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## Liberty or Licentiousness: Disinsenting, Disparaging, and Scandalous Marks Post-Tam and Brunetti

Ilewellyn Joseph Gibbons

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**LIBERTY OR LICENTIOUSNESS:  
DISINSENTING, DISPARAGING, AND  
SCANDALOUS MARKS POST-*TAM* AND  
*BRUNETTI***

by LLEWELLYN JOSEPH GIBBONS<sup>1</sup>

*Sorry if we try too hard  
To take some power back for ours  
The language of oppression  
Will lose to education  
Until the words can't hurt us again<sup>2</sup>*

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<sup>1</sup> Distinguished University Professor of Law, University of Toledo College of Law. The author would like to thank his colleagues at the University of Toledo College of Law “half-baked ideas workshop,” 4<sup>th</sup> National People of Color Legal Scholarship Conference for their valuable comments and suggestions as well as the thoughts informally shared at the 5<sup>th</sup> Annual Texas A&M IP Scholars Roundtable. I would also like to thank Professor Yvette Joy Liebesman for her follow up comments on an early draft of this article. This article was supported in part by a University of Toledo College of Law Summer Research Grant. Finally, a special thank you to Professor Bruce Kennedy who patiently listened to the author’s explorations of equity and history, and Professor Rick Goheen for his assistance in finding obscure materials. As always, the author acknowledges that any value in this article is attributed to the useful comments and prior scholarship of others, and the errors are solely his.

<sup>2</sup> Simon Tam, *#ActToChange: Working to Fight Bullying and Oppression, From the Heart*, THESLANTS.COM (Dec. 8, 2016), <http://www.theslants.com/acttochange-working-to-fight-bullying-and-oppression/>.

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## INTRODUCTION

The most significant change to the principle and supplemental trademark registers after the U.S. Supreme Court decided *Matal v. Tam* (and most recently *Iancu v. Brunetti*) is that the USPTO should be required to give an “NSFW” or a trigger warning before allowing users to conduct trademark research.<sup>3</sup> The trademark registers are filling quickly with banal salacious vulgarities gaudy with indecency; ripe with gender, ethnic, and racial invective; and entirely lacking wit, charm, innuendo, or puerile humor that characterized earlier marks.<sup>4</sup> But alas, there is no accounting for bad taste.

The U.S. Supreme Court could be blamed for holding that the disparaging clause of § 2(a) of the Lanham Act was an unconstitutional violation of the First Amendment<sup>5</sup> or for extending *Tam*'s holding in *Brunetti* to strike down the § 2(a)'s immoral or scandalous prohibition on federal trademark registration clause.<sup>6</sup>

Or Congress could be blamed for artless statutory drafting and recklessly creating a vacuous legislative history that provided the courts no sound jurisprudential reason to decide these issues differently, especially

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<sup>3</sup> Daviddv0601, *NSFW*, UrbanDictionary (2017), <https://www.urbandictionary.com/define.php?term=NSFW>.

<sup>4</sup> TRADEMARK ELECTRONIC SEARCH SYSTEM (TESS), USPTO.GOV, <https://www.uspto.gov/trademark> (last visited Feb. 27, 2020) (For example, there are 522 permutations on the word “FUCK,” 26 permutations on the word “NIGGER,” 863 permutations on the word “SHIT,” 61 permutations for the word “PISS,” 43 permutations on the word “ASSHOLE,” 10 permutations of the word “MOTHERFUCKER,” 6 permutations on the word “CUNT,” and 3 permutations on the word “COCKSUCKER.” In this context, permutation means any combination of the profane term and it also includes applications that are both “live” and “dead”); See Vicenç Feliú, *The F Word - An Early Empirical Study of Trademark Registration of Scandalous and Immoral Marks in the Aftermath of the In Re Brunetti Decision*, 18 J. MARSHALL REV. INTELL. PROP. L. 404, 419-20 (2019) (explaining that there was no rush post-Tam and Brunetti to register profane terms); See generally Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks that May be Scandalous or Immoral*, 101 TRADEMARK REP. 1476 (2011) (salacious marks of an earlier more innocent era included BUBBY TRAP [for brassieres], ACAPULOCO GOLD [for suntan lotion], OLD GLORY [for condoms], BASTARD, DAMN, EFFIN [a euphemism for “fucking”], the middle finger, acronyms such as WTF [for “what’s the fuck”]); See also Stacy L. Wu and Seth I. Appel, *The Evolving Landscape of Disparaging and Scandalous Trademarks*, published in *Landslide*, Vol. 11, No. 6, (2019), [https://www.americanbar.org/groups/intellectual\\_property\\_law/publications/landslide/2018-19/july-august/evolving-landscape-disparaging-scandalous-trademarks/](https://www.americanbar.org/groups/intellectual_property_law/publications/landslide/2018-19/july-august/evolving-landscape-disparaging-scandalous-trademarks/) (last visited Nov. 11, 2020) (describing the registration of disparaging or scandalous marks as a “land grab” by lesser-known entrepreneurs).

<sup>5</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1765 (2017).

<sup>6</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294, 2302 (2019).

considering compelling First Amendment policies that disfavor government regulation of speech.<sup>7</sup> Perhaps, the best result would be to share the credit equally for the current mishigas.

Better yet, the blame-slate could be wiped clean, and the analytical focus shifted from allocating blame to searching for a solution. There are at least three possible solutions. First, the courts and the United States Patent Office (“USPTO”) could strictly apply existing viewpoint-neutral trademark registration principles when examining scandalous or disparaging marks and find that often they are not serving a trademark signaling function. Second, Congress could accept the Supreme Court’s implicit invitation in *Brunetti* and enact a constitutional limitation on trademark registration prohibiting registering scandalous marks. Finally, the best option could be for the courts to look to their inherent powers in equity jurisdiction when crafting a remedy to constrain incentives to encourage the registration of the most vulgar and offensive of marks.

Courts have experience balancing the individualized needs of speakers and the speaker’s preferred choice of expression—obviously, for example, in the cases of obscene or pornographic speech. Courts have determined whether speech serves a trademark function expressing source, origin, or sponsorship or merely an ornithological use, generic or other use without secondary meaning. And, like obscenity, the courts know fighting words when they see or hear them. In the context of broadcast television, the courts know which profane terms constitute a nuisance—or at least ones that are temporally regulatable by the FCC. The marks that preoccupy this article are not puerile or merely salacious—those that give offense but do not cause injury. Instead, the marks that this article focuses on are those on the spectrum from hate-speech to fighting words. This article limits itself to the consideration of marks that constitute fighting words or similar terms that are already regulated consistent with the First Amendment, such as the N-word, C-word, F-word, or equivalent designations defamatory or profane as well as scandalous.<sup>8</sup> These words are outside the mainstream of communication and contribute infinitesimally to discourse.<sup>9</sup> Enforcing these designations as trademarks (incentivizing them) under principles of equity would add little societal value. At the same time, correspondingly, there may

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<sup>7</sup> See *Matal v. Tam*, 137 S. Ct. 1744, 1748 (2017); see also Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and Immoral and the Disparaging: Section 2(a) Trademark Law After Lawrence v. Texas*, 9 MARQ. INTEL. PROP. L. REV. 187, 233 (2005).

<sup>8</sup> In this context, the *F*-word is faggot, a derogatory term often used towards gay men but may be used towards other members of the LGBTQ+ communities.

<sup>9</sup> See *Iancu v. Brunetti*, 139 S. Ct. 2294, 2303 (2019) (Alito, J., concurring in part); (Roberts, C.J., concurring and dissenting), at 2304; (Breyer, J., concurring and dissenting).

be significant societal damage if these terms are presented to the public more frequently.<sup>10</sup> This article will use the term “profane” in a manner analogous to the FCC definition to describe the types of offensive marks with which this article is concerned. Moreover, in this article, to be a profane or indecent (scandalous) mark, the offensiveness must be “in the mode of communication rather than the [expressed] idea.”<sup>11</sup>

Concededly, there is no bright line that separates profane marks that are the semiotic equivalent of fighting words from marks that are merely common vulgarity. Also, a significant part of analyzing speech, both in terms of law and meaning, involves identifying the speaker and context in which the communication is made and the audience.<sup>12</sup> This process requires nuance in adjudication. For example, using the *N*-word by an individual or member of a group stigmatized by the term *may* depending on use and context and add value to the social discourse.<sup>13</sup> There is a transformative value-added to the discourse regardless of the government’s approval or disapproval of the message.<sup>14</sup> For the purposes of this article, a transformative use of a profane make is a trademark use that adds “adds something new, with a further purpose or different character, altering the first with new expression, meaning or message...” In contrast, when used by an individual or group *merely* to degrade or insult others, the *N*-word merely conveys animus without adding new value or meaning to the term in the context of the proffered discourse.<sup>15</sup> The pejorative remains untransformed, carrying only a derogative emotive weight. In this analytical context, the speaker and context analysis are analogous to the transformational use analysis of a work under copyright law, which is more highly valued and

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<sup>10</sup> See *F.C.C. v. Pacifica Found.*, 98 S. Ct. 3026, 3028 (1978).

<sup>11</sup> See *Brunetti*, 139 S. Ct. at 2310 (Sotomayor, J., concurring in part).

<sup>12</sup> Cf. *Synder v. Phelps*, 562 U.S. 443, 454-455 (2011).

<sup>13</sup> See Keith Allan, *Contextual determinants on the meaning of the N word*, SPRINGERPLUS 5, 1141 (2016) (discussing three types of uses of the *N*-word), <https://doi.org/10.1186/s40064-016-2813-1>; RANDALL KENNEDY, *NIGGER, THE STRANGE CAREER OF A TROUBLESOME WORD* 30 (Random House 2008); Cf. Meaghan Annett, *When Trademark Law Met Constitutional Law: How A Commercial Speech Theory Can Save The Lanham Act*, 61 B.C. L. REV. 253, 267-268 (2020).

<sup>14</sup> *Author’s Guild, Inc. v. HathiTrust*, 755 F.3d. 87, 96 (4th Cir. 2014) (citations omitted) “[A] transformative work is one that serves a new and different function from the original work and is not a substitute for it.”; *Id.* (citations omitted). The transformative use analysis is well developed in copyright law and could readily be incorporated by analogy into trademark law.

<sup>15</sup> See generally Shanye E. Jones & Gregory S. Parks, “Nigger”: A Critical Race Realist Analysis of the *N*-Word Within Hate Crimes Law, CRIMINOLOGY FAC. PUBL’N. Paper 1, (2013), [http://scholarcommons.usf.edu/cjp\\_facpub/1](http://scholarcommons.usf.edu/cjp_facpub/1).

protected more than a mere mindless unoriginal reproduction of the copyrighted work.<sup>16</sup>

This article contends that the courts are in the best position to delicately weigh competing interests at the equitable remedy stage when crafting an appropriate level of relief among speakers, commercial competitors, and involuntary listeners. The USPTO often made pre-*Tam*, an implicit determination of societal value in an *ex parte* administrative proceeding without a fully developed record.<sup>17</sup> On rare occasions, when parties litigated profane marks before an Article III court, the adjudication was part of a trademark registration cancellation proceeding. The claims presented a court with a false dichotomy: maintain the registration or cancel the registration. However, logically, there is a third choice. Register the mark but craft a limited equitable remedy that accommodates congressionally stated public policies and the public's interest in using the mark—especially First Amendment rights in the mark as a form of commercial speech.

Courts that enforce federal trademarks do so subject to the principles of equity, and equity also provides a solution.<sup>18</sup> Courts have a long history of balancing the rights of speakers and audiences. At the remedy stage, this article does not challenge whether the First Amendment protects these marks. They are. It does not question whether, when used as part of truthful speech or otherwise legal speech, the speaker is fully protected by the First Amendment for the use of pernicious marks. The speaker is. Instead, this article raises a much different question. Whether courts must provide an expansive remedy, especially in equity, for trademark infringement for pernicious trademark-speech has been a hotly contested question, *Tam* and *Brunetti* now move the battle over the role of equity from protecting pornographic, copyrighted speech to the protection of harmful, pornographic marks (a form of commercial expression). Inherent in this issue is whether the right to register a mark guarantees a right of access to all available statutory remedies at their broadest scope for its infringement. If not, under what circumstances and under what limits should a court grant an equitable remedy to stop the infringement of a profane mark?

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<sup>16</sup>Cf. *Harper & Row Publishers, Inc. v. Nation Enterprises*, 105 S. Ct. 2218, 2225 (1985).

<sup>17</sup>See *In re Brunetti*, 2014 WL 3976439, at 5 (TTAB Aug. 1, 2014) (“Finally, we readily recognize the statutory limitations of this tribunal. It is abundantly clear that the Trademark Trial and Appeal Board is not the appropriate forum for re-evaluating the impacts of any evolving First Amendment jurisprudence within Article III courts upon determinations under Section 2(a) of the Lanham Act, or for answering the Constitutional arguments of legal commentators or blog critics.”).

<sup>18</sup>See *United States Pat. & Trademark Off. v. Booking.com B.V.*, 140 S. Ct. 2298, 2302 (2020).

Equity may not enjoin the registration of disparaging, scandalous, or immoral marks.<sup>19</sup> Still, equity may return the available remedies to the *status-quo-ante* when pre-*Tam* and pre-*Brunetti* trademark law would not help the commercial legitimization of an offensive designation through dominant social or commercial institutions coupled with the government's scarlet ® imprimatur through the federal registration of trademarks that were detrimental to society.<sup>20</sup> Federal courts should not provide an unnecessary de-facto subsidy for profane offensive injurious speech through the rigorous enforcement or protection of these marks in equity. Federal trademark protection constitutes a subsidy to commercial speech.<sup>21</sup> The right to free speech and property rights in a trademark does not entitle the speaker to maximum commercial speech subsidy provided by trademark law. The removal or narrowing of an equitable remedy will disincentivize trademark speech that serves no societal purpose. At least elementary microeconomic theory teaches that this should result in fewer profane marks.<sup>22</sup> At first blush, this may seem repugnant to the First Amendment or the principle that there must be a potent remedy for each right's infringement.<sup>23</sup> However, "[t]he grant of jurisdiction to ensure compliance with a statute hardly suggests an

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<sup>19</sup> See *infra* Section V.

<sup>20</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1759 (2017) (dismissing the significance of the ® signifier as a federal imprimatur in the minds of the public). *But see* *Iancu v. Brunetti*, 139 S. Ct. 2294, 2305 (2019) (Breyer, J., concurring in part) (The Court relied on two cases where judges simply assert public ignorance, disinterest, or uninterest in the significance of the ® without any citation to the factual record, legislative history, any other source, including formally taking judicial notice. The trademark registration symbol must serve some purpose to the consumer as well as to competitors even if *all* the consumer understands that economically significant companies are entitled to use the ® symbol through a process of consumer osmosis from persistent market exposure); *Copelands' Enterprises, Inc. v. CNV, Inc.*, 945 F.2d 1563, 1566 (Fed. Cir. 1991) (explaining that courts have considered the unauthorized use of the ® in claims for the cancellation of a mark); *Virginia Polytechnic Inst. & State Univ. v. Hokie Real Estate, Inc.*, 813 F. Supp. 2d 745, 757 (W.D. Va. 2011) (false advertising); *PepsiCo, Inc. v. Reyes*, 70 F. Supp. 2d 1057, 1060 (C.D. Cal. 1999) (holding "failure to use the proper trademark registration symbols, also are material and demonstrate that there is a likelihood of confusion and deception concerning the nature and origin of the goods."); See also §19:146. Misuse of Statutory Notice, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §19:146 (5th ed.); *Skydive Arizona, Inc. v. Quattrocchi*, 673 F.3d 1105, 1110 (9th Cir. 2012) (explaining that one of the elements in a false advertising case is "the deception is material, in that it is likely to influence the purchasing decision.").

<sup>21</sup> See *Matal v. Tam*, 137 S. Ct. 1744, 1761 (2017); See *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297-2298 (2019).

<sup>22</sup> Cf. *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 863 n.80 (5th Cir. 1979).

<sup>23</sup> See *Marbury v. Madison*, 5 U.S. 137, 163 (1803); *Leo Feist, Inc. v. Young*, 138 F.2d 972, 974 (7th Cir. 1943); See also "*Ubi Jus Ibi Remedium*" BLACK'S Law Dictionary, (11th ed. 2019).



absolute duty to do so under any and all circumstances, and a federal judge sitting as chancellor [in equity] is not mechanically obligated to grant an injunction for every violation of law.”<sup>24</sup>

Part I considers whether infringing these profane marks cause an injury worthy of addressing. Part II evaluates whether Congress could enact a constitutionally firm trademark regime that would disincentivize profane mark registration. This section concludes that while revising the Lanham Trademark Act is possible, Congress is unlikely to do so. This article will then analyze one remaining realistic option for courts to use equitable limitations on enforcement and remedies to provide a disincentive to the registration of profane marks. To develop the thesis that the existing doctrines of equity may be used to discourage the registration and commercial development of the most extreme disparaging, immoral, or scandalous (“profane”) marks by creating an equitable disincentive, Part III of this article will review the moral and equitable development of other forms of intellectual property law. Part IV will analyze the enforcement of trademarks in equity. Part V will consider the equitable enforcement of profane trademarks post-*Tam* and *Brunetti*. This article will conclude that using existing limitations on equitable remedies presents a possible robust solution to discourage registration of profane marks by legitimate businesses. Accordingly, the solution of denying an equitable remedy or crafting the narrowest of remedies is simple, elegant, and consistent with First Amendment values. Nevertheless, limiting equitable remedies will provide little to no deterrence for marks (or products) that exist on the margins of the law or for whom the mark’s purpose is to offend, communicate, or challenge societal norms.

## I. THE NUANCE NUISANCE OF AN OFFENSIVE MARK; NAMES CAN HURT

Unfortunately, social science literature suggests that profane marks incorporate stereotypes that are more than merely a social faux pas offensive only to so-called “snowflakes.” Instead, these stereotypes also reinforce implicit and explicit bias engendering cognizable individual and societal harm.<sup>25</sup> The social science literature suggests, and courts have long held that

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<sup>24</sup> *Weinberger v. Romero-Barcelo*, 456 U.S. 305, 313 (1982).

<sup>25</sup> See Florian Arendt & Temple Northup, *Effects of Long-Term Exposure to News Stereotypes on Implicit and Explicit Attitudes*, 9 INT’L J. OF COMM. 2370 (2015), <https://ijoc.org/index.php/ijoc/article/view/2691/1325>; See generally Richard Delgado, *Words that Wound: A Tort Action for Racial Insults, Epithets, and Name-Calling*, 17 HARV.

these terms cause psychological and social damage.<sup>26</sup> The American Psychological Association (APA) resolved that “the continued use of American Indian mascots, symbols, images, and personalities establishes an unwelcome and often times hostile learning environment for American Indian students that affirms negative images/stereotypes that are promoted in mainstream society.”<sup>27</sup> The APA further resolved that “the continued use of American Indian mascots, symbols, images, and personalities by school systems appears to have a negative impact on the self-esteem of American Indian children.”<sup>28</sup> These stereotypes are harmful not only because they are disparaging but also because they remind the referenced group of “the limited ways others see them and, in this way, constrain how they can see themselves.”<sup>29</sup> Stereotypes are associated with lower self-esteem, decreased aspirations, lower performance levels on tests, and problematic interpersonal relations.<sup>30</sup>

The response by non-minority groups to these daily slights, injuries, and other forms of microaggression suffered by others is often “don’t be a snowflake.” However, the advice is only honored so long as their affinity group is not targeted with commercial invective.<sup>31</sup> Children learn a wise but

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C. R.-C.L. L. REV. 133 (1982); Robert T. Carter, *Racism and Psychological and Emotional Injury: Recognizing and Assessing Race-Based Traumatic Stress*, 35 THE COUNSELING PSYCHOLOGIST 13 (2007) available at <https://tinyurl.com/y5hna7ce>; J.V. Sanchez-Hucles, *Racism: Emotional Abusiveness and Psychological Trauma for Ethnic Minorities*, 1 J. OF EMOTIONAL ABUSE 69 (1988).

