

The Trademark Reporter®



The Law Journal of the International Trademark Association

Cultural Misappropriation: What Should the United States Do?

Lauren M. Ingram

The Lanham Act's Immoral or Scandalous Provision: Down, but Not Out

Michael Stephenson

Book Review: *Likelihood of Confusion in Trademark Law*. Richard L. Kirkpatrick.

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The Trademark Reporter®

EDITOR'S NOTE

As our readers are aware, the International Trademark Association (INTA) annually presents the Ladas Memorial Award to outstanding papers in the field of trademark law or on matters that directly relate to or affect trademarks. The award is presented in two categories—with two Student¹ winners and one Professional winner. Many members of *The Trademark Reporter* (TMR) Committee volunteer to serve as judges for the Ladas Memorial Award Competition. I look forward to the opportunity each year to review papers presenting cutting-edge scholarship, often expanding the scope of debate, as well as seeing what our future colleagues are thinking and writing.

In this issue, we are proud to publish both winning 2021 Student papers: “Cultural Misappropriation: What Should the United States Do?” by Lauren M. Ingram, and “The Lanham Act’s Immoral or Scandalous Provision: Down, but Not Out” by Michael Stephenson.

In “Cultural Misappropriation,” Ms. Ingram, who graduated in 2021 with a L.L.M. from American University Washington College of Law (and is now in private practice), addresses the current debate on cultural misappropriation, generally understood to be the aping or commodification of some unique cultural aspect of a marginalized community by members of the dominant culture, without consent or against the will of the original community. There are currently few legal frameworks on which marginalized cultures can rely to protect against such misappropriation, particularly in the United States, nor is there a consensus on what constitutes cultural misappropriation. Ms. Ingram surveys legal structures, including trademark law, around the world, and considers whether such structures provide effective protection. After considering the laws of other countries, including Tunisia, the Philippines, and Panama, she concludes by proposing the creation of a *sui generis* right that can be exercised by indigenous and other marginalized communities.

¹ INTA defines the “Student” category as meaning those in the United States who are “enrolled as either full- or part-time law or graduate students.” For international students, “university enrollment is acceptable.” See Ladas Memorial Award Competition Rules & Requirements, https://www.inta.org/wp-content/uploads/public-files/about/awards/2021_LADAS_FLYER-012521.pdf.

Michael Stephenson, a 2021 graduate of the University of Pittsburgh School of Law (and now in private practice), considers the potential for a “Wild West” of obscene, profane, and vulgar trademarks used and registered in the United States following the Supreme Court’s decisions in *Matal v. Tam* and *Iancu v. Brunetti*, which struck down, on First Amendment freedom of speech grounds, first the disparagement clause and then the prohibition on registration of immoral or scandalous marks in Section 2(a) of the Lanham Act. Mr. Stephenson argues there is a place for Congress to reinstate a bar to registration of certain categories of marks that reflect a presumed consensus as to immorality or scandalousness. Mr. Stephenson’s argument relies on the dissenting opinions in *Iancu*; he also surveys modern First Amendment jurisprudence, positing that, as there are exceptions to an absolute Constitutional free speech right, such categories may provide a road map for specifying non-registrable marks, supporting both the government’s interest in not being involved in protection of unseemly trademarks, as well as a greater degree of certainty as to what marks will or will not qualify as scandalous or immoral. Mr. Stephenson argues that the categories selected can be considered in a value-neutral fashion.

Both articles address topics as to which there is a wide range of viewpoints and will undoubtedly spur further debate on how to treat these increasingly prominent topics in trademark law. The TMR is honored to be able to publish these pieces for the benefit and edification of our members and others interested in these topics. N.B.: While both pieces have been lightly edited, largely for conformance to TMR’s style requirements, we have endeavored to leave the articles in a form close to that reviewed by the Ladas judges.

The TMR Committee congratulates this year’s Student Ladas Memorial Award winners. We think that after you read the winning pieces you will agree that the future of trademark jurisprudence is bright.

Glenn Mitchell
Editor-in-Chief
Chair, The Trademark Reporter Committee

**CULTURAL MISAPPROPRIATION:
WHAT SHOULD THE UNITED STATES DO?**

*By Lauren M. Ingram**

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* Winner, 2021 Ladas Memorial Award, Student Category. Associate, Aronberg Goldgehn Davis & Garmisa, Member, International Trademark Association; LL.M., American University Washington College of Law, (2021). All opinions, errors, and omissions are the author's own.

I. INTRODUCTION

What will satisfy the public outcry for cultural misappropriation in the United States? So far, the current solutions include celebrity apologies,¹ company statements,² and the rare legal remedy if the misappropriation claim fits within the criteria of copyright or trademark law. The general public does not understand that there are few solutions within the current legal system to address cultural misappropriation. There are characteristics of cultural misappropriation³ that do not fit into the current intellectual

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- ¹ Rania Aniftos, *Cardi B Apologizes for Appropriating Hindu Culture: 'Maybe I Should Have Done My Research,'* BILLBOARD (Nov. 12, 2020), <https://www.billboard.com/articles/columns/hip-hop/9483234/cardi-b-apologizes-appropriating-hindu-culture>. (The rapper Cardi B was called out for cultural appropriation for her cover of *Footwear News* magazine. On the cover she was holding a red sneaker and was depicted as the Hindu goddess Durga). Morgan Hines, *'Stupid doesn't even cut it': Florence Pugh apologizes for cultural appropriation,* USA TODAY (June 27, 2020), <https://www.usatoday.com/story/entertainment/celebrities/2020/06/27/florence-pugh-apologizes-cultural-appropriation/3270209001/> (Actress Florence Pugh posted to her Instagram page apologizing for her previous incidents of cultural appropriation, when she wore her hair in cornrows and binds.) Christina Careaga, *British model issues lengthy, sincere apology for cultural appropriation,* MASHABLE (Nov. 21, 2016), <https://mashable.com/2016/11/21/emily-bador-blackhair-magazine-apology/> (British model Emily Bador apologized for her appearance on the cover of *Blackhair Magazine*; as a white model, Bador was accused of cultural appropriation of black culture, since in the picture her hair is styled to look as if it has the same texture as a woman of color).
- ² Avery Matera, *People Are Accusing H&M of Cultural Appropriation for Selling Socks That Appear to Feature the Word "Allah": Will H&M ever learn?,* TEENVOGUE, <https://www.teenvogue.com/story/handm-cultural-appropriation-arabic-socks> (Jan. 30, 2018) (H&M was selling a pair of socks with images of yellow figurines with jackhammers exuding squiggles that shoppers have said look like the word "Allah"). Briana Arps, Susanna Heller, and Amanda Krause, *18 controversial clothing items that were pulled from stores,* INSIDER (Oct. 30, 2019), <https://www.insider.com/clothing-items-pulled-from-stores-2017-6#before-being-sold-to-boohooom-nasty-gal-was-criticized-for-appropriating-black-culture-with-a-50-faux-leather-do-rag-8> (Nasty Gal sold a vegan leather durag and was accused of appropriating black culture. H&M had to remove a faux feather headdress from U.S. and Canadian stores when Native Americans addressed the retailer. Nordstrom and Gucci faced backlash in May for selling an \$800 "Indy Full Head Wrap," which looked to appropriate the Sikh community.)
- ³ Bruce Ziff & Pratima V. Rao, *Introduction to Cultural Appropriation: A Framework for Analysis,* in BORROWED POWER: ESSAYS ON CULTURAL APPROPRIATION 1, 1 (Bruce Ziff & Pratima V. Rao eds., 1997) [hereinafter Ziff & Rao, *Introduction to Cultural Appropriation*]; see Jill Koren Kelley, *Owning the Sun: Can Native Culture Be Protected Through Current Intellectual Property Law?,* 7 J. HIGH TECH. L. 180, 188 (2007) (quoting Ziff & Rao); Sally Engle Merry, *New Direction: Law, Culture, and Cultural Appropriation,* 10 YALE J.L. & HUMAN. 575, 585-86 (1998) [hereinafter Merry, *New Direction*]; Madhavi Sunder, *Intellectual Property and Identity Politics: Playing with Fire,* 4 J. GENDER RACE & JUST. 69, 73 (2000) [hereinafter Sunder, *Identity Politics*] (same); Rebecca Tsosie, *Reclaiming Native Stories: An Essay on Cultural Appropriation and Cultural Rights,* 34 ARIZ. ST. L.J. 299, 300, 310 (2002) (same); Angela R. Riley & Kristen A. Carpenter, *Owning Red: A Theory of (Cultural) Appropriation,* 94 TEX. L. REV. 859 (2016). Christine Haight Farley, *Protecting Folklore of Indigenous Peoples: Is Intellectual Property the Answer?,* 30 CONN. L. REV. 1, 5 (1997) (citing U.N. ESCOR, *Committee of Governmental Experts on the Safeguarding of Folklore,* 16 COPYRIGHT BULL. 27, 37 (1982)). WIPO, Revised Draft Provisions for the Protection of Traditional

property system's mold. The first problem is who should the law protect? A city? A country? An entire ethnic group? It is not clear as to who needs legal protection. If a community requires protection, who is credited as the author? The innovator? The owner? If a community recognizes its members as the author or owner, it is challenging to establish authorship in the current system. And if the original author is not identifiable, who can claim authorship? Other countries have acknowledged the current system's shortcomings and have established new laws to answer the questions above.⁴ Meanwhile, the United States has not.

In the United States, the intellectual property system⁵ is the primary source for misappropriation of intangible property. At this point, there are no cultural appropriation or misappropriation laws in the United States, so the copyright system has been the primary source for solutions. Most of the current scholarship is based on working within the confines of the copyright system.⁶ More recently, there has been the development of scholarship around remedial use of the trademark system. The current literature explores legal solutions to cultural misappropriation within the context of the current intellectual property system. Still, it has not provided a *sui generis*⁷ proposal outside of the established system, in the United States.

In Part I, this article will discuss the definition of *cultural misappropriation* and explore how the current U.S. intellectual property system fails to address cultural misappropriation adequately. Part II will analyze suggestions from the World Intellectual Property Organization ("WIPO") and provide examples of other countries' *sui generis* cultural misappropriation systems.

Cultural Expressions/Expressions of Folklore, § III, Art. 1, in WIPO/GRTKF/IC/9/4 (January 9, 2006). Rosemary J. Coombe & Nicole Aylwin, *The Evolution of Cultural Heritage Ethics via Human Rights Norms*, in DYNAMIC FAIR DEALING: CREATING CANADIAN CULTURE ONLINE 201, 201-02 (Rosemary J. Coombe, Darren Wershler & Martin Zeilinger eds., 2014).

- ⁴ Law for the Safeguarding of the Elements of Culture and Identity of Indigenous, Afro-Mexican and Equivalent. Esquivel & Martin Santos, Mexico to Pass Law Against Cultural Appropriation, ESQUIVEL & MARTIIN SANTOS (Feb. 2, 2020). <https://www.emps.es/post/mexico-legislates-cultural-appropriation> (The Mexican Senate has approved the law to "protect the rights of indigenous peoples over their collective cultural work.")
- ⁵ In the United States, intellectual property laws are put in place for the protection of patents, copyright, industrial design rights, plant varieties, trademarks, trade dress, and trade secrets.
- ⁶ This can rarely be applied, due to the fact that copyright law expects the original holder, or author, to own the work. Copyright Act, 17 U.S.C. § 201. The United States allows copyright protection for the life of the author plus seventy years. Copyright Act, 17 U.S.C. § 305.
- ⁷ *Sui generis* is Latin for "of its own kind." It is used to describe a form of legal protection that exists outside typical legal protections. *Sui generis*, CORNELL LAW SCHOOL: LEGAL INFORMATION INSTITUTE, https://www.law.cornell.edu/wex/sui_generis.

Part III of this article will conclude with my recommendation on implementing a sui generis cultural misappropriation solution in the United States, which is my contribution to this literature.

II. WHAT IS CULTURAL MISAPPROPRIATION?

One of the significant problems with a cultural misappropriation legal claim is its lack of clear definition. It is challenging to classify cultural misappropriation, which has led to confusion as to how to best remedy it. This section explores the meaning of *cultural misappropriation* and its divulsion from *cultural appropriation*.

The terms “cultural appropriation” and “cultural misappropriation” are often used interchangeably.⁸ However, not all forms of cultural appropriation are cultural misappropriation.⁹ The term “cultural appropriation” first appeared in academic writings about colonialism and Western expansionism.¹⁰ The earliest iteration of cultural appropriation derives from *cultural repatriation*¹¹ or *cultural looting*.¹² Cultural looting is the act of physically stealing cultural property from other people.¹³

The definition of “cultural appropriation” has been explored for twenty years in legal literature. However, there is no legal standard of cultural appropriation. The most cited definition of “cultural appropriation” in intellectual property comes from Sally Engle Merry, PhD.¹⁴ Merry describes cultural appropriation as “the process by which dominant groups take, and often profit from, the artistic, musical, and knowledge productions of subordinate

⁸ Nadra Nittle, *The cultural appropriation debate has changed. But is it for the better?*, THE VOX (Dec. 18, 2018, 4:10 PM EST), <https://www.vox.com/the-goods/2018/12/18/18146877/cultural-appropriation-awkwafina-bruno-mars-madonna-beyonce>.

