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A FREE SPEECH RIGHT TO TRADEMARK PROTECTION?

By Lisa P. Ramsey

I. INTRODUCTION

Many governments refuse to register and protect as trademarks certain categories of words or symbols that are offensive to members of the public. For example, Section 2(a) of the Lanham Act—the federal trademark law in the United States—bans registration of trademarks which are immoral or scandalous, or which may disparage people, institutions, beliefs, or

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1. Committee on Development and Intellectual Property, Study on Misappropriation of Signs, CDIP/9/INF/5 (Mar. 14, 2012), http://www.wipo.int/edocs/mdocs/mdocs/en/cdip_9/cdip_9_inf_5.pdf (discussing trademark laws of several countries, including laws that exclude from registration trademarks that are contrary to morality or public order); WIPO Secretariat, Grounds for Refusal of All Types of Marks, WIPO/STrad/INF/5, 16-18 (Aug. 30, 2010), http://www.wipo.int/sct/en/wipo-strad/ (stating that 74 countries responded that they deny registration to trademarks contrary to morality or public order). Specific examples of these laws are included infra Part II.B.
national symbols. In addition, Canada’s Trade-marks Act prohibits the adoption, use, and registration of any scandalous, obscene, or immoral word or device used as a mark in connection with a business. Such laws are used to deny trademark protection to subject matter ranging from profanity, obscene images, and drug references to expression that ridicules indigenous communities, racial groups, and religions. When a statute requires trademark offices to refuse to register such “offensive” trademarks, some commentators and courts claim the statute violates the right to freedom of expression.

This free speech argument was raised by Pro-Football, Inc. in a trademark case currently pending in the Fourth Circuit Court of Appeals after a district court upheld the decision of the U.S. Patent and Trademark Office (“USPTO”) to cancel six registrations of marks containing the word REDSKINS used by Washington, D.C.’s football team on the ground the mark may disparage Native Americans. A similar argument was also made in the Federal Circuit Court of Appeals by the trademark applicant in In re Brunetti after the USPTO refused to register the term FUCT as a mark for clothing on the ground that the word is scandalous. The right to freedom of expression was also invoked by a trademark applicant in the case In re Tam after the USPTO rejected Simon Tam’s application to register THE SLANTS as a mark for entertainment services on the ground the mark may disparage Asian Americans. (Tam claimed his Asian-American dance-rock band “The Slants” was trying to reclaim this slur and make a statement about racial and cultural issues in the United States.)

In December 2015, the Federal Circuit sitting en banc agreed with Tam and held that Section 2(a)’s ban on registration of trademarks that may disparage others is a facially invalid government regulation that violates the Free Speech Clause in the First Amendment of the U.S. Constitution, which provides: “Congress

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3. Trade-marks Act, R.S.C. 1985, c T-13, § 9(1)(j) (Can.) (adoption); id. § 11 (use); id. § 12(1)(e) (registration); see Teresa Scassa, Canadian Trademark Law 205-07 (2d ed. 2015).


5. In re Brunetti, Serial No. 85310960, 2014 WL 3976439 (T.T.A.B. 2104) [not precedential] (noting the examining attorney maintained that the term “fuct” is the phonetic equivalent of “fucked” and is therefore “vulgar, profane and scandalous slang”). This case is currently pending in the Federal Circuit. In re Brunetti, No. 2015-1109 (Fed. Cir.).

shall make no law . . . abridging the freedom of speech.” On September 29, 2016, the U.S. Supreme Court granted the USPTO’s petition for writ of certiorari seeking review of the Tam decision, and the Court will now consider whether the disparagement provision of Section 2(a) of the Lanham Act is constitutional under the First Amendment.

Constitutions and human rights treaties recognize the right to freedom of expression and require governments to protect this right. Trademark laws can conflict with the free speech right when noncommercial expression or nonmisleading commercial expression is suppressed or punished by the government in trademark disputes. Yet many disagree about whether the right to freedom of expression is implicated or violated when a government refuses to allow a private party to register an offensive trademark. Commentators have considered the constitutionality and utility of laws regulating offensive trademarks in the United States, Europe, Australia, Canada, New Zealand, and other countries, but most do not address and properly evaluate in a


10. See infra note 155 and the discussion and sources cited in Parts III and IV. See also Lisa P. Ramsey, Increasing First Amendment Scrutiny of Trademark Law, 61 SMU L. Rev. 381 (2008).

comprehensive manner all of the relevant free expression issues that may arise in a trademark dispute. Moreover, they have not persuaded judges to follow a single approach to these issues. Court decisions in the United States regarding Section 2(a) of the Lanham Act are inconsistent with each other both in the holdings and in the rationales used to find the statute either unconstitutional or constitutional. In the Tam case, for example, there were five different opinions in which the twelve judges


sitting *en banc* disagreed on the content and scope of U.S. free speech law and its application to the facts of the case.\(^{13}\)

This article organizes the various free speech doctrines that may be relevant in a trademark dispute into a framework that may be used to more clearly and effectively evaluate the constitutionality of trademark laws, with a focus on laws regulating offensive trademarks. This article also provides an international perspective on the free speech issues raised in the cases involving the REDSKINS, FUCT, and THE SLANTS trademarks and considers whether there is (or should be) a universal free speech right to trademark registration and protection of offensive trademarks under human rights treaties or customary international law. (While countries outside the United States generally use the phrase “free expression” rather than “free speech,” the phrase “free speech” in the First Amendment covers all types of expression,\(^{14}\) and references to “free speech” in this article are meant to be synonymous with “free expression.”) Governments all over the world have laws banning registration of offensive trademarks, but this article focuses on United States law and Section 2(a) of the Lanham Act due to the recent controversies involving the REDSKINS, FUCT, and THE SLANTS marks and because the United States has strong protection both for trademark rights and freedom of expression.

Below in Part II, this article provides background information about international, regional, and national trademark laws relating to the registration and use of offensive language as a trademark. The article then explains in Part III that obligations to protect the right to freedom of expression in international and regional human rights treaties do not require governments to register or protect trademark rights in offensive words or symbols. Each nation has discretion to decide whether to recognize a free speech right to trademark protection, or to deny registration to marks contrary to morality or public order. Part IV sets forth a proposed framework for evaluating when trademark laws violate the right to freedom of expression, and includes six possible “elements” of a free speech violation in a trademark dispute.

Part IV applies this framework to the situation where a private party claims a free speech right to obtain registration of an

\(^{13}\) *Tam*, 808 F.3d at 1327-82. Judge Moore wrote the court’s opinion, which was joined by Judges Prost, Newman, O’Malley, Wallach, Taranto, Chen, Hughes, and Stoll. Under her maiden name Kimberly Pace, Judge Moore wrote an article that argued that the disparagement provision in Section 2(a) is an unconstitutional regulation of expression. Pace, *supra* note 11, at 8 (“While this article does propose a test for racial disparagement, it also argues that the Lanham Act’s content-based restrictions that deny registration to immoral, scandalous and disparaging trademarks are an unconstitutional violation of the trademark owner’s First Amendment rights.”).

offensive mark, and argues that the U.S. Supreme Court should not affirm the Federal Circuit’s holding in *Tam*. Section 2(a) of the Lanham Act is constitutional because the second element of a free speech violation—suppression or punishment of expression, or some other actionable harm to expression—is not satisfied. The statute allows use of the offensive language claimed as a mark, and does not suppress the expression or punish it by requiring jail time or payment of fines or damages. A trademark law banning registration—but not use—of an offensive trademark does not implicate the First Amendment. As there is no free speech right to registration of an offensive trademark under U.S. law, Congress has discretion to decide on public policy grounds whether to deny or allow registration of such marks.

Critics of Section 2(a)’s offensive mark provisions may argue that registration of offensive marks and protection of trademark rights in such language benefits society overall by reducing consumer confusion in the marketplace. They may also argue that we should protect a trademark owner’s investment of time, money, and energy in its brand, and not cancel a distinctive mark on the ground it is immoral, scandalous, or potentially disparaging years after it was registered. These are public policy or property rights arguments, not free speech arguments. They should be addressed to the legislature and not used to justify the creation in the courts of a free speech right to trademark registration.

The conflict between free speech rights and trademark laws today is not found in Section 2(a) or similar trademark laws that deny registration to certain subject matter based on its content. The real problem is the expansion of trademark law beyond the regulation of misleading commercial expression to allow the government to suppress and punish the unauthorized use of trademarks in noncommercial and commercial expression that is not misleading. Even though some trademark statutes and court decisions protect expressive interests in trademark law, infringement and dilution laws are still used to stifle protected expression. Moreover, most trademark disputes are resolved through the use of demand letters threatening a costly lawsuit and damage award, or notice-and-takedown requests to private parties operating social media sites, search engines, online stores, and other marketplaces of ideas, information, and products. Thus, granting a trademark registration in offensive language has the potential to chill protected expression to a much greater extent than denying registration to a mark that is immoral, scandalous, or potentially disparaging.
II. TRADEMARK LAWS BANNING REGISTRATION OF OFFENSIVE MARKS

The United States has prohibited the registration of offensive trademarks for more than a hundred years, and international trademark treaties have allowed contracting parties to refuse to register or to invalidate trademarks that are contrary to morality and public order since 1883. Therefore Tam’s holding that the “may disparage” provision of Section 2(a) of the Lanham Act is a facially-invalid law which violates the right to freedom of expression—with the result that the United States must now allow the registration of marks that may disparage others unless the U.S. Supreme Court disagrees—radically departed from the way the United States and other nations have approached trademark registrations of offensive language for the last century.

Regardless of whether they may also contain offensive words, trademarks such as REDSKINS or THE SLANTS can identify and distinguish the source of goods or services. In addition to its source-identifying meaning created by the trademark owner and the word’s inherent meaning, a trademark can also convey information about the brand image of the trademark owner and the quality of its products. Trademarks can consist of words (e.g., VIRGIN for an airline), symbols (e.g., the Nike swoosh for shoes), names (e.g., LOUIS VUITTON for handbags), product configurations (e.g., Ferrari’s design of its Daytona Spider car), and a variety of other signs that have the ability to convey information about the source or quality of products.

In the United States, trademarks are capable of protection if they are distinctive, not functional, and the trademark owner has priority based on use of the trademark first in the United States to identify the source of certain goods or services. Other nations have similar requirements for trademark protection but primarily grant priority to the company that registers the mark first with that nation’s trademark office. Trademark rights are generally

15. See infra note 71 (explaining that immoral and scandalous marks have been denied registration since 1905) and Part II.A (discussing trademark treaties).

16. Use of the mark “in commerce” is required for federal trademark protection, but a trademark owner may also obtain priority in a trademark in the United States by filing an intent-to-use trademark application or a U.S. trademark application based on a foreign trademark application or registration. For information about trademark law in the United States, see Louis Altman & Rudolf Callmann, Callmann on Unfair Competition, Trademarks and Monopolies (4th ed. 2016); Anne Gilson LaLonde & Jerome Gilson, Gilson on Trademarks (2016); J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition (4th ed. 2016).

territorial (linked to the sovereign powers and borders of individual nations), and once a trademark is valid and protectable in a country, that nation’s trademark laws protect the owner’s trademark rights against infringement and other trademark violations.\textsuperscript{18} The trademark owner can obtain an injunction, monetary relief, and other remedies in a successful trademark lawsuit. The owner may also be able to convince private parties such as Facebook or CafePress to enforce its rights in a trademark by removing third-party posts or merchandise that infringes the mark.\textsuperscript{19}

Most nations generally require registration of a trademark before the trademark owner can sue another party for trademark violations.\textsuperscript{20} However, in the United States, registration is not required to sue for infringement of a valid trademark, or for dilution of a mark that is both distinctive and famous.\textsuperscript{21} Still, registration provides several benefits in the United States. As explained by the Federal Circuit in \textit{Tam}:

Registration is significant. The Lanham Act confers important legal rights and benefits on trademark owners who register their marks.’ \textit{B & B Hardware, Inc. v. Hargis Ind., Inc.}, — U.S. —, 135 S. Ct. 1293, 1300, 191 L.Ed.2d 222 (2015)

\textsuperscript{18} See, e.g., 15 U.S.C. § 1114(1)(a) (infringement of a registered mark); 15 U.S.C. § 1125(a)(1)(A) (false designation of origin and unfair competition, including infringement of an unregistered mark); 15 U.S.C. § 1125(c) (dilution); see \textit{Trademark Protection and Territoriality Challenges in a Global Economy} (Irene Calboli & Edward Lee eds., 2014) (discussing the principle of territoriality in trademark law, and applications of and exceptions to this rule).

\textsuperscript{19} Private parties reduce their chances of being sued for contributory trademark infringement and other trademark violations if they remove infringing uses of marks after a trademark owner complains. Lisa P. Ramsey, \textit{Brandjacking on Social Networks: Trademark Infringement by Impersonation of Markholders}, 58 Buff. L. Rev. 851 (2010). Facebook is a social media site that allows friends, family, and other people to connect online via posts of text, photos, and videos, www.facebook.com, and CafePress allows users to buy or create unique T-shirts, hats, stickers, and other expressive merchandise, www.cafepress.com.

\textsuperscript{20} See the sources cited \textit{supra} note 17. One exception is when the mark is well known to the people in that country, which might be the case for the mark of a famous company. International trademark laws require contracting parties to protect trademark rights in well-known marks even when the mark is not registered in that country. Paris Convention for the Protection of Industrial Property art. 6bis, Mar. 20, 1883 (as revised at Stockholm, July 14, 1967), 21 U.S.T. 1583, 828 U.N.T.S. 305 [hereinafter Paris Convention]; Agreement on Trade-Related Aspects of Intellectual Property Rights arts. 16(2)-(3), Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments—Results of the Uruguay Round, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) [hereinafter TRIPS Agreement].

(quotation marks omitted). These benefits—unavailable in the absence of federal registration—are numerous, and include both substantive and procedural rights. The holder of a federal trademark has a right to exclusive nationwide use of that mark where there was no prior use by others. See 15 U.S.C. §§ 1072, 1115. Because the common law grants a markholder the right to exclusive use only in the geographic areas where he has actually used his mark, see 5 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 26:32 (4th ed.) (hereinafter “McCarthy”), holders of a federally registered trademark have an important substantive right they could not otherwise obtain. Also, a registered mark is presumed to be valid, 15 U.S.C. § 1057(b), and the mark becomes incontestable (with certain exceptions) after five years of consecutive post-registration use, *id.* § 1065; see also *B & B Hardware*, 135 S. Ct. at 1310 (‘Incontestability is a powerful protection.’). A markholder may sue in federal court to enforce his trademark, 15 U.S.C. § 1121, and he may recover treble damages if he can show infringement was willful, *id.* § 1117. He may also obtain the assistance of U.S. Customs and Border Protection in restricting importation of infringing or counterfeit goods, *id.* § 1124, 19 U.S.C. § 1526, and qualify for a simplified process for obtaining recognition and protection of his mark in countries that have signed the Paris Convention, *see id.* § 1141b (Madrid Protocol); Paris Convention for the Protection of Industrial Property art. 6quinquies, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305. Lastly, registration operates as a complete defense to state or common law claims of trademark dilution. 15 U.S.C. § 1125(c)(6).22

Certain types of trademarks are ineligible for registration for a variety of reasons.23 For example, if someone claims trademark rights in a word that is the ordinary name of the product, such as COMPUTER for a computer, that term cannot be registered as a trademark because it is “generic” or the “customary” name for the product. The reason is that trademark protection of generic language can harm competition and the free flow of commercial information.24 Nations also ban registration of deceptive trademarks because the false or misleading words can confuse consumers in the marketplace. An example is the mark LOVEE LAMB for car seat covers that are not made of lambskin.25 In


23. *See supra* notes 16 and 17 for books that discuss the trademark laws containing absolute bars to registration.


addition, the trademark provisions in the Paris Convention for the Protection of Industrial Property ("Paris Convention") treaty require contracting parties to deny registration of national flags and other symbols of the government, and the United States is one of many nations that have an absolute bar to registration of this type of subject matter.

The Paris Convention also allows governments to deny registration to trademarks that are contrary to morality or public order, and the United States and other nations have laws banning registration of words or symbols that are immoral, scandalous, disparaging, or otherwise offensive or against public policy. Proponents of laws banning registration of offensive trademarks have made several arguments in support of these regulations. Among other things, they contend that the government should protect morality and members of the public by refusing to register words or symbols that are vulgar, profane, obscene, sexist, homophobic, or which may offend or be demeaning to people who are members of certain racial, ethnic, indigenous, or religious groups.

If offensive terms are not eligible for registration, this may discourage individuals and companies from adopting such marks and encourage them to use a non-offensive trademark so they can obtain the benefits of trademark registration. Unless a country also bans use of that mark, however, the company can still express itself using that offensive term.

26. Paris Convention, supra note 20, art. 6ter(1)(a).

27. 15 U.S.C. § 1052(b) (banning registration of a mark that "[c]onsists 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"), discussed in In re City of Houston, 731 F.3d 1326, 1331-35 (Fed. Cir. 2013). For information about similar laws in other countries, see the books in supra note 17.

28. Paris Convention, supra note 20, art. 6quinquies(3).

29. See infra Part II.B. & Part II.C.

30. See, e.g., Tam, 808 F.3d at 1363 (Dyk, J., concurring in part and dissenting in part) (stating that "the purpose of the statute is to protect underrepresented groups in our society from being bombarded with demeaning messages in commercial advertising"); Baird, supra note 11, at 788 ("Withholding the many benefits of federal registration from scandalous, immoral, and disparaging trademarks has been justified on a number of public policy grounds, including ... the federal government should promote the public health, welfare, and morals by discouraging the use of scandalous, immoral, and disparaging trademarks ... [and] the federal government should protect the sensitivities of those in the public who might be offended by the use of scandalous, immoral, and disparaging trademarks."); Farley, Stabilizing Morality, supra note 11, at 1025 (Section 2(a) "seeks to encourage civility by denying the benefits of federal registration to marks that cause deep offense to a significant portion of the public").

31. Tam, 808 F.3d at 1341.

32. Tushnet, supra note 11, at 8-9 (noting that courts and the USPTO have argued that Section 2(a)’s “bar is acceptable because of the lack of any effect on a user’s ability or right to use the mark.”). Moreover, Megan Carpenter and Mary Garner have shown that several scandalous marks denied registration under Section 2(a) were still being used in the
Another justification for such laws is that they help avoid the appearance of government endorsement or approval of the offensive trademark. In addition, supporters of the ban contend that government resources should not be spent on registering or protecting offensive trademarks. Others argue that the marketplace by the trademark applicant or another party. Megan M. Carpenter & Mary Garner, *NSFW: An Empirical Study of Scandalous Trademarks*, 33 Cardozo Arts & Ent. L.J. 321, 362-63 (2015).

33. *Tam*, 808 F.3d at 1375 (Lourie, J., dissenting) ("[I]t has been questioned whether federal registration imparts the 'imprimatur' of the federal government on a mark, such that registration could be permissibly restricted as government speech. I believe that such action is justified."); Baird, *supra* note 11, at 788 (stating that one justification for Section 2(a) is that the "federal government should not create the appearance that it favors or approves the use of scandalous, immoral, and disparaging trademarks by placing them on the Principal Register"); Tushnet, *supra* note 11, at 8 (noting courts and the USPTO have argued that “the bar avoids the harm done by the government endorsement represented by a registration”).

In its brief filed in the *Tam* dispute at the Federal Circuit, the U.S. government argued that the First Amendment “does not require Congress to assist those who seek to use racial epithets as trademarks in interstate commerce.” En Banc Brief for Appellee at 3, *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015) (No. 14–1203); see also id. at 14 (“The Constitution does not preclude Congress from creating a federal trademark registration program without extending it to embrace racial epithets as commercial identifiers.”). The U.S. government made similar arguments when it asked the U.S. Supreme Court to review the Federal Circuit’s decision in *Tam*. See Petition for Writ of Certiorari, *supra* note 8, at 10 (“Section 1052(a) simply reflects Congress’s judgment that the federal government should not affirmatively promote the use of racial slurs and other disparaging terms by granting them the benefits of registration.”).

34. See, e.g., *Tam*, 808 F.3d at 1364 (Dyk, J., concurring in part and dissenting in part) ("[T]he statute is designed to preclude the use of government resources not when the government disagrees with a trademark’s message, but rather when its meaning ‘may be disparaging to a substantial composite of the referenced group.’"); *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981) ("In providing that marks comprising scandalous matter not be registered, Congress expressed its will that such marks not be afforded the statutory benefits of registration. We do not see this as an attempt to legislate morality, but, rather, a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government.", quoted in *In re Fox*, 702 F.3d 633, 634 (Fed. Cir. 2012); Baird, *supra* note 11, at 788 (noting that one justification for Section 2(a) is that “the federal government should not squander its precious time and resources on scandalous, immoral, and disparaging trademarks”); Tushnet, *supra* note 11, at 8-9 (noting courts and the USPTO have argued that “the bar implements a decision to withhold government resources from disparaging or scandalous terms”).

In *Tam* at the Federal Circuit and U.S. Supreme Court, the U.S. government argued that it need not use government resources to encourage the use of offensive trademarks. En Banc Brief for Appellee, *supra* note 33, at 16 (“The Constitution does not require Congress to underwrite the commercial use of racist, misogynist, or bigoted terms and imagery in interstate commerce—let alone record them on the government’s Principal Register and certify their registration under the official seal of the United States Patent and Trademark Office.”); *id.* at 21 (Section 2(a) “reflects Congress’s judgment that a federal agency should not use its resources affirmatively to promote the use in commerce of racial slurs and similar disparagements as the means for avoiding confusion as to the source of goods or services.”); *id.* at 41 (“[T]he government has a legitimate interest in declining to use its resources in a manner that would encourage the use of offensive or disparaging marks.”); *id.* at 43 (“Tam cannot seriously dispute the government’s legitimate interest in declining to expend its resources to facilitate the use of racial slurs as source identifiers in interstate commerce.”); Petition for Writ of Certiorari, *supra* note 8, at 16 (“Congress legitimately
disparagement provision of Section 2(a) serves trademark interests. For example, Professor Michael Grynberg believes that disparaging words do not function effectively as trademarks.\textsuperscript{35} Moreover, Judge Reyna contends in his dissent in \textit{Tam} that the use of disparaging trademarks tends to disrupt commercial activity and registration of such marks does not further the Lanham Act's goal of promoting the orderly flow of commerce.\textsuperscript{36}

As explained by Professor Christine Farley, critics of laws denying registration to offensive marks “charge that they unconstitutionally restrict free expression, are unwarranted in an otherwise relatively value-neutral regulation of marketplace practice, introduce inherent subjectivity into registration determinations, and produce erratic and inconsistent results.”\textsuperscript{37} As noted by the Federal Circuit in \textit{Tam}, “[t]he [US]PTO’s record of trademark registrations and denials [under Section 2(a)] often appears arbitrary and is rife with inconsistency.”\textsuperscript{38} This makes it difficult for companies or individuals to determine if they can register subject matter which may fall within the offensive trademark provisions in Section 2(a) and similar laws. It can also chill the use of expression as a mark that could possibly be deemed immoral, scandalous, potentially disparaging, or otherwise offensive by certain members of the public.

Regardless of whether one agrees with the critics or supporters of trademark laws banning registration of offensive marks, it is important to note that these laws are not new. They were determined that a federal agency should not use government funds to issue certificates ‘in the name of the United States of America’ conferring statutory benefits for use of racial slurs and other disparaging terms.”\textsuperscript{id} at 18-19 (“But the First Amendment does not bar Congress from using the resources of the federal government to encourage some forms of expressive conduct rather than others.”); \textit{id.} at 21 (“[T]he government also has an interest in declining to use its resources to encourage offensive or disparaging marks.”). However, the Federal Circuit in \textit{Tam} notes that government funds are not currently used to carry out the activities of the USPTO; since 1991 “registration fees cover all of the operating expenses associated with registering marks.”\textsuperscript{In re Tam, 808 F.3d 1321, 1353 (Fed. Cir. 2015) (en banc), as corrected (Feb. 11, 2016), cert. granted sub nom. Lee v. Tam (U.S. Sept. 29, 2016) (No. 15-1293).}


\textsuperscript{36} \textit{Tam}, 808 F.3d at 1379 (Reyna, J., dissenting) (“Section 2(a) serves the same substantial government interest as the Lanham Act as a whole—the orderly flow of commerce. Commercial speech that insults groups of people, particularly based on their race, gender, religion, or other demographic identity, tends to disrupt commercial activity and to undermine the stability of the marketplace in much the same manner as discriminatory conduct.”).

\textsuperscript{37} Farley, \textit{Stabilizing Morality}, supra note 11, at 1024 (citing Carpenter & Murphy, \textit{supra} note 11; LaLonde & Gilson, \textit{supra} note 11, at 1477, 1482-87; Lee, \textit{supra} note 11; Smith, \textit{supra} note 11).

\textsuperscript{38} \textit{In re Tam, 808 F.3d 1321, 1342 n.7 (Fed. Cir. 2015) (en banc), as corrected (Feb. 11, 2016), cert. granted sub nom. Lee v. Tam (U.S. Sept. 29, 2016) (No. 15-1293) (providing examples); Tam, 808 F.3d at 1359-63 (O’Malley, J., concurring) (same).
have been a part of international, regional, and national trademark laws for a long time.

A. International and Regional Trademark Obligations Relating to Offensive Trademarks

At the international level, multilateral trademark treaties and trade agreements give the United States and other nations complete discretion on whether to refuse to register or invalidate the registration of trademarks that are deemed by the government to be immoral or contrary to public order. Countries have international obligations relating to the registration and protection of trademarks if they are members of the “Paris Union” that agreed to be bound by the Paris Convention. 39 Importantly, the United States and other Paris Union members do not have any international obligations to register offensive trademarks. To the contrary, Article 6quinquies(3) of the Paris Convention currently provides: “Trademarks covered by this Article may be neither denied registration nor invalidated except when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public.”40 The morality and public order language appears in the original 1883 version of this treaty, and was the only ground for refusal or cancellation of a trademark registration in the Paris Convention at that time.41 According to


40. Paris Convention, supra note 20, art. 6quinquies(3). Note that Article 6quinquies of the Paris Convention also provides: “This provision is subject, however, to the application of Article 10bis.” Per Bodenhausen, this last sentence of Paris Convention Article 6quinquies “enables member States to refuse or invalidate the registration of a trademark if, for reasons other than those already mentioned in the Article—for example, infringement of the rights of third parties or [the] deceptive character of the mark—its registration would constitute an act of unfair competition. This, for example, could be the case if the mark, in reproducing the picture of a well-known building which is the seat of a competitor, would be liable to cause confusion with that establishment, or if the mark contained a discrediting comparison with the goods of one or more competitors.” Bodenhausen, supra note 39, at 117 (footnotes and emphasis omitted); see Ladas, supra note 39, at 1237 (explaining that this provision was added “so that it would be clearly understood that the exception with regard to marks contrary to morality or public order or deception of the public purported to include marks filed under circumstances constituting an act of unfair competition in the sense of article 10bis”) (footnotes omitted).

41. Bodenhausen, supra note 39, at 114 (“In the original Convention of 1883, the only ground for refusal or invalidation of the registration of trademarks covered by the Article under consideration was contained in the rule (then paragraph 4 of Article 6) that filing may be refused if the object for which it is requested is considered contrary to morality or public order.”) (citing Actes de Paris, I, pp. 73/4, 138); Ladas, supra note 39, at 1226 (noting
William Henry Browne’s *A Treatise on the Law of Trade-Marks* from that time period, there was “a rule of universal application” that trademarks “must not transgress the rules of morality or public policy.”42 G.H.C. Bodenhausen—who wrote a 1969 guide to the 1967 version of the Paris Convention—provides the following examples of these types of offensive trademarks:

A mark contrary to morality would, for example, be a mark containing an obscene picture. A mark contrary to public order would be a mark contrary to the basic legal or social concepts of the country concerned. Examples of such marks could be a mark containing a religious symbol, or a mark containing the emblem of a forbidden political party, or the emblem of a public body . . . .43

The flexibility relating to denials of registration for trademarks contrary to morality or public order was not changed in 1994 when the Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS Agreement”) was adopted by the United States and other members of the World Trade

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42. William Henry Browne, *A Treatise on the Law of Trade-Marks* 464-65 (1873) (“Propriety must be the standard in the selection of something intended to serve as a symbol of commerce . . . The moral, religious, or political sensibilities of any people must not be shocked by the perversion of an emblem sacred in their eyes . . . To be a ‘lawful trade-mark’ the emblem must not transgress the rules of morality or public policy. The law will not aid any person to blasphemously bring obloquy upon objects and symbols consecrated to religion . . . All peoples worship God under some form or other, or at least think that they do. Their religious prejudices must not be trampled upon. We tolerate all religions, true or false. A reader of these lines may be a Chinaman. His *joss* must not be caricatured. If a scoffer should endeavor to curry favor with an infidel class by the profane use of an Agnus Dei, or of any symbol of the Alpha and Omega, or the Ineffable Name, or even of angels, apostles, saints, and martyrs, or of a thousand objects depicted by ancient art, and hallowed by associations, would any court of justice sustain a claim to a trade-mark so composed? No! This is a rule of universal application.”) (footnotes omitted), cited in En Banc Brief for Appellee, *supra* note 33, at 45.

43. Bodenhausen, *supra* note 39, at 116. One commentator argues the phrase “in particular, of such a nature as to deceive the public” means that Article 6quinques “is directed toward immorality based on deception or its tendency to cause public disorder.” Marc J. Randazza, *Freedom of Expression and Morality-Based Impediments to the Enforcement of Intellectual Property Rights*, 16 Nev. L.J. 107, 120 (2015). Yet Bodenhausen explains that deceptive marks are only a “special category of trademarks” that are contrary to morality or public order: “The Revision Conference of London in 1934 added to this provision, as a special category of trademarks contrary to morality or public order, those trademarks which are of such a nature as to deceive the public. The purpose of this addition was to enable the member States to refuse or invalidate trademarks containing suggestions that the goods concerned possessed non-existing qualities, or unjustified references to rewards or to protection by a patent, etc. The provision will also apply to trademarks containing misleading indications of geographic origin.” Bodenhausen, *supra* note 39, at 116 (footnotes and emphasis omitted).
Organization ("WTO"). Article 15(2) of the TRIPS Agreement provides that WTO members may deny registration to trademarks on grounds other than those set forth in Article 15(1)—such as lack of distinctiveness—"provided that they do not derogate from the provisions of the Paris Convention (1967)." WTO members can therefore continue to enact laws banning registration of offensive trademarks without violating their international obligations under the TRIPS Agreement.

Paris Union and WTO members have used their discretion to enact trademark laws banning registration of trademarks “contrary to morality or public order” at the regional and national level. For example, Article 7(1)(f) of the European Union Trade Mark Regulation provides that “[t]he following shall not be registered: . . . (f) trade marks which are contrary to public policy or to accepted principles of morality.” In addition, Article 1708(14) of the North American Free Trade Agreement (“NAFTA”) between Canada, Mexico, and the United States provides that “[e]ach 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, or bring them into contempt or disrepute.” If the USPTO begins to


45. TRIPS Agreement, supra note 20, art. 15(2).


47. North American Free Trade Agreement, Dec. 17, 1992, art. 1708(14), H.R. Doc. 103-159, 32 I.L.M. 289, 673 (entered into force Jan. 1, 1994), discussed in Scassa, supra note 11, at 1178. Note NAFTA is a free trade agreement rather than a treaty (it was not ratified by two-thirds of the U.S. Senate), and it is not self-executing in the United States. While the U.S. Congress must implement NAFTA for its rules to be binding on U.S. citizens, the United States is bound by international law to comply with its obligations in this trade agreement. If the United States violates its obligations under NAFTA, Canada or Mexico could file a complaint under the dispute settlement mechanisms of NAFTA and argue to a NAFTA panel that the United States is not in compliance and needs to change its laws or provide monetary restitution.
register trademarks that may disparage people, institutions, beliefs, or national symbols of Canada, Mexico, or the United States after the Federal Circuit’s holding in *Tam*, then the United States will violate its trademark obligations under NAFTA. While compliance with a free trade agreement (or a treaty) is not a sufficient justification to violate a provision in the U.S. Constitution, it is still surprising that this international obligation of the United States was not discussed in any of the opinions of the judges in the *Tam* case.

**B. Examples of National Trademark Laws Relating to Offensive Trademarks**

While the specific language in the statute and the exact meaning of the words may vary, several nations have enacted trademark legislation prohibiting registration (and sometimes even the use) of offensive trademarks. This fact is relevant here not to show that nations should enact such provisions or adopt the language in the laws set forth below. Rather, these national laws, along with the international and regional laws discussed above, suggest that the custom in international law is for nations to ban registration and protection of offensive trademarks rather than recognize a free speech right to registration of such marks.

There are a variety of ways that an offensive trademark may be denied registration on a nation’s trademark register. First, an offensive mark may be refused registration by a trademark office examiner during the initial examination of the trademark application for the mark. An example is the application to register THE SLANTS mark for entertainment services in *Tam*. Second, if the trademark examiner approves of the mark and allows it to be published, another party may still oppose the application on the ground that registration of the offensive mark is prohibited by the trademark statute. For example, the Boston Red Sox Baseball

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48. *Boos v. Barry*, 485 U.S. 312, 323-24 (1988) (striking down content-based restriction on display of placards critical of foreign governments outside those governments' embassies despite the United States’ "vital national interest in complying with international law," and noting that "the fact that an interest is recognized in international law does not automatically render that interest 'compelling' for purposes of First Amendment analysis"); *Reid v. Covert*, 354 U.S. 1, 16 (1957) ("[N]o agreement with a foreign nation can confer power on the Congress, or on any other branch of Government, which is free from the restraints of the Constitution.").

49. See the sources in note 1. Canada is one example of a country that bans the adoption, use, and registration of an offensive trademark. See supra note 3. The World Intellectual Property Organization (WIPO) administers the Paris Convention, and the WIPO website contains the national trademark laws of the Paris Union and WTO members. World Intellectual Prop. Org., *WIPO Lex*, http://www.wipo.int/wipolex/en/ (last visited Aug. 4, 2016). English-language translations of non-English language trademark laws discussed in this section of the paper were obtained from this WIPO website, and the author cannot vouch for the accuracy of these translations.
Club successfully opposed an application to register a mark containing the term SEX ROD for clothing on the ground that this mark was immoral, scandalous, and may disparage others.\footnote{50} Third, once the mark is registered, others may petition the trademark office or ask a court to cancel the registration. Pro-Football, Inc.’s six registrations containing the word REDSKINS are examples of registrations that were cancelled after they were issued by the USPTO.

Given that the Paris Convention allows denial of registration and invalidation of trademarks that are “contrary to morality or public order,” it is not surprising that many Paris Union members use the words “morality” and “public order” (or the phrase “public policy”) in their statutes banning registration of offensive trademarks. For example, Article 20(k) of Chile’s Industrial Property Law provides “[t]he following may not be registered as marks: . . . (k) marks contrary to public policy, morality and proper practice, including the principles of fair competition and trade ethics.”\footnote{51} In Egypt, Article 67(2) of the Law on Protection of Intellectual Property Rights states that “[t]he following shall not be registered as trademarks or components thereof: . . . (2) any mark which is contrary to public order or morality.”\footnote{52} Per Article 123(1)(f) of Greece’s Trademark Law, “[t]he following signs shall not be registered as trademarks: . . . (f) signs which are contrary to public order or to principles of morality.”\footnote{53} In Japan, Article 4(1)(vii) of the Trademark Act provides that “no trademark shall be registered if the trademark: . . . (vii) is likely to cause damage to public policy.”\footnote{54} Article 4 of Mexico’s Industrial Property Law (which applies to patents in addition to trademarks) provides “[n]o patent, registration or authorization shall be granted, nor shall any publicity be given in the Gazette to any of the legal authorities or institutions governed by this Law, where their contents or substance are contrary to public policy, morality or proper practice, or if said contents or substance violate any legal provision.”\footnote{55}
trademark state registration shall be granted to designations which are or comprise elements: . . . (2) which conflict with the public interest and with humanity and moral principles.”

Article 2(c) of Saudi Arabia’s Law of Trademarks provides “[t]he following signs, emblems, flags and others as listed below shall not be considered or registered as trademarks: . . . (c) Any expression, sign or drawing inconsistent with public order or public morality.”

Finally, Section 3(3)(a) of the United Kingdom’s Trade Marks Act provides “[a] trade mark shall not be registered if it is—(a) contrary to public policy or to accepted principles of morality.”

Some national trademark laws banning registration of offensive marks contain additional language tailored to the needs of a particular nation, whether they are religious, political, or specific to certain indigenous groups. For example, in Afghanistan, Article 6(6) of the Trademark Registration Law provides “[t]he following symbols may not be used or registered as trademarks: . . . (6) Any marks repugnant to chastity, morality and public order.”

In Brazil, Article 124(III) of the Industrial Property Law refuses registration to marks that consist of “figures, drawings or any other signs that are contrary to morals and standards of respectability or that offend the honor or image of persons or attempt freedom of conscience, belief, religious cult or ideas and feelings worthy of respect and veneration.”

Article 10 of The Trademark Law of the People’s Republic of China provides “[t]he following words or devices shall not be used as trademarks: . . . (6) Those that discriminate against any nationality . . . (8) Those detrimental to socialist morals or customs, or having other unhealthy influences.”

In South Korea, Article 34 of the Trademark Act prohibits the registration of “2. Any trademark which falsely indicates a connection with a state, race, ethnic group, public organization, religion or famous deceased person, or which slanders, insults or is likely to defame them” and “4. Any

56. Grazhdanskii Kodeks Rossiiskoi Federatsii [GK RF] [Civil Code] art. 1483(3)(2) (Russ.).

57. Law of Trademarks, Royal Decree No. M/21, art. 2(c), Aug. 7, 2002 (Saudi Arabia).

58. Trade Marks Act, 1994, c. 26, § 3(3)(a) (U.K.); see Griffiths, supra note 11, at 311–19, 322–33 (discussing the law on marks contrary to public policy and morality in the United Kingdom, and evaluating whether refusal of an application to register a mark under this provision violates the applicant’s right to freedom of expression).

59. Trademark Registration Law, art. 6(6) (2009) (Afg.).

60. Lei No. 9.279 art. 124(3), de 14 de Maio de 1996, Diário Oficial da União [D.O.U.] de 15.05.1996 (Braz.).

trademark whose meaning, content, etc. conveyed to consumers is likely to harm public order, such as being contrary to moral norms, the prevailing moral sense of ordinary people, where the trademark itself is used or the trademark is used for goods.”62 Section 17(1)(c) of the New Zealand Trade Marks Act mentions the Māori, a group of indigenous people in that country; it states that “[t]he Commissioner must not register as a trade mark or part of a trade mark any matter - . . . (c) the use or registration of which would, in the opinion of the Commissioner, be likely to offend a significant section of the community, including Māori.”63

Other nations ban registration of subject matter that is scandalous, obscene, or which is likely to offend others.64 For example, in Australia, Section 42(a) of the Trade Marks Act provides “[a]n application for the registration of a trade mark must be rejected if: (a) the trade mark contains or consists of scandalous matter.”65 Section 9(1)(j) of the Trade-marks Act of Canada provides “[n]o person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for, . . . (j) any scandalous, obscene or immoral word or device.”66 In addition,

62. Sangpyobeob [Trademark Act], Act No. 71, Nov. 28, 1949, amended by Act No. 14033, Feb. 29, 2016, art. 34 (S. Kor.).
63. Trade Marks Act 2002, pt 2, subs 2, s 17(1)(c) (N.Z.); see also Frankel, supra note 11, at 433-63.
64. In Australia, the “scandalous” bar to registration “is most likely to operate in the area of religious or racial matters” rather than prohibit shocking matter such as profanity or sexually offensive trademarks. Davison, Monotti, & Wiseman, supra note 17, at 100; see also Burrell & Handler, supra note 17, at 164-69 (noting that Trade Mark Office decisions suggest that the mark must be more than merely indecent, crude, or in bad taste, and must go further than merely alluding to or suggesting an obscene term). Canada’s trademark examination manual explains that “[a] scandalous word or design is one which is offensive to the public or individual sense of propriety or morality, or is a slur on nationality and is generally regarded as offensive. It is generally defined as causing general outrage or indignation.” Canadian Intellectual Property Office, Trade-marks Examination Manual, IV.10.6 Paragraph 9(1)(j), https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr03636.html#iv.10 (last modified July 14, 2016). In Canada, “[a] word is obscene if marked by violations of accepted language inhibitions or regarded as taboo in polite usage. This word is generally defined as something that is offensive or disgusting by accepted standards of morality or decency; or offensive to the senses. A word or design is immoral when it is in conflict with generally or traditionally held moral principles, and generally defined as not conforming to accepted standard[s] of morality . . . . In order to determine if a word or design is scandalous, obscene or immoral, examiners must determine whether the trademark would offend the feelings or sensibilities of a not insignificant segment of the public.” Id.; see also Hallelujah Trade Mark [1976] 93 R.P.C. 605, 610 (Eng.) (refusal to register mark HALLELUJAH for clothing because it might offend people’s religious sensibilities); Oomphies Trade Mark [1947] 64 R.P.C. 27, 29 (Eng.) (overruling denial of registration of OOMPHIES for shoes; word “oomph” was American slang for sex appeal).
65. Trade Marks Act 1995 (Cth) s 42 (Austl.); see Burrell & Handler, supra note 17, at 164-69 (discussing potential reasons for the law, examples of decisions, and the standards used in Australia to determine if a mark is scandalous).
Sections 11 and 12(1)(e) of Canada’s Trade-marks Act ban the use and registration of such marks, respectively. 67 Section 9(2)(c) of India’s Trademarks Act provides “[a] mark shall not be registered as a trade mark if . . . (c) it comprises or contains scandalous or obscene matter.” 68 Section 11 of Nigeria’s Trade Marks Act prohibits the registration as a mark of “(a) any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice or be contrary to law or morality; or (b) any scandalous design.” 69 In South Africa, Section 10(12) of the Trade Marks Act denies registration to ”a mark which is inherently deceptive or the use of which would be likely to deceive or cause confusion, be contrary to law, be contra bonos mores, or be likely to give offence to any class of persons.” 70 United States trademark law also bans registration of “scandalous matter” and other types of offensive marks, as discussed next.

C. Section (2)(a) of the Lanham Act and the Free Speech Arguments in Tam

United States federal trademark law has prohibited the registration of scandalous and immoral trademarks since 1905, and banned trademarks that may disparage others from registration since 1946. 71 Currently, Section 2(a) of the Lanham Act provides “[n]o 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

67. Id. § 11 (use); id. § 12(1)(e) (registration); see Scassa, supra note 3, 205-07; Scassa, supra note 11, at 1178, 1183.
70. Trade Marks Act No. 194 of 1993 § 10(12) (S. Afr.).
71. Trademark Act of 1905, § 5, 33 Stat. 724, 725; Trademark Act of 1946, Pub. L. No. 79-489, § 2(a), 60 Stat. 427, 428; see Hearings on H.R. 9041 Before the Subcomm. on Trademarks of the H. Comm. on Patents, 75th Cong., 3d Sess. 79-113 (1938) (legislative history of Section 2(a)); see also In re Tam, 808 F.3d 1321, 1330 (Fed. Cir. 2015) (en banc), as corrected (Feb. 11, 2016), cert. granted sub nom. Lee v. Tam (U.S. Sept. 29, 2016) (No. 15-1293) (discussing the disparagement provision of Section 2(a) and examples of marks that were found disparaging by the USPTO); id. at 1374 (Lourie, J., dissenting) (noting that the U.S. government has banned registration of offensive marks since 1905 and asking “[i]s there no such thing as settled law, normally referred to as stare decisis?”); Farley, Stabilizing Morality, supra note 11, at 1024-25 (while the “United States has regulated the morality of marks for over a century” Section 2(a) is “not a puritanical relic” since it is consistent with international law and similar rules exist in the trademark laws of U.S. states and most European nations). State trademark statutes and the model state trademark bill in the United States contain a similar provision. See LaLonde & Gilson, supra note 11, at 1477; Model State Trademark Bill § 2 (1964), reprinted in McCarthy, supra note 16, § 22:8. For background information about Section 2(a) of the Lanham Act see Abdel-Khalik, supra note 11, at 180-98; Baird, supra note 11, at 666-67.
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.” 72 Before Tam, the only U.S. court of appeals decision that evaluated the constitutionality of Section 2(a) was the opinion of the U.S. Court of Customs and Patent Appeals (the predecessor to the Federal Circuit) in the 1981 case In re McGinley. 73 There the court held that Section 2(a) did not violate the constitutional right to freedom of expression:

With respect to appellant’s First Amendment 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,

72. Lanham Act § 2(a), 15 U.S.C. § 1052(a). Per the U.S. trademark examination manual, the word “scandalous” has been defined in the United States as “shocking to the sense of propriety, offensive to the conscience or moral feelings or calling out for condemnation” and includes “matter that is ‘vulgar,’ defined as ‘lacking in taste, indelicate, morally crude.’” U.S. Trademark Manual of Examining Procedure (“TMEP”), § 1203.01 (Apr. 2016 ed.), https://mpep.uspto.gov/RDMS/TMEP/current#/current/TMEP-1200d1e3042.html (last visited Aug. 4, 2016) (citations omitted). “Although the words ‘immoral’ and ‘scandalous’ may have somewhat different connotations, case law has included immoral matter in the same category as scandalous matter.” Id. The USPTO trademark examination manual further states that “[d]isparagement is essentially a violation of one’s right of privacy—the right to be ‘let alone’ from contempt or ridicule.” Id. § 1203.03(b) (quoting Greyhound Corp. v. Both Worlds Inc., 6 U.S.P.Q.2d 1635, 1639 (T.T.A.B. 1988)). In Tam, the Federal Circuit explained that “[a] disparaging mark is a mark which ‘dishonors by comparison with what is inferior, slights, deprecates, degrades, or affects or injures by unjust comparison.’” Tam, 808 F.3d at 1330 (quoting In re Geller, 751 F.3d 1355, 1358 (Fed. Cir. 2014)).

There are different tests for evaluating whether a mark is potentially disparaging or scandalous in the United States. “To determine if a mark is disparaging under § 2(a), a trademark examiner of the PTO considers ‘(1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and (2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.’” Id. at 1330-31 (quoting TMEP, supra, § 1203.03(b)(i)); see also In re Geller, 751 F.3d at 1358 (finding mark STOP THE ISLAMISATION OF AMERICA would be disparaging to a substantial composite of American Muslims). “The determination of whether a mark is scandalous must be made in the context of the relevant marketplace for the goods or services identified in the application, and must be ascertained from the standpoint of not necessarily a majority, but a ‘substantial composite of the general public.’ As long as a substantial composite of the general public would perceive the mark, in context, to have a vulgar meaning, ‘the mark as a whole “consists of or comprises . . . scandalous matter” under §2(a).’” TMEP, supra, § 1203.01 (citing In re Fox, 702 F.3d 633, 638 (Fed. Cir. 2012) (holding mark COCK SUCKER for a rooster-shaped chocolate lollipop was scandalous)).

73. In re McGinley, 660 F.2d 481 (C.C.P.A. 1981) (affirming the examiner’s rejection of a mark consisting of “a photograph of a nude man and woman kissing and embracing in a manner appearing to expose the male genitalia” for a newsletter), abrogated by In re Tam, 808 F.3d 1321 (Fed. Cir. 2015) (en banc), as corrected (Feb. 11, 2016), cert. granted sub nom. Lee v. Tam (U.S. Sept. 29, 2016) (No. 15-1293).
appellant’s First Amendment rights would not be abridged by the refusal to register his mark.\textsuperscript{74}

The Federal Circuit followed this holding in \textit{McGinley} several times when trademark applicants challenged the constitutionality of Section 2(a).\textsuperscript{75} Then in 2015 the court overturned \textit{McGinley} in \textit{Tam} and held the disparagement provision of Section 2(a) is unconstitutional on its face and as applied to Tam’s mark THE SLANTS for entertainment services.\textsuperscript{76}

In \textit{Tam}, the \textit{en banc} Federal Circuit held the “may disparage” provision of Section 2(a) is a facially-invalid regulation of expression that violates the First Amendment right to freedom of expression because the government is denying registration of the potentially disparaging trademarks based on disapproval of the message conveyed by those marks.\textsuperscript{77} Even though the statute does not suppress or punish expression, the Federal Circuit said it chills the speech of trademark owners and is an unconstitutional condition on expression because the statute deprives them of a valuable benefit solely because of the content of the message communicated by the mark.\textsuperscript{78} The court also held the statute discriminates based on the viewpoint of the speaker in a manner repugnant to the First Amendment because the government has allowed registration of terms that celebrate (rather than offend) certain groups.\textsuperscript{79} For example, the court noted “the PTO has registered marks that refer positively to people of Asian descent. See, e.g., CELEBRASIONS, ASIAN EFFICIENCY.”\textsuperscript{80} The court said this content-based law must be justified under the highest level of constitutional scrutiny regardless of whether the law regulates commercial expression or other speech deemed to be of low value, and concluded Section 2(a) fails strict scrutiny analysis.\textsuperscript{81} In addition, the court held a trademark registration is not government speech\textsuperscript{82} or a government subsidy,\textsuperscript{83} which would

\textsuperscript{74.} \textit{McGinley}, 660 F.2d at 484 (footnotes omitted).

\textsuperscript{75.} See, e.g., \textit{In re Fox}, 702 F.3d 633, 635 (Fed. Cir. 2012) (COCK SUCKER for rooster-shaped lollipops); \textit{In re Boulevard Entm't, Inc.}, 334 F.3d 1336, 1343 (Fed. Cir. 2003) (JACK-OFF for adult entertainment services provided over the telephone); \textit{In re Mavety Media Grp. Ltd.}, 33 F.3d 1367, 1374 (Fed. Cir. 1994) (BLACK TAIL for an adult entertainment magazine featuring African-American women).

\textsuperscript{76.} \textit{Tam}, 808 F.3d at 1330 n.1.

\textsuperscript{77.} Id. at 1334-39.

\textsuperscript{78.} Id. at 1339-45. The unconstitutional conditions doctrine will be discussed \textit{infra} Part IV.A.2.

\textsuperscript{79.} Id. at 1136-37. Viewpoint discrimination will be discussed \textit{infra} Part IV.A.6.

\textsuperscript{80.} Id. at 1336.

\textsuperscript{81.} Id. at 1334-37 (arguing that Reed v. Town of Gilbert, 576 U.S. __, 135 S. Ct. 2218, 2226-33 (2015) requires the highest level of constitutional scrutiny in this case because the law is content-based). Constitutional scrutiny is discussed \textit{infra} Part IV.A.6.

\textsuperscript{82.} \textit{Tam}, 808 F.3d at 1345-48. Government speech doctrine is discussed \textit{infra} Part IV.4.
enable the government to more easily regulate the content of the expression. Finally, the court said the statute would fail intermediate scrutiny analysis under the Central Hudson test used to evaluate the constitutionality of regulations of commercial speech if that standard applied.84

In addition to joining the majority opinion in Tam, Judge O’Malley wrote a concurrence (joined by Judge Wallach).85 Judge O’Malley argued that the “may disparage” provision of Section 2(a) was unconstitutionally vague under both the First Amendment and the Fifth Amendment of the U.S. Constitution, which provides that no person shall “be deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use, without just compensation.”86 After discussing the USPTO’s inconsistent and arbitrary decisions under Section 2(a) and the statute’s chilling effect on expression,87 Judge O’Malley concluded that Section 2(a) was not constitutional because it is void for vagueness.88

The judges in Tam who believed Section 2(a) is constitutional on its face or as applied to THE SLANTS mark responded to these arguments in various ways. In his partial concurrence and partial dissent, Judge Dyk agreed with the majority that the law was unconstitutional as applied to Tam’s mark (which he thought was political speech), but he would have held Section 2(a) is a facially-constitutional regulation of commercial speech.89 Judge Dyk (joined by Judges Lourie and Reyna in Parts I-IV of his opinion) said “many trademarks lack the kind of ‘expressive character’ that would merit First Amendment protection for offensive content, and a regulation of the use of those marks could satisfy the Central Hudson test for commercial speech.”90 He also stated that registration is a government “subsidy” and that awards of subsidies can be made based on their content, so Section 2(a) is not an unconstitutional condition on expression.91 In addition, Judge Dyk said the majority is incorrect that the government cannot

83. Id. at 1348-55. Government subsidies are discussed in the unconstitutional conditions section of infra Part IV.2.
84. Id. at 1355-57. The intermediate scrutiny test set forth in Central Hudson provides that a restriction on nonmisleading commercial speech is constitutional if the law directly advances a substantial government interest and is no more extensive than necessary to serve that interest. Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y., 447 U.S. 557, 565-66 (1980).
85. Tam, 808 F.3d at 1358-63 (O’Malley, J., concurring).
86. Id.; U.S. Const. amend. V.
87. Tam, 808 F.3d at 1359-60.
88. Id. at 1361-63.
89. Id. at 1363-64, 1373 (Dyk, J., concurring in part and dissenting in part).
90. Id. at 1368.
91. Id. at 1368-71.
award subsidies based on viewpoint, but even if it cannot, he thought Section 2(a) is a viewpoint-neutral law. Judge Dyk concluded that this regulation is “reasonable” to protect the disparaged groups when applied to commercial speech, and said the government can make the decision to not assist disparaging commercial expression.

In addition to joining part of Judge Dyk’s opinion in *Tam*, Judge Lourie argued in his dissent that it is best to apply stare decisis and defer to the legislature on whether to filter out undesirable marks from the federal trademark registration system. He did not think a refusal to register a trademark denies the right of free speech, and questioned whether “a trademark, even an expressive trademark, is protected commercial speech.” He said “the government does not necessarily violate an individual’s constitutional rights merely by refusing to grant registration and thereby provide additional assistance in the enforcement of trademark rights.” In addition, he said the federal registration (but not Tam’s trademark itself) “could be permissibly restricted as government speech” because “federal registration imparts the ‘imprimatur’ of the federal government on a mark.” Judge Lourie thought it was clear that owners of marks denied registration under Section 2(a) on the ground that the marks may disparage others could still obtain common law protection against unfair competition under Section 43(a) of the Lanham Act, and disagreed with the majority in *Tam*, who suggested otherwise.

Dissenting Judge Reyna criticized the majority for holding “that Mr. Tam’s speech, which disparages those of Asian descent, is valuable political speech that the government may not regulate except to ban its use in commerce by everyone but Mr. Tam.” Judge Reyna said trademarks are commercial speech and due to the “nature of trademarks seeking federal registration for use in interstate commerce”—which “is indisputably commercial, not political”—Section 2(a) is subject to intermediate scrutiny analysis.

92. Id. at 1371-72.
93. Id. at 1372-73.
94. Id. at 1374-75 (Lourie, J., dissenting).
95. Id. at 1375.
96. Id.
97. Id.
98. Id.
99. Id. at 1344-45 & 1344 n. 11 (majority opinion).
100. Id. at 1376 (Reyna, J., dissenting); see also id. at 1378 (“But if the expressive content of the mark precludes regulation, on what authority may the government grant Mr. Tam the exclusive right to use this mark in commerce? Whatever standard of scrutiny protects the content of Mr. Tam’s trademark from government regulation, that same standard must necessarily be overcome by the government’s substantial interest in the orderly flow of commerce, or no trademark could issue.”) (emphasis in original).
even when a trademark includes a political element. Judge Reyna also argued that Section 2(a) is a content-neutral regulation of expression because the government’s purpose is to address the harmful secondary effects of the speech rather than to suppress speech, and said this is another reason that intermediate scrutiny analysis applies. Like Judge Lourie, Judge Reyna concluded that Section 2(a) survives intermediate scrutiny analysis and found the law constitutional on its face and as applied to THE SLANTS mark.

