

THE SCARLET LETTER OF TRADEMARK LAW: THE BAR TO REGISTRATION OF IMMORAL AND SCANDALOUS TRADEMARKS

“On a field, sable, the letter A, gules.”¹

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The Lanham Trademark Act bars federal registration of immoral or scandalous matter as a trademark. The term “scandalous” has been considered to encompass matter that is “vulgar,” defined as “lacking in taste, indelicate, morally crude” as measured by contemporary public attitudes. Although few applications for registration are rejected these days for this reason, a court in a recent case upheld the U.S. Trademark Office’s refusal to register “1-800-JACK-OFF” and “JACK-OFF” as trademarks for adult-oriented entertainment and telephone services. The case raises issues of how the courts may regulate commercial speech and what standards should apply in determining what constitutes a crude, immoral, or vulgar trademark. In our paper, we examine these issues and consider whether such a bar to registration is merely a quaint leftover in the Lanham Act from a bygone era.

I. INTRODUCTION

Almost anything that meets the statutory requirements set out in the Lanham Trademark Act² can be federally registered as a trademark.³ Nevertheless, there are a few limitations as to what subject matter can be registered, including a bar to registration of “immoral” or “scandalous” matter as a trademark. This bar has been applied to sexually oriented and socially distasteful marks, but not surprisingly, the borderline between registrable and unregistrable marks has shifted as social mores and conditions have changed over the years.⁴ Indeed, what might currently be considered crude or offensive may someday be regarded as amusing or socially acceptable.

In a recent case, for example, The Boulevard Entertainment, Inc. (Boulevard) sought to register “1-800-JACK-OFF” and “JACK-OFF” as federal trademarks for adult-oriented entertainment and telephone services. The trademark examiner had refused to

¹ NATHANIEL HAWTHORNE, THE SCARLET LETTER (1850).

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² 15 U.S.C. §§ 1051-1127. In addition, the Lanham Act prohibits infringement and dilution of trademarks. *Id.* § 1125.

³ *See infra* notes 5-9 and accompanying text.

⁴ Examples of trademarks that have been subject to litigation or possible rejection on the grounds that they are eligible or ineligible for registration based on the “immoral or scandalous” standard are found in the Appendix to this article. *See infra* Appendix.

register the marks on the grounds that they were immoral or scandalous, and the Trademark Trial and Appeal Board (“TTAB”) of the U.S. Patent and Trademark Office (“USPTO”) affirmed the refusal to register on the ground that the marks consist of or comprise scandalous matter. On appeal, the Federal Circuit Court of Appeals affirmed because substantial evidence supported the TTAB’s finding that the term “jack-off” was an offensive and vulgar reference to masturbation and because The Boulevard’s use of the marks referred to that meaning.⁵

The courts have held that the First Amendment does not guarantee a right to register an immoral or scandalous trademark, even though the subject matter of the mark is not considered to be “obscene.” Currently, the term “scandalous” has been considered by the courts to encompass matter that is “vulgar” or “lacking in taste, indelicate, morally crude” as measured by contemporary public attitudes.⁶ Whether the obscenity standard as applied to speech would be a better measure for deciding if a mark is immoral or scandalous is one question raised by cases such as *Boulevard*. Perhaps a more fundamental question is whether at this point in time it makes any sense to regulate trademarks on the grounds of indecency or immorality. An alternative to doing this would be to allow consumers to decide whether a trademark is so vulgar or unappealing that they choose to avoid purchasing the product or services represented by that brand. Thus, the marketplace will weed out trademarks that consumers find offensive.

In this paper, we begin with a brief overview of trademark law and the registration process. Next, we examine the current standard for adjudging a mark to be immoral or scandalous. We then turn to a review of the Federal Circuit’s decision in the *Boulevard* case. Finally, we assess whether the obscenity standard might offer a better alternative and consider whether such a bar to registration is merely a quaint leftover in the Lanham Act from a bygone era that should be discarded.

II. THE PURPOSE OF TRADEMARKS AND THE “IMMORAL OR SCANDALOUS” BAR TO FEDERAL REGISTRATION

Trademarks may be protected under common law as well as federal law. The Lanham Trademark Act provides for federal registration of trademarks used in interstate commerce.⁷ A trademark is defined as “any word, name, symbol, or device, or any combination thereof ... used ... to identify and distinguish ... goods ... from those manufactured or sold by others and to indicate the source of the goods.”⁸ Although trademarks serve as indicators of source, they also simplify consumers’ purchasing decisions by providing visual cues that assist in brand recognition and that connote product performance attributes.⁹ As such, trademarks lower the costs of consumer searching by providing a reliable signal of product quality in comparison with competing

⁵ See *In re The Boulevard Entertainment, Inc.*, 334 F.3d 1336 (Fed. Cir. 2003).

