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TO LIVE IN IN-“FAME”-Y:  
RECONCEIVING SCANDALOUS MARKS AS  
ANALOGOUS TO FAMOUS MARKS

JASMINE ABDEL-KHALIK\*

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## I. INTRODUCTION

“He is not dead who departs from life with a high and noble fame; but he is dead, even while living, whose brow is branded with infamy.”—Ludwig Tieck

A line easily crossed is that between fame, meaning “widespread reputation . . . renown . . . [or] public eminence,” and infamy, meaning “evil reputation, public reproach, or strong condemnation as the result of a shameful, criminal, or outrageous act.”<sup>1</sup> Both fame and infamy arise from public perception, but, as Tieck suggested, a wide chasm exists between the consequences of fame and those of infamy. Congress must agree with Tieck’s sentiment because it has recently accorded famous marks a greater than average “life” that extends beyond the specific goods or services associated with the mark.<sup>2</sup> On the other hand, scandalous and immoral (or infamous) marks, while purportedly entitled to common law protection, are essentially “dead” in the federal trademark registration scheme because they are barred from receiving a federal trademark registration and all the protections and benefits encompassed therein.<sup>3</sup> The connection between these two types of marks has never been explored. However, drawing parallels between famous marks and marks that may be scandalous or immoral suggests a new, two-tiered approach in identifying scandalous and immoral marks that will more appropriately frame the registration prohibition’s scope and create greater consistency in its application.<sup>4</sup>

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<sup>1</sup> WEBSTER’S ENCYCLOPEDIA UNABRIDGED DICTIONARY OF THE ENGLISH LANGUAGE 513, 728 (revised ed. 1994) [hereinafter WEBSTER’S].

<sup>2</sup> Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730 (codified at 15 U.S.C. § 1125(c) and other scattered sections (2006)).

For purposes of this article, I will be using “trademark” and “mark” interchangeably as encompassing trademarks, service marks, collective marks, or certification marks. *Cf.* WILLIAM HENRY BROWNE, A TREATISE ON THE LAW OF TRADE-MARKS AND ANALOGOUS SUBJECTS (FIRM-NAMES, BUSINESS-SIGNS, GOOD-WILL, LABELS, & C.) 63-68 (Boston, Little, Brown, and Co. 1873) [hereinafter BROWNE I].

<sup>3</sup> 15 U.S.C. § 1052(a) (2006).

<sup>4</sup> For purposes of this article, the prohibition on registering marks that consist of or comprise scandalous or immoral matter will be referred to as the “scandalous registration prohibition.” Additionally, I will refer to “scandalous marks” rather than marks that “consist[] of or comprise[] immoral . . . or scandalous matter.” *Id.*

Given the relatively few decisions interpreting scandalous marks, creating a more appropriate standard appears to focus on a minor conflict in trademark law. However, the problem is far greater than these few decisions indicate. At least one scholar estimates that the scandalous registration prohibition is used to reject hundreds of trademark applications each year, but because registrants appeal few of these rejections, only a few decisions are reported.<sup>5</sup> In recent years, many of these rejected applications likely are intent-to-use applications, meaning that the applicants have not spent time, money, or other significant resources in creating customer association and good-will between their products and the rejected marks. However, other applicants file their applications after using their marks in interstate commerce. For these applicants, rejection of their federal registration applications means that either they will have to abandon marks in which they have invested significant resources and customer goodwill, or they will continue to use their marks without receiving the protection of federal registration. Either option harms these owners. Creating a more consistent standard allows future applicants to predict with more accuracy whether they will be able to obtain federal registration for their marks and, presuming that this is the function of the prohibition, will guide them to use more “appropriate” marks.<sup>6</sup>

One justification for precluding registration of scandalous marks may be that such marks cannot fulfill the purpose of a mark, which is to identify that a product is generated from a single source and thereby distinguish the product from those generated by other sources.<sup>7</sup> Ask the residents of Scottsdale, Arizona, if vulgar terms can serve as a source-identifier, and they may not know what you are asking. If you ask them about the new Pink Taco restaurant, they are likely to express outrage at Harry Morton’s expansion of the Las Vegas restaurant into Scottsdale.<sup>8</sup> Although the Patent and Trademark Office (PTO) apparently is unaware of its meaning, the term “pink taco” is a vulgar slang term

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<sup>5</sup> Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661, 676 (1993).

<sup>6</sup> Whether it is constitutional to guide trademark applicants towards “appropriate” speech is beyond the scope of this article. However, some have discussed whether such a channeling function violates First Amendment protections on freedom of speech. See, e.g., Michelle B. Lee, *Section 2(a) of the Lanham Act as a Restriction on Sports Team Names: Has Political Correctness Gone Too Far?*, 4 SPORTS LAW. J. 65, 71-74 (1997).

<sup>7</sup> FRANCIS H. UPTON, A TREATISE ON THE LAW OF TRADE MARKS, WITH A DIGEST AND REVIEW OF THE ENGLISH AND AMERICAN AUTHORITIES 51-52 (Albany, Weare C. Little 1860).

<sup>8</sup> See Lesley Wright, *Council Becomes Equal Opportunity Offender*, ARIZ. REPUBLIC, May 1, 2006, at 2.

for female genitalia.<sup>9</sup> Despite its “scandalous” nature, “pink taco” has obviously served as an excellent source identifier.

So if these scandalous and immoral marks can serve their semiotic function, one must consider why Congress has prohibited federal registration of such marks since 1905. One theory is that Congress implemented the prohibition under the influence of the restrictive moral precepts of 1905, indicating that the registration prohibition should hold little value in contemporary society. Alternatively, even if the purpose of including a scandalous registration prohibition is to regulate morality, one may question the value of such a prohibition. If the mark was truly offensive, then one may speculate that the general public would refuse to purchase the associated goods or services, which would eventually eliminate the mark from the marketplace. Regardless of one’s normative assessment of the prohibition, Congress has retained the scandalous registration prohibition for more than a century, even while amending other portions of the trademark registration system. Because the restriction is not likely to change, a host of secondary questions are raised regarding what should constitute a scandalous mark.

Under the current trademark registration act, a trademark cannot be registered if it “[c]onsists of or comprises immoral, deceptive, or scandalous matter.”<sup>10</sup> Because this prohibition affects a person’s statutory right to a trademark registration, it must comport with Fifth Amendment due process rights by being “sufficiently precise to enable the PTO and the courts to apply the law fairly and to notify a would-be registrant that the mark he adopts will not be granted a federal registration.”<sup>11</sup> However, Congress has never expressly provided a definition or standard for determining “immoral” or “scandalous” matter, leading courts to rely upon dictionary definitions to define and apply the

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<sup>9</sup> *Id.* The Patent and Trademark Office (PTO) issued three registrations to Morton for PINK TACO in 2000 and 2001 for: restaurant services, U.S. Trademark No. 2,418,093 (filed Sept. 24, 1998); beverage glassware, U.S. Trademark No. 2,376,167 (filed Mar. 22, 1999); and clothing, U.S. Trademark No. 2,400,891 (filed Feb. 18, 1999). When similar vulgar terms have been submitted for registration, the PTO has at least questioned whether they should be registered. Compare *In re Runsdorf*, 171 U.S.P.Q. (BNA) 443 (T.T.A.B. 1971) (finding BUBBY TRAP for brassieres scandalous) with *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470 (T.T.A.B. 1988) (finding BIG PECKER BRAND for clothing not to be scandalous). With respect to PINK TACO, it appears that the PTO did not raise the question.

<sup>10</sup> 15 U.S.C. § 1052(a) (2006). The relevant statutory language allows registration unless a mark “[c]onsists 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, or disrepute.” *Id.* This article will focus on the scandalous and immoral prohibition and will not address deceptiveness or disparagement.

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

parameters of “scandalousness.”<sup>12</sup> Unfortunately, such definitions merely cast the same ill-defined concept into new words rather than clarify how the prohibition should be applied.<sup>13</sup> To date, the search for a unified and consistent standard has proven less than successful, making it questionable whether the scandalous registration prohibition is sufficiently precise to give a trademark owner notice that his or her adopted mark will be barred from federal registration as scandalous or immoral.

Courts recognize that application of the scandalous registration prohibition is confusing and inconsistent. Part of the reason for this inconsistency is that societal standards change over time. Thus, “what was considered scandalous as a trademark or service mark twenty, thirty or fifty years ago may no longer be considered so, given the changes in societal attitudes. Marks once thought scandalous may now be thought merely humorous (or even quaint).”<sup>14</sup> While it is true that societal standards change, it is not true that there is no possibility of having consistency in the *standard* and its *application*, merely that, over decades, there may not be consistency in the *outcome*.

In comparison to the century-long prohibition on scandalous marks, Congress did not recognize famous marks until 1996. For purposes of receiving extra trademark protection akin to an absolute property right, a mark is considered famous when the public associates the mark with a single source (and single image) without reference to the associated goods and services.<sup>15</sup> Congress originally identified at least eight factors to determine if the mark has sufficient fame, which recently was reduced to four factors.<sup>16</sup> Regardless of the number, the factors detail different facets of three essential considerations: (1) whether the mark is the kind that can have a singular meaning for the general public regardless of the associated goods or services; (2) the public’s recognition of the mark’s singular meaning; and (3) the scale of the public’s understanding, or the level of fame, that the term has.

The recent elevation and clarification of famous marks raises the question of whether famous trademarks’ ugly stepsister, scandalous marks, could be determined by using factors that

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<sup>12</sup> See, e.g., *id.* at 485 n.10; see also *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938).

<sup>13</sup> “Despite the lack of legislative guidance, the courts and the Board have been fairly consistent in articulating a definition for the term. Any disparities arise in the application of the definition.” ANNE GILSON LALONDE, 1 TRADEMARK PROTECTION AND PRACTICE § 3.04[6][a][i][A] (2006).

<sup>14</sup> *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1219 (T.T.A.B. 1993).

<sup>15</sup> 15 U.S.C. § 1125(c)(2)(A).

<sup>16</sup> *Id.* § 1125(c)(1)(A)-(H) (2000), amended by Trademark Dilution Revision Act of 2006, 15 U.S.C. § 1125(c) (2006).

reflect the same or similar considerations. These considerations are informative if one considers *certain* scandalous and immoral marks as crossing the line between fame and infamy, namely, marks that are scandalous or immoral regardless of the associated goods or services.

Although no one has expressly explored this connection between famous and scandalous marks, others have hinted at it. Before Congress enacted the prohibition on the registration of scandalous trademarks, the Patent Office (now known as the PTO) considered an application for a mark consisting of a Masonic emblem for use on flour.<sup>17</sup> Initially, the PTO rejected the application because the Masonic emblem had world-wide recognition as being associated with the quasi-religious fraternity and, thus, could not serve as a source-identifier for the flour merchant.<sup>18</sup> The Masonic emblem would merely indicate to the public that the flour merchant was a Freemason. This decision may be an early example of the Patent Office rejecting an application because of fame—the “mark” had such a strong association with an existing entity that it was unavailable as a mark for another entity in a different field.<sup>19</sup>

On appeal, the Commissioner of Patents recognized the fame of the Masonic emblem as an important factor by questioning whether the Masonic “emblems are not to be regarded as its property, at least in such a sense, that no person can monopolize them as trade-mark devices.”<sup>20</sup> The Commissioner of Patents did not answer his own question regarding property rights. Rather, he rested his decision upon a ground similar to that of the PTO Examiner. The public would not only believe that the flour merchant was connected to the Mason fraternity, but such a connection would be a deception.<sup>21</sup> In discussing the public’s reaction to the Masonic mark in trade, the Commissioner noted the following:

Among masons with whom this token has a moral significance, its use in that capacity would undoubtedly be regarded as a base prostitution of it to mercenary purposes, while with others its

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<sup>17</sup> BROWNE I, *supra* note 2, at 238-42. Masonry is both a body of knowledge and a system of ethics based upon the idea that people must improve themselves while supporting “family, faith, country, and [the] fraternity.” Masons of California, Mission, [http://www.freemason.org/about\\_mission.php](http://www.freemason.org/about_mission.php) (last visited Feb. 23, 2007).

<sup>18</sup> BROWNE I, *supra* note 2, at 238-39.

<sup>19</sup> During this time period, trademark protection did not extend to service marks and, thus, would not have extended to the Masonic emblem. A prominent legal scholar of the time also scoffed at the idea that a religious entity could become a trading company and acquire trademarks. *Id.* at 37-38.

<sup>20</sup> *Id.* at 241 (reprinting the appellate decision).

<sup>21</sup> *Id.* at 241-42.

mystic force would often dissipate its virtues as a trade-mark, and perhaps in some instances place the article it appeared upon under a ban.<sup>22</sup>

In other words, using this famous “mark” for commerce would raise “strong condemnation”—or be scandalous—either because the merchant was commercializing an important moral philosophy or because the merchant was associated with a morally corrupt and depraved group, depending upon the individual’s perception of Freemasonry.<sup>23</sup>

As recognized by the PTO’s decision, there is a strong connection between fame and scandal (or infamy), and this connection suggests a clearer standard for the scandalous registration prohibition. Part II of this article discusses the evolution of the registration prohibition on scandalous marks. In particular, it will highlight previously unrecognized aspects of the common law and international law regimes which formed the legal landscape prior to, and significantly influenced, congressional enactment of the scandalous registration prohibition in 1905. Part III discusses the evolution of the scandalous registration prohibition through case law and suggests a classification system for the marks previously considered under the scandalous prohibition. Part IV discusses the proposed two-tiered test for evaluating whether a mark is scandalous or immoral. The first tier concerns *per se* scandalous marks, which are analogized to famous marks in that there is a singular image or meaning associated with the mark regardless of the associated goods or services. Moreover, these marks may be classified as famous—or infamous—based upon “niche” geographic regions within the United States. In the second tier are the contextually scandalous marks, namely, those that require examination of the mark as a whole, the associated goods and services, and other marketplace considerations before determining whether the mark is scandalous. The proposed test would apply a presumption of scandalousness and then identify specific factors that an applicant can use to overcome this presumption. Assuming that Congress retains the scandalous mark prohibition, as it has for more than a century, the proposed two-tier test would result in a more predictable application of the scandalous registration prohibition.

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<sup>22</sup> *Id.* at 242.

<sup>23</sup> WEBSTER’S, *supra* note 1, at 1274 (defining “scandalous”).



## II. EVOLUTION OF THE REGISTRATION PROHIBITION ON SCANDALOUS MARKS

When Congress enacted the scandalous registration prohibition, it did not do so in a vacuum. Years of preexisting common law defined the purpose for protecting trademarks and the type of property right a trademark should receive. The federal registration system reflected the rights accorded marks under the common law. The initial versions of the statute, however, lacked an express scandalous registration prohibition. Congress eventually added the registration prohibition in 1905 with little explanation. However, the extant common law and international law indicate that practitioners and courts did contemplate whether a scandalous mark should be accorded protection. A more careful examination of these historical roots forms the foundation for the proposed two-tier standard.

### A. *The Federal Trademark Registration System*

#### 1. The Purpose and Scope of Common Law Trademark Rights

Before Congress enacted a federal registration system, the common law protected existing trademarks from acquisition or misappropriation by entities competing with the trademark owner. In fact, the main purpose in creating trademark protection was to protect the general public from unscrupulous entities engaged in unfair competition.<sup>24</sup> Thus, any protection should extend “only insofar as is necessary to prevent customer confusion as to who produced the goods and to facilitate differentiation of the trademark owner’s goods.”<sup>25</sup>

To effectuate this purpose, a mark has been accorded a limited property right.<sup>26</sup> The property right only extends to a mark when used with the good or service for which the manufacturer appropriated the mark.<sup>27</sup> The effect of having a limited property right is aptly summarized by Professor Clarisa

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<sup>24</sup> 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:70 (4th ed. 2006) (“Traditional trademark law rests primarily on a policy of protection of customers from mistake and deception . . .”).

<sup>25</sup> 1 *Id.* § 2.14 (quoting *Int’l Order of Job’s Daughters v. Lindeburg & Co.*, 633 F.2d 912, 919 (9th Cir. 1980)).

<sup>26</sup> *The Trade-Mark Cases*, 100 U.S. 82, 92 (1879).

The right to adopt and use a symbol or a device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons . . . is a property right for the violation of which damages may be recovered in an action at law, and the continued violation of it will be enjoined by a court of equity, with compensation for past infringement.

*Id.* See also BROWNE I, *supra* note 2, at 338-39 (stating that the property right is created by customer perception).

<sup>27</sup> See *Canal Co. v. Clark*, 80 U.S. 311, 326 (1872); BROWNE I, *supra* note 2, at 43-44.

Long as follows: “[W]ith this focus on consumers, the classical trademark entitlement is essentially a set of *use rights* rather than purely *exclusionary rights*: A trademark holder’s ability to recover is determined by the way the mark is used by others. What constitutes a prohibited third-party use is a context-dependent question.”<sup>28</sup>

As a necessary corollary, nineteenth century courts and legal commentators generally rejected any express claim that a trademark owner could acquire an absolute property right in a trademark.<sup>29</sup> For example, the New Jersey Court of Chancery stated in 1888 that

It would seem to be settled beyond question, that there can be no such thing as a trade-mark distinct from and unconnected with a vendible commodity . . . . It can have no existence as property or a thing distinct from and wholly unconnected with an article of traffic.<sup>30</sup>

As the law progressed, it would become clear that this statement was incorrect on two counts: courts recognized and protected service marks associated with services rather than just vendible goods, and more importantly, some marks were elevated to the point where they were accorded property rights *in absentia* of association with a commodity.<sup>31</sup>

Thus, under the traditional conception of trademark protection, the Nike swoosh would receive protection from any entity using the mark on the same or similar goods to those sold by Nike under the swoosh mark, such as athletic equipment. However, if another entity were to use the Nike swoosh on a wholly disparate type of good or service, such as photocopying, Nike would not be able to prevent such use. It is with this limited approach to trademark rights that Congress undertook the task of creating a federal registration system.

## 2. Creation of a Federal Registration System

As early as 1860, the House of Representatives considered

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<sup>28</sup> Clarisa Long, *Dilution*, 106 COLUM. L. REV. 1029, 1034 (2006) (emphasis added).

<sup>29</sup> *Canal*, 80 U.S. at 326 (citing *McAndrews v. Bassett*, 10 Jur. N.S. 550) (“Property in the word for all purposes cannot exist . . . .”); UPTON, *supra* note 7, at 25-26; WILLIAM HENRY BROWNE, A TREATISE ON THE LAW OF TRADE-MARKS AND ANALOGOUS SUBJECTS (FIRM-NAMES, BUSINESS-SIGNS, GOOD-WILL, LABELS, & C.) 71 (Boston, Little, Brown, and Co. 2d ed. 1885) [hereinafter BROWNE II] (citing *Ainsworth v. Walmesley*, L.R. 1 Eq. 518 (1866)) (noting that no man has property in a mark *per se* but only rights in the mark in association with his trade).

<sup>30</sup> *Schneider v. Williams*, 14 A. 812, 814 (N.J. Ch. 1888) (citing numerous English and American cases with approval). As previously noted, however, the PTO did question whether some entities should receive an absolute property right in their mark when the mark has reached a certain level of fame. See *supra* notes 17-23 and accompanying text.

<sup>31</sup> See 1 MCCARTHY, *supra* note 24, § 4:14; see also *infra* Part IV.A.

federal legislation to protect the exclusive use of trademarks.<sup>32</sup> Believing the protection of trade to be one of the principal objects of government, a Committee on Commerce report identified two advantages to regulating the use of false trademarks: (1) to ensure that the mark's owner can retain the advantage associated with his own skill or superior quality of goods or services and (2) to give the public a means to distinguish among different manufacturers' goods and judge the quality of the articles purchased.<sup>33</sup>

Congress enacted the first federal law authorizing trademark registration in 1870 ("the 1870 Act"), and by October 1878, the federal government had issued more than 7,200 registrations.<sup>34</sup> Under the 1870 Act, the following "so-called trade-marks" were barred from registration: marks that could not become a lawful trademark; the name of a person, firm, or corporation; marks identical to prior registered marks; and marks so similar to prior registered marks as to be likely to deceive the public.<sup>35</sup> In addition, a trademark owner could not enforce a trademark if it was used or claimed in any unlawful business, was used upon an injurious article, was fraudulently obtained, or was formed and used with deceptive intent.<sup>36</sup>

Because the 1870 Act failed to define trademarks, courts interpreted the first prohibition as excluding symbols that could not constitute trademarks under the common law.<sup>37</sup> If the common law prior to 1870 refused to recognize certain marks based upon scandalousness, then the 1870 Act incorporated the scandalous registration prohibition. On the other hand, even if Congress had incorporated a scandalous prohibition in the 1870 Act, it likely did so by mere fortuity as Congress, at that time, had little knowledge of the parameters of trademarks under the common law.<sup>38</sup> Within a few years of the Act's passage, in 1879,

<sup>32</sup> H.R. REP. NO. 36-527, at 1 (1860).

