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## Standing to Oppose Scandalous or Immoral Trademarks: *Bromberg v. Carmel Self Service, Inc.*, Opp. No. 59,979 (T.T.A.B. Mar. 28, 1978)

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## Standing to Oppose Scandalous or Immoral Trademarks

*Bromberg v. Carmel Self Service, Inc.*, Opp. No. 59,979 (T.T.A.B. Mar. 28, 1978).

### I. INTRODUCTION

Recently, the Trademark Trial and Appeal Board granted standing to two women to oppose the registration of an applicant's mark.<sup>1</sup> The opposers asserted that the registration of the applicant's mark<sup>2</sup> is prohibited by section 2(a) of the Lanham Act<sup>3</sup> in that the mark comprises immoral and scandalous matter, and that the services for which it was sought to be registered had not been performed in interstate commerce as required by section 1<sup>4</sup> of the Lanham Act.<sup>5</sup> The Board granted standing under section 13<sup>6</sup> of the Act on the basis that the women had demonstrated a real interest in the proceeding and believed that they would be damaged by the registration of the applicant's mark. In so doing, the Board allowed the opposition to be heard on grounds other than fear of commercial or economic damage or damage to the opposer's property interest in a similar or identical mark. This has raised important questions regarding the scope of section 2(a), the purposes of the Lanham Act, the nature of the interests so protected, and the scope of section 13 of the Lanham Act and its provisions relating to an opposer's standing.

In *Bromberg v. Carmel Self Service, Inc.*,<sup>7</sup> the applicant, doing

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1. *Bromberg v. Carmel Self Serv., Inc.*, Opp. No. 59,979 (T.T.A.B. Mar. 28, 1978) (memorandum denying motion to dismiss).
  2. The mark is a slogan which consists of the words "[o]nly a breast in the mouth is better than a leg in the hand." *Bromberg v. Carmel Self Serv., Inc.*, Opp. No. 59,979, slip op. at 1.
  3. 15 U.S.C. § 1052(a) (1976) (Lanham Act, ch. 540, § 2(a), 60 Stat. 427 (1947)).
  4. 15 U.S.C. § 1051 (1976).
  5. *Bromberg v. Carmel Self Serv., Inc.*, Opp. No. 59,979, slip op. at 1.
  6. 15 U.S.C. § 1063 (1976).
  7. Opp. No. 59,979 (T.T.A.B. Mar. 28, 1978) (memorandum denying motion to dismiss).

business as Stuart's Chicken House, filed an application to register the slogan "ONLY A BREAST IN THE MOUTH IS BETTER THAN A LEG IN THE HAND" as a mark for its restaurant services.<sup>8</sup> After the Examiner of Trademarks found the mark to be registrable<sup>9</sup> it was published in the *Official Gazette*.<sup>10</sup> Notice of opposition was then filed by Marion Bromberg and Judith Horvitz.<sup>11</sup> They asserted that

registration of applicant's mark is believed to be prohibited by Section 2(a) in that it comprises immoral and scandalous matter, disparaging to all people of a specific class, and in particular, women, in that it has false connotations and brings individuals, especially women, into contempt and disrepute; that the obvious double entendre of the mark indicates that it is lewd, lascivious, indecent, obscene, worthless, depraved, chauvinistic, degrading, and has no commercial value, and that the granting of a registration therefor unnecessarily lowers the standards of the United States Government, in particular, the United States Patent Office.<sup>12</sup>

The opposers also filed affidavits from various women's organizations supporting the opposers' assertions as to the nature of the applicant's mark.<sup>13</sup>

The case came before the Trademark Trial and Appeal Board on the applicant's motion to dismiss the opposition on the grounds that the opposers lacked the requisite standing under section 13 of the Lanham Act. The applicant argued that the opposers were neither engaged in a commercial activity nor had they demon-

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8. *Id.*, slip op. at 1.

9. Section 12(a) of the Lanham Act provides:

Upon the filing of an application for registration and payment of the fee provided in this chapter, the Commissioner shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and, if on such examination it shall appear that the applicant is entitled to registration, the Commissioner shall cause the mark to be published in the *Official Gazette of the Patent and Trademark Office* . . . .

15 U.S.C. § 1062(a) (1976).

Thus, the mark is not published unless and until the examiner has determined (1) that the applicant has met all of the formal requirements of the statute and (2) that the mark is not within the prohibitions of the statute. This would include a determination by the examiner that the mark is not immoral or scandalous.

10. The publication process is provided for in 15 U.S.C. § 1062(a) (1976). See note 9 *supra*.

11. *Bromberg v. Carmel Self Serv., Inc.*, Opp. No. 59,979, slip op. at 1.

12. *Id.* at 1-2.

13. *Id.* at 2. Included were affidavits from the Chicagoland Women's Federal Credit Union, Women In Management, and the executive and managing editors of She Publications, Ltd., which stated that the applicant's slogan "is scandalous, offensive to a segment of the public sense of propriety or morality, lacking in taste, indelicate and morally crude." Notice of Opposition at 2, *Bromberg v. Carmel Self Serv., Inc.*, Opp. No. 59,979 (T.T.A.B. Mar. 28, 1978) (memorandum denying motion to dismiss) [hereinafter cited as Notice of Opposition].

strated that the registration of the mark would damage them.<sup>14</sup> In deciding the motion, the Board refused to consider damages asserted by the opposers on behalf of other persons or groups as a class.<sup>15</sup> It also indicated that while oppositions predicated on sections 2(d)<sup>16</sup> and 2(e)<sup>17</sup> require some type of commercial damage, "it is not necessarily true as to Section 2(a) which precludes registration of, inter alia, marks which 'consist of or comprise immoral, deceptive or scandalous matter.'"<sup>18</sup> The Board then evaluated the standing issue in terms of whether the opposers had demonstrated a real interest in the matter. The Board reasoned that the omission of a class action provision under section 13 coupled with the nature of the prohibition of section 2(a) "can lead to only one conclusion. That is, the instant opposers who are persons within the meaning of Section 13 and members of a group who may believe the mark to be scandalous have the requisite standing to be heard on the question . . . [of the registrability of the mark]."<sup>19</sup> Concerning the applicant's contention that the opposers had failed to demonstrate that they would be damaged, the Board simply stated that "[s]ection 13 requires only that an opposer believe that it would be damaged. Establishing such damage is a matter for proof."<sup>20</sup>

Section 2 of the Lanham Act provides:

No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) . . . .

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office or a mark or a trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive . . . .

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14. *Bromberg v. Carmel Self Serv., Inc.*, Opp. No. 59,979, slip op. at 2.

