

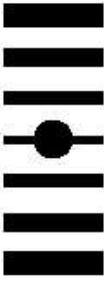
Chapter 6

Grounds for Refusing Registration

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**INTELLECTUAL PROPERTY:
LAW & THE INFORMATION SOCIETY**
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CHAPTER SIX

Grounds for Refusing Registration

Section 1052 of the Lanham Act contains a series of grounds for refusing federal registration of trademarks. We will take its subsections in turn.

1.) 1052(a)

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501 (9) of title 19) enters into force with respect to the United States.

Note: The last clause of 1052(a) was inserted to comply with the TRIPS Agreement. It prohibits geographical indications on wines and spirits that identify a place other than their origin, even if the term is not misleading; “Champagne” cannot be used on sparkling wine unless it comes from Champagne, France. (Or unless the wine was grandfathered in by being used before the relevant date. Hence the excellent Chandon Brut sparkling wine from California may not use the term champagne but Cooks Champagne may.)

i.) Disparaging marks. In June 2014, the Trademark Trial and Appeal Board (TTAB) cancelled the federal registration of six trademarks containing the term REDSKINS—issued between 1967 and 1990—on the basis that they were disparaging to Native Americans in violation of section 1052(a). In an earlier case from 1999, the TTAB found that those same marks were disparaging, but that decision was reversed in 2003 by the United States District Court for the District of Columbia, which held that there was insufficient evidence to support the disparagement finding, and that the claim was barred

by *laches*. The 2014 decision revisited the question of disparagement, using a two-step inquiry: “What is the meaning of the matter in question?” and “Is the meaning of the marks one that may disparage Native Americans?” We will first consider the District Court case and then the more recent TTAB decision.



Pro-Football, Inc. v. Suzan Shown Harjo
284 F.Supp.2d 96 (D.D.C. 2003)

KOLLAR-KOTELLY, District Judge.

Presently before the Court are cross motions for summary judgment in this long-running trademark cancellation case. At issue in this appeal is the decision of the Trial Trademark and Appeal Board (“TTAB” or the “Board”) to cancel six federal trademark registrations involving the professional football team, the Washington Redskins, because it found that the marks “may disparage” Native Americans or “bring them into contempt, or disrepute.” While the national debate over the use of Native American terminology and imagery as depictions for sports teams continues to raise serious questions and arouse the passions of committed individuals on both sides of the issue, the Court’s decision on the motions before it does not venture into this thicket of public policy. Rather, at the summary judgment stage, the Court only assesses the legal sufficiency of the TTAB’s decision. . . . The Court’s conclusions in this case, as to the sufficiency of the evidence before the TTAB and the applicability of the *laches* defense, should not be interpreted as reflecting, one way or the other, this Court’s views as to whether the use of the term “Washington Redskins” may be disparaging to Native Americans. . . . [T]he Court concludes that the TTAB’s decision must be reversed.

WASHINGTON



REDSKINS



Two of the challenged Redskins trademarks. Images from the USPTO trademark record.

II. FACTUAL BACKGROUND

Pro-Football, Inc. (“Pro-Football”), Plaintiff in the current action and Respondent in the trademark action below, holds six trademarks containing the word, or a derivative of

the word, “redskin(s)” that are registered with the Patent and Trademark Office (“PTO”). In September 1992, Suzan Shown Harjo and six other Native Americans (collectively, “Defendants” or “Petitioners”) petitioned the TTAB to cancel the six trademarks, arguing that the use of the word “redskin(s)” is “scandalous,” “may . . . disparage” Native Americans, and may cast Native Americans into “contempt, or disrepute” in violation of section 2(a) of the Lanham Trademark Act of 1946 (“Lanham Act” or “Act”). Pro-Football raised several affirmative defenses in the TTAB action. These included arguments that section 2(a) of the Lanham Act unconstitutionally impinges on First Amendment speech rights, that it also contravenes Fifth Amendment due process rights, and that the Petitioners’ challenge to the trademarks was barred by the equitable defense of laches.

In a pretrial order issued in March of 1994, the TTAB struck each of those defenses. The TTAB dismissed Pro-Football’s constitutional defenses because assessing the constitutionality of a statute is “beyond the Board’s authority.” On April 2, 1999, five years after issuing its pretrial order, the TTAB issued a cancellation order in which it scheduled the cancellation of the contested trademarks. The TTAB based its decision on the conclusion that the trademarks “may be disparaging of Native Americans to a substantial composite of this group of people,” and “may bring Native Americans into contempt or disrepute.”

In its complaint, Pro-Football presents five causes of action supporting its request that the Court overturn the TTAB’s cancellation order. It argues first that the trademarks do not disparage Native Americans and second that they do not bring Native Americans into contempt or disrepute. In the third cause of action, Pro-Football contends that section 2(a) of the Lanham Act violates the First Amendment because it is a vague, overbroad, and content-based restriction on speech. Fourth, it asserts that section 2(a) is unduly vague in violation of the Fifth Amendment. Finally, it argues that the Defendants’ cancellation petition was barred by the doctrine of laches.

a. The Origins of the Trademarks at Issue

Plaintiff Pro-Football, Inc. is a Maryland corporation with its principal place of business in Virginia. Pro-Football is the owner of the Washington Redskins, a professional football franchise located in the Washington, D.C. area, and one of the thirty-two member clubs of the National Football League (“NFL”). On or about July 8, 1932, George Preston Marshall, along with Vincent Bendix, Jay O’Brien, and Dorland Doyle, purchased a then-inactive Boston National Football League franchise. Within the year, his co-owners dropped out and Mr. Marshall was left as the sole owner of the franchise. The Boston team played the 1932 season in Braves Field, home of Boston’s then-National League baseball team, and like the baseball team, were known as “The Braves.” On or about July 8, 1933, Mr. Marshall officially changed the name of his franchise from the “Boston Braves” to the “Boston Redskins.” Mr. Marshall chose to rename his franchise the Redskins in honor of the team’s head coach, William “Lone Star” Dietz, who was a Native American. Around this time, i.e. the 1930’s, the Redskins began to use the marks in commerce. On or about February 13, 1937, the Boston Redskins franchise moved to the Washington, D.C. area and were rechristened the “Washington Redskins.” On or about September 16, 1937, the day of the Redskins’ first game in Washington, D.C., the Redskins began to use the mark “WASHINGTON REDSKINS” in commerce....

[The marks at issue were registered in 1967, 1974, 1978, and 1990. Eds.]

a. The Expert Linguist Testimony

During the proceedings below, Petitioners presented the testimony of Geoffrey

Nunberg, a linguistics expert, while Pro-Football presented the testimony of David Barnhart and Ronald Butters, who also are linguistics experts. The Board then summarized the testimony of these experts. After compiling this summary, the TTAB essentially made five findings of fact regarding the linguists' testimony. These findings of fact are:

1. "There is no dispute among the linguistics experts that the word 'redskin(s)' has been used historically to refer to Native Americans, and is still understood, in many contexts, as a reference to Native Americans."

2. "[F]rom at least the mid-1960's to the present, the word 'redskin(s)' has dropped out of written and most spoken language as a reference to Native Americans."

3. "[F]rom at least the mid-1960's to the present, the words 'Native American,' 'Indian,' and 'American Indian' are used in spoken and written language to refer to Native Americans."

4. "[F]rom at least the mid-1960's to the present, the word 'redskin(s)' appears often in spoken and written language only as a reference to respondent's football team."

