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Summer 7-1-2011

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### Recommended Citation

Megan M. Carpenter & Kathryn T. Murphy, *Calling Bulls\*\*t on the Lanham Act: The 2(a) Bar for Immoral, Scandalous, and Disparaging Marks*, 49 *Louisville L. Rev.* 465 (2011).

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# CALLING BULLS\*\*T ON THE LANHAM ACT: THE 2(a) BAR FOR IMMORAL, SCANDALOUS, AND DISPARAGING MARKS

*Megan M. Carpenter\* and Kathryn T. Murphy\*\**

## I. INTRODUCTION

As the Lanham Act approaches the age of sixty-five, it is a good time to take stock of its application to, and place within, the object and purpose of trademark law. The consumer-search theory of trademarks posits that the purpose of trademark law is to promote fair competition by reducing consumer search costs and preventing confusion in the minds of consumers as to the source of goods and services.<sup>1</sup> However, section 2(a) of the Lanham Act expands trademark law well beyond its basic goals by preventing registration of marks that are “immoral,” “scandalous,” or “disparaging.”<sup>2</sup>

There are two primary questions raised by this issue: First, should the Lanham Act proscribe trademark registration for marks that are scandalous, immoral, or disparaging? Second, can (and does) the Lanham Act do so effectively? The former question will be the focus of a subsequent article; the latter is the central inquiry of this piece, which discusses some of the practical problems with the interpretation and application of 2(a). Part II begins with a brief discussion of the purpose of trademark law as it has evolved over time and the expansion of trademark law into areas unrelated to its original purpose. Part III examines the meaning and application of the section 2(a) bars for immoral, scandalous, and disparaging marks, and

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<sup>1</sup> See, e.g., David W. Barnes, *Trademark Externalities*, 10 YALE J.L. & TECH. 1, 10–11 (2007); Mark A. Lemley & Mark P. McKenna, *Owning Mark(et)s*, 109 MICH. L. REV. 137, 142 (2010); Philip Nelson, *Information and Consumer Behavior*, 78 J. POL. ECON. 311, 313 (1970); see also Mark McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1844–45 (2007), reprinted in 97 TRADEMARK REP. 1126, 1129–30 (2007).

<sup>2</sup> See 15 U.S.C. § 1052(a) (2006). In section 2(a), the Lanham Act also prevents registration of marks that are deceptive or create a false association with persons, groups, or beliefs. See *id.* While a bar to registration for marks that are deceptive or create a false association is related to the overall object and purpose of trademark law, the bar to registration for marks that are immoral, scandalous, or disparaging is not. A thorough explication of the 2(a) bars in light of trademark policy will be forthcoming in a later piece.

examines how the two doctrines have been interpreted by courts. We argue that the standards are unclear, and, to the extent they do exist, are often erroneously interpreted. Part IV discusses the high degree of inconsistency inherent in interpretation of these particular 2(a) bars and argues that the content-based determinations are so highly subjective that application of the standards fails to take into account contextually relevant information. Part V looks at the registration process itself as a central situs of the application of the 2(a) bars and discusses the inadequacy of evidence available to trademark examiners at the United States Patent and Trademark Office (USPTO). Finally, we conclude that the section 2(a) bar for immoral, scandalous, and disparaging marks is problematic in both interpretation and application.

## II. THE PRIMARY PURPOSE OF TRADEMARK LAW IS TO PROTECT CONSUMERS FROM DECEPTIVE PRACTICES.

The original purpose of trademark law was to indicate ownership of goods.<sup>3</sup> With advancements in transportation and increases in trade, the trademark took on an important second function of identifying the source of the goods that were being offered for sale in the marketplace, enabling consumers to make selections based upon the reputation and quality of the goods.<sup>4</sup> The purpose of trademark law was, thus, “to protect the interests of consumers in not being misled by the unauthorised use of others’ marks.”<sup>5</sup> The function of trademarks is two-fold, including the lessening of consumer search costs and encouraging producers of goods and services “to invest in quality by ensuring that they, and not their competitors, reap the reputation-related rewards of that investment,”<sup>6</sup> thereby protecting consumers from deceptive practices.<sup>7</sup>

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<sup>3</sup> See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 cmt. b (1995), as reprinted in JANE C. GINSBURG ET AL., *TRADEMARK AND UNFAIR COMPETITION LAW* 43 (4th ed. 2007). For a more comprehensive explication of the history and development of trademark law, see also Megan M. Carpenter, *Trademarks and Human Rights: Oil and Water? Or Chocolate and Peanut Butter?*, 99 *TRADEMARK REP.* 892, 905–06 (2009).

<sup>4</sup> See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 cmt. b.

<sup>5</sup> César Ramirez-Montes, *Emerging Scholars Series: A Re-examination of the Original Foundations of Anglo-American Trademark Law*, 14 *MARQ. INTELL. PROP. L. REV.* 91, 92 (2010). There are relevant policy debates about the proper scope and foundation of trademark law, however, which are outside the scope of this paper.

<sup>6</sup> Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 *UCLA L. REV.* 621, 623 (2004) (suggesting that while a secondary consideration of trademark law is the legal means to protect the rights of the trademark owner, the primary purpose was and continues to be consumer protection from deceptive practices on goods and services).

<sup>7</sup> See I.J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 2:4 (4th ed. 2010).

The 1905 Trade-Mark Act was the first federal statute to forbid directly and explicitly registration of scandalous and immoral trademarks,<sup>8</sup> a prohibition that was later “reenacted as section 2(a) of the [Lanham] Act of July 5, 1946.”<sup>9</sup> The Lanham Act was enacted in a post-World War II political and social environment, when the Hays Code banned “excessively lustful” kissing in movies, and Senator Joseph McCarthy spearheaded aggressive investigations of artists for communist associations and beliefs.<sup>10</sup> In that context, “it is [of] little surprise that Congress chose to refuse trademark registration to material that ‘[c]onsists of or comprises immoral, deceptive, or scandalous matter.’”<sup>11</sup> Though no justifications for the 2(a) bars can be found in the statute or its legislative history, scholars have posited that the purpose behind this provision was that “the government should not waste its resources on protecting unseemly marks,”<sup>12</sup> suggesting conformance with social and cultural practices of the time. Barring registration for marks that are immoral, scandalous, or disparaging, however, expands trademark law well beyond the basic purpose of consumer protection from confusion as to the source and quality of goods and services, and into protection from salacious material. That is, the consumer protection at the base of trademark policy is one of source quality, not moral quality.<sup>13</sup>

Because the legislative history of the Lanham Act contains a dearth of information about the intent behind the section 2(a) bars to registration,

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<sup>8</sup> See Trade-Mark Act of 1905 § 5(a), 15 U.S.C. § 85(a) (1946) (repealed 1946) (current version at 15 U.S.C. § 1052 (2006)) (“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 [c]onsists of or comprises immoral or scandalous matter.”).

