

The Trademark Reporter®



The Law Journal of the International Trademark Association

Tracking the Protection of Well-Known Marks in India:
A Befuddled Path to Nirvana?

Latha R. Nair

A Verdict for Your Thoughts? Why an Accused Trademark Infringer's
Intent Has No Place in Likelihood of Confusion Analysis

Thomas L. Casagrande

Trademarks Laid Bare: Marks that May Be Scandalous or Immoral

Anne Gilson LaLonde and Jerome Gilson

Masterpiece v. Alavida: Supreme Court of Canada Clarifies
Likelihood of Confusion Test and Role of Expert Witnesses

Paul Tackaberry

The Dilution Defense Congress Never Meant to Create (and Needs to Fix)

Timothy A. Lemper and Joshua R. Bruce

**TRADEMARKS LAID BARE:
MARKS THAT MAY BE
SCANDALOUS OR IMMORAL***

*By Anne Gilson LaLonde** and Jerome Gilson****

WARNING

This article is a scholarly treatment of scandalous and immoral trademarks in the United States. Section 2(a) of the Lanham Act bars their registration, and here we analyze such marks and the activities of the United States Patent and Trademark Office in dealing with them.

In order to address the subject comprehensively, candidly and accurately, we have included subject matter that may offend some readers.

I. INTRODUCTION

Would people be offended by the trademark CRAZY BITCH for pajamas? Would they think the mark NUN STALKER for adult entertainment was immoral? Would they be scandalized by EAT POOP for underwear? What about a bottle of whiskey shaped like a naked woman? And how on earth would one find the answer, other than by tapping into one's own visceral reaction?

The United States Patent and Trademark Office (USPTO) is faced with an impossible task: It is legally required to make such determinations. Section 2(a) of the Lanham Act, The United States Trademark Act of 1946, bars registration in the United States of trademarks that consist of or comprise "immoral, deceptive, or scandalous matter."¹ Under this language, cancellation petitioners

* Copyright © 2011 Matthew Bender & Company, Inc., a member of the LexisNexis Group. All rights reserved. Materials reproduced from *Gilson on Trademarks* with the permission of Matthew Bender & Co., Inc., a member of the LexisNexis Group. Changes to the original are stylistic, save for a few updates.

** Anne Gilson LaLonde, author of *Gilson on Trademarks* (LexisNexis/Matthew Bender), Professor Member of the International Trademark Association.

*** Jerome Gilson, Shareholder in the firm of Brinks Hofer Gilson & Lione, Chicago, Illinois, Associate Member of the International Trademark Association, original author of *Gilson on Trademarks*. Mr. Gilson is a member of the Past Presidents and Past Counsel of INTA. He served on the Association's Board of Directors (1977-1980), as Counsel to the Association (1991-1994), and as Reporter for the Association's Trademark Review Commission (1985-1987).

1. 15 U.S.C. § 1052(a). That provision bars registration of such marks on the U.S. Principal Register. Registration on the Supplemental Register is prohibited as well. See 15 U.S.C. § 1091(a) ("All marks capable of distinguishing applicant's goods or services and not registrable on the principal register . . . except those declared to be unregistrable under subsections (a), (b), (c) and (d) of section 2 . . . may be registered on the supplemental register . . ."). See generally TMEP § 1203.01 ("Immoral or Scandalous Matter"). Deceptive matter as such is outside the scope of this article.

can even challenge registered marks that are incontestable.² Every state except Colorado, Maine and Wisconsin tracks the Lanham Act language exactly in prohibiting registration of scandalous or immoral marks,³ but to date there is no published state court case interpreting the language.

While this article focuses on United States standards and decisions, we note that international law also bars similar registrations. Under Article 6quinquies of the Paris Convention, member states may refuse or invalidate registration of marks that are “contrary to morality or public order.”⁴ Among the absolute grounds for refusal for Community Trade Marks is whether the mark is “contrary to public policy or to accepted principles of morality.” Trademark offices throughout the world are tasked with keeping their registries free of marks that are scandalous, immoral or contrary to public policy.

The difficulties with the USPTO deciding whether marks are “scandalous” and “immoral” are manifest, and consistency is topmost. The Office has no independent standards that apply to such determinations, which are made by dozens of different individuals of varying political, religious, geographic and family backgrounds. Further, it compounds the issue by refusing to acknowledge previous registrations of similar marks as precedential.

Another intractable problem is whether there is in fact a general public view about the offensiveness, or not, of any given trademark, and if there is, whether such a view can be determined by the USPTO under its current procedures. The Office has tremendous expertise in many areas of trademark law, but none in discerning the temperature of the public’s moral outrage.

2. 15 U.S.C. § 1064.

3. Code of Ala. § 8-12-7 (2011); Alaska Stat. § 45.50.010 (2011); A.R.S. § 44-1442 (2011); A.C.A. § 4-71-202 (2010); Cal. Bus. & Prof. Code § 14205 (2010); Conn. Gen. Stat. § 35-11b (2010); 6 Del. C. § 3303 (2010); Fla. Stat. § 495.021 (2010); O.C.G.A. § 10-1-441 (2011); HRS § 482-21 (2010); Idaho Code § 48-502 (2011); 765 ILCS 1036/10 (2011); Burns Ind. Code Ann. § 24-2-1-3 (2011); Iowa Code § 548.102 (2010); K.S.A. § 81-203 (2009); KRS § 365.567 (2010); La. R.S. 51:212 (2011); Md. Bus. Reg. Code Ann. § 1-404 (2011); ALM GL ch. 110H, § 2 (2010); MCLS § 429.32 (2011); Minn. Stat. § 333.19 (2010); Miss. Code Ann. § 75-25-3 (2010); § 417.011 R.S. Mo. (2011); Mont. Code Anno. § 30-13-303 (2010); R.R.S. Neb. § 87-129 (2010); Nev. Rev. Stat. Ann. § 600.330 (2010); NH RSA 350-A:2 (2010); N.J. Stat. § 56:3-13.2 (2011); N.M. Stat. Ann. § 57-3B-4 (2010); N.Y. CLS Gen. Bus. § 360-a (2011); N.C. Gen. Stat. § 80-2 (2010); N.D. Cent. Code, § 47-22-02 (2010); ORC Ann. 1329.55 (2011); 78 Okl. St. § 22 (2010); ORS § 647.035 (2009); 54 Pa. C.S. § 1111 (2010); R.I. Gen. Laws § 6-2-3 (2011); S.C. Code Ann. § 39-15-1110 (2010); S.D. Codified Laws § 37-6-6 (2010); Tenn. Code Ann. § 47-25-502 (2010); Tex. Bus. & Com. Code § 16.08 (2010); Utah Code Ann. § 70-3a-301 (2011); 9 V.S.A. § 2527 (2010); Va. Code Ann. § 59.1-92.3 (2010); Rev. Code Wash. (ARCW) § 19.77.020 (2011); W. Va. Code § 47-2-2 (2011); Wyo. Stat. § 40-1-102 (2011).

4. See www.wipo.int/treaties/en/ip/paris/ for the full text of the Paris Convention and a list of members.

Even if a majority would not be offended at marks that disturb a minority, those could still be barred from registration under a different provision of the Act. Racially offensive marks, for example, could be considered disparaging of “persons, living or dead, institutions, beliefs, or national symbols” and rejected to the same extent as scandalous and immoral marks.⁵

II. CASE STUDY: MILF

To understand the difficulties inherent in Section 2(a) determinations of scandalousness or immorality, we are going to do a short case study. We will look at USPTO determinations of the registrability of marks that include one particular controversial term. There is no Trademark Trial and Appeal Board (the Board) pronouncement on it; these are decisions by USPTO examining attorneys and in some cases their managing attorneys.

The term is the evidently-popular acronym MILF, which some take to stand for Mom(s) I’d Like to Fuck. On its face, though, the acronym itself is not profane.

As of this writing, applicants have filed forty-one applications to register marks that include it. Twenty received an office action refusal based on Section 2(a), but twenty did not. (The electronic files of one application from a decade ago are incomplete.) Clearly, the USPTO cannot make up its mind. Here is a summary of its handling of MILF-formative marks.

Nine marks that include the acronym are registered: DIARY OF A MILF, BACKROOM MILF, MILF MAGNET, FAT MILF, MILFDATE, MILF NEXT DOOR, MILF WORKOUT, MILF SOUP and MILF LESSONS.⁶ Of these, DIARY OF A MILF received an office action with a Section 2(a) scandalousness refusal and then an August 16, 2007 reconsideration letter reaffirming that refusal. A February 12, 2008 notation to the file states: “Subsequent consultation with Managing Attorney; 2(a) refusal withdrawn.” The mark registered on June 3, 2008. Similarly, MILF NEXT DOOR received an office action with a Section 2(a) scandalousness refusal on November 1, 2007. A notation to the file from June 27, 2008 reads: “Subsequent consultation with Managing Attorney;

5. 15 U.S.C. § 1052(a). See also § VI[a] *infra* on treatment of religious and ethnic trademarks under the “scandalous” provision.

6. Reg. Nos. 3440702 (adult entertainment web site) (registered June 3, 2008), 3805833 (adult entertainment web site) (registered June 22, 2010), 3759020 (athletic apparel) (registered Mar. 9, 2010), 3372094 (sandwich) (registered Jan. 22, 2008), 3611639 (“Internet based social networking, introduction, and dating services”) (registered Apr. 28, 2009), 3518834 (adult entertainment web site) (registered Oct. 21, 2008), 3782533 (physical fitness instruction) (registered Apr. 27, 2010), 3754285 (adult entertainment web site) (registered Mar. 2, 2010) and 3754284 (adult entertainment web site) (registered Mar. 2, 2010).

2(a) refusal withdrawn.” That mark registered on October 21, 2008.⁷

Seven applications were abandoned following an office action that did *not* mention Section 2(a): MILF CLOTHING,⁸ MILF MATERNITY WEAR,⁹ three applications for MILF HUNTER from the same applicant,¹⁰ MILFYOURSELF.COM¹¹ and MILF MAGAZINE.¹² Three others were published for opposition with no office action: UNIVERSITY OF MILF for “a website featuring adult-oriented videos and photographs,”¹³ MILF MAN I LOVE FOOTBALL for clothing,¹⁴ and MENOPAUSE MILF for jewelry and clothing.¹⁵ Another received an office action that did not mention Section 2(a) and was approved for publication: a design mark for cosmetics and skin care including the words MILF COSMETICS MOMS INTENT ON LOOKING FABULOUS:¹⁶



We can assume that no examining attorney considered these marks to contain a scandalous term.

On the other hand, twenty applications were abandoned after receiving office actions containing Section 2(a) rejections for scandalousness and immorality: WANT MILF? for clothing,¹⁷ GOT

7. In comparison, another mark, THE G-MILF HUNTER, received an office action refusal based on scandalousness on May 8, 2008, along with a notation to the file from the same day noting that the examining attorney had checked the mark with his managing attorney, who confirmed the refusal. Ser. No. 77376265 (application abandoned Dec. 8, 2008).

8. Ser. No. 77320621 (Office Action Feb. 19, 2008) (application abandoned Sept. 22, 2008).

9. Ser. No. 77435429 (abandoned Jan. 12, 2009).

10. Ser. No. 77457166 (abandoned Mar. 20, 2009); Ser. No. 77457157 (abandoned Mar. 23, 2009); Ser. No. 77457128 (abandoned Mar. 20, 2009).

11. Ser. No. 77595504 (abandoned Aug. 19, 2009).

12. Ser. No. 77787583 (abandoned June 3, 2010).

13. Ser. No. 85065096 (published for opposition on Nov. 9, 2010).

14. Ser. No. 77798661 (notice of publication on Jan. 5, 2010) (application abandoned).

15. Ser. No. 77960545 (notice of publication on Aug. 4, 2010).

16. Ser. No. 85119982 for skin care products (Office Action Dec. 21, 2010) (approved for publication Mar. 17, 2011).

17. Ser. No. 78710449 (Office Action Mar. 24, 2006).

MILF? for clothing,¹⁸ GOT MILF for clothing,¹⁹ MILF.XXX for an adult entertainment web site,²⁰ MILF CONTEST for “arranging and conducting beauty contests featuring mothers,”²¹ MILF SEEKER for adult entertainment services,²² MILF GOLF for women’s golf apparel,²³ MILF-WEAR for clothing,²⁴ MILF MANIA for online adult entertainment services,²⁵ GOT MILF? for clothing, hats, belts, underwear and stickers,²⁶ MILF for clothing,²⁷ FROM SOCCER MOM TO MILF for a series of non-fiction self-help books for women,²⁸ THE G-MILF HUNTER for wrestling performances and the provision of wrestling news,²⁹ MILF MEMBER for t-shirts and hats,³⁰ MILF AND COOKIES for motion picture and television production,³¹ MILF DUDS #1-B for apparel,³² MILF SEEKER for an adult entertainment website,³³ MILF MAKEOVERCONTEST.COM (with design) for “promoting the sale of goods and services of others through the distribution of printed material and promotional contests,”³⁴ MILF DUDS for apparel³⁵ and MILF INDUSTRIES for clothing.³⁶

Insufficient information was available on MILF for clothing, filed on October 23, 2000 and abandoned on October 3, 2001.³⁷

Here is a brief summary of the checkered career of the above MILF-formative applications:

-
18. Ser. No. 78840760 (Office Action Sept. 4, 2006).
 19. Ser. No. 78700246 (Office Action Mar. 14, 2006).
 20. Ser. No. 78643772 (Office Action Aug. 10, 2006).
 21. Ser. No. 78643088 (Office Action Aug. 31, 2006).
 22. Ser. No. 78618337 (Office Action Nov. 28, 2005).
 23. Ser. No. 78614007 (Office Action Nov. 30, 2005).
 24. Ser. No. 78388365 (Office Action Aug. 1, 2005).
 25. Ser. No. 78375304 (Office Action July 20, 2005).
 26. Ser. No. 78223801 (Office Action Sept. 6, 2003).
 27. Ser. No. 78164236 (Office Action Mar. 6, 2003).
 28. Ser. No. 77686422 (Office Action June 2, 2009).
 29. Ser. No. 77376265 (Office Action May 8, 2008).
 30. Ser. No. 77247488 (Office Action Nov. 26, 2007).
 31. Ser. No. 77126313 (Office Action Aug. 6, 2007).
 32. Ser. No. 77070433 (Office Action Feb. 15, 2007).
 33. Ser. No. 77043802 (Office Action Mar. 19, 2007).
 34. Ser. No. 77009914 (Office Action Feb. 23, 2007).
 35. Ser. No. 77004154 (Office Action Feb. 15, 2007).
 36. Ser. No. 76495559 (Office Action Aug. 4, 2003).
 37. Ser. No. 78031970.

CATEGORY	NUMBER OF APPLICATIONS	DATE RANGE OF REGISTRATION, ABANDONMENT, PUBLICATION
Registered	9	2008-2010
Abandoned after office action that did not mention Section 2(a)	7	2008-2010
Published for opposition with no office action	3	2010
Received office action that did not mention 2(a), approved for publication	1	2010-2011
Abandoned after office action refusal based on Section 2(a)	20	2003-2009
Abandoned, other details unknown	1	2000-2001

The USPTO would protest that these applications cover different marks, goods and services, and cannot be compared with each other. However, in each of the refusals on Section 2(a) grounds, the Office looked exclusively at the term MILF and found it to be vulgar, offensive and scandalous. It did not mention the goods or services or discuss the mark as a whole.³⁸ In other words, we conclude that each rejection was expressly due to the use of the term MILF alone because of the offensive “F” letter and its widely-understood meaning. Thus, twenty marks were rejected for using the term MILF while twenty others were not. It was a *tie*.

As the USPTO issued the registrations more recently, it seems that the USPTO has changed its view of the term MILF and whether it should be refused under Section 2(a). Though one mark was refused registration in 2008 and another in 2009, all the rest were refused *before* the MILF applications began to make it to registration. What happened to change the Office’s mind? Was there a concerted decision, or did one accidental registration pave the way for the rest? Had the examining attorneys who did not issue a Section 2(a) refusal never heard of the acronym? Was there a personnel change, or perhaps a change in attitude reflecting either capitulation or a grudging tolerance for modern usage?

38. The one exception is the office action for MILF.XXX for online adult entertainment, which responded to the applicant’s claim that MILF also stands for “Moro Islamic Liberation Front” by stating that “it is clear from the applicant’s specimen of use, description of services, and use of the lettering XXX that the applicant intended consumers to readily understand that the term ‘MILF’ . . . refers to the vulgar or scandalous phrase.” Ser. No. 78643772 (Office Action Aug. 10, 2006).

This case study also illustrates the difficulties of deciding whether a mark that is not overtly vulgar or offensive on its face can still be scandalous. If a large percentage of the population does not know what this acronym means, an issue not addressed by the USPTO, it is difficult to believe that a substantial composite of the general public would be offended by it. And teenagers have surely created acronyms to stand for phrases that contain vulgar words, acronyms totally unknown to many adults. Should the USPTO deny registration to those?

We raise more questions than we answer, because we cannot attribute a coherent thought process to dozens of different individuals. Nevertheless, one must admire the diligent examining attorney who did not raise a scandalousness refusal but instead required the applicant for MILF HUNTER to disclaim the word MILF because “[t]he applicant’s adult entertainment will feature MILFs.”³⁹

III. RATIONALES

The ban on scandalous and immoral trademark registrations first surfaced in U.S. federal law in the Trade-Mark Act of 1905,⁴⁰ and it was carried over to the Lanham Act in Section 2(a) in 1946. Legislative history provides no insight as to the rationale for prohibiting registration of scandalous and immoral marks, but with varying degrees of persuasiveness, several different reasons have been advanced for such a ban.

a. Refusal to Spend Taxpayer Money on Inappropriate Trademarks

Courts have protested that rejection of scandalous or immoral marks is a matter of money. As the argument goes, limited government resources should not be spent to protect material that offends many people.

In 1981, the United States Court of Customs and Patent Appeals (CCPA) declared that the prohibition against registering scandalous marks was not “an attempt to legislate morality, but, rather, a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government.”⁴¹

39. Ser. No. 77457157 (Office Action Aug. 24, 2008).

40. See Section 5(a) of the Trade-Mark Act of 1905, 15 U.S.C. § 85(a) (1905) (“That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—(a) Consists of or comprises immoral or scandalous matter.”).

41. *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981).

The Federal Circuit echoed this statement in 1994.⁴² The 1981 *McGinley* court provided a litany of ways in which the government must spend money on a trademark registration:⁴³

- giving public notice in an official government publication;
- maintaining permanent public records listing the mark;
- compelling the Customs service to block importation of infringing goods;
- providing access to federal courts to protect the mark where the registration enjoys a presumption of validity;
- sending notices to the registrant regarding maintenance of its registration; and
- protecting the mark by refusing registration to third parties of their conflicting marks.

The court added that “these costs are underwritten by public funds.”

However, all USPTO trademark operating costs have been funded by user fees for years;⁴⁴ therefore, registration, notice, and maintenance of records no longer depend upon public funding. If there were no Section 2(a) grounds for refusal, the Office would actually save time and money in not making the refusals, following up after responses to office actions, and handling proceedings before the Board.⁴⁵ As the dissent in *McGinley* claimed, “[m]ore ‘public funds’ are being expended in the prosecution of this appeal than would ever result from the registration of the mark.”⁴⁶

42. *In re Mavety Media Gp. Ltd.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994), quoting *In re McGinley*, 660 F.2d at 486. See also *In re Wilcher*, 40 U.S.P.Q.2d 1929 (T.T.A.B. 1996) (same); *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216 (T.T.A.B. 1993) (same).

43. *In re McGinley*, 660 F.3d at 486.

44. By 1991, the process of converting to a user-funded agency was complete. See *Revision of Patent and Trademark Fees*, 56 Fed. Reg. 65142 (1991).

45. Ron Phillips, *A Case for Scandal and Immorality: Proposing Thin Protection of Controversial Trademarks*, 17 U. Balt. Intell. Prop. L.J. 55, 68-69 (2008) (“It seems likely that more governmental time and resources are needlessly spent with office actions and appellate work targeted at barring scandalous marks than is saved by their proscription.”); Jasmine Abdel-Khalik, *To Live in In-Fame’-Y: Reconceiving Scandalous Marks As Analogous to Famous Marks*, 25 Cardozo Arts & Ent. L.J. 173, 213 (2007) (“[O]ne may speculate that the government spends more resources debating with the applicant (or third parties) whether a mark is scandalous than it would if it allowed the mark to register.”); Theodore H. Davis, Jr., *Registration of Scandalous, Immoral, and Disparaging Matter Under Section 2(a) of the Lanham Act: Can One Man’s Vulgarity be Another’s Registered Trademark?*, 83 TMR 801, 833 (1993) (“[I]t is the PTO’s opposition to a mark, rather than its approval, that is more likely to cause the expenditure of federal funds and, for that reason, Section 2(a) is inappropriately considered a presumptively valid decision not to fund.”) (footnote omitted).