<sup>33</sup> *Id.*; S. REP. NO. 56-43, at 167 (1899) (reprinting all congressional debates).

<sup>34</sup> *See* The Trade-Mark Cases, 100 U.S. 82, 92 (1879) (stating that the Act of August 14, 1876 (19 Stat. 141) added to the 1870 Act by creating penalties for "the fraudulent use, sale, and counterfeiting of" registered trademarks); H.R. REP. NO. 46-3, at 2 (1879) (charting the trademarks registered under the 1870 Act).

<sup>35</sup> Act of July 8, 1870, ch. 230, § 79, 16 Stat. 198, 211 (1870), *invalidated by The Trade-Mark Cases*, 100 U.S. 82.

<sup>36</sup> *Id.* at 212.

<sup>37</sup> BROWNE I, *supra* note 2, at 247. Marks were refused under the common law if they fell within one of the following categories: (1) the name of a person, firm, or corporation; (2) calculated to deceive the public as to the source or character of the good; (3) generic or descriptive; or (4) distinctive from other marks in the same class. *See id.* at 105-09, 111, 240 (discussing in part *In re R.W. English*, Commissioner's Decisions for 1870 at 142; *Choynski v. Cohen*, 39 Cal. 501 (Cal. 1870); *Stokes v. Landgraff*, 17 Barb. 608 (N.Y. Sup. Ct. 1853)).

<sup>38</sup> With respect to the 1870 Act, Browne noted that "[t]he promoters of the bill had very little knowledge of the general common law of the matter." BROWNE II, *supra* note 29, at 28.

the Supreme Court struck down the 1870 Act as unconstitutional.<sup>39</sup>

Despite the Supreme Court's decision in *The Trade-Mark Cases*, Congress recognized the importance of trademarks to the consuming public and manufacturing companies and the desirability of having a federal system to protect trademarks.<sup>40</sup> Within a month of the decision, the Committee on Manufactures considered a constitutional amendment to give Congress the power to grant, protect and regulate the right to adopt and use trademarks.<sup>41</sup> Alternatively, Congress considered passing a more limited trademark registration act.<sup>42</sup>

In 1881, Congress chose to enact the more limited act ("the 1881 Act").<sup>43</sup> In an overly cautious attempt to address constitutionality concerns, the 1881 Act only allowed registration of marks used in commerce with foreign nations or with Native American tribes.<sup>44</sup> Aside from general registration requirements, the 1881 Act listed two bars to federal registration: marks consisting of the applicant's name and marks for the same class of goods as registered marks that were either identical or so similar as to cause a likelihood of confusion, mistake, or deception for the public.<sup>45</sup> These two registration bars are, in essence, identical to the second, third, and fourth bars in the 1870 Act.<sup>46</sup> The 1881 Act, however, lacked the 1870 Act's first registration prohibition, a specific incorporation of the common law definition of trademark. Regardless, courts interpreted the 1881 Act as incorporating the same common law parameters as those set forth in the 1870 Act.<sup>47</sup>

Almost immediately upon the 1881 Act's passage, various

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<sup>39</sup> *The Trade-Mark Cases*, 100 U.S. at 95-99; *see also* H.R. REP. NO. 46-3, at 2 (1879). Even though the Supreme Court found the 1870 Act unconstitutional in 1879, the Commissioner of Patents continued to issue federal trademarks registrations. *See* H.R. EXEC. DOC. NO. 46-83, at 1 (1881).

<sup>40</sup> H.R. REP. NO. 46-3, at 3 (1879).

<sup>41</sup> *Id.* at 1.

<sup>42</sup> H.R. REP. NO. 46-561, at 1, 5 (1880). The Judiciary Committee opined that Congress did not have the power to regulate trademarks under the Commerce Clause because trademarks were not necessary to commerce. *Id.* at 5. Some members of the House of Representatives championed this position. *See* S. REP. NO. 56-43, at 187-90 (1899) (reprinting comments from Representative Hammond from Georgia).

<sup>43</sup> Act of March 3, 1881, ch. 138, 21 Stat. 502.

<sup>44</sup> H.R. REP. NO. 51-27, at 1 (1890). The Committee on Patents persistently recommended including registration for marks used in interstate commerce. *See* H.R. REP. NO. 48-2376, at 1 (1885). However, the Judiciary Committee was equally persistent in its position that Congress did not have the power to regulate trademarks under the Commerce Clause. H.R. REP. NO. 51-1749, at 1 (1890); H.R. REP. NO. 46-561, at 5 (1880).

<sup>45</sup> Act of March 3, 1881, § 3.

<sup>46</sup> The first prohibition in the 1870 Act was construed to mean the name of the applicant. BROWNE I, *supra* note 2, at 245.

<sup>47</sup> *See, e.g.,* United States *ex rel.* Bronson Co. v. Duell, 17 App. D.C. 471, 479-80 (D.C. Cir. 1901) (affirming the denial of a registration for EVER-READY for coffee mills as descriptive) (citing Elgin Nat'l Watch Co. v. Illinois Watch Case Co., 179 U.S. 665 (1901) (holding that a geographically descriptive term cannot be a valid trademark)).

groups attempted to amend it, leading to the first suggestion of a “scandalous” registration prohibition in 1892.<sup>48</sup> Amendment proponents gave three reasons to amend the 1881 Act. First, the 1881 Act needed additional penalty provisions. In 1876, Congress passed an act to penalize trademark infringement.<sup>49</sup> When Congress enacted the 1881 Act, practitioners improperly assumed that the 1876 Act’s penalty provisions applied to the 1881 Act, but the courts held otherwise.<sup>50</sup> Thus, some advocated for recreating the penalty system enacted in 1876. Second, Congress also reconsidered regulations on labels. Practitioners had difficulties applying the distinction between a trademark and a label.<sup>51</sup> This nebulous distinction created more confusion than solutions for merchants attempting to protect themselves, leading Congress to consider how to consolidate the trademark and label laws into a cohesive, federal statute.<sup>52</sup> Third, many people continued to view the 1881 Act as incomplete because it did not allow for registration of trademarks used in interstate commerce. Agreeing that the constitutional provision governing copyright and patents does not extend to trademarks, these advocates argued that Congress had the power to regulate trademarks via the commerce clause.<sup>53</sup>

Only the last two proposed amendments would have substantively changed the scope of trademark protection. However, an 1892 proposal suggested *three* substantive changes. Section 1 of the statute would “limit[] registration to marks *and labels* used in foreign *or interstate* commerce or with Indian tribes, *and to such as are not offensive to public sentiment or morals.*”<sup>54</sup> In addition to incorporating two of the previously suggested changes to trademark scope, this suggested language is notable in its

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<sup>48</sup> See, e.g., *supra* note 44.

<sup>49</sup> The Trade-Mark Cases, 100 U.S. 82, 92 (1879) (describing the addition of penalties); see S. REP. NO. 49-1188, at VII (1886) (attaching the label law while considering revisions).

<sup>50</sup> H.R. REP. NO. 52-1860, at 2-3 (1892); WILLIAM EVARTS RICHARDS & WILLIAM WALLACE WHITE, UNITED STATES PATENTS, TRADE MARKS, DESIGNS AND COPYRIGHTS 91, 93 n.\* (2d ed. 1896) (noting that the penalties in the 1876 act and the 1880 Act “are in effect one, and should be construed together”). But see S. REP. NO. 56-43, at 194, 204 (1899) (noting that the 1876 Act was unconstitutional). By 1889, it became clear that the penalties enacted in 1876 did not apply to the 1881 Act. *United States v. Koch*, 40 F. 250, 252-53 (E.D. Mo. 1889).

<sup>51</sup> H.R. REP. NO. 52-1860, at 3 (1892).

<sup>52</sup> *Id.*

<sup>53</sup> “Unquestionably, the word ‘commerce’ includes the use of trade-marks in the same way and for the same reason that it includes telegraphy; and Congress may regulate the use of trade-marks in the same manner and to the same extent that it can regulate commerce generally.” ROWLAND COX, THE CONSTITUTION OF THE UNITED STATES AND ITS RELATION TO THE SUBJECT OF TRADEMARKS: A PAPER READ BEFORE THE BAR ASSOCIATION OF THE STATE OF NEW YORK 13 (1895?).

<sup>54</sup> H.R. REP. NO. 52-1860, at 3 (1892) (emphasis added).

exclusion of offensive marks. First, this appears to be the first instance where Congress was asked to consider a prohibition based upon offensive language. Second, the Committee did not recommend revising the 1881 Act to preclude registration of trademarks on any of the other subsequently added registration prohibitions in the 1905 Act, such as the prohibition against using national symbols. This singular prohibition suggests that preventing registration of scandalous trademarks holds unique import. Unfortunately, the Committee failed to explain, in its report or any other document, why it considered this particular preclusion important. Third, the prohibition is on *trademarks that offend*, rather than merely restricting enforcement of *trademarks associated with businesses that offend*. Thus, the Committee indicated a need to focus on marks rather than merely whether the marks were associated with unlawful businesses, a restriction included in another section of both the 1870 and 1881 Acts.<sup>55</sup>

After years of negotiation, Congress enacted substantial changes to the federal trademark statute in the Act of February 20, 1905 (“the 1905 Act”).<sup>56</sup> The 1905 Act significantly increased the enumerated reasons why a trademark registration may be barred, including any mark that “[c]onsists of or comprises immoral or scandalous matter.”<sup>57</sup>

Since 1905, Congress has revised the trademark registration statute several times. Representative Fritz G. Lanham introduced the most significant restructuring in 1938, eventually enacted as the Act of July 5, 1946 (“the Lanham Act”).<sup>58</sup> The stated purpose of the Lanham Act amendments was to “place all matters relating to trade-marks in one statute and to eliminate judicial obscurity, to simplify registration and to make it stronger and more liberal, to dispense with mere technical prohibitions and arbitrary provisions, to make procedure simple, and relief against infringement prompt and effective.”<sup>59</sup> Irrespective of this purpose, the Lanham Act did not clarify the scandalous registration prohibition. In fact, the specific language of the scandalous registration prohibition did not change until 1994, when it became the following: “Consists of or comprises immoral, *deceptive*, or scandalous matter.”<sup>60</sup> The various congressional bodies that

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<sup>55</sup> Act of July 8, 1870, ch. 230, § 84, 16 Stat. 198, 212; Act of March 3, 1881, ch. 138, § 8, 16 Stat. 504.

<sup>56</sup> Act of Feb. 20, 1905, ch. 592, 33 Stat. 724.

<sup>57</sup> *Id.* at 725.

<sup>58</sup> Act of July 5, 1946, Pub. L. No. 79-489, 60 Stat. 427 (codified at 15 U.S.C. §§ 1051-1127 (2006)).

<sup>59</sup> S. REP. NO. 79-1333, at 1274 (1946).

<sup>60</sup> 15 U.S.C. § 1052(a) (2006) (emphasis added).

have amended the Lanham Act over the years have not been troubled by a lack of definition or parameters for “scandalous matter” but have repeated the phrasing regarding scandalous matter with minimal alteration for about a century.

B. *Historical Roots for the Scandalous Registration Prohibition*

The 1905 Act significantly increased the number of enumerated registration prohibitions and was “intended to permit the registration of all marks which, under the common law as expounded by the courts, could be considered trademarks, and become the exclusive property of the person using it as his trademark.”<sup>61</sup> Little in the legislative history, however, describes the scope of the scandalous registration prohibition. The common law, therefore, is one source likely to provide further guidance. The pre-1870 law is pertinent in evaluating the general landscape of trademark law. While it does not specifically explain why Congress enacted a scandalous registration prohibition, it does elucidate the state of trademark law as Congress considered creating a registry. Of more relevance, the common law created between the 1870 Act and the 1905 Act clarifies why Congress may have added the scandalous registration prohibition (and other prohibitions) to the 1905 trademark registration regime.

Moreover, while Congress contemplated revisions to the 1881 Act, it also considered the trademark registration regimes of various foreign countries, particularly those in Europe and the other Americas. Several influential foreign countries added a scandalous registration prohibition to their trademark registration regimes before Congress passed the 1905 Act. The climate of trademark law on a national and international level at the time indicates that Congress may have been significantly influenced while drafting the 1905 Act by both preexisting United States law and international registration regimes.

1. Common Law in the United States

Before the first treatise on trademarks appeared in 1860, United States common law regarding trademarks was difficult to discern and thus, often led to confusion among practitioners, in the courts, and in the general public.<sup>62</sup> As summarized in Francis Upton’s groundbreaking treatise on trademark law, the common law described the right to adopt any mark in broad terms: a manufacturer had the right to adopt any mark that could serve as

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<sup>61</sup> ARTHUR P. GREELEY, REGISTRATION OF TRADEMARKS UNDER THE NEW TRADEMARK ACT OF THE UNITED STATES WITH NOTES ON THE ACT 11-12 (1905).

<sup>62</sup> BROWNE I, *supra* note 2, at vi; *see also* UPTON, *supra* note 7, at 4.

a source-identifier as long as the mark was not generic, descriptive, or previously appropriated.<sup>63</sup> Additionally, pre-1860 courts refused to enforce trademarks that were fraudulent or deceptive.<sup>64</sup>

Regarding trademarks and scandalousness or immorality, Upton made only one relevant but somewhat mysterious statement. In the context of discussing the proscription on deceptive trademarks and the pro-competitive effect of trademark protection, Upton stated that “[n]o just reason can be assigned why, upon similar grounds, this salutary [trademark] protection should not be extended, in like manner, to every business and occupation that is *not positively immoral in its character, or vicious in its tendency*.”<sup>65</sup> Assuming that the terms “scandalous” and “immoral” are to be given distinct meanings in the 1905 Act’s registration prohibition, this statement would, at most, inform the common law precursor to the immorality portion of the 1905 Act. Unfortunately, Upton did not clarify or expand upon this statement.

One interpretation of Upton’s statement, merely based upon its language, is that trademark protection should not be granted to, or courts cannot enforce a trademark for, businesses based solely upon the business’ nature rather than upon the mark’s nature. Certainly, some courts would not only agree with such an assessment but would extend it to an extreme degree. For example, Justice Clerke of the Supreme Court of New York County noted that “[i]t is unquestionably the duty of courts to regard with disfavor every establishment having any tendency to corrupt the public morals, to create idle or dissipated habits, to encourage a craving for undue excitement, or to impair the taste for domestic attachments and domestic society.”<sup>66</sup> If Justice Clerke’s statements served as a foundation for a general understanding of immorality, many common trademarks would immediately fall into disrepute merely because they are perceived by some as associated with businesses that encourage idleness or undue excitement.<sup>67</sup> Fortunately, no subsequent courts endorsed Justice Clerke’s stated position.<sup>68</sup>

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<sup>63</sup> UPTON, *supra* note 7, at 85-88.

<sup>64</sup> *See, e.g., id.* at 62-71, 100-02. In particular, courts appear to consider deception as an imposition upon the general public. *Id.* at 90 (“But he must not, by any deceitful or other practice, impose upon the public . . .” (citing *Howard v. Henriques*, 3 Sand. S.C.R. 725)).

<sup>65</sup> UPTON, *supra* note 7, at 95 (emphasis added).

<sup>66</sup> *Christy v. Murphy*, 12 How. Pr. 77 (N.Y. Sup. Ct. 1856).

<sup>67</sup> Given the breadth of Justice Clerke’s interpretation of immorality, many trademarks could have been barred as immoral due to the associated business’ propensity for encouraging undue excitement or to create idleness, such as PLAYERS HAVE MORE FUN for the Illinois Lottery or GRAND THEFT AUTO: SAN ANDREAS for a computer role-playing game.

<sup>68</sup> The author was unable to find any cases that referred to this language. Moreover, a



A prominent legal scholar of the late nineteenth century, William Henry Browne, also noted that any business conflicting with the morals of the time should not be able to enforce trademark and unfair competition rights.<sup>69</sup> His specific examples of unlawful businesses included those that use trademarks on obscene publications, on articles used in committing acts of vice, while trading with the enemy during a time of war, and while engaging in a business that violates the laws of another nation.<sup>70</sup> Browne's examples all consist of businesses that, in and of themselves, should not be able to enforce any legal rights, including trademark rights.<sup>71</sup> These "unlawful" businesses may be divided into two categories. First, there are businesses that may be considered immoral when evaluated in light of the mores of the time, such as an obscene publication or an article used in committing acts of vice. One can neither determine what constitutes obscenity or a vice, nor determine whether obscenity and the identified vices are prohibited, without assessing society's standards at that time.<sup>72</sup> At least one type of "unlawful" business seems to be more of an absolute prohibition without need to reference the mores of the time: trading with the enemy during times of a declared war.<sup>73</sup> These unlawful businesses indicate that there are some forms of "immorality" that are *per se* immoral

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prominent legal scholar accorded a slightly different purpose for this language, namely, as being one of the many reasons courts give for judicially intervening in a trademark dispute. BROWNE II, *supra* note 29, at 70-71. Even so, Browne focused the weight of his regard upon the theory that judicial intervention is warranted to prevent fraud upon the public and that the prevention of fraud is the moral and legal obligations of the court. *Id.* at 68-71.

<sup>69</sup> *Id.* at 342.

<sup>70</sup> *Id.*; BROWNE I, *supra* note 2, at 263-64.

<sup>71</sup> See also RICHARDS & WHITE, *supra* note 50, at 91 (noting that trademarks used on obscene publications or used in acts of vice cannot be enforced because the business is unlawful).

<sup>72</sup> These businesses require both inquiries because, even if a vice is recognized, it still may not be legally prohibited. For example, gluttony is one of the seven deadly sins, but society's standards have not legally prohibited gluttony as a vice. A better comparative example may be cannibalism. Almost universally throughout its history, the United States has condemned cannibalism, whereas there are other cultures that do not find cannibalism to be a vice. Clare Murphy, *Cannibalism: A Modern Taboo*, BBC NEWS, Dec. 2, 2003, <http://news.bbc.co.uk/2/hi/europe/3254074.stm> (noting cultures that accept cannibalism).

<sup>73</sup> One can argue that trading with the enemy during a time of war also has an element of relativity in that one may need to assess what constitutes a "war" and who is the "enemy." However, the concept of trading with the enemy falls more as a *per se* prohibition in that, once an enemy is identified and a war has begun, exchanging commerce with that enemy is unlawful. See, e.g., Trading with the Enemy Act of 1917, 12 U.S.C. § 95(a) (2006) (giving the President the power to regulate trade during times of war). But see Robert W. McGee, *Legal Ethics, Business Ethics, and International Trade: Some Neglected Issues*, 10 CARDOZO J. INT'L & COMP. L. 109, 166-67 & n.255 (2002) (arguing that economic sanctions are warranted to avoid selling supplies to the enemy but noting that Serbs often sold food and clothing to the starving Bosnian army during the conflict between the two ethnic groups).

whereas others require contextual evaluation.

Although Browne lists these unlawful businesses, he does not provide any examples where a court refused to enforce a trademark because of its use in an unlawful business. Before the 1905 Act, however, there was one group of cases where courts often refused to enforce trademark rights because of the “morality” of the business: cases involving “quack medicine.”<sup>74</sup> Regardless of the various courts’ ultimate decisions regarding whether to enforce the trademarks, the relevant portions of the courts’ consideration focused on the morality or immorality of the business rather than that of the associated trademarks. Thus, as one contemporary legal scholar noted, “[a] complainant, whose business is imposition, cannot invoke the aid of equity against the piracy of his trademarks.”<sup>75</sup>

Even so, courts became reluctant to prohibit enforcement of “quack medicine” trademarks *per se*. These courts questioned whether quack medicine constituted an unlawful business such that the practitioners’ trademark rights should not be enforced, particularly when the purported medicines either had doubtful medicinal properties or otherwise were harmless.<sup>76</sup> Thus, Judge Sutherland in the New York courts noted the following:

[I]f these pills are an innocent humbug, by which both parties are trying to make money, I doubt whether it is my duty, on those questions of property, of right and wrong between the parties, to stop outside of the case, and abridge the innocent individual liberty which all persons must be presumed to have in common, of suffering themselves to be humbugged.<sup>77</sup>

Eventually, the Supreme Court resolved any debate regarding enforceability of trademarks for quack medicines by stating that trademark law was insufficient, standing alone, to preclude enforcement of “quack medicine” trademarks.<sup>78</sup> As long as the associated product was not harmful, courts could not fail to

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<sup>74</sup> *E.g.*, *Fowle v. Spear*, 9 F. Cas. 611 (C.C.E.D. Pa. 1847) (No. 4,996) (stating that quack medicine manufacturers cannot invoke equity courts to protect a label, termed a trademark); *Smith v. Woodruff*, 48 Barb. 438 (N.Y. Sup. Ct. 1867) (considering it “beneath the dignity of a court of justice” to enforce a quack compound that is harmful but advertised as safe or a compound that is useless); BROWNE I, *supra* note 2, at 359 (stating that quack medicine manufacturer is not entitled to invoke equity courts).

