The Trademark Prudes Strike Again

Thomas G. Field, Jr.

The bar on registration of scandalous marks needn't be embraced so heartily.

Since 1979, Marsha Fox has sold chocolate suckers in the form of roosters "primarily, [to] fans of the University of South Carolina and Jacksonville State University, both of which employ gamecocks as their athletic mascots." In re Fox, 2012 WL 6602862 (Fed. Cir.) (Fox II). In 2001, she filed, pro se, to register the mark depicted above. *See* 2011 WL 6012204 at 1 (TTAB 2011) (Fox I) (nonprecedential).

In *Fox I*, the board affirms an ex parte rejection under Lanham Act § 2(a), saying, "consumer statements submitted by applicant tend [to, sic] corroborate her argument that some consumers find her mark to be inoffensive. Nevertheless, the lollipops are available to all consumers, including parents shopping with children. Moreover, even if some consumers find the product whimsical and innocuous, they may still find that the mark is vulgar." *Fox I* at *3-4.

Before the TTAB, Ms. Fox relied on a prior registration for BIG PECKER t-shirts. *See* In re Hershey, 6 U.S.P.Q.2d 1470 (TTAB 1988). The board, however, finds, "Unlike in the case before us, the Board in *Hershey* found that the evidence was "at best marginal to demonstrate that the mark is a vulgar, slang reference to male genitalia and would be recognized as such a reference by a substantial composite of the general public." *Fox I* at *3 (citing *Hershey* at 1471).

On appeal, the Federal Circuit affirms. *Fox II* at *6. With regard to *Hershey*, it writes, "we do not decide whether *Hershey* supports Fox's position, or whether *Hershey* was correctly decided. To the extent, however, that *Hershey* can be read to suggest that a mark that clearly is recognizable as a double entendré is exempt from [15 U.S.C.] § 1052(a) for that reason

alone, that is an incorrect reading of the statute." *Fox II* at *5 n.3. Indeed, as the court has previously noted, "that… some marks have been registered even though they may be in violation of the governing statutory standard does not mean that the agency must forgo applying that standard in all other cases." In re Boulevard Entm't, Inc., 334 F.3d 1336, 1343 (Fed. Cir. 2003).

Fox argued that *Boulevard* and In re Mavety Media Grp. Ltd., 33 F.3d 1367 (Fed. Cir. 1994), support the registerability of marks comprising double entendrés despite § 2(a), but the court disagrees. Why the first was argued is unclear, but the court says, "In *Boulevard*, this court dealt with a situation in which the only pertinent definition of the term at issue was vulgar." *Fox II* at *5 (citation omitted).

The court's treatment of *Mavety* is less convincing. That opinion "considered the mark BLACK TAIL as applied to 'an adult entertainment magazine featuring photographs of both naked and scantily-clad African-American women.' The Board affirmed the examiner's refusal to register the mark, citing a vulgar dictionary definition of 'tail' as 'a female sexual partner. …. The court reversed, holding that '[i]n view of the existence of … an alternate, non-vulgar definition' (a woman's rear end), the Board erred by refusing registration based solely on the existence of a vulgar dictionary definition, without identifying any '[extrinsic] evidence as to which of these definitions the substantial composite would choose.' Nowhere in its opinion did the court describe the constellation of meanings at issue as a 'double entendré' …." *Fox II* at *4 (citations omitted). With all due respect, that comes across as evasive, semantic quibbling.

Mavety also bears in a more significant way. Fox argued that the case supports the idea that her mark should be published for opposition. The court finds, however, that publication is warranted only "where registrability of the mark is uncertain. Here there is no uncertainty. Where, as here, the PTO has properly determined that a mark is 'scandalous' … there is no

obligation to publish the mark…. Congress has empowered the PTO to serve as the first line of defense against 'scandalous' marks …, and this court has no authority to read such a power out of existence." *Fox II* at *6.

Mavety, however, doesn't seem to be so easily dismissed. Some might well find the mark in that case to be both racist and sexist but perhaps not in context. Some might see the text component of the mark Fox sought to register as patently offensive in some settings, but that does not address the mark as a whole, nor the market in which it is used. The court says: "We recognize that there are 'whimsical' and humorous aspects to Fox's mark. But the fact that something is funny does not mean that it cannot be 'scandalous.'" *Fox II* at *5. Yet, were it truly scandalous in the context of its use, surely that would have become apparent during more than two decades. Indeed, given the protracted proceedings, it has now been used for more than three decades. The mark might be seen by children. That children young enough to warrant solicitude would understand the double entendré, however, seems to border on silly.

Given long use of her arguably strong mark, it is difficult to see why Fox sought registration or continued to pursue it after being rejected. Internet marketing could quickly expand her market to cover the entire country, thereby achieving what may be the most significant benefit of registration. *See, e.g.,* Burger King of Florida, Inc. v. Hoots, 403 F.2d 904, 908 (7th Cir. 1968) ("Congress intended the Lanham Act to afford nation-wide protection to federally-registered marks, and that once the certificate has issued, no person can acquire any additional rights superior to those obtained by the federal registrant.")

The court says, "Fox will remain free to use her mark in commerce." *Fox II* at *6. That proposition is beyond debate; one needs no registration to use. Remarkably, the opinion follows immediately with the observation, "She will be unable, however, to call upon the resources of the federal government in order to enforce that mark." That proposition is simply

false. Without registration, Fox may not enjoy the presumption in § 7(b), but, that aside, she has access to all the federal resources needed to enforce her rights under § 43(a)(1(A).