

NOTES

SELF-DISPARAGING TRADEMARKS AND SOCIAL CHANGE: FACTORING THE REAPPROPRIATION OF SLURS INTO SECTION 2(A) OF THE LANHAM ACT

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Section 2(a) of the Lanham Act bars the United States Patent and Trademark Office (PTO) from registering trademarks that “may disparage” a group of people. What happens, however, when an applicant seeking to register a trademark containing a slur is also a member of that disparaged group? Many applicants have applied to register such “self-disparaging” trademarks featuring arguably reappropriated slurs, from lesbians seeking to register DYKES ON BIKES, to an African American seeking to register NIGGA, to a Jew seeking to register THE BIG HEEB BREWING COMPANY. Under the current regime, applicants for these self-disparaging marks are treated identically to any other applicant. However, such an approach commits two serious errors: (1) It overlooks the important role that the reappropriation of slurs plays in disarming historically hateful speech and fostering a healthy self-identity; and (2) it ignores the fact that a self-disparaging mark’s mere existence automatically raises evidentiary doubts about whether that mark is truly disparaging to the referenced group. This Note argues that the PTO’s current approach to gauging whether a mark is disparaging does not adequately consider the special circumstances of self-disparaging marks, and proposes that examining attorneys should no longer be permitted to deny an application to register a trademark solely because the mark is self-disparaging.

INTRODUCTION

In July of 2003, the San Francisco Women’s Motorcycle Contingent applied to register the group’s more popular name, Dykes on Bikes, for federal trademark protection with the United States Patent and Trademark Office (PTO).¹ The application’s first stop, like that of all trademark applications, was the desk of an examining attorney,² whose job it is to confirm that marks meet the registration requirements set forth in the Lanham Act.³ After considering the application, however, examining attorney Sharon A. Meier refused to register the mark DYKES ON BIKES.⁴

1. Serial No. 78/281,746, filed July 31, 2003 (DYKES ON BIKES).

2. This Note uses the terms “examining attorney” and “examiner” interchangeably.

3. 15 U.S.C. § 1062(a) (2000) (“Upon the filing of an application . . . the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made . . .”).

4. Serial No. 78/281,746, Office Action Outgoing, Feb. 20, 2004.

Her reason: The word “dyke” is disparaging to lesbians,⁵ and under section 2(a) of the Lanham Act, the PTO cannot register any mark that “may disparage” a group of people or bring them into contempt or disrepute.⁶ Dykes on Bikes requested both a reexamination and a reconsideration of the application, but each time Meier held firm that DYKES ON BIKES disparages lesbians.⁷

At surface level, Meier’s repeated rejections of Dykes on Bikes’s application seem remarkably ordinary—both examiners and courts routinely evaluate whether a proposed trademark contains disparaging terms, thus failing to qualify for federal trademark protection. For example, the marks REDSKINS and REDSKINETTES as applied to football entertainment services,⁸ and MOONIES as applied to a doll that exposes its

5. *Id.* at 2 (“Registration is refused because the proposed mark consists of or comprises matter which may disparage or bring into contempt or disrepute to the lesbian, bisexual and transgender communities.”).

6. 15 U.S.C. § 1052(a) (barring federal registration of any trademark that “[c]onsists of or comprises . . . matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute”). This Note uses the term “disparaging” to refer to any mark which may disparage, bring into contempt, or bring into disrepute. See Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 *Trademark Rep.* 661, 740 (1993) (stating that “no decision has relied solely on the ‘contempt’ and ‘disrepute’ language of Section 2(a)” and suggesting that “the standard for determining contemptuous marks is coextensive with the standard for determining disparaging marks”).

7. See Serial No. 78/281,746, Office Action Outgoing at 2, Oct. 28, 2004 (“The fact that some of the disparaged party have embraced or appropriated the term DYKE, does not diminish the offensiveness of the term that has historically been considered offensive and derogatory.”); *id.*, Reconsideration Letter at 1, May 28, 2005 (finding nothing new that is “significant or compelling” to warrant reexamination).

Only after Dykes on Bikes mounted a public campaign criticizing the denials did the PTO finally reverse Meier’s earlier decisions, clearing the way for DYKES ON BIKES to receive federal trademark protection. See Press Release, Nat’l Ctr. for Lesbian Rights, Trademark Office Says Yes to “Dykes on Bikes” (Dec. 8, 2005), at <http://www.nclrights.org/releases/pr-dykesonbikes120805.htm> (on file with the *Columbia Law Review*) [hereinafter NCLR Press Release] (“[I]n a decision issued December 5, [2005,] the Trademark Office reversed itself and finally published the application.”); see also Julian Guthrie, Trademark Office OKs ‘Dykes on Bikes,’ *S.F. Chron.*, Dec. 9, 2005, at A2. Many commentators predicted such a reversal, either by the PTO or by the Trademark Trial and Appeal Board. See, e.g., The TTABlog, at <http://thettablog.blogspot.com/2005/07/ttablog-predicts-ttab-reversal-of.html> (July 21, 2005, 20:00 EST) (on file with the *Columbia Law Review*) (expecting “the TTAB to reverse this refusal to register because the PTO failed to establish a *prima facie* case that DYKES ON BIKES, when used in connection with Applicant’s services, would be considered disparaging by a substantial composite of the relevant community”).

8. See *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1708 (T.T.A.B. 1999) (quoting petitioners’ claim that term “redskins” is “‘a pejorative, derogatory, . . . disreputable, disparaging and racist designation for a Native American person’”), *rev’d* on other grounds, 284 F. Supp. 2d 96 (D.D.C. 2003).

buttocks,⁹ have been criticized as disparaging Native Americans and religious followers of the Unification Church, respectively.¹⁰ But in each of these examples, the applicant seeking trademark protection was not a member of the disparaged group; rather, the applicant was a nonmember, attaching a historic slur to a product targeted toward the general public. The applicants for DYKES ON BIKES, however, *are* members of the disparaged group—they are lesbians who use the mark in connection with products and services targeted toward the lesbian community.¹¹ Further, they openly embrace the label “dyke” as “a symbol of power and pride” to communicate strength and self-respect.¹² As Vick Germany, President of Dykes on Bikes, explains, “We self-identify as dykes on bikes.”¹³

DYKES ON BIKES is an example of a “self-disparaging” trademark. Such a mark contains a term that is usually considered to be a slur toward a particular group, yet the applicant is a member of that group, suggesting that the slur has lost its disparaging potency. The fact that a member of the traditionally disparaged group no longer finds the slur disparaging raises the question of whether an applicant’s identity should be considered in an evaluation of disparagement. For example, should a lesbian pride organization applying to register DYKES ON BIKES be treated identically to a college basketball team applying to register THE DALLAS DYKES as its team name?¹⁴

Under current PTO practice, examining attorneys take no notice of an applicant’s self-identity. This formal neutrality, however, has resulted

9. See *In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1653 (T.T.A.B. 1990) (noting examiner’s rejection of application because mark may “disparage[] The Unification Church founded by the Reverend Sun Myung Moon”).

10. In both decisions, the courts ultimately decided that the marks at issue were not disparaging.

11. See Serial No. 78/281,746, Trademark Application at 2, July 31, 2003 (describing Dykes on Bikes’s goods and services as “fostering pride in a wide variety of sexual orientations and identities, namely lesbian, bisexual and transgender”).

12. See *Dykes on Bikes*, at <http://www.dykesonbikes.org> (last visited Nov. 17, 2005) (on file with the *Columbia Law Review*).

13. Joe Garofoli, *Attorneys Find Dykes on Bikes Patently Offensive, Reject Name*, S.F. Chron., July 14, 2005, at A1; see also Guthrie, *supra* note 7 (quoting Germany as stating that “[t]he word dyke has been used to put us down, and we have taken that name and reclaimed it as a source of pride”).

14. Many scholars responded to the challenge to cancel federal registration for REDSKINS by posing hypothetical disparaging team names. See, e.g., Kimberly A. Pace, *The Washington Redskins Case and the Doctrine of Disparagement: How Politically Correct Must a Trademark Be?*, 22 Pepp. L. Rev. 7, 7 (1994) (“San Francisco Yellowmen” and “New York Niggers”); Ethan G. Zlotchew, “Scandalous” or “Disparaging”? *It Should Make a Difference in Opposition and Cancellations Actions: Views on the Lanham Act’s Section 2(a) Prohibitions Using the Example of Native American Symbolism in Athletics*, 22 Colum.-VLA J.L. & Arts 217, 217 (1998) (“Dallas Spics,” “New York Hymies,” and “Washington Blackskins”).

in inconsistent and contradictory evaluations of self-disparaging marks.¹⁵ For example, examiners have denied multiple applications to register marks containing the word “dyke” in reference to lesbians,¹⁶ yet in 2001 the PTO registered the mark TECHNODYKE¹⁷ as applied to a lesbian-oriented website. Further, from as early as 1994, examiners have approved applications for marks containing the word “queer” in reference to lesbians and gay men,¹⁸ yet in 2000 an examiner rejected an application to register the mark CLEARLY QUEER¹⁹ because “[t]he term ‘queer’ is a derogatory mark to gays or lesbians.”²⁰ This confusion goes well beyond marks addressing sexual orientation. In 2003, the PTO registered the mark HEEB,²¹ a variant of an anti-Semitic slur,²² for use as the name of a Jewish culture magazine, yet just two years later another examiner denied an application to register THE BIG HEEB BREWING

15. The PTO initially responded to the DYKES ON BIKES controversy by stating that PTO examiners merely “apply federal law.” Garofoli, *supra* note 13. Examiners’ individual determinations of how to apply federal law, however, demonstrate the unpredictable outcomes self-disparaging marks face.

16. Examples of denials of applications to register marks containing the word “dyke” as applied to lesbian-oriented goods or services include the following: Serial No. 76/627,653, filed Jan. 12, 2005 (DYKESINTHECITY); Serial No. 78/497,352, filed Oct. 9, 2004 (DYKEDOLLS); Serial No. 78/448,110, filed July 8, 2004 (VELVETPARK DYKE CULTURE IN BLOOM); Serial No. 76/434,481, filed July 24, 2002 (DYKE TV); Serial No. 75/121,779, filed June 11, 1996 (DYKE DISH).

17. Reg. No. 2,498,459 (2001); see also Serial No. 75/312,451, filed June 20, 1997 (DYKE WEAR) (approved for publication but abandoned before registered).

18. See, e.g., Reg. No. 2,985,912 (2005) (QUEER DUCK); Reg. No. 2,984,395 (2005) (QUEER SHOP); Reg. No. 2,905,014 (2004) (QUEER EYE FOR THE STRAIGHT GUY); Reg. No. 2,592,636 (2002) (QUEER AS FOLK); Reg. No. 1,828,351 (1994) (QUEER GEAR).

19. Serial No. 76/132,003, filed Sept. 19, 2000. The mark was later approved for publication but abandoned. *Id.*, Notice of Abandonment, May 22, 2003.

20. Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging*: Section 2(a) Trademark Law After *Lawrence v. Texas*, 9 Marq. Intell. Prop. L. Rev. 187, 223–24 & n.181 (2005) (quoting examiner’s rejection of CLEARLY QUEER and suggesting that other marks containing “queer” which were abandoned during registration process likely received initial denials based on disparagement). Similar confusion reigns over the word “fag.” Compare Reg. No. 2,997,761 (2005) (registering F■A■G FABULOUS AND GAY as applied to grooming products), with Serial No. 78/164,481, Office Action Outgoing at 1, Mar. 14, 2003 (rejecting FAG as applied to magazine title because “‘FAG’ is a derogatory term”).

21. Reg. No. 2,858,011 (2004). The editor justified the magazine’s name by stating that “[i]t’s similar to the way gays use the word ‘queer’ We’re reappropriating it, but with a twist of pride.” Peg Tyre, *Not the Holiest of Scripture*, Newsweek, Sept. 23, 2002, at 10 (internal quotation marks omitted).

22. See Merriam-Webster Online Dictionary, at <http://www.m-w.com/cgi-bin/dictionary?book=dictionary&va=Hebe> (last visited Nov. 1, 2005) (on file with the *Columbia Law Review*) (defining “hebe” as “short for Hebrew,” “usually offensive: Jew”).

COMPANY²³ because “the proposed mark consists of or comprises matter which may disparage.”²⁴

The need for a consistent policy for evaluating self-disparaging marks will only intensify as disparaged groups continue to disarm the power of epithets by actively transforming slurs into sources of pride. The reappropriation of slurs is a common source of empowerment among disparaged groups,²⁵ and such movements often spill into trademark registration applications.²⁶ Examples include:

- A 1995 application to register N.I.G.G.A. NATURALLY INTELLIGENT GOD GIFTED AFRICANS.²⁷

23. Serial No. 78/432,597, filed June 9, 2004.

24. *Id.*, Office Action Outgoing at 2, Jan. 19, 2005. The examiner cited the *Merriam-Webster Online Dictionary* definition to support her finding. *Id.* at 5. The examiner did not know that the applicant was Jewish, nor that the product was targeted toward Jewish customers. See E-mail from Nathan Arkush, Applicant, to author (Sept. 26, 2005) (on file with the *Columbia Law Review*).

25. Examples of the reappropriation of slurs are so common that it would be beyond the scope of this Note to address the sociology behind the phenomenon at length. Professor Adam D. Galinsky and his colleagues provide a concise explanation, using the word “queer” as an example:

Where “queer” had connoted undesirable abnormality, by the fact that it is used by the group to refer to itself, it comes to connote pride in the groups’ unique characteristics. Where before it referred to despised distinctiveness, it now refers to celebrated distinctiveness. Reappropriation allows the label’s seemingly stable meaning to be open to negotiation. In addition, the defiant act of reappropriation may attack the negative evaluations of the denoted group.

Adam D. Galinsky et al., *The Reappropriation of Stigmatizing Labels: Implications for Social Identity*, in *Identity Issues in Groups* (Jeffrey T. Polzer, ed.) 221, 231 (Research on Managing Groups and Teams, Series No. 5, 2003).

A few brief examples display the scope and depth of slur reappropriation. See, e.g., Randall Kennedy, *Nigger: The Strange Career of a Troublesome Word* 48 (2002) (stating that some African Americans “have added a positive meaning to *nigger*”); Ratna Kapur & Tayyab Mahmud, *Hegemony, Coercion, and Their Teeth-Gritting Harmony: A Commentary on Power, Culture, and Sexuality in Franco’s Spain*, 5 *Mich. J. Race & L.* 995, 1023 (2000) (“[W]ords intended to insult gay men and women, such as ‘fruit,’ ‘dyke,’ and ‘fag,’ have been appropriated by the gay community as words denoting pride, self-awareness, and self-acceptance.”); Michelangelo Signorile, *Op-Ed.*, *The Word ‘Queer’ Belongs in the Mainstream*, *Newsday* (N.Y.), Nov. 25, 2003, at A26 (discussing reappropriation of “queer”); Naeem Mohaiemen, *Rebirth of a Word, a Film, a Slur*, *AlterNet*, July 20, 2004, at <http://www.alternet.org/mediaculture/19281/> (on file with the *Columbia Law Review*) (describing how Pakistani teenagers in England are reappropriating slur “Paki” as “a symbol of an assertive brown community”). For further examples, see *infra* note 169.

26. See Jendi B. Reiter, *Redskins and Scarlet Letters: Why “Immoral” and “Scandalous” Trademarks Should Be Federally Registrable*, 6 *Fed. Cir. B.J.* 191, 207 (1996) (“[C]omplicating the task of any regulator of the moral content of trademarks is the tendency of disparaged groups to adopt the names and symbols which their detractors applied to them, thereby reclaiming control over the power to represent themselves and . . . implicitly asserting their ability to withstand and transcend insults.”).

27. Serial No. 75/002,364, filed Oct. 6, 1995. The application was ultimately abandoned.

- A 2000 application to register S.P.I.C. SPANISH PEOPLE IN CONTROL.²⁸
- A 2005 application by an African American to register NIGGA²⁹ for retail and entertainment services.
- A 2005 application by a Jewish woman to register BABY JAP³⁰ for a clothing line.³¹

And in addition to DYKES ON BIKES, examiners in 2005 considered or reconsidered applications for the marks DYKE TV³² as applied to lesbian-oriented television programming, DYKEDOLLS³³ as applied to a line of lesbian dolls, DYKESINTHECITY³⁴ as applied to clothing, VELVETPARK DYKE CULTURE IN BLOOM³⁵ as applied to a magazine addressing lesbian issues, MARRIAGE IS FOR FAGS³⁶ as applied to gay pride t-shirts, and F■A■G FABULOUS AND GAY³⁷ as applied to grooming products.

28. Serial No. 76/082,591, filed July 1, 2000. The application was ultimately abandoned.

29. Serial No. 76/639,548, filed May 25, 2005. The applicant was African American actor Damon Wayans. See *id.*, Trademark Application at 1, May 25, 2005. The examiner rejected the application, finding the mark to be both disparaging and scandalous. See *id.*, Office Action Outgoing at 2, Dec. 22, 2005 (“A substantial composite of African-Americans would find the term derogatory because the term is a slang equivalent of ‘nigger’ and is commonly used to denigrate African-Americans.”). The same applicant filed an earlier application to register NIGGA as applied to a clothing line. Serial No. 76/623,949, filed Dec. 10, 2004. The examiner denied the application to register NIGGA based only on the scandalous nature of the word “nigger,” but the examiner’s reasoning is actually consistent with disparagement. See *id.*, Office Action Outgoing at 1, July 24, 2005 (“NIGGA means nigger and is thus scandalous because it disparages African-Americans.”).

30. Serial No. 78/665,332, filed July 7, 2005. The application is currently under review.

31. The applicant’s use of the word “JAP” refers to the abbreviation for “Jewish American Princess.” See E-mail from Richard A. Catalina, Jr., Managing Att’y, Catalina & Associates, to author (Sept. 26, 2005) (on file with the *Columbia Law Review*). This usage of “JAP” has roots as a slur toward Jewish women. See Merriam-Webster Online Dictionary, at <http://www.m-w.com/cgi-bin/dictionary?book=dictionary&va=JAP> (last visited Nov. 1, 2005) (on file with the *Columbia Law Review*) (defining “JAP” as a “usually disparaging” term for “Jewish American Princess”).

32. Serial No. 76/434,481, Office Action Outgoing at 2, Jan. 27, 2005 (denying registration because mark “consists of or comprises matter which may disparage lesbians”).

