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**N.I.G.G.A., SLUMDOG, DYKE, JAP, AND HEEB:
RECONSIDERING DISPARAGING TRADEMARKS IN A
POST-RACIAL ERA[†]**

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[†] “Post-racial era” is a term that was coined after the 2008 presidential election of the United States of America’s first African-American President, President Barack Obama.

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ABSTRACT

Currently, registration of disparaging trademarks is prohibited under Section 2(a) of the Lanham Act.¹ Recent events, however, should reinvigorate the debate about the protection and registration of disparaging marks: (1) recent decisions published by the Trademark Trial and Appeal Board (TTAB) that continue to address and highlight the issues surrounding the registration of disparaging marks;² (2) a proposed federal act that would not only specifically bar the registration of any trademark that includes the word “redskins,” but would also retroactively cancel any existing registration that consists of or includes that term;³ and (3) an amendment to a state act that would allow public institutions to use disparaging terms (subject to challenge by the community).⁴ In light of these activities, I have written this article, which considers the viability of the federal registration of disparaging marks. I posit that the registration of such marks should be allowed for a variety of reasons. First, it is not in line with the original goals of the U.S. Trademark Act of 1946, also commonly known as the Lanham Act. For example, trademark law seeks to protect consumers—it is the mind of the consumer that we are most concerned about when deciding likelihood of confusion or counterfeit cases.⁵ This goal has been improperly extended to justify the denial of disparaging trademarks. For instance, if consumers have socially accepted and adopted the use of such terms, then trademark owners should be allowed to adopt these terms to promote its goods or services to those consumers. Second, and along the same lines, the country has recently experienced a shift in its social climate. During the past few years we have elected (and re-elected) our first African-American president; we had our first viable female Democratic Presidential nominee, and; the military’s “Don’t Ask Don’t Tell”

¹ 15 U.S.C. § 1052(a) (2012).

² See *In re Prosynthesis Labs., Inc.*, No. 77902555, 2012 WL 1267929, at *2 (T.T.A.B. Mar. 23, 2012), where the applicant, Prosynthesis Laboratories, Inc., sought registration of the mark CHINA FREE and Design (“CHINA FREE”) for use in connection with “vitamin and mineral supplements.” The applicant touted on its website that its products are free of products that originate from China, and expressed concern about the wholesomeness of such products. The examining attorney used this evidence to prove that the mark was disparaging of China and/or people from China, and therefore refused registration of the mark. On appeal to the TTAB, the Board overruled the decision of the examining attorney’s denial of registration of CHINA FREE. The Board gave several reasons for why this mark is registrable, and seemingly opened the door for registration of similar marks that may be deemed disparaging; see also *In re Tam*, No. 85472044, 2013 WL 5498164, at *6 (T.T.A.B. Sept. 26, 2013) reaching a different result because the applicant touted the disparaging nature of the mark.

³ Non-Disparagement of Native American Persons or Peoples in Trademark Registration Act of 2013, H.R. 1278, 113th Cong. (1st Sess. 2013).

⁴ WIS. STAT. § 118.134(1) (2014).

⁵ See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64 (1995).

policy has been repealed. It has been said we now live in a post-racial America: an era that has magically erased racism, and perhaps sexism and homophobia. Let's be clear, however; the dream of living in a "post-racial" United States of America has been a dream deferred.⁶ Still, in the spirit of this post-racial era where race, among other things, should no longer be a "hot-button" issue, registration of disparaging trademarks should be allowed. Finally, the law surrounding disparaging trademarks is unclear, scant, and where applied, has been applied in an inconsistent manner. Clearer guidelines must be set, or this portion of the Trademark Act must be repealed. Without such guidelines, Congress may be compelled to continue to present amendment after amendment for each term it deems to be repugnant.

Part I of this article will explore the history of these types of marks, consider the standards for trademark registration, and explore the purpose behind Section 2(a) of the Lanham Act. In Part II, I will examine specific disparaging trademarks and show the lack of uniformity in rejecting registration of these marks. Finally, in Part III, I will explain the benefits and drawbacks of prohibiting registration of disparaging trademarks, and propose three options for reform in this area of the law.

⁶ Reference to a poem entitled Harlem (but commonly called "A Dream Deferred") by Langston Hughes.

**I. HISTORY: THE PROCESS OF BANNING DISPARAGING TRADEMARKS
FROM FEDERAL PROTECTION**

“I refuse to accept the view that mankind is so tragically bound to the starless midnight of racism and war that the bright daybreak of peace and brotherhood can never become a reality I believe that unarmed truth and unconditional love will have the final word”

— Dr. Martin Luther King, Jr.⁷

Disparaging terms—terms that may bring one into contempt or disrepute⁸—were not always expressly banned from trademark registration. It was not until the adoption of The Federal Trademark Act (“Lanham Act” or “Act”), enacted on July 5, 1946, that the word “disparages” appeared and a formal ban on such trademarks (or “marks”) marks was allowed.⁹ Since that time, few disputes over the registrability of such marks have emerged. While it is unclear exactly how many applicants have attempted to register a term that the courts may deem disparaging, it is clear that a trend has emerged when such marks are at issue.¹⁰ Specifically, if a mark is deemed to be a

⁷ Martin Luther King, Jr., Nobel Peace Prize Acceptance Speech (Dec. 10, 1964), in *LES PRIX NOBEL EN 1964* (Göran Liljestrand ed., 1965), available at http://www.nobelprize.org/nobel_prizes/peace/laureates/1964/king-acceptance_en.html. Dr. King was honored with the Nobel Peace Prize at the height of the Civil Rights Movement. It was a time when millions of Americans fought for equality. It was a time, as Dr. King alludes to in his speech, when race relations were at an impasse—the people of our great nation would either peacefully accept that “all men were created equal,” or face continued and increasing civil unrest.

⁸ 15 U.S.C. § 1052(a) (2012).

⁹ See Trade Mark Act of 1946, Pub. L. No. 79–489, 60 Stat. 427 (codified at 15 U.S.C. §§ 1051–141 (2012)). The Act is officially called the “Trademark Act of 1946,” but is most commonly called the “Lanham Act” in reference to Congressman Fritz G. Lanham who introduced the bill to Congress and was the driving force behind getting the Act adopted. See generally H.R. 9041, 75th Cong. (1938). This was not the first trademark act in the United States. However, previous attempts to protect trademark rights under the law failed for either being unconstitutional or for being inadequate in keeping pace with the global changes in trademark. See *The Trade-Mark Cases*, 100 U.S. 82, 82 (1879) (holding and effectively abolishing the Federal Trade Mark Act of 1870 as being unconstitutional due to its conflict with the provision on patents in the United States Constitution); see also Trademark Act of 1881, ch. 138, 21 Stat. 502 (1881), adopted on March 3, 1881, which underwent several substantial amendments and was ultimately replaced by the Lanham Act.

¹⁰ I have done an extensive search of the online federal trademark database,

continued . . .

disparaging term then the likelihood that an applicant will be able to successfully defend her mark is very slim. On the other hand, marks that are challenged through a third party proceeding (opposition or cancellation) seem to stand a better chance of achieving registration. Ultimately, the success of the mark rests on the subjective beliefs of the finders of fact (either an examining attorney during the application phase, or a panel of administrative judges who are in charge of reviewing the registrability of a mark when it is challenged).¹¹

In order to better understand the flaws in the process of denying registration to marks that are deemed disparaging, a review of the historical development of this portion of the Act is necessary. A discussion of the current process that is in place will follow.

The Lanham Act defines a trademark as, “any word, name, symbol, or device, or any combination thereof”¹² The United States Supreme Court has interpreted this provision very broadly, allowing for the adoption of a variety of types of trademarks.¹³ In *Qualitex Co. v. Jacobson Products Co., Inc.*,¹⁴ the Court interpreted the word “device” found in the Lanham Act to include any number of things, so long as the item sought to be used as a trademark was used properly to distinguish the goods or services of one trademark owner

TESS, from 2009 to the present. My research included determining the number of applications filed each year, and then reviewing month by month all of the applications filed in search of disparaging marks, monitoring the applications I deemed to have a disparaging term. I also searched the database by term, and yielded results beyond my 2009 search. When possible, I reviewed the file history of each application containing the disparaging term. However, in some cases, I was unable to determine why a term was registered or not. The database is not complete. Specifically, for older applications or registrations the file history is not available online or only includes basic details of the application and/or registration; information relating to any potential objections raised by the examining attorney or a third party is missing. This particularly appeared to be true for applications starting with “75” or smaller serial number. Finally, my results may vary as it is not possible to search the TESS database based on rejection (i.e., a Section 2(a) disparaging rejection). Additionally, even if I could, I would not get a hit on all disparaging terms as in some instances marks that I deemed to be disparaging were either registered without any incident (e.g., the words BITCH or SLUT is disparaging of women, but I failed to locate one application that was refused registration because the word was disparaging) or denied registration on other grounds (e.g., the mark conflicted with a previously registered mark).

¹¹ See *infra* Part I.C. (discussing generally the process of registering a trademark).

¹² 15 U.S.C. § 1127 (2012).

¹³ See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (holding that a “color” could serve as trademark so long as it was not functional and had acquired secondary meaning).

¹⁴ 514 U.S. 159 (1995).

from another.¹⁵ This interpretation is also supported by language found in the Act which supports registration of a trademark that is “distinguishable from the goods of others.”¹⁶

The Lanham Act, however, also sets forth certain limitations as to what can be federally registered as a trademark. Specifically, the Act prohibits the registration of any trademark that is “immoral, deceptive, scandalous, or disparaging.”¹⁷ This language, while present in the Lanham Act since its adoption, was not included in prior trademark acts.

A. Earlier Federal Trademark Acts

Congress’s first attempt at federally protecting trademarks came with the adoption of The Federal Trade-Mark of 1870 (“1870 Act”).¹⁸ The 1870 Act recognized that “any person or firm” under the authority of the United States had a right to lawful protection of its trademark in the United States.¹⁹ While the 1870 Act was slim compared to today’s modern trademark act, the drafters did have the foresight to place certain limitations on what could be registered and/or protected as a trademark in the United States.²⁰ For instance, the 1870 Act prohibited the registration of any trademark which was merely the name of a person or a trade name, a mark that was identical to a previously registered trademark used in the same class of merchandise that belongs to a different owner, or any mark that is likely to cause confusion and deceives the public.²¹ In 1879, however, the Supreme

¹⁵ *Id.* at 163.

¹⁶ 15 U.S.C. § 1127 (2012).

¹⁷ *Id.* at § 1052(a).

¹⁸ Trademark Act of 1870, ch. 230, 16 Stat. 198.

¹⁹ *Id.* at § 77.

²⁰ *Id.* at § 79.

²¹ *Id.* The complete language of the 1870 Act’s prohibition on certain trademarks is:

The commissioner of patents shall not receive and record any proposed trade-mark which is not and cannot become a lawful trade-mark, or which is merely the name of a person, firm, or corporation only, unaccompanied by a mark sufficient to distinguish it from the same name when used by other persons, or which is identical with a trade-mark appropriate to the same class of merchandise and belonging to a different owner, and already registered or received for registration, or which so nearly resembles such last-mentioned trade-mark as to be likely to deceive the public . . .

continued . . .

Court held that the 1870 Act was unconstitutional.²² The Court found that the 1870 Act did not distinguish between intrastate and interstate commerce, and on its face appeared to only apply to intrastate commerce.²³ Congress only has the power to regulate interstate commerce; and therefore, the 1870 Act exceeded the powers granted to Congress under the Constitution.²⁴

Congress, in response to the Court's ruling, enacted the Trademark Act of 1881 ("1881 Act"),²⁵ making clear that the 1881 Act was limited to the regulation of interstate commerce and commerce with foreign nations.²⁶ Again, Congress prohibited the registration of some trademarks, mirroring the limitations found in the 1870 Act.²⁷ Certainly, the chief concern of the day seemed to stem from an increase of counterfeit goods, whereby competitors were using the trademarks of others on inferior goods.²⁸ In fact, by the time the 1881 Act was debated, nineteen states had already adopted trademark provisions that provided "severe" penalties for the unauthorized use of the same or similar marks on similar goods.²⁹ The legislative history is devoid, however, as to why Congress limited registration of certain trademarks in this manner.³⁰

Id. In comparison, the Lanham Act still prohibits the registration of marks based on these same standards.

²² The Trade-Mark Cases, 100 U.S. 82, 99 (1879).

²³ *Id.* at 96–97.

²⁴ *Id.* at 96 (holding that the Constitution does not apply to the regulation of all property, including trademarks; and only applies to regulation of interstate commerce); *see also* U.S. CONST. art. I, § 8, cl. 8 (authorizing Congress to promote the progress of science and useful arts by securing to authors and inventors the exclusive right to their respective writings and discoveries (the Court interpreting "writings" to not include trademarks)).

²⁵ Trademark Act of 1881, ch. 138, 21 Stat. 502 (1881).

²⁶ Trademark Act of 1881, ch. 138, 21 Stat. 502 (1881). The 1881 Act was substantially identical to the 1870 Act, with minor formatting changes (i.e., grouping certain sections of the 1870 Act together), "save that it [was] confined to foreign and inter-State commerce." H.R. REP. NO. 46-561, at 1 (1880).

²⁷ Trademark Act of 1881, ch. 138, 21 Stat. 502 § 3 (1881) (limiting the registration of trademarks that were "merely the name of the applicant; nor which is identical with a registered or known trade-mark owned by another and appropriate to the same class of merchandise, or which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers.").

²⁸ *See* The Trade-Mark Cases, 100 U.S. 82, 82 (1879).

²⁹ H.R. REP. NO. 561, at 6.

³⁰ The legislative history found for the 1881 Act appears to serve as a response to the Supreme Court's decision in the *Trade-Mark Cases*, including a complete copy of the opinion in the report and focusing solely on the question of whether Congress has the ability to regulate the use and registration of trademarks. H.R. REP. NO. 561, at 1. There does not appear to be any legislative history for the 1870 Act.

It was not until 1905, when the 1881 Act underwent the substantial changes (“1905 Amendments”³¹), that we see federal trademark law take shape in terms of placing further prohibitions on what may serve as trademark.³² The 1905 Amendments included all of the same prohibitions, but further denied registrations of marks, for example, that were immoral or scandalous.³³ Still, the statute makes no reference to the inability to register “disparaging” marks.

