CHALLENGING THE REGISTRATION OF SCANDALOUS AND DISPARAGING MARKS UNDER THE LANHAM ACT: WHO HAS STANDING TO SUE?

by

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These propositions are so well understood as to require neither the citation of authority nor an elaborate argument to prove them.1

At the time that Justice Miller penned these words regarding the fundamental precepts of trademark law over 120 years ago, trademark law was indeed simpler, more direct, and less ambiguous. Since then, however, federal trademark law, responding to unprecedented growth in marketing and the consumer economy, has mushroomed, encompassing a complexity of rules and a proliferation of federal causes of action that Justice Miller likely never imagined.2 At the same time, society mores and norms have also undergone radical and dramatic change, particularly with regard to the nature of the words and symbols that are used to identify and distinguish products or services. Marks that might have been deemed unacceptable a century ago may well be perfectly acceptable today; conversely, marks that may have had raised few eyebrows in the past may well be viewed as outrageous today.3 While marks comprised of racial epithets or depicting offensive ethnic or racial stereotypes were commonplace a century ago, contemporary norms reject many of these blatant derogatory marks.

Many, but not all. Marks depicting stereotypes of Native Americans, for example, are still commonplace in the sports world, despite the 1999 cancellation of the REDSKINS marks used by the Washington football team in Harjo v. Pro-Football, Inc. (a decision that is currently on appeal).4 The Chief Wahoo mark used by the Cleveland Indians baseball team, for example, depicts a racial stereotype that would be perceived as demeaning or derogatory by many.5

Modern federal trademark law provides a mechanism to allow a third party to oppose the registration of marks that would be scandalous to the general public or that would disparage particular groups or individuals, as well as a mechanism to cancel such a registration after it has been issued. Historically, these opposition and cancellation actions have been seldom used.6

In recent years, however, there have been a handful of high-profile challenges to federal registrations of allegedly scandalous or disparaging marks. Two cases, in particular, have been highly controversial: the 1999 decision of the Trademark Trial and Appeal Board (TTAB or Board) to cancel the registration of the Washington REDSKINS marks in Harjo,7 and the 1999 decision of the U.S. Court of Appeals for the Federal Circuit in Ritchie v. Simpson8 that an individual had standing to challenge O.J. Simpson’s attempted registration of several marks based upon his name in the midst of his double-murder trial. These two cases generated a flurry of scholarly comment and many dire predictions about the erosion of First Amendment commercial speech protection and the potential for a rash of ill-advised suits challenging the federal registration of marks on grounds that they offend the idiosyncratic preferences of activist individuals or groups.9 To the surprise of many, these fears have not materialized. The Lanham Act’s provisions barring registration of scandalous and disparaging marks remain a largely untapped, though potent, source for third party challenges to federal registrations.

Much has been written about whether the Lanham Act’s prohibition against registration of scandalous or disparaging marks is sound, either on constitutional grounds or as a matter of public policy.10 Similarly, much has been written about what the tests should be for determining whether a particular mark is scandalous or disparaging, although the Board’s decision in Harjo did much to lay this issue to rest.11

It seems pointless to argue about whether marks should be denied federal registration on the grounds that they are scandalous or disparaging. Congress has shown no signs of intent or desire to revise the Lanham Act at any point in the foreseeable future to permit the registration of all marks, no matter how outrageous, offensive, or damaging they might be. Congress has determined that some sort of restriction upon the federal registration of marks is necessary, and it has settled upon the scandalous and disparaging bars of the Lanham Act as the mechanism by which to achieve its policy goals. The courts have rejected First Amendment challenges to this statutory scheme.12 Moreover, as discussed below,13 Congress and the courts have determined that the interests of fairness dictate that third parties, and not just the government acting through the examination process of the Patent and Trademark Office (PTO),14 should have a role to play in furthering these goals.

Fairness also dictates, however, that there must be some sort of reasonable and logical restraint upon who has standing to challenge the federal registration of a mark as violating the Act’s bar against registration of scandalous or offensive marks. Applicants or registrants should not be subject to random suits at the whim of parties whose interest in the registration of the mark is attenuated, obscure, or based upon improper motives. And indeed, I believe that it is because the

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courts and Board have articulated specific, though as yet incomplete, rules limiting the ability of third parties to bring such challenges that we have not yet seen these challenges turn into a blunt weapon for militant activists to pursue their own agendas.

Thus, my focus in this Paper is on the issue of who has standing to sue to challenge the federal registration of a mark as being scandalous or disparaging. This is an issue that, to paraphrase Justice Miller, is not well understood; elaborate argument is necessary to elucidate this issue, yet little authority exists to help in the inquiry, nor has there been much scholarly analysis on this topic. However, well-crafted and clearly-articulated standing rules are precisely the tool that will allow the courts and Congress to strike the delicate balance between permitting appropriate challenges to the registration of allegedly scandalous or disparaging marks, and preventing inappropriate challenges from being brought by disaffected groups or individuals. Unfortunately, the standing rules in this area have not yet reached this high degree of refinement, yet the seeds of such reform can be found in existing caselaw.

Part I of this Paper contains a brief overview of trademark law. Part II discusses the tests employed by tribunals for determining whether a mark is “scandalous” or “disparaging” and thus not eligible for federal registration. It focuses in particular on the tests recently articulated by the Board in *Harjo*. Part III turns to the question of who has standing to challenge the registration of allegedly scandalous or disparaging marks. Subpart A looks at general standing rules in federal trademark cases. Subpart B examines the specific standing requirements applicable to scandalousness and disparagement cases as developed through recent caselaw. Part IV discusses the steps that the courts and Board should take to formulate a functional test for standing in Section 2(a) cases. Concluding remarks are made in Part V.

I. OVERVIEW OF TRADEMARK LAW

Trademarks are the words or symbols used by companies or individuals to distinguish or identify their goods or services. Trademarks serve the important functions of identifying and differentiating products, indicating consistent source and quality, and facilitating advertising and sales. Their effectiveness in fulfilling these critical roles makes trademarks extremely valuable to marketers.

Trademarks are creatures of state law, easily acquired and maintained. To acquire a mark, the claimant need only: (1) be the first to use the mark in trade and (2) continue to use it thereafter. Thus, a claimant seeking to establish a mark need only place a mark not already in use on the product or service it is selling and then market that product or service to consumers. If the claimant does this, it automatically has an enforceable right of exclusivity in the geographic area in which the mark is in use; no formal procedures need be followed. However, often a claimant will want to claim use of the mark in a geographic region greater than that in which it currently operates, particularly if the claimant has plans for expansion. This is where federal registration under the Lanham Act becomes important.

The Lanham Act is a federal statute, enacted by Congress in 1946, with the dual objectives of protecting the consuming public from deception and protecting the mark holder from misappropriation. The Act permits persons who own common law marks to register those marks on the Principal Register. While mark owners are not required to federally register their mark, federal registration confers several important benefits, including: (1) assistance from the U.S. Customs Service in preventing importation of goods with an infringing mark; (2) nationwide constructive notice of the use and ownership of the mark; (3) original jurisdiction in federal courts over disputes involving the mark; (4) prima facie evidence of the validity of the mark under certain circumstances; and (5) nationwide rights to the mark even if the mark is not yet in nationwide use.

The federal registration process involves an evaluation of the mark. The claimant first files an application with the PTO based upon either a bona fide intention to use the mark in commerce or actual use in commerce. An examining attorney then reviews the application to determine whether the mark conforms to the formal requirements of the application process, as well as whether it avoids the Lanham Act’s statutory barriers to registration. These statutory bars arise under Section 2 of the Lanham Act, which provides for a number of grounds on which marks can be denied registration. Proscribed marks include marks that consist of or comprise the flag, coat of arms, or insignia of any state, municipality, or nation; marks that consist of or comprise the name, portrait or signature of a particular living person (unless authorized by that person) or of a deceased President of the United States during the lifetime of his widow (unless she consents); certain misleading marks; marks that are merely geographic descriptions, general descriptive terms, or surnames, unless they have acquired a secondary meaning; and functional marks. The most controversial of these grounds is Section 2(a)’s prohibition against registration of marks that are scandalous or disparaging. The basis for these two bars against federal registration are discussed further below.

If the examiner approves the application, the mark is published in the PTO’s Official Gazette. Persons who believe that they will be injured by the registration then have thirty days in which to file an opposition challenging the mark. If no opposition is filed, or if the PTO determines that the opposition is groundless, the PTO issues a certificate of registration. Registration is good for ten years and can be renewed indefinitely in ten-year increments as long as the mark remains in commercial use.
If the PTO rejects the application or if a successful opposition is filed, the applicant can appeal the denial of registration in an ex parte proceeding to the Board. If the Board upholds the denial, the applicant can appeal on the administrative record to the U.S. Court of Appeals for the Federal Circuit or de novo to the U.S. District Court.

Once a mark has been placed on the Principal Register, a third party can file a petition to cancel the registration if that party believes the registration to have been improperly issued. Within the first five years of a mark’s registration, a petition for cancellation can be brought for any of the grounds originally available to the examiner for refusing registration. Cancellation proceedings brought more than five years after registration can only be initiated on limited grounds, which include, inter alia, an allegation that the mark violates Section 2(a)’s prohibition against registration of scandalous or disparaging marks.

Typically, this cancellation petition is filed with the Board, whose decision may be appealed to the federal courts. In each instance, whether registration of the mark is challenged during the registration process by the examiner, during the publication period by an opposer, or post-registration by a petitioner in a cancellation proceeding, the examiner, opposer, or petitioner has the burden of proving by a preponderance of the evidence that the Lanham Act bars registration.

In sum, there are three points in the registration process in which registration of a mark can be challenged on the ground that the mark is scandalous or disparaging. First, the examiner can refuse the registration of the mark during the examination process. Second, once the mark has been published, a third party can file an opposition to the registration. Third, a third party can challenge the registration in a post-registration cancellation proceeding. These third party oppositions and challenges are the focus of this Paper.

Where the registrability of a mark is at issue, the courts and Board prefer that the examiner publish the mark for opposition rather than denying registration during the examination process. Their concern is that the government not be in the position of censoring marks without public input. As the Federal Circuit has explained: \[\text{[W]}e\text{ have commended the practice of resolving the issue of whether a mark comprises scandalous matter by first permitting the mark to pass for publication, and then allowing interested members of a composite of the general public who consider the mark to be scandalous to bring opposition proceedings. By doing so, the PTO avoids the risk of pre-judging public attitudes toward a proposed registration based on ad hoc responses by government officials, while at the same time affording the affected public an opportunity to effectively participate in the question of whether the registration is proper. Thus, the policy behind the procedure for determining whether a mark is scandalous encourages, if not requires, participation by members of the general public who seek to participate through opposition proceedings.}\]

In this sense, policy regarding publication for opposition of potentially scandalous or disparaging marks diverges from standard practice. In most other instances, the examiner, as the representative of the public at large, is supposed to initially resolve registration problems in ex parte proceedings with the applicant, rather than leaving the issues to be challenged (or not) by a third party in an opposition proceeding. As the Federal Circuit has stated, “[t]he opposition procedure is intended to remedy oversight or error, not to substitute for the examination process.” Presumably, it is the content-based nature of Section 2(a)’s restrictions that leads to the contrary process here.

The Lanham Act bars only the registration and not the use of scandalous and disparaging marks. Claimants can continue to use marks that have been denied federal registration and to claim the common law rights that might attach to them. The claimant simply cannot obtain the benefits that flow from federal registration. This is a significant disadvantage, however, and one that is likely to discourage many mark holders from using an unregistered (and unregisterable) mark.

The legislative history of Section 2(a) is frustratingly silent as to why the Lanham Act denies registration to scandalous or disparaging matter. Courts and commentators have offered two general theories: (1) the government should not waste its resources on protecting unseemly marks and (2) the government should not provide official sanction to unseemly marks. Such explanations are mere speculation, however, as Congress has given no signal of its intent in enacting the prohibitions of Section 2(a).

II. IDENTIFYING AND EVALUATING “SCANDALOUS” AND “DISPARAGING” MARKS

Section 2(a) of the Lanham Act directs the PTO to refuse registration of any mark that is scandalous or disparaging. Specifically, Section 2(a) states:

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, deceptively, 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.

The prohibition against registration of scandalous marks first appeared in the Trademark Act of 1905 and was repeated in Section 2(a) of the Lanham Act of 1946. The statutory prohibition against registration of disparaging marks, on the other hand, did not appear in the 1905 Act, and was first articulated in the 1946 Act. The legislative history of Section
2(a) is sparse and sheds little, if any, light on the meaning of “scandalous” and “disparaging.” The courts and Board have struggled in this arena to define these terms and to create standards to apply and the Board itself has noted that the determination of whether a mark is scandalous or disparaging is “highly subjective.”

Although more definitive tests for evaluating marks under Section 2(a) have emerged in recent years, the tests have been controversial and the specific nature and content of these tests have been the subject of much analysis and debate by commentators and courts alike. For purposes of this Paper, I accept these tests as articulated by the Board and the Federal Circuit, and do not attempt to evaluate either the efficacy of the tests or the wisdom of denying registration to scandalous or disparaging marks in the first place. Rather, I accept as a given that Congress has made a public policy determination to deny registration to such marks, and that the courts and the Board have attempted to fill in the interstices of the Section 2(a) statutory bars as best they can. My focus here is on who can sue to prevent or cancel a registration as being scandalous or disparaging, not on whether a particular mark actually violates these prohibitions or, indeed, whether these statutory prohibitions are even sound public policy. Nonetheless, it is necessary to understand the basic framework of the scandalous and disparaging tests set forth by the Board and courts in order to evaluate who has standing to invoke these statutory bars.

“Scandalous” and “disparaging” have very different meanings within the context of the Lanham Act. As discussed below, the prohibition against registration of scandalous marks is intended to protect the public as a whole, and the mark is evaluated from the perspective of the general public. Disparaging marks, by contrast, are viewed from the perspective of a particular person, group, set of beliefs, institution, or symbol which is allegedly being damaged by the mark.

As a practical matter, many courts have conflated the terms “scandalous” and “disparaging,” making it unclear whether the mark at issue is being denied registration because it is scandalous, because it is disparaging, or perhaps because it is both, and making it difficult for a coherent body of jurisprudence to develop. For example, in In re Reenstma Cigarettenfabriken GmbH, the Board upheld the examiner’s refusal of registration of the mark SENUSSI for cigarettes on the grounds that the tenets of the Moslem Senussi sect prohibit the use of cigarettes. The Board stated: “The 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.” The Board then concluded that the use of the mark was “scandalous.” Similarly, four years later, the Board determined that the use of the mark AMISH (accompanied by a drawing of a bearded, hatted man smoking a cigar) was not “scandalous” when used on cigars because it did not “disparage [the] religious or moral beliefs” of members of the Amish sect, whose religion does not ban the use of tobacco.

