



MARCH 2014 MEETING • March 10, 2014

*The Ritz-Carlton
1515 West Third Street • Cleveland, Ohio*

TRADEMARK COMMITTEE

**ANGLING FOR ALLOWANCE:
[The] THE SLANTS Appeal and
Examining Attorney
Independent Research**

Ronald D. Coleman



GOETZ FITZPATRICK LLP
New York • New Jersey

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www.goetzfitz.com
rcoleman@goetzfitz.com

www.likelihoodofconfusion.com

“ANGLING FOR ALLOWANCE” CLE MATERIALS

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15 U.S. Code § 1052 - Trademarks registrable on principal register; concurrent registration

Current through Pub. L. 113-75. (See [Public Laws for the current Congress.](#))

US Code

Notes

Updates

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or



1203.01 Immoral or Scandalous Matter

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), is an absolute bar to the registration of immoral or scandalous matter on either the Principal Register or the Supplemental Register.

Although the words “immoral” and “scandalous” may have somewhat different connotations, case law has included immoral matter in the same category as scandalous matter. *See In re McGinley*, 660 F.2d 481, 484 n.6, 211 USPQ 668, 673 n.6 (C.C.P.A. 1981), *aff’g* 206 USPQ 753 (TTAB 1979) (“Because of our holding, *infra*, that appellant’s mark is ‘scandalous,’ it is unnecessary to consider whether appellant’s mark is ‘immoral.’ We note the dearth of reported trademark decisions in which the term ‘immoral’ has been directly applied.”)

The prohibition against the registration of marks that consist of or comprise immoral or scandalous matter was originally enacted as §5(a) of the Trademark Act of 1905, and was reenacted as part of §2(a) of the Act of 1946. There is little legislative history concerning the intent of Congress with regard to the provision; therefore, the term “scandalous” is interpreted by looking to “its ordinary and common meaning.” *In re Riverbank Canning Co.*, 95 F.2d 327, 328, 37 USPQ 268, 269 (C.C.P.A. 1938). The Court has noted, however, that the word “comprises” meant “includes” at the time of the statute’s enactment in 1905, and thus Congress extended the prohibition not only to marks that consist of scandalous matter, but also to marks that include scandalous matter.” *In re Fox*, 702 F.3d 633, 638, 105 USPQ2d 1247, 1250 (Fed. Cir. 2012) (holding scandalous a mark for rooster-shaped chocolate lollipops where, in the context of the goods, “a substantial composite of the general public perceives” a scandalous meaning, even though the mark had a non-scandalous meaning in relation to the goods as well). Moreover, there is no requirement in §2(a) that a mark’s vulgar meaning be the only relevant meaning, or even the most relevant meaning. *Id.* Thus, an examining attorney need only prove the existence of one vulgar meaning to justify a §2(a) refusal. *Id.* This may be established by referring to court decisions, decisions of the Trademark Trial and Appeal Board and dictionary definitions. *McGinley*, 660 F.2d at 485, 211 USPQ at 673.

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. *McGinley*, 660 F.2d at 486, 211 USPQ at 673 (holding scandalous a mark comprising a photograph of a nude, reclining man and woman, kissing and embracing, for a “newsletter devoted to social and interpersonal relationship topics” and for “social club services”). The statutory language “scandalous” has also been considered to encompass matter that is “vulgar,” defined as “lacking in taste, indelicate, morally crude.” *In re Runsdorf*, 171 USPQ 443, 444 (TTAB 1971).

The meaning imparted by a mark must be determined in the context of the current attitudes of the day. *See In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 31 USPQ2d 1923 (Fed. Cir. 1994) (finding the evidence insufficient to establish that BLACK TAIL, used on adult entertainment magazines, comprises scandalous matter; noting that there were both vulgar and non-vulgar definitions of “tail,” and that the record was devoid of evidence demonstrating which of these definitions a substantial composite of the general public would choose in the context of the relevant marketplace); *In re Old Glory Condom Corp.*, 26 USPQ2d 1216 (TTAB 1993) (holding not scandalous OLD GLORY CONDOM CORP and design comprising the representation of a condom decorated with stars and stripes in a manner to suggest the American flag); *In re Thomas Laboratories, Inc.*, 189 USPQ 50, 52 (TTAB 1975) (“[I]t is imperative that

fullest consideration be given to the moral values and conduct which contemporary society has deemed to be appropriate and acceptable.”)

The determination of whether a mark is scandalous must be made in the context of the relevant marketplace for the goods or services identified in the application, and must be ascertained from the standpoint of not necessarily a majority, but a “substantial composite of the general public.” As long as a substantial composite of the general public would perceive the mark, in context, to have a vulgar meaning, “the mark as a whole ‘consists of or comprises . . . scandalous matter’” under §2(a). *In re Fox*, 702 F.3d at 638, 105 USPQ2d at 1250 (quoting 15 U.S.C. §1052(a) (emphasis added)); *In re Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1340, 67 USPQ2d 1475, 1477 (Fed. Cir. 2003); *McGinley*, 660 F.2d at 485, 211 USPQ at 673 (“[T]he Lanham Act does not require, under the rubric of ‘scandalous,’ any inquiry into the specific goods or services not shown in the application itself.”); *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059 (TTAB 2013)(finding the evidence sufficient to establish prima facie that the term “aw shit” is scandalous or vulgar to the conscience of a substantial composite of the general public); *In re Luxuria s.r.o.*, 100 USPQ2d 1146 (TTAB 2011) (finding a mark consisting of a bottle in the shape of a hand with middle finger extended upwards comprised matter that would be considered vulgar by a substantial composite of the general public); *In re Wilcher Corp.*, 40 USPQ2d 1929 (TTAB 1996) (holding scandalous a mark for restaurant and bar services consisting of words DICK HEADS positioned directly underneath caricature of a human head composed primarily of graphic and readily recognizable representation of male genitalia, as it would be considered offensive by a substantial portion of the public); *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1639 (TTAB 1988) (holding scandalous a graphic design of a dog defecating, as applied to polo shirts and T-shirts, given the broad potential audience that may view applicant’s mark in sales establishments and “virtually all public places”); *In re Hepperle*, 175 USPQ 512 (TTAB 1972) (holding ACAPULCO GOLD not scandalous when used as a mark for suntan lotion even though the words might be a reference to marijuana).

Therefore, to support a refusal on the ground that a proposed mark is immoral or scandalous, the examining attorney must provide evidence that a substantial portion of the general public would consider the mark to be scandalous in the context of contemporary attitudes and the relevant marketplace. *Mavety Media*, 33 F.3d at 1371-72, 31 USPQ2d at 1925-26. This evidence could include dictionary definitions, newspaper articles, and magazine articles. The examining attorney should not rely solely on an earlier decision holding a term to be scandalous in support of a refusal. **The Trademark Trial and Appeal Board has held that an earlier decision is insufficient to warrant the same finding in a future case. *In re Red Bull GmbH*, 78 USPQ2d 1375 (TTAB 2006) (rejecting examining attorney’s argument that the Board’s 1981 decision in *In re Tinseltown, Inc.*, 212 USPQ 863 (TTAB 1981) finding BULLSHIT to be scandalous is sufficient to warrant the same finding in a later case). Rather, the facts underlying the earlier decision must be looked at to determine, first, whether it has any relevance to the present case, and, if so, whether that earlier finding is equally applicable today, for example, by looking at other evidence such as recent dictionary definitions. *Red Bull*, 78 USPQ2d at 1381.**

Dictionary definitions alone may be sufficient to establish that a proposed mark comprises scandalous matter, where multiple dictionaries, including at least one standard dictionary, all indicate that a word is vulgar, and the applicant’s use of the word is limited to the vulgar meaning of the word. *Boulevard Entm’t*, 334 F.3d at 1341, 67 USPQ2d at 1478 (holding 1-800-JACK-OFF and JACK OFF scandalous, where all dictionary definitions of “jack-off” were considered vulgar); *In re Star Belly Stitcher*, 107 USPQ2d 2059 at 2062 (stating that dictionary evidence showed that the terms “shit” and “aw shit” are vulgar terms); *Boston Red Sox Baseball Club Ltd. P’ship v. Sherman*, 88 USPQ2d 1581 (TTAB 2008) (sustaining an opposition and finding that SEX ROD was immoral and scandalous under §2(a) based on dictionary definitions designating the term “ROD” as being vulgar, and applicant’s admission that SEX ROD had a sexual connotation); *Red Bull*, 78 USPQ2d at 1381-82 (finding multiple dictionary definitions indicating BULLSHIT is “obscene,” “vulgar,” “usually vulgar,” “vulgar slang,” or “rude slang” constitute a prima facie showing that the term is offensive to the conscience of a substantial composite of the general public).

“Whether applicant intended the mark to be humorous, or even whether some people would actually find it to be humorous, is immaterial.” *In re Luxuria, s.r.o.*, 100 USPQ2d at 1149 (quoting *Boston Red Sox Baseball Club*, 88 USPQ2d at 1588). A refusal is proper if the evidence shows that “the term would be perceived and understood as vulgar by a substantial portion of the purchasing public.” *Id.* ; see also *Fox*, 702 F.3d at 634, 105 USPQ2d at 1248 (“a mark that creates a double entendre falls within the proscription of §1052(a) where, as here, one of its meanings is clearly vulgar”); *In re Star Belly Stitcher*, 107 USPQ2d at 2063 (“[T]here is no requirement in Section 2(a) that a mark’s vulgar meaning must be the only relevant meaning, or even the most relevant meaning.”).

It has been noted that the threshold is lower for what can be described as “scandalous” than for “obscene.” Refusal to register immoral or scandalous matter has been found not to abridge First Amendment rights, because no conduct is proscribed and no tangible form of expression is suppressed. Also, the term “scandalous” has been held sufficiently precise to satisfy due process requirements under the Fifth Amendment. *McGinley*, 660 F.2d at 484-85, 211 USPQ at 672.

The prohibition in §2(a) of the Act against the registration of scandalous matter pertains only to *marks* that are scandalous. The authority of the Act does not extend to goods that may be scandalous. See *In re Madsen*, 180 USPQ 334, 335 (TTAB 1973) (holding WEEK-END SEX for magazines not scandalous and observing that whether the magazine contents may be pornographic was not an issue before the Board).

The examining attorney may look to the specimen(s) or other aspects of the record for confirmation that a substantial composite of the general public would perceive the mark to be vulgar in the context of the goods or services at issue. See *McGinley*, 660 F.2d at 482 n.3, 211 USPQ at 670 n.3 (referring to excerpts from appellant’s newsletters pertaining to the sexual connotation of the subject matter).

To ensure consistency in examination with respect to immoral or scandalous matter, 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.



Int. Cl.: 41

Prior U.S. Cls.: 100, 101 and 107

Reg. No. 3,323,803

United States Patent and Trademark Office

Registered Oct. 30, 2007

**SERVICE MARK
PRINCIPAL REGISTER**

DYKES ON BIKES

SAN FRANCISCO WOMEN'S MOTORCYCLE
CONTINGENT (CALIFORNIA CORPORATION)
633 CASTRO STREET
SAN FRANCISCO, CA 94114

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).

FOR: EDUCATION AND ENTERTAINMENT
SERVICES IN THE NATURE OF ORGANIZING,
CONDUCTING, AND PROMOTING PARADE
CONTINGENTS, COMMUNITY FESTIVALS, EVENTS,
STREET FAIRS, FORUMS, SEMINARS, PARTIES
AND RALLIES TO SUPPORT, ORGANIZE AND
MOTIVATE WOMEN MOTORCYCLISTS EVERY-

FIRST USE 6-0-1976; IN COMMERCE 6-0-1976.

SER. NO. 78-281,746, FILED 7-31-2003.

SHARON MEIER, EXAMINING ATTORNEY



12-10-2004

U.S. Patent & TMOfr/TM Mail Ropt Dt. #67

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

The Mark:

NIGGA

NOT APPROVED

U.S. Patent & TM Ofc/TM



76623949

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51 and 52

United States Patent and Trademark Office

Reg. No. 2,997,761

Registered Sep. 20, 2005

TRADEMARK
PRINCIPAL REGISTER

F·A·G

Fabulous and Gay

APPROVED

GRAYSON FAIRBANKS, INC. (NEW YORK CORPORATION)
PO BOX 16563
ROCHESTER, NY 14616

FOR: HAIR AND BODY WASH, HAIR CONDITIONER, BODY CREAM, LIP BALM, PET SHAMPOO/CONDITIONER, BATH SALTS, SHAVE CREAM, FACE CREAM, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 7-1-2004; IN COMMERCE 7-1-2004.

SER. NO. 78-451,780, FILED 7-16-2004.

DOMINIC J. FERRAIUOLO, EXAMINING ATTORNEY

Int. Cl.: 41

Prior U.S. Cls.: 100, 101 and 107

United States Patent and Trademark Office

Reg. No. 2,905,014

Registered Nov. 23, 2004

**SERVICE MARK
PRINCIPAL REGISTER**



QUEER EYE FOR THE STRAIGHT GUY

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

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.

FOR: ENTERTAINMENT SERVICES, NAMELY,
PROVIDING A TELEVISION PROGRAM IN THE

LINDA M. KING, EXAMINING ATTORNEY

Int. Cl.: 41

Prior U.S. Cls.: 100, 101 and 107

United States Patent and Trademark Office

Reg. No. 2,858,011
Registered June 29, 2004



**SERVICE MARK
PRINCIPAL REGISTER**



HEEB

BLEYER, JENNIFER S. (UNITED STATES INDIVIDUAL)
81 VANDERBILT AVE.
BROOKLYN, NY 11205

FIRST USE 2-15-2001; IN COMMERCE 2-1-2002.

SER. NO. 78-250,619, FILED 5-15-2003.

FOR: PUBLICATION OF MAGAZINES, IN CLASS
41 (U.S. CLS. 100, 101 AND 107).

RONALD AIKENS, EXAMINING ATTORNEY

Mail/Create Date

Mar. 23, 2007



UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/558043

APPLICANT: HEEB MEDIA, LLC

78558043

CORRESPONDENT ADDRESS:

Jerald M. Tenenbaum, Esq.
Fridman Law Group, PLLC
Suite 505
185 Varick Street
New York, NY 10014

RETURN ADDRESS:

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

MARK: HEEB



CORRESPONDENT'S REFERENCE/DOCKET NO: NA

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

gerald@ifridman.com

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.

