



November 7, 2014
1:45 PM – 3:00 PM

Session 301: What Did You Just Call Me?!

Should the U.S. government be in the business of deciding what names we can call others? What about ourselves? The Native American plaintiffs in the Washington Redskins case say "yes," having obtained a historic cancellation of the Washington Redskins trademark by the U.S. Patent and Trademark Office after years of litigation on the basis that the mark is disparaging to Native Americans. Asian Pacific American (APA) rock band, The Slants, say "no." The band seeks to re-appropriate the term "slant" in connection with APAs by giving it a positive connotation through their music and activism, and has applied to register their name as a trademark. But the USPTO has denied registration for the past five years, deeming The Slants to be disparaging given the Asian ethnic identities of the band members, despite surveys, language experts, and APA community leaders supporting their case. The panelists, who include the founder and bassist of The Slants and the band's pro bono trademark counsel, will explore the trademark and First Amendment interests that must be balanced when determining whether a name is disparaging, and discuss where the line should be drawn when enforcing the Lanham Act prohibition against the registration of disparaging marks.

Program Chair & Moderator:

Karen Lim, *Partner*, Fross Zelnick Lehrman & Zissu, P.C.

Speakers:

Ronald Coleman, *Partner*, Goetz Fitzpatrick LLP

Naresh Kilaru, *Of Counsel*, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

Leticia Smith-Evans, *Interim Director, Education Practice*, NAACP Legal Defense & Educational Fund, Inc.

Simon Tam, *Manager and Founder*, The Slants

TMEP § 1203.1: Immoral or scandalous matter “In affirming a refusal to register a mark as scandalous under §2(a), the Court of Customs and Patent Appeals noted dictionary entries that defined ‘scandalous’ as, *inter alia*, shocking to the sense of propriety, offensive to the conscience or moral feelings or calling out for condemnation.

“The statutory language ‘scandalous’ has also been considered to encompass matter that is ‘vulgar,’ defined as ‘lacking in taste, indelicate, morally crude.’

“The meaning imparted by a mark must be determined in the context of the **current attitudes of the day**”

<p>APPROVED</p> <p>Int. Cl.: 41 Prior U.S. Cls.: 100, 101 and 107 United States Patent and Trademark Office Registered Oct. 30, 2007</p> <p>SERVICE MARK PRINCIPAL REGISTER</p> <p>DYKES ON BIKES</p> <p>SAN FRANCISCO WOMEN'S MOTORCYCLE CONTINGENT (CALIFORNIA CORPORATION) 633 CASTRO STREET SAN FRANCISCO, CA 94114</p> <p>WHERE TO DO THE SAME, THEREBY FOSTERING PRIDE IN A WIDE VARIETY OF SEXUAL ORIENTATIONS AND IDENTITIES, NAMELY LESBIAN, BISEXUAL AND TRANSGENDER, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).</p> <p>FIRST USE 6-0-1976, IN COMMERCE 6-0-1976. SER. NO. 78-281,746, FILED 7-31-2003. SHARON MEIER, EXAMINING ATTORNEY</p>	<p>12-10-2004 U.S. Patent & TMO/™ Mail Rpt#1 DL #67</p> <p>Applicant Name: Damon Wayans Applicant's Address: 9909 Topanga Canyon B #214, Chatsworth, CA 91311 Los Angeles, California 90036 Goods: Clothing; namely, headwear, caps, tops, shirts, T-shirts, sweatshirts, jackets, bottoms, pants, shoes, wristbands, headbands, underwear, socks</p> <p>The Mark:</p> <p>NIGGA</p> <p>NOT APPROVED</p>
<p>Int. Cl.: 3 Prior U.S. Cls.: 1, 4, 6, 50, 51 and 52 United States Patent and Trademark Office Registered Sep. 20, 2005</p> <p>TRADEMARK PRINCIPAL REGISTER</p> <p>F·A·G <i>Fabulous and Gay</i></p> <p>APPROVED</p> <p>GRAYSON FAIRBANKS, INC. (NEW YORK CORPORATION) PO BOX 16563 ROCHESTER, NY 14616</p> <p>FIRST USE 7-1-2004; IN COMMERCE 7-1-2004. SER. NO. 78-451,780, FILED 7-16-2004. DOMINIC J. FERRAIUOLO, EXAMINING ATTORNEY</p>	<p>Int. Cl.: 41 Prior U.S. Cls.: 100, 101 and 107 United States Patent and Trademark Office Registered June 29, 2004</p> <p>SERVICE MARK PRINCIPAL REGISTER</p> <p>HEEB</p> <p>APPROVED</p> <p>BLEYER, JENNIFER S. (UNITED STATES INDIVIDUAL) 81 VANDERBILT AVE. BROOKLYN, NY 11205</p> <p>FIRST USE 2-15-2001; IN COMMERCE 2-1-2002. SER. NO. 78-250,619, FILED 5-15-2003. RONALD AIKENS, EXAMINING ATTORNEY</p>
<p>Mail/Create Date Mar. 23, 2007</p> <p>UNITED STATES PATENT AND TRADEMARK OFFICE</p> <p>SERIAL NO.: 78558043 APPLICANT: HEEB MEDIA, LLC CORRESPONDENT ADDRESS: Jerald M. Tenenbaum, Esq. Fridman Law Group, PLLC Suite 505 185 Varick Street New York, NY 10014</p> <p>MARK: HEEB</p> <p>CORRESPONDENT'S REFERENCE/DOCKET NO.: CORRESPONDENT EMAIL ADDRESS: jerald@fridman.com</p> <p>NOT APPROVED</p> <p>*78558043*</p> <p>RETURN ADDRESS: Commissioner for Trademarks P.O. Box 1431 Alexandria, VA 22313-1431</p> <p>Please provide in all correspondence: 1. Filing date, serial number, mark and applicant's name. 2. Date of this Office Action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and e-mail address.</p>	<p>Int. Cl.: 41 Prior U.S. Cls.: 100, 101 and 107 United States Patent and Trademark Office Registered Nov. 23, 2004</p> <p>SERVICE MARK PRINCIPAL REGISTER</p> <p>QUEER EYE FOR THE STRAIGHT GUY</p> <p>APPROVED</p> <p>BRAVO COMPANY (NEW YORK LIMITED PARTNERSHIP) 2 PARK AVE., 11TH FLOOR NEW YORK, NY 10016 AND SCOUT PRODUCTIONS, INC. (MASSACHUSETTS CORPORATION) 119 BRAINTREE STREET BOSTON, MA 02134</p> <p>FIELD OF REALITY TELEVISION, IN CLASS 41 (U.S. CLS. 100, 101 AND 107). FIRST USE 7-15-2003; IN COMMERCE 7-15-2003. SER. NO. 78-304,405, FILED 9-23-2003. LINDA M. KING, EXAMINING ATTORNEY</p>

JIGGERING IT OUT AT THE PTO

From the **LIKELIHOOD OF CONFUSION**® BLOG | January 27, 2009

Oh, to be a hip, Jewish intellectual... property owner. Stick with me here.