33. Serial No. 78/497,352, Office Action Outgoing at 3, May 19, 2005 (denying registration because “the term ‘DYKE’ is a derogatory term used for homosexual women”).

34. Serial No. 76/627,653, Office Action Outgoing at 2, Aug. 19, 2005 (denying registration “because the proposed mark consists of or comprises matter which may disparage or bring into contempt or disrepute the lesbian, bisexual and transgender communities”).

35. Serial No. 78/448,110, Office Action Outgoing at 2, Aug. 18, 2005 (denying registration “because the proposed mark consists of or comprises matter which may disparage or bring into contempt or disrepute the lesbian, bisexual and transgender communities”).

36. Serial No. 78/547,365, Office Action Outgoing, Aug. 20, 2005 (denying application on procedural grounds, making no mention of whether “fag” is disparaging).

37. Reg. No. 2,997,761 (2005).

The PTO could only benefit from a just and consistent approach to evaluating these loaded labels.

Examiners' denials of these applications, though appealable, cost applicants money,³⁸ time,³⁹ and, most importantly, the power to construct their own identities.⁴⁰ Despite the government's intention to protect groups from disparagement, the targets "may suffer in the long run because they have surrendered the power to confront, survive, and transform these negative representations of themselves."⁴¹ The challenge, however, is fashioning "a workable rule"⁴²—a policy where examiners may refuse to register truly disparaging marks, as section 2(a) requires, without undermining the legitimate reappropriation of slurs.

This Note argues that examining attorneys should no longer have the power to deny an application to register a mark for federal trademark protection on the sole basis that the mark is self-disparaging. Such a policy would apply in circumstances where (1) the mark at issue contains what has traditionally been considered a slur that may disparage a particular group; and (2) the applicant is a member of the disparaged group.⁴³ This shift in PTO policy would not only result in increased consistency in examiners' evaluations of these marks, but would also respect a disparaged group's ability to control its identity. Further, under such a policy, members of the referenced group who believe a particular mark is disparaging would still have the ability to seek a reversal of registration.⁴⁴

38. See 15 U.S.C. § 1070 (2000) ("An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner . . . upon the payment of the prescribed fee."); see also *infra* note 223 and accompanying text (discussing legal costs of appealing denials).

39. See Garofoli, *supra* note 13 (describing registration process for Dykes on Bikes as "a humiliating two years slogging through the swampland of trademark law").

40. See Gibbons, *supra* note 20, at 246 ("[M]any formerly offensive terms have been re-signified so that they are neither immoral, scandalous, nor disparaging In this context, acts by the [PTO] to bar registration of such re-signified marks, rather than protecting the disenfranchised, merely places the U.S. government's imprimatur on their oppression."). Even if the public is not aware of a mark's registration status, the imprimatur still conveys a message to the applicant. See *infra* notes 64–66 and accompanying text.

41. Reiter, *supra* note 26, at 208; cf. Signorile, *supra* note 25 (criticizing New York's refusal to allow state trademark registration of QUEER AMERICA, stating that "[w]hile it's laudable that the state might want to protect gays from a slur[,] . . . the state is 10 years behind the culture").

42. The Trademark Blog, at http://schwimmerlegal.com/archives/2005/07/dykes_on_bikes.html (July 15, 2005, 15:34 EST) (on file with the *Columbia Law Review*) (arguing that Dykes on Bikes does not "intend to disparage lesbians and in the context in which this mark is encountered, the mark will not likely be perceived as disparaging. However, can this phenomenon . . . be reduced to a workable rule?").

43. See *infra* text accompanying notes 261–263 (discussing how to determine if applicant is member of disparaged group).

44. See *infra* text accompanying note 264 (discussing how members of disparaged group maintain right to initiate challenges to disparaging mark's registrability).

Part I begins by outlining the benefits of federal registration and the procedure for registering a trademark. This Part then describes the doctrine of disparagement and dissects the guidelines examining attorneys use to evaluate disparaging marks. Part II introduces the concept of self-disparaging marks and exposes the improper burdens they face under the current system of disparagement analysis. Finally, Part III argues that examiners should no longer be permitted to reject an application to register a mark solely on the basis that the mark is self-disparaging, and explains how a policy of pure deference for such marks might operate.⁴⁵

I. FEDERAL TRADEMARK REGISTRATION AND THE DOCTRINE OF DISPARAGEMENT

Registering trademarks for federal protection provides applicants with many valuable benefits; however, in order for applicants to avail themselves of these benefits, they must adhere to detailed procedural and substantive registration requirements, including that the mark not be disparaging.

Part I.A outlines the importance of federal trademark registration and the formal procedure for registering a mark. Part I.B then discusses the doctrine of disparagement, tracing its historic roots to its modern form.

A. *Fundamentals of Federal Trademark Registration*

Trademarks are words or symbols that individuals or companies use to “identify and distinguish” their goods from those manufactured or sold by others.⁴⁶ Trademarks primarily function as cognitive shortcuts, allowing consumers to make assumptions about a product’s source and quality based on the presence of a familiar mark.⁴⁷ Because consumers rely on trademarks as proxies for judgments of source and quality, producers place great value on the protection of their trademarks.⁴⁸

45. The purpose of this Note is not to argue that the rejection of Dykes on Bikes’s application should have been reversed on appeal (as it eventually was). Rather, this Note advocates a policy change in the PTO which would have prevented the examining attorney from rejecting the mark based on self-disparagement in the first place.

46. 15 U.S.C. § 1127 (2000) (“The term ‘trademark’ includes any word, name, symbol, or device, or any combination thereof . . . [used] to identify and distinguish [the user’s] goods . . . from those manufactured or sold by others and to indicate the source of the goods”); see also *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412 (1916) (“The primary and proper function of a trade-mark is to identify the origin or ownership of the article to which it is affixed.”).

47. See Jennifer A. Lee, *Comedy III Productions, Inc. v. New Line Cinema*, 16 Berkeley Tech. L.J. 183, 185 (2001) (“Trademarks serve as shortcuts in consumer culture by allowing consumers to make assumptions about the quality or source of goods and services represented by familiar marks.”).

48. See Lynda J. Oswald, *Challenging the Registration of Scandalous and Disparaging Marks Under the Lanham Act: Who Has Standing to Sue?*, 41 Am. Bus. L.J. 251, 256 (2004) (“Trademarks serve the important functions of identifying and differentiating products, indicating consistent source and quality, and facilitating advertising and sales.”).

The mere first use of a mark on a product in trade automatically entitles the user to certain protections under common law,⁴⁹ such as the right of exclusivity in the mark in the geographic region where it is used.⁵⁰ Nevertheless, many trademark holders still seek to register their trademarks with the PTO because federal registration offers many valuable benefits beyond those of common law. To qualify for federal registration, however, an applicant's trademark must meet certain substantive standards, including the requirement that the mark not be disparaging.⁵¹

Part I.A.1 begins by detailing the unique benefits that federal trademark registration offers beyond those of common law, thereby explaining why groups such as Dykes on Bikes seek to register their trademarks. Part I.A.2 then outlines the process of registering a trademark with the PTO, describing the stages trademark holders must survive to gain and keep these benefits.

1. *The Benefits of Federal Trademark Registration.* — Through Congress's enactment of the Lanham Act,⁵² registered trademark holders now have access to significant benefits unavailable under common law. Federal registration, for example, provides nationwide constructive no-

Their effectiveness in fulfilling these critical roles makes trademarks extremely valuable to marketers." (citation omitted)). For further discussion of the economic functions of trademarks, see William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & Econ. 265 (1987).

Many scholars assert that trademarks have a second function based on their expressive qualities. See, e.g., Malla Pollack, *Your Image Is My Image: When Advertising Dedicates Trademarks to the Public Domain—With an Example from the Trademark Counterfeiting Act of 1984*, 14 *Cardozo L. Rev.* 1391, 1393 (1993) ("Trademarks may become communicative symbols standing for something *besides* the source or sponsorship of the product . . ."). Under this theory, aside from providing information about a product's quality, a trademark has the power to shape, reflect, and comment upon social identities. See Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 *Notre Dame L. Rev.* 397, 397 (1990) (noting that trademarks "have become products in their own right, valued as indicators of the status, preferences, and aspirations of those who use them"); Gibbons, *supra* note 20, at 192–93 (arguing that "use of marks as communicative symbols of social identity are inadequately explained using only the law and economics approach").

49. See *Allard Enters., Inc. v. Advanced Programming Res., Inc.*, 249 F.3d 564, 572 (6th Cir. 2001) ("The first to use a mark in the sale of goods or services is the 'senior user' of the mark and gains common law rights . . ."). The Lanham Act codified these common law benefits for unregistered marks. See 15 U.S.C. § 1125(a)(1) ("Any person who . . . uses in commerce any word, term, name, symbol, or device . . . which . . . is likely to cause confusion . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.").

50. See *Tally-Ho, Inc. v. Coast Cmty. Coll. Dist.*, 889 F.2d 1018, 1023 (11th Cir. 1989) (explaining that under common law, "[t]he first to use a mark on a product or service in a particular geographic market, the senior user, acquires rights in the mark in that market").

51. 15 U.S.C. § 1052 ("No trademark . . . shall be refused registration . . . unless it . . . (a) [c]onsists of or comprises . . . matter which may disparage . . .").

52. Lanham Act, ch. 540, 60 Stat. 427 (1946) (codified as amended at 15 U.S.C. §§ 1051–1129).

tice of use and ownership of a particular mark.⁵³ The consequence of this constructive notice is that the registrant has exclusive rights to the mark across the entire United States, even in geographic locations where the registrant has no plans to expand;⁵⁴ a subsequent infringer cannot invoke the defenses of ignorance or good faith.⁵⁵ A corollary benefit is that a registrant can prevent a subsequent applicant from registering a similarly confusing mark.⁵⁶ Further, unlike common law, the Lanham Act allows a registrant to reserve federal protection for a mark that is not yet in actual use, provided that the registrant attests to a bona fide intent to use the mark.⁵⁷ Federal registration also provides automatic federal jurisdiction for infringement suits, regardless of the amount in controversy,⁵⁸ and successful plaintiffs in such suits may recover profits, costs, treble damages, and attorney fees.⁵⁹ Additionally, a federal registrant is entitled to stop the importation of any goods bearing an infringing mark.⁶⁰ Finally, registration constitutes prima facie evidence of the validity of the mark and the registrant's ownership of the mark.⁶¹ After the mark has been registered for five years, the validity of the registration becomes incontestable;⁶² that is, the mark's registration can no longer be challenged except in a limited set of circumstances—one of which is when a mark "may disparage."⁶³

In addition to these formal statutory benefits, federal registration may also provide intangible psychological benefits to a trademark holder through the government's implicit approval of the mark. Though courts generally refuse to acknowledge these benefits, contending that "the act of registration is not a government imprimatur" of the mark,⁶⁴ federal

53. 15 U.S.C. § 1072.

54. See *Dawn Donut Co. v. Hart's Food Stores, Inc.*, 267 F.2d 358, 362 (2d Cir. 1959) ("[T]he Lanham Act, 15 U.S.C.A. § 1072, provides that registration of a trademark on the principal register is constructive notice of the registrant's claim of ownership. Thus, . . . § 1072 affords nationwide protection to registered marks, regardless of the areas in which the registrant actually uses the mark.").

55. See *Champions Golf Club, Inc. v. The Champions Golf Club, Inc.*, 78 F.3d 1111, 1123 (6th Cir. 1996) ("After registration, there can be no new 'innocent' users, and even an innocent prior user cannot expand the area of its use . . ."); *Dawn Donut*, 267 F.2d at 362 (describing elimination of defenses of good faith and lack of knowledge).

56. 15 U.S.C. § 1114(1)(a).

57. *Id.* § 1051(b)(1).

58. *Id.* § 1121.

59. *Id.* § 1117.

60. *Id.* § 1125(b).

61. *Id.* §§ 1057(b), 1115(a).

62. *Id.* § 1065.

63. *Id.* § 1052(a); *id.* § 1064(3) (stating that petition to cancel mark may be filed "[a]t any time if the registered mark . . . was obtained . . . contrary to the provisions . . . of subsection (a) . . . of section 1052").

64. In re *Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1220 n.3 (T.T.A.B. 1993) ("[W]e have detected an undercurrent of concern that the issuance of a trademark registration for applicant's mark amounts to the awarding of the U.S. Government's 'imprimatur' to the mark. Such a notion is, of course, erroneous."); see also In re

registration of a trademark undeniably carries a message to the individual registrant.⁶⁵ For example, when Vick Germany, President of Dykes on Bikes, received the letter from the PTO initially rejecting her application, she said that “it felt like a hate letter.”⁶⁶ Germany’s reaction illustrates how federal registration does more than provide procedural protections; it can also communicate respect for the applicant’s self-identity.

2. *The Process of Federal Trademark Registration.* — The federal registration process begins when a “person”⁶⁷ files an application with the PTO to register a mark on the Principal Register.⁶⁸ The PTO then assigns an examining attorney for an *ex parte* examination of the application.⁶⁹ The examiner has two duties: (1) to conduct a procedural analysis, determining that the application satisfies the formal requirements of registration;⁷⁰ and (2) to conduct a substantive analysis of the proposed mark, scrutinizing the mark itself and determining whether it violates any of the Lanham Act’s substantive bars to registration.⁷¹ Examples of substantive deficiencies include if a mark “comprises immoral, deceptive, or scandalous matter” and if a mark “may disparage . . . persons, . . . institutions,

McGinley, 660 F.2d 481, 487 n.13 (C.C.P.A. 1981) (“Whether the PTO would be considered to have placed its imprimatur on the mark . . . is not relevant.”). Some commentators also discount the “imprimatur theory,” arguing that a denial of registration does not bar the applicant from using the mark. See, e.g., Jeffrey Lefstin, Note, Does the First Amendment Bar Cancellation of REDSKINS?, 52 *Stan. L. Rev.* 665, 684 (2000) (“[T]he ‘imprimatur’ theory requires that citizens understand trademark registration to connote government approval or sponsorship. Evidence for such understanding is not apparent.”). Such analysis, however, does not consider the registrant’s reaction to the denial of registration.

65. See *In re McGinley*, 206 U.S.P.Q. (BNA) 753, 756 (T.T.A.B. 1979) (“We recognize that denial of registration will not affect applicant’s continued use of his mark, but such use . . . will be visible only to those who share applicant’s interest and *will be without the implied approval* and the statutory benefits that would result from Federal registrations.” (emphasis added)).

66. Garofoli, *supra* note 13; see also NCLR Press Release, *supra* note 7 (quoting Shannon Minter, National Center for Lesbian Rights Legal Director, as saying, “We were outraged by the Trademark Office’s initial ruling, which was an insult to our community . . .”).

67. The Lanham Act defines “person” to include “a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.” 15 U.S.C. § 1127; see also Jerome Gilson & Anne Gilson LaLonde, U.S. Patent and Trademark Office, Trademark Manual of Examination Procedure § 803 (4th ed. 2005) [hereinafter T.M.E.P.] (detailing who may apply to register a trademark).

68. 15 U.S.C. § 1062(a). This Note limits its analysis to the registration of marks on the Principal Register and not the Supplemental Register. The Supplemental Register only comes into use when a particular mark has not yet developed sufficient secondary meaning necessary to receive federal trademark protection. See *id.* § 1091.

69. *Id.* § 1062(a).

70. Examples of such requirements include that the registrant properly filled out the application form, paid the fees, and provided a sample of the mark. See *id.* § 1051(a); see also T.M.E.P., *supra* note 67, §§ 801–818 (providing examiners with guidelines for evaluating whether application meets procedural requirements).

71. See T.M.E.P., *supra* note 67, §§ 1201–1217 (providing examiners with guidelines for evaluating whether application meets substantive requirements).

beliefs, or national symbols, or bring them into contempt, or disrepute.”⁷²

If, after a complete evaluation,⁷³ the examining attorney approves the application, then the PTO will provide notice of the mark’s pending registration by publishing the mark in the *Official Gazette*.⁷⁴ Barring any successful opposition to registration,⁷⁵ the mark will usually be registered within twelve weeks of publication⁷⁶ and appear on the Principal Register.⁷⁷ Alternatively, if the examining attorney decides that the mark is unregistrable, the examiner will send an initial rejection to the applicant explaining the reason(s) for rejection.⁷⁸ The applicant then has six months⁷⁹ to respond to the rejection with legal arguments and/or additional evidence,⁸⁰ and the examiner will reassess the application.⁸¹ If the examiner again rejects the application, the applicant will receive another letter of explanation and have six more months to respond.⁸² This back-and-forth parrying “continues until: (1) the applicant abandons the application; (2) the Examining Attorney [approves the application]; or (3) the application receives a final rejection.”⁸³ Upon receiving a final rejection,⁸⁴ the applicant may appeal the rejection

72. 15 U.S.C. § 1052(a).

73. T.M.E.P., supra note 67, § 704.01 (“The initial examination . . . should be a *complete* examination.”).

74. See 15 U.S.C. § 1062; 37 C.F.R. § 2.80 (2004).

75. See *infra* text accompanying note 87 (discussing third-party opposition to registration of mark).

76. Philip J. Greene, Trademark Counsel in the Federal Government—A Practitioner’s Perspective, 86 J. Pat. & Trademark Off. Soc’y 361, 380 (2004).

77. 37 C.F.R. § 2.46.

78. 15 U.S.C. § 1062(b); 37 C.F.R. § 2.61(a); see also T.M.E.P., supra note 67, § 704.01 (“If the application is not in condition to be approved for publication or issue, the examining attorney will write, call or e-mail the applicant, informing the applicant of the reason(s) why the mark may not be registered . . .”).

79. 15 U.S.C. § 1062(b); 37 C.F.R. § 2.62; see also T.M.E.P., supra note 67, § 711.

80. See 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 19:128 (4th ed. 2005) (stating that after receiving initial rejection, “the applicant will normally do one or both of two things: (1) file an amendment changing the application to avoid objections made by the Examiner; or (2) file a Response, setting forth a legal rebuttal to the objections raised by the examiner” (citation omitted)).

81. 15 U.S.C. § 1062(b). The examining attorney may, on reexamination, reject the application for a reason not raised in the prior rejection. T.M.E.P., supra note 67, § 706 (“If in the first Office action the examining attorney inadvertently failed to refuse registration on a clearly applicable ground[,] . . . the examining attorney must take appropriate action to correct the inadvertent error in a subsequent action.”).

