

Trademark Law

Prof. Madison

Today: Offensive trademarks

Key concepts from Class 23:

Free expression / First Amendment as an independent basis for defending claims of TM infringement

Relationship to “fair use”

Rogers v. Grimaldi

And its limitations

What if a trademark defendant claims that the infringing use counts as “art”? How does it matter if the “artist” is selling copies of the item?

Campbell’s Soup did not sue Warhol for TM infringement.

If it had, should it have won? Why / why not?



**P A R E N T A L
A D V I S O R Y
E X P L I C I T C O N T E N T**

(Thanks, Tipper Gore.)

Freedom of expression in tension with TM law

Version 2 of 2: registering and protecting trademarks in the first place

- *Reprise*: parody/satire/commentary and other forms of free expression (art!) are (often) protected under the First Amendment from government interference/regulation, such as © or TM.
- Denying access to TM registration on the basis of the content of the mark or the viewpoint expressed by the mark (if there is one) seems to conflict with Constitutional principles permitting content discrimination or viewpoint discrimination by the government only under very limited circumstances.
- Generally, courts are slowly figuring out how the 1A applies in the TM registration (and enforcement) setting.
- If bars to registration are invalid b/c of content or viewpoint discrimination, then how is dilution constitutional?

Remember the bars to registration:

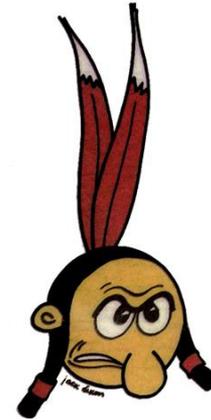
Lanham Act § 2(a) (15 U.S.C. § 1052):

No trademark 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**;

Lanham Act § 43 (15 U.S.C. § 1025) has no complementary provision relative to unregistered trademarks ... but it is often assumed that the § 2(a) statutory bars apply to unregistered marks, too, as a matter of public policy.

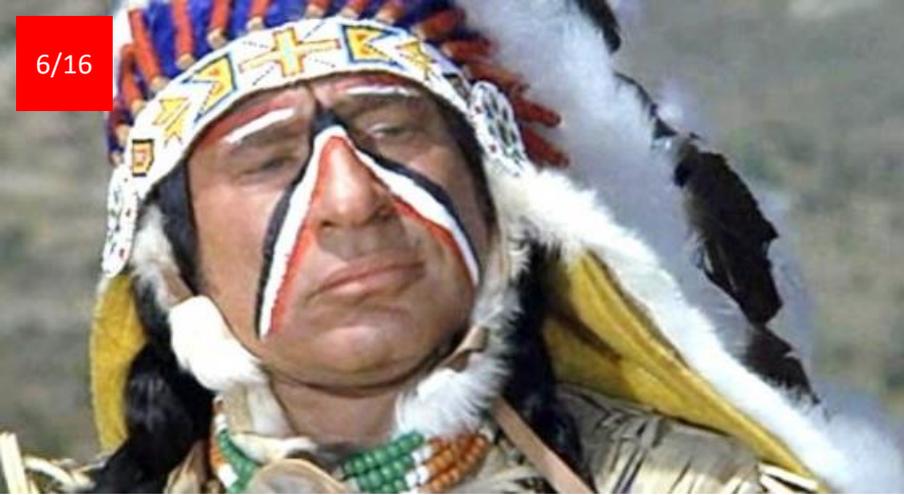
A public policy question, to begin with: What role should (TM law) (1A law) play – if any – relative to brands / logos / images that are considered offensive and harmful? Can markets and public pressure alone be (sufficiently) effective in appropriate ways?



Pro and college mascots



Product branding



Mel Brooks, playing in the parody Western *Blazing Saddles* (1974)

Chief Dan George, playing in the postmodern Western *Little Big Man* (1970)



Lily Gladstone, playing in the Western crime drama *Killers of the Flower Moon* (2023)

Popular culture is never uniform or consistent

GAY OLYMPIC GAMES I

SAN FRANCISCO 1982



**S.F. Arts &
Athletics, Inc. v.
USOC
(U.S. 1987)**

Does the case illustrate flaws in the “market” model? Or is this (hidden) government-sanctioned censorship?

