

WORKING DRAFT

Contextual Healing:

Scandalous Marks and the Role of Context in Trademark Registration

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Contextual Healing:**Scandalous Marks and the Role of Context in Trademark Registration**

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ABSTRACT

This Article is the culmination of a series of pieces on Lanham Act Section 2(a), which bars registration of trademarks that are scandalous or immoral. Herein, I answer the fundamental question: *Given the problems that my previous research has identified, what should be done about the 2(a) bar for scandalous marks?*

This Article proposes, first, that the registration bar for scandalous marks be removed from the Lanham Act. It should be removed because morality is outside the function and purpose of trademark law; the consumer protection at the heart of trademark law is one of source quality, not moral quality. Removing the registration bar would further be in line with other forms of intellectual property, which have moved away from regulating morality. Finally, removing the bar would resolve concerns about the provision's constitutionality. However, while the bar is in effect, I argue that it should be applied in a way that is fair and effective within the legal framework of trademark law. Scandalousness should be evaluated in the context of the current attitudes of the day and the marketplace identified in the application; however, marks are most often rejected in the abstract without regard for context. I argue that examining attorneys should treat a 2(a) question based on scandalousness or immorality the same way they treat most other issues in trademark law: through an assessment of the mark in the context of the marketplace. This would be consistent with other bars to registration found in the Lanham Act, and forms of content regulation in broadcast media.

I. INTRODUCTION

Lanham Act 2(a) prohibits registration of trademarks that are “scandalous” or “immoral.” In my previous research I have identified two relevant questions regarding this aspect of the 2(a) bar: First, can (and does) the Lanham Act effectively bar registration of marks that are scandalous and immoral? Second, should it do so? The first question was

the central inquiry of my first article, *Calling Bulls**t on the Lanham Act*,¹ which discussed some initial practical problems with the interpretation and application of 2(a). I have tackled the second question in two parts. In order to best normatively evaluate the effectiveness of the bar and determine whether it should be removed, it is critical to know how the provision is being applied in practice throughout the registration process. Thus, my second piece provided an in-depth, empirical study of this prohibition.² While many scholars have written on the morality provisions of the Lanham Act, there had never been an empirical study of scandalous marks. Through an examination of the trademark records for 232 marks, the project examined why marks were being rejected for scandalousness, what evidence was being used in the rejections, what inconsistencies exist throughout the process, and what the practical impact of these rejections may be on the use of trademarks in the marketplace, either by the original applicants or otherwise. My empirical research demonstrated that the application of the 2(a) bar for scandalous marks is inconsistent and ineffective.

This Article tackles the normative question head-on. It proceeds in two parts: First, I argue that the 2(a) bar should be removed. The Lanham Act should not bar registration of trademarks that are deemed scandalous or immoral.³ The bar is inconsistent with the object and purpose of trademark law, is inconsistent with the evolution of morality bars in IP generally, and may be unconstitutional. However, there are reasons to think that the bar may not be overturned. If that is the case, how can it be applied in a way that is effective, fair, and in harmony with the body of trademark law? The second part of this article argues that while the bar is in existence, it would be more effectively applied if trademark examiners considered contextual factors in their analysis; consideration of context is consistent with both other bases for rejection and other forms of content regulation. Specifically, I argue that trademark examiners should conduct a 2(a) analysis for scandalousness by considering the mark in context of the relevant marketplace. This solution is in line with the overarching body of trademark law, which evaluates trademarks in context. Marks are often rejected for being “scandalous” in the abstract based on dictionary definitions that note a particular term is “offensive” or “vulgar.” These

¹ See generally, Megan M. Carpenter & Kathryn T. Murphy, *Calling Bulls**t on the Lanham Act: The 2(a) Bar for Immoral, Scandalous, and Disparaging Marks*, 49 U. LOUISVILLE L. REV. 465 (2011).

² See generally, Megan M. Carpenter & Mary Garner, *NSFW: An Empirical Study of Scandalous Trademarks*, 33 CARDOZO ARTS & ENT'L J. (forthcoming 2015).

³ See *In re Tam*

refusals do not consider whether a mark is scandalous in context of the particular marketplace for goods and services, and yet that should be a material inquiry.

My proposal would bring the morality bar in line with the general body of trademark law, which focuses on trademark rights not as rights in gross, but rights appurtenant to a particular business.⁴ Context is a common consideration throughout the registration process, and examining attorneys routinely consider contextual factors in other areas of trademark registration, most notably in a likelihood of confusion analysis, but also for refusals on a variety of bases, including descriptiveness, functionality, and deceptiveness.⁵ In fact, it is unusual not to consider marketplace context in the application process. If we are going to prohibit registration of marks that are scandalous or immoral, that evaluation should consider context in the same way that other registration bars do.

This Article proceeds in six parts. In Part II, I trace the role and function of trademarks over time, and identify core functions of trademarks as source identifiers and consumer protection devices. These functions support the efficiency of consumer search costs and incentivize producers to invest in the goodwill of their goods and services. Part III argues that the bar on registration for scandalous marks should be removed; in order to stay in line with its core function and with the movement of intellectual property law generally, trademark law should move away from considering scandalousness as a bar to registration. This would be in line with recent case law on disparaging marks, and with other forms of intellectual property, which have moved away from regulating morality. While copyright and patent regimes once conditioned acquisition or maintenance of rights on the morality of works or inventions, they no longer do so. In Part IV, I propose that while the registration bar is in existence, it would be more effectively applied if trademark examiners considered contextual factors in their analysis. While the bar is in effect, we should interpret and apply it in a way that is effective, fair, and in harmony with the body of trademark law; consideration of context is consistent with other forms of content regulation. In Part V, I discuss the relevance of context in trademark registration, particularly with regard to the most common bar to registration, likelihood of confusion; the key *DuPont* factors considered by

⁴ United Drug Co. v. Theodore Rectanus Co. 248 U.S. 90, 97 (1918) (“The asserted doctrine is based upon the fundamental error of supposing that a trade-mark right is a right in gross There is no such thing as property in a trade-mark except as a right appurtenant to an established business or trade in connection with which the mark is employed.”)

⁵ See TMEP § 1207 (Jan. 2015).

examiners in a likelihood of confusion analysis of an application all focus on aspects of context. Similarly, other registration bars, such as descriptiveness and functionality, focus on aspects of context. Finally, in Part VI, I demonstrate that this change would be in line with other forms of content regulation, which have evolved to accommodate context, as well.

II. HISTORICAL DEVELOPMENT OF TRADEMARK FUNCTION

A. *Trademarks have developed throughout history to protect source quality, not moral quality.*

While trademark law is a relatively recent phenomenon, trademarks themselves predate reading and writing. Cave paintings in Europe and wall paintings in Egypt, dating from the late Stone Age or early Bronze Age, both show the act of cattle branding, which was likely the first use of a trademark.⁶ The verb “to brand,” in fact, is derived from the Old English *brand* or *brond*, meaning “firebrand” or “piece of burning wood.”⁷ In 1552, the word “brand” signified “identifying mark made by a hot iron,” but by 1827, this use had broadened to “a particular make of goods.”⁸

Trademarks have historically served to identify a source of goods and services. Pottery found in Greece and Rome usually had the maker’s name inscribed on the handle.⁹ Chinese porcelain had date marks and, sometimes, a maker’s mark, and/or the place of manufacture or destination of the particular piece.¹⁰ Bricks and tiles from Egypt have been found that contain identifying marks, including the inscription or symbol of the monarch, and the particular building project for which the bricks and tiles were to be used.¹¹ Egyptian signboards, with distinct marks and sometimes rebuses, have also been found.¹² Hindu goods dated to 1300 B.C. were

⁶ Sidney A. Diamond, *The Historical Development of Trademarks*, 65 The Trademark Reporter 265, 266-67 (1975).

⁷ Douglas Harper, *Brand*, ONLINE ETYMOLOGY DICTIONARY, http://www.etymonline.com/index.php?term=brand&allowed_in_frame=0 (last visited July 13, 2015).

⁸ *Id.*

⁹ Diamond, *supra* note ___, at 267; Gerald Ruston, *On the Origin of Trademarks*, 45 TRADEMARK REP. 127, 132 (1955); Benjamin G. Paster, *Trademarks—Their Early History*, 59 TRADEMARK REP. 551, 552-53 (1969).

¹⁰ Diamond, *supra* note ___, at 267; Paster, *supra* note ___, at 552.

¹¹ Diamond, *supra* note ___, at 268; Paster, *supra* note ___, at 552-53; see also Ruston, *supra* note ___, at 131.

¹² Diamond, *supra* note ___, at 272.

traded between India and Asia Minor and regularly utilized trademarks to indicate source.¹³

Over time, trademarks grew to represent the goodwill of their producers. Historian Sidney Diamond notes the proliferation of potters' marks used on Roman goods, particularly oil lamps, during the period 35 B.C. to 265 A.D.; approximately 1,000 marks have been identified as in use during that period of time.¹⁴ Since then, trademarks have been an integral aspect of trade. After a decline in the Dark Ages, the Medieval Period saw the development of personal marks, proprietary marks, and geographical appellations.¹⁵ Personal marks included coats of arms, seals, and house marks.¹⁶ House marks identified a family in residence and were literally affixed to a house; if a member of that family became a business owner, the house mark became a way of signifying the source of the business, as well.¹⁷ Sometimes house marks were placed on goods, also, either of a particular family business or of the household generally.¹⁸ Proprietary marks on goods enabled individuals to identify their tools and other articles, including farm animals, in the event they were lost or stolen.¹⁹ Geographical indications were often placed on goods that were likely to be part of a broader stream of commerce, such as tapestries and cloth.²⁰ Some tapestries also contained what would be the equivalent of a certification mark, certifying a particular level of quality for the goods.²¹ It is also claimed that during this period, in 1544, Charles V pronounced by edict that marks identifying the city of origin and maker were required on tapestries.²² The punishment for trademark infringement was amputation of the right hand.²³

¹³ Diamond, *supra* note ___, at 270.

¹⁴ Diamond, *supra* note ___, at 271; see also Ruston, *supra* note ___, at 133-34; Paster *supra* note ___, at 553-54. Of particular success was the FORTIS brand; FORTIS brand oil lamps have been found as far away as France, Germany, Holland, England, and Spain. The wide range of brand distribution may be attributed not only to the success of the FORTIS brand, but also to other incidental novelties: Perhaps the FORTIS brand was one of the first broad trademark counterfeiting operations. Or, perhaps the mark FORTIS became the first generic designation, signifying a particular type of oil lamp rather than a brand.

¹⁵ Ruston, *supra* note ___, at 134-135; Paster, *supra* note ___, at 555.

¹⁶ Diamond, *supra* note ___, at 272; Ruston, *supra* note ___, at 136-38.

¹⁷ Diamond, *supra* note ___, at 272-73; see Ruston, *supra* note ___, at 136-38; Paster, *supra* note ___, at 560-61.

¹⁸ Diamond, *supra* note ___, at 273; Ruston, *supra* note ___, at 136-38.

¹⁹ Diamond, *supra* note ___, at 273.

²⁰ Diamond, *supra* note ___, at 273.

²¹ See Diamond, *supra* note ___, at 274.

²² Diamond, *supra* note ___, at 279.

²³ Diamond, *supra* note ___, at 279; Paster, *supra* note ___, at 557. Diamond points out that the dates recorded for the identifying marks edict and the punishment conflict, the first being documented as occurring in 1544 with the latter being documented in 1554. It is

Ironically, between the invention of the printing press and the development of the concept of copyright, it was the trademark that governed original works fixed in a tangible medium. That is, where works were not protected by copyright, their indication of source was often determinative of their value. The trademark, for example, sat at the center of competition in the publishing trade. Printers and publishers competed for the most accurate version of a particular work, and in that regard used trademarks as an identification of source.²⁴ Trademarks served as the mechanism for protection of visual art, as well. In 1515, Albert Durer brought a complaint against an individual who was copying his works.²⁵ Rather than complaining about the copying of the work *per se*, however, Durer asked that the individual be prevented from using “AD” as a source-identifying mark.²⁶ The Council of Nuremberg complied.²⁷

Using trademarks as an indicator of source became commonplace in the industrial revolution.²⁸ From English pewter to French porcelain to American silversmithing, trademarks became widely used in the marketplace.²⁹ In 1783, an English court held that to infringe a trademark was fraud, and damages would be assessed accordingly.³⁰

B. Trademarks identify quality as well as source

Originally, trademarks were primarily identifiers of source. From the cattle-brands of Egypt in the late Stone Age to the proprietary and house marks in England during the Medieval Ages, these marks were clearly placed on goods to identify a particular source. As the characteristics and functions of trademarks have evolved over time, however, the property interest has grown stronger. Gilson notes that the distinction between how a

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

²⁴ Diamond, *supra* note ___, at 275; Ruston, *supra* note ___, at 139; Paster, *supra* note ___, at 558-59. In fact, the works of Livy, published by Aldus of Venice, contain a warning against imitations in the preface of the book.

²⁵ Diamond, *supra* note ___, at 279.

²⁶ Diamond, *supra* note ___, at 279.

²⁷ Diamond, *supra* note ___, at 279; Paster, *supra* note ___, at 556-57.

²⁸ See Diamond, *supra* note ___, at 280-81; Paster, *supra* note ___, at 564.

²⁹ Diamond, *supra* note ___, at 281.

³⁰ Singleton v. Bolton, (1783) 99 Eng. Rep. 661 (K.B.), 3 Doug. 293. Yet, there was no explicit law of trademarks, and no provision to try a case for trademark infringement.

trademark operates and why it should be protected is often blurred by courts, and, furthermore, that courts, legislatures, and commentators have differed in their views over time with changes in economy and culture.³¹

During the Industrial Revolution and ensuing developments of economy and culture in the 20th century, consumers became farther and farther removed from the producers of goods. With technology and transportation enabling mass production of goods, consumers drifted far downstream from manufacturers in the stream of commerce. Furthermore, others shared the waters; suppliers and merchants, both wholesale and retail, became integrated into the supply chain. As consumers could no longer rely exclusively on the trademark to identify a known *producer* of goods, they began to rely on marks to identify a particular *quality* of goods and/or services, through, for example, the sales from a particular merchant.