All of these issues are organized in Part IV into a six-part framework that may be beneficial to legislators, courts, attorneys, and scholars who are considering whether Section 2(a) or a similar law prohibiting registration of offensive marks conflicts with the right to freedom of expression. Before discussing these free speech doctrines, however, it is important to first consider why nations protect the right to freedom of expression and when nations can limit this right to protect other public and private interests.

III. THE RIGHT TO FREEDOM OF EXPRESSION AND LIMITS ON THIS RIGHT

To properly assess whether a trademark regulation violates the right to freedom of expression in a country, courts will first need to determine whether the government has an obligation under international, regional, or national laws to protect the free expression right. As explained below, many nations are required to protect the right to freedom of expression, but U.S. and foreign courts are not required to recognize a free speech right to register an offensive trademark. Legislatures therefore have discretion to deny registration of offensive trademarks unless national courts conclude—like the Federal Circuit in Tam—that such laws are an unconstitutional regulation of expression or otherwise violate the constitution in that country.

A. Human Rights Treaties and the Right to Freedom of Expression

Scholars debate whether there is a universal moral right of freedom of expression and many people disagree on the content and scope of the free expression right. Yet this right is clearly

101. Id. at 1376-78.
102. Id. at 1378-79.
103. Id. at 1379-82; id. at 1374-76 (Lourie, J., dissenting).
recognized by human rights treaties and national constitutions. For example, Article 19(2) of the International Covenant on Civil and Political Rights (“ICCPR”), to which the United States and 167 other countries are currently parties, declares: “Everyone shall have the right to freedom of expression; this right shall include the freedom to seek, receive and impart information and ideas of all kinds, regardless of frontiers, either orally, in writing or in print, in the form of art, or through any other media of his choice.”

A similar right is also included in regional human rights treaties, including the American Convention on Human Rights, and the European Convention on Human Rights. The American Convention on Human Rights obligates various nations in the Americas to protect the free expression right, including but not limited to Argentina, Chile, Columbia, Costa Rica, Ecuador, Nicaragua, Peru, and Uruguay. Article 13(1) of the American Convention on Human Rights provides: “Everyone has the right to freedom of thought and expression. This right includes freedom to seek, receive, and impart information and ideas of all kinds, regardless of frontiers, either orally, in writing, in print, in the form of art, or through any other medium of one’s choice.”

Similar language appears in Article 10(1) of the European Convention on Human Rights: “Everyone has the right to freedom

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110. American Convention on Human Rights, supra note 107, art. 13(1).
of expression. This right shall include freedom to hold opinions and
to receive and impart information and ideas without interference
by public authority and regardless of frontiers. This Article shall
not prevent States from requiring the licensing of broadcasting,
television or cinema enterprises.”111

Nations have significant discretion to determine the contours
of the free expression right because the language in these human
rights treaties is broad and lacks detail as to what is covered by
the right to freedom of expression. One thing that is clear,
however, is that the free expression right in the ICCPR, American
Convention on Human Rights, and European Convention on
Human Rights does not include an explicit right to register an
offensive trademark. The treaties do not mention “trademarks” at
all. Of course, international human rights law is growing to
include a robust sense of the government’s role in securing and
safeguarding human rights, and international norms about what is
and is not protected under the free expression right may change
over time.112 Still, there is no evidence of any current international
free expression right to registration of an offensive mark in human
rights treaties or customary international law. To the contrary,
several states ban registration of such marks,113 and trademark
and free expression treaties contain language which suggests that
nations have discretion to regulate offensive language with
restrictions or conditions on that expression to protect the public
interest and the rights or reputations of others.

The ICCPR, American Convention on Human Rights, and
European Convention on Human Rights allow member nations to
regulate expression for a variety of reasons—including to protect
morals, public order, and the rights or reputations of others—but
the rules must be set forth in the law (i.e., in statutes, codes, or the
common law rather than enforced at the discretion of the
government) and “necessary” to achieve the goal of the
regulation.114 For example, Article 19(3) of the ICCPR provides:

The exercise of the rights provided for in paragraph 2 of this
article carries with it special duties and responsibilities. It

111. European Convention on Human Rights, supra note 108, art. 10(1); see Wolfgang
Sakulin, Trademark Protection and Freedom of Expression: An Inquiry into the Conflict
(discussing the European Convention on Human Rights and noting that the European
Court of Human Rights has held that Article 10 covers commercial information and
advertisements).

112. I appreciate the comments of Rochelle Dreyfuss on this issue.

113. See supra Part II.B.

(Sept. 19, 2006), discussed in Eduardo Andrés Bertoni, The Inter-American Court of Human
Rights and the European Court of Human Rights: A Dialogue on Freedom of Expression
(discussing European law); Verpeaux, supra note 104, at 42 (same).
may therefore be subject to certain restrictions, but these shall only be such as are provided by law and are necessary: (a) For respect of the rights or reputations of others; (b) For the protection of national security or of public order (ordre public), or of public health or morals.\textsuperscript{115}

In addition, members of this human rights treaty agreed in Article 20(2) of the ICCPR that “[a]ny advocacy of national, racial or religious hatred that constitutes incitement to discrimination, hostility or violence shall be prohibited by law.”\textsuperscript{116}

Similar rules allowing restrictions on free expression rights are found in Article 13 of the American Convention on Human Rights:

2. The exercise of the right [to freedom of expression] provided for in the foregoing paragraph shall not be subject to prior censorship but shall be subject to subsequent imposition of liability, which shall be expressly established by law to the extent necessary to ensure:

a. respect for the rights or reputations of others; or

b. the protection of national security, public order, or public health or morals.

... 

4. Notwithstanding the provisions of paragraph 2 above, public entertainments may be subject by law to prior censorship for the sole purpose of regulating access to them for the moral protection of childhood and adolescence.

5. Any propaganda for war and any advocacy of national, racial, or religious hatred that constitute incitements to lawless violence or to any other similar action against any person or group of persons on any grounds including those of race, color, religion, language, or national origin shall be considered as offenses punishable by law.\textsuperscript{117}

In Europe, the free expression right is limited in Article 10(2) of the European Convention on Human Rights:

The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society, in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or rights of others,

\textsuperscript{115} ICCPR, supra note 106, art. 19(3) (emphasis added).

\textsuperscript{116} Id. art. 20(2) (emphasis added).

\textsuperscript{117} American Convention on Human Rights, supra note 107, art. 13(2)-(5) (emphasis added).
for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary.\textsuperscript{118}

Commentators note that certain types of expression such as hate speech and misleading commercial expression fall outside the subject matter that is protected under Article 10.\textsuperscript{119}

As the contracting parties to these human rights treaties can enact laws that restrict, punish, or put conditions on expression to protect morals, public order, and the rights or reputations of others, and to prevent incitement to discrimination, violence, and disorder,\textsuperscript{120} surely nations can enact statutory bans on registration of marks that are contrary to morality or public order, or which harm the rights or reputations of others targeted by the offensive expression, or which incite others to unlawful activities. These laws must be “necessary,” but nations can argue the law is justified under the relevant balancing test developed by courts interpreting the treaty language.\textsuperscript{121} If nations ban profanity, obscene matter, hate speech, or misleading commercial expression,

\textsuperscript{118} European Convention on Human Rights, supra note 108, art. 10(2) (emphasis added).

\textsuperscript{119} Barendt, supra note 104, at 182-83 (noting the European Court of Human Rights “has indicated that hate speech and Holocaust denial laws are in principle compatible with the Convention”); Griffiths, supra note 11, at 322 (noting states have “greater freedom to restrict artistic and commercial expression” under Article 10); Sakulin, supra note 111, at 112-13 (“Expression that may fall outside the subject-matter of Article 10 ECHR is racist or hate speech, and . . . misleading commercial expression.”) (internal footnotes omitted). “Trademark rights fall into the category of ‘the protection of the [. . . ] rights of others,’” and therefore governments can restrict the use of another’s trademark in misleading commercial expression without violating the free expression right in Article 10 of the European Convention on Human Rights. Sakulin, supra note 111, at 113, 149-80.

\textsuperscript{120} See, e.g., Eduardo Bertoni, Hate Speech Under the American Convention on Human Rights, 12 ILSA J. Int’l & Comp. L. 569 (2006); Krotoszynski, supra note 104, at 9, 26, 94 (discussing how in Germany and Canada protection of equality and human dignity are deemed more important than the right to freedom of expression); Verpeaux, supra note 104, at 48-62, 184-85, 198 (discussing limits on freedom of expression to protect morals and the rights of others in France, Germany and other countries in Europe, and noting in matters of morals there is no consensus and the margin of appreciation left to states is much greater).

\textsuperscript{121} Griffiths, supra note 11, at 322-33 (discussing the application by courts of Article 10 to refusals to register marks deemed contrary to morality or public policy, and arguing that such refusals do not violate Article 10). For example, the European Court of Human Rights requires (1) the limitation to be set forth in the law, (2) the limitation must strive to achieve one of the legitimate goals contained in Article 10(2), and (3) the limitation must be necessary in a democratic society. See, e.g., Casado Coca v. Spain, App. No. 15450/89, 18 Eur. H.R. Rep. 1 (1994) (deferring to the local courts on how to balance the interests in case involving a ban on advertising by attorneys); Handyside v. United Kingdom, App. No. 5493/72, 1 Eur. H.R. Rep. 737 (1976) (holding that Handyside’s free expression rights were not violated by the British government’s seizure of publications relating to pornography, masturbation, abortion, and drug use pursuant to the Obscene Publications Act of 1959, as the government was justified in protecting young people from being exposed to obscene material), discussed in Oetheimer, supra note 104, at 85; see Sakulin, supra note 111, at 149-80, 222-23 (discussing the European Court of Human Rights’ analysis); Verpeaux, supra note 104, at 29-31, 42, 46 (same).
they are more likely to find that trademark laws denying registration to offensive or deceptive marks, or trademark laws suppressing or punishing misleading commercial expression, are “necessary” to further these goals.

In the European Union, any free expression challenge to a trademark office’s refusal to register an offensive mark would be informed by the European Court of Human Rights’ case law interpreting the European Convention on Human Rights, but the Court of Justice of the European Union’s analysis would be conducted within the framework provided by the Charter of Fundamental Rights of the European Union.122 Article 11(1) of the Charter provides: “Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers.”123

Unlike the European Convention on Human Rights, the Charter does not include a specific exception to the free expression right to protect “morals” or the “reputation or rights of others.” Instead, Article 52(1) allows limits on all of the rights and freedoms discussed in the Charter:

Any limitation on the exercise of the rights and freedoms recognised by this Charter must be provided for by law and respect the essence of those rights and freedoms. Subject to the principle of proportionality, limitations may be made only if they are necessary and genuinely meet objectives of general


123. Id. art. 11(1). Article 11(2) of the Charter also provides: “The freedom and pluralism of the media shall be respected.” Id. art. 11(2).
interest recognised by the Union or the need to protect the rights and freedoms of others.”

In addition to citing Article 52(1), supporters of the ban on registration of marks that disparage certain members of the public will also likely note that Article 21(1) of the Charter bans discrimination: “Any discrimination based on any ground such as sex, race, colour, ethnic or social origin, genetic features, language, religion or belief, political or any other opinion, membership of a national minority, property, birth, disability, age or sexual orientation shall be prohibited.” Trademark owners seeking registration of offensive marks will likely argue that expression is different than discrimination, and note that Article 17(2) of the Charter declares that “[i]ntellectual property shall be protected,” and Article 16 recognizes the “freedom to conduct a business.” As of this writing, the Court of Justice of the European Union has not held that the right to freedom of expression requires governments in the European Union to register marks which are contrary to public policy or to accepted principles of morality.

While the right to freedom of expression (with its various limitations) is part of customary international law, there is no

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124. *Id.* art. 52(1).

125. *Id.* art. 21. This provision played a significant role in a copyright case involving a racist parody. Case C-201/13, Deckmyn v. Vandersteen, 2014 EUR-Lex CELEX LEXIS 62013CJ0201 (Sept. 2, 2014). In addition, Article 21(2) provides: “Within the scope of application of the Treaties and without prejudice to any of their specific provisions, any discrimination on grounds of nationality shall be prohibited.” Charter of Fundamental Rights of the European Union, *supra* note 122, art. 21(2).

126. *Id.* art. 17(2).

127. *Id.* art. 16.

128. See Audrey R. Chapman, *The Human Rights Implications of Intellectual Property Protection*, 5 J. Int’l. Econ. L. 861, 863 (2002); Christophe Geiger, *The Constitutional Dimension of Intellectual Property, in Intellectual Property and Human Rights, supra* note 11, at 101, 113 (noting “many authors consider that the [Universal Declaration of Human Rights] exerts a binding effect as customary international law”); see also Part III.B. (national constitutions). *But see* Paul H. Brietzke, *Insurgents in the ‘New’ International Law*, 13 Wis. Int’l L.J. 1, 35 n.73 (1994) (“[F]reedom of expression is widely recognized but it is not a rule of customary international law. It is one of the weakest rights in the Political Covenant (see arts. 4, 19-20): there was little political support for a stronger right, and the art. 19(3) permission to derogate from the right on grounds of national security or public order, health or morals permits an almost unlimited abuse.”); Hurst Hannum, *The Status of the Universal Declaration of Human Rights in National and International Law*, 25 Ga. J. Int’l & Comp. L. 287, 348 (1995/96) (“[T]he widespread restrictions on freedom of opinion and expression, set forth in article 19 of the [Universal Declaration of Human Rights], make it difficult to conclude that this provision is now part of customary international law, unless one accepts that the restrictions to freedom of expression which states believe are permissible can be so broad as to swallow the right itself.”). I am not aware of any scholarship arguing that customary international law recognizes a free speech right to register an offensive trademark. To the contrary, some commentators argue that there is a growing international consensus that hate speech that threatens unlawful harm or incites violence may be regulated without violating the right to freedom of expression. John C. Knechtle, *When to Regulate Hate Speech*, 110 Pa. St. L. Rev. 539 (2006).
evidence that customary international law requires nations to recognize a free speech right to register offensive trademarks. For over a century the parties to the Paris Convention explicitly agreed to give nations the right to refuse to register marks “contrary to morality or public order,” and the 1994 TRIPS Agreement did not change this rule. Moreover, regional and national trademark laws currently ban registration of such marks. Not only do certain nations—such as Canada—ban the use of offensive marks in connection with a business, but private parties also prohibit the use of offensive expression on their websites. For example, Facebook’s terms of service state that “You will not post content that: is hate speech, threatening, or pornographic; incites violence; or contains nudity or graphic or gratuitous violence.” While some nations—such as the United States—protect a free speech right to use profane language or expression that is racist, sexist, or otherwise offensive to a certain group, the international custom or practice is for nations to refuse to register offensive trademarks. Of course international human rights law does not prevent the United States or other nations from recognizing a free speech right to registration of offensive trademarks, and customary international law on this issue could change after Tam (although this is unlikely), but for now nations have discretion to deny registration to such marks under international law.

B. National Constitutions and the Right to Freedom of Expression

The right to freedom of expression is also explicitly recognized in national constitutions, including the constitutions of Canada,

129. See supra Part II.A.

130. See supra Part II.B and the sources in note 1.

131. Facebook Statement of Rights and Responsibilities, Section 3(7), https://www.facebook.com/legal/terms (Jan. 30, 2015) (last visited Oct. 19, 2016); id. Section 3(9) (“You will not use Facebook to do anything unlawful, misleading, malicious, or discriminatory.”). In addition, Professor Farley notes that “the Internet Corporation for Assigned Names and Numbers (ICANN) recently proscribed applications for new generic top-level domains (gTLDs) that are immoral or contrary to public order.” Farley, Registering Offense, supra note 11, at 118 (citing ICANN, gTLD Applicant Guidebook 1-42, 3-4, 3-6 (June 4, 2012), http://newgtlds.icann.org/en/applicants/agb/guidebook-full-04jun12-en.pdf); see generally Griffin M. Barnett, ICANN Morality Standards and the New gTLDs: A Comparative Analysis of Morality in International Trademark Law in the Internet Age, 103 TMR 1214 (2013).


133. See supra Parts II.A & II.B.
Germany, Japan, South Africa, and the United States. As with the human rights treaties, the free expression right is not absolute in constitutional laws and can be restricted in certain circumstances.

For example, in Canada the right to freedom of expression is set forth in Section 2(b) of the Canadian Charter of Rights and Freedoms: “Everyone has the following fundamental freedoms: . . . (b) freedom of thought, belief, opinion and expression, including freedom of the press and other media of communication.” Section 1 of the Canadian Constitution expressly allows restrictions on expression and other rights: “The Canadian Charter of Rights and Freedoms guarantees the rights and freedoms set out in it subject only to such reasonable limits prescribed by law as can be demonstrably justified in a free and democratic society.”

The Canadian Supreme Court has interpreted the right to freedom of expression to encompass most forms of expression, including commercial speech. If expression falls within the Court’s broad definition of expression and the purpose or effect of the government action is to restrict that expression, then the government must show that its regulation is justified under Section 1 of the Charter. The Canadian Supreme Court often defers to the legislature and concludes that Section 1 is satisfied, however, especially when laws restrict or proscribe expression to promote equality or multiculturalism. Among other things, the

134. Canadian Charter of Rights and Freedoms, Part I of the Constitution Act, 1982, being Schedule B to the Canada Act, 1982, c 11 s 2(b) (U.K.), reprinted in R.S.C. 1985, app II, no 44 sched B pt I s 2 (Can.); Grundgesetz [GG] [Basic Law] art. 5, translation at https://www.gesetze-im-internet.de/englisch_gg/englisch_gg.html#p0030 (Ger.); Nihonkoku Kenpō [Kenpō] [Constitution], art. 21, para. 1 (Japan); S. Afr. Const. 1996 § 16; U.S. Const. amend. I; see Krotoszynski, supra note 104, at 12, 26-51, 93-104, 139-45 (discussing the laws of the United States, Canada, Germany, and Japan); Verpeaux, supra note at 17 (“Freedom of expression is enshrined in the majority of European constitutions, sometimes with differences in wording and name that are not always due to translation problems.”). Other nations do not have a constitutional right to freedom of expression but still protect this right in legislation. See, e.g., New Zealand Bill of Rights Act 1990, s 14; Human Rights Act 1998, c. 42, § 12 (U.K.); id. sch. 1, pt. 1, art. 10; see Krotoszynski, supra note 104, at 183-213 (discussing freedom of expression in the United Kingdom).


136. Id. s 1.

137. Scassa, supra note 3, at 667-68 (discussing the cases by the Canadian Supreme Court).

138. Krotoszynski, supra note 104, at 26-92 (discussing freedom of expression law in Canada); Scassa, supra note 3, at 666-69 (discussing the right to freedom of expression in the trademark context).

139. Barendt, supra note 104, at 172-77 (discussing Canada’s hate speech laws); Krotoszynski, supra note 104, at 26 (“The Supreme Court of Canada has suggested that the constitutional values of pluralism and multiculturalism enjoy some degree of priority over the freedom of expression, at least when a legislative body acts to strike a balance favoring the equality project.”); Scassa, supra note 3, at 668; see also Moon, supra note 104; Sharpe & Roach, supra note 104. A court evaluating the constitutionality of Canada’s trademark law
Court has upheld laws criminalizing “promoting hatred against an identifiable group,” and a civil law that prohibits incitement to racial hatred. The Court also found that laws proscribing the possession, distribution, or sale of obscene materials and child pornography did not violate the right to freedom of expression in Canada.

Like Canada, Japan protects the right to freedom of expression in its constitution but this right is not unlimited. Section 1 of Article 21 of the Japanese Constitution provides: “Freedom of assembly and association as well as speech, press and all other forms of expression are guaranteed.” In addition, Section 2 of Article 21 states: “No censorship shall be maintained, nor shall the secrecy of any means of communication be violated.” Despite this constitutional guarantee of freedom of expression and prohibition of censorship, the Supreme Court of Japan usually defers to the legislature when it regulates expression, and has routinely upheld laws restricting or punishing expression to protect both public and private interests. Among other things,
the Court has upheld the constitutionality of laws that regulate political expression,147 commercial expression,148 criminal and civil defamation laws that protect the reputations of others,149 prohibitions on the manufacture and publication of child pornography,150 and a ban on obscene materials.151

147. Krotoszynski, supra note 104, at 146-47 (discussing Japan’s “severe restrictions that limit political speech incident to elections”).

148. Saikō Saibansho [Sup. Ct.] Feb. 15, 1961, 15 Saikō Saibansho Keiji Hanreishū [Keishū] 347 (Japan) [Ōno v. Japan—the Moxa Advertising Case] (upholding a regulation of nonmisleading commercial advertising by massage therapists), included in Itoh & Beer, supra note 146, at 183-223; see also Beer, supra note 104, at 367-69. Experts on constitutional law in Japan disagree on whether Japan protects commercial expression under the right to freedom of expression. Some say commercial expression is not protected in Japan, Krotoszynski, supra note 104, at 220, while others state that such expression is protected but to a lesser extent than political expression. Matsui, supra note 104, at 159 (noting the Supreme Court of Japan “has held there is no reason to deny fundamental human rights to corporations,” and has extended free expression protection to mass media organizations); id. at 196-97 (stating that many commentators believe political speech deserves stronger protection than commercial speech); Nobuyoshi Ashibe, Kenpō [Constitutional Law] 186 (5th ed. 2011) (commercial speech is protected in Japan, but to a lesser extent); cf. Chiteki Zaisan Kōtō Saibansho [Intellectual Prop. High Ct.] Mar. 19, 2008, 2007 (Ne) no. 10057, 1269 Hanrei Taimuzu [Hanta] 288 (Japan) (declining to consider the free expression argument of the defendant in a case involving the ELLE mark).

149. Matsui, supra note 104, at 202-03 (discussing cases upholding the constitutionality of Article 230 of the Criminal Code and Article 709 of the Civil Code).

150. Id. at 206 (discussing Article 7 of the Child Prostitution and Child Pornography Prohibition Act).

Unless a national constitution explicitly provides that the right to freedom of expression includes a right to register offensive language as a trademark, which is unlikely, any free speech right to trademark registration would need to be recognized (or created) by national courts interpreting the scope of their constitutional provisions protecting the right to freedom of expression. This is what the Federal Circuit did in *Tam* when it held that the Free Speech Clause in the First Amendment applies to Section 2(a) of the Lanham Act and government refusals to register trademarks that may disparage others.

Regardless of whether the U.S. Supreme Court affirms *Tam*, a U.S. court’s analysis of the constitutionality of Section 2(a) of the Lanham Act would only be relevant as persuasive authority in other countries when courts consider the constitutionality of trademark laws banning registration of offensive marks. While there are some similarities in the laws of nations that protect the right to freedom of expression, the differences can be significant. An identical regulation of expression may be constitutional in one nation and unconstitutional in another. For example, Germany has laws prohibiting Holocaust denials and other hate speech, but such regulations of political expression would be unconstitutional under the First Amendment in the United States.

**C. The Right to Freedom of Expression Should Not Include the Right to Register Offensive Language as a Trademark and Obtain Trademark Protection in that Language**

As noted by commentators, over-expansive government regulations of trademarks can violate the right to freedom of expression in the United States and other countries. While

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152. See generally Barendt, *supra* note 104; Krotoszynski, *supra* note 104.

153. Barendt, *supra* note 104, at 172, 176-77, 180-01, 182-83 (discussing regulations of hate speech in Germany and the German Constitutional Court’s holding that it is constitutional to make Holocaust denial a criminal offense); Krotoszynski, *supra* note 104, at 93-138 (discussing German law).

154. Barendt, *supra* note 104, at 183 (noting the general consensus among scholars is that hate speech laws “would, and should, be struck down as incompatible with the First Amendment” because the expression—however unpleasant and offensive—is protected political speech unless it falls within the narrow category of fighting words).

human rights treaties and constitutional laws protecting freedom of expression do not explicitly recognize a free speech right to register an offensive mark, the U.S. Supreme Court and foreign courts could follow the approach of the Federal Circuit in Tam and recognize such a right. For the reasons set forth below, this path is not recommended. If courts want to allow registration and protection of offensive trademarks, they should justify this rule under a property rights rationale or other public policy unrelated to freedom of expression.156


156. Whether Tam, Pro-Football, or any other trademark owner have constitutionally-protected property rights in their marks is beyond the scope of this paper, and is not relevant to the issue of whether they have a free speech right to registration of an offensive trademark. For more on the topic of whether trademark rights should be regarded as property rights, see, e.g., Megan M. Carpenter, Trademarks and Human Rights: Oil and
Governments protect the right to freedom of expression for a number of reasons, including to aid in the discovery of truth via the marketplace of ideas, to further democratic self-governance, to promote individual autonomy, and to foster tolerance.\textsuperscript{157} Regardless of whether allowing the use of offensive language increases the free flow of expression, helps voters make informed decisions in elections, advances autonomy interests and self-fulfillment, or promotes tolerance, allowing the registration of offensive language as a trademark does not further these goals. The reason is that a trademark registration grants the trademark owner the exclusive nationwide right to use that language as a mark in connection with certain goods or services (with some limited exceptions), and infringement and dilution laws allow trademark owners to enjoin the expression of others and obtain monetary relief when their trademark rights are violated. While there are good public policy reasons to protect trademarks against unauthorized use by others in misleading commercial expression and prevent unfair competition by unscrupulous traders, the right to freedom of expression should not be invoked to justify trademark registration of a desired trademark because of the potential ability of the owner to use that right to suppress expression by others.

For example, in the United States a registered mark is presumed valid and can become incontestable in litigation (among other benefits), and thus may be more easily protected under infringement and dilution laws in the courts.\textsuperscript{158} Imported T-shirts, hats, or other goods displaying registered marks can be stopped at the border by customs agents, and seized or destroyed if they are deemed to be infringing or counterfeit. Registration of a trademark may also increase the effectiveness of demand letters sent to individuals or small companies, and help trademark owners convince social media sites, search engines, online stores, or other

Water—Or Chocolate and Peanut Butter, 99 TMR 892 (2009) (arguing that trademarks are property rights but such rights are not absolute); Anheuser-Busch Inc. v. Portugal, App. No. 73049/01, ¶¶ 72-78 (Eur. Ct. H.R. Jan. 11, 2007), http://www.echr.coe.int (in trademark dispute involving the mark “Budweiser” for beer, the European Court of Human Rights said that trademarks could be regarded as property rights for purposes of human rights analysis).

\textsuperscript{157} Chemerinsky, supra note 14, at 969-74. See also the sources in supra note 104.

\textsuperscript{158} See supra text accompanying note 22 (discussing the benefits of registration); 15 U.S.C. § 1125(c)(2)(A)(iv) (when “determining whether a mark possesses the requisite degree of recognition” to be a famous mark protected against dilution, one relevant factor is “whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register”); McCarthy, supra note 16, § 32:138 (discussing application of the Lanham Act rule that registration on the Principal Register “shall be prima facie evidence” of the validity of the registered mark, and noting the majority rule is that the prima facie effect of a registration shifts the burden of proof to the challenger; that party must prove the mark is invalid by a preponderance of the evidence); id. § 11:43 (discussing the significance and strength of the presumption of validity).
private parties hosting or distributing expression on the Internet to take down unauthorized uses of marks that allegedly violate trademark laws or the site’s terms of service. Recognizing a **free speech right** to register offensive language does not make sense because the government’s registration and protection of a trademark will likely chill use of the same words or symbols by others.

The free speech rationale for striking down the “may disparage” provision of Section 2(a) of the Lanham Act is to protect the right of people or companies to express themselves by securing a trademark registration for offensive language, and to reduce the chilling effect of government regulations on this type of expression. If Section 2(a) of the Lanham Act banned the use of language that is immoral, scandalous, or which may disparage others, this law would suppress and chill expression and would likely be found unconstitutional under U.S. law even if it only applied to commercial expression. But Section 2(a) does not restrict the use of offensive trademarks; it just bans the registration of such marks. This fact, combined with the fact that trademark infringement and dilution laws do suppress expression and have a chilling effect on the use of another’s trademark, is important when evaluating whether Section 2(a) and similar trademark laws violate the right to freedom of expression. Courts evaluating the constitutionality of these provisions should consider the free speech interests not just of parties claiming the right to secure a registration in offensive language, but also the free speech interests of others who may want to use that language.

In the United States, trademark infringement laws do not harm expressive values when they ban misleading uses of trademarks in commercial expression because misleading commercial speech is not protected expression under the First Amendment.

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159. Cf. Leah Chan Grinvald, *Shaming Trademark Bullies*, 2011 Wis. L. Rev. 625 (2011); Irina D. Manta, *Bearing Down on Trademark Bullies*, 22 Fordham Intell. Prop. Media & Ent. L.J. 853 (2012); Ramsey, *supra* note 19, at 857, 867-68 (discussing notice-and-takedown procedures of social media sites). Registration of a mark may also make it easier to prevent others from registering domain names that contain the registered mark, as the Trademark Clearinghouse mechanism of Internet Corporation for Assigned Names and Numbers (ICANN) allows rights holders who register their marks with the Trademark Clearinghouse to obtain access to Sunrise registration with new generic top-level domain (gTLD) registries and notification from the Clearinghouse when a domain name matching the mark is registered. Trademark Clearinghouse ICANN New gTLDs, *Understanding the Trademark Clearinghouse*, https://newgtlds.icann.org/en/about/trademark-clearinghouse (last visited Oct. 10, 2016). The Trademark Clearinghouse will accept and verify registered trademarks, marks protected by statute or treaty, court-validated marks, and other marks that meet the requirements of the Trademark Clearinghouse. Accepted Trademarks, http://www.trademark-clearinghouse.com/content/accepted-trademarks (last visited Oct. 10, 2016).

Amendment. If trademark offices only registered trademarks used in commercial contexts, and trademark laws only regulated misleading commercial expression, then the accused infringer’s free speech rights would not be harmed when the government suppressed or punished that person’s unauthorized use of another’s trademark.

The problem is that today U.S. trademark laws are also used to regulate noncommercial expression and commercial expression that is not misleading. Political messages used as trademarks in commerce in connection with political action committee services or the sale of T-shirts and other expressive merchandise are currently being registered in the United States. An example is presidential candidate Donald Trump’s trademark MAKE AMERICA GREAT AGAIN registered for political action committee services, fundraising in the field of politics, bumper stickers, stickers, advertising signs, printed publications, posters, pens, clothing, hats, campaign buttons, political campaign services, blogs and other online journals, social networking services, retail and online store services, and other goods and services.

In addition, the federal trademark infringement statutes do not explicitly require “commercial use” or “trademark use” of the mark for liability—they require use “in commerce” of the mark. U.S. courts have applied trademark infringement laws to uses of marks in expression that would likely not qualify as commercial speech under the U.S. Supreme Court’s First Amendment jurisprudence. For example, in a trademark dispute involving the registered service mark UNITED WE STAND AMERICA “initially used by the principal campaign committee for Ross Perot’s 1992 presidential campaign,” the Second Circuit enforced the infringement statute against another political organization.


162. See, e.g., MAKE AMERICA GREAT AGAIN, Registration No. 4,773,272 (“Political action committee services, namely, promoting public awareness of political issues” and “Fundraising in the field of politics”) (registered July 14, 2015 by Donald J. Trump and currently owned by Donald J. Trump for President, Inc.); MAKE AMERICA GREAT AGAIN, Registration No. 5,020,556 (various goods and services) (registered Aug. 16, 2016 by Donald J. Trump for President, Inc.).


164. See, e.g., People for the Ethical Treatment of Animals v. Doughney, 263 F.3d 359, 362 (4th Cir. 2001); United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc., 128 F.3d 86, 88 (2d Cir. 1997); Dr. Seuss Enters., L.P. v. Penguins Books USA, Inc., 109 F.3d 1394, 1396 (9th Cir. 1997); Anheuser-Busch, Inc. v. Balducci Pubns., 28 F.3d 769, 771-73 (8th Cir. 1994); Dallas Cowboys Cheerleaders, Inc. v. PussyCat Cinema, Ltd., 604 F.2d 200, 202 (2d Cir. 1979); SMJ Group, Inc. v. 417 Lafayette Rest. LLC, 439 F. Supp. 2d 281, 291 (S.D.N.Y. 2006); Planned Parenthood Fed’n of Am., Inc. v.ucci, 42 U.S.P.Q.2d 1430, 1440 (S.D.N.Y. 1997), aff’d, 152 F.3d 920 (2d Cir. 1998); Am. Dairy Queen Corp. v. New Line Prods., Inc., 35 F. Supp. 2d 727, 728 (D. Minn. 1998); see Ramsey, supra note 10, at 384, 395-404 (discussing how trademark regulations do not just apply to commercial speech).
using a similar name and held the “in commerce” language refers to the power of the U.S. Congress to regulate interstate commerce and does not require “commercial use” of the mark.\footnote{United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc., 128 F.3d 86, 88 (2d Cir. 1997); see also 15 U.S.C. § 1127 (“The word ‘commerce’ means all commerce which may lawfully be regulated by Congress.”). For more information about the “in commerce” language in the Lanham Act, see Graeme B. Dinwoodie & Mark D. Janis, \textit{Trademarks and Unfair Competition: Law and Policy} 247-49 (4th ed. 2014); Ramsey, \textit{supra} note 19, at 873-76; see also McCarthy, \textit{supra} note 16, § 23.11.50 (discussing whether “trademark use” of another’s mark or “use in commerce” as defined in Section 45 of the Lanham Act are required for infringement, and concluding there are no such requirements in the infringement statute). The UNITED WE STAND AMERICA mark was registered by United We Stand America, Inc. for “conducting voter registration drives, voter forums, polls and referendums in the field of public policy, for non-business, non-marketing purposes; and issues and candidate research activities and dissemination of information in the field of public policy.” UNITED WE STAND AMERICA, Registration No. 1,844,852 (cancelled).} It is not clear whether Congress intended to create a commercial use requirement for infringement liability, but trademark owners may point out that the trademark statute’s explicit exclusion of noncommercial use of a mark from dilution liability—but not infringement liability—suggests otherwise.\footnote{15 U.S.C. § 1125(c)(3)(C).} On the other hand, some U.S. appellate courts have interpreted the “in connection with any goods or services” language in the Lanham Act to require commercial use of the mark for infringement liability to protect expressive interests.\footnote{Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research, 527 F.3d 1045, 1051-53 (10th Cir. 2008) (quoting 15 U.S.C. § 1125(a)(1)); Bosley Med. Inst., Inc. v. Kremer, 403 F.3d 672, 676-77 (9th Cir. 2005); Taubman Co. v. Webfeats, 319 F.3d 770, 774-75, 778 (6th Cir. 2003).} In addition, claims of trademark infringement involving expressive uses of marks in artistic and literary works sold for profit are evaluated under a more stringent test in some circuits.\footnote{See, e.g., Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 900-02, 906-07 (9th Cir. 2002) (\textit{Barbie Girl} song). See \textit{infra} note 185 (discussing the Rogers balancing test).} As the U.S. Supreme Court has not yet addressed whether commercial use of the mark is required for infringement, an accused infringer may still be sued in a jurisdiction that extends the scope of trademark infringement law to uses of marks in noncommercial expression which is protected by the First Amendment.

U.S. federal trademark infringement laws have also been applied by courts to expression which would likely not qualify as misleading under the First Amendment jurisprudence of the U.S. Supreme Court. Infringement is no longer limited to a likelihood of confusion about the source of goods or services, and can be found where consumers are likely to be confused about affiliation, sponsorship, or consent.\footnote{15 U.S.C. § 1125(a)(1); Ramsey, \textit{supra} note 10, at 417-421; see generally McKenna & Lemley, \textit{supra} note 155.} For example, the Eighth Circuit held
that the “Mutant of Omaha” logo displayed on the front of T-shirts and other expressive merchandise infringed Mutual of Omaha’s trademarks.\footnote{Mut. of Omaha Ins. Co. v. Novak, 836 F.2d 397, 398 (8th Cir. 1987).} In addition, U.S. trademark laws prohibiting the dilution of famous marks in commercial expression do not require proof “of actual or likely confusion, of competition, or of actual economic injury.”\footnote{15 U.S.C. § 1125(c)(1).} It is not clear that trademark laws regulating such nonmisleading expression would survive constitutional scrutiny under the stringent test for content-based regulations of expression set forth in Reed and Sorrell.\footnote{See Reed v. Town of Gilbert, 576 U.S. __, 135 S. Ct. 2218, 2226-33 (2015) (“Content-based laws—those that target speech based on its communicative content—are presumptively unconstitutional and may be justified only if the government proves that they are narrowly tailored to serve compelling state interests.”); Sorrell v. IMS Health Inc., 564 U.S. 552, 565-67 (2011) (requiring heightened judicial scrutiny for content-based regulations when the government regulates speech because of disagreement with the message it conveys, and applying this rule to regulations of commercial expression that impose “more than an incidental burden on protected expression”); Retail Dig. Network, LLC v. Appelsmith, 810 F.3d 638, 648 (9th Cir. 2016) (“[W]e rule that Sorrell modified the Central Hudson test for laws burdening commercial speech. Under Sorrell, courts must first determine whether a challenged law burdening non-misleading commercial speech about legal goods or services is content- or speaker-based. If so, heightened judicial scrutiny is required.”). It is also not clear dilution laws would satisfy the intermediate scrutiny test for regulations of nonmisleading commercial expression set forth in Central Hudson. See Rebecca Tushnet, Truth and Advertising: The Lanham Act and Commercial Speech Doctrine, in Trademark Law and Theory, supra note 11, at 312-22; LaFrance, supra note 155, at 711; Paul Alan Levy, The Trademark Dilution Revision Act—A Consumer Perspective, 16 Fordham Intell. Prop. Media & Ent. L.J. 1189, 1192-93 (2006); Ramsey, supra note 10, at 425-27 & n. 269; see also Rebecca Tushnet, Gone in Sixty Milliseconds: Trademark Law and Cognitive Science, 86 Tex. L. Rev. 507 (2008). The Central Hudson test holds that a restriction on nonmisleading commercial speech is only constitutional if the law directly advances a substantial government interest and is no more extensive than necessary to serve the interest. Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y., 447 U.S. 557, 565-66 (1980).} Either these expansive trademark laws violate the right to freedom of expression, or the government has more leeway to regulate trademarks compared to other types of expression than the U.S. Supreme Court’s current First Amendment jurisprudence suggests.

Trademark laws do have some built-in free-speech safeguards.\footnote{For a discussion of U.S. trademark law, see generally Ramsey, supra note 10; Ramsey, First Amendment, supra note 155. For a discussion of international trademark laws and trademark laws of other countries, see generally Ramsey, Reconciling, supra note 9; Ramsey, Free Speech, supra note 9. See also the sources in supra note 155.} Most trademark statutes deny trademark protection to generic terms or descriptive language that lacks acquired distinctiveness.\footnote{See the sources in notes 1, 16, and 17.} Trademark offices also refuse to register informational or decorative subject matter and other marks which fail to function as a trademark, such as BLACK LIVES MATTER.
or I ♥ DC displayed on the front of clothing.\textsuperscript{175} In Europe, marks must be used “in the course of trade”—in a commercial context—for liability.\textsuperscript{176} Australia’s trademark statute requires an allegedly infringing mark to be used “as a trade mark” for liability and does not contain a cause of action for dilution.\textsuperscript{177}

In addition, some nations have statutory defenses for descriptive fair use;\textsuperscript{178} comparative advertising;\textsuperscript{179} parody, criticism, and commentary;\textsuperscript{180} news reporting and news


\textsuperscript{177} Trade Marks Act 1995 (Cth) s 120 (Austl.); Burrell & Handler, supra note 17, at 4-6, 369-92, 412-16.

\textsuperscript{178} E.g., 15 U.S.C. § 1115(b)(4) (affirmative defense for “use, otherwise than as a mark, of the party’s individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin”); 15 U.S.C. § 1125(c)(3)(A) (exclusion from dilution liability for descriptive fair use of a famous mark “other than as a designation of source for the person’s own goods or services”); EU Trade Mark Regulation, supra note 176, art. 12 (limitations on the effects of an EU trade mark); EU Trade Mark Directive, supra note 176, art. 14 (same).

\textsuperscript{179} E.g., 15 U.S.C. § 1125(c)(3)(A) (exclusion from dilution liability for nominative fair use of a famous mark “other than as a designation of source for the person’s own goods or services” including use in connection with “advertising or promotion that permits consumers to compare goods or services”); Trade Marks Act 1995 (Cth) s 122(1)(d) (Austl.) (stating there is no infringement of a registered mark when “the person uses the trade mark for the purposes of comparative advertising”); Burrell & Handler, supra note 17, at 427.

\textsuperscript{180} E.g., 15 U.S.C. § 1125(c)(3)(A) (exclusion from dilution liability for nominative fair use of a famous mark “other than as a designation of source for the person’s own goods or services” including use in connection with “identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark
commentary,181 and noncommercial use of another’s mark.182 Courts have also protected expressive values by interpreting the scope of trademark rights narrowly, such as by finding there is no likelihood of confusion or dilution when a trademark is used by a defendant in parody, criticism, or commentary, or when the defendant is not selling any goods or services.183 Courts also apply speech-protective trademark doctrines developed in the common law. Examples include the nominative fair use doctrine, which is applied when an accused infringer is using the mark to refer to the trademark owner,184 and the Rogers balancing test, used in trademark cases involving unauthorized use of another’s mark in the titles or content of artistic or literary expression.185

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182. E.g., 15 U.S.C. § 1125(c)(3)(C); see Radiance, 786 F.3d at 331-32 (holding this use of the NAACP mark was a noncommercial use of the mark); Smith v. Wal-Mart Stores, Inc., 537 F. Supp. 2d 1302 (N.D. Ga 2008) (holding that sale of parody T-shirts could qualify as noncommercial speech and be exempt from dilution claims); Lucasfilm Ltd. v. Media Mkts., 182 F. Supp. 2d 897 (N.D. Cal. 2002) (finding “Starballz” pornographic movie did not dilute the Star Wars mark because this parody was a noncommercial use of the mark).

183. E.g., Radiance, 786 F.3d at 321-24 (finding no trademark infringement liability because defendant did not use the NAACP’s mark “in connection with the sale, offering for sale, distribution, or advertising of any goods or services”); Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 260-63 (4th Cir. 2007) (finding no infringement or dilution based on sale of Chewy Vuiton dog toy parody of LOUIS VUITTON handbags); Lamparello v. Fulwell, 420 F.3d 309, 313-15 (4th Cir. 2005) (finding no infringement when Reverend Falwell’s trademark was used in the domain name of a website critical of him); Jordache Enters., Inc. v. Hogg Wyld, Ltd., 828 F.2d 1482 (10th Cir. 1987) (holding “Lardashe” parody of Jordache blue jeans did not infringe the JORDACHE mark); L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 29-34 (1st Cir. 1987) (holding “L.L. Bean’s Back-To-School-Sex-Catalog” parody did not violate L.L. Bean’s trademark rights); ProtectMarriage.com v. Courage Campaign, 680 F. Supp. 2d 1225 (E.D. Cal. 2010) (holding modified logo used on website that did not sell any products did not infringe plaintiff’s mark); Smith, 537 F. Supp. 2d 1302 (granting summary judgment after finding no infringement or dilution of Wal-Mart marks by critic who displayed the phrases Walocaust, Wal-Qaeda, and Freedom-Hater-Mart on parody T-shirts); see also Ramsey, supra note 10, at 447-50.


185. The Rogers balancing test requires courts to construe trademark law to apply “only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” Rogers v. Grimaldi, 875 F.2d 994, 999 (2d Cir. 1989). The Rogers balancing test provides that “[a]n artistic work’s use of a trademark that otherwise would violate the Lanham Act is not actionable unless the use of the mark has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless it explicitly misleads as to the source or the content of the work.” E.E.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1099 (9th Cir. 2008) (internal quotations omitted) (discussing the Rogers test). This test is currently applied in trademark disputes involving the unauthorized use of another’s mark in the title or content of an artistic or literary work.
Yet expression is still not adequately protected in United States trademark law. For example, the USPTO has registered descriptive terms that lack secondary meaning such as PARK ‘N FLY for airport parking services, and informational slogans such as IF YOU SEE SOMETHING, SAY SOMETHING for promoting public awareness of public safety and security issues. Moreover, after five years on the trademark register, such trademarks can become incontestable and no longer challenged on the ground that they lack distinctiveness. In addition, the U.S. statutory descriptive fair use defense to trademark infringement is limited—it only applies to words or symbols used otherwise than as a mark to describe the goods or services—and contains factual questions that often cannot be resolved on a motion to dismiss or motion for 

_E.g._, _Brown v. Elec. Arts, Inc._, 724 F.3d 1235, 1239-42 (9th Cir. 2013) (holding use of retired football player’s likeness in a video game did not violate Section 43(a)); _Mattel, Inc. v. MCA Records, Inc._, 296 F.3d 894, 900-02, 906-07 (9th Cir. 2002) (holding use of mark Barbie in title and content of _Barbie Girl_ song was not infringement); Univ. of Ala. Bd. of Trs. v. New Life Art, Inc., 683 F.3d 1266, 1276-79 (11th Cir. 2012) (holding university claiming trademark rights in football uniforms could not prevail in infringement action against artist who included uniforms in paintings of famous football scenes in the university’s history, and sold prints and calendars incorporating those paintings); E.S.S. _Entm’t 2000_, 332 F.3d 915, 924-37 (6th Cir. 2003) (finding no false endorsement when an artist included an image of Tiger Woods in a painting); _Mattel Inc. v. Walking Mt. Prods._, F.3d 792, 806-07 (9th Cir. 2003) (finding no infringement by photographer who included the Barbie doll in various poses in photographs); _Cliffs Notes, Inc. v. Bantam Doubleday Dell Pub’g Grp._, 886 F.2d 490, 493-97 (2d Cir. 1989) (finding no infringement when owner of the study guide CLIFFS NOTES brought infringement action against the publisher of “Spy Notes” parody); Twentieth Century Fox Television v. Empire Distribution, Inc., 161 F. Supp. 3d 902 (C.D. Cal. 2016) (finding no infringement based on use of EMPIRE mark in title of _Empire_ television show); Fortresses Grand Corp. v. Warner Bros. _Entm’t, Inc._, 947 F. Supp. 2d 922, 931-34 (N.D. Ind. 2013) (finding no infringement based on use of CLEAN SLATE mark in content of _Dark Knight Rises_ film); Novalogic, Inc. v. Activision Blizzard, 41 F. Supp. 3d 885, 897-904 (C.D. Cal. 2013) (finding no infringement when video game _Call of Duty_—_Modern Warfare 3_ used DELTA FORCE mark and logo); _Louis Vuitton Malletier S.A. v. Warner Bros. _Entm’t Inc._, 868 F. Supp. 2d 172, 177-84 (S.D.N.Y. 2012) (granting motion to dismiss of Warner Brothers in trademark infringement action by Louis Vuitton based on use of a bag similar to Louis Vuitton bag in the content of _The Hangover: Part II_ film).

186. _See generally_ Ramsey, _supra_ note 10.


summary judgment. For example, when the owner of the incontestable mark DELICIOUS for footwear sued Victoria’s Secret for infringement based on its display of the word “Delicious” on the front of a tank top, the Ninth Circuit held the descriptive fair use defense must be heard by a jury because there was a genuine issue of material fact as to whether Victoria’s Secret used “Delicious” as a mark and whether this word was used “only to describe” the company’s goods. The display of language on the front of clothing is usually not descriptive of the goods and may be classified as a trademark use since many trademark owners (including Victoria’s Secret) display their marks on the front of clothing and other expressive merchandise.

In addition, nominative fair use doctrine may help accused infringers in cases involving comparative advertising, parody, criticism, or commentary, but not if the defendant is using this expression because of its inherent meaning or to comment about society rather than to refer to the plaintiff. The Rogers balancing test is only relevant in cases involving the use of marks in the titles or content of artistic or literary works, and some courts do not apply the Rogers test if the expression is deemed to be commercial, such as an advertisement for a video game. There is no statutory exemption or defense in federal trademark infringement law for news reporting, news commentary, comparative advertising, or noncommercial or nontrademark use of a mark, and thus bloggers, competitors, T-shirt designers, humorists, and other people engaging in such expression may not be able to determine if a threatened infringement lawsuit will be successful. Even if the accused infringer would likely prevail on summary judgment or at trial, many individuals and small

189. 15 U.S.C. § 1115(b)(4); see, e.g., Fortune Dynamic, Inc. v. Victoria’s Secret Store Brand, 618 F.3d 1025, 1039-43 (9th Cir. 2010). Courts also send other trademark defenses to the jury rather than resolve them on summary judgment. See e.g., Parks v. LaFace Records, 329 F.3d 437, 448-59 (6th Cir. 2003) (in false endorsement dispute involving use of name of Rosa Parks in the title of a song, the court held the Rogers balancing test applied but reversed the district court’s finding of no infringement on summary judgment and remanded for a jury trial because the artistic relationship between the title and the content of the song was “open to reasonable debate”). On the other hand, some courts do resolve trademark cases before trial. See, e.g., Smith v. Wal-Mart Stores, Inc., 537 F. Supp. 2d 1302 (N.D. Ga 2008) (granting summary judgment to defendant on Wal-Mart’s infringement and dilution claims).

190. Fortune Dynamic, 618 F.3d at 1039-43.

191. Facenda v. N.F.L. Films, Inc., 542 F.3d 1007, 1015-18 (3d Cir. 2008) (in action for false endorsement based on use of a famous broadcaster’s voice in a commercial about the upcoming release of Madden NFL 2006, court held the advertisement was commercial speech and was not protected under the First Amendment).

192. There are some common law defenses to infringement available, such as for comparative advertising, see, e.g., Smith v. Chanel, Inc., 402 F.2d 562 (9th Cir. 1968) (competitor’s advertisement for imitation perfume), but accused infringers may not find out about them without consulting a trademark attorney.
businesses may not be able to afford to litigate a trademark dispute. Moreover, providers of services on the Internet may take down unauthorized uses of marks at the request of trademark owners to avoid liability without considering whether this use is infringing or allowed under trademark law.

An example may demonstrate why protection of trademark rights today is more likely to suppress and chill freedom of expression than the denial of a trademark registration. Trademark registration of offensive language is similar to the government granting the Ku Klux Klan ("KKK") a parade permit that enables it to not only express racist or anti-Semitic messages in a parade at a certain time and place, but also prevent other hate groups from expressing those exact same racist or anti-Semitic words or symbols in a parade on any day or in any location. Just as there is no free speech right to a parade permit that can be used to prevent others from using certain offensive language in a parade, it does not make sense to recognize a free speech right to trademark registration and protection of offensive language that could be used to stop infringing or diluting uses of that language in a slogan or displayed on a T-shirt or website. Under the Federal Circuit's reasoning in Tam, the KKK could obtain a trademark registration for certain racist words or symbols used as a mark in commerce in connection with political action committee services, blogs, social networking services, or the sale of T-shirts or bumper stickers, and prevent others from using the registered mark in the exact same way. Of course, the KKK would have to show that that the mark is distinctive—that consumers associate that language with the KKK's "goods" or "services"—and this accused infringer's use of the mark was likely to cause confusion, but it seems strange to interpret the Free Speech Clause in the First Amendment to give one entity a trademark right that can be used to suppress and punish other people's expression.

193. Trump has a registration for these types of goods and services. See supra note 162 (discussing the MAKE AMERICA GREAT AGAIN trademark registrations).

194. The KKK would not need to show likelihood of confusion about the source of the goods; a likelihood of confusion about affiliation, sponsorship or consent is sufficient. Moreover, the statute does not explicitly require the KKK to prove commercial use or a trademark use of the mark for infringement liability. If the mark becomes famous, a dilution claim may also be available regardless of whether this use of the mark is confusing or competed with the KKK's goods or services. The descriptive fair use defense would not apply here for T-shirts and other expressive merchandise since the offensive words do not describe the clothing. Nominative fair use doctrine is irrelevant since the accused infringer is likely not using the offensive language to refer to the KKK. This is not comparative advertising. While the Rogers balancing test would apply to use of the offensive mark in the title or content of films, songs, video games, books, and other artistic or literary works sold by an accused infringer, it may not apply to expression on T-shirts and other merchandise unless a court deems the expression to be artistic or literary.

195. Cf. Griffiths, supra note 11, at 328-33 (arguing that the right to freedom of expression is not implicated by the European Union trademark law banning registration of
These potential conflicts of trademark rights and free speech rights do not just arise in trademark disputes involving offensive trademarks, but they are important because Pro-Football, Tam, and their supporters are arguing that trademark owners have a free speech right to a registration which helps them enforce trademark rights against others. If the offensive trademark provisions in Section 2(a) do not adequately protect the property rights invested in a mark or do not benefit society overall, they should be repealed by Congress for these reasons, but not because the right to freedom of expression compels such a result. Expression will be chilled regardless of whether the government denies registrations for offensive marks or grants registrations for such marks. The main difference is that the law denying registration may affect one person’s decision to use the offensive mark, while the law granting registration may chill the expression of everyone else who also wants to use that language in the marketplace. If a trademark law bans registration of offensive language but still allows use of this expression, courts evaluating the constitutionality of the trademark law should think carefully about deferring to the legislature on the social utility of this law. If the legislature is democratically elected, it may be in a better position than a judge (or group of judges) to weigh the various public and private interests implicated by that trademark law that bans registration of offensive marks.

Should we recognize a free speech right to trademark registration and protection of offensive marks if the government disapproves of the message conveyed by the trademark and wants to discourage its use in the marketplace to protect morality and the public? Some scholars believe that freedom of expression is implicated whenever expression “is regulated because of a message that the regulator wishes to suppress, alter, or otherwise affect.” 196 The Federal Circuit in Tam claimed that Section 2(a) is an unconstitutional content-based law because the government wants to discourage the use of offensive language as a trademark and encourage the selection of non-offensive trademarks. 197 Yet it is marks contrary to morality and public order since the law does not suppress expression, and noting that offensive trademark laws would satisfy constitutional balancing in Europe because other social values usually prevail over free expression rights in Europe; Sakulin, supra note 111, at 21 (arguing that “[t]here is a severe dogmatic problem when assuming that the grant, refusal, or limitation of trademark rights may impair the right to freedom of expression of the relevant trademark right holder” because (1) the right holder can still use the sign in trade and (2) a trademark right is the “antithesis of freedom of expression” since it allows the right holder to prevent others from using the sign).

196. Alexander, supra note 104, at 55; id. at 9 (arguing that freedom of expression is implicated whenever expression “is suppressed or penalized for the purpose of preventing a message from being received”).

clear from the Lanham Act that the government also wants to discourage the use in commerce of language that infringes or dilutes the trademarks of others, and encourage the use of distinctive words or symbols as trademarks rather than generic or descriptive terms. Does that mean all of these content-based trademark laws automatically violate the right to freedom of expression or are subject to strict scrutiny analysis regardless of whether the law suppresses or punishes expression, or whether it is regulating commercial or noncommercial expression? The constitutional analysis by the Federal Circuit in *Tam* suggests this is the correct approach for the disparagement provision in Section 2(a). The court did not discuss whether its free speech analysis in *Tam* should be applied to other provisions of the trademark laws, including laws that ban and punish infringement and dilution of trademarks, and laws denying registration to other subject matter such as generic and descriptive terms.

