

ARTICLES

TERRIFYING TRADEMARKS AND A SCANDALOUS DISREGARD FOR THE FIRST AMENDMENT: SECTION 2(A)'S UNCONSTITUTIONAL PROHIBITION ON SCANDALOUS, IMMORAL, AND DISPARAGING TRADEMARKS

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I. INTRODUCTION

It is uncontroversial to hold that speech is more than mere words. Speech is images, iconography, logos, and illustrations. Speech is wearing black armbands in school to protest a war,¹ or burning an American flag to demonstrate against public policy.² Speech can offend.³ One needs look no further than the reaction to cartoonists by religious fundamentalists: the offense of cartoons can be so deep that it moves individuals to commit murder.⁴

When that speech is undertaken as part of commerce it does not magically lose any political, social or religious dimension it had when in a non-commercial context.⁵ Cartoons issued bearing the image of the Prophet as part of a commercial magazine are surely a political statement deserving of protection. The situation is the same if an organization adopts a logo that is derisive to a particular political or religious ideology – that publication is making a protected, expressive statement through its branding.

However, when it comes to obtaining a trademark on such a brand, speech receives significantly less protection than it does in other areas of law. The ongoing efforts to cancel the Redskins' trademark are illustrative of the struggle a registrant of a controversial mark faces in light of lesser constitutional protections.⁶ First used by the football club in 1933,⁷ the

¹ *Tinker v. Des Moines Indep. Cmty. Sch. Dist.*, 393 U.S. 503, 514 (1969).

² *United States v. Eichman*, 496 U.S. 310, 318–19 (1990); *Texas v. Johnson*, 491 U.S. 397, 419–20 (1989).

³ *Snyder v. Phelps*, 131 S. Ct. 1207, 1220 (2011).

⁴ Dan Bilefsky & Maïa de la Baume, *Terrorists Strike Charlie Hebdo Newspaper in Paris, Leaving 12 Dead*, N.Y. TIMES, Jan. 7, 2015, http://www.nytimes.com/2015/01/08/world/europe/charlie-hebdo-paris-shooting.html?_r=0.

⁵ See discussion *infra* Part III.C.

⁶ See Theresa Vargas, *Federal Agency Cancels Redskins Trademark Registration, Says Name is Disparaging*, WASH. POST, June 18, 2014, http://www.washingtonpost.com/local/us-patent-office-cancels-redskins-trademark-registration-says-name-is-disparaging/2014/06/18/e7737bb8-f6ee-11e3-8aa9-dad2ec039789_story.html (examining the Washington Redskins' trademark registration constraints).

Redskins have undergone multiple challenges to the use of their mark since 1992.⁸ The Redskins enjoyed initial success by relying upon a laches defense: the challengers had simply waited too long to challenge the controversial mark.⁹ However, in June 2014, the Trademark Trial and Appeal Board (TTAB) decided that this defense no longer applied.¹⁰ In order to prove that their mark was not disparaging, the Redskins were forced to undergo a historical and cultural analysis in order to determine the extent of the mark's offensiveness.¹¹

Losing that argument,¹² the Redskins turned to a last ditch effort: argue that the First Amendment really can protect offensive speech, even in the context of the Lanham Act.¹³ I call it a last ditch effort because, even though Pro Football rightly argues that the Lanham Act attempts to unconstitutionally regulate the substantive content of speech,¹⁴ and that it also burdens disfavored speech that is nonetheless protected under the jurisprudence of the Supreme Court,¹⁵ the Federal Circuit has to date not seemed at all concerned with the First Amendment implications of the Lanham Act.

Section 2(a) of the Lanham Act – the federal statute governing

⁷ Alicia Jessop, *Inside the Legal Fight to Change the Washington Redskins' Name*, FORBES (Oct. 15, 2013, 8:34 PM), <http://www.forbes.com/sites/aliciajessop/2013/10/15/a-look-at-the-legal-fight-to-change-the-washington-redskins-name/>.

⁸ *Id.*

⁹ *Id.*

¹⁰ Mason Levinson & Susan Decker, *Redskins' 'Disparaging' Trademark Canceled by Patent Office*, BLOOMBERGBUSINESS (June 18, 2014, 1:29 PM), <http://www.bloomberg.com/news/articles/2014-06-18/redskins-trademark-is-canceled-by-patent-office-as-disparaging->.

¹¹ See Ken Motolenich-Salas, *The Four Quarters of the Redskins Trademark Cancellations: The Revival of the Disparagement Doctrine*, 51-OCT ARIZ. ATT'Y 20, 22 (2014) (“[T]he TTAB relied on two categories of evidence: (i) general analysis of the word and (ii) the specific views of Native Americans at the time of registration.”).

¹² See *id.* (“[T]he TTAB found that . . . approximately 30 percent of Native Americans . . . found the term ‘redskins’ to be disparaging at all times, . . . which warranted cancellation on the grounds of disparagement . . .”).

¹³ See generally Pro-Football, Inc.'s Memorandum of Law in Support of its Motion for Summary Judgment on Constitutional Claims III–IV at 5–17, Pro-Football, Inc. v. Blackhorse, No. 1:14-cv-1043-GBL-IDD (E.D. Va. Feb. 23, 2015), available at <http://www.scribd.com/doc/256912560/NFL-v-Blackhorse-The-Redskins-Brief>.

¹⁴ *Id.* at 5–6.

¹⁵ *Id.* at 7–8.

the registration of trademarks – places a prohibition on the registration of “scandalous,” “immoral” or “disparaging” marks.¹⁶ In support of this prohibition, the Patent and Trademark Office (PTO), together with the TTAB and the Federal Circuit, have characterized the benefit granted by the Lanham Act as merely “procedural” and not “substantive.”¹⁷ Further, by preventing registration of “immoral” or “disparaging” marks, the Federal Circuit believes that there is no actual harm suffered – said registrant remains free to utilize the mark in commerce, albeit without the protection of federal law.¹⁸

However, this position propounded by the TTAB and reinforced by the Federal Circuit misses a very important dimension of the issue. The Lanham Act essentially creates a federally backed market in trademarks – one in which nonparticipants can be severely penalized by being unable to effectively compete on the national stage. To have an unprotected mark, one that any other entity is free to exercise as part of its commercial or noncommercial presence, can mean a total lack of identity.¹⁹ Further, the Lanham Act grants a number of benefits, discussed below, that taken together create a significant basis for investment on the part of individuals.²⁰ Thus, to be denied federal registration of a trademark is not so insignificant a thing as the Federal Circuit would have us believe. Surely the denied registrants can continue to “speak,” but their voice is significantly muffled.²¹

This article argues that the practice of silencing “immoral,” “scandalous,” and “disparaging” trademarks is unconstitutional, from at least two perspectives. First, the Unconstitutional Conditions Doctrine prevents the Lanham Act from discriminating against “immoral” or “disparaging” trademarks.

¹⁶ See Lanham Act, Pub. L. No. 79-489, § 2(a), 60 Stat. 427, 428 (1946) (codified as amended at 15 U.S.C. § 1052(a) (2012)).

¹⁷ See, e.g., *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981).

¹⁸ See *id.* at 486 (discussing Congress’ intent that unregistered “scandalous” marks do not have the same benefits as registered ones).

¹⁹ See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992) (“Protection of trade dress, no less than of trademarks, serves the [Lanham] Act’s purpose to ‘secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.’”).

²⁰ See *infra* notes 29–38 and accompanying text.

²¹ Cf. *McGinley*, 660 F.2d at 484 (holding that an applicant’s “First Amendment rights would not be abridged by the refusal to register his mark”).

In essence, since trademarks constitute “intertwined speech” – that is an inextricable mixture of commercial and noncommercial speech – Congress’s limitation of that speech as a condition for the benefit of federal registration is unconstitutional.²² Second, trademarks may constitute a public forum such that the government would be restricted from viewpoint discrimination.²³

Part II of this article offers a brief overview of trademark law and the Lanham Act. Part III introduces the Unconstitutional Conditions Doctrine and presents a test from that body of law that should be applied to § 2. Part III also analyzes the ways that the First Amendment and the Unconstitutional Conditions Doctrine may provide protection for marks otherwise prohibited under § 2(a) of the Lanham Act. Part IV considers the possibility that trademarks may constitute a limited public forum in such a way that the government would be prevented from viewpoint discrimination against registrants. Part V concludes by synthesizing the law presented and demonstrating that the Lanham Act faces a very serious constitutional problem.

II. TRADEMARKS: SCANDALOUS DISPARAGEMENT

Under state common law, state statutory law, and federal statutory law, a trademark is a symbol, word, or other similar device used “to identify and distinguish” the goods or services of one seller from the goods or services of others.²⁴ In order to be legally protected as a trademark, a symbol must be distinctive.²⁵ That is, the symbol must be capable of serving the function of distinguishing the source of one product from another.²⁶ A trademark must also be more than merely descriptive of some attribute of the product and cannot be a fully generic term for the product.²⁷

The Lanham Act, 15 U.S.C. § 1051, et seq., was passed by Congress in 1946 in order to create a uniform federal trademark law.²⁸ Among the various benefits that the Lanham Act bestows

²² See discussion *infra* Part III.D.

²³ See discussion *infra* Part IV.

²⁴ J. THOMAS MCCARTHY, 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3:1 (4th ed. 2015).

²⁵ *Id.*

²⁶ *Id.*

²⁷ See *id.* (stating the essential elements for trademark qualification).

²⁸ See Patrick E. Boland, *Wrongful Assault on the Trademark System*, 1987 COLUM. BUS. L. REV. 153, 156–57 (1987) (discussing the lack of uniformity in

upon the holders of federally registered trademarks, a trademark owner is permitted to enter his mark into evidence and to use it as prima facie evidence of validity.²⁹ Further, a federally registered mark that complies with the requirements of § 1065 may be incontestable.³⁰ Additionally, the Lanham Act also provides certain rights, such as constructive nationwide use as of the filing date of a registration application,³¹ and certain federal remedies, such as attorneys' fees otherwise unavailable for common law trademarks.³²

Particularly for businesses that operate in a multitude of jurisdictions, the federally recognized registration of their trademarks provides an efficient venue for the vindication of their rights.³³ For instance, trademark owners may bring suits in federal court in order to enforce their rights.³⁴ Federally registered marks are also listed in the Trademark Registrar's databases and the Official Gazette,³⁵ and are thus publicly visible across the entire country and the world.³⁶ Trademark owners may also use their United States registrations as the basis to obtain registration in foreign countries,³⁷ and can use their

federal trademark law sought to be remedied by the Lanham Act).

²⁹ Lanham Act, Pub. L. No. 79-489, § 33, 60 Stat. 427, 438–39 (1946) (codified as amended at 15 U.S.C. § 1115 (2012)).

³⁰ *Id.* § 15, 60 Stat. at 433–34 (codified as amended at 15 U.S.C. § 1065 (2012)).

³¹ *Id.* § 22, 60 Stat. at 435 (codified as amended at 15 U.S.C. § 1072 (2012)).

³² *Id.* § 35, 60 Stat. at 439–40 (codified as amended at 15 U.S.C. § 1117 (2012)).

³³ *See id.* § 21, 60 Stat. at 435 (codified as amended at 15 U.S.C. § 1071 (2012)) (allowing those with registered trademarks to bring appeals before the United States Court of Appeals for the Federal Circuit).

³⁴ *Id.*

³⁵ *Id.* § 12, 60 Stat. at 432 (codified as amended at 15 U.S.C. § 1062 (2012)).

³⁶ *See Trademark Official Gazette (TMOG)*, U.S. PAT. & TRADEMARK OFF., <http://www.uspto.gov/learning-and-resources/official-gazette/trademark-official-gazette-tmog> (last visited Apr. 25, 2015) (explaining that the Trademark Official Gazette is published weekly, containing bibliographic information regarding each published trademark as well as a list of cancelled and renewed registrations); *See All Trademark Data is Public*, U.S. PAT. & TRADEMARK OFF., <http://www.uspto.gov/trademarks-application-process/filing-online/all-trademark-data-public> (last visited Apr. 25, 2015) (indicating that all information submitted to the USPTO during the trademark registration process is made publically viewable).