15. *Id.* at 4. See also *National Ass'n of Blue Shield Plans v. Standard Mattress Co.*, 176 U.S.P.Q. 29 (T.T.A.B. 1972), in which the Board states that the opposer had "failed to state a justiciable controversy for the reason that opposer does not include itself as one of those who would be 'adversely affected' by the registration . . . ." *Id.* at 30.

16. 15 U.S.C. § 1052(d) (1976).

17. *Id.* § 1052(e).

18. *Bromberg v. Carmel Self Serv., Inc.*, Opp. No. 59,979, slip op. at 4.

19. *Id.* at 7.

20. *Id.*

(e) Consists of a mark which, (1) when applied to the goods of the applicant is merely descriptive or deceptively misdescriptive of them, or (2) . . . is primarily geographically descriptive or deceptively misdescriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, or (3) is primarily merely a surname.<sup>21</sup>

Section 2(f) provides that "[e]xcept as expressly excluded in paragraphs (a), (b), (c), and (d) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce."<sup>22</sup> Section 13 of the Lanham Act provides for oppositions by third parties:

Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the required fee, file a verified opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered.<sup>23</sup>

From this statutory overview it is apparent that the Lanham Act is concerned with protecting marks from appropriation by persons or entities and preventing the resulting damage to the applicant who possesses a genuine interest in the particular mark sought to be registered. It is against this statutory background that the decision in *Bromberg* must be analyzed.

It is important to note that the refusal of a registration under the Lanham Act prevents neither the continued use of the mark by the applicant in commerce nor the public's exposure to such marks. However, it does prevent the applicant from gaining the commercial advantages of possessing a mark registered on the principal register for its goods and/or services.<sup>24</sup> In fact, it is argu-

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21. 15 U.S.C. § 1052 (1976).

22. *Id.* § 1052(f).

23. *Id.* § 1063.

24. The advantages of registration include:

(1) A federal registration [on the principal register] . . . is constructive notice to the country at large of the registrant's claim of ownership, and is not limited to a single state.

(2) The registrant of a federal trademark registration has the right to bring suit in the United States courts, regardless of the amount in controversy or the diversity of citizenship.

(3) A federal registration entitles the registrant to register his mark substantially as a matter of right in a large number of foreign countries.

(4) A federal trademark registration . . . may be filed with the Treasury Department and used to stop importations bearing infringing marks under the provisions of 19 U.S.C. § 1526, and section 42 of the Lanham Act (15 U.S.C. § 1124).

(5) The scope of marks that may be registered upon the registers provided by the Lanham Act is considerably broader than that of the marks that may be registered under any of the state registration acts.

(6) Since, unlike infringement actions under the patent and copy-

able that refusal could increase exposure since anyone could use the mark, absent a common law or state statutory cause of action. Thus, it appears that one of the few interests left to be protected is the integrity of the Patent and Trademark Office. But that interest *could* be adequately protected by the examiners whose duties include making an ex parte determination of the registrability of all marks sought to be registered on the principal register.

## II. THE STANDING ISSUE

In *Bromberg*, the Board dealt with the question of the opposers' standing by distinguishing between the type of damage required to be alleged under section 2(a) and that which has traditionally been required under the other prohibitive sections. In support of the proposition that oppositions based on section 2(a) need not allege commercial damage for the opposers to have standing under section 13, the Board relied on three principal cases.<sup>25</sup>

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right laws, the federal courts and state courts have concurrent jurisdiction in respect to trademark infringement actions, a federal registration may be relied upon, even in suits brought in state courts.

(7) The rights to relief and freedom from concern conferred upon the registrant by the Lanham Act far exceed those conferred by any state statute, except in the area of penalties, and in the concept of dilution.

A. SEIDEL, WHAT THE GENERAL PRACTITIONER SHOULD KNOW ABOUT TRADEMARKS AND COPYRIGHTS 19-20 (ALI-ABA Comm. on Continuing Prof. Educ., 3d ed. 1976). In addition, the following advantages are conferred upon a registration:

(1) A Principal Register registration obviously gives the registrant all the benefits provided for in the Act. These benefits include the right to bring suit in the federal courts without diversity or statutory amount; the ability to obtain an injunction enforceable by any district court of the United States, by proceedings to punish for contempt; and the right to recover profits and damages, . . . and destruction of infringing labels. Unlike the copyright and patent statutes, the Lanham Act has no provision for attorney fees, although on rare occasions, in statutory trademark infringement suits with aggravated circumstances, attorney fees have been awarded on a nonstatutory basis under the equity powers of the court.

(2) A Principal Register registration is prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and the registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate. It is to be emphasized that the evidentiary benefits flowing from a registration certificate are directed only to the goods or services specified in the certificate, and not to the Patent Office class within which the goods are classified.

*Id.* at 25.

25. United States *ex rel.* FBI v. Societe Anonyme Francaise M. Bril & Co., 187 U.S.P.Q. 685 (D.D.C. 1975); Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098 (C.C.P.A. 1976); Universal Oil Prods. Co. v. Rexall Drug & Chem. Co., 463 F.2d 1122 (C.C.P.A. 1972).

In *United States ex rel. FBI v. Societe Anonyme Francaise M. Bril & Co.*,<sup>26</sup> the applicant sought to register a mark which employed the letters "FBI" in the composite mark.<sup>27</sup> The United States opposed the registration on the ground that it would falsely suggest a connection with the United States government, and in particular, with the FBI. The court noted that since the applicant was a garment manufacturer and distributor there was no relation between the goods or services offered by the two organizations. The applicant's use of "FBI" in connection with its whole name was an important consideration in the court's determination. "This composite mark when considered as a whole, reduces to a bare minimum the possibility of falsely suggesting a connection with the Bureau."<sup>28</sup> The court dismissed the opposition on that basis but stated the following regarding the government's standing:

Normally an opposition to the registration of a trademark is filed by a commercial enterprise seeking to preserve and protect an economic interest. *The Trademark Act, however, makes it clear that one need not be a commercial enterprise, nor is it necessary that a commercial interest be at stake for one to object to a trademark registration.*<sup>29</sup>

In *Bromberg*, the Board relied on the above quoted language for the proposition that under section 13, commercial activity is not a prerequisite to standing to oppose a registration thought to be prohibited by section 2(a). It should be noted that while the court in the *FBI* case granted standing to the government, it did so on the basis of the government's interest in a particular designation of its own, *i.e.*, the mark "FBI." The court required that the opposer believe it would be damaged in a manner related to its use or possible association with the mark sought to be registered. Thus, there was a concern with possible confusion as to the source of the goods despite the noncommercial nature of the government's interest. The statute protects against damage from such confusion by purporting to make "actionable the deceptive and misleading use of marks in . . . commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; [and] to protect persons engaged in such commerce against unfair competition . . . ."<sup>30</sup>

The Board in *Bromberg* also cited *Federated Foods, Inc. v. Fort Howard Paper Co.*<sup>31</sup> which stated that "[a] party has standing to oppose within the meaning of Section 13 if that party can demon-

26. 187 U.S.P.Q. 685 (D.D.C. 1975).

