Ritchie v. Simpson: The Federal Circuit Drops the Ball

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INTRODUCTION

Imagine walking into your local housewares store and picking up a set of kitchen knives with the name “O. J. Simpson” etched on the handles. If O. J. Simpson had his way, not only would his name appear on the handles, but they would be followed by the “®” symbol designating his name as a trademark registered with the United States Patent and Trademark Office (PTO). Simpson applied for federal trademark protection for his name and nicknames in the wake of the notorious 1994 murders of his ex-wife and a male companion. Before the facts and issues of the case that is the subject of this Comment can be examined, some background information is in order.

A trademark can be any “word, name, symbol or device” that identifies and distinguishes one producer’s goods or services from another producer.¹ Trademarks pervade our everyday lives to the point that usually one need only turn his head in some direction in order to see a trademark on some commonplace item.² Through the Lanham Act,³ Congress provides for the

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² Some common trademarked names associated with goods or services are COKE® (soft drinks), McDONALD’S® (restaurants), DUNKIN DONUTS® (doughnuts), DELL® (personal computers), MICROSOFT® (computer software and services), WINDOWS® (computer operating system), BIC® (pens and lighters), SWINGLINE® (staplers), GAP® (clothing), COLGATE® (toothpaste), HONDA® (motorized vehicles and equipment), BUGS BUNNY® (cartoon character), THE HOME DEPOT® (retail home improvement centers), STAR WARS® (motion picture entertainment), and BILLY JOEL® (music entertainment). Trademark registrations can be accessed through the U.S. Patent & Trademark Office website at http://www.uspto.gov.

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registration of trademarks with the PTO.4 Although the lack of federal registration does not preclude the use of a mark, registration carries with it several benefits,5 among them, prima facie evidence of the mark’s validity and the registrant’s ownership of the mark;6 nationwide constructive notice of use to potential infringers;7 the availability of federal courts to bring infringement actions without the need for diversity of citizenship or a minimum amount in controversy;8 possible “incontestability” status after a period of time;9 and the ability to block the foreign importation of goods bearing an infringing mark.10

After a trademark application is filed, a trademark examining attorney reviews the application to ensure that it does not run afoul of the Lanham Act’s various grounds for denial of registration.11 One of the primary concerns during examination is whether the applicant’s mark is confusingly similar to an existing registered mark.12 If the application is rejected and the applicant fails to convince the examiner that a re-consideration is in order, a final rejection is issued.13 If the

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4 The statute also created a “supplemental” register for those marks that do not currently meet the requirements of the “principal” register. See id. § 1091(a). All mention of trademark registration in this Comment refers to registration on the principal register only.
6 See 15 U.S.C. § 1057(b); see also Liberty Mutual Ins. Co. v. Liberty Ins. Co., 185 F. Supp. 895, 902 (E.D. Ark. 1960) (“[T]he registration of a mark is presumptively valid. The presumption is that the mark is . . . owned by the applicant for registration, and that the applicant has the exclusive right to use the mark in interstate commerce in connection with the goods or services specified.”).
9 See id. § 1065 (permitting a trademark to become “incontestable” after five continuous years of registration with no pending claims against it).
10 See id. § 1124.
11 See id. § 1052 (listing the grounds for denying trademark registration). Generally, the PTO carries the initial burden of showing that a trademark is unregisterable. See In re Budge Mfg. Co., 857 F.2d 773, 775 (Fed. Cir. 1988).
13 After a final rejection, the applicant can proceed with an ex parte appeal to
examiner determines that the mark has met all the statutory requirements, it is published in the PTO's official gazette.\textsuperscript{14} Publication in the gazette provides public notice of the applicant's intention to register the mark. This is akin to a "public hearing" where community members are provided a forum to voice their concerns about a proposed matter that will impact them. The "community" in this context, however, is the entire nation. Under section 13 of the Lanham Act, "[a]ny person who believes that he would be damaged by the registration of a mark . . ." may oppose its registration.\textsuperscript{15} If an opposition is filed, an opposition proceeding takes place before the Trademark Trial and Appeal Board (TTAB or "the Board"), where the fate of the pending application is decided. One of the most interesting and controversial bars to the registration of a trademark is contained in section 2(a) of the Lanham Act. Section 2(a) provides that a mark that "consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead . . ." cannot be registered.\textsuperscript{16} Either the trademark examiner or a third party can oppose the mark's registration on this ground.\textsuperscript{17} A section 2(a) denial of registration presents special issues not found when other grounds are asserted because of this provision's content-based restrictions on the registration of

