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Stabilizing Morality in Trademark Law

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Stabilizing Morality in Trademark Law

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STABILIZING MORALITY IN TRADEMARK LAW

CHRISTINE HAIGHT FARLEY*

Almost all of the commentary concerning the statutory prohibition on registering offensive trademarks lambasts it as a misguided attempt to enforce civility through trademark law. This Article carefully considers the challenges accompanying section 2(a) of the U.S. Trademark Act and defends it as good policy. There are, however, a few instances in which the jurisprudence under section 2(a) has created more problems than it has solved. To alleviate these problems, this Article proposes judging words per se and abandoning the traditional trademark notion of evaluating words in context. Judging words per se is warranted given the very different objectives underlying section 2(a) as compared with the rest of the Trademark Act.

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INTRODUCTION

The regulation of morality in trademark law is one of those topics that generates more law review articles than cases. Recently, however, three cases have renewed interest in this area of law and highlighted its challenges. The first case is the well-known dispute over the REDSKINS trademark. This case has been actively litigated since 1992 with decisions from the Trademark Trial and Appeal Board (TTAB) and the U.S. Court of Appeals for the D.C. Circuit. The parties are currently awaiting a new decision from the TTAB, which should be imminent. Although the TTAB had previously determined that the mark was disparaging to Native Americans, this ruling was overturned on appeal. The district court, affirmed by the court of appeals, held that the claim was barred by laches. The current case, in which the petitioners have just reached the age of majority, seeks to avoid this holding. The second case involved the mark COCK SUCKER and was recently decided by the U.S. Court of Appeals for the Federal Circuit. The court found the mark "scandalous" and unregistrable. The third case is currently on appeal to the Federal Circuit and involves the mark THE SLANTS. The court will determine whether the mark as applied to an Asian-American band is disparaging.

In addition to testing the "morality bars" of the Trademark Act of 1946 (Lanham Act), these cases share a fundamental question about how this law should be applied. In each case, it is suggested that when looking beyond the words to the context of the mark's use, the offensiveness of the word is either diminished or disappears. So the word "redskins" when applied to a professional football team becomes simply a name for the team due to strong secondary meaning. For the public, the racial meaning of the word disappears in this context, it is argued. In the second case, although the words "cock sucker" have a clear vulgar meaning, the trademark applicant argued that her commercial use of the words on rooster-shaped lollipops conveyed another, non-vulgar meaning. Moreover, the applicant marketed these lollipops to fans of the University of South Carolina Gamecocks. Finally, the pending case over the mark THE SLANTS involves the same argument, although it is not advanced by the applicant. Instead, the U.S. Patent and Trademark Office (USPTO), after learning that the applicant band is Asian and the band's music explores Asian stereotypes, concluded that in such a context, the mark would be disparaging.

The proposal to evaluate marks in context is not only intuitive and logical, it is also consistent with the current doctrine in this area. And this doctrine is consistent with the rest of trademark law. That is,

when a mark is evaluated for almost any issue in trademark law, it should be evaluated in the full context of its commercial use. The rationale is that the law should be applied in a manner that best protects consumers, and the relevant consumer will encounter marks in the marketplace, not in the abstract.

The many law review articles written about this area of law are surprisingly consistent. Each of the authors criticizes the effort to regulate the morality of trademark. The prospect of regulating morality obviously raises concern about the exercise of unrestrained subjectivity. The decisions in this area support this critique since, in contrast to the law review articles, they appear utterly inconsistent. For example, while *COCK SUCKER* was refused registration, another application for *GAMECOCK SUCKER* was not only registered, but the issue of scandalousness was not even raised. And while the TTAB refused registration for *THE SLANTS*, finding the mark disparaging, it permitted the registration of the mark *DYKES ON BIKES*, applied for by a lesbian motorcycle group.

This Article seeks to go against the grain in unabashedly defending section 2(a) of the Lanham Act. The thesis of this Article, in addition to risking accusations of being prudish or lacking proper respect for the Constitution, is certain to raise ire. This Article argues that we need a radical new approach to determine the morality of trademarks. What we need is in fact to de-contextualize marks for the purpose of a section 2(a) analysis. This proposal not only goes against what is natural for English speakers—performing semiotic analysis on language—but it is also at variance with the general approach in trademark law. Nevertheless, this new approach is preferable because (1) it will better fulfill the objectives of the law; (2) it will produce more consistent results; and (3) it will be a more manageable task for the USPTO.

Part I of this Article explains why this law is good policy. Part II describes how moralistic determinations are made in context. Part III argues that a *per se* say approach to these determinations is preferable and will highlight why marks that include words denoting race and religion are better served by this approach. Part IV shows how unrestrained contextualization can lead to trouble in evaluating marks that contain religious words. Part V demonstrates that the reason for the inconsistency in the application of this law is precisely because of the approach of contextualizing marks. Part VI critiques the rule that the morality of marks should be evaluated in the context of the date of application, rather than the date of the challenge. And finally, Part VII addresses the difficulty of evaluating marks that

contain offensive words that are being reclaimed by the groups that have historically been disparaged by them. These determinations should not ride on who is speaking, but rather on how successful these groups have been reclaiming disparaging words. The Article concludes that trademark law's regulation of morality is not misguided, but its approach is.

I. SECTION 2(A): THE RIGHT POLICY FOR THE PROBLEM

Consumers are barraged by offensive marks and marketing practices. In an era of information overload, merchants often resort to extremes in order to grab consumers' attention. Recent news stories suggest that risqué brand names are a current phenomenon.¹ These stories highlight cereals called "Holy Crap," large fans called "Big Ass Fans," wines called "Sassy Bitch," and breakfast restaurants called "Eggslut."² According to these reports, profanity pays.

A search of the USPTO database reveals an alarming number of offensive trademark applications and registrations. For instance, there is currently a registration for SLUTMAGNET for shirts and musical group entertainment services³ and registration applications for WHITE TRASH for trash bags,⁴ I EAT PUSSY WITH A FORK for T-shirts,⁵ SHANK THE B!T@H for board games,⁶ DEGO for tequila,⁷ and WILD INJUN for "plastic frame assembly for holding a ballcap when washed in a washing machine or dishwasher."⁸

Should the USPTO permit federal registration of such offensive trademarks? Should it protect the public in some way from highly offensive or racist trademarks? Does prohibiting registration of offensive marks amount to censorship? Who is the USPTO to judge morality? These questions spur difficult policy choices, administrative decisions, and obvious challenges.

Perhaps surprisingly, the Trademark Act of 1946⁹ (Lanham Act) contains a provision addressing the morality of trademarks. In section

1. E.g., David Boyle, *For Fcuk's Sake—Brands Are Swearing More than Ever*, *GUARDIAN* (Apr. 28, 2014, 8:06 AM), <http://www.theguardian.com/commentisfree/2014/apr/28/brands-swearing-marketing-social-media-advertisers>.

2. John Grossman, *Risqué Names Reap Rewards for Some Companies*, *N.Y. TIMES* (Apr. 23, 2014), http://www.nytimes.com/2014/04/24/business/smallbusiness/risque-names-reap-rewards-for-some-companies.html?_r=0.

3. SLUTMAGNET, Registration No. 2,404,415.

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

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

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

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

8. U.S. Trademark Application Serial No. 75,627,642 (filed Jan. 26, 1999).

9. 15 U.S.C. §§ 1051–1141n (2012). The Act is also known as the Lanham Act after Fritz G. Lanham, a Texas congressman who introduced the Act in 1938 after

2(a) of the Lanham Act, Congress has explicitly forbidden registration for certain categories of marks including those that “[c]onsist[] of or comprise[] immoral . . . or scandalous matter; or matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”¹⁰

The dated words and difficult syntax are only the start of the challenges associated with administering this provision. The USPTO determines whether a trademark falls under section 2(a)’s purview, which involves tackling subtle questions of appropriate cultural sensitivity.¹¹ The examining attorneys in the USPTO ordinarily rely on the rules and standards in the Trademark Manual of Examining Procedure to guide them in making these determinations.¹² Differing sensitivity levels across varied public sectors, however, make determining the appropriate standard for judging immorality difficult. These determinations invite subjectivity¹³ and often result in

experiencing difficulty acquiring adequate protection for his and others’ trademarks. Beverly Patishall, *The Lanham Trademark Act at Fifty—Some History and Comment*, 86 TRADEMARK REP. 442, 442 (1996).

10. 15 U.S.C. § 1052(a). This Article refers to this list of prohibited matter in the shorthand of “immoral,” “scandalous,” or “disparaging” marks.

11. See *id.* (commanding that “[n]o trademark . . . shall be refused registration” unless certain conditions apply).

12. See U.S. PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE §§ 1203–1203.03 (Apr. 2014) [hereinafter TMEP]. “The [TMEP] contains guidelines for Examining Attorneys and materials in the nature of information and interpretation, and outlines the procedures which Examining Attorneys are required or authorized to follow in the examination of trademark applications.” *Id.* foreword. To determine whether a trademark violates section 2(a), examining attorneys must evaluate whether “a substantial portion of the general public would consider the mark to be scandalous in the context of contemporary attitudes and the relevant marketplace.” *Id.* § 1203.1; see also *id.* § 1203.03(b)(i) (requiring examining attorneys defending their decisions in an *ex parte* case to “make a prima facie showing that a substantial composite of the *referenced group*, . . . would find the proposed mark, as used on or in connection with the relevant goods or services, to be disparaging” (emphasis in original)).

To make this evaluation, the attorneys may only rely primarily on dictionary definitions, news and magazine articles, and blog posts. See *id.* § 1203.01 (permitting examining attorneys to gather evidence from “dictionary definitions, newspaper articles, and magazine articles” and prohibiting them from relying solely on earlier holdings on whether a term is scandalous); Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks that May Be Scandalous or Immoral*, 101 TRADEMARK REP. 1476, 1488, 1498–99 (2011) (noting that the USPTO relies heavily on dictionary evidence to determine whether terms are scandalous as well as news articles characterizing terms as “offensive, obscene, coarse, taboo, vulgar, . . . or crass”). This approach has been criticized as too limited because it does not include other methods of determining public attitudes, such as consumer surveys, expert witnesses, and affidavits. See, e.g., *id.* at 1488 (noting these limitations). When their decisions are challenged, examining attorneys can take the role of advocates presenting one-sided views of the evidence, requiring applicants to present their cases carefully and thoroughly. *Id.*

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

the application of different standards and, thus, widely inconsistent results. For these reasons, some have called the enforcement of section 2(a) “an impossible task.”¹⁴

Almost everything that has been written about the registration bars for immoral, scandalous, and disparaging trademarks under section 2(a) of the Lanham Act has been critical of the law.¹⁵ The multitudinous critics of these bars charge that they unconstitutionally restrict free expression,¹⁶ are unwarranted in an otherwise relatively value-neutral regulation of marketplace practice,¹⁷ introduce inherent subjectivity into registration determinations,¹⁸ and produce erratic and inconsistent results.¹⁹

Section 2(a)'s morality bars are, however, worth defending.²⁰ The United States has regulated the morality of marks for over a century.²¹

REV. 465, 468, 472 (2011) (recognizing that the content-based approach for determining what is scandalous or disparaging varies in each case and is highly subjective); *see also In re Mavety Media Grp.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994) (noting the “inherent difficulty in fashioning a single objective measure . . . from the myriad of subjective viewpoints,” as well as the added complication of evolving social attitudes).