Upholding a federal statute that grants the USOC exclusive rights in the word “Olympic,” regardless of whether other uses cause confusion; there is no Constitutional violation because the USOC is not a governmental actor.

[This **was** the law] The doctrine, under § **2(a)**: marks that “may disparage” cannot be registered. How to apply the law:

- [1] Determine **the meaning of the mark** [remember from earlier discussion of distinctiveness and registrability: “primary significance of the mark” standard; anti-dissection rule]
Consider: What does the mark denote (refer to)? Also: What does the mark connote (mean, or signify)?
- [2] In view of the likely meaning, may the matter be **perceived as disparaging *by the object group/individual?***

Potential problems:

1. Viewpoint discrimination?
[government providing/denying benefits based on the content of private speech?]
2. Vagueness/
administrability?

From Judge Moore's opinion in *In re Tam* (Federal Circuit):

- **Refused:** HAVE YOU HEARD SATAN IS A REPUBLICAN (refused)
- **Published** (potentially registrable): THE DEVIL IS A DEMOCRAT
- **Registered** 3 times, **refused** twice): FAGDOG
- **Refused:** FAG FOREVER A GENIUS!
- **Registered:** F*A*G FABULOUS AND GAY
- **Registered:** DANGEROUS NEGRO

[What's the law now, in light of *In re Tam*?]

Should **The Slants** be registrable for live music / entertainment services?

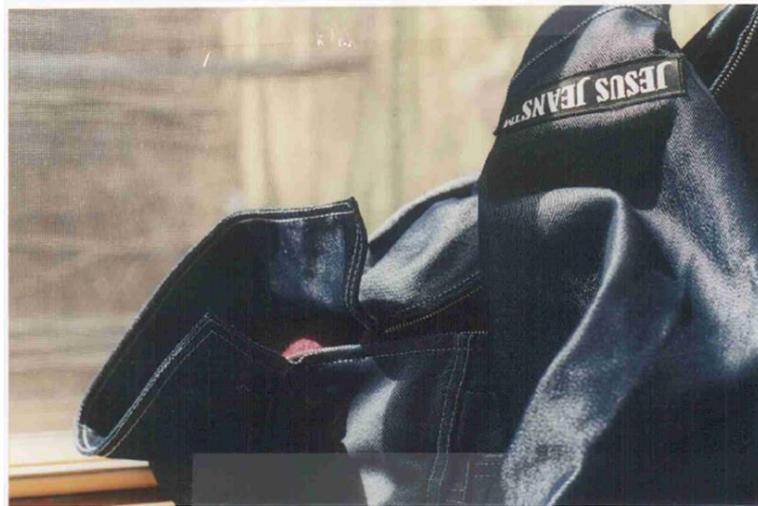
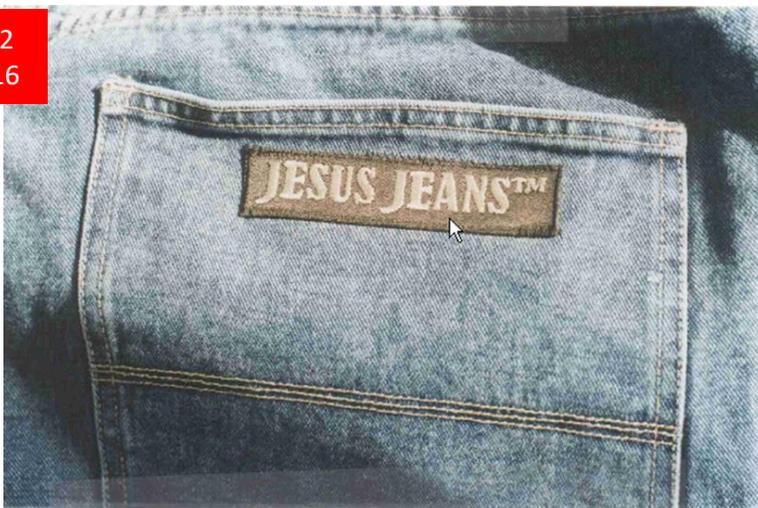
- **What if the (offensive?) TM is part of the art?**
- Which law should we use to answer the question? [1] commercial tort law [the Lanham Act] or [2] First Amendment law
- Which one is better for addressing how to deal with *social / cultural interests* re branding (diversity of subjective reactions, range of interests and concerns re role of “claiming” and “reclaiming” identity in broader society).
- Which one is better for addressing *fair competition interests*?
- How does it matter that the band members are all of Asian / Pacific Islander descent?



