

# Registration of Scandalous, Immoral, and Disparaging Matter Under Section 2(a) of the Lanham Act: Can One Man's Vulgarity Be Another's Registered Trademark?

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## I. INTRODUCTION

Although federal registration of a trademark, service mark, collective mark, or certification mark<sup>1</sup> on the Principal Register provides its owner with numerous competitive advantages,<sup>2</sup> the door to registration is not open to all marks. Consistent with its underlying purpose of consumer protection, for example, the Lanham Act<sup>3</sup> contains broad prohibitions against the registration of marks that are likely to create confusion between their owners' goods or services and those of prior registrants.<sup>4</sup> Similarly, the Act bars from

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<sup>1</sup> Under federal law, a "trademark" may be "any word, name, symbol, or device, or any combination thereof" that may be used by its owner "to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown," while a "service mark" acts to identify and distinguish the services of its owner. In contrast, a "certification mark" is a mark that certifies such things as a product's regional origin or mode of manufacture, and "collective marks" include designations indicating membership in a union, an association, or other organization. 15 U.S.C. § 1127 (1988). In keeping with the convention employed by the Lanham Act, *see, e.g., id.*, the term "marks" as used in this Article collectively refers to all of these designations unless otherwise noted.

<sup>2</sup> Federal registrants, for example, enjoy nationwide constructive notice of their use and ownership of the underlying mark. *Id.* § 1072. Prior to the fifth anniversary of the issuance of a registration, the registration constitutes prima facie evidence of the registrant's exclusive right to use the mark in interstate commerce; after that time this presumption becomes conclusive. *Id.* § 1115(a); *see also id.* § 1121 (providing for federal jurisdiction in infringement suits brought by federal registrants without regard to the amount in controversy); *id.* § 1117 (providing for awards of profits, treble damages, costs, and attorneys fees to federal registrants who are successful in infringement suits); *id.* § 1125(b) (providing for exclusion from U.S. of goods infringing upon rights of registrant).

<sup>3</sup> Pub. L. No. 79-489, 60 Stat. 427 (1946), codified as amended at 15 U.S.C. §§ 1051-1127 (1988 & Supp. III 1991) [hereinafter the Act].

registration marks that affirmatively misrepresent the qualities or geographical origin of the goods or services associated with them.<sup>5</sup>

The Act does not, however, restrict registrability solely to promote the competitive process by preventing consumer confusion or deception. Rather, it also prohibits registration of a broad variety of marks based merely on their content or subject matter.<sup>6</sup> Thus, for example, applicants applying to register such material as the flag of the United States, the official seal of a state, or the portrait of a recently deceased President will encounter express congressional disapproval.<sup>7</sup> Likewise, individuals seeking to block registration of their names without their consent may arm themselves with the Act's express prohibition against such actions.<sup>8</sup>

This Article focuses on the latter of these types of restrictions. More specifically, this Article examines the content-based prohibitions contained in Section 2(a) of the Act, which prohibits registration of, *inter alia*, marks consisting of or comprising scandalous, immoral, or disparaging matter.<sup>9</sup>

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<sup>4</sup> See 15 U.S.C. § 1052(d) (1988) (barring registration of marks "likely, when used on or in connection with the goods of the applicant, to cause confusion, to cause mistake, or to deceive").

<sup>5</sup> See *id.* § 1052(e)-(f).

<sup>6</sup> These prohibitions are contained in Section 2 of the Act, which provides in relevant part as follows:

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 or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or any State or municipality, or of any foreign nation, or any simulation thereof.

(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.

*Id.* § 1052(a)-(c).

<sup>7</sup> *Id.* § 1052(b)-(c).

<sup>8</sup> *Id.* § 1052(a).

<sup>9</sup> *Id.* [hereinafter Section 2(a)]. For the text of this provision, see *supra* note 6.

Although an examination of these provisions is beyond the scope of this Article, most state trademark acts include similar prohibitions against state registration of scandalous,

Although among the lesser known provisions of the Act, this section arguably has spawned its most interesting case law. Indeed, few other bodies of federal law can lay claim to the sheer scope of the subject matter encompassed by Section 2(a) jurisprudence, a subject matter ranging from the Virgin Mary to the Reverend Sun Myung Moon, from tabernacle safes to condoms, and from World War I soldiers to penis size-increasing devices.

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immoral, and disparaging material. *See, e.g.*, ALA. CODE § 8-12-7 (1984 Supp.); ALASKA STAT. § 45.50.010 (1986); ARIZ. REV. STAT. ANN. § 44-1442 (1989); ARK. CODE ANN. § 4-71-104 (Michie 1987); CAL. BUS. & PROF. CODE § 14220 (West 1990); COLO. REV. STAT. § 7-70-108 (1988); CONN. GEN. STAT. § 35-11b (West 1985); DEL. CODE ANN. tit. 6, § 3303 (1983); FLA. STAT. ch. 495.021(1) (West 1985); GA. CODE ANN. § 10-1-441 (1982); IDAHO CODE 48-502(b)(1) (1990); ILL. REV. STAT. ch. 140, para. 9 (1972); IND. CODE § 24-2-1-3 (1982); IOWA CODE ANN. § 548.2 (West 1989); KAN. STAT. ANN. § 81-112 (1985); KY. REV. STAT. ANN. § 365.575 (Michie/Bobbs-Merrill 1989); LA. REV. STAT. ANN. § 51:212 (West 1990); MD. CODE ANN. BUS. REG. § 1-404 (1992); MASS. GEN. L. ch. 110B § 3 (1990); MICH. COMP. LAWS § 429.32 (1982); MISS. CODE ANN. § 75-25-3 (1971); MO. REV. STAT. § 417.011 (1978); MONT. CODE ANN. § 30-13-303 (1985); NEB. REV. STAT. § 87-112 (1943); NEV. REV. STAT. § 600.330 (1991); N.H. REV. STAT. ANN. § 350-A:2 (1991); N.J. STAT. ANN. § 56:3-13.2 (West 1989); N.Y. GEN. BUS. LAW § 361 (McKinney 1988); N.C. GEN. STAT. § 80-2 (1989); N.D. CENT. CODE § 47-22-02 (1988); OHIO REV. CODE ANN. § 1329.55 (Baldwin 1991); OKLA. STAT. tit. 78, § 22 (1989); OR. REV. STAT. § 647.035 (1991); 54 PA. CONS. STAT. ANN. § 1111 (Supp. 1991); R.I. GEN. LAWS § 6-2-3 (1990); S.C. CODE ANN. § 39-15-120 (Law. Coop. 1976); S.D. CODIFIED LAWS ANN. § 37-6-6 (1989); TENN. CODE ANN. § 47-25-502 (1990); TEX. BUS. & COM. CODE § 16.08 (West 1987); UTAH CODE ANN. § 70-3-2 (1953); VT. STAT. ANN. tit. 9, § 2527 (1991); VA. CODE ANN. § 59.1-79 (1989); WASH. REV. CODE ANN. § 19.77.020 (West Supp. 1989); WYO. STAT. § 40-1-102 (1992); *see also* Model State Trademark Bill § 2 (1964).

Despite these express prohibitions in the trademark area, the United States Code is silent on the subject of whether allegedly scandalous, immoral, or disparaging material may be protectable under the patent and copyright laws. In light of this silence, whether such bars may be read into the relevant statutes has been a subject of some judicial debate. The modern view, however, is that in the absence of a provision corresponding to Section 2(a), the patent and copyright statutes contemplate the protection of any works or inventions otherwise falling within their scope. *Compare* *National Automatic Device Co. v. Lloyd*, 40 F. 89, 89-90 (N.D. Ill. 1889) (gambling devices lack utility and thus are ineligible for patent protection) *with Ex parte* *Murphy*, 200 U.S.P.Q. (BNA) 801, 802-03 (Bd. Pat. App. 1977) (approving patentability of invention used solely for gambling); *compare also* *Broder v. Zeno Mauvais Music Co.*, 88 F. 74, 78 (N.D. Cal. 1898) (denying protection on ground that "the word 'hottest,' as used in the chorus of [the] song 'Dora Dean,' has an indelicate and vulgar meaning and that for that reason the song cannot be protected by copyright") *with* *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852, 854, 858 (5th Cir. 1979) (copyright statute contains no explicit or implicit bar to the copyrighting of obscene materials).

Part I of this Article briefly introduces the federal registration process, including the *ex parte* and *inter partes* litigation characteristic of proceedings involving allegedly scandalous, immoral, or disparaging marks.<sup>10</sup> Part II surveys the case law arising under Section 2(a), describing the methodology employed in evaluations of the registrability of marks arguably falling within its scope. Finally, Part III critiques this jurisprudence, identifying three areas in which prevailing Section 2(a) doctrine suffers from critical deficiencies. This Part suggests alternative interpretations of the Lanham Act that would avoid these flaws and at the same time better serve the underlying purposes of unfair competition law and the Constitution itself.

## II. THE REGISTRATION PROCESS

Upon receipt of an application to register a mark on the Principal Register,<sup>11</sup> the United States Patent and Trademark Office ("PTO") assigns it to an Examining Attorney for processing.<sup>12</sup> Although this *ex parte* review generally focuses on whether the application complies with various formal requirements,<sup>13</sup> the Examining Attorney also evaluates whether the mark applied for complies with the Act's substantive barriers to registration.<sup>14</sup>

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<sup>10</sup> For purposes of this Article, the term "*ex parte*" refers to cases in which an applicant challenges the Patent and Trademark Office's determination that the applicant's mark is not entitled to registration. In contrast, the term "*inter partes*" refers to conflicts between: (1) competing applicants for registration; (2) an applicant and another party seeking to block registration of the applicant's mark; and (3) a federal registrant and another party seeking to cancel the registrant's registration.

<sup>11</sup> In addition to the Principal Register, the Lanham Act also provides for the maintenance of a Supplemental Register for marks that are capable of distinguishing their owners' goods and services but do not do so as of yet. See 15 U.S.C. §§ 1091-95 (1988). Because each of the cases discussed by this Article involved eligibility of marks for the Principal Register, this Part does not attempt to set forth the application process for the Supplemental Register.

<sup>12</sup> *Id.* § 1062(a).

<sup>13</sup> Thus, for example, the PTO might reject an application because it does not include the required specimens demonstrating that the mark is being used in conjunction with the specified goods or services. See 37 C.F.R. § 2.56 (1992).

<sup>14</sup> See generally *Glenwood Lab., Inc. v. American Home Prod. Corp.*, 455 F.2d 1384, 1387 (C.C.P.A. 1972). For purposes of Section 2(a) determinations, this process is as follows:

In order to achieve uniformity in [PTO] practice in this area, the Examining Attorney, before refusing registration of a mark on the ground that it consists of or

Should the Examining Attorney initially reject the application, the applicant may respond with appropriate legal arguments or additional submissions.<sup>15</sup> This process continues until: (1) the applicant abandons the application; (2) the Examining Attorney withdraw the objection(s) upon reconsideration; or (3) the application receives a final rejection.<sup>16</sup> If the mark ultimately is approved for registration, the PTO notices that approval by publishing the mark in its *Official Gazette*, with a registration normally issuing within six months.<sup>17</sup>

Not all final determinations of registrability are made by Examining Attorneys. Prior to 1958, for example, an unsuccessful *ex parte* applicant could appeal to the Commissioner of Patents.<sup>18</sup> Since that time, such an applicant may appeal to the PTO's administrative appellate body, the Trademark Trial and Appeal Board ("the Board").<sup>19</sup> In proceedings before the Board, the Examining Attorney bears the burden of establishing that the mark is unregistrable<sup>20</sup> and is entitled to file a brief responsive to that of the applicant, who in turn is then allowed a reply brief.<sup>21</sup>

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comprises immoral or scandalous matter, must consult with his or her supervisor, who in turn will bring the matter to the attention of the Deputy Assistant Commissioner for Trademarks for approval.

UNITED STATES PATENT AND TRADEMARK OFFICE, U.S. DEP'T OF COMM., TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1203.01 at 1200-14 (1992 ed.) [hereinafter *T.M.E.P.*].

<sup>15</sup> See 15 U.S.C. § 1062(b) (1988).

<sup>16</sup> See generally JAMES E. HAWES, TRADEMARK REGISTRATION PRACTICE § 1.08[2], at 1-16 (1992); 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19.40[1], at 19-214 (3d ed. 1992).

<sup>17</sup> 37 C.F.R. § 2.80 (1992).

<sup>18</sup> See Pub. L. No. 85-609, 72 Stat. 540 (1958). As a practical matter, the Commissioner typically delegated responsibility for hearing the appeal to PTO employees under his supervision. See, e.g., *Ex parte* Parfum L'Orle, Inc., 93 U.S.P.Q. (BNA) 481 (Comm'r Patents 1952) (appeal heard by Patent Office Examiner in Chief); *Ex parte* Martha Maid Mfg. Co., 37 U.S.P.Q. (BNA) 156 (Comm'r Patents 1938) (appeal heard by Assistant Commissioner of Patents).

Note that pursuant to Pub. L. No. 93-596, 88 Stat. 1949 (1975), the office of "Commissioner of Patents" became the "Commissioner of Patents and Trademarks."

<sup>19</sup> 15 U.S.C. § 1070 (1988). An applicant whose application has foundered on purely procedural requirements still may petition the Commissioner to waive the requirement. See 37 C.F.R. § 2.146 (1992). The Commissioner does not, however, have the authority to waive statutory requirements. See, e.g., *In re* Krusman, Inc., 199 U.S.P.Q. (BNA) 110 (Comm'r Patents 1977).

<sup>20</sup> *In re* Budge Mfg. Co., 857 F.2d 773, 775 (Fed. Cir. 1988).

<sup>21</sup> 37 C.F.R. § 2.144 (1992).

The registrability of particular marks may also be challenged by third parties. Within thirty days after the mark's publication in the *Official Gazette*, for example, any party who believes that she will be damaged by the mark's registration may challenge it in a formal opposition proceeding.<sup>22</sup> Similarly, the same party facing an existing registration of the mark may petition to cancel it by alleging that the registration was improperly issued under the Act.<sup>23</sup> Both types of these *inter partes* proceedings are heard by the Board in its capacity as an administrative fact finder.

If dissatisfied with the Board's decision, parties to *inter partes* proceedings and unsuccessful applicants may appeal to the United States Court of Appeals for the Federal Circuit<sup>24</sup> or, alternatively, may elect to have their cases heard on a *de novo* basis by a federal district court.<sup>25</sup> Because there are no reported cases under Section 2(a) in which a party has appealed to a district court, this Article examines decisions falling within the jurisdiction of the Federal Circuit and its predecessor, the Court of Customs and Patent Appeals.<sup>26</sup>

<sup>22</sup> 15 U.S.C. § 1063 (1988); 37 C.F.R. § 2.101-07 (1992).

<sup>23</sup> 15 U.S.C. § 1064 (1988); 37 C.F.R. § 2.111-15 (1992). Once a mark has been registered for five years, the registration may be cancelled only on the narrow grounds specified in 15 U.S.C. § 1064(3). Among these, however, is the allegation that the mark has been registered in violation of Section 2(a).

<sup>24</sup> See 15 U.S.C. § 1071(a) (1988); 28 U.S.C. § 1295 (1988).

<sup>25</sup> See 15 U.S.C. §§ 1071(b), 1121 (1988). An appellant electing to proceed before the Federal Circuit thereby waives his right to an appeal before a district court. *Id.* § 1071(b)(1). Nevertheless, an *inter partes* appellee may direct the appeal to a district court even if the appellant has appealed to the Federal Circuit by filing a notice of appeal in the district court within 20 days after the filing of the appeal to the Federal Circuit. 37 C.F.R. § 2.145(c)(3) (1992).

The primary advantage of an appeal to a district court is that a party may submit any additional evidence it feels necessary, whereas an appellant before the Federal Circuit is limited to the record before the Board. See generally *Squirtco v. Tomy Corp.*, 697 F.2d 1038 (Fed. Cir. 1983); see also *Wells Fargo & Co. v. Stagecoach Properties, Inc.*, 685 F.2d 302 (9th Cir. 1982) (Board's decision to be accorded "substantial weight" by reviewing district court but can be overcome by persuasive evidence).

<sup>26</sup> Prior to October 1, 1982, appeals from the Board were heard by the Court of Customs and Patent Appeals. On that date, however, this court merged with the United States Claims Court to form the new United States Court of Appeals for the Federal Circuit. Pub. L. No. 97-164, 96 Stat. 25 (1982). Pursuant to the Federal Circuit's decision in *South Corp. v. United States*, 690 F.2d 1368 (Fed. Cir. 1982) (en banc), all decisions of the Court of Customs and Patent Appeals are binding precedent in the Federal Circuit.

## III. SECTION 2(a) JURISPRUDENCE: A SURVEY

A. *Establishing an Underlying Rationale*

Although, as shown in the following sections, numerous applicants have proven willing to pursue registration of their marks in the face of Section 2(a) objections, the resulting decisions focus almost exclusively on whether particular marks are, in fact, scandalous, immoral, or disparaging. Consequently, there is a dearth of case law examining whether the statute represents a permissible means towards achieving a valid government purpose.

To the extent that applicants have directly attacked Section 2(a)'s validity, however, these attacks have failed. In *In re McGinley*,<sup>27</sup> for example, the applicant challenged Section 2(a)'s constitutionality after both the Examining Attorney and the Board found his mark impermissibly scandalous.<sup>28</sup> Claiming on appeal to the Court of Customs and Patent Appeals that his mark fell under the First Amendment's protection, the applicant argued that a refusal to register violated his constitutional rights.<sup>29</sup>

The court, however, rejected this argument. It first found that Section 2(a)'s prohibitions did not affirmatively bar the mark's use altogether. Rather, the court relied on the applicant's ability to use and protect his mark even in the absence of a federal registration to conclude that "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."<sup>30</sup>

Of equal importance, however, the *McGinley* court found that Congress' intent to make the benefits of registration unavailable to particular marks also passed constitutional muster. Properly viewed, the court held, the PTO's refusal to register the mark was a valid legislative allocation of the federal

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<sup>27</sup> 660 F.2d 481 (C.C.P.A. 1981).

<sup>28</sup> See *In re McGinley*, 206 U.S.P.Q. (BNA) 753 (T.T.A.B. 1979), *aff'd*, 660 F.2d 481 (C.C.P.A. 1981).

<sup>29</sup> *McGinley*, 660 F.2d at 484. Note that, as a purely technical matter, the applicant's claims sounded in a denial of due process under the Fifth Amendment, rather than a direct violation of his First Amendment rights. See *id.* Consistent with the *McGinley* court's treatment of this issue, however, this Article will refer to mark owners' "First Amendment rights," although "Fifth Amendment rights" would be more accurate.

<sup>30</sup> *Id.* at 484 (citation omitted); see also *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470, 1472 (T.T.A.B. 1988) (Cissel, Member, concurring). On the distinction between a mark's use and its registration, see *infra* notes 282-84 and accompanying text.



government's resources. The court noted that the PTO's processing of applications, together with its maintenance of previously registered marks, required continuing government expenditures.<sup>31</sup> Finding that "[a]part from nominal fees, these costs are underwritten by public funds," the court concluded that "[w]e do not see this as an attempt to legislate morality, but, rather, a judgment by the Congress that such marks [should] not occupy the time, services, and use of funds of the federal government."<sup>32</sup>

## B. *The Problem of Standards*

### 1. *The Proper Relationship Between the Mark and the Covered Goods and Services*

#### a. *The Riverbank Canning Analysis*

The earliest cases to interpret Section 2(a) and its predecessors<sup>33</sup> left no doubt that an innocuous mark could become unregistrable by its association with particular goods or services. In *In re Riverbank Canning Co.*,<sup>34</sup> the talisman of all Section 2(a) jurisprudence, the PTO determined that the mark MADONNA was sufficiently scandalous when applied to wines as to preclude

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<sup>31</sup> As the court observed:

The benefits of registration, in part with government assistance, include public notice of the mark in an official government publication and in official records which are distributed throughout the world, maintenance of permanent public records concerning the mark, availability of the Customs Service for blocking the importation of infringing goods, access to federal courts where there is a presumption of validity of the registration (*e.g.*, that the mark is *not* immoral or scandalous), notices to the registrant concerning maintenance of the registration, and, to some extent, direct government protection of the mark in that the PTO searches its records and refuses registration to others of conflicting marks.

*McGinley*, 660 F.2d at 486.

<sup>32</sup> *Id.*

<sup>33</sup> The ban against registration of immoral or scandalous marks was first enacted as Section 5(a) of the Trademark Act of 1905, Pub. L. No. 489, 33 Stat. 724 (1905). Congressional disapproval of disparaging marks, however, did not appear until Section 2(a)'s passage as part of the Lanham Act in 1946. *See infra* note 104 and accompanying text.

<sup>34</sup> 95 F.2d 327 (C.C.P.A. 1938).

its registration. On appeal, the Court of Customs and Patent Appeals agreed with the applicant that the term was not inherently scandalous.<sup>35</sup> Nevertheless, the court held, "[i]t is . . . obvious that, in determining whether a mark 'consists of or comprises . . . scandalous material,' consideration ordinarily must be given to the goods upon which the mark is used."<sup>36</sup>

In applying this standard, the court disclaimed any intent to moralize on the applicant's product.<sup>37</sup> Apparently taking judicial notice that "wine, like any intoxicating beverage, may be, and often is, used to excess,"<sup>38</sup> however, the court concluded that:

We can readily understand that many who are accustomed to the use of wine as a beverage, remembering the use of it as a beverage in Biblical times, would not be shocked at the use of the word "Madonna" or a representation of the Virgin Mary as a trade-mark upon wine used for beverage purposes; but we also believe that there are many wine users who, knowing that the excessive use of wine is a great evil and not uncommon, would be shocked by such use of said mark upon wine, especially in view of the fact that such mark would probably be displayed, among other places, in barrooms.

In our opinion, to commercialize the name of, or a representation of, the Virgin Mary as a trade-mark is of very doubtful propriety, and we feel certain that its use upon wine for beverage purposes would be shocking to the sense of propriety of nearly all who do not use wine as a beverage, and also to many of those who do so use it; therefore, we think that such use of the word "Madonna" would be scandalous and its registration prohibited under said trade-mark act.<sup>39</sup>

Although, consistent with *Riverbank Canning*, religious marks associated with alcoholic beverages have continued to fare poorly in the registration process, under both the 1905 Act<sup>40</sup> and the Lanham Act.<sup>41</sup> The Board also has

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<sup>35</sup> *Id.* at 328.

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

<sup>37</sup> *See id.* ("Whether wine in itself is harmless we are not called upon here to determine, and we express no opinion upon that subject.").

<sup>38</sup> *Id.* at 329.

<sup>39</sup> *Id.* The dissenters argued that the numerous uses of wine referenced in the Bible precluded the mark from being considered scandalous when applied to that beverage, but would have joined the court had the goods been "whisky, brandy, rum, beer, or the like." *Id.* at 330 (Jackson, J., dissenting).