Critics of the immoral, scandalous, or “may disparage” language of Section 2(a) may argue the constitutional analysis should be different since that provision is focused on morality concerns and the harm to people or groups targeted by the expression, while the provisions on infringement, dilution, distinctiveness, and generic and descriptive terms further trademark law’s goal of helping consumers identify and distinguish among competing goods or services advertised and sold in commerce. Regardless of the government’s reasons for enacting all of these trademark laws, focusing the constitutional analysis on the purpose of the government in regulating the expression is problematic in the trademark context, and would not further the various justifications for protecting the right to freedom of expression. Such a focus ignores the fact that granting a trademark registration in offensive language and protecting that trademark right against others could eventually result in the suppression and punishment of the *exact same messages* of others under trademark infringement or dilution laws.

Moreover, recent U.S. Supreme Court decisions suggest that the focus should not be on the government’s stated purpose for the law. Per the Court in *Reed*, “A law that is content based on its face is subject to strict scrutiny regardless of the government’s benign motive, content-neutral justification, or lack of ‘animus toward the ideas contained’ in the regulated speech.” Yet a content-based

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198. *See infra* Part IV.A.6.b for a discussion of the difference between content-neutral and content-based regulations.


200. *But see* Grynberg, *supra* note 35 (arguing that the disparagement provision in Section 2(a) can be justified on the ground that disparaging marks do not function effectively as trademarks).

trademark law need not be subject to strict scrutiny analysis in the United States if that law does not suppress or punish expression, or cause other actionable harm to the right to freedom of expression. Such a law does not implicate the First Amendment, as explained next.

**IV. DOES A TRADEMARK LAW REGULATING OFFENSIVE LANGUAGE SATISFY ALL THE ELEMENTS OF A FREE SPEECH VIOLATION?**

Courts and scholars disagree on whether trademark laws banning registration of offensive marks violate the right to freedom of expression, and often they do not engage in this analysis in a systematic manner or correctly evaluate all of the issues that may arise under that country’s free speech jurisprudence.202 Below, this Part provides a framework of free expression issues to consider in the trademark law context, with a focus on whether there is a free speech right in the United States to registration and protection of trademark rights in an offensive mark.

A government or private party accused of violating the right to freedom of expression in a trademark dispute may argue the free expression right in a constitution, human rights treaty, or other law is not violated by that nation’s trademark law because under that country’s laws (1) trademark disputes are between private parties (i.e., there is no government action);203 (2) there is no suppression or punishment of expression, or other actionable harm to freedom of expression, in this trademark dispute;204 (3) trademarks do not qualify as protected “expression;”205 (4) this


204. See, e.g., In re McGinley, 660 F.2d 481, 484 (C.C.P.A. 1981). This issue is discussed *infra* Part IV.A.2.

205. In the United States, some courts explicitly or implicitly argue that certain uses of a mark which are actionable under trademark infringement laws do not qualify as First Amendment “speech” because the expression is used to identify the source of a product rather than communicate a message. E.g., SMJ Grp. v. 417 Lafayette Rest. LLC, 439 F. Supp. 2d 281, 291 (S.D.N.Y. 2006); Gucci Am., Inc. v. Hall & Assocs., 135 F. Supp. 2d 409,
is speech of the government or a corporation rather than expression of an individual;206 (5) a categorical exclusion from free expression protection applies to this type of expression regulated by the trademark law;207 or (6) the law is subject to less rigorous scrutiny because the expression is commercial or the law is a content-neutral regulation of expression, and the law satisfies the relevant balancing test in national, regional, or international laws requiring protection of the right to freedom of expression.208

Several of these arguments were made by the government and judges in the trademark disputes involving the REDSKINS and THE SLANTS marks.209 As explained below, some of these

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418 (S.D.N.Y. 2001); Planned Parenthood Fed’n of Am., Inc. v. Bucci, 42 U.S.P.Q.2d 1430, 1440 (S.D.N.Y. 1997), aff’d, 152 F.3d 920 (2d Cir. 1998). This is not correct. See Ramsey, supra note 10, at 385, 409-12; infra Part IV.A.3.


207. While trademark infringement law primarily regulates misleading commercial expression, which is not protected expression, trademark laws also regulate noncommercial expression and commercial expression that is not misleading. See Ramsey, supra note 10, at 385, 414-21; see infra Part IV.A.5 & Part IV.A.6.a.


209. Examples of these arguments will be included below in the sections discussing these issues. The Federal Circuit also said that the uncertainty created by Section 2(a) “contributes significantly to the chilling effect on speech” and explained that “uncertainty of speech-affecting standards has long been recognized as a First Amendment problem” under overbreadth doctrine and “Fifth Amendment vagueness standards as they have been specifically applied in the First Amendment setting.” Tam, 808 F.3d at 1342 (citing Broadrick v. Oklahoma, 413 U.S. 601, 613, 615 (1973) (overbreadth doctrine); Reno v. ACLU, 521 U.S. 844 871-72 (1997) (discussing the chilling effect of vague laws); Village of Hoffman Estates v. Flipside, Hoffman Estates, Inc., 455 U.S. 489, 499 (1982) (noting “a more stringent vagueness test should apply” when the law interferes with the right of free speech); Fed. Commc’ns Comm’n v. Fox Television Stations, Inc., ___ U.S. ___, 132 S. Ct. 2307, 2317-18 (2012) (stating that the void for vagueness doctrine addresses due process concerns)). As several trademark laws are vague and not narrowly tailored to achieve their goals, Tushnet, supra note 11, at 35-38; see also Graeme B Dinwoodie, Lewis & Clark Law School Ninth Distinguished IP Lecture: Developing Defenses in Trademark Law, 13 Lewis &
arguments are incorrect under U.S. free speech law as applied to Section 2(a) of the Lanham Act, but they may be correct in other trademark contexts and in other jurisdictions. If just one of these arguments is correct (e.g., there is no suppression or punishment of expression, or other actionable harm to expression), then the trademark law may not implicate the right to freedom of expression in that country; in such a situation, all the elements of a “free speech violation” are not satisfied.

When determining whether a trademark law conflicts with the right to freedom of expression in a country, courts should first determine the “elements” that must be satisfied for there to be a free speech violation under that nation’s constitution, human rights treaties, or other laws protecting the right to freedom of expression. Second, courts should determine whether all of these elements of a free speech violation in that country are established, with the burden of proof resting on the government or the private party who is using trademark law to allegedly violate the right to freedom of expression. Just like the elements of a cause of action for trademark infringement, if any of these elements of a free speech violation is missing, then the trademark law does not violate the free expression right under the laws of that country. Admittedly, this proposed framework for evaluating the constitutionality of a trademark law oversimplifies several complicated doctrines in freedom of expression law, and it focuses on U.S. free speech doctrine. In addition, the framework will not apply in constitutional analysis of other laws which require consideration of different issues. Nevertheless, in trademark disputes these issues have all been raised (but usually not all in the same opinion, brief, or law review article), and it is helpful to consider each issue in an organized and comprehensive manner.

Clark L. Rev. 99, 115-17, 122 (2009); Tushnet, Gone, supra note 172 (discussing dilution laws), it is unlikely the U.S. Supreme Court will find Section 2(a) unconstitutional solely on this basis since this reasoning might require the invalidation of other trademark laws that are vague and overbroad. The chilling effect of Section 2(a) is discussed infra Part IV.A.2.

210. This test assumes the court has already determined that the government has an obligation under a constitution, human rights treaty, or other law to protect the right to freedom of expression. See supra Part III.A & B.

211. See Sorrell v. IMS Health Inc., 564 U.S. 552, 567 (2011) (noting the government has the burden to show the law is consistent with the First Amendment); Edenfield v. Fane, 507 U.S. 761, 768-71 (1993); Zauderer v. Office of Disciplinary Counsel of the Supreme Court of Ohio, 471 U.S. 626, 646 (1985) (stating “the free flow of commercial information is valuable enough to justify imposing on would-be regulators the costs of distinguishing the truthful from the false, the helpful from the misleading, and the harmless from the harmful”); see also Ramsey, supra note 10, at 421 (stating that “the burden of proof on the misleading or commercial nature of the speech should remain with the trademark holder or the government”).

While some commentators have argued that U.S. courts should subject trademark laws to more First Amendment scrutiny, courts generally do not engage in constitutional analysis of trademark laws.\textsuperscript{213} Instead of applying strict scrutiny or intermediate scrutiny analysis, U.S. courts usually protect expressive values in trademark cases by interpreting the statute in speech-protective ways or creating speech-protective trademark rules in the common law, such as a commercial use requirement for infringement liability.\textsuperscript{214} This approach of avoiding constitutional analysis of trademark laws was abruptly changed when the Federal Circuit held in \textit{Tam} that Section 2(a) is unconstitutional under the First Amendment. This decision may lead courts to analyze the constitutionality of other trademark laws and also find them unconstitutional.

Below, this Part first sets forth a framework of issues for courts to consider if they are asked to evaluate whether a trademark law violates the right to freedom of expression, with a focus on U.S. law and Section 2(a) of the Lanham Act. Next this Part argues that the constitutional analysis may differ if a government enacts a law denying registration or protection of a copyright in offensive expression.

\textbf{A. Potential Elements of a Free Speech Violation in Trademark Disputes}

The elements for a violation of the right to freedom of expression by a trademark law in a country will depend on the content and scope of that country’s trademark and free expression laws. Below are six possible elements of a free speech violation in a trademark dispute; they all contain issues to consider in the United States, and many will also be relevant in other countries. For example, under the proposed framework, the elements of a free speech violation in a trademark dispute in the United States are: (1) government action; (2) suppression or punishment of expression, or some other actionable harm to expression; (3) this use of the trademark qualifies as expression; (4) this is expression of an individual or non-government entity, rather than government speech; (5) this expression is not categorically excluded from protection; and (6) the trademark law does not satisfy constitutional scrutiny.

In trademark disputes in the United States involving enforcement of trademark rights against others accused of


\textsuperscript{214} Ramsey, \textit{supra} note 10, at 447-50, 454-57.
infringement, the first four elements of a free speech violation are usually satisfied: (1) there is government action in the form of trademark laws or court orders; (2) there is suppression or punishment of this use of another’s trademark with injunctions, monetary relief, or other penalties; (3) the defendant’s use of the trademark constitutes expression (i.e., it communicates the source or quality of the goods or services, or other information or ideas); and (4) the defendant is typically an individual or non-government entity. Yet, even if the right to freedom of expression is implicated by a trademark law (i.e., elements 1-4 are satisfied), the law does not violate the free expression right if (5) the law regulates expression that is categorically refused protection under the First Amendment, such as misleading commercial expression. An example is when courts apply trademark infringement law to stop or punish a competitor’s misleading use of a trademark to sell commercial products. The government also does not violate the right to freedom of expression if (6) the trademark law satisfies constitutional scrutiny. For example, a trademark infringement law banning the misleading use of the marks of political or religious groups to cause confusion about the source of free noncommercial goods or services could arguably satisfy strict scrutiny analysis under the U.S. Constitution even though the law regulates noncommercial use of another’s mark.215

On the other hand, the free speech right may be violated by a trademark law in the United States if (1) the government suppresses or punishes (3) the expression (4) of an individual or non-government entity, and (5) this is noncommercial expression or nonmisleading commercial expression (which is not categorically excluded from free speech protection in the United States) and (6) the trademark law does not survive constitutional scrutiny. An example would be a court order in trademark litigation that enjoins noncommercial use of another’s mark in a domain name linked to a website that contains criticism or parody of that trademark owner, and which does not contain any misleading expression.216 While the court may believe this use of the mark causes a likelihood of confusion regarding whether the trademark owner consented to its use or is affiliated with the website, a government injunction banning further use of the


216. In one case with similar facts the Fourth Circuit held that an arguably noncommercial use of a trademark was commercial expression and affirmed the district court’s finding of trademark infringement and other trademark violations. See People for the Ethical Treatment of Animals v. Doughney, 263 F.3d 359, 362-63 (4th Cir. 2001) (affirming summary judgment for plaintiff where defendant used the PETA mark in the domain name peta.org that linked to a “People Eating Tasty Animals” website parody; PETA asked the court to enjoin use of the PETA mark and order the transfer of the domain name to PETA).
trademark owner’s mark by that individual implicates the free speech right and is unlikely to survive the strict constitutional scrutiny used for content-based regulations of nonmisleading expression.\(^\text{217}\)

As discussed in more detail below, when Section 2(a) of the Lanham Act bans the registration of a mark that is immoral or scandalous or which may disparage others, there is government action (element 1), the trademarks qualify as expression (element 3), the law applies to the expression of people and non-government entities (element 4), and most of the offensive language banned from registration under Section 2(a) is not categorically excluded from protection under the right to freedom of expression in the United States (element 5). This article argues, however, that the offensive mark provisions of Section 2(a) do not implicate the First Amendment because Section 2(a) does not suppress or punish the trademark owner’s use of the expression, or cause some other actionable harm to expression (element 2). If the U.S. Supreme Court disagrees, and finds the First Amendment is implicated by this law, the Court should subject this content-based law regulating commercial and noncommercial expression to strict constitutional scrutiny (element 6), which is usually fatal,\(^\text{218}\) or explain why the constitutionality of trademark laws should not be evaluated under the Court’s traditional First Amendment jurisprudence.


When determining whether a trademark law implicates or violates the right to freedom of expression, courts may want to first focus on who is regulating the expression. In the United States, the free speech guarantee “restricts only government action, not action by private employers, property owners, householders, churches, universities, and the like.”\(^\text{219}\) Most other countries also require government action (also known as “state action”) for a free speech violation, although there are some exceptions, such as Germany.\(^\text{220}\) If the law in a country provides that the right to

\(^{217}\) Reed v. Town of Gilbert, 576 U.S. __, 135 S. Ct. 2218, 2226-33 (2015); Sorrell v. IMS Health Inc., 564 U.S. 552, 565-75 (2011); see also Ramsey, supra note 10, at 384-85, 424-25, 445; id. at 417-21 (discussing how trademark infringement law is applied to commercial uses of trademarks that would not qualify as misleading under the U.S. Supreme Court’s free speech jurisprudence).

\(^{218}\) Reed, 135 S. Ct. at 2226-33; In re Tam, 808 F.3d at 1334-37.

\(^{219}\) Volokh, supra note 132, at 409; see also Krotoszynski, supra note 104, at 98-102.

\(^{220}\) Krotoszynski, supra note 104, at 99 (citing Dieter Grimm, Human Rights and Judicial Review in Germany, in Human Rights and Judicial Review: A Comparative Perspective 276 (David M. Beatty, ed. 1994); Dieter Grimm, Judicial Activism, in Judges in Contemporary Democracy: An International Conversation 17, 21 (Robert Badinter &
freedom of expression is not implicated without some sort of involvement by the government—such as a statute that prohibits or punishes expression, or a court order enforcing such a law—then the first element of a free speech violation in a trademark dispute is government action.

Government action in trademark enforcement. There is government action in trademark disputes when governments protect trademark rights. This would include the legislature’s enactment of a statute banning the use of counterfeit marks or the unauthorized use of another’s trademark which may infringe or dilute that mark. There is also government action when a court enjoins the use of that trademark with an injunction, or punishes the defendant’s use of the mark with jail time, fines, or an award of monetary relief. In the United States, it does not matter that civil litigation involving expression is initiated by a private party rather than the government; if the government is involved in enforcing the private party’s rights and it suppresses or punishes expression to protect those rights, then there is government action and this element of a free speech violation is satisfied.

Government enforcement of private trademark rights therefore

Stephen Breyer eds. 2004)); Mark Tushnet, Weak Courts, Strong Rights: Judicial Review and Social Welfare Rights in Comparative Constitutional Law (2008) (discussing the law in Canada and Germany); Mark Tushnet, The Issue of State Action/Horizontal Effect in Comparative Constitutional Law, 1 Int’l J. Const. L. 79 (2003) (discussing the law in Canada, Czech Republic, Germany, South Africa, and the United States); see also Griffith, supra note 11, at 323 (noting the European Convention on Human Rights binds only contracting state parties); Sakulin, supra note 111, 111-12 (same). For example, Japan has a state action requirement. Krotoszynski, supra note 104, at 142. Yet, as noted by Professor Krotoszynski, “[t]o the extent freedom of speech faces serious threats in Japan, those threats are much more a function of privately imposed constraints than of official government repression or censorship . . . It is not always the government that is the enemy of freedom of expression; corporations, churches, and communities can be far more effective at stifling dissent than bureaucrats and misguided police chiefs.” Id. at 141 (internal citations omitted).

221. Chemerinsky, supra note 14, at 1015-16 (noting statutes prohibiting speech and authorizing criminal punishment must satisfy constitutional scrutiny, and also court orders and licensing systems precluding speech without a permit); see also id. at 532-42 (explaining that the “state action” doctrine applies to governments at all levels, including federal, state, and local, and to the conduct of government officers in all branches, including legislative, judicial, and administrative).

222. Note the focus of this element is on the word “government”—who is regulating the expression—not on the word “action”; in the proposed framework, the action by that party is the second element of a free speech violation, which focuses on what that party does (e.g., suppression, punishment, denial of a benefit due to expression) or does not do (e.g., registration) to the expression. In addition, the expression of the government—government speech—is addressed in the fourth element of the framework.

223. See N.Y. Times v. Sullivan, 376 U.S. 254, 265 (1964) (finding state action in a civil libel lawsuit between private parties where the Alabama court enforced a law which imposed invalid restrictions on the freedoms of speech and the press, and holding that “[t]he test is not the form in which state power has been applied but, whatever the form, whether such power has in fact been exercised”).
qualifies as state action in the United States. On the other hand, if a nation believes that the right to freedom of expression is a negative liberty that only prohibits government censorship and punishment of expression, then a court may find there is no free speech violation if a private party enforces its trademarks in court against another private party and obtains an injunction and damages.

**Government action in trademark registration.** A government statute or regulation prohibiting a trademark office from registering an offensive trademark is also government action. In addition, there is government action when the trademark office denies registration of offensive language, or a court orders cancellation of a registration for such a mark. In the trademark cases involving the REDSKINS, THE SLANTS, and FUCT trademarks there is government action, and therefore courts must evaluate the other elements of a free speech violation to determine if the law is constitutional.

**Regulation of trademarks by private parties.** A government action element of a free speech violation would not be met if private parties restrict expression in trademark disputes without the involvement of the government. For example, Facebook bans infringing use of a trademark in its terms of service and has removed posts containing unauthorized use of a trademark after receiving complaints about trademark violations from trademark owners. This conduct by a private party suppresses expression, but it is not government action (and it may be justified if this use of the mark is infringing). If there is no infringing use of the mark and the complainant is a trademark bully who is abusing Facebook’s notice-and-takedown system to stop criticism or parody of the company, then removal of the post by Facebook may harm the free flow of information and ideas but it does not constitute a free speech violation in a country that has a government action requirement. If someone complains in litigation about this private suppression of expression that incorporates another’s trademark, and a court upholds the private party’s contractual right to remove expression, this involvement by the

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225. Facebook Statement of Rights and Responsibilities, Section 4(1) (Jan. 30, 2015) (last visited Oct. 19, 2016), https://www.facebook.com/terms (Facebook reserves the right to remove or reclaim a username if “a trademark owner complains about a username that does not closely relate to a user’s actual name”); id. Section 5(1) (“You will not post content or take any action on Facebook that infringes or violates someone else’s rights or otherwise violates the law.”); id. Section 5(5) (“If you repeatedly infringe other people’s intellectual property rights, we will disable your account when appropriate.”); Ramsey, supra note 19, at 852-54, 867-68 (discussing trademark disputes on social media sites and their terms of service banning infringement).
government may qualify as state action depending on the constitutional laws of that country.\textsuperscript{226}

2. Suppression, Punishment, and Other Actionable Harms to Expression: How Does the Regulation Harm Expression?

When determining whether a trademark law violates the right to freedom of expression, the second issue courts should focus on is how this regulation harms expression. If a country’s free speech doctrine states that the right to freedom of expression may be implicated by suppression or punishment of expression and other types of regulations that harm expression without banning or penalizing it (such as a law that compels expression), then the second element of a free speech violation in that country would include suppression or punishment of expression and these other types of harms. In this article, the phrase “suppression” is used to refer to a court injunction or law that is a prior restraint on expression,\textsuperscript{227} and “punishment” refers to jail time or a court order requiring payment of a fine or an award of monetary remedies. As explained below, a denial of a benefit (such as a tax exemption, monetary subsidy, or trademark registration) due to the content of expression is a different type of harm compared to suppression or punishment of expression as those terms are used in the article.

**Suppression or punishment of the use of another’s trademark.** The “harm to expression” element of a free speech violation would be satisfied in a trademark enforcement dispute where the government suppressed or punished the infringing, diluting, or counterfeit use of another’s trademark.\textsuperscript{228} This includes

\textsuperscript{226} Cf. Shelley v. Kraemer, 334 U.S. 1 (1948) (holding that state court enforcement of racially restrictive covenants constituted state action and violated the Equal Protection Clause of the U.S. Constitution), discussed in Chemerinsky, supra note 14, at 552-53 (discussing the entanglement exception to the state action doctrine, which provides that “the Constitution applies if the government affirmatively authorizes, encourages, or facilitates private conduct that violates the Constitution” including judicial enforcement actions; he notes judges are government actors and judicial remedies are state action, but Shelley remains controversial because “ultimately everything can be made state action under it”).

\textsuperscript{227} Lemley & Volokh, supra note 155, at 216-24 (discussing prior restraint doctrine in the trademark context).

\textsuperscript{228} Injunctive relief is available in trademark disputes upon a finding of a trademark violation and a showing of irreparable harm. See Herb Reed Enters., LLC v. Florida Entm’t Mgmt. Inc., 736 F.3d. 1239, 1247-50 (9th Cir. 2013); see also Case C-487/07, L’Oréal v. Bellure, 2009 E.C.R. I-5185 (brand owners can seek injunctive relief for infringement in the online marketplace of eBay); Case C-278/08, BergSpechte v. Trekking, 2010 E.C.R. I-2517 (noting that the court may enjoin use of another’s mark in keyword advertising). In the United States, a few courts have considered whether certain injunctions in trademark disputes violate the right to freedom of expression. See, e.g., Nissan Motor Co. v. Nissan Computer Corp., 378 F.3d 1002, 1016 (9th Cir. 2004) (holding that a lower court’s injunction
a trademark statute that gives courts discretion to enjoin use of a trademark, award damages, or require jail or payment of a fine for a trademark violation. It also includes court orders enforcing these laws, such as an injunction prohibiting infringing or diluting use of the mark, or an award of money to the trademark owner.\(^{229}\) If the defendant’s use of the mark constitutes misleading commercial expression, then the trademark law would be constitutional in the United States under the fifth element of a free speech violation even though this second “harm to expression” element was satisfied.

**Suppression or punishment of the use of certain language as a trademark.** While Section 2(a) of the Lanham Act only bans the registration of offensive terms, Canada’s trademark law also prohibits the adoption or use in connection with a business of any scandalous, obscene, or immoral word or device “as a trademark or otherwise.”\(^{230}\) Thus this Canadian trademark law, and court enforcement of the law, would satisfy the “harm to expression” element of a free speech violation and require consideration of the other elements of a free speech violation in Canada.

**No suppression or punishment of expression upon denial of a trademark registration.** As noted in *McGinley*, and more recently by the Eastern District of Virginia in *Pro-Football* and the dissenting judges in *Tam*,\(^{231}\) Section 2(a)’s ban on registration of offensive expression does not suppress or punish that expression. The trademark owner can continue to use that language in commercial and noncommercial expression, and enforcement of the law does not result in a jail term, fines, or civil liability.

If a country requires suppression or punishment of expression for a free speech violation, then this element (element 2) is not satisfied by a law that only prohibits registration of an offensive trademark. In such circumstances there is no violation of the right to freedom of expression and further consideration of the constitutionality of the trademark law (element 6) is unnecessary;
the law does not implicate the right to freedom of expression.\textsuperscript{232} On the other hand, if a country’s free speech laws provide that harms to expression beyond suppression and punishment can implicate the right to freedom of expression, then courts must evaluate whether the law causes this harm to expression. In the United States, laws that do not ban or penalize expression may still be subject to constitutional scrutiny if the unconstitutional conditions doctrine applies, as discussed next.

**Unconstitutional conditions doctrine should not be relevant when the government refuses to register trademarks.** As explained by Professor Erwin Chemerinsky, “The unconstitutional conditions doctrine is the principle that the government cannot condition a benefit on the requirement that a person forgo a constitutional right.”\textsuperscript{233} For example, in the United States there is generally a First Amendment right to criticize the government,\textsuperscript{234} complain about your employer,\textsuperscript{235} engage in editorializing,\textsuperscript{236} lobby public officials,\textsuperscript{237} argue for reform of the law,\textsuperscript{238} and publish a religious magazine,\textsuperscript{239} among other things. If the government conditions receipt of a tax exemption, monetary subsidy (such as welfare benefits), or another government benefit based on a requirement that the person refrain from constitutionally-protected expression, this law may be subject to constitutional scrutiny under the unconstitutional conditions doctrine.\textsuperscript{240}

\textsuperscript{232.} Cf. Authors League of America, Inc. v. Oman, 790 F.2d 220, 222-23 (2d Cir. 1986) (holding the manufacturing clause of the Copyright Act which denies full copyright protection to works imported in violation of 17 U.S.C. § 601 (1985) did not implicate the First Amendment right to freedom of expression because the author can still distribute the work even if the author cannot receive copyright protection for it).


\textsuperscript{234.} Bd. of County Comm’rs v. Umbehr, 518 U.S. 668 (1996) (Board of County Commissioners terminated government contract in retaliation for independent contractor’s criticism of county and the board; Court held First Amendment applied and used the *Pickering* balancing test); Speiser v. Randall, 357 U.S. 513, 518-19 (1958).


\textsuperscript{240.} *Velazquez*, 531 U.S. 533 (restriction on the activities of lawyers receiving funds from the federal Legal Services Corporation); *Rosenberger*, 515 U.S. at 834 (state refusal to provide funds to a Christian student group that published a religious magazine); *League of Women Voters*, 468 U.S. 364 (federal statute prohibited noncommercial educational broadcasting station from engaging in editorializing if it received a grant from the Corporation for Public Broadcasting, even if it used non-federal money for the editorializing); *Sindermann*, 408 U.S. at 597 (denial of employment to professor because of his public criticism of the college’s policy); *Speiser*, 357 U.S. at 518-19 (California law conditioned receipt of a veterans’ property tax exemption on signing a declaration
Note, however, that there are exceptions to this rule. For example, if the government is providing federal funds to support a particular government program, such as the National Endowment for the Arts’ funding of artists, the government can make decisions on what to fund based on the content of the expression, although it cannot engage in viewpoint discrimination. As explained by the U.S. Supreme Court, the Spending Clause of the U.S. Constitution gives Congress “the authority to impose limits on the use of [government] funds to ensure they are used in the manner Congress intends,” including by attaching “conditions that define the limits of the government spending program—those that specify the activities that Congress wants to subsidize.” However, Congress cannot attach “conditions that seek to leverage funding to regulate speech outside the contours of the program itself,” such as by conditioning receipt of funding to help combat the spread of HIV/AIDS to organizations that have policies affirmatively opposing prostitution and sex trafficking.

Citing this First Amendment doctrine, the Federal Circuit in Tam held that Section 2(a) of the Lanham Act imposes an unconstitutional condition on trademark owners when it denies the benefits of trademark registration to offensive trademarks. Per disavowing a belief in overthrowing the U.S. government by force or violence); see also Chemerinsky, supra note 14, at 582-83, 1028-33 (discussing the unconstitutional conditions doctrine and these cases). Note some of these cases do not expressly invoke the unconstitutional condition doctrine but commentators believe the Court applied the doctrine in these cases. Id.

241. Rust v. Sullivan, 500 U.S. 173, 192-200 (1991) (declining to apply unconstitutional conditions doctrine to federal regulation that prohibited recipients of federal funds for family planning services from providing abortion-related counseling because the government distributed those funds to promote the conveying of a particular message); Regan, 461 U.S. at 546, 548 (The Court upheld a provision of the federal tax law that conditioned tax-exempt status on the requirement that the organization not participate in lobbying or partisan political activities, and noted there was no attempt to suppress ideas. Per the Court, “Congress has not infringed any First Amendment rights or regulated any First Amendment activity. Congress has simply chosen not to pay for TWR’s lobbying.”). Chemerinsky argues these cases are inconsistent with the Court’s doctrine. He believes these cases may reflect implicit balancing by the Court with the Justices weighing the burden on speech imposed by a condition against the government’s justifications for the requirement, or may simply turn on the views of the Justices in the particular cases. Chemerinsky, supra note 14, at 1029-33.


243. Agency for Int’l Dev. v. All. for Open Soc’y Int’l, Inc., 133 S. Ct. 2321, 2328 (2013) (citing Rust, 500 U.S. at 195 n.4); see also United States v. Am. Library Ass’n, 539 U.S. 194, 211-12 (2003) (plurality) (where the government conditioned public libraries’ receipt of federal money on their use of Internet filtering software, stating “when the Government appropriates public funds to establish a program it is entitled to define the limits of that program”) (quoting Rust, 500 U.S. at 194).

244. Id. at 2328.

245. Id. at 2330-31.
the court, the law discourages a trademark owner from using its desired mark because it cannot obtain a registration for it, and the premise “that denial of a benefit would chill exercise of the constitutional right” of freedom of expression “undergirds every unconstitutional conditions doctrine case.” The Federal Circuit rejected the arguments of the government and dissenting judges in Tam that Section 2(a) provides a government subsidy that is exempt from strict scrutiny analysis or application of the unconstitutional conditions doctrine.

I agree with the Federal Circuit that Section 2(a) is not a law providing a monetary subsidy, but disagree that the unconstitutional conditions doctrine should apply in the context of the government’s denial of a trademark registration. The reason is that Section 2(a) of the Lanham Act is substantially different from the laws in these other cases that invoke the unconstitutional conditions doctrine. The differences include (1) the condition imposed on the recipient of the benefit, and (2) the benefit sought by the party claiming a free speech violation.

First, Section 2(a) does not require the trademark owner to forgo its constitutionally-protected right to freedom of expression to receive this benefit of registration. The trademark owner can continue to use offensive language as a trademark or otherwise regardless of whether it also registers marks that meet the criteria of Section 2(a) of the Lanham Act. To qualify for registration, the mark must not be immoral, scandalous, or potentially disparaging, but this condition on registration of a mark (like the requirement that a mark not be generic or deceptive) is not a condition on the expression of the trademark owner. This is a critical fact that makes Section 2(a) so different from the other laws that required the recipient of a benefit to agree to not criticize the government, not engage in editorializing, not lobby public officials, or not argue for reform of the law. Put another way,
Section 2(a) is a restriction on the words that can be registered, and not on the words that can be used by the person who obtains the benefit of registration of a trademark that does not violate Section 2(a).

While the government may not want to expend government resources in registering offensive marks or appear to endorse the use of such marks, Section 2(a) is not like the laws in the federal funding cases—in which limits were imposed on the expression of recipients of the money—because Section 2(a) does not award public money to trademark owners (there is no disbursement of funds) and the law does not impose any limits on expression or compel private parties to engage in expression. Even if Section 2(a) imposes a “financial disincentive to the use of [offensive] marks in commercial communication,” or has a chilling effect on the use of offensive language as a mark, this is not due to any requirement to forgo constitutionally-protected expression. The Lanham Act’s prohibition on the registration of generic and deceptive terms also creates a financial disincentive to use such language as a mark and has similar chilling effects on use of the expression, but—like Section 2(a)—these laws do not ban the use of this language, nor do they ban any expression. The chilling effect of a law should not by itself be sufficient to make that law an unconstitutional condition on expression, especially when that law still allows use of the expression upon either receipt or denial of the benefit.

Second, the benefits of registration under the Lanham Act are valuable, but they are significantly dissimilar to the benefits in the cases that apply the unconstitutional conditions doctrine. There is no tax exemption, monetary subsidy, or similar government benefit at issue here. A person did not lose his job because of his expression. The Federal Circuit notes that “the scope of the subsidy cases has never been extended to a ‘benefit’ like recognition of legal rights in speakers against private interference.” True, but the U.S. Supreme Court has also not applied the unconstitutional conditions doctrine to trademark law or the grant of a private right to suppress and punish another’s...

254. *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981) (“We do not see this as an attempt to legislate morality, but, rather, a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government.”); see also *En Banc Brief for Appellee*, *supra* note 33, at 16, 21, 41, 43.

255. Thus it does not run afoul of the rule in *Agency for Int’l Dev. v. All. for Open Soc’y Int’l*, Inc., 133 S. Ct. 2321, 2328 (2013).

256. Lefstin, *supra* note 11, at 678, cited in *Tam*, 808 F.3d at 1341.

257. *Tam*, 808 F.3d at 1339-45.

258. See *supra* text accompanying note 22 (summary of benefits set forth in the *Tam* decision).

259. *Tam*, 808 F.3d at 1351.
expression that uses the same language as that private party. Unlike a trademark registration, a tax exemption or monetary subsidy does not give the recipient an exclusive nationwide right to use language as a mark for the registered goods or services, or to obtain the assistance of the government to restrict the importation of infringing or counterfeit goods that display that expression. When facts are not analogous, we should question whether a free speech doctrine created for one set of facts should apply in different circumstances.260

A refusal to register an offensive trademark is also not similar to a hypothetical law in which the government refuses to protect the real property rights of Pro-Football or Tam, or does not provide lights or police protection for their entertainment services, because they use marks that may disparage others.261 Unlike Section 2(a)’s regulation of what words can be registered as trademarks, such laws and actions have no nexus or connection to the offensive language. Moreover, such benefits—the enforcement of property rights in land against trespassers or the provision of lights or police protection during a football game or concert—do not give Pro-Football or Tam the exclusive nationwide right to stop others from using the words REDSKINS or THE SLANTS in the marketplace.

Courts should not extend the unconstitutional conditions doctrine to Section 2(a) because the justification for striking down laws that impose unconstitutional conditions on expression—reducing the law’s chilling effect on expression—does not apply in this context. Denial of a registration may actually decrease the chilling effect on speech since registration provides a presumption of validity of the mark, and others may refrain from using the mark due to the registration, the cost of litigation, and the uncertainty of whether a trademark lawsuit will be successful. Reasonable people may disagree on whether a mark is sufficiently distinctive or famous for protection, whether defendant’s unauthorized use of the mark infringes or dilutes that mark, or whether a defense applies. Regardless of whether a defendant’s use of a registered mark infringes or dilutes that mark, it seems odd to recognize a free speech right to suppress or punish the expression of others under the unconstitutional conditions

260. But cf. Ned Snow, Content-Based Copyright Denial, 90 Indiana L.J. 1473, 1490-97 (2015) (arguing that the unconstitutional conditions doctrine applies if an economic benefit is denied to a copyright owner, but concluding that a content-based copyright denial still does not violate the First Amendment).

261. Pro-Football’s brief filed in the Fourth Circuit said that denying a registration of a trademark is just like turning off the lights “at a Redskins night game because the government disfavors the name, and defend[ing] the action because the Redskins can still play in the dark.” Opening Brief of Appellant, Pro-Football, Inc. v. Blackhorse, No. 15-1874, at 5 (4th Cir. Oct. 30, 2015). The other examples were raised by people who commented on the paper.
doctrine. The U.S. Supreme Court should instead hold that the U.S. trademark law denying registration of immoral, scandalous, or potentially disparaging trademarks does not implicate the First Amendment because the trademark owner can still use the language claimed as a trademark in noncommercial and commercial expression, and no one is placed in jail or required to pay any money due to the use of this offensive expression.

If the Court finds Section 2(a) to be constitutional because it does not suppress or punish expression or cause other actionable harm to expression, critics may argue that the legislature could therefore enact a new law explicitly prohibiting registration of trademarks that are critical of the government. At first glance, such a law appears to be extremely problematic from a free expression perspective. Yet denying trademark registration to commentary critical of the U.S. government could actually increase the free flow of that expression. An example will illustrate this point.

Assume that the U.S. government believes that presidential candidate Donald Trump’s slogan MAKE AMERICA GREAT AGAIN suggests that the United States of America is not currently great, and decides to cancel the trademark registrations containing that phrase under the disparagement provision of Section 2(a), or a new law that bans registration of trademarks critical of the government. Will cancellation of this registration discourage Trump from using this phrase as a trademark on hats and T-shirts and encourage him to select another slogan that he can register? Maybe. But allowing the marks to remain on the trademark register will likely decrease the use of this expression in a similar way by other parties, as a trademark registration makes it easier for Trump to chill expressive use of this language using demand letters and private enforcement of trademark rights. Per news reports, Trump has already asked politicians not to use the phrase “Make America Great Again” in speeches and complained when merchandising websites such as CafePress sold T-shirts displaying this language on the front of the clothing. These politicians and companies would likely win in court if Trump sued them for trademark violations, but due to the time and expense of litigation some people will likely just self-censor their expression and not use the registered slogan in ways that might trigger trademark violations.

liability. If the government truly wants to discourage the overall use of language that is immoral, scandalous, potentially disparaging, or critical of the government, then allowing trademark registration and protection of that language might do the trick since granting a trademark registration will likely chill the unauthorized use of the registered language by others.263

While Section 2(a)’s bar on registration of an offensive mark does not prevent use of the mark, a remaining question is whether this law also prevents the trademark owner from pursuing a claim for infringement under Section 43(a) of the Lanham Act against competitors who use the mark to confuse consumers.264 Registration of a mark is not required for protection of the mark in the United States, and a distinctive and nonfunctional mark may still be protected against false designations of origin and unfair competition under Section 43(a). Some commentators argue that enforcement of trademark rights in offensive marks should not be allowed under Section 43(a) because it would circumvent the policy reasons for Section 2(a)’s rule banning registration of immoral, scandalous, or potentially disparaging marks.265 The Federal Circuit said in Tam that it was not clear whether the owner of an offensive mark could sue under Section 43(a), and noted the U.S. Supreme Court said in Two Pesos that “it is common ground that § 43(a) protects qualifying unregistered trademarks and that general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a).”266 In addition, the Tam majority noted that the district court in Renna held that government flags cannot be protected under Section 43(a) since they cannot be registered under Section 2(b) of the Lanham Act.267

On the other hand, dissenting judge Lourie in Tam, the International Trademark Association, and other commentators have argued that owners of marks denied registration under

263. Perhaps the United States should reconsider allowing registration of political slogans used in commerce as trademarks, as trademark protection for such marks can chill expression more than Section 2(a). Whether it should do this is beyond the scope of this article.


265. Baird, supra note 11, at 791 (arguing that government resources should not be spent enforcing Section 43(a) and allowing Section 43(a) claims would encourage the use of offensive terms as marks).

266. Tam, 808 F.3d at 1344 (citing Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992)).

267. Tam, 808 F.3d at 1344 n.11 (citing Renna v. Cty. of Union, 88 F. Supp. 3d 310, 320 (D.N.J. 2014) (“I am persuaded that Section 2 declares certain marks to be unregistrable because they are inappropriate subjects for trademark protection. It follows that such unregistrable marks, not actionable as registered marks under Section 32, are not actionable under Section 43, either.”)).
Section 2(a) can still sue for violations of Section 43(a) of the Lanham Act. Some courts have allowed unfair competition claims under Section 43(a) in cases involving non-registerable generic terms, trade names, and titles of single literary works where the defendant was passing off its goods or services as those of the plaintiff. In addition, the Two Pesos case dealt with a different issue—whether the trade dress of a restaurant can be protected under Section 43(a) without proof of acquired distinctiveness—rather than the subject matter exclusions from registration in Section 2. Moreover, other courts and trademark expert Professor McCarthy disagree with Renna’s holding about Section 2(b) and Section 43(a).

Regardless of whether Renna is correct with regard to the relationship between Section 43(a) and the ban on registration of government symbols in Section 2(b), courts can find a reason to treat offensive marks differently in the trademark provisions of the Paris Convention. The Paris Convention requires contracting parties to this trademark treaty to ban the use without authorization by the government of flags and other government symbols as trademarks, and not just refuse their registration. Article 6ter(1)(a) of the Paris Convention provides:

The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty.

268. See Tam, 805 F.3d at 1375 (Lourie, J., dissenting) (citing International Trademark Association’s En Banc Amicus Brief, http://www.inta.org/Advocacy/Documents/2015/In%20Tam_En%20Banc%20Amicus%20Brief%20for%20INTA.pdf; see also Baird, supra note 11; Farley, Registering Discontent, supra note 11, at 124.

269. See, e.g., Herbko Int’l, Inc. v. Kappa Books, Inc., 308 F.3d 1156, 1162 n.2 (Fed. Cir. 2002) (“While titles of single works are not registrable, they may be protected under section 43(a) of the Lanham Act upon a showing of secondary meaning.”); Blinded Vet. Ass’n v. Blinded Am. Vet. Found., 872 F. 2d 1035 (D.C. Cir. 1989) (third party use of generic term with de facto secondary meaning may violate unfair competition laws if it passes off its services as those of another); Accuride Int’l, Inc. v. Accuride Corp., 871 F.2d 1531, 1534 (9th Cir. 1989) (“The major legal distinction between trademarks and trade names is that trade names cannot be registered and are therefore not protected under 15 U.S.C. § 1114. However, analogous actions for trade name infringement can be brought under section 43(a).”) (citation omitted); see also Jake Linford, A Linguistic Justification for Protecting “Generic” Trademarks, 17 Yale J.L. & Tech. 110, 166-69 (2015).

270. Bros. of the Wheel M.C. Exec. Council, Inc. v. Mollohan, 909 F. Supp. 2d 506, 542 (S.D. W. Va. 2012) (noting availability of protection under Section 43(a) for flag design even if design unregistrable). Professor McCarthy notes that the statement in Renna that unregistrable marks are not actionable under Section 43 is erroneous; he says “[t]here is no statutory or case law support for such a view.” McCarthy, supra note 16, § 19:78.
adopted by them, and any imitation from a heraldic point of view.\textsuperscript{271}

Article 6\textsuperscript{quinquies}(3) of the Paris Convention allows contracting parties to ban the registration of trademarks contrary to morality or public order, but it does not require the United States or other Paris Union members to prohibit their registration or use.\textsuperscript{272}

Moreover, Article 10\textsuperscript{bis} of the Paris Convention requires contracting parties to protect companies against unfair competition.\textsuperscript{273} If U.S. courts want to interpret U.S. trademark laws to be consistent with the international treaty obligations of the United States,\textsuperscript{274} they can refuse Section 43(a) protection to government symbols (since they should not be used as marks without the government’s authorization under Article 6\textsuperscript{ter}(1)(a)), but still permit Section 43(a) unfair competition claims against parties who use the distinctive marks of others that are denied registration under Section 2(a) on the ground that the marks are immoral, scandalous, or potentially disparaging to others.

Thus, an unfair competition cause of action could be available against competitors under Section 43(a) to parties whose otherwise valid common law trademarks are denied registration under the immoral, scandalous, or potentially disparaging mark provision in Section 2(a). At the same time, the constitutionality of Section 2(a) does not depend on whether owners of offensive marks can sue for violations of Section 43(a) because Section 2(a) does not suppress or punish expression, impose an unconstitutional condition on expression, or result in other actionable harm to expression for the reasons set forth above.\textsuperscript{275} If courts decline to enforce trademark rights in such marks under Section 43(a), or if Congress decides to prohibit their enforcement under this unfair competition law, this

\textsuperscript{271}. Paris Conv., \textit{supra} note 20, art. 6\textsuperscript{ter}(1)(a) (emphasis added). But Article 6\textsuperscript{ter}(1)(c) of the Paris Convention clarifies that the government need not ban the use or registration of such marks if they do not “suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.” \textit{Id.}, art. 6\textsuperscript{ter}(1)(c).

\textsuperscript{272}. Paris Convention, \textit{supra} note 20, art. 6\textsuperscript{quinquies}(3).

\textsuperscript{273}. \textit{Id.} art. 10\textsuperscript{bis}.

\textsuperscript{274}. Under the \textit{Charming Betsy} canon, courts should interpret ambiguous language in a statute in such a way so as to avoid a conflict with international law. Curtis A. Bradley, \textit{The Charming Betsy Canon and Separation of Powers: Rethinking the Interpretive Role of International Law}, 86 Geo. L.J. 479 (1998) (citing Murray v. Schooner Charming Betsy, 6 U.S. (2 Cranch) 64, 118 (1804)). Moreover, if the United States complies with its treaty obligations, it is in a better position to argue that other nations should follow their treaty obligations relating to unfair competition laws and intellectual property rights.

\textsuperscript{275}. See also the discussion of this issue in Tushnet, \textit{supra} note 11, at 13-15 (discussing the relationship between Section 2(a) and Section 43(a)); \textit{id.} at 15-24 (arguing that Section 2(a) does not impose unconstitutional conditions); \textit{id.} at 30 & n. 91 (discussing \textit{Renna} and the absolute bar for registration of flags and other government symbols).
decision would also be constitutional under the First Amendment for the same reason: The party claiming trademark rights can still use the offensive language subject to other laws which ban the use of this expression, such as obscenity laws.


Another issue that may arise in a free expression challenge to a trademark law is whether the trademark law is regulating expression or something else that does not implicate the right to freedom of expression, such as non-expressive conduct or economic activity. In addition to words, symbols, and other traditional forms of written, aural, and visual expression (for example, a poem, a song, a sculpture, or a speech communicated by sign language), expressive use of symbols and other conduct also qualifies as “expression” that is protected by the free expression right in Europe, the United States, and other countries. This type of expression is called “symbolic speech,” and examples include displaying or waving a flag, burning a flag, wearing an armband, or wearing a red square pinned to your clothing to express yourself on a social or political issue.276 The third element of a free speech violation therefore considers whether the law is regulating “expression” (or “speech”) as that term is used in constitutions, human rights treaties, or other laws that protect the right to freedom of expression.

**Trademarks contain expression.** Use of a trademark to identify the manufacturer of a shoe may not be akin to using words or symbols to criticize the government or promote a social movement,277 but most uses of trademarks should still qualify as protected “expression.”278 Words, names, symbols, designs, and product configurations can all qualify as trademarks when used in commerce in connection with the sale of goods or services, but they are usually only protected under trademark law if they identify and distinguish the source of goods or services. Trademarks can also communicate information about the brand image of the company and its product quality. Examples include the terms

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277. Cf. Tam, 808 F.3d at 1368 (Dyk, J., concurring in part and dissenting in part) (stating that "many trademarks lack the kind of 'expressive character' that would merit First Amendment protection for offensive content").

278. See Ramsey, supra note 10, at 409-12; Snow, supra note 11, at 112-19 (discussing the speech value in source identification).
NIKE and JUST DO IT, the Nike swoosh symbol, a distinctive design on the surface of Nike’s product packaging for shoes, or the distinctive and nonfunctional product configuration of the shoe itself. The words REDSKINS and THE SLANTS identify and distinguish the source of entertainment services, and can also make a social or political statement when used as marks. For both of these reasons, these marks contain expression. As trademark rights cannot exist unless the alleged mark communicates information about the source or quality of the product, trademarks constitute expression and this third element of a free speech violation is satisfied.

Use of another’s trademark is expression. When someone uses another’s trademark such as THE SLANTS or REDSKINS without authorization this also constitutes expression regardless of whether this trademark use confuses consumers, conveys information, or makes a political statement. 279 This expression may be misleading commercial expression, such as counterfeit copies of the NIKE mark on shoes sold by one of Nike’s competitors, and thus categorically unprotected under the First Amendment (element 5), but it is still expression. So is a truthful comparative advertisement saying “Champion shoes are less expensive than Nike shoes”; this is nonmisleading commercial expression. Other expressive uses of marks include a consumer’s gripe site on a website critical of Nike, Inc. located at the domain name nikesucks.com and display of the phrase JUST DID IT or JUST DON’T DO IT on a T-shirt. In trademark disputes, this third element of a free speech violation—whether “expression” is being regulated—is usually satisfied when a trademark is involved, and thus courts must consider the other elements of a free speech violation to determine if the law is constitutional.

4. Individuals and Non-Government Entities: Whose Expression Is Regulated?

A fourth issue that may arise in a free speech challenge to a trademark law relates to the identity of the person or entity whose expression is regulated. Individuals and groups of people (such as Native Americans) clearly have the “human” right to freedom of expression. Some countries, such as the United States and members of the European Union, also protect the “fundamental” right to freedom of expression of corporations and other commercial entities. 280 In such countries, the fourth element of a

279. Ramsey, supra note 10, at 409-12.
280. Citizens United v. Fed. Election Comm’n, 558 U.S. 310, 342-43 (2010) (“The Court has recognized that First Amendment protection extends to corporations…. This protection has been extended by explicit holdings to the context of political speech…. Under the rationale of these precedents, political speech does not lose First Amendment
free speech violation is satisfied if the expression is from an individual, a nonprofit group of individuals, or a commercial entity. If a nation generally does not protect the expression of commercial entities from government regulation, however, then laws regulating such expression are more likely to be found constitutional or in compliance with obligations under human rights treaties (element 6).  

In addition, if “government speech” is being regulated, under U.S. law there is no free speech violation unless the government is compelling private citizens to convey its message. The government can usually control what is expressed when the government is a speaker, employer, or educator. The government speech doctrine allows the government to make content-based decisions relating to government expression, especially when the public might think the government is endorsing the expression communicated to the public. The U.S. Supreme Court recently applied this doctrine in Walker v. Texas Division, Sons of Confederate Veterans, Inc., and held that it was constitutional for the government to reject a design containing the Confederate flag for a government-issued license plate because this was government speech. Thus, in the United States and other nations with a similar approach to this issue, the fourth protection ‘simply because its source is a corporation.’ The Court has thus rejected the argument that political speech of corporations or other associations should be treated differently under the First Amendment simply because such associations are not ‘natural persons.’ (citations omitted); Sakulin, supra note 111, at 166-67 (discussing European law).


283. Volokh, supra note 132, at 411 (discussing cases).

284. Walker, 135 S. Ct. at 2245-46 (“When government speaks, it is not barred by the Free Speech Clause from determining the content of what it says . . . .That freedom in part reflects the fact that it is the democratic electoral process that first and foremost provides a check on government speech . . . .Thus, government statements (and government actions and programs that take the form of speech) do not normally trigger the First Amendment rules designed to protect the marketplace of ideas.”); id. at 2246 (noting “as a general matter, when the government speaks it is entitled to promote a program, to espouse a policy, or to take a position”); see also Rust v. Sullivan, 500 U.S. 173, 194 (1991) (refusing “[t]o hold that the Government unconstitutionally discriminates on the basis of viewpoint when it chooses to fund a program dedicated to advance certain permissible goals, because the program in advancing those goals necessarily discourages alternative goals”); Legal Servs. Corp. v. Velazquez, 531 U.S. 533, 541 (2001) (when the government “disburses public funds to private entities to convey a government message, it may take legitimate and appropriate steps to ensure that its message is neither garbled nor distorted by the grantee”); id. (Therefore, “viewpoint-based funding decisions can be sustained in instances . . . in which the government used private speakers to transmit specific information pertaining to its own program.”). Velazquez says Rust must be understood as resting on the conclusion that it involved “government speech.” Id.
element of a free speech violation is not satisfied unless the identity of the speaker whose expression is being regulated in a trademark dispute is an individual or non-government entity.

Expression of individuals and non-government entities in trademark enforcement. In trademark litigation, typically the party claiming a free expression right to use another’s trademark is an individual or company accused of infringement or other trademark violations, not the government. Regardless of whether that defendant is a counterfeiter or a critic of the trademark owner, this fourth element of a free speech violation will be satisfied if the defendant is a human being or a noncommercial group of people. If a country’s free expression doctrine also applies to expression by corporations and other commercial entities, then this element will also be satisfied if the defendant accused of trademark violations is a company.

Expression of individuals and non-government entities in trademark registration. The district court in Pro-Football and Judge Lourie in his dissent in Tam held that the government speech doctrine applies to Section 2(a) because, among other things, the public may believe the government endorses offensive marks when it approves of adding them to the trademark register. Professor Rebecca Tushnet also argues that we should treat trademark registration as a form of endorsement by the government and allow the government to express an opinion about the boundaries of appropriate public discourse in the trademark context. As noted previously, the Tam majority refused to apply the government speech doctrine to the offensive mark provision in Section 2(a).

The Federal Circuit is correct that the government speech doctrine does not apply in the context of registrations or denials of registrations for a trademark adopted and used by a private party. When it registers (or refuses to register) a mark, the USPTO may be communicating to the public that the mark satisfies (or fails to satisfy) the requirements in Section 2(a), but Section 2(a) does not regulate this communication about the decision to register nor does it regulate anything the government says about the mark; it prohibits the act of registration of offensive trademarks. The


287. Tam, 808 F.3d at 1339. In its brief filed with the Fourth Circuit, Pro-Football listed a number of offensive trademarks that were registered by the USPTO to illustrate that “no one today thinks registration reflects government approval.” Opening Brief of Appellant, Pro-Football, Inc. v. Blackhorse, No. 15-1874, at 24 (4th Cir. Oct. 30, 2015).
trademark register and USPTO website contain a list of registered marks, and the USPTO website also lists marks that are being considered for registration and marks that are rejected for registration, but Section 2(a) does not regulate the publication of these lists of trademarks; it regulates whether certain marks can be registered. Moreover, while the trademarks denied registration under Section 2(a) contain expression, this is expression of Pro-Football, Tam, and other private parties, and not expression of the government unless the government is applying for registration of a trademark.

Regardless of whether some people might think the government is endorsing or approving of the trademarks it accepts for registration, the government speech doctrine is not relevant when considering the constitutionality of a law banning registration of offensive language as a mark because the mark is usually the speech of a private party. Thus, in a free speech challenge to Section 2(a) or a similar trademark law, this fourth element of a free speech violation will be satisfied when the trademark applicant or registrant is an individual such as Tam. It will also be met in countries that protect the free expression rights of companies such as Pro-Football. In such cases, a U.S. court must next consider whether a categorical exclusion for this type of expression applies.

5. No Categorical Exclusion for this Expression:
Is this Regulation Justified Because a Categorical Exclusion from Protection Applies to This Expression?

Some countries have free expression laws which allow the government to constitutionally regulate certain categories of expression without having those laws subject to judicial scrutiny of the proper balance between the benefits and harms of the specific law regulating the expression. For example, in the United States the U.S. Supreme Court has stated that certain categories of expression are generally denied free speech protection, including misleading commercial expression, incitement of imminent illegal activity, fighting words, obscene expression, and child pornography.288 This is a form of “definitional” balancing rather than “ad hoc” balancing, and laws regulating these categories of

expression are normally not subject to strict or intermediate scrutiny under the First Amendment. Thus, a possible fifth element of a free speech violation is that there is no categorical exclusion for this type of expression that is regulated by a country’s trademark law.

In addition, in the copyright law area the U.S. Supreme Court created a doctrine similar to a categorical exclusion for expression when it declined to evaluate the constitutionality of a new copyright law under the Court’s traditional strict scrutiny or intermediate scrutiny analysis. In Eldred, the U.S. Supreme Court said that suppression or punishment of the use of another’s copyrighted expression implicates the First Amendment, but copyright law is constitutional (and is not subject to further constitutional scrutiny) unless Congress alters the traditional contours of protection, such as by protecting copyright in ideas or eliminating the copyright fair use defense. The U.S. Supreme Court has not created a similar categorical exclusion from constitutional scrutiny for regulations of trademarks. Perhaps it will do this in Lee v. Tam as a way to find the disparagement provision in Section 2(a) consistent with the First Amendment.