<sup>9</sup> *In re McGinley*, 660 F.2d 481, 485 n.10 (C.C.P.A. 1981).

<sup>10</sup> See Christopher T. McDavid, Note, *I Know It When I See It: Obscenity, Copyright, and the Cautionary Tale of the Lanham Act*, 47 U. LOUISVILLE L. REV. 561, 575 (2009) (citing *The Motion Picture Production Code of 1930 (Hays Code)*, ARTSREFORMATION.COM, <http://www.artsreformation.com/a001/hays-code.html> (last visited Feb. 15, 2011)); Dara L. Schottenfeld, Comment, *Witches and Communists and Internet Sex Offenders, Oh My: Why It is Time to Call Off the Hunt*, 20 ST. THOMAS L. REV. 359, 365 (2008); see also 15 U.S.C. § 1052(a).

<sup>11</sup> McDavid, *supra* note 10, at 575 (citing 15 U.S.C. § 1052(a)); see also 15 U.S.C. § 1052(a); Schottenfeld, *supra* note 10, at 365.

<sup>12</sup> Jack A. Guggenheim, *The Indians' Chief Problem: Chief Wahoo as State Sponsored Discrimination and a Disparaging Mark*, 46 CLEV. ST. L. REV. 211, 229 (1998); see *In re McGinley*, 660 F.2d at 486 (“We do not see [the refusal to register such marks] as 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.”); Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661, 674–75 (1993); 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 TRADEMARK REP. 801, 807 (1993); Jendi B. Reiter, *Redskins and Scarlet Letters: Why “Immoral” and “Scandalous” Trademarks Should Be Federally Registrable*, 6 FED. CIR. B.J. 191, 193 (1996).

<sup>13</sup> See Baird, *supra* note 12, at 666 (stating that bars for scandalous, immoral, or disparaging marks, on the other hand, are “designed to regulate not only society's moral values, but [are] also designed to discourage the commercial use of offensive subject matter that may not directly implicate principles of morality or virtue”).

courts are forced to “speculate as to Congress’s intent based on the text” of the statute.<sup>14</sup> Scholars generally agree, however, that there are four common justifications for the 2(a) bars: The federal government (1) “should not create the appearance that it favors or approves the use of scandalous, immoral and disparaging trademarks”; (2) “should not squander its precious time and resources” on such marks; (3) “should promote the public health, welfare, and morals by discouraging the use” of them; and (4) “should protect the sensitivities of those in public who might be offended” by them.<sup>15</sup>

### III. THE SECTION 2(a) BAR FOR MARKS THAT ARE IMMORAL, SCANDALOUS, OR DISPARAGING IS NOT EFFECTIVE BECAUSE THE STANDARDS ARE UNCLEAR.

The Lanham Act does not define “scandalous,” “immoral,” or “disparaging,” yet it prohibits trademark registration for marks that fall into any one of these categories.<sup>16</sup> The Trademark Trial and Appeal Board (TTAB) has acknowledged problems in making these content-based determinations, calling the guidelines “somewhat vague” and “highly subjective.”<sup>17</sup> Additionally, there is not enough published precedent to provide meaningful guidance to courts attempting to apply these standards.<sup>18</sup>

In the first case to consider what a “scandalous” mark might look like, the court in *In re Riverbank Canning Co.* noted that, in light of the dearth of stated intent or guidance in the legislative history, the word “scandalous” should be interpreted through “its ordinary and common meaning,” which was “[c]ausing or tending to cause scandal; . . . shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable, . . . [g]iving offense to the conscience or moral feelings; . . . [or] calling out [for] condemnation.”<sup>19</sup> When considering whose sense of truth, decency, or

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<sup>14</sup> Llewellyn J. Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(a) Trademark Law After Lawrence v. Texas*, 9 MARQ. INTELL. PROP. L. REV. 187, 233 (“Because there is little legislative history explaining Congress’s intention in enacting section 2(a), courts will have to speculate as to Congress’s intent based on the text and purpose of the statute.”).

<sup>15</sup> See Baird, *supra* note 12, at 788.

<sup>16</sup> See 15 U.S.C. § 1052(a).

<sup>17</sup> *In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654 (T.T.A.B. 1990) (quoting *In re Hershey*, 6 U.S.P.Q.2d 1470, 1471 (T.T.A.B. 1988)).

<sup>18</sup> See *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1218 (T.T.A.B. 1993).

<sup>19</sup> *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938) (citation omitted). Interestingly, despite the separate existence of each term in the Lanham Act, the analysis for “scandalous” and “immoral” is typically collapsed, and separate standards do not exist.

propriety matters, the analysis focuses on a substantial composite of the general public.<sup>20</sup> The court sought to determine whether the use of MADONNA on wine not limited to religious use would be shocking or give offense to the conscience or moral feelings of the consuming public.<sup>21</sup> While the Court of Customs and Patent Appeals (CCPA) noted numerous references to wine in the Bible, it also noted that “the evils growing out of the excessive use of intoxicating beverages are probably much greater today than they were 1900 years ago.”<sup>22</sup> While courts are not supposed to consider the morality of the goods or services in question, the likely meaning of the mark is determined “in the context of the marketplace as applied to only the goods described in [the] application for registration.”<sup>23</sup> The CCPA sought to consider the viewpoint of wine drinkers, as well as people who do not drink wine.<sup>24</sup> It also considered the fact that the mark would be displayed in such places as barrooms.<sup>25</sup> The trademark owner had submitted affidavits indicating that wine drinkers would not object to the use of the mark on wine, but the court held that the proper scope of inquiry should be broadened to include people who do not “use” wine as a beverage.<sup>26</sup>

In this type of assessment, USPTO examining attorneys often rely on dictionary definitions of words because they “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.”<sup>27</sup> Because meaning can be inferred from dictionary definitions, the existence of alternate definitions can imply that the trademark is nonscandalous.<sup>28</sup> However, while the focus on an ordinary and common meaning potentially implies a sort of logical baseline, the appropriate focus is not simply the meaning of the word or phrase, but the way that word or phrase is perceived by a substantial composite of consumers. A centralized focus on dictionary definitions fails to inquire as to the degree of perceived scandal, shock, or offense to consumers in the marketplace.