<sup>40</sup> Although the cases themselves are unreported, the 1938 testimony of the Commissioner of Patents provided the House Subcommittee on Trademarks with troubling evidence of distillers' attempts under the 1905 Act to register for their goods marks connected with religious organizations or their employees:

applied this analysis to tobacco. In *In re Reemtsma Cigarettenfabriken G.m.b.H.*,<sup>42</sup> the Board refused to allow registration of the mark SENUSSI for cigarettes on the ground that the tenets of the Senussi Moslem sect forbade the use of tobacco. In contrast, however, the Board in *In re Waughtel*<sup>43</sup> allowed registration of the AMISH mark for cigars after testimony that not only did the Amish faith permit smoking, but at least seventy-five percent of Amish men did so.

Subsequent decisions have not limited the *Riverbank Canning* analysis to marks for addictive substances. For example, in *Doughboy Industries, Inc. v. Reese Chemical Co.*,<sup>44</sup> a manufacturer of, among other things, "Donald Ducks and shmoos," opposed registration of the applicant's DOUGH-BOY mark for an anti-venereal disease preparation.<sup>45</sup> Although dismissing the opposer's allegations of a likelihood of confusion between its and the applicant's products under Section 2(d) of the Act,<sup>46</sup> the Commissioner's office engaged in an

I would like to mention to the committee an attempt that was made to register, immediately upon the death of Knute Rockne, the name of Knute Rockne for whisky and alcoholic beverages . . . and the attempt to register the name Notre Dame for alcoholic beverages.

Now, to me those attempts shock my sense of propriety as an American citizen, in addition to my official capacity.

*Hearings Before the Subcomm. on Trademarks of the House Comm. on Patents on H.R. 9041, 75th Cong., 3d Sess. 79 (1938) [hereinafter 1938 House Hearings] (testimony of Commissioner Coe).*

<sup>41</sup> Although *Riverbank Canning* was decided under Section 5(a) of the 1905 Act, the Board subsequently cited its holding in once again refusing to register the MADONNA mark for wine under Section 2(a). See *In re P.J. Valckenberg, G.m.b.H.*, 122 U.S.P.Q. (BNA) 334 (T.T.A.B. 1959); see also *In re Sociedade Agricola E. Comerical Dos Vinhos Messias, S.A.R.L.*, 159 U.S.P.Q. (BNA) 275 (T.T.A.B. 1968) (refusing registration to MESSIAS mark for wine and brandy on ground that religious connotations of term to Jews and Christians rendered the mark scandalous as used). But cf. *H. Sichel Sohne, G.m.b.H. v. John Gross & Co.*, 204 U.S.P.Q. (BNA) 257 (T.T.A.B. 1979) (cancelling registration of registrant's BLUE CHAPEL mark for wines under Section 2(d), on finding that registrant's mark likely to be confused with prior registered BLUE NUN mark for wines).

<sup>42</sup> 122 U.S.P.Q. (BNA) 339 (T.T.A.B. 1959).

<sup>43</sup> 138 U.S.P.Q. (BNA) 594 (T.T.A.B. 1963).

<sup>44</sup> 88 U.S.P.Q. (BNA) 227 (Comm'r Patents 1951).

<sup>45</sup> *Id.* at 227.

<sup>46</sup> 15 U.S.C. § 1052(d) prohibits the registration of marks likely to be confused with those of prior users. When determining whether a likelihood of confusion exists between two marks, tribunals in the Federal Circuit apply the multifactor analysis set forth in *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

independent *ex parte* inquiry into the possibly disparaging nature of the mark. Finding "Doughboy" to refer to American soldiers in the First World War, Examiner in Chief Federico denied registration, noting that "[a] trade mark does not exist apart from the goods in connection with which it is used . . . and the nature of a trade mark for the purpose of section 2(a) may be determined from the associations conveyed by the word used as the mark with the goods in connection with which it is used."<sup>47</sup>

The *Riverbank Canning* methodology also has made its way into the women's undergarment industry. In *In re Runsdorf*,<sup>48</sup> which addressed the registrability of the mark BUBBY TRAP for brassieres, the Board relied on the mark's association with these goods to find the proposed use "offensive to a segment of the public sense of propriety."<sup>49</sup> Similarly, in *Ex parte Martha Maid Mfg. Co.*,<sup>50</sup> the Assistant Commissioner of Patents found the mark QUEEN MARY (presumably otherwise inoffensive) to be impermissibly scandalous when applied to women's underwear.

Notwithstanding the majority of the decisions discussed above, however, *Riverbank Canning* does not always work to the applicant's disadvantage. For example, in *In re Hepperle*,<sup>51</sup> the Examining Attorney initially denied registration to the applicant's ACAPULCO GOLD mark for suntan lotion in part on the ground that it was a commonly recognized term for marijuana. The Board relied on the *Riverbank Canning* analysis to reverse, however, noting that "in our opinion, to the average purchaser of suntan lotion in the normal marketing milieu for such goods the term 'ACAPULCO GOLD' would

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<sup>47</sup> 88 U.S.P.Q. (BNA) at 228. Anticipating the Board's treatment of the same issue eight years later, *see supra* note 41, the Examiner in Chief held *Riverbank Canning* applicable under the Lanham Act, with the following apt characterization of the earlier decision's holding:

In applying . . . the Act of 1905 the Court of Customs and Patent Appeals held in effect that it was not necessary that a word be scandalous per se to be unregistrable as a trade mark, but that a trade mark was unregistrable if it was scandalous by reason of the particular goods in connection with which it was used, the question being whether the use of a mark upon particular goods may be scandalous.

88 U.S.P.Q. (BNA) at 228.

<sup>48</sup> 171 U.S.P.Q. (BNA) 443 (T.T.A.B. 1971).

<sup>49</sup> *Id.* at 443.

<sup>50</sup> 37 U.S.P.Q. (BNA) 156 (Comm'r Patents 1938).

<sup>51</sup> 175 U.S.P.Q. (BNA) 512 (T.T.A.B. 1972).

suggest the resort city of Acapulco, noted for its sunshine and other climatic attributes rather than marijuana.”<sup>52</sup>

Likewise, in *In re In Over Our Heads, Inc.*,<sup>53</sup> the Examining Attorney denied registration to the applicant’s MOONIES mark (complete with a stylized pair of buttocks) for exhibitionistic dolls, after determining the word portion of the mark to be “lacking in taste and is an affront to an organized religious sect.”<sup>54</sup> On appeal, however, the Board affirmatively relied on the applicant’s description of goods to dismiss the objection: “We believe that applicant’s mark MOONIES—with its naked buttocks design and spelled without emphasizing the letter ‘m’—would, when used on a doll, most likely be perceived as indicating that the doll ‘moons,’ and would not be perceived as referencing members of the Unification Church.”<sup>55</sup>

*Hepperle* and *In Over Our Heads* notwithstanding, perhaps the clearest example of the *Riverbank Canning* analysis working in an applicant’s favor is the Board’s decision in *In re Old Glory Condom Corp.*<sup>56</sup> In *Old Glory*, the applicant marketed condoms under a composite mark consisting of the words “Old Glory Condom Corp” and “a pictorial representation of a condom decorated in a manner to suggest the American flag”<sup>57</sup>:



OLD GLORY CONDOM CORP

The applicant’s purpose in adopting this mark was not merely to identify the source of origin of its products. Rather, as the Board found, the applicant

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<sup>52</sup> *Id.* at 512. The *Hepperle* Board did, however, ultimately disallow registration for the applicant’s mark because of its confusing similarity to an existing registration for the same mark for use in connection with lipstick and face powder. *Id.*

<sup>53</sup> 16 U.S.P.Q.2d (BNA) 1653 (T.T.A.B. 1990).

<sup>54</sup> *Id.* at 1654.

<sup>55</sup> *Id.*; see also *In re Leo Quan Inc.*, 200 U.S.P.Q. (BNA) 370, 371 (T.T.A.B. 1978) (apparently finding nature of applicant’s goods persuasive of applicant’s claim that its mark was an innocent acronym).

<sup>56</sup> Serial No. 74/004,391, 1993 TTAB LEXIS 3 (T.T.A.B. March 3, 1993).

<sup>57</sup> *Id.* at \*1.

sought "to focus attention on the AIDS epidemic and, in particular, to emphasize that Americans have a patriotic duty to fight the AIDS epidemic and other sexually transmitted diseases."<sup>58</sup> The Examining Attorney, however, was unimpressed with the applicant's self-professed goal, and denied registration on Section 2(a) grounds after concluding that the consuming public would be offended by the use of the American flag to promote products associated with sexual activity.<sup>59</sup>

On the applicant's appeal, the Board reversed. Noting that "whether [the] applicant's mark would be likely to offend must be judged not in isolation but in the entire context of the mark's use,"<sup>60</sup> the Board held that that context mandated a different result from that reached by the Examining Attorney. In particular, the Board found that the applicant's intent in adopting its mark was entitled to probative weight in any determination of registrability under Section 2(a). As the Board concluded:

Here, applicant markets its condoms in packaging which emphasizes applicant's commitment to the sale of high quality condoms as a means of promoting safer sex and eliminating AIDS and its belief that the use of condoms is a patriotic act. Although we know that not everyone would share applicant's view that the use of condoms is a patriotic act, the seriousness of purpose surrounding the use of applicant's mark—a seriousness of purpose made manifest to purchasers on the packaging for applicant's goods—is a factor to be taken into account in assessing whether the mark is offensive or shocking. When we consider that factor, along with the others we have discussed, we find that applicant's mark can in no way be considered "scandalous" under Section 2(a).<sup>61</sup>

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<sup>58</sup> *Id.* at \*3. In addition to accepting the applicant's testimony in reaching this finding, the Board also noted that the applicant's packaging for its products bore the following "Old Glory Pledge": "We believe that it is patriotic to protect and save lives. We offer only the highest quality condoms. Join us in promoting safer sex. Help eliminate AIDS. A portion of Old Glory profits will be donated to AIDS related services." *See id.*

<sup>59</sup> *Id.* at \*3-4. The Examining Attorney applied the *Riverbank Canning* analysis throughout the litigation in reaching this conclusion. *See, e.g.,* Examining Attorney's Appeal Brief at 5, *In re Old Glory Corp.*, Serial No. 74/004,391, 1993 TTAB LEXIS 3 (T.T.A.B. March 3, 1993) ("[T]he applicant's mark is scandalous, not because it is obscene or objectionable *per se*, but because its use of a representation of an American flag to advertise condoms would offend a substantial composite of the public.").

<sup>60</sup> *Old Glory*, Serial No. 74/004,391, 1993 TTAB LEXIS 3, at \*17.

<sup>61</sup> *Id.* at \*17-18 (footnote omitted).

### b. *The Per Se Inquiry*

In contrast to the approach under *Riverbank Canning*, another line of cases has focused on the mark itself. Under these cases, the proper inquiry under Section 2(a) has tended to be whether the mark is unregistrable *per se*, separately and independently of the nature of the mark owner's business. Consequently, association with particular goods or services will not affect the registrability of an otherwise clearly acceptable or unacceptable mark.

The earliest examples of such an analysis appear within the Commissioner's office. In *Ex parte Summit Brass and Bronze Works, Inc.*,<sup>62</sup> for example, the PTO refused registration to the mark AGNUS DEI for tabernacle safes for members of the Catholic clergy. Declining to take into account the clearly religious nature of these goods, the First Assistant Commissioner of Patents looked only to the mark itself, concluding that "[t]o commercialize an emblem of such highly sacred religious significance would, I think, be offensive to most individuals of the Christian faith, and thus scandalous within the meaning of the statute."<sup>63</sup>

In contrast, however, registration of the allegedly immoral mark LIBIDO for perfumes was allowed in *Ex parte Parfum L'Orle, Inc.*<sup>64</sup> Noting (incorrectly, in light of *Summit Brass*) that "this appears to be the first instance in which the question of refusal of a registration on the ground of the immoral or scandalous nature of the mark itself has arisen on appeal,"<sup>65</sup> the Examiner in Chief found that the widespread use of similarly sexually charged terms in the perfume industry precluded a finding that the mark was impermissibly immoral under Section 2(a)'s predecessor.<sup>66</sup>

The majority of more recent decisions at least implicitly have adopted *Summit Brass'* and *Parfum L'Orle's* underlying application of a *per se* standard. A variation of this analysis, albeit in a case ultimately denying registration, occurred in *McGinley*, which addressed the registrability of a mark consisting of "a photograph of a nude man and woman kissing and embracing in a manner appearing to expose the male genitalia" for a sexually-oriented

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<sup>62</sup> 59 U.S.P.Q. (BNA) 22 (Comm'r Patents 1943).

<sup>63</sup> *Id.* at 23. Curiously enough, however, the Assistant Commissioner *did* take into account the religious nature of the goods in denying registration on the alternative ground that the mark would likely be viewed as mere ornamentation, rather than as a trademark. *See id.*

<sup>64</sup> 93 U.S.P.Q. (BNA) 481 (Comm'r Patents 1952).

<sup>65</sup> *Id.* at 481 (emphasis added).

<sup>66</sup> *Id.* at 482.

newsletter and social club services.<sup>67</sup> In refusing to allow registration, the Examining Attorney relied heavily on the nature of the applicant's goods and services to find the mark impermissibly scandalous.<sup>68</sup>

The Board took an even dimmer view of the applicant's mark, even without consideration of the applicant's businesses. It found that the unrestricted description of the goods and services contained in the application made possible the mark's exposure to virtually the entire populace.<sup>69</sup> Given such an expansive audience, the Board concluded, "applicant's photograph, *when used as a mark for any goods or services*, is offensive to propriety and morality, outrages a sense of decency, and is shocking to the moral sense of members of the community, whose sensibilities are protected by the statute."<sup>70</sup>

On the applicant's appeal, the Court of Customs and Patent Appeals expressly rejected the PTO's invitation to consider the nature of the applicant's goods and services:

Contrary to the Solicitor's argument, the Lanham Act does not require, under the rubric of "scandalous," any inquiry into the goods or services not shown in the application itself. Thus, the PTO's views with respect to the specific information disseminated by appellant in his newsletter and the specific services provided by appellant are not relevant.<sup>71</sup>

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<sup>67</sup> *In re McGinley*, 660 F.2d 481, 482 (C.C.P.A. 1981). Testimony before the Board established that the individuals in the photograph were none other than the applicant himself and his wife, who together operated "Bob and Geri's Wide World Social Swing Club." *In re McGinley*, 206 U.S.P.Q. (BNA) 753, 753 (T.T.A.B. 1979), *aff'd*, 660 F.2d 481 (C.C.P.A. 1981). The Board, however, was unimpressed with the models' marital status. *Id.* at 756 ("We have no doubt that the overwhelming majority of [potential viewers] would be affronted by the use as a mark of a photograph of a nude couple embracing, whether or not the models who posed for the photograph happened to be married to each other.").

<sup>68</sup> *See McGinley*, 660 F.2d at 482 ("Such activities are considered deviations from the sexual norm of husband and wife relations. Such activities are immoral or scandalous. . . . The mark graphically indicates the activity carried on in applicant's Club; sex not normally sanctioned by (even today's permissive) social standards." (quotations and emphasis deleted)).

<sup>69</sup> *In re McGinley*, 206 U.S.P.Q. (BNA) 753, 755-56 (T.T.A.B. 1979), *aff'd*, 660 F.2d 481 (C.C.P.A. 1981).

<sup>70</sup> *Id.* at 756 (emphasis added).

<sup>71</sup> *McGinley*, 660 F.2d at 485. The court's holding on this point was anticipated by the Board's decision in *In re Madsen*, 180 U.S.P.Q. (BNA) 334 (T.T.A.B. 1973), which addressed the registrability of WEEK-END SEX for a magazine. In overturning the Examining Attorney's rejection of the mark, the Board noted, "the question of whether or not the contents of the magazine may be pornographic in nature, is not an issue to be decided by this Board. If such were the criterion, many well-known magazines with



This language notwithstanding, however, the court nevertheless upheld the Board's determination that the design itself was sufficiently scandalous as to preclude its registration.<sup>72</sup>

Consistent with *McGinley*'s refusal to examine closely the precise nature of the applicant's goods and services, other decisions have undertaken the Section 2(a) inquiry as a *per se* determination. In *In re Tinseltown, Inc.*,<sup>73</sup> for example, the applicant's claimed motivation for placing its BULLSHIT mark on the outside of its fashion accessories was to satirize the use of designers' names on similar products.<sup>74</sup> The Board, however, limited its inquiry solely to whether the nature of the word itself precluded its registration.<sup>75</sup> Answering this question in the affirmative, the Board denied registration.

Similarly, in *Greyhound Corp. v. Both Worlds Inc.*,<sup>76</sup> the Greyhound Corporation opposed the applicant's attempt to register for shirts a design mark consisting of a defecating dog on Section 2(a) grounds as well as an alleged likelihood of confusion with Greyhound's design mark for identical goods. As in *Tinseltown*, the Board declined to accord weight to the applicant's intent to "mock[] the craze for shirts bearing prestigious emblems."<sup>77</sup> Instead, like the *McGinley* court, the Board found that the design's use as a mark potentially exposed it to the entire population.<sup>78</sup> Given such possible exposure, the Board concluded, "a substantial composite of the general public would find the use on a shirt of a graphic portrayal of a dog in the act of defecating, including the depiction of the feces, to be scandalous."<sup>79</sup>

Although *McGinley*, *Tinseltown*, and *Greyhound* each found the particular mark in question to be unregistrable,<sup>80</sup> the strongest example of a *per se*

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inoffensive or arbitrary titles might well have been precluded registration in the Patent Office." *Id.* at 335.

<sup>72</sup> See *McGinley*, 660 F.2d at 487.

<sup>73</sup> 212 U.S.P.Q. (BNA) 863 (T.T.A.B. 1981).

<sup>74</sup> *Id.* at 864.

<sup>75</sup> See *id.* at 865 (framing inquiry as "whether the mark 'BULLSHIT' comprises matter which gives offense to the conscious or moral feelings or is shocking to the sense of decency or propriety of a substantial composite of the general public of the United States").

<sup>76</sup> 6 U.S.P.Q.2d (BNA) 1635 (T.T.A.B. 1988).

<sup>77</sup> *Id.* at 1638.

<sup>78</sup> *Id.* at 1639 ("[T]he goods are T-Shirts and polo shirts, goods which may be encountered in sales establishments patronized by a wide variety of people of all ages and convictions or may be worn and seen by people in virtually all public places.").

<sup>79</sup> *Id.*

<sup>80</sup> For another example of this methodology to produce a similar result, see *In re Anti-Communist World Freedom Congress, Inc.*, 161 U.S.P.Q. (BNA) 304 (T.T.A.B. 1969) (mark found impermissibly disparaging to national symbol of foreign country).

standard may be found in a case upholding registration. In *In re Thomas Laboratories, Inc.*,<sup>81</sup> a manufacturer of a penis size-increasing device sought to register for its goods the following design mark, perhaps best described by the Board as "a melancholy, unclothed male figure ruefully contemplating an unseen portion of his genitalia"<sup>82</sup>:



Consistent with *Riverbank Canning*, the Examining Attorney initially refused registration on the theory that "the mark, in the marketplace, is not viewed in a vacuum, but is viewed in connection with the goods."<sup>83</sup> The Board, however, rejected this approach by examining the mark independently of the goods, noting:

Turning . . . to a consideration of the goods themselves, inasmuch as no question has been raised concerning the legality of the sale thereof in commerce which can be regulated by Congress, there can be no occasion for this factor to play a role, either expressly or implicitly in the determination of registrability. In this connection, it should be noted that the goods are already the subject matter of a registration owned by applicant, the mark therein being the designation "LEGEND LENGTHENER."<sup>84</sup>

Taken as a whole, these cases present two arguably conflicting treatments of the relationship between a mark and its goods or services. On the one hand, the trend apparently is to reject the theory that an innocuous mark may be made unregistrable by the covered goods or services.<sup>85</sup> On the other hand, however,

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<sup>81</sup> 189 U.S.P.Q. (BNA) 50 (T.T.A.B. 1975).

<sup>82</sup> *Id.* at 52.

<sup>83</sup> *Id.* at 51.

<sup>84</sup> *Id.* (footnote omitted).

<sup>85</sup> See, e.g., *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470 (T.T.A.B. 1988) (allowing registration of applicant's BIG PECKER mark for use in connection with shirts without

a trier of fact predisposed to find the mark unregistrable *per se* may rely on the mark owner's recitation of goods or services to establish an expansive potential audience.<sup>86</sup> If, as the *McGinley* Board found, an arguably impermissible mark may be exposed "to youngsters just learning to read, to teenagers, to senior citizens, to persons of strong moral and religious convictions, to members of the clergy, and to an uncountable number of other persons in the large and varied population of the United States,"<sup>87</sup> there can be little doubt as a practical matter as to the ultimate outcome of the inquiry.<sup>88</sup>

## 2. Defining "Scandalous," "Immoral," and "Disparaging"

As might be expected, precisely what constitutes "scandalous," "immoral," or "disparaging" matter often is the subject of debate, even in cases in which the proper relationship between the mark and the relevant goods or services is not at issue. Notwithstanding the absence of clear congressional definitions,<sup>89</sup> however, the Court of Customs and Patent Appeals has held that the language of Section 2(a) is not unconstitutionally vague.<sup>90</sup> Moreover, the

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discussion of number of people potentially exposed to mark); *see also In re Leo Quan Inc.*, 200 U.S.P.Q. (BNA) 370 (T.T.A.B. 1978).

<sup>86</sup> *See* *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1639 (T.T.A.B. 1988) (refusing registration in part because that applicant's mark when used on shirts would be exposed to virtually unlimited number of people); *see also In re Tinseltown*, 212 U.S.P.Q. (BNA) 863, 865 (T.T.A.B. 1981).

<sup>87</sup> *In re McGinley*, 206 U.S.P.Q. (BNA) 753, 755 (T.T.A.B. 1979), *aff'd*, 660 F.2d 481 (C.C.P.A. 1981).

<sup>88</sup> It perhaps bears emphasis that this methodology differs from that employed in the *Riverbank Canning* analysis in a fundamental respect. Under *Riverbank Canning*, the trier of fact should examine whether the intrinsic nature of the covered goods or services renders an otherwise innocent mark scandalous, immoral, or disparaging. In contrast, however, *McGinley* suggests that any doubts concerning an arguably unregistrable mark *per se* may be resolved against its owner if the unrestricted distribution or provision of the covered goods or services would increase the likelihood of the mark's exposure to individuals particularly susceptible to being scandalized or disparaged. Thus, to the extent that *per se* inquiries have taken into account the mark owner's goods and services, this consideration has gone to determine the scope of the mark's potential audience, rather than the nature of the mark itself.

<sup>89</sup> *See McGinley*, 660 F.2d at 485 ("Because there is a paucity of legislative history of this provision, we must look to the 'ordinary and common meaning' of [scandalous.]"); *In re Riverbank Canning*, 95 F.2d 327, 328 (C.C.P.A. 1938) ("Its legislative history does not aid us in arriving at the intent of Congress in its enactment . . .") (interpreting 1905 Act); *see also infra* note 106.

