

TOUGH NOOKIE: TRADEMARK'S UNFAIR TREATMENT OF THE "SCANDALOUS" AND THE "IMMORAL"

 **Miley Ray Cyrus** ✓
@MileyCyrus

@fucktyler my "barber" couldn't even come close to the fuck job that is your face. # your right you should shut up. PS your musics dope

12:09 PM - 14 Aug 2012

45,123 RETWEETS 24,056 FAVORITES

 **Rihanna** ✓
@rihanna

So much dick riding that my cock hurt!
instagram.com/p/Onw-HnhMoj/

3:05 AM - 22 Aug 2012

2,210 RETWEETS 1,053 FAVORITES

 **Lucy Hale** ✓
@lucyhale

Bitch crazy.

8:42 PM - 5 Jun 2012

11,501 RETWEETS 2,665 FAVORITES

 **Kate Upton** ✓
@KateUpton

Let's play a little game.. Who's boobs are these??
Hint: they aren't mine =) #boobcam
<http://plixi.com/p/77981558>

12:31 AM - 17 Feb 2011

3 RETWEETS 7 FAVORITES

 **Katy Perry** ✓
@katyperry

@rihanna yo batch lemme borrow those latex dresses!
#slutty #skank #ho #whore #bearcunt #yesyesyes!

3:09 PM - 1 Feb 2011

1,250 RETWEETS 486 FAVORITES

 **ke\$ha** ✓
@keshasuxx

dear bearded guy on laurel canyon using his leaf blower - I have a crush on ur penis.

8:07 PM - 23 Sep 2012

721 RETWEETS 507 FAVORITES

 **Taylor Momsen** ✓
@taylormomsen

Manila, you better be ready to fucking rock cause we're gonna blow the roof of this motherfucker
@bazookarocksph

12:59 AM - 30 Sep 2012

593 RETWEETS 294 FAVORITES

 **Harry Styles** ✓
@Harry_Styles

#ReplaceRihannaSongsWithVagina Pon De Vagina..

2:44 PM - 5 Jan 2012

49,603 RETWEETS 23,047 FAVORITES

 **demetria lovato** ✓
@ddlovato

Oh jesus people, don't get your panties in a wad. I'm not being sexist, I'm being old-fashioned. Can't ever say shit on this thing.

2:30 AM - 14 Mar 2012

10,821 RETWEETS 4,471 FAVORITES

 **Nicki Minaj** ✓
@NICKIMINAJ

ok but simba is a pussy too so... *directs u to nearest exit* > RT @iRide4Her_: @NICKIMINAJ Pop Dat Nala For A Real Simba #FreaksVideo

1:13 PM - 7 Mar 2013

719 RETWEETS 543 FAVORITES

Victoria Nemiah

Advanced Trademark Law (LAW-LW.11692.1.001.SP13)
Professors David H. Bernstein and Barton Beebe

I. INTRO

Nobody even tells you, when you're a kid, what the words are that you're supposed to avoid. You have to say them to find out which ones they are. "SHIT!" [*slapping noise*] "OH, FUCK!" [*slapping noise*] That's two! Oh, ma, that's enough trial and error, huh? Please ma, give me a list, huh? "Alright, you're six years old now, and here's the list of words your dad and I don't ever want to hear you say." Oh, hey, thanks ma. Boy, that's going to save me an ass-kicking or two! [*slapping noise*]. ... The trouble is, I was trying to find out what these words might be, and I wanted to know the ones that you could never say on television. I mean the filthy words that are always filthy. There are a lot of these little two-way double entendre words that have two meanings; words that they're ok part of the time. I call them like 'part-time filth.' ... You have words like 'ass': ass is hardly even a dirty word anymore, but it has a few meanings that you can't say on television. ... Ass is all right on television; you can say on television things like "Well, you've made a perfect ass of yourself tonight!" But you can't say "Hey, let's go get some ass!" ... We have so many ways of describing these dirty words; well we have more ways to describe dirty words than we actually have dirty words! ... They kept referring to them; they called them 'bad' words, dirty, filthy, foul, vile, vulgar, coarse, in poor taste, unseemly, street talk, gutter talk, locker room language, barracks talk, bawdy, naughty, saucy, raunchy, rude, crude, lewd, lascivious, indecent, profane, obscene, blue, off-color, risqué, suggestive, cursing, cussing, swearing, and all I could think of was **shit, piss, fuck, cunt, cocksucker, motherfucker, and tits!** ... That was my original list. I knew it wasn't complete, but it was a starter set, you know?

-George Carlin, *On Location: George Carlin at Phoenix* (1978)¹

It's been 35 years since Carlin delivered this monologue, but not much has changed. The Supreme Court, in a 2012 opinion, held that it was unconstitutional for the Federal Communications Commission (FCC) to implement a new policy banning the use of "fleeting" expletives (as contrasted to repeated use of expletives) without first providing notice to networks, but declined to rule on whether such a ban itself was unconstitutional.² This meant that the court's 1978 decision in *FCC v. Pacifica Foundation* (which upheld as constitutional the FCC's ban of the seven words in Carlin's "Filthy Words" monologue³) remained untouched, as did the

¹ Available at <http://www.youtube.com/watch?v=vbZhpF3sQxQ>.

² *F.C.C. v. Fox Television Stations, Inc.*, 132 S. Ct. 2307, 2320 (2012).

³ *F.C.C. v. Pacifica Found.*, 438 U.S. 726 (1978).

FCC's later policy-expanding decision to "assess the full context of allegedly indecent broadcasts rather than limit its regulation to an index of indecent words or pictures".⁴

An alert reader may be confused as to the relevance of the FCC's policing of offensive language on the nation's airwaves to the topic of this paper, the refusal of the US Patent and Trademark Office (PTO) to register marks that include words or depictions it finds to be "scandalous" or "immoral". However, there is an important parallel between the two: neither the FCC nor the PTO works from a published list of indecent expressions, and a quick look at the historical pattern of fines and rejections (respectively) by the two organizations demonstrates just how arbitrary the policing of social mores in both trademarks and broadcasting has become.

