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Registering Offense: The Prohibition of Slurs as Trademarks, in Diversity in Intellectual Property: Identities, Interests, and Intersections

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Recommended Citation

Farley, Christine, "Registering Offense: The Prohibition of Slurs as Trademarks, in Diversity in Intellectual Property: Identities, Interests, and Intersections" (2015). *Contributions to Books*. 104.
https://digitalcommons.wcl.american.edu/facsch_bk_contributions/104

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Diversity in Intellectual Property

Identities, Interests, and Intersections

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www.cambridge.org

Information on this title: www.cambridge.org/9781107065529

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First published 2015

A catalog record for this publication is available from the British Library.

Library of Congress Cataloging in Publication Data

Diversity in intellectual property : identities, interests, and intersections /
edited by Irene Calboli, Marquette University Law School and Faculty of Law,
National University of Singapore; Srividhya Ragavan, University of Oklahoma
College of Law.

pages cm

Includes bibliographical references and index.

ISBN 978-1-107-06552-9 (hardback)

1. Intellectual property. 2. Intellectual property (International law)

3. Culture and law. 4. Multiculturalism – Law and legislation.

I. Calboli, Irene, editor. II. Ragavan, Srividhya, editor.

K1401.D58 2015

346.04'8–dc23 2015003109

ISBN 978-1-107-06552-9 Hardback

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5 Registering Offense: The Prohibition of Slurs as Trademarks

*Christine Haight Farley**

I. Introduction

In what way does trademark law either promote diversity or protect the interests of diverse communities? Facially at least, the U.S. Trademark Act (Lanham Act) seeks to prevent the disparagement of persons. Section 2(a) of the Lanham Act prohibits the registration of marks that consist of matter that may disparage or bring into contempt or disrepute any person, institution, or belief.¹ This provision would thus appear to bar discriminatory language or hate speech from being registered as a trademark. Significantly, neither this provision, nor any other section of the Lanham Act prohibits the *use* of disparaging trademarks. Only the *registration* of disparaging trademarks is prohibited. Is it thus possible for such a limited protection to promote diversity?

Limited as it may be, the refusal of the U.S. Patent and Trademark Office (USPTO) to grant federal registration to offensive marks plays some role in protecting the public from racist or otherwise highly offensive trademarks. The USPTO does so even though such actions may appear to some as a form of censorship and even though such determinations may embroil the USPTO and courts in differing standards of cultural sensitivity. Were the USPTO less committed to these policy

* Professor, American University Washington College of Law. Please send comments to cfarley@wcl.american.edu. I am grateful for the helpful feedback I received from Ann Bartow, Irene Galboli, Leah Chan Grinvald, Glynn Lunney, Jessica Silbey, Rebecca Tushnet, and Mary Wong at the American University Trademark Works in Progress Colloquium, and the outstanding research assistance I received from Kristin Lockhart.

¹ 15 U.S.C. § 1052(a) (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 – (a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt.

In this chapter, I refer to this list of prohibited matter in the shorthand of “immoral, scandalous, or disparaging” marks.

goals, it might instead play it safe and stick with determinations that are more germane to trademark law. These policy choices come with obvious challenges, but ultimately indicate that trademark law may have a role to play in fostering civility and diversity.

In this chapter, I first consider the policy goals and challenges of barring the registration of offensive marks through the ongoing dispute over the REDSKINS mark for the professional American football team in Washington, D.C. Building on this analysis, I will address today's practices of registering disparaging and otherwise offensive trademarks in general, and highlight the limited role of Section 2(a) of the Lanham Act in addressing the problems deriving from these registrations. I conclude by raising policy arguments in favor of restricting disparaging and otherwise offensive content in the form of registered trademarks under the Lanham Act.

II. Trademarking the “R Word” and the Harm Caused by Offensive Marks

A. *History and Developments of the REDSKINS Dispute*

The REDSKINS marks have been the subject of organized protests since 1968 and ongoing litigation in U.S. courts since 1992.² This dispute has garnered more attention and interest in Section 2(a) and its attendant issues than any other dispute or case under that section thus far.

Between 1967 and 1990, Pro-Football Inc. registered six marks containing the word “redskins.”³ The word “redskin” is generally understood to be a derogatory racial epithet referring to Native Americans. Many believe that the term “redskins” comes from a time “when bounties were offered for the murder of Native Americans” and the term refers to scalping.⁴ Native American organizations – including the National Congress of American Indians (NCAI), the National Indian Education Association, the Native American Journalists Association, the Native

² Public protest of the name began in 1968, with a resolution by the National Congress of American Indians. See NAT'L CONG. OF AM. INDIANS, ENDING THE LEGACY OF RACISM IN SPORTS & THE ERA OF HARMFUL INDIAN MASCOTS 18–20 (2013), available at http://www.ncai.org/attachments/PolicyPaper_mijApMoUWDbjqFtjAYzQWlqLdrwZvsYfakBwTHpMATcOroYolpN_NCAI_Harmful_Mascots_Report_Ending_the_Legacy_of_Racism_10_2013.pdf [hereinafter ENDING THE LEGACY OF RACISM IN SPORTS].

³ See *Harjo v. Pro Football, Inc.*, 30 U.S.P.Q.2d (BNA) 1828, 1829 (T.T.A.B. 1994).

⁴ Gale Courey Toensing, *Navajo Council Member Introduces Anti-Redskins Bill*, INDIAN COUNTRY TODAY, Mar. 13, 2014, available at <http://indiancountrytodaymedianetwork.com/2014/03/13/navajo-council-member-introduces-anti-redskins-bill-153979>.

American Rights Fund, the Morning Star Institute, the International Indian Treaty Council, and the National Indian Youth Council – have publicly and vociferously opposed the continued use of the term “red-skin” in trademarks or in the names of sports teams. Suzan Shown Harjo, the lead plaintiff in the first trademark challenge, refrains from using the word at all and instead refers to it as the “R word,” finding it analogous to the “N word.”⁵ The director of the Smithsonian National Museum of the American Indian has stated that he considers “redskin” to be the most offensive name in current use.⁶

In 1992, a group of seven prominent Native American leaders first challenged the REDSKINS trademarks in the USPTO as disparaging under Section 2(a). They petitioned the Trademark Trial and Appeal Board (TTAB) to cancel all six marks that contain the word “redskins.” To prove that the marks may disparage Native Americans or bring them into contempt or disrepute, petitioners presented the TTAB with the following evidence: dictionary definitions, reference works, written sources regarding meaning and use of “redskin,” examples of “redskin” used in a derogatory manner in written work and movies, the team’s own use of the name and marks in ways that mocked Native Americans, the expert testimony of linguists, the results of a survey, resolutions by the NCAI, and the opposition of other Native American groups and individuals. In 1999, the TTAB issued a 145-page opinion canceling all of the trademarks. The TTAB ruled that as of the date of registrations, “redskins” as used in connection with the marks refers to Native Americans, and a substantial composite of Native Americans would consider the term disparaging.⁷

The team then brought an appeal by way of a civil action to the district court for the District of D.C., which granted summary judgment in favor of the team. The court held that the Native American plaintiffs’ claims were barred by laches since they were unjustifiably delayed in bringing the action when some of the trademarks had already been registered for as long as twenty-five years by the time of the lawsuit.⁸ Yet, in a previous decision, the TTAB ruled that laches did not apply because

⁵ Suzan Shown Harjo, *DirtyWord Games*, INDIAN COUNTRY TODAY, June 22, 2005, available at <http://indiancountrytodaymedianetwork.com/2005/06/22/dirty-word-games-96506>.

⁶ See Brett Zongker, *American Indian Museum Tackles Racism in U.S. Sports*, WTOP LOCAL NEWS, Feb. 7, 2013, available at <http://www.wtop.com/41/3219546/American-Indian-museum-tackles-racism-in-US-sports> (finding that some understand the word “redskins” to be the equivalent of the “n-word”).

⁷ *Harjo v. Pro Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705 (T.T.A.B. 1999).

