

# CONGRESSIONAL TRADEMARK DELUSION: SECTION 2(A) EXPANDS THE UNCLEAR HANDS DOCTRINE TOO FAR

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## I. INTRODUCTION

An inconsistency exists in the protection of intellectual property when it comes to immoral marks in commerce. While the band N.W.A. can promote and exclusively sell its song entitled “Fuck tha Police,”<sup>1</sup> a business cannot obtain trademark registration for its “BULLSHIT” purse line.<sup>2</sup> Similarly, a movie poster for a 1981 movie, *The Blue Lagoon*, featured two young nude adolescents affectionately touching each other in the jungle,<sup>3</sup> but in the same year a picture of a couple kissing in the nude did not gain trademark registration when applied to a sexually oriented newsletter.<sup>4</sup> Copyright law grants an exclusive monopoly to the author of *any* original authorship.<sup>5</sup> The Lanham Act on trademarks, however, denies the minimal added rights of registration for scandalous

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<sup>1</sup> N.W.A., *Fuck tha Police*, on STRAIGHT OUTTA COMPTON (Ruthless Records 1988).

<sup>2</sup> *In re Tinseltown, Inc.*, 212 U.S.P.Q. (BNA) 863, 865–66 (T.T.A.B. 1981).

<sup>3</sup> THE BLUE LAGOON (Columbia Pictures 1981).

<sup>4</sup> *In re McGinley*, 660 F.2d 481, 487 (C.C.P.A. 1981).

<sup>5</sup> 17 U.S.C. § 102 (2006). A copyright monopoly is limited to life of the author plus seventy years, whereas a trademark owner may prohibit unfair competition in their mark as long as the mark is in use. 17 U.S.C. § 302; 15 U.S.C. § 1059 (2006). There is a split among the courts over the protection of obscene works under copyright discussed further *infra* Section III.B. *Compare* Mitchell Bros. Film Group v. Cinema Adult Theater, 604 F.2d 852, 863 (5th Cir. 1979), *with* Devils Films, Inc. v. Nectar Video, 29 F. Supp. 2d 174, 175–76 (S.D.N.Y. 1998).

and immoral marks.<sup>6</sup> This ban on registration does not prevent a manufacturer's use of the mark, but merely prevents the benefits of registration.<sup>7</sup>

The purpose of trademark law is economic in nature.<sup>8</sup> It intends to advance a business's goodwill and prevent consumer confusion.<sup>9</sup> Whether a mark is immoral or scandalous has no bearing on fair competition or the mark's use as a product indicator. So what is section 2(a) of the Lanham Act other than an unnecessary and burdensome limitation on trademark registration? This Article argues that section 2(a) is a remnant of religious protectionism and the doctrine of unclean hands, neither of which further the fundamental policy concerns of trademark law, and therefore should have no place in the Lanham Act. A review of trademark's neighboring copyright law supports this position.<sup>10</sup> Furthermore, judging society's varying mores is beyond the scope of the United States Patent and Trademark Office ("PTO") and none of the policy reasons currently raised for its inclusion supports its continued use. Therefore, Congress should revoke the ban on registration of scandalous and immoral marks from section 2(a) of the Lanham Act and let the marketplace decide the fate of products bearing marks of questionable public acceptability.

This Article begins by tracing a brief background of trademark law and the origins of section 2(a) of the Lanham Act. Section III discusses the application of the unclean hands doctrine in trademark and copyright cases. Section IV explains how the inclusion of section 2(a) is incongruous with the purpose of

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<sup>6</sup> Lanham Act § 2(a), Pub. L. No. 79-489, 60 Stat. 427, 428 (1946) (codified at 15 U.S.C. § 1052(a) (2006)) (The Act permits registration of a mark unless the mark "consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute."). Although the clause includes several other bans, this Article takes issue only with the barring of immoral and scandalous matter. Of interest, no case has come before the courts regarding whether Section 43(a) of the Lanham Act, which protects unregistered trademarks, would protect a mark deemed scandalous or immoral. See also Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661, 791 (1993) (arguing that Section 43(a) would not likely protect scandalous marks).

<sup>7</sup> *In re McGinley*, 660 F.2d at 486 ("[T]here is no prohibition against appellant's use of his mark or any limitation on enforcement of his rights under the common law or state legislation. What is denied are the benefits provided by the Lanham Act which enhance the value of a mark.").

<sup>8</sup> See William N. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265 (1987).

<sup>9</sup> See 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 2:15, 2:33 (4th ed. 2007).

<sup>10</sup> See Jendi B. Reiter, *Redskins and Scarlet Letters: Why "Immoral" and "Scandalous" Trademarks Should Be Federally Registrable*, 6 FED. CIR. B.J. 191, 200 (1996).

trademark law and inconsistent in application. Section V concludes that the Legislature should sensibly strike section 2(a) from the Lanham Act.

## II. THE LANHAM ACT CODIFIED THE COMMON LAW

From the onset of competition between manufacturers, there has existed a need for distinguishing between merchandise from different manufacturers.<sup>11</sup> Thus, in the beginning of American jurisprudence, the courts recognized an exclusive and legal right in trademark property.<sup>12</sup> A trademark is *any* word or symbol that designates the origin of a good or service.<sup>13</sup> The qualified rights of trademark attach only when an owner uses the mark in commerce to designate a product's source,<sup>14</sup> as opposed to the monopolistic rights of patent and copyright.<sup>15</sup> A trademark's "real value consists in the confidence and patronage of the public, secured through its instrumentality in acquainting them with the origin and ownership of an article, which thus gains reputation for its superior qualities."<sup>16</sup>

Trademark law evolved from the common law of unfair competition and generally promoted three goals: 1) protecting fair competition; 2) building a business's goodwill; and 3) reducing consumer search costs. Primarily, "[t]he object of trade-mark law is to prevent one person from selling his goods as those of another, to the injury of the latter and of the public."<sup>17</sup> Before the Lanham

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<sup>11</sup> FRANCIS H. UPTON, A TREATISE ON THE LAW OF TRADEMARKS: WITH A DIGEST AND REVIEW OF THE ENGLISH AND AMERICAN AUTHORITIES 9–10 (1860) ("The necessity for the use of such distinguishing marks for articles of merchandise, must have arisen with the dawn of manufacturing and mercantile competition.").

<sup>12</sup> *Id.* at 10.

<sup>13</sup> *Avery & Sons v. Meikle & Co.*, 81 Ky. 73, 84 (1883) ("A trade-mark is a sign or symbol primarily confined exclusively to the indication of the origin or ownership of the goods to which it may be attached, and it may be composed of any name, device, line, figure, mark, word, letter, numeral, or combination, or arrangement of any or all of these which would serve the sole purpose of a trade-mark, and which no other person can adopt or use with equal truth.").

<sup>14</sup> *Id.* at 86.

<sup>15</sup> *See* U.S. CONST. art. 1, § 8, cl. 8 (granting Congress the ability to make laws to promote the arts and sciences); 17 U.S.C. §§ 102, 106 (2006) (granting exclusive rights to authors of original artistic expressions fixed in a tangible medium); 35 U.S.C. §§ 101–103, 154(a) (2006) (granting exclusive rights to inventors of novel, useful, and nonobvious creations); 35 U.S.C. § 171 (2006) (granting exclusive rights to designers of novel, nonobvious, nonfunctional, ornamental features and configurations).