⁶ See *In re Runsdorf*, 171 U.S.P.Q. 443, 444 (TTAB 1971).

⁷ *Id.* §§ 1051-1127.

⁸ 15 U.S.C. § 1127.

⁹ See Itamar Simonson, *Trademark Infringement from the Buyer Perspective: Conceptual Analysis and Measured Implications*, 13 J. PUB. POL’Y & MARKETING 181 (1994).

products.¹⁰ In addition, trademarks can also signify sponsorship or authorization by the trademark owner.¹¹ So long as a trademark is inherently distinctive, or has acquired distinctiveness through secondary meaning, it may be registered.¹² Thus, the more distinctive the mark, the greater the likelihood it can be protected.

Not all distinctive trademarks may be registered. Section 1052(a) of the Lanham Act serves as an absolute bar to federal registration of immoral or scandalous matter as a trademark: “No trademark ... may be refused registration ... unless it ... [c]onsists of or comprises immoral ... or scandalous matter.”¹³ The term “scandalous” is to be interpreted by looking to “its ordinary and common meaning,”¹⁴ as found in court decisions, TTAB decisions, and dictionary definitions.¹⁵ In addition, the term “scandalous” has been considered to encompass matter that is “vulgar,” defined as “lacking in taste, indelicate, morally crude.”¹⁶ In the case of *In re McGinley*,¹⁷ for instance, the court found that a mark for a social club comprising “a photograph of a nude man and woman kissing and embracing in a manner appearing to expose the male genitalia” was scandalous within the ordinary and common meaning of the term scandalous.¹⁸

A number of marks have been barred from federal registration based on this definition of scandalous.¹⁹ Procedurally, there are three points during the registration process at which the registration of a mark can be challenged on the ground that the mark is immoral or scandalous. First, the trademark examiner can refuse the registration of the

¹⁰ For an economic analysis of trademark protection, see William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J. L. & ECON. 265 (1987).

¹¹ See 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3:4 (4th ed. 2001).

¹² See 2 McCarthy, *supra* note 10, § 11:2-28; see also Restatement (Third) of Unfair Competition §§ 13-17 (1995).

¹³ 15 U.S.C. § 1052(a). “The prohibition against the registration of marks that consist of or comprise immoral or scandalous matter was originally enacted as §5(a) of the Act of 1905, and was reenacted as part of §2(a) of the Act of 1946.” TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1203.01 (3d ed. 2003). Courts have treated the terms “immoral” and “scandalous” as synonymous. See *In re McGinley*, 660 F.2d 481, 484 n.6 (C.C.P.A. 1981) (“Because of our holding ... that appellant’s mark is ‘scandalous,’ it is unnecessary to consider whether appellant’s mark is ‘immoral.’ We note the dearth of reported trademark decisions in which the term ‘immoral’ has been directly applied.”).

¹⁴ *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938).

¹⁵ See *In re McGinley*, 660 F.2d at 486.

¹⁶ See *In re Runsdorf*, 171 U.S.P.Q. 443, 444 (TTAB 1971). See also *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938)(defining “scandalous” as “shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; giving offense to the conscience or moral feelings; . . . [or] calling out [for] condemnation”); *Bromberg v. Carmel Self Servs., Inc.*, 198 U.S.P.Q. (BNA) 176 (T.T.A.B. 1978)(stating that “scandalous” means “that which offends established moral conception or disgraces all who are associated or involved” and “to horrify or shock the moral sense”); *In re Tinseltown, Inc.*, 212 U.S.P.Q. 863, 864 (TTAB 1981)(BULLSHIT, which the Board termed “profane,” held scandalous for “accessories of a personal nature, ... attaché cases, hand bags, purses, belts, and wallets”).

¹⁷ F.2d 481 (C.C.P.A. 1981).

¹⁸ *Id.* at 486 (holding that a mark comprising a photograph of a nude, reclining man and woman, kissing and embracing, for a “newsletter devoted to social and interpersonal relationship topics” and for “social club services” was scandalous and noting dictionary entries that defined “scandalous” as shocking to the sense of propriety, offensive to the conscience or moral feelings, or calling out for condemnation).