³⁷ *Trademark FAQs: Why Should I Obtain a Trademark?*, U.S. PAT. & TRADEMARK OFF., <http://www.uspto.gov/learning-and-resources/trademark-faqs> (last visited Apr. 25, 2015).

registration to record with the Customs and Border Protection Service to prevent the importation of foreign goods that infringe on their mark.³⁸

In order to be registrable, a trademark must be used in or be intended for use in commerce.³⁹ For the purposes of the Lanham Act, a trademark is used in commerce when, in connection with a good or service, it is used as part of an organization's "ordinary course of trade."⁴⁰ In the case of goods, the trademark must be on the containers, tags, labels, or other relevant documents related to the good.⁴¹ For services, a mark is used in commerce when it is:

[U]sed or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.⁴²

A sufficiently distinct symbol is federally registrable as a trademark for goods or services subject to a handful of exceptions set forth in § 2 of the Lanham Act.⁴³ This article is interested in the § 2(a) prohibitions on marks that are either "immoral . . . or scandalous matter," (the "scandalous" prohibition) or else "matter[s] which may disparage or falsely suggest a connection

³⁸ Lanham Act § 42, 60 Stat. at 440–41 (codified as amended at 15 U.S.C. § 1124 (2012)).

³⁹ The authority to regulate trademarks under the Lanham Act is based on and co-extensive with congress's power to regulate commerce. *See* S. REP. NO. 102-280, at 7–8 (1992) (explaining that with regard to S. 759, facilitating equal access to Federal and State forums for trademark plaintiffs, is justified under the Commerce Clause). "Commerce" means all commerce that Congress is entitled to regulate under the Constitution. Lanham Act § 45, 60 Stat. at 443 (codified as amended at 15 U.S.C. § 1127 (2012)). The Lanham Act is the inheritor of the 1905 Trademark Act, which was itself passed under the full extent of the Commerce Clause in order to avoid being declared unconstitutional, as its predecessor had been so declared. *See* Trade-Mark Cases, 100 U.S. 82, 96–98 (1879) (explaining that intrastate commerce is not subject to Congressional control, and that laws set forth by Congress regulating commerce are typically clearly meant to regulate commerce other than intrastate commerce; where they are not, they are in excess of Congress' power, and indicating that the Trademark law in question appeared to be in excess of Congress' Commerce Clause powers).

⁴⁰ Lanham Act § 45, 60 Stat. at 444 (codified as amended at 15 U.S.C. § 1127 (2012)).

⁴¹ *Id.*

⁴² *Id.*

⁴³ *See id.* § 2, 60 Stat. at 428–29 (codified as amended at 15 U.S.C. § 1052 (2012)) (providing exceptions).

with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute” (the “disparaging” prohibition).⁴⁴

Before presenting a full analysis of the PTO’s and Federal Circuit’s approach to the scandalous prohibition and the disparaging prohibition, this article presents some initial remarks about the Lanham Act’s historical context with respect to the Supreme Court’s First Amendment jurisprudence.

The passage of the Lanham Act in 1946 predates much of modern First Amendment jurisprudence.⁴⁵ Two Supreme Court cases decided not long before 1946 demonstrate commonly accepted limitations on freedom of speech that may have influenced the legal presumptions at the time of the Lanham Act’s drafting.⁴⁶

For instance, as late as 1931, there was a serious split in the court as to whether it was constitutional to suppress scandalous speech.⁴⁷ *Near v. Minnesota ex rel. Olsen* involved a Minnesota law that classified “malicious, scandalous and defamatory” newspapers or other periodicals as public nuisances.⁴⁸ Once so classified, the law allowed for the periodical to be enjoined.⁴⁹

At issue in the case was a publication of the Saturday Press, in which it was alleged that the Chief of Police in Minneapolis was corruptly working with or influenced by a prominent “Jewish gangster” who ran racketeering, gambling, and other illicit

⁴⁴ Lanham Act § 2(a), 60 Stat. at 428 (codified as amended at 15 U.S.C. § 1052(a) (2012)).

⁴⁵ *See, e.g., Miller v. California*, 413 U.S. 15, 24 (1973) (setting forth the factors to be used in determining whether a statute designed to regulate obscene materials is sufficiently limited); *Brandenburg v. Ohio*, 395 U.S. 444, 447–48 (1969) (holding that statutes which fail to draw a distinction between punishing abstract teaching of using force and violence and punishing the preparation of a group for violent action is a violation of the constitutional guarantees of free speech).

⁴⁶ *See generally Valentine v. Chrestensen*, 316 U.S. 52 (1942) (deciding whether an ordinance forbidding distribution of commercial advertising in the streets was an unconstitutional limitation of the freedom of the press and speech), *overruled by Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748 (1976); *Near v. Minnesota*, 283 U.S. 697 (1931) (discussing the constitutionality of a Minnesota law deeming scandalous newspapers a public nuisance).

⁴⁷ *See Near*, 283 U.S. at 723 (5-4 decision) (Butler, J., dissenting).

⁴⁸ *Id.* at 701–02 (majority opinion).

⁴⁹ *Id.* at 702–03.

operations.⁵⁰ The United States Supreme Court divided 5-4 on two related issues: (1) whether the injunctive remedy constituted a “prior restraint” in violation of the original intent of the First Amendment (since 1925 applicable to the states through the Fourteenth Amendment); and (2) whether scandalous accusations (in this case, against a public official), were protected by the First Amendment against public law restraint (as distinct from private libel damages).⁵¹ The majority answered “yes” to both questions and therefore held the state statute unconstitutional.⁵² The dissent, however, offered four votes for the propositions that the law was not an invalid prior restraint, and, important for our purposes here, that the First Amendment did not protect scandalous accusations against public officials from public law regulation or sanction.⁵³

In crafting the dissent, Justice Butler relied upon Justice Joseph Story’s Commentaries on the Constitution.⁵⁴ Although first published in 1833, Justice Butler quoted the Commentaries as though it were the applicable law of 1931.⁵⁵ The view Justice Butler relied upon was that holding the First Amendment to protect an “absolute right to speak, or write, or print whatever he might please, without any responsibility, public or private” was a “supposition too wild to be indulged by any rational man.”⁵⁶

The right to free expression, to Justice Butler and the other dissenters, is “that every man shall be at liberty to publish what is true, with good motives and for justifiable ends.”⁵⁷ The right of free expression must give way, therefore, to a concept of civility

⁵⁰ *Id.* at 704.

⁵¹ *See id.* at 713, 718–19 (indicating that “[t]he question is whether a statute authorizing such proceedings in restraint of publication is consistent with the conception of liberty of the press as historically conceived and guaranteed,” and that public officers do not find remedies under proceedings restraining newspaper publication).

⁵² *Id.* at 718–19, 721.

⁵³ *See id.* at 735–36 (Butler, J., dissenting) (“The business and publications unquestionably constitute an abuse of the right of free press It is fanciful to suggest . . . the granting or enforcement of the decree authorized by this statute to prevent further publication of malicious, scandalous and defamatory articles and the previous restraint . . .”).

⁵⁴ *Id.* at 732.

⁵⁵ *Id.* at 732–33.

⁵⁶ *Id.* at 732 (quotation omitted).

⁵⁷ *Id.* at 733 (quotation omitted).

that is bound up with the ideals of the early American republic.⁵⁸ Chief Justice Hughes and the majority disagreed.⁵⁹

The majority, following Madison's 1798 response to the Sedition Act, recognized "that even a more serious public evil would be caused by authority to prevent publication [of scandalous material]."⁶⁰ Moreover, if the First Amendment was not intended to protect the expression of those who would offend others with their expressions, it would be robbed of force and be "reduced to a mere form of words."⁶¹ Thus, even uncivil, scandalous and disparaging speech would be afforded protection.⁶²

As of five years before passage of the Lanham Act, Congress didn't have to worry about the First Amendment protecting commercial speech at all.⁶³ In *Valentine v. Chrestensen*, the private owner of a former Navy submarine brought his ship to New York City.⁶⁴ Once there, he distributed handbills advertising his submarine on the streets of the city, and was thereafter restrained by the police.⁶⁵ The handbills he was distributing contained a protest against a city ordinance restricting the distribution of handbills on one side and an advertisement of his submarine on the other.⁶⁶ He was charged with violating a city sanitary code for distributing leaflets.⁶⁷ In upholding the charges against him, the Supreme Court noted that "the Constitution imposes no . . . restraint on government as respects purely commercial advertising."⁶⁸ Instead, the regulation of commercial speech was considered purely the prerogative of legislative

⁵⁸ *See id.* (quotation omitted) (stating that the freedom of expression must have some reasonable limitation if the values of the Republic are to be upheld).

⁵⁹ *See id.* at 718 (majority opinion) (noting the importance of the freedom of the press, and that some degree of abuse is inseparable from this freedom).

⁶⁰ *Id.* at 722.

⁶¹ *Id.*

⁶² *Id.* at 722–23.

⁶³ *See Valentine v. Chrestensen*, 316 U.S. 52, 54 (1942) (finding that the Constitution imposes no restraint on government when it comes to regulating commercial speech), *overruled by* *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748 (1976).

⁶⁴ *Valentine*, 316 U.S. at 52–53.

⁶⁵ *Id.* at 53.

⁶⁶ *Id.*

⁶⁷ *Id.*

⁶⁸ *Id.* at 54.

decision.⁶⁹

Since 1946, although the opportunity has arisen, Congress has not revisited the Lanham Act in order to correct any First Amendment deficiencies with § 2(a).⁷⁰

In considering the definition of scandalous and immoral, the Federal Circuit has explicitly refused to apply the “obscenity” standards⁷¹ from the Supreme Court to Lanham Act registrations on the grounds that the Act does not itself use the word “obscenity.”⁷² Instead, the Federal Circuit says that the definition of scandalous must be derived from the “ordinary and common meaning’ of that term,” the sources of which standard arise from the dictionary meaning as well as, somewhat circularly, the decisions of the PTO board itself.⁷³ Interestingly, although the term ‘vulgar’ also does not appear in the Lanham Act’s language prohibiting scandalous marks, the Federal Circuit has held that “the PTO may prove scandalousness by establishing that a mark is ‘vulgar.’”⁷⁴

The Federal Circuit further distinguishes the obscenity cases from immoral and scandalous trademarks by noting that a trademark can be displayed prominently in the public, and will not be concealed within a publication.⁷⁵ Although this distinction is not apparently within the obscenity jurisprudence of the Supreme Court, the Federal Circuit has used it in an effort to justify sidestepping possible restraints that would be imposed by the First Amendment.⁷⁶

The disparagement prohibition, although with less support in the case law, has received a similarly breezy treatment of its

⁶⁹ *Id.*

⁷⁰ 1 MCCARTHY, *supra* note 24, §§ 5:5–:11 (providing a summary of the various amendments to the Lanham Act).

⁷¹ The standard for determining what speech is obscene is governed by the Miller Test: “(a) whether the average person, applying contemporary community standards would find that the work, taken as a whole, appeals to the prurient interest, . . . (b) whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law; and (c) whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value.” *Miller v. California*, 413 U.S. 15, 24 (1973) (internal quotation marks and citations omitted).

⁷² *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981).

⁷³ *Id.*

⁷⁴ *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012).

⁷⁵ *McGinley*, 660 F.2d at 483–84.

⁷⁶ *Id.* at 484.

First Amendment implications. Recently, the Federal Circuit had rare occasion to issue a decision around § 2(a)'s prohibition on disparaging remarks.⁷⁷ The mark in question, "STOP THE ISLAMISATION OF AMERICA," was being used by noted anti-Muslim activist Pamela Geller.⁷⁸ The purpose of the group is to "educate Americans about 'Islamic domination and expansionism.'"⁷⁹ The TTAB denied her the right to federally register the mark on the grounds that it was disparaging to Muslims.⁸⁰ On appeal, Spencer and Geller argued that there was insufficient evidence to justify that the mark was disparaging.⁸¹

Since no case law existed on which to resolve the dispute, both sides and the Federal Circuit agreed that *In re Lebanese Arak Corp.*, a matter from the TTAB, provided the necessary framework for analysis.⁸²

Pursuant to *In re Lebanese Arak Corp.*, the analysis inquires:

(1) what is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and (2) if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.⁸³

The TTAB found that there existed both a religious and a political meaning for the term "Islamisation."⁸⁴ The religious meaning referred to the conversion to or conformance with the Islamic religion, and the political meaning referred to the "sectarianization of a political society through efforts to 'make [it] subject to Islamic law.'"⁸⁵ In support of its position the TTAB

⁷⁷ See *In re Geller*, 751 F.3d 1355, 1362 (Fed. Cir. 2014) (affirming the TTAB's refusal to register a mark as disparaging matter under § 2(a)).

