

THE LANHAM ACT'S UNCONSTITUTIONAL HODGEPODGE

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The Hodgepodge is a statutory monster. Lurching quietly and stalking with menace, the Hodgepodge picked off unsuspecting victims for decades. In broad daylight, the Hodgepodge snuck behind its victim placing a muzzle on their mouth. Anyone who gave a cross eye—ridiculed. Anyone who dare question the Hodgepodge's existence—a heretic. An amalgam of supposed morality and societal decency, the Government released the Hodgepodge on any citizen bold enough to wade into commercial waters without sensitivity to such morality and societal decency. For years, the Hodgepodge has been the Government's loyal hound, eager to deny federal protection to those stepping outside the bounds of accepted decorum. But, alas, the Hodgepodge may now be dead.

This is the story of Section 2(a) of the Lanham Act in the context of religious disparagement. Section 2(a)—the Hodgepodge¹—bars federal trademark registration of immoral, deceptive, scandalous or disparaging marks. For decades, the Government has used Section 2(a) as a means to deny the benefits of federal registration offending, *inter alia*, religious camps. However, on December 22, 2015, in the case of *In re Tam*, the United States Court of Appeals for the Federal Circuit held Section 2(a) to be an unconstitutional restraint on the First Amendment right of free speech—almost *seventy* years after the statute was passed.²

First, this Note will dive into the legal framework of trademark law and the First Amendment regarding speech-based

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¹ Referring to Section 2(a) as a “hodgepodge” seems to have first been used by Prof. Stephen Baird, *infra* n.56. Moreover, in *In re Tam*, Judge Kimberly Moore also saw fit to use the term. 808 F.3d 1321, 1329 (Fed. Cir. 2015) (“Section 2(a) . . . is a hodgepodge of restrictions.”) Therefore, the term “hodgepodge”—i.e., a heterogeneous mixture of things—seems as good as any.

² *Id.*

laws. Next, this Note reviews the history of Section 2(a), as well as discusses the law's application throughout the years to both mundane and truly offensive trademarks alike in the context of religiously themed trademarks. Then, this Note will discuss *In re Tam*—the case from late 2015 where the Federal Circuit held Section 2(a) unconstitutional. And finally, in light of *Tam*, we will take a quick look forward at what lies ahead for the Hodgepodge.

Ultimately, this Note sets out to do one thing: discuss Section 2(a)'s complex (and irrational) history in the context of religious themed trademarks. While issues relating to the Washington Redskins' trademark has been litigated in both the public arena and courts for decades, it is my contention that when the law is viewed through the lens of apparent religious disparagement, only then, can one see how truly arbitrary the Hodgepodge can be.

I. LEGAL FRAMEWORK

A threshold matter when it comes to the constitutionality of Section 2(a) is whether trademarks are in fact *speech* protected under the First Amendment. Generally speaking, this Note assumes that trademarks are speech. Nevertheless, here is a quick argument in support of that assumption. Trademarks are expressive and are therefore speech.³ As noted in *Texas v. Johnson*, speech is not limited to spoken or written word. Rather, the First Amendment comes into play when there is an intent to convey a particularized message and there is likelihood that people will understand the message.⁴ Under this *broad* view of speech, it is hard to argue that a trademark does not connote a message of quality or even the *purpose* of a product. In other words, a trademark is saying something. As the Supreme Court noted in *Qualitex Co. v. Jacobson Products Co.*, trademarks may include words, names, or symbols, and “human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning.”⁵

³ Consider Prof. Lisa Ramsey's article *Increasing First Amendment Scrutiny of Trademark Law*, 61 SMU L. REV. 381 (2008), for a nuanced argument that when trademark laws suppress or chill expression, then the First Amendment must play a role.

⁴ 491 U.S. 397, 404 (1989).

⁵ 514 U.S. 159, 162 (1995).

Importantly, the mere fact that trademarks are used in connection with a commercial transaction should not bar qualifying them as speech. For example, in *Sorrell v. IMS Health Inc.*, the Supreme Court recently held that a Vermont law, which restricted the dissemination of information regarding the prescribing practices of particular doctors, impinged the First Amendment rights of pharmaceutical manufacturers.⁶ In other words, if a pharmaceutical company discussing the prescription habits of doctors is speech (an act done with the intent of benefiting commercially), then a trademark must surely be as well. Consider the following examples. When you look at a Coca-Cola bottle, it portrays a certain kind of quality. When you see a Red Bull advertisement, it expresses a certain kind of lifestyle, and an invitation to adopt that lifestyle. And when you look at either the Republican or Democratic Party symbol, this connotes a message of political action and a call to “join up.” As such, trademarks must be a form of speech subject to First Amendment protections. Working off this assumption, the following is a general review of trademark law and First Amendment jurisprudence.

A. *Trademark Law*

A trademark is any word, name, symbol, and/or device used to identify and distinguish his or her goods.⁷ Simply put, if a producer uses a mark to identify herself as the maker of that good, then only that producer may use the mark. This field of law is based on the fundamental principles of unfair competition and the tort of consumer deception.⁸ Modern trademark law has two goals.⁹ On the one hand, trademark law serves to protect consumers from deception and confusion over symbols used to identify the source of goods.¹⁰ On the other hand, trademark law serves to protect a plaintiff’s infringed trademark as property.¹¹

⁶ 564 U.S. 552, 557 (2011).

⁷ 15 U.S.C. § 1127 (2006).

⁸ See Mark McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1840–41 (2007).

⁹ J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2:2 (4th ed. 2013).

¹⁰ *Id.*

¹¹ *Id.*; see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 782 n.15 (1992) (Stevens, J., concurring) (citing S. REP. NO. 1333, at 3 (1946)):

Trademarks differ substantially from the other three areas of intellectual property.¹² Unlike patents, copyrights, and trade secrets, where intellectual property protection is based on utilitarianism and the need to incentivize innovation, trademark law is founded in tort theory and commercial integrity.¹³ And while trademark law is similar in that other commercial actors are affirmatively excluded from benefitting from an individual's property right, in trademark law this exclusion is not for the purpose of progressing the arts and sciences as enumerated in the Constitution.¹⁴ On occasion, these derivative fields of intellectual property are confused and mistakenly used interchangeably.¹⁵ However, one must remain cognizant of the fact that trademarks exclusively serve as shorthand notifications to alert consumers of the quality (or lack thereof) and reputation of the product.

Trademarks are an important component of our free-market ecosystem. The ability of a consumer to quickly recognize a mark and make a decision promotes both confidence and competition.¹⁶ Microeconomic theory makes clear that trademark law performs two important market functions.¹⁷ First, trademark law encourages producers to continue making quality products, because, otherwise, the disrepute of lesser quality products will

The purpose underlying any trade-mark statute is twofold. One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trade-mark owner.

¹² ROBERT P. MERGES, ET AL., *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 765 (6th ed. 2012).

¹³ See McKenna, *supra* note 8, at 1840–41.

¹⁴ See U.S. CONST. art. I, § 8, cl. 8 (Congress shall have the power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries”).

¹⁵ See MCCARTHY, *supra* note 9, at § 6:1 (collecting cases that confuse patent law, copyrights, and trademark law).

¹⁶ See MEGAN M. CARPENTER & KATHRYN T. MURPHY, *Calling Bulls**t on the Lanham Act: The 2(a) Bar for Immoral, Scandalous, and Disparaging Marks*, 49 U. LOUISVILLE L. REV. 465, 466 (2011).

¹⁷ See WILLIAM M. LANDES & RICHARD A. POSNER, *The Economics of Trademark Law*, 78 TRADEMARK REP. 267 (1988).

tarnish the producers mark in the mind of the consumer—goodwill that is hard to recuperate.¹⁸ Second, microeconomic theory instructs that trademark law is helpful in reducing the costumer’s cost of shopping and making purchasing decisions.¹⁹ As such, the government has a role to play in creating a scheme whereby consumers can benefit from trademarks in the marketplace. And Congress did just that when it passed the Lanham Act.

