

Fall 9-1-2016

# Contextual Healing: What to Do About Scandalous Trademarks and Lanham Act 2(a)

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## Recommended Citation

Megan M. Carpenter, *Contextual Healing: What to Do About Scandalous Trademarks and Lanham Act 2(a)*, 68 *Hastings L. J.* 1 (Fall 2016).

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## Articles

# Contextual Healing: What to Do About Scandalous Trademarks and Lanham Act 2(a)

MEGAN M. CARPENTER\*

*Offensive trademarks have come to the forefront of trademark policy and practice in recent years. While it was once true that more attention had been paid to Lanham Act section 2(a) in the pages of law reviews than in the courts,<sup>1</sup> recent cases have focused attention on the ban on registration of offensive marks and the widespread impact of this ban on trademark owners, including a case before the Supreme Court this term.<sup>2</sup> In this Article, I answer the fundamental question: Given the problems previous research has identified, what should be done about the 2(a) bar for scandalous marks?<sup>3</sup>*

*This Article argues, as a preliminary matter, that the registration bar for scandalous marks be removed from the Lanham Act because morality is outside the function and purpose of trademark law. Furthermore, removal of the bar would be in line with other forms of intellectual property, which have moved away from regulating morality. Finally, removing the bar would resolve concerns about the constitutionality of section 2(a). However, if the 2(a) bar remains part of the Lanham Act, it should be applied in a way that is fair and effective within the legal framework of trademark law. Specifically, this Article argues that trademark examiners should evaluate offensiveness in the same way other bars to registration—and content in broadcast media—are evaluated: by considering the context of the marketplace.*

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\* Professor of Law and Founder and Co-Director of the Center for Law and Intellectual Property at Texas A&M University School of Law. I am indebted to the research assistance of Mary Garner, as well as to the participants in the Chicago Intellectual Property Colloquium (2016), Intellectual Property Scholars Conference (Chicago, 2015), Fordham Intellectual Property Conference (2016), and Works in Progress in Intellectual Property Conference (Arlington, 2015) for helpful feedback and commentary.

1. Christine Haight Farley, *Stabilizing Morality in Trademark Law*, 63 AM. U. L. REV. 1019, 1020 (2014). Additional articles on the topic include, e.g., Megan M. Carpenter & Kathryn T. Murphy, *Calling Bulls\*\*t on the Lanham Act*, 49 U. LOUISVILLE L. REV. 465 (2011); Jasmine Abdel-Khalik, *To “Live in In-“Fame”-Y: Reconceiving Scandalous Marks as Analogous to Famous Marks*, 25 CARDOZO ARTS & ENT. L.J. 173 (2007); Megan M. Carpenter & Mary Garner, *NSFW: An Empirical Study of Scandalous Trademarks*, 33 CARDOZO ARTS & ENT. L.J. 321 (2015); Anne Gilson LaLonde & Jermone Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*, 101 TRADEMARK REP. 1476 (2011); Michelle B. Lee, *Section 2(a) of the Lanham Act as a Restriction on Sports Team Names: Has Political Correctness Gone Too Far?*, 4 SPORTS LAW. J. 65 (1997); Regan Smith, *Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks*, 42 HARV. C.R.–C.L. L. REV. 451 (2007).

2. See, e.g., *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015); *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015).

3. In my previous scholarship on the subject, I discussed problems with both the application and interpretation of the ban and completed an empirical study of rejections under section 2(a). Carpenter & Murphy, *supra* note 1; Carpenter & Garner, *supra* note 1.

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INTRODUCTION

Section 2(a) of the Lanham Act prohibits registration of trademarks that are “scandalous” or “immoral.” In my previous research, I have identified two relevant questions regarding this aspect of the 2(a) bar: First, can (and does) the Lanham Act effectively bar registration of scandalous and immoral marks? Second, should it do so? The first question was the central inquiry of two articles on the subject. *Calling Bulls\*\*t on the Lanham Act* discussed some initial practical problems with the interpretation and application of 2(a).<sup>4</sup> The second piece provided an in-depth, empirical study of this prohibition.<sup>5</sup> In order to best normatively evaluate the effectiveness of the bar and to determine

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4. See generally Carpenter & Murphy, *supra* note 1 (discussing practical problems with the interpretation and application of section 2(a)).

5. See generally Carpenter & Garner, *supra* note 1 (providing an empirical study of the prohibition on scandalous or immoral trademark registration).

whether it should be removed, it is critical to know how the provision is being applied in practice throughout the registration process. While many scholars have written on the morality provisions of the Lanham Act, this was the first empirical study of scandalous marks. Through an examination of the trademark records for 232 marks, the project examined why marks were being rejected for scandalousness, what evidence was being used in the rejections, what inconsistencies exist throughout the process, and what the practical impact of these rejections may be on the use of trademarks in the marketplace, either by the original applicants or otherwise.<sup>6</sup> This empirical project demonstrated that the application of the 2(a) bar for scandalous marks is inconsistent and ineffective.

This Article tackles the second question head-on. First, it argues that the 2(a) bar should be removed because the Lanham Act should not bar registration of trademarks that are deemed scandalous or immoral.<sup>7</sup> The bar is inconsistent with both the object and purpose of trademark law and the evolution of morality bars in intellectual property law generally, and it may be unconstitutional.

However, there are reasons to think that the bar may not be overturned. If that is the case, how can it be applied in a way that is effective, fair, and in harmony with the body of trademark law? In response to this question, the bulk of this Article argues that 2(a) would be more effectively applied if trademark examiners considered limited contextual factors in their analysis of trademark registration applications; consideration of context is consistent with other bases for rejection and other forms of content regulation. Specifically, this Article argues that trademark examiners should conduct a 2(a) analysis for scandalousness by considering the mark in the context of the relevant marketplace. This solution is in line with the overarching body of trademark law, which evaluates trademarks in context. Marks are often rejected for being “scandalous” in the abstract based on dictionary definitions that note a particular term is “offensive” or “vulgar.” These refusals fail to consider whether a mark is scandalous in the context of the relevant marketplace for goods and services identified in the application, which should be a material aspect of the inquiry.

This Article’s proposal would bring the morality bar in line with the general body of trademark law, which focuses on trademark rights not as rights in gross, but rights appurtenant to a particular business.<sup>8</sup> Context is

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6. *Id.*

7. See *In re Tam*, 808 F.3d at 1329.

8. *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918) (“The asserted doctrine is based upon the fundamental error of supposing that a trade-mark right is a right in gross . . . . There is no such thing as property in a trade-mark except as a right appurtenant to an established business or trade in connection with which the mark is employed.”).

a common consideration throughout the registration process, and examining attorneys routinely consider contextual factors in other areas of trademark registration, most notably in a likelihood of confusion analysis, but also for refusals on a variety of bases, including descriptiveness, functionality, and deceptiveness.<sup>9</sup> In fact, it is unusual not to consider marketplace context in the application process. If we are going to prohibit registration of marks that are scandalous or immoral, that evaluation should consider context in the same way that other registration bars do.

This Article proceeds in five parts. Part I traces the role and function of trademarks over time, and identifies core functions of trademarks as source identifiers and mechanisms for consumer protection. These functions support the efficiency of consumer search costs and incentivize producers to invest in the goodwill of their goods and services. Part II argues that the bar on registration of scandalous marks should be removed; in order to stay in line with its core function and developments in intellectual property law generally, trademark law should move away from considering scandalousness as a bar to registration. This would be consistent with recent case law on disparaging marks, and with other forms of intellectual property, which have moved away from regulating morality. While in the past copyright and patent regimes conditioned acquisition or maintenance of rights on the morality of works or inventions, they no longer do so.

The second half of this Article contemplates the retention of 2(a) within the Lanham Act. Part III proposes that while the registration bar is in existence, it would be more effectively applied if trademark examiners considered contextual factors in their analysis. So long as the bar is in effect, we should interpret and apply it in a way that is effective, fair, and in harmony with the body of trademark law. Consideration of context is further consistent with other forms of content regulation. Part IV discusses the relevance of context in trademark registration, particularly with regard to likelihood of confusion—the key *DuPont* factors considered by examiners in a likelihood of confusion analysis of an application, for example, all focus on aspects of context. Similarly, other registration bars, such as descriptiveness and functionality, focus on aspects of context. Finally, Part V demonstrates that this proposed change would be consistent with other forms of content regulation, which have evolved to accommodate context.

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9. See U.S. PATENT & TRADEMARK OFFICE, TMEP § 1207 (Apr. 2016).

## I. HISTORICAL DEVELOPMENT OF TRADEMARK FUNCTION

### A. TRADEMARKS HAVE DEVELOPED THROUGHOUT HISTORY TO PROTECT SOURCE QUALITY, NOT MORAL QUALITY

The type of consumer protection at the base of trademark law is not a moral one. Trademarks serve to identify a source of goods and services and to distinguish them from others. Toward that end, trademarks have a strong qualitative component. However, the quality with which trademark law is concerned is source quality; moral quality is not part of the core function and purpose of trademark law, and it should not be.

#### *I. Trademarks Developed as Source Identifiers*

The historical development of trademarks demonstrates a focus on source quality. While trademark law is a relatively recent phenomenon, trademarks as identifying marks of ownership or source predate reading and writing. Cave paintings in Europe and wall paintings in Egypt, dating from the late Stone Age or early Bronze Age, both show the act of cattle branding, which was likely the first use of a trademark.<sup>10</sup> The verb “to brand,” in fact, is derived from the Old English *brand* or *brond*, meaning “firebrand” or “piece of burning wood.”<sup>11</sup> In 1552, the word “brand” signified “identifying mark made by a hot iron,” but by 1827, this use had broadened to “a particular make of goods.”<sup>12</sup>

Trademarks worldwide have historically served to identify a source of goods and services. Pottery found in Greece and Rome usually had the maker’s name inscribed on the handle.<sup>13</sup> Chinese porcelain had date marks, and sometimes a maker’s mark, the place of manufacture, or the destination of the particular piece.<sup>14</sup> Bricks and tiles from Egypt have been found that contain identifying marks, including the inscription or symbol of the monarch, and the particular building project for which the bricks and tiles were to be used.<sup>15</sup> Egyptian signboards, with distinct marks and sometimes rebuses, have also been discovered.<sup>16</sup> Hindu goods

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10. Sidney A. Diamond, *The Historical Development of Trademarks*, 65 TRADEMARK REP. 265, 266–67 (1975).

11. *Brand*, ONLINE ETYMOLOGY DICTIONARY, [http://www.etymonline.com/index.php?term=brand&allowed\\_in\\_frame=0](http://www.etymonline.com/index.php?term=brand&allowed_in_frame=0) (last visited Nov. 7, 2016).

12. *Id.*

13. Diamond, *supra* note 11, at 267; Gerald Ruston, *On the Origin of Trademarks*, 45 TRADEMARK REP. 127, 132 (1955); Benjamin G. Paster, *Trademarks—Their Early History*, 59 TRADEMARK REP. 551, 553 (1969).

14. Diamond, *supra* note 11, at 267; Paster, *supra* note 14, at 552.

15. Diamond, *supra* note 11, at 268; Paster, *supra* note 14, at 552–53; *see also* Ruston, *supra* note 14, at 131.

16. Diamond, *supra* note 11, at 272.

dated from 1300 B.C. were traded between India and Asia Minor and regularly utilized trademarks to indicate source.<sup>17</sup>

Over time, trademarks grew to represent the goodwill of their producers. Historian Sidney Diamond notes the proliferation of potters' marks used on Roman goods, particularly oil lamps, during the period 35 B.C. to 265 A.D.—approximately 1000 marks have been identified as in use during that period of time.<sup>18</sup> Since then, trademarks have been an integral aspect of trade. After a decline in the Dark Ages, the Medieval Period saw the development of personal marks, proprietary marks, and geographical appellations.<sup>19</sup> Personal marks included coats of arms, seals, and house marks.<sup>20</sup> House marks identified a family in residence and were literally affixed to a house. If a member of that family became a business owner, the house mark became a way of signifying the source of the business, as well.<sup>21</sup> Sometimes house marks were also placed on goods, either of a particular family business or of the household generally.<sup>22</sup> Proprietary marks on goods enabled individuals to identify their tools and other articles, including farm animals, in the event they were lost or stolen.<sup>23</sup> Geographical indications were often placed on goods that were likely to be part of a broader stream of commerce, such as tapestries and cloth.<sup>24</sup> Some tapestries also contained what would be the equivalent of a certification mark, certifying a particular level of quality for the goods.<sup>25</sup> It is also claimed that during this period, in 1544, Charles V pronounced by edict that marks identifying the city of origin and maker were required on tapestries.<sup>26</sup> The punishment for trademark infringement was amputation of the right hand.<sup>27</sup>

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17. *Id.* at 270.

18. *Id.* at 271; see also Paster, *supra* note 14, at 553–54. Of particular success was the FORTIS brand; FORTIS brand oil lamps have been found as far away as France, Germany, Holland, England, and Spain. The wide range of brand distribution may be attributed not only to the success of the FORTIS brand, but also to other incidental novelties. Brian J. Winterfeldt, *Historical Trademarks: In Use Since . . . 4,000 B.C.*, INT'L TRADEMARK ASS'N BULL., Mar. 2002, <http://www.inta.org/INTABulletin/Pages/HistoricalTrademarksInUseSince4000BC.aspx>; Rossella Lorenzi, *Roman 'Factory Town' for Oil Lamps Found*, NBC News (Dec. 5, 2008, 1:27 PM), [http://www.nbcnews.com/id/28072109/ns/technology\\_and\\_science-science/t/roman-factory-town-oil-lamps-found/#.WBaNLsorJaQ](http://www.nbcnews.com/id/28072109/ns/technology_and_science-science/t/roman-factory-town-oil-lamps-found/#.WBaNLsorJaQ) (discussing the discovery of pottery center where oil lamps used in the ancient Roman Empire were made). Perhaps the FORTIS brand was one of the first broad trademark counterfeiting operations. Or, perhaps the mark FORTIS became the first generic designation, signifying a particular type of oil lamp rather than a brand.

19. Paster, *supra* note 14, at 555.

20. Diamond, *supra* note 11, at 272; Ruston, *supra* note 14, at 136–38.

21. Diamond, *supra* note 11, at 272–73; see Ruston, *supra* note 14, at 136–38; Paster, *supra* note 14, at 560–61.

22. Diamond, *supra* note 11, at 273; Ruston, *supra* note 14, at 136–38.

23. Diamond, *supra* note 11, at 273.

24. *Id.*

25. *Id.*

26. *Id.* at 279.

27. *Id.* Diamond points out that the dates recorded for the identifying marks edict and the punishment conflict, the former documented as occurring in 1544 with the latter documented in 1554.



Ironically, between the invention of the printing press and the development of the concept of copyright, it was the trademark that governed original works fixed in a tangible medium. That is, where works were not protected by copyright, their indication of source was often determinative of their value. The trademark, for example, sat at the center of competition in the publishing trade. Printers and publishers competed for the most accurate version of a particular work, and in that regard used trademarks as an identification of source.<sup>28</sup> Trademarks served as the mechanism for protection of visual art, as well. In 1512 Albrecht Dürer brought a complaint against an individual who was copying his works.<sup>29</sup> Rather than complaining about the copying of the work *per se*, however, Dürer asked that the individual be prevented from using “AD” as a source-identifying mark.<sup>30</sup> The Council of Nuremberg complied.<sup>31</sup>

Using trademarks as an indicator of source became commonplace during the Industrial Revolution.<sup>32</sup> From English pewter to French porcelain to American silversmithing, trademarks became widely used in the marketplace.<sup>33</sup> In 1783, an English court held that to infringe a trademark was fraud, and damages would be assessed accordingly.<sup>34</sup>

## 2. Trademarks Have Evolved to Identify Quality

From the cattle-brands of Egypt in the late Stone Age to the proprietary and house marks in England during the Medieval Ages, trademarks worldwide were clearly placed on goods to identify a particular source. As the characteristics and functions of trademarks have evolved over time, however, the property interest in trademarks has grown stronger. In *Gilson on Trademarks*, Gilson notes that the distinction between how a trademark operates and why it should be protected is often blurred by courts, and, furthermore, that courts, legislatures, and commentators have differed in their views over time with changes in economy and culture.<sup>35</sup>

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It is possible this discrepancy was due to a typographical error. Diamond further notes that there is no documented evidence of enforcement; that is, no indication that any infringer’s right hand was actually cut off. *Id.* at 279–80. See Ruston, *supra* note 14, at 141 (dating Charles V’s edict regarding punishment of an infringer to 1554).