This paper seeks to address first the murky and contradictory applications of the Lanham Act's provision against "immoral" and "scandalous" marks. I first consider the history of bans on scandalous trademarks. Next, I examine the problems with the current system, using these as a springboard to discuss important considerations that must factor into any attempt to retool the system. Lastly, I propose several changes Congress, trademark examiners, and the judiciary could make in their approach to the registrability of trademarks.

II. THE HISTORY OF TRADEMARK'S "SCANDALOUSNESS"

To understand how the current policies restricting "scandalous" trademarks came to be, one must go back more than one hundred years. At common law, marks or products considered "immoral" or "against public policy" were denied protection.⁵ The first statutory systems for trademark protection, registered in 1881 and 1882, did not specify an outright ban on immoral or scandalous marks, stating only that "no alleged trade-mark shall be registered unless the same

⁴ *Fox Television Stations*, 132 S. Ct. at 2309.

⁵ Jennifer E. Rothman, *Sex Exceptionalism in Intellectual Property*, 23 STAN. L. & POL'Y REV. 119, 122 (2012).

appears to be lawfully used.”⁶ In 1905, however, another Trademark Act was passed, providing further restrictions on the registrability of such marks. That Act stated that “no mark ... shall be refused registration as a trademark on account of the nature of such mark unless such mark ... [c]onsists of or comprises *immoral or scandalous matter*....”⁷ In 1946, Congress passed the Lanham Act, setting out a new scheme of federal trademark protection and registration.⁸ Section 2 of the Lanham Act reads as follows:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises *immoral, deceptive, or scandalous matter* ...⁹

Following Congress’s lead, many states have also added a ban on immoral or scandalous language and illustrations.¹⁰ Though the PTO’s (or state’s) refusal to register a mark does not affect the right to use the mark¹¹, marks declared scandalous under both federal and state provisions are relegated to the protection offered to unregistered marks, and miss out on the additional protections conferred upon registered marks (such as nationwide priority).

Notably missing from both the 1905 and 1946 Acts is any explicit definition of what qualifies as “immoral” or “scandalous”. There is also little legislative history concerning Congress’s general intent in creating these exclusions from registrability.¹² Left without guidance on the definitions or scope of these words, courts have chosen to “give to the word ‘scandalous’ its ordinary and common meaning.”¹³ *In re Riverbank Canning Co.*, the first court case to

⁶ DAPHNE ROBERT, *THE NEW TRADE-MARK MANUAL: A HANDBOOK ON PROTECTION OF TRADE-MARKS IN INTERSTATE COMMERCE* 272 (1947) (quoting §3 of the 1881 Act).

⁷ §5(a) of the Trade-Mark Act of 1905, 15 USC §85(a) (1905), emphasis added.

⁸ 15 U.S.C. § 1051 et seq.

⁹ § 1052, emphasis added.

¹⁰ *See, e.g.*, Miss. Code Ann. § 75-25-3(a) (West 2011); Wash. Rev. Code Ann. § 19.77.020(1)(a) (West 2011); W. Va. Code Ann. § 47-2-2(1) (West 2011).

¹¹ *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981).

¹² TMEP § 1203.01.

¹³ *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938).

address scandalousness, relied on dictionary definitions to define the scope of scandalousness, and considered such definitions as “[c]ausing or tending to cause scandal”, “shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable”, and “[g]iving offense to the conscience or moral feelings; exciting reprobation; calling out condemnation.”¹⁴ In *In re Runsdorf*, the Trademark Trial and Appeal Board (TTAB) subsequently ruled that scandalousness encompassed expressions that were “vulgar”, or “lacking in taste, indelicate, morally crude”.¹⁵ A later case also held that in defining what is scandalous, it is appropriate to supplement dictionary definitions with court and TTAB decisions.¹⁶ Earlier cases tended to center on proposed marks’ “scandalous” nature, rather than considering the marks’ status as “immoral”, and later cases—noting this dearth of case law on immorality—have folded one into the other, choosing to focus mainly on a mark’s scandalousness when deciding whether to grant registration.¹⁷

Finally, the CCPA’s ruling in *McGinley* in 1981 put to bed an objection many had taken with the lack of specificity within 2(a): its potential unconstitutionality. *McGinley*, appealing the TTAB’s affirmance of an examiner’s decision to reject two applications on 2(a) grounds, argued that section 2(a) was constitutionally “void for vagueness”, pointing to the lack of established definition of “scandalousness”.¹⁸ The CCPA held that 2(a) did not violate the First Amendment, pointing out that “[n]o conduct is proscribed, and no tangible form of expression is suppressed.”

¹⁹ The court contrasted 2(a) to the FCC’s ban on language in *Pacifica*, pointing to the fact that when a mark is rejected under 2(a), the public is not denied access to that material. While

¹⁴ *Id.* (quoting Funk & Wagnalls New Standard Dictionary and Webster’s New Standard Dictionary).

¹⁵ *In re Runsdorf*, 171 USPQ 443 (TTAB 1971).

¹⁶ *In re McGinley*, 660 F.2d at 485.

¹⁷ *See id.* at 484 n.6 (“Because of our holding, *infra*, that appellant’s mark is ‘scandalous,’ it is unnecessary to consider whether appellant’s mark is ‘immoral.’ We note the dearth of reported trademark decisions in which the term ‘immoral’ has been directly applied.”)