<sup>26</sup> Cf. *Brown v. Board of Ed.*, 347 U.S. 483, 692 & n. 11 (1954) (citing psychological studies); but see, Charles R. Lawrence III, *The Id, The Ego, and Equal Protection: Reckoning with Unconscious Racism*, 39 STAN. L. REV. 317, 361-361 (1987) (“Our misgivings about allowing judicial decisions to turn on social science evidence are prompted, in large part, by social science’s inability to prove or disprove such propositions. If the proposed cultural meaning test required the courts to rely upon social scientists to conclusively demonstrate causal relationships between challenged governmental actions and harm to blacks, it would be subject to similar criticism concerning the inadequacy of social science methodology.”).

<sup>27</sup> *APA Resolution Recommending the Immediate Retirement of American Indian Mascots, Symbols, Images, and Personalities by Schools, Colleges, Universities, Athletic Teams, and Organizations*, AMERICAN PSYCHOLOGICAL ASSOCIATION, <https://www.apa.org/about/policy/mascots.pdf> (last visited Oct. 16, 2020).

<sup>28</sup> *APA Resolution Recommending the Immediate Retirement of American Indian Mascots, Symbols, Images, and Personalities by Schools, Colleges, Universities, Athletic Teams, and Organizations*, AMERICAN PSYCHOLOGICAL ASSOCIATION (last visited Oct 16, 2020), <https://www.apa.org/about/policy/mascots.pdf>.

<sup>29</sup> Stephanie A. Fryberg, *Of Warrior Chiefs and Indian Princesses: The Psychological Consequences of American Indian Mascots*, 30 BASIC AND APPLIED PSYCHOLOGY 208, 215-216 & 218 (2008), [http://www.indianmascots.com/fryberg--web-psychological\\_.pdf](http://www.indianmascots.com/fryberg--web-psychological_.pdf).

<sup>30</sup> *Id.* at 209 (citing studies).

<sup>31</sup> Frieda Powers, *Thin-skinned NY Post editor complains to university that a professor called him ‘calamari’*, BIZPAC REVIEW, (Jan 11, 2020),

incomplete nursery rhyme that “sticks and stones can break your bones, but *names* will never hurt *you*.” This is true unless the *name* is a profane mark.<sup>32</sup> Trademark law recognizes that sticks and stones can “break” a mark or brand.<sup>33</sup> Tort law recognizes that names can hurt you.<sup>34</sup> Equal rights laws recognize that group-identity brands hurt individual rights and opportunities. Stereotypes are the functional branding of aspects of individual identity. Like brands, these stereotypes convey substantial economic advantages or impose significant costs individuals associated with the stereotype.<sup>35</sup>

Stereotypes, like trademarks, “assist” the consumer because “(1) they encourage the production of quality products; and (2) they reduce the customer’s costs of shopping and making purchasing decisions.”<sup>36</sup> In the case of stereotypes, there are trademark-analogous functions, for example, (1) the model minority myth or the obligation to be a credit to one’s race (positive brand development), and (2) **relying** on social reputation (or personal interactions with one member of the group) to generalize to the entire group to avoid the costs of obtaining information and making an individualized decision. This abuse of stereotypes is analogous to having an experience with one brand named product and generalizing that other products by the company are either good or bad rather than making individual decisions as to each product based on facts. Unfortunately, group-identity-brands can only serve these quality assurance functions poorly; they do not perform this pseudo-proxy for information. Stereotypes almost

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<https://www.bizpacreview.com/2020/01/11/thin-skinned-ny-post-editor-complains-to-university-that-a-professor-called-him-calamari-874588>.

<sup>32</sup> See [https://en.wikipedia.org/wiki/Sticks\\_and\\_Stones](https://en.wikipedia.org/wiki/Sticks_and_Stones). The context of this article the dual meanings of the word *brand* and *branding* are often a tragically bad pun; See Oxford Languages Dictionary, definition of *brand*, <https://tinyurl.com/yxnav55e> (“a type of product manufactured by a particular company under a particular name” and “an identifying mark burned on livestock or (formerly) criminals or slaves with a branding iron.”). In the context of a product, it is a source identifier, and, in the context of the human, the commercial brand trademark can be an inerasable mark on the psyche of the individual and the modern equivalent of a scarlet letter in social interactions and economic opportunity.

<sup>33</sup> Mark A. Lemley, *Fame, Parody, And Policing In Trademark Law*, 2019 MICH. ST. L. REV. 1, 9 (2019) (“On the flip side, a number of courts have found the strength of the mark decreased due to the presence of a number of other, similar marks, and the mark thus entitled to only a narrow scope of protection.”).

<sup>34</sup> See *Steiner v. Showboat Operating Co.*, 25 F.3d 1459, 1466 (9th Cir. 1994) (“while simple insults do not constitute intentional infliction of emotional distress, insults which include sexual or racial harassment may rise to that level”); *but see Herra v. Lufkin Indust., Inc.*, 474 F.3d 675, 688 (10th 2007).

<sup>35</sup> John E. Elmore, *The Valuation of Trademark-Related Intangible Property*, WILLAMETTE MANAGEMENT ASSOCIATION (2015), [http://www.willamette.com/insights\\_journal/15/winter\\_2015\\_8.pdf](http://www.willamette.com/insights_journal/15/winter_2015_8.pdf).

<sup>36</sup> J. Thomas McCarthy, *Trademark Law and Unfair Competition*, § 2:3 (5th ed.).

always convey inaccurate information—excessive false positives and false-negatives.<sup>37</sup> Individuals are not commodified branded goods. Therefore, more precisely, the signal to noise ratio is appallingly bad but remains unrecognized because of confirmation bias reinforced by the consumer's cognitive dissonance of stereotypes.

The ubiquitous exposure to these marks (potentially even in putative places of refuge, so-called “safe spaces”) creates an injury well known in trademark law, the death of a mark by a thousand cuts (or infringements).<sup>38</sup> While it is rare in legal scholarship to examine race, gender, sexual orientation, ethnicity, and religion using trademark law, trademark law may provide a most useful paradigm in the case of profane marks through a trademark law lens.<sup>39</sup> Unfortunately, some immutable characteristics such as race, gender, ethnicity, and sexual orientation, as brand proxies, are significant determinants of social capital at birth, future income, wealth, health rather than assessing individual merit. Arguably, this analytical construct is a bit strained because trademarks are protected because of their commercial value against other forms of commercial speech.

Accepting that these often-immutable characteristics serve a branding function, one needs to determine analogous trademark protection scope to be used in this analysis. This article contends that race, gender, ethnicity, LGBTQ+ status, and religion designations may be best analyzed as *famous marks*.<sup>40</sup> A *famous mark* is one that is known to the general consuming public of the United States.<sup>41</sup> Not for all, but for many of the group-identities, the

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<sup>37</sup> Andrea Giampetro-Meyer, *The Proper Place for Intellectual Property in Employment Discrimination Law*, 25 GEO. MASON U. C.R. L.J. 1 (2014)(responding to Professor Rowe’s article). There appears to be no inherent reason why IP as a BFOQ thesis could not be extended to any situation where a human gender or religious characteristic can become part of a commercial brand identity. For example, a restaurant that wants to reproduce the stereotypic *Gone With the Wind* ante-bellum southern hospitality could require that all of the wait staff must look like the Aunt Jemima character/logo. See [https://en.wikipedia.org/wiki/Aunt\\_Jemima#Logo](https://en.wikipedia.org/wiki/Aunt_Jemima#Logo) (explaining the symbolism of the logo).

<sup>38</sup> Llewellyn Joseph Gibbons, *Liberty or Licentiousness: Disinsenting Disparaging and Scandalous Marks Post-Tam and Brunetti*, 72 FLORIDA L. REV. 797 (Feb. 29, 2020).

<sup>39</sup> Sonia K. Katyal, *Trademark Intersectionality*, 57 UCLA L. REV. 1601 (2010).

<sup>40</sup> Cf. David Tan, *The Semiotics of Alpha Brands: Encoding/Decoding/Recoding/Transcoding of Louis Vuitton and Its Implications for Trademark Law*, 32 CARDOZO ARTS & ENT. L. REV. 225, 241 (2013) (“the well-known trademarks or alpha brands that are constitutive of our cultural heritage have transcended their source designation function, and are symbolic of the ideological hegemonies of social identities in contemporary society. Their recoding by counterpublics may be viewed as [p]ractices of articulating social difference [that] are central to democratic politics.”) (internal quotation marks and citation omitted).

<sup>41</sup> 15 U.S.C.A. § 1125(c)(2)(a); See generally Jasmine Abdel-khalik, *To Live in In-“Fame”-y: Reconceiving Scandalous Marks As Analogous To Famous Marks*, 25 CARDOZO ARTS &

profane, offensive reference-terms that fall within this article's scope as profane marks, words that will need be reconstituted from merely disparaging to the status of scandalous or indecent, are generally known to the general consuming public of the United States.<sup>42</sup> Further, other forms of trademark infringement require a likelihood of consumer confusion.<sup>43</sup> A likelihood of consumer confusion analysis would add little to the discussion in this article because consumers are unlikely to make goods or services association with a profane mark.<sup>44</sup>

This article assumes that courts could analyze social-cultural-genetic identities such as African American or LGBTQ+ in *part* as brands or "famous marks." These profane terms are not only referents of an individual or group identity; they are also terms that affect the individual or group's social or monetary worth in the marketplace. Derogatory, disparaging, or profane euphemisms, such as the N-word, C-word, or F-word, carry extremely negative connotations. Negative connotations tarnish the value of the individual's brand identity either by using these faux brand-labels to self-identify or others who perceive the individual as a disparaged member branded-group.

The article does not develop the potential ramification of a terms' status when used by a group member to portray a positive self-identity—an act of semiotic democracy.<sup>45</sup> This limitation, too, is in keeping the trademark analogy in this article. Trademark law does not recognize the self-tarnishment of a famous mark. Interestingly, the flip side of tarnishment is the blurring of a famous mark. "Dilution by blurring consists of a single mark identified by consumers with two different sources."<sup>46</sup> In race, gender, sexual orientation, ethnicity, as brand proxies, the equivalent concept is cultural misappropriation. "[B]orrowing may become appropriation when it reinforces historically exploitative relationships or deprives [cultures] of opportunities to control or benefit from their cultural material."<sup>47</sup> So, the

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ENT. L.J. 173 (2007).

<sup>42</sup> See Jasmine Abdel-khalik, *Disparaging Trademarks: Who Matters*, 20 MICH. J. RACE & L. 287, 311-313 (2015) (discussing the conflation in trademark law of the disparaging and scandalous prohibitions).

<sup>43</sup> 15 U.S.C.A. § 1125(a).

<sup>44</sup> See *infra* Section II.

<sup>45</sup> See Llewellyn Joseph Gibbons, *Redux, Successfully De-Bowdlerizing the Trademark Register or One Person's Vulgarity is Another Person's Lyric*, 59 IDEA: L. REV. FRANKLIN PIERCE CENTER FOR INTELL. PROP. 89, 99 (2018) (concepts such as trans-valuing a negative identity or reclaiming the power to name); See Tan, *supra* note 40, at 238.

<sup>46</sup>J. Thomas McCarthy, *Trademark Law and Unfair Competition*, § 24:69 (5th ed.).

<sup>47</sup> David A. Singleton, *Disrupting Victim Exploitation*, 69 MERCER L. REV. 805, 807-808

detachment of control and the economic benefits of a group's culture so that consumers believe that there are multiple sources for the fruits of that culture constitute cultural appropriation. A human being or human culture's brand identity is deserving of at least as much protection as a trademark as a commercial property right.

## II. DISPARAGING, IMMORAL, OR SCANDALOUS MARKS: FREE FLOATING SIGNIFIERS OF NOTHING

At the extreme end of the spectrum, the initial question is whether some marks are so vulgar, profane, and offensive that the visceral societal messages they convey will overwhelm their capacity to serve as a source identifier the *sine qua non* of trademark law.<sup>48</sup> Broadly, the first question is whether disparaging, immoral, or scandalous designations (or more significantly post-*Tam* and *Brunetti*, a narrowly defined subset of indecent or scandalous profane marks may be constitutionally denied registration) are capable of serving as trademarks under first principles of trademark law.<sup>49</sup> The next question is that should these marks be registerable as trademarks, whether once registered and infringed that the owners of these profane marks are entitled to a full panoply of trademark remedies. In answering this question, one should first consider what Justice Breyer wrote in his *Brunetti* concurrence about the extraordinary emotional and physical impact of profane marks, and their viability as marks before answering.<sup>50</sup> When a trademark is no longer capable of serving a source-identifying function, it will lose its trademark status.<sup>51</sup> On the flip side, if a designation does not initially serve a source-identifying function, it was never a mark in the first place. Further, an affirmative answer to this question also solved another problem that of recognizing and protecting unregistered profane marks. So, this question worth exploring briefly in this article.

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(2018) (quoting Olufunmilayo Arewa, *Cultural Appropriation: When 'Borrowing' Becomes Exploitation*, THE CONVERSATION (June 20, 2016), <https://theconversation.com/cultural-appropriation-when-borrowing-becomes-exploitation-57411>); See also Tan, *supra* note 40 at 239-240.

<sup>48</sup> See United States Pat. & Trademark Off. v. Booking.com B.V., 140 S. Ct. 2298, 2304 (2020); 15 U.S.C. § 1127; *Qualitex v. Jacobson Prod. Co, Inc.*, 514 U.S. 159, 162-163 (1995); MCCARTY ON TRADEMARK LAW AND UNFAIR COMPETITION §3:4-§3:7.

<sup>49</sup> See *Booking.com*, 140 S. Ct. at 2304-2305.

<sup>50</sup> See *Iancu v. Brunetti*, 139 S. Ct. 2294, 2307 (2019) (concurring in part and dissenting in part).

<sup>51</sup> MCCARTY ON TRADEMARK LAW AND UNFAIR COMPETITION §12:2.

A court's analysis should start with a principle of viewpoint neutrality. In determining whether a profane mark serves a source-identifying function, the court should be agnostic whether the mark is conveying a socially desirable message or any message other than its source. However, the court cannot be indifferent to the profane meaning of the mark. This proposed factor test is in keeping with the ordinary trademark analysis of a designation purporting to be a trademark. APPLE for fruit is generic and cannot serve a trademark function, while the designation APPLE for a technology company is a strong (arbitrary) trademark. Note in this analysis; the court would not consider the social valance of the term APPLE.

Profane marks may require that the courts reconsider the *Abercrombie and Fitch* word-mark test and treat profane marks as presumptive descriptive or that courts treat profane marks as trade dress in the court's analysis. With profane marks, the negative social valance (or viewpoint) is irrelevant. The court must merely answer whether the profane designation is serving a trademark source-identifying function to indicate source, origin, or sponsorship of the associated product in the context of the marketplace to the consumer.<sup>52</sup>

When a consumer first encounters one of these profane terms, the consumer will have first to determine whether the term is serving a function other than to give offense, such as to identify the source of the product. For example, F\*CK on a t-shirt. Does the viewer get over the shock of visual assault sufficiently to engage in an internal trademark source identification analysis? Is F\*CK serving a trademark source-identifying function, or is it a message or a social statement?<sup>53</sup> In trademark law, this would be the penguin cocktail shaker dilemma first posited by Justice Scalia in *Walmart v. Samara Brothers*—whether a use of a mark is product design or product packaging.<sup>54</sup> The dilemma is whether the putative mark “is intended not to identify the source, but to render the product itself more useful or appealing.”<sup>55</sup> Here, the question is whether the profane mark indicates the source of the product or the mark as constituting the product itself.

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<sup>52</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294, 2307 (2019).

<sup>53</sup> *Samara Brothers, Inc.*, 529 U.S. at 207. *Samara Brothers* is especially instructive because it involved whether “line of spring/summer one-piece seersucker outfits decorated with appliques of hearts, flowers, fruits, and the like” could be inherently distinctive as trade dress.

<sup>54</sup> *Samara Brothers, Inc.*, 529 U.S. at 213. Justice Breyer noted in his concurrence in part and dissent in part in *Brunetti* that “some consumers may be attracted to products labeled with highly vulgar or obscene words.”; *Brunetti*, 139 S. Ct. at 2307. Implicitly recognizing that the attraction of these products may be the profane term itself rather than the reputation of the source of the product. This is not a trademark function.

<sup>55</sup> *Samara Brothers, Inc.*, 529 U.S. at 213.

Accordingly, profane marks should never be inherently distinctive and always require a showing of secondary meaning.<sup>56</sup>

As one court held, “[u]se of similar marks by third-party companies in the relevant industry weakens the mark at issue.”<sup>57</sup> Therefore, considering the number of market entrants/participants using similar profane designations—some as trademark/product packaging and others as expressive product design, it is unlikely that profane terms could readily acquire secondary meaning.<sup>58</sup> Moreover, in the context of adult sexualized products, a profane mark could be merely descriptive of the associated product. Naturally, the greater the semiotic distance between the designation and the product, the more likely it is to function as a mark. Those designations with the most significant distance (arbitrary or fanciful marks) from the associated product or service constitute the strongest marks.<sup>59</sup> This “distance” distinction may fail in the case of profane marks and their associated goods or services

Consequently, the emotional impact of these designations and their descriptive nature annihilates their ability to serve a trademark function. These profane terms carry so much semiotic meaning that they are akin to slogans or other informational marks.<sup>60</sup> Informational marks or informational slogans are not registerable because consumers rarely view them as marks absent extraordinary efforts on the trademark owner’s part to convey to the consumer than the informational mark or slogan is a trademark and not merely a source of useful additional information.<sup>61</sup> At best, a profane is often a monosyllabic informational mark or descriptive of an associated product.<sup>62</sup>

For the reasons discussed in this section, profane terms are best described in trademark nomenclature as descriptive marks with secondary

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<sup>56</sup> *Samara Brothers, Inc.*, 529 U.S. at 213-16 (“Consumers should not be deprived of the benefits of competition with regard to the utilitarian and esthetic purposes that product design ordinarily serves by a rule of law that facilitates plausible threats of suit against new entrants based upon alleged inherent distinctiveness.”).

<sup>57</sup> *M2 Software, Inc. v. Madacy Ent., Corp.*, 421 F.3d 1073, 1088 (9th Cir. 2005).

<sup>58</sup> *See Arcona, Inc. v. Pharmacy Beauty, LLC*, 976 F.3d 1074, 1081 (9th Cir. 2020) (“recognizing that third parties used similar and identical marks, and finding no reasonable jury could find a likelihood of confusion”); *M2 Software, Inc.*, 41 F.3d at 1088.

<sup>59</sup> *See Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 210-211 (2000) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10-11 (2d Cir. 1976)).

<sup>60</sup> *See generally* Tan, *supra* note 40 at 229-233.

<sup>61</sup> J. Thomas McCarthy, *Trademark Law and Unfair Competition*, § 3:5 (5th ed.) (listing examples of informational marks that were denied registration).

<sup>62</sup> *See e.g.* Adam Sandler, *Uses of the Word Fuck*, <https://www.letras.com/adam-sandler/643438/> (using the *F*-word as a transitive verb, intransitive verb, adjective, adverb, object, noun, etc.).



meaning. In other words, courts should handle weak marks similarly to weak copyrights in their analysis regarding the scope of trademark protection and crafting remedies.<sup>63</sup> Accordingly, the protection of profane marks, if any, should be limited to a form of thin-trademark protection.<sup>64</sup> Thin copyright limits the protection against copyright infringement to only virtually identical copies where the amount of originality in the original (infringed) work is slight.<sup>65</sup> So, “[w]hen the range of protectable and unauthorized expression is narrow, the appropriate standard for illicit copying is virtual identity.”<sup>66</sup> In the context of trademark law, the scope of thin trademark protection could be analytically similar to an application of trademark counterfeiting. The court in *Montres Rolex, S.A. v. Snyder* defined a counterfeit mark as “a spurious mark which is identical with, or substantially indistinguishable from, a registered mark.”<sup>67</sup> Analogously, the concept of a thin or narrowly circumscribed scope of protection to the *literal* work is well established in copyright law.<sup>68</sup> In the practical application of thin-trademark protection, the context of trademark law may require the profane mark's near identity to the alleged infringing mark coupled with a narrow application only to the specific types of goods or services listed in the trademark registration. The existing multi-factor context, consumer, and market-sensitive tests used by the different circuits are sufficiently robust to adopt this recommendation.