5. "The experts agree the evidence of record establishes that, until at least the middle of this century, spoken and written language often referred to Native Americans in a derogatory, or at least condescending, manner and that references to Native Americans were often accompanied by derogatory adjectives and/or in contexts indicating savagery and/or violence." ([N]oting that "[t]here is no dispute that, while many of these usage examples refer to Native Americans as 'Indians,' the word 'Indian' has remained in the English language as an acceptable reference to Native Americans during the second half of this century.")

b. The Survey Evidence

Survey expert Dr. Ivan Ross, President of Ross Research and a former Professor of Marketing and Adjunct Professor of Psychology with the Carlson School of Management of the University of Minnesota testified by deposition in the TTAB proceeding. In March of 1996, Dr. Ross conducted a survey for purposes of this case. Dr. Ross stated that the purpose of the survey was "to determine the perceptions of a substantial composite of the general population and of Native Americans to the word "redskin(s)" as a reference to Native Americans." Dr. Ross surveyed three hundred and one American adults and three hundred and fifty-eight Native American adults. ([O]bserving that both groups included men and women ages 16 and above.) . . .

According to Dr. Ross, the Native American sample reflected "a consistent mix of rural and urban Native Americans; and included both registered members of Indian tribes and non-registered individuals who identified themselves as Native American."

The survey was constructed as follows: Individuals in both population groups were read a list, in varying order, of the following terms: "Native American," "Buck," "Brave," "Redskin," "Injun," "Indian," and "Squaw." With respect to each term, participants were asked whether or not they, or others, would be "offended" by the use of the term and, if so, why. Dr. Ross testified that he chose these terms as representative of a spectrum of acceptability, positing that, in general, "Native American" would be likely to be considered acceptable and "Injun" would be likely to be considered pejorative. Dr. Ross testified that, for the question, he chose the word "offensive" as most likely to reflect, to those unfamiliar with trademark law, the behavioral concepts embodied in the terms "scandalous" and "disparaging" in the trademark law. Dr. Ross stated that asking participants whether others might be offended is an accepted additional means of obtaining the speaker's opinion, based on the assumption that the speaker may be circumspect in answering a direct question.

On the basis of these questions, Dr. Ross found that 46.2% of the general

population sample would be personally offended by the use of the term “redskin” and 36.6% of the Native American population sample would be personally offended by the use of the term “redskin.”

Pro-Football did not conduct its own survey; however, it did provide an expert witness to critique Dr. Ross’s survey. Dr. Jacob Jacoby, a psychologist and expert in the area of marketing and trademark surveys made a number of criticisms. His critique of the questions asked stated that:

- the questions in the survey were leading and not neutral;
- the lists of words referring to Native Americans contained an insufficient number of terms;
- in using the term “offensive” in its questions, the survey did not illicit the necessary information for a determination under section 2(a);
- asking questions about what others think leads to ambiguous results.

[For these reasons among others Dr. Jacoby was led to] conclude that the survey was completely unscientific. In addition, Dr. Jacoby found the survey flawed because it sought the current views of its participants rather than their perceptions during the relevant time period. Finally, Dr. Jacoby observed that the survey was a failure because it did not ascertain the perceptions of those questioned on the use of the word “redskin(s)” in the context of Pro-Football’s entertainment services.

IV. DISCUSSION

A. The Evidence Below is Insufficient to Conclude that During the Relevant Time Periods the Trademarks at Issue Disparaged Native Americans or Brought Them Into Contempt or Disrepute

Essentially, this appeal presents the question of whether the TTAB’s decision that the registered marks “may disparage” Native Americans was supported by “substantial evidence.” Under the section 2(a) of the Lanham Act:

No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

- (a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute. . . .

15 U.S.C. § 1052(a). In reaching its decision, the TTAB concluded that the registrations at issue did not comprise “scandalous matter.” That decision has not been appealed and is not before this Court. The TTAB also conflated the “contempt or disrepute” inquiry with the “disparage” inquiry. In other words, the TTAB concluded that “the guidelines enunciated, in connection with determining whether matter in a mark may be disparaging are equally applicable to determining whether such matter brings ‘persons, living or dead, institutions, beliefs, or national symbols into contempt or disrepute.’” None of the parties argue that the TTAB’s decision to treat “disparage” in the same manner as “contempt or disrepute” was error. Therefore, the Court has not reviewed this legal determination and in assessing the TTAB’s decision, only reviews whether the marks at issue “may disparage” Native Americans, which includes whether the marks bring Native Americans into contempt or disrepute.

Pursuant to section 14 of the Lanham Act “any person who believes that he is or will be damaged by the registration of a mark” may file a petition to cancel a registration

“[w]ithin five years from the date of the registration of the mark,” or “[a]t any time . . . if its registration was obtained fraudulently or contrary to the provisions of . . . subsection (a), (b), or (c) of section 1052 of this title. . . .” 15 U.S.C. § 1064....

2. The TTAB’s Disparagement Conclusion is a Question of Fact

As discussed *supra*, the TTAB’s findings of fact are reviewed under the substantial evidence test. However, while the Court is unable to find any helpful precedent on point, it would appear that, by analogy, there is a dispute in authority as to whether the “ultimate” question about whether a trademark “may disparage” would be treated as one of fact or one of law. The parties have not directly addressed this question in their papers. The Federal Circuit has held that the question of whether a trademark is scandalous under section 2(a) of the Lanham Act is treated as a question of law. *In re Mavety Media Group* (Fed. Cir. 1994) (“The determination that a mark comprises scandalous matter is a conclusion of law based upon underlying factual inquiries. . . . Therefore, while we review the Board’s underlying fact findings for clear error, we review de novo the Board’s ultimate legal conclusion of scandalousness.”). In making this decision, the Federal Circuit analogized to cases involving “likelihood of confusion” scenarios.

The Court’s research reveals, however, that the courts of appeals are split over whether, in the context of “likelihood of confusion” cases, the “ultimate” question as to whether the trademarks are similar is one of fact or of law. The majority view, that the question is a pure question of fact, is considered to be “the better view.” Restatement (Third) of Unfair Competition § 21 cmt. m (1995).

The Court agrees with the majority view. Whether the six trademarks disparage Native Americans is ultimately a fact-bound conclusion that rests with the fact-finder in the first instance....

3. The TTAB’s Findings of Fact

The Court’s review of the TTAB’s findings of fact is limited by necessity given the paucity of actual findings of fact made by the TTAB. Even though it spent fourteen pages cataloging the evidence in the case, the TTAB made specific findings of fact in only two areas: (1) linguists testimony, and (2) survey evidence....

b. TTAB’s Findings Regarding Dr. Ross’s Survey

The Board basically made three findings of fact regarding this survey evidence. First, the Board found that the survey methodology was sound. Second, the TTAB found that the survey was nothing more than “a survey of current attitudes as of the time the survey was conducted.” Finally, the Board concluded that the survey adequately represents the views of the two populations sampled.

First, the Court finds that there is substantial evidence for the narrow conclusion that the survey represents nothing more “than a survey of current attitudes at the time the survey was conducted.” This fact does not appear disputed by either side and therefore it would be difficult for the Court to conclude that this conclusion was not supported by substantial evidence.

In regard to the TTAB’s decision that the survey methodology used was appropriate, the Court finds that there is substantial evidence to show that this methodology supported a survey that did nothing more “than survey . . . current attitudes.” [Rather than attitudes at the time the trademarks were registered. Eds.] However, to the extent that the TTAB’s finding purported to hold that the methodology was proper to extrapolate the survey results to the Native American population at large, the Court must disagree that substantial evidence supports this conclusion.