¹⁸ *Id.* at 483.

scholars have continued to write on the unconstitutionality of 2(a),²⁰ there has yet to be a successful challenge to the statute on constitutional grounds.²¹

III. THE CURRENT STATE SCANDALOUSNESS OF TRADEMARK LAW

In more recent cases, the context in which a mark's potential scandalousness should be measured has been further specified. In 1994, the US Court of Appeals for the Federal Circuit, which had taken over the CCPA's docket and jurisdiction, heard *In re Mavety Media Group*. In deciding whether the mark in question was scandalous, it cautioned that "we must be mindful of ever-changing social attitudes and sensitivities."²² It pointed out that many popular elements of violence and sexual activity featured in popular media at the time of the decision would have left the previous generation's audience "aghast".²³ Specifically, it contrasted older decisions that found scandal in marks like BUBBY TRAP (for bras),²⁴ MESSIAS (for wine and brandy),²⁵ MADONNA (for wine),²⁶ and QUEEN MARY (for women's underwear)²⁷ with more recent decisions that didn't find scandal to be present in regards to marks like OLD GLORY CONDOM CORP (with stars and stripes design, for condoms),²⁸ BIG PECKER BRAND (for t-shirts),²⁹ BADASS (for bridges on stringed instruments),³⁰ and WEEK-END SEX (for magazines).³¹ In a more recent decision, the TTAB made this point about changes in the history of 2(a) decisions

¹⁹ *Id.* at 484.

²⁰ See, e.g., Robert H. Wright, *Today's Scandal Can Be Tomorrow's Vogue: Why Section 2(a) of the Lanham Act Is Unconstitutionally Void for Vagueness*, 48 *HOW. L.J.* 659 (2005).

²¹ *Id.* at 672.

²² *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

²³ *Id.*

²⁴ *In re Runsdorf*, 171 USPQ 443 (TTAB 1971).

²⁵ *In re Sociedade Agricola E. Comerical Dos Vinhos Messias, S.A.R.L.*, 159 USPQ 275 (TTAB 1968).

²⁶ *In re Riverbank Canning Co.*, 95 F.2d 327, 37 USPQ 268 (CCPA 1938); *In re P.J. Valckenberg, GmbH*, 122 USPQ 334 (TTAB 1959).

²⁷ *Ex parte Martha Maid Mfg. Co.*, 37 USPQ 156 (Comm'r Pats.1938).

²⁸ *In re Old Glory Condom Corp.*, 26 USPQ2d 1216 (TTAB 1993).

²⁹ *In re Hershey*, 6 USPQ2d 1470 (TTAB 1988).

³⁰ *In re Leo Quan Inc.*, 200 USPQ 370 (TTAB 1978).

³¹ *In re Madsen*, 180 USPQ 334 (TTAB 1973).

even more explicit, holding that an examiner may not cite solely to a previous case in which a word has been ruled scandalous when rejecting an application for a mark featuring the same word,³² but suggesting that examiner could cite a prior decision in conjunction with dictionary excerpts to establish a *prima facie* case of scandalousness.³³

Mavety also addressed the evidentiary burden involved in a case regarding an application for a federal trademark. In a previous 1967 decision, the CCPA had held that the PTO carries the burden of proving that a trademark's registration is prohibited by § 1052.³⁴ However, *Mavety* noted that the PTO could discharge its burden to prove scandalousness through the use of "evidence such as consumer surveys regarding the substantial composite of the general public."³⁵

Courts have also explored how to measure the potential for offense that a mark threatens. Certainly, a mark featuring an illustration of a pair of breasts is far more likely to be "scandalous" if used on children's milk boxes in a grocery store than if used on a line of pornographic films sold only in adult video stores. The TTAB in *In re Madsen* held that when assessing for scandalousness, only the *mark* that should be evaluated as scandalous, not the *good*. Otherwise, it noted, "many well-known [pornographic] magazines with inoffensive or arbitrary titles might well have been precluded registration."³⁶ In *In re McGinley*, the court held that a mark must be evaluated "in the context of the marketplace as applied to only the goods or services described in the application for registration."³⁷ This 'marketplace' application is useful when cases arise where a mark is subject to two readings (Carlin's "part-time filth"), as in

³² *In re Red Bull GmbH*, 78 USPQ2d 1375, 1381 (TTAB 2006) ("The examining attorney contends that the finding in *Tinseltown*, ... is sufficient to warrant the same finding in this case. However, we must look at the facts underlying that decision to determine, first, if it has any relevance to the case before us; and, if so, we must determine whether that 1981 finding is equally applicable today.").

³³ *Id.* at 1382.

³⁴ *In re Standard Elektrik Lorenz Aktiengesellschaft*, 371 F.2d 870, 873 (CCPA 1967).

³⁵ *In re Mavety Media Group*, 33 F.3d at 1374.

³⁶ *In re Madsen*, 180 USPQ at 335.

³⁷ *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981).

Mavety where the court considered whether the relevant marketplace would interpret the word “tail” in the mark BLACK TAIL as a vulgar reference to a “female sexual partner” or a non-vulgar reference to a “rear end”.³⁸ Similarly, in *Greyhound Corp v. Both Worlds*, the TTAB considered that the marketplace for t-shirts was “sales establishments patronized by a wide variety of people of all ages and convictions”, and that wearers of t-shirts might appear in “virtually all public places” before holding that a t-shirt with a “graphic portrayal of a dog in the act of defecating, including the depiction of the feces” was scandalous.³⁹

In re McGinley also addressed the question of *who* must be scandalized. Citing *Riverbank Canning* as the source of its rule, the CCPA wrote that “[w]hether or not the mark, including innuendo, is scandalous is to be ascertained from the standpoint of not necessarily a majority, but a substantial composite of the general public.”⁴⁰ In his dissent in *McGinley*, however, Judge Rich wrote, “[t]here is no such expression in *Riverbank* and I am at a loss to know what it means or how one can have a ‘composite’ of a class such as ‘the general public.’”⁴¹ *Mavety*, acknowledging the difficulty of averaging a “single objective measure” from the “myriad of subjective viewpoints”, deferred to the *McGinley* standard, suggesting that even if the circuit panel found the mark scandalous, “appellate judges ... represent only a tiny fraction of the whole [general public]”.⁴² A later case echoed this sentiment, holding that “the personal opinion of the examining attorney cannot be the basis for a determination that a mark is scandalous”.⁴³

Lastly, the TTAB and courts have demonstrated their approach to marks that flirt with sexual meanings or other forms of impropriety. In *In re Hershey*, the mark under consideration

³⁸ *In re Mavety Media Group*, 33 F.3d at 1374.