⁸ *Pro Football, Inc. v. Harjo*, 284 F. Supp. 2d 96 (D.D.C. 2003).

matters of broad public policy are not subject to the equitable defense of laches.⁹ The district court's ruling was ultimately upheld by the Court of Appeals for the D.C. Circuit.¹⁰ Thereafter, the U.S. Supreme Court denied certiorari.¹¹

As a result of the laches ruling, a new group of five younger Native Americans brought another challenge in 2006, again petitioning the TTAB to cancel the six REDSKINS registrations.¹² In 2014, the TTAB issued another lengthy opinion cancelling all of the trademarks, finding that the REDSKINS mark still retained its derogatory meaning referring to Native Americans, even though it was commonly associated with the Washington football team. After thoroughly examining expert testimony and dictionary evidence, it reached the conclusion that at least 30 percent of Native Americans found the mark, in connection with professional football, to be offensive or disparaging.¹³ In its decision, the TTAB revisited the issue of laches¹⁴ and ruled for a second time that the equitable defense does not apply where there is a broader public policy concern at issue. Namely, even if the owner of the REDSKINS mark did have a viable laches defense, the new petitioners' "unreasonable delay" was not compelling enough to bar a disparagement claim and retain a racial slur's registration.¹⁵ As expected, the Washington football team issued a statement following the decision, expressing its confidence of a more favorable outcome on appeal.¹⁶

Due to the attention this litigation generated about the REDSKINS trademark and the frustration with the courts' rulings, a bill was introduced in the U.S. Congress to provide a legislative fix to the problem. On March 20, 2013, Congressman Eni F.H. Faleomavaega (American Samoa), along with nineteen other bipartisan cosponsors, introduced the Non-Disparagement of Native American Persons or Peoples in

⁹ *Harjo v. Pro Football, Inc.*, 30 U.S.P.Q.2d (BNA) 1828, 1833 (T.T.A.B. 1994).

¹⁰ *See Pro-Football, Inc. v. Harjo*, 565 F.3d 880, 880–81 (D.C. Cir. 2009).

¹¹ *Harjo v. Pro Football, Inc.*, 565 F.3d 880 (D.C. Cir.), *cert. denied*, 130 S. Ct. 631 (2009).

¹² *Blackhorse et al. v. Pro-Football, Inc.*, Cancellation No. 92046185 (June 18, 2014) (precedential).

¹³ *Id.* at 71 (finding that 30% was "without a doubt a substantial composite").

¹⁴ *Id.* at 73–74 (ruling that the enactment of the AIA, which changed the venue for appeals from the USPTO *inter partes* proceedings, meant that the previous laches decision by the U.S. District Court for the District of D.C. was not binding or persuasive).

¹⁵ *Id.* at 75 ("It is difficult to justify a balancing of equities where a registrant's financial interest is weighed against human dignity.").

¹⁶ Statement by Bob Raskopf, Trademark Attorney for the Washington Redskins, Washington Redskins; Press Release, June 18, 2014, available at <http://files.redskins.com/pdf/Statement-by-Bob-Raskopf-Trademark-Attorney-for-the-Washington-Redskins.pdf>.

Trademark Registration Act to amend the U.S. Trademark Act to prohibit the registration of the word “redskins.”¹⁷ The bill states:

Section 2(a) of the Trademark Act of 1946 (15 U.S.C. 1052(a)) is amended by adding at the end the following: “A mark consisting of or including the term ‘redskin’ or any derivation of the term ‘redskin’ shall be conclusively presumed to consist of matter which may disparage persons if (1) the mark has been, is, or is intended to be used in commerce in connection with references to or images of one or more Native American persons or peoples, or to Native American persons or peoples in general; or (2) the Director determines that the term as included in the mark is commonly understood to refer to one or more Native Americans persons or peoples, or to Native American persons or peoples in general.”¹⁸

In reaction to the publicity over the trademark dispute, a segment of the general public has renounced the team name. Many fans of the team, including the Mayor of Washington, D.C., and major sportscasters such as Bob Costas, avoid using the name and instead refer to the team as “the Washington football team.”¹⁹ Senate Majority Leader Harry Reid and House Minority Leader Nancy Pelosi, as well as other members of Congress, have publicly spoken out about the name.²⁰ Even President Obama has publically stated: “If I were the owner of the team and I knew that there was a name of my team – even if it had a storied history – that was offending a sizeable group of people, I’d think about changing it.”²¹

Based on the time and effort expended on this dispute, Native American leaders obviously feel that this is an important civil rights issue. Between the evidence produced in the litigation, the amicus curiae briefs filed with the Supreme Court, and the public discussion generated by the dispute, a clearer understanding of the harms in registering offensive trademarks has emerged. The social costs to the public are huge and include reinforcing hateful stereotypes and misinformation about fellow citizens. The psychological effects of such racialized representations are immediate to the referenced group and also to society as a whole.

¹⁷ Non-Disparagement of Native American Persons or Peoples in Trademark Registration Act of 2013, H.R. 1278, 113th Cong. (2013) [hereinafter Non-Disparagement Act].

¹⁸ *Id.* at §4.

¹⁹ Mike Florio, *D.C. Mayor Backpedals on Redskins Name Change*, NBC SPORTS, Feb. 11, 2013, available at <http://profootballtalk.nbcsports.com/2013/02/11/d-c-mayor-backpedals-on-redskins-name-change/>.

²⁰ Dan Steinberg, *Harry Reid Predicts Redskins Name Changes Within Three Years*, WASH. POST, Mar. 27, 2013, available at <http://www.washingtonpost.com/blogs/dc-sports-bog/wp/2014/03/27/harry-reid-predicts-redskins-name-changes-within-three-years/>.

²¹ Mike Jones, *President Obama: ‘I’d Think About Changing’ The Redskins Name*, WASH. POST, Oct. 5, 2013, available at <http://www.washingtonpost.com/blogs/football-insider/wp/2013/10/05/president-obama-id-think-about-changing-redskins-name/>.

B. *The Harm Caused by Offensive Trademarks*

Recent psychological evidence has demonstrated the negative effects associated with stereotypical and derogatory references to Native American people.²² A group of psychologists filed an amicus curiae brief at the Supreme Court that cogently argues that racially charged trademarks have myriad negative impacts on minority populations, including the perpetuation of harmful stereotypes and the promotion of discrimination. Research in this area suggests that the use of ethnic slurs, whether intentionally or unintentionally, “conveys hatred and hostility toward the target group.”²³ According to the brief authors, the repeated use of ethnic slurs and stereotypes has “profound and lasting negative impacts on American Indians and non-Indians alike.”²⁴

The authors cite research demonstrating that the use of Native American mascots:

(1) perpetuate[s] a narrow and false public perception of American Indian culture and identity, thereby diminishing and degrading such identity; (2) diminish[es] the self-esteem of American Indian individuals; and (3) correspondingly enhance[s] the self-esteem of European Americans, at the expense of American Indians.²⁵

Ethnic slurs and stereotypes have invidious public and private impacts. Strikingly, research shows that groups that are subject to ethnic slurs:

were less likely to marry native-born Americans; more likely to participate in ethnic fraternal associations; more likely to be segregated into ethnic neighborhoods; more likely to be deemed suitable for hazardous work; less likely to become naturalized citizens; and more likely to be subjected to harsher immigration quota restrictions, ... [and] were more likely to be portrayed to children in negative ways.²⁶

Moreover, and especially relevant to the Native American population, research suggests that ethnic groups targeted by racial slurs have higher suicide rates than other groups.²⁷

²² Brief of Psychol. Professors as Amici Curiae in Support of Petitioners at 14, *Pro Football, Inc. v. Harjo*, 565 F.3d 880 (D.C. Cir. 2009) (No. 03–7162) [hereinafter Brief].

²³ *Id.* at 11.

²⁴ *Id.* at 2.

²⁵ *Id.* at 14–15.

²⁶ *Id.* at 11–12, quoting Brian Mullen, *Complexity and Valence in Ethnophobias and Exclusion of Ethnic Out Groups: What Puts the “Hate” Into Hate Speech?*, 96 J. PERSONALITY & SOC. PSYCHOL. 170, 172 (Jan. 2009).

²⁷ *Id.* at 12, citing Brian Mullen & Joshua M. Smyth, *Immigrant Suicide Rates as a Function of Ethnophobias: Hate Speech Predicts Death*, 66 PSYCHOSOMATIC MED. 343, 343 (2004).