It is commonly accepted that the 1905 Amendments were enacted to bring United States trademark law closer to the standards being set around the world. At the time, the United States was a member of numerous “separate treaties, conventions, and declarations” with various foreign countries; and, there was growing concern over protecting the trademark rights of foreign entities in the United States and vice versa.³⁴ In light of this, on June 4, 1898, President William McKinley appointed a group of commissioners to review and suggest amendments to the 1881 Act in order to bring it in line with the various conventions and treaties of which it was a part.³⁵ Two years later, after an exhaustive review of the trademark acts of several nations and seeking comments from the professional community, the commissioners submitted their findings to the Senate’s Committee of Patents (“Report”).³⁶ The commissioners primarily sought to make changes to the 1881 Act by establishing a clearer trademark registration process, clarifying the process for handling marks that were likely to conflict with existing registered trademarks, and of course, by changing the 1881 Act so that it would “conform to treaty stipulations entered into between the U.S. and certain governments.”³⁷

In the Report, the three commissioners proposed two trademark acts—one proposal being supported by two of the commissioners, with a dissenting report and proposal by one commissioner.³⁸ The “majority bill” (a term used by the dissenting commissioner), was

³¹ Trademark Act of 1905, ch. 592, 33 Stat. 724 (1905).

³² *Id.*

³³ *Id.* at § 5. The 1905 Amendments also prohibited registration of marks that consisted of or comprised the official insignia of any country, state or municipality; was descriptive in connection with the goods on which it was used; was merely a geographical name or term; or was the portrait of a living person that was used without the consent of that individual.

³⁴ H.R. REP. NO. 58-3147, at 2 (1904).

³⁵ *Id.*

³⁶ See “Report of The Commissioners Appointed to Revise the Statutes Relating to Patents, Trade and Other Marks, and Trade and Commercial Names, under Act of Congress Approved June 4, 1898,” S. REP. NO. 56-20 (1900).

³⁷ H.R. REP. NO. 58-3147, at 7.

³⁸ See S. REP. NO. 56-20 (starting at page 63 for the first proposed act, and starting at page 126 for the second proposed act).

similar in many aspects, but did diverge on which marks should be prohibited from federal protection.³⁹ Ultimately, it was the language from the dissenting proposal that was adopted by Congress.⁴⁰ Unfortunately, neither in the Report (which spans over 550 pages) nor in the numerous House of Representatives or Senate Reports on the 1905 Act is any justification given for the adoption of the language that prohibits registration of certain marks.⁴¹ The Majority Bill proposed by the commissioners made no reference to immoral, scandalous or disparaging trademarks.⁴² In this respect the Dissenting Bill diverged from the majority.⁴³ This is the first time that reference is made to immoral or scandalous marks. Regrettably, again no justification is given for why these terms were added to the list of prohibitions.⁴⁴ I suspect that given some of the primary goals of revising the 1881 Act—“to remedy existing defects in the present trademark law”⁴⁵ and to bring the law in line with the trademark laws of foreign countries—that the drafter of the Dissenting Bill was attempting to capture something either already being done in practice in the United States (whether on a state or federal level) or being done in one of the many member countries to which the United States has joined under some treaty or convention. Still, no clear guidance is given by the commissioners on why this language was chosen.⁴⁶ What is clear, however, is that the word “disparaging” was not in the Report, and did not make it into the 1905 Act.⁴⁷

The 1905 Act was amended twelve times.⁴⁸ In order to clear up conflicting provisions and consolidate the 1905 Act into one piece of legislation, Congress adopted the 1920 Act.⁴⁹ Similar to its predecessors, the 1920 Act had its flaws, underwent numerous amendments, and ultimately was found to create further problems with

³⁹ *Id.* at 66.

⁴⁰ H.R. REP. NO. 58-3147 at 7 (referencing to the Report that “[t]he language of section 5 is taken almost verbatim from section 5 of the bill proposed by Mr. Arthur P. Greeley . . .”).

⁴¹ S. REP. NO. 56-20.

⁴² *Id.* at 66. The Majority Bill did expand on the prohibitive language by proposing a ban on the registration of marks that are descriptive of the goods, geographical names, or comprise or consist of public arms, decor, or national flags. *Id.*

⁴³ *Id.* at 127 (adopting the proposed prohibitions listed in the Majority Bill).

⁴⁴ *Id.*

⁴⁵ *Id.* at 126.

⁴⁶ *Id.*

⁴⁷ Trademark Act of 1905, ch. 592, 33 Stat. 724 (1905).

⁴⁸ *Trade-Marks: Hearing on H.R. 9041 Before the Subcomm. on Trade-Marks & Comm. on Patents, 75th Cong.* 18 (1938) (statement of Earl H. Thomson).

⁴⁹ Trademark Act of 1920, ch. 104, 41 Stat. 534 (1920).

respect to which trademarks could be registered.⁵⁰ Still, no limitations were placed on the registration of disparaging marks.⁵¹

B. The Lanham Act

It was not until the Trademark Act of 1946 (“Lanham Act”)⁵² that further prohibitions were adopted, including “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”⁵³ Nevertheless, this prohibition was not in the original bill proposed by Congress.⁵⁴ It was not until nearly fifteen years later, after much debate on the revision of the current trademark act, that a refusal to register disparaging marks was added to the bill.⁵⁵ Further amendments to this section of the bill were made in 1941 and 1943, which reflects this portion Lanham Act that we see today.⁵⁶ The goals behind revising the law were clear—the drafters wanted to “eliminate judicial obscurity,” “to dispense with mere technical prohibitions and arbitrary [sic] provisions,” and to mirror “the purpose of any act . . . to protect the public.”⁵⁷ With respect to the latter goal, the drafters appear to be concerned about two segments of the public: (1) businesses and their ability to prevent others from tarnishing the goodwill associated with their marks and products; and (2) well-known individuals and their right to privacy and not to have their name or likeness associated with a product.

1. Protection of the Public: Businesses or Organizations

⁵⁰ *Trade-Marks: Hearing on H.R. 9041 Before the Subcomm. on Trade-Marks & Comm. on Patents, 75th Cong. 19 (1938)* (statement of Earl H. Thomson) (citing that the chief concerns were the ability to register descriptive marks, the inability to use registration as prima facie evidence of ownership, and that no set term limit for registration was given).

⁵¹ Trademark Act of 1920, ch. 104, 41 Stat. 534 (1920).

⁵² 15 U.S.C. §1051 et seq. (2012).

⁵³ 15 U.S.C. § 1052(a) (2012).

⁵⁴ See *Registration of Trade-Marks: Joint Hearings on S. 2679 Before the Comm. on Patents, 68th Cong. (1925)*.

⁵⁵ *Trade-Marks: Hearing on H.R. 4744 Before Subcomm. on Trade-Marks & Comm. on Patents, 76th Cong. 19-21 (1939)*.

⁵⁶ See Kenneth L. Port, *The Congressional Expansion of American Trademark Law: A Civil Law System in the Making*, 35 WAKE FOREST L. REV. 827, 839 n.51 (2000).

⁵⁷ See H.R. REP. NO. 78-603, at 2 (1943) (detailing that the purpose of the Bill was to eliminate conflicting interpretations of the 1905 Act and the amendments that followed, thereby giving trademark owners a clearer understanding of how to protect and enforce its trademark rights).

In 1938, Congress proposed H.R. 9041⁵⁸, which included a ban on the registration of a mark that “[c]onsists of or comprises immoral, deceptive, or scandalous matter[.]”⁵⁹ Upon reviewing the legislative history, the purpose of this proposed section seems to prohibit the registration of certain matter that would either deceive the public or blemish a preexisting trademark or product.⁶⁰ The objective seems to be less about protecting the public in general and more about protecting businesses and their consumers from the deceptive acts of others.⁶¹ Ultimately the drafters were attempting to protect the public from counterfeit goods and protect the goodwill of trademark owners.⁶²

What is absent from this debate on this portion of the Act is the concern or desire to enact a law that protects individuals (collectively or otherwise) from the unwanted intrusions that one might face by allowing the registration of disparaging marks, unless that individual is well known.⁶³ With this in mind, the drafters of the Lanham Act appear to be more concerned about “trademark disparagement” (false or misleading claims about another’s trademark, goods or services, or business) and less about trademarks that might disparage others personally (even non-trademark holders).⁶⁴

This analysis is further supported by the discussion that ensued when the language was revised and adopted in H.R. 4744.⁶⁵ The section at issue was amended to ban “matter which tends to disparage persons, living or dead, *institutions*, beliefs, or national symbols, or to bring them into contempt” (emphasis added).⁶⁶

Still, the concern focused less on what kind of matter would be “disparaging” to an established institution (and thereby bring it into

⁵⁸ H.R. 9041, 75th Cong. § 3(a) (1938).

⁵⁹ *Id.*

⁶⁰ *See* H.R. REP. NO. 76-944 (1939).

⁶¹ *Id.*

⁶² *See* H.R. REP. NO. 76-944, at 2 (1939) (expressing that times had changed since the adoption of the earlier trademark act, and that a new trademark act was needed in order to keep pace with commercial development; thereby strengthening the trademark rights of businesses and protecting the public from the deceitful acts of others that attempted to exploit the goodwill of its competitors).

⁶³ H.R. REP. NO. 76-944 (1939).

⁶⁴ *But see* *The Freecycle Network, Inc. v. Oey*, 505 F.3d 898, 904 (9th Cir. 2007) (rejecting an interpretation of the Lanham Act as providing for a “trademark disparagement” claim); *see also* *World Wide Prosthetic Supply, Inc. v. Mikulsky*, 640 N.W.2d 764, 772 (Wis. 2002) (considering the possibility of an action under the Lanham Act for “commercial disparagement” without supporting or rejecting the same).

⁶⁵ H.R. 4744, 76th Cong. (1939).

⁶⁶ *Id.* at 1.

ridicule or contempt), and more on an “institution’s” right to freely associate itself with certain goods (and thereby not face contempt from its consumers who may be opposed to the sale of certain products).⁶⁷ Case in point, in both the 1938 and 1939 bills, apparently alcohol was the vice that respectable individuals or institutions might not want associated with their name.⁶⁸ The drafters expressed concern about the ability of someone not in association with the institution to register an identical name for a product not sold by the institution.⁶⁹ The fear, however, was not that consumers would be confused by the source of the product, but that consumers would not respect the institution for having its name associated with certain products.⁷⁰

2. *Protection of the Public: Individuals and Right to Privacy*

The drafters also aspired to protect the rights of celebrities.⁷¹ Again, the record appears to be devoid of any concern about protecting a general class of people, except for perhaps members of a particular organization.⁷² Under the originally proposed language, there was great concern over a person’s right to register the name of someone else.⁷³ The proposed language included a section that prohibited the registration of a mark that “[c]onsists of or comprises the portrait or signature of a living individual . . . or the name, portrait, or signature of any deceased President of the United States” without the consent of the living person or the President’s widow.⁷⁴

Nevertheless, the drafters expressed concern over whether this section (section 3(c)) had enough teeth to prevent registration of marks

⁶⁷ *See id.* at 20 (noting that it would be hard for a fraternal organization, club, or society to get a name that has not been or is not being used by another fraternal organization, club, or society).

⁶⁸ *Trade-Marks: Hearing on H.R. 9041 Before the Comm. on Patents Subcomm. on Trade-Marks*, 75th Cong. 79 (1938) (providing as examples Harvard University’s objection to having beer and liquor sold under the name “Harvard” and “Notre Dame for alcoholic beverages” (most likely referring to the University of Notre Dame), respectively). The disdain for liquor probably is the result of the vestiges of the Prohibition Era, where there was a federal ban on the sale and consumption of alcohol. The prohibition was repealed by the 21st Amendment in 1933 (only five to six years prior to the discussion of these bills). *See id.*

⁶⁹ *Trade-Marks: Hearing on H.R. 4744 Before the Comm. on Patents Subcomm. on Trade-Marks*, 76th Cong. 30 (1939).

⁷⁰ *Id.*

⁷¹ *Trade-Marks: Hearing on H.R. 9041 Before the Comm. on Patents Subcomm. on Trade-Marks*, 75th Cong. 79-80 (1938); *see also*, *Hearing on H.R. 4744* at 20.

⁷² *Trade-Marks: Hearing on H.R. 9041 Before the Comm. on Patents Subcomm. on Trade-Marks*, 75th Cong. 79-80 (1938); *see also*, *Hearing on H.R. 4744* at 20.

⁷³ *Hearing on H.R. 9041* at 79.

⁷⁴ *Id.* at 1.

that might taint the character of reputable figures.⁷⁵ For instance, one attorney that was called to testify before the Sub-committee of Trade-Marks thought “[t]he idea of prostituting great names [like Thomas Jefferson Coffee or Abraham Lincoln products] . . . [to be] very distasteful”⁷⁶ Others followed in this sentiment, including the Commissioner of the Patent Office who found it to be a “shock to [his] sense of propriety to see liberty taken not only with the names of our Presidents, but with the names of celebrities of private life.”⁷⁷ Therefore, it was proposed that section 3(a) be amended to capture marks that would “bring into disrepute or ridicule anyone in the place or community he resides.”⁷⁸ The drafters further distinguished this language from that found in § 3(c), finding that such language was necessary in order to prevent the registration of “immoral and scandalous matter” or matter that would allow for the *laissez-faire* adoption of some prominent figures names.⁷⁹

In 1939, this intent was supported by the adoption of the revised language found in the corresponding section, now numbered § 2(a).⁸⁰ The intent of this revised language was made clear in H.R. 4744⁸¹, which made reference to the 1938 bill, where “a good deal of discussion” was made in support of protecting the names of prominent individuals.⁸² By way of example, the drafters endeavored to prevent certain nefarious uses (like the use of “Abraham Lincoln gin”) but not prevent good-natured uses (like “G. Washington on coffee”).⁸³

In any event, neither bill defines (and therefore protects) “persons” as meaning those belonging to a certain group that shares similar physical characteristics, disabilities, race or nationality, or sexual

⁷⁵ *Id.* at 79.