⁹ *Id.*

¹⁰ In 1979, sociologist Dick Hebdige wrote the book *Subculture: The Meaning of Style*, which is about “how White subcultures in Great Britain constructed ‘style’ to reinforce communal identity and borrowed cultural or revolutionary symbols from other marginalized groups, particularly groups who have even less social or economic power.” This is one of the first references to cultural appropriation in literature. *Cultural Appropriation v. Appreciation | What I Hear When You Say: Viewing Guide*, PBS, https://bento.cdn.pbs.org/hostedbento-prod/filer_public/whatihear/9-Cultural_Approp-Viewing_Guide.pdf.

¹¹ Repatriation’s definition is the return or restoration of money, historical artefacts, etc., to their country of origin; an instance of this. *Repatriation*, OXFORDENGLISHDICTIONARY.com.

¹² “Cultural property” is defined as art, artifacts, etc., of cultural importance or interest, especially those regarded as belonging collectively to a particular country or people. *Cultural property*, OXFORDENGLISHDICTIONARY.com.

¹³ *Id.*

¹⁴ Sally Engle Merry (Ph.D., Brandeis, M.A., Yale, B.A., Wellesley) was a Silver Professor of Anthropology at New York University and Faculty Co-Director of the Center for Human Rights and Global Justice at New York University School of Law. *Sally Engle Merry*, N.Y.U. | LAW.

groups.”¹⁵ It is also described as “outsiders borrow[ing] cultural products not only for their intrinsic value, but also [to] invoke, describe, or caricature the source community.”¹⁶ According to Professor Merry, power dynamics are fundamental to this definition.¹⁷

The most accepted legal definition of cultural appropriation is “taking from a culture that is not one’s own of intellectual property, cultural expressions or artifacts, history and ways of knowledge.”¹⁸ Professor Susan Scafidi¹⁹ has expanded on this definition by identifying the “person or group of a certain culture as “the appropriator,” and the tangible or intangible objects that are taken from the different culture as “cultural products.”²⁰

“Most people who carry out cultural appropriation do [not] understand what cultural appropriation is.”²¹ “Cultural misappropriation occurs when a cultural fixture of a marginalized culture/community is copied, mimicked, recreated, or [commodified] by the dominant culture against the will of the original community.”²² The use of the term “misappropriation” “assumes that there are 1) instances of neutral appropriation, 2) the specifically referenced instance is non-neutral and problematic, even if benevolent in intention, 3) an act of theft or dishonest attribution has taken place, and 4) moral judgement of the act of appropriation is subjective to the specific culture from which [it] is being engaged.”²³ The two terms often seem to be conflated. However, the difference between the two terms describes a systematic level of oppression, and the other is more of day-to-day oppression. Cultural appropriation is the “loose idea of borrowing, sharing, and being inspired by other cultures,” day-to-day.²⁴ In contrast, “[c]ultural misappropriation distinguishes itself from the

¹⁵ Merry, *New Direction*, *supra* note 3, at 586.

¹⁶ Susan Scafidi, *Intellectual Property and Cultural Products*, 81 B.U. L. REV. 793, 824 (2001).

¹⁷ Merry, *New Direction*, *supra* note 3, at 586.

¹⁸ Ziff & Rao, Introduction to Cultural Appropriation, *supra* note 3.

¹⁹ Susan Scafidi (J.D., Yale, B.A., Duke) is currently the Academic Director of the Fashion Law Institute at Fordham University School of Law.

²⁰ Sari Sharoni, *The Mark of a Culture: The Efficiency and Propriety of Using Trademark Law to Deter Cultural Appropriation*, STANFORD LAW SCHOOL, 1, 4.

²¹ Anastasiya Sytnyk, *Cultural appropriation and misappropriation, why is it important and what does it mean?*, STAND (July 11, 2020). <https://stand.ie/cultural-appropriation-importance/>

²² Devyn Springer, *Resources On What ‘Cultural Appropriation’ Is and Isn’t*, MEDIUM (Sept. 11, 2018). <https://medium.com/@DevynSpringer/resources-on-what-cultural-appropriation-is-and-isn-t-7c0af483a837>.

²³ *Id.*

²⁴ Jessica Metcalf, *quoted in id.*

neutrality of cultural exchange, appreciation, and appropriation because of the instances of colonialism and capitalism.”²⁵

Before outsiders can appropriate a cultural product, they must first recognize its existence, source community, and value. The next section will examine the problems that occur with cultural misappropriation.

Problem

“Cultural groups often want to be able to control, restrict, authorize, or license uses of their cultural products by non-group members.”²⁶ Some wish to receive economic compensation for the use of their cultural products through licensing fees.²⁷ Others demand restrictive use of their cultural property.²⁸ These objectives are challenging to accomplish without some regulation or at least some remedy of cultural product misuse.

Cultural misappropriation can be challenging to identify, thus difficult to remedy. Due to these difficulties, it often faces disparagement for its restraints. Current scholarship criticizes the limitations of cultural misappropriation because of the lack of defined membership and source communities. Membership standards should include a test of group belonging, another measure to determine whether the cultural product belongs to that particular group, and a legitimacy requirement to assess whether the use of the culture’s product conforms with the rules they set out to govern it.²⁹ However, these clearly defined standards “may ‘freeze’ a culture at a particular moment.”³⁰ Opponents believe that those restraints would not benefit the source community. Scholars suggest that defining cultural products may “insulate cultures that reinforce traditions through law”³¹ or that monetization of a cultural product may diminish the importance of the cultural product.

WIPO members have expressed a need for Traditional Cultural Expressions (“TCEs”)³² or cultural product protection against unauthorized use and to prevent insulting, derogatory, culturally, or spiritually offensive use. This also includes protection from misleading or false indications as to authenticity or origin, lack of

²⁵ Devyn Springer, *Resources On What ‘Cultural Appropriation’ Is and Isn’t*, MEDIUM (Sept. 11, 2018). <https://medium.com/@DevynSpringer/resources-on-what-cultural-appropriation-is-and-isn-t-7c0af483a837>.

²⁶ Sharoni, *supra* note 20, at 11.

²⁷ *Id.*

²⁸ *Id.*

²⁹ Rebecca Tsotsie, *Reclaiming Native Stories: An Essay on Cultural Appropriation and Cultural Rights*, 34 ARIZ. ST. L.J. 299, 349-50 (2002).

³⁰ Sharoni, *supra* note 20, at 12.

³¹ Sunder, *Identity Politics*, *supra* note 3, at 170.

³² Traditional Cultural Expression as defined by WIPO.

acknowledgement of the TCE's source, and unauthorized disclosure of confidential or secret TCEs.³³ Due to the lack of consensus among WIPO members, the countries have developed their own methods to handle cultural misappropriation. The United States' law to address cultural misappropriation is discussed in the next section.

Law

In the United States, there is only one law to combat any sort of misuse of cultural products from a source community, and that is the Indian Arts and Crafts Act ("IACA").³⁴ Created by the Indian Arts and Crafts Board, it is an example of a truth-in-advertising law.³⁵ The Indian Arts and Crafts Board's purpose is "to promote American Indian and Alaska Native economic development [by expanding] the Indian arts and crafts market."³⁶ The 1990 Act made it "illegal to offer or display for sale, or sell, any art or craft product in a manner that falsely suggests it is *Indian* produced, an *Indian product*, or the product of a particular Indian tribe."³⁷ An *Indian-made* product does not include an Indian product designed by an Indian but produced by a non-Indian.³⁸ A complaint should be filed with the Indian Arts and Crafts Board to remedy a violation of the IACA.³⁹ Due to this Act, there are now criminal⁴⁰ and civil⁴¹

³³ WIPO, INTERGOVERNMENTAL COMMITTEE ON INTELLECTUAL PROPERTY AND GENETIC RESOURCES, TRADITIONAL KNOWLEDGE AND FOLKLORE, WIPO Doc. WIPO/GRTK/IC/37/7 3, 8 (2018) [hereinafter *WIPO IGC on IP, GR, TK, and FK*, WIPO/GRTK/IC/37/7].

³⁴ In this article, the word "Indian" is used as a defined term under the IACA; the use of that term does not represent the author's view.

³⁵ See Know the Law: Indian Arts and Crafts Act, WIPO, <https://www.wipo.int/edocs/lexdocs/laws/en/us/us207en.pdf>.

³⁶ Richard Awopetu, *In Defense of Culture: Protecting Traditional Cultural Expressions in Intellectual Property*, 69 EMORY L. REV. 745, 767 (2020) [hereinafter Awopetu, *In Defense of Culture*] (citing Cultural Sovereignty Series: Modernizing the Indian Arts and Crafts Act to Honor Native Identity and Expression: Field Hearing Before the S. Comm. on Indian Affairs, 115th Cong. 12 (2017) testimony of Meredith Stanton, Director, Indian Arts and Crafts Board, U.S. Department of the Interior).

³⁷ See *Know the Law: Indian Arts and Crafts Act*, *supra* note 35.

³⁸ The Indian Arts and Crafts Act, 25 U.S.C. § 305-305(e).

³⁹ The Indian Arts and Crafts Board ("IACB") is within the U.S. Department of Interior. The IACB investigates complaints of alleged IACA violations and recommends the prosecution of violators for a first-time violation of the Act. Violators can face civil or criminal penalties up to a \$250,000 fine or a five-year prison term, or both. If a business violates the Act, it can face civil penalties or can be prosecuted and fined up to \$1,000,000. *Id.*

⁴⁰ Only the U.S. Attorneys' Office can file these criminal actions in Federal Court. *Id.*

⁴¹ Only the U.S. Attorney General, on the request of the Secretary of the Interior on behalf of an Indian, Indian tribe, or Indian arts and crafts organization; an Indian tribe on its own behalf or on behalf of a tribal member or Indian arts and crafts organization; and an Indian and an Indian arts and crafts organization can file a civil action in Federal Court. *Id.*

penalties for falsely advertising that products are “Indian Made.”⁴² The Indian Arts and Crafts Board also maintains the Source Directory of American Indian and Alaska Native Owned and Operated Arts and Crafts Businesses.⁴³

There are no specific cultural appropriation or misappropriation laws in the United States. In fact, after a preliminary search on LexisNexis®, the only case to involve cultural appropriation was the infamous *Navajo Nation v. Urban Outfitters, Inc.* case.⁴⁴ The Navajo Nation filed suit against Urban Outfitters for illegally using the tribe’s name for its products, the “Navajo hipster panties” and a “Navajo print flask.”⁴⁵ Ultimately, the Navajo Nation settled. But this cultural misappropriation issue is not new to Urban Outfitters. Previously, the retail store sold an “anti-war woven scarf”⁴⁶ that many believed was exactly like a Palestinian-style keffiyeh.⁴⁷ Navajo Nation was able to file suit against Urban Outfitters under the Lanham Act.⁴⁸ A trademark infringement claim is not an option for most source communities. The next section focuses on legal protection for cultural products under the current intellectual property system.

⁴² “Indian Made” is defined as “work marketed as authentic Indian art and craftwork...produced by an artist or artisan who is an enrolled member of a federally or officially State recognized Indian tribe, or an Indian artisan certified by the tribe of their direct descent.” *Id.*

⁴³ These businesses include Indian arts and crafts cooperatives and tribal arts and crafts enterprises; businesses and galleries privately owned and operated by individuals, designers, artists, and artisans who are enrolled members of federally recognized tribes; and a few nonprofit organizations, managed by enrolled members of federally recognized tribes, that develop and market art and craft products. *Source Directory of Arts and Crafts Businesses*, DEPARTMENT OF INTERIOR: INDIAN ARTS AND CRAFTS BOARD, <https://www.doi.gov/iacb/source-directory>.

⁴⁴ A LEXISNEXIS Boolean search for “cultural appropriation” gave five results. *Navajo Nation v. Urban Outfitters, Inc.*, 2016 U.S. Dist. LEXIS 111459; *EEOC v. Catastrophe Mgmt. Sols.*, 876 F.3d 1273 (11th Cir. 2017) (Catastrophe Mgmt. Sols. Rescinded an offer to employee who refused to remove her dreadlocks. The EEOC sued on behalf of the former employee. The court compared the EEOC’s argument to cultural appropriation claim.); *Hiramoto v. Goddard College Corp.*, 184 F. Supp. 3d 84 (D.C. Vt. 2016); *Edwards v. Dep’t of State Hospitals-Coalinga*, 2014 U.S. Dist. LEXIS 176365 (E.D. Cal. 2014); *In re Marriage of Ray*.