<sup>16</sup> *Avery & Sons*, 81 Ky. at 86.

<sup>17</sup> *Id.* at 84.

Act, “[c]ourts of equity proceed[ed] ‘on the principle of protecting property alone,’ and the promotion of honesty and fair dealing.”<sup>18</sup> Mere protection of the public was insufficient.<sup>19</sup>

At common law, a manufacturer could not gain a trademark by mere registration; it required actual use.<sup>20</sup> Today, a company may register a trademark with the intent to use, however the United States still requires actual use to maintain the benefits of registration and the protection of the Lanham Act.<sup>21</sup>

Although the Patent Act of 1842<sup>22</sup> did not explicitly protect trademarks, the courts often applied the law protecting ornamental designs literally, resulting in the protection of trademarks.<sup>23</sup> Noting the unwarranted construction of the law, Congress revised the act to include federal trademark laws under Article I, section eight of the U.S. Constitution.<sup>24</sup> The 1870 Act barred registration of marks that either: (1) could not become lawful trademarks; (2) incorporated the name of a person, firm or corporation; or (3) were similar to other registered marks that resulted in deceit.<sup>25</sup> Additionally, the 1870 Act held that an owner could not enforce a mark if it was used in an unlawful business, upon an injurious article, was fraudulently obtained, or was formed and used with a deceptive intent.<sup>26</sup> The Supreme Court eventually struck down the amended statutes relating to trademarks under this Act because “[t]he ordinary trade-mark has no necessary relation to invention or discovery” required for protection of patents or

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<sup>18</sup> *Id.* at 90.

<sup>19</sup> *Id.* at 90–91.

<sup>20</sup> Trade-Mark Cases, 100 U.S. 82, 94 (1879).

<sup>21</sup> 15 U.S.C. § 1051 (2006).

The benefits of registration, in part with government assistance, include public notice of the mark . . . , maintenance of permanent public records concerning the mark, availability of the Customs Service for blocking importation of infringing goods, . . . a presumption of validity of the registration . . . notices to the registrant concerning maintenance of the registration, and, to some extent, direct government protection of the mark in that the PTO searches its records and refuses registrations to others of conflicting marks.

*In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981).

<sup>22</sup> Act of Aug. 29, 1842, ch. 263, 5 Stat. 543 (current version at 35 U.S.C. § 171 (2006)) (granting an exclusive patent right in designs affixed to manufactured products).

<sup>23</sup> See UPTON, *supra* note 11, at 17–18.

<sup>24</sup> Act of July 8, 1870, ch. 230, §§ 77–84, 16 Stat. 198, 210–12, *invalidated by* Trade-Mark Cases, 100 U.S. 82 (1879).

<sup>25</sup> *Id.* § 79, 16 Stat. at 211.

<sup>26</sup> *Id.* § 84, 16 Stat. at 212.

the originality required for copyrights.<sup>27</sup> The initial attempt, however, sheds light on the boundaries of the laws. After the Supreme Court invalidated the Act of 1870, Congress passed the Act of 1881 protecting “owners of trademarks used in commerce with foreign nations, or with the Indian tribes . . . .”<sup>28</sup> The 1881 Act barred marks that consisted of the applicant’s name, and marks of the same class of goods as registered marks that were either identical or so similar as to cause a likelihood of confusion, mistake or deception for the public.<sup>29</sup> Since Congress did not initially limit any of the previous intellectual property laws with morality, why would it later restrict the moral boundaries of trademarks?

The first sign of the ban on scandalous and immoral marks appeared in a House of Representatives Report that proposed an amendment to “limit[] registration to marks . . . [that] are not offensive to public sentiment or morals.”<sup>30</sup> Congress incorporated the restriction into the next revision of the Act in 1905.<sup>31</sup>

#### A. Section 5(a) of the 1905 Act

The ban on registration of “immoral” and “scandalous” marks began with the 1905 federal trademark statute.<sup>32</sup> Section 5(a) of the 1905 Act protected marks used to distinguish goods from the same class unless the mark “con-

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<sup>27</sup> Trade-Mark Cases, 100 U.S. at 94.

<sup>28</sup> Act of Mar. 3, 1881, ch. 138, § 1, 21 Stat. 502, 502 (current version at 15 U.S.C. § 1051(d) (2006)).

<sup>29</sup> *Id.* § 3, 21 Stat. 502, 503 (current version at 15 U.S.C. § 1052 (2006)).

<sup>30</sup> H.R. REP. NO. 52-1860, at 3 (1892). One scholar speculates that the introduction of this ban was a result of a review of international trademark law and the United States accession to the Paris Convention in 1887, which included the option for members to deny registration to trademarks contrary to morals and public order. Jasmine Abdel-khalik, *To Live in In-“Fame”-Y: Reconceiving Scandalous Marks as Analogous to Famous Marks*, 25 CARDOZO ARTS & ENT. L.J. 173, 197 (2007); see Paris Convention for the Protection of Industrial Property, art. 6, Mar. 20, 1883, 25 Stat. 1372, 21 U.S.T. 1583 (last revised at Stockholm on July 14, 1967).

<sup>31</sup> Act of Feb. 20, 1905, ch. 592, § 5(a), 33 Stat. 724, 725 (current version at 15 U.S.C. § 1052(a) (2006)).

<sup>32</sup> *Id.* Scholars have generally grouped the marks that fall under this clause as “political imagery; religious terms and icons; race, gender, and sexual orientation; sexual matter (vulgar); profanity (vulgar); and illegality.” Abdel-khalik, *supra* note 30, at 200; see, e.g., Baird, *supra* note 6, at 704. The courts generally combine the immoral and scandalous terminology and decide cases using only the definition of scandalous. See TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1203.01 (5th ed.), available at, [http://tess2.uspto.gov/tmdb/tmep/1200.htm#\\_T120301](http://tess2.uspto.gov/tmdb/tmep/1200.htm#_T120301).

sist[ed] of or comprise[d] immoral or scandalous matter.”<sup>33</sup> Why Congress included this ban remains unclear because Congress included minimal legislative history to explain its purpose or guide the courts in evaluating claims.<sup>34</sup> The Committee on Patents of the House of Representatives believed section 5 would “permit the registration of all marks which could, under the common law as expounded by the courts, be the subject of a trademark and become the exclusive property of the party using the same as his trademark.”<sup>35</sup> Up until the added restriction of section 5(a), scandalous and immoral marks could be the proper subject of a trademark.<sup>36</sup>

The first case to deny registration of a mark as scandalous under section 5(a) involved the mark “MADONNA” on a bottle of wine.<sup>37</sup> Due to a lack of legislative history on the clause, the court defined the word “scandalous” using its ordinary and common meaning as found in the dictionary.<sup>38</sup> The court stated the mark need not be per se scandalous, but consideration “must be given to the goods upon which the mark is used.”<sup>39</sup> Thus, after finding the mark was not per

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<sup>33</sup> Section 5(b) banned registration of national or state flags, coat or arms, or other insignia, names of individuals, corporations, or associations, mere descriptive marks, and portraits of living individuals.

