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NSFW: An Empirical Study of Scandalous Trademarks

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Megan M. Carpenter & Mary Garner, *NSFW: An Empirical Study of Scandalous Trademarks*, 33 *Cardozo Arts & Ent. L. J.* 321 (2015).

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NSFW:
AN EMPIRICAL STUDY OF SCANDALOUS
TRADEMARKS[♦]

MEGAN M. CARPENTER*

MARY GARNER**

Abstract

This project is an empirical analysis of trademarks that have received rejections based on their “scandalous” nature. It is the first of its kind.

The Lanham Act bars registration for trademarks that are “scandalous” and “immoral.” While much has been written on the morality provisions in the Lanham Act, this piece is the first scholarly project that engages an empirical analysis of the Section 2(a) rejections based on scandalousness; it contains a look behind the scenes at how the morality provisions are applied throughout the trademark registration process. This study analyzes which marks are being rejected, what evidence is being used to reject them, and who the applicants are. Our data pays particularly close attention to the evidence used to determine whether a mark is scandalous. We also consider whether this bar is effective at removing these marks from the consumer marketplace.

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INTRODUCTION

Trademarks serve primarily to identify a source of goods and services.¹ This function enables trademarks to both reduce consumer search costs and incentivize producers to develop goodwill in their products and services.² Trademark rights are determined by priority of

¹ 15 U.S.C. § 1127 (2012) (“The term ‘trademark’ includes any word, name, symbol, or device, or any combination thereof . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”); Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L. J. 367, 417 (1999) (claiming that historically trademark ownership was attributed to the individual who “was conveniently placed and strongly motivated to vindicate the broader public interest in a mark’s ability to identify accurately the source of the goods to which it was attached.”).

² Scholars have long debated the proper balance and scope of these normative goals of trademark law. The view that a core value of trademark law is to reduce consumer search costs is associated with the Chicago School of law and economics. William N. Landes and Richard A. Posner, *The Economics of Trademark Law*, 78 TRADEMARK REP. 267, 267 (1988) (arguing that trademark law seeks to “promote economic efficiency”); Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 778 (2004) (commenting that the goal of trademark law has been to support information flow and reduce consumer search costs); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1695–96 (1999) (stating that the goal of trademark law is “to enable the public to identify easily a particular product from a particular source”); Lunney, *supra* note 1, at 432 (stating that “by enabling consumers to connect information to precise product[s] more accurately, trademarks help consumers express more accurately their preferences and tastes.”). Other scholars have criticized this approach and argued that trademark law has historically been designed as a mechanism to protect producer interests. See Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1848 (arguing that “‘traditional’ American trademark law was unapologetically producer-oriented. Trademark law, indeed all of unfair competition law, was designed to promote commercial morality and protect producers from illegitimate attempts to divert their trade.”). See also Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 623–24 (positing that trademark law may instead be

use in commerce, and trademark registration confers significant benefits to a mark owner.³ Trademark registration is a powerful tool for an entity interested in building a strong brand. Among other benefits, registration confers nationwide rights,⁴ serves as prima facie evidence of ownership of a particular mark,⁵ and enables enhanced protections against counterfeiting.⁶ Under the Lanham Act, certain types of trademarks cannot be registered; for the most part, these provisions correspond with the core function and purpose of trademark law. For example, trademarks that increase consumer search costs and create inefficiencies in the marketplace cannot be registered. These may include marks that are merely descriptive, as well as marks likely to cause consumer confusion or mislead consumers in some way.⁷

The Lanham Act also bars registration of marks that are scandalous or immoral.⁸ Under Section 2(a), marks cannot be registered

viewed as a system of rules designed to protect the integrity of a sign's meaning).

³ 15 U.S.C. §1127 defines use in commerce. For goods, the mark must be placed on the goods, or their containers, tags or labels, and must be sold or transported in commerce. For services, the mark must be displayed in the sale or advertising, and services must be rendered in commerce. Use requirements support the policies behind trademark law by enabling consumers to identify the source of goods and services, preventing reservation of rights in marks that are not being used in the marketplace, and putting others on notice of trademark rights.

⁴ 15 U.S.C. § 1057(c) (2012) (“Contingent on the registration of a mark on the principal register provided by this chapter, the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration . . .”). See discussion *infra* Part I.

⁵ *Id.* § 1057(b) (“A certificate of registration of a mark upon the principal register provided by this Act shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.”). See discussion *infra* Part I.

⁶ *Id.* § 1124 (“[N]o article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer, or trader, or of any manufacturer or trader located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trademark registered in accordance with the provisions of this Act or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any custom house of the United States.”). See discussion *infra* Part I.

⁷ *Id.* § 1052. For example, Section 2(d) of the Lanham Act bars registration for marks that:

Consist[] of or comprise[] a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

Id. § 1052(d). Section 2(e) bars registration for marks that, “when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them.” *Id.* § 1052(e).

⁸ *Id.* § 1052(a). The full text of Section 2(a) bars registration of marks that:

Consist[] of or comprise[] 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; or a geographical indication which, when used on or in connection with wines or spirits,

if they “comprise[] immoral . . . or scandalous matter.”⁹ This prohibition raises many questions. *How is this provision of the Lanham Act being applied in practice? Under what circumstances do examiners decide that a mark is scandalous or immoral? What is the impact of this provision on trademark owners? And what are the implications for trademark law as a whole?*

This project is the first of its kind. While much has been written on the morality provisions in the Lanham Act, this piece is the first to look behind the scenes and engage an empirical analysis of Section 2(a) rejections based on scandalousness. This project looks in-depth at trademarks that have received rejections based on their “scandalous” nature. We look at which marks are being rejected, what evidence is being used to reject them, and who the applicants are. We consider whether this bar is effective at removing these “scandalous” marks from the consumer marketplace. Our data pays particularly close attention to the evidence used to support a refusal based on scandalousness.

Our analysis proceeds in four parts. Part I discusses trademark registration and the morality provisions generally. We discuss the benefits of federal trademark registration, including the value of registration to both trademark owners and the system itself. We also discuss the development of the morality bars and their treatment in scholarly literature. Many scholars have been critical of the morality provisions both *de jure* and *de facto*, and solutions proposed in the literature vary.¹⁰ In Part II, we explain our methodology and the process by which we arrived at the data we present. Throughout the course of our research, we analyzed 232 trademark records containing applications that received a scandalousness refusal in either the first or

identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 2(9) of the Uruguay Round Agreements Act [19 U.S.C. §3501(9)]) enters into force with respect to the United States.

⁹ *Id.*

¹⁰ Jasmine Abdel-Khalik, *To Live in In-“Fame”-Y: Reconceiving Scandalous Marks as Analogous to Famous Marks*, 25 CARDOZO ARTS & ENT. L.J. 173, 214 (2007); Stephen R. Baird, *Moral Intervention in The Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661, 798 (1993); Megan M. Carpenter & Kathryn T. Murphy, *Calling Bulls**t on the Lanham Act: The 2(a) Bar for Immoral, Scandalous, and Disparaging Marks*, 49 U. LOUISVILLE L. REV. 465, 468–82 (2011); Christine Haight Farley, *Stabilizing Morality in Trademark Law*, 63 AM. U. L. REV. 1019 (2014); Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*, 101 TRADEMARK REP. 1476, 1533–1534 (2011); Ron Phillips, *A Case for Scandal and Immorality: Proposing Thin Protection of Controversial Trademarks*, 17 U. BAL. INTEL. PROP. L.J. 55, 71–72, 74, 76 (2008); Jendi B. Reiter, *Redskins and Scarlet Letters: Why “Immoral” and “Scandalous” Trademarks Should be Federally Registrable*, 6 FED. CIRCUIT B.J. 191, 209 (1996); Danwill Schwender, *Congressional Trademark Delusion: Section 2(a) Expands The Unclean Hands Doctrine Too Far*, 48 IDEA 225, 245 (2008); Regan Smith, *Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks*, 42 HARV. C.R.-C.L. L. REV. 451, 453 (2007).

second Office Action, and gathered information about the applicants, the marks, and the prosecution record. In Part III, we present our findings. While scandalousness is given its meaning from the perspective of a substantial composite of the general public in context of the relevant marketplace for the applicant's goods or services identified in the application, trademark examiners often refuse applications by reference to dictionary definitions alone.¹¹ Our findings indicate that the vast majority of Office Actions for refusals based on scandalousness do not consider the context of the marketplace at all; our data also indicate that context is the most common argument made by applicants to refute a rejection. The absence of consideration of context is true even for "niche" markets, such as adult entertainment. To the extent that examiners address context, they generally use it only to support the scandalous nature of the mark, rather than consider how context may make a mark less scandalous: If a mark is used on "scandalous" goods or services, that use reinforces the scandalous nature of the mark; if a mark of questionable taste is used on general goods, it becomes more scandalous in context. Furthermore, our data indicate that refusals and approvals are highly inconsistent and unpredictable. We find that the morality bars found in Section 2(a) have a disproportionate impact on individuals and small businesses, which are the primary applicants for such marks. These applicants are more likely to file applications *pro se* and are less likely to file responses to Office Actions, choosing instead (or by default) to simply abandon the application. Finally, most of these marks are still in use, either by the applicant or by third parties, even after refusal of registration, something that frustrates one of the key purposes of the morality bar.

I. THE TRADEMARK SYSTEM AND MORALITY

Trademark law seeks to foster fair competition. As the federal instrument of trademark law, the purpose of the Lanham Act is twofold; at its base, it is both a consumer protection mechanism and a producer protection mechanism.¹² It seeks to reduce consumer search costs by assuring consumers that they are buying the goods they believe

¹¹ See *In re Blvd Entm't, Inc.*, 334 F.3d 1336, 1340–41 (Fed. Cir. 2003) ("[I]n a case in which the evidence shows that the mark has only one pertinent meaning, dictionary evidence alone can be sufficient to satisfy the PTO's burden.").

¹² See S. REP. NO. 79-1333, at 3 (1946), reprinted in 1946 U.S.C.C.A.N. 1274,1274 ("The purpose underlying any trade-mark statute is twofold. One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trade-mark owner.").

they are buying with the qualities they expect from a particular brand.¹³ Thus, it also incentivizes producers to invest time, money, and energy into the quality of goods and services presented to the public under a particular mark.¹⁴

A. Trademark Registration is Valuable Both to Trademark Owners and to the Trademark System as a Whole

The federal registration system is a key element of brand strategy for trademark owners. While common law trademark rights accrue through use of the mark in commerce, federal registration of a trademark provides additional substantive and procedural rights that are unavailable to common law marks.¹⁵ Marks may be registered on either the Principal or Supplemental Register.¹⁶ Federal registration on the Principal Register confers the greatest benefit to a trademark owner. It creates a statutory presumption that the trademark is valid, the registrant is the owner of that mark, and that the registrant has the exclusive right to use it on or in connection with the goods or services listed in the registration.¹⁷ Registration on the Principal Register also serves as constructive notice of a claim of ownership, eliminating third-party defenses based on good faith adoption and use after the registration date.¹⁸ Marks on the Principal Register also enjoy nationwide priority

¹³ *Id.* at 4, reprinted in 1946 U.S.C.C.A.N. at 1275 (“Trade-marks, indeed, are the essence of competition, because they make possible a choice between competing articles by enabling the buyer to distinguish one from the other. Trademarks encourage the maintenance of quality by securing to the producer the benefit of the good reputation which excellence creates. To protect trade-marks, therefore, is to protect the public from deceit, to foster fair competition, and to secure to the business community the advantages of reputation and good will by preventing their diversion from those who have created them to those who have not.”). *But see* McKenna, *supra* note 2, at 1840–41 (arguing that trademark law was not traditionally intended to protect consumers, and instead, “like all unfair competition law, sought to protect producers from illegitimate diversions of their trade by competitors.”).

¹⁴ S. REP. NO. 79-1333. *See* McKenna, *supra* note 2, at 1840–41.

¹⁵ Common law rights arise from use of a mark in commerce. Unregistered marks have limited rights at common law and under the Lanham Act. 15 U.S.C. § 1125(a) (2012) (establishing a cause of action in Section 43(a) for infringement of unregistered marks). Additional rights available to registered marks can be found in 15 U.S.C. §§ 1051–1072.

¹⁶ Applicants must specify whether they are applying to register a mark on the Principal or Supplemental Register. If an applicant does not specify, the examining attorney will require the applicant to amend the application to specify only one, or to file a request to divide the application under 27 C.F.R. § 2.87. USPTO, Trademark Manual of Examining Procedure (TMEP) § 801.02(b) (2015). If an applicant does not specify a particular register in an application, the examiner will presume the applicant intends to apply for the Principal Register. TMEP § 801.02(a); TMEP § 801.02(b); 15 U.S.C. §§ 1051–1072; 15 U.S.C. §§ 1091–1096.

¹⁷ 15 U.S.C. § 1057(b) (“A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.”).

¹⁸ 15 U.S.C. § 1072 (“Registration of a mark on the principal register provided by this chapter or under the Act of March 3, 1981, or the Act of February 20, 1905, shall be constructive notice of

in direct contrast to common law rights, which only extend to the geographical reach of the market.¹⁹ They can become “incontestable” after five years of continuous use, after which time they can only be challenged on limited statutory grounds.²⁰ And owners of marks on the Principal Register can file the certificate of registration with the U.S. Customs Service to prevent importation of infringing foreign goods.²¹

The Supplemental Register, on the other hand, is for registration of marks that are not inherently distinctive and have not yet acquired secondary meaning. While these marks are capable of distinguishing the applicant’s goods or services, they do not yet signify in the minds of the public a particular source of goods or services. While marks on the Supplemental Register do not enjoy the full extent of benefits of those registered on the Primary Register, it does enable use of the registered trademark symbol, acts as a bar to registration of confusingly similar marks, and may serve as the basis for an international trademark application.²²

B. Section 2(a) of the Lanham Act Bars Registration of Marks that are Scandalous or Immoral

Section 2(a) bars registration of marks that are “scandalous” or “immoral.”²³ While scandalousness and immorality are not precisely

the registrant’s claim of ownership thereof.”).

¹⁹ 15 U.S.C. § 1057(c) (“Contingent on the registration of a mark on the principal register provided by this chapter, the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration . . .”).

²⁰ 15 U.S.C. § 1065 (“Except on a ground for which application to cancel may be filed at any time under paragraphs (3) and (5) of section 1064 of this title, and except to the extent, if any, to which the use of a mark registered on the principal register infringes a valid right acquired under the law of any State or Territory . . . the right of the owner to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable.”).

²¹ 15 U.S.C. § 1124 (“[N]o article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer, or trader, or of any manufacturer or trader located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trademark registered in accordance with the provisions of this chapter or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any custom house of the United States . . .”).

²² See TMEP §§ 815, 816 for procedures related to registration of marks on the Supplemental Register. 15 U.S.C. § 1094 (“The provisions of this chapter shall govern so far as applicable applications for registration and registrations on the supplemental register as well as those on the principal register, but applications for and registrations on the supplemental register shall not be subject to or receive the advantages of sections 1051(b), 1052(e), 1052(f), 1057(b), 1057(c), 1062(a), 1063 to 1068, inclusive, 1072, 1115, and 1124 of this title.”).