Until passage of the Lanham Act, trademark law had been governed by common law and a series of narrowly tailored statutes that provided little protection.²⁰ In 1946, however, Congress overhauled federal trademark law with the passage of the Lanham Act.²¹ This law, *inter alia*, provides a federal registration system for trademarks and service marks that are used in any commerce that Congress has the authority to regulate.²² Here, should a mark be infringed upon by another—by causing a likelihood of confusion in the marketplace as to the source of the goods or services carrying the marks in question—the Lanham Act provides for a number of remedies available to the plaintiff.²³

There are three main provisions in the Act: Sections 2, 32, and 43(a). First, Section 2 lays out the guidelines for registering a trademark or service mark on the Principal Register of the Patent and Trademark Office (PTO).²⁴ Next, Section 32 protects federally registered trademarks from the unauthorized use of another mark that is likely to confuse or mislead consumers as to the origin of

¹⁸ MCCARTHY, *supra* note 9, at § 2:3.

¹⁹ *Id.* The Assistant Attorney General in charge of Antitrust Division in 1982 stated, “Trademark counterfeiting . . . if freely permitted . . . would eventually destroy the incentive of trademark owners to make the investments in quality control, promotion and other activities necessary to establishing strong marks and brand names. It is this result that would have severe anticompetitive consequences.” *Id.*

²⁰ See ROBERT P. MERGES, ET AL., *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 765 (6th. ed. 2012) (explaining: (1) how early Congressional attempts to regulate trademark law through the patent and copyright clause of the Constitution was struck down by the Supreme Court in *Trade-Mark Cases*, 100 U.S. 82, 94 (1879) because the law was not based on novelty and originality; and, (2) the passage of the Trademark Act of 1905 under the Commerce Clause).

²¹ The Lanham (Trademark) Act, Pub. L. No. 79-489, 60 Stat. 427 (1946) (codified starting at 15 U.S.C. § 1051).

²² DONALD S. CHISUM, ET AL., *UNDERSTANDING: INTELLECTUAL PROPERTY LAW* 483 (2d ed. 2011).

²³ For example, the holder of a mark may seek injunctive relief under 15 U.S.C. § 1116. See 15 U.S.C. § 1116 (2008).

²⁴ See 15 U.S.C. § 1052 (2006).

goods or services.²⁵ In other words, Section 32 is the vehicle from which a federally registered trademark holder can bring suit against an alleged infringer. And third, Section 43(a) serves a vehicle to bring an infringement action against a trademark that is *not* registered on the Principal Register.²⁶

In order for a commercial actor to benefit from federal trademark protection, an application must be submitted and accepted by the Patent and Trademark Office.²⁷ If accepted, the mark will be placed on a database called the Principal Register.²⁸ This centralized database is helpful for multiple reasons. First, by having all the registered trademarks in one place, businesses can check and make sure they are not infringing on another's mark. Moreover, when an application is submitted, the existence of a centralized database helps the examiner search for similar marks.

Federal registration of one's trademark is important.²⁹ First, a federally registered mark carries with it a presumption that the mark is valid,³⁰ and the exclusive right to use that mark in order to commercialize those goods or services for which the trademark was granted.³¹ Therefore, should the trademark holder bring an infringement action, they will not need to prove that the mark is valid. Rather, the burden will shift to the defendant—if raising an argument of trademark validity—to show that the mark should *not* have been granted in the first place.³² Second, federal registration carries with it a presumption of constructive use as of the date the application was filed.³³ This is important because when bringing an infringement action, the plaintiff must show it has an interest in a senior (i.e. older) trademark; therefore, federal registration allows the plaintiff to backdate the seniority date to the time the application was submitted.³⁴ Third, federal registration serves as constructive notice of the trademark holder's ownership of the mark nationwide—even in markets where the

²⁵ See 15 U.S.C. § 1114 (2005).

²⁶ See 15 U.S.C. § 1125(a) (2012).

²⁷ 15 U.S.C. § 1051(a) (2002).

²⁸ See *id.*

²⁹ See *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 135 S. Ct. 1293, 1300 (2015) (“Registration is significant. The Lanham Act confers ‘important legal right and benefits’ on trademark owners who register their marks.”)

³⁰ 15 U.S.C. § 1057(b) (2010).

³¹ 15 U.S.C. § 1115(a) (2002).

³² See *id.*

³³ 15 U.S.C. § 1057(c).

³⁴ See *id.* (need parenthetical).

mark has not been used.³⁵ Fourth, a federally registered trademark is incontestable for five years.³⁶ Therefore, in an infringement suit brought by the trademark holder within five years of acceptance on the principal register, the defendant may not challenge its validity. Fifth, only those trademarks that are federally registered are used by the U.S. Customs Service to seize infringing goods entering the country.³⁷ This is because only federally registered trademarks—i.e., those in the Principal Register database—are searchable by agencies responsible for filtering out unwanted imports. Moreover, a federally registered trademark qualifies for a simplified process for obtaining recognition and protection in signatory countries to the Paris Convention.³⁸ This is all to say, the benefits of federal registration on a trademark far surpass those of a non-registered mark.

B. First Amendment

It is axiomatic to say freedom of speech is core to a well-functioning democracy and is the necessary foundation to our American way of life. The First Amendment prohibits the Government from passing any law “abridging the freedom of speech.”³⁹ Therefore, First Amendment jurisprudence is the primary means for citizens to combat any effort by the Government to abridge speech in a wide array of contexts.⁴⁰

The most terrible kind of anti-speech laws are those discriminating against the content and viewpoint of the speech. These types of anti-speech laws are analyzed under (the almost always deadly) strict scrutiny standard. For example, in *Reed v. Town of Gilbert*, the Supreme Court confirmed, “[c]ontent-based laws—those that target speech based on its communicative content—are presumptively unconstitutional and may be justified only if the government provides that they are narrowly tailored to

³⁵ 15 U.S.C. § 1072 (2016).

³⁶ 15 U.S.C. § 1065 (2010).

³⁷ See 15 U.S.C. § 1124 (1999).

³⁸ See Paris Convention for the Protection of Industrial Property art.

6*quinuies*, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.A. 305.

³⁹ U.S. CONST. amend. I.

⁴⁰ See, e.g., *Coates v. City of Cincinnati*, 402 U.S. 611, 620–21 (1971) (applying void for vagueness doctrine to strike down regulation prohibiting three or more persons from assembling in an “annoying” manner); *Texas v. Johnson*, 491 U.S. 397, 399 (1989) (holding that the First Amendment protects the right to burn the American flag).

serve compelling state interests.”⁴¹ Therefore, in *Reed*, the Court held a town ordinance restricting the size, duration and location of temporary signs announcing religious services, were unconstitutional.⁴²

There are only a few circumstances where content-based regulations will survive judicial analysis. As Justice O’Connor once opined, “[t]he First Amendment permits restrictions upon the content of speech in a few limited areas, which are of such *slight* social value as a step to truth that any benefit that may be derived from them is clearly outweighed by the social interest in order and morality.”⁴³ For example, under the famed *Brandenburg* test, the Government may restrict the right to free speech in cases where an individual has truly incited imminent lawless action.⁴⁴

Even worse than laws targeting content, are those laws that discriminate among *viewpoints*. As Justice Clarence Thomas noted in *Reed*, “[g]overnment discrimination among viewpoints—or the regulation of speech based on ‘the specific motivating ideology or the opinion or perspective of the speaker’—is a ‘more blatant’ and ‘egregious form of content discrimination.’”⁴⁵ For instance, in *Consolidated Edison Co. v. Public Service Comm’n of New York*—a case where the Supreme Court invalidated an order prohibiting utility companies from including inserts of controversial issues of public policy in billing statements—Justice John Paul Stevens opined:

A regulation of speech that is motivated by nothing more than a desire to curtail expression of a particular point of view on controversial issues of general interest is the purest example of a “law abridging the freedom of speech, or of the press.” A regulation that denies one group of persons the right to address a selected audience on “controversial issues of public policy” is plainly such a regulation.⁴⁶

⁴¹ 135 S. Ct. 2218, 2226 (2015).

⁴² *Id.* at 2232–33.

⁴³ *Virginia v. Black*, 538 U.S. 343, 358–59 (2003) (internal quotations and citations omitted) (emphasis added).

⁴⁴ *Ohio v. Brandenburg*, 395 U.S. 444, 449 (1969).

⁴⁵ 135 S. Ct. at 2230 (quoting *Rosenberg v. Rector and Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995)).