The Court concludes that the TTAB’s decision to extrapolate the results of the Ross

Survey to the Native American population as a whole was not supported by substantial evidence. Critiques by Dr. Jacoby went unanswered in the TTAB opinion. Conclusory statements such as “no survey is perfect” do not assist the Court in understanding the basis for accepting Dr. Ross’s decision to extrapolate his results to the Native American population as a whole. Indeed, counsel at the July 23, 2003, motions hearing came up with the extrapolation figure on the spot by doing “plain arithmetic” based on information not in the record. For all of these reasons, the Court concludes that the decision of the TTAB to extrapolate the Ross Survey results to the Native American population as a whole is not supported by substantial evidence....

b. The Meaning of “May Disparage”

After acknowledging the dearth of precedent to guide their hand in interpreting the disparagement clause of section 2 the TTAB approached the task as it would a charge of scandalousness under section 2(a). No party disputes this approach and the Court finds no error in treating the two as similar for purposes of developing a conceptual framework.

The TTAB first defined the term “disparage” in accordance with the ordinary and common meaning of the term. From this review, the Board concluded that the trademarks may disparage if they may “dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison.” The Board then observed that unlike the inquiry into whether a trademark is scandalous, where the test looks to the reaction of American society as a whole, a disparagement test is much more circumscribed and is limited by section 2(a) of the Lanham Act. The TTAB stated that “it is only logical that in deciding whether the matter may be disparaging we look, not to American society as a whole, . . . but to the views of the referenced group.” The views of the referenced group, the Board concluded, are “reasonably determined by the views of a substantial composite thereof.” To determine the referenced group, the TTAB adopted the test from *In re Hines*, which looks to “the perceptions of ‘those referred to, identified or implicated in some recognizable manner by the involved mark.’” (“In determining whether or not a mark is disparaging, the perceptions of the general public are irrelevant. Rather, because the portion of section 2(a) proscribing disparaging marks targets certain persons, institutions or beliefs, only the perceptions of those referred to, identified or implicated in some recognizable manner by the involved mark are relevant to this determination.”). As the parties have not objected to this approach and because this approach is often used in cancellation proceedings, the Court does not find legal error in applying it to this proceeding.

In addition, the TTAB concluded that the addition of the term “may” before the word “disparage” in the Lanham Act was to “avoid an interpretation of this provision which would require an intent to disparage.” ([N]oting that such an interpretation shifts the focus to whether the matter may be perceived as disparaging.) This conclusion is also not disputed by the parties.

c. Determining if a Trademark is Disparaging

The Court concludes that the TTAB correctly stated the test for disparagement and neither of the parties specifically dispute this approach. The Board stated:

[O]ur analysis is essentially a two-step process in which we ask, first: What is the meaning of the matter in question, as it appears in the marks and as those marks are used in connection with the services identified in the registrations? Second, we ask: Is this meaning one that may disparage Native Americans? As previously stated, both questions are to be answered as of the dates of registration of the marks herein.

Since the oldest trademark in this case was issued in 1967 and the newest was issued in 1990, the Board “focus[ed its] determination of the issue of disparagement on the time periods, between 1967 and 1990, when the subject registrations issued.” None of the parties contest this approach and the Court finds no error in the TTAB’s articulation of this test for disparagement.

5. The TTAB’s Finding of Disparagement

The Court concludes that the TTAB’s finding that the marks at issue “may disparage” Native Americans is unsupported by substantial evidence, is logically flawed, and fails to apply the correct legal standard to its own findings of fact. With no material facts in dispute, the Court finds that Defendants’ motion for summary judgment must be denied, and that Pro-Football’s motion must be granted as to the Counts I and II of the Complaint. . . . As the Court has no need to reach the constitutional claims raised by Pro-Football, these claims are rendered moot.

.....

In 2014, the TTAB again addressed the question—using much the same body of evidence as considered in the *Harjo* case.



Amanda Blackhorse v. Pro-Football, Inc.

111 U.S.P.Q.2d 1080 (T.T.A.B. 2014)

KUHLKE, Administrative Trademark Judge.

As noted above, as was found in the *Harjo* case, both by the Board and the District Court, and conceded by respondent, “the meaning of the matter in question,” retains the core meaning Native American when used as the name of respondent’s sports team. More specifically, the term “redskin(s)” as used by respondent in its registered marks when used in connection with professional football retains the “likely meaning” Native Americans. Much of respondent’s evidence is directed to the first part of the test. Respondent’s argument regarding “secondary meaning” in the sense that it has “a secondary or alternate meaning” denoting a football team, is not persuasive in that the “secondary meaning” has not stripped the word “redskins” of its “ethnic” meaning. See *Squaw Valley* (Squaw Valley ski resort meaning of squaw is “likely meaning” “rather than the meaning of Native American woman or wife”).

We turn then to the second question, “was the meaning one that may have disparaged” a substantial composite, which need not be a majority, of Native Americans, at the times of the registrations. The crux of this case is whether or not this record supports petitioners’ contention that the answer to that question is yes. Respondent contends that it does not and characterizes the record as, at most, showing a handful of individuals (the *Harjo* petitioners, the current petitioners, the letter writers, a few individuals from various organizations) who have their own individual opinion. Such a characterization, however, ignores, and is contradicted by the substantial evidence of record.

NCAI [the “National Council of American Indians”] Resolution 93-11 represents the views of a substantial composite of Native Americans. NCAI consists of member tribes from across the United States and they voice their collective opinion through the Executive Council by resolutions. A resolution from the oldest Native American organization composed of tribes from across the United States and structured in a manner to represent the collective opinion of its membership through resolutions is strong evidence of the views of Native Americans. The NCAI members throughout the relevant time period represent approximately 30 percent of Native Americans. . . .

The trend in dictionary usage labels also corroborates the time frame of objections from Native Americans starting in the late sixties and continuing through the nineties as lexicographers begin and finally uniformly label the term as “offensive” or “disparaging.” The recognition that this racial designation based on skin color is disparaging to Native Americans is also demonstrated by the near complete drop-off in usage of “redskins” as a reference to Native Americans beginning in the 1960’s.

The record establishes that, *at a minimum*, approximately thirty percent of Native Americans found the term REDSKINS used in connection with respondent’s services to be disparaging at all times including 1967, 1972, 1974, 1978 and 1990. Section 2(a) prohibits registration of matter that disparages a substantial composite, which need not be a majority, of the referenced group. Thirty percent is without doubt a substantial composite. To determine otherwise means it is acceptable to subject to disparagement 1 out of every 3 individuals, or as in this case approximately 626,095 out of 1,878,285 in 1990. There is nothing in the Trademark Act, which expressly prohibits registration of disparaging terms, or in its legislative history, to permit that level of disparagement of a group and, therefore, we find this showing of thirty percent to be more than substantial.

Respondent has introduced evidence that some in the Native American community do not find the term “Redskin” disparaging when it is used in connection with professional football. While this may reveal differing opinions within the community, it does not negate the opinions of those who find it disparaging. The ultimate decision is based on whether the evidence shows that a substantial composite of the Native American population found the term “Redskins” to be disparaging when the respective registrations issued. *Heeb Media LLC*. Therefore, once a substantial composite has been found, the mere existence of differing opinions cannot change the conclusion.

In view of the above, petitioners have shown by a preponderance of the evidence that a substantial composite of Native Americans found the term REDSKINS to be disparaging in connection with respondent’s services during the relevant time frame of 1967–1990. Accordingly, the six registrations must be cancelled as required under Sections 2(a) and 14(3) of the Trademark Act.

BERGSMAN, Administrative Trademark Judge, dissenting.

I respectfully dissent from the majority’s decision to grant the petition on the claim of disparagement because the dictionary evidence relied upon by the majority is inconclusive and there is no reliable evidence to corroborate the membership of National Council of American Indians.

