1203.01 Immoral or Scandalous Matter

Section 2(a) of the Trademark Act, **15 U.S.C. §1052(a)**, is an absolute bar to the registration of immoral or scandalous matter on either the Principal Register or the Supplemental Register.

Although the words "immoral" and "scandalous" may have somewhat different connotations, case law has included immoral matter in the same category as scandalous matter. *See In re McGinley*, 660 F.2d 481, 484 n.6, 211 USPQ 668, 673 n.6 (C.C.P.A. 1981) , *aff'g*206 USPQ 753 (TTAB 1979) ("Because of our holding, *infra*, that appellant's mark is 'scandalous,' it is unnecessary to consider whether appellant's mark is 'immoral.' We note the dearth of reported trademark decisions in which the term 'immoral' has been directly applied.")

The prohibition against the registration of marks that consist of or comprise immoral or scandalous matter was originally enacted as §5(a) of the Trademark Act of 1905, and was reenacted as part of §2(a) of the Act of 1946. There is little legislative history concerning the intent of Congress with regard to the provision; therefore, the term "scandalous" is interpreted by looking to "its ordinary and common meaning." *In re Riverbank Canning Co.*, 95 F.2d 327, 328, 37 USPQ 268, 269 (C.C.P.A. 1938) . The Court has noted, however, that the word "comprises" meant "includes" at the time of the statute's enactment in 1905, and thus Congress extended the prohibition not only to marks that consist of scandalous matter, but also to marks that include scandalous matter. *In re Fox*, 702 F.3d 633, 638, 105 USPQ2d 1247, 1250 (Fed. Cir. 2012) (holding scandalous a mark for rooster-shaped chocolate lollipops where, in the context of the goods, "a substantial composite of the general public perceives" a scandalous meaning, even though the mark had a non-scandalous meaning in relation to the goods as well). Moreover, there is no requirement in §2(a) that a mark's vulgar meaning be the only relevant meaning, or even the most relevant meaning. *Id*. Thus, an examining attorney need only prove the existence of one vulgar meaning to justify a §2(a) refusal. *Id*. This may be established by referring to court decisions, decisions of the Trademark Trial and Appeal Board and dictionary definitions. *McGinley*, 660 F.2d at 485, 211 USPQ at 673.

In affirming a refusal to register a mark as scandalous under §2(a), the Court of Customs and Patent Appeals noted dictionary entries that defined "scandalous" as, *inter alia*, shocking to the sense of propriety, offensive to the conscience or moral feelings or calling out for condemnation. *McGinley*, 660 F.2d at 486, 211 USPQ at 673 (holding scandalous a mark comprising a photograph of a nude, reclining man and woman, kissing and embracing, for a "newsletter devoted to social and interpersonal relationship topics" and for "social club services"). The statutory language "scandalous" has also been considered to encompass matter that is "vulgar," defined as "lacking in taste, indelicate, morally crude." *In re Runsdorf,* 171 USPQ 443, 444 (TTAB 1971).

The meaning imparted by a mark must be determined in the context of the current attitudes of the day. *See In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 31 USPQ2d 1923 (Fed. Cir. 1994) (finding the evidence insufficient to establish that BLACK TAIL, used on adult entertainment magazines, comprises scandalous matter; noting that there were both vulgar and non-vulgar definitions of "tail," and that the record was devoid of evidence demonstrating which of these definitions a substantial composite of the general public would choose in the context of the relevant marketplace); *In re Michalko*, 110 USPQ2d 1949, 1953 (TTAB 2014) (finding the evidence sufficient to establish that ASSHOLE remains vulgar and offensive under modern standards of usage); *In re Old Glory Condom Corp.*, 26 USPQ2d 1216 (TTAB 1993) (holding not scandalous OLD GLORY CONDOM CORP and design comprising the representation of a condom decorated with stars and stripes in a manner to suggest the American flag); *In re Thomas Labs., Inc*., 189 USPQ 50, 52 (TTAB 1975) ("[I]t is imperative that fullest consideration be given to the moral values and conduct which contemporary society has deemed to be appropriate and acceptable.")

The determination of whether a mark is scandalous must be made in the context of the relevant marketplace for the goods or services identified in the application, and must be ascertained from the standpoint of not necessarily a majority, but a "substantial composite of the general public." As long as a substantial composite of the general public would perceive the mark, in context, to have a vulgar meaning, "the mark as a whole 'consists of or *comprises* . . . scandalous matter'" under §2(a). *In re Fox*, 702 F.3d at 638, 105 USPQ2d at 1250 (quoting **15 U.S.C. §1052(a)** (emphasis added); *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1340, 67 USPQ2d 1475, 1477 (Fed. Cir. 2003); *McGinley*, 660 F.2d at 485, 211 USPQ at 673 ("[T]he Lanham Act does not require, under the rubric of 'scandalous,' any inquiry into the specific goods or services not shown in the application itself."); *In re Star Belly Stitcher, Inc*., 107 USPQ2d 2059 (TTAB 2013) (finding the evidence sufficient to establish prima facie that the term "aw shit" is scandalous or vulgar to the conscience of a substantial composite of the general public); *In re Luxuria s.r.o.*, 100 USPQ2d 1146 (TTAB 2011) (finding a mark consisting of a bottle in the shape of a hand with middle finger extended upwards comprised matter that would be considered vulgar by a substantial composite of the general public); *In re Wilcher Corp.*, 40 USPQ2d 1929 (TTAB 1996) (holding scandalous a mark for restaurant and bar services consisting of words DICK HEADS positioned directly underneath caricature of a human head composed primarily of graphic and readily recognizable representation of male genitalia, as it would be considered offensive by a substantial portion of the public); *Greyhound Corp. v.*

Both Worlds Inc., 6 USPQ2d 1635, 1639 (TTAB 1988) (holding scandalous a graphic design of a dog defecating, as applied to polo shirts and T-shirts, given the broad potential audience that may view applicant's mark in sales establishments and "virtually all public places"); *In re Hepperle,* 175 USPQ 512 (TTAB 1972) (holding ACAPULCO GOLD not scandalous when used as a mark for suntan lotion even though the words might be a reference to marijuana).