Case law in the first half of the 1900s demonstrates this shift, from trademarks as source identifiers to trademarks as identifiers of quality.³² In *Hanover Star Milling Co.*, for example, discussed above, the Court held that “the primary and proper function of a trademark is to identify the origin or ownership of the article to which it is affixed.”³³ The Court reasoned that the core of trademark function is to designate goods as being from a particular producer, and that consequently trademark law bars others from applying the same mark to the same goods, “because to do so would in effect represent their goods to be of his production and would tend to deprive him of the profit he might make through the sale of the goods which the purchaser intended to buy.”³⁴ The Court summarized: “the essence of the wrong consists in the sale of the goods of one manufacturer or vendor for those of another.”³⁵ It was only slightly more than a decade later that Frank Schechter, in his article “The Rational Basis of Trademark Protection,” argued that the public had come to rely on a trademark not for the origin of goods or services, but as a measure of quality, and that trademark law should accommodate this shift in function.³⁶ In the latter

³¹ 1-1 ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 1.03[2-3] (89th rev. 2015).

³² Cases that support the idea that trademarks identify a particular source of goods include, *inter alia*: United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90 (1918); Hanover Star Milling Co. v. Metcalf, 240 U.S. 403 (1916); Columbia Mill Co. v. Alcorn, 150 U.S. 460 (1893); Canal Co. v. Clark, 80 U.S. 311 (1871). Later cases acknowledge a material shift: *In re Polar Music Int'l*, 714 F.2d 1567 (Fed. Cir. 1983);

³³ *Hanover Star Milling Co.*, 240 U.S. at 412.

³⁴ *Id.*

³⁵ *Id.* at 412-13.

³⁶ Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 824 (1927), reprinted in 60 TRADEMARK REP. 334 (1970).

half of the 20th Century, courts and trademark owners honed in on the function of trademarks as a signifier of quality rather than source. Controlling quality began to be seen as one of the key functions of the Lanham Act.³⁷

This principle is enshrined in two separate places in the Lanham Act. Of primary importance is the definition of a trademark itself, which provides that a trademark can be any symbol that indicates the source of goods “even if that source is unknown.”³⁸ Also, Section 45 of the Lanham Act provides that a trademark may be “adopted and used by a manufacturer or merchant.”³⁹ This provision recognizes that the trademark does not always identify the producer of goods, and instead can identify other entities in the stream of commerce. Lanham Act provisions on trademark licensing support this shift from source to quality, as well. Under the Act, the owner of a federal trademark application or registration can license the right to use the mark to another party, provided that the trademark owner retains control over the nature and quality of the goods or services sold by the licensee under the mark⁴⁰. As long as the trademark owner has adequate quality-control mechanisms in place, he or she does not even have to use the mark, and use by the licensee inures to his or her benefit.⁴¹

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

³⁷ El Greco Leather Products Co. v. Shoe World, Inc., 806 F.2d 392, 395 (2nd Cir. 1986) and Gorenstein Enters. v. Quality Care-USE, 874 F.2d 431, 435 (7th Cir. 1989) both discuss how ensuring quality is an important function of the Lanham Act. *El Greco Leather*, also specifically states “one of the most valuable and important protections afforded by the Lanham Act is the right to control the quality of the goods” and then references Menendez v. Faber, 345 F. Supp. 527 (S.D.N.Y. 1972), *aff’d in relevant part and modified*, 485 F.2d 1355 (2d Cir. 1973); Alfred Dunhill, Inc. v. Republic of Cuba, 425 U.S. 682 (1976). It goes on to also state that “the actual quality of the goods is irrelevant; it is the control of quality that a trademark holder is entitled to maintain” (citing Professional Golfers Ass’n of Am. V. Bankers Life & Cas. Co., 514 F.2d 665, 670-71 (5th Cir. 1975)).

³⁸ 15 U.S.C. § 1127 (2012).

³⁹ *Id.*

⁴⁰ 15 U.S.C. § 1055.

⁴¹ *Id.*

III. REMOVAL OF THE 2(A) BAR FOR SCANDALOUSNESS

In order to stay in line with the core function and purpose of trademark law, the registration bar for scandalous marks should be removed. This would align with the movement of intellectual property law generally—with other forms of intellectual property, which have moved away from regulating morality, and with recent case law on disparaging marks. While copyright and patent regimes once conditioned acquisition or maintenance of rights on the morality of works or inventions, they no longer do so. In addition, recent case law suggests that the 2(a) registration bar for scandalous and immoral marks may be unconstitutional.

A. *Trademark is a form of intellectual property.*

While trademark rights are distinct in many ways, trademarks are part of the body of intellectual property law.⁴² Intellectual property law generally provided a starting point for consideration of the vesting of trademark rights and the interpretation of trademark doctrine, including registration of marks and federal legislation.⁴³

There was resistance, however, to bring trademarks within the parameters of intellectual property law. Central to this resistance was the claim that trademarks were not a form of property, but rather a device to prevent forgery or fraud: “It should be remembered that there was this important difference between patents and trademarks, that copying or infringing the latter was really analogous to forgery, while the infringement of a patent was merely interfering with a private right of property.”⁴⁴ Hindmarch believed that the property interest was the core element that separated trademarks from other forms of intellectual property, stating that “copyright in books and designs is a totally different thing, because there is a property created.”⁴⁵ This, combined with the fact that trademark law often protects pre-existing subject matter rather than a new creation, distinguished trademarks in the eyes of most practitioners and theorists, and trademark law was considered largely to fall outside the scope of intellectual property

⁴² See Diamond, *supra* note ___, at 288; Paster, *supra* note ___, at 566; Rudolf Callmann, *Unfair Competition Without Competition? The Importance of the Property Concept in the Law of Trade-Marks*, 95 U. PA. L. REV. 443, 454-57 (1947); see also Millington v. Fox (1838) 40 Eng. Rep. 956 (Ch.); *In re Trade-Mark Cases*, 100 U.S. 82 (1879).

⁴³ BRAD SHERMAN & LIONEL BENTLY, THE MAKING OF MODERN INTELLECTUAL PROPERTY LAW 168-69 (Cornish ed., 1999).

⁴⁴ SHERMAN & BENTLY, *supra* note ___, at 172 (quoting Campin).

⁴⁵ SELECT COMMITTEE ON TRADE MARKS BILL, 1862, H.C., ¶ 2984 (U.K.).

protection.⁴⁶

Contemporaneous with this debate was the growing tendency to treat trademarks, on a *de facto* if not *de jure* basis, as property interests, despite the fact that the particular property interest involved was vague and indistinct. Injunctions, for example, began to be issued in trademark infringement suits in England in 1838.⁴⁷ In the landmark case *Millington v. Fox*,⁴⁸ Lord Cottingham put forth for the first time the theory that there may be a property right in a trademark.⁴⁹ Trademark suits thereafter reaffirmed the property right in a trademark time and again, although they failed to clarify the particular property interests. Various opinions contained language proclaiming the property in a mark, typically in order to provide justification for an injunction as a remedy.⁵⁰ In 1882, Lord Blackburn noted, following this series of decisions, that it had been settled “that both trademarks and trade names are in a certain sense property.”⁵¹ Proclaiming such a settlement did not make it so, however, and the matter was settled in quite a different manner according to Sir Wood, Vice Chancellor, who held in *Collins Co. v. Brown* in 1857 that it was “now settled law that there is no property whatever in a trademark.”⁵² Decades after this matter was settled in both the affirmative and the negative, Lord Herschell struck a middle ground; in a foreshadowing of things to come on the other side of the Atlantic, he made a first reference to what might be the “instrumentality approach” to trademarks as property rights: He doubted that there were property rights in trademarks *per se*, but conceded that some *incidental* property rights might exist.⁵³

⁴⁶ SHERMAN & BENTLY, *supra* note ___, at 170-71

⁴⁷ A plaintiff in a trademark suit in 1838 was able to obtain an injunction in England.

⁴⁸(1838) 40 Eng. Rep. 956, 958, 961; Callmann, *supra* note ___, at 454.

⁴⁹ Louis Altman & Malla Pollack, CALLMANN ON UNFAIR COMPETITION, TRADEMARKS & MONOPOLIES § 17:7 (4th Ed.), Westlaw (database updated Apr. 2015).

⁵⁰ *Edelsten v. Edelsten*, I De G. J. & S. 185, 199, '10 L. T. R. (N. S.) 780 (1863) (“This court will act on the principle of protection property alone, and it is not necessary for the injunction to prove fraud in the defendant, or that the credit of the plaintiff is injured by the sale of an inferior article.”) *Leather Cloth Co. v. American Leather Cloth Co.*, 4 De G. J. & S. 137, 142 (1863) (“The true principle therefore would seem to be, that the jurisdiction of the Court in the protection given to trade-marks rests upon property, and that the Court interferes by injunction, because that is the only mode by which property of this description can be effectually protected.”) (“The same things are necessary to constitute a title to relief in equity in the case of the infringement of the right to a trade-mark as in the case of the violation of any other right of property.”)

⁵¹ *Singer Mfg. Co. v. Loog*, (1882) 8 App. Cas. 15 (U.K.); *see also Hall v. Barrows*, (1863) 46 Eng. Rep. 873 (Ch.) (U.K.).

⁵² *Collins Co. v. Brown*, (1857) 69 Eng. Rep. 1174 (V.C.) 1176.

⁵³ *Reddaway v. Banham*, [1896] AC 199 (HL) 209-10 (U.K.).

In the United States, the development of the issue was met with similar controversy, and similar ambivalence of resolution. Here, the concept of trademarks as property rights dominated early jurisprudence, and it was not until some body of case law had developed that general consensus began to shift in the other direction. The first reported trademark case in United States federal courts was decided in 1844, in which a plaintiff alleged that its trademark on spools of thread had been infringed.⁵⁴ In that case, the court held that the defendant had both defrauded the public and taken “from the plaintiffs the fair earnings of their skill, labor, and enterprise,” justifying its holding through what is at base a Lockean labor theory of property.⁵⁵ In support of its findings, the court stated: “I do not quote cases, to establish the principles above stated. They are very familiar to the profession; and are not now susceptible of any judicial doubt.”⁵⁶ The reasoning of the court appeals thus to both labor theory and natural law, which often serve as a justification for property rights generally.

The latter half of the 19th Century saw the development of U.S. trademark law in both breadth and depth as a form of intellectual property, clarifying the rights that accompany trademarks and the extent of their protection of marks against use by others. Twenty-six years later the first federal trademark act was passed, only to be held unconstitutional by the Supreme Court as having been based in the patent and copyright clause⁵⁷ (perhaps that had something to do with the fact that the Act was called, “An Act to Revise, Consolidate, and Amend the Statutes Relating to Patents and Copyrights”).⁵⁸ Courts expanded the geographic scope of trademark protection,⁵⁹ allowed protection for coined words against others *idem sonans*,⁶⁰ excluded descriptive terms from protection,⁶¹ and endorsed assignability of marks.⁶² When the court analyzed the assignability of marks, it reasoned directly that “there is a right of property in a trademark which is capable of being transferred to another.”⁶³ The noted *Trade-Mark*

⁵⁴ Taylor v. Carpenter, 23 F. Cas. 742, 744 (C.C.D. Mass. 1844).

⁵⁵ *Id.*

⁵⁶ *Id.*

⁵⁷ *In re Trade-Mark Cases*, 100 U.S. 82 (1879).

⁵⁸ 16 Stat. 198 (1870).

⁵⁹ See *Derringer v. Plate*, 29 Cal. 292, 298 (1865).

⁶⁰ *Gear v. Kenyon*, 10 Haw. 162, 163-64 (1895).

⁶¹ See, e.g., *Barrows v. Knight*, 6 R.I. 434, 437-38 (1860); *Falkinburg v. Lucy*, 35 Cal. 52, 70-71 (1868); *Filley v. Fassett*, 44 Mo. 168, 176-77 (1869).

⁶² See, e.g., *Coe v. Bradley*, 5 F. Cas. 1170, 1170-71 (C.C.D. Mass. 1876) (No. 2,941); *Witthaus v. Braun*, 44 Md. 303, 306 (Md. 1876).

⁶³ *Lockwood v. Bostwick*, 2 Daly 521, 525 (C.P.N.Y. 1869).

Cases further hold that the right to adopt and use a trademark as a form of intellectual property:

is a property right for the violation of which damages may be recovered in an action at law, and the continued violation of it will be enjoined by a court of equity, with compensation for past infringement. This exclusive right was not created by the act of Congress, and does not now depend upon it for its enforcement. The whole system of trademark property and the civil remedies for its protection existed long anterior to that act, and have remained in full force since its passage.⁶⁴

In several cases around the turn of the 20th century, the Court evinced a sort of ambivalence toward the conception of trademarks as property rights. In one circuit court case, there appeared a shift away from the more expansive view that had been elucidated by the Supreme Court in *The Trade-Mark Cases*;⁶⁵ that court, led by Justice Holmes, held that the common law did not create “a property in advertisements more absolute than it would have allowed the author of ‘Paradise Lost;’ but the meaning was to prevent one man from palming off his goods as another’s, from getting another’s business or injuring his reputation by unfair means, and, perhaps, from defrauding the public.”⁶⁶ Justice Holmes later extended this view from the bench of the Supreme Court. In *DuPont Powder Co. v. Masland*, he stated that “[t]he word property as applied to trademarks and trade secrets is an unanalyzed expression of certain secondary consequences of the primary fact that the law makes some rudimentary requirements of good faith.”⁶⁷

⁶⁴ *In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879).

⁶⁵ See *id.* at 92-93.

⁶⁶ *Chadwick v. Covell*, 23 N.E. 1068, 1069 (1890).

⁶⁷ E.I. Du Pont De Nemours Powder Co. v. Masland, 244 U.S. 100, 102 (1917). Justice Holmes’s vacillation on this subject would continue for another decade. In *Bourjois & Co. v. Katzel*, he expressed the view that the monopoly interest of a trademark is equal to that of a patent. *A. Bourjois & Co. v. Katzel*, 260 U.S. 689, 692 (1923). Contrarily, in *Prestonettes, Inc. v. Coty*, he expressed the limitations of trademarks vis-à-vis property interests. *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368-69 (1924). And, finally, in *Beech-Nut Packing Co. v. P. Lorillard Co.*, he seemed to have resolved the issue in favor of trademarks as qualified property rights. *Beech-Nut Packing*, 273 U.S. at 632. (“[I]n a qualified sense the mark is property, protected and alienable, although as with other property its outline is shown only by the law of torts, of which the right is a prophetic summary.)