⁴⁵ Nick Woolf, *Urban Outfitters settles with Navajo Nation after illegally using tribe’s name*, THE GUARDIAN, (Nov. 18, 2016 at 7:22 PM). <https://www.theguardian.com/us-news/2016/nov/18/urban-outfitters-navajo-nation-settlement>.

⁴⁶ *Id.*

⁴⁷ The *keffiyeh* is a traditional Middle Eastern headdress fashioned from a square meter scarf. It is most commonly used to protect the neck. During the British Mandate, Palestinian rebels used the keffiyeh to hide their identity to avoid arrest. The British mandate authorities banned the keffiyeh; however all Palestinians started to wear it to make it difficult to identify the rebels. The keffiyeh turned into a symbol of resistance for the Palestine people. *The History of Keffiyeh: A Traditional Scarf from Palestine*, HANDMADE PALESTINE, (Sept. 24, 2018), <https://handmadepalestine.com/blogs/news/history-of-keffiyeh-the-traditional-palestinian-headress>.

⁴⁸ The Navajo Nation registered the Navajo name as a trademark in 1943. *Id.*

Copyright Protection

Current intellectual property scholars look to the copyright system to remedy cultural misappropriation claims. U.S. copyright law addresses the copyright of literary and artistic works under the Berne Convention.⁴⁹ The policy goal of copyright law is to allow authors to control the exploitation of their intellectual creations.⁵⁰ The Copyright Act protects:

original works of authorship fixed in any tangible medium of expression, now known or later developed. They can be perceived, reproduced, or otherwise communicated, either directly or with [a machine's aid.]⁵¹

“Under [United States] law, [cultural products] that do not satisfy the requirements ... of intellectual property protection are, by default, part of the public domain.”⁵² Most cultural products fail both the “originality and fixation requirements, [do not fulfill] the term [requirements] of the copyright, the concept of the public domain, the focus on sole authors, ... [and] fair use.”⁵³ The originality requires the work must be “independently created by the author” and possess “at least some minimal degree of creativity.”⁵⁴ “Much of cultural [intellectual property] is comprised of intergenerational literary and artistic works, or words and symbols that are not protectable under [classic intellectual property] law.”⁵⁵ Due to the difficulty to fulfill copyright protection, some source communities look to trademark law to receive some sort of protection for their cultural products.

⁴⁹ The Berne Convention for the Protection of Literary and Artistic Works was adopted in 1886. It is a treaty among countries that deals with the protection of works and the rights of their authors. It provides creators with the means to control how their works are used, by whom, and on what terms. It is based on three basic principles and contains a series of provisions determining the minimum protection to be granted, as well as special provisions available to developing countries that want to make use of them. *Berne Convention for the Protection of Literary and Artistic Works*, WIPO, <https://www.wipo.int/treaties/en/ip/berne/>.

⁵⁰ *WIPO IGC on IP, GR, TK, and FK*, WIPO/GRTK/IC/37/7, *supra* note 33, at 3, 7.

⁵¹ 17 U.S.C. § 102(a).

⁵² Awopetu, *In Defense of Culture*, *supra* note 36, at 752 (citing Tzen Wong & Claudia Fernandini, *Traditional Cultural Expressions: Preservation and Innovation*, in *INTELLECTUAL PROPERTY AND HUMAN DEVELOPMENT* 175, 185 (Tzen Wong & Graham Dutfield eds., 2011).

⁵³ Awopetu, *In Defense of Culture*, *supra* note 36, at 770 (citing Molly Torsen, *Intellectual Property and Traditional Cultural Expressions: A Synopsis of Current Issues*, 3 *INTERCULTURAL HUM. RTS. L. REV.* 199, 201 (2008).

⁵⁴ *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 347 (1991).

⁵⁵ J. Janewas Osei-Tutu, *Cultural IP v. Commercial IP*, AMERICAN BAR ASSOCIATION: LANDSLIDE (Apr. 1, 2020) [hereinafter Osei-Tutu, *Cultural IP v. Commercial IP*]. https://www.americanbar.org/groups/intellectual_property_law/publications/landslide/2019-20/march-april/cultural-ip-vs-commercial-ip/

Trademark Protection

The trademark tools used to combat cultural misappropriation include the use of collective marks⁵⁶ and certification marks.⁵⁷ The source communities who own these marks do not have to offer goods or services identified by the mark, only that the mark is used in group membership.⁵⁸ Registration is not a prerequisite for an infringement action. If the source community has a known mark, it could file a suit based upon the likelihood of confusion or dilution.⁵⁹ However, few cultural products qualify for trademark protection, either by certification marks or collective marks. “Trademark law protects commercial symbols but not words or symbols that are primarily cultural in nature.”⁶⁰

As much as the United States intellectual property system wants to work within their current system, it ignores cultural products that are not used within commerce, which applies to most of them.⁶¹ The Indian Arts and Crafts Act allows for a cause of action in infringement cases and imposing civil and criminal penalties on infringing parties, analogous to Section 2(a) of the Lanham Act.⁶²

If the United States could incorporate a concise definition of cultural misappropriation, that would be the first step to identify effective legal solutions to cultural misappropriation, instead of the alternative of trying to remedy the claims within the copyright and trademark system. And the use of the IACA applies only to select cultural products. WIPO has looked to create a concise definition of cultural misappropriation and to develop cooperation among

⁵⁶ Collective mark means a trademark or service mark—(1) used by the members of a cooperative, an association, or other collective group or organization, or (2) which cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this [Act], and includes marks indicating membership in a union, an association, or other organization. 15 U.S.C. § 1127.

⁵⁷ “Certification mark” means any word, name, symbol, or device, or any combination thereof—(1) used by a person other than its owner, or (2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this Act, to certify regional or other origin material, mode of manufacture, quality, accuracy, or other characteristics of such person’s goods or services or that he work or labor on the goods or services was performed by members of a union or other organization. 15 U.S.C. §§ 1054, 1127.

⁵⁸ Dariush Aldi, *Countering Cultural Appropriation Through Trademark Laws*, IP WATCHDOG (July 31, 2019), <https://www.ipwatchdog.com/2019/07/31/countering-cultural-appropriation-trademark-laws/id=111746/>

⁵⁹ *Id.*

⁶⁰ Osei-Tutu, *supra* note 55.

⁶¹ *Id.*

⁶² Provides that no trademark shall be refused registration on account of its nature unless it consists of matter that may disparage persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute. Section 2(a) of the Lanham Act, 15 U.S.C. 1052(a).

national WIPO members to address cultural misappropriation claims.

III. WIPO GUIDELINES

WIPO would like to find a solution to cultural product protection because cultural product protection is incompatible with the current intellectual property system. According to WIPO's *Practical Guide to Intellectual Property for Indigenous Peoples and Local Communities*,⁶³ cultural products, as defined above, are called Traditional Knowledge ("TK") and "TCEs,"⁶⁴ as defined above. WIPO's increased attention to cultural misappropriation protection comes from other countries that have developed their own cultural misappropriation sui generis systems. TK is collaboratively known as the "know-how skills, innovations, and practices developed by indigenous peoples and local communities."⁶⁵ TCEs are tangible knowledge and intangible forms in which traditional knowledge and cultures are expressed.⁶⁶ For this article, the focus is solely on legislation regarding TCEs, not TK. TCEs are most similar to the cultural products at the epicenter of cultural misappropriation in the United States. The author also acknowledges some overlap in both categories—for example, making traditional handicrafts. The method of making a handicraft could be considered TK, and the handicraft's external appearance would be considered a TCE.⁶⁷

WIPO has yet to negotiate an international legal instrument for the protection of TK and TCEs. As described above, this incompatibility has led WIPO to create frameworks for the legal protection of cultural products. WIPO's policy goals behind cultural product protection include the creative and distinctive expressions themselves, the reputation or distinctive character associated with them, and their manufacturing method.⁶⁸ Both TK and TCEs were around long before the current intellectual property system was created and not considered when it was developed.

WIPO suggests implementing a sui generis system if the country's intellectual property system is incompatible with cultural product protection. Based upon its policy goals, WIPO created a framework for a sui generis cultural product protection system based on the following questions:

⁶³ *Protect and Promote Your Culture: A Practical Guide to Intellectual Property for Indigenous Peoples and Local Communities*, WIPO, https://www.wipo.int/edocs/pubdocs/en/wipo_pub_1048.pdf.

⁶⁴ An example of TK is the knowledge indigenous peoples and local communities developed regarding the use of plants for medicinal purposes. *Id.* at 9.

⁶⁵ Examples of TCEs include traditional dances, songs, and designs. *Id.*

⁶⁶ *Id.*

⁶⁷ *Id.*

⁶⁸ *Id.* at 6. Handicrafts, musical instruments, and textiles. *Id.*

(i) What is the policy objective of the protection? (ii) What is the subject matter? (iii) What criteria should this subject matter meet to be protected? (iv) Who owns the rights? (v) What are the rights? (vi) How are the rights acquired? (vii) How to administer and enforce the rights? and (viii) How are rights lost or how do they expire?⁶⁹

Other countries and WIPO members have implemented sui generis measures based upon the questions presented above. Their implementation of their respective sui generis systems is explored in the next section.

Other Laws Outside of the United States

The Tunis Model Law was drafted by the Secretariat of United Nations Educational, Scientific and Cultural Organization (“UNESCO”) and the International Bureau of WIPO to “facilitate countries’ access to foreign works protected by copyright while ensuring appropriate international protection for their works.”⁷⁰ Under the Tunis Model Law, cultural products, or “folklore” (as described in the model law),⁷¹ should receive sui generis protection. Under this protection, an author would have exclusive rights to reproduce, translate, adapt, arrange, transform, and communicate work to the public through performance or broadcasting. Infringement of cultural products’ rights is considered a violation of national cultural heritage and may be curbed by legitimate means.⁷² There is no fixation requirement to receive this protection.

The Tunis Model Law for cultural product protection distinguishes itself from copyright law by its unlimited term duration.⁷³ Most copyright provisions across the globe allow protection for only a certain duration, as in the United States, where the protection duration is only the author’s life plus seventy years.⁷⁴

⁶⁹ WIPO, INTERGOVERNMENTAL COMMITTEE ON INTELLECTUAL PROPERTY AND GENETIC RESOURCES, TRADITIONAL KNOWLEDGE AND FOLKLORE, WIPO Doc. WIPO/GRTK/IC/3/8 (2002). [hereinafter *WIPO IGC on IP, GR, TK, and FK*, WIPO/GRTK/IC/3/8].

⁷⁰ Tunis Model Law on Copyright for developing countries. Tunis Model Law on Copyright was adopted by the Committee of Governmental Experts convened by the Tunisian Government in Tunis from February 23 to March 2, 1976, with the assistance of WIPO and UNESCO.

⁷¹ *Folklore* as defined by the Tunis Model Law is all literary, artistic, and scientific works created on national territory by authors presumed to be nationals of such countries or by ethnic communities, passed from generation to generation and constituting one of the basic elements of the traditional cultural heritage. WIPO, Tunis Model Law on Copyright for developing countries Section 18.

⁷² Tunis Model Law on Copyright for developing countries Section 15(2).

⁷³ Tunis Model Law on Copyright for developing countries Section 6(2).

⁷⁴ U.S. copyright protection is the life of the author plus 70 years. Copyright Act, 17 U.S.C. § 305.

If the use of folklore work is derivative, it could qualify as copyright work and have limited-term protection.⁷⁵

In 1997, the Philippines, a WIPO member, created its traditional knowledge law, *The Indigenous Peoples Rights Act. The Indigenous Peoples Rights Act of 1997* allows for its source community (Indigenous Cultural Communities/Indigenous Peoples, or “ICCs/IPs”⁷⁶) to protect their right to practice and revitalize their own traditions and customs.⁷⁷ The Act entitles those under its protection to recognized full ownership, control, and protection of their cultural and intellectual rights.⁷⁸ This protection is automatic if the cultural product comes from an ICC/IP. This is in contrast to the United States, whose source communities receive protection only for their cultural products sold in commerce that comply with the Indian Arts and Crafts Board mentioned above.⁷⁹

Another WIPO member, Panama, created a separate office to protect its source communities’ cultural products, the Directorate General of the Industrial Property Registry Ministry of Commerce and Industries (“DIGERPI”). Panama’s sui generis system is based upon Panama’s Law No. 20, Article 15:

The rights of use and commercialization of the art, crafts and other cultural expressions based on the tradition of the indigenous community, must be governed by the regulation of each indigenous communities [sic], approved and registered in DIGERPI or the National Copyright Office of the Ministry of Education, according to the case.⁸⁰

This Panamanian law “[h]elps confine protected subject matter [that is] within . . . (a) the expression of the cultural identity of a given community, and (b) the susceptibility of commercial exploitation.”⁸¹ Only elements of traditional knowledge that remain

⁷⁵ *Id.*

⁷⁶ “ICCs/IPs are a group of people identified by self-ascription and ascription by others, who have continuously lived as an organization community on communally bounded and defined territory, and who have, under claims of ownership since time immemorial, occupied, possessed, and utilized such territories, sharing common bonds of language, customs, traditions, and other distinctive cultural traits, or who have, through resistance to political, social, and cultural inroads of colonization, non-indigenous religions, and cultures, become historically differentiated from the majority of Filipinos.” The Indigenous Peoples Rights Act of 1997, Republic Act No. 8371.