A while back I was following the story of the PTO's refusal to register the mark NIGGA. As I put it then:

Forget "immoral or scandalous," which, as we have said before, is an increasingly hopeless position for national government to take on almost anything in this enlightened era. Interestingly, though, this one will probably stick. Political correctness — in this case, quite correct! (most of the time) — is the empty husk of what was once considered the public virtue of "decency."

No, the real problem is this: Can the Patent and Trademark Office register as a trademark a word that is, culturally (and almost legally) restricted for use to members of one race only — and that is considered practically a "hate crime" for members of other races to utilize? (As opposed to trademarks that no one can pronounce!) Now that seems as if it would be a bad policy decision for any government agency, much less one (i.e., the PTO) that takes eight months just to queue up a trademark application — no offense intended.



Now come the heeb — or, more specifically, racy, but not racist, Heeb magazine — and, in very much the same vein, the TTAB has bounced its appeal of the PTO's refusal to register a (second) trademark for HEEB, on the grounds that the term heeb disparages persons. Hebrew persons, of course. Heeb-rews. Juice.

A similar argument to that utilized in connection with the NIGGA application was attempted by *Heeb*, mainly along the lines of, hey, we're hip, we're past all that, we're taking the oppressive language of past repression and wearing it like a badge of pride.

I think* that's a very good argument. And I think the whining of the usual suspects, professionals in the outrage and offendedness fields, cited in the opinion as tisk-tisking this and the previous (successful, as it turns out) application for a HEEB registration, is mostly pathetic.

In fact, unlike NIGGA or "nigger," the turn-of-the-century-vintage slur *heeb* has lost virtually all its punch or offense. When you want to insult Jews these days, in fact, you just call them "Zionists Nazis" — that gets you, not opprobrium, but a job at the BBC or Columbia University.

In short, *bubbele*, the PTO — which has found a way to register numerous terms once considered derogatory when referring to those, fabulous or otherwise, who have adopted non-standard sexual practices — can't open this Pandora's box. The PTO acknowledges, implicitly, the objectively demonstrable fact that words that once shocked and offended are now ironic, defiant playthings of the hip, comfortably assimilated (in a multi-culti way) descendants of the former targets of some kinds of opprobrium. But the PTO ignores this fact when it comes to trademarks for kikes, *shvartsers* and the rest of us.



Well, it doesn't ignore it, or the inconsistency involved, so much as hide behind a thick lens of pretended obtuseness, relying on "proof" of offensiveness such as outdated dictionaries and statements by such cultural barometers as the Anti-Defamation League.

No, it's okay to "get it" when it comes to alternative-lifestyle terminology. But the PTO is, as we said, boxed in on the issue of racial slurs. For it is above all terrified of the prospect of what would happen politically if it issued a NIGGA or NIGGER trademark registration for anything, anyone, any time.

And if they can't have theirs, the Jews can't have ours, either. Sorry, my heeb.

—

* I was consulted by *Heeb* in connection with this appeal, but I was not retained. You know — they wanted a **bargain**.

A DIFFERENT SLANT

From the **LIKELIHOOD OF CONFUSION**® BLOG | April 7, 2011

Does this story in the *Northwest Asian Weekly* about the trademark registration woes of a rock band called The Slants sound familiar?

The Slants, whose members are of Asian descent, have amassed fans nationwide, taking the stage at dive bars, Asian festivals, anime conventions, and even serving on panels to discuss racial stereotypes.

But behind the scenes, the band is fighting a battle with the United States Patent and Trademark Office USPTO. The office has twice denied The Slants' request to obtain federal trademark registration of its name, or "service mark," on the grounds that it is "disparaging to people of Asian ethnicity."

The band denies that its name is offensive to Asians and is preparing to file a second appeal.

Good luck with that, fellows. I've addressed this issue here before in the context of such charming would-be trademark registrations such as HEEB and NIGGA, rejected as scandalous and offensive by the same PTO that granted that coveted registration status to such fabulous acts as QUEER EYE FOR THE STRAIGHT GUY, DYKES WITH BIKES and others.

All those thisses have to do with alternative lifestyles, once considered highly scandalous but now quite socially acceptable. Ah, but nicknames to describe those who so alternate? Perfectly fine when adopted by the object of former derision with "pride."

That rule, however, does not apply to ethnic groups. As I said in the above-linked posts regarding the HEEB and NIGGA applications, racism remains the third rail of American bureaucratic practice — ironic self-descriptive pride notwithstanding.

Is there any good policy reason behind this? Or is it, as I suggested in the NIGGA post, merely a way to avoid even having to read, much less type out, the word "nigger" in a government building near Washington, DC?

That is not a good reason.



UPDATE AND CLARIFICATIONS ABOUT THE SLANTS APPEAL

From the **LIKELIHOOD OF CONFUSION®** BLOG | October 25, 2013

There has been some press coverage of the intention of my client, The Slants, to appeal the denial of their application to register THE SLANTS. Some of what has been reported is inaccurate or imprecise. This is not the place to argue the appeal, but because the case has garnered some extra-judicial attention and there has been a great deal of extra-judicial misunderstanding, here is a bit of clarification:



Some reports and commentators have given the impression that the applicant is fighting the PTO's conclusion that "slants" is an ethnic slur, or that the Slants argue that it was one in the past but is not one any more, along the lines of the unsuccessful TTAB appeal of the PTO's denial of the HEEB application.

This is error. That was not the applicant's argument in the TTAB with respect to the application that was actually denied in this proceeding.