⁴⁶ 447 U.S. 530, 546 (1980) (Stevens, J., concurring)

In addition to laws restricting content and viewpoint, the Government is also generally barred from passing laws abridging commercial speech.⁴⁷ Simply put, commercial speech is speech that does no more than *propose* a commercial transaction—such as advertising.⁴⁸ Unlike content and viewpoint-based laws, which are reviewed under strict scrutiny, laws abridging commercial speech are reviewed under an intermediate scrutiny standard.⁴⁹ Put another way, rather than requiring that the Government show a compelling governmental interest and that the law in question accomplishes that via the least restrictive means, under intermediate scrutiny, the Government need only show a substantial government interest and does not require that the law be the least restrictive means.⁵⁰ As Circuit Judge Alex Kozinski opines:

The commercial speech doctrine is the stepchild of first amendment jurisprudence: Liberals don't much like commercial speech because it's commercial; conservatives mistrust it because it's speech. Yet, in a free market economy, the ability to give and receive information about commercial matters may be as important, sometimes more important, than expression of a political, artistic, or religious nature.⁵¹

Ultimately, even though commercial speech is subject to less protection than content and viewpoint-based speech, we generally leave it up to the audience—rather than the Government—to assess the value of the speech proposing a particular transaction.⁵²

II. SECTION 2(A)—THE HODGEPODGE

Section 2 of the Lanham provides that no trademark will be refused registration on the principal register, *unless* the mark:

⁴⁷ See *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm. of New York*, 447 U.S. 557, 571 (1980).

⁴⁸ *Harris v. Quinn*, 134 S. Ct. 2618, 2639 (2014).

⁴⁹ See *Cent. Hudson Gas & Elec. Corp.*, 447 U.S. at 573 (Blackmun, J., concurring).

⁵⁰ See *id.* at 566.

⁵¹ Alex Kozinski & Stuart Banner, *Who's Afraid of Commercial Speech?*, 76 VA. L. REV. 627, 652 (1990).

⁵² *Sorrell v. IMS Health Inc.*, 131 S. Ct. 2653, 2672 (2011).

Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.⁵³

This, my friends, is the Hodgepodge. An amalgam of supposed morality and societal decency wrapped up in a blanket of civility. Surprisingly, there is scant legislative history attributable to the adoption of Section 2(a) in the Lanham Act.⁵⁴ Nevertheless, scholars have noted four justifications for Section 2(a), namely: (1) the federal government has an interest in not approving of such scandalous or disparaging material; (2) efficiency would be wasted if resources were allocated to such trademarks; (3) the public health and welfare is promoted by rejected unwholesome trademarks; and (4) the government has a role in protecting the sensitivities of the general public.⁵⁵

However, the process used to reject trademark applications under Section 2(a) is uncertain. As noted by scholar Stephen R. Baird:

Section 2(a) is really a hodgepodge [sic] of several distinct statutory bars to federal trademark registration. A thorough reading of the cases reveals that the lines separating each distinct bar have been blurred. Section 2(a) provides that notwithstanding a particular mark's ability to indicate origin and function as a trademark, certain classes of trademarks must be denied registration to discourage the use of certain subject matter that is contrary to public policy: (1) scandalous matter; (2) immoral matter; (3) disparaging matter; (4)

⁵³ 15 U.S.C. § 1052 (2006).

⁵⁴ See Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(a) Trademark Law After Lawrence v. Texas*, 9 MARQ. INTELL. PROP. L. REV. 187, 233 (2005) ("Because there is little legislative history explaining Congress's intention in enacting section 2(a), courts will have to speculate as to Congress' intent based on the test and purpose of the statute.").

⁵⁵ Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661, 788 (1993).

contemptuous matter; (5) disreputable matter; (6) deceptive matter; and (7) matter that suggests a false connection. The last two trademark classes are different from the first five classes in that the first five do not further the stated goals of the Trademark Act. Of the set, only the registration prohibitions concerning deceptive and false connection trademarks appear to facilitate the goal of preventing confusion and deception in the market place.⁵⁶

There remains much confusion regarding allegedly disparaging trademarks. Because the Lanham Act does not define “disparaging,” the Patent and Trademark Office—as well as the courts—is left to speculate as to what trademarks are actually “disparaging.” This—needless to say—is as subjective as you can get.⁵⁷

The Trademark Manual of Examining Procedure attempts to outline a test for Examiners to reject an application under the disparagement clause.⁵⁸ First, with *ex parte* cases, the examining attorney must make a *prima facie* showing that a substantial composite, although not necessarily a majority, of the referenced group would find the proposed mark, as used on or in connection with the relevant goods or services, to be disparaging in the context of contemporary attitudes.⁵⁹ The manual further states, that when the application of a mark to a product would “offend the sensibilities of an ethnic or religious group,” the proper ground for refusal is not under the clause of Section 2(a) that prohibits registration of matter that is “immoral” or “scandalous.”⁶⁰ Rather,

⁵⁶ *Id.* at 666 n.14.

⁵⁷ For example, early interpretations of Section 2(a) used a kind of Justice Potter Stewart-inspired “I know it when I see it” analysis. See Todd Anten, *Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of Slurs into Section 2(a) of the Lanham Act*, 106 COLUM. L. REV. 388, 402 (2006) (explaining early interpretations of the TTAB used language such as “obviously” and “there can be no question” when striking down trademark applications under Section 2(a) (collecting cases)).

⁵⁸ See TMEP (Jan. 2015 ed.) § 1203.03(b)(i) (“The Board applies one of two substantive tests in determining whether a proposed mark is disparaging. The test depends on the nature of the interest disparaged by the mark, that is, whether the interest is commercial or non-commercial (e.g., religious, ethnic, personal reputation, or national interest).”)

⁵⁹ *Id.*

⁶⁰ *Id.*

the examiner must turn to the clause that prohibits registration of matter that “‘may disparage’ the affected person, belief, institution, or symbol, or may bring them into contempt or disrepute.”⁶¹

Consequently, the Manual instructs that “when religious beliefs or tenets are involved, the proper focus is on the group of persons that adhere to those beliefs or tenets” and *not* the population at large.⁶² Moreover, “the fact that an applicant may be a member of that group, or has good intentions underlying its use of the term, does not obviate the fact that a substantial composite of the referenced group would find the term objectionable.”⁶³ When this is the case, the Manual states “[t]he prima facie showing shifts the burden to the applicant for rebuttal.”⁶⁴ Under this framework, the decision maker was required to assess whether the mark in question was scandalous to a substantial composite of the general public.⁶⁵

When rejecting a trademark under one of the statutory bars of Section 2(a) of the Lanham Act, the burden rests on the Patent and Trademark Office to adduce evidence to show that the rejection is proper.⁶⁶ In the case of trademarks that have been rejected for religious reasons, the particular clause used to reject the registration has varied between the “scandalous” clause and the “disparaging” clause. In recent years, a move has been made to reject marks under the “disparage” clause when it seems to affect a particular religious group. As noted by one commentator:

The disparagement bar differs from the scandalousness bar, foremost because there is a particular object of disparagement, *i.e.*, a person,

⁶¹ *Id.*

⁶² *Id.*

⁶³ *Id.*

⁶⁴ TMEP (Jan. 2015, ed.) § 1203.03(b)(i).

⁶⁵ Over the years, “scandalous” has been defined a number of different ways, including: “shocking to the sense of truth, decency or propriety,” “disgraceful,” “offensive,” “disreputable,” “giving offense to the conscience or moral feelings,” “calling out for condemnation,” “exciting reprobation,” and “vulgar” (“lacking in taste, indelicate, morally crude”). ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 3.04(6)(a)(i)(A)(II)(aa).

⁶⁶ MCCARTHY, *supra* note 9, at § 19:75 (4th ed. 2013). Consider the fact that the statutory bars of Lanham Act § 2 are introduced by the phrase “No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature *unless . . .*” (emphasis added).

group, set of beliefs, institution or symbol, and the statutory bar depends on the perspective of the object of disparagement. In contrast, the scandalousness provision protects the public as a whole and the effect of the trademark is judged from the perspective of the general public.⁶⁷

As such, when a trademark applicant invokes religion, examiners use the “disparagement” clause to assess the effect on the referenced group. But is this good policy? Are trademark examiners truly capable of being a Buddhist, a Jew, a Christian, a Mormon, a Muslim, a Scientologist, or whatever other religion exists in the world, all at once? If one were to view trademarks as speech, should someone’s First Amendment rights be restricted based on the subjective views of one trademark examiner? The following cases show why this approach is not good policy.

