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Disparaging Trademarks: Who Matters

Jasmine Abdel-khalik

University of Missouri-Kansas City School of Law

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DISPARAGING TRADEMARKS: WHO MATTERS

Jasmine Abdel-khalik*

For more than a century, non-majority groups have protested the use of trademarks comprised of or containing terms referencing the group—albeit for various reasons. Under the 1946 Lanham Act, Congress added a prohibition against registering disparaging trademarks, which could offer protection to non-majority groups targeted by the use of trademarks offensive to members of the group. The prohibition remained relatively unclear, however, and rarely applied in that context until a group of Native Americans petitioned to cancel the Washington NFL team’s trademarks as either scandalous, offensive to the general population, or disparaging, offensive to the referenced group. In clarifying the appropriate test for disparaging, however, the decision makers have overly analogizing the two prohibitions, rendering the disparaging trademark prohibition less effective in protecting non-majority groups from offensive trademarks.

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* Associate Professor of Law, University of Missouri-Kansas City School of Law, J.D., University of Michigan; B.A., Cornell University. The author is honored to participate in “The Highest Tribute: The Michigan Journal of Race & Law at 20” Symposium and greatly appreciates the fantastic comments and support from the symposium participants and the MJRL, especially Professor Martha Jones and the editors of the MJRL. The author also thanks commentator Bruce Boyden and the participants of The First Annual Mosaic Conference: Diverse Voices in IP Scholarship as well as my UMKC colleagues who participated in the UMKC Law Faculty Development Workshop Series. Additional thanks to the UMKC Law Foundation for its research grant, which supported this Article, and the support of my family.

INTRODUCTION

[Speaker 1] I am trying to speak of this matter generally, and the answer is that there is no necessity for it. There is no need for it. **There is no offense** being committed. There being no offense there should not be any such drastic punishment that would tie up not only our business, but a great deal of the business of our country, destroy trade-marks used throughout the civilized world, **cause a loss in the American industries** at the present time, just because of the **supersensitiveness** – and I say it with all respect – the supersensitive conscience of some very high-minded men. . . .

[Speaker 2] I want to call attention to the fact that we . . . feel that it is not for other people to sit in judgment upon our possible supersensitiveness, because we believe we are here representing the conscience of our domination[sic] in the question¹

In 1914, the Quaker Oats Company faced a serious challenge to all of its QUAKER trademarks.² This challenge was not brought in court or before the predecessor to the United States Patent and Trademark Office (USPTO). Instead, the Society of Friends, commonly known as the Quakers, brought its challenge to the legislative branch, first supporting an Indiana state statute and then, finding the state statute ineffective, federal legislation to criminalize the commercial use of any religious society, church, or denomination's name or nickname.³ The Quakers sought these protections because the denomination was humiliated and offended by use of its nickname, and its good character, as a trademark to sell goods, including "Quaker whiskey, Quaker oats, Quaker engines, Quaker lace, and Quaker vegetables of every description, and an almost innumerable list of articles that have been put upon the market bearing the name 'Quaker.'"⁴ Speculating that businesses may adopt QUAKER as a trademark because Quakers have a reputation for being honest, the Quaker representative suggested that consumers might be more likely to trust products marked as

1. *Use of Name of Religious Organizations: Hearings on H.R. 15401 Before the H. Comm. on the Judiciary*, 63rd Cong., 3d Sess. 16 (1914) [hereinafter *Hearings on Use of Religious Org. Names*] (emphasis added). Speaker 1 was Mr. Lynden Evans, representing Quaker Oats Co. Speaker 2 was Mr. S.E. Nicholson, Chairman of the Friends Legislative Board, representing the Society of Friends a/k/a Quakers.

2. *See id.* at 5.

3. *Hearings on Use of Religious Org. Names*, *supra* note 1, at 5, 7, 10, 11.

4. *Id.* at 6 (testimony of Mr. Nicholson, Chairman of the Friends Legislative Board); *see also Prohibition of Use in Commerce of Any Church Name: Hearing on S. 5262 Before a Subcommittee of the S. Comm. on the Judiciary*, 63rd Congress, 3d Sess. 12 (1914) [hereinafter *Hearing on Use of Any Church Name*].

Quaker.⁵ However, the heart of the objection is twofold: not only is commercialization “entirely foreign to the purposes of [its] existence[,]” but also has led non-Quakers to find the religion disreputable.⁶

The first QUAKER trademark for cereal was registered in 1877 (allegedly by Quakers),⁷ but the company itself was founded in its current incarnation in 1901.⁸ By 1914, Quaker Oats had already achieved great success.⁹ Not surprisingly, therefore, Quaker Oats vociferously objected to a bill that would criminalize future use of QUAKER as a trademark, with its representative raising at least three themes: (1) there is no harm; (2) criminalizing trademarks, and stripping companies of existing trademarks, would hurt American businesses; and (3) any complaints are unwarranted and demonstrate excessive “sensitivity.”¹⁰ The Quaker Oats representative also claimed that the bulk of Americans were not offended—suggesting that it is the general public’s opinion that matters rather than people in the referenced group.¹¹ In a contemporaneous news report, Quaker Oats also noted that there are other definitions for “Quaker,”¹² perhaps suggesting that Americans may not even recognize Quaker Oats as related to the religious group. Of course, the figure of man dressed as a Quaker, which appeared on the packaging and advertisements, belies that suggestion.¹³

The QUAKER dispute highlights a dual narrative problem. On the one hand, a smaller group in American society¹⁴ is offended by trademark

5. *Hearings on Use of Any Church Name*, *supra* note 4, at 2-3.

6. *Id.* at 3-4, 12. At this time of American history, asserting that commercialization of religious terms is degrading in some way is not, in point of fact, unique to the Quakers. Starting within a few decades, other religious terms used for trademarks were rejected or cancelled as scandalous. *See infra* note 47. However, the successful objections were not only long ago but were also associated with larger religious denominations. One of the most recent objections, associated with a small religious organization, was rejected.

7. QUAKER OATS, *Quaker History: There’s a Whole Lot of History in Our Whole Grain Oat*, <http://www.quakeroats.com/about-quaker-oats/content/quaker-history.aspx> [hereinafter *Quaker History*]; *Hearings on Use of Any Church Name*, *supra* note 4, at 7.

8. QUAKER OATS, *Quaker FAQs: When was the Quaker Oats Company founded?*, <http://www.quakeroats.com/about-quaker-oats/content/quaker-faq.aspx>; *but see Hearings on Use of Religious Org. Names*, *supra* note 1, at 11-12 (noting that the business has been using QUAKER trademarks for forty years as of 1914).

9. *See Hearings on Use of Religious Org. Names*, *supra* note 1, at 12 (stating that the business was running between \$35 and \$40 million a year).

10. *See id.* at 16.

11. *See, e.g., id.* at 11.

12. *See Quaker Oats Co. Won’t Quit Using ‘Quaker’ as Name*, AKRON BEACON JOURNAL, available at <http://www.ohio.com/news/dec-12-1914-quaker-oats-co-won-t-quit-using-quaker-as-name-1.547697> (republishing a Dec. 12, 1914 article on Dec. 8, 2014).

13. The QUAKER federal trademark registration included the figure of a man at least as far back as 1877, and the 1882 first national magazine advertisement includes a more familiar form of a man dressed as a Quaker. *See Quaker History*, *supra* note 7.

14. The Quaker representative noted that it believes only the Quakers, as a smaller religious group, were subjected to commercialization of its name as of 1914. He suggests that larger

use of a term that refers to that group in some way. On the other, the business trademark owner suggests that any such offensive is trivial, unimportant, or insignificant when weighed against economic interests. Further, the business may suggest that there are, in fact, other meanings that the American public would attach to the mark. In large part, this dispute centers around—who matters? In assessing whether a trademark, appearing in commerce, is offensive, whose feelings, interpretations, and meanings should be validated and who should be ignored?

This dual narrative is in even starker relief today because of the current dispute over the Washington NFL football team's name (hereafter "the Washington team") in various trademarks, originally *Harjo v. Pro Football, Inc.*¹⁵ and subsequently *Blackhorse v. Pro-Football, Inc.*¹⁶ The Washington team's defense of its R__S__s mark is surprisingly parallel to that of Quaker Oats a century ago.¹⁷ The Washington team first argues that the marks do not cause any offense either because they are intended to honor Native Americans, including the team's first coach who claimed he was Native American,¹⁸ or because they now are associated with a single football team's long and proud traditions.¹⁹ Note that this argument incorporates another Quaker Oats argument that almost accuses those that object of some sort of self-aggrandizement or delusions of importance; specifically, because the term has different meanings, the referenced group should not claim that Americans will automatically associate the mark with the group rather than with one of the alternate meanings. Second, the Washington team suggests, albeit more obliquely than Quaker Oats did in 1914, that economics trump any pain caused by hurtful words by arguing that it is absolutely improper and unnecessarily costly to destroy trademark rights on the claimed basis of hurt feelings, especially after decades of

denominations would have protested much earlier and have been accorded protection. *Hearings on Use of Any Church Name*, *supra* note 4, at 3.

15. *Harjo v. Pro Football*, 30 U.S.P.Q.2d (BNA) 1828 (T.T.A.B. 1994).

16. *Blackhorse v. Pro-Football, Inc.*, 2011 TTAB LEXIS 77 (T.T.A.B. Mar. 15, 2011).

17. This Article will focus on trademarks accused of being or found to be offensive to the general population or to specific groups within American society. Many of these offensive words will need to be reproduced in order to be recognized and discussed. However, the Washington team's dispute is of such prominence now that the term does not need to be reproduced to be discussed. As such, I intend to avoid reproducing it in its entirety except as necessary in quotes or in article titles.

18. See Richard Leiby, *The Legend of Lone Star Dietz: Redskins Namesake, Coach – and Possible Imposter?*, WASH. POST (Nov. 6, 2013), available at http://www.washingtonpost.com/lifestyle/style/the-legend-of-lone-star-dietz-redskins-namesake-coach—and-possible-imposter/2013/11/06/a1358a76-466b-11e3-bf0c-cebf37c6f484_story.html.

19. See John Keim, *Dan Snyder Defends 'Redskins,'* ESPN, (Oct. 10, 2013), http://espn.go.com/nfl/story/_/id/9797628/dan-snyder-defends-washington-redskins-name; see also Alison Harding, *Washington Redskins Owner Dan Snyder Defends Team Name in Letter*, CNN (Oct. 10, 2013), <http://www.cnn.com/2013/10/09/us/washington-redskins-name/>.

use.²⁰ And finally, there is the message that anyone from the targeted group who protests is simply overly sensitive, signaling both that their “sensitivities” are unwarranted and also that their feelings should be discounted or found insufficiently important to alter existing trademarks.²¹

In response to Quaker Oats, a Quaker representative argued that protection is needed precisely to avoid situations where the majority can disregard the harm caused to a minority group. Giving power to the protesting voices may be particularly important as recent studies substantiate the harm caused by, for example, the use of racial slurs or stereotypes upon both the targeted population and the perceptions of the general population.²² True, in some situations a majority group member or an entire majority group may be unaware or lack understanding of this harm. But when confronted with that information, what is the response? In the current Washington team situation, the response is to refuse to change the trademarks.

Prior to the challenge raised by several Native American protestors in 1992,²³ there was little useful information as to whether or how the Lanham Act might protect non-majority populations from harm based upon trademarks. Still, they raised two arguments. First, the Washington team marks were scandalous, which prohibits registration of marks offensive to a

20. See, e.g., Peter Keating, *What's in a name?*, ESPN (June 27, 2014), available at http://espn.go.com/nfl/story/_/id/9540075/dan-snyder-refuses-change-washington-redskins-mascot-espn-magazine; see also Alicia Jessop, *Inside the Legal Fight to Change the Washington Redskins' Name*, FORBES (Oct. 15, 2013), available at <http://www.forbes.com/sites/aliciajessop/2013/10/15/a-look-at-the-legal-fight-to-change-the-washington-redskins-name/>; Tim Devaney, *What's in a name? Dumping 'Redskins' could have a major financial impact*, THE WASHINGTON TIMES (Oct. 17, 2013), available at <http://www.washingtontimes.com/news/2013/oct/17/renaming-the-redskins-could-have-a-major-financial/?page=all>; Michelle FlorCruz, *Redskins Name Trademark Canceled: The Whole NFL Could Lose Millions*, INT'L BUS. TIMES (June 18, 2014), available at <http://www.ibtimes.com/redskins-name-trademark-canceled-whole-nfl-could-lose-millions-1605022>. The economics argument was part of the laches argument raised against the first cancellation petition filed against the Washington team's trademarks. See, e.g., *Pro Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 143-44 (D.D.C. 2003). Because of the way that the court construed the laches argument, it only ran from the time an individual reaches his/her majority. See *Pro Football, Inc. v. Harjo*, 415 F.3d 44, 48-49 (D.C. Cir. 2005). Therefore, the laches defense was obviated by a new filing with younger Native American petitioners. See *Blackhorse v. Pro Football, Inc.*, 2014 TTAB LEXIS 231, at *124-32 (T.T.A.B. June 18, 2014).