²³ The 1905 Trade-Mark Act was the first to ban trademarks of ill-repute. Trade-Mark Act of 1905 § 5(a), 15 U.S.C. § 85(a) (1946) (repealed 1946) (current version at 15 U.S.C. § 1052 (2012)) (“That no mark by which the goods of the owner of the mark may be distinguished from

synonymous, courts include immoral matter within the parameters of scandalousness; there are no cases that directly and independently consider immorality.²⁴ Whether a mark is barred for moral reasons, thus, is evaluated according to the ordinary and common meaning of the word “scandalous” in 1938, when the provision was introduced.²⁵ According to the 1938 dictionary, scandalous matter is “shocking to the sense of propriety, offensive to the conscience or moral feelings or calling out for condemnation.”²⁶ During that period of time, it was common to regulate content based on its scandalous nature. The Motion Picture Production Code,²⁷ also called the Hays Code, prohibited a variety of content based on moral judgment, including pointed profanity,²⁸ miscegenation,²⁹ revenge in modern times,³⁰ and dances that emphasize indecent movements.³¹ It further restricted content by requiring particular care for subjects like methods of crime,³² sympathy for criminals,³³ childbirth,³⁴ and suggestive postures and

other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark [c]onsists of or comprises immoral or scandalous matter.”). This prohibition was imported into the Lanham Act by Fritz Lanham, a Texas Congressman who introduced the Act in 1938. In section 2(a) of the Lanham Act, Congress has explicitly forbidden registration for certain categories of marks including those that “[c]onsist[] of or comprise[] immoral . . . or scandalous matter; or matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute . . .” 15 U.S.C. § 1052(a).

²⁴ See *In re McGinley*, 660 F.2d 481, 484 n.6 (C.C.P.A. 1981), *aff’g* 206 U.S.P.Q. (BNA) 753 (T.T.A.B. 1979) (“Because of our holding, *infra*, that appellant’s mark is ‘scandalous,’ it is unnecessary to consider whether appellant’s mark is ‘immoral.’ We note the dearth of reported trademark decisions in which the term ‘immoral’ has been directly applied.”).

²⁵ *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938).

²⁶ *Id.* at 328 (defining scandalous according to the Funk & Wagnalls New Standard Dictionary as “1. Causing or tending to cause scandal; * * * shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable. * * *” and the 1932 Webster’s New International Dictionary as “2. Giving offense to the conscience or moral feelings; exciting reprobation; calling out for condemnation. * * *” Most modern Office Action rejections based on scandalousness repeat this language verbatim). See, e.g., *In re McGinley*, 660 F.2d at 486.

²⁷ A CODE TO GOVERN THE MAKING OF TALKING AND MOTION PICTURES (Motion Pictures Producers and Distributors of America, Inc. 1930) (“Motion picture producers . . . know that the motion picture within its own field of entertainment may be directly responsible for spiritual or moral progress, for higher types of social life, and for much correct thinking. During the rapid transition from silent to talking pictures they have realized the necessity and the opportunity of subscribing to a Code to govern the production of talking pictures and of re-acknowledging this responsibility.”).

²⁸ *Id.* ¶ V., (“Pointed profanity (this includes the words, God, Lord, Jesus, Christ - unless used reverently - Hell, S.O.B., damn, Gawd), or every other profane or vulgar expression however used, is forbidden.”).

²⁹ *Id.* ¶ II(6). Incidentally, “white slavery” was also forbidden, but, notably, not black slavery. *Id.* ¶ II(5).

³⁰ *Id.* ¶ I(1)(c) (“Revenge in modern times shall not be justified.”).

³¹ *Id.* ¶ VII(2) (“Dances which emphasize indecent movements are to be regarded as obscene.”).

³² *Id.* ¶ I(2) (“Methods of crime should not be explicitly presented.”).

³³ *Id.* ¶ I (Crimes against the law “shall never be presented in such a way as to throw sympathy with the crime as against law and justice or to inspire others with a desire for imitation.”).

³⁴ *Id.* ¶ II(8) (“Scenes of actual child birth, in fact or in silhouette, are never to be presented.”).

gestures.³⁵

While the Hays Code claimed a moral responsibility to bring entertainment to a “higher level of wholesome[ness] . . . for all the people,”³⁶ the legislative history of the Lanham Act does not provide insight into the purpose of the prohibition on scandalous trademarks. Scholars generally speculate that reasons for the ban on registration of these marks may include a desire to protect the public welfare and morals, a government refusal to put an official imprimatur on marks that are scandalous and immoral, and a position that the government should not put resources into protecting marks of questionable taste.³⁷

C. Morality Bars Have Been Criticized Across the Spectrum of Intellectual Property

Although other forms of intellectual property, including copyright and patent, have discriminated against works based on morality in the past, there has been a trend towards eliminating restrictions based on morality. In the past, copyright law contained bars to protection based on morality, a restriction that has since been removed. While Congress has generally construed the term “writings” in the Intellectual Property Clause of the Constitution broadly to cover almost every type of literary property, “obscene” works were denied copyright protection until fairly recently.³⁸ The modern view is to afford copyright protection to all eligible works, regardless if a community regards a work as immoral or obscene.³⁹ The Fifth and Ninth Circuits have expressly held that obscene works are copyrightable, reasoning that the need for national copyright protection outweighs the state and federal public policies against obscenity.⁴⁰ This is the approach taken by the Copyright Office

³⁵ *Id.* ¶ II(2)(b) (“Excessive and lustful kissing, lustful embraces, suggestive postures and gestures, are not to be shown.”)

³⁶ *Id.* Preamble.

³⁷ Carpenter & Murphy, *supra* note 10, at 468 (citing Baird, *supra* note 10, at 788).

³⁸ *See*, Hoffman v. Le Traunik, 209 F. 375, 379 (N.D.N.Y. 1913) (holding that works must be “free from illegality or immorality” to obtain copyright protection); *contra* Mitchell Bros. Film Group v. Cinema Adult Theater, 604 F.2d 852 (5th Cir. 1979), *cert. denied*, 445 U.S. 917 (1980) (removing immoral standard).

³⁹ *See* 1-2 MELVILLE B. NIMMER AND DAVID NIMMER, NIMMER ON COPYRIGHT § 2.17 (“*Mitchell* expressly held that a work is not excluded from copyright protection by reasons of its obscene content. This may be taken as the currently prevailing view, although in the past, a number of courts took the view that obscene works are not eligible for copyright.”)

⁴⁰ *Jartech, Inc., v. Clancy*, 666 F.2d 403 (9th Cir. 1982); *Mitchell Bros. Film Group*, 604 F.2d at 862. In 1979, the Fifth Circuit held in *Mitchell Brothers* that works could not be excluded from copyright because of obscene content. In *Mitchell Brothers*, copyright owners of the adult film *Behind the Green Door* brought an infringement suit against a group of theater owners showing the film without permission. Defendants argued that the copyright holders brought suit with “unclean hands,” and that equity should uphold obscenity as an affirmative defense to infringement. The Fifth Circuit did not agree, rejecting the “moral conservator theory of copyright invalidation,” the “property interest theory,” and the unclean hands equitable doctrine. The court reasoned that Congress had intentionally omitted, and therefore did not intend, a bar for immoral

today.

Patents were once invalidated based on a theory of moral utility, requiring “. . . the invention [to] not be frivolous or injurious to the well being, good policy, or sound morals of society.”⁴¹ Under this definition, “immoral” or “mischievous” inventions were not patentable because those uses were not beneficial to society. The evolution to disregard morality as a basis for patentability is well illustrated in the context of gambling. In 1889, devices related to gambling were found to lack utility, and thus were not patentable.⁴² However, an invention that was solely used for gambling was granted a patent in 1977.⁴³ In *Ex parte Murphy*, the Board stated that the U.S. Patent and Trademark Office (“USPTO”) “should not be the agency which seeks to enforce a standard of morality with respect to gambling, by refusing, on the ground of lack of patentable utility, to grant a patent.”⁴⁴ The moral utility theory has not been used since that time, a fact that has led scholars to characterize it as a relic of the past.⁴⁵

Many scholars have been critical of the morality provisions both *de jure* and *de facto*, and proposed solutions vary.⁴⁶ Critics of the bar

or obscene works. The court further argued that denying copyright to obscene works was contrary to the Intellectual Property Clause’s purpose of promoting creativity, and reasoned that the market was the appropriate arbitrator in determining if a work is fit for public consumption. The Ninth Circuit followed the reasoning of the Fifth Circuit in *Jartech*, a case decided three years after the *Mitchell Brothers* decision and the first major copyright-morality case under the Copyright Act of 1976. The issue of copyrightability of obscene material has remained untouched at the appellate level since *Jartech*.

⁴¹ Lowell v. Lewis, 15 F. Cas. 1018, 1019 (D. Mass. 1817) (No. 8568); Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(a) Trademark Law After Lawrence v. Texas*, 9 MARQ. INTELL. PROP. L. REV. 187, 205 n.88 (2005).

⁴² Nat’l Automatic Device Co. v. Lloyd, 40 F. 89, 89–90 (N.D. Ill. 1889).

⁴³ *Ex parte Murphy*, 200 U.S.P.Q. 801, 802–803 (B.P.A.I. Apr. 29, 1977).

⁴⁴ *Id.* “While some may consider gambling to be injurious to the public morals and the good order of society, we cannot find any basis in [35 U.S.C. 101] or related sections which justify a conclusion that inventions which are useful only for gambling ipso facto are void of patentable utility.” *Id.*

⁴⁵ Cynthia M. Ho, *Splicing Morality and Patent Law: Issues Arising from Mixing Mice and Men*, 2 WASH. U. J.L. & POL’Y 247, 248 (2000). In the landmark case *Juicy Whip, Inc. v. Orange Bang, Inc.*, the patent in question created the illusion that liquid was being dispensed from a container above a spout when it was really pumped from a container hidden below the counter. When Juicy Whip sued a competitor for infringement, the competitor claimed that the patent was invalid because it lacked utility due to its deceptiveness. The district court found the patent invalid because its purpose was to increase sales by deception, but the 2nd Circuit reversed. The court reasoned “the fact that one product can be altered to make it look like another is in itself a specific benefit sufficient to satisfy the statutory requirement of utility.” The court subsequently described several issued patents that had utility because they were designed to represent something that they were not. *Juicy Whip, Inc. v. Orange Band, Inc.*, 185 F.3d 1364, 1366–67 (Fed. Cir. 1999) (“. . . but the principle that inventions are invalid if they are principally designed to serve immoral or illegal purposes has not been applied broadly in recent years.”).

⁴⁶ Abdel-Khalik, *supra* note 10, at 214; Baird, *supra* note 10, at 798; Farley, *supra* note 10; LaLonde & Gilson, *supra* note 10, at 1533–34; Phillips, *supra* note 10, at 71–72, 74, 76; Reiter, *supra* note 10, at 209; Schwender, *supra* note 10, at 245; Smith, *supra* note 10, at 453. .

have accused it of being ineffective, inconsistent, and possibly illegal.⁴⁷ Several scholars have questioned whether the bar has been at all effective in removing offensive trademarks from the marketplace, or whether it has merely removed them from the screen of the federal register.⁴⁸ Furthermore, inconsistencies exist in the application of the bar, both internally and with regard to the basic purpose and function of trademark law.⁴⁹ Scholars have also considered whether the provision violates the First Amendment protections of the U.S. Constitution.⁵⁰ Even defenders of the provision have suggested solutions to “fix” the problems presented by the bar.⁵¹ Proposed solutions include eliminating the terms “scandalous” and “immoral” from the statute altogether, amending the statute to provide more specificity, and devising new procedures to better effectuate the object and purpose of the bars.⁵²

In this paper, we do not seek to solve the problems presented by the morality bars found in Section 2(a) of the Lanham Act. Rather, we recognize that in order to be effective, the first step to any solution is to seek a thorough understanding of the depth and breadth of the problem itself. Accordingly, this paper presents an empirical analysis of the application of the scandalousness bar.

II. METHODOLOGY

We examined an original dataset of 232 trademark records containing a Section 2(a) refusal based on scandalousness and immorality for applications filed between 2001 and 2011. Because the USPTO’s database does not enable searches by grounds for refusal of a particular mark, based on previous research and study we used the USPTO’s Trademark Electronic Search System (“TESS”) to search for marks containing terms that would likely meet trademark examiners’ criteria for a Section 2(a) refusal on these grounds. Once we identified salient terms for particular refusals, we searched for a sample of additional marks containing those terms, and extrapolated to additional related marks across the broad spectrum of categories for refusal outlined by Gilson and LaLonde: profanity; sex; violence; disability; ethnicity; religion; politics; and scatology.⁵³

We reviewed the life cycle of the trademark application in its entirety for each mark, from application through either final refusal or

⁴⁷ Carpenter & Murphy, *supra* note 10.

⁴⁸ Carpenter & Murphy, *supra* note 10, at 468–73; LaLonde & Gilson, *supra* note 10, at 1534.

⁴⁹ Carpenter & Murphy, *supra* note 10, at 468–73; LaLonde & Gilson, *supra* note 10, at 1534.

⁵⁰ See Baird, *supra* note 10, at 661; Smith, *supra* note 10, at 451.

⁵¹ See, e.g., Farley, *supra* note 10, at 101.

⁵² See Abdel-Khalik *supra* note 10 (arguing for a two-tiered approach to determine whether a mark is scandalous); Reiter, *supra* note 10; Schwender, *supra* note 10 (arguing that the market should be sufficient to weed out objectionable marks).

⁵³ LaLonde & Gilson, *supra* note 10, at 1510–30.

registration, in an effort to examine how trademark applications are being analyzed based on this particular provision of Section 2(a). Our dataset includes a variety of information about the applicants, the marks themselves, and the goods/services identified in the application. It also includes an analysis of any Office Actions issued by the USPTO, including grounds for refusal, evidence presented, and explicit reasoning of the examining attorney. It includes information about any Office Action responses filed on behalf of the applicant, including rate of response and arguments submitted, as well as the final dispensation of the application.

When analyzing the USPTO record for each mark, we looked at each Office Action issued and the applicant's responses, where applicable.⁵⁴ In order to determine whether context was used in an examiner's evaluation of a particular application, we considered whether the examiner or applicant referred specifically to the goods, the marketplace those goods are or would be sold in, internet evidence such as computer filters or search results, the visual context of the mark itself, alternate meanings of the word(s), and any evidence the word is or is not scandalous in society, as well as other individual arguments as raised by the applicants or examiner.⁵⁵ We did not count third-party registrations and refusals as a contextual factor, although applicants frequently used this information as an argument in support of registration.⁵⁶

In order to assess inconsistencies between or within the disposition of applications by the USPTO, we also did a "deep-dive" into a few specific terms for which marks were rejected by examiners. These terms include: BITCH, POTHEAD, SHIT, SLUT, and WHORE. We selected these marks based on identified inconsistencies in the dataset. For these terms, to provide a representative sample we searched all marks containing those terms, and selected marks identified by the Basic Index field of the Structured Search engine of the TESS of the USPTO with an application date of even years during the selected research period.⁵⁷ Where there were more than thirty-five such marks for each year, we only reviewed the first thirty-five listed. For these marks, we reviewed all trademark proceedings from application through to registration or final refusal.

⁵⁴ There are a few marks where the USPTO record is incomplete, consisting solely of a registration certificate. *See, e.g.*, KICK ASS LIMITED, Registration No. 2,039,645.

⁵⁵ This included evidence such as internet searches, articles, other media using the word, and FCC rulings and standards. For applicants, we also considered arguments such as that the mark was self-referential, regulations, and the consumer market. *See infra* Part III.A–B.

⁵⁶ Though the presence in the marketplace of other marks with similar words would be relevant, registration is not required to use a mark and thus not a contextual factor at issue in those situations.

⁵⁷ The years included 2000; 2002; 2004; 2006; 2008; and 2010.