14. LaLonde & Gilson, *supra* note 12, at 1476.

15. *See, e.g.,* Carpenter & Murphy, *supra* note 13, at 473–74 (noting that section 2(a)'s context-based application is unpredictable and, thus, ineffective because public sensibilities change depending on the context, time, and tribunal); LaLonde & Gilson, *supra* note 12, at 1487 (arguing that section 2(a)'s purpose is incompatible with the overall trademark protection scheme, which aims to protect consumers from deception and unfair trade practices); Michelle B. Lee, *Section 2(a) of the Lanham Act as a Restriction on Sports Team Names: Has Political Correctness Gone Too Far?*, 4 SPORTS LAW J. 65, 66 (1997) (raising a series of constitutional objections to section 2(a)); Regan Smith, *Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks*, 42 HARV. C.R.-C.L. L. REV. 451, 452 (2007) (contending that the bar on offensive trademarks violates the First Amendment); Marc Randazza, *Federal Circuit's COCKSUCKER Decision Sucks*, LEGAL SATYRICON (Dec. 20, 2012), <http://randazza.wordpress.com/2012/12/20/federal-circuits-cocksucker-decision-sucks> (condemning section 2(a) for the “unfettered discretion” it grants to trademark attorneys to deny registration for marks that are arguably protected by the First Amendment and for denying a government benefit on the basis of morality).

16. *See* Lee, *supra* note 15, at 66 (maintaining that section 2(a)'s prohibition is a “content-based regulation, which uses vague language, and is essentially unrelated” to the Trademark Act's purpose); Smith, *supra* note 15, at 467 (contending that courts should view trademark protection as commercial speech). This Article does not attempt to address the question of the constitutionality of section 2(a).

17. Carpenter & Murphy, *supra* note 13, at 467 (“[T]he consumer protection at the base of trademark policy is one of source quality, not moral quality.”).

18. *See id.* at 468, 472 (adding that there is insufficient precedent to guide courts in applying already “vague” and “highly subjective” guidelines).

19. *See, e.g.,* LaLonde & Gilson, *supra* note 12, at 1477 (attributing the inconsistent determinations to the lack of independent standards applied by individuals of varying demographics and the USPTO's refusal to use prior decisions as precedent).

20. *See* Christine Haight Farley, *Registering Offense: The Prohibition of Slurs as Trademarks, in PROTECTING AND PROMOTING DIVERSITY WITH INTELLECTUAL PROPERTY LAW* (Irene Calboli & Srividhya Ragavan, eds., forthcoming 2014) (arguing that section 2(a) fulfills a limited but important policy goal in promoting standards of civility).

Moreover, section 2(a) is consistent with international law²² and mirrors both state law²³ and the trademark laws of most European nations.²⁴ Accordingly, section 2(a) is not a puritanical relic²⁵ but a common feature of modern trademark law.

The public policy underlying these bars is self-evident. Although the legislative history of section 2(a) is scant,²⁶ the language of the provision reveals its purpose: it seeks to encourage civility by denying the benefits of federal registration to marks that cause deep offense to a significant portion of the public.²⁷ This policy goal is as worthy of

21. Congress first implemented the bar to registering “immoral” or “scandalous” marks in 1905. See Trademark Act of 1905, § 5, 33 Stat. 724, 725. Congress discussed prohibiting the registration of “disparag[ing]” marks as early as 1939. See *Trademarks: Hearing on H.R. 4744 Before the Subcomm. on Trade-marks of the H. Comm. on Patents*, 76th Cong. 18–21 (1939) [hereinafter *H.R. 4744 Hearings*] (statement of Leslie Frazer, Asst. Comm’r of Patents). The Trademark Act continues to regulate the registration of such marks. See 15 U.S.C. § 1052(a) (2012). Other areas of intellectual property law have addressed morality standards. U.S. design patents are subject to similar regulations as trademarks. According to the USPTO’s guide to filing a design patent application, any “matter that could be considered offensive to any race, religion, sex, ethnic group, or nationality is not proper subject matter for a design patent application.” See *Design Patent Application Guide*, U.S. PAT. & TRADEMARK OFF., <http://www.uspto.gov/patents/resources/types/designapp.jsp#improper> (last visited May 19, 2014). Although the doctrine of “moral utility” used to guide courts in patent law subject matter considerations, this doctrine fell out of use after 1977. Cynthia M. Ho, *Splicing Morality and Patent Law: Issues Arising from Mixing Mice and Men*, 2 WASH. U. J.L. & POL’Y 247, 249 (2000). In copyright law, protection had been unavailable to pornography until 1979. In *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852 (5th Cir. 1979), the court held that the copyright act neither explicitly nor implicitly prohibits the protection of obscene materials. *Id.* at 854–55, 858.

22. See Paris Convention for the Protection of Industrial Property, art. 6quinquies, Mar. 20, 1883, revised July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305 [hereinafter *Paris Convention*] (permitting member states to deny the registration marks that are “contrary to morality or public order”). One hundred and seventy-five countries have ratified the Paris Convention. *WIPO Administered Treaties: Statistics for the Paris Convention for the Protection of Industrial Property*, WORLD INTELL. PROP. ORG., http://www.wipo.int/treaties/en/StatsResults.jsp?treaty_id=2&lang=en (last visited May 19, 2014).

23. LaLonde & Gilson, *supra* note 12, at 1477 (reporting that every state except Colorado, Maine, and Wisconsin follows the exact “scandalous or immoral” language contained in the Trademark Act).

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

25. See, e.g., Ron Phillips, *A Case for Scandal and Immorality: Proposing Thin Protection of Controversial Trademarks*, 17 U. BALT. INTELL. PROP. L.J. 55, 57 (2008) (suggesting how the creation of section 2(a) in the 1905 Trademark Act may reflect “post-Victorian sensibilities” and a growing desire to regulate marks that were “offensive to public sentiment or morals”).

26. See 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, 233 (2005) (“Because there is little legislative history explaining Congress’s intention in enacting section 2(a), courts will have to speculate as to Congress’s intent based on the text and purpose of the statute.”).

27. See Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661, 788 (1993)

promotion today as it was when Congress first enacted section 2(a). Indeed, the current barrage of offensive trademark applications²⁸ may make it more necessary today than ever before.

There is simply no way to fulfill the purposes of section 2(a) other than to make moralistic determinations. There can be no other objective of the provision than to protect the public from offensive marks.²⁹ If jurists shy away from this duty, then it is preferable to repeal section 2(a).

There is no international treaty obligation for a country to adopt such bars to immoral, deceptive, or scandalous trademark registrations. The Paris Convention, for example, states only that prohibitions of this type are permitted; they are certainly not mandated.³⁰ Although section 2(a) is consistent with the trademark laws of other countries,³¹ no international disharmony would result if the United States permitted the registration of offensive marks. Maintaining a morality bar to registration is therefore a choice that the U.S. government freely exercises. So long as the choice has been made, the law ought to be enforced, and it ought to be enforced in a straightforward and predictable manner.

II. CONTEXTUALIZING MARKS

In response to section 2(a)'s overtly moralistic pronouncement, jurists³² have sought to evade the very issues the law aspires to address. In treating these issues like garden-variety trademark disputes and framing them within the regular precepts of trademark law, jurists have sought to minimize their moral judgments. Specifically, jurists analyze proposed marks in light of the commercial context in which the mark will be used to determine the mark's morality.³³ Contextualizing marks is routine in trademark law; it is

(justifying the bar by arguing that the federal government should protect the sensitivities of those "who might be offended by the use of scandalous, immoral, and disparaging trademarks").

28. See, e.g., LaLonde & Gilson, *supra* note 12, at 1540-45 (indexing various rejected trademarks, such as CUMFIESTA, A-HOLE PATROL, SEX ROD, W.B. WIFE BEATER, and THE BEARDED CLAM).

29. See *supra* note 27 and accompanying text; see also H.R. 4744 Hearings, *supra* note 21 (Statement of Leslie Frazer, Asst. Comm'r of Patents) ("[T]he use of this word [disparage] in this context is going to cause a great deal of difficulty in the Patent Office, because . . . it is always going to be just a matter of the personal opinion of the individual parties as to whether they think [the mark] is disparaging.").

30. Paris Convention, *supra* note 22, at art. 6.

31. See *supra* notes 21-25 and accompanying text.

32. This Article uses the term "jurists" to refer to federal judges who decide these cases as well as TTAB judges and USPTO examining attorneys.

33. See, e.g., *In re Riverbank Canning Co.*, 95 F.2d 327, 328-29 (C.C.P.A. 1928) (declining to approve registration for the commercial use of the Virgin Mary's name

done with almost every other trademark issue. In section 2(a) determinations, however, assessing these marks in light of the goods on which they will be used provides jurists a way to envelop their moral judgments within traditional trademark analysis.

Thus, examining attorneys and courts have fairly consistently refused to find marks *per se* offensive under section 2(a).³⁴ Instead, jurists determine whether a mark is immoral, scandalous, or disparaging in the context of the relevant marketplace for the goods or services identified in the application.³⁵ Consequently, jurists evaluate marks for their offensiveness in the context of their expected commercial use.³⁶

Under this doctrine, the issue is not whether a word is offensive in the abstract (or “*per se*”), but rather whether it is offensive when used as a trademark for particular goods or services to which the mark is applied.³⁷ The litigation surrounding the REDSKINS trademark is the most prominent controversy in this area and provides a useful

on wine bottles because it would be “shocking” to many people); *Doughboy Indus., Inc. v. Reese Chem. Co.*, 88 U.S.P.Q. (BNA) 227, 227–28 (P.T.O. 1951) (finding the mark DOUGH-BOY combined with a depiction of a U.S. Soldier scandalous and disparaging when used as a “prevention of venereal diseases” but not when used for food).