The assertion that "slants" is not an ethnic slur, based on evidence that contradicts what the PTO claimed as the evidentiary basis for its determination, **was** the applicant's argument — but that was in an **earlier** application for the same trademark. Indeed, rejection of that argument was, we assert, one basis of the TTAB's affirmance of the PTO's refusal to register. We argued in our TTAB brief that in refusing to allow the registration based on the Slants' second application — the one **before the TTAB** — the PTO rejected an argument the Slants did **not** make in its response to the Office Action.

This is not to say that the applicant concedes the underlying substantive point. It does not, but this is not the subject of the appeal. Rather, we argued before the TTAB that the PTO failed to base its "disparaging mark" refusal on competent evidence pursuant to the Trademark Manual of Examining Procedure (TMPEP).

The burden of proof with respect to a denial under Section 2(a) is on the PTO. But the PTO relied on factual assertions about the applicant's use that were stale, not having been updated since the first application; it merely cut and pasted these, so that the PTO failed even to consider if there was any change in "the actual use of the mark" since the first application and refusal. Because of this, we argued, the actual use of the mark did not seem to matter as long as the person using it was Simon Tam, the Asian-American leader of the band. To the extent his ethnic identity provided, however, "all the use we need to know" — i.e., use by this Asian, or arguably any Asian, of an otherwise neutral word rendered that word "disparaging" — we argued that this was not a proper legal standard.



We also argued that the PTO's refusal was based on very unreliable third-party sources and, contrary to the requirement of the TMPEP, that it cherry-picked its citations to reach a predetermined conclusion. You can see how we attempted to demonstrate this in the brief, too.

The planned appeal will address the TTAB's disposition of these arguments, as well as other issues concerning the statute and its application such as may be considered by an appellate court.

Finally, as the TTAB opinion itself made clear, it made no determination — nor could it — as to whether THE SLANTS is "a trademark" of The Slants — which it most assuredly is.

TRADEMARKS, FREE SPEECH AND POLITICS

From the **LIKELIHOOD OF CONFUSION**® BLOG | May 14, 2014:

Says Prof. Glenn Reynolds at Instapundit.com:

TRADEMARK LAW SEEMS INCREASINGLY POLITICIZED. Eugene Volokh comments: “My tentative view is that the general exclusion of marks that disparage persons, institutions, beliefs, or national symbols should be seen as unconstitutional.”

Perhaps. But the STOP THE ISLAMIZATION OF AMERICA case was not the one to test that proposition, for a couple of reasons. As I explained in my original post on the subject of this appeal:

Forget the politics of this. Besides the fact that I have no idea why these two thought a word trademark (as opposed to protection for the logo) was needed here — being dubious, as I am in general, to the extension of trademark protection to words people say to mean things in English — I’m not too surprised about the outcome of their application on the “scandalous or offensive” denial.

This is because, as I’ve written before (and of course I’m in good company), while the PTO’s criteria for “scandalous and offensive” denials under Section 2(a) of the Trademark Act are a conceptual and a practical mess, the outcome’s certainly predictable when it comes to racial, ethnic or other “protected class” categories: Only the politically correct need apply.

That’s a “criterion” Pam and Bob are not going to meet!

I have elaborated on that point considerably in light of my involvement in the appeal over the PTO’s denial of the trademark THE SLANTS, of course.

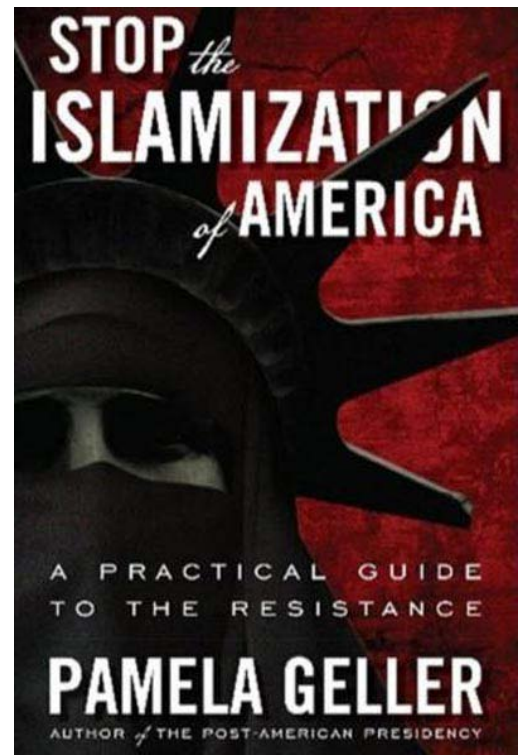
And then there’s don’t-forget-the-politics-of-this: The ones here just stunk too much.

No less importantly, so did the “trademark” application. What were the “goods or services” described in the application? “Providing information regarding understanding and preventing terrorism.”

Really? Was Pamela going use that as a trademark? (She already used it as the title of a book, but that, it is well established, is not an appropriate subject for trademark protection.) Or did she just want to coin a phrase and somehow monetize it, consistent with the widespread public misunderstanding (TRAYVON trademark, anybody?) of what trademarks are and under what circumstances they’re entitled to protection?

Eugene Volokh, of course, is right about the politicization of trademarks — in both directions. The TTAB’s decision in the SLANTS case, discussed in detail in our appeal brief to the Federal Circuit, wrestles with the issue regarding the PTO’s political correctness quite explicitly. But applicants for trademark registrations that are merely political statements have some learning to do, too.

Well, I’m trying my best!



26th Annual NAPABA Convention
November 6-9, 2014
What did you just call me?!

Naresh Kilaru
Of Counsel, Finnegan

Section 2(a) of the Lanham Act bars the registration of any mark that “may disparage... persons, living or dead, institutions, beliefs or national symbols, or bring them into contempt or disrepute.” 15 U.S.C. § 1052(a). The burden is on the Examining Attorney or on the party challenging an application/registration to prove that a mark falls within the Section 2(a) prohibition. Significantly, the determination of whether a mark is disparaging is not made in a vacuum, but with respect to the particular goods and services covered by the application/registration. For instance, the Trademark Trial and Appeal Board has found the word SQUAW to be disparaging in connection with clothing because the term when used in connection clothing has no connotation other than as a disparaging term for Native American women, but found that SQUAW was not disparaging in connection with ski-related goods because in that context the mark would likely be understood as a shorthand reference to the famous ski resort located at Squaw Valley, California. *In re Squaw Valley Development Co.*, 80 USPQ.2d 1264 (TTAB 2006).