82. The six-month response period applies after “*any* action by the examiner.” 37 C.F.R. § 2.62 (emphasis added).

83. Theodore H. Davis, Jr., Registration of Scandalous, Immoral, and Disparaging Matter Under Section 2(a) of the Lanham Act: Can One Man’s Vulgarity Be Another’s Registered Trademark?, 54 Ohio St. L.J. 331, 336 (1993).

84. See 37 C.F.R. § 2.64(a) (“On the first or any subsequent reexamination or reconsideration the refusal of the registration or the insistence upon a requirement may be stated to be final . . .”).

to the Trademark Trial and Appeal Board (TTAB),⁸⁵ and may appeal the TTAB's decision to United States Court of Appeals for the Federal Circuit.⁸⁶

Even if an examiner ultimately approves an application for federal registration, third parties may interfere with that mark's registration via an inter partes proceeding before the TTAB. After a mark is published in the *Official Gazette*, "[a]ny person who believes that he would be damaged by the registration" of the mark has thirty days to file an opposition with the PTO to challenge the registration of the mark.⁸⁷ Further, after a mark is placed on the Principal Register, third parties who believe they are or will be damaged by a mark's registration may petition the PTO to cancel the mark's registration.⁸⁸ While grounds to raise a petition for cancellation are subject to various limitations,⁸⁹ a third party with proper standing⁹⁰ may always petition for the cancellation of a mark on the basis that it is disparaging.⁹¹ Finally, the unsuccessful party of an inter partes proceeding may appeal the TTAB's decision to the Court of Appeals for the Federal Circuit.⁹²

B. Section 2(a) and the Doctrine of Disparagement

Section 2(a) of the Lanham Act bars the registration of, inter alia, "immoral . . . or scandalous matter; or matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute."⁹³ Though Congress did not lay out

85. 15 U.S.C. § 1070 ("An appeal may be taken to the [TTAB] from any final decision of the examiner . . ."). The applicant, in the interim, may also request a reconsideration. 37 C.F.R. § 2.64(b).

86. 15 U.S.C. § 1071(a). The applicant may alternatively seek de novo review by a federal district court. *Id.* § 1071(b).

87. *Id.* § 1063.

88. *Id.* § 1064; see also *Boswell v. Mavety Media Group Ltd.*, 52 U.S.P.Q.2d (BNA) 1600, 1604 (T.T.A.B. 1999) (finding opposer to be "damaged" when opposer is "a member of the group which is asserted to be disparaged").

89. See *supra* notes 62–63 and accompanying text (discussing incontestability of registered marks).

90. See 15 U.S.C. § 1069 ("In all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable may be considered and applied."); *Pro-Football, Inc. v. Harjo*, 415 F.3d 44, 47–50 (D.C. Cir. 2005) (discussing laches in context of inter partes proceeding over disparaging marks); Oswald, *supra* note 48, at 288–304 (discussing standing to challenge registrability of disparaging marks).

91. 15 U.S.C. § 1064(3) (stating that a petition to cancel a mark may be filed "[a]t any time if the registered mark . . . was obtained . . . contrary to the provisions . . . of [section 2(a)]").

92. *Id.* § 1071(a). A party may alternatively seek de novo review by a federal district court. *Id.* § 1071(b).

93. *Id.* § 1052(a). Many scholars criticize section 2(a) as an improper governmental regulation of speech that violates the First Amendment. See, e.g., Davis, *supra* note 83, at 345–47 (critiquing Court's refusal to consider applicants' purposes for expression or types of goods); Gibbons, *supra* note 20, at 231 ("[S]ection 2(a) violates the First Amendment rights of those who wish to use scandalous or immoral marks in the course of their commercial enterprises . . ."); Lefstin, *supra* note 64, at 677–79 (arguing that registration

an explicit justification for section 2(a),⁹⁴ many scholars have concluded that the driving rationales behind this provision are that “the government should not waste its resources on protecting unseemly marks”⁹⁵ and should not “provide its imprimatur to unseemly marks.”⁹⁶ A third possible rationale, uniquely relevant to disparagement law, is that the federal registration of a disparaging mark “is essentially a violation of one’s right of privacy—the right to be ‘let alone’ from contempt or ridicule.”⁹⁷ Despite, or perhaps because of, the many possible justifications for enacting section 2(a), the application of disparagement doctrine by examining attorneys has been murky at best.

Part I.B.1 investigates the definition of “disparage.” Next, Part I.B.2 explores the various tests used to determine whether a mark is “disparaging” under section 2(a). Part I.B.3 then discusses the evidence examiners may use in deciding whether a mark disparages a particular group. Finally, Part I.B.4 reveals how examiners, the TTAB, and courts routinely confuse disparagement with scandalousness, and exposes the repercussions of this confusion.

denial should undergo First Amendment scrutiny because of its “potential to drive particular forms of expression from the marketplace”). Nevertheless, courts repeatedly confirm that because a trademark holder may still use an unregistered mark, section 2(a) does not unlawfully suppress free expression. See, e.g., *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) (“[I]t is clear that the PTO’s refusal to register appellant’s mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant’s First Amendment rights would not be abridged by the refusal to register his mark.” (citation omitted)). The Federal Circuit recently reaffirmed this sentiment in *In re Boulevard Entertainment, Inc.*:

Previous decisions of this court and our predecessor court . . . have rejected First Amendment challenges to refusals to register marks under section [2(a)], holding that the refusal to register a mark does not proscribe any conduct or suppress any form of expression because it does not affect the applicant’s right to use the mark in question.

334 F.3d 1336, 1343 (Fed. Cir. 2003).

94. See Oswald, *supra* note 48, at 265 (“The legislative history of Section 2(a) is frustratingly silent as to why the Lanham Act denies registration to scandalous or disparaging matter.”).

95. Jack Achiezer Guggenheim, *The Indians’ Chief Problem: Chief Wahoo as State Sponsored Discrimination and a Disparaging Mark*, 46 *Clev. St. L. Rev.* 211, 229 (1998). Judges, too, have discerned this rationale in section 2(a). See, e.g., *In re McGinley*, 660 F.2d at 486 (“We do not see [the refusal to register such marks] as an attempt to legislate morality, but, rather, a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government.” (citation omitted)).

96. Guggenheim, *supra* note 95, at 229; see also Bruce C. Kelber, Comment, “Scalping the Redskins:” Can Trademark Law Start Athletic Teams Bearing Native American Nicknames and Images on the Road to Racial Reform?, 17 *Hamline L. Rev.* 533, 560–61 (1994) (“[T]he government has a substantial interest in prohibiting certain marks from carrying the implied approval of the federal government [and] does not want to encourage these marks by granting exclusive ownership.”); *supra* notes 64–66 and accompanying text (discussing imprimatur theory as applied to individual registrants). But see Reiter, *supra* note 26, at 199–200 (disputing basis of “‘implied imprimatur’ theory”).

97. *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1639 (T.T.A.B. 1988).

1. *Defining "Disparaging."* — Though section 2(a) forbids the registration of disparaging marks, the Lanham Act neglects to define the term "disparage."⁹⁸ The TTAB and courts initially solved this problem by ignoring it, appearing to apply a "we know it when we see it" standard.⁹⁹ For example, a 1951 court held that the mark DOUGH-BOY "obviously" disparaged American soldiers when placed on anti-venereal medication for condoms alongside a picture of a soldier, because "'Doughboy' is the name given to the American soldier in the first World War."¹⁰⁰ In 1969, the TTAB similarly declared, without citing support, that "[t]here can be no question" that a mark depicting a large red "X" superimposed upon a hammer and sickle disparaged the Communist Party.¹⁰¹

It was not until 1999 that the TTAB finally solidified a formal definition of "disparage" based on the "ordinary and common" definition of the word in 1946, the year Congress adopted the Lanham Act.¹⁰² Looking to definitions in contemporaneous dictionaries, the TTAB concluded that a mark "may disparage"¹⁰³ a person, belief, institution, or national symbol when it "may dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison."¹⁰⁴

2. *Determining Whether a Mark Is Disparaging.* — Though courts floundered for many years without formal guidelines for determining when a mark disparages,¹⁰⁵ judges and examining attorneys now have

98. See *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1221 n.4 (T.T.A.B. 1993) (noting existence of "little precedent on the meaning of 'disparage' in Section 2(a)").

99. Cf. *Jacobellis v. Ohio*, 378 U.S. 184, 197 (1964) (Stewart, J., concurring) (using similar standard for defining pornography).

100. *Doughboy Indus., Inc. v. Reese Chem. Co.*, 88 U.S.P.Q. (BNA) 227, 228 (P.T.O. 1951).

101. *In re Anti-Communist World Freedom Cong., Inc.*, 161 U.S.P.Q. (BNA) 304, 305 (T.T.A.B. 1969).

102. *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1738 (T.T.A.B. 1999), rev'd on other grounds, 284 F. Supp. 2d 96, 121–22 (D.D.C. 2003) (adopting TTAB's definition as correct).

103. The TTAB reasoned that the word "may" was included "to avoid an interpretation of this statutory provision that would require a showing of intent to disparage. Such a showing would be extremely difficult in all except the most egregious cases." *Id.*

104. *Id.* An earlier case also defined the term "disparage" by looking to dictionaries, but did not look to 1946 definitions. See *In re Hines*, 31 U.S.P.Q.2d (BNA) 1685, 1688 (T.T.A.B. 1994) (presenting definitions of "disparage," including "to lower in esteem or reputation; diminish the respect for; to speak slightly of: run down: depreciate" and "to speak of or treat slightly; depreciate; belittle; to bring reproach or discredit upon; lower the estimation of" (internal quotation marks and citations omitted)), rev'd on other grounds, 32 U.S.P.Q.2d (BNA) 1376 (T.T.A.B. 1994).

105. See 3 *McCarthy*, *supra* note 80, § 19:77.1 ("There is very little case law on what constitutes a mark that disparages a racial or ethnic group.").

guidance for evaluating disparagement thanks to a recent influential TTAB ruling. In *Harjo v. Pro-Football Inc.*, seven Native Americans sought to cancel the registration of the marks REDSKINS, REDSKINETTES, and THE WASHINGTON REDSKINS as applied to football entertainment services on the basis that “the word ‘redskin(s)’ ‘was and is a pejorative, derogatory, denigrating, offensive, scandalous, contemptuous, disreputable, disparaging and racist designation for a Native American person.’”¹⁰⁶

With *Harjo*, the TTAB provided the most complete procedural account to date of how to evaluate allegedly disparaging marks. Distinguishing the analysis of disparaging marks from that for scandalous marks, the TTAB held that “in deciding whether the matter may be disparaging, we look, not to American society as a whole . . . but to the views of the referenced group.”¹⁰⁷ Based upon this explicit adoption of a policy where a mark’s disparaging nature is gauged through the eyes of its alleged targets, the TTAB laid out a two-step test for determining whether a mark is disparaging: (1) Would the mark be understood, in its context, as referring to an identifiable group of people?; and (2) May that reference be perceived as disparaging to a “substantial composite”¹⁰⁸ of that group?¹⁰⁹

106. 50 U.S.P.Q.2d (BNA) at 1708.

107. *Id.* at 1739 (citing *In re Hines*, 31 U.S.P.Q.2d (BNA) at 1688) (“In determining whether or not a mark is disparaging, the perceptions of the general public are irrelevant. Rather, because the portion of Section 2(a) proscribing disparaging marks targets certain persons, institutions or beliefs, only the perceptions of those . . . implicated in some recognizable manner . . . are relevant to this determination.” (citation omitted)).

A separate test exists for circumstances when a mark “may disparage” an individual or a corporation. See *Order Sons of Italy in Am. v. Memphis Mafia Inc.*, 52 U.S.P.Q.2d (BNA) 1364, 1368 n.13 (T.T.A.B. 1999) (“[T]here are different tests for disparagement depending upon whether the party alleging disparagement is an individual or commercial corporate entity, or a non-commercial group, such as a religious or racial group.” (citations omitted)). The steps for determining whether a mark may disparage an individual or corporate entity are “(1) that the communication reasonably would be understood as referring to the plaintiff; and (2) that the communication is disparaging, that is, would be considered offensive or objectionable by a reasonable person of ordinary sensibilities.” *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1639 (T.T.A.B. 1988).

108. *Harjo*, 50 U.S.P.Q.2d (BNA) at 1739 (“The views of the referenced group are reasonably determined by the views of a substantial composite thereof.”). Though a “substantial composite” does not rise to the level of “majority,” courts have not yet arrived at a fixed percentage that constitutes a “substantial composite.” See, e.g., *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 133 n.32 (D.D.C. 2003) (finding that 36.6% of Native Americans did not constitute “substantial composite”); cf. *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981) (stating that “a substantial composite” is “not necessarily a majority”).

109. *Harjo*, 50 U.S.P.Q.2d (BNA) at 1740–41 (“[W]e ask, first: What is the meaning of the matter in question, as it appears in the marks and as those marks are used in connection with the services identified in the registrations? Second, we ask: Is this meaning one that may disparage [members of the target group]?”; see also *Order Sons of Italy*, 52 U.S.P.Q.2d (BNA) at 1368 (discussing two-part *Harjo* test).

Determining whether a mark implicates an identifiable group¹¹⁰ is inherently a case-specific¹¹¹ and context-specific¹¹² inquiry. In addition to the obvious step of looking to the dictionary definition of the allegedly disparaging term,¹¹³ examiners also consider (1) the relationship between the disparaging term and other elements of the mark; (2) the type of product upon which the mark appears; and (3) how the mark will appear in the marketplace.¹¹⁴ For example, the TTAB recently determined that one common dictionary definition of the word “mafia” is “a secret organization of Italian origin engaged in criminal activities”¹¹⁵ and that this definition is capable of disparaging Italian Americans in certain circumstances.¹¹⁶ However, the TTAB also determined that the use of “mafia” in the mark THE MEMPHIS MAFIA as applied to Elvis Presley-related entertainment services was not disparaging because there was no evidence that the word “mafia,” in this context, triggered an automatic, per se association with Italian Americans.¹¹⁷ For self-disparaging marks, the first prong is usually a nonissue; such marks will clearly refer to an identifiable group of people because successful reappropriation of a slur depends on viewers connecting the word to the group.¹¹⁸

110. Targets of disparagement are not limited only to certain preselected groups; rather, any mark that disparages “certain persons, institutions or beliefs” violates section 2(a). As the TTAB explained in *Harjo*:

[I]f the alleged disparagement is of a religious group or its iconography, the relevant group may be the members and clergy of that religion; if the alleged disparagement is of an academic institution, the relevant group may be the students, faculty, administration, and alumni; if the alleged disparagement is of a national symbol, the relevant group may be citizens of that country.

50 U.S.P.Q.2d (BNA) at 1739.

111. *Id.* (“Who comprises the targeted, or relevant, group must be determined on the basis of the facts in each case.”).

112. *Id.* at 1738 (“[T]he question of disparagement must be considered in relation to the goods or services identified by the mark in the context of the marketplace.”).

113. *Id.*

114. *Id.* at 1739.

115. *Order Sons of Italy in Am. v. Memphis Mafia Inc.*, 52 U.S.P.Q.2d (BNA) 1364, 1368 (T.T.A.B. 1999).

116. *Id.* at 1369.

117. *Id.*; see also *In re Mothers and Fathers Italian Ass’n.*, Serial No. 75/197,967, 2000 TTAB LEXIS 52, at *9–*10 (T.T.A.B. Feb. 11, 2000) (reversing examiner’s refusal to register “MAFIA BRAND” as applied to tomato sauces because word “mafia” does not per se disparage Italian Americans and because examiner did not provide sufficient evidence that substantial composite of Italian Americans would find “mafia” disparaging in mark’s context).

118. There can be exceptions—consider the mark BABY JAP. Serial No. 78/665,332, filed July 7, 2005. Though the applicant intended the mark to refer to “Jewish American Princess,” see *supra* note 31, the term “Jap” is also an anti-Japanese slur. See Merriam-Webster Online Dictionary, at <http://www.m-w.com/cgi-bin/dictionary?book=dictionary&va=JAP> (last visited Nov. 1, 2005) (on file with the *Columbia Law Review*) (defining “JAP” as a “usually disparaging” term for both “Jewish American Princess” and “Japanese”). See *infra* note 260 for further discussion of slurs with double meanings.

3. *Evidentiary Grounds That a Mark Is Disparaging.* — Once it has been established that the mark at issue refers to an identifiable group of people, the examining attorney must evaluate whether a substantial composite of people in that referenced group would view the use of the mark, in the context presented, as disparaging. In making this assessment, the PTO has a strong preference for erring on the side of publication.¹¹⁹ The TTAB first explained this policy in 1990 when it rejected an examiner's assertion that the mark MOONIES as applied to a doll that exposes its buttocks was not registrable because it may disparage religious followers of the Unification Church:

Because the guidelines [for determining whether a mark is disparaging] are somewhat vague and because the determination is so highly subjective, we are inclined to resolve doubts on the issue of whether a mark is . . . disparaging in favor of [the] applicant and pass the mark for publication with the knowledge that if a group does find the mark to be . . . disparaging, an opposition proceeding can be brought and a more complete record can be established.¹²⁰

Recognizing that a mark, once published, may then be challenged by a third party in an inter partes proceeding, both the TTAB and courts have repeatedly warned examining attorneys not to substitute their own personal judgments for those of potential challengers.¹²¹ Even if an examiner comes across some evidence that a mark may disparage, the intrinsic

119. Though the Lanham Act does not specify a standard of review for section 2(a) violations, courts and scholars now accept that an examiner must establish a prima facie case of disparagement. See, e.g., *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994) (“The PTO has the burden of proving that a trademark falls within a prohibition of [section 2(a)].”).

120. *In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654–55 (T.T.A.B. 1990). The Federal Circuit recently supported such action in a case involving a scandalous mark, stating:

[W]e have commended the practice of resolving the issue of whether a mark comprises scandalous matter by first permitting the mark to pass for publication, and then allowing interested members of a composite of the general public who consider the mark to be scandalous to bring opposition proceedings. By so doing, the PTO avoids the risk of pre-judging public attitudes toward a proposed registration based on ad hoc responses by government officials, while at the same time affording the affected public an opportunity to effectively participate in the question of whether the registration is proper.