Trademarks are now commonly considered to be a form of intellectual property right as a form of human creativity that may be treated as an asset, even if that right is an instrumental one, as described in *Hanover Star Milling Co. v. Metcalf*,⁶⁸ and *United Drug v. Theodore Rectanus*.⁶⁹ In *Hanover Star Milling Co.*, three entities all had separate claims to the mark TEA ROSE as applied to flour. In evaluating priority as well as the territorial limitations of the individual uses, the court treated the trademark at issue as a property right only to the extent that the trademark serves as an instrumentality to a trade reputation and the good will that flows from that, stating that the property interest in a trademark is limited to that “appurtenant to an established business or trade in connection with which the mark is used.”⁷⁰ The property interest, thus, inheres only in connection with the good will of an existing business, and a trademark’s ability to signify that source.⁷¹

B. Other forms of intellectual property have moved away from regulating morality.

The prohibition on registration for scandalous and immoral trademarks sets trademark law apart from other forms of intellectual property by maintaining distinctions based on morality. Although other forms of intellectual property have discriminated against works based on morality in the past, in both copyright and patent law there has been a trend toward eliminating these restrictions.

⁶⁸ *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403 (1916).

⁶⁹ *United Drug Co. v. Theodore Rectanus*, 248 U.S. 90 (1918).

⁷⁰ *Hanover Star Milling Co.*, 240 U.S. at 414.

⁷¹ *Theodore Rectanus*, 248 U.S. at 97. *Theodore Rectanus* also focused on the territorial scope of trademark protection, and supports this view of trademarks as an instrumentality, stating that the notion of a trademark as a right in gross or at large is a “fundamental error.” Trademarks are, rather, a “means for facilitating the protection of one’s good-will in trade,” and the accompanying rights grow out of the use of a mark, not the adoption of it. The Court grounded trademark law in the law of unfair competition, a perspective supported by the Lanham Act, the comprehensive federal trademark act which came into force in 1947, and provides the core of trademark law even today. The Lanham Act was principally drafted by Edward S. Rogers of Chicago, and introduced into Congress by Texas Congressman Fritz Lanham. Edward S. Rogers, *The Lanham Act and the Social Function of Trade-Marks*, 14 L. & CONTEMP. PROBS. 173, 180 (1949) (arguing that the purpose of the Lanham Act was to “protect trade-marks and to repress unfair competition, [as well as to] encourage the use of trade-marks and thus recognize their social value.”) Edward S. Rogers, *Introduction to DAPHNE ROBERT, THE NEW TRADE-MARK MANUAL: A HANDBOOK ON PROTECTION OF TRADE-MARKS IN INTERSTATE COMMERCE* xiv (1947).

1. Morality and Copyright

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.⁷² Throughout history, courts have formulated different definitions of and tests for obscenity. The Supreme Court first attempted to define obscenity by attending “Movie Day,” where the justices would gather together with their clerks to view the adult films that were the subject matter of the obscenity cases before the Court.⁷³

In 1973, the Supreme Court set forth a definitive three-prong test determining if a work is obscene in *Miller v. California*. The *Miller* test for obscenity paved the way for the modern view of copyrightability for obscene works. The *Miller* test asks (1) whether the average person, applying contemporary community standards, would find that the work, taken as a whole, appeals to the prurient interest; (2) whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law, and; (3) whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value.⁷⁴ The Court later defined “community” as the community of the individual juror,⁷⁵ the “average person” to include both sensitive and insensitive adults,⁷⁶ and “prurient” to mean any lust that is not “normal.”⁷⁷

a. Historical Morality Bars in Copyright

The common law bar of copyright to obscene works is thought to have originated in England, when a publisher sought damages for the

⁷² See, *Hoffman v. Le Traunik*, 209 F. 375, 379 (N.D.C. New York 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*, 100 S. Ct. 1277 (March 3, 1980) (No. 79-1088) (removing immoral standard).

⁷³ Christopher Thomas McDavid, *Note: I know It When I See It: Obscenity, Copyright, and The Cautionary Tale of the Lanham Act*, 47 U. Louisville L. Rev. 561, 563 (2009); citing Bob Woodward and Scott Armstrong, *The Brethren*, 198 (1979) (noting that neither Justices Douglas and Black never attended Movie Day because they rejected the argument that any expression should be banned. Justice Black famously commented, “If I want to go see that film, I should pay my money.”).

⁷⁴ *Miller v. California*, 413 U.S. 15 (1973).

⁷⁵ *Hamling v. United States*, 418 U.S. 87, 105 (1974).

⁷⁶ *Pinkus v. United States*, 436 U.S. 293, 298-99 (1978).

⁷⁷ *Brockett v. Spokane Arcades, Inc.*, 472 U.S. 491, 498 (1985).

unauthorized sale of his work by a subsequent publisher.⁷⁸ In *Stockdale v. Onwhyn*, the court held that the work in question was “libelous and licentious” and that “it would be a disgrace to the common law should a court of justice protect from piracy a work on an indecent nature.”⁷⁹ The court observed that English equity courts frequently refused to grant injunctive relief to stop piracy of morally objectionable works.⁸⁰ This equity-focused view was based on the doctrine of unclean hands, which prevents an author tainted by the illegality of publishing an obscene work from enjoying the protection of the court’s authority.⁸¹

In 1867, the California Circuit Court in *Martinetti v. Maguire* adopted the *Stockdale* doctrine when it denied relief in an infringement action because the work in question did not fit within the boundaries of the Intellectual Property Clause.⁸² Because the play featured “scant and meaningless dialog,” “women lying about in novel dress or no dress,” and consisted “mainly of women lying about loose,” it did not promote science or the useful arts.⁸³ The court elaborated: “To call such a spectacle a ‘dramatic composition’ is an abuse of language, and an insult to the genius of the English drama.”⁸⁴ Although the judge denied that he was acting as a conservator of public morality by denying copyright, he contradicted himself by concluding, “it is the duty of all courts to uphold public virtue, and [to] discourage and repel whatever tends to impair it.”⁸⁵ In 1898, a court similarly held that songs containing obscene lyrics were not entitled to copyright protection because they did not progress the arts as required by the Intellectual Property Clause.⁸⁶ The court held that the song “Dora Dean” was not useful (and, implicitly, obscene) because it contained the lyric “the hottest thing you ever seen” in reference to an attractive woman.⁸⁷ The court noted that “hot” could be defined as “lustful, lewd, or lecherous,”

⁷⁸ McDavid, *supra* at 564; *Stockdale v. Onwhyn*, 108 Eng. Rep. 65 (1826).

⁷⁹ *Stockdale*, 108 Eng. Rep. at 66. The work in question was the *Memoirs of Harriett Wilson*, a story of the exploits of a notorious courtesan. Kurt L. Schmalz, *Problems in Giving Obscenity Copyright Protection: Did Jartech and Mitchell Brothers Go Too Far?*, 36 Vand. L. Rev. 403, 404 (1983).

⁸⁰ *Id.*

⁸¹ Schmalz, *supra* at 405.

⁸² *Martinetti v. Maguire*, 16 F. Cas. 920 (1867). The case concerned an infringement action regarding the play “Black Crook,” which the author slightly modified the characters and dialog in creating “Black Rook.” The Court held that both plays lacked originality, and thus neither was entitled to copyright protection.

⁸³ *Id.* at 922.

⁸⁴ *Id.*

⁸⁵ *Id.*

⁸⁶ *Broder v. Zeno Mauvais Music Co.*, 88 F. 74, 79 (C.C.D. Cal. 1898).

⁸⁷ *Id.*

and concluded that the obscene lyrics were not copyrightable.⁸⁸

Throughout the 1900s, however, courts began to erode away the bar for obscene works. In 1925, in a case that serves as an exemplar for changing mores, a court echoed the morality requirement for copyright protection, but failed to apply it.⁸⁹ A district court in New York held that the play *White Cargo* infringed upon the novel *Hell's Playground*, even though the works were “unnecessarily coarse and highly sensual.”⁹⁰ The novel and the play both depicted an Englishman’s affair with a West African native in the French Congo. The court did not find the work in question immoral, but stated that copyright would have been invalid if it was.⁹¹

A district court in California similarly rejected an infringement defense based on (im)morality in 1942. In the movie *When Tomorrow Comes*, a couple engaged in “indecent and vulgar acts” before a church altar.⁹² Interestingly, the court in this case did not apply the *Martinetti* rule to invalidate the copyright.⁹³ Rather, the court applied the United States Post Office’s definition of obscenity that was used to keep pornography out of the mail; this test considers the works as a whole and proscribes the work if it has a “direct tendency to corrupt morals.”⁹⁴ The court determined that the work was not obscene because the woman who desecrated the altar was killed at the end of the film, and thus cured the film of any possible immorality.⁹⁵

As a last gasp of morality restrictions in copyright, the New York Supreme Court refused to allow copyright on plaintiff’s satirical strip-tease dance because it failed to promote the objectives of copyright.⁹⁶ Although the decision was not based on moral outrage, as was the focus in earlier decisions, the court still denied copyright because the dance failed to promote the progress of science and useful arts.⁹⁷ The court reasoned: “Not everything that is put on stage can be subject to copyright. While plaintiff’s performance was no doubt amusing and entertaining to many, it does not

⁸⁸ *Id.*

⁸⁹ *Simonton v. Gordon*, 12 F.2d 116, 124 (S.D.N.Y. 1925).

⁹⁰ *Id.*

⁹¹ *Id.*

⁹² *Cain v. Universal Pictures Co.*, 47 F. Supp. 1013 (S.D. Cal. 1942).

⁹³ *Id.*

⁹⁴ *Id.* at 1018

⁹⁵ *Id.*

⁹⁶ *Dane v. M. & H. Co.*, 136 U.S.P.Q. (BNA) 426 (N.Y. Sup. Ct. 1963).

⁹⁷ *Id.* at 429.

fall within the purview of the statute as a production tending to promote the progress of science and useful arts.”⁹⁸

b. Modern Copyright Law Rejects Bars Based on Morality

Although neither Congress nor the Supreme Court have explicitly weighed in, the modern view is to afford all eligible works copyright protection, regardless if a community regards a work as immoral or obscene.⁹⁹ 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.¹⁰⁰ This is the approach taken by the Copyright Office today.

In 1979, the Fifth Circuit held in *Mitchell Brothers* that works could not be excluded from copyright because of obscene content.¹⁰¹ 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.¹⁰² Defendants argued that the copyright holders brought suit with “unclean hands,” and that equity should uphold obscenity as an affirmative defense to infringement.¹⁰³ The Fifth Circuit did not agree, rejecting the “moral conservator theory of copyright invalidation,”¹⁰⁴ the “property interest theory,”¹⁰⁵ and the unclean hands equitable doctrine.¹⁰⁶ The court reasoned that Congress had intentionally omitted, and therefore did not intend, a bar for immoral or obscene works.¹⁰⁷ The court further argued that denying copyright to obscene works was contrary

⁹⁸ *Id.* The court noted, “Where a performance contains nothing of a literary, dramatic or musical character which is calculated to elevate, cultivate, inform or improve the moral or intellectual natures of the audience, it does not tend to promote the progress of science or the useful arts.

⁹⁹ See 1-2 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.”)

¹⁰⁰ Schmalz, *supra* at 417.

¹⁰¹ *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852, 862 (5th Cir. 1979), cert. denied, 445 U.S. 917 (1980).

¹⁰² *Id.*

¹⁰³ *Id.*

¹⁰⁴ *Id.*

¹⁰⁵ *Id.*

¹⁰⁶ *Id.*

¹⁰⁷ *Id.* (“We can only conclude that we must read the facially all-inclusive 1909 copyright statute as containing no explicit or implicit bar to the copyrighting of obscene materials, and as therefore providing for the copyright of all creative works, obscene or non-obscene, that otherwise meet the requirements of the Copyright Act.”)

to the Intellectual Property Clause's purpose of promoting creativity,¹⁰⁸ and reasoned that the market was the appropriate arbitrator in determining if a work is fit for public consumption.¹⁰⁹ 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 1976.¹¹⁰ The issue of copyrightability of obscene material has remained untouched at the appellate level since *Jartech*.¹¹¹

Perhaps the most definitive evidence that modern copyright law does not contain a morality bar is a simple search of issued United States Copyrights via the Copyright Office's Internet database.¹¹² The amount of potentially obscene or scandalous material that has obtained copyright protection is voluminous, and the copyright holders of pornographic and "adult" material regularly engage with the Copyright Act to enforce their exclusive rights under Section 106.¹¹³

2. Morality and Patent

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

a. Historical Morality Bars in Patent Law

¹⁰⁸ *Id.* (Reserving copyright for only moral works "would be antithetical to [the] promotion of creativity. The pursuit of creativity requires freedom to explore into gray areas, to the cutting edge, and even beyond.") (The court also cited books banned under obscenity laws as further evidence of stifled creativity. These include *Lady Chatterley's Lover* by D.H. Lawrence (*Commonwealth v. Delacey*, 171 N.E. 455 (Mass. 1930)); *An American Tragedy* by Theodore Dreiser (*Commonwealth v. Friede*, 171 N.E. 472 (Mass. 1930)); and Henry Miller's *Tropic of Cancer* and *Tropic of Capricorn* (*Besig v. United States*, 208 F.2d 1087 (9th Cir. 1973)).

¹⁰⁹ *Id.* (Copyright "is best served by allowing all creative works to be accorded copyright protection regardless of subject matter or content, trusting to the public taste to reward creators of useful works and to deny creators of useless works any reward.").

¹¹⁰ [CITE TO JARTECH] See Schmalz, *supra* at 416.

¹¹¹ See *Mitchell*, *supra* at 567.

¹¹² Search available at the United States Copyright Office Webpage: <http://cocatalog.loc.gov/cgi-bin/Pwebrecon.cgi?DB=local&PAGE=First>

A search for "incest" provided 221 unique registrations.

¹¹³ [CITE TO NEWS ARTICLES]

Utility patents were once subject to restrictions based on morality like the ones that trademarks are subject to today. Patent law required “. . . the invention [to] not be frivolous or injurious to the well being, good policy, or *sound morals* of society.”¹¹⁴ The word ‘useful’ therefore, is incorporated into the act in contradistinction to mischievous or immoral.¹¹⁵ Under this definition, “immoral” or “mischievous” inventions were not patentable because those uses were not beneficial to society. Justice Story cited inventions designed to poison people, promote debauchery, or facilitate private assassination as examples of immoral inventions that did not perpetuate the public good.¹¹⁶

This moral utility requirement was echoed in subsequent caselaw. In *Rickard*, the 2nd Circuit held that a patent on a process for treating plain leaf tobacco plants to make their leaves become spotted invalid.¹¹⁷ Cigar smokers of the time believed that spotted tobacco leaves were of better quality, and thus enabled the inventor to sell the counterfeit tobacco for a higher price.¹¹⁸ The court denied patent protection because the invention did not improve the tobacco leaf or the cigar smoking process, and because its sole purpose was to deceive the public.¹¹⁹ Similarly, in *Artiso Hosiery*, the 2nd Circuit denied patent protection for a seamless stocking that featured an imitation seam on one side.¹²⁰ The prevailing thought of the time was that seamed stockings were of higher quality.¹²¹ Again, the court denied patent protection because its sole design was to deceive the public.¹²² This invention was useful in a particular way—that is, it allowed people who were unable to purchase seamed stockings to obtain the appearance of the expensive alternative. However, the court focused on the underlying purpose to deceive the public, and refused registration.