Below are summaries of several recent decisions involving Section 2(a).

***Blackhorse v. Pro-Football, Inc.*, 111 USPQ.2d 1080 (TTAB 2014)**

In a high-profile precedential decision, a divided Trademark Trial and Appeal Board panel cancelled six REDSKINS trademarks for various entertainment services including professional football contests and cheerleading because the marks contained matter which may disparage a substantial composite of Native Americans. After conspicuously noting that its decision affected *registration*, not use, of the REDSKINS marks, the Board recounted the first, decades-long challenge to the marks, commencing in 1992 and culminating in a D.C. Circuit Court of Appeals’ decision that laches barred the petitioners’ claims. *Pro-Football, Inc. v. Harjo*, 90 USPQ2d 1593 (D.C. Cir. 2009). The *Blackhorse* petitioners filed this cancellation proceeding

while *Harjo* was pending and focused their claim on whether the term REDSKIN was disparaging to Native Americans.

The test for disparagement in this case was two-pronged: “(a) 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 goods and services identified in the registrations? [and] (b) Is the meaning of the marks one that may disparage Native Americans?” Both questions were answered *as of the various dates the marks were registered*, considering the views of Native Americans, not the American public as a whole. The Board also noted that a “substantial composite” is not necessarily a majority of the referenced group.

With regard to the first prong, Pro-Football argued that the term REDSKINS now has a separate meaning—the name of a football team. But this meaning did not affect the Board’s analysis of the “meaning of the matter in question.” The Board examined the Redskins logo, marching band and Redskinettes costumes, and Washington Redskin press guides to determine that Pro-Football “made continuous efforts to associate its football services with Native American imagery.” Therefore, REDSKINS, as used in connection with professional football, retained its Native American meaning.

Turning to the second prong, the Board noted that use of a mark in context with certain goods or services can (1) render an innocuous term disparaging (KHORAN used for wine disparages American Muslims), (2) strip the disparaging meaning from an otherwise disparaging term (Squaw Valley used on ski-related goods relates to the geographic location rather than Native American women), or (3) have no effect on a term’s disparaging meaning (racial slurs or similar pejorative, derogatory terms). Because REDSKINS kept its Native American meaning when used in connection with football services, it did not belong in the second category. Petitioners argued, and the Board agreed, that REDSKINS, as a racial slur, belonged in the third, rather than first, category.

The Board considered many dictionary definitions listing REDSKIN as offensive or disparaging and its marked disappearance from written and most spoken language in the mid-1960’s to conclude that REDSKIN was disparaging during the relevant time period of 1967-1990. The Board also considered a resolution passed by the National Congress of American

Indians (NCAI) in 1993 regarding the “pejorative, derogatory, denigrating, offensive, scandalous, contemptuous, disreputable, disparaging and racist” nature of the term REDSKIN. Even though the resolution was passed after 1990, the group’s prior efforts to change the Washington Redskins’ name, together with the resolution, evidenced that Native Americans found the term disparaging during the relevant time period. Because deposition testimony and newspaper articles showed that NCAI represented approximately thirty percent of Native Americans from 1967-1990, the Board concluded that a substantial composite of Native Americans found the term REDSKIN disparaging.

The dissent took issue with the sufficiency of the evidence supporting the petitioners’ claims, noting that the expert testimony did not involve the Native American viewpoint of the term REDSKIN. The dissent also pointed to several examples of *Native Americans* using REDSKIN in connection with football, noting that “the context in which ‘Redskin’ is used changes the perception of the term.” Finally, the dissent did not find the dictionary evidence convincing and gave little probative value to the evidence establishing that NCAI represented a “substantial composite” of Native Americans during the relevant time period.

In re Geller, No. 13-1412 (Fed. Cir. May 13, 2014)

The Federal Circuit refused to register STOP THE ISLAMISATION OF AMERICA for “[p]roviding information regarding understanding and preventing terrorism,” because the mark contained disparaging matter in violation of Section 2(a) of the Lanham Act.

According to the Board, the term “Islamisation” has both a religious meaning and a political meaning. The religious meaning of Islamisation is “the conversion or conformance to Islam,” and the political meaning is “a sectarianization of a political society through efforts to ‘make [it] subject to Islamic law.’” The Board found the mark disparaging to a substantial composite of American Muslims under both meanings.

On appeal, the Federal Circuit upheld the Board’s findings. The two-pronged test for determining whether a mark is disparaging requires considering: (1) the likely meaning of the matter in question, taking into account dictionary definitions, the relationship of the matter to the

other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods and services; and (2) if that meaning refers to identifiable persons, beliefs, or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

With regard to the first prong, Appellants argued that the political meaning of “Islamisation” was its sole likely meaning. The Court rejected this argument, holding that the term had a religious meaning as well. The Court then shed light on the types of evidence appropriate for determining the meaning of allegedly disparaging terms. The Board properly relied on dictionary definitions of “Islamisation” listing “to convert” or “conform” to Islam as primary definitions, select essays from Appellants’ website, and comments posted on Appellants’ website to determine the religious meaning of the term. The essays showed that Appellants used the mark in the context of stopping the spread of the Islamic faith and the comments, while of more limited probative value, also reflected the religious meaning of Islamisation and evidenced a desire to stop the spread of Islam in America. Academic materials and congressional testimony established the political meaning as *a* meaning of “Islamisation,” rather than its *sole* meaning because these materials were less widely available and did not reflect the general public’s understanding of the term. Appellants agreed that both meanings of “Islamisation” referred to all American Muslims and conceded at oral argument that the mark was disparaging under the religious meaning. The mark was also disparaging under its political meaning because political Islamisation does not require violence or terrorism and associating peaceful Islamisation with terrorism would be disparaging to a substantial composite of American Muslims.