³⁹ *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1639 (TTAB 1988).

⁴⁰ *In re McGinley*, 660 F.2d at 485.

⁴¹ *Id.* (Rich, J., dissenting).

⁴² *In re Mavety Media Group*, 33 F.3d at 1371.

⁴³ *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1340 (Fed. Cir. 2003).

was BIG PECKER BRAND as a mark for t-shirts. The application, though it only sought registration of the textual mark, included a specimen in the form of a label, which displayed the text “Seaside Graphics/Big Pecker Brand”, the business’s New Jersey address, and an illustration of a smiling rooster’s head.⁴⁴ While admitting that the bird design could be removed at any time, the TTAB decided that the label buttressed the applicant’s claim that it did not intend to refer to male genitalia.⁴⁵ The Board ultimately held the mark to be a permissible double entendre, and reversed refusal. However, in another case, the Board held the mark BEARDED CLAM to be a vulgar reference to female genitalia, despite evidence submitted by the applicant that the phrase could refer to thread-like filaments that allow clams to attach to stationary objects.⁴⁶ Ultimately, outcomes in double entendre cases are highly unpredictable. One group of scholars writes that “[t]he PTO and the courts will accept nearly any plausible explanation or other means of defusing offensive interpretations of the mark in allowing registration, absent profanity or unavoidably disgusting imagery.”⁴⁷ However, writing on the discrepancy between the BIG PECKER and BEARDED CLAM cases, another scholar has claimed that in the latter case, “it seems that the disfavoring of female genitalia trumped the availability of an alternative meaning of the word.”⁴⁸

IV. ISSUES WITH THE CURRENT SYSTEM

A. Discrepancies in Examiners’ Approaches

⁴⁴ *In re Hershey*, 6 USPQ2d 1470, 1472 (TTAB 1988).

⁴⁵ *Id.*

⁴⁶ *In Re Jim Douglas & David Watson*, 2004 WL 2202264 (TTAB 2004) (“... the evidence of use of the term “beard” to describe mucous-like threads that are used by a clam to attach itself to rocks or other objects is very sparse, and obviously does not show use of the specific term “bearded clam” in ordinary discourse.”).

⁴⁷ M. Christopher Bolen, et. al., *When Scandal Becomes Vogue: The Registrability of Sexual References in Trademarks and Protection of Trademarks from Tarnishment in Sexual Contexts*, 39 IDEA 435, 451 (1999).

⁴⁸ Rothman, *supra* note 5, at 126.

Because examiners must evaluate marks in the context of the “relevant marketplace” and decide whether a “substantial composite” of the public would consider the marks to be scandalous, a certain amount of examiners’ experience with and opinions on popular culture is necessarily implicated. For instance, an older examiner with children of his or her own might have a different take on what types of marks would scandalize a substantial composite of the public than would an examiner fresh out of law school who often frequented bars and clubs. Similarly, an examiner raised in a religious household might see things differently than one raised as an atheist. One’s perception of what the rest of the world finds acceptable is necessarily colored by one’s own experiences, and this makes for an unreliable, and at times hypocritical, system.

For instance, consider the term “jizz.”⁴⁹ In November 2003, a New Jersey man applied for the mark “JIZZ” for use on household cleaning products.⁵⁰ In June 2004, Trademark Examiner Steven Foster sent an outgoing office action to the applicant, explaining that he had refused registration under Section 2(a). He enclosed with the action several definitions “showing the term to be either ‘usually considered vulgar’ or ‘usually objectionable’ as a term meaning ‘semen’ or ‘to ejaculate semen’.”⁵¹ By January 2005, with no response from the applicant, the mark was considered abandoned. Several years later, in January 2011, an Oklahoma applicant requested registration of “JIZZ” for aftershave, sunscreen products, and lip balm.⁵² The applicant cited a World English dictionary definition of the term as “[noun] a term for the total

⁴⁹ For those who are unfamiliar, “jizz”, which the Random House Historical Dictionary of American Slang lists as a shortened form of “jism”, is defined by Urban Dictionary as “[o]ne of many slang words for semen”. Bladesage, *Jizz definition*, URBANDICTIONARY.COM, <http://www.urbandictionary.com/define.php?term=jizz>.

⁵⁰ U.S. Trademark Application Serial No. 78325173 (filed Nov. 08, 2003).

⁵¹ *Id.*, Office Action Outgoing (Jun. 15, 2004).

⁵² U.S. Trademark Application Serial No. 85225675 (filed Jan. 25, 2011).

combination of characteristics that serve to identify a particular species of bird or plant.”⁵³ The examining attorney, William Verhosek, logged a note in the file that he had searched Google, OneLook, and Wikipedia,⁵⁴ and on May 31, 2011, the applicant was sent notice of publication. Two months later, the applicant was sent notice of allowance, and the application is currently live, pending a statement of use (for which three extensions have been granted).⁵⁵

This uneven application of the rules for considering scandalousness isn’t limited to examiners, either. In *In re McGinley*, the CCPA affirmed an examiner’s refusal to register a mark featuring a photograph of a nude couple kissing in which the man’s genitalia was visible.⁵⁶ The application stated the mark would be used for “‘Newsletter Devoted to Social and Interpersonal Relationship Topics’ and ‘Social Club Services.’”⁵⁷ Investigating further the submitted newsletter specimen, the court found one topic of the newsletter to be swinging, which it explained “appears to be a form of group sex.”⁵⁸ The examiner rejected the application because “[s]uch activities are considered deviations from the sexual norm of husband and wife relations. Such activities are immoral or scandalous....”⁵⁹ While the CCPA claimed not to consider the nature of the goods in upholding the refusal, even citing to *In re Madsen* that only the mark itself should be considered for scandalousness, Judge Rich wrote in his dissent that he found the majority’s opinion “lacking in factual foundation on the main issue of whether the picture sought to be registered as a trademark is ‘scandalous’ when used on the goods and services named in the application.”⁶⁰ Judge Rich disputed the contention that the illustration “appeared” to expose the

⁵³ *Jizz definition*, DICTIONARY.REFERENCE.COM, <http://dictionary.reference.com/idioms/jizz> (last visited May 19, 2013).