Some speakers for first amendment expressive speech purposes also need these profane terms.<sup>69</sup> Albeit a bit factiously, the registration of the designation F\*CK could have resulted in the “F\*CK THE DRAFT” being

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<sup>63</sup> See *Tarsus Connect, LLC v. Cvent, Inc.*, 452 F. Supp. 3d 1334, 1351 (ND Ga. 2020) (“a descriptive mark with a secondary meaning . . . is “relatively weak” and [is] only “entitled to a narrow range of protection.”).

<sup>64</sup> See Michael Grynberg, *Thick Marks, Thin Marks*, 67 CASE W. L. REV. 13, 59-60 (2016) (discussing the concept of thin-trademarks and thin-trademark protection); Ron Phillips, *A Case for Scandal and Immorality: Proposing Thin Protection of Controversial Trademarks*, 17 U. BALT. INTELL. PROP. L.J. 55, 74-76 (2008) (suggesting limiting thin protection to controversial marks only to inherently distinctive marks—arbitrary, fanciful or suggestive marks).

<sup>65</sup> See *Satava v. Lowry*, 323 F.3d 805, 812 (9th Cir. 2003); Katherine L. McDaniel and James Jue, *A Quantum of Copyright*, 8 CHI.-KENT J. INTELL. PROP. 169, 183 (2009).

<sup>66</sup> *Apple Com., Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1439 (9th Cir. 1994).

<sup>67</sup> *Montres Rolex, S.A. v. Snyder*, 718 F.2d 524, 527 (2d Cir. 1983) (citing 15 U.S.C. §1124).

<sup>68</sup> See *Feist Pub. Inc. v. Rural Tele. Serv. Co.*, 499 U.S. 340 349 (1991).

<sup>69</sup> See *Cohen v. California*, 403 U.S. 15, 16 (1971); See also MARK TWAIN, *THE WIT AND WISDOM OF MARK TWAIN* (1987), <https://www.goodreads.com/quotes/4957-the-difference-between-the-almost-right-word-and-the-right> (“The difference between the *almost right* word and the *right* word is really a large matter. ’tis the difference between the lightning bug and the lightning.”) (emphasis in original).

resolved under the Lanham Act rather than the First Amendment.<sup>70</sup> Many of the uses of these profane terms by someone other than the trademark owner would be informational or expressive rather than as a source identifier for competing or counterfeit goods.<sup>71</sup> Traditional trademark law only prohibits commercial uses that result in a likelihood of consumer confusion. Consequently, the Lanham Act does not prohibit expressive uses—and these uses probably could not be regulated consistent with the First Amendment. As was discussed earlier, whether an ordinary prudent consumer viewing a profane mark, F\*CK YOU would understand F\*CK YOU as a trademark indicating the source of the product or an insulting message to the viewer is problematic in the case of profane marks. Regardless of the mark’s commercial success, others will always desire to use the mark in its ordinary customary meaning—either to send a message or classic trademark fair uses.

Even if these profane designations are eventually registrable (in that they have acquired at least a weak secondary meaning and are serving a trademark function of indicating source), there would appear to be strong trademark fair use arguments to permit their continued widespread use by others.<sup>72</sup> The trademark fair use may take either of two forms: statutory (classic) fair use or a judicially created nominative fair use.<sup>73</sup> In the typical trademark infringement case, the plaintiff must show that the commercial use of the mark by another creates a likelihood of consumer confusion. Based on their current commercial use, for example, on clothing or inexpensive consumer goods, one may assume that most of these profane marks uses will be expressive uses rather than trademark uses and are so unlikely to infringe the profane mark. Moreover, the Lanham Act’s fair use defense provides that “use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, . . . of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party or their geographic origin . . . .” So, there may be strong trademark fair use arguments.<sup>74</sup>

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<sup>70</sup> *Cohen*, 403 U.S. at 16. It would not be unreasonable at the height of the Viet Nam era anti-war protests, if it was legal, that someone would have registered F\*CK THE DRAFT as a mark.

<sup>71</sup> See J. Thomas McCarthy, *Trademark Law and Unfair Competition*, § 3:5 (5th ed.) (listing examples of informational marks that were denied registration)

<sup>72</sup> *United States Pat. & Trademark Off. v. Booking.com B.V.*, 140 S. Ct. 2298, 2307-8 (2020); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 118 (2004) (quoting 15 U.S.C. §1115(b)(4)).

<sup>73</sup> See *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 214 (3d Cir. 2005).

<sup>74</sup> *Booking.com*, 140 S. Ct. at 2307-08.

Furthermore, the trademark fair use defense may be a strong deterrent against successful infringement litigation because the *Lasting Impression I, Inc.*, Court held that some degree of the likelihood of consumer confusion is consistent with trademark fair use.<sup>75</sup> Thus, statutory trademark fair use will raise barriers to plaintiffs effectively asserting trademark rights in profane marks.<sup>76</sup> Also, widespread unpoliceable uses by competitors and significant non-commercial uses will threaten if not irreversibly cause genericide to many profane marks.<sup>77</sup> Recently, in *USPTO v. Booking.Com*, the Court seemed to waiver on this point, making it a more fact-specific analysis. The *Booking.com* court observed that “The weaker a mark, the fewer are the junior uses that will trigger a likelihood of consumer confusion.”<sup>78</sup> Yet, “in a crowded field of look-alike marks, . . . consumers may have learned to carefully pick out” one mark from another.<sup>79</sup>

Although harshly criticized, the common law doctrine of aesthetic functionality still survives in trademark law.<sup>80</sup> Aesthetic functionality applies where the trademark does not drive consumer demand for the product as a source identifier but rather by the consumer demand for the aesthetic mark as an object in itself divorced from the product's source or reputation.<sup>81</sup> In this context, competitors need to use the mark to compete, and the mark no longer serves as an indication of quality. Therefore, a broad range of uses by competitors will not be infringing the trademark. The defense of aesthetic functionality would often apply in profane marks infringement actions where consumer desire is for the medium or the message (the aesthetics of the mark) rather than a desire to have a product from a particular source with a specific, consistent level of quality.

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<sup>75</sup> See *Lasting Impression I, Inc.*, 543 U.S. at 551.

<sup>76</sup> The law is unclear whether nominative fair use is an affirmative defense with the burden on the defendant, or whether once asserted, the plaintiff's burden of proof on likelihood on consumer confusion. See *Brookwood Funding, LLC v. Avant Credit Corporation, Inc.*, (ND Ga. 2015) 2015 WL 11504556 at n.6 (not reported in Fed. Supp.); (“The court recognizes there is a split of authority as to whether “nominative fair use” is considered an affirmative defense or whether it goes to plaintiff's proof of the likelihood of confusion element. Compare *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1182 (9th Cir. 2010) (not affirmative defense) with *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 228–31 (3d Cir 2005) (affirmative defense). The Supreme Court has ruled that “classic fair use” is an affirmative defense. See *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004).”).

<sup>77</sup> *United States Pat. & Trademark Off. v. Booking.com B.V.*, 140 S. Ct. 2298, 2307-8 (2020).

<sup>78</sup> See *Booking.com*, 140 S. Ct. at 2307 (Citation omitted).

<sup>79</sup> See *Booking.com*, 140 S. Ct. at 2307 (Citation omitted and quotation modified).

<sup>80</sup> See J. Thomas McCarthy, *Trademark Law and Unfair Competition*, § 7:80 (5th ed.).

<sup>81</sup> McKenney & Long, *Federal Unfair Competition: Lanham Act Section 43(a) § 5:19* (1989).

Finally, other doctrines of law may result in a plethora of quasi-mark uses that further dilute the profane designation's capacity to achieve secondary meaning and narrow its capacity to serve as only the thinnest of trademarks.<sup>82</sup> For example, the *Rogers v. Grimaldi* balancing test that further limit the scope of trademark protection available expressive uses of profane marks to “only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”<sup>83</sup> While the early cases, involved disputes over clearly expressive works such as titles to motion pictures or virtual products in video games, the *Rogers* balancing test is increasingly robust. For example, in *VIP Products LLC. v. Jack Daniel's Properties, Inc.*, the court found that a dog toy was an expressive work because it conveyed a humorous message.<sup>84</sup> Using the two-pronged *Rogers* balancing test, courts will only find trademark infringement in an expressive work if the mark's use is explicitly misleading.<sup>85</sup> The *Rogers* balancing test merely requires no artistic relevance, or if there is artistic relevance, it is misleading.<sup>86</sup> Under the first prong, the level of relevance merely needs to be above zero.<sup>87</sup> Under the second prong, it is not enough that consumers be misled, that there is a likelihood of consumer confusion. The court must decide “whether there was an ‘explicit indication,’ ‘overt claim,’ or ‘explicit misstatement’ that caused such consumer confusion.”<sup>88</sup> As the court noted in *VIP Products, LLC*, “[T]he Constitution looks beyond written or spoken words as mediums of expression.”<sup>89</sup> Few, if any, products using profane marks could not claim credibly that the profane mark's use was also artistic or expressive.<sup>90</sup>

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<sup>82</sup> For example, in the area of constitutional law, the *Tam* and *Brunetti* courts did not address whether enforcement was government speech. See Yvette Joy Liebesman, *Offensive Mark Owners have an Enforcement Problem*, 59 HOUS. L. REV., 31, (forthcoming) (manuscript on file with author).

<sup>83</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

<sup>84</sup> *VIP Products LLC. v. Jack Daniel's Properties, Inc.*, 953 F.3d 1170, 1175 (9th Cir. 2020).

<sup>85</sup> See Lisa P. Ramsey, *Free Speech Challenges to Trademark Law After Matal v. Tam*, 56 HOUSTON L. REV. 401, 438 (2018).

<sup>86</sup> See *Twentieth Century Fox Televisions v. Empire Distr., Inc.*, 875 F.3d. 1192, 1198-1199 (9th Cir. 2017).

<sup>87</sup> *Id.* at 1198.

<sup>88</sup> *Id.* at 1199.

<sup>89</sup> *Id.* at 1175 (quoting *Hurley v. Irish-Am. Gay, Lesbian & Bisexual Grp. of Bos.*, 515 U.S. 557, 569 (1995)).

<sup>90</sup> *But see Parks v. LaFace Records*, 329 F.3d 437, 452-453 (6th Cir. 2003) (remanding on the question of the use of Rosa Parks' name as a title to the Outkast's song *Back of the Bus* despite the fact that Ms. Parks is a civil rights heroine in part for her refusal to surrender her seat on a bus to a white passenger and move to the back of the bus.).

Although this article recommends that courts adopt these forms of analysis to discourage the development of profane designations as marks through government subvention, the article's analytical position is also consistent with robust first amendment principles to keep profane terms in the public domain rather than allowing commercial interests to capture them and to incentivize their further use or legitimatization.<sup>91</sup> Accordingly, traditional viewpoint-neutral black letter requirements of either common law or statutory trademark law may be sufficient if applied regularly and deftly to prevent the registration or enforcement of profane marks by ensuring that profane marks serve a trademark function before registration and continue to do so throughout the life of the mark and that the alleged infringing use falls within the narrow ambit of commercial uses that trademark law prohibits in the context of a profane mark.<sup>92</sup>

### III. A NEW CONSTITUTIONAL §2(A) OF THE LANHAM ACT (PROPOSAL)

For the past seventy years, the disparaging, immoral, and scandalous clauses of § 2(a) of the Lanham Trademark Act provided a statutory bulwark to keep the trademark register relatively clean of offensive or profane marks.<sup>93</sup> The Court Post-*Tam* and *Brunetti* eliminated the prohibition on federally registering disparaging, immoral, or scandalous marks.<sup>94</sup> Bowdlerizes of the trademark register must seek new tools to discourage the commercial development of disparaging, immoral, or scandalous marks. The Court's opinion in *Tam* and *Brunetti* may have left some lacunae in which Congress could act. Rather than just accepting either of two unlikely solutions, successfully challenging *Tam* and *Brunetti*'s wisdom or Congress enacting constitutionally firmer legislation. This article will move on in section IV to suggest an alternative approach that individuals who contend that these profane marks are unworthy of trademark protection should shift the battle from the federal registration of the profane mark to its enforcement and the limiting doctrines in equity law.

In light of the Court's holding in *Matal v. Tam*, while the opinion is well subject to criticism, it is unlikely that the Court will reconsider its holding,

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<sup>91</sup> See Ramsey, *supra* note 85, at 466-469.

<sup>92</sup> There are so many possible claimants to these marks that it is not clear that any one claimant will ever be able to establish secondary meaning the most profane of these marks, and if so, it will be a very narrow zone of protection (aka thin-trademark).

<sup>93</sup> 11 U.S.C. § 1052(a); See generally Megan M. Carpenter, *NSFW: An Empirical Study of Scandalous Trademarks*, 33 CARDOZO ARTS & ENT. L.J. 321 (2015).

<sup>94</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1744 (2017).

nor is it likely that Congress could amend the Lanham Act to prohibit the registration of disparaging trademarks. However, several justices in *Iancu v. Brunetti* may have pointed to Congress a narrow constitutional path to banning some federal registration of scandalous, obscene, vulgar, and profane marks.<sup>95</sup> There is also a possibility that the worst excesses of disparaging trademarks may be denied federal registration; for example, the *N*-word, *C*-word, or *F*-word could be considered indecent or scandalous under the rubric proposed in this section.<sup>96</sup> This section will briefly examine the possibilities of artful statutory solutions. However, even if Congress could enact a narrow constitutionally firm prohibition against registering some scandalous marks that carry the potential for protected commercial speech, there does not seem to be the legislative or political will at this time for such a revision of the Lanham Act.<sup>97</sup>

#### A. REMOVING THE VULGAR OR PROFANE FROM THE TRADEMARK LEXICON

As the *Tam* Court noted, Congress was not required to pass a law providing trademark registration or protection. Congress has *so-far* permissibly prohibited specific terms or symbols from being used as trademarks. The simplest solution is for Congress to make a substitution in the text of §2(a). Currently, §2(a) provides that “No trademark . . . shall be refused registration . . . unless . . . (a) Consists of or comprises *immoral, deceptive, or scandalous matter* . . .”<sup>98</sup> “Immoral, deceptive, or scandalous” could be changed to “obscene, vulgar, or profane matter . . .”<sup>99</sup> Such clarification should overcome the Court’s objections in *Brunetti*. Further, Congress could explicitly or through firm statements in the legislative

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<sup>95</sup> Even absent a federal law, a court may be able to deny profane marks common law protection. See *Iancu v. Brunetti*, 139 S. Ct. 2294, 2312 (2019).

<sup>96</sup> See *Brunetti*, 139 S. Ct. at 2312 n. 5. (Justice Sotomayor, with whom Justice Breyer joins, concurring in part and dissenting in part) (suggesting that at least one racial epithet may fall under the rubric of indecent or scandalous); See also Abdel-khalik, *supra* note 41, at 204-209; see generally Gary Myers, *It’s Scandalous!—Limiting Profane Trademark Registrations after Tam and Brunetti*, 27 J. INTELL. PROP. L. 1, 10-11 (2019).

<sup>97</sup> Significant institutional players such as International Trademark Association (INTA) oppose it. See, e.g., Brief of Amicus Curiae on Behalf of the International Trademark Association in Support of Respondent, *Lee v. Tam*, available at 2016 WL 7405846 (U.S.); Amicus Curiae Brief of the International Trademark Association in Support of Respondent, *Iancu v. Brunetti*, available at 2019 WL 1453517 (U.S.). Further, the weight of the amicus brief filings in both cases were clearly in favor to limiting or striking § 2(a).

<sup>98</sup> 15 U.S.C. §1052(a).

<sup>99</sup> Myers, *supra* note 96, at 18.

history guide the courts as to which body of relevant case law to use when interpreting these terms in the context of a specific mark.

Congress could also expressly provide a list of designations that could not be registered as federal trademarks selected on some viewpoint-neutral reason appropriately narrowly tailored to serve a constitutionally permissible public purpose.<sup>100</sup> Congress could amend the Lanham Act §2(a)'s immoral or scandalous bar to make it expressly viewpoint neutral and give the USPTO and the courts the ability over time to expand or to decrease the list of prohibited terms based on statutorily defined societal norms.<sup>101</sup> Congress has statutorily awarded trademark and trademark-like rights to public and private entities. The justices in their concurrences cite facially neutral justifications for a policy limiting scandalous trademark registration regulation.<sup>102</sup> Congress merely needs to select at least one narrowly drawn substantial government interest to deny federal registration to scandalous marks.<sup>103</sup> Assuming that a mark is commercial speech, however if the mark is not commercial speech, Congress would need a compelling government interest coupled with a narrowly tailored law.<sup>104</sup> In either case, Congress has managed to do so in other contexts, so in essence, this proposal is a return to the *status quo ante* with a constitutionally permissive twist.<sup>105</sup>

Alternatively, Congress could grant the USPTO as an administrative agency (possibly subject to the Administrative Procedures Act) the power to create a constitutionally tailored list of scandalous marks using viewpoint-neutral justifications to determine which designations get placed on this list.<sup>106</sup> Or similar to the FCC regulation of indecent speech in on-air

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<sup>100</sup> See *Iancu v. Brunetti*, 139 S. Ct. 2294, 2298 (2019).

<sup>101</sup> See *Id.*; See also Ramsey, *supra* note 85, at 430-432.

<sup>102</sup> See *infra* Section III(C).

<sup>103</sup> See *Matal v. Tam*, 137 S. Ct. 1744, 17654 (2017) (declining to decide if trademarks are commercial speech, but applying the Central Hudson intermediate scrutiny standard); *but see Tam*, 137 S. Ct. at 1769 (Thomas, J., concurring in part) (“I continue to believe that when the government seeks to restrict truthful speech in order to suppress the ideas it conveys, strict scrutiny is appropriate, whether or not the speech in question may be characterized as ‘commercial.’”).

<sup>104</sup> See Ramsey, *supra* note 85, at 435-436.

<sup>105</sup> Amending the Lanham Trademark Act may require more than a technical change to the definitional understanding or colloquial use of *scandalous* to incorporate a statutorily defined concept of profanity or indecency. See Section III; the USPTO was inconsistent in its application of the pre-*Tam* and *Brunetti* rules to rejecting trademarks. See Carpenter, *supra* note 93, at 334-345; See also Abdel-khalik, *supra* note 42, at 313-314; Simon Tam, *First Amendment, Trademarks, and “The Slants: Our Journey to the Supreme Court*, 12 BUFFALO INTELL. PROP. L. REV. 1, 10-13 (disparate impact of the PTOs inconsistent application of § 2(a) on minority groups).

<sup>106</sup> Cf. *FCC v. Fox Television Stations*, 567 U.S. 239 (2012) (discussing the FCC regulation

broadcast television and radio, Congress could continue its current practice of providing the USPTO with some generic criteria such as obscene, indecent, or scandalous with some narrowing principles in either the statutory text or the legislative history as guided by the dissents in *Tam*.<sup>107</sup> Still, respect for first amendment values would require a clear statement of Congress's intent to guide agency discretion.

The least effective method of eliminating scandalous marks would be a *final* list, whether created by Congress or the USPTO; the meaning of words evolve—one generation's profanity is another generation's euphemisms and the third generations vernacular.<sup>108</sup> Consequently, over time, the list of prohibited profane terms must change to reflect contemporary attitudes and ideas of obscenity, scandal, indecency, words, and symbols added or deleted from the available trademark lexicon as a living culture demands.<sup>109</sup> Changes not a one-way street. Existing trademark (property) rights should be protected. At the same time, those terms may be recapture or released for registration as to new marks in the future as societal values change, as will their scope of protection in equity. Therefore, the USPTO should be required to review this list and consider expressions of public opinion regularly—perhaps every three years like the Library of Congress's review DMCA circumvention exemptions.<sup>110</sup> Regardless of the approach used by Congress or the USPTO, the burden of showing that a proposed designation is not registerable as a scandalous mark should be on the USPTO.<sup>111</sup> Placing the burden to refuse registration on the government and providing a narrowly tailored definition of the types of terms that are unregistrable is a paradigm

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of indecent speech in broadcast on air content). *Contra* n.17.