By the time the Federal Circuit rejected the immorality and mischief bars in 1999, they had already become somewhat of a relic and courts rarely

¹¹⁴ *Lowell v. Lewis*, 15 F. Cas. 1018, 1019 (D. Mass. 1817) (No. 8568) (emphasis added); 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 (Summer 2005).

¹¹⁵ *Id.*

¹¹⁶ *Id.*

¹¹⁷ *Rickard v. Du Bon*, 103 F. 868, 873 (2d Cir. Conn. 1900).

¹¹⁸ *Id.* at 868.

¹¹⁹ *Id.* at 873.

¹²⁰ *Scott & Williams, Inc. v. Aristo Hosiery Co.*, 7 F.2d 1003, 1004 (2d Cir. N.Y. 1925).

¹²¹ *Id.*

¹²² *Id.*

implicated the moral utility theory at all.¹²³ 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.¹²⁴ When Juicy Whip sued a competitor for infringement, the competitor claimed that the patent was invalid because it lacked utility due to its deceptiveness.¹²⁵ The district court found the patent invalid because its purpose was to increase sales by deception, but the 2nd Circuit reversed.¹²⁶ 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.”¹²⁷ The court subsequently described several issued patents that had utility because they were designed to represent something that they were not.¹²⁸

b. Evolution of Patent Law Demonstrates Increasing Disregard for Morality

The evolution of disregarding morality as a basis for patentability is well illustrated in the context of gambling. In 1889, devices related to gambling were found to lack utility, and thus were unpatentable.¹²⁹ However, an invention solely used for gambling was granted a patent in 1977.¹³⁰ In *Ex Parte Murphy*, the Board stated that the PTO “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.”¹³¹ Since that time, no court has relied on the moral utility doctrine in rejecting a patent.¹³²

¹²³ *Juicy Whip, Inc. v. Orange Band, Inc.*, 185 F.3d 1364, 1367 (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.”)

¹²⁴ U.S. Patent No. 5,575,405; *Juicy Whip*, 185 F.3d at 1365, 1368.

¹²⁵ *Id.*

¹²⁶ *Id.*

¹²⁷ *Id.* at 1367.

¹²⁸ *Id.* at 1366; See, e.g., U.S. Pat. No. 5,762,968 (method for producing imitation grill marks on food without using heat); U.S. Pat. No. 5,899,038 (laminated flooring imitating wood); U.S. Pat. No. 5,571,545 (imitation hamburger). The court also referred to cubic zirconium, imitation gold leaf, and imitation leather.

¹²⁹ *National Automatic Device Co. v. Lloyd*, 40 F. 89, 89-90 (N.D. Ill. 1889).

¹³⁰ *Ex Parte Murphy*, 200 U.S.P.Q. (BNA) 801, 802-803 (Bd. Pat. App. 1977).

¹³¹ *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.”

¹³² Ho, Cynthia, Splicing Morality and Patent Law at 248.

We can see a similar evolution away from morality in other areas of patent law, as well. A patent for a novelty “keyhole finder” was invalidated by the CCPA in the 1950s when it was discovered that the device gave the appearance of female genitalia.¹³³ However, patents have been granted in recent decades on countless sexually explicit inventions, including an oral prophylactic¹³⁴, a contraceptive and flavor delivery system¹³⁵, a unisex condom¹³⁶, interactive lingerie¹³⁷, a female garment with enfolding at labia majora¹³⁸, couples intimacy reciprocating and pivoting two seat assembly¹³⁹, a method and device for interactive virtual control of sexual aids using digital computer networks¹⁴⁰, and a penis pump.¹⁴¹

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

In recent years, the USPTO has had the opportunity to revisit the moral utility theory, but has chosen not to do so as a basis for rejection of patent rights. The filing of patent applications for life-related patents raised the question of morality as a basis for determining patentable subject matter when cellular biologist Stewart Newman attempted to obtain a method patent for producing a half-human, half animal species.¹⁴² Newman’s application was not filed to acquire a patent on his invention, but was rather a de facto petition to the USPTO to clarify its stance on the patentability of

¹³³ U.S. Patent No. 2,632,266 (filed May 2, 1950). Patent office subsequently invalidated this patent when it found that its application gave the appearance of female genitalia.

¹³⁴ U.S. Patent No. 4,494,731 (filed Aug. 27, 1987). Invention claimed both oral contraception and protection from paint entering the mouth when painting with the mouth.

¹³⁵ U.S. Patent No. 4,919,149 (filed Jul. 8, 1988).

¹³⁶ U.S. Patent No. 4,966,165 (filed Aug. 12, 1988).

¹³⁷ U.S. Patent No. 5,068,519 (filed Feb. 7, 1991).

¹³⁸ U.S. Patent No. 5,285,531 (filed Sep. 4, 1992).

¹³⁹ U.S. Patent No. 5,385,154 (filed Jan. 31, 1995).

¹⁴⁰ U.S. Patent No. 6,368,268 (filed Aug. 17, 1998).

¹⁴¹ U.S. Patent No. 7,651,463 (filed Sep. 2, 2005). Note that some of these were issued much earlier than 1999, further suggesting that the requirement was not uniformly implemented before formally rejected. For a more in-depth look at sexual inventions, see Hoag Levins, *American Sex Machines: The Hidden History of Sex at the U.S. Patent Office* (Adams Media Corporation 1996). Also note that some of the patents would more readily offend some than others, and that some would probably been more offensive earlier in history than they are now.

¹⁴² See Group Faults PTO for Issuing Patent on ‘Method of Producing Cloned Mammal,’ 64 Pat. Trademark & Copyright J. 81 (2002); Benjamin Enerson, *Protecting Society From Patently Offensive Inventions: The Risk of Reviving the Moral Utility Doctrine*, 89 Cornell L. rev. 685, 693 (March 2004).

life.¹⁴³ When Newman's application was publicized, the USPTO reacted quickly with an advisory stating that all patent applications must meet strict patentability requirements and the USPTO does not discriminate against fields of technology.¹⁴⁴ It also stated that "courts have interpreted the utility requirement to exclude inventions that are 'injurious to the well being, good policy, or good morals of society'."¹⁴⁵ While this raised the spectre of resurrection of the moral utility theory, the USPTO did not use it as a basis for rejecting the Newman's application; instead, the office rejected the patent on the basis that it failed to claim statutory subject matter.¹⁴⁶ The USPTO has more recently acknowledged that it is without authority to deny a patent based on morality. The Agency has stated:

The scope of subject matter that is eligible for a patent, the requirements that must be met in order to be granted a patent, and the legal rights that are conveyed by an issued patent, are all controlled by statutes which the USPTO must administer. . . Congress creates the law and the Federal judiciary interprets the law. The USPTO must administer the laws as Congress has enacted them and as the Federal courts have interpreted them. Current law provides that when the statutory patentability requirements are met, there is no basis to deny patent applications.¹⁴⁷

d. Design Patents Retain a Morality Bar but the Bar is Infrequently Applied in Practice

¹⁴³ Sean M. Couglan, The Newman Application and the Uspto's Unnecessary Response: Patentability of Humans and Human Embryos, 5 Chi.-Kent J. Intell. Prop. 90, 90 (Spring 2006). Newman is generally against patenting life, and sought to "reignite debate about the ethics of genetic engineering and the patenting of life forms."

¹⁴⁴ Patent and Trademark Office, Facts on Patenting Life Forms Having a Relationship to Humans <<http://www.uspto.gov/web/offices/com/speeches/98-06.htm>>.

¹⁴⁵ Patent and Trademark Office, Facts on Patenting Life Forms Having a Relationship to Humans <<http://www.uspto.gov/web/offices/com/speeches/98-06.htm>>. The USPTO cited the 1817 *Lowell v. Lewis* case in this advisory.

¹⁴⁶ *Id.* The PTO has noted that "a claim directed to or including within its scope a human being will not be considered to be patentable subject matter under 35 U.S.C. § 101." Patent and Trademark Office, Animals --Patentability, 1077 OFF. GAZ. PAT. OFFICE 24 (1987). See Enerson, 89 Cornell L. rev. at 693; See fiel history of U.S.S.N. 08/993,564, non-final Office Action mailed on October 7, 2003 at 17 (presenting a new standard: claims "embracing" humans and human embryos are not patentable.).

¹⁴⁷ Examination Guidelines for the Utility Requirement, 66 Fed. Reg. 1092, 1095. The Utility Examination Guidelines are instructions to be used by USPTO examiners when assessing the patentability of a claimed invention.

United States law provides modified patent protection for inventions of “new, original, and ornamental design for an article of manufacture.”¹⁴⁸ Unlike utility patents, design patents are barred for subject matter that could be offensive to any race, religion, sex, ethnic group, or nationality.¹⁴⁹ However, this bar is infrequently used; while rejections of design patent applications are not published, and no statistics on design patent rejections are publicly available from the USPTO, it is at least some indication that there are no appeals on record for rejections on this basis.¹⁵⁰ In addition, there are many examples of existing design patents for material that may reasonably be found offensive to a race, religion, sex, ethnic group, or nationality:

- Bottle with frontal female nudity¹⁵¹
- Buddha golf head cover¹⁵²
- A.R. Conner Flag (flag depicting an African-American caricature, along with a watermelon, a chicken, and a rat)¹⁵³
- Pasta box depicting the Last Supper¹⁵⁴

C. The 2(a) registration bar for scandalous and immoral marks may be unconstitutional.

Removing the 2(a) bar for registration of scandalous and immoral trademarks would be in line with the function and purpose of trademark law, and with other forms of intellectual property. In addition, a bar on registration of scandalous and immoral trademarks is likely unconstitutional as a content-based restriction on speech.¹⁵⁵ As a content-based restriction,

¹⁴⁸ 35 U.S.C. 171

¹⁴⁹ See Patent and Trademark Office, U.S. Dep’t of Commerce, Manual of Patent Examining Procedure § 1504.01(e) (2008).

¹⁵⁰ In addition, correspondence with USPTO Patent Attorney David Gerk, who specializes in design patent applications, supports this conclusion. Regarding rejection of design patents for offensiveness, he states: “[T]his is not something I understand comes up frequently.” Email correspondence with David Gerk, Patent Attorney, Office of Policy and International Affairs, United States Patent and Trademark Office, February 3, 2015 (on file with author).

¹⁵¹ U.S. Patent No. D721,974 S (filed June 28, 2013) (issued Feb. 3, 2015).

¹⁵² U.S. Patent No. D465821 (filed Dec. 4, 2001) (issued Nov. 19, 2002).

¹⁵³ U.S. Patent No. D35,985 (filed June 9, 1902) (a flag picturing a African-American caricature along with a watermelon, chicken, and a rat).

¹⁵⁴ U.S. Patent No. D627,661S (filed Jan. 4, 2010) (box of pasta depicting the Last Supper on the box). Although the scene appears to be accurately depicted, the existence of the last supper on a pasta box may offend someone, and copyright protection might be more appropriate.

¹⁵⁵ *In re Tam*, 808 F.3d 1321, 1329 (2015) (stating that this provision in the Lanham

the bar is presumptively invalid and subject to strict scrutiny; to overcome the presumption, the restriction must be narrowly tailored to serve a compelling state interest.¹⁵⁶ If scandalous marks rise to the level of obscenity, the government would have sufficient interest in restricting them and would be able to overcome the presumption. If, however, scandalous marks comprise a lesser standard, such as vulgarity or offensiveness, the registration bar would be unconstitutional.

Marks that are scandalous are held to a lower standard than obscenity. The Trademark Manual of Examining Procedure (TMEP), case law, and empirical research all indicate that the standard for scandalousness is below that of obscenity. The TMEP states: “[T]he standard is lower for what can be described as scandalous than for obscene.”¹⁵⁷ The standard in case law illustrates this principle: A mark is scandalous if multiple dictionaries indicate a proposed mark is vulgar, and the applicant’s use is limited to the vulgar meaning.¹⁵⁸ Vulgarity and offensiveness, in fact, are used as the standard in the majority of rejections based on scandalousness: Our research found that dictionary definitions noting a word is “vulgar” or “offensive” were used as a primary source of support for a rejection based on scandalousness 91% of the time, and that examiners used *only* the dictionary in 70% of such refusals.¹⁵⁹ Thus, their regulation would not be a compelling state interest.

Act serves as a content-based restriction on speech).

¹⁵⁶ The Federal Circuit recently held that the bar on registration of disparaging marks does not serve a compelling state interest, given the viewpoint-based nature of the restriction. The registration bar for scandalous marks would not constitute viewpoint-based discrimination, however, because it does not value one perspective over another.

¹⁵⁷ TMEP 1203.01. However, the TMEP states: “Refusal to register immoral or scandalous matter has been found not to abridge First Amendment rights, because no conduct is proscribed and no tangible form of expression is suppressed. Also, the term “scandalous” has been held sufficiently precise to satisfy due process requirements under the Fifth Amendment.” *McGinley*, 660 F.2d at 484-85, 211 USPQ at 672.

¹⁵⁸ TMEP 1203.01 (citing *Boulevard Entm’t*, 334 F.3d at 1341, 67 USPQ2d at 1478 (holding 1-800-JACK-OFF and JACK OFF scandalous, where all dictionary definitions of “jack-off” were considered vulgar); *Boston Red Sox Baseball Club Ltd. P’ship v. Sherman*, 88 USPQ2d 1581 (TTAB 2008) (basing scandalousness of SEX ROD mark on dictionary definitions designating the term “ROD” as being vulgar, and applicant’s admission that SEX ROD had a sexual connotation); *Red Bull*, 78 USPQ2d at 1381-82 (finding BULLSHIT scandalous because dictionary definitions indicate it is “obscene,” “vulgar,” “usually vulgar,” “vulgar slang,” or “rude slang” constitute a *prima facie* showing that the term is offensive to the conscience of a substantial composite of the general public)). For a comprehensive discussion of the evidence used to reject marks for scandalousness, see Carpenter & Garner, *supra* note X, at Section X.

¹⁵⁹ Carpenter & Garner, *supra* note X, at 336-37.