⁵⁴ U.S. Trademark Application Serial No. 85225675, Notation to File (Apr. 25, 2011).

⁵⁵ *Id.*, ITU Extension Approval (Jan. 26, 2013).

⁵⁶ *In re McGinley*, 660 F.2d 481, 482 (C.C.P.A. 1981).

⁵⁷ *Id.*

⁵⁸ *Id.*

⁵⁹ *Id.*

⁶⁰ *Id.* at 487, (Rich, J., dissenting).

male's genitalia, arguing that the majority should have decided either that it *did* expose such a display or that it *did not*, and in his own opinion it did not.⁶¹

In an attempt to impose order on chaos, several scholars have tried to delineate categories of trademarks that tend to be rejected as scandalous. One argues that “[t]he three dominant categories of marks deemed scandalous or immoral are those that refer to a specific religion in the context of selling a forbidden item under that religion's precepts (such as Koran as a mark for wine), marks referring to defecation or urination, and marks referring to sex.”⁶² Another suggests that the foremost categories of rejections are “Religion and Ethnicity”, “Sexual References”, “Drug References”, “Violence”, “Patriotism”, and “Profanity and Vulgarity”.⁶³

B. Single-Examiner Review Process

Under the current system of trademark application reviewing, a single PTO examiner may often make the decision that a mark is scandalous without consulting anyone else.⁶⁴ Some examining attorneys may choose to consult with a managing attorney, but the PTO does not require this second opinion in order to dispatch a refusal under 2(a). Professor Jennifer Rothman, in her critique on sex exceptionalism in intellectual property, points out that absent any appeal, the decisions made by these examiners are final. She expresses concern that, given the low rates of TTAB appeals (and even lower rates of Federal Circuit appeals from the TTAB), the rates of rejection for scandalous marks are even higher than much of the literature, which often focuses on appeals, would suggest.⁶⁵

⁶¹ *Id.*

⁶² Rothman, *supra* note 5, at 123.

⁶³ Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*, 101 TRADEMARK REP. 1476, 1510–32 (2011).

⁶⁴ Rothman, *supra* note 5, at 123.

⁶⁵ *Id.*

C. Unrepresentativeness of Examiners

In considering the biases that may be present among examiners and the judiciary, it's important to consider who they each are. Neither is fully representative of the US population at large: to become either a trademark examiner or a judge, one must obtain a law degree. Most judges work as attorneys before becoming judges, meaning that the average judge is older than the average attorney. In fact, of the 1,200 sitting federal district and circuit judges, around 12 percent are 80 or older.⁶⁶ As of 2010, the average age of a trademark examiner was 55 years old, with the average examiner having given the office 27 years of service.⁶⁷ [In addition, compared to the general population, the PTO (including other offices, like the patent office) has a larger representation of Asian and African-American examiners, but lower representations of American Indian, Hispanic, and White examiners.⁶⁸] These sometimes drastic age and cultural differences between an examiner/judge and the intended audience of a product whose mark is under consideration can lead to outcomes far more conservative than a “substantial composite” of the general public would dictate. As Richard Posner has written, “judges know next to nothing about sex beyond their own personal experience, which is limited, perhaps more so than average, because people with irregular sex lives are pretty much ... screened out of the judiciary.”⁶⁹

D. Systemic Preference for Clinical Terms

⁶⁶ Joseph Goldstein, *The Oldest Bench Ever*, SLATE.COM (Jan. 18, 2011, 7:01 AM), http://www.slate.com/articles/news_and_politics/jurisprudence/2011/01/the_oldest_bench_ever.html.

⁶⁷ USPTO, 2011-2015 STRATEGIC HUMAN CAPITAL PLAN 32 (2011), *available at* http://www.uspto.gov/about/stratplan/USPTO_2011-2015_Strategic_Human_Capital_Plan.pdf.

⁶⁸ Breakdown by ethnicity of PTO and US Census data:

	American Indian	Asian	African American/Black	Hispanic	White
PTO (FY 2010)	0.4%	26.7%	22.8%	2.6%	47.5%
US Census 2010	0.9%	4.8%	12.6%	16.3%	72.4%

Note that due to the US Census's differing approach towards the classification “Hispanic”, Census percentages don't add up to 100%. *Id.* at 31; UNITED STATES CENSUS BUREAU, OVERVIEW OF RACE AND HISPANIC ORIGIN: 2010 at 4, *available at* <http://www.census.gov/prod/cen2010/briefs/c2010br-02.pdf>.

⁶⁹ RICHARD A. POSNER, SEX AND REASON 1 (1992).

In conducting research on instances of rejection or approval of marks featuring various scandalous or immoral language or depictions, an odd pattern emerges.⁷⁰ The words “penis” and “vagina”, for instance, are ok, but “cock” and “pussy” are often rejected where there isn’t another possible meaning in the context of the mark (such as the implication of a rooster or cat). In 2003, an application was filed for the mark MY PENIS for use in conjunction with body lotions and gels.⁷¹ By June 2004, it had made it through the process and was granted registration.⁷² In contrast, a much more recent application was filed in 2012 for the mark GOT COCK. An examiner quickly rejected the application, explaining that dictionary evidence demonstrated that “COCK is a vulgar term meaning ‘penis’,” and that the vulgarity of “cock” was sufficient to establish its scandalousness.⁷³ Even such potentially offensive constructions as ON THE WRONG END OF THE PENIS have been registered.⁷⁴ Similarly, I LOVE VAGINA was permitted registration,⁷⁵ but HELLO PUSSY was denied, because even though “the term ‘PUSSY’ could also refer to a cat”, it is a “highly offensive and taboo term for female genitals.”⁷⁶

This distinction between clinical terms and slang terms (which also applies to such pairs as SEMEN versus JIZZ/CUM and FECES versus SHIT) seems an odd one in the context of modern society, where much legitimate discussion of sexual topics is conducted with an informal air. Take, for instance, the mark TOUCH YOUR TITS, which the application stated would be used for “[c]haritable fund raising services.”⁷⁷ Ultimately, I believe the distinction between clinical and casual terms for anatomy is one not easily justified, as the context of use ultimately

⁷⁰ For a table of historical PTO rejections and approvals of various terms, see Appendix A.