\textsuperscript{14} See id. § 1062(a).
\textsuperscript{15} Id. § 1063(a). A party can either oppose the registration of a mark when it is published in the gazette or seek to cancel an existing registration. See id. § 1064; see also Baird, supra note 5, at 751–52 (stating that most individuals and groups do not read the PTO's gazette on a regular basis and therefore most often bring cancellation proceedings rather than opposition proceedings to challenge the registration of a mark).
\textsuperscript{17} The trademark examining attorney enforces the section 2(a) provisions during the examination process. See Baird, supra note 5, at 750 ("[T]he trademark examining attorney is often thought of as the guardian of public virtue when making determinations under section 2(a) of the Lanham Act. Theoretically then, scandalous, immoral, and disparaging trademarks never should be published for opposition or issued registrations. Theory, however, does not always reflect reality . . .".).
Despite challenges by litigants and criticism by commentators that section 2(a) of the Lanham Act is an abridgement of protected speech under the First Amendment, the constitutionality of section 2(a) has been upheld on the basis that a denial of registration does not preclude the continued use of the mark. An issue that can arise in opposition or cancellation proceedings is whether the party seeking denial or cancellation of a registration has standing under section 13 of...
the Lanham Act. The standing issue does not arise often in these proceedings because the classic trademark dispute centers on a claim that the applicant’s mark will cause economic harm to the owner of a similar, pre-existing mark. Only in a handful of decisions have courts or the TTAB addressed the issue of whether a person has standing to oppose or cancel the registration of a trademark in the context of a section 2(a) challenge. In *Ritchie v. Simpson*, the United States Court of Appeals for the Federal Circuit greatly expanded the ability of a person to oppose or cancel a trademark’s registration under section 2(a). The issue before the court was whether a member of the general public had standing to oppose the registration of an alleged “scandalous” trademark on the basis that the mark caused injury to his personal beliefs. A majority of a three-judge panel of the Federal Circuit held that the challenger did have standing.

This Comment reviews the Federal Circuit’s decision in *Ritchie v. Simpson*. Part I discusses the brief, yet interesting facts of the case. Part II examines the court’s rationale in reaching its decision and the rationale of the sole dissenting judge. Part III argues that the court’s approach in this case is not useful and its holding creates a potential for needless adjudication of trademark oppositions. This Part also discusses two significant decisions by the TTAB where the issue of standing to oppose a trademark was decided and proposes modifications to the Lanham Act’s standing requirement for opposing an alleged scandalous mark. Part IV concludes that the marks in question are not scandalous under section 2(a) of the Lanham Act in light of contemporary attitudes and recent decisions.

I. “O. J.” KNIVES?—WHAT WAS HE THINKING?

Although O. J. Simpson first acquired fame as a professional football player and spokesperson for a national rent-a-car company, he became even better known after the murder of his ex-wife, Nicole Brown Simpson, and a male companion, Ronald

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on the “Case or Controversy” Requirement, 93 HARV. L. REV. 297 (1979) (providing an in-depth analysis of the standing doctrine).

22 170 F.3d 1092 (Fed. Cir. 1999).
23 See id. at 1093–94.
24 See id. at 1099.
Goldman on June 12, 1994.\textsuperscript{25} Simpson was charged with the murders and ultimately acquitted\textsuperscript{26} after a year-long trial that kept the media buzzing and a good part of the country captivated.\textsuperscript{27} He was subsequently found liable in a wrongful death civil action brought by the families of the victims.\textsuperscript{28} In 1995, Simpson filed applications with the PTO to register the names O. J., O. J. SIMPSON, and THE JUICE to be used in connection with the sale of various items.\textsuperscript{29} The marks were allowed by the examiner and published in the gazette. William Ritchie, who had no connection to O. J. Simpson, the murder victims, or anyone involved with the case, filed an opposition on section 2(a) grounds claiming the marks were scandalous and disparaging.\textsuperscript{30} According to Ritchie, these marks injured his