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<sup>20</sup> See *Ex parte Parfum L'Orle, Inc.*, 93 U.S.P.Q. (BNA) 481, 482 (Pat. Office Exam'r-in-Chief 1952).

<sup>21</sup> See *In re Riverbank Canning Co.*, 95 F.2d at 328.

<sup>22</sup> *Id.* at 329.

<sup>23</sup> *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994) (citing *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981)).

<sup>24</sup> See *In re Riverbank Canning Co.*, 95 F.2d at 329.

<sup>25</sup> See *id.*

<sup>26</sup> See *id.*

<sup>27</sup> *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1340 (Fed. Cir. 2003).

<sup>28</sup> See *In re Mavety Media Group Ltd.*, 33 F.3d at 1373–74.

Although section 2(a) forbids the registration of disparaging marks, the Lanham Act does not define the term “disparaging”, and examining attorneys and courts alike have noted the existence of little precedent on its meaning.<sup>29</sup> Many TTAB decisions and court opinions have found that something *just is* disparaging with little supporting analysis. In *Doughboy Industries, Inc. v. Reese Chemical Co.*, for example, the court held that the mark DOUGH-BOY for medication to treat sexually transmitted diseases “obviously” disparaged American soldiers because American soldiers were often referred to colloquially as “dough-boys” during World War I.<sup>30</sup> In another case, concluding that a large red “X” atop a hammer and sickle was not registrable by the Anti-Communist World Freedom Congress, the TTAB noted conclusively that “there can be no question” that such mark disparaged the Communist Party.<sup>31</sup>

In 1999, a formal definition of “disparage” was solidified in *Harjo v. Pro-Football, Inc.*,<sup>32</sup> based on the “ordinary and common” definition of the word in 1946, the year that Congress adopted the Lanham Act.<sup>33</sup> Something is thus disparaging, for the purposes of the 2(a) bar, if it “may dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison.”<sup>34</sup> Additionally, the court confirmed that “in deciding whether the matter may be disparaging, we look, not to American society as a whole . . . but to the views of the referenced group.”<sup>35</sup> The court crafted a two-step test for determining whether a mark is disparaging: (1) Would the mark be understood in its context as referring to an identifiable group of people? (2) May that reference be perceived as disparaging to a “substantial composite” of that group?<sup>36</sup> However, the court did not define what a “group” is for purposes of the test, again leaving the definition open to interpretation with very little precedent to guide.

The question arises whether the terms are “sufficiently precise to enable the PTO and the courts to apply the law fairly and to notify a would-be registrant that the mark he adopts will not be granted a federal

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<sup>29</sup> See *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1221 & n.4 (T.T.A.B. 1993).

<sup>30</sup> See *Doughboy Indus., Inc. v. Reese Chem. Co.*, 88 U.S.P.Q. (BNA) 227, 228 (Pat. Office Comm’r-in-Chief 1951).

<sup>31</sup> See *In re Anti-Communist World Freedom Cong., Inc.*, 161 U.S.P.Q. (BNA) 304, 305 (T.T.A.B. 1969).

<sup>32</sup> See *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1738 (T.T.A.B. 1999), *rev’d*, 284 F. Supp. 2d 96 (D.D.C. 2003).

<sup>33</sup> See *id.* at 1737–38; see also *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 124 (D.D.C. 2003) (adopting the TTAB’s definition as correct).

<sup>34</sup> *Harjo*, 50 U.S.P.Q.2d (BNA) at 1738.

<sup>35</sup> *Id.* at 1739.

<sup>36</sup> See *id.* at 1739–40.

registration.”<sup>37</sup> Scholars have widely discredited the content-based determinations as ineffective and highly arbitrary, going so far as to posit that “[a] Section 2(a) proceeding is even less democratic than an obscenity trial [sic]: the decision is made by judges and administrative agencies on a national level and a minority of hypothetically offended people can override the community standard of taste.”<sup>38</sup>

*A. To the Extent There Are Standards, They Are Often Erroneously Conflated.*

An examining attorney who believes a mark is both scandalous and disparaging must provide separate analysis for each, using the two separate tests: “[I]t is critical for the tribunal to distinguish between allegations that a mark is scandalous and allegations that a mark is disparaging, for these two categories implicate very different interests and are resolved through different tests.”<sup>39</sup> However, examining attorneys routinely collapse the two analyses, which “does a disservice to the statutory language, leads to injustice in the individual case without any gains in the predictability of outcomes, and makes for bad public policy.”<sup>40</sup>

In *In re Hines*, the applicant was denied registration for the mark BUDDHA on casual clothing,<sup>41</sup> and on appeal the TTAB noted that the examining attorney “appear[ed] to lump all of these different concepts in Section 2(a) together, using [scandalous and disparaging] interchangeably.”<sup>42</sup> The court went on to note that “[a] thorough reading of the cases reveals that the lines separating each distinct bar have been blurred.”<sup>43</sup> Similarly, in *In re Old Glory Condom Corp.*, the board stated that “the examining attorney’s refusal of registration on the grounds that applicant’s mark is scandalous was based, in large part, on her finding that

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<sup>37</sup> *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981).

<sup>38</sup> See Gibbons, *supra* note 14, at 237 (citing Reiter, *supra* note 12, at 195); see also Baird, *supra* note 12, at 681.

<sup>39</sup> Lynda J. Oswald, *Challenging the Registration of Scandalous and Disparaging Marks Under the Lanham Act: Who Has Standing To Sue?*, 41 AM. BUS. L.J. 251, 290 (2004) (footnote omitted); see *In re Hines*, 31 U.S.P.Q.2d (BNA) 1685, 1686 n.2 (T.T.A.B. 1994) (“[T]he fact that the disparagement language was added after more than forty years of employing the scandalous and immoral language under the 1905 Act, suggests that Congress believed there was a gap that needed to be filled and that Congress must have intended for the standards to be distinct.” (quoting Baird, *supra* note 12, at 667)).