⁷⁷ *Id.*, Chapter VI, Section 32 (Phil.).

⁷⁸ *Id.*

⁷⁹ *Know the Law: Indian Arts and Crafts Act*, *supra* note 35.

⁸⁰ Law No. 20 of June 26, 2000, on Special System for the Collective Intellectual Property Rights of Indigenous Peoples for the Protection and Defense of their Cultural Identity and their Traditional Knowledge [hereinafter Special System for the Collective Intellectual Property Rights of Indigenous Peoples Act 20], Chapter III, Article 7, available at <https://wipolex.wipo.int/en/text/497286>.

⁸¹ *WIPO IGC on IP, GR, TK, and FK*, WIPO/GRTK/IC/3/8, *supra* note 69, at 18.

intrinsically linked to the community that originated them deserve legal protection.

The DIGERPI has dual roles as an “examiner and auditor for all matters involving intellectual property rights and interests of indigenous peoples (including, but not limited to, the filing of indigenous knowledge-based applications in the area of patents by third parties).”⁸² The DIGERPI’s role is already similar to the current system developed within the United States Patent and Trademark Office (“USPTO”). The United States does not always implement WIPO guidelines, regardless of other WIPO members’ application of them.⁸³ In the final part of this article, the author will address WIPO’s recommendations and its applications to the United States.

IV. AUTHOR RECOMMENDATIONS

“An intellectual property system becomes [a] *sui generis* one if its modification of some of its features [is] to properly accommodate the special characteristics of its subject matter, and the specific policy needs which led to the establishment of a distinct system.”⁸⁴

The author recommends that the U.S. establish a *sui generis* system to protect its source communities’ cultural products. The system should be based upon the recommendations of WIPO and the model laws of other countries. Creating a *sui generis* system should begin with creating a database of source communities in the United States and then ensure that the system fits the criteria to adapt to WIPO’s policy goals discussed in Part II.

The system should first ensure which source communities are protected by expanding the database created by the United States Patent and Trademark Office’s Native American tribal insignia database.⁸⁵ It would be nearly impossible to assume that every innovator is aware of every cultural product. Thus, it is necessary to create a database for source communities that need protection. For a *sui generis* cultural product system, “[t]he inventory, compilation, or database [s]hould describe in detail the knowledge of traditional communities, without separating its components.”⁸⁶ This is vital, especially in a vast multicultural country like the United States.

⁸² *Id.* at 22.

⁸³ WIPO administers 26 treaties, including the WIPO Convention. The United States is a member to only seventeen of the twenty-six WIPO treaties. *WIPO-Administered Treaties*, WIPO, <https://www.wipo.int/treaties/en/>.

⁸⁴ *WIPO IGC on IP, GR, TK, and FK*, WIPO/GRTK/IC/3/8, *supra* note 69.

⁸⁵ Awopetu, *In Defense of Culture*, *supra* note 36, at 763; In 2001, the USPTO “established a database containing the official insignia of all State and federally recognized Native American tribes which cannot be registered as trademarks.” Trademark Law Treaty Implementation Act, Pub. L. 105-330, § 302, 112 Stat. 3071 (1998).

⁸⁶ *WIPO IGC on IP, GR, TK, and FK*, WIPO/GRTK/IC/3/8, *supra* note 69, at 14.

After determining the appropriate source communities, it is essential to determine what attributes for this new sui generis system can be established. Based upon WIPO's suggestions, the author has identified six key attributes of a successful sui generis system in the United States. These attributes include definitive criteria, collective ownership, specific ownership rights, acquisition of ownership rights, administration and enforcement of rights, and possible termination of rights.

A. Criteria

The initial step in identifying the attributes of a cultural product protection system would be creating criteria. The purpose of the criteria is not to limit the elements of the scope of cultural products but to "operate as 'no trespassing' signs" as suggested by WIPO.⁸⁷ The first criteria should apply only to cultural products with commercial utility. Cultural products that are not susceptible to commercial utility should not be covered. The author acknowledges the difficulty of separating cultural products into those that have commercial utility and those that do not. Thus, the protection should apply only to cultural products used in interstate and international commerce.

The second criteria would apply protection only to cultural products that are documented and fixated.⁸⁸ The documentation and fixation do not have to occur when the cultural product was created, especially if facts surrounding the documentation and fixation prove that its origin occurred before documentation and fixation were possible. The next attribute is determining ownership of the cultural product.

B. Ownership

It is important to establish criteria for ownership based upon the customs within that specific source community. Ownership should be based on the collective source community, not a single individual. A source community must define its cultural product because community membership may extend beyond national borders.⁸⁹ That would mean learning from and receiving information about customs in that community, about whether or not the cultural

⁸⁷ *Id.*

⁸⁸ This is the same as the fixation requirement in copyright law. A work is fixed in a tangible medium of expression "when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration. A work consisting of sounds, images, or both, that are being transmitted, is 'fixed' . . . if a fixation of the work is being made simultaneously with its transmission." 17 U.S.C. § 101.

⁸⁹ *Id.*

product comes from one person, and about who may represent the community or identify knowledge passed down to everyone in the community.⁹⁰ WIPO suggests that “lawmakers establish co-ownership of rights or leave it up to communities to apply for separately and obtain rights in jointly held [cultural products].”⁹¹

I recommend the creation of co-ownership rights in this sui generis system. It is not clear to the author of any detrimental effects of incorporating co-ownership rights into the current intellectual property regime. Thus, in the sui generis regime that protects indigenous groups’ cultural products, it is recommended that co-ownership rights be created. WIPO also mentions that “competition between traditional communities for assigning or transferring knowledge susceptible of industrial application would lead to a reduction of prices and benefits to be paid for such knowledge, hence to the ultimate benefit of customers.”⁹² The next criteria are to determine which rights need protection.

C. What Are the Rights?

Based upon the recommendations from WIPO, the rights of a sui generis system on intellectual property protection of cultural product should be a combination of features from copyright law and industrial property features.⁹³ These two rights include moral rights and licensing rights. The first right from the current IP system that should be applied to the new sui generis system are moral rights.⁹⁴ WIPO says strong moral rights are “a crucial component [to a] sui generis system [due] to the ... protection and preservation of the cultural identity of traditional communities.”⁹⁵ Moral rights apply only to visual arts⁹⁶ under the current copyright system. Nonetheless, in this proposed sui generis system, moral rights should apply to any cultural product that fits the criteria discussed in this section.

The next right is “the right to assign, transfer and license the [cultural products].”⁹⁷ The owner or owners of the cultural product have “the right to say ‘no’ to third parties” and to say “yes” to those who request permission to reproduce, fix, or use the protected

⁹⁰ *Id.*

⁹¹ *Id.* at 19-20.

⁹² *Id.* at 20.

⁹³ *Id.* at 20.

⁹⁴ Moral rights are the rights “to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to this honor or reputation.” 17 U.S.C. § 106A.

⁹⁵ *WIPO IGC on IP, GR, TK, and FK*, WIPO/GRTK/IC/3/8, *supra* note 69, at 21.

⁹⁶ 17 U.S.C. § 101.

⁹⁷ *WIPO IGC on IP, GR, TK, and FK*, WIPO/GRTK/IC/3/8, *supra* note 69, at 20.

subject matter.⁹⁸ This right is integral to most intellectual property rights in the United States and should continue with the cultural product protection.

D. How Are the Rights Acquired?

WIPO recommends multiple options for a sui generis system to establish a community's rights. One option is to establish rights based upon the filing of the compilation of traditional knowledge data with a governmental agency.⁹⁹ Another option is to create a formal system, similar to the USPTO, which allows the "establishment of subsequent mechanisms of control over the legitimacy of claims."¹⁰⁰ This formal system could be based upon the DIGERPI office in Panama, which would also help administer the rights, as discussed in the next section.

E. How Are the Rights Administered and Enforced?

"Traditional knowledge protection would not be effective without the availability of effective and expeditious remedies against their unauthorized reproduction or use."¹⁰¹ This proposed sui generis system should be analogous to the Indian Arts and Crafts Board,¹⁰² wherein complaints can be filed and evaluated by a board and would be optimal to administer and enforce cultural product owners' rights. Or a separate governmental agency, such as the DIGERPI in Panama, could be created.¹⁰³ This board or agency could evaluate the best remedy for an infringement of the rights or whether the remedy would require civil or criminal sanctions. Ultimately, the United States should create an intellectual property office similar to the DIGERPI office that focuses on administration and enforcement of the appropriate source communities' cultural products. After determining how the rights are enforced and administered, it is important to know if and how the rights can terminate.

F. How Are the Rights Lost? How Do They Expire?

There might be a need for defining the public domain in connection with traditional knowledge.¹⁰⁴ Many national laws

⁹⁸ *Id.*

⁹⁹ *Id.* at 22.

¹⁰⁰ *Id.* at 23.

¹⁰¹ *Id.*

¹⁰² *Know the Law: Indian Arts and Crafts Act*, *supra* note 35.

¹⁰³ Special System for the Collective Intellectual Property Rights of Indigenous Peoples Act 20, *supra* note 80.

¹⁰⁴ *WIPO IGC on IP, GR, TK, and FK*, WIPO/GRTK/IC/3/8, *supra* note 69, at 24.

attempt to protect traditional knowledge through an indefinite period.¹⁰⁵ This allows source communities to receive protection in perpetuity, preserving their community's culture. Limiting the amount of time for rights could allow for someone else to make money off of a source community's culture. I recommend creating an indefinite period of protection due to the "intergenerational and incremental nature of [cultural products]."¹⁰⁶

The United States is not limited to protections solely under its current IP system and should consider the WIPO guidelines for cultural product protection. A sui generis system is the best option to protect the country's vast cultural misappropriation claims.

V. CONCLUSION

It is arduous to change the balance of the current intellectual property regime in the United States. Its focus is to foster creativity, not limit innovation. The author acknowledges the impediments to innovation that adapting a sui generis system would have in the United States. However, the author believes that a new system would provide economic freedom to others whose innovations began long before the IP system existed. Many of the recommendations mentioned in this article are based upon elements that are already part of the IP system and should be implemented into cultural product legal protection in the United States.

¹⁰⁵ Rights are indefinite (not unlimited). Panama Law No. 20, Article 7. Moral Rights and traditional cultural rights continue in force in perpetuity, are inalienable, and cannot be waived or transferred. South Pacific Model Law for National Laws Section 9 and 13(4) without limitation in time. Tunis Model Law on Copyright Section 6(2).

¹⁰⁶ *WIPO IGC on IP, GR, TK, and FK*, WIPO/GRTK/IC/3/8, *supra* note 69, at 24.

**THE LANHAM ACT'S IMMORAL OR
SCANDALOUS PROVISION:
DOWN, BUT NOT OUT**

*By Michael Stephenson**

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I. INTRODUCTION

The United States Trademark Act, known as the “Lanham Act,” defines trademarks as “any word, name, symbol, or device, or any combination thereof used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others.”¹ They can range from the logos and symbols of global brands, like APPLE, COKE, GOOGLE, and MICROSOFT, to the names of local stores that line the streets of Small-town, USA. Nevertheless, it seems as though trademarks are everywhere, and for good reason. After all, if used effectively, trademarks can serve as an efficient communication tool for businesses, as they possess the ability to instantly convey persuasive, emotional messages about a mark’s associated products or services. Accordingly, trademark owners often spend a lot of time and money to ensure that the messages attached to their mark are positive ones and that their marks reach as many consumer eyes as possible.

Much like the Federal Communications Commission (“FCC”) regulates communications by radio, television, and other broadcast media that have the ability to reach a large audience, the United States Patent and Trademark Office (“USPTO”) regulates trademarks and determines whether trademark applicants meet the statutory requirements, set forth by the Lanham Act, for federal registration.² While the Lanham Act’s primary purpose is to protect trademark owners against infringement and unfair competition, and the public against confusion and inaccurate information,³ the act contains other provisions that indicate a broader purpose. For example, as the FCC imposes regulations against indecency and obscenity from reaching a large audience,⁴ the Lanham Act similarly includes an “immoral”/“scandalous” provision that prohibits registration of marks that “[c]onsist[] of or comprise[] immoral . . . or scandalous matter.”⁵ To determine if a mark falls under this provision, the USPTO “asks whether a ‘substantial composite of the general public’ would find the mark ‘shocking to the sense of truth, decency, or propriety’; ‘giving offense to the conscience or moral feelings’; ‘calling out for condemnation’; ‘disgraceful’; ‘offensive’; ‘disreputable’; or ‘vulgar.’”⁶ Clearly, in addition to its primary purposes, the Lanham Act also serves to regulate certain content from reaching a mass audience.