**Trademarks and uses of trademarks that constitute misleading commercial expression.** If a country refuses to protect misleading commercial expression under the right to freedom of expression, then the government can regulate the commercial use of trademarks that are misleading. For example,
the USPTO could clearly reject a registration for LOVEE LAMB for synthetic car seat covers not made of lambskin without violating the First Amendment if this deceptive mark qualifies as misleading commercial expression. Not only may the government deny registration to a misleading trademark used in commercial expression, but it can also use false advertising laws to suppress or punish misleading expression in the marketplace without implicating the free expression right because the “no categorical exclusion for this expression” element is not satisfied.

Infringing uses of trademarks are also not protected under the First Amendment if they constitute misleading commercial expression. An example is a competitor’s counterfeit copies of the NIKE mark on shoes that are not sold by Nike, Inc. In such a case, the fifth element of a free speech violation would not be satisfied and any criminal or civil penalty for this trademark violation (such as jail time, a fine, or an injunction or monetary relief) would likely be found constitutional in the United States. On the other hand, if the defendant’s unauthorized use of another’s mark does not qualify as misleading commercial expression, such as the diluting but nonmisleading use of a famous mark, then a U.S. court evaluating the constitutionality of the trademark dilution law will need to determine whether the law can survive constitutional analysis under the Court’s First Amendment jurisprudence (element 6).

Trademarks containing other excluded categories of expression. If a nation excludes incitement to illegal activity, fighting words, obscene expression, child pornography, or other categories of expression from protection under the right to freedom of expression, then it should also be able to refuse to register this expression as a trademark, and ban or punish the use of this expression as a trademark, without violating the right to freedom of expression. Note, however, that this categorical exception rule may not apply in the United States if the government is engaging in viewpoint discrimination within a category of expression. As Section 2(a) regulates some subject matter that is not categorically excluded from constitutional protection, this fifth element of a free speech violation (“no categorical exclusions for this expression”) is satisfied for a facial challenge to Section 2(a), and courts must evaluate whether the other elements of a violation of the right to freedom of expression are met. If the U.S. Supreme Court believes that the second element of a free speech violation (suppression or

293. Ramsey, supra note 10, at 421-46 (discussing intermediate and strict scrutiny analysis in trademark disputes).
294. See supra note 288 (discussing U.S. law).
punishment of expression, or other actionable harm to expression) is satisfied by Section 2(a), then it will need to evaluate whether Section 2(a) satisfies constitutional scrutiny (element 6).

6. The Regulation of Expression Fails the Relevant Balancing Test Created by Courts Applying Constitutional Laws and Human Rights Treaties Protecting Freedom of Expression

There is no universal approach to analyzing whether a trademark law violates the right to freedom of expression, and a comparative discussion of the free expression jurisprudence of several nations is beyond the scope of this article. In many countries, however, the particular level of constitutional scrutiny or the exact balancing test applied by courts may depend on certain factors, including whether the expression is commercial or noncommercial, whether the law is a content-based or content-neutral regulation, or whether the law is regulating expression in a government forum. Below, the article briefly addresses these issues with a focus on United States law, but the analysis may also be useful for judges in other jurisdictions who are deciding how to resolve potential conflicts between trademark and free expression rights.

In Tam the judges disagreed about whether strict scrutiny or intermediate scrutiny analysis should be applied to evaluate the constitutionality of the “may disparage” language in Section 2(a). The majority in Tam held that strict scrutiny of the law is required under Reed—regardless of whether the law regulates commercial expression—because Section 2(a) is a content-based regulation and the government disapproves of the offensive language being regulated. The dissenting judges in Tam held that this law only regulated commercial expression, and thus was subject to Central Hudson’s intermediate scrutiny analysis. Judge Reyna also argued that Section 2(a) is a content-neutral regulation of expression subject to intermediate scrutiny analysis because it regulates the secondary effects of speech. The judges did not evaluate whether the government forum doctrine applied in this context.

296. See supra note 121 (discussing the free expression analysis under the European Convention on Human Rights).
299. Id. at 1378-79 (Reyna, J., dissenting).
case, and the government declined to pursue this approach during oral argument before the Federal Circuit, but some commentators have argued this doctrine could apply to the trademark register or the trademark registration system.

As discussed in more detail below, this article argues that trademark laws such as Section 2(a) currently regulate both commercial and noncommercial expression, and are content-based rather than content-neutral laws. As the trademark register and trademark registration system are part of a regulatory regime and are not a “forum” for expression by private parties, the article also contends that the U.S. Supreme Court’s government forum doctrine is not relevant when evaluating the constitutionality of Section 2(a).

a. Trademark Laws Can Regulate Commercial and Noncommercial Expression

If a country (such as Japan) generally permits government regulations of commercial expression, or subjects such laws to lesser scrutiny under balancing tests in that country’s free expression laws, courts will need to determine if the trademark law only regulates trademarks used in commercial contexts. If so, this law is less likely to violate the right to freedom of expression. In the United States, commercial expression is usually defined as expression that does no more than propose a commercial transaction, and regulations of such expression have been subjected to intermediate scrutiny analysis under the test in Central Hudson rather than the strict scrutiny analysis used for evaluating the constitutionality of regulations of noncommercial expression. After Sorrell, however, heightened scrutiny analysis for content-based regulations of expression may be required in the

300. Id. at 1353 n.12 (majority opinion) (noting that government’s counsel at oral argument disclaimed that the government forum approach was appropriate in the context of trademark regulation).

301. See infra Part IV.A.6.c.

302. See supra note 148 (Japanese constitutional law on commercial expression).


United States regardless of whether the expression is commercial or noncommercial.\textsuperscript{305}

As I have explained elsewhere in the context of U.S. trademark law,\textsuperscript{306} trademark laws primarily regulate commercial expression, but they also occasionally regulate noncommercial expression. Even though most trademarks are used by trademark owners and other parties to identify and distinguish commercial goods or services, political and religious organizations have registered trademarks in the United States and enforced these marks against competitors.\textsuperscript{307}

The REDSKINS and THE SLANTS marks for entertainment services can identify the source of the services (which seems more commercial) and convey the inherent meaning of the words (which seems more political). Several judges in the Tam case classified THE SLANTS mark as political expression because the Asian-American rock band was trying to reclaim this term and make a political and social statement, but the mark is also used by the band to propose a commercial transaction when it advertises its services. For example, if a poster or email advertisement for the band’s concert said “Tickets are now available for THE SLANTS show at the House of Blues,” this use of THE SLANTS mark is at least partially commercial since consumers will use the mark to identify and distinguish Tam’s band from other bands, and then purchase tickets for THE SLANTS concert. At the same time, Tam’s use of this mark on the poster or in the email could start a public conversation about offensive terms, and thus may qualify as mixed commercial-noncommercial speech or noncommercial expression under U.S. First Amendment doctrine because it does more than propose a commercial transaction.\textsuperscript{308} As offensive marks may be used in commercial or noncommercial contexts, and rejection of the registration under Section 2(a) does not depend on the commerciality of this use, it does not make sense to categorize

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\textsuperscript{305} Citizens United v. Fed. Election Comm’n, 558 U.S. 310, 336-37 (2010); Sorrell v. IMS Health Inc., 564 U.S. 552, 565-67 (2011); see Jake Linford, The Institutional Progress Clause, 16 Vand. J. Ent. & Tech. L. 533, 542-43 (2014) (noting that Citizens United and Sorrell suggest the Court is moving closer to strict scrutiny analysis for commercial speech and a commitment to a speaker-neutral First Amendment in both the political and commercial arenas).

\textsuperscript{306} Ramsey, supra note 10, at 390-404 (discussing increasing First Amendment protection for commercial speech and application of trademark laws to commercial and noncommercial expression); Ramsey, supra note 19, at 887-88.

\textsuperscript{307} E.g., United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc., 128 F.3d 86, 88 (2d Cir. 1997); Gen. Conference Corp. of Seventh-Day Adventists v. Perez, 97 F. Supp. 2d 1154, 1164 (S.D. Fla. 2000) (holding use of the registered SEVENTH-DAY ADVENTIST mark for church services, books, and other goods and services by an unaffiliated church infringed the marks of the national religious organization).

the expression as either commercial or noncommercial here. It can be both. For this reason, heightened scrutiny of the trademark law is appropriate in the United States since the law regulates noncommercial expression and is a content-based law, as discussed next.

b. Trademark Laws Are Content-Based Regulations

If a country subjects content-based regulations of expression to higher scrutiny under balancing tests in that country’s free expression laws, courts will also need to determine if the trademark law regulates expression based on its content. In the United States, content-neutral regulations of expression are generally subject to less scrutiny than content-based regulations. 309 I agree with the Federal Circuit that Section 2(a) is a content-based regulation of expression. 310

As I have discussed in more detail in other work, trademark laws are content-based laws because the government must examine the content of the message when deciding how to regulate that expression. 311 Section 2(a) is not similar to content-neutral laws that regulate the time, place, or manner of expression (such as the sound levels at concerts), 312 or to regulations of expressive conduct (such as burning a flag), 313 because Section 2(a) requires the government to make decisions on what to register as a trademark based on the meaning of the words. This law is similar to the content-based law punishing the public display of profanity in Cohen v. California. 314

Trademark infringement and dilution laws are also content-based regulations of expression because the court must examine the content of the defendant’s expression to determine if this use of the mark is infringing or diluting. For example, in infringement actions courts determine whether the parties’ marks are similar in sight, sound, or meaning. Moreover, if the trademark owner

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310. In re Tam, 808 F.3d 1321, 1321-58 (Fed. Cir. 2015) (en banc), as corrected (Feb. 11, 2016), cert. granted sub nom. Lee v. Tam (U.S. Sept. 29, 2016) (No. 15-1293). Some commentators argue that the Court should not apply heightened scrutiny in the trademark context because this would call into question “all content-based restrictions that trademark law imposes on speech.” Snow, supra note 11, at 126; see Tushnet, supra note 11, at 24-39.


314. Cohen v. Calif., 403 U.S. 15, 26 (1971) (where defendant was punished for wearing a jacket with the words “Fuck the Draft” in the corridor of a courthouse, holding “absent a more particularized and compelling reason for its actions, the State may not, consistently with the First and Fourteenth Amendments, make the simple public display here involved of this single four-letter expletive a criminal offense”).
prevails, the court punishes the defendant’s use of specific words or symbols protected as a mark, and enjoins further use of that language as a mark in an injunction. Of course, the trademark law may be constitutional if it regulates misleading commercial expression, but it is still a content-based law. The free flow of expression is not adequately protected if we deem trademark laws to be content-neutral regulations, and subject them to a lower level of constitutional scrutiny for this reason.315

In addition to arguing that Section 2(a) is a content-based regulation, the Tam majority and some commentators also argue that Section 2(a) facially discriminates based on the viewpoint of the speaker.316 Professor Tushnet and the dissenting justices in Tam persuasively argue that this is incorrect.317 The statute on its face bans immoral, scandalous, or potentially disparaging marks from registration, and examiners and courts usually focus on the content of the words used in connection with certain goods or services, and what they mean to a substantial composite of the relevant group, rather than the identity of the speaker or anyone’s intent or viewpoint when they apply the law.318 This law is very different compared to the law banning fighting words that was found to discriminate based on viewpoint in R.A.V.: “Whoever places on public or private property a symbol, object, appellation, characterization or graffiti, including, but not limited to, a burning cross or Nazi swastika, which one knows or has reasonable grounds to know arouses anger, alarm or resentment in others on the basis of race, color, creed, religion or gender commits disorderly conduct and shall be guilty of a misdemeanor.”319 Moreover, the U.S. Trademark Office’s cancellation of the REDSKINS marks and denial of Tam’s application to register THE SLANTS to reclaim the term suggests that the government did not apply the law in a manner that discriminates against viewpoint in those decisions.

316. In re Tam, 808 F.3d 1321, 1328, 1336-37 (Fed. Cir. 2015) (en banc), as corrected (Feb. 11, 2016), cert. granted sub nom. Lee v. Tam (U.S. Sept. 29, 2016) (No. 15-1293); Lefstin, supra note 11, at 676, 679-81.
317. Tam, 808 F.3d at 1371-72 (Dyk, J., concurring in part and dissenting in part); Tushnet, supra note 11, at 39-43. Note, however, that the USPTO could apply the law in a way that discriminates based on the viewpoint of the speaker.
318. See supra note 72 (discussing the TMEP rules regarding Section 2(a)).
319. R.A.V. v. City of St. Paul, 505 U.S. 377, 380 (1992) (emphasis added). As explained by the Court, “Displays containing some words—odious racial epithets, for example—would be prohibited to proponents of all views. But ‘fighting words’ that do not themselves invoke race, color, creed, religion, or gender—aspersions upon a person’s mother, for example—would seemingly be usable ad libitum in the placards of those arguing in favor of racial, color, etc., tolerance and equality, but could not be used by those speakers’ opponents.” Id. at 391.
While the Trademark Office has allowed registration of terms that are not immoral, not scandalous, or not potentially disparaging, such as ASIAN EFFICIENCY, this is based on the content of the trademark, and not on the speaker’s identity, intention, or viewpoint. Just as Tam can use THE SLANTS in a positive way to reclaim a racial slur, a non-Asian American person could use the mark ASIAN EFFICIENCY in a derogatory way to ridicule Asians or reinforce stereotypes about them. It would be problematic from a free expression, equal protection, and practical standpoint if we required the government to discern the characteristics of the applicant (e.g., Asian-American, Native American, African-American, white, etc.) and his or her intent (e.g., criticism, commentary, ridicule, or celebration of Asian-Americans, Native Americans, African-Americans, whites, etc.) and then use this information to determine whether to grant or deny a registration for a mark that is deemed to be immoral, scandalous, or potentially disparaging. Even if there are good policy reasons to allow Tam to register THE SLANTS as a mark for his rock band’s entertainment services, the constitutionality of Section 2(a) should not depend on the identity of the trademark applicant or that person’s purpose in selecting the mark.

c. The Trademark Register and the Trademark Registration System Are Not Government Forums for Expression

The government forum or “public forum” doctrine divides government property into three types of fora: the traditional public forum, the limited public forum, and the nonpublic forum. It is more difficult for the government to regulate expression communicated in public forums such as parks, streets, sidewalks, or post offices when compared to nonpublic forums, such as a government workplace or an elementary school, or limited public forums such as student organization resources or student publications.

Some commentators argue that the government forum doctrine is relevant when evaluating the constitutionality of

320. Perry Educ. Ass'n v. Perry Local Educators' Ass'n, 460 U.S. 37, 45-46 (1983) (finding school mail system was a nonpublic forum); see, e.g., Ark. Educ. Television Comm'n v. Forbes, 523 U.S. 666, 677 (1998) (holding debate was either a nonpublic forum or not a forum at all); Cornelius v. NAACP Legal Def. & Educ. Fund, Inc., 473 U.S. 788 (1985) (holding charitable contribution program was a nonpublic forum); see also Chemerinsky, supra note 14, 1189 (“Public forums are government-owned properties that the government is constitutionally obligated to make available for speech”); id. at 1189-1200 (discussing public forum doctrine); Volokh, supra note 132, at 411 (same).

Section 2(a) because the government is providing resources to facilitate private speech when it operates the trademark register and protects registered marks in the trademark registration system. However, the forums for expression in the government forum cases are substantially different compared to the trademark register and the trademark registration system. Trademark owners usually express themselves in the marketplace, and not on the trademark register, in the Official Trademark Gazette, or on the USPTO website. As discussed in Part IV.A.4, the register is the place where the USPTO adds marks that are registered. It is not usually a forum for private parties to place their marks to convey information and ideas. While the government publishes these marks in various places, Section 2(a) does not regulate these publications of expression. It simply denies registration to certain subject matter. Thus the government forum doctrine is not relevant when courts evaluate the constitutionality of Section 2(a).

d. Options for the U.S. Supreme Court
If It Wants to Find Section 2(a) Constitutional under the First Amendment

If Section 2(a) implicates the First Amendment, the law’s ban on registration of immoral, scandalous, or potentially disparaging marks should be subject to strict scrutiny analysis under the U.S. Supreme Court’s current First Amendment jurisprudence. Intermediate scrutiny of the law is not appropriate since Section 2(a) is not a content-neutral regulation and regulates both commercial and noncommercial expression. Thus the offensive trademark provisions of Section 2(a) may only be constitutional if: (1) the Court holds that the second element of a free speech violation (suppression or punishment of expression, or other actionable harm to expression) is not satisfied, (2) the Court finds that this content-based law satisfies strict scrutiny analysis, or (3) the Court creates a new trademark-specific free speech doctrine that excludes this trademark law from traditional First Amendment analysis.

322. Some commentators argue that the trademark register should be classified as a nonpublic forum. See, e.g., Sonia K. Katyal, Trademark Intersectionality, 57 UCLA L. Rev. 1601, 1669-82 (2010) (arguing that the trademark register is similar to vanity license plates); Hammad Rasul, The Washington Redskins’ Deflating Hope: The Lanham Act Survives the First Amendment Challenge, 26 Marq. Sports L. Rev. 159, 171-79 (2015) (same); see also Leslie Gielow Jacobs, The Public Sensibilities Forum, 95 Nw. U. L. Rev. 1357, 1358-64, 1385 n.233 (2001) (stating that Section 2(a) conditions “the distribution of speech opportunities on meeting public sensibilities standards” when discussing nonpublic forums). Others argue the trademark register is more like a limited public forum. See, e.g., Lefstin, supra note 11, at 702-07; Snow, supra note 11, at 109-10 (arguing the “trademark system functions as a metaphysical forum that Congress created for limited commercial purposes”); Stout, supra note 11, at 249-51.
For the reasons set forth in Part III.C. and Part IV.A.2 above, the Court should find that Section 2(a) does not implicate the First Amendment since the law only bans the registration (and not the use) of offensive trademarks. If the Court disagrees, it should hold that Section 2(a) is a content-based regulation of commercial and noncommercial expression, that the trademark register is not a government forum, and trademark registrations are not government speech, for the reasons set forth above. Whether the Court should apply strict scrutiny analysis to Section 2(a) or create a new trademark-specific free speech doctrine is beyond the scope of this article.

**B. The Differences Between Trademark Laws and Copyright Laws May Justify Different Constitutional Analysis of Laws Regulating Trademarks and Copyrights**

In *Tam*, the Federal Circuit argued that a copyright law that allowed the government to deny a copyright registration based on the immoral, scandalous, or potentially disparaging content of the artistic or literary work would be an unconstitutional regulation of expression under the First Amendment, and said this fact offers additional support for the argument that the “may disparage” language in Section 2(a) of the Lanham Act is unconstitutional.\(^{323}\) The constitutionality of a government prohibition of copyright registration and protection for works of authorship that contain offensive content is beyond the scope of this article. Regardless, the constitutional analysis of such a copyright law would likely be different because the two intellectual property laws are different in various ways.\(^{324}\)

First, the subject matter and goals of copyright and trademark law are quite distinct, and this fact may influence the analysis under the second element (suppression or punishment of expression, or other actionable harm to expression) and sixth element (constitutional scrutiny) of the proposed framework for a free speech violation. In copyright law, one acquires rights by creating an original work of authorship that is fixed in a tangible medium of expression, such as a poem written on paper or a computer. In the United States, the government primarily protects copyright to produce incentives to create and disseminate expression, and the Intellectual Property Clause of the U.S.


\(^{324}\) For information about copyright laws in the United States, see David Nimmer & Melville B. Nimmer, *Nimmer on Copyright* (2016); Willard F. Patry, *Patry on Copyright* (2016). See also Snow, supra note 11, at 133-34 & n.162; Snow, supra note 260, at 1478-79; Tushnet, supra note 11, at 43-44.
Constitution specifically allows Congress to grant copyright protection to authors to promote the progress of science and the useful arts. The U.S. Supreme Court has also declared that copyright is the engine of free expression, and that copyright laws are constitutional as long as Congress does not alter the traditional contours of protection.

If the U.S. government denies an author a copyright registration for an offensive novel first published in the United States, and thereby prevents her from suing in a U.S. court for copyright infringement, this decision would likely reduce the author’s profits because others could copy her work and charge less or distribute it for free. This would decrease the incentive for that author to create this new expression, and the public may not receive this message that the government deems to be offensive. A court may find this harm to incentives to create expression satisfies the second element of a free speech violation in my framework above (although it is not clear that it would do so), or the court may determine that the content-based law does not survive constitutional scrutiny under the Court’s First Amendment jurisprudence for these reasons.

Unlike copyright, governments generally do not protect exclusive rights in trademarks to encourage the creation of more trademarks. Rather, they protect trademark rights to enable consumers to identify and distinguish goods and services in the marketplace, encourage trademark owners to invest in selling products of a consistent quality, and discourage fraud and unfair competition in the marketplace, among other goals. In the United States, Congress gets its power to regulate trademarks from the Commerce Clause of the U.S. Constitution, not the Intellectual Property Clause. While some trademarks are made-up fanciful marks, and these types of marks have stronger protection than descriptive terms claimed as trademarks, most trademarks (and especially offensive trademarks) are selected from our current language. Trademark rights are created upon registration or use of this previously-existing language in connection with certain goods or services. Even if there is no trademark registration for offensive terms, members of the public still have access to that language and are likely to still use it because of its inherent meaning. A company who is denied trademark rights for offensive language may (or may not) continue to use this language as part of a trademark or otherwise, and so can everyone else subject to other laws that regulate this expression, such as obscenity laws. Unlike

327. U.S. Const. art. I, § 8, cl. 3.
a copyright law which denied registration to offensive expression, Section 2(a) does not discourage the creation of offensive expression, so it is less harmful to free expression values.

Another significant difference between copyright and trademark laws relates to the scope of rights and what type of use of the intellectual property triggers liability. Independent creation of offensive expression protected by copyright law is not infringing. But a trademark defendant can infringe a trademarked word or symbol without copying the plaintiff’s trademark. It is possible that another party will use words such as FUCT on a T-shirt or RAGING BITCH in connection with the sale of beer, because of the inherent offensive meaning of the expression rather than to confuse consumers about the source or quality of the products. An accused infringer may not even realize someone claims trademark rights in the offensive language until the demand letter arrives in the mail. That individual or company may want to reclaim the word just like THE SLANTS rock band, or appeal to people who like profanity, slurs, or sexual images. Registering trademark rights in offensive language will help the trademark owner prevent dissemination of this offensive language in commerce by others who infringe or dilute the mark without any increase in the creation of new offensive language, which is arguably inconsistent with the right to freedom of expression.

Regardless of whether courts recognize a free speech right to copyright registration of offensive expression, it does not make sense to recognize a free speech right to registration of an offensive trademark. Providing exclusive nationwide trademark rights in this subject matter via registration will not create more expression and will instead likely result in the suppression, punishment, and chilling of the expression of others.

V. CONCLUSION

The Federal Circuit was wrong when it held in Tam that the disparagement provision of Section 2(a) of the Lanham Act is a facially-invalid regulation of expression under the First Amendment. Offensive expression will likely be chilled if governments allow (rather than deny) registration of offensive trademarks. If a rock band member cannot register THE SLANTS

328. While the USPTO denied Brunetti’s application for the mark FUCT for clothing, see supra note 5, it granted the application to register RAGING BITCH for “[b]rewed malt-based alcoholic beverages in the nature of a beer.” RAGING BITCH, Registration No. 4,063,379 (registered Nov. 29, 2011 by Flying Dog Brewery). The government has unsuccessfully attempted to stop Flying Dog from using the RAGING BITCH label, which includes a picture of a wild female dog in addition to the registered phrase. Jacob Sullum, The Petty Tyranny of Beer Label Censors, Forbes.com (May 19, 2016), http://www.forbes.com/sites/jacobsullum/2016/05/19/how-raging-bitch-bad-frog-and-dirty-bastard-escaped-beer-label-censorship/#5ef0a126f218.
as a mark and obtain the benefits of registration, he may still use that expression. He may also adopt a different non-disparaging name, slogan, or logo that can be registered. If he can register THE SLANTS mark, the public may be chilled from using these words in various ways. As trademark registrations help trademark owners obtain the government’s assistance in suppressing and punishing use of the registered expression by others, we should not recognize a free speech right to secure that registration. The decision on whether to prohibit or allow registration of offensive language under trademark law should be left to national legislatures unless a court finds the law clearly violates the right to freedom of expression or other rights under that nation’s constitution or human rights treaties.

The recent Tam and Pro-Football cases have increased the focus by courts and commentators on the potential conflict between the right to freedom of expression and trademark laws. This is a positive development and will help ensure that trademark laws are not abused to suppress, punish, and chill protected expression. At the same time, it is critical that we avoid applying free expression doctrines such as the unconstitutional conditions doctrine, the government speech doctrine, government forum doctrine, or laws regulating content-neutral regulations of expression to trademark registration law when those doctrines do not fit. Perhaps the U.S. Supreme Court will take the opportunity presented by Tam to create a new trademark-specific free expression doctrine that balances trademark rights, the right to freedom of expression, and other public interests at issue in a trademark dispute. Regardless of what the Court does in Tam, however, this article provides a framework for considering the constitutionality of trademark laws in the United States and other countries.
UNDERSTANDING MICHAEL JORDAN v. QIAODAN: HISTORICAL ANOMALY OR SYSTEMIC FAILURE TO PROTECT CHINESE CONSUMERS?

By Laura Wen-yu Young∗

I. BACKGROUND

In 1997, a Fujian company wanted to sell sportswear to Chinese consumers, who did not yet have a history or culture of sports. China would soon join the World Trade Organization (WTO), and was bidding to host the Olympic Games in 2008. The company selected a name that evoked energy by sounding foreign, but yet would sound familiar to consumers: the name 乔丹 (pronounced and transliterated as “Qiao Dan” in pinyin,1 or “Ch’iao Tan” in the Wade-Giles system2), which translates literally as “tall red,” and sounds like “bridge peony.” The company registered its name as Qiaodan Sports Company, Limited (乔丹体育股份有限公司) (“Qiaodan Sports”). In 1997, the company filed to register trademark rights in 乔丹 and logo ⪏ for swim wear, shoes, and rain coats.3 The logo showed a baseball batter with pale hands and face about to hit a floating baseball, surrounded by a baseball diamond. The company continued to add to its inventory of trademarks, and filed more than 100 applications, which include the Chinese characters 乔丹 or the pinyin word “Qiaodan.”4

The name “Qiaodan” was attractive probably because since 1986 it had appeared in Chinese newspapers and on television broadcasts of National Basketball Association (NBA) games.5 As many now know, it was often used as a rough transliteration of the

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1. Pinyin is a system of writing the sounds of Chinese in Roman characters. There are several such systems, but pinyin is the official system of mainland China.

2. The Wade-Giles system is the romanization system for Chinese that was used for most of the twentieth century and in Taiwan, but has now been supplanted by the pinyin system.


4. In 1998, Jinjiang Mai Ke Footwear Co., Ltd., a predecessor to Qiaodan Sports, filed an exact copy of Nike’s Jumpman logo with the word “QIAODAN,” Registration No. 1407911. It later assigned the registration to Qiaodan Sports. The registration was later ruled invalid, presumably as a copy of Nike’s Jumpman logo.

5. CCTV Broadcast NBA History, Baidu, http://zhidao.baidu.com/link?url=083XUg8qCP6dttPBVX2xXxAV_0kAk9xE25ic1B6uliBgn4npB7sFYWwzhk8PoWMkgkuchKDWFnExdmGYZNZMa (last visited Feb. 12, 2016).
surname of the famous American basketball player Michael Jordan. "Qiaodan" means many things and is not the only way of writing Michael Jordan’s name in Chinese. Many other characters could have been used to sound like Jordan: Jiao-er-dun, 角尔顿, Zhao-deng, 喬登, Chao-er-dan, 朝兒旦. In fact, the Chinese Wikipedia page uses a different transliteration. But 乔丹 (hereinafter “Qiaodan”) is the most common way of transliterating the Western name “Jordan” into Chinese in mainland China, and it was used in mainland Chinese news reporting of Michael Jordan’s successful career. “Qiaodan” used in the context of basketball in China has become virtually synonymous with Michael Jordan, and is used in many online reference materials about the athlete.7

In 2002, Qiaodan Sports filed a trademark application for a jumping basketball player logo, and began to use that logo on its products. In 2006, the company registered a logo that included the number “23”: Many fans recognize the number “23” as Michael Jordan’s jersey number. The company grew rapidly. By 2010, its sales revenue reportedly exceeded $460,000,000, and by 2012, it had more than 5,700 distributors around China. By 2011, the company was planning an initial public offering on the Shanghai Stock Market.11

Furthermore, in an undeniable display of long-range thinking, Qiaodan Sports registered trademarks in Chinese characters 杰弗里乔丹 (Jie Fu Li Qiao Dan) and 马库斯乔丹 (Ma Ku Si Qiao Dan), which sound similar to “Jeffrey Jordan” and “Marcus Jordan,” the names of two of Michael Jordan’s sons.12 Apparently, the company


7. See, e.g., 迈克尔·乔丹 (Michael Jordan), Baidu http://baike.baidu.com/view/19096.htm (last visited Feb. 12, 2016). But the Baidu page also lists several other people and entities under the name “Qiaodan,” including a British female celebrity and the Fujian sportswear company.


expected the sons of a basketball legend would become famous athletes as well, and their names might become valuable brands in their own right.\footnote{13} These registrations support the allegation that the company had a deliberate intention to associate itself with, or trade on the fame and goodwill of, Michael Jordan’s trademarks.

Nike has had a presence in China since 1981, and it registered trademark rights in MICHAEL JORDAN for Class 25 goods in 1991.\footnote{14} It filed many more trademarks in China over the years, including, in 1993, its “Jumpman logo” for apparel and footwear.\footnote{15} Like most Western companies at that time, Nike focused on sourcing and product manufacture in China rather than sales to Chinese consumers.

By 2002, after China had joined the WTO and Yao Ming had joined the NBA, Chinese consumer awareness of foreign sports, particularly basketball and soccer, made them eager to buy sportswear with foreign brands. Prior to 2000, few Western companies sold products in China, and Chinese consumers were generally motivated by value and affordability rather than luxury or prestige.

By 2008, the “Great Recession” in the West had badly affected China’s export-driven economy. The “Factory Floor to the World” found itself with fewer overseas buyers. China’s government began to encourage its citizens to start spending their savings in order to develop a domestic consumer economy less reliant on exports to overseas markets. Furthermore, Chinese consumers were encouraged to travel, and non-Chinese companies noticed that Chinese tourists voraciously purchased authentic luxury goods during trips to the West. China’s domestic consumers were now eager to purchase authentic foreign and luxury goods at home.

By 2007, Nike had successful retail stores around the world, and was expanding its retail presence in China.\footnote{16} Among other products, Nike planned to sell its genuine AIR JORDAN brand shoes in China. In 2009, Nike filed at least five trademark applications for JORDAN, including for sports bags, clothing, and footwear.\footnote{17} However, protection for its JORDAN brand in China


\footnotetext{14}{China Trademark Reg. No. 605003.}

\footnotetext{15}{China Trademark Reg. No. 643806.}


\footnotetext{17}{China Trademark Office records show application numbers 7350128, 7752571, 7752572, 7752573, and 7752574, filed in 2009, since marked invalid.}
was blocked by Qiaodan Sports’ earlier filed QIAODAN registrations on the basis that JORDAN was likely to be confused with QIAODAN. They were opposed, and did not register. In addition, at least thirty other companies and individuals all over China had filed at least forty different applications for QIAODAN trademarks in a variety of classes and subclasses.

In 2012, newspapers reported that Michael Jordan filed to invalidate about 80 trademark registrations held by Qiaodan Sports. Michael Jordan also published a video in English in which he asserted that “Qiaodan” is “his name.”

At least one online survey found that 51.2% of roughly 200,000 Internet users believed that the Fujian company did not infringe on the American athlete’s name. In contrast, another online survey showed that a majority of roughly 3,000 Chinese Internet users surveyed online believed that the QIAODAN brand should belong to Michael Jordan, but also that the respondents knew of Qiaodan Sports, and expected the American athlete would lose the dispute. This latter finding indicates that consumers knew the athlete was not the registrant of the QIAODAN brand, but nevertheless felt he should have property rights to the name.

18. Some of the decisions were issued by the Trademark Review and Appeal Board, which handles appeals from the Chinese Trademark Office. The parties’ arguments and the reasoning of decisions is not part of the public record. Only the final status of a registration/application is listed on the Trademark Register, [sbj.saic.gov.cn/sbcx/], therefore the author’s conclusions are based on logical inference. The author concludes that some appeals were filed, but were not successful.

19. The author’s search of the China State Administration for Industry and Commerce’s Trademark Office Trademark Register, [sbj.saic.gov.cn/sbcx/] lists a variety of entities in Beijing, Shanghai, Wuxi, Guangzhou, and many individuals, as registrants of QIAODAN trademarks in different classes.


22. “Among 200,000 Sina.com online participants in a Sina Qiaodan Litigation opinion poll, 51.2% said they considered Qiaodan Sports did not infringe, 44.4% considered the [company’s] actions constituted infringement, and 4.4% said they were unsure.” Jumpman Qiaodan sues Qiaodan Sports Infringement Case China Legal Daily, April 27, 2013, (乔丹诉乔丹体育侵权案开审), http://www.legaldaily.com.cn/legal_case/content/2013-04/27/content_4418427.htm.


24. Id. Eighty-two percent of roughly 1,400 online voters selected that they support “Qiaodan himself” over the Chinese company Qiaodan, but only 55% believed Michael Jordan would win the law suit.
However, online surveys are notoriously unreliable given the uncertainty of the survey population and the possibility of multiple votes by each participant, and so courts do not rely on them.

In December 2015, the China Supreme People’s Court issued decisions rejecting Michael Jordan’s claims that the Beijing High Court, Beijing First Intermediate Court, the Trademark Review and Appeal Board (“TRAB”), and the Trademark Office erred in rejecting his invalidation actions against Qiaodan Sports’ registrations for QIAODAN. Each registration was handled as a separate action, and the Supreme People’s Court has posted sixty similar decisions on its website.25

In its decision on the Class 25 registration for QIAODAN in pinyin,26 for example, the Supreme People’s Court briefly summarized the dispute and stated that the Beijing High Court did not err in its decision.27 The Beijing High Court decision has a fuller discussion of the evidence presented by both parties.28 It stated that Qiaodan Sports’ registration of QIAODAN was recognized as a famous Chinese trademark, and that the company’s nearly 200 registrations for related marks were connected to its business and did not count as trademark squatting.29 The Court listed the evidence of the company’s investment in the trademarks, and concluded that there was no violation of law or procedure in the lower court or Trademark Review and Appeal Board rulings.30

The Court also listed the evidence submitted by Michael Jordan, mostly dated after 2010, including a consumer survey conducted on April 10, 2015. The Court noted that Michael Jordan’s evidence of fame in China and evidence of consumer confusion were not relevant to his claim that Qiaodan Sports’ trademark registration was obtained by fraud, or constituted an immoral trademark.31 To those who believe that Qiaodan Sports

25. Decisions are accessible at http://wenshu.court.gov.cn/list/list/?sorttype=1&conditions=searchWord+QWJS+++%E5%85%A8%E6%96%87%E6%A3%80%E7%B4%A2.%E8%BF%88%E5%85%8B%E5%B0%94.%E4%B9%94%E4%B8%B9.


27. China Supreme Court, Case No. 312 (2015), 知行字第312号, published Mar. 17, 2016, at: http://wenshu.court.gov.cn/content/content?DocID=b956be8e-fc3c-4223-8793-6e5435665703&KeyWord=乔丹体育|1477414. Each decision relates to a specific and separate trademark registration.

28. Beijing High Court, IP Tribunal, Case No. 1053 (2015), 高行（知）终字第1053号, citing to Trademark Registration No. 3208768, designation of QIAODAN as a Famous Mark, published at: http://wenshu.court.gov.cn/content/content?DocID=498450f3-0c-22-46e0-a74e-0ea41bfc946&KeyWord=.

29. Id.

30. Id.

31. Id. The statement can be read to mean that Michael Jordan’s fame as QIAODAN in 2010 and later is not relevant to prove that QIAODAN was his famous trademark in 1999, when the registration issued.
engaged in deliberate free-riding on the fame of Michael Jordan, the decisions were deeply dissatisfying. The inference that must be drawn from the Court’s decisions is that Michael Jordan did not have prior rights to the name and mark QIAODAN.

The High Court decision stated that “Qiaodan” is a translation of part of Michael Jordan’s name but not his actual name, and so registration of QIAODAN did not qualify as a fraudulent registration. The Court specifically stated that it is not proper to try to apply the immoral trademark category to Qiaodan Sports’ registration, and that use of a trademark causing consumer confusion does not make a trademark immoral, or qualify it as obtained by fraud or other improper means.

The Court’s decisions are economical in expression, but the findings are clear. The import of the finding is that there was no improper action by Qiaodan Sports even if its trademarks engaged in free-riding on the association with the American athlete. Interestingly, the Court did not mention several allegations that were reported by the media and would seem to have supported a finding of bad faith registration. These include the allegation that Qiaodan Sports registered the number “23” and the names of the athlete’s sons, the exact photo of Michael Jordan from which Qiaodan Sports derived its logo, and that Qiaodan Sports made the incredible argument that the name “Qiaodan” was not meant to refer to the American athlete, but instead to a type of South Asian plant. Finally, the Court made no mention of the video in which Michael Jordan claimed Qiaodan to be his “own name.” The media reports could be wrong, and perhaps some of these are not true facts, or they were not raised by Michael Jordan at the Beijing

32. China Trademark Law, Article 13, prohibits registration of “a reproduction, imitation, or translation of the famous mark of another.” In addition, Article 45 provides that the five-year statute of limitations shall not apply where the filing was made with “ill will.”

33. PRC Trademark Law, Article 10 (8) provides:

The following words or devices shall not be used as trademarks:

7) Those in the nature of fraud in advertising that easily confuses the public with the quality or other characteristics or origins of the goods, or the place of origin of the goods;

8) Those detrimental to socialist morals or customs, or having other unhealthy influences.

34. PRC Trademark Law, Article 44 (prior to the 2014 amendments, Article 41), provides: “Where a trademark registration violates the provisions of Articles 10, 11, and 12 of this Law, or the registration of a trademark was acquired by fraud or any other improper means, the Trademark Office shall invalidate the registration at issue.”

High Court level. The public record is limited to the decisions published on the courts' websites.36

Many have criticized the court decisions, and by implication, the legal system. The intentional free-ride on the association with Michael Jordan causes Westerners to wonder why Chinese authorities don’t stop Qiaodan Sports. Western media, and even some Chinese media, cried out that Michael Jordan had been denied rights to “his own name.”37 The intent here is to more fully explore the issues, as well as other cases to determine whether Chinese authorities could find in favor of other foreign brand holders in similar circumstances in the future.

II. ANALYSIS

A. Michael Jordan as Emblematic of Many Western Brands

Michael Jordan’s problem symbolizes that of thousands of foreign companies in China. As China’s consumers now have the freedom and money to buy global brands, foreign companies are entering the Chinese consumer market. But many are finding themselves blocked by local companies that have already registered the foreign brand in China. Although China implemented Article 6bis of the Paris Convention38 in its Trademark Law prior to its accession to the World Trade Organization in 2001, its protections are not available unless a mark is famous or has at least achieved a degree of notoriety in the


38. The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

In the past, many world-famous brands were not distributed in China, or were too expensive for Chinese consumers, or were not marketed in a way that attracted Chinese consumers. Thus, many brands famous in the West cannot provide evidence of fame in China at an early enough date. In the meantime, Chinese adopters of the same mark can grow into full-on competitors, using the exact same name to block the foreign company from selling to consumers in China. The aggressive manner in which Chinese companies and individuals seek out foreign names and brands, and then register exclusive trademark rights in order to sell their exports, perpetuates China’s reputation as the source of most of the world’s pirated goods.

The claims by a foreign celebrity in China exceed these purely trademark issues and implicate other theories as well, because the situation involves the name of an individual. The dispute then raises other novel questions in the age of globalization, such as how we define and identify a name when we traverse linguistic and cultural borders. Western nations with multiethnic populations face similar questions domestically, but the shift from romanized languages to ideogram-based languages is relatively recent. In addition, the use of Romanization for foreigners’ convenience in describing Chinese characters raises greater problems for transnational branding and name protection. The dispute between the American athlete (Michael Jordan) and the Fujian company (Qiaodan Sports) highlights the mismatch between phonetic and non-phonetic languages in the environment of rapid globalization. Perhaps the mismatch will become merely an anomaly from a time when China’s consumers and

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39. China Trademark Law, Article 14, provides:

A famous trademark, based on the parties’ request, can be defined when the facts in each case dealing with the relevant trademark support such a conclusion. The following factors shall be considered in making such a determination:

1) The degree of public recognition of the mark in its trading areas;
2) How long the mark has been in use;
3) The duration and extent of advertising and publicity of the mark, and the geographical extent of the trading areas in which the mark is used;
4) The protection of the mark as a famous trademark;
5) Other reasons for the fame of the trademark.

In examining a trademark registration and in the course of investigating cases involving illegal use of trademarks, the Authorities for Industry and Commerce may, upon a claim filed by the parties involved, in accordance with Article 13 of this law, the Trademark Office may make a determination as to whether a trademark is a famous trademark.

In the process of handling a trademark dispute, the parties may, in accordance with Article 13 of this law make such claims in regard to whether a trademark is famous; The Trademark Review and Adjudication Board may, in accordance with the needs of a specific case, make a determination as to whether a trademark is famous.
manufacturers opened to the world, but the rest of the world hadn’t yet caught up with the changes in China.\textsuperscript{40}

\textbf{B. Available Legal Theories}

Unlike most companies that can only claim rights under commercial laws, a celebrity can claim a fundamental right of personality that takes priority over trademark and other commercial rights. Under China’s General Principles of Civil Law, a subject-matter-specific statute should be applied wherever possible, and if not possible, the next most applicable statute should be applied, and if none are applicable, the General Principles of Civil Law should be applied.\textsuperscript{41} A celebrity therefore has five different potential arguments to try to reclaim prior rights in a Chinese version of his or her name or brand from a Chinese brand usurper:

1. Trademark Law Claims:
   a. Famous Trademark;
   b. Bad Faith Registration;
   c. Immoral Trademark.

2. Civil Law Claims:
   a. Right Against Anti-Unfair Competition;
   b. Right of Personality.

\textbf{1. Trademark Law Claims}

Given the popularity of Michael Jordan in China, and his assertion that his name in China is “Qiaodan,” many people are puzzled why the dispute wasn’t resolved in his favor. It might seem sufficient that Qiaodan Sports registered with the intention to refer to the famous American athlete in the knowledge that the athlete had multimillion dollar licensing deals for his name on sportswear and shoes. But the issues are complex and intertwined.

\textbf{a. Famous Trademark}

In accordance with China’s obligations as a member of the World Trade Organization and the Paris Convention, famous

\textsuperscript{40} In the author’s opinion, translation between non-phonetic languages and phonetic ones is more complex and less direct than between two phonetic languages.

\textsuperscript{41} China’s Legislation Law, Article 92, provides:

In the case of national law, administrative regulations, local decrees, autonomous decrees and special decrees, and administrative or local rules enacted by the same body, if a special provision differs from a general provision, the special provision shall prevail; if a new provision differs from an old provision, the new provision shall prevail.
trademarks are protected, even absent registration.42 However, marks that are famous in other countries are not necessarily famous in China. The Trademark Law provides for means to invalidate registrations of a famous mark by someone other than the original rights holder.43

Unusual names with high levels of publicity have received trademark protection against local opportunists who seek to own a foreign name, even for goods or services not marketed by the celebrity. For example, Beyonce successfully opposed BEYONCE for clothing and BEYONCE COFFEE for restaurants, based on her famous unregistered trademark in musical performances.44 The fact that she advertises her performances in China by the single name, in very significant volumes and scale, appears to have been accepted as evidence of fame allowing protection beyond musical performance services.45 However, it is more difficult to challenge Chinese versions that sound similar but are not the exact name or mark, as in the QIAODAN case.46 If registrations that are not successfully challenged later become successful, the owners will be in the same position as Qiaodan Sports; the Chinese company could claim in the future that their own investment, not the foreign celebrity’s efforts, built the brand in China.

As a counter-example, a local company tried to build a business on a famous foreign trademark, using a lawful

42. China Trademark Law, Article 13, provides:
Should any rights of a trademark well known to the relevant public be infringed, the trademark holder can follow the relevant provisions in this law to request the protection of the said famous trademark.

Where a mark is a reproduction, imitation, or translation of a third-party’s famous trademark that has not been registered in China and where the goods are identical or similar, which may cause public confusion and damage the interests of the registrant of the famous mark, no registration shall be granted and the use of the mark shall be prohibited.

43. China Trademark Law, Article 45, provides:
Where a trademark registration violates the provisions [on protection of famous marks, bad faith, geographic descriptiveness, etc.], any holder of prior rights or any interested party may, within five years from the date of registration, request that the trademark Review and Adjudication Board make a ruling to invalidate the trademark’s registration. Where the registration was obtained with ill will, the owner of a famous trademark shall not be bound by the five-year limitation.

44. For example, China Trademark Applications No.: 6080044 in Class 25, marked “Invalid,” and No.: 6853164 in Class 43, marked “Invalid.”

45. Decisions are not usually publicly available, and generally contain limited reasoning. This is the logical inference from the note that the application/registration is “invalid.”

46. There are currently two common transliterations of Beyonce (碧昂丝 and 碧昂斯, both pronounced Bi Yan Si, although others are possible, and Bei Yang Sai sounds more like the American pronunciation of the singer’s name). As of spring 2016, there were 15 trademark applications for 碧昂丝 and 8 more for 碧昂斯 in various classes. Some applications have been rejected, but others have been approved to various owners.
registration of a trade name registration, but the case was decided in favor of the foreign company on Trademark Law grounds. In 2007, the Shanghai Intermediate Court found that a local company that incorporated and operated a chain of coffee shops as 星巴克 (pronounced “Xing Ba Ke,” written “Hsing Pa Ke” in Wade-Giles), violated the registered Chinese trademark of Starbucks.\(^\text{47}\) The local company had lawfully registered a corporate name, invested in its copycat business model, and established cafes in Shanghai.\(^\text{48}\) It claimed that it had followed the letter of the law and registered an available company name, not a trademark.\(^\text{49}\) However, the Shanghai Court found that the company used its trade name on menus and signboards, as a trademark, to mislead consumers.\(^\text{50}\) The Court ordered the company to change its company name registration, and awarded damages of RMB500,000 to Starbucks.\(^\text{51}\)

Nevertheless, it is important for a foreign celebrity or brand owner to take control of a Chinese version of their name by registering and using it. It can serve as the basis for opposing future imitations using Chinese characters.

\textbf{b. Bad Faith Registration}

To claim bad faith registration in China, one must show either objective evidence of violation of agency and duty,\(^\text{52}\) or the usurpation of prior rights.\(^\text{53}\) In Michael Jordan’s example, Qiaodan

\begin{itemize}
  \item \(^\text{48}\) \textit{Id.}
  \item \(^\text{49}\) \textit{Id.}
  \item \(^\text{50}\) \textit{Id.}
  \item \(^\text{51}\) \textit{Id.}
  \item \(^\text{52}\) China Trademark Law, Article 15, provides:

Where an agent or representative, without the authorization of the principal, seeks to register in the agent’s name the principal’s trademark, and where the principal objects, registration shall be refused and the use of the mark shall be prohibited.

Where a trademark used on an identical or similar product that is considered for registration and that is identical or similar to a prior use of an unregistered trademark, where no prior contractual agreement or business relationship exists between the registrant and the prior user, [the applicant] may not register its trademark where the prior user files an opposition, and the prior user’s mark is clearly in use.

\item \(^\text{53}\) China Trademark Law, Article 15, provides: “No trademark application shall infringe upon another party’s existing prior rights. Nor shall an applicant rush to register in an unfair manner a mark that is already in use by another party and enjoys substantial influence.”
\end{itemize}
Sports and its founder had no relationship to him, and so had no duty to him not to use the mark. Prior rights include those created by investment and promotion of a trademark to create fame or “substantial influence.” A trademark registered in order to unfairly take a free ride on the “substantial influence” of another can be invalidated. Absent a prior relationship, or trademark registration, prior rights are most likely to stem from the fame of a trademark. The courts in Michael Jordan’s cases found no evidence that QIAODAN was the famous trademark of Michael Jordan prior to the registration by Qiaodan Sports. Therefore, the athlete’s claims of bad faith registration were rejected.54

While it is clear that as early as the 1980s there has been an association between Michael Jordan the basketball player and the name “Qiaodan,” the difficulty is to demonstrate that the fame of QIAODAN should accrue trademark rights for him. As Michael Jordan never directly used or licensed the name “Qiaodan,” he could only provide evidence for the similar mark JORDAN, not QIAODAN. He could claim that he provided basketball services under the name “Qiaodan,” but a Chinese court is likely to find that the player was contracted for services in the United States under the name “Michael Jordan,” not under the name “Qiaodan.” There was no transaction for basketball services by the athlete in China under the name “Qiaodan” and therefore no trademark.

In another example involving Nike in China, Nike filed to register the trademark LEBRON JAMES in Chinese 勒布朗・詹姆斯 (pronounced LEBULANG ZHANMUSI) in 2005,55 but found that a squatter had already beat them to it.56 Nike successfully opposed the blocking mark, eventually allowing Nike’s own registration to proceed, but only after Nike won the highest and final level of court appeal with China’s Supreme People’s Court in July 2015.57

Similarly, the Beijing High Court upheld a decision by the Beijing First Intermediate Court to overturn the TRAB and Chinese Trademark Office decisions against FACEBOOK’s opposition to a Chinese individual’s registration of FACEBOOK for beverages in 2011.58 The TRAB decision found that since FACEBOOK was not famous for beverages, it was available to the

54. See supra note 28.
56. China Trademark App. No. 4001053. The China Trademark Register shows that the registration was opposed by Nike in 2010, opposition was granted, then unsuccessfully appealed by the registrant.
57. China Trademark Reg. No. 4903847 for LEBRON JAMES in Chinese. Supreme People’s Court decision (2015) Xing Ti Zi No. 7 available at: http://wenshu.court.gov.cn/content/content?DocID=50e74db98-3b47-46d2-8f72-0522db98efba &KeyWord=%E5%8B%92%E5%B8%83%E6%9C%97.%E8%A9%B9%E5%A7%86%E6%96%A F.
local company. The First Intermediate Court's reversal did not explicitly find fame for Facebook Inc.'s China registrations, but the finding is implied in upholding the opposition on the grounds of the need to protect the principle of good faith dealing in the Chinese market.

Since China follows the Civil Law system, the decision is not binding precedent. However, the difference with Michael Jordan's actions are obvious. First, there is no dispute that FACEBOOK is exactly the trademark and service mark of Facebook, Inc. Second, and most importantly, the registrant had not built up a business making open and obvious use of his registrations for many years before Facebook filed its action. Also, the registrant's many registrations for “other famous trademarks” were noted as a factor in ruling that the FACEBOOK registration was invalid. However, similar evidence of intent raised against Qiaodan Sports appears to have been ignored as not relevant to a company that made open and long-standing use. Such cases demonstrate that vigilant enforcement under the Trademark Law is needed to protect even Chinese transliterations of famous foreign names.

However, a finding that Qiaodan Sports had registered the QIAODAN trademark in bad faith after so many years of use would have been surprising. As a first-to-file jurisdiction, where many foreign companies have no interest in paying to register a trademark that they don’t plan to use in China, China’s Trademark Office has registered many famous foreign brands to local companies. If a brand is famous in China, and ideally, famous and unusual, the owner can invalidate the infringing registration, as demonstrated by cases like Beyonce’s and Facebook’s. However, fame in China is a very high bar, and most brands cannot achieve it. If a brand is famous in its home jurisdiction but not famous or used in China, a domestic company may claim registration for itself and develop the brand.

While Western media have generally expressed outrage over the trademark decisions against Michael Jordan, the decisions have parallels with U.S. reasoning for treatment of foreign famous trademarks. The laws of China are designed to protect consumers in China, not distant foreigners. The U.S. Patent and Trademark Office and the U.S. Court of Appeals for the Federal Circuit have also consistently declined to protect distant foreigners who failed to use their marks in U.S. commerce but later seek to remove the U.S. registrations of competitors.

60.  (2015) Jing Xing Zhong Zi No. 475, ((2016)京行终475号) (available at http://www.ciplawyer.cn/article.asp?articleid=18827). The Court did not mention that Facebook's website has been blocked in China for many years.
61. See supra text accompanying note 30.
In the 1980s, a U.S. company registered a U.S. trademark in a mark copied from a Japanese supplier. The Japanese company first registered PERSON’S as a trademark for clothing in Japan in 1977. (The record does not tell us whether or how the name was presented in Japanese.) The company’s sales grew and it began selling to U.S. wholesalers, and eventually planned to enter the U.S. market in the 1980s.

Mr. Christman, a U.S. clothing wholesaler, visited the Japanese company’s retail shop on a trip to Japan. Upon return to the United States, after consulting with U.S. legal counsel, he planned his own business for PERSON’S brand jeans. He apparently copied the designs of the products he purchased from the Japanese company, and used the same mark on clothing he produced and sold as early as 1982. In 1983, both Christman and the Japanese company applied for trademark registration for PERSON’S. Christman received a registration of PERSON’S for apparel in 1984, and the Japanese company received the trademark registration for PERSON’S for luggage, clothing, and accessories in 1985.

In 1986, the Japanese company’s U.S. advertising made Christman aware of its activities, and Christman filed to cancel its U.S. registration. The Japanese company alleged that it had begun selling to U.S. resellers in 1982, seven months prior to the earliest U.S. sales by Christman. However, the TTAB decided that Christman was the good faith senior user of the trademark in the United States. “The Board found no evidence to suggest that the PERSON’S mark had acquired any notoriety in this country at the time of its adoption by Christman,” and absent such evidence, the Japanese company did not have senior rights to the mark in the United States. The Court noted, “[k]nowledge of a foreign use

62. Person’s Co., Ltd. v. Christman, 900 F.2d 1565 (Fed. Cir. 1990). The Court of Appeals for the Federal Circuit upheld an appeal from a Trademark Trial and Appeal Board (“TTAB”) decision cancelling the Japanese company’s U.S. trademark registrations in the brand it had created. As many will remember, the TTAB found that the Japanese company’s registrations of PERSON’S for clothing were confusingly similar to prior registrations by American Larry Christman.