⁷¹ U.S. Trademark Application Serial No. 78218847 (filed Feb. 25, 2003).

⁷² MY PENIS, Registration No. 2853632.

⁷³ U.S. Trademark Application Serial No. 85535653 (filed Feb. 7, 2012).

⁷⁴ ON THE WRONG END OF THE PENIS, Registration No. 3398617.

⁷⁵ I LOVE VAGINA, Registration No. 3364871.

⁷⁶ U.S. Trademark Application Serial No. 77906546 (Jan. 6, 2010).

has much more bearing on the mark's potential to scandalize. Further, this distinction isn't cleanly enforced: both MASTURBATE and JACK OFF are off limits to applicants, while WANKER has been approved in certain instances.

E. Pursuant Neglect of 2(a)'s Other Limitations

You may recall that section 2(a) prohibits registration of marks that are “immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute....”⁷⁸ Research into the rejection of potentially offensive or scandalous marks, however, shows that examiners use 2(a) mostly as a mechanism for rejecting such scandalous terms as SHIT, FUCK, ASSHOLE, and JACK OFF. While marks offensive to religious or ethnic groups are often rejected under 2(a), they are often still rejected for being “scandalous”, rather than disparaging.⁷⁹ In the midst of this, disparagement against one class in particular has fallen by the wayside: many terms considered disparaging to women are almost universally allowed registration, including words like BITCH, WHORE, HO, SLUT, and SKANK. Nor are these words used in the subtle double-entendre style that sometimes helps words like COCK and PUSSY evade rejection under 2(a). INSIDE EVERY GOOD GIRL IS A

⁷⁷ U.S. Trademark Application Serial No. 77883100 (Dec. 1, 2009).

⁷⁸ 15 U.S.C. § 1052(a).

⁷⁹ See, e.g., U.S. Trademark Application Serial No. 77309301 (filed Oct. 20, 2007) (rejecting BLACKS AGAINST NIGGERS as “scandalous” under 2(a)). But see U.S. Trademark Application Serial No. 77600757 (filed Oct. 26, 2008) (rejecting BEANER BAR as disparaging Mexican immigrants per 2(a)).

KINKY BITCH,⁸⁰ SHANK THE B!T@H,⁸¹ DEAD WHORE RIVER,⁸² MUD SLUT,⁸³ and SKANKTEES.COM⁸⁴ have all been permitted registration.

V. CONSIDERATIONS IN DESIGNING AN ALTERNATIVE SYSTEM

A. *Who Our Current System Benefits*

The first step in analyzing the current system is to consider for whose benefit it was put in place. In their article on section 2(a), Anne Gilson LaLonde and Jerome Gilson lay out three rationales for the 2(a)'s ban of scandalousness: (1) a refusal to spend taxpayer money on inappropriate trademarks, (2) a refusal to put a government stamp of approval on inappropriate trademarks, and (3) the protection of consumers' sensibilities.⁸⁵ In *In re McGinley*, the CCPA certainly argued that the first of the above rationales was the true motivation behind 2(a): the court claimed that it 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."⁸⁶ However, as LaLonde and Gilson note, the costs of the federal trademark system have been fully covered by user fees for years.⁸⁷ The government has been clear that the second rationale is not relevant to 2(a): in *Old Glory Condom*, the TTAB wrote that, "[j]ust 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

⁸⁰ INSIDE EVERY GOOD GIRL IS A KINKY BITCH, Registration No. 3612237.

⁸¹ U.S. Trademark Application Serial No. 85301216 (filed Apr. 21, 2011) (notice of allowance issued; registration pending filing of statement of use).

⁸² DEAD WHORE RIVER, Registration No. 3186066.

⁸³ MUD SLUT, Registration No. 3223942.

⁸⁴ SKANKTEES.COM, Registration No. 3928938 (mark includes graphic of woman bending over to expose her panties beneath her dress).

⁸⁵ LaLonde & Gilson, *supra* note 63, at 1482–87.

⁸⁶ *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981).

analogous, sense.”⁸⁸ This leaves only the third rationale, the protection of consumer sensibilities. LaLonde and Gilson argue that if there does exist a desire by the government to protect the public from profanity, 2(a) is an ineffective way to do so, as the owner of a rejected, unregistered mark is still able to use the mark commercially; he is simply denied the protection afforded to registered marks.⁸⁹ While the authors do not ultimately determine whether this motivation is a driving one in the continued existence of 2(a), I argue that even if the government wishes to protect the public from impropriety, this is a fool’s errand. I believe that in the context of today’s expansive and uncensored internet culture, especially given the types of sentiment publicly expressed on forums like Twitter and Facebook or visible in Google search results and pop-up ads, the government will be unable to shield the public’s eyes from such scandalousness. Further, the increasing popularity of cable television channels (like HBO) and satellite radio mean that the FCC’s attempts to regulate the airwaves are likewise becoming Sisyphean. Lastly, if we decide that we should use some standard to filter inappropriate marks, the question naturally arises: whose standard should we use? While examiners and judges purport to apply the “substantial composite” test, there seems to be a large element of personal bias or assessment inherent in various rejections. Professor Jennifer Rothman argues that “[t]he law’s construction of sex has largely been a negative one, in which sex—unless it is in service to other state-approved goals (such as procreation or marital intimacy)—is devalued and feared” and that courts often end up imposing their views of “what constitutes ‘good sex.’”⁹⁰ Ultimately, the yardstick by which we measure scandalousness should be influenced by the group we are seeking to protect or benefit.