FINAL OFFICE ACTION

Hearing: June 19, 2012

Mailed: February 7, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pamela Geller and Robert B. Spencer

Serial No. 77940879

David Yerushalmi, Esq. for Pamela Geller and Robert B. Spencer.

Maria-Victoria Suarez, Trademark Examining Attorney, Law Office 102 (Karen M. Strzyz, Managing Attorney).

Before Cataldo, Taylor and Kuczma, Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Pamela Geller and Robert B. Spencer, (“applicants”), filed an application under § 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), seeking registration of the mark:

Stop the Islamisation of
America

in standard character form for “providing information regarding understanding and preventing terrorism,” in International Class 45.¹

NOT APPROVED

¹ Application Serial No. 77940879, filed on February 21, 2010.

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The TTABlog®

Keeping Tabs on the TTAB™

by John L. Welch

TUESDAY, JULY 03, 2007

Precedential No. 44: TTAB Says Wikipedia Evidence is Admissible, but Should Be Corroborated

The TTAB has adopted the same stance as the Trademark side of the USPTO on the admissibility of Wikipedia evidence: admissible, but its weight may vary depending on the existence, or lack, of corroborating sources. [Trademark Commissioner Beresford's statement [here](#)]. That evidentiary ruling had little impact, however, on the Board's affirmance of the PTO's Section 2(e)(1) mere descriptiveness refusals of the marks ipPCS and ipPIPE for telecommunications services featuring a device that allows Internet transmission of images and video. [In re IP Carrier Consulting Group](#), 84 USPQ2d 1028 (TTAB 2007) [precedential].



The brouhaha arose when Applicant submitted the Wikipedia entry for "Internet Service Provider" in an attempt to show that the most common abbreviation for "Internet Provider" is "ISP." The Board then launched into its discussion of Wikipedia evidence.

"There are inherent problems regarding the reliability of Wikipedia entries because Wikipedia is a collaborative website that permits anyone to edit the entries. *** As a result, entries,



[John L. Welch](#)

[Lando & Anastasi, LLP](#)

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JLW Articles

[The Sixty-Sixth Year of Administration of the U.S. Trademark \(Lanham\) Act of 1946](#)

[The Top Ten TTAB Decisions of 2012-2013](#)

[2012-2013 Decisions of the Trademark Trial and Appeal Board and the Federal Circuit on Registrability Issues](#)

[The Sixty-Fifth Year of Administration of the U.S. Trademark \(Lanham\) Act of 1946](#)

[The Top Ten TTAB Decisions of 2011-2012](#)

[The Sixty-Fourth Year of Administration of the U.S. Trademark \(Lanham\) Act of 1946](#)

[The Top Ten TTAB Decisions of 2011 \[Part II\]](#)

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especially newer entries and recent edits, may contain significant misinformation, false or debatable information, 'unencyclopedic' content, unexpected oversights and omissions, vandalism, or unchecked information that requires removal. At any given time an article may be in the middle of an edit or controversial rewrite."

On the other hand, the Board noted, Internet evidence is "generally admissible and may be considered for purposes of evaluating a trademark."

The Board concluded that it will consider Wikipedia evidence "so long as the non-offering party has an opportunity to rebut that evidence by submitting other evidence that may call into question the accuracy of the particular Wikipedia information."

"As recommended by the editors of Wikipedia, the information in a particular article should be corroborated. The better practice with respect to Wikipedia evidence is to corroborate the information with other reliable sources, including Wikipedia's sources."

Here, there was corroborating evidence for the Wikipedia entry in the form of an American Heritage Dictionary listing for "Internet Service Provider."

The Board nonetheless found that "IP" is readily understood to mean "Internet Provider" and/or "Internet Protocol," and it found the two marks at issue to be merely descriptive of Applicant's services.

TTABlog comment: As I have said before, I think the better practice is to exclude Wikipedia evidence. [In short, I agree with INTA's position, found [here](#)]. If corroboration is required, why not discard the Wikipedia evidence entirely and rely on the corroborating evidence?

What happens when the corroborating evidence is other Internet evidence? Does such a house of cards provide any real support?

Text Copyright John L. Welch 2007.

posted by John L. Welch @ [7/03/2007](#)

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**710.01(b) Internet Evidence**

Articles downloaded from the Internet are admissible as evidence of information available to the general public, and of the way in which a term is being used by the public. However, the weight given to this evidence must be carefully evaluated, because the source may be unknown. See *In re Total Quality Grp. Inc.*, 51 USPQ2d 1474, 1475-76 (TTAB 1999); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370-71 (TTAB 1998). When making Internet evidence part of the record, the examining attorney must both (1) provide complete information as to the date the evidence was published or accessed from the Internet, and its source (e.g., the complete URL address of the website), and (2) download and attach the evidence to the Office action. See *Safer Inc. v. OMS Invs. Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010). Providing only a website address or hyperlink to Internet materials is insufficient to make such materials of record. *In re Powermat Inc.*, 105 USPQ2d 1789, 1791 (TTAB 2013); *In re HSB Solomon Assocs. LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012). Because of the transitory nature of Internet postings, websites referenced only by address or hyperlinks may be modified or deleted at a later date without notification. See *Safer Inc.*, 94 USPQ2d at 1039. Thus, information identified only by website address or hyperlink would not be available for verification by the applicant to corroborate or refute. See *In re HSB Solomon Assocs. LLC*, 102 USPQ2d at 1274.

A list of Internet search results generally has little probative value, because such a list does not show the context in which the term is used on the listed web pages. *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715 (TTAB 2011); see *In re Bayer AG*, 488 F.3d 960, 967, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (deeming Google® search results that provided very little context of the use of ASPIRINA to be “of little value in assessing the consumer public perception of the ASPIRINA mark”); *In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062, 1064 n.3 (TTAB 2008) (finding truncated Google® search results entitled to little probative weight without additional evidence of how the searched term is used); *In re Thomas*, 79 USPQ2d 1021, 1026 (TTAB 2006) (rejecting an applicant’s attempt to show weakness of a term in a mark through citation to a large number of Google® “hits” because the “hits” lacked sufficient context); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1050 (TTAB 2006) (noting that web page links “do little to show the context within which a term is used on the web page that could be accessed by the link”); *In re Remacle*, 66 USPQ2d 1222, 1223 n.2 (TTAB 2002) (finding the print-out of Internet search results to be of little probative value due to insufficient text to determine the nature of the information or its relevance); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002) (noting that “[e]vidence of actual use of a phrase by a website has far greater probative value” than a search summary). The examining attorney should attach copies of the website pages that show how the term is actually used.

As long as it is written in the English language, information originating on foreign websites or in foreign news publications that are accessible to the United States public may be relevant to discern United States consumer impression of a proposed mark. The probative value of such evidence will vary depending upon the context and manner in which the term is used. In *Bayer*, NEXIS® evidence that originated in foreign publications was deemed to be of “some probative value with respect to prospective consumer perception in the United States,” the Court noting “the growing availability and use of the internet as a resource for news, medical research results, and general medical information.” 488 F.3d at 969, 82 USPQ2d at 1835. In *Remacle*, the Board held evidence from a website in Great Britain admissible, noting that:

[I]t is reasonable to assume that professionals in medicine, engineering, computers, telecommunications and many other fields are likely to utilize all available resources, regardless of country of origin or medium. Further, the Internet is a resource that is widely available to these same professionals and to the general public in the United States. Particularly in the case before

us, involving sophisticated medical technology, it is reasonable to consider a relevant article from an Internet web site, in English, about medical research in another country, Great Britain in this case, because that research is likely to be of interest worldwide regardless of its country of origin.

66 USPQ2d at 1224 n.5. However, the weight given to such evidence depends upon the context and manner in which the term is used. In *King Koil*, the Board gave only “limited probative value” to the contents of websites of commercial entities outside the United States showing use of the term “breathable” in relation to mattresses and bedding, stating that:

[C]onsumers may visit foreign web sites for informational purposes, even if they are more likely to focus on internet retailers that can easily ship items or make items available for pick up in a store in a location convenient to the purchaser. That would appear especially likely in a case such as this, where the item in question, a mattress, is large and potentially more expensive to ship than a smaller item. Accordingly, while we do not discount entirely the impact of foreign web sites in this case, we find them of much more limited probative value than in the *Remacle* case.

79 USPQ2d at 1050. See also *In re Cell Therapeutics, Inc.*, 67 USPQ2d 1795, 1797-98 (TTAB 2003) (relying on NEXIS® items from foreign wire services to support a refusal and distinguishing earlier decisions that accorded such evidence little probative value given the sophisticated public and the widespread use of personal computers that increase access to such sources).

With respect to evidence taken from the online Wikipedia® encyclopedia, at www.wikipedia.org, the Board has noted that “[t]here are inherent problems regarding the reliability of Wikipedia entries because Wikipedia is a collaborative website that permits anyone to edit the entries,” and has stated as follows:

[T]he Board will consider evidence taken from Wikipedia so long as the non-offering party has an opportunity to rebut that evidence by submitting other evidence that may call into question the accuracy of the particular Wikipedia information. Our consideration of Wikipedia evidence is with the recognition of the limitations inherent with Wikipedia (e.g., that anyone can edit it and submit intentionally false or erroneous information)....

As a collaborative online encyclopedia, Wikipedia is a secondary source of information or a compilation based on other sources. As recommended by the editors of Wikipedia, the information in a particular article should be corroborated. The better practice with respect to Wikipedia evidence is to corroborate the information with other reliable sources, including Wikipedia’s sources.

In re IP Carrier Consulting Grp., 84 USPQ2d 1028, 1032-33 (TTAB 2007).

Given its inherent limitations, any information obtained from Wikipedia® should be treated as having limited probative value. If the examining attorney relies upon Wikipedia® evidence and makes it of record, then additional supportive and corroborative evidence from other sources should also be made of record, especially when issuing final actions.

The examining attorney should check applicant’s own website for information about the goods/services. See *In re Promo Ink*, 78 USPQ2d 1301, 1303 (TTAB 2006), where the Board rejected applicant’s argument that it was improper for the examining attorney to rely on evidence obtained from applicant’s website when the application was based on intent to use and no specimens were yet required. According to the Board, “[T]he fact that applicant has filed an intent-to-use application does not limit the examining attorney’s evidentiary options, nor does it shield an applicant from producing evidence that it may have in its possession.” *Id.*; see also *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 1379, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007); *In re Ameritox Ltd.*, 101 USPQ2d 1081, 1084-85 (TTAB 2011).

When a document found on the Internet is not the original publication, the examining attorney or Trademark Law Library staff should try to obtain a copy of the originally published document, if practicable. Electronic-only documents are considered to be original publications, and scanned images are considered to be copies of original publications. Internet Usage Policy Notice, 64 Fed. Reg. 33056, 33063 (June 21, 1999).

See TBMP §1208.03 for further information regarding the use of material obtained through the Internet in ex parte proceedings.

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September 21, 2009 | [6 Comments](#)

Jiggering it out at the PTO

Originally posted 2009-01-27 19:59:39. Republished by [Blog Post Promoter](#)



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. (See John Welch's coverage [here](#).)

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.



Get the point? “Hip.”

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.

[{ Edit }](#)

Tags: [Disparaging Trademarks](#), [Heeb Trademark](#), [Nigga Trademark](#)



Author: Ron Coleman

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6 Responses to “Jiggering it out at the PTO”



[Reply](#)

[Marc J. Randazza](#)

January 29, 2009 at 9:19 am [# Edit](#)

Outstanding writing Ron. Out freakin standing.



2.

[Reply](#)

Steven Fox

January 29, 2009 at 11:35 am [# Edit](#)

Are you Jewish? Your footnote: "I was consulted by Heeb in connection with this appeal, but I was not retained. You know â€" they wanted a bargain." On the face of it, I find it very offensive and in poor taste. You have first amendment rights.



o

[Reply](#)
[Ron Coleman](#)
January 29, 2009 at 2:40 pm [# Edit](#)

Hi, Steven.

Regular readers of the blog know that I am an orthodox Jew. I thought the hint in the last two sentences of the post would do the trick, but sorry I didn't spell it out for you.



3.

[Reply](#)

Steven Fox

January 29, 2009 at 5:39 pm [# Edit](#)

Thanks Ron. Although I can now see the sarcasim, I find it offensive. Maybe I am a bit defensive, close minded, and simply slow witted. In any event, I look forward to reading your posts.



o

[Reply](#)
[Ron Coleman](#)
January 29, 2009 at 7:18 pm [# Edit](#)

I doubt that! You could merely have a somewhat different sense of humor from mine. I wrote this post in a particularly provocative way, and I certainly acknowledge that there are different ways to take this issue. After all, for all my attitude I would not dismiss the TTAB. That's some serious cats there. (Not Katz. Cats.)

Trackbacks/Pingbacks

1. [Update \(and clarifications\) about the SLANTS appeal | LIKELIHOOD OF CONFUSION®](#) - October 25, 2013

[...] What is also unfortunate is that 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. [...]

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The question of whether consumers are [likely to be confused](#) is the signal [inquiry](#) that determines if a trademark infringement claim is valid. This

Trademark/Service Mark Application, Principal Register

Serial Number: 77952263

Filing Date: 03/05/2010

To the Commissioner for Trademarks:

MARK: THE SLANTS (Standard Characters, see [mark](#))

The literal element of the mark consists of THE SLANTS.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Simon Shiao Tam, a citizen of United States, having an address of

8026 S.E. Reedway St.
Portland, Oregon 97206
United States

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

For specific filing basis information for each item, you must view the display within the Input Table.

International Class 041: Entertainment, namely, live performances by a musical band

In International Class 041, the mark was first used at least as early as 11/15/2006, and first used in commerce at least as early as 11/15/2006, and is now in use in such commerce. The applicant is submitting one specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) Flyer; printout of website.