⁷⁸ *Id.* at 1357.

⁷⁹ Gail Sullivan, *Court Denies Trademark Protection to Anti-Muslim Group*, WASH. POST, May 14, 2014, <http://www.washingtonpost.com/news/morning-mix/wp/2014/05/14/court-denies-trademark-to-anti-muslim-group/>.

⁸⁰ *Geller*, 751 F.3d at 1357.

⁸¹ *Id.* at 1358.

⁸² *Id.*

⁸³ *Id.* (quoting *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 1217 (T.T.A.B. 2010)).

⁸⁴ *Geller*, 751 F.3d at 1357.

⁸⁵ *Id.* (internal quotation marks omitted).

relied upon three sources of information: an online dictionary, the Appellants anti-Islamisation website, and comments of readers on the Appellant's web site.⁸⁶ The Appellants, on the other hand, contended that the sole use of the term in public referred to the "political and military process [of] replacing civilian laws with Islamic religious law."⁸⁷ Indeed, they asserted that the whole purpose of their website was to oppose the militant tactics of the Muslim Brotherhood.⁸⁸

The TTAB did not ultimately share the view of the Appellants, and the Federal Circuit affirmed.⁸⁹ In supporting the reasoning of the TTAB, The Federal Circuit cited a particular essay on Appellant's web site that "provides tips for opposing 'huge monster mosque[s]' proposed in people's communities."⁹⁰ The court noted that the essay in question addressed both political opinions regarding the Muslim Brotherhood, as well as merely religious opinions of Islam generally.⁹¹ The Federal Circuit also concluded that the cited essay advocates suppression of the Muslim religion as well as the mosques that serve as the center of faith.⁹² The TTAB relied upon another article on Appellant's website describing a controversial bus ad in Florida that was taken out by Appellants in order to counter-act pro-Islamic advertising that invited people to convert to Islam.⁹³ In the opinion of the Federal Circuit, that article was purely religious and without political content because it offered people a help line when leaving the Islamic religion in order to avoid retaliation.⁹⁴ The TTAB also relied upon anonymous comments on articles on the Appellant's web site in order to gauge the public's reaction to the Appellant's mark.⁹⁵

In the opinion of the Federal Circuit, the first prong of *In re Lebanese Arak Corp* was therefore satisfied by establishing that the challenged mark had the above religious and political meanings.⁹⁶ In analyzing the core of the second prong – whether

⁸⁶ *Id.* at 1359.

⁸⁷ *Id.* (internal quotation marks omitted).

⁸⁸ *Id.* at 1358–59.

⁸⁹ *Id.* at 1362.

⁹⁰ *Id.* at 1359.

⁹¹ *Id.* at 1359–60.

⁹² *Id.* at 1359.

⁹³ *Id.* at 1359–60.

⁹⁴ *Id.* at 1360.

⁹⁵ *Id.* at 1359–60.

⁹⁶ *Id.* at 1358–59.

the meanings established in prong one were disparaging – the Court determined first that both definitions would be applicable to all American Muslims.⁹⁷ Further, because the mark wanted to “STOP” the Islamisation of America, it “set[] a negative tone and signals that Islamization is undesirable and is something that must be brought to an end in America.”⁹⁸

Because Appellants did not clearly spell out that they were only against terrorism, and not against Islam in general, the mark was therefore disparaging.⁹⁹ Central to this opinion was the fact that Appellants did not prove that violence was a central requirement of the political aspect of Islamisation.¹⁰⁰ Therefore, since violence was not a facially necessary component of the political ambition of converting civil regimes into Shariah regimes, the mark improperly cast aspersions on Muslims.¹⁰¹

Since the Appellants conceded at oral argument that their mark would be offensive to Muslims in the purely religious meaning,¹⁰² the Federal Circuit proceeded with its analysis under the political meaning.¹⁰³ Leaving aside whether the political position of the Appellants is a good or worthy one, it is quite remarkable that the Court felt at liberty to parse political arguments in order to determine whether the very content of a political message was appropriate or correct. In no other area of federal jurisprudence would a court feel at liberty to determine whether political speech was accurate enough to warrant protection or federal recognition. Even in cases of defamation, a higher standard is typically applied when dealing with public figures or matters of public concern, where the burden rests upon the injured public figure to demonstrate that actual malice existed when a defendant propounded a known falsehood.¹⁰⁴

⁹⁷ *Id.* at 1360–61.

⁹⁸ *Id.* at 1361 (internal quotation marks omitted).

⁹⁹ *Id.* at 1362. The term “disparagement” was defined as “dishonor[ing] by comparison with what is inferior, slight[ing], deprecate[ing], degrad[ing], or affect[ing] or injur[ing] by unjust comparison.” *Id.* at 1358 (quoting *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 124 (D.D.C. 2003)) (internal quotation marks omitted).

¹⁰⁰ *Geller*, 751 F.3d at 1361–62.

¹⁰¹ *Id.*

¹⁰² *Id.* at 1361.

¹⁰³ *Id.* at 1361–62.

¹⁰⁴ *See* W. PAGE KEETON ET AL., PROSSER AND KEETON ON THE LAW OF TORTS 806 (5th ed. 1984) (stating that a “public official or a public figure” must establish with “clear and convincing clarity” that a defamatory statement was

However, when speaking on political matters through a trademark, the Federal Circuit would have the situation reversed. Under the reasoning of *In re Geller*, the burden rests upon the registering party to prove the entire factual basis of any political opinion expressed through its mark.¹⁰⁵ Even more curious, the Federal Circuit felt no obligation at all to provide even a small acknowledgement of the potential implications to the First Amendment of its decision.

While the Federal Circuit ignored or missed the First Amendment implications of such a decision, the TTAB at least acknowledged that there was some concern on that front.¹⁰⁶ Much as in the context of § 2(a)'s scandalous prohibition, the TTAB found that "our decision does not impact [applicants'] rights under the First Amendment" because "[t]he refusal to register applicants' mark does not impede their right to use the mark. As such, it imposes no restraint or limit on their ability to communicate ideas or express points of view"¹⁰⁷ Thus, even though their national reach would be restricted by being excluded from the franchise offered through the Lanham Act, there was no complete prohibition from using the mark in commerce.¹⁰⁸

As noted below in Part III, the Unconstitutional Conditions doctrine presents quite a different perspective on the First Amendment implications of § 2(a)'s prohibitions.¹⁰⁹

III. THE UNCONSTITUTIONAL CONDITIONS DOCTRINE

The Unconstitutional Conditions Doctrine emerged over the course of the twentieth century.¹¹⁰ In essence, the doctrine holds

"published with knowledge of its falsity or recklessly" unless the statement "relates to aspects of the person's life that does not relate to a legitimate public interest").

¹⁰⁵ See *Geller*, 751 F.3d at 1361–62 (explaining that the appellants could not provide a factual basis for their political opinion that spreading Islamic law requires violence).

¹⁰⁶ *In re Geller & Spencer*, No. 77940879, 2013 WL 2365001, at *11 (T.T.A.B. Feb. 7, 2013).

¹⁰⁷ *Id.*

¹⁰⁸ *Id.*

¹⁰⁹ See discussion *infra* Part III.

¹¹⁰ See generally Brian T. Hodges, *Reexamining the Doctrine of Unconstitutional Conditions*, PAC. LEGAL FOUND. (May 29, 2012), <http://blog.pacificlegal.org/2012/re-examining-the-doctrine-of-unconstitutional-conditions/> (providing a brief history of the Unconstitutional Conditions

that the government is not allowed to require that an individual surrender a constitutionally guaranteed right in exchange for a government benefit.¹¹¹ However, this doctrine did not fully emerge in constitutional jurisprudence until after the period in which the Lanham Act was drafted.¹¹² Instead, the prior era was characterized by the rights-privileges distinction.¹¹³ The rights-privileges distinction is well captured in a famous holding of Oliver Wendell Holmes,¹¹⁴ who would become Chief Justice of the Massachusetts Supreme Judicial Court seven years after the holding. In *McAuliffe v. City of New Bedford*, a police officer sued for reinstatement after he was dismissed for his participation in a political organization.¹¹⁵ In dismissing the case, Chief Justice Holmes held that “[t]he petitioner may have a constitutional right to talk politics, but he has no constitutional right to be a policeman.”¹¹⁶

By contrast, the Supreme Court has very recently reaffirmed the proposition that “the government may not deny a benefit to a person because he exercises a constitutional right.”¹¹⁷ Although this principle contains exceptions, as will be discussed below, it has been applied to a wide variety of situations, including refusal to renew teaching contracts over First Amendment-protected speech acts, and infringement of the right to travel by refusing to adequately extend healthcare benefits to sick persons who had

Doctrine throughout the twentieth century).

¹¹¹ See, e.g., *Koontz v. St. Johns River Water Mgmt. Dist.*, 133 S. Ct. 2586, 2591 (2013) (“[A] unit of government may not condition the approval of a land-use permit on the owner’s relinquishment of a portion of property . . .”).

¹¹² See *In re Tam*, No. 2014-1203, 2015 WL 1768940, at *6 (Fed. Cir. Apr. 20, 2015) (dictum) (noting that “First Amendment jurisprudence on the ‘unconstitutional conditions’ doctrine . . . has evolved since the *McGinley* decision” and therefore the “constitutionality of § 2(a)” must be duly considered), *reh’g granted*, 600 F. App’x 775 (Fed. Cir. Apr. 27, 2015); see also Richard A. Epstein, Foreword, *Unconstitutional Conditions, State Power, and the Limits of Consent*, 102 HARV. L. REV. 4, 104 (1986) (declaring the unconstitutional conditions doctrine an “emergent doctrine” of the post-1937 era of constitutional jurisprudence).

¹¹³ See William W. Van Alstyne, *The Demise of the Right-Privilege Distinction in Constitutional Law*, 81 HARV. L. REV. 1439, 1441, 1463 (1968) (describing rights-privileges distinction decisions of the 1950’s and giving an example of departure from the rights-privileges tradition in 1960’s jurisprudence).

¹¹⁴ *McAuliffe v. City of New Bedford*, 29 N.E. 517, 517–18 (Mass. 1892).

¹¹⁵ *Id.* at 517.

¹¹⁶ *Id.*

¹¹⁷ *Koontz v. St. Johns River Water Mgmt. Dist.* 133 S. Ct. 2586, 2594 (2013).

not been residents of a county for at least a year.¹¹⁸

Mitchell Berman offers an interesting view of the Unconstitutional Conditions Doctrine.¹¹⁹ On his account, the wrong that occurs when the government withholds a benefit that affects a constitutional right is a wrong of coercion.¹²⁰ Berman defines coercion for these purposes as “the wrong of manipulating a person to act in a certain way by placing wrongful pressure upon her alternatives.”¹²¹ Berman synthesizes his view of the Unconstitutional Conditions Doctrine as follows:

Every constitutional right entails a claim-right that the state not penalize the exercise (or nonwaiver) of the constitutional right itself in the sense of imposing (or allowing to obtain) consequences upon the right-holder that are adverse relative to the consequences that the state would impose (or allow to obtain) but for the state’s purpose in having the right-holder experience the consequences as disagreeable. That is largely what it means to have a constitutional right. It follows that the withholding of what seems to be a “benefit” is in fact a “penalty”—and hence is unconstitutional—if undertaken for the purpose of punishing or discouraging exercise of a right. And a conditional proposal is coercive (in the constitutional sense) if the state threatens to impose a penalty for the refusal to waive a constitutional right.¹²²

Although the Supreme Court continues to rely upon the Unconstitutional Conditions Doctrine in protecting constitutional rights,¹²³ such protection is not without limitation. For instance, in *Garcetti v. Ceballos*, the Supreme Court held that “when

¹¹⁸ See *Perry v. Sindermann*, 408 U. S. 593, 597–98 (1972) (discussing free speech rights in the employment context); *Mem’l Hosp. v. Maricopa Cnty.*, 415 U. S. 250, 269–70 (1974) (holding that a failure to extend healthcare benefits to temporary residents impinges upon the right to travel); see also *Goldberg v. Kelly*, 397 U.S. 254, 262–64 (1970) (finding that welfare recipients had some interest in the welfare benefits that required Due Process proceedings even though welfare was merely a government benefit and not a right), *superseded by statute*, Personal Responsibility and Work Opportunity Reconciliation Act of 1996, Pub. L. No. 104-193, 110 Stat. 2105, as recognized in *State ex rel. K.M. v. W. Va. Dep’t of Health & Human Res.*, 575 S.E.2d 393 (W. Va. 2002).