46. *In re McGinley*, 660 F.3d at 487 (Rich, J., dissenting).

***b. Refusal to Put Governmental Stamp of
Approval on Inappropriate Trademarks***

Another reason for denying registration to scandalous and immoral marks is that the government should not give its approval to offensive or prurient matter. Unlike the funding rationale, the USPTO and its reviewing courts have denied that this is the reason behind the ban. They have stated instead that the government does not explicitly or tacitly approve of the message inherent in a trademark when registering it, and therefore registration would not create the appearance of government approval. In the seminal *McGinley* opinion, for example, the CCPA declared:

The issue is not whether the act of registration would create a scandal insofar as the relationship between the PTO and the public is concerned, but whether the mark comprises scandalous matter based on the ordinary and common meaning of “scandalous.” Whether the PTO would be considered to have placed its imprimatur on the mark . . . is not relevant.⁴⁷

Over a decade later, the Board reinforced this conclusion. It stated that it had, in cases involving scandalous marks, “detected an undercurrent of concern that the issuance of a trademark registration for applicant’s mark amounts to the awarding of the U.S. Government’s ‘imprimatur’ to the mark.”⁴⁸ There, it concluded:

The duty of this Office under the Trademark Act in reviewing applications for registration is nothing more and nothing less than to register those marks that are functioning to identify and distinguish goods and services in the marketplace, as long as those marks do not run afoul of any statutory provision that would prohibit registration. . . . Just as the issuance of a trademark registration by this Office does not amount to a government endorsement of the quality of the goods to which the mark is applied, the act of registration is not a government imprimatur or pronouncement that the mark is a “good” one in an aesthetic, or any analogous, sense.

In other words, the government does not intend to approve or disapprove of any marks, so no one should believe that it does.

But is it possible that a determination that a term “gives offense to the conscious or moral feelings or is shocking to the sense of decency or propriety of a substantial composite of the

47. *Id.* at 487 n.13.

48. *In re Old Glory Condom*, 26 U.S.P.Q.2d 1216, n.3.

general public of the United States”⁴⁹ is not government disapproval?

Even if the case law makes such a claim, it does not represent a realistic assessment of the public’s view. If a newspaper printed an article stating that the USPTO had registered an extremely vulgar term, people would surely believe that the agency had approved of its use. Trademark lawyers and the USPTO may understand that registration is not a stamp of approval, but this seems far less likely to be the case with the general public, who will inevitably infer that registration connotes support or endorsement.

c. Protection of Consumers’ Sensibilities

Another explanation is the claim that scandalous and immoral trademarks will harm society’s sensibilities. Seeing vulgarities on products will inflict emotional distress on a substantial portion of consumers, the argument goes. As we shall see, the ultimate question in deciding whether a mark is scandalous is whether a substantial composite of the American public will understand it to be vulgar, offensive, or shocking.⁵⁰ This rationale is the one that in fact appears to be driving the ban on scandalous and immoral trademark registrations. The evident harm that the ban is seeking to prevent is offense, embarrassment and shock to the public.

Numerous marks mentioned in this article are indeed offensive and would embarrass or disgust many. However, refusal to register a given mark does *not* prevent the trademark owner from using it.⁵¹ If marks are too offensive for consumers’ sensibilities—or at least the sensibilities of a substantial composite of consumers—then according to the consumer protection argument, they should not be permitted in the marketplace at all. But we know that, even if the trademark for a product or service is grossly inappropriate, refusing registration will not prevent businesses from using it. The mark may continue to be used at will, shocking and dismaying consumers. Refusing registration, then, does not really protect consumers’ sensibilities. One would also think that, if a mark were truly offensive to a substantial portion of the public, consumers would boycott the associated

49. *E.g., In re Tinseltown, Inc.*, 212 U.S.P.Q. 863 (T.T.A.B. 1981).

50. *See* § IV[a] *infra*.

51. *See* Anne Gilson LaLonde, 3 *Gilson on Trademarks* § 9.01[2][b] (“The T.T.A.B. cannot determine parties’ rights to use trademarks.”); TBMP § 102.01.

But see Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TMR 661, 677 (1993) (“Although it is clear that barring and removing offensive matter from the federal registers will not proscribe the commercial use of such matter, it certainly provides an economic disincentive to engage in such use. Section 2(a) may provide the economic lever necessary to affect . . . changes in trademark usage. . . .”).

goods or services. Ultimately, this would remove the mark from the marketplace.

Protecting consumers from prurient and distasteful matter in trademarks has no bearing on the goods and services that registrations cover.⁵² Therefore, refusal to register scandalous marks does not eliminate exposure to potentially offensive goods and services. The TMEP states plainly that this Section 2(a) prohibition “pertains only to *marks* that are scandalous. The authority of the Act does not extend to goods that may be scandalous.”⁵³ Included in the USPTO’s Acceptable Identification of Goods and Services Manual are adult sexual stimulation aids in Class 10; entertainment services, namely, providing a web site featuring non-downloadable adult-themed photographs and videos in Class 41; sex dolls in Class 10; and prostitution services in the state of Nevada in Class 45. There are current registrations for escort services,⁵⁴ “artificial body part sex toy devices,”⁵⁵ and an “on-line buyers guide service providing information in the field of fetish related goods and services.”⁵⁶ While goods and services are not covered by the statutory mandate of Section 2(a), allowing registrations where the goods or services are prurient is inconsistent with the policy of protecting the public from exposure to scandalous and immoral registrations.

The USPTO only registers marks that would be in lawful use in interstate commerce.⁵⁷ It has registered marks for prostitution services but only for “legalized” or “legal” prostitution services.⁵⁸ Similarly, if it appears to the USPTO that the goods contain a controlled substance, it will refuse registration. For example, the USPTO issued an office action refusing registration for

52. *McDermott v. San Francisco Women’s Motorcycle Contingent*, 81 U.S.P.Q.2d 1212 (T.T.A.B. 2006) (“A claim under Section 2(a) against the registration of scandalous or immoral matter pertains only to *marks* that are scandalous or immoral. The authority of the Act does not extend to goods or services that may be viewed as scandalous or immoral in nature.”), *aff’d*, 240 Fed. Appx. 865 (Fed. Cir. 2007) (unpublished); *In re Thomas Labs., Inc.*, 189 U.S.P.Q. 50 (T.T.A.B. 1975) (“Turning first to a consideration of the goods themselves, inasmuch as no question has been raised concerning the legality of the sale thereof in commerce which may be regulated by Congress, there can be no occasion for this factor to play a role, either expressly or implicitly, in the determination of registrability.”); *In re Madsen*, 180 U.S.P.Q. 334 (T.T.A.B. 1973) (“In making this determination, the question of whether or not the contents of the magazine may be pornographic in nature, is not an issue to be decided by this Board.”).

53. TMEP § 1203.01 (emphasis in original).

54. *E.g.*, Reg. Nos. 3187289 (VIP ESCORTS); 3167508 (MOONLITE BUNNY RANCH).

55. Reg. No. 3866044 (SEX IN THE SHOWER).

56. Reg. No. 3863689 (TELL ME WHERE YOU WANT IT TO HURT).

57. TMEP § 907 (“Use of a mark in commerce must be lawful use to be the basis for federal registration of the mark.”).

58. WORLD FAMOUS BROTHEL (Reg. No. 3238218); WILD HORSE ADULT RESORT AND SPA (Reg. No. 3408075); WORLD FAMOUS MUSTANG RANCH (Reg. No. 3408075).

MARIJUANA COOLERS for herbal food beverages on the ground that the wording in the mark “plainly indicates” that the goods include a substance prohibited by the Controlled Substances Act.⁵⁹

***d. The Prohibition Does Not Fit Into
the Overall Trademark Protection Scheme***

The Lanham Act protects consumers from deception and unfair trade practices. For example, Section 2 bars registration of marks that would mislead the public as to the qualities or geographic origin of the goods or services connected with them. This includes deceptive,⁶⁰ deceptively misdescriptive, primarily geographically descriptive, and primarily geographically deceptively misdescriptive marks,⁶¹ as well as marks that “falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols.”⁶² These grounds for refusal also protect competitors from unfair, deceptive practices.

The Lanham Act refuses to register marks that are functional,⁶³ descriptive or generic⁶⁴ in order to stop one producer from having a monopoly on a name or useful product feature.⁶⁵ Courts protect competitors from a wide variety of unfair practices, like infringement and dilution,⁶⁶ and the USPTO must refuse registration of a mark that is likely to cause confusion, mistake or deception by its resemblance to another mark.⁶⁷

The ban on scandalous and immoral registrations does not fit within the fundamental goals of trademark law.⁶⁸ Such marks do not by their nature deceive consumers or harm competitors, and could serve as source identifiers and acquire good will. In fact, the ban may even thwart an important goal. The purpose of a trademark register is to have a record of active trademarks so that potential trademark owners can consult it and avoid using previously-adopted marks.⁶⁹ In other words, to the extent possible,

59. Ser. No. 85102716 (abandoned June 10, 2011).

60. 15 U.S.C. § 1052(a).

61. 15 U.S.C. § 1052(e).

62. 15 U.S.C. § 1052(a).

63. 15 U.S.C. § 1052(e)(5).

64. 15 U.S.C. § 1052(e)(1).

65. See 1 Gilson on Trademarks §§ 2.02[2], 2A.04.

66. See 2 Gilson on Trademarks Chapters 5 (likelihood of confusion), 5A (dilution).

67. 15 U.S.C. § 1052(f).

68. Danwill Schwender, *Congressional Trademark Delusion: Section 2(a) Expands the Unclean Hands Doctrine Too Far*, 48 IDEA 225, 225 (2008) (“Denial of registration should be a direct result of unfair competition and source identification—the underlying principles of trademark law.”).

69. See *In re Old Glory Condom*, 26 U.S.P.Q.2d 1216, n.3 (“[T]he registration scheme of the Trademark Act is one more inclined to inclusion than exclusion, the obvious idea being

a register of marks should include all valid marks in actual use. Failure to register marks that are not deceptive or confusingly similar to others directly contravenes this goal.

Another difference between prohibiting the registration of scandalous and immoral marks and prohibiting the registration of deceptive or confusing marks is a difference in who has the most information. In the case of deceptive marks, for example, the USPTO has the edge. It can ask an applicant whether HAPPYSILK pajamas are actually made out of silk, but a consumer is unlikely to do so and is more likely to assume that the pajamas contain silk. It can determine whether a particular living individual identified in a mark has given his or her consent, whereas a consumer may simply assume the use was authorized. In the case of scandalous and immoral marks, however, the Office and, more often, its examining attorneys, are forced to rely on dictionary definitions, news articles and blog posts to deduce what a substantial composite of the public will understand about a mark.⁷⁰

IV. STANDARD FOR FINDING MARKS TO BE SCANDALOUS OR IMMORAL

How does the USPTO determine which marks are scandalous and immoral?

a. Scandalous

In order to meet its burden and reject a trademark as scandalous or immoral, the USPTO must show that the mark is “shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . giving offense to the conscience or moral feelings; . . . [or] calling out [for] condemnation.”⁷¹ Those formulations are taken from two dictionary definitions cited in the 1938 Federal Circuit opinion finding MADONNA to be scandalous for wines and are used in modern opinions.⁷² Here is a handy list of the USPTO’s definitions of the relatively old-fashioned term “scandalous,” all but the last from 1938:

to give as comprehensive a notice as possible, to those engaged in commerce, of the trademarks and service marks in which others have claimed rights.”).

70. See § IV[g] *infra*.

71. *In re Mavety Media*, 33 F.3d at 1371 (Fed. Cir. 1994), citing *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938).

72. *In re Riverbank Canning*, 95 F.2d at 327. See *In re McGinley*, 660 F.3d at 486 n.11 (“We note that the dictionary editions cited were extant at the time of enactment of the Lanham Act in 1946, and it is these definitions which, in the absence of evidence to the contrary, the Congress considered in framing the Act.”).

- “shocking to the sense of truth, decency or propriety”
- “disgraceful”
- “offensive”
- “disreputable”
- “giving offense to the conscience or moral feelings”
- “calling out for condemnation”
- “exciting reprobation”
- “vulgar” (“lacking in taste, indelicate, morally crude”)⁷³

The Federal Circuit has held that a showing that a mark is “vulgar” is sufficient to show that it is scandalous or immoral under Section 2(a).⁷⁴ Generally, if a mark in context is extremely offensive, it is scandalous. A dissenting Board Administrative Law Judge once sought to clarify the situation, declaring that, “although a term may be in bad taste or politically incorrect, that does not mean that it is ‘shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . giving offense to the conscience or moral feelings; . . . [or] calling out [for] condemnation.’”⁷⁵ However, that has proved to be a minority opinion.

b. Immoral

U.S. courts and the Board have not distinguished between “immoral” and “scandalous”⁷⁶ and have focused on whether marks are scandalous or offensive rather than contrary to some accepted standard of morality.

In one refusal of registration that reached the Board, the mark at issue was a drawing of a frog that may or may not have been raising its middle finger in a vulgar gesture.⁷⁷ The examining attorney had rejected the mark on the ground that it was scandalous but also on the ground that it was immoral. The majority of the panel found the mark not scandalous, but did not discuss the immorality rejection. However, the dissent agreed that the mark “falls well within the definition of that word,”⁷⁸ using a dictionary contemporaneous with the enactment of the Lanham

73. *Id.* at 486.

74. *In re Boulevard Entertainment, Inc.*, 334 F.3d 1336, 1340 (Fed. Cir. 2003).

75. *In re Love Bottling Company*, 2005 TTAB LEXIS 261 (T.T.A.B. 2005) (not precedential) (Seeherman, J., dissenting) (citations omitted).

76. TMEP § 1203.01 (“Although the words ‘immoral’ and ‘scandalous’ may have somewhat different connotations, case law has included immoral matter in the same category as scandalous matter.”).

77. *In re Bad Frog Brewery, Inc.*, 1999 TTAB LEXIS 86 (T.T.A.B. 1999) (not precedential). See § VI[f][iii] *infra*.

78. *Id.* (Simms, J., dissenting).

Act to define “immoral” as “inconsistent with rectitude, purity, or good morals; contrary to conscience or moral law; wicked; vicious; licentious.”⁷⁹ The average person, stated the dissent, would recognize that “applicant’s frog is clearly making a very obscene human gesture, fully intended by applicant,” and would perceive the mark as “inconsistent with . . . purity, or good morals.”

Fortunately, the concept of immorality has not gotten much play on its own. Even an entity with more expansive resources than the USPTO would have difficulty determining what a substantial composite of the American people finds to be immoral. Some people believe that spanking children is immoral, or that smoking is immoral, or that abortion is immoral. Others disagree. Some people enjoy television shows that include profanity and violence. Others abhor them.

The USPTO has chosen to go beyond the statutory requirement of refusing registration to trademarks that consist of or comprise “immoral, deceptive, or scandalous matter.”⁸⁰ It has added the requirement that it must instead make a determination of a *point of view about morality* rather than discovering what material is *in fact immoral*.⁸¹ Nevertheless, making a finding about what some, a majority, or all people think is immoral is not feasible.

c. Context of the Marketplace

The USPTO declares that it does not analyze whether a mark is *per se* scandalous. Instead, it considers the mark in the context of the goods or services presented in the application for registration.⁸² For example, in its 1938 opinion, the Court of Customs and Patent Appeals found that, “[o]f course, the word ‘Madonna’ is not *per se* scandalous,”⁸³ but refused registration for the religious term in connection with wine. And much more recently, it found COCAINE scandalous as applied to soft drinks

79. *Id.*, citing Webster’s New International Dictionary (2d ed. unabridged 1945).

80. 15 U.S.C. § 1052(a).

81. *Ritchie v. Simpson*, 170 F.3d 1092, 1098-99 (Fed. Cir. 1999) (“The ultimate question the PTO must decide is whether the use of [a mark] on a broad range of goods in the public market place ‘comprises immoral, deceptive, or scandalous matter which may disparage . . . beliefs . . . or bring them into . . . disrepute.’ This is a question of public perception, not private morals or even private conduct.”) (citation omitted).

82. *E.g.*, *In re Riverbank Canning*, 95 F.2d at 328 (“It is therefore obvious that, in determining whether a mark ‘consists of or comprises * * * scandalous matter,’ consideration ordinarily must be given to the goods upon which the mark is used.”); *Doughboy Indus., Inc. v. Reese Chemical Co.*, 88 U.S.P.Q. 227 (PTO Exm’r-in-Chief 1951) (“A trade mark does not exist apart from goods in connection with which it is used (or to be used, in other jurisdictions), and the nature of a trade mark for the purpose of section 2(a) may be determined from the associations conveyed by the word used as the mark in connection with the goods with which it is used.”).

83. *In re Riverbank Canning*, 95 F.2d at 328.

and energy drinks because the goods were consumable and would be marketed to teenagers.⁸⁴

On the flip side, the Board, perhaps with tongue in cheek, permitted registration of a slang term for marijuana in 1972, finding that the mark ACAPULCO GOLD for suntan lotion would suggest the sunshiny resort city of Acapulco rather than the illegal drug.⁸⁵ It also found that the mark MOONIES would not suggest followers of the Reverend Sun Myung Moon because it was used on dolls that “moon,” or drop their pants.⁸⁶

Despite its general rule, the USPTO has found some marks *per se* scandalous, no matter what the goods. In 1943, the Commissioner of Patents affirmed the refusal to register AGNUS DEI, meaning Lamb of God, and a pictorial representation, for metallic tabernacle safes.⁸⁷ Citing the MADONNA opinion, the Commissioner reasoned: “To commercialize an emblem of such highly sacred religious significance would, I think, be offensive to most individuals of the Christian faith, and thus scandalous within the meaning of the statute. . . . It is applicant’s attempted appropriation of the mark to indicate commercial origin that is objectionable.” More recently, the Board found the mark BULLSHIT profane and thus scandalous regardless of the goods on which it was placed.⁸⁸

Some have argued that the plain language of the Lanham Act requires that the USPTO look only at the marks themselves, absent the context of goods and services.⁸⁹ This interpretation, however, is not persuasive. The Act bars registration of “immoral, deceptive, or scandalous matter.” The two adjectives at issue

84. *In re Kirby*, 2008 TTAB LEXIS 156 (T.T.A.B. 2008) (not precedential) (“The word ‘Cocaine’ is not objectionable because it is vulgar . . . inasmuch as it is a term that would be commonly used to refer to the drug. However, when used in combination with soft drinks and energy drinks, the term does not have a neutral meaning, as it might when used in a news story or medical reference.”).

85. *In re Hepperle*, 175 U.S.P.Q. 512 (T.T.A.B. 1972). See § VI[c] *infra*.

86. *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d 1653 (T.T.A.B. 1990). See § VI[a] *infra*.

87. *Ex parte Summit Brass & Bronze Works, Inc.*, 59 U.S.P.Q. 22 (Comm’r Pats. 1943).

88. *In re Red Bull GmbH*, 78 U.S.P.Q.2d 1375 (T.T.A.B. 2006) (“It is clearly the profane connotation of the term *per se*, rather than a particular meaning of the term when considered in connection with goods of this nature (handbags and personal accessories), that led the Board to conclude that the term would be perceived by a substantial majority of the public as profane and, thus, the term was scandalous.”), citing *In re Tinseltown*, 212 U.S.P.Q. 863.

89. *E.g.*, *Davis*, *supra* note 45, at 839 (“[T]he statutory language itself does not mandate consideration of the covered goods and services. Rather, it simply proscribes registration of any mark that ‘[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.’ In stark contrast, however, the content-based restrictions of Sections 2(d) and 2(e) each expressly require consideration of marks ‘when used on or in connection with the goods of the applicant’ in determining registrability.”) (footnote omitted).

bookend the word “deceptive,” a term that is meaningless unless measured against specific goods and services, much like the distinctiveness spectrum that is meaningless out of context.⁹⁰

Finally, considering the mark as it relates to its associated goods and services should not mean that offensive goods and services should cause the mark itself to be offensive.⁹¹ Though the MADONNA wine opinion was written in 1938, it can serve as a cautionary tale for those seeking to insert their own opinions about the goods and services. The CCPA majority opinion claimed to express no opinion on whether “wine in itself is harmless.”⁹² However, it also noted that wine had been barred under Prohibition and its sale was still subject to regulation.