JPG file(s):

[Specimen File 1](#)

Original PDF file:

[spec-20610211110-191043575_.specimen2.pdf](#)

Converted PDF file(s) (3 pages)

[Specimen File 1](#)

[Specimen File 2](#)

[Specimen File 3](#)

The applicant's current Attorney Information:

Spencer Trowbridge and Kohel Haver of Swider Medeiros Haver LLP
621 S.W. Morrison St., Suite 1420
Portland, Oregon 97205
United States

The applicant's current Correspondence Information:

[Attorney]

A fee payment in the amount of \$325 has been submitted with the application, representing payment for 1 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the 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/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: // Date Signed: 03/05/2010

Signatory's Name:

Signatory's Position: Attorney of record

RAM Sale Number: 6035

RAM Accounting Date: 03/08/2010

Serial Number: 77952263

Internet Transmission Date: Fri Mar 05 19:43:57 EST 2010

TEAS Stamp: USPTO/BAS-206.102.11.110-201003051943572

06603-77952263-460635ad0233bca459e8aaa91

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Sat Mar 13	...	Neon Reverb	...	Las Vegas, NV US
Sun Mar 14	...	Samurai Comics	...	Phoenix, AZ US
Sun Mar 14	...	The Rouge	...	Scottsdale, AZ US
Mon Mar 15	...	Las Cruces	...	Las Cruces, NM US
Mon Mar 15	...	Equinox	...	Las Cruces, NM US

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信息 NEWS

- Sakuracon 2010! 02.24.10
- Zombies & Slants 02.06.10
- The Slants in the Paper 01.02.10

關於 ABOUT

- The Legend of The Slants in Short
- A Little About The Slants Family
- Frequently Asked Questions



A framed music player interface. At the top, it says "You Make Me Blue (from the album 'F 00:00)". Below that, it lists several songs: "You Make Me Blue (from the album 'Pa Gho Shei The Radio?)", "How The Wheel Laid (from the album 'Pa Luiky Strike)", and "Yakara (Sun of Real Heart of Everything I the Hill Honor The Heart Know Me!)". At the bottom, it says "MUSIC PLAYER BY CHROMOSOME".

theslants: A Huge thanks to Brandon at Seymour Duncan for the hookup on our new pickup's! The Slants Acoustic performances on... <http://bit.ly/9ak56m>

theslants: Our tour officially kicks off one week from today! <http://bit.ly/b2Rmth>

A photo gallery interface titled "照片 PHOTOS". Below the title is a section titled "The Slants Live" which contains a grid of 24 small thumbnail photos showing the band performing live on stage.

A large red banner featuring two stylized red dragons flanking a central circular logo. The logo contains a stylized character, possibly 'S'. Below the logo, the Chinese characters "商店" (Store) are written in a large, bold font, with the word "STORE" in smaller English letters underneath.

A framed interface titled "另外 EXTRAS" (Extras). Below the title, it says "Desktop Wallpapers" and shows a preview of a desktop wallpaper featuring a photo of the band.



our new pickup at The Slants
Acoustic performances on...
<http://bit.ly/9nk56m>

the slants: Our tour officially kicks
off one week from today!
<http://bit.ly/b2Rmlh>



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April 7, 2011 | [11 Comments](#)

A different Slant



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, uh, [this](#) and [this](#), and [this](#). And, of course, [this](#).

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.

Hat tip to [Reid Wilson](#) via [this tweet](#).

[\[Edit \]](#)

Tags: [Scandalous Marks](#), [The Slants](#), [Trademark Law](#)



Author: Ron Coleman

I write this blog.

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 85472044

Filing Date: 11/14/2011

To the Commissioner for Trademarks:

MARK: THE SLANTS (Standard Characters, see [mark](#))

The literal element of the mark consists of THE SLANTS.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Simon Shiao Tam, a citizen of United States, having an address of
8026 S.E. Reedway St.
Portland, Oregon 97206
United States

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

For specific filing basis information for each item, you must view the display within the Input Table.

International Class 041: Entertainment in the nature of live performances by a musical band

In International Class 041, the mark was first used at least as early as 11/15/2006, and first used in commerce at least as early as 11/15/2006, and is now in use in such commerce. The applicant is submitting one specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) Flyers advertising performances.

[Specimen File1](#)

[Specimen File2](#)

[Specimen File3](#)

The applicant's current Attorney Information:

Ronald Coleman of GOETZ FITZPATRICK LLP

1 Penn Plaza

Suite 4401

New York, New York 10119

United States

The applicant's current Correspondence Information:

Ronald Coleman
GOETZ FITZPATRICK LLP
1 Penn Plaza
Suite 4401
New York, New York 10119
2126958100(phone)
rcoleman@goetzfitz.com (authorized)

A fee payment in the amount of \$275 has been submitted with the application, representing payment for 1 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the 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/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /Simon Shiao Tam/ Date Signed: 11/14/2011
Signatory's Name: Simon Shiao Tam
Signatory's Position: Owner

RAM Sale Number: 4120
RAM Accounting Date: 11/15/2011

Serial Number: 85472044
Internet Transmission Date: Mon Nov 14 16:48:48 EST 2011
TEAS Stamp: USPTO/FTK-66.251.23.10-20111114164848549
373-85472044-4808b9c85f3636e2c33bf8b705e
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THE SLANTS

THE SUNSET PRESENTS SUNDAY BLOODY SUNSET

WITH

THE
MOON-
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THE
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THE VAGUE

PROPHETS

THE SLANTS

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SWEET WATER 11 PM
BLIND PILOT 12 AM
THE SLANTS 1 AM



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[Attachment - 159](#)

[Attachment - 160](#)

[Attachment - 161](#)

[Attachment - 162](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85472044

MARK: THE SLANTS

85472044

CORRESPONDENT ADDRESS:

RONALD COLEMAN
GOETZ FITZPATRICK LLP
1 PENN PLZ STE 4401
NEW YORK, NY 10119-0196

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Tam, Simon Shiao

**CORRESPONDENT'S REFERENCE/DOCKET
NO:**

N/A

CORRESPONDENT E-MAIL ADDRESS:

rcoleman@goetzfitz.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 1/6/2012

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SEARCH OF OFFICE'S DATABASE OF MARKS

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

SECTION 2(A) – MARK IS DISPARAGING

Registration is refused because the applied-for mark consists of or includes matter which may disparage or

bring into contempt or disrepute persons, institutions, beliefs or national symbols. Trademark Act Section 2(a), 15 U.S.C. §1052(a); see *In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264, 1267-79 (TTAB 2006); *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1740-48 (TTAB 1999), *rev'd*, 284 F. Supp. 2d 96, 125, 68 USPQ2d 1225, 1248 (D.D.C. 2003) (finding “no error in the TTAB’s articulation of [the Section 2(a)] test for disparagement”), *remanded on other grounds*, 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); TMEP §§1203.03, 1203.03(c).

The following two factors must be considered when determining whether matter may be disparaging under Trademark Act Section 2(a):

- (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 and/or services, and the manner in which the mark is used in the marketplace in connection with the goods and/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., 80 USPQ2d at 1267 (citing *Harjo*, 50 USPQ2d at 1740-41); TMEP §1203.03(c).

To “disparage” means “to speak slighting[ly] of: run down: depreciate.” *In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264, 1276 (TTAB 2006) (internal punctuation omitted) (quoting *Webster’s Third New International Dictionary* (unabridged ed. 1993)). The determination of whether a mark is disparaging depends upon the perspective of the object of disparagement. *In re Lebanese Arak Corp.*, 94 USPQ2d 1215, 1217 (TTAB 2010); see also TMEP §1203.03(c). A mark may be disparaging in two ways:

- (1) Matter that is not, in and of itself, disgusting or otherwise unpleasant, may be applied or combined in such a way that it is offensive to the disparaged party. See, e.g., *In re Anti-Communist World Freedom Cong., Inc.*, 161 USPQ 304, 305 (TTAB 1969) (holding design of an “X” superimposed over a hammer and sickle to disparage, and to bring into contempt and disrepute, a national symbol of the U.S.S.R.); or
- (2) Matter may be inherently offensive, and, when directed at a specific individual or entity, may become even more offensive. See, e.g., *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1640 (TTAB 1988) (noting “the offensiveness of [applicant’s mark, depicting a defecating dog,] becomes even more objectionable because it makes a statement about opposer itself”).

The attached evidence shows the likely meaning of “THE SLANTS” to be a negative term regarding the shape of the eyes of certain persons of Asian descent. See attached definitions of “Slant”. This refers to “persons of Asian descent” in a disparaging manner because it is an inherently offensive term that has a long history of being used to deride and mock a physical feature of those individuals. See Online Etymology Dictionary, Mother Chronicles, “Slant Eyes, Almond Eyes, What’s in those Chinese Eyes?”.

The term “slants” and the full equivalent “slant-eyes” has long been a derogatory term directed towards those of Asian descent. The etymology of the term suggests that its use became prevalent during the various wars of the 20th century, starting with World War II and increasing in use in the Vietnam war as a

term to deride and mock the citizens of the countries at war with the United States and those of Asian descent in general. *See* *The Color of Words: An Encyclopaedic Dictionary of Ethnic Bias in the United States*.

Since that time, the research of the Office indicates that the term “slants” retains its offensive and derogatory meaning. Importantly, the oldest and largest Asian American civil rights organization in the United States, the Japanese American Citizens League (JACL), has issued a publication on hate speech that specially states that the term “slant” is derogatory and should not be used. *See* attached webpage excerpt and literature on hate speech from JACL. Moreover, numerous dictionaries define “slants” or “slant-eyes” as a derogatory or offensive term. *See* attached definitions from, among others, Oxford Dictionary of Modern Slang, American Heritage Dictionary, Online Etymology Dictionary, New Partridge Dictionary of Slang and Unconventional English, *The Color of Words: An Encyclopedic Dictionary of Ethnic Bias in the United States*, American English Compendium, and [Urbandictionary.com](http://urbandictionary.com). Further, many listings of slang and offensive terms include the word “slants” and its derivatives such as slant-eyes, slanted-eyes, and the pictorial representation as a slur or derogatory. *See* listing of racial slurs from Wikipedia.org, <http://gyral.blackshell.com/names.html>, http://www.asianjoke.com/others/ethnic_slurs.htm, and www.fact-index.com/list_of_ethnic_slurs.html.

More specifically, the band’s name has been found offensive numerous times. First, a band performance and a speaking engagement for the lead singer were cancelled because there had been concerns raised over the name of his band. *See* *The Daily Swam*, “Oregon Governor Cancels Asian Band the Slants’ Performance at Asian Youth Conference.” Second, articles on the band have noted that the name has been controversial and that the band chose the name, in part due to the history of the term. *See* *Northwest Asian Weekly*, “Rock band to trademark Office: Our Name is Not Disparaging to Asians”, “Shuffled! The Slants”. Further, several bloggers and commenters to articles on the band have indicated that they find the term and the applied-for mark offensive, even after extensive dialogue with the applicant. *See* attached blogs and article comments, including BigWOWO and Ben Efsaneyim.

Applicant may have chosen the applied-for mark to be self-deprecating and to attempt to reappropriate the disparaging term. The lack of a disparaging intent is not dispositive on the issue of Section 2(a) disparagement in the Federal registration analysis. The intent of an applicant to disparage the referenced group is not necessary to find that the mark does, in fact, disparage that group. *In re Lebanese Arak Corp.*, 94 USPQ2d 1215, 1220 (TTAB 2010); *see also In re Anti-Communist World Freedom Cong., Inc.*, 161 USPQ 304, 305 (TTAB 1969) (finding applicant’s intent to disparage the referenced group immaterial to the disparagement determination). Further, while applicant may not find the term offensive, applicant does not speak for the entire community of persons of Asian descent and the evidence indicates that there is still a substantial composite of persons who find the term in the applied-for mark offensive.

Please note that the denial of the trademark application does not mean that the applicant must use a different name with its music performances or is otherwise prohibited from using the wording “The Slants” in association with its music. Rather, it is a denial of a federally registered trademark, not the right to use the words. *See In re Heeb Media LLC*, 89 USPQ2d 1071 (TTAB 2008) (quoting *In re McGinley*, 211 USPQ 668, 672 (CCPA 1981) (“[I]t is clear that the PTO’s refusal to register [applicant’s] mark does not affect [its] right to use it. No conduct is proscribed....”).

The Office research indicates that the applied-for mark remains disparaging to a substantial composite of Asian-Americans. Accordingly, registration is refused under Section 2(a) as disparaging.

GENERAL INFORMATION

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

/Mark Shiner/
Trademark Examining Attorney
Law Office 102
Phone: 571-272-1489
E-mail: mark.shiner@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

Despite name, band aims for diverse dance rock The Oregonian (Portland Oregon) December 4, 2010 Saturday

music, "Sakura Sakura" is energetic and rhythmic, with catchy, sometimes haunting lyrics --aptly earning them the title "dance rock."

Young says they originally chose to include Chinatown as part of the description because "Chinatown dance rock" sounded cool. But soon, it became a reflection of all Chinatowns, everywhere. "In a Chinatown it's not all just Chinese cultures. It's a point where all different kinds of Asian immigrants come to town and converge," he said. "For our band, we're not just Chinese, we're not just Vietnamese, we're kind of a pan Asian band that celebrates all the different Asian cultures out there."

Although The Slants continues to be a controversial name, according to Young, "Everyone in the band really loves the fact that we can try and empower Asian Americans and say, 'You know what? We are slanted. Who cares? We're proud of that.' "

The Slants have toured nationwide and play at many anime conventions and Asian cultural festivals. Their current demographic is predominately teenage girls, but Young said they like to play for "anybody and everybody."

He concluded, "We hope that our music can bring together all sorts of people --both Asian and not, old and young. We're just like hey, let's come together, dance and have a good time."

LOAD-DATE: December 5, 2010

Asian immigrant, complete with slant-eyed jokes? Maybe it's niffing off the movie. But no one has seen the movie.

The play also needs a bigger theater, better choreography and a live band, rather than the taped music of this production. Mostly, though, it needs a character, any character, who generates some sympathy. "One-Way Ticket" is aiming for the same campy territory as "Little Shop of Horrors." But " ...