Of course, these stereotypes also affect how non-Native Americans view Native Americans. A White Paper by the NCAI emphasized research by Dr. Fryberg suggesting that these stereotypes also contribute to violence against Native Americans:

The intolerance and harm promoted by “Indian” mascots have very real consequences. The alarmingly high rates of hate crimes against Native people indicates a need to take immediate action in a number of areas, including the removal of harmful images and education of the general public to diffuse additional hateful activity against Native peoples. According to Department of Justice analysis, “American Indians are more likely than people of other races to experience violence at the hands of someone of a different race.”²⁸

These studies demonstrate that exposure to Native American mascots depresses the self-esteem, erodes the self-confidence, damages the sense of identity, diminishes the feelings of community worth, and limits the aspirations of Native American youth.²⁹ Significantly, these harmful effects were present even when the mascot was not considered to be “negative” by the affected individual.³⁰ That is, even the so-called honorific Native American mascots can be harmful because a stereotype does not have to be negative to have a dehumanizing impact on the individual and the rest of society. Public stereotypical representations play the same role as racist institutionalized policies and practices. They devalue culture and pose a continuing threat to identity. Individuals need to feel safe, valued, and respected in order to contribute to their full potential. In the case of marks and mascots referring to Native Americans, the effect is particularly pernicious as Native Americans make up only 1.5 percent of the U.S. population³¹ and non-Natives will likely encounter a Native American depicted on a sports team t-shirt far more frequently than they would encounter an actual Native American.

Besides this psychological harm, an additional and more symbolic harm occurs when someone’s cultural identity is literally, and legally, owned by another entity, regardless of whether the racial referent that is registered as a mark may be considered disparaging. By trademarking a racial referent, the message is that the referent is owned,³² and the owner

²⁸ See ENDING THE LEGACY OF RACISM IN SPORTS, *supra* note 2, at 5.

²⁹ Brief, *supra* note 22, at 14–15, citing Stephanie Fryberg, *Of Warrior Chiefs and Indian Princesses*, 30 BASIC & APPLIED SOC. PSYCHOL. 208, 209 (2008).

³⁰ Brief, *supra* note 22, at 17.

³¹ *Frequently Asked Questions*, U.S. DEPARTMENT OF THE INTERIOR: INDIAN AFFAIRS, available at <http://www.bia.gov/FAQs/> (last updated Apr. 11, 2014).

³² See ROSEMARY J. COOMBE, THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES: AUTHORSHIP, APPROPRIATION, AND THE LAW 175, 197 (1998) (“Many Native American names, for example, are far more prominent due to their mass reproduction

has the legal right to use the racial term; perhaps even the obligation to use it. The owner of the mark thus controls the use of the racial word, including where it appears and with what it is associated. Thus, in the case of a word or image for Native Americans, the mark's owner gets to decide whether to depict a fierce warrior, such as Pro-Football's mark, or a pathetic clown-like figure, such as the Chief Wahoo logo owned by the Cleveland Indians baseball team.³³ Adopting a racialized mark is a statement that the owner is so insensitive to the pain it causes that they have blithely built a business around it. And by going into business under harmful words, the owner also causes others – fans and consumers – to endlessly utter them.

The public discourse prompted by the REDSKIN litigation has helped the White majority better understand why Native Americans are offended by the mark. Although Pro-Football characterizes the mark as honorific, the logo as a noble depiction of a Native American, and their use of the marks as positive, the appropriation of Native American identity is nevertheless announced to the world. This appropriation, no matter how “honorific,” invites fans and consumers to invoke stereotypes. Hence warpaths, headdresses, tomahawks, silly dances, and other acts of mockery are enabled. An excellent political cartoon captures this offence in one frame where a White man outfitted in a loincloth, war paint, and headdress, carrying a beer in one hand and a pennant in the other that reads, “Go Warrior Savages,” says to a disappointed looking Native American: “But I’m honoring you, dude.”³⁴

III. The Phenomenon of Offensive Trademarks

A. *Beyond the REDSKINS: A Closer Look at Today's Practices*

The REDSKINS dispute may be the most notorious example of an offensive trademark in the United States, but it is not an isolated case. Offensive trademarks, unfortunately, are not merely relics of a bygone era. While it is true that some trademarks are particularly offensive because they were registered in a previous time when our sensitivity

as trademarks than are their original referents ... reiterate[ing] the injury” by reminding them “of their symbolic status as an invisible and vanishing peoples, whose images serve primarily as effigies in the national imagination.”)

³³ CLEVELAND INDIANS, Registration No. 1283304. This mark was cancelled on November 29, 1990, because the registrant failed to provide an acceptable declaration under Section 8.

³⁴ Lalo Alcaraz, Editorial Cartoon (2002), available at <http://pocho.com/wpcontent/uploads/2014/04/savagesmascotton2002.jpg>.

to racist or sexist language was lower than it may be today, offensive trademarks have emerged as a more recent phenomenon as well.³⁵

We must consider the historical use of racially charged trademarks in order to understand the present spectacle. Besides REDSKINS, other older racist marks include SAMBO'S, ESKIMO PIE, CRAZY HORSE, and FRITO BANDITO.³⁶ In other cases, the brand names alone were not racist, but the brand image associated with the product was. UNCLE BEN'S, AUNT JEMIMA, ROBERTSON'S, CREAM OF WHEAT, and CHIQUITA are all examples of racist stereotypes being used as trademarks.³⁷ In most of these cases, the offensive stereotype used in the packaging and advertising has been updated or abandoned in reaction to public outrage.³⁸

As Rosemary Coombe points out, use of the imagery of "others," – especially Eskimos, Hawaiians, Indians, and Blacks – was predominant at the creation of mass markets. Rather than mere coincidence, this imagery was deliberately employed. Mass advertised trademarks that accentuated the ethnic differences of some Americans in turn tended to deemphasize the cultural differences of others and thereby create an "American" consumer.³⁹ Nearly a century later, the Washington D.C. of 1967 – the year Pro-Football first registered the REDSKINS mark – was a city preoccupied with race and racial tensions. Perhaps the overt use of racial difference was to downplay the differences among Washington

³⁵ See *ex parte* Martha Maid Mfg. Co., 37 U.S.P.Q. 156 (Comm'r Pats. 1938) (denied registration of QUEBEN MARY for underwear); *In re* P.J. Valckenberg, GMBH, 122 U.S.P.Q. (BNA) 334 (T.T.A.B. 1959) (denying registration to MADONNA for wines); *In re* Runsdorf, 171 U.S.P.Q. (BNA) 443 (T.T.A.B. 1971) (finding the mark BUBBY TRAP for bras to be offensive). For an exhaustive list and analysis of marks denied registration on Section 2(a) grounds, see Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*, 101 TRADEMARK REP. 1476 (2011).

³⁶ U.S. Trademark Application Serial No. 77,915,048 (filed Jan. 19, 2010); ESKIMO PIE, Registration No. 893,953 (for frozen foods); CRAZY HORSE, Registration No. 3,044,028 (for entertainment services in the form of exotic dance performances); FRITO BANDITO, Registration No. 0,875,271 (for puffed corn snacks). In another example, the AMOS AND ANDY mark, was abandoned for non-use because it was racist. *Silverman v. CBS Inc.*, 870 F.2d 40 (2d Cir. 1989). Rosemary Coombe cites other examples such as Cherokee, Oneida, Winnebago, and Red Man chewing tobacco. See Rosemary J. Coombe, *Embodied Trademarks: Mimesis and Alterity on American Commercial Frontiers*, 11 CULTURAL ANTHROPOLOGY 202 (1996).

³⁷ UNCLE BEN'S, Registration No. 2,516,392 (for rice); AUNT JEMIMA, Registration No. 1,697,862 (for pancake and waffle mix and table syrup); ROBERTSON'S, Registration No. 3,629,301 (for jerky and other meat products); CREAM OF WHEAT, Registration No. 4,099,162 (for cereals and other breakfast foods); CHIQUITA, Registration No. 4,064,603 (for dipping sauces).

³⁸ Kim Bhasin & Karlee Weinmann, *12 Uncomfortably Racist Vintage Brand Mascots*, BUS. INSIDER, Sept. 8, 2011, available at <http://www.businessinsider.com/racist-company-mascots-2011-9?op=1>.

³⁹ Coombe, *Embodied Trademarks*, *supra* note 36, at 209.

D.C. residents and the football team's fans by contrasting those differences with the differences between the fan base and the savage primitiveness of the Indian depicted by the team. While the racial difference experienced by city's fans might have been a source of confusion and anxiety, the racial difference displayed by the mark was something easily recognized and consumed.