Then, in what can only be described as a debate between a biblical scholar and an oenophile, the court went on:

It is true that the Bible records that the Savior changed water into wine at the behest of his Virgin Mother at the wedding feast, and quotations can be made from the Bible commending the use of wine; but it is also true that the evils growing out of the excessive use of intoxicating beverages are probably much greater today than they were 1900 years ago.⁹³

The dissent countered:

I cannot agree that wine is often drunk to excess, as, in my opinion, it is a matter of common knowledge that wine users are generally not drunkards and that habitués of barrooms are not generally wine drinkers. The excessive use of good food results in evil. Surely a glutton gives scandal comparable to the scandal caused by one who drinks alcoholic beverages to excess.

Wine seems to have been a concomitant of mankind as far back as books and tradition reach. It appears to have been what man has always considered the principal and finest product of the grape. The very nature of wine has placed it in a unique position as a beverage. It never has been and never can be classed with the harsh products of distillation which are made, not for the palate, but rather for powerful stimulating effect. Wine always has and probably always will grace boards of refinement and gentle conduct.⁹⁴

90. See 1 Gilson on Trademarks § 2.01[1].

91. Cf. *Ritchie*, 170 F.3d at 1102 (Newman, J., dissenting) (No one “has legal right, moral authority, social responsibility, or judgmental power, to intrude into commercial trademark rights based on moral disapproval of the trademark owner.”).

92. *In re Riverbank Canning*, 95 F.2d at 328.

93. *Id.* at 329.

94. *Id.* at 330 (Jackson, J., dissenting).

While amusing, this colloquy illustrates the result of bias against certain goods and services.

d. Substantial Composite of the General Public

The USPTO determines whether a mark is scandalous “from the standpoint of not necessarily a majority, but a substantial composite of the general public.”⁹⁵ The “substantial composite” test was adopted but neither justified nor explained by the CCPA in *In re McGinley*.⁹⁶ Indeed, the dissenting judge in *McGinley* stated: “I am at a loss to know what [a ‘substantial composite’] means or how one can have a ‘composite’ of a class such as ‘the general public.’”⁹⁷ A later opinion by the Federal Circuit was sympathetic to that notion but resigned to following the benchmark that had been laid out: “While we recognize the inherent difficulty in fashioning a single objective measure like a substantial composite of the general public from the myriad of subjective viewpoints we are duty bound to apply the standard set forth by our predecessor court.”⁹⁸ The USPTO “may not decide whether a registration is scandalous simply by asserting its own views and values. Instead, the Board has a duty to obtain the views of the affected public.”⁹⁹

It is difficult to know even where to begin gathering information about the feelings of a “substantial composite of the general public.”¹⁰⁰ Even if dictionaries and news articles label a mark as vulgar, that does not mean that a substantial composite of the general public has heard of or knows what a particular mark means.¹⁰¹ Where the mark is sufficiently vulgar—the words DICK

95. *In re McGinley*, 660 F.3d at 485.

The INTA Guidelines for Trademark Examination (2007), available at www.inta.org/Advocacy/Documents/INTAGuidelinesforTrademarkExamination.pdf, state that the test for registration of scandalous marks “should be whether a substantial body of the population would understand the mark applied for to consist of scandalous, immoral or offensive matter in relation to the respective goods or services. If the Examiner believes that the mark falls within the above definition, an objection should be raised and the burden of proof shifted to the applicant to provide satisfactory evidence to the contrary.”

96. *In re McGinley*, 660 F.2d at 485.

97. *Id.* at 487 (Rich, J., dissenting).

98. *In re Mavety Media*, 33 F.3d at 1371.

99. *Ritchie*, 170 F.3d at 1094. *See also In re Mavety Media*, 33 F.3d at 1371 (“[E]ven if the members of this panel personally find the mark BLACK TAIL disgustingly scandalous, the legal conclusion that a trademark comprises scandalous matter must derive from the perspective of the substantial composite. To be sure, appellate judges are a part of the composite of the general public, but they represent only a tiny fraction of the whole, which necessarily encompasses a wondrous diversity of thought.”).

100. *Cf. Schwender*, *supra* note 68, at 226 (“[J]udging society’s varying mores is beyond the scope of the United States Patent and Trademark Office.”).

101. *See In re Mavety Media*, 33 F.3d at 1373 (“Armed with only personal opinions and dictionary sources, the Board concluded that the mark BLACK TAIL ‘is an affront to a substantial composite of the general public.’”).

HEADS' combined with a recognizable representation of male genitalia, for example—the Board may simply find that “the graphic nature of the mark . . . establish[es] prima facie that the mark would be offensive to the conscience or moral feelings of a substantial composite of the general public.”¹⁰² There, the Board opined that “the amount of proof required to support the rejection depends upon the nature of the mark, with less evidence being required in those cases involving the more egregious marks.” In other words, “I know it when I see it.”

One applicant argued that its goods were popular with consumers and therefore not offensive to a substantial composite. The Board responded by saying that “some people may well buy applicant’s promotional items *because* of the scandalous nature of the mark, for ‘shock’ value, but this does not mean that the mark, in the context in which it is used, is not offensive to a substantial composite of the general public.”¹⁰³ That may be true, but it may also be true that the mark is not so offensive that people would not purchase the product. Here, the Board appears to be placing the burden improperly on the applicant to show that its trademark is not scandalous.

It would be more equitable and more accurate to limit the determination of whether a mark is scandalous to the point of view of the relevant or potential purchasers of the indicated goods or services. However, applicants who have made this argument have been unsuccessful. For example, the Board refused to look at the applicant’s marks CUMFIESTA and CUMGIRLS for online adult entertainment from the point of view of “Internet patrons of erotica” rather than the public in general; it then affirmed a refusal to register.¹⁰⁴ But it makes no sense to determine what the public in general thinks if it will never be exposed to the mark. And is it at all likely that those looking for Internet pornography would be shocked by those marks?

When courts and the Board determine whether there is a likelihood of confusion between marks, they look to the degree of care of actual or prospective purchasers of the goods, among other factors.¹⁰⁵ Similarly, the USPTO should look at the prospective purchasers of goods and services rather than the general public where the goods and services will not be marketed to the general public.¹⁰⁶ As First Amendment attorney Marc Randazza put it in

102. *In re Wilcher*, 40 U.S.P.Q.2d 1929.

103. *Id.*

104. *In re RK Netmedia, Inc.*, 2009 TTAB LEXIS 389 (T.T.A.B. 2009) (not precedential).

105. *See* 2 Gilson on Trademarks § 5.08.

106. Davis, *supra* note 45, at 815-16 (“If, as the *McGinley* Board found, an arguably impermissible mark may be exposed ‘to youngsters just learning to read, to teenagers, to senior citizens, to persons of strong moral and religious convictions, to members of the clergy, and to an uncountable number of other persons in the large and varied population of

his commentary on the CUMBRELLA decision, “[s]ince the mark is to be applied to condoms, one can only stare in bewilderment at the Examining Attorney’s determination that the condom-purchasing public would find reference to orgasms or ‘cum’ to be immoral or scandalous.”¹⁰⁷

e. Contemporary Attitudes

The case law emphasizes that determinations of scandalousness should be made according to contemporary attitudes and social mores.¹⁰⁸ The Board declared that it is “imperative that fullest consideration be given to the moral values and conduct which contemporary society has deemed to be appropriate and acceptable.”¹⁰⁹ For example, the prospect of registering MADONNA for wine would likely not produce the same revulsion today as it did in 1938.¹¹⁰ In fact, one prescient Board opinion from 1993 explicitly found cases involving scandalousness from 1938 to 1971 “to be of little precedential value in deciding the case now before us. . . . [W]hat was considered scandalous as a trademark or service mark twenty, thirty or fifty years ago may no longer be considered so, given the changes in societal attitudes. Marks once thought scandalous may now be thought merely humorous (or even quaint).”¹¹¹

Occasionally, the Board and the Federal Circuit espouse the sentiment that “we must be mindful of ever-changing social attitudes and sensitivities. Today’s scandal can be tomorrow’s

the United States,’ there can be little doubt as a practical matter as to the ultimate outcome of the inquiry.”) (citation omitted).

107. Marc Randazza, “Randazza Returns: His Thoughts on the TTAB’s ‘CUMBRELLA’ Section 2(a) Reversal,” at <http://thettablog.blogspot.com/2007/10/randazza-returns-his-thoughts-on-ttabs.html>, commenting on *In re Gray*, Ser. No. 78622783 (T.T.A.B. 2007) (not precedential) (reversing the refusal to register CUMBRELLA for condoms). See § VI[b][i] *infra*.

108. See, e.g., *Ritchie*, 170 F.3d at 1094 (“Whether a mark comprises immoral and scandalous matter is to be ascertained in the context of contemporary attitudes.”); *In re Old Glory Condom*, 26 U.S.P.Q.2d 1216 (“[I]n deciding whether a mark is scandalous under Section 2(a), we must consider that mark in the context of contemporary attitudes.”); *In re Madsen*, 180 U.S.P.Q. 335 (finding the mark WEEKEND SEX not scandalous as applied to magazines and noting that “consideration must be given to the moral values and conduct fashionable at the moment, rather than that of past decades”); TMEP § 1203.01 (“The meaning imparted by a mark must be determined in the context of the current attitudes of the day.”).

109. *In re Thomas Labs.*, 189 U.S.P.Q. 50.

110. *In re Riverbank Canning*, 95 F.2d 327 (affirming refusal of registration as scandalous). See also *In re McGinley*, 660 F.3d at 487 (Rich, J., dissenting) (“The majority appears to rely on the Riverbank (MADONNA for wine) case decided in 1938. . . . I think the decision is no longer of precedential value in view of the social changes in the ensuing 43 years.”).

See § VI[a] *infra*.

111. *In re Old Glory Condom*, 26 U.S.P.Q.2d 1216.

vogue. Proof abounds in nearly every quarter, with the news and entertainment media today vividly portraying degrees of violence and sexual activity that, while popular today, would have left the average audience of a generation ago aghast.”¹¹² However, they also lament the unfortunate state of society in which profanity is so prevalent, and declare that “the fact that profane words may be uttered more freely does not render them any the less profane.”¹¹³ This enables the Board to ignore contemporary attitudes if it so chooses.

A prior Board decision finding a mark scandalous does not require the same finding in a later case involving the same mark.¹¹⁴ Nevertheless, such a finding may contribute to the USPTO’s *prima facie* case against the mark in a later application. In 1981, the Board had found BULLSHIT scandalous for personal accessories.¹¹⁵ Twenty-five years later, a different applicant for the same mark for beverages and a variety of services argued that community standards had changed over that time and the mark was no longer considered offensive.¹¹⁶ The Board noted that it did need to look to current standards but, considering the prior opinion and various dictionary definitions, ultimately found that consumers would still consider the term to be vulgar.¹¹⁷

If a registered trademark is found to be scandalous and disparaging under Section 2(a), then it is void *ab initio*—that is, it never should have been registered. Even registrations that are incontestable under 15 U.S.C. § 1065 are not protected from a

112. *In re Mavety Media*, 33 F.3d at 1371.

113. *In re Tinseltown*, 212 U.S.P.Q. 863 (“We do not say that there has not been an increase in the amount of usage of profanities in our contemporary society and a diminution of the social inhibitions to such usage. No person blessed with the gift of hearing can fail to be cognizant of this much freer use of obscenities in contemporary America. Neither is it our function to moralize about this trend.”). *See also In re Boulevard Entertainment, Inc.*, 2002 TTAB LEXIS 345 (T.T.A.B. 2002) (not precedential) (“[T]he evidence of record is sufficient to establish *prima facie* that the term ‘jack-off’ is offensive to the conscience of a substantial composite of the general public, notwithstanding the fact that contemporary attitudes toward sex and sexual talk are more liberal than they were just a generation ago.”), *aff’d*, *In re Boulevard Entertainment*, 334 F.3d 1336; *In re Frankel*, 2002 TTAB LEXIS 250 (T.T.A.B. 2002) (not precedential) (“[W]e believe the evidence of record is sufficient to establish *prima facie* that the term ‘shithead’ or ‘shit head’ is offensive to the conscience of a substantial composite of the general public, notwithstanding the fact that contemporary attitudes toward coarse language are more liberal than they were just a generation ago.”); *In re Bad Frog Brewery*, 1999 TTAB LEXIS 86 (Simms, J., dissenting) (“[C]ontrary to the majority, I believe that even by today’s perhaps relaxed societal attitudes, applicant’s frog giving this obscene gesture would be offensive to many.”).

114. TMEP § 1203.01 (“The Trademark Trial and Appeal Board has held that an earlier decision is insufficient to warrant the same finding in a future case.”).

But see In re P.J. Valckenberg, GmbH, 122 U.S.P.Q. 334 (T.T.A.B. 1959) (refusing registration of MADONNA for wines and relying on earlier *Riverbank Canning* case).

115. *In re Tinseltown*, 212 U.S.P.Q. 863.

116. *In re Red Bull GmbH*, 78 U.S.P.Q.2d 1375.

117. For more on profanity as scandalous, *see* § VI[f] *infra*.

challenge that they are immoral or scandalous. If a mark is challenged after registration, the relevant date for determining whether it is perceived as scandalous or disparaging is the date of registration.¹¹⁸ In a cancellation hearing that takes place long after registration, this can be vitally important, as in the *Harjo REDSKINS* case. Evidence of current attitudes and usage is certainly easier to gather. Although such current evidence may be somewhat relevant to determining perceptions from years ago, evidence from the relevant time period is far more persuasive.¹¹⁹

f. Role of Applicant's Intention

An applicant's good intentions are generally not relevant to whether or not its mark is scandalous or immoral, just as they are not relevant to whether a mark owner has infringed on another's mark.¹²⁰ Where applicants have, for example, claimed that they want to use vulgar marks to satirize social conventions, the Board has found that intention irrelevant. An applicant for the mark BULLSHIT stated that it intended to use the mark in a repetitive pattern on various accessories much like higher end accessories use repeating patterns of GUCCI or HERMES marks.¹²¹ The Board found "the intention of applicant in marketing accessories under the mark . . . wholly irrelevant to the issue before us." Similarly, another applicant sought to mock the social standing of shirts bearing prestigious emblems by using a defecating dog as a shirt emblem, and the Board rejected that argument as well, citing the BULLSHIT case.¹²² And when the Red Sox opposed registration of the mark SEX ROD, the Board noted the applicant's assertion that he meant it to be a humorous parody but found that "nothing in the parody itself which changes or detracts from the vulgar meaning inherent in the term. In other words, the parody, to the extent there is one, is itself vulgar."¹²³

118. See *Harjo v. Pro Football, Inc.*, 30 U.S.P.Q.2d 1828 (T.T.A.B. 1994) ("[T]he critical dates in this case . . . are the issue dates of respondent's registrations. That is, the case will be determined by deciding whether, at the time these registrations issued, the various marks were scandalous and/or disparaging.").

119. See *Harjo v. Pro Football, Inc.*, 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999), *rev'd*, 284 F. Supp. 2d 96, 68 U.S.P.Q.2d 1225 (D.D.C. 2003), *remanded*, 415 F.3d 44, 75 U.S.P.Q.2d 1525 (D.C. Cir. 2005).

120. See 2 Gilson on Trademarks § 5.09[1][d].

121. *In re Tinseltown*, 212 U.S.P.Q. 863. See § VI[f][iv] *infra*.

122. *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d 1635 (T.T.A.B. 1988) ("[I]n *In re Tinseltown* . . . this Board rejected a similar argument that because the motivation for marketing 'BULLSHIT' accessories was to satirize the use of designers' names on products, the clientele for that applicant's goods would not regard the mark as immoral or scandalous.").

123. *Boston Red Sox Baseball Club Ltd. Partnership v. Sherman*, 88 U.S.P.Q.2d 1581 (T.T.A.B. 2008). See § VI[b][i] *infra*.

Still, good intentions are not *always* irrelevant. In some rather surprising cases, the Board has taken the applicant's good intentions into account. In one case in particular, the Board relied heavily on the fact that the applicant did not intend to cause offense. The applicant sold condoms in a package marked with an American flag shaped like a condom, along with the word mark OLD GLORY CONDOM.¹²⁴ The Board noted that the applicant "emphasizes that its mark is expressly designed not to offend but to redefine patriotism to include the fight against sexually-transmitted diseases, including AIDS." It concluded that the applicant's "seriousness of purpose," apparent from statements on the packaging, was "a factor to be taken into account in assessing whether the mark is offensive or shocking." In another case, the Board found, incredibly, that specimens containing a bird "serve to buttress the applicant's contention that the mark [BIG PECKER BRAND] is not intended to refer to male genitalia but, rather, refers to the more common meaning of a bird's beak."¹²⁵

And in the high point of reliance on good intentions, the Board reversed a refusal to register BADASS for bridges on stringed instruments, accepting the applicant's claim that the mark stood for Bettencourt Acoustically Designed Audio Sound Systems.¹²⁶ In fact, the Board scolded those who might see only naughtiness in this trademark: "One of a certain cast of mind may perhaps see evil wherever the eye may light or in whatever may fall on the ear." The Board even brought up the fact that applicant's pronunciation of the mark was "wholly innocent" (buh-DASS, perhaps?) as support for its own "unwilling[ness] to assign base motives" to the applicant. It also noted that the mark was connected to "a part of an instrument which has charms to soothe the savage beast." The Board's lofty conclusion, probably with a wink: "Seen as applicant presents it and heard as applicant would have it, 'BADASS' gives no offense to morality nor raises scandal; the peace of the commonwealth is not threatened."

g. Evidence of Scandalousness

The USPTO bears the burden of proving that a trademark consists of or comprises scandalous or immoral matter.¹²⁷ Examining attorneys need to muster evidence to bring to light the contemporary attitude of a substantial composite of the American public in reference to a particular mark and applicants may submit evidence in response. In order to bolster the reasons for a refusal, an examining attorney may present a one-sided view of

124. *In re Old Glory Condom*, 26 U.S.P.Q.2d 1216. See § VI[e] *infra*.

125. *In re Hershey*, 6 U.S.P.Q.2d 1470 (T.T.A.B. 1988). See § VI[f][iii] *infra*.

126. *In re Leo Quan Inc.*, 200 U.S.P.Q. 370 (T.T.A.B. 1978). See § VI[f][iii] *infra*.

127. *In re Mavety Media*, 33 F.3d at 1371.

the evidence as an advocate. If the applicant is not careful and thorough, it will be at a definite disadvantage in a Section 2(a) proceeding.

Although it bears the burden, the USPTO is limited in the evidence it is able to gather. It does not conduct consumer surveys, call expert witnesses or collect affidavits from members of the public. The Trademark Manual of Examining Procedure states that an examining attorney may provide dictionary definitions of the mark and newspaper and magazine articles making reference to it to show scandalousness.¹²⁸ However, other types of evidence have been considered in Section 2(a) proceedings, as the following sections indicate.

i. Dictionaries

The USPTO relies heavily upon dictionary evidence in determining whether terms are scandalous according to a substantial composite of contemporary purchasers.¹²⁹ The Federal Circuit stated in a scandalous mark case that “dictionary definitions represent an effort to distill the collective understanding of the community with respect to language and thus clearly constitute more than a reflection of the individual views of either the examining attorney or the dictionary editors.”¹³⁰

If all dictionaries consulted by the examining attorney agree that a mark is vulgar, according to the USPTO, those dictionary definitions alone *may* be enough to demonstrate that the mark is scandalous.¹³¹ However, even if all dictionary definitions state that the term is vulgar, where the applicant’s use of the word does not necessarily utilize its vulgar meaning, it might not be scandalous.¹³² Where dictionary definitions do not plainly show the

128. TMEP § 1203.01.

129. Courts and the Board often look to dictionary definitions where distinctiveness of a mark is at issue. *See* 1 Gilson on Trademarks § 2.05[3].

130. *In re Boulevard Entertainment*, 334 F.3d at 1340.

131. *E.g., id.* at 1340-41 (“[I]n a case in which the evidence shows that the mark has only one pertinent meaning, dictionary evidence alone can be sufficient to satisfy the PTO’s burden.”) (where dictionary definitions uniformly characterized “jack-off” as offensive or vulgar, court upheld refusal to register 1-800-JACK-OFF and JACK-OFF for “entertainment in the nature of adult-oriented conversations by telephone”); *In re Greenfield Records, LLC*, Ser. No. 77514177 (T.T.A.B. 2010) (not precedential) (affirming refusal to register design mark featuring the word AUDIOTURD based on dictionary definitions of the word “turd” that were designated either “vulgar,” “vulgar slang,” “a highly offensive term,” “taboo” or “sometimes vulgar”); *In re Mexico 69 SRL*, 2006 TTAB LEXIS 358 (T.T.A.B. 2006) (not precedential) (“All of the Spanish dictionary definitions of record for the entire phrase DE PUTA MADRE indicate that it is ‘rude,’ ‘offensive’ or ‘vulgar.’”).