21. On this point, the Washington football team's most recent argument has been that 90 percent of 1,000 Native Americans polled are not offended by the team name. See Keim, *supra* note 19. Among his proxies, the argument is made more strongly (even while recognizing that some are offended). See, e.g., Sean Gregory, *A Mysterious Defense of the Washington Redskins Name*, TIME (Oct. 11, 2013), available at <http://keepingscore.blogs.time.com/2013/10/11/a-mysterious-defense-of-the-washington-redskins-name/>. And then there are those who make the argument more forcefully, stridently, and offensively. I choose not to air their offensive tirades, but they are easily found on the Internet.

22. See *infra* Part III.B.

23. *Harjo v. Pro Football*, 30 U.S.P.Q.2d (BNA) 1828 (T.T.A.B. 1994).

substantial composite of the general public at the time of registration.²⁴ Possibly, the petitioners believed that the “substantial composite of the general public” requirement could be satisfied by one small group, Native Americans. Although unlikely in modern jurisprudence,²⁵ it occasionally happened in the past. Otherwise, it is unclear why they raised the scandalous objection as it is doubtful that they could prove that a substantial composite of non-Native Americans in relevant time periods were offended by the racial slur against Native Americans. The inability to count on non-Native Americans supporting their scandalous claim is particularly stark given not only our historical treatment of Native Americans, but also because Native Americans comprise such a small percentage of the American population.²⁶ Without support from other people in the general population, Native American voices are not sufficient to succeed in a scandalous prohibition argument.

Second, the petitioners also argued that the marks were disparaging—a registration prohibition that was very unclear in scope at the time but seemed like it might have some power.²⁷ Over the long and tortured course of this dispute, the scope of disparaging has been clarified but in ways that undermine the necessary protection for non-majority groups. This problem may stem from the faulty premise that these two prohibitions are parallel in scope, purpose, and justification. In fact, such parallels diminish the protection afforded non-majority groups when the sensibilities of the majority are not offended. While not easily remedied, it would help to refocus the disparaging prohibition, when applied to claims based on identity or religious issues, on ameliorating harm caused by reinforcing stereotypes and bias.

24. See *id.*

25. Recent decisions affirm that a single market segment is insufficient to constitute the requisite substantial composite of the general population. See, e.g., *In re Brunetti*, 2014 WL 3976439 (T.T.A.B. Aug. 1, 2014).

26. According to the 2010 Census, there are 5.2 million Native Americans (including Alaska Natives) in the United States, which is .9% of the total American population. See Tina Norris, Paula L. Vines, & Elizabeth M. Hoeffel, *The American Indian and Alaskan Native Population: 2010 Census Briefs*, available at <http://www.census.gov/prod/cen2010/briefs/c2010br-10.pdf>; U.S. CENSUS BUREAU, *2010 Census Data*, available at <http://www.census.gov/2010census/data/>.

27. Periodically, including in the Washington team’s dispute, First Amendment objections are raised. To date, such concerns have been rejected because of the limited scope of the federal registration system and the fact that any such marks can continue to be used and protected under the common law. See, e.g., *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012); *In re McGinley*, 660 F.2 481, 484 (C.C.P.A. 1981). This Article will not address the First Amendment concerns.

I. MORALITY IN TRADEMARK ACQUISITION

When an entity, whether an individual, a company, a partnership, or the like, has a new product (good or service)²⁸ to offer for sale, it needs a symbol. This symbol will identify for the consumer the source of the product and give the consumer information about the product itself.²⁹ For example, after buying and drinking a Coca-Cola soda, the consumer can identify that product in the future by simply looking for the COCA-COLA trademark on a soda. That trademark denotes that the source of the soda is the same as the prior source.³⁰ It also provides information for the consumer regarding the expected quality and experiential characteristics of the product because the consumer can use the trademark to find the product previously described or experienced.³¹ Consequently, trademark law is commonly seen as a species of unfair competition law, a means for protecting consumers from deception.³²

Several types of symbols are prohibited or limited from being trademarks because they undermine the ability of the symbol to serve its unfair competition purpose. For example, a symbol is prohibited from becoming a trademark for a particular product if it is deceptive, meaning that it seems to describe a characteristic of the product that would influence the buyer's purchasing decision, but in fact that product does not have that characteristic.³³ As it tricks the consumer into buying the product, a deceptive mark would provide an unfair advantage.³⁴ Because trademark protection began in the common law, these concerns were captured by common law jurisprudence.³⁵ When Congress created a federal trademark system, which supplements rather than supplants common law protection, it captured many of those same prohibitions and restrictions.³⁶

28. Trademarks actually denote a symbol associated with goods, and service marks denote symbols associated with services. *See, e.g.*, 15 U.S.C. §1127 (2014). For the purpose of this Article and as in common parlance, the term trademark will be used throughout to encompass both trademarks and service marks.

29. *See* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §2:3 (4th ed., 2014).

30. *See id.*

31. *See id.* at §2:5.

32. *See id.* at §2:1; ANNE GILSON LALONDE, GILSON ON TRADEMARKS §1.03 (2014).

33. *See* 15 U.S.C. §1052(a) (2014); *see, e.g.*, *Daesang Corp. v. Rhee Bros., Inc.*, 2005 U.S. Dist. LEXIS 9066, at *31-35 (D. Md. May 13, 2005).

34. *See, e.g.*, *Worden v. Cal. Fig Syrup Co.*, 187 U.S. 516, 528 (1903).

35. *See* MCCARTHY, *supra* note 29, §3:1; There is some suggestion that deceptive marks, marks that appear to describe the associated products but in fact do not, were perceived as immoral. *See* WILLIAM HENRY BROWNE, A TREATISE ON THE LAW OF TRADE-MARKS AND ANALOGOUS SUBJECTS (FIRM-NAMES, BUSINESS-SIGNS, GOOD-WILL, LABELS, & C.) 238-39 (Little, Brown, and Co. 1873).

36. In the current trademark act, most, although not all, of the relevant restrictions and prohibitions can be found in 15 U.S.C. §1052 (2014).

However, there are two prohibitions that appear to have little United States common law antecedent: scandalous and disparaging. Neither of these prohibitions, on their face, relate to concerns of unfair competition. Instead, they appear to have some sort of moral or public order justification. This fundamental difference renders the considerations used to shape other prohibitions inapplicable. Because they lack precedent in common law jurisprudence or clear connective tissue with other prohibitions, their respective scopes have been defined in their application and in light of each other.

A. *Scandalous Registration Prohibition*

In the 1905 Trademark Act,³⁷ Congress first included a prohibition against registering marks that consist of or comprise immoral or scandalous matter. Apparently added at the last minute to the legislation, the direct legislative history provides little express information regarding Congress' intent in enacting this prohibition nor its expected parameters. However, there are some useful hints. Similar prohibitions related to immorality were proposed previously,³⁸ and at least one early legal commentator believed immorality to be a viable argument against trademark acquisition under prior acts.³⁹ There is other indirect, relevant legislative history evidencing the Senate's exposure to various international trademark laws before 1900, many of which contained a similar prohibition.⁴⁰ By 1900, the Commission appointed to revise our trademark law also considered many foreign trademark laws, presumably to evaluate what provisions may be incorporated into U.S. law.⁴¹ In 1902, the Commissioners presented alternative proposals precluding trademark protection based upon immorality, including one proposal that contained the precise language adopted in 1905.⁴²

It was decades before administrative decisions and courts began to interpret the scandalous prohibition by considering if it "would be shock-

37. Trademark Act of 1905, ch. 592, 33 Stat. 724, 725.

38. See, e.g., H.R. REP. NO. 52-1860, at 3 (1892) (suggesting limiting registration to "marks and labels . . . as are not offensive to public sentiment or morals.").

39. BROWNE, *supra* note 35, at 239; see also *Hughes v. Alfred H. Smith Co.*, 205 F. 302, 315 (S.D.N.Y. 1913).

40. Jasmine Abdel-khalik, *To Live in In-"Fame"-y: Reconceiving Scandalous Marks as Analogous to Famous Marks*, 25 CARDOZO ARTS & ENT. L.J. 173, 198-99 (2007); see, e.g., S. EXEC. DOC. NO. 52-149, at 495 (1893); S. EXEC. DOC. NO. 52-8, pt. 2 at 354, 357, 359 (1891); S. EXEC. DOC. NO. 51-177, at 1-2 (1890); S. EXEC. DOC. NO. 51-57, at 60 illus. (1890). The U.S. also joined the Paris Convention for the Protection of Industrial Property in 1887, which allowed treaty members to reject trademark registrations if contrary to morals and to public order. 21 U.S.T. 1583, 828 U.N.T.S. 305, available at <http://www.wipo.int/treaties/en/ip/paris/index.html>; see also H.R. REP. NO. 50-3281, at 5 (1890).

41. S. DOC. NO. 56-20, at 40-43, 55 (1902).

42. See *id.* at 66, 130.

ing to the sense of propriety or call out condemnation.”⁴³ Eventually, reviewing bodies developed a two-part test for scandalous: (1) determine the likely meaning of the mark in the context of the associated goods or services in the application, any other elements in the mark, and the marketplace; and (2) evaluate if a substantial composite (not necessarily a majority) of the general public would find the mark to be scandalous based upon attitudes contemporary to the application.⁴⁴ Over the decades, this prohibition has been assessed for marks that fall into the following categories:⁴⁵ (1) political imagery;⁴⁶ (2) religious terms and icons;⁴⁷ (3) identity issues involving race, gender, and sexual orientation;⁴⁸ (4) sexual matter

43. *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938). Although some have tried to analogize scandalous trademarks and obscenity, reviewing bodies specifically have held that they are not comparable because there is a lower threshold for objectionable material under scandalous as compared to obscenity. *See, e.g., In re McGinley*, 660 F.2d 481, 485–86 (C.C.P.A. 1981); *In re Brunetti*, 2014 WL 3976439, at *2 (T.T.A.B. Aug. 1, 2014).

44. *See In re McGinley*, 660 F.2d at 485; *see also In re Red Bull GmbH*, 2006 TTAB LEXIS 136, at *18 (T.T.A.B. Feb. 15, 2006) (affirming refusal of BULLSHIT for various drinks (alcoholic and non-alcoholic) and various services as scandalous).

45. *See Abdel-khalik*, *supra* note 40, at 200–10; *see also* Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TMR 661, 701–28 (1993).

46. *See, e.g., In re Advanced Armament Corp. LLC*, 2013 TTAB LEXIS 601 (T.T.A.B. Nov. 29, 2013) (reversing refusal of ADVANCED ARMAMENT CORP. SILENCERS with a Statue of Liberty design holding a gun with silencer for firearms); *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216 (T.T.A.B. 1993) (reversing refusal of OLD GLORY CONDOM CORP and flag/condom design for condoms); *Ex parte Marta Maid Mfg. Co.* 37 U.S.P.Q. (BNA) 156 (Comm’r Pats. 1938) (affirming refusal of QUEEN MARY (and design) for underwear); *Ex parte Banner Cigar Mfg. Co.*, 1909 C.D. 9 (affirming refusal to register the portrait and signature of Grover Cleveland for cigars).