¹⁹ See, e.g., *Ex parte Martha Maid Mfg. Co.*, 37 U.S.P.Q. 156 (1938)(QUEEN MARY for women’s underwear); *In re Runsdorf*, 171 U.S.P.Q. 443 (TTAB 1971)(BUBBY TRAP for brassiers); *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938)(MADONNA for wine).

mark during the examination process. Second, once the mark has been published in the Official Gazette, a third party can file an opposition to the registration. Finally, a third party can challenge the registration in a post-registration cancellation proceeding after the mark has been placed on the Principal Register.²⁰

To determine whether a mark is scandalous or immoral, the Federal Circuit Court of Appeals developed a three-pronged test: (1) the mark must be shocking to the sense of truth, decency, or propriety, or call out for condemnation; (2) the mark must be considered in the context of the marketplace as applied to only the goods or services in the application for registration; and (3) the mark must be scandalous to a substantial composite of the general public, as measured from the context of contemporary attitudes.²¹ The determination of whether a mark is scandalous must be made in the context of the relevant marketplace for the goods or services identified in the application, and must be ascertained from the standpoint of not necessarily a majority, but a “substantial composite of the general public”²² and in the context of the current attitudes of the day.²³

Absent any indication of scandalousness as measured by this standard, the mark will not be barred from registration.²⁴ As such, to support a refusal on the ground that a proposed mark is immoral or scandalous, the trademark examiner must provide evidence that a substantial portion of the general public would consider the mark to be scandalous

²⁰ In *Bromberg v. Carmel Self Servs., Inc.*, 198 U.S.P.Q. 176 (TTAB 1978), a competitor successfully opposed registration of the mark ONLY A BREAST IN THE MOUTH IS BETTER THAN A LEG IN THE HAND for restaurant services. For further discussion of trademark proceedings, see 3 JEROME GILSON, TRADEMARK PROTECTION AND PRACTICE § 9.01[2][a] (2002). Note that trademark owners who have been denied federal registration may continue to use the mark at common law without the benefits afforded by registration. See 74 AM. JUR. 2d *Trademarks and Trade Names* § 70 (“the denial of an application for registration of a mark does not, of itself, prevent the continued use thereof by the applicant; it merely deprives him of the benefit of the protection accorded to the registered marks”).

²¹ See *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

²² See *In re Wilcher Corp.*, 40 U.S.P.Q.2d 1929 (TTAB 1996) (mark for restaurant and bar services consisting of words DICK HEADS positioned directly underneath caricature of a human head composed primarily of graphic and readily recognizable representation of male genitalia held scandalous, as it would be considered offensive by a substantial portion of the public); *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d 1635, 1639 (TTAB 1988) (graphic design of a dog defecating, as applied to polo shirts and T-shirts, held scandalous, given the broad potential audience that may view applicant’s mark in sales establishments and “virtually all public places”); *In re Hepperle*, 175 U.S.P.Q. 512 (TTAB 1972) (while the words might be a reference to marijuana, ACAPULCO GOLD found not scandalous when used as a mark for suntan lotion).

²³ See *In re Mavety Media Group Ltd.*, 33 F.3d 1367 (Fed. Cir. 1994) (evidence found insufficient to establish that BLACK TAIL used on adult entertainment magazines containing pictures of African American women comprises scandalous matter; court noted that there were both vulgar and non-vulgar definitions of “tail,” and that the record was devoid of evidence demonstrating which of these definitions a substantial composite of the general public would choose in the context of the relevant marketplace); *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216 (TTAB 1993) (OLD GLORY and design comprising the representation of a condom decorated with stars and stripes in a manner to suggest the American flag held not to be scandalous); *In re Thomas Laboratories, Inc.*, 189 U.S.P.Q. 50, 52 (TTAB 1975) (“[I]t is imperative that fullest consideration be given to the moral values and conduct which contemporary society has deemed to be appropriate and acceptable.”).

²⁴ See, e.g., *Ex parte Parfum L’Orle, Inc.*, 93 U.S.P.Q. 481 (TTAB 1952)(LIBIDO not scandalous for perfume); *In re Bad Frog Brewery, Inc.*, 1999 WL 149819 (TTAB 1999)(BAD FROG and design of frog gesturing with its middle finger not immoral for beer); *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d 1653 (TTAB 1990)(MOONIES not scandalous for novelty dolls that drop their pants when squeezed).

in the context of contemporary attitudes and the relevant marketplace.²⁵ In doing so, the trademark examiner may consider the specimens or other portions of the record to determine how the mark will be viewed in the marketplace.²⁶

III. THE DECISION IN THE BOULEVARD CASE

The *In re The Boulevard Entertainment, Inc.* case, decided by the United States Court of Appeals for the Federal Circuit, stemmed from a decision by the TTAB, which had affirmed a refusal by the examiner to register certain trademarks as requested by Boulevard. The issue presented to the Court on appeal was whether the USPTO could base its refusal to register a mark solely on dictionary definitions which designate the words of the mark as having only one meaning, that one meaning being identified as vulgar. The court held that “in a case in which the evidence shows that the mark has only one pertinent meaning, dictionary evidence alone can be sufficient to satisfy the PTO’s burden”²⁷ in justifying refusal to register the mark.