34. See, e.g., *In re Heeb Media, LLC*, 89 U.S.P.Q.2d (BNA) 1071, 1072 (T.T.A.B. Nov. 26, 2008) (“We ultimately must determine how the [mark] will be perceived in connection with the goods and services listed in this application.”); see also *Riverbank Canning Co.*, 95 F.2d at 328 (reasoning that while the word “Madonna” is not *per se* scandalous, a mark need not be *per se* scandalous to be prohibited by the statute); *Doughboy Indus.*, 88 U.S.P.Q. (BNA) at 228 (articulating that the standard for whether a mark is scandalous is not whether it is *per se* scandalous but whether it is scandalous when considered in the context of the goods on which it is used). *But see* Phillips, *supra* note 25, at 63 (noting that marks containing profanity are generally considered *per se* scandalous); *infra* notes 55–56 and accompanying text (discussing the *per se* bar on registration of trademarks consisting of flags, coats of arms, or other insignia of the United States).

35. See *Heeb Media*, 89 U.S.P.Q. (BNA) at 1071 (distinguishing the applicant’s other goods and services and holding that it could only consider the mark in dispute in connection with the identified goods or services in the application).

36. See *id.* at 1072 (relying solely on how the mark will be used based on what is listed in the application); TMEP, *supra* note 12, § 1203.1 (“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, and must be ascertained from the standpoint of not necessarily a majority, but a ‘substantial composite of the general public.’” (quoting *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981))).

37. See *In re Fox*, 702 F.3d 633, 635, 640 (Fed. Cir. 2012) (finding a mark for rooster-shaped chocolate lollipops to be scandalous because a substantial composition of the general public could perceive an offensive meaning); *Heeb Media*, 89 U.S.P.Q. (BNA) at 1072 (denying use of the mark for applicant’s magazine where magazine was not properly included in the uses listed in the application); *Doughboy Indus.*, 88 U.S.P.Q. (BNA) at 227–28 (refusing to allow DOUGH-BOY, a term used to describe WWI soldiers, to be used for prophylactics).

demonstration of this doctrine in application.³⁸ In order to determine whether the mark REDSKINS is disparaging to Native Americans, the TTAB evaluated the mark in the context of its use with professional football services and merchandising.³⁹ The TTAB ultimately concluded that the mark was disparaging—relying, in part, on survey evidence that showed that 131 (37%) of the 358 Native Americans surveyed found the word to be offensive.⁴⁰ But on appeal, the district court was critical of this finding because the survey asked respondents to react to the use of the word “redskins” in the abstract and not in the context of football. The court overturned the cancelation of the trademark for this and other reasons.⁴¹

This case provides perhaps the clearest divide between the two modes of evaluating immoral, scandalous, and disparaging marks. The position taken by Pro Football, the trademark owner, is that context matters.⁴² The REDSKINS mark certainly enjoys strong “secondary meaning.” Secondary meaning is the trademark doctrine describing the phenomenon of words taking on a second meaning due to their use as a trademark.⁴³ Pro Football argues that in the case of its trademark, the second meaning has overtaken the first in the minds of the public.⁴⁴ That is, the word “redskins” has come to so strongly connote Pro Football’s team that the public tends to now forget that the word also denotes race.⁴⁵ Pro Football’s secondary meaning argument clearly hinges on a consideration of the mark in context and not in the abstract.

38. See *Pro Football, Inc. v. Harjo (Harjo IV)*, 565 F.3d 880, 880–81 (D.C. Cir. 2009) (affirming the use of the laches defense to bar a challenge to the mark because of the passage of twenty-five years between when the mark was approved and when it was challenged).

39. *Harjo v. Pro Football, Inc. (Harjo I)*, 30 U.S.P.Q.2d (BNA) 1828, 1830 (T.T.A.B. 1994). And this test was recently adopted by the Federal Circuit in *In re Geller*, No. 2013-1412, 2014 WL 1887661 (Fed. Cir. May 13, 2014).

40. *Harjo v. Pro Football, Inc. (Harjo II)*, 50 U.S.P.Q.2d (BNA) 1705, 1745–46 (T.T.A.B. 1999), *rev’d*, 284 F. Supp. 2d 96, 1225 (D.D.C. 2003), *rev’d per curiam on other grounds*, 415 F.3d 44 (D.C. Cir. 2005).

41. *Pro-Football, Inc. v. Harjo (Harjo III)*, 284 F. Supp. 2d 96, 145 (D.D.C. 2003), *rev’d per curiam on other grounds*, 415 F.3d 44. The district court also ruled that the petitioners unreasonably delayed in bringing suit. *Id.* at 882.

42. *Harjo III*, 284 F. Supp. 2d at 130 (arguing that there are contexts in which the term “redskins” is not considered offensive).

43. 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15:1 (4th ed. 2013) (explaining that when consumers use a word or symbol to identify a single commercial source, that word or symbol has achieved secondary meaning).

44. *Harjo III*, 284 F. Supp. 2d at 130 (finding the evidence related to the media and fans had no bearing on whether a substantial composite of Native Americans finds the mark to be offensive when used in connection with Pro Football’s services).

45. *Id.* (stressing that “redskins” is not considered offensive in some contexts).

III. MORALITY DETERMINATIONS DEMAND A PER SE EVALUATION

Of course, considering the commercial context of words makes logical sense when making other trademark determinations such as whether the mark is distinctive or likely to cause confusion.⁴⁶ The information the public takes from a mark is dependent on how the public will encounter it in the marketplace.⁴⁷ A mark cannot be per se generic or confusing.⁴⁸ It is only in the context of its particular use that these determinations can be made.

In contrast, a mark can be per se immoral, scandalous, or disparaging. A racist or obscene word's meaning is implicated regardless of the commercial context of its use. Unlike other provisions of the Trademark Act, section 2(a)'s prohibition on the registration of offensive marks is not an attempt to regulate the marketplace.⁴⁹ Instead, this provision's objective is simply to bar certain words from the registry.⁵⁰ Therefore, how the words act as marks is not relevant; only their plain meanings matter.⁵¹

46. 4 MCCARTHY, *supra* note 43, § 23:1 (describing the standard for whether trademark infringement has occurred under both common law and the Lanham Act as the "likelihood of confusion" test whereby if a use is likely to cause confusion or mistake or to deceive there is an infringement).

47. *Id.* §§ 24:6, 24:24 (suggesting that a likelihood of confusion may exist when the "marks as used [in the marketplace] are 'related' in the mind of the consuming public," or that they are likely to mistakenly believe that the "infringer's goods came from the same source as the senior user's goods").

48. *Advertise.com, Inc. v. AOL Adver., Inc.*, 616 F.3d 974, 977 (9th Cir. 2010) ("Context is critical to a distinctiveness analysis . . . [and the level of distinctiveness of a mark] can be determined only by reference to the goods or services that [the mark] identifies." (alterations in original)). See generally 4 MCCARTHY, *supra* note 43, §§ 23:1-23:11.50 (detailing the "likelihood of confusion" test).

49. *Carpenter & Murphy*, *supra* note 13, at 465 (recognizing that the section 2(a) bar goes "well beyond" the Lanham Act's basic goals of promoting fair competition and preventing confusion in the minds of consumers).

50. See *Baird*, *supra* note 27, at 666 (recognizing that section 2(a) is unlike the rest of the Lanham Act because it is designed to regulate "moral values" and "discourage the commercial use of offensive subject matter that may not directly implicate principles of morality or virtue").

51. For this reason, the decision in *Doughboy Industries, Inc. v. Reese Chemical Co.*, 88 U.S.P.Q. (BNA) 227 (P.T.O. 1951), was wrongly decided. As recognized by the court, Doughboy was the name given to American soldiers who participated in WWI. *Id.* at 228. Still, the examining attorney held that the mark DOUGHBOY for condoms disparaged WWI soldiers after considering the packaging, which depicted soldiers. *Id.*; see also Todd Anten, Note, *Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of Slurs into Section 2(a) of the Lanham Act*, 106 COLUM. L. REV. 388, 411-12 (2006) (identifying DOUGHBOY as a contextually disparaging mark, or a "mark contains a term that would be acceptable to the relevant group as a general label of identification, but becomes disparaging based on the mark's contextual use"). Had the examining attorney not judged the mark in the context of the packaging, the dominant meaning of "doughboy" would have been maintained. Having DOUGHBOY on the registry would not offend soldiers. And although the use of a reference to WWI soldiers on condoms may offend, it is not within the

Marks that include racial terms illustrate this point. It is difficult to accept that a racial epithet could become acceptable when applied to any conceivable set of goods. When it comes to racial epithets, one would think that almost any commercial use would deeply offend.⁵² In fact, any racial referent, not just racial epithets, should be held to be *per se* offensive.⁵³ Without any information at all about the particular commercial use of the mark, its status as a racial reference should suffice to bar its registration. Certainly "Native American" is preferred to "redskin." But would the preferred racial description result in an inoffensive mark? It is unlikely that Native Americans would feel indifferent about "NATIVE AMERICAN" brand paper towels, for example. Even the most inoffensive words that denote race, when used commercially as a mark on any goods or services, are offensive. The USPTO should not allow the registration of LAKOTA brand socks or JEW brand window cleaner. The use of a word denoting race for a brand name is offensive regardless of the goods it is applied to because the commercial appropriation of race in this way suggests a certain power relation between the appropriator and the appropriated.⁵⁴

A *per se* approach is supported by the statutory language of section 2(a). That section forbids registration to any mark that "[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage."⁵⁵ This provision directs the USPTO to forbid immoral, scandalous, and deceptive "matter," not immoral, scandalous, and disparaging marks. That is, the matter contained within the mark is the object of inquiry, not the mark. The word "comprises" indicates that part of the mark can be offensive and therefore unregistrable. This dissection is consistent with a *per se*

jurisdiction of the USPTO, or any other agency for that matter, to police this insulting use.

52. See ROSEMARY J. COOMBE, *THE CULTURAL LIFE OF INTELLECTUAL PROPERTY: AUTHORSHIP, APPROPRIATION, AND THE LAW* 188 (Stanley Fish & Fredric Jameson eds., 1998) (acknowledging how the use of such terms can be "disrespectful, demeaning, or discriminatory" and can ultimately translate into "virulent racism").

53. See, e.g., U.S. Trademark Application Serial No. 76,639,548 (filed May 25, 2005) (African American's application to register the mark NIGGA). That application was denied on the grounds that it was disparaging. Office Action Letter, U.S. Trademark Application Serial No. 76,639,548 (Dec. 22, 2005) ("A substantial composite of African-Americans would find the term derogatory because the term is a slang equivalent of 'nigger' and is commonly used to denigrate African-Americans.").