47. *See, e.g., In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653 (T.T.A.B. 1990) (reversing refusal to register MOONIES and design for a pants-dropping doll); *In re Waughtel*, 138 U.S.P.Q. (BNA) 594 (T.T.A.B. 1963) (reversing refusal to register AMISH with a picture of a man smoking a cigar for cigars and cigar boxes); *In re Reemtsma Cigarettenfabriken*, 122 U.S.P.Q. (BNA) 339 (T.T.A.B. 1959) (affirming refusal to register SENUSSI for cigarettes); *In re Sociedade Agricola E. Comercial Dos Vinhos Messias*, 159 U.S.P.Q. (BNA) 275 (T.T.A.B. 1968) (affirming refusal of MESSIAS for wine and brandy); *In re P.J. Valckenberg*, 122 U.S.P.Q. (BNA) 334 (T.T.A.B. 1959) (affirming refusal of MADONNA for wines); *Ex parte Summit Brass & Bronze Works, Inc.*, 59 U.S.P.Q. (BNA) 22 (Comm’r Pats. 1943) (affirming refusal of AGNUS DEI (and picture) for metallic tabernacle safes); *In re Riverbank Canning Co.*, 95 F.2d at 328 (affirming refusal of MADONNA for wine).

48. *See, e.g., In re Lombardi*, 2013 TTAB LEXIS 337 (T.T.A.B. June 14, 2013) (affirming refusal for PROTECT THE COOCH! for various types of clothing); *In re Love Bottling Co.*, 2005 TTAB LEXIS 261 (T.T.A.B. June 22, 2005) (affirming refusal to register W.B. WIFE BEATER for T-shirts); *In re Mothers and Fathers Italian Ass’n*, 2000 TTAB LEXIS 52 (T.T.A.B. Feb. 11, 2000) (reversing refusal of MAFIA BRAND for various foods); *In re Undeas, Inc.*, 2000 TTAB LEXIS 39 (T.T.A.B. Jan. 28, 2000) (reversing refusal of JUNIOR M.A.F.I.A. for musical tapes/discs and concerts/performances); *In re Runsdorf*, 171 U.S.P.Q. (BNA) 443 (T.T.A.B. 1971) (affirming refusal of BUBBY TRAP for bras); *see also Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. (BNA) 176 (T.T.A.B. 1978) (denying motions to dismiss for opposition to ONLY A BREAST IN THE MOUTH IS BETTER THAN A LEG IN THE HAND

(vulgar);⁴⁹ (5) profanity (vulgar);⁵⁰ and (6) illegality.⁵¹ These categories are

for restaurant services); *see also* DYKES ON BIKES, U.S. Trademark Application Serial No. 78/281,746 (filed July 31, 2003); Office Action from Sharon A. Meier, Trademark Attorney, to Brooke Oliver (Feb. 20, 2004). The opposition to DYKES ON BIKES was eventually dismissed on standing grounds. *See* McDermott v. San Francisco Women's Motorcycle Contingent, 240 Fed. Appx. 865 (Fed. Cir. 2007).

49. *See, e.g., In re* Blvd. Entm't, 334 F.3d 1336 (Fed. Cir. 2003); (affirming refusal to register 1-800-JACK-OFF for adult-oriented phone conversations); *In re* Mavety Media Grp., 33 F.3d 1367 (Fed. Cir. 1994) (remanding after vacating refusal of BLACK TAIL for an adult entertainment magazine); *In re* McGinley, 660 F.2d at 481 (affirming refusal for a mark comprised of a photograph of a nude man and woman kissing while male genitalia appears to be exposed for a sex related newsletter and social club services); *In re* Fox, 702 F.3d 633 (affirming refusal to register COCK SUCKER and design for rooster-shaped chocolate lollipops); *In re* Manwin/RK Collateral Trust, 2014 TTAB LEXIS 270 (T.T.A.B. July 3, 2014) (affirming refusal for MOM-SBANGTEENS for adult-oriented web site services); *In re* Betty Bangs, LLC, 2013 TTAB LEXIS 383 (T.T.A.B. July 9, 2013) (affirming refusal of I BANGED BETTY for various types of clothing); *In re* Mackman, 2011 WL 810206 (T.T.A.B. Feb. 9, 2011) (reversing refusal to register COCKTALES for a variety of entertainment services); *In re* RK Netmedia, Inc., 2009 TTAB LEXIS 389 (T.T.A.B. May 21, 2009) (affirming refusal of CUMFIESTA and CUM-GIRLS for adult oriented internet material); *In re* Shearer, 2009 TTAB LEXIS 374 (T.T.A.B. May 14, 2009) (affirming refusal of PUSSY NATURAL ENERGY (and design) for various non-alcoholic drinks); Boston Red Sox Baseball Club Ltd. v. Sherman, 88 U.S.P.Q.2d (BNA) 1581 (T.T.A.B. Sept. 9, 2008) (sustaining opposition to SEX ROD and design for various types of clothing); *In re* Carlson, 2007 TTAB LEXIS 651 (T.T.A.B. Aug. 28, 2007) (affirming refusal of YOU CUM LIKE A GIRL for clothing); *In re* Douglas and Watson, 2004 TTAB LEXIS 524 (T.T.A.B. Sept. 7, 2004) (affirming refusal of THE BEARDED CLAM for restaurant services); *In re* Wilcher Corp., 1996 TTAB LEXIS 28 (T.T.A.B. June 13, 1996) (affirming refusal for DICK HEADS! and design for restaurant/bar services); *In re* Hershey, 6 U.S.P.Q.2d (BNA) 1470 (T.T.A.B. 1988) (reversing the refusal of BIG PECKER BRAND for T-shirts); *In re* Thomas Lab., Inc., 189 U.S.P.Q. (BNA) 50 (T.T.A.B. 1975) (reversing refusal of a drawn picture of a "cartoon-like representation of a melancholy, unclothed male figure ruefully contemplating an unseen portion of his genitalia" for a corrective implement to increase penis size); *In re* Madsen, 180 U.S.P.Q. (BNA) 334 (T.T.A.B. 1973) (reversing refusal of WEEK-END SEX for a magazine); *Ex parte* Parfum L'Orle, 93 U.S.P.Q. (BNA) 481 (P.T.O. 1952) (reversing refusal of LIBIDO for perfumes and toilet water).

50. *See, e.g., In re* Brunetti, 2014 WL 3976439 (T.T.A.B. Aug. 1, 2014) (affirming refusal to register FUCT, treated as the phonetic equivalent of fucked, for athletic apparel, children's apparel, and infant's apparel); *In re* Michalko, 110 U.S.P.Q.2d (BNA) 1949 (T.T.A.B. 2014) (affirming refusal of ASSHOLE REPELLENT for a gag gift can with spray top); *In re* Murchison, 2014 TTAB LEXIS 130 (T.T.A.B. Mar. 24, 2014) (affirming refusal of FOK'N HURTS for stun guns); *In re* Jones, 2013 TTAB LEXIS 615 (T.T.A.B. Dec. 13, 2013) (affirming refusal of NO \$#!+ for a website featuring news, humor, and memes); *In re* Star Belly Stitcher, Inc., 107 U.S.P.Q.2d (BNA) 2059 (T.T.A.B. Aug. 12, 2013) (affirming refusal of AWSHIT WORKS for various hats, caps, and types of clothing); *In re* Luxuria, s.r.o., 100 U.S.P.Q.2d (BNA) 1146 (T.T.A.B. Sept. 19, 2011) (affirming refusal of bottle in shape of a hand with upward middle finger design for various alcoholic and non-alcoholic drinks); *In re* Jibjab Media, Inc., 2009 TTAB LEXIS 67 (T.T.A.B. Feb. 4, 2009) (affirming refusal of A-HOLE PATROL for an online joke forum); *In re* Mexico 69 SRL, 2006 TTAB LEXIS 358 (T.T.A.B. Aug. 7, 2006) (affirming refusal of DE PUTA MADRE for various types of clothing); *In re* Red Bull GmbH, 2006 TTAB LEXIS 136 (T.T.A.B. Feb. 15, 2006) (affirming refusal of BULLSHIT for various types of drinks and services); *In re* Tinseltown, Inc., 212 U.S.P.Q. (BNA) 863 (T.T.A.B. 1981) (affirming refusal of BULLSHIT for various accessories like handbags and wallets); *In re* Watkins,

not absolute or exclusive. For example, some marks that contain gendered material easily cross categories and may be treated as falling into one of the vulgar categories (sexual matter or profanity).⁵²

As with other bases for objection, in situations where there is doubt as to whether the mark is scandalous, doubt is resolved in favor of the applicant.⁵³ Even if it passes the examination process, the application may still have other hurdles to overcome before registration, such as publication for opposition (where a third party may object based on scandalousness) and filing an acceptable statement of use if it was an intent-to-use application. Even registration does not guarantee that the mark is inviolate. After registration, scandalousness can be raised by third parties in a petition to cancel the registered mark.⁵⁴

Of the recent scandalous rejections affirmed by the Trademark Trial and Appeal Board (Board), the majority appear to fall within one of the two vulgar categories.⁵⁵ This suggests that applicants are testing the boundary between permissible double entendres/jokes and vulgarity. Alternatively, applicants may be pushing to see if contemporary attitudes no longer consider certain terms to be offensive. Moreover, many applicants, especially those without experienced trademark counsel, may not be aware

2005 TTAB LEXIS 66 (T.T.A.B. Feb. 8, 2005) (reversing refusal of TWATTY GIRL for cartoons); *In re Zaharoni*, 2005 TTAB LEXIS 3 (T.T.A.B. Jan. 4, 2005) (affirming refusal of THE COMPLETE A**HOLE'S GUIDE TO for a series of self-help books); *In re Douglas and Watson*, 2004 TTAB LEXIS 524 (T.T.A.B. Sept. 7, 2004) (affirming refusal of THE BEARDED CLAM for restaurant services); *In re Frankel*, 2002 TTAB LEXIS 250 (T.T.A.B. Mar. 29, 2002) (affirming refusal of GRANDMA SCHITTHED'S OUTHOUSE BROWN, GRANDPA SCHITTHED'S INKY STINKY PALE ALE, and SCHITTHED'S for various alcoholic drinks, restaurant services, T-shirts, and hats); *In re Friggin Barnyard*, 1999 TTAB LEXIS 108 (T.T.A.B. Mar. 30, 1999) (affirming refusal of FRIGGIN and design for decorative refrigerator magnets); *In re Bad Frog Brewery, Inc.*, 1999 TTAB LEXIS 86 (T.T.A.B. Mar. 16, 1999) (reversing refusal for BAD FROG BEER and design for beer); *In re R.G.S. Group, Ltd.*, 1997 TTAB LEXIS 293 (T.T.A.B. Mar. 5, 1997) (affirming refusal of REALLY GOOD SHIT for oil); *The Greyhound Corp. vs. Both Worlds, Inc. d.b.a. The Wild Berry*, 1988 TTAB LEXIS 78 (T.T.A.B. Mar. 30, 1988) (granting summary judgment in opposition that dog defecating for T-shirts would be scandalous and disparaging); *In re Leo Quan*, 200 U.S.P.Q. (BNA) 370 (T.T.A.B. 1978) (reversing refusal of BADASS for stringed musical instruments).

51. See, e.g., *In re Kirby*, 2008 TTAB LEXIS 156 (T.T.A.B. Sept. 22, 2008) (affirming refusal of COCAINE and design for soft and energy drinks); *Schlage Lock Co. v. Staiano*, 2005 TTAB LEXIS 846 (T.T.A.B. Dec. 12, 2005) (dismissing opposition to KRYPTOKING and (allegedly aloe) design for sunglasses, bags, wallets, various types of clothing, and various goods related to tobacco and smoking); *In re Hepperle*, 175 U.S.P.Q. (BNA) 512 (T.T.A.B. 1972) (affirming refusal on other grounds of ACAPULCO GOLD for suntan lotion).

52. See, e.g., *In re Brunetti*, 2014 WL 3976439 (noting that the term in Serial No. 85/310, 960 was treated as vulgar/sexual term even though it may also be used in the context of extreme misogyny, nihilism, or violence).

53. *In re Watkins*, 2005 TTAB LEXIS 66, at *12-13.

54. 15 U.S.C. §1064(3) (2015).

55. Responding to the argument that the term bullshit is more freely used, "[that fact] does not render them any the less profane." *In re Tinseltown*, 212 U.S.P.Q. (BNA) at 866.

of the scandalous prohibition for vulgar terms. And finally, the fact that vulgarity objections dominate scandalous decisions may also reflect the rise of disparagement as a viable argument for certain marks previously considered under the scandalous prohibition, such as religious terms and terms related to identity issues.