Ritchie v. Simpson, 170 F.3d 1092, 1094 (Fed. Cir. 1999) (citations omitted).

121. See *In re Hines*, 32 U.S.P.Q.2d (BNA) 1376, 1377 (T.T.A.B. 1994) (reversing examiner's refusal to publish mark that allegedly disparaged Buddhists because PTO should “avoid interposing its own judgment for that of Buddhists”); Oswald, *supra* note 48, at 264 (“Where the registrability of a mark is at issue, the courts and [TTAB] prefer that the examiner publish the mark for opposition rather than deny registration during the examination process. Their concern is that the government not be in the position of censoring marks without public input.”); cf. *Ritchie*, 170 F.3d at 1094 (“This court has made it clear that the officials of the PTO may not readily assume, without more, that they know the views of a substantial composite of the public.”).

cally subjective and speculative nature of disparagement analysis instructs the examiner to publish the mark, so long as the examiner has doubts.¹²²

The specific evidence upon which an examining attorney may rely in rejecting a mark as disparaging is hazy¹²³—without the benefit of an actual member of the disparaged group coming forward to challenge the mark, an examiner’s assessment is akin to a prediction of how a particular group of people might conceivably react to the mark. The PTO suggests that examiners look to “dictionary definitions, newspaper articles and magazine articles.”¹²⁴ Supporting materials an applicant provides in response to an initial rejection, such as affidavits from members of the disparaged group,¹²⁵ public opinion surveys, and historical accounts,¹²⁶ may also be persuasive.

122. See *In re Hines*, 32 U.S.P.Q.2d (BNA) at 1376 (agreeing with applicant’s argument that mark should be published for opposition because evidence “raise[d] doubts as to whether applicant’s mark is disparaging”). Placing the burden on third parties to come forward and challenge the registration of a mark is not unreasonable, particularly considering that (1) the doctrine of incontestability does not cover disparaging marks, see *supra* notes 62–63 and accompanying text, and (2) third-party standing requirements are extremely low, see *Ritchie*, 170 F.3d at 1098 (suggesting that “an opposer [who] alleges that he possesses a trait or characteristic that is clearly and directly implicated by the proposed trademark” is sufficient to establish proper standing).

123. See Baird, *supra* note 6, at 774 (“[T]he quantity and quality of evidence required before an examining attorney may refuse a registration on Section 2(a) grounds is uncertain.”). Though the PTO does not offer guidance specific to disparagement, it does provide guidelines for determining whether a mark is scandalous, which may provide instruction. See *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1738 (T.T.A.B. 1999) (“In seeking guidance for determining . . . whether matter may be perceived as disparaging, we look to the limited precedent of the courts and the [TTAB] on the issue of disparagement, as well as to the previously enunciated precedent on the related issue of scandalousness.”), *rev’d on other grounds*, 284 F. Supp. 2d 96 (D.D.C. 2003).

124. T.M.E.P., *supra* note 67, § 1203.01. Dictionaries constitute the most common evidence in disparagement analysis. See Baird, *supra* note 6, at 779 (stating that dictionary evidence “often forms the basis for an examining attorney’s registration refusal under Section 2(a)”). Using dictionary definitions for disparagement analysis, however, is problematic because the group being disparaged may adopt definitions not included in standard dictionaries. For example, in *Dykes on Bikes*’s response to the examiner’s initial denial, the group submitted alternative definitions of “dyke.” See Serial No. 78/281,746, Paper Correspondence Incoming at 4–5, Aug. 23, 2004 (DYKES ON BIKES) (discussing alternative definitions of “dyke” provided in *The New Queer Dictionary*).

125. See, e.g., Serial No. 78/281,746, Paper Correspondence Incoming at 4–7, Aug. 23, 2004 (DYKES ON BIKES) (responding to examining attorney’s initial rejection of application by supplying statements from lesbians attesting to word’s reappropriated usage in lesbian community).

126. Cf. *Order Sons of Italy in Am. v. Memphis Mafia Inc.*, 52 U.S.P.Q.2d (BNA) 1364, 1366–67 (T.T.A.B. 1999) (noting that opposers submitted dictionary definitions, information on historical use of “mafia,” and one public opinion survey). While *Order Sons of Italy* involved a third-party opposition, the TTAB suggests that applicants may supply such evidence when supplementing their applications. See *id.*

The quality of the evidence upon which examining attorneys base their decisions is not ideal—dictionary definitions, website searches, and newspaper articles will not necessarily provide reliable information as to how a particular segment of people would react to an allegedly disparaging term in the context of the mark’s use. Because personal affidavits and “consumer surveys are not a viable option for the [PTO], due to its limited resources,”¹²⁷ the PTO tolerates such deficiencies and offers examiners conducting ex parte evaluations of disparagement wide discretion in selecting the materials that will guide their decisions. In contrast, courts hold third parties who challenge the registrability of marks to a higher standard, strongly suggesting they offer evidence such as surveys,¹²⁸ testimony from linguistic experts,¹²⁹ petitions,¹³⁰ and personal testimony from members of the disparaged group¹³¹ to prove that a substantial composite of the target group would find the mark disparaging.

Though examining attorneys are given a wide range of latitude, there are limits on the evidentiary materials they may use when evaluating disparagement. First, examiners “must provide evidence”¹³²

127. In re Wilcher Corp., 40 U.S.P.Q.2d (BNA) 1929, 1930 n.3 (T.T.A.B. 1996); cf. In re Budge Mfg. Co., 857 F.2d 773, 775 (Fed. Cir. 1988) (“[T]he PTO has limited facilities for acquiring evidence—it cannot, for example, be expected to conduct a survey of the marketplace or obtain consumer affidavits”); In re Loew’s Theatres, Inc., 769 F.2d 764, 768 (Fed. Cir. 1985) (“No more can be expected from the PTO in the way of proof. The PTO does not have means to conduct a marketing survey The practicalities of the limited resources available to the PTO are routinely taken into account in reviewing its administrative action.”).

128. See *Harjo*, 50 U.S.P.Q.2d (BNA) at 1732–34, 1745–46. However, for a survey to hold persuasive power, it must measure reaction to the use of the mark in the proper context. In *Harjo*, for example, the district court did not view the proffered survey as dispositive because “[t]he survey did not test the participants’ view of the term ‘redskin(s)’ in the context of Pro-Football’s services.” *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 127 (D.D.C. 2003).

129. See *Harjo*, 50 U.S.P.Q.2d (BNA) at 1728–32, 1744–45.

130. See *Boswell v. Mavety Media Group Ltd.*, 52 U.S.P.Q.2d (BNA) 1600, 1608 (T.T.A.B. 1999) (suggesting that petitions may constitute evidence that mark disparages).

131. See *Harjo*, 50 U.S.P.Q.2d (BNA) at 1723–24; see also *Boswell*, 52 U.S.P.Q.2d (BNA) at 1608 (suggesting that personal testimony from opposer might have held persuasive power if she provided “testimony as to what the mark indicated to her personally, or why she felt it was disparaging” or “any evidence with respect to the views of other women”).

132. *T.M.E.P.*, supra note 67, § 1203.01 (stating that examiner “must provide evidence that a substantial portion of the general public would consider the mark to be scandalous” in context of mark’s use). While the *T.M.E.P.* is silent in terms of the evidentiary requirements for disparaging marks, courts have established that the same basic evidentiary standards for scandalousness generally apply to disparagement. See *Harjo*, 50 U.S.P.Q.2d at 1738 (“In seeking guidance for determining . . . whether matter may be perceived as disparaging, we look to the limited precedent of the courts and the [TTAB] on the issue of disparagement, as well as to the previously enunciated precedent on the related issue of scandalousness.”).

to justify their decisions, indicating that they may not base an evaluation solely on their own personal opinion of whether a mark may disparage.¹³³ Additionally, examiners may not rely on the registration or rejection of prior similar marks as having precedential value—“each application for registration of a mark for particular goods must be separately evaluated.”¹³⁴ Finally, examining attorneys currently do not consider the fact that the applicant is a member of the disparaged group at issue as a factor in their decisions;¹³⁵ rather, examiners try to predict how a hypothetical “substantial composite” of the referenced group would react.

4. *The Difference Between “Disparaging” Marks and “Scandalous” Marks.*—Section 2(a) prohibits the registration of not only disparaging marks, but also marks containing “immoral . . . or scandalous matter.”¹³⁶ While the Lanham Act does not define the term “scandalous,”¹³⁷ courts interpret it to mean “giv[ing] offense to the conscience or moral feelings” and “shocking to the sense of truth, decency, or propriety; disgraceful, offen-

133. While examiners likely allow their personal opinions to influence their decisions, they nonetheless “must provide evidence” for their ultimate decision. See *supra* note 132.

134. *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 769 (Fed. Cir. 1985). While such a policy fosters inconsistency across applications for registration, the fact that “hundreds of different examiners interpret the law in thousands of applications over a number of years” makes adherence to prior decisions impracticable. 3 McCarthy, *supra* note 80, § 19:126.1. To help foster consistency across evaluations of scandalous marks, “when an examining attorney believes, for whatever reason, that a mark may be considered to comprise such matter, the examining attorney must consult with his or her supervisor.” T.M.E.P., *supra* note 67, § 1203.01.

135. Some scholars claim that the PTO has previously considered the applicant’s membership in the disparaged group as evidence. See, e.g., Davis, *supra* note 83, at 354 (“In determining whether particular marks are impermissibly disparaging, the [TTAB] has examined such considerations as . . . the mark owner’s membership in the allegedly disparaged group” (citing *In re Condas S.A.*, 188 U.S.P.Q. (BNA) 544 (T.T.A.B. 1975))); Cameron Smith, Note, Squeezing the Juice® out of the Washington Redskins®: Intellectual Property Rights in “Scandalous” and “Disparaging” Trademarks After *Harjo v. Pro-Football Inc.*, 77 Wash. L. Rev. 1295, 1308 (2002) (asserting that TTAB has considered “the applicant’s membership in the allegedly offended group” (citing *In re Condas*, 188 U.S.P.Q. (BNA) 544)). In *In re Condas*, the applicant, who was Japanese, applied to register the mark JAP. The TTAB, however, did not consider the applicant’s ethnicity in its decision to register the mark, rather basing its decision on a New York Supreme Court case, which it found to be persuasive authority. See *In re Condas*, 188 U.S.P.Q. (BNA) at 544. See *infra* text accompanying notes 175–181 for further discussion of *In re Condas*.

136. 15 U.S.C. § 1052(a) (2000). Case law treats “immoral” and “scandalous” as synonymous. See *In re McGinley*, 660 F.2d 481, 484 n.6 (C.C.P.A. 1981) (“We note the dearth of reported trademark decisions in which the term ‘immoral’ has been directly applied.”); T.M.E.P., *supra* note 67, § 1203.01 (“Although the words ‘immoral’ and ‘scandalous’ may have somewhat different connotations, case law has included immoral matter in the same category as scandalous matter.”).

137. See *In re McGinley*, 660 F.2d at 485 (noting difficulty in defining “scandalous” due to “paucity of legislative history”).

sive.”¹³⁸ Expletives,¹³⁹ sexual references,¹⁴⁰ crude images,¹⁴¹ and offensive phrases¹⁴² have all been denied federal registration based on their scandalous natures.

Though scandalous and disparaging marks share similarities, such as their joint presence in section 2(a), they are also separated by important differences. The primary distinction is that scandalous marks are shocking to the general public, while disparaging marks offensively target an identifiable subgroup.¹⁴³ Understanding this important difference, appellate bodies repeatedly remind examiners that the two doctrines are distinct—an examiner who believes a mark is both scandalous and disparaging must provide separate analyses for each,¹⁴⁴ using separate tests.¹⁴⁵

Despite this mandate for separation, examining attorneys routinely conflate the doctrines of disparagement and scandalousness.¹⁴⁶ Examin-

138. *Id.* at 485–86 (internal quotation marks omitted) (quoting various dictionaries); see also *In re Wilcher Corp.*, 40 U.S.P.Q.2d (BNA) 1929, 1930 (T.T.A.B. 1996) (discussing various definitions of “scandalous” used in earlier cases).

139. See, e.g., *In re Tinseltown, Inc.*, 212 U.S.P.Q. (BNA) 863, 865 (T.T.A.B. 1981) (rejecting mark BULLSHIT as scandalous); Serial No. 78/491,710, Office Action Outgoing at 1, May 2, 2005 (FUCK YOU YOU FUCKIN’ FUCK) (rejecting mark because it is “slang obscenity”).

140. See, e.g., *In re McGinley*, 660 F.2d at 482, 487 (rejecting “a photograph of a nude man and woman kissing and embracing in a manner appearing to expose the male genitalia” as scandalous); Serial No. 78/509,841, Office Action Outgoing at 2, June 29, 2005 (DICK’S HALFWAY IN PULL OUT BY 2 COME ON INN) (rejecting mark as scandalous “because it refers to a penis being half way [sic] inside something, and it also refers to pulling the penis out at a certain specific moment”).

141. See, e.g., *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1639 (T.T.A.B. 1988) (rejecting mark containing image of defecating dog as scandalous).

142. See, e.g., Serial No. 78/368,298, Office Action Outgoing at 2, Dec. 23, 2004 (WHITE PRIDE COUNTRY WIDE) (rejecting mark “because the proposed mark consists of or comprises immoral or scandalous matter”); Serial No. 78/322,569, Office Action Outgoing at 2, May 17, 2004 (STUPID BITCHES) (rejecting mark “because the proposed mark consists of or comprises immoral or scandalous matter”).

143. See *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1738 (T.T.A.B. 1999) (“[S]candalous’ [analysis] looks at the reaction of American society as a whole . . . to establish whether such matter violates the mores of ‘American society’ [D]isparage’ has an entirely different focus, as disparagement has an identifiable object”), *rev’d on other grounds*, 284 F. Supp. 2d 96 (D.D.C. 2003).

144. See *id.* (“Considering the . . . meanings of the words ‘scandalous’ and ‘disparage,’ we find that distinct differences in these meanings dictate that we apply different standards for determining disparagement from those enunciated by the Court and Board for determining scandalousness.”); Oswald, *supra* note 48, at 290 (“[I]t is critical for the tribunal to distinguish between allegations that a mark is scandalous and allegations that a mark is disparaging, for these two categories implicate very different interests and are resolved through different tests.” (citation omitted)).

145. While analysis of disparaging marks looks to a substantial composite of the disparaged group, see *supra* notes 107–118 and accompanying text, analysis of scandalous marks “is to be ascertained from the standpoint of not necessarily a majority, but a substantial composite of the general public.” *In re McGinley*, 660 F.2d at 485.

146. See, e.g., *In re Hines*, 31 U.S.P.Q.2d (BNA) 1685, 1686 n.2 (T.T.A.B. 1994) (“The Examining Attorney appears to lump all of these different concepts in Section 2(a) together, using [scandalous and disparaging] interchangeably. . . . [T]he refusal under

ers often claim that a mark is scandalous *because* it disparages a particular group of people, failing to clarify exactly who the mark offends.¹⁴⁷ Such findings confuse matters because determining whether lesbians find the word “dyke” to be offensive, for example, is a different task than determining whether the general public finds “dyke” to be vulgar, shocking, and disgraceful.¹⁴⁸ As one commentator notes, when an examiner “sloppily” treats scandalous and disparaging marks as being synonymous, “This does a disservice to the statutory language, leads to injustice in the individual case without gains in the predictability of outcomes, and makes for bad public policy.”¹⁴⁹

II. THE SPECIAL CASE OF SELF-DISPARAGING TRADEMARKS

Evaluating whether a mark is disparaging is rife with pitfalls—examiners must make highly subjective decisions based on rudimentary evidence, and they often employ incorrect standards. Amid this befuddlement, too many applicants who seek to reappropriate former slurs in their marks have gotten lost in the registration shuffle, wrongly having their marks rejected by examining attorneys when the marks should at least be published for opposition.¹⁵⁰

Part II.A first explains the unique characteristics of self-disparaging marks and their prominence in trademark applications. Part II.B then discusses the improper treatment self-disparaging marks receive under current disparagement analysis—specifically, that such marks are often analyzed under an improper standard and that such marks receive inconsistent treatment across examiners.

Section 2(a) on the ground that the mark is scandalous or immoral was based, almost entirely, on his finding that the mark disparages Buddhism.”), rev’d on other grounds, 32 U.S.P.Q.2d (BNA) 1376 (T.T.A.B. 1994); *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1221 n.4 (T.T.A.B. 1993) (“[T]he examining attorney’s refusal of registration on the grounds that applicant’s mark is scandalous was based, in large part, on her finding that the mark disparages . . .”). The TTAB is not immune from this error. See Smith, *supra* note 135, at 1305 (“Generally, the [TTAB] must make separate findings that a mark is scandalous or disparaging, but this distinction is often blurred.” (citations omitted)).

147. See, e.g., Serial No. 76/623,949, Office Action Outgoing at 1, July 24, 2005 (NIGGA) (rejecting mark because “NIGGA means nigger and is thus scandalous because it disparages African-Americans”); Serial No. 78/164,481, Office Action Outgoing at 1, Mar. 14, 2003 (FAG) (rejecting mark as scandalous on basis that “fag” is a “‘derogatory,’ ‘offensive’ or ‘derisive’ word referring to a male homosexual”).

148. One of the unexpected results noted by the district court in *Harjo* was that the general public found the word “redskin” to be more offensive than did Native Americans as a subgroup. *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 128 (D.D.C. 2003).

149. Zlotchew, *supra* note 14, at 230 (citation omitted); see also Oswald, *supra* note 48, at 290 (“When the courts and the [TTAB] use the terms scandalous or disparaging imprecisely or interchangeably, they confuse the very foundations of Section 2(a)’s statutory bars to registration . . .”).

150. See *In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654–55 (T.T.A.B. 1990) (stating that examiners should “resolve doubts” in favor of publication so that third parties may oppose registration).