<sup>34</sup> *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938) (“This clause first appeared in the Trade-Mark Act of February 20, 1905. Its legislative history does not aid us in arriving at the intent of Congress in its enactment . . .”). *But see* Abdel-khalik, *supra* note 30, at 195–200 (noting the possible influence of international law on the authors of the Act of 1905).

<sup>35</sup> JAMES LOVE HOPKINS, *THE LAW OF TRADEMARKS, TRADENAMES, AND UNFAIR COMPETITION* 558 (3d ed. 1917).

<sup>36</sup> This is not to be confused with “immoral businesses,” which are unlawful or against public policy. WILLIAM HENRY BROWNE, *A TREATISE ON THE LAW OF TRADE-MARKS* § 349 (2d ed., Boston, Little, Brown 1885). “To entitle one to favorable judicial interposition, in case of infringement, it is not only essential that the symbol claimed be his mark of manufacture or commerce; but the business in which it be used by him must be lawful.” *Id.* These businesses are void and thus should not be able to enforce trademark rights. *Id.*; *see also* Abdel-khalik, *supra* note 30, at 188–90.

<sup>37</sup> *In re Riverbank Canning Co.*, 95 F.2d at 329. Prior cases denied registration under section 5(b) for use of insignia, prior use, and descriptive names. *See* HOPKINS, *supra* note 35, at 559–65.

<sup>38</sup> *In re Riverbank Canning Co.*, 95 F.2d at 328 (using dictionary definitions of scandalous—“shocking to the sense of truth, decency, or propriety”—and Madonna—“[m]y lady; signora; . . . the Virgin Mary”); *see also* *In re McGinley*, 660 F.2d 481, 485–86 (C.C.P.A. 1981).

<sup>39</sup> *In re Riverbank Canning Co.*, 95 F.2d at 328; *see* Theodore H. Davis, Jr., *Registration of Scandalous, Immoral, and Disparaging Matter Under Section 2(a) of the Lanham Act: Can One Man’s Vulgarity Be Another’s Registered Trademark?*, 83 TRADEMARK REP. 801, 807–17 (1993) (analyzing courts’ application of the *per se* standard).

se scandalous,<sup>40</sup> the court denied registration of the “MADONNA” mark on wine, fearing it would likely offend the Christian population to use the Virgin Mary in connection with wine.<sup>41</sup> The dissent noted that the PTO had registered the term for use on nonalcoholic items.<sup>42</sup> Therefore, the dissent argued, the mere commercialization of the mark did not shock the senses and, thus, it should not be shocking to use the mark on wine.<sup>43</sup> Although courts differ on whether connection with the product is necessary, and despite the previous finding that the mark “MADONNA” was not per se scandalous, the same mark in pictorial form in association with edible oil was also later denied.<sup>44</sup>

The same year as the “MADONNA” case the mark “QUEEN MARY” on women’s underwear was also denied registration.<sup>45</sup> In a very short opinion, the commissioner agreed with the examiner who merely stated “the application of the name of the Dowager Queen of England as a trade mark to the goods involved constitutes scandalous matter.”<sup>46</sup> Additionally, the commissioner denied the mark registration because it consisted of an individual’s name and was not distinctively displayed.<sup>47</sup> Despite its limited use, Congress maintained the limitation in the next revision of the act over forty years later.<sup>48</sup>

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<sup>40</sup> *In re Riverbank Canning Co.*, 95 F.2d at 328.

<sup>41</sup> *Id.* at 329.

Because the relevant focus of the Section 2(a) inquiry in the religious context seems to focus on the particular religious group identified by the mark, the decisions interpreting the ‘scandalous’ language of Section 2(a) are difficult to distinguish from those decided under the ‘disparaging’ language of Section 2(a). Perhaps the Section 2(a) cases with a religious nexus are better dealt with under the disparaging rubric.

Baird, *supra* note 6, at 705. Section 2(a) also denies registration to “disparaging” marks, but the analysis is slightly different from that for scandalous or immoral marks. *See Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1639 (T.T.A.B. 1988) (stating that a disparaging mark is “essentially a violation of one’s right of privacy -- the right to be ‘let alone’ from contempt or ridicule”); *see also In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654 (T.T.A.B. 1990) (holding the mark “MOONIES”—a term that identifies members of the Unification Church—with a buttocks caricature not scandalous).

<sup>42</sup> *In re Riverbank Canning Co.*, 95 F.2d at 330 (Jackson, J., dissenting).

<sup>43</sup> *Id.*

<sup>44</sup> *Ex parte F. & M. Importing Co.*, 39 U.S.P.Q. (BNA) 451 (Comm’r Pat. 1938).

<sup>45</sup> *Ex parte Martha Maid Mfg. Co.*, 37 U.S.P.Q. (BNA) 156 (Comm’r Pat. 1938).

<sup>46</sup> *Id.*

<sup>47</sup> *Id.*

<sup>48</sup> Lanham Act § 2(a), Pub. L. No. 79-489, 60 Stat. 427, 428 (1946) (codified at 15 U.S.C. § 1052(a) (2006)).

**B. Section 2(a) of the 1946 Act**

In 1946, Congress passed the Lanham Act to “place all matters relating to trade-marks in one statute and to eliminate judicial obscurity, to simplify registration and to make it stronger and more liberal, to dispense with mere technical prohibitions and arbitrary provisions, to make procedure simple, and relief against infringement prompt and effective.”<sup>49</sup> The registration ban on scandalous and immoral marks moved to section 2(a), refusing registration if a mark “consists of or comprises immoral, deceptive, or scandalous matter,” but Congress failed to add any statements clarifying the purpose of the ban or its appropriate implementation. Thus, application of the clause generally remained the same. For example, under the revised 1946 Act the mark “MADONNA” on wine was again refused registration, despite its continued use from 1934 until 1959, absent federal registration.<sup>50</sup> Because the wording of the statute had not changed, the use of the mark on wine was still scandalous.<sup>51</sup>

Without any additional guidance in the revised Act, the PTO and the courts continued to misapply the statute. This is well illustrated in a case where a company successfully registered and used the mark “Dough-boy” on “a prophylactic preparation for the prevention of venereal diseases” beginning in 1923.<sup>52</sup> The company allowed the registration to expire, and another company, Doughboy Industries, began using the mark absent the hyphen on wheat flour products.<sup>53</sup> In 1951, Doughboy Industries opposed the prophylactic company’s attempt to re-register its mark.<sup>54</sup> Despite finding that “there would not be any reasonable likelihood of confusion or deception of purchasers,” the court denied registration under section 2(a) stating only that “the mark obviously ‘consists of or comprises . . . matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.’”<sup>55</sup> In contrast, “OLD GLORY CONDOM CORP,” with stars and stripes on condoms suggesting the American flag, was

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<sup>49</sup> S. REP. NO. 79-1333, at 1274 (1946).

<sup>50</sup> *In re P.J. Valckenberg, GmbH*, 122 U.S.P.Q. (BNA) 334, 334 (T.T.A.B. 1959).

<sup>51</sup> *Id.*

<sup>52</sup> *Doughboy Indus., Inc. v. Reese Chem. Co.*, 88 U.S.P.Q. (BNA) 227, 227–28 (Pat. Office Exam’r-in-Chief 1951) (“‘Doughboy’ is the name given to the American Soldier in the first World War . . .”).