63. Id. at 1566.
64. Id. at 1567.
65. Id.
66. Id.
67. Id.
68. Id.
69. Id.
70. Id.
71. Id.
72. Id.
73. Id. at 1568.
does not preclude good faith adoption and use in the United States.”74 The Board adopted the view that copying a mark in use in a foreign country is not bad faith use unless the foreign mark is famous in the United States or the copying is undertaken for the purpose of interfering with the prior user’s planned expansion into the United States.75 The Court declined to find that the Japanese company planned expansion into the United States, despite evidence of sales to U.S. wholesalers in 1982.76

In another U.S. example, a foreign company unsuccessfully asserted that its famous foreign trademark should preclude a U.S. squatter. In *ITC v. Punchgini, Inc.*,77 an Indian company that owned a chain of restaurants in India sued a New York company operated by the former employees of a closed U.S. location.78 The New York restaurant copied ITC’s trademark BUKHARA, its logo, as well as much of the trade dress of its restaurants, including the décor, menus, and uniforms.79 The Court of Appeals for the Second Circuit found that the Indian company had abandoned its trademark in the United States.80 The Second Circuit further held that Article 16(2) of the Agreement on Trade-Related Aspects of Intellectual Property Rights81 and Paris Convention 6bis are not self-executing, and that there was no basis in the Lanham Act for protection of BUKHARA on the grounds of its use or fame in India, and to do so would exceed the fundamental principle of territoriality.82

In contrast, in *Grupo Gigante S.A. de C.V. v. Dallo & Co.*,83 the Court of Appeals for the Ninth Circuit took a global view, perhaps influenced by the high rate of travel and immigration of the population of the Western states. The Court evinced a desire to ensure that consumers were not misled by U.S. knock-offs of overseas brands,84 a concern not expressed by the Federal Circuit

74. *Id.* at 1570.
75. *Id.* at 1570.
76. *Id.* at 1567.
77. 482 F.3d 135 (2d Cir. 2007).
78. *Id.* at 144.
79. *Id.*
80. *Id.* at 153.
82. *Id.* at 163. But see infra note 92 and accompanying text discussing Belmora LLC v. Bayer Consumer Care AG, 819 F.3d 697 (4th Cir. 2016), which may complicate this position.
83. 391 F.3d 1088 (9th Cir. 2004).
84. *Id.* at 1098. (“The court should consider such factors as the intentional copying of the mark by the defendant, and whether customers of the American firm are likely to think they are patronizing the same firm that uses the mark in another country.”)
in Person’s. The Ninth Circuit found that without such an exception, an absolute territoriality rule “would promote consumer confusion and fraud.”

The China Supreme Court’s view in the QIAODAN case is consistent with the decisions in Christensen and ITC. The local company that invested in and developed the brand was found to be the rightful owner of the brand, despite evidence of a foreign party with conflicting claims. Mr. Christman was more clearly an imitator since he copied the exact trademark of the Japanese company, while there is still a question of whether QIAODAN was a name or mark owned by Michael Jordan.

Also, the argument that QIAODAN is a person’s name does not necessarily strengthen trademark rights. Not all jurisdictions accept that celebrity fame increases trademark rights. For example, in the United Kingdom, the common law position has been the greater the fame of a name, the less distinctive it is as a trademark. The cultural expectation in the United Kingdom is that consumers buy items because they like the celebrity, not because they believe the celebrity is the source of the product, or stands for a consistent quality of manufacturing. This reasoning can be applied to Chinese consumers, particularly in the past. However, consumer expectations are changing. Chinese consumers are learning to expect that purchase of celebrity licensed goods is a form of economic support for the celebrity.

Usurpation of another’s brand may seem peculiar to China, but it is legally possible in most jurisdictions, including the United States, under the fundamental principle of territoriality. The difference between China now and most Western countries on the one hand, and China of 20 years ago on the other hand is the participation in and awareness of global consumer society. Thus this conflict may still be replayed many times in other developing countries with non-phonetic languages.

c. Immoral Trademark

In China, trademarks containing obscenities or references to illegal substances have been regularly rejected on the basis of immorality. The standard is stringent. Occasionally, a naive examiner misses an obscenity attached to a mark, and allows registration. But when such a mark is brought to the TRAB’s attention, the board will usually invalidate the obscene registration.

85. The Person’s decision has been cited favorably in 33 subsequent published federal trademark court decisions from 1990 to 2014.

86. Grupo Gigante, 391 F.3d at 1094.

In the Qiaodan trademark cases, the Court found no immorality in being the first to file a trademark where trademark rights are granted on a first-to-file basis, and the registrant was closely connected to the trademark by virtue of its use and investment. However, "trademark squatting," where authorities deem the registration was made only for the purpose of interfering with the rights of the foreign owner, not for use of the trademark in legitimate business, can result in loss of registrations. While the determination of squatting can seem subjective, two key factors are the similarity of the marks and the amount of use and development by the local registrant. Protection of Chinese transliterations of a foreign-language mark can be very difficult.

The Beijing High Court’s decision essentially requires a mark to be inherently immoral, rather than the result of opportunistic registration. In the United States, under Lanham Act Section 2(a), the test is similarly limited to the inherent nature of the trademark itself. For example, in In re McGinley, the Court of Appeals for the Federal Circuit ruled that the TTAB acted improperly in rejecting a trademark application on the ground that it indicated immoral services.

2. Civil Law Claims

In addition to actions on trademark grounds, a foreign celebrity or brand owner can consider filing a civil action to claim rights in a name under the Anti-Unfair Competition Law, or the Civil Code’s Protection of Personality.

a. Unfair Competition

China’s Anti-Unfair Competition Law protects individual or enterprise names and unregistered trademarks from use by another that causes confusion or misleads consumers. Proving
unfair competition requires showing that the name is used on famous products or services. In the QIAODAN case, even accepting that QIAODAN was famous in 1997, and showing Chinese media reports from the 1980s and 1990s to argue that Chinese media attention for “Qiaodan” is proof of Michael Jordan’s fame, Section 2 of the statute still requires the use of QIAODAN as a mark on commodities or services.\footnote{Id.}

Article 5, Section 3 seems to provide an alternative as it does not require fame. However, this section is interpreted to still require fame in order “to cause confusion between its commodities and those of the other enterprise . . . .”\footnote{See supra note 94.} According to the Supreme People’s Court, “The pen name or stage name of any natural person that has a certain [degree of] market popularity and is acknowledged by the public concerned may be ascertained as a name as stipulated in Subparagraph (3) of Article 5 of the Anti-unfair Competition Law.”\footnote{Sup. People’s Ct., Interpretation on Issues Concerning the Application of Law in Hearing Civil Cases Involving Unfair Competition, Fa Shi [2007] No. 2. (最高人民法院关于审理不正当竞争民事案件应用法律若干问题的解释) Supreme People’s Court Interpretations are advisory opinions providing binding guidance to lower courts in China.} Unless a celebrity can demonstrate that the stage name had some degree of fame in China at the time a local registrant began its competition, a claim of confusion under Section 3 will not succeed either. Many foreign companies have found that China’s Anti-Unfair Competition Law provides so little protection as to constitute none at all because it also requires fame in China, leaving the same problem as the Trademark Law. In the Michael Jordan case, even assuming fame for QIAODAN, there is the question of whether Michael Jordan can be said to have used “Qiaodan” as a stage name. Like a pen name, a stage name should be used by the nominee. The fact that Mr. Jordan never used the name for himself until 2012 seems a key weakness in such a claim. In contrast, the Lanham Act asks only that a plaintiff believe he or she has suffered harm. Section 43(a) of the Lanham Act does not require a trademark registration in order to prove a right to protection but asks if the accused user of a mark or name has made any misleading representation of fact.\footnote{“(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}
In a recent U.S. circuit court opinion, the Fourth Circuit ruled that the Lanham Act applies to protect consumers from misleading associations and advertising even when made by a U.S. trademark registrant, where it usurped the goodwill of a foreign trademark. *Belmora LLC v. Bayer Consumer Care AG* describes a situation parallel to the QIAODAN case. Bayer Consumer Care AG (“Bayer”) has owned the trademark FLANAX in Mexico since 1976, and marketed sodium naproxene under the mark. Bayer did not use the FLANAX brand in the United States, instead marketing the same medicine in the United States under the name “ALEVE.” In about 2004, an American company, Belmora LLC (“Belmora”) began to market sodium naproxene to the Spanish-speaking community in the United States under the FLANAX trademark. Belmora obtained a U.S. trademark registration for FLANAX. In advertising, Belmora stated, “For generations, FLANAX has been a brand that Latinos have turned to for various common ailments.”

The Court did not find that Bayer has trademark rights to FLANAX in the United States. However, it did note that Belmora’s trademark rights do not extend to deceiving consumers, and such deliberate efforts to mislead Mexican tourists visiting the United States, and Mexican-American consumers familiar with Bayer’s product, constituted a violation of Lanham Act § 43(a) protections against unfair competition. This decision is more similar in global outlook to the Ninth Circuit’s *Grupo Gigante* case, although that case was based on the Lanham Act’s unregistered trademark rights grounds rather than its unfair competition grounds.

Since the Lanham Act does not specifically require that the mark be famous before it can be protected, Bayer was able to
protect its Mexican brand, Flanax, in the United States, at least to some degree. Unfortunately for Chinese consumers, such protection is not extended in China unless a mark qualifies as made famous on commodities or services in China.107

b. The Right of Personality

China’s Principles of Civil Law provide that a citizen has the right to use his or her name and prevent others from usurping it or using it for false representation.108 As a fundamental protection under Civil Law, as opposed to a commercial right under the more specific Trademark Law, the right to one’s name takes precedence over trademark rights. This right is broader than the right to protection from unfair competition and does not impose any commercial requirement. A well-publicized case from 1999 illustrates the use of the concept in Chinese society.109 A high-school student’s name was usurped by a classmate when the classmate’s father, a village Communist party official, used the student’s name and exam score for his own daughter.110 The high-scoring student, with the unusual name “Qi Yuling,” was informed that she did not qualify for university and went on to a life of low-wage jobs.111 The official’s daughter went on to university and a job at a bank.112 The case came to light nearly 15 years later, after Qi Yuling learned of a bank official with the same unusual name and age as herself, who had attended the same school to which Qi Yuling had been denied entrance.113 Qi Yuling sued, and won an award for damages after appeal to the Shandong High Court.114

The right to one’s name in China begins with the inquiry as to the definition of someone’s name. For example, since many Chinese only know Michael Jordan by the name “Qiaodan,” it can be understood to be his name. But courts are tasked with enforcing the law strictly.115 With more than one billion people in China,

107. See supra notes 99-100 and accompanying text.
108. Principles of Civil Law, Article 99: “Citizens enjoy the right to their personal name and are entitled to determine, use, or change their personal names in accordance with relevant provisions. Interference, usurpation, and false representation of personal names are prohibited.” The statute extends to non-citizens by virtue of the Law on Choice of Law for Foreign-related Civil Relations, Articles 5 and 10.
110. Id.
111. Id.
112. Id.
113. Id.
114. Id.
115. PRC Statute on Judges, Article 7(2): “Judges shall perform the following duties: 1) to strictly observe the Constitution and laws; 2) to take facts as the basis, and laws as the criteria when trying cases. . . .” In addition, the PRC Household Registration Ordinance,
there are many names shared by many people. The statute does not provide examples of types of names other than personal names, nor does it include nicknames in its definition. Thus courts will normally interpret someone’s name to be the name on their identity card, or the name given at birth. Since the law states that everyone has the right to use his or her own name, the law does not contemplate a right so broad as to prevent others from the normal, non-commercial uses of their own names.

(1) Nicknames

This right is recognized as a growing area of economic rights. Some Chinese scholars suggest that nicknames, pseudonyms, and other associated names should be included in the definition of “name.” Reasoning from the function of a name, as that by which one is known to others, nicknames and other associated names should be included in protection as names. Given that many famous people are known by either a nickname or a portion of their full name, the absence of such protection could allow many third parties to free-ride on famous names to mislead the public. This is especially true given that China is building a consumer culture and foreign brands and foreign celebrities are now of great interest.

Foreigners’ names are often transliterated into Chinese characters to make them legible to average Chinese consumers. The transliterations often come from a standard reference dictionary, such as the one that lists “Jordan” as equivalent to “Qiaodan.” The translation dictionary evidence would also reveal that anyone else with the same foreign name would receive the same transliteration, so such evidence could undercut a foreign celebrity’s argument. For example, in Michael Jordan’s case, there

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Article 18: “Where a citizen wants to change his or her name, the following rules must be observed: 1) when under 18 years of age, the application should be filed to the authorities by a parent or guardian; 2) when over 18 years of age, the application should be filed to the authorities by the applicant.”

116. The PRC Law on Resident Identity Cards, Article 3, lists the items to be registered including, “name, gender, nationality, date of birth, address of permanent domicile, identity number,” etc., but does not define “name.”


are several U.S. professional athletes with "Jordan" as either a first or last name. In the NFL, there are such players as Cameron Jordan, Dion Jordan, and Jordan Reed. In the NBA, the very association in which Michael Jordan spent his career, other players bearing the name "Jordan" include DeAndre Jordan and Jerome Jordan.\footnote{See NBA Players – Letter J, Land of Basketball.com, http://www.landofbasketball.com/nba_players_index/letter_j.htm (last visited Feb 20, 2016)}

In determining a foreign celebrity's "name," a Chinese court would examine official documents that list the name of the foreign celebrity, which will be in Roman characters.\footnote{Legal transactions for foreigners in China rely on passports and use the foreigner's name in roman letters. If not a European name, a foreign name is expected to be spelled out in romanized form. The government does not use customary Chinese transliteration, or Chinese nicknames, for official actions related to foreigners.} It is therefore unlikely that Chinese character transliterations will qualify as a foreigner's name under the narrow language of Article 99, even though blanket denial of protection for Chinese character versions of foreign names amounts to a license to squatters and those who will mislead Chinese consumers.

On the other hand, Americans have the sense a name, even if common to others, should nevertheless belong to a foreign celebrity because the extensive use and publicity around their activities created the value of the name. This acceptance of the notion of created association is part of unfair competition law, but is increasingly reflected in American concepts of the right of personality and publicity. In the United States, the right is governed by state laws, and varies from state to state. For example, Washington State's law defines names to include "the actual or assumed name or nickname . . . that is intended to identify that individual. . . ."\footnote{Wash. Rev. Code Ann. § 63.60.020(6) (LexisNexis 2016) ("'Name' means the actual or assumed name, or nickname, of a living or deceased individual that is intended to identify that individual.")} By using the language "intended to identify that individual," the statute recognizes that an association created by others can create a right for an individual, and implies the individual can assume the name without officially registering such name.

The broad definition in Washington state law conceives of the name and personality as a property right.\footnote{New York State's Civil Rights Law sets forth a similarly broad concept linked to commercial exploitation.} New York State's Civil Rights Law defines names as a property right, and California's statute defines names as a property right. Under California's statute, names are
protected from use for commercial purposes by a third party.\textsuperscript{125} Under California common law, such protection is not limited to names, but extended to a person’s identity.\textsuperscript{126}

A question of ownership of identity arose for the New Orleans Saints football team, whose fans customarily cheer “Who Dat?” When the football team reached the Superbowl in 2009, 5 years after Hurricane Katrina destroyed much of New Orleans, the football cheer “Who Dat?” became famous around the United States. A poor understanding of trademark law and a desire to “get rich, quick” motivated many Americans to file numerous applications to the USPTO to register WHO DAT as their trademark, particularly for apparel and items to be sold at the Superbowl.\textsuperscript{127} Nearly all of the over fifty applications have been rejected or abandoned.\textsuperscript{128} One company, Who Dat? Inc., was able to prove that it had, in fact, used the trademark in interstate commerce, so it has emerged as the owner of several registrations.\textsuperscript{129}

Many Saints fans were angered that one company obtained exclusive rights to a collective, spontaneous chant.\textsuperscript{130} Many felt that the cheer belonged to all the football team’s fans, and should not be the exclusive property of one company. Some felt the mark should belong to the team or the NFL. However, under U.S. trademark law, since one company was able to prove that it had used the mark as a designation of source of origin, before others, it

\begin{itemize}
  \item \textsuperscript{125} Any person who knowingly uses another’s name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person’s prior consent . . . shall be liable for damage sustained by the person . . . injured . . .
  \item \textsuperscript{126} The Federal Court for the Sixth Circuit similarly found that identity was not limited to a person’s name or image, in Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831, 836 (1983).
  \item \textsuperscript{127} Search of U.S. Patent and Trademark Office Trademark Register, tmsearch.uspto.gov (last visited Mar. 1, 2016) (running search query "("who dat")[COMB]").
  \item \textsuperscript{128} See, e.g., U.S. Trademark Reg. Nos. 4310960 and 4385857.
  \item \textsuperscript{129} See supra note 127.
\end{itemize}
acquired trademark rights.\textsuperscript{131} Despite the collective cheer’s association with, and arguable identification of, the football team, the trademark rights belong to the one company who made trademark use of the phrase.

(2) Names in the Global and Multicultural Context

Washington and California’s state statutes make use of broad definitions of “name,”\textsuperscript{132} rather than requiring the determination of a “real name.” This is appropriate in a society where there are many people with names from all around the world. Names in the United States are no longer uniformly composed of a Christian name and surname. Immigrants and foreign celebrities used to select a name that would fit into American society. Now it is common for people to retain a foreign name, but spell it in romanized form. Contrast the name of Chinese-American actress Joan Chen with the younger actress Zhang Ziyi. To stay with only Chinese examples, and leaving aside the many other examples of non-phonetic languages, the geographic and linguistic range of Chinese names from many different dialects of Chinese, plus immigration from different parts of Southeast Asia, create a wide variety of legitimate possible names for individuals of Chinese ancestry.\textsuperscript{133} It can be difficult to determine exactly the “real” or definitive version of a Chinese name in a foreign country. For example, celebrities from Chinese-speaking regions who are famous in the United States include martial arts and comedy actor Jackie Chan (成龙 pronounced “Cheng Long” in mainland China, and written as 成龍 in all other Chinese-language jurisdictions), or martial arts actress Michelle Yeoh (杨紫琼 pronounced “Yang Zi-qiong” and written as 楊紫瓊 outside of mainland China, but pronounced “Yu Chih-kheng” in her native Hakka dialect).

Each of these famous people was born with an official name, but each is known to the public in different countries by a different name.\textsuperscript{134} When travelling to the United States, for work or immigration, they must convert their name into a romanized form. Such version becomes their official name in the United States. However, some U.S. consumers who read Chinese, or speak

\textsuperscript{131} Cf. Who Dat? Sues Saints, NFL and Louisiana, Courthouse News Service (Mar. 9, 2010), http://www.courthousenews.com/2010/03/09/25378.htm (describing lawsuit Who Dat!, Inc. filed asserting that the trademark was not in the public domain).

\textsuperscript{132} See supra notes 122, 125.

\textsuperscript{133} Phonetic languages, such as Arabic, Russian, etc. generally have a clear translation into English, even if regional pronunciations vary. With non-phonetic languages, the dilemma is whether to translate the meaning or transliterate the sound into the phonetic language.

\textsuperscript{134} Celebrities famous before 2000, or from Taiwan, Hong Kong, Malaysia, etc. often selected a Western first-name. However, many from mainland China do not select a Western name, and are only known by a pinyin Romanization of their Chinese name.
various dialects,135 could be deceived by a third party’s use of another version of the famous name, and arguably, such use could qualify as the use of a name under some state laws.

This issue of multiple names is not new, however. It has been common for writers and actors to use pseudonyms to protect a writer from critics or to enhance acceptance of a work (George Eliot, born Mary Ann Evans136) or due to Hollywood studio or Screen Actor’s Guild requirements (Frances Ethel Gumm to Judy Garland,137 or Marion Morrison to John Wayne,138 or Julie Ann Smith to Julianne Moore139). Under a strict reading of the Chinese statute, they likely would not receive protection for their pen names or stage names under Article 99.140

In contrast, under statutes such as those of California or Washington, any version of the name that is recognized as the name of that person, as long as the name is used in U.S. commerce, can be protected. Thus a celebrity in California or Washington State doesn’t need to choose between protecting, for example, “Jackie Chan,” or “Cheng Long.” Both are names by which the celebrity is known in commerce. And, as long as there is a commercial use of a name in interstate commerce, the Lanham Act may also apply, allowing for protection across the United States for a range of translations associated with the person, if used to mislead the public.141 Furthermore, even before there was a substantial Chinese-literate community in the United States, foreign language characters could be protected under U.S. law as a “symbol or device.”142

135. The U.S. Census Bureau reports that as of 2011, there were 2.31 million U.S. residents born in China. The Foreign Born from Asia, U.S. Census Bureau (Oct. 2012), https://www.census.gov/prod/2012pubs/aecsr11-06.pdf. In addition, there were roughly 300,000 mainland Chinese students studying in the United States by 2015, and additional Chinese readers from Hong Kong, Taiwan, and other Southeast Asian countries. Chinese Students in America: 300,000 and Counting, Foreign Policy (Nov. 16, 2015), http://foreignpolicy.com/2015/11/16/china-us-colleges-education-chinese-students-university/.


140. See supra note 112. However, pen names used commercially to provide services or goods in China would receive protection under the Anti-Unfair Competition Law. See supra note 98.

141. See supra note 98.

142. Id.
U.S. individual states’ laws’ often include a commercial element and focus on confusion to the public, reflecting more consumer protection than a law that defines “name” as strictly a person’s official name. This commercial element in U.S. state laws helps to narrow the protection so as to avoid prohibiting other people from using their own names for ordinary purposes. Thus the California name right, for example, is akin to a trademark right in one’s name. Would Michael Jordan be able to prevent others from using “Jordan” altogether as a name in the United States under the California law? It is clear that he could not, absent other factors. “Jordan” is not his name, only a portion of it. He cannot even prevent others who share his exact full name from using “Michael Jordan” for ordinary activities of regular life. However, if another individual named “Michael Jordan” sought to commercialize sportswear under the name “Michael Jordan,” after the athlete had already made it famous for related goods or services, such use would likely be found a violation of the California statute.

(3) Protection of Name Rights in Other Regions

There is another approach to name protection, followed for nearly forty years in Central America, for example. Four Central American nations signed a regional treaty in 1968 that created a registry of individuals’ names. The treaty required trademark offices to obtain authorization from living individuals whose name was the subject of third-party trademark applications. On this basis, Guatemala invalidated third-party trademark squatting registrations to RALPH LAUREN and CALVIN KLEIN, after years of litigation. If China had belonged to such a treaty,

143. There are nearly 4,000 individuals named “Michael Jordan” in the various U.S. telephone directories, according to a search of Whitepages.com.

144. This concept is not unique to California or even U.S. states. See, e.g., Decision of the Head of the Department of Industrial Property of Chile, August 23, 2002, Case No. 2637/01, Marco A. Pinochet et al. v. Augusto Pinochet H., where a man named “Augusto Pinochet” was prevented from using his birth name for a Chilean trademark in light of the similar name of the famous former leader.

145. Central American Agreement for the Protection of Industrial Property, June 1, 1968. The treaty was abrogated by the signatories on January 1, 2000, to be replaced in the future with another treaty. Thomas Andrew O’Keefe, Latin American and Caribbean Trade Agreements: Keys to a Prosperous Community of the Americas 239 (Martinus Nijhoff Publishers, 2009).

146. “The following may not be used or registered as trademarks or elements thereof . . . (h): names, signatures, patronymics and portraits of persons other than those applying for registration without the consent of such persons or, in the event of their decease, of their ascendants or descendants in the nearest degree . . .” Id., at art. 10.

147. Antonio Malouf Gabriel v. Calvin Klein, Guatemala Supreme Court of Justice (1999); see also Exclusividades Finas, Sociedad Anonima v. Inversiones San AugustIn, Sociedad Anonima, Case 59-94, Guatemala Supreme Court of Justice (1994).
applying the regional approach might change the result in the QIAODAN case, if Michael Jordan could have proved that QIAODAN was his name.

There are other jurisdictions with arguably broader protections for rights of personality. For example, in Italy, the concept has extended from name and image to the broader indicia of persona. In a famous case from 1984, *Dalla v. Autovox SpA*, the court found a knit cap and small, round glasses to be so closely associated with a certain celebrity as to prohibit the use of a similar hat and glasses in advertising by others.148 However, a Chinese lower court is unlikely to reason by analogy from the narrow definition of name in the statute to protect clothing and accessories, as did the Italian Court in *Dalio*.149

(4) Protection of Names in Domain Name Disputes

The issue of name protection has also arisen in the international context, with Internet domain name disputes brought by famous persons before a domain name arbitration body. Where the complainant can show trademark rights infringed, or consumers misled, the success rates have been higher.150 Even so, domain name arbitration panels have ruled that celebrities do not have exclusive rights to their names, and may have to allow use of their name for domain name registrations by others. Third parties can have legitimate interests in a celebrity name, such as operating a fan club or website.151 However, diverting business away from a celebrity’s business is not recognized as a legitimate purpose. For example, in an Internet domain name dispute proceeding before the World Intellectual Property Association (“WIPO”), the actor Pierce Brosnan was able to protect his name. He did so, however, on trademark grounds, demonstrating that his name was a famous, although unregistered, trademark because of his many product endorsement contracts.152 His name is composed of relatively unusual elements, unlike “Michael Jordan.”

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149. However, it is conceivable that such a claim could succeed, in a very unusual case, under China’s Anti-Unfair Competition Law.


Another WIPO domain name dispute proceeding panel found that the famous singer known as "Sting" did not have a superior right to the name "Sting" used in a domain name.\textsuperscript{153} While the case ruled for the defendant on other grounds, the panel noted that "sting" is a common word, and that twenty U.S. trademark registrations already existed in the word, none of them belonging to the man who performed under the stage name "Sting."\textsuperscript{154} Sting had never registered a trademark to the name, and it is not his real name.\textsuperscript{155} There was also no evidence that the user intended to take a free-ride on the fame of the singer known as Sting.\textsuperscript{156} Therefore, his effort to invalidate the domain name registration failed.

(5) Modifying the Definition of Name for Foreigners in China

The Chinese statute does not use a broad definition of "name," and does not mention commercial uses of a name.\textsuperscript{157} So under the narrow language of China’s Principles of Civil Law, Michael Jordan could not take exclusive ownership of the name "Qiaodan." Expanding "names" to include commercial rights may cause the fundamental right of personality to lose its supremacy over economic rights like trademark rights and the right of protection against unfair competition.\textsuperscript{158} Furthermore, as China is a civil law jurisdiction, judges are responsible to make rulings based on statutes as promulgated, without regard to other courts’ precedents as under the common law system.\textsuperscript{159} The right to expand the right of personality belongs to the National People's Congress, although guidance from China’s Supreme People’s Court could clarify the proper scope of the right. It is highly unlikely that many Chinese judges would extend the right of personality beyond the statute based on their own reasoning, without guidance from the Supreme People’s Court or legislative amendments. Under a narrow reading of China’s Principles of Civil Law, foreign celebrities will have difficulty claiming a right in a Chinese name.

The cost of such a narrow reading, however, is high. It effectively eliminates the right of personality as a form of protection available to foreigners, since most foreigners in China

\textsuperscript{154} Id.
\textsuperscript{155} Id.
\textsuperscript{156} Id.
\textsuperscript{157} See supra note 108.
\textsuperscript{158} See discussion around footnotes 41 and 115.
\textsuperscript{159} Id.
will become famous under a Chinese transliterated name, not their legal foreign name. The lack of such protection may result in continued deception and in Chinese consumer confusion. Only foreigners with sufficient fame in China will be able to receive protection, under the Anti-Unfair Competition Law, but not Article 99. On the other hand, the cost of granting a right to one person is to foreclose the public from use in the future. In general, China has been wary of granting private rights. Consumer confusion may be deemed an acceptable price.

There is another complication in applying the Chinese right of personality to a foreign plaintiff. The statute grants the right to citizens, but allows foreigners to assert the laws of their domicile. If foreign laws cannot be ascertained or there are no provisions in the laws of that country, then the laws of the People's Republic of China should apply. If that provision is interpreted to mean that the definition of a foreigner’s name should follow their home jurisdiction, it could include nicknames and could potentially change the outcome of the case in China. A foreign celebrity who can show that his or her home jurisdiction recognizes a broad definition of “name,” including multiple languages, might be able to claim several names “belong” to him or her. However, extra-territorial application of such an expansive standard in China is difficult to envision.

III. CONCLUSION

A fundamental principle of the rule of law is predictability. Citizens should be able to guide their own behavior by knowledge of right and wrong according to their social customs and legal system. China’s society and its legal regime have experienced so much dramatic change over the past forty years that it is not surprising that standards of behavior are unclear. Only forty years ago, the Great Proletarian Cultural Revolution was under way, capitalism and material wealth were reviled, China’s per capita

160. Law on Choice of Law for Foreign-related Civil Relations, Article 15: “The content of personality rights is governed by the law of the principle's habitual residence.”

161. Law on Choice of Law for Foreign-related Civil Relations, Article 10. The foreign Law applicable to a foreign-related civil relation will be ascertained by the relevant people’s court, arbitration body, or administrative agency. Where the parties have chosen foreign law to apply, they shall adduce the law of that country. Where the foreign law cannot be ascertained or the law of that country does not have a relevant provision, PRC law shall apply.

162. The World Justice Project, endorsed by the American Bar Association, has a four-part standard for the Rule of Law: . . .

“The laws are clear, publicized, stable and fair, and protect fundamental rights, including the security of persons and property.
GDP was $158,163, and Chairman Mao still ruled the nation. In just four decades, per capita GDP increased to $13,206, and in recent years China has become an economic powerhouse, sending over 100 million tourists out of China to see the world’s sights and to purchase foreign products.

The Chinese Trademark Law seeks to protect Chinese consumers by ensuring that they know the source of origin of products they purchase. It provides for a territorial first-to-file system with protection of unregistered trademarks famous in China. Under the principle of predictability, trademark registrations, if lawful when made, should be protected. In the QIAODAN case, when QIAODAN was first registered in 1997, it was reasonable to believe that foreign brands were too expensive to sell to Chinese consumers, and a local company using a Chinese transliteration of “Jordan” in the local market was not worth pursuing. Now China’s economic growth and more open markets allow Chinese consumers to purchase foreign brands, so they may be deceived by knockoffs made by local brand usurpers who follow the rules and are the first to file trademarks that sound like foreign brands.

If a foreign celebrity can demonstrate a certain degree of notoriety in China and takes action quickly before a squatter can turn into a competitor, the name can be protected. Vigilance by foreign brand owners is required to assert infringement of a famous but unregistered trademark, bad faith registration, or registration by fraudulent means under China’s Trademark Law. In the alternative, a foreign celebrity or brand owner can try to show that their unregistered name, trade dress, or mark has been used in commerce on goods or services, in order to claim rights under China’s Anti-Unfair Competition Law. Finally, a foreign celebrity or brand owner can try to claim the right of personality in China, under Article 99 of the General Principles of Civil Law. The right to one’s own name is a fundamental right, inscribed in the Civil Code, and so has priority over trademark rights, unfair

164. GDP Per capita, PPP (current international $), The World Bank http://data.worldbank.org/indicator/NY.GDP.PCAP.PP.CD) (last visited Feb. 15, 2016);
166. See supra Section II.B.1.
167. See supra Section II.B.1(a).
168. See supra Section II.B.1(a).
169. See supra Section II.B.2(a).
competition, and other specific commercial rights. If China follows international trends it will protect nicknames as part of the protection of names. But it is likely that the right will not be expanded, especially for commercial purposes, absent guidance from the National People’s Congress, State Council, or Supreme Court.170 So the question is whether a name applied by third parties for convenience when referring to a foreigner can qualify for protection as property of the foreigner.171

If the Court had accepted Michael Jordan’s claims, it would mean that the long and open promotion of a trademark in China would not strengthen trademark rights.172 It would have sent a strong message that technical compliance with the Trademark Law is insufficient, and would subject marks that potentially infringe on a foreign mark to challenge for an unlimited time. This might be desirable to some brand holders, but would seem to contradict other trademark principles. Such a decision would also contradict the principle of territoriality as shown in the U.S. decisions Persons and ITC,173 and instead follow the more globally oriented decisions in Grupo Gigante and Belmora.174 On the other hand, it appears that the Court ignored much of the evidence of intent to free-ride on the fame of Michael Jordan, in order to issue a clean decision on the grounds of use and investment in trademarks.

The case is an example of many that arose in the context of a rapidly changing Chinese consumer economy. American audiences and consumers are culturally accustomed to see a connection between athletes and sportswear. However, consumer culture is relatively new to Chinese consumers, so the connection is not as clear. Globalization has increased Chinese consumers’ awareness of foreign celebrities and brands in a greater shared culture. More Chinese consumers can now afford to buy foreign brands, so there is a greater chance that such brands can demonstrate fame in China. So while Michael Jordan and others had few sales in China on which to base a claim of fame in the past, the problem should ameliorate in the future.

However, this historical disparity is not entirely eliminated. Since the law in China favors the first to register, and foreign brands are only beginning to learn about Chinese consumers, it is likely Chinese consumers will be misled by trademark squatters for some years to come. Smaller foreign companies without the

170. See supra Section II.B.2(b)(v).
171. See supra Section II.B.2(b)(i). However, the use of the word “property” is loaded with undesirable connotations and should be reformulated by a potential plaintiff.
172. See supra Section II.B.2(b).
173. See supra notes 62 and 77.
174. See supra notes 83 and 99.
resources to enter the China market will still face the *Person’s* dilemma. Small companies will need to consider registration and licensing in China as soon as they achieve some success in Western markets, even if they do not desire global expansion themselves. Among the different grounds to protect a variety of property rights, trademark protection still offers the best means for foreigners to protect their names, brands, nicknames and any other associated names or symbols. The QIAODAN case is a reminder to foreign brand holders that early registration in China is an essential investment to protecting their rights in the future, and that China is a market and export platform that can't be ignored.
解读迈克尔·乔丹与乔丹体育股份有限公司案：
历史的异常还是保护中国消费者体系的崩溃？
杨文玉 著

一、事件背景
一九九七年，一家中国福建省的公司为了在国内市场行销运动系列服装，选择了一个足以激发活力并颇有新鲜感的名称——乔丹。

该公司于一九九七年申请注册了“乔丹及图”商标使用商品为游泳衣、鞋和雨衣。商标的图案部分是一名棒球球员在棒球场内转身准备去击打一个跃动的棒球。之后该公司继续用“乔丹”申请商标注册，其申请注册的四百六十个商标中有一百多个商标申请包含了中文“乔丹”，3和二十三号图4，或拼音“QIAODAN”。至二零零零年，该公司的销售收入已经达到了四点六亿美元，至二零一二年，

* The author of this piece produced both an English article and a Chinese summary article. INTA staff and members of The Trademark Reporter (TMR) Committee edited the English article, and the author then carried those edits to the Chinese summary article (where applicable). INTA staff and members of the TMR Committee have taken steps to ensure that the author’s intended meaning is preserved in both the English article and Chinese summary article; however, because of language limitations, INTA has not undertaken its normal editorial process with regard to the Chinese summary article and does not vouch for absolute translation accuracy between the two articles. INTA’s goal is to expose important non-English writing on trademark law issues to the broader audience of its TMR readership.

1. 加州执业律师，加州伯克利大学法学院法学博士。国际律所王和王律师事务所管理合伙人。在加州伯克利大学、苏州大学、康奈尔大学法学院和太平洋大学麦可乔治法学院教授《国际商事交易》、《国际知识产权》和《法律基础比较》等课程。在此感谢林晔和周晨的协助。本文作者与本文中讨论提及的任何团体或个人没有任何关系。
2. 注册号为1186599的中国商标。
3. 注册号为3018498的中国商标。
4. 注册号为3667082的中国商标, 第25类, 之后被撤回或撤销。
该公司在中国的分销商已逾五千七百家。五 二零零一年，该公司计划在上海证劵交易所挂牌上市。六

在中国，喜爱体育运动的人只要提起“乔丹”几乎都会与美国篮球明星迈克尔·乔丹画上了等号，且“乔丹”一词在许多网络参考资料中都被用作描述该名运动员。七

自一九八一年起，耐克公司就进入了中国市场，并于一九九一年向中国商标局就第二十五类商品申请注册了MICHAEL JORDAN商标。八 多年来，耐克公司在中国申请了多个商标，包括一九九三年在服装和鞋类上申请注册的“飞人图形”商标，九 与当时大多数欧美公司一样，耐克公司主要将中国作为采购和产品生产的基地。二零零九年，耐克公司就JORDAN商标注册至少提出过五次申请，商品涵盖运动包、服装和鞋类，十 但这些申请都被提异议了，最终未获得注册。十一 二零一二年，据媒体报导迈克尔·乔丹对福建乔丹体育公司所拥有的约八十件含有“乔丹”字样的商标注册分别提出了撤销申请。十二


7. 参见如，百度描述该运动员的网页，http://baike.baidu.com/view/19096.htm？fromtitle=%E4%B9%94%E4%B8%B9&fromid=30699&type=syn.百度列出了名为乔丹的数位个人和数家机构，包括一位英国女性名人和一家福建运动服装公司。

8. 注册号为605003的中国商标。

9. 注册号为643806的中国商标。

10. 中国商标局记录显示申请号7350128，7752571，7752572，7752573，7752574，于2009年提出申请，商标的状态已标为无效。

11. 一些决定是由负责商标争议的商标评审委员会作出的。当事人的理由和作出决定的依据不公开，仅公开最后的结果。因此作者的结论是基于从公开观点和意见中所得之事实而进行的逻辑推理。

据《法制日报》报导，至少一项网上调查显示，在接受调查的二十余万互联网用户中，百分之五十一点二的被调查者不认为福建公司侵犯了美国运动员迈克尔·乔丹的姓名权。与此相反，另一项网上调查显示，在接受调查的三千余名中国互联网用户中，大多数的被调查者认为乔丹品牌应当属于迈克尔·乔丹，且被调查者知晓福建公司并预测美国运动员将会败诉。这后一项调查结果表明消费者知道美国运动员并非乔丹品牌的注册人，但仍认为他应当对该名字享有姓名权。考虑到被调查人群的不确定性及每位参与者多次投票的可能性，网上调查被认为不可信的。

二零一五年十二月，中国最高法院裁定驳回迈克尔·乔丹就北京高院对乔丹商标撤销案所作出的二审判决的再审申请。目前，最高院网站上公布的有关乔丹商标争议案件的个案裁决就有六十多个。举例来说，在涉及迈克尔·乔丹申请第二十五类乔丹商标撤销案的高法院（2015）知行字第312号申诉行政裁定中，最高院在概述了各方诉辩主张后认为北京高院的判决并无不当，对迈克尔·乔丹的再审申请予以驳回。对于本案的争议焦点及认定，北京高院在(2015)高行（知）终字第1053

13. 在有20余万网友参加的新浪网“乔丹诉讼”民意测验中，有51.2%的人认为乔丹体育不侵权，44.4%的人认为（公司的）行为构成侵权，而4.4%的人选择了“不好说”。《“飞人”乔丹诉“乔丹体育”侵权案开审》法制网，2013年4月27日，网址：http://www.legaldaily.com.cn/legal_case/content/2013-04/27/content_4418427.htm


15. 同上。在约1400名网上投票者中，82%的投票者选择他们支持“乔丹本人”，而非中国的乔丹公司，但仅有55%的投票者认为迈克尔·乔丹最终将胜诉。

16. 注册号为1477414的中国商标。

17. 中国最高法院，案件号第三十一号（2015）(知行字第312号)， http://wenshu.court.gov.cn/list/list/?sorttype=1&conditions=searchWord+QWJS+++%E5%85%A8%E6%96%87%E6%A3%80%E7%B4%A2%2E%88%84%E8%BF%88%E5%85%8B%E5%B0%94%4E%4B9%94%4B8%9B
号判决书中作出了比较详尽的论述。迈克尔·乔丹认为其作为世界知名的美国篮球运动体育明星，在中国具有极高的知名度。经媒体报道，中国公众看到与“乔丹”、“QIAODAN”相同的或者相似的标识，就会将其与迈克尔·乔丹联系到一起。乔丹公司用乔丹申请注册为商标，属于《中华人民共和国反不正当竞争法》规定的违反诚实信用原则的行为，乔丹公司还大规模申请注册与迈克尔·乔丹相关的商标，扰乱商标注册秩序，属于《中华人民共和国商标法》第四十一条第一款“以其他不正当手段取得注册”所指情形，争议商标的注册和使用会造成公众对产品的来源产生误认，属于《商标法》第十条第一款规定的“有其他不良影响”所指情形。法院在审理中查明乔丹体育公司所注册的部分类别的乔丹商标已被认定为中国驰名商标，且福建公司注册的近两百个商标都与其业务相关联，非以不正当手段取得商标注册行为。法院列出了乔丹体育公司对商标所进行的投入，并认为一审法院及商标评审委员会所作出的裁决没有违反法律或程序。法院同时也对迈克尔·乔丹所递交的证据作出认定，大多数证据的日期都在二零一零年之后，包括在二零一五年四月十日做的一项消费者调查报告。法院认为迈克尔·乔丹有关其在中国知名度的证据，以及使用乔丹名称容易被消费者混淆的证据不能证明乔丹体育通过欺骗手段或不正当手段获得商标注册，也不构成有害道德的商标。

18. 北京高级法院，知识产权庭，案件号第1053号(2015)，高行(知)终字第1053号，引用第3208768号商标注册，乔丹商标被认定为驰名商标。判决书可在以下网址获取：http://wenshu.court.gov.cn/content/content?DocID=498450f3-0c22-46e0-a74c-0ea41bf0c946&KeyWord=

19. 同上。

20. 同上。

21. 同上。该陈述可理解为两千十年及之后乔丹作为迈克尔·乔丹名字的知名度无法证明在一九九九年乔丹商标获得注册之时其已是驰名商标了。
二、分析

（一）迈克尔·乔丹是诸多西方品牌的象征

由于中国消费者如今拥有购买全球品牌的自由度和财力，外国公司纷纷准备进军中国市场。但许多公司发现它们都被在中国已经注册了外国品牌的国内公司阻挡了。在某些情况下，中国的抢注者已发展成了羽翼丰满的竞争对手，利用相同的名称阻挠外国公司进入中国市场。

对于外国名人在中国的权利要求已经超出了纯粹的商标问题，也牵涉了其他理论，因为它涉及了个人名字。该争议在全球化时代提出了其他新问题，如当我们跨越语言和文化界限时是如何定义和确定名字的。

美国运动员与福建公司之间的纠纷反映了在快速全球化的环境中因使用表音文字和非表音文字所致的不匹配。乔丹案已超出了单纯的商品问题，而且由于它还涉及个人的姓名，所以还需考虑其他的理论。

该案引发了全球化时代的其他新问题，诸如当我们跨越语言和文化界限时应当如何界定和确定一个名称。拥有民族人口的西方国家在其国内就面临着类似的问题。但从罗马字语言转化为汉字语言及为方便外国人使用罗马字在跨国品牌化和名称保护方面提出了更严峻的问题。乔丹案可能是一个时代造成的异常，当时中国消费者和生产者向世界敞开了大门，而世界上的其他人尚未跟上中国发展变化的脚步。中国消费者通过电影、新闻和流行音乐等渠道对西方的了解远比西方人对中国消费者的了解多的多。

（二）适用的法律理论

由于商法下的权利是以在中国的商业使用和知名度为前提条件的，名人可以尝试争辩民事权以外的权利。其可主张优先于商标权及其他商
事权的作为基本权利的人格权。迈克尔·乔丹有五种可辩的论点以主张对“乔丹”的在先权利：

A）基于商标法的主张，包括：
1) 驰名商标；
2) 恶意注册；
3) 有害道德的商标。

B）其他的法律主张，包括：
1) 《反不正当竞争法》下的不正当竞争；
2) 《民法通则》下的人格权。

1、商标法

1) 驰名商标：

根据中国《商标法》，对于以不正当地采用“搭便车”行为侵占他人有一定影响的商标为目的的商标注册可以予以撤销。对外国公司而言，难点是如何证明其商标在中国具有一定的影响。许多国际知名品牌未在中国销售，或对中国消费者来说价格过于昂贵，或未以吸引中国消费者的方式进行营销。因此，许多国际知名的品牌无法提供其早期在中国驰名的证据。抢注他人的品牌看似是中国特有的，但在采用属地原则的大多数地区，从法律上说，这种情况还是可能出现的，包括美国。

当西方媒体在对迈克尔·乔丹商标案的决定表示愤慨时，该等决定与美国对国外驰名商标的判决思路如出一辙。中国法律的制定旨在保护在中国的消费者，而非在外国的人。对于那些未在美国商业使用其商标
第二十世纪八十年代，一家美国公司将从日本供商处复制而来的商标在美国申请了商标注册。联邦巡回上诉法院在上诉中作出了维持了美国审判和上诉委员会决定的判决，撤销了日本公司在美国的商标注册，该注册品牌在日本已可证明为驰名。正如大家所记得的，美国商标审判和上诉委员会认为日本公司对PERSON’S商标在服装商品上的注册与美国人拉里·克里斯曼在先的商标注册相近似。日本公司最初于一九七八年在日本在服装商品上注册了PERSON’S商标（记录未显示是否有该商标的日文，或该商标的日文如何表示）。日本公司的销售增长了，其开始向美国的批发商销售产品，并最后计划在二十世纪八十年代进军美国市场。

美国服装批发商，克里斯曼先生，在一次去日本的采购途中访问了这家日本公司。回到美国，在咨询了美国法律顾问后，他计划开始自己的PERSON’S品牌牛仔裤业务。他表面上从日本公司购买样品，复制其商标放在他生产的服装上，并最早在一九八二年开始在美国销售。一九八三年，克里斯曼和日本公司都对PERSON’S商标提出了注册申请。一九八四年，克里斯曼获得了服装上的PERSON’S商标注册。一九八五年，日本公司获得了在行李箱、服装和配饰上PERSON’S的商标注册。

一九八六年，日本公司在美国所作的广告宣传使克里斯曼注意到了日本公司的业务，于是他申请撤销日本公司的美国注册。日本公司声称其于一九八二年开始向美国代理商销售产品，比克里斯曼在在美国最早进行的销售还要早七个月。然而，美国商标审判和上诉委员会认为克里斯曼是在美国的商标善意、资深的使用人。虽然无“在美国的恶名”

24. PERSON’S有限公司诉克里斯曼，900 F.2d 1565（联邦巡回法院：1990年）。
日本公司却无法享受资深使用人的权利。法院的注解是：“对商标在国外使用的知悉并不排除其在美国对商标的善意采纳和使用。”

委员会认为对在外国使用的商标的复制并非恶意使用，除非该外国商标在美国已经驰名或复制商标是为了阻碍在先使用人计划在美国的业务拓展。”

尽管有证据表明日本公司于一九八二年向美国批发商进行销售，但法院最终还是没有认定日本公司计划向美国市场拓展。在PERSON’S案的决定作出之时，许多美国的商标律师都提出了反对的意见，理由是该决定忽视了兴起的全球市场。然而，大多数法院，包括美国的大多数法院仍然将地域性视为商标保护的一条基本原则。

值得注意的一个例外是美国第九巡回上诉法院依据公平原则对未在美国商业使用的未注册的外国商标给予了商标保护。法院持有一种全球观，可能是受了西部州高比例旅游和移民人群的影响。法院表明了希望确保消费者不被仿冒外国品牌的美国假货所误导的愿望，而这点在联邦巡回法院判决PERSON’S案中却并没有得以体现。第九巡回法院认为：“没有这样的例外，绝对的地域性规则将促使在消费者群体中的混淆和欺诈。然而，在美国，第九巡回法院只是例外，而非规则。最近的第四巡回法院在Belmora（以下简称“贝尔莫拉”）案中的裁决则反映了对全球化的认识，但却是基于反不正当竞争法，而非商标法，以下加以详述。

在另一个美国案例中，一家外国公司声称其在外国驰名的商标不应在美国被抢注，但却以失败告终。一家名称为ITC的在印度拥有连锁餐馆的印度公司对一家由ITC前雇员经营的纽约公司提起了诉讼。纽约餐

25. 同上，第1570页。
26. 同上，第1567页。
27. 吉冈特集团公司诉黛洛有限公司，391 F.3d 1088, (第九巡回法院 两千零四年)，第 1094页。
28. PERSON’S案的裁定在随后自1990年至2014年间被公布的33个由联邦法院作出的商标裁定中被作为正面效应地予以引用。
馆复制了ITC的商标“BUKHARA”和ITC的标志及其餐馆的诸多商业外观，包括餐馆的装饰布置、菜单和制服。第二巡回上诉法院认为印度公司在美国不享有资深商标权。法院认为《与贸易有关的知识产权协议》第十六条第二款和《保护工业产权巴黎公约》第六条并不是自动生效的，且在《兰哈姆法案》中没有因在印度使用商标或商标驰名而给予BUKHARA商标保护的依据，这样做将逾越地域性之基本原则。29

并非所有的地区都认为名人的名气增强商标权的这一论点。英国的普通法认为一个名称的名气越大，那么它作为商标的显著性就越弱。文化预期是消费者购买东西是因为他们喜爱这位名人，而并非他们相信名人代表了优质的生产或其是产品的来源。这种思维方式也适用于中国消费者，特别是在过去。然而，消费者预期在不断变化中。中国消费者逐渐习惯于期盼名人与合法许可的商品之间可能存在某种联系，这与盗版产品是截然不同的。30

2) 恶意注册

若在中国提出恶意注册，必须提供违反代理人和义务规定或侵犯在先权利的客观证据。31 在迈克尔·乔丹案例中，乔丹体育与迈克尔·乔丹无任何关系，因此对其不负有不使用该商标的义务。在先权利包含因对商标的投入和宣传而致商标在中国驰名所产生的权利。依据中国《商标法》，对他人具有在先权利和一定影响力的商标进行不正当搭便车而注册的商标可以被宣告无效。32 但是，法院的裁定明确指出未发现恶意。是他们对证据故意视而不见，还是他们的裁决确有依据？

29. ITC有限公司诉Punchgini有限公司，482 F.3d 135 (第二巡回法院)，无证据，128 S. Ct. 288 (2007)。
31. 中国《商标法》第十五条：未经授权，代理人或者代表人在自己的名义将被代理人或者被代表人的商标进行注册，被代理人或者被代表人提出异议的，不予注册并禁止使用。
32. 中国《商标法》第三十二条：申请商标注册不得损害他人现有的在先权利，也不得以不正当手段抢先注册他人已经使用并有一定影响的商标。
然显而易见篮球运动员迈克尔·乔丹和“乔丹”这个名字之间存在关联，但迈克尔·乔丹在中国拥有这个名字却并非显然。难点在于证明“乔丹”这个名字的知名度应使其获得商标权。由于迈克尔·乔丹从未直接使用或许可他人使用“乔丹”，它只能提供类似商标“JORDAN”的使用证据，而非“乔丹”。他可以声称以“乔丹”提供篮球服务，但中国法院很可能会认为该运动员是以“MICHAEL JORDAN”（迈克尔·乔丹）这个名字在美国签约，而非“乔丹”。

在另一个有关耐克公司的中国案例中，耐克公司于两千零五年提交了中文“勒布朗·詹姆斯”的商标申请，但发现有抢注人已在他们之前申请了该商标。二零一一年，该商标被耐克公司提异议后不予注册。最终耐克公司的商标申请获得了注册，但却是一直等到二零一五年七月耐克公司在中国最高法院的裁定中获得胜诉，这是最高也是最终级别的法院上诉。类似地，北京高院维持了北京一中院的判决，推翻了商标评审委员会和商标局就FACEBOOK公司对一中国个人二零一一年在饮料商品上申请注册“FACEBOOK”商标所提异议作出的决定。法院发现商标评审委员会的裁定称由于“FACEBOOK”商标在饮料商品上非驰名商标，该公司可予以申请注册。虽然法院的判决书没有明确地认可美国FACEBOOK公司在中国的商标注册驰名，但这种

33. 申请号为4903847的中国商标。
34. 申请号为4001053的中国商标。中国商标网的记录显示耐克公司于2010年对该商标注册提出异议申请并获胜，之后商标注册人提复审，但被驳回。
35. 注册号为4903847的中国商标，中文“勒布朗·詹姆斯”商标。最高法院的判决书（2015）行提字第7号。可在以下网址获取：http://wenshu.court.gov.cn/content/content?DocID=5e74db08-3b47-46d2-8f72-0522db986fba&KeyWord=%E5%8B%97%E5%A7%86%E6%96%AF
36. 注册号为9081730的中国商标。
37. 注册号为5251161和5251162的中国商标。
认定却是暗含在对基于保护中国市场诚实信用交易原则的需要而作出支持异议的判决之中的。38

由于中国是大陆法系，法院裁判不受在先判例的约束。但是该案与迈克尔·乔丹案的不同之处还是极为明显的。首先，对“FACEBOOK”是FACEBOOK公司的商标和服务商标这一点没有争议。第二点也是最重要的，在FACEBOOK公司提出异议申请之前的许多年里，商标注册人并没有设立公司公开对其商标注册进行使用。商标注册人对“其他驰名商标”的诸多注册在法院裁定其商标注册无效中也是被考量的一个因素。然而，对乔丹体育提出的类似的表明恶意的证据却看起来未被采纳，因为公司对乔丹商标已进行长期、公开的使用，故该等证据也就不相关了。39这些案例表明若及早申请，依据《商标法》高度警戒的执法甚至可以保护有名的外国名字的中文音译。

3）有害道德的商标：

据报道，美国运动员迈克尔·乔丹试图争辩福公司的注册构成了有害道德的商标。然而，由于商标的内容本身并没有可被称之为非道德的，该论点未被采纳。当然，根据商标法，依照法律在他入之前申请注册商标并非不道德的行为。

在美国，依据《兰哈姆法案》第2(a)条，测试也同样限于商标本身的内在性质。美国商标和申诉委员会以不道德服务为由将商标申请驳回，但联邦巡回上诉法院裁定美国商标审判和申诉委员会的驳回行为不当。40
2、其他法律主张

1）不正当竞争

在最近的美国巡回法院的裁决意见中，第四巡回法院裁定《兰哈姆法案》适用于保护美国消费者不受误导性关联和广告宣传的影响，即使作出该误导性关联和广告宣传的是美国商标注册人。FLANAX案描述了与乔丹案相近的情形。拜耳消费保健品股份公司（以下简称“拜耳”）自一九七六年起在墨西哥持有FLANAX商标，并在该商标下销售萘普生钠药品。拜耳并未在美国使用FLANAX品牌，相反在美国销售相同的药品使用的品牌却是ALLEVE。在两千零四年，一家美国公司，贝尔莫拉公司，开始向在美国的讲西班牙话社区销售FLANAX品牌下的萘普生钠药品。贝尔莫拉在美国获得了FLANAX商标注册。在广告宣传中，贝尔莫拉称：“世世代代，FLANAX已成为拉丁美洲人寻求治疗各类普通疾病的药品品牌了。”

第四巡回法院认为该等对访美的墨西哥游客及熟悉拜耳产品的墨西哥裔美国消费者的有意误导违反了《兰哈姆法案》第43(a)和43(b)条下的反不正当竞争的保护规定。法院没有认为拜耳在美国享有FLANAX商标权。但法院注意到贝尔莫拉的商标权不能用以欺骗消费者，且该等欺骗构成了不正当竞争。

从全球性视角来看，此裁定与第九巡回法院的吉冈特集团案更相似，尽管该案是依据《兰哈姆法案》的商标条款，而非不正当竞争条款作出裁决。

不幸的是对中国消费者而言，他们无法享受该等保护，除非某一商标在中国的相关商品或服务上达到驰名程度。福建公司对迈克尔·乔丹的球衣号码及其孩子名字等进行的其他商标注册体现了其误导性地建立与美国运动员关联的一贯做法，但法院在判决中没有提到。然而，由

41. 贝尔莫拉有限责任公司诉拜耳消费保健品股份公司，美国地方法院第四巡回法院，2016年3月23日。第6页—（仍需官方引证）。

42. “...商标权不包括使用商标作为一种不正当竞争的方式来欺骗消费者，如在此所声称的。”Id. 第31页。
于中国要求乔丹品牌必须已经在中国的相关商品或服务上驰名，因此美国运动员无法获得中国不正当竞争法下的救济。相比较而言，由于《兰哈姆法案》在保护消费者时，并不一定要求商标是驰名的，拜耳可以保护消费者不受到因其墨西哥品牌FLANAX在美国未经授权使用所致的误导。美国运动员若经历美国的FLANAX案，将获得比中国案子有利得多的裁决。