⁷⁶ *Id.* (quoting from an exchange between Representatives Lanham, Chairman of the Sub-Committee on Trade-Marks, and Edward S. Rogers, a lawyer from Chicago, Illinois).

⁷⁷ *Id.* (citing examples where people attempted to register KNUTE ROCKNE for alcoholic beverages (an American football player and coach for the University of Notre Dame) and DUCHESS OF WINDSOR for ladies’ underwear (most likely a reference to Wallis Simpson, an American socialite, who acquired the title “The Duchess of Windsor” after marrying the Duke of Windsor, Prince Edward).

⁷⁸ *Id.* at 80 (quoting from an exchange among Harrison F. Lyman, from The Boston Patent Law Association, Commissioner Coe, Representatives Lanham, and Mr. Rogers).

⁷⁹ *Id.* (seeking to preserve the sanctity of certain names).

⁸⁰ See H.R. 4744, 76th Cong. (1939).

⁸¹ H.R. 4744, 76th Cong. (1939).

⁸² *Trade-Marks: Hearing on H.R. 4744 Before the Comm. on Patents Subcomm. on Trade-Marks*, 76th Cong. 19 (1930).

⁸³ *Id.*

orientation.⁸⁴ This overly broad application of this section of the Act is why we have conflicting registrations and cases on these issues.

C. The Registration Process and Review of Disparaging Matter by Examining Attorneys

Another goal of the drafters of the Lanham Act was to streamline and simplify the federal trademark registration process.⁸⁵ In order to understand the flaws in the current system as applied to disparaging marks, a brief explanation of the registration process is needed.

1. The Registration Process

Upon the filing of an application that meets the minimum filing requirements⁸⁶, the application is assigned to an examining attorney for review.⁸⁷ The examining attorney will conduct an initial, yet complete review of the application in order to determine if the mark is eligible for registration and to make sure that other matters conform to the requirements of the United States Patent and Trademark Office (“USPTO”).⁸⁸

Under federal law, in order to protect matter as a trademark, all that is required is that the mark be used in commerce and not fall into one of the recognized prohibited categories.⁸⁹ For example, upon initial review, the examining attorney is making sure that: the description of goods or services provided by the applicant is written in a format as prescribed by the USPTO; that the applicant is the owner of the mark; that there are no conflicting marks already in the system; and that it is not a prohibited mark that should be denied registration.

⁸⁴ See H.R. 4744, 76th Cong. (1939); H.R. 9041, 75th Cong. § 3(a) (1938).

⁸⁵ See *id.* at 18 (revising the section to read “[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which tends to disparage persons, living or dead, institutions, beliefs, or national symbols, or to bring them into contempt . . .”).

⁸⁶ See 37 C.F.R. § 2.21(a) (2012) (requiring that before a substantial review of an application is conducted, an applicant must submit an application that meets the minimum filing requirements—the name of the applicant; the name and address for correspondence; a drawing of the mark; a description of goods and/or services associated with the mark; and the filing fee).

⁸⁷ 15 U.S.C. § 1062 (2012).

⁸⁸ See TMEP §§ 701–20 (8th ed., Apr. 2014) (setting forth the general procedures for examining trademark applications).

⁸⁹ *Id.* at § 901; see also 15 U.S.C. § 1052 (2012). The Lanham Act also allows for filing of a trademark application based on intent-to-use; however, the applicant must start using the mark in order for the USPTO to issue a certificate of registration. See TMEP § 1101.

⁹⁰ If there is any offending information in the application, the examining attorney will issue an Office Action and give the applicant a period of time to respond to the Office Action.⁹¹ If the applicant cannot overcome the objections of the examining attorney, then a final refusal will be issued.⁹² On the other hand, if the applicant successfully addresses the examining attorney's concerns, then the application will clear the examination phase and the mark will be published for opposition.⁹³ The opposition period allows for any party that believes it will be harmed by registration of the mark to oppose registration of that mark.⁹⁴ If no opposition is filed, or the applicant successfully defends an opposition, then the mark will be registered.⁹⁵ After registration, the public has another opportunity to challenge registration of a mark by way of a cancellation proceeding.⁹⁶ Similar to an opposition proceeding, any party that believes it will be harmed by registration of the mark may petition to cancel registration of that mark.⁹⁷

In each of the challenges referenced—final refusal by examining attorney, an opposition proceeding, and a cancellation proceeding—the owner of the challenged mark has a right to a review of the issues by the Trademark Trial and Appeal Board (“TTAB”) or may appeal a decision to the United States Court of Appeals for the Federal Circuit.⁹⁸ Should the challenged mark successfully clear review and adjudication by either the TTAB or Court of Appeals, then the mark may be registered or the registration maintained.⁹⁹

What is inherently missing from this process is the fact that even if the owner of the offending mark loses on any level, they may still be able to use the mark in commerce.¹⁰⁰ The Lanham Act regulates the registration of trademarks, but does not regulate the use of matter that

⁹⁰ TMEP § 704 (8th ed., Apr. 2014).

⁹¹ TMEP § 705 (8th ed., Apr. 2014).

⁹² TMEP § 714.03 (8th ed., Apr. 2014).

⁹³ TMEP § 704 (8th ed., Apr. 2014).

⁹⁴ 15 U.S.C. § 1063(a) (2012).

⁹⁵ *Id.* at § 1063(b).

⁹⁶ *Id.* at § 1064.

⁹⁷ *Id.*

⁹⁸ *See id.* (discussing opposition and cancellation proceedings before the TTAB); *see also* 15 U.S.C. § 1070 (2012) (discussing appeals from final decisions by examining attorney); 15 U.S.C. § 1071 (2012) (discussing appeals to courts so long as the mark is in use in commerce).

⁹⁹ *See, e.g.*, U.S. PATENT & TRADEMARK OFFICE, TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 124 (3d ed. 2011).

¹⁰⁰ The owner of an offending mark would, however, be enjoined from using matter that is likely to cause confusion with the owner of a superior mark (a mark that was in use prior to adoption and use of the offending mark).

might otherwise be unregistrable. In other words, what the Act attempts to avoid—having matter in the marketplace that would offend or harm people—does nothing more than prevent the owner of that mark from being able to use the federal trademark symbol in connection with the offending mark.¹⁰¹ The offending mark could still be used, and used in connection with a TM or SM symbol without fear of sanctions from the USPTO.¹⁰²

Furthermore, the Lanham Act regulates trademarks used in interstate commerce.¹⁰³ Therefore, certain matter prohibited under the Lanham Act, may still be acceptable under a state's definition and valid within that state. For example, Colorado defines a trademark in similar manner as the Lanham Act,¹⁰⁴ but no further limitations are imposed on what could qualify as a trademark in Colorado.¹⁰⁵ In theory a disparaging trademark could be protected under Colorado law, validly use the TM or SM symbol, and be put into the stream of commerce, exposing the public to the mark.¹⁰⁶

Applying the test of whether a mark would disparage a person has proven to be difficult and seems to be left more up to the subjective beliefs of the examining attorney, without taking into account whether the applicant belongs to the class of people associated with that term, the intent of the applicant, even if not a member of the class of people, or if the term, once disparaging, remains disparaging when the applicant seeks protection of the mark.

¹⁰¹ See 15 U.S.C. § 1057(a) (2012) (limiting the use of the circle R symbol to federally registered trademarks). However, use of the symbol is permissible if the mark is registered in a foreign country (presumably even if that mark would not be eligible for registration in the U.S.). See 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 19:146 n.1 (4th ed. 2014); TMEP § 906 (8th ed., Apr. 2014).

¹⁰² TMEP § 906 (8th ed., Apr. 2014) (“A party may use terms such as ‘trademark,’ ‘trademark applied for,’ ‘TM’ and ‘SM’ regardless of whether a mark is registered. These are not official or statutory symbols of federal registration.”).

¹⁰³ 15 U.S.C. § 1127

¹⁰⁴ COLO. REV. STAT. § 7-70-101(7) (2013) (defining a trademark as “a word, name, symbol, device, or any combination thereof.”).

¹⁰⁵ *But see* COLO. REV. STAT. § 7-70-107(1)(b) (2013) (establishing a process for cancelling registration of a mark “[b]y a person who is harmed by a statement of trademark registration . . . that . . . contains a material misstatement, [was filed] in bad faith, or is fraudulent.”).

¹⁰⁶ I conducted a search of the Colorado online trademark database, searching for marks that have been cited in this article. See online searching database at <http://www.sos.state.co.us/biz/BusinessEntityCriteriaExt.do> where only one similar mark was located: REDNECK ROY, Registration No. 19911009906 (expired Feb. 19, 2001).

2. *What is a disparaging trademark?*

No statutory definition of what constitutes a disparaging mark is provided in the Lanham Act.¹⁰⁷ Due to this lack of a basic framework, the Trademark Office and the TTAB has been left to create its own definition and test for determining if a mark is disparaging.¹⁰⁸ For example, the Trademark Manual of Examining Procedure (“TMEP”)¹⁰⁹ adopts the definition of disparagement that was established in *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635 (“TTAB 1988”) as:

Disparagement is essentially a violation of one’s right of privacy—the right to be ‘let alone’ from contempt or ridicule. *See Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 218 USPQ 1 (6th Cir. 1983). It has been defined as the publication of a statement which the publisher intends to be understood, or which the recipient reasonably should understand, as tending ‘to

¹⁰⁷ 15 U.S.C. §1051 et seq. (2012).

¹⁰⁸ United States Patent and Trademark Office (USPTO) is a multi-faceted organization that is broadly divided into three groups: the prosecution of patent and trademark applications (the Patent Office and the Trademark Office), the litigation of patent and trademark issues (the Board of Patent Appeals and Interferences and the Trademark Trial and Appeal Board), and the administration of the organization. Any reference to the USPTO, will mean the Trademark Office and not the Trademark Trial and Appeal Board (TTAB). The TTAB is the adjudicatory arm of the Trademark Office, and hears disputes over the ownership and validity of trademarks, including trademarks that have been rejected as unregistrable by a trademark examining attorney. In this paper, when discussing the process and standards followed by the USPTO, I am referring to the Trademark Office and the examination phase of the application (the process by which a trademark application is assigned to an examining attorney who then makes a determination about the validity or registrability of a trademark before either approving it for publication and ultimately for registration should the application clear additional hurdles not related to the examining attorney’s belief in the registrability of the mark). Reference to the TTAB reflects a different phase in the life cycle of trademark: appeals by applicants whose marks did not clear the examination phase; marks that did clear the

continued . . .

examination phase, but a third party seeks to prevent registration of the mark (opposition proceeding); and marks that were registered, but a third party missed the opposition period and now seeks to cancel the registration (cancellation proceeding).

¹⁰⁹ The TMEP is a publication issued by the USPTO to provide examining attorneys with a framework on how to review and resolve issues that come up in the registration process. As found in the foreword of the TMEP, “[t]he Manual contains guidelines for Examining Attorneys and materials in the nature of information and interpretation, and outlines the procedures which Examining Attorneys are required or authorized to follow in the examination of trademark applications.” TMEP (8th ed., Apr. 2014).

cast doubt upon the quality of another's land, chattels, or intangible things.' Restatement (Second) of Torts §629 (1977).¹¹⁰

When determining if a term fits this definition of disparagement, the USPTO and the TTAB apply a two-part test:

(1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and

(2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.¹¹¹

When reviewing an application, an examining attorney has the burden of proving that a term adopted as a trademark is disparaging.¹¹² The threshold of such proof is low. For instance, scandalous marks are also barred from registration.¹¹³ This bar is coupled with disparaging marks and is found in the same section of the Lanham Act.¹¹⁴ Because scandalous marks have been barred from registration longer than disparaging marks, much of the early disparaging cases built on the tests set for denying registration of disparaging marks.¹¹⁵ With this in mind, it is possible for an examining attorney to submit little documentation to support that a term is disparaging. For example, in a case dealing with whether or not a term was scandalous and thus prohibited from registration under the Lanham Act, an examining attorney only needed to provide a dictionary definition to prove the mark was scandalous.¹¹⁶ Therefore, once the examining

¹¹⁰ *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d 1635, 1639 (T.T.A.B. 1988); TMEP § 1203.03(b) (8th ed., Apr. 2014).

¹¹¹ *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 1217 (T.T.A.B. 2010); TMEP § 1203.03(b)(i).

¹¹² *See In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d at 1225.

¹¹³ 15 U.S.C. § 1052(a) (2012).

¹¹⁴ *Id.*

¹¹⁵ *Greyhound Corp. v. Bothworlds Inc.*, 6 U.S.P.Q.2d 1635, 1639 (T.T.A.B. 1988); H.R. 16560, 58th Cong. § 5 (1920) (enacted).

¹¹⁶ *See In re Boulevard Entertainment, Inc.*, 334 F.3d 1336, 1340–41 (Fed. Cir. 2003) (affirming the refusal to register 1-800-JACK-OFF and JACK-OFF as being

attorney has found evidence (no matter how small) that the mark is disparaging, the burden then shifts to the applicant to prove that the mark, as used in connection with the claimed goods or services in the application, is not disparaging.¹¹⁷

The ability of an applicant to overcome such an objection is rarely seen, however, leaving the applicant's option of abandoning the mark (or at least the possibility of obtaining a federal registration), or appealing the examining attorney's decision to the TTAB. In fact, after conducting an extensive search of the federal trademark database, I have only found one instance where an examining attorney later withdrew his refusal to register the mark based on the term being disparaging.¹¹⁸ In this instance, the registrant sought registration of word PHAG and filed an application to protect the same on October 17, 2006.¹¹⁹ On March 8, 2007, the examining attorney issued his first office action, denying registration of the mark as being disparaging because would likely associate the term with "fag," a word that is "clearly defined in the English language as an offensive, although slang, term to the public."¹²⁰ To support this claim, the examining attorney provided as proof a dictionary definition of "fag."¹²¹ Nearly nine months later, the applicant filed a petition to reconsider the refusal and submitted her own evidence of various dictionary definitions and examples of other trademark owners using FAG in connection with its goods or services.¹²² Without further inquiry, the examining attorney approved the mark for publication on May 14, 2008.¹²³ Nevertheless, as indicated previously, this is a rare outcome for an applicant that gets an objection to registration of matter that is initially deemed disparaging by an Examining Attorney.

scandalous marks, where the examining attorney cited to few references of the 85 sources discovered in her search).