In re Heeb Media, LLC, 89 USPQ.2d 1071 (TTAB 2008)

The Examining Attorney refused registration under Section 2(a) on the ground that Applicant’s HEEB mark is disparaging to a substantial composite of the referenced group, namely, Jewish people. Applicant appealed the Examining Attorney’s decision. On appeal, the Examining Attorney contended that the word HEEB is a highly disparaging reference to Jewish people, that it retains that meaning when used in connection with Applicant’s goods and services,

and that a substantial composite of the referenced group finds it to be disparaging. In support of her position, the Examining Attorney submitted dictionary definitions indicating that “Hebe” and “Heeb” are derogatory or offensive terms for Jewish people, excerpts retrieved from the NEXIS database discussing the derogatory or offensive nature of the term HEEB (including in connection with Applicant’s HEEB magazine), and evidence of Applicant’s acknowledgement that some Jewish people have been offended by the use of the HEEB mark in connection with its magazine. In support of its position that the HEEB mark is not disparaging, Applicant submitted letters from various individuals representing prominent Jewish organizations, or in their individual capacity, discussing Applicant’s use of HEEB, as well as advertisements in Applicant’s HEEB magazine allegedly showing the acceptance of the term by a wide range of Jewish organizations, and a list of Jewish organizations that support Applicant’s publication. Applicant also noted that the 1998 edition of the Cassel Dictionary of Slang defines “heeb” as “a derogatory term for a Jew,” but the 2005 second edition includes the additional entry “[1920’s+] Jewish,” suggesting a change in the perception of the term in recent years.

To determine whether the HEEB mark is disparaging, the TTAB applied a two-part test: (1) what is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and (2) if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

With respect to the first prong, the TTAB found that there was no dispute that HEEB means a Jewish person and that it had no other meaning pertinent to clothing or entertainment services. Regarding the second prong, the TTAB found that the dictionary definitions unanimously underscored the derogatory nature of the HEEB mark. Further, although Applicant submitted evidence showing that certain organizations and individuals did not believe the HEEB mark was disparaging, the TTAB noted that there was also substantial evidence that other members of the Jewish population did consider the mark to be derogatory. The TTAB explained that its consideration of whether the term is disparaging is not restricted to the perception of Applicant’s magazine subscribers who have no objection to HEEB as the title of Applicant’s

magazine, but rather takes into account the views of the entire referenced group who may encounter Applicant's clothing and advertising for its entertainment services in any ordinary course of trade for the identified goods and services. The TTAB also relied on an article in which Applicant's founder acknowledged that certain prominent members of the Jewish community were offended by the name of its HEEB magazine.

Based on this and other evidence, the TTAB found that, among the older generation of Jews, the term retained its negative meaning, and that the postcollege-age Jewish population constituted "a substantial composite" of the Jewish population. The TTAB rejected Applicant's argument that a minority opinion should not veto registration of a particular mark, noting that while there is no fixed number or percentage, it is well established that a "substantial composite" is not necessarily a majority. Finally, the TTAB made clear that evidence that Applicant had good intentions with its use of the HEEB mark did not obviate the fact that a substantial composite of the referenced group found the term objectionable. The TTAB affirmed the refusal to register.

Although an applicant may intend to transform the meaning of a mark, if that mark continues to be viewed as disparaging by a substantial component of the referenced group, it will be barred registration under Section 2(a).

***In re Lebanese Arak Corp.*, 94 USPQ2d 1215 (TTAB March 4, 2010)**

The TTAB identified disparagement under Section 2(a) of the Lanham Act as the proper ground for refusal of registration based on perceived offense to religious or ethnic sensibilities and clarified that disparagement must be considered from the standpoint of a substantial composite of the referenced group rather than the public as a whole.

In a 3-2 decision, the TTAB affirmed the refusal of registration of the mark KHORAN for wine on disparagement grounds under Section 2(a) of the Lanham Act based on the mark's similarities to the term "Koran," which is the sacred text of Islam, and the fact that alcohol is prohibited by the tenets of Islam. The majority held that use of the name of the sacred Islamic text for a substance prohibited by that religion would be disparaging to Muslims.

Applicant Lebanese Arak Corp. applied for registration of KHORAN for “alcoholic beverages, namely wines.” The Examining Attorney refused the application on grounds of disparagement under Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a). Specifically, the Examining Attorney concluded that KHORAN is the phonetic equivalent of “Koran,” which is the sacred text of Islam, and that because the Koran forbids consumption of alcoholic beverages, use of KHORAN for wine is disparaging to the beliefs of Muslims. The Examining Attorney rejected Applicant’s position that because the English translation of the Armenian word KHORAN is “alter,” KHORAN had an entirely different meaning and commercial impression than “Koran.” Applicant appealed the Examining Attorney’s decision to the TTAB.

In a 3-2 decision affirming the Examining Attorney’s refusal of registration, the TTAB majority first clarified that disparagement, not scandalousness, under Section 2(a) of the Lanham Act is the proper ground for refusal of registration based on perceived offense to religious or ethnic sensibilities. Disparagement is determined under a two-prong test, namely: (1) what is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods and services; and (2) if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

The majority began its analysis with the second prong of the test, finding “no real dispute” that the Examining Attorney had met its burden on that prong. In particular, the majority relied on the fact that the Koran is the sacred text of Islam and Islamic authorities view alcohol as a prohibited substance. Thus, the crux of the second prong was whether use of the name of the holy Islamic text for a substance banned by that religion would be disparaging to Muslims and their beliefs. The majority answered this question in the affirmative.

Turning to the hotly contested first prong, the likely meaning of the matter in question, the majority held that the public would regard Applicant’s KHORAN mark as referring to the holy text of Islam. First, the majority concluded that KHORAN was the phonetic equivalent of “Koran.” Second, the majority pointed out that Koran has many alternate spellings and thus the

public was likely to believe that KHORAN was yet another alternate spelling. Third, the majority acknowledged that people do, in fact, use “Khoran” as an alternate spelling for “Koran” based on Internet evidence from blogs and web articles. Fourth, there was no evidence that people other than those who speak Armenian were likely to recognize KHORAN as the Armenian word for “alter.”

Finally, the majority rejected the dissent’s position that the meaning of Applicant’s mark under the first prong must be determined from the standpoint of the general public, rather than that of a substantial composite of the referenced group. The majority first noted that the result would be the same here regardless of whether it considered how the mark would be perceived by Muslim Americans or the public in general due to the relative renown of the Koran. However, in limiting the scope of the inquiry to a substantial composite of the referenced group, the majority focused its reasoning on hypothetical situations in which a term or symbol would be clearly understood by members of a particular religious group as being significant to their worship or beliefs, but would not be known or understood by the general public. The majority refused to interpret the disparagement test in a way that would ignore such situations, holding that the proper analysis of the meaning of the mark under the first prong is from the standpoint of a substantial composite of the referenced group.