<sup>75</sup> CHARLES E. CODDINGTON, A DIGEST OF THE LAW OF TRADEMARKS AS PRESENTED IN THE REPORTED ADJUDICATIONS OF THE COURTS OF THE UNITED STATES, GREAT BRITAIN, IRELAND, CANADA, AND FRANCE, FROM THE EARLIEST PERIOD TO THE PRESENT TIME 169 (Ward & Peloubet 1878).

<sup>76</sup> *See, e.g.*, *Fetridge v. Merchant*, 4 Abb. Pr. 156 (N.Y. Sup. Ct. 1857) (noting in *dicta* an inclination to follow judges that will enforce rights when the article is innocuous or useful); *see also* *Curtis v. Bryan*, 2 Daly 312, 319 (1868) (rejecting claim that the “quack medicine” in use for more than twenty years was harmful to children).

<sup>77</sup> *Comstock v. White*, 10 Abb. Pr. 264 (N.Y. Sup. Ct. 1860).

<sup>78</sup> *See, e.g.*, *Worden v. Cal. Fig Syrup Co.*, 187 U.S. 516, 527 (1903).

enforce trademark rights based upon the legitimacy of the associated product.

As various courts and legal scholars believed that “unlawful” businesses should not be able to enforce trademark rights, the 1870 Act and 1881 Act reflected the same proposition. Section 84 of the 1870 Act and Section 8 of the 1881 Act prohibited enforcement of a trademark used in any “unlawful business” or upon any injurious article.<sup>79</sup> This language is merely a codification of the equity court principles, which would prevent trademark enforcement when the marks were used to promote sales that are unlawful, such as sales of assassin’s tools.<sup>80</sup>

Assuming that Upton was referring to these types of unlawful businesses as immoral, his statement that trademark protection should not be extended to immoral businesses and occupations has only limited value in informing the scope of the scandalous registration prohibition. When Congress added the scandalous registration prohibition in the 1905 Act, it also retained the right to refuse to enforce trademarks used in unlawful businesses.<sup>81</sup> If one were to assume that unlawful businesses encompassed the same scope as immoral trademarks, having both provisions in the 1905 Act would be redundant. Moreover, if Congress intended the two provisions to encompass the same scope, one would expect it to use the same terms. As Congress did not use the same terms, it is more likely that the prohibition against enforcing unlawful businesses, and the examples of unlawful businesses, reflected more upon equity courts’ general refusal to enforce unlawful businesses rather than upon trademark law and the limitations on acquiring a property right in a trademark.<sup>82</sup> For these unlawful businesses, the fact that the dispute involves

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<sup>79</sup> Act of July 8, 1870, ch. 230, § 84, 16 Stat. 198, 212; Act of Mar. 3, 1881, ch. 138, § 8, 21 Stat. 502, 504. By injurious articles, Browne and others identified that these are goods that are *per se* unlawful, such as adulterated foods and assassin’s tools, rather than those that can be perverted from lawful purposes, such as intoxicating liquors. RICHARDS & WHITE, *supra* note 50, at 91 (would not include “poisons, explosives, [and] weapons used in warfare”); BROWNE I, *supra* note 2, at 265.

<sup>80</sup> Youngs Rubber Corp. v. C.I. Lee & Co., 45 F.2d 103, 108-09 (2d Cir. 1930) (discussing the same language in a later incarnation of the trademark act).

<sup>81</sup> Act of Feb. 20, 1905, ch. 592, § 21, 33 Stat. 724, 729.

<sup>82</sup> Courts of equity will not assist a plaintiff with unclean hands to effectuate his or her wrongful, illegal purpose. *See, e.g.*, UPTON, *supra* note 7, at 40; Dunning v. Bathrick, 41 Ill. 425 (Ill. 1866); Phippen v. Durham, 49 Va. (8 Gratt.) 457, 472 (Va. 1852) (citing 1 Story’s Equ. Jur. § 64, e). For example, the equity court in *Piddings v. Howe*, 8 Simons R. 479, refused to enforce plaintiff’s trademark rights because plaintiff falsely represented the procuring method and composition of the teas used to create his final product, known as Hoqua’s Mixture, supposedly after the man who created the mixture. *Fetridge v. Merchant*, 4 Abb. Pr. 156 (N.Y. Sup. Ct. 1857) (discussing *Piddings*). In fact, the mixture had never been made or used by Howqua. BROWNE I, *supra* note 2, at 363. The refusal was not based upon the trademark rights, or lack thereof, but upon plaintiff’s unclean hands.

trademark enforcement is almost incidental. The identified problem was with the *business* practices and not with the *trademark* matter.

In addition to unlawful businesses, Browne discussed one example of an immoral business. Monks in Bordeaux exported white wine to Turkey under the mark MINERAL WATER even though Turks, by their religion, were forbidden from drinking alcohol.<sup>83</sup> Businessmen in Burgundy, hearing about the Bordeaux success, undertook the same business practice using the same MINERAL WATER mark. While this scenario would be ripe for an unfair competition claim, Browne supposed that the Bordeaux monks would not have standing due to their “immoral” business practice of marking an alcoholic product as water and then selling the product to people who are forbidden from drinking alcohol.<sup>84</sup> Browne specifically rejected the supposition that the monks would have no standing because the MINERAL WATER mark was deceptively indicating that the product was a kind of water rather than alcohol.<sup>85</sup> In Browne’s view, no one was deceived.<sup>86</sup> Rather, it is the business of enticing Turks to violate a tenant of their religion, rather than the mark, that led Browne to suppose that the monks had no recourse.

Browne’s example confirms that an unlawful business under the pre-1905 common law is one that violated *any* religion’s beliefs. Interpreting this example as a common law precursor to the immorality portion of the scandalous registration prohibition, one can extrapolate that Congress intended the registration prohibition to protect *any* religion’s terms and images from use by trademark owners. Moreover, such a prohibition would serve the original purpose of trademark regulation. As the PTO noted in its rejection of the Masonic emblem, the quasi-religious icon could not serve as an adequate source-identifier.<sup>87</sup> Likewise, Browne also presumed that a trademark for CHRISTIAN would be rejected because of its strong connection to a religious faith, precluding it from adequately serving as a merchant’s source-identifier.<sup>88</sup> On the other hand, symbols that had lost their religious significance, like the Maltese cross, could adequately serve as trademarks because they would not offend anyone.<sup>89</sup> Thus, under Browne’s

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<sup>83</sup> BROWNE I, *supra* note 2, at 51-52.

<sup>84</sup> *Id.*; BROWNE II, *supra* note 29, at 92-93.

<sup>85</sup> BROWNE I, *supra* note 2, at 52.

<sup>86</sup> *Id.*

<sup>87</sup> *See supra* text accompanying notes 17-23.

<sup>88</sup> BROWNE I, *supra* note 2, at 239-40.

<sup>89</sup> *Id.* at 240 (noting that the “most bigoted” found no fault with using the crescent, a Muslim symbol, to trade with the Turks).

discussion of the common law protection for trademarks, trademarks that expressly adopt religious *terms* or *icons* are improper trademarks because the marks cannot serve the essential purpose of a trademark, namely, a means to identify the source.<sup>90</sup> In light of this common law approach, the registration prohibition on immoral marks fits into the general purpose of the regulatory scheme—to prevent registration of marks that cannot serve as an adequate source-identifier.

There is a second potential meaning to Upton's mysterious statement. Upton may be casting as immoral the situation where the business is improper because the mark, when considered in light of the associated goods, is deceptive. For example, the case of *Fetridge v. Wells* evaluated whether the trademark BALM OF THOUSAND FLOWERS, associated with "quack medicine," should be protected.<sup>91</sup> The court stated:

[I]f the plaintiff and his firm are themselves engaged in the execution of a systematic plan for deceiving the public . . . by false representations of the composition, qualities and uses of the liquid compound which they invite the public to buy, . . . a court of equity would violate its principles and abuse its powers by consenting to aid them by an injunction or otherwise, in accomplishing their design.<sup>92</sup>

Unlike the courts that refused to enforce trademarks associated with quack medicine, the *Fetridge* court first focused on the deceptive nature of the mark (falsely representing the compound's ingredients) and then discussed the nature of the business (purportedly selling healing substances when it was merely soap).<sup>93</sup> Even after discussing the nature of the business, the court quickly restated that its purpose in doing so was to determine whether the trademark was intended for the purpose of deceiving and actually would deceive the public.<sup>94</sup>

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<sup>90</sup> Unlike subsequent PTO decisions that identified the use of religious symbols as marks as scandalous, Browne does not draw any distinction between using religious marks on "immoral" products and using religious marks on other products, including those associated with the religion. Rather, it is the use of a religious symbol in connection with *trade* that is improper. *Id.* at 239-40.

<sup>91</sup> UPTON, *supra* note 7, at 36-39 (discussing *Fetridge v. Wells*, 4 Abb. Pr. 144 (N.Y. Sup. Ct. 1857)). Another case, *Fetridge v. Merchant*, 4 Abb. Pr. 156 (N.Y. Sup. Ct. 1857), which had very similar facts, was decided at nearly the same time by another judge in the same court. In that case, Judge Hoffman decided that the mark was more fanciful than deceptively descriptive and, thus, should be accorded trademark protection. *See* BROWNE I, *supra* note 2, at 168-69.

<sup>92</sup> *Fetridge v. Wells*, 4 Abb. Pr. 144 (N.Y. Sup. Ct. 1857) (emphasis added).

<sup>93</sup> *Id.*

<sup>94</sup> *See id.*

The proof is, therefore, complete, that the name was given and is used to deceive the public; to attract and impose upon purchasers; that, in the sense that the plaintiff means it shall convey, it is a representation to the public that he finds to be useful and knows to be false.

By quickly refocusing the discussion on the BALM OF THOUSAND FLOWERS mark, the *Fetridge* court honed in on the specific manner in which the mark must interact with the product before the mark is considered improper—or perhaps immoral—namely, marks cannot be enforced when they are deceptively descriptive.<sup>95</sup> Both Upton and subsequent courts perceived the *Fetridge* case as standing for the proposition that deceptively descriptive trademarks are improper.<sup>96</sup> Reinforcing the notion that deceptively descriptive marks may be immoral and, thus, should not be registered, Browne also identifies a deceptively descriptive trademark as unlawful and immoral.<sup>97</sup> Thus, one could argue that the pre-1870 common law would consider a mark immoral if it were deceptively descriptive; notably, such marks would be immoral regardless of the mores of the time.

The structure of the 1905 Act, however, belies any indication that Congress referred to, or intended to include, deceptive trademarks in the immoral portion of the scandalous registration prohibition. In the 1870 and 1881 Acts, the clause that prohibits enforcement of unlawful businesses or injurious articles also prohibits, in nearly identical language, courts from enforcing any trademark “which has been formed and “used with the design of deceiving the public in the purchase” or use of any article “of merchandise.”<sup>98</sup> As with the “unlawful businesses” provision, Congress retained this bar when it added the scandalous

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*Id.* In *dicta*, the court also noted other evidence of plaintiff’s deception, including an advertisement that misled the public regarding how much plaintiff paid for the rights to the compound and misrepresentations regarding the compound’s benefits. *Id.*

<sup>95</sup> See BROWNE I, *supra* note 2, at 155-71 (subsequently discussing both deceptiveness and descriptiveness); see also *Coats v. Holbrook, Nelson & Co.*, 2 Sand. Ch. 586 (N.Y. Ch. 1845) (finding that there was no good faith or morality in transaction when deceiving the public via passing off). Browne also referenced the *Fetridge v. Wells* case to note that the Patent Office will determine when a proposed mark is calculated to deceive and reject it accordingly. BROWNE I, *supra* note 2, at 227-28.

<sup>96</sup> See, e.g., *Worden v. Cal. Fig Syrup Co.*, 187 U.S. 516, 528-32 (1903) (discussing *Fetridge* while refusing to enforce a trademark because it fraudulently represented that the associated product contained figs); *Manhattan Med. Co. v. Wood*, 108 U.S. 218, 222-25 (1883) (rights in trademark are forfeited upon misrepresentation as to the manufacturer and manufacturing location for the medicine); *Grocers Journal Co. v. Midland Publ’g Co.*, 105 S.W. 310, 315-16 (Mo. Ct. App. 1907) (summarizing *Fetridge* as denying trademark protection due to its deceptively descriptive nature); see also BROWNE II, *supra* note 29, at 78-79.

<sup>97</sup> Shortly after the Civil War, a Massachusetts boot-maker stamped as trademarks the likeness and signature of Robert E. Lee along with the Confederacy’s six stars. BROWNE II, *supra* note 29, at 343. The PTO refused registration because the marks “tended to . . . keep alive . . . sectional feeling[s]” and were deceptive since the boot-maker was a Northern, not Southern, business. *Id.* at 343-44. It appears that Browne believes that this business was unlawful because of the deception. *Id.* at 344 (suggesting that the mark may have been allowed registration if the applicants were Southern manufacturers).

<sup>98</sup> Act of July 8, 1870, ch. 230, § 84, 16 Stat. 198, 212; Act of Mar. 3, 1881, ch. 138, § 8, 21 Stat. 502, 504.

registration prohibition to the 1905 Act.<sup>99</sup> Thus, if one were to assume that immoral trademarks encompassed deceptively descriptive trademarks, having both provisions in the 1905 Act would have been redundant. Moreover, Congress subsequently amended the scandalous registration prohibition to add in specific language prohibiting deceptive trademarks.<sup>100</sup> In so doing, Congress reaffirmed that the immoral trademark prohibition was not intended to include deceptively descriptive trademarks.

Despite the scant pre-1905 common law addressing immoral or scandalous trademarks, at least one legal scholar was not silent regarding morality or scandalousness in the context of trademarks. The first edition of Browne's treatise, published shortly after the 1870 Act, extolled trademark owners to choose trademarks with propriety.<sup>101</sup> Browne reiterated this discussion in the treatise's second edition, published shortly after the 1881 Act was passed.<sup>102</sup> According to Browne, a lawful mark "must not transgress the rules of morality or public policy."<sup>103</sup> Thus, he recommended choosing a mark that does not shock the sensibilities of anyone in the world on the basis of moral, religious, or political grounds by "the perversion of an emblem sacred in their eyes."<sup>104</sup> Browne further opined that, without support in case law, judges would not enforce a trademark comprised of any religious emblem.<sup>105</sup>

Two essential points should be noted. First, in Browne's estimation, the 1870 and 1881 Acts would prohibit marks that lack propriety—marks that were scandalous or immoral. These improper marks are ones that have political, religious, or moral content. As discussed below, these are precisely the types of marks that the PTO and courts have evaluated under the scandalous registration prohibition. Second, Browne discusses these marks as being improper regardless of the goods with which they are associated, indicating that these marks should be *per se* prohibited. Browne's only example of a mark potentially lacking propriety further reinforces this point: an entity with a German registration submitted a trademark application consisting of a sitting, smiling, and drunken devil carrying six bottles.<sup>106</sup> Although the PTO

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<sup>99</sup> Act of Feb. 20, 1905, ch. 592, 33 Stat. 724, 729.

<sup>100</sup> See *supra* note 60 and accompanying text.

<sup>101</sup> BROWNE I, *supra* note 2, at 464.

<sup>102</sup> BROWNE II, *supra* note 29, at 607.

<sup>103</sup> BROWNE I, *supra* note 2, at 465.

<sup>104</sup> *Id.* at 464.

<sup>105</sup> *Id.* at 464-65. In fact, Browne makes his statements regarding propriety in contrast to "blindly follow[ing] the loose, random sayings of judges, that any emblem may be lawfully employed for [commerce]." *Id.* at 464.

<sup>106</sup> *Id.* at 465.

eventually allowed registration of the mark, Browne expressed outrage because the mark “might possibly convey a moral lesson by an association of ideas.”<sup>107</sup> Browne noted that, if the mark depicted the devil venerated by followers, it would have been “an atrocious libel, and must have been rejected on that account.”<sup>108</sup> Notably, Browne never discussed, or even identified, the associated good, medicine bitters, indicating that the mark should be evaluated for impropriety (or immorality) without reference to the associated goods.<sup>109</sup>

Congress did not include the 1905 additional registration prohibitions in a vacuum. As recognized by Congress and Arthur Greeley, the architect of the 1905 Act, the registration prohibitions were intended to permit registration of all marks that could function as trademarks under the preexisting United States common law and to prohibit registration for all marks considered improper under the common law.<sup>110</sup> The common law landscape prior to 1905 indicates that some scholars and the PTO pondered whether trademark protection should extend to marks consisting of, or referring to, illegal, political, religious, or other moral matters. Given these considerations, the scandalous registration prohibition likely was intended to prevent registration for marks that connote illegal acts or political matter, and the immoral marks prohibition likely was intended to prevent registration for marks containing terms or icons associated with a religion or otherwise referring to moral matters. Thus, both portions of the scandalous registration prohibition had their roots in the pre-existing common law.

## 2. The Influence of International Trademark Law in the United States

While the United States common law laid an important foundation for the 1905 Act, foreign law was also considered an important source of trademark law. Legal scholars often referred to the more developed trademark law of foreign countries, particularly those of England, France, and other European nations, to evaluate appropriate principles for United States law<sup>111</sup>

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<sup>107</sup> *Id.*

<sup>108</sup> *Id.*

<sup>109</sup> See Patent and Trademark Depository Library Association, History, <http://www.ptdla.org/history> (follow “Trademarks 1870-1873” hyperlink to open .xls file) (last visited Mar. 6, 2007).

<sup>110</sup> See GREELEY, *supra* note 61, at 11-12, 36 (reproducing comments from the House of Representatives Committee on Patents when recommending the 1905 Act).

<sup>111</sup> See, e.g., COX, *supra* note 53, at 22-23 (referring to all “civilized” nations, including Great Britain, France, Germany, Belgium, the Netherlands, Norway, Japan, Italy, Switzerland, Russia, Denmark, and the Argentine Confederation); BROWNE I, *supra* note 2,



and even to define a “trademark.”<sup>112</sup> Congress also considered coordinating trademark regulation at an international level well before the 1905 Act.<sup>113</sup> In fact, one of the motivations for enacting the 1870 Act was to comport with treaty obligations giving trademark rights to citizens of Belgium, France, and Russia.<sup>114</sup>

Foreign trademark law appears to have shifted between approximately 1860 and 1885 towards having a registration system and subsequently shifted again towards including certain registration prohibitions. American law appears to have developed on a parallel, if later, track.

According to documents revealing their perceptions and knowledge, American commentators and lawmakers were aware of few foreign jurisdictions with a registration system before the 1870 Act. Austria’s law of December 7, 1858, was the most developed registration system.<sup>115</sup> The law provided for exclusive use of a trademark in connection with the associated merchandise after registration and contained several registration prohibitions.<sup>116</sup> France, the Bavarian and Wirtemberg portions of the German Empire, Sardinia and Italy, and Russia also had registration systems of some sort before the 1870 Act, although some were less developed or narrower in scope than others.<sup>117</sup> Great Britain’s House of Commons considered, but did not adopt, a registration system before the 1870 Act.<sup>118</sup> None of the enacted registration systems had specific prohibitions related to scandalous or immoral marks.<sup>119</sup>

According to compilations by American scholars and lawmakers, the foreign jurisdictions with extensive trademark

at vi-ix, 560-73. Moreover, knowledge of international trademark regimes was important as a matter of comity. COX, *supra* note 53, at 17. This point became particularly clear when the Tribunal of Commerce of Geneva noted in 1859 that a trademark should be protected as the manufacturer’s property under the law of nations. *Id.*

<sup>112</sup> See, e.g., BROWNE II, *supra* note 29, at 98-100.

<sup>113</sup> See, e.g., S. REP. NO. 56-43, at 167-68 (1899) (reprinting Representative Cleveland’s comments for the 1870 Act, which referred to French and English law); BROWNE I, *supra* note 2, at v (discussing commercial treatise, conventions, and diplomatic compacts).

<sup>114</sup> S. REP. NO. 56-43, at 167-68 (noting that, under these treaties, non-citizens received significantly more trademark protection than American citizens).

<sup>115</sup> All references to international law are garnered from treatises and congressional records contemporaneous to the time period when the United States enacted various trademark provisions. Relying upon these sources to identify relevant international law is more important than determining the actual foreign law because they demonstrate the United States perception of foreign law and, thus, what influenced the creation of the United States trademark provisions.

<sup>116</sup> BROWNE I, *supra* note 2, at 560-61 (summaries or reprinting of relevant acts).

<sup>117</sup> *Id.* at 560-63, 569-73; BROWNE II, *supra* note 29, at 697. Despite the lack of registration prohibitions in the French Act, Browne perceived the 1870 Act as very similar to the French registration legislation. BROWNE I, *supra* note 2, at 193.

<sup>118</sup> BROWNE I, *supra* note 2, at 565 & n.1. In fact, the first act for trademark registration in Great Britain was passed in 1875. 1 MCCARTHY, *supra* note 24, § 5:3 n.1.