Courts have long assumed that the 2(a) registration bar is constitutional based on *In re McGinley*,¹⁶⁰ a 1981 case that held without much analysis that the registration bar did not violate the First Amendment “because no conduct is proscribed and no expression is suppressed.” Until recently courts did not engage in further analysis of the issue, but the Federal Circuit in *In re Tam* recently considered the constitutionality of the 2(a) bar for disparaging marks at length and held that the bar was subject to, and could not withstand, strict scrutiny. In light of this opinion, arguments for the constitutionality of the registration bar for scandalous marks may be unpersuasive.¹⁶¹ For example, an argument exists that this provision of the Lanham Act regulates commercial speech, and is therefore not subject to strict scrutiny.¹⁶² However, *In re Tam* found that with regard to disparaging marks, the mark’s expressive nature is what subjects it to rejection.¹⁶³ This is true also for scandalous marks; a mark’s scandalous nature is not part of its source-identifying function any more than a disparaging mark would be. Like disparaging marks, the expressive component is precisely what is targeted by the prohibition.¹⁶⁴

The argument that the registration bar is constitutional because registration is government speech is similarly unpersuasive. The Federal Circuit affirmed that trademark registration is not government speech because it is merely a regulatory activity, like registration of copyright.¹⁶⁵ Finally, the constitutionality of 2(a) is not likely to be salvaged because trademark owners can still use a mark. The Model State Trademark Act keeps 2(a) intact and would prevent trademark owners from registering scandalous marks under state law, as well.¹⁶⁶ Furthermore, there is uncertainty regarding the enforceability under 43(a) of marks that have been refused registration based on policy reasons.¹⁶⁷ A trademark owner receives

¹⁶⁰ *In re McGinley*, 660 F.2d 481, 484-85 (CCPA 1981)).

¹⁶¹ See generally *In re Tam*, 808 F.3d.

¹⁶² If trademark registration is commercial speech, the standard would be evaluated on a basis of intermediate scrutiny. *Central Hudson Gas & Electric Corp. v. Public Service Commis*

¹⁶³ *In re Tam*, 808 F.3d at 1337-38.

¹⁶⁴ See id.

¹⁶⁵ *In re Tam*, 880 F.3d at 1346 (holding that the circle R does not convert trademark into government speech anymore than a circle C converts a copyrighted work into government speech).

¹⁶⁶ Model State Trademark Act; *In re Tam*, 880 F.3d at 1343-44.

¹⁶⁷ *Two Pesos v. Taco Cabana* (“[I]t is common ground that § 43(a) protects qualifying unregistered trademarks and that the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a).”); see *Renna v. County of Union*, N.J., 2014 WL 2435775, No. 2:11-3328 (D.N.J. May 29, 2014) (holding that a mark

substantial benefits from trademark registration, and denial of those benefits creates a chilling effect on use of those types of marks.¹⁶⁸

denied registration based on policy grounds is not enforceable under 43(a)).

¹⁶⁸ See *In re Tam* at 1342.

IV. CONTEXTUAL HEALING

As discussed above, removing the registration bar would be in line with the core function of trademark law and with other forms of intellectual property, as well as fundamental constitutional principles. However, on a practical level, Congress and the courts may be unlikely to strike the morality bar from the Lanham Act—and while it is in place it should be applied in a way that is fair and appropriate within the parameters of trademark law.

A. The registration bar for scandalousness would be more effectively applied if trademark examiners considered contextual factors in their analysis.

We should interpret and apply the existing law in a way that is effective, fair, and in harmony with the body of trademark law. However, as applied, the registration bar is ineffective and vague, and both trademark examiners and applicants need better guidance in this area.¹⁶⁹ One way to do effectuate trademark policy is to ensure that trademark examiners consider context when evaluating marks that may be scandalous or immoral. When evaluating the eligibility of marks for registration generally, trademark law typically considers subject marks in context. And while scandalous marks are also in principle to be evaluated in the context of the marketplace, trademark examiners do not typically consider contextual factors. Considering contextual factors in a determination of scandalousness would lead to a more effective and fair result throughout the application process.

As previous articles have acknowledged, application of this provision of the Lanham Act is inconsistent at best and nonsensical at worst. Despite the fact that scandalousness is supposed to be determined according to the context of the current attitudes of the day and the relevant marketplace for goods and services identified in the application,¹⁷⁰ context is not considered in any way regarding targeted consumers, goods and services, or the marketplace. Marks are often rejected on the basis of a dictionary definition without regard for any contextual factors whatsoever. Despite the absence of meaningful analysis, marks containing the same terms on similar goods and services may end up both rejected and approved without additional explanation. Whether a mark is rejected or registered often depends on the particular trademark examiner, and responses to office actions are rarely if

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¹⁷⁰ In re Mavety Media; In re McGinley.

ever successful because, in the absence of relevant analysis, there is nothing to argue against. Furthermore, the standards for scandalousness and immorality are unclear; to the extent that there are standards, they are often erroneously conflated with disparagement. Requiring a consideration of context will also provide trademark applicants and examiners with clearer guidance throughout the registration process.

1. The determination of whether a mark is scandalous should be made in the context of the relevant marketplace.

A mark must be evaluated in the context of the current attitudes of the day, and the determination of whether a mark is scandalous must be made in the context of the relevant marketplace for the goods or services identified in the application.¹⁷¹ This should be ascertained from the standpoint of not necessarily a majority, but a substantial composite of the general public.¹⁷² To support a refusal on these grounds, the examiner must provide evidence that a substantial portion of the general public would consider the mark to be scandalous in the context of contemporary attitudes *and the relevant marketplace*.¹⁷³ Thus, a determination that a mark is scandalous because it is used in a scandalous marketplace is a misapplication of the law. Rejecting a mark because the use of that mark on sexually explicit goods reinforces the vulgarity of its intended meaning is not just circular reasoning, but incorrect. It creates a situation where though a mark is on a good sold in a specific marketplace—in the context of which the goods or services may not be considered scandalous, and which may not be frequented by or accessible to the general public—that mark still cannot be registered because the general public may find the term vulgar in the abstract. The proper inquiry, however, is not in the abstract; it is whether or not a substantial composite of the general public would find the mark scandalous for the particular marketplace. Context of any sort was considered in refusals less than half the time.

At the same time, “scandalous” has been held to encompass matter that is merely “vulgar”.¹⁷⁴ And evidence of the opinions of a substantial composite of the general public can include media, including magazine

¹⁷¹ In re Mavety Media Group Ltd., 33 F.3d 1367, 31 USPQ2d 1923 (Fed. Cir. 1994). In re McGinley, 660 F.2d at 485, 211 USPQ at 673; In re Wilcher Corp., 40 USPQ2d 1929 (TTAB 1996); Greyhound Corp. v. Both Worlds, Inc., 6 USPQ2d 1635, 1639 (TTAB 1988). TMEP 1203.01.

¹⁷² Id.

¹⁷³ In re Mavety Media, 33 F.3d at 1371-1372, 31 USPQ2d at 1925.

¹⁷⁴ Vulgar has been defined as “lacking in taste, indelicate, morally crude.” In re Rundorf, 171 USPQ 443, 444 (TTAB 1971).

articles, newspaper articles, and dictionary definitions.¹⁷⁵ 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.¹⁷⁶

Examining attorneys are under pressure to process applications quickly. According to the USPTO Performance Appraisal Plan, a trademark examiner must meet quarterly quotas. To be “fully successful”, examiners must have 425-549 balanced disposals¹⁷⁷ of applications per quarter.¹⁷⁸ To be “outstanding,” an examiner should have completed at least 515-75 balanced disposals. At an average of 500 working hours per quarter, an “outstanding” trademark examiner should process more than one application per hour. When considering whether or not a particular mark is scandalous, an examining attorney can either ascertain the meaning of a mark in the context of the current attitudes of the day, or perform a quick dictionary search and reject an application if the particular term is “vulgar.” It is unsurprising that the majority of applications refused on the basis of scandalousness fail to consider the context of the marketplace or the goods and services listed in the application.

2. Trademark examiners do not typically consider contextual factors in a refusal based on scandalousness, regardless of the marketplace or goods at issue.

Trademark examiners are highly unlikely to consider contextual factors in a refusal based on the scandalous or immoral nature of a mark. Refusals frequently mention the relevance of context *de jure* but disregard it *de facto*.¹⁷⁹ The vast majority of applications that are rejected on the basis of

¹⁷⁵ TMEP 1203.01

¹⁷⁶ The applicant's use must be limited to the vulgar meaning of the word. In re Boulevard Entertainment, Inc., 334 F.3d 1336, 67 USPQ2d 1475 (Fed Cir. 2003) (1-800-JACK-OFF and JACK OFF were scandalous where multiple dictionary definitions indicated the term “jack off” was vulgar).

¹⁷⁷ Examiners take one action for completing an initial examination and making a determination regarding the registrability of the mark or “first action” on the application, and one for either approving an application for publication or abandonment.

¹⁷⁸ GS 9/11/12 PERFORMANCE APPRAISAL PLAN, available at <http://www.nteu245.org/GS-9-11-12PAP.pdf>; GS 13/14 P PERFORMANCE APPRAISAL PLAN, available at <http://www.nteu245.org/PAP13-14.pdf>; see also MEMORANDUM OF UNDERSTANDING BETWEEN THE UNITED STATES PATENT AND TRADEMARK OFFICE AND NATIONAL TREASURE EMPLOYEES UNION, Chapter 245 TM GS-9/11/12 Performance Appraisal Plan, available at <http://www.nteu245.org/GS-9-11-12PAPMOU.pdf>

¹⁷⁹ Carpenter & Garner, *supra* note X, at 344-45 (citing, e.g., *In re Tinseltown, Inc.*, 212 U.S.P.Q. (BNA) 863, 866 (T.T.A.B. 1981).

scandalousness are rejected because they are listed as “vulgar” in the dictionary.¹⁸⁰ My previous research indicated that dictionary definitions were used as a primary source of support for a rejection based on scandalousness 91% of the time.¹⁸¹ Sixty-three percent of rejections used the dictionary exclusively for support.¹⁸²

The use of dictionary definitions as exclusive or primary evidence for a refusal based on scandalousness is consistent across various marketplaces, including niche markets such as adult entertainment and adult-oriented goods.¹⁸³ For adult-oriented goods and services, dictionary definitions served as the only basis for rejection in the majority of refusals.¹⁸⁴ When examiners did consider contextual information in these niche markets, they did so only as an argument against registration; that is, use of a mark in an adult-oriented marketplace was used as further evidence of the mark’s scandalous nature.¹⁸⁵ For example, an examiner rejected the mark POST-TITS on the basis that the general public would find it scandalous, despite assertions by the trademark owner that the relevant market was controlled and narrow.¹⁸⁶ This is often the case whether or not the application contained a reference to adult goods and/or services.¹⁸⁷ Most often,

This frequently occurred with regard to refusals based on words typically considered profane. 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, rejecting the registration without any additional supporting evidence.

¹⁸⁰ Carpenter & Garner, *supra* note X, at 336-37.

¹⁸¹ *Id.*

¹⁸² *Id.*

¹⁸³ Carpenter & Garner, *supra* note X, at 337-38. In marks targeting an adult marketplace, only five Office Actions referenced context of the marketplace at all.

¹⁸⁴ *Id.* at 338.

¹⁸⁵ See, e.g., 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).

¹⁸⁶ U.S. Trademark Application Serial No. 76,536,775 (filed July 22, 2003) (Office Action dated May 20, 2004).

¹⁸⁷ See Carpenter & Garner, *supra* note X (citing e.g., U.S. Trademark Application Serial No. 78,853,993 (filed Apr. 4, 2006) (TITTY CITY) (claiming services in class 41 for “entertainment”); U.S. Trademark Application Serial No. 85,253,332 (filed Feb. 28, 2011) (FAT COCK BEER); U.S. Trademark Application Serial No. 76,484,466 (filed Jan. 22, 2003) (TOKYO CREAMPIE); U.S. Trademark Application Serial No. 76,490,572 (filed Feb. 19, 2003) (JAPANESE CREAMPIE); U.S. Trademark Application Serial No. 76,639,548 (filed May 25, 2005) (NIGGA); U.S. Trademark Application Serial No. 77,281,745 (filed Sept. 18, 2007) (THIZZ JUICE); U.S. Trademark Application Serial No. 76,675,279 (filed Apr. 10, 2007) (TITTIGYM); U.S. Trademark Application Serial No.

trademark examiners consider whether a substantial composite of the general public would find the mark scandalous abstracted from the market for the goods and services at issue.¹⁸⁸ Google searches are common contextual evidence used to demonstrate a mark is scandalous.¹⁸⁹

Examiners are also generally unlikely to consider the context of goods and services in rejections for scandalous marks. Like the above findings with regard to marketplace, examiners are unlikely to consider context of goods and services identified in the application. Use of a mark on adult-oriented goods is often used as evidence that a mark is scandalous;¹⁹⁰ use of a mark

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").

¹⁸⁸ Carpenter & Garner, *supra* note X, at 340-41.

¹⁸⁹ For example, an examiner rejected the mark FAT COCK BEER in part based on the results of a Google search indicating that "fat cock" is vulgar slang, concluding the mark was therefore scandalous to the general public. U.S. Trademark Application Serial No. 85,253,332 (filed Feb. 28, 2011). TITTY PRETTIES was similarly rejected in part because of a Google search showing that the word "titty" can be used in an "offensive and disgraceful manner." U.S. Trademark Application Serial No. 78,524,781 (filed Nov. 30, 2004) (Office Action dated July 11, 2005).

¹⁹⁰ Carpenter & Garner, *supra* note X, at 342-43 (citing *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.

that may be vulgar on goods sold to the general public is also used as evidence that a mark is scandalous.¹⁹¹

A lack of clarity in the guidelines for refusals based on scandalousness sometimes leads to bizarre results. In at least one instance, the examiner refused registration of a mark in part because scandalous information would be found while searching for the stated vulgar terms, rather than the mark would be found while searching for more innocent things.¹⁹² In another

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) (BEAVERSCHAVER); 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 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)).

¹⁹¹ U.S. Trademark Application Serial No. 78,879,965 (filed May 9, 2006) (rejecting TIT-MITT on the basis that its use on bras would ensure people would know that “tit” was used to reference a breast); U.S. Trademark Application Serial No. 78,631,791 (filed May 17, 2005) (rejecting MY SH!T D*N'T STINK because “shit” rendered the mark scandalous even if the term is relevant and not being used in the vulgar sense). *See also* U.S. Trademark Application Serial No. 77,883,100 (filed Dec. 1, 2009) (TOUCH YOUR TITS for shirts); U.S. Trademark Application Serial No. 76,675,279 (filed Apr. 10, 2007) (TITTIGYM for an adult health and fitness club); U.S. Trademark Application Serial No. 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).