132. TMEP § 1203.01 (“Dictionary definitions alone may be sufficient to establish that a proposed mark comprises scandalous matter, where multiple dictionaries, including at least one standard dictionary, all indicate that a word is vulgar, and the applicant’s use of the word is limited to the vulgar meaning of the word.”).

mark to be vulgar, the USPTO states that its examining attorneys should resolve the doubt in favor of publishing the mark for opposition.¹³³ In one case where the term “rod” had several nonvulgar dictionary meanings along with the vulgar meaning of “penis,” the Board refused registration, finding none of the nonvulgar meanings relevant as the applicant’s mark was SEX ROD; “The significance of ‘rod’ when preceded by the word ‘sex’ denotes only one meaning.”¹³⁴

Whether or not dictionary definitions are consistent, the USPTO looks at how the applicant uses or proposes to use its mark. In one case, the Federal Circuit reversed the Board where it had affirmed a refusal to register the mark BLACK TAIL based only on dictionary definitions of the word “tail.”¹³⁵ The dictionaries had included not only the vulgar definition that the Board had relied on but also nonvulgar definitions. In that case, the Court found that the nonvulgar definitions (such as rear end) were “equally applicable to define ‘tail’ in the context of an adult entertainment magazine.”

Dictionary editors’ labels of “vulgar,” “usually vulgar,” “vulgar slang,” “taboo term,” “obscene,” “offensive” or “rude” suggest that people may be offended by seeing the defined word in connection with goods or services. However, a term’s appearance in a dictionary does not show how many people in fact have heard of the term, and the test for scandalousness is not whether, *if people had heard of the mark*, they would find it offensive. Further, the Board has relied on alternative nonvulgar meanings in allowing registration. Beyond observing these different definitions and bringing to bear examiners’ personal reactions to the marks, there is no way for the USPTO to ascertain which definition will resonate with the public.

The Federal Circuit has correctly bemoaned the “inherent fallibility in defining the substantial composite of the general

133. *E.g.*, *In re Big Effin Garage, LLC*, 2010 TTAB LEXIS 418 (T.T.A.B. 2010) (not precedential) (“[W]hile the evidence of record supports a finding that ‘effin’ and ‘fn are used as substitutes for the offensive term ‘fucking,’ such evidence also indicates that these derivative terms are utilized as a substitute therefor precisely because they are less offensive, and may be used in conversation, on television, and on Internet message boards.”); *In re Watkins*, 2005 TTAB LEXIS 66 (T.T.A.B. 2005) (not precedential) (some definitions showed the mark was vulgar, others did not) (“To the extent that there is doubt as to the immoral or scandalous nature of applicant’s mark, that doubt must be resolved in favor of publication of the mark.”); *In re Friggin Barnyard*, 1999 TTAB LEXIS 108 (T.T.A.B. 1999) (not precedential) (finding definitions of FRIGGIN “in which it is invariably considered to be vulgar as well as definitions in which it is usually regarded to be inoffensive”; ordering the mark to be passed for publication).

See § VIII[e] *infra*.

134. *Boston Red Sox Baseball Club*, 88 U.S.P.Q.2d 1581.

135. *In re Mavety Media*, 33 F.3d at 1373 (“Armed with only personal opinions and dictionary sources, the Board concluded that the mark BLACK TAIL ‘is an affront to a substantial composite of the general public.’”). *See* § VI[b][iii] *infra*.

public based solely on dictionary references. While a standard dictionary may indicate how the substantial composite of the general public defines a particular word, the accompanying editorial label of vulgar usage is an arguably less accurate reflection of whether the substantial composite considers the word scandalous. Such labels are subject not only to differences in opinion among the respective publication staffs of particular dictionaries, but also to the potential anachronism of those opinions.”¹³⁶ As Samuel Johnson wrote in 1755 in the preface to his *Dictionary of the English Language*: “[N]o dictionary of a living tongue ever can be perfect, since while it is hastening to publication, some words are budding, and some falling away.”¹³⁷

ii. Articles

News articles that characterize the term as “offensive, obscene, coarse, taboo, vulgar, vulgarity or crass,” for instance, suggest that the mark is seen as offensive by the general public.¹³⁸ However, articles that simply use the term without characterizing it do not suggest such a conclusion. For example, in an opinion rejecting registration of the mark A-HOLE PATROL, the Board noted excerpts from Internet articles that the examining attorney had placed into evidence, including the following:

The Subtext seemed to be that difficulty in fiction is the tool of socially privileged readers and writers who turn up their noses at the natural pleasure of a “good read” in favor of the invidious, artificial pleasure of feeling superior to other people. To Mrs. M—, I was a “pompous snob, and a real **ass-hole**.”¹³⁹

This excerpt does not use the term as it appears in the mark, nor does it convey a particular feeling about the highlighted term. It is therefore not evidence of the mark’s scandalousness.

It is unclear whether the existence of a term in news articles, from the Internet or in print, will in fact demonstrate the feelings of a substantial composite of the American people towards that term. For example, as the Board denied registration to the mark THE COMPLETE A**HOLE’S GUIDE TO . . . , it dismissed the applicant’s evidence as to the non-scandalous nature of the term A**HOLE:

It is common knowledge that all types of material appears on the Internet, some of it scandalous in nature. Thus, the mere

136. *In re Mavety Media*, 33 F.3d at 1373.

137. See 6 Gilson on Trademarks Appendix 10, “Dictionaries and Other Lexical Sources.”

138. See, e.g., *In re Shearer*, 2009 TTAB LEXIS 374 (T.T.A.B. 2009) (not precedential).

139. *In re Jibjab Media, Inc.*, 2009 TTAB LEXIS 67 (T.T.A.B. 2009) (not precedential) (bold in original).

appearance of the term “a**hole” on the Internet says nothing about how the public would regard the term. There is no evidence in this record that the term “a**hole” has appeared in general interest publications that are widely distributed to the public.¹⁴⁰

This appropriately skeptical attitude is supported by some of the examining attorney’s evidence in the case, which suffers from the same deficiency as that in the case described in the prior paragraph. For example, the examining attorney put the following into evidence:

An article from Salon.com bears the headline—“Trump revelation. I am an a**hole.” The article continues with: “Setting fire to a series of \$ 100 bills last week for the benefit of a largely indifferent gathering of reporters, real estate mogul Donald Trump suddenly announced that he is a big asshole.”

This excerpt tells the reader little about the offensiveness of the word at issue, except perhaps suggesting that the word “a**hole” is a less offensive alternative for “asshole.”

Some Board opinions have found that the appearance of a term without negative comment shows that the term is not in fact scandalous. One Board opinion noted that because the examining attorney’s article excerpts were from family newspapers, the appearance of the mark therein suggests that it is “not likely to be presently viewed as vulgar, highly indecent or otherwise offensive.”¹⁴¹ Another opinion similarly characterized the examining attorney’s evidence when finding in favor of the applicant, evidence that showed that “numerous major newspapers, magazines and television stations have often shown humans giving the finger to particular individuals and groups. If said gesture were truly scandalous, immoral or obscene . . . , we seriously doubt that these major newspapers, magazines and television stations would feature this gesture with no attempt to cover it up.”¹⁴²

One examining attorney argued to the Board that little evidence about the term at issue appeared in news stories because “vulgar terms are not likely to make it past the editors of the journals and then into the database.”¹⁴³ Instead of taking this

140. *In re Zaharoni*, 2005 TTAB LEXIS 3 (T.T.A.B. 2005) (not precedential).

141. *In re Friggin Barnyard*, 1999 TTAB LEXIS 108.

142. *In re Bad Frog Brewery*, 1999 TTAB LEXIS 86. *But see id.* (Simms, J., dissenting) (“To me, this gesture has not somehow become acceptable because it may have appeared, rarely, in newspapers, magazines or perhaps on television broadcasts. On the fairly rare occasions when this obscene gesture may have appeared, it most assuredly was in connection with newsworthy events. . . . The appearance of this gesture on such rare occasions is certainly not very probative of its lack of offensiveness.”).

143. *In re Friggin Barnyard*, 1999 TTAB LEXIS 108.

claim seriously, the Board chastised the examining attorney for using an “exceedingly restrictive search request.” However, the examining attorney had made an insightful observation about the limitations of determining public attitude about a word from searching a database.

If the mark is already in use, the examining attorney may put in evidence of actual public reaction to the mark as used. An applicant for the following mark for soft drinks and energy drinks was faced with news articles highly critical of its products.¹⁴⁴



One article described a warning letter to the applicant from the Food and Drug Administration claiming that the company was illegally marketing the drink as a street drug alternative. Another described lawmakers’ call for a boycott of the drink. A third stated that many U.S. stores were refusing to stock it. The Board upheld the refusal to register on the ground that the mark was scandalous.¹⁴⁵

iii. Specimens and Marketing

The specimen of use saved one mark from the registration dustbin: BIG PECKER BRAND was accompanied in its specimen by a bird with a large beak, thus the Board found it to have an alternative, nonvulgar meaning.¹⁴⁶ The mark was registered in spite of the fact that the bird was not part of the mark itself and that the advertising of the mark could change at any time.

Other marks have not fared as well when the Board took into account their advertising. In determining, as discussed above, whether COCAINE was scandalous for energy drinks, the Board noted that “applicant’s website ‘suggests that the carbonated beverage should be mixed with alcohol—offering recipes for cocktails with names like Liquid Cocaine, Cocaine Smash, Cocaine Blast and Cocaine Snort.’”¹⁴⁷ There, the Board also noted the applicant’s marketing, stating that he had promoted the product as “Speed in A Can,” “Liquid Cocaine” and “Cocaine—Instant

144. *In re Kirby*, 2008 TTAB LEXIS 156.

145. *See* § VI[c] *infra*.

146. *In re Hershey*, 6 U.S.P.Q.2d 1470.

147. *In re Kirby*, 2008 TTAB LEXIS 156.

Rush.” It concluded: “Because the product is an inexpensive ‘highly caffeinated soft drink’ that can be purchased by teens and children and is advertised in a manner so as to suggest an illegal drug-like effect, it has a scandalous meaning when used in association with these goods.”

In one case, the Board improperly took into account the efforts of a third party, not the applicant, who marketed t-shirts under the name WIFEBEATER, in deciding whether to affirm a refusal to register WB WIFE BEATER for t-shirts.¹⁴⁸ The examining attorney submitted a copy of this third party’s web site, which displayed a man spanking a woman and offered a free t-shirt to convicted wife beaters. This evidence contributed to the Board finding the term offensive. The majority of the panel was corrected by the dissent: “The fact that a third party’s marketing efforts may have crossed the line of acceptability, and have drawn fire from Dads and Daughters and other organizations, goes not to whether WIFE BEATER per se is a scandalous term for t-shirts, but whether a third party is using the term in a scandalous manner.”

iv. Internet Forums and Blogs

The Board has noted the contents of blogs and comments from online forums in determining whether a mark is scandalous to a substantial composite of the public. In determining that the word “cum” is vulgar in the marks CUMFIESTA and CUMGIRLS, the Board relied on the examining attorney’s evidence from parentsconnect.com, dearcupid.org, worldtv.com, antimoon.com and stupidquestions.com, as well as other sites.¹⁴⁹ It was not persuaded by the applicant’s evidence of blog posts and online advice columns using the term.¹⁵⁰ In finding PUSSY for energy drinks scandalous, the Board listed user comments on a post on typepad.com on the movie *Austin Powers International Man of Mystery* and concluded that the “evidence shows a visceral repulsion to the term PUSSY and a clear sense that it is highly offensive to these women, in particular.”¹⁵¹ The examining attorney in the case in which the Board denied registration to WB WIFE BEATER for t-shirts provided as evidence “entries from an online discussion entitled ‘Wife Beater v. Tank Top’ on the list

148. *In re Love Bottling*, 2005 TTAB LEXIS 261. See § VI[d] *infra*.

149. *In re RK Netmedia*, 2009 TTAB LEXIS 389 (“In many of the online forums and blogs, participants characterized the word ‘cum’ as vulgar.”).

150. Compare *In re Gray*, Ser. No. 78622783 (“While the Examining Attorney has shown that the term ‘cum’ has been used in connection with sexually graphic activities, he has not established that the term itself is vulgar or offensive.”).

151. *In re Shearer*, 2009 TTAB LEXIS 374.

forum ‘The Wordwizard Clubhouse’ . . . regarding the origin of the word wifebeater used in connection with t-shirts.”¹⁵²

Of all the different types of evidence on scandalousness, this may be the most revealing of the views of real people. Unlike dictionary entries or newspaper articles, comments from the Internet represent views directly expressed by members of the general public.

Nevertheless, this type of evidence is far too easy to cherry-pick in order to prove whatever point one would like to prove. An examining attorney attempting to demonstrate a prima facie case can probably find some comments on an online forum or the musings of an opinionated blogger to support its claim that people find a term or trademark to be offensive. Overall, evidence from Internet forums and blogs is highly questionable.

v. Survey Evidence and Witnesses, Including Experts

In the highly contentious and long-running *Harjo* case in which cancellation petitioners argued that the mark REDSKINS for a football team was scandalous and disparaging, each party submitted voluminous evidence, likely a high water mark for the amount of expert witness testimony and surveys entered into evidence before the Board.¹⁵³ The parties submitted the testimony of a battery of expert linguists, and one party submitted survey evidence conducted with Native Americans and non-Native Americans while the other provided an expert witness to critique it. Just as in any other case, the Board will take into account expert testimony on factual matters but not on the ultimate issues before the Board.¹⁵⁴ In *Harjo*, the Board emphasized that witnesses’ opinions on whether a mark is scandalous “are not determinative,” and declared that it will not adopt the opinions even of experts “on the ultimate questions of scandalousness or disparagement.”¹⁵⁵

vi. Third-Party Registrations

The USPTO compounds the unavoidable inconsistency of determining whether a mark is scandalous or immoral by its continued refusal to entertain evidence of third party registrations for similar marks as precedent. In *RK Netmedia*, for example, the

152. *In re Love Bottling*, 2005 TTAB LEXIS 261.

153. *Harjo*, 50 U.S.P.Q.2d 1705, *rev'd*, 284 F. Supp. 2d 96, 68 U.S.P.Q.2d 1225 (D.D.C. 2003), *remanded*, 415 F.3d 44, 75 U.S.P.Q.2d 1525 (D.C. Cir. 2005).

154. *See* 3 Gilson on Trademarks § 9.02[5][d][vi].

155. *Harjo*, 50 U.S.P.Q.2d 1705, *rev'd*, 284 F. Supp. 2d 96, 68 U.S.P.Q.2d 1225 (D.D.C. 2003), *remanded*, 415 F.3d 44, 75 U.S.P.Q.2d 1525 (D.C. Cir. 2005).

applicant sought to register CUMFIESTA and CUMGIRLS for an adult entertainment website.¹⁵⁶ It introduced evidence of a current registration for CUM TOGETHER for “prerecorded DVDs, video CDs and VHS featuring adult content”¹⁵⁷ and CUMBRELLA for condoms, for which a notice of allowance had issued.¹⁵⁸ The Board sang its familiar refrain:

It is well settled that the Board must decide each application on its own merits, and decisions regarding other registrations do not bind either examining attorneys or this Board. The fact that, whether because of administrative error or otherwise, some marks have been registered even though they may be in violation of the governing statutory standard does not mean that the U.S. Patent and Trademark office must forgo applying that standard in all other cases.¹⁵⁹

Even if the other marks were distinguishable, it would be much more helpful if the USPTO explicitly distinguished them. Without third-party registrations having some force, trademark owners will largely have to guess about whether their potentially scandalous mark can register.

vii. Other Evidence

In attempting to register BULLSHIT, an applicant submitted evidence of a book written by a professor of philosophy at Princeton University entitled “On Bullshit” and of the existence of a television show called “Penn & Teller: Bullshit!”¹⁶⁰ The Board was not persuaded that these examples could overcome the prima facie case of dictionary definitions categorizing the word as vulgar, and noted that the applicant had provided no evidence of “the extent of exposure of the American public to either the Penn and Teller program or the Professor Frankfurt essay.”

Another applicant submitted evidence that the vulgarity in its mark had been used in old-time vaudeville shows and was not censored from the television shows “Arrested Development,” “South Park” and “Drawn Together.”¹⁶¹ The Board was not persuaded: “We reject the proposition that any word which has not been censored or otherwise sanctioned when used in artistic expression or entertainment must be regarded as not scandalous.

156. *In re* RK Netmedia, 2009 TTAB LEXIS 389.

157. Reg. No. 2844606. The registration was cancelled on December 31, 2010 for the registrant’s failure to file a statement of use.

158. *See In re* Gray, Ser. No. 78622783. This application was abandoned on March 28, 2011.

159. *In re* RK Netmedia, 2009 TTAB LEXIS 389 (citations omitted).

160. *In re* Red Bull GmbH, 78 U.S.P.Q.2d 1375.

161. *In re* Shearer, 2009 TTAB LEXIS 374.

While the boundaries of what is scandalous under Section 2(a) may be difficult to define, we reject the notion that those boundaries are coextensive with the boundaries of permissible, that is, uncensored, artistic expression. Neither vaudeville nor South Park provide a useful guide for applying Section 2(a).¹⁶²

V. STANDING TO CHALLENGE MARKS AS SCANDALOUS AND IMMORAL

The Board has acknowledged the “somewhat vague” and “highly subjective” standard inherent in Section 2(a).¹⁶³ Thus, it has promised “to resolve doubts on the issue of whether a mark is scandalous or disparaging in favor of applicant and pass the mark for publication with the knowledge that if a group does find the mark to be scandalous or disparaging, an opposition proceeding can be brought and a more complete record can be established.”¹⁶⁴

Article III standing requirements do not apply to proceedings before administrative agencies such as the USPTO.¹⁶⁵ The administrative agency instead looks to the statute that confers standing before it. Section 13 of the Lanham Act provides, in part, that any person who believes that he or she would be damaged by the registration of a mark upon the principal register may file an opposition to that application in the Patent and Trademark Office.¹⁶⁶ The Federal Circuit and its predecessor court have also required that an opposer have a “real interest” in the proceedings and a “reasonable” basis for its belief of damage.¹⁶⁷ The “real interest” must be “a direct and personal stake in the outcome of the opposition,” and need not be an interest in the proceeding “beyond that of the general public.”¹⁶⁸ The Federal Circuit has stated: “The crux of the matter is not how many others share one’s belief that one will be damaged by the registration, but whether that belief is reasonable and reflects a real interest in the issue.”¹⁶⁹

162. See also *In re Frankel*, 2002 TTAB LEXIS 250 (“Applicant maintains that the fact that the term “shit head” or “shithead” appears in the magazine and newspaper excerpts submitted by the Examining Attorney is evidence that the term is not scandalous. A close examination of the story excerpts reveals that most, if not all, of the stories are in the nature of social commentary or art or film reviews. In other words, these stories do not evidence use of the term “shithead” or “shit head” in ordinary discourse.”).

163. *In re Hershey*, 6 U.S.P.Q.2d 1470.

164. *In re In Over Our Heads*, 16 U.S.P.Q.2d 1653. See § VIII[e] *infra*.

165. *Ritchie*, 170 F.3d at 1094 (citing cases).

166. 15 U.S.C. § 1063. See 3 Gilson on Trademarks § 9.03[1] for more on standing before the Trademark Trial and Appeal Board.

167. *Ritchie*, 170 F.3d at 1095.

168. *Id.* at 1095, 1096 (“[T]he fact that particular interests are shared by the many rather than the few does not make them less deserving of legal protection through the judicial process.”), citing *Sierra Club v. Morton*, 405 U.S. 727, 734 (1972).

169. *Id.* at 1097.

The Federal Circuit has recognized two distinct ways of showing a reasonable belief of damage for purposes of standing. First, the opposer may allege that he “possesses a trait or characteristic that is clearly and directly implicated in the proposed mark.” Second, the opposer may allege “that others also share the same belief of harm from the proposed trademark” and that “the belief is not simply the opposer’s subjective view.” For this second type of standing, the opposer may present surveys, petitions, or affidavits from public interest groups representing those who allegedly share the belief.