Sadly, it appears that offensive trademarks are now on the rise. In fact, there may be reason to believe that the problem is increasing rather than decreasing.⁴⁰ A recent search of the USPTO database reveals an alarming number of offensive trademark applications for registration, as well as issued registrations containing offensive words. These marks are offensive because they are racist, misogynist, and religiously intolerant. For example, there is a registration for SLUTMAGNET for shirts and musical group entertainment services,⁴¹ an application for registration for WHITE TRASH for trash bags,⁴² an application for I EAT PUSSY WITH A FORK for T-shirts,⁴³ an application for SHANK THE B!T@H for board games,⁴⁴ an application for DEGO for tequila,⁴⁵ and an application for WILD INJUN for a "plastic frame assembly for holding a ball-cap when washed in a washing machine or dishwasher."⁴⁶ These examples provide a glimpse of the range and type of offensive word marks that are being pursued.

As to the pervasiveness of the interest in offensive trademarks, while no empirical research yet exists, a search for trademark applications and registrations involving the word "bitch" returns hundreds of records and most of them are recent. Likewise, "pussy" and "fuck" produce a large number of results. Many of these applications involve plays on words. For instance, a recent application to register the mark COCK SUCKER was refused for chocolate lollipops molded in the shape of a rooster.⁴⁷

⁴⁰ David Boyle, *For Fuck's Sake – Brands Are Swearing More Than Ever*, THE GUARDIAN (Apr. 28, 2014); John Grossman, *Risqué Names Reap Rewards for Some Companies*, NY TIMES (Apr. 23, 2014).

⁴¹ SLUTMAGNET, U.S. Registration No. 2,404,415.

⁴² U.S. Trademark Application Serial No. 85,510,369 (filed Jan. 6, 2012).

⁴³ U.S. Trademark Application Serial No. 86,128,843 (filed Nov. 25, 2013).

⁴⁴ U.S. Trademark Application Serial No. 85,301,216 (filed Apr. 21, 2011).

⁴⁵ U.S. Trademark Application Serial No. 86,102,857 (filed Oct. 28, 2013).

⁴⁶ U.S. Trademark Application Serial No. 75,627,642 (filed Jan. 26, 1999). A company has registered the trademark BITCH for beer. BITCH, U.S. Reg. No. 2,448,202 (May 1, 2001). Other shocking applications for registration include JEWFR0, U.S. Registration No. 3,300,680 (Oct. 2, 2007); JEWBUTT, U.S. Registration No. 3,491,905 (Aug. 26, 2008); NEW PUSSY SMELL, U.S. Serial No. 86,136,180 (filed Dec. 5, 2013); and WIFE'S A BITCH, U.S. Serial. No. 86,090,187 (filed Oct. 12, 2013).

⁴⁷ *In re Fox*, 702 F.3d 633, 640 (Fed. Cir. 2012) (upholding the T.T.A.B.'s decision to deny registration of the mark, finding that one of the meanings of the mark was offensive under § 2(a) of the Lanham Act).

Why would anyone even invest the \$325 application fee⁴⁸ to register offensive words?⁴⁹ The proprietization of offensive speech is an interesting, but troubling phenomenon. Of course, we are also witness to an explosion of intellectual property exploitation. And in the case of offensive trademarks, these two phenomena have combined forces. Whatever proves to attract attention, intellectual property will be there providing exclusive rights to the savvy merchant. If a trendy new brand gets a response from the public, trademark law ensures a monopoly for the first user. Thus, the law must confront these new marketing practices.

B. *Marketing Practices and Offensive Trademarks*

In an effort to be noticed in an era of overwhelmed and distracted consumers, marketers have resorted to some base tactics. It is increasingly common to encounter indecent trademarks or marks that deliberately cross a line. The goal is to get attention. Offensive trademarks are one type of marketing that is not easily ignored.

For example, an Italian jeans company uses the trademark JESUS JEANS. It has applied for trademark registration in countries all over the world including the United States. In one ad campaign, a woman's derriere fills the screen and is barely covered by a teeny pair of cutoff jean shorts. The text reads: "He who loves me follows me."⁵⁰ In another ad, the image is a close-up of a woman's pelvic area with her jeans, tight and unzipped. The text reads: "Thou shalt not have any other jeans but me."⁵¹ These ads not only push the sex buttons, but also attempt to provoke religious sensitivities.

Increasingly, brands want to provoke a "wow!" response from consumers. In a case brought against an Australian beer company that launched a new beer called DUFF, there was evidence of a marketing study that indicated how the young adult demographic is attracted to brands that generate humor and wonderment.⁵² Indeed, the marketing

⁴⁸ Or \$375 for a paper application. See *Current Fee Schedule*, UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO), available at <http://www.uspto.gov/web/offices/ac/qs/ope/fee031913.htm>.

⁴⁹ Although I am mostly dealing with offensive words and word marks, it is of course possible that logos, designs, shapes, and packaging pose the same issues. See, e.g., *In re Luxuria s.r.o.*, 100 U.S.P.Q.2d (BNA) 1146 (T.T.A.B. 2011) (finding a mark consisting of a bottle in the shape of a hand with middle finger extended upwards scandalous).

⁵⁰ Apparently, the Catholic Church denounced this ad when it ran in the 1970s in Italy. See Jacob Gershman, *If You Take These Jeans' Name in Vain, Prepare to Meet Their Maker: Italian Apparel Company Registered 'Jesus' as Trademark, Protects It Devoutly*, WALL ST. J., Feb. 24, 2013, available at <http://online.wsj.com/news/articles/SB10001424127887324432004578302060560501092>.

⁵¹ *Id.*

⁵² See *Twentieth Century Fox v S. Austl. Brewing Co.* [1996] 66 FCR 451.

literature suggests that the use of humor in advertising not only enhances the attention the brand receives, but also enhances purchase intention.⁵³ And so we see marketing campaigns with quirky humor that do not even advertise the product or service in any traditional way. For example, the College Humor ad for Vitamin Water, which is one of the top five most viewed ads of 2013, never mentions or depicts the product or category of goods it is promoting.⁵⁴ A related phenomenon is “gonzo marketing.” As with gonzo journalism, which involves the reporter becoming part of the story,⁵⁵ gonzo marketing likewise involves marketers seemingly conversing with their markets rather than talking at them in the traditional one-sided manner. The two also have in common the characteristics of humor and bad taste. Gonzo implies shock value. An example is the Maxi Pad video that responds to a man’s Facebook rant, which of course went viral.⁵⁶

Sex sells. The use of sex in marketing is as old as the campaigns dreamed up by the ad men epitomized by Don Draper. It has long been assumed that sex is used as a device to cause consumers to stop, look, and listen, or at least notice specific messages in the context of media clutter. And while advertisers are upping the ante, they do so based on marketing research that suggests that younger audiences are less offended by sexually explicit messages. The FCUK mark for the brand French Connection is aimed at this group.⁵⁷ Because the FCUK trademark is controversial, it is an extremely successful marketing device.

IV. The Role of Morality in Trademark Law

A. The Impetus to Regulate Offensive Language

Due to the continued use of offensive trademarks, there have been other attempts to protect the public from the use of racist trademarks.

⁵³ Martin Eisend, *A Meta-Analysis of Humor in Advertising*, 37 J. ACAD. MARKETING SCI. 191, 192 (2009) (conducting a study that showed a positive correlation between the “funniness” of the ad and positive attitudes about the advertised brand).

⁵⁴ See College Humor, *Panhandler Pranks Entire Subway*, YOUTUBE (Aug. 5, 2013), available at <http://www.youtube.com/watch?v=QjFoDTPeX6U#t=80>.

⁵⁵ See Christopher Locke, *Fear and Loathing on the Web: “Gonzo” Marketing Thrives*, CNN, July 16, 1998, available at <http://www.cnn.com/TECH/computing/9807/16/gonzo.idg/> (quoting Hunter S. Thompson: “The writer must be a participant in the scene while he’s writing it.”).

⁵⁶ See Bodyform, *Bodyform Responds: The Truth*, YOUTUBE, Oct. 16, 2012, available at <http://www.youtube.com/watch?v=Bpy75q2DDow>; Tim Nudd, *See Maxipad Maker Bodyform’s Brilliant Reply to a Man’s Facebook Rant: Blunt Apology for Years of False Advertising*, ADWEEK (Oct. 16, 2012), available at <http://www.adweek.com/adfreak/maxipad-brand-goes-blood-brilliant-reply-facebook-rant-144500>.

