex and controversial aspects of the Lanham Act discussed in the cited legal scholarship, should be no reason to reject this opinion.

Another example in which legal scholarship might be used to serve the strategy of conveying competence and knowledge can be seen in opinions that use scholarship to help acknowledge that there are different views about an issue. An example of this sort of use discussed earlier comes from *Fleischmann*, where the opinion, introducing the issue of fee awards to successful plaintiffs, states: “Although some American commentators have urged adoption of the English practice in this country, our courts have generally resisted any movement in that direction.”¹⁴⁶ From that sentence, and specifically from “country,” the opinion notes:

Ehrenzweig, *Reimbursement of Counsel Fees and the Great Society*, 54 Calif. L. Rev. 792 (1966); McCormick, *Counsel Fees and Other Expenses of Litigation as an Element of Damages*, 15 Minn. L. Rev. 619 (1931); Stoebuck, *Counsel Fees Included in Costs: A Logical Development*, 38 Colo. L. Rev. 202 (1966); Note, 65 Mich. L. Rev. 593 (1967).¹⁴⁷

As discussed earlier, a review of the articles cited indicate that they either advocate for, or analyze fairly favorably, the award of attorney fees to successful plaintiffs. But the opinion does not address the details of the cited alternative views, and they appear to have no bearing on the decision the opinion reaches.

¹⁴⁵ *Id.* (some case citations omitted).

¹⁴⁶ *Fleischmann Distilling Corp. v. Maier Brewing Co.*, 386 U.S. 714, 717 (1967) (footnote omitted).

¹⁴⁷ *Id.* at 717 n.10.

So why cite the legal scholarship? We cannot be sure, of course, but a plausible speculation is for strategic purposes, viz. to again effect the strategy of creating the appearance of competence and knowledge: to suggest that there has been a decisional accounting of alternative views, whether or not such an accounting has actually been made.

Examples from other forms of use of legal scholarship are consonant with a theory of strategic use. For example, as set out earlier, when the *American Needle* opinion uses legal scholarship to support claims about the content of Supreme Court doctrine—specifically, about concerted activity within the meaning of the Sherman Act—the Court appends legal scholarship to a stringcite that emphasizes primary and other forms of secondary authority, signaling the legal scholarship with a “*see also*.”

The legal scholarship is thus made to appear as an additional, albeit not crucial, vote for what the opinion contends is the Court’s doctrine. But while perhaps unnecessary, the addition of a citation to legal scholarship may serve the strategy of adding costs to challengers of the views espoused in the opinion.

Each additional citation that is claimed to support the opinion’s view is an ally of sorts that a challenger might need to overcome. If the opinion offered no support for its statements about the doctrine surrounding concerted activity, the opinion’s statements are arguably at their most vulnerable. Contrary statements alone could stand on equal footing, and if equally or more convincing than what the opinion states, might by themselves be adequate to challenge the opinion’s claims about the law. Contrary statements, moreover, might go the extra step and claim support in cases, and so appear even stronger than an unsupported statement in an opinion.

By enlisting the relevant cases, the opinion sets them up as obstacles to competing views. But case interpretation can be a facile business. Certainly all lawyers are supposed to be competent at it. By adding a treatise, and then a law review article, the opinion defends the structure of the case interpretation it offers. To overcome it, a challenger now has to deal with the opinion’s allies, Professor Rock and Professor Areeda,¹⁴⁸ both of whom it is claimed support the meaning the opinion gives the cases. Indeed, even if the legal scholarship is not particularly supportive of the opinion’s claims, it is an ally that a challenger may have to account for. At bottom, such an opinion writing approach adds costs to challengers, costs that help to protect an opinion from successful challenge.

The above are examples of some strategies that may be served by the use of legal scholarship in the cases we examined. We have not here

¹⁴⁸ Not to mention the Areeda & Hovenkamp treatise, which is also used.

attempted to present an exhaustive list. The main point is to show through some examples that strategic use might explain the paradox of perfunctory use.