28. Diamond, *supra* note 11, at 275; Ruston, *supra* note 14, at 139; Paster, *supra* note 14, at 558–59. In fact, the works of Livy, published by Aldus of Venice, contain a warning against imitations in the preface of the book. Diamond, *supra* note 10, at 275.

29. Diamond, *supra* note 11, at 279.

30. *Id.*

31. *Id.*; Paster, *supra* note 14, at 556–57.

32. See Diamond, *supra* note 11, at 280–81; Paster, *supra* note 14, at 564.

33. Diamond, *supra* note 11, at 281.

34. *Singleton v. Bolton* (1783) 99 Eng. Rep. 661 (K.B.). Yet, there was no explicit law of trademarks, and no provision to try a case for trademark infringement.

35. 1 ANNE GILSON LALONDE, *GILSON ON TRADEMARKS* § 1.03 (92nd rev. ed. 2016).

During the Industrial Revolution and ensuing developments of economy and culture in the twentieth century, consumers became further removed from the producers of goods. With technology and transportation enabling mass production of goods, consumers drifted far downstream from manufacturers in the stream of commerce. Furthermore, others shared the waters—suppliers and merchants, both wholesale and retail, were integrated into the supply chain. As consumers could no longer rely exclusively on the trademark to identify a known *producer* of goods, they began to rely on marks to identify a particular *quality* of goods and/or services, for example, through the sales from a particular merchant.

In the United States, case law in the first half of the 1900s demonstrates this shift from trademarks as exclusively source identifiers to trademarks as identifiers of quality.<sup>36</sup> In *Hanover Star Milling Co. v. Metcalf*, for example, the Court held that “[t]he primary and proper function of a trade-mark is to identify the origin or ownership of the article to which it is affixed.”<sup>37</sup> The Court reasoned that the core of trademark function is to designate goods as being from a particular producer, and that consequently, trademark law bars others from applying the same mark to the same goods, “because to do so would in effect represent their goods to be of his production and would tend to deprive him of the profit he might make through the sale of the goods which the purchaser intended to buy.”<sup>38</sup> The Court summarized: “The essence of the wrong consists in the sale of the goods of one manufacturer or vendor for those of another.”<sup>39</sup> It was only slightly more than a decade later that Frank Schechter, in his article *The Rational Basis of Trademark Protection*, argued that the public had come to rely on a trademark not for the origin of goods or services, but as a measure of quality, and that trademark law should accommodate this shift in function.<sup>40</sup> In the latter half of the twentieth century, courts and trademark owners honed in on the function of trademarks as a signifier of quality in addition to source. Controlling quality began to be seen as one of the key functions of the Lanham Act.<sup>41</sup>

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36. See, e.g., *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90 (1918); *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403 (1916); *Columbia Mill Co. v. Alcorn*, 150 U.S. 460 (1893); *Canal Co. v. Clark*, 80 U.S. 311 (1871) (supporting the idea that trademarks identify a particular source of goods); see also *In re Polar Music Int'l AB*, 714 F.2d 1567 (Fed. Cir. 1983) (acknowledging a material shift from reliance on trademarks as source identifiers to quality identifiers).

37. *Hanover Star Milling Co.*, 240 U.S. at 412.

38. *Id.*

39. *Id.* at 412–13.

40. Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 824 (1927), reprinted in 60 TRADEMARK REP. 334 (1970).

41. For example, various cases discuss how ensuring quality is an important function of the Lanham Act. *El Greco Leather Prods. Co. v. Shoe World, Inc.*, 806 F.2d 392, 395 (2d Cir. 1986); *Gorenstein Enters., Inc. v. Quality Care-USA, Inc.*, 874 F.2d 431, 435 (7th Cir. 1989). *El Greco Leather* also specifically states that “[o]ne of the most valuable and important protections afforded by the Lanham Act

This principle is enshrined in two separate places in the Lanham Act. Of primary importance is the definition of a trademark itself, which provides that a trademark can be any symbol that indicates the source of goods “even if that source is unknown.”<sup>42</sup> Also, section 45 of the Lanham Act provides that a trademark may be “adopted and used by a manufacturer or merchant.”<sup>43</sup> This provision recognizes that the trademark does not always identify the producer of goods, and instead can identify other entities in the stream of commerce. Lanham Act provisions on trademark licensing support this shift from source to quality, as well. Under the Act, the owner of a federal trademark application or registration can license the right to use the mark to another party, provided that the trademark owner retains control over the nature and quality of the goods or services sold by the licensee under the mark.<sup>44</sup> As long as the trademark owner has adequate quality-control mechanisms in place, he or she does not even have to use the mark, and use by the licensee inures to his or her benefit.<sup>45</sup>

In the consumer marketplace, these functions are at base a form of consumer protection. When a consumer purchases a particular good or service, associated trademarks serve as both an indicator of source and an indicator of quality, facilitating and/or encouraging purchasing decisions. This type of consumer protection, however, should not be mistaken for one that safeguards the morality of consumers or shields them in any way from offensive content. While trademarks have a strong qualitative component, the quality with which trademark law is concerned is source quality, not moral quality.

## II. REMOVAL OF THE 2(A) BAR FOR SCANDALOUSNESS

In order to remain consistent with the core function and purpose of trademark law, the registration bar for scandalous marks should be removed. This would align with the movement of intellectual property law generally, which has shifted away from regulating morality, and with recent case law on disparaging marks. As previously mentioned in Part I, while copyright and patent regimes once conditioned acquisition or maintenance of rights on the morality of works or inventions, they no longer do so. In addition, recent case law suggests that the 2(a)

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is the right to control the quality of the goods . . .” *El Greco Leather*, 806 F.2d at 395 (citing *Menendez v. Faber, Coe & Gregg, Inc.*, 345 F. Supp. 527 (S.D.N.Y. 1972), *aff’d in relevant part and modified*, 485 F.2d 1355 (2d Cir. 1973) and *Alfred Dunhill of London, Inc. v. Republic of Cuba*, 425 U.S. 682 (1976)). It goes on to also state that “the actual quality of the goods is irrelevant; it is the control of quality that a trademark holder is entitled to maintain.” *Id.* (citing *Prof’l Golfers Ass’n of Am. v. Bankers Life & Cas. Co.*, 514 F.2d 665, 670–71 (5th Cir. 1975)).

42. 15 U.S.C. § 1127 (2016).

43. *Id.*

44. *Id.* § 1055.

45. *Id.*

registration bar for scandalous and immoral marks may be unconstitutional.

A. OTHER FORMS OF INTELLECTUAL PROPERTY HAVE MOVED AWAY FROM  
CONDITIONING PROTECTION ON MORALITY

There has been a trend toward eliminating morality-based restrictions in copyright and patent law. The prohibition on registration for scandalous and immoral trademarks sets trademark law apart from other forms of intellectual property by maintaining distinctions based on morality.

I. *Morality and Copyright Law*

While Congress has generally construed the term “writings” found in the Intellectual Property Clause of the Constitution broadly to cover almost every type of literary property, “obscene” works were denied copyright protection until fairly recently.<sup>46</sup>

The *Miller* test for obscenity paved the way for the modern view of copyrightability for obscene works. The *Miller* test asks: (1) whether the average person, applying contemporary community standards, would find that the work, taken as a whole, appeals to the prurient interest; (2) whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law; and, (3) whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value.<sup>47</sup> The Court later defined “community” as the community of the individual juror;<sup>48</sup> the “average person” to include both sensitive and insensitive adults;<sup>49</sup> and “prurient” to mean any lust that is not “normal.”<sup>50</sup>

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46. See *Hoffman v. Le Traunik*, 209 F. 375, 379 (N.D.N.Y. 1913) (holding that works must be “free from illegality or immorality” to obtain copyright protection); *contra* *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852 (5th Cir. 1979), *cert. denied*, 445 U.S. 916 (1980) (removing immoral standard). Throughout history, courts have formulated different definitions of and tests for obscenity. The Supreme Court first attempted to define obscenity by attending “Movie Day,” where the justices would gather together with their clerks to view the adult films that were the subject matter of the obscenity cases before the Court. Christopher Thomas 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, 563 n.11 (2009) (noting “that neither Justice William Douglas nor Justice Hugo Black ever attended Movie Day, as they rejected the argument that any expression could be banned. Black famously commented, ‘If I want to go see that film, I should pay my money.’” (citing *BOB WOODWARD & SCOTT ARMSTRONG, THE BROTHERS* 198 (1979))).

47. *Miller v. California*, 413 U.S. 15, 24 (1973).

48. *Hamling v. United States*, 418 U.S. 87, 105 (1974).

49. *Pinkus v. United States*, 436 U.S. 293, 298–99 (1978).

50. *Brockett v. Spokane Arcades, Inc.*, 472 U.S. 491, 498 (1985).

a. *Historical Morality Bars in Copyright Law*

In the past, copyright protection was denied to offensive works because they failed to progress science and the useful arts. The common law bar to copyright of obscene works is thought to have originated in England, when a publisher sought damages for the unauthorized sale of his work by a subsequent publisher.<sup>51</sup> In *Stockdale v. Onwhyn*, the court held that the work in question was “libelous and licentious” and that “it would be a disgrace to the common law should a court of justice protect from piracy a work on an indecent nature.”<sup>52</sup> The California Circuit Court in *Martinetti v. Maguire* adopted the *Stockdale* doctrine when it denied relief in an infringement action because the work in question did not fit within the boundaries of the Intellectual Property Clause.<sup>53</sup> Because the play featured “scant and meaningless” dialogue, “the exhibition of women in novel dress or no dress,” and consisted “mainly ‘of women lying about loose,’” it did not promote science or the useful arts.<sup>54</sup> The court elaborated: “To call such a spectacle a ‘dramatic composition’ is an abuse of language, and an insult to the genius of the English drama.”<sup>55</sup> Although the judge denied that he was acting as a conservator of public morality by denying copyright, he contradicted himself by concluding, “it is the duty of all courts to uphold public virtue, and [to] discourage and repel whatever tends to impair it.”<sup>56</sup>

Songs containing obscene lyrics were also ineligible for copyright protection because they did not progress the arts as required by the Intellectual Property Clause.<sup>57</sup> A California court held that the song “Dora Dean” was not useful (and, implicitly obscene) because it contained the lyric “the hottest thing you ever seen” in reference to an attractive woman.<sup>58</sup> The court noted that “hot” could be defined as

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51. McDavid, *supra* note 47, at 564; *Stockdale v. Onwhyn* (1826) 108 Eng. Rep. 65 (K.B.).

52. *Stockdale*, 108 Eng. Rep. at 66. The work in question was the *Memoirs of Harriett Wilson*, a story of the exploits of a notorious courtesan. Kurt L. Schmalz, *Problems in Giving Obscenity Copyright Protection: Did Jartech and Mitchell Brothers Go Too Far?*, 36 VAND. L. REV. 403, 404 (1983). In *Stockdale*, the court observed that English equity courts frequently refused to grant injunctive relief to stop piracy of morally objectionable works. This equity-focused view was based on the doctrine of unclean hands, which prevents an author tainted by the illegality of publishing an obscene work from enjoying the protection of the court’s authority. *Id.* at 405.

53. *Martinetti v. Maguire*, 16 F. Cas. 920 (C.C.D. Cal. 1867 (no. 9173)). The case concerned an infringement action regarding the play “Black Crook,” which the author slightly modified the characters and dialog in creating “Black Rook.” The court held that both plays lacked originality, and thus neither was entitled to copyright protection. *Id.* at 922–23.

54. *Id.* at 922.

55. *Id.*

56. *Id.*

57. *Broder v. Zeno Mauvais Music Co.*, 88 F. 74, 79 (C.C.N.D. Cal. 1898).

58. *Id.*

“lustful, lewd, or lecherous,” and concluded that the obscene lyrics were not copyrightable.<sup>59</sup>

Throughout the 1900s, however, courts began to erode the bar for obscene works. In 1925, in a case that serves as an exemplar for changing mores, a court echoed the morality requirement for copyright protection, but failed to apply it.<sup>60</sup> A district court in New York held that the play *White Cargo* infringed upon the novel *Hell's Playground*, even though the works were “unnecessarily coarse and highly sensual.”<sup>61</sup> The novel and the play both depicted an Englishman’s affair with a West African native in the French Congo. The court did not find the work in question immoral, but stated that copyright would have been invalid if it were.<sup>62</sup>

The difficulty of applying morality to copyright was acknowledged in litigation over the movie *When Tomorrow Comes*, a movie in which a couple engaged in “indecent and vulgar” acts before a church altar.<sup>63</sup> Interestingly, the court in this case did not apply the *Martinetti* rule to invalidate the copyright.<sup>64</sup> Rather, the court applied the U.S. Post Office’s definition of obscenity that was used to keep pornography out of the mail. This test considers the works as a whole and proscribes the work if it has a “direct tendency to corrupt morals.”<sup>65</sup> The court determined that the work was not obscene because the woman who desecrated the altar was killed at the end of the film, and thus cured the film of any possible immorality.<sup>66</sup>

The last gasp of moral regulation in copyright occurred when the New York Supreme Court refused to allow copyright on a plaintiff’s satirical strip-tease dance because it failed to promote the objectives of copyright.<sup>67</sup> Although the decision was not based on moral outrage, as was the focus in earlier decisions, the court denied copyright because the dance failed to promote the progress of science and useful arts.<sup>68</sup> The court reasoned: “[N]ot everything [that is] put on the stage can be subject to copyright. While plaintiff’s performance was no doubt amusing and entertaining to many, it does not fall within the purview of the statute as a production tending to promote the progress of science and useful arts.”<sup>69</sup>

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59. *Id.*

60. *Simonton v. Gordon*, 12 F.2d 116, 124 (S.D.N.Y. 1925).

61. *Id.*

62. *Id.*

63. *Cain v. Universal Pictures Co.*, 47 F. Supp. 1013, 1018 (S.D. Cal. 1942).

64. *See id.*

65. *Id.*

66. *Id.*

67. *Dane v. M. & H. Co.*, 1963 WL 8060, at \*4 (N.Y. Sup. Ct. Jan. 25, 1963).

68. *Id.*

69. *Id.* (“Where a performance contains nothing of a literary, dramatic or musical character which is calculated to elevate, cultivate, inform or improve the moral or intellectual natures of the audience, it does not tend to promote the progress of science or the useful arts.”).

*b. Modern Copyright Law Rejects Bars Based on Morality*

Although neither Congress nor the Supreme Court has explicitly weighed in, the modern view is to afford all eligible works copyright protection, regardless of the (im)morality of the content.<sup>70</sup> The Fifth and Ninth Circuits have expressly held that obscene works are copyrightable, reasoning that the need for national copyright protection outweighs the state and federal public policies against obscenity.<sup>71</sup> This is the approach taken by the Copyright Office today.

In 1979, the Fifth Circuit held in *Mitchell Brothers Film Group v. Cinema Adult Theater* that works could not be excluded from copyright because of obscene content.<sup>72</sup> In *Mitchell Brothers*, copyright owners of the adult film *Behind the Green Door* brought an infringement suit against a group of theater owners showing the film without permission.<sup>73</sup> Defendants argued that the copyright holders brought suit with “unclean hands,” and that equity should uphold obscenity as an affirmative defense to infringement.<sup>74</sup> The Fifth Circuit did not agree, rejecting the moral conservator theory of copyright invalidation,<sup>75</sup> the property interest theory,<sup>76</sup> and the unclean hands equitable doctrine.<sup>77</sup> The court reasoned that Congress had intentionally omitted, and therefore did not intend, a bar for immoral or obscene works.<sup>78</sup> The court further argued that denying copyright to obscene works was contrary to the Intellectual Property Clause’s purpose of promoting creativity,<sup>79</sup> and reasoned that the market was the appropriate arbiter in determining if a work is fit for

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70. See 1–2 NIMMER ON COPYRIGHT § 2.17 (*Mitchell* expressly held “that a work is not excluded from copyright protection by reason of its obscene content. This holding may be taken as the currently prevailing view, although [in the past], a number of previous courts took the view that obscene works are not eligible for copyright.”).