III. VICTIMS OF THE HODGEPODGE

Section 2(a) has claimed a number of victims. The following section provides an in-depth analysis of trademark applications that were denied due to their apparent scandalous or disparaging effect towards religious groups.

A. *In re Riverbank Canning*

In 1938, the United States Court of Customs and Patent Appeals (CCPA) rejected a trademark application of “Madonna” for the sale of wine.⁶⁸ In that case, the court considered whether the word “Madonna” as a trademark for wines, came within the scope of the 1905 Trademark Act’s section prohibiting the registration of any mark that “consists of or comprises immoral or scandalous matter.”⁶⁹ Having been denied a trademark by the initial examining attorney and also on appeal to the Commissioner of Patents, the applicant brought the action before the CCPA for a final determination.⁷⁰

⁶⁷ LALONDE, *supra* note 65, at § 3.04[6][a][i][B]. [Could not find reference to Matthew Bender in collected source (could not add a comment to a footnote)].

⁶⁸ *In re Riverbank Canning Co.*, 95 F.2d 327, 327 (C.C.P.A. 1938).

⁶⁹ *Id.* at 327–28.

⁷⁰ *Id.*

After first defining the word “scandalous,” the court framed the central issue as, “whether the use of the mark ‘Madonna’ upon wine which is not limited to a religious use may be held to be ‘shocking to the sense of propriety’, or would such use give ‘offense to the conscience or moral feelings.’”⁷¹ Importantly, the court looked to whether the term was scandalous, rather than whether the term would be interpreted as scandalous by the public. In other words, the manner in which the issue was phrased gave the court carte blanche to insert its own, subjective, moral opinions on the mark. Ultimately, the court considered multiple factors, including: (1) the meaning of the word “Madonna” among all English speaking people; (2) the post-prohibition environment at the time in the United States; and (3) the nature of wine drinking itself.⁷²

First, in an effort to decipher the meaning of the word Madonna, the court turned to dictionary definitions.⁷³ Here, Funk & Wagnalls New Standard Dictionary defined the term as “My lady; signora: an old Italian form of address equivalent to madam;” and “the Virgin Mary; also, a painted or sculpted representation of the Virgin.”⁷⁴ Moreover, Webster’s New International Dictionary defined Madonna as “My lady;—a term of address in Italian formerly used as the equivalent of madame, where signora is now substituted”; and “An Italian designation of the Virgin Mary . . . a picture or statue [sic] of the Virgin Mary.”⁷⁵ Having weighed the dictionary definitions, the court reasoned that while in Italy the term Madonna carried other connotations than identifying the Virgin Mary, in the United States, the term was “generally understood to refer to the Virgin Mary or to a pictorial representation of the Virgin Mary.”⁷⁶ The court offered no evidence or well-thought out reasoning for this determination; rather, the CCPA simply assumed Madonna could only refer to the Virgin Mary in the mind of the United States citizenry.

Next, the court looked to the cultural environment of the time. Even though the court conceded that judging the harms of drinking wine and other alcoholic beverages was outside the scope of its analysis, the CCPA went out of its way to note that the

⁷¹ *Id.*

⁷² *See id.* at 328–29.

⁷³ *See id.* at 328.

⁷⁴ *In re Riverbank Canning Co.*, 95 F.2d at 328.

⁷⁵ *Id.*

⁷⁶ *Id.*

manufacture and sale of wine had been prohibited nationally for a number of years, and individual states had passed prohibition laws.⁷⁷ Additionally, the court noted that while the Bible referred to wine on various occasions, it was “also true that the evils growing out of the excessive use of intoxicating beverages are probably much greater today than they were 1900 years ago.”⁷⁸ Consequently, the CCPA concluded, “wine, like any other intoxicating beverage, may be, and often is, used to excess, is a *matter of common knowledge*.”⁷⁹

Finally, after apparently determining that the consumption of wine—in and of itself—was of low moral character, the CCPA turned to whether the use of Madonna on a bottle of wine was scandalous. Here, the court took “the viewpoint, not of wine drinkers alone, but also of those who do not use wine as a beverage.”⁸⁰ In its final analysis, the court prohibited the registration of the mark but turned to no evidence other than its own assumptions, stating:

The Virgin Mary stands as the highest example of the purity of womanhood, and the entire Christian world pays homage to her as such. Her representation in great paintings and sculpture arouses the religious sentiments of all Christians.

We can readily understand that many who are accustomed to the use of wine as a beverage, remembering the use of it as a beverage in Biblical times, would not be shocked at the use of the word “Madonna” or a representation of the Virgin Mary as a trade-mark upon wine used for beverage purposes; but we also believe that there are many wine users who, knowing that the excessive use of wine is a great evil and not uncommon, would be shocked by such use of said mark upon wine, especially in view of the fact that such mark would probably be displayed, among other places, in barrooms.⁸¹

⁷⁷ *See id.*

⁷⁸ *Id.* at 328–29.

⁷⁹ *Id.* at 329 (emphasis added).

⁸⁰ *In re Riverbank Canning Co.*, 95 F.2d at 329.

⁸¹ *Id.*

All in all, *In re Riverbank Canning* stands for the proposition that assessing a mark under Section 2(a) inherently involves the injection of the reviewer's subjective belief. Here, the court injected its own beliefs about how wine consumption was seen in the general public. Unfortunately, this approach has permeated trademark law.

B. In re Summit Brass and Bronze Work, Inc.

Similarly, the 1943 case of *Ex Parte Summit Brass & Bronze Works, Inc.*⁸² provides a further example of early trademark courts inserting their own opinion of whether a proposed trademark is scandalous in the religious context. Here, the applicant sought to trademark the phrase "Agnus Dei" (Latin for "Lamb of God") for metallic tabernacle safes—presumably for use by Roman Catholic churches.⁸³ The applicant argued that the "Agnus Dei" mark was not scandalous because the evidence showed that priests and bishops had been purchasing the tabernacle with the phrase, and they were not offended.⁸⁴ In a short opinion, the Commissioner of Patents disagreed, reasoning, "[t]o commercialize an emblem of such highly religious significance would, *I think*, be offensive to most individuals of the Christian faith, and thus scandalous within the meaning of the statute."⁸⁵

The opinion referred to no evidence in support of its decision. Once again, as in *Riverbank Canning*, the rejection of the mark seems to have been based exclusively on the examiner's personal feelings towards the mark and its proposed use. In this case, it was clear that the trademark applicant had adduced evidence—priests and bishops had been purchasing the item with "Agnus Dei" stamped on the tabernacle, and did *not* raise any fuss. Moreover, the court's "*I think*" analysis can be seen as nothing short of pure subjective analysis.

Admittedly, *Riverbank Canning* and *Summitt Brass* are older cases from the World War II Era. Nevertheless, recent cases show the Patent and Trademark Office still engages in such subjectivity.

⁸² 59 U.S.P.Q. 22, 1943 WL 8300 (TTAB 1943).

⁸³ *Id.* at *1.

⁸⁴ *Id.*

⁸⁵ *Id.* (emphasis added).

C. *In re Lebanese Arak Corp.*

In 2010, the Trademark Trial and Appeal Board upheld the rejection of a trademark application for the term “KHORAN” used to identify “alcoholic beverages, namely wines.”⁸⁶ In that case, the trademark was initially rejected because KHORAN “is the phonetic equivalent of ‘Koran’; that the Koran is the sacred text of Islam; that the Koran forbids consumption of alcoholic beverages, including wine; and therefore that the use of KHORAN for wine is disparaging to the beliefs of Muslims.”⁸⁷ In so reasoning, the Board laid out the following test to determine whether a mark should be rejected on the basis of religious disparagement.⁸⁸ First the court asked, “what is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services[?]”⁸⁹ Next, after determining the meaning of the mark in step one, the court asked, “if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, *whether that meaning may be disparaging to a substantial composite of the referenced group.*”⁹⁰ With regards to using KHORAN on a bottle of wine, the Appeals Board determined:

The evidence submitted by the examining attorney in the case at hand, which shows that drinking alcohol is considered unacceptable by Muslims, is sufficient to show that the use of the name of the sacred text of Islam for a substance prohibited by that religion, indeed, a substance prohibited by that very text, would be disparaging to followers of Islam and their beliefs.⁹¹

⁸⁶ *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 2010 WL 766488, at *1 (T.T.A.B. 2010).