<sup>107</sup> See *Brunetti*, 139 S. Ct. at 2308 (Breyer, J.); Chris Cochran, *It's "FUCTION": The Demise of the Lanham Act*, 59 IDEA 333, 360-364 (2019).

<sup>108</sup> See *Iancu v. Brunetti*, 139 S. Ct. 2294, 2307 (2019) (Breyer, J., concurring in part) (noting that profane words change overtime); MELISSA MOHR, *HOLY SHIT: A BRIEF HISTORY OF SWEARING* 254-258 (Oxford Univ. Press 2013); See also Timothy Jay, *The Utility and Ubiquity of Taboo Words*, 4 PERSPECTIVES ON PSYCHOLOGICAL SCIENCE 153, 156 (2009) (Taboo words remain relatively stable over time and the 10 most frequent used terms account for 80% of the data) available at <https://journals.sagepub.com/doi/pdf/10.1111/j.1745-6924.2009.01115.x>.

<sup>109</sup> *Cf. Brunetti*, 139 S. Ct. at 2307 (Breyer, J., concurring in part).

<sup>110</sup> See 17 U.S.C. § 1201(a)(1)(B)-(E); *Universal City Studios, Inc. v. Corley*, 273 F.3d 429, 440 (2d Cir. 2001). The proposed review process could also follow other administrative processes such as those used by the FCC when considering what constitutes indecent speech. Even departments of motor vehicles have developed lists of words that cannot be used on license plates; See Martybeth Herald, *Licensed To Speak: The Case of Vanity Plates*, 72 U. OF COLO. L. REV. 595, 596 & n.8 (2001) (citing statutes). There are numerous models from which to choose that would provide both flexibility and consistency.

<sup>111</sup> See *In re Standard Elektrik Lorenz Aktiengesellschaft*, 371 F.2d 870, 873 (CCPA 1967).



that is most consistent with first amendment values and trademarks as commercial choices respond to a market economy.

### B. §2(A) LANHAM ACT “DISPARAGING” MARKS

Considering the Court’s holding in *Matal v. Tam*, that disparagement as defined by § 2(a) of the Lanham Act was a form of unconstitutional viewpoint discrimination, Congress and future judicial decisions must recharacterize the worst excesses of a disparagement such a racial, gender, gender identity, sexual orientation, religious, or ethnic epitaphs as falling under the rubric of scandalous.<sup>112</sup> This shift in focus can be done constitutionally by focusing on how (manner) something was communicated rather than the message itself (viewpoint). However, many disparaging terms denied registration under the existing pre-*Tam* § 2(a) would never reach the level of constituting scandalous marks—a proposed narrow subset disparaging marks that are simultaneously obscene, vulgar, or profane.<sup>113</sup>

Section 2(a) of the Lanham Act prohibited the USPTO from granting trademark registration to marks that “disparage . . . or bring . . . into contemp[t] or disrepute and persons, living or dead.”<sup>114</sup> Unfortunately, depending on the trademark examiner and the day’s politics, many of these terms escaped scrutiny and became ensconced on the trademark register.<sup>115</sup> The *Tam* Court rested its holding on the bedrock first amendment principle that ideas cannot be suppressed merely because ideas are offensive to some members of the public—viewpoint discrimination.<sup>116</sup>

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<sup>112</sup> See *Iancu v. Brunetti*, 139 S. Ct. 2294, 2307 (2019) citing *M. MOHR*, *supra* note 108, at 252, 254, 256 (2013) (“And the list of swear words may be evolving yet again, perhaps in the direction of including race-based epithets.”).

<sup>113</sup> See Regan Smith, *Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks*, 42 HARV. C.R.-C.L. L. REV. 451, 480 (2007) (“Given the wide divergence of cultural attitudes towards indecency, the hurdle for what is scandalous to a “substantial composite of the general public” must be exceedingly high if the public is defined as the American people. This may mean in practice that the “scandalous” test will be met less often than the “disparaging” test, if it is met at all. Additionally, whereas the denial of a scandalous trademark removes the mark from use by everybody, the denial of a disparaging trademark can be seen as preserving that trademark for a different registrant.”).

<sup>114</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1753 (2017).

<sup>115</sup> See *Tam*, 137 S. Ct. at 1756; Ramsey, *supra* note 85, at 422-423.

<sup>116</sup> *Tam*, 137 S. Ct. at 1763. Almost all federally registered trademarks begin their lives as common law trademarks, and much of the federal litigation involving trademarks are under § 43(a) of the Lanham Act which protects non-registered trademarks. It is not clear whether in the case of an unregistered trademark a federal or state court could use common law rules and public policies to determine that the mark is unenforceable. See *In re Tam*, 808 F.3d. 1321, 1343-1344 (Fed. Cir. 2015); *aff’d on other grounds*, *Matal v. Tam*, 137 S.Ct 1744

At least one commentator has observed that the Court may have erroneously conflated viewpoint discrimination with the giving of offense in applying this core first amendment principle in the context of disparaging marks.<sup>117</sup> There are at least two speech acts in the case of a disparaging mark.<sup>118</sup> The first and most apparent is the giving of offense to members of the disparaged group (and perhaps to the population at large). The second speech is the expression of a viewpoint. It is easy to conflate these two ideas because most disparaging terms carry an overwhelming legacy of offensive stereotypes laden with one-dimensional caricatures of the disparaged group; consequently, offensive speech regulation cannot be viewpoint neutral.

The *Tam* Court seemed divided equally on the question of whether axiomatically *offense* equals *viewpoint*.<sup>119</sup> However, the justices all agreed that the language of §2(a) constituted constitutionally impermissible viewpoint discrimination by the government. Justice Alito opined in the plurality opinion that to the degree disparagement clause of § 2(a) may have had a constitutionally legitimate objective such as to drive out discriminatory commercial conduct, the disparagement clause was not narrowly tailored to eliminate only invidious discrimination.<sup>120</sup> The holding in *Tam* would have been more persuasive and unlikely to bleed into other areas of First Amendment jurisprudence had the Court expressly considered the offensive speech line of cases, such as *Cohen v. California* and *FCC v. Pacifica*

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(2017). States would also be free to interpret state trademark law terms such as *disparaging* or *scandalous* narrowly in order to avoid the impermissible viewpoint discrimination that the Court found in *Tam* and *Brunetti*. See *Leavitt v. Jane L.*, 518 U.S. 137, 146 (1996) (Stevens, J., dissenting on other grounds, joined by Souter, Ginsburg, and Breyer, JJ.) (“[T]he decision of a federal court (even this Court) on a question of state law is not binding on state tribunals”). This may merely mean that the battle over profane marks will be shifted to other grounds such as whether there was ever a designation functioning as a trademark in the first place rather than if the designation itself is registerable as a trademark. However, any further discussion of these interesting issues is outside the scope of this article.

<sup>117</sup> See Clay Calvert, *Merging Offensive-Speech Cases with Viewpoint Discrimination Principles: The Immediate Impact of Matal v. Tam on Two Strands of First Amendment Jurisprudence*, 27 WM & MARY BILL OF RIGHTS J. 829, 831 (2019).

<sup>118</sup> See Michiel Bot, *The Right to Offend? Contested Speech Acts and Critical Democratic Practice*, 24 LAW & LITERATURE 232, 251-53 (2012); See generally Peter Meijes Tiersma, *The Language of Defamation*, 66 TEX. L. REV. 303, 305-06 (1987).

<sup>119</sup> Compare *Tam*, 137 S. Ct. at 1763 (“Giving offense is a viewpoint.”) (Alito, Roberts, Thomas, and Breyer) with *Tam*, 137 S. Ct. at 1765 (striving to give a more nuanced definition of viewpoint discrimination) (Kennedy, Ginsburg, Sotomayor, and Kagan). Justice Gorsuch did not participate in this case. Based on the majority opinion in *Brunetti*, it is likely that Justice Gorsuch would have joined the Alito, Roberts, Thomas, and Breyer faction. Although, these seems to conflict cause with effect.

<sup>120</sup> Ramsey, *supra* note 85, at 420.

*Foundation*.<sup>121</sup> The *Cohen-Pacific* line of cases focused on the government's legitimate interest in regulating how an idea is expressed (manner) rather than its possible illicit interest in regulating the idea being expressed (viewpoint). The government has a greater interest in protecting civility and public morality in public interactions than regulating the speaker's motivation or ideology.<sup>122</sup> In the future, because the Court failed to distinguish between commercial and noncommercial speech, nor did the Court create a sui generis first amendment law for trademarks, lower courts should apply traditional First Amendment jurisprudence in deciding First Amendment challenged to trademark law.<sup>123</sup> The Constitution and the First Amendment permit the government to control the rules of war governing the battle in the marketplace of ideas but not choose winners or losers or even place too massive a thumb to tilt the board in a favored direction.

Suppose Congress had focused on the harm that the registration of these marks caused by using another more neutral term rather than the semantically loaded connotation and denotation carried by the term *disparaging*, the Court could have more readily have reached an interpretation that would have upheld §2(a)'s refusal to register "disparaging" marks clause with perhaps some minor constitutional limitations. This result would not be a far stretch. The Trademark Trial and Appeal Board and the Federal Circuit consistently held that "[d]isparagement is essentially a violation of one's right of privacy—the right to be 'let alone' from contempt or ridicule."<sup>124</sup> The right of privacy is a point not adequately addressed by the court in *Tam*. In other contexts, courts have upheld rights of privacy and protection against defamation against constitutional challenges.<sup>125</sup>

The *Miller v. California* line of obscenity cases requires that the challenged content be "patently offensive" as an element of whether the content is legally obscene may have to be reconsidered by the Court.<sup>126</sup> Whether those cases will survive, without revision, if giving offensive is a

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<sup>121</sup> See Calvert, *supra* note 76, at 833-34. Justice Sotomayor joined by Justice Breyer in their concurrence and dissent in part in *Brunetti* did mention the "Cohen-Pacific" line of cases; See Iancu v. Brunetti, 139 S. Ct. 2294, 2313-2314 (2019) There appears to be no mention or discussion in *Tam*.

<sup>122</sup> *Id.*

<sup>123</sup> See Ramsey, *supra* note 85, at 432-433.

<sup>124</sup> *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d 1635, 1636 (TTAB 1988) ("Disparagement is essentially a violation of one's right of privacy—the right to be 'let alone' from contempt or ridicule.").

<sup>125</sup> See *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 341-342 (1974) (defamation); *Schulman v. Group W. Prod., Inc.*, 955 P.2d 469, 478 (Cal. 1998); Rest. 2d Torts, § 558 & § 652D.

<sup>126</sup> See *Miller v. California*, 413 U.S. 15, 24 (1973).

protected viewpoint is an open question of whether Tam and Brunetti's broad scope is dicta or holding. The scope of the question is significant to this article primarily because when the Court returned to this issue again in *Iancu v. Brunetti*, and it was faced with the federal registration of an immoral or scandalous mark, a divided Court had to consider the manner (or mode) of speech apart from the message of the speech. Considering, the court was unanimous in striking down §2(a)'s disparagement clause, and it was unanimous that §2(a)'s disparagement clause was not viewpoint neutral, it is unlikely that the Lanham Act could be amended to have a viewpoint-neutral disparagement clause. Consequently, critics of registering racial slurs, ethnic stereotypes, and religious bigotry as federal trademarks must look elsewhere in the Lanham Act, for example, limiting their registration under the rubric of scandalous marks or creating new categories such as indecent or profane marks that track statutory language that the Court has approved of in other contexts.

### C. §2(A) LANHAM ACT “SCANDALOUS” OR “IMMORAL” MARKS

Two years after *Tam*, the Court again considered a §2(a) issue whether the Lanham Act's prohibition of registering immoral or scandalous marks was an impermissible viewpoint regulation.<sup>127</sup> The designation in question here was F-U-C-T.<sup>128</sup> As a matter of statutory interpretation, although there is an “or” between scandalous and immoral in the Lanham Act text, courts and the USPTO have treated these two terms as a unitary bar, giving both words the same meaning, treating one word or the other as superfluous or a nullity.<sup>129</sup> The *Brunetti* court followed *Tam*'s reasoning and concluded that §2(a)'s immoral or scandalous bar represented viewpoint discrimination. The TTAB found that the designation F-U-C-T in the context that the respondent Brunetti was using the mark, F-U-C-T had two messages one was sexual (immoral), and the other represented “misogyny, nihilism or violence” (scandalous).<sup>130</sup> Either of which interpretations of the designation F-U-C-T under prior pre-*Tam* TTAB or Federal Circuit precedent rendered the mark unregistrable as immoral, scandalous, or vulgar.<sup>131</sup>

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<sup>127</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019).

<sup>128</sup> *Id.*

<sup>129</sup> *Brunetti*, 139 S. Ct. at 2298 (2019); *But see* 139 S. Ct. at 2310-11 (Sotomayor, J., concurring in part); *See* Jasmine Abdel-khalik, *To Live in In-“Fame”-y: Reconceiving Scandalous Marks As Analogous To Famous Marks*, 25 CARDOZO ARTS & ENT. L.J. 173, 182 (2007).

<sup>130</sup> *Brunetti*, 139 S. Ct. at 2298.

<sup>131</sup> *Id.*

Designations may not be denied registration or protection as marks merely because of the viewpoint represented by the designation.<sup>132</sup> The court held that designations under the Lanham Act §2(a)'s immoral or scandalous bar are

“immoral” when it is “inconsistent with rectitude, purity, or good morals”; “wicked”; or “vicious.” So, the Lanham Act permits registration of marks that champion society’s sense of rectitude and morality, but not marks that denigrate those concepts. And material is “scandalous” when it “giv[es] offense to the conscience or moral feelings”; “excite[s] reprobation”; or “call[s] out condemnation.”

The Lanham Act allows registration of marks when their messages accord with, but not when their messages defy, society’s sense of decency or propriety. On its face, the statute distinguishes between two opposed sets of ideas: those aligned with conventional moral standards and those hostile to them, those inducing societal nods of approval and those provoking offense and condemnation.<sup>133</sup>

Thus, facially and textually, §2(a)'s immoral or scandalous bar represents an impermissible form of viewpoint discrimination.

Striving to the save §2(a)'s immoral or scandalous bar to trademark registration, the government unsuccessfully argued that the Court should ignore the ordinary dictionary meanings and the 70-year history of past-interpretations by the USPTO and construe §2(a)'s immoral or scandalous bar narrowly to shift from offensive-*viewpoint* discrimination to an offensive-*mode* of communication regulation analysis.<sup>134</sup> The Court would have had to ellipse out the term “immoral” because immoral is “inconsistent with rectitude, purity, or good morals,” “wicked,” or “vicious.”<sup>135</sup> Before *Brunetti*, the USPTO “ask[ed] whether a “substantial composite of the general public” would find the mark “shocking to the sense of truth, decency, or propriety,” “giving offense to the conscience or moral feelings,” “calling out for condemnation,” “disgraceful,” “offensive,” “disreputable,” or

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<sup>132</sup> *Id.* at 2301-02. In *Matal v. Tam*, 137 S. Ct. 1752 n.1 (2017), the Court opined “We need not decide today whether respondent could bring suit under § 43(a) if his application for federal registration had been lawfully denied under the disparagement clause.” The point seems to have been decided without analysis in *Brunetti*. See *Brunetti*, 139 S. Ct. at 2297.

<sup>133</sup> *Brunetti*, 139 S. Ct. at 2299.

<sup>134</sup> *Brunetti*, 139 S. Ct. at 2301.

<sup>135</sup> *Id.* at 2299.

“vulgar.”<sup>136</sup> According to the Court, this definition represents impermissible viewpoint discrimination.

Conversely, the government contended that the term *scandalous*, as used in § 2(a), is susceptible to a strained, but constitutional reading if properly construed narrowly by the Court. The government urged the Court to hold that *scandalous* only means lewd, sexually explicit, or profane marks. It did not include the broader dictionary definitions or the past practices and interpretations of the USPTO and the lower courts.<sup>137</sup> As interpreted by the government, the term *scandalous* would then be a mode or manner restriction and not a viewpoint restriction. Rejecting the government’s preferred interpretation of 2(a)’s the immoral or scandalous bar to trademark registration, the Court declined to opine on whether a more focused prohibition on lewd, sexually explicit, or profane marks would be permissible a permissible bar nor did the Court opine on how to evaluate such a viewpoint-neutral trademark registration scheme.<sup>138</sup>

Thus, the Court left the door open for some future trademark registration regulation of the most egregious designations. Four justices writing in dissent may have pointed a narrow constitutional path. Justice Alito, in his concurrence, wrote that:

Our decision does not prevent Congress from adopting a more carefully focused statute that precludes the registration of marks containing vulgar terms that play no real part in the expression of ideas. The particular mark in question, in this case, could be denied registration under such a statute. The term suggested by that mark is not needed to express any idea and, as commonly used today, generally signifies nothing except emotion and a severely limited vocabulary. The registration of such marks serves only to coarsen our popular culture coarsens further our popular culture. But we are not legislators and cannot substitute a new statute for the one now in force.<sup>139</sup>

Chief Justice Roberts, concurring in part and dissenting in part, wrote “I also agree that regardless of how exactly the trademark registration system is best conceived under our precedents—a question we left open in *Tam*—refusing registration to obscene, vulgar, or profane marks does not offend

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<sup>136</sup> *Id.* at 2298.

<sup>137</sup> *Id.* at 2301; *See also id.* at, 2302 n\*.

<sup>138</sup> *Id.* at 2302, n\*.

<sup>139</sup> *Brunetti*, 139 S. Ct. at 2303 (Alito, J., concurring). Justice Alito apparently following conventional wisdom regarding the size of a speaker’s vocabulary and the use profanity.

the First Amendment . . . . Meanwhile, the Government has an interest in not associating itself with trademarks whose content is obscene, vulgar, or profane. The First Amendment protects the freedom of speech; it does not require the Government to give aid and comfort to those using obscene, vulgar, and profane modes of expression.”<sup>140</sup>

Justice Breyer wrote concurring in part and dissenting in part, that “I would conclude that the prohibition on registering ‘scandalous’ marks does not ‘wor[k] harm to First Amendment interests that is disproportionate in light of the relevant regulatory objectives.’ I would therefore uphold this part of the statute. I agree with the Court, however, that the bar on registering ‘immoral’ marks violates the First Amendment.”<sup>141</sup>

Justice Sotomayor (joined by Justice Breyer) wrote concurring in part and dissenting in part that “rather than read the relevant text as the majority does, it is equally possible to read that provision’s bar on the registration of ‘scandalous’ marks to address only obscenity, vulgarity, and profanity. Such a narrowing construction would save that duly enacted legislative text by rendering it a reasonable and viewpoint-neutral restriction on speech that is permissible in the context of a beneficial governmental initiative like the trademark-registration system.”<sup>142</sup>

While the justices are collectively often more than the sum of their individual positions, there seem to be at least four votes supporting some form of a limited prohibition on registering scandalous marks, if the term scandalous is limited to the obscene, vulgar, and profane designations. There also appears to be five justices who are unwilling to state a position at this time. One may conclude that a properly drafted amendment to §2(a)’s immoral or scandalous bar written to prohibit the registration of obscene, vulgar, or profane designations in a viewpoint-neutral manner, would pass first amendment muster. This proposed amendment to the Lanham Act is as simple as Congress developing a legislative history and a record supporting viewpoint-neutral societal or commercial trademark purposes that would be served by excluding obscene, vulgar, or profane marks from trademark registration and redefining the term scandalous to be limited to profane or indecent marks. Those words, names, symbols, or devices, or any

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<sup>140</sup> *Id. at* 2303-04 (Roberts, C.J., concurring in part and dissenting in part). The author assumes that Chief Justice Roberts is not using “obscene” in its technical meaning in first amendment jurisprudence, rather he is using the term in a sense akin to meaning pornographic or salacious. If Chief Justice Roberts merely limited obscene marks that those which is already banned by other laws would make his concurring in part and dissenting in part opinion totally superfluous.

<sup>141</sup> *Id. at* 2308 (Roberts, C.J., concurring in part and dissenting in part).