27. "The defendant's mark . . . used the letters FBI in conjunction with three identifying words—Fabrication Bril International." *Id.* at 687.

28. *Id.*

29. *Id.* at 686 (emphasis added).

30. 15 U.S.C. § 1127 (1976).

31. 544 F.2d 1098 (C.C.P.A. 1976).

strate a *real interest* in the proceeding."<sup>32</sup> However, in *Federated Foods*, the Court of Customs and Patent Appeals was dealing with an opposition based on section 2(d) of the statute which prohibits registration of any mark which "[c]onsists of or comprises a mark which so resembles a mark registered . . . or a mark or trade name previously used in the United States by another . . . as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive."<sup>33</sup> The "real interest" in the proceeding which the court found to be dispositive of the standing issue was the opposer's property interest in its own mark. That mark was similar to the applicant's mark. The court further stated:

The record shows that opposer is the owner of registered trademarks similar to appellant's HY-TOP for goods identical to some of those described in appellant's application. Opposer's real *commercial* interest in protecting its registered marks is manifest and, in our opinion, justifies opposer's belief that it would be "damaged" by the registration.<sup>34</sup>

If, as the Board stated in *Bromberg*, there is in fact a different test for standing to oppose under section 2(a) than under section 2(d), the Board's reliance upon *Federated Foods* was misplaced. In *Federated Foods* the court was clearly dealing with a type of damage that the Act addresses.

The Board's reference to *Universal Oil Products Co. v. Rexall Drug & Chemical Co.*<sup>35</sup> seems to lend no additional support to the Board's conclusion that the opposers in *Bromberg* had standing. Indeed, it appears that the Board's references to each of the above mentioned cases was designed to establish that the test to be applied is whether or not the opposers have demonstrated a "real interest" in the proceeding. However, the court in *Universal Oil Products*, as in the other cited opinions, relied upon the opposer's property interest in the mark sought to be registered, or on the existence of impending pecuniary damage to the opposer. In *Universal Oil Products*, the Board concluded that the opposer's subsidiary had the direct interest in the mark sought to be registered and that the opposer lacked the requisite control over the subsidiary to enable it to bring the action. The Court of Customs and Patent Appeals held that the Board had applied an erroneous standard and stated that "[c]ontrol over the mark or name relied upon is not determinative of standing to oppose. . . . Standing, within the meaning of § 13 . . . is found when the opposer establishes a real interest in the proceeding."<sup>36</sup> That real interest is illustrated by the following passage:

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32. *Id.* at 1101.

33. 15 U.S.C. § 1052(d) (1976).

34. 544 F.2d at 1101 (emphasis added).

35. 463 F.2d 1122 (C.C.P.A. 1972).

36. *Id.* at 1124.



We think appellant here has at least as great a *pecuniary* interest as had the trade association in *Tanners' Council*, and, perhaps, an even greater one. As the parent corporation of a wholly owned subsidiary, appellant can reasonably believe that damage to the subsidiary will naturally lead to financial injury to itself.<sup>37</sup>

The accuracy of the Board's statement in *Bromberg* that "the fact that opposers have not based their claim of damage on their involvement in a commercial activity is not fatal to the question of standing"<sup>38</sup> is unquestioned. However, it appears that the "real interest" required by the cited decisions is something more than a requirement of disgust on the part of the opposers.

In *McKesson & Robbins, Inc. v. Isenberg*,<sup>39</sup> the Court of Customs and Patent Appeals dealt with an opposition based on the Trademark Act of 1905.<sup>40</sup> The opposer in *Isenberg* sought to prevent the registration of a mark which allegedly was merely descriptive and, therefore, unregistrable. The opposer had not been involved in the sale of goods similar or identical to those for which the applicant sought to register the mark. Therefore, the opposer had no interest in the use of the allegedly descriptive term on goods similar to those for which the registration was sought. The court in *Isenberg* stated:

[I]n the ex parte consideration of the right of an applicant to register his mark, it is the Commissioner of Patents and not the opposer who represents the public and his decision is final so far as the opposer is concerned. Therefore, appellant here cannot invoke error on the part of the tribunals of the Patent Office in its not ruling that the interest of the public at large requires rejection of the application for registration based on descriptiveness.<sup>41</sup>

Thus, it has been considered the role of the Patent and Trademark Office, and not that of a member of the public at large, to represent the public on issues of registrability under the trademark legislation.

Similarly, the Court of Customs and Patent Appeals in *United Shoe Machinery Corp. v. Compo Shoe Machinery Corp.*<sup>42</sup> indicated that standing to oppose under the Trademark Act of 1905 required a particular type of interest in the proceeding. In dealing with the opposer's assertion of damage due to the loss of the use of a descriptive term, the court stated:

The statute gives *any person* who believes he would be damaged the right to oppose . . . . These provisions are very broad and should be

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37. *Id.* (emphasis added).

38. *Bromberg v. Carmel Self Serv., Inc.*, Opp. No. 59,979, slip op. at 5.

39. 167 F.2d 510 (C.C.P.A. 1948).

40. Trademark Act of 1905, ch. 592, 33 Stat. 724 (1905). The standing provisions of the Act of 1905 were similar to those of section 13 of the Act of 1946.

41. 167 F.2d at 512.

42. 56 F.2d 292 (C.C.P.A. 1932).

broadly construed. Of course, Congress did not mean to grant these rights to a mere intermeddler . . . and thereby authorize such a person to interfere in the affairs of others and in the business of the Patent Office. Certainly the person seeking to cancel a registration or oppose an application for registration must have a greater interest than a member of the general public who by such registration suffers no invasion of his rights and privileges. It is well understood in the application of equitable remedies that one who seeks such application is bound to show an interest in a suit personal to himself and not such an interest as he has only by virtue of being a citizen.<sup>43</sup>

The traditional result has been that opposers must assert some damage personal to themselves stemming either from their proprietary interest in the use of a mark or their direct commercial/economic interest in a mark. The Board's decision in *Bromberg* to limit its consideration of damages to those "which opposers have alleged as to themselves"<sup>44</sup> is consistent with that in *Federated Foods*, which required an opposer to demonstrate a real interest in the proceeding to obtain standing. Although it is difficult to characterize any of the damages asserted by the opposers in *Bromberg* as personal to themselves, apart from their status as citizens, the Board's analysis of the issue attempts to draw a distinction between the opposers' status as women and their status as citizens.