C. *Why So Much Use of Legal Scholarship in Trademark Opinions*

As noted in Part II, trademark opinions are more likely to use legal scholarship than nontrademark opinions. Here, we offer some very preliminary thoughts about why that might be so.

It might be the case that the Court uses so much legal scholarship in trademark opinions because trademark law is esoteric. If trademark law is generally the province of a relatively few knowledgeable individuals, it is quite possible that justices and their clerks are not normally well versed in it. If so, they might be less confident about the subject than they are about the other areas of law that comprise the Court's jurisprudence, and might be anxious that trademark decisions are more vulnerable than some other types of opinions to challenge. They might also be worried about embarrassment from making a mistake, or reaching an absurd-appearing decision. For the reasons discussed above, scholarship might be strategically deployed as a prophylactic against these concerns, and so the esotericness of trademark law—assuming it is esoteric to justices and their clerks—might provide an explanation for the comparatively high levels of use of scholarship we observed.

It might also be the case that there is something about trademark scholarship that recommends it to use. It might, for example, be especially easy to understand. Or, perhaps for some reason, much of it happens to be directed to issues that make their way into Supreme Court decisions.

In this connection, legal scholars, as noted earlier, have been roundly criticized over the last ten to fifteen years for producing scholarship that is supposedly unhelpful to the bench and bar. When jurists speak of the issue they typically finger "law and" type scholarship as well as other forms of social sciences research that has found its way into law reviews. Perhaps the trend to engage with social sciences and other disciplines has not been as strong in trademark scholarship as it has been in other areas. The articles we observed being used do not, with one or two exceptions, appear to engage with the social sciences in the ways that are normally criticized. So perhaps trademark scholarship is more regularly featured in opinions because it is comprised less of this supposedly useless sort of legal scholarship, and is comprised more of the sort of legal scholarship that jurists and practitioners find valuable to mention in cases.

CONCLUSION

Very little is known about how and why courts use legal scholarship. This Article reports a study of the Supreme Court's use of legal scholarship in its trademark jurisprudence. Among its contributions are the identification of Supreme Court trademark cases using and not using legal scholarship, including the identification of the pieces of legal scholarship used in each case. The Article also offers a preliminary taxonomy useful for descriptively categorizing the various sorts of uses of legal scholarship observed, and further, argues that much of the Court's use of legal scholarship is of the low quality, perfunctory variety. It discusses some potential implications of this observation.

APPENDIX A: CODING INSTRUCTIONS

Database: Legal > Cases - U.S. > Supreme Court Cases & Materials > U.S. Supreme Court Cases, Lawyers' Edition

Search, e.g.: CITES(20XX pre/1 "U.S. LEXIS") and (("L.J." or "L. J." or "L. REV." or "L.REV." or "J.L." or "LAW REVIEW" or "Ct.Rev." or "Ct. Rev.") w/15 (20** or 19** or 18**)) and not (("J.L." w/4 V.) or name((J. w/2 L.) or LJ or JL or "L.J." or "J.L.") or (counsel(LJ or JL or "L.J." or "J.L.)) or ("NAT! L.J." or "NATIONAL LAW JOURNAL"))

Overall Approach: Run search for year; code; run search for next year; code; repeat until finished.

How to search: Cut and past search from this sheet into search window for the proper LEXIS db. When changing search, click "Edit Search," change the Year, then "Search."

How to code:

Code only cases that have citations on the spreadsheet (constructed from The Supreme Court Database).

Sometimes you will see results with citations, and no cite for the case on the spreadsheet. These are usually things like dissents from denials of cert.; do not count them, e.g., 2008 U.S. LEXIS 8193, 2008 U.S. LEXIS 7763.

("bin" = binary (0,1); "num" = continuous number, including 0s (e.g., 0, 1, 3, 6, 7, 12, etc.)).

bincite: Do any of the opinions in the case cite a law review article?

numcites: How many articles are cited (a sum of all opinions)?