A. *Contextually Disparaging Marks, Intrinsically Disparaging Marks, and Self-Disparaging Marks*

At first glance, all disparaging marks may appear to warrant identical analysis; however, a more nuanced approach to disparaging marks highlights important differences between the various forms which disparagement may take. Disparaging marks may be separated into two categories: contextually disparaging marks and intrinsically (or *per se*) disparaging marks.¹⁵¹

A contextually disparaging mark contains a term that would be acceptable to the relevant group as a general label of identification, but becomes disparaging based on the mark's contextual use. For example, an examiner might find that the mark BLACK TAIL as applied to an "adult entertainment magazine" disparages African American women.¹⁵² However, the disparagement stems from the alleged characterization of African American women "as mere female sexual objects . . . similar to the attitude of slave owners toward black women during the time of slavery"¹⁵³ and not from the mere presence of the word "black" in the mark.¹⁵⁴ Examiners have similarly refused to register other marks containing terms that become disparaging only when used in particular contexts: BUDDA BEACHWEAR¹⁵⁵ as applied to beach products, AMISH¹⁵⁶

151. This Note's analysis assumes that the target of disparagement is not an individual or a corporation. An individual and a corporate entity is each considered one "person" under the Lanham Act, see *supra* note 67, rather than a group of "persons," and as such, each is subject to a different test for evaluating whether the mark at issue is disparaging. The steps for determining whether a mark may disparage an individual or corporate entity are "(1) that the communication reasonably would be understood as referring to the plaintiff; and (2) that the communication is disparaging, that is, would be considered offensive or objectionable by a reasonable person of ordinary sensibilities." *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1639 (T.T.A.B. 1988); see also *infra* text accompanying notes 183–192.

152. *Boswell v. Mavety Media Group Ltd.*, 52 U.S.P.Q.2d (BNA) 1600, 1602 (T.T.A.B. 1999).

153. *Id.* at 1602–03.

154. See Amy Adler, *What's Left?: Hate Speech, Pornography, and the Problem for Artistic Expression*, 84 Cal. L. Rev. 1499, 1521 n.94 (1996) ("The word 'black' (when used to refer to African-Americans) was considered to be a derogatory term until it was adopted by 'blacks' themselves.").

155. *In re Hines*, 31 U.S.P.Q.2d (BNA) 1685 (T.T.A.B. 1994), *rev'd*, 32 U.S.P.Q.2d (BNA) 1376 (T.T.A.B. 1994). The TTAB agreed with the examiner, stating:

[T]he particular depiction of Buddha in the involved mark disparages the founder of Buddhism, and, in turn, slights Buddhists and Buddhism. . . . [T]he pictorialization of an easily recognizable Buddha in palm tree-embazoned casual wear of some sort slights, undervalues, discredits, or cheapens this person of great religious significance and the religion he founded and its followers.

Id. at 1688–89 (citation omitted).

156. *In re Waughtel*, 138 U.S.P.Q. (BNA) 594, 595 (T.T.A.B. 1963) (stating examiner refused to register mark because examiner believed application of word "Amish" to cigars "is an affront to such persons and tends to disparage their belief").

as applied to cigars, MOONIES¹⁵⁷ as applied to a doll that exposes its buttocks, and DOUGH-BOY¹⁵⁸ as applied to anti-venereal medicine for condoms.¹⁵⁹

An intrinsically disparaging mark, by contrast, contains a term that a substantial composite of the target group would always find disparaging, regardless of the mark's contextual use, based on the mere presence of a hateful slur. For example, the Native Americans who petitioned for the cancellation of REDSKINS claimed that the term "redskin" is never acceptable when it refers to Native Americans.¹⁶⁰ Similarly, opposers of the mark JAP, as applied to clothing, argued that the word "Jap" is a slur toward Japanese people and is thus intrinsically disparaging.¹⁶¹

Self-disparaging trademarks, however, defy this binary categorization. These are marks that an examining attorney would usually consider to be intrinsically disparaging based on the mere presence of a slur, but for the fact that the applicant is a member of the allegedly disparaged group. The applicant's purposeful use of the slur is thus persuasive evidence that the slur is no longer disparaging in all situations—the mark is transforming into a contextually disparaging mark that might not disparage a "substantial composite" of the referenced group, depending on the context of use. The word "fag" provides a clear example of such a transition. Historically, "fag" has been used as a slur against gay men;¹⁶² as a result, through as recently as 2003, examiners consistently refused to register marks using the word "fag" in reference to gay men because of its

157. *In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654 (T.T.A.B. 1990) (stating that examiner did not find term "moonies" to be per se disparaging, but rather "that [the] applicant's mark is 'lacking in taste and is an affront to an organized religious sect'").

158. *Doughboy Indus., Inc. v. Reese Chem. Co.*, 88 U.S.P.Q. (BNA) 227, 228 (P.T.O. 1951) (agreeing with examiner that "Doughboy" becomes disparaging "[w]hen used by applicant on its particular goods").

159. This list illustrates examiners' final rejections of disparaging marks; several of these refusals were later reversed. See *In re Hines*, 32 U.S.P.Q.2d (BNA) 1376; *In re In Over Our Heads*, 16 U.S.P.Q.2d (BNA) 1653; *In re Waughtel*, 138 U.S.P.Q. (BNA) 594.

160. *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1743 (T.T.A.B. 1999) ("Several of petitioners' witnesses expressed their opinions that the use of Native American references or imagery by non-Native Americans is, essentially, *per se* disparaging to Native Americans . . ."), *rev'd on other grounds*, 284 F. Supp. 2d 96 (D.D.C. 2003). The TTAB, however, rejected this broad notion and used a contextual approach to find that the word "redskins" may disparage Native Americans. See *id.*

161. *In re Condas S.A.*, 188 U.S.P.Q. (BNA) 544, 544 (T.T.A.B. 1975) ("[T]he Examiner points out that the Japanese American Citizens League considers the word 'JAP' to be derogatory and injurious . . .").

162. See Merriam-Webster Online Dictionary, at <http://www.m-w.com/cgi-bin/dictionary?book==dictionary&va=fag> (last visited Nov. 1, 2005) (on file with the *Columbia Law Review*) (characterizing "fag" as "usually disparaging"); GLSEN, Lesson Plan: What Do "Faggot" and "Dyke" Mean? 7 (2001), at http://www.glsen.org/binary-data/GLSEN_ATTACHMENTS/file/188-1.pdf (on file with the *Columbia Law Review*) (stating that by 1960s, "faggot" "had become one of the most common slurs used against gay men").

intrinsically disparaging nature.¹⁶³ But in September of 2005, the PTO registered the mark F■A■G FABULOUS AND GAY¹⁶⁴ as applied to grooming products—the first time the PTO registered a mark containing the word “fag” when it referred to gay men.¹⁶⁵ As gay men continue to reappropriate “fag” as a term of empowerment,¹⁶⁶ the word’s intrinsically disparaging nature disintegrates, becoming acceptable in certain contexts.¹⁶⁷ This message is what the registrant sought to communicate.¹⁶⁸ There are countless other slurs currently undergoing such revision: “Dyke,” “queer,” “nigger,” “spic,” “chink,” “bitch,” “hebe,” and “J.A.P.” are all in various stages of reappropriation by lesbians, gay men, bisexuals, transgender people, African Americans, Latinos, Asian Americans, women, and Jews.¹⁶⁹ Virtually any word that is or has been a slur can be

163. See, e.g., Serial No. 78/164,481, Office Action Outgoing at 1, Mar. 14, 2003 (rejecting mark FAG as applied to magazine title because “‘FAG’ is a derogatory term”). The PTO has registered marks containing the word “fag” when the term did not refer to gay men. See, e.g., Reg. No. 1,121,874 (1975) (registering mark FAG BAG as applied to purses and handbags, with the words “fag bag” emerging from lit cigarette).

164. Reg. No. 2,997,761 (2005).

165. The notion that the examiner of the application for F■A■G FABULOUS AND GAY recognized the word “fag” as undergoing a transition into a contextually disparaging mark is purely speculative; examiners do not provide reasons for why they approve marks. Further, it could be argued that the PTO was willing to register the mark because of the clear positive context of the word’s use, associating “fag” with “fabulous.” This explanation, however, demonstrates how contextually disparaging marks should be analyzed. By comparison, an intrinsically disparaging mark would always be rejected, despite indications that the word is meant to convey a positive message.

166. See Kapur & Mahmud, *supra* note 25, at 1023 (“[W]ords intended to insult gay men and women, such as ‘fruit,’ ‘dyke,’ and ‘fag,’ have been appropriated by the gay community as words denoting pride, self-awareness, and self-acceptance.”).

167. A mark containing the word “fag” thus becomes contextually disparaging. The hypothetical mark FAG & CHILD, for example, may disparage if used to imply that gay men are pedophiles, yet might not disparage if used as the title of a magazine targeted at gay parents of young children.

168. See F.A.G. — Fabulous & Gay, at <http://www.fabulousandgay.com/index1.html> (last visited Nov. 17, 2005) (on file with the *Columbia Law Review*) (“The dedicated team at Grayson Fairbanks, Inc. has come together to abolish the negative connotation of the word fag and reposition it to mean *Fabulous and Gay*. We all have the power to change the perspective of this word and to transform it into a positive vision.”); Bennett Law, Wash That Hate Right Out of Your Hair, Out in the Mountains, Dec. 2004, at http://www.mountainpridemedia.org/oitum/issues/2004/12dec2004/fea02_thanks.htm (on file with the *Columbia Law Review*) (discussing line’s name and implying cofounder’s membership in disparaged group); see also *infra* note 259 (discussing how corporation may be representative of larger disparaged group).

169. See Signorile, *supra* note 25 (discussing reappropriation of “queer”); Kennedy, *supra* note 25, at 48 (stating that many African Americans “have added a positive meaning to *nigger*”); Adler, *supra* note 154, at 1521 (“Although the term ‘nigger’ has long been an element of black vernacular, the word . . . has come to be viewed by some as a term of empowerment when used by blacks.” (citation omitted)); James Sullivan, Slurring Their Words: Comedians, Writers, Entrepreneurs Defang Hateful Language by “Flipping” It Back and Exploding Some Long-Held Stereotypes, *S.F. Chron.*, June 24, 2002, at A1 (discussing reappropriation of ethnic slurs including “spic,” “chink,” and “wog”); Reg. No. 3,002,579, Specimen (2005) (TOP BITCH) (“Throughout the ages women have not

reappropriated by the target group.¹⁷⁰ Not coincidentally, as subordinated groups reclaim former slurs as badges of self-approval, the PTO has been forced to evaluate these terms in trademark applications.¹⁷¹

While the existence of self-disparaging trademarks is undeniable, it is difficult to catalog all of the self-disparaging marks that have passed through the PTO over the years. Trademark application forms do not ask applicants for their group membership affiliations,¹⁷² and many respondents choose not to reply to initial rejections, opting to abandon their applications instead of arguing that a former slur has been reappropriated.¹⁷³ Additionally, the PTO does not maintain a cumulative record of marks that have been rejected as disparaging.¹⁷⁴ However, recent efforts challenging examiners' initial rejections shed substantial light on how examiners evaluate self-disparaging marks today.

embraced the word [bitch], but have cringed because of the negative stigma society has placed on it. Instead of the negative stigma, the word should be synonymous with beautiful, intelligent, charming, talented and humorous.”); Matthew Hunt, *Cunt: A Cultural History*, at <http://www.matthewhunt.com/cunt/reappropriation.html> (last visited Nov. 17, 2005) (on file with the *Columbia Law Review*) (“The commonest derogative term for a woman—‘bitch’—is on the road to reclamation.”); Tyre, *supra* note 21, at 10 (quoting *Heeb* magazine’s founder who justified name by stating that “[i]t’s similar to the way gays use the word ‘queer’ . . . We’re reappropriating it, but with a twist of pride” (internal quotation marks omitted)); Alana Newhouse, *The JAP: Reclaim Her or Reject Her?*, *Lilith*, Summer 2005, at 28–30 (discussing reappropriation of “J.A.P.”); Yolanda Shoshana, *Isabel Rose: Jewish American Powerhouse*, *New York Cool*, Sept. 2005, at http://www.newyorkcool.com/archives/2005/September/interview_1.html (on file with the *Columbia Law Review*) (discussing desire of Rose, author of *The J.A.P. Chronicles*, “to redefine the term [J.A.P.] as Jewish American Powerhouse”); see also *supra* note 25 (discussing reappropriation of slurs).

The power of reappropriation is not limited to textual slurs; visual slurs may also be reappropriated. For discussion of how the image of a pink triangle evolved from a mark of Nazi hatred into a symbol of gay pride, see Erik N. Jensen, *The Pink Triangle and Political Consciousness: Gays, Lesbians, and the Memory of Nazi Persecution*, 11 *J. Hist. Sexuality* 319 (2002).

170. Though it is often unclear whether an applicant is a member of a disparaged group, there is no shortage of applications to register marks which, intentionally or unintentionally, contain potential slurs. See, e.g., Reg. No. 2,863,012 (2004) (PAPI CHULO) (novelty products); Serial No. 78/693,535, filed Aug. 16, 2005 (DAGO CITY) (clothing); Serial No. 78/275,455, filed July 17, 2003 (THE SHIKSA’S GUIDE) (books); Serial No. 78/102,326, filed Jan. 12, 2002 (STRANGE FRUITS TV; YOUR INTERNET GAY SOAP OPERA TV) (internet entertainment).

171. See, e.g., Reg. No. 3,002,579 (2005) (TOP BITCH); Reg. No. 2,905,014 (2004) (QUEER EYE FOR THE STRAIGHT GUY); Reg. No. 2,858,011 (2004) (HEEB); Serial No. 78/665,332, filed July 7, 2005 (BABY JAP); Serial No. 76/623,949, filed Dec. 10, 2004 (NIGGA); Serial No. 78/281,746, filed July 31, 2003 (DYKES ON BIKES); Serial No. 78/164,481, filed Sept. 16, 2002 (FAG); Serial No. 76/082,591, filed July 1, 2000 (S.P.I.C.: SPANISH PEOPLE IN CONTROL).

172. The current online filing form is available at <http://www.uspto.gov/teas/index.html> (last visited Nov. 17, 2005).

173. See Gibbons, *supra* note 20, at 223 (discussing application abandonment).

174. See *id.*

B. Current Treatment of Self-Disparaging Trademarks

The TTAB and courts do not offer any guidance as to the role an applicant's membership in the disparaged group should play, if any, when an examiner suspects that a mark is disparaging. Only one published opinion even mentions an applicant's identity in the context of a disparaging trademark. In *In re Condas S.A.*, an examiner denied an application to register the mark JAP as applied to a clothing line because the mark "may disparage . . . the Japanese."¹⁷⁵ The examiner did support her decision with evidence, finding that "use of the word has been labeled derogatory by various statesmen" and that "the Japanese American Citizens League considers the word 'JAP' to be derogatory."¹⁷⁶ However, the examiner did not appear to consider the fact that the applicant, Kenzo Takada, was of Japanese origin.¹⁷⁷ In his appeal, Takada argued that "it would be inconceivable that someone of Japanese origin would choose a mark that would disparage his own heritage."¹⁷⁸ The TTAB reversed the examiner's decision, but not based on Takada's Japanese heritage.¹⁷⁹ Rather, the TTAB relied on a similar New York Supreme Court case that "rejected the contention . . . that 'JAP' is derogatory or would subject Americans of Japanese ancestry to contempt, ridicule, or scandal."¹⁸⁰ While some commentators dispute the New York Supreme Court's factual determination that the word "Jap" is not derogatory,¹⁸¹ it is clear that Takada's ethnicity was not a determinative factor.

With little assistance coming from the PTO or case law, examining attorneys have engaged in haphazard analyses of self-disparaging trademarks, usually treating them as they would any other mark suspected of disparagement.¹⁸² Two deficiencies continually arise amid these examinations, jeopardizing the validity of examiners' decisions: (1) incorrect

175. 188 U.S.P.Q. (BNA) 544, 544 (T.T.A.B. 1975) (internal quotation marks omitted) (quoting examiner's decision).

176. *Id.*

177. *See id.*

178. *Id.*

179. Several commentators have incorrectly suggested that Takada's ethnicity carried weight in the TTAB's decision. *See, e.g.,* Davis, *supra* note 83, at 354 n.110 (stating that TTAB "allow[ed] registration of JAP trademark upon showing that the applicant was Japanese"). The TTAB did acknowledge that Takada argued his ethnicity should be considered, but never adopted his argument, deciding the case on different grounds. *See In re Condas*, 188 U.S.P.Q. (BNA) at 544.

180. *In re Condas*, 188 U.S.P.Q. (BNA) at 544 (citing Japanese Am. Citizens League v. Takada, 171 U.S.P.Q. (BNA) 109 (N.Y. Sup. Ct. 1971)).

181. *See, e.g.,* Baird, *supra* note 6, at 668 n.20 (stating that TTAB "failed miserably" when "asked to place itself in the position of Japanese Americans and ascertain their subjective feelings").

182. *See, e.g.,* Serial No. 78/281,746, Office Action Outgoing at 1, Oct. 28, 2004 (DYKES ON BIKES) (taking no notice of applicant's membership in disparaged group and stating that while "some of the disparaged party have embraced or appropriated the term DYKE, [that] does not diminish the offensiveness of the term that has historically been considered offensive and derogatory").

applications of the test for evaluating disparaging marks, and (2) inconsistent judgments of whether a particular term is disparaging.

1. *Incorrect Applications of the Disparagement Test.* — Examining attorneys repeatedly apply the wrong test for evaluating disparaging marks. In *Harjo*, the TTAB stated that “the perceptions of the general public are irrelevant. . . . [O]nly the perceptions of those referred to, identified or implicated in some recognizable manner by the involved mark are relevant to this determination.”¹⁸³ The TTAB acknowledged an earlier standard set forth in *Greyhound Corp. v. Both Worlds Inc.*, which stated that a disparaging mark is one that “would be considered offensive or objectionable by a reasonable person of ordinary sensibilities.”¹⁸⁴ However, the TTAB expressly rejected the application of this standard to the Native Americans’ challenge:

[The *Greyhound* standard] may be appropriate in cases involving alleged disparagement of individuals or commercial entities. However, . . . *the perceptions of “those referred to, identified or implicated in some recognizable manner by the involved mark,” is appropriate for determining whether matter may disparage a non-commercial group, such as a religious or racial group, or beliefs . . .*¹⁸⁵

The message is clear: When a mark may disparage a particular person or corporate entity, the *Greyhound* test is appropriate. However, when a mark references a group of people connected by a noncommercial characteristic (such as religion, race, or sexual orientation), the examiner must adopt the perspective of the referenced group to determine whether the mark is disparaging.¹⁸⁶

Despite these explicit instructions, examiners continue to use the *Greyhound* test when the *Harjo* test is warranted. For example, in refusing an application to register DYKE TV, the examiner applied the *Greyhound* test and found that “said term [dyke] is disparaging to a reasonable person of ordinary sensibilities,”¹⁸⁷ even after receiving three explanations from the applicant explaining why *Harjo* is the proper standard.¹⁸⁸ Other examiners’ similar usage of this incorrect standard is embarrassingly

183. *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1739 (T.T.A.B. 1999) (internal quotation marks omitted) (quoting *In re Hines*, 31 U.S.P.Q.2d (BNA) 1685, 1688 (T.T.A.B. 1994)), rev’d on other grounds, 284 F. Supp. 2d 96 (D.D.C. 2003).