<sup>119</sup> 1 MCCARTHY, *supra* note 24, § 5:3 n.1.

registration systems grew in short order. Between 1870 and 1885, the following countries enacted new trademark registration system or refined their preexisting system: Belgium, Brazil, Canada, Germany, Great Britain, Japan, the Netherlands, Norway, Romania, Sweden, and Switzerland.<sup>120</sup>

Particularly in the 1880s and 1890s, while Congress wrestled with creating its own trademark regime, it kept abreast of changing trademark regimes among various countries.<sup>121</sup> This international focus was required to effectuate United States participation in efforts to coordinate enforcement of trademark rights. Through these efforts, U.S. lawmakers were exposed to the idea of expressly prohibiting registration of “immoral” or “scandalous” marks. For example, Article 6 of the Paris Convention for the Protection of Industrial Property (“Paris Convention”), first joined by the United States in 1887, expressly allows treaty members to reject trademark registration if the trademark is contrary to morals and to public order.<sup>122</sup>

By 1890, the United States agreed to participate in the International American Conference, where leaders from both North and South America considered, among other subjects, the best method to protect each country’s trademarks from infringement and forgery in the other American countries.<sup>123</sup> In preparation for the conference, the Senate reviewed a summary of trademark laws in various North and South American countries.<sup>124</sup> The pre-conference summary and subsequent publications advised that several North and South American countries would not register trademarks containing scandalous material, including Canada, Argentina, Uruguay, Brazil, and Mexico.<sup>125</sup>

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<sup>120</sup> BROWNE II, *supra* note 29, at 680-83, 688-701, 703-05.

<sup>121</sup> *See, e.g.*, H.R. MISC. DOC. NO. 48-34, at 316-19 (1885) (Sweden and Norway’s trademark laws); H.R. MISC. DOC. NO. 48-12, pt. 4, at 683-88 (1884) (Japan’s trademark law and by-laws); H.R. MISC. DOC. NO. 48-12, pt. 2, at 675-77 (1884) (discussing Great Britain’s trademark registration system); H.R. MISC. DOC. NO. 47-39, at 223 (1883) (discussing Brazil’s trademark registration system); H.R. MISC. DOC. NO. 47-65, at 529-35 (1882) (discussing Austria-Hungary’s trademark law).

<sup>122</sup> H.R. REP. NO. 51-3281, at 5 (1890); *see also* Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, as last revised at Stockholm July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305, *available at* [www.wipo.int/treaties/en/ip/paris/index.html](http://www.wipo.int/treaties/en/ip/paris/index.html); 5 MCCARTHY, *supra* note 24, § 29:22.

<sup>123</sup> S. EXEC. DOC. NO. 51-177, at 1-2 (1890).

<sup>124</sup> S. EXEC. DOC. NO. 51-57, at 60 *illus.* (1890).

<sup>125</sup> *Id.* In the 1891 first edition of the *Handbook of the American Republics*, the following countries maintained a prohibition on registering scandalous marks: Argentine Republic and Uruguay (“[D]esigns or expressions contrary to morals”), Brazil (“[W]ords, pictures, or allegories which involve offence to either individuals or the public decorum . . .”), and Canada (“[C]ontains any immorality or scandalous figure . . .”). S. EXEC. DOC. NO. 52-8, pt. 2, at 354, 357, 359 (1891). By the second edition in 1893, Mexico also had a prohibition against registering a “mark against public morals.” S. EXEC. DOC. NO. 52-149, at 495 (1893).

Of the various foreign regimes to which Congress was exposed during the 1880s and 1890s, the prohibitions on scandalous or immoral trademarks were perceived as falling into three categories: (1) countries that did not prohibit or otherwise restrict registration on the basis of scandal or immorality; (2) countries that simply prohibited scandalous or immoral marks; and (3) countries that prohibited marks intended to be scandalous or immoral. The first category included Belgium, Japan, and Romania.<sup>126</sup> The second category included: Brazil, Canada (the revised 1879 statute), Germany, Great Britain,<sup>127</sup> the Netherlands, Norway, Sweden, and Switzerland,<sup>128</sup> as well as the Argentine Republic, Uruguay, and Mexico.<sup>129</sup> Of these countries, only Canada specifically prohibited both immoral and scandalous marks.<sup>130</sup> Denmark's statute fell into the third category.<sup>131</sup>

After being exposed to these various international regimes and treaties, Congress first considered adding a prohibition against scandalous marks in 1892, when it considered whether to prohibit marks that are "offensive to public sentiment or morals."<sup>132</sup> Although there is no indication that the drafters referred to other countries' registration regimes, the proposed language is nearly identical to the Netherlands' prohibition on "words or designs offensive to public order or good morals."<sup>133</sup> By 1900, the Commissioners appointed to revise trademark laws "propose[d] to review . . . salient features of foreign trademark laws which are of interest to our citizens and which may aid in coming to a conclusion as to what should be incorporated into such a law."<sup>134</sup> These Commissioners proceeded to consider the "scandalous" provision of many international regimes, including that of the Paris Convention.<sup>135</sup> The Commissioners' proposed bill

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<sup>126</sup> BROWNE II, *supra* note 29, at 680-81, 697-701.

<sup>127</sup> In addition to the prohibition on scandalous designs, Great Britain also accorded complete discretion to the comptroller-general of patents, designs, and trademarks to refuse registration to a trademark where the use of the mark would, in his opinion, be contrary to law and morality. *Id.* at 696.

<sup>128</sup> *Id.* at 681-83, 688-97, 700-01, 703-05 (based upon Browne's summary of the relevant statutes). Countries that only prohibited scandalous marks are Brazil, Germany, and Great Britain, whereas the Netherlands, Norway, Sweden, and Switzerland prohibited marks based upon morality. *Id.*

<sup>129</sup> S. EXEC. DOC. NO. 52-149, at 495 (1893).

<sup>130</sup> BROWNE II, *supra* note 29, at 682.

<sup>131</sup> *See id.* at 683-85. According to the Denmark Law, "Registration of the declaration shall be refused . . . [i]f it contains objects calculated to provoke public scandal." *Id.* at 684.

<sup>132</sup> *See* text accompanying *supra* note 54.

<sup>133</sup> BROWNE II, *supra* note 29, at 700.

<sup>134</sup> S. DOC. NO. 56-20, at 40 (1902) (referred to the Committee on Patents on December 4, 1900).

<sup>135</sup> *Id.* at 42-43, 55 (noting that the provisions in article 6 of the Paris Convention are essentially French in origin and that some countries prohibit registration of "marks not

included a prohibition against “[a] mark contrary to good morals.”<sup>136</sup> After summarizing United States trademark history, the dissenting Commissioner, Arthur P. Greeley, proposed prohibiting any mark that “[c]onsists of or comprises immoral or scandalous matter,”<sup>137</sup> which is the precise language included in the 1905 Act.<sup>138</sup> Notably, Greeley specifically incorporated his keen awareness of foreign trademark law, based upon the “comparative study of [f]oreign [p]atent and [t]rademark [l]aws” that he published just prior to 1905.<sup>139</sup>

The ultimate language included in the 1905 Act can fairly be described as a broad version of the various scandalous prohibitions enacted by other countries, and it also included several additional prohibitions that appeared in the registration regimes of other countries.<sup>140</sup> The breadth of the Act indicates that the United States examined the laws in other jurisdictions and then created the broadest protection for its own citizens. Certainly, Congress enacted the 1905 Act in a trademark landscape, both in the United States common law and abroad, that steered it towards including a prohibition on scandalous and immoral marks.<sup>141</sup>

### III. THE SCANDALOUS REGISTRATION PROHIBITION

#### A. *Marks that Contain Scandalous Matter*

One would imagine that, shortly after enacting the 1905 Act, someone would endeavor to explain the new registration prohibition on scandalous matter. Yet, trademark treatises and

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subject to the rules of good morals”).

<sup>136</sup> *Id.* at 66.

<sup>137</sup> Act of Feb. 20, 1905, ch. 592, § 5(a), 33 Stat. 724, 725.

<sup>138</sup> S. DOC. NO. 56-20, at 130.

<sup>139</sup> GREELEY, *supra* note 61, at preface. In 1905, Greeley’s credentials included membership in the Patent Law Association of Washington, membership in the commission to revise patent and trademark laws, membership in the American Bar Association, and serving as Assistant Commissioner of Patents. *Id.* at tit. p. In notes explaining the proposed prohibitions, Greeley only mentions that the purpose of the section was to provide for registration of all marks that the Supreme Court would hold as capable of being trademarks. S. DOC. NO. 56-20, at 130. As discussed *supra* Part II.B.1, however, there was no definitive and preexisting Supreme Court case law that prohibited registration of marks that consist of or comprise immoral or scandalous matter, and the Commissioner’s majority report indicates that foreign law had a significant influence upon the Commission.

<sup>140</sup> S. EXEC. DOC. NO. 51-57, 60 illus. (1890). Canada, the other country that expressly included scandal and immorality in its prohibition, limited it to scandalous or immoral “figures” rather than scandalous and immoral matter. BROWNE II, *supra* note 29, at 682.

<sup>141</sup> Of course, one cannot say that American law exactly mapped foreign law, as there were often contradictions even among different foreign jurisdictions. For example, as pointed out by Browne, France would accept arbitrary words as valid marks, but Germany refused registration of word marks. BROWNE II, *supra* note 29, at 105.

manuals published shortly thereafter shied away from discussing the scandalous registration prohibition even while discussing various other restrictions.<sup>142</sup> Therefore, to determine what constituted “scandalous,” courts turned to dictionary definitions to give the term its ordinary and common meaning and, once available, to prior court and administrative decisions.<sup>143</sup> By 1938, the Court of Customs and Patent Appeals, an early trademark appellate body, defined “scandalous” as “shocking to the sense of propriety or call out condemnation.”<sup>144</sup> Under this definition, various entities have considered at least six categories of marks as potentially including scandalous material: political imagery; religious terms and icons; race, gender, and sexual orientation; sexual matter (vulgar); profanity (vulgar); and illegality.

### 1. Political Imagery

While not expressly relying upon the scandalous registration prohibition, the first true consideration of the scandalous registration prohibition occurred in a 1909 decision, in which the PTO refused to register the portrait and signature of Grover Cleveland as a trademark for cigars.<sup>145</sup> The applicant had a signed letter from President Cleveland authorizing use of his name as a trademark.<sup>146</sup> Despite believing that that 1905 Act did not expressly prohibit such marks, the PTO refused the registration, stating that the mark’s use detracted from presidential dignity and thus was against public policy.<sup>147</sup> In a subsequent decision, the PTO speculated that the true basis for rejecting the Cleveland mark was because the mark was scandalous as it was “offensive to good taste.”<sup>148</sup> In another decision, however, the PTO reached the opposite conclusion when evaluating an application to register Thomas Jefferson’s portrait for certain electrical apparatuses, finding that the mark was not scandalous.<sup>149</sup>

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<sup>142</sup> For example, a 1911 trademark manual written for businessmen, addresses numerous prohibitions, including several that are not on the face of the 1905 Act, such as the prohibition against registration of the Red Cross insignia, but does not discuss what may constitute a scandalous mark. J. WALTER THOMPSON COMPANY, THINGS TO KNOW ABOUT TRADE-MARKS: A MANUAL OF TRADE-MARK INFORMATION 3, 26-42 (1911).

<sup>143</sup> See *In re McGinley*, 660 F.2d 481, 485-86 (C.C.P.A. 1981); *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938).

<sup>144</sup> *Riverbank Canning Co.*, 95 F.2d at 328; see also *McGinley*, 660 F.2d at 485 n.10 (noting that Congress did not change or clarify the scope of the prohibition when it revised the Lanham Act nearly eight years later).

<sup>145</sup> *Ex parte* Banner Cigar Mfg. Co., 1909 C.D. 9, 10.

<sup>146</sup> *Ex parte* Jefferson Elec. Mfg., 1917 C.D. 71, 71-72. The PTO may have questioned the validity of the letter as it was dated 1900, but the applicant did not submit his trademark application until after President Cleveland had died in 1908. *Id.* at 72.

<sup>147</sup> *Ex parte* Banner Cigar Mfg. Co., 1909 C.D. at 10.

<sup>148</sup> *Ex parte* Jefferson Elec. Mfg., 1917 C.D. at 72.

<sup>149</sup> *Id.* at 71.

One of the earliest reported decisions expressly relying upon the scandalous registration prohibition was in 1938, when the PTO rejected an application for the mark QUEEN MARY (and design) to be used on underwear.<sup>150</sup> The PTO found the mark scandalous because it associated the name of the Dowager Queen of England with women's undergarments.<sup>151</sup> Either demonstrating reluctance on the PTO's part to reject such marks, or reluctance on the applicants' part to appeal rejections, the next decision involving political images did not occur until 1993. In *In re Old Glory Condom Corp.*, an applicant attempted to register a mark consisting of OLD GLORY CONDOM CORP. with the design element of a condom decorated with American flag-like stars and stripes for use on prophylactics.<sup>152</sup> The PTO initially refused to register the mark because it connected the "sacrosanct" symbol of the flag with condoms and sexual activity.<sup>153</sup> Upon appeal, the application was approved, in large part, because the applicant stated on its condom packages that having safer sex and eliminating AIDS is a patriotic act.<sup>154</sup> The PTO expressed great reluctance to quash this form of political speech even if some Americans may have considered it improper.<sup>155</sup>

While political images were the first category of material prohibited under the scandalous registration, the current approach of protecting political speech makes it highly unlikely that subsequent trademark applications would be prohibited as scandalous or immoral simply due to political imagery. This shift may reflect a changing social norm regarding the appropriateness of critiquing political images. Further, objections to certain recent trademark registration applications, such as AL QAEDA, do not rebut this shift.<sup>156</sup> The PTO has made clear that such marks are rejected due to their association with terrorism, and thus illegality,

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<sup>150</sup> *See Ex parte* Martha Maid Mfg. Co., 37 U.S.P.Q. (BNA) 156 (Comm'r Pat. 1938).

<sup>151</sup> *Id.*

<sup>152</sup> *In re* Old Glory Condom Corp., 26 U.S.P.Q.2d (BNA) 1216 (T.T.A.B. 1993).

<sup>153</sup> *Id.*

<sup>154</sup> *Id.* at 1216-20.

<sup>155</sup> *Id.*

<sup>156</sup> AL-QAEDA, U.S. Trademark Serial No. 78/444,968 (filed July 1, 2004), Office Action from William Breckenfeld, Trademark Attorney, to Jon Messner (Nov. 22, 2004) (rejecting the application because "al Qaeda" refers to an organization that undertakes the bombing of civilians and other terrorist acts that are shocking to the sense of decency); *see also* OBAMA BIN LADEN, U.S. Trademark Serial No. 77/086,418 (filed January 19, 2007), Office Action from Karen K. Bush, Trademark Attorney, to Alexandre Battle (Feb. 6, 2007) (initially refusing registration because, among other things, it references a terrorist and because it associates a United States presidential candidate with that terrorist); BABY AL-QAEDA, U.S. Trademark Serial No. 78/400,213 (filed April 12, 2004), Office Action from William Breckenfeld, Trademark Attorney, to John A. Race (Feb. 23, 2005).

rather than any political speech.<sup>157</sup>

Notably, it took decades to effectuate the changing social norms into trademark policy regarding registrability. More importantly, this aspect of the scandalousness standard moved from being more restrictive to more permissive, giving ample notice to trademark owners regarding the kind of marks that will be excluded as scandalous due to political content.

## 2. Religious Terms and Icons

As the pre-1905 common law suggested, the PTO also applied scandalous registration prohibition to protect religions. While it would be logical to evaluate these terms for “immorality,” the decisions discuss the matter in terms of scandalousness. Unlike the common law discussion of immoral businesses, these decisions involve situations where the mark itself contains religiously significant terms, names, or images.

In 1938, the Court of Customs and Patent Appeals considered whether the mark MADONNA is scandalous when used in connection with wine.<sup>158</sup> The majority, finding the application scandalous, associated MADONNA with the Virgin Mary in Christianity, which “stands as the highest example of the purity of womanhood, and the entire Christian world pays homage to her as such.”<sup>159</sup> In contrast, it described intoxicating liquors as causing various “evils,” as indicated by national prohibition, state regulation and prohibition, and a Supreme Court decision decrying the evils of alcohol.<sup>160</sup> While conceding that the mark MADONNA is not *per se* scandalous or immoral, the court noted and quickly dismissed any positive Biblical references to the consumption of wine and the connection between wine and the Virgin Mary.<sup>161</sup>

One may attribute the caustic *Riverbank Canning Co.* majority opinion to its apparent support of prohibition, which had been repealed in 1933 by the Twenty-first Amendment to the United States Constitution.<sup>162</sup> Moreover, one might assume that, due to changing social norms, a similar mark for alcoholic goods would

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<sup>157</sup> *Id.*

<sup>158</sup> *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938). As the dissent noted, the mark MADONNA and pictorial representations of the Virgin Mary had already been registered numerous times in connection with various goods, including tooth powder, cold cream, and food. *Id.* at 329-30. In fact, the applicant had previously registered two forms of the MADONNA mark for various food items. *See* U.S. Trademark No. 186,786 (filed Jan. 30, 1924); U.S. Trademark No. 342,537 (filed Aug. 14, 1936).

<sup>159</sup> *Riverbank Canning Co.*, 95 F.2d at 329. The court relied upon little evidence to support its conclusions regarding the public’s perception of Virgin Mary. *See id.* at 328-29.

<sup>160</sup> *Id.* at 329 (citing *Crane v. Campbell*, 245 U.S. 304, 307 (1917)).

<sup>161</sup> *Id.*

<sup>162</sup> U.S. CONST. amend. XXI, § 1.

not automatically be refused registration decades later on the same grounds. Yet, the Trademark Trial and Appeal Board (TTAB), the appellate forum for PTO decisions, applied the same reasoning in 1959 to another application for the use of MADONNA in connection with wine,<sup>163</sup> and again in 1968 to find the mark MESSIAS, equivalent to the term Messiah, scandalous when associated with wine and brandy.<sup>164</sup> Rather than undertake any assessment of changing social norms, the TTAB simply relied upon its prior decision. As with the political imagery category, the decisions indicate that the PTO tends to be slow in adjusting for social norms. Once the PTO has classified a particular word or phrase as scandalous, it seems likely to continue excluding the word or phrase as scandalous for far longer than may be strictly necessary under society's standards.

The *In re Riverbank Canning Co.* decision appears to be driven by the idea that religious terms and images should be refused trademark status when paired with an "inappropriate" good as determined by the relevant religion. Several subsequent decisions applied the same standard. Thus, when a trademark applicant attempted to register SENUSSI for cigarettes, the TTAB refused registration because of the specific religious tenets associated with the "Senussi," a Muslim sect which forbids smoking cigarettes.<sup>165</sup> On the other hand, the TTAB allowed registration for the mark AMISH (with picture) for cigars and cigar boxes because Amish religious principles do not forbid cigars and tobacco.<sup>166</sup>

Taking this approach one step further, the PTO has considered whether a religious term has a secular meaning that the public would be more likely to associate with the mark than the religious term. For example, the TTAB allowed registration for MOONIES (with a buttocks design) in connection with a doll that apparently drops its pants ("mooning" the audience).<sup>167</sup> The decision focused on the mark's design elements and associated good as emphasizing the non-religious meaning of the term. The TTAB also recognized that the term "Moonies" appears to be an accepted, rather than derogatory, term for members of The Unification Church.<sup>168</sup>

The only exception to this trend occurred in 1943, when the

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<sup>163</sup> See *In re P.J. Valckenberg, GmbH*, 122 U.S.P.Q. (BNA) 334 (T.T.A.B. 1959).

<sup>164</sup> See *In re Sociedade Agricola E. Comercial Dos Vinhos Messias, S.A.R.L.*, 159 U.S.P.Q. (BNA) 275, 275-76 (T.T.A.B. 1968).

<sup>165</sup> *In re Reemtsma Cigarettenfabriken G.m.b.H.*, 122 U.S.P.Q. (BNA) 339 (T.T.A.B. 1959) (noting that use of the mark would disparage the Muslim sect).

<sup>166</sup> *In re Waughtel*, 138 U.S.P.Q. (BNA) 594, 594-95 (T.T.A.B. 1963).

<sup>167</sup> *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1653-54 (T.T.A.B. 1990).

<sup>168</sup> *Id.* at 1654 n.4.



PTO refused registration for the mark AGNUS DEI (and picture) used for metallic tabernacle safes.<sup>169</sup> Regardless of the religious character of the associated goods and the fact that Catholic clergy were apparently not offended, the PTO found it offensive to “commercialize an emblem of such highly sacred religious significance.”<sup>170</sup> This *per se* position against the commercialization of religious terms and images is similar to the position Browne took in his pre-1905 treatise. Yet, perhaps because the general public cannot possibly know the religious terms and beliefs of every religion, most decisions now only consider whether the relevant religion prohibits the associated goods or whether those who practice the relevant religion would be offended.