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May 11, 2003, Sunday, Metro Edition

SECTION: NEWS; C.J.; Pg. 7B

LENGTH: 875 words

HEADLINE: Hall airs best features on Oxygen mag cover;
The Fox Sports Net North honcho shows off her breathtaking buffness

BYLINE: Cheryl Johnson, Staff Writer

|

BODY:

...tells the mag that her parents, Veretta and Herbert Hall, are her role models. They've been married 35 years, surviving the '60s as an interracial couple. Happy Mother's Day to Veretta. "My mom said she thinks it's so important to take care of yourself and stay healthy," Hall said.

Words fail Ed Piette

"My whole approach is that viewers out there don't look at the color of someone's skin or the slant of a person's eyes," said KSTP-TV G.M. Ed Piette. This quote regarding the hiring of anchor Kent Ninomiya started out so nobly before it veered into Prince Philip territory. "OK. Wow. Ouch," said Mae Cheng, national president of the Asian American Journalists Association, when she heard it. "It's insensitive. Various forms of the word slant are "very stereotypical adjectives [describing] Asians and Asian Americans," Cheng said. "There are other words that could have been used." For example, Piette could have referred to the shape of a person's eyes. Around the office he is known as a fast talker _ guess his mouth ran away from him? Piette just laughed. "If in fact there are those out there who feel I offended them, I certainly apologize. There was no intent to do that, and I stand by my actions, which were to hire this individual because of his journalistic credentials." Piette has heard that someone from the KQ Barnyard had the nerve to rip him on this matter. That's rich, given the morning show's penchant for racial slurs and its unimpressive record in minority hiring. Despite Piette's verbal slip, KSTP-TV still gets high marks for hiring Ninomiya and pairing him with ...

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sky 1. an unpleasant person; one's enemy. Possibly from SKITE (*q.v.*). [British slang, mid 1800s, Hotten] 2. a derogatory nickname for an Italian. [Australian, early 1900s, Baker] Synonyms for sense 2: DINGBAT, DINO, EYTIES, EYTO, GHIN, GINGO, GINNEY, GINZO, GREASER, GUIN, GUINEA, GUINIE, GUINNEE, HIKES, ITE, ORGAN-GRINDER, RING-TAIL, SPAGHETTI, SPAGHETTI-BENDER, SPIC, WALLIYO, WOP, ZOO. 3. whisky. From "whisky." Cf. SKEE. [widespread slang, 1900s]

sky-pilot a preacher; a chaplain; an evangelist or a missionary. [British and U.S. slang, late 1800s-pres.] Synonyms: AMEN SNORTER, BIBLE-BANGER, BIBLE-BASHER, BIBLE-POUNDER, BIBLE-PUNCHER, BIBLE-THUMPER, BISH, BLACK COAT, CHIMNEY SWEEP, CHRISTER, CUSHION-THUMPER, DEVIL-CATCHER, DEVIL-CHASER, DEVIL-DODGER, DEVIL-DRIVER, DEVIL-PITCHER, DEVIL-SCOLDER, DEVIL-TEASER, DIVINE, DOMINIE, FIRE ESCAPE, FIRE INSURANCE AGENT, GLUEPOT, GOD-BOTHERER, GOSPEL-COVE, GOSPEL-GRINDER, GOSPEL-POSTILION, GOSPEL-PUSHER, GOSPEL-SHARK, GOSPEL-SHARP, GOSPEL-SHOOTER, GOSPEL-WHANGER, HAUL-DEVIL, HEAD CLERK OF THE DOXOLOGY-WORKS, HOLY-JOE!, JESUS-SCREAMER, JESUS-SHOUTER, MAN-IN-BLACK, MAN OF THE CLOTH, PADRE, PARISH-BULL, PARISH-PRIG, PARSON, POUND-TEXT, PULPIT-CUFFER, PUZZLE-TEXT, SALVATION-RANCHER, SIN-HOUND, SKY-RIDER, SKY-SCOUT, SNUB-DEVIL, SOUL-AVIATOR, SOUL-DOCTOR, SOUL-DRIVER, SPIRITUAL FLESH-BROKER, TICKLE-TEXT.

skyrocket an amphetamine tablet or capsule. Cf. ROCKET, ROCKET-FUEL. For synonyms see AMP. [U.S. drug culture, mid 1900s-pres.]

slack 1. to urinate. [British slang, 1800s, Farmer and Henley] 2. a slovenly man or woman; a sexually loose woman. [Caribbean (Jamaican). Cassidy and Le Page]

slacks trousers. For synonyms see GAL-LIGASKINS. [U.S. colloquial, 1900s]

slag (also **slagheap**) a sexually loose woman. [U.S. collegiate, late 1900s, Munro]

slam to COIT someone, presumably a woman. For synonyms see OCCUPY. [U.S. slang, late 1900s]

slammed alcohol intoxicated. For synonyms see WOOFLED [U.S. slang, late 1900s]

slam some beers to drink beer; to drink a number of beers. [U.S. slang, late 1900s]

slant a derogatory nickname for any Oriental. From the shape of the Oriental eyes. Cf. SRANT. [U.S. slang, mid 1900s-pres.]

slant-eye (also **slant-eyes**) a derogatory nickname for an Oriental. [U.S. underworld and slang, early 1900s-pres.]

slap artist a sadist; a man who achieves erection (or orgasm) while beating or slapping a woman. [early 1900s, *Dictionary of the Underworld*]

slash 1. to urinate. Cf. SPLASH. For synonyms see WHIZ. 2. urination; an act of urination. [both senses, British slang, 1900s, *Dictionary of Slang and Unconventional English*] 3. women considered as sexual objects. [U.S. slang, 1900s]

slashers the testicles. For synonyms see WHIRLYGIGS. [British slang, mid 1900s, *Dictionary of Slang and Unconventional English*] 3. women considered as sexual objects. [U.S. slang, 1900s]

slattern a carelessly dressed and sloppy woman; a dirty or sloppy housekeeper. Occasionally there is some reference to low manners or other negative characteristics. [since the early 1600s]

slaughtered alcohol or drug intoxicated. For synonyms see TALL, WOOFLED. [U.S. slang, 1900s]

slaughter-house a brothel. Cf. CUT (sense 3), MEAT (sense 2). [British slang, 1900s, *Dictionary of Slang and Unconventional English*]

sleep around to be sexually promiscuous. [somewhat euphemistic; U.S. slang, mid 1900s-pres.]

sleepers a barbiturate or nonbarbiturate capsule or tablet. [U.S. slang and drug culture, mid 1900s-pres.]

sleep with to copulate with someone; to copulate with someone illicitly. This

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Slang and Euphemism

*A dictionary of oaths, curses,
insults, sexual slang and metaphor,
racial slurs, drug talk, homosexual lingo,
and related matters*

SECOND ABRIDGED EDITION

by
Richard A. Spears

ASSOCIATE PROFESSOR OF LINGUISTICS
NORTHWESTERN UNIVERSITY



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PHYSICAL TRAITS

About one in five ethnic epithets in American English refers to supposed physical traits of groups. These are allusions to color, to shapes of eyes, heads, noses, and lips, and to hair texture. Epithets that refer to physical traits are mostly interracial slurs. Nearly half of all interracial slurs (whites slurring blacks, Asians, and Native Americans—and these racial minorities slurring whites) refer to real or imagined physical differences. Whites have called Asian-American groups *slant eyes* and Asians have begun calling whites *round eyes* as a comeback. Jews were called *eagle beaks* and blacks *broad noses*. African Americans were also called *wooly heads* and blacks, in turn, called whites *silks*, an allusion to thinner, straighter hair.

Most references to physical differences are to skin color, which affirms what we have always known about the significance of color in human relations. Asian groups were called *yellow* this and that and Native Americans were called *redskins*, *red men*, and *red devils*. Most slurs on skin color appear in the name-calling between whites and blacks. Whites have slurred blacks with a profusion of terms that allude to dark skin (*blue*, *darky*, *shade*, *smoke*) and blacks, tit for tat, have slurred whites (*chalk*, *grey*, *pink*, *pale*). A large number of white terms for African Americans were *black* this or that, such as *black bird*, or else a word for something—anything—black in color, such as *coal*, *charcoal*, *skillet*, *tarpot*, and a host of others.

CHOCOLATE IS BROWN AND SO ARE YOU

A bizarre feature of making derisive names about color differences is the many references to the color of foods. A perennially popular derisive name for African Americans is

Korean Women

moose Originally a female prostitute, but later applied to any girl or woman. Perhaps from Japanese *musume*, girl. Yet *moose* is American slang for an “ugly” woman.

slant eye The generic slur for any Asian person seemed to become chiefly feminine when referring to Koreans.

Mexican Women

hot tamale 1929. Also a pun on slang *hot*, sexy.

mexican dish 1930s. A pun on slang *dish*, an attractive woman.

sexy mex(y)

Native American Women

squaw From various Algonquian words for *woman*. Later used for any Native American woman. See under Inupiat Women.

Pacific-Islander Women

gee chee Often feminine. Perhaps from either Japanese *geisha*, a female entertainer, or *geechee*, a Bahamian black person. It is also a generic term for a Eurasian woman.

gooney gal Also *gooney girl*. From *gooney*, a term of uncertain origin for any South Seas Islander, but possibly from the name of the gooney bird.

grass skirt A Hawaiian. A pun on slang *skirt*, a woman.

hula Lula Also *hulabula*. A Hawaiian. Cf. *grass skirt*.

Mary Originally any female household servant. From the given name.

pineapple A native “dish.”

shack mammy Related to slang *to shack up*, to live illicitly with a local woman in a tropical “shack.”

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UNKIND WORDS

Ethnic Labeling from
Redskin to *WASP*

IRVING LEWIS ALLEN



BERGIN & GARVEY

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Simon Shiao Tam

Mark: THE SLANTS

Serial No.: 85472044

Filing Date: November 4, 2011

Examining Attorney: Mark Shiner

Law Office: 102

RESPONSE TO OFFICE ACTION DATED JANUARY 6, 2012

Applicant submits this response to the Office Action dated January 6, 2012, in which the Examining Attorney refused registration of Applicant’s standard character mark on the grounds that the mark consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols pursuant to 15 U.S.C. §1052(a). In response, Applicant respectfully submits the following:

I. THE APPLICATION DOES NOT JUSTIFY A FINDING THAT THE APPLICANT’S STANDARD CHARACTER MARK IS DISPARAGING.

The Examining Attorney relied, in making his denial, on materials assertedly showing the “likely meaning” of “THE SLANTS” to be “a negative term regarding the shape of the eyes of certain persons of Asian descent,” citing sources indicating that the word can refer to “persons of Asian descent . . . in a disparaging manner” and “is an inherently offensive term that has a long history of being used to deride and mock a physical feature of those individuals.”

Applicant disputes the relevance of these materials, and certainly the conclusion the Examining Attorney draws from them, for reasons set forth below. Fundamentally, Applicant’s response is that in contrast to all disparagement-based refusals to register cited by the Examining Attorney, the applied-for mark “THE SLANTS” has meanings other than the disparaging

meaning that is the Examining Attorney deemed “likely,” the word “slant” being a common English word (and the dominant portion of numerous trademark registrations). The Application provides no basis, based on the goods or services described in the application for registration, for the Examining Attorney’s conclusion that the likely meaning of the mark is in the disparaging sense.

Indeed, as demonstrated below, the Examining Attorney’s finding that the “likely meaning” of “slant” is an ethnic slur was achieved by refusing even to consider the neutral meanings of the word and by bypassing the actual Application submitted – on which no such finding could be based – and instead building an entire independent record as a predetermined basis for that conclusion. As demonstrated below, both of these approaches were improper.

A. Application of the Relevant Legal Standard for Choosing Among Disparaging or Non-Disparaging Meanings of the words “The Slants”

As the Office Action notes, the first question that must be addressed under Section 2(a) is “What is the **likely meaning** of the matter in question . . .” in light of the circumstances. *In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264 (TTAB 2006) (emphasis added). In determining such meaning, the PTO is adjured to consider “**not only** dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods and/or services, and the manner in which the mark is used in the marketplace” based on use of the marks “on applicant's identified goods and services” (emphasis added).

The premise of the *Squaw Valley* formulation is that a dictionary definition may well be insufficient authority on which to determine whether a trademark is disparaging meaning; i.e., while not dispositive, dictionary definitions are relevant to the inquiry. Two corollaries follow: (1) where the dictionary definition does not, by itself, support a finding of disparagement, that

fact standing alone favors the Applicant; and (2) if a dictionary, or even the full scope of sources set forth in Squaw Valley, suggest that the trademark is amenable to multiple meanings, the burden is on the PTO to demonstrate why one meaning and not another is the likely meaning.

a. Cases Relied on by the Examining Attorney

The Examining Attorney cited several cases in the Office Action, each of which is materially distinguishable from this case mainly because they involve trademarks whose meanings – based either on their sole or at least dominant definitions, or the facts in the respective applications – could **only** be disparaging:

- In *In re Lebanese Arak Corp.*, 94 USPQ2d 1215 (TTAB 2010), the subject trademark was KHORAN, for use with alcoholic beverages. This was, unsurprisingly, found to constitute disparagement because Islam prohibits the consumption of alcoholic beverages. There was no neutral interpretation of the mark in juxtaposition with the use.
- *In re Anti-Communist World Freedom Cong., Inc.*, 161 USPQ 304 (TTAB 1969) concerned disparagement of a “national symbol” – the hammer-and-sickle symbol of the Soviet Union – whose symbolism was amenable only to that association.
- *In re Heeb Media LLC*, 89 USPQ2d 1071 (TTAB 2008) concerned the trademark HEEB, a disparaging term for Jews with no other English meaning.
- The trademark in *In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264 (TTAB 2006) was SQUAW – an offensive term referring to a female American Indian and meaning nothing else.

- And *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705 (TTAB 1999) involved the use of the mark REDSKINS, also regarded as demeaning by American Indians and also lacking any other definition.

In not one of the cases cited by the Examining Attorney was the subject trademark a plain English word, such as “slants,” that only **could, but need not**, have a disparaging connotation. Each and every one of them involved a trademark that could only be offensive based on the four corners of the application – the mark itself (i.e., the word or term), the description and the specimens. In extending these cases to the Application, where the registration sought is for a standard English word having multiple meanings and where nothing in the Application provides grounds for finding the use of the term disparaging, the Office Action represents a significant departure from precedent and an unwarranted extension of 15 U.S.C. §1052(a).