The majority concluded that KHORAN would be recognized as the name of the holy text of Islam and that the use of that name for wine would be disparaging to the beliefs of Muslims Americans. Accordingly, the majority affirmed the refusal of registration under Section 2(a) of the Lanham Act.

In The United States Patent and Trademark Office

Applicant:	Simon Shiao Tam
Mark:	THE SLANTS
Serial No.:	77952263
Filing Date:	March 5, 2010

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Attn: Mark Shiner, Examining Attorney
Law Office 102

AMENDMENT AND REQUEST FOR RECONSIDERATION

Dear Commissioner:

This Request for Reconsideration is being filed in response to the Office Action dated December 23, 2010.

AMENDMENT TO APPLICATION

At the outset, Applicant amends the identified goods and services (in International Class 41) in Application No. 77952263 to read as follows:

“Live performances by a musical group that is comprised, in majority, of Asians.”

INTRODUCTION

In an Office Action dated June 11, 2010 (Office Action, 06/11/10), the Examining Attorney initially refused registration of Application No. 77952263 for the mark “THE SLANTS” (“Applicant’s Mark”) under Trademark Act Section 2(a), 15 U.S.C. § 1052(a), on the grounds that Applicant’s Mark is disparaging to persons of Asian ethnicity. Applicant submitted a Response to the Office Action on December 3, 2010, and a Final Office Action was issued on December 23, 2010 (Office Action, 12/23/10), refusing registration on that same basis.

Applicant now timely submits this Request for Reconsideration, and has concurrently filed an appeal of the Examining Attorney's refusal with the Trademark Trial and Appeal Board.

As set forth hereinafter, Applicant respectfully requests reconsideration on the basis that Applicant's Mark is not considered disparaging by a substantial composite of the referenced group, and Applicant here provides substantial evidence to support that position.

BACKGROUND

Applicant's group, *The Slants*, is a dance-rock musical group that is well-known within the Asian community. Second Declaration of Simon Tam (attached as Exhibit A) ("Second Tam Declaration") at ¶ 1. All members of The Slants are of Asian Pacific Islander (API) descent. *Id.* The group plays on average 125 shows per year. *Id.* Each year, a number of the group's performances take place in front of audiences exceeding 10,000 attendees. *Id.* They are endorsed by Fender Musical Instruments, Red Bull, Dunlop, and many other notable companies. *Id.*

While the appeal of the group spans across all ethnic backgrounds, the group is especially recognized and celebrated within Asian community. *Id.* at ¶ 2. Their debut album, *Slanted Eyes, Slanted Hearts*, was listed in the top 5 Asian-American albums of 2007 by AsiaXpress. *Id.* The group has also established itself as one of the most well-known performers within the anime (Japanese animation) convention circuit, both nationally and abroad. *Id.* Finally, the group has been widely heralded in the Asian American press and has been featured in many of the largest Asian American festivals in the county. *Id.* Each year, The Slants are involved with events that specifically center on the celebration of Asian and Asian American culture. The yearly cumulative attendance at these events surpasses 500,000. *Id.*

ANALYSIS

Applicant's Mark, as used in connection with Applicant's identified entertainment services, is a positive term of self-reference that promotes Asian cultural pride and identity. Such use by Applicant is not considered by a substantial composite of persons of Asian ethnicity to be disparaging. In fact, as explained below, the exact opposite is the case: people of Asian ethnicity overwhelmingly *support* Applicant's use of Applicant's Mark. Accordingly, Applicant's Mark cannot be denied registration on the grounds that it is disparaging. Further, even if there were some doubt as to whether Applicant's Mark is disparaging, such doubt must be resolved in favor of Applicant and Applicant's Mark must be published for opposition.

Determining whether a mark is disparaging requires application of the following two-step analysis:

- (1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other

elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and

- (2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

In re Squaw Valley Dev. Co., 80 USPQ2d 1264, 1267 (TTAB 2006) (citing *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1740-41 (TTAB 1999) (“*Harjo I*”), *rev’d on other grounds*, 284 F. Supp. 2d 96, 68 USPQ2d 1225, 1248 (D.D.C. 2003) (“*Harjo IP*”), *remanded*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), *and aff’d*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert denied*, 130 S. Ct. 631 (2009)). On the question of whether a matter may be disparaging, the general public’s views are irrelevant. *Harjo I* at 1739 (“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.”). In determining whether a mark is disparaging, the PTO strongly prefers that doubts be resolved in favor of the applicant and that the mark be published:

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.

In re In Over Our Heads Inc., 16 USPQ2d (BNA) 1653, 1654-55 (T.T.A.B. 1990).

The examining attorney has the burden of proving 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)]”). The mark at issue should be considered “in the context of contemporary attitudes” and while keeping in mind changes in social mores and sensitivities. *Id.* at 1371. Finally, examining attorneys should take care not to substitute their own views for those of the referenced group. *See In re Hines*, 32 USPQ2d (BNA) 1376, 1377 (T.T.A.B. 1994) (in reversing a refusal to register a mark that allegedly disparaged Buddhists, the TTAB made clear that the PTO should “avoid interposing its own judgment for that of the Buddhists”).

I. The Examining Attorney Has Not Established That Applicant's Mark is Disparaging

In the Office Action, 12/23/2010, Examining Attorney introduces additional evidence purported to support the refusal to register the Mark. However, like the evidence presented in the Office Action 06/11/10, this evidence is unconvincing. It does not establish that “slant” is a disparaging term, nor does it establish that a substantial composite of the referenced group finds Applicant’s Mark to be disparaging. Accordingly, the Examining Attorney has not met the required burden of proof.¹

As in the Office Action, 6/11/2010, the Examining Attorney introduces wiki (user-edited) sources to argue that the term “slant” is, by itself, a disparaging racial epithet. However, the very nature of these sources – sources which are edited by users themselves - renders them of dubious reliability. More importantly, relying on sources such as Urban Dictionary and Wikipedia does not paint a complete picture (or, in this case, even an accurate picture) of how the word is used in contemporary society. As explained below, a more comprehensive analysis reveals that the term “slant” is effectively no longer a term of disparagement, and is indeed with more and more frequency being used in a casual self-referential manner by people of Asian descent.