There is no provision for a class action before the Board, but those who have objected to marks on the basis of their perceived scandalousness and immorality have been seen as speaking on behalf of an affected group. Further, it is clear that those opposing on grounds of scandalousness and immorality need not be competitors of the applicant nor have any commercial stake in the matter.¹⁷⁰ In fact, the Board has found it questionable that corporate entities “are persons possessing the emotional characteristics requisite to being or feeling offended by that which may be considered scandalous.”¹⁷¹

When an opposer demonstrates standing for any reason, such as a claim of likely confusion, it may also rely on any other statutory ground that might deny registration and “may invoke the general public interests in support of its claim.”¹⁷² Therefore, a competitor claiming likelihood of confusion may also rely on Section 2(a)’s scandalous and immoral ground to bar registration of another’s mark. For example, the Board found that Greyhound Corporation had standing to challenge a mark consisting of a defecating dog on the basis of scandalousness based on its own ownership of a mark consisting of a running dog because it had already established standing based on its allegation of likely confusion.¹⁷³

The Federal Circuit surprisingly laid down a broad standard for standing in the stunning *Ritchie v. Simpson* case in 1999.¹⁷⁴

170. *Bromberg v. Carmel Self Service, Inc.*, 198 U.S.P.Q. 176 (T.T.A.B. 1978) (holding that “the fact that opposers have not based their claim of damage on their involvement in a commercial activity is not fatal to the question of standing”).

171. *Id.* In *Schlage Lock Company v. Staiano*, 2005 TTAB LEXIS 543 (T.T.A.B. 2005) (not precedential), the corporate opposer owned the mark KRYPTONITE and opposed an application for a mark with a leaf design and the word mark KRYPTOKING. The opposer claimed likelihood of confusion with its own mark and also argued that the mark in the application was an immoral and scandalous drug reference, with the leaf and part of the mark being TOKING. The Board found that opposer did not meet its evidentiary burden. See § VI[c] *infra* for more on drug references as scandalous.

172. *Greyhound Corp.*, 6 U.S.P.Q.2d 1635.

173. *Id.* See also *Boston Red Sox Baseball Club*, 88 U.S.P.Q.2d 1581; *Schlage Lock Company*, 2005 TTAB LEXIS 453.

174. *Ritchie*, 170 F.3d 1092.

William Ritchie appeared *pro se* to oppose O.J. Simpson's applications for O.J. SIMPSON, O.J. and THE JUICE in connection with various goods. He argued that he would be damaged by the registrations because the marks were allegedly synonymous with wife beater and wife murderer, and thus the marks disparaged his values as a "family man." He also argued that the marks were scandalous because they "attempt to justify physical violence against women."¹⁷⁵ There, the Federal Circuit ruled that Ritchie did indeed have standing, and that the Board "may not decide whether a registration is scandalous simply by asserting its own views and values. Instead, the Board has a duty to obtain the views of the affected public."

A male petitioner opposed registration of DYKES ON BIKES for organizing parades, festivals, seminars and rallies to support female motorcyclists and foster "pride in a wide variety of sexual orientations and identities, namely lesbian, bisexual and transgender." The opposer stated that the mark was scandalous and disparaging to men, but the Board held that he was not a member of the potentially disparaged group.¹⁷⁶ Because he was not, he was required to show that others shared his belief in harm from the mark's registration, which he failed to do. Applying *Ritchie*, the Board found that the opposer had a "real interest" but did not show his belief in damage was reasonable. It declared in dicta that lesbians could have established standing in the case because they have "a trait or characteristic that is inherently implicated" by the mark. The Federal Circuit, in its unpublished opinion affirming the Board's decision, agreed that the opposer's papers contained "no allegations that his belief [in damage] is shared by others and no reference to supporting evidence demonstrating such a shared belief."¹⁷⁷

Even before the *Ritchie* case, the Board had interpreted standing to include broad categories, as long as the opposers could show damage. In 1978, the Board found that two women had standing on behalf of women to challenge an application for ONLY A BREAST IN THE MOUTH IS BETTER THAN A LEG IN THE HAND for restaurant services.¹⁷⁸ The opposers argued that the mark was immoral, scandalous and disparaging to women, as well

175. *Id.* at 1097.

176. *McDermott*, 81 U.S.P.Q.2d 1212 (T.T.A.B. 2006), *aff'd*, 240 Fed. Appx. 865 (Fed. Cir. 2007) (unpublished).

177. *McDermott v. San Francisco Women's Motorcycle Contingent*, 240 Fed. Appx. 865 (Fed. Cir. 2007) (unpublished), *cert. denied*, 552 U.S. 1109 (2008).

178. *Bromberg*, 198 U.S.P.Q. 176. The fate of the mark after this opinion is unclear. Two years after standing was granted, the opposition was dismissed with prejudice. See <http://ttabvue.uspto.gov/ttabvue/v?pno=91059979&pty=OPP>. However, no information about the mark appears in the USPTO's Trademark Electronic Search System (TESS) for Serial No. 73087118.

as being “lewd, lascivious, indecent, obscene, worthless, depraved, chauvinistic, degrading, and [lacking] commercial value.” They also filed affidavits from women’s organizations supporting their claims. The Board found that the opposers had the requisite standing to be heard. In the *Harjo* case, the Board found that petitioners, as Native Americans, had standing to assert that the mark REDSKINS offended them and other Native Americans.¹⁷⁹

VI. CATEGORIES

A wide variety of trademarks have been implicated by the ban on registering scandalous and immoral marks, from religious and political imagery to sexual matter, profanity and illegality.¹⁸⁰

a. Religion and Ethnicity

Most of the early scandalousness rejections were for trademarks with religious themes. Before the Lanham Act became law in 1946, an earlier federal statutory provision barred registration of scandalous marks.

Under that provision, the CCPA affirmed a refusal to register MADONNA as a trademark for wine.¹⁸¹ In the *Riverbank Canning* case, the court found that the mark would be “shocking to the sense of propriety of nearly all who do not use wine as a beverage, and also to many who do so use it.”¹⁸² In that same year, 1938, the Commissioner of Patents affirmed a refusal of registration of a *copyright* for a label for edible oil that included “a representation of the Christ child in the arms of St. Joseph.”¹⁸³ After quoting *Riverbank Canning*, the Commissioner questioned “the propriety of commercializing the name of the Savior.” He went on to declare: “I am clearly of the opinion that even in the absence of statutory authority registration may properly be refused either of trade marks or labels involving matter which is manifestly scandalous, immoral, sacrilegious, or otherwise offensive to the public. That applicant’s label would be so regarded by numerous individuals I have no doubt.” And in 1943, the Commissioner of Patents

179. *Harjo*, 30 U.S.P.Q.2d 1828.

180. See Davis, *supra* note 45, at 803 (“[F]ew other bodies of federal law can lay claim to the sheer scope of the subject matter encompassed by Section 2(a) jurisprudence, a subject matter ranging from the Virgin Mary to the Reverend Sun Myung Moon, from tabernacle safes to condoms, and from World War I soldiers to penis size-increasing devices.”).

181. *In re Riverbank Canning*, 95 F.2d 327, *aff’g Ex parte Riverbank Canning Co.*, 30 U.S.P.Q. 374 (Comm’r Pats. 1936) (“I think the use of ‘Madonna,’ in connection with the particular goods here involved might very properly give offense to the conscience and moral feelings of a considerable portion of the public; and I am therefore constrained to agree with the examiner that applicant’s mark is ‘scandalous’ within [the] meaning of the statute.”).

182. *Id.* at 329. In 1959, the Board again refused registration of MADONNA for wines, relying on *Riverbank Canning*. *In re P.J. Valckenberg*, 122 U.S.P.Q. 334.

183. *Ex parte F. & M. Importing Co.*, 39 U.S.P.Q. 451 (Comm’r Pats. 1938).

affirmed the refusal to register the trademark AGNUS DEI, meaning Lamb of God, and a visual representation, for metallic tabernacle safes.¹⁸⁴ Citing *Riverbank Canning*, the Commissioner reasoned: “To commercialize an emblem of such highly sacred religious significance would, I think, be offensive to most individuals of the Christian faith, and thus scandalous within the meaning of the statute.”¹⁸⁵

The Board declared in 2010 in *In re Lebanese Arak* that the appropriate ground for refusing marks that would offend the members of a religious or ethnic group is that the mark is disparaging to them, rather than that it is scandalous.¹⁸⁶ The provision barring the registration of disparaging trademarks was not yet in the Lanham Act when the MADONNA, AGNUS DEI and Christ child cases were decided. The test for scandalousness depends on the meaning of the mark to the general public, while the test for disparagement focuses on the effect on the allegedly disparaged group, and the Board has reasoned that “the proper focus, when religious beliefs or tenets are involved, is on the group of persons that adhere to those beliefs or tenets.”¹⁸⁷

Before the *Lebanese Arak* decision, most post-1946 Lanham Act decisions continued to rely on the scandalousness provision rather than find religious marks disparaging. In a similar vein, the Board found MESSIAS scandalous for wine and brandy in 1968, finding the word to be the equivalent of “Messiah” and determining that the American public would see it as referring to Jesus Christ.¹⁸⁸ Again relying on *Riverbank Canning*, the Board found the mark scandalous and unregistrable.¹⁸⁹

It appears plain from the language of the opinions that some judges in the above cases were among the allegedly targeted religious group, which led to their dismay at the commercialization of these religious terms. One would hope that Board members who

184. *Ex parte Summit Brass & Bronze Works*, 59 U.S.P.Q. 22.

185. There is currently on the Principal Register the mark AGNUS DEI CLOTHING for a variety of clothing. Reg. No. 3693910. The office action for that mark did not mention a possible scandalousness or immorality 2(a) rejection.

186. *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215 (T.T.A.B. 2010) (“Notwithstanding that *Riverbank Canning* and various subsequent Board decisions involving religious sensibilities discussed scandalousness as the ground for refusal, likely because of the historical development of Section 2(a), all such decisions clearly contemplated the beliefs of particular groups of individuals as critical.”). For more on disparaging marks, see 1 Gilson on Trademarks § 3.04[6][a][i][B]. See also TMEP § 1203.03(c).

187. *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215.

188. *In re Sociedade Agricola E. Comerical Dos Vinhos Messias, S.A.R.L.*, 159 U.S.P.Q. 275 (T.T.A.B. 1968).

189. There is currently on the Principal Register the word mark MESSIAH for computer games; the Office Action for that mark did not suggest a possible 2(a) rejection. Reg. No. 3868981. The marks VIOLENT MESSIAHS for comic books and clothing and DARK MESSIAH for an on-line computer game received no office actions. Reg. Nos. 2677110 (VIOLENT MESSIAHS), 3627369 (DARK MESSIAH).

identified themselves with the involved religious groups would have recused themselves, though nothing in the decisions so indicates. Similarly, we do not know whether such Board members disclosed their possible personal bias to applicants.

The Board has also ruled on marks that referred to other religions. In 1959, the Board affirmed the refusal to register SENUSSI for cigarettes because it was the name of a Muslim sect that forbids the use of cigarettes.¹⁹⁰ It found that using the name of a religious order “to a product whose use is forbidden to the followers or adherents of such sect or order is an affront to such persons and tends to disparage their beliefs.” Thus, the use of SENUSSI for cigarettes was found to be scandalous under Section 2(a).

The decision in 2010 urging the application of the disparagement provision to religious marks was based on similar facts. There, applicant sought to register KHORAN for wines, and the Board affirmed a refusal of registration on the ground that the Koran is the sacred text of Islam and Islam teaches that alcohol is forbidden.¹⁹¹ The Board ruled: “[W]e have no doubt both that KHORAN would be recognized as the name of the holy text of Islam, and that the use of this term for wine would be disparaging to the religion and beliefs of Muslim Americans.”

Compare these cases to a 1963 opinion reversing the refusal to register the mark AMISH for cigars, along with a representation of a man in Amish garb smoking cigars. There, the applicant entered into evidence affidavits from two Amish men declaring that nothing in the religious principles of the Amish sect forbids the use of cigars and that the majority of men in the sect smoke cigars or chew tobacco.¹⁹² The Board found that evidence, along with portions of the Mennonite Encyclopedia and a pamphlet on Amish Life, showed that the mark was not an affront to the Amish and thus not scandalous.

In another opinion that would have been better resolved under the disparagement provision, the Board reversed a refusal to register the following mark for a doll that dropped its pants to expose its buttocks when a collapsible bulb was squeezed:¹⁹³



190. *In re* Reemtsma Cigarettenfabriken G.M.B.H., 122 U.S.P.Q. 339 (T.T.A.B. 1959).

191. *In re* Lebanese Arak Corp., 94 U.S.P.Q.2d 1215. For more on disparaging marks, see 1 Gilson on Trademarks § 3.04[6][a][i][B].

192. *In re* Waughtel, 138 U.S.P.Q. 594 (T.T.A.B. 1963).

193. *In re* In Over Our Heads, 16 U.S.P.Q.2d 1653.

While stating that the decision presented “a close case,” the Board disagreed with the examining attorney that the mark was scandalous matter that disparaged the Reverend Sun Myung Moon’s Unification Church. It concluded that the term MOONIES would be perceived as indicating that the dolls “moon,” or drop their pants, and not as referring to members of the Unification Church.

The Board has looked at trademarks that might disparage certain ethnicities under the scandalousness provision as well, though after the *Lebanese Arak* decision, it will focus instead on the disparagement provision in future cases. The most well known of these marks is the REDSKINS mark for goods and services related to the District of Columbia football team, the subject of drawn-out litigation on behalf of Native Americans. The Board’s opinion in the case granted the petition to cancel the mark on the grounds that it may disparage Native Americans and may bring them into contempt or disrepute, but denied the petition’s allegation that the mark consisted of or comprised scandalous matter under Section 2(a).¹⁹⁴ (The D.C. Circuit ultimately ruled that the disparagement and contempt claims were barred by laches.¹⁹⁵) The Board case held that the evidence showed that, during the relevant time periods, a substantial composite of the general population would have found REDSKINS to be a derogatory term for Native Americans. However, it held that the evidence did not show the term to be shocking or offensive to a substantial composite of the general population, when used in connection with the football team.

Public acceptance of a derogatory term provides a good rationale for the statutory inclusion of a ban on disparaging marks. In the REDSKINS case, the term was derogatory, yet a substantial composite of the American people apparently had no difficulty with it being used as the name of a professional football team. Because Native Americans were and are a minority of the population, a term that was shocking and offensive to them would not necessarily have been shocking and offensive to a substantial composite of the population.

In a case involving similar allegations, the Board again found that a cancellation petitioner had failed to show that the following registered mark was scandalous:¹⁹⁶

194. *Harjo*, 50 U.S.P.Q.2d 1705, *rev’d*, 284 F. Supp. 2d 96, 68 U.S.P.Q.2d 1225 (D.D.C. 2003), *remanded*, 415 F.3d 44, 75 U.S.P.Q.2d 1525 (D.C. Cir. 2005).

195. *Pro-Football, Inc. v. Harjo*, 565 F.3d 880 (D.C. Cir.), *cert. denied*, 130 S. Ct. 631 (2009).

196. *Native American Resource Academy v. Atlanta Nat’l Baseball Club, Inc.*, 2000 TTAB LEXIS 593 (T.T.A.B. 2000) (not precedential).



In denying the petitioner's motion for summary judgment, the Board pointed to petitioner's failure to submit any evidence in support of its position beyond two exhibits generally relating to team names based on Native Americans. (This contrasts with the voluminous amount of evidence presented in the REDSKINS case.)

In two separate cases, the Board found that use of the word MAFIA in marks was not scandalous: MAFIA BRAND for various food items¹⁹⁷ and JUNIOR M.A.F.I.A. for live musical concerts and prerecorded musical performances.¹⁹⁸ In each case, the examining attorney put into evidence news articles that used the term "Mafia" to refer to criminal organizations. However, the Board found that the term is used appropriately to refer to an historical criminal organization and would not *per se* be considered offensive to a substantial composite of the general public or Italian Americans.

b. Sexual References

As with profanity, in order to show that marks are scandalous or immoral, "it is sufficient if the Examining Attorney shows that the terms [or images] are vulgar."¹⁹⁹ Most word marks in this category are slang terms, but those that are not have fared relatively well. For example, the Patent Office Examiner in Chief found nothing vulgar in 1952 about the mark LIBIDO for perfumes.²⁰⁰ And in 1973, the Board allowed the mark WEEK-END SEX to register for a magazine.²⁰¹ Simply referring to certain

197. *In re Mothers & Fathers Italian Ass'n*, 2000 TTAB LEXIS 52 (T.T.A.B. 2000) (not precedential).

198. *In re Undeas, Inc.*, 2000 TTAB LEXIS 39 (T.T.A.B. 2000) (not precedential).

199. *In re RK Netmedia*, 2009 TTAB LEXIS 389.

200. *Ex parte Parfum L'Orle, Inc.*, 93 U.S.P.Q. 481 (Pat. Off. Exam'r-in-Chief 1952).

201. *In re Madsen*, 180 U.S.P.Q. 334.

parts of the anatomy is not scandalous unless there is some prurient or vulgar element in the mark.²⁰²

i. Slang References

Slang references to material related to sex will nearly always be considered scandalous and unregistrable. In 1971, the Board even found that BUBBY TRAP for brassieres was vulgar, relying on nothing more than evidence from one dictionary that the word “bubby” means “Breast, now often considered vulgar.”²⁰³

The Board affirmed a refusal to register the following mark after finding that, “in the view of a substantial composite of the public, in particular women, the term PUSSY currently has a vulgar, offensive sexual meaning and that the offensive meaning is the meaning which the relevant public will perceive as applied to the beverage products identified in the application, including energy drinks”:²⁰⁴



Similarly, the Board affirmed a refusal to register THE BEARDED CLAM for restaurant services, finding it to be slang for female genitalia and therefore vulgar.²⁰⁵ In a seemingly inconsistent opinion, the Board reversed a refusal to register the mark TWATTY GIRL for “cartoon strips, cartoon prints and newspaper cartoons.”²⁰⁶ In that case, however, the Board found that the term “twatty” had a meaning “quite distinct from any immoral, scandalous or vulgar connotations.”

Along the same lines, other marks found to be vulgar slang and unregistrable are 1-800-JACK-OFF and JACK OFF for “entertainment in the nature of adult-oriented conversations by telephone,”²⁰⁷ YOU CUM LIKE A GIRL for clothing,²⁰⁸

202. See, e.g., HAPPY PENIS for lotions, creams, oils and gels (Reg. No. 2853632); ON THE WRONG END OF THE PENIS for calendars (Reg. No. 3398617); BOUNTIFUL BREAST for dietary supplements for breast enlargement (Reg. No. 2958266); HOME OF THE BIGGER BREAST for clothing (Reg. No. 3867259).

203. *In re Runsdorf*, 171 U.S.P.Q. 443 (T.T.A.B. 1971).

204. *In re Shearer*, 2009 TTAB LEXIS 374. But see PUSSY PATCH for clothing (Reg. No. 3213591, Section 2(a) not mentioned in office action); PUSSY TEAM for women's casual clothing (Reg. No. 3045604, no office action).

205. *In re Douglas*, 2004 TTAB LEXIS 524 (T.T.A.B. 2004) (not precedential).

206. *In re Watkins*, 2005 TTAB LEXIS 66.

207. *In re Boulevard Entertainment*, 334 F.3d 1336.

208. *In re Carlson*, 2007 TTAB LEXIS 651 (T.T.A.B. 2007) (not precedential) (“Applicant failed to offer any evidence to support her argument that she uses the designation You Cum Like A Girl as a symbol of female empowerment.”).

CUMFIESTA and CUMGIRLS for adult-oriented online entertainment services,²⁰⁹ and FACIAL ABUSE for “providing an adult entertainment website featuring photographic, audio and video presentations.”²¹⁰ However, the Board found insufficient evidence that CUMBRELLA for condoms was scandalous, holding that, in that case, “the evidentiary record regarding whether the term ‘cum’ is vulgar is far from compelling, and ambiguous at best.”²¹¹

The Board rejected the following mark for clothing not only because it was scandalous, but also because it was disparaging to the Boston Red Sox baseball team:²¹²



It rejected the applicant’s contention that the mark was humorous and merely suggestive and found the mark instead to be vulgar and sexually explicit. The Board was particularly disturbed by the fact that the goods listed included children’s and infant’s clothing, making the mark “particularly lurid and offensive.”

ii. Images

Realistic images of sexual material will also be considered scandalous. In 1981, the CCPA affirmed a refusal to register a photograph of a nude man and woman kissing and embracing, possibly exposing the male genitalia.²¹³ Where the designs are not realistic, they are more likely to be registrable.²¹⁴

209. *In re* RK Netmedia, 2009 TTAB LEXIS 389.

210. *In re* D&E Media, Inc., Ser. Nos. 76669945, 76669946 (T.T.A.B. 2010) (not precedential). Similarly, the USPTO refused registration to the same applicant for LATINA ABUSE (Ser. No. 76669948) and to a different applicant for WHOREABUSE.COM (Ser. No. 77352574), both for adult entertainment websites, on the ground that they were scandalous.

211. *In re* Gray, Ser. No. 78622783. This application was abandoned on March 28, 2011.