To be clear, this case is not about the controversy, currently playing out in the media, over whether the term “redskins,” as the name of Washington’s professional football team, is disparaging to Native Americans today. The provisions of the statute under which the Board must decide this case—§§ 2(a) and 14(3) of the Trademark Act, 15 U.S.C. §§ 1052(a) and 1064(3)—require us to answer a much narrower, legal question: whether the evidence made of record in this case establishes that the term

“redskins” was disparaging to a substantial composite of Native Americans at the time each of the challenged registrations issued. See generally *Consortio del Prosciutto di Parma v. Parma Sausage Prods.* (TTAB 1992) (discussing the language of Lanham Act § 14(3) and explaining that the “registration was obtained” language Congress used to specify when a registration for a mark may be cancelled under the enumerated statutory provisions, such as § 2(a), “shows an intent that only if it should not have issued in the first place should a registration more than five years old be cancelled”).

The new petitioners here have filed a petition to cancel the same registrations on one of the same grounds asserted in the *Harjo* cancellation proceeding originally filed with the Board. Not only is this claim the same as one in the *Harjo* cancellation proceeding, but the evidence relating to whether the term “redskins” was disparaging to Native Americans during the relevant time period predominantly is the same as well. As noted by the majority, in this case the new petitioners re-submitted most of the same evidence that the *Harjo* petitioners submitted—evidence which the district court previously ruled was insufficient to support an order to cancel the challenged registrations as disparaging. . . .

Thus, beyond the statutory constraint that the Board can decide only whether the marks can remain registered, the Board’s decision also is constrained by the evidence placed before it. The new petitioners in this proceeding made the decision to simply re-use the trial record from the previous *Harjo* litigation, without substantial augmentation. The D.C. Circuit Court of Appeals did not overturn the district court’s ruling in *Harjo II* that the evidence introduced at the Board in the *Harjo* cancellation proceeding was insufficient to support the Board’s decision in that case. Nor has the passage of time aided what could be described as a stale record. The consequence of petitioners’ decision to rely on the same evidence previously found insufficient to support cancellation without substantial augmentation is that the evidence before the Board in this case remains insufficient as well.

By this dissent, I am not suggesting that the term “redskins” was not disparaging in 1967, 1974, 1978, and 1990 (the registration dates at issue). Rather, my conclusion is that the evidence petitioners put forth fails to show that it was.

Questions:

1.) The TTAB decision is being appealed. Will it be reversed or upheld? Why?

2.) If the TTAB decision is upheld, what are the practical effects? Are the Washington Redskins *forbidden* from using the mark? May others now use the mark without payment? How does that exert pressure on the Redskins? Remember, the loss of a Federally registered mark leaves behind common law marks—both state marks and Federal protection under section 1125(a).

3.) Any standard to adjudicate 1052(a) cancellation of disparaging marks has to answer the central “what, who, how many and when” questions.

a.) **”What”?** The TTAB and the District Court agreed that the meaning of the word “Redskins” was to refer to Native Americans. It rejected an argument that that term had dropped out of usage and that the primary significance of the term was now its reference to the team. Do you agree? If you heard the word in a conversation, e.g. “How about those redskins?” what or who would you assume it referred to? Does it matter, so long as some people find the term offensive? Is the stylized Native American featured on the logo important to the analysis of the word mark?

b.) **”Who”?** Whose view of whether a mark is disparaging is relevant? The TTAB and the District Court believed it was those who believed they were being disparaged. Do you agree? And who has standing to oppose registration of a mark? The TTAB said that the

plaintiffs must have a “real interest”—meaning “a legitimate personal interest”—in the outcome of the proceeding. The five Native American plaintiffs, all of whom found “redskins” disparaging, readily met that standard. *Amanda Blackhorse et al v. Pro-Football, Inc.* (TTAB 2014). Do you agree? Does this meet the Article 3 threshold for standing?

c.) **”How many”?** How many members of a group need to find the mark disparaging in order to satisfy the standard for cancellation? The TTAB found that when 30% of a group finds a term disparaging, this is a “substantial composite” sufficient to prohibit federal registration. Is this threshold high? Low? What kind of evidentiary showing should be required?

d.) **”When”?** The court and the TTAB agreed that the relevant date at which the finding of disparagement had to be made was at the time of registration, which in the case of the earliest mark was 1967. Do you agree that is the relevant time frame? What if a mark we find wildly offensive today had been registered when the term was regarded as respectable? Should it be subject to cancellation nevertheless?

4.) A 2010 case prevented registration of KHORAN for wine because the term would be recognized as referring to the Koran, and its use on wine disparaged the beliefs of Muslim Americans. *See In re Lebanese Arak Corp.*, 94 USPQ2d 1215 (TTAB 2010). Sound?

Courts that have considered the constitutionality of §1052(a) denials have uniformly held that there was no restriction of freedom of speech: individuals were still free to *use* a name, but without trademark protection. In the first edition of this casebook we argued that this definitional answer was an unsatisfying one and that courts would eventually need to confront the issue. In *In re Tam*¹, an April 2015 case, the Federal Circuit considered an appeal to the denial of registration for “The Slants,” the name of an Asian-American band who had chosen this name, they said, to highlight the importance of confronting stereotypes and slurs about Asian-Americans. The registration was denied because the examiner considered the name disparaging to people of Asian descent. Writing for a unanimous panel, Judge Kimberly Moore upheld the denial of registration. In the process she considered The Slants’ First Amendment challenge and had this to say about it.

“This argument is foreclosed by our precedent. In *In re McGinley*, our predecessor court wrote: ‘With respect to appellant’s First Amendment rights, it is clear that the PTO’s refusal to register appellant’s mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant’s First Amendment rights would not be abridged by the refusal to register his mark.’ 660 F.2d 481, 484 (C.C.P.A. 1981). In subsequent cases, we have accepted this reasoning.”

However, immediately after the order confirming the refusal of registration, Judge Moore added an opinion merely titled “Additional Considerations” that invited the *en banc* court to *reconsider* those prior precedents.

“It is time for this Court to revisit *McGinley*’s holding on the constitutionality of § 2(a) of the Lanham Act. Under § 2(a), the PTO may refuse to register immoral, scandalous, or disparaging marks. 15 U.S.C. § 1052(a). In *In re McGinley*, our predecessor court held without

¹ *In re Tam*, 2015 WL 1768940. (Mr. Tam is the “front man” of The Slants.)

citation to any legal authority in just a few sentences that § 2(a) does not implicate the First Amendment. More than thirty years have passed since *McGinley*, and in that time both the *McGinley* decision and our reliance on it have been widely criticized. Furthermore, First Amendment jurisprudence on the ‘unconstitutional conditions’ doctrine and the protection accorded to commercial speech has evolved significantly since the *McGinley* decision. In 1991, the source of the PTO’s funding shifted from the taxpayers to application fees. The constitutionality of § 2(a) is an important and timely issue that raises a number of constitutional questions. The time has come to give this issue the consideration it is due. . . . Neither the court in *McGinley* nor any other court has analyzed § 2(a) under the ‘unconstitutional conditions’ doctrine. This is error. Federal trademark registration confers valuable benefits, and under § 2(a), the government conditions those benefits on the applicants’ choice of a mark. Because the government denies benefits to applicants on the basis of their constitutionally protected speech, the ‘unconstitutional conditions’ doctrine applies.