¹¹⁹ Mitchell N. Berman, *Commercial Speech and the Unconstitutional Conditions Doctrine: A Second Look at “The Greater Includes the Lesser,”* 55 VAND. L. REV. 693 (2002).

¹²⁰ *Id.* at 730.

¹²¹ *Id.*

¹²² *Id.* at 732–33.

¹²³ See *Garcetti v. Ceballos*, 547 U.S. 410, 417 (2006) (explaining that public employees do not surrender all First Amendment rights due to their employment as such).

public employees make statements pursuant to their official duties, the employees are not speaking as citizens for First Amendment purposes, and the Constitution does not insulate their communications from employer discipline.”¹²⁴

In other words, while the government may not deny a benefit (such as governmental employment) to penalize the exercise of a “constitutional right,” the concept of a “constitutional right” is itself subject to definition and, in *Garcetti*, contraction in certain contexts.¹²⁵ The *Garcetti* limitation reflects the Court majority’s desire to support the managerial authority of governmental employers. By contrast, the Supreme Court has not made any moves that would suggest that private citizens interacting with the government as non-employees would sometimes find themselves required to surrender a constitutional right for a government benefit.

Indeed, the recent *Koontz v. St. Johns River Water Mgmt. Dist.* case,¹²⁶ involving the property rights of landowners,¹²⁷ suggests the contrary. In *Koontz*, the Supreme Court held that the *Nollan/Dolan* “‘nexus’ and ‘rough proportionality’” requirement when a government placed conditions on land use must be satisfied even when a permit is denied.¹²⁸ In reaching this decision, the Supreme Court relied upon the Unconstitutional Conditions Doctrine, holding that “so long as [in the land use context] there is a ‘nexus’ and ‘rough proportionality’ between the property that the government demands and the social costs of the applicant’s proposal,” the conditions will be constitutional.¹²⁹ Otherwise, the conditions will fail scrutiny.¹³⁰

A. *Trademarks, the First Amendment, and Unconstitutional Conditions*

The PTO and the Federal Circuit Court of Appeals have not yet

¹²⁴ *Id.* at 421.

¹²⁵ *See id.* (analyzing contraction in the context of a public employee’s speech).

¹²⁶ 133 S. Ct. 2586 (2013).

¹²⁷ *See id.* at 2588 (discussing a landowner’s intention to develop property on neighboring wetlands).

¹²⁸ *Id.* at 2591.

¹²⁹ *Id.* at 2595.

¹³⁰ *See id.* (explaining that the government “may not leverage its legitimate interest in mitigation to pursue governmental ends that lack an essential nexus and rough proportionality to those impacts”).

seen fit to apply the Unconstitutional Conditions Doctrine to trademark law.¹³¹ Under § 2(a) of the Lanham Act, trademark owners are barred from registering scandalous, immoral or disparaging marks.¹³² The Federal Circuit has refused to even entertain the notion that trademarks may be a protected form of speech, and that § 2(a) is an unconstitutional prior restraint.¹³³ Take, for example, *In re McGinley*, a seminal case on the scandalous and immoral prohibitions in § 2(a).¹³⁴

In *McGinley*, the refused mark in question, two naked people embracing, was used to represent “social club” services helping swingers to connect. The trademark owner’s challenge was that § 2(a) is void for vagueness because there is no satisfactory definition of “immoral” or “scandalous” and, as in First Amendment obscenity cases, there is no basis on which to establish a national standard.

The court dismissed First Amendment concerns out of hand, holding that since “[n]o conduct is proscribed, and no tangible form of expression is suppressed,” there was no affect on the trademark owner’s speech rights.¹³⁵ In failing to even consider doctrines such as unconstitutional conditions or Equal Protection, they relied on a previous trademark case, *Holiday Inn v. Holiday Inns, Inc.*,¹³⁶ for the proposition that since the core

¹³¹ See *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) (refusing to entertain the notion that trademarks may be a protected form of speech).

¹³² Lanham Act, Pub. L. No. 79-489, § 2(a), 60 Stat. 427, 428 (1946) (codified as amended at 15 U.S.C. § 1052(a) (2012)). Notably, the Federal Circuit has read this section such that scandalous can be interpreted as “vulgar” as defined in the dictionary. See *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012) (“[W]here it is clear from dictionary evidence ‘that the mark as used by the applicant in connection with the products described in the application’ invokes a vulgar meaning to a substantial composite of the general public, the mark is unregistrable.”) (internal brackets omitted). “Obscenity,” as it has been delineated as an exception to the First Amendment freedom of speech, however, has been explicitly rejected as the standard for scandalousness. See *In re McGinley*, 660 F.2d 481, 485 n.9 (C.C.P.A. 1981) (noting that “the threshold for objectionable matter” under § 2(a) “is lower for what can be described as ‘scandalous’ than for ‘obscene’”); see also note 104 and accompanying text (providing a definition of the term “disparaging”).

¹³³ See *McGinley*, 660 F.2d at 482 (affirming a rejection of the appellant’s application on the basis that it comprises “immoral . . . or scandalous matter, and is therefore not a protected form of speech).

¹³⁴ *Id.*

¹³⁵ *Id.* at 484.

¹³⁶ 534 F.2d 312 (C.C.P.A. 1976).

right of a trademark registration is the ability to exclude others from using that mark, and such a right is created via use and not registration, the failure to register a mark could not affect the ownership or use of a mark.¹³⁷

Further, the *McGinley* court was of the opinion that “[w]hat is denied are the benefits provided by the Lanham Act which enhance the value of a mark,” and that the appellant still had legal recourse under state common law.¹³⁸ Therefore, so the court in *McGinley* reasoned, since the right to use the mark is not actually abridged, no expression is abridged.¹³⁹

Perhaps a key insight into the Federal Circuit’s dismissive attitude toward the First Amendment analysis is that it regarded the statutory rights granted as merely “procedural” and not substantive.¹⁴⁰ Although it did not elaborate, ostensibly it is talking about the various benefits of trademark registration enforcement such as presumptive use nationwide and damages, and it is not considering them as a total package that provides a competitive advantage to trademark owners, as well as a means of nationwide expression.¹⁴¹

If one did take this view, the entitlements of federal trademark registration could be shunted into the *Garcetti* exception: regulating federally registered trademarks is like regulating speech when you are an employee of the federal government. However, this argument attempts to cover too much ground, and ends up echoing much more of the early twentieth century rights-privileges jurisprudence of Justice Holmes.¹⁴² As will be discussed, *infra*, trademark registration is the federal registration of a use-based, pre-federal registration property right that has speech implications far outside of any mere

¹³⁷ *McGinley*, 660 F.2d at 484.

¹³⁸ *Id.* at 486 n.12.

¹³⁹ *Id.* at 484. The Federal Circuit and the PTO continue to rely on this position in refusing registrations under § 2(a). *See, e.g., In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012); *In re The Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003); *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994).

¹⁴⁰ *McGinley*, 660 F.2d at 484.

¹⁴¹ Also consider the position taken in MCCARTHY ON TRADEMARKS: “[T]here is little doubt that Congress, in passing the Lanham Act, intended it to grant ‘substantive as distinguished from merely procedural rights in trademarks.’” 3 MCCARTHY, *supra* note 24, § 19:8.

¹⁴² *See supra* notes 113–16 and accompanying text.

regulatory or ministerial interest.¹⁴³

In *McCauliffe*, the police officer before Justice Holmes lost his job.¹⁴⁴ This is an obviously tangible harm. The Federal Circuit dismisses owners of “immoral” or “disparaging” trademarks on the ground that no actual harm is done – they still own the mark, and, as far as the Federal Circuit is concerned, no speech has been suppressed.¹⁴⁵ There are real advantages to trademark registration, as discussed in Part II.¹⁴⁶ For instance, businesses and individuals enjoy a nationwide recognition of their presence and can vindicate their interests in federal courts.¹⁴⁷ Without the federal registration that is presumptively supplied to marks that are not “immoral” or “scandalous,” an individual can find himself attempting to protect his interests in a mark in the courts of every state in which he does business.¹⁴⁸

It is important also to make a distinction between a refusal to acknowledge a copyright federally, and the sorts of non-prohibitory interests protected in other First Amendment contexts. For example in *National Endowment of the Arts v. Finley*,¹⁴⁹ a refusal to award an arts grant was not equated with censorship of the artist.¹⁵⁰ The Court did acknowledge, however, that were the legislation in question aimed at suppressing a particular viewpoint, it would violate the First Amendment.¹⁵¹

Interestingly, Respondents in *Finley* argued that the statute in

¹⁴³ See discussion *infra* Part III.D. Notably, state common law or statutory rights are not a condition precedent to federal registration. 3 MCCARTHY, *supra* note 24, § 19:8. However, the rights to marks arise out of an actual use, which is then later recognized as the basis for a federal registration. *Id.* Thus, federal and state protections of trademarks differ, but the right to a trademark under either system flows from the use of the mark that occurs before the government deems to recognize the mark.

¹⁴⁴ *McCauliffe v. City of New Bedford*, 29 N.E. 517, 517 (Mass. 1892).

¹⁴⁵ *McGinley*, 660 F.2d at 484.

¹⁴⁶ See Lanham Act, Pub. L. No. 79-489, § 33, 60 Stat. 427, 438–39 (1946) (codified as amended at 15 U.S.C. § 1115 (2012)) (discussing benefits of federally registered trademarks).

¹⁴⁷ See *id.* § 21, 60 Stat. at 325 (codified as amended at 15 U.S.C. § 1071 (2012)) (allowing those with registered trademarks to bring appeals before the U.S. Court of Appeals for the Federal Circuit, thereby avoiding having to litigate in state courts).

¹⁴⁸ *Id.*

¹⁴⁹ 524 U.S. 569 (1998).

¹⁵⁰ *Id.* at 583.

¹⁵¹ *Id.* at 586–87.

question actually forbade the funding of art that was indecent,¹⁵² something apparently relevant in the context of a prohibition on immoral trademarks.¹⁵³ However, the Court specifically carved out the ability to select between decent and indecent art in the context of funding the arts because the government was itself providing the subsidy and was not acting as a criminal or civil regulator.¹⁵⁴

Under the Unconstitutional Conditions Doctrine, which emerged along with modern First Amendment jurisprudence *after* the passage of the Lanham Act, even though the benefits of trademark registration are not constitutionally guaranteed rights, those benefits cannot be offered in exchange for a trademark owner's loss of actually guaranteed rights.¹⁵⁵

B. Applying the Unconstitutional Conditions Doctrine

In order for the Unconstitutional Conditions Doctrine to have any place in a § 2(a) analysis, there must obviously be constitutional rights at stake.¹⁵⁶ The primary position put forth here is that trademarks do constitute a form of speech protected by the First Amendment.¹⁵⁷ However, some brief remarks should be offered regarding potential Fifth Amendment protection of trademarks as property rights.¹⁵⁸

Trademarks are property and have the attributes of property:

¹⁵² *Id.* at 580. *But see id.* at 580–81 (finding that the statute did not forbid the funding of art that was indecent, but merely allowed the National Endowment for the Arts (“NEA”) to use “indecentcy” as a criterion for awarding art grants).

¹⁵³ *See* Lanham Act, Pub. L. No. 79-489, § 2(a), 60 Stat. 427, 428 (1946) (codified as amended at 15 U.S.C. § 1052(a) (2012)) (stating that “immoral” trademarks may be refused registration); *see also* 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, 802 (1993) (explaining that the Lanham Act effectively “prohibits registration of a broad variety of marks based merely on their content or subject matter”).

¹⁵⁴ *Finley*, 524 U.S. at 588–89.

¹⁵⁵ *See* Davis, *supra* note 153, at 830–35 (discussing the “unconstitutional conditions” doctrine).