¹¹⁷ See TMEP § 1203.03(b)(i) (8th ed., Apr. 2014).

¹¹⁸ See PHAG, Registration No. 4,135,694.

¹¹⁹ U.S. Patent and Trademark Office, *Trademark Search U.S. Serial No. 77022538*, TRADEMARK STATUS AND DOCUMENT RETRIEVAL, http://tsdr.uspto.gov/#caseNumber=77022538&caseType=SERIAL_NO&searchType=statusSearch (generated on Aug. 31, 2014, 12:19:09 PM).

¹²⁰ Letter from John D. Dailer, Trademark Examining Attorney, to Lisa L. Wright, Trademark Applicant (Oct. 3, 2007) (on file with author) <http://tsdr.uspto.gov/documentviewer?caseId=sn77022538&docId=OOA20070308111156#docIndex=38&page=1>.

¹²¹ *Id.*

¹²² TEAS Petition Revive Abandoned Application, from Lisa Miller, to The Commissioner for Trademarks (Dec. 07, 2007) (on file with addressee) <http://tsdr.uspto.gov/documentviewer?caseId=sn77022538&docId=POA20071208185401#docIndex=36&page=1> (last visited Sept. 4, 2014).

¹²³ U.S. Patent and Trademark Office, *supra* note 97, at prosecution history.

II. MOVING TOWARD THE REGISTRATION OF DISPARAGING TRADEMARKS

The disparagement test and the policies that support such a test are straightforward. Clearly, however, there are issues with the application of this test. In light of this, measures have been put in motion to combat some of the terms that exist on the federal trademark registration despite the current law.¹²⁴ However, the goals that the test seeks to achieve are not prevented under the current law or the proposed amendment. Particularly, the refusal to register such marks will not prevent the continued use of those marks in the marketplace. Further, as illustrated above, application of the test has been inconsistent.

A. Denial of Registration Will Not Stop Use of the Term

One fallacy with the current law is that, by denying registration of disparaging terms, the government will somehow protect consumers that would otherwise be subjected to seeing these marks in the marketplace.¹²⁵ However, the Trademark Office has long recognized that the denial of registration does not prevent one from using the mark or securing common law rights in the mark.¹²⁶ Certainly, examples of this exist today.¹²⁷

¹²⁴ H.R. 1278, 113th Cong. (2013), <http://www.gpo.gov/fdsys/pkg/BILLS-113hr1278ih/pdf/BILLS-113hr1278ih.pdf> (last visited Aug. 28, 2014). Discussed in more detail below.

¹²⁵ This seems to be a paternalistic approach to granting or denying trademark rights, and this justification should not be encouraged.

¹²⁶ *Stephano Bros. v. Stamatopoulos*, 238 F. 89, 91 (2d Cir. 1916) (citing *Southern v. How*, Popham, 143, 144, 79 E.R. 1243, 1244 (K.B.1582) (noting that there are some inconsistencies with the date of the *Southern v. How* decision and finding that while the plaintiff's trademark failed to meet the requirements for registration under the 1905 Act, plaintiff still had common law rights and therefore an ability to use the mark and successfully assert a claim of trademark infringement)).

¹²⁷ It seems unlikely that a sports team like, for example, the Washington Redskins, would continue to use a term without the protection of a federally registered trademark given the amount of money generated under that brand name that potentially would be lost if others could sell goods bearing that same term. Nevertheless, Dan Snyder, owner of the Washington Redskins, affirmatively declared “[w]e’ll never change the name . . . It’s that simple. NEVER—you can use caps.” Erik Brady, *Dan Snyder Says Redskins Will Never Change Name*, USA TODAY, May 10, 2013, <http://www.usatoday.com/story/nfl/redskins/2013/05/09/Washington-redskins-daniel-snyder/2148127>.

To be clear, federal trademark registration of a term is not necessary in order to use that term in connection with the sale of goods or services.¹²⁸ Certainly, there are many benefits to receiving federal registration, including a legal presumption of ownership and the right to use the federal registration symbol, which puts others on notice of your claim of ownership of the mark.¹²⁹ Still, the Trademark Office cannot prevent the sale of goods or services bearing the disparaging term.¹³⁰

Case in point, on August 11, 2012, James Genobaga filed a federal trademark application for FLIPS AND BEANERS for use in connection with the promotion of a comedy tour.¹³¹ On March 11, 2013, the Examining Attorney refused registration of the mark, claiming that the terms “flips” and “beaners” were derogatory terms, despite the fact that the trademark had already been in use since November 10, 2010.¹³² The Examining Attorney submitted Wiktionary definitions that defined “flip” as a “chiefly derogatory, ethnic slang” for a Filipino person, and “beaner” as an “offensive” and “ethnic slur” for a Mexican.¹³³ While the application is still pending, it is unlikely that the applicant will file a response, and will ultimately abandon the application.¹³⁴ In the meantime, the mark is still being used in commerce to promote the comedy tour.¹³⁵

¹²⁸ In fact, the Lanham Act recognizes a cause of action of unfair competition and false designation of origin for unregistered trademarks. Nevertheless, the claim is limited to those marks that *could* be registered. 15 U.S.C. § 1125(a) (2012).

¹²⁹ See *Frequently Asked Questions about Trademarks*, USPTO, http://www.uspto.gov/faq/trademarks.jsp#_Toc275426681 (last modified Apr. 23, 2013).

¹³⁰ Additionally, it seems unlikely that a class of people could receive damages because the group is offended by the term being used in connection with certain goods or services. See, e.g., *Bromberg v. Carmel Self Service Inc.*, 198 U.S.P.Q. (BNA) 176, 178 (T.T.A.B. 1978) (“There is no provision in the Trademark Act for class actions.”).

¹³¹ U.S. Trademark Application Serial No. 85,701,322 (filed Aug. 11, 2012), *available at* <http://tsdr.uspto.gov/documentviewer?caseId=sn85701322&docId=APP20120815061530#docIndex=7&page=1>.

¹³² Letter from Sani Khouri, Examining Attorney, USPTO, to James Genobaga (Mar. 11, 2013), *available at* <http://tsdr.uspto.gov/documentviewer?caseId=sn85701322&docId=OOA20130311205353#docIndex=1&page=1>.

¹³³ See *id.* The USTPO attorney attached several screen captured images from the internet that contained the definitions they used when making their determination.

¹³⁴ As of Oct. 9, 2013 this application was abandoned by the applicant for failure to respond to the Office Action. See Notice of Abandonment from USPTO to James Genobaga (Oct. 9, 2013), *available at*

Another example, involves the Asian-American rock band, The Slants. A member of the band attempted to register THE SLANTS in connection to “live performances by a musical band.”¹³⁶ The application was filed in 2011, but the applicant claimed to be using the mark since 2006.¹³⁷ Ultimately, the mark was deemed to be disparaging and the Trademark Office refused to register the mark.¹³⁸ To date, the band is still performing under the name The Slants.¹³⁹

B. Approval of Registration Will Not Guarantee Continued Use of the Mark.

Just as denial of trademark registration will not prevent use of the mark, approval of trademark registration will not ensure the continued use of the mark. First, those that believe that the registration of a disparaging mark is improper can petition to have the registration canceled.¹⁴⁰ Second, consumers who are offended by goods that bear

<http://tsdr.uspto.gov/documentviewer?caseId=sn85701322&docId=NOA20131009223027#docIndex=0&page=1>.

¹³⁵ An internet search revealed that there was a show as recent as Aug. 11, 2013 at Cobb’s Comedy Club in San Francisco, CA. See FLIPS AND BEANERS COMEDY JAM AT COBB’S, <https://www.goldstar.com/events/san-francisco-ca/flips-and-beaners-comedy-jam> (last visited Aug. 26, 2014); see also U.S. Trademark Application Serial No. 85,718,169 (filed Aug. 31, 2012), available at <http://tsdr.uspto.gov/documentviewer?caseId=sn85718169&docId=APP20120904074320#docIndex=4&page=1>. This trademark application was for MADE NIGGAS INC. and Design, and was filed by Adrian Mitchell for use in connection with entertainment services. The Examining Attorney refused registration of the trademark as being derogatory of African Americans. See Letter from Katy Halmen, Trademark Examining Attorney, USPTO, to Adrian Mitchell (Jan. 8, 2013), available at <http://tsdr.uspto.gov/documentviewer?caseId=sn85718169&docId=OOA20130108134156#docIndex=1&page=1>. The application was later abandoned on Aug. 6, 2013, but a search of the internet reveals that the term is still in use. See Notice of Abandonment from USPTO to Adrian Mitchell (Aug. 6, 2013), available at <http://tsdr.uspto.gov/documentviewer?caseId=sn85718169&docId=NOA20130806223051#docIndex=0&page=1>, and Made Nigga\$ Inc., <http://madeniggainc.yolasite.com/> (last visited Aug. 26, 2014).

¹³⁶ *In re Tam*, No. 85472044, 2013 WL 5498164, at *1 (T.T.A.B. Sept. 26, 2013).

¹³⁷ *Id.* at *1 n.1.

¹³⁸ *Id.* at *8 (upholding the examining attorney’s refusal to register the mark as being disparaging against members of the Asian community).

¹³⁹ See THE SLANTS, *Extras Needed for Music Video Filming in Sacramento*, <http://www.theslants.com/extras-needed-for-music-video-filming-in-sacramento/> (last visited Aug. 29, 2014).

¹⁴⁰ Kristine A. Brown, *Native American Team Names and Mascots: Disparaging and Insensitive or Just a Part of the Game?*, 9 SPORTS LAW. J. 115, 122 (2002). As I will argue in Part III of this article, even if the Trademark Act is amended to strike

a disparaging mark can voice their concerns by protesting to the company's use of the term, or otherwise "vote with their wallet" by not purchasing the goods. Such efforts may drive a company to adopt another brand in order to avoid the bad press and loss of revenue by using the disparaging term.¹⁴¹ For this reason, the Trademark Office should err on the side of registration.

This point is best illustrated by the current campaign to get the Washington Redskins to change its name. Launched in September 2013, members of the Oneida Indian Nation started a "Change the Mascot" campaign that included a symposium and series of radio and online ads emphasizing the disparaging nature of the name "redskin," and asking the National Football League to change the team's name.¹⁴² The campaign thus far has been effective, at least to the extent that it has stirred a national debate and has led many (both within and outside the NFL) to understand the significance of the term in the Native American community.¹⁴³ For example, the campaign has caused people like NFL Commissioner Roger Goodell, President Obama, and a series of other politicians to address the viability of a business that uses a term like "redskins" and does not listen to its consumer base.¹⁴⁴

C. The Application of the Disparaging Test Is Too Subjective

The most notable problem with the application of the disparaging test is that it is too subjective and instills too much power in one person (the examining attorney) to determine the validity of the term as a trademark. The counter to this point is that an examining attorney is charged with basing his/her decisions on objective criteria—the review of dictionaries, encyclopedias, surveys of the general public

out "disparage" or the Trademark Office develops a policy of allowing the registration of disparaging marks without scrutiny, then members of a targeted class may still petition to cancel the registration.

¹⁴¹ *Id.* at 123. Public shaming and ostracizing have proven to be effective tools in getting companies to change everything from company policies to ingredients in food to discriminatory practices. The public, therefore, would not make an exception for using such tactics when it comes to a company's trademark use. *See, e.g.,* John R. Harris, *Nuances of Trademark Protection: Policing, Bullying and Shaming*, TECH LAW & BUSINESS REPORT, <http://www.mmmtechlaw.com/?p=5669> (last visited Aug. 30, 2014).

¹⁴² *See* Oneida Indian Nation, CHANGE THE MASCOT, <http://www.changethemascot.org/> (last visited Aug. 29, 2014).

¹⁴³ *See* Alison Harding, *Tribe Seeks to Force NFL Redskins Name Change*, CNN.COM (Oct. 8, 2013, 5:45 PM), <http://www.cnn.com/2013/10/07/us/washington-redskins-name/>.

¹⁴⁴ *Id.*

and the alleged disparaged group, and the like.¹⁴⁵ Still, the examining attorney's personal beliefs about the term may influence her research of the matter. The chart below best illustrates this point:

Disparaging Marks	Non-Disparaging Marks
REDSKIN ¹⁴⁶ for computer software ¹⁴⁷	REDSKIN for beans ¹⁴⁸

SQUAW for clothing ¹⁴⁹	SQUAW for ski-related goods ¹⁵⁰
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¹⁴⁵ See John R. Wallace, *Discriminatory & Disparaging Team Names, Logos, & Mascots: Workable Challenges & the Misapplication of the Doctrine of Laches*, 12 RUTGERS RACE & L. REV. 203, 222–24 (2011).

¹⁴⁶ For purposes of this comparison, I have not included the Pro-Football marks that are the center of *Harjo v. Pro Football, Inc.*, 565 F.3d 880 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009) and pending *Blackhorse*, Cancellation No. 92046185 (T.T.A.B. 2014). With respect to the former case, the Board initially canceled the trademark registration due to it being a disparaging term. On appeal to the district court, the court reversed the cancellation due to a delay in filing the initial

continued . . .

claim (i.e. laches). See *Pro-Football Inc. v. Harjo*, 284 F. Supp. 2d 96, 144 (D.D.C. 2003). The petitioners appealed, and in 2009, the Supreme Court denied certiorari. In light of this decision, a series of new petitioners in *Blackhorse* filed a similar cancellation action. Earlier this year, the Board conducted a hearing to determine whether the term “redskin” is a disparaging trademark. However, it may be several months before an opinion is issued. Additionally, I have included these particular marks because House Bill 1278 seems to limit the refusal to register or cancel marks consisting of or comprising the term “redskin” to those marks that are “used in . . . connection with references to or images of [Native Americans].” H.R. 1278, 113th Cong. (2013). Considering the goods used in connection with the “redskin” marks cited in the table, it is clear that these marks are not intended to reference Native Americans. Therefore, making each inapplicable under House Bill 1278.