<sup>40</sup> Ethan G. Zlotchew, “Scandalous” or “Disparaging”? It Should Make a Difference in Opposition and Cancellations Actions: Views on the Lanham Act’s Section 2(a) Prohibitions Using the Example of Native American Symbolism in Athletics, 22 COLUM.-VLA J.L. & ARTS 217, 230 (1998) (footnote omitted); see Todd Anten, Note, *Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of Slurs into Section 2(a) of the Lanham Act*, 106 COLUM. L. REV. 388, 409–10 (2006).

<sup>41</sup> *In re Hines*, 31 U.S.P.Q.2d (BNA) at 1685–86.

<sup>42</sup> *Id.* at 1686 n.2.

<sup>43</sup> *Id.* (quoting Baird, *supra* note 12, at 666 n.14).



the mark disparages.”<sup>44</sup> And again in *In re In Over Our Heads Inc.*, the TTAB noted that “[i]t is not entirely clear whether the Examining Attorney has rejected the mark (1) on the basis that it ‘consists of or comprises . . . scandalous matter’ or (2) on the basis that it ‘consists of or comprises . . . matter which may disparage . . . institutions [or] beliefs.’”<sup>45</sup> When these terms are used interchangeably without regard to their already imprecise standards under the Lanham Act, they “confuse the very foundations of Section 2(a)’s statutory bars to registration.”<sup>46</sup>

*B. Ascertaining the Relevant Group Is an Essential Part of the Analysis, and Yet It Is Ambiguous Under Existing Normative Practice.*

When a mark is alleged to be disparaging, the “relevant group” changes depending upon the target of the possible disparagement. When a trademark targets a particular ethnic or religious group, for example, the analysis is understood to focus on a substantial composite of that group; conversely, where the mark is alleged to be disparaging to consumers as a whole, the focus expands accordingly.<sup>47</sup> However, a precise determination of the parameters of the relevant group has proved to be difficult in individual cases, which is problematic particularly because the relevant group is often determinative of the conclusion. The creation of a standard that requires a content-based consideration of a “substantial composite of the general public” is difficult to define and changes with each highly subjective case.<sup>48</sup>

In *In re Heeb Media, LLC*, in affirming the denial of registration of the mark HEEB for a Jewish-owned, Jewish-targeted magazine, the TTAB noted that “[w]hile case law does not provide a fixed number or percentage, it is well established that a ‘substantial composite’ is not necessarily a majority.”<sup>49</sup> In response to applicant’s argument that a mark should not be denied based on minority opinion, the TTAB listed the sources that the examiner cited condemning registration of HEEB for a magazine, including

<sup>44</sup> *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1221 (T.T.A.B. 1993).

<sup>45</sup> *In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654 n.2 (T.T.A.B. 1990).

<sup>46</sup> Oswald, *supra* note 39, at 290.

<sup>47</sup> Cf. *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d (BNA) 1635 (T.T.A.B. 1998).

<sup>48</sup> See *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994) (“Although constantly at odds, progressive views and conservative or traditional thinking participate alike in the formation of the composite of the general public. While we recognize the inherent difficulty in fashion 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.”).

<sup>49</sup> *In re Heeb Media, LLC*, 89 U.S.P.Q.2d (BNA) 1071, 1077 (T.T.A.B. 2008) (citing *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981)).

statements from the Anti-Defamation League, rabbis, a university professor, a talk-show host, and members of the general public.<sup>50</sup> This small subset of the composite seemed to trump the evidence in the record that the applicant submitted, including letters from various individuals representing prominent Jewish organizations (UJA Federation and Hillel) and notable Jewish leaders (Charles Bronfman, Steven Spielberg), as well as monetary support from a variety of Jewish advertisers (American Jewish World Service, Birthright Israel, Jewish Fund for Justice, Museum of Jewish Heritage, New Israel Fund, and University of Judaism).<sup>51</sup> To what degree and by what standards one group is deemed more “substantial” than another, however, was entirely unclear.

#### IV. DETERMINATIONS UNDER SECTION 2(a) ARE CONTENT BASED AND SO HIGHLY SUBJECTIVE THAT APPLICATION OF THE STANDARDS ARE INCONSISTENT AND VARY WITH TIME, CONTEXT, AND TRIBUNAL.

Because of a lack of sufficient definitional standards, examining attorneys must make determinations as to which marks will be deemed scandalous, immoral, or disparaging with little more than subjective guidance. As a result, “the trademark landscape is littered with inconsistencies” and puzzling results.<sup>52</sup> For example, the mark, TECHNODYKE, was registered in 2001 for a lesbian-oriented website,<sup>53</sup> but the marks DYKESINTHECITY for clothing,<sup>54</sup> DYKEDOLLS for lesbian dolls,<sup>55</sup> DYKE TV for lesbian-oriented television programming,<sup>56</sup> and SUPERDYKE for clothing<sup>57</sup> were rejected. Additionally, the mark QUEER GEAR, for clothing, was registered,<sup>58</sup> while the mark CLEARLY QUEER, also for clothing, was not successfully registered.<sup>59</sup> Whether a mark is considered “scandalous” or “disparaging” can often change drastically given the context of the mark. For example, in 1951, when the Patent Office Commissioner-in-Chief denied registration of the mark DOUGH BOY for an anti-venereal medication, he noted that DOUGH BOY was not a *per se* disparaging mark, only becoming so when used in

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

<sup>51</sup> *See id.* at 1073–74.

<sup>52</sup> *See* McDavid, *supra* note 10, at 578.

<sup>53</sup> TECHNODYKE, Registration No. 2,498,459.

<sup>54</sup> U.S. Trademark Application Serial No. 76,627,653 (filed Jan. 12, 2005).

<sup>55</sup> U.S. Trademark Application Serial No. 78,497,352 (filed Oct. 10, 2004).

<sup>56</sup> U.S. Trademark Application Serial No. 76,434,481 (filed July 24, 2002).

<sup>57</sup> U.S. Trademark Application Serial No. 74,325,314 (filed Oct. 26, 1992).

<sup>58</sup> QUEER GEAR, Registration No. 1,828,351.