⁸⁷ *Id.* at *1.

⁸⁸ *Id.* at *3–4.

⁸⁹ *Id.* at *3.

⁹⁰ *Id.* (emphasis added).

⁹¹ *Id.* at *4.

But *what* evidence was actually used? Was the examiner's decision simply based on the fact that Muslims do not drink alcohol, and, therefore, the use of a word sounding like Koran, or anything having to do with alcohol, was inherently disparaging to a substantial composite of Muslims?

First, the Appeals Board focused on the first prong: the likely meaning of the term in question.⁹² Here, the main concern was over the spelling of the mark KHORAN and whether the mark would be interpreted to mean the Quran. While acknowledging that the Quran possesses numerous spellings across various languages—namely, Qur'aan, Koran and Quran—the examiner had ultimately concluded that spelling was irrelevant and that the phonetic similarity and connotation of the marks was what was most important.⁹³ In support, the Appeals Board turned to evidence showing the public misspells the Quran as “Khoran” regularly.⁹⁴ Here, the following examples were used as evidence:

There is no true alliance with the Islamic governments because the Khoran forbids it Read this book and you will be compelled to also read parts of the Khoran to see why our government's policies are leading us into a terrible trap. Publisher's notes on book Princes of Islam, website headed “Welcome to C.T.U. Bookstore,” (Conservative Theological University), <http://97.66.25.67/bookstore/store.php>

It is forbidden for muslims [sic] to hurt or kill anyone, according to the Khoran. <http://messageboard.rediff.com>, (letter posted on a message board)

He says the surgeons are fine, but the nurses and those involved in aftercare view painkillers like they do drugs or alcohol—against the laws of the Khoran. Live Journal, <http://zainybrain.livejournal.com> (journal entry by Wendy Wheeler about her dinner with “Jungle Bob”)

⁹² See *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 2010 WL 766488, at *4–8.

⁹³ See *id.* at *5, *13.

⁹⁴ See *id.* at *5.

In Prager's view, allowing Ellison to be sworn in on the Khoran "will embolden Islamic extremists and make new one [. . .]" "Will Samson, On a Journey of Discovery Toward God, Society and Sustainability," Nov. 28, 2008, [http:// willzhead.typepad.com](http://willzhead.typepad.com)

I cringe [sic] anytime I found a Holy Bible in the drawer of my hotel rooms. Why not the Khoran, the Taoism of Buddha, the Torah? Comment by gingersoul, Dec. 11, 2006 on article "Religion finds firm footing in some offices," SoulCast, <http://soulcast.com>

But this points much more at the human aspect of interpreting what is in the Khoran. Post by Sparky on FaithFreedom.org website.⁹⁵

Essentially, the Appeals Board sought to show that while certain misspelling is not accepted as true, considering the point of view of the public, misspelling can still call one's attention to a defined term; and therefore, misspelling cannot be an adequate defense to the first prong of the "disparaging" analysis.⁹⁶ As a result, the KHORAN mark was found to "give[] the commercial impression that it is the word Koran, and that the public . . . in general, and Muslim Americans in particular, would regard the mark as referring to the holy text of Islam."⁹⁷

Next, the Appeals Board went on to refute multiple points made by the dissent. First, the board rejected the dissent's argument that the disparagement test requires that one must interpret the meaning of the mark from the standpoint of the general public rather than the point of view of Muslim Americans.⁹⁸ In rejecting it, the Appeals Board noted, "[w]e can envision situations in which, for example, a term or symbol would be clearly understood by members of a religious group as being significant in their worship, but would not be known or understood by the public at large."⁹⁹ Moreover, the Appeals Board rejected the

⁹⁵ *Id.*

⁹⁶ *See id.* at *6.

⁹⁷ *Id.*

⁹⁸ *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 2010 WL 766488, at *6.

⁹⁹ *Id.*

dissent's argument that the public would not view the mark KHORAN as the word "Koran" *because* people know practitioners of the Muslim faith do not drink alcohol.¹⁰⁰ Ultimately, the Board concluded:

The record is replete with evidence that alcohol, including wine, is prohibited by the tenets of Islam. Therefore, the Board is not in a position in which it is interposing its own judgment for that of Muslims . . . we have no doubt both that KHORAN would be recognized as the name of the holy text of Islam, and that the use of this term for wine would be disparaging to the religion and beliefs of Muslims Americans¹⁰¹

Simply put, the Board's reasoning was a sham. In one sentence the Board notes that they are not in a position to interpose their own judgment with that of Muslims, but in the very next sentence, the Board, after considering the tenets of Islam, made an assumption that a "substantial composite" of Muslim Americans would be disparaged by the mark KHORAN on wine. It is clear from the opinion that the only evidence considered was documents summarizing the religious doctrine of Islam, without any input from Muslim Americans themselves. Perhaps, this is true and a "substantial composite" of the population would find the mark disparaging—but that is not the point. Rather, the tragedy of the decision is that no evidence was used actually indicating that disparagement might occur. Rather, the Board relied on pure conjecture and subjective interpretation of the fact that Islam bars the consumption of alcohol. This is a dangerous standard however. There are numerous religions that ban any number of activities, yet their practitioners still partake in them, and are likely to not be offended by an individual obtaining federal trademark registration.

D. In re Heeb Media, LLC

In 2008, the Trademark Trial and Appeal Board considered the rejection of the mark HEEB to be used to develop a lifestyle

¹⁰⁰ *Id.* at *8

¹⁰¹ *Id.* at *8–9.

brand, including for clothing and entertainment purposes.¹⁰² The mark was rejected, however, because it was found to be “disparaging to a substantial composite of . . . Jewish people.”¹⁰³ Interestingly, the applicant had already obtained a trademark for HEEB as a mark the company used as the title of its magazine.

In its analysis, the Appeal Board first assessed the meaning of the word “Heeb” in dictionaries.¹⁰⁴ The following definitions were used as evidence: (1) “Hebe/Heeb – a derog. term for a Jew”¹⁰⁵; (2) “Hebe n. *informal, offense* a jewish person. > 20th cent.: abbreviation of Hebrew.”¹⁰⁶ Next, the Board considered how the magazine’s use of HEEB had played in the community. The evidence included, *inter alia*, the following statements from the Anti-Defamation League’s associate national director, a college professor in Jewish-American studies, and a syndicated talk show host:

Adopting a “title for a publication that is offensive to many Jews is unnecessary and in my view counterproductive . . . One could argue this is a sign that Jews have really made it, that people can poke fun and really satirize.” However, “we’re also living in a world where anti-Semitism is flourishing The usual sensitivity should continue and not assume that things are so secure.”

“Heeb is an effort to get some attention with a tasteless title It would have to be explained to me that the person who called me a Heeb was not meaning to be offensive.”

“I think it is a bad idea for a name. Certainly, I could think back to Archie Bunker, who quite frequently would refer to Jews as heeb and other derogatory names. Just knowing that it is a derogatory name and it has a derogatory history, you have to start thinking, well, if it was a black magazine trumpeting

¹⁰² *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071, 2008 WL 5065114, at *1 (T.T.A.B. 2008).

¹⁰³ *Id.*

¹⁰⁴ *See id.* at *1–2

¹⁰⁵ *Id.* at *1 (citing THE CASSELL DICTIONARY OF SLANG (1998)).

¹⁰⁶ *Id.* (citing THE NEW OXFORD AMERICAN DICTIONARY (2d ed. 2005)).