B. *The Legislative Development of the Disparaging Prohibition*

Although the scandalousness prohibition was enacted with the 1905 Trademark Act, the Quakers must have felt that it was insufficient for their purposes in 1914.⁵⁶ In arguing for the proposed legislation to criminalize the use of religious organizations' names and nicknames as trademarks, the Chairman of the Friends Legislative Board, Mr. Nicholson, stated that goods should be purchased based on the merits of the goods, and "not upon the merit of some name, especially if that name has been taken from a denominational body, the use of which in the markets of the world *tends to bring into disrepute* the denomination that carries the name."⁵⁷ In so arguing, Mr. Nicholson raised a sort of unfair competition argument—that the company is exploiting or riding the coattails of the Quakers' good name. But more importantly, he contended, the Quakers did not want their nickname used for commercial purposes.⁵⁸

A similar line of reasoning was raised decades later against trademarks for other religious terms, but concerns about commercialization of religious terms or iconography have lost popularity or success or both.⁵⁹ There are at least two reasons for this. The first is that there may be an increasing acceptance of religious terms for some items, particularly items used by religious clergy. For example, it seems unlikely that a substantial composite of the general population in today's society would be offended by an AGNEUS DEI mark used for metallic tabernacle safes purchased and used by Catholic clergy; and yet, a 1943 decision affirmed refusal of the registration because it was offensive, at that time, to commercialize "highly sacred religious" emblems.⁶⁰ Second, parties may be more successful raising the claim under a more narrowly tailored prohibition that does not require assessing the general public's perception, avoiding reliance on the

56. According to the U.S.P.T.O. database, The American Cereal Company filed a trademark application for a mark containing "Quaker Oats" in 1897. See QUAKER OATS 1 POUND QUAKER OATS MANUFACTURED BY THE AMERICAN CEREAL CO. ADDRESS CHICAGO U.S.A. USE ONLY QUAKER BRAND ROLLED OATS, US Trademark Reg. No. 29,632 (filed Jan. 15, 1897 and expired Dec. 22, 1988). The American Cereal Company was eventually rolled into a parent company, Quaker Oats Co. See OHIO HISTORY CENTRAL, *American Cereal Company*, http://www.ohiohistorycentral.org/w/American_Cereal_Company?rec=833.

57. *Hearings on Use of Religious Org. Names*, *supra* note 1, at 8 (emphasis added).

58. See *id.* at 10, 18.

59. See cases cited, *supra* note 47.

60. *Ex Parte Summit Brass & Bronze Works, Inc.*, 59 U.S.P.Q. (BNA) 22.

fickleness of the general public to catch terms or usage offensive to others.⁶¹ Such a prohibition did not exist in the 1905 Act—even though some of the mid-20th century scandalous decisions stretch to accommodate concerns of offending some religious organizations.⁶²

In the late 1930s, Representative Fritz Lanham spearheaded the process of entirely rewriting our federal trademark registration system. The initial proposed legislation contained the prohibition on scandalous material but nothing related to disparaging.⁶³ In a 1938 hearing, various speakers raised a concern that the proposed limitation on using the portrait or signature of a living individual or the name, portrait, or signature of any deceased President during the life of his widow was wholly insufficient.⁶⁴ The Commissioner of Patents, who also had authority over the federal trademark system, stated shock to his sense of propriety at three recent trademark applications: upon Mr. Rockne's death, KNUTE ROCKNE for whisky and alcoholic beverages, the Duchess of Windsor's name for brassieres and underwear, and NOTRE DAME for alcoholic beverages.⁶⁵ Another speaker, attorney Edward Rogers, also noted that some may be "prostituting great names" and obtaining "vicarious credit to goods by putting a great man's name on them."⁶⁶ One solution suggested was a prohibition on marks that "bring into disrepute or ridicule anyone in the place of community he resides."⁶⁷

Perhaps because these concerns related to individuals or institutions, the House of Representatives passed a bill in 1939 that now included a prohibition against "matter which tends to disparage persons, living or dead, institutions, beliefs, or national symbols, or to bring them into contempt."⁶⁸ In a subsequent hearing, a commentator again raised concerns about improper use of prior presidents' names, images, or the like as trademarks even after the widow has died (and thus not precluded under the

61. See, e.g., *Hearings on Use of Religious Org. Names*, *supra* note 1, at 13, 16; see also *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653 (T.T.A.B. 1990) (reversing refusal to register MOONIES and design for a pants-dropping doll on the basis of scandalousness).

62. For example, the T.T.A.B. found SENUSSI scandalous for cigars because the Senussi are a Muslim sect that forbids the use of cigarettes. Allowing the trademark would be offensive to members of that religious organization, which was the reference group to determine scandalous rather than the general public. See *In re Reemtsma Cigarettenfabriken*, 122 U.S.P.Q. (BNA) 339 (T.T.A.B. 1959).

63. See *Hearings on H.R. 9041 Before the H. Comm. on Patents, Subcommittee on Trademarks*, 75th Cong., 3d Sess. 1-2 (1938) [hereinafter *Hearings on H.R. 9041*].

64. See *id.* at 79-81. Both years, these concerns were raised to suggest an amendment of §2(c), but the ensuing conversation brought the issue back to §2(a) disparagement.

65. See *id.* at 79.

66. See *id.* at 79, 81.

67. See *id.* at 80.

68. See H. JOURNAL, 76th Cong., Sess. 1, at 877, 883 (1939).

proposed section that directly addresses dead Presidents).⁶⁹ Referring to the disparaging/contempt language recently added as well as the scandalousness prohibition, it was suggested that these prohibitions allowed the USPTO to strike the right balance between preventing abuses and allowing legitimate uses.⁷⁰ ABRAHAM LINCOLN gin would not be permissible, but GEORGE WASHINGTON for coffee would be.⁷¹ The speaker evidently believed it would be self-evident why one would be disparaging and the other not, perhaps having to do with lingering concern over alcohol.⁷²

In discussing various potential issues addressed (or not addressed) by the disparaging prohibition, commentators raised a salient concern: the scope of disparagement.⁷³ For example, one commentator contested the notion that an ex-President's name should be used as a trademark even in a "respectful manner."⁷⁴ The Assistant Commissioner of Patents subsequently suggested that "disparaging" would be too difficult for the USPTO because it would be a matter of the relevant individuals' personal opinion as to whether something is disparaging.⁷⁵

And yet, the term "disparage" did not change in subsequent bills. In 1942, the relevant portion of the bill was amended in two ways. First, "tends to disparage" was changed to "may disparage."⁷⁶ Second, the bill inserted after "may disparage" the additional prohibition against "falsely suggest[ing] a connection with."⁷⁷ The second amendment was likely to address the concern that unscrupulous businesses would attempt to unfairly gain the benefit of others' good name by using the others' names as trademarks.⁷⁸ The first amendment, however, reaffirms that disparagement remained an essential concern outside of merely protecting individual names. It also suggests that disparagement was intended to have broader scope (in at least one facet) than either scandalousness or its own original formulation. The scandalousness prohibition applies when the matter consists or comprises of scandalous material; so, it must cross the threshold of *being* scandalous. Originally, disparagement would have prohibited registration if

69. See *Hearings on H.R. 4744 Before the H. Comm. on Patents, Subcommittee on Trade-Marks*, 76th Cong., 1st Sess. 19 (1939) [hereinafter *Hearings on H.R. 4744*].

70. See *Hearings on H.R. 4744*, *supra* note 69, at 19, 20.

71. *Id.* at 19.

72. Prohibition had just ended on December 5, 1933 with ratification of the Twenty-First Amendment to the Constitution.

73. See *Hearings on H.R. 4744*, *supra* note 69, at 20-21.

74. See *id.* at 21.

75. See *id.*

76. H. JOURNAL, 77th Cong., 2d Sess., at 541 (1942).

77. *Id.*

78. See, e.g., *In re W.H. Snyder & Sons Inc.*, 137 U.S.P.Q. (BNA) 569 (T.T.A.B. 1963) (noting that HOUSE OF WINDSOR for cigars would be prohibited regardless of whether the applicant uses the mark in a "dignified" manner without intent to deceive).

the matter *tends to* disparage. “Tends to” was defined around that time as “to move, direct, or develop one’s course in a particular direction; to exhibit an inclination or tendency.”⁷⁹ Already broader than scandalous, the original formulation would have prohibited a mark as long as it was *in the direction* of disparaging. By changing it to “may disparage,” Congress further loosened the requirement, suggesting that a mark should be prohibited as long as there is a *possibility or probability* of disparagement.⁸⁰ Of course, this still leaves open the question of what disparagement means. None of the subsequent Lanham Act legislative history provides further evidence of congressional intent, leaving its development to the administrative and court process.

C. The Pre-Harjo Disparaging Decisions

Although the *Harjo* dispute⁸¹ changed the landscape of disparaging trademarks, there were prior disparagement decisions. However, they were inconsistent and provided little guidance as to the contours of disparagement.

Unlike the scandalous prohibition, which, for right or wrong, seemed to put decision-makers more at ease with respect to its meaning, the initial decisions raising the disparaging prohibition reflected uncertainty in how to construct what disparaging means in the context of the statutory language. Perhaps this uncertainty also explains why the first reported decision is one where the Patent Examiner in Chief appears to have raised the issue of disparagement *sua sponte*, 1951’s *Doughboy Industries, Inc. v. The Reese Chemical Company*.⁸²

Arguing likelihood of confusion, Doughboy Industries opposed an application for DOUGH-BOY for “a prophylactic preparation for the prevention of venereal diseases” based on Doughboy Industries’ use and registrations of DOUGHBOY for various food products.⁸³ The term “Doughboy” is slang for American soldiers in World War I. Finding no likelihood of confusion, the Patent Examiner in Chief then raised the issue of disparagement and, with minimal analysis, held that it is disparaging to associate DOUGHBOY, and presumably our American soldiers, with venereal disease treatments.⁸⁴ In so finding, the Patent Examiner in Chief must have

79. *Tend*, MERRIAM-WEBSTER DICTIONARY, <http://www.merriam-webster.com/dictionary/tend> (2014).

80. *May*, MERRIAM-WEBSTER DICTIONARY, <http://www.merriam-webster.com/dictionary/may> (2014).

81. Although this cancellation action ended on a laches argument, and Amanda Blackhorse and others filed the currently active petition to cancel, I will use *Harjo* to refer to both disputes by Native Americans against the Washington team marks.

82. 88 U.S.P.Q. (BNA) 227 (Pat. Off. Exm’r-in-Chief 1951).

83. *Id.*

84. The analysis is essentially comprised of the following sentence: “When used by applicant on its particular goods, the mark obviously ‘consists or comprises * * * matter which may

believed that the collective “doughboy” term constituted either persons or a national symbol.

Interestingly, the concern raised by associating American soldiers with venereal diseases parallels a later matter, where an Examiner rejected an application associating an American flag mark with condoms.⁸⁵ In the later matter, however, the Trademark Trial and Appeal Board (TTAB) relied upon the scandalous prohibition. Perhaps the Patent Examiner in Chief used the disparaging prohibition for DOUGHBOY because the mark triggers a specific entity or group of people, and the statutory language suggested a connection between disparaging and offense to individuals. The Patent Examiner in Chief seemed to find disparagement because he presumed the targeted group would be embarrassed or otherwise not want to be associated with the identified goods and services. The Gavel Club likewise successfully raised disparagement against the collective mark GAVEL CLUBS AN AFFILIATION OF TOASTMASTERS INTERNATIONAL (and design) because it would be used, in part, for clubs in penal and mental institutions, which “might well disparage [Gavel Club] and its members, past and present.”⁸⁶

Some attempted to create clearer criteria regarding what it means to disparage. For some decisions, the latter part of the disparagement statutory language, “matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute,”⁸⁷ became an essential part of the analysis.⁸⁸ The initial step, therefore, would be determining who or what is disparaged and ensure that that person or entity fits within the definition of persons, institutions, beliefs, or national symbols.⁸⁹ Additionally, the decision-maker may require evidence that the trademark application clearly incorporates a trade-

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

85. *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216 (T.T.A.B. 1993).

86. *Gavel Club v. Toastmasters Int'l*, 127 U.S.P.Q. (BNA) 88 (T.T.A.B. 1960). This case also evidences some of the early, common confusion, where the analysis of disparagement mixed with the false association portion of §2(a).

87. 15 U.S.C. §1052(a).

88. *See, e.g., In re Consol. Foods Corp.*, 187 U.S.P.Q. (BNA) 63 (1975) (finding OSS, the predicate to the CIA, is not a national symbol); *Doughboy Indus., Inc. v. The Reese Chem. Co.*, 88 U.S.P.Q. (BNA) 227 (1951); *Jacobs v. Int'l Multifoods Corp.*, 211 U.S.P.Q. (BNA) 165 (1981) (finding BOSTON TEA PARTY is neither a belief nor national symbol in the context of a false connection argument).