⁵⁷ FCUK, U.S. Registration No. 4,167,152 (for retail stores featuring clothing, watches, and eyewear).

Sometimes these regulations come not from the trademark office, and are not even part of trademark law. For example, at roughly the same time that the first cancellation petition against the REDSKINS trademarks was filed, another trademark offensive to Native Americans was receiving negative public attention. The Hornell Brewing Company had begun selling a malt liquor under the name "Crazy Horse."⁵⁸ Crazy Horse was a revered Native American leader who strongly believed that use of alcohol would destroy Native American communities. Due to the deep offense caused by this trademark, and to Hornell's unwillingness to change the name, Congress enacted a law to address this specific problem:

Upon the date of enactment of this Act, the Bureau of Alcohol, Tobacco, and Firearms (ATF) shall deny any application for a certificate of label approval, including a certificate of label approval already issued, which authorizes the use of the name Crazy Horse on any distilled spirit, wine, or malt beverage product.⁵⁹

The public outcry over Crazy Horse followed a similar episode over the restaurant chain called "Sambo's." Sambo's was a national family restaurant chain with over 1,000 outlets nationwide. Although the name had been in use since its founding in 1957, it began to fall into disfavor because "sambo" is a derogatory reference to African Americans. In the 1970s, a number of municipalities, such as Ann Arbor, Michigan and Toledo, Ohio, prohibited the use of the racially offensive business name by refusing to issue sign permits and through other measures.⁶⁰ In the cases of both CRAZY HORSE and SAMBO'S trademarks, the attempts to regulate the use — as opposed to the registration — of racist trademarks were each held to be unconstitutional restraints on First Amendment speech rights.⁶¹

Protecting the public from offensive language is a policy goal difficult to achieve while maintaining strong free speech principles. Numerous regulations attempt to protect the public from offensive speech, but every attempt to censor speech based on its content will be subject to the First Amendment. Some regulations, like the attempts to ban the racist trademarks discussed previously, have been held to violate the First Amendment. Other regulations of offensive speech have survived a First Amendment challenge, such as the Federal Communications

⁵⁸ *Hornell Brewing Co. v. Brady*, 819 F. Supp. 1227 (E.D.N.Y. 1993) (finding a First Amendment violation).

⁵⁹ Treasury, Postal Service, and General Government Appropriations Act, 1993, Pub. L. No. 102-393, § 633 (1993).

⁶⁰ *Sambo's Restaurants, Inc. v. Ann Arbor*, 663 F.2d 686 (6th Cir. 1981); *Sambo's of Ohio, Inc. v. City Council of Toledo*, 466 F. Supp. 177 (N.D. Ohio 1979).

⁶¹ *Sambo's of Ohio, Inc. v. City Council of Toledo*, 466 F. Supp. 177 (N.D. Ohio 1979) (holding unconstitutional the City of Toledo's revocation of permits to display the name Sambo's on the premises of a restaurant).

Commission's ban on "obscene," "indecent," and "profane" language in broadcasting⁶² and various states' bans on offensive or profane vanity license plates.⁶³ Still other prohibitions of offensive speech have not been the subject of litigation. For instance, some states prohibit non-profits from adopting offensive corporate names,⁶⁴ while the Internet Corporation for Assigned Names and Numbers (ICANN) recently proscribed applications for new generic top-level domains (TLDs) that are immoral or contrary to public order.⁶⁵

In all of these examples, regulators risk charges of censorship and its attendant problems in order that they might protect the public from being injured by offensive words. These attempts to regulate offensive language demonstrate an overriding concern that the public can be injured by certain language. Moreover, these policies, in addition to protecting a minority from the offensive material, are also aimed at promoting inclusiveness.

B. *A Common Feature of Trademark Law*

Many are surprised when they learn that the Lanham Act has a provision that regulates the offensiveness of trademarks. U.S. federal trademark law, however, is not unique in prohibiting the registration of offensive trademarks. Many countries' trademark laws contain similar

⁶² 18 U.S.C. § 1464 (2014). This regulation was upheld as constitutional by the Supreme Court in 1978. See *FCC v. Pacifica Found.*, 438 U.S. 726 (1978). Since this decision, the USPTO has registered numerous marks containing each of the words banned by the FCC. See Reagan Smith, *Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks*, 42 HARV. C.R.-C.L. L. REV. 451, 452 (2007).

⁶³ Generally courts have found that states have a valid purpose in prohibiting vanity license plates that are offensive, profane, or make reference to drugs or alcohol. See Jack Achiezter Guggenheim & Jed M. Silversmith, *Confederate License Plates at the Constitutional Crossroads: Vanity Plates, Special Registration Organization Plates, Bumper Stickers, Viewpoints, Vulgarity, and the First Amendment particularly whether this exclude from patentability inventions*, 54 U. MIAMI L. REV. 563, 568 (2000); see, e.g., *Higgins v. Driver & Motor Vehicle Servs. Branch*, 335 Or. 481 (Or. 2003) (affirming administrative ruling that denied vanity license plate with the words WINE, INVINO, and VINO).

⁶⁴ Some states will disqualify a nonprofit organization from receiving a tax-exempt status for use of offensive words in their corporate names. See, e.g., N.Y. Not-for-Profit Corp. Law § 301(a)(8) (McKinney 2012) (This statute is currently being revised).

⁶⁵ ICANN, *gTLD Applicant Guidebook* 1-42, 3-4, 3-6 (June 4, 2012) (prohibiting new top-level domains that are "contrary to generally accepted legal norms relating to morality and public order that are recognized under international principles of law"), available at <http://newgtlds.icann.org/en/applicants/agn/guidebook-full-04jun12-en.pdf>. This restriction is not imposed by any government, but is the policy of ICANN, who is in the process of delegating numerous new TLDs. See Griffin M. Barnett, *ICANN Standards for Morality and the New gTLDs: A Comparative Analysis of Morality in International Trademark Law in the Internet Age*, 103 TRADEMARK REP. 1214 (2013).

provisions.⁶⁶ Indeed, international treaties such as the Paris Convention for the Protection of Industrial Property (Paris Convention) administered by the World Intellectual Property Organization (WIPO) contain provisions that anticipate the prohibition of trademarks that are contrary to morality or public order.⁶⁷ This provision dates back to 1883 and was at that time the only ground for refusal or invalidation of a trademark in the treaty.⁶⁸

Most other countries' trademark acts refer to "morality" and "public order" as a bar for trademark registration.⁶⁹ European trademark law has adopted precisely this standard.⁷⁰ Although the Lanham Act refers to morality, it does not refer to public order and it is not clear why U.S. law has taken a different tact on this regulation. Despite a difference in statutory language, most countries have similarly addressed the issues inherent in dealing with offensive trademarks.

Furthermore, most state trademark acts have enacted prohibitions that mirror the language of Section 2(a).⁷¹ The Model State Trademark Bill similarly denies registration to offensive marks.⁷² The common law may also decline to extend protection to marks that are deemed offensive.⁷³

⁶⁶ United Kingdom Trade Marks Act, 1994, c. 26, § 3(3)(a) ("A trade mark shall not be registered if it is – (a) contrary to public policy or to accepted principles of morality"). Although 9(1)(f) of the Canadian Trade-Marks Act is similar, it "has received little attention by the courts in Canada." TERESA SCASSA, CANADIAN TRADEMARK LAW 154 (2010). New Zealand's Trademarks Act in Section 17(1)(c) requires a trademark to be rejected if the use or registration of the mark would likely "offend a significant section of the community." New Zealand also has a separate provision that prohibits the registration of trademarks that disparage the Māori. See Paul Sumpter, *Intellectual Property Law and the New Morality*, 11 N.Z. BUS. L.Q. 216 (May 2005).

⁶⁷ Paris Convention for the Protection of Industrial Property, art. 6 *quinquies*, Mar. 20, 1883, 21 U.S.T. 1583, 828 U.N.T.S. 305 (stating that a trademark can be denied registration if it is contrary to public order or morality).

⁶⁸ G. H. C. BODENHAUSEN, GUIDE TO THE APPLICATION OF THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY 114 (1968).

⁶⁹ See Council Regulation 40/94, art. 7(1)(f), 1993 O.J. (L 11) 1, 4 (EC) (mandating that "trade marks which are contrary to public policy or to accepted principles of morality" not be registered).