⁸⁷ The authors note that the process of converting to a user-funded agency was complete by 1991. *See* Revision of Patent and Trademark Fees, 56 Fed. Reg. 65142 (1991).

⁸⁸ *In re Old Glory Condom Corp.*, 26 USPQ2d 1216, *5, n.3 (TTAB 1993).

⁸⁹ LaLonde & Gilson, *supra* note 63, at 1485–86.

B. How to Achieve Consistent, Current Standards

If, however, we can find a justification for continuing to police the propriety of registered trademarks, we should reevaluate the success of the current system at “keeping up with the times.” No one who has done a full review of the literature and case law on 2(a) can sincerely claim that there is not an element of adaptation within our current system, though scholars of the subject do often enjoy expressing umbrage over the hypocrisy displayed by a contrasting rejection and acceptance that happened a decade or more apart.⁹¹ To see the evolution of the current system, one need only look at the word “penis”: no mark containing the word “penis” achieved registration until 2009,⁹² despite 18 applications containing the word having been filed between 1992 and 2008. However, the current system has not been flexible enough to progress in lockstep with popular culture.⁹³ Thus, in considering alternative systems, care must be taken to allow for future acceptance of words today considered scandalous.

C. Whether A Ban on Scandalous Marks is Necessary

While I have already addressed above the fact that modern technology is rendering otiose the government’s attempts to shield children and other impressionable audiences from uncouth language, another force may make 2(a) unnecessary: cultural evolution. The incidence of swearing has increased among children in the last few decades,⁹⁴ and studies in other countries

⁹⁰ Rothman, *supra* note 5, at 119–20.

⁹¹ *See, e.g.*, Rothman, *supra* note 5, at 164 (protesting the affirmed rejection of “the cheekily-named mark Bubby Trap for a bra” (in 1971) and contrasting to acceptance of Hooters Restaurant’s “owl/breast logo” (in 1985)).

⁹² MY PENIS, Registration No. 3582316.

⁹³ For example, in 2005, the mark ASS LIKE WHOA was rejected as scandalous. U.S. Trademark Application Serial No. 78587507 (filed Mar. 15, 2005) (explaining that “like whoa” means “extreme”, thus making clear that the word “ass” was intended to refer to buttocks). A mere two years later, the PTO had caught up to the public usage of “ass” and registered EXTREME ASSES without incident. EXTREME ASSES, Registration No. 3359356.

⁹⁴ *Children Are Swearing More Often, At Earlier Age*, PSYCHCENTRAL (Sept. 22, 2010), <http://psychcentral.com/news/2010/09/22/children-are-swearing-more-often-at-earlier-age/18596.html>.

show that use of expletives is becoming increasingly acceptable elsewhere as well.⁹⁵ As words lose their power to shock and disgust, a system based on “scandalousness” loses relevance. One scholar suggests that allowing registration of certain (pornographic) trademarks can encourage racism, sexism, and homophobia,⁹⁶ but offers no evidence that in the absence of such registration, such marks (or their bigotry-laced sentiments) would not exist. Ultimately, in a perfect exposé of the current system’s flaws, Justice Stephen Breyer once asked, “what sense does it make to forbid selling to a 13-year-old boy a magazine with an image of a nude woman, while protecting a sale to that 13-year-old of an interactive video game in which he actively, but virtually, binds and gags the woman, then tortures and kills her?”⁹⁷

VI. PROPOSED ALTERNATIVE APPROACHES

A. Adapt the Current System to Use Additional Resources in Determinations

The easiest option for altering the current system of rejecting “scandalous” marks would be to tweak slightly the ways in which examiners measure scandalousness. This approach presents one key advantage: it requires no intervention on the part of Congress or even the PTO. Courts could easily build improved criteria for proving scandalousness into the case law, as examiners often cite to case law when making a 2(a) determination. Chief among available options for more quantitative criteria is survey evidence. While *Mavety* mentioned surveys as a way for the PTO to discharge its burden in showing scandalousness, the PTO has not availed itself of such an approach. I would suggest that, since the PTO may well not wish to rely on the credibility of an applicant-run survey, an applicant who faces 2(a) refusal should be offered the

⁹⁵ See, e.g., *Swear words more acceptable?*, MSN NZ (Mar. 30, 2010, 2:00 AM), <http://news.msn.co.nz/haveyoursay/1033725/swear-words-more-acceptable>; Jon Swaine, *Britons 'swear 14 times a day on average'*, THE TELEGRAPH (Jan 16, 2009, 7:33 AM), <http://www.telegraph.co.uk/news/uknews/4268304/Britons-swear-14-times-a-day-on-average.html>.

option to pay an additional sum to fund a PTO-run survey of the mark's potential to scandalize. Additionally, LaLonde and Gilson suggest two other sources of potential guidance for examiners. First, they propose that examiners be instructed to treat 3rd-party registrations of similar marks as non-binding precedent.⁹⁸ Second, they argue that the Trademark Manual of Examining Procedure (TMEP) should be supplemented with more detailed advice for examiners on how to make a determination of scandalousness.⁹⁹ While both approaches would need to be crafted so as to allow for evolution, they would offer an increase in the internal consistency of PTO decisions.