The Board's determination of whether the opposers in *Bromberg* had demonstrated a real interest in the proceeding began with a definition of the word "scandal." "'Scandal,' is defined as 'the distressing effect on others of unseemly or unrighteous conduct . . . ; that which offends established moral conception or disgraces all who are associated or involved.' To 'scandalize' is 'to horrify or shock the moral sense of.'"<sup>45</sup> The Board reasoned that although commercial enterprises are included as persons under section 13, "it is more than likely that an individual or group of individuals might be offended by a mark which they consider to be scandalous, and that such parties were therefore certainly among those intended to be protected under Section 2(a) of the Statute."<sup>46</sup> The Board noted four decisions<sup>47</sup> in which the Examiner had refused registration on the ground that the marks were "offensive to a certain segment of the public."<sup>48</sup> The Board then posed this question:

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43. *Id.* at 295.

44. *Bromberg v. Carmel Self Serv., Inc.*, Opp. No. 59,979, slip op. at 4.

45. *Id.* at 5 (quoting WEBSTER'S NEW COLLEGIATE DICTIONARY (2d ed. 1910)).

46. *Id.* at 6.

47. *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938); *In re Runsdorf*, 171 U.S.P.Q. 443 (T.T.A.B. 1971); *In re Sociedade Agricola E. Comerical Dos Vinhos Messias*, 159 U.S.P.Q. 275 (T.T.A.B. 1968); *In re Reemtsma Cigarettenfabriken*, 122 U.S.P.Q. 339 (T.T.A.B. 1959).

48. *Bromberg v. Carmel Self Serv., Inc.*, Opp. No. 59,979, slip op. at 6.

Suppose, in each of the aforementioned cases, that the Examiner had allowed the mark to be published. Since, as noted earlier, our practice does not permit class actions but requires each opposer to be identified and to pay a fee, could every member of the Senussi sect or every Christian who reveres the Virgin Mary be required to be named as an opposer? Or would one or several members of those groups be permitted under our statute to be heard in opposition to the issuance of the registration sought?<sup>49</sup>

It seems that the Board's determination of the standing issue hinged on the definition of a group to which the opposers, two women, belonged. It is at this point that the Board's reasoning became somewhat innovative. Each of the four cases<sup>50</sup> cited by the Board were appeals from the examiners' refusals to register the applicants' marks. None of the cases involved any issue of standing under section 13. The Board's reliance on these cases to support the idea that women are a definable class of persons who are to be protected by section 2(a), apart from the public in general, is less than convincing.

One of the cited cases, *In re Riverbank Canning Co.*,<sup>51</sup> involved an appeal from the Examiner's refusal to register "MADONNA" for wine. The court's decision was not concerned with the issue of standing to oppose the registration. In *Riverbank*, the Examiner had concluded that the registration of the mark would be offensive to wine drinkers and non-drinkers alike. The Examiner was clearly acting within the statutory mandate as interpreted by judicial decisions in that "it is the Commissioner of Patents [now, the Examiner of Trademarks] and not the opposer who represents the public."<sup>52</sup> Thus, it is fully within the province and duty of the Examiner to determine the registrability of a mark considering its probable effects on the public at large.

*In re Reemtsma Cigarettenfabriken*<sup>53</sup> and *In re Sociedade Agricola E. Comerical Dos Vinhos Messias*<sup>54</sup> involved the examiners' refusals to register marks that were found to be scandalous to certain religious groups because "[t]he application of the name of any religious order or sect to a product whose use is forbidden to the followers or adherents of such sect or order is an affront to such persons and tends to disparage their beliefs."<sup>55</sup>

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49. *Id.* at 7.

50. See note 47 *supra*.

51. 95 F.2d 327 (C.C.P.A. 1938), *aff'd* 30 U.S.P.Q. 374 (Comm'r Pat. 1936).

52. *McKesson & Robbins, Inc. v. Isenberg*, 167 F.2d 510, 512 (C.C.P.A. 1948).

53. 122 U.S.P.Q. 339 (T.T.A.B. 1959).

54. 159 U.S.P.Q. 275 (T.T.A.B. 1968).

55. 122 U.S.P.Q. at 339. *In re Reemtsma* involved the Examiner's refusal to register "SENUSSI" for cigarettes due to the fact that it was also the name of a Moslem sect the adherents of which were forbidden to use cigarettes. *In re Sociedade* involved the Examiner's refusal to register "MESSIAS" for wine and brandy on the ground that the mark was the equivalent to "Christ" and that the registration was scandalous as defined by section 2(a).

In *In re Runsdorf*<sup>56</sup> the Examiner refused to register the applicant's mark "BUBBY TRAP" for brassieres. Registration was refused on the ground that the mark, as applied to brassieres, was vulgar and offensive to the public at large. Neither *Runsdorf* nor the other three cases cited by the Board as instances in which the examiners have successfully asserted the rights of the public at large or of a particular group, necessarily leads to the Board's conclusion that "the instant opposers who are persons within the meaning of Section 13 and members of a group who may believe the mark to be scandalous have the requisite standing to be heard on the question . . . ."<sup>57</sup>

It is arguable that even if women are a protected, sex-determined class under the statute, their interests should be protected by the Examiner, and the individual members should not be able to sue. However, no noted case in the area has held that women, *per se*, are a specific class or group deserving protection apart from that afforded the general public via the Examiner's duties to determine the registrability of a mark under the Lanham Act. The allegations contained in the Notice of Opposition indicate merely that the opposers in *Bromberg* "believe that they and all people of a class in general in the United States will be damaged and defamed by registration of the mark"<sup>58</sup> and that the mark "is disparaging to all people of a specific class, and in particular, women."<sup>59</sup> Nowhere is there an indication as to (1) why women are includable in a class of people who find the mark offensive and are, therefore, damaged in a manner apart from the damage to the public at large (men and women); (2) how their sex plays a part in the determination of which marks are scandalous or immoral under section 2(a) with respect to which products; or (3) why women would be damaged by immoralities or scandalous matter, and in particular the allegedly immoral mark sought to be registered in *Bromberg*, to any greater extent than are men. Thus, it appears that the opposers asserted no belief of damage beyond that which would accrue to the public at large, failed to define themselves as members of any class or group which is entitled to greater protection than the general public, and consequently, neither stated facts sufficient to give them standing under section 13, nor alleged the type of damage required thereunder.

The Board's decision addressed the scantiness of the opposers' allegations on the damage issue by stating that "[s]ection 13 requires only that an opposer believe that it would be damaged. Es-

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56. 171 U.S.P.Q. 443 (T.T.A.B. 1971).