¹⁵⁶ *Id.* at 834–35.

¹⁵⁷ *See, e.g., id.* at 806 n.29 (noting other cases in which plaintiffs have argued that their trademarks are protected First Amendment rights).

¹⁵⁸ *See id.* at 816 n.90 (“The right to registration cannot be denied without compliance with Fifth Amendment due process requirements.”).

they are alienable and include a right to exclude.¹⁵⁹ Moreover, trademarks are widely recognized as a valuable business asset.¹⁶⁰ Although expectations regarding property rights will be adjusted in light of a long standing regulation,¹⁶¹ such property rights in trademarks will nonetheless stimulate Fifth Amendment takings scrutiny.¹⁶²

As noted above, the Federal Circuit maintains the position that in preventing registration of “scandalous” or “disparaging” marks the Act does not negate their status as property under applicable state law, but merely withholds federal protection for that particular class of trademark property.¹⁶³ The position effectively resorts to the historical rights-privileges view of constitutional rights, and ignores the fact that the federal government has entered into an existing private market. By intervening in the market, and by enhancing the value of marks that are allowed

¹⁵⁹ See *Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666, 673 (1999) (“[T]rademarks . . . are the ‘property’ of the owner because he can exclude others from using them.”); 1 MCCARTHY, *supra* note 24, § 2:14 (declaring that since “a trademark is undoubtedly a ‘right to exclude,’ a trademark is a form of ‘property.’”). For instance, accountants will treat trademarks as an example of an “intangible asset[.]” *Id.* § 2:26. Furthermore, under the bankruptcy code, they are considered property. See 3 MCCARTHY, *supra* note 24, § 18:28 (stating that a trademark “constitutes a part of the assets of an estate of an insolvent . . .”).

¹⁶⁰ See 1 MCCARTHY, *supra* note 24, § 2:14 (“Businesspeople regard trademarks as valuable assets and are willing to pay large sums to buy or license a well-known mark.”).

¹⁶¹ See, e.g., *Ruckelshaus v. Monsanto Co.*, 467 U.S. 986, 1007 (1984) (discussing Monsanto Company’s continuing research and registrations in the area of pesticides, which is heavily regulated, and stating that “a voluntary submission of data by an applicant in exchange for the economic advantages of a registration can hardly be called a taking”).

¹⁶² See *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 532 (1987) (explaining that investment in a mark creates a form of property right); see also *Ruckelshaus*, 467 U.S. at 1003–04 (recognizing that intangible forms of property, such as trade secrets, will be subject to Fifth Amendment scrutiny); *Zoltek Corp. v. United States*, 672 F.3d 1309, 1326–27 (Fed. Cir. 2012) (holding that patents receive just as much property protection under the Constitution as other forms of intellectual property); *Pharm. Care Mgmt. Ass’n v. Rowe*, 429 F.3d 294, 308 (1st Cir. 2005) (examining whether the case at issue qualified for property protection as a trade secret).

¹⁶³ The court in *McGinley* held that “[w]hat is denied are the benefits provided by the Lanham Act which enhance the value of a mark” and that the appellants still had legal recourse under state common law. *In re McGinley*, 660 F.2d 481, 486 n.12 (C.C.P.A. 1981). I would characterize this holding as a concession that trademarks are property.

national registration, the federal government has stripped “immoral” or “disparaging” trademark owners of a large amount of exploitable value. This is the sort of regulatory taking that was contemplated by *Pennsylvania Coal Co. v. Mahon*,¹⁶⁴ where the Court held that “if regulation goes too far it will be recognized as a taking.”¹⁶⁵ Regulatory takings occur either when there is a total loss of value stemming from the regulation,¹⁶⁶ or the taking violates the *Penn Central* test.¹⁶⁷

Under *Penn Central*, an *ad hoc* examination is conducted to determine (1) the economic impact on the property owner, (2) “the extent to which the regulation has interfered with distinct investment-backed expectations”, and (3) “the character of the governmental action.”¹⁶⁸

By denying federal registration, there are significant, practical economic effects on the trademark owner.¹⁶⁹ This includes an inability to record conveyances, mortgages, and grant security interests, as well as the costly expense of having to litigate trademark actions on a state-by-state basis in order to enforce their property rights.¹⁷⁰ While § 2(a) does not remove all value

¹⁶⁴ 260 U.S. 393 (1922).

¹⁶⁵ *Id.* at 415.

¹⁶⁶ See *Lingle v. Chevron U.S.A. Inc.*, 544 U.S. 528, 548 (2005) (discussing “a *Lucas*-type” total regulatory taking).

¹⁶⁷ *Penn. Cent. Transp. Co. v. City of New York*, 438 U.S. 104, 124 (1978).

¹⁶⁸ *Id.*

¹⁶⁹ See, e.g., Scott Baldwin, *Don't Sit and Wait: Stopping Trademark Squatters*, 4(1) INVENTORS EYE (Feb. 2013), <http://www.uspto.gov/custom-page/inventors-eye-don-t-sit-and-wait-stopping-trademark-squatters> (“Businesses rely on these marks to identify their products and distinguish them from those of their competitors. The public relies on them to distinguish among competing producers and to determine authenticity.”). If a trademark is not registered, then another company may be able to use that mark and cause damage to the original creator’s business. *Id.*

¹⁷⁰ See, e.g., 35 U.S.C. § 261 (Supp. 2013) (discussing assignment of rights of “[a]pplications for patent, patents, or any interest therein . . .”). If registration itself is not allowed, then the entity seeking registration cannot assign those rights because “[a]n assignment, grant or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.” *Id.* See also Paul Edward Kim, Comment, *Preventing Dilution of the Federal Dilution Act: Why the FDTA Requires Actual Economic Harm*, 150 U. PA. L. REV. 719, 727 n.38 (2001) (noting how the “[u]neven application of [trademark] dilution standards in state courts and the inconsistent availability of state antidilution statutes encouraged forum shopping for those courts which

from a trademark, the federal government has distorted the private market in trademarks by greatly enhancing the value of marks that can operate nationally. By then erecting a morally-based barrier to those who would like to use their otherwise acceptable property in national commerce, the government has indeed removed a good deal of value from private hands. It is not difficult to see, further, how investors in various enterprises that would rely on potentially questionable marks, could have their expectations frustrated by being stymied in conducting national commerce.

Finally, “a legitimate government action is a precondition for a valid takings claim,”¹⁷¹ thus complicating the character element of the *Penn Central* test with respect to § 2(a). The Lanham Act was created as a means for avoiding confusion and deception between marks and the products or services they were meant to identify.¹⁷² Section 2(a) is an anomaly in this context. It purports to protect the public morals.¹⁷³ At least in the context of the Lanham Act, it is arguable that § 2(a) would fail the “character” prong of the *Penn Central* test.

There is quite a lot more to be said about the Fifth Amendment and § 2(a), including whether one may argue that the *Nolan* nexus requirement could operate in this area. What is clear, however, is that it is likely that a constitutionally protected property right may be implicated with respect to the Unconstitutional Conditions Doctrine. To hold otherwise would be to offer the contention that property can be constitutionally taken because one exercises their constitutionally protected right to speak in an “immoral” or “disparaging” manner.

However, the real focus here is the First Amendment, which could protect trademarks in at least two different ways. First, as commercial speech, trademarks will deserve some level of protection, though perhaps not as much as non-commercial

offered the broadest trademark protection”).

¹⁷¹ John D. Echeverria, *Lingle, Etc.: The U.S. Supreme Court's 2005 Takings Trilogy*, 35 E.L.R. 10577, 10583 (2005).

¹⁷² See Francesca Barigozzi & Martin Peitz, *Comparative Advertising and Competition*, in RECENT DEVELOPMENTS IN ANTITRUST: THEORY AND EVIDENCE 215, 221 (Jay Pil Choi ed., 2007) (discussing how the Lanham Act was intended to prevent “palming off” and prevent registration of misleading marks).

¹⁷³ Betsy Rosenblatt, *Moral Rights Basics*, HARV. L. SCH. (Mar. 1998), <http://cyber.law.harvard.edu/property/library/moralprimer.html>.

speech.¹⁷⁴ More likely, however, is the possibility that trademarks constitute “intertwined speech” – that is, speech that contains both commercial and noncommercial elements.¹⁷⁵ As discussed, *infra*, intertwined speech will receive the full protection of the First Amendment.¹⁷⁶

C. Commercial Speech

The First Amendment provides broad protection for a wide spectrum of “speech,” generally forbidding the government restriction of speech by virtue of “its message, its ideas, its subject matter, or its content.”¹⁷⁷ The definition of speech itself is likewise broad, including not only words, but also non-verbal gestures and symbols.¹⁷⁸ Any governmental curtailing of such speech will be “presumptively invalid,” with the burden of rebutting that presumption on the government.¹⁷⁹

Exceptions to this prohibition on government regulation of speech do exist as “well-defined and narrowly limited classes of speech.”¹⁸⁰ Such limitations include “obscenity . . . defamation . . . fraud . . . incitement . . . and speech integral to criminal conduct.”¹⁸¹ Importantly, merely “offensive” speech will not be subject to government restriction.¹⁸²

Another class of speech that will receive less First Amendment

¹⁷⁴ See Rebecca Tushnet, *Trademark Law as Commercial Speech Regulations*, 58 S.C. L. REV. 737, 737–38 (2007) (discussing protections for trademarks as commercial speech but stating that commercial speech has traditionally received less protection than noncommercial speech).

¹⁷⁵ David M. Kelly & Lynn M. Jordan, *Twenty Years of Rogers v. Grimaldi: Balancing the Lanham Act With the First Amendment Rights of Creators of Artistic Works*, 99 J. INT’L TRADEMARK ASS’N 1360, 1361–62 (2009).

¹⁷⁶ See discussion *infra* Part III.D.

¹⁷⁷ *Ashcroft v. Am. Civil Liberties Union*, 535 U.S. 564, 573 (2002).

¹⁷⁸ See *Texas v. Johnson*, 491 U.S. 397, 404 (1989) (“[W]e have long recognized that [First Amendment] protection does not end at the spoken or written word . . . conduct may be sufficiently imbued with elements of communication to fall within the scope of the First and Fourteenth Amendments.”).

¹⁷⁹ *United States v. Playboy Entm’t Grp., Inc.*, 529 U.S. 803, 817 (2000).

¹⁸⁰ *Chaplinsky v. New Hampshire*, 315 U.S. 568, 571 (1942).

¹⁸¹ *United States v. Stevens*, 559 U.S. 460, 468 (2010).

¹⁸² See *Johnson*, 491 U.S. at 414 (“If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.”).

scrutiny is commercial speech.¹⁸³ The Third Circuit has noted that classifying speech as “commercial” is not as simple as examining whether the speech is used in connection with an act of commerce.¹⁸⁴ Under *Fascenda v. N.F.L. Films, Inc.*,¹⁸⁵ courts would examine (1) whether “the speech was an advertisement”; (2) whether “the speech referred to a specific product or service”; and (3) whether “the speaker had an economic motivation for the speech.”¹⁸⁶ If all three inquiries are answered in the affirmative, then there is “strong support for the conclusion that the speech is commercial.”¹⁸⁷

Importantly, the Supreme Court has noted that otherwise commercial information may at times be more urgent than even political dialog,¹⁸⁸ and that information relating to a financial incentive was not necessarily commercial for First Amendment purposes.¹⁸⁹ “[S]ignificant societal interests are served by such speech.”¹⁹⁰ This is so because even entirely commercial speech “may often carry information of import to significant issues of the day.”¹⁹¹

When speech is commercial, the “*Central Hudson Test*”¹⁹² is applied in order to determine if governmental regulation is constitutional. The Central Hudson test asks:

- (1) Does the speech concern illegal activity or is it misleading?
- (2) Is the asserted government interest substantial; and if so
- (3) Does the regulation directly advance the interest; and if so
- (4) Is the regulation more extensive than necessary to serve that

¹⁸³ See *Zauderer v. Office of Disciplinary Counsel of Supreme Court of Ohio*, 471 U.S. 626, 637 (1985) (“There is no longer any room to doubt that what has come to be known as ‘commercial speech’ is entitled to the protection of the First Amendment, albeit to protection somewhat less extensive than that afforded ‘noncommercial speech.’”).

¹⁸⁴ See *Fascenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1017 (3d Cir. 2008) (discussing a three-step test for determining whether speech is commercial).