A. FACTUAL BACKGROUND OF THE CASE

In January of 1998, Boulevard applied to the USPTO for the purpose of registering two trademarks. One mark, “1-800-JACK-OFF” was being used by Boulevard to provide “telephone entertainment services, namely interpersonal telephone services for adults.”²⁸ Boulevard also applied to register “JACK-OFF” since it intended to use that mark for the same type of “adult-oriented conversations by telephone.”²⁹ In June of 1998, the examining attorney refused to register the marks on the ground that the marks contained immoral and scandalous matter.

The conclusion of the examining attorney was based on definitions to the words “jack-off” as contained in four dictionaries.³⁰ The four dictionaries defined the term to mean “masturbate” and all designated the term as “vulgar.”³¹ Although several of the dictionaries provided an alternate definition of the term to mean “a stupid, incompetent person = jerk,” a “worthless jerk” and “a dolt; idiot,” the alternate definitions were also identified as vulgar or “forbidden.”³² The examining attorney also conducted a search for the term “jack-off” in the Lexis/Nexis Research Database. Excerpts that used the term in

²⁵ See *In re Mavety Media*, 33 F.3d at 1371-1372. This evidence could include dictionary definitions, newspaper articles and magazine articles. See TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1203.01 (3d ed. 2003).

²⁶ See *In re McGinley*, 660 F.2d at 482 n.3 (containing excerpts from appellant’s newsletters pertaining to their subject matter); *In re Hershey*, 6 U.S.P.Q.2d 1470, 1472 (TTAB 1988) (considering labels submitted as specimens in determining the question of how the mark BIG PECKER BRAND for T-shirts might be perceived).

²⁷ 334 F. 3d 1336, 1340.

²⁸ *Id.* at 1339.

²⁹ *Id.*

³⁰ The examining attorney consulted WEBSTER’S COLLEGIATE DICTIONARY, FORBIDDEN AMERICAN ENGLISH, AMERICAN SLANG, AND HISTORICAL DICTIONARY OF AMERICAN SLANG. *Id.* at 1339.

³¹ *Id.* at 1339.

³² *Id.*

a relevant manner appeared in, the opinion of the examining attorney, non-mainstream publications thus substantiating her conclusion that the term “jack-off” was offensive to a substantial composite of the general public.³³

Boulevard then appealed the examining attorney’s decision to the TTAB. The TTAB affirmed the refusal to register the marks. The TTAB’s decision was based on several points. First, dictionary definitions indicated the term “jack-off” to be vulgar. Second, Boulevard used the words in a vulgar manner. Third, Boulevard had not submitted sufficient evidence to overcome the prima facie case, established by the examining attorney, that the words were scandalous. The TTAB concluded that the term “jack-off” was offensive to a substantial composite of the general public and was thus ineligible for registration.³⁴ Boulevard then appealed the decision of the TTAB to the United States Court of Appeals for the Federal Circuit, which affirmed.

B. THE FEDERAL CIRCUIT’S RATIONALE

In order to affirm the TTAB’s decision, the court stated that it was required to find substantial evidence in support of the the TTAB’s conclusion that the words “jack-off” comprise “immoral, deceptive, or scandalous matter.”³⁵ In addition, the court recognized that “whether the mark consists of or comprises scandalous matter must be determined from the standpoint of a substantial composite of the general public, (although not necessarily a majority), and in the context of contemporary attitudes”³⁶

Boulevard maintained that the examining attorney acted improperly by relying solely on dictionary definitions and her personal opinion in rejecting the registration application. The court agreed that the personal opinion of the examining attorney could not be used to support a conclusion that the mark was scandalous. However, the court recognized that dictionary definitions are more than an indication of the personal views of the examining attorney or the editors of the dictionary. The court stated that “dictionary definitions represent an effort to distill the collective understanding of the community with respect to language”³⁷

The question before the court was: can dictionary definitions alone provide an adequate basis for concluding that a mark is scandalous when there are no alternative non-scandalous meanings for the term? This particular question had not been answered in previous cases.³⁸ The court held that “in a case in which the evidence shows that the mark has only one pertinent meaning, dictionary evidence alone can be sufficient to satisfy the PTO’s burden.”³⁹ In an effort to convince the court to reverse the decision of the TTAB, Boulevard argued that the word “jack-off” is sometimes used to refer to a stupid or incompetent person. The court pointed out that the dictionaries identified the term “jack-off” as vulgar or “forbidden” either when used to make reference to a person

³³ *Id.*

³⁴ *Id.*

³⁵ *Id.* at 1340 (citing *In re Save Venice N.Y., Inc.*, 259 F.3d 1346 (Fed. Cir. 2001)(weight of the evidence); *In re Mavety Media Group, Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994)(nature of the matter)).