Therefore, to support a refusal on the ground that a proposed mark is immoral or scandalous, the examining attorney must provide evidence that a substantial portion of the general public would consider the mark to be scandalous in the context of contemporary attitudes and the relevant marketplace. *Mavety Media,* 33 F.3d at 1371-72, 31 USPQ2d at 1925-26. This evidence could include dictionary definitions, newspaper articles, and magazine articles. The examining attorney should not rely solely on an earlier decision holding a term to be scandalous in support of a refusal. The Trademark Trial and Appeal Board has held that an earlier decision is insufficient to warrant the same finding in a future case. *In re Red Bull GmbH*, 78 USPQ2d 1375 (TTAB 2006) (rejecting examining attorney's argument that the Board's 1981 decision in *In re Tinseltown, Inc.*, *212 USPQ* 863 (TTAB 1981) finding BULLSHIT to be scandalous is sufficient to warrant the same finding in a later case). Rather, the facts underlying the earlier decision must be looked at to determine, first, whether it has any relevance to the present case, and, if so, whether that earlier finding is equally applicable today, for example, by looking at other evidence such as recent dictionary definitions. *Red Bull*, 78 USPQ2d at 1381.

Dictionary definitions alone may be sufficient to establish that a proposed mark comprises scandalous matter, where multiple dictionaries, including at least one standard dictionary, all indicate that a word is vulgar, and the applicant's use of the word is limited to the vulgar meaning of the word. *Boulevard Entm't,* 334 F.3d at 1341, 67 USPQ2d at 1478 (holding 1-800-JACK-OFF and JACK OFF scandalous, where all dictionary definitions of "jack-off" were considered vulgar); *In re Manwin/RK Collateral Trust*, 111 USPQ2d 1311, 1314 (TTAB 2014) (finding dictionary definitions alone sufficient to make prima facie showing that mark MOMSBANGTEENS comprises vulgar matter); *In re Star Belly Stitcher*, 107 USPQ2d 2059 at 2062 (stating that dictionary evidence showed that the terms "shit" and "aw shit" are vulgar terms); *Boston Red Sox Baseball Club Ltd. P'ship v. Sherman*, 88 USPQ2d 1581 (TTAB 2008) (sustaining an opposition and finding that SEX ROD was immoral and scandalous under §2(a) based on dictionary definitions designating the term "ROD" as being vulgar, and applicant's admission that SEX ROD had a sexual connotation); *Red Bull,* 78 USPQ2d at 1381-82 (finding multiple dictionary definitions indicating BULLSHIT is "obscene," "vulgar," "usually vulgar," "vulgar slang," or "rude slang" constitute a prima facie showing that the term is offensive to the conscience of a substantial composite of the general public).

"Whether applicant intended the mark to be humorous, or even whether some people would actually find it to be humorous, is immaterial." *In re Luxuria, s.r.o.*, 100 USPQ2d at 1149 (quoting *Boston Red Sox Baseball Club*, 88 USPQ2d at 1588). A refusal is proper if the evidence shows that "the term would be perceived and understood as vulgar by a substantial portion of the purchasing public." *Id.*; *see also Fox*, 702 F.3d at 634, 105 USPQ2d at 1248 ("a mark that creates a double entendre falls within the proscription of §1052(a) where, as here, one of its meanings is clearly vulgar"); *In re Star Belly Stitcher*, 107 USPQ2d at 2063 ("[T]here is no requirement in Section 2(a) that a mark's vulgar meaning must be the only relevant meaning, or even the most relevant meaning.").

It has been noted that the threshold is lower for what can be described as "scandalous" than for "obscene." Refusal to register immoral or scandalous matter has been found not to abridge First Amendment rights, because no conduct is proscribed and no tangible form of expression is suppressed. Also, the term "scandalous" has been held sufficiently precise to satisfy due process requirements under the Fifth Amendment. *McGinley*, 660 F.2d at 484-85, 211 USPQ at 672.

The prohibition in §2(a) of the Act against the registration of scandalous matter pertains only to *marks* that are scandalous. The authority of the Act does not extend to goods that may be scandalous. *See In re Madsen*, 180 USPQ 334, 335 (TTAB 1973) (holding WEEK-END SEX for magazines not scandalous and observing that whether the magazine contents may be pornographic was not an issue before the Board).

The examining attorney may look to the specimen(s) or other aspects of the record for confirmation that a substantial composite of the general public would perceive the mark to be vulgar in the context of the goods or services at issue. *See McGinley,* 660 F.2d at 482 n.3, 211 USPQ at 670 n.3 (referring to excerpts from appellant's newsletters pertaining to the sexual connotation of the subject matter).

To ensure consistency in examination with respect to immoral or scandalous matter, when an examining attorney believes, for whatever reason, that a mark may be considered to comprise such matter, the examining attorney must consult with his or her supervisor.