212. *Boston Red Sox Baseball Club*, 88 U.S.P.Q.2d 1581.

213. *In re* McGinley, 660 F.3d 481. The images for the marks at issue in *In re* McGinley do not appear in TESS. See Ser. Nos. 73107819, 73107820.

See also, e.g., Office Action Feb. 3, 2005, Ser. No. 79007454 (refusal under 2(a) of word mark plus “design featuring a naked woman posing, with breasts exposed”) (“The examining attorney refers to the attached evidence showing that exposed breasts are considered offensive to a substantial composite of the American public.”); Office Action of Feb. 14, 2008, Ser. No. 77318828 (refusal under 2(a) of word mark NAKED HAPPY GIRLS plus a photograph of the upper half of a naked woman).

214. See, e.g., Reg. No. 3100731 (for providing information relating to exercise programs for post-operative breast surgery/reconstruction patients); Reg. No. 2275995 (for clothing) (registered in 1999, cancelled in 2006 for failure to file statement of use).

An applicant's protestation that its mark DICK HEADS' was a nickname for Richard Heads' Bar & Restaurant was belied by the positioning of those words underneath a caricature of a head made up of male genitalia.²¹⁵ Because of the vulgarity of the design, the Board rejected the applicant's argument that both its words and its design were double entendres, and found that "it is the vulgar, anatomical significance of the mark which first strikes the viewer and dominates the commercial impression created by the mark as a whole." The caricature, according to the Board, "certainly pushes the mark a substantial distance along the continuum from marks which are relatively innocuous to those which are most egregious."

This relatively innocuous image was allowed to register as a mark for corrective implements to increase the size of the human penis:²¹⁶



In that case, the Board found nothing lewd or immoral about the figure's nudity and held that "[t]he mere fact that the male figure which constitutes the mark is apparently unclothed cannot in and of itself militate against registrability."

iii. Possible Non-Vulgar Alternative Meanings

If the applicant can show that consumers would readily see its mark as having a non-vulgar meaning, even if one meaning of the mark is vulgar, it may be able to register the mark. In 1994, the Federal Circuit vacated a Board decision affirming a refusal to register BLACK TAIL for adult entertainment magazines.²¹⁷ The examining attorney had relied on a dictionary reference defining "tail" as "sexual intercourse" while the applicant had shown that the primary definition in that dictionary was "rear end." The Federal Circuit ruled that the Board had erred in relying solely on dictionary definitions where there were both vulgar and non-vulgar definitions to be found. Without evidence as to which meaning a substantial composite of the general public would understand, the USPTO had not met its burden of showing the mark to be unregistrable under Section 2(a).

215. *In re Wilcher*, 40 U.S.P.Q.2d 1929.

216. *In re Thomas Labs.*, 189 U.S.P.Q. 50.

217. *In re Mavety Media*, 33 F.3d at 1375.

c. Drug References

The USPTO has rejected as scandalous and immoral several trademark applications related to illegal drugs, citing the adverse health effects of drug use. In particular, if the trademark uses the common name for the drug, the USPTO is unlikely to register it. For example, the Board rejected the following mark for “carbonated and non-carbonated soft drinks and energy drinks”:²¹⁸



In that case, the Board noted that cocaine is a Schedule II controlled substance with a high potential for abuse. It found that the mark was scandalous for the applied-for goods given that they were consumable; would be marketed to “virtually all consumers,” including children; and were advertised to suggest the drinks had a cocaine-like effect or should be mixed with alcohol. The applicant argued that the USPTO had registered or published for opposition other drug-related marks to be used in connection with energy drinks, “including EXTAZY, BLACK OPIUM, METH, BONG WATER, DIESEL, JUICE and KRONIK.” The Board explained that this information was entitled to little weight as it was merely a list of serial and registration numbers and marks.

Examining attorneys have also rejected applications for KO KANE for alcoholic beverages,²¹⁹ COCAINE for carbonated and non-carbonated soft drinks and energy drinks,²²⁰ and COCAINE for beauty creams, perfumes, deodorants and other personal care products.²²¹ In general, applications that use the word “marijuana”

218. *In re Kirby*, 2008 TTAB LEXIS 156.

219. *See* Office Action of Aug. 28, 2010 for Ser. No. 85038867 (application abandoned) (“It is well known that cocaine is an illegal drug that has led to widespread addiction and related health problems. A substantial composite of the general public would therefore find it scandalous that an alcoholic product called KO KANE is available for sale. Such use of the phonetic equivalent of the word “cocaine” would be seen as inappropriately glamorizing drug abuse.”) (citing research from the National Institute on Drug Abuse and evidence from Wikipedia listing the deaths of well-known people from cocaine abuse).

220. Office Action of July 3, 2007 for Ser. No. 78829207 (application abandoned) (“A substantial composite of the general public would find it scandalous that a product called COCAINE is freely sold to their children.”).

221. Office Action of Nov. 14, 2006 for Ser. No. 78820405 (application abandoned) (“[T]he proposed mark COCAINE is an illegal drug and is thus scandalous.”).

are also rejected. For example, MARIJUANA COLA for medicinal drinks was refused as scandalous.²²²

Nevertheless, some such applications have made it to registration. The following mark is registered on the Principal Register for footwear and clothing; the word mark is noted as COCAINE:²²³



COCAINE was registered for perfume in 1981 but was cancelled in 1989 for applicant's failure to file a statement of use.²²⁴ The same mark was registered for clothing in 1985 to a different applicant, but was cancelled in 1991 for lack of a statement of use.²²⁵ PARIS HEROIN is registered for t-shirts.²²⁶ HEROIN was registered for perfume in 1982 but was cancelled in 1988 for no statement of use.²²⁷ GOD MADE MARIJUANA was registered for shirts and hats in 2003 but cancelled in 2010 for lack of a statement of use.²²⁸ Marks that include drug names may be registered if the goods or services do not advocate drug use, such as COCAINE ANONYMOUS for "promoting the interests of those

222. Office Action of Nov. 17, 2009 for Ser. No. 77671304 (application abandoned) ("[T]he applied-for mark MARIJUANA COLA is scandalous because marijuana is an illegal drug or substance.").

See also Office Action of October 12, 2006 for MARIJUANA for various beverages, Ser. No. 78401566 (registration refused as comprising immoral or scandalous matter) ("According to the attached evidence from the Internet, including dictionary and encyclopedic extracts, the term MARIJUANA refers to an illicit drug that is associated with illegal behavior and adverse health consequences. The proposed mark is therefore immoral or scandalous and thus unregistrable."). For that application, there had been three previous office actions that had not mentioned a scandalousness basis for refusal, on November 17, 2004, August 10, 2005 and May 8, 2006.

Compare MARIA JUANA for clothing, Reg. No. 3567035 (only issue in Office Action was whether it identified the name of a particular living individual).

223. Reg. No. 3382096.

224. Reg. No. 1169787.

225. Reg. No. 1340874.

226. Reg. No. 3849798.

227. Reg. No. 1194945.

228. Reg. No. 2790741.

concerned with the use of cocaine and other narcotics”²²⁹ or MARIJUANA SYMPOSIUM for conferences in the field of medical science.²³⁰

Slang terms for drugs may or may not be accepted for registration, depending upon the goods and services, whether the mark uses double entendre or whether the slang term might have another meaning. The Board permitted registration of a slang term for marijuana in 1972, finding that the mark ACAPULCO GOLD for suntan lotion would evoke in consumers’ minds the sunny resort city of Acapulco rather than the illegal drug.²³¹ E-TOKE for a workshop on marijuana use awareness and prevention is also registered,²³² the mark POTHEADS AND PANS is registered for cookbooks²³³ and ECSTASY is registered for distilled liquor and spirits.²³⁴

However, BONG HITS 4 JESUS was rejected in 2008 on scandalousness grounds by an Office Action declaring that “it uses the name of a deity that is worshipped by a well-established group of people and suggests that people should engage in an illegal activity either in worship of that deity or for the benefit of that deity. . . . [T]he proposed mark . . . is scandalous because Christians would be morally outraged by a statement that connects Jesus Christ with illegal drug use.”²³⁵ The phrase had been the subject of a Supreme Court opinion relating to the First Amendment rights of public school students; the Court held that it was constitutionally permissible for school administrators to confiscate a banner reading BONG HITS 4 JESUS from students at a school event.²³⁶

d. Violence

In the Federal Circuit’s *Ritchie v. Simpson* case in 1999, it found that opposer William Ritchie had standing to oppose O.J. Simpson’s applications for O.J. SIMPSON, O.J. and THE JUICE in connection with various goods.²³⁷ He argued that he would be damaged by the registrations because the marks were allegedly synonymous with wife beater and wife murderer, and thus the marks disparaged his values as a “family man.” He also argued

229. Reg. No. 1612405.

230. Reg. No. 3801424 (Supplemental Register).

231. *In re Hepperle*, 175 U.S.P.Q. 512.

232. Reg. No. 3132959.

233. Reg. No. 3178332.

234. Reg. No. 3402958.

235. Office Action of Mar. 15, 2008 for Ser. No. 77305946 (BONG HITS 4 JESUS for various items of apparel) (application abandoned).

236. *Morse v. Frederick*, 551 U.S. 393, 396 (2007).

237. *Ritchie*, 170 F.3d 1092.

that the marks were scandalous because they “attempt to justify physical violence against women.”²³⁸ Unfortunately, there is no later office action or Board opinion available that assesses whether the marks were in fact scandalous for that reason.

In its one opinion focusing directly on the subject, the Board has shown a low tolerance for marks that advocate violence. It affirmed a refusal to register the mark W.B. WIFE BEATER for t-shirts where the evidence showed that the term “wife beater” has become a slang term for tank-top style t-shirts.²³⁹ The examining attorney’s evidence included statements from “a wide range of individuals and organizations expressing outrage and moral indignation about the use of the term WIFE BEATER in connection with t-shirts.” Some members of the public—the Board here showed its bias by stating parenthetically “not surprisingly, younger members”—find the term used in this context to be amusing and not offensive. Nonetheless, the Board concluded that a substantial composite of the general population finds “wife beater” in connection with t-shirts to be offensive.

The dissent in the case recognized that the term “wife beater” is offensive, politically incorrect and in bad taste. However, the dissenting judge suggested that the USPTO had not met its burden to show that a substantial composite of the general public would find the mark scandalous as applied to t-shirts.²⁴⁰ The evidence showed that some people found the mark offensive and others did not, and the dissent pointedly questioned the majority’s assumption “that an Internet search will necessarily reveal the views of a ‘substantial composite’ of the American public on a particular subject.”²⁴¹

The USPTO has refused registration of BABY AL QAEDA for t-shirts²⁴² and AL-QAEDA for t-shirts, sportswear, caps, a counter-terrorism organization, and a news and current events website (all in the same application).²⁴³ There, the examining attorneys declared that the name AL QAEDA “is synonymous with the terrorist actions of that organization and is thus scandalous because the bombing of civilians and other terrorist acts are shocking to the sense of decency and call out for condemnation.” The USPTO also refused registration of AL QAEDA WORRY BEADS on the grounds that it is scandalous.²⁴⁴ And the USPTO

238. *Id.* at 1097. See § V *supra* for more on this case and standing to challenge registrations on the basis of scandalousness.

239. *In re Love Bottling*, 2005 TTAB LEXIS 261.

240. *Id.* (Seeherman, J., dissenting).

241. For more on evidence of scandalousness, see § IV[g] *supra*.

242. Office Action of Nov. 18, 2004, Ser. No. 78400213 (application abandoned).

243. Office Action of Nov. 22, 2004, Ser. No. 78444968 (application abandoned).

244. Office Action of Oct. 21, 2010, Ser. No. 85057166 (application abandoned).

refused registration of OBAMA BIN LADEN for hats, shirts, bumper stickers and pins on Section 2(a) grounds, stating that the name BIN LADEN is synonymous with the terrorist acts of September 11, 2001, and therefore is scandalous.²⁴⁵

Finally, we note that the following mark is registered for jewelry and clothing:²⁴⁶

AGGRESSIVEKILLERGUN

e. Patriotism

In addition to the prohibition on registration of scandalous and immoral marks, the Lanham Act also bars registration of marks that may disparage national symbols or that incorporate a flag, coat of arms, or other insignia of a nation, state or city.²⁴⁷ In 1938, before the disparagement provision was enacted, the USPTO refused to register QUEEN MARY for women's underwear, finding that the use of the name as applied to those goods was "shocking to the sense of propriety."²⁴⁸ In a similar case, though involving the disparagement, contempt and disrepute portion of Section 2(a) rather than the scandalousness provision, the USPTO found that DOUGH-BOY for condoms was "obviously" unregistrable.²⁴⁹ The term "doughboy" was a nickname for American soldiers in World War I and the applicant had depicted soldiers on its packaging.

Distinct from those cases, the 1993 *Old Glory Condom* case focused squarely on the scandalousness provision and patriotism, but had an unexpected result. When reversing a refusal to register the following mark, the Board questioned the examining attorney's objection to the combination of flag imagery and the representation of a condom:²⁵⁰



245. See Office Action of Feb. 6, 2007, Ser. No. 77086418.

246. Reg. No. 3409432.

247. 15 U.S.C. § 1052(a) (marks that may disparage national symbols), 1052(c) (marks that incorporate a flag or other insignia). See 1 Gilson on Trademarks § 3.04[6][a][i][B][II] for more on national symbols and § 3.04[6][a][iii] for more on marks incorporating a flag or other insignia.

248. *Ex parte* Martha Maid Mfg. Co., 37 U.S.P.Q. 156 (Comm'r Pats. 1938) (quoting definition of "scandalous" from Funk & Wagnalls New Standard Dictionary, 1931).

249. *Doughboy Indus.*, 88 U.S.P.Q. 227.

250. *In re* Old Glory Condom, 26 U.S.P.Q.2d 1216.

In this case, the Board engaged in a lengthy discussion of the origins of the product and the laudable goals the applicant sought to achieve.²⁵¹ The opinion explained that applicant's president had participated in an exhibition at the prestigious Massachusetts Institute of Technology that "focused on artists' responses to contemporary social and political issues." His participation involved using patriotic American symbols "to emphasize that Americans have a patriotic duty to fight the AIDS epidemic and other sexually transmitted diseases." He then decided to market condoms using the above mark. The back of each package bears the "Old Glory Pledge":

We believe it is patriotic to protect and save lives. We offer only the highest quality condoms. Join us in promoting safer sex. Help eliminate AIDS. A portion of Old Glory profits will be donated to AIDS related services.

The Board apparently agreed with applicant that, rather than being offensive, its mark served to "redefine patriotism to include the fight against sexually-transmitted diseases, including AIDS."

In *Old Glory Condom*, the examining attorney had not refused the mark on the ground that it violated Section 2(b) of the Act, which prohibits registration of marks that incorporate a national flag, so the Board did not address that issue. However, the USPTO will not refuse to register stylized flags that form a design apart from that of an actual flag.²⁵²

f. Profanity and Vulgarity

A showing that the mark is "vulgar" is enough to show that it is scandalous or immoral under Section 2(a).²⁵³ However, profanity and vulgarity exist along a wide spectrum, from "damn" and "crap" to words one cannot say on television or the radio. The latter, terms that are no more than straightforward, mainstream profanity, will typically fail to attain registration. The difficulty for the USPTO comes with abbreviations, euphemisms, slang variations, innuendo and nicknames for otherwise clearly vulgar terms. In terms of registration, these are unpredictable.

i. Mild Profanity

The Board has allowed registrations including mild profanity to issue. Several marks are registered that include the terms

251. See § IV[f] *supra*.

252. TMEP § 1204.01(b) ("Marks containing elements of flags in a stylized or incomplete form are not refused under §2(b).").

253. *E.g., In re Big Effin Garage*, 2010 TTAB LEXIS 418 ("To prove that the words 'effin' and 'fn' are scandalous or immoral, the examining attorney must demonstrate that the terms are vulgar.").

BASTARD,²⁵⁴ CRAP,²⁵⁵ DAMN²⁵⁶ or BITCH.²⁵⁷ One office action, however, rejected the mild BULLCRAP FLAG as scandalous, stating that, “[a]ccording to the attached evidence from the Merriam-Website online dictionary website, the term ‘crap,’ included in the applied-for mark, BULLCRAP FLAG, is a vulgar term which means to defecate.”²⁵⁸ Several marks surprisingly include SLUT,²⁵⁹ a term that is generally considered to be offensive.

The mark SON OF A BITCH for ski goggles and equipment and dog apparel was abandoned after an office action rejection under Section 2(a).²⁶⁰ There, the examining attorney found:

According to the attached evidence from the Internet (in particular, numerous web pages and online dictionaries), the applied-for mark “SON OF A BITCH” means an unpleasant, disagreeable person and is thus scandalous because, as used in conversation (and as noted in the various definitions), the term has come to be known as an offensive, vulgar slang term.

Ironically, in addition to the scandalousness/immorality rejection, the examining attorney also rejected the class of the application pertaining to ski clothing on the ground of likelihood of confusion with a previously-registered mark: SOM BITCH for hats, shirts and shorts.²⁶¹ “As is apparent from the attached references,” reads the office action, “the phrase ‘som bitch’ is a well-known contraction for ‘son of a bitch.’ . . . Thus, the respective marks are similar and create similar commercial impressions.”

254. *E.g.*, RAT BASTARDS for clubs promoting the interests of car enthusiasts (Reg. No. 3897349); RUDE BASTARD for shirts (Reg. No. 3877017); FAT BASTARD for wine (Reg. No. 3580560); DON'T BE A BASTARD for stickers, posters, hang tags and clothing (Reg. No. 3481975).

255. *E.g.*, PURECRAP for clothing (Reg. No. 3103477); HANDICRAP for coaching and counseling individuals with disabilities (Reg. No. 3028459); WIFF O' CRAP for novelty odor room sprays (Reg. No. 2944922); FACT OR CRAP for trivia games and publications (Reg. No. 2663264); IF IT AIN'T SCOTTISH—IT'S CRAP! for beer (Reg. No. 3710425).

256. *E.g.*, BEST DAMN SPORTS SHOW PERIOD for a television series featuring sports (Reg. No. 3066021); DAMN SEXY for perfumes and cosmetics (Reg. No. 2903158); DAMMIT! for musical and dance performances (Reg. No. 3601703).

257. *E.g.*, RICH BITCH for wine (Reg. No. 3117353); FAT BITCH for a sandwich (Reg. No. 3153825); DIVINE BITCHES for an adult entertainment web site (Reg. No. 3870498).

258. Office Action of Jan. 23, 2006, Ser. No. 78660310 (application abandoned). The goods covered by the application are unclear; the description of goods read merely “bullcrap flag.”

259. WINE SLUT for clothing (Reg. No. 3559153); SLUT.XXX for adult-oriented entertainment on the Internet (Reg. No. 3243680) (Supplemental Register); THE SLUTCRAKER for dance performances (Reg. No. 3650802); CHEAP SLUT for candles (2891787); HUSTLER'S YOUNG SLUTS, INC. for pre-recorded adult entertainment DVDs (Reg. No. 2785841).

260. Ser. No. 77852839.

261. Reg. No. 2419459.

ii. Profanity Where the Term May Also Have a Relatively Innocuous Definition

In some cases, the Board will overlook the vulgarity of a term when it also has a non-vulgar connotation. For example, in one unlikely decision, the Board reversed a refusal to register BIG PECKER BRAND for t-shirts.²⁶² It concluded that only one meaning of that phrase was a vulgar reference to male genitalia and that the public would see the associated bird head design as on the specimens and understand it to refer to a large bird's beak:²⁶³

Seaside Graphics/Big Pecker Brand



1010 OCEAN TERRACE
SEASIDE HEIGHTS, N.J.
08751
(201) 830-3888



Another applicant may have read this opinion before deciding on the following mark, which is registered for clothing:²⁶⁴



262. *In re Hershey*, 6 U.S.P.Q.2d 1470. The same registrant also owns BIG PECKER for wine (Reg. No. 3621024).

See also PECKERHEADZ for condoms (Reg. No. 2977094); design mark for PECKERHEAD BREWING CO. featuring a cartoon woodpecker (Ser. No. 77878956) (published for opposition); PECKERHEADS for fan clubs at professional sporting events (Ser. No. 77182582) (published for opposition and then abandoned).

But see THE PECKERS for television programs and live entertainment, Ser. No. 77799415 (abandoned after Section 2(a) rejection).

263. *In re Hershey*, 6 U.S.P.Q.2d 1470 (“We fully recognize that the bird design may be removed at any time, but the specimens do serve to buttress the applicant’s contention that the mark is not intended to refer to male genitalia but, rather, refers to the more common meaning of a bird’s beak. Moreover, we think the inclusion of the bird design would make it less likely that purchasers would attribute any vulgar connotation to the word mark and we note that it is proper to look to the specimens of record to determine connotation or meaning of a mark.”).