African-American history or events or culture, would it be named the N-word? Or [if] it was Hispanic, would an editor come along and name it a word that starts with S? I can't see it happening. And I don't understand why there are Jewish groups and charities and whatever that help fund this magazine. I think it is a terrible choice for a name."¹⁰⁷

In response to the use of this type of individualized, subjective evidence, the Board noted that the applicant contended "the determination of disparagement cannot be based 'on isolated editorial comments made by members of one organization or one vocal individual whose opinions do not represent Jewish popular thought cultural mainstream.'"¹⁰⁸ In support of its argument that the mark HEEB would not be disparaging to a substantial composite of Jewish people, the applicant included the following letters in support from a professor of American Jewish history at Brandeis University, a large Jewish organization, and a professor from New York University:

There can be no doubt that the word "Heeb" (also spelled "Hebe") has historically been used as "a derogatory term for a Jew," and that is precisely how the Oxford English Dictionary defines the word. I myself can recall hearing this taunt as a youngster in public school, and even today, the term is occasionally used in this way by prejudiced people. The individuals who founded Heeb Magazine, however, are themselves Jewish, and their magazine received significant start-up money from the Joshua Venture, a fund dedicated to stimulating Jewish "social entrepreneurship" and supported by such notable Jewish leaders as Charles Bronfman and Steven Spielberg. The editor and most of the thousands of readers of Heeb are likewise Jewish. Given this context it is clear that Heeb aims to transvalue the term "heeb" from an epithet into a term of Jewish empowerment . . . I know that the

¹⁰⁷ *Id.* at *2.

¹⁰⁸ *In re Heeb*, 89 U.S.P.Q.2d 1071, 2008 WL 5065114, at *2.

young people behind Heeb have intentions that are anything but “scandalous and immoral.” To the contrary, these young men and women are engaged in myriad efforts to revitalize American Jewish life. Heeb is part of their effort to re-engage those who have grown disaffected with their heritage.

Heeb is widely distributed among the Jewish student population with whom we work so closely, and currently we have yet to receive any complaints about the name or its availability on our over one hundred college campuses. Not only have we not received any complaints among the student population but we have yet to receive a single complaint from a parent or a community member. While there may be some in the Jewish and non-Jewish community who take offense to the magazine's articles, it has been our uniform impression that the Jewish audiences Hillel interacts with understand the playful, satirical nature and format of the magazine, and do not consider the name to be offensive . . . The magazine's target population of Jewish students and young Jewish adults certainly were not around to experience the negative associations with the word “hebe” as some of the older Jewish generations may have.

According to a professor from New York University: In the case of this magazine and other examples I will cite, the meaning of the word and feelings attached to it has a generational character, with younger and more confident Jews embracing a term of abuse as a badge of honor (note the magazine's subtitle: “The New Jew Review”), while the word generally makes an older generation uncomfortable . . . While there will be those in the Jewish community who find the magazine, both its name and its content, offensive, there are many others who embrace its unflinching and confrontational style in giving voice to a new generation of proudly

Jewish youth in search of unconventional ways of defining themselves.¹⁰⁹

The applicant also cited evidence that the phrase HEEB was not disparaging, including, *inter alia*: (1) Jewish cultural and religious organizations such as Steven Spielberg's Righteous Persons Foundation, and (2) that HEBE magazine currently had 100,000 subscribers. Additionally, the applicant even adduced evidence that, in contrast to the dictionary definition previously relied on by the examiner as "a derog. term for a Jew," the more updated 2005 definition had done away with the derogatory interpretation and defined the term as "[1920's+] Jewish."¹¹⁰ Nevertheless, even in light of this substantial information proffered by the trademark applicant, the Appeals Board found the manner in which clothing carrying the mark HEBE would be worn in public required a finding that the term would be found disparaging.¹¹¹

Even more interesting was the Board's disregard for the fact that "HEEB" had already been granted federal trademark protection.¹¹² In 2004, the trademark applicants received a trademark to use HEEB for the publication of magazines.¹¹³ Nevertheless, the Board afforded this fact little weight, noting that although "the evidence that has been submitted, relates to applicant's magazine which has the title HEEB. While it is useful to understand the context in which the mark is used, we ultimately must determine how the term HEEB will be perceived in connection with the goods and services listed in this application, which do not include magazines."¹¹⁴ In other words, the Board found that wearing the mark HEEB on a shirt would be more disparaging to a "substantial composite" of the Jewish faith, than having the mark on a magazine stand.

Once again, the decision came down to one of subjective preference. At its core, the case was a tug-of-war between competing evidentiary records. And even though Section 2(a) places the burden on the *examiner*, seemingly equal evidence was used against the applicant.

¹⁰⁹ *Id.* at *3.

¹¹⁰ *Id.* at *4.

¹¹¹ *See id.*

¹¹² *Id.* at *1.

¹¹³ HEEB, Registration No. 2,858,011.

¹¹⁴ *In re Heeb*, 89 U.S.P.Q.2d 1071, 2008 WL 5065114, at *1.

E. In re Geller

In 2014, the Federal Circuit issued its first opinion addressing Section 2(a), holding “STOP THE ISLAMISATION OF AMERICAN” was disparaging, and therefore could not be registered.¹¹⁵ The case involved the outspoken activist, Pamela Geller, commonly known for her ardent opposition to the construction of the Park51 mosque near Ground Zero in New York City.¹¹⁶ Whatever one’s political leaning, there can be no doubt her rhetoric and political views draw the ire of her opponents. For example, Ms. Geller’s speech has earned her a ban from traveling to the United Kingdom.¹¹⁷ Most notably, Geller’s rightful exercise of her free speech (regardless of what one thinks of her tactics) came to a head when two men attacked a “Draw Muhammad” contest she was hosting in Texas.¹¹⁸ Moreover, Geller has even been targeted for beheading.¹¹⁹ Along with her literary partner Robert Spencer, Pamela Geller co-founded the Freedom Defense Initiative and Stop the Islamization of America, as well as published a number of books under the umbrella of these initiatives.¹²⁰ As such, Geller uses the term “Stop the Islamization of America” in commerce to identify the source of her literary

¹¹⁵ See *In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014).

¹¹⁶ See Anne Barnard & Alan Feuer, *Outraged, and Outrageous*, N.Y. TIMES, Oct. 8, 2010, http://www.nytimes.com/2010/10/10/nyregion/10geller.html?pagewanted=all&_r=0.

¹¹⁷ See Kevin Rawlinson, *Anti-Ground Zero Mosque Campaigners Pamela Geller and Robert Spencer Barred from Entering Britain to Speak at an EDL Rally*, INDEPENDENT, June 26, 2013, <http://www.independent.co.uk/news/uk/crime/antiground-zero-mosque-campaigners-pamela-geller-and-robert-spencer-barred-from-entering-britain-to-speak-at-an-edl-rally-8675251.html>.

¹¹⁸ See Manny Fernandez et. al., *Gunman in Texas Shooting Was F.B.I. Suspect in Jihad Inquiry*, N.Y. TIMES, May 4, 2015, <http://www.nytimes.com/2015/05/05/us/garland-texas-shooting-muhammad-cartoons.html>.

¹¹⁹ Pete Williams & M. Alex Johnson, *Boston Terror Suspect Usaamah Rahim Plotted to Behead Pam Geller: Sources*, MSNBC (June 6, 2014), <http://www.msnbc.com/msnbc/boston-terror-suspect-usaamah-rahim-plotted-behead-pam-geller-sources>.

¹²⁰ See generally PAMELA GELLER & ROBERT SPENCER, *THE POST-AMERICAN PRESIDENCY: THE OBAMA ADMINISTRATION’S WAR ON AMERICA* (2013); PAMELA GELLER, *FREEDOM OR SUBMISSION: ON THE DANGERS OF ISLAMIC EXTREMISM & AMERICAN COMPLACENCY* (2013).

work. For example, in 2011, Geller published the book *Stop the Islamization of America: A Practical Guide to the Resistance*.¹²¹

On February 21, 2010, Pamela Geller filed an application to federally register the mark STOP THE ISLAMISATION OF AMERICA.¹²² The application was filed under International Class 45 for the purpose of “Providing information regarding understanding and preventing terrorism.”¹²³ Upon review, the Examiner rejected the mark under the disparagement clause of section 2(a).¹²⁴ Here, the USPTO Examiner determined:

The likely meaning of the term “ISLAMISATION” or “ISLAMIZATION” refers to the act of “convert[ing] to Islam or [of] bring[ing] into a state of harmony or conformity with the principles and teachings of Islam; giv[ing] an Islamic character or identity to.” Islam is “the religious faith of Muslims based on the works and religious system founded by the prophet Muhammad and taught by the Koran, the basic

¹²¹ See generally PAMELA GELLER, STOP THE ISLAMIZATION OF AMERICA: A PRACTICAL GUIDE TO THE RESISTANCE (2011). The Amazon.com summary reads:

Islamic supremacism is seeping into every aspect of American life. Islamic jihad groups aren't solely concentrating on terror attacks (although another one of those could come at any moment), but on the creeping encroachment to introduce Islamic law into this country, step-by-step and bit-by-bit, until finally America wakes up to a country transformed into an Islamic state. In *Stop the Islamization of America*, the renowned activist Pamela Geller lays bare the chilling details of the Muslim Brotherhood's strategy of steady subversion and erosion of our freedoms, while offering a practical guide for how to fight back. Written by an original thinker and innovative, tested, successful activist, *Stop the Islamization of America* is a much-needed wake-up call about a sinister, subversive agenda that could do nothing less than destroy the United States - with unique instructions about how we can, and must, fight back now to defend our nation and our civilization.