<sup>53</sup> *Id.*

<sup>54</sup> *Id.*

<sup>55</sup> *Id.* (quoting Lanham Act § 2(a)).

not scandalous.<sup>56</sup> As these cases illustrate, despite spare application of the clause, the courts continued to apply the law inconsistently.

### III. THE COURTS' DIFFERING APPLICATION OF UNCLEAN HANDS

The doctrine of unclean hands requires that one who seeks equity from a court must come with clean hands.<sup>57</sup> There are multiple rationales for this doctrine, including simple fairness such that a plaintiff who is no better than the defendant should not receive relief, and protection of the public.<sup>58</sup> Something less than illegal conduct that transgresses the “equitable standards of conduct is sufficient cause for the invocation of the [unclean hands] maxim.”<sup>59</sup> The plaintiff’s misconduct, however, must relate to the subject matter of the litigation.<sup>60</sup>

A discrepancy exists in the application of the doctrine between the laws of trademark and copyright. In trademark cases, injury to the defendant is not required.<sup>61</sup> In other words, harm to the public is sufficient to raise the unclean hands maxim because the commercial nature of deceitful trademarks creates a fraud on the consumers.<sup>62</sup> Therefore, even when the defendant has infringed a trademark, a court may deny the plaintiff relief if the plaintiff has misused his mark. In copyright cases, however, the content of the material is irrelevant and therefore the misconduct of the rights owner must directly relate to the defendant.<sup>63</sup>

#### A. *The Use of Unclean Hands in an Immoral Trademark Context*

The Supreme Court of Pennsylvania was the first to connect the doctrine of unclean hands with an immoral trademark argument in a case involving

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<sup>56</sup> *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216 (T.T.A.B. 1993).

<sup>57</sup> *Manhattan Med. Co. v. Wood*, 108 U.S. 218, 227 (1883).

<sup>58</sup> MCCARTHY, *supra* note 9, § 31:45.

<sup>59</sup> *Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co.*, 324 U.S. 806, 815 (1945).

<sup>60</sup> MCCARTHY, *supra* note 9, § 31:48.

<sup>61</sup> *Id.* § 31:47.

<sup>62</sup> *Id.*

<sup>63</sup> *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852, 863 (5th Cir. 1979). *But see Devils Films, Inc. v. Nectar Video*, 29 F. Supp. 2d 174, 175–76 (S.D.N.Y. 1998) (identifying a circuit split about providing judicial awards to copyright holders of obscene material). See *infra* Section II.B.

the counterfeiting of a union label.<sup>64</sup> The defendant attached counterfeit “Union Labels” to boxes of cigars for retail sale.<sup>65</sup> The “Union Labels” certified that the cigars were “made by First-Class Workman, a member of the Cigar-Makers’ International Union of America, an organization opposed to inferior rat-shop, Cooly, Prison, or Filthy Tenement-House Workmanship.”<sup>66</sup> The court related “morals” to both parties in the case. To the defendants the court stated, “[t]here is no rule of morals or of business upon which he can defend himself in the preparation and use of spurious labels.”<sup>67</sup> Additionally, to the plaintiffs the court stated “[t]heir right to use such a label may well be doubted, whether the question be treated as one of morals or of law.”<sup>68</sup> The court then ruled against the plaintiff Union because they did not come into court with clean hands.<sup>69</sup> Rather, the Union had “the avowed purpose to do harm to non-union men; to prevent the sale of their work; to cover them with opprobrium.”<sup>70</sup>

In a different case with the same facts, *Cohn v. People*,<sup>71</sup> the defendant claimed the label attacked manufacturers of cigars who did not use Union workers and, therefore, argued the label “could not have been rightfully adopted . . . as a . . . trade-mark . . . [because] it transgressed the rules of morality and public policy.”<sup>72</sup> The court cited *McVey* and also quoted William Henry Browne’s treatise on trademarks: “To be a ‘lawful trade-mark,’ the emblem must avoid transgressing the rules of morality or public policy.”<sup>73</sup> The court, however, decided that the label did not attack any manufacturers of cigars.<sup>74</sup> Instead, the court held for the Union and stated the label simply acknowledged that other

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<sup>64</sup> *McVey v. Brendel*, 22 A. 912, 915 (Pa. 1891). Although the court decided that the “label” was not a trademark and that “labels” were not protected under the Act of 1870, the court continued to analyze the label’s purpose and the conduct of defendants in promoting the label. *Id.* at 914–15. At the time, courts often considered labels analogous to trademarks and granted protection. See BROWNE, *supra* note 36, § 521 (“Several species of incorporeal rights are protected on principles similar to those on which rests the ownership of a trademark. . . . Such rights may consist . . . in mere labels, wrappers, styles of packages, or other means of representing goods.”). The Act of 1891, however, included the protection of labels.

<sup>65</sup> *McVey*, 22 A. at 913.

<sup>66</sup> *Id.* at 912.

<sup>67</sup> *Id.* at 915.

<sup>68</sup> *Id.*

<sup>69</sup> *Id.*

<sup>70</sup> *Id.*

<sup>71</sup> 37 N.E. 60 (Ill. 1894).

<sup>72</sup> *Id.* at 62.

<sup>73</sup> *Id.*; BROWNE, *supra* note 36, § 602.

<sup>74</sup> *Cohn*, 37 N.E. at 62–63.

non-union made cigars were on the market and assured that these non-union establishments did not make their cigars.<sup>75</sup>

The court's quote of Browne took the issue of morality away from its original context of religion. Browne believed there were an "infinite" number of "objects suitable for use as trade-marks" and therefore "[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>76</sup> Courts that quoted Browne's statement that lawful trademarks must not offend morals or public policy forgot to include his further refinement of this thought that "[t]he law will not aid any person to bring obloquy upon objects and symbols consecrated to religion."<sup>77</sup> Although Browne did not cite any cases in support of these statements, he noted that the PTO "hesitated to permit a representation of the evil one himself to be registered as a trademark" for a German brewery, yet the PTO registered the trademark.<sup>78</sup> The section ends with Browne's hypothetical trademark of a devil in human form with followers and claims that registration of such a mark "would have been in law an atrocious libel, and must have been rejected on that account."<sup>79</sup> Thus, although cases regarding the cigar union label cited Browne's treatise section on immoral marks, none of them included the context of religion to which Browne specifically applied his doctrine of barring registration of immoral marks.

The underlying rationale for the doctrine of unclean hands does not support refusing to register a scandalous or immoral mark. The marks are not illegal, and therefore the plaintiff is better than any potential defending infringer, and no fraud or deceit is put upon the public. Thus, the only possible explanation for the clause is to protect societal mores.

### ***B. Unclean Hands in a Copyright Context***

Courts have promoted several reasons for denying a defense of unclean hands to copyright infringement that would apply equally well to trademark infringement suits: (1) the defense generally does not relate to the defendant; (2) use of the doctrine does not promote the goals of copyright law; (3) the standard

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<sup>75</sup> *Id.* at 61; *see also* Hetterman v. Powers, 43 S.W. 180 (Ky. 1897) (following *Cohn* and ruling in favor of Plaintiff Union in action to prevent wrongful use of the label by defendants); Perkins v. Heert, 53 N.E. 18 (N.Y. 1899) (finding same); Cigar Makers' Protective Union v. Lindner, 2 Ohio N.P. 114 (Ct. Com. Pl. Ohio 1895) (finding same).