³⁶ *Id.* at 1340 (citing *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981)).

³⁷ *Id.*

³⁸ *Id.*

³⁹ *Id.*

as being stupid or incompetent or when used to refer to masturbation. Most importantly, however, the court stated that in spite of the fact that the word “jack-off” could be used to refer to a stupid or incompetent person (rather than to masturbation), it was clear that Boulevard intended the word to refer only to “masturbation.”⁴⁰

In this particular case multiple dictionaries indicated the word “jack-off” to be vulgar. In addition, Boulevard’s use of the word, in the opinion of the court, was clearly restricted to the vulgar meaning of the word (masturbation). In this instance then, the court held that “the PTO can sustain its burden of showing that the mark comprises or consists of scandalous matter by reference to dictionary definitions alone.”⁴¹

Boulevard raised several other arguments in an effort to convince the court to rule in its favor. Boulevard contended that the dictionaries used by the examining attorney were outdated and thus did not reflect current community standards.⁴² However, Boulevard did not present a later dated authoritative dictionary taking a different view of the meaning or acceptability of the word “jack-off.”⁴³ Boulevard also attempted to establish that the word “jack-off” was no longer considered a vulgar word. Boulevard presented declarations of a number of academics and business persons who stated that the term was not offensive. Boulevard argued that sexually oriented publications accepted advertising using the word “jack-off.” The court indicated that this evidence did not establish whether members of the public at large would no longer consider the word vulgar.⁴⁴

Boulevard also argued that the examining attorney’s discussion of her Lexus/Nexus search of the word “jack-off” was flawed because she did not describe how she conducted the search or indicate whether the references she did discuss were representative. The court indicated that although the examining attorney did not provide a more detailed account of her search, any error on her part was harmless. The failure was harmless for several reasons. First, the examining attorney did not rely on her Lexus/Nexus search as a principal ground for her decision. Second, TTAB did not rely on the Lexus/Nexus search results. Third, Boulevard’s attorneys had sufficient information to replicate the search and failed to do so. Finally, if the Lexus/Nexus evidence is disregarded in its entirety, the dictionary evidence alone was sufficient to support the USPTO’s “burden of showing that the marks are scandalous to a substantial composite of the general public.”⁴⁵

Boulevard further argued that the refusal to register the mark violated the First Amendment. The court indicated that the refusal to register the mark did not “proscribe any conduct or suppress any form of expression because it does not affect the applicant’s right to use the mark in question.”⁴⁶ Moreover, the court stated that Boulevard was free

⁴⁰ *Id.* at 1341.

⁴¹ *Id.*

⁴² *Id.* The dictionaries consulted by the examining attorney had copyrights as early as 1987, 1990, 1993, and 1997.

⁴³ *Id.* Nor did Boulevard present through other evidence that the dictionary categorization of the term “jack-off” no longer reflected commonly held views of vulgarity.

⁴⁴ *Id.* at 1341-42.

⁴⁵ *Id.* at 1342-43.

⁴⁶ *Id.* at 1344 (citing *In re Mavety Media Group, Ltd.* 33 F.3d 1367, 1374 (Fed. Cir. 1994) and *In re McGinley*, 660 F.2d 481, 484 (CCPA 1981) in support of its rejecting the claimed violation of First Amendment rights).

to use the words in its advertisements. According to the court, the USPTO had merely refused to grant the words trademark protection.

A final argument made by Boulevard was that the USPTO violated Boulevard's equal protection rights as embodied in the Due Process Clause of the Fourth Amendment. Boulevard asserted that the USPTO has registered other sexually-oriented marks.⁴⁷ The court indicated that in many of the marks that Boulevard cited, the marks created a double entendre that was not present in Boulevard's marks. In addition, the court stated that even if the USPTO "had previously allowed a mark similar to Boulevard's marks to be registered, that would not give Boulevard an equal protection right to have its mark registered unless the agency acted pursuant to some impermissible or arbitrary standard."⁴⁸ The fact that the USPTO may have registered some marks, either because of administrative error or otherwise, that may be in violation of the governing statutory standard does not mean that the USPTO can not apply the standard in all other cases.⁴⁹