57. *Bromberg v. Carmel Self Serv., Inc.*, Opp. No. 59,979, slip op. at 7.

58. Notice of Opposition, *supra* note 13, at 1.

59. *Id.* at 2.

tablishing such damage is a matter for proof.”<sup>60</sup> The Board failed to adequately address the existing case law which indicates that a real interest in the proceeding must be demonstrated before a person has the requisite standing to oppose a registration under section 13. The decisions cited by the Board in support of its conclusions lend little weight to its determination of the standing issue. However, they do highlight an apparent change of position on the part of the Board.

The Board’s seeming lack of decisional authority does not detract from the fact that there are major concerns involving situations in which an examiner might allow the registration of a mark that is publicly unacceptable under section 2(a). The impracticalities of requiring each member of a group that believes it would be damaged by a registration to file an opposition are obvious. And indeed, it appears that the decisions in the *FBI* and related cases<sup>61</sup> allow such organizations or groups to protect their interests in their beliefs or marks. The more perplexing situation is one in which an examiner allows a mark to be registered that is offensive to the public in general due to the morally unacceptable nature of the mark, as opposed to its particular offensiveness to any one sect or group whose beliefs are disparaged. Although the cases seem to require a particularized type of damage to be alleged by the opposer, they do not address the concern of the Board in *Bromberg* relating to the registration of a mark that is publically unacceptable under section 2(a). Thus, the Board’s decision on the standing issue does appear to enfranchise the general public by vindicating its ability to quest for morality.

### III. THE SCOPE AND APPLICABLE STANDARDS OF THE PROHIBITION OF SECTION 2(a)

In *Bromberg* the Examiner had determined that the mark was registrable under the Lanham Act, including section 2(a), and had published the mark in the *Official Gazette*. The issue of whether the mark constituted immoral and scandalous matter prohibited from registration by section 2(a) was not reached by the Board in *Bromberg*. However, the Board’s decision to grant the opposers standing under section 13 will place that issue before the Board if the litigation continues.

The determination of the question of whether a particular mark is immoral or scandalous under section 2(a) involves rather extensive reliance on the judgment of the body making the determination. McCarthy has suggested that “[g]iven the present state of

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60. *Bromberg v. Carmel Self Serv., Inc.*, Opp. No. 59,979, slip op. at 7.

61. See notes 26-37 & accompanying text *supra*.

the law of obscenity, it is difficult to conceive of many marks which could validly be rejected as being 'immoral.' Perhaps the use of the word 'immoral' itself renders that ground for the refusal of a registration void for vagueness."<sup>62</sup> Generally the determination of whether a mark constitutes immoral or scandalous matter requires consideration of the mark as applied to the goods or services for which it is sought to be registered together with a consideration of those members of the public likely to come into contact with the mark. Thus, each decision is highly dependent upon the particular facts involved and is of little precedential value to future applicants.

#### A. Marks Which Disparage or Falsely Suggest a Connection with Protected Entities

The registration of a mark which consists of a name or word of particular religious significance and which is used in a manner inconsistent with the beliefs and practices of those who attribute significance to the word or name will be refused.<sup>63</sup> Section 2(a) specifically prohibits the registration of marks "which may disparage . . . beliefs . . . or bring them into contempt or disrepute."<sup>64</sup> Thus, in *In re Reemtsma Cigarettenfabriken*,<sup>65</sup> the Trademark Trial and Appeal Board affirmed the Examiner's refusal to register the mark "SENUSSI" for cigarettes. The Board stated that "'SENUSSI' is the name of a Moslem sect whose followers and adherents are in many lands. The tenets of this religious sect forbid the use of cigarettes."<sup>66</sup> The fact that the use of cigarettes is forbidden by the sect made the use of the mark, as applied to cigarettes, disparaging to their beliefs. It should be noted that the interest involved in *Reemtsma* was directly related to the protection of the integrity of the sect's name.

Similarly, refusals to register "MADONNA"<sup>67</sup> and "MESSIAS"<sup>68</sup> for wines have been upheld by the Board on the grounds that the marks, as applied to the goods, tended to disparage beliefs held by certain groups. However, in *In re Waughtel*,<sup>69</sup> the Board reversed the Examiner's refusal to register "AMISH" for cigars and cigar boxes based upon a review of affidavits which accompa-

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62. 1 J. MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 19:27, at 704 (1973).

63. See notes 53-55 & accompanying text *supra*.

64. 15 U.S.C. § 1052(a) (1976).

65. 122 U.S.P.Q. 339 (T.T.A.B. 1959).

66. *Id.*

67. *In re Valckenberg*, 122 U.S.P.Q. 334 (T.T.A.B. 1959). See also *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938).

68. *In re Sociedade Agricola E. Comerical Dos Vinhos Messias*, 159 U.S.P.Q. 275 (T.T.A.B. 1968).

69. 138 U.S.P.Q. 594 (T.T.A.B. 1963).

nied the application. The affidavits indicated "that there's nothing in the religious principles or teachings of the Amish sect which forbids the use of cigars and/or chewing tobacco; and that at least seventy-five percent of the male members of the sect smoke cigars and/or chew tobacco."<sup>70</sup> Thus, it appears that at least some factual basis is required in order to sustain a refusal in this area.

Prior judicial determination of a similar question may provide the requisite factual basis for sustaining the Examiner in allowing registration of a mark. In *In re Condas*,<sup>71</sup> the Examiner refused to register "JAP" for articles of clothing on the ground that it would disparage or falsely suggest a connection with Japanese persons. The Board found persuasive a decision by the New York Supreme Court rejecting the contention of a group of persons of Japanese ancestry that "JAP" was derogatory as to Americans of Japanese origin and reversed the Examiner's refusal to register the mark.<sup>72</sup>

The language of section 2(a) also prohibits registration of marks that "may disparage or falsely suggest a connection with persons, . . . institutions, beliefs, or national symbols."<sup>73</sup> The Board has required oppositions based on this language to allege a false connection with the particular persons opposing registration. In *Abbey of the Genesee v. Friar's Products Co.*,<sup>74</sup> the Board held that the opposers lacked standing to oppose the registration of "ABBEY" and "FRIAR'S" as trademarks for bread. The Board stated that

it is clear from the provisions of Section 2(a) of the Statute that in order to establish damage thereunder, opposer must show that applicant's use of "FRIAR'S" and "ABBEY" would falsely suggest an association with it specifically rather than with "a monastic order". Since opposer is a Trappist organization and admits that from the standpoint of ecclesiastical terminology Trappist Monks are not Friars, and inasmuch as the term "ABBEY", per se, could not mean opposer to the exclusion of other Abbeys, opposer cannot properly challenge applicant's right of registration on this ground.<sup>75</sup>

Although the Board in *Bromberg* did not deal specifically with a claim suggesting a false connection between opposers and the applicant, the Board's decision refusing to allow the opposers to assert the damage attested to in the affidavits offered by various women's groups<sup>76</sup> is consistent with such a requirement.