<sup>76</sup> BROWNE, *supra* note 36, § 602.

<sup>77</sup> *Id.*

<sup>78</sup> *Id.*

<sup>79</sup> *Id.*

fluctuates; and (4) criminal laws sufficiently control moral behavior. First, where the plaintiff's wrongdoing does not relate to the defendant, an unclean hands defense will fail in a copyright infringement suit.<sup>80</sup> The Fifth Circuit expounded that "limiting copyright protection on a broad public injury rationale would lead to absurd and unacceptable results . . . [u]nless . . . limited . . . to misuses that frustrate the particular purposes of the copyright . . . statute . . . ."<sup>81</sup> "[T]he theory that a person can have no property in obscene works, merely expresses by means of a legal fiction the underlying judicial moral conclusion that the work is not worthy of protection."<sup>82</sup> The decision of the Fifth Circuit in upholding the rights of an obscene movie "suggests that . . . copyright may not be denied to a work because of its seditious or libelous content."<sup>83</sup>

Second, use of the doctrine does not promote the goals of copyright law.

[T]he constitutional purpose of [Congress's] copyright power . . . is best served by allowing all creative works (in a copyrightable format) to be accorded copyright protection regardless of subject matter or content, trusting to the public taste to reward creators of useful works and to deny creators of useless works any reward.<sup>84</sup>

Third, the Ninth Circuit explained that because the morality standard fluctuates on account of varying community standards for defining obscenity, a defense of unclean hands "would fragment copyright enforcement, protecting

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<sup>80</sup> *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852, 863 (5th Cir. 1979); see also Note, *Can Intellectual Property Laws Regulate Behavior? A "Modest Proposal" for Weakening Unclean Hands*, 113 HARV. L. REV. 1503 (2000) (arguing for the implication of compliance conditions in copyright and patent laws). But see *Devils Films, Inc. v. Nectar Video*, 29 F. Supp. 2d 174, 176–77 (S.D.N.Y. 1998) (refusing to protect obscene materials under copyright).

<sup>81</sup> *Mitchell Bros.*, 604 F.2d at 864. In copyright cases, the courts have extended this defense to deny a plaintiff legal remedy of damages. *Id.*; see also 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.09[B] (4th ed. 2007) (noting this position is the prevailing view). Although "[t]he doctrine of unclean hands is equitable in nature and would seemingly not bar recovery of damages for copyright infringement" the court went on to state that there is authority for applying the doctrine "to both legal and equitable relief." *Mitchell Bros.*, 604 F.2d at 865 n.26.

<sup>82</sup> *Mitchell Bros.*, 604 F.2d at 861; see also *Jartech, Inc. v. Clancy*, 666 F.2d 403, 406 (9th Cir. 1982) (following the rationale of *Mitchell Bros.* under the Copyright Act of 1976); *Belcher v. Tarbox*, 486 F.2d 1087, 1088 (9th Cir. 1973) (holding that "[t]here is nothing in the Copyright Act to suggest that the courts are to pass upon the truth or falsity, the soundness or unsoundness, of the views embodied in a copyrighted work" concerning copyrights of fraudulent materials).

<sup>83</sup> NIMMER, *supra* note 81, § 2.17.

<sup>84</sup> *Mitchell Bros.*, 604 F.2d at 855.

registered materials in a certain community, while, in effect, authorizing pirating in another locale.”<sup>85</sup>

Finally, denying protection to obscene works “would add little to the existing arsenal of weapons against pornography and would have many undesirable consequences.”<sup>86</sup>

The U.S. District Court for the Southern District of New York, however, took an opposite view in *Devils Films, Inc. v. Nectar Video*.<sup>87</sup> In this case, the court found the doctrine of unclean hands a viable defense against copyright infringement where the material was obscene and the plaintiff distributed pornographic films across state lines in violation of federal law.<sup>88</sup> The court stated that “[i]t strains credulity that Congress intended to extend the protection of the copyright law to contraband.”<sup>89</sup> Although phrased as against public policy, the court essentially, and inappropriately, denied its equitable powers because the plaintiffs dirtied their hands by claiming rights in obscene materials.<sup>90</sup> Despite this opposing view, the argument is weaker when applied to trademarks because the discussion on copyright revolves around material the Legislature has deemed illegal to transport across state lines, whereas the transportation of scandalous goods and marks is not illegal. On the other hand, where the Copyright Act is silent as to rejecting protection of obscene material, the Lanham Act includes the ban on registration of scandalous and immoral marks under section 2(a). Nonetheless, comparing the reasoning from the *Mitchell Brothers* line of cases to the trademark context suggests the Legislature should remove the restriction on registration of scandalous and immoral trademarks.

#### IV. APPLICATION OF *MITCHELL BROTHERS* TO SECTION 2(A) OF THE LANHAM ACT

Assuming section 2(a) evolved from the doctrine of unclean hands, nothing in the history of the law supports its expansion into non-disparaging, non-fraudulent marks; nor does a plaintiff’s use of a scandalous or immoral

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<sup>85</sup> *Jartech*, 666 F.2d at 406.

<sup>86</sup> *Mitchell Bros.*, 604 F.2d at 858 n.12.

<sup>87</sup> 29 F. Supp. 2d 174, 176–77 (S.D.N.Y. 1998).

<sup>88</sup> *Id.* at 175–76 (noting that other courts have not regarded fraudulent content as grounds for denying copyright protection).

<sup>89</sup> *Id.* at 176 (“Once a court has determined that copyrighted material is obscene, there seems no reason to require it to expend its resources on behalf of a plaintiff who it could as readily be trying for a violation of the federal criminal law.”).

<sup>90</sup> *Id.* at 176–77.

mark relate to the defendant. Moreover, application of the doctrine is irrelevant to the goals of trademark law, requires a fluctuating standard, and mistakenly considers the morals of the defendant. Furthermore, modern rationales no longer support banning scandalous and immoral marks.

### A. *History Does Not Support Banning Scandalous or Immoral Marks*

Trademark law evolved from consumers' needs to distinguish between manufacturers and manufacturers' needs to protect their businesses from frauds and free riders.<sup>91</sup> As evidenced by early case law and Congress' inclusion of trademarks in the 1870 revision to the Patent Act,<sup>92</sup> early scholars, legislators and judges considered trademarks intellectual property on par with copyrights and patents. In fact, the early acts and cases stated that trademark owners could use any word, symbol or mark so long as it identified the source of the product or service and was not obtained fraudulently or used to deceive the public.<sup>93</sup> Furthermore, all early treatises spoke only of the generally accepted denials of registration for fraudulent and deceitful marks, descriptive and geographical marks, and insignia, flags, and coats of arms of countries, states, and associations,<sup>94</sup> the one exception being Browne's treatise.<sup>95</sup>

Similarly, the case law prior to the 1905 Act conspicuously lacks any cases denying registration or protection of any immoral or scandalous marks. Instead, the courts used the doctrine of unclean hands and public policy to re-

<sup>91</sup> See *Amoskeag Mfg. Co. v. D. Trainer & Sons*, 101 U.S. 51, 53–54 (1879); MCCARTHY, *supra* note 9, §§ 2:8–2:9.