In both instances, the Board used the terms “scandalous” and “disparaging” as though the two grounds for denying registration were somehow either indistinguishable or inextricably linked. As discussed below, however, these two terms address very different kinds of injury and implicate very different classes of potential plaintiffs. In 1999, the Board finally explicitly recognized the importance of this distinction in Harjo v. Pro-Football, Inc., stating: “Considering the ‘ordinary and common’ meanings of the words ‘scandalous’ and ‘disparage,’ we find that distinct differences in these meanings dictate that we apply different standards for determining disparagement from those enunciated by the Court and Board for determining scandalousness . . . .” These standards are described below.

A. The Test for Determining Whether a Mark is “Scandalous”

Although the Lanham Act orders the PTO to refuse registration to scandalous marks, nowhere does the Act define “scandalous.” Given the “paucity of legislative history” on the meaning of “scandalous” for purposes of Section 2(a), the courts and administrative bodies have generally looked to dictionaries for a definition of the term. In In re Riverbank Canning Co., for example, the Court of Customs and Patent Appeals (CCPA), the predecessor to the Federal Circuit, quoted from two well-known dictionaries in defining “scandalous” as “shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; giving offense to the conscience or moral feelings; . . . [or] calling out [for] condemnation.” Similarly, in Bromberg v. Carmel Self Service, Inc., the Board relied upon dictionary definitions in stating that “scandalous” means “that which offends established moral conception or disgraces all who are associated or involved” and “to horrify or shock the moral sense.” The CCPA has also held that “the threshold for objectionable matter is lower” for scandalous matter under Section 2(a) than for “obscene” matter under the First Amendment.

In a prominent 1999 decision, Harjo v. Pro Football, Inc., the Board examined a challenge brought by several Native Americans alleging that the mark REDSKINS for a football team was both scandalous and disparaging. The Board ultimately determined that the mark was disparaging but not scandalous. In the course of making this determination, the Board clarified the tests for both scandalous and disparaging marks.

The Harjo Board set forth a two-part test for determining whether a mark is scandalous. First, the court or administrative body must determine what the likely meaning of the mark is. Second, the court or administrative body must determine whether, given the likely meaning of the mark, the mark is perceived as scandalous by “a substantial composite of the general public.”

In determining the meaning of the mark, as required under the first prong of the Harjo test, the court or administrative body must look to the relationship between the challenged subject matter and the mark in its entirety, the nature of the goods and services on which the mark is used, and the manner in which the mark is used in the marketplace.
The second prong of the *Harjo* scandalousness test looks to whether a “substantial composite of the general public” would find the mark scandalous. This language was first articulated by the CCPA in *In re McGinley* in 1981. The courts and the Board have emphasized that in evaluating a potentially scandalous mark, it must look to the standards of the general public, and not to the standards of the particular group that might purchase the goods or services on which the mark is used. This distinction is a logical one, as one need not be a consumer of the goods or services on which the mark appears in order to be shocked or offended by the mark.

The “substantial composite” test is by no means universally and enthusiastically embraced by the courts. For example, the dissenting judge in *McGinley* expressed his frustration with the majority’s language, stating: “I am at a loss to know what it means or how one can have a ‘composite’ of a class such as ‘the general public’.” The Federal Circuit also voiced its discomfort with the test in *In re Mavety Media Group Ltd.* in 1994, noting that it nonetheless was “duty bound” to apply the precedent. Despite such judicial misgivings, the substantial composite persists and is the controlling test for evaluating scandalousness of marks today.

The *Harjo* Board explained that a mark that scandalizes a substantial composite of the general public “violates the mores of American society;” thus, the evaluating tribunal must examine the reaction of “American society as a whole.” Contemporary mores and standards are critical in determining whether a mark is scandalous. As the Board stated in *In re Old Glory Condom Corp.*, “What was considered scandalous as a trademark or service mark twenty, thirty, or fifty years ago may no longer be considered so, given the changes in societal attitudes. Marks once thought scandalous may now be thought merely humorous (or even quaint).” Thus, depending upon changing societal views, what was deemed scandalous in the past may not be so in the present and vice-versa.

In a pluralistic society such as the United States, of course, there may be many different opinions as to whether a particular mark is scandalous. This dilemma is resolved by requiring that only a significant portion of the general public, not the entire public or even a majority, be offended by the mark. While it may be disturbing to contemplate such a vague standard – whether a substantial composite of the general public would be shocked or offended by registration of a mark – the alternative of allowing the PTO to make a determination of scandalousness without opportunity for public input is even less palatable. As noted above, the Federal Circuit discourages the PTO from assuming it knows the views of a substantial composite of the public. Rather than the PTO unilaterally denying a mark registration because of scandalousness, the PTO is encouraged to publish the mark for opposition, thus avoiding the specter of the PTO acting as a censor, and thus ensuring that members of the public have an opportunity to weigh in on the issue.

B. The Test for Determining Whether a Mark is “Disparaging”

Disparaging marks are ones that “may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.” “Persons” in this context includes both natural and artificial persons, such as corporations and fraternal organizations. Although there is an extensive body of case law on scandalous marks, only a handful of cases have involved disparaging marks.

The term “disparage,” like the term “scandalous,” is not defined in the Lanham Act, and the legislative history sheds little or no light on what Congress intended this prohibition to encompass. Thus, the courts have given “disparage” its “ordinary and common” meaning as stated in dictionaries contemporaneous with the passage of the 1946 Act, as matter which “may dishonor by comparison with what is inferior, slight, deprecate, degrade or affect or injure by unjust comparison.” Unlike scandalousness, which looks to the conscience or moral feelings of a substantial composite of the general public, “disparagement has an identifiable object.”

In 1999, the *Harjo* Board clarified the test for disparaging marks, setting forth a two-step test for determining whether a mark is disparaging under Section 2(a). In its most fundamental form, this test remarkably similar to that articulated by the *Harjo* Board for evaluating whether a mark is scandalous: First, the court or administrative body has to determine what the likely meaning of the mark is (i.e., would it be understood as referring to persons in an identifiable group?). Second, the court or administrative body must determine whether that likely meaning may be disparaging to a substantial composite of the persons or institutions at issue. In its specifics, therefore, the disparagement test differs significantly from the scandalousness test. While “scandalous” looks to the mores of the general public, disparagement necessarily has an identifiable object, defined under Section 2(a) as “persons, living or dead, institutions, beliefs or national symbols.”

The first prong of the *Harjo* disparagement test requires the court or administrative body to identify the likely meaning of the mark at issue. As with scandalous marks, this requires the tribunal to examine “the relationship between the subject matter in question and the other elements that make up the mark in its entirety; the nature of the goods and/or services; and the manner in which the mark is used in the marketplace in connection with the goods and/or services.” Testimony about the meaning of the mark preferably should come from a linguistics expert or other disinterested witness.

With regard to the second prong of the test, the *Harjo* Board emphasized that where the matter at issue is found to refer to persons or institutions in an identifiable group, the inquiry then becomes whether a substantial composite of the persons in that group view the matter as disparaging. The relevant group must be determined on a case-by-case basis. The *Harjo* Board identified several mechanisms by which petitioners could demonstrate the beliefs of a substantial composite
of the target group, including surveys, resolutions by the affected group, and personal testimony by petitioners. Where the target of the alleged disparagement is an individual or commercial entity, the “substantial composite” test, of course, makes no sense. In that instance, the Harjo Board suggested, the applicable test may be “the perception of a ‘reasonable person of ordinary sensibilities.’”

III. WHO HAS STANDING TO CHALLENGE THE REGISTRATION OF AN ALLEGEDLY SCANDALOUS OR DISPARAGING MARK?

The tests for determining whether a mark is scandalous or disparaging are starting to solidify in the wake of Harjo. The question of who has standing to raise such a challenge is less settled, however, despite recent decisions by the Board and the Federal Circuit that shed some light on this topic. While Lanham Act cases generally have specialized standing rules, Section 2(a) cases present even more particularized issues that require even more detailed and specific standing tests. These issues are discussed below.

A. Standing Generally Under the Lanham Act

“Standing” refers to whether “a party has a sufficient stake in an otherwise justiciable controversy to obtain judicial resolution of the controversy.” The purpose of this doctrine, as explained by the U.S. Supreme Court, is “to ensure, among other things, that the scarce resources of the federal courts are devoted to those disputes in which the parties have a concrete stake.”

Standing has both constitutional and prudential components. In constitutional terms, standing refers to the requirement that courts created pursuant to Article III of the Constitution hear only those disputes in which “the plaintiff has made out a ‘case or controversy’ between himself and the defendant.” As stated by the Supreme Court, “[t]he ‘gist of the question of standing’ is whether the plaintiff seeking relief has alleged such a personal stake in the outcome of the controversy as to assure that concrete adverseness which sharpens the presentation of the issues . . . .” Because an Article III court’s power can only be invoked to redress or prevent injury to the complaining party, the plaintiff must show that he or she has suffered “some threatened or actual injury resulting from the putatively illegal action . . . .” This actual or threatened injury “may exist solely by virtue of statutes creating legal rights, the invasion of which creates standing . . . .”

Prudential limitations on standing are judge-made rules, forming an integral part of “judicial self-government,” that seek “to avoid deciding questions of broad social import where no individual rights would be vindicated and to limit access to the federal courts to those litigants best suited to assert a particular claim.” The purpose of these prudential limitations is to determine whether the plaintiff is “a proper party to invoke judicial resolution of the dispute and the exercise of the court’s remedial powers.” Thus, the federal courts will examine whether the plaintiff has suffered a direct and palpable injury and is within the “zone of interests to be protected or regulated” by the statutory provisions at issue.

Although the Court has stated that Congress may not override the constitutional limitations of actual or threatened injury as required by Article III, Congress may override prudential standing rules. However, the courts presume that Congress has incorporated background prudential standing principles, unless the statute expressly negates those principles. Thus, Congress can statutorily grant standing in instances in which prudential considerations might otherwise bar extension of federal jurisdiction, but it must do so explicitly.

Congress has, in fact, provided statutory standing to those seeking to challenge or oppose registration of a mark, in Sections 13 and 14 of the Lanham Act. Section 13 provides that “[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register . . . may . . . file an opposition . . . of the mark sought to be registered.” Similarly, under Section 14, “[a]ny person who believes that he is or will be damaged by [an existing] registration of a mark” may petition to cancel it.

In determining the scope of statutory grant of standing, the courts start by looking to congressional intent. Although the courts have yet to rule on the precise nature of congressional intent in the context of suits brought under Sections 13 and 14, the Third Circuit has addressed a similar issue in the context of suits brought under Section 43(a) of the Act, finding that the court must consider the statutory text, its structure, and its legislative history in determining whether Congress expressly negated prudential limitations on the standing of plaintiffs to bring suit.

Section 43(a) is specifically directed toward the Lanham Act’s goal of preventing unfair competition. Section 2(a) of the Act, by contrast, focuses on the Lanham Act’s second primary objective, which is to provide a statutory framework for the registration and protection of marks. In this respect, Section 2(a) provides for substantive bars to registration of marks that are based upon public policy concerns, and not necessarily upon competitive harm to others.

Section 45 of the Act describes congressional intent with regard to preventing anti-competitive behavior of the type addressed in Section 43(a). Unfortunately, Congress has not provided us with a similar statutory explanation of its intent regarding the registrability of marks under Section 2. Moreover, Sections 13 and 14 provide enforcement mechanisms for Section 2(a)’s substantive bars that are remarkably broad but that are also unenlightened by any explanatory legislative
Because of this congressional silence, the courts have been forced to step in to define the scope of standing in opposition and cancellation proceedings.

Because the language of Sections 13 and 14 is so broad, referring, as it does, in each instance, to “any person” who merely “believes” that he or she would be damaged by the registration of a mark, the courts have been unable to formulate an “absolute” test for standing in opposition or cancellation actions. Over time, however, the courts have created a two-part test that a plaintiff must meet in order to have standing under Sections 13 and 14 of the Lanham Act. First, the plaintiff must have a “real interest” in the proceedings. Second, the plaintiff must have a “reasonable basis” for his or her belief that his or her interests will be damaged.

The “real interest” prong is intended to prevent “mere intermeddlers” who do not raise a real controversy from bringing opposition or cancellation challenges. Rather, the opposer or challenger must have a legitimate personal interest in opposing or challenging the registration. This limitation is designed “to preclude meddlesome parties from instituting proceedings as self-appointed guardians of the purity of the Register.” The Board has stated, however, that there is “a low threshold for a plaintiff to go from being a mere intermeddler to one with an interest in the proceeding.”

Although actual proof of damage is not required by the statute, either to establish standing or to prevail in the suit, the “reasonable belief of damage” prong means that the plaintiff must have more than a subjective belief that he or she will be damaged by the registration of the defendant’s mark. The plaintiff can demonstrate the reasonableness of his or her belief in damage by establishing that he or she has a direct commercial interest at stake. Commercial damage or direct economic interest in the proceeding is not a prerequisite to standing to challenge or oppose a registration, however.

Thus, the Federal Circuit has recognized two additional grounds for showing a reasonable belief in damage that do not rely upon a commercial interest. First, the petitioner can show that it “possesses a trait or characteristic that is clearly and directly implicated in the proposed trademark.” Alternatively, the petitioner may “allege that others also share the same belief of harm from the proposed trademark,” using surveys or petitions in support.

As a result, the definition of “real interest” in the context of Section 2(a) is much broader than it is in other Lanham Act contexts. As the Board has stated, the “trademark statute protects members of the public against registration of scandalous marks and . . . it is parties who are offended by the scandalous, commercial usage of offensive terms that are within the zone of interest protected by the statute.” Similarly, Section 2(a)’s prohibition against registration of disparaging marks creates a broad class of potential plaintiffs in cancellation or opposition actions — any person who can show that he or she is the object of the alleged disparagement has a “real interest” in the proceeding. Thus, standing requirements in Section 2(a) proceedings have evolved into a special category of trademark standing rules, in which standing rules appear to be very relaxed. These rules are discussed in the next section.

B. Standing to Challenge or Oppose Registration of Allegedly “Scandalous” and “Disparaging” Marks

The sui generis nature of Section 2(a)’s ban on registration of scandalous and disparaging marks raises unique standing issues. Standing actually is not at issue at all in the great majority of Section 2(a) cases, which arise in ex parte proceedings; i.e., where the PTO has denied registration of the mark because it has found the mark to be scandalous or disparaging, and the applicant is appealing the PTO’s decision to the Board or the courts. In such cases, the applicant whose registration has been denied clearly has standing to appeal the examiner’s decision.