184. 6 U.S.P.Q.2d (BNA) 1635, 1639 (T.T.A.B. 1988) (citing Restatement (Second) of Torts § 629 (1977)). Note the similarities of this test to that for evaluating whether a mark is scandalous. See *supra* notes 143–145 and accompanying text.

185. *Harjo*, 50 U.S.P.Q.2d (BNA) at 1740 (emphasis added) (quoting *In re Hines*, 31 U.S.P.Q.2d (BNA) 1685, 1688 (T.T.A.B. 1994)).

186. While *Harjo* does not list sexual orientation as a noncommercial group, its list is nonexclusive. See *id.* (offering examples of noncommercial groups).

187. Serial No. 76/434,481, Office Action Outgoing at 5, Mar. 14, 2004.

188. See *id.*, Paper Correspondence Incoming at 3, July 27, 2005; *id.*, Paper Correspondence Incoming at 16, Sept. 13, 2004; *id.*, Paper Correspondence Incoming at 3, July 11, 2003.

widespread.¹⁸⁹ The likely source for this error is the *Trademark Manual of Examination Procedure (T.M.E.P.)*, a guide published by the PTO to assist examiners in their evaluations.¹⁹⁰ In the section discussing the standards for evaluating disparagement, the *T.M.E.P.* mistakenly lists only the *Greyhound* test and makes no mention of the *Harjo* test,¹⁹¹ despite the fact that the *T.M.E.P.* published its fourth edition in April of 2005.¹⁹²

Other examining attorneys stray even further from proper evaluation by confusing disparaging marks with scandalous marks.¹⁹³ For example, the examiner reviewing the application to register DYKEDOLLS provided several dictionary definitions of “dyke” and decided that “[t]hese representative dictionary definitions all show that the term ‘DYKE’ is a derogatory term used for homosexual women,” but then concluded that the “applicant’s mark comprises immoral or scandalous material.”¹⁹⁴ Similarly, another examiner rejected the mark FAG as applied to a magazine title because it is a “‘derogatory,’ ‘offensive’ or ‘derisive’ word referring to a male homosexual,” but refused registration “because the mark consists of or comprises immoral or scandalous matter.”¹⁹⁵ Other examiners appear to bounce from one doctrine to the other, depending on

189. See, e.g., Serial No. 78/281,746, Office Action Outgoing at 2, Feb. 20, 2004 (DYKES ON BIKES) (“A reasonable person of ordinary sensibilities would consider this reference offensive or objectionable because the term has been used as a derogatory or offensive term for lesbians.”); see also Serial No. 76/627,653, Office Action Outgoing at 2, Aug. 19, 2005 (DYKESINTHECITY) (providing verbatim justification for rejecting mark); Serial No. 78/448,110, Office Action Outgoing at 2, Aug. 18, 2005 (VELVETPARK DYKE CULTURE IN BLOOM) (same, after having erroneously deemed mark as scandalous in earlier rejection letter); see also *infra* note 192 (discussing use of form paragraphs).

190. The *T.M.E.P.* “is the official internal manual of procedure to be followed by trademark . . . examiners in reviewing applications for the registration of marks in the [PTO]. The *T.M.E.P.* provides PTO trademark examiners and attorneys for applicants with a very useful reference work on [PTO] practices and procedures” 3 McCarthy, *supra* note 80, § 19:129. However, the *T.M.E.P.* “does not have the force and effect of law.” *W. Fla. Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 1127 n.8 (Fed. Cir. 1994).

191. See *T.M.E.P.*, *supra* note 67, § 1203.03(c). In one examiner’s rejection letter, he applies the *Greyhound* test of a “reasonable person of ordinary sensibilities,” yet at the end of the letter states without analysis that only the disparaged group’s perceptions matter. See Serial No. 78/448,110, Office Action Outgoing at 2–3, Aug. 18, 2005 (VELVETPARK DYKE CULTURE IN BLOOM). The letter does not reconcile this contradiction.

192. Likely contributing to this error is examiners’ use of form paragraphs. See *T.M.E.P.*, *supra* note 67, § 705.01 (“Examining attorneys are encouraged to use form paragraphs to accelerate the preparation of Office actions and increase the uniformity of the substance and appearance of these actions.”).

193. See *supra* Part I.B.4 (discussing how examiners confuse disparagement with scandalousness).

194. Serial No. 78/497,352, Office Action Outgoing at 3, May 19, 2005. The examiner claimed that the word “dyke” is “considered to be a vulgar or offensive term to most people,” but the only evidence the examiner provided were dictionary definitions that indicate disparagement and not universal vulgarity. See *id.* at 2–3.

195. Serial No. 78/164,481, Office Action Outgoing at 1, Mar. 14, 2003. If the examiner of FAG believed the mark to be scandalous, she should have used the test for scandalous marks: that the mark is offensive not to gay men, but to the general public. See also Serial No. 78/448,110, Office Action Outgoing at 2–3, Feb. 16, 2005

how the applicant responds to an initial rejection.¹⁹⁶ While an examiner may find that a particular mark is scandalous, the reasoning cannot be based on a finding that the mark is insulting or offensive to a referenced group.¹⁹⁷

The impact of an examining attorney's erroneous use of the *Greyhound* test or the scandalous standard is that the examiner improperly ties evaluations of disparaging marks to the perceptions of the general public, rather than to the perceptions of the referenced population. As a result, the examiner does not properly weigh evidence sourcing from the referenced group's perception of the former slur. For example, responding to an application to register DYKESINTHECITY, the examiner used only standard dictionary definitions instead of inspecting materials sourcing from within the lesbian community.¹⁹⁸ By applying standards that respect only the general public's understanding of an allegedly disparaging term and not the referenced community's understanding, the examiner undermines the central component of disparagement analysis: Only the referenced group's perceptions matter. Materials created from outside the referenced group are less likely to capture emerging developments that reappropriation fosters.¹⁹⁹ Relying purely on opinions of the gen-

(VELVETPARK DYKE CULTURE IN BLOOM) (finding word "dyke" to be "derogatory . . . and offensive," but then rejecting mark as scandalous).

196. Compare Serial No. 78/448,110, filed July 8, 2004 (VELVETPARK DYKE CULTURE IN BLOOM), in which the examiner first judged the mark to be scandalous, *id.*, Office Action Outgoing at 2, Feb. 16, 2005, yet found the mark to be disparaging on reexamination, *id.*, Office Action Outgoing at 2, Aug. 18, 2005, with Serial No. 78/281,746, filed July 31, 2003 (DYKES ON BIKES), in which the examiner first judged the mark to be disparaging, *id.*, Office Action Outgoing at 2, Feb. 20, 2004; *id.*, Office Action Outgoing at 2, Oct. 28, 2004, but suggested the mark may be scandalous on reconsideration, *id.*, Reconsideration Letter at 1, May 25, 2005.

One example of confusion involves an African American applicant's two applications to register the mark NIGGA, filed only months apart. One examiner rejected the mark as scandalous, while the other examiner rejected the mark as both scandalous and disparaging. Compare Serial No. 76/623,949, Office Action Outgoing at 2, July 24, 2005 (NIGGA) (rejecting as scandalous), with Serial No. 76/639,548, Office Action Outgoing at 2, Dec. 22, 2005 (NIGGA) (rejecting as both scandalous and disparaging).

197. In *In re Hines*, for example, the TTAB evaluated the examiner's opinion as a disparagement claim, despite the examiner's opinion of scandalousness, because the reasoning behind the examiner's opinion was based on the mark's disparaging treatment of Buddhists. 31 U.S.P.Q.2d (BNA) 1685, 1686 n.2 (T.T.A.B. 1994), *rev'd* on other grounds, 32 U.S.P.Q.2d (BNA) 1376 (T.T.A.B. 1994).

198. Serial No. 76/627,653, Office Action Outgoing at 2, Aug. 19, 2005 (providing online dictionary evidence to support that "the term DYKES is considered derogatory or offensive in relation to lesbians"); see also Serial No. 78/497,352, Office Action Outgoing at 2-3, May 19, 2005 (DYKEDOLLS) (relying on standard dictionary definitions in rejecting mark).

199. Considering that reappropriation begins within the relevant community as a form of empowerment and then spreads outward, it is not surprising that the general public would not be aware of a term's reappropriation. See Garofoli, *supra* note 13 (quoting PTO administrator Jessie Roberts as acknowledging, "Yes, there is sometimes a difference between what is going on in the street currently"). Additionally, even

eral public not only defeats the purpose of having separate doctrines for scandalous and disparaging marks, but it also blocks applicants who have reapropriated slurs from registering marks that would pass the *Harjo* test.

2. *Inconsistent Judgments Across Examiners.* — In addition to continually using incorrect standards, examining attorneys also issue contradictory decisions with regard to whether a particular term is disparaging. For example, examiners have rejected at least seven applications to register marks containing the word “dyke” in reference to lesbians,²⁰⁰ yet in 2001 the PTO registered the mark TECHNODYKE as applied to a lesbian website.²⁰¹ Similar inconsistent opinions surround the registration and denial of marks containing the words “queer,”²⁰² “fag,”²⁰³ and “heeb.”²⁰⁴

Some inconsistency is unavoidable because the registration or rejection of one mark has no effect on the acceptance or denial of future applications.²⁰⁵ However, the PTO already has an internal mechanism to promote consistency: The TTAB encourages examiners to “resolve doubts” in favor of publication.²⁰⁶ Despite this mandate, many examining attorneys refuse to register marks containing former slurs in the face

mainstream dictionaries do not unanimously attribute a disparaging definition to “dyke.” See Serial No. 78/448,110, Paper Correspondence Incoming at 5, July 19, 2005 (VELVETPARK DYKE CULTURE IN BLOOM) (asserting that *Oxford English Dictionary Online* does not define “dyke” as being disparaging).

200. See, e.g., Serial No. 76/627,653, Office Action Outgoing at 2, Aug. 19, 2005 (DYKESINTHECITY); Serial No. 78/448,110, Office Action Outgoing at 2, Aug. 18, 2005 (VELVETPARK DYKE CULTURE IN BLOOM); Serial No. 78/497,352, Office Action Outgoing at 2, May 19, 2005 (DYKEDOLLS); Serial No. 76/434,481, Office Action Outgoing at 2, Jan. 27, 2005 (DYKE TV); Serial No. 78/281,746, Office Action Outgoing at 2, Oct. 28, 2004 (DYKES ON BIKES); see also Serial No. 75/121,779, filed June 11, 1996 (DYKE DISH); Serial No. 74/325,314, filed Oct. 26, 1992 (SUPERDYKE).

201. Reg. No. 2,498,459 (2001); see also Serial No. 75/312,451, filed June 20, 1997 (DYKE WEAR) (approved for publication but abandoned before registered).

202. Compare Reg. No. 1,828,351 (1994) (QUEER GEAR) (registering mark), with Serial No. 76/132,003, filed Sept. 19, 2000 (CLEARLY QUEER) (rejecting mark). See supra note 20 for discussion on the rejection of the mark CLEARLY QUEER.

203. Compare Reg. No. 2,997,761 (2005) (F■A■G FABULOUS AND GAY) (registering mark), with Serial No. 78/164,481, Office Action Outgoing at 1, Mar. 14, 2003 (FAG) (rejecting mark because “‘FAG’ is a derogatory term”).

204. Compare Reg. No. 2,858,011 (2004) (HEEB) (registering mark), with Serial No. 78/432,597, Office Action Outgoing at 2, Jan. 19, 2005 (THE BIG HEEB BREWING COMPANY) (rejecting mark because “the proposed mark consists of or comprises matter which may disparage or bring into contempt or disrepute”).

205. See supra note 134 and accompanying text (discussing how examiners’ acceptances or rejections of past applications do not hold precedential value for future applications).

206. In re In Over Our Heads Inc., 16 U.S.P.Q.2d (BNA) 1653, 1654–55 (T.T.A.B. 1990); see supra notes 119–122 and accompanying text (discussing PTO’s preference to resolve doubts by publishing mark so that it may be opposed by third parties); cf. *Ritchie v. Simpson*, 170 F.3d 1092, 1094 (Fed. Cir. 1999) (“[W]e have commended the practice of . . . first permitting the mark to pass for publication, and then allowing interested members . . . to bring opposition proceedings.”).

of strong doubts. For example, Dykes on Bikes's response to the examiner's initial rejection of its application included references to *The New Queer Dictionary* and other lesbian-centered materials, suggesting that a substantial composite of lesbians would not consider the word "dyke" to be disparaging.²⁰⁷ The examiner responded to this evidence by stating that "[t]he fact that some of the disparaged party have embraced or appropriated the term DYKE, does not diminish the offensiveness of the term that has historically been considered offensive and derogatory."²⁰⁸ Not only did this examiner inappropriately rely on "historical" meanings of the term instead of how lesbians understand "dyke" today, but even more surprisingly, the examiner explicitly acknowledged that doubts exist about the word's meaning within the lesbian community, conceding that "some of the disparaged party have embraced or appropriated" the word "dyke."²⁰⁹ When the PTO finally approved Dykes on Bikes's application, it claimed to do so because "[t]he applicant came in at the last moment with a lot of evidence to show that the community did not consider it disparaging."²¹⁰ This ad hoc justification conveniently ignores that Dykes on Bikes responded to the initial rejection with sixty-six pages of exhibits demonstrating the reappropriation of "dyke," and over three hundred pages of exhibits demonstrating reappropriation after the final rejection, nearly a month before the examiner denied the application on reconsideration.²¹¹ These exhibits were anything but "last moment" addi-

207. See Serial No. 78/281,746, Paper Correspondence Incoming at 4–7, Aug. 23, 2004 (DYKES ON BIKES) (providing alternative definitions of "dyke" and statements from lesbians confirming word's reappropriation); see also Serial No. 78/448,110, Paper Correspondence Incoming at 5, July 19, 2005 (VELVETPARK DYKE CULTURE IN BLOOM) (exposing doubt by submitting that *Oxford English Dictionary Online* does not define "dyke" as being disparaging).

208. Serial No. 78/281,746, Office Action Outgoing at 2, Oct. 28, 2004 (DYKES ON BIKES); see also Serial No. 78/448,110, Office Action Outgoing at 2–3, Aug. 18, 2005 (VELVETPARK DYKE CULTURE IN BLOOM) (repeating argument verbatim).

209. Another examiner recently made a similar error when considering an application by an African American to register the mark NIGGA. The examiner acknowledged that use of the term "nigga" in African American communities was the subject of debate, and then concluded that "[t]he very fact that debate is on-going regarding in-group usage, shows that a substantial composite of African-Americans find the term 'nigga' to be offensive." Serial No. 76/639,548, Office Action Outgoing at 2, Dec. 22, 2005. However, the mere acknowledgement of the debate indicates that there are doubts over the term's acceptability; those doubts must be resolved in favor of publication, and not against publication as the examiner erroneously concluded. See *supra* note 206 and accompanying text.

210. Guthrie, *supra* note 7 (quoting Lynne Beresford, a U.S. commissioner for trademarks).

211. See Serial No. 78/281,746, Paper Correspondence Incoming, Aug. 23, 2004 (DYKES ON BIKES); *id.*, Paper Correspondence Incoming, Apr. 28, 2005. In the examiner's reconsideration of the rejection, sent nearly one month after Dykes on Bikes's submission of exhibits, she stated that "no new facts or reasons have been presented that are significant and compelling." *Id.*, Reconsideration Letter at 1, May 25, 2005. It is difficult to reconcile this statement with the PTO's subsequent characterization of the evidence as being submitted at the "last moment." See *supra* text accompanying note 210.

tions;²¹² rather, they consisted of hundreds of pages of evidence demonstrating that doubts exist over the meaning of “dyke,” and yet the examiner repeatedly refused to acknowledge these doubts. While the PTO encourages examiners to publish marks when doubts exist, examiners apply idiosyncratic standards in determining whether a doubt exists in the first place.

III. THE NEED FOR A PURE DEFERENCE POLICY TOWARD SELF-DISPARAGING TRADEMARKS

The difficulties facing the registration of self-disparaging marks are similar to those facing other-disparaging marks—examiners who apply incorrect standards or foster inconsistent judgments currently do so without regard for the identity of the applicant. However, because of the central role that self-identification plays in the human experience, the rejection of a self-disparaging mark carries heightened harms that do not affect rejections of other-disparaging marks. Further, the fact that the applicant is a member of the disparaged group represents intrinsically persuasive evidence that should automatically raise “doubts” about whether a mark truly disparages. The optimal solution for recognizing these unique facets of self-disparaging marks is for the PTO to adopt a policy of pure deference, forbidding examiners from rejecting an application for a self-disparaging mark solely on the basis that it is intrinsically disparaging.

Part III.A first elaborates upon why a pure deference policy best addresses the burdens self-disparaging marks face, discussing the sociological and evidentiary foundations supporting deference. Next, Part III.B examines the formal logistics of implementing such a policy consistently and fairly. Finally, Part III.C addresses possible critiques of a policy of deference.

A. *Why Examining Attorneys Should Defer to Publishing Self-Disparaging Marks*

Applicants of self-disparaging marks do not accidentally use former slurs, nor are they ignorant about the potential impact of a slur on consumers; rather, they are highly aware of the word’s history. However, under the current disparagement regime, self-disparaging marks face heightened burdens that only a policy of pure deference may correct. There are two primary justifications for this pure deference proposal: (1) The importance of self-definition should lead the federal government to err on the side of publication; and (2) such a policy is consistent with the PTO’s current treatment of evidence.

The examiner appeared to consider the evidence and reject it as neither significant nor compelling.

