

Brandmarking

THOUGHTS ON THE CREATION,
PROTECTION, AND ENFORCEMENT OF
BRAND IDENTITY

THEY CAN'T REGISTER THAT AS A TRADEMARK -- CAN THEY?

Ronda Rousey, the famous Mixed Martial Arts fighter has filed several applications to register a trademark that presumably reflects her feelings about her detractors. **The mark is "FTA" which, Ms. Rousey says, is an acronym for "F**k Them All."** She plans to use FTA as a trademark for goods ranging from perfume to cell phone covers to removable tattoo transfers to organizing MMA events (some of which sound more appropriate to her "Rowdy Ronda" persona than others).

By filing these applications to register FTA, Ms. Rousey may – or may not – have stepped into the middle of a legal controversy that has engulfed the world of trademark law over the last couple years, and has recently escalated.

The controversy revolves around Section 2(a) of the Trademark Act, which provides that federal registration can be denied to a trademark that

Consists of or comprises immoral...or scandalous matter; or matter which may disparage...persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.

The statute does not prescribe a standard by which the Trademark Office is to determine what is or is not "immoral" or "scandalous," or the precise point at which a particular trademark *"may disparage"* someone. **Perhaps not surprisingly, such determinations have been more than a little inconsistent over the years.** For example, the Trademark Office has both granted *and* denied applications for trademarks that contain the words "Heeb," "Dago," "Injun" and "Squaw."

Ms. Rousey's mark is an acronym, one letter of which stands for a word that – if spelled out – would seem to qualify as "immoral" or "scandalous" under almost anyone's definition. Even so, the acronym will likely pass muster. In 2009 the Trademark Office rejected several applications to register "LMFAO" on grounds that it was immoral, citing the Urban Dictionary and other online sources as evidence that it stood for "Laughing My F***ing Ass Off." But by 2011, applicants had figured out that they could sidestep this obstacle by telling the Office that the letters actually stood for "Laughing My *Freaking* Ass Off." Presumably Ms. Rousey will, necessarily, employ the same tactic.

Note, by the way, that the Trademark Office had no problem with the word "ass," having granted dozens of registrations for marks including



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THIS MONTH:

"Scandalous," "Immoral," and "Disparaging" Trademarks

Slants and Redskins Cases Headed to the Supreme Court?

ABOUT "BRANDMARKING"

The word is a combination of "branding" and "trademark." It reflects a conviction that marketing and legal professionals share a common goal, and that they need to learn to speak each other's language in order to reach it. That goal is simple: to develop powerful, durable brand identities and capture them in names, slogans, and designs that customers will associate with their products -- and with no one else's.

If you like what you find here, feel free to pass it along to others.

ABOUT THE AUTHOR



Attorney John Blattner helps businesses develop and protect brand identities. He does trademark counseling, clearance, prosecution, enforcement, and litigation, in the fashion, entertainment, financial services, technology, retailing, media, automotive, sporting goods, restaurant, and other industries. John also teaches Trademarks and Unfair Competition at Michigan State University College of Law.

CONTACT

John Blattner
350 S. Main Street, Suite 300
Ann Arbor, MI 48104
(734) 623-1698 (direct)
jblattner@dickinsonwright.com

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that word. Indeed, it has already accepted 16 applications, filed by none other than Ms. Rousey, for “Do Nothing B*tch” – both with and without using the asterisk.

TRADEMARKS AND THE FIRST AMENDMENT: SLANTS, RED-SKINS, AND BEYOND

The fuss over “immoral,” “scandalous,” and “disparaging” trademarks may soon be coming to a head.

Last December, the United States Court of Appeals for the Federal Circuit decided a case called *In re Tam*, in which it overruled the Trademark Office’s refusal to register “The Slants” as a trademark for a music group, finding that the term was disparaging to individuals of Japanese extraction. In a 9-3 decision, the Federal Circuit ruled that by barring registration of such trademarks, the disparagement provision of Section 2(a) violates the First Amendment’s protection of freedom of speech. **Tacitly acknowledging that their ruling would likely unleash a torrent of trademarks that many consider offensive, the court concluded:**

Whatever our personal feelings about the mark at issue here, or other disparaging marks, the First Amendment forbids government regulators to deny registration because they find the speech likely to offend others. Even when speech “inflict[s] great pain,” our Constitution protects it “to ensure that we do not stifle public debate.”

The Trademark Office was widely expected to, and last month did, ask the Supreme Court to review the Federal Circuit’s decision in *In re Tam*. In a related move, Pro-Football, Inc. took the unusual step of asking the Supreme Court to hear its appeal of the federal district court decision cancelling six registrations for the Washington Redskins trademarks – which has not even been ruled upon yet by the Court of Appeals – as part of the Slants appeal.

The Slants and Redskins cases both turn on the “disparaging” clause of Section 2(a). But if the Supreme Court decides to take on one or both of these cases, **the statute’s bar on “immoral” and “scandalous” marks could easily be addressed at the same time: the constitutional issues are pretty much identical.** Moreover, during a recent visit to the law school where I teach, the Commissioner of Trademarks, Mary Boney Denison, noted that another case – involving an application to register the word “FUCTION” – might also be headed to the Supreme Court before long.

In the meantime, the Trademark Office – presumably seeking to avoid getting itself into any more controversy – has announced that **action on applications that raise any of these Section 2(a) issues will be indefinitely suspended pending further court action.** So Rowdy Ronda may need to wait awhile to get her registrations for “FTA.”

Dickinson Wright Offices

Detroit

500 Woodward Ave.
Suite 4000
Detroit, MI 48226
Phone: 313.223.3500

Washington, D.C.

1825 Eye St., NW
Suite 900
Washington, DC 20006
Phone: 202.457.0160

Columbus

150 E. Gay St.
Suite 2400
Columbus, OH 43215
Phone: 614.744.2570

Ann Arbor

350 S. Main St.
Suite 300
Ann Arbor, MI 48104
Phone: 734.623.7075

Las Vegas

8363 West Sunset Rd.
Suite 200
Las Vegas, NV 89113
Phone: 702.382.4002

Grand Rapids

200 Ottawa Ave., NW
Suite 1000
Grand Rapids, MI 49503
Phone: 616.458.1300

Lexington

300 W. Vine St.
Suite 1700
Lexington, KY
Phone: 859.899.8700

Lansing

215 S. Washington Square
Suite 200
Lansing, MI 48933
Phone: 517.371.1730

Nashville

424 Church St.
Suite 1401
Nashville, TN 37219
Phone: 615.244.6538

Music Row

54 Music Square East
Suite 300
Nashville TN 37203
Phone: 615.577.9600

Phoenix

1850 North Central Ave.
Suite 1400
Phoenix, AZ 85004
Phone: 602.285.5000

Saginaw

4800 Fashion Square Blvd.
Suite 300
Saginaw, MI 48604
Phone: 989.791.4646

Reno

100 West Liberty
Suite 940
Reno NV 89501
Phone: 775.343.7500

Troy

2600 W. Big Beaver Rd.
Suite 300
Troy, MI 48084
Phone: 248.433.7200

Toronto

199 Bay St., Suite 2200
Commerce Court West
Toronto ON M5L 1G4
Phone: 416.777.0101