71. Schmalz, *supra* note 53, at 417.

72. *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 862 (5th Cir. 1979).

73. *Id.* at 854.

74. *Id.*

75. *See id.* at 861.

76. *See id.*

77. *See id.*

78. *Id.* at 854–55 (“We can only conclude that we must read the facially all-inclusive 1909 copyright statute as containing no explicit or implicit bar to the copyrighting of obscene materials, and as therefore providing for the copyright of all creative works, obscene or non-obscene, that otherwise meet the requirements of the Copyright Act.”). *Id.* at 858.

79. *Id.* at 856 (reserving copyright for only moral works “would be antithetical to [the] promotion of creativity. The pursuit of creativity requires freedom to explore into the gray areas, to the cutting edge, and even beyond.”) The court also cited books banned under obscenity laws as further evidence of stifled creativity. *Id.* at 857. *See, e.g.*, *Commonwealth v. Delacey*, 171 N.E. 455 (Mass. 1930) (finding *Lady Chatterley’s Lover* by D.H. Lawrence obscene); *Commonwealth v. Friede*, 171 N.E. 472 (Mass. 1930) (finding *An American Tragedy* by Theodore Dreiser obscene); *Besig v. United States*, 208 F.2d 142(9th Cir. 1953) (finding Henry Miller’s *Tropic of Cancer and Tropic of Capricorn* obscene).

public consumption.<sup>80</sup> The Ninth Circuit followed the reasoning of the Fifth Circuit in *Jartech v. Clancy*, a case decided three years after the *Mitchell Brothers* decision and the first major copyright-morality case under the Copyright Act of 1976.<sup>81</sup> The issue of copyrightability of obscene material has remained untouched at the appellate level since *Jartech*.

Perhaps the most definitive evidence that modern copyright law does not contain a morality bar is a simple search of issued U.S. Copyrights via the Copyright Office's Internet database.<sup>82</sup> The amount of potentially obscene or scandalous material that has obtained copyright protection is voluminous, and the copyright holders of pornographic and "adult" material regularly engage with the Copyright Act to enforce their exclusive rights under section 106.<sup>83</sup>

## 2. *Morality and Patent Law*

The treatment of morality in patent law is parallel to that of copyright law. Patents were once invalidated based on a theory of moral utility, which is a theory that an invention designed for an immoral purpose should not be patentable. This theory has not been used in many years, a fact that has led scholars to characterize it as a relic of the past.

### a. *Historical Morality Bars in Patent Law*

Utility patents were once subject to restrictions based on morality like the ones that trademarks are subject to today. Patent law required that "the invention should not be frivolous or injurious to the well-being, good policy, or *sound morals* of society. The word 'useful,' therefore, is incorporated into the act in contradistinction to mischievous or

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80. *Mitchell Bros. Film Grp.*, 604 F.2d at 855 (stating copyright "is best served by allowing all creative works . . . to be accorded copyright protection regardless of subject matter or content, trusting to the public taste to reward creators of useful works and to deny creators of useless works any reward.").

81. *Jartech v. Clancy*, 666 F.2d 403 (9th Cir. 1982). See Schmalz, *supra* note 53, at 416.

82. Search available at *Public Catalog*, U.S. COPYRIGHT OFF., <http://cocatalog.loc.gov/cgi-bin/Pwebrecon.cgi?DB=local&PAGE=First> (last visited Nov. 7, 2016). For example, a search for "incest" provided 221 unique registrations. *Id.*

83. Gabe Friedman, *The Biggest Filer of Copyright Lawsuits? This Erotica Web Site*, NEW YORKER (May 14, 2014), <http://www.newyorker.com/business/currency/the-biggest-filer-of-copyright-lawsuits-this-erotica-web-site>; Tony Pipitone & Sandra Esquivel, *Porn Company Sues Thousands Claiming Copyright Infringement*, NBC MIAMI (May 4, 2014), <http://www.nbcmiami.com/news/local/Porn-Company-Sues-Thousands-Claiming-Copyright-Infringement-257869461.html>; Claire Sudath, *Prenda Law, the Porn Copyright Trolls*, BLOOMBERG BUSINESSWEEK (May 30, 2013, 1:51 PM), <http://www.bloomberg.com/news/articles/2013-05-30/prenda-law-the-porn-copyright-trolls>; Kashmir Hill, *How Porn Copyright Lawyer John Steele Has Made a 'Few Million Dollars' Pursuing (Sometimes Innocent) 'Porn Pirates'*, FORBES (Oct. 15, 2012, 2:09 PM), <http://www.forbes.com/sites/kashmirhill/2012/10/15/how-porn-copyright-lawyer-john-steele-justifies-his-pursuit-of-sometimes-innocent-porn-pirates/#35d8bb59a764>.



immoral.”<sup>84</sup> Under this definition, “immoral” or “mischievous” inventions were not patentable because those uses were not beneficial to society. Justice Story cited inventions designed to poison people, promote debauchery, or facilitate private assassination as examples of immoral inventions that did not perpetuate the public good.<sup>85</sup>

This moral utility requirement was typically applied in two distinct situations: one in which the public was likely to be deceived, and the other where the invention would enable immoral behavior. Courts invalidated patents based on artifice, where a process for treating plain leaf tobacco plants made their leaves spotted, because cigar smokers believed that spotted tobacco leaves were of better quality, which enabled the inventor to sell counterfeit tobacco for a higher price.<sup>86</sup> The court denied patent protection because the invention did not improve the tobacco leaf or the cigar smoking process, and because its sole purpose was to deceive the public.<sup>87</sup> Similarly, in *Scott & Williams, Inc. v. Aristo Hosiery Co.*, the Second Circuit denied patent protection for a seamless stocking that featured an imitation seam on one side.<sup>88</sup> The prevailing thought of the time was that seamed stockings were of higher quality.<sup>89</sup> Again, the court denied patent protection because its design was deceptive.<sup>90</sup> This invention was useful in a particular way—that is, it allowed people who were unable to purchase seamed stockings to obtain the appearance of the expensive alternative. However, the court focused on the underlying artifice and refused registration.<sup>91</sup>

By the time the Federal Circuit rejected the immorality and mischief bars in 1999, they had already become somewhat of a relic, and courts rarely implicated the moral utility theory at all.<sup>92</sup> In the landmark case *Juicy Whip, Inc. v. Orange Bang, Inc.*, the patent in question created the illusion that liquid was being dispensed from a container above a spout when it was really pumped from a container hidden below the counter.<sup>93</sup> When Juicy Whip sued a competitor for infringement, the competitor claimed that the patent was invalid because it lacked utility due to its

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84. *Lowell v. Lewis*, 15 F. Cas. 1018, 1019 (C.C.D. Mass. 1817) (No. 8568); see also Llewellyn Joseph 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, 205 n.88 (2005).

85. *Lowell*, 15 F. Cas. at 1019.

86. *Rickard v. Du Bon*, 103 F. 868, 869 (2d Cir. 1900).

87. *Id.* at 872–73.

88. *Scott & Williams, Inc. v. Aristo Hosiery Co.*, 7 F.2d 1003, 1004 (2d Cir. 1925).

89. *Id.*

90. *Id.*

91. *Id.*

92. *Juicy Whip, Inc. v. Orange Bang, Inc.*, 185 F.3d 1364, 1366–67 (Fed. Cir. 1999) (“[B]ut the principle that inventions are invalid if they are principally designed to serve immoral or illegal purposes has not been applied broadly in recent years.”).

93. *Id.* at 1365; U.S. Patent No. 5,575,405 (filed Apr. 18, 1996).

deceptiveness.<sup>94</sup> The district court found the patent invalid because its purpose was to increase sales by deception, but the Second Circuit reversed.<sup>95</sup> The court reasoned that “[t]he fact that one product can be altered to make it look like another is in itself a specific benefit sufficient to satisfy the statutory requirement of utility.”<sup>96</sup> The court subsequently described several issued patents that had utility because they were designed to represent something that they were not.<sup>97</sup>

Patents were once invalid if they enabled an immoral behavior, but courts no longer do so based on the theory that the U.S. Patent and Trademark Office (“USPTO”) should not be the arbiter of morality. The evolution of disregarding morality as a basis for patentability is well illustrated in the context of gambling. In 1889, devices related to gambling were found to lack utility, and thus were unpatentable.<sup>98</sup> However, an invention solely used for gambling was granted a patent in 1977.<sup>99</sup> In *Ex parte Murphy*, the Board stated that the USPTO “should not be the agency which seeks to enforce a standard of morality with respect to gambling, by refusing, on the ground of lack of patentable utility, to grant a patent.”<sup>100</sup> Since that time, no court has relied on the moral utility doctrine in rejecting a patent.<sup>101</sup>

We can see a similar evolution away from morality in other areas of patent law as well. A patent for a novelty “keyhole finder” was invalidated by the U.S. Court of Customs and Patent Appeals (“CCPA”) in the 1950s when it was discovered that the device gave the appearance of female genitalia.<sup>102</sup> However, patents have been granted in recent decades on countless sexually explicit inventions including: an oral prophylactic,<sup>103</sup> a contraceptive and flavor delivery system,<sup>104</sup> a unisex condom,<sup>105</sup> interactive

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94. *Juicy Whip, Inc.*, 185 F.3d at 1366.

95. *Id.*

96. *Id.* at 1367.

97. *Id.*; see, e.g., U.S. Patent No. 5,762,968 (filed Mar. 12, 1996) (method for producing imitation grill marks on food without using heat); U.S. Patent No. 5,899,038 (Apr. 22, 1997) (laminated flooring imitating wood); U.S. Patent No. 5,571,545 (Jan. 23, 1996) (imitation hamburger). The court also referred to cubic zirconium, imitation gold leaf, and imitation leather. *Juicy Whip, Inc.*, 185 F.3d at 1367.

98. *Nat'l Automatic Device Co. v. Lloyd*, 40 F. 89, 89–90 (C.C.N.D. Ill. 1889).

99. *Ex parte Murphy*, 200 U.S.P.Q. (BNA) 801, 802–03 (T.T.A.B. 1977).

100. *Id.* at 803. “[W]hile some may consider gambling to be injurious to the public morals and the good order of society, we cannot find any basis in 35 U.S.C. 101 or related sections which justify a conclusion that inventions which are useful only for gambling ipso facto are void of patentable utility.” *Id.* at 802.

101. Cynthia M. Ho, *Splicing Morality and Patent Law: Issues Arising from Mixing Mice and Men*, 2 *WASH. U. J.L. & POL'Y* 247, 249 (2000).

102. U.S. Patent No. 2,632,266 (filed May 2, 1950).

103. U.S. Patent No. 4,949,731 (filed Aug. 27, 1987) (claiming both oral contraception and protection from paint entering the mouth when painting with the mouth).

104. U.S. Patent No. 4,919,149 (filed July 8, 1988).

105. U.S. Patent No. 4,966,165 (filed Aug. 12, 1988).

lingerie,<sup>106</sup> a female garment with enfolding labia majora,<sup>107</sup> couples intimacy reciprocating and pivoting two seat assembly,<sup>108</sup> a method and device for interactive virtual control of sexual aids using digital computer networks,<sup>109</sup> and a penis pump.<sup>110</sup>

*b. Modern Patent Law Avoids the Moral Utility Theory as a Basis for Rejection of Patent Rights*

In recent years, the USPTO has had the opportunity to revisit the moral utility theory, but has chosen not to do so as a basis for rejection of patent rights. The filing of patent applications for life-related patents raised the question of morality as a basis for determining patentable subject matter when cellular biologist Stewart Newman attempted to obtain a method patent for producing a half human, half animal species.<sup>111</sup> Newman's application was not filed to acquire a patent on his invention, but was rather a de facto petition to the USPTO to clarify its stance on the patentability of life.<sup>112</sup> When Newman's application was publicized, the USPTO reacted quickly with an advisory stating that all patent applications must meet strict patentability requirements and the USPTO does not discriminate against fields of technology.<sup>113</sup> It also stated that "courts have interpreted the utility requirement to exclude inventions that are deemed to be 'injurious to the well being, good policy, or good morals of society.'"<sup>114</sup> While this raised the spectre of resurrection of the moral utility theory, the USPTO did not use it as a basis for rejecting the Newman's application. Instead, the USPTO rejected the patent on the basis that it failed to claim statutory subject matter.<sup>115</sup> The USPTO has more recently acknowledged that with regard to

106. U.S. Patent No. 5,086,519 (filed Feb. 7, 1991).

107. U.S. Patent No. 5,285,531 (filed Sept. 4, 1992).

108. U.S. Patent No. 5,385,154 (filed Nov. 4, 1993).

109. U.S. Patent No. 6,368,268 B1 (filed Aug. 17, 1998).

110. U.S. Patent No. 7,651,463 B2 (filed Sept. 2, 2005). Note that some of these were issued much earlier than 1999, further suggesting that the requirement was not uniformly implemented before being formally rejected. For a more in-depth look at sexual inventions, see generally HOAG LEVINS, *AMERICAN SEX MACHINES: THE HIDDEN HISTORY OF SEX AT THE U.S. PATENT OFFICE* (1996). Also note that some of the patents would more readily offend some than others, and that some would probably have been more offensive earlier in history than they are now.

111. See *Group Faults PTO for Issuing Patent on 'Method of Producing Cloned Mammal'*, 64 *PAT. TRADEMARK & COPYRIGHT J.* 81 (2002); Benjamin D. Enerson, Note, *Protecting Society from Patently Offensive Inventions: The Risk of Reviving the Moral Utility Doctrine*, 89 *CORNELL L. REV.* 685, 693 (2004).

112. Seán M. Coughlin, *The Newman Application and the USPTO's Unnecessary Response: Patentability of Humans and Human Embryos*, 5 *CHI-KENT J. INTELL. PROP.* 90, 90 (2006). Newman is generally against patenting life, and sought to "spur debate about the ethics of genetic engineering and patenting life forms." *Id.* at 92.

113. Press Release, U.S. Patent and Trademark Office, Facts on Patenting Life Forms Having a Relationship to Humans (Apr. 1, 1998), <http://www.uspto.gov/web/offices/com/speeches/98-06.htm>.

114. *Id.* (citing *Lowell v. Lewis*, 15 F. Cas. 1018 (C.C.D. Mass. 1817) (No. 8568)).

115. See *id.*; U.S. PAT. & TRADEMARK OFF., Vol. 1077 (No. 3), OFF. GAZ. PAT. & TRADEMARK OFFICE 8 (1987) ("A claim directed to or including within its scope a human being will not be considered to be

DNA sequences it is without authority to deny a patent based on morality. The USPTO has stated:

The scope of subject matter that is eligible for a patent, the requirements that must be met in order to be granted a patent, and the legal rights that are conveyed by an issued patent, are all controlled by statutes which the USPTO must administer. . . . Congress creates the law and the Federal judiciary interprets the law. The USPTO must administer the laws as Congress has enacted them and as the Federal courts have interpreted them. Current law provides that when the statutory patentability requirements are met, there is no basis to deny patent applications . . . .<sup>116</sup>

*c. Design Patents Retain a Morality Bar but It Is Infrequently Applied in Practice*

U.S. law provides modified patent protection for inventions of “new, original and ornamental design for an article of manufacture . . . .”<sup>117</sup> Unlike utility patents, design patents are barred for subject matter that could be offensive to any race, religion, sex, ethnic group, or nationality.<sup>118</sup> However, this bar is infrequently used. While rejections of design patent applications are not published, and no statistics on design patent rejections are publicly available from the USPTO, it is at least some indication that there are no appeals on record for rejections on this basis.<sup>119</sup> In addition, there are many examples of existing design patents for material that may reasonably be found offensive to a race, religion, sex, ethnic group, or nationality:

- Bottle with frontal female nudity<sup>120</sup>
- Buddha golf head cover<sup>121</sup>
- A.R. Conner Flag (flag depicting an African-American caricature, along with a watermelon, a chicken, and a rat)<sup>122</sup>
- Pasta box depicting the Last Supper<sup>123</sup>

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patentable subject matter under 35 U.S.C. [§] 101.”). Enerson, *supra* note 113, at 693; U.S. Patent & Trademark Office, Non-final Office Action Summary of App. No. 08/993,56, at 17 (Oct. 7, 2003) (presenting a new standard: Claims embracing humans and human embryos are not patentable).