¹ 15 U.S.C. § 1127 (2018).

² See generally Lanham Act, 15 U.S.C. ch. 22.

³ Chris Cochran, *It’s “FUCTION”: The Demise of the Lanham Act*, 59 IDEA 333, 335 (2019).

⁴ See *Obscene, Indecent and Profane Broadcasts*, FCC, <https://www.fcc.gov/consumers/guides/obscene-indecnt-and-profane-broadcasts> (last updated Jan. 13, 2021).

⁵ 15 U.S.C. § 1052(a).

⁶ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2298 (2019).

For decades, critics have placed the immoral or scandalous provision under a microscope, arguing that it is unconstitutional under the Free Speech Clause of the First Amendment of the U.S. Constitution.⁷ Despite this claim, though, the provision held steady within the Lanham Act and had consistently resisted opposition. However, this all changed in 2019 when the Supreme Court finally struck down the immoral or scandalous provision as unconstitutional in *Iancu v. Brunetti*.⁸ The Court reasoned that the provision permitted USPTO examiners to exercise “viewpoint discrimination” by either favoring or disfavoring one or more opinions of a particular controversy.⁹ Specifically, the Court expressed disapproval in the provision’s overly broad language and in the USPTO’s inconsistency in drawing the line between unregistrable and permissible marks.¹⁰ In the end, the Court was left with no choice but to open the door for immoral and scandalous marks to be federally registered and to receive full federal protection. At the same time, though, the Court seemed to express concerns regarding the possibility of immoral and scandalous marks becoming prevalent in society,¹¹ and dissenting opinions gave a clear invitation to Congress to fill this newly created void with fresh legislation.¹²

This article argues that it is imperative that the Lanham Act’s immoral or scandalous provision be revitalized in light of the *Brunetti* decision and further proposes a new, narrow, viewpoint-neutral test that will allow for more consistent and predictable results. This new test can replace the USPTO’s old viewpoint-discriminatory standard while also promoting the long-standing goal of barring registration of immoral and scandalous marks. This

⁷ See, e.g., Megan M. Carpenter & Kathryn T. Murphy, *Calling Bulls**t on the Lanham Act: The 2(a) Bar for Immoral, Scandalous, and Disparaging Marks*, 49 U. Louisville L. Rev. 465 (2011) (arguing that the sole object and purpose of trademark law is to promote fair competition, and that the immoral or scandalous provision “expands . . . well beyond [this] basic goal[]”).

⁸ See 139 S. Ct. 2294.

⁹ *Id.* at 2299.

¹⁰ *Id.* at 2300.

¹¹ *Id.* at 2301 (describing the USPTO’s refusal to register certain immoral and scandalous marks as “understandable,” as the “marks express opinions that are, at the least, offensive to many Americans”).

¹² See *id.* at 2303–04 (Roberts, C.J., dissenting) (“The Government . . . has an interest in not associating itself with trademarks whose content is obscene, vulgar or profane. The First Amendment protects the freedom of speech; it does not require the Government to give aid and comfort to those using obscene, vulgar, and profane modes of expression.”); *Id.* at 2307 (Breyer, J., dissenting) (“The Government has at least a reasonable interest in ensuring that it is not involved in promoting highly vulgar or obscene speech, and that it will not be associated with such speech.”); *Id.* at 2317 (Sotomayor, J., dissenting) (“[T]he Government has an interest in not promoting certain kinds of speech, whether because such speech could be perceived as suggesting governmental favoritism or simply because the Government does not wish to involve itself with that kind of speech.”).

article proceeds in three parts. Part I includes a detailed discussion of the Lanham Act, its problematic provisions, and case law that has shaken up the modern trademark landscape. Part II investigates the First Amendment, specifically the ideas of viewpoint discrimination and regulated speech. Finally, Part III will propose a framework for a new constitutionally sound provision to replace the now-invalid immoral or scandalous provision.

II. THE LANHAM ACT AND ITS PROBLEMATIC PROVISIONS

A. A Brief History

The first trademark lawsuits arose in the United States in the 1840s, but it was not until decades later in 1870 that Congress first adopted a federal statutory trademark law.¹³ This act was short lived, and was eventually replaced by the more narrowly crafted 1881 Trademark Act.¹⁴ The 1881 Act listed only two bars to federal registration: (a) marks that contained the name of a person, and (b) marks that were so similar to previously registered marks as to cause a likelihood of confusion, mistake, or deception for the public.¹⁵

Almost immediately after the passage of the 1881 Act, amendments were proposed and lobbied for.¹⁶ Eventually, in 1892, the first suggestion of a “scandalous” registration prohibition was made.¹⁷ After more than a decade of debate, in the updated 1905 Trademark Act, Congress included a provision that precluded the registration of any mark that “consists of or comprises immoral or scandalous matter.”¹⁸ Congress then included a similar provision in 1946 with the passage of the Lanham Act, and in 1994, the language of the current provision was adopted: “Consists of or comprises immoral, deceptive, or scandalous matter.”¹⁹

Though no direct justifications for the immoral and scandalous bars can be found within the aforementioned string of federal trademark acts or their legislative histories, scholars have suggested that the provision was adopted because “the government should not waste its resources on protecting unseemly marks.”²⁰

¹³ See Ross Housewright, *Early Development of American Trademark Law* 3 (2007); Jasmine Abdel-khalik, *To Live in In-“fame”-y: Reconceiving Scandalous Marks as Analogous to Famous Marks*, 25 *Cardozo Arts & Ent. L.J.* 173, 182 (2007).

¹⁴ Abdel-khalik, *supra* note 13, at 183.

¹⁵ *Id.*

¹⁶ *Id.* at 183–84.

¹⁷ *Id.*

¹⁸ *Id.* at 185.

¹⁹ *Id.*

²⁰ Carpenter & Murphy, *supra* note 7, at 467.

Scholars have also pointed to a number of other justifications for the immoral or scandalous provision, including that “the government ‘should not create the appearance that it favors the use of scandalous [or] immoral marks,’” that the government “should promote . . . public health, welfare, and morals by discouraging” said marks, and that the government “should protect the sensitivities of those in public who might be offended” by said marks.²¹ The works of William Henry Browne, a prominent legal scholar of the nineteenth century, seem to support these validations.²² In his treatise published shortly after the 1881 Act, Browne explained that marks should not “transgress the rules of morality or public policy,” and that marks should not shock the sensibilities of anyone in the world on the basis of moral, religious, or political grounds.²³ So, while there may be a lack of legislative history and straightforward reasoning regarding the inclusion of an immoral or scandalous provision, the above economic and moral justifications are ones that transcend time and remain relevant today.

Evidence also suggests that such a provision is useful to promote the overall well-being of society.²⁴ For example, scientific research shows that vulgarity and other similar speech leave negative psychological and emotional impacts on their audiences.²⁵ Because vulgar words stem from a different part of our brains, as opposed to most other words,²⁶ these types of words are harder to forget and attract more attention than other “normal” words.²⁷ Further, studies have found that the modern use of profanity is associated with emotions such as sadness and anger, and people usually use this strong language in social settings to excite these emotions in both themselves and others.²⁸ All in all, this information indicates that there certainly seems to be legitimate and strong interests in keeping immoral and scandalous marks from public view.

²¹ *Id.* at 468.

²² Abdel-khalik, *supra* note 13, at 188–95.

²³ *Id.* at 194.

²⁴ *See generally* Melissa Mohr, *Holy S**T: A Brief History of Swearing* (2013); Timothy Jay, Catherine Caldwell-Harris & Krista King, *Recalling Taboo and Nontaboo Words*, 121 *Am. J. Psychol.* 83 (2008).

²⁵ *See* Mohr, *supra* note 27, at 252.

²⁶ *Id.* at 250.

²⁷ *See* Jay, Caldwell-Harris & King, *supra* note 27, at 83–86.

²⁸ Katy Steinmetz, *#Cursing Study: 10 Lessons About How We Use Swear Words on Twitter*, *Time* (Feb. 19, 2014), <https://time.com/8760/cursing-study-10-lessons-about-how-we-use-swear-words-on-twitter/>.

B. The Clash Between the Lanham Act and the First Amendment

Typically, the USPTO has applied the immoral or scandalous provision “as a ‘unitary provision,’ rather than treating the two adjectives . . . separately.”²⁹ To determine whether a mark fits within this provision, the USPTO “asks whether a ‘substantial composite of the general public’ would find the mark ‘shocking to the sense of truth, decency, or propriety’; ‘giving offense to the conscience or moral feelings’; ‘calling out for condemnation’; ‘disgraceful’; ‘offensive’; ‘disreputable’; or ‘vulgar.’”³⁰

However, Congress cannot simply put into place any restriction they so desire, as it must adhere to well-established constitutional limits. At issue within the context of trademarks and the Lanham Act is the First Amendment’s Free Speech Clause.³¹ A core idea of free speech is that the government cannot favor or disfavor certain speech based on the ideas or opinions it conveys,³² also known as “viewpoint discrimination.” Put differently, a statutory provision disfavoring “ideas that offend,” like the immoral or scandalous provision, may not pass constitutional muster, as it permits the USPTO to be selective in the ideas it allows.³³

For example, two years prior to *Brunetti*, the Supreme Court laid down significant groundwork for the eventual revocation of the Lanham Act’s immoral or scandalous provision under the Free Speech Clause. In *Matal v. Tam*, a 2017 decision, the Court nullified the Lanham Act’s prohibition on “disparaging” trademarks, holding that the provision violated the First Amendment’s Free Speech Clause.³⁴ Although the disparaging provision is separate and distinct from the immoral or scandalous provision, a dive into *Tam* is worthwhile, as the Court’s analyses in both *Tam* and *Brunetti* follow a similar form.

1. Strike One: *Matal v. Tam*

In 2010, Simon Tam, founder of the Asian American band “The Slants,” applied for trademark protection for the name of his band.³⁵ The USPTO rejected Tam’s application and reasoned that the likely

²⁹ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2298 (2019) (quoting *In re Brunetti*, 877 F.3d 1330, 1330 (Fed. Cir. 2017)).

³⁰ *Id.*

³¹ *See generally id.* (explaining that all trademark provisions must survive Free Speech Clause review to be valid).

³² *See id.* at 2299 (“[A] core postulate of free speech law: The government may not discriminate against speech based on the ideas or opinions it conveys.”).

³³ *Id.* at 2299 (quoting *Matal v. Tam*, 137 S. Ct. 1744 (2017)).

³⁴ *Matal v. Tam*, 137 S. Ct. 1744 (2017).

³⁵ *In re Tam*, 785 F.3d 567, 568 (Fed. Cir. 2015).

meaning of “The Slants” was to refer to people of Asian descent, thus violating the Lanham Act’s disparaging clause,³⁶ which prohibits the registration of marks that may disparage persons, institutions, or beliefs.³⁷ Tam decided to appeal this decision to the Federal Circuit on the issue that the disparaging clause violated the Free Speech Clause of the First Amendment. In 2015, the Federal Circuit ruled in favor of Tam and held that the disparagement bar is facially unconstitutional and exercised viewpoint discrimination.³⁸

In 2017, the Supreme Court affirmed this decision.³⁹ The Court agreed on two ideas: first, if a trademark regulation bar is viewpoint based, it is unconstitutional because it violates the First Amendment’s Free Speech Clause, and second, the disparagement bar was based on viewpoint.⁴⁰

The Court determined that a core principle of free speech law is that the government cannot discriminate against speech based on the ideas or opinions it conveys.⁴¹ The Court further determined that the disparagement clause reflects the government’s disapproval of a subset of messages it finds offensive, which is the exact essence of viewpoint discrimination.⁴² Particularly important to Justice Alito was that the Lanham Act’s disparagement clause is not “narrowly drawn,” as “[t]he clause reaches any trademark that disparages *any* person, group, or institution.”⁴³ The Court seemed to concede that speech that demeans on the basis of race, ethnicity, gender, religion, age, or any other ground is undoubtedly hateful and is speech that the government cannot be expected to endorse, but nevertheless, the “proudest boast of the Supreme Court’s free speech jurisprudence is that it protects the freedom to express hated thoughts.”⁴⁴

Ultimately, the *Tam* decision not only killed the disparagement clause, but it put the immoral or scandalous provision on death row, as the immoral or scandalous provision similarly called for USPTO examiners to judge the marks on the basis of viewpoint.

2. Strike Two: *Iancu v. Brunetti*

In 2011, Erik Brunetti, owner of a clothing line under the name “FUCT,” sought to register the mark FUCT to prevent competitors

³⁶ *Tam*, 137 S. Ct. at 1754.

³⁷ *Id.* at 1748.

³⁸ *In re Tam*, 785 F.3d 567.

³⁹ *Tam*, 137 S. Ct. at 1747.

⁴⁰ *Id.* at 1751.

⁴¹ *Id.* at 1763.