54. See COOMBE, *supra* note 52, at 174 (arguing that trademark owners, in their attempt to overcome mere descriptiveness, not surprisingly took advantage of power relationships by "turn[ing] to bodily signs of social difference [or] those indicia that Americans . . . were coming to recognize as the signs of the *primitive other*" (emphasis added)).

55. 15 U.S.C. § 1052(a) (2012).

approach. This “matter” should be considered out of context. The statute speaks of “matter” not “words” since the prohibition applies equally to design marks.⁵⁶ If it is the particular word or image that is to be judged as immoral, scandalous, or disparaging, it follows that the analysis should be per se, not in context. Here the statutory language directs us away from the traditional contextual analysis.

Of course it is possible that users of an offensive mark may be well intentioned and that the USPTO may only realize this good intention by considering the context of a mark’s use.⁵⁷ Nevertheless, the government’s trademark registry should still not contain such words. If, in the context of use, a trademark holder can demonstrate an alternate meaning to the public, the *use* of that mark may well be justified.⁵⁸ The *registration* of the mark, however, is not justified. For example, any application for HEIL HITLER should be denied under section 2(a) because these words are per se immoral, scandalous, and disparaging. Although one can imagine a filmmaker using these words as a title of a film that explores how people came to follow Nazism, the title should not receive the benefits of federal registration. While the motivations of the filmmaker may be admirable, registration benefits should not be extended to these words since they will likely cause deep offense to a significant portion of the population.

Some have argued that the maturity or the sensitivity of the relevant consumer should be taken into account when determining the section 2(a) bar.⁵⁹ According to this thinking, jurists should approve the registration of sexually explicit or even sexually violent words when they are applied for use with pornography, for instance.⁶⁰

56. *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981), concerned a photograph of a nude man, genitalia exposed, kissing a nude woman.

57. *See, e.g., In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d (BNA) 1264, 1266–68 (T.T.A.B. 2006) (considering SQUAW in the context of Squaw Valley ski resort).

58. *Compare In re Geller*, No. 2013-1412, 2014 WL 1887661, at *1 (Fed. Cir. May 13, 2014) (affirming the TTAB’s denial of the mark STOP THE ISLAMISATION OF AMERICA for “providing information regarding understanding and preventing terrorism”), and *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215, 1216 (T.T.A.B. 2010) (denying the mark KHORAN for wine because it would disparage a substantial composite of Muslims), with MUSLIM EDUCATION AND CONVERTS CENTER OF AMERICA, Registration No. 3,960,200 (for educational services in the field of Islam), and MUSLIM WRITERS GUILD OF AMERICA, Registration No. 4,333,123 (for providing information regarding the Islamic faith).

59. LaLonde & Gilson, *supra* note 12, at 1494 (arguing that the TTAB should evaluate “whether a mark is scandalous to the point of view of the relevant or potential purchasers of the indicated goods or services” and not the general public since they will “never be exposed to the mark”).

60. *See, e.g., Examining Attorney’s Appeal Brief*, U.S. Trademark Application Serial No. 77,060,742 (T.T.A.B. Mar. 12, 2009) (arguing that the applicant’s mark CUMFIESTA for pornographic goods should be considered within the pornographic

Presumably these marks will be aimed at adults who seek such goods, and it is unlikely that children will encounter them. Taken to its logical conclusion, however, this argument allows for explicitly racist words to be registrable for services directed at Klu Klux Klan members. Although the relevant market may not be offended, such words nevertheless are unsuitable for the trademark registry and are undeserving of federal benefits. Again, the regulation is not aimed at the marketplace, but only at the registry.

Ideally, when determining whether a mark is immoral, scandalous, or disparaging, the trademark examining attorney would simply consult a database of offensive words.⁶¹ This approach would track the typical analysis conducted by examining attorneys for other trademark determinations. For instance, when an examining attorney determines whether a mark is geographically descriptive or geographically misdescriptive, she consults a database of geographical terms.⁶² Were immoral, scandalous, and disparaging marks to be determined on a per se basis, an examining attorney would consult a similar database, and no further analysis would be necessary. The word would either be included in such a database or not.

Of course there may be some practical problems in creating a database of offensive terms since not everyone will agree on what words offend.⁶³ There will be genuine differences of opinion, for example, about which words are scandalous. But this only means that there may not be a universally accepted, authoritative list of offensive words. Some may be under-inclusive and some may be over-inclusive.⁶⁴ This does not pose a major obstacle to enforcement of the provision because there are numerous lists of offensive words. Examining attorneys regularly consult multiple sources of conflicting

marketplace, consisting of a "consensual adult audience desirous of receiving and enjoying the message conveyed by works relating to human sexuality").

61. See *supra* note 12 and accompany text.

62. TMEP, *supra* note 12, § 1210.04 (listing examples of sources that an examining attorney may consult in order to show there is a goods/place or services/place association with the mark).

63. See *H.R. 4744 Hearings*, *supra* note 21, at 21 (recognizing that whether a mark is disparaging invariably hinges on a person's opinion); see also *In re Hines*, 32 U.S.P.Q.2d 1376 (T.T.A.B. 1994) (acknowledging that the determination of whether a mark was disparaging is "highly subjective").

64. See generally GEOFFREY HUGHES, AN ENCYCLOPEDIA OF SWEARING: THE SOCIAL HISTORY OF OATHS, PROFANITY, FOUL LANGUAGE, AND ETHNIC SLURS IN THE ENGLISH SPEAKING WORLD, at xv (2006) ("An extraordinary range of style and content has evolved in oaths, profanity, foul language, and ethnic slurs over the centuries, on a scale from the most sacred utterances to the most taboo."). New Zealand, which prohibits the registration of Maori words and symbols as marks, maintains a database for this purpose. See Paul Sumpter, *Intellectual Property Law and the New Morality*, 11 N.Z. BUS. L.Q. 216, 217-18, 227 (2005).

information in making various determinations.⁶⁵ As in other determinations, they would base their section 2(a) decisions on the weight of authority.

This is not to suggest that making per se determinations about the moral meanings of words is straightforward. Making these determinations is particularly difficult because sensitivities are not objective or absolute. Morals vary across communities. For example, while some communities consider the use of alcohol immoral, others do not. Moreover, determining the moral significance of words is difficult because meaning is not stagnant.⁶⁶ Meaning also changes over time. While "Bin Laden" may have been a perfectly innocuous surname and trademark at one time, its meaning has changed after 9/11.⁶⁷ Nevertheless, making these determinations is more straightforward than the complicated and nuanced analysis that currently occurs when jurists attempt to go beyond a word's plain meaning and interpret listeners' contexts.

Differing sensitivities and the ever-evolving meaning of words does not necessarily require that section 2(a) determinations be contextualized. Quite the opposite. Because morality and language can be so relative to context, contextualizing words in order to make moral determinations leads to an impossible task.⁶⁸ It is only when words are decontextualized that such determinations become manageable.

Determining the meaning of words out of context, however, is somewhat unnatural for English speakers. We are conditioned to

65. TMEP, *supra* note 12, §1203.01 (noting how dictionary definitions, notwithstanding the source's reputation, may be sufficient to support a 2(a) refusal if most suggest the mark has an offensive meaning).

66. See, e.g., ANTONIN SCALIA & BRYAN A. GARNER, *READING LAW: THE INTERPRETATION OF LEGAL TEXTS* 78 (2012) (exemplifying "awful, artificial, and amusing" as words having undergone "pejoration," a process by which a word's meaning degenerates to a mostly negative connotation); see also *From Abandon to Nice . . . Words that Have Literally Changed Meaning Through the Years*, DAILY MIRROR (Aug. 16, 2013), <http://www.mirror.co.uk/news/uk-news/words-literally-changed-meaning-through-2173079#.UuBVT3n0B1M> (discussing how the meaning of multiple words, including "abandon," "addict," and "awful," have changed over time).

67. For this reason, a trademark application for BIN LADIN was refused by the Office for Harmonization in the Internal Market (OHIM) Board of Appeal as contrary to public policy or accepted principles of morality (Article 7(1)(f)) of the CTM Regulation. The applicant, a Swiss company called Falcon Sporting Goods, is owned by Yeslam Bin Ladin, a half brother of Osama Bin Laden. BIN LADIN, Trade Mark Application No. 002223907, Case No. R0176/2004-2 (OHIM filed May 2001). Likewise, in the United States, an application for OBAMA BIN LADEN was refused as scandalous for the same reason. Office Action Letter, U.S. Trademark Application Serial No. 77,086,418 (Feb. 6, 2007) ("The terrorist acts perpetrated by this individual's organization on September 11, 2001 have caused the name BIN LADEN itself to be synonymous with the acts themselves.").

68. See *supra* notes 12-14 and accompanying text.

perform semiotic analysis in order to discover meaning.⁶⁹ Determining the meaning of words out of context is the job of a dictionary, not a person.⁷⁰ But this is precisely the task that was envisioned for USPTO examining attorneys⁷¹: they should consult a dictionary or database to determine the meaning of a word,⁷² but not attempt to decipher semiotic meaning when considering a section 2(a) bar. A per se approach would make trademark prosecution more straightforward. The acquisition of a trademark registration should be affordable. An individual or small business should not have to go into debt to provide an extensive legal record, including testimony from historians and linguists in order to secure registration for a trademark. Likewise, civil society should not have to devote a large portion of their legal budget to oppose the registration of deeply offensive marks.

Moreover, the category of unregistrable words should be plainly obvious and knowable in advance. A trademark attorney should be able to give clients clear advice about which marks are registrable and which are not. Thus, a trademark attorney should be able to tell her client, "Having opened a dictionary, I see that your proposed trademark contains a racial slur. As such, you will likely be denied registration. I suggest you choose another mark if you want a federal registration."

The category of words that ought to be denied registration as immoral, scandalous, or disparaging should be limited. That is, the section 2(a) bar should be set quite high. Most parents have a finite list of words that their children ought not utter. They likely have a longer, possibly indefinite, list of words they would prefer not to hear their children say. A section 2(a) morality bar should be analogous to the first list; it should be an absolute, per se, but seldom-exercised,

69. Structuralist linguistics has demonstrated how meaning arises only in structuralist relations. Semiotics involves the relationship of abstract system of rules or language structure and specific uses. See WINFRIED NÓTH, HANDBOOK OF SEMIOTICS (1995); see also Gibbons, *supra* note 26, at 197 ("[S]emiotics is structural. Meaning is created through the relationships or oppositions among elements.").

70. See *infra* notes 98–99 (asserting that dictionary definitions do not account for semantic shifts due to context and that individuals must rely on context to determine a word's proper meaning).