2) 《民法通则》下的人格权

商法下的权利是基于在中国的商业使用和知名度，但作为基本权利的人格权则不然。迈克尔·乔丹也曾试图争辩其对乔丹这个名字拥有基本的人格权。

在中国，人的姓名权始于对人姓名定义的探究。在超过十亿人口的中国，许多人的名字相同，这种重名的现象很普遍，法院的任务需要严格执行法律。法规中并没有提供其他类型名字的例子，也没有在定义中加入别名。与《商标法》下具体的商事权相比较，作为《民法通则》下的基本权利保护，人的姓名口口先于商口口。

然而，该权利被视为逐步发展的经济权领域。一些中国学者建议别名、假名和其他名字应当都加入“名字”的定义。从“名字”的功能性考虑，因为一个人是通过名字被他人所知的，所以别名和其他名字都应当作为名字获得保护。考虑到许多名人是通过其别名或其完整名字的一部分为他人所知的，若缺乏该等保护，将使许多第三方对这些有名的名字“搭便车”以误导公众。这在中国正打造一种消费文化且外国品牌和外国名人正引起人们的广泛兴趣时尤为重要。外国人的名字，正如在迈克尔·乔丹一案中的，常常被音译为中文。对外国名字

43. 程曦，侵权责任法，第二卷，中国：法律出版社，第137-139页。
44. 杨立新，人格权法，中国：法律出版社，2012年，第334-335页。刘文杰，民法上的姓名权，中国学术期刊电子杂志社有限公司，第65-76页，可登录www.cnki.net获取。
中译文给予保护的全盘否决等同于发出了一个误导中国消费者的许可证。

迈克尔·乔丹发布了一个视频，在这其中他称“乔丹”是他的自己的名字。45 他的自述在中国大概不足以作为一个法律事实，特别它首次是在二零一二年才作出，在与福建公司的纠纷产生之后。此外，在香港和台湾使用不同的中文字。为反驳乔丹是他“名字”的主张，中国政府部门可以要求出具包含乔丹作为他名字的任何官方文件，因为知道迈克尔·乔丹的美国护照不会显示乔丹这个名字。考虑到第九十九条的狭义语言，乔丹不太可能作为迈克尔·乔丹的名字。

另一方面，西方普遍的观点是乔丹或是QIAODAN是迈克尔·乔丹在中国的名字，这是因为广泛的使用及与他相关的宣传已经将他与乔丹之间建立了关联性。这种建立的关联性理念的接受是从不正当竞争概念借鉴而来的，但在美国对人格权的理念中却愈来愈显现出来。该等权利是由州法律所管辖的，且各个州做法不一。但举例来说，华盛顿州法律对名字的定义是包含“真实的名字、假名或别名…意图确定该个人身份的名字…”46 使用了“意图确定该个人身份”的措词，该法律认同了由他人所建立的关联性可使个人产生一种权利，无论该个人是否采取任何行动来正式地申领或注册该名字。

华盛顿州法律看起来是对此情形作出了回应，即当一位运动员通过别名为众人所知晓后，法律使运动员对该别名拥有了所有权。这种宽泛的定义将名字和人格视为产权。47 纽约州的民权法规定了类似的宽泛

46. 《华盛顿州民法典》第63:60:020 (6)章：“名字”指意图确定个人身份的一个活着的或死了的个人的真名或假名或别名。
47. 《华盛顿州民法典》第63:60:010章：每个个人或名人对使用其名字、声音、签名、照片等都享有所有权。
概念，与商业利用相联系。48 根据加州法律，可保护名字不被第三人以商业目的进行使用。49

姓名权法规对于由他人建立的关联性或获得的名字规定有规定。联邦商标法对此却有规定。一个例子是新奥尔良圣徒橄榄球队，它的球迷常用的加油欢呼是“WHO DAT？”在卡特里娜飓风摧毁了新奥尔良大部分地区的四年后两千零九年底，球迷欢呼的“WHO DAT？”一度风靡全美。对商标法的一知半解和希望“迅速致富”的愿望促使许多美国人向美国专利商标局提交了许多注册WHO DAT为商标的申请，特别是在服装及在美国橄榄球超级杯大赛上销售的物品上的商标。五十多个申请几乎全部被驳回或放弃了。一家名称为WHO DAT？有限公司的公司能够证明它实际在州际贸易中使用该商标，因此也就成为了数个商标注册的权利人。50

诸多圣徒球迷对于一家公司最后获得了一个由集体自发生产生的欢呼口号的独占权而感到愤愤不平。许多人认为欢呼口号属于球队的全体球迷，不应成为一家公司的独占所有权。有些人认为商标应当属于球队或全国橄榄球联盟。然而，根据美国商标法，由于一家公司能够证明它在其他人之前第一个将该标识作为区分商品来源的标志予以使用，它就获得了商标权。但是，该决定是基于商标注册人在商业中对该短语的积极使用，而非他人将该短语与球队建立起来的关联性。

48. 《纽约州民权法》第50章：为了广告或贸易之目的，个人、公司或法人在未事先获得某一活着的人（或若是未成年人，则未事先获得其父母或监护人）的书面同意的情况下擅自使用其名字、肖像或照片，则构成了轻罪。

49. 《加州民法典》第3344章，(1) 若未事先获得他人同意，任何人未在知情的情况下以任何方式在产品、商品或货物上，或为了广告或销售，或推销产品、商品、货物或服务之目的，使用他人的名字、声音、签名、照片等，应当对遭受损害者承担赔偿的责任。

(3)(e)：对他人名字、声音、签名、照片等的使用是否与商业赞助或付费广告直接关联，这应当是一个事实问题，以确定是否构成需要事先获得(a)条下同意的使用。

50. 美国商标注册号4310960,4385857等。
华盛顿州和加州法律对“名字”采用宽泛的定义，而并不要求确定一个“实际的名字”。对于一个其许多成员的名字都来自全球各地的社会，这样的定义是恰当的。美国的名字不再是整齐划一地由一个基督教名和一个姓组成。即使移民和外国名人都会挑选一个符合传统欧洲形式的名字。现在，人们保留一个外国名字，但用罗马字的形式来拼写已经是很普遍的了。比较一下美籍华人女演员陈冲“Joan Chen”与其名字被西方人所知的中国更年轻的女演员章子怡“Zhang Ziyi”。

但这“一人多个名字”的问题并非新问题。对于作者和演员来说，使用化名的情况比比皆是，这样做可以保护作者不受到批评抨击，或为了增加作品的接受度（乔治·艾略特，原名玛丽·安·伊万斯）或为了符合好莱坞影城或演员公会的要求（朱迪·加兰，原名弗朗西斯·埃塞尔·古姆，或约翰·韦恩，原名马里恩·莫里森）。如严格遵照中国《民法通则》第九十九条，他们的笔名或艺名都受不到任何保护。

相比较而言，根据加州或华盛顿州的法律，一个人名字的任何形式都能获得保护，只要该名字在美国被商业使用。因此，在加州或华盛顿的名人无需对其想获得保护的名字作出选择，如是保护“Jackie Chan”还是“成龙”。两个名字都是该名人在商业中使用并为大众所知的。并且，只要在州际商务中商业使用该名字，就可适用《兰哈姆法案》，即美国各州对与人名相关联的一系列翻译都给予保护，使其无法被用来误导公众。此外，在大量看得懂中文的群体在美国社会立足之前，依据美国法律中文汉字的使用可作为“符号或图案”受到保护。
国州的法律常常包含商业元素，且重点关注公众的混淆，其较之将“名字”严格定义为人的正式名字的法律而言，对消费者的保护更充分。

加州《民法典》中的商业元素帮助缩小了保护范围，以允许其他人使用其自身的姓名。因此，加州姓名权与人名的商标权相类似。迈克尔·乔丹是否能够根据加州法律在加州禁止他人以“Jordan”作为名字来使用呢？显然倘若没有其他因素存在的话，他不能。“Jordan”不是他的全名，只是名字的一部分。他甚至不能禁止与他同名者在正常生活的日常活动中使用“Michael Jordan”这个名字。但是，在运动员已对其名字进行了商业使用后，若另一名叫“Michael Jordan”的个人试图将“Michael Jordan”用作运动装的商标，后者的行为将有可能被认定为违反了加州法律。即使在加州法律的规定下，单单“Jordan”这个名字将不能作为迈克尔·乔丹的名字而受到保护。他需要使用《兰哈姆法案》下的保护。

按照对中国《民法通则》原理的狭义解读，迈克尔·乔丹对于“乔丹”这个名字无法获得排他性质的所有权。但这种狭义的解读代价不低。它将外国人可作为人身权的一种保护形式有效地排除了，因为大多数外国人在我国是以某一音译的中文名字，而非其法定的外文名字而出名。缺乏这一保护将致使欺骗及中国消费者的混淆继续存在。

对外国原告适用人身权，还存在另一个复杂问题。法律给予公民权利，但对外国人，允许适用其经常居住地的法律。54 如外国法律无法被查明的，或该国法律没有规定的，应当适用中华人民共和国的法律。55 如该条款的意思被解读为外国人名字的定义应遵照其所属国法律的话，它将包含别名，这可能改变在中国此案的结果。如果人们能表明

54. 美国电话簿上，叫“Michael Jordan”这个名字的超过4000人。
55. 《民法通则》第15条：人格权的内容，适用权利人经常居住地法律。
56. 《民法通则》第10条：外国人姓名的含义，适用该国法律。未能查明该国法律或该国法律没有规定的，适用中华人民共和国法律。
其所属国法律认同对“名字”的宽泛定义时，包括多种语言，他们就能宣称几个名字都“属于”他们。但是，很难想象在中国对一个更为宽泛的标准进行如此超地域的应用。

三、结论
法治的一条基本准则是可预测性。公民应当能够根据他们自身的社会习俗和法律体系所形成的是非观来引导他们自己的行为。在过去的四十年里，中国的社会和法律体系所经历的变化如此巨大，因此如果指引行为的标准有些模糊也就不足为奇了。

《商标法》力图对中国消费者给予保护，确保其知晓市场上的产品的来源。法律规定区域内的先申请制，并对在中国驰名的未注册商标给予保护。在可预测性的准则下，福建公司的注册，若合法的话，应当予以保护。在第二十世纪九十年代，认为外国品牌价格过高或不为人所知，故难以吸引中国消费。如今中国消费者对这些品牌产品有巨大的需求，但它们可能已被那些仿冒品和遵照法律程序比外国原品牌持有人抢先一步在中国申请注册商标的当地品牌仿冒者所蒙骗。

乔丹案发生在迅速发展的中国消费经济的大背景下。消费文化对中国消费者来说相对较新，因此对于名人与品牌之间关系的预期也同样较新。由于中国的法律采用先注册制，而外国品牌持有人才刚刚开始了解中国消费者，所以可能在之后的许多年中都会存在商标抢注者和品牌仿冒者误导中国消费者的情况。

为避免被一个具有先见之明的、计划全球出口的中国品牌仿冒者夺去自己的品牌，名人和品牌持有人应当认清其资产的价值，并在其产品风靡美国时立即考虑去中国进行商标注册。乔丹案是对外国品牌持有

57.《世界正义工程》，受到美国律师协会的支持，对于法治有四部分的标准，包括第2点：“法律是清楚的、公开的、稳定的和公正的，并且旨在保护包括人和财产安全的诸多基本权利。”
人的一个提醒，即及早在中国进行商标注册是在将来保护其权利的必不可少的投资，且中国是不可忽视的消费之市场和出口平台。
REGISTRABILITY OF NONTRADITIONAL TRADEMARKS IN BRAZIL: CURRENT SITUATION AND PERSPECTIVES*

By Pedro Vilhena**

I. INTRODUCTION


In an increasingly competitive market, every sign is important and may represent an edge in the struggle to get a customer's immediate attention first, then secure their place as a customer's preference, and, finally, gain their loyalty. The evolution of technologies and the increased level of commercial activity have pushed companies to develop and offer not only better goods and services, but also better experiences, often immersing consumers in an atmosphere of pleasant sensations whose elements are strategically placed in order to obtain such a result.

Most of the signs listed above, generally referred to as "nontraditional marks," are studied, crafted, improved, and adopted by companies for advertising purposes. Thus, the initial interest is the use of such elements as a way of standing out from one's competitors' goods and grabbing consumers' eyes (or noses or ears, as the case may be) in the market, either physically or virtually. But the effects of such strategies may vary.

In most cases, the use of these signs remains purely promotional. They communicate, in the scope of advertising material, the values and the image behind a company, a product, or a service. And, as soon as the material is replaced by new advertising pieces, such signs are forgotten, vanishing from most consumers' minds.

But, in some cases, for reasons that may generate more interest in advertisers than in lawyers, this period of advertising is enough to create an associative link in consumers' minds between a given sign and the promoted good or service. This associative link is a tool that allows consumers to identify, or distinguish, a good from other similar goods, or a service from other similar goods.
services. And, thus, such sign begins to perform the function of a trademark.

Simply put, nontraditional marks are signs that, despite their apparently inappropriate ontological status, manage to distinguish goods or services in the marketplace.

Jurisdictions such as the United States, the European Union, and Argentina, for instance, have tackled this issue throughout the last few decades, but reasons such as economic underperformance, political crisis, and conservative and slow legislative decision-making have kept some important emerging markets, including Brazil, from updating their legal systems to adequately acknowledge and protect nontraditional trademarks. This article focuses on the Brazilian experience.

A. Recent Market and Legal Developments

After struggling against hyperinflation for decades, the Brazilian economy finally found a more stable ground to grow in the mid-1990s, following the reopening of the Brazilian market to imported goods, and the successful creation of a new currency. Such changes created the Brazilian market reality as seen today: an industrialized economy, with strong agricultural business and services platforms, which heavily relies on its 200,000,000 consumers. Driven by such a large internal market, and boosted by internationally known advertising agencies, some Brazilian companies have been implementing intricate advertising strategies and daring corporate communication.

The conjunction of so many positive factors created a fertile environment for the exploitation of nontraditional marks that, little by little, started creating those aforementioned associative links in consumers’ minds, and performing trademark functions. Examples from the last couple of decades are abundant: a finger gesture identifying the country’s top-selling beer, a combination of colors identifying a network of gas stations, and a short musical phrase sounding like a “plim plim,” identifying the country’s main

1. An image of the gesture (a closed hand with a raised pointing finger symbolizing the number “1” was registered as a device mark under Registration No. 817935487, in Class 35.10 (beverages, syrups, and concentrated juice), filed by Ambev S.A. on August 11, 1994, and granted by the BPTO on October 1, 1996. The gesture was made famous by means of very intense advertising throughout 1993 and 1994, including agreements with soccer players that celebrated goals scored during official matches by raising their pointing fingers up. The strategy included hiring the striker Romario and having him make the gesture while celebrating his goals in the 1994 USA World Cup. He ended up being the tournament’s best scorer, amplifying the reach of the gesture.

2. Shell’s notorious combination of red and yellow has been recognized by courts as a “characteristic” component of the company’s trade dress. See decision by the São Paulo State Court issued on October 16, 2013 [re Appeal No. 9134487-70-2008-8-26-0000].
television broadcast company\textsuperscript{3} are just a few of the prominent cases. And it is safe to say that nontraditional marks are now a part of the country’s commercial landscape.

Except for three-dimensional shapes, nontraditional marks are still quite uncommon and pale in comparison with the quantity of word marks or device marks. When a company invests a substantial amount of resources in the creation of a nontraditional mark, however, it is definitely not willing to share the results of such efforts with unauthorized third parties, particularly its direct competitors. So, while nontraditional marks are few in number, they are usually deemed important assets by their owners, and deserving of legal protection.

Despite such marketplace evolution, Brazil’s legal landscape has improved just slightly. The Brazilian Industrial Property Code,\textsuperscript{4} which was in effect prior to April 14, 1997, made no mention of nontraditional marks. The Code listed as eligible for trademark protection “names, words, denominations, monograms, emblems, symbols, devices and any other distinctive signs,” but such eligibility was restricted to signs not otherwise prohibited from exclusive appropriation, such as isolated colors and the shape of products or their packaging. Moreover, despite the lack of express legal prohibition, the Brazilian Patent and Trademark Office’s (“BPTO” or the “agency”),\textsuperscript{5} construction of these articles led to a \textit{de facto} ineligibility for registration of any nonvisibly perceptible signs. In other words, from an ontological perspective, the range of signs eligible for trademark protection was effectively restricted to word marks and two-dimensional device marks. And despite at least a soft clamor by the country’s industry for a broader range of protectability, the question remained unaltered during the period of validity of the IP Code. If local pressures were too mild to provoke any action from Brazilian lawmaking bodies and administrative authorities (the BPTO included), a factor external to Brazil was ultimately responsible for the recent revision of the Brazilian industrial property legal framework, namely, the Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement,\textsuperscript{6} which imposed a new set of obligations on Brazil.

\textsuperscript{3} An onomatopoeic representation of the sound (“PLIM, PLIM”) was registered as a word mark under Registration No. 811501710, in Class 38.10 (communication, publicity, and advertising services), filed by Globo Comunicação e Participações S.A., on March 27, 1984, and granted by the BPTO on August 13, 1985. The sound is the network’s main audio mark, and has been used several times a day for more than four decades to identify the network’s broadcasts.

\textsuperscript{4} Established by Law No. 5,772/71, usually referred to as IP Code.

\textsuperscript{5} Officially named, in Portuguese, “Instituto Nacional da Propriedade Industrial,” often referred to as “INPI.”

\textsuperscript{6} The Agreement on Trade-Related Aspects of Intellectual Property Rights (the “TRIPS Agreement”), as concluded during the Uruguay Round negotiations.
B. The TRIPS Agreement and the Brazilian IP Law

The chapter on trademarks in the TRIPS Agreement reveals a trend easily recognizable in the minutes of the Agreement’s discussion: while developed countries aimed at more expansive trademark protection (including the broadening of the range of protectable signs), other countries used bureaucratic and economic difficulties as justification to resist expanding protection. For the scope of this article, our analysis is focused on Article 15.1:

Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible. (Emphasis added.)

The wording of the article reflects the discrepancy of interests. The first sentence establishes a definition of “mark” with no limitations in connection with the ontological nature of the sign. In this sense, the definition established by the Agreement favors a teleological approach to trademarks,7 which leads to the characterization of a mark by the functions performed rather than by the nature of the sign.8 Such a broad definition reveals the interests of developed countries, whose local companies are trademark owners willing to obtain and enforce such rights in as many territories as possible. Counterbalancing the initial sentence, the last clause in Article 15.1 addresses the preoccupation of developing countries with regard to overprotection of nontraditional marks.9 And, thus, the scope of


8. The United States Supreme Court supported this approach in 1995, stating that “[i]t is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word, or sign—that permits it to serve these basic purposes. [. . .] And, for that reason, it is difficult to find, in basic trademark objectives, a reason to disqualify absolutely the use of a color as a mark.” Qualitex Co. v. Jacobson Prods. Co., Inc., 514 U.S. 159, 164 (1995).

9. Such preoccupation was not new and had already been manifested back in the 1960s, during the creation of the United International Bureaux for the Protection of Intellectual Property—BIRPI’s Model Law for Developing Countries on Marks, Trade Names, and Acts of Unfair Competition, as reported by Georg Hendrik Christiaan Bodenhausen: “[T]he Second Model Law Committee considered the question whether, in the definitions, the word ‘visible’ should be deleted or replaced by ‘perceptible’, so as to include in the definition of marks audible, olfactory, and other non-visual signs. These proposals,
the initial bold definition shrank to accommodate such preoccupations, allowing developing countries to condition protection of marks to the visual perceptibility of the signs.10

As a result of the obligations set forth by the TRIPS Agreement, the Brazilian government enacted a new Industrial Property Law in May 14, 1996,11 valid as of May 14, 1997, taking full advantage of the right to require visual perceptibility as permitted by Article 15.1. The new law revoked the precedent IP Code, and established new and more modern rules concerning industrial property protection.

The enactment of the new IP law represented a small yet important step in creating a more protective environment for trademarks by reviewing the definition of trademark, narrowing the scope of material excluded from trademark protection, and refining the criteria of eligibility for registration. The terms of the new law were generally praised, but industry expectations regarding the protection of sound marks fell flat, given that the new law still lacked such provisions.

II. TRADEMARK PROTECTION OF NONTRADITIONAL MARKS: SCOPE AND EXCLUSIONS

Almost twenty years after the 1997 reform, it is now clear, as discussed below, that the reform legislation was less daring than it could have been, and that some new amendments would be very welcome and could lead the country to a more current perspective.

In this Part II, the object of trademark protection is analyzed by the assessment of the matter protectable by trademark law and the matter legally excluded from such protection. A strictly legal perspective arising from the interpretation of the relevant dispositions of the Brazilian IP Law in light of other applicable legal texts (local and international) is presented in Part II.A. This however, were not adopted for three reasons: first, non-visual signs serving to distinguish goods or services are much less common than visual signs, although some audible signs are used in commercial broadcasting; secondly, these signs, even if not accepted as marks, are protected against confusion by the provisions against unfair competition; thirdly, the acceptance as marks of non-visual signs would cause complications with regard to their registration, and this was deemed undesirable, especially in developing countries.” Model Law for Developing Countries on Marks, Trade Names, and Acts of Unfair Competition (BIRPI, 1967).

10. See Resource Book on TRIPS and Development. [Online.] Cambridge University Press (2005): “Thus the broad reference of the first sentence is intended to permit Members to adopt an extensive scope of trademark subject matter protection, the second sentence is intended to set out a list of obligatory subject matter and the fourth sentence permits the exclusion of certain subject matter.”

analysis is followed, in Part II.B, by a review of the opinions of scholars and practitioners regarding the evolution of the range of signs accepted for trademark protection in Brazil. In Part II.C, the situation of some types of signs admitted by law but ignored by the BPTO is analyzed and classified as a gray area of eligibility for registration. Finally, Part II.D discusses relevant case law, including administrative decisions rendered by the BPTO and decisions issued by Federal Courts regarding the eligibility for registration of some types of signs.

A. Review of the IP Law

Title III of the IP Law, dedicated to marks, starts with a curious twist: instead of defining what a mark is, and then clarifying what marks are eligible for registration, the legal text proceeds in the opposite direction. This inversion caused a continual shrinking of the importance of the statutory definition of a trademark in Brazil, which can be verified by the small number of mentions of the legal definition in administrative and judicial petitions, or in academic articles or books. The inversion of the order of the articles also contributed to the diffusion of the idea that a mark is necessarily a visually perceptible sign, which does not strictly follow from the definition of “mark” in the IP Law, Article 123. In general terms, any sign can constitute a mark under Article 123, as long as it “is used to distinguish a product or service from another that is identical, similar, or alike, but of different origin.” The expression “visually perceptible signs” is used, in fact, to narrow the range of signs eligible for registration as a mark, in light of Article 122.

As previously stated, the restriction expressed in Article 122 arises from the permission set forth at the end of Article 15.1 of the TRIPS Agreement. The use of such permission by Brazil is incongruous with the country’s position during the negotiations. Despite the country’s historical disregard of nontraditional marks, Brazilian representatives negotiated for a less traditional definition. Most of the drafts sponsored or supported by the Brazilian delegation were silent with respect to the nature of signs that could constitute and/or be registered as a trademark. But

12. IP Law – Article 122: “Any visually perceptible distinctive sign, when not prohibited under law, is eligible for registration as a mark.” (Emphasis added.) Article 123: “For the purposes of this Law, the following definitions apply: I. product or service mark: one which is used to distinguish a product or service from another that is identical, similar, or alike, but of different origin; II. certification mark: one that is used to attest to the conformity of a product or service with certain technical standards or specifications, particularly regarding its quality, nature, material used and methodology employed; and III. collective mark: one that is used to identify products or services provided by members of a certain entity.”

13. The definition of “trademark” included in the 1989 Brazilian Draft was amplified with examples such as “names, words, denominations, monograms, emblems, and symbols which allow the differentiation of goods and services for commercial purposes.” In May
there is a notable difference between negotiating in an external international forum, and implementing the results thereof in the national law through discussions at the National Congress, and this led to the adoption of the requirement of visual perceptibility.

The immediate logical consequence of the text of Article 122 is that any non-visually perceptible signs shall not be eligible for registration as a mark, distinctive as it may be or become. In this case, the exclusion is tacit, but its clarity leaves little room for discussion: sound marks, tactile marks, taste marks, olfactory marks, and any combination of signs, including one of such elements, are not eligible for registration in Brazil, in light of the concept of limited registrability as a trademark set forth in Article 122. At first glance, Article 122’s language—“Any visually perceptible distinctive sign, when not prohibited under law, is eligible for registration as a mark”—could lead to the impression that any visually perceptible sign could be registered as a mark. This would be a premature conclusion.

Visual perceptibility per se does not guarantee that a sign will be eligible for proprietary protection, given that Article 122 also requires that the sign be “distinctive” and “not included in legal prohibitions.” The mention of the distinctive character of the sign reinforces the role of distinctiveness as the essential function of the trademarks in the Brazilian legal system.14 But the distinctive character requirement itself does not limit in any way the range of signs eligible for registration. Case law is abundant in providing examples of signs of all natures that are recognized as being distinctive.

On the other hand, Brazilian IP Law contains an extensive list of prohibitions against registration, including 23 items under Article 124. The analysis of this list reveals some important

1990, Brazil sponsored the Developing Country Joint Draft, according to which the formalities and requirements for trademark registration should be set forth by national law. This formula was reprised in the Anell Draft, of June 1990, partially sponsored by Brazil (the draft was divided into two sections—one covering A dispositions, sponsored by developed countries, and one covering B dispositions, sponsored by developing countries).

14. See Maite Cecilia Fabbri Moro, Marcas tridimensionais: sua proteção e aparentes conflitos com a proteção outorgada por outros institutos da propriedade intelectual (Saraiva, 2009); Lélio Denicoli Schmidt, A distintividade das marcas: secondary meaning, vulgarização, teoria da distância. (Saraiva, 2013); and José Roberto d’Affonso Gumão, L’acquisition du droit sur la marque au Brésil (Litec, 1990). A dissonant opinion has emerged with the insertion in the Brazilian Federal Constitution of an article highlighting the social function of property rights. E.g., Renata Pozzato Carneiro Monteiro, A Função Social da Propriedade na Constituição da República de 1988 e a Propriedade Industrial, Revista da ABPI – Associação Brasileira da Propriedade Intelectual No. 69, March/April 2004: “As observed, the right to every and any property is limited by its social function. This happens, since, given the overcoming of individualism by the 1988 Constitution of the Republic, the social function of property rights became more important than their remaining functions.”
limitations (and, by reverse interpretation, some important permissions) connected with the nature of the distinctive signs.

First, item VII states that “signs or expressions used only as a means of advertising” are not eligible for registration as marks. Advertising expressions (or “slogans”) have been considered a type of nontraditional mark to the extent that they can create an associative link between the consumer and a specific good or service. This provision bars the registration of advertising signs and expressions that are used only as a means of advertising and, thus, that are not used as trademarks. But, interpreting such terms *a contrario sensu* reveals a different and welcoming understanding: registration as a mark is possible for advertising signs and expressions that are also used as marks. Such interpretation embodies the application of the teleological view of trademark law to slogans: if it is used and functions as a mark, it is eligible for registration, even if it also happens to be an advertising sign or an advertising expression.

The subsequent item, VIII, refers to nonregistrability of colors as trademarks. The law establishes a general rule—“colors and their names are not registrable”—and then provides an exception—“except when arranged or combined in an unusual and distinctive manner.” In order to assess what is and is not eligible for registration under Article 124, VIII, it is important to look first at the exception. The prohibition does not operate against colors that have been arranged or combined. This leads to a logical assumption that, since an isolated color cannot be arranged or combined with itself, it cannot be registered as a mark. So, the exception refers to signs comprising two or more colors, arranged or combined. But the exception requires that such combination or arrangement also be unusual and distinctive. So, under Article 124, VIII, unusual and distinctive combinations and arrangements of colors are eligible for registration, while isolated colors are not—just like usual and nondistinctive combinations and arrangements of colors.

In connection with three-dimensional shapes, item XXI of Article 124 determines the ineligibility for registration of “necessary, common or usual shapes of a product or of its packaging, or, furthermore, shapes that cannot be disassociated from a technical effect.” Here again, a reverse logic can be used: three-dimensional shapes that do not fall into the prohibition of Article 124, XXI, are eligible for registration as trademarks.

In view of the above, from a purely legal perspective, Brazilian IP law permits trademark registration of visually perceivable distinctive signs, including:

- *some* advertising signs and expressions that are used as marks;
• unusual and distinctive combinations and arrangements of colors; and
• three-dimensional shapes that are not necessary, common or usual and that can be dissociated from a technical effect.

On the other hand, besides the tacit exclusion of nonvisible signs (i.e., sound marks, tactile marks, taste marks, and olfactory marks), the law also expressly excludes from trademark protection:

• advertising signs and expressions that are used only as a means of advertising;
• isolated colors;
• combinations and arrangements of colors that are either usual, common, or undistinctive;
• necessary, common, or usual shapes of a product or of its packaging, and
• shapes that cannot be disassociated from a technical effect.

B. Academic and Industry Reaction to the IP Law

The reception of the trademark-related amendments to the IP Law by scholars was lukewarm. Some long-awaited evolution finally came to light, such as the registrability of three-dimensional signs or the lengthened term of protection without an obligation to use the mark (for purposes of forfeiture). Some authors even praised the improvement of the wording used in some amendments.

Article 122’s concise language for determining registration eligibility was praised for its straightforward technique that avoided the need of reverting to examples in defining what constitutes a mark, as did the corresponding article of the prior IP Code. Such precise definition created two different types of marks under Brazilian Law, each ruled by a specific legal regime:

15. E.g., Instituto Dannemann Siemsen, Comentários à Lei de Propriedade Industrial (3d ed., Renovar, 2013): “Instead of, as examples, listing the signs eligible for registration, the law broadly determines that all the signs not forbidden by law be protected, as long as they are distinctive and visually perceptible, which leaves space, for instance, for three-dimensional marks.”

16. IP Code – Article 64: “The following are registrable as marks: names, words, denominations, monograms, emblems, symbols, figures and any other signs (devices) which are distinctive and which are not anticipated by or do not conflict with prior registrations and which are not prohibited by law.”

17. Lélio Denicoli Schmidt, A Distintividade das Marcas: Secondary Meaning, Vulgarização e Teoria da Distância (Saraiva, 2013): “The law does not treat equally all the types of signs. (. . .) Article 122 of the Law 9.279/96 highlights that the registration as a mark is granted to visually perceptible distinctive signs. Thus, unlike what happens in other countries, in Brazil sound, taste and olfactory marks are not eligible for registration as a mark, because, in the words of Saint Augustine, they cannot be ‘pointed out with the fingers’ and are not visually perceptible.”
while visually perceptible marks are eligible for the full protection granted by registration under the Trademark Law, the owner of the remaining signs must count on other legal tools to prevent undue use by third parties.18

The use of the permission foreseen in Article 15.a of the TRIPS Agreement was questioned by scholars, in view of its unjustified causes19 and aims.20 The inclusion of the visual perceptibility requirement in the Brazilian IP law was also the object of divergent views regarding its scope and its consequences. Several scholars addressed the fact that the choice of the visual perceptibility requirement led to the automatic exclusion of a large number of signs from trademark protection.21

18. This particular subject was analyzed by the author in the unpublished paper “Mechanisms of protection of nontraditional marks in Brazil,” under the academic supervision of Professor Elisabeth Kasznar Fekete (Partner, Kasznar Leonardos Intellectual Property, Rio de Janeiro, Brazil, Associate Member, INTA; Member, The Trademark Reporter Committee).

19. Instituto Dannemann Siemsen, Comentários à Lei de Propriedade Industrial (3d ed., Renovar, 2013): “The limitation is due, undoubtedly, to the difficulties of technical and bureaucratic nature related to the registration of such signs, as well as to the extreme complexity of the evaluation of their absolute and relative eligibility for registration.”

20. Denis Borges Barbosa, Marcas em Movimento, in Revista Eletrônica do IBPI 8 (2013): “We do not see any systematic reason for such exclusion, except that of guaranteeing the due process of law for third parties that may either be affected by the exclusive rights granted by the registration or be willing to oppose its interests. That is, it is necessary that the nonvisual sign be capable of being fixated and recovered by all those to whom the exclusivity benefits or affects. Once there are enough technical means to such purpose, the prohibition can be and must be overtaken.” Also refer to José Antonio B.L. Faria Correa, Sinais Não Registráveis, in Manuel Joaquim Pereira dos Santos & Wilson Pinheiro Jabur, Sinais Distintivos e Tutela Judicial e Administrativa (Saraiva, 2007): “In short, we do not see conceptual or procedural obstacles to the legal protection of sound marks or of those addressed to the remaining human senses other than the vision. In a world in quick mutation, shaken by incessant technological innovations that redesign our habits constantly, closing the doors on the so-called nontraditional marks, including those consisting of sounds, would be a serious mistake, and might stifle or, at least, hamper human creative verve.”

21. This fact is highlighted in the analysis made by Denis Borgas Barbosa: “By option of the legislator, sound marks, taste marks and smell marks are excluded from registration. Until now, they have never been admitted to protection in Brazil, even though they are admitted in other jurisdictions.” Proteção das Marcas: Uma Perspectiva Semiológica (Lumen Juris, 2008). See also Lélio Denicoli Schmidt, A distintividade das marcas: secondary meaning, vulgarização e teoria da distância (Saraiva, 2013): “[T]he impossibility of registration for sound marks does not mean, however, the complete absence of protection. (. . .) The visual perception is not, therefore, an essential element to the definition of mark, because it is just a character required for registered marks. Even unregistered marks are still marks and, as such, can find forms of legal protection other than that granted by the registration.”; Instituto Dannemann Siemsen, Comentários à Lei de Propriedade Industrial (3d ed., Renovar, 2013): “By posing the condition of the marks being visually perceptible, the law forbids the direct registration of signs accessible only to human senses other than the vision, thus leaving unsheltered the concepts of smell marks, taste marks, sound marks and tactile marks.”; and to Maite Cecilia Fabbri Moro, Marcas Tridimensionais: sua proteção e os aparentes conflitos com a proteção outorgada por outros institutos da propriedade intelectual (Saraiva, 2009): “Many of the exclusions of signs are found in Article 122 of the Brazilian law, since it established that only visually perceptible signs are eligible for
There are, however, two other schools of thought. A mild dissonance warns that Article 122 may be construed either restrictively (as most claim) or extensively. Under an extensive interpretation, it would be possible to claim that the visual perceptibility requirement refers to the representation of the mark, such as musical notation representing a sound mark and not to the mark itself.\textsuperscript{22} Another divergent opinion recommends a modern interpretation of Article 122 and advocates that there is space for nontraditional marks in Brazilian IP Law and that the visual perceptibility requirement must be interpreted merely as a graphic representation requirement instead.\textsuperscript{23}

In spite of the progressive intentions, the differing opinions were gradually forgotten, in view of the general acceptance of the literal understanding. Given that the concepts of visual perceptibility and of susceptibility of graphical representation\textsuperscript{24} were already established at the time of the discussions of the IP Law in the National Congress, it is safe to affirm that the registration. This expression already excludes the possibility of registration of a series odd presentation forms of signs that are possibly distinctive, such as sounds, smells and tastes (…)."

\textsuperscript{22} Peter Dirk Siemsen & Sandra Leis, Novos Campos Em Estudo Para A Proteção Da Propriedade Industrial —Marcas Não-Tradicionais, \url{http://www.dannemann.com.br/dsbim/uploads/imgFCKUpload/file/PDS_SLE_Marcas_Nao-Tradicionais(1).pdf}: "The Brazilian law could be construed in two ways: one, more strict, understanding that the mark itself must be visually perceptible; other, broader, understanding that the mark itself does not need to be visually perceptible, but the form through which it is expressed or exteriorized, that is, if the representation of the mark is visually perceptible, the mark would be in accordance with the law and would be eligible for registration. Following such broader construal, sound marks and smell marks could be represented by means of a description in words or notes, making them visually perceptible, as required by law."

\textsuperscript{23} José Antonio B.L. Faria Correa. A dimensão plurissensorial das marcas: a proteção da marca sonora na lei brasileira, in Revista da ABPI No. 69, March–April 2004: “The trademark protection, under Brazilian law, welcomes, in Article 122, all “distinctive signs perceived visually, not prohibited by law.”

In describing the nature of the distinctive signs eligible for registration, and in requiring visual perceptibility, the legislator, at first sight, takes the position that only the trademark directly perceived by sight can be registered by a competent authority. If the interpretation that the legislator decided to focus on just one of the human sensory channels prevails, it would not be adequate because it is not sensitive to the dynamic world of trademarks, influenced by constant technological innovations that have direct impact on the behavior of manufacturers, merchants and service providers. It would be awkward to imagine that the legislator that enacted a modern law such as Law No. 9276/96 would leave out of the equation nontraditional marks that appeal to other human senses. Despite the apparent option for the signs destined for the human eye, the law, obliquely, has mechanisms that open a window to the other human senses, as we shall see in this paper, and a systematic and teleological exegesis of the statute in focus shows that, in fact, Brazilian law has ample room for plurissensorial signs.”

\textsuperscript{24} This particular subject was analyzed by the author of this article in Critérios Determinantes da Noção de Sinal no Direito de Marcas, Revista Científica Virtual da ESA, April 2012.
legislature was in position to use different words if the intended meaning of the provision was to be different.25

C. Gray Zone: Signs Accepted by Law but Unregulated by the Trademark Office

From the preceding items, it is possible to assess the scope of eligibility for trademark registration in Brazil from a purely legal perspective and from scholars’ opinions. This section provides (and discusses) the BPTO’s interpretation of the subject matter.

As commonly highlighted by scholars,26 the BPTO has consistently enacted resolutions establishing four possible forms of presentation for all marks filed and examined:

- word marks (including words, combination of letters, numbers, combination of numbers, combination of numbers and letters, with no particular graphic presentation);
- figurative marks (including only pictorial elements, with no words or numbers);
- device marks (comprising both word and figurative elements); and
- three-dimensional marks (the shapes of products or their packaging).

This list falls short of comprising all the possible forms of presentation of “visually perceptible signs,” as foreseen by Article 122 of the IP Law. There is no exhaustive list detailing and/or classifying all existing visually perceptible signs and their corresponding forms of presentation, but the procedure crafted by the BPTO does not encompass even some relatively common types of nontraditional marks, such as moving images, holograms, trade dress elements, position marks, combination of colors, or gesture

25. See Denis Borgas Barbosa, Marcas em Movimento, in Revista Eletrônica do IBPI 8 (2013). Further see Michelle Copetti, Afinidade entre Marcas: Uma questão de Direito (Lumen Juris, 2010): “Thus, in Brazil, sound marks (nontraditional marks—taste, smell and tactile marks, for instance) cannot be registered, even if there is a possibility of graphic representation (as music scores for sound marks, for instance).”

26. See Maite Cecilia Fabbri Moro, Marcas Tridimensionais: sua proteção e os aparentes conflitos com a proteção outorgada por outros institutos da propriedade intelectual (Saraiva, 2009): “There is not in the national law a specific article that deals with the presentation forms of the trademarks, but the Instituto Nacional da Propriedade Industrial (INPI), based on what is delimited and not forbidden by law, currently accepts four presentation forms of signs as eligible for registration. Those are: the form of word marks, the form of figurative marks, the form of device marks and the form of three-dimensional marks.” Also see Claudio Roberto Barbosa, Propriedade Intelectual: introdução à propriedade intelectual como informação (Elsevier, 2009): “Registered marks may, by their turn, consist of four different presentation forms: a) word mark, consisting only of words and/or combination of numbers; b) figurative marks, when consisting only of graphic elements, of a drawing; c) device marks, consisting of a word element presented with a specific graphic element; and, finally, d) three-dimensional marks, when consisting of the graphic representation of the plastic distinctive shape of a product.”
marks. In fact, all the agency did upon the revocation of the prior IP Code and the enactment of the IP Law was adding a fourth type of presentation to allow registration of three-dimensional marks.

The problem was initially revealed in the official paper forms, where applicants must choose the form of presentation of their marks by checking one of the four boxes available: word, figurative, device, or three-dimensional marks. The introduction of the e-filing system did nothing to overcome the problem, since the online forms offer the same four check boxes.

The BPTO’s policy constitutes a limitation of trademark owners’ right of filing visually perceptible nontraditional marks, under Article 122. And, in this regard, it creates an intermediate category of trademarks, to be included between those eligible for registration and those excluded from registration. This intermediate category, a “gray zone of eligibility” to registration, is composed of signs eligible to registration in light of the disposition of the Brazilian IP Law (particularly under Article 122) but whose applications for registration face unfair and unnecessary obstacles created by the BPTO.

The gray area is broad and displays different tones of gray. For some types of marks (such as moving images or gesture marks), the number of obstacles set by the BPTO’s practice turn the gray dark, indicating an increased difficulty for the applicant. In other cases, solutions created by trademark attorneys were accepted by the BPTO, leaving the corresponding signs (such as combination of colors or holograms) in a lighter gray area, indicating less difficulty.

In an effort to display the BPTO’s connection with the current needs of trademark owners, BPTO representatives have affirmed that all visually perceptible nontraditional marks are regularly accepted for registration in Brazil and have displayed examples. Such examples include registrations of black and white figurative marks that supposedly represented holograms, gestures, position marks, moving images, and combinations of colors. However, a review of the examples provided by the BPTO, outlined in the next section of this paper, lays bare the limitations on nontraditional marks and reveals how distant its position is from what is experienced by trademark owners in other countries.

27. The e-filing system (named “Sistema e-marcas”) was established by the BPTO’s President through Resolution Nos. 126/2006 and 127/2006, enacted on August 10, 2006, and was made available on September 1, 2006.

28. Pedro Vilhena, A disciplina jurídica das marcas não-tradicionais visualmente perceptíveis no Brasil. Unpublished paper made under the academic supervision of Professor Maitê Cecília Fabbri Moro.

29. The author attended a presentation in 2008 given by Ms. Larissa Clarindo, then trademark examiner at the BPTO.
But what exactly do these registrations protect? The trademark owner intention was, for instance, to obtain a registration for his hologram mark. In order to be able to file an application, the owner had to simplify his hologram to a black and white static image, seen from just one perspective, with no indication of movement, three-dimensionality, or color. The BPTO accepts such an application and grants the corresponding registration, issuing a certificate of registration in which the black and white static image is displayed. If ever such hologram is in any way counterfeited by a competitor of its owner and a lawsuit is filed, the first issue the judge will have to face is determining the scope of the trademark registration, whether it refers to the simplified image or to the hologram its owner actually uses.

Such an obstacle, verified in the exercise of trademark rights and not in the registration thereof, is just one of the many possible negative outcomes of the lack of regulation of the filing, examination, and granting of registrations of nontraditional marks in Brazil. The gray zone is an important flaw in the country's trademark system, creating an imbalance of treatment between different types of signs and generating an undesired level of legal uncertainty in connection with corporate assets.

Considering that the problem arises from the BPTO's internal policy, it seems reasonable to expect that a solution could only come about by act of the agency itself. But before tackling the possible solutions and the existing initiatives, it is important to demonstrate the imbalance of treatment with regard to the eligibility for registration of nontraditional marks, by presenting and briefly discussing some contradictory case law.

D. Administrative Case Law

The BPTO's decisions regarding nontraditional marks have been consistent with its interpretation of the IP Law, denying registration for: (i) signs that are not visually perceptible; (ii) isolated colors; (iii) some combinations of colors found to be usual or nondistinctive; and (iv) slogans that do not perform the functions of a trademark. Moreover, the BPTO's case law regarding three-dimensional marks is also noteworthy, with a number of polemic decisions, rejecting protection for product and package shapes. At the same time, there are a number of registrations granted for device marks that potentially represent nontraditional marks.

There have been no sound marks, taste marks, or smell marks ever filed for registration in Brazil, and, thus, there is no effective case law in this regard. However, the BPTO's statements have historically and consistently denied any possibility of registration
for those types of marks, including explicit mentions to such prohibition in the examination guidelines.\footnote{30}

Regarding isolated colors, the BPTO has been very strict in the interpretation of Article 124, VIII, rejecting all applications filed, such as HRB International’s attempt to obtain a registration for the green square that identifies its consulting services\footnote{31} and Localiza Rent a Car’s application for the color green in connection with car rental.\footnote{32}

The situation is less clear for combinations of colors. In some cases, the BPTO grants the registration without any office actions or first instance rejections, like Gucci’s red-green-red stripes\footnote{33} and Visa’s blue-white-yellow stripes.\footnote{34} In other cases, the BPTO has rejected applications with no apparent reason, as in Kawasaki Motors’ application for a combination of green and black for distinguishing motorcycles\footnote{35} and in Shell’s attempt to obtain exclusivity for its pattern of yellow and red by filing an application for a three-dimensional mark in the shape of a gas station, claiming said colors.\footnote{36}

The same inconsistency may be found with regard to advertising expressions. Most applications are rejected and filed

30. BPTO Guidelines for the Examination of Trademark Applications: “Although every expression comprised in a mark has a sound component, there is no possibility of registration of a mark consisting only of a sound, even if the sound can be represented graphically. ( . . .) The same understanding is applicable to taste and smell marks. Even though it is currently recognized that such signs may function as marks distinguishing goods or services, the IP Law, through the requirement that the claimed sign be visually perceptible, forbids the registration of sound, taste and smell marks.”

31. Application No. 903720825, for a green square, in Class 35 (tax advice services among others), filed by HRB International LLC on June 7, 2011. Rejection decision issued on July 8, 2014: “The mark consists of colors and their denominations with no distinctive form and thus irregistrable under item VIII of Article 124 of the IP Law.”


34. Registration No. 006088244, for a rectangle in three stripes blue-white-golden, in Class 36 (financial services), filed by Visa International Service Association on December 16, 1968. Registration granted on May 25, 1975.

35. Application No. 904096912, for a square with a green upper half and a black lower half, in Class 12 (motorcycles, among others), filed by Kawasaki Motores do Brasil Ltda. on September 26, 2011. Rejection decision issued on September 16, 2014: “The mark consists of colors and their denominations with no distinctive form and thus irregistrable under Item VIII of Article 124 of the IP Law.”

36. Application No. 827816413, for a three-dimensional gas station façade claiming the colors red and yellow, in Class 35 (gas station, among others), filed by Shell Brands International AG on October 14, 2005. Rejection decision issued on June 2, 2009, based on the generic nature of the three-dimensional shape (Item XXI of Article 124 of the IP Law).
away, such as PRAMESA QUALIDADE EM BACALHAU\textsuperscript{37} ("Pramesa Quality in Cod Fish"), but some overcome the BPTO's strict analysis and are converted into registrations, like the trademark É ÓCULOS\textsuperscript{38} (that could be translated as "these are glasses").

It is curious to note that few applicants have appealed to the Federal Courts to try to reverse rejection decisions issued by the BPTO in applications for nontraditional marks. Without registrations, however, several owners of nontraditional marks have reached to the courts to restrain competitors from using their marks, based on unfair competition claims. While the requirements for such claims largely differ from those connected with a trademark infringement claim, plaintiffs usually managed to stop the reproduction or imitation of their nontraditional marks.\textsuperscript{39}

\textbf{E. Optimizing Protection}

Amidst so many gray areas, owners must rely on solid legal strategies for optimizing the protection of its nontraditional marks in Brazil. Such strategies may be used in attempts to obtain proper trademark protection by means of a registration, thus overcoming limitations set by the Brazilian IP Law or by BPTO practice. As good as the results may be, such strategies are evidently palliative measures that allow owners to count on levels of protection that are either lower or substantially different from the regular rights that arise from a trademark registration in Brazil. Therefore, the use of such strategies does not dismiss the need of effective change in Brazilian IP Law.

\textsuperscript{37} Application No. 820343439, for a word mark PRAMESA QUALIDADE EM BACALHAU, in Class 29 (fish), filed by Porto de Mar Comércio de Gêneros Alimentícios Ltda. on October 24, 1997. Rejection decision issued on November 21, 2006, based on the prohibition of registration of advertising expressions (Items VI and VII of Article 124 of the IP Law). Appeal filed and dismissed. Decision sustained.

\textsuperscript{38} Registration No. 824096100, for a device mark É ÓCULOS, in Class 35 (retail of glasses), filed by Dicopol Comércio de Produtos Óticos Ltda on October 3, 2001. Rejection decision issued on November 21, 2006, based on lack of distinctiveness and on the prohibition of registration of advertising expressions (Items VI and VII of Article 124 of the IP Law). Appeal filed and decision reversed. Registration granted on May 8, 2012.

\textsuperscript{39} There have been several lawsuits filed based on unfair competition claims whose main issue is related to the use of an unregistered distinctive sign by a direct competitor. Courts have been very careful in the analysis of such lawsuits, usually inviting plaintiffs to prove that there is effective competition among the parties and judges usually count on court expert reports to assess if the use of the unregistered mark is able to divert costumers. See decision by Goiás State Court issued on November 26, 2002 [re Appeal No. 65558-9/188], about the trade dress of a chain of shoe stores being imitated by an unauthorized competitor, and decision by São Paulo State Court issued on February 19, 2014 [re Appeal No. 9104805-770.2008.8.26.0000], about the similar combination of colors used to identify competing nasal sprays.
When trying to obtain trademark registration for its nontraditional marks, companies must first recognize the best possible way to graphically represent the chosen mark. In other words, owner must translate the nontraditional mark (e.g., a hologram or a moving image) to a static image (or a group of words). Companies have successfully obtained registrations for holograms by filing a simplified version of the holographic three-dimensional image and for moving images by filing a square split in four parts, each of which represents a frame of the motion. Position marks can be filed by the presentation of the mark with dotted lines displaying its position on the product. In all of those cases, submitting an explanatory petition along with the filing papers clarifying the scope of protection aimed is a sign of applicant's good faith and, even if it lacks legal ground, can be used as a defining element in the interpretation of the resulting registration.

Similar strategies may be used even for other marks, such as sound marks. While filing a music sheet as a device mark may be absolutely useless for the protection of the sound represented (the BPTO and courts would certainly construe such application as a logo, instead of a sound), onomatopoeic representations of nonmusical sound marks or the lyrics of musical sound marks can be registered as word marks and may help build stronger claims in case of infringement.

Even some touch marks could be filed as device marks, if their visual aspect is sufficient to allow the BPTO, courts, and competitors to minimally identify the touch sensation provoked by the mark. While such strategy could not be successfully applied to a touch mark consisting of a velvet or leather sensation, it could certainly be useful in the protection of larger patterns such as a rugged bottle.

In any case, the success of any of the strategies above will depend on the effectiveness of the resulting registrations, to be

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40. Registration No. 800243056, for a device mark consisting of a simplified view of Visa's Bird hologram, in Class 36 (financial services, including credit cards and travelers checks), filed by Visa International Service Association on September 1, 1980, granted by the BPTO on December 21, 1982.

41. Registration No. 826006248, for a device mark consisting of four frames of Nokia Connecting People motion mark, in Class 09 (communication devices, among others), filed by Nokia Corporation on October 28, 2003, granted by the BPTO on July 24, 2007.

42. Registration No. 815547480, for a device mark consisting of a New Balance dotted shoe, with the "N" logo on its characteristic position, in Class 25 (sport shoes), filed by New Balance Athletic Shoe, Inc. on May 29, 1990, granted by the BPTO on October 5, 2004.

43. See supra note 4. Established by Law 5,772/71, usually referred to as IP Code.

44. While the author could not retrieve any such case in Brazil, a fitting example comes from a neighbor country: Colombian Registration No. 1545738, for a touch mark named "Old Parr texture bottle," for alcoholic beverages (except beer), filed by Diageo Brands B.V. on February 27, 2015, and granted by the Colombian Trademark Office on June 2, 2016.
assessed before the competent courts whenever an infringement arises. Trademark owner and IP counsel must collaborate in analyzing infringements and electing one that could serve as the leading case. Chances of a positive decision in the first court test of a registration increase in cases of double identity (a full reproduction of the mark applied to an identical product) in which a competition between the parties is detected. The reunion of those elements makes it difficult for the adverse party to present distracting claims and, thus, helps the judge focus on the validity and enforceability of the registration.

III. PERSPECTIVES: IS A CHANGE EVER GOING TO COME?

As mentioned in the introduction, the last important change in Brazilian IP Law, in 1997, resulted from an external factor (the obligations set forth in the TRIPS Agreement).45 Intellectual property faces a period of discredit and suspicion by some sectors of the public,46 as these sectors struggle to accept the existence and enforcement of exclusive rights. Moreover, the Brazilian government has not always been successful in obtaining solutions for the structural and systematic problems related to obtaining and protecting IP rights. A telling example of the size of such problems is the infrastructure of the BPTO, which currently employs approximately only one hundred analysts to examine an annual inflow of 150,000 applications, resulting in a backlog that surpasses half a million pending applications.47


46. Contemporary criticism may be exemplified by the proposals of the Pirate Parties (now present in more than ten European countries, as well as in some states of the United States of America), which defend the reform of the Copyright and Patent Laws, aiming at limiting the scope and shortening the terms of protection in order to allow the “free flow” or “sharing” of ideas, knowledge and culture.” See Principles at pirateparty.org.uk/policy or partidopirata.org/quem-somos/estrutura-nacional/documentos/estatuto.

47. Associação Brasileira da Propriedade Intelectual. Propostas para a Inovação e a Propriedade Intelectual. Vol. 1 Fatores de Crescimento Econômico, Competitividade Industrial e Atração de Investimentos. (ABPI, 2014 under the presidency of Elisabeth Kasznar Fekete): “According to the BPTO, the increase of the backlog in the recent years was caused by the elevation of the amount of filings. In fact, still according to the autarchy, only in 2013, at least 507,000 trademarks and 184,200 patents were pending. Between January and May of the current year, 83.5% of the trademark applications accepted in the period took between three to four years to be analyzed. In relation to patents, 63.3% [of the accepted applications] took more than ten years.”
Aware of such problems, the federal government started to analyze, plan, and propose modernization measures, in connection with the rendering of the agency’s basic services and with the acceleration of examination and the adopting of regulatory and structural reforms.\textsuperscript{48} In such context, it is expected that one of the projects will respond to applicant demands regarding nontraditional marks, which would likely entail an increase in filings. For the last decade, the BPTO has been concentrating its efforts in education and cooperation, and updating its concepts, definitions, or filing procedures.

In view of the recent initiatives of public administration, in cooperation with the private sector, the panorama now shows trademark owners exploring better ways of pressuring the Congress and the federal agencies to move forward in toward full protection of nontraditional marks in Brazil.

\textbf{A. Proposed Solution: Paving the Way to Graphic Representation}

When this subject was first analyzed by the author in 2006,\textsuperscript{49} nontraditional marks were seldom cited as a problem and the BPTO was silent about their registrability under Brazilian law. At that time, only a couple of articles had been written and even important works on trademark law by renowned authors failed to address the issue.

Almost a decade later, a lot has changed. The globalization of the economy and the trademark portfolios built by multinational corporations have gradually introduced most stakeholders to situations involving nontraditional marks. The various problems posed by the existence of a gray zone of registrability likely contributed to a wave of awareness, opening the discussion to more and more forums and revealing the urgency of finding solutions.

In 2006, the BPTO refrained from being involved in external discussions on nontraditional marks. It would not have come as a surprise if the agency had issued a statement interpreting the IP Law in a form that denied protection to nontraditional marks. But throughout the years, in meetings, presentations, and informal conversations, the BPTO revealed a more coherent and conciliatory position: nontraditional marks are eligible for registration if they somehow meet the requirement of visual perceptibility. So, the core of the problem is less about understanding what is or is not eligible for registration and more

\textsuperscript{48} Structural changes performed in the terms of Federal Decree No. 8854, of September 22, 2016.