Another line of cases which have been the subject of litigation

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70. *Id.* at 595.

71. 188 U.S.P.Q. 544 (T.T.A.B. 1975).

72. The Board relied on *Japanese American Citizens League v. Takada*, 171 U.S.P.Q. 109 (N.Y. Sup. Ct. 1971).

73. 15 U.S.C. § 1052(a) (1976).

74. 132 U.S.P.Q. 644 (T.T.A.B. 1962).

75. *Id.* at 648.

76. See notes 13-15 & accompanying text *supra*.

under section 2(a) involves the Examiner's refusal to register marks which may disparage national symbols. In *In re Anti-Communist World Freedom Congress, Inc.*,<sup>77</sup> the applicant sought to register a mark containing a hammer and sickle with an "X" painted over it. The Board noted that the hammer and sickle was the national symbol of the USSR and that the prohibition of section 2(a) is not limited to symbols of the United States. It then determined that the applicant's mark was in fact disparaging to the national symbol of the USSR and could not be registered.

*In re American Industries, Inc.*<sup>78</sup> involved a refusal to register a mark consisting of a drawing of a flag resembling the confederate flag. Since the applicant had disclaimed use of the flag apart from the composite symbol, the Board held that the fact that the flag in the mark was recognizable as a confederate flag was an insufficient basis for refusing the application.<sup>79</sup>

The Board has expressed a particular concern for marks which may falsely suggest connections with the United States government. This is due, in part, to the impact that an endorsement by the federal government could have on the buying public. Thus, in *In re National Collection & Credit Control, Inc.*,<sup>80</sup> the Board upheld the refusal to register a mark consisting of the outline of a map of the continental United States with a superimposed eagle, accompanied by the words "National Collection & Credit Control," because the mark falsely suggested a connection with the United States government. The Board further reflected the statute's concern for the use of words and symbols likely to suggest a connection with the United States government by emphasizing the irrelevance of the registrant's intent to mislead the public. Additionally, the Board indicated that it was not the Examiner's burden to prove that a false suggestion would in fact arise, and pointed out that "the affidavit, letter, and report submitted by applicant are entirely insufficient to establish that, as a fact, no false suggestion could arise from applicant's use of its mark."<sup>81</sup> Thus, it seems that the Board, at least when dealing with symbols or marks which suggest a false connection with the United States government, makes the most of the word "may" in the language of section 2(a).

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77. 161 U.S.P.Q. 304, 305 (T.T.A.B. 1969).

78. 161 U.S.P.Q. 60 (T.T.A.B. 1969).

79. *Id.*

80. 152 U.S.P.Q. 200 (T.T.A.B. 1966). In a more recent decision the Board upheld the Examiner's refusal to register "NATIONAL INTELLIGENCE ACADEMY" as a service mark for educational services for law enforcement officers on section 2(a) grounds. *In re National Intelligence Academy*, 190 U.S.P.Q. 570 (T.T.A.B. 1976).

81. 152 U.S.P.Q. at 201.



In *In re Health Maintenance Organizations, Inc.*,<sup>82</sup> however, the Board overruled the Examiner's refusal to register the applicant's mark. It concluded that since "applicant's mark does not so resemble or involve a simulation of the Greek red cross, or the flag of the Swiss Confederation, . . . it is *unlikely* to falsely suggest a connection therewith."<sup>83</sup> Thus, in dealing with a mark alleged to suggest connections with foreign countries, the Board in *Health Maintenance Organizations* seemed less concerned with the fact that section 2(a) only requires that the mark "may" falsely suggest a connection than it was in *National Collection & Credit*.

In *United States ex rel. FBI v. Societe Anonyme Francaise M. Bril & Co.*,<sup>84</sup> the district court was faced with the government's opposition to a mark based on both sections 2(a) and 2(d). Relying upon the language in *Morehouse Manufacturing Corp. v. Strickland & Co.*,<sup>85</sup> the court stated that "for a party to succeed under subsection (a), 'there would have to exist, at the very least, the same likelihood of confusion with appellant's marks under [subsection (d)].'"<sup>86</sup> However, the court articulated two different standards for determining the question under section 2(a) and section 2(d):

As to subsection (a) the question to be determined is whether the defendant's goods are of such a type and character that the public would be misled by the use of the *mark* into believing that the Federal Bureau of Investigation has either approved or sponsored the goods or that the mark by its very nature falsely suggests a connection with the Bureau.<sup>87</sup>

The court then articulated the relevant standard under section 2(d). The question is "whether it is 'likely' that a sizable number of normally intelligent persons exercising due care, would be confused. . . . The question is not whether an 'ordinary' person is likely to be confused, or that a few undiscerning and indiscriminate persons might be misled."<sup>88</sup> The court held the applicant's mark to be registrable. The result is that in order for the possibility of the false suggestion of a connection between applicant and opposer with respect to the origin of the goods to exist, it is necessary to demonstrate the likelihood of confusion between the two

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82. 188 U.S.P.Q. 473 (T.T.A.B. 1975).

83. *Id.* at 474 (emphasis added).

84. 187 U.S.P.Q. 685 (D.D.C. 1975).

85. 407 F.2d 881 (C.C.P.A. 1969).

86. 187 U.S.P.Q. at 687 (quoting *Morehouse Mfg. Corp. v. Strickland & Co.*, 407 F.2d 881, 888-89 (C.C.P.A. 1969)). See also *CCI Corp. v. Continental Communications, Inc.*, 184 U.S.P.Q. 445 (T.T.A.B. 1974) (elaboration on the standard applied under section 2(d)).

87. 187 U.S.P.Q. at 687. See also *Sterling Silversmiths Guild of America v. Kirk's Ltd.*, 153 U.S.P.Q. 85 (T.T.A.B. 1967) (application of a similar standard).

88. 187 U.S.P.Q. at 687.

sources. The burden under section 2(a) is ostensibly greater than that under section 2(d) with respect to the Examiner or the opposer.