In addition to an examination of the trademark records, we sought to obtain additional information about post-registration use of marks that received a final refusal. For each rejected mark, we performed an internet search in an effort to determine whether the mark was still in use, and, if so, whether the original applicant was the one (or one of the ones) using that mark.⁵⁸

III. EMPIRICAL FINDINGS

A. Scandalousness is to be Determined in the Context of the Marketplace, yet Most Refusals Fail to Consider Context of any Kind

The determination of whether a mark is scandalous must be made in the context of current attitudes of the day.⁵⁹ A trademark is scandalous or immoral in context of the relevant marketplace for the applicant's goods or services identified in the application.⁶⁰ Those attitudes must be ascertained from the standpoint of a "substantial composite of the general public," not necessarily a majority.⁶¹ Thus, in summary, the relevant inquiry is whether a substantial composite of the general public would find the mark scandalous in the context of that particular marketplace in contemporary society.

However, over 73% of refusals issued by examiners on the grounds of scandalousness failed to discuss context of any kind, including the context of the relevant marketplace for the goods and services identified in the application. Though nearly a quarter of the applications we reviewed were targeted at niche markets, the fact that a particular mark was intended for a niche, rather than a general, market did not appear to weigh significantly in the calculation of whether a trademark application was rejected or approved for publication. While the marketplace is a key aspect of the legal standard, it did not significantly impact the rates of refusal.

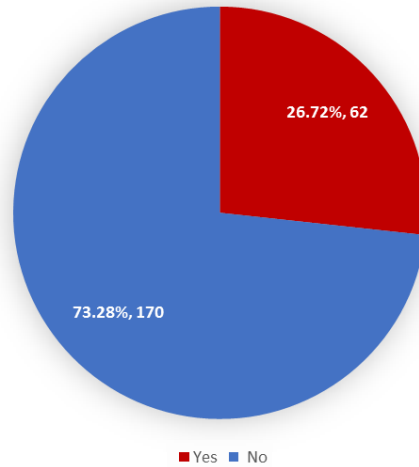
⁵⁸ While we were unable to obtain information about every mark, where we were able to locate the mark, the information obtained was notable. See *infra* Part III.G.

⁵⁹ *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367 (Fed. Cir. 1994); *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981); *In re Wilcher Corp.*, 40 U.S.P.Q.2d1929 (T.T.A.B. 1996); *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d 1635, 1639 (T.T.A.B. 1988); TMEP § 1203.01.

⁶⁰ TMEP § 1203.01; *In re Mavety Media*, 33 F.3d at 1371; *In re McGinley*, 660 F.2d at 485.

⁶¹ *In re Mavety Media*, 33 F.3d at 1372–74 (noting the dearth of evidence before the court demonstrating which of multiple definitions of "tail" would be best understood by a substantial composite of the general public); *In re McGinley*, 660 F.2d at 485; *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216 (T.T.A.B. 1993) (finding that a design mark of a condom decorated with stars and stripes in a manner to suggest the American flag was not scandalous where it was presented in a patriotic and positive way); *In re Thomas Laboratories, Inc.*, 189 U.S.P.Q. 50, 52 (T.T.A.B. 1975) ("[I]t is imperative that fullest consideration be given to the moral values and conduct which contemporary society has deemed to be appropriate and acceptable.").

Did the Office Action Discuss Context?



The visual context of the mark itself was also often not addressed, unless either brought up by the applicant or when it served to reinforce the examiner's viewpoint of the vulgarity of the words in the mark. Overall, out of 53 marks with visual context to consider, the examiner was the first to reference this context in only 43% of these marks.⁶² The applicant argued visual context for the first time in 13% of these marks,⁶³ and in the remaining 43%, visual context was not addressed at all by either the applicant or the examiner.

If the USPTO examining attorneys fail to address context, which is a material part of the legal standard, what evidence is being used to refuse registrations based on scandalousness/immorality? The term "scandalous" has been held to encompass matter that is merely "vulgar."⁶⁴ Evidence of the opinions of a substantial composite of the general public can include media, including magazine articles, newspaper articles, and dictionary definitions.⁶⁵ Accordingly, the Federal Circuit has held that dictionary definitions alone can be sufficient to establish scandalousness where multiple dictionaries indicate a word is vulgar and the applicant's mark indicates the vulgar meaning of the word.⁶⁶

⁶² The examiner referenced visual context first in 43.4% of the marks. In 37.74% of marks with visual context, the examiner addressed such context in the initial Office Action. In 5.66%, the examiner brought up visual context for the first time in the second Office Action.

⁶³ 13.21% of marks with visual context, constituting seven of the 53 marks which had visual context.

⁶⁴ Vulgar has been defined as "lacking in taste, indelicate, morally crude." *In re Runsdorf*, 171 U.S.P.Q. (BNA) 443, 444 (T.T.A.B. 1971).

⁶⁵ TMEP § 1203.01.

⁶⁶ The applicant's use must be limited to the vulgar meaning of the word. *See In re Blvd Entm't*,

Trademark examiners are under pressure to meet high quarterly quotas of “balanced disposals” of applications.⁶⁷ Balanced disposals are credits that examiners are given as they complete work or take action on the total number of classes within a trademark application.⁶⁸ Quotas are based on the attorney’s grade level and quarterly production requirements. An examiner’s performance is evaluated based on quantity and quality according to the terms of the USPTO Performance Appraisal Plan.⁶⁹ To be “fully successful,” examining attorneys at a GS 9/11/2 ranking must have from 425–549 Balanced Disposals per quarter.⁷⁰ To be designated as “outstanding,” the attorney must have completed at least 515–75 balanced disposals.⁷¹ Aside from the quarterly quotas, examiners are under additional time pressures. For example, examiners are asked to complete examination of all new applications, including search of the mark and preparing an Office Action or a Notice of Allowance, within seven calendar days of receipt.⁷²

1. Dictionary Definitions were the Primary Evidence Used to Support a Refusal Based on Scandalousness

Where a particular mark contains words that are listed as “vulgar” in the dictionary, it may be the most expedient—and logical—course of action for an examiner to use dictionary definitions to quickly dictate acceptance or rejection of a mark. Examining attorneys under pressure to process applications quickly can either ascertain the meaning of a mark in the context of current attitudes of the day, which is the legal standard, or they can do a quick dictionary search and reject an

334 F.3d 1336, 1340–43 (Fed Cir. 2003) (1-800-JACK-OFF and JACK OFF were scandalous where multiple dictionary definitions indicated the term “jack off” was vulgar).

⁶⁷ GS 9/11/12 PERFORMANCE APPRAISAL PLAN, *available at* <http://www.nteu245.org/GS-9-11-12PAP.PDF>; GS 13/14 PERFORMANCE APPRAISAL PLAN, *available at* <http://www.nteu245.org/PAP13-14.pdf>.

⁶⁸ Examiners take one action for completing an initial examination and making a determination regarding the registrability of the mark or “first action” on an application, and one for either approving an application for publication or abandonment.

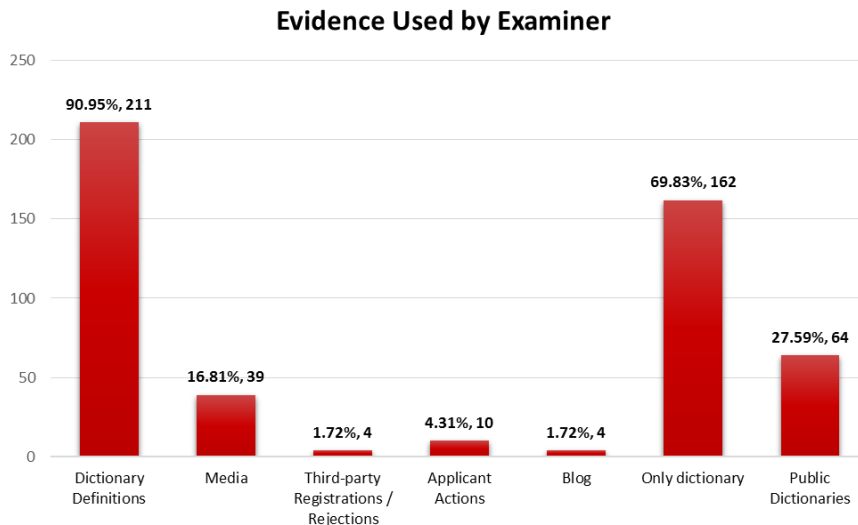
⁶⁹ GS 9/11/12 PERFORMANCE APPRAISAL PLAN, *supra* note 67; GS 13/14 PERFORMANCE APPRAISAL PLAN, *supra* note 67.

⁷⁰ GS 9/11/12 PERFORMANCE APPRAISAL PLAN, *supra* note 67; GS 13/14 PERFORMANCE APPRAISAL PLAN, *supra* note 67. *See also* MEMORANDUM OF UNDERSTANDING BETWEEN THE UNITED STATES PATENT AND TRADEMARK OFFICE AND NATIONAL TREASURY EMPLOYEES UNION, Chapter 245 TM GS-9/11/12 Performance Appraisal Plan, *available at* <http://www.nteu245.org/GS-9-11-12PAPMOU.pdf>.

⁷¹ GS 9/11/12 PERFORMANCE APPRAISAL PLAN, *supra* note 67; GS 13/14 PERFORMANCE APPRAISAL PLAN, *supra* note 67.

⁷² For amended applications, the examiner must review the application and take appropriate action within 21 calendar days. For applications returned for correction, the attorney advisor takes appropriate action within 7 calendar days. For applications returned for abandonment, the attorney advisor takes appropriate action within 14 calendar days. GS 9/11/12 PERFORMANCE APPRAISAL PLAN, *supra* note 69; GS 13/14 PERFORMANCE APPRAISAL PLAN, *supra* note 69.

application if it contains a word that is listed as “vulgar.” It is no wonder that the vast majority of applications that are rejected for scandalousness are rejected based on the fact that they contain a word that is listed as “vulgar” in the dictionary.



Of the records we reviewed, dictionary definitions were used as a primary source of support for a rejection based on scandalousness 91% of the time. Examiners used *only* the dictionary, without any other contextual information, as supporting evidence in 70% of Office Actions.⁷³ Public or crowd-sourced dictionaries were used in 27% of all rejections based on scandalousness.⁷⁴

2. The Use of Dictionary Definitions in the Abstract to Support a Refusal was Consistent Across Marketplaces, Including Niche Markets

The tendency of a trademark examiner to rely on dictionary definitions as the exclusive or primary evidence for a rejection based on scandalousness is consistent across diverse marketplaces. Though, on the face of the applications we reviewed, the bulk of marks are targeted for a general market, nearly a quarter (20%) of applications reviewed were explicitly targeted for niche markets, such as adult entertainment or adult-oriented goods.

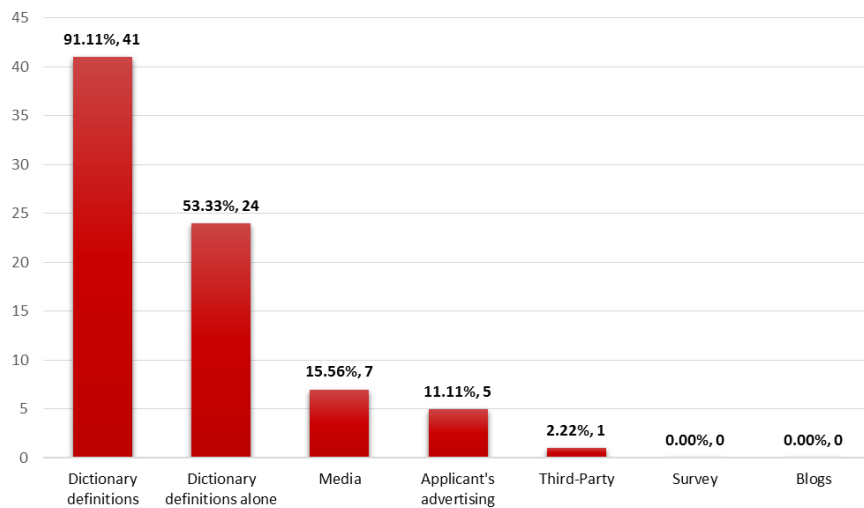
Even within the narrow context of those niche markets, dictionary definitions figured as primary evidence in refusals based on

⁷³ 162 Office Actions used only the dictionary as evidence for a rejection based on scandalousness. This is over three-quarters (76.78%) of the times that dictionaries are used as supporting evidence.

⁷⁴ Public or crowd-sourced dictionaries include dictionaries such as Urban Dictionary.

scandalousness 91% of the time. Of those rejections, dictionary definitions served as the *only* evidence used in over half (53%) of the refusals. Evidence regarding the narrowness of the marketplace did not appear to be considered, except to reinforce a scandalousness rejection.

Evidence Used by Examiner for Niche Markets



B. When Examiners do Consider the Context of the Marketplace, They Often do so as an Argument Against Registration

While examiners consider contextual information only infrequently, when they do consider context of the marketplace they often do so as an argument against registration.⁷⁵ This is the case whether or not the marketplace is a niche or general market. The consideration of context appears to be a Catch-22: If the marketplace is of an “adult” nature, that fact is used against the applicant as evidence that a scandalous meaning is intended by the mark. If the marketplace is a general consuming market, the examiner often rejects the mark because a questionable mark is especially scandalous in a general marketplace.

1. Use of a Mark in an Adult-Oriented Marketplace is Frequently Used as Evidence That the Mark Itself is Scandalous or Immoral

To the extent that examiners consider marketplace context, an adult-oriented marketplace may be used as evidence that the mark itself is scandalous or immoral.⁷⁶ Examiners frequently reason that marks

⁷⁵ Of marks targeted at niche markets, only five Office Actions referenced context of the market at all.

⁷⁶ See, e.g., U.S. Trademark Application Serial No. 78,643,827 (filed June 5, 2005)

applied to specific adult marketplaces reinforce the assertion that those terms are scandalous or vulgar.⁷⁷ For example, the marks TOKYO CREAMPIE and GAYFACIALSXXX were marketed and used in niche markets, such as an adult website. However, the very fact that the marks were used in those markets was supporting evidence that the general public would be scandalized, because usage in that context makes it clear that the marks reference sexually explicit material.⁷⁸ This is the case even with regard to marks in narrow and specific markets; while the applicant for POST-TITS asserted that the relevant market was controlled and narrow, the examiner reasoned that the market was irrelevant because the general public would find the mark scandalous.⁷⁹

Sometimes, this is the case irrespective of what is contained in the application.⁸⁰ In these situations, context is used only to reinforce the vulgar or scandalous meaning. However, a proper evaluation considers whether a substantial composite of the general public would find the

(FUCK.XXX); U.S. Trademark Application Serial No. 78,785,542 (filed Jan. 5, 2006) (BLACKCOCKSWHITESLUTS); U.S. Trademark Application Serial No. 78,694,903 (filed Aug. 17, 2005) (BIGCOCKSEX); U.S. Trademark Application Serial No. 78,699,858 (filed Aug. 24, 2005) (COPYCOCK.XXX).

⁷⁷ See, e.g., U.S. Trademark Application Serial No. 78,785,542 (filed Jan. 5, 2006) (BLACKCOCKSWHITESLUTS); U.S. Trademark Application Serial No. 78,699,858 (filed Aug. 24, 2005) (COPYCOCK.XXX); U.S. Trademark Application Serial No. 78,586,759 (filed Mar. 14, 2005) (YOU COCK); U.S. Trademark Application Serial No. 78,694,903 (filed Aug. 17, 2005) (BIGCOCKSEX).