\textsuperscript{49} Pedro Vilhena, \textit{A disciplina jurídica das marcas não-tradicionais visualmente perceptíveis no Brasil}. Unpublished paper made under the academic supervision of Professor Maitê Cecília Fabbri Moro.
about finding more efficient logistical ways of recognizing, granting, and enforcing the rights of the owners of nontraditional marks that may defy easy visual or graphic representation.

As seen in Part II.C. above, the BPTO has no precise rules regarding representation of marks in applications filed. Such lack of regulation is the source of most of the problems currently faced by companies that decide to invest in the creation of a nontraditional mark. In this sense, establishing a set of rules regarding the graphic representation of trademarks for registration purposes may be one crucial step toward embracing more current practices and policies that can ultimately prepare the country for the registrations of nontraditional marks.

The functions of graphic representation are (i) identifying the protected matter, (ii) informing third parties, and (iii) allowing the administration of the system. And, to this extent, enhancing graphic representation is important not only to nontraditional marks, but for the core functionality of any registration system as whole. The graphic representation of the sign registered as a trademark is what will determine the extent of its protection and, thus, it is an essential tool in guaranteeing legal certainty in the market.

Therefore, regardless of the need for protection of nontraditional marks, Brazil could highly benefit from higher standards of graphic representation, including the determination of more accurate forms of representation, such as a description in words and the indication of a color code.

B. Initiatives by INTA’s Non-Traditional Marks Committee

INTA’s increasing presence in Latin America is reflected in the number of its activities in Brazil. The activities of the Non-Traditional Marks Committee in Brazil have been facilitated by the good relations established between INTA’s Government Officials Training Committee and BPTO officials.

The talks among the Non-Traditional Marks Committee and the Government Officials Training Committee and the BPTO started in 2008, and have proved to be useful in paving the way for the recognition of nontraditional marks by the agency. Since then, two meetings between representatives of the Non-Traditional Marks Committee and the BPTO’s officials have taken place. On both occasions, the Non-Traditional Marks Committee presented

52. Reference is made to the very recent approval, by INTA’s Board of Directors, of the establishment of a Latin America Representative Office in Santiago, Chile.
the need for protecting nontraditional marks, and the practices of other national offices compared with examples that could be identified in Brazil. Such meetings also led to a more proactive collaboration between INTA and the BPTO, not only in connection with nontraditional trademarks, but also in other topics. In recent years, at least six talks from INTA’s representatives have taken place in the headquarters of the BPTO, to audiences of trademark examiners. Each of the presentations focused on one aspect of nontraditional marks: the economic rationale allowing their protection, the criteria used for their classification, the challenges regarding distinctiveness of such signs and the ways of graphically representing them. The author presented two of these lectures and experienced the examiners’ views about nontraditional marks, ranging from an expected initial skepticism to an openness of mind.

The positive consequences of such initiatives are experienced in both the short and long term. The meetings help the officials to realize how important the issue is and prepare them for a possible future change.

INTA’s role in South America has increased, as the region has become one of the association’s priorities. INTA entered into a memorandum of understanding with the Colombian Trademark Office53 and engaged in talks with the BPTO. Though it is too soon to assess the outcome of this new priority status, the BPTO is likely to be more willing to engage in open-minded conversations with INTA’s representatives, and this may be seen as a new set of opportunities to bring the subject of nontraditional marks to the BPTO’s attention.

It is also important to observe that INTA’s Committees may now engage in talks with different areas of the BPTO. INTA could try to engage in an exchange with the BPTO’s Intellectual Property Academy, an institution that offers Masters and Doctorate programs in Intellectual Property. By reaching to the academic arm of the BPTO, INTA may also contribute to internal debates and possibly attract master and doctorate students to the analysis of nontraditional signs.

C. Initiatives by ABPI
(Brazilian Intellectual Property Association)

ABPI is an active national association whose main strength is the union of nearly all of the country’s IP firms and some of the most important companies, especially those with an innovative character. For years, ABPI had a nonlinear connection with nontraditional marks and the subject had been occasionally

brought to the association’s many channels of communication (its bulletin, its academic publication, its Trademark Commission, its roundtables, or its annual meetings’ seminars). But the analysis was usually perfunctory and there was not a concentration of efforts in connection with the challenges Brazil must face in order to offer complete protection to nontraditional signs.

The creation, in 2011, of a Corporate Committee was an important step toward change. The Committee is composed exclusively of more than seventy in-house attorneys from the country’s biggest companies in different fields of activities. Deliberating on the situation of trademark protection in Brazil in 2012, the Committee decided to tackle the issue of nontraditional marks institutionally by calling the Trademark Commission to action and requesting a study on the situation of nontraditional marks in Brazil and on the necessary measures to obtain full legal protection. The Trademark Commission conducted an analysis of the situation and decided to create two task forces: one dedicated to visually perceptible signs and the other dedicated to non–visually perceptible signs.

The task of the first group was to assess the ways of changing the BPTO’s regulations and procedures in order to allow for a less cumbersome registration process of visually perceptible nontraditional marks (those mentioned above as being in a gray area) resulting in registrations that more clearly define the scope of the registered rights. The main scope was to study and reveal the main flaws of the current regulations and of the interpretations of the IP Law, as well as to offer a draft detailing more current ideas emanating from experiences of other national agencies. The group’s objective was to deliver a work that could effectively be used as a tool by the BPTO’s officials to improve their practices, rather than a long paper criticizing the agency’s positions.

As for the second group, the task was to draft a bill of law withdrawing the visual perceptibility requirement and establishing the rules for the registration of non–visually perceptible marks.

The works of both groups were carried out throughout 2013, in both Rio de Janeiro and São Paulo, with the volunteer help of several prominent trademark attorneys. As usually happens in associative activities, the works were paused in December 2013 in view of the inauguration of ABPI’s new officials and coordinators, and the perspective was to resume the works in the first quarter of 2014.

When the Trademark Commission was ready to resume and finalize the works, the BPTO’s Trademark Directorate issued new guidelines for trademark examination, formalizing some of the agency’s interpretations of the IP Law and introducing some new
rules. Yet it is important to stress that no mention of nontraditional marks is made in the guidelines.

The urgency of the analysis of these new guidelines postponed indefinitely the activities of the working groups. After this two-year gap, both the Corporate Committee and the Trademark Commission must reassess the need and/or interest of resuming the work of the task forces. If the project is resumed, it is expected that its members will submit a report, including the proposed drafts for legal and regulatory amendments, for the approval of the Trademark Commission. Then, the Commission will send the report to the Corporate Committee for analysis. Finally, both the Committee and the Commission will send the report to ABPI's officials for publication as an institutional document. At this time, members of all ABPI's bodies will have the possibility to openly discuss the issue and to strategically present the issue to policymakers and members of the Congress.

D. Obstacles to These Initiatives

The initiatives by INTA and ABPI have something in common: more than requesting immediate change, the associations have shown themselves to be eager to help and to provide tools to the BPTO, so that it can be prepared to implement and administer such change. It is intended to be a collaborative approach, rather than a contentious one. Another common trait is the institutionalization of the subject. Both INTA and ABPI managed to turn this very particular subject into an issue in their institutional agendas, which has been useful in allowing the participation of more and more people. On the negative side, the initiatives may be regarded as superficial, since none of the associations managed to create a permanent link to the BPTO or to other stakeholders in developing a more proactive role. In other words, it seems that meetings and lectures will not be enough to provoke a change. And this is particularly important, in view of the strength of the obstacles faced by the initiatives.

The main obstacles: (i) the current situation of the BPTO and the difficulties faced by the public sector in Brazil; (ii) the peculiarities of lawmaking in Brazil; and (iii) the absence of an echo of the need for such initiatives in most forums.

These obstacles operate in two different ways: while the first obstacle actively blocks the positive effects of the initiatives from taking place, the remaining obstacles passively contribute to the maintenance of the status quo.

The average time the BPTO takes to analyze a trademark application (from three to six years) generates impacts that hinder
the repression of counterfeiting. It also lends itself to the facile and mistaken idea that filing applications is not important, which helps to explain the low number of trademark applications filed in Brazil in recent years (approximately 150,000 per year, against 1,600,000 in China). Amid such reality, both the federal government and the BPTO started acting proactively to ensure the enforcement of existing rules and, eventually, to create new rules.

As for the remaining reasons, they could be summarized in the expression “financial difficulties.” Change is always difficult, and it takes a lot of energy and many investments to obtain results. Several sectors of the public service in Brazil are resistant to change and lawmakers’ interest in intellectual property matters has not been converted into new laws (nearly no changes have been introduced to the country’s current IP Law since its enactment in 1996). So it is understandable that that examiners, officials, the BPTO, public administrators, the National Congress, and even politicians find difficulties in they attempts to change the country’s legal and administrative approach to intellectual property.

The final obstacle is probably the easiest to overcome. Even if there is a sense of apathy in some forums, enthusiasm may be found in associations and most colleges. In some cases, the silence may simply be a matter of lack of openness to dialogue. In this sense, it is important for companies and associations of the private sector to reach out to new partners and to try to establish a comprehensive and cohesive discussion of the matter, by means of seminars, debates, joint working groups, roundtables, etc. It would also be beneficial to increase exchange among trademark attorneys and in-house lawyers, which could open ground for new lawsuits, submitting to the country’s courts the decision on the eligibility for registration of some types of signs. Overcoming such final obstacle could be an important step in using the courts’ power to legislate by creating consistent paradigmatic precedents whose continued reproduction in similar cases will finally demand some kind of extra regulation by law and regulation makers.

IV. CONCLUSION

Promoting change in Brazil is not an easy task. Bureaucratic obstacles, when not properly dealt with, work against new ideas, instead of promoting them, compressing the country’s dynamic


56. All the modifications were introduced by Law No. 10,196/2001 and refer to patent issues. The trademark section of the IP Law remains unaltered.
economy and blocking what could be its natural organic growth. And this applies to nontraditional marks. Brazil’s main competitors (local and global) have recognized the importance of these new signs for the economy of this century. Now, it is up to Brazil to discuss the issue openly, in view of problems that still affect the structure of the BPTO. Overcoming such obstacles will entail, at least, two positive outcomes: mitigating some investors’ impression that the country lacks regulation and ending the senseless limitations placed on the operations of companies.

Such evolution will also serve as an incentive for Brazilian and foreign companies to rely on new technologies to identify and promote their products and services. On the other hand, those companies that take risks and proceed to the creation of new signs will no longer count solely on indirect legal provisions (such as those repressing unfair competition) and will be granted a higher level of protection for their efforts. It is, thus, necessary to correct the current situation, which exposes companies to the unfair risk of being emulated by a third party using a similar trademark, without the possibility of relying on a trademark registration for protection. In some cases, the infringing party can even get away with its behavior, since the laws for combating acts of unfair competition do not apply when no competition can be proven. The damages caused by such situation for trademark owners may be even bigger: even if a court grants an order of cessation of use based on unfair competition, the amount of damages to be awarded may be significantly lower. While most Brazilian courts agree that the damage in trademark infringement may be presumed (the use of one’s mark by a third party is considered a damage in re ipsa\textsuperscript{57}), they also agree that the damage must be proved in claims of unfair competition.\textsuperscript{58}

It is fundamental to acknowledge that the creation, promotion, and exploitation of a nontraditional mark entails bigger investments than those required for the introduction of a traditional mark. Thus, the use of such a sign by any third party is able to acutely hurt the owner’s investments.

\textsuperscript{57} See decision by the Superior Tribunal de Justiça (Brazilian highest court for non-constitutional matters) issued on August 4, 2011 [re Special Appeal No. 1174098]: “In cases dealing with undue trademark use, able to provoke confusions between the companies and consequential diversion of customers, it is unnecessary to present evidence of the damages, which are presumed.”

\textsuperscript{58} See decision by the State Court of Rio Grande do Sul issued on February 4, 1999 [re Appeal No. 598070324]: “Unfair competition is only possible if there is intent. For it to be verified, there must also be concrete evidence of the damages or of a risk of damage, and the mere possibility of damage cannot be considered sufficient, because the commercial competition is of the essence of the market economy, where the dispute among companies is a natural consequence. If intent, damage or risk of damage are not proved, the lawsuit cannot be upheld.”
But change is needed not only because of the risks posed by the current situation, but also in view of the many benefits that can arise from modern regulation of nontraditional marks. In a regulated market, Brazilian and foreign companies could start to deliberately invest in new types of signs, using as tools in such strategy the creativity of the country’s advertising tradition and the massive internal market, which can provide tests in large scale for markets like the European Union and the United States. Apart from the economy itself, such investments could also represent benefits in other areas, like the creation of new jobs, the development of the internal market and the recognition of prior investments in some of the country’s most important marks.

The final question is how to provoke change in an unwelcoming environment. And this is a difficult question, because it implies that there is a manner of doing something that was not done yet. And that manner must be put into action by someone, in some way, at a given time, with the right forum and under determined conditions. So, the final question hides a lot of other equally essential questions.

Measures taken isolatedly tend to have limited impacts. It is thus expected that the involved parties, such as the BPTO, public administration, associations, trademark owners, attorneys, and courts will concentrate and connect their efforts, aiming at better results.

As discussed above, INTA and ABPI have made important moves toward the recognition of nontraditional marks by the Brazilian legal framework, in constant and consistent works. Moreover, the interested parties must direct these efforts to obtaining an amendment of the country’s IP Law by the National Congress and to assisting the BPTO to proceed with regulatory changes.

Given the urgency of the matter, it is time that such concerted efforts take place. Changes like this take time, and preparation is needed. So, the sooner the engines start to turn, the better for the share of the Brazilian market that is currently exposed to unnecessary risks.

Finally, it is also important to mention the contribution made by some trademark owners. On behalf of owners’ best interests, finding ways to protect a given intangible asset is an effort toward change, rather than the mere executions of a professional obligation. In this sense, they are expected to remain vigilant in detecting nontraditional marks and in proposing the most adequate course of action to obtain legal protection. As mentioned above, some visually perceptible signs are insufficiently protected in Brazil, as their registration is only allowed by a figurative depiction of the complex mark, which increases the level of legal uncertainty. In such cases, proactive advice should be given,
detailing the possible lawsuits that could declare the shortcomings of the BPTO’s approach and determine a change in the agency’s practices.

Such measures certainly will lead Brazil out of the uncertainties of the gray zone, solidifying the protection of nontraditional marks in its creative internal market.
REGISTRABILIDADE DE MARCAS NÃO TRADICIONAIS NO BRASIL: SITUAÇÃO ATUAL E PERSPECTIVAS*

Por Pedro Vilhena**

I. INTRODUÇÃO


Em um mercado crescentemente competitivo, cada uma dessas formas de comunicação é importante e pode representar uma vantagem na batalha para conquistar a atenção, a preferência e a lealdade dos consumidores. A evolução da tecnologia e o elevado nível de atividade comercial levaram as empresas a desenvolver e oferecer não apenas produtos e serviços melhores, mas também melhores experiências de consumo. Essas experiências frequentemente envolvem consumidores em uma aura de sensações prazerosas que resultam da estratégica composição de diversos elementos.

A maior parte dos sinais listados acima, genericamente denominados “marcas não tradicionais”, é estudada, criada, aprimorada e adotada por empresas com finalidade meramente publicitária. Logo, o interesse inicial no uso dos elementos é se destacar dos produtos de seus concorrentes e arrebatar os olhos (ou narizes ou ouvidos, dependendo do caso) dos consumidores no mercado, físico ou virtual. Mas os efeitos de tal estratégia podem variar.

Quase sempre o uso destes sinais permanece puramente publicitário. Por meio de peças de propaganda, eles comunicam os valores e a imagem de uma empresa, um produto ou um serviço. E

* The author of this piece produced both an English article and a Portuguese translation. INTA staff and members of The Trademark Reporter (TMR) Committee edited the English article, and the author then carried those edits to the Portuguese translation. INTA staff and members of the TMR Committee have taken steps to ensure that the author’s intended meaning is preserved in both the English article and Portuguese translation; however, because of language limitations, INTA has not undertaken its normal editorial process with regard to the Portuguese translation and does not vouch for absolute translation accuracy between the two articles. INTA’s goal is to expose important non-English writing on trademark law issues to the broader audience of its TMR readership.

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desaparecem das mentes dos consumidores tão logo o material publicitário é substituído por novas peças.

Há casos, entretanto, por razões que devem interessar mais aos publicitários do que aos advogados, que este período de uso publicitário se revela suficiente para criar uma conexão associativa na mente dos consumidores entre um determinado sinal e o produto ou serviço que ele promove. Essa conexão associativa é uma ferramenta que permite aos consumidores identificar, ou distinguir, um produto de outros produtos similares ou um serviço de outros serviços similares. Tal sinal, em outras palavras, passa a exercer a função de marca.

De forma simplificada, marcas não tradicionais são sinais que, apesar de sua situação ontológica aparentemente inapropriada, conseguem distinguir produtos e serviços no mercado.

O tema foi tratado ao longo das últimas décadas em jurisdições como os Estados Unidos, a União Europeia e a Argentina, por exemplo, mas razões como baixa performance econômica, crises políticas e processos legislativos conservadores e lentos deixaram inerentes importantes mercados emergentes, que não atualizaram seus sistemas legais para reconhecer e proteger adequadamente as marcas não tradicionais. Este artigo apresenta a experiência brasileira.

A. Recente evolução mercadológica e legal

Depois de décadas de luta contra a hiperinflação, a economia brasileira finalmente achou terrenos mais estáveis para seu crescimento em meados da década de 1990, seguindo a reabertura do mercado brasileiro a bens importados e a criação exitosa de uma nova moeda. Levadas por um substancial mercado interno e impulsionadas por agências de publicidade mundialmente renomadas, algumas empresas brasileiras implementaram estratégias de marketing intrincadas e ousadas formas de comunicação corporativa.

A conjunção de tantos fatores positivos criou uma atmosfera fértil para a exploração de marcas não tradicionais, que gradualmente começaram a criar conexões associativas e a exercer funções de marca. São abundantes os exemplos recentes: o gesto de um dedo levantado identificando uma das cervejas mais vendidas do país,¹ uma combinação de cores identificando uma rede de

1. Uma imagem representativa do gesto (uma mão cerrada com o dedo indicador levantado simbolizando o número 1) foi registrada como marca figurativa sob o n. 817935487, na classe 35.10 (bebidas, xaropes e sucos concentrados), depositado por Ambev S.A. em 11 de agosto de 1994 e concedido pelo INPI em 01 de outubro de 1996. O gesto ficou famoso por meio de publicidade intensiva ao longo de 1993 e 1994, incluindo contratos de patrocínio com jogadores de futebol que passaram a utilizá-lo na celebração de seus gols em jogos oficiais. A estratégia incluiu a contratação do atacante Romário para que fizesse o
postos de gasolina, e uma curta vinheta musical parecida com “plim plim” identificando a maior empresa de teledifusão do país. Pode-se, desde logo, atestar que as marcas não tradicionais fazem parte da paisagem comercial brasileira.

As marcas não tradicionais são ainda incomuns e podem parecer raras, se comparadas à quantidade de marcas nominativas ou figurativas. No entanto, a empresa que investe substanciais recursos na criação de um destes sinais certamente não está disposta a compartilhar o resultado de seus esforços com terceiros, sobretudo com seus concorrentes diretos. Então, ainda que o número de marcas não tradicionais seja baixo, elas usualmente constituem importantes ativos de seus titulares, o que reclama proteção legal.

A evolução verificada nas práticas de mercado não encontra reflexo no espectro legislativo. O Código da Propriedade Industrial vigente até 14 de abril de 1997 não mencionava marcas não tradicionais. O CPI listava como registráveis como marca “os nomes, palavras, denominações, monogramas, emblemas, símbolos, figuras e quaisquer outros sinais distintivos”, mas essa registrabilidade era restrita aos sinais cuja apropriação exclusiva não restava impedida por outros dispositivos legais, como cores isoladas e a forma de produtos e de suas embalagens. Ademais, apesar da ausência de proibição legal, a interpretação dada pelo INPI a esses dispositivos legais levava à irregistrabilidade de fato de sinais não visualmente perceptíveis. Em outras palavras, sob uma perspectiva ontológica, a gama de sinais registráveis como marca era efetivamente restrita a marcas nominativas e figurativas bidimensionais. Apesar do anseio da indústria nacional por uma gama mais ampla de proteção de marcas, a questão manteve-se inalterada durante toda a vigência do CPI. Se as pressões locais foram demasiadamente sutis para provocar qualquer ação de órgãos legislativos e administrativos do país (o INPI, inclusive), um fator externo foi o responsável definitivo pela revisão recente da estrutura legal brasileira relacionada à gestão ao comemorar seus gols na Copa do Mundo de Futebol de 1994. Ele terminou o torneio como um dos melhores atacantes, amplificando o alcance do gesto.


4. Estabelecido pela Lei 5.772/71, usualmente designado “CPI”.

5. Nome oficial: Instituto Nacional da Propriedade Industrial – INPI.
propriedade industrial: o Acordo TRIPS\textsuperscript{6}, que impôs ao país uma série de novas obrigações internacionais.

\section*{B. O Acordo TRIPS e a LPI}

O capítulo sobre Marcas do Acordo TRIPS revela uma tendência facilmente reconhecível nas atas de discussão do Acordo: enquanto países desenvolvidos buscavam proteção marcaria mais abrangente (incluindo a ampliação da gama de sinais registráveis), outros países usavam dificuldades econômicas e burocráticas como argumento para resistir à expansão da proteção. Para o escopo deste artigo, nossa análise se concentra no Artigo 15.1:

“Qualquer sinal, ou combinação de sinais, capaz de distinguir bens e serviços de um empreendimento daqueles de outro empreendimento, poderá constituir uma marca. Estes sinais, em particular palavras, inclusive nomes próprios, letras, numerais, elementos figurativos e combinação de cores, bem como qualquer combinação desses sinais, serão registráveis como marcas. Quando os sinais não forem intrinsecamente capazes de distinguir os bens e serviços pertinentes, os Membros poderão condicionar a possibilidade do registro ao caráter distintivo que tenham adquirido pelo seu uso. Os \textit{Membros poderão exigir, como condição para registro, que os sinais sejam visualmente perceptíveis.”} (Grifos nossos)

A redação do artigo reflete a discrepância de interesses. A primeira sentença estabelece uma definição aberta de marca sem limitações com relação à natureza ontológica dos sinais. Neste sentido, a definição estabelecida pelo Acordo favorece uma visão teleológica das marcas,\textsuperscript{7} que leva à caracterização de uma marca pelas funções que ela exerce e não pela natureza do sinal que a compõe ou constitui.\textsuperscript{8} Uma definição tão ampla decorre dos interesses de países desenvolvidos, cujas empresas nacionais são titulares de marcas ávidas para obter e aplicar seus direitos em tantos territórios quanto seja possível.

Contrabalançando a sentença inicial, a última cláusula do Artigo 15.1 leva em conta a preocupação de países em desenvolvimento com relação à proteção excessiva de marcas não

\begin{itemize}
\item \textsuperscript{6} O Acordo sobre Aspectos dos Direitos de Propriedade Intelectual relacionados ao Comércio (o Acordo TRIPS), tal como concluído durante a Rodada do Uruguai.
\item \textsuperscript{7} G. B. Dinwoodie, \textit{The Death of Ontology: A Teleological Approach to Trademark Law}, 84 Iowa L. Rev. (1999).
\item \textsuperscript{8} A Suprema Corte dos Estados Unidos da América adotou essa perspectiva em 1995, atestando que “[é] a habilidade de distinguir a origem – e não a situação ontológica como uma cor, uma forma, uma fragrância, uma palavra ou um sinal – que permite que a marca sirva a tais finalidades básicas [...]. E, por essa razão, é difícil encontrar, nos objetivos básicos de uma marca, um motivo que desqualifique de forma absoluta o uso de uma cor como marca.” (in Qualitex Co. v. Jacobson Products Co., Inc., 514 U.S. 159 (1995)).
\end{itemize}
A promulgação da nova LPI representou um passo importante, ainda que pequeno, na criação de um ambiente mais protetivo das marcas, pela revisão da definição legal de marca, reduzindo o escopo da matéria excluída da proteção e refinando os critérios de registrabilidade. Em geral, seus termos foram elogiados, mas foram frustrados os anseios da indústria quanto à proteção de marcas não tradicionais.

II. PROTEÇÃO DE MARCAS NÃO TRADICIONAIS: ESCOPO E EXCLUSÕES

Quase vinte anos após a promulgação da LPI, é possível afirmar que as inovações trazidas foram menos ousadas do que deveriam. Neste sentido, modificações adicionais seriam muito bem-vindas e levariam o país a um patamar mais moderno de proteção.

9. Essa preocupação não era nova e já havia sido manifestada na década de 1960, durante a criação da Lei-Modelo para Países em Desenvolvimento sobre Marcas, Nomes Comerciais e Atos de Concorrência Desleal pelos Escritórios Internacionais Reunidos para a Proteção da Propriedade Intelectual – BIRPI, e foram reportadas pelo presidente do órgão, Georg Hendrik Christiaan Bodenhausen: “[O] Segundo Comitê de Lei-Modelo considerou a questão se, nas definições, a palavra ‘visível’ deve ser deletada ou substituída por ‘perceptível’, de forma a incluir na definição de marcas sinais auditivos, olfativos e outros não-visuais. Essas propostas, no entanto, não foram adotadas por três razões: primeiro, sinais não visuais usados para identificar produtos ou serviços são muito menos comuns que sinais visuais, apesar de alguns sinais auditivos serem usados em teledifusão; segundo, esses sinais, mesmo que não admitidos como marcas, são protegidos de confusão por meio de normas de repressão à concorrência desleal; terceiro, a aceitação de sinais não visuais como marcas causaria complicações com relação ao seu registro, e isso foi considerado indesejável, especialmente em países em desenvolvimento.” (in Model Law for Developing Countries on Marks, Trade Names, and Acts of Unfair Competition (BIRPI, 1967)).


Nesta Parte II, analisa-se aquilo que pode ser protegido pelo Direito de Marcas e a matéria legalmente excluída de tal proteção. Uma perspectiva estritamente legal, extraída da interpretação das disposições da LPI à luz de outros textos legais aplicáveis (locais e internacionais) é apresentada na Seção II.A. Essa análise é seguida, na Seção II.B, por uma revisão das opiniões de doutrinadores e advogados quanto à evolução da gama de sinais registráveis no Brasil. Na Seção II.C, a situação de alguns tipos de sinais admitidos pelo texto legal, mas ignorados pelo INPI, é discutida e classificada como uma zona cinzenta de registrabilidade. Finalmente, a Seção II.D. discute a jurisprudência sobre o tema, incluindo decisões administrativas, do INPI, e judiciais, das cortes federais.

A. Analisando a LPI

O Título III da LPI, dedicado às marcas, guarda logo início uma curiosa inversão: ao invés de definir o que são marcas para, posteriormente, delimitar quais marcas são registráveis, o texto legal faz justamente o oposto.12 Essa inversão tem causado uma contínua diminuição da importância da definição legal de marca no Brasil, o que se verifica no baixo número de menções da definição legal em petições judiciais ou administrativas, bem como em livros e artigos acadêmicos. A inversão da ordem dos artigos também contribuiu para a difusão de que uma marca é necessariamente visualmente perceptível, o que não decorre da definição legal trazida no Artigo 123. Em termos gerais, qualquer sinal pode constituir uma marca, desde que seja usado “para distinguir produto ou serviço de outro idêntico, semelhante ou afim, de origem diversa”. A expressão “sinais visualmente perceptíveis” é usada, na verdade, para estreitar a gama de sinais registráveis como marca, à luz do Artigo 122.

Como anteriormente ressaltado, a restrição do Artigo 122 decorre da permissão estabelecida no final do Artigo 15.1 do Acordo TRIPS. O uso de tal permissão pelo Brasil é contraditório em relação à posição do país durante as negociações. Apesar de o país ter historicamente ignorado as marcas não tradicionais, os representantes brasileiros negociaram em favor de uma definição menos tradicional. A maior parte das minutas patrocinadas ou

12. LPI – Artigo 122 - São suscetíveis de registro como marca os sinais distintivos visualmente perceptíveis, não compreendidos nas proibições legais. (Grifos nossos.) Artigo 123 - Para os efeitos desta Lei, considera-se: I - marca de produto ou serviço: aquela usada para distinguir produto ou serviço de outro idêntico, semelhante ou afim, de origem diversa; II - marca de certificação: aquela usada para atestar a conformidade de um produto ou serviço com determinadas normas ou especificações técnicas, notadamente quanto à qualidade, natureza, material utilizado e metodologia empregada; e III - marca coletiva: aquela usada para identificar produtos ou serviços provindos de membros de uma determinada entidade.
apoia a delegação brasileira era silente com relação à natureza dos sinais que poderiam constituir uma marca e/ou serem registrados como tal.13 Há, entretanto, uma diferença entre negociar em um fórum internacional e implementar os resultados de tal negociação no direito interno, o que ocorreu por meio de discussões no Congresso Nacional que levaram à adoção do requisito da perceptibilidade visual.

A consequência lógica imediata do texto do Artigo 122 é que qualquer sinal que não seja visualmente perceptível é irregistrável como marca, por mais distintivo que seja inerentemente ou que venha a ser pelo uso. Neste caso, a exclusão é tácita, mas sua clareza deixa pouco espaço para discussão: marcas sonoras, gustativas, olfativas, e qualquer combinação de sinais incluindo um destes elementos são irregistráveis no Brasil, à luz do conceito de registrabilidade limitada de marca esculpido no Artigo 122.

Seria precipitado, entretanto, interpretar Artigo 122 no sentido de que qualquer sinal visualmente perceptível poderia ser registrado como marca. A perceptibilidade visual sozinha não garante que um sinal poderá ser objeto de proteção proprietária, visto que o Artigo 122 ainda exige que o sinal seja “distintivo” e que não esteja “compreendido nas proibições legais”. A menção ao caráter distintivo do sinal reforça o papel da distintividade como a função essencial da marca no ordenamento jurídico brasileiro.14 O requisito da distintividade não limita de qualquer forma a gama de sinais registráveis e a jurisprudência nos traz exemplos abundantes de sinais de todas as naturezas que foram reconhecidos como distintivos.

Por outro lado, a LPI contém uma lista extensa de proibições ao registro, com 23 itens listados no Artigo 124. A análise desta

13. A definição incluída na Minuta Brasileira de 1989 se dava por meio de exemplos como “nomes, palavras, denominações, monogramas, emblemas, e símbolos que permitem a diferenciação de produtos e serviços para fins comerciais”. Em maio de 1990, o Brasil patrocinou a Minuta Conjunta dos Países Em Desenvolvimento, que defendia que as formalidades e requisitos para registro de marcas deveriam ser estabelecidas pela lei nacional. Essa fórmula foi utilizada novamente na Minuta Anell, de junho de 1990, parcialmente patrocinada pelo Brasil (a minuta continha disposições A, patrocinadas por países desenvolvidos, e disposições B, patrocinadas por países em desenvolvimento).

lista revela algumas limitações importantes (e, por interpretação reversa, algumas permissões importantes) conectadas à natureza do sinal distintivo. Primeiramente, o inciso VII estabelece que não é suscetível de registro como marca o “sinal ou expressão empregada apenas como meio de propaganda”. Expressões de propaganda (ou “slogans”) tem sido consideradas como um tipo de marca não tradicional, à medida que elas podem criar uma conexão associativa entre o consumidor e um produto ou serviço específico. Essa disposição impede o registro de sinais e expressões de propaganda que são usados apenas como meio de propaganda e que, portanto, não são usados como marcas. Mas interpretar tais termos a contrário senso revela um entendimento diferente: o registro como marca é possível para sinais e expressões de propaganda que sejam também usados como marcas. Essa interpretação incorpora a aplicação da visão teleológica do Direito de Marcas aos slogans no Brasil: se é usado e funciona como marca, é registrável como marca, mesmo que se trate, por acaso, de um sinal ou expressão de propaganda.

O subsequente inciso VIII refere-se à irregistrabilidade de cores como marcas. A lei estabelece uma regra geral – “cores e suas denominações não são registráveis – para então inserir uma exceção permissiva – “salvo se dispostas ou combinadas de modo peculiar e distintivo”. Para determinar o que é registrável sob o Artigo 124, VIII, é importante primeiro analisar a exceção. A proibição não se opera contra cores que foram arranjadas ou combinadas, o que leva à conclusão lógica de que uma cor isolada é irregistrável, visto que não poderia ser arranjada ou combinada consigo mesma. Logo, a exceção se refere a sinais compostos por duas ou mais cores. Desta forma, sob o Artigo 124, VII, são registráveis as combinações e arranjos de cores peculiares e distintivos, e restam irregistráveis tanto as cores isoladas quanto os arranjos e combinações usuais ou desprovidos de distintividade.

Em relação às marcas tridimensionais, o inciso XXI do Artigo 124 estabelece a irregistrabilidade de “forma necessária, comum ou vulgar do produto ou de acondicionamento, ou, ainda, aquela que não possa ser dissociada de efeito técnico”. Novamente aqui, a lógica reversa pode ser aplicada: formas tridimensionais que não se enquadram na proibição do Artigo 124, inciso XXI, são registráveis como marcas.

Diante do exposto, de um ponto de vista puramente legalista, a LPI permite o registro como marca de sinais distintivos visualmente perceptíveis, incluindo:

- alguns sinais e expressões de propaganda usados como marcas;
- combinações e arranjos de cores peculiares e distintivos; e
formas tridimensionais que não sejam necessárias, comuns ou usuais e que possam ser dissociadas de um efeito técnicos.

Por outro lado, além da exclusão tácita de sinais não visíveis (como, por exemplo, marcas sonoras, tácteis, gustativas ou olfativas), a LPI ainda exclui expressamente da proteção marcaria:

- sinais e expressões de propaganda utilizados apenas como meio de propaganda;
- cores isoladas;
- combinações e arranjos de cores que sejam usuais, comuns ou não distintivos;
- formas de produtos ou embalagens que sejam necessárias, comuns ou usuais, e
- formas que não podem ser dissociadas de um efeito técnico.

B. Reação da academia à LPI

A recepção das alterações trazidas pela LPI no que tange ao Direito de Marcas foi tépida. Algumas evoluções há muito aguardadas finalmente vieram à tona, como o registo de sinais tridimensionais ou o alongamento do período de proteção sem a obrigação de uso da marca (para fins de caducidade). Alguns autores elogiaram, inclusive, a melhoria da formulação utilizada em algumas alterações.

A linguagem concisa do artigo 122 para determinar a registrabilidade dos sinais foi elogiada por sua técnica objetiva que evitou a necessidade de recorrer a exemplos para definir o que constitui uma marca, assim como fazia o artigo correspondente do precedente CPI. Tal definição precisa criou dois tipos diferentes de marcas sob as leis brasileiras, cada uma governada por um regime jurídico específico: enquanto as marcas visualmente perceptíveis são elegíveis para a plena proteção concedida pelo

15. Vide Instituto Dannemann Siemsen, Comentários à Lei de Propriedade Industrial 3ª ed. (Renovar, 2013): “Em lugar de, à guise de exemplificação, relacionar os sinais passíveis de registro, o legislador, de forma ampla, manda que se protejam todos aqueles que a Lei não proíba, desde que distintivos e visualmente perceptíveis, o que abre espaço, por exemplo, para as marcas tridimensionais.”

16. CPI – Artigo 64 – São registráveis como marca os nomes, palavras, denominações, monogramas, emblemas, símbolos, figuras e quaisquer outros sinais distintivos que não apresentem anterioridades ou colidências com registros já existentes e que não estejam compreendidos nas proibições legais.

17. Lélio Denícoli Schmidt, A distintividade das marcas: secondary meaning, vulgarização e teoria da distância, (Saraiva, 2013): “Entretanto, a legislação não trata igualmente todos os tipos de sinais marcários. (...) O art. 122 da Lei 9.279/96 destaca que o registro como marca é conferido aos sinais distintivos visualmente perceptíveis. Assim, diversamente do que acontece em alguns outros países, no Brasil os sinais sonoros, gustativos ou olfativos não são registráveis como marca, pois no dizer de Santo Agostinho não podem ser apontados com os dedos e não são visualmente perceptíveis.”
registo ao abrigo do Direito de Marcas, os detentores dos sinais restantes devem contar com outras ferramentas legais para prevenir o uso indevido por terceiros.\textsuperscript{18}

O uso da permissão prevista no artigo 15.1 do Acordo TRIPS foi questionado por estudiosos, tendo em conta as suas causas\textsuperscript{19} e objetivos\textsuperscript{20} injustificados. A inclusão da exigência de perceptibilidade visual na LPI também foi objeto de pontos de vista divergentes quanto ao seu alcance e as suas consequências. Vários especialistas destacaram o fato de que a opção pelo requisito perceptibilidade visual levou à exclusão automática de um grande número de sinais de proteção de marcas.\textsuperscript{21}

\textsuperscript{18} Esse assunto em particular foi analisado pelo autor na monografia inédita “Mecanismos de proteção das marcas não tradicionais no Brasil”, sob supervisão académica da Professora Elisabeth Kasznar Fekete.

\textsuperscript{19} Instituto Dannemann Siemsen, Comentários à Lei de Propriedade Industrial 3rd ed (Renovar, 2013): “A limitação prende-se, sem dúvida, às dificuldades de natureza técnico-burocrática relacionadas com o registro desses sinais, bem como à extrema complexidade da avaliação da sua registrabilidade absoluta e relativa.”

\textsuperscript{20} Denis Borges Barbosa, Marcas em Movimento, in Revista Eletrônica do IBPI 8 (2013): “Não vemos qualquer razão sistemática para tal exclusão, senão a de assegurar o devido processo legal tanto para terceiros, que se tenham de resguardar do espaço tornado exclusivo pelo registro, quanto para suscitar seus próprios interesses contrapostos. Ou seja, é preciso que o sinal não visual possa ser fixado e recuperado por todos a quem a exclusividade aproveite ou afete. Uma vez que haja os meios técnicos para tanto, a vedação poderá e deverá ser superada.” Vide ainda José Antônio B.L. Faria Correa, Sinais Não Registráveis, In Manoel Joaquim Pereira dos Santos & Wilson Pinheiro Jabur, Sinais Distintivos e Tutela Judicial e Administrativa (Saraiva, 2007): “Em síntese, não vemos obstáculo conceitual, nem procedimental, à tutela jurídica das marcas sonoras ou de outras endereçadas aos demais sentidos humanos que não a visão. Em um mundo em rápida mutação, socurado por inovações tecnológicas incessantes que redesenham nossos hábitos a todo instante, fechar as portas a marcas chamadas “não tradicionais”, incluindo aquelas consistentes em sons, seria um grave erro, suscetível de travar ou, pelo menos, dificultar a verve criativa do homem.”

\textsuperscript{21} Esse fato é sublinhado na análise feita por Denis Borges Barbosa: “Por opção do legislador, excluem-se do registro as marcas sonoras, as aromáticas e gustativas. Até agora, nunca foram admitidas à proteção no Brasil, embora sejam admitidas em outros sistemas jurídicos.” [in Proteção das Marcas: Uma Perspectiva Semiológica (Lumen Juris, 2008)]. No mesmo sentido, Lélia Denícoli Schmidt, A distintividade das marcas: secondary meaning, vulgarização e teoria da distância (Saraiva, 2013): “a impossibilidade de registro para as marcas sonoras não significa, contudo, ausência completa de proteção. (...) A percepção visual não é, portanto, um elemento essencial à definição da marca, pois se limita a uma característica exigida das marcas registradas. Mesmo as marcas não registradas continuam sendo marcas e como tal podem encontrar outras formas de tutela diversas daquela propiciada pelo registro.”; Instituto Dannemann Siemsen, Comentários à Lei de Propriedade Industrial 3rd ed (Renovar, 2013): “Com a condicionante de as marcas serem visualmente perceptíveis, a lei proíbe o registro direto de sinais acessíveis apenas a outros sentidos humanos que não a visão, não abrigando os conceitos de marcas olfativas, gustativas, sonoras e tácteis.” e, ainda, Maitê Cecília Fabbri Moro, Marcas Tridimensionais: sua proteção e os aparentes conflitos com a proteção outorgada por outros institutos da propriedade intelectual (Saraiva, 2009): “Muitas das exclusões de sinais encontram-se no art. 122 da lei brasileira, ao estabelecer que só são registráveis os sinais visualmente perceptíveis. Essa expressão já exclui da possibilidade de registro uma série de formas de apresentação de eventuais sinais distintivos, tais como os sinais sonoros, táteis, olfativos e gustativos (...).”
Há, no entanto, dois outros entendimentos. Uma leve dissonância adverte que o artigo 122 pode ser interpretado quer de forma restritiva (como a maioria reivindica), quer de forma extensiva. Sob uma interpretação extensiva, seria possível afirmar que a exigência de perceptibilidade visual se refere à representação da marca, como a notação musical que representa uma marca de som e não à própria marca. Outra opinião divergente recomenda uma interpretação moderna do artigo 122 e defende que há espaço para as marcas não tradicionais na LPI e que a exigência de perceptibilidade visual deve ser interpretada apenas como uma exigência representação gráfica.

Apesar das intenções progressistas, as opiniões divergentes têm se provado equivocadas, diante da ampla aceitação geral do entendimento literal (defendido, inclusive, pelo INPI). Tendo em conta que os conceitos de perceptibilidade visual e de representabilidade gráfica já estavam estabelecidos na época das discussões da LPI no Congresso Nacional, é seguro afirmar que o legislador queria efetivamente excluir sinais não visualmente perceptíveis da proteção conferido pelo registro e que poderia ter


23. José Antonio B.L. Faria Correa. A dimensão plurissensorial das marcas: a proteção da marca sonora na lei brasileira. In Revista da ABPI n. 69, Março/Abril 2004: "O regime de tutela às marcas, no direito brasileiro, acolhe, no artigo 122, todos os sinais 'distintivos visualmente perceptíveis não compreendidos nas proibições legais'. Ao qualificar a natureza dos sinais distintivos aptos ao registro, exigindo perceptibilidade visual, o legislador, à primeira vista, adota a postura de que somente as marcas diretamente percebidas pela visão podem ser objeto de amparo mediante título expedido pelo órgão competente. A interpretação de que o legislador optou por privilegiar apenas um dos canais sensoriais humanos, se prevalecesse, estaria longe de ser feliz, porque insensível à dinâmica do mundo das marcas, influenciada pelas constantes inovações tecnológicas que têm repercussão direta sobre o comportamento dos industriais, comerciantes e prestadores de serviços. Ao dotar o país de uma lei de inspiração moderna, como é a Lei 9.279/96, o legislador teria deixado à margem da evolução os marcas não tradicionais, captadas por outros sentidos humanos, o que causaria estranheza. Apesar da aparente opção pelos sinais destinados à vista humana, a lei, obviamente, dispõe de mecanismos que abrem uma janela para os demais sentidos do homem, como se verá no decorrer deste trabalho, e uma exegese sistemática e teleológica do diploma legal em foco mostra que, na realidade, o direito brasileiro tem amplo espaço para os sinais plurissensoriais."

usado palavras diferentes caso buscasse outro significado para a provisão.25

C. Zona Cinzenta: Sinais admitidos por lei mas não regulados pelo INPI

As seções precedentes permitem-nos avaliar o escopo de registrabilidade de marcas no Brasil a partir de uma perspectiva puramente legal e da opinião dos doutrinadores. Esta seção apresenta (e discute) a interpretação do INPI quanto ao assunto.

Tal como comumente destacado pelos doutrinadores,26 as resoluções do INPI consistentemente apontam para quatro possíveis formas de apresentação:

- marcas nominativas (incluindo palavras, combinação de letras, números, combinação de números, combinação de números e letras, sem apresentação gráfica particular);
- marcas figurativas (incluindo apenas os elementos pictóricos, sem quaisquer palavras ou números);
- marcas mistas (compreendendo elementos nominativos e figurativos); e
- marcas tridimensionais (as formas de produtos ou das respectivas embalagens).

Esta lista evidentemente não contempla todas as possíveis formas de apresentação dos "sinais visualmente perceptíveis", tal como prevê o artigo 122 da LPI. Ainda que não exista uma lista exaustiva detalhando ou classificando todos os sinais visualmente perceptíveis existentes e as correspondentes formas de apresentação, o INPI poderia ter ido além, sem ter deixado para trás itens como imagens em movimento, hologramas, elementos de trade dress, marcas de posição, combinação de cores ou marcas 25. Vide Denis Borges Barbosa, Marcas em Movimento, in Revista Eletrônica do IBPI 8 (2013). Vide também Michelle Copetti, Afinidade entre Marcas: Uma questão de Direito (Lumen Juris, 2010): "Dessa forma, no Brasil, os sinais sonoros (marcas não tradicionais – gustativas, aromáticas e táteis, por exemplo) não podem ser registrados, ainda que haja possibilidade de representação gráfica (partitura para sinais sonoros, por exemplo)."

26. Vide Maitê Cecília Fabbri Moro, Marcas Tridimensionais: sua proteção e os aparentes conflitos com a proteção outorgada por outros institutos da propriedade intelectual (Saraiva, 2009): “Não há na lei nacional um artigo específico que trate das formas de apresentação das marcas, mas o Instituto Nacional da Propriedade Industrial (INPI), com base no delimitado e não vedado em lei, aceita, atualmente, quatro formas de apresentação de sinais como registráveis. São elas: a forma nominativa, a forma figurativa, a forma mista e a forma tridimensional.” Vide também Claudio Roberto Barbosa, Propriedade Intelectual: introdução à propriedade intelectual como informação (Elsevier, 2009): “As marcas registradas podem, por sua vez, apresentar quatro formas de apresentação diferentes: a) nominativas, sendo constituídas apenas por palavras e/ou combinações de quaisquer algarismos; b) figurativas, quando constituídas apenas por elementos gráficos, por um desenho; c) mistas, quando compreendem um elemento nominativo apresentado com determinada grafia específica; e, finalmente, d) tridimensional, constituído pela representação gráfica da forma plástica, distintiva de um produto.”
gestuais. Na verdade, tudo o que o Instituto fez entre a revogação do CPI e a promulgação da LPI foi adicionar um quarto tipo de forma apresentação, no intuito de viabilizar a permissão legal de registo de marcas tridimensionais.

O problema podia ser facilmente detectado nos formulários disponibilizados pelo Instituto, onde os depositantes deveriam escolher a forma de apresentação das suas marcas por meio de uma seleção entre quatro caixas disponíveis: nominativa, figurativa, mista ou tridimensional. A introdução do sistema de depósito eletrónico não trouxe qualquer evolução para esta finalidade específica, uma vez que figuram nos formulários on-line as mesmas quatro opções.

A prática do INPI constitui, assim, uma limitação ao direito de petição dos detentores de marcas no que tange aos sinais não tradicionais visualmente perceptíveis, em desconsideração ao artigo 122. E, desta forma, o INPI cria uma categoria intermediária de marcas, incluída entre as registráveis e as irregistráveis. Esta categoria intermediária, uma "zona cinzenta de registrabilidade", é composta por sinais registráveis à luz da LPI (e particularmente nos termos do artigo 122), mas cujos pedidos de registro enfrentam obstáculos injustos e desnecessários criadas pelo INPI.

A amplitude da zona cinzenta apresenta diferentes tonalidades de cinza. Para alguns tipos de marcas (tais como imagens em movimento ou marcas gestuais), o número de obstáculos criados pela prática do INPI escurece o cinza, indicando uma maior dificuldade para o depositante. Em outros casos, as soluções criadas pelos advogados de marcas foram aceitas pelo INPI, deixando os sinais correspondentes (como a combinação de cores ou hologramas) em uma zona com o cinza mais claro, indicando menores dificuldades.

Em um esforço para mostrar que compreende as atuais necessidades dos usuários, o INPI tem afirmado que marcas não tradicionais visualmente perceptíveis são regularmente aceitas para registo no Brasil. Como exemplos, apresenta marcas figurativas registradas em preto e branco que supostamente representariam hologramas, gestos, marcas de posição, imagens em movimento e combinação de cores. No entanto, ao analisar tais exemplos, descritos na próxima seção, saltam aos olhos as


29. O autor compareceu a uma apresentação realizada em 2008 pela Sra. Larissa Clarindo, então examinadora do INPI.
limitações impostas às marcas não tradicionais e revela a distância entre a posição oficial do Instituto e a prática enfrentada pelos usuários.

Mas o que exatamente esses registros protegem? A intenção do depositante era, por exemplo, obter um registo para a sua marca holográfica. Para poder apresentar um pedido de registro, o depositante teve que simplificar seu holograma para uma imagem estática em preto e branco, vista de apenas uma perspectiva, sem indicação de movimento, tridimensionalidade ou cor. O INPI aceita esse pedido e concede o registo correspondente, emitindo um certificado de registo no qual a imagem estática em preto e branco é exibida. Caso tal holograma venha a ser de forma alguma imitado por um concorrente e um processo venha a ser proposto, a primeira questão que o juiz terá que enfrentar é determinar o escopo de proteção do registo de marca, se referente à imagem simplificada ou ao holograma que o detentor efetivamente usa. Este é apenas um dos obstáculos impostos pela ausência de regulamentação referente à apresentação, ao exame e à concessão de registos de marcas não tradicionais no Brasil. Seu impacto é ampliado pelo fato de que esta dificuldade só se verifica no momento do exercício dos direitos e não no momento em que se instaura e desenvolve o processo administrativo de sua obtenção.

Nota-se, portanto, que a zona cinzenta é uma falha importante no sistema de registo de marcas do Brasil, criando um desequilíbrio de tratamento entre os diferentes tipos de sinais e gerando um nível indesejado de insegurança jurídica em conexão com ativos corporativos. Considerando-se que o problema decorre da política interna do INPI, parece razoável esperar que uma solução surja por ato do próprio Instituto. Mas antes de abordar as possíveis soluções e as iniciativas existentes, demonstraremos a inconsistência na análise de pedidos de registro de marcas não tradicionais, apresentando e discutindo brevemente aspectos contraditórios da jurisprudência administrativa.

**D. Jurisprudência administrativa**

As decisões do INPI sobre marcas não tradicionais têm sido coerentes com a interpretação que o Instituto faz da LPI, causando o indeferimento de pedidos para: (i) sinais que não são visualmente perceptíveis; (ii) cores isoladas; (iii) algumas combinações de cores entendidas como usuais não distintivas; e (iv) slogans que não executam as funções de uma marca. Além disso, o INPI conta com uma jurisprudência considerável sobre marcas tridimensionais, com uma série de decisões polêmicas, rejeitando a proteção para formas de produtos e embalagens. Ao mesmo tempo, há uma série de registros concedidos para marcas figurativas que potencialmente representam marcas não tradicionais.
Não houve pedidos de registros no país para marcas sonoras, ou olfativas ou gustativas e, portanto, não há registro de jurisprudência com relação a estes tipos de sinais. No entanto, as declarações do INPI têm histórica e consistentemente negado qualquer possibilidade de registro para esses tipos de marcas, incluindo menções explícitas para tal proibição em diretrizes de exame revogadas. 30

Em relação as cores isoladas, o INPI tem sido rigoroso na interpretação do artigo 124, inciso VIII, rejeitando todos os pedidos depositados, como a tentativa de HRB Internacional de obter um registo para o quadrado verde que identifica os seus serviços de consultoria31 e o pedido da Localiza Rent a Car, também para a cor verde, em conexão com o aluguer de automóveis.32

A situação é menos clara para combinações de cores. Em alguns casos, INPI concede o registo sem emitir quaisquer exigências ou indeferir sumariamente o pedido, como as listras vermelho-verde-vermelho da Gucci33 e listras azul-branco-amarelo da Visa.34 Em outros casos, o INPI rejeitou pedidos sem motivo aparente, como no pedido de registro da Kawasaki Motors para uma combinação de verde e preto para distinguir motocicletas35 e na tentativa de Shell de obter a exclusividade de seu padrão de amarelo e vermelho mediante a apresentação de um pedido de

30. Diretrizes de análise de marcas do INPI (instituídas pela Resolução PR 28/2013 e revogadas pela Resolução PR 142/2014): “Embora toda expressão contida em uma marca tenha um conteúdo sonoro, não há possibilidade de se registrar marca constituída somente de som, ainda que o sinal sonoro possa ser representado graficamente. Essa representação visual não se confunde com aquela enquadrada como marca figurativa, pois esta se destina a ser exclusivamente vista e não decodificada. Igual entendimento se aplica aos sinais gustativos e olfativos. Embora já se vislumbre a possibilidade de tais sinais virem a existir como marcas distintivas de produtos e serviços, a LPI, ao exigir que o sinal reivindicado como marca seja visualmente perceptível veda o registro de sinal sonoro, gustativo ou olfativo.”

31. Pedido de registro n.903720825, para um quadrado verde, na classe 35 (serviços de aconselhamento tributário, entre outros), depositado por HRB International LLC em 07 de junho de 2011. Decisão de indeferimento em 08 de julho de 2014, com base no Artigo 124, inciso VIII, da LPI.


34. Registro n.006088244, para um retângulo em três listras azul-branco-dourado, na classe 36 (serviços financeiros), depositado por Visa International Service Association em 16 de dezembro de 1968 e concedido pelo INPI em 25 de maio de 1975.

35. Pedido de registro n.904096912, para um quadrado cuja metade superior é verde e a metade inferior é preta, na classe 12 (motocicletas, entre outros), depositado por Kawasaki Motores do Brasil Ltda. em 26 de setembro de 2011. Decisão de indeferimento em 16 de setembro de 2014, com base no Artigo 124, inciso VIII, da LPI.
registro de marca tridimensional em forma de um posto de gasolina, reivindicando tais cores. 36

A mesma inconsistência pode ser encontrada com relação às expressões de propaganda. A maioria dos pedidos são rejeitados e arquivados, como PRAMESA QUALIDADE EM BACALHAU 37, mas alguns superam a análise rigorosa do INPI e são convertidos em registo, como a marca É ÓCULOS 38.

É curioso notar que poucos depositantes têm recorrido à Justiça Federal para reverter decisões de indeferimento do INPI em pedidos de marcas não tradicionais. Por outro lado, diante da impossibilidade de contar com registros, os detentores de marcas não tradicionais têm optado por ajuizar ações inibitórias para impedir os concorrentes de usar suas marcas com base nas normas de repressão à concorrência desleal. Embora os requisitos para configuração da deslealdade concorrencial sejam bastante diferentes daqueles exigidos para configurar uma violação de marca, a estratégia tem se mostrado exitosa na cessação do uso de reproduções ou imitações de marcas não tradicionais.39

E. Como otimizar a proteção

Em meio a tantas zonas cinzentas, os detentores precisam se apoiar em estratégias jurídicas sólidas para otimizar a proteção de suas marcas não tradicionais no Brasil. Tais estratégias podem ser

36. Pedido de registro n.827816413, para a testeira de um posto de gasolina reivindicando as cores vermelha e amarela, na classe 35 (postos de gasolina, entre outros), depositada por Shell Brands International AG em 14 de outubro de 2005. Decisão de indeferimento em 02 de junho de 2009, com base na natureza genérica da forma tridimensional (Artigo 124, XXI, da LPI).


utilizadas na tentativa de obter proteção adequada por meio de um registo de marca, superando assim as limitações estabelecidas pela LPI ou pela prática do INPI. Por melhores que possam ser os resultados, essas estratégias são medidas paliativas, evidentemente, que dão acesso a um nível de proteção inferior ou substancialmente diferente daquele obtido a partir de um registo de marca no Brasil. Portanto, o uso de tais estratégias não descarta, ao contrário, evidencia, a necessidade de mudança efetiva na LPI.