Indeed, unlike the various offensive terms cited by the Examining Attorney via case law and otherwise known to have been rejected for registration, the word “slant,” in singular or plural form, is the dominant portion of numerous registrations, many of them quite recent.¹ While PTO decisions respecting registration are not precedential, in this case these registrations can hardly be ignored as demonstrations that the word “slant” is in and of itself a registrable term. The Office Action neither demonstrates that the use of the same word as a trademark for “entertainment in the nature of live performances by a musical band” is disparaging, nor that any

¹ These include, for example, the following (see Exhibit A) – there are many more in addition to these:

- SLANTS, Serial Number 85269787 (ITU), published for opposition August 2, 2011
- SLANT, Registration Number 4123704 dated April 10, 2012
- SLANT, Registration Number 3894536 dated December 21, 2010
- SLANT, Registration Number 3437238 dated May 27, 2008
- SLANT, Registration Number 3437230 dated May 27, 2008

other matter found in the Application provides a basis for the Examining Attorney's conclusion regarding the mark's "likely meaning."

Seen this way the Office Action seems to amount to a prohibition against registration by this Applicant *ad hominem* – a ruling that this Applicant is different from others whose "slant" registrations have been allowed, and the implication that if an identical application were filed under a different name, it would have been. Such a result could not be justified by any rule or legal precedent, and in and of itself raises troubling legal questions that need not be addressed in this Response.

b. Definitions of the Word "Slant"

1. Dictionary and other Definitions provided by the Examining Attorney

The Examining Attorney has taken a rule authorizing him to go **beyond** dictionary definitions as permission to **ignore** the most authoritative dictionary definitions entirely. In fact, the Office Action makes no effort even to cite entries from actual dictionaries, with the exception of a reference from the *American Heritage Dictionary* that ignores **three** inoffensive definitions given for the word "slant" and relies on the fourth, slang entry. In doing so, the Examining Attorney proceeded as if seeking an offensive definition to the exclusion of all else, disregarding, without explanation, that fact in the *American Heritage Dictionary*, "Entries containing more than one sense are arranged for the convenience of the reader with the central and often the most commonly sought meaning first."² The Examining Attorney did not provide any justification for disregarding the three more common definitions, or in any way address the fact that the word "slant" primarily has an inoffensive meaning.

² The American Heritage Dictionary of the English Language website, found at http://ahdictionary.com/word/how_touse.html, last visited May 2, 2012.

To the contrary, in order to “demonstrate” that the fourth-level definition sought to be emphasized by the Examining Attorney is supported by a mass of authority, the Office Action sets forth the results of an extensive, but predetermined and outcome-directed inquiry directed to works that are not dictionaries at all, or certainly not dictionaries as that term was meant by the *Squaw Valley* formulation of “not only dictionary definitions.” For example, the Examining Attorney cites a book called *The Color of Words: An Encyclopaedic Dictionary of Ethnic Bias in the United* to elucidate the history of the ethnic slur associated with the word “slant,” fully aware that this book is a “dictionary of terms associated with racial discrimination”³ – guaranteeing that the mere existence of an entry in the book would “prove” a disparaging meaning, and would shed no light on whether the word in question has a non-discriminatory meaning as well.

Most of the other works cited by the Examining Attorney that describe themselves as “dictionaries” also, by their own terms, narrow the field of inquiry so as to exclude standard English definitions of the word in question. Indeed, the Office Action states, “many listings of slang and offensive terms include the word ‘slants’ and its derivatives such as slanteyes, slanted-eyes, and the pictorial representation as a slur or derogatory.” But the Examining Attorney has, it is submitted, done no more than demonstrated a “converse error,” which is the logical fallacy of “affirming the consequent” – reversing or confusing the general category with the specific or sub-category. Naturally if one peruses a list of “forbidden words” for a specific word – albeit one that also has a “permissible” use also – the mere confirmation that the word is on that list constitutes a “false positive.” The exercise serves only to confirm a preexisting and relatively uncontroversial premise, namely that the word “slant” has a disparaging meaning – much in the way that it has been said a censor will, inevitably, “feed” his own prurient interests if he looks

³ *Library Journal*, quoted by Amazon.com at the entry for the work found at <http://www.amazon.com/The-Color-Words-Encyclopaedic-Dictionary/dp/1877864420>, last visited May 2, 2012.

hard enough at the material in question.⁴ Such an exercise sheds no light at all on whether that meaning is the dominant one, however, or even close to being dominant, and improperly exempted the Examining Attorney from any explanation as to why the disparaging definition of “slant” was to be inferred from the application over the non-disparaging ones.

Further consideration of the content of the lists and sources relied on by the Examining Attorney, in fact, is illuminating, and further demonstrates their very limited usefulness for the purposes to which they have been put in the Office Action. For example, the Office Action gives, as an additional authority, an anonymous website called the “Racial Slurs Database” found at <http://gyral.blackshell.com/names.html>. Perusing that list, a user will learn that the following English words are, along with “slants,” also presumably “disparaging” and not eligible for trademark registration:

- Apple
- Banana
- Cans
- Beanie
- Brother
- Bumblebee
- Cabdriver
- Canal

These are just a few examples; Applicant has not proceeded beyond the “C’s.”

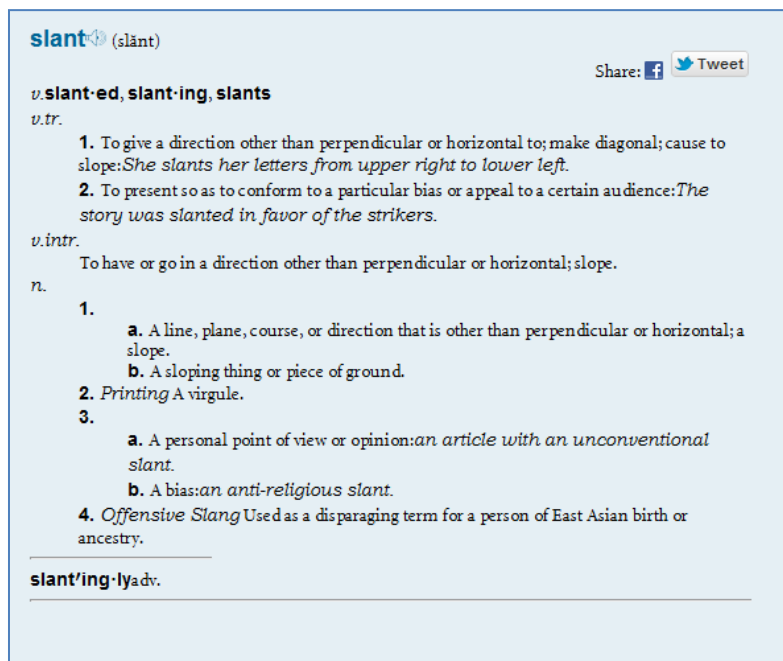
The point of this discussion is to demonstrate that finding a word amenable to numerous meanings on a list of ethnic slurs is of little weight when considering whether it is in fact disparaging. Such lists certainly do not constitute “dictionary definitions.” And in and of themselves they reveal nothing about “the relationship of the matter to the other elements in the

⁴ The humorist Dick Cavett is quoted as saying, specifically, “Censorship feeds the dirty mind more than the four-letter word itself.”

mark, the nature of the goods and/or services, and the manner in which the mark is used in the marketplace in connection with the goods and/or services” and should not have been relied on by the Examining Attorney absent any content in the Application suggesting that an ethnic-oriented meaning of the word was the one intended by the Application.



2. Dictionary Definitions not Considered by the Examining Attorney

As noted above, in providing a definition for THE SLANTS, the Examining Attorney relied in part on the *American Heritage Dictionary*, leaping over almost the entire entry in that work defining the word “slant” to find a fourth, slang definition that fit a preconceived notion. It is worthwhile, however, for the record to indicate what, in fact, was overlooked in the body of the Office Action, although it was displayed as a screen capture of that dictionary’s entry included in its exhibits, as reproduced below:⁵



The image is a screenshot of the online entry for the word "slant" from the American Heritage Dictionary. The entry is titled "slant" with a small icon of a slanted line and the phonetic transcription "(slănt)". To the right of the title are social media sharing options for Facebook and Twitter. The entry is divided into several parts: a transitive verb section with two numbered definitions and example sentences; an intransitive verb section with one definition; a noun section with four numbered definitions, each with sub-points (a and b) and example sentences. The entry concludes with the adverb "slant'ing-ly".

slant (slănt)

Share:   Tweet

v. **slant·ed, slant·ing, slants**

v. tr.

1. To give a direction other than perpendicular or horizontal to; make diagonal; cause to slope: *She slants her letters from upper right to lower left.*
2. To present so as to conform to a particular bias or appeal to a certain audience: *The story was slanted in favor of the strikers.*

v. intr.

To have or go in a direction other than perpendicular or horizontal; slope.

n.

1.
 - a. A line, plane, course, or direction that is other than perpendicular or horizontal; a slope.
 - b. A sloping thing or piece of ground.
2. *Printing* A virgule.
3.
 - a. A personal point of view or opinion: *an article with an unconventional slant.*
 - b. A bias: *an anti-religious slant.*
4. *Offensive Slang* Used as a disparaging term for a person of East Asian birth or ancestry.

slant'ing-ly *adv.*

⁵ “Slant” in *The American Heritage Dictionary of the English Language*, found at <http://ahdictionary.com/word/search.html?q=slant&submit.x=0&submit.y=0>, last visited May 2, 2012.

Applicant respectfully submits that there is nothing in the Application to even suggest that definition number (4), describing the offensive slang on which the Examining Attorney relies in denying registration, is more likely to be the Applicant's intended meaning of the mark than the first three, more common or "central" meanings of the word.⁶

B. Application of the Relevant Legal Standard for Evaluating Disparaging Use to the Pending Application

To justify refusing to register a trademark under the first clause of section 1052(a), the PTO must, in addition to weighing the factors set forth in the last quotation, "consider the mark in the context of the marketplace as applied to **only the goods described** in [the] application for registration." *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994) (emphasis added), citing *In re McGinley*, 660 F.2d 481, 485, 211 USPQ 668, 673 (CCPA 1981). It is respectfully submitted that the Examining Attorney overlooked the actual content of the Application, which is devoid of any reference to Asians, to conclude that THE SLANTS must be a reference to Asians.

c. Goods and services described in the application

1. Description

The description of goods and services provided in connection with the mark found in the Application is "Entertainment in the nature of live performances by a musical band." Nothing in this description refers to Asians, and cannot, therefore, justify the Examining Attorney's "likely meaning" conclusion.

⁶ See also, Oxford English Dictionary, reproduced as Exh. B hereto, showing the ethnic-slang definition of "slant" as the **tenth** out of ten definitions.

2. Specimens

The specimens submitted in support of the Application are three advertisements for the musical band referred to in the description. The Examining Attorney at no time requested



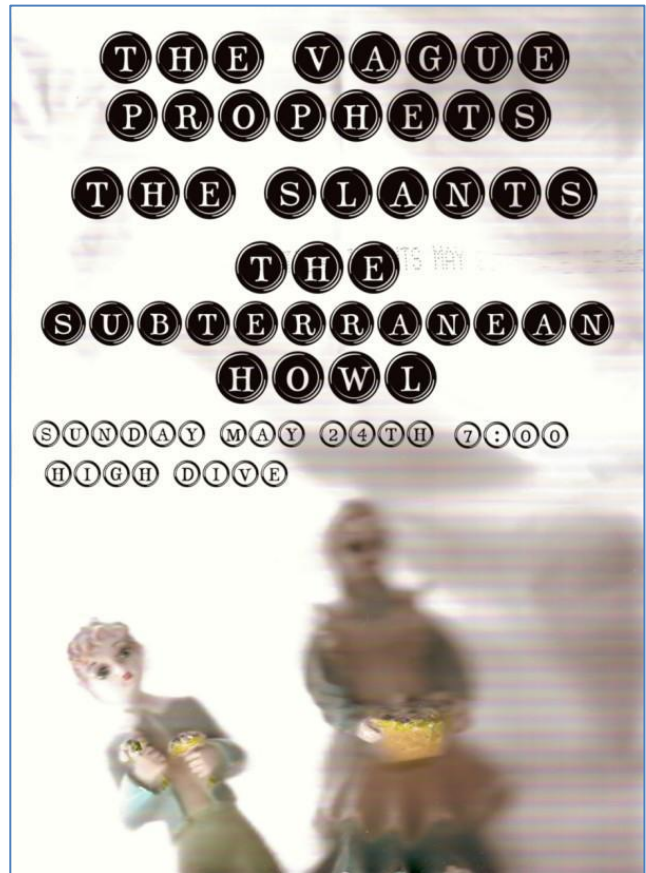
Specimen 1

depicted, three of which are shown playing musical instruments with rock-and-roll-style verve and enthusiasm, and emerging from within the elevated beehive-style hairdo of a fourth, larger, female figure who is driving a 1950's style automobile. None of the characters shown on Specimen (1) could be described as possessing Asian features, either stereotyped or otherwise. Nor could the automobile. No other indicia or associations with Asian persons are present.

additional or replacement specimens. The specimens submitted with the Application, to which the Office Action makes no reference but which are in fact an appropriate basis for the Examining Attorney to consider the Applicant's use of the mark, are reproduced here for convenience.