Articles*, unless separate (concur in part and dissent in part) cite the same article. If so, count the article 1x for each (concur in part and dissent in part) that cites to it.

*Do not double count articles means: If a single opinion cites the same article, viz. the majority opinion cites 123 U. Pa. L. Rev. 345 (2000), and then cites it again in either full or short form, count the article as being cited only once. If the opinion for the court cites 123 U. Pa. L. Rev. 345 (2000), and a concurrence cites 123 U. Pa. L. Rev. 345 (2000), count the article as being cited 2X; if the dissent also cites it, count it 3X, etc. The basic rule is only one count per opinion, although if more than one of the opinions deciding the case uses the article it can be counted more than once in a case.

APPENDIX B: Case Citations to Scholarship

Case	Citation to Scholarship	CaseCite	Form of Use
Steele v. Bulova Watch Co.		344 U.S. 280	
	Zlinkoff, <i>Erie v. Tompkins: In Relation to the Law of Trade-Marks and Unfair Competition</i> , 42 Col. L. Rev. 955 (1942)		FYI
	Bunn, <i>The National Law of Unfair Competition</i> , 62 Harv. L. Rev. 987 (1949)		FYI
	Timberg, <i>Trade-Marks, Monopoly, and the Restraints of Competition</i> , 14 Law & Contemp. Probs. 323 (1949)		FYI
	Brown, <i>Advertising and the Public Interest: Legal Protection of Trade Symbols</i> , 57 Yale L.J. 1165 (1948)		FYI
	Pattishall, <i>Trade-Marks and the Monopoly Phobia</i> , 50 Mich. L. Rev. 967 (1952)		FYI
	Rogers, <i>The Lanham Act and The Social Function of Trade-Marks</i> , 14 Law & Contemp. Probs. 173 (1949)		FYI
Fleischmann Distilling Corp. v. Maier Brewing Co.		386 U.S. 714	
	Goodhart, <i>Costs</i> , 38 Yale L.J. 849, 852 (1929)		Historical Fact
	Goodhart, <i>Costs</i> , 38 Yale L.J. 849-852 (1929)		Historical Fact
	Ehrenzweig, <i>Reimbursement of Counsel Fees and the Great Society</i> , 54 Calif. L. Rev. 792 (1966)		Acknowledge Diff
	McCormick, <i>Counsel Fees and Other Expenses of Litigation as an Element of Damages</i> , 15 Minn. L. Rev. 619 (1931)		Acknowledge Diff
	Stoebeck, <i>Counsel Fees Included in Costs: A Logical Development</i> , 38 Colo. L. Rev. 202 (1966)		Acknowledge Diff
	Note, 65 Mich. L. Rev. 593 (1967)		Acknowledge Diff
United States v. Sealy, Inc.		388 U.S. 350	
Inwood Labs., Inc. v. Ives Labs., Inc.		456 U.S. 844	
	Note, <i>Consumer Protection and Prescription Drugs: The Generic Drug Substitution Laws</i> , 67 Ky. L.J. 384 (1978-1979)		Historical Fact
	Note, <i>The Problem of Functional Features: Trade Dress Infringement Under Section 43(a) of the Lanham Act</i> , 82 Colum. L. Rev. 77 (1982)		Law/Policy Is
	Warner, <i>Consumer Protection and Prescription Drugs: The Generic Drug Substitution Laws</i> , 67 Ky. L.J. 384 (1978-1979)		Historical Fact
	Note, <i>The Problem of Functional Features: Trade Dress Infringement Under Section 43(a) of the Lanham Act</i> , 82 Colum. L. Rev. 77, 81 (1982)		Law/Policy Is
	Note, 82 Colum. L. Rev., <i>supra</i> , at 78-80		Law/Policy Is

- Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.** 469 U.S. 189
 Comment, Incontestable Trademark Rights and Equitable
 Defenses in Infringement Litigation, 66 Minn. L. Rev. 1067
 (1982) FYI
 Diggins, The Lanham Trade-Mark Act, 35 Geo. L.J. 147, 195
 (1947) Law/Policy Is
- San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.** 483 U.S. 522
 Schechter, The Rational Basis of Trademark Protection, 40
 Harv. L. Rev. 813, 825 (1927) Black Box Fact
- K Mart Corp. v. Cartier, Inc.** 485 U.S. 176
- K Mart Corp. v. Cartier, Inc.** 486 U.S. 281
 Derenberg, The Impact of the Antitrust Laws on Trade-
 Marks in Foreign Commerce, 27 N.Y.U. L. Rev. 414, 429
 (1952) Historical Fact
 Derenberg, The Seventh Year of Administration of the
 Lanham Trade-Mark Act of 1946, 44 Trade-Mark Rep. 991,
 996-1000 (1954) Historical Fact
 Note, Trade-Mark Infringement: The Power of an American Trade-Mark
 Owner to Prevent the Importation of the Authentic Product Manufactured by
 a Foreign Company, 64 Yale L.J. 557, 559-562, 566-568 (1955) Historical Fact
 Grismore, The Assignment of Trade Marks and Trade
 Names, 30 Mich. L. Rev. 490, 491 (1932) Historical Fact
 Grismore, 30 Mich. L. Rev. at 499 Historical Fact
 Atwood, Import Restrictions on Trademarked
 Merchandise—The Role of the United States Bureau of
 Customs, 59 Trademark Rep. 301, 304 (1969) Historical Fact
 Atwood, 59 Trademark Rep., at 305-307 Historical Fact
- Two Pesos, Inc. v. Taco Cabana, Inc.** 505 U.S. 763
 Derenberg, Federal Unfair Competition Law at the End of
 the First Decade of the Lanham Act: Prologue or Epilogue?,
 32 N.Y.U. L. Rev. 1029, 1034 (1957) Historical Fact
 Handler, Unfair Competition, 21 Iowa L. Rev. 175, 193
 (1936) FYI
 Derenberg, 32 N.Y.U. L. Rev., at 1047, 1049 Law/Policy Is
 Germain, Unfair Trade Practices Under § 43(a) of the
 Lanham Act: You've Come a Long Way Baby—Too Far,
 Maybe?, 64 Trademark Rep. 193, 194 (1974) Acknowledge
 Diff
- Qualitex Co. v. Jacobson Prods. Co., Inc.** 514 U.S. 159
 Landes & Posner, The Economics of Trademark Law, 78 T.
 M. Rep. 267, 271-272 (1988) Law/Policy Is
 Ebert, Trademark Protection in Color: Do It By the
 Numbers!, 84 T. M. Rep. 379, 405 (1994) Law/Policy
 Should Be

Coll. Sav. Bank v. Florida Prepaid Postsecondary Educ. Expense**Bd.** 527 U.S. 666**Wal-Mart Stores, Inc. v. Samara Bros., Inc.** 529 U.S. 205**Traffix Devices, Inc. v. Mktg. Displays, Inc.** 532 U.S. 23**Dastar Corp. v. Twentieth Century Fox Film Corp.** 539 U.S. 23**Moseley v. V Secret Catalogue, Inc.** 537 U.S. 418

Rational Basis of Trademark Protection, 40 Harv. L. Rev. 813, 831

Persuasive
Background

Klieger, Trademark Dilution: The Whittling Away of the Rational Basis for Trademark Protection, 58 U. Pitt. L. Rev. 789, 812–813, and n. 132 (1997)

Persuasive
Background

KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc. 543 U.S. 111**American Needle, Inc. v. NFL** 560 U.S. 183

Rock, Corporate Law Through an Antitrust Lens, 92 Colum. L. Rev. 497, 506–510 (1992)

Law/Policy Is

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Law/Policy Is

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Persuasive
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Persuasive
Background

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Persuasive
Background

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Background