Ao tentar obter registros para suas marcas não tradicionais, as empresas devem primeiro identificar a melhor maneira possível para representar graficamente a marca escolhida. Em outras palavras, o detentor deve traduzir a marca não tradicional (por exemplo, um holograma ou uma imagem em movimento) em uma imagem estática (ou um grupo de palavras). As empresas têm obtido sucesso depositando pedidos de registro para hologramas mediante a apresentação de uma versão simplificada da imagem tridimensional holográfica40 e para imagens em movimento, mediante a apresentação de uma imagem dividida em quatro quadros, cada um dos quais representando um frame do movimento.41 O depósito de marcas de posição pode ser feito por meio da apresentação da marca em linha contínua com o produto desenhado em linhas pontilhadas, como meio de indicar a posição da marca.42 Em todos esses casos, é recomendada a apresentação de uma petição de esclarecimentos junto com os formulários de depósito. Ainda que não seja publicada e não faça parte do Certificado de Registro que delimitará a extensão dos direitos outorgados, tal petição poderá indicar uma delimitação do âmbito de proteção buscado e servir como um sinal de boa-fé do depositante, podendo ser invocado como um elemento decisivo na interpretação do registro.

Estratégias semelhantes podem ser utilizadas até mesmo para outras marcas, como marcas sonoras. Enquanto a apresentação de uma partitura como marca figurativa pode ser absolutamente inútil para a proteção do som representado (tanto o INPI quanto os tribunais certamente interpretariam esse registro como um

40. Registro n.800243056, para uma marca figurativa consistindo de uma visão simplificada do holograma da ave característica da Visa, na classe 36 (serviços financeiros, incluindo cartões de crédito e cheques de viagem), depositado por Visa International Service Association em 01 de setembro de 1980 e concedido pelo INPI em 21 de dezembro de 1982.

41. Registro n.826006248, para uma marca figurativa consistindo de quatro frames da marca em movimento conhecida como “Nokia Connecting People”, na classe 09 (dispositivos de comunicação, entre outros), depositado por Nokia Corporation em 28 de outubro de 2003 e concedido pelo INPI em 24 de julho de 2007.

42. Registro n.815547480, para uma marca figurativa consistente em um tênis New Balance pontilhado, com o logo “N” em sua posição característica, na classe 25 (sapatos esportivos), depositado por New Balance Athletic Shoe, Inc. em 29 de maio de 1990 e concedido pelo INPI em 05 de outubro de 2004.
logotipo, em vez de um som), representações onomatopeicas de marcas sonoras não musicais 43 ou as letras das marcas sonoras musicais podem ser registrados como marcas nominativas e ajudar a construir reivindicações mais fortes em caso de violação.

Mesmo algumas marcas táteis poderiam ser depositadas como marcas figurativas, se o seu aspecto visual for suficiente para permitir ao INPI, aos tribunais e aos concorrentes a correta identificação da sensação de toque provocada pela marca. Conquanto tal estratégia não possa ser aplicada com sucesso a uma marca tátil constituída pela sensação de toque do veludo ou do couro, poderia, certamente, ser útil na proteção de padrões de maiores dimensões, tais como uma garrafa enrugada. 44

Em qualquer caso, o êxito de qualquer das estratégias acima dependerá da eficácia dos registros resultantes, a ser avaliada ante os tribunais competentes sempre que uma infração surgir. O detentor da marca e seu advogado devem colaborar na análise de infrações, bem como eleger uma situação que possa servir como o leading case. As chances de uma decisão positiva na primeira ocasião em que um registro é testado ante um tribunal aumentam significativamente em casos de dupla identidade (uma reprodução integral da marca registrada aplicada a um produto idêntico), em que é detectada a concorrência entre as partes. A reunião destes elementos dificulta a apresentação de argumentos transversais e, assim, ajuda o juiz a concentrar-se sobre a validade e aplicabilidade do registro.

III. PERSPECTIVAS DE MUDANÇA

Como mencionado na introdução, a última alteração importante na LPI, em 1997, decorreu de um fator externo (as obrigações previstas no Acordo TRIPS). 45

A propriedade intelectual enfrenta um período de descrédito e desconfiança por parte de alguns setores da sociedade, 46 que

43. Como no exemplo trazido na nota de rodapé 5, acima.

44. Enquanto o autor não pode localizar qualquer exemplo no Brasil, um exemplo adequado pode ser visto em país vizinho: o registro colombiano n. 1545738, para uma marca tátil denominada “Textura da garrafa de Old Parr”, para bebidas alcoólicas (exceto cerveja), depositada por Diageo Brands B.V. em 27 de fevereiro de 2015 e concedida pelo escritório colombiano de marcas em 02 de junho de 2016.


46. Críticas contemporâneas podem ser exemplificadas pelas propostas dos Partidos Piratas (atualmente presentes em mais de dez países europeus, assim como em alguns
relutam em aceitar a existência e aplicação dos direitos exclusivos. Além disso, o governo brasileiro nem sempre obteve sucesso na solução dos problemas estruturais e sistemáticos relacionados com a obtenção e a proteção dos direitos de propriedade intelectual. Um exemplo revelador de tal ordem de problemas é a infra-estrutura do INPI, que emprega aproximadamente uma centena de examinadores para analisar um fluxo anual de 150.000 pedidos de registro de marcas, resultando em um backlog que supera meio milhão de pedidos.  

Consciente de tais problemas, o governo federal passou a analisar, planejar e propor uma série de medidas de modernização dessa agência, tanto no que tange à prestação dos serviços básicos e à aceleração do exame quanto à sua reforma regimental e estrutural. Em tal contexto, poderia esperar-se que um dos projetos seja voltado ao atendimento das reivindicações dos depositantes com relação às marcas não tradicionais, o que certamente ocasionaria um aumento do número de pedidos de registros. Durante a última década, o INPI concentrou seus esforços na educação e cooperação, o que pode atualizar os conceitos e definições de suas resoluções ou alterar os procedimentos de depósito.

Diante dessas iniciativas recentes da administração pública, em cooperação com o setor privado, o cenário é de vermos os detentores de marcas e advogados de propriedade industrial explorando as melhores formas de pressionar o Congresso e a as agências federais para avançar na discussão para a completa proteção de marcas não tradicionais no Brasil.


47. Associação Brasileira da Propriedade Intelectual. Propostas para a Inovação e a Propriedade Intelectual. Vol. 1 Fatores de Crescimento Econômico, Competitividade Industrial e Atração de Investimentos. (ABPI, 2014, sob a presidência de Elisabeth Kasznan Fekete): “Segundo o INPI, o aumento do backlog nos últimos anos foi motivado pela elevação do número de depósitos. De fato, ainda de acordo com a autarquia, só em 2013, pelo menos 507,4 mil marcas e 184,2 mil patentes estavam pendentes de decisão. Entre janeiro e maio deste ano, 83,5% dos pedidos referentes a marcas deferidos no período demoraram entre três e quatro anos para serem analisados. Em relação às patentes, 63,3% demoraram mais de dez anos.”

A. Pavimentando o caminho para a representação gráfica

Na primeira vez em que o autor analisou este tema, em 2006, as marcas não tradicionais eram raramente citadas como um problema e o INPI mantinha-se silente sobre a sua registrabilidade nos termos da legislação brasileira. Naquele momento, apenas um par de artigos tinham sido escritos e publicados sobre o assunto, que passava despercebido até mesmo por renomados autores em importantes obras sobre Direito de Marcas.

Quase uma década depois, muito mudou. A globalização da economia e os portfólios de marcas construídos por empresas multinacionais foram gradualmente introduzindo a questão das marcas não tradicionais aos interessados. Os diferentes problemas criados pela existência de uma zona cinzenta de registrabilidade provavelmente contribuíram para uma conscientização, abrindo a discussão para mais e mais fóruns e revelando a urgência de encontrar soluções.

Em 2006, INPI não se envolvia nas discussões externas sobre marcas não tradicionais e não seria surpresa se viesse a se pronunciar oficialmente contra a sua proteção. Mas ao longo dos anos, em reuniões, apresentações e conversas informais, o INPI foi construindo e revelando uma posição mais conciliatória: marcas não tradicionais são registráveis se, de alguma forma, cumprirem a exigência de perceptibilidade visual. Assim, o problema hoje não é entender o que é ou não é registrável, mas sim encontrar formas mais eficientes de reconhecer, conceder e aplicar os direitos dos detentores de marcas não tradicionais, sobretudo aquelas que carecem de uma forma simples de representação visual ou gráfica.

Como visto na Parte II.C, acima, o INPI ainda não tem regras precisas sobre a representação de marcas em pedidos de registro. A ausência de regulamentação é a fonte da maioria dos problemas atualmente enfrentados por empresas que decidem investir na criação de uma marca não tradicional. Neste sentido, estabelecer um conjunto de regras relativas à representação gráfica das marcas para fins de registro pode ser um passo crucial para abraçar práticas mais atuais e políticas que, em última instância, poderiam preparar o país para o registo de marcas não tradicionais.

As funções da representação gráfica são (i) identificar o material protegido; (ii) informar terceiros; e (iii) permitir a administração do sistema. E, nessa medida, melhorar mecanismos de representação gráfica é importante não só para marcas não tradicionais, mas para a funcionalidade do núcleo de qualquer
sistema de registo como um todo. A representação gráfica do sinal registado como marca é o que vai determinar a extensão da sua proteção e, assim, é uma ferramenta essencial para garantir a segurança jurídica no mercado.

Portanto, independentemente da necessidade de proteção das marcas não tradicionais, o Brasil poderia se beneficiar muito caso melhorasse os padrões de representação gráfica, incluindo a determinação das formas mais precisas de representação, como uma descrição por palavras e pela indicação de um código de cores.

**B. Iniciativas do Comitê de Marcas Não Tradicionais da INTA**

A crescente presença da INTA na América Latina se reflete no aumento quantitativo e qualitativo de suas atividades no Brasil. As atividades do Comitê de Marcas Não Tradicionais têm sido facilitadas pelas boas relações que se estabeleceram entre representantes do Comitê da INTA de Educação e Treinamento de Funcionários de Governos e os examinadores e autoridades do INPI.

As tratativas entre estes Comitês da INTA e o INPI começaram em 2008 e têm se revelado úteis na viabilização do reconhecimento de marcas não tradicionais pelo Instituto. Desde então, ocorreram duas reuniões entre membros do Comitê de Marcas Não Tradicionais e autoridades do INPI. Em ambas as ocasiões, o Comitê sublinhou a necessidade de proteger adequadamente marcas não tradicionais, apresentando as práticas de escritórios homólogos com exemplos que poderiam ser identificados no Brasil. Essas reuniões também levaram a uma colaboração mais proativa entre a INTA e o INPI, não só em relação a marcas não tradicionais, mas também em outros tópicos. Nos últimos anos, pelo menos seis palestras de representantes da INTA ocorreram na sede do INPI, para examinadores de marcas. Cada uma das apresentações teve foco em um aspecto de marcas não tradicionais: a justificativa econômica permitindo a sua proteção, os critérios utilizados para a sua classificação, os desafios relacionados à aferição da distintividade de tais sinais e às formas de representá-los gráficamente. O autor apresentou duas dessas palestras e pode constatar o entendimento dos examinadores sobre o tema, variando entre o previsível ceticismo inicial até uma surpreendente abertura de espírito.

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51. Neste sentido, a recente notícia da aprovação, pelo Conselho Diretor da INTA, de um escritório regional da entidade voltado para a América Latina, com sede na cidade de Santiago, Chile.
As consequências positivas de tais iniciativas são experimentadas no curto e no longo prazo. As reuniões ajudam os funcionários a perceber a importância do problema e os preparam para uma possível alteração futura.

O papel da INTA na América do Sul vem aumentando, na medida em que a região se tornou uma das prioridades da associação. A INTA assinou um memorando de entendimentos com o Escritório de Marcas colombiano52 e tem mantido negociações com o INPI. Embora seja muito cedo para avaliar os resultados desta aproximação, é provável que o INPI se revele mais disposto a manter conversas mais aberta com os representantes do INTA, gerando eventualmente um novo conjunto de oportunidades para trazer as marcas não tradicionais de volta à atenção do Instituto.

Também é importante observar que os Comitês da INTA podem agora iniciar e manter tratativas com diferentes áreas do INPI, como, por exemplo, a Academia de Propriedade Intelectual mantida pelo Instituto, que oferece programas de Mestrado e Doutorado em Propriedade Intelectual. Ao manter contato com o braço acadêmico do INPI, a INTA pode contribuir para os debates internos e possivelmente influenciar na seleção de temas de interesse, inclusive incentivando o estudo de marcas não tradicionais.

C. Iniciativas da ABPI
(Associação Brasileira da Propriedade Intelectual)

A ABPI é uma associação nacional com intensa atividade cuja principal força é a união de quase todos os escritórios de advocacia e das agências de propriedade industrial, ao lado de algumas das mais importantes empresas, especialmente aquelas dedicadas à inovação. Durante anos, a ABPI manteve uma conexão não-linear com marcas não tradicionais e o assunto foi ocasionalmente levado a muitos canais de comunicação da associação, como seu boletim, sua publicação acadêmica, a sua Comissão de Estudos de Marcas, suas mesas redondas ou mesmo os seminários de seus encontros anuais. Em virtude da própria natureza dos canais, a análise tendia a ser superficial ou pouco abrangente. Não havia, enfim, uma concentração de esforços na direção do enfrentamento dos desafios que separam o Brasil da uma efetiva proteção às marcas não tradicionais.

A criação, em 2011, de um Comitê Empresarial foi um passo importante para a mudança. O Comitê é composto exclusivamente por advogados internos de maiores empresas do país (mais de 70) em diferentes campos de atividades. Deliberando sobre a situação da proteção de marcas no Brasil em 2012, a Comitê decidiu

52. Cujo nome oficial, em espanhol, é “Superintendencia de Industria y Comercio”.
abordar a questão das marcas não tradicionais de forma institucional, requerendo ação da Comissão de Estudos de Marcas e solicitando um estudo sobre a situação das marcas não tradicionais no Brasil e sobre as medidas necessárias para obter completa proteção legal. A Comissão de Estudos de Marcas realizou uma análise da situação e decidiu criar dois grupos de trabalho: um dedicado a sinais visualmente perceptíveis e outro dedicado aos sinais não visualmente perceptíveis.

A tarefa do primeiro grupo era avaliar as maneiras de mudar regulamentos e procedimentos do INPI, a fim de permitir um processo de registo menos acidentado de marcas não tradicionais visualmente perceptíveis (as mencionadas acima como pertencendo a uma zona cinzenta) resultando em registos com escopo de exclusividade mais claro. A empreitada era estudar e revelar as principais falhas da regulamentação em vigor, bem como oferecer uma minuta de regulamentação preenchida com ideias mais atuais, já experimentadas por outros organismos nacionais. O objetivo do grupo era entregar uma obra que poderia efetivamente ser utilizada como uma ferramenta por funcionários do INPI para melhorar suas práticas, em vez de um longo artigo criticando as posições do Instituto.

Quanto ao segundo grupo, a tarefa era a elaboração de um projeto de lei que retirasse a exigência de perceptibilidade visual e estabelecesse regras para o registo de marcas não visualmente perceptíveis.

Os trabalhos de ambos os grupos foram realizados ao longo de 2013, tanto no Rio de Janeiro como em São Paulo, com a ajuda voluntária de vários renomados advogados da área. Como normalmente acontece em atividades associativas, os estudos foram pausados em dezembro de 2013, tendo em vista a posse do novo conselho diretor e dos novos coordenadores de Comissões de Estudos, com perspectiva de retomada dos trabalhos no primeiro trimestre de 2014.

Quando a Comissão de Estudo de Marcas estava pronta para retomar e concluir os trabalhos, a Direção de Marcas do INPI emitiu novas diretrizes para o exame de marcas, formalizando algumas das interpretações do INPI com relação a artigos da LPI e introduzindo algumas novas regras. No entanto, é importante salientar que nenhuma menção a marcas não tradicionais é feita nas diretrizes.

A urgência da análise dessas novas diretrizes adiou indefinidamente as atividades dos grupos de trabalho. Após este intervalo de dois anos, tanto o Comitê Empresarial quanto a Comissão de Estudos de Marcas devem reavaliar a necessidade e/ou interesse de retomar o projeto. Havendo retomada, os grupos deverão finalizar seus relatórios e submetê-los à aprovação da Comissão de Estudos de Marcas. Em seguida, a Comissão enviará
o relatório ao Comitê Empresarial, para análise. Finalmente, Comitê e Comissão enviarão o relatório ao Conselho Diretor da ABPI, para publicação como Resolução. Neste momento, os membros da Associação poderiam usar a Resolução como forma de discussão da questão e de apresentação para os membros do Congresso Nacional.

D. Obstáculos a tais iniciativas

Tanto a INTA quanto a ABPI buscam auxiliar o INPI a se preparar para a mudança, mais do que simplesmente exigir uma mudança imediata. A abordagem, nos dois casos, é colaborativa, e não contenciosa. Ambas associações conseguiram igualmente institucionalizar o tema, transformando-o em ponto permanente de suas agendas e atraindo a participação de mais e mais pessoas nas discussões. Por outro lado, nenhuma das associações conseguiu criar uma ligação permanente com o INPI, o que pode gerar dúvidas quanto à solidez da atuação. Em outras palavras, será necessário mais do que organizar reuniões e palestras para provocar uma mudança. E isto é particularmente importante, tendo em conta a força das barreiras com que se deparam as iniciativas.

Os principais obstáculos são: (i) a atual situação do INPI e as dificuldades enfrentadas pelo setor público no Brasil; (ii) as particularidades do processo legislativo no Brasil; e (iii) a ausência de eco da necessidade de tais iniciativas na maior parte dos fóruns.

Estes obstáculos operam de duas formas diferentes: seja bloqueando ativamente os efeitos positivos das iniciativas, seja contribuindo passivamente à manutenção da situação atual. O tempo médio que o INPI leva para analisar um pedido de registro de marca (de três a seis anos) produz impactos que dificultam o combate à falsificação. 53 Ele também se presta a alimentar o pensamento simplista e equivocado de que depositar pedidos não é importante, o que ajuda a explicar o baixo número de pedidos de marcas depositados no Brasil nos últimos anos (cerca de 150.000 por ano, contra 1,6 milhões na China). 54 Em meio a essa realidade, tanto o INPI quanto o governo federal passaram a agir de forma proativa para garantir a aplicação das regras existentes e para, oportunamente, criar novas regras.

As razões restantes poderiam ser resumidas na expressão "dificuldades financeiras". A mudança é sempre difícil e é preciso muita energia e muito investimento para se obter resultados.


Diversos setores do serviço público no Brasil resistem a mudanças e o interesse dos legisladores pela propriedade intelectual não tem se convertido em leis (quase nenhuma mudança foi introduzida na LPI desde sua promulgação em 1996). Então, é compreensível que os examinadores e os funcionários do INPI, os administradores públicos e os políticos encontrem dificuldades nas tentativas de mudança da abordagem jurídica e administrativa do país com relação à Propriedade Intelectual.

O obstáculo final é provavelmente o mais fácil de superar. Mesmo que haja um sentimento de apatia em alguns fóruns, o entusiasmo pode ser encontrado em associações, em algumas faculdades, e na ativa cooperação do setor privado. Em alguns casos, o silêncio pode ser simplesmente uma questão de falta de abertura de canais para o diálogo. Neste sentido, é importante para as empresas e associações do setor privado buscar novos parceiros e para tentar estabelecer uma discussão abrangente e coerente da questão, por meio de seminários, debates, grupos de trabalho conjuntos, mesas redondas, etc. Seria também benéfico aumentar o intercâmbio com advogados internos e externos lidando com marcas, o que poderia abrir terreno para novas ações, submetendo-se aos tribunais do país a decisão sobre a registrabilidade de alguns tipos de sinais. Superar esse obstáculo final poderia ser um passo importante no uso do poder dos tribunais para legislar, criando precedentes paradigmáticos consistentes cuja reprodução contínua em casos semelhantes, finalmente, exigiria alguma forma de consolidação.

IV. CONCLUSÃO

Promover mudanças no Brasil não é tarefa fácil. Obstáculos burocráticos, quando não tratados, podem atravancar novas ideias, ao invés de promove-las, e comprimir a economia dinâmica do país, bloqueando o que poderia ser seu crescimento natural e orgânico. E isso se aplica a marcas não tradicionais.

Os principais concorrentes locais e globais do Brasil reconheceram a importância destes sinais para a economia deste século. Cabe agora ao Brasil discutir a questão abertamente, diante dos problemas que ainda afetam a estrutura do INPI. Vencer esses obstáculos ocasionará pelo menos duas vitórias: mitigar a impressão de alguns investidores de que o país carece de regulamentação e retirar uma inexplicável limitação à operação das empresas.

Essa evolução servirá, ainda, de incentivo para que empresas nacionais e estrangeiras explorem novas tecnologias na identificação e divulgação de seus produtos e serviços. Aquelas que

55. Todas as modificações foram introduzidas pela Lei n. 10.196/2001 e se referem exclusivamente à seção de patentes. A seção de marcas da LPI permanece inalterada.
correm esses riscos e conseguem criar novos sinais deixarão de contar com proteções legais reflexas (como as normas de repressão à concorrência desleal) e passarão a ter garantido um nível mínimo de proteção para seus esforços. É necessário, assim, corrigir a situação atual, de proteção insuficiente, que expõe empresas ao risco injusto de serem rivalizadas por terceiros usando marcas semelhantes, sem a possibilidade de recorrer à proteção conferida por um registro. Em alguns casos, o infrator pode mesmo ficar imune, uma vez que as normas de repressão aos atos de deslealdade concorrencial se aplicam apenas quando comprovada uma relação efetiva de concorrência. Os prejuízos causados aos detentores das marcas por tal situação podem ser ainda maiores: os danos calculados em ações por concorrência desleal podem ser significativamente menores do que aqueles arbitrados em ações de infração de marca. Enquanto a maior parte dos tribunais nacionais entende que os danos em casos de infração de marca podem ser presumidos (o uso de uma marca registrada por um terceiro é considerado como gerador de um dano in re ipsa\textsuperscript{56}), há o entendimento que os danos devem ser provados em casos de concorrência desleal\textsuperscript{57}.

É fundamental reconhecer que a criação, promoção e exploração de uma marca não tradicional requer investimentos superiores àqueles envolvidos na introdução mercadológica de uma marca tradicional. Então, o uso de tal sinal por qualquer terceiro é capaz de atingir negativamente e agudamente os investimentos do detentor.

A mudança é necessária não só em vista dos riscos gerados pela situação atual, mas também em vista dos benefícios que podem surgir de uma regulação moderna das marcas não tradicionais. Em um mercado regulado, empresas brasileiras e estrangeiras poderiam começar a investir deliberadamente em novos tipos de sinais, usando como ferramentas de tal estratégia a criatividade da tradição publicitária do país e o mercado interno de proporções continentais, que poderia servir como testes de large escala para mercados como a União Europeia e os Estados Unidos. Além da economia propriamente dita, estes investimentos poderiam representar benefícios em outras áreas, como a criação

\textsuperscript{56} Neste sentido, decisão do Superior Tribunal de Justiça datada de 04 de Agosto de 2011 [Recurso Especial 1174098]: “Na hipótese de uso indevido de marca, capaz de provocar confusão entre os estabelecimentos e consequente desvio de clientela, desnecessária a prova concreta do prejuízo, que se presume.”

\textsuperscript{57} Neste sentido, decisão do Tribunal de Justiça do Rio Grande do Sul datada de 04 de fevereiro de 1999 [re Apelação 598070324]: “A concorrência desleal é prática somente possível a ser perpetrada com o emprego do dolo. Para que reste configurada, é necessário, ainda, a existência de prova concreta de dano ou perigo de dano, não sendo suficiente mera possibilidade de dano, porque a concorrência comercial é própria do regime de economia de mercado, onde a disputa entre empresas é consequência natural. Incomprovado o dolo, o dano ou perigo de dano, improcede a ação cominatória proposta.”
de novos empregos, o desenvolvimento do mercado interno e o reconhecimento de investimentos anteriores em algumas das marcas mais importantes do país.

A questão final é como provocar mudança em um ambiente pouco convidativo. É essa é uma questão difícil porque ela implica que existe uma maneira de fazer algo que ainda não foi feito. E que essa maneira deve ser operacionalizada por alguém, de alguma forma, em algum momento, no fórum adequado e sob determinadas condições. Então, a questão final esconde uma série de outras questões igualmente essenciais.

Medidas isoladas tendem a ter impacto reduzido. Assim, espera-se que as partes envolvidas, como o INPI, a administração pública, as associações, os detentores de marcas, os advogados e os tribunais concentrem e conectem seus trabalhos para evitar desperdício visando a melhores resultados.

Como debatido, a INTA e a ABPI fizeram movimentos importantes na direção do reconhecimento das marcas não tradicionais no ordenamento jurídico brasileiro, em trabalhos constantes e persistentes. Ademais, as partes interessadas devem direcionar tais esforços na alteração da LPI pelo Congresso Nacional e no auxílio para que o INPI proceda com alterações regulatórias.

Dada a urgência do tema, entende-se que chegou a hora de levar tais esforços à prática. Mudanças deste porte levam tempo e é necessário preparar-se. Então, quanto antes as engrenagens começarem a rodar, melhor para as parcelas do mercado brasileiro que se veem atualmente expostas a riscos desnecessários.

Finalmente, importa mencionar a contribuição que vem sendo dada por parte de detentores de marcas. Na defesa dos melhores interesses daqueles que detêm marcas não tradicionais, a busca por formas de proteção eficientes para estes bens intangíveis tem sido se provado um importante esforço pela mudança, mais do que o mero cumprimento de uma obrigação profissional. Neste sentido, espera-se que continuem extremamente vigilantes na detecção das marcas não tradicionais e meticulosos na elaboração de estratégias para a obtenção de proteção legal adequada. Como mencionado acima, alguns sinais visualmente perceptíveis são protegidos de forma insuficiente no Brasil, posto que seu registro só é permitido por meio de uma representação figurativa de sinais complexos, o que aumenta o nível de insegurança jurídica. Nestes casos, é importante oferecer aconselhamento jurídico proativo no sentido de detalhar os possíveis caminhos judiciais para ver declarados e sanados os procedimentos inadequados do INPI, levando a mudanças nas práticas do Instituto.

Tais medidas certamente levarão o Brasil a deixar para trás as incertezas da zona cinzenta, solidificando a proteção de marcas não-tradicionais no seu criativo mercado interno.
COMMENTARY

USPTO SNUFFS OUT MARIJUANA DISPENSARY SERVICE MARK APPLICATION:
WILL ALL OTHERS GO UP IN SMOKE, TOO?

By J. Michael Keyes∗

In an attempt to fill the empty pots of state budgets, several legislatures have legalized “recreational use” of various marijuana products. Washington, Colorado, Alaska, and Oregon have all jumped into the field. The issue is smoldering in California, too, where voters will have a chance to legalize weed on the same day they cast their ballots for the next president of the United States. If the world’s eighth largest economy votes in favor of “making ganja great again,” that will lead to an exponential explosion of new businesses trying to compete for cannabis customers.

Although marijuana is illegal under the federal Controlled Substances Act, the U.S. Department of Justice (the “DOJ”) (in the so-called “Cole Memorandum”) has settled on a “wait and see” approach as to whether the various state legalization regimes are sufficiently robust such that federal law enforcement priorities will not be compromised. While the DOJ’s position may seem a bit hazy to some, other federal agencies do not appear as dazed and confused on the issue.

One such agency is the United States Patent and Trademark Office (the “USPTO”), which in In re Brown recently had the opportunity to consider whether a service mark could issue when the services in question include the dispensing of cannabis in

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2. In a memorandum of August 29, 2013, to all U.S. Attorneys, Deputy Attorney General James Cole notes that the federal government has not historically devoted resources to prosecuting individuals whose conduct is limited to possession of small amounts of marijuana for personal use on private property.” The Cole Memo further states that “[i]n jurisdictions that have enacted laws legalizing marijuana in some form and that have also implemented strong and effective regulatory and enforcement systems to control the cultivation, distribution, sale, and possession of marijuana, conduct in compliance with those laws and regulations is less likely to threaten the federal priorities set forth above.


commerce. Not surprisingly, the application went up in smoke. In at least one sense, the USPTO’s precedential decision is of no moment. The USPTO has previously rejected other marijuana-laced applications, so In re Brown is not a shocker. On the other hand, though, the USPTO may be signaling a willingness to entertain similar applications in the future under the right circumstances. Here’s the straight dope on what happened as well as a couple of takeaways to ponder.

Applicant Morgan Brown operates a licensed marijuana dispensary in the state of Washington. In order to protect this budding business, Brown filed a federal service mark application for HERBAL ACCESS for “retail store services featuring herbs,” in International Class 35. The Examiner rejected the application, finding that the “herbs” offered by the applicant included marijuana. In reviewing the Examiner’s decision, the Trademark Trial and Appeal Board (the “TTAB”) first noted that it presumes that an applicant’s use of a mark in commerce is lawful under federal law and, thus, registration generally will not be refused unless either: (1) a violation of federal law is indicated by the application record; or (2) the applicant’s “application-relevant activities” involve a per se violation of federal law. Given that the application on its face did not reveal any federal law transgressions, the relevant inquiry was whether the applicant’s “activities” involve a per se violation of federal law.

Both the Examiner and the TTAB found a per se violation based on two pieces of evidence. First, the applicant’s specimen of use included photographs of the applicant’s “herbal” business. Both photographs contained depictions of a “green cross” seen in close proximity to the “Herbal Access” mark. The TTAB cited several sources that indicated that a green cross “clearly indicates” what has become “the symbol of the organized medical marijuana industry.” The TTAB may have refused to bless the application for this reason alone, but the real smoking gun was the second piece of evidence considered: the applicant’s website. Among other things, the site enticed potential cannabis customers to “[c]all or stop by today and find out why people consider our marijuana to be the best of the best!” The site also invited visitors to come to the store

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6. Id. at *3-4.

7. Id. at *4.

8. Id. at *6.
for some “sweet tasting ganja.” And, finally, the site’s tagline was “Marijuana For the Masses.”

Based on this evidence, the Examiner and the TTAB had no problem finding that the application was prohibited given that the Controlled Substance Act prohibits the “manufacturing, distributing, dispensing or possessing” of such things as “marijuana and marijuana-based preparations.”

The applicant made one last gasp to try and save the application. The applicant argued that the evidence considered did not show the use of the mark specifically in connection with one particular herb: marijuana. The TTAB rejected this claim because it “did not directly address or rebut the evidence that marijuana is an herb and Applicant sells marijuana.” Instead, as the TTAB noted, the United States Court for the Federal Circuit (the “Federal Circuit”) has previously rejected attempts to use “generalized language” in services identifications (i.e., “retail store services featuring herbs”) in order to sidestep refusals where the particular services fall within the generalized identification and the evidence shows that the applicant’s actual usage involves the specific service that is the subject of the refusal.

So, what are the key takeaways from this precedential decision of the TTAB? There are at least a couple of noteworthy kernels for future applicants who may not be flying so high after digesting In re Brown:

1. **Cleverly Concealing Cannabis Won’t Cut It.** The applicant engaged in a bit of smoke and mirrors in concealing the true nature of what was really being dispensed within its herbal joint. While the description of services may have seemed legally defensible, the Examiner was able to smoke things out with minimal effort. Even if the applicant had been able to obtain a registration based on the description, the registration would have remained vulnerable to future attack.

2. **Consider Challenging the Controlled Substances Act Conclusion.** It is important to note that the TTAB did not address the issue of “whether use not lawful under federal law, but not prosecuted by federal authorities, is thereby rendered sufficiently lawful to avoid the unlawful use refusal.” In other words, the TTAB did not consider the effect of the Cole Memorandum and whether a state-licensed marijuana operation is eligible to obtain a federal registration. Thus, it is still an open question as to how the

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9. *Id.*
10. *Id.* at *12.*
11. *Id.*
12. *Id.* at *3, n.3.*
TTAB would rule when faced with the question of whether the DOJ’s tacit approval of state marijuana laws should allow cannabis-based applications to move forward.

As *In re Brown* tells us, federal trademark protection is currently unavailable for those businesses seeking to protect trademarks and service marks that involve the sale of marijuana. Not all arguments in favor of registration are forever snuffed out, though. There may still be some daylight to challenge the underlying basis of the TTAB’s decision regarding the application of the Controlled Substance Act to applicants who are legally exercising their right to sell marijuana under state law. Presumably an applicant would need to present evidence and argument that the state regulatory and enforcement regime satisfies the criteria set forth in the Cole Memorandum. Then, be ready for a trip to the Federal Circuit if the application is denied. All of this will take a fair amount of time to accomplish, not to mention a lot of green.
COMMENTARY

CANADA’S OFFICIAL MARKS REGIME: OFFICIALLY TIME FOR A CHANGE!

By Janice M. Bereskin* and Christina Capone Settimi**

What do SEASON'S GREETINGS, HAPPY HOLIDAYS, HOLIDAY CHEER, WINTER WISHES, JACKPOT, BINGO, POSTAL CODE, PERSONALIZED MAIL, YEAR 2000, and SCRATCH 'N WIN have in common?

These are all so-called “official marks,” a uniquely Canadian construct afforded a broad and unusual scope of protection in Canada under Section 9 of the Canadian Trade-marks Act (the “Act”).

Canada’s trademark law and practice with respect to official marks is widely regarded as one of the most arcane and curious features of Canadian trademark law. Although traditionally more a source of annoyance than a significant legal impediment, official marks are increasingly becoming an albatross, and there seems to be no relief in sight for the legitimate trademark owner.

Section 9(1)(n)(iii) of the Act prohibits any person from adopting in connection with a business, as a trademark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for, any badge, crest, emblem or mark adopted and used by any public authority, in Canada as an official mark for wares or services, in respect of which the Registrar of Trademarks has given public notice of its adoption and use.

The provision, which, on its face, prohibits use “as a trademark or otherwise,” would seem to encompass non-trademark uses, perhaps even generic uses. While it seems unlikely that the statute would be so broadly construed, official marks are afforded a significantly broader scope of protection and procedural advantages than traditional registered trademarks. For example, Section 9(1)(n)(iii) does not:

• provide for any examination of official marks: the public authority need not identify any goods and services, nor is

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the mark subject to any examination on grounds of inherent registrability or confusion;

- provide for any renewal of, or payment of any maintenance fees for, an official mark; or

- prescribe any opposition procedure for challenging an official mark.

As a consequence, any entity qualifying as a public authority can protect virtually any mark—including those that are generic or descriptive, or even those that are the subject of a prior registration—for an indefinite period of time for any and all goods and services. Moreover, official marks cannot be expunged in the normal course; a published official mark can only be challenged through a proceeding in the Federal Court of Canada (i.e., by judicial review, or by counterclaim).

Also, unlike traditional trademarks, where a finding of a likelihood of confusion is required to establish infringement, the test to be applied in determining whether a mark has been adopted contrary to Section 9 is one of resemblance: whether a person, as a matter of first impression, with knowledge only of the official mark and having an imperfect recollection of it, would be likely to be deceived or confused. The fact that the marks may be used with completely unrelated goods is irrelevant. The question is whether consumers are likely to be mistake one product for another; thus, the issue is between the marks themselves, and not with respect to the source of the goods/services with which the marks are used.

While a legitimate rationale for the official mark regime may be to save governments and other nonprofit public authorities from the costs of registering and maintaining trademarks used in relation to their programs and services, in practice, public authorities of all types have capitalized on their ability to bypass regular trademark examination and registration requirements and have utilized official marks to protect their brands (despite the fact that the official marks regime has been described as a mechanism to remove marks from the field of trade or business). For example, Canada Post, the Canadian Olympic Association, and Western Canada Lottery Corporation are among the most prolific owners of official marks in Canada. Perhaps not surprisingly given the lack of legislative standards, official marks have a long-standing history of abuse in Canada, with many public authorities claiming official mark status for generic and clearly descriptive words and


phrases, which would otherwise not satisfy regular registration requirements.

In the absence of any statutory limitations, Canadian courts have attempted to establish some standards for official marks, in part by narrowing the scope of what qualifies as a “public authority.” Under current case law, a public authority must be an entity that: (i) is subject to a significant degree of Canadian government control; and (ii) is performing some activity that benefits the public. The test of governmental control requires that the Canadian government be enabled, directly or through its nominees, to exercise a degree of ongoing influence in the body's governance and decision-making, and calls for ongoing government supervision of the activities of the body claiming to be a public authority. Canadian courts have been clear that there is no official mark privilege available to public authorities that are controlled by foreign governments. Moreover, an entity seeking publication of an official mark must establish, by way of evidence, both its status as a public authority as well as its adoption and use of the official mark. Finally, the courts and the Registrar have typically required a very high degree of visual similarity, as well as a high degree of similarity in sound and in the ideas suggested by the marks, for a proceeding based on a prior official mark to succeed.

Notwithstanding judicial attempts to place some limitations on the broad scope of protection afforded by Section 9(1)(n)(iii), official marks continue to be a thorn in the side of applicants of traditional trademark applications in Canada. While the publication of an official mark does not impact the prior use or registration of the same or similar mark, once published, the official mark prohibits the subsequent adoption, including the use or filing, of a trademark that is the same as or similar to the official mark, regardless of apparent goods, services, or channels of trade, without consent of the official mark owner. This impacts not only new marks, but also the ability of a prior registered owner to later register the same mark for an expanded list of goods and/or services.

In the past, official marks have been more nuisance than impediment. Traditionally, few public authorities have relied on their official marks to challenge use of the same or similar marks

by others, particularly in a situation where the mark is used or intended to be used with unrelated goods and services. In addition, obtaining a simple consent from the official mark owner is generally a straightforward and affordable solution to overcoming an objection based on an official mark. Public authorities have typically responded favorably to requests for consent. In most cases, consent has been granted readily, often for no consideration or, sometimes, in exchange for a modest payment or donation to cover incidental legal fees.

However, recent concerning trends suggest that official marks are becoming increasingly problematic for trademark owners. What was once an inconvenience is steadily becoming a costly and difficult obstacle.

Specifically, an increasing number of official marks are being filed that create, often unnecessarily, monopolies and obstacles to legitimate trademark use and registration in Canada. By way of example, Western Canada Lottery Corporation alone has requested the publication of over six hundred official marks. It is inconceivable that all but a few of these are now in actual use, but once recorded as an official mark, the Act contains no provision under which they can be challenged for non-use.

Official mark owners are also becoming less acquiescent to requests for consent. In our recent experience, requests for consent are more frequently being responded to with demands for unreasonably high monetary payments (on occasion, several million dollars) or with the imposition of onerous and overreaching license agreements and undertakings, or both. Moreover, while some official mark owners appear to be attempting to “cash in” on their official marks, still others simply refuse to grant consent at all, thereby obtaining a monopoly over their marks for all goods and services, regardless of any risk (or lack thereof) of harm to the official mark.

Faced with the choice of agreeing to disproportionate and unreasonable demands for payment, or incurring significant costs to seek relief from the Federal Court, many applicants opt to abandon their applications altogether, leaving the owners of official marks to enjoy an inappropriate monopoly for their marks.

For these reasons, official marks have been the source of a considerable amount of criticism and debate, with trademark professionals, commentators, and traders alike calling for reform and even the abolition of the official mark regime in Canada. Two years ago, the Canadian government tabled a much anticipated omnibus bill that introduced sweeping changes to Canadian trademark law and, although it was hoped that a reform to the official mark regime would be among them, Section 9(1)(n)(iii) remained untouched. A Private Members Bill, Bill C-611, entitled “An act to amend the Trade-marks Act (public authority),” which
was tabled in June, 2014, sought to amend Section 9 to, among other things, include a definition of “public authority,” and establish a ten-year renewal period for official marks as well as an opposition proceeding. While these would have been welcome changes, Bill C-611 failed to survive its first reading in the House of Commons and has not as yet been reintroduced into Parliament. Perhaps more disappointingly, the current Canadian government has intimated that it has no plans at present to introduce further amendments to the Act to address Section 9. Consequently, Canada’s official mark regime will, at least for the foreseeable future, remain, and, based on current trends, official mark abuse is not only likely to continue, but to escalate. The 2014 reform to the Trade-marks Act was a missed opportunity by the Canadian government to address the significant deficiencies in the official mark regime. It is hoped that it will not be another 100-plus years before this area of trademark law and practice sees much-needed change.
COMMENTARY
UNITED IN DISCORD:
DISREGARDING NATIONAL DECISIONS IN THE EU

By Martin Viefhues*

I. INTRODUCTION

No, this is not about the “Brexit.”

Rather, it is about an aversion to accepting what another level of the European Union system thinks is right. But this time it is not about accepting determinations from above, but from below. It is about disregarding national decisions in the European Intellectual Property Office (the “EUIPO”).

The structure of EU trademark law is that it consists of two legislative systems that live side by side in harmony: the EU trademark law, with its EU trademarks (“EUTMs”) established by the EU Trademark Regulation, and the national trademark laws with their national trademarks established by national Trademark Acts. To ensure harmony in every direction, the EU Trademark Directive has obliged the EU member states to harmonize their national laws, vertically with the EU trademark system and horizontally among each other.

The ideal of EU trademark practice therefore suggests that the EU and national trademark authorities should consider each other’s decisions. The reality of EU trademark practice is, however, that the EU and national trademark authorities do not care for each other’s decisions at all.

Disregarding each other’s decisions is a practice that seems to be logical: each system is independent (even though all should be harmonized), each national market has its own particularities, each EU member state has its own language, and each case has its own peculiarities (even if the trademarks concerned are identical). And, most importantly, it is always the others who are wrong, and the principle of legality does not permit the repetition of mistakes to ensure equal treatment: “There is no equality in illegality.”1 In

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EU parlance, the label for this kind of situation is: “United in diversity.”

Of course, the national trademark authorities cannot be expected to consider each other’s decisions; a lack of availability of translations of decisions and a lack of time to prepare decisions may prevent or impede the authorities’ full consideration of these decisions. Instead, the responsibility lies only with each member state’s ultimate authority in trademark matters—whether a Supreme Court or an IP Court—to try to harmonize the national practice with the decisions of the Court of Justice of the EU (“CJEU”) as the ultimate authority on the interpretation of the EU trademark law and with the decisions of the CJEU’s General Court (“GC”) as the “entry” court in proceedings on EUTMs.

But even when decisions of other member states are available and submitted in proceedings, disregarding each other’s decisions can, at least to a certain extent, be justified by differing aspects of market conditions. However, this rationale does not apply where the market is overlapping—that is, in the relationship between decisions of the EUIPO and the national trademark authorities, as the EUTM always covers that national market as well. This raises the question whether a national decision can be a benchmark for a decision of the EUIPO: what if there is a national Supreme Court decision on a trademark identical to an EUTM? Should (or must) the EUIPO (and the GC/CJEU in the end) accept the decision as a benchmark? The GC has a clear opinion regarding this question, as two recent decisions show.

II. THE WINNETOU CASE

One of the most famous German literary characters is the fictional Native American “Winnetou,” chief of the tribe of the Mescalero Apaches, and hero of the *Winnetou* trilogy, written by German author Karl May (1842–1912), one of the best-selling German writers of all time.

In 1996, the Karl May publishing company registered WINNETOU as a German trademark\(^2\) for printed matter, film production, publishing, and a variety of merchandising articles, and in 2003 for a much broader classification of goods and services as an EUTM.\(^3\)

In December 2002, the German Federal Supreme Court,\(^4\) confirming a decision of the German Federal Patent Court,\(^5\) found in an invalidation proceeding regarding the German trademark

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2. Registration No. 396 19 425.
3. Registration No. 2 735 017.
4. Case No. I ZB 19/00 (German Federal Supreme Court, Dec. 5, 2002) (WINNETOU).
that WINNETOU is descriptive of the content of the books and films, in that it refers to goods that deal with the famous literary character.

However, in March 2016, the GC\(^6\) annulled a decision of the EUIPO’s Board of Appeal (“BoA”)\(^7\) that found in an invalidation proceeding regarding the EU trademark that WINNETOU lacked distinctiveness. The BoA referred to the German decisions and stated that, according to the German decisions, the German consumer perceives the name WINNETOU as merely descriptive. The BoA pointed out: “The Board is not bound by the decisions of national courts. However, as in this case a national supreme court has decided that the term is descriptive in Germany, also the EUTM is to be regarded as being not distinctive.”

Still, the BoA explained for all goods and services why the name is descriptive. Nevertheless, the GC stated that the BoA had not made its own assessment and had accused the BoA of having felt bound by the German decisions. Having only adopted the grounds of the German decision instead of reviewing the matter independently, the BoA’s decision was annulled for non-compliance with the principle of autonomy and independence and for lacking sufficient grounds.

III. THE NEUSCHWANSTEIN CASE

One of the most famous German buildings is the castle called “Neuschwanstein,” the fame of which can, according to a survey, be compared to that of the Eiffel Tower in Paris, the Colosseum in Rome, or the Taj Mahal in Agra. It does not come as a surprise that visitors of the castle can buy T-shirts, mugs, or pralines as souvenirs that remind them of the castle and their visit by having the word “Neuschwanstein” on the product or its packaging. Such souvenirs are sold not only in the castle’s museum shop but also by the many merchants who sell such souvenirs around and in the region of the castle. Does this also indicate that all these souvenirs have the same commercial origin, or have at least been produced under the control of the same business source—for example, the owner of the castle?

In 2005, the State of Bavaria registered NEUSCHWANSTEIN for a variety of souvenir articles as a German trademark\(^8\) and in 2011 as an EUTM\(^9\)—as the State of Bavaria said, to avoid “junk

\(^6\) Case No. T 501/13 (GC, Mar. 18, 2016) (WINNETOU).
\(^7\) Case No. R 125/2012-1 (EUIPO BoA, July 9, 2013), Constantin Film v. Karl May Verwaltungs- und Vertriebs- GmbH (WINNETOU).
\(^8\) Registration No. 305 44 198.
\(^9\) Registration No. 10 144 392.
goods” and extensive diluting use of the beautiful name.10 Both trademark registrations have been contested, inter alia, for lack of distinctiveness.

In March 2012, the German Federal Supreme Court,11 confirming a decision of the German Federal Patent Court,12 found in an invalidation proceeding regarding the German trademark that NEUSCHWANSTEIN is indeed lacking distinctiveness. Descriptiveness was stated at least for those goods that are typical souvenirs, as the public associates the name on the souvenir only as a reference to the castle—that is, as an indication that the souvenir has been purchased in, or in connection with, a visit to the Neuschwanstein castle and not as an identifier of the source or origin of the souvenirs.

However, in July 2016, the GC13 found in an invalidation proceeding regarding the EUTM that NEUSCHWANSTEIN is not lacking distinctiveness, as the name “Neuschwanstein,” meaning “der neue Stein des Schwans” (or “the new stone of the swan”) is fanciful, so that the character of the castle’s name on the souvenir will allow the public not only to remember the visit of the castle but also to associate the name on the souvenir with the source of production in a way that it makes the visitors conclude that all souvenirs are produced under the control of the trademark owner. In this case, the cancellation petitioner had referred to the decision of the German Federal Supreme Court, which the EUIPO’s BoA disregarded.14 The CJEU pointed out that the EUTM system is autonomous, that it is not bound by a decision rendered on the national level, and that this applies even if the decision had been made on the basis of a statutory provision harmonized by the EU Trademark Directive, concluding that “therefore the Board of Appeal was right not taking the national decision ... into account.”

IV. HARMONIZATION IN DISHARMONY?

Whether a sign is distinctive depends on its perception among the public. It is established practice, following from the unitary character of the EUTM, that an EUTM can be registered only if the sign concerned is distinctive in all EU member states. If it is

not distinctive in only one member state, the trademark application will fail.

When the EUIPO examines the distinctiveness of an EUTM, it has to look for appropriate sources to support its finding—sources related to the various member states—that is, the national markets. It may find the same sources that the national court found as well. However, the court decision should be considered a source in itself. If it is a final decision of a national Supreme Court, the question has been finally answered for the respective country. It seems odd that a decision from the highest national court does not even qualify as a source for the finding when the same question is raised at the EU level.

There is quite some space between “being bound” and “not taking into account.” If the EUIPO reaches a different conclusion, it may do so, but it should have to explain why it is assessing the same factual question differently—that is, why it knows the public perception among—in this case—the Germans better than the Germans themselves, or why the facts should be judged in a different way. How the view from a distance (in a geographical sense) increases the awareness of the truth still needs to be proven. But in dealing with the national decision, the EUIPO might disclose a different way to judge the facts—and thereby disclose an aspect of trademark practice that suggests a need for harmonization.

For example, the EUIPO could have found that in the NEUSCHWANSTEIN case the German Supreme Court pointed out that the assessment of the distinctiveness of a sign also depends on the usual way to designate the goods concerned, in particular the location where a trademark is usually placed. If there are relevant and manifest (even if not necessarily the most likely) options to use the sign in a way in which the public will perceive it as a trademark (i.e., on tags or on the packaging) the sign may be distinctive.\(^{15}\) In contrast, it may be qualified as descriptive if the use on the goods (in the case of NEUSCHWANSTEIN, souvenirs) shows a close relationship to the topic symbolized in the sign (in the case of NEUSCHWANSTEIN, castle), in which case the sign is interpreted as a mere reference to the topic symbolized in the sign. The EUIPO could then have found that the CJEU, in contrast, is looking at the most likely way of use,\(^{16}\) accepting a “distinctiveness by presentation” only if the sign is used in a way and at a place where it is most likely perceived as an indication of origin. It could have further asked

\(^{15}\) Case No. I ZB 115/08, para. 30 (German Federal Supreme Court, June 24, 2010) (TOOOR!); and Case No. I ZB 62/09, para. 23 (German Federal Supreme Court Mar. 31, 2010) (MARLENE-DIETRICH-BILDNIS II).

whether it is admissible to consider terms in the specification of goods (e.g., mugs) that cover both souvenirs (e.g., mugs decorated with the name of the castle) and non-souvenir goods (e.g., standard mugs without any decoration) only to the extent that they cover “problematic” goods—namely souvenirs—and to make their inclusion be sufficient for a refusal. It could finally have found that the fancy nature of NEUSCHWANSTEIN is not relevant in answering the question, as it does not influence the public perception, since it is not the linguistic nature of the word itself that makes it indistinctive but rather its general recognition as the name of a famous tourist attraction. All these considerations would be key to harmonize not only the law but also the legal practice.

“Not being bound” may allow a dissenting opinion, but should at least also require an in-depth explanation of why the decision of the ultimate national court does not qualify as a reference for the case. “Not taking into account,” however, is nothing but deliberately disregarding a relevant source, even if there is no different way to judge the facts.

The justification for ignoring a national decision is tenuous, since the harmonized national trademark law is to be interpreted in the same way as the EU trademark law. The national trademark authorities and the EUIPO are therefore equal authorities in the same EU trademark system—they address trademarks on different registers but apply the same legal principles and rules. Like courts of the same member state having a look at each other’s decisions to see how the other courts handle a legal question, it seems obvious that the court-like BoAs of the EUIPO should likewise have a look at final decisions of national ultimate trademark authorities if the question to be examined on the EU level has already been finally answered for the respective territory.

It is even more tenuous when EU and national trademark law end up in the same court. At least in Germany, the Federal Supreme Court is the final instance not only in trademark prosecution matters but also in litigation matters, and insofar also the highest EU trademark court. If it has decided against the distinctiveness of a German trademark WINNETOU or NEUSCHWANSTEIN, how can it find that the EUTM WINNETOU or NEUSCHWANSTEIN was infringed? It may be bound by the EUTM registration and will have to concede a minimal scope of protection. But having stated with final effect that WINNETOU or NEUSCHWANSTEIN is not distinctive for souvenirs, it will have to deny that the contested sign is used by the defendant as a trademark, or state that such use is not covered by the scope of protection of the EUTM—and therefore deny an infringement. Otherwise, it would have to disregard its own
judgment as being no longer relevant even though it is in the court’s competence to make that judgment.

Even if the CJEU is the ultimate instance for interpreting EU law—including the EU Directive that determines the (harmonized) national law—the assessment of the facts lies with the national courts on national level, as it lies with the EUIPO on the EUTM level. There should not only be *harmony* among the EU and national levels (EUIPO’s court-like BoAs and at least the ultimate national trademark authorities) but also *equality*—as well as the encouragement to disclose possible aspects of trademark practice that may require further harmonization throughout the entire EU.

But, alluding to a well-known quotation from *Animal Farm* by George Orwell, one of Britain’s (!) most famous authors, we know that “all [courts] are equal, but some are more equal than others”—an insight that may cause some discord, not only among the British.

But, no, this did not cause the “Brexit.”
BOOK REVIEW


The Law and Practice of Trademark Transactions is best viewed as a collection of essays on various aspects of trademark transactions, rather than an attempt to provide a comprehensive survey on the topic. It has twenty-three articles written by twenty-six authors from all over the world, each writing in their own style and voice, typically on a particular aspect of trademark transactions in a particular jurisdiction.

The book is divided into two main parts. As described by the editors, the first section of the book is more universal in scope and considers strategic issues, while the second section covers selected regional and national laws.

The first part begins with an informative article on the World Trade Organization's Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) and is followed by an article on the history and scope of the various trademark treaties that harmonize many aspects of trademark law, both substantive and procedural. This may be the most helpful part of the book for practitioners because it describes the overarching requirements with which most countries must comply. Some of the strategic areas covered are the overlap of trademark and copyright for copyrighted characters, splitting trademark portfolios, and international taxation.

The second part has articles on differing aspects of trademark transactional law in the European Union, the United Kingdom, Germany, France, the United States, Brazil, China, Japan, and the Association of Southeast Asian Nations and India, organized by region (Europe, Americas, and Asia) and then by country. For the most part, the articles provide a fairly comprehensive overview of the transactional laws of the country or region, although several are more narrowly focused. For example, the U.S. section covers only the doctrine known as “assignment in gross,” not transactions more generally.

The various articles may, or may not, be useful or informative for any given reader. When an author trained or practicing in a particular country writes on a topic for which local laws vary widely, even the strategic articles will necessarily have a country-specific view that may not provide much practical advice outside of that jurisdiction. As an example, there is a discussion of
registering security interests, but it is specific to Australian law and may not apply to the registration of security interests in other countries.

The book is therefore a mixed bag. It is not a survey work that will help guide a practitioner through a multinational licensing program or restructuring, although it occasionally has helpful practice pointers. But if you have an academic bent and are interested in comparative trademark law or international harmonization, you may gain some interesting insights.

Pamela S. Chestek
GUIDELINES FOR SUBMITTING MANUSCRIPT TO THE TRADEMARK REPORTER

1. Length of articles is flexible, depending upon what is necessary to adequately cover the subject. Articles can be sent via email to Willard Knox, Staff Editor-in-Chief, at wknox@inta.org.

2. Articles under consideration are initially sent to our Senior Editors for a pre-review to assess the topic and quality of the article and decide if the article is one that the TMR wishes to pursue. If the article is accepted, it is sent to three members of our Editorial Board for review and comment. To ensure an objective process, the author's name is removed from the article. The reviewers' comments are then sent to our Senior Editor and Editor-in-Chief for a final publication decision. The review process generally requires a minimum of 90 days; the timing can vary based upon the length and complexity of the submission. The TMR cannot guarantee the timing of the review and editorial process. During this review process, we ask that contributors make a commitment to the TMR and not publish their articles elsewhere. Our reviewers are practitioners and other trademark professionals who contribute their time on a voluntary basis. The TMR counts on their expertise to ensure the quality of articles published in the TMR, and we ask that contributors respect the time commitment they make.


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