### 3. Race, Gender, and Sexual Orientation

Marks evaluated for scandalousness due to their connection to race, gender, and sexual orientation are evaluated in a similar manner to marks associated with religious terms and images.<sup>171</sup> Of race, gender, and sexual orientation, the most prominently discussed category is race, due to the *Harjo v. Pro-Football, Inc.* cancellation action. In *Harjo*, a group of Native Americans sought to cancel all registrations containing the term “redskins” owned by the Washington Redskins football team as scandalous, disparaging, or bringing the relevant group “into contempt or disrepute.”<sup>172</sup> The TTAB ultimately found that, even though the term “redskins” was a derogatory term, the marks were not scandalous to a substantial composite of the general population.<sup>173</sup> When

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<sup>169</sup> See *Ex parte* Summit Brass & Bronze Works, Inc., 59 U.S.P.Q. (BNA) 22 (Comm’r Pat. 1943).

<sup>170</sup> *Id.* at 23. Agnus Dei translates to Lamb of God and is significant in Catholic masses. As Browne suggested, the PTO held in the alternative that the mark was incapable of trademark significance—it could not serve as an adequate source-identifier. *Id.*

<sup>171</sup> While there have been no appellate decisions regarding sexual orientation, it certainly seems that certain marks have had difficulty registering because they refer to sexual orientation. See, e.g., DYKES ON BIKES, U.S. Trademark Serial No. 78/281,746 (filed July 31, 2003); Office Action from Sharon A. Meier, Trademark Attorney, to Brooke Oliver (Feb. 20, 2004) (DYKES ON BIKES initially refused for registration on the basis of disparagement, was eventually allowed for publication and is currently involved in an opposition); FAG, U.S. Trademark Serial No. 78/164,481 (filed Sept. 16, 2002), Office Action from Nora Buchanan Will, Trademark Attorney, to Peter P. Michaud (initially refused registration as scandalous and derogatory and eventually abandoned).

Although similar objections could (and should) be raised based upon gender, the objection is not always raised. Compare SHOE WHORE, U.S. Trademark Reg. No. 2,959,584 (filed Jan. 9, 2004) (no objection) and BIKER BITCH, U.S. Trademark Reg. No. 2,828,348 (filed Mar. 4, 2002) (no objection), with DE PUTA MADRE, U.S. Trademark Serial No. 78/827,324 (filed Mar. 2, 2006) (“The direct translation [of DE PUTA MADRE,] ‘WHORE MOTHER’S’ . . . also comprises derogatory, scandalous matter.” Letter from Nelson B. Snyder III, Trademark Examining Attorney, to Howard N. Aronson).

<sup>172</sup> *Pro-Football, Inc., v. Harjo*, 284 F. Supp. 2d 96, 99 (D.D.C. 2003).

<sup>173</sup> *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1748-49 (T.T.A.B. 1999), *rev’d*, 284 F. Supp. 2d 96 (D.D.C. 2003).

evaluating disparagement, the TTAB appropriately applied a narrower standard than that of scandalous; the relevant standard is the perceptions of the (purportedly) disparaged group rather than those of the general public.<sup>174</sup>

It seems unlikely that a mark would be perceived as scandalous by the general public but fail to be perceived as disparaging or derogatory by a substantial composite of the targeted group. Moreover, because these terms are the kind that may take the general public more time to be recognized as offensive, inclusion of these marks within the scandalous standard has simply served to obfuscate the appropriate standard and consistency in evaluating scandalous marks. Both these marks and those containing religious terms and images have a limited reference group and thus should more properly be evaluated under the disparagement portion of 15 U.S.C. § 2(a) rather than under the scandalous registration prohibition.

#### 4. Sexual Matter (Vulgar)

One of the more significant categories of marks evaluated under the scandalous registration prohibition includes marks that are connected to sexual material. The decisions discussing these marks are, however, some of the most inconsistent and unpredictable. The first reported decision occurred in 1952 when Parfum L'Orle applied to register the mark LIBIDO for perfumes and toilet water.<sup>175</sup> The Examiner originally rejected the application because the word "libido" refers to sexual desire, but the Commissioner summarily reversed the Examiner, declaring the mark unlikely to be shocking.<sup>176</sup>

The next decision was in 1971, when the TTAB refused registration for BUBBY TRAP as scandalous based upon two essential facts: the mark was applied to brassieres, and "bubby" was defined as a vulgar term for breast.<sup>177</sup> Without significant analysis, discussion, or identification of the relevant segment of the population, the TTAB held that the mark would be offensive to a segment of the population.<sup>178</sup>

A mere two years later, however, the TTAB allowed registration of a much more explicit mark, WEEK-END SEX for a

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<sup>174</sup> See *id.* at 1738-39; see also *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d (BNA) 1264 (T.T.A.B. 2006); see generally *In re Mothers and Fathers Italian Ass'n*, 2000 TTAB LEXIS 52 (Feb. 11, 2000); *In re Undeas, Inc.*, 2000 TTAB LEXIS 39 (Jan. 28, 2000).

<sup>175</sup> See *Ex parte Parfum L'Orle, Inc.*, 93 U.S.P.Q. (BNA) 481 (P.T.O. 1952).

<sup>176</sup> *Id.*

<sup>177</sup> *In re Runsdorf*, 171 U.S.P.Q. (BNA) 443, 443-44 (T.T.A.B. 1971).

<sup>178</sup> *Id.*

magazine.<sup>179</sup> The TTAB subsequently also allowed registration of a drawing consisting of a sad, naked male apparently staring at his genitalia to be used for a corrective implement to increase human penis size.<sup>180</sup> The TTAB not only considered the mark appropriate in light of the goods and contemporary social norms but also seemed to be swayed by the fact that the mark was a drawing rather than a photograph.<sup>181</sup> The use of a drawing may explain the entirely different result in *In re McGinley*, concerning a photograph of a nude man and woman kissing and embracing for a sex-oriented newsletter and swinger-related services.<sup>182</sup> It would appear that the mark in *McGinley* was nothing more than an extension of the marks considered in the prior two decisions and, thus, should have been allowed to be registered. To the contrary, the TTAB rejected the application.<sup>183</sup> Based upon the rather limited factual analysis, one can only conclude that the photograph was rejected because the majority believed that it exposed part of the male genitalia, a risk that is less likely with a drawing.<sup>184</sup>

In the more recent era, the TTAB has allowed registration of marks that have both vulgar and non-vulgar meanings. Thus, the TTAB allowed registration of BIG PECKER BRAND for clothing even though one of the numerous definitions for “pecker” is penis (vulgar); the TTAB’s decision was influenced by a dictionary notation that the vulgar definition was becoming archaic.<sup>185</sup> Not only did the TTAB find the primary meaning of “pecker” to be an innocuous one related to birds, but the TTAB also relied upon the specimens in the trademark application as reinforcing the innocuous definition by using the mark with a bird image.<sup>186</sup> Likewise, the Federal Circuit expressed great skepticism that the term BLACK TAIL, used for an adult entertainment magazine featuring African-American women, would be considered scandalous because of its non-vulgar definition.<sup>187</sup> The most

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<sup>179</sup> *In re Madsen*, 180 U.S.P.Q. (BNA) 334, 334-35 (T.T.A.B. 1973).

<sup>180</sup> *In re Thomas Labs., Inc.*, 189 U.S.P.Q. (BNA) 50, 50-52 (T.T.A.B. 1975).

<sup>181</sup> *Id.* at 52.

<sup>182</sup> *In re McGinley*, 660 F.2d 481, 482 (C.C.P.A. 1981). As the applicant noted, numerous works of art, such as Michelangelo’s David, are far more explicit than the proposed mark. *See id.* at 483.

<sup>183</sup> *Id.*

<sup>184</sup> *Id.* at 487 (Rich, J., dissenting) (finding that the application should not be barred because the male genitalia are not exposed).

<sup>185</sup> *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470, 1471 (T.T.A.B. 1988).

<sup>186</sup> *Id.* at 1472.

<sup>187</sup> *In re Mavety Media Group, Ltd.*, 33 F.3d 1367, 1368-69, 1375 (Fed. Cir. 1994). After the Federal Circuit remanded the matter for greater factual development, the PTO allowed the mark to publish. Subsequently, two individuals raised an opposition, which eventually focused upon disparagement rather than scandalousness. *Boswell v. Mavety Media Group Ltd.*, 52 U.S.P.Q.2d (BNA) 1600, 1602, 1604 (T.T.A.B. 1999). The TTAB

extreme example of this trend, however, is the TTAB's decision related to the mark TWATTY in connection with a cartoon strip.<sup>188</sup> Although the term "twat" is accorded only one vulgar meaning, the TTAB relied on comparatively weak evidence to find that the term "twatty" not only looks different from "twat" but also has a non-vulgar meaning.<sup>189</sup> Because the TTAB was uncertain whether the term "twatty" would be accorded a non-vulgar meaning, the TTAB allowed registration.<sup>190</sup>

In stark contrast, other marks have been refused registration because the TTAB accords the term only one meaning, or only one generally known meaning, and that meaning is vulgar. The Federal Circuit affirmed the registration refusal for 1-800-JACK-OFF and JACK-OFF in connection with adult entertainment services.<sup>191</sup> The term "jack off" is accorded only vulgar meanings, which was reinforced by applicant's use of the word to relate to masturbation.<sup>192</sup> Thus, the court found it appropriate to refuse registration. Likewise, even though some scientists or other subsets of the population may have recognized a non-vulgar meaning, the TTAB refused registration of THE BEARDED CLAM for restaurant services because the general population would only be acquainted with the vulgar meaning.<sup>193</sup> In addition to the inconsistency between these two cases and, for example, the TWATTY matter, these last two cases also demonstrate an inconsistency as to whether the PTO will use a *per se* standard or will examine extrinsic considerations. Despite espousing doubt that there is a non-vulgar meaning, the Federal Circuit evaluated the JACK OFF marks in the context of the associated services and advertisements to find that the applicant was directing the public to the vulgar meaning.<sup>194</sup> In contrast to the TWATTY matter, the TTAB brushed off evidence that clams do have a feature called a beard and determined the matter solely upon the mark, THE BEARDED CLAM, without considering whether the services would direct the general public to the non-vulgar understanding.<sup>195</sup>

## 5. Profanity (Vulgar)

A slightly different category of vulgar terms are those that are

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allowed the mark to be registered. *Id.* at 1605-09.

<sup>188</sup> *In re Watkins*, 2005 TTAB LEXIS 66 (Feb. 8, 2005).

<sup>189</sup> *Id.* at \*1-2, \*10-12.

<sup>190</sup> *Id.* at \*12.

<sup>191</sup> *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1339 (Fed. Cir. 2003).

<sup>192</sup> *Id.*

<sup>193</sup> *In re Douglas*, 2004 TTAB LEXIS 524, at \*10-13 (Sept. 7, 2004) (finding that the general public would likely only know the vulgar definition).

<sup>194</sup> *Boulevard*, 334 F.3d at 1339.

<sup>195</sup> *Douglas*, 2004 TTAB LEXIS 524, at \*10-14.

considered profane. As with marks relating to sexual matter, these decisions are inconsistent.

The first relevant decision evaluated whether BADASS was registrable for stringed musical instruments; the PTO Examiner used a dictionary to define “bad” and “ass” and refused the mark for registration.<sup>196</sup> The TTAB reversed, relying upon the applicant’s alternate explanation that the term was an acronym and the fact that the unitary mark was not a profane term and only a limited portion of the population would recognize “badass” as including the profanity “ass.”<sup>197</sup> In doing so, the TTAB appeared to apply a presumption that, if there is an alternate explanation to justify the profane word, the mark will not be rejected as scandalous. Thus, the TTAB allowed registration of FRIGGIN’ in connection with refrigerator magnets because the PTO failed to establish that a substantial composite of the purchasing public would regard the mark as scandalous; in so holding, the PTO recognized that the innocent, alternate explanation was a “stretch,” and most definitions accorded a vulgar connotation to the term.<sup>198</sup>

In other decisions, however, marks containing profanity have been assessed on more of a *per se* standard, meaning that the refusal is not influenced by any factors extrinsic to the mark itself. For example, when considering an application for BULLSHIT for personal accessories, the TTAB rejected the applicant’s argument that the mark satirized the use of designers’ names on the outside of accessories and that the term “bullshit” has a non-profane meaning in contemporary dictionaries.<sup>199</sup> Using the substantial composite of the general public standard, the TTAB refused registration because it determined that the mark would give offense to the composite’s conscious or moral feelings.<sup>200</sup> The TTAB also refused registration of REALLY GOOD SHIT in connection with oil for automotive, marine, industrial, residential, and sporting use solely because the term “shit” is vulgar.<sup>201</sup>

As with other vulgar marks, one cannot find consistency in the approach to profane marks as the examining body has

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<sup>196</sup> *In re* Leo Quan Inc., 200 U.S.P.Q. (BNA) 370, 371 (T.T.A.B. 1978).

<sup>197</sup> *Id.*

<sup>198</sup> *In re* Friggin Barnyard, 1999 TTAB LEXIS 108, at \*8-16 (Mar. 30, 1999).

<sup>199</sup> *In re* Tinseltown, Inc., 212 U.S.P.Q. (BNA) 863, 864, 866 (T.T.A.B. 1981); *see also In re* Red Bull, GmbH, 78 U.S.P.Q.2d 1375, 1381 (T.T.A.B. 2006) (noting that a *per se* standard was applied in the *Tinseltown* decision).

<sup>200</sup> *Tinseltown*, 212 U.S.P.Q. (BNA) at 865; *see also Red Bull, GmbH* 78 U.S.P.Q.2d at 1382 (finding that the mark BULLSHIT is still scandalous).

<sup>201</sup> *In re* R.G.S. Group, Ltd., 1997 TTAB LEXIS 293, at \*1 (Mar. 5, 1997). The TTAB also refused registration for various marks containing the term SCHITTHED for beer. *In re* Frankel, 2002 TTAB LEXIS 250 (Mar. 29, 2002).

occasionally used a contextual approach. Thus, the TTAB looked to the context of the mark and associated goods to determine that “asshole” in THE COMPLETE A\*\*HOLE’S GUIDE TO . . . clearly referred to the vulgar definition of a person rather than the potentially non-vulgar definition of an anatomical part.<sup>202</sup>

Applications containing images involving profanity have received equally inconsistent treatment. Thus, for example, the TTAB had little difficulty in refusing an application consisting of a dog defecating and feces as a mark to use on clothing.<sup>203</sup> On the other hand, the TTAB allowed registration, in a split decision, for BAD BEER FROG, with a design described as a frog “giving the finger,” a vulgar gesture usually understood to mean “fuck you.”<sup>204</sup> The majority based its decision upon uncertainty that the frog was raising a middle finger (given that it only has four fingers) and the fact that “giving the finger” may not be scandalous.<sup>205</sup> The dissent was understandably incredulous at the majority’s reasoning, particularly given the numerous news articles identifying this specific mark as a frog giving people an obscene gesture.<sup>206</sup> Regardless, the mark was issued a registration.

## 6. Illegality

It is consistent with the pre-1905 common law and legal scholars to find scandalous any mark that expressly refers to illegal activity.<sup>207</sup> While there is a paucity of reported, relevant decisions, there are two cases involving terms or images associated with marijuana, and in both, the marks were approved for registration. In *In re Hepperle*, the PTO Examiner initially refused an application for ACAPULCO GOLD for suntan oil because the term “Acapulco Gold” was commonly understood to mean marijuana.<sup>208</sup> Upon appeal, the TTAB considered the term in light of the associated goods and determined that the average suntan oil purchaser would associate the term with the resort city of

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<sup>202</sup> *In re Zaharoni*, 2005 TTAB LEXIS 3, at \*1, \*8 (Jan. 4, 2005).

<sup>203</sup> *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1638-39 (T.T.A.B. 1988). Likewise, the TTAB quickly rejected any innocuous interpretations of the mark DICK HEAD’S for restaurant services when it was paired with an image of male genitalia fashioned to resemble a head. *In re Wilcher Corp.* 40 U.S.P.Q.2d (BNA) 1929, 1933-34 (T.T.A.B. 1996). Apparently, the applicant commonly combined the mark with the phrase “GIVE ME HEAD . . . TILL I’M DEAD,” which reinforced the scandalous interpretation. *Id.* at 1932-33.

<sup>204</sup> *In re Bad Frog Brewery, Inc.*, 1999 TTAB LEXIS 86, at \*1-2, \*20-21 (Mar. 16, 1999).

<sup>205</sup> *Id.* at \*3-6, \*8 (arguing that the finger may be meaningless unless it is directed at a particular person and that the gesture may be socially acceptable).

<sup>206</sup> *Id.* at \*9-29.

<sup>207</sup> See *supra* Part II.B.

<sup>208</sup> *In re Hepperle*, 175 U.S.P.Q. (BNA) 512 (T.T.A.B. 1972).

Acapulco, Mexico rather than an illegal substance.<sup>209</sup> In *Schlage Lock v. Staiano*, the TTAB considered a design mark consisting of the term KRYPTOKING beneath an image of a plant with three leaves for various clothing, accessories, and smoking related items.<sup>210</sup> The TTAB rejected the argument that the mark should be prohibited as scandalous, noting that the depicted leaves may be aloe leaves rather than marijuana leaves, the associated goods in the trademark application are legal, and the word “taking” was not prominent in the word KRYPTOKING.<sup>211</sup>

On the other hand, the TTAB refused registration for W.B. WIFE BEATER for clothing.<sup>212</sup> Even when defined as a style of shirt, the TTAB found that the term clearly evokes connotations of spousal abuse.<sup>213</sup> Thus, the mark was refused registration as scandalous.

### B. *Current Standard for Scandalous Marks*

Over the last 100 years, various standards have been applied to terms classified as scandalous marks—from a *per se* scandalous standard to one evaluating whether a targeted segment of the population would consider the mark scandalous and eventually to a standard evaluating whether a substantial composite of the general public would consider the mark scandalous in light of its context. Part of the difficulty in finding a single standard is that there are really two different categories of marks at issue: marks where the negative implication is addressed to a specific subset of the population and marks where the question is whether the general population would react negatively. Marks falling in the first category include those relating to religious organizations, gender or racial groups, and sexual orientation. The concern raised by these marks is the negative effect the terms have upon the targeted group. Thus, it is more appropriate to consider these marks under section 2(a)’s disparagement standard.<sup>214</sup>

For those marks considered under the scandalous registration prohibition, the question still remains as what the standard should be. At least in name, the majority of recent decisions have adopted the Federal Circuit’s articulation in *In re Boulevard Entertainment*:

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<sup>209</sup> *Id.* Although the mark survived the scandalousness objection, it was still refused registration as likely to cause confusion with a preexisting registration of ACAPULCO for makeup. *Id.*

<sup>210</sup> *Schlage Lock Co. v. Staiano*, 2005 TTAB LEXIS 543, at \*1 (Dec. 12, 2005).

<sup>211</sup> *Id.* at \*24-25.

<sup>212</sup> *In re Love Bottling Co.*, 2005 TTAB LEXIS 261 (June 22, 2005).

<sup>213</sup> *Id.* at \*20-21.

<sup>214</sup> *See supra* Parts III.A.2-3.

[T]he PTO must consider the mark in the context of the marketplace as applied to the goods described in the application for registration. In addition, whether the mark consists of or comprises scandalous matter must be determined from the standpoint of a substantial composite of the general public (although not necessarily a majority), and in the context of contemporary attitudes, keeping in mind changes in social mores and sensitivities.<sup>215</sup>

This has been applied as a two-step test where the examining body must first determine the likely meaning of the mark and then evaluate if a substantial composite of the general public finds the mark scandalous.<sup>216</sup>

Regardless of whether the examining body purported to apply this standard or any other, the examining bodies over the past century have moved back and forth between applying a *per se* approach and applying a contextual approach. This schizophrenic movement likely reflects courts' dissatisfaction or subconscious rejection of attempts to force all scandalous marks into the traditional trademark mold, namely, one where trademarks are accorded rights (or given meaning) only in the context of the associated goods or services.

### C. *Justifications for Enacting a Scandalous Registration Prohibition*

Given the inconsistent manner in which examining bodies have evaluated scandalousness, one may attempt to harmonize the decisions by resorting to the underlying purpose for which Congress enacted the registration prohibition. Interestingly, at least one contemporary of the 1905 Act considered the prohibition's justification to be "obvious," but then failed to further articulate this "obvious" reason.<sup>217</sup> Subsequent commentators and the courts have postulated two potential justifications for enacting the scandalous registration: avoiding the appearance of government imprimatur and protecting government resources. Neither sufficiently explains this particular exception to trademark registration rights.