<sup>92</sup> Act of July 8, 1870, ch. 230, § 77, 16 Stat. 198, 217 (“[A]ny person or firm . . . who are entitled to the exclusive use of any lawful trade-mark . . . may obtain protection for such lawful trade-mark . . .”). Section 84 of this Act denied remedy to any party who used a trademark in any unlawful business, injurious article, fraudulently obtained trademark, or designed to deceive the public in purchase or use of any article of merchandise.

<sup>93</sup> See, e.g., *Clinton E. Worden & Co. v. Cal. Fig Syrup Co.*, 187 U.S. 516, 528 (1903) (denying plaintiff a right of remedy because trademark of ‘syrup of figs’ as a laxative when not an active ingredient was plainly deceptive and a fraud on the public); *Cal. Fig Syrup Co. v. Frederick Stearns & Co.*, 73 F. 812, 816–17 (6th Cir. 1896); *Petrolia Mfg. Co. v. Bell & Bogart Soap Co.*, 97 F. 781, 784 (S.D.N.Y. 1899); *Hennessy v. Wheeler*, 69 N.Y. 271 (1877); HOPKINS, *supra* note 35 §§ 36–39, 130–31, 191–92; 1 HARRY D. NIMS, *THE LAW OF UNFAIR COMPETITION AND TRADE-MARKS*, § 196 (4th ed. 1947); UPTON, *supra* note 11, at 202–46.

<sup>94</sup> See HOPKINS, *supra* note 35, §§ 36–39, 130–31, 191–92, app. E; NIMS, *supra* note 93, §§ 196, 200–210, 231; UPTON, *supra* note 11, at 202–46.

<sup>95</sup> See BROWNE, *supra* note 36, § 602.

strict fraud, deceit, and outright attacks on other manufacturers.<sup>96</sup> Moreover, the majority of cases used the unclean hands doctrine in connection with marks that deceived the public with false claims of manufacture or origin or infringing trademarks. In short, the courts did not ground their use of the unclean hands doctrine in the scandalous or immoral qualities of a mark.<sup>97</sup>

### **B. Section 2(a) Is Irrelevant to the Goals of Trademark Law**

The main purpose of a trademark is to build the goodwill of a business by promoting a consistent product and preventing customer confusion.<sup>98</sup> The main purposes of trademark law are to prevent unfair competition and to protect customers from mistake and deception.<sup>99</sup> The Lanham Act, therefore, should interpret marks broadly and generally protect any mark that can successfully act as a source identifier. Most people would agree that a scandalous or immoral mark could sufficiently act as a source identifier. Therefore, a ban on registration of scandalous or immoral marks must be for some other policy reason.

Scholars and courts have suggested two main policy reasons for banning registration of scandalous or immoral trademarks. First, the federal government should not waste its time and money on scandalous or immoral marks.<sup>100</sup> Second, the federal government should not create the appearance of approving the use of scandalous or immoral marks.<sup>101</sup>

As to the first, the public no longer funds the PTO. Today, the PTO is user-funded.<sup>102</sup> Moreover, the government possibly spends more time and

<sup>96</sup> See HOPKINS, *supra* note 35, §§ 36–39, 130–31, 191–92; NIMS, *supra* note 93, §§ 196, 231; UPTON, *supra* note 11, ch. 5.

<sup>97</sup> See, e.g., *Worden*, 187 U.S. at 528; *Cal. Fig Syrup Co.*, 73 F. at 816–17; *Petrolia*, 97 F. at 782 (protecting the mark COAL OIL JOHNNY where petroleum was used in the product); *Fetridge v. Wells*, 13 How. Pr. 385 (N.Y. 1857) (denying protection of the mark BALM OF A THOUSAND FLOWERS on hand soap because the soap was not a medicine); *Palmer v. Harris*, 60 Pa. 156 (1869) (denying protection for a cigar manufacturer who claimed cigars were made in Havana, but actually were made in New York).

<sup>98</sup> See Landes & Posner, *supra* note 8, at 268; MCCARTHY, *supra* note 9, §§ 2:1-2:14.

<sup>99</sup> MCCARTHY, *supra* note 9, §§ 2:7-2:9.

<sup>100</sup> *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981) (“We do not see this as an attempt to legislate morality, but, rather, a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government.”); Baird, *supra* note 6, at 788; Davis, Jr., *supra* note 39, at 831–37; Reiter, *supra* note 10, at 199.

<sup>101</sup> See *McGinley*, 660 F.2d at 483; Abdel-Khalik, *supra* note 30, at 211–12; Baird, *supra* note 6, at 788; Reiter, *supra* note 10, at 200.

<sup>102</sup> Omnibus Budget Reconciliation Act of 1990 § 10101, Pub. L. No. 101-508, 104 Stat. 1388, 1391; see also Davis, Jr., *supra* note 39, at 832–33.

money defending its position against scandalous marks than it does granting registration.<sup>103</sup> Countering the second claim, the Lanham Act is not a public health, welfare or moral law. The main argument is that trademark owners place their marks in commerce for all to see, whereas in the copyright context a consumer would have the option of opening the book or playing the movie rather than being faced directly with the offending trademark. Yet, retailers have found simple ways to avoid such offenses in the copyright arena. For example, retailers often cover adult magazines that are in full view of the public or hide the product behind curtains. Retailers also lock condoms and cigarettes behind doors. Additionally, “the issuance of a registration does not indicate any endorsement of the goods on which the mark is used, [and] it also does not imply the government’s pronouncement that the mark is a good one, from an aesthetic or any other viewpoint.”<sup>104</sup> The argument that registration would indicate government approval is hypocritical because the Copyright Office grants copyrights to obscene material, which is a step beyond scandalous or immoral marks.<sup>105</sup>

Denial of registration should be a direct result of unfair competition and source identification—the underlying principles of trademark law. For example, the government denies generic marks registration because

no matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.<sup>106</sup>

No such policy consideration is at issue with scandalous or immoral marks. These marks adequately identify the source of the product at issue without denying competitors’ competition or confusing consumers in their search for products.

### C. *The Moral Worth of the Plaintiff Is Not at Issue*

While it is true that the government should promote public health, welfare and morals,<sup>107</sup> harm to the public interest by itself is generally insufficient to invoke the unclean hands doctrine and deny a plaintiff the equitable powers of

<sup>103</sup> Abdel-khalik, *supra* note 30, at 212–13.

<sup>104</sup> Ritchie v. Simpson, 41 U.S.P.Q.2d (BNA) 1859 (T.T.A.B. 1997), *rev’d on other grounds*, 170 F.3d 1092 (Fed. Cir. 1999).

<sup>105</sup> See Mitchell Bros. Film Group v. Cinema Adult Theater, 604 F.2d 852, 863 (5th Cir. 1979).

<sup>106</sup> Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976).