IV. REEVALUATING THE CURRENT APPROACH

A. TRADEMARKS AND SPEECH: DOES OBSCENITY OFFER A BETTER STANDARD?

The First Amendment prohibits Congress from "... abridging the freedom of speech"⁵⁰ However, a distinction has been made by the U.S. Supreme Court between non-commercial and commercial speech.⁵¹ It is clear that the government may not censor non-commercial speech because it is considered offensive, disagreeable, indecent or immoral.⁵² That the government may not accomplish indirectly what it is prohibited from achieving directly appears obvious. To label speech as "commercial" in order to avoid the constitutional protections of the First Amendment is not permissible.⁵³

Although the First Amendment offers less protection to commercial speech than political speech, the U.S. Supreme Court has instructed that governmental actors must satisfy several requirements before suppressing speech that proposes a commercial transaction.⁵⁴ If commercial speech concerns lawful activity and is not misleading, it is

⁴⁷ *Id.* at 1344.

⁴⁸ *Id.* (citing *In re Int'l Flavors & Fragrances*, 183 F.3d 1361, 1368 (Fed. Cir. 1999)).

⁴⁹ *Id.*

⁵⁰ U.S. Const. amend. I.

⁵¹ See *Valentine v. Chrestensen*, 316 U.S. 52, 54 (1942) (Court's first reference to commercial advertising).

⁵² See *FCC v. Pacifica Found.*, 438 U.S. 726, 745 (1978) (plurality opinion) (finding that "the fact that society may find speech offensive is not a sufficient reason for suppressing it"); see also *Texas v. Johnson*, 491 U.S. 397, 414 (1989) ("If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.").

⁵³ See *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 492 (1995) (Stevens, J. concurring) (indicating that a truthful statement "would receive full First Amendment protection in any other context, without some justification tailored to the special character of commercial speech, the Government should not be able to suppress the same truthful speech merely because it happens to appear on the label of a product for sale"); *Linmark Assocs. v. Township of Willingboro*, 431 U.S. 85, 91 (1977) (reaffirming the Court's dissatisfaction with the . . . approach of resolving a class of First Amendment claims simply by categorizing the speech as commercial").

⁵⁴ See *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n of N.Y.*, 447 U.S. 557 (1980).

entitled to First Amendment protection.⁵⁵ The government cannot regulate commercial speech unless its interest is (1) substantial, (2) directly advanced by the regulation, and (3) the regulation is no more extensive than necessary to accomplish its purpose.⁵⁶

Assuming that trademarks warrant First Amendment protection, inquiry with respect to the constitutionality of Section 2(a) in barring registration of certain trademarks on the basis of content would appear to be subject to this three-part test. The Supreme Court has never decided whether devices that merely convey information about a product's source, such as trademarks, warrant First Amendment protection; however, the Second and Sixth Circuits have extended commercial speech protection into this area.⁵⁷

Refusal to register immoral or scandalous matter has been found not to abridge First Amendment freedom of speech, because no conduct is proscribed and no tangible form of expression is suppressed.⁵⁸ Moreover, the term "scandalous" has been held sufficiently precise to satisfy due process requirements under the Fifth Amendment.⁵⁹

In the *Boulevard* case the appellant contended that its First Amendment rights were violated by denying federal trademark protection to its mark. The court denied the First Amendment claim by simply stating that the appellant was free to use the mark and therefore there was no abridgment of freedom of speech. The only adverse consequence to the appellant was that the government had merely denied the request to register the mark. At first glance this would appear to be a conclusion supported by reason. One is free to speak, just not speak using a registered trademark. However, as usual the law is not as simple as it would appear. Once the government begins to distinguish marks that are and are not registrable, decisions are being made regarding speech. Granting registration to some marks and denying it to others deemed to be "scandalous" or "vulgar" raises significant First Amendment issues. These issues do not disappear with the court simply stating that the government is not preventing speech, but rather merely denying trademark protections.

Does the government really have a substantial interest in suppressing "tasteless" commercial speech?⁶⁰ As long as the commercial speech in question is not obscene or does not consist of child pornography there appears to be no legitimate governmental interest to be served in the suppression.⁶¹ Moreover, construing the terms "scandalous"

⁵⁵ *Id.* at 566.

⁵⁶ *Id.* However, in *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 507-08 (1996) (Justice Stevens writing the principal opinion for the Court proposing the application of a higher standard of scrutiny for regulations aimed at commercial speech

⁵⁷ *See In re Bad Frog Brewery, Inc. v. N.Y. State Liquor Auth.*, 134 F.3d 87, 91 (2d Cir. 1998) (classifying a beer label with a frog "giving the finger" and the accompanying slogan "The beer so good...it's bad" as commercial speech); *Sambo's Rest., Inc. v. City of Ann Arbor*, 663 F.2d 686, 694 (6th Cir. 1981) (classifying a restaurant's service mark as commercial speech because it provides consumers with valuable information about the restaurant's quality).