Standing does become an issue in inter partes proceedings, where a third party files an opposition to a registration or a petition to cancel a registration under Section 13 or 14 of the Lanham Act. In either instance, the opposer or petitioner must “show (1) that it possesses standing to challenge the continued presence on the register of the subject registration and (2) that there is a valid ground why the registrant is not entitled under law to maintain the registration.” The second inquiry looks to the substantive question of whether the mark violates the Lanham Act’s statutory provisions for registration and requires application of the tests for scandalousness and disparagement discussed earlier.

The first inquiry — whether the opposer or petitioner has standing — is particularly difficult to resolve in the context of Section 2(a) challenges because of the unique nature of these actions. If the opposer or petitioner is challenging the mark as being disparaging, he or she must show membership in the group allegedly being disparaged. As discussed below, this may be easy in some instances (e.g., where the members of the group share some immutable characteristic, such as race or gender), but may be very difficult in others (e.g., where the disparagement is of a belief or some other less concrete a characteristic). And where the opposer or petitioner is challenging a mark as being scandalous, he or she is actually asserting a right on behalf of the public as a whole to prevent the registration of a mark that a substantial composite of the general public would find offensive. The assertion of a public right by a private individual is generally frowned upon in standing doctrine, yet that is precisely what the Lanham Act contemplates in this area. As a result of these unique characteristics, standing doctrine in scandalous or disparaging cases has evolved along very specialized grounds.
The first extensive discussion of standing in Section 2(a) cases came in a 1978 Board decision in *Bromberg v. Carmel Self Service, Inc.* The Board determined that two women had standing to oppose the registration of a chicken restaurant’s mark, *ONLY A BREAST IN THE MOUTH IS BETTER THAN A LEG IN THE HAND.* The opposers argued that the mark was “immoral and scandalous” and was “disparaging to all people of a specific class, and in particular, women.” They had affidavits from various women’s organizations in support of their opposition and had received funding from unspecified contributors to defray the costs of the proceedings.

The Board rejected the applicant’s arguments that the opposers should have been required to show some sort of special injury or damage (separate from that felt by the general class of women) before they would be allowed to sue. While the Lanham Act does not provide for the bringing of a class action, which prevented the opposers from asserting damage claims on behalf of the entire class of women, the opposers were not required to have every member of that group be named as an opposer, nor were they required to show that their injury was somehow unique.

As the first decision substantively analyzing the standing of individuals to challenge a registration on Section 2(a) grounds, *Bromberg* has been a significant and influential case. Nonetheless, the decision reveals a fundamental analytic error common to Section 2(a) cases. The *Bromberg* Board struggled with correctly identifying and analyzing the challenge to a mark as being either scandalous or disparaging. The *Bromberg* opposers challenged the registration on both grounds—that the mark was scandalous and that it was disparaging to women. The *Bromberg* Board, however, did not seem to distinguish between these two statutory grounds, conflating them by ultimately holding that persons who are “members of a group who may believe the mark to be scandalous have the requisite standing” to challenge the registration.

As discussed above, it is critical for the tribunal to distinguish between allegations that a mark is scandalous and allegations that a mark is disparaging, for these two categories implicate very different interests and are resolved through different tests. When the courts and the Board use the terms “scandalous” or “disparaging” imprecisely or interchangeably, they confuse the very foundations of Section 2(a)’s statutory bars to registration, and they obscure the basis for determining whether the opposer or challenger has standing to pursue the action.

Standing in Section 2(a) cases received little attention by the Board and the courts for almost two decades following *Bromberg.* In the lone exception, *Abraham’s Seed v. John One Ten,* the Board found that a company did not have standing to challenge another company’s registration of a SIGN OF THE FISH mark on the grounds that it disparaged Christian beliefs. The challenger had made numerous allegations regarding how its commercial interests would be damaged by the registration, but had not provided any proof of this damage, nor had it provided any evidence regarding how the mark disparaged its Christian beliefs.

The standing logjam broke in 1994, when the Board issued its first decision in *Harjo v. Pro-Football, Inc.* In addressing a motion to strike certain affirmative defenses, the Board rejected the argument that the petitioners did not have standing to challenge the registration of the respondent’s REDSKINS marks. The Board stated that “[i]n order to assert a legally sufficient pleading of standing, a plaintiff must plead facts which, if later proved, would establish that the plaintiff has a real interest in the outcome of the proceeding, that is, a personal interest in the outcome of the case beyond that of the general public.” Here, the petitioners were Native Americans, and had alleged that the mark REDSKINS was a derogatory term referring to Native Americans and that it was offensive to Native Americans and other persons. This, the Board had concluded, was sufficient to show that the petitioners had “a personal interest in the outcome of the case beyond that of the general public,” such that they had standing to challenge the marks.

This decision was quickly followed by two actions brought by the Order Sons of Italy in America, a fraternal organization of Italian-Americans, challenging the registration of marks based on the term “Cosa Nostra,” arguing that the use of such a mark was disparaging to members of the Order. In both instances, the Board determined that the Order had standing to sue because it had alleged that “its good reputation” would be “jeopardized” by the challenged registrations; thus, the Order had shown a personal interest in the outcome of the case beyond that of the general public and had standing to challenge the registrations.

Then, in March, 1999, the Federal Circuit issued what has become the leading case on standing to sue under Section 2(a), *Ritchie v. Simpson.* This case has provided critical insight into what is required to show standing in Section 2(a) cases, yet it also leaves many issues unresolved and many questions unanswered.

In the midst of his double-murder trial, O.J. Simpson applied for federal registration of the word marks OJ SIMPSON, O.J, and THE JUICE, to be used on a variety of items, including figurines, trading cards, and sportswear. The PTO examiner approved the marks and published them for opposition. An individual named William B. Ritchie filed an opposition, claiming that the marks violated Section 2(a)’s prohibition against registration of scandalous and disparaging marks, and Section 2(e)(4)’s prohibition against registration of a non-distinctive mark consisting primarily of a surname.

In his notices of opposition, Ritchie alleged that the registration of the marks would disparage his values, especially those relating to his family, in that Ritchie believed that the applicant’s surname and nicknames had become “synonymous with wife beater and murderer,” that the use of the marks to market the goods identified in the application (some of which were intended to be marketed to children) was “obscene” and “ridicule[d]” Ritchie’s “belief in the family ideal,” that the marks were scandalous in that they were “shocking to the sense of propriety and offensive to one’s moral feelings,” that the registrations would “attempt to justify physical violence against women and use the imprimatur of the government to give the impression that criminal acts may be financially rewarding,” that Ritchie, as a “family man,” was a member of a group
potentially damaged by the registrations, and that Ritchie had obtained petitions from people around the United States who agreed that the marks were scandalous and denigrated their values.\(^{187}\)

The Board dismissed Ritchie’s oppositions, stating that Ritchie’s allegations were insufficient to demonstrate a reasonable belief on his part that he would be personally damaged by these registrations.\(^{188}\) The Ritchie Board treated Ritchie’s oppositions as though they arose solely under the “scandalous” prong of Section 2(a), when, in fact, his oppositions also alleged that the marks were disparaging. The Board then found that he did not have a sufficient interest in the proceedings to assert a claim that a substantial component of the general public would find the marks scandalous.\(^{189}\) Rather, the Board found that “[t]he essence of [Ritchie’s] pleading is . . . that he and others believe that the man who seeks to register those marks has committed acts they find offensive.”\(^{190}\) The Board went on to state:

If we were to find that [Ritchie] has standing based on allegations in his pleadings, we would be, in effect, finding that an opponent’s pleading of feelings of moral outrage directed toward a person (either an individual or a “corporate” person) is a sufficient pleading of standing to oppose, on Section 2(a) “scandalous” and “immoral” grounds, the registration of that person’s name as a trademark or service mark. That would seem to open the way for any individual to challenge the registration of an individual’s or corporation’s trademark or service mark, where that individual opposer pleads, for example, that he or she is offended by the individual or corporate trademark applicant’s products or its hiring policies, political affiliation, environmental record, advertising campaigns, etc. We do not believe that Section 13 of the Lanham Act . . . was intended to have such a result.\(^{191}\)

On appeal, the Federal Circuit reversed the Board’s decision in a 2-1 decision; in the course of doing so, it issued the most comprehensive opinion on Section 2(a) standing provided by any court or Board to date. The Ritchie court’s decision is problematic, in part, perhaps, because the court made a serious fundamental error in its initial review of the law governing standing to oppose registration of a mark.\(^{192}\) The court misquoted Section 2(a), stating that the section prohibited registration of marks that consist of “scandalous matter which may disparage or falsely suggest a connotation with persons, living or dead, institutions, beliefs, or national symbols . . . .”\(^{193}\) Section 2(a) actually refers to “scandalous matter; or matter which may disparage . . . .”\(^{194}\) By omitting the italicized punctuation and words, the Ritchie court conflated the prohibition against scandalous marks into the prohibition against disparaging marks. While the error may have been a simple typographical error on the court’s part, its later discussion of scandalous and disparaging marks, which again conflates the two terms,\(^{195}\) suggests that the court failed to understand the critical distinction between the two grounds for challenging registrations.

In addition, the court seemed to misconstrue the statutory basis for granting standing to opposers. The court stated that the “case or controversy” restrictions for standing that apply to Article III courts do not apply to proceedings before administrative agencies, such as the PTO.\(^{196}\) While it is true that in administrative proceedings, the case or controversy requirements applicable to Article III courts do not apply, and agencies can grant much broader standing to interested parties than can federal courts, the cases cited by the court in support of this proposition were ones addressing the ability of an administrative agency itself to define broadly who can come before it.\(^{197}\) As the Ritchie court correctly noted, “the starting point for the standing determination for the opposer is § 13 of the Lanham Act . . . .”\(^{198}\) However, this is not, as the Ritchie court seemed to suggest, an extension of standing by an administrative agency; rather, Section 13 (and its parallel, Section 14) are examples of Congress statutorily extending standing beyond jurisprudential limitations, as it is entitled to do.\(^{199}\)

The Ritchie court began by noting that the issue presented in the case was not whether the marks at issue actually were scandalous, but whether Ritchie had standing to oppose their registration.\(^{200}\) The court stated that the Board cannot assume that it knows the views of the public and that it cannot substitute its own values and views for that of the public in determining whether a mark is scandalous.\(^{201}\) The purpose of the opposition hearing is to establish how a substantial composite of the general public views the mark. By dismissing Ritchie’s opposition petition, the Board had impermissibly cut off Ritchie’s opportunity to make a showing as to how a substantial composite of the general public would view the challenged marks.\(^{202}\) In effect, the Ritchie court rejected the role of the Board as censor.

The Ritchie majority also emphasized that this was not a case about the morals of the applicant for registration—a characterization with which Judge Newman, in her dissent, strongly disagreed. She argued that “[d]isapproval, by a member of the general public, of the applicant for registration, however notorious that applicant, does not provide standing to oppose registration of the applicant’s commercial trademarks.”\(^{203}\) The majority rejected her position, however, stating that the issue was not the personal offensiveness of the applicant or his personal morals or lack thereof.\(^{204}\) Rather, the issue was whether the use of these marks on goods in the public marketplace would comprise “immoral, deceptive, or scandalous matter which may disparage . . . beliefs . . . or bring them into . . . disrepute.”\(^{205}\) This, the majority concluded, “is a question of public perception, not private morals or even private conduct.”

The Ritchie majority and dissent also disagreed on the application of the prudential limitations on standing in this case. Section 13 of the Lanham Act establishes the broad class of persons who are entitled to oppose a registration—any person who believes that he would suffer some damage as a result of the registration.\(^{206}\) However, as noted above, to have standing, an opposer must also meet two judicially-created requirements: the opposer must have: (1) a “real interest” in the proceedings and (2) a “reasonable basis” for his or her belief of damage.\(^{207}\) The Ritchie majority emphasized that the “real interest” test is to be read broadly, not narrowly. According to the court, the “real interest” test requires merely that the opposer have “a legitimate personal interest in the opposition”;\(^{208}\) i.e., a
The court found that the Board had correctly interpreted the “real interest” test by finding that a person has a “real interest” only if he or she has “a personal interest in the proceeding beyond that of the general public.” The Ritchie court found that the Board had supported its erroneous interpretation by citing Jewelers Vigilance Committee, Inc. v. Ullenberg Corp., which had paraphrased the “beyond that of the general public” language from Lipton Indus. Inc. v. Ralston Purina Co., which the Ritchie court found had taken “out of context” language from the Supreme Court’s decision in Sierra Club v. Morton.

In unraveling this chain of precedents, the Ritchie court stated that the Sierra Club Court had actually noted that “the fact that particular interests are shared by the many rather than the few does not make them less deserving of legal protection through the judicial process.” Rather, stated the Ritchie court, Sierra Club required only that the person seeking standing must distinguish his injury from that of a large section of the public. The “beyond the general public” language found in Jewelers and Lipton was, according to the Ritchie court, merely dicta.

The Ritchie court stated that the opposer need not have a commercial interest not shared by the general public in order to have standing; rather, the opposer must have a personal stake in the outcome of the proceeding. The mere fact that a large number of other people share that same interest does not negate the opposer’s standing. Indeed, the Bromberg Board had found that women, who comprise more than half the general population, had standing to oppose a registration. Here, the Ritchie court found, it must accept as true (for purposes of determining standing) Ritchie’s allegations that he would be damaged by registration of the marks because the marks disparaged his values relating to his family. Ritchie had described himself in his notices of opposition as “a ‘family man’ who believes that the ‘sanctity of marriage requires a husband and wife who love and nurture one another,’ and as a member of group that could be potentially damaged by marks that allegedly are synonymous with wife-beater and wife-murderer.” In addition, Ritchie alleged that the marks were “scandalous because they would ‘attempt to justify physical violence against women.’”

The Ritchie court concluded that the Board had erred in denying Ritchie standing simply because he was a member of a large group with shared concerns. The court stated: “On the contrary, the purpose of the opposition proceeding is to establish what a substantial composite of the general public believes. The limitation placed upon standing in this case by the Board undermines that very purpose.” The court then concluded that the potential injury that Ritchie would suffer if the marks were registered was “disparagement of his alleged belief in a loving and nurturing relationship between husband and wife.” This was enough to show a “real interest” on the part of Ritchie in the opposition: the mere fact that his concerns were shared by a large number of other people -- “perhaps even the majority of the American public” -- did not render him a mere intermeddler without a personal stake in the litigation.

The Ritchie court’s analysis incorrectly conflates the scandalous and disparaging test, however. If the basis for opposing registration is “disparagement” of a belief, the proper test is not what a substantial composite of the general public believes, but rather what a substantial composite of the targeted group believes. And, in fact, the Ritchie court was inconsistent in classifying the oppositions as being based on scandalous or disparaging grounds. In one instance, the court characterized the oppositions to the registration as being based on allegations that the marks were scandalous and the test it articulated -- whether a “substantial composite” of the public would agree with him -- is a scandalousness test. Yet later the court stated that the potential injury that would be suffered by Ritchie if the marks were registered was “disparagement of his alleged belief in a loving and nurturing relationship between husband and wife.”