<sup>90</sup> *See McGinley*, 660 F.2d at 484:

court's early decisions left little doubt that, at least in its view, any uncertainty should be resolved against the applicant: "The field is almost limitless from which to select words for use as trade-marks, and one who uses debatable marks does so at the peril that his mark may not be entitled to registration."<sup>91</sup>

a. "Scandalous" and "Immoral" Marks

In the absence of clear congressional guidance, the definitions of "scandalous" and "immoral" generally are regarded as equivalent and properly discerned "by reference to court and board decisions and dictionary definitions."<sup>92</sup> As a practical matter, litigation has turned on the definition of the former term.<sup>93</sup> In *Riverbank Canning*, for example, the court accepted dictionary definitions of "scandalous" as encompassing all marks "[c]ausing or tending to cause scandal; . . . shocking to the sense of truth, decency, or

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[The right to registration] cannot be denied without compliance with Fifth Amendment due process requirements. This entails a determination of whether the term "scandalous" is sufficiently precise to enable the PTO and the courts to apply the law fairly and to notify a would-be registrant that the mark he adopts will not be granted a federal registration. The Supreme Court "has consistently held that lack of precision is not itself offensive to the requirements of due process. ' . . . [T]he Constitution does not require impossible standards'; all that is required is that the language 'conveys sufficiently definite warning as to the prescribed conduct when measured by common understanding and practices . . . .'"

*Id.* (citation and footnote omitted) (second brackets in original).

<sup>91</sup> *Riverbank Canning*, 95 F.2d at 329. At least one Board decision, however, has rejected this presumption. *See In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d (BNA) 1653 (T.T.A.B. 1990):

Because the guidelines are somewhat vague and because the determination is so highly subjective, we are inclined to resolve doubts on the issue of whether a mark is scandalous or disparaging in favor of applicant and pass the mark for publication with the knowledge that if a group does find the mark to be scandalous or disparaging, an opposition proceeding can be brought and a more complete record can be established.

*Id.* at 1654-55.

<sup>92</sup> *McGinley*, 660 F.2d at 485.

<sup>93</sup> *See, e.g., id.* at 484 n.6 ("Because of our holding . . . that appellant's mark is 'scandalous,' it is unnecessary to consider whether appellant's mark [also] is 'immoral.' We note the dearth of reported trademark decisions in which the term 'immoral' has been directly applied."); *see also T.M.E.P., supra* note 14, § 1203.01, at 1200-13 ("Although the words 'immoral' and 'scandalous' might have slightly different connotations, case law has generally included immoral matter in the same category as scandalous matter.").

propriety; disgraceful; offensive; disreputable” or, alternatively, “[g]iving offense to the conscience or moral feelings; exciting reprobation; calling out condemnation.”<sup>94</sup> Finding the mark in question to be “shocking to the sense of propriety,” the court denied registration.<sup>95</sup>

The majority of subsequent decisions have reaffirmed this methodology, namely reliance on pre-Lanham Act dictionaries for appropriate definitions.<sup>96</sup> As the *McGinley* court observed of this procedure in apparent disapproval of the Board’s reliance in that case on both contemporary and pre-Lanham Act dictionaries,<sup>97</sup> “[w]e note that the [1940’s] dictionary editions cited were extant at the time of the enactment of the Lanham Act in 1946, and it is these definitions which, in the absence of evidence to the contrary, the Congress considered in framing the Act.”<sup>98</sup> At least two more recent Board decisions, however, have departed from this practice in favor of (substantively identical) definitions drawn from contemporary dictionaries.<sup>99</sup>

Whatever the definitions chosen, the Court of Customs and Patent Appeals has held that “[w]hether or not the mark, including innuendo, is scandalous is to be ascertained from the standpoint of not necessarily a majority, but a substantial composite of the general public.”<sup>100</sup> Nevertheless, other decisions by the Board have suggested that the relevant perspective from which scandal and immorality should be examined is that of the potential purchasers of the mark owner’s goods and services rather than the public as a whole.<sup>101</sup> Notwithstanding the general adoption of Lanham Act-era definitions of

<sup>94</sup> *Riverbank Canning*, 95 F.2d at 328 (quoting contemporary dictionaries).

<sup>95</sup> *Id.* at 329.

<sup>96</sup> See, e.g., *McGinley*, 660 F.2d at 485–86; *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470, 1471 (T.T.A.B. 1988); *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1638 (T.T.A.B. 1988); *In re Tinseltown*, 212 U.S.P.Q. (BNA) 863, 865 (T.T.A.B. 1981).

<sup>97</sup> See *In re McGinley*, 206 U.S.P.Q. (BNA) 753, 754 (T.T.A.B. 1979), *aff’d*, 660 F.2d 481 (C.C.P.A. 1981).

<sup>98</sup> *McGinley*, 660 F.2d at 486 n.11.

<sup>99</sup> See *Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. (BNA) 176, 178 (T.T.A.B. 1978) (defining “scandalous” as, *inter alia*, “giving scandal,” “scandalizing,” creating “the distressing effect on others of unseemly or unrighteous conduct,” or “that which offends established moral conception or disgraces all who are associated or involved”); *In re Runsdorf*, 171 U.S.P.Q. (BNA) 443 n.1 (T.T.A.B. 1971) (“offensive to public or individual sense of propriety or morality”).

<sup>100</sup> *McGinley*, 660 F.2d at 485.

<sup>101</sup> See, e.g., *In re Hepperle*, 175 U.S.P.Q. (BNA) 512, 512 (T.T.A.B. 1972) (“average purchaser”); see also *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470, 1472 (T.T.A.B. 1988) (Cissell, Member, concurring) (“prospective purchaser”).

"scandalous," most decisions have taken the apparently inconsistent position that the public whose feelings are at issue is not that of Congressman Lanham's immediate post-war generation.<sup>102</sup> Rather, "in determining whether a proposed mark is scandalous or immoral, it is imperative that fullest consideration be given to the moral values and conduct which contemporary society has deemed to be appropriate and acceptable."<sup>103</sup>

b. "*Disparaging*" Marks

Unlike their scandalous and immoral counterparts, disparaging marks historically have received little attention under Section 2(a). To the extent that a mark with particular significance to a certain group is used with goods or services disapproved by that group, the PTO and courts are likely to invoke *Riverbank Canning* to determine registrability.<sup>104</sup> Thus, for example, the

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<sup>102</sup> See *In re Old Glory Condom Corp.*, Serial No. 74/004,391, 1993 TTAB LEXIS 3, at \*11 (T.T.A.B. March 3, 1993) ("[W]hat was considered scandalous as a trademark or service mark twenty, thirty or fifty years ago may no longer be considered so, given the changes in societal attitudes. Marks once thought scandalous may now be thought merely humorous (or even quaint) . . .").

<sup>103</sup> *In re Thomas Lab.*, 189 U.S.P.Q. (BNA) 50, 52 (T.T.A.B. 1975); see also *In re Leo Quan Inc.*, 200 U.S.P.Q. (BNA) 370, 371 (T.T.A.B. 1978) (referencing "mores of our time"); *In re Madsen*, 180 U.S.P.Q. (BNA) 334, 335 (T.T.A.B. 1973) ("In resolving the issue as to registrability of the mark . . . consideration must be given to the moral values and conduct fashionable at the moment, rather than that of past decades . . ."); cf. *McGinley*, 660 F.2d at 487 (Rich, J., dissenting) ("I think the decision [in *Riverbank Canning*] is no longer of precedential value in view of the social changes in the ensuing 43 years.").

Note, however, that at least one Board decision expressly has rejected the argument that a particular word may become less scandalous as a result of more frequent use in ordinary speech. See *In re Tinseltown*, 212 U.S.P.Q. (BNA) 863 (T.T.A.B. 1981):

We do not say that there has not been an increase in the amount of usage of profanities in our contemporary society and a diminution of the social inhibitions to such usage. No person blessed with the gift of hearing can fail to be cognizant of this much freer use of obscenities in contemporary America. Neither is it our function to moralize about this trend. However, the fact that profane words may be uttered more freely does not render them any the less profane. Nor does this fact amend the statute by which we are required to determine the registrability of such matter as marks.

*Id.* at 866.

<sup>104</sup> See, e.g., *In re Sociedade Agricola E. Comerical Dos Vinhos Messias, S.A.R.L.*, 159 U.S.P.Q. (BNA) 275 (T.T.A.B. 1968); *In re P.J. Valckenberg, G.m.b.H.*, 122

registrability of the names of particular religious groups as marks for tobacco likely will turn on the groups' views on the evils of smoking.<sup>105</sup>

In the absence of such a relationship, however, the case law until recently failed to produce a clear standard.<sup>106</sup> Indeed, although presented with several opportunities to define "disparagement" under these circumstances,<sup>107</sup> the Board did not even attempt to do so until its 1988 *Greyhound* decision. In that case, however, it adopted a relatively detailed rule:

Disparagement is essentially a violation of one's right of privacy—the right to be "let alone" from contempt and ridicule. . . . The two elements of such a claim are (1) that the communication reasonably would be understood as referring to the plaintiff; and (2) that the communication is disparaging, that is,

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U.S.P.Q. (BNA) 334 (T.T.A.B. 1959); *see also* *Doughboy Indus. v. Reese Chem. Corp.*, 88 U.S.P.Q. (BNA) 227 (T.T.A.B. 1951). *But see In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653 (T.T.A.B. 1992) (allowing registration of applicant's MOONIES mark without consideration of the Unification Church's views on the applicant's goods, namely "dolls . . . which drop their pants when a collapsible bulb is squeezed, thus exposing their buttocks").

Note that cases decided under the 1905 Act that adopt this methodology frequently rest refusals to register on a finding that the marks as used are "scandalous" or "immoral." *See, e.g., In re Riverbank Canning*, 95 F.2d 327, 328–29 (C.C.P.A. 1938). Although this language clearly has its origins in the text of the 1905 Act, which proscribed registration only of scandalous and immoral marks, the legislative history of the Lanham Act clearly evinces an intent that these cases more properly should be considered under the disparagement clause introduced by that legislation. *See, e.g., Hearings Before the Subcomm. on Trademarks of the House Comm. on Patents on H.R. 4744*, 76th Cong., 1st Sess. 18–21 (1939) [hereinafter *1939 House Hearings*]; *1938 House Hearings*, *supra* note 40, at 79–80.

<sup>105</sup> Compare *In re Waughtel*, 138 U.S.P.Q. (BNA) 594 (T.T.A.B. 1963) (allowing registration) with *In re Reemtsma Cigarettenfabriken G.m.b.H.*, 122 U.S.P.Q. (BNA) 339 (T.T.A.B. 1959) (refusing registration).

<sup>106</sup> This failure is hardly surprising given the lack of a statutory definition of "disparage." As the Assistant Commissioner of Patents predicted to the House Subcommittee on Trademarks as early as 1939, "the use of this word in this connection 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." *1939 House Hearings*, *supra* note 104, at 21 (testimony of Assistant Commissioner Frazer).

<sup>107</sup> *See, e.g., Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. (BNA) 176 (T.T.A.B. 1978); *In re Condas S.A.*, 188 U.S.P.Q. (BNA) 544 (T.T.A.B. 1975); *In re Anti-Communist World Freedom Congress, Inc.*, 161 U.S.P.Q. (BNA) 304 (T.T.A.B. 1969); *see also Doughboy Indus.*, 88 U.S.P.Q. (BNA) at 227.

would be considered offensive or objectionable by a reasonable person of ordinary sensibilities.<sup>108</sup>

In determining whether particular marks are impermissibly disparaging, the Board has examined such considerations as personal testimony,<sup>109</sup> the mark owner's membership in the allegedly disparaged group,<sup>110</sup> documentary evidence of the presence or absence of offense,<sup>111</sup> the mark owner's intent to disparage,<sup>112</sup> and whether the mark would be impermissibly scandalous separately and independently of the disparagement inquiry.<sup>113</sup>

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<sup>108</sup> *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1639 (T.T.A.B.1988) (citation omitted).

<sup>109</sup> *Compare Bromberg*, 198 U.S.P.Q. (BNA) at 176 (holding opposers' allegations that the mark brought them into contempt and disrepute sufficient to establish their standing to challenge its registration) *with Condas*, 188 U.S.P.Q. (BNA) at 544 (according limited weight to hearsay testimony that "the Japanese American Citizens League considers the word 'JAP' to be derogatory and injurious to those of Japanese ancestry"); *compare also In re Riverbank Canning*, 95 F.2d 327, 329 (C.C.P.A. 1938) (finding testimony by applicant's customers of lack of offense unpersuasive) *with Waughtel*, 138 U.S.P.Q. (BNA) at 595 (finding persuasive testimony by members of sect that use of sect's name as a mark for tobacco not disparaging).

<sup>110</sup> *Condas*, 188 U.S.P.Q. (BNA) at 544 (allowing registration of JAP trademark upon showing that the applicant was Japanese). The *Condas* Board additionally found "persuasive of a similar finding" a decision by a New York state court rejecting a contention that the term was "derogatory or would subject Americans of Japanese ancestry to contempt, ridicule, or scandal." *Id.* (citing *Japanese American Citizens League v. Takada*, 171 U.S.P.Q. (BNA) 109 (N.Y. Sup. Ct. 1971)).

<sup>111</sup> Note, however, that the Board frequently finds this evidence unpersuasive. *See, e.g., In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654 (T.T.A.B. 1990); *Condas*, 188 U.S.P.Q. (BNA) at 544 (both according limited weight to newspaper articles detailing allegedly disparaging nature of word in question). *But see In re Leo Quan Inc.*, 200 U.S.P.Q. (BNA) 370, 371 (T.T.A.B. 1978) (finding persuasive testimony submitted by applicant of long-term use without complaints of offense).

<sup>112</sup> *See In re Anti-Communist World Freedom Congress, Inc.*, 161 U.S.P.Q. (BNA) 304, 305 (T.T.A.B. 1969).

<sup>113</sup> *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1639-40 (T.T.A.B. 1988).

Note, however, that the Board has declined to recognize a bright-line rule on this issue, *i.e.*, that a finding that a mark is impermissibly scandalous or immoral necessarily translates into a finding that the mark is impermissibly disparaging as well. *See In re Old Glory Condom Corp.*, Serial No. 74/004,391, 1993 TTAB LEXIS 3 (T.T.A.B. March 3, 1993):

It is clear to us that the examining attorney's refusal of registration on the grounds that applicant's mark is scandalous was based, in large part, on her finding that the mark



### 3. Applying the Standards

#### a. Word Marks

Registrability of particular word marks generally depends on their lexicographic meanings, with *Riverbank Canning* establishing the practice of reliance on dictionaries to fix the definition of the word or words under consideration.<sup>114</sup> Unlike the situation frequently found in cases defining the words “scandalous” or “immoral,” however, the Board consistently has turned to contemporary dictionaries, rather than those in print at the time of the Lanham Act’s passage, to discern this meaning.<sup>115</sup> Not surprisingly, this practice can lead to “dueling dictionaries,” as the mark’s owner and the PTO invoke competing editions with definitions favorable to their respective positions.<sup>116</sup>

Notwithstanding the case law’s extensive reliance on dictionaries, however, these decisions leave unresolved the extent to which the text of a dictionary definition may be dispositive. In *Tinseltown*, for example, the Board held that a dictionary’s designation of the word “bullshit” as “profane” was sufficient, in

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disparages the flag. Her finding that the mark is scandalous subsumed a finding of disparagement. Likewise, our finding, to the contrary, that the mark is *not* scandalous subsumes a finding that the mark is not disparaging. But, by focusing our analysis and discussion in *this* case on the issue of whether applicant’s mark is scandalous, we do not mean to suggest (and certainly do not hold) that, in *every* case, a finding that a mark is scandalous subsumes, or is the same as, a finding of disparagement.

*Id.* at \*18 n.4.

<sup>114</sup> See *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938). The court did, however, disregard the primary definition of “Madonna” contained in each of the dictionaries, namely an Italian form of address, in finding that “there can be no doubt that in the United States, and among all English-speaking peoples, the word ‘Madonna’ is generally understood to refer to the Virgin Mary or to a pictorial representation of the Virgin Mary.” *Id.*

<sup>115</sup> See, e.g., *In Over Our Heads*, 16 U.S.P.Q.2d (BNA) at 1654; *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470, 1470–72 (T.T.A.B. 1988); *In re Tinseltown, Inc.*, 212 U.S.P.Q. (BNA) 863, 866 (T.T.A.B. 1981); *Leo Quan*, 200 U.S.P.Q. (BNA) at 371; *In re Runsdorf*, 171 U.S.P.Q. (BNA) 443, 443 (T.T.A.B. 1971); *In re Sociedade Agricola E. Comerical Dos Vinhos Messias, S.A.R.L.*, 159 U.S.P.Q. (BNA) 275, 275 (T.T.A.B. 1968); see also *In re Reemtsma Cigarettenfabriken G.m.b.H.*, 122 U.S.P.Q. (BNA) 339 (T.T.A.B. 1959) (referencing contemporary encyclopedia entry).

<sup>116</sup> See, e.g., *Hershey*, 6 U.S.P.Q.2d (BNA) at 1470–72; *Runsdorf*, 171 U.S.P.Q. (BNA) at 443–44.

and of itself, to preclude its registration.<sup>117</sup> Rejecting the applicant's contention that the term should be considered in a separate category as it had been assigned a "respectable, nonprofane meaning" in another contemporary dictionary,<sup>118</sup> the Board observed,

The argument might be persuasive were it not for the fact that the same edition lists other clearly profane words which are similarly defined for their non-profane meanings. It is not at all uncommon for profane words to have secondary as well as literal meanings or to be used other than, merely, as expletives. The fact that Merriam-Webster included such definitions in its third edition (whereas they are not found in the second edition) merely reflects a change in editorial policy as to what words or definitions should be incorporated rather than that the words have somehow lost their profane or obscene connotations.<sup>119</sup>

Similarly, the Board also allowed a dictionary definition of "bubby" as a "vulgar" term for the female breast to dispose of the registrability inquiry in *In re Runsdorf*.<sup>120</sup> Finding that "[v]ulgar,' as defined, means, inter alia, lacking in taste, indelicate, [and] morally crude," the Board concluded that such material "can, in our opinion, be encompassed by the term scandalous matter."<sup>121</sup> Consistent with its decision in *Tinseltown*, the Board gave little weight to another dictionary proffered by the applicant that defined the term without reference to its putative vulgarity in denying registration to the mark BUBBY TRAP for brassieres.

As in the case of the *Riverbank Canning* methodology, however, this reasoning does not always work to the applicant's disadvantage. For example, the owner of Reg. No. 1,532,169 overcame an initial Section 2(a) rejection of his stylized ORGASM mark for beauty products in part with the following argument:

The term "orgasm" is defined in *Webster's New Collegiate Dictionary* (1980 ed.), p. 802, as "intense or paroxysmal emotional excitement; esp: the climax of sexual excitement typically occurring toward the end of coitus." There is no indication that the word is considered vulgar or obscene. By contrast, the same

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<sup>117</sup> *Tinseltown*, 212 U.S.P.Q. (BNA) at 866.

<sup>118</sup> See *id.* at 864 ("Applicant contends . . . that the word 'bullshit' is in such common usage in contemporary America that it is defined in modern dictionaries as having the meaning of nonsense or exaggerated talk, rather than the feces of a bull . . .").

<sup>119</sup> *Id.* at 866 (footnote omitted).

<sup>120</sup> 171 U.S.P.Q. (BNA) 443 (T.T.A.B. 1971).

<sup>121</sup> *Id.* at 444.

dictionary's definition of "fuck" contains the notation "usu. [usually] considered obscene" and its definition of the word "shit" contains the notation "usu. [usually] considered vulgar." Thus, in the opinion of the editors of this standard dictionary, there is nothing vulgar or obscene about the term "orgasm."<sup>122</sup>

Thus, the absence of negative references in a word's definition may weigh towards its registrability.<sup>123</sup>

In another line of cases, the Board has accorded dictionary definitions significantly less weight in allowing registration of allegedly improper marks. In *In re Hershey*,<sup>124</sup> for example, the Examining Attorney rejected the applicant's BIG PECKER BRAND mark for T-shirts after finding that its primary component was a slang reference to the word "penis" in "various publications such as Playboy, Medical Economics, Financial Times and Newsweek," and one that—as in *Runsdorf*—was deemed "vulgar" by contemporary dictionaries.<sup>125</sup> Not surprisingly, the applicant responded with his own dictionaries and other material defining the word as "one that pecks, a woodpecker or a bird's bill."<sup>126</sup>

In contrast to the analysis in *Runsdorf* and *Tinseltown*, the Board did not allow the PTO's adverse dictionary definition to dispose of the inquiry, but instead looked to the applicant's specimens. Noting that they featured a rooster head well-endowed with a large beak, the Board observed that "[w]e fully recognize that the bird design may be removed at any time, but the specimens do serve to buttress the applicant's contention that the mark is not intended to refer to male genitalia but, rather, refers to the more common meaning of a

<sup>122</sup> Response to Office Action at 2, *In re Spira*, Serial No. 74/512,169 (Tm. Ex. Div. 1985) (brackets in original) (copy on file with author).

<sup>123</sup> See also *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653 (T.T.A.B. 1990):

[T]he term "Moonies" appears in dictionaries and is defined as meaning, in one sense, members of a particular religious group. These dictionary listings do not state that this term is derogatory or disfavored. Hence, in reaching our decision in this case, we have operated on the premise that "Moonies" is an accepted, nonderogatory term for members of The Unification Church.

*Id.* at 1654 n.4.

<sup>124</sup> 6 U.S.P.Q.2d (BNA) 1470 (T.T.A.B. 1988).

<sup>125</sup> *Id.* at 1470-71.

<sup>126</sup> *Id.* at 1472.

bird's beak."<sup>127</sup> Finding that the mark was "at most, a double entendre," the Board allowed its registration.<sup>128</sup>

Similarly, in *In re Leo Quan Inc.*,<sup>129</sup> the Board allowed the applicant to explain away the "erotic connotations" found in a dictionary definition of its BADASS mark. Accepting the applicant's assertions that the mark was an acronym for "Bettencourt Acoustically Designed Audio Sound Systems," the Board noted "[w]e are unwilling to assign base motives to an applicant who propounds a plausible explanation for a trademark which is susceptible to a wholly innocent pronunciation . . . ."<sup>130</sup> In doing so, the Board expressly rejected as a ground for nonregistrability the argument that "[o]ne of a certain cast of mind may perhaps see evil wherever the eye may light or in whatever may fall on the ear."<sup>131</sup>

Likewise, in *Parfum L'Orle*, the PTO held that the mere reference to sex in a definition of LIBIDO did not necessarily render the word impermissibly immoral. Rather, registration was allowed in light of the fact that "[i]t is notorious that the perfume trade uses names and advertisements of a suggestive nature . . . . Many of the names used have been registered . . . and some of these might well have been refused on the ground raised in this case."<sup>132</sup> Consequently, this line of cases discourages exclusive reliance on a single dictionary entry in favor of an examination of the overall context in which a mark is used.