⁵⁸ *See In re McGinley*, 660 F.2d at 484.

⁵⁹ *Id.* at 484-85.

⁶⁰ *See Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 765 (1976) (holding that even "tasteless and excessive commercial speech is not stripped of First Amendment protection).

⁶¹ *See Sambo's of Ohio v. City Council*, 466 F. Supp. 177, 180 (N.D. Ohio 1979) (noting that it "would be selling our birthright for a mess of pottage to hold that because [a mark] is offensive and distasteful even to a majority of the public, a legislative body may forbid its use").

and “immoral” to include only obscenity and child pornography would comply with the first prong of the three-part commercial speech analysis.

The question remains, however, whether replacement of the current “scandalous” standard with an “obscenity” standard is wise. It has been held that the threshold is lower for what can be described as “scandalous” than for what is considered “obscene.”⁶² There is little doubt that marks, which in the past have been refused registration on the basis of their being “scandalous,” would be eligible for registration today using that same standard.⁶³ The “scandalous” standard and its application to specific marks have changed along with the change in society’s morals and sensitivities. What may be deemed as “obscene” is clearly “scandalous.” What may be deemed as “scandalous” may not, however, be “obscene.” Nevertheless, the difference between what is “scandalous” and what is “obscene” is becoming less distinctive. It may be time to replace the “scandalous” standard with an obscenity standard.

What is left in our society that would shock us? Almost nothing. The real question, outside of constitutional and moral considerations, is does it make sense in today’s society for the government, at least in the trademark registration arena, to adhere to a standard that in its application will exclude fewer and fewer marks? Contemporary society is increasingly immune to what, in the past, may have been considered offensive language or pictures. From a moral perspective, this may be a sad commentary on where we are and where we are heading as a society. However, from a more pragmatic viewpoint, this may just be a natural change in the mores of the general public.⁶⁴

B. TRADEMARKS AND MORALITY: SHOULD THE LANHAM ACT CONTINUE TO BAR “IMMORAL AND SCANDALOUS MARKS”?

The immoral or scandalous bar remains the “Scarlet Letter” of federal trademark law. Once branded as immoral or scandalous, the mark is forever shunned from federal registration. While the current standard for finding a mark to be immoral or scandalous is vague and dependent upon shifting public perceptions that a particular mark is shocking or offensive, the alternative of allowing the USPTO to unilaterally determine this without considering public opinion is even more problematic. Such a standard would presume

⁶² See *In re McGinley*, 660 F.2d 481, 485, n.9, where the Court of Customs and Patent Appeals stated that “the threshold for objectionable matter is lower for what can be described as ‘scandalous’ than for ‘obscene,’ . . .”

⁶³ See *In re Rundsordt*, 171 U.S.P.Q. (BNA) 443, 443 (T.T.A.B. 1971), where in dealing with the registrability of the mark “Bubby Trap” for brassieres, the Board relied on the mark’s relationship with a woman’s undergarment and concluded that the proposed use would be “offensive to a segment of the public sense of propriety.” Compare *Rundsordt with Application for Registration*, USPTO Serial No. 78203823 (filed Jan. 16, 2003)(granting registration to trademark INVISIPPLES for adhesive material that performs the function of a brassiere by shaping and covering women’s breasts).

⁶⁴ For a more comprehensive discussion on the issue of the “scandalous” standard and obscenity see, Theodore H. Davis, Jr., *Registration of Scandalous, Immoral and Disparaging Matter Under Section 2(a) of the Lanham Act: Can One Man’s Vulgarity Be Another’s Registered Trademark?*, 54 OHIO ST. L.J. 331 (1993); Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661 (1993); M. Christopher Bolen, et. al., *The Journal of Law and Technology, When Scandal Becomes Vogue: The Registrability of Sexual References in Trademarks and Protection of Trademarks from Tarnishment in Sexual Contexts*, 39 IDEA 435 (1999).

that the USPTO could accurately gauge the views of a substantial segment of the public. At the same time, the question remains as to whether the Lanham Act's prohibition of immoral and scandalous trademarks continues to make sense as a matter of public policy.