212. Guthrie, *supra* note 7.

1. *The Importance of Self-Definition.* — The reappropriation of former slurs is an integral part of the fostering of individual and group identity, recapturing “the right of self-definition, of forging and naming one’s own existence.”²¹³ Negative labels imposed upon subordinated groups by a powerful majority create perpetual stigmas, eating away at the targets’ “self-integrity or wholeness” they would otherwise enjoy in society.²¹⁴ Through the use of slurs, a powerful majority savagely defines the target group’s identity instead of allowing members to create their own identities. While recipients of negative labels have a variety of counterattacks available for challenging the negative associations such labels carry, slur reappropriation has the particular benefit of “depriv[ing] outgroup members of a linguistic weapon.”²¹⁵ The reappropriation of a slur is thus ideal because it not only removes a stigma,²¹⁶ but it also cultivates self-definition in the target group—the recipients of the label actively choose to incorporate it into their identities rather than having it passively thrust upon them.²¹⁷ As one team of group identity researchers concludes:

[R]eappropriating a negative group label and changing its connotative meaning is a solution for the entire group to maintain and enhance positive self-esteem. If the very meaning of the group label has changed in a positive direction, this may allow people formerly ashamed of their group memberships to take pride in them, while simultaneously robbing name-callers of a previously potent weapon of interpersonal hostility.²¹⁸

The reappropriation of a former slur is nothing less than an act of “courageous self-emancipation”²¹⁹ that allows the victims of hateful labels to make themselves “whole” again.

The fundamental role that the reappropriation of slurs plays in the fostering of healthy self-definition requires heightened attention to the treatment of self-disparaging marks. To an applicant for a disparaging mark who is not a member of the disparaged group, an examiner’s rejec-

213. Robin Brontsema, *A Queer Revolution: Reconceptualizing the Debate over Linguistic Reclamation*, Colo. Res. Linguistics, June 2004, at 1, 1, at http://www.colorado.edu/ling/CRIL/Volume17_Issue1/paper_BRONTSEMA.pdf (on file with the *Columbia Law Review*).

214. Galinsky et al., *supra* note 25, at 225; see also Erving Goffman, *Stigma: Notes on the Management of Spoiled Identity* 3 (1963) (defining “stigma” as an attribute that reduces a person “from a whole and usual person to a tainted, discounted one”).

215. Galinsky et al., *supra* note 25, at 232.

216. See *id.* at 231 (“[S]elf-labeling defuses the impact of derisive terms by making the name more commonplace.”).

217. See Brontsema, *supra* note 213, at 16 (“To appropriate the power of naming and reclaim the derogatory name that one never chose nor willed is to rebel against the speech of hate . . .”).

218. Galinsky et al., *supra* note 25, at 232.

219. Brontsema, *supra* note 213, at 16; see also Deborah Cameron & Don Kulick, *Language and Sexuality* 27–29 (2003) (discussing reappropriation of words such as “queer” and “black”). The authors describe the act of linguistic appropriation as a “confrontational [strategy]: it says, ‘yes, we are exactly what you say—and what’s more, we’re proud of it.’” *Id.* at 27.

tion is a mere inconvenience; the applicant's identity is not endangered. An examiner who rejects a self-disparaging mark, however, cuts to the core of the applicant's self-identity. Such a rejection not only precludes the applicant from acquiring federal benefits for that mark, but also impedes the applicant's power to construct a chosen identity.²²⁰ In short, current application of disparagement doctrine forces an applicant to choose between self-definition and the benefits of federal trademark protection—a choice which warrants, at a minimum, deference to an applicant's good-faith belief that a former stigma has been reappropriated.

Consider the example of a lesbian applicant seeking to register the trademark DYKEDOLLS for her line of lesbian-themed dolls.²²¹ If an examining attorney initially rejects the mark because the word "dyke" is disparaging, the applicant has two options. The first option allows her to contest the examiner's decision by providing evidence and legal arguments that the word "dyke" has been reappropriated by the lesbian community.²²² However, such a course of action has costs. First, the financial burdens of collecting evidence and hiring an attorney are not insubstantial,²²³ particularly considering that the applicant may be an individual who filled out an application online without an attorney's help.²²⁴ Further, after collecting evidence and responding to the examiner's concerns, the applicant must wait an indeterminate number of months for a response.²²⁵ Finally, even if the applicant provides strong evidence that

220. See Reiter, *supra* note 26, at 207 ("[C]omplicating the task of any regulator of the moral content of trademarks is the tendency of disparaged groups to adopt the names and symbols which their detractors applied to them, thereby reclaiming control over the power to represent themselves and . . . implicitly asserting their ability to withstand and transcend insults.").

221. Serial No. 78/497,352, filed Oct. 9, 2004.

222. See T.M.E.P., *supra* note 67, § 713 (stating that "[t]he examining attorney must carefully consider all arguments, comments, and amendments made or proposed by the applicant" in response to initial rejection).

223. Dykes on Bikes, for example, responded to the examiner's initial opinion with a seven page single-spaced letter from an attorney providing legal analysis of the examiner's error and sixty-six pages of exhibits, including evidence of how lesbians use the word "dyke," alternate dictionary definitions, declarations from witnesses, and letters of support. See Serial No. 78/281,746, Paper Correspondence Incoming, Aug. 23, 2004 (DYKES ON BIKES). Upon the examiner's final rejection, Dykes on Bikes's attorney submitted twenty-three pages of single-spaced legal argument and over three hundred pages of exhibits, including declarations from linguistic experts, witnesses, and the Editor-at-Large of the *Oxford English Dictionary*. See *id.*, Paper Correspondence Incoming, Apr. 28, 2005.

224. An individual may apply to register a mark by visiting <http://www.uspto.gov/teas/index.html> and filling out an online form. For example, the applicant for Serial No. 78/432,597, Trademark Application, June 9, 2004 (THE BIG HEEB BREWING COMPANY) did not use an attorney.

225. Receiving a response usually takes at least six months. For example, Dykes on Bikes submitted its application to register DYKES ON BIKES in July 2003, and did not receive an opinion from an examining attorney until February 2004. See Serial No. 78/281,746, Trademark Application, July 31, 2003; *id.*, Office Action Outgoing, Feb. 20, 2004; see also Garofoli, *supra* note 13 (describing registration process for Dykes on Bikes as "a humiliating two years slogging through the swampland of trademark law").

“dyke” has been reappropriated by the lesbian community, the examiner may simply reaffirm the earlier opinion.²²⁶ Such costs are simply too high for most to bear.

The DYKEDOLLS applicant will more likely choose the second option: to abandon her application, as do most applicants who receive initial rejections based on self-disparagement.²²⁷ She may freely continue to use the mark DYKEDOLLS on her products, but she would then forgo access to federal registration benefits.²²⁸ Instead, she will likely create a new, non-disparaging mark for her product which does not include the word “dyke,” providing her access to the multiple benefits of federal registration.²²⁹

The ultimate impact of the examining attorney’s initial rejection of DYKEDOLLS in this scenario is severe. By rejecting an applicant’s use of a self-defining term, an examiner interferes with the process of reappropriation, forcing an applicant to choose between the benefits that accompany identity formation and the benefits that accompany federal trademark registration. When a term is undergoing reappropriation, a transition which is inherently controversial,²³⁰ it is the members of that

226. See Serial No. 78/281,746, Reconsideration Letter, May 25, 2005 (DYKES ON BIKES) (refusing to register mark on reconsideration because “no new facts or reasons have been presented that are significant and compelling”).

227. See Gibbons, *supra* note 20, at 223 (“In response to a first office action citing section 2(a) as a possible grounds for denying the application, many applicants do not respond, consequently, the record shows that the application was abandoned without showing the examining attorney’s objection.”). Abandoned applications to register what are or are likely to be self-disparaging marks include: Serial No. 78/432,597, filed June 9, 2004 (THE BIG HEEB BREWING COMPANY); Serial No. 78/164,481, filed Sept. 16, 2002 (FAG); Serial No. 78/042,552, filed Jan. 10, 2001 (NIGGA’CLOTHING); Serial No. 76/132,003, filed Sept. 19, 2000 (CLEARLY QUEER); Serial No. 76/090,631, filed July 18, 2000 (FN’Z FIELD N!GGA WEAR); Serial No. 76/082,591, filed July 1, 2000 (S.P.I.C. SPANISH PEOPLE IN CONTROL); Serial No. 75/121,779, filed June 11, 1996 (DYKE DISH); Serial No. 75/002,364, filed Oct. 6, 1995 (N.I.G.G.A. NATURALLY INTELLIGENT GOD GIFTED AFRICANS); Serial No. 74/325,314, filed Oct. 26, 1992 (SUPERDYKE).

228. Organizations that have already used the mark in commerce for a substantial period of time will likely choose such a route. See *Dykes on Bikes*, at <http://www.dykesonbikes.org> (last visited Nov. 17, 2005) (on file with the *Columbia Law Review*) (stating that San Francisco Women’s Motorcycle Contingent has used mark in commerce for over twenty-eight years). Without federal trademark protection, other organizations may use the same mark in their own geographic regions, capitalizing on the goodwill *Dykes on Bikes* has procured over the past twenty-eight years. Such a danger is very real—five months before the San Francisco Women’s Motorcycle Contingent applied to register *DYKES ON BIKES*, another applicant unaffiliated with the group applied to register the marks *DYKES ON BIKES USA* and *DYKES ON BIKES MADISON* with the PTO. Serial No. 78/219,492, filed Feb. 26, 2003. The PTO rejected the unaffiliated marks on procedural grounds, *id.*, Office Action Outgoing at 2, Aug. 18, 2003, and the applicant abandoned the application, *id.*, Notice of Abandonment, Nov. 3, 2003.

229. See *supra* Part I.A.1 for discussion of the benefits of federal trademark registration.

230. See Brontsema, *supra* note 213, at 1 (“Because this self-definition is formed not in one’s own terms but those of another, because it necessarily depends upon the word’s

group and not an examiner who should be able to determine a former slur's current status in that community. The only way to receive an accurate portrait of that slur's current use "in the street"²³¹ is to publish the mark for opposition and allow members of the disparaged group to challenge the applicant's use of the mark.²³² This policy of deference has the invaluable benefit of creating a full record garnered by different factions of the disparaged group itself, rather than an examining attorney relying on online dictionary definitions and newspaper articles²³³—in other words, deference promotes and protects self-definition. With the stakes as high as that of one's self-identity, a policy of deference to publication is not only appropriate, but indispensable.

2. *Deference to the Applicant Is Consistent with the PTO's Current Evidentiary Policies.* — Not only does a policy of pure deference in cases of self-disparagement pay proper respect to a disparaged group's need for self-definition through reappropriation, but it is also fully consistent with how the PTO purports to consider evidence. Under the current disparagement regime, examining attorneys "must provide evidence"²³⁴ that a mark may disparage a particular group, while still "resolv[ing] doubts" in favor of publication.²³⁵ Usually, examiners rely on dictionary definitions, website searches, and newspaper articles,²³⁶ without having the opportunity to receive personal testimony from third parties.²³⁷ Nonetheless, ex-

pejoration for its revolutionary resignification, it is never without contestation or controversy.").

231. See Garofoli, *supra* note 13 (quoting PTO administrator as stating, "Yes, there is sometimes a difference between what is going on in the street" and resources upon which examiners rely (internal quotation marks omitted)).

232. Publication seems to be particularly warranted for self-disparaging marks containing the term "dyke," considering that no third parties opposed the publication or registration of the mark TECHNODYKE, Reg. No. 2,498,459 (2001).

233. See *infra* notes 250–255 and accompanying text (discussing advantages of allowing third parties to challenge mark's registrability rather than relying on examiner's determination).

234. T.M.E.P., *supra* note 67, § 1203.01.

235. *In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654–55 (T.T.A.B. 1990).

236. See *supra* notes 123–126 and accompanying text for discussion of evidence examiners may consider.

237. Cf. *In re Budge Mfg. Co.*, 857 F.2d 773, 775 (Fed. Cir. 1988) (noting that PTO has limited resources and cannot be expected to conduct surveys or obtain affidavits).

The TTAB has previously ruled on the reliability of witness testimony in trademark disparagement disputes. In *Order Sons of Italy in America v. Memphis Mafia Inc.*, an inter partes challenge, the TTAB was not persuaded by the affidavits of three members of the disparaged group when there was evidence challenging the witnesses' statements, particularly because the witnesses belonged to the organization that raised the challenge. 52 U.S.P.Q.2d (BNA) 1364, 1369 (T.T.A.B. 1999) ("[W]e cannot ignore the fact that these witnesses are all active members of the Order. Their testimony cannot be viewed as other than reflecting the objectives of this organization. Accordingly, this testimony must be considered as potentially self-serving . . ."). The TTAB ultimately held that examiners may opt to fully disregard any witness testimony, because the TTAB "is required to reach its own conclusions with respect to the ultimate issue of disparagement, rather than relying

aminers must take all possible precautions to avoid “interposing [their] own judgment[s]” for those of the disparaged group.²³⁸ When an applicant who seeks to register a mark containing a traditional slur is a member of the disparaged group, such circumstances *inherently* constitute strong enough evidence to raise sufficient “doubts” about whether the term is truly disparaging. A pure deference policy treats the applicant’s membership in the disparaged group as per se testimony that the former slur is undergoing reappropriation and might no longer be disparaging in the presented context, despite the word’s historical roots. Indeed, it is strange to imagine that an examiner could find a dictionary to be so reliable that there could be no doubt that the mark at issue is disparaging, despite being confronted by a member of the group who, through the mere act of applying to register the mark, contends that the dictionary is not reliable.²³⁹

There are several explanations for why a pure deference policy is preferable to examiner discretion in determining whether a self-disparaging mark has recently become acceptable within the disparaged community. First, a member of a target community is more likely to be aware of a slur’s current “in the street” usage than would general mainstream publications, such as dictionaries and newspapers, which lag in acknowledging linguistic trends²⁴⁰ or may be swayed by “historical” usage.²⁴¹ Second, a pure deference policy simplifies the examination process so that applicants and examiners do not engage in a “battle of the dictionaries.”²⁴² As the clash over DYKES ON BIKES illustrates, it is not difficult to find a

upon the opinions of witnesses.” *Id.* Such circumstances do not apply, however, in the context of ex parte proceedings, where the applicant simply seeks publication. Further, the PTO already accepts other “self-serving” statements during the application process, such as sworn statements attesting that all of the information contained in the application is accurate. See 15 U.S.C. § 1051(a)(3) (2000). Even if testimony is “self-serving” during the application process, such a statement is nonetheless enough to at least raise a “doubt.”

238. *In re Hines*, 32 U.S.P.Q.2d (BNA) 1376, 1377 (T.T.A.B. 1994) (reversing examiner’s refusal to publish mark because PTO should “avoid interposing its own judgment for that of Buddhists”).

239. In some cases, examiners rejected applications as disparaging by supporting their opinions with only a single dictionary definition. See, e.g., Serial No. 78/432,597, Office Action Outgoing at 2, Attachment-1, Jan. 19, 2005 (THE BIG HEEB BREWING COMPANY) (rejecting application based on single definition from *Merriam-Webster Online Dictionary*).

240. See Garofoli, *supra* note 13 (noting that PTO administrator Jessie Roberts acknowledged, “Yes, there is sometimes a difference between what is going on in the street currently” and research upon which examiners rely); cf. Nadine Strossen, Thoughts on the Controversy over Politically Correct Speech, 46 SMU L. Rev. 119, 130 (1992) (“[T]he designation preferred by members of particular groups changes over time, so the [*Dictionary of Cautionary Words and Phrases*] is likely to be quickly outdated.”).

241. See Serial No. 78/281,746, Office Action Outgoing at 2, Oct. 28, 2004 (DYKES ON BIKES) (justifying rejection of mark because “the term . . . has historically been considered offensive and derogatory”).

242. Gibbons, *supra* note 20, at 222.

dictionary supporting either side of a disparagement debate.²⁴³ Third, considering the limited resources available to examiners to determine whether a “substantial composite” of a particular group would view a mark as disparaging,²⁴⁴ the testimony of a group member operates as an efficient proxy for the mark’s current acceptability.

Further, a pure deference policy for self-disparaging marks would not bind examining attorneys from denying an application for other legitimate reasons. For example, even though an examiner would no longer be able to reject an application for a self-disparaging mark based on its being intrinsically disparaging, she may reject a mark because it is scandalous. A rejection of the mark NIGGA, submitted by an African American applicant, would be permissible if the rejection is based on the general public’s feeling toward the word “nigger” and not only the effect the word has on African Americans.²⁴⁵ Similarly, if the mark DYKES ON BIKES “violates the mores” of a “substantial composite” of “American society as a whole,”²⁴⁶ then the mark is unregistrable.²⁴⁷ This allowance of alternate bases²⁴⁸ for rejection allays potential fears that disparaged

243. See Serial No. 78/281,746, Office Action Outgoing at 2, Oct. 28, 2004 (DYKES ON BIKES) (comparing definitions of examiner with those provided by applicant).

244. See *In re Wilcher Corp.*, 40 U.S.P.Q.2d (BNA) 1929, 1930 n.3 (T.T.A.B. 1996) (acknowledging that “consumer surveys are not a viable option for the [PTO], due to its limited resources”); cf. *In re Budge Mfg. Co.*, 857 F.2d 773, 775 (Fed. Cir. 1988) (“[T]he PTO has limited facilities for acquiring evidence—it cannot, for example, be expected to conduct a survey of the marketplace or obtain consumer affidavits”); *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 768 (Fed. Cir. 1985) (“No more can be expected from the PTO in the way of proof. . . . The practicalities of the limited resources available to the PTO are routinely taken into account in reviewing its administrative action.”).

245. An examining attorney recently rejected the mark NIGGA as applied to clothing because “NIGGA means nigger and is thus scandalous because it disparages African-Americans,” despite the fact that the applicant was African American. Serial No. 76/623,949, Office Action Outgoing at 1, July 24, 2005. Under a policy of pure deference, the examiner may still reject the mark based on its scandalous nature, but the examiner must provide reasoning based on the perspective of the general public, as the test requires. See, e.g., Serial No. 76/639,548, Office Action Outgoing at 2, Dec. 22, 2005 (NIGGA) (rejecting mark based on both disparagement and scandalousness, each analyzed independently).

246. *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1738 (T.T.A.B. 1999), rev’d on other grounds, 284 F. Supp. 2d 96 (D.D.C. 2003).