71. See LaLonde & Gilson, *supra* note 12 ("The USPTO may not decide whether a registration is scandalous simply by asserting its own views and values. Instead, the [TTAB] has a duty to obtain the views of the affected public." (internal quotation marks omitted)).

72. Trademark examining attorneys regularly consult dictionaries and other reference sources in their evaluations of trademark applications. See TMEP, *supra* note 12, § 1203.01 (suggesting that dictionary definitions alone are sometimes enough to support a section 2(a) refusal).

prohibition.⁷³ Currently, it is impossible to have a discussion about the appropriate level of the bar due to the inconsistency of the rulings.

IV. CONTEXTUALIZATION RISKS ENTANGLEMENTS WITH RELIGION

Words that are strongly connected to particular religions, like racial words, are perhaps not appropriate for any kind of commercial appropriation. These words likely do not cause offence on their own, but the offense is caused by their commercial appropriation. These words are of such a sensitive nature that they should not be used in new commercial contexts.

According to current section 2(a) jurisprudence, a trademark use of a word may be offensive because of the particular type of commercial use that is made. This was the case with the application for KHORAN for wine.⁷⁴ The word "Khoran" is Armenian for alter, and a company attempted to trademark KHORAN for wine in the United States.⁷⁵ However, because KHORAN is phonetically equivalent to the sacred text of Islam, the TTAB determined its use would likely offend Muslims when used to denote an alcoholic beverage since consumption of alcohol is forbidden according to that religion.⁷⁶ Based on this contextual analysis, the TTAB denied registration of the mark.⁷⁷

A trademark containing a religious word may, however, only become offensive in the context of its marketing. Consider the mark JESUS JEANS.⁷⁸ It would seem difficult to deny trademark registration for the word "Jesus," since many business owners' legal name is Jesus and they may want to operate their business under their own name.⁷⁹ Under the current jurisprudence, when that word is

73. For an example, see George Carlin's "Filthy Words" monologue, reproduced in *FCC v. Pacifica Foundation*, 438 U.S. 726, 751-55 (1978).

74. *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215 (T.T.A.B. 2010), *aff'd*, 108 U.S.P.Q.2d 1305 (T.T.A.B. 2013).

75. *Id.*

76. *Id.* at 1217-19.

77. *Id.* at 1220.

78. See JESUS, Registration No. 3,232,057 (authorizing use of the trademark name JESUS for "articles of clothing and sportswear"). The owner of that trademark used it to sell jeans under the brand name JESUS JEANS. Answer to Notice of Opposition and Counterclaim to Cancel Opposer's Registration No. 3,232,057, *Jesus S.R.L. v. Anton*, No. 91209383 (T.T.A.B. Apr. 1, 2013).

79. Indeed, a trademark search of the mark JESUS produced 1676 records. Moreover, use of the trademark JESUS is so desirable that it has produced contentious litigation. The JESUS trademark owner of JESUS, Registration No. 3,232,057, has successfully opposed applications for similarly named trademarks, including JESUS MESSIAH, JESUS COUTURE, SWEET JESUS, JESUS>LIFE, JESUS LOVES JEANS, JESUS IQ, and JESUS GOT IT RIGHT, to name a few. Notice of Opposition, *Jesus Jeans S.R.L. v. Anton*, No. 91209383 (T.T.A.B. Feb. 20, 2013).

considered in the context of the particular goods on which the mark would be used—for example, jeans—the association is not immediately offensive. However, the advertisement campaigns for this brand have drawn ire from conservative Christians.⁸⁰ For instance, in one advertisement, the text below an image of a woman's derriere barely covered by a small pair of cutoff jean shorts reads: "He who loves me follows me."⁸¹ In another advertisement, the image portrays a close-up of a woman's pelvic area with her jeans, tight and unzipped. The text reads: "Thou shalt not have any other jeans but me."⁸²

But because the marketing campaign is arguably outside of the purview of the USPTO,⁸³ the offense caused by that advertising may escape section 2(a). Trademark examining attorneys cannot fully consider an applicant's marketing campaigns in their registration determinations. Typically, the examining attorney only reviews a sparse application that names the mark's proffered goods or services.⁸⁴ Further, an applicant will seldom add additional context by offering evidence that it intends to combine overtly religious references with explicit sexual references because doing so is unlikely

Most recently, in 2013, the JESUS trademark owner opposed the registration of the trademark JESUS SURFED. *Id.* at 1.

80. Answer to Notice of Opposition, *supra* note 78 (arguing that JESUS's use of the trademark JESUS JEANS is "sacrilegious," "sexually suggestive," "irreverent," "prurient," and violative of "Jesus Christ's call for sexual purity").

81. *Id.* at 3. Apparently, the Catholic Church denounced this advertisement when it ran in the 1970s in Italy. See Jacob Gershman, *If You Take These Jeans' Name in Vain, Prepare To Meet Their Maker: Italian Apparel Company Registered 'Jesus' as Trademark, Protects It Devoutly*, WALL ST. J. (Feb. 24, 2013), <http://online.wsj.com/news/articles/SB10001424127887324432004578302060560501092>.

82. Answer to Notice of Opposition, *supra* note 78.

83. An applicant may, but is not required to, convey a sense of its marketing campaign in the specimens it submits to the USPTO. "The determination of whether a mark is scandalous must be made in the context of the relevant marketplace . . . [t]he Examining Attorney may look to the specimen(s) or other aspects of the record to determine how the mark will be seen in the marketplace." TMEP, *supra* note 12, § 1203.01. And, of course, the examining attorney may consider the specimens for confirmation that a mark is offensive in context of the goods or services at issue. Perhaps the TTAB opened the door to this consideration in the KHORAN wine case when it explained:

The dissent notes that KHORAN should not be considered in the abstract but in connection with the goods. We agree, and have not reached our conclusion based on an analysis of the mark in the abstract. However, we cannot limit our consideration of the mark to prospective purchasers of wine. . . . [W]e must assume that Muslim Americans would be exposed to the *sale and advertising of the product* even if they do not actually buy or consume wine.

In re Lebanese Arak Corp., 94 U.S.P.Q.2d (BNA) 1215, 2020 (T.T.A.B. 2010) (emphasis added).

84. See *supra* note 12 and accompanying text.

to enhance its chances for registration.⁸⁵ Thus, because an application for “Jesus” might only be evaluated in the context of the applied for goods, it will likely pass section (2)(a) muster.

The inconsistency resulting from this limited contextualization has led to a contest regarding which party, if any, may use the word “Jesus” as a trademark for clothing. The owner of the JESUS JEANS mark opposed another’s application for the mark JESUS SURFED.⁸⁶ The JESUS SURFED applicant has in turn sought to cancel the registration for JESUS JEANS on the grounds that the mark is scandalous and immoral.⁸⁷ The JESUS SURFED applicant fortifies his argument with evidence that, as a Christian evangelical preacher himself, he would connect the brand to his ministry services.⁸⁸ The JESUS SURFED applicant has thus invited trademark jurists to determine which use of the mark is more consistent with Christian beliefs. The USPTO, however, should not accept this invitation. An all or nothing approach is preferable; jurists should either refuse registration for all marks containing the word “Jesus” due to its religious significance or else permit all registrations because “Jesus” is also a common first name. Trademark jurists should not be deciding which use of “Jesus” is more consistent with Christianity. A *per se* rule would better prevent religious entanglements.

The application of section 2(a) to marks identifying religions should mirror that of section 2(b). Section 2(b) of the Trademark Act bars marks consisting of flags, coats of arms, or “other insignia of the United States, or of any State or municipality, or of any foreign nation.”⁸⁹ These bans are effectuated on a *per se* basis.⁹⁰ This list of

85. The examining attorney, however, can supplement the record with evidence of the applicant’s use of the mark. This was done in the case of the application for THE SLANTS. Examining Attorney’s Appeal Brief, *In re* Tam, 108 U.S.P.Q.2d (BNA) 1305 (T.T.A.B. 2013) (Opposition No. 85472044), 2013 WL 6039241. The examining attorney there included material from the applicant band’s webpage. *Id.* at 6–7.

86. Notice of Opposition, *supra* note 79; *see also* Gershman, *supra* note 81 (quoting a JESUS JEANS spokesman as having said: “If somebody—small church or even a big church—wants to use Jesus for printing a few T-shirts, we don’t care But when companies like [JESUS SURFED] seek to commercialize their products, that’s a concern.” (internal quotation marks omitted)); *supra* note 79 and accompanying text (noting several other trademark applications JESUS JEANS has opposed).

87. Answer to Notice of Opposition, *supra* note 78.

88. *See* Gershman, *supra* note 81 (“Mr. Anton said he got the idea for his company after organizing a spiritual beach retreat under the theme ‘walk on water.’ He thought if Jesus were around today, he would be a surfer. So he registered *jesussurfed.com* and started selling T-shirts, hoodies and bandannas decorated with a silhouette of Jesus holding a giant surfboard under a palm grove.”).

89. 15 U.S.C. § 1052(b) (2012).

banned insignia represents institutions that Congress presumably thought deserved respect and should be spared the indignity of having their symbols sullied by *any* commercial appropriation, not just instances that would sully these symbols based on the particular use involved.⁹¹ Like state insignia, religious and racial terms should also enjoy an absolute ban on registration.

The irony here is that contextualizing marks is an attempt to do traditional trademark analysis since jurists are uncomfortable making moral judgments. But the very act of contextualizing marks is what has pulled the trademark office and the courts into murky subjectivity.

V. CONTEXTUALIZATION LEADS TO INCONSISTENT RESULTS

This area of trademark law is fraught with inconsistency. A review of the USPTO's determinations on the issue of scandalousness, for instance, reveals a set of rulings that appear utterly random.⁹² Rightly so, critics of section 2(a) decry this inconsistency as one of the fundamental problems resulting from the current interpretation of the law.⁹³

The reason for this inconsistency relates to jurists' discomfort in making moralistic judgments. Jurists' efforts to evade the moral judgments that are required under section 2(a) have led to these subjective and inconsistent results.⁹⁴ For instance, there may be

90. See *id.* (prohibiting registration of any mark that “[c]onsists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation”). But see, e.g., *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216 (T.T.A.B. 1993) (reversing the examining attorney's refusal to register the mark OLD GLORY CONDOM CORPORATION with a design of the U.S. flag for condoms).

91. See 15 U.S.C. § 1052(b); TMEP, *supra* note 12, § 1204 (Unlike section 2(a), section 2(b) of the Lanham Act is an absolute bar to registration and requires no additional element, such as disparagement). But see S. 1816, 113th Cong. (2013); H.R. 3713, 113th Cong. (2013) (proposed legislation allowing states or municipalities to trademark their own insignia).