## B. Marks of Questionable Moral Propriety

There have been few cases involving refusals or oppositions based on the language "immoral . . . or scandalous"<sup>89</sup> which concern the immorality of a particular mark. One of the first such appellate cases was *Ex parte Parfum L'Orle, Inc.*<sup>90</sup> In *L'Orle* the applicant sought to register "LIBIDO" for perfumes and toilet waters. Registration was refused on the ground that the mark comprised immoral and scandalous matter "in view of its definition in the dictionaries, one of which is that the word refers to sexual desire."<sup>91</sup> The Patent Office Examiner in Chief overruled the Examiner of Trademarks:

The word involved in this case has more general meanings than the particular one mentioned, notably in psychoanalysis, and is probably not a word in every day use. I do not think that, when used in ordinary writing or speech, particularly among the class of persons who would be apt to use such a word, it would be considered shocking or offensive, or obscene, and I do not believe that the Office can refuse registration in this particular case on the ground raised.<sup>92</sup>

The decision in *L'Orle* seems to focus on two facts. First, it is noted that the word has more general meanings than those relating to sexual desire. The Examiner in Chief did not address the issue of whether sex is synonymous with obscenity, but considered it important that the word, as commonly used, does not exclusively refer to obscenities and/or sex. Second, in determining the word's meaning, the Chief Examiner relied on the meaning attributed to the word by those persons most likely to use the word commonly. Since the word was susceptible of more than one connotative meaning, and those who used the word were not likely to consider it obscene or offensive, the Chief Examiner determined that use of the mark would not be offensive to such persons and was not prohibited by section 2(a).

*In re Runsdorf*<sup>93</sup> involved a refusal to register the mark "BUBBY TRAP" for brassieres. The Examiner's refusal was based on the ground that the mark comprised scandalous matter prohibited by section 2(a). The Examiner had relied on a dictionary defi-

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89. 15 U.S.C. § 1052(a) (1976).

90. 93 U.S.P.Q. 481 (Pat. Off. Examiner in Chief 1952).

91. *Id.*

92. *Id.* at 482.

93. 171 U.S.P.Q. 443 (T.T.A.B. 1971).

nition of "bubby" as "[b]reast, now often considered vulgar"<sup>94</sup> and concluded that "as applied to brassieres, the mark 'BUBBY TRAP' would be offensive to public or individual sense of propriety or morality."<sup>95</sup> The applicant's arguments to the Board were first, that a different dictionary had made no reference to vulgarity in its definition of "bubby," and second, that the terms "vulgar" and "scandalous" are not synonymous. The Board seemed to ignore the former argument in upholding the Examiner's decision.<sup>96</sup> It stated that the definition of vulgar could "be encompassed by the term scandalous matter."<sup>97</sup> The Board's decision, therefore, was based upon little more than a subjective and unscientific evaluation of exactly what the public sense of propriety and morality was at that time. While the Board indicated that vulgarity could be encompassed by the prohibitions of section 2(a), it did not seem to rely on a finding that the term "bubby" was vulgar. Instead, it determined that the composite mark was immoral. McCarthy has criticized the Board's decision in *Runsdorf* by stating that "[i]t is hoped that the brassiere symbolized by the mark BUBBY TRAP lends more support to its users than the reasoning of the Trademark Board supports its moral judgments."<sup>98</sup> Although the Board arrived at its conclusion by considering the mark as used in connection with the goods for which it was sought to be registered, the basis for its determination is less than evident.

It should be noted that the scope of the requirement that the mark be considered in connection with the goods it is registered for is not at all clear. In *In re Hepperle*,<sup>99</sup> the applicant's registration of "ACAPULCO GOLD" for suntan lotion was refused on the grounds that it was immoral and scandalous under section 2(a) and that it was likely to cause confusion under section 2(d) with "ACAPULCO" which was previously registered for lipstick and face powder. The Examiner's refusal under section 2(a) was predicated on the assumption that "Acapulco Gold" was commonly understood to mean marijuana.<sup>100</sup> The Board overruled the Examiner's determination that the mark was scandalous and immoral. In doing so, the Board stated that a term's registrability under section 2(a)

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94. *Id.* (quoting WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY (3d ed. 1971)).

95. 171 U.S.P.Q. at 443.

96. It held that the mark "was offensive to a segment of the public sense of propriety or morality and . . . therefore prohibited by Section 2(a) of the Act." *Id.* at 443-44.

97. *Id.* at 444.

98. 1 J. MCCARTHY, *supra* note 62, § 19:27, at 704.

99. 175 U.S.P.Q. 512 (T.T.A.B. 1972).

100. *Id.*

must necessarily be considered in relationship to the goods in connection with which it is used. The goods in this case is suntan lotion, and, in our opinion, to the average purchaser of suntan lotion in the normal marketing milieu for such goods, the term "ACAPULCO GOLD" would suggest the resort city of Acapulco noted for its sunshine . . . rather than marijuana.<sup>101</sup>

Thus, in the subjective determination of the Board, the fact that the goods may or may not be considered immoral or scandalous in and of themselves seems to be a significant consideration.

In *In re Madsen*,<sup>102</sup> the Board wrestled with the obvious subjective judgment that it is required to make in cases involving refusals based on the "immoral or scandalous" language of section 2(a). The applicant in *Madsen* sought to register "WEEK-END SEX" as a name for a magazine. In refusing the registration, the Examiner relied upon the Board's decision in *Runsdorf* to the effect that marks offensive to the public sense of propriety are prohibited by section 2(a). The Board noted that cases involving marks offensive to religious groups or other recognized groups were distinguishable and of little assistance in determining the registrability of "WEEK-END SEX" since the Examiner's refusal was based upon a determination of what the public sense of propriety or morality actually was. In contrast to the approach taken in *Hepperle*, the Board indicated that the nature of the magazine's contents was irrelevant to the question of whether the mark, as applied to the goods, was registrable. It then articulated the relevant standard stating that "consideration must be given to the moral values and conduct fashionable at the moment, rather than that of past decades . . .".<sup>103</sup> Admitting that the mark was suggestive of week-end affairs and sexual relationships, the Board held that the mark was "not so offensive to the public sense of propriety or morality as to preclude registration thereof under the provisions of Section 2(a)."<sup>104</sup> At this point in the decision the Board made an editorial comment:

Finally, it should be recognized that what is scandalous or immoral is merely a matter of degree and that this decision should not be interpreted as a precedent for the allowance of clearly immoral or scandalous matter as applied to applicant's goods. Also, this decision should not be considered as a reversal of *In re Runsdorf* . . . which applied to an entirely different factual situation.<sup>105</sup>

This comment seems indicative of the fact that the Board was less than comfortable with its application of such a vague and unhelpful standard. Indeed, its fear of future applicants relying on

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101. *Id.*

102. 180 U.S.P.Q. 334 (T.T.A.B. 1973).

103. *Id.* at 335.