In her dissent, Judge Newman rejected the majority’s approach, arguing that Board was correct in stating that in order to have standing, the opposer must show that he or she has a personal interest in the outcome beyond that shared by the general public. Most of the cases cited by Judge Newman in support of this position, however, did not arise under Section 2(a)’s bar against registration of scandalous marks, and so did not raise the same public policy concerns presented by Section 2(a) analysis; rather, most of them raise unfair competition concerns. In addition, while Judge Newman’s approach might make sense in the context of a disparagement challenge -- where the challenger must identify the group being disparaged and demonstrate membership within that group -- Judge Newman did not address the critical question of who would have standing to challenge a mark as scandalous if the challenger was required to have a personal interest beyond that of the general public. By definition, a mark is scandalous if “a substantial composite of the general public” believes it to be so; who, then, but a member of that general public would have standing to sue? And, in fact, Judge Newman seemed to completely read out the scandalous prong of Section 2(a) out of the Lanham Act, stating “[u]ntil today, neither the trademark office nor the courts has entertained an opposition or cancellation proceeding where the only purported interest in the outcome is that of the general public.”

Judge Newman further argued that the majority had misconstrued the Supreme Court’s decision in Sierra Club, which she contended “reinforced the requirement of a personal interest in an administrative action beyond that of the general public.” Judge Newman stated: “While the Court recognized that a person may acquire standing through injury other than economic harm, the Court cautioned that ‘broadening the categories of injury that may be alleged in support of standing is a different matter from abandoning the requirement that the party seeking review must have himself suffered an injury.’” In Sierra Club, however, standing was predicated upon the provisions of the Administrative Procedure Act, while Sections 13 and 14 of the Lanham Act expressly confer standing in the trademark opposition and cancellation arenas.
The *Ritchie* majority also discussed the second prong of Section 2(a) standing requirements – whether the opposer has a “reasonable basis in fact” for his or her conclusion that he or she would be damaged by the marks, i.e., something more than a “subjective belief” that damage might occur.240 According to the *Ritchie* court, an opposer can show this reasonable belief in several ways (although the court’s analysis on this point reveals its confusion about the distinction between the scandalousness and disparagement bars). First, the petitioner may possess “a trait or characteristic that is clearly and directly implicated by the proposed trademark,” such as gender or race (which would suggest that the challenge was being brought on disparagement grounds).241 Second, because a substantial composite of the public (a phrase which suggests that the challenge was being brought on scandalousness grounds) may find a mark offensive even if the mark does not implicate particular traits or characteristics, an opposer can also allege that others share the same belief of harm from the proposed trademark, asserting sufficient facts to show that the belief of damage is not a subjective one held by the opposer.242 This could be demonstrated by bringing in petitions or survey evidence of what others believe, as well as affidavits from public interest groups representing persons who allegedly suffered the damage caused by the mark.243

Here, Ritchie had alleged that the marks were damaging to his beliefs as “a Christian, family man.”244 Because the *Ritchie* court did not find these traits or characteristics to be immutable traits or characteristics, such as gender or race, the majority required Ritchie to allege other facts demonstrating that his beliefs were not subjective. Ritchie alleged he had petitions signed by people from around the United States who agreed with him that the marks were scandalous, denigrated their values, and encouraged spouse abuse, and minimized the problem of domestic violence.245 This, the court concluded, was sufficient to constitute “objective proof” that Ritchie had a reasonable basis for his belief of damage.246 Thus, the majority concluded, Ritchie had met the judicially-created tests of “real interest” and “a reasonable belief of damage” such that he had standing to oppose the registrations.247

Four months after the Federal Circuit handed down its decision in *Ritchie*, the Board had the opportunity to apply this new standing precedent in *Boswell v. Mavety Media Group Ltd.*248 In *Boswell*, two individuals opposed the registration of the mark BLACK TAIL for use on adult entertainment magazines.249 One individual, Arnita Y. Boswell, was an African-American female and the mother of a daughter. The other opposer, James M. Clement, was a white male, with four children and seven grandchildren. As summarized by the Board, in their notices of opposition, the opposers alleged that:

- the use of BLACK TAIL as the name of adult entertainment magazines disparages women as a group, and
disparages African American women as a group, brings women as a group into contempt, and brings African American women as a group into disrepute, and brings African American women as a group into disrepute; that the use of BLACK TAIL for adult entertainment magazines is, with respect to women in general, African American women in particular, and a substantial portion of men of all races and colors in the United States, shocking to the sense of decency or propriety, is disgraceful, disreputable and offensive, and gives offense to the conscience or moral feelings.250

Despite this broad language suggesting both scandalousness and disparagement as grounds for the challenge, the opposers challenged the mark before the Board solely on grounds that it was disparaging, and not on grounds that it was scandalous.251

In examining the issue of standing, the Board noted that the opposers had claimed that the mark disparaged women as a group, and African American women in particular. Because opposer Boswell was an African American woman and therefore a member of the group asserted to be disparaged by the mark, the Board determined that she had standing to oppose the mark.252 Because opposer Clement was a white male, which was not a group alleged in the notice of opposition to have been disparaged by the mark and because he had failed to establish facts on which he could base a reasonable belief that he would be damaged by registration of the BLACK TAIL mark, the Board determined that he had no standing to pursue the opposition.253

The *Boswell* Board specifically stated that it was not deciding the general question of whether a person who is not a member of a group alleged to be disparaged could ever establish standing to oppose a mark in a disparagement proceeding.254 Rather, it examined the specific allegations of damage set forth by opposer Clement himself in his notice of opposition. While Clement had alleged that he would suffer if there were a worsening of relations between the majority and minority communities, he did not provide any evidence in support of this claim.255 Though Clement asked that the Board take judicial notice of the allegations, the Board declined to do so, stating that the allegations were “argument and speculation, rather than facts with ‘a high degree of indisputability’ or ‘capable of ready determination by resort to sources whose accuracy cannot reasonably be questioned.’”256 Thus, opposer Boswell had standing, but opposer Clement did not.257

IV. FORMULATING A FUNCTIONAL TEST FOR STANDING IN SECTION 2(a) CASES

As the dissenting judge in *Ritchie* noted,259 opposition (and cancellation) proceedings are a necessary mechanism to correct an inherent inadequacy in the trademark examination process. Given the large number of marks in use and registered in the United States, the PTO cannot possibly ensure that every mark for which registration is sought or acquired is in compliance with the dictates of the Lanham Act. Moreover, as the *Ritchie* majority pointed out,250 when it comes to applying the substantive bars of Section 2(a), with their content-based prohibitions on registration, we do not want the PTO making unilateral decisions about what is or is not scandalous or disparaging. Far better, rather, to publish the marks for opposition
particular stated belief, no matter how idiosyncratic or out-of-the-mainstream it might happen to be. Thus, the American populace, it seems certain that virtually any opposer could find at least some persons willing to support any loosely-defined group might even have a cohesive, shared belief system? Although Ritchie was able to bring in some extrinsic evidence that others shared his beliefs, given the wide diversity in thoughts, beliefs, and attitudes among the American populace, it seems certain that virtually any opposer could find at least some persons willing to support any particular stated belief, no matter how idiosyncratic or out-of-the-mainstream it might happen to be. Thus, the Ritchie test
does not place adequate emphasis on preventing mere intermeddlers from pressing forward their opposition or cancellation claims.

Likewise, Ritchie’s claim that the proposed marks were disparaging to his beliefs as a “Christian” also fall short. The proposed marks were not specifically directed toward persons of the Christian faith, nor did they use Christian images or symbols that could be directly linked to Christians and their belief system. In other cases that have found disparagement of religious beliefs, the connection was much more direct. For example, in *In re Reemtsma Cigarettenfabriken GmbH* the Board upheld a denial of a registration of the mark SENUSSI, which is the name of a Moslem sect, because the mark was to be used on cigarettes, when the sect explicitly prohibited the use of such products. Similarly, *In re Hines*, the Board found that the applicant’s use of the mark BUDDA BEACHWARE for clothing, which depicted an easily-recognizable Buddha figure clothed in palm-tree emblazoned casual wear, was disparaging to the beliefs of adherents to the Buddhist religion.

In these examples, the link between the mark and the religious belief system at issue was direct and clear and easily recognizable to anyone viewing the mark in the marketplace. In *Ritchie*, on the other hand, there was no direct link between the proposed marks based upon the applicant’s name and the religious beliefs of Christians. No one seeing the marks, even if shocked by them, would immediately connect them with disparagement of Christian beliefs. Even if one accepts Ritchie’s premise that registering the name of an accused (though ultimately not convicted) “wife-beater” or “wife-murderer” is antithetical to Christian beliefs, is it not easily just as antithetical to the beliefs of adherents of other organized religions, such as Moslems or Jews, or for that matter to the non-religious beliefs of most atheists or agnostics? This suggests that the challenge in *Ritchie* should not have been brought on disparagement grounds – because there is no clear target being disparaged by the registration of the mark – but rather on scandalousness grounds.

Scandalousness challenges to federal registration of a mark raise their own set of difficult issues. If the test is whether a substantial composite of the general public would find the mark offensive, then any member of the general public must have the opportunity to sue. By the same token, however, we do not mark registrants or applicants subjected to excessive litigation or challenge on these grounds. In a sense, the issue presented in standing case involving a scandalousness claim is the flip side of a class action suit. In a class action suit, the plaintiff attempts to show that he or she is a proper proxy for the class as a whole. In a scandalousness suit, the plaintiff must attempt to show that the “class” (defined as a substantial composite of the general public) actually exists; once the “class” is shown, the plaintiff would automatically be deemed a proper party to represent that “class” through an opposition or cancellation proceeding.

*Ritchie* contained the seeds for correctly defining standing in scandalousness causes of action, but the Federal Circuit did not fully develop the concept. The *Ritchie* court noted that because marks may be offensive to a substantial composite of the general public if they do not implicate particular traits or characteristics (which would lead to a disparagement cause of action), the opposer or challenger could also support the “belief of damage” prong of the standing test by showing that others share his or her same belief of harm from the proposed registration. This, the court stated, could be shown by bringing in evidence sufficient to indicate that the belief is not merely a subjective one on the part of the challenger or opposer, and could take the form of surveys or petitions.

The *Ritchie* court should have taken the analysis one step further, however, by requiring that the petitions or surveys be methodologically sound and capable of demonstrating that a significant portion of the general population would share that belief, not merely a small minority group with idiosyncratic beliefs. Although the courts have determined that a “substantial composite” means less than a majority, it presumably means something more than a bare minimum as well. A scientifically sound study that indicates that a significant number of the general population, say something in excess of 10%, believed they would be harmed by the registration of the mark, would enable scandalousness causes of action to go forward but would still cut off those proceedings where the challenger or opposer is unable to garner sufficient support for his or her allegation.

While the costs of obtaining such data are likely to be substantial and may even prove prohibitive in some instances, placing such a hurdle in front of third parties bringing such actions would help weed out claims brought by mere intermeddlers. It is not unreasonable to ask a challenger or opposer to undertake this expenditure prior to allowing them to file an action that is likely to result in substantial defense fees to the applicant or registrant. In addition, if a “substantial composite” of the general public would be offended by the registration of a particular mark, presumably enough of them would be willing to underwrite the cost of obtaining such data to enable the suit to go forward. (And if not, that would be a good indication that a substantial composite of the general public would not be offended by such marks.)

By instituting a higher standard for establishing standing in scandalousness cases, we can greatly reduce the likelihood of inappropriate challenges based on idiosyncratic beliefs or improper motives. At the same time, however, we do not prevent challenges from going forward where the challenger has a reasonable likelihood of demonstrating on the merits that a substantial composite of the general public does indeed share his or her beliefs.

V. CONCLUSION

It is impossible to formulate rules for standing to bring Section 2(a) challenges to federal registration of marks that will always lead to consistent applications and predictable outcomes. The fluid nature of Section 2(a)’s statutory bars ensures that that will be so. However, that same fluid nature also ensures that federal trademark law is able to accommodate broader societal concerns than just the commercial application of marks and the promotion of fair competition. By formulating more
precise Section 2(a) standing rules, the courts and Board can continue to strike the proper balance between these competing concerns.

FOOTNOTES

1 The Trade-Mark Cases, 100 U.S. 82, 92 (1879).
2 The most recent of these is the creation of a federal cause of action for trademark dilution in the Federal Trademark Dilution Act, 15 U.S.C. § 1125(c) (2000).
3 See infra note 103 and accompanying text.
4 See HAL MORGAN, SYMBOLS OF AMERICA 52 (1986) (reproducing federally registered marks that depict offensive racial stereotypes). [looking for scannable images]
6 See, e.g., Tr. Reg. No. 1711810 (registered Sept. 1, 1992) (design to be used on clothing):

7 See infra note 101 and accompanying text.
9 170 F.3d 1092 (Fed. Cir. 1999).
10 See, e.g., 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 20.7, at 20-18 (4th ed. 1997) (“The O.J. Simpson decision contains the seeds of an administrative and judicial chaos in which harassment before the Trademark Board becomes a weapon of the contentious militant, combative extremist, and well-funded activist.”). The Federal Circuit’s decision in Ritchie, moreover, seemed to push the boundaries of standing doctrine to the limits, potentially opening the floodgates to future challenges.
11 See infra note 40 (collecting cites).
12 See infra Part II (discussing Harjo’s scandalousness and disparagement tests).
13 See infra note 40.
14 See infra notes 57-58 and accompanying text.
15 See infra notes 30-49 and accompanying text (describing the trademark examination process).
16 See 15 U.S.C. § 1127 (2000) (“The term ‘trademark’ includes any word, name, symbol, or device, or any combination thereof . . . [used] to identify and distinguish [the owner’s] goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”). In addition to trademarks, the Lanham Act recognizes service marks (which “identify and distinguish the services of one person . . . from the services of others and . . . indicate the source of the services, even if that source is unknown”), certification marks (which “certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person’s goods or services or that the work or labor on the goods or services was performed by members of a union or other organizations), and collective marks (which are “used by the members of a cooperative, an association, or other collective group or organization”). Id.
17 See 1 McCarthy, supra note 10, § 3.2.
18 See, e.g., Gerry Khermouch, The Best Global Brands, BUS. WK., Aug. 5, 2002, at 92 (listing the top ten brands by value as: Coca-Cola, $69.6 million; Microsoft, $64.1 million; IBM, $51.2 million; GE, $41.3 million; Intel, $30.9 million; Nokia, $30.0 million; Disney, $29.3 million; McDonald’s, $26.4 million; Marlboro, $24.2 million; Mercedes, $121.0 million). In the words of Justice Frankfurter:

The protection of trade-marks is the law’s recognition of the psychological function of symbols. . . . A trade-mark is a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, the aim is the same – to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is attained, the trade-mark owner has something of value.