“However, we are faced with a fundamental predicate question: does the ‘unconstitutional conditions’ doctrine apply with full force in the context of trademark registration, or is it tempered by virtue of Congress’ spending power? The benefits of trademark registration, while valuable, are not monetary. Unlike tangible property, a subsidy, or a tax exemption, bestowal of a trademark registration does not result in a direct loss of any property or money from the public fisc. Rather, a trademark redefines the nature of the markholder’s rights as against the rights of other citizens, depriving others of their rights to use the mark. Like the programs in *Bullfrog* and *Texas Lottery Commission*, the system of trademark registration is a regulatory regime, not a government subsidy program. Furthermore, the act of registering a trademark does not involve the federal treasury. In 1981, as noted by the *McGinley* court, trademark registration was ‘underwritten by public funds.’ 660 F.2d at 486. That is no longer true today. Since 1991, PTO operations have been funded entirely by registration fees, not the taxpayer.”

The Federal Circuit has accepted that challenge and is rehearing the case *en banc*. However, Judge Moore’s “Additional Considerations” also point out one possible distinguishing point between The Slants and the Redskins.

“While it may be true that many marks are used solely as a source identifier, that is not the case here. Mr. Tam’s mark THE SLANTS does more than merely identify the band in the commercial arena. In *Friedman*, the Court reasoned that the optician seeking the trade name ‘does not wish to editorialize on any subject, cultural, philosophical, or political. He does not wish to report any particularly newsworthy fact, or to make generalized observations even about commercial matters.’ 440 U.S. at 11. Here, by contrast, Mr. Tam seeks to trademark the name of a musical group, selecting the name ‘The Slants’ to ‘reclaim’ and ‘take ownership’ of Asian stereotypes. The band draws inspiration for its lyrics from childhood slurs and mocking nursery rhymes, and its albums include ‘The Yellow Album’ and ‘Slanted Eyes, Slanted Hearts.’ The band ‘feel[s] strongly that Asians should be proud of their cultural

heritage, and not be offended by stereotypical descriptions.’ With their lyrics, performances, and band name, Mr. Tam and The Slants weigh in on cultural and political discussions about race and society that are within the heartland of speech protected by the First Amendment.”

Can the Redskins football team claim that they used the name to *honor* Native Americans or are they foreclosed by their prior arguments? Does this line of thought lead to the ironic conclusion that a company which chose a slur deliberately—either to mock or to honor a particular group—would receive greater protection than one who “just thought the name sounded cool”? Does it matter what the owner of the putative mark intended if the government is denying a benefit for a speech-related reason?

PROBLEM 6-1

Does 1052(a) abridge the freedom of speech in a way that violates the First Amendment? Consider these materials in developing your answer.

As Judge Moore notes, courts that have considered the issue have so far held that there are no First Amendment problems with § 1052(a). Their argument is that “the refusal to register a mark does not proscribe any conduct or suppress any form of expression because it does not affect the applicant’s right to use the mark in question.” *In re Boulevard Entertainment, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003). Because the Redskins are free to go on using the mark (but without the benefits of Federal Registration) courts have held that there is no impermissible restriction of the right to speak. Do you agree? If the US Post Office gives a preferential mailing rate to newspapers, may it restrict that rate to newspapers that espouse tolerance? May it deny the rate to offensive or disparaging newspapers? Consider the following analysis.

[I]t is clear that section 2(a) of the Lanham Act is a selective denial of a government benefit (trademark registration) to a particular means of communication on the basis of content. The government benefit, granted to inoffensive trademarks but denied to scandalous or disparaging trademarks, is the right to prevent others from using the trademarked word, term, name, or symbol in commerce. Thus, the commercial value of the speech, not expression of the speech itself, is burdened by section 2(a)’s content discrimination. However, the proposition that government may financially burden speech on the basis of its content was unanimously rejected by the Supreme Court in *Simon & Schuster, Inc. v. Members of the New York State Crime Victims Board*. Schuster decision invalidated New York’s “Son of Sam” law. Under the “Son of Sam” law, any publisher, if contracting with an accused or convicted criminal for a literary work relating to the author’s crimes, had to pay royalties ordinarily due the criminal into a special escrow account. This escrow account was reserved to satisfy civil judgments against the criminal brought by his or her victim within five years. The “Son of Sam” law prohibited no speech. . . . Nonetheless, the Court characterized the law as one that “plainly imposes a financial disincentive only on speech of a particular content.” According to the Court, government control of the right to profit from speech raised the same concerns as government control of the right to speak itself: “[T]he government’s ability to impose content-based

burdens on speech raises the specter that the government may effectively drive certain ideas or viewpoints from the marketplace. The First Amendment presumptively places this sort of discrimination beyond the power of the government.” . . . [S]ection 2(a) places a financial burden on scandalous and disparaging trademarks on the basis of their content. As this exercise of government power has the potential to drive particular forms of expression from the marketplace, it must be subjected to First Amendment scrutiny.

Jeffrey Lefstin, *Does the First Amendment Bar Cancellation of REDSKINS?* 52 Stan. L.Rev. 665 (February 2000).

Do you agree with Mr. Lefstin’s analogy of § 1052(a) denials to the *Simon & Schuster* case? What distinctions can you draw here? Was the content at issue in *Simon & Schuster* “commercial speech” – not speech from which someone makes money, but an entity communicating directly in the marketplace about products and services? Even if § 1052(a) is subject to First Amendment analysis, does it pass muster because it is the regulation of commercial speech, which is subject to a lower level of scrutiny? Commercial speech can be regulated without violating the First Amendment if:

1. The regulated speech is related to illegal activity, **or**
2. The speech is misleading, **or**
3. The government has a substantial interest in restricting the speech, the regulation in question directly advances that interest, **and**
4. The law in question is narrowly tailored to serve the governmental interest.

The general structure of the Lanham Act’s prohibitions aimed at preventing likelihood of confusion, deception, mistake, and false commercial statements of fact clearly passes muster under the second prong or alternatively the third and fourth prongs of this test. Does the prohibition of disparaging speech do so? Is *SFAA v USOC* of any use here?

Is § 1052(a)’s disparagement provision content-based regulation or viewpoint-based regulation? (The latter is subject to a much higher constitutional burden.) Does the question of how “disparaging” is defined and determined in practice – as laid out in the cases above – help you answer that question? Would the Redskins be able to register “The Washingtolerants,” the “DC Anti-Discriminators” or the “Capitol Kumbayas”? May the government require tolerance as the “price” for a mark? Is the “may disparage” standard, with no requirement of intent and no definitive guideline on what counts as disparaging, void for vagueness?

Is *Rust v Sullivan*, 500 U.S. 173 (1991), of any use here? In that case, the rules at issue were Health and Human Services regulations that forbade, among other things, medical entities receiving governmental funds for family planning services from discussing abortion as one of the options available to its patients. The regulations specifically forbade them from providing information about abortion providers, or the desirability of abortion, even upon direct request. Justice Rehnquist, writing for the majority, rejected a First Amendment challenge. The case was complex, but the heart of the majority’s First Amendment analysis was that the government itself was speaking (and paying others to speak). Having paid the piper, it could call the tune. In *Tam*, however, Judge Moore suggests that the reliance on fees rather than general tax revenue for trademark registration may undercut that argument. Is the government itself “speaking” through a registered mark and choosing to “subsidize” only non disparaging speech? If so, would that accord it greater leeway? Or does this lead to a slippery slope of remarkable steepness?