⁷⁸ U.S. Trademark Application Serial No. 76,484,466 (filed Jan. 22, 2003) (TOKYO CREAMPIE) (Third Office Action dated Feb. 2, 2004); U.S. Trademark Application Serial No. 78,788,383 (filed Jan. 10, 2006) (GAYFACIALSXXX) (Office Action dated July 15, 2006).

⁷⁹ U.S. Trademark Application Serial No. 76,536,775 (filed July 22, 2003) (Office Action dated May 20, 2004).

⁸⁰ See e.g., U.S. Trademark Application Serial No. 78,853,993 (filed Apr. 4, 2006) (TITTY CITY) (claiming services in class 41 for “entertainment”); U.S. Trademark Application Serial No. 85,253,332 (filed Feb. 28, 2011) (FAT COCK BEER); U.S. Trademark Application Serial No. 76,484,466 (filed Jan. 22, 2003) (TOKYO CREAMPIE); U.S. Trademark Application Serial No. 76,490,572 (filed Feb. 19, 2003) (JAPANESE CREAMPIE); U.S. Trademark Application Serial No. 76,639,548 (filed May 25, 2005) (NIGGA); U.S. Trademark Application Serial No. 77,281,745 (filed Sept. 18, 2007) (THIZZ JUICE); U.S. Trademark Application Serial No. 76,675,279 (filed Apr. 10, 2007) (TITTIGYM); U.S. Trademark Application Serial No. 77,600,723 (filed Oct. 26, 2008) (COCAINE ENERGY); U.S. Trademark Application Serial No. 85,264,154 (filed Mar. 11, 2011) (SOCK MY COCK); U.S. Trademark Application Serial No. 78,829,207 (filed Mar. 3, 2006) (COCAINE); U.S. Trademark Application Serial No. 77,118,639 (filed Feb. 28, 2007) (COCAINE CUT THE LEGAL ALTERNATIVE); U.S. Trademark Application Serial No. 77,119,448 (filed Mar. 1, 2007) (COCAINE FREE THE LEGAL ALTERNATIVE); U.S. Trademark Application Serial No. 78,750,399 (filed Nov. 9, 2005) (METH); U.S. Trademark Application Serial No. 76,536,775 (filed July 22, 2003) (POST-TITS); U.S. Trademark Application Serial No. 78,558,043 (filed Feb. 1, 2005) (HEEB); U.S. Trademark Application Serial No. 78,904,458 (filed June 9, 2006) (BONER BATS ROCK HARD WOOD); U.S. Trademark Application Serial No. 78,682,282 (filed July 31, 2005) (YOU CUM LIKE A GIRL); U.S. Trademark Application Serial No. 78,631,791 (filed May 17, 2005) (MY SH!T D*N*T STINK); U.S. Trademark Application Serial No. 77,600,222 (filed Oct. 24, 2008) (SHAKE THOSE TITTIES); U.S. Trademark Application Serial No. 78,078,534 (filed Aug. 9, 2001) (SHITBEGONE); U.S. Trademark Application Serial No. 78,716,443 (filed Sept. 20, 2005) (“TALKING COCK”).

mark scandalous in the context of that particular marketplace.⁸¹ It is a tautology to reason that a mark is scandalous simply because it is used in a specific channel of trade that involves sexually explicit goods or services; yet that is a common argument in scandalousness refusals when the mark is to be used in an “adult” marketplace.⁸²

2. Use of a Mark in a General Marketplace is Frequently Used as Evidence That the Mark Itself is Scandalous or Immoral

Most often, the marketplace is abstracted from the analysis entirely, and the examiner focuses on whether a substantial composite of the general public would find the mark scandalous, with any marketplace analysis going to support that argument. When they do consider market context, examining attorneys often consider a more general marketplace abstracted from the particular goods or services at

⁸¹ See *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994); *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981); *In re Wilcher Corp.*, 40 U.S.P.Q.2d (BNA) 1929, 1930-32 (TTAB 1996); *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1639 (TTAB 1988); TMEP § 1203.01.

⁸² See U.S. Trademark Application Serial No. 78,699,858 (filed Aug. 24, 2005) (COPYCOCK.XXX) (Third Office Action dated Mar. 12, 2007) (use in connection with the goods clearly refers to erotic meanings, reinforcing vulgarity); U.S. Trademark Application Serial No. 78,694,903 (filed Aug. 17, 2005) (BIGCOCKSEX) (because the mark is applied in a specific marketplace—adult entertainment—it reinforces the vulgarity); U.S. Trademark Application Serial No. 78,785,542 (filed Jan. 5, 2006) (BLACKCOCKSWHITESLUTS) (because the mark is applied to a specific marketplace—sexually explicit services such as web sites containing adult entertainment—and uses that to reinforce assertion that the terms “cock” and “slut” are scandalous or vulgar); U.S. Trademark Application Serial No. 78,586,759 (filed Mar. 14, 2005) (YOU COCK) (use of mark in the field of adult entertainment services reinforces the vulgar meaning). See also U.S. Trademark Application Serial No. 76,484,466 (filed Jan. 22, 2003) (TOKYO CREAMPIE); U.S. Trademark Application Serial No. 76,490,572 (filed Feb. 19, 2003) (JAPANESE CREAMPIE); U.S. Trademark Application Serial No. 76,639,548 (filed May 25, 2005) (NIGGA); U.S. Trademark Application Serial No. 77,281,745 (filed Sept. 18, 2007) (THIZZ JUICE); U.S. Trademark Application Serial No. 76,675,279 (filed Apr. 10, 2007) (TITTIGYM); U.S. Trademark Application Serial No. 77,600,723 (filed Oct. 26, 2008) (COCAINE ENERGY); U.S. Trademark Application Serial No. 85,264,154 (filed Mar. 11, 2011) (SOCK MY COCK); U.S. Trademark Application Serial No. 78,829,207 (filed Mar. 3, 2006) (COCAINE); U.S. Trademark Application Serial No. 77,118,639 (filed Feb. 28, 2007) (COCAINE CUT THE LEGAL ALTERNATIVE); U.S. Trademark Application Serial No. 77,119,448 (filed Mar. 1, 2007) (COCAINE FREE THE LEGAL ALTERNATIVE); U.S. Trademark Application Serial No. 78,750,399 (filed Nov. 9, 2005) (METH); U.S. Trademark Application Serial No. 76,536,775 (filed July 22, 2003) (POST-TITS); U.S. Trademark Application Serial No. 78,558,043 (filed Feb. 1, 2005) (HEEB); U.S. Trademark Application Serial No. 78,904,458 (filed June 9, 2006) (BONER BATS ROCK HARD WOOD); U.S. Trademark Application Serial No. 78,682,282 (filed July 31, 2005) (YOU CUM LIKE A GIRL); U.S. Trademark Application Serial No. 78,631,791 (filed May 17, 2005) (MY SHIT D*N'T STINK); U.S. Trademark Application Serial No. 77,600,222 (filed Oct. 24, 2008) (SHAKE THOSE TITTIES); U.S. Trademark Application Serial No. 78,078,534 (filed Aug. 9, 2001) (SHITBEGONE); U.S. Trademark Application Serial No. 78,716,443 (filed Sept. 20, 2005) (“TALKING COCK”). One Office Action reasoned precisely to the contrary, claiming that if the proposed mark were analyzed in reference to the relevant market base, the mark wouldn’t fail because applicants would not tend to adopt marks that would drive away relevant purchasers. U.S. Trademark Application Serial No. 78,643,827 (filed June 5, 2005) (FUCK.XXX).

issue. Google searches are a common contextual piece of evidence used to demonstrate that a mark is scandalous to the general public.⁸³ For instance, in the case of FAT COCK BEER, though the applicant submitted a preliminary label to clarify the meaning of the mark, the examiner stated that “fat cock” is vulgar slang according to a Google search and the mark was therefore scandalous to the general public.⁸⁴ Likewise, TITTY PRETTIES was determined to be scandalous based in part on a Google search showing that the word “titty” can be used in an “offensive and disgraceful manner.”⁸⁵ Even for marks that are intended for a niche market, this sort of abstract marketplace context is applied.⁸⁶

Perhaps because of a lack of clarity as to the proper procedure for trademark examiners, there are inconsistencies in reasoning across refusals. In at least one instance, the examiner reasoned that a refusal was warranted because scandalous information would be found while searching for the stated vulgar terms on the internet, rather than the reverse, that the mark would be found while searching in general commerce.⁸⁷ The examiner went on to state that the relevant audience is irrelevant to an analysis of whether a mark is scandalous or immoral because that would help people attempting to register such marks.⁸⁸ The examiner reasoned that if the appropriate test were put in context of the “relevant population” no mark would ever be refused on Section 2(a) grounds “since the applicant would not adopt a mark which [sic] would drive the relevant purchasers or audience away from using or purchasing the applicant’s identified goods or services.”⁸⁹

C. When Examiners Consider the Context of Goods and Services, They Often do so as an Argument Against Registration

Our research yielded similar findings with regard to goods and services. Examiners are generally unlikely to consider goods and services in Office Actions issued under Section 2(a). When they do, the argument is similarly circular: Goods or services that are adult-oriented

⁸³ 22.58% of the time search engine results (Google, Yahoo!, etc.) are used to indicate public opinion of the relevant term.

⁸⁴ U.S. Trademark Application Serial No. 85,253,332 (filed Feb. 28, 2011).

⁸⁵ U.S. Trademark Application Serial No. 78,524,781 (filed Nov. 30, 2004) (Office Action dated July 11, 2005).

⁸⁶ See, e.g., U.S. Trademark Application Serial No. 78,218,607 (filed Feb. 25, 2003) (CLITS AND TITS); U.S. Trademark Application Serial No. 78,519,589 (filed Nov. 18, 2004) (COOCHIE SMOOCHIE).

⁸⁷ The examiner states that websites are ubiquitous and can be accessed by anyone, and notes that the attorney found several other scandalous sites while searching for the term “fuckxxx.” The examiner uses this to support the proposition that anyone may come across these goods and services, but does not seem to take into consideration that s/he was specifically searching for the term “fuckxxx” on the internet. U.S. Trademark Application Serial No. 78,643,827 (filed June 5, 2005) (FUCK.XXX).

⁸⁸ *Id.*

⁸⁹ *Id.*

will be used to support a scandalousness refusal on the idea that those particular goods and services remove doubt as to the vulgar meaning of the mark. Conversely, where the goods themselves are not scandalous, the nature of the goods or services is either ignored or used to support the argument that the mark is vulgar; an offensive mark on inoffensive goods is especially scandalous.

1. Use of a Mark on Adult-Oriented Goods is Frequently Used as Evidence That the Mark is Scandalous

As with the marketplace, when the specific goods are referenced by the examiner, it is generally used to support an assertion that the goods reinforce, or at least do not rebut, the vulgarity. Specifically, if the goods or services are adult-oriented rather than something that would be for sale in a more general market, that supports the vulgarity aspect because, by removing doubt as to the vulgar meaning, the general public will be scandalized.⁹⁰

⁹⁰ See, e.g., U.S. Trademark Application Serial No. 78,639,658 (filed May 30, 2005) (DO THE JEW) (similar goods, not necessarily applicant's); U.S. Trademark Application Serial No. 76,415,493 (filed Apr. 29, 2002) (COOCHIECALENDAR); U.S. Trademark Application Serial No. 77,281,745 (filed Sept. 18, 2007) (THIZZ JUICE); U.S. Trademark Application Serial No. 76,675,279 (filed Apr. 10, 2007) (TITTIGYM); U.S. Trademark Application Serial No. 78,864,664 (filed Apr. 19, 2006) (MR. HORSE COCK); U.S. Trademark Application Serial No. 78,416,780 (filed May 11, 2004) (BLOW JOB BUBBLE GUM); U.S. Trademark Application Serial No. 78,416,796 (filed May 11, 2004) (THE ORIGINAL BLOW JOB GUM); U.S. Trademark Application Serial No. 77,522,412 (filed July 15, 2008) (HUMP!); U.S. Trademark Application Serial No. 76,511,051 (filed May 2, 2003) (C P CREAM PIE); U.S. Trademark Application Serial No. 77,600,723 (filed Oct. 26, 2008) (COCAINE ENERGY); U.S. Trademark Application Serial No. 77,745,550 (filed May 27, 2009) (RIDE HARD RETARD); U.S. Trademark Application Serial No. 77,128,286 (filed Mar. 12, 2007) (TITTY TV); U.S. Trademark Application Serial No. 78,788,383 (filed Jan. 10, 2006) (GAYFACIALSXXX); U.S. Trademark Application Serial No. 78,666,012 (filed July 7, 2005) (SCHLONG WEAR); U.S. Trademark Application Serial No. 78,784,737 (filed Jan. 4, 2006) (HISFIRSTHUGECOCK); U.S. Trademark Application Serial No. 78,879,965 (filed May 9, 2006) (TIT-MITT); U.S. Trademark Application Serial No. 77,462,627 (filed May 1, 2008) (BEAVERSHAVEN); U.S. Trademark Application Serial No. 85,264,154 (filed Mar. 11, 2011) (SOCK MY COCK); U.S. Trademark Application Serial No. 77,866,123 (filed Nov. 5, 2009) (DOUCHEBAG AWARD); U.S. Trademark Application Serial No. 78,716,443 (filed Sept. 20, 2005) ("TALKING COCK"); U.S. Trademark Application Serial No. 78,829,207 (filed Mar. 3, 2006) (COCAINE); U.S. Trademark Application Serial No. 77,118,639 (filed Feb. 28, 2007) (COCAINE CUT THE LEGAL ALTERNATIVE); U.S. Trademark Application Serial No. 77,119,448 (filed Mar. 1, 2007) (COCAINE FREE THE LEGAL ALTERNATIVE); U.S. Trademark Application Serial No. 78,750,399 (filed Nov. 9, 2005) (METH); U.S. Trademark Application Serial No. 85,038,867 (filed May 14, 2010) (KO KANE); U.S. Trademark Application Serial No. 78,785,542 (filed Jan. 5, 2006) (BLACKCOCKSWHITESLUTS); U.S. Trademark Application Serial No. 76,536,775 (filed July 22, 2003) (POST-TITS); U.S. Trademark Application Serial No. 78,558,043 (filed Feb. 1, 2005) (HEEB); U.S. Trademark Application Serial No. 85,168,702 (filed Nov. 3, 2010) (FUCK MEAT); U.S. Trademark Application Serial No. 77,643,745 (filed Jan. 6, 2009) (SHIT-KICKERS); U.S. Trademark Application Serial No. 85,082,839 (filed July 12, 2010) (BONER BIBLE); U.S. Trademark Application Serial No. 78,631,791 (filed May 17, 2005) (MY SH!T D*N'T STINK); U.S. Trademark Application Serial No. 78,866,347 (filed Apr. 20, 2006) (FUGLY); U.S. Trademark Application Serial No. 77,883,100 (filed Dec. 1, 2009) (TOUCH YOUR TITS); U.S. Trademark Application Serial No. 78,135,356 (filed Jun. 13, 2002) (NICE

This is particularly common where the goods in question are adult videos. For the mark MR. HORSE COCK, the examiner noted that the wording clearly referred to the subject matter of the movies and was “thus . . . shocking to a substantial composite of the general public.”⁹¹ Similarly, the fact that the videotapes intended to be sold under the mark JAPANESE CREAMPIE would depict sexual acts meant they would be “morally crude” to the general public.⁹² Non-video goods received this treatment as well, such as the product under the mark TALKING COCK. Because the product itself would make what the examiner stated were vulgar statements, this reinforced the offensiveness of the mark.⁹³

2. Use of a Mark on Goods Oriented to the General Public is Frequently Used as Evidence That the Mark is Scandalous

Even where the goods themselves are not necessarily scandalous alone, they are used to reinforce the vulgarity of the mark. For example, the mark TIT-MITT was rejected in part because the use of the word “tit” on bras would ensure people know that the word “tit” was used in reference to a woman’s breast.⁹⁴ In another instance, though SCHLONG WEAR⁹⁵ is for clothing and is a spin-off brand of SCHLONGBOARDS,⁹⁶ the goods were ignored in favor of the slang meaning of the word “schlong” and the potentially vulgar nature of the mark’s design.⁹⁷ Similarly, MY SH!T D*N’T STINK is a mark for a deodorizer to be used by hikers and other participants in outdoors activities.⁹⁸ Despite the non-scandalous nature of the goods, the examiner reasoned that use of the word “shit” rendered the mark vulgar even if the term is relevant and not being used in the vulgar sense.⁹⁹ Our research uncovered similar reasoning in refusals for marks TOUCH YOUR TITS for shirts¹⁰⁰ and TITTIGYM for an adult health and fitness

TITS); U.S. Trademark Application Serial No. 78,853,993 (filed Apr. 4, 2006) (TITTY CITY); U.S. Trademark Application Serial No. 77,671,044 (filed Feb. 15, 2009) (HAND JOB); U.S. Trademark Application Serial No. 78,078,534 (filed Aug. 9, 2001) (SHITBEGONE).