\textsuperscript{26} See Stephanie Simon & Jim Newton, The Simpson Verdict: Simpson Not Guilty, L. A. TIMES, Oct. 3, 1995, at A1 (illustrating how the verdict stirred peoples’ emotions); see also Cathleen Decker & Sheryl Stolberg, Half of Americans Disagree with Verdict; Times Poll: Many Cite Race as Key Factor in Trial, L.A. TIMES, Oct. 4, 1995, § A, at 1 (noting the division in opinion about the verdict among people across the country and discussing the belief that race played a role in the jury’s decision).


\textsuperscript{29} In total, Simpson listed 120 items he planned to sell under the marks, including comic books, musical toys, jigsaw puzzles, jewelry, figurines, trading cards, and cutlery. See Simpson Trademark Challenge Stands a Former Patent Lawyer from Maine Wins Standing in his Fight to Stop O. J. Simpson from Registering his Name, PORTLAND HERALD PRESS, Mar. 18, 1999, available at 1999 WL 44473249 at *58; see also Bruce Rubenstein, Trademark Challenges Could Become Routine after Ruling on O. J. Marks, 9 CORP. LEGAL TIMES 62 (1999). The selling of cutlery with the marks is particularly eerie because the murders were committed with a knife. See Malnic & Ferrell, supra note 25, § A, at 1. Simpson’s attorneys claimed Simpson wanted the rights to his name on cutlery to prevent “tasteless exploitation of his name” by people selling souvenirs outside the courthouse during his trial. Rubenstein, supra. This was not the first time Simpson applied for a trademark. In 1983, he successfully registered his signature with the PTO. This mark, however, was not at issue in the Ritchie case because it was cancelled in 1990. See U.S. Trademark Serial No. 73256893, available at http://tess.uspto.gov.

\textsuperscript{30} See Ritchie v. Simpson, 41 U.S.P.Q.2d 1859 (T.T.A.B. 1996), rev’d, 170 F.3d 1092 (Fed. Cir. 1999). The opposer also asserted that the marks were unregistrable
Christian family values because they were “synonymous with wife-beater and wife-murderer” and “they would attempt to justify physical violence against women.” The TTAB ruled that Ritchie had no standing to oppose. On appeal, the Federal Circuit held that Ritchie did have the requisite standing and remanded the case to the Board.

II. THE MAJORITY AND DISSENTING VIEW

To decide the standing issue, the court relied on a two-part test for standing that requires the opposer to show both a “real interest” in the proceeding and a reasonable basis for his belief that he will be damaged. As a preface to its analysis under this test, the court stated that whether a mark is scandalous is to be determined under “contemporary attitudes” with the relevant vantage point being a “substantial composite” of the general public and not necessarily a majority of the public. The court then made it clear that the Article III standing provisions do not apply to administrative proceedings such as a trademark opposition before the TTAB. An opposer’s standing, said the

under section 2(e)(4) of the Lanham Act, which prohibits the registration of a mark that is merely a surname unless the mark has acquired “secondary meaning,” i.e., that the general public generally associates the name with a single producer of the goods or services. See 15 U.S.C. § 1052(e)(4)-(f) (1994). The Federal Circuit did not address this issue.

Ritchie, 170 F.3d at 1097.

See id. at 1092. The Board’s rationale centered on their finding that Ritchie had failed to allege a damage distinguishable from that of the general public. See id. at 1861 (citing Jewelers Vigilance Comm., Inc. v. Ullenberg Corp., 823 F.2d 490, 493 (Fed. Cir. 1987)). Accordingly, the Board held that Ritchie had neither a real interest in the proceeding nor a reasonable basis for his belief. See id. at 1862.

Ritchie, 170 F.3d at 1099.


See id. at 1097–98 (citing Universal Oil, 463 F.2d at 1124).