ii.) Marks that falsely suggest a connection to persons. In addition to disparaging marks, § 1052(a) also prohibits marks that “falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols.” Note that this is different from disparagement – falsely suggesting a connection need not be disparaging. It is also distinct from § 1052(c)’s prohibition on using names of particular living individuals, and § 1052(e)’s prohibition on marks that are “primarily merely a surname” (both discussed below). The provision barring false associations with “persons” emerged from the concepts of rights of publicity and privacy. It only precludes registration when, among other things, “the plaintiff’s name or identity is of sufficient fame or reputation that when the defendant’s mark is used on its goods or services, a connection with the plaintiff would be presumed.” So, for example, BO BALL with a baseball/football design could not be registered because it falsely suggested a connection with the famous athlete Bo Jackson, but DA VINCI could be registered for jewelry and leather giftware because reasonable buyers would not assume a connection between Leonardo Da Vinci and the trademark owner’s products.² The descendants of Crazy Horse, the Native American leader who strongly opposed alcohol use by his people, have objected to the use of his name on “Crazy Horse Malt Liquor.” If they opposed a federal registration of “Crazy Horse Malt Liquor” on disparagement grounds, would they succeed? What would they need to show? What if they opposed a “Crazy Horse Gentleman’s Club” mark for a domestic franchise of France’s famous “Crazy Horse” nude revue?

iii.) Immoral or scandalous marks. To determine whether a mark is too immoral or scandalous to be registrable, courts look at whether a “substantial composite” of the public views it as vulgar or offensive. Courts have held that terms such as BULLSHIT and JACK-OFF have obvious vulgar meanings. But what if the mark in question is capable of multiple meanings? Compare the two opinions below.

² See *In re Sauer*, 27 U.S.P.Q.2d 1073 (T.T.A.B. 1993), *aff’d*, 26 F.3d 140 (Fed. Cir. 1994); *Lucien Piccard Watch Corp. v. Crescent Corp.*, 314 F. Supp. 329 (S.D.N.Y. 1970).



In re Marsha Fox

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

DYK, Circuit Judge.

The mark at issue here has two parts: a literal element, consisting of the words COCK SUCKER, and a design element, consisting of a drawing of a crowing rooster. Since 1979, Fox has used this mark to sell rooster-shaped chocolate lollipops. . . . The consumers targeted by Fox’s business are, primarily, fans of the University of South Carolina and Jacksonville State University, both of which employ gamecocks as their athletic mascots. . . .

[T]he association of COCK SUCKER with a poultry-themed product does not diminish the vulgar meaning—it merely establishes an additional, non-vulgar meaning and a double entendre. This is not a case in which the vulgar meaning of the mark’s literal element is so obscure or so faintly evoked that a context that amplifies the non-vulgar meaning will efface the vulgar meaning altogether. Rather, the mark is precisely what Fox intended it to be: a double entendre, meaning both “rooster lollipop” and “one who performs fellatio.” . . .

[T]here is no requirement in the statute that a mark’s vulgar meaning must be the only relevant meaning—or even the most relevant meaning. Rather, as long as a “substantial composite of the general public” perceives the mark, in context, to have a vulgar meaning, the mark as a whole “consists of *or comprises* . . . scandalous matter.” . . . We therefore see no reason why the PTO is required to prove anything more than the existence of a vulgar meaning to a substantial composite of the general public in order to justify its refusal. . . .

[T]he outcome of our decision is that Fox will remain free to use her mark in commerce. She will be unable, however, to call upon the resources of the federal government in order to enforce that mark.



Image from the USPTO Trademark record.



In re Hershey

6 U.S.P.Q.2d 1470 (T.T.A.B. 1988)

KRUGMAN, Administrative Judge.

While the Examining Attorney has demonstrated that “pecker” is a slang expression for penis, one reference, The American Thesaurus of Slang, bears a 1947 copyright notice indicating that said reference is over forty years old. The more recent reference, the 1975 edition of The Dictionary of American Slang, indicates that use of the term “pecker” meaning penis is rapidly becoming archaic. . . . [Dictionary] evidence, standing alone, is at best marginal to demonstrate that the mark is a vulgar, slang reference to male genitalia and would be recognized as such a reference by a substantial composite of the general public. Moreover, applicant has demonstrated from dictionary definitions of “pecker” that its primary meanings to the public are innocuous, namely, one that pecks, a woodpecker or a bird’s bill. In addition, while not part of the mark sought to be registered, the specimens of record comprise labels showing a design of a bird appearing below the mark. . . . We conclude, therefore, that the term “BIG PECKER BRAND” is, at most, a double entendre, one meaning of which may be a vulgar reference to male genitalia. However, considering the relative paucity of evidence concerning the public’s perception of “pecker” as referring to penis and considering the bird head design on the specimens reinforcing the more conventional meaning of the term, we believe the mark neither offends morality nor raises scandal, and we reverse the refusal of registration under Section 2(a).

PROBLEM 6-2

Hooters is often held up as the oldest example of a restaurant subgenre dubbed “Breastaurants”—defined by Wikipedia as “a restaurant that has sexual undertones, most commonly in the form of large-breasted, skimpily-dressed waitresses and barmaids and *double-entendre* brand name.” (Others include the Tilted Kilt, Twin Peaks, Bone Daddy’s, and Mugs & Jugs.) Hooters, on the other hand, has sometimes referred to itself as “a family restaurant.” HOOTERS owns numerous trademarks including the term HOOTERS and the image of the owl peering through the “OO,” first registered in 1985 (Owls hoot).



Does the federal registration of the HOOTERS mark comply with 1052(a)? Is it scandalous and immoral? Disparaging? Does your answer only go to the word mark, or to the combination of word and logo? Both?

Your analysis will require you to answer the following:

1.) What is the meaning of “Hooters”? Does the owl image make a difference? Positive or negative? Would the reasoning of the *Fox* court and the *Hershey* TTAB decision provide different answers?

2.) Did a “substantial composite” of the public or a particular group (which?) find the term immoral, scandalous, or disparaging when it was registered?

3.) Who would have standing to challenge? The courts have been relatively generous with standing in the context of cases alleging marks are immoral or scandalous, just as they are in the disparaging marks cases. In *Bromberg v. Carmel Self Service, Inc.*, 198 U.S.P.Q. 176 (T.T.A.B. 1978), the TTAB held that two women had standing to oppose a registration application of ONLY A BREAST IN THE MOUTH IS BETTER THAN A LEG IN THE HAND for restaurant services on grounds that the mark was immoral and scandalous, and disparaging to women, even though they were not in the restaurant business and pleaded no commercial injury; they needed merely to be “members of a group who may *believe* the mark to be scandalous.” (Emphasis added.) Is this enough to meet a constitutional standing requirement?

iv.) Deceptive marks. A deceptive mark can never be registered, unlike “deceptively misdescriptive” marks (see the discussion of § 1052(e) below), which can be registered upon acquiring secondary meaning. A mark is deceptive if its misrepresentation materially affects purchasing decisions. LOVEE LAMB for car seat covers made entirely of synthetic fibers and WHITE JASMINE for tea that contained no white tea were found to be deceptive because they were likely to affect the purchasing decisions of customers who wanted sheepskin seats, or the purported health benefits of white tea.³

2.) 1052(b)

Consists 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, or any simulation thereof.

Flags and other government insignia. Section 1052(b) denies registration to a mark that “consists 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, or any simulation thereof.” Government “insignia” is a narrow category, and only includes “specific designs formally adopted to serve as emblems of governmental authority,” such as flags and official seals.⁴ Other national symbols, such as the Statue of Liberty or the Capitol building, may be part of a registered mark, as long as the mark does not falsely suggest a connection with the government in violation of § 1052(a).⁵ What is the policy behind keeping core “emblems of governmental authority” from serving as registered trademarks, but allowing the registration of other national symbols?