116. Utility Examination Guidelines, 66 Fed. Reg. 1092, 1095 (Jan. 5, 2001). The Utility Examination Guidelines are instructions to be used by USPTO examiners when assessing the patentability of a claimed invention.

117. 35 U.S.C. § 171 (2012).

118. See U.S. PAT. & TRADEMARK OFF., MPEP § 1504.01(e) (8th ed. Rev. 7, July 2008).

119. In addition, correspondence with USPTO Patent Attorney David Gerk, who specializes in design patent applications, supports this conclusion. Regarding rejection of design patents for offensiveness, he states: “[T]his is not something I understand comes up frequently.” E-mail from David Gerk, Patent Attorney, Office of Policy & Int’l Affairs, U.S. Patent & Trademark Office, to Megan Carpenter, Professor of Law, Tex. A&M Univ. Sch. of Law, and Author of this Article (Feb. 3, 2015, 8:40 AM) (on file with author).

120. U.S. Patent No. D721,974 S (filed June 28, 2013) (issued Feb. 3, 2015).

121. U.S. Patent No. D465,821 S (filed Dec. 4, 2001) (issued Nov. 19, 2002).

122. U.S. Patent No. D35,985 (filed June 9, 1902) (issued Aug. 5, 1902) (flag picturing an African-American caricature along with a watermelon, chicken, and a rat).

B. LIKE OTHER FORMS OF INTELLECTUAL PROPERTY, TRADEMARKS SHOULD MOVE AWAY FROM CONDITIONING PROTECTION ON MORALITY

While trademark rights are distinct in certain ways from other forms of intellectual property, trademarks are part of the body of intellectual property law, and the development of copyright and patent law can be insightful.<sup>124</sup> Intellectual property law generally provided a starting point for consideration of the vesting of trademark rights and the interpretation of trademark doctrine, including registration of marks and federal legislation.<sup>125</sup> While there was some resistance to bringing trademarks within the umbrella of intellectual property law, trademarks are now categorically considered to be a form of human creativity that may be treated as an asset. Central to the initial resistance was the claim that trademarks were not a form of property, but rather a device to prevent forgery or fraud: “[I]t should be remembered that there was this important difference between patents and trade marks, that copying or infringing the latter was really analogous to forgery, while the infringement of a patent was merely interfering with a private right of property.”<sup>126</sup> Trademarks are now commonly considered a form of intellectual property right, even if that right is an instrumental one, as described in *Hanover Star Milling Co.*,<sup>127</sup> and *United Drug v. Theodore Rectanus*.<sup>128</sup> In evaluating priority and territorial limitations of the individual uses, the Court in *Hanover* treated the trademark at issue as a property right to the extent that it served as an instrumentality to a trade reputation and the goodwill that flows from that. The Court stated that the property interest in a trademark exists, but is limited to that “appurtenant to an established business or trade in connection with which the mark is used.”<sup>129</sup> The property interest, thus, inheres in connection with the goodwill of an existing business, and a trademark’s ability to signify that source.<sup>130</sup>

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123. U.S. Patent No. D627,661 S (filed Jan. 4, 2010) (box of pasta depicting the Last Supper on the box). Although the scene appears to be accurately depicted, the existence of the Last Supper on a pasta box may offend someone, and copyright protection might be more appropriate.

124. See Diamond, *supra* note 10, at 288; Paster, *supra* note 13, at 566; Rudolf Callmann, *Unfair Competition Without Competition? The Importance of the Property Concept in the Law of Trade-Marks*, 95 U. PA. L. REV. 443, 454–57 (1947); see also *In re Trade-Mark Cases*, 100 U.S. 82 (1879); *Millington v. Fox* (1838) 40 Eng. Rep. 956.

125. BRAD SHERMAN & LIONEL BENTLY, *THE MAKING OF MODERN INTELLECTUAL PROPERTY LAW* 168–69 (1999).

126. *Id.* at 172.

127. *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 411 (1916) In *Hanover Star Milling Co.*, three entities all had separate claims to the mark TEA ROSE as applied to flour. *Id.*

128. *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918).

129. *Hanover Star Milling Co.*, 240 U.S. at 414.

130. *United Drug Co.*, 248 U.S. at 97. This case also focused on the territorial scope of trademark protection, and supports this view of trademarks as an instrumentality, stating that the notion of a trademark as a right in gross or at large is a “fundamental error.” *Id.* Trademarks are, rather, a “means

Trademarks are one of the main forms of intellectual property, therefore it is worth considering the development of the other forms of intellectual property when advancing its development. Like trademark law, copyright and patent law once conditioned acquisition or maintenance of rights on its subjects' morality. As previously discussed, copyright was denied to offensive works because those types of works failed to promote the progress of science and the useful arts. Patent rights were once conditioned on the moral utility of an invention. However, both forms of intellectual property have moved away from using morality as a basis on which to deny protection, because doing so would be outside the core functions of those bodies of law. Because regulating morality is also outside the core function of trademark law, it should also remove these bars.

### C. THE MORALITY BAR FOR SCANDALOUS AND IMMORAL MARKS MAY BE UNCONSTITUTIONAL

As discussed previously, removing the 2(a) bar for registration of scandalous and immoral trademarks would be in line with the function and purpose of trademark law, and with other forms of intellectual property. In addition, the Federal Circuit has held that a bar on registration of scandalous and immoral trademarks is unconstitutional as a content-based restriction on speech—it denies certain benefits to scandalous and disparaging speech that it provides to non-scandalous and non-disparaging speech.<sup>131</sup> As a content-based restriction of private speech, the bar is presumptively invalid and subject to strict scrutiny—the focus of the government action is on the expressive, not commercial, functions of the particular speech involved. To overcome this presumption of invalidity, a restriction must be narrowly tailored to serve a compelling state interest.<sup>132</sup> If scandalous marks rise to the level

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for facilitating the protection of one's good-will in trade," and the accompanying rights grow out of the use of a mark, not the adoption of it. *Id.* at 98. The Court grounded trademark law in the law of unfair competition. *Id.* at 97. The Lanham Act, the comprehensive federal trademark act which came into force in 1947, supports this perspective and provides the core of trademark law even today. The Lanham Act was principally drafted by Edward S. Rogers of Chicago, and introduced into Congress by Texas Congressman Fritz Lanham. Edward S. Rogers, *The Lanham Act and the Social Function of Trade-Marks*, 14 L. & CONTEMP. PROBS. 173, 180 (1949) (arguing that the purpose of the Lanham Act was to protect trade-marks and to repress unfair competition, as well as to encourage the use of trade-marks and thus recognize their social value) (citing Edward S. Rogers, *Introduction to DAPHNE ROBERT, THE NEW TRADE-MARK MANUAL: A HANDBOOK ON PROTECTION OF TRADE-MARKS IN INTERSTATE COMMERCE* XIV (1947)).

131. *In re Tam*, 808 F.3d 1321, 1329 (Fed. Cir. 2015) (stating that this provision in the Lanham Act serves as a content-based restriction on speech).

132. The Federal Circuit recently held in *In re Tam* that the bar on registration of disparaging marks does not serve a compelling state interest, given the viewpoint-based nature of the restriction. The registration bar for scandalous marks would not constitute viewpoint-based discrimination, however, because it does not value one perspective over another. *Id.*

of obscenity, the government would have sufficient interest in restricting them and would be able to overcome the presumption. However, if scandalous marks only rise to a lesser standard, such as vulgarity or offensiveness, the registration bar would be more likely to be unconstitutional.

The Trademark Manual of Examining Procedure (“TMEP”), case law, and empirical research all indicate that the standard for scandalousness is below the obscenity standard. The TMEP states: “[T]he threshold is lower for what can be described as ‘scandalous’ than for ‘obscene.’”<sup>133</sup> Under current case law, a mark is scandalous if multiple dictionaries indicate a proposed mark is vulgar and the applicant’s use is limited to the vulgar meaning.<sup>134</sup> Vulgarity and offensiveness, in fact, are used as the standard in the majority of rejections based on scandalousness.<sup>135</sup> My research has found that dictionary definitions noting that a word is “vulgar” or “offensive” were used as a primary source of support for a rejection based on scandalousness ninety-one percent of the time, and that examiners used *only* the dictionary in seventy percent of such refusals.<sup>136</sup> Thus, their regulation is unlikely to rise to the level of a compelling state interest.

Courts have long assumed that the 2(a) registration bar is constitutional based on *In re McGinley*,<sup>137</sup> a 1981 case that held without much analysis that the registration bar did not violate the First Amendment because “no conduct is proscribed, and no tangible form of expression is suppressed.” Courts have only recently analyzed the issue, and the Federal Circuit in *In re Tam* recently considered the constitutionality of the 2(a) bar for disparaging marks at length. The court held that the bar was subject to, and could not withstand, strict scrutiny. In light of this opinion, arguments for the constitutionality of

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133. U.S. PATENT & TRADEMARK OFFICE, TMEP § 1203.01 (Apr. 2016). However, the TMEP states: “Refusal to register immoral or scandalous matter has been found not to abridge First Amendment rights, because no conduct is proscribed and no tangible form of expression is suppressed. Also, the term ‘scandalous’ has been held sufficiently precise to satisfy due process requirements under the Fifth Amendment.” See *In re McGinley*, 660 F.2d 481, 484–85 (C.C.P.A. 1981).

134. TMEP § 1203.01 (citing *In re Boulevard Entm’t*, 334 F.3d 1336, 1341 (Fed. Cir. 2003) (holding 1-800-JACK-OFF and JACK OFF scandalous, “where all dictionary definitions of ‘jack-off’ were considered vulgar”)); *Bos. Red Sox Baseball Club Ltd. P’ship v. Sherman*, 88 U.S.P.Q.2d 1581 (T.T.A.B. 2008) (basing scandalousness of SEX ROD mark on dictionary definitions designating the term “ROD” as being vulgar, and applicant’s admission that SEX ROD had a sexual connotation); *In re Red Bull GmbH*, 78 U.S.P.Q.2d 1375, 1381–82 (T.T.A.B. 2006) (finding BULLSHIT scandalous because dictionary definitions indicate it is “obscene,” “vulgar,” “usually vulgar,” “vulgar slang,” or “rude slang,” which “constitutes a prima facie showing that the term” is “offensive to the conscience of a substantial composite of the general public”). See Carpenter & Garner, *supra* note 1, for a comprehensive discussion of the evidence used to reject marks for scandalousness.

135. See generally all sources cited, *supra* note 134.

136. Carpenter & Garner, *supra* note 1, at 336–37.

137. *In re McGinley*, 660 F.2d at 484.

the registration bar for scandalous marks may be unpersuasive.<sup>138</sup> For example, some argue that this provision of the Lanham Act regulates commercial speech, and is therefore not subject to strict scrutiny.<sup>139</sup> However, *In re Tam* found that with regard to disparaging marks, the mark's expressive nature subjects it to rejection.<sup>140</sup> This is also true for scandalous marks. A mark's scandalous nature is not part of its source-identifying function any more than a disparaging mark would be. Like disparaging marks, the expressive component is precisely the prohibition's target.<sup>141</sup>

The argument that the registration bar is constitutional because registration is government speech is similarly unpersuasive. The Federal Circuit affirmed that trademark registration is not government speech because it is merely a regulatory activity, like registration of copyright.<sup>142</sup> Finally, the constitutionality of 2(a) may not be salvaged on the basis that trademark owners can still use a mark. A trademark owner receives substantial benefits from trademark registration, and denial of those benefits creates a chilling effect on use of those types of marks.<sup>143</sup> Furthermore, there is uncertainty regarding the enforceability under section 43(a) of the Lanham Act of marks that have been refused registration based on policy reasons.<sup>144</sup> In addition, the Model State Trademark Act keeps 2(a) intact and prevents trademark owners from registering scandalous marks under state law.<sup>145</sup>

### III. CONTEXTUAL HEALING

As discussed above, removing the registration bar would be in line with the core function of trademark law, other forms of intellectual property, and fundamental constitutional principles. However, on a practical level, Congress and the courts may be unlikely to displace the Lanham Act's morality bar.

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138. See generally *In re Tam*, 808 F.3d 1321 (2016).

139. If trademark registration is commercial speech, the standard would be evaluated on a basis of intermediate scrutiny. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 571–72 (1980).

140. *In re Tam*, 808 F.3d at 1337–38.

141. See *id.* at 1338.

142. *Id.* at 1345–46 (holding that the ® does not convert trademark into government speech any more than a © converts a copyrighted work into government speech).

143. See *id.* at 1342.

144. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (“[I]t is common ground that § 43(a) protects qualifying unregistered trademarks and that the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a).”); see *Renna v. County of Union, N.J.*, 88 F. Supp. 3d 310 (D.N.J. 2014) (holding that a mark denied registration based on policy grounds is not enforceable under 43(a)).

145. MODEL STATE TRADEMARK BILL (Int'l Trademark Ass'n 1992); *In re Tam*, 808 F.3d at 1343–44.



A. THE MORALITY BAR WOULD BE MORE EFFECTIVELY APPLIED  
IF TRADEMARK EXAMINERS CONSIDERED CONTEXTUAL FACTORS  
IN THEIR ANALYSIS

We should interpret and apply existing law in an effective and fair way that is in harmony with the body of trademark law. However, as currently applied, the registration bar is ineffective and vague. Both trademark examiners and applicants need clearer guidance in this area.

One way to effectuate trademark policy is to ensure that trademark examiners consider context when evaluating marks that may be scandalous or immoral. When evaluating the eligibility of marks for registration generally, trademark law often considers subject marks in context. While scandalous marks are also in principle to be evaluated in the context of the marketplace, trademark examiners do not typically consider contextual factors. Considering contextual factors while determining scandalousness would lead to a more effective and fair result throughout the application process.

As previous research has acknowledged, application of this provision of the Lanham Act is inconsistent at best and nonsensical at worst.<sup>146</sup> Despite the fact that scandalousness is supposed to be determined according to the context of contemporary attitudes and the relevant marketplace for goods and services identified in the application,<sup>147</sup> context is not considered with regard to targeted consumers, goods and services, or the marketplace. Marks are often rejected on the basis of a dictionary definition without consideration of contextual factors. Despite the lack of meaningful analysis, marks containing the same terms on similar goods and services may end up both rejected and approved without additional explanation. Whether a mark is rejected or registered often depends on the particular trademark examiner, and responses to office actions are rarely if ever successful, because in the absence of relevant analysis, there is nothing to argue against.<sup>148</sup> Furthermore, the standards for scandalousness and immorality are unclear: To the extent that there are standards, they are often erroneously conflated with disparagement. Requiring consideration of context will also provide trademark applicants and examiners with clearer guidance throughout the registration process.

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146. Carpenter & Murphy, *supra* note 1; Carpenter & Garner, *supra* note 1.

147. *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994); *In re McGinley*, 660 F.2d 481, 484-85 (C.C.P.A. 1981).