**Matal v. Tam
(U.S. 2017)**

[This **was** the law] The doctrine, under § **2(a)**: “scandalous” and “immoral” marks cannot be registered. How to apply the law:

- [1] Determine **the meaning of the mark** [remember: “primary significance of the mark” standard; anti-dissection rule]
Consider: What does the mark denote (refer to)? Also: What does the mark connote (mean, or signify)?
- [2] In view of the likely meaning, is it **scandalous [or immoral] *to a substantial composite of the general public***?



Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 3,379,848

Registered Feb. 12, 2008

**TRADEMARK
PRINCIPAL REGISTER**

JESUS JEANS

MICHAEL BAGBY (UNITED STATES INDIVIDUAL)
5 PUTTING WAY
REISTERSTOWN, MD 21136

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "JEANS", APART FROM THE MARK AS SHOWN.

FOR: CLOTHING, NAMELY, JEANS, SKIRTS, T-SHIRTS, SWEATSHIRTS, CAPS AND HATS, IN CLASS 25 (U.S. CLS. 22 AND 39).

SER. NO. 76-305,357, FILED 8-27-2001.

FIRST USE 12-23-1995; IN COMMERCE 6-7-1996.

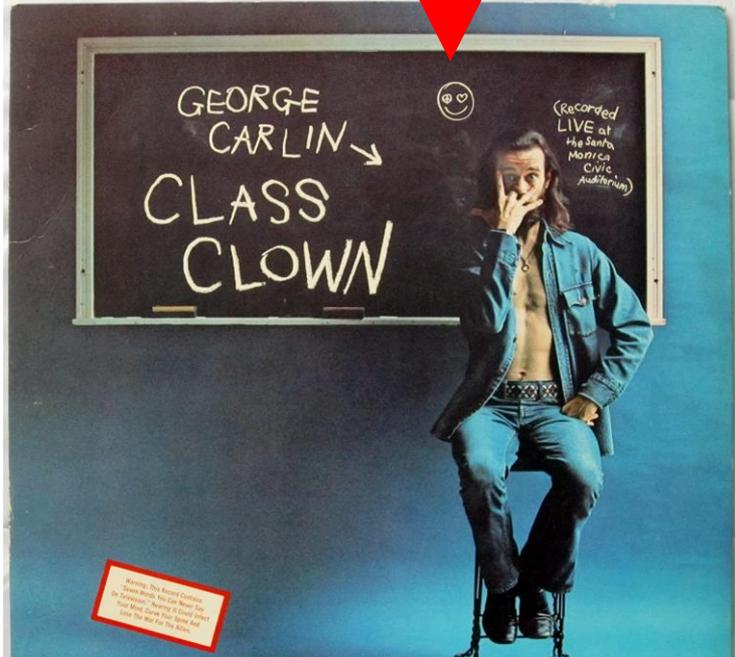
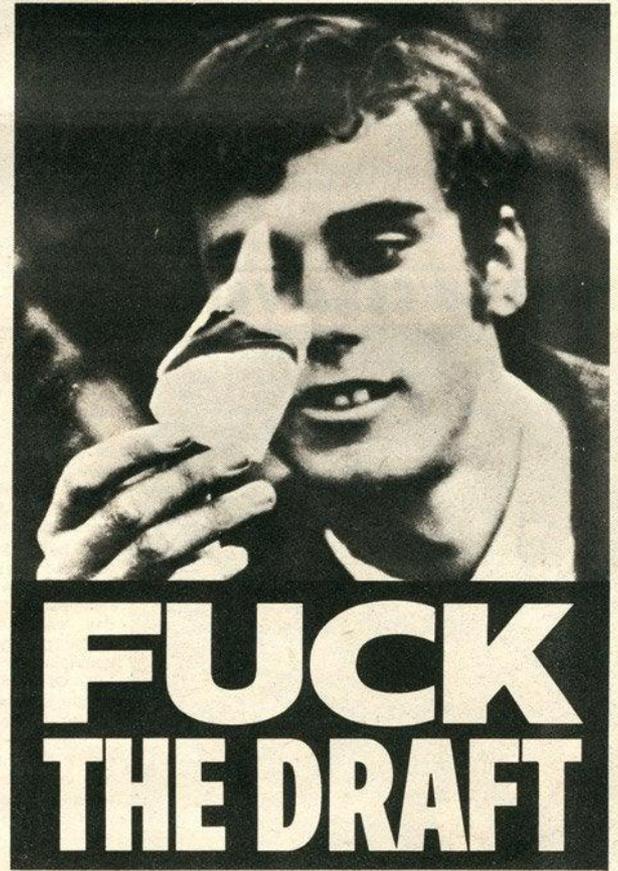
HENRY S. ZAK, EXAMINING ATTORNEY