89. *See Gavel Club*, 127 U.S.P.Q. (BNA) 88 (determining that Gavel Club constitutes an institution for purposes of disparagement); *see also Wells Fargo & Co. v. J. Halpern Co.*, 133 U.S.P.Q. (BNA) 625 (T.T.A.B. 1962) (finding that Wells Fargo is not an institution, defined as “an organization or foundation, for the exercise of some public purpose or function, as an asylum or a university”).

mark previously (and recognizably) associated with another entity.⁹⁰ For example, the TTAB reversed a refusal to register a mark with a confederate flag as disparaging or falsely suggesting a connection with The Sons of the Confederate Veterans because of insufficient resemblance between the marks.⁹¹ Others defined disparagement as occurring when a new trademark damaged the reputation of a senior trademark holder with the same or similar mark.⁹² Although the damage could be described as damage to senior trademark user's mark or products, at least one decision-maker returned to a DOUGHBOY-like reasoning, simply evaluating if the new trademark user's products would be so repugnant to the senior user as to harm the senior user's products.⁹³ The doctrine was shaped by an interesting fact; most of the pre-*Harjo* cases were brought by corporate or similar institutions to protect themselves.⁹⁴ As such, they have significantly different interests at play as compared to marks opposed because of identity or religious issues.

Of the pre-*Harjo* cases related (broadly) to identity or religious issues, most were perfunctory.⁹⁵ In the late 1960s, an applicant attempted to register design mark comprised of an "X" over the Soviet hammer and sickle for patriotic educational services, namely, dissemination of information about U.S. laws concerning Communist Party activities.⁹⁶ The bulk of the

90. See, e.g., *Fanta v. The Coca-Cola Co.*, 140 U.S.P.Q. (BNA) 674 (T.T.A.B. 1964) (suggesting that the petitioner has no grounds to argue false connection or disparagement because his name FANTA has no recognition in the field); *Gavel Club*, 127 U.S.P.Q. (BNA) 88 (requiring evidence that opposer was an institution with a propriety interest in its name and that someone was subsequently seeking to register a mark that would disparage or falsely suggest a connection); see also *Int'l Playtex Corp. v. Lever Bros. Co.*, 161 U.S.P.Q. (BNA) 306 (T.T.A.B. 1969) (requiring evidence that some in the purchasing public would associate the two marks, at least in part because the senior user's mark was well-known).

91. See *In re Am. Indus., Inc.*, 161 U.S.P.Q. (BNA) 60 (T.T.A.B. 1969).

92. See, e.g., *Int'l Playtex Corp.*, 161 U.S.P.Q. (BNA) 306.

93. See *Nat'l Aeronautics and Space Admin. v. Record Chem. Co., Inc.*, 185 U.S.P.Q. (BNA) 563 (T.T.A.B. 1975) (finding nothing offensive to NASA in the applicant's moth preventative-air fresheners). For a time, decision-makers also struggled with standing. See, e.g., *Abraham's Seed v. John One Ten*, 1 U.S.P.Q.2d (BNA) 1230 (1986); *Bromberg et al v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. (BNA) 176 (T.T.A.B. 1978). This issue was resolved in *Ritchie v. Simpson*, 170 F.3d 1092 (Fed. Cir. 1999) (finding that an individual had standing to oppose O.J. Simpson marks as scandalous).

94. See, e.g., *K2 Corp. v. Phillip Morris*, 192 U.S.P.Q. (BNA) 174 (Aug. 14, 1976); *Nat'l Aeronautics and Space Admin.*, 185 U.S.P.Q. (BNA) 563; *In re Am. Indus., Inc.*, 161 U.S.P.Q. (BNA) 60; *Wells Fargo & Co.*, 133 U.S.P.Q. (BNA) 625; *Gavel Club*, 127 U.S.P.Q. (BNA) 88.

95. See, e.g., *Abraham's Seed*, 1 U.S.P.Q.2d (BNA) 1230 (decision standing not the merits).

96. See *In re Anti-communist World Freedom Cong., Inc.*, 161 U.S.P.Q. (BNA) 304 (T.T.A.B. 1969) (rejecting argument that the hammer and sickle is a symbol of the International Communist Congress rather than a national symbol of the U.S.S.R.).

short analysis focused on whether another country's national symbol is included in Section 2(a) protection; it is and the rejection was affirmed.⁹⁷

In those matters that focused on religion or racial identity, the refusals to register were all reversed. The TTAB reversed the refusal to register JAP for clothing, argued as offensive to those of Japanese ancestry by the Japanese American Citizens League.⁹⁸ The decision intimated that the term could not be disparaging because the company was controlled by someone of Japanese origin.⁹⁹ It is unclear why the TTAB expected someone from Japan to know whether a term is an American slur.¹⁰⁰ In *In re In Over Our Heads, Inc.*, the TTAB reversed a refusal to register MOONIES (and design suggesting a buttocks) for dolls that drop their pants; the term "Moonies" is a slur applied to members of a small religion often called a cult.¹⁰¹ In the years after *Harjo* was filed but before a merits decision issued, an examiner also rejected BUDDA BEACHWEAR and logo for clothing as being disparaging.¹⁰² In reversing the refusal, the TTAB noted that the determination in this case is "highly subjective . . . 'perhaps being all the more subjective due to the relative obscurity of Buddhism in this country.'" ¹⁰³ In other words, few appeals focused on identity or religion issues, and those that did failed. It is not until the *Harjo* case that the TTAB and courts finally articulated a clear test for the disparaging prohibition for non-corporate entities.¹⁰⁴

97. *Id.*

98. *In re Condas S.A.*, 188 U.S.P.Q. (BNA) 544 (T.T.A.B. 1975).

99. *Id.*

100. The decision also pointed to another case as holding that the term is not derogatory. See *Japanese Am. Citizens League v. Takada*, 171 U.S.P.Q. (BNA) 109 (Sup. Ct. N.Y. 1971). However, the decision seemed to turn more on the notion that there is no claim available for "injury to petitioners' feelings." *Id.* The court also argued that, by using the term, Takada was enhancing and popularizing the term, an argument raised by others in modern cases with some success. *Id.*

101. See 16 U.S.P.Q.2d (BNA) 1653; see also *infra* notes 162-70.

102. *In re Hines*, 32 U.S.P.Q.2d (BNA) 1376 (T.T.A.B. 1994). Despite the misspelling of Buddha, the logo strongly suggests an intent to refer to Buddha.

103. *Id.*

104. In the modern era, most claims brought under disparagement are related to religion and identity issues, and that is the focus of this Article. However, a separate test is sometimes used when a corporation claims that another trademark disparages that company. In the paradigmatic and seminal case, *The Greyhound Corporation* claimed disparagement by a mark for shirts consisting of a greyhound-shaped dog shadow defecating. See *The Greyhound Corp. vs. Both Worlds, Inc. d.b.a. The Wild Berry*, 1988 TTAB LEXIS 78 (T.T.A.B. Mar. 30, 1988) (stating that disparagement is "essentially a violation of one's right of privacy—the right to be 'let alone' from contempt or ridicule."). Apparently based on the distinct claim of *commercial* disparagement, the two pronged test created by the T.T.A.B. for a corporate claim of disparagement is: "(1) that the communication reasonably would be understood as referring to the plaintiff and (2) that the communication is disparaging, that is, would be considered offensive or objectionable by a reasonable person of ordinary sensibilities." *Id.* (citing *Eagle's Eye, Inc. v. Ambler Fashion Shop, Inc.*, 227 U.S.P.Q. (BNA) 1018, 1023 (E.D. Pa. 1985)). Despite the fact that it seems to be

II. THE DISPUTE OVER THE WASHINGTON TEAM MARKS AND ITS IMPACT ON DISPARAGEMENT

In 1992, seven Native Americans filed a petition to cancel the Washington team's marks as both scandalous and disparaging to Native Americans.¹⁰⁵ These marks vary from simple word marks, including WASHINGTON R__S__S, R__S__S, and R__S__ETTES, to marks combining Washington team words with a portrait of a Native American in profile or the profile with a spear.¹⁰⁶ They were registered between 1967 and 1990.¹⁰⁷ Although the Petitioners raised scandalousness, the bulk of the evidence and the decisions focus on the disparaging prohibition.

The Petitioners argued “r__s__s” arises from a historical setting where the term was used by Euro-Americans to segregate and subjugate Native Americans and identify Native Americans as violent savages; even after the U.S. government began to display more respect towards Native Americans, the general public continued to “view and portray Native Americans as ‘simple “savages” whose culture was treated mainly as a source of amusement for white culture.’”¹⁰⁸ Among other evidence and testimony, each of the Petitioners described situations where the term was directed at them in a derogatory manner, causing anger and humiliation, and described how the Washington team's various marks are insulting, portray a negative stereotype, and demean women.¹⁰⁹

The Respondents argued that, far from being offensive, the r__s__s term is “[a] neutral and ordinary term of reference” denoting Native Americans.¹¹⁰ Moreover, because of its long use, the Washington team has created a secondary meaning for the phrase Washington R__s__s, which now refers to the professional football team and creates positive, rather than negative, associations.¹¹¹ Respondents also argued that the marks could only be offensive if the *products* associated with Respondent's mark

based on an entirely different type of claim, the T.T.A.B. has applied the *Greyhound* test for other “corporate” claims of disparagement. *See* New York Yankees P'ship v. Evil Enter., Inc., 2013 TTAB LEXIS 72 (T.T.A.B. Feb. 8, 2013) (sustaining an opposition on non-disparagement grounds for BASEBALL'S EVIL EMPIRE for clothing); Bd. of Trs. of Univ. of Ala. and Bryant v. Pitts and Blackburn, 2013 TTAB LEXIS 370 (T.T.A.B. July 23, 2012) (dismissing an opposition on numerous grounds for HOUNDSTOOTH MAFIA stylized mark for clothing); Boston Red Sox Baseball Club Ltd. P'ship v. Sherman, 88 U.S.P.Q.2d (BNA) 1581 (T.T.A.B. Sept. 8, 2008) (sustaining the opposition on several grounds, including disparagement, for SEX ROD on clothing).

105. *See* Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d (BNA) 1705, 1707-08 (T.T.A.B. 1999).

106. *See id.* at 1741.

107. *See id.* at 1741.

108. *Id.* at 1720.

109. *See id.* at 1723-24.

110. *See id.* at 1720.

111. *See Harjo*, 50 U.S.P.Q.2d (BNA) at 1720.

are offensive *per se* or to the referred group's specific religious/cultural practices, which is not the case here.¹¹² Respondents next argued that the term is neutral absent contextual adjectives that create pejorative phrases.¹¹³ According to the Washington team, its trademarks could not reinforce a stereotype of violence, and any connection with warfare is due to Native Americans' "troubled history," not the term or the team.¹¹⁴ Additionally, in the context of football, the term would not be negative; rather, the team name reflects "positive attributes of the American Indian such as dedication, courage and pride."¹¹⁵ Finally, perhaps assuming that intent matters, the Washington team argued that its intent in adopting the mark was purely positive.¹¹⁶

In determining if the marks were disparaging, the TTAB started by identifying the relevant time period, the time of registration.¹¹⁷ It proceeded to create the first consistent test for disparagement of identity or religion. As with scandalousness, the TTAB started by defining the term "disparage" as it was defined at the time of the legislative enactment: whether, in relation to persons, institutions, beliefs, or national symbols, "such matter may dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison."¹¹⁸ Then, it applied a two-step test that directly parallels the scandalousness test: (1) determine the likely meaning of the matter in question, in relation to other elements of the mark, the associated products, and the context of the marketplace; and (2) determine whether that meaning may be disparaging to a substantial composite of the referenced group (rather than the general public).¹¹⁹ The TTAB rejected any notion that negative intent was required because the statutory language included "may."¹²⁰ Although it placed the analytic focus on whether the mark "may be perceived as disparaging," it also noted that intent to disparage or not disparage could be a factor.¹²¹

112. See *id.* at 1720-21.

113. See *id.* at 1721.

114. See *id.*

115. *Id.*

116. *Id.*

117. See *Harjo*, 50 U.S.P.Q.2d (BNA) at 1735.

118. See *id.* at 1738.

119. See *id.* at 1738-39.

120. See *id.* at 1738, 1738 n.100.

121. See *id.* One recent decision, in the context of national origin, suggests that intent is highly relevant. In *In re Prosynthesis Laboratories*, 2012 WL 1267929 (T.T.A.B. Mar. 23, 2012), the T.T.A.B. reversed the refusal to register CHINA FREE (and design) for vitamins and mineral supplements. Arguing that it merely provides information that the supplements are not from China, the T.T.A.B. rejected the argument that it was implying that ingredients from China, and China itself, are bad. See *id.* at 7-8. It seemed to seek out evidence of animus or prejudicial intent as if that was relevant. See *id.* at 13. Perhaps some of the unexpected conclusions in this case stem from its blending of the *Harjo* standard with that of *Greyhound*. See *id.* at 13.