⁷⁰ See *id.* ("The following shall not be registered ... (f) trade marks which are contrary to public policy or to accepted principles of morality").

⁷¹ Anne Gilson LaLonde, *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*, 101 TRADEMARK REP. 1476 (2011).

⁷² Model State Trademark Bill § 2 (1964) (reprinted in 3 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 22:8 (4th ed. 1998)).

⁷³ See Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661, 793–94 (1993).

V. Understanding the Impact of Section 2(a) of the Lanham Act

A. *Beyond Disparaging: Other Offenses Addressed under the Lanham Act*

In addition to disparaging trademarks, the registration of marks that are deemed “immoral” or “scandalous” are also barred from registration. Under Section 2(a) of the Lanham Act, the trademark office must refuse the registration of any mark if it contains any of several itemized types of matter including “immoral, . . . or scandalous matter; or matter which may disparage . . . persons, living or dead, institutions, beliefs or national symbols, or bring them into contempt, or disrepute.”⁷⁴

While we tend to think of the disparagement clause as protecting subjugated groups from marks that perpetuate discrimination, the immoral and scandalous bars as well as the “bring them into contempt” language broadens the protection against offensive trademarks. These terms taken together can be thought of as indicting a category of words that cause grave offense to the public that is of a non-commercial nature. As a result of Section 2(a), the trademark office must screen racist marks, such as KNIGGA,⁷⁵ misogynistic marks, such as GET IN THE KITCHEN BIT@HES!,⁷⁶ and marks that offend religious and ethnic minorities such as KHORAN for wine.⁷⁷

Many of the marks that cause offense to religious groups have been dealt with under the scandalous bar. Thus, the marks MADONNA for wine,⁷⁸ MESSIAS for wine and brandy,⁷⁹ BUDDHA BEACHWARE for apparel,⁸⁰ SENUSSI for tobacco,⁸¹ and MOONIES for dolls that

⁷⁴ See 15 U.S.C. § 1052(a), *supra* note 1.

⁷⁵ U.S. Trademark Application Serial No. 76,639,548.

⁷⁶ BITCHES, Registration No. 4,406,626 (for food mixers and whisks).

⁷⁷ Apparently, the word “Khoran” is Armenian for “altar,” which is why a company sought to register the mark “Khoran” for wine in the United States. See *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215 (T.T.A.B. 2010). But should such a trademark be registered by the U.S. government when it, being phonetically equivalent to the sacred text of Islam, may offend Muslims when used to denote an alcoholic beverage?

⁷⁸ *In re Riverbank Canning Co.*, 95 F.2d 327 (25 C.C.P.A. 1028) (declining to approve registration for the commercial use of the Virgin Mary’s name on wine bottles because it would be “shocking” to many people).

⁷⁹ IL MESSIA, Registration No. 4,093,035.

⁸⁰ *In re Hines*, 31 U.S.P.Q. 2d 1685, 1687 (T.T.A.B 1994) (allowing the mark BUDDA BEACHWEAR because there was insufficient evidence to demonstrate that a substantial composite of Buddhist would be offended by the mark in the context of clothing).

⁸¹ *In re Reemtsma Cigarettenfabriken G.M.B.H.*, 122 U.S.P.Q. (BNA) 339 (T.T.A.B. 1959).

drop their pants⁸² were all analyzed not under the disparagement clause, but under the standard for scandalous marks. In 2010, the TTAB, in a case involving the mark KHORAN for wine, explicitly addressed this situation and suggested that the disparaging bar was more appropriate for religious marks.⁸³ Recently, for instance, the registration of the mark STOP THE ISLAMATION OF AMERICA was refused under Section 2(a) because it was disparaging to Muslims in the United States.⁸⁴

In addition to marks that offend religions, misogynistic marks have also tended to be dealt with under the scandalous bar. Thus marks such as ONLY A BREAST IN THE MOUTH IS BETTER THAN A LEG IN THE HAND for restaurant services⁸⁵ and BLACK TAIL for “an adult entertainment magazine featuring photographs of both naked and scantily-clad African-American women”⁸⁶ were analyzed not as disparaging to women, but as scandalous.

These statutory descriptions – “immoral,” “scandalous,” and “may disparage” – have produced not one, not three, but oddly two separate doctrines. Although “immoral” and “scandalous” are different words, which would ordinarily result in statutory interpretation that affords each word a separate meaning, case law has combined the two words into the same category.⁸⁷ “Scandalous” means shocking to the sense of propriety; offensive to the conscience or moral feeling; or calling out for condemnation.⁸⁸ Scandalous has also been held to include that which is “vulgar,” or “lacking in taste, indelicate, morally crude.”⁸⁹ The standard for refusing “scandalous” or “immoral” marks under Section 2(a) is tested against the perceptions of a substantial composite of the general public. This standard is in contrast to the disparagement doctrine, which significantly tests the mark against the perceptions of the targeted group.

⁸² *In re In Over Our Heads, Inc.*, 16 U.S.P.Q. 2d (BNA) 1653 (T.T.A.B. 1990) (allowing registration of the mark MOONIES because it did not disparage Reverend Sun Myung Moon, referring rather to dolls that “mooned” or dropped their pants).

⁸³ *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215, 1216 (T.T.A.B. 2010) (denying the mark because it would disparage a substantial composite of Muslims).

⁸⁴ *In re Geller*, 2013-1412, 2014 WL 1887661 (Fed. Cir. May 13, 2014) (affirming the TTAB’s decision to refuse registration, recognizing that the “majority of Muslims are not terrorists and [would be] offended by being associated as such.”).

⁸⁵ *Bromberg v. Carmel Self Service, Inc.*, 198 U.S.P.Q. (BNA) 176 (T.T.A.B. 1978).

⁸⁶ *In re Mavety Media Group Ltd.*, 33 F.3d 1367 (Fed. Cir. 1994).

⁸⁷ See *In re McGinley*, 660 F.2d 481, 484 n.6, 211 U.S.P.Q. (BNA) 668, 673 n.6 (C.C.P.A. 1981), aff’g 206 U.S.P.Q. 753 (T.T.A.B. 1979) (holding it unnecessary to evaluate whether a mark was immoral after the court found it to be scandalous).

⁸⁸ *McGinley*, 660 F.2d at 486, 211 U.S.P.Q. at 673.

⁸⁹ *In re Runsdorf*, 171 U.S.P.Q. (BNA) 443, 444 (T.T.A.B. 1971).

Section 2(a) requires the trademark office to screen the content of the marks and determine the meaning of words in order to protect the public from harmful marks. The trademark examining attorney may cite evidence derived from dictionaries and news articles.⁹⁰ And in that sense it is no different from many other trademark determinations. In addition to the harm being non-commercial, the only difference is that the words whose meanings are at issue tend to affect different groups of people differently. And therein lies the controversy.

B. Burdens on Challengers

Whereas a challenge to an offensive mark could be as straightforward as opening a dictionary to determine whether a mark is immoral, scandalous, or disparaging, instead U.S. law has developed in such a way as to throw many significant hurdles before challengers.⁹¹ For instance, the test for disparagement was declared as involving two steps. First, one must determine the likely meaning of the trademark – taking into account not only dictionary definition, but also any figurative elements of the trademark, the nature of the goods or services associated with the trademark, and the manner in which the trademark is used in the marketplace. Second, there should be evidence that the trademark’s meaning is more likely than not disparaging to a substantial composite of the referenced group.⁹² Thus, in order to ultimately succeed in cancelling the REDSKIN registrations, the appeals court must be satisfied that the Native American challengers have presented sufficient evidence⁹³ that a substantial composite of Native Americans regard the term REDSKINS as disparaging when used as a trademark by the football team.⁹⁴

⁹⁰ TMEP (5th ed. Sept. 2007) § 1203.01. (In order to refuse a mark under § 2(a) grounds, a trademark examining attorney must offer evidence that a substantial section of the public would consider the mark offensive. This evidence can be in the form of dictionary definitions, newspaper articles, or magazine articles).

⁹¹ See Christine Haight Farley, *Stabilizing Morality in Trademark Law*, 63 AM. U. L. REV. 101 (2014).

⁹² *In re Geller*, 2013-1412, 2014 WL 1887661, *1, 10 (Fed. Cir. May 13, 2014) (quoting *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d at 1217).