Certainly, one rationale for denying federal registration to immoral or scandalous marks is that the government should not officially condone or grant exclusive rights in matter that is considered by the public to be offensive, profane, or decadent.⁶⁵ However, is this type of moral intervention by the government in the marketplace presently necessary or desirable? Trademarks that do not qualify for or have been denied federal registration may still be protected by common law. In that case, the state and federal courts continue to serve as forums for enforcing such marks, irrespective of whether they would be deemed immoral or scandalous under the Lanham Act. In addition, morality plays no role in patent and copyright registration. Pornographic art, literature, and photography are protected by copyright without regard to their moral or aesthetic quality.⁶⁶ Sexual devices and similar subject matter may be patented so long as they meet the statutory requirements for protection.⁶⁷

Furthermore, as we have seen, to support a refusal on the grounds that a proposed mark is immoral or scandalous, the trademark examiner must provide evidence that a substantial portion of the general public would consider the mark to be scandalous in the context of contemporary attitudes and the relevant marketplace. The inherently indistinct nature of this standard will continue to lead merchants who may wish to register marks that carry a questionable meaning or double entendre to self-censor their choice or make contorted arguments that the mark does not really mean what it suggests.

It can be presumed that most merchants will attempt to choose pleasing and appealing trademarks with positive and attractive associations for the understandable reason that such marks are most likely to interest and maintain consumers. When a merchant selects a potentially offensive, vulgar, or shocking word, logo, or slogan to serve as its brand, the most likely explanation is that such a mark will catch the attention of the public in a competitive market and attract the targeted consumers. In some instances, it may simply be a matter of defining a market niche or suggesting to the consumer exactly what he or she can expect from the product.⁶⁸ Arguably, the consumer is capable of making the ultimate determination of whether the mark is so offensive, vulgar, or shocking as to repel him or her from considering a purchase of the product or services offered for sale. A product or service that is sexually-oriented or not widely used may not suffer at all. On the other hand, declining sales and commercial reputation for other products or services would surely follow if enough consumers were repelled by a sexually-oriented or

⁶⁵ See *McGinley*, 660 F.2d at 484 & 486 (“placing the mark on the register would be stamping the government’s imprimatur on the picture [service mark] which would be shocking to the average person” and “Congress intended for scandalous and immoral trademarks to “not occupy the time, services, and use of funds of the federal government”).

⁶⁶ See 1 MELVIN NIMMER, NIMMER ON COPYRIGHT, § 2.17 at 2-194.2 (1991).

⁶⁷ See 1 EDWARD LIPSCOMB III, LIPSCOMB’S WALKER ON PATENTS, § 5:13 at 539 (3d ed. 1984) (“[T]he Patent Office will no longer be concerned with deciding what inventions might or might not be injurious to one’s morals ...”).

⁶⁸ Cf. ROGER E. SCHECHTER & JOHN R. THOMAS, INTELLECTUAL PROPERTY: THE LAW OF COPYRIGHTS, PATENTS AND TRADEMARKS § 27.5 (2000) (“such a mark [may attract] ... consumers who fancy themselves rebels or non-conformists”).

distasteful mark. If so, the merchant is likely to quickly abandon the use of the mark in favor of one that is more alluring or engaging.

V. CONCLUSION

The Lanham Trademark Act bars federal registration of immoral or scandalous matter as a trademark. The term “scandalous” has been considered to encompass matter that is “vulgar,” defined as “lacking in taste, indelicate, morally crude” as measured by contemporary public attitudes. Although few applications for registration are rejected these days for this reason, the court in *Boulevard* upheld the USPTO’s refusal to register “1-800-JACK-OFF” and “JACK-OFF” as trademarks for adult-oriented entertainment and telephone services. The case raised issues of how the courts may regulate commercial speech and what standard should apply in determining what constitutes a crude, immoral, or vulgar trademark. Applying the obscenity standard instead might be better because it is more in line with Constitutional standards of commercial speech. In the end, however, the marketplace may be the best regulator of acceptable trademarks.

APPENDIX

TRADEMARK	PRODUCT OR SERVICE	RULED IMMORAL OR SCANDALOUS?
OLD GLORY	condoms	NO
BUBBY TRAP	brassieres	YES
BAD FROG	beer	NO
BULLSHIT	bags, belts, wallets	YES
DICK HEADS	bar & restaurant	YES
MADONNA	wine	YES
QUEEN MARY	women's underwear	YES
LIBIDO	perfume	NO
BLACK TAIL	African-American adult magazine	NO
BADASS	stringed musical instruments	NO
WEEK-END SEX	adult magazine	NO
LEGEND LENGTHENER	penis enlarger	NO
BIG PECKER	novelty t-shirts	NO
MOONIES	novelty dolls	NO
JACK-OFF	adult entertainment telephone services	YES
ACAPULCO GOLD	suntan lotion	NO
INVISIPPLES	adhesive covering for women's breasts	NO