The initial TTAB decision held that the meaning of *res* denotes Native Americans, and the Washington team's use of Native American imagery does not detract from that denotation.¹²² The TTAB found that the term is not *per se* disparaging nor are the design elements of the marks, the Native American profile and the spear.¹²³ However, based on the cumulative effect of the record, the TTAB held for the petitioners, finding that the Washington team's marks are disparaging.¹²⁴ Various subsequent appellate decisions held that the Petitioners in this case were barred by laches; they waited too long after reaching the age of majority to bring their claims.¹²⁵ In the alternative, the initial appellate decision found that there was insufficient evidence that, at the time of registration, the marks were perceived by a substantial composite of Native Americans as disparaging.¹²⁶ Of course, the solution to the laches problem was to bring a new petition with younger Native Americans who could file the petition quickly after reaching the age of majority. That is precisely what happened, and as of the most recent decision, the *Blackhorse* petition has led to the cancellation of the Washington team's marks.¹²⁷ The Washington team has utilized their option to obtain *de novo* review in federal district court, which is now pending.¹²⁸

After the TTAB identified a new disparagement standard in *Harjo*, disparagement rejections have apparently increased because the number of TTAB reviews have increased, and nearly all identity or religious based cases apply the *Harjo* two step analysis.¹²⁹ Additionally, most arguments on appeal before the TTAB are premised on race/ethnicity/gender or religious concerns.¹³⁰ With respect to race or ethnicity, the bulk are claims that certain terms associated with criminal life, such as "mafia," harm Italian-

122. See *Harjo*, 50 U.S.P.Q.2d (BNA) at 1741-42.

123. See *id.* at 1743.

124. See *id.* at 1743-48.

125. See *Pro Football, Inc. v. Harjo*, 565 F.3d 880 (D.C. Cir. 2009) (affirming decision that the final Petitioner was barred by laches); *Pro-Football, Inc. v. Harjo*, 415 F.3d 44, 47-50 (D.C. Cir. 2005) (remanding for appropriate standard in assessing laches for one final Petitioner); *Pro-Football, Inc. v. Harjo*, 567 F.Supp. 2d 46 (D.D.C. 2010) (finding that the final Petitioner was barred by laches); *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 136-44 (D.D.C. 2003) (affirming that laches is an available and applicable defense).

126. See *Harjo*, 284 F. Supp. 2d at 113-36.

127. See *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d (BNA) 1080 (T.T.A.B. June 18, 2014).

128. See *Pro-Football v. Blackhorse*, 2014 WL 6682640 (E.D. Va. Nov. 25, 2014).

129. In *The Board of Trustees of the University of Alabama v. Pitts*, the T.T.A.B. did not apply the *Harjo* standard in assessing whether a stylized version of HOUNDSTOOTH MAFIA for clothing is disparaging. 107 U.S.P.Q.2d (BNA) 2001 (T.T.A.B. 2013). Instead, it applied the *Greyhound* test because the University argued that its commercial interests were at play. *Id.* at 29.

130. But see *In re Prosynthesis Laboratories*, 2012 WL 1267929 (T.T.A.B. Mar. 23, 2012) (treated more as a national origin of goods case in reversing the refusal to register CHINA FREE (and design) for vitamins and mineral supplements).

Americans; applicants who have appealed these refusals have universally succeeded.¹³¹

The remaining decisions raise interesting issues. In *Boswell v. Mavety Media Group*, Anita Boswell and James Clement argued that BLACK TAIL for adult entertainment magazines was disparaging both because of gender and at the intersectionality of race and gender.¹³² Notably, the TTAB looked extensively to a prior scandalousness decision for this application to determine the relevant types of evidence.¹³³ While refusing to require surveys to demonstrate disparagement, an expensive endeavor, the TTAB allowed the mark to register because the dictionary and ten submitted magazines were insufficient to prove the offense.¹³⁴ Another dispute around SQUAW and SQUAW ONE found most of the applicant's marks disparaging except where, due to the associated goods, it may be perceived as referencing a geographic location for skiing rather than a racial slur referencing a Native American woman; for the latter, the TTAB reversed the refusal to register.¹³⁵ Most recently, an Asian-American band member applied to register THE SLANTS, arguing that it was, in essence, taking back the power of a slur against Asians by turning it into something positive.¹³⁶ The application was denied. Despite the "good intentions underlying his use of the term," it was a term that, in context, is perceived as a slur and offensive by a substantial composite of the targeted group.¹³⁷ The Federal Circuit initially affirmed the TTAB's denial of the application as dis-

131. See *Bd. of Trs. of Univ. of Ala.*, 107 U.S.P.Q.2d (BNA) 2001 (dismissing disparagement claim on a stylized HOUNDSTOOTH MAFIA for clothing); *In re Mothers and Fathers Italian Ass'n*, 2000 TTAB LEXIS 52 (reversing refusal of MAFIA BRAND for various foods); *In re Undeas*, 2000 TTAB LEXIS 39 (reversing refusal of JUNIOR M.A.F.I.A. for entertainment services and recordings); *Order Sons of Italy in Am. v. The Memphis Mafia, Inc.*, 52 U.S.P.Q.2d (BNA) 1364 (T.T.A.B. 1999) (rejecting that "mafia" in THE MEMPHIS MAFIA would disparage members of the Order or Italian-Americans); *Order Sons of Italy in Am. vs. Callisi*, 1999 WL 450012 (T.T.A.B. June 29, 1999) (dismissing opposition to GOODFELLAS and design for entertainment services and noting that numerous successful prior oppositions against MAFIA, MA-FI-O-SO, DON VITO, MAFIA BOB, AND MAFIA FOR MOB all received judgment by default).

132. See 52 U.S.P.Q.2d (BNA) 1600 (T.T.A.B. July 28, 1999).

133. See *id.* Boswell and Clement originally also argued scandalousness but wisely dropped it. During the examination process, the USPTO Examiner refused to register the trademark as scandalous, which was affirmed by the TTAB but reversed by the Federal Circuit in 1994. See *In re Mavety Media Group Ltd.*, 33 F.3d 1367 (Fed. Cir. 1994). Despite the length of time, Boswell and Clement were opposing the same trademark application.

134. See *Boswell*, 52 U.S.P.Q.2d (BNA) 1600.

135. See *In re Squaw Valley Development Company*, 80 U.S.P.Q.2d (BNA) 1264 (T.T.A.B. 2006).

136. See *In re Tam*, 108 U.S.P.Q.2d (BNA) 1305 (T.T.A.B. Sept. 26, 2013).

137. See *id.* at 1312.

paraging, which was then vacated based on “[a] sua sponte request for a poll on whether to consider this case en banc.”¹³⁸

Religion also remains a significant basis for objection. Similar to *In re Tam*, the TTAB in *In re Heeb Media* affirmed the refusal to register a magazine aimed at reclaiming a Jewish slur, despite its good intentions, because the term was so offensive to a substantial composite of the Jewish faith.¹³⁹ It should be noted that the reclaiming argument may have been successful at the Examiner level when made in the sexual orientation context.¹⁴⁰

A more recent religious-based disparagement case, *In re Lebanese Arak Corporation*, returns to a familiar issue in at least two ways. As in the past, the TTAB assessed the tenets of the referenced religion, affirming the refusal to register KHORAN for wine as the term appears to refer to Islam, and Muslims are forbidden to drink alcohol.¹⁴¹ Additionally, the dissent resurrected the question of who matters even within the context of a disparagement claim.¹⁴² The majority recognized that disparagement protects the sensibilities of an ethnic or religious group, many of whom cannot be adequately protected under the scandalous prohibition because they are small minorities.¹⁴³ In determining whether the mark KHORAN would be seen as identifying the holy Muslim text, the majority opinion looked to the referenced group’s perception, a decision subsequently questioned by the dissent as “loading the deck” in ways that will cause the mark to be rejected as disparaging “despite the fact that most Americans attribute a different and inoffensive meaning to the mark.”¹⁴⁴ Once again, the issue is whether perceptions of the minority group will be assessed and heard or whether the majority opinion is all that matters. In this case, the former garnered more votes.

138. See *In re Tam*, 2015 U.S. App. LEXIS 6430 (Fed. Cir. Apr. 20, 2015), vacated by 2015 U.S. App. LEXIS 6840 (Fed. Cir. Apr. 27, 2015). Although this Article does not address concerns that the disparaging prohibition is unconstitutional under the First Amendment, the *en banc* review specially added an additional question related to the constitutionality of the disparagement prohibition under the First Amendment. 2015 U.S. App. LEXIS 6840, at *2.

139. See *In re Heeb Media*, 2008 TTAB LEXIS 65 (T.T.A.B. Nov. 26, 2008) (affirming refusal of HEEB for clothing and entertainment).

140. An opposition to DYKES ON BIKES was dismissed on standing. See *McDermott v. San Francisco Women’s Motorcycle Contingent*, 240 Fed. Appx. 865 (Fed. Cir. 2007) (affirming dismissal due to lack of standing). Although the Examiner raised disparagement three times during prosecution of the application, the mark was allowed to proceed through registration as of December 5, 2005 after the applicant filed a few things in an *ex parte* appeal. See Serial No. 78/281,746, file history (including Office Action dated Feb. 20, 2004, Office Action dated Oct. 28, 2004, and Reconsideration Letter dated May 25, 2005).

141. See *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215 (T.T.A.B. 2010) (affirming refusal of KHORAN for alcoholic beverages).

142. See *id.* at 1216.

143. See *id.*

144. See *id.* at 1222.

The applicants in one of the most recent decisions, rejecting STOP THE ISLAMISATION OF AMERICA for services related to understanding and preventing terrorism, represent a group recognized by the Southern Poverty Law Center as an Anti-Muslim hate group in New York.¹⁴⁵ The rejection was premised on finding that the phrase is anti-Muslim and disparaging (connecting Islam and terrorism/violence or perhaps suggesting that the religion should not be permitted or allowed to grow in America).¹⁴⁶ The applicants lost their appeal, and their petition for certiorari, partly premised on First Amendment arguments, was denied.¹⁴⁷

These cases further developed the notion of context as affecting the disparagement determination. As noted in the recent *Blackhorse* TTAB decision, disparaging cases may be treated as falling within one of three categories: (1) there is an innocuous term that, in context, becomes a disparaging one; (2) a term that may otherwise seem disparaging may, in context, be stripped of the offensiveness; and (3) the context may be insufficient to change the disparaging meaning of the mark.¹⁴⁸ Whose context matters. Without taking into account the strong interests in protecting members of minority groups, the disparagement claim cannot consistently serve to protect minority members.

III. DETANGLING THE DISPARAGING PROHIBITION

Because they are the two that do not appear to relate to unfair competition concerns, it is natural to associate the scandalous and disparaging prohibitions. Doing so, however, can force too much symmetry. Although the legislative history is sparse, at a minimum, the language changes indicate that disparaging was intended to be a broad protection for those who need it. More importantly, drawing parallels obfuscates the unique, important, and necessary protections of the disparaging prohibition for non-majority populations.

A. *The Practice of Blending Scandalous and Disparaging Registration Prohibitions*

First, the notion of conceptually combining the scandalous and disparaging registration prohibitions began early. In the first reported decision

145. See *In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014); Southern Poverty Law Center, *Active Anti-Muslim Groups*, available at <http://www.splcenter.org/node/3502/activegroups> (2014).

146. See *In re Geller*, 751 F.3d at 1358-62.

147. See *Geller v. PTO*, 2015 U.S. LEXIS 220 (Jan. 12, 2015). Although this Article does not intend to address First Amendment issues, I should note that SOIA bases at least part of its argument on the belief that its political speech is being chilled. See, e.g., Tony Dutra, *Cert Petition Faults Disparaging Trademark Analysis, Standard in 'Stop Islamisation' Case*, BNA, (Aug. 18, 2014), available at <http://www.bna.com/cert-petition-faults-n17179894028/>.