Attempts to register "Jesus" for clothing (jeans) have been rejected on "moral" grounds in Britain, Turkey, China, Switzerland, Australia, Norway, and Cuba. "Jesus" is registered as a "Community Trademark" in the EU.

fuct™



HERE'S
 A LITTLE
 SOMETHING
 * * * FOR * * *
 MOTHER'S
 * * * DAY * * *
 [Hand pointing]



Sometimes the government **can** regulate offensive speech that circulates in public places. FCC v. Pacifica Foundation (U.S. 1978)

Sometimes the government **cannot** regulate offensive speech that circulates in public places. Cohen v. California (U.S. 1971)

?? *Janic v. Brunetti* (U.S. 2019) ??

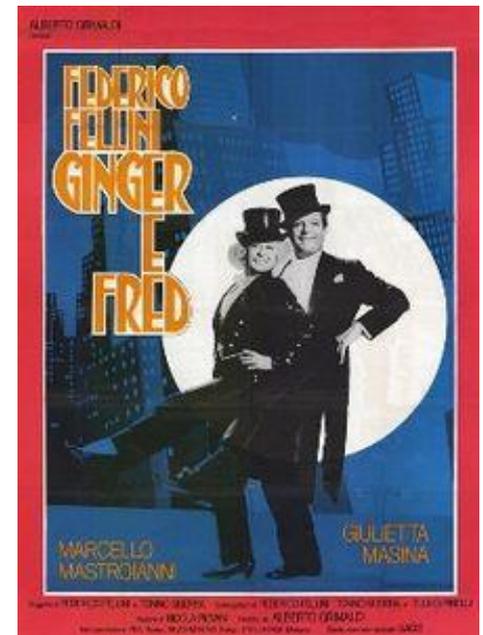
(How much is that, Dog Crap in the window?)
 All-America the Beautiful

... five pos
 sixth one
 choice. Ple
 ster to:

Lady Bird
 Shirley Ter
 tenant Gene
 General William W
 Madame Ngo Dinh Nhu

NAME _____

 STATE _____ ZIP _____



Remember *Rogers*
Artistic relevance under
Rogers v. Grimaldi
(2d Cir. 1989). For LoC
re: expressive works,
does the title have some
artistic relevance to the
content? If not, then:
LoC?

Rogers does not apply where the defendant used the plaintiff's mark as a mark – as a designation of source. Instead: ordinary LoC applies.

Is a dog toy an expressive work, so that *Rogers v. Grimaldi* should have applied?

Dilution claims are subject to the defense that the deft's use is "noncommercial." Is use of the JD mark and trade dress by the deft "noncommercial"?

LoC? If the deft were to file a motion for SJ on "no likelihood of confusion" grounds and "no likelihood of dilution by tarnishment" grounds, should the motion be granted? What if surveys show that some consumers were confused as to source?



Jack Daniel's Properties, Inc. v. VIP Products, LLC (U.S. 2023)

(Both products are still available for purchase.)

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If it had, should it have won? Why / why not?



The image features a central graphic consisting of several concentric circles. The innermost circle is a dark blue color. Surrounding it are several rings of varying shades of red, from a deep, dark red to a lighter, more vibrant red. The outermost ring is a solid black color. Overlaid on this circular pattern is the text "That's all Folks!" written in a white, elegant cursive script. The text is positioned diagonally across the center of the graphic, starting from the lower-left and ending at the upper-right. The overall composition is balanced and visually striking due to the high contrast between the white text and the dark background elements.

That's all Folks!