⁹¹ U.S. Trademark Application Serial No. 78,864,664 (filed Apr. 19, 2006) (Office Action dated Sept. 26, 2006).

⁹² U.S. Trademark Application Serial No. 76,490,572 (filed Jun. 4, 2003) (Office Action dated Aug. 15, 2003).

⁹³ See U.S. Trademark Application Serial No. 78716443 (filed Sept. 20, 2005) (Office Action dated Apr. 3, 2006).

⁹⁴ U.S. Trademark Application Serial No. 78,879,965 (filed May 9, 2006).

⁹⁵ U.S. Trademark Application Serial No. 78,666,012 (filed July 7, 2005).

⁹⁶ U.S. Trademark Application Serial No. 78,371,260 (filed Feb. 20, 2004).

⁹⁷ Applicant’s additional information regarding what the final mark would look like, particularly in the addition of color to emphasize that a monkey in the mark is holding a banana, and a slightly edited version of the mark which also served to clarify its non-scandalous nature were rejected by the examiner. See *id.* (Paper Correspondence Incoming dated Apr. 11, 2006).

⁹⁸ U.S. Trademark Application Serial No. 78,631,791 (filed May 17, 2005).

⁹⁹ *Id.* (Office Action dated Aug. 2, 2006).

¹⁰⁰ U.S. Trademark Application Serial No. 77,883,100 (filed Dec. 1, 2009).

club.¹⁰¹ Because TOUCH YOUR TITS was used on shirts, for example, the examiner stated that the goods only reinforced the vulgar meaning by ensuring consumers realize that breasts are the intended meaning of the word.¹⁰²

On some occasions, the applicant's goods were specifically mentioned but not elaborated on as to whether or how they support a finding of a Section 2(a) refusal.¹⁰³ There were also a few situations in which, although there was nothing that indicated whether the goods would be sexual on the face of the application, the examiner inferred scandalousness by relating the salient portions of the mark with and how it may be applied to the goods in question. This occurred with both TITTIGYM¹⁰⁴ for an adult health and fitness club services and TITTY TV¹⁰⁵ for caps, shirts, shorts, and undergarments.

D. Examiners Often Acknowledge the Relevance of Context de jure, but Disregard it de facto

Examiners often acknowledge the relevance of context in particular Office Actions, but proceed to disregard that context in subsequent refusals. This frequently occurred with regard to profanity. In a significant number of rejections, examiners (1) cited the rule that trademarks must be evaluated in the context of current attitudes; (2) noted that profanity was more common in current society; and then (3) concluded that acceptance of profanity makes words no less profane.¹⁰⁶ The examiner then rejected the marks without any additional supporting evidence.¹⁰⁷ This occurred for marks containing 11 terms out of the 40 we investigated. These 11 words account for 125 total records in the dataset,¹⁰⁸ and this reasoning was present in a majority of all rejections

¹⁰¹ U.S. Trademark Application Serial No. 76,675,279 (filed Apr. 10, 2007). *See also*, U.S. Trademark Application Serial No. 77866123 (filed Nov. 5, 2009) (DOUCHEBAG AWARD) (stating that because the mark is clearly not referencing the personal hygiene meaning of the word, use of the mark with those goods supports the vulgar meaning).

¹⁰² U.S. Trademark Application Serial No. 77,883,100 (filed Dec. 1, 2009) (TOUCH YOUR TITS).

¹⁰³ *See, e.g.*, U.S. Trademark Application Serial No. 77,090,708 (filed Jan. 25, 2007) (STFU); U.S. Trademark Application Serial No. 78,519,589 (filed Nov. 18, 2004) (COOCHIE SMOOCHIE); U.S. Trademark Application Serial No. 77,402,917 (filed Feb. 21, 2008) (BAD ASS MOTHER FUCKER); U.S. Trademark Application Serial No. 78,471,577 (filed Aug. 22, 2004) (I'VE HAD IT UP TO TIKRIT WITH THIS SHIT); U.S. Trademark Application Serial No. 78,502,095 (filed Oct. 19, 2004) (IT DON'T MEAN SHIT); U.S. Trademark Application Serial No. 76,626,410 (filed Dec. 28, 2004) (FUCK YOU); U.S. Trademark Application Serial No. 85,268,293 (filed Mar. 16, 2011) (SHITSHOOTER); U.S. Trademark Application Serial No. 78,735,840 (filed Oct. 18, 2005) (RETARDS GONE WILD); U.S. Trademark Application Serial No. 78,750,245 (filed Nov. 9, 2005) (COOCHIE CUSHION).

¹⁰⁴ U.S. Trademark Application Serial No. 76,675,279 (filed Apr. 10, 2007).

¹⁰⁵ U.S. Trademark Application Serial No. 77,128,286 (filed Mar. 12, 2007).

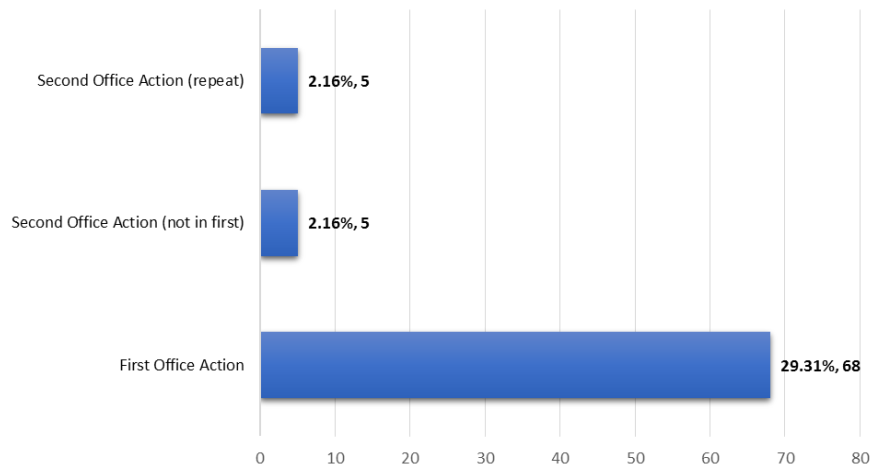
¹⁰⁶ *In re* Tinseltown, Inc., 212 U.S.P.Q. (BNA) 863, 866 (T.T.A.B. 1981).

¹⁰⁷ 58.4%.

¹⁰⁸ These terms also account for over half of the records in the dataset: 53.88%.

based on those terms.¹⁰⁹ Several of these words are in marks that have also been registered.¹¹⁰

**Cites context and also that profanity is more common
in society**



*E. This Mischaracterization of the Law Has a Real Impact on the
Trademark Registration Process*

According to our research, initial refusals based on scandalousness are statistically much less likely to result in ultimate registrations than refusals based on other grounds. The overall success rate for a response to an Office Action, when represented by an attorney, was 72%.¹¹¹ That rate dropped to 45%¹¹² for *pro se* applicants. However, in our data, the success rate was less than 5%, significantly lower than either success rate and particularly significant given the applicants in our data were both represented by attorneys. Furthermore, applicants are unlikely to respond to Office Actions based on scandalousness. This may be because the majority of applicants in these situations are individuals and small businesses, because there are higher-than-average rates of *pro se* applicants for these marks, and/or because the lack of clear legal standards for examiners makes it too difficult for applicants to overcome refusals. Data on each of these issues are presented below.

¹⁰⁹ 58.4%. The words that received that treatment were FUCK, SHIT, ASSHOLE, TITS, CUM, DOUCHEBAG, MILF, NIGGER/BLACK, BITCH, CUNT, AND BEAVER.

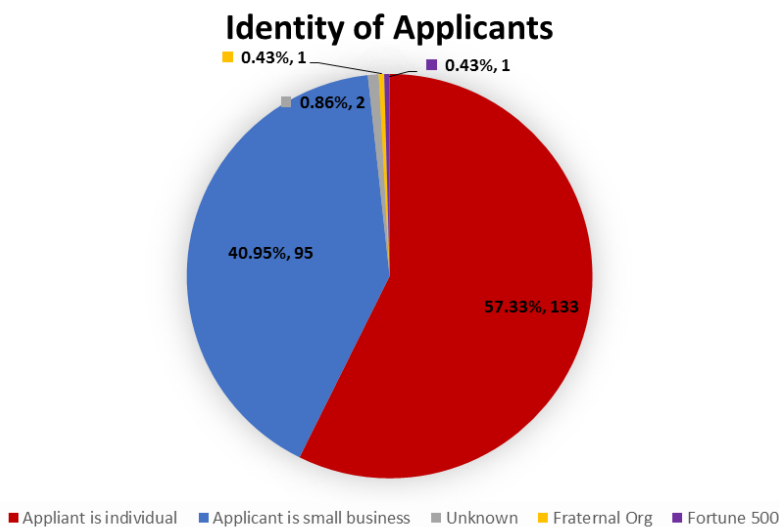
¹¹⁰ For example, MILF, BEAVER, and TITS.

¹¹¹ Deborah R. Gerhardt & Jon P. McClanahan, *Do Trademark Lawyers Matter?*, 16 STAN. TECH. L. REV. 583, 616 (2013).

¹¹² *Id.*

1. Refusals Based on Scandalousness Disproportionately Impact Individuals and Small Businesses

Over 97% of all applications in the dataset were filed by individuals and small businesses. Though there were two applications where the legal entity is unknown,¹¹³ only one applicant, Turner Broadcasting System, Inc. (TBS), was clearly in possession of significant resources, such as money and access to legal support, as a Fortune 500 company.



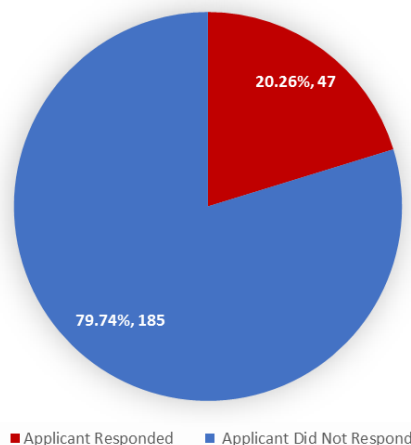
2. Applicants are Unlikely to Respond to a Refusal Based on Scandalousness

According to our research, applicants are unlikely to respond to a refusal based on scandalousness, and instead let the mark go abandoned. Of those that responded, the applicants were evenly split between smaller businesses and individuals at 23 each (49%). The final respondent was an unknown legal entity. However, given the larger overall number of applicants that were individuals, there appears to be a smaller chance that an individual will respond. Only 17% of individuals filed a response to an Office Action, as compared with 24% of small businesses. Even so, applicants are highly unlikely overall to respond when their proposed mark is rejected for being scandalous or immoral.

¹¹³ Per the USPTO information. *See e.g.*, U.S. Trademark Application Serial No. 79,014,488 (filed Aug. 18, 2005) (COCK & BALLS IT'S JUST WRONG); U.S. Trademark Application Serial No. 76,663,546 (filed July 24, 2006) (CUM PARTAY).

This low probability of response may be related to the high number of applicants who are not represented by an attorney. Of the marks rejected for being scandalous or immoral, 75%¹¹⁴ of applicants filed their trademark applications *pro se*. Both of the marks that ultimately overcame the scandalousness rejection were filed by applicants represented by an attorney. In contrast, of the approved marks, the numbers are reversed with 79% being represented by attorneys and only 21% filing *pro se*.¹¹⁵

How Often Did Applicants Respond?



Applicants responded to an Office Action containing a rejection on scandalous or immoral grounds less than one-quarter of the time. There was no response to 80% of rejections, thus resulting in abandonment of the mark. Applicants represented by an attorney were more likely to respond to a rejection.¹¹⁶ However, even when there was a response to the rejection, only twice in our dataset was that response successful in overcoming the scandalousness argument. This number constitutes fewer than five percent¹¹⁷ of all responses, with the other nearly 96%¹¹⁸ failing in their challenge. Of responses that failed, only five of them (10%¹¹⁹) were appealed to the Trademark Trial and Appeal Board (“TTAB”).

¹¹⁴ 74.57%.

¹¹⁵ 78.95% of approved marks were represented by an attorney, contrasted with 21.05% that were *pro se*.

¹¹⁶ 57.45% of applicants who responded were represented by an attorney as compared to 42.55% of respondents who were acting *pro se*.

¹¹⁷ 4.26%.

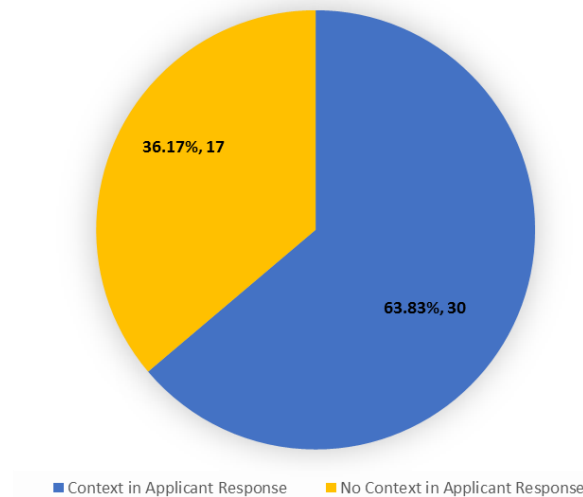
¹¹⁸ 95.74%.

¹¹⁹ 10.42%.

3. When Applicants Do Respond, They Argue Contextual Factors

When applicants did respond, most frequently applicants argued a variety of contextual factors to show that the mark was not scandalous and that those factors supported registration of the mark. A contextual argument was made in 64% of all responses, and was the most common argument presented by trademark owners.

Did the Applicant Argue Context?



The individual arguments regarding context ranged from the very specific to more general arguments regarding overall attitudes of society. The most common argument in rebutting a rejection for scandalousness was that a particular term had alternate meanings. An argument for alternate meanings of the mark in question was advanced in 32%¹²⁰ of Office Action responses. The next most common argument was that the word was not scandalous in the context of the marketplace. This type of argument was advanced in just over 25%¹²¹ of responses to a rejection. This included arguments both regarding the specific location where the goods were sold, such as regulated shops or adult markets,¹²² and also that the mark wasn't scandalous in the context of the specific goods, such as on shirts being sold by PETA.¹²³ Visual context, while not brought up often by the applicant, appeared to be the most effective argument; in fact, it was the sole argument that overcame

¹²⁰ 31.91%.