<sup>59</sup> U.S. Trademark Application Serial No. 76,132,003 (filed Sept. 19, 2000).

conjunction with those goods and services.<sup>60</sup> And while context is of great importance in such determinations, the various factors considered by individual examining attorneys without the benefit of a tribunal—including the relationship between the disparaging term and other elements of the mark, the type of product upon which the mark appears, and how the mark will appear in the marketplace<sup>61</sup>—often yields inconsistent and unpredictable results. For example, in *In re In Over Our Heads Inc.*, the TTAB allowed registration of the mark MOONIES for dolls who, upon squeezing an attached collapsible bulb, dropped their pants to reveal their buttocks.<sup>62</sup> While the trademark examiner had primarily focused on the term “moonie” as a reference to members of The Unification Church (whose leader is the Reverend Sun Myung Moon), the TTAB felt that purchasers were more likely to view the marks as an allusion to “mooning,” given the context, than as a reference to members of The Unification Church.<sup>63</sup> In reversing the examining attorney’s refusal, the TTAB opinion noted the substantial composite that the examining attorney had relied on:

There is in the record a short article appearing in the April 24, 1989 edition of U.S.A. Today indicating that the term “Moonies” may be viewed by some members of that religious group as being derogatory. However, the record is also replete with articles taken from major newspapers and magazines wherein the term “Moonies” is used to refer to members of The Unification Church. These articles do not suggest that the term “Moonies” is derogatory, and we doubt that such major newspapers and magazines would have repeatedly used a term derogatory of a particular religious group.<sup>64</sup>

While context is considered in some applications, such as the marks listed above, other times marks have been found *per se* scandalous without the consideration of context. In denying registration to the applicant’s mark BULLSHIT for high-end handbags, the TTAB rejected the argument that in this particular context the applicant’s mark was intended to be tongue-in-cheek.<sup>65</sup> Applicant claimed to be commenting on and satirizing the ludicrousness of the high-end handbag market and argued that “the word ‘bullshit’ is in such common usage in contemporary America that it is

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<sup>60</sup> See *Doughboy Indus., Inc. v. Reese Chem. Co.*, 88 U.S.P.Q. (BNA) 227, 228 (Pat. Office Comm’r-in-Chief 1951).

<sup>61</sup> See *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1739 (T.T.A.B. 1999), *rev’d*, 284 F. Supp. 2d 96 (D.D.C. 2003).

<sup>62</sup> See *In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654 (T.T.A.B. 1990).

<sup>63</sup> See *id.*

<sup>64</sup> *Id.* at 1654 n.4.

<sup>65</sup> See *In re Tinseltown, Inc.*, 212 U.S.P.Q. (BNA) 863, 864, 866 (T.T.A.B. 1981).

defined in modern dictionaries as having the meaning of nonsense . . . rather than the feces of a bull.”<sup>66</sup> The TTAB refused this contextual consideration, instead holding the public in general would be scandalized by such a mark.<sup>67</sup> However, on the other end of the spectrum, the mark BADASS for stringed instrument bridges was registered without issue, in part because the mark was alleged to be an acronym for “Bettencourt Acoustically Designed Audio Sound Systems” rather than as a word having any apparent profane connotation.<sup>68</sup> In a further example confounding both ends of the spectrum, the mark BIG PECKER BRAND was initially denied registration for T-shirts on the grounds that “pecker” was a vulgar expression for “penis.”<sup>69</sup> The TTAB reversed the refusal, finding that the T-shirts had a design of a bird in conjunction with the word mark and concluding that, in view of the context of the mark’s use, the mark neither offended morality nor raised a scandal.<sup>70</sup> Thus, “[t]here seems to be no clear way to identify the bounds of the context of the meaning of a trademark.”<sup>71</sup>

*A. The Identity of the Trademark Owner Is Not Separately Considered in the Disparagement Analysis and Yet Is a Relevant Contextual Inquiry.*

A self-disparaging trademark may become empowering when it is used by a particular oppressed group. Such trademark “contains a term that is usually considered to be a slur toward a particular group, yet the applicant is a member of that group, suggesting that the slur has lost its disparaging potency.”<sup>72</sup> If a trademark applicant is a member of a traditionally disparaged group and is reappropriating a particular term toward the ends of social justice and empowerment, the applicant’s identity may be relevant to an evaluation of disparagement.<sup>73</sup> A mark may become very powerful in these circumstances.<sup>74</sup> Many of these terms are not scandalous or derogatory *per se*; rather, “[i]t is the use of the term in its specific context

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<sup>66</sup> *Id.* at 864; see also HARRY G. FRANKFURT, ON BULLSHIT 41 (2005).

<sup>67</sup> See *In re Tinseltown, Inc.*, 212 U.S.P.Q. (BNA) at 865.

<sup>68</sup> See *In re Leo Quan Inc.*, 200 U.S.P.Q. 370, 371 (T.T.A.B. 1978).

<sup>69</sup> See *In re Hershey*, 6 U.S.P.Q.2d 1470, 1470 (T.T.A.B. 1988).

<sup>70</sup> See *id.* at 1471.

<sup>71</sup> Regan Smith, *Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks*, 42 HARV. C.R.-C.L. L. REV. 451, 460 (2007).

<sup>72</sup> Anten, *supra* note 40, at 390.

<sup>73</sup> See *id.* at 390–94.

<sup>74</sup> See *In re Carlson*, No. 78682282, 2007 T.T.A.B. LEXIS 651, at \*2–3 (T.T.A.B. Aug. 28, 2007) (arguing that the word “cum,” while historically used to refer to degrading sexual acts involving women, can become a mark of empowerment when used by women).

that imparts the value judgment of scandalous or immoral.”<sup>75</sup> When that context involves reappropriation of language by a disadvantaged group in empowering ways, it is particularly relevant. However, “[u]nder current PTO practice, examining attorneys take no notice of an applicant’s self-identity,” resulting in “inconsistent and contradictory evaluations of self-disparaging marks.”<sup>76</sup> For example, over the years, multiple applications including the term “dyke,” have been rejected because of the term’s significance in referring to lesbians, despite the fact that the trademark owners were lesbian groups reappropriating the term in nonoffensive and empowering ways.<sup>77</sup>

The confusion goes well beyond marks addressing sexual orientation. In *In re Heeb Media, LLC*, discussed above, the applicant, in order to overcome the initial refusal by the examining attorney, submitted evidence that included letters from various prominent Jewish organizations, advertisements from a wide range of Jewish organizations that wished to advertise in his magazine, and testimony from prominent Jewish leaders and scholars that found his appropriation of the slang term nonoffensive.<sup>78</sup> Applicant argued that “the context in which [we] use[] the term ‘heeb’ is the exact opposite of derogatory and is rather as a symbol of pride and progressive identity among today’s Jews.”<sup>79</sup> In affirming the examiner’s refusal, however, the TTAB noted that the mark would not be “limited to clothing and entertainment services offered by Jews and for Jews, once registered, this registration could be assigned to anyone, and these goods and services could be offered in all channels of trade to all classes of consumers.”<sup>80</sup>

Currently, there are many groups attempting to take once derogatory terms and internalize them, make them their own, and in the process strip

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<sup>75</sup> *Id.* at \*3.