⁴² *Id.*

⁴³ *Id.* at 1764–65.

⁴⁴ *Id.* at 1764.

and knock-offs from appropriating his brand.⁴⁵ The USPTO rejected Brunetti's application and reasoned that FUCT was phonetically similar to a well-known expletive previously established as a scandalous word under the Lanham Act.⁴⁶ Brunetti appealed this decision to the Trademark Trial and Appeal Board, but they upheld the decision.⁴⁷ Brunetti followed with an appeal to the Federal Circuit on the issue that the immoral or scandalous provision violated the Free Speech Clause of the First Amendment.⁴⁸

Less than a year after the Supreme Court decided *Tam*, the Federal Circuit ruled that the USPTO correctly labeled FUCT as an established scandalous word, but further ruled that the immoral or scandalous provision violated a trademark applicant's right to free speech.⁴⁹ The court concluded that language in the form of trademarks should be considered private speech, not government speech, and be subject to First Amendment analysis.⁵⁰ Consequently, under this type of analysis, the court found that the provision was unconstitutional.⁵¹ Importantly, the court also expressed concerns over the provision's wide scope and its ability to cast a net that is far more extensive than necessary to serve any government interest.⁵²

On appeal in 2019, a unanimous Supreme Court held that the Lanham Act's prohibition on the registration of immoral trademarks infringes on First Amendment rights.⁵³ Further, in a 6-3 decision in favor of Brunetti, the Court held that the Lanham Act's prohibition on the registration of scandalous marks also infringes on First Amendment rights.⁵⁴ The majority concluded that the USPTO has refused to register marks expressing an immoral or scandalous viewpoint on, among other things, drug use, religion, and terrorism,⁵⁵ while also approving the registration of marks expressing more accepted views on the same topics.⁵⁶ While the Court certainly does not expect the government to promote or advance any extreme ideas, a law disfavoring "ideas that offend" discriminates based on viewpoint and is in violation of the First

⁴⁵ *In re Brunetti*, 877 F.3d 1330, 1337 (Fed. Cir. 2017).

⁴⁶ *Id.* at 1337–38.

⁴⁷ *Id.* at 1337.

⁴⁸ *Id.*

⁴⁹ *Id.* at 1335.

⁵⁰ *Id.* at 1340.

⁵¹ *Id.* at 1341.

⁵² *See id.* at 1350, 1353.

⁵³ *See Iancu v. Brunetti*, 139 S. Ct. 2294 (2019).

⁵⁴ *See id.*

⁵⁵ *Id.* at 2300–01.

⁵⁶ *Id.*

Amendment's Free Speech clause.⁵⁷ Justice Kagan, writing for the majority, particularly found issue with the breadth of the provision, stating that “[t]here are a great many immoral and scandalous ideas in the world,” and the immoral or scandalous provision “cover[ed] them all.”⁵⁸

In *Brunetti*, the government argued that the provision should be read more narrowly, and that only “marks that are offensive [or] shocking to a substantial segment of the public because of their *mode* of expression, independent of any views that they may express” should be barred.⁵⁹ Essentially, this would limit the USPTO to only refuse marks that are “vulgar”—meaning “lewd,” “sexually explicit or profane.”⁶⁰ This is an important distinction from how the current provision reads, as this new interpretation would not turn on viewpoint, and could not be struck down on the grounds of viewpoint discrimination.⁶¹ The majority explained that they could not accept the government’s proposal, as the statute’s text says something markedly different, but at the same time, the majority did not shut the door on such an interpretation, suggesting that if Congress chooses to act, the immoral or scandalous provision can be revived.⁶²

Three justices, Chief Justice Roberts, Justice Breyer, and Justice Sotomayor, each dissented in part in regard to the registration of scandalous trademarks.⁶³ All three felt that the “scandalous” interpretation was not as broad as the majority seemed to make it, and that the USPTO would not be discriminating on the basis of viewpoint under this particular clause.⁶⁴

In a particularly influential dissent, Justice Sotomayor expressed concern that *Brunetti* could lead to an onslaught of new scandalous trademark applications.⁶⁵ Further, Justice Sotomayor seemed to agree with the government and advocated for a narrow construction for the word “scandalous,” interpreting it to regulate “only obscenity, vulgarity, and profanity,” thus saving the provision from unconstitutionality.⁶⁶ This narrow interpretation would create a viewpoint-neutral form of content discrimination, as restrictions

⁵⁷ *Id.* at 2301.

⁵⁸ *Id.* at 2302.

⁵⁹ *Id.* at 2301.

⁶⁰ *Id.*

⁶¹ *Id.*

⁶² *Id.*

⁶³ *See id.* at 2303–04 (Roberts, C.J., dissenting); *Id.* at 2304–08 (Breyer, J., dissenting); *Id.* at 2308–18 (Sotomayor, J., dissenting).

⁶⁴ *See id.* at 2303–04 (Roberts, C.J., dissenting); *Id.* at 2304–08 (Breyer, J., dissenting); *Id.* at 2308–18 (Sotomayor, J., dissenting).

⁶⁵ *Id.* at 2308, 2318 (Sotomayor, J., dissenting).

⁶⁶ *Id.* at 2308 (Sotomayor, J., dissenting).

on particular “modes of expression” do not inherently qualify as viewpoint discrimination.⁶⁷ These “modes of expression” are not by nature examples of “government target[ing] . . . particular views taken by speakers on a subject,” and therefore, should pass scrutiny.⁶⁸ Ultimately, Justice Sotomayor not only advocated for the idea of prohibiting scandalous marks from registration, but also provided Congress with a roadmap on how they could shape a newly constructed provision.

3. Aftermath of *Brunetti*

After the *Tam* and *Brunetti* decisions, it may seem as though the prohibitions on disparaging, immoral, and scandalous marks may have met the same fate, but this is far from the case. While it appears the days ahead for any exclusions on disparaging marks are gloomy, the immoral and scandalous prohibitions still have life. Between Justice Sotomayor’s dissent and the *Brunetti* majority failing to close the door on a narrowly crafted provision, the ball is now in Congress’s court to create a provision that passes potential First Amendment critique. After *Brunetti*, it is clear the heart of the issue lies with the “immoral” provision,⁶⁹ but as Justice Sotomayor suggested, a “scandalous” provision can be crafted to avoid unconstitutionality.

As a result, this article proposes a provision that will slightly narrow the scandalous half of the old provision and try to merely salvage all that is possible from the immoral half. First, though, there are important First Amendment concepts that must be analyzed and scrutinized.

III. THE FIRST AMENDMENT AND REGULATED SPEECH

A. *The Free Speech Clause*

The Free Speech Clause of the First Amendment reads: “Congress shall make no law . . . abridging the freedom of speech, or of the press.”⁷⁰ This amendment was undoubtedly a reaction against the suppression of speech and press that existed in English society, but beyond this, there is little to no indication of what exactly the framers intended to achieve with this provision.⁷¹ This has left Americans to debate for centuries over the meaning behind the Free

⁶⁷ *Id.* at 2309 (Sotomayor, J., dissenting).

⁶⁸ *Id.* at 2313 (Sotomayor, J., dissenting).

⁶⁹ This is clear, as all nine justices felt that the immoral provision was invalid, while only six justices believed that the scandalous provision was invalid. *See generally id.*

⁷⁰ U.S. Const. amend. I.

⁷¹ Rodney A. Smolla, Smolla and Nimmer on Freedom of Speech 1–18 (1996).

Speech Clause.⁷² For example, the clause could be read with an absolutist lens, under which the First Amendment puts a complete stranglehold on Congress and prohibits virtually any law abridging the freedom of speech.⁷³ However, the Supreme Court has generally rejected this view.⁷⁴

On the other hand, critics of the absolutist view commonly promote a more practical balancing approach, which argues that courts should weigh the competing social and individual interests in unregulated speech against legitimate social and individual interests in protecting against certain speech.⁷⁵ For example, First Amendment scholar Jud Campbell suggests that the founders thought that the First Amendment's Free Speech Clause required Congress to restrict speech and the press "only in the promotion of public good," and that the First Amendment stood for a general principle that left plenty of room for debate as to how it should be applied in practice.⁷⁶ This view, rather than the absolutist view, more closely reflects reality, as it has been up to the courts to decide what speech can be regulated by the government.⁷⁷ Predictably, this has led to plenty of line drawing and judicially created categories of so-called "protected" and "unprotected" speech, the latter falling outside of the First Amendment's protection.

As *Brunetti* points out, the Court has often held that viewpoint discrimination, the notion that the government cannot regulate speech based on the ideas or opinions it conveys, is at the core of the First Amendment.⁷⁸ For example, with regard to the immoral or scandalous provision, if the Lanham Act permits registration of trademarks that promote society's sense of morality, or marks that are neither immoral nor scandalous, then it must also permit the registration of trademarks that promote the opposing viewpoint.⁷⁹

⁷² See Jud Campbell, *What did the First Amendment originally mean?*, Richmond Law (July 9, 2018), <https://lawmagazine.richmond.edu/features/article/-/15500/what-did-the-first-amendment-originally-mean.html>.

⁷³ This absolutist view was famously used by Justices Black and Douglas. See *Konigsberg v. State Bar of Cal.*, 366 U.S. 36, 56 (1961) (Black, J., dissenting); See *Braden v. United States*, 365 U.S. 431, 441 (1961) (Black, J., dissenting); *Wilkinson v. United States*, 365 U.S. 399, 423 (1961) (Black, J., dissenting); *Uphaus v. Wyman*, 364 U.S. 388, 392 (1960) (Black, J., dissenting); *Barenblatt v. United States*, 360 U.S. 109, 140 (1959) (Black, J., dissenting). For Justice Douglas's position, see *New York Times Co. v. United States*, 403 U.S. 713, 720 (1971) (Douglas, J., concurring); *Roth v. United States*, 354 U.S. 476, 508 (1957) (Douglas, J., dissenting); *Brandenburg v. Ohio*, 395 U.S. 444, 450 (1969) (Douglas, J., concurring).

⁷⁴ See, e.g., *Konigsberg*, 366 U.S. at 49.

⁷⁵ John R. Vile, *Ad Hoc Balancing*, First Amendment Encyclopedia (2009), <https://mtsu.edu/first-amendment/article/888/ad-hoc-balancing>.

⁷⁶ Campbell, *supra* note 72.

⁷⁷ *Id.*

⁷⁸ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2299 (2019).

⁷⁹ *Id.*

Put differently, the immoral or scandalous provision distinguishes between opposite sets of trademarks: “those aligned with conventional moral standards and those hostile to them; those inducing societal nods of approval and those provoking offense and condemnation.”⁸⁰ As such, the Lanham Act allows for the former, but disfavors the latter, displaying blatant viewpoint bias and violating the First Amendment.⁸¹

B. First Amendment Exceptions

However, even in the context of viewpoint discrimination, the Supreme Court has drawn lines and created above-mentioned categories of unprotected speech, falling outside of the Free Speech Clause and granting the government more freedom to regulate speech. In other words, if the government seems to regulate viewpoint-based speech, as is the case with the immoral or scandalous provision, the next step is to determine whether that speech fits into some narrow juridically created category of unprotected speech.⁸² It is important to note, though, that these categories are not determinative of whether a government regulation is constitutional or not, but rather signal that the government generally has more leeway to regulate speech based on its content.⁸³

Types of speech particularly relevant to trademarks that should be examined for their fit within categories of unprotected speech are: (1) obscenity, (2) profanity, (3) drug use, and (4) terroristic speech. These have all frequently fallen within the immoral or scandalous provision’s grasp in the past, so an investigation into each is worthwhile in constructing a new constitutionally sound provision. As Justice Sotomayor pointed out in *Brunetti*, obscenity and profanity fall under the definition of “scandalous” and do not necessarily turn on viewpoint.⁸⁴ On the other hand, drug use and terrorism fall under the “immoral” heading and are more likely to turn on viewpoint. Nonetheless, drug use and terrorism are both explicitly mentioned in *Brunetti* as problematic,⁸⁵ so if a new provision is to be doctored, they must also undergo an investigation.

⁸⁰ *Id.* at 2296.

⁸¹ *Id.* at 2300.

⁸² *See* United States v. Stevens, 559 U.S. 460, 470 (2010) (discussing the “historically unprotected categories of speech”).

⁸³ *R.A.V. v. City of St. Paul*, 505 U.S. 377, 383–84 (1992).

⁸⁴ *Brunetti*, 139 S. Ct. at 2308, 2318 (Sotomayor, J., dissenting).

⁸⁵ *See id.* at 2300.