19 See 2 McCarthy, supra note 10, at § 16.1; The Trade-Mark Cases, 100 U.S. 82, 94 (1879) (trademark law is a creature of common law, and does not arise from an act of Congress).
See Allard Enters. Inc. v. Advanced Programming Res., Inc., 58 U.S.P.Q.2d (BNA) (BNA) 1710, 1715 (6th Cir. 2001) (“The first to use a mark in the sale of goods or services is the ‘senior user’ of the mark and gains common law rights to the mark in the geographic area in which the mark is used.”).

See Keebler Co. v. Rovira Biscuit Corp., 624 F.2d 366, 372 (1st Cir. 1980) (“[R]egistration does not create the underlying right in a trademark. That right, which accrues from the use of a particular name or symbol, is essentially a common law property right . . . .”).


See S. REP. No. 79-1333, at 3 (1946), reprinted in 1946 U.S.C.C.A.N. 1274, 1274: The purpose underlying any trade-mark statute is twofold. One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trade-mark owner.

See also S. REP. No. 79-1333, at 4 (1946), reprinted in 1946 U.S.C.C.A.N. 1274, 1275: Trade-marks, indeed, are the essence of competition, because they make possible a choice between competing articles by enabling the buyer to distinguish one from the other. Trade-marks encourage the maintenance of quality by securing to the producer the benefit of the good reputation which excellence creates. To protect trade-marks, therefore, is to protect the public from deceit, to foster fair competition, and to secure to the business community the advantages of reputation and good will by preventing their diversion from those who have created them to those who have not.

The Lanham Act also provides for the creation and maintenance of a Supplemental Register for marks that are capable of distinguishing their owners’ goods and services, but do not yet do so. See 15 U.S.C. §§ 1091-96 (2000). The Lanham Act does not provide for opposition of registrations on the Supplemental Register. See id. at § 1092 (“Marks for the supplemental register shall not be published for or be subject to opposition . . . .”). Marks on the Supplemental Register are subject to cancellation challenges, however. See id. (permitting “any person” who “believes that he is or will be damaged” by placement of a mark on the Supplemental Register to petition for cancellation of such registration). In addition, every state has adopted its own trademark statute and registration scheme. Most of these statutes are based upon the Model State Trademark Act. See INT’L TRADEMARK ASSOC., STATE TRADEMARK AND UNFAIR COMPETITION LAW app. 5-1 to 5-4 (1989) (rel. no. 28, Nov. 2002) (indicating which states follow the Model State Trademark Act).


Id. at § 1072.

Id. at § 1121.

Id. at § 1115.

Id. at § 1072.

Id. at § 1051.

Id. at § 1062(a).

These statutory bars are discussed infra notes 65-79 and accompanying text.


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; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19 [section 2(9) of the Uruguay Round Agreements Act]) enters into force with respect to the United States.

(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) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.
Section 2(a) of the Lanham Act: Can One Man’s Vulgarity Be Another’s Registered Trademark?,
conditions” doctrine, violation of the First Amendment’s guarantee of free speech, often on grounds that it violates the “unconstitutional registration on the Principal Register. This is the most common ground for denying an application for registration on the Principal Register. See 3 McCarthy, supra note 10, § 19.75, at 19-66.

Although some commentators and litigants have argued that Section 2(a)’s bar on scandalous and disparaging marks is a violation of the First Amendment’s guarantee of free speech, often on grounds that it violates the “unconstitutional conditions” doctrine, see, e.g., 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?, 54 OHIO ST. L.J. 331 (1993); Michelle B. Lee, Section 2(A) of the Lanham Act as a Restriction on Sports Team Names: Has Political Correctness Gone Too Far?, 4 SPORTS LAW. J. 65 (1997); Jeffrey Lefstin, Note, Does the First Amendment Bar Cancellation of REDSKINS?, 52 STAN. L. REV. 665 (2000); Kimberly A. Pace, The Washington Redskins® Case and the Doctrine of Disparagement: How Politically Correct Must a Trademark Be?, 22 PEPP. L. REV. 7 (1994); Cameron Smith, Note and Comment, Squeezing the Juice® out of the Washington Redskins®, Intellectual Property Rights in “Scandalous” and “Disparaging” Trademarks After Harjo v. Pro-Football, Inc., 77 WASH. L. REV. 1295 (2002); John V. Tait, Note,
Trademark Regulations and the Commercial Speech Doctrine, 67 FORDHAM L. REV. 897 (1998), the courts have upheld the constitutionality of Section 2(a) on the grounds that refusal to federally register a mark does not prevent the applicant from using the mark, and so does not affect the applicant’s free speech rights. See, e.g., Ritchie v. Simpson, 170 F.3d 1092, 1099 (Fed. Cir. 1999) (stating that “[a]lthough the mark holder who is denied federal registration will not receive the benefits conferred on a federal trademark registrant, the mark holder may and can continue to use the mark”); In re Mavety Media Group, Ltd., 33 F.3d 1367, 1374 (Fed. Cir. 1994) (rejecting First Amendment Challenge to PTO’s refusal to register the mark “BLACK TAIL”); In re Hershey, 6 U.S.P.Q.2d (BNA) 1470, 1472 (T.T.A.B. 1988) (Cissel, Member, concurring) (“[T]his is not a constitutional issue involving the right to free speech. Applicant has used and might well continue to use this mark whether or not we find it is entitled to registration under the Lanham Act.”). See also In re McGinley, 660 F.2d 481, 484 (C.C.P.A. 1981), where the court stated that “it is clear that the PTO’s refusal to register appellant’s mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant’s First Amendment rights would not be abridged by the refusal to register his mark.” See also Stephen R. Baird, Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks, 83 TRADEMARK REP. 661 (1993) (arguing that Section 2(a) is constitutional). But see Ritchie, 170 F.3d at 1103-04 (Newman, J., dissenting) (arguing that § 2(a) violates First Amendment rights).

See infra Part II.

41 See infra Part II.
42 37 C.F.R. § 2.80 (2002).
45 Id. at § 1070.
46 An ex parte proceeding is one in which the parties are the applicant and the PTO. See BLACK’S LAW DICTIONARY 597 (7th ed. 1999). An inter partes proceeding, by contrast, is a case between two parties (the mark applicant or registrant and a third party), in which the PTO is not a litigant. Id. at 823. There are four types of inter partes proceedings in trademark cases: oppositions, cancellations, concurrent use proceedings, and interferences. See 3 JEROME GILSON, TRADEMARK PROTECTION AND PRACTICE § 9.01[2][a] (2002). Only the first two types of inter partes proceedings -- oppositions and cancellations -- are discussed in this Article.
48 Id. at § 1071(a); 28 U.S.C. § 1295(a)(4)(B) (2000).
49 15 U.S.C. §§ 1071(b) and 1121 (2000). The courts have indicated that where a party challenges the Board’s decision in federal district court, “the court’s standard of review is a hybrid deferential treatment and de novo scrutiny.” Harjo v. Pro-Football, Inc., 57 U.S.P.Q.2d (BNA) 1140, 1142 (D.D.C. 2000) (citation omitted). Because of the Board’s expertise in trademark disputes, “findings of fact made by the [TTAB] are given great weight and not upset unless new evidence is introduced which carries thorough conviction.” Id. (citations omitted; brackets in original). Legal questions are reviewed de novo, however, as “the district court is just as able as the TTAB to determine an issue of law.” Id. (citation omitted). See also In re Mavety Media Group, Ltd., 33 F.3d 1367, 1371 (Fed. Cir. 1994) (“While we review the Board’s underlying fact findings for clear error, we review de novo the Board’s ultimate legal conclusion of scandalousness.”).
51 See id. Other grounds include allegations that the mark has become generic, is functional, has been abandoned, or that the registration was obtained through fraud or should never have been granted because the registration violates one of the content-based prohibitions of Sections 2(a)-(c) of the Act, see id. at § 1052(a)-(c) (quoted supra note 33), or is being used in such a way as to misrepresent the source of the goods or services on which it is being used. Id.
52 But see id. at § 1119, which provides: “In any action involving a registered mark the court may ... order the cancellation of registration ...”
53 See In re Mavety Media Group Ltd., 33 F.3d 1367, 1371 (Fed. Cir. 1994) (in an ex parte hearing, “[t]he PTO has the burden of proving that a trademark falls within the prohibition of section 1052”).
54 See Hoover Co. v. Royal Appliance Mfg. Co., 238 F.3d 1357, 1360 (Fed. Cir. 2001) (“In opposition proceedings, the opposer bears the burden of establishing that the applicant does not have the right to register its mark.”).
55 See Cerveceria Centroamericana, SA v. Cerveceria India, Inc., 892 F.2d 1021, 1023 (Fed. Cir. 1989) (“Because a trademark owner’s certificate of registration is ‘prima facie evidence of the validity of the registration’ and continued use of the registered mark, the burden of proof is placed upon those who seek cancellation.”) (citation omitted).
56 See, e.g., Dep’t of Justice, FBI v. Calspan Corp., 578 F.2d 295, 300-01 (C.C.P.A. 1978) (in cancellation proceedings, “burden is on petitioner to show by a preponderance of the evidence that it is or will be damaged by continued registration of the mark). Most cancellation and opposition actions are premised on Section 2 of the Lanham Act, although other sections of the Act permit these actions as well. See, e.g., Young v. AGB Corp., 152 F.3d 1377, 1380 (Fed. Cir. 1998) and cases cited therein.
57 See, e.g., In re Over Our Heads, Inc., 16 U.S.P.Q.2d (BNA) 1653, 1654-55 (T.T.A.B. 1990) (“Because the guidelines are somewhat vague and because the determination is so highly subjective, we are inclined to resolve doubts on the issue of whether a mark is scandalous or disparaging in favor of applicant and pass the mark for publication with the knowledge that
if a group does find the mark to be scandalous or disparaging, an opposition proceeding can be brought and a more complete record can be established."); In re Mavety Media Group, Ltd., 33 F.3d 1367, 1374 (Fed. Cir. 1994) (“commending” the Board’s practice of publishing potentially scandalous marks for opposition rather than unilaterally determining whether a mark is scandalous); In re Hines, 32 U.S.P.Q.2d (BNA) 1376, 1377 (T.T.A.B. 1994) (stating that the Board would pass a mark that allegedly disparaged Buddhists for publication because the Board wanted “to avoid interposing its own judgment for that of Buddhists”).


In re Shell Oil Co., 992 F.2d 1204, 1209 (Fed. Cir. 1993) (citing 2 McCarthy, supra note 10, § 20.01[1] (3d ed. 1992)) (in a case challenging a mark under section 2(d)’s prohibition against registration of marks likely to confuse consumers). Thus, the examiner is not “the guardian of public virtue when making determinations under Section 2(a) of the Lanham Act,” as suggested by one commentator. See Baird, supra note 40, at 750.

See Estate of P.D. Beckwith, Inc. v. Comm’r of Patents, 252 U.S. 538, 546 (1920) (“refusal to register a mark does not prevent a former user from continuing its use, but it deprives him of the benefits of the statute”); 74 AM. JUR. 2D Trademarks and Trade Names § 70 (“the denial of an application for registration of a mark does not, of itself, prevent the continued use thereof by the applicant; it merely deprives him of the benefit of the protection accorded to the registered marks”). The Restatement (First) of Torts 726 (1938), however, provides that a “designation cannot be a trade-mark or tradename if it is scandalous or indecent, or otherwise violates a defined public policy.” In addition, 47 states have statutes denying registration to scandalous, immoral, and disparaging marks. Only Hawaii, Maine, and Wisconsin do not. See Justin G. Blankenship, Case Note, The Cancellation of Redskins as a Disparaging Trademark: Is Federal Trademark Law an Appropriate Solution for Words that Offend?, 72 U. COLO. L.REV. 415, 451-52 & nn. 231-232 (2001) (collecting statutes).

See supra notes 25-29 and accompanying text (describing benefits from federal registration).

See infra note 68.

See, e.g., In re McGinley, 660 F.2d 481, 486 (C.C.P.A. 1981) (“We do not see [Section 2(a)] as an attempt to legislate morality, but, rather, a judgment by the Congress that such marks [should] not occupy the time, services, and use of funds of the federal government.”). But see id. at 487 (Rich, J. dissenting) (“More ‘public funds’ are being expended in the prosecution of this appeal than would ever result from the registration of the mark.”); Jendi B. Reiter, Redskins and Scarlet Letters: Why “Immoral” and “Scandalous” Trademarks Should be Federally Registrable, 6 FED. CIR. B.J. 191, 199 (1996) (arguing that because the PTO’s trademark operations are entirely funded by application and maintenance fees, it is the PTO’s opposition to a mark, rather than its approval, that is more likely to cause expenditure of federal funds”). These arguments ignore the potential deterrence effect of the PTO denying registrations to allegedly scandalous and disparaging marks, however.

See, e.g., Bruce C. Kelber, “Scalping the Redskins:” Can Trademark Law Start Athletic Teams Bearing Native American Nicknames and Images on the Road to Racial Reform?”, 17 HAMLINE L.REV. 533, 560-61 (1994) (“[T]he government has a substantial interest in prohibiting certain marks from carrying the implied approval of the federal government” and “does not want to encourage these marks by granting exclusive ownership.”). But see In re Old Glory Condom Corp., 26 U.S.P.Q.2d (BNA) 1216, 1220 n.3 (T.T.A.B. 1993) (“the act of registration is not a government imprimatur or pronunciation that the mark is a ‘good’ one in an aesthetic, or any analogous, sense”)

Other commentators, however, argue that all marks should be registered, regardless of their content, and that the marketplace should decide what is or is not acceptable commercial behavior. See infra notes 260-61 and accompanying text.

15 U.S.C. § 1052(a) (2000). Two prohibitions in Section 2(a) – that against registration of “scandalous” marks and that against registration of “immoral” marks -- can be treated as a single category. As a practical matter, no reported decision has barred registration of a mark on the sole grounds that it is immoral, see, e.g., McGinley, 660 F.2d at 484 n.6 (C.C.P.A. 1981); Mavety Media, 1993 TTAB Lexis 25, at *1 n.2 (T.T.A.B. 1993); rather, the issue of “immorality,” where it arises at all, is subsumed into the analysis of whether the mark is “scandalous.” See, e.g., id. at *1, n2. (“Where refusal have been made for both reasons, the cases seem to focus almost exclusively upon the issue of whether a mark is scandalous.”)

Although this Article focuses on federal registration, almost all states would refuse to register such marks as well, see supra notes 60 and accompanying text, and most international agreements, such as NAFTA, would recognize that such marks should not receive legal protection. See, e.g., North American Free Trade Agreement, Dec. 17, 1992, art. 1708(14), 32 I.L.M. 289, 673 (1994) (NAFTA) (entered into force January 1, 1994) (“Each Party shall refuse to register trademarks that consist of or comprise immoral, deceptive or scandalous matter or matter that may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or any Party’s national symbols . . . . ”). For a listing of the relevant state statutes, see Tait, supra note 40, at 907 n.94.