¹⁴⁷ See REDSKIN, Registration No. 85,394,731 (filing made as of Aug. 10, 2011, and later abandoned by the applicant due to the examining attorney refusing registration of the mark as being disparaging to Native Americans). I believe the examining attorney did not understand the purpose of the mark. First, the mark was filed by a company called Red.com. Second, the mark is used in connection with computer software. “Skin” is a commonly recognized term in the computer industry used to reference decorative and/or protective sleeves that can be placed over computer equipment (e.g., laptops). It is my belief that the examining attorney missed the play of the words on the trade name and the product. Instead, the examining attorney opted to reject the mark as being disparaging.

¹⁴⁸ See REDSKIN, Registration No. 2,183,639.

¹⁴⁹ See *In re Squaw Valley Development Company*, 80 U.S.P.Q.2d 1264, 1264 (T.T.A.B. 2006) (finding that SQUAW was disparaging to Native American women when used in connection with clothing, but not when used in ski-related items as consumers would think that it was a reference to ski resort in Squaw Valley, California).

¹⁵⁰ *Id.* at 1285.

KHORAN for wine ¹⁵¹	KORAN WE MAKE FIRM MATTRESS ONLY and Design for mattresses ¹⁵²
HEEB for clothing and entertainment services ¹⁵³ ; THE BIG HEEB BREWING COMPANY for beer ¹⁵⁴	HEEB for magazines ¹⁵⁵
JAP for clothing ¹⁵⁶	JAP for clothing; JUNGLE JAP for hand bags and linens ¹⁵⁷

¹⁵¹ See Serial No. 77/072,261. This application was reviewed by two examining attorneys. The first examining attorney issued an office action on Feb. 23, 2007, making no objections to registration of the mark, but seeking more information as to whether the word had any significance in the alcoholic beverage industry or any geographical significance. This information was provided by the applicant. At some point the application was assigned to another examining attorney, and on Sept. 19, 2007, the new examining attorney refused registration of the mark as being disparaging to Muslims because the mark was the phonetic equivalent of Koran, and under the Koran the consumption of alcohol is prohibited. (Use of a term that is the phonetic equivalent of a disparaging term is also disparaging. *See, e.g., In re Hines*, 31 U.S.P.Q.2d 1685, 1691 (T.T.A.B. 1994) (recognizing BUDDA as a misspelling of the name of the religious figure “Buddha”). A final office action was issued on Apr. 8, 2008, and the applicant appealed the decision.

¹⁵² Reg. No. 3,243,538 (providing information in the application that “koran” in Chinese means “big flower”; the mark proceeded to registration without a § 2(a) refusal).

¹⁵³ Serial No. 78/558,043. This application seems to have suffered a similar fate as the KHORAN mark. When the application was initially assigned to an examining attorney, her objections to the registration of the mark centered on the fact that the mark seemed to be ornamental in nature when used in connection with clothing (i.e., it served more as a design on a shirt, rather than serving as a source identifying trademark). Eight months later, the examining attorney reconsidered her objections and issued another order denying registration of the mark based on disparagement. Applicant appealed the decision to the T.T.A.B., which affirmed the refusal. *See In re Heeb Media, LLC* (T.T.A.B. 2008).

¹⁵⁴ Serial No. 78/432,597. The examining attorney refused registration of the mark because it is the phonetic equivalent of the term HEBE, which is viewed as being disparaging to Jews. The application was later abandoned by the applicant.

¹⁵⁵ HEEB, Registration No. 2,858,011 (proceeding to registration without a § 2(a) refusal).

¹⁵⁶ U.S. Trademark Application Serial No. 76,704,644 (filed Sept. 23, 2010) (refusing registration of the mark as being disparaging to Japanese and young Jewish women; the applicant later abandoned the mark without fighting the refusal).

¹⁵⁷ JUNGLE JAP, Registration No. 1,296,211 (proceeding to registration without objection, but later canceled by registrant for failure to file the appropriate documents showing continued use).

WHITE PRIDE COUNTRY WIDE for clothing ¹⁵⁸	WHITE POWER for vehicle parts ¹⁵⁹ ; REDNECK CONFEDERATION for flags ¹⁶⁰
	BLACK PRIDE for games ¹⁶¹ ; BLACK POWER for cattle breeding ¹⁶²
FAG for magazines ¹⁶³	F A G FABULOUS AND GAY for bath products ¹⁶⁴ PHAG for clothing ¹⁶⁵
SUPERDYKE ¹⁶⁶	DYKES ON BIKES ¹⁶⁷

¹⁵⁸ U.S. Trademark Application Serial No. 78,368,298 (filed Feb. 15, 2004) (refusing registration as being offensive to minorities; the applicant challenged the examining attorney's refusal to register the mark by citing at least thirty examples where the USPTO allowed registration for similar marks, including: ASIAN PRIDE; BLACK PRIDE; CHOCTAW PRIDE; HISPANIC PRIDE; and JEWISH PRIDE).

¹⁵⁹ WHITE POWER, Registration No. 2,249,953 (proceeding to registration without a § 2(a) refusal, but later canceled for failure to show continued use of the trademark).

¹⁶⁰ REDNECK CONFEDERATION, Registration No. 4,229,888 (approving registration without any objections).

¹⁶¹ BLACK PRIDE, Reg. No. 1,573,602 (showing that the mark proceeded to registration without a § 2(a) refusal, but was later canceled for failure to show continued use of the trademark).

¹⁶² BLACK POWER, Reg. No. 3,332,496 (indicating that the mark proceeded to registration without a § 2(a) refusal).

¹⁶³ U.S. Trademark Application Serial No. 78,164,481 (filed Sept. 16 2002). This mark was refused registration for being a "derogatory term." The applicant later abandoned the mark without challenging the refusal.

¹⁶⁴ F•A•G FABULOUS AND GAY, Reg. No. 2,997,761. The mark was registered without any challenge from the examining attorney, but was later canceled for failure to show continued use of the mark.

¹⁶⁵ PHAG, Reg. No. 4,135,694. In this case the examining attorney refused registration of the mark under § 2(a), but the trademark owner challenged the examining attorney's refusal citing resources that showed PHAG (and its phonetic equivalent FAG) were used by homosexuals in a non-pejorative manner. Based on this argument, the examining attorney withdrew his refusal and approved the mark for registration.

¹⁶⁶ U.S. Trademark Application Serial No. 74,325,314 (filed Oct. 26, 1992) (showing this application was filed before the DYKES ON BIKES decision, and was refused registration as being disparaging to lesbians).

¹⁶⁷ Various other pending applications that were filed by different trademark owners were initially refused registration, as "dyke" was viewed as being disparaging to lesbians. Those applications were suspended until a final determination was made for DYKES ON BIKES. The T.T.A.B. ultimately approved

RHR RIDE HARD RETARD for clothing ¹⁶⁸	RETARDIPEDIA and RETARDAISSANCE for entertainment services ¹⁶⁹ RETARDS GONE WILD for adult entertainment services ¹⁷⁰
NIGGA for clothing and retail services ¹⁷¹	COLORED PEOPLE and Design for clothing ¹⁷² UPPITY NEGRO for clothing ¹⁷³ REDNECK and Design for clothing ¹⁷⁴ REDNECK ALERT for humorous novelty items ¹⁷⁵

The above-noted examples clearly show the inability to consistently and accurately apply the disparagement test. As the chart

registration of DYKES ON BIKES, and other “DYKE” marks were allowed registration based on the T.T.A.B.’s decision. *See* McDermott v. S.F. Women’s Motorcycle Contingent, 81 U.S.P.Q.2d 1212 (T.T.A.B. 2006) (citable as precedent).

¹⁶⁸ U.S. Trademark Application Serial No. 77,745,550. This mark was refused registration for being a “derogatory term.” The applicant later abandoned the mark without challenging the refusal.

¹⁶⁹ Registration No. 3,750,644, Registered Feb. 16, 2010; Registration No. 3,739,648, Registered Jan. 19, 2010; Registration No. 3,751,638, registered Feb. 23, 2010 (all approved for registration without any challenges).

¹⁷⁰ U.S. Trademark Application Serial No. 78,735,840. This mark was ultimately abandoned by the applicant and was never approved for registration. The examining attorney refused registration of the mark for two reasons: (1) the mark was confusingly similar to prior filed marks; and (2) the mark was immoral and scandalous. However, the reasons given by the examining attorney support denying the mark because it is a disparaging term, citing from a dictionary definition that “the word “RETARD” is an “offensive term that deliberately insults somebody with a learning disability or somebody regarded as unintelligent.” The applicant abandoned the mark without challenging the refusal. *See also* FUNCTIONING RETARD, U.S. Trademark Application Serial No. 85,832,575, filed Jan. 23, 2013 (monitor for results).

¹⁷¹ U.S. Trademark Application Serial Nos. 76,623,949, 76,639,548.

¹⁷² Registration No. 3,843,574, registered Sept. 7, 2010, without challenge.

¹⁷³ U.S. Trademark Application Serial No. 86,053,392 (filed Aug. 31, 2013). As of Dec. 20, 2013, this application is pending and the examining attorney has requested only minor amendments to the application. Should the applicant address these minor requests, then the mark will clear the examination phase.

¹⁷⁴ REDNECK, Registration No. 1,054,383 (later canceled for failure to show continued use of the mark). Other marks are currently registered for REDNECK for drinks, food, and car care products.

¹⁷⁵ REDNECK ALERT, Registration No. 3,128,078.

highlights, several so-called disparaging marks have been registered, *without challenge*, by various examining attorneys. Again, when an applicant files a trademark application, that application is assigned to one examining attorney that is in charge of deciding the fate of the subject mark.¹⁷⁶ It is the mind of this individual that will determine if (in his or her view) the mark is disparaging. Granted, the test lays out objective factors that an examining attorney can use in order to investigate if the mark is disparaging. Still, if at first glance the examining attorney does not perceive the mark to be a disparaging term, then there is no prompt for that individual to apply any of the objective factors.

Take, for instance, the HEEB, JAP, FAG, and REDNECK marks cited in the chart. There is objective evidence that exists that shows each of these terms have been used in a disparaging manner against a group of specific people. Still, for the examining attorneys in charge of reviewing these applications, the prosecution history seems to suggest that these individuals did not have concerns about the disparaging nature of the marks.¹⁷⁷ Perhaps they did not know about the historical and/or current use of the terms. It is also plausible that despite knowing that the term had a disparaging definition, the examining attorney did not think that the term was “disparaging enough” to warrant a refusal. Certainly, this is just speculation. Nevertheless, if an applicant gets the right examining attorney, the mark will be registered. If not, the mark will be denied registration. Given these notable inconsistencies, this portion of the Act should be struck and disparaging marks should receive the same protection as other arbitrary terms.¹⁷⁸

One perplexing example of the subjective nature of disparaging marks and support for why such terms should be treated as arbitrary trademarks can be found in *Dayton Nut Specialties, Inc. v. Fuqua Pecans, LLC*.¹⁷⁹ In this opinion, the Board took judicial notice of a

¹⁷⁶ See e.g., HEEB, *supra* note 132, Attorney Information.

¹⁷⁷ See *id.*, Prosecution History.

¹⁷⁸ Trademarks may either be inherently distinctive (and thus immediately qualify for trademark protection) or may become protectable over time after meeting certain requirements. Marks that are deemed “inherently distinctive” are classified as either fanciful (completely made up words or terms, like XEROX), suggestive (indirectly conveys a quality about the goods or services, like COPPERTONE for tanning lotion), or arbitrary. Arbitrary marks have been defined as “words that are in common linguistic use but, when used to identify particular goods or services, do not suggest or describe . . . the goods or services.” TMEP § 1209.01(a) (8th ed., Apr. 2014). Commonly cited examples include APPLE for computers or CAMEL for cigarettes.

¹⁷⁹ See generally *Dayton Nut Specialties, Inc. v. Fuqua Pecans, LLC*, No. 91179464, 2009 WL 1068776, (T.T.A.B. 2009).

dictionary definition that defined the term in question, “redneck,” as “disparaging.”¹⁸⁰ The opinion stemmed from a trademark opposition that was filed by Dayton Nut Specialties, Inc. (“Dayton Nut”) against Fuqua Pecans, LLC (“Fuqua”) when the latter sought protection for a mark that Dayton Nut claimed was confusingly similar to its mark.¹⁸¹ Fuqua had filed an Intent-to-Use application on October 3, 2006 to protect REDNECK NUTS for use in connection with various nut products.¹⁸² Although Fuqua had filed its application prior to Dayton Nuts application, the record showed that Dayton Nut had used the trademark REDNECK in connection with “processed nuts” since at least 1997.¹⁸³ Dayton Nut argues that since its mark was used first in connection with the same product that it had acquired common law protection of the trademark.¹⁸⁴

Fuqua’s defense was that in order to make a claim for common law protection, Dayton Nut would have to show that its mark was inherently distinctive or had otherwise acquired secondary meaning.¹⁸⁵ With respect to the former point, if a trademark is “fanciful” (i.e., the word is made up by the trademark owner) or arbitrary (i.e., it is a commonly recognized word, but used in connection with unrelated goods or services) then the trademark would be deemed to be inherently distinctive.¹⁸⁶ In other words, the mark would immediately be protectable once in use in commerce.¹⁸⁷ The Board addressed this issue by taking judicial notice of a Merriam-Webster’s dictionary definition that defined “redneck” as “disparaging: a white member of the Southern rural laboring class.”¹⁸⁸ In light of this definition, the Board found “redneck” to be an arbitrary term when used in connection with peanuts, and held Dayton Nut’s trademark, REDNECK, to be an inherently distinctive mark.¹⁸⁹ The Board went on to conclude that Dayton Nut had established a priority use over

¹⁸⁰ *Id.* at *2.

¹⁸¹ *Id.* at *1.

¹⁸² *Id.* at *2; *see also* U.S. Trademark Application Serial No. 77,012,333 (filed Oct. 3, 2006).

¹⁸³ *Id.*; *see also* REDNECK, Registration No. 3,703,868 showing filing date of Feb. 2, 2007 and a first use date of Aug. 1, 1997.

¹⁸⁴ *Dayton Nut Specialites, Inc.*, 2009 WL 1068776 .at *2.

¹⁸⁵ *Id.*

¹⁸⁶ *See* TMEP, §1209.01–.01(a).

¹⁸⁷ *Id.* at § 1202.

¹⁸⁸ *Dayton Nut Specialities, Inc.*, 2009 WL 1068776 at *2.