<sup>76</sup> Anten, *supra* note 40, at 390–91.

<sup>77</sup> *See id.* at 391 (“[E]xaminers have denied multiple applications to register marks containing the word ‘dyke’ in reference to lesbians, yet in 2001 the PTO registered the mark TECHNODYKE as applied to a lesbian-oriented website.”); *see also* U.S. Trademark Application Serial No. 76,627,653 (filed Jan. 12, 2005) (DYKESINTHECITY); U.S. Trademark Application Serial No. 78,497,352 (filed Oct. 9, 2004) (DYKEDOLLS); U.S. Trademark Application Serial No. 78,448,110 (filed July 8, 2004) (VELVETPARK DYKE CULTURE IN BLOOM); U.S. Trademark Application Serial No. 76,434,481 (filed July 24, 2002) (DYKE TV); U.S. Trademark Application Serial No. 75,312,451 (filed June 20, 1997) (DYKE WEAR) (approved for publication but abandoned before registered); U.S. Trademark Application Serial No. 75,121,779 (filed June 11, 1996) (DYKE DISH).

<sup>78</sup> *See supra* text accompanying notes 49–51.

<sup>79</sup> *In re Heeb Media, LLC*, 89 U.S.P.Q.2d (BNA) 1071, 1075 (T.T.A.B. 2008).

<sup>80</sup> *Id.* at 1075 n.5. It is arguable whether a trademark could be assigned to “anyone,” and offered “in all channels of trade to all classes of consumers.” A thorough discussion of this issue is outside the scope of this paper, but the law of assignments creates restrictions that substantially constrain the rights of assignors.

them of hateful meaning.<sup>81</sup> As our society evolves socially and culturally, disparaged groups will increasingly seek to “disarm the power of epithets by actively transforming slurs into sources of pride.”<sup>82</sup> Accordingly, these groups should have the freedom to confront and “transform these negative representations of themselves,”<sup>83</sup> which they are not able to do under the current constructions of the 2(a) bar.

*B. What Is Considered To Be Scandalous Changes with Evolving Social and Cultural Context.*

It is perhaps a basic truism that what was once considered scandalous changes over time with the evolution of social attitudes. “[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.”<sup>84</sup> In 1938, for example, QUEEN MARY was held to be scandalous for underwear,<sup>85</sup> and in 1971, the TTAB affirmed an examiner’s refusal to register the mark BUBBY TRAP for brassieres because the mark “would be offensive to public or individual sense of propriety or morality,”<sup>86</sup> however, these results would be unlikely in a contemporary social context.<sup>87</sup> Yet, while trademark law to some extent depends on the constantly moving target of consumer opinion, evidence of changed social attitudes toward certain words have had limited impact in litigation. In *In re Boulevard Entertainment, Inc.*,<sup>88</sup> for example, a trademark applicant was not allowed to register 1-800-JACK-OFF for “entertainment in the nature of adult-oriented conversations by telephone,”<sup>89</sup> despite the submission of “a substantial amount of evidence to establish that societal attitudes toward sex and sexual talk in general have changed significantly over the last several

<sup>81</sup> See, e.g., U.S. Trademark Application Serial No. 76,082,591 (filed July 1, 2000) (SPIC SPANISH PEOPLE IN CONTROL); U.S. Trademark Application Serial No. 75,002,364 (filed Oct. 6, 1995) (N.I.G.G.A. NATURALLY INTELLIGENT GOD GIFTED AFRICANS).

<sup>82</sup> Anten, *supra* note 40, at 392.

<sup>83</sup> Reiter, *supra* note 12, at 208.

<sup>84</sup> *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1219 (T.T.A.B. 1993); see also M. Christopher Bolen et al., *When Scandal Becomes Vague: The Registrability of Sexual References in Trademarks and Protection of Trademarks from Tarnishment in Sexual Contexts*, 39 IDEA 435, 439–31 (1999) (arguing that the boundaries of immoral or scandalous have moved over time to correspond to contemporary mores as a process of normalizing deviance).

<sup>85</sup> *Ex parte Martha Maid Mfg. Co.*, 37 U.S.P.Q. (BNA) 156, 156 (Dec. Comm’r Pat. 1938).

<sup>86</sup> *In re Runsdorf*, 171 U.S.P.Q. (BNA) 443, 443 (T.T.A.B. 1971).

<sup>87</sup> See *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) at 1219 (“Marks once thought scandalous may now be thought merely humorous (or even quaint), as we suspect is the case with the marks held scandalous in *Ex parte Martha Maid Mfg. Co.* and *In re Runsdorf*.” (citations omitted)).

<sup>88</sup> *In re Boulevard Entm’t, Inc.*, 334 F.3d 1336 (Fed. Cir. 2003).

<sup>89</sup> *Id.* at 1339.

decades.”<sup>90</sup> While the board conceded that this might be true, it denied registration based on three different dictionary definitions that labeled the term vulgar.<sup>91</sup>

*C. Cancellation Actions on the Basis of Disparagement Artificially Freeze Time at Registration and Are Particularly Vulnerable to a Laches Defense.*

For a mark to be held disparaging in a cancellation action, the standard requires that it be found disparaging at the time of registration; that is, contemporary attitudes and meanings are not considered: “If a trademark was registered in a time of more virulent racism, it is conceivable that either internalized racism or lack of hope for success prevented members of a disparaged group from bringing a challenge within the five-year period.”<sup>92</sup> On the other hand, slang terms and nicknames that used to be socially acceptable and are now disparaging may not be seen as such under the relevant standard. This may be true even when a particular mark was disparaging all along, but not perceived as such by a substantial composite of the relevant group. Because of an evolving social and cultural climate, disparaging marks will often face a laches defense. In the action brought by a group of Native Americans challenging certain marks of the Washington Redskins football franchise,<sup>93</sup> the United States District Court for the District of Columbia held that a finding of disparagement was not supported by substantial evidence and that the doctrine of laches precluded consideration of the case because “[t]he marks in question were registered between 1967 and 1990, but the Petitioners did not file a complaint against Pro-Football until 1992.”<sup>94</sup>

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<sup>90</sup> *In re Boulevard Entm't, Inc.*, No. 75/414,435, 2002 WL 1258274, at \*5 (T.T.A.B. Jan. 31, 2002), *aff'd*, 334 F.3d 1336; *In re Boulevard Entm't, Inc.*, 334 F.3d at 1341–42.