148. See *Blackhorse v. Pro-Football Inc.*, 2014 TTAB LEXIS 231, 29-30 (T.T.A.B. June 18, 2014). Even the Washington team's expert admitted that some racial terms are inherently disparaging regardless of context, such as the n-word. See *id.* at *30 n.43.

applying the disparaging prohibition, the Examiner in Chief drew parallels to prior scandalous decisions when describing the criteria for its evaluation, noting that the mark must be assessed in the context of the associated goods or services.¹⁴⁹ Subsequent decisions continued the trend of comparing scandalous decisions with disparaging and vice versa.¹⁵⁰

A more troubling indicia of confusion between the scandalous and disparaging registration prohibition appears in some early decisions involving religious-based objections to registrations. Some of the earliest decisions applying the scandalous registration prohibition involved marks that invoked Christianity, a specific group within the larger population. For example, in 1938, The Court of Customs and Patent Appeals affirmed the refusal to register MADONNA for wines on the basis that it would be scandalous to take “the highest example of the purity of womanhood” and associate her with wine for drinking.¹⁵¹ The majority opinion even opined that it would be of “very doubtful propriety” to commercialize the name or representation of the Virgin Mary at all.¹⁵² A later decision reiterated that commercializing a similar religious symbol, AGNUS DEI with pictorial representation, would be offensive to most Christians—even though it was applied to metallic tabernacle safes used and presumably purchased by Catholic clergy.¹⁵³ Perhaps such sensitivity to Christian beliefs and symbols is understandably characterized as scandalous as even today the majority religious tradition in the United States remains Christianity by a wide margin.¹⁵⁴ And these decisions occurred before the disparaging prohibition existed, making scandalous the only option to prohibit the registration. The problem with mixing the scandalous and disparaging prohibitions becomes clearer when the decision-makers were later faced with non-Christian religious symbols and terms.

The first reported decision to confront non-Christian religious traditions is *In re Reemtsma Cigarettenfabriken*, involving an application to register SENUSSI for cigarettes.¹⁵⁵ In finding that the mark should be refused registration, the TTAB stated that

149. See *Doughboy Indus., Inc. v. The Reese Chem. Co.*, 88 U.S.P.Q. (BNA) 227 (1951).

150. See, e.g., *Ex parte Parfum L’Orle, Inc.*, 93 U.S.P.Q. (BNA) 481 (P.T.O. 1952) (referring to the DOUGHBOY decision in assessing whether LIBIDO for perfumes and toilet waters would be scandalous).

151. See *In re Riverbank Canning Co.*, 95 F.2d 327, 327, 329 (C.C.P.A. 1938).

152. See *id.* at 329. Despite the majority’s position, the dissent noted that MADONNA has been registered numerous times on different articles of trade. *Id.* at 329-30.

153. See also *Ex parte Summit Brass & Bronze Works, Inc.*, 59 U.S.P.Q. (BNA) 22 (Comm’r Pats. 1943).

154. See THE PEW FORUM ON RELIGION AND PUBLIC LIFE, *U.S. Religious Landscape Survey: Religious Affiliation: Diverse and Dynamic*, 10-12 (Feb. 2008), <http://religions.pewforum.org/pdf/report-religious-landscape-study-full.pdf>.

155. See 122 U.S.P.Q. (BNA) 339, 339 (T.T.A.B. 1959).

[t]he application of the name of any religious order or sect to a product whose use is forbidden to the followers or adherents of such sect or order is an affront to such persons and tends to DISPARAGE their beliefs. The use of “SENUSSI” on cigarettes, therefore, would be SCANDALOUS within the purview of Section 2(a) of the Act of 1946 and is not entitled to registration.¹⁵⁶

One can assume that, at that time, the general population would not know that the Senussi sect is prohibited from smoking.¹⁵⁷ Even though the current standard for assessing scandalous trademarks is to evaluate whether the mark would be scandalous to a substantial composite of the *general public*, decision-makers certainly were inconsistent for decades in assessing the relevant population for a scandalous objection.¹⁵⁸ Perhaps there was an assumption that offending someone’s religion would, in and of itself, be considered scandalous to the general population.

Confusion about the tenants of non-majority (or smaller population) religions caused problems in a subsequent decision involving tobacco, *In re Waughtel*, where the Trademark Examiner refused to register AMISH and design for cigars and cigar boxes.¹⁵⁹ The Examiner rejected the mark as scandalous because it would be disparaging under the targeted group’s religious tenets as he believed the Amish were forbidden to use tobacco.¹⁶⁰ Unfortunately for the Examiner, the applicant provided proof during appellate review, affidavits from two Amish men, that the religion does not forbid tobacco in any form.¹⁶¹ The application was allowed to register because it was not scandalous. Some may categorize this as a problem—the Examiner raising religious concerns incorrectly. However, in the proper examination process, most such mistakes would be resolved when the applicant responds to the Examiner with additional, verified information.

These examples demonstrate two concerns with blending scandalous and disparaging registration prohibitions. First, neither of these cases involved a third party challenge to the registration. It was incumbent upon the Trademark Examiner (or perhaps the reviewing body as in the case of DOUGHBOY) to catch the issue and raise it, and that assumes that the Examiner properly understands the scope of the targeted groups beliefs or position. However, placing the burden on members of any group to catch

156. *Id.* (emphasis added).

157. A later decision recognized that this decision blended the distinctions between scandalous and disparaging but did not resolve the issue of how to divide the two. *See Jacobs v. Int’l Multifoods Corp.*, 211 U.S.P.Q. (BNA) 165 n.4, 169 (1981).

158. *See Abdel-khalik*, *supra* note 40, at 210.

159. *See* 138 U.S.P.Q. (BNA) 594 (1963).

160. *See id.*

161. *See id.* Amish in Lancaster County, Pennsylvania, have been raising tobacco since about 1838. JOHN A. HOSTETLER, *AMISH SOCIETY* 120 (4th ed. 1993).

every offensive trademark before it is registered and used (and thus often before the applicant has invested in the mark) seems quite unlikely as well as an abdication of the PTO's examination responsibility. Second, it suggests that protection of the targeted group is in the hands of the general population. Especially once it became clear that the scandalous prohibition only applies to marks that are offensive to a substantial composite of the general population, any blending between scandalous and disparaging would not only undermine the distinctions between these two provisions of the Lanham Act, but would also limit protection of targeted groups from terms or images that the majority may not find offensive. After all, religious terms that previously would be scandalous are now regularly allowed to register. For example, the two marks previously rejected as scandalous, MADONNA and AGNUS DEI, are now registered trademarks,¹⁶² including one application for MADONNA for wine.¹⁶³ These new registrations suggest that objections rooted in some sort of antipathy to commercializing religious terms and images has dissipated—for the general public. If an applicant uses a term or image from a smaller group, perhaps its religious tenets would lead to an objection to commercialization. Such a group could no longer rely for protection upon a general population's antipathy to commercializing religious terms, images, or emblems.

A fairly recent decision, but still pre-*Harjo* demonstrates the subsequent lack of protection for targeted, non-majority religious groups. In 1988, In Over Our Heads, Inc. filed an application for the mark MOONIES (with a buttocks design) for a doll.¹⁶⁴ It is true that the term "mooning" is a slang term associated with someone dropping their clothes and exposing a naked backside,¹⁶⁵ and given the mark's design and the description of the doll in argument, that certainly seems the likely intended meaning. However, Moonies, the noun form, only has one recognized meaning—it refers to the followers of Korean Reverend Sun Myung Moon and his Unification Church.¹⁶⁶ The Unification Church is a small

162. See, e.g., MADONNA FROM MODENA, U.S. Trademark Reg. No. 4,013,813 (filed Aug. 26, 2010); MADONNA DELLA SCOPERTA, U.S. Trademark Reg. No. 4,010,795 (filed Apr. 23, 2009); AGNUS DEI CLOTHING, U.S. Trademark Reg. No. 3,693,910 (filed on Sept. 16, 2008); MADONNA PERINATAL SERVICES, U.S. Trademark Reg. No. 3,515,216 (filed Nov. 13, 2007); DA VINCI MADONNA, U.S. Trademark Reg. No. 2,277,700 (filed May 26, 1998); MADONNA JEWELS, U.S. Trademark Reg. No. 1,660,751 (filed April 26, 1990); MADONNA, U.S. Trademark Reg. No. 1,473,554 (filed Dec. 9, 1985); MADONNA, U.S. Trademark Reg. No. 1,463,601 (filed Dec. 9, 1985); MADONNA, U.S. Trademark Reg. No. 1,386,990 (filed Aug. 5, 1985); MADONNA, U.S. Trademark Reg. No. 762,471 (filed Oct. 3, 1960).

163. See MADONNA, U.S. Trademark Reg. No. 3,545,635 (filed Sept. 15, 2006).

164. See U.S. Serial No. 73/755,278.

165. See *Mooning*, DICTIONARY.COM, Def. No. 11, <http://dictionary.reference.com/browse/mooning?s=t> (identified as slang definition).

166. See *Unification Church*, MODERN DICTIONARY FOR THE LEGAL PROFESSION (3d ed. 2001); Moonies, DICTIONARY.COM, <http://dictionary.reference.com/browse/moonies?s=t>.

group and highly controversial, often labeled a cult.¹⁶⁷ The Examiner rejected the MOONIES application as a “mark [that] comprises SCANDALOUS matter which DISPARAGES The Unification Church. . . .”¹⁶⁸ As noted by the TTAB, it was entirely unclear whether the Examiner relied on the scandalous or disparaging registration prohibition.¹⁶⁹ Calling it a close case, the TTAB reversed, finding that

Applicant’s mark MOONIES – with its naked buttocks design and spelled without emphasizing the letter “m” – would, when used on a doll, most likely be perceived as indicating that the doll “moons,” and would not be perceived as referencing members of The Unification Church.¹⁷⁰

In a footnote, the TTAB noted that the record contained some evidence that the term “may be viewed *by some members of that religious group* as being derogatory.”¹⁷¹ The TTAB discounted that evidence. Because dictionaries, major newspapers, and magazines used the term Moonies as if it were non-derogatory, the TTAB ruled on the assumption that Moonies is an accepted and acceptable term for members of The Unification Church.¹⁷² The Moonies may not be the most sympathetic example given claims that they are a cult, the criticized mass marriages, and the like.¹⁷³ Regardless, the Unification Church is an exemplar of a small institution with few members as compared to other religions.¹⁷⁴ When considering the concerns of a small group, the TTAB discounted the term’s impact on its followers because of the language choice of the general population.¹⁷⁵

The blending of scandalous and disparaging prohibitions, explicitly, has done precisely what one would predict and fear if done implicitly, still possible post-*Harjo*, and that is to allow the majority opinion as to meaning and insult dominate over any referenced small group perceptions. In evaluating disparagement, the TTAB used as the relevant referent the general

167. See, e.g., Emine Saner, *I Was a Moonie Cult Leader*, THE GUARDIAN (Sept. 3, 2012), <http://www.theguardian.com/world/2012/sep/03/moonie-cult-leader>.

168. *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1653 (T.T.A.B. 1990) (emphasis added).

169. *Id.* at 1653 n.2.

170. *Id.* at 1654.

171. *Id.* at 1654, n.4 (emphasis added)

172. *Id.*

173. See, e.g., Saner, *supra* note 167; Daniel J. Wakin, *Rev. Sun Myung Moon, Self-Proclaimed Messiah Who Built Religious Movement, Dies at 92*, N.Y. TIMES (Sept. 2, 2012), available at http://www.nytimes.com/2012/09/03/world/asia/rev-sun-myung-moon-founder-of-unification-church-dies-at-92.html?pagewanted=all&_r=0.

174. While The Unification Church estimated its membership at 3 million, authorities suggest that the membership was 50,000 at the height of the Church’s reach. See Wakin, *supra* note 173.

175. *Id.*

public and its perception of the term (via dictionaries, newspapers, and magazines) regardless of whether it would be seen as offensive to members of The Unification Church. After all, the reasoning is, the majority would never use such an offensive term in such a public and consistent manner. And yet Native Americans have been protesting the common use of *r_s_s* for more than two decades at this point. Only recently has the general public opened its mind to the objections.