⁹³ See 15 U.S.C. § 1071(b) (Appeals to federal district courts are not appeals of record, meaning parties can bring additional claims or evidence that were either not submitted during the PTO’s review or were not allowed under the TTAB’s jurisdiction).

⁹⁴ *Harjo v. Pro Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705 (T.T.A.B. 1999), *rev’d*, 284 F. Supp. 2d 96, 68 U.S.P.Q.2d 1225 (D.D.C. 2003), *remanded*, 415 F.3d 44, 75 U.S.P.Q.2d 1525 (D.C. Cir. 2005); see also *In re Geller*, 2013-1412, 2014 WL 1887661 at *10 (determining that the word “STOP” in connection with the religious meaning of “Islamation” conveys a negative tone and suggests that the conversion to Islam is “undesirable.”).

Within this test, a couple of significant policy choices were made. Two in particular will frustrate challengers of offensive marks and confound the courts that decide these cases.⁹⁵ First, the relevant sector of the public whose offense must be gauged was determined to be the referenced group. Thus, surveys of the general public will not be relevant. If the entire public is affected by the mark, as psychological evidence has demonstrated, why then only focus on the targeted group? This rule creates a burden on minority groups to raise the objection and explain the harm from a minority perspective, but in a way that the majority can understand.

Second, it was determined that the allegedly disparaging content must be evaluated in the context of the mark's use. Therefore, the question is not what the meaning of "redskin" is, but instead what the meaning is in the context of its use as a professional football team name.

Most likely in an attempt to be as circumscribed as possible, Congressman Faleomavaega's bill to prohibit the registration of the word "redskins"⁹⁶ also adopts a highly contextualized evaluation of the allegedly disparaging mark. The broad pronouncement of a presumption of disparagement is qualified by the need to be used with references to or images of Native Americans, or the need to be used in a way that is commonly understood to refer to Native Americans. This formulation thus permits the registration of REDSKINS for use with redskin potatoes.⁹⁷ Other than being explicitly directed to marks containing the word "redskin," this legislation then does little to change the current rules. What it does do is predetermine that a racial reference containing the word "redskin" is per se disparaging. This legislation, if passed, would then present a path to success for the challengers of the REDSKINS mark. For other groups disparaged by racially insulting marks, it would do nothing.

C. *A Limited Remedy*

Like other jurisdictions, U.S. trademark law only seeks to regulate the registration of offensive trademarks and is not so ambitious in attempting to regulate the use of offensive trademarks. This policy means that a

⁹⁵ Another determination was made that the requisite level offense must be perceived by a "substantial composite." This is clearly a quantitative assessment, and although it is not clear what the threshold percentage is, it is likely more than merely "some."

⁹⁶ See Non-Disparagement Act, *supra* note 17.

⁹⁷ There is an application for WASHINGTON REDSKIN POTATOES, U.S. Trademark Application Serial No. 86,092,137 (filed Oct. 15, 2013), but for entertainment services, mainly in the form of football contests.

trademark deemed offensive and therefore denied registration can still legally be used in the marketplace. Therefore, if the Native Americans are victorious in their case against the football team, the only legal result would be the cancellation of the registrations of the REDSKINS trademark. The team, however, would still be legally entitled to continue their use of the mark in commerce without interference. Such results prove that these trademark laws are a very limited regulation of offensive speech.

In fact, trademarks deemed too immoral, scandalous, or disparaging to be registered may still be protected by the Lanham Act as common law trademarks if they have been used as source indicators in commerce. So not only does U.S. trademark law fail to prohibit the use of offensive trademarks, but they may still be protected in U.S. courts as common law trademarks. It remains an open question whether an offensive mark whose registration has been cancelled under Section 2(a) will be protected as a common law mark. No case has yet addressed this issue.⁹⁸

The only case to directly address the constitutionality of Section 2(a) held that the provision does not violate the First Amendment because no conduct is proscribed and no tangible form of expression is suppressed.⁹⁹ Thus, Section 2(a) may be constitutional only because it is directed only at registration, and not use.

The sine qua non of U.S. trademark law is that trademark rights derive from use, not registration. Registration merely provides extra federal benefits.¹⁰⁰ The registration of a trademark is a federally granted benefit; it is not a constitutionally enshrined right. Trademarks containing offensive terms should not enjoy the benefits of federal registration. Significant benefits flow from the issuance of a trademark registration from the USPTO. The benefits of registration include nationwide constructive notice, original jurisdiction in federal courts, the presumption of validity of the mark, the possibility of incontestable status, border measures, attorneys' fees and costs, and statutory damages.¹⁰¹ These benefits, once conferred by the trademark office, may actually be granted by other government actors such as agencies and federal courts.¹⁰² For these reasons,

⁹⁸ Baird has addressed the question of whether a scandalous, immoral, or disparaging mark may nevertheless receive protection under Section 43(a) and has concluded that protection will likely be denied based on public policy reasons. Baird, *supra* note 73, at 661.

⁹⁹ *In re McGinley*, 660 F.2d 484, 84-85, 211 U.S.P.Q. (BNA) 668, 672 (1981).

¹⁰⁰ See 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:1.75 (4th ed. 1998).

¹⁰¹ See *What are the Benefits of Federal Trademark Registration?*, USPTO, Apr. 23, 2013, available at http://www.uspto.gov/faq/trademarks.jsp#_Toc275426681.

¹⁰² See Jennifer Ward, *Trademarks 101*, 15 UTAH BAR J. (2D SER.) 18, 20 (Apr. 2002).

by granting these trademarks federal registration, the government is putting its imprimatur on the offensive trademark.

If these trademark doctrines do not prohibit the use of offensive trademarks, then what impact, if any, do they have? Surely the Native Americans who challenged the REDSKINS trademark would prefer to ban the use of the trademark rather than to just ban the registration of the trademark. Nonetheless, the registration of a trademark by a national government has the symbolic effect of the government giving its stamp of approval to the trademark. Obviously, if that trademark deeply offends a minority, it may appear that the government condones the use of such offensive language.¹⁰³ Therefore, this legal restriction provides governments with an opportunity to refuse to lend the support of the administration to those trademarks that offend the public. Merchants should take heed and consumers should take notice of the determinations made under Section 2(a). Thus the government can perform important signaling for civility without abridging the freedom of speech.

One would expect a correlation between being granted a registration and going into business with the mark. Perhaps businesses use the standards applied by the trademark office as a guide for appropriateness in the marketplace. Relatedly, the public may react differently to offensive marks when they learn that the trademark office has issued a registration and thus deemed them acceptable. If these speculations are well founded, the impact of these determinations goes well beyond its effect on the registry.

What would happen if the Native American challengers won their case? Would Pro-Football change their team name? They have said they would not and the law would not require them to. It is possible that Pro-Football could maintain common law trademark rights in the canceled marks. That is, were Pro-Football to lose its registration, the team might still be able to enforce its common law trademark rights against anyone who would infringe its mark. As noted, this question has not yet been addressed by any court. On the one hand, a court faced with this issue may refuse to grant an injunction on behalf of a party who comes to court with a mark that has been declared to be disparaging. On the other hand, the constitutionality of Section 2(a) has been defended on the basis that this content restriction does not affect the use of the mark.¹⁰⁴

¹⁰³ In *In re Old Glory Condom Corp.*, the T.T.A.B. stated that the registration of a trademark is not necessarily a government endorsement of the mark. 26 U.S.P.Q.2d (BNA) 1216, 1220 n.3 (T.T.A.B. 1993).

¹⁰⁴ See *In re McGinley*, 660 F.2d 481, 211 U.S.P.Q. (BNA) 668 (C.C.P.A. 1981), *aff'd* 206 U.S.P.Q. 753 (T.T.A.B. 1979).

Thus, after years of litigation, it is possible that the Native American challengers will have won the lawsuit, but failed to effect any change in the use of the mark. This case then starkly advances the question of whether the provision makes good policy. For if minority groups are injured by the use of trademark in the way that the amici have suggested,¹⁰⁵ and the only remedy provided by trademark law is cancellation of the registration of the trademark, then the effort and expense of challenging the trademark may have been wasted. Alternatively, the symbolic gesture of the federal government cancelling the registration of a trademark on the basis that it disparages people may be significant and affect the way society views the mark.