Stop the Islamization of America: A Practical Guide to the Resistance, AMAZON, http://www.amazon.com/Stop-Islamization-America-Practical-Resistance/dp/1936488361/ref=asap_bc?ie=UTF8.

¹²² See U.S. Trademark Application Serial No. 77,940,879 (filed Feb. 21, 2010).

¹²³ *Id.*

¹²⁴ *Id.*

principle of which is absolute submission to a unique and personal god, Allah.”

The applied for mark refers to Muslims in a disparaging manner because by the definition it implies that conversion or conformity to Islam is something that needs to be stopped or caused to cease.

The proposed mark further disparages Muslims because, taking into account the nature of the services (“providing information regarding understanding and preventing terrorism”), it implies that Islam is associated with violence and threats Therefore, the suggestion that Islam equates terrorism would be disparaging to a substantial group of Muslims.

Accordingly, the applied-for mark has been refused under Section 2(a) because it consists of matter which may disparage or bring into contempt or disrepute Muslims and the Islamic religion.¹²⁵

On appeal to the Trademark Trial and Appeals Board, Geller’s central argument was that “ISLAMISATION” refers exclusively to the political aspect of Islam, and, therefore, was not disparaging to the faith. Applying the *In re Lebanese* two-pronged inquiry, the Board determined, “when the mark is used in connection with the services identified in the application, namely providing information for the understanding and preventing terrorism, the mark is disparaging to Muslims in the United States and is therefore not registrable.”¹²⁶

In an effort to determine the meaning of Islamisation under the first prong of the *Lebanese* analysis, Geller asserted that the phrase was directed towards a political meaning of the word, while the PTO’s position was that the term Islamisation was primarily a religious term.¹²⁷ Here, the Board turned to dictionary definitions and concluded that from the religious-meaning perspective, “the mark in its entirety would be understood to mean that action must

¹²⁵ *Id.* (internal citations omitted).

¹²⁶ *In re Geller & Spencer*, 2013 WL 2365001, at *11 (T.T.A.B. 2013).

¹²⁷ *Id.* at *5.

be taken to cease or put an end to, converting or making people in America conform to Islam.”¹²⁸

Next, the Board looked at how the terms of the mark were used in the marketplace.¹²⁹ Here, two primary evidentiary sources were cited: (1) past articles written by Geller, and (2) readers’ comments on her website.¹³⁰ In particular, the Board assessed four particular articles written by Geller. The first article, *SIOA Mosque Manifesto: All Mosques are Not Created Equal, A Handy Guide to Fighting the Muslim Brotherhood*, was found to promote negative stereotypes of clerics and mosques.¹³¹ Likewise, the second and third articles, *Geller, Spencer in Big Government: The 9/11 Mosque’s Peace Charade* and *SIOA Condemns Obama’s Blessing of Grounds Zero Mega-Mosque and Bolton, Wilders to Speak At 9/11 Rally* were found to similarly play into negative stereotypes.¹³² Finally, the Board determined the fourth article cited offered assistance to people to leave the religion.¹³³ The Board did not look kindly on the articles as it found, “[t]here is no doubt that the underlying theme in the articles which are featured immediately underneath the website’s STOP THE ISLAMIZATION OF AMERICA banner is that the spread of Islam in America is undesirable and must be stopped.”¹³⁴

In an effort to further distill the marketplace’s interpretation of the mark, the Board focused on readers’ comments to Geller’s articles.¹³⁵ Based on these (certainly inflammatory) comments the Board found there was substantial

¹²⁸ *Id.* at *3.

¹²⁹ *Id.*

¹³⁰ *Id.*

¹³¹ *See id.*

¹³² *See In re Geller & Spencer*, 2013 WL 2365001, at *3.

¹³³ *Id.*

¹³⁴ *Id.* (citations omitted).

¹³⁵ *See id.* at *4. For example, one comment read:

Very few Americans are willing to educate themselves on what Islam teaches—it is not love and peace. They only know the propaganda the media and Islamic organization indoctrinate them with each day. This is why we are doomed to experience what every country that has allowed it to exist, [sic] has experienced—evil in its purest form. . . . If people only knew the truth, Islam would not be allowed to exist in the USA or any other country. Franklin Graham was right in saying, “Islam is evil.”

Id.

evidence to assign a religious meaning to the phrase “Islamization.” The TTAB noted, “[w]hile the probative value of the blog comments submitted by the readers of applicant’s website is less than that of the articles themselves due to the anonymity of the authors, they provide additional insight into the public’s perception of and reaction to applicant’s STOP THE ISLAMISATION OF AMERICA mark and services as used in the marketplace.”¹³⁶

Next, the Board turned to the alleged political meaning of the phrase “Islamization.” Here, Geller submitted evidence from professionals, academics, and religious and legal experts to bolster her argument.¹³⁷ For example, Geller pointed to congressional testimony, CLE course material, a doctoral dissertation entitled “Islamization in Pakistan: A Political and Constitutional Study from 1947–1988,” and multiple law review articles.¹³⁸ While acknowledging that the term may have a political meaning, the Board determined the political meaning was relegated to secondary status.¹³⁹ Therefore, because “a term that has multiple meanings must be understood—for purposes of the ‘meaning’ analysis—in the context of how it is use in the public domain relevant to the mark. . . . both meanings advance to the second phase of the analysis, i.e., does the group at issue consider the term as used in the context of the services disparaging?”¹⁴⁰

Here, at step two, the Board proceeded to determine whether *either* the religious or political meaning of Islamisation was disparaging to a “substantial composite” of the Muslim community. The court considered whether the mark caused “dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison.”¹⁴¹ The Board answered in the affirmative, reasoning that: (1) by using the word “stop”, a negative connotation permeated the entire mark; and (2) the use of STOP THE ISLAMISATION OF AMERICA for the

¹³⁶ See *id.* at *5.

¹³⁷ See *In re Geller & Spencer*, 2013 WL 2365001, at *5–6.

¹³⁸ See *id.* at *6.

¹³⁹ See *id.* (“Although applicants’ evidence is less probative of the meaning of the mark to the general public or to the American Muslim population at large, it evidences a second meaning of the mark at least to academic, professional, legal and religious experts based on the more narrow definition of the term “Islamisation” espoused by applicants.”)

¹⁴⁰ *Id.* at *7.

¹⁴¹ *Id.* at *7 (citing *Harjo II*, 68 U.S.P.Q.2d 1225, 1247 (2003); *Harjo I*, 50 U.S.P.Q.2d 1705, 1738 (1999)).

purpose of “understanding and preventing terrorism” created a direct correlation between Islam and terrorism, which was disparaging because a majority of Muslims are not terrorists.¹⁴² Moreover, even if Islamisation were read as a political term referencing Islamic law, the term would also be disparaging because the mark necessarily required an assumption that Islamic law mandated terrorism.¹⁴³

On appeal, the Federal Circuit upheld the Board’s ruling in full.¹⁴⁴ The gravamen of the court’s opinion, however, was the adoption of the PTO’s two-step framework used to assess marks under the disparaging clause of Section 2(a)—a move the Federal Circuit had not yet done.¹⁴⁵ Next, Pamela Geller appealed to the Supreme Court, arguing, *inter alia*, that her trademark was political speech, and therefore, rejecting the mark for disparagement under Section 2(a) amounted to viewpoint discrimination under the First Amendment.¹⁴⁶ This was to no avail, however, as the Supreme Court denied certiorari.¹⁴⁷

IV. CONSTITUTIONALITY OF THE HODGEPODGE

Now, one may wonder how a trademark applicant’s speech could be denied the numerous benefits of federal registration on the basis of such subjectivity. Whether denying protection for the use of KHORAN on a bottle of wine or STOP THE ISLAMIZATION OF AMERICA on books, subjective rulings that such marks are “disparaging” have permeated trademark law for almost seventy years. And while commentators have often criticized Section 2(a),¹⁴⁸ until recently, few courts had truly confronted its validity under the First Amendment, except for *In re McGinely*.¹⁴⁹ In that case, the court held the “scandalous” clause of

¹⁴² *Id.* at *8, *11.