¹⁹² cite? (Under “Quirks of Specific Marks,” below Figure 22)

instance, the examiner mentioned that the relevant audience is irrelevant to an analysis of whether a mark is scandalous or immoral because that would help people attempting to register such marks.¹⁹³ The examiner reasoned that if the appropriate test were the “relevant population” no mark would ever be refused on 2(a) grounds “since the applicant would not adopt a mark which would drive the relevant purchasers or audience away from using or purchasing the applicant’s identified goods or services.”¹⁹⁴

Compounding the confusion is a lower burden of proof for “egregious” marks, which is an unclear and inconsistently applied standard. Under *In re Wilcher Corp.*, the amount of proof required to support a refusal based on scandalousness depends upon the nature of the mark, with less evidence required for more egregious marks.¹⁹⁵ This standard appears to be applied inconsistently, when it is applied at all, and even when applied often no information is given to permit either the current applicant or any further applicants to determine what is particularly egregious so that could, if desired, be avoided in the future.¹⁹⁶ Examining attorneys frequently provide no explanation as to why a particular mark is considered “egregious”.¹⁹⁷ The word “fuck” appears most likely to be found “egregious,” but is also equally likely not to be held egregious.¹⁹⁸ Even when a reason is provided, there does not appear to be consistency. In two marks involving the term “donkey punch,” the violence of a sexual act made them egregious; however, in THE COCK MEAT SANDWICH SHOP, the reason given is simply that there is no other meaning for the phrase at issue.¹⁹⁹

¹⁹³ U.S. Trademark Application Serial No. 78,643,827 (FUCK.XXX).

¹⁹⁴ *Id.* The examiner stated 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.

¹⁹⁵ *In re Wilcher Corp.* The Board stated that “inclusion in a mark of a readily recognizable representation of genitalia certainly pushes the mark a substantial distance along the continuum from marks which are relatively innocuous to those which are most egregious.”

¹⁹⁶ MR. HORSE COCK, IMMANASSHOLE, FUCKTUBE, FUCK CANCER, FUCK EVERYBODY, FUCK OFF, A NIGGER FOR LIFE, SCHLONG WEAR, ASSHOLE, FUCK.XXX, MY SHIT D*N'T STINK, FUGLY

¹⁹⁷ MR. HORSE COCK, IMMANASSHOLE, FUCKTUBE, FUCK CANCER, FUCK EVERYBODY, FUCK OFF, A NIGGER FOR LIFE, SCHLONG WEAR, ASSHOLE, FUCK.XXX, MY SHIT D*N'T STINK, FUGLY

¹⁹⁸ FUCKSTRONG (fuck is a highly offensive, vulgar slang word), DRUNK DUMB FUCKS (fucks and fuck are obscene and therefore egregiously scandalous);

Cite marks that contain “fuck” but don’t talk about being egregious.

¹⁹⁹ DONKEY PUNCH (refers to a sexual practice that involves violent physical

Initial refusals evaluating a mark out of context have serious implications for the ultimate dispensation of the application. Applicants are unlikely to respond to a refusal based on scandalousness.²⁰⁰ Research has indicated that of those applicants who did file an Office Action response, contextual factors were the most common argument used in support of registration.²⁰¹ In fact, context was argued in 64% of all responses in our dataset.²⁰² These arguments, however, are unlikely to succeed; out of 232 records reviewed, only two such arguments were ultimately successful.²⁰³ In fact, examiners were not more likely even to address contextual factors in subsequent Office Actions when an applicant had filed a response containing an argument based on context.²⁰⁴

V. RELEVANCE OF CONTEXT IN TRADEMARK REGISTRATION

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

The scope of trademark rights depends on contextual factors such as the appearance of the mark itself, goods or services, relevant marketplace, and

abuse), doNKEy punCH (term is considered to associate with violence and violent sex), THE COCK MEAT SANDWICH SHOP (there are no other meanings for the phrase at issue)

²⁰⁰ Carpenter & Garner, *supra* note X, at 346-47 (finding that more than three-quarters of applicants whose marks were refused for scandalousness failed to respond to the Office Action).

²⁰¹ *Id.* at 348.

²⁰² *Id.*

²⁰³ *Id.* (stating that 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.

²⁰⁴ *Id.* at 355. While 64% of Office Action responses argued contextual factors, when the examiner had not discussed context in the initial Office Action, subsequent Office Actions were only 50% likely to address the contextual argument.

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

A. The Section 2(d) bar for likelihood of confusion centers on an analysis of contextual factors.

The proper focus of a likelihood of confusion analysis is the overall impression of a mark as it is likely to be perceived by prospective purchasers.²⁰⁵ Core to the likelihood of confusion analysis is the mantra that a mark must be examined in the context in which appears in the marketplace to the ordinary consumer.²⁰⁶ In fact, the substantive *DuPont* factors cited as most relevant in an ex parte examination evaluate a mark in light of the overall market context. Those factors include: (1) appearance, sound, connotation, and commercial impression of the marks; (2) goods or services at issue; (3) established, likely-to-continue trade channels; (4) conditions under which and buyers to whom sales are made; and (5) other uses of similar marks in the marketplace.²⁰⁷

²⁰⁵ Paula Payne Products Co. v. Johnson Pub. Co., 473 F.2d 901, 902 (C.C.P.A. 1973). (holding that SPRAY ‘N’ GLOW for hair conditioner or hair brightener spray sufficiently resembled SPRAY ‘N STAY for hair spray as to cause likelihood of confusion. The proper inquiry is whether consumers would be confused into thinking that the goods identified by the marks could emanate from a single source.). For an analysis of this principle in the infringement context, see *Sun-Fun Products, Inc. v. Suntan Research & Development, Inc.*, 656 F.2d 186 (5th Cir.1981); *Dreyfus Fund, Inc. v. Royal Bank of Canada*, 525 F.Supp. 1108 (S.D.N.Y.1981).

²⁰⁶ Restatement (Third) of Unfair Competition § 21(a)(I) (1995).

²⁰⁷ TMEP 1207.01. The other factor is “a valid consent agreement between the applicant and the owner of the previously registered mark.” *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003) (“Not all of the DuPont factors may be relevant or of equal weight in a given case, and ‘any one of the factors may control a particular case,’” quoting *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

1. Examiners routinely consider the appearance of marks in context of information contained in the application to determine likelihood of confusion.

In contrast to refusals based on scandalousness, likelihood of confusion refusals typically evaluate the mark in context. Because the likelihood of confusion analysis looks to the actual use of marks, a comparison of the texts of two marks alone is insufficient if the marks have different appearances in the marketplace.²⁰⁸ In an infringement context, the comparison of marks seeks to replicate the appearance of the mark under the market conditions in which the marks are encountered by prospective purchasers;²⁰⁹ in the registration context, the comparison of marks does the same to the extent of the information contained in—and inferred from—the application.²¹⁰ For example, the mark SPRAY ‘N STAY was found to sufficiently resemble SPRAY ‘N’ GLOW for hair care products, despite the different meanings of the words “stay” and “glow”, because the connotation to the average purchaser of the goods could lead them to believe that they come from the same source. Conversely, the marks DIGIRAD and DIGIRAY were found to have different connotations so as not to create a likelihood of confusion because the particular purchasers of the products could easily distinguish based on the connotations of –RAY and –RAD in connection with the respective parties’ goods.²¹¹ Considering what the

²⁰⁸ See *Luigino's, Inc. v. Stouffer Corp.*, 170 F.3d 827, 830 (8th Cir.1999); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 198 (5th Cir.1998); *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 872 (2d Cir.1986).

²⁰⁹ See, e.g., *Wynn Oil Co. v. Thomas*, 839 F.2d 1183 (6th Cir.1988); *Calvin Klein Cosmetics Corp. v. Lenox Laboratories, Inc.*, 815 F.2d 500 (8th Cir.1987). A side-by-side comparison is warranted if the products are viewed together in the marketplace. *Lever Bros. Co. v. Winzer Co.*, 326 F.2d 817 (C.C.P.A.1964). However, a comparison is improper in the “isolated circumstances” of the marketplace. *American Auto. Ass'n v. AAA Ins. Agency*, 618 F.Supp. 787, 792 (W.D.Tex.1985)). See, e.g., *Levi Strauss & Co. v. Blue Bell, Inc.*, 632 F.2d 817 (9th Cir.1980); *James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266 (7th Cir.1976), appeal after remand 572 F.2d 574 (7th Cir.1978).

²¹⁰ *Sun-Fun Products*

²¹⁰ See, e.g., *Paula Payne Prods. Co. v. Johnson's Publ'g Co.*, 473 F.2d 901 (C.C.P.A. 1973); *In re Max Capital Grp. Ltd.*, 93 U.S.P.Q.2d 1243 (TTAB 2010); *In Re Cynosure, Inc.*, 90 U.S.P.Q.2d 1644 (P.T.O. May 8, 2009) (citing *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975)).

²¹¹ *In re Digirad Corp.*, 45 U.S.P.Q.2d 1844 (TTAB 1998). A comparison based on a dissection of the designations is normally improper in a likelihood of confusion analysis. *Chevron Chemical Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695 (5th Cir.1981), cert. denied 457 U.S. 1126 (1982). The dominant elements of a mark may strongly impact the general commercial impression. See, e.g., *Burger Chef Systems, Inc. v. Sandwich Chef, Inc.*, 608 F.2d 875 (C.C.P.A.1979); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460 (Fed.Cir.1991) (a common characteristic of a family of marks used by the

overall commercial impression of a mark is in the eyes of targeted consumers is key to a likelihood of confusion analysis. In finding a likelihood of confusion between CITY GIRL and CITY WOMAN, the Board emphasized that purchasers of CITY GIRL goods would likely assume that CITY WOMAN was a new line of products from the same source, or was connected with CITY GIRL in some way.²¹² Even with regard to sound, there is some concern for methods of pronunciation of the public exposed to particular marks.²¹³ Marketplace context is a key focus for the first factor in a 2(d) rejection.

2. Examiners routinely consider the goods and services identified in the application in a likelihood of confusion analysis.

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

plaintiff may itself become associated with the trademark owner; McPRETZEL created a likelihood of confusion with the McDONALD'S family of trademarks). Particularly when the distinctiveness of the other's designation is weak, the addition of the defendant's house mark may avoid confusion. *See Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033 (2d Cir.1992); General Mills, Inc. v. Kellogg Co., 824 F.2d 622 (8th Cir.1987). However, in some circumstances the use of a house mark may not alleviate the likelihood of confusion. *See, e.g., Banff, Ltd. v. Federated Department Stores, Inc.*, 638 F.Supp. 652 (S.D.N.Y.1986), *affirmed* 841 F.2d 486 (2d Cir.1988) (Defendant's name is listed in such small print as to lead to the conclusion that it is not the company name on it is relying to sell the goods but rather the mark which is so similar to that previously used by the plaintiff.) Moreover, the use of a defendant's own name in conjunction with an otherwise similar mark does not generally excuse the infringement since it may instead simply increase the misappropriation by linking the defendant's own name to the plaintiff's good will established by its trademark. *Id. See also W. E. Bassett Co. v. Revlon, Inc.*, 435 F.2d 656, 662 (2d Cir. 1970); *Miles Shoes, Inc. v. R. H. Macy & Co., Inc.*, 199 F.2d 602, 603 (2d Cir. 1952).

²¹² *In Re M. Serman & Co., Inc.*, 223 U.S.P.Q. (BNA) ¶ 52 (P.T.O. July 31, 1984).

²¹³ *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461 (TTAB 1985). (noting that similarity of sound can be challenging because there is no "correct" method for determining how the relevant public will pronounce the mark. Here, the Board held that the "word portion of applicant's mark "SEYCOS", is virtually the phonetic equivalent of opposer's "SEIKO" mark and is, in fact, the phonetic equivalent of the plural of opposer's mark" and refused to register the mark.)

need to be in order to create a likelihood of confusion in the marketplace.²¹⁴

For a 2(d) analysis, examining attorneys consider the relatedness of the goods based on their identification in the application.²¹⁵ The operative question is whether consumers would relate the goods of the relevant marks, which can occur even where goods are not used together or related in kind.²¹⁶ In *In re Davey*, the Trademark Trial and Appeal Board (TTAB) determined that the goods need only be sufficiently related so that consumers would be likely to assume, upon encountering the goods under similar marks, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source. In cases where the applicant's mark is identical to the cited registered mark, the degree of relatedness between the respective goods that is necessary to support a finding that the goods are related is less than it would be if the marks were not identical; there need be only a viable relationship between the respective goods.²¹⁷ If goods or services are related in some manner in the minds of the consumers, marks that are similar may give rise to a likelihood of confusion.²¹⁸ For example, the TTAB affirmed rejection of a travel

²¹⁴ Gen Mills, Inc. v. Fage Dairy Processing Indus. S.A., 100 USPQ2d 1584, 1597 (TTAB 2011); In re Iolo Techs., LLC, 95 USPQ2d 1498, 1499 (TTAB 2010); In re Davey Prods. Pty Ltd., 92 USPQ2d 1198 (TTAB 2009).

²¹⁵ In Re Toshiba Med. Sys. Corp., 91 U.S.P.Q.2d 1266 (P.T.O. June 18, 2009).

²¹⁶ *Id.* (The market factor considered in this analysis was whether the same facilities could purchase the equipment to be used in the diagnosis of the same patients.) “[G]oods that are neither used together nor related to one another in kind may still ‘be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.”

²¹⁷ In Re Davey Products Pty Ltd., 92 U.S.P.Q.2d 1198 (P.T.O. Aug. 7, 2009) (citing *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984)). The examining attorney also found that it is not necessary that the respective goods be identical, or even competitive, in order to find that they are related for purposes of our likelihood of confusion analysis (“[T]he issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods.”).

²¹⁸ *Weider’s Publishings, LLC*, 109 U.S.P.Q.2d 1347 (P.T.O. Jan. 21, 2014) (finding that an applicant’s attempt to register SHAPE for not only cosmetics, but also health spa services and wellness would likely cause likelihood of confusion with the magazine SHAPE where those types of services were featured and advertised: “It is sufficient that the respective goods and/or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source.”). Joel Gott Wines, LLC, 91197659, 2013 WL 5407313, at *8 (June 26, 2013) (finding that GOTTLIGHT for various non-alcoholic drinks was likely to be confused by consumers with wine marks: GOTTLIGHT and JOEL GOTTLIGHT. The goods “need only be sufficiently related that consumers would be likely to assume, upon encountering the goods under similar marks, that the goods originate from, are sponsored or authorized

agency's application for VOGUE based on the likelihood of confusion with VOGUE magazine.²¹⁹ VOGUE magazine successfully asserted that the goods were related in such a way as to create confusion in the marketplace; most of its readers are highly interested in travel, the magazine had been running travel articles for seventy years.²²⁰

3. Examiners routinely consider channels of trade when evaluating whether there is a likelihood of confusion for registration purposes.