The Examining Attorney also submits an article concerning controversy over a physical gesture by country music performer Toby Keith. However, this article concerns a contextual physical gesture, and not the intrinsic definition of a word. To that end, the article’s context (*i.e.*, a white country western performer using his fingers to make his eyes appear slanted) is so far removed from the one at hand that it is difficult to see how one could plausibly argue that the article says *anything* that could be of use in the present matter. In essence, the Examining Attorney is using an instance of a contextual disparaging gesture, to make the case that a term itself is intrinsically disparaging. However, the flaw with the logic behind this argument, is that any racial, national, or ethnic epithet (and by extension, a physical gesture) can be used in a derogatory or offensive way, if, in context, offensiveness is clearly conveyed. *See e.g.*, Expert Report of Ronald Butters, Phd. (attached as Exhibit B) (“Butters Report”) at ¶ 16; Expert Report of Charlton McIlwain, Phd., & Stephen Caliendo, Phd. (attached as Exhibit C) (“Survey Report”) at ¶ 11 (“[A]ny term has some potential to be disparaging depending on the intention of its user...”). This use, however, is not evidence that a word itself is intrinsically disparaging or derogatory, or that the word itself will be received as offensive by the persons it is intended to describe. *Id.* Indeed, about all that can be said about the Toby Keith article, is that supports the proposition that Asians take offense when a white country-music performer attempts to ridicule them. This is, of course, not surprising, nor does it establish that there is anything necessarily disparaging about the term, THE SLANTS, either intrinsically, or when such term is used by an Asian group that recognizes and promotes Asian identity.

¹ Applicant must also respectfully submit that the provisions § 2(a) of the Lanham Trademark

Finally, as further evidence in support of his position that “slant” is a disparaging term, the Examining cites a MANAA (Media Action Network for Asian Americans) article. A closer read of the materials, however, reveals that they have been presented in a manner that takes them completely out of context. Specifically, in the article the author is talking about the use of phrases in Hollywood. In fact, Examining Attorney’s use of the article completely misses the point of the article, as the article is introduced by the following explanation: “This list is not intended as a bunch of ‘thou shalt-nots’ designed to inhibit the creative imagination. To the contrary, it is designed to help Hollywood’s creative minds to think in new directions - to help our storytellers to create more interesting roles for actors by avoiding, old, stale images.”

The Examining Attorney also introduces evidence intended to support his argument that The Slants’ use of the name is considered disparaging by Asians. However, again, like the evidence concerning the definition of the term “slant,” this evidence is unconvincing. For instance, the Examining Attorney mentions that “the band notes that some people called them racists shortly after posting a classified ad for band member’s that included the band’s name.” In doing so, the Examining Attorney is suggesting that the band was criticized because of its name. However, this is simply untrue. The reality is that the referenced accusations were made by non-Asians who took issue with Mr. Tam seeking band members of Asian descent; the accusers were not taking issue with the band’s name itself. Second Tam Declaration at ¶ 2.

The Examining Attorney also states that “rarely does an article introduce the band without commenting on the controversial nature of the band’s name.” In response, Applicant must first note that the test for disparagement is not whether a name is “controversial”; the ultimate question is whether the name is considered *disparaging* by members of the *referenced group*. In addition, Applicant takes issue with the accuracy of the Examining Attorney’s statement, but, more importantly, to whatever extent that the Examining Attorney’s statement *is* factually accurate, such statement completely misses the proverbial “elephant in the room,” namely, that the Asian press is demonstrating its support for the band by featuring and promoting the band in those articles to begin with.

Additionally, the Examining Attorney cites to a single online forum post from an individual who claims to be offended by the band’s name. In response Applicant must emphasize that this is nothing more than a single, *anonymous* post on an obscure forum that is not a part of the Asian press or community. Accordingly, it is hardly the type of evidence from which one could reliably draw conclusions about the views of a “substantial composite” of Asians. In fact, it doesn’t actually say *anything* about how *any* Asian feels about the issue.

Finally, the articles concerning the Asian American Youth Leadership Conference do not paint a complete picture of the events surrounding Applicant’s scheduled speaking appearance at the conference, and in some respect are even inaccurate. Second Tam Declaration at ¶¶ 4-6; Second Declaration of Rev. Joseph Santos-Lyons (attached as Exhibit D) (“Second Santos-Lyons Declaration”) at ¶¶ 3-6. In February 2009, Mr. Tam was asked to be the keynote speaker for the event and The Slants were invited to perform at the event as well. Second Lyons Declaration at

¶ 3. However, the AAYLC subsequently became aware of concerns from Portland Christian High School that the band’s music might contain objectionable lyrics. Second Tam Declaration at ¶ 4. While the AAYLC ultimately found nothing objectionable about The Slants’ lyrical content, the AAYLC nonetheless decided that it would withdraw the invitation to have The Slants perform. Second Santos-Lyons Declaration at ¶ 4. This decision was based on wanting to alleviate the concerns regarding the lyrics, as well as on the ultimate realization that, due to budget limitations, the AAYLC would not be able to accommodate The Slants’ performance logistically. *Id.* The decision was not based on the name of the group. *Id.*

One of the event sponsors, the Oregon Commission on Asian Affairs (OCAA), was concerned about involving The Slants, the OCAA indicating that some state legislators viewed the term “slant” as an offensive slur. *Id.* at 5. The OCAA’s primary concern was that these state legislators might be upset if the names “OCAA” and “The Slants” appeared together in written materials. *Id.* Originally, the AAYLC was going to return the OCAA sponsorship and keep Simon Tam as the keynote speaker. *Id.* However, with the OCAA (potentially) not supporting the event, the AAYLC was worried that other state groups might be hesitant to send their sponsorship support, and ultimately decided to choose another speaker. Second Tam Declaration at ¶ 6. This was one of the most difficult decisions reached by the AAYLC and was one that was regretted by both the AAYLC and members of the OCAA. Second Santos-Lyons Declaration at ¶ 5. Moreover, Mr. Tam was still involved with the planning team, as a facilitator, and The Slants still sponsored the event. Second Tam Declaration at ¶ 6. In addition, The AAYLC still promoted The Slants on its website, in the AAYLC 2009 magazine, and in all of the AAYLC’s event promotional materials which were distributed to students, chaperones, the OCAA board, as well as Asian American businesses throughout Oregon. *Id.*; *See also* organizational sponsors page of AAYLC brochure, wherein Simon Tam and The Slants are expressly thanked (attached as Exhibit E). Even after these materials were distributed, neither the AAYLC nor the OCAA received any complaints. Second Tam Declaration at ¶ 6; Second Santos-Lyons Declaration at ¶ 6. The AAYLC was proud to have The Slants involved with the event and had no hesitations in publicly acknowledging their relationship with the band. Second Tam Declaration at ¶ 6. Finally, Paul Van Mai (the AAYLC chair) later informed Mr. Tam that the decision to remove Mr. Tam as a speaker was a mistake because having someone from The Slants as a keynote would have elevated the overall experience for the Asian American students involved. *Id.*