148. See Carpenter & Garner, *supra* note 1.

I. *The Determination of Scandalousness Should Be Made in the Context of the Relevant Marketplace*

A mark must be evaluated in the context of contemporary attitudes, and the determination of whether a mark is scandalous should be made in the context of the relevant marketplace for the goods or services identified in the application.<sup>149</sup> This is ascertained from the standpoint of not necessarily a majority, but a substantial composite of the general public.<sup>150</sup> To support a refusal on these grounds, an examiner must provide evidence that a substantial portion of the general public would consider the mark scandalous in the context of contemporary attitudes *and the relevant marketplace*.<sup>151</sup> Thus, a determination that a mark is scandalous because it is used in a scandalous marketplace is a misapplication of the law. Rejecting a mark on the basis that mark's use on sexually explicit goods reinforces the vulgarity of its intended meaning is not just circular reasoning, but is incorrect. It creates a situation where a mark on a good sold in a specific marketplace cannot be registered, even though the good may not be considered scandalous in the context of that specific marketplace. Further, even though that marketplace may not be frequented by or accessible to the general public, the mark still may not be registered if the general public could find the term abstractly vulgar. The proper inquiry, however, is not an abstract one—it is whether a substantial composite of the general public would find the mark scandalous for the particular marketplace. Yet, context of any sort was considered in fewer than half of refusals based on scandalousness or immorality.<sup>152</sup>

At the same time, “scandalous” has been held to encompass matter that is merely “vulgar.”<sup>153</sup> Evidence of the opinions of a substantial composite of the general public can include magazine articles, newspaper articles, and dictionary definitions.<sup>154</sup> Accordingly, the Federal Circuit has held that dictionary definitions alone can be sufficient to establish scandalousness where multiple dictionaries indicate a word is vulgar and the applicant's mark indicates the vulgar meaning of the word.<sup>155</sup> What this means in practical terms is that, in the majority of rejections, a

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149. *In re Mavety Media Grp. Ltd.*, 33 F.3d at 1371. *In re McGinley*, 660 F.2d at 485; *In re Wilcher Corp.*, 40 U.S.P.Q.2d 1929 (T.T.A.B. 1996); *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d 1635, 1639 (T.T.A.B. 1988); U.S. PATENT & TRADEMARK OFFICE, TMEP § 1203.01 (Apr. 2016).

150. *In re Mavety Media Grp. Ltd.*, 33 F.3d at 1369.

151. *In re Mavety Media Grp.*, 33 F.3d at 1371–72.

152. See *Carpenter & Garner*, *supra* note 1, at 334–35.

153. Vulgar has been defined as “lacking in taste, indelicate, morally crude.” U.S. PATENT & TRADEMARK OFFICE, TMEP § 1203.01 (citing *In re Runsdorf*, 171 U.S.P.Q. 443, 444 (T.T.A.B. 1971)).

154. TMEP § 1203.01.

155. The applicant's use must be limited to the vulgar meaning of the word. *In re Boulevard Entm't, Inc.*, 334 F.3d 1336 (Fed. Cir. 2003) (finding the marks 1-800-JACK-OFF and JACK OFF were scandalous where multiple dictionary definitions indicated the term “jack off” was vulgar).

dictionary definition indicating a word is offensive or vulgar is the only evidence used to reject the mark.

The lack of clear standards causes problems for USPTO examiners who are under pressure to process applications quickly and efficiently. When considering whether a particular mark is scandalous, an examining attorney can either ascertain the meaning of a mark in the context of the current attitudes of the day or perform a quick dictionary search and reject an application if the particular term is “vulgar.” According to the USPTO Performance Appraisal Plan, a trademark examiner must meet quarterly quotas. To be considered “fully successful,” examiners must complete 425 to 549 balanced disposals<sup>156</sup> of applications per quarter.<sup>157</sup> To be “outstanding,” an examiner should have completed at least 515 to 575 balanced disposals.<sup>158</sup> If trademark examiners average 500 working hours per quarter, an “outstanding” trademark examiner must process more than one application per hour. Unsurprisingly, the examiners in the majority of applications refused on the basis of scandalousness fail to consider the context of the marketplace or the goods and services listed in the application.

2. *Trademark Examiners Typically Do Not Consider Contextual Factors in a Refusal Based on Scandalousness, Regardless of the Marketplace or Goods at Issue*

Trademark examiners are highly unlikely to consider contextual factors in a refusal based on the scandalous or immoral nature of a mark. Refusals frequently mention the relevance of context de jure but disregard it de facto.<sup>159</sup> The vast majority of applications that are rejected

156. A Balanced Disposal means that either a first Office Action has issued, the application has been approved for publication after examination, or the application has been abandoned. *See, e.g.*, U.S. PATENT & TRADEMARK OFFICE, TRADEMARK PUBLIC ADVISORY COMMITTEE ANNUAL REPORT 5 (2014), [https://www.uspto.gov/about/advisory/tpac/TPAC\\_Annual\\_Report\\_2014.pdf](https://www.uspto.gov/about/advisory/tpac/TPAC_Annual_Report_2014.pdf).

157. *Performance Plan, Progress Review and Appraisal Record (GS-9, GS-11, and GS-12)*, NAT'L TREASURY EMPs. UNION, <http://www.nteu245.org/memos-docs/PAPs/GS-9-11-12PAP.PDF> (last visited Nov. 7, 2016) [hereinafter *Performance Plan (GS-9, GS-11, and GS-12)*]; *Performance Plan, Progress Review and Appraisal Record (GS-13 and GS-14)*, NAT'L TREASURY EMPs. UNION, <http://www.nteu245.org/memos-docs/PAPs/PAP13-14.pdf> (last visited Nov. 7, 2016) [hereinafter *Performance Plan (GS-13 and GS-14)*]; *see also* Memorandum of Understanding Between the Nat'l Treasury Emps. Union Chapter 245 & the U.S. Patent & Trademark Office Regarding Implementation of a Pilot Award for Comprehensive Excellence (ACE Award) (Mar. 18, 2010), <http://lo101.com/ACEMOU.pdf>.

158. *Performance Plan (GS-9, GS-11, and GS-12)*, *supra* note 157; *Performance Plan (GS-13 and GS-14)*, *supra* note 157.

159. For various example, see Carpenter & Garner, *supra* note 1, at 344–45.

This frequently occurred with regard to [refusals based on words typically considered] profan[e].

In a significant number of rejections, examiners (1) cited the rule that trademarks must be evaluated in the context of current attitudes; (2) noted that profanity was more common in current society; and then (3) concluded that acceptance of profanity makes words no less profane.

The examiner then rejected the marks without any additional supporting evidence.

*Id.* at 344.

on the basis of scandalousness are rejected because they are listed as “vulgar” in the dictionary.<sup>160</sup> My previous research indicated that dictionary definitions were used as a primary source of support for a rejection based on scandalousness ninety-one percent of the time.<sup>161</sup> Seventy percent of rejections exclusively used the dictionary for support.<sup>162</sup>

The use of dictionary definitions as exclusive or primary evidence for a refusal based on scandalousness is consistent across various marketplaces, including niche markets such as adult entertainment.<sup>163</sup> For adult-oriented markets, dictionary definitions served as the only basis for rejection in the majority of refusals.<sup>164</sup> When examiners did consider contextual information in these niche markets, they only did so as an argument against registration. That is, use of a mark in an adult-oriented marketplace was used as further evidence of the mark’s scandalous nature.<sup>165</sup> For example, an examiner rejected the mark POST-TITS because the general public would find it scandalous, despite the trademark owner’s assertion that the relevant market was controlled and narrow.<sup>166</sup> This is often the case when the application contains a reference to adult material.<sup>167</sup> Most

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160. *Id.* at 336–37.

161. *Id.* at 337.

162. *Id.*

163. *Id.* at 338. In marks targeting an adult marketplace, only five Office Actions referenced context of the marketplace at all. *Id.* at 338 n.75.

164. *Id.* at 338.

165. *See, e.g.*, U.S. Trademark Application Serial No. 76/484,466 (filed Jan. 22, 2003) (TOKYO CREAMPIE) (Third Office Action dated Aug. 15, 2003); U.S. Trademark Application Serial No. 78/788,383 (filed Jan. 10, 2006) (GAYFACIALSXXX) (Office Action dated July 15, 2006).

166. U.S. Trademark Application Serial No. 76/536,775 (filed July 22, 2003) (Office Action dated May 20, 2004).

167. *See* Carpenter & Garner, *supra* note 1, at 339 (citing *e.g.*, U.S. Trademark Application Serial No. 78/853,993 (filed Apr. 4, 2006) (TITTY CITY) (claiming services in class 41 for “entertainment”); U.S. Trademark Application Serial No. 85/253,332 (filed Feb. 28, 2011) (FAT COCK BEER); U.S. Trademark Application Serial No. 76/484,466 (filed Jan. 22, 2003) (TOKYO CREAMPIE); U.S. Trademark Application Serial No. 76/490,572 (filed Feb. 19, 2003) (JAPANESE CREAMPIE); U.S. Trademark Application Serial No. 76/639,548 (filed May 25, 2005) (NIGGA); U.S. Trademark Application Serial No. 77/281,745 (filed Sept. 18, 2007) (THIZZ JUICE); U.S. Trademark Application Serial No. 76/675,279 (filed Apr. 10, 2007) (TITTIGYM); U.S. Trademark Application Serial No. 77/600,723 (filed Oct. 26, 2008) (COCAINE ENERGY); U.S. Trademark Application Serial No. 85/264,154 (filed Mar. 11, 2011) (SOCK MY COCK); U.S. Trademark Application Serial No. 78/829,207 (filed Mar. 3, 2006) (COCAINE); U.S. Trademark Application Serial No. 77/118,639 (filed Feb. 28, 2007) (COCAINE CUT THE LEGAL ALTERNATIVE); U.S. Trademark Application Serial No. 77/119,448 (filed Mar. 1, 2007) (COCAINE FREE THE LEGAL ALTERNATIVE); U.S. Trademark Application Serial No. 78/750,399 (filed Nov. 9, 2005) (METH); U.S. Trademark Application Serial No. 76/536,775 (filed July 22, 2003) (POST-TITS); U.S. Trademark Application Serial No. 78/558,043 (filed Feb. 1, 2005) (HEEB); U.S. Trademark Application Serial No. 78/904,458 (filed June 9, 2006) (BONER BATS ROCK HARD WOOD); U.S. Trademark Application Serial No. 78/682,282 (filed July 31, 2005) (YOU CUM LIKE A GIRL); U.S. Trademark Application Serial No. 78/631,791 (filed May 17, 2005) (MY SHIT D\*N\*T STINK); U.S. Trademark Application Serial No. 77/600,222 (filed Oct. 24, 2008) (SHAKE THOSE TITTIES); U.S. Trademark Application Serial No. 78/078,534 (filed Aug. 9, 2001) (SHITBEGONE); U.S. Trademark Application Serial No. 78/716,443 (filed Sept. 20, 2005) (TALKING COCK)).

often trademark examiners consider whether a substantial composite of the general public would find the mark scandalous without considering the market at issue.<sup>168</sup> Google searches are common contextual evidence used to demonstrate a mark is scandalous.<sup>169</sup>

Examiners are also unlikely to consider the context of goods and services in rejections of scandalous marks. Like the above findings regarding the marketplace, examiners are unlikely to consider the context of goods and services identified in the application. Use of a mark on adult-oriented goods is often used as evidence of the fact that a mark is scandalous.<sup>170</sup> Use of a mark that may be vulgar on goods sold to the general public is also used as evidence that a mark is scandalous.<sup>171</sup>

A lack of clarity in the guidelines for refusals based on scandalousness sometimes leads to bizarre results. In at least one instance, an examiner refused registration of a mark in part because scandalous information would be found while searching for the stated vulgar terms, rather than because the mark would be found while searching for more innocent things.<sup>172</sup> That examiner also mentioned that the relevant audience is irrelevant to an analysis of whether a mark is scandalous or immoral because that would help people attempting to register such marks.<sup>173</sup> The examiner reasoned that if the appropriate test were the “relevant population,” no mark would ever be refused on 2(a) grounds “since the applicant would not adopt a mark which would drive the relevant

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168. *Id.* at 340–41.

169. For example, an examiner rejected the mark FAT COCK BEER in part based on the results of a Google search indicating that “fat cock” is vulgar slang, concluding the mark was therefore scandalous to the general public. U.S. Trademark Application Serial No. 85/253,332 (filed Feb. 28, 2011). TITTY PRETTIES was similarly rejected in part because of a Google search showing that the word “titty” can be used in an “offensive and disgraceful manner.” U.S. Trademark Application Serial No. 78/524,781 (filed Nov. 30, 2004) (Office Action dated July 11, 2005).

170. For a list of examples, see Carpenter & Garner, *supra* note 1, at 342–43.

171. U.S. Trademark Application Serial No. 78/879,965 (filed May 9, 2006) (rejecting TIT-MITT on the basis that its use on bras would ensure people would know that “tit” was used to reference a breast); U.S. Trademark Application Serial No. 78/631,791 (filed May 17, 2005) (rejecting MY SHIT D\*N\*T STINK because “shit” rendered the mark scandalous even if the term is relevant and not being used in the vulgar sense); *see also* U.S. Trademark Application Serial No. 77/883,100 (filed Dec. 1, 2009) (TOUCH YOUR TITS for shirts); U.S. Trademark Application Serial No. 76/675,279 (filed Apr. 10, 2007) (TITTIGYM for an adult health and fitness club); U.S. Trademark Application Serial No. 77/866,123 (filed Nov. 5, 2009) (DOUCHEBAG AWARD) (stating that because the mark is clearly not referencing the personal hygiene meaning of the word, use of the mark supports the vulgar meaning).

172. Office Action, U.S. Trademark Application Serial No. 78/643,827 (Office Action Aug. 24, 2006) (FUCK.XXX). The examiner used the fact that he found other scandalous websites while searching for the mark as support for the proposition that anyone may come across these goods and services: “The examining attorney himself, in searching for the term FUCKXXX readily encountered a number of sites where, even if not directly entered, clearly displayed a scandalous connotation of the term in relation to sexual activity.” *Id.* The examining attorney did not address the consideration that he encountered those websites while specifically searching for the term “fuck.xxx.”

173. U.S. Trademark Application Serial No. 78/643,827 (filed June 5, 2005) (FUCK.XXX).

purchasers or audience away from using or purchasing the applicant's identified goods or services."<sup>174</sup>

Compounding the confusion is a lower burden of proof for "egregious" marks, which is an undefined and inconsistently applied standard. Under *In re Wilcher Corp.*, the amount of proof required to support a refusal based on scandalousness depends upon the nature of the mark, with less evidence required for more egregious marks.<sup>175</sup> This standard is applied inconsistently when it is applied at all, and often no information is given to permit either the current applicant or any further applicants to determine what constitutes "egregious."<sup>176</sup> Examining attorneys frequently provide no explanation as to why a particular mark is considered "egregious."<sup>177</sup> The word "fuck" appears most likely to be found "egregious," but is also equally likely not to be held egregious.<sup>178</sup> Even when a reason is provided, there does not appear to be consistency in the reasoning. For example, in two marks involving the term "donkey punch," egregiousness was based on the implication of a violent sex act. Additionally, egregiousness was found in the mark THE COCK MEAT

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174. *Id.* The examiner stated that websites are ubiquitous and can be accessed by anyone noting that the attorney found several other scandalous sites while searching for the term "fuckxxx." *Id.* The examiner uses this to support the proposition that anyone may come across these goods and services, but does not seem to take into consideration that s/he was specifically searching for the term "fuckxxx" on the internet. Office Action, U.S. Trademark Application Serial No. 78/643,827 (Office Action Aug. 24, 2006).

175. *In re Wilcher Corp.*, 40 U.S.P.Q.2d 1929, 1996 WL 725479 (T.T.A.B. 1996). The Board stated that "inclusion in a mark of a readily recognizable representation of genitalia certainly pushes the mark a substantial distance along the continuum [sic] from marks which are relatively innocuous to those which are most egregious." *Id.* at \*6.