#### b. *Design Marks*

In contrast to decisions involving word marks, relatively few cases have examined the registrability of allegedly scandalous, immoral, or disparaging design marks. Moreover, to the extent that design marks have been subject to Section 2(a) challenges, no clear principles have emerged. For example, although the *McGinley* court denied registration to a photograph of a nude

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<sup>127</sup> *Id.* (footnote omitted).

<sup>128</sup> *Id.* For a case employing similar methodology to reach a contrary result, see *Doughboy Indus. v. Reese Chem. Corp.*, 88 U.S.P.Q. (BNA) 227, 228 (T.T.A.B. 1951) (denying registration after finding the meaning of applicant's mark "shown by the specimens submitted with the application").

<sup>129</sup> 200 U.S.P.Q. (BNA) 370 (T.T.A.B. 1978).

<sup>130</sup> *Id.* at 371.

<sup>131</sup> *Id.*

<sup>132</sup> *Ex parte Parfum L'Orle*, 93 U.S.P.Q. (BNA) 481, 482 (Comm'r Patents 1952).

couple "appearing to expose the male genitalia,"<sup>133</sup> the *Thomas Laboratories* Board allowed registration of a depiction of a nude male, emphasizing that "applicant's mark is not a photograph of a nude male figure but is rather a cartoon-like representation . . . ."<sup>134</sup> Likewise, although the *Greyhound* Board found impermissibly scandalous and disparaging "a graphic portrayal of a dog in the act of defecating, including depiction of the feces,"<sup>135</sup> the PTO has approved the registration of more farcical representations of a urinating dog and a defecating man, both for commercial paper.<sup>136</sup> Consequently, applicants apparently may escape rejection by presenting caricatures of subject matter that otherwise would be unregistrable *per se* if portrayed realistically.<sup>137</sup>

### C. The Problem of Standing

As the discussion above might suggest, the vast majority of Section 2(a) cases involve appeals of refusals to register particular marks. Nevertheless, it is, of course, possible to oppose an application to register or petition to cancel an existing registration of an allegedly scandalous, immoral, or disparaging mark in a formal proceeding even if the mark meets the PTO's standards.<sup>138</sup> As with litigation before any federal tribunal, however, a party seeking to challenge registration of a mark on Section 2(a) grounds must first satisfy the threshold jurisdictional hurdle of standing established by Article III of the Constitution.<sup>139</sup>

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<sup>133</sup> *In re McGinley*, 660 F.2d 481, 482 (C.C.P.A. 1981). The *McGinley* dissenters took issue with this characterization of the mark. Although adopting the majority's general analysis, Judge Rich observed that "amazingly, on the crucial matter the majority equivocates in the phrase 'appearing to expose the male genitalia.' Either it does or it doesn't and I find it doesn't." *Id.* at 487 (Rich, J., dissenting).

<sup>134</sup> *In re Thomas Lab.*, 189 U.S.P.Q. (BNA) 50, 52 (T.T.A.B. 1975).

<sup>135</sup> *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1639 (T.T.A.B. 1988).

<sup>136</sup> See UNITED STATES PATENT AND TRADEMARK OFFICE, U.S. DEP'T OF COMM., OFFICIAL GAZETTE OF THE U.S. PAT. AND TRADEMARK OFF., May 31, 1988, at TM 68 [hereinafter OFFICIAL GAZETTE].

<sup>137</sup> See also *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654 (T.T.A.B. 1990) (allowing registration of composite word and design mark featuring stylized buttocks).

<sup>138</sup> See *supra* notes 22-23 and accompanying text.

<sup>139</sup> Standing doctrine has its origins in the so-called "Case and Controversy" language of Article III, section 2, clause 1, which establishes the federal judiciary's jurisdiction over, *inter alia*, "all Cases, in Law and Equity, arising under this Constitution, the Laws of the

As summarized by the Supreme Court,<sup>140</sup> "the question of standing is whether the litigant is entitled to have the court decide the merits of the dispute or of particular issues."<sup>141</sup> More specifically, "[t]he 'gist of the question of standing' is whether the party seeking relief has 'alleged such a personal stake in the outcome of the controversy as to assure that concrete adverseness which sharpens the presentation of the issues . . .'"<sup>142</sup> Consequently, "to entitle a private individual to invoke the judicial power to determine the validity of executive or legislative action he must show that he has sustained or is immediately in danger of sustaining a direct injury . . ."<sup>143</sup>

The Lanham Act sets forth similar statutory standards for determining a party's standing to bring an opposition or cancellation action. Section 13, for example, provides that "[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office . . . of the mark sought to be registered."<sup>144</sup> Likewise, under Section 14, "any person who believes that he is or will be damaged by [an existing] registration of a mark" may petition to cancel it.<sup>145</sup>

In interpreting these provisions, the Court of Customs and Patent Appeals has noted that "[n]o absolute test can be laid down for what must be proved to establish standing as a petitioner in a cancellation proceeding or as an opposer in an opposition."<sup>146</sup> Nevertheless, the court has held that standing is appropriately recognized only for parties having "a personal interest in the outcome [of the proceeding] beyond that of the general public."<sup>147</sup> Under this rule, the standing barrier should be invoked "to preclude meddlesome parties

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United States, and Treaties made, or which shall be made, under their Authority [and] to Controversies . . . between Citizens of different States." U.S. CONST. art. III, § 2, cl. 1.

<sup>140</sup> None of the Board's decisions discussed in this Section on their face purport to apply any of the various tests for determining standing articulated by the Supreme Court. For this reason, this Article does not address the general principles emerging from the Court's decisions at this point but instead does so at *infra* notes 244-314 and accompanying text.

<sup>141</sup> *Warth v. Seldin*, 422 U.S. 490, 498 (1975).

<sup>142</sup> *Flast v. Cohen*, 392 U.S. 83, 99 (1968) (quoting *Baker v. Carr*, 369 U.S. 186, 204 (1962)).

<sup>143</sup> *Ex parte Levitt*, 302 U.S. 633, 634 (1937).

<sup>144</sup> 15 U.S.C. § 1063(a) (1988).

<sup>145</sup> *Id.* § 1064.

<sup>146</sup> *Lipton Indus. v. Ralston Purina Co.*, 670 F.2d 1024, 1028 (C.C.P.A. 1982). The standards for satisfying Section 13 and Section 14 are identical. *Id.*

<sup>147</sup> *Id.*

from instituting proceedings as self-appointed guardians of the purity of the Register.”<sup>148</sup>

Although an opposition or cancellation proceeding brought under Section 2(a) is virtually by definition one to protect the “purity of the Register,” the Board has had few opportunities to address the issue of standing in such actions. For example, in *Sta-Power Indus. v. Lasting Products, Inc.*,<sup>149</sup> the owner of the mark STA-POWER for various automotive goods opposed registration of the applicant’s S-T-A-Y POWER mark for a desensitizing agent “intended to prevent premature ejaculation during intercourse and . . . advertised as a product which can lead to sexual fulfillment.”<sup>150</sup> After rejecting the opposer’s claims of a likelihood of confusion under Section 2(d), the Board declined to grant standing to oppose based on testimony “that applicant’s use of a similar mark on a product indicated for sexual fulfillment is ‘offensive’ to opposer corporation and its ‘image.’”<sup>151</sup> Despite this claim, however, the

<sup>148</sup> *Norac Co. v. Occidental Petroleum Corp.*, 197 U.S.P.Q. (BNA) 306, 320 (T.T.A.B. 1977); *cf. United Shoe Mach. Corp. v. Compo Shoe Mach. Corp.*, 56 F.2d 292 (C.C.P.A. 1932) (interpreting 1905 Act):

The statute gives *any person* who believes that he would be damaged the right to oppose . . . . These provisions are very broad, and should be broadly construed. Of course, Congress did not mean to grant these rights to a mere intermeddler . . . and thereby authorize such a person to interfere in the affairs of [another] and in the business of the Patent Office. Certainly the person seeking to cancel a registration or oppose an application for registration must have a greater interest than a member of the general public who by such recognition suffers no invasions of his rights or privileges. It is well understood in the application of equitable remedies that one who seeks such application is bound to show an interest in a suit personal to himself and not such an interest as he has only by virtue of being a citizen.

*Id.* at 295.

<sup>149</sup> 177 U.S.P.Q. (BNA) 351 (T.T.A.B. 1973).

<sup>150</sup> *Id.* at 352.

<sup>151</sup> *Id.*; *cf. Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 834 (6th Cir. 1983) (affirming dismissal of plaintiff’s attempt to enjoin use of trademark on “odious” products on theory that such use caused him embarrassment).

On this issue, note that, largely since the decision in *Sta-Power*, approximately half the states have enacted so-called “dilution” statutes, most of which are based on Section 12 of the Model Trademark Act:

Likelihood of injury to business reputation or of dilution of the distinctive quality of a mark registered under this Act, or a mark valid at common law, or a trade name valid at common law, shall be a ground for injunctive relief notwithstanding the absence

opposer did not expressly state as a ground for opposition that the mark was impermissibly scandalous, immoral, or disparaging under Section 2(a).

Had such an express claim been made, the outcome may have been different. For example, in *Greyhound*, the Board confronted the argument that an opposer with admitted standing to oppose under Section 2(d) lacked standing to challenge registration of the applicant's mark under Section 2(a) as well.<sup>152</sup> In contrast to the result in *Sta-Power*, the *Greyhound* Board held that "when an opposer has demonstrated its standing in connection with any ground on which it bases the opposition, it may rely on any other statutory ground which negates the applicant's right to registration and may invoke the general public interests in support of its claim."<sup>153</sup>

Such a rule, however, does not resolve the more difficult question of under what circumstances a party lacking an alternative statutory ground may object

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of competition between the parties or the absence of confusion as to the source of goods or services.

Model State Trademark Bill § 12 (1964). These statutes frequently are relied on by plaintiffs alleging that the use of their marks in an unsavory manner dilutes the marks' value. *See, e.g., American Express Co. v. Vibra Approved Lab.*, 10 U.S.P.Q.2d (BNA) 2006 (S.D.N.Y. 1989) (preliminary injunction under New York dilution law against defendant's "condom card" featuring plaintiff's AMERICAN EXPRESS and DON'T LEAVE HOME WITHOUT IT marks). Thus, although these state statutes do not provide a basis for opposition to a particular mark's federal registration, the opposer in *Sta-Power* might very well now be able to secure injunctive relief against the applicant's use of its mark under state legislation, even if, as was the case before the Board, the opposer could not demonstrate a likelihood of confusion between its and the applicant's products. *See, e.g., Pillsbury Co. v. Milky Way Prods.*, 215 U.S.P.Q. (BNA) 124 (N.D. Ga. 1981) (injunctive relief under Georgia dilution law against defendant's use in its magazine of plaintiff's trade characters "Poppin' Fresh" and "Poppie Fresh" engaged in sexual intercourse and fellatio).

<sup>152</sup> *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1638 (T.T.A.B. 1988).

<sup>153</sup> *Id.* For a case in which the would-be petitioners failed to demonstrate the alternative statutory grounds required under *Greyhound*, see *Abraham's Seed v. John One Ten*, 1 U.S.P.Q.2d (BNA) 1230 (T.T.A.B. 1986). In *Abraham's Seed*, the petitioner's application to register its Christian "fish symbol" mark previously had been rejected by a PTO Examining Attorney on Section 2(a) grounds as well as a likelihood of confusion with the registrant's prior registered virtually identical mark. Faced with this rejection, the petitioner challenged the applicant's registration on Section 2(a) grounds, but failed to expressly claim standing under Section 2(d). The Board, however, found the fact that the PTO had denied registration to the petitioner's mark under Section 2(a) but nevertheless had allowed registration to the registrant's mark to be irrelevant to the petitioner's ability to claim standing under that section. Noting the absence of a Section 2(d) claim similar to that in *Greyhound*, the Board dismissed the petition in its entirety. *Id.* at 1233.



to the registration of a particular mark under Section 2(a). In *Bromberg v. Carmel Self Service, Inc.*,<sup>154</sup> for example, two women opposed registration of the applicant's ONLY A BREAST IN THE MOUTH IS BETTER THAN A LEG IN THE HAND mark for restaurant services solely on Section 2(a) grounds, arguing that it disparaged women and brought them into contempt and disrepute.<sup>155</sup> In response, the applicant argued that the would-be opposers' failure to allege potential commercial damage from the mark's registration precluded them from claiming standing under the interaction of Sections 2(a) and 13.<sup>156</sup>

The Board, however, rejected this latter theory. Although acknowledging the legal status of corporations and other commercial enterprises as "persons" under the law, the Board questioned "whether these are persons possessing the emotional characteristics requisite to being or feeling offended by that which may be considered scandalous."<sup>157</sup> For this reason, it concluded, it was more likely that individuals, rather than commercial enterprises, would be sufficiently offended by a mark as to oppose its registration. Under the circumstances, "such parties were therefore certainly among those intended to be protected under Section 2(a) of the Statute."<sup>158</sup> Holding sufficient the mere allegation that a mark's registration would scandalize the opposers, the Board allowed the opposition to proceed after finding only that "the instant opposers . . . are persons within the meaning of Section 13 and members of a group who may believe the mark to be scandalous . . . ."<sup>159</sup>

This language notwithstanding, however, *Bromberg* does not stand for the proposition that a potential opposer may enjoy standing on behalf of an entire class of individuals. To the contrary, the *Bromberg* Board held that Section 13's requirement that each opposer pay a filing fee and be identified precluded a single opposer from advancing putative evidence of alleged damage to an

<sup>154</sup> 198 U.S.P.Q. (BNA) 176 (T.T.A.B. 1978).

<sup>155</sup> *Id.* at 177. The opposers supported this claim with affidavits from a number of women's groups. *Id.*

<sup>156</sup> *Id.* at 178.

<sup>157</sup> *Id.* at 178-79. Note that the Board did not express similar qualms in *Greyhound*, in which it found that the plaintiff was subject to disparagement notwithstanding its corporate status. See *Greyhound*, 6 U.S.P.Q.2d (BNA) at 1636-37.

<sup>158</sup> *Bromberg*, 198 U.S.P.Q. (BNA) at 179.

<sup>159</sup> *Id.* The results of the opposition in *Bromberg* are not reported. Ultimately, however, the applicant's mark was denied registration on Section 2(d) grounds after the Board found it to be confusingly similar to another opposer's A LEG IN THE HAND WILL PUT A SMILE ON YOUR FACE mark. See *Golden Skillet Corp. v. Carmel Self Serv., Inc.*, 201 U.S.P.Q. (BNA) 790 (T.T.A.B. 1979).

entire class. As the Board concluded, “[t]here is no provision in the Trademark Act for class actions and reference to damage which might be incurred by a particular class is inappropriate . . . .”<sup>160</sup>

*Bromberg* therefore establishes several apparently incongruous principles. On the one hand, potential opposers may not rely on claims of damage to an entire class of individuals to which they belong as a means of establishing their standing to challenge a mark’s registration. On the other hand, at least in cases in which allegedly scandalous or immoral marks are at issue, such opposers nevertheless must demonstrate that a “substantial composite of the general public” is likely to consider a mark offensive to prevail on the merits in a Section 2(a) opposition.<sup>161</sup>

#### IV. TOWARDS A NEW SCANDALOUS, IMMORAL, AND DISPARAGING JURISPRUDENCE

To this point, this Article has surveyed decisions addressing Section 2(a) with an eye toward impartially setting forth their results. The remainder of the Article identifies three areas in which prevailing Section 2(a) doctrine suffers from severe deficiencies and suggests alternative interpretations of the Lanham Act that cure these deficiencies. In particular, the following sections examine: (1) the constitutional problems associated with denying registration to particular marks according to a content-based standard; (2) the proper relationship between goods or services covered by a mark and the mark itself for purposes of determining registrability under Section 2(a); and (3) constitutional standing requirements for individuals seeking to challenge a mark’s registration under Section 2(a).

##### A. *Refusal to Register Scandalous, Immoral, or Disparaging Marks as an Unconstitutional Condition*

In applying the “unconstitutional conditions” doctrine, the Supreme Court generally has employed one of two approaches. The first of these is premised on the theory that the government may not discourage the exercise of

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<sup>160</sup> *Bromberg*, 198 U.S.P.Q. (BNA) at 178.

<sup>161</sup> See *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981). *Bromberg* arguably is more consistent with the *Greyhound* disparagement inquiry, which requires consideration of the more personalized “reasonable person” standard. See *Greyhound*, 6 U.S.P.Q.2d (BNA) at 1639.

constitutionally protected rights<sup>162</sup> by withholding particular benefits. Thus, for example, the Court has held that denial of a tax exemption for individuals refusing to take a special loyalty oath impermissibly infringed upon their freedom of speech.<sup>163</sup> Similarly, the Court also has invalidated a state government's refusal to provide unemployment benefits to an individual unwilling, for religious reasons, to work on Saturdays.<sup>164</sup> As the Court has noted of this line of cases:

For at least a quarter-century, this Court has made clear that even though a person has no "right" to a valuable governmental benefit and even though the government may deny him the benefit for any number of reasons, there are some reasons upon which the government may not rely. It may not deny a benefit to a person on a basis that infringes his constitutionally protected interests.<sup>165</sup>

As a practical matter, the Court is more likely to adopt this approach in cases in which the government has extended the benefit in question to a very broad class of recipients, but has purposefully excluded individuals holding certain viewpoints.<sup>166</sup>

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<sup>162</sup> See *supra* note 29.

<sup>163</sup> See *Speiser v. Randall*, 357 U.S. 513 (1958):

To deny an exemption to claimants who engage in certain forms of speech is in effect to penalize them for such speech. Its deterrent effect is the same as if the State were to fine them for this speech. . . . [T]he denial of a tax exemption for engaging in certain speech necessarily will have the effect of coercing the claimants to refrain from the proscribed speech.

*Id.* at 518-19.

<sup>164</sup> See *Sherbert v. Verner*, 374 U.S. 398, 406 (1963) (holding that denial of benefits to petitioner under such circumstances "effectively penalizes the free exercise of her constitutional liberties"); see also *Thomas v. Review Bd. of the Indiana Employment Sec. Div.*, 450 U.S. 707, 717 (1981).

<sup>165</sup> *Perry v. Sindermann*, 408 U.S. 593, 597 (1972). For other cases adopting this reasoning, see, e.g., *FCC v. League of Women Voters*, 468 U.S. 364, 399-401 (1984) (invalidating restriction on public broadcasting stations' use of federal funds to editorialize); *Healy v. James*, 408 U.S. 169, 181 (1972) (holding that state college's denial of access to campus facilities for certain unpopular groups "burdens or abridges" the right to association); cf. *Shapiro v. Thomson*, 394 U.S. 618, 634 (1969) (denial of welfare benefits to individuals residing in state for less than one year impermissibly burdens right to travel).

<sup>166</sup> See, e.g., *Arkansas Writers' Project, Inc. v. Ragland*, 481 U.S. 221 (1987) (invalidating state sales tax scheme taxing general interest magazines but exempting

In the second line of cases, however, the Court has deferred to legislative allocations of benefits as presumptively valid determinations of how best to distribute limited government resources.<sup>167</sup> In contrast to the rule discussed above, this line of holdings most frequently occurs in cases in which the government has singled out a particular viewpoint for favorable treatment in a manner that leaves nonrecipients in a position no worse off than they would be in the absence of any government action.<sup>168</sup> In these cases, the Court has treated the denial of "entitlements" to would-be beneficiaries as a nonsubsidy, rather than a coercive penalty qualifying it as an unconstitutional condition.<sup>169</sup>

As set forth above in greater detail,<sup>170</sup> tribunals in the Federal Circuit traditionally have viewed Section 2(a) as the latter type of regulation.<sup>171</sup> More specifically, the Court of Customs and Patent Appeals in *McGinley* held Section 2(a)'s prohibitions to be a legitimate decision by the government not to expend its limited resources processing applications to register particular marks or maintaining those registrations once they are issued. As the court noted of PTO funding at that time, the costs for such procedures largely were underwritten by public funds.<sup>172</sup>

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newspapers and religious, professional, trade, and sports journals); *Department of Agric. v. Moreno*, 413 U.S. 528 (1973) (invalidating scheme of allocating benefits in light of impermissible legislative motive of burdening particular class of individuals suspected of being hippies).

<sup>167</sup> See, e.g., *Lyng v. Castillo*, 477 U.S. 635, 638-39 (1986) (distinction in assistance program between households of one family and households with separate units subject only to rational basis review); *Dandridge v. Williams*, 397 U.S. 471, 485 (1970) (applying rational basis review to state regulation establishing unequal ceilings for grants to families of unequal sizes).

<sup>168</sup> See, e.g., *Harris v. McRae*, 448 U.S. 297, 317 n.19 (1980) ("A refusal to fund protected activity, without more, cannot be equated with the imposition of a 'penalty' on that activity."); *Maher v. Roe*, 432 U.S. 464, 474 (1977) (upholding refusal to pay for indigent women's abortion expenses on ground that "[t]he State may have made childbirth a more attractive alternative, thereby influencing the woman's decision, but it has imposed no restriction on access to abortion that was not already there").

<sup>169</sup> See, e.g., *Regan v. Taxation With Representation*, 461 U.S. 540, 549 (1983) ("We have held in several contexts that the legislature's decision not to subsidize the exercise of a fundamental right does not infringe the right, and thus is not subject to strict scrutiny."); see also *Arkansas Writers' Project, Inc. v. Ragland*, 481 U.S. 221, 237 (1987) (Scalia, J., dissenting) ("The reason that denial of participation in a tax exemption or other subsidy scheme does not necessarily 'infringe' a fundamental right is that—unlike direct restriction or prohibition—such a denial does not, as a general rule, have any significant coercive effect.").

<sup>170</sup> See *supra* notes 27-32 and accompanying text.

<sup>171</sup> See, e.g., *In re Tinseltown*, 212 U.S.P.Q. (BNA) 863, 865 (T.T.A.B. 1981).

<sup>172</sup> *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981).

Whether this factual underpinning was valid in 1981,<sup>173</sup> however, it no longer is so. Rather, congressional funding of the PTO's operations since that time has shifted to a "user-funded" mechanism supported entirely by processing fees paid by applicants and registrants seeking to maintain their registrations.<sup>174</sup> Indeed, not only are public funds not currently being used to finance the PTO operations cited by the *McGinley* court, this system at times has generated a surplus so large that the PTO has considered *lowering* fees.<sup>175</sup> Under these circumstances, it is the PTO's *opposition* to a mark, rather than its approval, that is more likely to cause the expenditure of federal funds<sup>176</sup> and, for that reason, Section 2(a) is inappropriately considered a presumptively valid decision not to fund.<sup>177</sup>

More importantly, however, the Act's content-based prohibitions against registration would fail to qualify as valid nonsubsidies even under the funding system in place at the time of *McGinley*. It is well established that "the registration scheme of the Trademark Act is one more inclined to inclusion than exclusion, the obvious idea being to give as comprehensive a notice as possible . . . of the trademarks and service marks in which others have claimed rights."<sup>178</sup> Consistent with this philosophy, Section 2(a) does not identify certain classes of marks for favorable consideration, with impermissibly immoral, scandalous, or disparaging marks merely being denied the federal subsidy of registration through omission; rather, the statute instead specifically singles out and targets the latter for *disfavorable* treatment. As Section 2(a) itself expressly provides, "No trade-mark . . . shall be refused registration on the principal register on account of its nature *unless* it . . . [c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage . . . persons . . . or bring them into contempt or disrepute."<sup>179</sup>

<sup>173</sup> See *infra* note 176.