Unlike the analysis involved in scandalous marks, a likelihood of confusion analysis looks at the marketing methods and channels of distribution used. The significance of trade channels is based upon where they lead and whether at the end certain classes of persons are exposed to the marks in issue under circumstances likely to result in confusion.²²¹ This factor is significant in illuminating what actually happens in the marketplace and, where other factors are not particularly probative, channels of distribution become of special importance.²²²

by, or are otherwise connected to the same source.”)

²¹⁹ The Conde Nast Publications Inc., 205 U.S.P.Q. (BNA) ¶ 579 (P.T.O. Dec. 21, 1979).

²²⁰ The Conde Nast Publications Inc., 205 U.S.P.Q. (BNA) ¶ 579 (P.T.O. Dec. 21, 1979) (providing account on how many articles related to travel were published each year and what kind of “travel-related” phrases – such as VOGUE on the Go, Passionate Traveler, Travel Egypt, or Vogue’s Travel log – were used).

²²¹ See, e.g., *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 U.S.P.Q. 58, 61 (T.T.A.B. 1984); *TCPIP Holding Co. v. Haar Commc’ns*, 244 F.3d 88, 901, 57 U.S.P.Q.2d 1969 (2d Cir. 2001) (similar buyers targeted); *Motion Picture Ass’n of Am. v. Respect Sportswear, Inc.*, 83 U.S.P.Q.2d 1555, 1562 (T.T.A.B. 2007) (“encountered by the same persons”).

²²² *Homeowners Group, Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1110 (6th Cir. 1991)(this factor consists of considerations of how and to whom the respective goods or services of the parties are sold). For example, if similar marks are used on goods sold through the same marketing channels, the probability of confusion may be higher than if the goods are marketed through separate channels. See *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460 (3d Cir.1983) (similar sales contexts can enhance the likelihood of confusion); See also, e.g., *Boston Athletic Ass’n v. Sullivan*, 867 F.2d 22 (1st Cir.1989) (identical nature of sales outlets and advertising methods supported a finding of infringement) Thus, dissimilarities between the retail outlets for and the predominant customers of plaintiff’s and defendant’s goods lessen the possibility of confusion, mistake or deception. *Ross Bicycles, Inc. v. East Coast Cycles, Inc.*, 224 U.S.P.Q. 725, 728 (N.D.Fla.1984), aff’d 765 F.2d 1502 (11th Cir.1985), cert. denied 475 U.S. 1013 (1986). Accordingly, similar marks used on goods sold through single-brand distributors may be less confusing than when used on goods sold through multi-brand stores, and goods sold only at discount outlets might not be confused with goods sold only in specialty shops.

Even when the marks are used in the same venues, a proper likelihood of confusion analysis will consider goods sold in different departments and targeted at different purchasers.²²³ A likelihood of confusion analysis can narrow the focus of the marketplace to particular areas where the goods are sold, or where two marks may overlap—for example, exclusive distributorship, which in turn sells to the public exclusively through boutique/specialty stores can be overlapped with a mass marketed product sold through specialty shops, discount stores, drug stores, and other retail outlets.²²⁴ When sold in the same stores, competing products with similar trade dress may easily be confused if proximately located or actually intermixed; the consumer may not even realize the opportunity for comparison and differentiation.²²⁵ On the other hand, it has become a common practice for retailers to shelve national brand products side-by-side with private brands having similar packaging features.²²⁶

The analysis looks at trade channels specifically enough that a likelihood of confusion may be found even on non-competing goods. Targeting of a relatively narrow universe of potential purchasers through a specific trade channel may lead to confusion even if the goods do not compete.²²⁷ Conversely, likelihood of confusion has been avoided where the senior and junior marks appear on products sold in professional, wholesale or industrial channels as opposed to ordinary consumer retail channels.²²⁸

²²³ *Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960 (2d Cir. 1981). There is no rule that separation avoids confusion. Rather, the degree of physical proximity between two products in different sections of the same stores is relevant only to the extent it involves the consumer's reliance on memory or affects the consumer's perceptions of the relatedness of the products. *Plus Prods. v. Plus Disc. Foods, Inc.*, 722 F.2d 999 (2d Cir. 1983). *Helene Curtis Indus., Inc. v. Suave Shoe Corp.*, 13 U.S.P.Q.2d 1618, 1624 n.30 (T.T.A.B. 1989). (“The crucial question here is whether source confusion is likely. As to that, whether or not the goods are displayed close together or far apart in the same store is immaterial.”).

²²⁴ *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 487 (1st Cir. 1981).

²²⁵ *Roulo v. Russ Berrie & Co.*, 886 F.2d 931 (7th Cir. 1989); *Storck USA, L.P. v. Farley Candy Co.*, 785 F. Supp. 730 (N.D. Ill. 1992); *P.T.C. Brands, Inc. v. Conwood Co., L.P.*, 28 U.S.P.Q.2d 1895, 1904 (W.D. Ky. 1993); see *Ty, Inc. v. Jones Group*, 237 F.3d 891, 900-01 (7th Cir. 2001).

²²⁶ *Conopco, Inc. v. May Dep't Stores Co.*, 32 U.S.P.Q.2d 1225, 1231 (Fed. Cir. 1994); cf. *Kroger Co. v. Johnson & Johnson*, 570 F. Supp. 1055 (S.D. Ohio 1983); cf. *Gray v. Meijer Inc.*, 295 F.3d 641, 650 (6th Cir. 2002) (no confusion; store brands grouped separately from independent brands, albeit in the “same basic area” of the store).

²²⁷ See *Marathon Mfg. Co. v. Enerlite Prods. Corp.*, 767 F.2d 214, 226 U.S.P.Q. 836, 839 (5th Cir. 1985) (restricted market, very similar marks).

²²⁸ *Am. Cyanamid Co. v. S.C. Johnson & Son, Inc.*, 729 F. Supp. 1018 (D.N.J. 1989) (insecticide sold at retail and to exterminators); *In re Shipp*, 4 U.S.P.Q.2d 1174, 1176 (T.T.A.B. 1987) (retail dry cleaning services and commercial dry cleaning machine filters).

The channels may be such that the only persons in a position to confuse the marks would be those familiar with one mark in their trade or industry that happen to encounter the other mark in their business or perhaps when doing their personal retail shopping. Such persons may be relatively sophisticated (at least as to the industrial goods) and less likely to be confused.²²⁹

4. Examiners routinely consider the consumer base in a likelihood of confusion analysis.

The likelihood of confusion analysis considers the level of sophistication of the targeted consumer base, as well. Examining attorneys consider consumers' sophistication relative to relevant trade channels; the analysis recognizes that people who are sophisticated purchasers of a product in one trade channel may be ordinary consumers of a product in another channel.²³⁰ The fact that a product or service is expensive, or sold to a more specialized group of consumers, does not necessarily mean that such "sophisticated" consumers are immune to confusion.²³¹ When products may be purchased by both sophisticated and unsophisticated consumers, the examining attorney will likely look at the group of consumers that is least sophisticated and base the decision of the examination of the potential of likelihood of confusion in that group.²³² Circumstances indicating that consumers would exercise care when purchasing relevant goods tend to minimize the likelihood of confusion.²³³

The appropriate consumer base is considered in conjunction with relevant trade channels. As such, it may include people who are not

²²⁹ *In re Shipp*, 4 U.S.P.Q.2d 1174, 1176 (T.T.A.B. 1987).

²³⁰ However, an applicant may not restrict the scope of the goods covered in the cited registration; rather, trademark owners are limited to the identification of goods and services contained in the application. *In Re Davey Products Pty Ltd.*, 92 U.S.P.Q.2d 1198 (P.T.O. Aug. 7, 2009) (citing *In re Peregrina Ltd.*, 86 USPQ2d at 1646) (finding that "it is the identification of goods that controls, not what extrinsic evidence may show about the specific nature of the goods... an applicant may not restrict the scope of the goods covered in the cited registration by argument or extrinsic evidence.").

²³¹ See *In Re Davey Products Pty Ltd.*, 92 U.S.P.Q.2d 1198 (P.T.O. Aug. 7, 2009); *In Re Toshiba Med. Sys. Corp.*, 91 U.S.P.Q.2d 1266 (P.T.O. June 18, 2009); *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir.)

²³² *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 110 USPQ2d 1157 (Fed. Cir. 2014); see also *Gen. Mills, Inc. v. Fage Dairy Proc. Indus. S.A.*, 100 U.S.P.Q.2d 1584, 1600 (T.T.A.B. 2011), judgment set aside on other grounds, 2014 WL 343267 (T.T.A.B. Jan. 22, 2014); cf. *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 293 (3d Cir. 1991) (stating, in the context of a trademark infringement case, that "when a buyer class is mixed, the standard of care to be exercised by the reasonably prudent purchaser will be equal to that of the least sophisticated consumer in the class").

²³³ *In re Home Vinyl Prods., Inc.* 81 USPQ2d 1378, 1380.

targeted by the trademark owner but who are exposed to the mark in question. For example, in *Stone Lion Capital Partners, LP*, the examining attorney found even though the company providing financial services targeted only sophisticated investors, unsophisticated consumers seeking financial advice would also likely be exposed to the trademark.²³⁴ In another case, the Federal Circuit found a high level of sophistication where medical products would be purchased only in consultation with anesthesiologists or other professionals with technical knowledge.²³⁵

B. Other bases for refusal regularly consider contextual factors throughout the registration process.

Contextual factors are key to the application of other registration bars, as well, including, *inter alia*, descriptiveness, genericism, and functionality. Trademarks are typically evaluated with reference to the goods and services at issue. As a baseline, trademarks must be distinctive; distinctiveness is measured by evaluating the mark with in relation to the specific goods or services listed in the application.²³⁶ Marks that are merely descriptive of the goods or services thus cannot be registered on the principal register absent a showing of secondary meaning, which is evaluated pursuant to further contextual information—what is in the minds of consumers.²³⁷ The determination of whether a mark is merely descriptive must be made in relation to the goods or services, not in the abstract; “[t]his requires consideration of the context in which the mark is used or intended to be used in connection with those goods/services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace.”²³⁸

²³⁴ *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 1320 (Fed. Cir. 2014). The Federal Circuit held that because the services could be “consumed” by sophisticated and unsophisticated consumers alike, the TTAB correctly found likelihood of confusion.

²³⁵ *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985).

²³⁶ 15 U.S.C. § 1052 (“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . (e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them . . .”); TMEP § 1209.01 (citing *Remington Products, Inc. v. North American Philips Corp.*, 892 F.2d 1576, 1580, 13 U.S.P.Q.2d 1444, 1448 (Fed. Cir. 1990).

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

²³⁸ TMEP §1209.01(b) (citing, generally, *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 U.S.P.Q.2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 U.S.P.Q. 215 (C.C.P.A. 1978); *In re Venture Lending Associates*, 226 U.S.P.Q. 285 (T.T.A.B. 1985).

Like a merely descriptive mark, a generic mark cannot be registered because it fails to function as a trademark.²³⁹ The two-part test to determine whether or not a trademark is generic is a contextual one. It looks at the class of goods or services at issue, and asks whether the relevant public understands the designation primarily to refer to that class of goods or services.²⁴⁰ Marks cannot be registered at all if they are found to be generic. Generic terms are understood by the relevant purchasing public to be the common or categorical name for the goods or services.²⁴¹

Functional elements cannot be protected as a trademark or as trade dress. Like the other bases for refusal of registration, the test for functionality is highly based on contextual factors. A proper assessment of functionality includes evidence both within and beyond the trademark application. A mark will be functional where it is “essential to the use or purpose of the product or if it affects the cost or quality of the device.”²⁴² The examining attorney must establish a *prima facie* case for functionality, which then can be rebutted by the applicant.²⁴³ Contextual evidence is key, and may include: (1) the existence of a utility patent whose claims cover the features sought to be registered; (2) promotional material touting the utilitarian advantages of the design; (3) availability of alternative designs for competitors; and (4) whether the design is comparatively simple, efficient, or inexpensive.²⁴⁴ Context is so important to the functionality analysis that examining attorneys are instructed not just to examine the specimen(s) submitted by the applicant, but to ask the applicant to submit contextual information outside the application,²⁴⁵ and to conduct

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

²⁴⁰ TMEP §1209.01(c)(1) (citing *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 U.S.P.Q. 528, 530 (Fed. Cir. 1986).

²⁴¹ TMEP 1209.01(c) (noting that “Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services.”) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 U.S.P.Q.2d 1807, 1811 (Fed. Cir. 2001)).

²⁴² *TraffFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 33 58 U.S.P.Q.2d 1001, 1006 (2001).

²⁴³ TMEP § 1202.02(a)(iv) (citing *Textron, Inc. v. U.S. Int'l Trade Comm'n*, 753 F.2d 1019, 1025, 224 U.S.P.Q. 625, 629 (Fed. Cir. 1985).

²⁴⁴ *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 1340-41, 231 U.S.P.Q. 9, 15-16 (C.C.P.A. 1982); *see also* TMEP § 1202.02(a)(v).

²⁴⁵ TMEP § 1202.02(a)(v) (stating that “the examining attorney should: (1) ask the applicant to provide copies of any patent(s) or any pending or abandoned patent

independent research to find advertising or promotional material.²⁴⁶

C. Like other bases for refusal of registration, the bar to registration of scandalous marks should consider contextual factors.

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

VI. CONTEXT IN OTHER FORMS OF CONTENT REGULATION

Consideration of context for scandalous marks would be consistent with other forms of content regulation. The Federal Communications Commission (FCC), for example, has moved toward consideration of context in its broadcast regulations. The FCC regulation of broadcast content has been often criticized by popular culture and in the media, perhaps best known through George Carlin's 1972 monologue "Filthy Words."²⁴⁷ However, even within these oft-criticized regulations there is a move away from a categorical judgment based on the "seven words" and toward some consideration of the general context and market for the broadcast content. Furthermore, the Supreme Court and the FCC have very clearly stated that the appropriate community for assessing whether something is patently offensive is the context of the specific broadcast and market, rather than in the abstract.

application(s); (2) ask the applicant to provide any available advertising, promotional, or explanatory material concerning the goods/services; (3) inquire of the applicant whether alternative designs are available; and (4) inquire whether the feature makes the product easier or cheaper to manufacture.")

