

MAKE AMERICA NAUGHTY AGAIN: THE RISK OF RISQUÉ TRADEMARKS

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Two years ago, in a post entitled "[Is Your Brand Naughty or Nice? The New Santa at the Trademark Office](#)", I discussed some rulings at the U.S. Trademark Office that suggested that those old fuddy-duddies might be relaxing their view of what types of trademarks violate the immoral/scandalous rule in the Lanham Act. In addition to giving a shout-out to the [Office's registration of my new favorite beer trademark](#)—Nut Sack Brown Ale—I offered the following observations on two trademark registration disputes that were working their way up through the courts:

In re Tam involved the rejection of an Asian-American music band's application to register their name, THE SLANTS. That rejection was based on the other provision of Section 2(a) of the Trademark Act, namely, the one that bans registration of "disparaging" trademarks. But on the appeal late last year, the Federal Circuit ruled that Section 2(a)'s ban on "disparaging" trademarks is unconstitutional.

"While the Trademark Office may yet ask the Supreme Court to review that ruling it has for now conceded—in connection with the appeal of the refusal to register FUCT as "scandalous and immoral"—that the Federal Circuit's reasoning in In re Tam also requires elimination of the Lanham Act's prohibition on the registration of scandalous and immoral marks.

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that “the trademark at issue is vulgar,” that “the use of such marks in commerce is discomforting,” and that “we are not eager to see a proliferation of such marks in the marketplace.”

It's too soon to tell whether there will be such a proliferation—especially since the application process can be lengthy and expensive and, moreover, it can be challenging to try to market your goods and services under a brand that offends a large portion of your consumer audience.

Pending 4-letter words Trademarks: “truck” and “fit”

Nevertheless, in seeking an answer to the “proliferation” question your humble scribe conducted on your behalf a search of the US Trademark Office data base for pending applications that include one of the two most familiar 4-letter words—namely, the one that rhymes with “truck” and the one that rhymes with “fit.”

As for that first one, I can report that there are more than 90 pending applications to register a trademark that includes the F-word, including **OFF** (for “charitable fundraising”—yes, you read that right), **PROUD AS** (for entertainment services), **CALM THE DOWN** (for tea) and, of course, **CLUSTER** (for beer, which somehow seems appropriate, at least based on my recollection of supposedly brilliant plans hatched by college students around closing time in bars). One clever company actually obtained a registration for **FAUQ-YEAH!** for athletic apparel.

As for that 4-letter word for excrement, you will not be shocked to learn that there are more than 100 pending applications, including, of course, **HAPPENS** (for card games), **HOLY** (for t-shirts), **PIECE OF** (for athletic apparel), and **YOU DON'T LEARN IN COLLEGE** (for “Business training in the field of leadership development”).

Risqué Risk: Four-Letter Words as a Brand

But is there a takeaway for that clever entrepreneur or marketer who has no desire to adopt a four-letter word as a brand? Absolutely. Up until these two decisions—and especially the FUCT one—there was always the risqué risk, namely, that a mildly risqué trademark might get rejected as “immoral” or “scandalous.” You literally could not predict how a Trademark Examiner would react—an ongoing uncertainty that the Federal Circuit Court highlighted with the example of the handling of various applications to register trademarks that included the acronym MILF. (If you don't know the meaning of that acronym, I suggest you visit Urban Dictionary.)

Here is what the Court explained:

*One commentator has written that, of the forty marks containing the acronym MILF . . . as of 2011, twenty marks received an office action refusing registration based on § 2(a), while twenty did not. * * * It is difficult to understand what distinguished the refused marks, which included GOT MILF (clothing), MILF MANIA (adult online services), MILF SEEKER (adult entertainment services), and FROM SOCCER MOM TO MILF (self-help books for women), from the marks which were registered, including DIARY OF A MILF (adult online services),*

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And thus the Courts have eliminated the risqué risk, and in the process they have eliminated one important unpredictable factor in the trademark registration process.

Out of deference to any faint-hearted readers and to avoid the need for trigger warnings, we have BLEEPed out the words the rhyme with “truck” and “fit.”

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