<sup>142</sup> *Id. at* 2308 (2019) (Sotomayor, J., concurring in part and dissenting in part).

combinations thereof that have historically been subject to constitutionally valid regulation under other statutes because they can be regulated on viewpoint-neutral grounds and play little if any role in expressing ideas.

#### IV. MORALITY AND INTELLECTUAL PROPERTY

Assertions of public morality have always been at the heart of intellectual property rights in the United States. A more cynical commentator may describe these public assertions more accurately and alliteratively as prudish public puffery. At one point in history, courts viewed morality as an element of the creation or enforcement of copyright, patent, and trademark law. Of the four historical forms of intellectual property, the odd one out is trade secret law. In the case of a trade secret, unlike the prior three types of intellectual property, the court's moral lens was not on the plaintiff's creation of the right or the enforcement of the right, but rather on the morality of the defendant's use or acquisition of the trade secret. This section will briefly discuss morality and the enforcement of intellectual property rights to lay a foundation for a subsequent discussion of equity, trademark law, and profane marks.

##### A. COPYRIGHT

In the earliest days of copyright, the existence and enforcement of an author's copyright against an infringer were inextricably tied to the morality of the work.<sup>143</sup> These old cases recognized the work's lawfulness; for example, whether the work was obscene was a matter for state or local law. However, the court always had an independent duty under copyright law and a separate duty imposed by equity to determine whether to issue an injunction to protect such a work. Courts reached this conclusion through different channels. Some courts looked at Congressional intent when Congress enacted copyright laws. Others looked to the U.S. Constitution, art. I, § 8, cl. 8, to find that works that are injurious to public morality fail "to promote the progress of science and the useful arts." Consequently, such copyrighted works were unprotectable as a matter of constitutional law even if Congress affirmatively desired to protect such works independently statutorily under copyright law.<sup>144</sup> Of course, some belt and suspender judges used both the constitution and the copyright act as a basis to deny protection to immoral works.

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<sup>143</sup> See *e.g.*, *McCarrick, Inc. v. Dugan Piano Co.*, 220 F. 837 (5th Cir. 1915);

<sup>144</sup> *Maguire*, 16 F. Cas. at 922-23.



### **i. The Evolving Case Law of Copyright Morality**

For most U.S. history, the black letter law was that works of authorship harmful to public morality were uncopyrightable or at least not worthy of protection by equity. The black letter law of copyright morality survived until the 1970s when the sexual revolution and the evolving first amendment jurisprudence of obscenity roiled the basic premises of copyright law. The zeitgeist of the time read two lower court cases as a tsunami cleansing over 150 years of black letter law from the casebooks, including doctrines cited by the U.S. Supreme Court with approval. While copyright morality was a well-established judicial doctrine governing copyrights, and, infused into the principles of equity, lower courts without a firm command from Congress or even a hint the U.S. Supreme Court began to reconsider well established first principles of copyright law. Lower courts did so in light of other tangentially related case law that was evolving at the same time: the statutes and case law governing obscenity. As it will be demonstrated below, the common law doctrine of copyright morality was simultaneously much broader and narrower than the rules of law governing obscenity.

### **ii. *Belcher v. Tarbox***

In *Belcher v. Tarbox*, the Court considered a copyright challenge under the 1909 Copyright Act to a magazine that allegedly taught a fraudulent and ineffectual gambling method on horse races.<sup>145</sup> The *Tarbox* court's majority erroneously conflated the existence of the copyright act's author's right with the entitlement to a remedy in equity for copyright infringement.

The *Tarbox* court declined to pass on the truth (or falsity) of the infringed work.<sup>146</sup> The *Tarbox* court observed that "The gravity and immensity of the problems, theological, philosophical, economic and scientific, that would confront a court if this view were adopted are staggering to contemplate. It is surely not a task lightly to be assumed, and we decline the invitation to assume it."<sup>147</sup> However, the parties had not presented this issue before the *Tarbox* court. Rhetorically, the majority took a snowball and turned it into an avalanche with this slippery slope fallacy.<sup>148</sup>

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<sup>145</sup> *Belcher v. Tarbox*, 486 F.2d 1087, 1087-88 (9th Cir. 1973).

<sup>146</sup> *Id.* at 1088.

<sup>147</sup> *Id.* at 1088.

<sup>148</sup> *Id.* at 1088.

The narrow factual issue before the court was not a tremendous metaphysical truth. Instead, a false statement that a wagering method on horse racing was devised using computer technology when no computer was used in the analysis that created this wagering method.<sup>149</sup> This type of narrow factual claim is resolved almost daily under trademark law or false or deceptive advertising law.<sup>150</sup> And while further development on this topic is outside the scope of this article, there are sufficiently sound principles of trademark law (and tort law) that mandate courts to distinguish fact from opinion, philosophy from science, and metaphysics from physics.<sup>151</sup> Even as a public policy argument, in the context of copyright law, the difficulty in determining the truth or falsity of a copyrighted work making factual assertions is a weak contention to support rejecting copyright morality. The more creative a work is, the less likely courts could (or should) make a fact versus opinion distinction.

*Tarbox's* dissent correctly distinguished between the copyrightability of the work under copyright law and the entitlement to an injunction to prevent copyright infringement under equity principles.<sup>152</sup> Consequently, the dissent focused on “whether the court, [when] applying equitable principles mandated by 17 U.S.C. § 112,” could decide that an equitable remedy was warranted.<sup>153</sup> The dissent noted that, while the copyright act does not state that courts are to pass upon the truth or falsity of the views in copyrighted material, 17 U.S.C. § 112 provides that in granting relief to vindicate rights under the copyright act, the courts shall grant injunctions “according to the course and principles of courts of equity.”<sup>154</sup>

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<sup>149</sup> *Id.* at 1089.

<sup>150</sup> *See* 15 U.S.C. § 1125(a)(1)(B) (2012); *See generally* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, Ch 27 (5th ed. 2017).

<sup>151</sup> *See, e.g.* 15 U.S.C. § 1125(a)(1)(A); *Skydive Az, Inc. v. Quattrocchi*, 673 F.3d 1105, 1110 (9th Cir. 2012). Courts adjudicating trademark disputes are also often called upon to distinguish between commercial speech and core first amendment speech; *See, e.g.* *Procter & Gamble Co. v. Amway Corp.*, 242 F.3d 539, 547-48 (5th Cir. 2001), *abrogated on other grounds by Lexmark Intern., Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 124 (2014) (abrogating the standing requirements). *Amway Corp.* considered the relative protections for core first amendment speech and commercial speech; *Id.* at 548-49. The court then considered the motivation of the speaker and whether it was commercial or social-political speech; *Id.* at 550-51. Of course, this distinction resulted in differing levels of protection and liability for the same statement; *Id.* at 552-53. *Accord* *Milkovich v. Lorain Journal Co.*, 497 U.S. 1, 18-20 (1990) (constitutional distinction between fact and opinion in defamation law).

<sup>152</sup> *Belcher v. Tarbox*, 486 F.2d 1087, 1089, n.1 (9th Cir. 1973) (Wallace, J., dissenting).

<sup>153</sup> *Id.* at 1089 (Wallace, J., dissenting).

<sup>154</sup> *Id.* at 1089 n.1 (quotation marks in original) (17 U.S.C. § 112, *amended* by the 1976 Copyright Act).

The text of § 112 of the 1909 Copyright Act and the dissent reinforce Congress's intent and the court's execution of that intent not to depart from the traditional equity practice principles.<sup>155</sup> Unlike the majority opinion (which was rhetorically strong but weak on supporting law), the dissent relied very carefully on well-established legal principles. Significantly, *Stone & McCarrick*, the precedent that the majority summarily dismissed with a five-word phrase "[w]e think that decision unsound,"<sup>156</sup> had been cited by the U.S. Supreme Court with approval in *Morton Salt Co. v. G.S. Suppiger Co.*<sup>157</sup> In *G.S. Suppiger Co.*, the court observed that in copyright law, like in trademark law, a court of equity will deny relief for work infringement that harms the public interest.<sup>158</sup> When using the right granted to copyright, patent, and trademark owners are subverting the public policy, the rights owner cannot seek the protection of a court of equity. The Ninth Circuit later cases uses a prudential rule that the "dicta of the Supreme Court have a weight that is greater than ordinary judicial dicta as a prophecy of what that Court might hold. We should not blandly shrug them off because they were not a holding."<sup>159</sup> This analysis provides no reason to justify departure from this rule with a cursory shrug, especially in *Tarbox*, where the dismissed precedent was cited with approval and in support of the Court's holding.<sup>160</sup>

In his dissent, Judge Wallace stated a cogent policy justification for denying some copyrightable works the protection of equity.

By allowing copyright protection to such material, the law is not only condoning fraud but also placing its power, endorsement, and support behind fraudulent works. Persons who heretofore have never composed fraudulent literature can do so and seek solace in the law as the protector of their copyrighted fraud. I submit that

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<sup>155</sup> See Paul Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983, 1033, n. 194 (1970).

<sup>156</sup> *Belcher*, 486 F.2d at 1088.

<sup>157</sup> *Morton Salt Co. v. G.S. Suppiger Co.*, 314 U.S. 488, 494 (1941), *abrogated on other grounds by Illinois Tool Works Inc., v. Independent Ink, Inc.*, 547 U.S. 28, 42 (2006); See *Tarbox*, 486 F.2d at 1089.

<sup>158</sup> See *G.S. Suppiger Co.*, 314 U.S. at 494.

<sup>159</sup> *Zal v. Steppe*, 968 F.2d 924, 935 (9th Cir. 1992).

<sup>160</sup> The Fifth Circuit in *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852 (5th Cir. 1979) provided an extensive critical analysis of *Stone & McCarrick* which distinguished the precedent relied on by the *Stone & McCarrick* court as an erroneous, excessive interpretation of case law, including subsequent US Supreme Court cases that preclude the application of equity to subvert congressional intent. 604 F.2d at 864-865 & n.25.

this is detrimental to our legal system and not in the public interest.<sup>161</sup>

By granting protection to such works, equity does not provide an economic incentive to their creation or does it hinder their dissemination. Equity merely leaves the copyright owner with whatever damages the owner is entitled to by law.

### iii. *Mitchell Bros. Film Group v. Cinema Adult Theater*

Two modern federal circuit courts (the 5<sup>th</sup> and the 9<sup>th</sup>) have considered whether obscenity was grounds for denying copyright in the following cases: *Mitchell Bros. Film Group v. Cinema Adult Theater*, and *Jartech, Inc. v. Clancy*.<sup>162</sup> The Fifth Circuit in *Mitchell Bros. Film Group v. Cinema Adult Theater* provided the apparent *coup de grâce* to copyright morality. First, the Court noted that the 1909 Copyright Act did not explicitly authorize either the courts or the Library of Congress to deny copyright registration to works based on the work's immorality.<sup>163</sup> In support of this, the court noted that the 1909 Copyright Act granted protection to "all works of an author."<sup>164</sup> The court in *Mitchell Bros. Film Group* then noted Congress's long history of expanding the types of works eligible for copyright protection, the long tradition of judges modestly noting their inability to distinguish works of genius from dreck, and the First Amendment difficulties of balancing copyright principles and free speech rights in a copyright infringement proceeding.<sup>165</sup> The protection of obscene works was consistent with the copyright and patent clauses' language and within Congress's power to protect.

After determining the statutory and constitutional lawfulness of protecting obscenity under copyright law, the *Mitchell Bros. Film Group* Court subsequently discussed the arguments for defending obscene works in a court of equity, as equity would protect any copyright owner.<sup>166</sup>

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<sup>161</sup> *Tarbox*, 486 F.2d at 1090 (footnote omitted).

<sup>162</sup> See *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852 (5th Cir. 1979); See also *Jartech, Inc. v. Clancy*, 666 F.2d 403 (9th Cir. 1982).

<sup>163</sup> *Mitchell Bros. Film Group*, 604 F.2d at 854.

<sup>164</sup> *Id.* at 854.

<sup>165</sup> Interestingly, the *Mitchell Bros. Film Group* court did not discuss that fact that the copyright act was amended several times during the era of copyright morality without Congress expressly accepting or rejecting copyright morality resulted in a legislative acquiescence through inaction to the status quo.

<sup>166</sup> *Mitchell Bros. Film Group*, 604 F.2d at 854-861.

First, the *Mitchell Bros. Film Group* court rejected the line of cases that considered judges the custodian of public morality. The court held that “it is evident to us that it is inappropriate for a court, in the absence of some guidance or authorization from the legislature, to interpose its moral views between an author and his willing audience.”<sup>167</sup>

Second, the Court in *Mitchell Bros. Film Group* summarily rejected the judicial doctrine that a person can have no property right in illegal works by citing the U.S. Supreme Court case of *Board of Trade v. Christie Grain & Stock, Co.*—a trade secret case.<sup>168</sup> Trade secrets are readily distinguishable from copyright. Trade secret law is historically a matter of state common law or statutory law. Consequently, it is unclear whether, without substantive analysis, a court may import state tort law principles into rights created by Congress under an express grant of the constitutional power in which Congress provided for a remedy in equity. Because trade secret law’s relevance in this context is unclear, the cited case law underlying this point is infirm.<sup>169</sup>

Third, the *Mitchell Bros. Film Group* Court addressed the doctrine of unclean hands. The court rejected the unclean hands doctrine because it permitted a court to create a defense not authorized by Congress.<sup>170</sup> Disingenuously, the court conflated a remedy at law with an equitable remedy. If Congress allows a remedy in equity, then that equitable remedy, unless Congress provides otherwise, is subject to all the rules and maxims of equity remedies. The court held that “If the copyright holder cannot obtain financial protection for his work because of actual or possible judicial objections to the subject matter, the pro-creativity purpose of the copyright laws will be undercut.”<sup>171</sup> Arguendo, if this statement by the court is true, it merely becomes a factor to be weighed in balancing the equities instead of a dispositive factor to preclude consideration of equitable principles as a defense in copyright infringement cases.<sup>172</sup>

The *Mitchell Bros. Film Group* Court also considered whether limitations on equity would frustrate congressional purposes. The court did not have to make a nuanced balancing of the interests of the copyright owner

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<sup>167</sup> *Id.* at 861.

<sup>168</sup> *Id.*

<sup>169</sup> *Cf.* *Sony Corp. of America v. University City Studios, Inc.*, 464 US 417, 440 & n. 19 (1984) (exercising caution to bring patent principles into copyright law and rejecting a kinship between copyright and trademark law). A careful *Sony* suggests that there may be an abyss between copyright law and trade secret law.

<sup>170</sup> *Mitchell Brothers Film Group*, 604 F.2d at 861-862.

<sup>171</sup> *Id.* at 861.

<sup>172</sup> *See eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 392-393 (2006).

vs. the public because the lower court denied any remedy in equity to the copyright owner.

The *Mitchell Bros. Film Group* Court also never opined why it decided that Congress intended the 1909 Copyright Act to displace *sub silentio* the traditional doctrines, rules of equity, principles such as the doctrine of unclean hands.<sup>173</sup> A canon of judicial interpretation is that, when Congress does not speak on a topic when it amends or enacts new legislation, “Congress is presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it re-enacts a statute without change.”<sup>174</sup> Hence, the burden was on the *Mitchell Bros. Film Group* court to demonstrate that it was not Congress’s intention to maintain the status quo of prior courts denying registration, protection, or remedies to obscene works.<sup>175</sup>

Whether the *Mitchell Bros. Film Group* court’s analysis would survive more recent U.S. Supreme Court cases is unclear, such as *eBay, Inc. v. MercExchange, L.L.C.* in which the Court held that “a major departure from the long tradition of equity practice should not be lightly implied” in patent cases and copyright cases.<sup>176</sup>

Fourth, the *Mitchell Brothers Film Group* court held as a matter of judicial convenience and economy that adjudicating obscenity during each ordinary copyright infringement case (or copyright registration case) would inject an unmanageable element into a run of the mill copyright infringement actions.<sup>177</sup> Even today, there are only a handful of copyright infringement cases involving works that are arguably obscene or immoral. This argument

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<sup>173</sup> *Mitchell Bros. Film Group*, 604 F.2d at 861. One leading commentator wrote that the Library of Congress and the Copyright Office floated draft bills in 1905 and 1906 that would have “denied copyright to ‘any profane, indecent, immoral, or scandalous production, oral or written’”; William F. Patry, PATRY ON COPYRIGHT, VOL. 2 §3:43 (2019). However, it does not seem that these drafts were ever considered by Congress. So, there is language in the legislative history that was either ignored or uncited by the *Mitchell Bros. Film Group* court to support its position.

<sup>174</sup> *Lorillard v. Pons*, 434 U.S. 575, 580 (1978); see also SHAMBIE SINGER & NORMAN J. SINGER, SUTHERLAND STATUTES AND STATUTORY CONSTRUCTION § 49.09 & cases cited therein; but see *Star Athletica, LLC v. Varsity Brands, Inc.*, 127 S. Ct. 1002, 1015 (2017).

<sup>175</sup> Noting that, since the *Mitchell Bros. Film Group* Court’s opinion pre-dated the 1976 Copyright Act, one may argue that there still should be no change in the presumption that obscene works are not eligible for protection or remedy under the Copyright Act.

<sup>176</sup> *eBay Inc. v. MercExchange, LLC.*, 547 U.S. 388, 392 (2006) (citation omitted); See also *MercExchange*, 547 U.S. at 394-395 (Roberts, C.J., concurring). The Court in *MercExchange* cited numerous copyright cases in support of its holding. One leading commentator opines that the *MercExchange* Court’s holding may not apply to trademark injunctions; See J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARK AND UNFAIR COMPETITION § 30:47.70.

<sup>177</sup> *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852, 863 (5<sup>th</sup> Cir. 1979).

against federal courts litigating these issues assumes(creates?) a slippery slope into the abyss of additional work for federal judges. Again, assumption without citation to precedent, legislative history, or statistics. Federal obscenity cases are relatively rare. One may assume that obscenity cases that raise copyright issues would be even a smaller subset of a negligible part of the federal court docket.

Finally, the *Mitchell Bros. Film Group* court considered, even if obscenity was an affirmative defense, whether granting an equitable remedy would be proper in these types of cases.<sup>178</sup> To raise the defense of unclean hands, the party asserting the defense may show that unclean hands injured them. However, the defense of unclean hands is not a moral search warrant for judges to look for inequitable behavior outside the litigation.<sup>179</sup> In the case of an obscene work, the work's immorality does not change the relative status between the copyright owner and the infringer. The infringer may have even dirtier hands because while they are both distributing pornography, the infringer is also infringing another's copyright. The *Mitchell Bros. Film Group* Court also rejected the public injury argument as a ground to invoke the unclean hands doctrine.<sup>180</sup> They concluded equitable remedies may be appropriate but only if it furthered the purposes and policies underlying the copyright act.<sup>181</sup> However, the *Mitchell Brothers Film Group* court is not clear on why the public policy factor of the multi-factor balancing test would not encompass this injury to society at large.<sup>182</sup> The author concedes that he may be conflating separate strands of legal analysis.

Because the Ninth Circuit in *Jartech, Inc.* adopted the *Mitchell Brothers Film Group* court's analysis without engaging in an independent substantive analysis, it merely extended the holding of *Mitchell Brothers Film Group* to apply to the newly enacted 1976 Copyright Act, and further discussion of *Jartech, Inc.* would be superfluous.<sup>183</sup>

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<sup>178</sup> *Id.* at 861.

<sup>179</sup> *Id.* at 863-864.

<sup>180</sup> *Id.* at 863-864 nn.24-25.

<sup>181</sup> *Id.* at 865.

<sup>182</sup> *Id.* at 863 (The Court seemed to dismiss this possibility of public policy with "obscenity is not an appropriate defense in an infringement action, whether piggy backed on unclean hands or introduced in some other manner.").

<sup>183</sup> See *Jartech, Inc. v. Clancy*, 666 F.2d 406 (9th Cir. 1982); See also Ann Bartow, *Pornography, Coercion, and Copyright 2.0*, 10 VAN. J. OF ENT & TECH. L. 799, 832 (2008) ("Jartech court observed that 'Nimmer . . . considers Mitchell Brothers to represent the prevailing view on this issue,' and apparently outsourced its analytical thinking about the topic to a copyright treatise." internal citations omitted).