²⁴⁶ TMEP § 1202.02(a)(v)

²⁴⁷ George Carlin, "Filthy Words," available at <https://www.youtube.com/watch?v=FMkNsMMvrqk> (last visited Feb. 20, 2016); transcript available at <http://law2.umkc.edu/faculty/projects/trials/conlaw/filthywords.html> (last visited Feb. 20, 2016). The words are: shit; piss; fuck; cunt; cocksucker; motherfucker; and tits.

A. History of Regulation of Broadcast Content and Morality

The FCC regulates broadcast content based on both obscenity and indecency. The FCC has separate categories for each of these types of content; obscenity is flatly prohibited while indecency is regulated.²⁴⁸ Indecent broadcasts, which contain content that would be subject to a 2(a) rejection for scandalousness or immorality if contained in a trademark, are statutorily permitted between the hours of 10 p.m. and 6 a.m.²⁴⁹ Obscene material, on the other hand, is subject to a three-pronged test in an effort to determine whether the material is of a prurient nature and lacking in literary, artistic, political, or scientific value.²⁵⁰

When determining indecency, the focus is mainly on the material's effect on children and whether the material is patently offensive.²⁵¹ In both cases, when determining if material is prurient or patently offensive the proper standard is that of the "contemporary community" which is non-geographical and includes the average broadcast viewer or listener.²⁵²

1. There has consistently been an increase on the use of context to determine regulation of broadcast content based on offensiveness.

Although a general definition of indecency was adopted a few years

²⁴⁸ Federal Communications Commission, Obscene, Indecent and Profane Broadcasts, available at <http://www.fcc.gov/guides/obscenity-indecency-and-profanity> (last visited Feb. 20, 2016); Federal Communications Commission, Regulation of Obscenity, Indecency and Profanity, available at <http://transition.fcc.gov/eb/oip/> (last visited Feb. 20, 2016); Electronic Code of Federal Regulations, 47 CFR §73.3999 Enforcement of 18 U.S.C. 1464 (restrictions on the transmission of obscene and indecent material), available at http://www.ecfr.gov/cgi-bin/text-idx?SID=165cbc448a8d5b1e86642868727b791f&node=se47.4.73_13999&rgn=div8 ("(a) No licensee of a radio or television broadcast station shall broadcast any material which is obscene. (b) No licensee of a radio or television broadcast station shall broadcast on any day between 6 a.m. and 10 p.m. any material which is indecent." [60 FR 44439, Aug. 28, 1995]).

²⁴⁹ *Id.*

²⁵⁰ *Id.*; Obscene Language, 47 CFR §73.4165, available at http://www.ecfr.gov/cgi-bin/text-idx?SID=165cbc448a8d5b1e86642868727b791f&node=se47.4.73_14165&rgn=div8 (last visited Feb. 20, 2016).

²⁵¹ *Id.*

²⁵² *Id.*

before, the standard for regulation of morality in broadcast content was established in 1978.²⁵³ The *Pacifica* standard focused on the legendary “seven words” and a prohibition on indecent content between the hours of 6:00 a.m. and 10:00 p.m.²⁵⁴ A decade later, the FCC determined that this interpretation of the *Pacifica* standard was too narrow and needed to accommodate contextual considerations.²⁵⁵ The FCC reiterated the original indecency standard: “language that describes in terms patently offensive as measured by contemporary community standards for the broadcast medium, sexual or excretory activities and organs.”²⁵⁶ The FCC also emphasized that the focus was on impact on children and repetition of expletives, indicating that fleeting or isolated use weighed against—but did not prohibit—a finding of indecency.²⁵⁷ In 2001, the FCC issued a policy statement clarifying the indecency standard and stating a factor test for determining if something is indecent.²⁵⁸ The three main factors, though these are non-exhaustive and the FCC or courts may take into account other factors, are: (1) explicitness or graphic nature of the description or depiction; (2) whether it dwells on or repeats descriptions; (3) whether material appears to pander or is used to titillate, or whether material appears to be presented for shock value.²⁵⁹ The focus is on the contextual meaning; innuendo and double entendres can be indecent if the meaning is clear and unmistakable.²⁶⁰ Toward that end, the FCC reiterated that fleeting or isolated use would weigh against a finding of indecency, but would not preclude it.²⁶¹

²⁵³ *FCC v. Pacifica*, 438 U.S. 726 (1978) (holding that the government can constitutionally regulate indecent broadcasts, and providing the foundation for FCC enforcement of indecent material).

²⁵⁴ *Id.*

²⁵⁵ 56 FCC 2d. 94 (1975) (providing that the definition of indecent language is “language that describes in terms patently offensive as measured by contemporary community standards for the broadcast medium, sexual or excretory activities and organs.”)

²⁵⁶ *Id.*

²⁵⁷ The FCC also sought to do away with strict time periods, because children could still be exposed after 10 p.m. In 1995, in response to Congressional and Court rulings, the 10 p.m.-6 a.m. rule was reinstated and codified at 47 CFR § 73.3999.

²⁵⁸ 16 FCC Rcd. 7999 (2001).

²⁵⁹ *Id.* Under this standard, fleeting or single use would weigh against a finding of indecency, but may still be indecent where other factors contribute to a finding of patent offensiveness, such as broadcasting references to sexual activities with children and material that is graphic or explicit.

²⁶⁰ *Id.*

²⁶¹ See *Federal Communications Comm'n v. Fox Television Stations, Inc.*, 129 S.Ct. 1800 (2009).

In 2003 the FCC initially found that isolated use of the word “fuck” in a Golden Globes broadcast, because it was used as an expletive rather than descriptor of sex, and because the word was isolated rather than repeated, was not indecent. In 2004 the FCC

Overall the definitions of what is indecent or obscene have not changed but enforcement has become broader.²⁶² The focus in enforcement is primarily on protecting children but context is key.²⁶³ The analysis includes

appeals panel overturned that ruling that “fuck” was “one of the most vulgar, graphic and explicit descriptions of sexual activity in the English language” and “any use of that word or a variation, in any context, inherently has a sexual connotation” and stating that isolated use of a word does not preclude a finding of indecency. This removed the requirement that a broadcast must dwell on or repeat an expletive in order to be found indecent. 18 FCC Rcd 19859.

²⁶² The MPAA, on the other hand, does appear to have altered what it determines to meet each category over time. Harvard published a report in 2004 indicating “ratings creep” and that, over the previous decade, the amount of sex and violence permitted in lower ratings categories had increased. Violence appears to be the primary beneficiary, lower ratings having larger amounts of violence than before, while sex and sexual references are still considered more scandalous and more likely to garner a higher rating (though still more acceptable at lower ratings than previously). 19 FCC Rcd. 4975.

The ESRB has seen a similar shift in what is acceptable for different levels of ratings though to a lesser extent than the MPAA. For example, blood was previously not allowed in the “Teen” category but now is permitted so long as it is static and not gratuitous. However, the ESRB also acknowledges that, though it has shifted what is acceptable based on contemporary views, violence is more acceptable than sex as far as ratings. The TV Parental Guidance system is actually done by the broadcasters themselves resulting in inconsistencies in application. Interestingly, in the TV case it appears that ratings have increased due to a decrease in the stigma of a show with a higher rating. However with no centralized ratings board it is hard to say if there has been a shift in what falls under which category. Entertainment Software Ratings Board, Ratings Guide, available at http://www.esrb.org/ratings/ratings_guide.jsp (last visited Feb. 20, 2016); see also Heather Newman, Twenty Years of ESRB: More Blood, Less Hassle for Developers (Interview), VentureBeat (Sept. 16, 2014) at <http://venturebeat.com/2014/09/16/twenty-years-of-esrb-more-blood-less-hassle-for-developers-interview/> (last visited Feb. 20, 2016); Kyle Orland, 20 Years, 20 Questionable Game Ratings: A Timeline of ESRB Oddities, ArsTechnica (Sept. 20, 2014) at <http://arstechnica.com/gaming/2014/09/20-years-20-questionable-game-ratings-a-timeline-of-esrb-oddities/> (last visited Feb. 20, 2016); Matt Matthews, This Game In Not Yet Rated: Inside the Ratings System for the ESRB, Gamasutra: The Art and Business of Making Games, at http://www.gamasutra.com/view/feature/130387/this_game_is_not_yet_rated_inside_.php?print=1 (describing the ratings process and how context is taken into account) (last visited Feb. 20, 2016).

²⁶³ See *FCC v. Pacifica Foundation*, 438 U.S. 726, 57 L.Ed 2d 1073, 46 U.S.L.W. 5018 (1978); *Action for Children's Television v. FCC*, 852 F.2d 1332 (D.C. Cir. 1988); *Action for Children's Television v. FCC*, [ACT III] 11 F.3d 170 (D.C. Cir. 1993); *Action for Children's Television v. FCC*, [ACT IV] 15 F.3d 186 (D.C. Cir. 1994) (noting that safe harbor is 10:00 p.m.-6:00 a.m. because there is no relationship between the distinction of commercial v. noncommercial stations and the compelling gov’t interest); see also Report and Order, GC Docket 92-223, FCC 93-42, adopted January 19, 1993. 8 FCC Rcd 704; 58 FR 5937, January 25, 1993. (mandating the different midnight to 6 am and 10-6 and overruled by *Action for Children's Television*); Memorandum Opinion and Order, FCC 93-

the time and place that the program is aired, the place of viewing, and the greater context of the broadcast, including the surrounding content.²⁶⁴

The Supreme Court has established that, to be obscene, material must meet a three-pronged test, based on contemporary community standards: (1) An average person, applying contemporary community standards, must find that the material, as a whole, appeals to the prurient interest; (2) the material must depict or describe, in a patently offensive way, sexual conduct specifically defined by applicable law; and (3) the material, taken as a whole, must lack serious literary, artistic, political or scientific value.²⁶⁵ The FCC has defined broadcast indecency as “language or material that, in context, depicts or describes, in terms patently offensive as measured by contemporary community standards for the broadcast medium, sexual or excretory organs or activities.”²⁶⁶ Indecent programming contains patently offensive sexual or excretory material that does not rise to the level of obscenity.²⁶⁷ Courts have held that indecent material is protected by the First Amendment and cannot be banned entirely.²⁶⁸ It may, however, be

²⁴⁶, adopted May 11, 1993, 8 FCC Rcd 3600 (noting that audience poll not enough to demonstrate lack of child audience because broadcast was outside new safe harbor limits); Letter to Rusk Corporation (May 6, 1993), FCC 93-229, 8 FCC Rcd 3228 (arguing that the prevalence of sexual content doesn’t make the content less indecent, because rules are for protecting children and not about what adults consider decent for an adult audience).

²⁶⁴ Federal Communications Commission, Obscene, Indecent and Profane Broadcasts, available at <http://www.fcc.gov/guides/obscenity-indecency-and-profanity> (last visited Feb. 20, 2016); Federal Communications Commission, Regulation of Obscenity, Indecency and Profanity, available at <http://transition.fcc.gov/eb/oip/> (last visited Feb. 20, 2016); Electronic Code of Federal Regulations, 47 CFR §73.3999 Enforcement of 18 U.S.C. 1464 (restrictions on the transmission of obscene and indecent material), available at http://www.ecfr.gov/cgi-bin/text-idx?SID=165cbc448a8d5b1e86642868727b791f&node=se47.4.73_13999&rgn=div8 (“(a) No licensee of a radio or television broadcast station shall broadcast any material which is obscene. (b) No licensee of a radio or television broadcast station shall broadcast on any day between 6 a.m. and 10 p.m. any material which is indecent.” [60 FR 44439, Aug. 28, 1995]).

²⁶⁵ *Miller v. California*, 413 U.S. 15 (1973) (redefining obscenity from the previous standard of “utterly without socially redeeming value” to something that lacks “serious literary, artistic, political, or scientific value.”).

²⁶⁶ Federal Communications Commission, Obscene, Indecent and Profane Broadcasts, available at <https://www.fcc.gov/consumers/guides/obscene-indecent-and-profane-broadcasts> (last visited Feb. 20, 2016).

²⁶⁷ *Id.*

²⁶⁸ *Cohen v. California*, 403 U.S. 15, 25 (1971) (finding indecent speech protected by the First Amendment and famously noting that it is “often true that one man’s vulgarity is another’s lyric.”)

restricted in order to avoid its broadcast during times of the day when there is a reasonable risk that children may be in the audience.²⁶⁹ Currently even a single utterance of an expletive (the seven words from Carlin have been stated as examples rather than an exhaustive list) can still be ruled indecent depending on the other context of the material. However, there is now a statutory safe harbor time between 10 p.m.-6 a.m.²⁷⁰ The FCC has defined profanity as “including language so grossly offensive to members of the public who actually hear it as to amount to a nuisance.”²⁷¹ In making obscenity, indecency and profanity determinations, context is key. The FCC staff must analyze what was actually aired, the meaning of what was aired and the context in which it was aired.²⁷²

CONCLUSION

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

However, while the bar is in effect, it should be applied in a way that is fair and effective within the legal framework of trademark law. *In re Mavety Media* indicates that scandalousness should be evaluated in the context of the current attitudes of the day and the marketplace identified in the application. However, if the particular mark contains words that are listed as “vulgar” in the dictionary, that is sufficient for a 2(a) rejection. Examining attorneys are given these general guidelines, but they are not

²⁶⁹ *Federal Communications Commission v. Pacifica Foundation*, 438 U.S. 726 (1978); *Bethel Sch'l District v. Fraser*, 478 U.S. 675 (1986).

²⁷⁰ Electronic Code of Federal Regulations, 47 CFR §73.3999 Enforcement of 18 U.S.C. 1464 (restrictions on the transmission of obscene and indecent material), available at http://www.ecfr.gov/cgi-bin/text-idx?SID=165cbc448a8d5b1e86642868727b791f&node=se47.4.73_13999&rgn=div8 (“(a) No licensee of a radio or television broadcast station shall broadcast any material which is obscene. (b) No licensee of a radio or television broadcast station shall broadcast on any day between 6 a.m. and 10 p.m. any material which is indecent.” [60 FR 44439, Aug. 28, 1995]).

²⁷¹ Federal Communications Commission, Obscene, Indecent and Profane Broadcasts, *supra* note ____.

²⁷² *Id.*

very helpful in practical terms. Examining attorneys should treat a 2(a) question based on scandalousness or immorality the same way they treat most other issues in trademark law: through an assessment of the mark in the context of the marketplace. This would be consistent with other bars to registration found in the Lanham Act, and forms of content regulation in broadcast media.