176. U.S. Trademark Application Serial No. 78/864,664 (filed Apr. 19, 2006) (MR. HORSE COCK); U.S. Trademark Application Serial No. 77/605,025 (filed Oct. 31, 2008) (IMMANASSHOLE); U.S. Trademark Application Serial No. 77/079,909 (filed Jan. 10, 2008) (FUCKTUBE); (FUCK CANCER); U.S. Trademark Application Serial No. 78/703,973 (filed Aug. 31, 2005) (FUCK EVERYBODY); U.S. Trademark Application Serial No. 78/955,927 (filed Aug. 19, 2006) (FUCK OFF); U.S. Trademark Application Serial No. 78/965,104 (filed Aug. 31, 2006) (A NIGGER FOR LIFE); U.S. Trademark Application Serial No. 78/666,012 (filed Jul. 7, 2005) (SCHLONG WEAR); U.S. Trademark Application Serial No. 77/485,121 (filed May 28, 2008) (ASSHOLE); U.S. Trademark Application Serial No. 78/643,827 (filed Jun. 5, 2005) (FUCK.XXX); U.S. Trademark Application Serial No. 78/631,791 (filed May 17, 2005) (MY SH!T D\*N\*T STINK); U.S. Trademark Application Serial No. 78/866,347 (filed Apr. 20, 2006) (FUGLY).

177. See all examples cited, *supra* note 176.

178. U.S. Trademark Application Serial No. 77/618,080 (filed Nov. 19, 2008) (FUCKSTRONG) (fuck is a highly offensive, vulgar slang word); U.S. Trademark Application Serial No. 77/928,592 (filed Feb. 4, 2010) (DRUNK DUMB FUCKS) (fucks and fuck are obscene and therefore egregiously scandalous). But, see the following trademark application records that do not contain a rejection including egregiousness: U.S. Trademark Application Serial No. 86/744,789 (filed Sept. 2, 2015) (FUCK YOU PAY ME); U.S. Trademark Application Serial No. 86/958,035 (filed Mar. 3, 2016) (FUCK YEAH) (action suspended pending Supreme Court review of *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015)).

SANDWICH SHOP, because there was no other meaning for the phrase at issue.<sup>179</sup>

Initial refusals evaluating a mark out of context have serious implications for the ultimate dispensation of the application. Applicants are unlikely to respond to a refusal based on scandalousness.<sup>180</sup> Research has indicated that of those applicants who did file an Office Action response, contextual factors were the most common argument used in support of registration.<sup>181</sup> In fact, context was argued in sixty-four percent of all responses in a dataset created for one of my previous works.<sup>182</sup> These arguments, however, are unlikely to succeed: out of 232 records reviewed, only two such arguments were ultimately successful.<sup>183</sup> Further, examiners were no more likely to address contextual factors in subsequent Office Actions even when an applicant had filed a response containing an argument based on context.<sup>184</sup>

#### IV. RELEVANCE OF CONTEXT IN TRADEMARK REGISTRATION

Trademarks are nothing without context. Context is a central aspect of trademark law, and is critical in defining the very existence of trademark rights and their scope. As previously discussed, trademark rights are not rights in gross, but rights appurtenant to a particular business. They only exist in so far as they identify the source of particular goods and services. Marketplace context is a significant consideration at each stage of the trademark lifecycle, including acquisition, scope, maintenance, and termination of rights.

The very scope of trademark rights depends on contextual factors such as the appearance of the mark, the goods or services involved, the relevant marketplace, and the channels of trade. In stark contrast to the

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179. U.S. Trademark Application Serial No. 86/936,441 (filed Mar. 10, 2016) (DONKEY PUNCH) (refers to a sexual practice that involves violent physical abuse); U.S. Trademark Application Serial No. 78/856,809 (filed Apr. 20, 2016) (doNKEy punCH) (term is considered to be associated with violence and violent sex); U.S. Trademark Application Serial No. 85/038,983 (filed May 14, 2010) (THE COCK MEAT SANDWICH SHOP) (there are no other meanings for the phrase at issue).

180. Carpenter & Garner, *supra* note 1, at 346–47 (finding that more than three-quarters of applicants whose marks were refused for scandalousness failed to respond to the Office Action).

181. *Id.* at 348.

182. *Id.*

183. *Id.* at 350 n.127 (“Because of the vague standard and the little evidence required to sustain a rejection for scandalousness (dictionary definitions), it is very difficult for applicants to overcome a rejection on this basis in the registration process. The only marks that have overcome a rejection based on scandalousness are WHITE ASS, and FUGLY FRUITS. U.S. Trademark Application Serial No. 85/100,568 (filed Aug. 5, 2010) (WHITE ASS); U.S. Trademark Application Serial No. 78/736,643 (filed Oct. 19, 2005) (FUGLY FRUITS). PHAG was initially rejected and abandoned, but when revived went through with no apparent rejection. U.S. Trademark Registration No. 4,135,694. The applications for WHITE ASS and FUGLY FRUITS were later abandoned for other reasons.”).

184. *Id.* at 355. While sixty-four percent of Office Action responses argued contextual factors, when the examiner had not discussed context in the initial Office Action, subsequent Office Actions were only fifty percent likely to address the contextual argument. *Id.*

application of the registration bar for scandalous marks, contextual factors are regularly considered throughout the trademark registration process with respect to other bases for rejection, including likelihood of confusion, descriptiveness, functionality, and distinctiveness. The application of contextual factors to other registration bars provides a template for doing so with regard to scandalous marks. The discussion in the following Subparts highlights the ways in which examiners apply contextual factors throughout the registration process, in particular with regard to the section 2(d) bar for likelihood of confusion.

A. THE SECTION 2(D) BAR FOR LIKELIHOOD OF CONFUSION CENTERS ON AN ANALYSIS OF CONTEXTUAL FACTORS

The proper focus of a likelihood of confusion analysis is the overall impression of a mark as it is likely to be perceived by prospective purchasers.<sup>185</sup> Core to the likelihood of confusion analysis is the mantra that a mark must be examined in the context in which it appears in the marketplace to the ordinary consumer.<sup>186</sup> In fact, the substantive *DuPont* factors cited as most relevant in an ex parte examination evaluate a mark in light of the overall market context. Those factors include: (1) “appearance, sound connotation, and commercial impression” of the marks; (2) goods or services at issue; (3) “established, likely-to-continue trade channels;” (4) “conditions under which and buyers to whom sales are made;” and (5) other uses of similar marks in the marketplace.<sup>187</sup>

I. *Examiners Routinely Consider the Appearance of Marks in the Context of Information Contained in the Application*

In contrast to refusals based on scandalousness, refusals based on likelihood of confusion typically evaluate the mark in context. Because the likelihood of confusion analysis looks to the actual use of marks, a comparison of the texts of two marks alone is insufficient if the marks

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185. *Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 902 (C.C.P.A. 1973) (holding that SPRAY ‘N’ GLOW mark on hair conditioner and hair brightener spray were sufficiently similar to mark SPRAY ‘N’ STAY for hair spray, so as to create likelihood of confusion). For an analysis of this principle in the infringement context, see *Sun-Fun Prods., Inc. v. Suntan Research & Dev., Inc.*, 656 F.2d 186, 192 (5th Cir. 1981); *Dreyfus Fund Inc. v. Royal Bank of Canada*, 525 F. Supp. 1108, 1112 (S.D.N.Y. 1981).

186. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21(a)(i) (AM. LAW. INST. 1995).

187. U.S. PATENT & TRADEMARK OFFICE, § 1207.01 (Apr. 2016). The other factor is “a valid consent agreement between the applicant and the owner of the previously registered mark.” (citations omitted). *Id. In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 U.S.P.Q.2d 1201, 1204 (Fed. Cir. 2003) (“Not all of the *DuPont* factors may be relevant or of equal weight in a given case, and ‘any one of the factors may control a particular case.’ *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406–07, 41 U.S.P.Q.2d 1531, 1533 (Fed. Cir. 1997).”).



have different appearances in the marketplace.<sup>188</sup> In an infringement context, the comparison of marks seeks to replicate the appearance of the mark under the market conditions in which the marks are encountered by prospective purchasers.<sup>189</sup> In the registration context, the comparison of marks seeks to do the same to the extent possible based on the information contained in—and inferred from—the application.<sup>190</sup> For example, the mark SPRAY ‘N STAY was found to sufficiently resemble SPRAY ‘N’ GLOW for hair care products, despite the different meanings of the words “stay” and “glow,” because the connotation to the average purchaser of the goods could lead them to believe that they come from the same source.<sup>191</sup> Conversely, the marks DIGIRAD and DIGIRAY were found to have different connotations so as not to create a likelihood of confusion because the particular purchasers of the products could easily distinguish based on the connotations of -RAY and -RAD in connection with the respective parties’ goods.<sup>192</sup> Considering what the overall commercial impression of

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188. *See* Luigino’s, Inc. v. Stouffer Corp., 170 F.3d 827, 830 (8th Cir.1999); Elvis Presley Enters., Inc. v. Capece, 141 F.3d 188, 198 (5th Cir.1998); Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co., 799 F.2d 867, 872 (2d Cir.1986).

189. *See, e.g.*, Wynn Oil Co. v. Thomas, 839 F.2d 1183, 1187 (6th Cir. 1988); Calvin Klein Cosmetics Corp. v. Lenox Labs., Inc., 815 F.2d 500, 504 (8th Cir. 1987). A side-by-side comparison is warranted if the products are viewed together in the marketplace. *See* Lever Bros. Co. v. Winzer Co., 326 F.2d 819 (C.C.P.A. 1964). However, a comparison is improper in the “isolated circumstances” of the marketplace. *See* Am. Auto. Ass’n v. AAA Ins. Agency, 618 F. Supp. 787, 792 (W.D. Tex. 1985). *See, e.g.*, Levi Strauss & Co. v. Blue Bell, Inc., 632 F.2d 817, 819 (9th Cir. 1980); James Burrough Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266 (7th Cir. 1976), *appeal after remand*, 572 F.2d 574 (7th Cir. 1978).

190. *See, e.g.*, Paula Payne Prods. Co. v. Johnson Publ’g Co., 473 F.2d 901 (C.C.P.A. 1973); *In re* Max Capital Grp. Ltd., 93 U.S.P.Q.2d 1243 (T.T.A.B. 2010); *In re* Cynosure, Inc., 90 U.S.P.Q.2d 1644 (T.T.A.B. 2009) (citing *Sealed Air Corp. v. Scott Paper Co.*, 190 U.S.P.Q. 106, 108 (T.T.A.B. 1975)).

191. *Paula Payne Prods. Co.*, 473 F.2d at 901.

192. *In re* Digirad Corp., 45 U.S.P.Q.2d 1844, 5 (T.T.A.B. 1998). A comparison based on a dissection of the designations is normally improper in a likelihood of confusion analysis. *Chevron Chem. Co. v. Voluntary Purchasing Grps, Inc.*, 659 F.2d 695, 704 (5th Cir. 1981), *cert. denied*, 457 U.S. 1126 (1982). The dominant elements of a mark may strongly impact the general commercial impression. *See, e.g.*, *Burger Chef Sys., Inc. v. Sandwich Chef, Inc.*, 608 F.2d 875 (C.C.P.A. 1979); *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 1462 (Fed. Cir. 1991) (noting that a common characteristic of a family of marks used by the plaintiff may itself become associated with the trademark owner). The court specifically found that McPRETZEL created a likelihood of confusion with the McDonald’s family of trademarks. *Id.* at 1464. Particularly, when the distinctiveness of the other’s designation is weak, the addition of the defendant’s house mark may avoid confusion. *See* *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1045–46 (2d Cir. 1992); *Gen. Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 626 (8th Cir. 1987). However, in some circumstances the use of a house mark may not alleviate the likelihood of confusion. *See, e.g.*, *Banff, Ltd. v. Federated Dep’t Stores, Inc.*, 638 F. Supp. 652, 656 (S.D.N.Y. 1986), *aff’d*, 841 F.2d 486 (2d Cir. 1988) (noting that Defendant’s “name is listed in such small print as to lead to the conclusion that it is not the company name which [the company] is relying to sell these goods but rather the mark which is so similar to that previously used by the plaintiff. Moreover, the use of a defendant’s own name in conjunction with an otherwise similar mark does not generally excuse the infringement since it may instead simply increase the misappropriation by linking the defendant’s own name to the plaintiff’s good will established by its

a mark is in the eyes of targeted consumers is key to a likelihood of confusion analysis. In finding a likelihood of confusion between CITY GIRL and CITY WOMAN, the Board emphasized that purchasers of CITY GIRL goods would likely assume that CITY WOMAN was a new line of products from the same source, or was connected with CITY GIRL in some way.<sup>193</sup> Even with regard to sound, there is some concern for methods of pronunciation of the public exposed to particular marks.<sup>194</sup> Marketplace context is a key focus for the first factor in a 2(d) rejection.

## 2. *Examiners Routinely Consider the Goods and Services Identified in the Application*

As previously discussed, refusals to register a mark based on scandalousness often fail to consider relevant information related to the goods or services in question. However, as a trademark is only a right appurtenant to a particular business, the goods or services at issue are an important consideration when evaluating the registrability of a trademark. This consideration can weigh heavily in a likelihood of confusion analysis. Indeed, the scope of necessary relatedness of goods or services varies contextually according to the similarity of the marks. The more similar the marks, the less similar the goods or services need to be in order to create a likelihood of confusion in the marketplace.<sup>195</sup>

In a section 2(d) analysis, examining attorneys consider the relatedness of the goods based on their identification in the application.<sup>196</sup> The operative question is whether consumers would relate the goods of the relevant marks, which can occur even where goods are not used together or related in kind.<sup>197</sup> In *In re Davey*, the Trademark Trial and Appeal Board (“TTAB”) determined that the goods need only be

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trademark.”) *Id.* (internal citations omitted); *see also* *W. E. Bassett Co. v. Revlon, Inc.*, 435 F.2d 656, 662 (2d Cir. 1970); *Miles Shoes, Inc. v. R. H. Macy & Co.*, 199 F.2d 602, 603 (2d Cir. 1952).

193. *In re M. Serman & Co.*, 223 U.S.P.Q. (BNA) ¶ 52 (T.T.A.B. 1984).

194. *See* *Kabushiki Kaisha Hattori Tokeiten v. Scuto*, 228 U.S.P.Q. 461, 462 (T.T.A.B. 1985) (noting that similarity of sound can be challenging because there is no per se correct method for determining how the relevant public will pronounce the mark). Here, the Board refused to register the mark, holding that “the word portion of applicant’s mark ‘SEYCOS’, [sic] is virtually the phonetic equivalent of opposer’s ‘SEIKO’ mark and is, in fact, the phonetic equivalent of the plural of opposer’s mark.” *Id.*

195. *Gen. Mills, Inc. v. Fage Dairy Processing Indus. S.A.*, 100 U.S.P.Q.2d 1584, 1597 (T.T.A.B. 2011); *In re Iolo Techs., LLC*, 95 U.S.P.Q.2d 1498, 1499 (T.T.A.B. 2010); *In re Davey Prods. Pty Ltd.*, 92 U.S.P.Q.2d 1198 (T.T.A.B. 2009).

196. *In re Toshiba Med. Sys. Corp.*, No. 79046106, 2009 WL 1896059, at \*5 (T.T.A.B. June 18, 2009).

197. *Id.* (considering that the market factor in this analysis was whether the same facilities could purchase the equipment to be used in the diagnosis of the same patients). “[G]oods that are neither used together nor related to one another in kind may still ‘be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.’” *Id.*

sufficiently related so that consumers would be likely to assume, upon encountering the goods under similar marks, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source. In cases where the applicant's mark is identical to the registered mark cited, the degree of relatedness between the respective goods that is necessary to support a finding that the goods are related is less than it would be if the marks were not identical—there need be only a viable relationship between the respective goods.<sup>198</sup> If goods or services are related in some manner in the minds of the consumers, marks that are similar may give rise to a likelihood of confusion.<sup>199</sup> For example, the TTAB affirmed the rejection of a travel agency's application for VOGUE based on the likelihood of confusion with VOGUE magazine.<sup>200</sup> VOGUE magazine successfully asserted that the travel agency's goods were related in such a way as to create confusion in the marketplace, because most of its readers are highly interested in travel, and the magazine had been running travel articles for seventy years.<sup>201</sup>

### 3. *Examiners Routinely Consider Channels of Trade*

Also, unlike the analysis involved in assessing potentially scandalous marks, a likelihood of confusion analysis looks at the marketing methods and channels of distribution used. The significance of trade channels is based upon where they lead to and whether at the end certain classes of persons are exposed to the marks in issue under circumstances likely to

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198. *In re Davey Prods. Pty Ltd.*, 92 U.S.P.Q.2d at 4 (finding by the examining attorney that “it is not necessary that the respective goods be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. . . . the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods.” (citing *In re Rexel Inc.*, 223 U.S.P.Q. 830 (T.T.A.B. 1984))).