<sup>91</sup> *See In re Boulevard Entm't, Inc.*, F.3d at 1339; *see also In re Boulevard Entm't, Inc.*, 2002 WL 1258274, at \*5.

<sup>92</sup> Smith, *supra* note 71, at 481.

<sup>93</sup> *See Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96 (D.D.C. 2003).

<sup>94</sup> Lynette Paczkowski, *The Best Offense Is a Good Defense: How the Washington Redskins Overcame Challenges to Their Registered Trademarks*, 2004 B.C. INTELL. PROP. & TECH. F. 60803. The TTAB had found that the marks may be disparaging to a substantial composite of Native Americans and ordered cancellation of the registrations. *See Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1749 (T.T.A.B. 1999), *rev'd*, 284 F. Supp. 2d 96 (D.D.C. 2003).

V. THE REGISTRATION PROCESS IS PARTICULARLY UNSUITABLE TO CONDUCT A SECTION 2(a) ANALYSIS DUE TO INCONSISTENCIES IN REGISTRATION PRACTICE AND INADEQUATE EVIDENCE.

In the examination of trademark applications, examining attorneys are not required to follow other registration decisions when considering whether or not to register a mark, including decisions based on marks belonging to the same applicant. After being denied registration for the mark TWATTY GIRL for newspaper cartoon strips, for example, the applicant in *In re Ava Watkins*<sup>95</sup> pointed out that “two of her previously-filed applications for the marks TWATTY (Ser. No. 75704979)”<sup>96</sup> for cartoon strips and “TWATTYTRAX (Ser. No. 76072967)”<sup>97</sup> for cartoon soundtracks on tapes and CDs, “were passed to publication without a Section 2(a) rejection by the examining attorneys handling those applications.”<sup>98</sup> But the court noted “that the present examining attorney is not bound by the Office’s actions relative to applicant’s prior applications.”<sup>99</sup>

Additionally, there are also inconsistencies in how marks are investigated during the examination process. Some examining attorneys have taken it upon themselves to do a more advanced investigation as to goods and services other than the ones included in the application.<sup>100</sup> Other examining attorneys only consider the specimens in the application as an indication of goods and services; through different processes, different results arise.<sup>101</sup> In *In re Robert L. McGinley*, for example, the examiner denied, and the CCPA affirmed the denial of, a mark which was a photograph of a nude couple kissing that exposed the man’s genitalia.<sup>102</sup> While the specimens of use submitted with the application indicated that the mark would be used for a “‘Newsletter Devoted to Social and Interpersonal Relationship Topics’ and ‘Social Club Services,’” the court seemed to base its rejection of the mark after a thorough inquiry into the exact nature of the social club services.<sup>103</sup> The TTAB determined that the social club was a

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<sup>95</sup> *In re Watkins*, No. 76138675, 2005 TTAB LEXIS 66, at \*4 (T.T.A.B. Feb. 8, 2005) (“The mark TWATTY GIRL is derived from the Applicant’s name, Ava Watkins. Ms. Watkins has created a fictional character, ‘Eva Twatkins,’ . . . and ‘Twatty Girl’ is Eva Twatkin’s fictional alter ego.”).

<sup>96</sup> U.S. Trademark Application Serial No. 75,704,979 (filed May 13, 1999).

<sup>97</sup> U.S. Trademark Application Serial No. 76,072,967 (filed June 19, 2000).

<sup>98</sup> *In re Watkins*, 2005 TTAB LEXIS 66, at \*3.

<sup>99</sup> *Id.*

<sup>100</sup> *See, e.g., In re McGinley*, 660 F.2d 481, 482 (C.C.P.A. 1981).

<sup>101</sup> *See id.* at 485 (“[T]he Lanham Act does not require, under the rubric of ‘scandalous,’ any inquiry into the specific goods or services not shown in the application itself.”).

<sup>102</sup> *See id.* at 482.

<sup>103</sup> *See id.*



club for swingers, declaring “[s]uch activities are considered deviations from the sexual norm of husband and wife relations. Such activities are immoral or scandalous.”<sup>104</sup> In his dissenting opinion, Judge Rich noted that the court was “lacking in factual foundation on the main issue of whether the *picture* sought to be registered . . . is ‘scandalous’ when used on the goods and services named in the application,”<sup>105</sup> and claimed that the examining attorney and the court had instead made a subjective decision based on the activities of the club.<sup>106</sup>

*A. Inadequate Evidence Is Used when Denying Registrations.*

It is uncertain what degree of evidence is required—in both quantity and quality—before an examining attorney can refuse a registration based on section 2(a).<sup>107</sup> Examiners “look to the limited precedent of the courts and the [TTAB] on the issue of disparagement, as well as to the previously enunciated precedent on the related issue of scandalousness.”<sup>108</sup> When precedent is unavailable, there is often very little concrete evidence to consider, and examiners are left without access to adequate evidence. Examining attorneys may look to dictionary definitions and newspaper and magazine articles<sup>109</sup> when determining if a mark is scandalous, immoral, or disparaging, but their assessment is little more than a prediction as “consumer surveys are not a viable option for the Patent and Trademark Office, due to its limited resources.”<sup>110</sup> While it is expected to make decisions on trademark applications based on perceptions of a substantial composite of the general public, the USPTO is limited as to the evidence it can acquire related to consumer perception—“it cannot, for example, be expected to conduct a survey of the marketplace or obtain consumer affidavits.”<sup>111</sup> Dictionary definitions are often the central evidence for refusal of a mark on the basis of scandalousness or immorality. But dictionary definitions change over time, can differ between sources, and do

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

<sup>105</sup> *Id.* at 487 (Rich, J., dissenting) (emphasis added).