<sup>107</sup> Baird, *supra* note 6, at 788.

the court.<sup>108</sup> The purpose of trademark law is to prevent consumer confusion and build business goodwill.<sup>109</sup> At this, a scandalous or immoral mark could succeed. As in the copyright context, “the infringers’ attempt to immunize their illegal acts by wrapping themselves in the mantle of a ‘public injury’ caused by plaintiffs is antithetical to the purpose of these laws.”<sup>110</sup>

In the copyright context, the courts found that the moral worth of the plaintiff does not concern the copyright goals of promoting creativity.<sup>111</sup> Similarly, a court should not dismiss a company’s private trademark infringement suit because it uses a scandalous or immoral mark. Such dismissal would have no bearing on the mark’s ability to act as a source identifier or the resulting goodwill associated with the mark. For example, unless a plaintiff’s trademark caused harm to the defendant, such as a direct assault on the defendant’s business acumen,<sup>112</sup> a scandalous or immoral mark should not defeat the claim. The only issue before the court should be whether the defendant company has infringed the mark and caused consumer confusion.

Furthermore, denial of registration by the PTO should also be irrelevant because a scandalous or immoral trademark does not create a fraud on the public; nor are such trademarks always attached to contraband as are obscene materials in a copyright context.<sup>113</sup> The clause attempts to protect societal morals through a doctrine designed to protect the economics of businesses; such goals are better achieved through a criminal statute aimed at protecting society, not through trademark law.<sup>114</sup>

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<sup>108</sup> See *McCormick v. Cohn*, No. CV 90-0323 H, 1992 WL 687291, at \*4 (S.D. Cal. July 31, 1992). The doctrine, however, is not applied where plaintiff’s misconduct is not directly related to the merits of the controversy between the parties, but only where the wrongful acts “in some measure affect the equitable relations between the parties in respect of something brought before the court for adjudication.” *Keystone Driller Co. v. Gen. Excavator Co.*, 290 U.S. 240, 245 (1933).

<sup>109</sup> See *Landes & Posner*, *supra* note 8, at 268; *McCarthy*, *supra* note 9, at §§ 2:1-2:14.

<sup>110</sup> *Mitchell Bros.*, 604 F.2d at 865.

<sup>111</sup> *Id.* at 861–62 (“[E]quitable doctrines should not be applied where their application will defeat the purpose of a statute.”).

<sup>112</sup> This would be a disparaging mark rather than a scandalous or immoral one. See, e.g., *McVey v. Brendel*, 22 A. 912, 914 (Pa. 1891); *Baird*, *supra* note 6, at 730–40.

<sup>113</sup> For example, purses are certainly not contraband, yet the mark BULLSHIT was denied registration as a trademark on purses. *In re Tinseltown, Inc.*, 212 U.S.P.Q. (BNA) 863 (T.T.A.B. 1981).

<sup>114</sup> A criminal law against speech that is less than obscene would likely conflict with the First Amendment. See *Miller v. California*, 413 U.S. 15 (1973).

### D. *The Difficulty in Applying a Fluctuating Morality Standard*

Although the community standard for obscenity likely fluctuates more than the general public standard for trademarks, determining what constitutes an immoral or scandalous mark is a difficult task that results in disparate treatment.<sup>115</sup> Whether a trademark comprises scandalous matter depends on “the standpoint of not necessarily a majority, but a substantial composite of the general public”<sup>116</sup> and “in the context of contemporary attitudes.”<sup>117</sup> The changing mores of society are clear when viewing the past decisions of the PTO.<sup>118</sup> “Today’s scandal can be tomorrow’s vogue. Proof abounds in nearly every quarter, with the news and entertainment media today vividly portraying degrees of violence and sexual activity that, while popular today, would have left the average audience of a generation ago aghast.”<sup>119</sup>

<sup>115</sup> See Baird, *supra* note 6, at 677–82; Robert H. Wright, *Today’s Scandal Can Be Tomorrow’s Vogue: Why Section 2(a) of the Lanham Act Is Unconstitutionally Void for Vagueness*, 48 How. L.J. 659, 676–81 (2005).

<sup>116</sup> *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981).

<sup>117</sup> *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1219 (T.T.A.B. 1993).

<sup>118</sup> Compare *id.* (finding “OLD GLORY CONDOM CORP” with stars and stripes design on condoms suggesting the American flag not scandalous), *In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d (BNA) 1653 (T.T.A.B. 1990) (finding “MOONIES” on dolls, whose pants can be dropped to expose their buttocks not scandalous), *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470 (T.T.A.B. 1988) (finding “BIG PECKER BRAND” on T-shirts not scandalous), *In re Leo Quan Inc.*, 200 U.S.P.Q. (BNA) 370 (T.T.A.B. 1978) (finding “BADASS” for bridges of stringed musical instruments not scandalous), *In re Madsen*, 180 U.S.P.Q. (BNA) 334 (T.T.A.B. 1973) (finding “WEEK-END SEX” on magazines not scandalous), *In re Hepperle*, 175 U.S.P.Q. (BNA) 512 (T.T.A.B. 1972) (finding “ACAPULCO GOLD” on suntan lotion not scandalous), and *Ex parte Parfum L’Orle, Inc.*, 93 U.S.P.Q. (BNA) 481 (Pat. Off. Exam’r-in-Chief 1952) (finding “LIBIDO” on perfumes not scandalous), with *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938) (finding “MADONNA” on wine scandalous), *In re Tinseltown, Inc.*, 212 U.S.P.Q. (BNA) 863 (T.T.A.B. 1981) (finding “BULLSHIT” on personal accessories scandalous), *In re Runsdorf*, 171 U.S.P.Q. (BNA) 443 (T.T.A.B. 1971) (finding “BUBBY TRAP” for brassieres scandalous), *In re Sociedade Agricola E. Comercial Dos Vinhos Messias, S.A.R.L.*, 159 U.S.P.Q. (BNA) 275 (T.T.A.B. 1968) (finding “MESSIAS” on wine and brandy scandalous), *In re Reemtsma Cigarettenfabriken GmbH*, 122 U.S.P.Q. (BNA) 339 (T.T.A.B. 1959) (finding “SENUSSI” on cigarettes scandalous), *In re P.J. Valkenberg, GmbH*, 122 U.S.P.Q. (BNA) 334 (finding “MADONNA” on wine scandalous), *Ex parte Summit Brass & Bronze Works, Inc.*, 59 U.S.P.Q. (BNA) 22 (T.T.A.B. 1943) (finding “AGNUS DEI” on metallic tabernacle safes *per se* scandalous), and *Ex parte Martha Maid Mfg. Co.*, 37 U.S.P.Q. (BNA) 156 (Comm’r Pats. 1938) (finding “QUEEN MARY” on women’s underwear scandalous).

<sup>119</sup> *In re Mavety Media Group*, 33 F.3d 1367, 1371 (Fed. Cir. 1994) (reversing the Examiner’s denial of registration to the mark “BLACK TAIL” to adult magazines).

The courts have raised this difficulty as a reason for protecting obscene films under copyright.<sup>120</sup> Although the copyright standard is arguably more disparate because it depends on a local standard of morality,<sup>121</sup> the trademark standard of a substantial composite of the general public<sup>122</sup> also creates great difficulty, as evidenced by past cases.