15 U.S.C. § 1052(a). The explicit language of Section 2(a) states that registration shall be refused if the mark consists of matter that: (1) is scandalous; (2) is immoral; (3) is deceptive; (4) may disparage persons (living or dead), institutions, beliefs, or national symbols; (5) may bring persons (living or dead), institutions, beliefs, or national symbols into contempt or disrepute; or (6) may falsely suggest a connection with persons (living or dead), institutions, beliefs, or national symbols. Thus, while the first three categories ban registration of any mark that “is” scandalous, immoral, or deceptive; the latter three
categories, on the other hand, ban registration of any mark that “may” fall within one of the proscribed categories. See infra note 116 (discussing the significance of the word “may” in this context). In addition, once a mark has been placed on the Principal Register, it can be canceled or opposed in an inter partes proceeding under the same standard. 15 U.S.C. § 1063-64 (2000).

The Lanham Act also bars registration of matter that is “deceptive;” as a public policy matter, the Act does not permit registration of marks that deceive the public. Section 2(a)’s prohibition against registration of deceptive marks is distinct from Section 2(e)’s ban against registration of “deceptively misdescriptive” marks, 15 U.S.C. § 1052(e)(1) (quoted supra note 33) unless they have become distinctive of the applicant’s goods or services. 15 U.S.C. § 1052(f) (quoted supra note 33). The focus here is on the prevention of deception to the public – one of the two basic objectives of the Lanham Act, see supra note 33 and accompanying text, as opposed to the content-based basis of other parts of Section 2(a).

Section 2(a) prohibits registration of marks that disparage: (1) persons; see Morehouse Mfg. Corp. v. J. Strickland & Co., 407 F.2d 881, 888 (C.C.P.A. 1969); (2) institutions; see Gavel Club v. Toastmasters Int’l, 127 U.S.P.Q. (BNA) 88, 89 (T.T.A.B. 1960) (unincorporated fraternal-type associations); Frederick Gash, Inc. v. Mayo Clinic, 461 F.2d 1395 (C.C.P.A. 1972) (professional organizations); In re NAFTA, 43 U.S.P.Q.2d (BNA) 1218 (T.T.A.B. 1998) (NAFTA is an institution); (3) beliefs; and (4) national symbols. See In re Anti-Communist World Freedom Congress, Inc., 161 U.S.P.Q. (BNA) 304, 305 (T.T.A.B. 1969) (case law indicates that national symbols of other countries are also protected by Section 2(a)). While the Act also prohibits registration of marks that may bring living or dead persons, institutions, beliefs, or national symbols into “contempt” or “disrepute,” I could find no reported decision that relied solely on those grounds in denying registration of a mark; rather, this ban seems to be subsumed into the ban again “disparaging” marks. In Greyhound Corp. v. Both Worlds, Inc., 6 U.S.P.Q.2d (BNA) 1635, 1641 (T.T.A.B. 1988), for example, the Board stated:

[T]he offensiveness of the [challenged] design becomes even more objectionable because it makes a statement about opposer itself, and holds opposer up to ridicule and contempt. Accordingly, we find as a matter of law that applicant’s design disparages opposer and is precluded from registration by Section 2(a) of the Act.

Finally, the Act prohibits registration of marks consisting of or comprising matter that may falsely suggest a connection with living or dead persons, institutions, beliefs, or national symbols. This section is remarkably similar to Section 2(d)’s ban against registration of marks that are likely to confuse, see 15 U.S.C. §1052(d) (quoted supra note 33), and the two grounds are often pled together as alternative grounds for opposing a mark registration. See, e.g., Ritz Hotel Ltd. v. Ritz Closet Seat Corp., 17 U.S.P.Q.2d (BNA) 1466 (T.T.A.B. 1990). After the mark has been registered for five years, however, Section 2(d) ceases to be available as a ground for challenge, see 15 U.S.C. § 1064(a) (2000), while challenges may be brought under Section 2(a) at any time. See 15 U.S.C. § 1064(3) (2000). The Federal Circuit has stated that because these standards for challenge are inconsistent between the two sections, Congress could not have intended the sections to be read as identical. See Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co., 703 F.2d 1372, 1376 (Fed. Cir. 1983) (“Clearly the same standard cannot be adopted for § 2(a) as for § 2(d). To do so would nullify the deliberate omission of § 2(d) from § 14.”).

The Federal Circuit resolved this dilemma by finding that Section 2(a) was intended to control the use of one’s name or equivalent even though the name had not been used a mark or trade name, see Board of Trustees v. BAMA-Werke Curt Baumann, 231 U.S.P.Q. (BNA) 408, 410 (T.T.A.B. 1986) (stating a plaintiff can prevail under § 2(a) even if the name has not been commercially exploited as a mark), while Section 2(d)’s likelihood of confusion claim is based primarily in commercial or personal rights. See Treadwells Drifters Inc. v. Marshak, 18 U.S.P.Q.2d (BNA) 1318, 1322 (T.T.A.B. 1991) (Hanack, member) (stating that “likelihood of confusion cases, involving claims under Section 2(d), and cases involving claims of false suggestions of a connection, under Section 2(a), . . . are predominantly assertions of exclusive commercial or personal rights . . . .”).

67Act of Feb. 20, 1905, ch. 592, §§ 1-30, 33 Stat. 724 (1905) (repealed 1946) (previous version at 15 U.S.C. § 81-109 (repealed 1946). Section 5(a) of the Trade-Mark Act of 1905, 15 U.S.C. § 85(a) (1905) provided: “That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark – (a) consists of or comprises immoral or scandalous matter.”

68See McGinley, 660 F.2d at 485 (“Because there is a paucity of legislative history of this provision, we must look to the ‘ordinary and common meaning’ of [scandalous].”); In re Riverbank Canning Co., 95 F.2d 327, 328 (C.C.P.A. 1938) (“Its legislative history does not aid us in arriving at the intent of Congress in its enactment, and we must give to the word ‘scandalous’ its ordinary and common meaning.”) (interpreting 1905 Act); Hearings Before the Subcomm. of the House Comm. on Patents on H.R. 4744, 76th Cong., 1st Sess. 21 (1939) (testimony of Assistant Commission of Patents Leslie Frazer) (“the use of this word [disparage] in this connection is going to cause a great deal of difficulty in the Patent Office, because . . . it is always going to be just a matter of the personal opinion of the individual parties as to whether they think [the mark] is disparaging.”).
arguments. Required federal courts to exhaust all non-constitutional avenues for resolving a case before turning to constitutional.

“disparaging” was so vague as to deny due process, but declined to decide the issue, stating that the avoidance doctrine referred to registering a trademark on the grounds that it is scandalous does not violate First Amendment free speech rights:

It is clear that the PTO’s refusal to register appellant’s mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant’s First Amendment rights would not be abridged by the refusal to register his mark.

McGinley, 660 F.2d at 484. Several commentators have criticized McGinley, arguing that Section 2(a) does violate First Amendment rights. See, e.g., Baird, supra note 40, at 685-86; Davis, supra note 40, at 345-47; Lee, supra note 40, at 66-67; Pace, supra note 40, at 36 n. 192; Lefstin, supra note 409, at 677-78; Smith, supra note 40 at 1324; Tait, supra note 409 at 936. See generally supra note 40 (discussing First Amendment challenges to Section 2(a)).

50 U.S.P.Q.2d (BNA) 1705 (T.T.A.B. 1999). Ultimately, the Board found that the Redskins marks were disparaging to Native Americans, but were not scandalous to the general public.

The Board stated that the public’s acceptance of the word “Redskins” was “inconsistent with the sense of outrage by a substantial composite of the general population that would be necessary to find this word scandalous in the context of the subject marks and the identified services.” 50 U.S.P.Q.2d (BNA) at 1749.

91. The Harjo Board’s test for disparaging marks is discussed infra at notes 89-102 and accompanying text.

50 U.S.P.Q.2d (BNA) at 1736.
Id. Thus, for example, the Board determined that the mark “BIG PECKER BRAND” was not scandalous when used on t-shirts when accompanied by a picture of a rooster. In re Hershey, 6 U.S.P.Q.2d (BNA) 1470, 1472 (T.T.A.B. 1988). Similarly, the use of the mark “ACAPULCO GOLD” was not scandalous when used on suntan lotion, even though the term is often used as slang for marijuana. In re Hepperle, 175 U.S.P.Q.2d (BNA) 512 (T.T.A.B. 1972). However, in In re Wilcher Corp., 40 U.S.P.Q.2d (BNA) 1929 (T.T.A.B. 1996), the Board rejected the applicant’s argument that “dickhead” was simply a reference to the applicant’s nickname, noting that the mark “consists of the words DICK HEADS’ positioned directly underneath a caricature of a human head composed primarily of a graphic, readily recognizable representation of male genitalia, in which the scrotum serves as the chin, the penis as the nose, and the pubic hair as the hair on the head.” Id. at 1933. Likewise, the mark “DOUGH-BOY,” when used as a mark for “a prophylactic preparation for the prevention of venereal disease” and accompanied by a picture of soldiers was considered scandalous, as the term was a nickname for World War I soldiers. Doughboy Indus., Inc. v. The Reese Chem. Co., 88 U.S.P.Q. (BNA) 227, 228 (Pat. Off. 1951).

Commentators have debated whether marks can ever be held scandalous per se, as opposed to being evaluated in the context of the good or service in connection with which it is used. See, e.g., Baird, supra note 40, at 769-73 (arguing that because a mark has no meaning separate from its association with the goods or services it identifies, a per se test is “probably an inappropriate standard in the context of scandalous and immoral determinations under Section 2(a)”); Ethan G. Zlotchew, “Scandalous” or “Disparaging”? It Should Make a Difference in Opposition and Cancellation Actions: Views on the Lanham Act’s Section 2(a) Prohibitions Using the Example of Native American Symbolism in Athletics, 22 COLUM.-VLA & THE LAW THE ARTS 271, 239, 241-42 (1998) (arguing that a per se test should be used in certain instances for evaluating scandalous or disparaging marks). A few cases could be read as that suggesting that certain marks, consisting of profanity or religious symbols or words, may be considered per se scandalous. See In re Tinseltown, 212 U.S.P.Q. (BNA) 863 (T.T.A.B. 1981) (suggesting that the mark BULLSHIT was scandalous per se); Ex parte Summit Brass & Bronze Works, Inc., 59 U.S.P.Q. (BNA) 22, 23 (Comm’r 1943) (suggesting that the mark AGNUS DEI with a pictorial representation was scandalous per se).


95 See In re Tinseltown, Inc., 212 U.S.P.Q. (BNA) 863, 865 (T.T.A.B. 1981) (“[W]e reject applicant’s argument that the question is whether its mark is scandalous should be evaluated in the setting of its posh clientele. . . . [I]t seems to us that we are required to apply a broader standard . . . . [W]e could not possibly apply a standard of public policy to the question before us which would be limited to a particular stratum of society, defined by its level of ‘sophistication,’ or, as others might perceive it, its level of vulgarity.”). Similarly in In re Riverbank Canning Co., 95 F.2d 327, 329 (C.C.P.A. 1938), the CCPA stated: “[W]e feel certain that [the] use of the mark MADONNA upon wine for beverage purposes would be shocking to the sense of propriety of nearly all who do not use wine as a beverage, and also to many who do so use it; therefore, we think such use of the word “Madonna” would be scandalous and its registration prohibited under [the 1095 Trade-Mark Act].” However, in In re Hershey, 6 U.S.P.Q.2d (BNA) 1470 (T.T.A.B. 1988), the Board suggested, whether deliberately or inadvertently through inartful drafting, that purchasers were the relevant subgroup to consider in determining whether a mark was scandalous. In reversing the examiner’s denial of registration to the mark BIG PECKER BRAND as being scandalous, the Board stated that “the inclusion of the bird design would make it less likely that purchasers would attribute any vulgar connotation to the word mark . . . . ” Id. at 1472. Similarly, in a concurrence, Board Member Cissel wrote in that “To suggest that a significant number of potential purchasers of applicant’s shirts would be offended by applicant’s trademark for them is . . . unfounded . . . . ” Id. at 1472 (Cissel, concurring).

96 660 F.2d at 487 (Rich, J., dissenting).

97 33 F.3d 1367, 1371 (Fed. Cir. 1994) (“While we recognize the inherent difficulty in fashioning a single objective measure like a substantial composite of the general public from the myriad of subjective viewpoints, we are duty bound to apply the standard set forth by our predecessor court.”) (citing McGinley, 660 F.2d at 487 (Rich, J., dissenting)).

98 Harjo, 50 U.S.P.Q.2d (BNA) at 1738.

99 See In re Thomas Labs., Inc., 189 U.S.P.Q. (BNA) 50, 52 (T.T.A.B. 1988) (stating that “it is imperative that fullest consideration be given to the moral values and conduct which contemporary society has deemed to be appropriate and acceptable”).


101 Id. at 1219. See also In re Mavety Media Group Ltd., 33 F.3d 1367, 1371 (Fed. Cir. 1994) (“[W]e must be mindful of ever-changing social attitudes and sensitivities. Today’s scandal can be tomorrow’s vogue. Proof abounds in nearly every quarter, with the news and entertainment media today vividly portraying degrees of violence and sexual activity that, while popular today, would have left the average audience of a generation ago aghast.”).

102 In the 1930s, for example, the mark “Queen Mary” for women’s underwear was rejected as being scandalous because it was disrespectful of the former queen. See Ex parte Martha Maid Mfgs. Co., 37 U.S.P.Q. (BNA) 156 (Comm’r Pat. 1938). It is highly debatable, however, whether the mark would be rejected today, when few Americans could identify the queen being referenced by the mark. Similarly, the mark “Madonna” was rejected for registration for use on wine in 1938 and again in 1959 as being scandalous when used in that context. See In re P.J. Valckenberg, GmbH, 122 U.S.P.Q. (BNA) 334 (T.T.A.B.
Similarly, as discussed supra note 4 and accompanying text, many marks incorporating racial or ethnic stereotypes were deemed acceptable in the past, but are not acceptable today.

McGinley, 660 F.2d at 485 (“Whether or not the mark, including innuendo, is scandalous is to be ascertained from the standpoint of not necessarily a majority, but a substantial composite of the general public.”). See also Ritchie v. Simpson, 170 F.3d 1092, 1094 (Fed. Cir. 1999) (“Whether a mark comprises immoral and scandalous matter is to be ascertained in the context of contemporary attitudes, and the relevant viewpoint is not necessarily that of a majority of the general public, but of a ‘substantial composite.’”) (quoting In re Mavety Media Group Ltd., 33 F.3d 1367, 1371 (Fed. Cir. 1994)).