See id. at 1094 (citing In re Mavety Media Group, Ltd., 33 F.3d 1367, 1371 (Fed. Cir. 1994)). The “substantial composite of the general public” terminology has been used by practically every court making a scandalous trademark determination ever since the Federal Circuit’s predecessor court, the U.S. Court of Customs and Patent Appeals, first used the words in a 1981 decision. See In re McGnley, 660 F.2d 481, 485 (C.C.P.A. 1981).

See id. at 1094–95 (citing California Ass’n of Physically Handicapped, Inc. v. FCC, 718 F.2d 826, 828 n.8 (D.C. Cir. 1985)). See generally supra note 21. The Federal Circuit, however, has stated that even section 13 standing has some constitutional requirements. See Jewelers Vigilance Comm., Inc. v. Ullenberg Corp., 823 F.2d 490, 493 (Fed. Cir. 1987). The court in Jewelers’ Vigilance stated:

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According to the court, Ritchie's allegations of injury to his morals, if taken as true, demonstrated a "real interest" to satisfy the first part of the test. The court believed that the Board misinterpreted the cases it relied upon to hold that the alleged injury must be one that is "beyond that of the general public" and summarized this point by saying that "[t]he crux of the matter is not how many others share one's belief that one will be damaged by the registration, but whether that belief is reasonable and reflects a real interest in the issue."

In the court's opinion, the Board's denial of standing to Ritchie contradicted the Board's own ruling in *Bromberg v. Carmel Self Service, Inc.* where two opposers were granted standing to oppose a mark they alleged disparaged more than half of the general public.

For the second prong of the test, the court explained that a reasonable basis could be established by either "possess[ing] a trait or characteristic . . . implicated by the proposed mark" or by "alleg[ing] that others also share the same belief of harm from the proposed trademark." The court noted that at this stage, the claim of damage need not be proved but only alleged that the opposer's belief of damage "is not simply [his] subjective view."

In support of his opposition, Mr. Ritchie alleged that he obtained petitions from people across the nation supporting his view. The petitions served to satisfy the court that Ritchie's belief of

Section 13 of the Lanham Act . . . [grants standing to those who would not otherwise meet Article III standing]. Of course, the constitutional requirement remains that the opposer "must allege a distinct and palpable injury to himself even if it is an injury shared by a large class of other possible litigants. . . .”

damages had a "reasonable basis in fact." The allegation that he was not alone in his conviction was held sufficient to satisfy the second part of the test.

Judge Newman wrote a forceful dissent in the case. The judge’s primary concern was that by giving Ritchie standing to proceed with his opposition, the court was in essence allowing the trademark opposition process to be used as "a forum for attack on the morality of the registrant." In the judge’s view, "[d]isapproval, by a member of the general public, of the applicant for registration, however notorious that applicant, does not provide standing to oppose registration of the applicant's commercial trademarks." Employing the same "real interest" standard, Judge Newman agreed with the TTAB that Ritchie’s status as a family man failed to meet this requirement. The judge cited numerous cases to support her contention that an opposer’s interest must go beyond what would be shared by the general public. In Judge Newman’s view, Ritchie’s status was that of an intermeddler because his interest was not a legally cognizable one in trademark law. The judge pointed out that “[t]he forum for exercise of the moral preferences of the general public is the cash register for the trademarked goods—not the trademark register.” The judge also argued that the court’s holding raised issues relating to the constitutional protection of commercial speech.

III. AN ANALYSIS OF THE CASE

A. The Bromberg and Harjo Decisions

The approach of the Ritchie court can best be analyzed in light of two notable TTAB decisions where the issue of who may oppose the registration of a trademark was decided. It should be