³ See *In re Budge Mfg. Co.*, 857 F.2d 773 (Fed. Cir. 1988); *In re White Jasmine LLC*, 106 U.S.P.Q.2d 1385 (T.T.A.B. 2013).

⁴ *Trademark Manual of Examining Procedure* § 1204.

⁵ *Liberty Mut. Ins. Co. v. Liberty Ins. Co. of Tex.*, 185 F. Supp. 895 (E.D. Ark. 1960) (Liberty Mutual Insurance Company had a valid registration of a mark using the Statue of Liberty); *Heroes, Inc. v. Boomer Esiason Hero’s Foundation, Inc.*, 43 U.S.P.Q.2d 1193 (D.D.C. 1997) (charity had a valid registration for a mark that included an image of the Capitol building).

Government entities are also precluded from registering official insignia as trademarks.⁶ Outside of this narrow prohibition, however, the government owns many marks. In the wake of recent wars, there has been an uptick in trademark registrations by the Marines and other armed forces, along with efforts to protect their brands. The Navy successfully objected to Disney’s efforts to trademark the name SEAL TEAM 6. The Marines have objected to uses ranging from Marine-themed toilet paper called “Leatherneck Wipes” to a Star Trek fan site called “Starfleet Marine Corps Academy” that used the Marine Eagle (the website could keep the name but had to remove the eagle). They have also objected to uses by veterans—for example, a veteran who started a company called *Semper Fidelis* Garage Doors was required to remove the Marine emblem from his trademark. Who should have the exclusive right to use something like the Marine emblem as a source indicator? The government? Veterans? Disney? Entrepreneurs who successfully associate it with a product?

3.) 1052(c)

Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

Names and portraits of living individuals. Section 1052(c) bars the registration of a mark that “consists of or comprises a name, portrait, or signature identifying a particular living individual” or “deceased President of the United States during the life of his widow,” unless there is written consent. (Does this language need to be amended if Ms. Clinton becomes president?) This section only applies when “the person is so well known that the public would assume a connection or there will be an association of the name and the mark as used on the goods because the individual is publicly connected with the field in which the mark is being used.”⁷ For example, registration of the marks OBAMA PAJAMA, OBAMA BAHAMA PAJAMAS and BARACK’S JOCKS DRESS TO THE LEFT was rejected because they clearly identified President Obama.⁸ By contrast, the authors of this casebook do not have § 1052(c) claims against BOYLES or JENNIFER HOME FURNITURE, both registered marks for furniture stores, because the public would not associate them with those trademarks.

4.) 1052(d)

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

⁶ *In re City of Houston*, 101 U.S.P.Q.2d 1534 (T.T.A.B. 2012) (Houston could not register its city seal).

⁷ *Ross v. Analytical Technology Inc.*, 51 U.S.P.Q.2d 1269 (TTAB 1999) (James W. Ross, Jr. was sufficiently well-known in the field to bar registration of ROSS for electrochemical analysis equipment).

⁸ *In re Richard M. Hoefflin*, 97 U.S.P.Q.2d 1174, 2010 WL 5191373 (T.T.A.B. 2010).

Confusingly similar to existing marks. Section 1052(d) provides that a mark cannot be registered if it is likely to cause confusion with another active mark, though concurrent registration may be allowed in limited circumstances based on good faith prior use. The test for likelihood of confusion at the registration stage is the same as that used for infringement, and is explored in detail elsewhere in this book. Students who enter trademark practice after graduation will spend considerable time assessing whether marks proposed for registration are likely to cause confusion with existing marks.

5.) 1052(e)

Consists of a mark which

- (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them,
- (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title,
- (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them,
- (4) is primarily merely a surname, or
- (5) comprises any matter that, as a whole, is functional.

Section 1052(e) precludes registration of a mark that is: functional; merely descriptive or “deceptively misdescriptive”; “primarily geographically descriptive” or “primarily geographically deceptively misdescriptive”; or “primarily merely a surname.” However, marks within some of these categories can become registrable after they acquire distinctiveness (see § 1052(f) below).

i.) § 1052(e) “deceptively misdescriptive” v. § 1052(a) “deceptive.” Marks that are *functional* or *merely descriptive*, and the reasons they are ineligible for protection, have already been discussed elsewhere in this chapter. But what about deceptively misdescriptive marks? Like merely descriptive marks, these marks describe their products in a way that falls short of being suggestive; however, the description is misleading. The mark TITANIUM for RVs might be “merely descriptive” if the vehicles are made of titanium, but is “deceptively misdescriptive” if the RVs do not contain titanium.⁹ The test is “(i) whether the mark misdescribes the goods to which it applies; and (ii) whether consumers are likely to believe the misdescription.”¹⁰ If the misdescription is one that materially affects purchasing decisions—for example, if consumers purchased TITANIUM RVs *because* they thought they were made of titanium—then the mark goes beyond being deceptive misdescriptive and is flat out “deceptive” under § 1052(a). The distinction between “deceptive” under § 1052(a) and “deceptively misdescriptive” under § 1052(e) is important because deceptive marks are never registrable, while deceptively misdescriptive marks can be registered if they acquire distinctiveness (see § 1052(f) below).

ii.) Primarily geographically descriptive, or geographically deceptively

⁹ See *Glendale Intern. Corp. v. U.S. Patent & Trademark Office*, 374 F. Supp. 2d 479 (E.D. Va. 2005) (registration of TITANIUM for RVs that were not made of titanium was properly rejected).

¹⁰ *Id.*

misdescriptive. For a mark to be geographically descriptive, consumers must assume that the goods or services originated from the place designated in the mark. So, for example, CALIFORNIA PIZZA KITCHEN was found geographically descriptive. “[E]ven if applicant may have opened a branch of its restaurant outside of California, we believe customers encountering this out-of-state restaurant would believe that the services originated in California. It should be noted that restaurant services would include the restaurant concept, menu, recipes, etc., and even though a customer in Atlanta, Georgia would obviously recognize that the particular branch of the restaurant was physically located outside of California, he would be likely to assume that the restaurant services such as the concept, recipes and even possibly the food originated in the state of California. Thus, we believe that the primary significance of “CALIFORNIA” in applicant’s mark would be its geographical significance.”¹¹ Registration was thus refused. Similarly, CAROLINA APPAREL for a clothing store was found geographically descriptive. “Accordingly, although applicant acknowledges that its services are rendered in the state of North Carolina, the actual items of clothing may come from a variety of locations, applicant contends. It is applicant’s position, therefore, that the asserted mark is not primarily geographically descriptive of its services.” The Board was not convinced by this reasoning. “It is clear that the primary significance of the designation CAROLINA APPAREL, APPAREL being generic and disclaimed by applicant, is geographic. The addition of a generic term to a geographic term does not avoid the refusal of primary geographic descriptiveness. Inasmuch as the services admittedly do or will come from the place named in the mark, a public association of the services with the place named in the mark is presumed. . . . Accordingly, there is clearly an association of applicant’s retail clothing store services with the place named in the mark.”¹² Registration was refused. Do you agree with these conclusions? On the other hand, AMAZON for the online marketplace, SATURN for cars, and ATLANTIC for the magazine are not geographically descriptive because there is no goods/place association. While geographically descriptive marks are initially unregistrable, they can be registered if they acquire distinctiveness (see 1052(f) below).