¹⁸⁵ *Id.*

¹⁸⁶ *Id.* at 1017.

¹⁸⁷ *Id.*

¹⁸⁸ See *Sorrell v. IMS Health Inc.*, 131 S. Ct. 2653, 2664 (2011) (“A consumer’s concern for the free flow of commercial speech often may be far keener than his concern for urgent political dialogue.”).

¹⁸⁹ *Riley v. Nat’l Fed’n of the Blind of N.C., Inc.*, 487 U.S. 781, 795–96 (1988).

¹⁹⁰ *Bates v. State Bar of Ariz.*, 433 U.S. 350, 364 (1977).

¹⁹¹ *Id.*

¹⁹² *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557 (1980).

interest?¹⁹³

An important thing to note here is that the Court held that “[i]f the communication is neither misleading nor related to unlawful activity, the government’s power is more circumscribed.”¹⁹⁴ Section 2(a) already contains a prohibition against deceptive trademarks,¹⁹⁵ and the Lanham Act itself prohibits confusingly similar marks,¹⁹⁶ obviating the need for the commercial speech qualification here. Granting that scandalous and disparaging trademarks are not *per se* misleading or illegal,¹⁹⁷ the question then turns to the government’s interests. What are permissible government interests such that scandalous and immoral trademarks could be prohibited by the government under the commercial speech doctrines?

In *McGinley*, the Federal Circuit described the two animating interests driving § 2(a): (1) not appearing to give the government imprimatur to such material and (2) not wasting federal resources and public funds on such material.¹⁹⁸ Both of these justifications have been rendered unpersuasive over time.¹⁹⁹ The trademark registration system is now supported on user fees, sometimes running surpluses.²⁰⁰ Further, in *In re Old Glory Condom Corporation*,²⁰¹ the TTAB declared that there was no actual risk of the public viewing a trademark registration as having the imprimatur of the government.²⁰²

¹⁹³ *Id.* at 563–64.

¹⁹⁴ *Id.* at 564.

¹⁹⁵ See Lanham Act, Pub. L. No. 79-489, § 2(a), 60 Stat. 427, 428 (1946) (codified as amended at 15 U.S.C. § 1052(a) (2012)) (refusing registration of a trademark if it “[c]onsists of or comprises . . . deceptive . . . matter”).

¹⁹⁶ See *id.* § 2(d), 60 Stat. at 429 (codified as amended at 15 U.S.C. § 1052(d) (2012)) (refusing the same if it “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent Office . . . as to be likely . . . to cause confusion or mistake”).

¹⁹⁷ See *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 127 (D.D.C. 2003) (holding that the term “redskin(s)” when used in connection with the football team is not disparaging to Native Americans).

¹⁹⁸ *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981).

¹⁹⁹ See *infra* notes 200–02 and accompanying text.

²⁰⁰ *View Fee Schedule: Trademark Fee Information*, U.S. PAT. & TRADEMARK OFF., <http://www.uspto.gov/trademark/view-fee-schedule-trademark-fee-information> (last updated Apr. 14, 2015).

²⁰¹ *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1993 WL 114384 (T.T.A.B. 1993).

²⁰² *Id.* at 1220 n.3 (“[W]e have detected an undercurrent of concern that the issuance of a trademark registration . . . amounts to the awarding of the U.S.

It is worthwhile to note that the justification behind specially classifying commercial speech is when the regulation concerns protecting consumers from “misleading, deceptive, or aggressive sales practices, or requires the disclosure of beneficial consumer information.”²⁰³ However, when the state is attempting to completely abrogate non-misleading speech in a way unrelated to the “fair bargaining process,” strict scrutiny will likely apply.²⁰⁴ Moreover, the Court in *44 Liquormart, Inc. v. Rhode Island*, advised that the First Amendment directs us to be skeptical when the state seeks to regulate speech for our own good.²⁰⁵

With the foregoing in mind, it is presumable that trademarks may not constitute commercial speech deserving of lesser protection. Thus, even when viewed as commercial speech, trademarks should be protected from the prohibition of § 2(a). The government interests on behalf of prohibiting immoral and disparaging marks, as offered by the Federal Circuit, are simply too weak to trump the First Amendment concerns presented by the prohibition.²⁰⁶ This is particularly so since the weight of First Amendment jurisprudence presses against the state regulating speech with which it merely disagrees.²⁰⁷

However, even if some marks may so qualify, there are marks that contain content within them that aims at much more than a mere commercial purpose. Marks with a double meaning that is subversive, that promotes values or lifestyles that are unpopular, or that are part of social causes come to mind. Such marks that contain a mixture of expressive and commercial content will likely be evaluated as intertwined speech.

Government’s “imprimatur” to the mark. Such a notion is, of course, erroneous.”). It should be noted that, as a decision of the Trademark Appeals Board, the *Old Glory* case is not binding authority. However, the case nonetheless expresses an important sentiment within the decision making body regarding the justifications for § 2(a) prohibitions of scandalous and immoral material.

²⁰³ *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 501 (1996).

²⁰⁴ *Id.*

²⁰⁵ *Id.* at 503.

²⁰⁶ *See In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981) (discussing the reasons behind § 2(a)).

²⁰⁷ *See Sorrell v. IMS Health Inc.*, 131 S. Ct. 2653, 2664 (2011) (“The First Amendment requires heightened scrutiny whenever the government creates a regulation of speech because of disagreement with the message it conveys.”).

D. Intertwined Speech

Although the full extent of the doctrine is not definitively settled, it is clear that at least some speech will be fully protected despite the fact that it may contain noncommercial speech intertwined with commercial speech.²⁰⁸

In *Riley v. National Federation of the Blind*, professional fundraisers in North Carolina were required to disclose to potential donors the percentage of charitable donations collected in the previous year that were actually used for charitable purposes.²⁰⁹ Although the Court observed that there is no constitutional significance between “compelled speech” and “compelled silence,” for First Amendment purposes,²¹⁰ it is important to note that *Riley* dealt with a case of compelled speech.²¹¹ The speech in question was in part compelled by regulation.²¹² Nevertheless, although the Court noted this compulsion,²¹³ it does not necessarily appear to control the doctrine of intertwined speech.

A principle case upon which *Riley* was built did not contain compelled speech in the facts. In *Village of Schaumburg v. Citizens for a Better Environment*,²¹⁴ the Court also dealt with regulation of door-to-door fundraisers, and the speech interests so involved.²¹⁵ Fundraising – which the court characterized as commercial speech – deserves protection because it did more than “provid[e] information about the characteristics and costs of goods and services . . .”²¹⁶ “[S]olicitation is characteristically intertwined with informative and perhaps persuasive speech seeking support for particular causes or for particular views on economic, political, or social issues, and for the reality that without solicitation the flow of such information and advocacy

²⁰⁸ See *Riley v. Nat’l Fed’n of the Blind of N.C., Inc.*, 487 U.S. 781, 796 (1988) (“But even assuming, without deciding that such speech in the abstract is indeed merely commercial, we do not believe that the speech retains its commercial character when it is inextricably intertwined with otherwise fully protected speech.”).

²⁰⁹ *Id.* at 795.

²¹⁰ *Id.* at 796–97.

²¹¹ *Id.* at 798–98.

²¹² *Id.* at 784.

²¹³ *Id.* at 782.

²¹⁴ 444 U.S. 620 (1980).

²¹⁵ *Id.* at 622–24.

²¹⁶ *Id.* at 621.

would likely cease.”²¹⁷

The analogy to trademarks is rather clear in this context. Although trademarks may refer to a particular product or service, that product or service is not of necessity a purely commercial object. Further, even if the product or service is a commercial object, the trademark itself can be, or can become, a symbolic referent and not a mere sales pitch. Consider, for instance, Mickey Mouse. The iconic mouse ears certainly represent a vast commercial empire generally, and specifically operate as a functional trademark for Mickey Mouse cartoons and merchandise.²¹⁸ However, is there not much more of cultural significance to the mark than mere commercial value? The mouse ears represent something culturally – about childhood, about America, and about art – that is much more than merely a piece of commercial information.²¹⁹

At a certain point, very fortunate trademark holders find themselves in the position of carefully policing the public use of their marks to prevent things such as genericide.²²⁰ While there are commercial genericides, such as when Coke ensures that people do not use the term “coke” to refer generically to all soda when placing an order at a restaurant,²²¹ there are cultural genericides as well. Today, when one wishes to find an answer to a question, one “googles” it.²²² Popularly, this means to actually use Google.com, but it also refers to a general practice of checking the Internet for information.²²³ The mark of Levis on

²¹⁷ *Id.* at 632.

²¹⁸ See Bruce David Forbes, *Mickey Mouse as Icon: Taking Popular Culture Seriously*, 23 *WORD & WORLD* 242, 242 (2003) (explaining that Mickey Mouse’s “trademarked ears . . . have come to symbolize all things Disney.”).

²¹⁹ *Id.*

²²⁰ 2 MCCARTHY, *supra* note 24, §12.1 (“[I]f one seller develops trademark rights in a term which a majority of the relevant public then appropriates as the name of a product, the mark is a victim of ‘genericide’ and trademark rights may cease. That is, once declared to be a generic name, the designation enters the ‘linguistic commons’ and is free for all to use.”).

²²¹ See *id.* §12.4 (discussing examples of genericide among commonly used products).

²²² GOOGLE, https://www.google.com/?gws_rd=ssl (last visited Apr. 25, 2015). I am opining here that “googling” can be like a genericide because, to date, there has been no challenge to the Google mark on the grounds that it has become generic.

²²³ See *Google*, OXFORD DICTIONARIES, http://www.oxforddictionaries.com/us/definition/american_english/google (last visited Apr. 25, 2015) (defining the term “googling” as “[s]earch[ing] for information about (someone or something)

blue jeans meant something about American freedom and society during the Cold War that was much more than a mark guaranteeing the quality of a pair of pants.²²⁴

More recently, the Patent and Trademark Office allowed the registration of “I Love Boobies” for bracelets and sunglasses.²²⁵ This phrase is intended to elevate awareness about Breast Cancer.²²⁶ The Third Circuit had occasion to consider whether a bracelet bearing this mark was protected speech when a student wore one in school.²²⁷ It held that, even if the phrase were vulgar, since it was used in connection to a social issue, it would be protected.²²⁸

My point here is that the bracelet, a commercial good, became more than a mere commercial good by virtue of its reference to a larger social movement. By serving as a symbol to cultural and political movements, religions, or any other meaningful social structure, what may seem to be a mere commercial object is transformed into an expressive, meaningful cultural artifact.

Therefore, regulation of commercial speech should not be reviewed under a lesser scrutiny when “it is inextricably intertwined with otherwise fully protected speech.”²²⁹ Further:

[W]here . . . the component parts of a single speech are inextricably intertwined, we cannot parcel out the speech, applying one test to one phrase and another test to another phrase. Such an endeavor would be both artificial and impractical. Therefore, we apply our

on the Internet . . .”).

²²⁴ See *Throwback Thursday: 5 Moments in Denim History that Symbolized Progress*, LEVI STRAUSS & CO. UNZIPPED (Oct. 16, 2014), <http://www.levistrauss.com/unzipped-blog/2014/10/5-moments-in-denim-history/> (providing several historical examples of how denim jeans have “served as a powerful symbol of social advancement embodying rebellions, revolution and progress since their creation”).

²²⁵ The trademark “I LOVE BOOBIES” was registered on April 23, 2013 and was assigned registration number 4322785. See *Trademark Electronic Search System (TESS)*, U.S. PAT. & TRADEMARK OFF., <http://tmsearch.uspto.gov/bin/showfield?f=doc&state=4810:q1j48a.2.1> (last visited Apr. 25, 2015) (providing a complete record of the trademark’s registration).

²²⁶ See *I Love Boobies!*, KEEP A BREAST FOUND., <http://www.keep-a-breast.org/programs/i-love-boobies/> (last visited Apr. 25, 2015) (explaining that the “i love boobies!” outreach and awareness program “has brought the subject of early onset breast cancer to the national media”).

²²⁷ B.H. ex rel Hawk v. Easton Area Sch. Dist., 725 F.3d 293, 297–98 (3d Cir. 2013).

²²⁸ *Id.* at 298.