#### iv. *Devils Films, Inc. v. Nectar Video*

While commentators and scholars accepted *Mitchell Brothers Film Group* as an authoritative rejection of over a century of case law, lower courts outside the Fifth Circuit have found it less persuasive.<sup>184</sup> *Devils Films, Inc. v. Nectar Video* rejected the holdings in *Mitchell Brothers Film Group* and *Jartech*.<sup>185</sup> The *Devils Films, Inc.* court was presented in a petition for a preliminary injunction on the question of whether a court should “commit the resources of the United States Marshal’s Service to support the operation of the plaintiff’s pornography business.”<sup>186</sup> The court did not have to decide independently whether obscenity was a defense to copyright infringement.<sup>187</sup> This case is unique because there was already a finding that the infringed copyrighted content was also legally obscene.<sup>188</sup> Therefore, two of the policy arguments underlying the *Mitchell Brother’s Film Group* analysis were irrelevant:<sup>189</sup> (1) the fear that adjudicating obscenity would inhibit protected speech and (2) that it “introduce[s] an unmanageable array of issues into the routine copyright infringement actions.”<sup>190</sup> Obscenity is not protected under the First Amendment, and the question of obscenity was essential to the underlying litigation.<sup>191</sup>

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<sup>184</sup> See *Jartech*, 666 F.2d at 406 (“The leading treatise on copyright has called [the Mitchell Brothers] case “the most thoughtful and comprehensive analysis of the issue.” . . . Nimmer also considers Mitchell Brothers to represent the prevailing view on this issue.” internal citations omitted); Patry on Copyright § 3.22, Goldstein on Copyright § 2.51; Nimmer on Copyright § 2.17.

<sup>185</sup> *Devils Films, Inc. v. Nectar Video*, 29 F. Supp. 2d 174, 176 (S.D.N.Y. 1998); See also *Liberty Media Holdings, LLC v. Swarm Sharing Hash File*, 821 F. Supp. 2d 444, 447 n.2 (D. Mass. 2011) (“Notably, it is a matter of first impression in the First Circuit, and indeed is unsettled in many circuits, whether pornography is in fact entitled to protection against copyright infringement.”).

<sup>186</sup> *Devils Films, Inc.*, 29 F. Supp. 2d at 175.

<sup>187</sup> *Id.* at 176.

<sup>188</sup> Compare *Devils Films, Inc.*, 29 F. Supp. 2d at 175 with *Nova Prod. Inc. v. Kisma Video, Inc.*, 2004 WL 2754685 at \*3, Not Reported in F. Supp. 2d (S.D.N.Y. 2004) (obscenity is a question of fact and declining to decide it on summary judgment).

<sup>189</sup> *Devils Films, Inc.*, 29 F. Supp. 2d at 175.

<sup>190</sup> See *Mitchell Bros. Film Group*, 604 F.2d at 863. This fear of opening the floodgates to unmanageable copyright litigation asserting an obscenity defense seems to be irrational when one considers how rarely these issues are raised in copyright cases either before or after *Mitchell Brother’s Film Group*. For example, there are 1,457 federal cases on Westlaw using the search term (*obscene!*). There are 10 cases using the search in the synopsis and digest fields (*obscene! /s copyright*). Both searches were run in “federal cases” on November 7, 2020.

<sup>191</sup> *Miller v. California*, 413 U.S. 15, 24 (1973).



The *Devils Films, Inc.* court's nuanced analysis of a federal court's judicial powers and their limitations under principles of equity, as it carefully weighed public policy prohibiting the dissemination of obscenity, especially with the aid of the court, with the statutory rights of the copyright owner, And, the Court found under these specific facts that the Congress was unlikely to have intended the protection of copyright law to extend to contraband and to use the office of the United States Marshalls to aid in the violation of state and federal law.<sup>192</sup> Whether a copyright owner can suffer irreparable harm or even actual damages for the reproduction of an illegal work to reproduce or to disseminate is unclear unless it extends the infringer's profits.<sup>193</sup> However, the copyright's statutory damage provisions may still have applicability in similar cases.

## B. COPYRIGHT REGISTRATION AND COPYRIGHT IMMORALITY

Because of the Copyright Office's registration function as a precedent to infringement litigation, potentially, the morality of a copyrighted work is reviewed not only by the courts but also by an administrative agency before a copyright infringement suit.<sup>194</sup> the administrative history of obscenity and copyright registration demonstrates numerous confounding factors which make it difficult to discern any lessons. The Comstock Act prohibited sending sexually suggestive material through the mail and medical and scientific information relating to sexuality, for example, publications relating to birth control or abortion. Because it was illegal to send obscene material through the mail (Comstock Act), it is unlikely that any rational author would pursue copyright registration and risk fine or imprisonment. This observation is not a speculative "it is possible that" contention because at least the example one individual attempting to register a work who had his home raided by the police."<sup>195</sup> It was of no avail that the individual submitted the work to the Register of Copyright without using the post office services.<sup>196</sup> One may assume that only the most innocuous and banal of sexually

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<sup>192</sup> *Devils Films, Inc.*, 29 F. Supp. 2d at 176; even the *Nimmer* Treatise acknowledges that while illegality may not be considered as an element of copyrightability, it may be considered as factor in determining damages. See NIMMER ON COPYRIGHT § 14.04[C][3][b].

<sup>193</sup> Cf. *MercExchange*, 547 U.S. at 391-392.

<sup>194</sup> See 17 U.S.C. §411(c); see also *Fourth Estate Public Benefit Corporation v. Wall-Street.com, LLC*, 139 S. Ct. 881, 887 (2016).

<sup>195</sup> See William F. Patry, 2 PATRY ON COPYRIGHT §3:44 (2019).

<sup>196</sup> *Id.*

suggestive works or the most prudish medical textbooks were sent by mail to the Copyright Office for registration<sup>197</sup>

Eventually, the Register of Copyright wrote that “There seems to be plenty of authority for the proposition that a work which is obscene on the whole and which is published for an obscene purpose is not copyrightable. On the other hand, it seems equally clear that the fact that a book may contain obscene passages does not mean that it is not copyrightable.”<sup>198</sup> This sometimes led to the Copyright office’s spectacle granting copyright to work deemed unmailable by the United States Post Office.<sup>199</sup> To avoid this shame, the Library of Congress asked Congress to provide criminal penalties for registering (or attempting to register) obscene, seditious, or blasphemous material.<sup>200</sup>

As judicial standards for what constitutes obscenity became stricter, the Library of Congress sought the Attorney General’s opinion on whether it had the power to reject copyright registration for obscene works.<sup>201</sup> The Attorney General concluded that the Register of Copyright’s right to refuse copyright registration is unclear, but he declined to find Register was without this power.<sup>202</sup> However, the Attorney General noted the difficulties of exercising this power to review works pending copyright registration under morality principles by the Register of Copyright. It seems that it was the expedient policy of both the Attorney General and the Copyright Office to register these works, and challenges to the copyrightability of the work “should be raised if at all, as equitable defenses in infringement suites where a court can consider all of the circumstances and not as an outright bar to registration.”<sup>203</sup>

The current policy is to register the work without examining whether the work is obscene or illegal, with a narrow limitation on works that may contain child pornography. In child pornography cases, the Copyright Office will forward the work and the application to the Department of Justice.<sup>204</sup>

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<sup>197</sup> *See Id.* During this time the Copyright Office’s Revisory Board considered suggestively obscene or scandalous works such as a song containing the lyric that “Santa has cotton balls and a candy cane” and a traditional Dutch Holiday Scene.

<sup>198</sup> *Id.*

<sup>199</sup> *Id.*

<sup>200</sup> *Id.* “The Librarian of Congress was interested in works that were seditious, libelous, obscene, or other matter that would either be illegal or opposed to public policy.”

<sup>201</sup> *Id.*

<sup>202</sup> PATRY, *supra* note 195.

<sup>203</sup> *Id.*

<sup>204</sup> *Id.*

### i. Patent

As in the case of copyright law, the Copyright and Patent Clause of the U.S. Constitution was read by the early courts to include morality as an element of patent protection eligibility. Congress enacted the 1836 Patent Act and used the term *useful* without any definition of the word *useful*. It then allowed the courts to decide what was legally *useful* in the context of patent protection eligibility.<sup>205</sup> In *Lowell v. Lewis*, Justice Story articulated the requirements that *useful* patented inventions were not “injurious to the well-being, good policy, or sound morals of society,” for example, “a new invention to poison people, or to promote debauchery, or to facilitate private assassination.”<sup>206</sup> Eight years later, Justice Story tempered his opinion in *Earle v. Sawyer*. In *Sawyer*, the Court held the invention “must not be [solely] noxious or mischievous, but capable of being applied to good purposes; and perhaps it may also be a just interpretation of the law, that [useful] meant to exclude things absolutely frivolous and foolish.”<sup>207</sup>

While the technical legal history of moral utility is nuanced, the treatises and courts quickly grafted into the case law a general obligation of moral utility whose tentacles extended well beyond patent law in the legal imagination.

The most recent cases (post-1952 Patent Act) recognize that the Patent Act had never displaced or supplemented the states’ general police power, and Congress may, if it chooses, declare some subject matter unpatentable.<sup>208</sup> An invention may be noxious in one context and salubrious in another. The difference between poison and medicine is purely one of intent and not of effect.<sup>209</sup> Neither equity nor Congress has delegated the role of morality

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<sup>205</sup> See Application of Nelson, 280 F.2d 172, 178-79 (CCPA 1960) (quoting WILLARD PHILLIPS ON THE LAW OF PATENTS FOR INVENTIONS (American Stationers Co., Boston, 1837) “The requisite of usefulness has been sometimes contrasted with frivolousness, and the multiplicity of patents for trivial subjects has been occasionally deprecated by judges. An invention may be slight and trivial as being so obvious and apparent that it cannot be considered a discovery, or it may be trivial or frivolous in respect to its effect upon industry and production. A defect in the first sense renders the patent void as being for a subject that is not an invention. But an invention of a very slender character in the latter sense is still the subject of a patent, since it is not the province of the court to go into the question of the extent or degree of usefulness. It is enough that the invention is useful; how useful it may be is immaterial.”) This quotation suggests that the limitation of *useful* in the patent act was not a moral distinction but a limitation more analogous to the modern doctrine of non-obviousness.

<sup>206</sup> *Lowell v. Lewis*, 15 F. Cas. 1018, 1019 (C.C.D. Mass. 1817).

<sup>207</sup> *Earle v. Sawyer*, 8 F. Cas. 254, 256 (C.C.D. Mass. 1825).

<sup>208</sup> See *Juicy Whip, Inc. v. Orange Bang, Inc.*, 185 F.3d 1364, 1368 (Fed. Cir. 1999); See also Application of Anthony, 414 F.2d 1383, 1395 n. 12 (C.C.P.A. 1969).

<sup>209</sup> See *Cooley v. Granholm*, 291 F.3d 880, 882 (6th Cir. 2002).

police to the USPTO. Today usefulness under patent law is a question of functionality and not use-based morality.

Surprisingly, the doctrine of moral utility was rarely raised in published cases as an equitable defense in cases not challenging the patent's validity. The immorality of the invention seems to be an inchoate defense to an equitable remedy. In cases questioning the availability of an equitable remedy, courts have rejected the general societal morality of the patent, the patent owner, or the infringer in determining the availability of an equitable remedy.<sup>210</sup> For example, in *Mills v. Industry Novelty Co.*, the court rejected a defense in equity that the patented invention was used for the purpose of facilitating gambling, which was illegal at that time in most of the United States.<sup>211</sup> The court held that "Clearly an unlawful use of a device made by its patentee can be given no license to the general public to infringe the patent by the construction of a device which is used in legitimate trade."<sup>212</sup> Relying on a prior case involving the same or a similar device, the Court applied the equity's maxim that equity follows the law.<sup>213</sup> Through the patent act, Congress had granted the patentee the right to exclude others from practicing the invention. And in determining legal rights, equity follows the law. "And if a legal right is established beyond every defense, legal or equitable, available to the defendant or to the court on its own motion, *equity must grant appropriate relief if there is no adequate remedy at law*. Injunction, it is evident, is the only means equal to enforcing the right to exclude."<sup>214</sup>

The case law relied upon by the *Berger* court, and implicitly by the *Industry Novelty Co.* court, were cases involving whether a patentee had to practice or to license the invention before seeking an equitable remedy. These cases are distinguishable from disputes where the question before a court of equity is the claimed invention's morality and enforcing the patentee's rights in equity. Judge Grosscup wrote in a powerful and persuasive dissent in *Berger*:

The issuance of the writ, upon the case presented, will involve the court as an abettor in practices universally denounced and legislated against as harmful to the public morals. It will be an injunction in aid of crime. When the patentee comes into court

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<sup>210</sup> The author was only able to find two cases, and both are roughly contemporaneous, very old, involve gambling devices and a counterfeit coin detector, and are from the same circuit.

<sup>211</sup> *Mills v. Industry Novelty Co.*, 230 F. 463, 463-64 (N.D. Ill. 1916).

<sup>212</sup> *Mills v. Industry Novelty Co.*, 230 F. 463, 464 (N.D. Ill. 1916); *but see Fuller v. Berger*, 120 F. 274, 280 (7<sup>th</sup> Cir. 1903) (Grosscup, J., dissenting).

<sup>213</sup> *Fuller*, 120 F. at 279.

<sup>214</sup> *Id.* (emphasis added)

with some conscionable use for his invention, or even with a non-use divorced from unconscionable use, it will be time to consider his claim for a writ; until that time, he should be shown the chancellor's back.

On the point of whether equity affords a remedy in patent infringement cases where the invention violates morality and a well-established strong uniform public policy, there is at best weak case law. Nevertheless, the rare cases granting an equitable remedy explicitly first found that there was no adequate remedy at law, a prerequisite for equitable relief, and none of these cases found a need for an expansive equitable remedy.

## ii. Trade Secret

Although trade secret law sounds in equity,<sup>215</sup> there does not seem to be a similar robust (or any) black letter law strain of morality running through the modern history of trade secret law nor is trade secret law underpinned by explicit principles of commercial morality except for the weighing of the morality of its alleged misappropriation.<sup>216</sup> The modern law of trade secret was first coherently articulated in 1868 by the Massachusetts Supreme Judicial Court in *Peabody v. Norfolk*.<sup>217</sup> In 1905, in *Board of Trade v. Christie Grain & Stock, Co.*, the U.S. Supreme Court rejected morality as an element of trade secret protection.<sup>218</sup> The Court held that “[i]f, then, the plaintiff’s collection of information is otherwise entitled to protection, it does not cease to be so, even if it is information concerning illegal acts. The statistics of crime are property to the same extent as any other statistic, [sic] even if collected by a criminal who furnishes some of the data.”<sup>219</sup> The court here explicitly granted trade secret protection to data comprising illegal acts gathered by a criminal whose immoral acts generated some of the illicit data. Dirtier hands are hard to imagine.

There appears to be only one arguably more modern case on point (at least in dicta) that focused on a trade secret claimant’s morality. The court in *Cataphote Corp. v. Hudson* opines that “Protection of trade secrets is an equitable doctrine. Secrets obtained by wrongful means are not entitled to

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<sup>215</sup> WRIGHT & MILLER, FEDERAL RULES OF PRACTICE AND PROCEDURE § 5642 (1st ed.).

<sup>216</sup> Cf. Peter S. Menell, *Tailoring A Public Policy Exception to Trade Secret Protection*, 105 CAL. L. REV. 1, 20-21 (2017).

<sup>217</sup> *Peabody v. Norfolk*, 98 Mass. 452 (1868); see Robert G. Bone, *A New Look at Trade Secret Law: Doctrine in Search of Justification*, 86 CAL. L. REV. 241, 252-253 (1998).

<sup>218</sup> *Board of Trade v. Christie Grain & Stock, Co.*, 198 U.S. 236, 251 (1905).

<sup>219</sup> *Id.* at 251.

protection, and the ‘unclean hands’ doctrine may apply . . .”<sup>220</sup> So, at least one case makes it clear that the misappropriator of trade secrets will find no refuge in a court of equity when its stolen secrets are stolen from the thief.

Nevertheless, *Hudson* is not inconsistent with *Christie Grain*. The *Hudson* court focused on illicit obtaining the trade secret, not on the trade secret’s legality. The modern history of trade secret law seemingly focuses on whether the information was a commercial secret or the morality or immorality of the person obtaining or disclosing the trade secret rather than on the morality or legality of the content being revealed.<sup>221</sup> For example, a list of potential fencers of stolen goods was held to be a trade secret.<sup>222</sup> Therefore, a merchant was accused of selling stolen merchandise and was able to protect the sources of the alleged stolen goods as a trade secret. The court did not address a property interest morality in a list of entities potentially fencing stolen goods. Instead, the court focused solely on whether the party asserting the trade secret met their burden of proving that the information was secret and had some economic value without considering whether, as a matter of public policy, there should be a property interest in the information itself.<sup>223</sup> One may speculate that in an especially egregious case—perhaps misappropriating an already misappropriated trade secret (stealing from a thief) or if some strong public policy commanded it, the creation, retention, or possession of the underlying trade secret itself could be sufficient to constitute an unclean hands defense.<sup>224</sup>

The limitations on the scope of trade secret protection arise at the affirmative defense stage of the litigation when the alleged misappropriator asserts that the disclosure was privileged.<sup>225</sup> Much of the modern analysis of trade secret law focuses on carving out public policy exceptions for whistleblowers or testimonial privileges rather than the underlying question of whether the information that constituted the alleged trade secret was either

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<sup>220</sup> *Cataphote Corp. v. Hudson*, 422 F.2d 1290, 1295-96 (5th Cir. 1970) (citing 2 Callman, UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES §53.2(a)) (3d ed. 1968).

<sup>221</sup> See *Proctor & Gamble Co. v. Nabisco Brands Inc.*, 111 FRD 326, 331 (D. Del. 1986) (ignoring the surreptitious manner surrounds the trade secret collection of information and focusing on whether the claimed information met the legal definition of a trade secret).

<sup>222</sup> *Citizens of Humanity, LLC v. Costco Wholesale Corp.*, 171 Cal. App. 4th 1, 7 (2009), *disapproved on other grounds Kwikset Corp. v. Superior Court*, 246 P.2d 877, 894 (Cal. 2011).

<sup>223</sup> *Costco*, 171 Cal. App. 4th at 13-14.

<sup>224</sup> See 4 MILGRIM ON TRADE SECRETS § 16.01 (2020) (“Often defendants thrash about and make broad essentially *ad hominem* allegations about plaintiff. These will not suffice to create an unclean hands defense. The unclean hands has to be in some way directly or at least rationally related to the subject matter of the litigation.”).

<sup>225</sup> See *Wright, et al.*, 26 Fed. Prac. & Proc. Evid. § 5644 (1st ed.)

legal or moral and the correlative questions of whether rights in illicit information should be recognized as property or protected. These cases often start with information that may constitute evidence of a crime, assume that it is protected information if it meets the other elements of trade secret law (regardless in the licit or illicit nature of the secret itself), and then shift the burden to the whistleblower or discloser to demonstrate as an affirmative defense that there is a privilege that protects the disclosure. As the Restatement (Third) of Unfair Competition opines “A privilege [to disclose] is likely to be recognized, for example, in connection with the disclosure of information that is relevant to public health or safety, or the commission of a crime or tort, or to other matters of substantial public concern.”<sup>226</sup> Consequently, trade secret law is moot on injunctive relief based on the illicit nature of the information constituting the trade secret.

### iii. Trademarks

The disparaging, scandalous, and immoral clauses of § 2(a) of the Lanham Act served a similar function to moral utility limitations on patentability or the common law of copyright morality. Section 2(a) as well as § 2(a)-(b) of the Model State Trademark Bill kept the courts from having to enforce some marks which, like some inventions, violated well established public policies.<sup>227</sup> The prohibition on federal or state registration these marks served to insulate trademark law morality from judicial scrutiny in equity. Unlike the laws governing other forms of intellectual property, § 2(a) codified a form of statutory morality into the trademark law. The historic ban on registering immoral, scandalous, or immoral marks makes finding relevant case law outside the context of challenges to registering a mark a bit more onerous.