247. See, e.g., Serial No. 78/497,352, Office Action Outgoing at 2, May 19, 2005 (DYKEDOLLS) (finding mark to be scandalous because term “dyke” “is considered to be a vulgar or offensive term to most people”). However, the PTO’s subsequent publication of DYKES ON BIKES suggests that challenges of the word “dyke” as scandalous may not succeed. An open question, beyond the scope of this Note, is the influence that a disparaged group’s appropriation of a slur should have on an evaluation of scandalousness—if the target group does not find the word to be offensive, should an examiner use this information in determining whether the rest of the general public may find the word to be vulgar?

248. An examiner would even be permitted to find a self-disparaging mark disparaging because of its *contextual* use. See *infra* note 258 (discussing how examiner may still reject application if mark is contextually disparaging).

group members will take advantage of their statuses to drive clearly unacceptable marks through the PTO.²⁴⁹

Finally, a pure deference policy still allows third parties to challenge the registrability of marks that truly do disparage. Section 2(a) disparagement challenges have lax standing requirements, allowing anyone who “alleges that he possesses a trait or characteristic that is clearly and directly implicated by the proposed trademark” as having sufficient standing to initiate an inter partes proceeding for a mark’s denial or cancellation.²⁵⁰ Further, third parties are not restricted by the doctrine of incontestability when they believe a mark to be disparaging.²⁵¹ After an examiner allows a self-disparaging mark to be published, the mark is treated as any other challenged mark. This is the optimal course of action envisioned by the TTAB and the courts, where an examiner evaluates a “disparaging [mark] in favor of [the] applicant and pass[es] the mark for publication with the knowledge that if a group does find the mark to be . . . disparaging, an opposition proceeding can be brought and a more complete record can be established.”²⁵² For example, once an examiner publishes DYKES ON BIKES, a lesbian may then challenge the mark’s publication, presenting evidence that a substantial composite of the lesbian community would find the mark disparaging, aided by surveys, linguistic experts, petitions, and witness testimony.²⁵³ By shifting the burden to third parties to come forward, the PTO would be “avoid[ing] the risk of pre-judging . . . attitudes toward a proposed registration based on *ad hoc* responses by government officials, while at the same time affording the affected [individuals] an opportunity to effectively participate in the question of whether the registration is proper.”²⁵⁴

249. These alternate bases include any other procedural or substantive deficiencies. See, e.g., 15 U.S.C. § 1052(d) (2000) (registration of mark may not cause likelihood of confusion with another registered mark); 37 C.F.R. § 2.32(a)(6) (2004) (applicant must include list of goods on which mark will appear).

250. *Ritchie v. Simpson*, 170 F.3d 1092, 1098 (Fed. Cir. 1999); see also *Boswell v. Mavety Media Group Ltd.*, 52 U.S.P.Q.2d (BNA) 1600, 1604 (T.T.A.B. 1999) (“As a member of the group which is asserted to be disparaged or brought into contempt or disrepute by the mark BLACK TAIL, she has clearly demonstrated her standing in this proceeding.”). The only other restrictions to standing are equitable limitations. See 15 U.S.C. § 1069 (“In all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable may be considered and applied.”). For further discussion of third-party standing requirements, see generally Oswald, *supra* note 48.

251. See 15 U.S.C. § 1064(3) (stating that petition to cancel mark may be filed “[a]t any time if the registered mark . . . was obtained . . . contrary to the provisions of . . . section [2(a)]”).

252. *In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654–55 (T.T.A.B. 1990); cf. *Ritchie*, 170 F.3d at 1094 (“[W]e have commended the practice of resolving the issue of whether a mark comprises scandalous matter by first permitting the mark to pass for publication, and then allowing interested members . . . who consider the mark to be scandalous to bring opposition proceedings.”).

253. See *supra* notes 128–131 and accompanying text (discussing examples of available evidence third parties may present during challenges to mark’s registrability).

254. *Ritchie*, 170 F.3d at 1094.

Though opposers unavoidably would internalize the costs associated with initiating an opposition of a self-disparaging mark, such risks ensure that borderline cases will respect self-definition, while still giving opposers an opportunity to voice their dissent.²⁵⁵

B. Logistics: How to Treat Self-Disparaging Trademarks with Deference

A policy of deference would not only institute needed protections that self-disparaging marks require, but it is also a “workable rule”²⁵⁶ that is simple to implement and will not tax the PTO’s limited resources. A policy of pure deference²⁵⁷ for self-disparaging trademarks contains two required elements:

- (1) The mark at issue contains what has traditionally been considered a slur that may disparage a particular group;²⁵⁸ and
- (2) The applicant²⁵⁹ is a member of the disparaged group.

When an application satisfies both elements, an examining attorney would then be prohibited from using self-disparagement as a reason for rejecting the application. The first required element, that the mark contains a slur that “may disparage,” does not require further elaboration—it

255. Note that large financial costs are not inevitable; for example, an opposer need not conduct a survey. See *Boswell*, 52 U.S.P.Q.2d (BNA) at 1607 (“[A] party bringing a proceeding on the ground of disparagement should not be required to conduct a survey . . .”). Nonetheless, the onus is still on the plaintiff “to show that the allegedly disparaged group views the mark at issue to contain or comprise disparaging matter.” *Id.*

256. The Trademark Blog, *supra* note 42.

257. Because this is a proposal for a change of the PTO’s evaluation guidelines, such a policy would not require congressional approval or amendment of section 2(a). Rather, this policy of pure deference is an internal mechanism of the PTO, which the PTO has the power to adopt.

258. This proposal only applies to applications which are rejected because of the mere presence of a slur, because that is what linguistic reappropriation specifically seeks to counter. For example, if a lesbian applies to register DIRTY LESBIAN, as applied to soap products, an examiner may choose to reject the mark as disparaging. Similarly, an examiner may reject her application to register DIRTY DYKE if the rejection is not based on the mere use of the word “dyke” as a slur, but rather on the contextual use of the word as implying that lesbians are dirty. In this example, the examiner’s decision is not interfering with the applicant’s right to self-define. This treatment is consistent with examiners’ evaluations of other contextually disparaging marks, such as BLACK TAIL or BUDDA BEACHWEAR. See *supra* notes 151–159 and accompanying text; see also *supra* note 167 (using example of FAG & CHILD).

259. A potential wrinkle exists for situations where the applicant is not an individual, but an organization or corporation. In such situations, an organization should be able to show that it represents the target group through persuasive circumstantial evidence, such as affidavits signed by the leaders of the organization confirming their membership in the disparaged group, the presence of a mission statement which provides a specific commitment to the disparaged group, or evidence that the corporation only produces products targeted toward the disparaged group. See, e.g., Serial No. 78/281,746, Trademark Application, July 31, 2003 (DYKES ON BIKES) (describing applicant’s goods and services as “fostering pride in a wide variety of sexual orientations and identities, namely lesbian, bisexual and transgender”).

is identical to how examining attorneys currently evaluate disparagement.²⁶⁰ The second element, however, warrants further explanation.

The requirement that the applicant be a member of the disparaged group is fundamental to creating an effective response to self-disparagement. The central notion behind the desire to publish self-disparaging marks is the need to protect self-definition; if the applicant is not a member of the disparaged group, then self-definition is not at risk. Further, a nongroup member is more likely to use a disparaging term accidentally or without understanding its significance within the disparaged community. Therefore, for an applicant to benefit from the deference accompanying self-disparaging marks, the applicant must attest to membership in the group. The most efficient manner for proving group membership is simply to require that the applicant sign a sworn statement confirming membership in the disparaged group.²⁶¹ This method of proof is simple, unobtrusive, and respects an individual's right to self-define.

A potential critique of merely allowing an applicant to sign a statement in order to prove group membership is that it will be abused—anyone can sign a statement stating that he or she is Jewish, African American, or gay, and thus receive access to the automatic deference denied to nongroup members. Such a criticism, however, is unfounded because the PTO already widely embraces sworn statements from applicants as being reliable. For example, in an application to register a trademark, the applicant must already sign a sworn statement stating that all of the information contained in the application is true and accurate and that, to the best of the applicant's belief, no one else has a right to the mark.²⁶²

260. See *supra* Part I.B.2–4 (discussing current accepted method for evaluating disparagement). A possible problem may arise for words that may disparage multiple groups, such as “JAP.” See *supra* note 118. The first step of evaluating whether a mark disparages, however, requires the examiner to evaluate if a mark clearly identifies a particular identifiable group. If the contextual use of the mark BABY JAP makes it clear that the mark refers to “Jewish American Princess,” then the mark does not disparage Japanese people.

261. An applicant may submit this statement with the application or as a response to an examining attorney's initial rejection based upon disparagement.

262. See 15 U.S.C. § 1051(a)(3) (2000), which provides:

The statement shall be verified by the applicant and specify that—(A) the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be the owner of the mark sought to be registered; (B) to the best of the verifier's knowledge and belief, the facts recited in the application are accurate; (C) the mark is in use in commerce; and (D) to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion

See also 37 C.F.R. § 2.33(b)(1) (2004), which provides:

The application must include a statement that is signed and verified (sworn to) [T]he verified statement must allege . . . that the applicant believes it is the owner of the mark; that the mark is in use in commerce; that to the best of the declarant's knowledge and belief, no other person has the right to use the

A policy of self-definition is also consistent with the federal government's general approach toward membership in identity categories such as race.²⁶³

An additional response to the "dishonest applicant" critique can be found in the standing doctrine for third-party petitions seeking to challenge a trademark's registrability. Under the current regime, any member of the public who is a member of the disparaged group has standing to challenge a mark as being disparaging in an inter partes proceeding.²⁶⁴ Neither the TTAB nor courts have ever questioned whether an opposer's presence within the disputed disparaged group is accurate; rather, signed statements swearing to membership in the group are considered to be sufficient proof. If such a standard is acceptable for opposers challenging a mark's registrability, the same standard must be acceptable for applicants as well.

C. *Potential Critiques of a Pure Deference Policy for Self-Disparaging Trademarks*

Though the PTO's adoption of a pure deference policy for self-disparaging marks would provide substantial benefits for eligible applicants, such a policy is not immune from criticism. Particularly powerful critiques include that (1) examiners will simply reject the marks at issue by deeming them to be "scandalous"; (2) providing discrete procedural benefits to members of particular groups based on characteristics such as race and religion impermissibly provides such applicants "special treatment"; and (3) such a policy does not adequately prevent the registration of marks containing "obvious" slurs.

1. *Swallowed by Scandalousness.* — A serious criticism of a pure deference policy is that examining attorneys will simply reject the marks at issue by characterizing them as "scandalous." Such fears are well founded—in her third and final letter denying the publication of DYKES ON BIKES, the examiner suggested (for the first time) that in addition to

mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of the other person, to cause confusion or mistake, or to deceive; that the specimen shows the mark as used on or in connection with the goods or services; and that the facts set forth in the application are true.

An applicant who files an intent-to-use application must similarly sign a statement attesting to a "bona fide intention to use the mark in commerce." 15 U.S.C. § 1051(b)(3)(B).

263. In the U.S. Census, for example, "the federal government's official and principal position with respect to racial classification is self-definition." Tseming Yang, *Choice and Fraud in Racial Identification: The Dilemma of Policing Race in Affirmative Action, the Census, and a Color-Blind Society* 22 (Aug. 14, 2005) (unpublished manuscript, on file with the *Columbia Law Review*), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=783404.

264. See *Boswell v. Mavety Media Group Ltd.*, 52 U.S.P.Q.2d (BNA) 1600, 1604 (T.T.A.B. 1999) ("As a member of the group which is asserted to be disparaged or brought into contempt or disrepute by the mark BLACK TAIL, she has clearly demonstrated her standing in this proceeding.")

being disparaging, the mark might also be vulgar.²⁶⁵ If an examiner, intent on rejecting an application, can no longer rely on disparagement as a justification, it would not be difficult for the examiner to simply label the term as being offensive to the general public.

Such a shift, though possible, constitutes a severe disservice to the examiner's role as an official of the PTO. The proposed solution to self-disparaging marks relies on examining attorneys to do their jobs to the best of their abilities, rather than engaging in bad-faith efforts to produce outcome-determinative results. If an examiner is intent on blocking a particular mark from publication, then an examiner could improperly use any number of alternate justifications for denying registration, such as claiming that the proposed mark is likely to cause confusion with another mark already registered with the PTO.²⁶⁶ For examiners' evaluations to have any validity, a finding of scandalousness must be based upon a good-faith evaluation of the general public's shock and outrage toward a mark, not a surreptitious finding of disparagement.²⁶⁷ As federal employees, examining attorneys have a duty to conduct fair and proper evaluations.

2. *The Impropriety of "Special Treatment."* — A second criticism of a pure deference approach for self-disparaging marks is that providing discrete procedural benefits to members of particular groups based on characteristics such as race and religion impermissibly provides such groups "special treatment." The PTO, so the criticism goes, should treat all applicants neutrally, without regard for the applicant's race, gender, religion, or sexual orientation.

Such a criticism, however, is misdirected. Under a pure deference policy, an examiner is not consistently providing certain applicants with special benefits unavailable to all others. Rather, the policy instructs the examiner, in cases of disparagement, to take proper notice of the evidentiary value of the applicant's membership in the disparaged group. Because such membership inherently raises doubts about whether the mark is disparaging, and because examiners should resolve doubts in favor of publication, a pure deference policy merely ensures that examining attorneys treat such circumstances with proper evidentiary respect.²⁶⁸ At its

265. See Serial No. 78/281,746, Reconsideration Letter at 1, May 25, 2005 ("[T]he term DYKE is considered vulgar, offensive and/or disparaging.").

266. 15 U.S.C. § 1052(d) (barring registration of mark "which so resembles a mark registered in the [PTO] . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive").

267. See Oswald, *supra* note 48, at 290 ("When the courts and the [TTAB] use the terms scandalous or disparaging imprecisely or interchangeably, they confuse the very foundations of Section 2(a) []"); Zlotchew, *supra* note 14, at 230 (stating that confusion of scandalousness and disparagement "does a disservice to the statutory language, leads to injustice in the individual case . . . and makes for bad public policy").

268. See *supra* notes 234–239 and accompanying text for discussion of how an applicant's membership within a disparaged group automatically creates enough doubt to require publication.

core, a pure deference policy enforces what the current PTO policy of resolving doubts in favor of publication already recommends, yet too many examiners fail to recognize: A strong “doubt” automatically arises when an individual seeks to register a self-disparaging trademark.

3. *The Danger of Deferring to “Obvious” Slurs.* — A final criticism of a policy of pure deference is that it is too permissive, affording unwarranted respect to slurs that have not yet been reappropriated. For example, under the proposed deference policy, if a Jewish applicant seeks to register a mark containing the word “kike,”²⁶⁹ the examiner could not deny the application solely because the word “kike” is intrinsically disparaging to Jews. Critics may then ask: If the Jewish community is not currently reappropriating “kike” and the vast majority of Jews would find the term to be extremely disparaging, why should an examiner be powerless to block the registration of such a mark?

A policy of pure deference for self-disparaging marks, however, adequately addresses such concerns by allowing third parties to challenge a mark as disparaging at any time. For example, a Jewish person could freely challenge a mark containing the word “kike” as being disparaging, presenting the TTAB with evidence of such an understanding. The TTAB would then decide whether the mark is disparaging, having the opportunity to receive a full record from evidence presented by *both* parties. While it is tempting to establish different standards for “close” slurs which are at the end stages of reappropriation (such as “queer”) than for “clear” slurs which are at the beginning stages (such as “kike”),²⁷⁰ the essence of reappropriation is self-definition. The purpose of a pure deference policy is to respect the evidentiary value of an applicant’s use of a slur as indicating reappropriation at work, no matter how “obvious” the slur’s disparaging nature may seem to the examiner. Even if there is disagreement within a disparaged community over whether a term has been reappropriated, the unique importance of reappropriation in the construction of social identities mandates that the TTAB decide such issues with the benefit of a complete record, rather than an examiner’s reliance on a single definition from the *Merriam-Webster Online Dictionary*.²⁷¹

269. See Merriam-Webster Online Dictionary, at <http://www.m-w.com/cgi-bin/dictionary?book=dictionary&v=kike> (last visited Nov. 17, 2005) (on file with the *Columbia Law Review*) (defining “kike” as “usually offensive: Jew”).

270. While most would agree that most Jewish people would find the word “kike” to be extremely offensive, nonetheless there is evidence of Jews who seek to reappropriate the term. See, e.g., Annie Goldflam, *Queerer than Queer: Reflections of a Kike Dyke*, 36 J. Homosexuality 135, 135 (1999) (“I am both a Kike and a dyke, derogatory terms for Jews and lesbians, respectively, but which I here reclaim as proud markers of my identity.”).

271. See, e.g., Serial No. 78/432,597, Office Action Outgoing at 2, Attachment-1, Jan. 19, 2005 (THE BIG HEEB BREWING COMPANY) (rejecting application based solely upon definition of “hebe” from *Merriam-Webster Online Dictionary*).

CONCLUSION

A policy of pure deference for self-disparaging trademarks is ultimately a modest recommendation. Such a policy would not change the current standards examiners employ in evaluating other-disparaging marks, nor would it affect the disparagement standards the TTAB and courts use for *inter partes* proceedings brought by third-party opposers. Despite this limited scope, disparaged groups engaged in the active reappropriation of former slurs suffer real harms under the current regime—harms that strike at the core of their self-identities. Despite the PTO's noble intention to protect particular groups from harmful insults, its current application of disparagement analysis offers no safe harbor for the reappropriation of slurs. The longer it takes for a disparaged group to reclaim a former slur, the more harm the slur imposes upon its targets. Pure deference, however, strikes a stable balance between respecting an individual's right to self-define while still allowing challengers to stop the PTO from moving too quickly.

The reappropriation of slurs is not a mere exercise in linguistic gymnastics; rather, it is a potent strategy of identity creation and maintenance. The reclamation of language is a messy, controversial process, even within the communities where it takes place. Amid this upheaval, the current policy of disparagement evaluation allows an examining attorney to make critical decisions about whether an entire group has reappropriated a slur, informed by nothing more than a standard dictionary. While it might be true that lesbians feel insulted by the mark *DYKES ON BIKES*, the assumption that a dictionary resolves the debate more decisively than voices from within the lesbian community is an even greater insult.