199. *Weider Publ'ns, LLC v. D & D Beauty Care Co.*, No. 99199352, 2014 WL 343269, at \*10 (T.T.A.B. Jan. 21, 2014) (finding that an applicant's attempt to register SHAPE for not only cosmetics, but also health spa services and wellness, would likely cause confusion with the magazine SHAPE where those types of services were featured and advertised). “It is sufficient that the respective goods and/or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source.” *Id.* *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 91197659, 2013 WL 5407313, at \*8 (T.T.A.B. June 26, 2013) (finding that GOTT LIGHT for various non-alcoholic drinks was likely to be confused by consumers with the wine marks: GOTT and JOEL GOTT). The Board stated that “[t]he goods need only be sufficiently related that consumers would be likely to assume, upon encountering the goods under similar marks, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source.” *Id.*

200. *See Conde Nast Publ'ns Inc. v. Vogue Travel Inc.*, 205 U.S.P.Q. (BNA) 579, 1979 WL 24922 (T.T.A.B. 1979).

201. *Id.* at \*2 (providing an account of how many articles related to travel were published each year and what kind of travel-related phrases—such as VOGUE to Go, PASSIONATE TRAVELER, Travel Egypt, or Vogue's Travelog—were used).

result in confusion.<sup>202</sup> This factor is significant in illuminating what actually happens in the marketplace and, where other factors are not particularly probative, channels of distribution become of special importance.<sup>203</sup>

Even when the marks are used in the same venues, a proper likelihood of confusion analysis will consider goods sold in different departments and targeted at different purchasers.<sup>204</sup> A likelihood of confusion analysis can narrow the focus of the marketplace to particular areas where the goods are sold, or where two marks may overlap. For example, an exclusive distributorship—which in turn sells to the public exclusively through boutique or specialty stores—can overlap with a mass marketed product sold through specialty shops, discount stores, drug stores, and other retail outlets.<sup>205</sup> When sold in the same stores, competing products with similar trade dress may easily be confused if proximately located or actually intermixed. The consumer may not even realize the opportunity for comparison and differentiation.<sup>206</sup> On the other hand, it has become a common practice for retailers to shelve

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202. See, e.g., *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 U.S.P.Q. 58, 61 (T.T.A.B. 1984); *TCPIP Holding Co. v. Haar Comme'n's, Inc.*, 244 F.3d 88, 91 (2d Cir. 2001) (targeting similar buyers); *Motion Picture Ass'n of Am. Inc. v. Respect Sportswear, Inc.*, 83 U.S.P.Q.2d 1555, 1562 (T.T.A.B. 2007) (“[E]ncountered by the same persons . . .”).

203. *Homeowners Grp., Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1110 (6th Cir. 1991) (“This factor . . . consists of considerations of how and to whom the respective goods or services of the parties are sold.”). For example, if similar marks are used on goods sold through the same marketing channels, the probability of confusion may be higher than if the goods are marketed through separate channels. See *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460 (3d Cir. 1983) (noting that similar sales contexts can enhance the likelihood of confusion); see, e.g., *Bos. Athletic Ass'n v. Sullivan*, 867 F.2d 22, 28 (1st Cir. 1989) (noting that identical nature of sales outlets and advertising methods supported a finding of infringement). Thus, dissimilarities between the retail outlets for, and the predominant customers of, plaintiff's and defendant's goods lessen the possibility of confusion, mistake, or deception. *Ross Bicycles, Inc. v. East Coast Cycles, Inc.*, 224 U.S.P.Q. 725, 728 (N.D. Fla. 1984), *aff'd*, 765 F.2d 1502, 1507 (11th Cir. 1985), *cert. denied*, 475 U.S. 1013 (1986). Accordingly, similar marks used on goods sold through single-brand distributors may be less confusing than when used on goods sold through multi-brand stores, and goods sold only at discount outlets might not be confused with goods sold only in specialty shops.

204. *Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960, 966–67 (2d Cir. 1981). There is no rule that separation avoids confusion. Rather, the degree of physical proximity between two products in different sections of the same stores is relevant only to the extent it involves the consumer's reliance on memory or affects the consumer's perceptions of the relatedness of the products. *Plus Prods. v. Plus Disc. Foods, Inc.*, 722 F.2d 999, 1007–08 (2d Cir. 1983). *Helene Curtis Indus., Inc. v. Suave Shoe Corp.*, 13 U.S.P.Q.2d 1618, 1624 n.30 (T.T.A.B. 1989) (“The crucial question here is whether source confusion is likely. As to that, whether or not the goods are displayed close together or far apart in the same store is immaterial.”).

205. *Pignons S. A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 488 (1st Cir. 1981).

206. *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 937 (7th Cir. 1989); *Storck USA, L.P. v. Farley Candy Co.*, 785 F. Supp. 730, 734–35 (N.D. Ill. 1992); *P.T.C. Brands, Inc. v. Conwood Co., L.P.*, 28 U.S.P.Q.2d 1895, 1904 (W.D. Ky. 1993); see *Ty, Inc. v. Jones Grp.*, 237 F.3d 891, 900–01 (7th Cir. 2001).

national brand products side-by-side with private brands having similar packaging features.<sup>207</sup>

The analysis looks at trade channels specifically enough that a likelihood of confusion may be found even on non-competing goods. Targeting of a relatively narrow universe of potential purchasers through a specific trade channel may lead to confusion even if the goods do not compete.<sup>208</sup> Conversely, likelihood of confusion has been avoided where the senior and junior marks appear on products sold in professional, wholesale, or industrial channels as opposed to ordinary consumer retail channels.<sup>209</sup> The channels may be such that the only persons in a position to confuse the marks would be those familiar with one mark in their trade or industry that happen to encounter the other mark in their business or perhaps when doing their personal retail shopping. Such persons may be relatively sophisticated—at least as to the industrial goods—and less likely to be confused.<sup>210</sup>

#### 4. *Examiners Routinely Consider the Consumer Base*

Likelihood of confusion analysis also considers the level of sophistication of the targeted consumer base. Examining attorneys consider consumers' sophistication relative to relevant trade channels. Their analysis recognizes that people who are sophisticated purchasers of a product in one trade channel may be ordinary consumers of a product in another channel.<sup>211</sup> The fact that a product or service is expensive, or sold to a more specialized group of consumers, does not necessarily mean that such "sophisticated" consumers are immune to confusion.<sup>212</sup> When products may be purchased by both sophisticated and unsophisticated consumers, the examining attorney will likely look at the group of consumers that is least sophisticated and base the decision on the

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207. *Conopco, Inc. v. May Dep't Stores Co.*, 46 F.3d 1556, 1564–65 (Fed. Cir. 1994); *cf. Kroger Co. v. Johnson & Johnson*, 570 F. Supp. 1055 (S.D. Ohio 1983); *Gray v. Meijer, Inc.*, 295 F.3d 641, 650 (6th Cir. 2002) (finding no confusion because store brands grouped separately from independent brands, albeit in the "same basic area" of the store).

208. *See Marathon Mfg. Co. v. Enerlite Prods. Corp.*, 767 F.2d 214, 226 (5th Cir. 1985) (restricted market, very similar marks).

209. *Am. Cyanamid Co. v. S.C. Johnson & Son, Inc.*, 729 F. Supp. 1018, 1028 (D.N.J. 1989) (insecticide sold at retail and to exterminators); *In re Shipp*, 4 U.S.P.Q.2d 1174, 1176 (T.T.A.B. 1987) (retail dry cleaning services and commercial dry cleaning machine filters).

210. *In re Shipp*, 4 U.S.P.Q.2d at 1176.

211. However, an applicant may not restrict the scope of the goods covered in the cited registration; rather, trademark owners are limited to the identification of goods and services contained in the application. *In re Davey Prods. Pty Ltd.*, 92 U.S.P.Q.2d 1198, 1204 (T.T.A.B. 2009) ("[I]t is the identification of goods that controls, not what extrinsic evidence may show about the specific nature of the goods . . . . An applicant may not restrict the scope of the goods covered in the cited registration by argument or extrinsic evidence." (citing *In re Peregrina Ltd.*, 86 U.S.P.Q.2d 1645, 1646 (T.T.A.B. 2008))).

212. *See id.*; *In re Toshiba Med. Sys. Corp.*, 91 U.S.P.Q.2d 1266, 1272 (T.T.A.B. 2009); *In re N.A.D. Inc.*, 754 F.2d 996, 999–1000 (Fed. Cir. 1985).

examination of the potential for likelihood of confusion within that group.<sup>213</sup> Circumstances indicating that consumers would exercise care when purchasing relevant goods tend to minimize the likelihood of confusion.<sup>214</sup>

The appropriate consumer base is considered in conjunction with relevant trade channels. As such, it may include people who are not targeted by the trademark owner but who are exposed to the mark in question. For example, in *Stone Lion Capital Partners v. Lion Capital* the examining attorney found that even though the company providing financial services targeted only sophisticated investors, unsophisticated consumers seeking financial advice would also likely be exposed to the trademark.<sup>215</sup> In another case, the Federal Circuit found a high level of sophistication where medical products would be purchased only in consultation with anesthesiologists or other professionals with technical knowledge.<sup>216</sup>

#### B. OTHER BASES FOR REFUSAL REGULARLY CONSIDER CONTEXTUAL FACTORS THROUGHOUT THE REGISTRATION PROCESS

Contextual factors are key to the application of other registration bars as well, including, among others, descriptiveness, genericism, and functionality. Trademarks are typically evaluated with reference to the goods and services at issue. As a baseline, trademarks must be distinctive; distinctiveness is measured by evaluating the mark in relation to the specific goods or services listed in the application.<sup>217</sup> Marks that are merely descriptive of the goods or services thus cannot be registered on the principal register absent a showing of secondary meaning, which is evaluated pursuant to further contextual information—what is in the minds of consumers.<sup>218</sup> The determination of whether a mark is merely

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213. *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 1323–24 (Fed. Cir. 2014); *see also* *Gen. Mills, Inc. v. Fage Dairy Processing Indus. S.A.*, 100 U.S.P.Q.2d 1584, 1600 (T.T.A.B. 2011), judgment set aside on other grounds, 110 U.S.P.Q.2d 1679 (T.T.A.B. 2014); *cf.* *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 293 (3d Cir. 1991) (stating, in the context of a trademark infringement case, that “when a buyer class is mixed, the standard of care to be exercised by the reasonably prudent purchaser will be equal to that of the least sophisticated consumer in the class.”).

214. *In re Homeland Vinyl Prods., Inc.* 81 U.S.P.Q.2d 1378, 1380 (T.T.A.B. 2006).

215. *Stone Lion Capital Partners*, 746 F.3d at 1323–24. The Federal Circuit held that, because the services could be “consumed” by sophisticated and unsophisticated consumers alike, the TTAB correctly found likelihood of confusion. *Id.* at 1320.

216. *In re N.A.D.*, 754 F.2d at 999–1000.

217. 15 U.S.C. § 1052 (2006) (“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 . . . (e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them . . . .”); U.S. PATENT & TRADEMARK OFFICE, TMEP § 1209.01 (Apr. 2016) (citing *Remington Prods., Inc. v. N. Am. Philips Corp.*, 892 F.2d 1576, 1580 (Fed. Cir. 1990)).

218. 15 U.S.C. § 1052(f); TMEP § 1209.01(b); TMEP §§ 1212 *et seq.*

descriptive must be made in relation to the goods or services, not in the abstract: “This requires consideration of the context in which the mark is used or intended to be used in connection with those goods/services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace.”<sup>219</sup>

Like a merely descriptive mark, a generic mark cannot be registered because it fails to function as a trademark.<sup>220</sup> The two-part test to determine whether or not a trademark is generic is a contextual one. It looks at the class of goods or services at issue, and asks whether the relevant public understands the designation primarily to refer to that class of goods or services.<sup>221</sup> Marks cannot be registered at all if they are found to be generic. Generic terms are understood by the relevant purchasing public to be the common or categorical name for the goods or services.<sup>222</sup>

Functional elements cannot be protected as a trademark or as trade dress.<sup>223</sup> Like the other bases for refusal of registration, the test for functionality is highly based on contextual factors.<sup>224</sup> A proper assessment of functionality includes evidence both within and beyond the trademark application.<sup>225</sup> A mark will be functional where it is “essential to the use or purpose of the product or if it affects the cost or quality of the device.”<sup>226</sup> The examining attorney must establish a prima facie case for functionality, which can then be rebutted by the applicant.<sup>227</sup> Contextual evidence is key, and may include: (1) the existence of a utility patent whose claims cover the features sought to be registered; (2) promotional material touting the utilitarian advantages of the design; (3) availability of alternative designs for competitors; and (4) whether the design is

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219. TMEP § 1209.01(b).

220. 15 U.S.C. § 1052. The statute requires that a mark distinguish the applicant’s goods or services in order to be registered; because a generic term refers to an entire class of goods, it cannot be distinctive.

221. TMEP § 1209.01(c)(1) (citing *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 990 (Fed. Cir. 1986)).

222. *Id.* § 1209.01(c) (noting that “[g]eneric terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001).” (citations omitted)).

223. 15 U.S.C. § 1052(e)(5).

224. TMEP § 1202.02(a)(v) (Apr. 2016) (“In general terms, trade dress is functional, and cannot serve as a trademark, if a feature of that trade dress is ‘essential to the use or purpose of the article or if it affects the cost or quality of the article.’ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163–64 [sic] (1995) (quoting *Inwood Labs. v. Ives Labs., Inc.*, 456 U.S. 844, 850, n.10, 214 USPQ 1, 4, n.10 (1982)).”).

225. *Id.* § 1202.02(a)(v).

226. *Qualitex Co.*, 514 U.S. at 165.

227. TMEP § 1202.02(a)(iv) (citing *Textron, Inc. v. U.S. Int’l Trade Comm’n*, 753 F.2d 1019, 1025 (Fed. Cir. 1985)).

comparatively simple, efficient, or inexpensive.<sup>228</sup> Context is so important to the functionality analysis that examining attorneys are instructed not to just examine the specimen(s) submitted by the applicant, but to ask the applicant to submit contextual information outside the application,<sup>229</sup> and to conduct independent research to find advertising or promotional material.<sup>230</sup>

### C. LIKE OTHER BASES FOR REFUSAL, THE BAR TO REGISTRATION OF SCANDALOUS MARKS SHOULD CONSIDER CONTEXTUAL FACTORS

For a rejection based on morality, trademark examiners should do what they do across the spectrum of trademark law: evaluate the trademark in light of the overall market context in which the mark is used. Trademark examiners are accustomed to this analysis; they do it regularly to evaluate whether a mark is eligible for registration, including considering the goods and services in the context of the relevant marketplace, channels of trade, and the relevant purchasing public—in some situations, such as an evaluation of functionality, going well beyond information contained in the application. Consideration of these contextual factors would lead to better results for refusals based on scandalousness as they do for other registration bars.

### V. CONTEXT IN OTHER FORMS OF CONTENT REGULATION

Consideration of context for scandalous marks would be consistent with other forms of content regulation. The Federal Communications Commission (“FCC”) has moved toward consideration of context in its broadcast regulations. The FCC regulation of broadcast content has often been criticized by popular culture and the media, perhaps best known through George Carlin’s 1972 monologue, *Filthy Words*.<sup>231</sup> However, even within these oft-criticized regulations there is a move away from a categorical judgment based on the “seven words” and toward some consideration of the general context and market for the broadcast content. Furthermore, the Supreme Court and the FCC have very clearly stated that whether something is patently offensive is

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228. *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340–41 (C.C.P.A. 1982); see TMEP § 1202.02(a)(v).

229. TMEP § 1202.02(a)(v) (“[T]he examining attorney should: (1) ask the applicant to provide copies of any patent(s) or any pending or abandoned patent application(s); (2) ask the applicant to provide any available advertising, promotional, or explanatory material concerning the goods/services; (3) inquire of the applicant whether alternative designs are available; and (4) inquire whether the feature makes the product easier or cheaper to manufacture.”).