VI. The Policy Justifications for Content Restrictions in Trademark Law

Although there is not much in the legislative record of Section 2(a) that is particularly revealing in terms of indicating Congress's larger purpose in enacting this provision,¹⁰⁶ the language of the section itself makes its objective reasonably clear. It appears that the objective is simply to ban offensive words from the trademark registry. Again, the refusal of registration does not affect the continued use of the mark in commerce; it only affects the benefits of registration.¹⁰⁷

It has been suggested that the justifications for imposing this content restriction on trademark registrations are the following: (1) the federal government should protect the public from offensive trademarks; (2) the federal government should discourage the use of offensive trademarks; (3) the federal government should not squander its time and resources on offensive trademarks; and (4) the federal government should not create the appearance that it approves the use of such

¹⁰⁵ See Brief, *supra* note 22, and accompanying text.

¹⁰⁶ The prohibition against the registration of marks that consist of or comprise immoral or scandalous matter was originally enacted as §5(a) of the Trademark Act of 1905, and was reenacted as part of §2(a) of the Act of 1946. For legislative history, see *Hearings on H.R. 9041 Before the Subcomm. on Trademarks of the House Comm. on Patents, 75th Cong.* 79–113 (1938); Baird, *supra* note 73.

¹⁰⁷ The benefits of registration on the principal register include nationwide priority, constructive notice of the registrant's claim of ownership in the mark, prima facie evidence of the mark's validity, ownership of the mark, the registrant's exclusive right to use the mark in connection with the products and services for which it is registered, a basis for obtaining trademark registrations in foreign countries, a deterrent for others interested in adopting similar marks, the ability to register the mark with customs to prevent importation of infringing products, incontestability status, access to certain statutory remedies (i.e., treble damages), costs, and attorney's fees, and the right to use the ® symbol.

trademarks.¹⁰⁸ The *Redskins* case, the most litigated and most scrutinized case brought under Section 2(a), provides a useful context to measure these policy goals.

Analyzing these justifications in order, we see first that the federal government in fact has a very limited ability to protect the public from offensive trademarks. Since the public generally does not come into contact with the trademark registry, whether or not a trademark is listed there does not threaten to injure the public. And since Section 2(a) does not permit the federal government to prohibit the use of offensive trademarks, it can do little to protect the public from being injured by such marks. The public ought not to be confronted by trademarks that disturb, abuse, insult, or threaten them, but this provision offers no shield.

The second policy justification for Section 2(a) is that it discourages the use of offensive trademarks. Ideally, trademark applicants would consider the benefits of registration when deciding on a trademark, and would steer clear from offensive trademarks, at least out of concern that they would only receive common law protection. The trouble with this policy objective is that it has proven to be difficult to predict which trademarks will be barred registration under Section 2(a).¹⁰⁹ In a large number of cases, the same word has been both registered and denied registration.¹¹⁰ For instance, although REDSKINS was registered for a football team, it was denied registration for pork rinds.¹¹¹ Likewise, SQUAW was registered for ski equipment,¹¹² but denied for apparel,¹¹³ HEEB was registered for magazines,¹¹⁴ but denied for clothing,¹¹⁵ SLANT was registered for food serving ware,¹¹⁶ but THE SLANTS was denied for a band.¹¹⁷

The third justification is that the federal government should not expend its time and resources on offensive trademarks. Since the trademark office

¹⁰⁸ See Megan M. Carpenter & Kathryn T. Murphy, *Calling Bulls**t on the Lanham Act: The 2(a) Bar for Immoral, Scandalous, and Disparaging Marks*, 49 U. LOUISVILLE L. REV. 465 (2011).

¹⁰⁹ See Farley, *supra* note 91.

¹¹⁰ For a critique of how the Trademark Office applies Section 2(a) in a manner that leads to inconsistent results see Farley, *supra* note 91.

¹¹¹ U.S. Trademark Application Serial No. 86,052,159 (filed Aug. 30, 2013).

¹¹² SQUAW, Registration No. 3,322,061.

¹¹³ *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d (BNA) 1264 (T.T.A.B. 2006) (precedential).

¹¹⁴ HEEB, Registration No. 2,858,011 (for the publication of magazines).

¹¹⁵ U.S. Trademark Application Serial No. 78,558,043 (filed Feb. 1, 2005) (for clothing, namely jackets, jerseys, sweat pants, sweat shirts, track suits, t-shirts, tank tops, and pants; headwear).

¹¹⁶ SLANT, Registration No. 3,437,230 (for serving ware for food).

¹¹⁷ *In re Simon Shiao Tam*, 108 U.S.P.Q.2d (BNA) 1305 (T.T.A.B. 2013) (precedential).

must review every application under all of the prohibitions in Section 2, any wasted time and resources must be measured after the registration determination has been made. In the case of the REDSKINS trademarks, in addition to publishing the trademark for opposition, and then again as a registered trademark, the trademark office has had to be involved with all of the maintenance filings associated with these registrations, including the filing of specimens, Section 8 affidavits, Section 15 affidavits, and renewals. In addition, the TTAB has been involved in the *inter partes* proceeding for years. Had the trademarks been refused registration, the TTAB may have had to hear an appeal of the examiner's rejection. Even if this appeal would have been brought, it presumably would have been a smaller matter than the full litigation that it has experienced. The result is a prime example of how the federal government has expended significant resources on an offensive trademark.

Finally and most significantly, we come to the question of whether by permitting the registration of an offensive trademark the federal government creates the appearance that it approves of such marks. It is on this point that the *Redskins* case offers the greatest insight. Native Americans have sought to persuade Pro-Football to abandon the REDSKINS trademark ever since it was registered. They have sought to do this through private meetings with team management, as well as in public opinion shaping campaigns.¹¹⁸ Unfortunately, these efforts have had little, if any, impact. It was not until publicity about the cancellation proceeding emerged that momentum began to form around this effort. It was thus important that first, there was a legal ground upon which to challenge the mark and second, there was a legal standard of protection for disparaged groups. These two principles have enabled this issue to capture public interest and to maintain a public debate about the appropriateness of these trademarks. The law may not require Pro-Football to change its name, but the public may eventually demand it. Should the federal government ultimately cancel the REDSKINS marks, it will send a strong message that it does not approve of such hateful marks. This indicia of difference would no longer be legally recognized by the federal government. This result would be a victory for the trademark challengers that would be worth all these years of litigation.

¹¹⁸ For instance, in 1972, a delegation of Native American leaders including the president of the National Congress of American Indians met with then-Redskins owner Edward Bennett Williams, urging him to change the name. See Robert McCartney, *How Many Indians Must Feel Disparaged to Strip 'Redskins' Trademark Protection*, WASH. POST LOCAL, Mar. 9, 2013, available at http://www.washingtonpost.com/local/how-many-indians-must-feel-disparaged-to-strip-redskins-trademark-protection/2013/03/09/35cd90f0-8846-11e2-999e-5f8e0410cb9d_story.html.

VII. Conclusion

A trademark registration can be challenged as being immoral, scandalous, or disparaging by members of the public. But it is quite an arduous undertaking for a group of private citizens to mount a challenge to an offensive trademark. For this reason, many countries' trademark laws permit trademark examiners to refuse registration of offensive marks on their own. The exclusionary impact of disparaging language must become an issue for all members of the community and not a special burden for the stigmatized group.

As a society, we owe a debt of gratitude to those who mount such challenges. In many cases of offensive trademarks, the trademark may deeply offend a minority, while the majority may be insensitive to or unaware of the offense. These challenges become opportunities for all of us to improve our awareness of cultural sensitivities. And this has certainly been the case in the REDSKINS dispute.

For decades, indigenous peoples have fought to protect themselves from the public humiliation and discrimination associated with racial slurs such as "redskin." The use of the word is hurtful and insulting to our nation's first inhabitants and their descendants. Racist trademarks tear at the fabric of society by promoting negative stereotypes of minority groups. There is a strong public interest in eliminating damaging stereotypes and stigmatization. The social costs to the public at large are huge and include reinforcing hateful and erroneous stereotypes and misinformation about our fellow citizens. The psychological harms of such racialized representations impact not only the referenced group but also society as a whole. The public acceptance of hateful language against one group suggests tolerance of other hateful language and treatment toward other groups.

In these larger issues of racial identity, civility, and community, obviously trademark law plays a very minor role. But as some of these disputes – such as the REDSKINS dispute – demonstrate, on occasion this small role can be an important one.