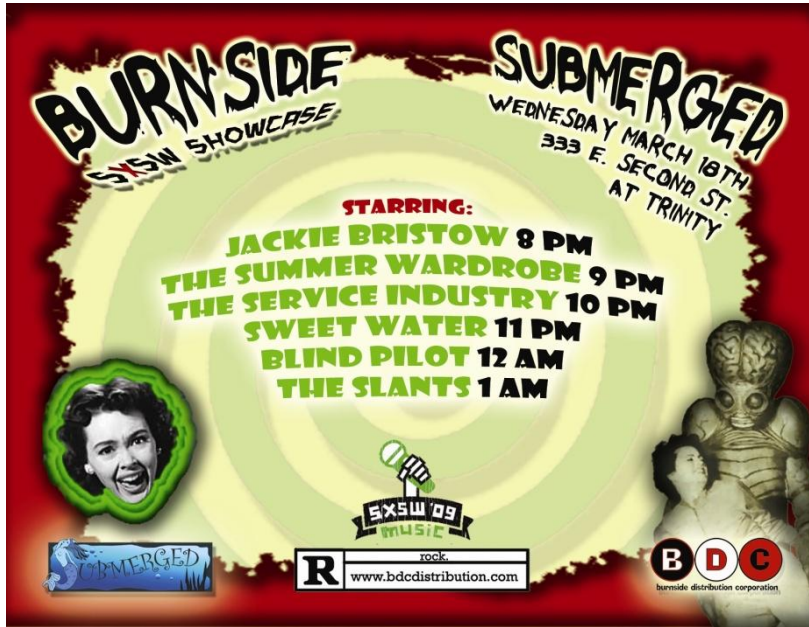
Specimen (1), reproduced at left, displays the names of three musical bands, "The Moon Spinners," "The Slants," and "The Get-Offs," who are to be performing at a venue called The Sunset, located in Seattle, Washington. Four stylized human figures are

Specimen (2), at right, refers to a performance, also by three ensembles including The Slants, at a venue called “High Dive.” Unlike Specimen (1), this handbill is “highly conceptual,” i.e., it bears no perceivable relation to the bands performing or their names, or high diving, or even to music, entertainment or anything clear at all. It depicts two eerie, doe-eyed female figurines or dolls, one of which is blurry and the other of which is leaning precipitously. Nothing about this hallucinogenic imagery suggests any association with Asians, so, like Specimen (1), there is no ground based on this specimen to find that the use of the mark justifies the Examining Attorney’s presumption that the THE SLANTS is being used in its unusual, disparaging sense.



Specimen 2

Finally, Specimen (3), below at left, also promotes a performance by various bands including The Slants. The theme in Specimen (3), as suggested by both the typeface used and



Specimen 3

the stock photos, is 1950's American science-fiction cinema in the "camp" style. The poster, which utilizes "creepy" typography and graphical style of that era, depicts a "screaming" teenage girl (not evidently Asian) on the

left and, on the right, an adult woman (also not evincing Asian features or other indicia of Asian ethnicity) conveying distress apparently arising out of her encounter with the "Metaluna Mutant," the antagonist in the 1955 motion picture, *This Island Earth*. Based on a novel of the same name, in this work the creature's origin is the fictional planet Metaluna,⁷ which of course is not in Asia.

Analysis of the content of this third and final Specimen is consistent with that of the other two, and its purpose is to demonstrate the following: Based on Application actually before the Examining Attorney, including the description and the specimens accepted by the Examining Attorney, and applying the instruction of *Mavety* that a mark be considered "in the context of the marketplace as applied to only the goods described in [the] application for registration," there is no basis for the conclusion in the Office Action that the registration of THE SLANTS would be

⁷ "This Island Earth," Wikipedia, found at http://en.wikipedia.org/wiki/This_Island_Earth, last visited on May 2, 2012.

unlawful on the ground that use of the word “slants” as a trademark for musical bands would offend Asians. There is nothing specifically, much less necessarily, “Asian” in the Application, and therefore no basis in the Application for the Examining Attorney’s finding as to the mark’s “likely meaning.”

d. Goods and services described in the Office Action

While the Application itself provides no basis for refusal to register Applicant’s THE SLANTS mark on the ground of disparagement, the Office Action relies on various other material that it treats as proof of the Applicant’s use of the mark. These are provided as context both for the sense of the word “slant” the Examining Attorney maintains the Applicant means to convey and the reactions that the marks’ use has supposedly engendered in the Asian community. It is respectfully submitted, however, that the Examining Attorney’s reliance on this material for the first of these two purposes – defining the use of the mark in contradistinction to how it is defined in the Application – is improper.

An examining attorney may refer to outside materials for purposes of assessing whether a mark suspected of being disparaging is regarded as such by the affected group. But such an inquiry properly takes place only after a prima facie determination that the application itself could indeed raise such a suspicion. Put differently, it is not the PTO’s practice, nor could it be, to conduct a “disparagement search” on every application – even words that may be known to the Examining Attorney to be contained on supposed lists of “bad words” such as those set forth above – words such as “apple,” “cans,” or “dyke” – that comes before it. As a threshold matter, the proper approach to such a determination under *In re Mavety*, i.e., the way the PTO determines **what an application is**, is the “context of the marketplace **as applied to only the**

goods described in [the] application.” *Id.*, 33 F.3d at 1371. See *In Re Hershey*, 6 U.S.P.Q.2d 1470 (TTAB Mar. 10, 1988) (focusing analysis on specimens); *In re Bose Corporation*, 546 F.2d 893, 192 USPQ 213 (CCPA 1976) (“an application for registration must be adjudged in light of the specimens of record”).

Here the Office Action makes no reference whatsoever to the “goods [or services] described in the application,” meaning the description of goods and services – “Entertainment, namely, live performances by a musical bands” – as illustrated by the specimens analyzed above. Registration was not refused on the ground that the specimen of use does not “evidence an association between the mark and the services specified in the application” pursuant to here under 37 C.F.R. 2.56(b)(2)). No substitute specimen was requested by the Examining Attorney. Rather than request additional evidence or request clarification, the Examining Attorney conducted an independent Internet search and came to his own conclusions concerning that use without any regard for the content of the Application that was refused.

In fact, absent an inquiry based on 37 C.F.R. 2.56(b)(2)), the Lanham Act does **not** mandate inquiry into specific goods or services not shown in the application itself. *In re McGinley, supra*, 660 F.2d at 485, 211 USPQ at 673. While TMEP Rule 710.01(b) provides that “Articles downloaded from the Internet are admissible as evidence of information available to the general public, and of the way in which a term is being used by the public,” such research refers essentially to evaluation of whether a mark is used descriptively or, as set forth above, whether a mark is generally used by the general public as a disparaging term. But the Examining Attorney did not conclude, from his Internet research, how the **public** uses the Applicant’s mark, but supposedly how the Applicant does. But this a not a situation akin to *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 1378-79 (Fed. Cir. 2007), where such research was justified as

defining “the genus of services at issue,” which is not at issue here. Moreover, in *Reed Elsevier*, the information at issue came from the Applicant’s own website; hence the Rule provides that “The examining attorney must check applicant's own website for information about the goods/services.” But the Office Action in this matter includes no excerpts from the Applicant’s website and cites no such material as grounds for the refusal.

Nor is there any reason that proper examination procedure would encourage such adventures. Disregard of the description of goods and specimens accompanying an application, as took place here, in favor of an independent research project undermines the concept of a trademark registration application as a *prima facie* “closed system” per opinions such as *In re Mavety*, *In Re Hershey* and *In re Bose Corporation*. A “free-form” approach to examination would also test the dubious proposition that Internet claims about a given applicant’s use of a given mark at a given time is entitled to more evidentiary weight than the Applicant’s own description of goods and services, even without a showing of inadequacy or fraud. This is especially true where, as here, the culling of Internet searches is unaccompanied by any accounting with respect to search results discarded as well as those submitted.

If the Examining Attorney had reason to believe that Application was incomplete, he could have made a request for more information or even a rejection premised on the inadequacy of the specimen as proof of the mark’s use under 37 C.F.R. 2.56(b)(2), which he did not. Yet in fact, as demonstrated above, there is no legitimate springboard for such a request or ruling. Nothing in the Application suggests that the specimens are incomplete, inaccurate or otherwise want supplementation.

Rejecting the Application based on other proceedings or independent research, however, is not an appropriate alternative; nor is arriving at a predetermined result without regard for the


record. Yet by all indications, these considerations – and not the Application itself – form the basis for the refusal embodied by the Office Action.

II. CONCLUSION

In light of the foregoing, Applicant respectfully requests that the Examining Attorney withdraw his refusal to register Applicant's mark and publish Applicant's mark on the Principal Register.

Respectfully submitted,

Simon Shiao Tam

By: 
Ronald D. Coleman

GOETZ FITZPATRICK, LLP
One Penn Plaza, 44th Floor
New York, New York 10119
(212) 695-8100

Attorneys for Applicant

Dated: May 29, 2012

To: Tam, Simon Shiao (rcoleman@goetzfitz.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85472044 - THE SLANTS - N/A
Sent: 6/20/2012 5:32:17 PM
Sent As: ECOM102@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 85472044

MARK: THE SLANTS

85472044

CORRESPONDENT ADDRESS:

RONALD COLEMAN

GOETZ FITZPATRICK LLP

1 PENN PLZ STE 4401

NEW YORK, NY 10119-0196

CLICK HERE TO RESPOND TO THIS LETTER

http://www.uspto.gov/trademarks/teas/response_forms.jspx

APPLICANT: Tam, Simon Shiao

CORRESPONDENT'S REFERENCE/DOCKET NO :

N/A

CORRESPONDENT E-MAIL ADDRESS:

rcoleman@goetzfitz.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 6/20/2012

THIS IS A FINAL ACTION.

This Office action is in response to applicant's communication filed on May 29, 2012.

By way of background, an Office action was issued on January 6, 2012, refusing registration under Section 2(a) as disparaging. Applicant's response argued against the refusal. Applicant's arguments have been considered and are found unpersuasive.

Accordingly, the refusal under Trademark Act Section 2(a) is now made **FINAL** for the reasons set forth below. *See* 15 U.S.C. §1052(a); 37 C.F.R. §2.64(a).

SECTION 2(A) – MARK IS DISPARAGING

The refusal of registration because the applied-for mark consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols is maintained and made FINAL. Trademark Act Section 2(a), 15 U.S.C. §1052(a); *see In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264, 1267-79 (TTAB 2006); *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1740-48 (TTAB 1999), *rev'd*, 284 F. Supp. 2d 96, 125, 68 USPQ2d 1225, 1248 (D.D.C. 2003) (finding “no error in the TTAB's articulation of [the Section 2(a)] test for disparagement”), *remanded on other grounds*, 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); TMEP §§1203.03, 1203.03(c).

The thrust of applicant's argument is that the application on its face and four-corners, fails to provide a basis for the conclusion that the likely meaning of the mark is disparaging.^[1]

See Applicant's response brief. Applicant's framing of the question and permissible evidence is misplaced. As is plainly stated in *In re Squaw Valley*, the test looks not only at dictionary definitions, any other elements in the mark, and the nature of the goods/services, but also at **the manner in which the mark is used in the marketplace in connection with the goods and/or services**. *In re Squaw Valley Dev.*, 80 USPQ2d at 1267 (citing *Harjo*, 50 USPQ2d at 1740-41); TMEP §1203.03(c). Thus, a proper consideration of the application is to determine how the mark would be perceived based upon how it is used in the marketplace. To hold otherwise would be to allow the clever construction of an application to avoid a disparaging finding, resulting in expensive opposition and cancellation proceedings by affected

third-parties.^[2]

Here, the evidence is uncontested that applicant is a founding member of a band (The Slants) that is self-described as being composed of members of Asian descent. *See* attachments to first Office action on bands name and makeup (for instance, theslants.com/about_f.html; www.asianreproter.com/arts/2009/30-slants.htm).

Thus, the association of the term SLANTS with those of Asian descent is evidenced by how the applicant uses the mark – as the name of an all Asian-American band. Further, applicant (and his fellow band members) have repeatedly indicated that the name THE SLANTS is in fact a direct reference to the derogatory meaning of the term and in fact, they are embracing the derogatory meaning of the term. One of the members of the band is quoted as stating: “I was trying to think of things that people **associate with Asians**. Obviously, one of the first things people say is that we have slanted eyes. I thought, what a great way to reclaim that stereotype....” *See* Rock Band to Trademark Office: Our Name is Not Disparaging to Asians, NW Asian Weekly (attached to the first Office action). In fact, the evidence shows applicant chose the name THE SLANTS for the band specifically **because** of the Asian connection. *See e.g.*, A Common Ground for a Controversial Band, THE ASIAN REPORT, attached to first Office action (“**For the band, the name was a way to reclaim a racial slur and to assert Asian pride.**”) Thus, the evidence is overwhelming that applicant chose the mark fully aware of the connection to the racial slur. There is no evidence of record to indicate that any meaning other than the offensive meaning is applicable to the instant application.

Applicant’s other arguments are equally misplaced. Applicant argues that the dictionaries referenced are not “actual” dictionaries. This statement is incredulous on its face. Specialized dictionaries are no less “actual” dictionaries than generalized dictionaries. In fact, many of the dictionaries and reference materials are published by large scale publishing houses, such as Harper Collins. Further, that applicant cleverly chose specimens that avoided associations with Asians or Asian culture is not evidence that the mark is not used in a way to conjure up the derogatory meaning and to be disparaging to Asians. The evidence attached to the first Office action is overwhelming that the applied-for mark is used in connection with an Asian-American band, performing Chinatown Dance music, and that the name was chosen in clear recognition of the offensive meaning of the term in connection with Asians. *See* attachments to First Office action. Further, the evidence shows that the applied-for mark was chosen expressly because of its association with Asians, perhaps in an attempt to reclaim the term. *See e.g.*, Despite Name, Band Aims for Diverse Dance Rock, THE OREGONIAN (“For our band, we’re not just Chinese, we’re not just Vietnamese, we’re kind of a pan Asian band that celebrates all the different Asian cultures out there....Everyone in the band really loves the fact that we can try and empower Asian Americans and say, ‘you know what? We are slant. Who cares? We’re proud of that.’”).

The evidence of record shows that the likely meaning of the mark, in light not only of the application, but also the “manner in which the mark is used in the marketplace,” is the disparaging term regarding the shape of the eyes of certain persons of Asian descent, and that the term remains disparaging to the Asian and Asian-American communities.

Accordingly, the refusal of registration under Section 2(a) is maintained and made FINAL.