<sup>106</sup> *See id.*

<sup>107</sup> *See Baird, supra* note 12, at 774.

<sup>108</sup> *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1738 (T.T.A.B. 1999), *rev'd*, 284 F. Supp. 2d 96 (D.D.C. 2003).

<sup>109</sup> *See* U.S. PATENT AND TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1203.01 (4th ed. 2005).

<sup>110</sup> *In re Wilcher Corp.*, 40 U.S.P.Q.2d (BNA) 1929, 1930 n.3 (T.T.A.B. 1996) (citing *In re Budge Mfg. Co.*, 857 F.2d 773, 775 (Fed. Cir. 1988)).

<sup>111</sup> *In re Budge Mfg. Co.*, 857 F.2d at 775.

not indicate the perception of—or emotional effect on—particular individuals, which is the central focus of the 2(a) inquiry.<sup>112</sup>

In some cases, the TTAB only considers dictionary definitions of words before denying registration of a mark. In *In re Runsdorf*, the TTAB affirmed the examiner's refusal, which was based solely on a dictionary definition of "bubby" as "[b]reast, now often considered vulgar."<sup>113</sup> And in *In re Tinseltown, Inc.*, the TTAB affirmed the examiner's refusal to register the mark BULLSHIT for women's handbags<sup>114</sup> based on the dictionary's editorial label of "usu. considered vulgar" to the term, "bullshit."<sup>115</sup> However, "vulgar" is not necessarily determinative of scandalousness or immorality, as something that is vulgar may or may not cause "shock to the conscience." In fact, precisely relevant to this issue, the Federal Circuit Court of Appeals noted

the inherent fallibility in defining the substantial composite of the general 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.<sup>116</sup>

In *In re Mavety Media Group Ltd.*, the examining attorney denied registration for the mark BLACK TAIL for an adult entertainment magazine, relying "upon a dictionary reference defining 'tail' as 'SEXUAL INTERCOURSE—usu. considered vulgar.'"<sup>117</sup> While the court declined to decide the larger issue, "whether a standard dictionary definition and its accompanying editorial designation of vulgarity conclusively demonstrates that a substantial composite of the general public considers [a] word scandalous,"<sup>118</sup> it did hold that the existence of an alternate, nonvulgar definition of the term was enough to demonstrate that a substantial

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<sup>112</sup> See Gibbons, *supra* note 14, at 208 ("Depending on the examining attorney's choice of dictionaries, the current denotations of the questioned mark may not be adequately addressed. Some dictionaries are slower in recognizing new meanings given to existing words." (footnote omitted)).

<sup>113</sup> See *In re Runsdorf*, 171 U.S.P.Q. (BNA) 443, 443 (T.T.A.B. 1971) (citing WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 287 (1968)).

<sup>114</sup> See *In re Tinseltown, Inc.*, 212 U.S.P.Q. (BNA) 863, 866 (T.T.A.B. 1981) (citing WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 294 (3rd ed. 1976)).

<sup>115</sup> See *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1372-73 (Fed. Cir. 1994).

<sup>116</sup> *Id.* at 1373.

<sup>117</sup> *Id.* at 1369 (citing WEBSTER'S NEW COLLEGIATE DICTIONARY 1178 (1981)).

<sup>118</sup> *Id.* at 1373.

composite of the general public would not necessarily attach a vulgar meaning to the term "tail" in BLACK TAIL.<sup>119</sup>

In *In re Riverbank Canning Co.*, for example, in affirming the rejection of MADONNA as a mark on wine, the CCPA took into consideration that, despite prior registrations of the mark for a host of other goods, the court looked at "the excessive use of wine" as "a great evil" and the existence of the Virgin Mary as "the highest example of the purity of womanhood."<sup>120</sup> In *In re Old Glory Condom Corp.*, the examining attorney argued that registration for prophylactics that were colored red, white, and blue, resembling the American flag, would surely offend a substantial composite of the American public because the American flag was a "sacrosanct" symbol.<sup>121</sup> She supported her refusal by alluding to an unsuccessful proposed amendment to the U.S. Constitution to prohibit flag burning and the public outcry that followed rock star Madonna doing a TV commercial scantily clad in the American flag.<sup>122</sup> In denying the registration of the aforementioned mark, MOONIES, for a doll that drops its pants, the examining attorney cited an article appearing in *U.S.A. Today* which indicated that the term "Moonies" may be viewed by some members of The Unification Church as being derogatory.<sup>123</sup> Reversing the examining attorney's refusal, the TTAB noted, among other things, that there were many more articles that suggested the term "moonies" was not derogatory.<sup>124</sup>

## VI. CONCLUSION

When BULLSHIT for handbags will scandalize the public, but BIG PECKER for T-shirts will not; when CLEARLY QUEER for clothing will register, but QUEER GEAR, also for clothing, will not; when TWATTY GIRL for cartoon strips is rejected, but TWATTY for cartoon strips is not, it is time to reexamine the structure and implementation of the section 2(a) bars. The bar to registration for marks that are scandalous, immoral, or disparaging is simply not effective as applied. Section 2(a) not only expands trademark law beyond its basic foundation—to promote fair competition, to

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<sup>119</sup> See *id.* at 1374. It is an open question whether the appropriate inquiry would be a substantial composite of the general public, or the general public who might be likely to purchase (or encounter) adult-entertainment magazines.

<sup>120</sup> See *In re Riverbank Canning Co.*, 95 F.2d 327, 329 (C.C.P.A. 1938).

<sup>121</sup> See *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1217, 1220 (T.T.A.B. 1993).

<sup>122</sup> See *id.* at 1220-21.

<sup>123</sup> See *In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654 n.4 (T.T.A.B. 1990).

<sup>124</sup> See *id.*

prevent consumer confusion, and to protect consumers' ability to distinguish goods in the marketplace—but also it creates an unworkable standard that is unclear and inconsistently applied, both at the examination level and the appellate level. At the registration level, trademark examiners are forced to make decisions based on inadequate evidence. In addition, application of the standards across the board fails to take into account contextually relevant information, including the reappropriation of words and phrases by disadvantaged groups. These content-based determinations are highly subjective and vary with time, context, and tribunal. By creating an ambiguous normative framework with little predictive quality, the section 2(a) bars are unreasonable and ineffective.