One justification for barring registration of scandalous and immoral matter is to avoid giving an "implied approval" of the mark.<sup>218</sup> This concern likely arose from the perception that

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<sup>215</sup> See, e.g., *Schlage Lock*, 2005 TTAB LEXIS 543, at \*22-23 (quoting *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1339 (Fed. Cir. 2003)).

<sup>216</sup> LALONDE, *supra* note 13, § 3.04[6][a][i][A].

<sup>217</sup> TRADE MARKS = TRADE NAMES: FOR THE BUSINESS MAN 25 (1912) ("For obvious reasons, scandalous or immoral matter is refused registration.").

<sup>218</sup> *In re McGinley*, 660 F.2d 481, 483 (C.C.P.A. 1981); see also *Ritchie v. Simpson*, 41 U.S.P.Q.2d (BNA) 1859, 1861-62 (T.T.A.B. 1997), *rev'd on other grounds*, 170 F.3d 1092 (Fed. Cir. 1999) ("[J]ust as the issuance of a registration does not indicate any



trademark registration is evidence that the mark is proper and *lawful*, leading the public to perceive government approval of any mark with a federal registration.<sup>219</sup> Despite the purported concerns of creating a government imprimatur, by 1993, this justification fell somewhat from favor.<sup>220</sup> The TTAB noted:

Just as the issuance of a trademark registration by this Office does not amount to a government endorsement of the quality of the goods to which the mark is applied, the act of registration is not a government imprimatur or pronouncement that the mark is a “good” one in an aesthetic, or any analogous, sense.<sup>221</sup>

This shift likely reflects recognition of an increasingly sophisticated general public.

To a certain degree, however, the fear of government imprimatur is rooted in the registration system. Allowing a mark to register indicates that the government either did not find the mark to be scandalous in its evaluation or had such doubt as to the scandalous nature that it waited to see if anyone in the general public would contest the registration.<sup>222</sup> Thus, in some sense, the PTO does give the public the impression that the government reviewed the registered mark and found it unlikely to be scandalous or immoral.

However, if the scandalous registration prohibition is to avoid government imprimatur, then it would seem that the PTO has been a poor caretaker of that task. As with all other prohibitions, when the PTO is in doubt, it allows the mark to proceed to publication with the notion that, if someone found the mark to be offensive, that person would raise an objection or bring a cancellation action.<sup>223</sup> If the true justification for prohibiting scandalous marks was the fear of giving government imprimatur, then it would be more appropriate to apply the reverse presumption, prohibiting the PTO’s registration of any mark that *may* have scandalous or immoral matter, even if the PTO is doubtful about that conclusion.

As an alternative justification, the Court of Customs and Patent Appeals postulated that the scandalous registration prohibition reflects “a judgment by the Congress that such marks

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endorsement of the goods on which the mark is used, it also does not imply the government’s pronouncement that the mark is a good one, from an aesthetic or any other viewpoint.”).

<sup>219</sup> See RICHARDS & WHITE, *supra* note 50, at 92.

<sup>220</sup> See, e.g., *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1220 n.3 (T.T.A.B. 1993).

<sup>221</sup> *Id.*

<sup>222</sup> *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654-55 (T.T.A.B. 1990).

<sup>223</sup> *Id.*

not occupy the time, services, and use of funds of the federal government.”<sup>224</sup> In other words, government resources should not be “wasted” in protecting scandalous material,<sup>225</sup> a justification that is still rooted in judging the value, or lack thereof, of scandalous marks. However, a registration prohibition that is uncertain in scope and application does not avoid “wasting” government resources. To the contrary, one may speculate that the government spends more resources debating with the applicant (or third parties) whether a mark is scandalous than it would if it allowed the mark to register.<sup>226</sup>

The obvious justification for prohibiting registration of scandalous marks is to regulate morality and, specifically, to guide potential trademark owners away from “improper” trademarks.<sup>227</sup> In 1909, for example, the Commissioner of Patents indicated that the role of the Patent Office included discouraging the use of marks that detract from “the dignity of the high office which [Presidents] have held.”<sup>228</sup> The intent behind the prohibition of scandalous marks may have been to chill adoption and use of commercial speech that would offend portions of the general public.<sup>229</sup> Despite this “obvious” justification, at least one court has rejected the implication that section 2(a) reflects a congressional attempt to regulate morality.<sup>230</sup>

Perhaps the problem with intuiting the justification for the scandalous registration prohibition is that the prohibition, as currently applied, is entirely disconnected from the underlying purpose for which trademarks are protected. Trademarks were originally granted protection as a consumer protection mechanism with the additional benefit of encouraging producers to associate their marks with good quality.<sup>231</sup> It is entirely consistent with this premise to prevent registration of marks that, for example, are so similar to other registered marks such that the general public would be confused as to the appropriate source.<sup>232</sup> Likewise, it is consistent to prohibit the registration of a

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<sup>224</sup> *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981).

<sup>225</sup> *See id.* For example, a federal registration on the Principal Register is prima facie evidence that the mark is valid for the goods and/or services listed and that the mark is owned by the registrant. 15 U.S.C. §§ 1057(b), 1115(a) (2006).

<sup>226</sup> *See, e.g., McGinley*, 660 F.2d at 487 (Rich, J., dissenting) (“More ‘public funds’ are being expended in the prosecution of this appeal than would ever result from the registration of the mark.”).

<sup>227</sup> LALONDE, *supra* note 13, § [6][a][i][A] (“The Lanham Act indirectly protects the public morals by barring scandalous and immoral trademarks.”).

<sup>228</sup> *Ex parte Banner Cigar Mfg. Co.*, 1909 C.D. 9, 10.

<sup>229</sup> *See Baird*, *supra* note 5, at 675.

<sup>230</sup> *McGinley*, 660 F.2d at 486.

<sup>231</sup> *See supra* Parts II.A.1-2.

<sup>232</sup> *See* 15 U.S.C. § 1052(d) (2006).

recognized national flag or emblem because it could lead the public to assume that the product is associated with or sponsored by the nation.<sup>233</sup> Assuming that religious terms and images were incapable of serving as a source-identifier, as was believed in the 1880s, the prohibition of religious terms and icons as immoral marks would serve the underlying purpose of the Lanham Act. However, the scandalous registration prohibition as a whole is entirely unrelated to concerns about consumer confusion, encouraging better quality products, or any other related concerns.<sup>234</sup> Rather, the prohibition relates to the quality and public perception of the mark itself and, thus, more aptly resembles the rationale behind the protection afforded to famous marks.

#### IV. A PROPOSED TWO-TIERED APPROACH TO SCANDALOUS MARKS

When twentieth century United States courts considered a test for scandalous or immoral trademarks, they faced two substantial restrictions. First, courts were confined by the contemporaneous theories of trademark protection, which, until recently, only afforded a limited property right for the mark in connection with the associated goods or services. Courts were also limited by their insistence in creating a single standard to draw a line between marks that are scandalous and those that are not. As the Federal Circuit recognized, courts have had great “difficulty in fashioning a single objective measure like a substantial composite of the general public from the myriad of subjective viewpoints, [but] we are duty bound to apply the standard set forth by our predecessor court.”<sup>235</sup> Rather than fighting to create a single, all encompassing test for the scandalous registration prohibition, United States courts would be better served to consider a two-tiered approach that incorporates modern trademark theory regarding famous marks because it would lead to more consistency.

##### A. *The First Tier of Scandalous Marks: Per Se Scandalous Marks*

The proposed first tier is only feasible in light of recent developments in trademark law, namely, recognition that famous marks should be accorded more of an absolute property right.

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<sup>233</sup> See *id.* § 1052(b).

<sup>234</sup> See, e.g., Baird, *supra* note 5, at 673-74; see also ROGER E. SCHECHTER & JOHN R. THOMAS, INTELLECTUAL PROPERTY: THE LAW OF COPYRIGHTS, PATENTS AND TRADEMARKS 600 (2003) (noting that the scandalous registration prohibition, unlike other prohibitions, is unrelated to competitors communicating with the public or avoiding deception).

<sup>235</sup> *In re Mavety Media Group, Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

The concept of a nearly absolute property right for famous marks is generally attributed to a 1927 article by Frank I. Schechter.<sup>236</sup> Schechter noted that highly distinctive trademarks may be “impress[ed] upon the public consciousness.”<sup>237</sup> Traditional trademark protection is insufficient to protect an essential part of the mark’s value—the public’s ability to instantly identify the mark’s source simply by reference to the mark.<sup>238</sup>

When choosing a trademark, companies either create a new symbol (e.g., the Nike swoosh) or use preexisting words or images that are either inherently distinctive or acquire distinctiveness (e.g., APPLE for computers). To constitute famous marks, however, these marks must move beyond merely being distinctive. Rather, famous marks are at a higher level where the mark is a “household name,” and simply noting the mark immediately calls a particular meaning or image to mind.<sup>239</sup> For example, merely stating “Rolls Royce” calls to mind an image of established, upper-class wealth and is instantaneously associated with one source. Similarly, the Coca-Cola Company has invested in its COCA-COLA brand to the point where the general public instantly knows the product’s source simply by referring to the COCA-COLA mark.<sup>240</sup> The general public also associates one image or meaning to the COKE mark, namely, people who are “care-free, sophisticated, but willing to work to unite the world in ‘peace and harmony’” or, for DIET COKE, as care-free, fun-loving, young, and happy.<sup>241</sup> After recognizing the value of Schechter’s concept, Congress adopted the Federal Anti-Dilution Act in 1996, which granted additional protection to “famous” trademarks.<sup>242</sup> Thus, the owners of famous marks are able to raise a dilution claim to prevent other entities from using the same mark in connection with any other goods or services.

Famous marks, therefore, are those believed to have such power that they can serve a source-identifying function or image-identifying function without reference to the associated goods and

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<sup>236</sup> See Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 825 (1927).

<sup>237</sup> *Id.*

<sup>238</sup> *Id.* at 831.

<sup>239</sup> Thane Int’l, Inc. v. Trek Bicycle Corp., 305 F.3d 894, 911 (9th Cir. 2002).

<sup>240</sup> Simone A. Rose, *Will Atlas Shrug? Dilution Protection for “Famous” Trademarks: Anti-Competitive “Monopoly” or Earned “Property” Right?*, 47 FLA. L. REV. 653, 662 n.28 (1995) (discussing subliminal associations).

<sup>241</sup> *Id.* The quoted passage refers to Coca-Cola’s famous advertisement where a multicultural group sings *I’d Like to Teach the World to Sing*. More recent advertisements for Diet Coke include young, happy people roller-skating near a beach with the song *Starry-Eyed Surprise* playing in the background.

<sup>242</sup> 15 U.S.C. § 1125 (2000); 4 MCCARTHY, *supra* note 24, § 24:67; see also Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev., 170 F.3d 449, 453-54 (4th Cir. 1999).

services. These marks have only one meaning to the public. If there are scandalous marks that are able to conjure a singular, negative meaning or image immediately and without need to reference the associated goods, these scandalous marks should be treated as the inverse of a famous mark—in other words, as absolutely unavailable for registration.

Recognizing the parallel nature between famous marks and these *per se* scandalous marks leads to two conclusions. First, these *per se* scandalous marks should be determined by using a test that parallels the test used for famous marks—or at least parallels the considerations implicit in the test for determining famous marks. Second, given the apparent policy considerations in prohibiting scandalous marks, marks should be prohibited as scandalous even if they have a scandalous meaning only within a region of the United States, similar to marks identified as famous based upon public recognition within a niche geographic area. Under this test, if the term PINK TACO is a vulgar reference that is only recognized in the Southwestern part of the United States, it would still be prohibited from federal registration under the proposed approach.

#### 1. *Per Se* Scandalous Marks Exist

Some marks are classified as scandalous when considered in light of the associated product, as the *In re Riverbank Canning Co.* court found when evaluating the MADONNA mark in association with liquor.<sup>243</sup> The first proposed tier, however, includes only marks that are scandalous simply by their existence, regardless of the associated goods or services.

Examining bodies have struggled in applying the current standard for the scandalous registration prohibition because, at least in part, they instinctively want to consider certain marks as *per se* scandalous. For example, the TTAB in *In re R.G.S. Group Ltd.* focused almost exclusively on the meaning attributed to the term “shit” in the mark REALLY GOOD SHIT and had little patience with any argument that the mark should be allowed to register.<sup>244</sup> Similarly, the TTAB in *In re Douglas & Watson* rejected THE BEARDED CLAM mark for restaurant services solely after considering the vulgar meaning accorded the mark.<sup>245</sup> These types of marks, profane or vulgar, are the ones most commonly associated with the scandalous registration prohibition. For example, one general intellectual property supplement gives only

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<sup>243</sup> *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938).

<sup>244</sup> *In re R.G.S. Group, Ltd.*, 1997 TTAB LEXIS 293 (Mar. 5, 1997).

<sup>245</sup> *In re Douglas*, 2004 TTAB LEXIS 524 (Sept. 7, 2004).

one example of an immoral mark—a mark resembling a sex organ.<sup>246</sup> Likewise, the supplement’s only example of a scandalous mark is one showing a mutilated corpse.<sup>247</sup> By focusing solely upon the mark in identifying scandalous or immoral marks, the author implies that these marks would be prohibited regardless of the associated good or services. Notably, these proposed marks also align with the proposal to limit scandalous marks to those that connote vulgarity or illegality.

The danger in applying a contextual approach to a *per se* scandalous mark is exemplified in *In re Boulevard Entertainment, Inc.*<sup>248</sup> The Federal Circuit considered whether it should classify as scandalous the marks 1-800-JACK-OFF and JACK-OFF (“JACK OFF marks”) used for “entertainment in the nature of adult-oriented conversations by telephone.”<sup>249</sup> The main inquiry focused on the meaning of “jack off.”<sup>250</sup> *Webster’s Collegiate Dictionary* defined the term only as a vulgar phrase that refers to masturbation, but the court also considered definitions in *Forbidden American English*, *American Slang*, and *Historical Dictionary of American Slang*.<sup>251</sup> Some of the reference material pointed to an alternate definition of an incompetent person, jerk, dolt, or idiot and subsequently identified this alternate definition as vulgar.<sup>252</sup> Thus, calling someone a “jerk” may not be scandalous, but calling someone a “jack off,” even though it has a similar denotation, has a vulgar connotation that is recognized by the general public and by the PTO’s reference material. After examining the mark in its context with reference to its definition, associated goods or services, and applicant’s use of the mark, the Federal Circuit affirmed the PTO’s determination that the mark was scandalous.<sup>253</sup>

Although the court reached the “right” result, this case demonstrates the dangers of applying a contextual analysis to *per se* scandalous marks. While the applicant fought to register its JACK OFF marks, the PTO evaluated and allowed registration of the

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<sup>246</sup> RICHARD STIM, *PATENT, COPYRIGHT & TRADEMARK: AN INTELLECTUAL PROPERTY DESK REFERENCE* 414 (Nolo 8th ed. 2006). Note that the PTO has considered this type of mark as possibly scandalous rather than immoral. See *supra* Part III.A.4.

<sup>247</sup> See *supra* Part III.A.4. These examples stand in sharp contrast to the example given of a deceptive mark—a mark suggesting miracle properties in a product when those properties cannot be substantiated. Unlike the *per se* scandalous marks, the PTO must evaluate not only the mark, but also how the mark compares to the underlying product or other contextual information before finding it deceptive.

<sup>248</sup> *In re Boulevard Entm’t, Inc.*, 334 F.3d 1336 (Fed. Cir. 2003). It seems likely that the term JACK OFF would satisfy the first tier requirements described *supra* Part IV.A.

<sup>249</sup> *Boulevard*, 334 F.3d at 1338 (quoting appellant’s trademark application).

<sup>250</sup> *Id.* at 1339.

<sup>251</sup> *Id.*

<sup>252</sup> *Id.*

<sup>253</sup> *Id.* at 1340.

mark JACK OFF JILL for a musical group.<sup>254</sup> According to the Federal Circuit, the difference in registration status is justified by the context—JACK OFF JILL is a double entendre that could relate to the nursery school rhyme of Jack and Jill.<sup>255</sup> Later PTO decisions for marks containing the “jack off” phrase have a similarly inconsistent result, which is likely due to the PTO’s contextualization of the marks.<sup>256</sup>

Allowing registration ignores the fact that the majority of the public would still see the admittedly scandalous material. Moreover, it is indisputable that consumers would have to refer to the product offered under these marks by using the scandalous phrase. Under any of the identified justifications for the registration prohibition, marks containing JACK OFF should be prohibited. Moreover, allowing a contextual analysis of these vulgar phrases merely encourages potential applicants to push the boundaries by mixing scandalous material with non-scandalous material in an attempt to obtain a federal registration for a risqué mark or a mark containing a sexual innuendo. Thus, the contextual approach encourages, rather than chills, use of marks containing scandalous material even if the applicants are ultimately able to obtain only common law protection.

It is significantly easier to avoid inconsistent decisions when *per se* scandalous marks are at issue because the relevant context should be minimized. There is no need to examine the associated goods or services because the mark’s meaning will not change, indicating that the marks should be treated as if they were an absolute and unavailable property right. These *per se* scandalous marks, therefore, are like the mirror image of a “famous” mark in that they fall within their category based purely on public perception of the mark’s meaning or image. Just as with famous marks, no new entities are allowed to register the scandalous marks.<sup>257</sup>

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<sup>254</sup> See U.S. Trademark Reg. No. 2,363,770 (filed July 31, 1998).

<sup>255</sup> *Boulevard*, 334 F.3d at 1343. The Federal Circuit strains to harmonize these decisions. For example, in the nursery rhyme, Jack fell down the hill first, and Jill came tumbling after. Given that, why would Jack be on Jill, meaning that the nursery rhyme justifies the mark JACK OFF JILL?

<sup>256</sup> Compare U.S. Trademark Serial No. 78/604,378 (filed April 7, 2005) (issuing an office action alleging that ONE JACK OFF for gambling services is scandalous) with U.S. Trademark Serial No. 78/604,405 (filed April 7, 2005) (never raising the scandalous registration prohibition for ONE JACK OFF (and playing card design) for gambling services). Even though the mark in the second application had a pictorial context that leads the general public to associate the mark with gambling, the fact of the matter is that consumers will have to state the words in order to refer to the services, which should trigger the same concerns as the word mark application.

<sup>257</sup> The parallel between famous marks and *per se* scandalous marks also indicates that *per se* scandalous marks should not be enforceable under the common law, just as a junior user of a famous mark cannot enforce his or her purported rights to use the famous mark.

## 2. A Proposed Test for Identifying *Per Se* Scandalous Marks

As with some scandalous marks, fame is achieved by building in the public's mind a strong reputation and renown in the mark such that the mark evokes a single meaning or image.<sup>258</sup> An inquiry into the standard for determining famous marks, therefore, suggests an appropriate test for determining which marks fall in the *per se* category. Under either the previous dilution statute or the current one, the factors used to identify famous marks essentially distill to three concerns. These three concerns should, likewise, be used to craft a test to identify marks that should be considered *per se* scandalous.

Prior to the October 2006 amendments, the Federal Trademark Dilution Act identified eight factors for courts to consider in determining if a mark is famous, although no one factor is required or dispositive:

- (1) the . . . distinctiveness of the mark;
- (2) the duration and extent of the use of the mark . . . ;
- (3) the duration and extent of advertising and publicity of the mark;
- (4) the geographical extent of the trading area in which the mark is used;
- (5) the channels of trade . . . with which the mark is used;
- (6) the degree of recognition of the mark in the trading areas . . . used;
- (7) the nature and extent of use of the same or similar marks by third parties; and
- (8) whether the mark [is] registered . . . on the principal register.<sup>259</sup>

After the Trademark Dilution Revision Act of 2006, the suggested

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However, such a discussion is beyond the scope of this article and, in fact, is mere speculation. As far as the author can determine, no one has raised any objection to enforcement of a common law trademark on the basis that the mark contains or consists of immoral or scandalous matter.

<sup>258</sup> J. THOMAS MCCARTHY ET AL., MCCARTHY'S DESK ENCYCLOPEDIA OF INTELLECTUAL PROPERTY 175 (BNA Books 3d ed. 2004).

<sup>259</sup> 15 U.S.C. § 1125(c)(1)(A)-(H) (2000), amended by Trademark Dilution Revision Act of 2006, 15 U.S.C. § 1125(c) (2006). Although the main concern spurring congressional action related to reinstating a likelihood of dilution standard, the Judiciary Committee also indicated that it intended to deny protection to marks that are famous only in "niche" markets. H.R. REP. NO. 109-23, at \*8 (2005) (statement of the Judiciary Committee). See also 152 CONG. REC. S1921, S1923 (2006) (statement of Sen. Leahy, an author of the original Federal Trademark Dilution Act); 151 CONG. REC. H2121, H2122-23 (2005) (statement of Rep. Sensenbrenner). As discussed *infra*, several courts have expressed similar concerns due to the extraordinary protections granted under dilution claims. Extension of the "niche market" concept to scandalous marks does not implicate the same concerns because categorization as a scandalous mark does not provide additional protection; rather, it prevents extension of additional protections under the federal registration scheme.



factors for fame were reduced to four with a preamble discussion: “a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner,” which is determined by examining . . .