230. *Id.*

231. *F.C.C. v. Pacifica Found.*, 438 U.S. 726, 751–55 (1978) (transcript of monologue); George Carlin, *7 Dirty Words*, YouTube (Jan. 11, 2014), <https://www.youtube.com/watch?v=FMkNsMMVrjq> (discussing the following seven words: shit, piss, fuck, cunt, cocksucker, motherfucker, and tits).



determined in the context of the specific broadcast and market, rather than in the abstract.

#### A. HISTORY OF REGULATION OF BROADCAST CONTENT AND MORALITY

The FCC regulates broadcast content based on both obscenity and indecency.<sup>232</sup> The FCC has separate categories for each of these types of content; obscenity is flatly prohibited while indecency is regulated.<sup>233</sup> Indecent broadcasts, which contain content that would be subject to a 2(a) rejection for scandalousness or immorality if contained in a trademark, are statutorily permitted between the hours of 10:00 p.m. and 6:00 a.m.<sup>234</sup> Obscene material, on the other hand, is subject to a three-pronged test in an effort to determine whether the material is of a prurient nature and lacking in literary, artistic, political, or scientific value.<sup>235</sup>

When determining indecency, the focus is mainly on the material's effect on children and whether the material is patently offensive.<sup>236</sup> In both cases, when determining if material is prurient or patently offensive, the proper standard is that of the "contemporary community" which is non-geographical and includes the average broadcast viewer or listener.<sup>237</sup>

##### *I. There Has Been a Consistent Increase in the Use of Context to Determine Regulation of Broadcast Content Based on Offensiveness*

Although a general definition of indecency was adopted a few years before, the standard for regulation of morality in broadcast content was established in 1978.<sup>238</sup> The *Pacifica* standard focused on the legendary "seven words" and a prohibition on indecent content between the hours

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232. 47 C.F.R. § 73.3999 (1995) ("Enforcement of 18 U.S.C. 1464 (restrictions on the transmission of obscene and indecent material)"); *Obscene, Indecent and Profane Broadcasts*, F.C.C., <http://www.fcc.gov/guides/obscenity-indecency-and-profanity> (last updated June 30, 2016); *Regulation of Obscenity, Indecency and Profanity*, F.C.C., <https://www.fcc.gov/general/regulation-obscenity-indecency-and-profanity> (last visited Nov. 7, 2016).

233. *Obscene, Indecent and Profane Broadcasts*, *supra* note 232; *Regulation of Obscenity, Indecency and Profanity*, *supra* note 232; 47 C.F.R. § 73.3999 ("(a) No licensee of a radio or television broadcast station shall broadcast any material which is obscene. (b) No licensee of a radio or television broadcast station shall broadcast on any day between 6 a.m. and 10 p.m. any material which is indecent.").

234. 47 C.F.R. § 73.3999.

235. *Obscene, Indecent and Profane Broadcasts*, *supra* note 232; 47 C.F.R. § 73.4165 (1994) ("Obscene language").

236. *Pacifica Found.*, 438 U.S. at 726.

237. *Id.*

238. *Id.* (holding that the government can constitutionally regulate indecent broadcasts, and providing the foundation for FCC enforcement of indecent material).

of 6:00 a.m. and 10:00 p.m.<sup>239</sup> A decade later, the FCC determined that this interpretation of the *Pacifica* standard was too narrow and needed to accommodate contextual considerations.<sup>240</sup> The FCC reiterated the original indecency standard: “language that describes in terms patently offensive as measured by contemporary community standards for the broadcast medium, sexual or excretory activities and organs.”<sup>241</sup> The FCC also emphasized that the focus was on impact on children and repetition of expletives, indicating that fleeting or isolated use weighed against—but did not prohibit—a finding of indecency.<sup>242</sup> In 2001, the FCC issued a policy statement clarifying the indecency standard and stating a factor test for determining if something is indecent.<sup>243</sup> The three main factors, though these are non-exhaustive and the FCC or courts may take into account other factors, are as follows: “(1) the *explicitness or graphic nature* of the description or depiction . . . ; (2) whether the material *dwells on or repeats at length* [indecent] descriptions . . . ; (3) *whether material appears to pander or is used to titillate*, or *whether the material appears to be presented for shock value*.”<sup>244</sup> The focus is on the contextual meaning; innuendo and double entendres can be indecent if the meaning is clear and unmistakable.<sup>245</sup> Toward that end, the FCC reiterated that fleeting or isolated use would weigh against a finding of indecency, but would not preclude it.<sup>246</sup>

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239. *Id.*

240. *In re Citizen’s Complaint Against Pacifica Found.*, 56 F.C.C.2d. 94, 98 (1975) (providing that the definition of indecent language is “language that describes in terms patently offensive as measured by contemporary community standards for the broadcast medium, sexual or excretory activities and organs”).

241. *Id.*

242. The FCC also sought to do away with strict time periods, because children could still be exposed after 10 p.m. In 1995, in response to congressional and court rulings, the 10:00 p.m. to 6:00 a.m. rule was reinstated and codified at 47 C.F.R. § 73.3999 (1995).

243. Industry Guidance on Interpreting 18 U.S.C. § 1464, 16 FCC Rcd. 7999 (2001).

244. *Id.* at 8003. Under this standard, fleeting or single use would weigh against a finding of indecency, but may still be indecent where other factors contribute to a finding of patent offensiveness, such as broadcasting references to sexual activities with children and material that is graphic or explicit.

245. *Id.* at 8002–03.

246. *See F.C.C. v. Fox Television Stations, Inc.*, 556 U.S. 502, 509 (2009). In 2003, the FCC initially found that isolated use of the word “fuck” in a Golden Globes broadcast, because it was used as an expletive rather than descriptor of sex, and because the word was isolated rather than repeated, was not indecent. In 2004, the FCC appeals panel overturned that ruling, finding that “fuck” was “one of the most vulgar, graphic and explicit descriptions of sexual activity in the English language” and “any use of that word . . . inherently has a sexual connotation,” thus, isolated use of such a word does not preclude a finding of indecency. *Id.* at 508–09. This removed the requirement that a broadcast must dwell on or repeat an expletive in order to be found indecent. *Complaints Against Various Broadcast Licensees Regarding the “Golden Globe Awards,”* 18 FCC Rcd. 19859 (2003).

Overall, the definitions of what is indecent or obscene have not changed, but enforcement has become broader.<sup>247</sup> The focus within enforcement is primarily on protecting children, but context is key.<sup>248</sup> The analysis includes the time and place that the program is aired, the place

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247. The Motion Picture Association of America (“MPAA”), on the other hand, does appear to have altered what it determines to meet each category over time. Complaints Against Various Licensees Regarding the “Golden Globe Awards,” 19 FCC Rcd. 4975 (2004). Harvard published a report in 2004 indicating “ratings creep” and that, over the previous decade, the amount of sex and violence permitted in lower ratings categories had increased. Violence appears to be the primary beneficiary, lower ratings having larger amounts of violence than before, while sex and sexual references are still considered more scandalous and more likely to garner a higher rating (though still more acceptable at lower ratings than previously). Kimberly H. Thompson & Fumie Yokota, *Violence, Sex, and Profanity in Films: Correlation of Movie Ratings with Content*, MEDSCAPE GEN. MED. (2004), <http://www.medscape.com/viewarticle/480900>; Press Release, Harvard Sch. of Pub. Health, Study Finds “Ratings Creep”: Movie Ratings Categories Contain More Violence, Sex, Profanity than Decade Ago (July 13, 2004), <http://archive.sph.harvard.edu/press-releases/archives/2004-releases/presso7132004.html>; Nell Minow, *Movie ‘Ratings Creep’ Means PG-13 Isn’t What It Used to Be*, CHICAGO TRIBUNE (Aug. 13, 2004), [http://articles.chicagotribune.com/2004-08-13/features/0408130192\\_1\\_potentially-objectionable-content-mpaa-ratings-movie](http://articles.chicagotribune.com/2004-08-13/features/0408130192_1_potentially-objectionable-content-mpaa-ratings-movie); Sharon Waxman, *Study Finds Film Ratings Are Growing More Lenient*, N.Y. TIMES (July 14, 2004), <http://www.nytimes.com/2004/07/14/movies/study-finds-film-ratings-are-growing-more-lenient.html>; Mike Snider, *Harvard Study Is First to Measure ‘Ratings Creep.’* USA TODAY (July 13, 2004, 11:06 PM), [http://usatoday30.usatoday.com/life/movies/news/2004-07-13-harvard-ratings-creep\\_x.htm](http://usatoday30.usatoday.com/life/movies/news/2004-07-13-harvard-ratings-creep_x.htm); ASSOC. PRESS, *‘Ratings Creep’ Found Prevalent*, L.A. TIMES (July 15, 2004), <http://articles.latimes.com/2004/jul/15/news/wk-quick15.4>. The Entertainment Software Ratings Board (“ESRB”) has seen a similar shift in what is acceptable for different levels of ratings though to a lesser extent than the MPAA. For example, blood was previously not allowed in the “Teen” category but is now permitted so long as it is static and not gratuitous. However, the ESRB also acknowledges that, though it has shifted what is acceptable based on contemporary views, violence is more acceptable than sex as far as ratings. The TV Parental Guidance system is actually done by the broadcasters themselves resulting in inconsistencies in application. Interestingly, in the case of television it appears that ratings have increased due to a decrease in the stigma of a show with a higher rating. However, with no centralized ratings board it is hard to say if there has been a shift in what falls under which category. *ESRB Ratings Guide*, ENT. SOFTWARE RATINGS BOARD, [http://www.esrb.org/ratings/ratings\\_guide.jsp](http://www.esrb.org/ratings/ratings_guide.jsp) (last visited Nov. 7, 2016); see also Telephone Interview with Patricia Vance, President, Entm’t Software Ratings Board (Sept. 16, 2014); Heather Newman, *Twenty Years of ESRB: More Blood, Less Hassle for Developers (Interview)*, VENTUREBEAT (Sept. 16, 2014, 3:00 AM), <http://venturebeat.com/2014/09/16/twenty-years-of-esrb-more-blood-less-hassle-for-developers-interview/> (providing transcription of Patricia Vance’s interview with VentureBeat); Kyle Orland, *20 Years, 20 Questionable Game Ratings: A Timeline of ESRB Oddities*, ARSTECHNICA (Sept. 16, 2014, 2:00 PM), <http://arstechnica.com/gaming/2014/09/20-years-20-questionable-game-ratings-a-timeline-of-esrb-oddities/>; Matt Matthews, *This Game Is Not yet Rated: Inside the ESRB Ratings System*, GAMASUTRA (Oct. 16, 2007), [http://www.gamasutra.com/view/feature/130387/this\\_game\\_is\\_not\\_yet\\_rated\\_inside\\_.php?print=1](http://www.gamasutra.com/view/feature/130387/this_game_is_not_yet_rated_inside_.php?print=1) (describing the ratings process and how context is taken into account).

248. See *F.C.C. v. Pacifica Found.*, 438 U.S. 726, 733 (1978); *Action for Children’s Television v. F.C.C.*, 58 F.3d 654 (D.C. Cir. 1995) (noting that safe harbor is 10:00 p.m. to 6:00 a.m. because there is no relationship between the distinction of commercial v. noncommercial stations and the compelling governmentt interest); see also *Enforcement of Prohibitions Against Broadcasting Indecency*, 8 FCC Rcd. 704 (1993); 58 Fed. Reg. 5937 (Jan. 25, 1993) (mandating 12:00 a.m. to 6 a.m. safe harbor instead of 10:00 p.m. to 6:00 a.m., overruled by *Action for Children’s Television v. F.C.C.*, 11 F.3d 170, 171 (D.C. Cir. 1993)); *In re Sagittarius Broadcasting Corp.*, 8 FCC Rcd. 3600, 3600 (1993) (noting that audience poll not enough to demonstrate lack of child audience because broadcast was outside new safe harbor limits); *Letter to The Rusk Corp.*, 8 FCC Rcd. 3228, 3229 (1993) (arguing that the prevalence of sexual content doesn’t make the content less indecent, because rules are for protecting children and not about what adults consider decent for an adult audience).

of viewing, and the greater context of the broadcast, including the surrounding content.<sup>249</sup>

The Supreme Court has established that, to be obscene, material must meet a three-pronged test, based on contemporary community standards: (1) An average person, applying contemporary community standards, must find that the material, as a whole, “appeals to the prurient interest;” (2) the material must depict or describe, in a patently offensive way, “sexual conduct specifically defined by applicable law;” and (3) the material, taken as a whole, must “lack serious literary, artistic, political or scientific value.”<sup>250</sup> The FCC has defined broadcast indecency as “language or material that, in context, depicts or describes, in terms patently offensive as measured by contemporary community standards for the broadcast medium, sexual or excretory organs or activities.”<sup>251</sup> Indecent programming contains patently offensive sexual or excretory material that does not rise to the level of obscenity.<sup>252</sup> Courts have held that indecent material is protected by the First Amendment and cannot be banned entirely.<sup>253</sup> It may, however, be restricted in order to avoid its broadcast during times of the day when there is a reasonable risk that children may be in the audience.<sup>254</sup> Currently, even a single utterance of an expletive—the seven words from Carlin have been stated as examples rather than an exhaustive list—can still be ruled indecent depending on the other context of the material. However, there is now a statutory safe harbor time between 10:00 p.m. to 6:00 a.m.<sup>255</sup> The FCC has defined profanity as “including language so grossly offensive to members of the public who actually hear it as to amount to a nuisance.”<sup>256</sup> In making obscenity, indecency, and profanity determinations, *context is key*. The FCC staff must analyze what was actually aired, the meaning of what was aired, and the context in which it was aired.<sup>257</sup>

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249. See *Obscene, Indecent and Profane Broadcasts*, supra note 232; *Regulation of Obscenity, Indecency and Profanity*, supra note 232; 47 C.F.R. § 73.3999 (1995).

250. *Miller v. California*, 413 U.S. 15, 24 (1973) (redefining obscenity from the previous standard of “utterly without redeeming social value” to something that lacks “serious literary, artistic, political, or scientific value”) (emphasis omitted).

251. *In re Citizen’s Complaint Against Pacifica Foundation*, 56 F.C.C.2d. 94, 98 (1975).

252. See *Obscene, Indecent and Profane Broadcasts*, supra note 232.

253. *Cohen v. California*, 403 U.S. 15, 25 (1971) (finding indecent speech protected by the First Amendment and famously noting that it is “often true that one man’s vulgarity is another’s lyric”).

254. *F.C.C. v. Pacifica Found.*, 438 U.S. 726, 749 (1978); *Bethel Sch. Dist. v. Fraser*, 478 U.S. 675, 684 (1986).

255. 47 C.F.R. § 73.3999 (1995).

256. *Obscene, Indecent and Profane Broadcasts*, supra note 232.

257. *Id.*

## CONCLUSION

The registration bar for scandalous marks should be removed from the Lanham Act. It should be removed because morality is outside the function and purpose of trademark law; the consumer protection at the heart of trademark law is one of source quality, not moral quality. Removal of the registration bar would be more consistent with other forms of intellectual property, which have moved away from regulating morality. It would also resolve concerns about the provision's constitutionality.

However, if the bar remains in the Lanham Act, it should be applied in a way that is fair and effective within the legal framework of trademark law. *In re Mavety Media* indicates that scandalousness should be evaluated in the context of the current attitudes of the day and the marketplace identified in the application.<sup>258</sup> However, if the particular mark contains words that are listed as "vulgar" in the dictionary, that is sufficient for a 2(a) rejection. Examining attorneys are given these general guidelines, but they are not very helpful in practical terms. Examining attorneys should treat a 2(a) question based on scandalousness or immorality the same way they treat most other issues in trademark law: through an assessment of the mark in the context of the marketplace. This would be consistent with other bars to registration found in the Lanham Act, and forms of content regulation in broadcast media.

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258. *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1370 (Fed. Cir. 1994).