This is not to say that, had the TTAB assessed the MOONIES application from the perspective of the non-majority group members, it would have reached a different result. The critique is not the result (nor can it be) but the process. As the current dispute regarding the Washington team demonstrates, what the majority considers scandalous often discounts or blatantly ignores the perceptions of the targeted group. Charitably, one hopes it is because the majority group has not been exposed to indicia of harm. The application process can rectify that lack.

B. *Blending the Justifications Hides the Distinct Need for a Disparaging Prohibition*

It is undisputed that the TTAB's decision in *Harjo* is the first articulation of the modern disparagement test, which, on its face, appears to separate the disparaging and scandalous prohibitions. However, it created the test by relying on the scandalousness precedent. The District Court for the District of Columbia noted that there is no error in treating the two as similar because (1) the TTAB noted differences where appropriate (by substituting disparaging for scandalousness and changing the relevant impact audience), and (2) there is little legislative history to provide guidance.¹⁷⁶ However, the framework insufficiently addresses the different policy interests at play and statutory language differences. In so doing, it runs the risk of masking the distinct benefit afforded by the disparaging prohibition to identity and religious objections.

On its face, the scandalous prohibition is unrelated to the concerns that animate trademark protection—consumer confusion, encouraging better quality products, providing information to consumers, and any other related concern.¹⁷⁷ The legislative history provides no direct, clear answer as to why Congress enacted the prohibition although one contemporary commentator considered the justification to be “obvious.”¹⁷⁸ Subsequently, two justifications have been posited. First, there was a concern

176. See *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 124 (D.D.C. 2003).

177. See, e.g., Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661, 673-74 (1993); see also ROGER E. SCHECHTER & JOHN R. THOMAS, *INTELLECTUAL PROPERTY: THE LAW OF COPYRIGHTS, PATENTS AND TRADEMARKS* 600 (2003) (noting that the scandalous registration prohibition, unlike other prohibitions, is unrelated to competitors communicating with the public or avoiding deception).

178. TRADEMARKS, TRADE NAMES: FOR THE BUSINESSMAN 25 (Munn & Co., 1912).

that a federal registration would be perceived as implicit, governmental approval of the mark.¹⁷⁹ After the first fell from favor,¹⁸⁰ courts raised the second justification, that scandalous marks should not occupy the time, services, and use of federal funds.¹⁸¹ At its root, such a justification is still a decision that certain marks are of less value, and the lesser value simply cannot be based on an unfair competition concern. Regardless, courts have rejected any implication that §2(a) reflects an intent to regulate morality.¹⁸²

Courts have stated even less regarding why we have the disparaging prohibition. In the context of laches, the initial *Harjo* decision held that there is a public policy interest in preventing registration where the marks may “hold a substantial segment of the population up to public ridicule.”¹⁸³ The *Harjo* and *Blackhorse* decisions, and the spurt of reports and studies in the wake of the dispute, have shown these consequences to the targeted population in stark relief. First, there are harms caused by stereotyping. As noted by a counseling psychology expert in the *Harjo* matter, stereotyping in culture can negatively impact members of the target group by objectifying and dehumanizing.¹⁸⁴ These conclusions are substantiated by studies assessing the negative impact of stereotypes on women and African Americans as well as Native Americans.¹⁸⁵ Numerous studies demonstrate that racial slurs and similar forms of discrimination affect the mental and physical health of the targeted group’s members.¹⁸⁶ The consequences include depression and low self-esteem, which can result in aggressive be-

179. WILLIAM EVARTS RICHARDS & WILLIAM WALLACE WHITE, UNITED STATES PATENTS, TRADE MARKS, DESIGNS AND COPYRIGHTS 91, 92 (2d ed. 1896); *In re McGinley*, 660 F.2d 481, 483 (C.C.P.A. 1981); see also *Ritchie v. Simpson*, 41 U.S.P.Q.2d (BNA) 1859, 1861-62 (T.T.A.B. 1997), *rev’d on other grounds*, 170 F.3d 1092 (Fed. Cir. 1999) (“[J]ust as the issuance of a registration does not indicate any endorsement of the goods on which the mark is used, it also does not imply the government’s pronouncement that the mark is a good one, from an aesthetic or any other viewpoint.”).

180. See, e.g., *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1220 n.3 (T.T.A.B. 1993).

181. *In re McGinley*, 660 F.2d at 486. But see *In re McGinley*, 660 F.2d at 487 (Rich, J., dissenting) (“More ‘public funds’ are being expended in the prosecution of this appeal than would ever result from the registration of the mark.”).

182. See, e.g., *In re McGinley*, 660 F.2d at 486.

183. *Harjo v. Pro Football, Inc.*, 30 U.S.P.Q.3d (BNA) 1828, 1831 (T.T.A.B. 1994)

184. See *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1707-08 (T.T.A.B. 1999).

185. See, e.g., Michael A. Friedman, *The Harmful Psychological Effects of the Washington Football Mascot*, 9-11, available at <http://www.changethemascot.org/wp-content/uploads/2013/10/DrFriedmanReport.pdf> (2013) (a report commissioned by the Oneida Indian Nation) (citing studies demonstrating negative impact of stereotyping on academic performance and body image).

186. See *id.* at 14-15 (citing studies related to African Americans, Latinos, gays and lesbians, the elderly, and obese as well as Native Americans).

havior years later and higher rates of suicide.¹⁸⁷ It also can create a hostile learning environment, decreasing students' ability to academically succeed.¹⁸⁸ Even when the stereotype was intended to be beneficial or to be positive, it still imparts psychological harm to members of the targeted group.¹⁸⁹

Not surprisingly, the negative stereotype is more readily identified as negative by those who are in the targeted population, and it impacts their self-esteem disproportionately.¹⁹⁰ However, studies specifically focused on Native American images demonstrate that stereotyping does impact those outside the target population by reinforcing negative attitudes.¹⁹¹ This negative reinforcement exists even when a flattering image of Chief Illiniwek, the University of Illinois mascot, was used—and even increased anti-Asian stereotypes at the same time.¹⁹² It also reinforces the notion that stereotyping, in and of itself, is an appropriate tool to use.¹⁹³ Further, based upon additional studies, these stereotypes result in strengthening implicit bias against Native American people and mascots¹⁹⁴ and dominate the conversation with such negativity that Native Americans cannot properly portray themselves or their various cultures.¹⁹⁵ These harms were also cited by the American Psychological Association in a 2005 resolution calling for the immediate retirement of Native American symbols and imagery from any level of school, and the resolution includes references to more than thirty studies.¹⁹⁶

The harms are numerous and well documented. Certainly, Congress may not have had this precise set of harms in mind when constructing the disparaging prohibition. But there are two key facts to show that they did intend the prohibition to have broad reach. The first is the use of “tends to” or “may” disparage. Either “tends to” or “may” allows for greater latitude than the language of other prohibitions. This suggests that Con-

187. See *Harjo*, 50 U.S.P.Q.2d (BNA) at 1727; Friedman, *supra* note 185, at 15, 16-17.

188. Erik Stegman & Victoria Phillips, *Missing the Point: The Real Impact of Native Mascots and Team Names on American Indian and Alaska Native Youth*, CTR. FOR AM. PROGRESS 5 (2014) [hereinafter Stegman & Phillips], available at <https://cdn.americanprogress.org/wp-content/uploads/2014/07/StegmanAIANmascots-reportv2.pdf>.

189. See Friedman, *supra* note 185, at 9, 10.

190. *Id.* at 11.

191. *Id.* at 11-13.

192. *Id.* at 12.

193. Stegman & Phillips, *supra* note 188, at 4 (citing a 2001 statement from the U.S. Commission on Civil Rights).

194. See Friedman, *supra* note 185, at 12.

195. Stegman & Phillips, *supra* note 188.

196. The American Psychological Association, Resolution Recommending the Immediate Retirement of American Indian Mascots, Symbols, Images, and Personalities by Schools, Colleges, Universities, Athletic Teams, and Organizations, <http://www.apa.org/about/policy/mascots.pdf> (2005).

gress was cognizant that the harm encapsulated by disparaging marks is so significant as to be prohibited based upon probability or even possibility rather than certainty at any level. Second, the failure to change the term “disparaging” is notable in the legislative history. When the USPTO representative complained that the term disparaging was too comprehensive to manage in the registration process, Representative Lanham invited the representative, and presumably the USPTO by extension, to submit better language. Yet, the word disparaging stayed in place. Now, we have choices regarding how to use it.

C. Choices

When considering the disparaging prohibition and how it can be used to protect against trademarks that offend based on identity and religion, there are at least three changes that should be made. As a predicate, decision-makers must be reminded that the relevant standard is offensive to a substantial composite, not the majority, of the referenced group at the relevant time. Evidence that a non-trivial segment of the targeted group is offended should be sufficient. This leads to the first change; the current two-pronged test places too high a burden of proof regarding the disparagement. When Congress changed from “tends to disparage” to “may disparage,” the language difference has meaning. Rather than seeking evidence that offense is probabilistic (tends), the evidentiary standard should be lowered to something less certain—even to acknowledge possibilities (may). Simply keeping in mind that the statutory language demands less certainty increases the chance that minority voices are heard regarding offense. Second, the current standard requires that, if there is doubt as to satisfying a prohibition’s requirements, the doubt falls in favor of the applicant; the application is allowed to proceed forward. When one takes into account both the broader statutory scope and the harm caused by identity and religiously offensive marks, the doubt presumption should flip the other way. When in doubt or in a close call, the examiner and TTAB should err on the side of exclusion. Not only does that comport with statutory language, but it also better reflects the unique harm caused by disparaging identity and religion marks—harms that relate to psychological well-being rather than economic concerns alone. Third, the majority decision’s position in *In re Lebanese Arak* must prevail and become incorporated into the disparaging test. When assessing the first prong, the likely meaning of the mark, it must be assessed from the referenced group’s perspective, not the general population. If there are multiple referenced groups, then they should all be identified to determine if the mark is offensive to any potentially relevant group. Again, this ties back to the unique justification for disparagement from that of scandalous, protecting smaller groups from significant harm.

The benefits from these changes affect both populations. Not only does it minimize the harm caused to the non-majority groups, it also pro-

vides greater information to the majority groups that may have been unaware of the offense. Once informed, the trademark applicants can make a choice. Do they want to hear the non-majority voices? Or will they choose to use the trademark anyway, which is their right under the common law (although without some benefits afforded by federal registration). Because most trademark applications are intent-to-use applications, meaning the applicant has not used the mark at the time of filing,¹⁹⁷ an informative and clearer message from the USPTO can also prevent an applicant from investing in a mark that may be offensive to a segment of the population (if it respects that concern) or, if it manages to register to mark, be aware that it may be challenged by third parties as disparaging.

CONCLUSION

There have been calls to abolish both the scandalous and disparaging trademark from a variety of sources and for a variety of reasons. Once again, conflating the two prohibitions can cause great harm by ignoring the unique problems that the disparaging prohibition can prevent. These harms, caused by “words that wound,” have long been recognized by legal scholars.¹⁹⁸ The disparaging prohibition provides a mechanism to help minimize words that wound and also can prevent uninformed adoption and acceptance by the general population of these harmful words and images. Certainly, the Washington team’s marks have rendered a racial slur part of common parlance and, as alleged, without alleviating the harm.

True, the prohibition is not a panacea. Trademark owners can continue to assert common law rights and otherwise have strong First Amendment rights as they should have. However, in the commercial context of choosing products to purchase, people should not have to be faced with such harmful terms potentially integrated into daily life without refuge. And when faced with the loss of registration benefits, entities can make an informed decision about whether non-majority voices, feelings, and harm matter.

197. Since the Intent-to-Use application became available, the number of Intent to Use Applications has grown as a percentage of overall applications and constituted more than half of all applications by 1993. Kenneth L. Port, *The Congressional Expansion of American Trademark Law: A Civil Law System in the Making*, 35 WAKE FOREST L. REV. 827, 836-37, n.45 (2000); see also Barton Beebe, *Is the TM Office a Rubber Stamp?*, 48 HOUS. L. REV. 751, 772-73 (2011) (noting 1,951,933 ITU applications and 1,336,759 use based applications between 1989 and 2007).

198. See, e.g., Richard Delgado, *Words that Wound: A Tort Action for Racial Insults, Epithets, and Name Calling*, 17 HARV. C.R.-C.L.L. REV. 133 (1982).