²²⁹ *Riley v. Nat’l Fed’n of the Blind of N.C., Inc.*, 487 U.S. 781, 796 (1988).

test for fully protected expression.²³⁰

However, there is at least one limit on the intertwined speech doctrine.²³¹ In *Board of Trustees of the State University of New York v. Fox*,²³² the Court did uphold a University ban on Tupperware parties on the grounds that the social & political messages that were uttered at the Tupperware parties were not inextricably tied to the commercial speech.²³³ In part, the Court nodded to the idea that there was no compulsion to convey either the commercial or noncommercial elements, making the case less easily fit into the doctrine.²³⁴ The essential contribution of *Fox* to the doctrine of intertwined speech is that the commercial elements of speech must be non-trivial and integral to the overall communication.²³⁵ This is to say that the commercial and noncommercial elements must be of a single piece.²³⁶ The Court observed that:

No law of man or of nature makes it impossible to sell housewares without teaching home economics, or to teach home economics without selling housewares. Nothing in the resolution prevents the speaker from conveying, or the audience from hearing, these noncommercial messages, and nothing in the nature of things requires them to be combined with commercial messages.²³⁷

This limitation on the intertwined speech doctrine does not appear to disturb the argument presented here, however. In the case of achieving national recognition for a trademark, a “law of man” does make it very difficult to operate if you intend to use a “scandalous” or “disparaging” word as part of your intertwined message. Although the state does not compel any part of a trademark directly, through the creation of a federally-protected, otherwise private context, a trademark owner who cannot register does indeed face serious consequences.²³⁸ The necessary

²³⁰ *Id.* at 796.

²³¹ 492 U.S. 469 (1989).

²³² *See id.* at 473–74 (discussing an exception to the intertwined speech doctrine).

²³³ *Id.*

²³⁴ *Id.* at 474–75.

²³⁵ *Id.* at 475.

²³⁶ *Id.*

²³⁷ *Id.* at 474.

²³⁸ *See In re Tam*, No. 2014-1203, 2015 WL 1768940, at *10 (Fed. Cir. Apr. 20, 2015) (dictum) (“While the denial of registerability and the attendant rights of protection both federal and state do not prevent a trademark owner from using its mark, such denial severely burdens use of such marks.”), *reh’g*

side effect of this state prohibition on scandalous and disparaging marks surely would be the chilling of speech.²³⁹ Section 2(a) is a *de facto* compulsion of silence that falls squarely within the doctrine as outlined in *Riley*.²⁴⁰

Outside of trademarks, there have been a number of cases in the circuits wrestling with the commercial/noncommercial issue presented in *Riley* and *Fox*. For instance the Ninth Circuit found that a commercially available magazine on the topic of classic films with noncommercial elements qualified for full First Amendment protection.²⁴¹ The court did not ask whether the magazine could have written an article commenting on classic films and famous actors without introducing a commercial element, such as the display of current designer fashions, or whether the display of current designer fashions itself deserved full First Amendment protection.²⁴² Instead, it focused on whether the blending of commercial and noncommercial elements in the article and photograph created a noncommercial whole.²⁴³ The Ninth Circuit ruled that it did.²⁴⁴

In a case involving sales of t-shirts printed with messages, the Seventh Circuit found the sale of the shirts to constitute a fully protected speech interest despite the mixture of commercial and noncommercial elements.²⁴⁵ And it did so almost without acknowledging the mixed nature of the speech.²⁴⁶

In a different case, the City of Chicago tried to use its “Peddlers’ Ordinance” to prevent an advocate of marijuana legalization from selling message-laden shirts within certain districts of the city, which included Grant Park and its

granted, 600 F. App’x 775 (Fed. Cir. Apr. 27, 2015).

²³⁹ See *Tam*, 2015 WL 1768940, at *10 (dictum) (“Section 2(a)’s content-based restrictions on registerability were adopted to reduce use of trademarks the government deemed unsuitable (such as those that disparage)—no doubt a chilling effect on speech”).

²⁴⁰ See *supra* notes 209–13 and accompanying text.

²⁴¹ *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1184 (9th Cir. 2001).

²⁴² See *id.* at 1184 (discussing the issue at hand and how the court decided to address the question).

²⁴³ *Id.*

²⁴⁴ *Id.* at 1189.

²⁴⁵ *Ayres v. City of Chicago*, 125 F.3d 1010, 1017 (7th Cir. 1997).

²⁴⁶ *Id.* at 1015. It should be noted that the *Ayres* court did not specifically rely on *Riley* for its holding. However, the holding nonetheless fits into the doctrine set forth by *Riley*.

surrounds.²⁴⁷ In affirming a preliminary injunction allowing the sale of the shirts pending further adjudication of the constitutionality of the statute, the court stated:

The T-shirts that the plaintiff sells carry an extensive written message of social advocacy; they are the equivalent of the sandwich boards that union pickets sometimes wear . . . [T]here is no question that the T-shirts are a medium of expression prima facie protected by the free-speech clause of the First Amendment, and they do not lose their protection by being sold rather than given away.²⁴⁸

There has also been activity in distinguishing commercial and noncommercial trademarks as part of the Federal Trademark Dilution Act (FTDA).²⁴⁹ The FTDA explicitly exempts from coverage any “noncommercial” use of a trademark.²⁵⁰

In passing the FTDA, Congress’s carve out for noncommercial uses of trademarks, likely shorthand for First Amendment protected uses,²⁵¹ was an acknowledgment that the use of trademarks is not always of a purely commercial nature. Of course the FTDA is meant to prohibit non-trademark owners from diluting the value of a holder’s mark, thus not contemplating that an original use is either commercial or noncommercial.²⁵² Nonetheless, that a non-holder would seek to use a registered trademark for an expressive purpose implies that there must be at least some expressive content in a trademark that the non-holder seeks to leverage for his own

²⁴⁷ *Id.* at 1012.

²⁴⁸ *Id.* at 1014.

²⁴⁹ Federal Trademark Dilution Act (FTDA) of 1995 § 3(a), 15 U.S.C. § 1125(c) (Supp. 2013). *See also* Patrick D. Curran, Comment, *Diluting the Commercial Speech Doctrine: “Noncommercial Use” and the Federal Trademark Dilution Act*, 71 U. CHI. L. REV. 1077, 1081–82 (2004) (discussing the FTDA’s impact on the commercial/ noncommercial distinction).

²⁵⁰ 15 U.S.C. § 1125(3)(c)(3).

²⁵¹ *See* Am. Family Life Ins. Co. v. Hagan, 266 F. Supp. 2d. 682, 695 (N.D. Ohio 2002) (“[W]hen Congress passed the Federal Trademark Dilution Act . . . it used the phrase “noncommercial use” as a somewhat inexact, shorthand reference to “speech protected by the First Amendment.”); *see also* Curran, *supra* note 249, at 1082 (“In the abstract, courts agree that the FTDA’s “noncommercial use” exemption is a catch-all for First Amendment concerns reflecting the Supreme Court’s distinction between protected noncommercial speech and less-protected commercial speech.”).

²⁵² *See* Stacey L. Dogan & Mark A. Lemley, *The Trademark Use Requirement in Dilution Cases*, 24 SANTA CLARA HIGH TECH. L.J. 541, 545 (2007) (explaining that the FTDA only contemplated commercial speech).

ends.

Certainly, some trademarks contain very little, if any, expressive aspects. But other trademarks may have a large degree of expressive content.²⁵³ Consider again, for instance *In Re Geller*, in which registration was denied for the mark “Stop the Islamisation of America” on the grounds that it was a disparagement prohibited under § 2(a).²⁵⁴ Also consider *In Re Old Glory*, a case in which registration was actually permitted for a trademark on condoms bearing the stars and stripes of the United States flag.²⁵⁵ Reconsider also the mark “I Love Boobies.”²⁵⁶ There, the Third Circuit held that even if the phrase was lewd or vulgar, that it referenced a social issue meant that it was fully protected speech, even in a school context.²⁵⁷

Somewhat parallel to the idea of the intertwined speech, is the Federal Circuit’s doctrine relating to dual meanings in trademarks.²⁵⁸ In *In re Mavety Media Group Ltd.*, the publisher of Black Tail magazine appealed the decision of the PTO to refuse registration of its mark on the grounds that it was immoral or scandalous material.²⁵⁹ During the review and appeal process the appellate board noted that while one dictionary meaning of “tail” meant sexual intercourse, there were at least two competing definitions that also made sense in the context of the magazine (a woman’s rear end, and the tails of an evening coat), neither of which were immoral or scandalous.²⁶⁰ Thus, a mark that is a double entendre may be registrable, since it arguably has a second, dual meaning.²⁶¹ Couldn’t this reasoning be extended by analogy to increase the scrutiny level for marks

²⁵³ See *infra* notes 254–57 and accompanying text.

²⁵⁴ *In re Geller & Spencer*, No. 77940879, 2013 WL 2365001, at *12 (T.T.A.B. Feb. 7, 2013).

²⁵⁵ *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1993 WL 114384, at *6 (T.T.A.B. 1993).

²⁵⁶ See *B.H. ex rel Hawk v. Easton Area Sch. Dist.*, 725 F.3d 293, 300–01 (3d Cir. 2013) (challenging a school district’s ban on students wearing bracelets with the trademark “I Love Boobies.”).

²⁵⁷ *Id.* at 298.

²⁵⁸ See *generally In re Mavety Media Grp. Ltd.*, 33 F.3d 1367 (Fed. Cir. 1994) (discussing the Federal Circuit’s doctrine relating to dual meanings in trademarks).

²⁵⁹ *Id.* at 1375.

²⁶⁰ *Id.* at 1369.

²⁶¹ See *id.* at 1369, 1375 (discussing the double meaning of the phrase “Black Tail” and vacating the Board’s decision denying registration of the trademark).

that have a dual message content: both commercial and non-commercial?

IV. TRADEMARKS AS A LIMITED PUBLIC FORUM

Trademarks can be construed as a limited public forum in two different ways. First, assuming that trademarks are protected as either non-commercial or intertwined speech, it seems reasonable that the federal franchise granted to mark holders can be construed as a limited public forum. Thus, to discriminate against immoral or disparaging marks runs up against the constitutional prohibition on viewpoint discrimination.²⁶²

However, it is also possible to hold that the actual *register* of trademarks constitutes the forum.²⁶³ Sonya Katyal, agreeing that federally registered trademarks constitute a limited public forum in this sense, has argued that the government is within its rights to prohibit “immoral,” “scandalous” or “disparaging” marks.²⁶⁴ Katyal draws an analogy to vanity license plates, and the fact that courts have been inclined to hold that vanity plates count as a limited forum subject to substantial government control.²⁶⁵ Katyal’s argument verges very closely on a justification that the *McGinley* court found to be important in the area of § 2(a) refusals.²⁶⁶

Essentially, the argument goes that if the government allows registration of these marks, it is giving its imprimatur to the

²⁶² See Jeffrey Lefstin, *Does the First Amendment Bar Cancellation of Redskins?*, 52 STAN. L. REV. 665, 703 (2000) (“[R]estrictions based on viewpoint are generally impermissible in all three kinds of fora.”).

²⁶³ *Id.* at 706.

²⁶⁴ Sonia K. Katyal, *Trademark Intersectionality*, 57 UCLA L. REV. 1601, 1675–76 (2010).

²⁶⁵ *Id.* at 1677. See also *Byrne v. Rutledge*, 623 F.3d 46, 54 (2d Cir. 2010) (“[V]anity plates are a highly limited and extremely constrained means of expression . . . vanity plates [are] a nonpublic forum.”); *Pruitt v. Wilder*, 840 F. Supp. 414, 417 n.2 (E.D. Va. 1994) (“The Court does not actually hold in this case that a CommuniPlate issued by DMV is a non-public forum, but rather assumes that the plates are non-public in rendering a decision on the immediate motion.”); *Kahn v. Dep’t of Motor Vehicles*, 20 Cal. Rptr. 2d 6, 10 (Cal. Ct. App. 1993) (stating that vanity plates are “expressive conduct, not speech” and discussing substantial government interests in the regulation of license plates). *But see Ariz. Life Coal. Inc. v. Stanton*, 515 F.3d 956, 967 (9th Cir. 2008) (finding that the addition of a logo to a vanity plate pushed the license plate into being primarily private speech.).