¹⁴³ *See id.* at *7–8.

¹⁴⁴ *In re Geller*, 751 F.3d 1355, 1356–57 (Fed. Cir. 2014).

¹⁴⁵ *Id.* at 1358–59.

¹⁴⁶ Petition for Writ of Certiorari, *Geller v. Pat. & Trademark Off.*, 2014 WL 3974723 (2014) (No. 14-175).

¹⁴⁷ *Geller v. Pat. & Trademark Off.*, 135 S. Ct. 944 (2015).

¹⁴⁸ *See e.g.*, Lilit Voskanyan, *The Trademark Principal Register as a Nonpublic Forum*, 75 U. CHI. L. REV. 1295, 1302 (2008); Justin G. Blankenship, *The Cancellation of Redskins as a Disparaging Trademark: Is Federal Trademark Law an Appropriate Solution for Words That Offend?*, 72 U. COLO. L. REV. 415, 443–44 (2001).

¹⁴⁹ 660 F.2d 481 (C.C.P.A. 1981).

Section 2(a) was constitutional under the First Amendment because it was “sufficiently precise to enable the PTO and the courts to apply the law fairly and to notify a would-be registrant that the mark he adopts will not be granted a federal registration.”¹⁵⁰

However, on December 22, 2015, the Federal Circuit abrogated *In re McGinley* and held Section 2(a) unconstitutional—a decision that has sent shockwaves throughout the trademark community.¹⁵¹ The case is *In re Tam*.¹⁵² In 2013, the PTO rejected a trademark for “THE SLANTS.”¹⁵³ In that case, a band called THE SLANTS sought federal registration for the mark in order to identify services within International Class 41 for “entertainment in the nature of live performances by a musical band.”¹⁵⁴ On initial review, the examiner rejected the mark considering “that THE SLANTS is a highly disparaging reference to people of Asian descent, that it retains this meaning when used in connection with applicant's services, and that a substantial composite of the referenced group finds it to be disparaging.”¹⁵⁵ Importantly, the PTO decided that it did not matter whether the band was using the term with good intentions, noting:

The fact that applicant has good intentions underlying his use of the term does not obviate the fact that a substantial composite of the referenced group find the term objectionable. As the examining attorney states “while applicant may not find the term disparaging, applicant does not speak for the entire community of persons of Asian descent and the evidence indicates that there is still a substantial composite of persons who find the term in the applied-for mark offensive.” Thus, despite applicant's assertion that “this is not yet another case of a member of an ethnic group seeking

¹⁵⁰ *Id.* at 484.

¹⁵¹ See Dennis Crouch, *Free Speech: Prohibition on Registering Disparaging Marks in Unconstitutional, Federal Circuit Rules*, PATENTLY-O (Dec. 22, 2015), <http://patentlyo.com/patent/2015/12/registering-disparaging-unconstitutional.html>.

¹⁵² 808 F.3d 1321 (Fed. Cir. 2015).

¹⁵³ *In re Simon Shiao Tam*, 108 U.S.P.Q.2d 1305, 2013 WL 5498164 at *8 (T.T.A.B. 2013), *reversed sub nom.*, *In re Tam*, 808 F.2d 1321 (Fed. Cir. 2015).

¹⁵⁴ *Id.* at *1.

¹⁵⁵ *Id.*

registration of a supposedly offensive slur on the ground that group members, or he in particular, have ‘embraced’ the term,” in fact it is just such a case.¹⁵⁶

After percolating through the courts, the Federal Circuit, en banc, left aside the “substantial composite” analysis and confronted the constitutional issue head on. In an opinion authored by Judge Kimberly Moore, the Federal Circuit proclaimed:

The government cannot refuse to register disparaging marks because it disapproves of the expressive messages conveyed by the marks. It cannot refuse to register marks because it concludes that such marks will be disparaging to others. The government regulation at issue amounts to viewpoint discrimination, and under the strict scrutiny review appropriate for government regulation of message or viewpoint, we conclude that the disparagement proscription of § 2(a) is unconstitutional. Because the government has offered no legitimate interests justifying § 2(a), we conclude that it would also be unconstitutional under the intermediate scrutiny traditionally applied to regulation of the commercial aspects of speech.¹⁵⁷

Acknowledging that “[c]ourts have been slow to appreciate the expressive power of trademarks,” the court went onto describe how Section 2(a) was a law discriminating on the content of proposed marks, as well as their viewpoint.¹⁵⁸ For example, Judge Moore opined that speech that is “offensive or hostile to a particular group conveys a distinct viewpoint from speech that carries a positive message about the group.”¹⁵⁹ For example, calling to mind the *Geller* case, the court noted that the accepted trademark of THINK ISLAM¹⁶⁰ is the opposite viewpoint of STOP

¹⁵⁶ *Id.* at *8 (internal citations omitted).

¹⁵⁷ *In re Tam*, 808 F.3d at 1328.

¹⁵⁸ *Id.* at 1339–45.

¹⁵⁹ *Id.* at 1337.

¹⁶⁰ THINK ISLAM, U.S. Reg. No. 4,719,002.

THE ISLAMISATION OF AMERICA. On the one hand, THINK ISLAM portrays a positive message of welcoming and invitation, while STOP THE ISLAMISATION OF AMERICA portrays a sense of otherness, whether religiously or politically. And, therefore, if THINK ISLAM was accepted, while Geller's trademark was rejected, then Section 2(a) *was* viewpoint discriminatory.¹⁶¹ Consequently, the almost always deadly strict scrutiny standard applied to Section 2(a).

The Federal Circuit's reasoning is both powerful and persuasive. Not only is Section 2(a) unconstitutional based on its text, but when combined with an examiner's subjective (and often selective) interpretation of evidence, a perfect storm of viewpoint and content discrimination occurs. It is an old adage in America that the First Amendment protects hurtful speech.¹⁶² To be frank: if a message hurts another's feelings, then *so what*. The Government has no role in moderating that speech. Now, this is not meant to be callous ignorance towards the humanity of others. Rather, it is an embrace of broad free speech rights.

V. LOOKING FORWARD

In all likelihood, the Supreme Court will have the final say about the constitutionality of Section 2(a). As of the authoring of this Note, two events have made this likely. First, the Government appealed the Federal Circuit's decision on April 20, 2016.¹⁶³ And second, the U.S. Court of Appeals for the Fourth Circuit is confronting this exact question in the long-standing trademark drama involving the Washington Redskins.¹⁶⁴ There, the question is the same: is Section 2(a) an unconstitutional abridgment of free speech? If the Fourth Circuit disagrees, then there will be a Circuit split. If the Fourth Circuit agrees, then a seventy-year-old federal statute will have been found unconstitutional by two circuits. Those are certainly waters the Court would need to enter.

Ultimately, if the Court considers the issue, then I believe the Hodgepodge should meet its end. Admittedly, it is hard to

¹⁶¹ *In re Tam*, 808 F.3d at 1337.

¹⁶² *Snyder v. Phelps*, 562 U.S. 443 (2013) (upholding Westboro Baptist Church's ability to protest funerals and opining "As a Nation we have chosen a different course—to protect even hurtful speech on public issues to ensure that we do not stifle public debate.")

¹⁶³ *Lee v. Tam*, Docket No. 15-1293 (petition filed April 20, 2016).

¹⁶⁴ *See Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015), *on appeal* (4th Cir. Filed Aug 06, 2015) (No. 15-1874).

acknowledge that a seventy-year-old statute has been an unconstitutional abridgement of free speech the entire time. But, that should play no role in the calculation. If a statute violates a fundamental aspect of our constitution, then judges should so say—no matter how long the monster has evaded capture.¹⁶⁵

¹⁶⁵ See Randy Barnett, *Our Republican Constitution: Securing the Liberty and Sovereignty of We the People* 224 (Broadside Books) (2016) (arguing that in a proper functioning constitutional republic, judges should reject judicial minimalism and enforce “the veto gates of our Republican Constitution.”).