¹⁸⁹ *Id.*

Fuqua,¹⁹⁰ and that the marks were confusingly similar.¹⁹¹ Therefore, it denied registration of Fuqua's trademark.¹⁹²

What is troubling about this decision is that the Board, while attempting to prove one's right for trademark protection, unwittingly proved its invalidity. The Board used a source that defined the term in a way that would make the term unregistrable, which should have prevented either party from being able to register the term. In fact, dictionary definitions are one of the primary sources that an examining attorney would use in order to support a claim of disparagement.¹⁹³ For example, when attempting to prove that a term is disparaging, the disparagement test incorporates a direction to consult dictionary definitions.¹⁹⁴ Consequently, if the Board recognizes that a term is disparaging and still allows for its protection, then the general refusal of disparaging marks should be struck from the Act.

D. The Introduction of H.R. 1278 Attempts to Prevent Adoption of REDSKIN as a Trademark, But Falls Short

In an effort to remove certain improperly registered disparaging terms, on March 20, 2013, Rep. Eni Faleomavaega and nine cosponsors introduced bill H.R. 1278, known as the "Non-Disparagement of Native American Persons or Peoples in Trademark Registration Act of 2013."¹⁹⁵ The bill attempts to provide finality to a line of disputes surrounding Pro-Football, Inc.'s registration of REDSKINS, and variations.¹⁹⁶ The dispute started in 1992 when a group of Native Americans petitioned the Board to cancel the REDSKINS trademark, arguing that the mark was disparaging and therefore registered in violation of the Lanham Act.¹⁹⁷ Based on this assertion, the Board canceled the registration.¹⁹⁸ Pro-Football appealed the decision to the district court, and the court reversed the

¹⁹⁰ *Id.*

¹⁹¹ *Id.* at *5.

¹⁹² *Id.*

¹⁹³ See *In re Lebanese Arak Corp.*, 94 USPQ2d 1215, 1217 (T.T.A.B. 2010) (stating that dictionary definitions are to be taken into account in the determination of whether a proposed mark is disparaging).

¹⁹⁴ *Id.*

¹⁹⁵ H.R. 1278, 113th Cong. (2013).

¹⁹⁶ See generally *Pro Football, Inc. v. Harjo*, 565 F.3d 880 (D.C. Cir. 2009), *cert. denied*, 558 U.S. 1025 (2009); *Blackhorse v. Pro Football, Inc.*, Cancellation No. 92046185 (T.T.A.B. 2006).

¹⁹⁷ See generally *Harjo v. Pro Football, Inc.*, 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999).

¹⁹⁸ *Id.*

cancellation.¹⁹⁹ However, the court did not reinstate the mark because it deemed it to be a non-disparaging term.²⁰⁰ Instead, the court reversed the Board's decision based on a laches defense.²⁰¹ The group of Native Americans appealed to the Supreme Court, but it denied *certiorari*.²⁰² In response to this result, a series of new petitioners, in *Blackhorse v. Pro Football, Inc.*, filed a similar cancellation action.²⁰³ On March 7, 2013, the Board conducted a hearing to determine whether the term "redskin" is a disparaging trademark.²⁰⁴ It was expected to be several months before an opinion was issued, and in the meantime, H.R. 1278²⁰⁵ was introduced.²⁰⁶ On June 18, 2014, the TTAB issued a decision on *Blackhorse*, and by a 2-1 vote, determined that REDSKINS is a disparaging term and ruled that the registration should be canceled.²⁰⁷ Still, it is expected that the decision will be appealed.²⁰⁸ Therefore, it could be some time before we get a final answer about the status of the REDSKINS registration.

The purpose behind H.R. 1278 (the "Bill") is two-fold: (1) to prevent the future registration of trademarks that consist of or include the term "redskin;" and (2) to cancel any existing registrations that contain the term, regardless of whether it was deemed disparaging at the time of registration or if it is incontestable.²⁰⁹ What is remarkable about this Bill is that it seems to be the first time in federal trademark history that the legislators have sought a statutory ban on a specific term.²¹⁰ However, such an express ban is not necessary under the current law and it does nothing more than trample on the rights of existing trademark owners. For example, under current and past trademark law, words are deemed registrable on a case-by-case review

¹⁹⁹ *Pro-Football, Inc. v. Harjo*, 284 F. Supp.2d 96, 145 (D.D.C. 2003).

²⁰⁰ *Id.*

²⁰¹ *Id.*

²⁰² *See generally* *Harjo v. Pro Football, Inc.*, *cert. denied*, 558 U.S. 1025 (2009).

²⁰³ *Blackhorse v. Pro Football, Inc.*, Cancellation No. 92046185 (T.T.A.B. 2006).

²⁰⁴ *Id.*

²⁰⁵ H.R. 1278, 113th Cong. (2013).

²⁰⁶ *Id.*

²⁰⁷ Erik Brady, *Redskins trademarks canceled by U.S. Patent Office*, USA TODAY SPORTS, June 18, 2014.

²⁰⁸ *Id.* A party to a cancellation proceeding may appeal a decision by the TTAB by either filing an appeal to the U.S. Court of Appeals for the Federal Circuit in Washington, DC, or by filing a civil action through the U.S. District Court for the Eastern District of Virginia. While an appeal is pending, the registration is still valid.

²⁰⁹ H.R. REP.1278, 113th Cong. § 2 (2013).

²¹⁰ *See* Trademark Act of 1905, ch. 592, 33 Stat. 724 (1905); Trademark Act of 1920, ch. 104, 41 Stat. 534 (1920); 15 U.S.C. §1051 et seq. (2012).

given the various tests laid out for accepting or denying registration or a mark.²¹¹ Disparaging marks are no exception, and it is possible under the current test to register a mark that may seem disparaging, but when analyzed in the context of its use in connection with the claimed goods or services, would otherwise be registrable. For example, in 1998 the Nittany Corporation received a registration for REDSKIN, as used in connection with canned beans.²¹² Clearly, this company's use of REDSKIN refers to the color of beans it is selling under the mark. In light of the current test, this mark was properly registered because it is not used in such a way as "to refer to identifiable persons."²¹³ Under this Bill, however, Nittany's trademark rights would be wiped out as the proposed legislation seeks to cancel any existing registrations that contain the term, regardless of whether it was deemed disparaging at the time of registration.²¹⁴ The Bill, being retroactive in nature if adopted, puts in jeopardy the rights of trademark owners who legally achieved registration under the current law.

Arguably, this Bill is necessary to achieve what the current law has not been able to do—prevent or cancel registrations that contain the word "redskin." However, H.R. 1278, as well meaning as it may be, does little to prevent the issue it seeks to address.²¹⁵ First, the Bill does not prevent use of the mark—only registration of the mark.²¹⁶ Granted, a trademark owner receives numerous benefits under the federal Trademark Act, but a mark owner may not be concerned about the protections and rights granted in the Trademark Act. Therefore, the owner will still use the mark, and the class that the legislators seek to protect will still be subject to the use of the mark in the marketplace.

Additionally, the Bill does not prevent the user from claiming common law rights in the mark.²¹⁷ Certainly, common law trademark rights do not provide the same protection that federal rights would

²¹¹ See *Trademark Process*, THE UNITED STATES PATENT AND TRADEMARK OFFICE (Sept. 6, 2012, 5:25:03 PM), <http://www.uspto.gov/trademarks/process/index.jsp>.

²¹² REDSKIN, Registration No. 2,183,639.

²¹³ *In re Lebanese_Arak Corp.*, 94 USPQ2d 1215, 1217 (T.T.A.B. 2010)..

²¹⁴ See H.R. 1278, 113th Cong. § 5 (2013).

²¹⁵ I acknowledge that the history of the term "redskin" is disparaging toward Native Americans, and that the term continues to be a source of pain and ridicule for a number of Native Americans. It is not my goal to advocate for the abuse of the word "redskin," or any other term now known or created in the future, that would disparage a group of people. Still, the harms that are trying to be prevented will not be cured via legislation.

²¹⁶ H.R. 1278, 113th Cong. § 5 (2013).

²¹⁷ *Id.*

give a trademark user. However, common law trademark rights do provide some protection, at least in the geographic area where the mark is actually used.²¹⁸ These rights are still recognized today, and given the prevalent use of the Internet to market and sell goods or services, these rights can rapidly expand to various territories even if the trademark user's base is only in one state.²¹⁹ Further, because the law protects the common law rights of a trademark user, that owner may use the "TM" or "SM" symbol.²²⁰ This designation serves to put others on notice that the user claims rights to the mark, thereby discouraging others from using the mark.²²¹ Therefore, while H.R. 1278 may prevent the registration of a particular term, it will not prevent the use of that term.

In short, the proposed bill does not achieve the goals it sets out to address. It stops short of preventing the real issues, and is overreaching in curing those issues by eliminating otherwise registrable marks. For these reasons, the proposed amendment is unnecessary and a waste of legislative time and resources.

III. PROPOSAL FOR RESOLVING DISPUTES SURROUNDING DISPARAGING MARKS

As I detailed above, determining what is a disparaging mark and applying this test resulted in inconsistency on the federal registry.²²² In light of this, I assert one of three proposals—(1) the registration of disparaging marks should be allowed without scrutiny or challenge; (2) registration of disparaging marks should be allowed, but with the ability for those that believe they would be injured by the mark to oppose registration of the mark or cancellation of the registration of contestable marks; or (3) the current Act should be reformed and guidelines adopted that would make the process more objective.

²¹⁸ Gen. Healthcare Ltd. v. Qashat, 364 F.3d 332, 336 n.7 (1st Cir. 2004) (citing United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90, 97-98 (1918), which clarifies that common-law trademark rights are confined to territories of use).

²¹⁹ See generally, e.g., Brian L. Berlandi, *What State Am I In?: Common Law Trademarks on the Internet*, 4 MICH. TELECOMM. & TECH. L. REV. 105 (1998) (highlighting the fact that common law rights are limited to the zone of the geographic use, and how the Internet may expand the geographic territory for a trademark user).

²²⁰ Trademarks FAQs, USPTO.GOV, http://www.uspto.gov/faq/trademarks.jsp#_Toc275426682 (last updated Apr. 23, 2013).

²²¹ *Id.*

²²² See, *supra* chart above, Section C.

A. First Proposal: Allow the Registration of Disparaging Marks Without Scrutiny or Challenge

My preferred approach to resolving the inherent inconsistencies that are sure to arise under the Trademark Act is to amend it so that disparaging marks could be registered. I particularly believe this to be the best approach because it is more in line with the legislative intent of preventing directed attacks at an identifiable individual or institution. Additionally, the current law has proven to be vague in terms of setting clear guidelines for resolving these disputes, and application of the disparagement test is highly subjective.

Currently, the Trademark Act reads, as follows:

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

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute;²²³

I propose that the Trademark Act should be amended, as follows:

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

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may ~~disparage or~~ falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols; or matter which may bring them an identifiable person, living or dead, or institution into contempt, or disrepute;²²⁴

²²³ 15 U.S.C. § 1052(a) (2012).

²²⁴ I am not attempting to amend the Act in such a way that would prevent likelihood of confusion, false designation or dilution claims that may also include a claim of bad faith and/or disparagement, as found under §§ 2(d) and 43 of the Lanham Act (15 U.S.C. §§ 1052(d), 1125 (2012)). Additionally, the focus of the proposed amendment is to prevent registration of marks that are clearly adopted to attack an identifiable individual or organization (“institution”), while allowing for the registration of marks that may or may not offend a particular, general class of

B. Second Proposal: Allow the Registration of Disparaging Marks, But with a Process for Protected Groups to Challenge the Registration of the Mark.

Under my second proposal, the Trademark Office should treat disparaging terms, which are directed at a general group of people, institution, belief, or national symbol, as arbitrary or suggestive marks when applied to the protected goods or services. By taking this approach, the Trademark Office should not prevent the registration of a term simply because it has disparaging meaning or context of use. However, if “a substantial composite of the referenced group”²²⁵ believes it will be harmed by the registration of the mark at issue, then a process should be adopted that would allow for these challenges to move forward.

A similar approach was adopted and recently amended in the state of Wisconsin.²²⁶ Under Wisconsin’s state trademark law, “any mark” may be adopted and registered with few limitations.²²⁷ These limitations, however, do not include one’s ability to register a disparaging trademark.²²⁸ For this reason, even state-supported institutions may adopt “race-based nicknames, logos, mascots, and team names” (collectively, “race-based marks”).

Wisconsin’s act specifically allows for schools to use these types of marks.²²⁹ The original act, 2010 Wisconsin Act 250 (“2010 Act”)²³⁰, provided the basic framework that allowed for the adoption of such marks, while still providing a way for injured parties to challenge a school’s use of the same. In December of 2013, the

people based on, for example, race, color, culture, religion, sex, sexual orientation, or handicap.

²²⁵ *In re Lebanese*, 94 U.S.P.Q.2d 1215, 1217 (T.T.A.B. 2010).

²²⁶ See 2010 Wis. Legis. Serv. 250 (West), *repealed by* 2013 Wis. Legis. Serv. 115 (West).

²²⁷ WIS. STAT. ANN. § 132.01(1) (West Supp. 2013).

²²⁸ WIS. STAT. ANN. § 132.01(5) (West Supp. 2013) (preventing the registration of “any mark which consists of or comprises a replica or simulation of the flag, coat of arms, or insignia of the United States, or of any state or municipality or any foreign nation”). Additionally, under Wisconsin case law, marks that are deemed generic or descriptive may also be denied registration. See *generally* *Vredenburg v. Safety Devices Corp.*, 10 N.W.2d 226 (Minn. 1955); *Avenarius v. Kornely*, 121 N.W. 336 (Wis. 1909). Marks that are “identical or substantially identical” to a previously registered mark are also rejected, under Wisconsin’s trademark counterfeiting act. WIS. STAT. ANN. § 132.001 (West 2011).

²²⁹ S. 25, 2009 Gen. Assemb. (Wis. 2010), *available at* <https://docs.legis.wisconsin.gov/2009/related/acts/250.pdf>.

²³⁰ 2010 Wis. Legis. Serv. 250 (West), *repealed by* 2013 Wis. Legis. Serv. 115 (West).