RESPONSE OPTIONS TO FINAL OFFICE ACTION

If applicant does not respond within six months of the date of issuance of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this

final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

GENERAL INFORMATION

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must

continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

/Mark Shiner/

Trademark Examining Attorney

Law Office 102

Phone: 571-272-1489

E-mail: mark.shiner@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Simon Shiao Tam

Mark: THE SLANTS

Serial No.: 85472044

Filing Date: November 14, 2011

Examining Attorney: Mark Shiner

Law Office: 102

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

EX PARTE APPEAL

APPLICANT'S BRIEF

STATUTES AND RULES

15 U.S.C. §1052(a)	2, 3, 5, 6, 9, 16, 17, 18
TMEP Rule 710.01(b)	11, 14
37 C.F.R. 2.56(b)(2)	15

PRELIMINARY STATEMENT

This is not yet another case of a member of an ethnic group seeking registration of a supposedly offensive slur on the ground that group members, or he in particular, have “embraced” the term. This is something far more serious, and implicates the subversion 15 U.S.C. §1052(a) and the policy underlying it. This is an Ex Parte Appeal of trademark explicitly refused registration on the basis of Applicant’s race.

The perverse outcome described arose from an application process rife with serious legal and procedural deficiencies. Applicant Simon Shiao Tam, founder of a band called The Slants, filed the Application that is the subject of this Ex Parte Appeal, seeking registration of THE SLANTS for “entertainment in the nature of live performances by a musical band” on November 14, 2011. The Examining Attorney refused registration, stating initially that the “likely meaning” of “THE SLANTS” was as “a negative term regarding the shape of the eyes of certain persons of Asian descent,” citing sources indicating that the word can refer to “persons of Asian descent . . . in a disparaging manner.” The Examining Attorney found that the mark, of which the dominant feature is the ordinary English word “slant,” “is an inherently offensive term.”

In a subsequent office action, however, the Examining Attorney implicitly acknowledged that the refusal was based not, or not only, on the implausible characterization of the word “slant” as inherently offensive. In that office action, the Examining Attorney addressed Applicant’s argument that, absent adequate proof of inherent offensiveness, the Application provided no basis for the “association” between the word “slant” and the Asian community. Referring to his own Internet research, the Examining Attorney explained that the association was unavoidable because “applicant is a founding member of a band (The Slants) that is self described as being composed of members of Asian descent.” It followed, therefore, that “the association of the term SLANTS with those of Asian descent is evidenced by how Applicant uses the mark – as the name of an all Asian-American band” of which he, an Asian, is a member.

The Examining Attorney’s rationale turned the entire policy justification for Section 2(a) on its head. It was a refusal to register based on the ethnic background of Applicant and his associates that was offensive. Unless reversed by the Board this formulation inevitably will involve the Patent and Trademark Office in inappropriate and constitutionally suspect inquiries concerning the ethnicity of applicants, their associates and their activities. Given this failure of proof and misapplication of law, the evidentiary record does not support the PTO’s conclusions that the Application for registration of THE SLANTS should be denied. The Board should reverse that determination.

DESCRIPTION OF RECORD

A. PROSECUTION HISTORY

The Application was initially refused on January 6, 2012 via a nonfinal office action (the “January 2012 Office Action”) on the ground that the mark THE SLANTS consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols pursuant to 15 U.S.C. §1052(a). Specifically the Examining Attorney asserted that “slants” is a derogatory term used to refer to Asian persons. Applicant filed a response to the January 2012 Office Action on May 29, 2012. A final office action refusing registration issued on June 20, 2012 (the “June 2012 Office Action”). Applicant sought reconsideration via a submission dated December 10, 2012, on which date Applicant also filed a Notice of Appeal. Reconsideration was refused on December 20, 2012.

B. EXAMINING ATTORNEY’S EVIDENCE

The Examining Attorney appended 162 attachments to the January 2012 Office Action. These consist of newspaper and magazine articles, excerpts from reference works and screen shots from Internet websites. Most are not referred to specifically in the Office Action. Many of the articles address the use of the term “slant eyes,” as opposed to “slants,” as an ethnic slur referring to Asians. A number of the exhibits concern controversies erupting over photographs of prominent people in which they are seen pulling on the skin around their eyes to simulate so-called “slanted eyes” in a childish simulation of Asian features. A large portion of the pages attached consist of online discussion groups and magazine articles in which the Applicant and others express

their personal opinions about the use of THE SLANTS by Applicant's musical band, The Slants. Another portion consists of Google Books search results yielded by searching for the phrase "SLANTS DEROGATORY" as well as photocopies of works by which the same "result" was obtained by virtue of selecting books that listed "derogatory" terms and slurs.

No additional evidence was attached to the June 2012 Office Action.

C. APPLICANT'S EVIDENCE

In his May 29, 2012 response to the first office action, Applicant included a full screen shot from the American Heritage dictionary excerpted by the Examining Attorney, showing the full range of definitions. He also analyzed the specimens submitted with the Application closely. He also included as an exhibit five exemplary registrations of the word SLANT allowed since 2008, as set out in the margin.¹ A second exhibit was a printout from the Internet version of the Oxford English Dictionary entry for the word "slant."

¹ These include, for example, the following (attached to the January 2012 Office Action as Exhibit B); there are many more in addition to these:

- SLANTS, Serial Number 85269787 (ITU), published for opposition August 2, 2011
- SLANT, Registration Number 4123704 dated April 10, 2012
- SLANT, Registration Number 3894536 dated December 21, 2010
- SLANT, Registration Number 3437238 dated May 27, 2008
- SLANT, Registration Number 3437230 dated May 27, 2008

ARGUMENT

I. LEGAL STANDARD

When considering a “disparagement” refusal under Section 2(a), the primary question is “What is the likely meaning of the matter in question . . .” in light of the circumstances. *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264 (TTAB 2006). A mark may be “inherently” disparaging or offensive, as in *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d 1635, 1640 (TTAB 1988) (mark depicting a defecating dog) or may be disparaging only in a given context, i.e., by being applied or combined in a way that is offensive to the disparaged party. *See, e.g., In re Anti-Communist World Freedom Cong., Inc.*, 161 U.S.P.Q. 304, 305 (TTAB 1969).

The January 2012 Office Action fails to present a legitimate legal or factual basis to refuse this Application for THE SLANTS because it neither demonstrates that the use of the same word as a trademark for “entertainment in the nature of live performances by a musical band” is inherently disparaging, nor that any other matter found in the Application provides a basis for the Examining Attorney’s conclusion regarding the mark’s “likely meaning.” As set out below, lacking either legal precedent or a factual basis on which to find that the general “likely meaning” of THE SLANTS is derogatory one, the January 2012 Office Action effects a novel, and offensive, *ad hominem* prohibition against registration by this Applicant – a rule that Simon Shiao Tam is different from numerous other non-Asians whose “slant” registrations have been allowed.

II. THE PTO FAILED TO ESTABLISH A LEGAL OF EVIDENTIARY BASIS FOR FINDING THAT APPLICANT’S STANDARD CHARACTER MARK “THE SLANTS” IS DISPARAGING.

When determining whether a trademark submitted for registration is offensive or disparaging, the Patent and Trademark Office (“PTO”) must establish what “the **likely meaning** of the matter in question . . . **not only** dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods and/or services, and the manner in which the mark is used in the marketplace” based on “on applicant's identified goods and services.” *Squaw Valley Dev. Co., supra* (emphasis added). The instruction in *Squaw Valley* that dictionary definitions are **relevant** to the inquiry concerning disparagement, but **not dispositive**, leads to two corollaries: (1) where the dictionary definition does not, by itself, support a finding of disparagement, that fact standing alone favors Applicant; and (2) if a dictionary, or even the full scope of sources set forth in *Squaw Valley*, suggest that the trademark is amenable to multiple meanings, the burden is on the PTO to demonstrate why one meaning and not another is the likely meaning.

“Slants,” of course, is a common English word. It is the dominant portion of numerous trademark registrations placed into evidence by Applicant. Considering these facts, the Examining Attorney should have based his refusal on well-established legal grounds and a firm factual footing. As shown below, however, no such showing was made here, either in response to Applicant’s submissions or otherwise.

A. The Examining Attorney failed to cite any precedent demonstrating that a plain English word such as “slant” can be inherently disparaging.

The January 2012 Office Action declared THE SLANTS was “an inherently offensive term.” As shown by Applicant in his responses to the January 2012 Office Action, however, the word “slant,” in singular or plural form, is the dominant portion of numerous registrations, many of them quite recent, as set out in Footnote 1 *supra*. While PTO decisions respecting registration are not precedential, these registrations demonstrate a proposition that should be uncontroversial, namely that, unlike inherently offensive slurs such as HEEB, SQUAW or REDSKIN, “slant” is not inherently offensive.

Yet in each case cited by the Examining Attorney the January 2012 Office Action, the subject was a trademark, unlike THE SLANTS, whose meanings – based either on their sole or dominant definitions – were inherently offensive, or where facts evident in the applications provided a ground for a juxtaposition between the mark and its use that could only be disparaging. Thus in *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215 (TTAB 2010), the subject trademark was KHORAN, for use with alcoholic beverages forbidden to Muslims who follow the Koran. There was no neutral interpretation of the mark in juxtaposition with the use. *In re Anti-Communist World Freedom Cong., Inc.*, 161 U.S.P.Q. 304, *supra*, concerned disparagement of a “national symbol,” the hammer-and-sickle symbol of the Soviet Union and the Communist Party, whose meaning was amenable only to those associations. *In re Heeb Media LLC*, 89 U.S.P.Q.2d 1071 (TTAB 2008) concerned the trademark HEEB, an antiquated slur referring to Jews having no other meaning. The trademark in *In re Squaw Valley Dev. Co.* was SQUAW, an inherently offensive term referring to a female American Indian and meaning nothing

else. And *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705 (TTAB 1999) involved the use of the mark REDSKINS, also regarded as demeaning by American Indians and also lacking any definition other than as a description of that ethnic group.

Not one of the decisions cited by the PTO in either of its Office Actions involved denial of registration for a plain English word, such as “slants,” that only **could, but need not**, have a disparaging connotation and hence could not be inherently offensive. Each one of them involved a trademark that could only be offensive based on the four corners of the application – where the mark itself (i.e., the word or term), the description or the specimens demonstrated a disparaging use. Extending the holdings of these cases to a situation such as presented by this Application – where registration sought is for a standard English word having multiple meanings, and where nothing in the Application provides an evidentiary basis for an unsavory association – would constitute a significant and unwarranted extension of 15 U.S.C. §1052(a), as set out in detail below.

B. The Examining Attorney’s Internet research failed to demonstrate that the English word “slant” is in general an offensive or derogatory term.

In the January 2012 Office Action, the Examining Attorney relied on what he described as “dictionary definitions” to support his contention that the likely meaning of THE SLANTS is as “a negative term regarding the shape of the eyes of certain persons of Asian descent” and “an inherently offensive term that has a long history of being used to deride and mock a physical feature of those individuals.” But the Examining Attorney failed to heed the guidance of Rule 710.01 in the January 2012 Office Action, which states, “In appropriate cases, the examining attorney may . . . present evidence that may appear contrary to the USPTO’s position, with an appropriate explanation as to why this

evidence was not considered controlling.” The Examining Attorney, however, chose the fourth, or, arguably, the sixth definition of the word “slants” given by the *American Heritage Dictionary* – a dictionary on which he relied – while providing no explanation of the obvious question: Why the prior five entries were not controlling or even worthy of consideration, especially considering that the *American Heritage Dictionary* itself states that “Entries containing more than one sense are arranged for the convenience of the reader **with the central and often the most commonly sought meaning first.**”² A copy of the “slant” entry in the very dictionary relied upon by the Examining Attorney was submitted in response to the Office Action, and is quoted in relevant part (i.e., with respect to the word’s definition as a noun) below:³

SLANT

n.

1. **a.** A line, plane, course, or direction that is other than perpendicular or horizontal; a slope.
 - b.** A sloping thing or piece of ground.
2. Printing A virgule.
3. **a.** A personal point of view or opinion: an article with an unconventional slant.
 - b.** A bias: an anti-religious slant.
4. Offensive Slang Used as a disparaging term for a person of East Asian birth or ancestry.

Neither office action explains the omission of the “central and most common meaning” of the word “slant” above. The June 2012 Office Action did not even acknowledge the nine non-disparaging definitions of “slant” in the *Oxford English Dictionary* submitted

² The American Heritage Dictionary of the English Language website, found at http://ahdictionary.com/word/how_touse.html, last visited May 2, 2012. (Emphasis added.)

³ “Slant” in *The American Heritage Dictionary of the English Language*, found at <http://ahdictionary.com/word/search.html?q=slant&submit.x=0&submit.y=0>, last visited May 2, 2012.

by Applicant,⁴ much less explain how a finding of inherent offensiveness could plausibly withstand such evidence. The reason for the Examining Attorney's refusal to so much as admit the existence of non-derogatory definitions for the common word "slant" is not hard to divine. Doing so would subvert the baseless and nonsensical finding that the word "slant" is "inherently offensive."

Seeking to overcome this flaw with sheer volume, the January 2012 Office Action quoted and appended the results of what purported to be an extensive inquiry regarding the word "slants" in various published works. But as explained below, few of these sources are either dictionaries or even conventional reference works. For example, one book relied on by the Office Action, *The Color of Words: An Encyclopaedic Dictionary of Ethnic Bias in the United States*, is described as a "dictionary **of terms associated with racial discrimination.**"⁵ The Examining Attorney's reliance on such a compendium here, however, constitutes a "converse error," also known as the logical fallacy of "affirming the consequent." Much as a censor will inevitably "confirm" his own prurient interests if he peruses suspect material imaginatively enough,⁶ "proofs" brought from works such as *The Color of Words* will, axiomatically, support almost any pre-existing suspicion that a word may have **some** derogatory meaning. But they provide no guidance about – and certainly not proof of – what the Examining Attorney was actually charged to ascertain: whether a mark's **likely meaning, given the full range of possibilities**, is

⁴ See, e.g., the *Oxford English Dictionary*, reproduced as Exh. A to Applicant's Response to the January 2012 Office Action, showing the ethnic-slang definition of "slant" as the **tenth** out of ten definitions.

⁵ *Library Journal*, quoted by Amazon.com at the entry for the work found at <http://www.amazon.com/The-Color-Words-Encyclopaedic-Dictionary/dp/1877864420>, last visited May 2, 2012.

