



IP: Federal Circuit denies vulgar trademark to rooster-shaped lollipops

CASE REMINDS TRADEMARK APPLICANTS TO STUDY DICTIONARY MEANINGS BEFORE ASKING THE GOVERNMENT TO ENFORCE A POSSIBLY INAPPROPRIATE MARK

The Federal Circuit has concluded that it can, as a matter of law, determine when a trademark is not entitled to federal trademark registration because the mark is vulgar. In doing so, the court appears to have ignored or changed the standard of proof requirement that has been part of the law for nearly 20 years. The recent opinion from the Federal Circuit, *In re Marsha Fox*, decided Dec. 19, 2012, is one that counsel should consider when seeking registration for trademarks that can have multiple meanings, one of which may present risqué overtones.

In the U.S. Patent and Trademark Office (PTO), Marsha Fox sought a registration on a dual-element mark, consisting of a literal element of two words and a design element of a rooster-shaped chocolate lollipop. The application specified the goods as “chocolate suckers molded in the shape of a rooster.” According to the applicant, the goods were primarily sold in area of the University of South Carolina

and Jacksonville State University because of the athletic mascot of both teams. The literal element of the mark at issue in *Fox* is one that, if stated in this article, would be blocked by most spam filters. Consequently, that element will simply be referred to as the NSFW (not safe for work) Mark.

In the PTO, the examiner determined that the mark comprised immoral or scandalous matter and refused registration under 15 U.S.C. Section 1052(a). The examiner reached this decision by consulting a dictionary for the meanings of each separate word of the two-word NSFW Mark. The examiner then combined several of those meanings to reach her conclusion. In response, the applicant pointed out that one accepted dictionary definition of the first word in the mark was a “rooster” and that the dictionary definition of the second word was a “lollipop.” Although the examiner conceded that the applicant had presented evidence potentially supporting a relevant non-scandalous

meaning, the examiner concluded that a substantial composite of the general public would give the overall mark a scandalous meaning. Accordingly, registration was refused.

The Trademark Trial and Appeal Board affirmed the examiner. The board concluded that the word portion of the NSFW Mark used in connection with the applicant’s goods created a double entendre, where one meaning was vulgar and the other meaning was not.

At the Federal Circuit, the applicant argued that the board lacked substantial evidence to support its finding that the overall mark has a vulgar meaning. The applicant also argued that even if the overall mark has a vulgar meaning, precedent gives a double entendre mark some slack in terms of the proofs required to deny registration. Finally, the applicant argued that if there is doubt as to how the general public would view the mark, the court should permit publication

of the mark; that way, members of the public could oppose the mark's registration if there was, in fact, a perception that the overall mark was vulgar. The Federal Circuit rejected each argument.

As background, Section 1052(a) of the Lanham Act provides that a trademark may be denied registration if it "[c]onsists of or comprises immoral, deceptive, or scandalous matter." Under the court's precedent, whether a mark comprises scandalous matter is a conclusion of law based on underlying factual inquiries, with the factual findings of the board reviewed for substantial evidence. The court has previously provided a three-element framework for the PTO and the board to follow when addressing Section 1052(a). First the PTO must demonstrate that the mark is shocking to the sense of truth, decency or propriety; disgraceful; offensive; disreputable; gives offense to the conscience or moral feelings; or calls out for condemnation. Second, the PTO must consider the mark in the context of the marketplace as applied to only the goods described in the application for registration. Finally, whether the mark comprises scandalous matter is to be determined from the standpoint of a substantial composite of the general public, not necessarily a majority, and in the context of contemporary attitudes. As to the applicant's substantial evidence argument, the Federal Circuit seemed to ignore its precedent. Indeed, the court pointed to the dictionary definitions of each of the two-word literal elements, as well as

the definition of those two words when they are written as one word, that were relied on by the examiner and concluded that the literal element is a vulgar term in common usage. The court observed that the dictionaries' comments about the word(s) indicated that they were usually vulgar. The court also noted that the applicant admitted that the "humor of the mark is derived" from the "possibility of [a] double entendre." The court, however, did not address the lack of PTO evidence regarding the use of the mark in the marketplace as applied to the goods recited in the application or the lack of evidence as to how a substantial composite of the general public would perceive the mark. Thus, the dictionary definitions and applicant's double-entendre admission seemed to constitute substantial evidence sufficient for the court.

As noted, the applicant also argued that the overall mark could be considered a double entendre, and consequently, the PTO must present evidence as to how the general public would perceive the mark, given at least two different meanings. On this point, however, the applicant acknowledged that the mark's effect as a humorous double entendre requires the consumer to understand the non-vulgar and risqué meanings of the mark.

Here, too, the Federal Circuit rejected this argument. According to the court, there was no reason for the PTO to prove anything more than "the existence of a vulgar meaning to a substantial composite of the general public in order to justify

its refusal" to register the mark. In reaching this conclusion, the court again did not address the lack of evidence on the use of the mark in the marketplace as applied to the goods recited in the application or the lack of evidence just what constitutes a substantial composite of the general public. Apparently, proof sufficient to deny registration can be satisfied solely from dictionary meanings.

Finally, the applicant argued that the mark should be published so the public would have an opportunity to oppose registration if there was, in fact, a perception that overall mark was vulgar. The court also rejected this argument. Because the court determined that the PTO properly concluded the mark was scandalous within the meaning of Section 1052(a), there was no need to publish the mark for opposition purposes. Indeed, to permit publication would simply be using the time and effort of the PTO for a futile purpose.

The Federal Circuit did, however, give the applicant some solace. As the court stated, the applicant "will remain free to use her mark in commerce. She will be unable, however, to call upon the resources of the federal government in order to enforce that mark."

Practice tips

Fox highlights that when a brand owner is selecting a trademark, it is important to look at the dictionary meanings of the words used in the mark. If any of those meanings have a vulgar or scandalous definition, the brand

owner may want to revise the mark. This use of dictionaries is important because in *Fox*, the court did not require the PTO to provide any evidence as to the meaning that would be given to the mark in the actual marketplace where it will be used. In addition, the court did not require the PTO to identify the makeup of the substantial composite of the general public that is the universe of individuals who would determine whether or not the mark is vulgar. Finally, the court did not require the PTO to provide any evidence, such as a survey, from the substantial composite of the general public as to how they would perceive or understand the mark. This case thus boils down to the application of Supreme Court Justice Potter Stewart's "I know it when I see it" test in the 1964 case *Jacobellis v. Ohio*.

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