Wisconsin legislators repealed the 2010 Act and adopted 2013 Wisconsin Act 115 (“2013 Act”).²³¹ The 2013 Act kept the same basic framework and procedural process, yet made changes in terms of who could bring a challenge, the timeliness of the challenge, and shifted the burden from the state of disproving the injury to the injured party proving an injury as a result of a school’s use of a race-based mark.²³² For example, in terms of who can bring the suit, under the 2010 Act, “a school district resident” could file a complaint challenging the use of a race-based mark and the school board had the burden of proving “by clear and convincing evidence, that the [race-based mark] did not promote discrimination, pupil harassment, or stereotyping.”²³³ In contrast, under the 2013 Act, any school district resident may file the complaint, but only after collecting signatures from “at least 10% of the school district’s member[s].”²³⁴ Additionally, the burden is on the complainant to prove discrimination, harassment, or stereotyping as a result of the school using a race-based mark.²³⁵ What is particularly appealing about the newly adopted process in the 2013 Act, is that it prevents one person from making a claim based on his or her personal view of how the mark causes an injury to a whole group. Instead, it implements a procedure whereby the collective voices of that community and/or targeted group may challenge a school’s use of the mark.

I believe that a similar approach should be adopted by the Trademark Office—allow for the registration of disparaging marks, with a process for injured parties to challenge the registration of the same. Such an approach would not be foreign to the federal trademark registration system.²³⁶ First, when there is any doubt as to the registrability of a trademark, an examining attorney must resolve that

²³¹ 2013-2014 Wis. Legis. Serv. Act 115, 1 (West).

²³² *Id.*

²³³ S. 25, 2009 Gen. Assemb. (Wis. 2010), *available at* <https://docs.legis.wisconsin.gov/2009/related/acts/250.pdf>.

²³⁴ *See* 2013-2014 Wis. Legis. Serv. Act 115, 1 (West) (defining a “school district member” as an adult only (i.e., “electors’ signatures”) and invalidating any signature that was obtained more than a 120 days before the complaint is filed).

²³⁵ *Id.*

²³⁶ There exists proof that concerned groups will use the process in order to protect themselves. For instance, the Trademark Office approved the registration of JAP for clothing (JAP, Registration No. 10,30,376) on January 13, 1976. (The prosecution history is not available for this file, therefore I do not know if the examining attorney ever questioned the registrability of the mark). On January 13, 1981, David Nikaido and The Japanese American Citizen League filed a petition to cancel the registration, arguing that the term “jap” was a derogatory term to Japanese-Americans. The petition was not challenged by the Registrant and the registration was canceled April 22, 1981.

doubt in favor of the applicant.²³⁷ At that point, the examining attorney would publish the mark for opposition. Under the current law, during the opposition phase any party that believes it will be injured by registration of the mark may oppose registration of the same.²³⁸ Furthermore, should an injured party miss the deadline for filing an opposition, that party will have a second bite at the apple once the mark is registered. Similar to filing an opposition before registration, a party may file a petition to cancel the registration within five years of the date of registration.²³⁹

Currently, anyone that believes a mark is disparaging may oppose registration of a mark, or petition to have a registration canceled.²⁴⁰ I propose, however, when it comes to disparaging terms that these petitions should not be brought unless the petitioner can show that “a substantial composite of the referenced group” also deems the mark to be disparaging.²⁴¹ By adding this extra layer, it prevents petitions brought on the subjective views of one individual, while protecting the collective views of the targeted group. Again, such an approach is not completely new to the process of determining the registrability of a mark under the current law. One, petitions may be brought by more than one party. Two, surveys of the targeted group and/or community can be used as evidence of how the term is used or perceived by or against the referenced group. Third, this approach is directly in line with the second prong of the disparagement test which requires that a “substantial” part of the referenced group must find the mark to be disparaging.²⁴² This process can be streamlined by requiring a petitioner to conduct a survey of the referenced group and/or collecting signatures from the referenced group before filing.²⁴³

²³⁷ See, e.g., *In re Prosynthesis Laboratories, Inc.*, No. 77902555, 2012 WL 1267929 at *18 (T.T.A.B. 2012) (overturning an examiner’s refusal to register CHINA FREE and Design, and finding that there was not enough evidence to support a claim of disparagement).

²³⁸ See *id.* at *16 (expressing its uneasiness about approving the mark for registration, but acknowledging “that if a group does find the mark to be scandalous or disparaging, an opposition proceeding can be brought. . .”).

²³⁹ 15 U.S.C. § 1064 (2012).

²⁴⁰ See *id.* at § 1063 (allowing “any person who believes that he would be damaged by registration of a mark” to file an opposition objecting to registration of the mark); § 1064 (allowing for the cancellation of a registration by “any person who believes that he is or will be damaged . . . by registration of a mark . . .”).

²⁴¹ *In re Lebanese*, 94 USPQ2d 1215, 1217 (BNA) (T.T.A.B. 2010).

²⁴² *Id.*

²⁴³ It is my belief that adding this requirement is not overly burdensome on a party that wishes to institute an opposition or cancellation proceeding. Given the ability to rapidly disseminate information on-line, collect electronic signatures (which the Trademark Office accepts when one files other documents), and conduct

Additionally, such a process would include the added benefit of avoiding unnecessary filings when (1) a survey, or the inability to collect the necessary number of signatures, reveals that the group does not find the mark disparaging, thus preventing the filing; and (2) if one party has already gathered the required evidence, then subsequent parties would not need to file a petition.

C. Third Proposal: Amend the Current Act and/or Adopt Guidelines that Clarify the Process and Make Application of the Test Less Subjective

Two recent TTAB decisions further illustrate the problem of deciding which terms are disparaging, and the factors used to judge whether or not a term is disparaging.²⁴⁴ The cases both involve terms directed at members of the Asian community, and each considers whether those terms are disparaging.²⁴⁵ Remarkably, however, while both boards seem to come to the conclusion that each mark is most likely disparaging, one board approves registration and other denies registration.²⁴⁶ For this reason, these decisions can be used to help clarify how the disparaging test should be applied.

The first decision stemmed from an applicant's attempt to register the mark CHINA FREE and Design (CHINA FREE) for use in connection with "vitamin and mineral supplements."²⁴⁷ The applicant, Prosynthesis Laboratories, Inc., touted on its website that its goods are free of ingredients that originate from China, and expressed concern about the wholesomeness of such products that contain such China-derived ingredients.²⁴⁸ The examining attorney used this evidence to prove that the mark was disparaging of China and/or people from China, and therefore refused registration of the mark.²⁴⁹ On appeal to

online surveys, the party could collect this information in a timely and cost-effective manner. Additionally, concerns about the ability to collect this within the required timeframe also should not be problematic. For example, once a mark is published for opposition, an injured party has thirty days to file a notice of opposition or request an extension. The extension request should be granted in order to give a party time to collect the required information.

²⁴⁴ See generally *In re Simon Shiao Tam*, No. 85472044, 2013 WL 5498164 (T.T.A.B. 2013); *In re Prosynthesis Lab., Inc.*, No. 77902555, 2012 WL 1267929 (T.T.A.B. 2012).

²⁴⁵ *In re Simon Shiao Tam*, No. 85472044, 2013 WL 5498164 (T.T.A.B. 2013); *In re Prosynthesis Lab., Inc.*, No. 77902555, 2012 WL 1267929 (T.T.A.B. 2012).

²⁴⁶ Under the current law, I believe both of these decisions are accurate and can be reconciled given the facts presented in each case.

²⁴⁷ *In re Prosynthesis Lab., Inc.*, at 1.

²⁴⁸ *Id.* at •1–4.

²⁴⁹ *Id.* at •6.

the TTAB, the Board overruled the decision of the examining attorney to deny registration of CHINA FREE.²⁵⁰ The Board gave several reasons for why this mark is registrable, and seemingly opened the door for registration of similar marks that may be deemed disparaging yet still registrable.²⁵¹

The second and more recent decision involved an Asian rock band that performs under the name “The Slants.”²⁵² A member of the group attempted to register THE SLANTS in connection with “entertainment in the nature of live performances by a musical band.”²⁵³ Registration of the mark was refused by the examining attorney due to THE SLANTS being a “highly disparaging reference to people of Asian descent.”²⁵⁴ The Board agreed.²⁵⁵ Similar to the CHINA FREE decision, the Board relied heavily on statements made on the applicant’s website and other promotional materials that revealed that the applicant picked the mark because it “derived from an ethnic slur for Asians.”²⁵⁶

In sum, the Trademark Act prevents the registration of disparaging marks. Under the test set in *In re Squaw Valley*, some guidelines are given for resolving the disparaging nature of the mark in question: (1) what is the likely meaning of the matter in question; and (2) whether the meaning would disparage a “substantial composite” of the referenced group.²⁵⁷ To some extent, objective factors are listed in the test. Still, The Board and other courts have been left to set its own definition of what a disparaging mark is and have used other objective (and sometimes subjective) factors for determining if a mark is

²⁵⁰ *Id.* at •45.

²⁵¹ The Board seemed to be troubled by the applicant’s statement, though said that the statements could be read to have a non-disparaging meaning as well.

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Ultimately, it appears from the decision that the Board begrudgingly allowed registration of the mark due to a lack of evidence that conclusively supported a disparaging use in the context of the goods provided by the applicant.

²⁵² Anandashankar Mazumdar, *Asian-American Rock Band's Attempt To Register 'The Slants' Rejected Under §2(a)*, BLOOMBERG BNA (Oct. 2, 2013), <http://www.bna.com/asianamerican-rock-bands-n17179877489/>.

²⁵³ MAZUMDAR, *supra* note 223, at 1; *see also* U.S. Trademark Serial No. 85/472,044 filed on November 14, 2011 (claiming a date of first use of November 15, 2006).

²⁵⁴ MAZUMDAR, *supra* note 223, at 2.

²⁵⁵ *Id.*

²⁵⁶ *Id.* (citing the band’s Wikipedia entry and Myspace page, which included an image of an Asian woman next to THE SLANTS mark).

²⁵⁷ *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d (BNA) 1264, 1267 (T.T.A.B. 2006).

disparaging.²⁵⁸ Further, none of the decisions include a comprehensive list or rank the order of importance of these factors.²⁵⁹ Under my third proposal, I argue that the factors listed below must be used in order to avoid decisions based on subjective beliefs. To be clear, a finder of fact should consider all of these factors before making a final determination.

*1. What is the likely meaning of the mark?*²⁶⁰

In order to determine if a mark is disparaging, one must consider the meaning of the mark. Disparaging marks may either be “per se disparaging” or disparaging as used with the goods or services. Under *In re Tam*, the Board bifurcated this first category, and listed three categories for disparaging marks:

Depending on the facts of the case, a proposed mark may be: (1) an innocuous term that in the context of the goods or services is disparaging . . . (2) a disparaging term that may have a non-disparaging meaning in a specific context . . . or (3) a disparaging term that has no non-disparaging meanings in any context, and remains disparaging despite the applicant’s goods or services, actual use or intent.²⁶¹

The *Tam* Board seems to suggest that only under the second category would it be possible to otherwise register a *per se* disparaging mark.²⁶² Therefore, in order to determine if a proposed mark falls into the other two categories (and therefore would be unregistrable), the following items should be considered:

²⁵⁸ See *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215, 1217 (T.T.A.B. 2010). The test was recently affirmed in *In re Tam*, 108 U.S.P.Q.2d 1305 (T.T.A.B. 2013).

²⁵⁹ *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d (BNA) 1264, 1267 (T.T.A.B. 2006); See *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215, 1217 (T.T.A.B. 2010); *In re Tam*, 108 U.S.P.Q.2d 1305 (T.T.A.B. 2013).

²⁶⁰ This question comes directly from the test set in *In re Squaw Valley*, 80 U.S.P.Q.2d at 1267.

²⁶¹ See *In re Tam*, 108 U.S.P.Q.2d at 1310. I disagree with the approach that only marks that have a non-disparaging meaning can be registered under the current test. For example, in the last category, a mark that may have started out as a disparaging term could be re-appropriated by a significant portion of the protected class and used in a non-disparaging manner. Therefore, the intent of the applicant and how the mark is used in connection with the claimed goods or services must be considered. See generally *McDermott v. San Francisco Women’s Motorcycle Contingent*, 81 U.S.P.Q.2d 1212 (T.T.A.B. 2006).

²⁶² *In re Tam*, 108 U.S.P.Q.2d at 1310.

- (a) The definition of the mark in standard dictionaries;²⁶³
- (b) The relationship of the matter to the other elements in the mark;²⁶⁴
- (c) The nature of the goods or services used in connection with the mark;
- (d) The manner in which the mark is used in the market place;²⁶⁵
- (e) The meaning of the term to the general public;²⁶⁶
- (f) The meaning of the foreign equivalent of the word;²⁶⁷

²⁶³ If there are other recognized definitions, showing that the term may have an innocuous meaning, then the mark should be approved for registration. *See In re Heeb Media LLC*, 89 U.S.P.Q.2d 1071, 1074 (T.T.A.B. 20008).

²⁶⁴ Marks that “comprise of” disparaging matter, may actually have a nondisparaging meaning when considered in the context of the whole mark. An

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examining attorney should not dissect a mark, but consider the meaning of the composite mark as a whole. *In re Am. Fertility Soc’y*, 188 F.3d 1341, 51 U.S.P.Q.2d 1832, 1837 (Fed. Cir. 1999).

²⁶⁵ *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 1217 (T.T.A.B. 2010); TMEP § 1203.03(b)(i).

²⁶⁶ The second part of the test focuses on the meaning of the term to the referenced group, and consideration of the general public’s perceptions has been rejected. *See In re Hines*, 31 U.S.P.Q.2d 1685, 1688 (T.T.A.B. 1994) (“[T]he perceptions of the general public are irrelevant. . . . [and] only the perceptions of those referred to, identified or implicated in some recognizable manner by the involved mark are relevant.”). I propose, however, that the meaning of the term to the general public can also provide some value and should be considered as evidence of the terms use in a non-pejorative manner. Therefore, if evidence exists that the term has been used in a non-pejorative way, the mark should be approved for registration.