104. *Id.*

105. *Id.*

*Madsen* as a precedent allowing the registration of immoral or scandalous matter confirms its apparent discomfort. The task of evaluating current social norms or of even specifying criteria for their measurement in the area of public morals is at the very least formidable. Being required to define those current standards and then draw the proper inferences (or the improper inferences, as the case may be) from the mark, as applied to the goods, places a doubly taxing burden on both the examiners and the Board in any case.

In *In re Leo Quan, Inc.*,<sup>106</sup> the Board upheld an application to register "BADASS" for bridges used on stringed musical instruments, overruling the Examiner's determination that the mark was prohibited by section 2(a). The board considered the applicant's explanation of the mark, and the fact that its use in many countries had not been opposed, to be important factors weighing against the mark's other interpretations.

The applicant explained that the mark was "an acronym (standing for Bettencourt Accoustically Designed Audio Sound Systems)."<sup>107</sup> Thus, the fact that the mark was susceptible to less pleasing colloquial connotations was not considered a sufficient ground for denial of registration. In arriving at this decision the board made the following observation:

To find that "BADASS" is a scandalous or immoral word, one would first have to divide what is unitary into separatenesses, and then, applying what knowledge one would have of the colloquialisms of a particular segment of the society of the age, give to the resulting expression a connotation offensive to the culture, or at least to the mores, of our time. One of a certain cast of mind may perhaps see evil wherever the eye may light or in whatever may fall on the ear. We are unwilling to assign base motives to an applicant who propounds a plausible explanation for a trademark which is susceptible to a wholly innocent pronunciation [*sic*] and is used for a part of an instrument which has charms to soothe the savage beast. Seen as applicant presents it and heard as applicant would have it, "BADASS" gives no offense to morality nor raises scandal; the peace of the commonwealth is not threatened.<sup>108</sup>

Another case in which the Board was called upon to apply these nebulous standards is *In re Thomas Laboratories, Inc.*<sup>109</sup> Applicant's registration of a mark "for a corrective implement for increasing the size of the human penis"<sup>110</sup> was refused by the Examiner on the ground that the mark consisted of immoral or scandalous matter. The mark consisted of a side-view of "a cartoon-like representation of a melancholy, unclothed male figure

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106. PAT., T.M. & COPYRIGHT J. (BNA) A-12 (No. 399, T.T.A.B. Sept. 22, 1978).

107. *Id.*

108. *Id.*

109. 189 U.S.P.Q. 50 (T.T.A.B. 1975).

110. *Id.* at 51.

ruefully contemplating an unseen portion of his genitalia.”<sup>111</sup> The Examiner reasoned that, considering the mark in connection with the goods sold thereunder, the object of the caricature’s gaze was obvious and concluded that the mark was immoral. The Board noted that the Examiner considered the nature of the goods and the posture and nudity of the figure to be very significant factors. It then indicated that the nature of the goods should play no role in the determination of the registrability of the mark since the goods were legally salable in commerce. It also stated that “[t]he mere fact that the male figure which constitutes the mark is apparently unclothed cannot in and of itself militate against registrability.”<sup>112</sup> However, the nudity of the figure could be considered a determinative factor as to the registrability of a mark if “the mien or posture of the subject figure . . . involve[d] an element of immorality or lewdness.”<sup>113</sup>

Turning to the consideration of the registrability of the mark as applied to the goods, the Board reaffirmed the relevant standard set out in *Madsen*. It then turned to a previously unmentioned consideration—the first amendment freedoms.<sup>114</sup> The Board cited language in *Roth v. United States*<sup>115</sup> which indicates that the Supreme Court does not consider sex and obscenity to be synonymous. Considering the Court’s articulation of the constitutional standards of morality, the Board opined that “the contemporary liberal attitude concerning the question of obscenity as derived from the present understanding of the meaning of the freedoms guaranteed under the First Amendment to the Constitution, militates against the narrow interpretation expressed by the Examiner in the decision here in question.”<sup>116</sup> In reversing the Examiner, the Board introduced another ambiguous consideration into the determination of what is registrable under section 2(a). The *Roth* decision involved the question of obscenity and first amendment freedoms. While the *Roth* opinion may aid the Board in determining the constitutional limits of speech in terms of what is obscene or morally unacceptable in today’s society, that question is not directly involved in applications for the registration of trademarks. As noted previously, denial of a registration does not prohibit use of the mark. Therefore, it seems entirely rational for different standards to be applied in the two circumstances. The question of what communications are entitled to constitutional protection

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111. *Id.* at 52.

112. *Id.* at 51.

113. *Id.*

114. U.S. CONST. amend I.

115. 354 U.S. 476 (1957).

116. 189 U.S.P.Q. at 52.

would not seem to be necessarily determinative of whether that same matter would be registrable under section 2(a).

Oppositions based on the allegedly immoral or scandalous nature of the marks under section 2(a) have been few. It is questionable whether such a criterion is available to an opposer. In *Sta-Power Industries, Inc. v. Lasting Products, Inc.*,<sup>117</sup> the applicant's registration of "S-T-A-Y POWER" for a medicated desensitizing agent was opposed. The opposer owned and used the mark "STA-POWER" for oil and gas additives and engine conditioners. The Board dismissed the contention that the applicant's mark would confuse the public as to the source of the products since there was no relationship between the parties' goods.<sup>118</sup> The Board then considered the testimony offered by the opposer as to the nature of the applicant's mark as applied to its product, and the damage asserted by the opposer. "The tenor of the witness' testimony appears to be that applicant's use of a similar mark on a product indicated for sexual fulfillment is 'offensive' to opposer corporation and its 'image'."<sup>119</sup> The Board held such damage to be insufficient to sustain the opposition and, accordingly, dismissed it.

#### IV. CONCLUSION

While the task of the Examiner of Trademarks and the Trademark Trial and Appeal Board may be difficult in terms of formulating and applying the standards for the registrability of marks under section 2(a), it should be kept in mind that they are concerned primarily with the administration of the trademark laws and with the purposes and protections involved with those provisions. The standing provisions of the trademark law must be administered with some limiting effect. Otherwise, they become meaningless. The concept of standing involves the idea of setting some requirements or limits on the number of persons or entities and the nature of the claims which will be recognized under the statute. Given the lack of elegance of any decision based on the early stages of the pleadings, the *Bromberg* decision would have been more valuable had it based its decision on legally cognizable grounds.

Kerry L. Kester '79

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117. 177 U.S.P.Q. 351 (T.T.A.B. 1973).

118. The Board noted that the applicant's product was "intended to prevent premature ejaculation during intercourse and was advertised as a product which can lead to sexual fulfillment." *Id.* at 352.

119. *Id.*