In summary, the “controversy” surrounding the OCAA incident was borne out of nothing more than concern that some members of the state legislature (as opposed to Asians themselves) would find the name offensive. Thus, as only the views of the referenced group are at issue in this matter, the OCAA incident has no bearing on this matter. However, even if the OCAA incident matter *does* somehow bear on this matter, Applicant must reiterate that the test for whether a group’s name is disparaging involves determining whether a *substantial composite* of the referenced group would find the name disparaging. By relying on this one instance, the Examining Attorney is allowing the actions of a single commission to in effect carry a national veto, even where the mark in question has been featured and promoted without controversy in over 25 Asian festivals, including the largest Asian American festivals in the country.

II. Applicant's Mark Is Not Disparaging

As explained above, the Applicant's Mark must be evaluated in the context of contemporary views, and not in context of what the term might have meant generations ago. One of the fundamental truths of linguistics is that human languages continually change. Arguably, the term "slant" was never as robust as many pejorative epithets, but in any event, the offensive connotations of the word have diminished to the point where the use of the word is obsolete or archaic as a form of disparagement, and indeed, Asians today increasingly view "slant" as a proud informal term of self-reference. *See generally* Butters Report (analyzing the modern meaning of the noun phrase, THE SLANTS). For example, the editors of the third (2010) edition of the *New Oxford American Dictionary* (NOAD) dropped the entire epithetic definition and its pejorative usage labels from the dictionary. *Id.* at ¶¶ 11-13 (discussing, among other things, the softening, and then ultimate removal of the definition of "slant" as a racial epithet). As noted by Dr. Butters, it appears that the NOAD editors judged slant to have been ameliorated to the extent that it has fallen into disuse as a pejorative racial epithet and is no longer considered particularly offensive to Asian-Americans themselves. *Id.* at ¶ 13.

It is no surprise then, that in contemporary culture the term is increasingly being used by Asians in a self-referential manner. Butters Report ¶¶ 18-22. These uses include "The Slant" (an entertainment and news series about the Asian experience), "Slant Eye For The Round Eye" (a popular Asian blog), the "Slant Film Festival" (a film festival showcasing Asian Artists), and "The Slanted Screen" (a documentary about Asian actors). *Id.*; Response to Office Action, Exhibits 14-18; Office Action, Exhibits 10-15 (self-referential uses of the term "slant"). Melissa Hung, the founder of the Slant Film Festival (which is now in its eleventh year), notes that throughout the entire time the festival has been running, there has only been a single instance where someone has contacted the festival to express concern about the use of the term "slant" in the festival's name. Declaration of Melissa Hung (attached as Exhibit F) at ¶ 3.

Applicant established in his Response, that the success of The Slants within the Asian community is indisputable. However, Applicant now nonetheless introduces substantial additional evidence in support of that point. *See* articles referencing The Slants (attached as Exhibit G); articles previously introduced in the Office Action, but reintroduced here for purposes of displaying complete URL information (attached as Exhibit H). Unlike the evidence set forth by Examining Attorney, this evidence specifically reflects the voice of the referenced group at issue.

Moreover, Applicant now also introduces direct survey evidence to establish that Applicant's Mark is not disparaging to a substantial composite of the referenced group. The survey evidence, which was gathered in accordance with appropriate scientific principles, demonstrates, among other things, that few members of the API community view THE SLANTS as a disparaging term. *See generally* Survey Report.

First, few survey respondents (16%) agreed that the name of the group was disparaging. *Id.* at ¶ 7. Applicant notes that 16% does not even come close to rising to the level of being a

“substantial composite.” *See e.g., Harjo II*, 284 F. Supp. 2d at 133 n.32 (36.6% of Native Americans did not constitute a “substantial composite”). Ultimately, if there was any strong feeling, it was in the direction as viewing THE SLANTS as a term that is *not* disparaging. *Id.* Moreover, even fewer agreed that THE SLANTS is disparaging when learning that the group’s membership is entirely Asian (8%). *Id.* at ¶ 7. And, to that end, Applicant notes that he has here amended the statement of identified services to read: “Live performances by musical group that is *comprised, in majority, of Asians.*” (Emphasis added).

The results of the survey are not surprising, nor are they in any way inconsistent with the conclusions reached by Dr. Butters in his report. In summary, the survey evidence speaks to the exact issue in this matter, and wholly supports the argument that THE SLANTS is not considered disparaging by a substantial composite of Asians.

Finally, to the extent that there is any doubt concerning the registrability of Applicant’s Mark, it should be resolved in favor of Applicant and the mark should be published for opposition. *In re In Over Our Heads*, 16 USPQ2d (BNA) at 1654-55; *see also* 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, 264 (2004) (“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 a position of censoring marks without public input”).

CONCLUSION

As set forth in detail above, Applicant’s Mark is not disparaging. As used by Applicant, it is a positive term of self-reference that has been embraced by the Asian community. While Applicant submits that this point was established beyond doubt in the Response to Office Action, Applicant has now submitted substantial additional evidence in support thereof. Applicant has sufficiently demonstrated that the Asian community does not find Applicant’s Mark to be disparaging, and, therefore, there is absolutely no justification for the Examining Attorney to refuse registration of the mark. Finally, even if there is any doubt concerning the registrability of Applicant’s Mark (which there is not), such doubt must be resolved in favor of Applicant. For all of these reasons, Applicant respectfully requests that Examining Attorney withdraw the refusal of registration under Section 2(a).

Please contact me at (503) 727-2502 or spencer@mcnamerlaw.com if you have any questions.

Date: June 15, 2011

Respectfully Submitted,

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