<sup>174</sup> See, e.g., Pub. L. No. 101-508, § 10101, 104 Stat. 1388, 1388-91 (1990); see also 56 Fed. Reg. 65,142, 65,147 (1991); *USTA Holds Annual Meeting: Trademark Review Commission Releases Report*, 34 PAT. TRADEMARK & COPYRIGHT J. (BNA) 56, 58 (1987).

<sup>175</sup> See *BNA Patent Conference Reviews Recent Developments*, 37 PAT. TRADEMARK & COPYRIGHT J. (BNA) 173, 173-74 (1988).

<sup>176</sup> As a practical matter, this likely was true even in 1981. See *McGinley*, 660 F.2d at 487 (Rich, J., dissenting) ("More 'public funds' are being expended in the prosecution of this appeal than would ever result from the registration of [this] mark.").

<sup>177</sup> See, e.g., *Bullfrog Films, Inc. v. Wick*, 847 F.2d 502, 509-10 (9th Cir. 1988) (holding nonsubsidy argument unavailable to government if no treasury funds being expended).

<sup>178</sup> *In re Old Glory Corp.*, Serial No. 74/004,391, 1993 TTAB LEXIS 3, at \*15 n.3 (T.T.A.B. March 3, 1993).

<sup>179</sup> 15 U.S.C. § 1052(a) (1988).

This purposeful content-based exclusion of particular marks from the Register renders Section 2(a) ineligible for treatment as a presumptively valid decision not to subsidize even were the public fisc at stake.<sup>180</sup> Even in those cases in which it has upheld legislation singling out a particular viewpoint for funding, the Court repeatedly has conditioned its holdings on a finding that the decision was not intended to discourage contrary expression.<sup>181</sup> Rather, “[a] regulation of speech that is motivated by nothing more than a desire to curtail expression of a particular point of view . . . is the purest example of a ‘law . . . abridging the freedom of speech, or of the press.’”<sup>182</sup>

A finding that Section 2(a) properly should be held to satisfy the requirements of the First Amendment is not, of course, dispositive of the separate and independent issue of whether it does satisfy those standards. Nevertheless, commercial speech qualifies for *some* sort of constitutional protection.<sup>183</sup> Indeed, the Court has held that although the government may

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<sup>180</sup> See, e.g., *Keene v. Meese*, 619 F. Supp. 1111, 1126 (E.D. Cal. 1985) (applying unconstitutional conditions doctrine on finding that congressional decision to withhold particular benefits “reflects a conscious attempt to place a whole category of materials beyond the pale of legitimate discourse”).

<sup>181</sup> See, e.g., *Rust v. Sullivan*, 111 S. Ct. 1759, 1772 (1991) (“This is not a case of the Government ‘suppressing a dangerous idea’ . . . .”); *Regan v. Taxation With Representation*, 461 U.S. 540, 548 (1983) (applying rational review standard, but noting that higher standard of review would be warranted “if Congress were to discriminate invidiously in its subsidies in such a way as to ‘ai[m] at the suppression of dangerous ideas’”).

<sup>182</sup> *FCC v. League of Women Voters*, 468 U.S. 364, 383–84 (1984) (quoting *Consolidated Edison Co. v. Public Serv. Comm’n*, 447 U.S. 530, 546 (1980) (Stevens, J., concurring in judgment)); see also *Speiser v. Randall*, 357 U.S. 513, 518 (1958) (“It cannot be gainsaid that a discriminatory denial of a [benefit] for engaging in speech is a limitation on free speech.”); *Hannegan v. Esquire, Inc.*, 327 U.S. 146 (1946) (rejecting subsidy theory on evidence of viewpoint discrimination in denying benefit); cf. *Los Angeles City Council v. Taxpayers for Vincent*, 466 U.S. 789, 804 (1984) (“The First Amendment forbids the government [from] regulat[ing] speech in ways that favor some viewpoints or ideas at the expense of others.”).

<sup>183</sup> See, e.g., *Zauderer v. Office of Disciplinary Counsel*, 471 U.S. 626 (1985); *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748 (1976); *First Nat’l Bank v. Bellotti*, 435 U.S. 765, *reh’g denied*, 438 U.S. 907 (1978).

It is beyond dispute that trademarks, service marks, collective marks, and certification marks qualify as protectable commercial speech. See *Sambo’s Restaurants, Inc. v. City of Ann Arbor*, 663 F.2d 686 (6th Cir. 1981):

“Sambo’s” is a valuable trade name that communicates useful information to consumers. To be sure, since its inception in 1957, the trade name “Sambo’s” has

regulate speech that is false, deceptive, or misleading,<sup>184</sup> or that proposes an illegal transaction,<sup>185</sup> restrictions on commercial expression not falling within these categories must satisfy a tripartite test: (1) the asserted governmental interest must be substantial; (2) the regulation must directly advance the asserted government interest; and (3) the regulation may not be more extensive than is necessary.<sup>186</sup> Thus, assuming that Section 2(a) means what it says, and that its prohibitions against the registration of certain categories of marks are straightforward content-based restrictions, the proper focus in any inquiry into Section 2(a)'s constitutionality becomes whether these restrictions meet this test.<sup>187</sup>

That they do is doubtful. The Court has held that the government does not have a legitimate interest in suppressing merely "tasteless" commercial speech,<sup>188</sup> even speech that—as in *Doughboy Industries*, *Thomas Laboratories*, *McGinley*, and *Old Glory*—promotes sexually-related products or services.<sup>189</sup> Rather, assuming that the commercial speech in question does not consist of obscenity or child pornography, "the fact that [it] may be offensive to some

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received substantial promotion so as to acquire an identity in the eyes of the public. It conveys information because of the associations that have grown up over time between the name and . . . the quality of food and service. Clearly it conveys the type of information protected by the First Amendment, as the First Amendment's concern for commercial speech is based on the informational function of advertising.

*Id.* at 694 (citations omitted); *see also* *Friedman v. Rogers*, 440 U.S. 1, 22 n.3 (1979) (Blackmun, J., concurring in part and dissenting in part) ("Trade names are a vital form of commercial speech.").

<sup>184</sup> *See Friedman*, 440 U.S. at 19.

<sup>185</sup> *See Pittsburgh Press Co. v. Human Relations Comm'n*, 413 U.S. 376 (1973).

<sup>186</sup> *See Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n*, 447 U.S. 557, 563–66 (1980); *see also* *Shapero v. Kentucky Bar Ass'n*, 486 U.S. 466, 472 (1988); *Zauderer v. Office of Disciplinary Counsel*, 471 U.S. 626, 638 (1985).

<sup>187</sup> *See In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) ("[The right to registration] cannot be denied without compliance with . . . due process requirements.").

<sup>188</sup> *See Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 765 (1976) (holding that even "tasteless and excessive" commercial speech is not stripped of First Amendment protection); *Sable Communications v. FCC*, 492 U.S. 115 (1989) (invalidating ban on "indecent" speech for hire).

<sup>189</sup> *See, e.g., Carey v. Population Serv. Int'l*, 431 U.S. 678, 701 (1977) ("Appellants contend that advertisements of contraceptive products would be offensive and embarrassing to those exposed to them, and that permitting them would legitimize sexual activity of young people. But these are classically not justifications validating the suppression of expression protected by the First Amendment."); *see also* *Planned Parenthood Ass'n v. Chicago Transit Auth.*, 592 F. Supp. 544, 554 (N.D. Ill. 1984).

does not justify its suppression."<sup>190</sup> Consequently, affirmative prohibitions on use of a particular mark altogether merely on an allegation of offense would fail to satisfy the first prong of the Court's test and thereby violate the First Amendment.<sup>191</sup>

That being the case, it is equally apparent that the government cannot "produce a result which [it] could not command directly," by conditioning access to a particular benefit on a business' refraining from use of an offensive

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<sup>190</sup> *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 71-72 (1983); *Carey*, 431 U.S. at 701; *see also* *Consolidated Edison Co. v. Public Serv. Comm'n*, 447 U.S. 530, 541 (1980) (invalidating a state regulation allowing a public utility to use bill inserts to advocate particular commercial views but not others, on ground that "[e]ven if a short exposure to Consolidated Edison's views may offend the sensibilities of some consumers, the ability of government 'to shut off discourse solely to protect others from hearing it '[is] dependent upon a showing that substantial privacy interests are being invaded in an essentially intolerable manner'" (quoting *Cohen v. California*, 403 U.S. 15, 21 (1971)); *cf. Texas v. Johnson*, 491 U.S. 397, 414 (1989) ("If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.")).

<sup>191</sup> As one court has noted, "[i]t would be selling our birthright for a mess of pottage to hold that because [a mark] is offensive and distasteful even to a majority of the public, a legislative body may forbid its use." *Sambo's of Ohio v. City Council*, 466 F. Supp. 177, 180 (N.D. Ohio 1979).

Note that this principle does not extend to prohibitions against use of allegedly offensive marks that are the result of injunctive relief entered under Section 34 of the Act in an infringement suit. *See* 15 U.S.C. § 1116 (1988). Rather, given their content-neutrality, the Act's bars against a junior party's use of a mark confusingly similar to that of a senior user are legitimate exercises of congressional power under the Commerce Clause. *See Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc.*, 600 F.2d 1184, 1188 (5th Cir. 1979) (enjoining defendants' "gross and revolting" use of the plaintiff's marks on the ground that "[t]he first amendment is not a license to trammel on legally recognized rights in intellectual property"); *see also Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1192-93 (E.D.N.Y. 1972).

In the absence of a likelihood of confusion, whether a court may, consistent with the First Amendment, enjoin use of a plaintiff's mark under state dilution statutes, *see supra* note 151, on the ground that the plaintiff finds the defendant's use "offensive" is a subject of some judicial disagreement. *Compare L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir.) (defendant's use of imitation of plaintiff's mark in farcical "Back-to-School-Sex-Catalogue" magazine insert protected by First Amendment against suit brought under Maine dilution statute), *appeal dismissed*, 483 U.S. 1013 (1987) with *Pillsbury Co. v. Milky Way Prods.*, 215 U.S.P.Q. (BNA) 124 (N.D. Ga. 1981) (enjoining defendant's use in its magazine of plaintiff's trade characters "Poppin' Fresh" and "Poppie Fresh" engaged in sexual intercourse and fellatio under Georgia dilution statute).



mark.<sup>192</sup> Thus, for example, the Sixth Circuit in *Sambo's Restaurants, Inc. v. City of Ann Arbor*<sup>193</sup> held unconstitutional a municipality's attempt to condition a building permit on an applicant's abandoning a service mark found to be "a form of latent vilification."<sup>194</sup> As the concurring opinion noted in remarks equally appropriate to a refusal to register on the same grounds, "[i]f the company has a right to use the name under the First Amendment, then the [government] may not threaten to refuse [an otherwise available benefit] in order to induce a waiver any more than it may threaten an assault or other illegal conduct."<sup>195</sup> To the extent that the historical interpretation of Section 2(a) has required marks only to be "offensive" to be impermissibly "scandalous," "immoral," and "disparaging,"<sup>196</sup> this interpretation is in clear constitutional error.<sup>197</sup> Taken together with the infirmity of the *McGinley* court's holding that Section 2(a) is justifiable as a rational exercise of congressional spending authority,<sup>198</sup> current Section 2(a) doctrine therefore lacks an underlying constitutional basis.

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<sup>192</sup> See *Speiser v. Randall*, 357 U.S. 513, 526 (1958); cf. *In re McGinley*, 660 F.2d 481, 484-85 (C.C.P.A. 1981) ("[The right to registration] cannot be denied without compliance with Fifth Amendment due process requirements.").

<sup>193</sup> 663 F.2d 686 (6th Cir. 1981).

<sup>194</sup> *Id.* at 694.

<sup>195</sup> *Id.* at 696 (Merritt, J., concurring).

<sup>196</sup> See, e.g., *McGinley*, 660 F.2d at 485-86; *In re Riverbank Canning*, 95 F.2d 327, 328 (C.C.P.A. 1938); *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470, 1472 (T.T.A.B. 1988); *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1638 (T.T.A.B. 1988); *In re Tinseltown*, 212 U.S.P.Q. (BNA) 863, 865 (T.T.A.B. 1981); *In re Leo Quan Inc.*, 200 U.S.P.Q. (BNA) 370, 371 (T.T.A.B. 1978); *Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. (BNA) 176, 178-79 (T.T.A.B. 1978); *In re Madsen*, 180 U.S.P.Q. (BNA) 334, 335 (T.T.A.B. 1973); *In re Runsdorf*, 171 U.S.P.Q. (BNA) 443, 443-44; *In re Sociedade Agricola E. Comerical Dos Vinhos Messias, S.A.R.L.*, 159 U.S.P.Q. (BNA) 275, 275 (T.T.A.B. 1968); *Ex parte Parfum L'Orle*, 93 U.S.P.Q. (BNA) 481, 482 (Comm'r Patents 1952); *Ex parte Summit Brass and Bronze Works, Inc.*, 59 U.S.P.Q. (BNA) 22, 23 (Comm'r Patents 1943).

<sup>197</sup> See *Southeastern Promotions, Ltd. v. Conrad*, 420 U.S. 546, 549-50 (1975) (invalidating city's attempt to condition group's access to public forum on group's engaging only in "clean and healthful and culturally uplifting" presentations) (quoting respondent from district court); *Hannegan v. Esquire, Inc.*, 327 U.S. 146, 158-59 (1946) (invalidating postal service's conditioning second-class mailing privileges on magazine's abstaining from "indecent" speech and that falling into the category of "morally improper and not for the . . . public good") (quoting Postmaster General's opinion revoking respondent's second-class mailing privileges).

<sup>198</sup> See *supra* notes 172-82 and accompanying text.

This does not, however, render Section 2(a) an entirely dead letter. For example, interpreting the terms "scandalous" and "immoral" to encompass only obscenity and child pornography, both of which the government has a *compelling* interest in prohibiting,<sup>199</sup> would more than satisfy the first prong of the Court's tripartite commercial speech analysis.<sup>200</sup> So too would restricting Section 2(a)'s prohibition on "disparaging" material to wholly unprotected "fighting words"<sup>201</sup> or defamation<sup>202</sup> also comply with the strictures of the First Amendment.<sup>203</sup>

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<sup>199</sup> *Roth v. United States*, 354 U.S. 476 (1957) (obscenity); *see also* *New York v. Ferber*, 458 U.S. 747 (1982) (child pornography).

<sup>200</sup> *See McGinley*, 660 F.2d at 485 n.9 ("[T]he threshold for objectionable matter is lower for what can be described as 'scandalous' than for 'obscene' . . .").

<sup>201</sup> *Compare* *Chaplinsky v. New Hampshire*, 315 U.S. 568, 571-72 (1942) (fighting words unprotected by First Amendment) *with* *R.A.V. v. City of St. Paul*, 112 S. Ct. 2538, 2540 (1992) (invalidating, on First Amendment grounds, a municipal ordinance prohibiting display of a symbol "which one knows or has reason to know 'arouses anger, alarm, or resentment in others on the basis of race, color, creed, religion, or gender'").

Note that in *Sambo's*, the Sixth Circuit rejected on evidentiary grounds the defendant municipality's argument that the plaintiff's service mark was a "fighting word" worthy of affirmative suppression. *See Sambo's Restaurants, Inc. v. City of Ann Arbor*, 663 F.2d 686, 694-95 (6th Cir. 1981).

<sup>202</sup> *See Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 342-50 (1974) (defamation unprotected by First Amendment).

Whether a mark can be defaming in and of itself is an unsettled issue. In *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972), the plaintiff alleged that the defendant's stylized ENJOY COCAINE slogan was *per se* libellous in that its strong resemblance to the plaintiff's ENJOY COCA-COLA mark implicitly represented that the plaintiff was engaged in the marketing of a dangerous drug. *Id.* at 1190. Although not expressly finding that the defendant's use defamed the plaintiff, the court ordered injunctive relief in substantial part on the ground that, "[t]o associate such a noxious substance as cocaine with plaintiff's . . . trademark . . . would clearly have a tendency to impugn [plaintiff's] product and injure plaintiff's business reputation . . ." *Id.* at 1189; *cf.* *Gucci Shops, Inc. v. R.H. Macy & Co.*, 446 F. Supp. 838, 840 (S.D.N.Y. 1977) (Lanham Act protects against "ridicule" of plaintiff's mark).

In contrast, however, in *Stop the Olympic Prison v. United States Olympic Comm.*, 489 F. Supp. 1112 (S.D.N.Y. 1980) (action for declaratory judgment), the court expressly rejected the claim that the plaintiff's use of the defendant's mark in literature protesting the planned conversion of the Lake Placid Olympic Village into a federal prison libelled the defendant by linking it to the prison. Relying on the defendant's failure to present evidence either that (1) the plaintiff's use of the mark was false or misleading, or (2) the plaintiff had acted with reckless disregard of whether it was false or not, the court found that no defamation had occurred. *Id.* at 1124-25.

According to these definitions to the categories of marks targeted by the statute would still comport with congressional intent by continuing to preclude truly repugnant marks from reaching the Principal Register.<sup>204</sup> Thus, for example, the registrability of the design mark at issue in *McGinley*, a photograph of an embracing nude couple, would still be subject to challenge on obscenity grounds.<sup>205</sup> Of greater importance, however, adoption of the alternative interpretations advanced here would bring Section 2(a) into compliance with constitutional requirements—mandates heretofore too frequently ignored.

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Although cases such as these are perhaps relevant to a determination of whether a mark is so defaming that it is not entitled to registration under Section 2(a), the plaintiff's objections in *Gemini Rising* and the defendant's objections in *Olympic Prison* were grounded in the opposing party's arguable misappropriation of the marks. To the extent that mark owners have attempted to enjoin use of allegedly defaming marks in the absence of a claim of superior rights to those marks, these attempts have failed. In *Japanese Am. Citizens League v. Takada*, 171 U.S.P.Q. (BNA) 109 (N.Y. Sup. Ct. 1971), for example, a group of Japanese Americans sought an injunction against, and a public apology for, the defendant's use of its JAP mark for clothing on the grounds that the term subjected them "to contempt, ridicule and scandal." The court, however, declined to issue a preliminary injunction, in substantial part on the ground that "[p]etitioners do not claim that . . . by the use of the word or trade name, [defendant] deprived them of a valuable right to the word." *Id.* at 109.

<sup>203</sup> *Bigelow v. Virginia*, 421 U.S. 809, 819 (1975) (acknowledging possibility that commercial speech falling within these categories can legitimately be suppressed).

<sup>204</sup> See *American Communications Ass'n v. Douds*, 339 U.S. 382, 407 (1950) ("[I]t is the duty of this Court to construe a statute so as to avoid the danger of unconstitutionality if it may be done in consonance with the legislative purpose."); see also *United States v. Congress of Indus. Orgs.*, 335 U.S. 106, 120-21 (1948); *United States v. Delaware & Hudson Co.*, 213 U.S. 366, 407-08 (1909).

<sup>205</sup> Note, however, that even the *McGinley* court acknowledged that "[i]t is well established . . . that nudity *alone* is not obscene." *In re McGinley*, 660 F.2d 481, 485 n.9 (C.C.P.A. 1981); cf. *In re Thomas Lab.*, 189 U.S.P.Q. (BNA) 50, 51 (T.T.A.B. 1975) ("The mere fact that the male figure which constitutes the mark is apparently unclothed cannot in and of itself militate against registrability.").

For differing views on the relationship between "scandalous" or "immoral" material, on the one hand, and "obscenity," on the other, compare *McGinley*, 660 F.2d at 485 n.9 ("[T]he threshold for objectionable matter is lower for what can be described as 'scandalous' than for 'obscene' . . .") with *Thomas Lab.*, 189 U.S.P.Q. (BNA) at 52 (equating scandalous and immoral material with obscenity).

## B. *Interaction of Goods, Services, and Marks Under Section 2(a)*

As set forth above in greater detail, judicial interpretations of Section 2(a) have produced conflicting treatments of the relationship between a mark and the goods or services in connection with which it is used.<sup>206</sup> Decisions following *Riverbank Canning*, for example, hold that an otherwise innocuous mark may be made unregistrable by its association with particular goods or services. A separate line of cases, however, has held that the proper inquiry when determining a mark's registrability under Section 2(a) is whether the mark is scandalous, immoral, or disparaging *per se*, separately and independently of the nature of the mark owner's business.

Of these differing treatments, it is the latter that warrants uniform adoption. To begin with, the statutory language itself does not mandate consideration of the covered goods and services. Rather, it simply proscribes registration of any mark that "[c]onsists 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."<sup>207</sup> In stark contrast, however, the content-based restrictions of Sections 2(d) and 2(e) each expressly require consideration of marks "when used on or in connection with the goods of the applicant" in determining registrability.<sup>208</sup>

That this is a distinction with a difference is apparent from the other subsections of Section 2 that, like Section 2(a), also omit the "when used on or

<sup>206</sup> See *supra* notes 33–88 and accompanying text.

<sup>207</sup> 15 U.S.C. § 1052(a) (1988).

<sup>208</sup> These sections provide, in relevant part:

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—

. . . .

(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 . . . . [or]

(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, or (2) *when used on or in connection with the goods of the applicant* is primarily geographically descriptive or deceptively misdescriptive of them . . . .

*Id.* § 1052(d)–(e) (emphasis added).

in connection with the goods" language in favor of an express *per se* standard. For example, Section 2(b) bars registration of the United States flag,<sup>209</sup> a prohibition that can hardly be considered applicable to some goods and services, but not others.<sup>210</sup> Similarly, it strains credulity to imagine that Congress intended Section 2(c)'s rule against the registration without consent of the names of deceased Presidents or of living individuals<sup>211</sup> to be summarily suspended upon a finding that the goods or services in question are benign or innocuous.<sup>212</sup> *Riverbank Canning*, however, completely fails to take into account these differences in wording.<sup>213</sup>

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<sup>209</sup> See *id.* § 1052(b).

<sup>210</sup> Indeed, Section 2(b) is perhaps the clearest possible evidence that Congress intended to enact a *per se* standard of registrability under at least some sections of the Act. For example, a pennant bearing a stars and stripes design does not become more of a United States flag for purposes of Section 2(b) when used as a trademark for condoms, but less of one when associated with apple pie. To the contrary, it either is the flag or it isn't, separately and independently of the relevant goods or services. Cf. *In re McGinley*, 660 F.2d 481, 487 (C.C.P.A. 1981) (Rich, J., dissenting) ("[A]mazingly, on the crucial matter the majority equivocates in the phrase 'appearing to expose the male genitalia.' Either it does or it doesn't and I find it doesn't.").

<sup>211</sup> See 15 U.S.C. § 1052(c) (1988).