92. Compare *In re Riverbank Canning Co.*, 95 F.2d 327, 329 (C.C.P.A. 1938) (refusing to register MADONNA for wines, noting that the commercialization of the name or image of the Virgin Mary is of “very doubtful propriety”), and *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215 (T.T.A.B. 2010) (holding that the word “Koran” was not, in itself, disparaging, but its use as a mark for wines was under section 2(a) of the Lanham Act), with *In re Waughtel*, 138 U.S.P.Q. (BNA) 594 (T.T.A.B. 1963) (finding that the image of an Amish man on cigars did not disparage a substantial composite of Amish people or their religious beliefs), and *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653 (T.T.A.B. 1990) (allowing registration of the mark MOONIES because it did not disparage Reverend Sun Myung Moon, referring rather to dolls that “mooned” or dropped their pants).

93. See generally Jendi B. Reiter, *Redskins and Scarlet Letters: Why “Immoral” and “Scandalous” Trademarks Should Be Federally Registrable*, 6 FED. CIRCUIT B.J. 191, 193 (1996) (critiquing the subjective and inconsistent application of section 2(a) by the USPTO).

94. See *supra* notes 32–36 and accompanying text.

absolute evasion when USPTO examining attorneys neglect entirely to make section 2(a) refusals for offensive marks.⁹⁵ This practice leads to the registration of some marks while similar marks reviewed by others may be denied registration.⁹⁶ But more fundamentally, the problem is the attempted masking of moral judgments in conventional trademark analysis.⁹⁷

At base, contextualization leads to inconsistent results by design; it is inherent in the exercise. Context changes our understanding of words;⁹⁸ inoffensive words become offensive and vice versa based on context.⁹⁹ Thus, inconsistencies naturally result from contextualization.

For example, a set of opposite results was arrived at in related applications for the word SQUAW. The TTAB denied an application for SQUAW for use on apparel as disparaging to Native Americans but in the same ruling approved the use of SQUAW by the same applicant for use on ski-related goods and services.¹⁰⁰ The TTAB rationalized this disparate treatment by stating that in the context of skiing, “squaw” would be regarded as a reference to the famous ski resort, Squaw Valley, but absent that context, the word would be understood as a racial slur.¹⁰¹

Similarly, the “redskin potatoes” example frequently arises in discussions regarding the REDSKINS mark and the futility of policing language.¹⁰² Indeed, it is an excellent example of the effect context can have on meaning. The simple addition of the word “potatoes” re-contextualizes the word and removes the offense. “Redskin potatoes” is, however, easily distinguishable from REDSKINS. Significantly, the word “redskin” is paired with “potatoes.” Were the football team to change their name to

95. For instance, WILD INJUN was registered without any USPTO refusal under section 2(a). See WILD INJUN, Registration No. 1,673,489.

96. See, e.g., U.S. Trademark Application Serial No. 77,186,637 (registration refused under section 2(a) for disparagement).

97. See *supra* notes 32–33 and accompanying text.

98. See SCALIA & GARNER, *supra* note 66, at 418 (explaining that “common words typically have more than one meaning,” and therefore, using the word’s context is necessary to “determine its aptest, most likely sense”).

99. See, e.g., *id.* (noting that dictionaries often do not account for words’ “semantic nuances as they may shift from context to context”); see also Lawrence Downes, *A Word Gone Wrong*, N.Y. TIMES (Mar. 2, 2013), http://www.nytimes.com/2013/03/03/opinion/sunday/a-word-gone-wrong.html?_r=0 (reporting on a national campaign to curb the derogatory usage of “retarded,” an otherwise neutral term in the clinical context).

100. *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d (BNA) 1264, 1266–68 (T.T.A.B. 2006).

101. *Id.* at 1283.

102. See, e.g., Alisa Mullins, *No Need for Redskins To Change Name, Says PETA*, PEOPLE FOR ETHICAL TREATMENT ANIMALS (Oct. 11, 2013), <http://www.peta.org/blog/no-need-for-redskins-to-change-name-says-peta> (“When you hear the word ‘redskin,’ what do you immediately think of? Potatoes, of course!”).

“Redskin Potatoes” and remove all references to Native Americans, no one could complain that their name is offensive.

The “redskin potatoes” example highlights the need to strictly confine section 2(a) bars to the statute’s purpose. Any trademark application for “redskin potato” simply fails to raise an issue under section 2(a) because the plain meaning of these words has no relevance for race, unlike an application for the word “redskin” on its own. The term “redskin” alone, however, should be denied registration even when applied for by a party that seeks to use it in the context of potatoes.¹⁰³

A related hypothetical involves the registration of a trademark containing the word “cracker,” a word that refers to crisp wafers but also poor Southern, Caucasian Americans. The USPTO does not deny trademarks to those merchants who wish to use “cracker” in its non-racial meaning.¹⁰⁴ At the same time, the USPTO should not encourage a double standard for different racial terms. The difference here is that the dominant meaning of the word “cracker” is not a racial slur, as is the case with “redskin.” Although one meaning of the word “cracker”—the fifth meaning of seven in many dictionaries—is a racial slur,¹⁰⁵ because other innocuous meanings

103. Recently, the USPTO refused registration for the mark REDSKIN HOG RINDS for pork rinds. See Office Action Letter, U.S. Trademark Application Serial No. 86,052,159 (Dec. 29, 2013). Perhaps “redskin” has an innocuous meaning with regard to pork rinds. On this point, the current record is silent. Subsequently, the USPTO refused registration for the mark WASHINGTON REDSKIN POTATOES. See Office Action Letter, U.S. Trademark Application Serial No. 86,092,137 (Mar. 17, 2014) (denying the mark on section 2(a) grounds). WASHINGTON REDSKIN POTATOES was refused because the applied-for services were football and entertainment services, thus undermining the link to potatoes. *Id.*

104. See, e.g., SARATOGA CRACKERS, Registration No. 4,516,593. *But see* Office Action Letter, U.S. Trademark Application Serial No. 86,037,455 (Dec. 5, 2013) (noting that although FLORIDA CRACKERS may refer to “early Florida cowboys, its primary meaning in relation to applicant’s cracker goods is geographically descriptive”).

105. See *Cracker Definition*, DICTIONARY.COM, <http://dictionary.reference.com/browse/cracker?s=t> (last visited May 19, 2014) (describing the disparaging definition of “cracker” in the fourth and fifth entries); *Cracker Definition*, MERRIAM-WEBSTER DICTIONARY, <http://www.merriam-webster.com/dictionary/cracker> (last visited May 19, 2014) (noting the disparaging definition of “cracker” in the fifth entry); *Cracker Definition*, OXFORD DICTIONARY, http://www.oxforddictionaries.com/us/definition/american_english/cracker?q=cracker (last visited May 19, 2014) (defining “cracker” as “another term for poor white” in the third entry).

Dissimilarly, “redskin” is often only defined as an offensive and discriminatory word. See *Redskin Definition*, DICTIONARY.COM, <http://dictionary.reference.com/browse/redskin?s=t> (last visited May 19, 2014) (describing “redskin” as a “[S]lang: [o]ften [d]isparaging and [o]ffensive” term for “North American Indian”); *Redskin Definition*, MERRIAM-WEBSTER DICTIONARY, <http://www.merriam-webster.com/dictionary/redskin> (last visited May 19, 2014) (listing only one definition of “redskin” as a “usually offensive” term for “American Indian”); *Redskin Definition*, OXFORD DICTIONARY, http://www.oxforddictionaries.com/us/definition/american_english/redskin?q=redsk

are more common, the word is registrable.¹⁰⁶ This same issue was present in *In re Tam*,¹⁰⁷ although analyzed differently as the court attempted to contextualize the mark. There, the mark THE SLANTS was denied registration as being disparaging to Asians.¹⁰⁸ The predominant meaning of “slant,” of course, is not racial. But the word at issue was not “slant”; it was “*The Slants*.”¹⁰⁹

A large number of offensive marks involve some kind of wordplay, such as a double entendre. In these cases, the mark may have two meanings only one of which may be scandalous or immoral.¹¹⁰ Presumably this is why some sexually explicit marks with double meanings have been registered.¹¹¹ For example, although the mark COCK RUB was initially refused registration as scandalous, the applicant overcame that refusal with its argument that the mark referred to a spice rub for poultry.¹¹² The applicant successfully argued that the commercial context would make it less likely that the relevant consumer would attribute a vulgar meaning to the mark.¹¹³

Double entendres were directly addressed by the Federal Circuit in *In re Fox*.¹¹⁴ There the court held that a double entendre will not necessarily cure the vulgarity of a mark.¹¹⁵ The court found that the applicant intended the mark COCK SUCKER to mean both a

in (last visited May 19, 2014) (defining “redskin” as a dated, offensive term for an American Indian).

106. This analysis does not require that in all of these examples, “redskin potatoes,” REDSKIN HOG RINDS (presumably), and “cracker,” merchants who wish to use these words for their innocuous meanings be denied registration. But another provision of section 2(a) prohibits the registration of words that merely describe the goods or services they designate. 15 U.S.C. § 1052(e) (2012) (denying registration when the trademark “[c]onsist[s] of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive . . . of them”). So if “redskin” does in fact relate to the color of hog rinds, the USPTO should also refuse registration for mere descriptiveness.

107. 108 U.S.P.Q.2d (BNA) 1305 (T.T.A.B. 2013).

108. *Id.* at 1313.

109. *Id.*

110. *See, e.g.*, Response to Office Action Letter at 1, U.S. Trademark Application Serial No. 85,050,620 (Mar. 16, 2011) (arguing that “cock” has more than one meaning, “rub” is descriptive of spice rubs, and thus COCK RUB is not immoral or scandalous).

111. *See* COCK RUB, Registration No. 4,258,088 (approving “COCK RUB” for spice rubs).

112. *Id.*; Office Action Letter, U.S. Trademark Application Serial No. 85,050,620 (Sept. 16, 2010) (denying application for COCK RUB as immoral or scandalous); *see also* COCK RUB, Registration No. 4,258,088.

113. *See, e.g.*, Response to Office Action Letter, *supra* note 110 (asserting that “the use of the term [‘rub’] to identify spice rubs” creates an association with “food and not a sexual act” in a consumer’s mind and therefore the overall commercial impression of COCK RUB is not immoral or scandalous).

114. 702 F.3d 633 (Fed. Cir. 2012).

115. *Id.* at 634.

“rooster lollipop” and “one who performs fellatio.”¹¹⁶ Overturning the TTAB, the court concluded: “the fact that something is funny does not mean that it cannot be scandalous.”¹¹⁷ It would have been preferable for the court to offer clearer guidance on evaluating double entendres. A *per se* approach would lead to more predictable and consistent results.