B. Adapt the Current System by Delegating Determination to Others

Another option available to the PTO is the delegation of “scandalousness” determinations. At a minimum, the PTO could form a committee of examiners whose sole focus was making determinations of scandalousness under 2(a). Under such a system, examiners who believed an application's mark had the potential for scandalousness would refer the mark to the committee for a more in-depth review. By routing such decisions through a small committee, decisions would become more consistent, and new guidelines could be easily issued to committee members where the PTO wished to alter past policies. LaLonde and Gilson take this approach one step further, suggesting that 2(a)'s scandalousness restriction could be ignored at the application stage, and that the PTO could instead allow the public to raise 2(a) objections during the publication stage.¹⁰⁰ However, I believe this approach unfairly places the “burden” to

⁹⁶ David Israel Wasserman, *Trading Sex, Marking Bodies: Pornographic Trademarks and the Lanham Act*, 23 NAT'L BLACK L.J. 121, 125 (2010).

⁹⁷ *Brown v. Entm't Merchants Ass'n*, 131 S. Ct. 2729, 2771 (2011) (Breyer, J., dissenting).

⁹⁸ LaLonde & Gilson, *supra* note 63, at 1535.

⁹⁹ *Id.* at 1536.

¹⁰⁰ *Id.* at 1537.

object to offensive marks upon the public, and might lead to the formation of trademark-policing interest groups who held the potential to slow down the registration process.¹⁰¹

C. Remove “Immoral” and “Scandalous” from 2(a)

Lastly, Congress could choose to remove the terms “immoral” and “scandalous” from 2(a) entirely. If this is done, it is important that language regarding marks that are “deceptive” and marks that “may disparage or falsely suggest a connection” be left in, since these categories protect specific, identifiable groups from a much clearer harm (disparagement). If 2(a)’s scandalousness restriction is removed, the tales of copyright law suggest little harm is likely to befall the public. In citing copyright’s refusal to differentiate between ‘good’ and ‘bad’ art,¹⁰² Rothman argues that registration does not imply a stamp of approval, writing that “[t]he state no more approves of individual porn films than it does issues of the comic book *Spawn* or issues of the magazine *Martha Stewart Living*. When I read something particularly offensive or simply drecky, I do not think ‘how could the copyright office have registered this?’”¹⁰³

Further, if marks are offensive or scandalous to a substantial composite of the public, that substantial composite will not choose to buy those products. Judge Jackson, writing a dissenting opinion in *Riverbank Canning*, argued as much: “[i]f the use of the trademark ‘Madonna,’ as applied to the goods and articles mentioned, gave offense or scandal, it seems to me it would be noised about and probably these articles would have but scanty sale.”¹⁰⁴ In a piece on 2(a) written for the *Trademark Reporter*, attorney Stephen Baird cites the registration of SAMBO’S

¹⁰¹ It should be noted that the public technically has the ability to raise such objections under the current system. *Id.* at 1507. However, I suspect due in large part to the fact that the PTO already considers such scandalousness, public objections under the “scandalous” and “immoral” terms of 2(a) are rare.

¹⁰² “It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.” *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (Holmes, J., writing for majority).

¹⁰³ Rothman, *supra* note 5, at 154.

¹⁰⁴ *In re Riverbank Canning Co.*, 95 F.2d 327, 330 (C.C.P.A. 1938) (Jackson, J., dissenting).

as a mark for restaurants as an example of this.¹⁰⁵ He explains that the public was “outraged by the use of that racially derogatory term to identify restaurant services”, leading the restaurant to eventually close, and argues that “[b]usinesses exist to make a profit, not to insult.”¹⁰⁶

Even after removing these two terms from the statute, many words currently restricted under the umbrella of “scandalousness” could still be controlled under the remaining language of 2(a). For example, the word “cunt”, currently rejected in every submitted application as “scandalous”, could easily be classified as a word that disparaged women. A similar argument could be made for “twat”, another word currently blocked by 2(a) scandalousness findings, as well as for many words that *are* currently allowed, such as “slut”, “ho”, “pussy”, and “skank”. In this way, a removal of “scandalous” and “immoral” from the existing language of 2(a) would simply redistribute the category of rejection for many currently-rejected words, rather than allowing massive waves of formerly-rejected marks into the system.

VII. CONCLUSION

The bar to registration for marks like RICH AS ***K,¹⁰⁷ even when contrasted with a permitted mark like MUTHA EFFIN BINGO,¹⁰⁸ is far from the most pressing concern facing trademark law today. At the same time, it is an important one, and one that the above proposals demonstrate could be remedied relatively easily. Ultimately, I believe that trademark law must address the issue of scandalousness because its current policing of morality will become more and more unjustifiable to younger generations of Americans. Eventually, society may respond to such censorship just as Mel Brooks did: “I’ve been accused of vulgarity. I say that’s bullshit.”

¹⁰⁵ Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661, 799 (1993).

¹⁰⁶ *Id.*

¹⁰⁷ U.S. Trademark Application Serial No. 77471293 (filed May 11, 2008).

¹⁰⁸ MUTHA EFFIN BINGO, Registration No. 4183272.

APPENDIX A

Words Usually Registrable

- BALLS
- BASTARD
- BITCH
- BOOBS
- CRAP
- FECES
- HEROIN (few applications)
- HO
- MARIJUANA (since 2009)
- PENIS
- PISS
- POOP
- SEMEN
- SKANK
- SLUT
- TATAS
- VAGINA
- WHORE

Unpredictably Registrable Words

- A**HOLE (1 instance allowed, 1 barred per 2(a))
- ASS (usually permitted, with 2 exceptions)
- COCAINE (usually disallowed outside of addiction treatment contexts, *but see* COCAINE COWBOYS)
- COCK (permissible where possible to construe as meaning other than 'penis')
- CUM (only allowed where clearly latinates, such as 'summa cum laude')
- DICK (permissible where possible to construe as meaning other than 'penis')
- JIZZ (conflicting approvals and 2(a) rejections)
- PUSSY (permissible where can be construed as 'cat' or no other evidence of reference to female genitals; especially permissible where paired with cat illustration)
- TITS (only permissible where second possible meaning exists)
- WANKER (conflicting approvals and 2(a) rejections)

Words Usually Unregistrable

- ASSHOLE
- COCKSUCKER
- CUNT
- FUCK
- JACK OFF
- MASTURBATE
- SHIT
- TWAT