<sup>212</sup> Thus, for example, as in Section 2(b) determinations, see *supra* note 210, the phrase "John Fitzgerald Kennedy" is no less a "name . . . of a deceased President of the United States" when used as a trademark for white bread than is the phrase "Lyndon Baines Johnson" when used in connection with marijuana. Rather, these arrangements of words *in and of themselves* constitute names of deceased Presidents and there is no apparent reason why societal views on the covered goods and services should affect their registrability (or, more properly, the lack thereof), particularly in view of Section 2(c)'s conspicuous omission of the standard "when used on or in connection with the goods of the applicant" qualifier. Indeed, as demonstrated by the following colloquy between Congressman Lanham and Edward S. Rogers concerning the language that eventually became Section 2(c), the provision clearly was intended as a blanket prohibition on the registration of *all* such marks, without regard to their goods or services:

MR. LANHAM. Are there any other objections to this section? There is one to which I wish to call attention, if I may, Mr. Rogers. That is in subsection (c) of section [2]. I am very doubtful whether the name of a President of the United States, even after his widow has passed on should be used in commerce.

. . . .

MR. ROGERS. Subsection (c) of section [2] restates the existing law. I quite agree with you that it is much too narrow, and it ought to be broadened. The idea of prostituting great names by sticking them on all kinds of goods is very distasteful to me. It is prohibited in most countries.

More importantly, however, *Riverbank Canning* is irreconcilable with the Lanham Act on another, more fundamental level. Judicial interpretations of the Act, as well as the common law of unfair competition, historically have afforded protection to marks on the basis of their distinctiveness as identifiers of origin. In infringement actions, courts typically begin likelihood of confusion analyses<sup>214</sup> by classifying the plaintiff's mark either as: (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.<sup>215</sup>

Through this classification, federal law encourages mark owners to select marks that do not convey information about their goods or services, *i.e.*, marks

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MR. LANHAM. Personally I think that there ought to be a provision in any law we enact that will prevent the use of the name of the President or any other well-known American character in this connection.

1938 House Hearings, *supra* note 40, at 79.

<sup>213</sup> Outside of Section 2(a) disputes, even the Court of Customs and Patent Appeals has attached significant weight to the presence or absence of this language. For example, in *In re Nantucket, Inc.*, 677 F.2d 95 (C.C.P.A. 1982), the court overruled the Board's interpretation of Section 2(e)(2), which prohibits registration of marks that "when used on or in connection with the goods of the applicant [are] primarily geographically descriptive or deceptively misdescriptive of them." See 15 U.S.C. § 1052(e)(2) (1988). In initially refusing to allow registration of the applicant's NANTUCKET mark, the Board took into account only the mark itself and the actual geographic origin of the goods, without consideration of their nature. Reversing this decision, however, the Court of Customs and Patent Appeals noted that "the [B]oard's test does not track the statute. Moreover, in rendering functionless the phrase 'when applied to the goods of the applicant' and the word 'deceptively,' the test violates a cardinal rule of statutory construction, *i.e.*, that a legislature is presumed to have used no superfluous words." *Nantucket*, 677 F.2d at 98; *see also* *World Carpets, Inc. v. Dick Littrell's New World Carpets*, 438 F.2d 482, 486 (5th Cir. 1971).

<sup>214</sup> "[T]he essential question in any case of alleged trademark infringement brought under the Lanham Act or under the law of unfair competition is 'whether a substantial number of ordinarily prudent purchasers are likely to be misled or confused as to the source of the different products.'" *Information Clearing House, Inc. v. Find Magazine*, 492 F. Supp. 147, 154 (S.D.N.Y. 1977) (quoting *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 441 F. Supp. 1220, 1225 (S.D.N.Y. 1977), *aff'd*, 580 F.2d 44 (2d Cir. 1978), *cert. denied*, 439 U.S. 1116 (1979)).

<sup>215</sup> See, *e.g.*, RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. b (Tent. Draft No. 2, 1990); *see also* *Perini Corp. v. Perini Const., Inc.*, 915 F.2d 121, 124 (4th Cir. 1990); *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790 (5th Cir. 1983); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976). These categories, of course, are not easily drawn in all cases: "Although meant as pigeon-holes, these useful labels are instead central tones in a spectrum; they tend to merge at their edges and are frequently difficult to apply." *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1183 (5th Cir. 1980), *cert. denied*, 450 U.S. 981 (1981).

toward the fanciful end of the spectrum. Thus, for example, the generic name of an article may not be protected as a mark.<sup>216</sup> Likewise, under most circumstances, descriptive words communicating information as to the quality or nature of their goods or services also are in the "public domain" in that all sellers should be free to use these terms truthfully to describe their wares.<sup>217</sup> In contrast, however, arbitrary<sup>218</sup> or wholly invented or fanciful marks<sup>219</sup> that do not communicate any information about their goods or services are entitled to the broadest scope of protection available.

Despite this general rule, protection is available under certain circumstances for marks communicating information about their products or services. For example, a completely descriptive mark may be protected, and even registered, if it has become uniquely associated with its owner's products

<sup>216</sup> See, e.g., *Holzappel's Compositions Co. v. Rahtjen's American Composition Co.*, 183 U.S. 1, 9 (1901) (public free to use "[t]he only name by which it is possible to describe" an article).

<sup>217</sup> 1 MCCARTHY, *supra* note 16, § 11:05[3], at 11-23. As the Supreme Court has noted of the protection available to purely descriptive marks upon their adoption:

[T]he law would not secure to any person the exclusive use of a trade-mark consisting merely of words descriptive of the qualities, ingredients or characteristics of an article of trade. This for the reason that the function of a trade-mark is to point distinctively, either by its own meaning or by association, to the origin or ownership of the wares to which it is applied, and words merely descriptive of qualities, ingredients or characteristics, when used alone, do not do this. Other like goods, equal to them in all respects, may be manufactured or dealt in by others, who, with equal truth, may use, and must be left free to use, the same language of description in placing their goods before the public.

*Estate of Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 543-44 (1920).

<sup>218</sup> Arbitrary marks, which are next in order of distinctiveness, are words having a common meaning but no connotation in association with the user's goods. See, e.g., *Stork Restaurant, Inc. v. Sahati*, 166 F.2d 348 (9th Cir. 1948) (THE STORK CLUB for a restaurant); *Borden, Inc. v. Topps Chewing Gum, Inc.*, 173 U.S.P.Q. (BNA) 447 (T.T.A.B. 1972) (ICE CREAM for chewing gum).

<sup>219</sup> The most distinctive and, therefore, protectable marks are invented or fanciful terms having no inherent linguistic meaning. See, e.g., *Polaroid Corp. v. Polaroid, Inc.*, 319 F.2d 830, 837 (7th Cir. 1963) (holding POLAROID mark entitled to broad protection as it is a "coined" or "invented" word); *Kotabs, Inc. v. Kotex Co.*, 50 F.2d 810, 811 (3d Cir.) (finding KOTEX mark "a coined word, arbitrary in the extreme"), *cert. denied*, 284 U.S. 665 (1931); *Clorox Chemical Co. v. Chlorit Mfg. Corp.*, 25 F. Supp. 702, 705 (E.D.N.Y. 1938) (holding CLOROX mark a "fanciful word, arbitrarily selected").

or services.<sup>220</sup> Such acquired distinctiveness, or so-called "secondary meaning," exists "[if], in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself."<sup>221</sup>

In contrast, suggestive marks are entitled to protection and federal registration even in the absence of secondary meaning.<sup>222</sup> Like descriptive marks, however, they too communicate information about their goods or services to potential consumers:

It cannot be said that they are primarily descriptive or that they are purely arbitrary or fanciful without any indication of the nature of the goods which they denominate. Such terms, indeed, shed some light upon the characteristics of the goods, but so applied they involve an element of incongruity, and in order to be understood as descriptive, they must be taken in a suggestive or figurative sense through an effort of the imagination . . . .<sup>223</sup>

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<sup>220</sup> See *Armstrong Paint & Varnish Works v. Nu-Enamel Corp.*, 305 U.S. 315, 336 (1938); *Coca-Cola Co. v. Koke Co. of America*, 254 U.S. 143, 146 (1920); see also 15 U.S.C. § 1052(e)-(f) (1988) (permitting registration of "merely descriptive" terms that have acquired distinctiveness as indicators of origin).

<sup>221</sup> *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 851 n.11 (1982); see also *Charcoal Steak House, Inc. v. Staley*, 139 S.E.2d 185, 187 (N.C. 1964) ("When a particular business has used words publici juris for so long or so exclusively or when it has promoted its product to such an extent that the words do not register their literal meaning on the public mind but are instantly associated with one enterprise, such words have attained a secondary meaning."). An owner of a descriptive mark seeking to establish that her mark has acquired the secondary meaning necessary for registration may do so by presenting evidence of, inter alia, her advertising expenditures, sales of her goods, and the nature of her use. See generally *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1125 (Fed. Cir. 1985); *In re Hollywood Brands*, 214 F.2d 139, 141 (C.C.P.A. 1954); *In re Motorola Inc.*, 3 U.S.P.Q.2d (BNA) 1142, 1143 (T.T.A.B. 1986).

<sup>222</sup> See, e.g., *Thompson Medical Co. v. Pfizer Inc.*, 753 F.2d 208, 216 (2d Cir. 1985) ("Suggestive marks are eligible for protection without any proof of secondary meaning, since the connection between the mark and the source is presumed."); see also *Hindu Incense v. Meadows*, 692 F.2d 1048, 1050 (6th Cir. 1982); *American Home Prods. Corp. v. Johnson Chem. Co.*, 589 F.2d 103, 106-07 (2d Cir. 1978); *Norwich Pharmacal Co. v. Charles Pfizer & Co.*, 165 U.S.P.Q. (BNA) 644 (T.T.A.B. 1970).

<sup>223</sup> *General Shoe Corp. v. Rosen*, 111 F.2d 95, 98 (4th Cir.), *reh'g denied*, 112 F.2d 561 (4th Cir. 1940); see also *Stix Prods., Inc. v. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968) ("A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods.").



Consequently, such a relationship with its goods or services does not render a suggestive word ineligible for protection and, in fact, "suggestive words may be and frequently are very good trademarks."<sup>224</sup>

*Riverbank Canning*, however, is flatly inconsistent with these fundamental principles of unfair competition law. By providing that an otherwise registrable mark may become unregistrable under Section 2(a) solely through its association with particular goods or services, this approach limits their producers' ability not only to register particular marks but, more importantly, *all* marks communicating information about their businesses. Strictly applied, this analysis would constructively preclude manufacturers of such goods as swingers' newsletters, penis size-increasing devices, and brassieres from using *any* suggestive or descriptive marks for their wares.<sup>225</sup>

More importantly, this methodology can prevent registration even of wholly *arbitrary* marks. The lexicographic meaning of the word "doughboy," for example, has no apparent connection to a prophylactic preparation for the prevention of venereal disease. Similarly, the words "Queen Mary" communicate nothing about women's undergarments. As a result, such terms ordinarily would be ideal marks under traditional principles of unfair competition law.<sup>226</sup> Yet, each was denied registration in *Doughboy*

<sup>224</sup> *Continental Scale Corp. v. Weight Watchers Int'l Inc.*, 517 F.2d 1378, 1380 (C.C.P.A. 1975); cf. *In re Madsen*, 180 U.S.P.Q. (BNA) 334, 335 (T.T.A.B. 1973) (upholding registrability of applicant's mark against an initial Section 2(a) rejection, notwithstanding acknowledgement that "we do not deny that 'WEEK-END SEX' would no doubt bring to mind a magazine dealing with sexual relationships or affairs on weekends").

<sup>225</sup> Cf. *San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522 (1987):

Here, the [defendant] intended, by use of the word "Olympic," to promote a realistic image of homosexual men and women that would help them move into the mainstream of their communities. As Judge Koszinski observed in dissent in the Court of Appeals, just as a jacket reading "I Strongly Resent the Draft" would not have conveyed Cohen's message, so a title such as "The Best and Most Accomplished Amateur Gay Athletes Competition" would not serve as an adequate translation of [defendant's] message. . . . By prohibiting use of the word "Olympic," the [plaintiff] substantially infringes upon the [defendant's] right to communicate ideas.

*Id.* at 569-70 (citation omitted) (Brennan, J., dissenting).

<sup>226</sup> See, e.g., *Horizon Financial, F.A. v. Horizon Bancorp*, 2 U.S.P.Q.2d (BNA) 1696, 1702 (E.D. Pa. 1987).

*Industries*<sup>227</sup> and *Martha Maid*,<sup>228</sup> respectively. *Riverbank Canning* therefore hinders the registration of marks that the remainder of the Act not only permits, but *encourages*,<sup>229</sup> thereby flying in the face of the principle that "[e]ach part or section of [the Lanham Act] should be construed in connection with every other part or section so as to produce a harmonious whole, and it is not proper to confine interpretation to the one section to be construed."<sup>230</sup>

Beyond being inconsistent with the express text of both Section 2(a) and the remainder of the Act, *Riverbank Canning* therefore unnecessarily erects a substantive barrier to effective competition in certain "politically incorrect" industries that does not exist in others.<sup>231</sup> Avenues of commercial communication available to such (presumably) innocuous businesses as suntan lotion manufacturers are off limits to those whose wares and services themselves might provoke offense among the general public. In addition to injecting a further level of subjectivity into the registrability inquiry absent from the *per se* test contemplated by Section 2(a)'s express text, this analysis thus applies the Act in a manner in irreconcilable conflict with its underlying purposes of promoting competition and protecting consumers from misinformation.<sup>232</sup>

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<sup>227</sup> *Doughboy Indus. v. Reese Chem. Corp.*, 88 U.S.P.Q. (BNA) 227 (T.T.A.B. 1951).

<sup>228</sup> *Ex parte Martha Maid Mfg. Co.*, 37 U.S.P.Q. (BNA) 156 (T.T.A.B. 1938).

<sup>229</sup> As one court has noted of distinctive marks such as those potentially denied registration under *Riverbank Canning* because they are descriptive or suggestive, "[e]asily identified trademarks reduce the costs consumers incur in searching for what they desire, and the lower the costs of search the more competitive the market." *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1429 (7th Cir. 1985).

<sup>230</sup> *In re Nantucket, Inc.*, 677 F.2d 95, 98 (C.C.P.A. 1982) (citation omitted); *see also Kokoszka v. Belford*, 417 U.S. 642 (1974):

When interpreting a statute, the court will not look merely to a particular clause in which general words may be used, but will take in connection with it the whole statute . . . and the objects and policy of the law, as indicated by its various provisions, and give to it such a construction as will carry into execution the will of the legislature . . . .

*Id.* at 650 (citation omitted).

<sup>231</sup> *See, e.g., In re Riverbank Canning*, 95 F.2d 327, 330 (C.C.P.A. 1938) (Jackson, J., dissenting) ("With respect to some [persons], wine itself is considered a scandalous thing and they would, if they could, not only deny to it a name, but destroy it utterly.").

<sup>232</sup> *See* S. Rep. No. 1333, 79th Cong., 2d Sess. (1946), *reprinted in* 1946 U.S.C.C.A.N. 1274:

Governments, of course, often have legitimate, if not compelling, reasons for discouraging competition in markets for certain goods and services. The appropriate mechanisms for accomplishing this, however, lie outside of content-based applications of trademark law. Thus, for example, express federal prohibitions on the interstate shipment of obscene materials<sup>233</sup> or state obscenity prosecutions<sup>234</sup> are each far more likely to bring about a reduction in the number of obscene magazines in circulation than restricting their publishers' access to particular marks.<sup>235</sup> Likewise, although health concerns may indeed justify the federal government's discouraging the production and sale of multicolored condoms,<sup>236</sup> proper action should assume the form of FDA regulations narrowly drafted for that purpose, rather than the far more subtle mechanism of denying registration to suggestive marks for these goods<sup>237</sup> merely because they are, in fact, suggestive.<sup>238</sup>

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Trade-marks, indeed, are the essence of competition, because they make possible a choice between competing articles by enabling the buyer to distinguish one from another. [They] encourage the maintenance of quality by securing to the producer the benefit of the good reputation which excellence creates. To protect [such symbols], therefore, is to protect the public from deceit, to foster fair competition, and to secure to the business community the advantages of reputation and good will by preventing their diversion from those who have created them to those who have not.

*Id.* at 1275.

<sup>233</sup> See, e.g., 18 U.S.C. § 1461 (1988) (criminalizing the mailing of obscene materials); *id.* § 1462 (criminalizing the interstate shipment of obscene materials by common carrier); *id.* § 1465 (criminalizing the interstate shipment of obscene materials for the purpose of sale or distribution).

<sup>234</sup> See *Miller v. California*, 413 U.S. 15 (1973) (setting forth standard for obscenity).

<sup>235</sup> As the Board noted in *In re Madsen*, 180 U.S.P.Q. (BNA) 334, 335 (T.T.A.B. 1973), "the question of whether or not the contents of [a] magazine may be pornographic in nature, is not an issue to be decided by this Board. If such were the criterion, many well-known magazines with inoffensive or arbitrary titles might well have been precluded registration in the Patent Office."

<sup>236</sup> See Marylou Tounsignant, *Drawing the Line on Patriotic Activity: Distributor Appeals Denial of 'Old Glory' Trademark*, WASH. POST, May 21, 1992, at A1.

<sup>237</sup> In fact, the prophylactics at issue in *Old Glory* were individually packaged (but not multicolored) red, white, and blue condoms. See *id.*

<sup>238</sup> Cf. *Anheuser-Busch, Inc. v. L & L Wings, Inc.*, 962 F.2d 316, 322 (4th Cir.) ("The purpose of the Lanham Act is to eliminate consumer confusion, not to banish all attempts at poking fun or eliciting amusement. The statute is designed to protect consumers from product misinformation, not to deprive the commercial world of all humor and levity." (citation omitted)), *cert. denied*, 113 S. Ct. 206 (1992).

Indeed, that unfair competition law is a wholly inappropriate vehicle for expressing societal opprobrium at particular goods and services is apparent in the holdings of Section 2(a) cases invoking *Riverbank Canning*. Although the need for a thriving market in swingers' newsletters and penis size-increasing devices may be debatable, the same hardly can be said of underwear and brassieres. Restricting the relevant inquiry to a purely *per se* consideration of the mark itself would avoid imposing competitive penalties on particular industries in the absence of reasoned legislative or administrative findings that such restrictions are necessary—determinations that clearly would not occur for some goods and services particularly suspect under *Riverbank Canning*.

Of equal importance is the fact that, although adoption of the *per se* standard would preclude an innocent mark from becoming impermissibly scandalous, immoral, or disparaging as used, the contrary would not necessarily hold. More specifically, the owner of a patently offensive *per se* mark would not be able to evade Section 2(a) by associating the mark with innocuous goods or services.<sup>239</sup> Thus, for example, assuming the correctness of the *Greyhound* Board's conclusion that a substantial composite of the general public would find scandalous a graphic portrayal of a defecating dog,<sup>240</sup> the same graphic portrayal would be no less scandalous if applied to buses. Similarly, the "profane" nature of the BULLSHIT mark at issue in *Tinseltown*<sup>241</sup> hardly would have been altered had the goods been fertilizers rather than fashion accessories.<sup>242</sup> Limiting Section 2(a) to its express text

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<sup>239</sup> On this issue, compare Leonard Shapiro, *Native American Coalition Files Action on 'Redskins,'* WASH. POST, September 11, 1992, at C1, C4 ("Because the word "redskin" has historically and is still commonly used as a pejorative, derogatory term, the . . . registrations of the Washington Redskins should not have been granted and are subject to cancellation.") with Hadley D. Kress, *Letter to the Editor*, WASH. POST, March 14, 1992, at A22 ("If the Washington Redskins football team was an organization comparable in character to—for example, the Ku Klux Klan—then our Native Americans should well be perturbed. Since the football team is a group of highly competent and generally well behaved athletes, well coached and managed, no persons or group should object to being identified with them.").

<sup>240</sup> *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1639 (T.T.A.B. 1988).

<sup>241</sup> See *In re Tinseltown*, 212 U.S.P.Q. (BNA) 863, 865-66 (T.T.A.B. 1981) (footnote omitted).

<sup>242</sup> In other words, although an otherwise acceptable mark would not become unregistrable merely because it was suggestive or descriptive, an otherwise unacceptable mark could not satisfy Section 2(a) by falling into the same categories.

therefore would fulfill its purpose of barring the proscribed matter without unnecessarily subverting the underlying goals of the Act as a whole.<sup>243</sup>

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<sup>243</sup> Omitting consideration of the goods and services covered by a mark in this manner *does*, of course, leave unresolved the significance of a mark's likely audience when evaluating registrability under Section 2(a). As set forth above, outcome-oriented decisions inconsistently have held in some cases that the nature of certain goods renders marks used for them particularly susceptible to a finding that they are scandalous, immoral, or disparaging, only to gloss over this finding in other cases involving identical goods when necessary to allow registration. *See supra* notes 33–88 and accompanying text. *Compare In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470 (T.T.A.B. 1988) (allowing registration of applicant's mark for use in connection with shirts without consideration of number of people potentially exposed to mark) with *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d (BNA) 1635 (T.T.A.B. 1988) (holding potential exposure of applicant's mark for shirts to unlimited number of people to weigh against registrability). There are, however, a number of factors suggesting that a trier of fact should assume that a mark may present itself to the entire populace, including individuals especially prone to being scandalized and disparaged.

First, such a rule is consistent with the standards articulated by the *McGinley* court and the *Greyhound* Board for determining on the merits whether particular marks fall afoul of Section 2(a)'s prohibitions. More specifically, *McGinley's* equating of "scandal" and "immorality" with offense felt by "a substantial composite of the general public," necessarily requires consideration of the sentiments of the public as a whole. *See In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981). Similarly, *Greyhound's* "reasonable person" standard for evaluating disparagement also discourages reliance on a single (possibly idiosyncratic) individual's perspective. *See Greyhound*, 6 U.S.P.Q.2d (BNA) at 1639.

Second, marks frequently are viewed by individuals other than those actually contracting for the covered goods and services. Thus, for example, passers-by viewing an infringing mark may be confused as to the origin of the goods to which it is affixed even if the original purchaser was not. *See, e.g., T & T Mfg. Co. v. A.T. Cross Co.*, 449 F. Supp. 813, 820–22 (D.R.I.), *aff'd*, 587 F.2d 533 (1st Cir. 1978), *cert. denied*, 441 U.S. 908 (1979); *see also Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches, Inc.*, 221 F.2d 464, 466 (2d Cir.), *cert. denied*, 350 U.S. 832 (1955); *Rolls-Royce Motors Ltd. v. A & A Fiberglass, Inc.*, 428 F. Supp. 689, 694 n.10 (N.D. Ga. 1977). So too, therefore, are goods bearing allegedly scandalous, immoral, or disparaging marks likely in the long run to present themselves to the easily offended. *See, e.g., McGinley*, 660 F.2d at 487–88:

Unlike the situation in some obscenity cases, the graphic portrayal before us does not appear within the covers of a magazine or a book to be freely examined or ignored by a person knowing the contents. Instead, as a mark, it may be used in a prominent location for public viewing by persons of all ages and convictions. As to appellant's argument that the mark is no more offensive than works of art which are publicly displayed, we

### C. Evaluating the Sufficiency of Section 2(a) "Injuries" as Article III Standing

As set forth above,<sup>244</sup> the Board in *Bromberg* adopted a relatively liberal measure for determining a potential opposer's standing under the interaction of Sections 2(a) and 13.<sup>245</sup> Under *Bromberg*, standing exists whenever individuals or businesses assert that they "might be offended by a mark which they

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agree with the board that "as trademarks or service marks, they are not before us for adjudication."