### 1. Past Cases Illustrate the Problems of a Fluctuating Standard

As discussed earlier, the PTO registered the mark “DOUGHBOY” for prophylactics in 1923, but then changed its decision in 1951.<sup>123</sup> Similarly, the courts repeatedly denied registration to the mark “MADONNA” on wine, while registering the same mark on non-alcoholic goods.<sup>124</sup> Today the mark is widely recognized as a pop musician renowned for sexual innuendos, who, coincidentally, has recently released her own wine label.<sup>125</sup> As further examples, the PTO denied registration of the marks “BULLSHIT” for purses and “SHITHEAD” for paperweights, but granted registration for clothing lines marked “BADASS,” “BUTTHEAD” and “S.C.R.E.W. ACTIVE WEAR.”<sup>126</sup> These examples regard simple, straightforward marks. The review process for scandalous marks becomes more difficult when the marks are more complex.

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<sup>120</sup> Mitchell Bros. Film Group v. Cinema Adult Theater, 604 F.2d 852, 857 (5th Cir. 1979).

<sup>121</sup> *Id.* at 858 n.11.

<sup>122</sup> *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) at 1219; *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981).

<sup>123</sup> *Doughboy Indus., Inc. v. Reese Chem. Co.*, 88 U.S.P.Q. (BNA) 227 (Pat. Office Exam'r-in-Chief 1951).

<sup>124</sup> *Compare In re Riverbank Canning Co.*, 95 F.2d 327, 329 (C.C.P.A. 1938), and *In re P.J. Valckenberg, GmbH*, 122 U.S.P.Q. 334 (T.T.B.A. 1959), with *In re Riverbank Canning*, 95 F.2d at 330 (Jackson, J., dissenting) (noting the mark “has been registered numerous times, as applied to different articles of trade”).

<sup>125</sup> Madonna Store, Madonna Wine Collection, <http://www.madonna.com/store/wine.php> (last visited Oct. 15, 2007); see also Baird, *supra* note 6, at 709.

<sup>126</sup> *In re Tinseltown, Inc.*, 212 U.S.P.Q. (BNA) 863, 866 (T.T.A.B. 1981) (rejecting “BULLSHIT”); U.S. Trademark App. Ser. No. 73/824,044 (“SHITHEAD” abandoned); U.S. Trademark No. 3,056,366 (“BADASS”); U.S. Trademark No. 1,962,497 (“S.C.R.E.W. ACTIVE WEAR”); U.S. Trademark No. 1,563,298 (“BUTTHEAD”).

## 2. The Added Discrepancy of Double Entendre and Innuendo

Adding to the confusion is allowance of registration for marks with double entendre or alternate meaning,<sup>127</sup> but denial of registration for marks with innuendo.<sup>128</sup> If a mark insinuates an offensive or shocking message, the PTO will reject registration.<sup>129</sup> However, the PTO permitted the registration of the mark “BIG PECKER BRAND” on T-shirts despite the slang term of “pecker” meaning penis.<sup>130</sup> The appeal board emphasized that this slang definition was the third cited definition in the dictionary.<sup>131</sup> Phrases that require less imagination, but still have alternate meanings, may also be permitted. For instance, the registrations were allowed for the mark “LIBIDO” when used on perfume because it was capable of a more general meaning,<sup>132</sup> and “BLACK TAIL” for an adult magazine filled with pictures of African-American woman.<sup>133</sup> Thus, beyond the difficulty in applying a fluctuating morality standard, marks may be granted or refused registration based on double entendre, innuendo or alternate meanings.

### E. *There Is No Criminal Law Prohibiting Use of Scandalous or Immoral Marks*

Although the Lanham Act specifically bans the registration of scandalous and immoral marks, it does not prevent their use in commerce. This differentiates trademark from copyright, where the court has stated that the added penalty to a “copyright which complies with every provision of the copyright act . . . is justifiable only if there is a serious need for extra pressure to induce

<sup>127</sup> *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470, 1472 (T.T.A.B. 1988).

<sup>128</sup> *See In re McGinley*, 660 F.2d (BNA) 481, 485 (C.C.P.A. 1981).

<sup>129</sup> *See id.*

<sup>130</sup> *In re Hershey*, 6 U.S.P.Q.2d (BNA) at 1472.

<sup>131</sup> *Id.* Yet the PTO denied the registration of MADONNA despite the definition of Virgin Mary being second. *See In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938) (“The word ‘Madonna’ is defined in Funk & Wagnalls New Standard Dictionary as follows: ‘1. My lady; signora: an old Italian form of address equivalent to madam. 2. (M-) hence, the Virgin Mary; also, a painted or sculptured representation of the Virgin.’”).

<sup>132</sup> *Ex parte Parfum L’Orle, Inc.*, 93 U.S.P.Q. (BNA) 481, 482 (Pat. Off. Exam’r-in-Chief 1952) (distinguishing the decisions on QUEEN MARY, MADONNA, and DOUGHBOY as marks of names of important, religious, and national persons or groups).

<sup>133</sup> *In re Mavety Media Group, Ltd.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994).

obedience to the criminal law.”<sup>134</sup> In the context of *Mitchell Brothers*, several federal laws prohibited the distribution of obscene materials.<sup>135</sup> The court, however, found that these crimes did “not indicate that Congress intend[ed] obscene material to be uncopyrightable.”<sup>136</sup> More importantly, the court stated that denying copyright protection to obscene materials would do little to prevent their production considering the existing penal statutes.<sup>137</sup> Thus, no extra pressure is needed to induce obedience to the law in relation to scandalous or immoral marks because no law prohibits their use. If Congress finds that the public requires further protection, it can enact criminal laws to prohibit use of scandalous and immoral marks in interstate commerce just as it has with obscenity.<sup>138</sup>

## V. CONCLUSION

In the end, nothing prevents producers from using offensive marks without the benefits of federal trademark protection. Consider the early applications for the mark “MADONNA.” The PTO denied registration of the mark in 1938, and again in 1959.<sup>139</sup> Despite these bans on registration, the producer used the mark consistently for over twenty years. Thus, the denial of registration did not prevent use of the mark or protect the public; more importantly, neither did it protect the producer from unfair competition or the consumer from confusion.

Because the clause fails to promote the primary goals of trademark law, and also fails to properly invoke the doctrine of unclean hands, the Legislature should redact section 2(a) from the Lanham Act and let the marketplace determine which marks survive. There is no longer any need or reasonable policy for maintaining the ban. A producer’s desire for profits and the consumer’s discretion and purchasing power is more than sufficient to keep scandalous and immoral marks from staying on the market.

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<sup>134</sup> *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852, 862 (5th Cir. 1979) (“In the obscenity situation, this need is not obvious.”).

<sup>135</sup> *Id.* at 858 n.12 (citing 18 U.S.C. §§ 1461, 1462, 1465 (2006) (making it a crime to mail or ship obscene material)).

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

<sup>137</sup> *Id.*

<sup>138</sup> Of course, this would create an even larger conflict with the First Amendment. See, e.g., Baird, *supra* note 6, at 677–702; Reiter, *supra* note 10, at 197–203.

<sup>139</sup> *In re P.J. Valckenberg, GmbH*, 122 U.S.P.Q. (BNA) 334, 334–35 (1959); *In re Riverbank Canning Co.*, 95 F.2d 327, 329 (C.C.P.A. 1938).