²⁶⁶ Katyal, *supra* note 264, at 1686–89.

“immoral” or “disparaging” plates.²⁶⁷ Since the registration is a service offered by the state in a proprietary capacity, it is at liberty to not grant that privilege when it would appear to function as a stamp of approval.²⁶⁸

Katyal is of the opinion that the federal registration of trademarks creates a forum in which people do not have absolute free speech rights.²⁶⁹ The cases Katyal relies upon found it to be proper for the government to protect people from “indecent” speech and to avoid placing the state imprimatur on such speech.²⁷⁰

However, there is an important distinction here, one which Katyal does acknowledge in passing. License plates are a creature totally of government manufacture.²⁷¹ One cannot legally drive a car on a public road without applying to the government for permission and affixing a government registration tag on the vehicle.²⁷² The plate is not a blank slate on which one may express one’s self, but a state-issued information placard used for law enforcement purposes.²⁷³

Trademarks, arising as they do from actual use, preexist federal recognition.²⁷⁴ The Lanham Act provides a mechanism for registering trademarks that happen to be used in interstate commerce and to protect interstate commerce by providing federal protection for trademarks that are registered because they are used in interstate commerce.²⁷⁵ One acquires a trademark through use in commerce.²⁷⁶ A state or the federal

²⁶⁷ *Id.* at 1679.

²⁶⁸ *See id.* at 1678 (discussing the government interest in disassociating the state from appearing to condone such speech). This was also discussed in the section applying the Unconstitutional Conditions doctrine to trademarks as commercial speech. *See* discussion *supra* Part III.C.

²⁶⁹ Katyal, *supra* note 264, at 1677–78.

²⁷⁰ *Id.* at 1678.

²⁷¹ *Id.* at 1680.

²⁷² *See Registration & Plates*, 4DMV.COM, http://www.4dmv.com/df_regdntitling_registration_and_plates.php (last visited Apr. 25, 2015) (stating that vehicles driven on state roadways “must be registered and plated to ensure that they are legally operable”).

²⁷³ Katyal, *supra* note 264, at 1677.

²⁷⁴ *See* 3 MCCARTHY, *supra* note 24, § 19:8 (providing a discussion of this principle). The point, here, is that the government, federal or state, becomes involved after a mark has been put into use. License plates only exist after a government mandates them.

²⁷⁵ 15 U.S.C. § 1052(f) (2012).

²⁷⁶ U.S. PATENT & TRADEMARK OFFICE, PROTECTING YOUR TRADEMARK:

government then chooses to recognize that trademark when contested or offered for registration.²⁷⁷

This is a major distinction: the social field of trademarks already exists – the federal government has chosen to regulate and provide an enforcement mechanism for these property rights and speech when used in interstate commerce.²⁷⁸ Thus it is the market for trademarks that constitutes the forum, and not the physically recorded government register. Given that the government has interfered in a preexisting market in a way in which it protects some state-created trademark property rights but not others, is it proper to regulate speech – even ostensibly commercial speech – by virtue of its content?

Further, even granting that the register constitutes the forum in question, Katyal tries to frame a vanity plate as obviously a personal expression in the same way that a trademark is a personal expression in order to demonstrate that the government is not foreclosed by the First Amendment from §2(a) prohibitions.²⁷⁹ This argument, though interesting, does not disturb a crucial distinction between vanity plates and trademarks. License plates are obviously government property to anyone who looks at them. Plates bear the very name of the state directly on their face.²⁸⁰ The system of trademark registration is a largely invisible process that only becomes relevant during legal proceedings.²⁸¹ When the public looks at a given trademark, the state's imprimatur is certainly one of the last things they would think of.

Katyal does ultimately provide a very interesting approach to framing § 2 inquiries, where the government's power is

ENHANCING YOUR RIGHTS THROUGH FEDERAL REGISTRATION 9 (2014), available at <http://www.uspto.gov/sites/default/files/trademarks/basics/BasicFacts.pdf>.

²⁷⁷ *Id.* at 18.

²⁷⁸ *Id.* at 9–10.

²⁷⁹ Katyal, *supra* note 264, at 1679–80.

²⁸⁰ See *Fast Facts Study Guide (State License Plates)*, THEUS50.COM, <http://www.theus50.com/licenses-state.php> (last visited Apr. 25, 2015) (providing a complete list of all state license plates with images).

²⁸¹ See *Overview of Trademark Law*, HARV. L. SCH., <https://cyber.law.harvard.edu/metaschool/fisher/domain/tm.htm> (last visited Apr. 25, 2015) (“Although registration with the PTO is not required for a trademark to be protected, . . . [r]egistration allows a party to bring an infringement suit . . . [and] to potentially recover treble damages, attorneys fees, and other remedies.”).

presumed.²⁸² Unfortunately, that power to regulate trademarks under a limited public forum theory is not persuasive. Thus, a restriction on “immoral” or “disparaging” trademarks constitutes viewpoint discrimination. Eugene Volokh echoed this sentiment when he wrote on the refusal to register “Stop the Islamisation of America”:

Trademark registration . . . is a government benefit program open to a wide array of speakers with little quality judgment. Like other such programs . . . it should be seen as a form of “limited public forum,” in which the government may impose content-based limits but not viewpoint-based ones. An exclusion of marks that disparage groups while allowing marks that praise those groups strikes me as viewpoint discrimination.²⁸³

The Lanham Act endows registrants with government-guaranteed legal rights in connection with the words and symbols by which they are recognized in society.²⁸⁴ Particularly in a globalized, interconnected society, the brand of an entity is a significant component of how it speaks to society.²⁸⁵ Discriminating against marks as “immoral” or “disparaging” can be nothing short of viewpoint discrimination.

V. CONCLUSION: A MAJOR PROBLEM FOR THE PTO AND TTAB

If, as the foregoing analysis suggests, trademarks will qualify as intertwined speech, the Unconstitutional Conditions doctrine will require that a § 2(a) refusal necessarily involved a First Amendment analysis. However, in *Harjo I*, the TTAB explicitly noted that it is not competent to consider constitutional

²⁸² See generally Katyal, *supra* note 264, at 1675–81 (discussing vanity plates).

²⁸³ Eugene Volokh, *Federal Appellate Court Rejects ‘Stop the Islamization of America’ Trademark*, WASH. POST, May 13, 2014, <http://www.washingtonpost.com/news/volokh-conspiracy/wp/2014/05/13/federal-appellate-court-rejects-stop-the-islamization-of-america-trademark/>.

²⁸⁴ See *supra* notes 29–32 and accompanying text.

²⁸⁵ See *Patent Reform: Protecting Innovation and Entrepreneurship: Hearing Before the S. Comm. on Small Bus. & Entrepreneurship*, 114th Cong. (2015) (statement of Robert Schmidt, Co-Chair, Small Bus. Tech. Council), available at <http://sbtc.org/wp-content/uploads/2015/03/Testimony-of-Robert-N.Schmidt-to-Senate-SBE-3-16-2015-as-submitted-rev.pdf> (“Intangible assets including corporate IP and brand recognition account for 84 percent of the value of U.S. public companies.”).

questions.²⁸⁶ Thus, § 2(a) disputes could no longer be resolved by the PTO or TTAB.²⁸⁷

Therefore, there are at least three distinct options available with respect to § 2(a) denials. First, all § 2(a) denials could be recommendations by the PTO that are referred to a district court. Alternatively, there could be introduced some mechanism for the PTO and TTAB to petition the district court for a finding of whether a trademark before it constitutes protected speech.

Second, Congress can amend the Lanham Act to bring it up to date with contemporary First Amendment jurisprudence. One way of doing this would be to change the definition of “scandalous,” “immoral,” and “disparaging” to collectively mean “obscenity.” By doing this, the PTO and TTAB could simply apply the existing *Miller* test to determine if a trademark does not qualify for registration.²⁸⁸ Under this test, the PTO or TTAB would inquire:

- (a) whether the average person, applying contemporary community standards would find that the work, taken as a whole, appeals to the prurient interest; (b) whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law; and (c) whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value.²⁸⁹

Although there is some degree of constitutional interpretation here, the *Miller* test controlling the obscenity determination is relatively straightforward. It is generally hard-core pornography that has qualified as “obscene” and not merely offensive words.²⁹⁰ For instance, saying “fuck you” while extending the middle-finger to a group of protesters was not “obscene.”²⁹¹ Similarly, swearing profusely at a police officer while offensively gesturing was not

²⁸⁶ *Harjo v. Pro Football, Inc.*, 30 U.S.P.Q.2d 1828, 1994 WL 262249, at *6 (T.T.A.B. 1994).

²⁸⁷ *Id.*

²⁸⁸ See generally Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661 (1993) (providing further discussion of the application of the *Miller* test to trademark registration disputes).

²⁸⁹ *Miller v. California*, 413 U.S. 15, 24 (1973).

²⁹⁰ See *id.* at 25 (giving two examples which fall under “obscene” and which include characteristics of hard-core pornography).

²⁹¹ See *Sandul v. Larion*, 119 F.3d 1250, 1255 (6th Cir. 1997) (applying the objective reasonableness standard and determining that the speech was entitled to “First Amendment protection with the exception of fighting words”).

“obscene.”²⁹² However, videotapes containing graphic depictions of urination, masturbation, oral sex, and anal sex were “obscene.”²⁹³

What is clear, and will clarify the “scandalous” or “disparaging” ambiguity at present, is that while “obscene” speech may be curtailed, merely “indecent” speech cannot be restricted by virtue of its content.²⁹⁴ Importantly, sexual expression may be “indecent” and not “obscene,” and thus deserve protection.²⁹⁵ For instance, in *Reno v. American Civil Liberties Union*,²⁹⁶ the Court noted that ambiguous legislation that curtails “indecent” sexual speech deserves heightened scrutiny when it held:²⁹⁷ “[i]n evaluating the free speech rights of adults, we have made it perfectly clear that ‘[s]exual expression which is indecent but not obscene is protected by the First Amendment.’”²⁹⁸

This approach to solving the problem will require either a command from the Supreme Court or a revision from Congress.²⁹⁹ In *McGinley*, the court explicitly refused to apply the obscenity standards from the Supreme Court to § 2(a) on the grounds that the Lanham Act does not itself use the word “obscenity.”³⁰⁰ Instead, the definition of scandalous must be derived from the “‘ordinary and common meaning’ of that term,” the sources of which standard arising from the dictionary meaning as well as, somewhat circularly, the decisions of the PTO board itself.³⁰¹

The third possibility is that § 2(a) will be struck down as

²⁹² See *Duran v. City of Douglas*, 904 F.2d 1372, 1378 (9th Cir. 1990) (finding that plaintiff’s speech fell “squarely within the protective umbrella of the First Amendment”).

²⁹³ See *U.S. v. Schein*, 31 F.3d 135, 137–38 (3d Cir. 1994) (explaining that obscene material is no less obscene because it is viewed only by consenting adults).

²⁹⁴ See *Sable Commc’ns of Cal., Inc. v. F.C.C.*, 492 U.S. 115, 126 (1989) (“Sexual expression which is indecent but not obscene is protected by the First Amendment . . .”).

²⁹⁵ *Id.*

²⁹⁶ 521 U.S. 844 (1997).

²⁹⁷ See *id.* at 845–46 (analyzing the statute with heightened scrutiny because “[t]he vagueness of such a content-based restriction, coupled with its increased deterrent effect as a criminal statute, raises special First Amendment concerns because of its obvious chilling effect on free speech”) (internal citation omitted).

²⁹⁸ *Id.* at 874–75.

²⁹⁹ See *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981) (refusing to apply an analogy of the language of Section 2(a) to the obscenity cases).

³⁰⁰ *Id.*

³⁰¹ *Id.*

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unconstitutional. The animating purpose of the Lanham Act is to prevent confusion between trademarks.³⁰² The ban on scandalous and disparaging marks bears little, if any, relation to that purpose. This is particularly so in light of the above noted mootness of the government interests in the prohibition.³⁰³ Thus, the provision is likely separable, and striking it down will not do harm to the rest of the Lanham Act.

³⁰² Lanham Act, Pub. L. No. 79-489, § 45, 60 Stat. 427, 444 (1946) (codified as amended at 15 U.S.C. § 1127 (2012)) (“The intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in commerce . . . to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks.”).

³⁰³ See discussion *supra* Part IV.