*Id.*; accord *Greyhound*, 6 U.S.P.Q.2d (BNA) at 1639 ("[T]he goods are T-Shirts and polo shirts, goods which may be encountered in sales establishments patronized by a wide variety of people of all ages and convictions, or may be worn and seen by people in virtually all public places."). Consequently, restrictions contained in a registration's or application's recitations of goods and services therefore are likely to mean little after the point of sale.

Finally, because one of the primary bases of the federal registration process is that a mark's presence on the Principal Register constitutes nationwide constructive notice of its registration, 15 U.S.C. § 1072 (1988), it follows that constructive offense may result as well. As the *Tinseltown* Board noted in rejecting that applicant's claim that its goods were sold only to sophisticated consumers, with presumably less delicate sensibilities than the general populace:

Although there appears to be considerable question about what was the underlying motivation behind the § 2(a) prohibition of registration of scandalous and immoral matter, there appears to be no question that Congress has long and consistently expressed its will that such matter not be accorded the statutory benefits of registration on any register within its control. Since these Congressional expressions have always been in reference to *national* registers of marks, the benefits of which are accorded for all the territory which is subject to the control of Congress, we could not possibly apply a standard of public policy to the question before us which would be limited to a particular stratum of society, defined by its level of "sophistication," or, as others might perceive it, its level of vulgarity.

*Tinseltown*, 212 U.S.P.Q. (BNA) at 865 (citation and footnote omitted).

<sup>244</sup> See *supra* notes 138-61 and accompanying text.

<sup>245</sup> Because *Bromberg* was an opposition proceeding and because, with the exception of the inartfully pleaded *Abraham's Seed v. John One Ten*, 1 U.S.P.Q.2d (BNA) 1230 (T.T.A.B. 1986), see *supra* note 153, there are no reported cancellation actions under Section 2(a), the following sections will, for the sake of convenience, refer to potential challengers to marks' registrability as opposers. Note, however, that the analysis set forth below is equally applicable to the standing requirements for would-be petitioners to cancel. See *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1028-30 (C.C.P.A. 1982) (standards for satisfying Section 13 and Section 14 are identical).

consider to be scandalous." Whether or not offense sufficient to prevent a mark's registration actually exists is a matter reserved for proof on the merits.<sup>246</sup>

*Bromberg's* narrow focus on the existence of mere *statutory* standing, however, does not dispose of the separate and independent inquiry of whether the opposers in that case enjoyed *constitutional* standing to proceed. Although the development and evolution of the doctrine of standing as a constitutionally mandated jurisdictional barrier has hardly produced a cohesive or consistent body of law,<sup>247</sup> certain governing principles have emerged from the Supreme Court's interpretations of Article III. And it is an application of these principles—an application wholly ignored by the Board in *Sta-Power*, *Greyhound*, and *Bromberg*—that reveals the constitutional infirmity of the *Bromberg* standard.

Under the Court's decisions, litigants must meet three general conditions to fulfill Article III's requirements. The first of these is that the grievant actually must have suffered a distinct and palpable injury.<sup>248</sup> Second, the grievant must demonstrate that "the interest sought to be protected is arguably within the zone of interests to be protected or regulated by the statute or constitutional

<sup>246</sup> *Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. (BNA) 176, 179 (T.T.A.B. 1978). As the Board itself has characterized this rule, "[t]he requirements for standing in a petition to cancel based on disparagement of beliefs are not very rigorous." *Abraham's Seed*, 1 U.S.P.Q.2d (BNA) at 1232-33.

<sup>247</sup> See, e.g., *Valley Forge Christian College v. Americans United for Separation of Church and State*, 454 U.S. 464, 475 (1982) ("We need not mince words when we say that the concept of 'Art. III standing' has not been defined with complete consistency . . ."); *Association of Data Processing Serv. Orgs. v. Camp*, 397 U.S. 150, 151 (1970) ("Generalizations about standing to sue are generally worthless as such."); *Control Data Corp. v. Baldrige*, 655 F.2d 283, 289 (D.C. Cir.) (noting that Supreme Court's constantly evolving test for determining standing "makes application difficult and careful evaluation difficult without some refinement"), *cert. denied*, 454 U.S. 881 (1981); *Scanwell Lab. v. Shaffer*, 424 F.2d 859, 861 (D.C. Cir. 1970) ("The law of standing as developed by the Supreme Court has become an area of incredible complexity.").

<sup>248</sup> For varying formulations of this requirement, see, e.g., *Valley Forge*, 454 U.S. at 472 (requiring "actual factual setting in which the litigant asserts a claim of injury of fact"); *Village of Arlington Heights v. Metropolitan Hous. Dev. Corp.*, 429 U.S. 252, 261 (1977) ("[P]laintiff must show that he himself is injured . . ."); *Schlesinger v. Reservists Comm. to Stop the War*, 418 U.S. 208, 221 (1974) ("[T]he complaining party [must] have suffered a particular injury caused by the action challenged as unlawful."); *Data Processing*, 397 U.S. at 152 (requiring plaintiff to allege "that the challenged action has caused him injury in fact, economic or otherwise").

guarantee in question.”<sup>249</sup> Finally, the grievant must establish a causal relationship between the challenged action and the alleged injury.<sup>250</sup>

Completely ignoring this framework, the *Bromberg* Board found standing merely on two allegations by the opposers, namely that: (1) the sexually disparaging nature of the mark involved brought women “into contempt and disrepute”; and (2) the mark’s registration would lower the standards of the Patent and Trademark Office.<sup>251</sup> Even assuming the correctness of the Board’s conclusion that these allegations did, in fact, bring the opposers within the zone of interests protected by Sections 2(a) and 13,<sup>252</sup> however, each of these grounds fails to satisfy the remaining Article III requirements—the first because the injury alleged is nonredressable and the second because it is not a legally cognizable injury.

### 1. *Moral Offense as Redressable Injury Under Article III and Section 2(a)*

As a general rule, a would-be plaintiff’s generalized moral objections to the government’s conduct are insufficient to create standing. In *Allen v. Wright*,<sup>253</sup> for example, the plaintiffs were parents of black children who alleged that the Internal Revenue Service had failed to deny tax-exempt status to racially discriminatory private schools. The Supreme Court, however, held that the plaintiffs’ claim that the regulations subjected them to a stigmatic injury as a class failed to establish their standing. Rather, the Court held, standing could exist only if the plaintiffs had themselves been personally subject to racially

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<sup>249</sup> *Data Processing*, 397 U.S. at 153.

<sup>250</sup> See, e.g., *Duke Power Co. v. Carolina Envtl. Study Group, Inc.*, 438 U.S. 59, 74 (1978) (“The more difficult step in the standing inquiry is establishing that these injuries ‘fairly can be traced to the challenged action of the defendant . . . .’”) (citation omitted); *Simon v. Eastern Ky. Welfare Rights Org.*, 426 U.S. 26, 45 (1976) (requiring plaintiff to show that the requested relief would “remove the harm”); *Warth v. Seldin*, 422 U.S. 490, 504 (1975) (requiring “substantial probability” that the challenged action caused the injury complained of); *Linda R.S. v. Richard D.*, 410 U.S. 614, 618 (1973) (declining to recognize plaintiff’s standing on the ground that the requested relief’s relationship to the alleged injury “can, at best, be termed only speculative”).

<sup>251</sup> *Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. (BNA) 176, 177 (T.T.A.B. 1978).

<sup>252</sup> For a discussion of whether the *Bromberg* opposers did, in fact, fall within the zone of protection afforded by the interaction of Sections 2(a) and 13, see generally Kerry L. Kester, Note, *Standing to Oppose Scandalous or Immoral Trademarks*, 58 NEB. L. REV. 249 (1978).

<sup>253</sup> 468 U.S. 737 (1984).



discriminatory conduct. In the absence of such conduct, "[r]ecognition of standing . . . would transform the federal courts into 'no more than a vehicle for the vindication of the value interests of concerned bystanders.'"<sup>254</sup>

The Court since has extended *Allen* to the limits of its logic.<sup>255</sup> In *Lujan v. Defenders of Wildlife*,<sup>256</sup> the Court denied standing to plaintiffs seeking to enforce a provision of the Endangered Species Act of 1973 requiring consultation among federal agencies for the purpose of protecting endangered species.<sup>257</sup> In doing so, the Court found significant the fact that the plaintiffs themselves were not the subject of the relevant government action (or, more accurately, *inaction*). Under these circumstances, the Court held, whatever injury the plaintiffs had suffered through the destruction of endangered species was the result of actions of third parties and not those of the government.<sup>258</sup> Consequently, the plaintiffs faced a strict standard under *Allen*: "[W]hen the plaintiff is not himself the object of the government action or inaction he challenges, standing is not precluded, but is ordinarily 'substantially more difficult' to establish."<sup>259</sup>

Although the *Lujan* Court's application of *Allen* arguably might doom claims such as those brought by the *Bromberg* opposers, it did not expressly

<sup>254</sup> *Id.* at 756 (quoting *United States v. SCRAP*, 412 U.S. 669, 687 (1973)).

<sup>255</sup> See BENJAMIN N. CARDOZO, *THE NATURE OF THE JUDICIAL PROCESS* 51 (1921).

<sup>256</sup> 112 S. Ct. 2130 (1992).

<sup>257</sup> See 16 U.S.C. § 1536(a)(2) (1988). The suit had its origins in the Department of the Interior's 1986 reinterpretation of the law that it did not apply to agency actions taken in foreign countries. See 51 Fed. Reg. 19,226 (1986) (codified at 50 C.F.R. § 402.01-.02 (1991)).

<sup>258</sup> See *Lujan*, 112 S. Ct. at 2136-40. The plaintiffs alleged, *inter alia*, that the government's failure to comply with the statute had resulted in the provision of funds to foreign governments for use in ecologically damaging projects. *Id.* at 2137-38.

<sup>259</sup> *Id.* at 2137 (quoting *Allen v. Wright*, 468 U.S. 737, 758 (1984)). As the *Lujan* Court explained:

When the suit is one challenging the legality of government action or inaction, the nature and extent of facts that must be averred (at the summary judgment stage) or proved (at the trial stage) in order to establish standing depends considerably upon whether the plaintiff is himself an object of the action (or foregone action) at issue. If he is, there is ordinarily little question that the action or inaction has caused him injury, and that a judgment preventing or requiring the action will redress it. When, however, as in this case, [the] injury arises from the government's allegedly unlawful regulation (or lack of regulation) of *someone else*, much more is needed.

*Id.*

overrule a separate line of cases holding that "[t]he actual or threatened injury required by Art. III may exist solely by virtue of 'statutes creating legal rights, the invasion of which creates standing.'"<sup>260</sup> Thus, in *United States Parole Commission v. Geraghty*,<sup>261</sup> the Court held that the Federal Rules of Civil Procedure granted standing to a former federal prisoner challenging the federal Parole Release Guidelines although the plaintiff himself was no longer incarcerated.<sup>262</sup> Closer to the point, in *Havens Realty Corp. v. Coleman*,<sup>263</sup> the Court held the Fair Housing Act of 1968 to create a statutory right not to be misled about the availability of housing and, accordingly, granted standing to a black professional "tester" who had been subjected to just such treatment.<sup>264</sup> Consequently, although a claim to offense otherwise might not suffice, Section 13's grant of standing to potentially "damaged" individuals could encompass psychological injuries such as disparagement. To the extent that these cases survive *Lujan*, the *Bromberg* Board correctly held that the opposers could, at least in theory, claim an injury based on their alleged disparagement.<sup>265</sup>

Nevertheless, *Bromberg*'s fundamental flaw lies in the Board's failure even to address, much less resolve, the issue of whether the opposers' injury could be redressed by the relief sought. Critically, the opposers alleged only that the "obvious double entendre" of the mark brought women into "contempt and disrepute."<sup>266</sup> Notably absent, however, was any allegation that the mark's registration would in any way exacerbate this damage—a demonstration

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<sup>260</sup> *Havens Realty Corp. v. Coleman*, 455 U.S. 363, 373 (1982) (citations omitted).

Note that this point has been accepted even by critics of an expansive standing doctrine. See, e.g., *Lujan*, 112 S. Ct. at 2146-47 (Kennedy, J., concurring) ("Congress has the power to define injuries and articulate chains of causation that will give rise to a case or controversy where none existed before . . ."); Antonin Scalia, *The Doctrine of Standing as an Essential Element of the Separation of Powers*, 17 SUFFOLK U. L. REV. 881, 885 (1983) ("Standing requires . . . the allegation of some particularized injury to the individual plaintiff. But legal injury is by definition no more than the violation of a legal right; and legal rights can be created by the legislature.").

<sup>261</sup> 445 U.S. 388 (1980).

<sup>262</sup> *Id.* at 390-94, 404.

<sup>263</sup> 455 U.S. 363 (1982).

<sup>264</sup> *Id.* at 371.

<sup>265</sup> *Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. (BNA) 176, 179 (T.T.A.B. 1978); cf. *Meese v. Keene*, 481 U.S. 465 (1987) (recognizing, for state senator alleging potential injury to political reputation, standing to challenge provision of Foreign Agents' Registration Act); *Joint Anti-Fascist Refugee Comm'n v. McGrath*, 341 U.S. 123 (1951) (holding sufficient for standing purposes allegations of harm to organization's reputation resulting from listing on official register of subversive organizations).

<sup>266</sup> *Bromberg*, 198 U.S.P.Q. (BNA) at 177.

mandated by Section 13. The opposers did not, for instance, claim that affixation of the ® symbol<sup>267</sup> would render the mark any more “lewd, lascivious, indecent, obscene, worthless, depraved, chauvinistic, degrading [and lacking] commercial value”<sup>268</sup> than it would be in association with an SM symbol or in the absence of any other notice of usage as a mark.<sup>269</sup> By way of further example, the record was similarly devoid of suggestions that the would-be registrant’s ability to enjoy the constructive notice<sup>270</sup> or incontestability<sup>271</sup> benefits of registration would subject women to disparagement beyond that triggered by the offending material’s use as a service mark.

These critical omissions distinguish the *Bromberg* opposers from potential opposers under other subsections of Section 2 and place them within the class of plaintiffs disapproved of by *Lujan*. For example, as between unregistered users of two confusingly similar marks, the plaintiff bears the burden of

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<sup>267</sup> Under 15 U.S.C. § 1111 (1988), a federal registrant may give notice of that registration by displaying the mark with the ® symbol or, alternatively, with the words “Registered in the U.S. Patent and Trademark Office” or “Reg. U.S. Pat. & Tm. Off.” Failure to affix such notices by a registrant will prevent her from recovering profits and damages in an infringement suit under the Act unless the defendant had actual notice of the mark’s registered status. *Id.* A mark owner’s improper use of these notices prior to issuance of a registration can defeat her right to registration if such misuse was occasioned by an intent to deceive the purchasing public or others into believing the mark was registered. *See generally* Wells Fargo & Co. v. Lundeen & Assocs., 20 U.S.P.Q.2d (BNA) 1156 (T.T.A.B. 1991); *see also* Fox-Stanley Photo Prods., Inc. v. Otaguro, 339 F. Supp. 1293 (D. Mass. 1972) (misuse of notice held to constitute unclean hands barring relief).

<sup>268</sup> *See Bromberg*, 198 U.S.P.Q. (BNA) at 177.

<sup>269</sup> If a mark is not registered, its owner may still use the designations TM (for a trademark) or SM (for a service mark) as informal quasi-legalistic notices that the word or design in question is, in fact, being used as a mark. Alternatively, he also may follow references to the mark with the word “Brand.” Thus, although the applicant in *Bromberg* ultimately was denied registration of its mark, *see supra* note 159, this rejection would in no way prevent it from advertising the goods sold in its store as “A BREAST IN THE MOUTH IS WORTH A LEG IN THE HAND Brand Chicken.” *See* 2 MCCARTHY, *supra* note 16, § 19:55, at 19-251.

<sup>270</sup> Section 7(c) of the Act provides for constructive notice of a registered mark, provided that the senior user’s application to register was filed prior to the junior user’s good faith adoption of the mark. 15 U.S.C. § 1057(c) (1988).

<sup>271</sup> Pursuant to Section 15 of the Act, a registrant’s right to exclusive use of its mark can become “incontestable” after five years of registration. *See id.* § 1065.

demonstrating superior rights to her mark in an infringement suit.<sup>272</sup> Under Section 33(a),<sup>273</sup> however, a federal registrant may rely on the registration as "prima facie evidence" not only of the mark's validity and her ownership of it, but also of her exclusive right to use the mark on the goods or services covered by the registration.<sup>274</sup> Similarly, if a registration has become incontestable, it constitutes "conclusive evidence" of the mark's validity, the registrant's ownership of it, and her exclusive right to its use.<sup>275</sup> In either case, registration shifts the burden of proof on these issues from the plaintiff to the defendant, who must introduce sufficient evidence to rebut these presumptions.<sup>276</sup>

A potential defendant in an infringement suit who opposes the potential plaintiff's application to register her mark on Section 2(d) grounds therefore faces the real and genuine possibility of suffering damage from the registration itself, rather than the plaintiff's mere use of the mark *as* a mark. Because the registration allows its owner to exclude all others from the mark's use,<sup>277</sup> the

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<sup>272</sup> See, e.g., *National Conference of Bar Examiners v. Multistate Legal Studies, Inc.*, 692 F.2d 478, 488 (7th Cir. 1982), *cert. denied sub nom. Multistate Legal Studies, Inc. v. Ladd*, 464 U.S. 814 (1983).

<sup>273</sup> 15 U.S.C. § 1115(a) (1988).

<sup>274</sup> See generally *American Heritage Life Ins. Co. v. Heritage Life Ins. Co.*, 494 F.2d 3 (5th Cir. 1974):

Under [Section 33(a)], registration is prima facie evidence of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in commerce in connection with the [goods or] services specified in the registration certificate. Thus registration is sufficient to establish prima facie (1) the required prior use (2) of a registrable mark (3) which is likely to be confused with another's use of the same or similar mark.

*Id.* at 10 (citation omitted). See also *Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 819-20 (1st Cir. 1987); *United States Jaycees v. Philadelphia Jaycees*, 639 F.2d 134, 143 (3d Cir. 1981).

<sup>275</sup> See 15 U.S.C. § 1115(b) (1988).

<sup>276</sup> See, e.g., *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 373 (1st Cir. 1980); *American Heritage Life Ins. Co. v. Heritage Life Ins. Co.*, 494 F.2d 3, 10 (5th Cir. 1974); *Coit Drapery Cleaners, Inc. v. Coit Drapery Cleaners, Inc.*, 423 F. Supp. 975, 978 (E.D.N.Y. 1976); see also *Wynn Oil Co. v. Thomas*, 839 F.2d 1183, 1190 (1st Cir. 1988). This shift in the burden of proof does not extend to the ultimate issue of whether the defendant's use of its mark is likely to create confusion. *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 746 F.2d 375, 379 (7th Cir. 1984).

<sup>277</sup> See, e.g., *James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 273 n.15 (7th Cir. 1976) ("'Exclusive right to use' means the right to exclude others from using the registered mark . . .") (citation omitted).

subject of the Act's registration provisions is just as much the right of the potential defendant and would-be opposer to its mark as it is the registrant's. As a result, a successful opposition brought under Section 2(d) by a prior user of a confusingly similar mark directly redresses the threatened injury—the specter of unfavorable presumptions at trial.<sup>278</sup> Such a direct linkage, however, was conspicuously absent from the allegations of standing in *Bromberg* and, more importantly, from the Board's consideration of them.

By neglecting to require this connection, the Board uncharacteristically failed to distinguish between use of words or designs as marks, on the one hand, and their federal registration as such, on the other. To the extent that the words ONLY A BREAST IN THE MOUTH IS BETTER THAN A LEG IN THE HAND, are, in fact, scandalous, immoral, or disparaging, these qualities result from the nature of the phrase itself and not its use as a mark,<sup>279</sup> much less its federal registration.<sup>280</sup> Indeed, as a service mark for a restaurant

<sup>278</sup> See, e.g., *Massey Junior College, Inc. v. Fashion Inst. of Technology*, 492 F.2d 1399, 1403 n.4 (C.C.P.A. 1974) ("If an opposer sustains his burden of proof regarding the ground of 'likelihood of confusion,' there is an irrebuttable presumption of likelihood of legal confusion to him."); see also *Daggett & Ramsdell, Inc. v. Proctor & Gamble Co.*, 275 F.2d 955, 958-59 (C.C.P.A. 1960).

<sup>279</sup> At least one Board member has questioned whether an offensive phrase can ever become more offensive merely through its use as an identifier of origin for goods or services. See *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470, 1472 (T.T.A.B. 1988) (Cissel, Member, concurring) ("To suggest that a significant number of potential purchasers of applicant's [goods] would be offended by applicant's trademark for them is as unfounded as would be the suggestion that a significant portion of the readers of this opinion have been offended by the manner in which the writer is identified above.").

<sup>280</sup> Indeed, even in *McGinley*, a case upholding a refusal to register under Section 2(a), the court expressly rejected the theory that the act of registration could, in and of itself, create scandal:

The issue is not whether the act of registration would create a scandal insofar as the relationship between the PTO and the public is concerned, but whether the mark comprises scandalous matter based on the ordinary and common meaning of "scandalous." Whether the PTO would be considered to have placed its imprimatur on the mark (the subject of opposing arguments) is not relevant.

*In re McGinley*, 660 F.2d 481, 487 n.13 (C.C.P.A. 1981); see also *In re Old Glory Condom Corp.*, Serial No. 74/004,391, 1993 TTAB LEXIS 3 (T.T.A.B. March 3, 1993):

In this case, as in others where the issue has been whether a mark is scandalous, we have detected an undercurrent of concern that the issuance of a trademark registration for [the] applicant's mark amounts to the awarding of the U.S. Government's

serving fried chicken, the phrase arguably is *less* offensive and disparaging than it otherwise would be.<sup>281</sup>

For this reason, one need not question the sincerity of the *Bromberg* opposers' claims of offense to doubt that denying registration would deter the applicant from wreaking further damage on women by continuing to place its mark before the general public.<sup>282</sup> Applicants denied registration of their marks under Section 2(a) remain free to use them in the marketplace,<sup>283</sup> and in fact

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"imprimatur" to the mark. Such a notion is, of course, erroneous. The duty of this Office under the Trademark Act in reviewing applications for registration is nothing more and nothing less than to register those marks that are functioning to identify and distinguish goods and services in the marketplace, as long as those marks do not run afoul of any statutory provision that would prohibit registration. . . . Just as the issuance of a trademark registration by this Office does not amount to a government endorsement of the quality of the goods to which the mark is applied, the act of registration is not a government imprimatur or pronouncement that the mark is a "good" one in an aesthetic, or any analogous, sense.