264. Reg. No. 3130205.

However, the mark need not be presented in a way that consumers will understand the alternative definition. In one case, the Board found that the mark at issue was not intended in its vulgar sense, thus it was registrable. In 1978, the Board reversed a refusal to register BADASS for bridges for stringed instruments, though not because the phrase “bad ass” was not scandalous. It based the reversal on two points: the applicant claimed that the mark was an acronym and had an “innocent” pronunciation.²⁶⁵ Since that opinion, the USPTO has registered several similar marks.²⁶⁶

iii. Terms that Substitute for More Vulgar Terms

The USPTO has also permitted registration of marks that are substitutes for more vulgar words. For example, it allowed registration of BIG EFFIN GARAGE and BIG F’N GARAGE, both for online communities for musicians and music fans.²⁶⁷ It also reversed a refusal to register the following design mark for “decorative refrigerator magnets”:²⁶⁸



For BIG EFFIN GARAGE and BIG F’N GARAGE, the dictionary evidence submitted by the examining attorney implied that the words EFFIN and F’N were used as a more acceptable, less offensive substitute for the word “fucking,” and therefore were not scandalous. In the FRIGGIN case, the Board observed that the given definitions indicated that the word was seen as a euphemism for a word “clearly still regarded as vulgar or offensive even under today’s more permissive standards.” Nevertheless, it concluded that the evidence presented left some doubt as to whether FRIGGIN itself was scandalous and it ordered the mark passed to publication.

265. *In re Leo Quan, Inc.*, 200 U.S.P.Q. 370 (Reg. No. 1403079). See § IV[f] *supra*.

266. *E.g.*, BAD ASS for sporting goods (Reg. No. 3023683), BAD ASS DIECAST, INC. (in specific font) for retail shops featuring diecast collectible models (Reg. No. 3255978); ROYAL BADASS for clothing (Reg. No. 3336821); BAD ASS B*TCHEs for apparel, live musical performances, CDs and DVDs, etc. (Reg. No. 3168130); BETTY BADASS for clothing (Reg. No. 3031998); AMERICAN BAD ASS for clothing (Reg. No. 3411662).

267. *In re Big Effin Garage*, 2010 TTAB LEXIS 418.

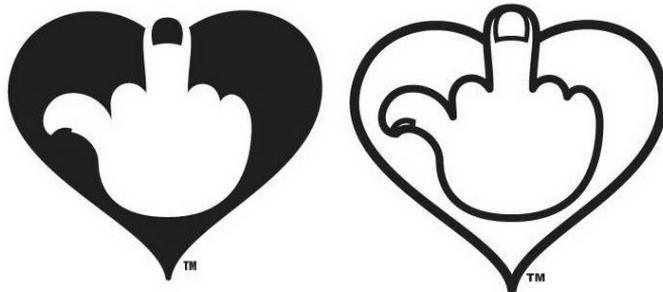
268. *In re Friggin Barnyard*, 1999 TTAB LEXIS 108.

A mark featuring a frog possibly raising its middle finger was also ultimately registered, after a scandalousness challenge. The Board reversed the refusal to register the following mark, for clothing and beer:²⁶⁹



The Board disagreed with the examining attorney that the frog was raising its middle finger, and noted that even if it were, he had “failed to establish that said gesture—when done by a realistic looking animal (and not a human) and when directed to no particular person or group—would be perceived as scandalous and immoral.” It also stated in dicta that, “depending upon the circumstances,” “when humans give the finger to a particular individual or group, . . . said gesture may be acceptable.” The dissent would have held that, “even by today’s perhaps relaxed societal attitudes, applicant’s frog giving this obscene gesture would be offensive to many.”

Several other “middle finger” marks have been refused registration, including the following for various items of clothing:²⁷⁰



269. *In re* Bad Frog Brewery, 1999 TTAB LEXIS 86.

270. *See, e.g.*, Ser. No. 78607760 (application abandoned).

The examining attorney found evidence from the Internet showing that such gestures are considered very offensive, in this case “perhaps twice as offensive when the gesture is made using both hands, or when accompanied by a vigorous upward motion of the hand and forearm.”²⁷¹

The Board has also refused an application for product packaging for beer and other alcoholic and non-alcoholic beverages where the packaging consists of a bottle in the shape of a hand with the middle finger extended upwards.²⁷² It cited several articles and dictionary definitions characterizing the gesture as “obscene,” and concluded that the gesture depicted in the mark was “vulgar.” The Board also noted that the goods in the application are “general consumer products, purchased by the public at large,” and therefore would be visible to all consumers, including parents shopping with children.

The USPTO has been inconsistent in its treatment of other substitutes for “fuck” or “fuck you.” It has allowed registration of, for example, THE F WORD for business consulting services related to franchising,²⁷³ THERE’S A NEW F WORD ON CAMPUS for providing digital messaging notifications,²⁷⁴ F U PAY ME for clothing²⁷⁵ and FCUK for many goods and services, ostensibly standing for French Connection United Kingdom.²⁷⁶ Compare the following marks abandoned after Section 2(a) rejections: F YOU for candles, body powder and cosmetics²⁷⁷ and FU for books in the field of humor, lifestyle and politics.²⁷⁸

As for acronyms and abbreviations, the USPTO has registered several that substitute for profanities in a way that is generally

271. Office Action of Nov. 23, 2005, citing www.wikipedia.org.

See also Office Action of Nov. 17, 2004, Ser. No. 78422390 for clothing (application abandoned) (“According to the attached evidence from the Internet, the proposed mark contains an obscene gesture.”); Office Action of Nov. 17, 2004, Ser. No. 78406811 for clothing (application abandoned) (same); Office Action of June 6, 2006, Ser. No. 78761897 for playing cards (application abandoned) (“According to the attached evidence, the proposed mark contains a stylized representation of “the finger” means “fuck you” and is thus scandalous because of the vulgar/expletive nature of the mark. . . . Here, the proposed mark features contemporary profanity.”); Office Action of June 18, 2008, Ser. No. 77420438 (clothing) (application abandoned) (“According to the attached evidence from multiple internet sources, the applied-for mark which shows a hand with an extended middle finger is considered profanity and is thus scandalous because it is offensive and derogatory.”).

272. *In re Luxuria*, s.r.o., 2011 TTAB LEXIS 279 (T.T.A.B. 2011) (precedential).

273. Reg. No. 3116416 (overcame a 2(a) rejection).

274. Reg. No. 3908827.

275. Reg. No. 3375001.

276. See Reg. Nos. 2520614 (perfume, cologne); 2772903 (eyeglasses, watches, etc.); 2920270 (leather goods, clothing); 3028227 (soaps, cologne, facial cleansers, sachets, etc.); 3128692 (advertising services, radio and television broadcasting, etc.); 3102906 (watches, jewelry, toys, retail department store services, etc.).

277. Ser. No. 78725523.

278. Ser. No. 77904643.

acceptable in society.²⁷⁹ For example, there are registrations for WTF (which stands for What The Fuck),²⁸⁰ FUBAR (Fucked Up Beyond All Recognition),²⁸¹ and SNAFU (Situation Normal All Fucked Up).²⁸² However, in a pair of decisions shocking not for the scandalousness of the marks involved but for the USPTO's overreaching, the Office refused registration for DEMOCRAT.BS and REPUBLICAN.BS.²⁸³ The examining attorney reasoned that the marks were scandalous because "BS" is a common abbreviation for "bullshit," which is vulgar slang that would be offensive to a substantial composite of the general public.

The USPTO has not been impressed by attempts to de-vulgarize vulgar terms by substituting asterisks or other symbols for parts of the term. For example, the Board affirmed a refusal to register THE COMPLETE A**HOLE'S GUIDE TO . . . for a "series of books providing information relating to advice, counseling, self-help, and humor."²⁸⁴ It declared: "[W]e are not convinced that the term "a**hole" is "cleaned-up" and non-vulgar. The fact that the term "a**hole" appears in articles at various Internet websites does not persuade us that the public would regard the term as non-scandalous." The Board also ironically affirmed a refusal to register A-HOLE PATROL for an "online social club that screens jokes submitted by users to control offensive and inappropriate content."²⁸⁵ It found that dictionary definitions and Internet

279. *But see* § II *supra*, discussing the USPTO's treatment of marks containing the acronym MILF.

280. WTF for clothing (Reg. No. 3174246); WTF design mark for shoes and clothing (Reg. No. 3078740); WTF . . . ORANGE MANGO for sports drinks and dietary supplement drinks (Reg. No. 3719285).

However, out of approximately thirty applications, there has been one refusal of a WTF mark on the grounds of scandalousness. The mark was WTF for "providing an internet website where users can post links to other sites and to content and rate the amusement value of the links and content posted by others." The examining attorney stated that, while the mark was an abbreviation, "any doubt as to what applicant meant by its use of WTF as a mark is dispelled by a glance at the applicant's website, which it attached as its specimen. The website is titled "WHAT THE F*CK?" and thus ties the letters WTF to the definition "What The Fuck." Office Action of June 8, 2006, Ser. No. 78623114. The applicant responded to the office action by asserting that it discontinued on its website and other materials use of the phrase "What the F*ck." The application was published for opposition but ultimately abandoned. (The applicant's web site may not have used the asterisk in the profanity; examining attorneys sometimes substitute asterisks or hyphens so as not to have to write the actual word.)

281. *E.g.*, FUBAR for dietary supplements and energy drinks (Reg. No. 3538804); FUBAR for Internet-based social networking (Reg. No. 3530984); FUBAR for bar services (Reg. No. 3498656).

282. *E.g.*, SNAFU for pre-recorded CDs featuring music (Reg. No. 3751679); SNAFU for wine (Reg. No. 3389473); SNAFU for hair care preparations (Reg. No. 2356194).

283. *See* Office Action of April 2, 2007, Ser. No. 77042069 (application abandoned); Office Action of April 2, 2007, Ser. No. 77042071 (application abandoned).

284. *In re* Zaharoni, 2005 TTAB LEXIS 3.

285. *In re* Jibjab Media, Inc., 2009 TTAB LEXIS 67.

evidence “consistently indicate that an A-HOLE is an ‘asshole’” and was “not convinced that the term A-HOLE is ‘sanitized’ or otherwise non-vulgar. The mere fact that the term A-HOLE is utilized in two slang dictionaries and an Internet article as a substitute to avoid use of the word ‘asshole’—while clearly conveying the same meaning—does not persuade us that the public would regard the term as non-scandalous. In other words, the evidence of record, while sufficient to support a finding that A-HOLE is less vulgar than ‘asshole,’ is insufficient to support a finding that A-HOLE is itself a non-vulgar, non-scandalous term.”

iv. Plainly Vulgar Terms

The Board will generally refuse to register marks that are comprised of or contain plainly vulgar terms that could not be understood any other way. In 1981, the Board refused registration of BULLSHIT for personal accessories and wearing apparel,²⁸⁶ and it refused registration of the same mark in 2006, this time for a different applicant seeking to register the mark for various beverages and services.²⁸⁷ The 1981 Board found that the mark “comprises matter which gives offense to the conscious or moral feelings or is shocking to the sense of decency or propriety of a substantial composite of the general public of the United States.” No marks containing the words “shit” or “fuck” have been registered with the USPTO. The Board also affirmed a refusal for DE PUTA MADRE for various items of apparel, finding that the mark translated into English as “fucking great.”²⁸⁸

v. Scatological References

The USPTO has rejected several scatological marks for registration. In 1988, Greyhound Corporation opposed the following mark for t-shirts as scandalous, disparaging and likely to be confused with its running dog mark:²⁸⁹



The Board found that the applicant admitted its mark to have “a shock value,” which it found to be “the offensiveness of the

286. *In re Tinseltown*, 212 U.S.P.Q. 863.

287. *In re Red Bull GmbH*, 78 U.S.P.Q.2d 1375.

288. *In re Mexico 69 SRL*, 2006 TTAB LEXIS 358.

289. *Greyhound Corp.*, 6 U.S.P.Q.2d 1635.

depiction.” It went on to find that a substantial composite of the general public would find the mark scandalous.

Word marks with scatological references or connotations have fared just as poorly. A design mark featuring the word AUDIOTURD for various digital media similarly was not registered, based on dictionary definitions of the word “turd” that were designated either “vulgar,” “vulgar slang,” “a highly offensive term,” “taboo” or “sometimes vulgar.”²⁹⁰ The Board also affirmed a refusal to register GRANDMA SCHITTHED’S OUTHOUSE BROWN for beer and ale, GRANDPA SCHITTHED’S INKY STINKY PALE ALE for beer and ale, and SCHITTHED’S for beer and ale, restaurant and bar services, mugs, T-shirts and hats.²⁹¹ There, the Board agreed with the examining attorney that the surname in the marks was the phonetic equivalent of the offensive, derogatory insult “shithead.” The Board has also affirmed a refusal to register REALLY GOOD SHIT for “penetrating oil for automotive, marine, industrial, residential, and sporting use.”²⁹² The applicant’s argument that the mark would be understood as “really good stuff” rather than “really good excrement” was unavailing.

VII. FIRST AMENDMENT CONCERNS

All challenges to the validity of Section 2(a)’s ban on scandalous marks on the basis that it violates the First Amendment have met a brick wall that is unlikely to crumble any time soon, though we will discuss the relevant arguments briefly. The Federal Circuit’s predecessor court addressed and rejected challenges based on freedom of speech. In 1981, the CCPA held that the bar to registration of scandalous marks does not violate the First Amendment because the trademark may still be used even if it is not registered. Therefore, the argument goes, Section 2(a) does not suppress expression.²⁹³ Ever since, the Federal Circuit has continued to relentlessly echo this decision.²⁹⁴

290. *In re Greenfield Records, LLC*, Ser. No. 77514177.

291. *In re Frankel*, 2002 TTAB LEXIS 250.

292. *In re R.G.S. Group, Ltd.*, 1997 TTAB LEXIS 293 (T.T.A.B. 1997) (not precedential).

293. *In re McGinley*, 660 F.3d at 484.

294. *In re Boulevard Entertainment*, 334 F.3d at 1343 (“Previous decisions of this court and our predecessor court . . . have rejected First Amendment challenges to refusals to register marks under section 1052(a), holding that the refusal to register a mark does not proscribe any conduct or suppress any form of expression because it does not affect the applicant’s right to use the mark in question. We adhere to the reasoning set forth in those cases and reject [applicant’s] First Amendment challenge.”) (citations omitted); *Ritchie*, 170 F.3d at 1099 (“The dissent . . . expresses at some length concerns about [applicant’s] First Amendment rights. The dissent fails to understand that the denial of federal registration of a mark does not prohibit the use of that mark.”); *In re Mavety Media*, 33 F.3d at 1374 (“[O]ur precedent forecloses [applicant’s] challenges to § 1052(a) as unconstitutional on its

In response, commentators have argued quite coherently that the court has gotten it wrong.²⁹⁵ The CCPA has been charged with “gloss[ing] over a difficult constitutional question”²⁹⁶ and failing to provide “a slightly more erudite analysis” due to the “delicate and subtle nature of free speech.”²⁹⁷

While a full discussion of this topic is beyond the scope of this article,²⁹⁸ we will cover the main arguments in brief. First, commercial speech receives limited protection under the First Amendment,²⁹⁹ and trademarks are commercial speech.³⁰⁰ In order to show that enforcement of Section 2(a) abridges protected commercial speech, a mark owner must show, first, that the denial of federal registration actually abridges speech. Courts have struck down statutes denying a government benefit to a person because of the content of her speech even where the speech is not entirely banned. Federal trademark registration gives a set of benefits to a mark owner³⁰¹ and Section 2(a)’s prohibition on registering scandalous and immoral marks effectively conditions receipt of those benefits on a finding that the mark is inoffensive.³⁰²

If the mark owner overcomes that hurdle, it must show that the contents of the speech are not false, misleading or proposing an illegal transaction; the government’s interest in regulating the speech is “substantial”; the regulation at issue directly advances that interest; and the regulation is no broader than necessary.³⁰³ The mark owner would therefore need to show that the federal

face or as applied. . . . We are thus obligated to reject [applicant’s] similar constitutional arguments.”).

295. Davis, *supra* note 45, at 862 (“[T]his Article has argued that a refusal to register marks other than those falling into categories of subject matter that the government has a compelling interest in prohibiting altogether is irreconcilable with the First Amendment.”); Phillips, *supra* note 45, at 68 (“The constitutionality of section 2(a) as a legitimate exercise of Congressional authority seems questionable.”); Jeffrey Lefstin, *Does the First Amendment Bar Cancellation of REDSKINS?* 52 Stan. L. Rev. 665 (2000) (concluding that cancellation of the REDSKINS marks as scandalous or immoral would be unconstitutional); Michelle B. Lee, *Section 2(a) of the Lanham Act as a Restriction on Sports Team Names: Has Political Correctness Gone Too Far?* 4 Sports Law. J. 65, 71-74 (1997) (arguing that Section 2(a) is unconstitutional).

296. Baird, *supra* note 51, at 686.

297. Phillips, *supra* note 45, at 67.

298. For more, see 1 Gilson on Trademarks § 3.04[6][a][i][F].

299. *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumers Council, Inc.*, 425 U.S. 748, 762-73 (1987).

300. *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, 483 U.S. 522, 535 (1987).

301. See 1 Gilson on Trademarks § 4.01 for a discussion of the advantages of federal registration on the principal register.

302. Phillips, *supra* note 45, at 68 (“In effect, federal registration of a mark is made conditional on the forfeiture of a right to use offensive speech.”).

303. *Central Hudson Gas & Electric Corp. v. Public Serv. Comm.*, 447 U.S. 557, 566 (1980).

government's interest in denying registration to scandalous and disparaging marks is not "substantial"; the statutory bar does not directly advance that interest; and the statutory bar is broader than necessary.³⁰⁴

A mark owner could also argue that applying Section 2(a) may unconstitutionally discriminate on the basis of viewpoint or that the "scandalous" provision is unconstitutionally overbroad or void for vagueness. Given the hostility of the Federal Circuit to constitutional arguments against Section 2(a), though, there seems little likelihood of success for these claims.

VIII. SOLUTIONS

The problems of inconsistency, subjectivity, and difficult line-drawing are inherent in trademark law. It is far more art than science. With potentially scandalous or immoral trademarks, the concepts of morality and taking personal offense add yet another layer of difficulty. While other aspects of trademark law are also fundamentally concerned with human psychology, these cases add elements of discomfort and the need to discern social norms that are not present in infringement, dilution or false advertising cases.

There are more grey areas in which to become lost, from whether a term is vulgar to how the goods or services shape a mark's commercial impression to just how many will be offended by it. In dealing with Section 2(a), the USPTO has a job no one can covet, but instead one with which everyone can sympathize.

This section postulates and evaluates several different ideas for best handling Section 2(a)'s requirement that the USPTO refuse registration of scandalous and immoral trademarks.

a. Amend or Repeal Statutory Language

The obvious possibility is amending the statutory language or, in the alternative, jettisoning it altogether.³⁰⁵

First, let us look at the question of amendment. The present language of Section 2(a) may simply be too broad and too vague to give the USPTO sufficient guidance. It could be replaced with "extremely offensive" or "vulgar" or "shocking" or "prurient" or any

304. Davis, *supra* note 45, at 835 (finding it "doubtful" that Section 2(a)'s restrictions meet this test); Phillips, *supra* note 45, at 56 ("[T]here is good cause to question whether policing the morality of trademarks is rationally related to a legitimate legislative objective."). *But see* Baird, *supra* note 51, at 698-701 (arguing that these elements are all satisfied by 2(a)).

305. Schwender, *supra* note 68, at 225 ("This Article argues that section 2(a) is a remnant of religious protectionism and the doctrine of unclean hands, neither of which further the fundamental policy concerns of trademark law, and therefore should have no place in the Lanham Act."); Phillips, *supra* note 45, at 70 (arguing that "the law governing certain "controversial" marks as embodied in section 2(a) is unworkable, out of place and has outlived its usefulness") (footnote omitted).

number of other terms, with the standards of “substantial composite” and “context of the marketplace” and “contemporary attitudes” specified, perhaps in the definitions section. However, this solution would simply exchange two unsatisfying words with others that provide no further guidance.

Another possibility is to delete “immoral” and “scandalous” and replace them with “obscene.”³⁰⁶ This would have the advantage of narrowing the scope of possible rejections and allowing reference to additional case law and standards.³⁰⁷ While it would not create much certainty, it would eliminate questions about many trademarks now at the edges of scandalousness. However, the goal is not necessarily to allow many additional marks onto the register; it is to find a workable standard that the USPTO can apply consistently.