- (1) the duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties;
- (2) the amount, volume, and geographic extent of sales of goods or services offered under the mark;
- (3) the extent of actual recognition of the mark; and
- (4) whether the mark was registered under the [1881 Act], or the [1905 Act], or on the Principal Register.<sup>260</sup>

In addition, the Revised Trademark Dilution Act includes specific factors for dilution by blurring that may be relevant because, as with marks subject to blurring, a *per se* scandalous mark has already acquired a singular meaning that would transfer to the new entity’s use of the mark.<sup>261</sup>

Both the prior eight factor fame standard and the current four factor fame standard in conjunction with the dilution by blurring definition represent at least three considerations. The first consideration entails examining whether the mark is the kind that can be unique, singular, and distinctive in identifying the product’s source.<sup>262</sup> A second consideration is the public recognition of the mark’s singular meaning.<sup>263</sup> The third and final consideration encompasses the efforts undertaken by the mark’s owner to create public recognition of the mark on a large scale—to create fame.<sup>264</sup> With some slight modifications, these same considerations can be used to determine if a mark is *per se* scandalous.

Before applying a test to determine scandalousness, a

<sup>260</sup> 15 U.S.C. § 1125(c)(2)(A)(i)-(iv); *see also* 151 CONG. REC. H2122-23 (2005).

<sup>261</sup> 15 U.S.C. § 1125(c)(B).

<sup>262</sup> The prior version of the Federal Trademark Dilution Act focused on the mark’s uniqueness in factors 1 and 7. The current statute encompasses a similar concept in the preamble language identifying that a mark is famous if it is widely recognized as associated with the mark’s owner. Moreover, some of this concern is addressed specifically in the dilution by blurring portion of the current statute. *E.g., id.* § 1125(c)(2)(B)(ii); *see also* H.R. REP. NO. 109-23 (2005) (Report of Rep. Sensenbrenner stating that “dilution occurs when unauthorized use of a famous mark reduces the public’s perception that the mark signifies something unique, singular, or particular.”).

<sup>263</sup> Concern regarding the public’s recognition of the mark’s singular meaning was identified in factor 6 of the prior statute. Likewise, factor 3 of the current statute focuses on the extent of actual recognition of the mark as does factor 4 of the dilution by blurring standard. *E.g.,* 15 U.S.C. § 1125(c)(2)(B)(iv).

<sup>264</sup> The efforts of the owner to create fame were discussed in factors 2 through 5, 7, and 8 in the prior dilution statute. These same efforts are identified in factors 1, 2, and 4 of the current fame standard.

necessary preliminary inquiry is identifying the relevant portions of the mark to evaluate. For some marks, it is the mark as a whole that should be evaluated, such as WEEK-END SEX. For other marks, it may be more appropriate to consider less than the whole mark, such as just the JACK OFF portion of 1-800-JACK-OFF. In the context of comparing famous marks to the purportedly diluting marks, several courts have noted that the purportedly diluting mark must be identical or nearly identical to the famous mark.<sup>265</sup> To do so, they “must be ‘similar enough that a significant segment of the target group of customers sees the two marks as essentially the same.’”<sup>266</sup> However, courts have not precluded themselves from dissecting a mark to evaluate whether part of the purportedly infringing mark is identical or nearly identical to the famous mark. For example, the Ninth Circuit noted that a jury could find that ORBITREK and TREK were nearly identical.<sup>267</sup>

When applied to scandalous marks, the proposed standard would require the examining body to consider the mark’s scandalousness when the applicant’s mark either consists of or contains a word, phrase, or image that could connote vulgarity or illegality.<sup>268</sup> To apply this standard, the examining body would be required to parse the trademark elements, but the extent of parsing should be limited to specific portions of the mark that would be perceived by the general public as individual words or images with individual meanings. In the context of evaluating scandalous words, this kind of dissection is commonly undertaken.<sup>269</sup> For example, if the word “badass” were not

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<sup>265</sup> See, e.g., *Playboy Enter., Inc. v. Welles*, 279 F.3d 796, 801 (9th Cir. 2002).

<sup>266</sup> *Id.* at 806 n.41 (quoting *Luigino’s Inc. v. Stouffer Corp.*, 170 F.3d 827, 832 (8th Cir. 1999)).

<sup>267</sup> *Thane Int’l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 907 (9th Cir. 2002); see also *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1012 (9th Cir. 2004) (holding that it was appropriate to evaluate whether NISSAN COMPUTERS dilutes NISSAN for automobiles because use of the famous mark with a generic term will not preclude a dilution claim); *Eli Lilly & Co. v. Nat’l Answers, Inc.*, 86 F. Supp. 2d 834, 847-53 (S.D. Ind. 2000) (evaluating whether HERBROZAC dilutes PROZAC).

<sup>268</sup> For famous marks, courts often apply a high standard of proof or a presumption of exclusion in order to minimize the ability of a mark’s owner from obtaining the extraordinary benefits of an anti-dilution claim. Regardless of which justification is used for the scandalous registration prohibition, it is more appropriate to apply the opposite approach. For the scandalous registration prohibition, Congress’ apparent desire to limit registration of scandalous marks warrants application of a presumption such that, when in doubt, the mark should be categorized as scandalous and, thus, be refused registration.

<sup>269</sup> For example, when evaluating BIG PECKER BRAND, the TTAB spent a good deal of time discussing the meaning of the term “pecker.” *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470, 1470-72 (T.T.A.B. 1988); see *supra* notes 185-86 and accompanying text; see also *supra* notes 201, 204-05 and accompanying text (noting that the TTAB refused registration for REALLY GOOD SHIT but allowed registration for image of frog that may be “giving the finger”). It is likely that the TTAB is willing to parse this kind of mark because of its perception that the general public is likely to undertake such parsing when it sees a phrase or a fanciful word that is composed of words that have a preexisting meaning.

recognized as a unique word, it would be parsed into the component words that were united to create the mark, namely “bad” and “ass.” On the other hand, a proposed mark consisting of BASS would not be parsed into “b” and “ass” because the word “bass” is one that the general public would recognize as a word and, thus, would not be likely to parse when seeing the mark. Similarly, a mark that slyly refers to another term but does not actually encompass the term, such as the FCUK mark used by French Connection Limited Co. UK, would be allowed to register because it is not a recognized word.<sup>270</sup> This proposed dissection, for example, would have led the TTAB to consider whether the recognized phrase “jack off” in the mark JACK OFF JILL is scandalous and thus, whether the mark should be allowed to register.

Once the examining body has identified the appropriate portion of the mark to consider, it can then apply the first prong of the proposed test. The first prong examines whether the mark (or relevant portion of the mark) has the threshold characteristic of an “infamous” mark, namely, that the mark or portion of the mark has a singular interpretation regardless of the associated goods or services. As will be discussed below, the second prong evaluates the specific meaning of that mark. By determining whether the mark has a singular meaning, the examining body can segregate those marks that are likely to be perceived as scandalous regardless of their context, and should be *per se* prohibited from registration, from those marks that can only be evaluated by examining the context surrounding the use of the mark. This inquiry is similar to part of the inquiry undertaken to evaluate famous marks, in which examining bodies ascertain whether the mark is such a strong mark that it can be famous.<sup>271</sup> In part, the fame inquiry involves determining whether the public has attached a meaning to the purportedly famous mark. In the context of determining scandalous marks, the essential inquiry

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<sup>270</sup> Allowing registration for a mark that suggests a scandalous term, but is not the term itself, is consistent with prior PTO determinations. More importantly, however, it also reflects the underlying justifications for this new test. See, e.g., FCUK, U.S. Trademark Reg. No. 2,920,270 (filed Apr. 6, 1998) (for leather goods and clothing). A word without a preexisting meaning is simply a fanciful mark (or, at most, a suggestive mark rather than a descriptive one). Consequently, it has no preexisting, scandalous meaning attributed to it and, thus, fails to create the kind of impression that is analogous to that of a famous mark.

<sup>271</sup> *Best Vacuum, Inc., v. Ian Design, Inc.*, 2005 U.S. Dist. LEXIS 9794, at \*7-10 (Jan. 18, 2005); *Thane*, 305 F.3d at 912. For most courts, the mark can be famous either based upon inherent distinctiveness, which includes marks that indicate little or no information about the associated products (e.g., KODAK), or acquired distinctiveness, which occurs when the mark provides some information about the product but, over time, the general public has learned to associate the mark with the source (e.g., STEAK AND BREW). SCHECHTER & THOMAS, *supra* note 234, at 573-74, 700.

would start by evaluating whether the mark or relevant portion of the mark would immediately call to mind a specific meaning regardless of its context. For example, in evaluating BIG PECKER BRAND, the relevant portion of the mark is “pecker.” As a term, “pecker” has several different definitions and at least one of its definitions is not vulgar.<sup>272</sup> Thus, the BIG PECKER BRAND mark would not fall within the first tier because context is necessary to determine which of the preexisting meanings would be associated by the public with the mark.

There are a number of resources available to determine whether a term has multiple definitions. Dictionary definitions are the primary resource, particularly slang or popular culture dictionaries. As the Federal Circuit has recognized, dictionary definitions are an excellent source because “dictionary definitions represent an effort to distill the collective understanding of the community with respect to language and thus clearly constitute more than a reflection of the individual views of either the examining attorney or the dictionary editors.”<sup>273</sup> Contrary to the Federal Circuit’s determination in *In re Boulevard Entertainment, Inc.*, however, reliance on dictionaries alone is insufficient.<sup>274</sup> Dictionaries often do not reflect the swiftly changing perceptions of society, which has particular importance in evaluating scandalousness. First, dictionaries may not include terms that have recently acquired a pejorative, slang meaning. For example, most dictionaries do not define the term “pink taco.”<sup>275</sup> Alternatively, some dictionaries may falsely indicate that a term has a single meaning when the general public would assign multiple meanings. For example, the Court of Customs and Patent Appeals in *In re Riverbank Canning Co.*<sup>276</sup> used dictionary definitions to determine if the mark MADONNA would be

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<sup>272</sup> In general, marks within the proposed first tier would only have a single meaning, and the second inquiry would evaluate whether the meaning is vulgar or related to illegal activity. The JACK OFF marks demonstrate a narrow but appropriate exception to that limitation, namely, some marks may have multiple meanings where all of the meanings are vulgar or scandalous, such as the term “jack off.” *In re Boulevard Entm’t*, 334 F.3d 1336, 1339-40 (Fed. Cir. 2003). This appears most likely to occur when the term is ascribed different meanings depending upon whether the term is used in its noun or verb form. In such instances, while the first inquiry would indicate that the mark should be evaluated under the second tier, the mark would be returned to *per se* scandalous status in the first tier after the examining body determines that all potential meanings are scandalous.

<sup>273</sup> *Boulevard*, 334 F.3d at 1340.

<sup>274</sup> *Id.* Having a singular, innocuous definition does not preclude finding a mark scandalous in the second tier. However, it would preclude a mark from inclusion in the first tier.

<sup>275</sup> See e.g., RICHARD A. SPEARS, *SLANG AMERICAN STYLE: MORE THAN 10,000 WAYS TO TALK THE TALK* (McGraw-Hill 2d ed. 1995).

<sup>276</sup> *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938).

scandalous when associated with wine. The court found that “in the United States, and among all English-speaking peoples, the word ‘Madonna’ is generally understood to refer to the Virgin Mary or to a pictorial representation of the Virgin Mary,” and ascribed a singular meaning to the term.<sup>277</sup> Current dictionaries retain the same definition for the term “Madonna,” and presumably, a current court that only referenced a dictionary definition would make the same determination even though a large portion of American society likely would also associate the term “Madonna” with the popular singer/actress Madonna.<sup>278</sup> While associating the term “Madonna” with the famous singer/actress would not necessarily avoid a scandalous connotation, it certainly demonstrates the fallacy of relying solely upon dictionary definitions to evaluate the meaning of a word or phrase.

One advantage of the modern era is access to the distilled, collective knowledge via the Internet. Thus, the PTO is better able to determine if a term has any meaning at all or if the term has multiple meanings. For example, the term “pink taco” is not defined in traditional dictionaries.<sup>279</sup> On the other hand, the Urban Dictionary website defines “pink taco” and gives a list of synonyms.<sup>280</sup> Of the eleven definitions listed, ten define the term as female genitalia; the only alternate definition provided is a reference to Morton’s Las Vegas restaurant.<sup>281</sup> Because these slang, on-line dictionaries are rapidly updated, they may contain a more accurate indication of whether a term has acquired a meaning. Resources such as Wikipedia are also useful for determining whether an image, such as a raised, middle finger, has a meaning. By allowing visitors to add or amend pages, Wikipedia has amassed a fairly comprehensive webpage of gestures, including the meaning of a raised middle finger.<sup>282</sup> In addition to these slightly more traditional sources, the PTO can also use a search engine, such as Google or Yahoo, to see whether a phrase or term is used by the general public in other settings,

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<sup>277</sup> *Id.* at 328. Notably, all further references as to the virtue and general understanding of the Virgin Mary appeared to be drawn by the court with little or no extrinsic support.

<sup>278</sup> WEBSTER’S, *supra* note 1, at 861 (defining Madonna as “the Virgin Mary,” “a picture or statue representing the Virgin Mary,” and “an Italian title of formal address to a woman”).

<sup>279</sup> *Id.* at 1094-95.

<sup>280</sup> Urban Dictionary, Pink Taco, <http://www.urbandictionary.com/define.php?term=pink+taco> (last visited Feb. 27, 2007).

<sup>281</sup> *Id.*

<sup>282</sup> Wikipedia, Gesture, [http://en.wikipedia.org/wiki/Gesture#Middle\\_finger](http://en.wikipedia.org/wiki/Gesture#Middle_finger) (last visited Feb. 27, 2007). The exact search was the following: “middle finger” raised meaning. Wikipedia is also an excellent source because it represents the knowledge of visitors, who collaboratively write or edit the entries. See *infra* note 285.

such as blogs, personal webpages, or online emails. These types of casual uses are likely to reflect the most current usage of a term and are therefore likely to demonstrate if there is a scandalous meaning.

There are two potential problems with relying upon Internet resources to determine whether a term has multiple meanings and, ultimately, whether it has a scandalous meaning. First, the scope of the Internet is global, which means that terms or images may have a meaning in a foreign country yet not have a recognized meaning in the United States. Although foreign terms are translated into English for purposes of evaluating their level of distinctiveness and the likelihood of confusion with other registered marks,<sup>283</sup> it is unclear whether the translation requirements would apply for purposes of applying the scandalous registration prohibition. Certainly, there are terms and images that may either have no meaning or a singular and different meaning in the United States. For example, raising the first two fingers into a “v” shape with the back of the hand facing the audience is a rude gesture in England but could be interpreted as a peace sign in the United States.<sup>284</sup> For consistency with the doctrine of foreign equivalents, however, it is appropriate for the PTO to evaluate whether a term has a singular, multiple, or any meaning regardless of the geographic origin of the information. Second, the flexibility of the Internet, while a boon, also means that it can be easily manipulated by a few people. For example, because Wikipedia entries can be edited by anyone, the information provided may not always be accurate.<sup>285</sup> These concerns, however, are easily addressed during the PTO examining process. When the PTO examiner determines that the meaning is scandalous, he will issue an Office Action to the trademark applicant and attach copies of all the material relied upon by the examiner in making his or her determination.<sup>286</sup> If any of the information relied upon by the examiner is questionable, the applicant will have the opportunity to respond to the specific material as well as to provide material in rebuttal. Thus, the PTO can take advantage of these resources, and the applicant will have the opportunity to respond to any questionable

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<sup>283</sup> PATENT AND TRADEMARK OFFICE, PRACTITIONER'S TRADEMARK MANUAL OF EXAMINATION PROCEDURE §§ 1207.01(b)(vi), 1209.03(g) (4th ed. 2005). For example, the PTO translated DE PUTA MADRE (to whore's mother) when determining if it should register. *See supra* note 171.

<sup>284</sup> Wikipedia, V sign, [http://en.wikipedia.org/wiki/V\\_sign](http://en.wikipedia.org/wiki/V_sign) (last visited Feb. 27, 2007).

<sup>285</sup> Wikipedia, Contributing to Wikipedia, [http://en.wikipedia.org/wiki/Wikipedia:Contributing\\_to\\_Wikipedia](http://en.wikipedia.org/wiki/Wikipedia:Contributing_to_Wikipedia) (last visited Feb. 27, 2007).

<sup>286</sup> *See e.g., supra* note 171 (application for DE PUTA MADRE).

data.

Further, by undertaking a slightly more thorough evaluation of how a word or term is used in popular culture, the PTO is better able to determine whether a term has multiple meanings such that the meaning of the applicant's mark would be context dependent. In such a case, the second tier of the proposed test is more appropriate. If the term has a singular meaning, then the examining body would continue with the first tier. If the term has no meaning or only has the meaning given by the trademark applicant through prior use, the PTO's inquiry into the scandalous registration is finished unless a third-party raises the question again.

If the first factor indicates that the mark has a singular meaning, then the next factor requires an evaluation of the mark's meaning to the general public. In the context of fame, this consideration is used to refuse "famous" status to marks that are only famous in the line of business where the owner uses the mark.<sup>287</sup> For example, the Ninth Circuit found that the AVERY and DENNISON marks were only famous within the office supply market, meaning that the marks' fame were limited to a particular sub-group.<sup>288</sup> Thus, the issue is whether the general public is aware of the purportedly famous mark's meaning and image such that the mark can serve its source-identifying function (and image function) in the absence of associated goods.<sup>289</sup>

In the context of scandalous marks, the proposed second factor addresses the meaning accorded to the term by the general public. Thus, this factor examines whether the singular meaning ascribed to the mark is one that would be considered scandalous or immoral, using society's norms and standards. Marks would satisfy the second prong if the singular definition squarely and uniquely falls within one of the articulated categories of scandalous marks, namely, marks that are sexually explicit (vulgar), marks that contain profane terms (vulgar), and marks that refer to illegal activity. General dictionaries or other similar resources already define terms such as "jack off" and images such as male genitalia as vulgar or improper for the general population. In addition, the Internet is an essential resource for resolving this

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<sup>287</sup> 4 MCCARTHY, *supra* note 24, § 24:92. The exception is that some courts will consider a dilution claim for a mark that is famous within its niche if the allegedly diluting mark will also be used in the same niche. *Id.*

<sup>288</sup> Avery Dennison Corp. v. Sumpton, 189 F.3d 868, 877-78 (9th Cir. 1999)

<sup>289</sup> 4 MCCARTHY, *supra* note 24, § 24:92. For this factor, many courts subsequently consider the percentage of the general public that is aware of the specific marks. *See, e.g.*, Times Mirror Magazines, Inc. v. Las Vegas Sports News, 212 F.3d 157, 174-75 (3d Cir. 2000). This aspect will be addressed in the third factor.

inquiry. As discussed above, there are numerous Internet resources that can assist in determining the meaning of a term, which vary from online dictionaries and encyclopedias to blogs, emails, and other casual fora. The PTO has already begun using these resources. For example, when evaluating THE BEARDED CLAM for scandalousness, the TTAB was highly influenced by the fact that the PTO submitted a seventy-five page Google search report after searching for the following: “bearded clam” (porn or pictures or photos or pussy).<sup>290</sup>

The question remains whether the PTO should apply the doctrine of foreign equivalents in the scandalous inquiry such that marks with a scandalous meaning in a foreign country, including terms like “bugger” or “bullock” in England, should be prohibited in the United States as well. Browne would argue that any term that is scandalous in the world should not be used as a trademark,<sup>291</sup> and certainly such a position would be consistent with the PTO’s current application of the doctrine of foreign equivalents. As with current application of the doctrine of foreign equivalents, it would be limited to translations from languages that might be familiar to American buyers, such as Spanish.<sup>292</sup>

While application of society’s mores is often the most subjective and variable aspect of the PTO’s examination, the first prong of the proposed test should minimize or eliminate the unpredictability caused by the subjective evaluation in the second factor. Focusing the first tier on marks or terms with singular definitions reduces the inconsistency and ambiguity in determining whether a mark will be barred as scandalous. The second inquiry becomes more complicated, however, if the mark is a longer phrase, such as ONLY A BREAST IN THE MOUTH IS BETTER THAN A LEG IN THE HAND.<sup>293</sup> This kind of phrase does not have a single word or smaller portion of words that are already attributed a scandalous meaning, as one might find with JACK OFF JILL. It is only potentially scandalous when taken as a whole and, therefore, should not fall within the *per se* scandalous tier unless the phrase as a whole is a preexisting phrase in common parlance.

The final consideration should also, in general, be a relatively facile analysis. In the context of fame, this consideration evaluates

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<sup>290</sup> *In re Watson*, 2004 TTAB LEXIS 524, at \*7 (Sept. 7, 2004).