⁶ The humorist Dick Cavett is quoted as saying, specifically, "Censorship feeds the dirty mind more than the four-letter word itself."

disparaging. The full scope of this fallacy is demonstrated by the pages and pages of excerpts from Google Books search results returned by inputting the words “slant” and “derogatory.” This was an exercise guaranteed to “prove” of the desired outcome, but ultimately it provides no support for the finding of inherent offensiveness asserted as the ground for refusal.

In any event, the limited usefulness, as best, of the lists and sources relied on by the Examining Attorney is demonstrated by the most casual inspection of their contents. For example, The January 2012 Office Action relies in part on an anonymous website called the “Racial Slurs Database” found at <http://gyral.blackshell.com/names.html>. Examining that list “proves” that, along with “slants,” the following English words are also “disparaging” and presumably not eligible for trademark registration:

- Apple
- Banana
- Cans
- Beanie
- Brother
- Bumblebee
- Cabdriver
- Canal

These are just a few examples of entries, starting with the letters “A” and proceeding only through “C,” found in the work relied on by the Examining Attorney as a definitive dictionary of slurs and proof that “slant” is an inherently offensive word. Similarly, the Wikipedia entry referred to in the January 2012 Office Action lists the words “ape,” “brownie,” “crow,” “gin,” “shine,” “spade,” “tiger” and “Yankee.”⁷ These lists are not “dictionary definitions,” and have little or no bearing at all on the serious legal question of whether the “likely meaning” of a given word is disparaging or offensive.

⁷ Wikipedia, “List of Ethnic Slurs,” found at http://en.wikipedia.org/wiki/List_of_ethnic_slurs, last visited February 19, 2013.

Ultimately, the PTO erred here by disregarding the TMEP Rule that advises careful, balanced explanations when quoting dictionaries. Nor did the reams of “bad word” lists appended to the January 2012 Office Action constitute meaningful evidence of the **likely** meaning of the word to any particular group or anyone in general. For these reasons, the PTO failed to provide an evidentiary basis for its finding that THE SLANTS, when used in connection with a band providing musical performances, is inherently offensive.

III. THE EXAMINING ATTORNEY ERRED IN FINDING THAT USE OF THE MARK BY APPLICANT, AN ASIAN, CONSTITUTED DISPARAGING USE OF THE MARK IN ASSOCIATION WITH ASIANS.

To justify refusal to register a trademark under the first clause of section 1052(a), the PTO must, in addition to weighing the factors set forth in the last quotation, “consider the mark in the context of the marketplace as applied to only the goods described in [the] application for registration.” *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994). And while there is no question that an examining attorney may refer to outside materials for purposes of assessing whether a mark suspected of being disparaging is regarded as such by the affected group, it is not the PTO’s practice, nor should it be, to conduct a “disparagement search” on every application for a trademark registration. *See also, In Re Hershey*, 6 U.S.P.Q.2d 1470 (TTAB 1988) (focusing analysis on specimens); *In re Bose Corporation*, 192 U.S.P.Q. 213 (CCPA 1976) (“an application for registration must be adjudged in light of the specimens of record”).

While TMEP Rule 710.01(b) provides that “Articles downloaded from the Internet are admissible as evidence of information available to the general public, and of

the way in which a term is being used by the public,” such research has only been found probative on the questions of (a) whether a mark is used descriptively or (b) whether a mark identified as potentially disparaging is so perceived by the subject group as a general proposition. That Rule also provides that “The examining attorney must check applicant's own website for information about the goods/services,” but neither office action included excerpts from The Slants’ own website. All the material evidencing Applicant’s supposed use of the mark was dated from 2010 or earlier – at least a year prior to the date of the Application.

Despite the haphazard nature of the research on which he relied, the Examining Attorney’s stated in the June 2012 Office Action that his Internet dossier about Applicant was an appropriate evidentiary exercise because it provided what he deemed an accurate picture of Applicant’s ethnically-oriented use of the mark.. “To hold otherwise would be to allow the clever construction of an application to avoid a disparaging finding, resulting in expensive opposition and cancellation proceedings by affected third[.]parties.”

But the Application was not refused registration on the ground of a failure of evidence under 37 C.F.R. 2.56(b)(2). As to the specimens, they are three advertisements for the band, none of which suggest a connection between the word “slant” and anything having to do with Asian people. No substitute specimen was requested by the Examining Attorney. This is not a case such as *In re Promo Ink*, 78 U.S.P.Q.2d 1301 (TTAB 2006), where the applicant argued unsuccessfully that the examining attorney improperly “created a specimen” for an Intent to Use application, which requires no specimen at all. The situation here is, at best, akin to that in *In re Reed Elsevier Properties*, 82

U.S.P.Q.2d 1378 (Fed. Cir. 2007), where research into an applicant's use was justified as defining "the genus of services at issue" for purposes of evaluating descriptiveness.

Here, however, the only "genus" relevant to the refusal here is ethnicity. And as addressed more fully below, while such an inquiry would technically correspond to the stated basis of the PTO's refusal, it would have been patently offensive and unlawful. Ultimately, as set forth above the evidentiary basis on which the Examining Attorney did make his decision was flawed in numerous respects, and constituted error.

IV. THE REFUSAL OF REGISTRATION WAS BASED IMPROPERLY ON THE IDENTITY AND ETHNIC BACKGROUND OF APPLICANT.

Disregarding the analysis submitted by Applicant in response to the January 2012 Office Action, the June 2012 Office Action frankly enunciated the real, and troubling, ground for the PTO's refusal to register as follows:

Here, the evidence is uncontested that applicant is a founding member of a band (The Slants) that is self described as being composed of **members of Asian descent**. . . . Thus, **the association of the term SLANTS with those of Asian descent** is evidenced by how Applicant uses the mark – **as the name of an all Asian-American band**. Further, applicant (and his fellow band members) has repeatedly indicated that the name THE SLANTS is in fact a direct reference to the derogatory meaning of the term and in fact, they are embracing the derogatory meaning of the term. One of the members of the band is quoted as stating . . .

[FN 1] Notably, this is not applicant's first time before the United States Patent and Trademark Office seeking registration of the mark THE SLANTS for live musical performances. . . .

June 2012 Office Action at 2 (emphasis added). These excerpts unmasked an implied admission that while the Application provides no grounds for a 2(a) refusal, **this particular** Applicant would not be allowed not register THE SLANTS as a trademark

because it refers to him, a person of “Asian descent,” along with his “all Asian-American band.” Use of this trademark by these people, according to the Office Action, constituted a perpetual, ubiquitous “derogatory association” with themselves.

These grounds for refusal constituted error at least two reasons, discussed below:

(1) They improperly condition registration on the ethnic background of an applicant, and
(2) they amount to an unprecedented prohibition against registration by a particular individual or group of people because of their past use of a mark.

A. The refusal of registration here was improperly tied by the PTO to the ethnic background of Applicant.

The refusal here was explicitly, and improperly, premised on the ethnic identity of Applicant and the other members of his band. “Here,” wrote the Examining Attorney, explaining the “association” between the mark and the Asian community, “applicant is a founding member of a band . . . composed of members of Asian descent. . . . [The] association of the term SLANTS with those of Asian descent is evidenced by how Applicant uses the mark – as the name of an all Asian-American band.”

By the Examining Attorney’s logic, the same exact application submitted by a non-Asian would be entitled to registration. THE SLANTS, the PTO admits, is not inherently offensive, as, for example, HEEB and SQUAW are. THE SLANTS could be registered as a trademark – **just not by Asians**. It should go without saying that the law does not support refusal of registration based on the ethnic descent of an applicant, such as occurred here.

Indeed, it is no less troubling that the Examining Attorney noted that there was no “rebuttal” to his assertion that The Slants were an “all Asian-American” band. The only

possible “rebuttal” would have been a submission proving that the band was **not** entirely Asian and hence entitled to registration, a patently offensive proposition. In any case, the standard to which such “evidence,” if submitted, would have been applied is unclear, for the Lanham Act is silent as to how many Asian members of The Slants would need to be fired from the band to avoid offending Asians by registration of this trademark.

B. The refusal of registration here was improperly tied by the PTO to the personal identity and application history of the Applicant.

Besides suggesting racial definitions redolent of laws from other times and places rather than the criteria typically associated with our law of trademarks and unfair competition, the PTO’s stated grounds of refusal to register this Application raise a less dramatic, but still problematic, traditional, legal concern: It amounts to a prohibition against registration, for which there is no legal basis, dependent on the identity of the person, rather than the content of the application. Again quoting the June 2012 Office Action, “Notably, this is not applicant’s first time before the United States Patent and Trademark Office seeking registration of the mark THE SLANTS for live musical performances. . . .” Under the Examining Attorney’s rationale, **no** application by Applicant for THE SLANTS could ever overcome the “stain” of his past use of that mark in connection with an “all Asian-American band.”

There is no legal basis for such an outcome, however. A person applying to register a trademark facially similar to an application by him that was previously refused is not barred by *res judicata* concerning a new, different application. *See, Sheffield-King Milling Co. v. Theopold-Reid Co.*, 269 F. 716 (D.C. Cir. 1921). Indeed it is less the

asserted sameness of the mark in the two applications on which the Examining Attorney relies in refusing registration; it is the sameness of Applicant.

As demonstrated in the foregoing sections, this refusal cannot have not based on a competent evidentiary record that THE SLANTS is inherently offensive or derogatory; the record is clear that “slant” is a word with multiple meanings, of which the ethnic slur on which the refusal is purportedly based is attenuated, to say the least. Nor does the Application itself provide such evidence. The refusal, rather, is based on who the Applicant is. It follows that if anyone else on earth – Asian or otherwise – submitted an application to register THE SLANTS that was identical to the Application here, registration would have been allowed. Concomitantly, Applicant could never register THE SLANTS no matter the content of the application.

This result would be a surprising and troubling reading of 15 U.S.C. §1052(a), and one that is not supported by law, policy or common sense. Neither the ethnic identity of Applicant, the extent to which he associates in his use of the mark with other Asians, the degree to which he makes use of his own cultural heritage, or his identity in any sense at all should be of relevance concerning registration of THE SLANTS as a trademark for “entertainment in the nature of live performances by a musical band.”

CONCLUSION

For all the foregoing reasons, Applicant respectfully submits that the Examining Attorney has failed to meet his burden to demonstrate that Applicant's mark THE SLANTS consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols pursuant to 15 U.S.C. §1052(a) and requests that the grant this Ex Parte Appeal and allow the registration of Applicant's mark THE SLANTS on the Principal Register.

Respectfully submitted,

GOETZ FITZPATRICK, LLP

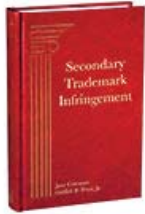
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One Penn Plaza, 44th Floor
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(212) 695-8100
Attorneys for Applicant

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About the Authors

Jane Coleman is author and creator of www.secondarytrademarkinfringement.com and a former Assistant Director in the Legal Affairs department for the national office of the Anti-Defamation League (ADL) in New York, N.Y. She is a legal writer and editor on topics as diverse as New York and New Jersey civil practice, estate taxation and claims against public entities. Ms. Coleman also is a co-author, with husband Ron Coleman, of a work on business and commercial litigation in federal courts.

Griffith B. Price, Jr., is senior counsel at Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, Washington, D.C., with extensive background in the procedural and substantive aspects of IP litigation in the federal courts, as well as federal and state appellate courts.

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- **Detailed Table of Contents**
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Ronald D. Coleman



CONTACT

Phone: (212) 695-8100

Fax: (212) 629-4013

E-mail: rcoleman@goetzfitz.com

PRACTICE AREAS

Commercial Litigation

Intellectual Property, Technology & Media

EDUCATION

J.D., Northwestern University

School of Law

A.B., Princeton University

BAR & COURT ADMISSIONS

New York

New Jersey

PROFESSIONAL AFFILIATIONS

New York State Bar Association

New Jersey State Bar Association Federal
Bar Association

New York Intellectual Property Law
Association

Association of the Bar of the City of New
York

American Intellectual Property Law
Association

Copyright Society of the USA

Ron Coleman is a commercial litigator focusing on copyright, trademark and unfair competition. He concentrates on commercial and intellectual property litigation and his work has been acknowledged as defining the leading edge in IP, online and new media counseling.

Ron is one of the lawyers whose work is developing the law relating to the use and abuse of intellectual property on the Internet. One of the best-known lawyers in the “blogging” world, he is the volunteer general counsel of the Media Bloggers Association. His blog about copyright, trademark, free speech and related issues, **LIKELIHOOD OF CONFUSION**, was recognized by the ABA Journal as one of the top 100 law-related blogs in the country in its first-ever listing of law blogs in 2007. In fact, Ron authored the first article on Internet law in the *ABA Journal*, in 1995, and has published numerous articles and treatise contributions on law and litigation. Most notably, he co-authored the chapter on “Responses to Complaints” in the first edition of *Business and Commercial Litigation in the Federal Courts* published by the American Bar Association and the West Group. More recently, he contributed a chapter on the topic of rights of publicity and trademark to a 2013 book called *In the Arena: A Sports Law Handbook*, published by the NYSBA.

An AV Preeminent-rated commercial litigator, Ron has successfully represented clients of every size in state and federal courts in bench and jury trials as well as in the Trademark Trial and Appeal Board, and in arbitrations and mediations throughout the country. He has litigated and tried a wide range of commercial and other cases, including not only IP / IT and business tort cases but also contract, employment, ERISA, estate, regulatory, RICO, franchising, taxation, insurance and other claims.

Ron is a member of the New York and New Jersey State Bar Associations and the Association of the Bar of the City of New York (the “City Bar”), having recently completed his second three-year term on its Trademark and Unfair Competition Committee. He is also a past member of the Internet Committee (Online Use Subcommittee) of the International Trademark Association (“INTA”) and has been a featured speaker in a wide variety of professional venues, including most recently the Copyright Society of the USA and the American Intellectual Property Law Association.

Ron has been recognized as a “Super Lawyer®” in the field of intellectual property litigation and is listed in the current editions of *Who’s Who in America* and *Who’s Who in American Law*. He was named one of Bergen County, New Jersey’s “Top Lawyers” in (201) magazine. He is actively involved in online social media and has a substantial following for his Twitter feed at the username [@roncoleman](https://twitter.com/roncoleman).