Examples of “geographically deceptively misdescriptive” marks include HAVANA CLUB for cigars that were not from Cuba and NEAPOLITAN for sausages made in Florida instead of Naples.¹³ However, a misleading mark might not be deemed geographically deceptively misdescriptive if it does not mislead a “substantial portion of the intended audience.” MOSKOVSKAYA—Russian for “of or from Moscow”—on vodka that was not from Moscow was initially rejected for registration, but this decision was vacated and remanded because it was not clear that the mark would deceive a substantial portion of relevant consumers, as only 0.25% of the U.S. population speaks Russian.¹⁴ Consider the following: the mark SWISS ARMY KNIFE is used on penknives that are made in China rather than Switzerland. Is the mark registrable? Why or why not?

Some geographical terms, such as SWISS cheese and PEKING duck, have become generic and cannot serve as trademarks at all. But if geographical terms cease being generic, and gain secondary meaning, they may become registrable. At one time,

¹¹ *In re California Pizza Kitchen Inc.*, 10 U.S.P.Q.2d 1704 (T.T.A.B. 1988).

¹² *In re Carolina Apparel*, 48 U.S.P.Q.2d 1542 (T.T.A.B. 1998).

¹³ *Corporacion Habanos, S.A. v. Annacas, Inc.*, 88 U.S.P.Q.2d 1785, 2008 WL 4409768 (T.T.A.B. 2008); *In re Jack’s Hi-Grade Foods, Inc.*, 226 U.S.P.Q. 1028 (T.T.A.B. 1985).

¹⁴ *In re Spirits Intern., N.V.*, 563 F.3d 1347 (Fed. Cir. 2009) (noting that if a larger percentage of vodka consumers speak Russian, or non-Russian speakers would understand MOSKOVSKAYA to suggest “from Moscow,” then this might amount to a substantial portion).

BUDWEISER was the generic term for beer brewed according to a method pioneered in the town of Budweis. However, it is now associated in the minds of consumers with Anheuser-Busch and registrable in the US (though not in the EU because of preexisting use of the mark by the Czech company Budvar).

iii.) Primarily merely a surname. On its face, this prohibition focuses on surnames rather than full names. So JOHN SMITH might be registrable, but SMITH would not, absent secondary meaning (see 1052(f) below). What is the general policy behind this provision? Why not allow a business owner to register SMITH for her products, without a showing of secondary meaning? Of course, many surnames have secondary meaning and are famous registered marks, such as FORD, DUPONT, or MCDONALD'S. What about J. SMITH—is this still “primarily merely a surname”? How about J.D. SMITH? SMITH ELECTRONICS? The touchstone for answering such questions is “the primary significance of the mark to the purchasing public.”¹⁵ So, for example, when surnames are combined with other terms (DELL COMPUTERS, DUKE UNIVERSITY), registrability would turn on whether or not the public perceives the mark as a whole as “primarily merely a surname.” Similarly, when a mark consists of a surname that is a double entendre (BIRD, COOK, KING), courts will look at the predominant meaning in the minds of consumers encountering the mark (does BIRD refer to the surname or the feathered vertebrate?). When the name of a famous person is used as a mark, it is unlikely to be “primarily merely a surname” because the public will instead associate it with the well-known personality.¹⁶

6.) 1052(f)

Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before December 8, 1993.

Registration of otherwise problematic marks with secondary meaning. Section 2(f) provides that marks that are *merely descriptive*, *deceptively misdescriptive*, *primarily geographically descriptive*, or *primarily merely a surname* can be registered if they acquire secondary meaning. Proof of exclusive and continuous use in commerce for five years can constitute prima facie evidence of distinctiveness. As a result of international agreements, marks that are *primarily geographically deceptively misdescriptive* can be registered only if they acquired secondary meaning before December 8, 1993. The

¹⁵ *Ex Parte Rivera Watch Corporation*, 106 U.S.P.Q. 145 (Comm'r Pat. & Trademarks 1955).

¹⁶ *Michael S. Sachs, Inc.*, 56 U.S.P.Q.2d 1132 (T.T.A.B. 2000) (“The mark M.C. ESCHER would no more be perceived as primarily merely a surname than the personal names P.T. Barnum, T.S. Eliot, O.J. Simpson, I.M. Pei and Y.A. Tittle.”).

remaining categories of marks addressed in § 1052—those that are deceptive, disparaging, immoral or scandalous, functional, falsely suggest connections with people or institutions, use flags or government seals, identify living individuals, or are likely to cause confusion with another mark—are not registrable even if they acquire distinctiveness. Why do we allow the registration of some categories of marks if they acquire secondary meaning and not allow others? What distinctions do you see between the various categories?

Section 2(f) also specifies proceedings for opposing or canceling marks on the basis of dilution, which we will deal with later in this book. Only “famous” marks are protected against dilution. There are two types of dilution, blurring and tarnishment. “[D]ilution by blurring” is “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.” “[D]ilution by tarnishment” is “association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.”¹⁷ Note, that this provision requires the owner of the mark to bring the action to refuse registration, not the PTO to refuse it on application.

A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be refused registration only pursuant to a proceeding brought under section 1063 of this title. A registration for a mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title.

PROBLEM 6-3

(We will be returning to this problem in future chapters, but you are asked here only about one aspect of it.)

Alan Turning is the brilliant computer scientist behind a new program known as Faceplant. Mr. Turning is a long-time vocal critic of Facebook, the social network site. He believes that its privacy practices are poor and less than transparent, that it imposes on its users a tightening spiral of narcissism and withdrawal from the “real” world, and that its network structure and architecture is overly controlling and anti-competitive. Mr. Turning is fond of pointing out that Facebook was able to supplant Myspace as the dominant social network because there was “open competition on the open web.” Facebook, by contrast, has boasted that its goal is to be the portal through which users get *all* their content, e-commerce services and forms of communication. Mr. Turning believe that Facebook is trying to replace the “open” structure of the World Wide Web with its own carefully controlled gated community, from which competitors or rivals can be excluded. His saying, “Their goal is to be the *last* social network!” has become something of a rallying cry for Facebook’s critics.

Mr. Turning’s solution was to create a program called Faceplant that he claimed would restore “control of privacy to the user and control of competition to the free market.” Mr. Turning’s program simplifies the process of selecting and fine-tuning one’s privacy preferences by automating the process of jumping through Facebook’s cumbersome sets

¹⁷ § 1125(c).

of menus. It also “nags” users if they stayed on Facebook for too long, sending messages such as “Enough with the profile tweaks!” “Only losers stalk their high school boyfriends!” and “It’s Spring! Go for a flippin’ walk outside!” Finally, the program “unlocks” Facebook’s integration with other apps, so that users can use any app or play any game “inside” Facebook, not merely those approved by the Facebook app store. Mr. Turning made clear by both the name of his program and the logo he selected that his product was critical of Facebook. He claimed that the name “Faceplant” was designed to highlight two of his criticisms – that users become effectively unconscious because of Facebook’s influence (“doing a faceplant” is a slang expression for falling rapidly asleep) and that they turn away from more imaginative engagement with forms of culture such as *books*, into vegetative recipients of manipulative advertising, mere “plants.”

Both Facebook’s name and its original logo have been registered on the Principal Register since 2005. The logo is shown below.



Mr. Turning’s logo for Faceplant is based on a modification of that image to send a very different message.



Mr. Turning has applied for a Federal trademark on both the name “Faceplant” and the logo above which changes Facebook’s “like” symbol by rotating it 90 degrees and adding a raised middle finger. He is giving the app away for free, but he does make a considerable amount of money from advertisements seen by the millions of users flocking to his website, Faceplant.com.

Would Mr. Turning be able to register his proposed marks? Why? Would Facebook be able to oppose registration? On what grounds and how? Bonus question: If refused registration on the Principal Register, would Mr. Turning be able to seek any other kind of protection for the name “Faceplant” and the logo?