The Federal Circuit has suggested (without deciding) that where the Board does make such a determination, “a standard dictionary definition and an accompanying editorial designation of vulgarity” alone may not be sufficient to demonstrate the belief of a substantial composite of the general public, Mavety Media, 33 F.3d at 1374, though “evidence such as consumer surveys” would suffice. Id.

In addition, while Section 2(a) prohibits registration of matter that “is” scandalous, it prohibits registration of matter that “may be” disparaging. The Harjo Board explained the difference as follows:

The use of the term may is necessary in connection with disparage in Section 2(a) to avoid an interpretation of this statutory provision that would require a showing of intent to disparage [on the part of the mark holder]. Such a showing would be extremely difficult in all except the most egregious cases. Rather, this provision, as written, shifts the focus to whether the matter may be perceived as disparaging.

50 U.S.P.Q.2d (BNA) at 1738. The Board went on to state that “the intent, or lack thereof, to ensure that the disparaging connotation of matter in a mark is so perceived is merely one factor to consider in determining whether a mark may be disparaging. It is not dispositive of the issue of disparagement.” Id.

Id. at 1739.

Id. at 1728-32; compare Order Sons of Italy in American v. Profumi Fratelli Nostra Ag, 36 U.S.P.Q.2d (BNA) 1221, 1223 (T.T.A.B. 1995) (granting standing to a fraternal order of Italian Americans to challenge a mark with Mafia connotations).

Most of the scandalousness cases have arise in ex parte proceedings, however. The inter partes decisions that are the focus of this Paper generally involve disparagement claims.

In re Harjo, 50 U.S.P.Q.2d (BNA) at 1737-38 & n.98. Id. at 1738.

Id.


Id. at 1737.


Id. at § 1127 defines “person” as including “a juristic person as well as a natural person.”

See, e.g., Order Sons of Italy in Am. v. Profumi Fratelli Nostra Ag, 36 U.S.P.Q.2d (BNA) 1221, 1223 (T.T.A.B. 1995) (granting standing to a fraternal order of Italian Americans to challenge a mark with Mafia connotations).

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In In re Hines, 31 U.S.P.Q.2d (BNA) 1685, 1688 (T.T.A.B. 1994), vacated on other grounds, 32 U.S.P.Q.2d (BNA) 1376 (T.T.A.B. 1994)). In Harjo, surveys indicated that approximately 37 percent of Native Americans found the word “Redskins” offensive, id. at 1745; while this was less than a majority, it was sufficient to satisfy the “substantial composite” test.

In In re Hines, 31 U.S.P.Q.2d (BNA) 1685 (T.T.A.B. 1994), vacated on other grounds, 32 U.S.P.Q.2d (BNA) 1376 (T.T.A.B. 1994), in determining whether the mark “BUDDHA BEACHWARE” accompanied by a drawing of Buddha was disparaging, the Board had to look to the perceptions of adherents to Buddhism. After reviewing various encyclopedia entries, the Board concluded that the image of Buddha was “one which is a subject of respect, reverence and devotion.” Id. at 1689. Thus, the Board concluded, the applicant’s depiction of Buddha “slights and cheapens the image to which Buddhists pay devotion” and is therefore disparaging. Id. Here, the Board was not concerned with whether Buddhists would or would not wear the beachwear connected with the mark (in fact, the court noted that the record was silent on this question), but rather that the depiction of the founder of Buddhism in “palm tree-emblazoned casual wear for commercial purposes,” was disparaging. Id. at 1691. In addition, the Board emphasized, however, that it did not hold that the word “Buddha” and/or the image of Buddha are per se unregistrable; rather, it found only that the particular depiction of Buddha in this particular mark was disparaging. Id. at 1690. The dissent in took issue with the majority’s conclusion that the depiction of Buddha in casual dress was disparaging of Buddhism or Buddhists. Id. at 1691 (Hanak, A., Trademark J., dissenting). The dissent pointed out
that the examiner bears the burden of demonstrating that a mark is statutorily barred under Section 2(a) from registration, id., finding that the prior registration of five other marks depicting Buddha cast doubt on whether the challenged mark was indeed disparaging.

Harjo, 50 U.S.P.Q.2d (BNA) at 1739 ([I]f the alleged disparagement is of a religious group or its iconography, the relevant group may be the members and clergy of that religion; if the alleged disparagement is of an academic institution, the relevant group may be the students, faculty, administration, and alumni; if the alleged disparagement is of a national symbol, the relevant group may be citizens of that country.”)

Id. at 1745-46.

Id. at 1724-25.

Id. at 1723-24.

Id. In fact, the Board adopted a similar test in 1988, in holding that the use of a silhouette of a defecating dog as a mark disparaged Greyhound’s running dog mark. Greyhound Corp. v. Both Worlds, Inc., 6 U.S.P.Q.2d (BNA) 1635 (T.T.A.B. 1981). The Greyhound Board adopted a two-part test for disparagement: (1) whether the communication is reasonably understood to refer to the petitioners; and (2) whether the communication is “considered offensive or objectionable by a reasonable person of ordinary sensibilities.” Id. at 1639.


Warth v. Seldin, 422 U.S. 490, 498 (1975) (“In essence the question of standing is whether the litigant is entitled to have the court decide the merits of the dispute or of particular issues. This inquiry involves both constitutional limitations on federal-court jurisdiction and prudential limitations on its exercise.”); see also Valley Forge Christian Coll. v. Ams. United for Separation of Church and State, 454 U.S. 464, 471 (1982) (“The term ‘standing’ subsumes a blend of constitutional requirements and prudential considerations . . . .”).

See Warth, 422 U.S. at 498-99; see also U.S. CONST. art III, § 2.


to satisfy Article III’s standing requirements, a plaintiff must show: (1) it has suffered an “injury in fact” that is (a) concrete and particularized and (b) actual or imminent, not conjectural or hypothetical; (2) the injury is fairly traceable to the challenged action of the defendant; and (3) it is likely, as opposed to merely speculative, that the injury will be redressed by a favorable decision.


Linda R.S. v. Richard D., 410 U.S. 614, 617 (1973); see also DOC v. United States, 525 U.S. 316 (1999) (“in order to establish Article III standing, ‘[a] plaintiff must allege personal injury fairly traceable to the defendant’s allegedly unlawful conduct and likely to be redressed by the requested relief’”) (quoting Allan v. Wright, 468 U.S. 737 (1984)).

Warth, 422 U.S. at 500.

Lujan, 504 U.S. at 560.


Ass’n of Data Processing Serv. Orgs. v. Camp, 397 U.S. 150, 153 (1970). As discussed by the Third Circuit in Conte Bros Auto., Inc. v. Quaker State-Slick 50, Inc., 165 F.3d 221, 226 (3d Cir. 1998), the “zone of interests” test “developed in the administrative law context where the issue is whether a person aggrieved by an administrative decision has standing to challenge it under § 10 of the Administrative Procedures Act” (APA). The Supreme Court has noted that “while inquiries into reviewability or prudential standing in other contexts may bear some resemblance to a ‘zone of interests’ inquiry under the APA, it is not a test of universal application.” Clarke v. Securities Indus. Ass’n, 479 U.S. 388, 400 n.16 (1987). The Conte Bros. court thus evaluated standing under § 43(a) of the Lanham Act by applying the congressional intent inquiry conducted by the Supreme Court in determining standing under the Clayton Act. Conte Bros., 165 F.3d at 226-27 (discussing Supreme Court’s approach in Associated Gen. Contractors v. California State Council of Carpenters, 459 U.S. 519 (1983)).

Warth v. Seldin, 422 U.S. 490, 499 (1975). The Supreme Court has stated that where the alleged injury “is a ‘generalized grievance’ shared in substantially equal measure by all or a large class of citizens,” a federal court generally ought not to exercise jurisdiction. Id. at 499 (citations omitted).

Id. at 501. As the Court went on to state, however, “Article III’s requirement remains: the plaintiff must still allege a distinct and palpable injury to himself, even if it is an injury shared by a large class of other possible litigants.”Id. at 501 (citation omitted). See also Bennett v. Spear, 520 U.S. 154, 164 (1997) (“Congress legislates against the background of our prudential standing doctrine, unless it is expressly negated.”).


Id. at § 1064. This language – “any person who believes that he would be damaged – while very broad, is not unique among legislative enactments. For example, in addition to being found in 15 U.S.C. § 1063 (2000) (opposition to registrations on the Principal Register), 15 U.S.C. § 1064 (2000) (cancellation of registrations on Principal Register), and 15


141 Section 43(a) allows “any person who believes that he or she is or is likely to be damaged” by false advertising or use of a confusing or deceptive mark to bring suit. Specifically, Section 43(a) provides:

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which –

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in a commercial advertising or promotion misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.


142 See Conte Bros. Auto., Inc. v. Quaker State-Slick 50, Inc., 165 F.3d 221 (3d Cir. 1998), where the court found that Congress did not expressly negate prudential limitations on the standing of plaintiffs to bring suit under Section 43(a). Id. at 227-30. The court noted that Section 43(a) limited the class of persons entitled to sue under its provisions to those who could trace their injury to the anti-competitive conduct prohibited by the Act. Id. at 228 (noting that § 43(a) limits suit to “any person who believes that he or she is or is likely to be damaged” by conduct proscribed in the section). The court also noted that the “structure” of the Act indicated “that Congress did not intend to abrogate prudential limitations on standing,” pointing to the intent section of Section 45 of the Act, which the court found “makes clear that the focus of the statute is on anti-competitive conduct in a commercial context,” id. at 229, a finding the court found was buttressed by the legislative history of the Lanham Act. See id. at 229 (stating that the legislative history of the Lanham Act “repeatedly references the Act’s focus on anti-competitive conduct in the commercial arena”) (citations omitted). Section 45 of the Lanham Act provides:

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 such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks, and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.


143 In particular, Section 43(a) focuses on two types of unfair competition: false association and false advertising. See Rosenfeld v. W.B. Saunders, 728 F. Supp. 236, 241-42 (S.D.N.Y. 1990) (discussing these two types of unfair competition).

144 See Serbin v. Ziebart Int’l Corp., 11 F.3d 1163, 1164 (3d Cir. 1993) (“[T]he Lanham Act . . . is primarily intended to provide a statutory framework for the registration and protection of trademarks . . . But trademarks are not the Lanham Act’s only concern. An important cognate statutory purpose is ‘to protect persons engaged in such commerce against unfair competition.’”) (citing 15 U.S.C. § 1127).

145 See supra note 144 and accompanying text.

146 See supra note 142.

147 See supra note 68 (discussing lack of legislative history).

148 See Lipton Indus., Inc. v. Ralphston Purina Co., 670 F.2d 1024, 1028 (C.C.P.A. 1982) (“No absolute test can be laid down for what must be proved to establish standing as a petitioner in a cancellation proceeding or as an opposer in an opposition.”).

149 Id. at 1028 (stating that “[a] party has standing to oppose within the meaning of § 13 if that party can demonstrate a real interest in the proceeding” and stating further that “[t]he same general statement is applicable to cancellation proceedings” under § 14) (citations omitted).

150 Ritchie v. Simpson, 170 F.3d 1092, 1095 (Fed. Cir. 1999) (the opposer “must have a ‘reasonable’ basis for his belief of damage”).

151 See Lipton, 670 F.2d at 1028-29.

152 Ritchie, 170 F.3d at 1095 (“the opposer must have a direct and personal stake in the outcome of the opposition”).
Estate of Biro v. Bic Corp., 18 U.S.P.Q.2d (BNA) 1382, 1385 (T.T.A.B. 1991). Once a plaintiff has established a “real interest” in the outcome of the case, the petitioner may “rely on any ground that negates the applicant’s right to the registration sought,” including Section 2(a). Id. at 1386; see also Lipton, 670 F.2d at 1031 (citing Warth v. Seldin, 422 U.S. 490, 501 (1975)) (stating that once standing is found, the “petitioner is entitled to rely on any statutory ground which negates appellant’s right to the subject registration and may invoke the general public interest in support of its claims”).

See Universal Oil Prods. Co. v. Rexall Drug & Chem. Co., 463 F.2d 1122, 1124 (C.C.P.A. 1972) (“section 13 requires only a belief of damage resulting from the applicant’s registration, and while that belief must have some reasonable basis in fact, this statutory provision ... has been liberally construed.”); Int’l Order of Job’s Daughters v. Lindeburg & Co., 727 F.2d 1087, 1092 (Fed. Cir. 1984) (“[T]here is no requirement that damage be proved in order to establish standing or to prevail in a cancellation proceeding.”).

Cunningham v. Laser Golf Corp., 222 F.3d 943, 945 (Fed. Cir. 2000) (citations omitted) (“A belief in likely damage can be shown by establishing a direct commercial interest.”) (ruling on a petition to cancel a registration under § 2(d)).

See, e.g., Tanner’s Council of America, Inc. v. Gary Indus. Inc., 440 F.2d 1404 (C.C.P.A. 1971) (finding a trade association that did not sell goods had standing to oppose a mark under § 13 of the Lanham Act). As the TTAB has stated, “The Trademark Act ... makes it clear that one need not be commercial enterprise, nor is it necessary that a commercial interest be at stake for one to object to a trademark registration.” Bromberg v. Carmel Self Service, Inc., 198 U.S.P.Q. (BNA) 176, 178 (T.T.A.B. 1978) (quoting United States ex rel. FBI, v. Societe Anonyme Francaise M. Bril & Co., 187 U.S.P.Q. (BNA) 685, 686 (D.D.C. 1975); see also Estate of Biro v. Bic Corp., 18 U.S.P.Q.2d (BNA) 1382, 1385 (T.T.A.B. 1991) (“Standing, in the context of a Section 2(a) claim, does not rise or fall on the basis of a plaintiff’s proprietary rights in a term; rather, a Section 2(a) plaintiff has standing by virtue of who the plaintiff is, that is, the plaintiff’s personality or ‘persona.’”).

Ritchie, 173 F.3d at 1098.

Bromberg, 198 U.S.P.Q. (BNA) at 178.

Abraham’s Seed v. John One Ten, 1 U.S.P.Q.2d (BNA) 1230, 1232-33 (T.T.A.B. 1986) (“The requirements for standing in a petition to cancel based on disparagement of beliefs are not very rigorous.”). See also Universal Oil Prods. V. Rexall Drug & Chem. Co., 463 F.2d 1123, 1124 (C.C.P.A. 1972) (stating that the liberal construction of standing requirements “is especially justified when the public interest served by a trademark opposition proceeding is recognized”).

The Federal Circuit has stated that due to “the linguistic and functional similarities between the opposition and cancellation provisions” of Sections 13 and 14 of the Lanham Act, it construes the standing requirements of these two sections “consistently.” Young v. AGB Corp., 152 F.3d 1377, 1380 (Fed. Cir. 1998) (cited with approval, Ritchie, 170 F.3d at 1095 n.2)).