*Old Glory*, Serial No. 74/004,391, 1993 TTAB LEXIS 3, at \*15 n.3; cf. *In re National Distillers and Chem. Corp.*, 297 F.2d 941 (C.C.P.A. 1962):

The purchasing public knows no more about trademark *registrations* than a man walking down the street in a strange city knows about legal title to the land and buildings he passes. There may be an occasional sign giving notice of ownership, just as an occasional trademark owner will call attention to the fact that he owns it, but it is the exception. What the public knows is the wares and the marks they bear and, perhaps subconsciously, its relationship to them. It is not concerned with legal titles to and registrations of marks.

*National Distillers*, 297 F.2d at 949 (Rich, J., concurring).

<sup>281</sup> Note, however, this Article's criticism of this methodology at *supra* notes 206-43 and accompanying text.

<sup>282</sup> See *National Distillers*, 297 F.2d at 948 (Rich, J., concurring):

The *refusal* of registration . . . does *not* serve to protect the public . . . because refusal to register has almost no effect on trademark use, which use always precedes [the] application to register, continues during the prosecution of the application, and usually goes on after registration is finally refused, unless something other than that refusal intervenes to stop such use . . . .

*Id.*

<sup>283</sup> See, e.g., *McGinley*, 660 F.2d at 484 ("[T]he PTO's refusal to register [an applicant's] mark does not affect his right to use it. No conduct is prescribed, and no tangible form of expression is suppressed.") (citation omitted); *Hershey*, 6 U.S.P.Q.2d (BNA) at 1472 (Cissel, Member, concurring) ("[T]his is not a constitutional issue involving

may still enforce their rights against infringing parties under federal and state law.<sup>284</sup> Consequently, as with the relief sought in *Lujan*, the application's rejection on Section 2(a) grounds would in no way directly redress the opposers' claimed injury; rather, relief would depend on the applicant's actions following rejection. Thus, the *Bromberg* Board properly should have rejected the opposers' claims of standing grounded solely on allegations of moral offense.

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the right to free speech. Applicant has used and might well continue to use this mark whether or not we find it is entitled to registration under the Lanham Act."); *In re Tinseltown*, 212 U.S.P.Q. (BNA) 863, 865-66 (T.T.A.B. 1981) (applicant's right to use mark unrelated to refusal to register); *see also* *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 372 (1st Cir. 1980) ("[R]egistration does not create the underlying right in a trademark. That right, which accrues from the use of a particular name or symbol, is essentially a common-law property right and cancellation cannot extinguish a right that federal registration did not confer.") (citation omitted); *cf. Sambo's Restaurants, Inc. v. City of Ann Arbor*, 663 F.2d 686 (6th Cir. 1981) (holding unconstitutional city's attempt to bar use of allegedly racially offensive mark).

<sup>284</sup> Although a refusal to register would prevent the owner of a mark from relying on the evidentiary presumptions afforded to federal registrants, *see supra* notes 272-78 and accompanying text, he still could bring an infringement action under Section 43(a) of the Act, 15 U.S.C. § 1125(a) (1988), or under state law. *See Boston Professional Hockey Ass'n, Inc. v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1010 (5th Cir.), *cert. denied*, 423 U.S. 868 (1975); *see also Keebler*, 624 F.2d at 372 n.3 ("The Lanham Act does not preempt the states' ability to recognize and protect trademark rights."). *But see De Nobili v. Scanda*, 198 F. 341, 346 (W.D. Pa. 1912) (declining to enjoin infringement of plaintiff's mark under common law on ground that "[i]f it could not be registered as a trademark . . . we see no reason why it should be protected as a label"). For a description of options available to an applicant whose mark has been denied registration but who still wishes to give notice to potential infringers of his claim of rights to the mark, *see supra* note 269.

In this connection, the original Restatement of Torts defined "trademark" as "any mark, word, letter, number, design, picture or combination thereof in any form of arrangement, which . . . is adopted and used by a person to denominate goods which he markets, and . . . the use of which . . . is prohibited neither by legislative enactment nor by an otherwise defined public policy." RESTATEMENT (FIRST) OF TORTS § 715 (1938). Such a definition lends itself to the argument that courts should decline to enforce rights to marks consisting of scandalous, immoral, or disparaging matter on the ground that to do so would be contrary to public policy. Rather than merely striking at a mark's federal registration, this approach would discourage the very use of the offending material as a mark. No court has adopted such a position, however, and in fact the American Law Institute since has abandoned this limitation on what may constitute a protectable mark. *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 (Tent. Draft No. 3, March 23, 1990).

## 2. "Lowering of Governmental Standards" as Cognizable Injury Under Article III and Section 2(a)

If the Board failed to dispose of the *Bromberg* opposers' first claimed basis for standing, so too did it also fail to dismiss the second, namely the allegation that registration of the mark in question would have "unnecessarily lower[ed] the standards of the United States Government."<sup>285</sup> For, in contrast to the theory apparently adopted by the *Bromberg* Board, the mere claim that the government has acted inconsistently with a particular standard is insufficient to create standing in the absence of express statutory authorization to the contrary. Thus, in *Allen*,<sup>286</sup> the Court rejected the argument that the government's failure to comply with a statutory mandate could, in and of itself, constitute a legally cognizable injury under Article III. Rather, the Court noted, "[t]his Court has repeatedly held that an asserted right to have the Government act in accordance with law is not sufficient, standing alone, to confer jurisdiction on a federal court."<sup>287</sup>

Indeed, assuming the absence of a constitutional tort,<sup>288</sup> the Court has declined to recognize standing even in cases in which the challenged action is alleged to violate a *constitutional* standard. In *Schlesinger v. Reservists Committee to Stop the War*,<sup>289</sup> for example, the Court declined to allow the plaintiffs to proceed in an action under the Constitution's Incompatibility Clause<sup>290</sup> seeking to prevent members of Congress from serving in the armed forces.<sup>291</sup> Likewise, the Court also has denied standing to plaintiffs alleging that the federal government's transfer of property, without payment, to a religious organization violated the Establishment Clause.<sup>292</sup> Simply put, "assertion of a right to a particular kind of Government conduct, which the

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<sup>285</sup> See *Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. (BNA) 176, 177 (T.T.A.B. 1978).

<sup>286</sup> *Allen v. Wright*, 468 U.S. 737 (1984).

<sup>287</sup> *Id.* at 754; accord *Whitmore v. Arkansas*, 495 U.S. 149, 158-61 (1990).

<sup>288</sup> See, e.g., *Davis v. Passman*, 442 U.S. 228 (1979) (recognizing private cause of action against violation of Fifth Amendment); *Bivens v. Six Unknown Named Agents of Fed. Bureau of Narcotics*, 403 U.S. 388 (1971) (recognizing private cause of action against violation of Fourth Amendment).

<sup>289</sup> 418 U.S. 208 (1974).

<sup>290</sup> U.S. CONST. art. I, § 6, cl. 2.

<sup>291</sup> *Schlesinger*, 418 U.S. at 214-16.

<sup>292</sup> See *Valley Forge Christian College v. Americans United for Separation of Church and State*, 454 U.S. 464, 488-90 (1982).



Government has violated by acting differently, cannot alone satisfy the requirements of Art. III without draining those requirements of meaning.”<sup>293</sup>

This is not to say, however, that Article III entirely forecloses actions such as that in *Bromberg*. For example, in enacting other statutes, Congress routinely authorizes “any person” to bring actions against governmental officials for failing to perform nondiscretionary duties<sup>294</sup> or to enjoin violations by other citizens.<sup>295</sup> To the extent that these provisions can survive Article III scrutiny,<sup>296</sup> they confer “automatic standing on any person claiming [their] violation.”<sup>297</sup> Through such language, “citizens are recruited to serve as private attorneys-general to facilitate enforcement of [legislation] in the face of official inaction,”<sup>298</sup> and it certainly would be within congressional power to provide for such a rule under the Lanham Act.<sup>299</sup>

<sup>293</sup> *Allen v. Wright*, 468 U.S. 737, 754 (1984); *see also Fairchild v. Hughes*, 258 U.S. 126, 129–30 (1922) (“Plaintiff has [asserted] only the right, possessed by every citizen, to require that the Government be administered according to law and that the public moneys be not wasted. Obviously this general right does not entitle a private citizen to institute in the federal courts a suit . . .”).

<sup>294</sup> *See, e.g.*, 42 U.S.C. § 7604(a) (1988) (permitting “any person” to commence an action against the EPA Administrator for failure to perform any nondiscretionary duty).

<sup>295</sup> *See, e.g., id.* § 4911 (providing for suits by “any person” under the Noise Control Act); 33 U.S.C. § 1415(g) (1988) (providing for suits by “any person” under the Marine Protection, Research and Sanctuaries Act).

<sup>296</sup> *See Lujan v. Defenders of Wildlife*, 112 S. Ct. 2130, 2142–46 (1992) (invalidating “any person” language of 16 U.S.C. § 1536(a)(2) (1988)).

<sup>297</sup> *National Wildlife Fed’n v. Coleman*, 400 F. Supp. 705, 710 (S.D. Miss. 1975) (interpreting “any person” language of 16 U.S.C. § 1540(g) (1988)), *rev’d on other grounds*, 529 F.2d 359 (5th Cir.), *cert. denied*, 429 U.S. 979 (1976).

<sup>298</sup> *Metropolitan Washington Coalition for Clean Air v. District of Columbia*, 511 F.2d 809, 814 & n.26 (D.C. Cir. 1975) (interpreting “any person” language of 42 U.S.C. § 1815h-2(a) (1988)).

<sup>299</sup> As amended to encompass such a standard, for example, Section 13(a) of the Lanham Act might read in part as follows (proposed additions are emphasized):

Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of this [Act] of the mark sought to be registered; *provided, however, that any person who believes that registration of a mark would be inconsistent with the provisions of sections 2(a)–(c) of this Act may file such an opposition in the absence of a showing that he would be damaged by registration of the mark.*

It bears repeating, however, that in passing the Act, Congress adopted a far more restrictive standard limiting standing to those individuals able to claim damage resulting from a mark's registration.<sup>300</sup> To the extent that the *Bromberg* Board held sufficient for standing purposes the opposers' claims that registration of the mark in question would lower government standards, this holding was therefore in error. Had the Board adequately examined the issue within Article III's well-established framework, it would have realized that litigants suffer no legally cognizable injury when they merely complain about government irregularity,<sup>301</sup> particularly if they themselves are not the subject of the challenged action.<sup>302</sup> Claims that the PTO has failed to live up to Section 2's mandates simply fail to create standing in the absence of an otherwise plausible claim of damage resulting from registration of a particular mark.<sup>303</sup> Therefore, just as the *Bromberg* opposers' claims of disparagement failed to satisfy Article III's mandates for redressability reasons, so too should the Board also have dismissed their "lowering of governmental standards" theory for failure to allege a cognizable injury.<sup>304</sup>

### 3. *Standing to Challenge Registration of Scandalous, Immoral, and Disparaging Marks: A Final Note*

Declining to recognize the plaintiff's standing in *United States v. Richardson*,<sup>305</sup> Chief Justice Burger acknowledged that "if respondent is not

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14 U.S.C. § 1063(a) (1988). Similar language, of course, might be added to Section 14 to allow for petitions to cancel existing registrations.

<sup>300</sup> See *Montclair v. Ramsdell*, 107 U.S. 147, 152 (1883) ("It is the duty of the court to give effect, if possible, to every clause and word of a statute . . ."); *In re Nantucket, Inc.*, 677 F.2d 95, 98 (C.C.P.A. 1982) ("[A] legislature is presumed to have used no superfluous words."); accord *United States v. Menasche*, 348 U.S. 528, 538-39 (1955); *Platt v. Union Pacific R.R. Co.*, 99 U.S. 48, 58 (1878).

<sup>301</sup> Gene R. Nichol, Jr., *Rethinking Standing*, 72 CAL. L. REV. 68, 76 (1984).

<sup>302</sup> *Lujan v. Defenders of Wildlife*, 112 S. Ct. 2130, 2137 (1992).

<sup>303</sup> See *McKesson & Robbins, Inc. v. Isenberg*, 167 F.2d 510, 512 (C.C.P.A. 1948).

<sup>304</sup> As pointed out at *supra* notes 166-70 and accompanying text, recent changes in congressional funding of the PTO's operations have created a situation in which the PTO's opposition to, rather than approval of, the registration of a particular mark is more likely to result in the expenditure of federal funds. If, in light of these changes, a mark's registration is viewed as agency inaction rather than agency action, then the burden on a would-be opposer or petitioner under Section 2(a), who otherwise would be unaffected by the PTO's decision, may be even greater. See *Heckler v. Chaney*, 470 U.S. 821, 832 (1985) (holding agency inaction, unlike agency action, presumed immune from judicial review).

<sup>305</sup> 418 U.S. 166 (1974).

permitted to litigate this issue, no one can do so.”<sup>306</sup> A correct application of Article III’s mandates, of course, need not necessarily reach this extreme result, as potential opposers or petitioners for cancellation could still challenge registration of particular marks under Section 2(a) after establishing their standing under other sections of the Act. Thus, for example, the arguments advanced above would not foreclose the result in *Greyhound*, in which the opposer also alleged a likelihood of confusion between its and the applicant’s marks under Section 2(d).<sup>307</sup>

Nevertheless, a proper application of standing doctrine to the Act as currently formulated<sup>308</sup> would limit greatly the ability of individuals lacking alternative statutory grounds to contest a registration merely by alleging that the mark itself is scandalous, immoral, or disparaging. Allowing such plaintiffs confuses the relationship between constitutional and statutory standing requirements by allowing a determination on the merits that a mark is unregistrable to subsume entirely the separate constitutional issue of whether the challenging party would suffer a cognizable and redressable injury upon its registration. However distasteful the results may be in cases in which an offensive mark receives administrative approval for registration, the last guardians of the purity of the Register under the current reading of the Act properly are the Examining Attorneys charged with enforcement of its prohibitions.<sup>309</sup>

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<sup>306</sup> *Id.* at 179.

<sup>307</sup> See *supra* notes 152–53 and accompanying text.

<sup>308</sup> See *supra* notes 295–99 and accompanying text.

<sup>309</sup> This approach is consistent with the historical treatment of parties lacking an interest in a mark’s registration who nevertheless seek to oppose it under provisions of the Act other than Section 2(a). As the Court of Customs and Patent Appeals has noted in dismissing a challenge to the registration of an allegedly descriptive mark under Section 2(e)’s predecessor brought by a company not engaged in the sale of goods identical or similar to those of the applicant:

[I]n the ex parte consideration of the right of an applicant to register his mark, it is the Commissioner of Patents and not the opposer who represents the public and his decision is final so far as the opposer is concerned. Therefore, appellant here cannot invoke error on the part of the tribunals of the Patent Office in its not ruling that the interest of the public at large requires rejection of the application for registration based on descriptiveness.

McKesson & Robbins, Inc. v. Isenberg, 167 F.2d 510, 512 (C.C.P.A. 1948).

Note that this approach also is consistent with the *Lujan* Court’s view of the separation of powers. See *Lujan v. Defenders of Wildlife*, 112 S. Ct. 2130, 2142–43 (1992) (holding

Of equal importance, to conclude that the public does not have general standing to challenge registration of scandalous, immoral, or disparaging marks—at least under the theories recognized by the *Bromberg* Board—does not necessarily render the general morality wholly lacking in weapons. Indeed, it is the public as a whole, rather than would-be opposers or petitioners to cancel, that enjoys the most effective safeguard of all against use of scandalous, immoral, or disparaging material as marks, namely its buying power. Instead of striking at a particular mark's registration, an action unlikely to hinder significantly the mark's appearance in the marketplace,<sup>310</sup> a lack of consumer interest will inevitably bring about its abandonment as a whole, a goal that likely was the *Bromberg* opposers' true aim.<sup>311</sup> Left to the market, investment in marks that are genuinely offensive to a "substantial composite of the general public" likely will generate insufficient returns to warrant their continued use.<sup>312</sup> Thus, for example, the arguably scandalous COCA-COLA trademark

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vindication of the public interest to be the function of the Congress and the Chief Executive and that to allow that interest to be converted into an individual right by a statute would transfer from the President to the courts the Chief Executive's constitutional duty to take care that the laws be faithfully executed).

<sup>310</sup> See *supra* notes 269, 282.

<sup>311</sup> To the extent that it has addressed the issue, the full Board has resisted applicants' efforts to equate popularity of marks with registrability under Section 2(a). See, e.g., *In re Tinseltown*, 212 U.S.P.Q. (BNA) 863, 865 (T.T.A.B. 1981) ("[T]he fact . . . that the public can judge the mark's propriety in the marketplace [is] wholly irrelevant to the issue before us."). This view, however, is not universally held. Rather, as one Board member has observed of the relationship between public acceptance of the BIG PECKER BRAND mark and its allegedly scandalous nature:

Applicant apparently enjoys a reasonable business in selling its goods under this mark. If the double entendre were in fact objectionable, why is it that business has developed to the point where the mark is worth the effort and expense of protecting it with registration? If it were actually so offensive, people simply would not purchase products bearing it.

*In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470, 1473 (T.T.A.B. 1988) (Cissel, Member, concurring); see also *In re Riverbank Canning Co.*, 95 F.2d 327, 330 (C.C.P.A. 1938) (Jackson, J., dissenting) ("If the use of the trademark "Madonna," as applied to the goods and articles mentioned, gave offense or scandal, it seems to me it would be noised about and probably these articles would have but scanty sale.").

<sup>312</sup> See *Sambo's of Ohio, Inc. v. City Council*, 466 F. Supp. 177 (N.D. Ohio 1979):

One of the basic premises of advertising is that if it is too offensive to too many people, its use will be counterproductive, for those who are offended will not only refuse to buy

for a beverage once rumored to have contained cocaine has survived, but the grotesque racial caricatures popular at the turn of the century have not.<sup>313</sup> To the extent that the public demands protection from exposure to offensive words, phrases, or designs as marks, therefore, such a shield is available with or without the intervention of the courts and PTO.<sup>314</sup>

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the product, but also, if they are sufficiently offended, they will attempt to persuade others to refuse also.

*Id.* at 180. Note that the subsequent history of the SAMBO'S mark itself ultimately validated this observation. Notwithstanding the success of the Sambo's restaurant chain in combatting the efforts of various localities to ban the mark's use altogether in the 1970s, *see supra* notes 192-95 and accompanying text, it eventually succumbed to commercial pressure by beginning to rename its stores "No Place Like Sam's" before going into bankruptcy in 1981. *See* Douglas C. McGill, *Colgate to Rename a Toothpaste*, N.Y. TIMES, Jan. 27, 1989, at D1.

<sup>313</sup> *See generally* HAL MORGAN, SYMBOLS OF AMERICA 52-63 (1986). Needless to say, these market forces also apply to marks other than those falling within the scope of Section 2(a). For example, although the Quaker Oats Company has deemphasized the most egregious of the black "mammy" characteristics of its Aunt Jemima trademark, so too has General Mills routinely updated the portrait appearing on its Betty Crocker baking mixes. *See id.* at 55, 126.

<sup>314</sup> This shield, of course, is hardly foolproof, particularly when allegedly disparaging marks are concerned. Thus, for example, although the disparagement felt by Native Americans at the use by professional and collegiate sports teams of such marks as REDSKINS, CHIEFS, INDIANS, and BRAVES is well documented, reliance on public outrage to force abandonment of the marks has been notably unsuccessful. *Compare* Leonard Shapiro, *Offensive Penalty is Called on 'Redskins': Native Americans Protest the Name*, WASH. POST, Nov. 3, 1991, at D1 (documenting Native American protests) *with* Richard Morin, *'America's Team' Has a New Home: Washington*, WASH. POST, Jan. 17, 1992, at G1, G7 (describing survey finding that 89% of respondents supported continued use of "Washington Redskins"). Consequently, relief through market forces from the use of marks disparaging to minorities is far less likely than from their scandalous or immoral counterparts. Note that doubtless because of frustration over this lack of concern in the general population, a coalition of Native American groups has petitioned to cancel registrations of the REDSKINS mark owned by the Washington Redskins. *See* Glenn Sheeley, *Native Americans focus on Redskins*, ATLANTA CONSTITUTION, Sept. 11, 1992, at E2. This (unfortunate) lack of public sensitivity, however, does not warrant reading into Sections 2(a), 13, and 14—not to mention Article III—language that is clearly absent from their texts.

## V. CONCLUSION

Although it may be true generally, as Justice Harlan once observed, that "one man's vulgarity is another's lyric,"<sup>315</sup> this rule carries reduced weight in evaluations of registrability under Section 2(a) of the Lanham Act. Indeed, as *In re Runsdorf* demonstrates, a finding that a mark is comprised of vulgar matter likely will prove fatal to its owner's chances ever of enjoying the benefits afforded to federal registrants.<sup>316</sup>

Whether a mark is in fact "vulgar" or, for that matter, "scandalous," "immoral," "disparaging," "profane," "offensive," "lacking in taste," or "shocking to the sense of propriety" is, of course, an inherently subjective judgment and one that defies prediction. Thus, for example, it is difficult to draw principled distinctions between the design mark reproduced below on the left, which was denied registration on Section 2(a) grounds,<sup>317</sup> and that on the right, whose registration the PTO duly approved<sup>318</sup>:



For this reason, this Article's purpose has not been to comment on the ultimate outcomes of particular cases arising under Section 2(a). Nor has it had as a goal the questioning of congressional wisdom in including purely content-based provisions such as Section 2(a) within the Lanham Act in the first place. The Article has, however, sought to suggest that the PTO, the Board, and the courts alike have allowed the often prurient or humorous subject matter of Section 2(a) disputes to obscure fundamental questions surrounding the proper

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<sup>315</sup> *Cohen v. California*, 403 U.S. 15, 25 (1971).

<sup>316</sup> See *supra* notes 120-21 and accompanying text.

<sup>317</sup> See *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1636 (T.T.A.B. 1988).

<sup>318</sup> See OFFICIAL GAZETTE, *supra* note 136, at TM 68.

interpretation of this provision. In particular, the Article has identified three areas in which the doctrinal framework used to evaluate registrability suffers from critical deficiencies that render it incompatible not only with the express text of Section 2(a), but also with the Constitution itself.

It is, of course, true that the interpretations of the Lanham Act advanced by this Article likely would have the incidental effect of allowing the registration of marks that are otherwise currently ineligible. Indeed, this Article has argued that a refusal to register marks other than those falling into categories of subject matter that the government has a compelling interest in prohibiting altogether is irreconcilable with the First Amendment. Nevertheless, the specter of MADONNA brand wine—whether on the Principal Register or in the nation's supermarkets—does not obviate the reexamination of Section 2(a) necessary to insure that the Constitution and the underlying policies of the Lanham Act, no less than the public morality, remain safe from violation.