²⁶⁷ The foreign equivalent doctrine has been applied to reject foreign terms that, when translated into English, are either descriptive or generic of the goods or services, or likely to cause confusion with existing marks. *See* TMEP, Foreign Equivalents, § 1209.03(g) (2013). The doctrine, however, does not seem to be applied when determining if a mark is disparaging under the English language. In contrast, it seems that the foreign meaning of the word is taken into account. Such an approach shows a nonpejorative meaning, and therefore should be viewed similarly to a dictionary definition. Any other approach leads to the bizarre result that foreign companies could register terms that are not disparaging in their country, but an American applicant would be barred because the term is disparaging in the U.S. *See, e.g.*, Reg. Nos. 0,759,908, 0,759,957, 0,759,980. (advancing FAG for industrial manufacturing products, which were registered, without challenge, by a German company based on existing foreign registrations in its home country. Also consider, PHAG, which was registered after an applicant successfully overcame a disparaging rejection by submitting as evidence, among other things, proof that

- (g) The likely meaning of the mark *at the time of use/filing*;²⁶⁸
 (h) The existence of third party registrations;²⁶⁹
 (i) Consideration for acronyms;²⁷⁰

“fag” is also a slang term in Europe for “cigarettes” and FAG BAG and Design for cigarettes and cigarette holders, Reg. No. 1,121,874, registered July 10, 1979 (now expired) (applicant disclaimed use of the term “fag bag,” most likely because it was deemed descriptive of the goods under the foreign equivalent doctrine).

²⁶⁸ See Pro-Football, Inc., v. Harjo, 284 F. Supp. 2d 96, 125, 68 U.S.P.Q.2d 1227, 1248 (D.D.C. 2003). *But see In re Tam*, 108 U.S.P.Q.2d at 1309 (“Whether a proposed mark is disparaging must be determined from the standpoint of a substantial composite of a referenced group. . . *in the context of contemporary*

continued . . .

attitudes.”) (emphasis added). I believe this approach is flawed and can lead to inequitable, retroactive cancellation of marks or the denial of current applications. For example, “colored” or “negro” were terms used to refer to African-Americans. At the time the terms were adopted, the use of those terms was not considered disparaging. In fact, prominent African-American organizations like the National Association of the Advancement of Colored People and the United Negro College Fund, incorporated a term in its trade name and sought registration of acronyms reflecting this usage. See UNCF, Reg. No. 4,163,579, registered June 26, 2012; and NAACP, Reg. No. 1,188, 182, registered January 26, 1982. However, the use of search terms today to reference African-Americans in general may be deemed disparaging in nature. Still, others have continued to successfully register marks incorporating these terms despite “contemporary attitudes.” See, e.g., UPPITY NEGRO, Serial No. 86/053,392 (the examining attorney sent a request to the applicant to make minor amendments as recently as December 20, 2013); BAKED BY A NEGRO, Reg. No. 4,424,120, registered October 29, 2013; COLORED PEOPLE and Design, Reg. No. 3,843,574, registered September 7, 2010.

²⁶⁹ While it is true that third party registrations provide “little value” and each application must stand on its own, the existence of third party registrations does provide some value. The fact that other registrations exist that consist or comprise the so-called disparaging term, at the very least, proves that others do not deem the term to be disparaging. With that in mind, doubt as to the meaning the mark should be resolved in favor of the applicant.

²⁷⁰ Acronyms should not be deemed disparaging unless the meaning of the acronym is disparaging. A similar approach is taken with descriptive marks, which are unable to be registered without showing secondary meaning or non-descriptive use. Under a descriptive-acronym analysis, if an acronym does not have a descriptive meaning, then the mark should be approved for registration. See, e.g., *Baroness Small Estates, Inc. v. Am. Wine Trade, Inc.*, 104 U.S.P.Q.2d (BNA) 1224, 1230–31 (T.T.A.B. 2012) (holding that CMS was not synonymous with “cabernet, merlot, and syrah” and therefore not descriptive for wine). A similar approach could be taken with disparaging marks. For instance, while the Trademark Office has rejected registrations for “fag,” one applicant was able to successfully register F•A•G – FABULOUS AND GAY for bath products, Reg. No. 2,997,761, registered September 20, 2005; compare with FAG for political and social commentary periodicals, Serial No. 78/164,481, filed on September 16, 2002 (refused by examining attorney as being “a derogatory term for homosexual men and homosexual woman.”). A similar approach could have been taken when an

(j) The intent of applicant should be considered, resolving matters in favor of the applicant that does not seek to do harm to others;²⁷¹

(k) Whether the applicant is a member of the “referenced group;”²⁴³

2. *What is a “substantial composite” of the referenced group?*

Under the second part of the test, a mark should only be denied registration if the term would be deemed to be disparaging “to a substantial composite of the referenced group.”²⁷² The TTAB and Courts have avoided setting a firm figure as to what would equal a

applicant attempted to register NIGGA for clothing. This acronym was developed by the late rapper Tupac “2Pac” Shakur, who defined the acronym as “never ignorant, getting goals accomplished.” See the “Strictly for my N.I.G.G.A.Z.” album (released in 1993) and the “Loyal to the Game” album (released posthumously in 2004). Shakur sought to redefine the term “nigger,” by using “nigga” to mean something positive to African-Americans. The word is still in widespread use (possibly to the chagrin of the older generation) and has been adopted as a term of endearment. See MARYANNE D. BROWN CAMPBELL, *FOOD FOR THE SOUL* 353 (AuthorHouse 2008); see also Kash Azrael, *The N Word*, CALL & POST (Aug. 9, 2013), www.callandpost.com/news/2013/aug/09/n-word/.

²⁷¹ Both the *Tam* and *Prosynthesis* Boards reject the notion that the applicant’s purpose for using the mark should matter. *In re Tam* 108 U.S.P.Q.2d (BNA) at 1312; *In re Prosynthesis Laboratories, Inc.*, No. 7790255, 2012 WL 1267929, at *3–4 (T.T.A.B. 2012). However, each Board does consider the applicant’s intent, but only when it is clear that the applicant is using a mark in a disparaging matter. If a finder of fact can use the applicant’s own statements to prove a disparaging use, then intent to use the mark in a non-disparaging manner should also be considered when weighing other factors for or against registration. It seems inequitable to claim that intent does not matter, but use the applicant’s intent against him/her when finding the mark is disparaging. *But see In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 1222 (T.T.A.B. 2010); *In re Heeb Media, LLC*, 89 U.S.P.Q.2d (BNA) 1071, 1077 (T.T.A.B. 2008); *In re Tam* 108 U.S.P.Q.2d at 1312 (rejecting consideration of applicant’s intent, even when adopted in good faith, not to disparage, or to “reclaim the term,” respectively).

²⁴³ In line with the prior point, an applicant that is a member of the referenced group is most likely not adopting the term in order to harm others. Additionally, such a factor could be used to show that the term has been reappropriated by the protected group and is no longer seen as being disparaging. See, e.g., *Michael J. McDermott v. San Francisco Women’s Motorcycle Contingent*, Opp. No. 91169211, 12-13 (T.T.A.B. 2006) (citable as precedent) (illustrating that “dyke” was not seen as a disparaging term and that members of the gay community had adopted the moniker in order to change to negative impact once associated with the word).

²⁷² *In re Lebanese*, 94 U.S.P.Q.2d at 1217.

“substantial composite.”²⁷³ Even further, how to confirm that a substantial composite of the referenced group would be offended by use of the term is also not clear. Such determinations seemed to be based more on gut reactions and selected evidence rather than objective evidence. So what is a “substantial composite” of the reference group if a majority is not required, what proof should be submitted in order to prove this standard, and who really should make up the group?

To the first point, I believe that at the very least some guidance should be given as to what should be the “magical” number. Perhaps Wisconsin’s standard of “10% of the school district community” is too small, but at least it gives us a starting point.²⁷⁴ I would propose, however, to set the number to at least 33% of the referenced group. It is not a majority, but the number seems to reflect the minimum requirement for having a “substantial” amount of a group.

With that in mind, who should make up the group? One interesting point inferred in the *Tam* case is this issue of whether the referenced group includes all members that could identify with the “referenced group” or only the targeted group (i.e., consumers). As stated by the Board in *Tam*:

[W]e are charged with taking into account the views of the entire referenced group *who may encounter applicant’s [services]* in any ordinary course of trade for the identified services. Thus, all members of the Asian-American public may encounter the mark THE SLANTS in *advertising* in newspapers, billboards or on a website. (emphasis added).²⁷⁵

This statement seems to suggest that it is not the entire referenced group that should concern the finder of fact, but only those that would encounter the mark. Therefore, consider a band like The Slants and how it would advertise its services. The Board specifically references “newspapers, billboards, or websites,” however, fails to prove that the band advertises in any of these ways, except for the website.²⁷⁶ Still, the Board states that “all members of Asian-American public” would encounter this mark because of the band’s use of these mediums to

²⁷³ *In re Tam*, at 9 (citing to Squaw Valley, 80 U.S.P.Q.2d at 1269) (determining that a “substantial composite” does not mean that a majority of the referenced group must find the term disparaging).

²⁷⁴ See 2013 Wisconsin Act 115 (allowing for any adult in the school district to sign a petition to have an offending name removed, and not just members of the targeted group).

²⁷⁵ *In re Tam*, at 16.

²⁷⁶ *Id.*

advertise its services.²⁷⁷ This is simply not in the record.²⁷⁸ For this reason, it is not “all members of the Asian-American public,” but only its consumers (i.e. fans that would visit the band’s website).

With that said, I am inclined to believe that perhaps a “substantial composite” should include all members of the referenced group and not just the targeted consumers. Still, such a consideration gives me pause when I consider the changing beliefs and views of those that are growing up in a “post-racial” world. The current standard of including “all members” fails to recognize that there is a split in beliefs about the negative nature of certain terms.²⁷⁹ Again, considering the *Tam* decision, a substantial composite of a younger generation of Asian-Americans may not deem “slant” to be a disparaging term, feel the same sting of the term if it is used against them, or are otherwise open to reappropriating the term. On the other hand, a substantial composite of the older generation may want the term completely wiped out. In such cases, perhaps those splits should be decided in favor of the applicant. Certainly, any doubt as to who makes up the group, or whether a substantial amount of the group finds the term disparaging, should be resolved in favor of the applicant.²⁵²

Finally, what proof should be submitted in order to establish that a substantial composite of the referenced group finds the term disparaging? Such determinations should not be based on gut reaction, a few newspaper clippings, or perceptions.²⁵³ Objective evidence should be required in these cases. For example, the applicant

²⁷⁷ *Id.*

²⁷⁸ *See, e.g., id.* at 5 (citing online articles submitted by the examining attorney in order to prove the Asian-American community’s concern about the band’s name, but not as forms of advertisement).

²⁷⁹ This debate is best illustrated by the longstanding and ongoing debate in the African-American community over the use of the word “nigga.” “Nigger” is seen by all as being a disparaging term, but to many younger generations “nigga” is a positive term. In fact, “nigga” is frequently used in the African-American community by younger groups, and can be heard in numerous rap songs. I would imagine that a survey of the African-American community would reveal stark differences in the number of “all African-Americans” that find the word “nigga” offensive and those that are most likely subjected to the term on a daily basis (i.e., fans of urban music and culture). Leora F. Eisenstadt, *The N-Word at Work: Contextualizing Language in the Workplace*, 33 BERKELEY J. EMP. & LAB. L. 299, 312–13 (2012).

²⁵² *In re Tam*, 108 U.S.P.Q.2d at 1309 (the USPTO has the burden of proving a mark is disparaging). Any doubts in proving a mark is disparaging should be resolved in favor of the applicant. *In re Lebanese*, 94 U.S.P.Q.2d at 1221.

²⁵³ *See id.* at 1310 (citing *In re Heeb Media*, 89 U.S.P.Q.2d 1071 (T.T.A.B. 2008), for the proposition that “mixed opinion among members of the referenced group does not erase the *perception* of a substantial composite who finds it disparaging.”) (emphasis added).

could be required (during the examination phase) to either submit evidence of a survey conducted of the referenced group's opinion about the disparaging nature of the term or provide a list of a certain amount signatures from members of the referenced group that would not object to registration of the mark. Such a task may seem burdensome; however, given the number of free online resources for conducting such surveys and collecting signatures, an applicant should be able to easily gather this evidence.²⁵⁴ Such an approach is far more favorable and reliable than depending on what can be located through a simple internet search.²⁵⁵

IV. CONCLUSION

Serious consideration must be given with respect to the continued prohibition of disparaging trademarks on the federal trademark registry. The law has been applied too subjectively, and has resulted in a patchwork of standards for approving or rejecting these marks. Furthermore, the main goal should be to prevent groups from being subjected to certain terms. However, the refusal to register disparaging marks does nothing to stop the use of the mark. Other measures exist that are more effective in preventing the use of truly offensive marks. Therefore, without solid evidence to prove that a term is disparaging, the USPTO should allow registration of these types of marks. Under the current law, parties that believe they will be harmed by the registration of the mark could challenge its validity under an opposition or cancellation proceeding. Additionally,

²⁵⁴ For example, SoGoSurvey.com offers survey services for as low as \$144/year of \$19/month with the ability to create unlimited surveys, questions, and

continued . . .

responses. SOGOSURVEY, www.sogosurvey.com (last visited Sept. 1, 2014). Also, websites like MoveOn.org and PetitionOnline.com allow users to create petitions and collect signatures. MOVEON.ORG, <http://front.moveon.org> (last visited Sept. 1, 2014); PETITIONONLINE.COM, <http://www.petitiononline.com> (last visited Sept. 1, 2014). Additionally, in order to facilitate such a collection, the USPTO could offer such a service through its website (it is, after all, the USPTO that has the burden of proving that a term is disparaging).

²⁵⁵ In *Tam*, the Board cited the examining attorney's evidence that certain Asian-American groups that had initially hired the band to perform and/or speak at its conference later pulled the group/speaker from the line-up out of concern over attendees objecting to the use of the band's name. *See In re Tam*, 108 U.S.P.Q.2d at 1307-08. Such evidence shows that some may object to the use of THE SLANTS, but it does not prove that a substantial composite would find the term disparaging. After all, the leaders of these Asian-American organizations did hire them to perform/speak, and it was only after some objected to them being on the line-up that they were pulled.

publically ostracizing the user of such a mark could work to end its use (even if validly registered).