1. Obscenity

The Supreme Court has held that “obscenity” is a category of speech that is unprotected by the First Amendment but has generally struggled to define what is “obscene.” The Court seemed to “solve” this problem in *Miller v. California*, when it set out three guiding considerations for determining whether speech is obscene: (1) whether the average person, applying contemporary community standards would find that the work, taken as a whole, appeals to a prurient interest; (2) whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law, and (3) whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value.⁸⁶

On its face, the *Miller* standard may not seem like it would fit well as a USPTO trademark regulation. For one, the first two prongs of the *Miller* test are held to the standards of the community, while the third prong is held to what is reasonable to a person in the country as a whole.⁸⁷ One reason the Court may have added the last prong is to serve as a check on the first two prongs, protecting speech that may be considered obscene to a specific community, but on a national level might provide positive value. In the case of trademarks, though, a national standard is really the only relevant standard. While it is true that some trademarks are used only in certain regions, registering a mark with the USPTO gives a trademark owner *national* protection. Thus, the USPTO should be thinking of a mark’s national impact rather than its impact on any certain community.

Second, the third prong specifically makes an exception for works that hold serious “literary, artistic, political, or scientific” value.⁸⁸ This should not be relevant to trademarks, as trademarks are meant to simply identify and distinguish goods or services and do not concern artistic or political value. Ultimately, while the *Miller* test may not be the perfect fit for trademarks, it provides a workable framework that can be utilized in creating a new immoral or scandalous provision, set forth in Part III.⁸⁹

2. Profanity

Even though profanity and obscenity are distinct categories of speech, the government has often regulated and punished them in a similar manner.⁹⁰ However, the Supreme Court has held that profanity is generally protected by the First Amendment’s Free

⁸⁶ See *Miller v. California*, 413 U.S. 15, 24 (1973).

⁸⁷ *Id.* at 25.

⁸⁸ *Id.* at 24.

⁸⁹ See Part III.

⁹⁰ See *Cohen v. California*, 403 U.S. 15 (1971).

Speech Clause.⁹¹ Still, there remain some notable exceptions. The Court has adopted a medium-by-medium approach, analyzing profane speech over broadcast media, over Internet, and over cable TV separately.⁹²

With regard to broadcast media, the Court held in *FCC v. Pacifica Foundation* that broadcasting has less First Amendment protection than other forms of communication because of its pervasive nature.⁹³ The Court recognized that the government has strong interests in protecting children from “patently offensive” speech and in safeguarding the privacy of one’s home from this speech.⁹⁴ These two concerns, the Court said, were sufficient to “justify special treatment of indecent broadcasting.”⁹⁵ Lastly, the Court in *Pacifica* reasoned that radio and television stations have a long history of government regulation and limited First Amendment protection.⁹⁶

Reaching the opposite conclusion with respect to the Internet, the Court held in *Reno v. ACLU* that it is unconstitutional to regulate profane speech over the Internet.⁹⁷ This is justifiable, as the legitimate government interests set out in *Pacifica* are simply not present in the Internet medium. For example, the Internet is not invasive into the home like broadcast media, and the need to shield children is decreased.⁹⁸ Moreover, there was no history of the government regulating the Internet.⁹⁹ Accordingly, profane speech in broadcast media and profane speech over the Internet are treated differently, and while trademarks differ from broadcast media and the Internet in significant ways, they can be compared to each in deciding which line of thought to follow.

To start, as previously stated, the purpose behind trademarks is to identify goods or services and to distinguish these goods or services from someone else’s. In reality, they are used as a promotional tool just as much as they are used to avert potential consumer confusion. Naturally then, a trademark owner wants his or her mark to be seen and will spend money to ensure the mark is in the public eye. When it comes to profanity, this suggests that

⁹¹ See David L. Judson Jr., *Profanity*, First Amendment Encyclopedia, <https://www.mtsu.edu/first-amendment/article/1143/profanity> (last updated Aug. 2017).

⁹² See, e.g., *Federal Communications Commission v. Pacifica*, 438 U.S. 726 (1978) (analyzing profanity in the broadcast media context); *Reno v. American Civil Liberties Union*, 521 U.S. 844 (1997) (analyzing profanity in the Internet context).

⁹³ *Pacifica*, 438 U.S. 726.

⁹⁴ See *id.* at 748–51.

⁹⁵ *Id.*

⁹⁶ *Id.*

⁹⁷ *Reno*, 521 U.S. 844.

⁹⁸ *Id.*

⁹⁹ *Id.*

trademarks are inherently invasive and should be treated in a similar manner as broadcast media, rather than the Internet. Additionally, like broadcast media, there is a long-standing history of government regulations on trademarks.¹⁰⁰ Congress first enacted a federal trademark regime in 1870, adjusting and updating it numerous times since then,¹⁰¹ including in 1946 when Congress passed the Lanham Act.¹⁰² Further, state law adds its own protections to marks in addition to federal law.¹⁰³ As such, long-standing regulation of trademarks also suggests that the Court should treat them in a similar manner as broadcast media when it comes to profanity. That is, the government's interest should be weighed against the Free Speech Clause, as in *Pacifica*.¹⁰⁴

3. Terrorism

In *Brunetti*, there is explicit mention of the USPTO's inconsistencies in granting registration for trademarks that display a "moral" view on terrorism, while denying registration to trademarks that endorse the opposite.¹⁰⁵ While this is understandable, the Court has made clear that "a law 'disfavoring ideas that offend' discriminates based on viewpoint, in violation of the First Amendment."¹⁰⁶ For marks that reference terrorism, the most applicable area of free speech jurisprudence may be speech that advocates for illegal action,¹⁰⁷ and the most relevant case in this area is *Brandenburg v. Ohio*.¹⁰⁸

In *Brandenburg*, a KKK leader gave a speech at a rally and said that "it's possible that there might have to be some revengeance [sic] taken."¹⁰⁹ This KKK leader was convicted under the Ohio Criminal Syndicalism Act for advocating for violent actions and for assembling a group of people to carry out these actions.¹¹⁰ On appeal, the KKK leader challenged the act's validity on First Amendment free speech grounds.¹¹¹ To determine if the government may prohibit speech advocating for the use of violence, the Supreme

¹⁰⁰ See Abdel-khalik, *supra* note 13.

¹⁰¹ *Id.*

¹⁰² *Id.*

¹⁰³ See, e.g., 54 Pa. Cons. Stat. §§ 1101–1126 (2020).

¹⁰⁴ See *Federal Communications Commission v. Pacifica*, 438 U.S. 726 (1978).

¹⁰⁵ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2300 (2019).

¹⁰⁶ *Id.*

¹⁰⁷ See *Brandenburg v. Ohio*, 395 U.S. 444 (1969).

¹⁰⁸ See *id.*

¹⁰⁹ *Id.* at 446.

¹¹⁰ *Id.* at 444–45.

¹¹¹ *Id.* at 445.

Court established a two-prong test.¹¹² If the speech (1) is “directed to inciting or producing imminent lawless action,” and (2) is “likely to incite or produce such action,” then the speech is not protected by the First Amendment.¹¹³

Admittedly, no trademark is likely to pass this test because no trademark calls for “imminent lawless action,” as required by the first prong. However, in the context of terroristic speech, it is reasonable and arguably necessary that the government use *proactive* regulation to prevent terroristic messages from coming to fruition. If the imminence standard is required to regulate terroristic speech, it creates room for danger because such a standard relies on a *retroactive* approach and sets a high burden to meet.¹¹⁴ In other words, a tragic event may already occur before terroristic speech can be attacked.¹¹⁵ Therefore, prong one of the *Brandenburg* test does not fit squarely in the terroristic trademark context.

On the contrary, a more proactive approach would be a “substantial likelihood” standard, similar to the one seen in prong two of the *Brandenburg* test. A substantial likelihood approach means that, not only is the threat of harm possible, but the speaker must be likely to achieve his or her goal of promoting harm without government intervention.¹¹⁶ This would work perfectly in the trademark context, as it would allow the USPTO to regulate terroristic marks during the registration process before violence occurs. If nothing else, it creates a useable template for the new provision proposed in Part III.¹¹⁷

4. Drug Use

In *Brunetti*, there is also explicit mention of the USPTO’s inconsistencies in granting registration for trademarks involving drug use.¹¹⁸ While taking a stance on drugs seems to be at the heart of viewpoint discrimination, speech that reasonably encourages illegal drug use has been identified by the Supreme Court as a category of unprotected speech.¹¹⁹

¹¹² *Id.*

¹¹³ *Id.*

¹¹⁴ Zachary Leibowitz, *Terror on Your Timeline: Criminalizing Terrorist Incitement on Social media Through Doctrinal Shift*, 86 *Fordham L. Rev.* 795, 821–22 (2017).

¹¹⁵ *Id.*

¹¹⁶ *Id.* at 822.

¹¹⁷ *See* Part III.

¹¹⁸ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2300 (2019).

¹¹⁹ *See Morse v. Frederick*, 551 U.S. 393 (2007).

In *Morse v. Frederick*, a high school student displayed a banner with the message “Bong Hits 4 Jesus.”¹²⁰ His school principal proceeded to confiscate the banner and suspended the student.¹²¹ The student challenged the suspension and claimed that the principal violated his First Amendment free speech rights.¹²² The Supreme Court held that the suspension did not violate the First Amendment, and punishment for speech on school grounds is appropriate only if such speech will substantially interfere with the work of the school.¹²³ The Court justified its holding by explaining that schools have a compelling interest in preventing illegal drug use among young students.¹²⁴ The breadth of the *Morse* holding has been debated, but it is generally believed that *Morse* is very narrow and applies only to student speech encouraging illegal drug use.¹²⁵

If *Morse* specifically applies to speech in a school setting, then its application to the trademark setting must be *extremely* narrow. Trademarks are meant to reach a wide audience, meaning that unless a trademark is meant to specifically target children and promote illegal drug use in a school setting, a rule like *Morse* likely cannot be applied, and trademarks involving drug use will likely remain protected.

IV. SAVING THE LANHAM ACT

A. A New Framework

In constructing a new immoral or scandalous provision, a couple of key initial considerations must be accounted for. First, as the Court pointed out in *Brunetti*, the old provision was far too broad and led to inconsistent grants of registration,¹²⁶ so a new provision must be sufficiently narrow and generate consistent results. Also, the Court was noticeably more open to the idea of a scandalous provision as opposed to an immoral provision, as the former is less likely than the latter to turn on viewpoint.

With these considerations in mind, a new provision should not be a single overarching, unitary provision as in the past—instead, there should be a clear line between the immoral provision and the scandalous provision. Further, there should be distinct categories within each of the immoral and scandalous provisions. Specifically, within the scandalous provision, there should be two categories:

¹²⁰ *Id.* at 397.

¹²¹ *Id.* at 398.

¹²² *Id.* at 399.

¹²³ *Id.* at 402.

¹²⁴ See Symposium: *Speech and the Public Schools After Morse v. Frederick: How Will Morse v. Frederick Be Applied?*, 12 Lewis & Clark L. Rev. 17 (2008).

¹²⁵ *Id.* at 21.

¹²⁶ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2300 (2019).

(a) obscenity and (b) profanity. These categories mirror the suggestions set forth by Justice Sotomayor in *Brunetti*.¹²⁷ Additionally, under the immoral provision, the categories should be even more narrow and unambiguously enumerated. For the purpose of this article, the categories (c) terrorism and (d) drug use will take focus, as these were two major categories focused on in the *Brunetti* decision.¹²⁸ It is worthwhile to note that these last two categories are certainly not the only categories that can fall under an immoral heading.¹²⁹ In fact, Congress can add as many categories as necessary. However, as explained by *Brunetti*, if Congress wants to prohibit the registration of immoral marks, Congress must be exceedingly narrow and specific in the marks considered to be problematic. So, if other “immoral” marks are to be barred, they should be added to the provision.

Moreover, to determine if a specific mark will fail under either the immoral or scandalous provisions, the USPTO should follow a two-part examination. The first part will ask in which provision—immoral or scandalous—and category the problematic trademark falls within. For example, a mark focused on marijuana falls under the immoral provision and under the “drug use” category. Next, the second part will entail applying a category-specific test to the trademark. These category-specific tests, set forth below, are modeled after previously established Supreme Court decisions introduced in Part III.¹³⁰

To summarize, the first prong of this proposed two-prong test puts the trademark in the appropriate bucket. This ensures that the provisions are not too broad and overreaching—if a trademark does not fall within an enumerated bucket, the immoral and scandalous provisions will not apply. Similarly, the second prong applies a bucket-specific Supreme Court–approved First Amendment analysis to the mark. This makes the new immoral or scandalous provision constitutionally sound, as decisions will no longer turn on viewpoint. Naturally, this will lead to more consistent results.

B. Category-Specific Tests

The provision’s first category addresses obscenity. The test for obscene marks should be as follows:

In deciding if a mark is obscene and unregistrable, a USPTO examiner should consider: (1) whether the average person, applying national standards, would find the mark obscene;

¹²⁷ *Id.* at 2308 (Sotomayor, J., dissenting).

¹²⁸ *Id.* at 2300.

¹²⁹ *Id.* (noting that religion, for example, can also fall under the immoral heading).

¹³⁰ *See* Part III.

and (2) whether the work depicts or describes, in a patently offensive way, sexual conduct.