Under the common law of trademarks, to be a trademark, the chosen designation could not “transgress[] the rules of morality and public policy.”<sup>228</sup> As the author of a leading trademark law treatise of the 19<sup>th</sup> century wrote: “[t]he moral, religious, or political sensibilities of any people must not be shocked by the perversion of an emblem sacred in their eyes.”<sup>229</sup>

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<sup>226</sup> THE RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 40, cmt c.

<sup>227</sup> See *In re Tam*, 785 F.3d. 567, 576-577 rehearing on banc granted opinion vacated 600 Fed. Appx 775 (Fed. Cir. 2015); MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 22:5.

<sup>228</sup> See *Cohn v. People*, 149 Ill. 486, 493 (1894); *Hetterman v. Powers*, 43 SW 180, 182 (Ky App. 1897).

<sup>229</sup> WILLIAM HENRY BROWNE, A TREATISE ON THE LAW OF TRADE-MARKS AND ANALOGOUS SUBJECT 608 (Little Brown & Co. 1873). Interestingly, Browne also wrote without any citation to cases or examples that “we must not blindly follow the loose, random sayings of

There are some common law trademark cases in which the court very briefly considered morality.<sup>230</sup> So, one may conclude that courts have the equitable power to consider the mark's nature in whether to grant an equitable remedy, but they have never been called upon to do so. At best, the history of trademark law in the 19<sup>th</sup> and 20<sup>th</sup> centuries focused on the morality of the mark in creating trademark rights themselves rather than in the morality of the trademark's enforcement.

## V. CLEAN HANDS AND DIRTY MARKS

The application of prudential limitations inherent in a court's equity jurisdiction governing the enforcement of disparaging, immoral, scandalous, or immoral (profane) marks was not an issue until the courts decided *Tam*. Before *Tam*, the USPTO had the obligation not to register profane marks. And, when the USPTO failed in its gatekeeping function, the newly registered marks were either likely to be (administratively or judicially) canceled or unlikely to be so extreme as to warrant a court denying the mark owner an equitable remedy. The marks that escaped the USPTO's scrutiny were generally disparaging marks or puerilely scandalous marks. In the case of disparaging marks or scandalous marks, the litigation's focus was either the registration of the mark or the cancellation of the registration, not the scope of enforcing the mark.<sup>231</sup> Courts will now squarely face with the question of whether despite registration, a mark may be so repugnant to principles of equity or public policy that a court may decline to exercise its equitable powers to provide a remedy for trademark infringement or whether the discretion that equity grants the court suggests or compels a narrow remedy.

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judges, that any emblem may be lawfully employed for this purpose." Accordingly, one may infer that there was some tension in the state of the law at that time.

<sup>230</sup> See *Ellis v. J.H. Zeillin & Co.*, 42 Ga. 91, 92-93 (1871).

<sup>231</sup> The persistent attempts to cancel the Washington Redskins marks are a good example of targeting a trademark registration for cancellation. The REDSKINS, WASHINGTON REDSKINS, and the REDSKINETTES marks were litigated, cancelled, appealed, reversed, affirmed, remanded, vacated, and relitigated before the USPTO and in the federal courts between 1994 and 2018; See e.g. *Harjo v. Pro-Football, Inc.*, 30 U.S.P.Q.2d 1828 (TTAB 1994) and *Pro-Football, Inc. v. Blackhorse*, 709 Fed. Appx. 182, 182 (4th Cir. 2018) (vacating an appeal in light of the Supreme Court's holding in *Tam*) with numerous cases in between.



## A. FIGHTING WORDS OR WORDS THAT YOU CANNOT SAY ON TELEVISION

Unlike the USPTO, which has been successfully drawing lines in the language of commerce through its *ex parte* grant or denial of trademark registrations under §2(a); courts have engaged in a nuanced analysis of words and their legal and social impact on a fully developed and litigated record in the context of broadcasting, fighting words, and most recently infringement by trademark dilution. Unlike the USPTO, federal courts may consider broader public policies and the first amendment in adjudicating disputes.<sup>232</sup> Further, in addition to the fighting words line of cases, there is a well-developed body of case law regarding profane words that may not be used or only used with limitations by broadcast television. There remains a robust doctrine of trademark dilution by tarnishment, which protects famous trademarks from disparagement (tarnishment). The obvious argument against this article's proposal that a court to deny or limit equitable remedies in cases involving profane marks is one of definition and precision. Concededly, a robust multi-factor description of pernicious profane marks, much less a bright-line test, is impossible. However, mere imprecision of language standing alone does not render an argument unsound as administrative agencies and courts have been drawing these lines in other sensitive first amendment contexts.

### i. Fighting Words (or Hate Speech)

There is a long line of U.S. Supreme Court cases that recognize that some speech in the context of fighting words, defamation, and obscenity may "be regulated because of their constitutionally proscribable content False"<sup>233</sup> Early U.S. Supreme Court decisions such as *Chaplinsky v. New Hampshire* which held that:

Allowing the broadest scope to the First Amendment's language and purpose, it is well understood that the right of free speech is always not absolute and under all circumstances. There are certain well-defined and narrowly limited speech-classes, the prevention and punishment of which have never been thought to

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<sup>232</sup> See *Weinberger v. Salfi*, 422 U.S. 749, 765 (1975); *Petruska v. Gannon University*, 462 F.3d 294, 308 (3d Cir. 2006); *Apple, Inc. v. Smartflash, LLC*, 2016 WL 3035587 at 13 (PTAB 2016) (citing cases).

<sup>233</sup> *R.A.V. v. City of St. Paul*, 505 U.S. 377, 383 (1992).

raise any Constitutional problem. These include the lewd and obscene, the profane, the libelous, and the insulting or ‘fighting’ words—those which by their very utterance inflict injury or tend to incite an immediate breach of the peace. It has been well observed that such utterances are no essential part of any exposition of ideas and 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. ‘Resort to epithets or personal abuse is not in any proper sense communication of information or opinion safeguarded by the Constitution, and its punishment as a criminal act would raise no question under that instrument.’<sup>234</sup>

Under this long but early line of cases, the solution of limiting protection to marks that constitute fighting words would barely raise a colorable first amendment argument.<sup>235</sup>

However, more recent fighting words (or hate speech) cases, such as *R.A.V. v. City of St. Paul, Minn.*, have gradually expanded first amendment protection to words and phrases that would have been fighting words under *Chaplinsky*.<sup>236</sup> Although *RAV* sounds in *Chaplinsky*, for example, in *R.A.V.*, the Court observed that “From 1791 to the present, however, our society, like other free but civilized societies, has permitted 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.’”<sup>237</sup>

Today, the standard is that fighting words or hate speech may be regulated speech based on their listeners' effects. These words may not be regulated based on the content of fighting words or hate speech.<sup>238</sup> Speech may be limited if the regulation serves a constitutional purpose without considering the content of the speech.<sup>239</sup> A broad fighting word prohibition is permissible because that would focus on the speech as an act provoking

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<sup>234</sup> *Chaplinsky v. New Hampshire*, 315 U.S. 568, 571-72 (1942) (citations omitted).

<sup>235</sup> *Id.* at 569 (“Argument is unnecessary to demonstrate that the appellations ‘damn racketeer’ and ‘damn Fascist’ are fighting words.”).

<sup>236</sup> *R.A.V. v. City of St. Paul*, 505 U.S. 377, 381 (1992) (rejecting the opportunity to modify the scope of the *Chaplinsky* formulation as overbroad).

<sup>237</sup> *Id.* at 382-83 (citing a long line of Supreme Court cases).

<sup>238</sup> *Id.* at 383-84, 391 (limiting “fighting words [to words] that insult, or provoke violence, on the basis of race, color, creed, religion or gender.” impermissible” internal quotation omitted).

<sup>239</sup> *Id.* at 389.

violence. Still, a ban on insulting words that target identifiable groups would be an unconstitutional government attempt to regulate content.<sup>240</sup>

First Amendment jurisprudence has evolved since the 1940s. Courts have been able to navigate these legal shoals with some limited success in at least in the context of fighting words (hate speech).<sup>241</sup> The line between trademarks that should be unenforceable as a matter of public policy or unenforceable as a matter of traditional equity principles is not a fixed bright line. The line will move in many dimensions—often simultaneously: social dimensions based on social, group, and even individual norms; temporal dimensions: as time passes, society and individuals change as well as the contemporary understanding of the meaning of a term; and another, dimension: the intent of the trademark owner. So, like much of trademark, the law courts and the public will have to accept likelihoods and probabilities rather than fixed points if courts accept this article’s contentions.

The time, place, manner, the speaker, and other aspects of context all influence how “speech” is understood and the legal consequences of the speech.<sup>242</sup> So, the use of the designation SLANTS, as measured immediately post-WWII and post-Japanese American internment camps, could be understood quite differently as measured in 2018.<sup>243</sup> The use of the designation SLANTS by a group that wants to return to an anti-immigration policy is different from using the designation SLANTS by an Asian-American singing group that intends to transvalue the negative meaning of the SLATS by adopting it as a trademark.<sup>244</sup>

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<sup>240</sup> *Id.* at 390-91.

<sup>241</sup> *See* *Chaplinsky v. New Hampshire*, 315 U.S. 568, 573-74 (1942); *but see* source cited *supra* note 191 (requiring the hate-speech prohibition be viewpoint neutral).

<sup>242</sup> *See, e.g.* *Albright v. Morton*, 321 F. Supp. 2d 130, 136-37 (D. Mass. 2004) (false statement that heterosexual plaintiff was homosexual is no longer slander *per se*). Trademark has always analyzed a mark in the context of the marketplace, consumer attitudes, and contemporary morals and mores; *See e.g.* *AutoZone v. Strick*, 543 F.3d 923, 930 (7th Cir. 2008) (this is an analogous concept to that of a transformational use under copyright law which is more highly valued and protected than a mere mindless unoriginal copying); *In re Brunetti*, 877 F.3d 1330, 1336 (Fed. Cir. 2017), *aff’d on other grounds*, 130 S. Ct. 2204 (2018).

<sup>243</sup> *See* *Matal v. Tam*, 137 U.S. 1744, 1751 (2017) (“‘Slants’ is a derogatory term for persons of Asian descent”).

<sup>244</sup> *Id.* at 1751; *See generally* cite literature to reclamation; *see also* Adam M. Croom, *The Semitics of slurs: A Refutation of Coreferentialism*, 2 AMPERSAND 30, 32-33 (2015) (slurs and derogatory terms are not the same as descriptors); Jean-Marc Dewaele, “CUNT”: *On the Perception and Handling of Verbal Dynamite by LI and LX Users of English*, 37 MULTILINGUA J. OF CROSS-CULTURAL AND INTERLANGUAGE COMMUNICATION 53, 78 (“the word ‘cunt’ uttered by a woman to a man removes the misogynistic connotation of the word, making it slightly less offensive.”).

## B. PROFANE WORDS ON BROADCAST TELEVISION OR RADIO

This section will discuss the jurisprudence of profane words whose use is limited by the Federal Communications Commission. The purpose of this discussion is not primarily to prove the constitutionality of the proposed solution (although it supports it); but rather the goal is to demonstrate the competency of the courts (or an administrative agency) to implement the solution by differentiating among the offense levels of marks, and to apply differing public policies that apply differing levels of protection to some forms of profane speech. There are words that one cannot say on broadcast television.<sup>245</sup> Comedian George Carlin made a career out of the seven words that one can never say on off-the-air broadcast television.<sup>246</sup> The U.S. Supreme Court in *FCC v. Pacifica Foundation* found that Congress could authorize the FCC to channel obscene, indecent, or profane terms into temporal or spatial zones that would minimize a consumer of broadcast television or radio to be exposed these offensive terms.<sup>247</sup> The *Pacifica Court* recognized the danger of self-censorship by on-air broadcast media and opined that:

It is true that the Commission's order may lead some broadcasters to censor themselves. At most, however, the Commission's definition of indecency will deter only the broadcasting of patently offensive references to excretory and sexual organs and activities. While some of these references may be protected, they surely lie at the periphery of First Amendment concern.<sup>248</sup> [The Court noted in the footnote to this quote that] A requirement that indecent language be avoided will have its primary effect on the form, rather than the content, of serious communication. There are few, if any, thoughts that cannot be expressed using less offensive language.<sup>249</sup>

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<sup>245</sup> See 18 U.S.C. §1464 (prohibiting "any obscene, indecent or profane language by means of radio communication" and prescribing a term of imprisonment and fine); 47 C.F.R. § 73.3999 (2018) (prohibiting indecent material on broadcast television between 6 a.m. and 10 p.m.).

<sup>246</sup> *Seven Dirty Words*, WIKIPEDIA, [https://en.wikipedia.org/wiki/Seven\\_dirty\\_words](https://en.wikipedia.org/wiki/Seven_dirty_words) (last updated October 8, 2020.) (according to Carlin they are shit, piss, fuck, cunt, cocksucker, motherfucker, and tits); See generally *FCC v. Pacifica Foundation*, 438 U.S. 726, 748-749 (1978) (The text of Carlin's act is reproduced at pages 751-755).

<sup>247</sup> *Pacifica Foundation*, 438 U.S. at 750.

<sup>248</sup> *Id.* at 743 (internal footnote omitted).

<sup>249</sup> *Id.* at 743 n.18.

This statement of First Amendment principles applies with equal or greater force in the context of profane marks and commercial speech.

### C. TRADEMARK DILUTION BY TARNISHMENT

Assuming *arguendo* that trademark dilution by tarnishment survives post-*Tam* as being viewpoint-neutral, trademark tarnishment law may be useful by analogy.<sup>250</sup> Federal trademark dilution law protects famous trademarks from dilution by blurring and dilution by tarnishment.<sup>251</sup> A *famous trademark* is one that is generally known among the consuming public of the United States.<sup>252</sup> “[D]ilution by tarnishment’ is [an] association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.”<sup>253</sup> A famous mark is tarnished when it is associated with inferior goods or if the association lessens the famous mark’s capacity to serve as a *wholesome* identifier.<sup>254</sup> So, students of trademark law learn to their amazement that associating Victoria’s Secret, a store that sells women’s lingerie and similar sexualized products, with sex-related products from a much smaller retailer was likely to tarnish Victoria’s Secrets famous brand.<sup>255</sup> Courts are readily able to determine when a brand is disparaged. Even when the likelihood of disparagement or tarnishment of the famous brand border on the inane and is based on readily distinguishable case law, courts are prepared to protect the famous mark. Courts could make similar determinations when the disparagement or tarnishment of a mark is not an economically valuable mark but relates to disparaging an individual or group identity’s core principles.

### D. FLATTENING THE SLIPPERY SLOPE

Concededly, the contention of this article that courts should use their equitable powers to enforce in equity some marks more rigorously and other marks perhaps not at all based on the nature of the mark, and even more specifically consider the social impact of the mark owner starts with one foot

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<sup>250</sup> See First Amendment—Freedom of Speech—Trademarks—*Matal v. Tam*, 131 HARV. L. REV 243, 252 (2017); Ramsey, *supra* note 85, at 456.

<sup>251</sup> 15 U.S.C. § 1125(c) (2012); J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §3:34 (5th ed. 2020).

<sup>252</sup> See *id.* § 1125(c)(1); Starbucks Corp. v. Wolfe Borough Coffee, Inc., 588 F.3d 97, 105-106 (2d Cir. 2009).

<sup>253</sup> *Id.* § 1125(c)(2)(C).

<sup>254</sup> Hormel Foods Corp. v. Jim Henson Prod., Inc., 73 F.3d 497, 507 (2d Cir. 1996).

<sup>255</sup> See V. Secret Catalogue, Inc. v. Mosely, 605 F.3d 383, 387-388 (6th Cir. 2010).

on a proverbial banana peel. And the other poised to take a step down a slippery slope to unconstitutionality—especially a strict application of concepts of such as vagueness in first amendment jurisprudence. As was discussed previously, there are at least four-justices of the Court prepared to accept that some class of marks will fall under a narrow definition of scandalous (but not disparaging) for if Congress is regulating for viewpoint-neutral reasons, may be constitutionally denied federal trademark protection. And, under its Commerce Clause powers, Congress could remove state or common law protection from the profane marks.

As inculcated into modern first amendment jurisprudence, the double effect doctrine provides as elegant, if narrow path, to leveling the fictitious slippery slope.<sup>256</sup> Legislatures and judges may not inhibit speech because they disagree with the expressed viewpoint. The fixed star in first amendment jurisprudence is content neutrality in enacting laws affecting speech. Still, speech may be restricted because of the harmful societal effects of the message—if the social impact independent of speech is the lawful subject of government regulation.<sup>257</sup>

Cases, such as *R.A.V. v. The City of St Paul*, illustrate that some forms of speech may be regulated because of their constitutionally prescribed content. However, the viewpoint expressed using that content may not be suppressed.<sup>258</sup> Indeed, even the general bar against viewpoint preference or suppression is not absolute when the regulated speech falls within the ambit of so-called proscribable speech.<sup>259</sup> In *R.A.V.*, the Court justified this departure from First Amendment norms stating that words that fall within the proscribable speech rubric play no essential role in expressing ideas.<sup>260</sup> Additionally, narrow limitations on profane speech remedies present a negligible risk of driving perspectives out of the marketplace of ideas.<sup>261</sup> The Court further found that “when the basis of the content discrimination consists entirely of the very reason the entire class of speech at issue is proscribable, no significant danger of idea or viewpoint discrimination exists.”<sup>262</sup> Viewpoint discrimination is a danger in the case of disparaging

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<sup>256</sup> See Edward C. Lyons, *In Incognito —The Principle of Double Effect In American Constitutional Law*, 57 FLA. L. REV. 469, 529-535 (2005).

<sup>257</sup> *R.A.V. v. City of St. Paul*, 505 U.S. 377, 385 (1992).

<sup>258</sup> See *id.* at 385; see also *id.* at 383 (giving examples such as obscenity, defamation, and fighting words).

<sup>259</sup> *Id.* at 387.

<sup>260</sup> *Id.* at 385.

<sup>261</sup> *Id.* at 387-88; see *IMS Health Inc. v. Sorrell*, 630 F.3d 263, 272 (2d Cir. 2010) (“lewd, obscene, profane, libelous, and fighting words to be categories of speech wholly outside the protections of the First Amendment”).

<sup>262</sup> *Id.* at 388.

marks. As previously discussed, it is a minimal risk in the case of scandalous marks as they are defined in this article.<sup>263</sup> So profane marks begin the analysis with a diminished zone of constitutional protection.

Under the First Amendment, the zone of protection for profane marks narrows because they are usually “associated with secondary effects of the speech so that the regulation of the speech is justified without reference to the content of the speech.”<sup>264</sup> As an example of constitutional government regulation of free speech, the Court in *R.A.V.* provided that “sexually derogatory fighting words,” may be regulated if they result in a violation of Title VII’s prohibition against discrimination of employment on the basis of sex.<sup>265</sup> The government’s interest in limiting this type of speech is not to prohibit the prejudicial message but rather to safeguard those who may be negatively impacted by this speech, whether in the workplace or society. Although there is sufficient evidence to support the legislative finding that profane marks can cause societal harm analogous to the injuries cited as examples in *R.A.V.* and Congress, courts have relied on content-neutral justifications discouraging particular speech even if an outright ban on trademark registration is impermissible.<sup>266</sup>

### **i. Equity and Trademark Law**

Trademarks are a property right, but of a strange sort.<sup>267</sup> The fundamental property right of a trademark owner is the limited right to exclude others from using the mark in a manner that is likely to cause consumer confusion.<sup>268</sup> Except in the case of famous trademarks, all other uses of marks by others are permissible.<sup>269</sup> As a matter of black letter law, an owner is entitled to damages as a matter of right to compensation for tortious injuries caused to the property. However, equitable remedies are a matter of judicial discretion and not a matter of right.<sup>270</sup> The most significant

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<sup>263</sup> See *supra* Section II.

<sup>264</sup> *R.A.V. v. City of St. Paul*, 505 U.S. 377, 389 (1992) (internal quotation marks and citations omitted).

<sup>265</sup> *Id.* (internal quotation marks and citations omitted).

<sup>266</sup> See *supra* Section II.