One commentator has proposed what he calls “thin” protection for scandalous marks.³⁰⁸ He would amend Section 2(a) to allow for registration of such marks if they meet all of the other criteria for validity, but would limit the protection granted the mark, which would be labeled “controversial.” The registrant would have a cause of action for infringement only for the goods and services for which the mark is registered and would not have a cause of action for dilution in an unrelated market. This solution would not appear to satisfy either those who want to limit the number of allegedly scandalous marks registered or those who wish to register allegedly scandalous marks. It would also encourage advocates contending for other exceptions to statutory protection.

What about simply eliminating the words “scandalous” and “immoral” from the statute and doing away with those grounds for refusal of registration? The marketplace would ideally deal with the most offensive marks, as consumers would presumably refuse to purchase goods sold under marks that offend them.³⁰⁹ The

306. TMEP § 1203.01 (“It has been noted that the threshold is lower for what can be described as ‘scandalous’ than for ‘obscene.’”).

307. See *Miller v. California*, 413 U.S. 15, 24 (1973) (“The basic guidelines for the trier of fact must be: (a) whether “the average person, applying contemporary community standards” would find that the work, taken as a whole, appeals to the prurient interest, (b) whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law; and (c) whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value.”) (citations omitted).

308. Phillips, *supra* note 45, at 70.

309. Schwender, *supra* note 68, at 226 (“[L]et the marketplace decide the fate of products bearing marks of questionable public acceptability.”). See also *In re Hershey*, 6 U.S.P.Q.2d 1470 (Cissel, J., concurring) (“Applicant apparently enjoys a reasonable business in selling its goods under this mark. If the double entendre were in fact objectionable, why is it that business has developed to the point where the mark is worth the effort and expense of protecting it with registration? If it were actually so offensive, people simply would not purchase products bearing it.”).

American public would continue, as it is now, to be faced with products, services, entertainment and printed matter that are in poor taste and even embarrassing to behold. Nevertheless, even with discomfort about refusals to register marks that appear to be outside the statutory ground, there is still discomfort about allowing some of the more offensive marks to register, particularly where the general public would be exposed to them.

Of course, these solutions, while obvious, are also the most patently flawed. No lawmaker would be willing to suggest even tinkering with a ban of any sort on immoral or scandalous material. Asking to be tagged as pro-immorality or pro-vulgarity is not a savvy political move. And advocating repeal of a century-old statutory phrase designed to protect public sensibilities would doubtless trigger impassioned opposition.

***b. Look to Third-Party Registrations as Precedent,
Though Not Binding***

The USPTO's extreme reluctance to be influenced by older registrations is certainly understandable. The idea of digging into files possibly from another era and having to distinguish differences in marks, goods and services is unpalatable. And even near-consistency is impossible with all of the variables in trademark applications.

But particularly in the case of allegedly vulgar marks, as we saw in the case study at the beginning of the article, USPTO examining attorneys may simply look at whether any part of the mark contains or suggests an offensive term and, if so, refuse registration. In such cases, the examining attorneys should be able to see what has previously been decided with respect to the term incorporated in similar marks. A registration allowed by a single examining attorney may cause another to allow registration for what he or she believes may be a scandalous mark. Conversely, a refusal for one mark may cause another examining attorney to refuse registration for what he or she believes may *not* be a scandalous mark. To avoid this, examining attorneys should consult with their managing attorneys or follow a possible USPTO-wide Section 2(a) clearance procedure when they see a registration or refusal that serves as a precedent they do not agree with.

But see In re Tinseltown, 212 U.S.P.Q. 863 (finding the argument that "the public can judge the mark's propriety in the marketplace" to be "wholly irrelevant" to the question of scandalousness).

***c. Provide Additional Guidance to
Examining Attorneys***

This solution is an inexpensive, straightforward one that operates within the existing system. First, the USPTO could provide more guidance in the TMEP, laying out a more detailed explanation of what goes into a determination of whether marks are scandalous and immoral.

Right now, TMEP § 1203.01 provides generalities, such as “The meaning imparted by a mark must be determined in the context of the current attitudes of the day” and “The determination of whether a mark is scandalous must be made in the context of the relevant marketplace for the goods or services identified in the application.” Both of these accurately represent the USPTO’s standards and should be included. However, without more explanation, these statements are not very helpful in practical terms. The Manual could include, for example, the USPTO’s policies on acronyms that include letters standing for vulgar terms and on vulgar terms that include symbols instead of the entire actual word, as well as additional guidance on evidence in cases involving potentially offensive marks.

Second, another way to provide guidance is to enlist the managing attorneys and educate them on more specific policies for handling scandalous and disparaging marks. The TMEP directs each examining attorney to consult with his or her supervisor when he or she believes that a mark may comprise immoral or scandalous matter.³¹⁰ This directive is meant to “ensure consistency in examination” with respect to such marks.

***d. Change Standard from “General Public” to
“Actual or Potential Purchasers”***

When potentially scandalous or immoral marks are at issue, the USPTO should look at whether a substantial composite of potential or actual purchasers of the goods or services would find the mark offensive. It should not ask whether a substantial composite of the general public would find the mark offensive unless the goods or services are or would be marketed *to the general public*. In likelihood of confusion determinations, the USPTO looks at classes of consumers who purchase certain goods or services. They should be able to look at the likely demographics of a particular class of consumer that is going to purchase the goods or services at issue in an application with a potentially scandalous or immoral product or service. The “general public” standard is not mandated by the statute.

310. TMEP § 1203.01.

e. Pass All Marks to Publication

The Board has often stated that doubts about whether a mark is scandalous should be resolved in favor of publication. Then, if there are people or institutions who find the mark scandalous, they can bring an opposition proceeding and develop a more complete record for the USPTO.³¹¹ In making this suggestion, the USPTO and the courts have acknowledged the subjectivity of whether a mark is scandalous and the vagueness of the guidelines to be followed.³¹² The Federal Circuit in *Ritchie* reaffirmed that the USPTO “may not readily assume, without more, that they know the views of a substantial composite of the public.”³¹³ It cautioned against “the risk of pre-judging public attitudes toward a proposed registration based on ad hoc responses by government officials.”

In the first case to suggest this course, the Board recognized that it was “a close case” that was “not free of doubt.” It then passed the mark to publication rather than affirming the refusal.³¹⁴ Still, this approach does not carry the day when the Board finds itself in no doubt as to whether the mark at issue is scandalous.³¹⁵

The Federal Circuit, however, would go further. That court explicitly “commend[ed] the practice” of passing a mark to publication in order to resolve the issue of whether a mark comprises scandalous matter.³¹⁶ It did *not* confine this practice to cases in which the USPTO had doubts about the mark’s registrability. Instead, it suggested that the Office “resolv[e] the issue of whether a mark comprises scandalous matter by first permitting the mark to pass for publication, and then allowing interested members of a composite of the general public who consider the mark to be scandalous to bring opposition proceedings.”³¹⁷ In fact, the Federal Circuit has gone so far as to

311. *E.g.*, *In re In Over Our Heads*, 16 U.S.P.Q.2d 1653 (“Because the guidelines are somewhat vague and because the determination is so highly subjective, we are inclined to resolve doubts on the issue of whether a mark is scandalous or disparaging in favor of applicant and pass the mark for publication with the knowledge that if a group does find the mark to be scandalous or disparaging, an opposition proceeding can be brought and a more complete record can be established.”).

312. *In re Friggin Barnyard*, 1999 TTAB LEXIS 108 (citing “the difficulties in accurately discerning contemporary attitudes” and noting the practice of passing the mark to publication to allow public opposition).

313. *Ritchie*, 170 F.3d at 1094.

314. *In re In Over Our Heads*, 16 U.S.P.Q.2d 1653.

See also In re Love Bottling, 2005 TTAB LEXIS 261 (Seeherman, J., dissenting) (arguing that because the evidence of record raised sufficient doubt about the scandalousness of the mark, the Board should have passed the mark to publication).

315. *See, e.g., In re Carlson*, 2007 TTAB LEXIS 651; *In re Mexico 69 SRL*, 2006 TTAB LEXIS 358; *In re Love Bottling*, 2005 TTAB LEXIS 261.

316. *In re Mavety Media*, 33 F.3d at 1374.

317. *Ritchie*, 170 F.3d at 1094.

find that the USPTO “has a duty to obtain the views of the affected public” and that Section 2(a)’s scandalousness ban “encourages, if not requires, participation by members of the general public who seek to participate through opposition proceedings.”³¹⁸

However, this approach has a two-fold problem. First, the USPTO would be abdicating its (admittedly difficult) mandate to keep those marks off of the register. It would effectively just be transferring its statutory responsibility to the public. Section 2(a) precludes registration of scandalous and immoral marks and the USPTO cannot and should not simply punt.

Second, even assuming the mark’s publication comes to their attention, concerned consumers are unlikely to have the time or money to file an opposition with the USPTO to protest registration. It is true that facilitating expression of public opinion has worked in a few past cases. For example, the mark COCAINE for soft drinks and energy drinks was published for opposition, and then two groups opposed registration, Americans for Drug Free Youth, Inc. and the Progressive Intellectual Property Law Association.³¹⁹ The examining attorney requested a remand and issued an office action refusing registration under Section 2(a), stating that “[a] substantial composite of the general public would find it scandalous that a product called COCAINE is freely sold to their children.” The applicant then abandoned its application. Nevertheless, there have only been a handful of published cases in which an opposer has raised this Section 2(a) issue. Some oppositions on Section 2(a) grounds are brought by competitors, primarily claiming relative grounds like likelihood of confusion or dilution and only secondarily arguing on behalf of consumers that the mark at issue is scandalous.³²⁰ These cases, of course, do not serve to elicit genuine public sentiment.

f. Set Up a Completely New Procedure

Distinguished British academics Jeremy Phillips and Ilanah Simon Fhima have proposed a “no mark” system prompted by the use of the mark ADOLF HITLER for wine.³²¹ Under this suggested system, trademarks that could be exploited “as an icon of hatred,

318. *Id.* See also *In re Mavety Media*, 33 F.3d at 1374 (“[S]uch a procedure establishes a meaningful opportunity for response by the applicant with evidence that a substantial composite of the general public would not consider the mark at issue scandalous in the context of contemporary attitudes and the relevant marketplace.”).

319. Ser. No. 78829207. See also *Ritchie*, 170 F.3d 1092; *Native American Resource Academy*, 2000 TTAB LEXIS 593; *Boswell v. Mavety Media Group Ltd.*, 52 U.S.P.Q.2d 1600 (T.T.A.B. 1999); *Harjo*, 30 U.S.P.Q.2d 1828; *Bromberg*, 198 U.S.P.Q. 176.

320. See, e.g., *Boston Red Sox Baseball Club*, 88 U.S.P.Q.2d 1581; *Schlage Lock Company*, 2005 TTAB LEXIS 543; *Greyhound Corp.*, 6 U.S.P.Q.2d 1635.

321. Jeremy Phillips & Ilanah Simon, *No Marks For Hitler: A Radical Reappraisal of Trade Mark Use and Political Sensitivity*, 8 European Intel. Prop. Rev. 327 (2004).

genocide or other consensually identified destructive social value” would be placed on a registry of unacceptable marks that could not be used for any goods or services. While this proposal has many advantages, including certainty, there are probably few terms that could never be used in any context. In addition, like making a list of well-known trademarks, the difficulty here would be in deciding which marks should be blacklisted. In the United States, it seems unthinkable that the ADOLF HITLER mark would achieve registration for any goods or services.³²²

Finally, perhaps some interested trademark search firm could set up a separate database for trademarks that have been refused by the USPTO as scandalous or immoral, or that the mark owner assumes would be refused on those grounds. Such a database would be particularly useful for those who deal in goods and services in which prurient marks are the norm.

IX. CONCLUSION

In an age of fluctuating social permissiveness, it does not seem fair to charge the USPTO, or anyone, really, with interpreting and applying the terms “scandalous” and “immoral.” Nevertheless, the Office must follow its mandate to examine marks and register only those that meet the statutory criteria, just as it is required to do with marks likely to confuse, containing the names of deceased presidents during the lives of their widows, or consisting of the flag of any U.S. state.

Section 2 of the Lanham Act is the gateway to federal trademark registration. These two terms, maddeningly obscure though they may be, form a part of federal trademark policy that has stood for over a century. The American public and applicants alike deserve thoughtful, coherent treatment of even those trademarks that are not appropriate dinner party conversation.

322. See § VI[d] *supra*.

APPENDIX A

**Trademarks Found to Be Scandalous or Immoral
in the United States**

These are marks that were the basis of opinions from the Trademark Trial and Appeal Board, the Commissioner of Patents and the Federal Circuit Court of Appeals. This list does not include marks that were denied trademark registration by the USPTO outside the scope of an *ex parte* or *inter partes* proceeding.

MARK	GOODS, SERVICES	CITATION
FACIAL ABUSE	adult entertainment web site	<i>In re</i> D&E Media, Inc., Ser. Nos. 76669945, 76669946 (T.T.A.B. 2010) (not precedential)
	various digital media	<i>In re</i> Greenfield Records, LLC, Ser. No. 77514177 (T.T.A.B. 2010) (not precedential)
CUMFIESTA; CUMGIRLS	entertainment services regarding adult oriented subject matter transmitted through a global computer network	<i>In re</i> RK Netmedia, Inc., 2009 TTAB LEXIS 389 (T.T.A.B. 2009) (not precedential)

MARK	GOODS, SERVICES	CITATION
	non-alcoholic beverages	<i>In re Shearer</i> , 2009 TTAB LEXIS 374 (T.T.A.B. 2009) (not precedential)
A-HOLE PATROL	online social club that screens jokes submitted by users to control offensive and inappropriate content	<i>In re Jibjab Media, Inc.</i> , 2009 TTAB LEXIS 67 (T.T.A.B. 2009) (not precedential)
	carbonated and non-carbonated soft drinks and energy drinks	<i>In re Kirby</i> , 2008 TTAB LEXIS 156 (T.T.A.B. 2008) (not precedential)
	clothing	Boston Red Sox Baseball Club Ltd. Partnership v. Sherman, 88 U.S.P.Q.2d 1581 (T.T.A.B. 2008)
YOU CUM LIKE A GIRL	clothing	<i>In re Carlson</i> , 2007 TTAB LEXIS 651 (T.T.A.B. 2007) (not precedential)
DE PUTA MADRE	clothing	<i>In re Mexico 69 SRL</i> , 2006 TTAB LEXIS 358 (T.T.A.B. 2006) (not precedential)
BULLSHIT	beverages, wide variety of services	<i>In re Red Bull GmbH</i> , 78 U.S.P.Q.2d 1375 (T.T.A.B. 2006)
W.B. WIFE BEATER	t-shirts	<i>In re Love Bottling Company</i> , 2005 TTAB LEXIS 261 (T.T.A.B. 2005) (not precedential)

MARK	GOODS, SERVICES	CITATION
THE COMPLETE A**HOLE'S GUIDE TO...	series of books providing information relating to advice, counseling, self- help, and humor	<i>In re Zaharoni</i> , 2005 TTAB LEXIS 3 (T.T.A.B. 2005) (not precedential)
THE BEARDED CLAM	restaurant services	<i>In re Douglas</i> , 2004 TTAB LEXIS 524 (T.T.A.B. 2004) (not precedential)
1-800-JACK-OFF; JACK OFF	entertainment in the nature of adult-oriented conversations by telephone	<i>In re Boulevard Entertainment, Inc.</i> , 334 F.3d 1336 (Fed. Cir. 2003)
GRANDMA SCHITTHED'S OUTHOUSE BROWN; GRANDPA SCHITTHED'S INKY STINKY PALE ALE; SCHITTHED'S	beer, ale, restaurant and bar services	<i>In re Frankel</i> , 2002 TTAB LEXIS 250 (T.T.A.B. 2002) (not precedential)
	restaurant and bar services	<i>In re Wilcher Corp.</i> , 40 U.S.P.Q.2d 1929 (T.T.A.B. 1996)
	polo shirts and t- shirts	<i>Greyhound Corp. v. Both Worlds, Inc.</i> , 6 U.S.P.Q.2d 1635 (T.T.A.B. 1988)
a photograph of a nude man and woman kissing and embracing, possibly exposing the male genitalia	newsletter devoted to social & interpersonal relationship topics; social club services	<i>In re McGinley</i> , 660 F.2d 481 (C.C.P.A. 1981)

MARK	GOODS, SERVICES	CITATION
BULLSHIT	personal accessories	<i>In re Tinseltown, Inc.</i> , 212 U.S.P.Q. 863 (T.T.A.B. 1981)
BUBBY TRAP	bras	<i>In re Runsdorf</i> , 171 U.S.P.Q. 443 (T.T.A.B. 1971)
MESSIAS	wine and brandy	<i>In re Sociedade Agricola E. Comerical Dos Vinhos Messias, S.A.R.L.</i> , 159 U.S.P.Q. 275 (T.T.A.B. 1968)
SENUSSI	cigarettes	<i>In re Reemtsma Cigarettenfabriken G.M.B.H.</i> , 122 U.S.P.Q. 339 (T.T.A.B. 1959)
MADONNA	wines	<i>In re P.J. Valckenberg, GmbH</i> , 122 U.S.P.Q. 334 (T.T.A.B. 1959)
AGNUS DEI and pictorial representation	metallic tabernacle safes	<i>Ex parte Summit Brass & Bronze Works, Inc.</i> , 59 U.S.P.Q. 22 (Comm'r Pats. 1943)
MADONNA	wines	<i>In re Riverbank Canning Co.</i> , 95 F.2d 327 (C.C.P.A. 1938)
QUEEN MARY	Underwear	<i>Ex parte Martha Maid Mfg. Co.</i> , 37 U.S.P.Q. 156 (Comm'r Pats. 1938)

APPENDIX B

**Trademarks Found Not to Be Scandalous or Immoral
in the United States**

These are marks that were the basis of opinions from the Trademark Trial and Appeal Board, the Commissioner of Patents and the Federal Circuit Court of Appeals. This list does not include marks that were granted trademark registration by the USPTO outside the scope of an *ex parte* or *inter partes* proceeding.

MARK	GOODS, SERVICES	CITATION
BIG EFFIN GARAGE; BIG F'N GARAGE	online community for musicians and music fans	<i>In re</i> Big Effin Garage, LLC, 2010 TTAB LEXIS 418 (T.T.A.B. 2010) (not precedential)
CUMBRELLA	condoms	<i>In re</i> Gray, Ser. No. 78622783 (T.T.A.B. 2007) (not precedential)
TWATTY GIRL	cartoon strips, cartoon prints and newspaper cartoons	<i>In re</i> Watkins, 2005 TTAB LEXIS 66 (T.T.A.B. 2005) (not precedential)
	sunglasses, tote bags, clothing, tobacco products	Schlage Lock Company v. Staiano, 2005 TTAB LEXIS 543 (T.T.A.B. 2005) (not precedential)
	decorative refrigerator magnets	<i>In re</i> Friggin Barnyard, 1999 TTAB LEXIS 108 (T.T.A.B. 1999) (not precedential)

MARK	GOODS, SERVICES	CITATION
	clothing, beer	<i>In re</i> Bad Frog Brewery, Inc., 1999 TTAB LEXIS 86 (T.T.A.B. 1999) (not precedential)
 OLD GLORY CONDOM CORP	condoms	<i>In re</i> Old Glory Condom Corp., 26 U.S.P.Q.2d 1216 (T.T.A.B. 1993)
	dolls	<i>In re</i> In Over Our Heads, Inc., 16 U.S.P.Q.2d 1653 (T.T.A.B. 1990)
BIG PECKER BRAND	t-shirts	<i>In re</i> Hershey, 6 U.S.P.Q.2d 1470 (T.T.A.B. 1988)
BADASS	bridges of stringed musical instruments	<i>In re</i> Leo Quan Inc., 200 U.S.P.Q. 370 (T.T.A.B. 1978)
	corrective implement for increasing the size of the human penis	<i>In re</i> Thomas Laboratories, Inc., 189 U.S.P.Q. 50 (T.T.A.B. 1975)
WEEK-END SEX	magazines	<i>In re</i> Madsen, 180 U.S.P.Q. 334 (T.T.A.B. 1973)
ACAPULCO GOLD	suntan lotion	<i>In re</i> Hepperle, 175 U.S.P.Q. 512 (T.T.A.B. 1972)
AMISH with the representation of a man in Amish clothing, smoking a cigar	cigars	<i>In re</i> Waughtel, 138 U.S.P.Q. 594 (T.T.A.B. 1963)
LIBIDO	perfumes	<i>Ex parte</i> Parfum L'Orle, Inc., 93 U.S.P.Q. 481 (Pat. Off. Exam'r-in-Chief 1952)