<sup>291</sup> See *supra* notes 101-105 and accompanying text.

<sup>292</sup> 2 MCCARTHY, *supra* note 24, § 12:41. As previously noted, the applicant will have the opportunity to respond to the PTO examiner’s objections where appropriate.

<sup>293</sup> See *Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. (BNA) 176, 177 (T.T.A.B. 1978).



the efforts undertaken to make the mark truly famous.<sup>294</sup> Most courts require a very high standard of fame across the relevant population before they will grant to any mark the status of an absolute property right.<sup>295</sup> The legislative history and statutory language related to the factors for fame indicate that the geographic fame of the mark should “extend throughout a substantial portion of the” United States.<sup>296</sup> The reason for having such a high standard is the desire to limit the extraordinary remedy of dilution protection to a very elite subset of marks.<sup>297</sup> The Revised Trademark Dilution Act and its legislative history reinforce that there should be a very high, national standard for fame.<sup>298</sup>

Unlike fame, however, categorization as a scandalous mark results in fewer benefits (rather than granting greater rights). Perhaps reflecting this distinction, the current standard for scandalous marks requires recognition by a substantial composite (but not necessarily a majority) of the general public.<sup>299</sup> Information gathered to evaluate the first and second prongs generally should easily satisfy this standard. If a term is ascribed a singular meaning in a dictionary or other reference source, then the examining body will rest assured that a majority of the population (if not everyone aware of the term) has the same interpretation of the term. Moreover, anyone in the general population who does not know the term’s meaning is likely to start her inquiry in the same place—a dictionary—which would reinforce the singular meaning of the mark. Even the online Urban Dictionary provides a running tally of visitor votes that either agree or disagree with the proposed definition, which demonstrates the population’s acceptance of the reported meaning.<sup>300</sup>

If other, less comprehensive resources are used, then the third prong requires further analysis. The sheer number of relevant websites may convince an examiner that the general population would accord a certain meaning to the term. However, the question becomes what percentage of the population must recognize a mark’s scandalous meaning before

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<sup>294</sup> 4 MCCARTHY, *supra* note 24, § 24:92.

<sup>295</sup> *Id.* (the standard for what constitutes fame is a high one).

<sup>296</sup> H.R. REP. NO. 104-374, at 7 (1995).

<sup>297</sup> 4 MCCARTHY, *supra* note 24, §§ 24:67.1, 24:92.

<sup>298</sup> *E.g.*, 15 U.S.C. § 1125(c)(2)(A); H.R. REP. NO. 109-23 (2005) (Statement of Rep. Berman noting that “dilution seems more akin to property protection . . . [and thus] any anti-dilution legislation should be carefully and narrowly crafted . . . to protect only the most famous trademarks. . .”).

<sup>299</sup> *See, e.g., In re Love Bottling Co.*, 2005 TTAB LEXIS 261, at \*21-22 (June 22, 2005).

<sup>300</sup> *See, e.g., supra* note 280 and accompanying text.

the mark is prohibited from receiving a national registration? There is no specific reason why a term must be nationally recognized to be prohibited under the scandalous registration prohibition. In fact, the registration prohibition justifications indicate that the federal government should do all in its power to avoid registering any marks that may be perceived as scandalous to any portion of the population. Such vigilance is consistent with Browne's position in his 1873 treatise, arguing that owners should choose marks that avoid offending even smaller groups of individuals.<sup>301</sup>

Further, nothing in the statutory language or the limited legislative history supports the current, national, substantial composite standard for determining scandalous marks. In fact, the foundation for the substantial composite standard is questionable at best. It was first articulated in *In re McGinley*, in which the majority claimed that the standard arose out of the *In re Riverbank Canning* decision.<sup>302</sup> However, as noted by the dissent in *McGinley*, the decision in *In re Riverbank Canning* did not include any references suggesting a substantial composite standard.<sup>303</sup>

The foundation for the standard is likely the TTAB's argument that the court should adopt a national standard because "[i]t would be impractical to require the examining corps to be familiar with the community standards in each state or federal district."<sup>304</sup> Such claims are disingenuous, however, because they offer only the stark dichotomy of either a national standard or a state standard. Moreover, the PTO's concerns regarding the difficulty of identifying more localized slang are unfounded, as this is the kind of inquiry undertaken on a fairly regular basis in this and other arenas. For example, the current obscenity standard requires that obscenity be determined by contemporary community standards rather than national standards.<sup>305</sup> Even under its current standard, the PTO regularly addresses this issue because it has never required a determination that a mark would have to be scandalous to everyone from the northern tip of Alaska to the southern tip of Puerto Rico. Further, the resources available to the PTO, including Internet searching capabilities and access to slang dictionaries, give the PTO Examiner a substantial basis for determining whether a mark would be considered

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<sup>301</sup> See BROWNE II, *supra* note 29, at 608-09 (discussing the need to protect emblems of any religion from desecration, which would presumably include religions that are practiced by a very small population within the United States).

<sup>302</sup> *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981).

<sup>303</sup> *Id.* at 487 (Rich, J., dissenting).

<sup>304</sup> *Id.* at 484 (majority opinion, quoting the Solicitor, Patent and Trademark Office).

<sup>305</sup> See, e.g., *Miller v. California*, 413 U.S. 15, 37 (1973).

scandalous or immoral within a more limited geographically region. Even if the PTO improvidently allows a mark through the examination process, the general public can oppose or cancel the mark's registration.<sup>306</sup> Thus, the TTAB's claims of an impossible burden ring rather hollow.

Moreover, the current substantial composite of the general public standard is neither a bright-line nor an inclusive standard. Once again, reference to standards applied to famous marks is helpful in formulating a clearer standard for scandalousness. In the context of niche geographic fame, courts have considered marks to be famous based upon general recognition within a five state area as well as recognition within two counties of one state.<sup>307</sup> These courts required fame within multiple, preexisting geographic divisions, which creates a clear bright-line rule. Similarly, if a geographically recognized region of the country attributes a vulgar or scandalous meaning to a mark or term within a mark, then such a level of scandalousness satisfies the proposed first tier of the test.

Some courts have criticized the use of smaller regions for a dilution claim, noting that fame in a single state or a region within three states is insufficient.<sup>308</sup> However, these critics have specific concerns that are irrelevant to the scandalous registration prohibition. Some of the critics point to the dilution legislative history and statutory language as indicating that Congress authorized dilution protection for marks having fame only when their fame has a substantially national reach.<sup>309</sup> Thus, after examining the legislative history, the Seventh Circuit rejected the idea that dilution extended to niche, geographically famous marks because the court believed that "Congress intended that" dilution protect only marks perceived as famous within "a substantial segment of the United States."<sup>310</sup> Others criticize niche geographic fame merely as a means for bypassing the purposefully high standard for fame.<sup>311</sup> Another criticism is that niche

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<sup>306</sup> 15 U.S.C. §§ 1063-1064 (2006).

<sup>307</sup> *Gazette Newspapers v. New Paper*, 934 F. Supp. 688, 690-91, 697 (D. Md. 1996) (finding that recognition in a region of several towns was sufficient); *WAWA, Inc., v. Haaf*, 1996 U.S. Dist. LEXIS 11494, at \*3, \*5 (E.D. Pa. Aug. 7, 1996) (finding that recognition in a region of five states was sufficient).

<sup>308</sup> *See, e.g., Star Mkts., Ltd., v. Texaco, Inc.*, 950 F. Supp. 1030, 1034-35 (D. Haw. 1996); *GreenPoint Fin. Corp. v. Sperry & Hutchinson Co.*, 116 F. Supp. 2d 405, 413 (S.D.N.Y. 2000) (holding that a mark cannot be famous under the federal statute when the mark is only famous within the tri-state area).

<sup>309</sup> H.R. REP. NO. 104-374, at 3, 7 (1995) ("The geographic fame of the mark must extend throughout a substantial portion of the U.S.").

<sup>310</sup> *Syndicate Sales, Inc. v. Hampshire Paper Corp.*, 192 F.3d 633, 641 n.7 (7th Cir. 1999).

<sup>311</sup> *See, e.g., Michael A. Carrier, Cabining Intellectual Property Through a Property Paradigm*, 54 DUKE L.J. 1, 20 n.59 (2004) (noting that Congress intended the standard to be high

geographic fame gives insufficient notice to companies in other parts of the United States and undercuts Congress' goal of promoting uniformity and consistency in the law of trademarks.<sup>312</sup> None of these arguments is applicable to the scandalous registration prohibition. In particular, marks classified as scandalous are given *less* protection, as opposed to marks classified as famous, which are given *more* protection. Moreover, most, if not all, entities considering a new trademark would have access to the same resources as the PTO and should take advantage of these resources to screen potential new trademarks for unavailability. Thus, potential trademark owners would have notice of localized, slang terms with scandalous connotations. Concerns about overextending the rights of trademark holders or providing improper notice to others are truly inapplicable in the context of scandalous marks. Instead, the main concern should be creating a consistent standard that would allow potential trademark owners to predict if their proposed marks will be refused as scandalous.

Thus, *per se* scandalous marks would be evaluated based upon a three part test: (1) evaluate if the mark or a phrase within the mark has a singular meaning; (2) determine if the singular meaning is one that would be scandalous or immoral; and (3) verify that a significant portion of the population within multiple, preexisting geographic regions ascribes the scandalous or immoral meaning to the mark or term within the mark.<sup>313</sup> Under this three-pronged analysis, the PTO should have less variability in making its determinations for *per se* scandalous marks. On the other hand, if the examiner has any doubt, the mark should not be accorded the status of a *per se* scandalous mark and, instead, should be evaluated under the second tier.

Compare this proposed test to the evaluation of the JACK OFF marks. The Federal Circuit first considered the meaning of the mark by evaluating dictionary definitions, the entire context of the mark, including a picture, and the mark in the context of the marketplace and as applied to the goods or services described in the registration application.<sup>314</sup> After determining the general meaning, the Federal Circuit considered whether the mark was scandalous to a substantial composite (not necessarily a majority) of the general public.<sup>315</sup>

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and courts have expansively interpreted fame by "analyzing [it] in local markets").

<sup>312</sup> 4 MCCARTHY, *supra* note 24, § 24.92.

<sup>313</sup> For purposes of this test and as discussed previously, this first tier would also include marks that have multiple meanings if all the meanings are vulgar, as may be true with phrases like "jack off."

<sup>314</sup> *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1340 (Fed. Cir. 2003).

<sup>315</sup> *Id.*

The problem with the Federal Circuit's test is that there is a tremendous level of ambiguity and uncertainty inserted into the inquiry as soon as the court examines the mark's context, which is how the court justified allowing registration of JACK OFF JILL for a musical group but prohibiting registration of JACK-OFF for adult-oriented conversations by telephone. Such uncertainty is unnecessary for terms with a singular meaning referencing vulgarity or illegality, and the proposed test would eliminate the inconsistency in the PTO's prior decisions. The Ninth Circuit has stated that strictly policing the famousness requirement will lead to predictability in applying dilution claims.<sup>316</sup> Likewise, a strict application of the proposed test for *per se* scandalous marks will increase predictability in categorizing marks as scandalous.

B. *The Second Tier of Scandalous Marks: Contextual Scandalous Marks*

The proposed second tier consists of marks that are scandalous when considered in context. Most of the marks recently evaluated for scandalousness in reported decisions likely would fall within the *per se* category, such as THE BEARDED CLAM or JACK OFF. The second tier would contain marks with terms that have multiple meanings, including at least one meaning that denotes vulgarity or illegality, such as BIG PECKER BRAND.

A unique aspect of the second tier proposal is implementation of a presumption against the applicant. Under the current standard, examining bodies appear to use the contextual approach mostly to find that the mark is not scandalous, which is what happened with the BIG PECKER BRAND mark, rather than to place the mark into the scandalous category.<sup>317</sup> This is most likely a side-effect of the current burden of proof standard, which places the burden upon the PTO to prove that a trademark falls within any of the section 2 prohibitions.<sup>318</sup> For example, in *In re Friggin Barnyard*, the TTAB reversed a refusal to register FRIGGIN' for refrigerator magnets, even though the TTAB conceded that the applicant's proposed non-vulgar meaning is strained, because the PTO failed to satisfy its burden of proof.<sup>319</sup>

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<sup>316</sup> *Thane Int'l, Inc. v Trek Bicycle Corp.*, 305 F.3d 894, 908 (9th Cir. 2002). Of course, the Ninth Circuit was concerned with using the factors to *exclude* marks as failing to meet the fame standard, and the proposed test uses the same considerations to *include* marks within the scandalous registration prohibition.

<sup>317</sup> *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470 (T.T.A.B. 1988). *But see In re Zaharoni*, 2005 TTAB LEXIS 3 (Jan. 4, 2005) (finding that the applicant is using the term ASSHOLE for its vulgar meaning because the mark referred to the person buying the book).

<sup>318</sup> *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

<sup>319</sup> *In re Friggin Barnyard*, 1999 TTAB LEXIS 108, at \*8 (Mar. 30, 1999).

The scandalous registration prohibition should not be subject to the same standards as the other section 2 prohibitions. Unlike these other prohibitions, the scandalous registration prohibition is entirely unrelated to promoting fair competition or avoiding public deception. Rather, it is grounded in a desire to protect from offense—either to protect the general public from being subjected to offensive material or to protect the government from associating with or wasting resources protecting offensive material. It is more consistent with the implicit value judgment in all three justifications to refuse registration for marks that *may* be scandalous. Thus, any mark that consists of or comprises a term with a potentially scandalous connotation should be subject to a presumption of scandalousness unless the applicant overcomes the presumption by reference to the context. Moreover, shifting the burden to the applicant also gives notice to potential applicants regarding the difficulty in registering marks with the appearance of scandalousness, which serves to channel potential applicants away from such material. At the same time, this channeling function will not quash the speech of trademark owners. After weighing the costs and benefits of a potential trademark, potential owners may still choose to use a scandalous mark with the understanding that the mark cannot receive the benefits of a federal registration.

Assuming that the applicant chooses to defend its mark, it will have to demonstrate that the mark, when considered within its context, will suggest a non-vulgar meaning. To overcome the presumption of scandalousness, the relevant contextual factors must be discussed. These factors are all based on material intrinsic to the application: the remainder of the mark, the listed goods and services, and the limitations on the mark's reach.

The first step is to examine the term in the context of the remainder of the mark. For example, if the term is used in conjunction with an image, the image may steer the general audience towards the more innocuous definition, as occurred with **BIG PECKER BRAND**. However, the inquiry into the other elements of the mark should be limited to the mark as described in the application, rather than relying upon the packaging or other elements related to the manner in which the applicant has used or intends to use the mark. Unfortunately, the TTAB has allowed such material to influence it in the past. For example, the TTAB allowed the marks in *In re Old Glory Condom* and *In re Hershey* to register and refused registration to the mark in *In re Boulevard Entertainment* based upon the manner in which the

applicant was using the mark in the specimen or packaging.<sup>320</sup> Reliance upon such information is faulty at best. The only relevant inquiry is the public perception of the mark rather than the current intention of the mark's owner. Even if the packaging or submitted specimens add material, the applicant's use of the mark will not be so restricted forever; it is subject to the owner's whim. The only true limitations upon applicant's use of the mark are the restrictions included in the trademark application. Thus, for example, the owner of BIG PECKER BRAND could easily change their label to remove the bird image and replace it with a vulgar image or merely use the word mark without an image. Given the justifications for the scandalous registration prohibition, it would be more appropriate to require relevant limitations on the mark to be a permanent part of the mark rather than simply relying upon the applicant to always use the mark in the same manner. Applying such a rule strikes a balance between the scandalous registration prohibition and allowing marks like BIG PECKER BRAND to register.

The second contextual factor examines the associated goods and services identified in the application to evaluate if they tend to steer the mark towards the vulgar or non-vulgar meaning. For example, the goods associated with the BUBBY TRAP mark convinced the PTO and TTAB that the mark should be refused registration as scandalous because using the word "bubby" in connection with brassieres suggested the vulgar breast definition of "bubby" rather than the "little boy" definition.<sup>321</sup> However, it is critical to consider the marks in light of the goods or services identified in the application, which can sometimes be a larger or broader category than the good or service actually provided by the applicant. Thus, for example, when the TTAB considered a photograph of a nude man and woman embracing for a magazine, the TTAB properly considered the mark as used on a newsletter or social club services in the broad sense described in the application rather than in the narrow swinger's context for which the applicant actually used the mark.<sup>322</sup> Knowing that the PTO will carefully examine the described goods and services may channel applicants towards giving more specific descriptions.

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<sup>320</sup> *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1336 (Fed. Cir. 2003) (noting the applicant's advertisements emphasize the vulgar definition); *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216 (T.T.A.B. 1993) (noting the message on the package regarding using condoms to prevent AIDS); *Hershey*, 6 U.S.P.Q.2d 1470 (noting that the specimen shows the image of a bird next to BIG PECKER BRAND, which means that the public may think of the non-vulgar definition of "pecker").

<sup>321</sup> *Mavety Media*, 33 F.3d at 1372.

<sup>322</sup> *In re McGinley*, 660 F.2d 481, 483 n.4 (C.C.P.A. 1981).

Merely examining the full mark and the associated goods will not always be sufficient to determine how the mark will be perceived, as demonstrated by BLACK TAIL.<sup>323</sup> This leads to the third, and related, category of relevant information for determining whether the mark should be registered: trade channels, channels of distribution, and relevant audience. Under the current standard, the only audience considered is the general public. In fact, it is well settled that marks are presumed to be viewed by all potential audiences in all trade channels appropriate for the identified goods and services unless there are restrictions in the application.<sup>324</sup> Thus, for most applications, it is appropriate to consider whether the general public would perceive the mark to be scandalous.

However, to do so may exclude a layer of legal businesses, namely, those that the general public considers tawdry or immoral. Consider Boulevard Entertainment's applications to register JACK-OFF in association with entertainment services in the nature of adult-oriented conversations by telephone. At the end of its decision, the Federal Circuit addressed Boulevard Entertainment's claim that it should be able to receive a federal registration because sexually oriented publications are enthusiastic about receiving advertisements featuring the term "jack-off."<sup>325</sup> The Federal Circuit rejected such reasoning because such an assertion does not inform whether the term would be considered vulgar to people outside the sexually oriented publications industry.<sup>326</sup> Assuming for the moment that the mark was no longer universally identified as vulgar and fell in the contextual scandalous mark tier, Boulevard Entertainment would be able to obtain a registration if it restricted the services in its application to certain market channels, equaling limiting enforceability of the federal registration. Such limitations are often required by the PTO before a junior user can register a trademark.<sup>327</sup> A similar process of focusing on a specific industry, customer base, or other manner of delineating a narrow market will allow entrepreneurs in less savory businesses to obtain a federal registration and all the attendant benefits, while still protecting the general public from being faced with scandalous matter in the local supermarket.

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<sup>323</sup> *Boulevard*, 334 F.3d at 1373-74 (noting that BLACK TAIL could refer to the vulgar definition or the non-vulgar definition of buttocks).

<sup>324</sup> *See, e.g., Royal Appliance Mfr. v. Minuteman Int'l, Inc.*, 30 Fed. Appx. 964, 969 n.1 (Fed. Cir. 2002).

<sup>325</sup> *Boulevard*, 334 F.3d at 1342.

<sup>326</sup> *Id.*

<sup>327</sup> *See, e.g., In re Kanematsu-Gosho (U.S.A.) Inc.*, 196 U.S.P.Q. (BNA) 849, 850 (T.T.A.B. 1977) (finding that goods presumed to move through all trade channels unless the applicant included a restriction in the application).



Thus, the proposed second tier contains a presumption that material that could be scandalous would be prohibited, but also includes a mechanism to allow registration of certain marks that would be contextually scandalous for the general public. In large part, however, the proposed second tier effectuates the protective purpose of the scandalous registration prohibition by imposing a presumption against allowing registration that can only be overcome if the applicant properly narrowly tailors its mark or its description of goods and services.

#### CONCLUSION

Some would be happy to have either fame or infamy, believing that either is the path to immortality. Certainly, both are defined by wide-spread public perception. In the federal trademark registration system, however, Tieck is right. Only famous marks obtain the extra privileges and extra "life," whereas scandalous, or infamous, marks may as well never have existed. We may never know exactly why Congress enacted the scandalous registration prohibition in 1905, but the more recent congressional bodies have expressed little desire to clarify or remove the prohibition. One fact is clear from congressional action over the last century: the scandalous registration prohibition will continue to be part of our trademark regime.

Thus, it would better serve trademark applicants, federal trademark officials, and the general public if there were greater clarity regarding what is a scandalous mark and how one can avoid accidentally adopting a mark that can never obtain a federal registration. A two-tiered evaluation, which adapts to consider various meanings and various audiences, will better serve these channeling functions. Consistency breeds certainty, which guides applicants towards more appropriate marks, avoids accidental government imprimatur of scandalous marks, and preserves, rather than wastes, government resources.