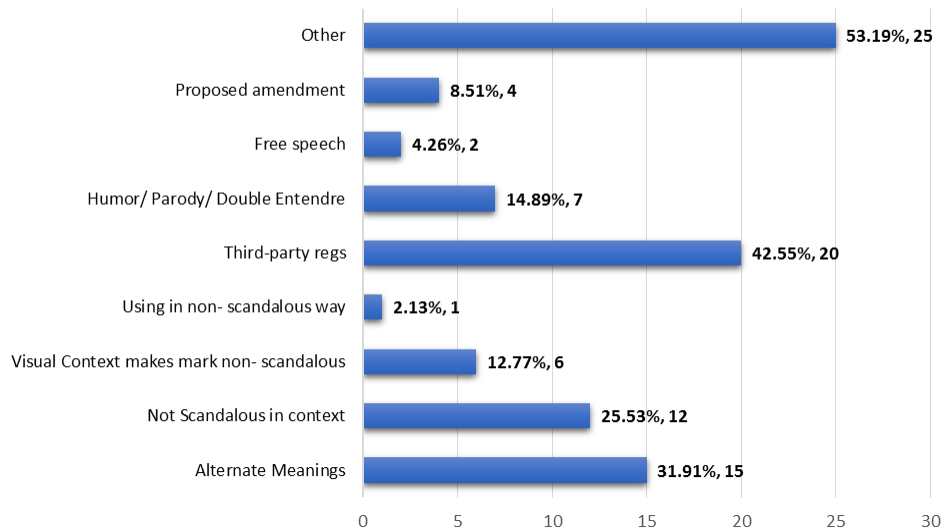
¹²¹ 25.53%.

¹²² See, e.g., U.S. Trademark Application Serial No. 76,536,775 (filed July 22, 2003) (POST-TITS).

¹²³ U.S. Trademark Application Serial No. 85,168,702 (filed Nov. 3, 2010) (FUCK MEAT).

a rejection for scandalousness.¹²⁴

What Arguments did Applicants Make in Response?



It is very difficult to overcome a Section 2(a) refusal based on scandalousness. While contextual factors were the most frequently argued rebuttal, those arguments were only successful in two of the 232 records we reviewed. More frequently, if the examiner then considered context, such argument was used against the applicant. The applicant in the case of “TALKING COCK,” for example, specifically pointed out that there are regulations in place to ensure products of an adult nature, such as the ones at issue, are adequately separated from the general population, and particularly from children.¹²⁵ This information regarding the specific marketplace for the good in question was, however, not addressed or rebutted in the examiner’s subsequent Office Action. Instead, the examiner copied verbatim the original arguments against the product: that the illustrations depicted the word in a vulgar fashion and the product made vulgar statements.¹²⁶ No further elaboration on the arguments was made, nor were the applicant’s arguments addressed. This example is typical of the dataset.

¹²⁴ In the case of the mark, WHITE ASS, the applicant pointed out the ears and tail adorning the “A” of the mark, indicating the reference to a donkey rather than a more vulgar usage of the word “ass.” U.S. Trademark Application Serial No. 85,100,568 (filed Aug. 5, 2010) (Response to Office Action dated May 23, 2011). In the case of FUGLY FRUITS, the applicant pointed to the “playful stylized form of the mark” to show that there would not be a potential perception that the word “fugly” meant “fucking ugly.” U.S. Trademark Application Serial No. 78,736,643 (filed Oct. 19, 2005) (FUGLY FRUITS) (Response to Office Action dated May 25, 2006).

¹²⁵ U.S. Trademark Application Serial No. 78,716,443 (filed Sept. 20, 2005) (Response to Office Action dated Oct. 2, 2006).

¹²⁶ *Id.* (Office Action dated Dec. 21, 2007).

Of the trademark records reviewed, only two responses were effective in convincing the trademark examiner to withdraw his or her Section 2(a) refusal, and in both cases the applicant argued context.¹²⁷ In fact, with those two exceptions, in none of the examined files was the mark approved by the examiner based on contextual factors. Rather, where the applicant argued context, the examiner often used that context to reinforce the scandalousness of the mark instead of withdrawing the Section 2(a) rejection, or disregarded the contextual argument entirely. Even when the examiner was the first to address the context of the mark, this context was used only to bolster the argument that the mark was scandalous or immoral. Some of the more common arguments beyond the broad argument of alternate meanings or general context are that the mark is intended to be humorous or a double entendre, that the mark was not scandalous in context of visual imagery, or that there are third-party registrations already approved by the USPTO containing the same material terms.

a. Double Entendre

Several applicants argued that their mark was intentionally humorous or a double entendre, thus mitigating or eliminating any scandalous meaning. This argument does not appear to be accepted as a reason to find something non-scandalous. Often, the double entendre appears not to be considered at all as contributing to the overall commercial impression of the mark, even if raised by the applicant. In cases where the entire phrase had a vulgar meaning, even if it was not intended or used in that fashion, the examiner stated that the vulgar meaning of the phrase is what matters rather than the potential double-entendre, despite possible visual context or other evidence showing the non-vulgar meaning.

For example, the mark HAND JOB contains a clear subtitle of “Nails & Spa” on the logo. Despite this, the examiner stated that because “hand job” as a phrase has no non-vulgar meaning, the play on words was not persuasive.¹²⁸ This is despite the applicant pointing out that taken as individual words in combination with the subtitle, “hand job” can have a meaning that is not vulgar. Similarly, FAT COCK

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

¹²⁸ U.S. Trademark Application Serial No. 77,671,044 (filed Feb. 15, 2009).

BEER was rejected due to the phrase “fat cock” despite a potential meaning of “fat rooster” rather than “fat penis” because a Google search indicated that the phrase “fat cock” is vulgar and used in a sexual context.¹²⁹ The applicant submitted a preliminary label indicating the intended meaning is that of “fat rooster” but this evidence was ruled insufficient to overcome the rejection because of the preliminary status.

b. Visual Context

When visual context is taken into account for a double entendre or humorous mark as part of the overall commercial impression of the mark, it is used in the dataset solely to bolster, rather than to rebut, an examiner’s initial rejection. In the case of POST-TITS, while the applicant pointed out the parodying nature of the goods, the examiner determined that imagery of breasts on the note pads made the mark vulgar, and that vulgarity made the mark scandalous.¹³⁰ Likewise in the case of BONER BATS ROCK HARD WOOD, the examining attorney found that the image of the bat with two baseballs reinforced the mark’s vulgar meaning and rendered the mark scandalous.¹³¹ The same is true for the mark CAMEL TOES, in which the examiner stated that the design of the mark dissipated any double entendre and clearly communicated the mark’s vulgar nature.¹³²

However, in what appears to be a contradiction, for the mark YOU CUM LIKE A GIRL,¹³³ the examiner pointed out that a third-party registration brought up by the applicant, CUM TOGETHER,¹³⁴ is a double entendre referencing a Beatles song and was therefore acceptable.

¹²⁹ U.S. Trademark Application Serial No. 85,253,332 (filed Feb. 28, 2011).

¹³⁰ U.S. Trademark Application Serial No. 76,536,775 (filed July 22, 2003).

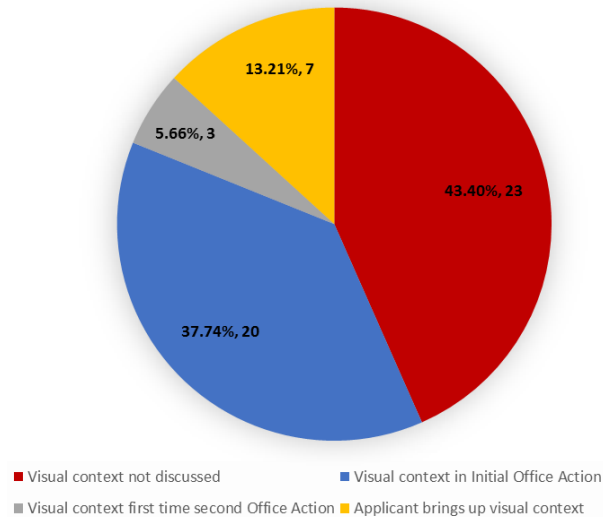
¹³¹ U.S. Trademark Application Serial No. 78,904,458 (filed June 9, 2006).

¹³² U.S. Trademark Application Serial No. 78,173,865 (filed Oct. 13, 2002).

¹³³ U.S. Trademark Application Serial No. 78,682,282 (filed July 31, 2005).

¹³⁴ CUM TOGETHER, Registration No. 2,844,606.

Visual Context



Out of all marks with visual elements that contribute to the overall commercial impression of the mark, the visual context was not discussed by either the examiner or the applicant in roughly half of those records. Instead, the examiner focused on the words themselves as vulgar, abstracted from the visual context, and therefore scandalous or immoral. For many of those marks, the visual context of the mark likely would not have been beneficial as it most frequently contributed to the overall commercial impression of the mark in such a way as to reinforce the vulgar implication with which the examiner was concerned.

In rejections that addressed visual context as part of the commercial impression of the mark, the issue was raised most often in the initial Office Action and used only by the examiner to reinforce the vulgar or scandalous rejection. In three cases, the visual context of the mark was not discussed until the second Office Action, and in each of those situations the context was used exclusively to reinforce the vulgarity of the mark.¹³⁵

Applicants did occasionally attempt to bring in the visual context of the mark in their responses. However, of those, only two successfully used that context to dispute the Section 2(a) rejection, *WHITE ASS* and *FUGLY FRUITS*. This was the case even when there were aspects of the visual context supporting a non-vulgar reference.

¹³⁵ U.S. Trademark Application Serial No. 85,082,839 (filed July 12, 2010) (*BONER BIBLE*); U.S. Trademark Application Serial No. 77,883,100 (filed Dec. 1, 2009) (*TOUCH YOUR TITS*); U.S. Trademark Application Serial No. 78,173,865 (filed Oct. 13, 2002) (*CAMEL TOES*).

For instance, WHITE ASS included ears and a tail on the “A” in the mark, clearly indicating that the mark referenced the “donkey” meaning of the word “ass,” rather than any vulgar meaning.¹³⁶ Despite this, the visual context was not apparently referred to by the examiner who relied solely on the meaning of the phrase “white ass” when initially rejecting the mark. After the applicant pointed out the visual aspects of the mark, the examiner withdrew the Section 2(a) rejection.¹³⁷ In FUGLY FRUITS, the applicant pointed to the “playful stylized form” to support their argument that “fugly” meant “fun ugly” rather than “fucking ugly.”¹³⁸ After this argument was raised, the Section 2(a) refusal was withdrawn.

In some cases, the examiner and the applicant focused on different aspects of the design to support their respective positions. In DONKEY PUNCH, the applicant pointed out that there was an actual donkey on the label, supporting his assertion that the mark referred to an actual donkey rather than the sexual term.¹³⁹ However, the examiner pointed out that the phrase “You’ll know it when it hits you in the back of the head!” also appears on the label, thus implying the scandalous meaning is in fact what was intended.¹⁴⁰ In the case of SCHLONG WEAR, the applicant asserted that the image comprised two monkeys with the boy monkey offering the girl monkey a banana, to be colored yellow in the final tag, and that the banana was in no way attached to or near the boy monkey’s groin to imply a sexual meaning.¹⁴¹ The examiner insisted that the fact that the boy monkey is offering the girl monkey a long, thick object reinforced the imagery of the word “schlong” and that modifications to the mark (coloring the banana yellow and giving the girl monkey a tail) did not change that.¹⁴²

In other situations in which the applicant attempted to use visual context to argue that the overall commercial impression of the mark was not scandalous, the examiner either did not address that context in subsequent Office Actions or dismissed the evidence altogether. For example, in the mark HAND JOB, though the applicant attached an image of the company’s logo, which reinforced the double entendre rather than the scandalous meaning given the clear statement of “Nails & Spa” below the main mark, the examiner did not address the visual context in the subsequent Office Action.¹⁴³ In FAT COCK BEER,

¹³⁶ U.S. Trademark Application Serial No. 85,100,568 (filed Aug. 5, 2010).

¹³⁷ *Id.*

¹³⁸ U.S. Trademark Application Serial No. 78,736,643 (filed Oct. 19, 2005) (Response to Office Action dated May 25, 2006).

¹³⁹ U.S. Trademark Application Serial No. 77,089,125 (filed Jan. 23, 2007).

¹⁴⁰ *Id.* (Second Office Action dated Oct. 11, 2007).

¹⁴¹ U.S. Trademark Application Serial No. 78,666,012 (filed Feb. 15, 2009).

¹⁴² *Id.* (Second Office Action dated June 8, 2006).

¹⁴³ U.S. Trademark Application Serial No. 77,671,044 (filed Feb. 15, 2009).

because the label was still preliminary, though it did in fact depict an actual rooster, the visual mark was ruled not to overcome the objection.¹⁴⁴

Overall, visual context is frequently not addressed by examining attorneys except when it supports rejection, and even an assertion of the visual context by the applicant appears not to be beneficial unless it is so clear as to create no doubt about the underlying meaning of the term.¹⁴⁵

c. Third-Party Registrations

Several applicants in the dataset raised third-party registrations in their responses. Most often, the examiner's response was that third-party registrations are irrelevant and each mark must stand on its own. Examiners also stated that "whether because of administrative error or otherwise, some marks have been registered even though they may be in violation of the governing statutory standard [but that] does not mean that the agency must forgo applying that standard in all other cases."¹⁴⁶ This is despite the fact that some registered marks contain the same or very similar words or imagery in them. On the occasions in which the previously registered mark was recognized by the examiner in the subsequent Office Action, it was used exclusively to distinguish such marks from the instant application.

For example, when addressing the BONER BATS mark, the applicant submitted evidence of third-party registrations with similar words and imagery, but the examiner stated that these marks are not only irrelevant but also neutral because none of them are referencing a penis like BONER BATS.¹⁴⁷ This was despite the fact that several of the marks used the word "boner" in the same sense and at least one, BONERWEAR¹⁴⁸ had a mark consisting of an upright bone with two skulls at its base, very similar to BONER BATS's bat with baseballs imagery. Similarly, for the mark YOU CUM LIKE A GIRL,¹⁴⁹ though the applicant used the mark CUM TOGETHER¹⁵⁰ to support registration, the examiner stated that the double entendre of that mark made it acceptable.

¹⁴⁴ U.S. Trademark Application Serial No. 85,253,332 (filed Feb. 28, 2011).

¹⁴⁵ Such as in the WHITE ASS mark. U.S. Trademark Application Serial No. 85,100,568 (filed Aug. 5, 2010) (WHITE ASS)

¹⁴⁶ *In re Blvd. Entm't*, 334 F.3d 1336, 1343 (Fed. Cir. 2003).

¹⁴⁷ U.S. Trademark Application Serial No. 78,904,458 (filed June 9, 2006).

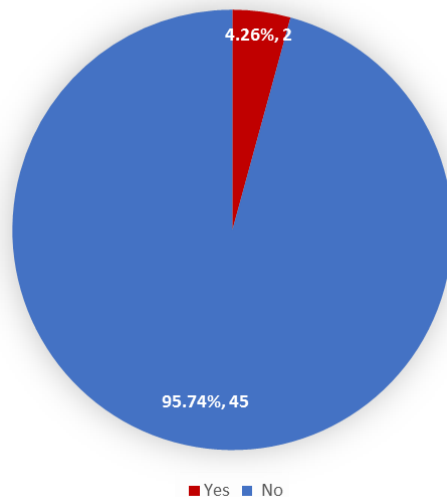
¹⁴⁸ BONERWEAR, Registration No. 3,163,407.