Young, 152 F.3d at 1379 (quoting Lipton Indus. Inc. v. Ralston Purina Co., 670 F.2d 1024, 1026 (C.C.P.A. 1982)).

See Part II supra.

See infra notes 263-64 and accompanying text.


The application for registration was subsequently successfully opposed by a competitor, who argued that the mark was confusingly similar to its “A LEG IN THE HAND WILL PUT A SMILE ON YOUR FACE” mark. See Golden Skillet Corp. v. Carmel Self-Service, Inc., 201 U.S.P.Q. (BNA) 790 (T.T.A.B. 1979).

Bromberg, 198 U.S.P.Q. (BNA) at 177.

Id. at 178 (“[t]here is no provision in the Trademark Act for class actions and reference to damage which might be incurred by a particular class is inappropriate ...”, rather each “person” who opposes a registration must pay a filing fee and be identified as an opposer).

Id. at 179.

Id.

See supra Part II.


Id. at 1223 (“Although the petition contains numerous allegations concerning how petitioner’s commercial interests may be adversely affected by maintenance of respondent’s registration on the Register, mere allegations of a party’s basis for standing are insufficient, without proof”) & n.9 (“Even if we were to accept petitioner’s allegations as proof, another issue would be presented, namely, whether petitioner’s basis for standing, essentially its use of a similar mark on the same goods, a proprietary interest, is a sufficient basis for standing in a proceeding in which the only pleaded grounds is a disparagement of beliefs under Section 2(a).”).


Id. at 1830.

Id.
While the Board’s 1994 decision regarding standing focused on whether the petitioner’s had a “legitimate interest” in the outcome of the proceeding, see id., it did not address the “reasonable basis” test.

Although the Board’s finding would suggest that the petitioners had standing to challenge the marks as disparaging, the Board went on to note that the petitioners had set forth statutory grounds for seeking cancellation of the marks as being both scandalous and disparaging. Id. A showing of standing on both grounds is unnecessary, however. As discussed earlier, see supra note 154 and accompanying text, once a petitioner has established standing to sue on one ground under Section 2, it has standing to sue under other grounds as well.

In its 1999 decision on the merits of the challenge, Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d (BNA) 1705 (T.T.A.B. 1999), the Board addressed standing very briefly in a footnote, noting that it had, in its 1994 decision, found that the Native American petitioners had a legitimate interest in the outcome of the proceeding to challenge the registration of the REDSKINS marks, and that it was now finding that the petitioners indeed had standing, citing both Bromberg and the very recent decision in Ritchie. Id. at 1735 n.89.


Profumi Fratelli Nostra, 36 U.S.P.Q.2d (BNA) at 1223; see also Marofa, 38 U.S.P.Q.2d (BNA) at 1603 (noting that the pleadings were similar to those in Profumi Fratelli Nostra and concluding that the opposer had standing). In later cases involving the Order’s challenge of registration of marks consisting of GOOD FELLA, Order Sons of Italy in America v. Callis, 1999 TTAB Lexis 282 (T.T.A.B. 1999) (not citable as precedent of TTAB); and MAFIA, Order Sons of Italy in America v. Memphis Mafia, 52 U.S.P.Q.2d (BNA) 1364 (T.T.A.B. 1999), standing apparently was not even raised as an issue.


Id. at *2.

Id. at *5 - *6.

Id. at *6.

Id. at *6. The Board went on to find that Ritchie also lacked standing to challenge the marks under Section 2(e)(4) because he did not have a commercial interest in the same or similar names. Id. at *8. If Ritchie had had standing to raise either Section 2(a) or Section 2(d)(4), he would have been entitled to assert the other ground as well, as once an opposer has adequately pled standing to raise one ground for opposition, it can raise any other ground for opposition as well. Id. at *9 n.2 (citing Jewelers Vigilance Comm. Inc. v. Ullenberg Corp., 823 F.2d 490, 492 (Fed. Cir. 1987) and Lipton Indus. Inc. v.Ralston Purina Co., 670 F.2d 1024 (C.C.P.A. 1982)).

In fact, even its heading “B. Standing to Oppose a Mark,” 170 F.3d at 1094, is itself incorrect, because the Lanham Act permits one to challenge registration of a mark, not the mark itself. See supra notes 60-61 and accompanying text.

Ritchie at 1094.

See note 33 supra (quoting Section 2(a)).

See infra notes 228-30 and accompanying text.

170 F.3d at 1094.

See id. (citing California Ass’n of Physically Handicapped, Inc. v. FCC, 778 F.2d 823, 826 n.8 (D.C. Cir. 1985) (stating that Article III limitations do not apply to the FCC and that the FCC “may choose to allow persons without Article III ‘standing’ to participate in FCC proceedings’); Ecee, Inc. v. Federal Energy Regulatory Comm’n, 645 F.2d 339, 349-50 (5th Cir. 1981) (“Administrative adjudications . . . are not an article III proceeding to which either the ‘case or controversy’ or prudential standing requirements apply; within their legislative mandates, agencies are free to hear actions brought by parties who might be without standing if the same issues happened to be before a federal court.”); 13A CHARLES A. WRIGHT ET AL., FEDERAL PRACTICE AND PROCEDURE § 3531.13 (1984) (“Once a party has been permitted to appear in the administrative proceeding, there are strong reasons to extend this administrative standing into standing for judicial review.”)).

170 F.3d at 1095.

170 F.3d at 1094 (quoted supra note 58 and accompanying text).

Id.
The majority declined to address the constitutionality of Section 2(a) on the grounds that the issue had not been raised or considered below, or briefed or argued before the Federal Circuit. *Id.* at 1099. Judge Newman, in her dissent, provided a more extensive discussion of the constitutional issues she saw as “implicit” in the majority’s decision. *Id.* at 1103-1104 (Newman, J., dissenting).

The crux of the matter is not how many others share one’s belief that one will be damaged by the registration, but whether that belief is reasonable and reflects a real interest in the issue.”

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203 Id. at 1099 (Newman, J. dissenting).
204 Id. at 1098-99.
205 Id. at 1098 (misquoting Section 2(a)), as discussed in *supra* note 193-94 and accompanying text.
206 Id. at 1098-99.
207 Id. at 1095.
208 Id.
209 Id. (citation omitted).
210 Id.
211 Id. at 1095 (citing *Ritchie*, 41 U.S.P.Q.2d (BNA) at 1861) (emphasis added by Federal Circuit).
212 823 F.2d 490, 492-93 (Fed. Cir. 1987).
213 670 F.2d 1024, 1028 (C.C.P.A. 1982).
214 170 F.3d at 1095-96.
215 405 U.S. 727 (1972). In *Sierra Club*, the Supreme Court held that an environmental organization lacked standing to prevent a governmental agency from constructing a resort in a national forest. The Court found that the organization did not demonstrate a direct and palpable injury from the project’s development and therefore was not within the “zone of interests” protected by the Administrative Procedure Act (APA). The Court stated that the jurisprudential policy of limiting standing to entities that have a direct stake in the outcome would be harmed if the Court construed the APA to grant standing to “organizations or individuals who seek to do no more than vindicate their own value preferences through the judicial process.” *Id.* at 738-40.
216 170 F.3d at 1096 (citing *Sierra Club*, 405 U.S. at 734).
217 Id. (citing *Sierra Club*, 405 U.S. at 735).
218 Id.
219 Id. at 1097.
220 Id. (“The crux of the matter is not how many others share one’s belief that one will be damaged by the registration, but whether that belief is reasonable and reflects a real interest in the issue.”).
222 170 F.3d at 1097.
223 Id.
224 Id.
225 Id.
226 Id.
227 The majority declined to address the constitutionality of Section 2(a) on the grounds that the issue had not been raised or considered below, or briefed or argued before the Federal Circuit. *Id.* at 1099. Judge Newman, in her dissent, provided a more extensive discussion of the constitutional issues she saw as “implicit” in the majority’s decision. *Id.* at 1103-1104 (Newman, J., dissenting).
228 Id. at 1093.
229 Id. at 1099.
230 Id. at 1097.
231 Id. at 1100 (Newman, J., dissenting).

See also Stephen Baird, Area Summaries: Review of the 1999 Trademark Decisions of the United States Court of Appeals for the Federal Circuit, 49 AM. U.L. REV. 1321, 1334 (2000) (“If someone from the general population, who is personally shocked or offended by a mark, is unable to challenge the registration of such a mark, who is left from the ‘substantial composite of the general public’ to object and thereby give meaning to Section 13 and Section 14 of the Lanham Act.”).

Ritchie, 170 F.3d at 1102 (Newman, J., dissenting).

Id. at 1101-02 (Newman, J., dissenting) (citing Sierra Club, 405 U.S. 727 (1972)).

Id. at 1101.

Id. (quoting Sierra Club, 405 U.S. at 738).

See 5 U.S.C. § 702 (2000) (“A person suffering legal wrong because of agency action, or adversely affected or aggrieved by agency action within the meaning of a relevant statute, is entitled to judicial review thereof.”).

See supra notes 138-39 and accompanying text.

170 F.3d at 1098.

Id. (citing Bromberg, 198 U.S.P.Q. (BNA) 176 (T.T.A.B. 1978) (women had standing to challenge a mark) and Harjo v. Pro Football, Inc., 30 U.S.P.Q.2d (BNA) 1828 (T.T.A.B. 1994) (Native Americans had standing to challenge the REDSKINS mark)).

Id.

Id.

Id.

Id.

Id.

Id.

Id. at 1009. This decision established only Ritchie’s standing to oppose and did not actually address the registrability of the marks under Section 2(a), which was an issue to be decided on remand. In fact, however, Simpson never pursued the registration of these marks beyond this stage, and the marks were not registered.


The applicant, Mavety Media Group Ltd., had five years earlier successfully challenged a decision by the Board to deny registration for the mark on the grounds that it was immoral or scandalous matter under Section 2(a). In re Mavety Media Group Ltd., 33 F.3d 1367 (Fed. Cir. 1994). In denying the registration, the examiner had relied upon a dictionary definition that defined “tail” as a vulgar term for sexual intercourse. Id. at 1369. The applicant appealed that denial, and the denial was affirmed in a 2-1 unpublished decision of the Board. See 52 U.S.P.Q.2d (BNA) at 1606. On appeal, the Federal Circuit vacated the Board’s decision, noting “tail” also has several non-vulgar definitions (such as buttocks or rear end) and that the Board had erred in concluding, without further evidence, that a substantial composite of the general public would necessarily attach a vulgar meaning to “tail” in this context. In re Mavety Media Group Ltd., 33 F.3d at 1373-74.

Boswell, 50 U.S.P.Q.2d (BNA) at 1603.

Id. at 1604.

Id.

Id. at 1604-05.

Id. at 1605.

Id.

Id. (quoting FED. R. EVID. 201, Advisory Committee notes).

The Board then went on to consider the substance of opposer Boswell’s claim that the mark was disparaging, ultimately dismissing the opposition. The Board noted that the opposer had failed to prove that a substantial component of the allegedly disparaged group would necessarily attach a vulgar meaning to “tail” rather than the non-vulgar meaning of “rear end.” Id. at 1608. The opposers had brought in only evidence of the dictionary meanings of “tail,” and had not provided other evidence, such as the testimony of linguistics experts or the results of public opinion surveys, to demonstrate how the alleged disparaged group would view the mark. Id. at 1605-08.

170 F.3d at 1099 (Newman, J., dissenting).

Id. at 1094.

See, e.g., id. at 1102 (Newman, J., dissenting) (“The forum for exercise of the moral preferences of the general public is the cash register for the trademarked goods – not the trademark register.”); In re Riverbank Canning Co., 95 F.2d 327, 330 (C.C.P.A. 1938) (Jackson, J., dissenting) (“If the use of the trademark ‘Madonna,’ as applied to the goods and articles mentioned, gave offense or scandal, it seems to me that it would be noised about and probably these articles would have but scanty sale.”); In re Hershey, 6 U.S.P.Q.2d (BNA) 1470, 1473 (T.T.A.B. 1988) (Cissel, Member, concurring) (“If the [BIG PECKER BRAND mark] were actually so offensive, people would simply not purchase goods bearing it.”); But see In re
Tinseltown, 213 U.S.P.Q. (BNA) 863, 865 (T.T.A.B. 1981) (“[T]he fact . . . that the public can judge the mark’s propriety in the market place [is] wholly irrelevant to the issue before us.”).

See Davis, supra note 40, at 398 (arguing that the public’s buying power is “the most effective safeguard of all against use of scandalous, immoral, or disparaging material”); Jack Aschiezer Guggenheim, Renaming the Redskins (and the Florida State Seminoles?): The Trademark Registration Decision and Alternative Remedies, 27 Fla. St. U. L. Rev. 287, 295 n.53 (1999) (“The value of a trademark is in the goodwill that accrues to the mark and the associations consumers make with the mark. The marketplace might be a more objective arbiter of what is and is not an offensive mark.”); Lee, supra note 40, at 73 n.51 (“[I]f a majority of the public is offended by a mark, they are not likely . . . to buy the goods bearing that mark. Therefore, it is not likely that anyone would use a mark that was truly offensive to a majority of the population.”).

Cf. Sambo’s of Ohio, Inc. v. City Council of City of Toledo, 466 F. Supp. 177 (N.D. Ohio 1979), in which the court struck down the portion of a city ordinance that purported to restrict a restaurant owner’s speech by prohibiting the owner from using the trade name “SAMBO’S” on its sign, even though the trade name was a federally registered mark. The Toledo Chapter of the NAACP had objected to its use in this instance. The court stated:

However much one may dislike or disapprove of most commercial advertising, there is no gainsaying that it has always served a useful purpose in helping buyers to make better selections among competitors for their business. One of the basic premises of advertising is that if it is too offensive to too many people, its use will be counterproductive, for those who are offended will not only refuse to buy the product, but also, if they are sufficiently offended, they will attempt to persuade others to refuse also.

Id. at 180. The court went on to state that the city had no authority to ban the use of federally registered mark, and that: the exclusive remedy for preventing the use of [disparaging] trade names is under the provisions of § 1064, which provides a method for canceling a registration which has been made “contrary to law.” The defendants may not or the NAACP wish to deprive the plaintiffs of their rights under their registration, their remedies lie in the Patent Office.

Id. at 1098.


As mentioned earlier, the Board had analyzed Ritchie solely on scandalousness grounds. See supra note 189 and accompanying text.

As noted above, Sections 13 and 14 of the Lanham Act do not permit class actions. See supra note 170 and accompanying text.

As noted earlier, though, the Ritchie court seemed to view this as a disparagement test. See supra notes 228-30 and accompanying text.

This initial showing would be required to establish standing; a greater showing would be necessary to prevail on the merits.