<sup>267</sup> See *United Drug Co. v. Theodore Rectanus, Co.*, 248 U.S. 90, 98 (1918); See also J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §2:10 (describing the nature of a property right in a trademark). Because of the unique nature of the limited ownership right in a trademark owner is often called a “trademark holder.”

<sup>268</sup> McCarthy, *supra* note 220.

<sup>269</sup> *Id.*

<sup>270</sup> See, e.g. *MercExchange*, 547 U.S. at 391; *Winter v. Natural Resources Defense Council, Inc.*, 555 U.S. 7, 24 (2008) (“A preliminary injunction is an extraordinary remedy never

distinctions between law and equity are the election of remedies. A court of law may award monetary damages while a court of equity may order an injunction or decree instructing a party (or even a third-party) to act or to forbear from acting.

Furthermore, a court of equity will not order an equitable remedy unless the party can show no other adequate remedies at law available to them (e.g., damages are insufficient to remedy the injury).<sup>271</sup> Generally, in copyright and patent infringement cases, courts of equity limit remedies where the subject matter of the protected intellectual property is injurious to public morals, illegal, or otherwise contrary to public policy.<sup>272</sup> More recently, case law and commentators have rejected or criticized this approach for numerous reasons, the most significant being that this exercise of equitable discretion does not have a statutory basis.<sup>273</sup>

In contrast to the other intellectual property law remedies,<sup>274</sup> all trademark infringement dispute remedies are guided by equity principles.<sup>275</sup> There is a sound statutory basis for distinguishing trademark remedies from other intellectual property remedies where the courts had read into the copyright or patent act limitations that were not clearly expressed in the statute. Section 35 of the Lanham Act expressly provides that:

When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, a violation under section 1125(a) or (d) of this title, or a willful violation under section 1125(c) of this title, . . . the plaintiff shall be entitled, subject to the provisions of sections 1111 and 1114 of this title, and *subject to the principles of equity, to recover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action.*<sup>276</sup> The phrase "subject to the principles of equity" was added at the last moment most likely to put a limit on awards of profits as damages in trademark infringement litigation without an intention by Congress for more significant equitable doctrine based limitations on at law remedies such as damages.<sup>277</sup>

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awarded as a matter of right.").

<sup>271</sup> See *International Kennel Club of Chicago, Inc. v. Mighty Star, Inc.*, 846 F.2d 1079, 1084 (7th Cir. 1988); Mark A. Thurmon, *Ending the Seventh Amendment Confusion: A Critical Analysis of The Right to A Jury Trial in Trademark Cases*, 11 TEX. INTELL. PROP. L.J. 1, 53 (2002).

<sup>272</sup> See *supra* Section I.

<sup>273</sup> *Id.*

<sup>274</sup> Compare 17 USC § 504 (copyright), 35 U.S.C. § 284 (patent), and Uniform Trade Secrets Act § 3, with 15 U.S.C. § 1117(a) (power of the courts to award damages in trademark cases).

<sup>275</sup> 15 U.S.C. § 1117(a); see *Burger King Corp. v. Mason*, 710 F.2d 1480, 1495 (11th Cir. 1983).

<sup>276</sup> 15 U.S.C. § 1117 (emphasis supplied).

<sup>277</sup> See also Thurmon, *supra* note 271, at 307-308 (2010) (suggesting that this historical



Consequently, the limitations on equitable remedies suggested in the article may not for policy reasons affect the amount of damages that the alleged infringer should pay.

As this article contends, rarely is there a public interest in the dissipation of profane marks. Interestingly, damages are usually a matter of law, and adequate damages may preclude an equitable remedy.<sup>278</sup> Here, Congress made even a damage award that is subject to the principles of equity.<sup>279</sup> The court has discretion in determining damages. Making damages subject to equitable principles and enhanced judicial discretion suggests that a trademark infringement court sitting as a court of equity should exercise sound discretion in granting or issuing an injunction or crafting the scope of the injunctive relief.

## ii. Powers of Courts of Equity

The court of equity's ultimate power is to close the door—for the chancellor to turn her back on the petitioner.<sup>280</sup> Every law student can recite by rote the maxim of equity. “[S]he who comes into equity must come with clean hands.”<sup>281</sup> One other maxim is relevant here. “Equity follows the law.”<sup>282</sup> This section analyzes whether an equitable principle is sufficiently nuanced to reach the solution proposed by this article that courts sitting in equity jurisdiction use equitable principles to deny or limit equitable relief to profane marks.

The most important in this context is equity follows the law “*aequitas sequitur legem*”.<sup>283</sup> A court sitting in equity jurisdiction cannot do what the law forbids.<sup>284</sup> However, the Supreme Court in *Holland v. Florida* stated:

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change permitted court's sitting in equity to award damages).

<sup>278</sup> See *International Kennel Club of Chicago, Inc. v. Mighty Star, Inc.*, 846 F.2d 1079, 1084 (7th Cir. 1988).

<sup>279</sup> See, e.g. *General Electric Co. v. Speicher*, 877 F.2d 531, 535 (7th Cir. 1989); *Louis Vuitton SA v. Lee*, 875 F.3d 584, 589 (7th Cir. 1989); See also John Edward McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* (WestLaw) (5th ed. 2020).

<sup>280</sup> *Precision Instrument Mfg. Co. et al. v. Automotive Maintenance Machinery Co.*, 324 U.S. 806, 814 (1945).

<sup>281</sup> *Id.*

<sup>282</sup> JOSEPH STORY, *COMMENTARIES ON EQUITY JURISPRUDENCE* (Sweet and Maxwell., 3d ed. 1920). Also relevant is “equity will not suffer a wrong to be without a remedy.”; See *Browing v. Peyton*, 918 F.2d 1516, 1521 (11th Cir. 1990); M.B. Angell, *The Principles of Equity*, 29 *HARV. L. REV.* 888, 889 (1916) (discussing the equity maxim). As was discussed *supra*, the proposal of this article does not leave trademark owners remedy-less.

<sup>283</sup> *But see* *Equity Contra Legem*.

<sup>284</sup> *SEC v. Stanford International Bank, Ltd.*, 927 F.3d 830, 842-843 (9th Cir. 2019); See also *Armstrong v. Exceptional Child Center*, 575 U.S. 320, 327-328 (2015).

We have said that courts of equity “must be governed by rules and precedents no less than the courts of law.” But we have also made clear that often the “exercise of a court’s equity powers ... must be made on a case-by-case basis.” In emphasizing the need for “flexibility,” for avoiding “mechanical rules,” we have followed a tradition in which courts of equity have sought to “relieve hardships which, from time to time, arise from a hard and fast adherence” to more absolute legal rules, which, if strictly applied, threaten the “evils of archaic rigidity.” The “flexibility” inherent in “equitable procedure” enables courts “to meet new situations [that] demand equitable intervention, and to accord all the relief necessary to correct ... particular injustices.” Taken together, these cases recognize that courts of equity can and do draw upon decisions made in other similar cases for guidance. Such courts exercise judgment in light of prior precedent, but with awareness of the fact that specific circumstances, often hard to predict in advance, could warrant special treatment in an appropriate case.<sup>285</sup>

This article does not recommend that lower courts ignore either law or precedent but rather recognize that profane marks are a special case that courts have not considered before *Tam* and *Brunetti* and use their just discretion. Courts should distinguish prior precedent and give appropriate weight in all profane mark cases to the public interest factor before granting an equity remedy in crafting one.

#### **a. Standards for Equitable Relief**

Equitable remedies are sought as a matter of course by litigants and seemingly granted or entered by judges as a matter of routine, so it is useful to begin this section with a reminder. An equitable remedy is an extraordinary remedy, and it is not a remedy that is granted as a matter of right.<sup>286</sup> Instead, an equitable remedy is vested in the sound discretion of the court.<sup>287</sup> Older cases refer to the discretion in equity as an exercise of

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<sup>285</sup> *Holland v. Fl*, 560 U.S. 631, 649-650 (2010)(internal citations omitted).

<sup>286</sup> *Weinberger v. Romero-Barcelo*, 456 U.S. 305, 311-312 (1982).

<sup>287</sup> *eBay, Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391 (2006).

discretion as the chancellor's conscience.<sup>288</sup> Regardless, “courts of equity must be governed by rules and precedents no less than the courts of law.”<sup>289</sup> So, before granting an equity remedy, there must be an affirmative finding that the existing remedies available at law are insufficient.<sup>290</sup> An adequate remedy at law is a plain, adequate, and complete remedy; and, an adequate remedy at law divests a court of equity of its jurisdiction.<sup>291</sup> There may be close cases on the question of whether a remedy at law is adequate; however, because of the inherent nature of profane marks as expressive terms and their pervasiveness in society, and the purposes of equitable relief in trademark infringement actions, monetary damages should be sufficient in most cases.

In *Weinberger v. Romero-Barcelo*, the court held that where the plaintiff and defendant present competing claims of injury, the traditional function of equity has been to arrive at a “nice adjustment and reconciliation” between the competing claims[.]. In such cases, the court “balances the conveniences of the parties and possible injuries to them according as they may be affected by the granting or withholding of the injunction.” “The essence of equity jurisdiction has been the power of the Chancellor to do equity and to mold each decree to the necessities of the particular case. Flexibility rather than rigidity has distinguished it.”<sup>292</sup>

To make this decision, the court must engage in an individualized, case-by-case determination applying all the factors articulated in *eBay Inc. v. MercExchange, L.L.C.*<sup>293</sup> “A plaintiff must demonstrate: (1) that it has suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a

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<sup>288</sup> See H. Jefferson Powell, “*Cardozo’s Foot*”: *The Chancellor’s Conscience and Constructive Trusts*, 56 DUKE L&CP 7, 27 (1993) (discussing the concepts of equity and justice in society today).

<sup>289</sup> *Lonchar v. Thomas*, 517 U.S. 314, 323 (1996).

<sup>290</sup> See *Sonner v. Premier Nutrition Corp.*, 971 F.3d 834, 845 (9th Cir. 2020) (“must establish that [plaintiff] lacks an adequate remedy at law before securing equitable restitution for past harm . . .”). See *Mort v. United States*, 86 F.3d 890, 892 (9th Cir. 1996) (“It is a basic doctrine of equity jurisprudence that courts of equity should not act . . . when the moving party has an adequate remedy at law.” (ellipsis in original) (quoting *Morales v. Trans World Airlines, Inc.*, 504 U.S. 374, 381(1992))); see also e.g. *Franklin v. Gwinnett Cty. Pub. Sch.*, 503 U.S. 60, 75–76 (1992) (holding that when “remedies are equitable in nature . . . it is axiomatic that a court should determine the adequacy of a remedy in law before resorting to equitable relief”); *Schroeder v. United States*, 569 F.3d 956, 963 (9th Cir. 2009) (“[E]quitable relief is not appropriate where an adequate remedy exists at law.”).

<sup>291</sup> See James Buchwalter and John Kimpflen, *What Constitutes and Adequate Rmedy at Law*, 23 CJS EQUITY § 23 (2020) (citing *Georgia RR & Bank Co. v. Redwine*, 342 U.S. 299 (1952)).

<sup>292</sup> *Weinberger v. Romero-Barcelo*, 456 U.S. 305, 312-313 (1982).

<sup>293</sup> *eBay, Inc. v. MercExchange, LLC*, 547 U.S. 388, 391 (2006).

remedy in equity is warranted; and (4) that a permanent injunction would not disserve the public interest.”<sup>294</sup> The court must weigh each of these factors before granting an injunction. This article will not address the first three factors because, as was discussed previously, the author contends that profane marks are inherently weak marks.<sup>295</sup> Profane marks are likely to be at best weakly descriptive marks or a form of trade dress requiring proof of secondary meaning. There will be strong trademark fair use justifications for competitors (and others) to use these marks and defenses aesthetic functionality. Ubiquitous exposure in numerous contexts so that one more use is unlikely to cause irreparable harm. Considering these competing uses and the mark’s weakness, monetary damages paid by a competitor-infringer is likely to be an adequate remedy at law. This article is agnostic on balancing the hardships. Still, it concedes between the trademark registrant and the infringer in most cases, the balance should tip in favor of the registrant. However, injunctive relief is a four-factor test and not a four-element test, so no one factor is dispositive in all cases—finally, the fourth factor, the factor of the public interest. As was and will be discussed, the public interest (“public policy”) and intellectual property seem to have a meandering role in modern equity practice.<sup>296</sup>

### **b. Public Policy and Equity in Intellectual Property**

One could with a high degree of confidence say that discouraging “immorality” broadly defined to cover deception, lewdness, or other acts detrimental to social morality and public policy was both in the public interest and consistent public policy when a court sat in its equity jurisdiction for most of U.S. history.<sup>297</sup> Over time, courts abandoned this role in the context of intellectual property disputes because of the complexity of the issues, a sustained doubt as to their institutional competency, and a desire to contract the court’s docket. This section briefly will develop the modern doctrine of public policy and injunctions and return to issues first mentioned earlier regarding *Mitchell Brothers Film Group*, but left until now for development.

*Public policy* is a formal recognition of the *public interest* as articulated by Congress, administrative agencies, and the courts. However, the court’s evaluation of the public interest factor when determining to enter an

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<sup>294</sup> *Id.*

<sup>295</sup> *See supra* Section II.

<sup>296</sup> *See supra* Section IV.

<sup>297</sup> *See supra* Section V.

injunction often gets short shrift by the courts as the court's attention weighs more on the first three factors. This prioritization is reasonable (but bad jurisprudence) because the parties before the court are focused on the first three factors and their significance to the actual dispute. The U.S. Supreme Court has held that in exercising their sound discretion, courts of equity should pay particular regard for the *public consequences* in employing the extraordinary remedy of injunction. Thus, the Court has noted that "[t]he award of an interlocutory injunction by courts of equity has never been regarded as strictly a matter of right, even though irreparable injury may otherwise result to the plaintiff[.]"<sup>298</sup>

## VI. BALANCING EQUITABLE PRINCIPLES WITH PUBLIC POLICY

A significant factor used by courts in weighing the balance of the equities is often not given enough weight by the courts—the public interest. In this context, injunctive remedies, the public interests are often a proxy for public policy. Courts have looked to the constitution, statutes, administrative regulations, court decisions, including the common law, and even canons of professional ethics to find relevant public policy sources. Whether the courts can use public policy articulated in §2(a) of the Lanham Act that survived *Tam* and *Brunetti* as a strong justification to limit the scope of an equitable remedy in the case of profane marks is a challenging question. Superficially, *Mitchell Brothers, Inc.* presents the most persuasive arguments articulated so far by a court against the use of equity to limit remedies based on “moral grounds.”<sup>299</sup> As discussed previously, the *Mitchell Brothers, Inc.* court clearly articulated several good reasons why a court should not consider the product's morality rather than the parties' morality in evaluating a petition for an equitable remedy. However, that was a copyright case, and trademark law is readily distinguishable. The *Mitchell Brothers* Court in rejecting the holding of *Stone & McCarrick* held that it “does not only apply a traditional equitable doctrine; it goes further and extends the doctrine of unclean hands to a situation not covered by the doctrine at common law and thus subverts a statutory purpose.”<sup>300</sup> In the case of profane marks, limitations on equitable remedies would not frustrate other statutory purposes or clear congressional intent.

A court in a trademark infringement case need not worry whether Congress intended the remedies to be duplicative of or separate from other

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<sup>298</sup> *Weinberger v. Romero-Barcelo*, 456 U.S. 305, 313 (1982).

<sup>299</sup> *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852, 864 (5<sup>th</sup> Cir. 1979).

<sup>300</sup> *Id.*

laws with differing incentives—at least as far as profane marks are concerned. Unlike in the case of copyright law where there are at least two bodies of the relevant law, the copyright act, which promotes creativity and the dissemination of works, and the laws governing obscenity, which *prohibit their creation and distribution which run (at least according to the Mitchell Brother's Film Group Court) on separate, but parallel tracks.* Under *Mitchell Brothers Film Group*, the author of the work had a federal copyright incentive to create, register, and exploit the work. Still, if the author does so, and the work is later deemed obscene by a court, the author may face fines, imprisonment, or both (under federal and state law). The *Mitchell Brothers Film Group* court thought it unfair to subject the author to a threat of no copyright registration or protection in works with pushed moral boundaries. While the author faced more severe penalties if the work was legally obscene. Trademark law is largely unitary. Congress has expressed one set of purposes and one set of policies governing trademarks embodied in the Lanham Trademark Act (as amended), unlike in the case of copyright law and obscenity.<sup>301</sup>

Congress did not intend for scandalous or profane marks to be federally registered trademarks.<sup>302</sup> To the degree that trademark registration and its accompanying rights and remedies constitute a subsidy, Congress did not desire to provide a subvention. There are no contrary federal or state policies that would promote the use of profane marks.<sup>303</sup> As was discussed above, other bodies of law discourage their use. Consequently, the only declared congressional trademark policy is to prevent the use of profane marks. However, while there is a clearly stated policy, the mechanism designed by Congress to implement this policy, the sections of § 2(a) prohibiting the registration of profane marks have been declared unconstitutional. Therefore, the hard question is whether the courts may use a constitutionally sound policy (at least as to the problem scandalous marks) to justify the application of equity when the specific means enacted by Congress are unconstitutional as written and Congress fails to amend the statute.<sup>304</sup>

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<sup>301</sup> There seems to be no other body federal of law that provides any incentive to create profane marks. In fact other bodies of law, such as those administered by the FCC would discourage their use during certain hours and broadcast mediums. See <https://time.com/wp-content/uploads/2014/12/da-14-1867a1.pdf>. (While the FCC refused to punish a radio station for using the disparaging REDSKINS mark on the air, the FCC did leave open the possibility of sanctioning marks that were sexual or excretory in nature or hate speech once a competent court makes that determination.).

<sup>302</sup> 15 USC § 1052(a) (2012).

<sup>303</sup> Cf. *Iancu v. Brunetti*, 139 S. Ct. 2294, 2311 (2019) (providing examples where indecent or profane terms may not be lawfully used).

<sup>304</sup> See *supra* Section III.

However, its use as a public policy justification to deny an equitable remedy or narrow the scope of such as remedy appears permissible and within the court's discretion when weighing equitable factors.

### CONCLUSION

There are several possible solutions to rid the trademark registers of the most indecent, vulgar, offensive, or profane of marks and perhaps incidentally reducing their ubiquitous (and inescapable) presence in modern society. Solutions range from—a careful application of neutral trademark registration principles—to a highly limited and viewpoint-neutral amendment of § 2(a) to eliminate scandalous marks—to a shift in the analytical focus from registering the mark to the enforcement/remedy stage of litigation. This article contends that all of these options would be undertaken to minimize these marks' social and economic harms in the best of all possible worlds. Unfortunately, this is not the best of all possible worlds; therefore, a focus on eliminating or narrowing equitable remedies may be the more efficient and realistic in removing some of the statutory trademark incentives supporting profane marks. For almost two hundred years, courts have found that intellectual property rights sound in morality and equity principles. Courts have not rejected morality as a basis for intellectual property. Instead, they doubted their competence to be moral arbitrators in an increasingly complex society. Equity still rests on a moral foundation. The protections or remedies equity giveth, equity may taketh away or narrow. As a matter of constitutional law, profane marks are registerable today *only* because Congress declared a public policy then artfully designed an unconstitutional mechanism to enforce that policy—and then failed to act to correct the situation.

The Lanham Trademark Act §2(a), as eviscerated by the Court in *Tam* and *Brunetti*, now permits individuals to register these marks. Still, neither the constitution nor the Lanham Act may require that courts of equity protect these marks by granting their owners a robust, comprehensive, equitable remedy for trademark infringement. Little can be done to discourage registrations for which the mark's vulgarity constitutes the product other than to consider under traditional trademark principles that recognize that these marks are not product packaging but product design and protect them under-trademark law. The changes proposed in this article are modest. Many marks that are run-of-the-mill potty mouth offensive but are not legally profane marks will escape the analysis offered in this article and receive robust, equitable protection. In sum, for trademark registrants who want to build a national brand, limitations on equitable remedies may provide a

solution that will keep the most disparaging, obscene, vulgar, and profane marks from becoming ubiquitous as trademarks for national brands. Still, it will do little to discourage marks where the brand's profanity is also its commercial product.



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