¹⁴⁹ U.S. Trademark Application Serial No. 78,682,282 (filed July 31, 2005).

¹⁵⁰ Registration No. 2,844,606.

4. Applicants' Contextual Arguments are Rarely Successful in Overturning a Refusal

When the Applicant Argued Context, Did it Work?



In general, if an examiner did not discuss context in the initial scandalousness rejection, almost half the time (43%)¹⁵¹ the examiner discussed context in a subsequent Office Action. Overall, examiners addressed contextual factors in subsequent Office Actions 66%¹⁵² of the time, whether or not these factors were brought up previously. Of cases in which the applicant argued context, whether initially addressed by the examiner or not, context was not raised in only 20% of final Office Actions.

However, a contextual argument on behalf of the applicant did not increase the chances that an examiner would address context in a subsequent Office Action. Though 64%¹⁵³ of applicant responses argued contextual factors, when the examiner did not address context in the initial Office Action and the applicant addressed context in a response, only 50%¹⁵⁴ of subsequent Office Actions addressed that contextual argument.

¹⁵¹ 42.55%.

¹⁵² 65.96%.

¹⁵³ 63.83%.

¹⁵⁴ This is out of the thirty responses where the applicant argued context. In fifteen subsequent Office Actions, the examiner also discusses context (where context was not addressed initially). Additionally, there were six times (20% of responses with context) where, even though the applicant discussed context, the subsequent Office Actions did not. The remaining records were split between five instances where context was addressed in both the initial Office Action and the response, and four records consisted of the two marks where the 2(a) rejection was withdrawn and two where the application was abandoned prior to the issuance of a subsequent Office Action.

F. *There are Inconsistencies in Reasoning Across Refusals*

Several words that served as the basis of a scandalousness refusal in some marks were material components of other marks that passed through to publication. For each of the published marks, those words were generally not flagged as presenting an issue.¹⁵⁵

1. There are Many Marks Containing the Same Terms That Have Been Both Registered and Refused

Despite the abstraction of salient terms in particular marks by the USPTO, there are often both approvals and rejections for marks containing the same terms with very similar overall commercial impressions.¹⁵⁶ While POTHEAD THE CREATIVE HIGH¹⁵⁷ was registered, for example, POTHEAD 420¹⁵⁸ was rejected on the basis that “pothead” is slang for smoker of marijuana. WET BEAVER¹⁵⁹ was approved, while BIG WET ROUND BOOTYS & ILL FLOWS¹⁶⁰ was rejected. The latter mark was rejected because use of the word “wet,” with other words like “booty,” reinforced the scandalous meaning.¹⁶¹

¹⁵⁵ With the exception of PHAG, which were ultimately registered. Registration No. 4,135,694.

¹⁵⁶ In addition to the examples noted here from our data set, there are others that create interesting distinctions. Though most marks with the word “cock” in our sample were rejected, it has also been permitted registration. COCKSOX was registered, for example, even though the specimen clearly indicates that the word is likely in reference to a penis, and the most common reason for refusing a mark with the word “cock” in it is because the term is vulgar slang for a penis. COCKSOX, Registration No. 4,123,962. In several cases, the context of the mark reinforces this meaning and further supports the rejection but in many, the word alone is enough without any further context. The mark GOD DOES NOT HAVE A PENIS was rejected because the mark was likely offensive due the reference to God and the existence of a penis or genitalia. U.S. Trademark Application Serial No. 77,212,829 (filed June 22, 2007). In the approved mark, HAPPY PENIS, the USPTO does not make a reference to the word “penis.” Registration No. 2,853,632. This mark is brought up by the applicant for COPYCOCK.XXX who specifically noted that:

HAPPY PENIS [RN: 2853632] is a registered trademark . . . Yet you request to deny my trademark for COPYCOCK because . . . “the term Cock in the proposed mark is a reference to a penis and is thus scandalous because it is considered vulgar usage.” YET HAPPY PENIS IS ACCEPTABLE? When I think about rubbing body lotion from Happy Penis on my body . . . I do think of a PENIS. This doesn’t make sense to me. If I had filed for HAPPY COPYCOCK would that have not been vulgar . . . as long as it’s HAPPY it’s okay?

U.S. Trademark Application Serial No. 78,699,858 (filed Aug. 24, 2005) (Paper Correspondence Incoming dated Jan. 4, 2007).

¹⁵⁷ Registration No. 2,058,380.

¹⁵⁸ U.S. Trademark Application Serial No. 77,290,998 (filed Sept. 27, 2007).

¹⁵⁹ Registration No. 2,437,957.

¹⁶⁰ U.S. Trademark Application Serial No. 78,955,262 (filed Aug. 18, 2006).

¹⁶¹ Though “wet” alone is not a cause for rejection, in the rejected mark, BIG WET ROUND BOOTYS & ILL FLOWS, the word “wet” is used in conjunction with other scandalous words that reinforced the scandalousness of the mark. However, the approved mark WET BEAVER appears to stand in contrast to this given that, based on rejected marks with the word “beaver” in them, “beaver” is considered a scandalous term due to being vulgar slang for female genitalia or pubic area. *See, e.g.*, U.S. Trademark Application Serial No. 77,462,627 (filed May 1, 2008) (BEAVERSHAVER); U.S. Trademark Application Serial No. 78,571,207 (filed Feb. 19, 2005)

This contradiction persists despite the fact that the word “beaver” has been separately rejected for scandalousness.¹⁶² Similarly, MILFHUNTER¹⁶³ and FAT MILF¹⁶⁴ were approved, while GOT MILF¹⁶⁵ was refused registration.¹⁶⁶ CAMEL TOES AND DESIGN¹⁶⁷ for apparel was rejected because “camel toe” is “well-known [as] crotch cleavage.”¹⁶⁸ The word mark NICE CAMELTOE¹⁶⁹ was rejected for the same reason.¹⁷⁰ In contrast, the word mark CAMEL TOES¹⁷¹ was registered for apparel without objection. Marks with the salient terms ANAL,¹⁷² ASS,¹⁷³ COCK,¹⁷⁴ CUM,¹⁷⁵ FAG,¹⁷⁶ MILF,¹⁷⁷ PENIS,¹⁷⁸

(HORNY BEAVER). However, the only apparent rejection for the mark was for being ornamental based on the Office Action response on file.

¹⁶² See, e.g., U.S. Trademark Application Serial No. 78,571,207 (filed Feb. 19, 2005) (HORNY BEAVER); U.S. Trademark Application Serial No. 77,462,627 (filed May 1, 2008) (BEAVERSHAVER).

¹⁶³ Registration No. 2,936,139.

¹⁶⁴ Registration No. 3,372,094.

¹⁶⁵ U.S. Trademark Application Serial No. 78,700,246 (filed Aug. 25, 2005).

¹⁶⁶ MILFHUNTER and FAT MILF, were both approved without any reference to the word “MILF” although MILFHUNTER was initially refused for being descriptive. MILFHUNTER, Registration No. 2,936,139; FAT MILF, Registration No. 3,372,094. In contrast, in the rejected marks, MILF, as a vulgar acronym including the word “fuck,” was the reason the marks were rejected. See e.g., U.S. Trademark Application Serial No. 77,043,802 (filed Nov. 14, 2006) (MILF SEEKER), U.S. Trademark Application Serial No. 78,614,007 (filed Apr. 21, 2005) (MILF GOLF); U.S. Trademark Application Serial No. 77,126,313 (filed Mar. 8, 2007) (MILF AND COOKIES). Additionally, as pointed out in GOT MILF and WANT MILF? the term is commonly associated with porn. U.S. Trademark Application Serial No. 78,710,449 (filed [date]) (WANT MILF?); U.S. Trademark Application Serial No. 78,700,246 (filed Aug. 25, 2005) (GOT MILF).

¹⁶⁷ U.S. Trademark Application Serial No. 78,173,865 (filed Oct. 13, 2002).

¹⁶⁸ Also, the design element reinforces the vulgar meaning.

¹⁶⁹ U.S. Trademark Application Serial No. 78,253,440 (filed May 22, 2003).

¹⁷⁰ In that Office Action, the examining attorney notes that “camel toe” refers to “to the shape formed by the vulva when extremely tight pants are worn.”

¹⁷¹ Registration No. 1,872,570.

¹⁷² In the Office Action for the approved mark, HUSTLER’S ANAL SEDUCTION, there is no mention of the word “anal” and the only rejection is for a disclaimer. Registration No. 2,920,403. In both rejected marks, HERFIRSTANALSEX and HER FIRST ANAL SEX, only the first is rejected because of the word “anal” (it refers to an activity that is considered immoral by some people and illegal in some states) while the second is only refused for being descriptive and possibly misdescriptive. U.S. Trademark Application Serial No. 78,618,381 (filed Apr. 27, 2005) (HERFIRSTANALSEX); U.S. Trademark Application Serial No. 77,043,892 (filed Nov. 14, 2006).

¹⁷³ Though “ass” is present in both approved and rejected marks, the word is never mentioned in the approved marks and in the rejected marks, “ass” alone is not the basis for refusal except in a single case. Instead, in the rejected marks, they are rejected for compound words such as “asshole” or because of the presence of other words in the mark such as “mother fucker” or “coon ass.” See U.S. Trademark Application Serial No. 85,100,568 (filed Aug. 5, 2010) (WHITE ASS) (rejected because the phrase “white ass” was scandalous); U.S. Trademark Application Serial No. 78,753,763 (filed Nov. 14, 2005) (SEXYASSMOFO.COM) (rejected because “mofo” is slang for “mother fucker; “sexyass” adds to offensiveness); U.S. Trademark Application Serial No. 77,087,533 (filed Jan. 21, 2007) (ASSHOLES ANONYMOUS) (rejected because “asshole” is vulgar slang); U.S. Trademark Application Serial No. 78,613,333 (filed Apr. 20, 2005) (KA KICK ASS SKATEBOARDS KABOARDS) (rejected based on the design portion of the mark depicting “a dog skeleton defecating or jumping over a pile of excrement”)U.S. Trademark

SLUT,¹⁷⁹ and WHORE¹⁸⁰ are other examples of marks that were both

Application Serial No. 77,163,723 (filed Apr. 23, 2007) (HARD ASS CRACKER) (rejected based on “cracker” as an offensive term). *But see* KICKASSMUSIC.COM, Registration No. 2,796,559; KICK ASS LIMITED, Registration No. 2,039,645. In a single case, JEWS KICK ASS, the mark was rejected because of the association of famous people with profanity. U.S. Trademark Application Serial No. 78,344,588 (filed Dec. 23, 2003).

¹⁷⁴ See U.S. Trademark Application Serial No. 78,716,443 (filed Sept. 20, 2005) (“TALKING COCK”); U.S. Trademark Application Serial No. 85,264,154 (filed Mar. 11, 2011) (SOCK MY COCK); U.S. Trademark Application Serial No. 78,867,619 (filed Apr. 23, 2006) (COCK BLOCKER); U.S. Trademark Application Serial No. 78,791,173 (filed Jan. 13, 2006). *But see* COCKSOX, Registration No. 4,123,962. *See also* discussion, *supra* note 156.

¹⁷⁵ See U.S. Trademark Application Serial No. 78,059,173 (filed Apr. 19, 2001) (CUM); U.S. Trademark Application Serial No. 78,572,277 (filed Feb. 22, 2005) (CUMSTRONG); U.S. Trademark Application Serial No. 77,138,948 (filed Mar. 23, 2007) (FUN CUM); U.S. Trademark Application Serial No. 78,682,282 (filed July 31, 2005) (YOU CUM LIKE A GIRL); U.S. Trademark Application Serial No. 76,663,546 (filed July 24, 2006) (CUM PARTAY); U.S. Trademark Application Serial No. 77,317,522 (filed Oct. 31, 2007) (GOT CUM?). *But see* CUM CUM, INC., Registration No. 2,036,162. CUM CUM, INC. has no documents other than a registration certificate available on the TSDR. However, its registration is in contrast with six marks that were rejected bearing the same word. All of the rejected marks were rejected because the word “cum” means semen or ejaculate and is therefore vulgar.

¹⁷⁶ In the approved mark, though PHAG is initially rejected on disparaging grounds because “phag” is a phonetic equivalent to “fag,” the mark eventually is approved after being revived. PHAG, Registration No. 4,135,694. In the three rejected marks, the term in the marks is “fag” rather than an alternate phonetic equivalent. In the case of BFF BIG FUCKING FAGGOT, the mark is refused because “faggot” is a disparaging word and is combined with a vulgar term and therefore scandalous. U.S. Trademark Application Serial No. 77,722,463 (filed Apr. 25, 2009) (BFF BIG FUCKING FAGGOT). In the other two marks, “fag” is a disparaging term and therefore the marks are rejected. U.S. Trademark Application Serial No. 78,164,481 (filed Sept. 16, 2002) (FAG); U.S. Trademark Application Serial No. 77,565,055 (filed Sept. 8, 2008) (FAGHAGMATCH.COM).

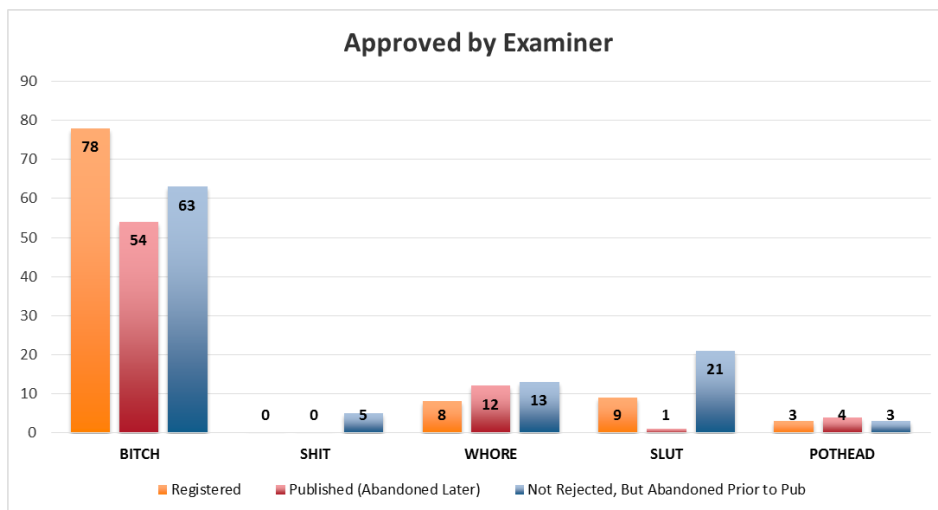
¹⁷⁷ Both approved marks, MILFHUNTER and FAT MILF, were both approved without any reference to the word “MILF” although MILFHUNTER was initially refused for being descriptive. MILFHUNTER, Registration No. 2,936,139; FAT MILF, Registration No. 3,372,094. In contrast, in the rejected marks, MILF, as a vulgar acronym including the word “fuck,” was the reason the marks were rejected. U.S. Trademark Application Serial No. 77,126,313 (filed Mar. 8, 2007) (MILF AND COOKIES); U.S. Trademark Application Serial No. 78,614,007 (filed Apr. 21, 2005) (MILF GOLF); U.S. Trademark Application Serial No. 77,043,802 (filed Nov. 14, 2006) (MILF SEEKER). Additionally, as pointed out in GOT MILF and WANT MILF?, the term is commonly associated with porn. U.S. Trademark Application Serial No. 78,700,246 (filed Aug. 25, 2005) (GOT MILF); U.S. Trademark Application Serial No. 78,710,449 (filed Sept. 9, 2005) (WANT MILF?).