The above language follows the test set forth in *Miller*.¹³¹ However, instead of *Miller*'s community standard, this test uses a national standard. This is important because trademark registration gives an owner national rights. Further, the third prong of the *Miller* test was not included, as trademarks should not concern themselves with "literary, artistic, political, or scientific value." This was not included because trademarks are meant to identify goods and services, not to serve as a standalone work of art.

The provision's second category addresses profanity. The test for profane marks should be as follows:

In deciding if a mark is especially profane and unregistrable, a USPTO examiner should consider: (1) if the content is "grossly offensive" language that is considered a public nuisance; and (2) the context and setting of the mark's use.

This test mirrors the standards set forth in *Pacifica* and in current FCC regulations.¹³² The first prong is simply the suggested definition of "profane" set forth by the FCC.¹³³ The *Pacifica* Court held that the government has a strong interest in protecting children from "patently offensive" speech and in safeguarding the privacy of one's home from this speech."¹³⁴ Thus, the second prong accounts for the context and setting of the mark's use. For example, if the mark is used in a way that makes it highly visible to children, it will likely be rejected. On the other hand, if the mark is for products used exclusively by adults or a mature audience, it will likely be granted registration and protection.

The provision's third category addresses terrorism. The test for marks that seem to have a terroristic message should be as follows:

In deciding if a mark reflects a terroristic message in an inappropriate manner, a USPTO examiner should consider: (1) If the speech is directed at producing lawless action; and (2) if the speech is substantially likely to produce such action if there is no government intervention.

This test follows the factors considered in *Brandenburg*. While the *Brandenburg* test included an "imminent" standard, as discussed in Part III, an imminence requirement creates room for danger, as it

¹³¹ See *Miller v. California*, 413 U.S. 15 (1973).

¹³² See *Federal Communications Commission v. Pacifica*, 438 U.S. 726 (1978); see also *Consumer Guide: Obscene, Indecent, and Profane Broadcasts*, FCC (2016), https://www.fcc.gov/sites/default/files/obscene_indecent_and_profane_broadcasts.pdf [hereinafter *Consumer Guide*].

¹³³ *Consumer Guide*, *supra* note 118.

¹³⁴ *Pacifica*, 438 U.S. at 748–51.

is mainly a retroactive approach.¹³⁵ To combat this issue, the test above includes a proactive “substantial likelihood” standard.

A few examples of proposed terroristic marks the Court included in *Brunetti* are: “WAR ON TERROR MEMORIAL,” “AL-QAEDA” on t-shirts, and “BABY AL QAEDA” on t-shirts.¹³⁶ Under the proposed standard, “WAR ON TERROR MEMORIAL” would be registrable, as this speech is not directed at lawless action, nor is it likely to produce such action. However, “AL-QAEDA,” the name of a well-known terror group and orchestrators of terroristic attacks that have killed thousands,¹³⁷ will likely be denied registration. Printing this mark on a t-shirt, for example, likely implies that the terror group is being promoted or endorsed, and given the group’s violent history, it is likely that promoting such a group will lead to increased violence. Finally, a mark like “BABY AL QAEDA,” which was denied registration under the old provision, will likely be granted registration under this proposed provision because the speech is not necessarily pointed at producing lawless action, as the word “baby” shows shades of parody or satire.

Overall, this new proposed provision is more narrowly tailored, and should lead to more consistent results. Only true terroristic speech, which is speech that is not afforded First Amendment protection, will be targeted.

The provision’s final category addresses drug use. This part will be exceedingly narrow and will apply to few mark applications. Nonetheless, it may be useful to include in a proposed immoral or scandalous provision for clarity. In deciding if a mark reflects a message that promotes drug use, a USPTO examiner should consider:

- (1) If a mark is specifically directed at promoting drug use;
- (2) if a mark is specifically directed at school-aged children;
- and (3) if the mark actually promotes drug use among school-aged children.

This standard follows the *Morse* opinion and is consistent with the compelling government interest in preventing illegal drug use among young students.¹³⁸

A few examples of proposed marks the Court included in the *Brunetti* are: “SAY NO TO DRUGS—REALITY IS THE BEST TRIP IN LIFE” and “MARIJUANA COLA” for beverages. Under this new standard, the first mark will obviously be granted registration because it does not promote drug use, even if it may target school-

¹³⁵ See Part III.

¹³⁶ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2300 (2019).

¹³⁷ *Al-Qaeda Terrorist Attacks by Number of Deaths from 1993 to 2010*, Statista (May 3, 2011), <https://www.statista.com/statistics/272757/al-qaeda-terrorist-attacks-by-death-toll/>.

¹³⁸ See *Morse v. Frederick*, 551 U.S. 393 (2007).

aged children. The second mark will also likely be granted registration because, even if it may seem to promote drug use, there is no clear indication that it is targeting school-aged children. However, an example of a mark that may be denied registration under this proposed provision is “SMOKE WEED” on a t-shirt line targeting young adults. This would meet all three prongs of the test and would be denied registration.

As a final note, the *Brunetti* opinion also explains that there have been a great number of inconsistencies in the USPTO granting marks about religion. Because freedom of religion is engrained in the First Amendment of the Constitution,¹³⁹ and there is no provision that could pass constitutional muster. Thus, all religious marks should be passed, assuming they pass other statutory requirements, of course.

V. CONCLUSION

All in all, it is imperative that the Lanham Act’s immoral or scandalous provision be revitalized in light of the *Brunetti* decision. If not, as the Justice Sotomayor predicts, there will be an influx of obscene, profane, and vulgar marks, among others, being registered with the USPTO and gaining prevalence in society. The Court left the ball in Congress’s court to act and create a narrow, consistent provision, and Congress must do just that. As this article points out, this proposed provision will carry out the purpose of the old provision, while still passing constitutional muster. In other words, the best of both worlds will be realized, as free speech rights are adhered to, while certain inappropriate trademarks are kept from the public eye.

¹³⁹ U.S. Const. amend. I.

BOOK REVIEW

*By Raffi Zerounian**

Likelihood of Confusion in Trademark Law. Richard L. Kirkpatrick. 2d ed. 2013 & Release No. 17 (Nov. 2021). Pp. 642. \$582. Practising Law Institute. 1177 Avenue of the Americas, New York, New York 10036.

“Likelihood of confusion” is the main focus of most Lanham Act violations. Given the centrality of this principle to U.S. trademark law, many trademark practitioners spend a significant amount of time thinking about whether one mark is likely to cause confusion with another. The determination of likelihood of confusion requires the application of facts to a pliable multifactor test that varies (mostly slightly) by circuit. But since factual patterns are rarely the same, and because analyzing likelihood of confusion requires an understanding of prospective consumers’ mental states, the body of case law on establishing likelihood of confusion is dense, complicated, and seemingly inconsistent, which makes determinations of likelihood of confusion all the more challenging.

The Second Edition of *Likelihood of Confusion in Trademark Law* provides clarity to the elusive multifactor likelihood-of-confusion test. The one-volume treatise, which was first published in 1995, has 642 pages of content divided into eight chapters followed by an appendix with illustrations from trade dress cases. The treatise’s second edition was published in May 2013 and is regularly updated, with a digital format that is included with Practising Law Institute’s PLI PLUS subscription.

The treatise stays true to its title. In the preamble, the author wrote that the “book is confined to what confusion law is” and it “does not propose what likelihood of confusion law *ought* to be.” This is accurate. Perhaps because the book was written by a trademark attorney, the book is intuitively organized for trademark practitioners, which is part of what makes it so useful. The treatise provides a logical analytical framework to determinations of likelihood of confusion and breaks up the test into digestible sections and subsections. The volume of citations to case authority throughout the book is impressive, and the selected quotes are organized in a user-friendly way, often in string citations in footnotes. The book succeeds in providing a practitioner-focused resource that will be of benefit to even the most experienced

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trademark practitioners who need to analyze likelihood of confusion in their practices.

While the book is a fantastic resource, it is not an exhaustive stand-alone treatise for all things related to liability under the Lanham Act. Rather, consistent with the treatise's title, the focus of the book—and the value that the treatise successfully offers its readers—is its deep analysis of likelihood of confusion in trademark law. Although the book will be a great resource for non-trademark practitioners or those new to the field, the treatise's nuanced and well-researched discussion of likelihood-of-confusion case law may be most beneficial to experienced practitioners who need easy access to hard-to-find legal authority to support their clients' positions.

The first chapter of *Likelihood of Confusion in Trademark Law* establishes the foundation of likelihood of consumer confusion and how that principle relates to trademark law and corollary causes of action, going through federal and state statutes as well as common law rights. The chapter provides an illuminating discussion of the different types of actionable confusion, including source confusion, sponsorship confusion, reverse confusion, and subliminal and associational confusion. The section also provides in-depth treatment of relevant considerations of how to prove likelihood of confusion, including a discussion of relevant consumers and time periods, as well as matters of proof, such as direct and indirect evidence, the quantum of likely consumer confusion, and lay and expert witnesses. The chapter also covers commonly raised questions such as the weight courts give to decisions by USPTO Examining Attorneys and the effects of foreign acts, prior inconsistent arguments, and which party is afforded the benefit of the doubt in the confusion analysis.

Chapter 2 provides an overview of the multifactor test employed by courts to determine the question of trademark infringement. This overview of the likelihood-of-confusion test used by each of the thirteen regional circuits includes other broad considerations regarding each circuit's approach to balancing the factors in the multifactor test. The section also offers a detailed analysis of the mechanics of and strategy for preliminary injunction and summary judgment motions.

The next six chapters each provide comprehensive treatment of a factor in the likelihood-of-confusion test. Each chapter goes into detail with a practitioner-focused discussion of the major relevant considerations for each factor with helpful string citations providing support for myriad legal propositions. Each part of the following chapters is organized in a manner that is logical and easy to navigate.

Chapter 3 covers the strength of the senior mark factor. This chapter includes a discussion of the various factors that are relevant for gauging the inherent and commercial strength of a mark. The

chapter also discusses the effect of third-party marks on the strength factor and in establishing trademark infringement and covers how such evidence is introduced into a case or proceeding. This chapter, which covers a factor that is often very important in trademark infringement disputes, is particularly beneficial to experienced trademark practitioners because it includes many helpful and easy-to-find citations to relevant authorities to support sophisticated arguments that often arise in a trademark enforcement or litigation context.

Chapter 4 provides an in-depth discussion of all relevant aspects of the similarity-of-marks factor. This section includes a number of lists of decisions in which marks were found to be similar or not similar organized in intuitive bulleted lists such as “Give Dominant Portions of Composite Marks Greater Weight,” “Common Portion Comparatively Strong, Dominant,” and “Common Portion Weak, Recessive.” The content in this section will be of benefit to practitioners looking for ready access to case law that has a balanced overview of the weight of the case authorities on the similarity of marks factor.

Chapter 5 covers the relatedness of the parties’ offerings and channels of trade. The discussion of the factor for relatedness of the parties’ goods or services is comprehensive and of interest to both the novice and experienced practitioner alike. Additionally, this section provides an in-depth treatment of the relevance of the parties’ respective channels of trade with up-to-date case law, keeping current with the authority that has evolved as technological development has affected how brands market and consumers purchase goods and services.

Chapter 6 discusses consumer sophistication and their degree of care. The author begins with a discussion of the relevant consuming public and the standard of care that must be applied. Next, the chapter provides a detailed and well-researched discussion of situations in which a lower degree of ordinary care may be exercised and then covers scenarios involving consumers who typically exercise a high degree of care.

Chapter 7 discusses actual confusion. This factor is often of great interest in litigation and enforcement contexts, yet the relevance of actual confusion evidence to establishing trademark infringement and whether an incident is likely to be considered actual confusion is often misunderstood. This chapter lays out the often conflicting approaches of courts to evidence of confusion with well-researched footnotes including pertinent authority regarding each legal principle. Again, the discussion is organized into easy-to-follow categories with clear headings that appropriately guide the reader to the relevant section.

Chapter 8 discusses the intent of the junior user. The chapter begins with an overview of this factor, which is different from the

other likelihood-of-confusion factors in that it is not readily ascertainable to potential consumers. This section discusses what constitutes wrongful intent, and then covers the weight given to what is most often circumstantial evidence of bad faith. The section also analyzes the disagreement among the circuits regarding whether an intent to confuse creates a rebuttable presumption or merely just an inference of likelihood of confusion. In its in-depth treatment of this factor, the treatise includes helpful bulleted lists with citations to authority succinctly describing the fact patterns that have supported findings of both good faith as well as bad faith.

Even for those practitioners who have access to other well-known trademark treatises like *McCarthy on Trademarks and Unfair Competition* or *Kane on Trademark Law: A Practitioner's Guide*, *Likelihood of Confusion in Trademark Law* is not superfluous. Rather, *Likelihood of Confusion in Trademark Law* is a practice-elevating resource that has deep and well-organized analysis and case law that would benefit even the most experienced practitioner who needs to analyze likelihood of confusion.

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