Just prior to the COCK SUCKER trademark decision, the USPTO published for opposition another trademark—GAMECOCK SUCKER—also for lollipops.¹¹⁸ Astonishingly, the examining attorney considering that application never even raised the issue of scandalousness.¹¹⁹ It is this type of inconsistency that fuels criticism of section 2(a).¹²⁰

Can these opposite results for such similar marks be justified? Can the difference in result be entirely explained by the additional word “game?” In both cases, the marks were apparently references to the University of South Carolina and its mascot—the gamecock.¹²¹ This geographic context may have made the difference for GAMECOCK SUCKER. Perhaps in South Carolina, the public’s sensitivity to the use of the word “cock” has been diminished due to frequent references to the University of South Carolina Gamecocks. If so, this is simply an example of the difference that geographic context can make. Outside of this context, however, the word retains its vulgar meaning.

The lesson here is that context is indeterminate and leads to inconsistency. Reconsider the example of the hypothetical HEIL HITLER mark for a film about early Nazism.¹²² If the jurist considers the mark in context, she may permit the filmmaker to register the mark because of the film’s virtuous message. But what if the film’s message is ambiguous? Or what if the applicant is the creator of a

116. *Id.* at 637 (internal quotation marks omitted).

117. *Id.* at 639.

118. Notice of Publication, U.S. Trademark Application Serial No. 85,054,752 (Nov. 23, 2010). *Cf.* LaLonde & Gilson, *supra* note 12, at 1478 (noting that of the forty-one applications to register marks that include the word “milf,” twenty received an office action refusal based on section 2(a), but twenty did not).

119. Office Action Letter, U.S. Trademark Application Serial No. 85,054,752 (Sept. 21, 2010) (requiring only a disclaimer of the word “sucker,” a generic name for the good, in the application for COCK SUCKER in order to proceed). Similarly, in the United Kingdom, two variants recalling a coarse slang term received different treatment. Curiously, FOOK was denied registration, *see* UK Application No. 2,309,350, but FCUK was allowed, *see* UK Trade Mark No. 2,184,549.

120. *See, e.g.,* LaLonde & Gilson, *supra* note 12, at 1515 (highlighting how the TTAB refused to register THE BEARDED CLAM but reversed a refusal to register TWATTY GIRL); *see also* Reiter, *supra* note 93, at 193 (criticizing the inconsistent implementation of 2(a)).

121. U.S. Trademark Application Serial No. 85,054,752 (filed June 4, 2010).

122. *See supra* note 58 and accompanying text.

gruesomely violent video game that also aims to lead to a better understanding of the followers of Nazism? Should USPTO attorneys wade into these subjective determinations? Even if they do an excellent job of sorting out intentions and artistic messages, the results will still lack consistency. Some HEIL HITLER marks will be registered while others will not.

VI. THE MISGUIDED DOCTRINE OF TEMPORAL CONTEXTUALIZATION

Dictionaries change over time to reflect the evolving meaning of words.¹²³ Parents' lists of unutterable words may also change over time.¹²⁴ Some words become more offensive, while some become less offensive.¹²⁵ Similarly, the words barred under section 2(a) cannot remain constant.

When considering cultural sensitivity, the evolution of words and their meaning is both dramatic and complicated. Consider the varied labels that have been used over just the past fifty years to refer to African-Americans¹²⁶ or the generational shift in the use of the term "oriental" in favor of "Asian."¹²⁷ What may have been appropriate at one time may be deemed offensive at a later time.

A USPTO examining attorney, however, need not be a linguistic historian. Only contemporary meanings should be relevant because only contemporary meanings have the power to offend the contemporary public.¹²⁸ Whether or not the meaning of a word has changed is irrelevant—it only matters what the word means at the time of the evaluation.

123. See SCALIA & GARNER, *supra* note 66, at 419 (providing a list of "contemporaneous-usage dictionaries" because "[d]ictionaries tend to lag behind linguistic realities").

124. See *supra* Part I (proposing that jurists consult a database of unregistrable words similar in nature to a parent's "finite list of words that their children ought not utter").

125. See *supra* notes 98–99 and accompanying text.

126. See, e.g., Tom W. Smith, *Changing Racial Labels: From "Colored" to "Negro" to "Black" to "African American,"* 56 PUB. OP. Q. 496, 497 (1992) (discussing how the preferential term for African Americans has changed over time and the importance of those racial labels).

127. See N.Y. EXEC. LAW § 170-b (McKinney 2014) (banning the use of the term "oriental" to identify or denote persons of Asian or Pacific Islander heritage"); see also Sewell Chan & Jennifer Lee, *Law Bans Use of 'Oriental' in State Documents*, N.Y. TIMES (Sept. 9, 2009), http://cityroom.blogs.nytimes.com/2009/09/09/law-bans-use-of-oriental-in-state-documents/?_php=true&_type=blogs&_php=true&_type=blogs&_php=true&_type=blogs&_r=1 (noting that many consider the term "oriental" outdated and some consider it offensive).

128. See TMEP, *supra* note 12, § 1203.01 (requiring that the meaning of the mark must be determined in light of "current attitudes"); *In re Thomas Labs., Inc.*, 189 U.S.P.Q. (BNA) 50, 52 (T.T.A.B. 1975) ("[I]t is imperative that fullest consideration be given to the moral values and conduct which contemporary society has deemed to be appropriate and acceptable.").

Astonishingly, current trademark jurisprudence requires that a mark's offensiveness be considered in the context of time in which it was registered.¹²⁹ The TTAB produced perhaps the single worst ruling in the long-standing dispute over the REDSKINS trademark when it held that in evaluating whether or not the mark disparages Native Americans, its consideration was constrained to 1967—the date when the trademark application was first filed.¹³⁰ This is a misguided rule. First, this policy fails to protect the public today and instead attempts to reconstruct a public of the past. Second, it creates a laches problem for any challenger who is presently offended because registrants will argue that they are legally prejudiced in reconstructing the historical context of their original applications.¹³¹

Conceivably, one might defend this rule by arguing that unfairness would result if innocuous trademarks that garnered offensive connotations after they were registered were to lose their registrations. In such cases, the registrants are certainly innocent. Nevertheless, the registered mark is injurious to the public and should therefore cease to reap federal benefits. The duration of protection of trademarks, unlike other forms of intellectual property, is limitless. Although trademarks must be renewed every ten years, the renewal does not include a section 2(a) reconsideration. Again, the mark should not be evaluated in the context of the applicant's intentions but should be judged on its own.¹³² Registrants should protect their investment in marks by cautiously steering clear from words that in any way denote race. Based on history, these words have a great propensity to change connotations over time.¹³³ The unpredictability of society's sensibilities, coupled with trademark law's ability to cancel a mark that has become offensive, might incentivize trademark owners to seek innocuous marks. In this way, the rule would further the goals of section 2(a).

VII. OFFENSIVE WORDS RECLAIMED

Remarkably, the evolution of language is not always in the direction of abandoning words. Our society sometimes accepts the

129. *Harjo IV*, 565 F.3d 880, 885 (D.C. Cir. 2009).

130. *Id.*

131. *Id.* at 884; *see also*, *Blackhorse v. Pro Football, Inc.*, 98 U.S.P.Q.2d (BNA) 1633, 1637 (T.T.A.B. 2011) (addressing the defendant's argument that the plaintiff's claim should be barred by equitable estoppel because the trademark has been registered for many years and the plaintiff has known of its existence).

132. *See supra* Part II (discussing the inherent inconsistency that results from contextualization of a mark and consideration of an applicant's intent).

133. *See supra* notes 126–27.

broad use of words previously thought to be off limits, typically provoked by a disparaged group actively changing the meaning of a word. The reclamation and re-appropriation of words can be a political act performed to great effect by subjugated groups.¹³⁴ Feminist, LGBT, racial, ethnic, and religious groups have all sought to reinvent hurtful words as a source of strength and pride for their communities.¹³⁵ The ability of groups to reclaim offensive language and to reinvest it with new, more positive meanings counters the notion that the general society is becoming more sensitive and therefore more easily offended.

The reclamation of disparaging words is occasionally presented to the USPTO and courts. For instance, an examining attorney initially refused DYKES ON BIKES because he considered the term “dykes” to be a derogatory term for lesbians.¹³⁶ The applicant, a group of lesbian bikers who used the term and considered it empowering, argued that the views of the referenced group should determine whether the term is offensive.¹³⁷ The examining attorney nevertheless maintained the refusal and stated that “[t]he fact that some of the disparaged party have embraced or appropriated the term [“dyke,”] does not diminish the offensiveness of the term that has historically been considered offensive and derogatory.”¹³⁸ In response, the applicant submitted more than 300 pages of evidence on the present connotations of the term to show that the historically negative connotations have been re-appropriated as self-referential

134. Robin Brontsema, *A Queer Revolution: Reconceptualizing the Debate Over Linguistic Reclamation*, 17 COLO. RES. LINGUISTICS, June 2004, at 1, (“Laying claim to the forbidden, the word as weapon is taken up and taken back by those it seeks to shackle—a self-emancipation that defies hegemonic linguistic ownership and the (ab)use of power.”).

135. See Jessica M. Kiser, *How Dykes on Bikes Got It Right: Procedural Inequities Inherent in the Trademark Office’s Review of Disparaging Trademarks*, 46 U.S.F. L. REV. 1, 2 (2011) (analyzing how previously derogatory phrases indicating sexual preference, like “dyke,” have been reappropriated and are now understood as terms of pride rather than disparagement); see also Brontsema, *supra* note 134, at 1, 14 (discussing the reclamation of various pejorative terms—“queer,” “dyke,” “black,” “nigger”—and claiming that “dyke claims a political fierceness and anti-assimilationism that lesbian lacks”).

136. Office Action Letter, U.S. Trademark Application Serial No. 78,281,746 (Feb. 20, 2004); Kiser, *supra* note 135, at 1–2.

137. See Response to Office Action Letter, U.S. Trademark Application Serial No. 78,281,746 (Aug. 23, 2004) (attaching several testimonials from lesbian individuals asserting that they find the word “dyke” to be a term of empowerment rather than one of discrimination); see also Kiser, *supra* note 135, at 10–11 (describing the “hundreds of pages of supplemental evidence” testifying to the “self-referential use of dyke within the lesbian community”).