¹⁷⁸ See U.S. Trademark Application Serial No. 77,212,829 (filed June 22, 2007) (GOD DOES NOT HAVE A PENIS (GDNHAP)). *But see* HAPPY PENIS, 2,853,632. *See also* discussion, *supra* note 149.

¹⁷⁹ The approved mark SLUT.XXX was initially refused for being descriptive and an unacceptable specimen, however the word “slut” never came up. SLUT.XXX, Registration No. 3,243,680. It is particularly interesting that this mark had “.XXX” in it similarly to GAYFACIALSXXX, FUCK.XXX, and COPYCOCK.XXX. However, in two of those cases, the presence of “.XXX” served to reinforce the sexual meaning (the XXX never came up in GAYFACIALSXXX though the examiner does note the mark is applied to sexually explicit services). Of the three rejected marks that contained “slut,”—S.L.U.T.S., SLUT PUPPY, BLACKCOCKSWHITESLUTS—two were rejected for different reasons than the presence of the word “slut.” S.L.U.T.S. was rejected for likelihood of confusion. U.S. Trademark Application Serial No. 77,368,404 (filed Jan. 10, 2008). SLUT PUPPY was rejected for needing a disclaimer. U.S. Trademark Application Serial No. 78,948,669 (filed Aug. 9, 2006). That being said, BLACKCOCKSWHITESLUTS was rejected because “cock” and “sluts” are vulgar terms. U.S.

approved and rejected—in some instances the marks were refused registration based on scandalousness, and in others they passed through to registration without issuance of an Office Action.

We conducted an in-depth look at trademark applications for marks containing the words BITCH, POTHEAD, SHIT, SLUT, and WHORE, in order to understand the depth of the inconsistencies both within and between marks. There was some measure of inconsistency within marks containing each of these terms as a primary feature. In fact, for each term, there were both approved and rejected registrations. With the exception of SHIT, all of the words listed above had registered marks containing those terms as a primary feature of the mark. Even in the case of SHIT, however, there were several marks that were approved but abandoned prior to publication.



2. Marks Containing Some Terms Tend to be Rejected, and Others Tend to be Accepted, Inconsistently

Overall, the data indicate general trends among trademark examiners to either approve or deny marks containing particular terms. For example, examiners tend to reject marks containing the word “shit,”

Trademark Application Serial No. 78,785,542 (filed Jan. 5, 2006).

¹⁸⁰ Interestingly, though the word “whore” is in both an approved mark and three rejected marks, none of them mention it in any Office Actions. The approved mark WM WHOREMOANS was initially rejected for a discrepancy in in entity type but no other reasons. WM WHOREMOANS, Registration No. 3,506,488. The other three marks—DUMB BLONDE WHORES, THE WHORE STORE, and THEY’RE ALL WHORES, AL—were refused on other grounds but the word “whore” never came up. U.S. Trademark Application Serial No. 85,022,334 (filed Apr. 23, 2010) (THE WHORE STORE); U.S. Trademark Application Serial No. 78,610,626 (filed Apr. 18, 2005) (THEY’RE ALL WHORES, AL); U.S. Trademark Application Serial No. 77,731,907 (filed May 7, 2009) (DUMB BLONDE WHORES).

but register marks with the words “bitch” and “whore.” This appears to be based on a *de facto*, unofficial consideration of third-party registrations by examiners in the examination process. Anecdotal evidence in the records demonstrates that examiners consider third-party registrations selectively when approving or rejecting applications for registration. For example, there is an email in the record from the examiner for SEXY BITCH to an apparent supervisor, stating:

[T]here are 34 registered marks with the word ‘Bitch’ as either the mark or a component thereof, such as FILMBITCH for TV production services, BITCH for a women’s magazine, BITCHWEAR for clothing, TOTAL BITCH for cosmetics. We are not going to hold SEXY BITCH 2(a) – please let me know if you think we should.¹⁸¹

One particularly troubling instance of this inconsistency was evident in the USPTO records regarding a refusal for NBB NATURAL BORN BITCHES.¹⁸² In that record, the examiner noted that it was an “uphill” battle to reject the mark, but did so anyway.¹⁸³ The applicant was an individual filing *pro se*, and did not respond to the refusal, so the application went abandoned without further inquiry.¹⁸⁴

In the case of marks containing POTHEAD, only one mark was rejected. In the Office Action for that mark, POTHEAD 420, the examiner stated that the term “pothead” is disapproving slang for “a regular or heavy smoker of marijuana” and “420” is also slang for smoking marijuana.¹⁸⁵ Because the mark references an illegal activity, it was rejected for being scandalous. However, the rest of the marks we analyzed that included the term “pothead” were not rejected under Section 2(a), and, in fact, three were registered.¹⁸⁶ In particular, despite the rejection of POTHEAD 420 in part because of the “420,” a different mark, THE POTHEAD DIARIES EST. 4.20.09 was registered with no Section 2(a) rejection despite the same reference.¹⁸⁷

Where there are general trends indicating approval or refusal for marks containing a particular term, those general trends are apparently

¹⁸¹ Registration No. 2,870,126 (Email Incoming dated Aug. 30, 3002) (Email from Mary Sparrow to Debbie Cohn and Ron Williams, August 26, 2002. Deborah Cohn later served as Commissioner of Trademarks from 2010–14).

¹⁸² U.S. Trademark Application Serial No. 78,507,090 (filed Oct. 27, 2004) (NBB NATURAL BORN BITCHES).

¹⁸³ *Id.* (Notation to File dated June 9, 2005) (Karla Perkins, “discussed uphill 2(a) with TS”).

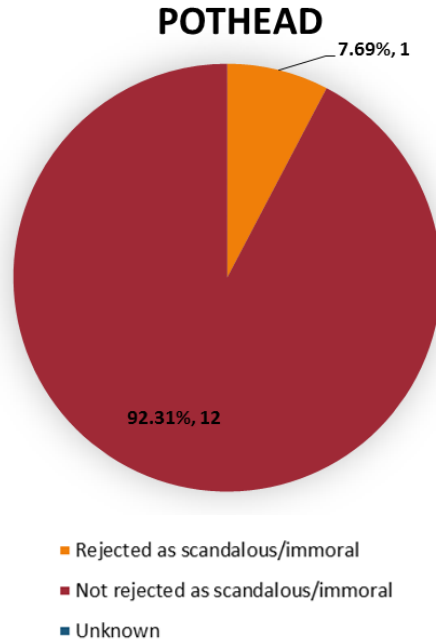
¹⁸⁴ *Id.*

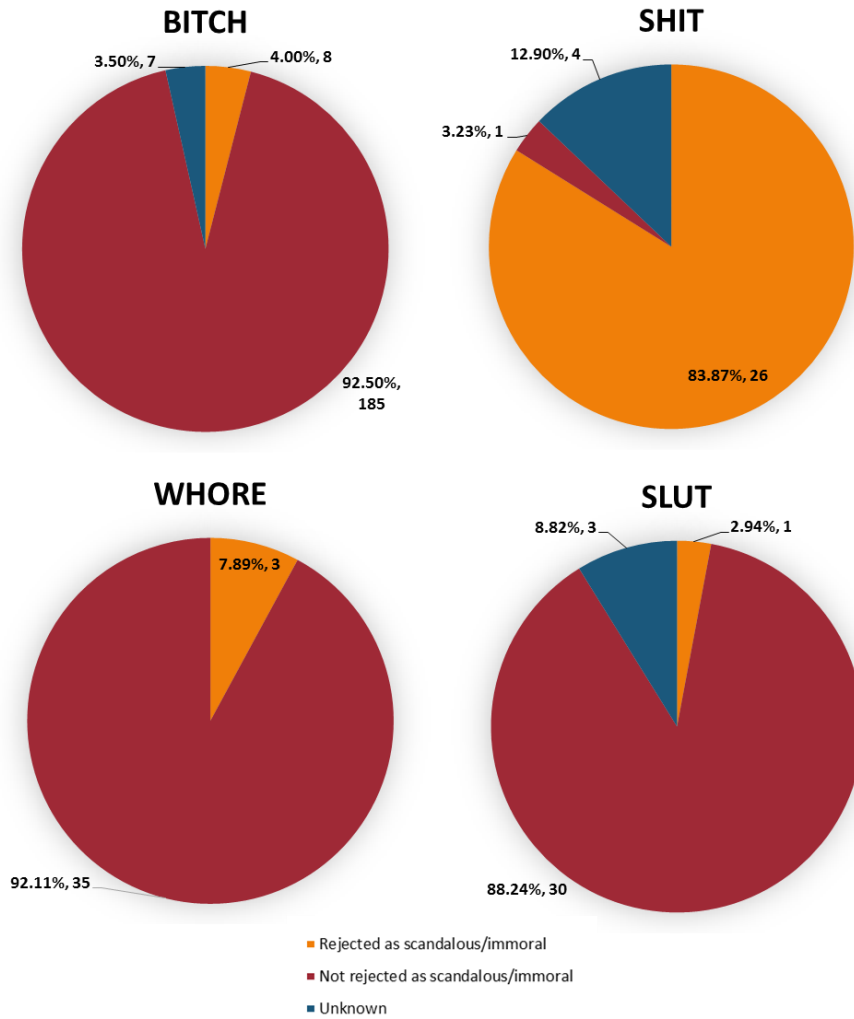
¹⁸⁵ U.S. Trademark Application Serial No. 77,290,998 (filed Sept. 27, 2007).

¹⁸⁶ This is 23.08% of the marks we looked at containing POTHEAD. POTHEAD, Registration No. 3,956,340; POTHEADS, Registration No. 4,365,056; THE POTHEAD DIARIES EST. 4.20.09, Registration No. 4,534,051.

¹⁸⁷ Registration No. 4,534,051.

inconsistent with one another. That is, why should marks with SHIT be rejected in the abstract categorically, while marks with BITCH or SLUT or WHORE tend to proceed to publication (again, in the abstract, and categorically)?



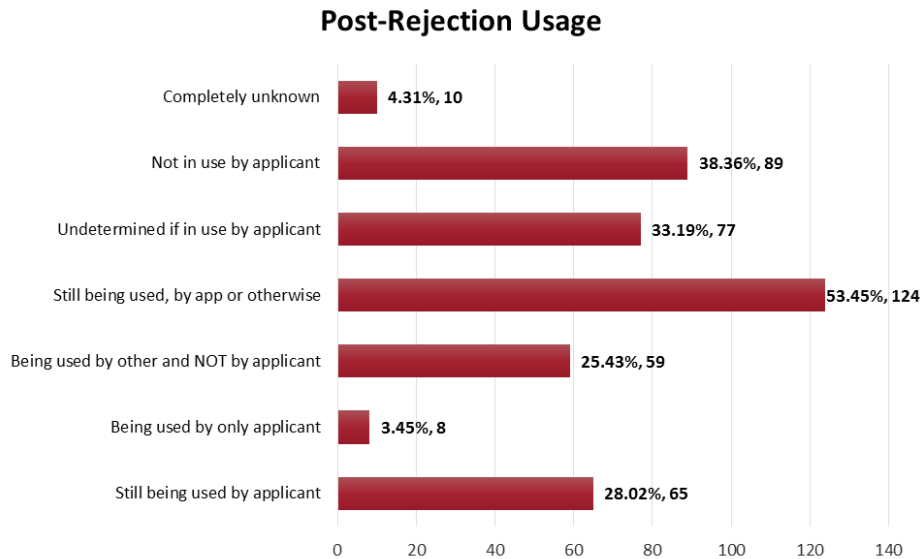


G. The Morality Bar is Not Effective at Keeping Immoral Trademarks out of the Marketplace

Our evidence shows a lot of uncertainty and inconsistency throughout the application of the Section 2(a) bar to registration for scandalousness. One thing, however, is clear: the bar is not succeeding at removing trademarks from the marketplace. A majority of rejected marks that we reviewed were easily determined to still be in use, either by the applicant or a third party.¹⁸⁸

¹⁸⁸ Overall, 53.45% (124) of marks rejected under Section 2(a) are still in use, by either the application or a third-party as based on Internet searches for the marks.

1. A Majority of Marks Refused Registration for Scandalousness are Still Being Used



Over half of the marks we investigated are still in use, whether by the applicant or a third-party. In addition to those marks determined to be in use or abandoned, the current use status of just under 5% of the marks was unclear. Of the marks still in use, approximately half (65) of those marks are being used by the applicant, and the rest are being used by at least one third-party. If any or all of the marks whose current usage was unclear are, in fact, still being used by the applicant, as much as 61% (75) of rejected marks are still in use by the applicant after rejection. This would also increase the number of marks still in use to 134, up to nearly 60%¹⁸⁹ of the total rejected marks in the data set. Even if those unknown marks are no longer in use, over half of the rejected marks are still being used in some fashion.

Given that only eight of the marks are being used solely by the applicant, which is fewer than 7% of the marks still in use, it is clear that refusing registration does not prevent proliferation of the marks. In fact, without recourse it is clear that third-parties are likely to begin using the same mark, continuing the presence of these types of marks in the marketplace.¹⁹⁰ Even marks that are currently not being used have no impediment from being used again in the future, whether by the

¹⁸⁹ 57.75%.

¹⁹⁰ 47.5% of marks still in use after rejection are being used by a third-party. Though it is possible current users are somehow affiliated with the original applicant, it is equally possible the current user is a completely separate entity.

original applicant or someone new.

CONCLUSION

According to the applicable legal standard, the determination of whether a mark is scandalous and thus barred from registration should be made in the context of current attitudes of the day. The relevant inquiry is whether a substantial composite of the general public would find the mark scandalous in the context of the particular marketplace in contemporary society. However, most refusals in our dataset failed to consider context of any kind, either in the commercial impression of the mark or the marketplace in which the goods/services are found. Despite the fact that they are abstracted from the marketplace, dictionary definitions have been held to be sufficient to support a refusal, and these are the primary evidence used to support refusals on this basis. The use of dictionary definitions to support refusals was consistent across various marketplaces, including “adult” or “niche” markets. When examiners did consider context, it was nearly exclusively used as an argument against registration: Use of a possibly scandalous mark in an adult-oriented marketplace was an indication that a scandalous meaning was intended; use of the mark in a general marketplace was an indication that the mark was even more scandalous. We found the same tendency across various goods and services, creating a catch-22 for the applicant. While examiners often acknowledged the relevance of context *de jure*, they frequently disregarded it *de facto*.

The implications of these findings are real. There is an impact on the trademark registration process generally, and on small businesses and individuals in particular, which comprise a disproportionate percentage of applicants. These applicants also are frequently *pro se* and unlikely to respond to refusals. When they do respond, they often argue contextual factors that may or may not be addressed by USPTO examiners and are rarely successful in overturning refusals. Furthermore, there are inconsistencies in reasoning across refusals. There are many similar marks that have been both registered in some cases and rejected in others. There are also comparable terms that tend to trigger rejections or acceptances, without apparent justification for the differential treatment. While some inconsistency is to be expected given the non-precedential nature of third-party registrations, the inconsistencies in our dataset were notable. In addition, to the extent that Section 2(a) of the Lanham Act seeks to keep immoral trademarks out of the marketplace, it is not succeeding. The majority of marks refused registration on this basis are still being used.

Trademark registration is a powerful tool to an entity interested in building a strong brand. Registration confers significant benefits to a trademark owner, both substantively and procedurally. The registration

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system serves also as a mechanism for consumer protection, contributing at some level to efficiencies in the consumer marketplace. Accordingly, bars to registration should be applied thoughtfully. Our findings indicate that this is not the case with regard to the bar for “scandalous” trademarks.