138. Office Action Letter, U.S. Trademark Application Serial No. 78,281,746 (Oct. 28, 2004).

terms of endearment and empowerment distinct from "lesbian."¹³⁹ In light of this voluminous record of evidence on the contemporary meaning of the term, the USPTO withdrew the refusal on reconsideration without comment.¹⁴⁰

The reclamation of offensive words raises the question of whether courts may consider who the speaker is when determining if a word is disparaging. This was addressed in *In re Heeb Media, LLC*,¹⁴¹ which involved an application for the mark HEEB for clothing. "Heeb" is a slang term for Hebrew with a history of anti-Semitic usage.¹⁴² The USPTO rejected the trademark application as disparaging of Jewish people even though the applicant was the publisher of *Heeb* magazine and used the term as a form of language reclamation.¹⁴³ Interestingly, the evidence that was presented demonstrated a generational divide in how the Jewish population regarded the term.¹⁴⁴ While younger Jewish people no longer found the trademark offensive, older Jewish people still did.¹⁴⁵

The TTAB held that the intent of the applicant is irrelevant to the determination of the meaning of the mark.¹⁴⁶ This rule, however, is in conflict with the general rule of contextualization that pervades this area of law. It forbids the context of the applicant's intent from otherwise disturbing the plain meaning of the word.

In re Heeb Media exposes another example of inconsistent results. Although HEEB was permitted as a mark for magazines, it was denied as a mark for T-shirts.¹⁴⁷ The context of the mark, appearing as the title of a magazine offers more opportunities for a reader to understand the reclaimed meaning of the word, particularly in light of the content of the magazine at issue here;¹⁴⁸ the meaning of the word on a T-shirt, however, is more ambiguous because T-shirts do not enrich the context in which to consider the meaning of the word.

139. Request for Reconsideration, U.S. Trademark Application Serial No. 78,281,746 (Apr. 28, 2005).

140. DYKES ON BIKES, Registration No. 3,323,803; see also Kiser, *supra* note 135, at 10–11 ("The examiner relented and the trademark application was finally approved . . . more than four years" later).

141. 89 U.S.P.Q.2d (BNA) 1071 (T.T.A.B. 2008).

142. *Id.* at 1071–73.

143. *Id.* at 1072–73, 1078.

144. *Id.* at 1076.

145. *Id.*

146. See *id.* at 1077 (noting that the court's inquiry centered on the referenced group's perception of the term rather than the applicant's intentions).

147. *Id.* at 1072.

148. See *id.* at 1072–75 (acknowledging that support for the name HEEB from prominent members of the Jewish community indicates their understanding that the word is not used offensively considering the magazine's content, readership, and advertisements as a whole).

Once again, therefore, the mark's context led to different conclusions about the offensiveness of the word.

Although the reclamation of offensive words is a worthy enterprise, contextualizing marks for the purpose of section 2(a) is the wrong policy approach. Reclaimed words should be evaluated based on our contemporary understanding of these words in the abstract. The question in these instances is not whether the offensiveness of the word has been cured for the speaker, but whether the offensiveness of the word has been cured for all audiences. *DYKES ON BIKES* was properly granted registration because the substantial record of evidence demonstrated that the word "dyke" now has a new meaning.¹⁴⁹ However, similar evidence was lacking in the case of *HEEB*.¹⁵⁰ Thus, what jurists have required in these cases is not a secondary meaning, but a new meaning.

Another example of an attempt to reclaim a disparaging word and register it as a trademark is *In re Tam*.¹⁵¹ In that case, a Seattle band comprised of Asian-American members attempted to register *THE SLANTS*.¹⁵² The TTAB affirmed the examining attorney's refusal based on disparagement, despite noting the applicant's intent to "embrace this slang meaning and to 'own' the stereotype."¹⁵³ Again, the TTAB weighed the context of the mark's use in its determination, but it refused to consider the intent of the speaker as determinative of the mark's meaning. Because of the TTAB's partial contextualization, the applicant accused the USPTO of unfairly using race in its determination.¹⁵⁴ According to the applicant, the USPTO considered the race of the applicant to arrive at the disparaging meaning of the mark but refused to make a similar consideration to determine the applicant's intent or public's perception.¹⁵⁵

149. Kiser, *supra* note 135, at 2-3; *see also supra* note 139 and accompanying text (showing how, ultimately, significant testimonial support from the lesbian community persuaded the examiner to grant the registration).

150. *See Heeb Media*, 89 U.S.P.Q.2d (BNA) at 1077 (pointing out the conflicting evidence regarding whether the Jewish community considered "heeb" an offensive term).

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

152. U.S. Trademark Application Serial No. 85,472,044 (filed Nov. 14, 2011).

153. *In re Tam*, 108 U.S.P.Q.2d (BNA) at 1310.

154. Response to Office Action Letter Dated January 6, 2012, U.S. Trademark Application Serial No. 85,472,044 (May 29, 2012) (arguing that the examining attorney refused to consider alternate, non-derogatory meanings of the word "slant" in its analysis); *see also In re Tam*, 108 U.S.P.Q.2d (BNA) at 1310 (describing the applicant's arguments that the examining attorney inappropriately weighed the applicant's race in connection to the word itself).

155. *See In re Tam*, 108 U.S.P.Q.2d (BNA) at 1310 ("[A]pplicant asserts that the refusal is dependent on the identity of the person, rather than the content of the application . . .") (internal quotation marks omitted). The court disagreed, stating "[n]either the ethnic identity of Applicant, the extent to which he associates in his use of the mark with other Asians . . . should be of relevance." *Id.*

In re Tam demonstrates the dangers of contextualization. The case is currently on appeal in the Federal Circuit where the applicant's brief accuses the USPTO of discrimination.¹⁵⁶ According to the applicant, the USPTO looked beyond the application and did independent research to discover that the applicant was Asian.¹⁵⁷ Only as a result of that information, according to the applicant, did the racial meaning of THE SLANTS come into play.¹⁵⁸ This dispute is a perfect illustration of how contextualization can lead a jurist down various paths of inquiry but may not lead to clarity.

CONCLUSION

The meaning of language and symbols evolve; they are not static.¹⁵⁹ Furthermore, the meanings of words vary based on their use and the contexts in which we find them. Trademark registration determinations are made rather quickly and are based upon small sets of information presented at particular historic moments. Thus, how can a USPTO trademark examining attorney correctly determine whether a mark is immoral, scandalous, or disparaging?

Since the Trademark Office does not employ linguists or anthropologists, it may be ill-equipped to determine which words offend which populations at which points in time. A trademark examining attorney, when confronted with an application for a mark containing a word, must ask a series of questions about that word. For instance, is the word a surname? Is the word a geographic term? Does the word relate to a quality or characteristic of the good? In answering these questions, the examining attorney will ordinarily consult a database of information that exists to describe the world at that moment.¹⁶⁰ If, for instance, the examining attorney consulted a phone book to determine whether a foreign word was a surname, the answer would greatly depend upon immigration trends at that point in time.¹⁶¹ One can easily imagine immigration trends changing and affecting the prevalence of a particular foreign name at a later point in time. Likewise, place names change over time. Mumbai is one of the major cities in the world today but would not have appeared in a

156. Brief on Behalf of Appellant at 50, *In re Tam*, No. 14-1203 (Fed. Cir. Apr. 21, 2014).

157. *Id.*

158. *Id.*

159. See *supra* notes 98–99 and accompanying text (examining the evolution of words and their meanings and changing contextualization).

160. See TMEP, *supra* note 12, § 1203.01 (providing case examples of definitions and standards for reviewing marks).

161. See *id.* § 1211.02(b)(i) (telephone directory listings from telephone books or electronic databases are one type of credible evidence of the surname significance of a term).

database of place names that an examiner could have consulted before the year 1994.¹⁶²

Although the law should be consistently applied, legal doctrines, like language, do not remain static. Legal doctrines must evolve and respond to changes in society. However, where the law stands in any moment should be easily understood and applied, and its application should be reasonably consistent.

A word can be considered offensive based on audience reaction, specific to a time and place. Furthermore, a word may be offensive to one group and not to another.¹⁶³ Similarly, a word may be offensive at one time, but not in another.¹⁶⁴

Judging the offensiveness of a mark, then, is certainly difficult terrain for an examining attorney, but it is navigable. As trademark law has developed, the doctrines require answers to certain questions, such as does the word disparage a significant composite of the referenced group?¹⁶⁵ And does the complainant have standing?¹⁶⁶ But there are other questions that cloud the picture rather than illuminate it. These include: Was the word disparaging at the time of registration?¹⁶⁷ Is the word intended to be offensive?¹⁶⁸ Is the word offensive when used in connection with the particular goods for which it has been applied?¹⁶⁹ Is the word offensive when considered in the context of its marketing?¹⁷⁰ These questions are not appropriate considerations to fulfill the objective of section 2(a).

The bars to registration under section 2(a) for immoral, scandalous, and disparaging marks are easier to apply if the marks containing offensive words are evaluated in the abstract

162. Mumbai, one of the historical names for the city, was officially adopted in 1995, replacing the former, Anglicized name, Bombay. Nilanjana Bhowmick, *The Firebrand Who Renamed Bombay*, TIME (Nov. 17, 2012), <http://world.time.com/2012/11/17/the-firebrand-who-renamed-bombay-bal-thackeray-1926-2012>.

163. See *supra* notes 37–45 and accompanying text (describing whether the mark REDSKINS is disparaging to Native Americans). For instance, although the use of the REDSKINS trademark for football causes great offense to a substantial portion of Native Americans, the racial reference of the mark might appear to go unnoticed by many of the team's fans.

164. See *supra* notes 63–67 and accompanying text (describing how language is not stagnant and words take on new meaning over time).

165. *Harjo I*, 30 U.S.P.Q.2d (BNA) 1828 (T.T.A.B. 1994).

166. *McDermott v. S.F. Women's Motorcycle Contingent*, 240 F. App'x 865 (Fed. Cir. 2007) (per curiam) (affirming dismissal for lack of standing); *Ritchie v. Simpson*, 170 F.3d 1092, 1093–94 (Fed. Cir. 1999) (finding that the appellant had standing to oppose O.J. Simpson's trademark application).

167. *Harjo I*, 30 U.S.P.Q.2d (BNA) at 1831.

168. See *supra* notes 136–55 and accompanying text.

169. See *supra* note 37 and accompanying text.

170. See *supra* note 37 and accompanying text.

rather than in context. This approach would result in more predictable, consistent, and defensible results. It would also better serve the objective of this statutory provision: to deny the benefits of federal registration to those marks that injure the public by causing deep offense.¹⁷¹

171. See *In re Fox*, 702 F.3d 633, 634–35 (Fed. Cir. 2012) (noting the court’s understanding about Congress’s intent that “scandalous marks not occupy the time, services, and use of funds of the federal government”).

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