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47 Ritchie, 170 F.3d at 1098.
48 Id. at 1099 (Newman, J., dissenting).
49 Id.
50 See id. at 1100.
51 See id. at 1101.
52 See id. at 1104 ("Moral indignation is not such an interest; the trademark tribunals do not serve the busybody and moral cop. The commercial benefits of trademark registration cannot be withheld merely because of the registrant's unpopularity or notoriety.").
53 Id. at 1103.
54 See id. at 1103–04; see also supra note 19.
noted that decisions of an administrative tribunal such as the TTAB are not binding on the Federal Circuit Court of Appeals. Nevertheless, these two decisions are important because the Federal Circuit cited them in support of their decision to grant standing to Ritchie. The first decision is *Bromberg v. Carmel Self Service, Inc.*, where the applicant sought to register the slogan ONLY A BREAST IN THE MOUTH IS BETTER THAN A LEG IN THE HAND for use in connection with chicken restaurant services. Two women filed an opposition to the registration of the mark based on its double entendre. The women alleged that the mark was scandalous and disparaged the class of all women in the United States. The Trademark Trial and Appeal Board gave scant discussion to the issue and merely looked to the language of section 13 of the Lanham Act to conclude that the provision only requires that the opponents “believe that [they] would be damaged.” Interestingly, in its discussion of why a class action could not be maintained in a trademark opposition, the Board made it clear that these women were members of a class that could believe they would be harmed by the registration of the mark. The obvious class here is, of course, women, and it is apparent from the Board’s opinion that it was the fact that the opponents were undisputed members of this class that was critical in the Board’s decision to grant the women standing to oppose the mark.

The second significant decision involving a party’s standing to oppose or cancel a mark under section 2(a) involved the famous Washington Redskins professional football team. In *Harjo v. Pro Football, Inc.*, a group of Native Americans sought to cancel the various registered trademarks of the Washington Redskins, including the depiction of a Native American, on the grounds that the term “redskin” was a “pejorative, derogatory, degrading, offensive, scandalous, contemptuous, disreputable, disparaging, and racist designation for a Native American

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56 Id. at 177.
57 See id. The women claimed the mark was “lewd, lascivious, indecent, obscene, worthless, depraved, chauvinistic, degrading, and [lacking in] commercial value . . . .” Id.
58 See id.
59 Id. at 179; see also supra note 15 and accompanying text.
60 See *Bromberg*, 198 U.S.P.Q. at 179.
In articulating the standing doctrine in these proceedings, the Board stated that the very purpose in requiring standing is "to prevent litigation where there is no real controversy between the parties, e.g., where a plaintiff is no more than a mere intermeddler." The TTAB concluded that the group had standing to cancel the mark because they, as Native Americans enrolled in a recognized Indian tribe, demonstrated a "legitimate interest" in the cancellation of the mark and were not "mere intermeddler[s]."

B. The Court's Misinterpretation of the Standard

The court in Ritchie interpreted the two-part test for standing too broadly. To show a real interest, the court stated that what is important is that the opposer's views be shared by a "substantial composite" of the general public. The inherent vagueness of this standard makes its application very difficult. The Ritchie court, like previous courts using these words, failed to explain how a "substantial composite" differs from the general public, e.g., how many are required to meet this standard? Is it confined to specific purchasers of the trademarked goods or should it include all people? Should this depend on the nature of the trademark? In the case of O. J. Simpson, the allegedly scandalous nature of the mark stems solely from a crime for which Simpson was acquitted. The fact that he was found liable for civil charges and Mr. Ritchie's personal belief that the

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62 Id. at 1829.
63 Id. at 1830.
64 Id. The battle over the registerability of the REDSKINS trademarks that began with the initial cancellation proceeding in 1992 is ongoing. In 1999, the Board held that the various REDSKINS marks disparaged Native Americans under section 2(a) and ordered the registrations cancelled. See Harjo v. Pro-Football Inc., 50 U.S.P.Q.2d 1705, 1749 (T.T.A.B. 1999). The football team's appeal of the Board's cancellation order is pending. See Pro-Football Inc. v. Harjo, 57 U.S.P.Q.2d 1140, 1141 (D.C. 2000). Native Americans are now seeking to cancel the trademark of the Atlanta Braves professional baseball team on the same grounds. See Native Am. Res. Acad. v. Atlanta Nat'l Baseball Club, Inc., 2000 TTAB LEXIS 593, at *1 (T.T.A.B. Aug. 24, 2000).
65 See In re McGinley, 660 F.2d 481, 487 (C.C.P.A. 1981) (Rich, J., dissenting) ("I am at a loss to know what [substantial composite] means or how one can have a 'composite' of a class such as 'the general public.'").
66 It would not be unreasonable to say that a lot more people will see and recognize a well-promoted trademark than just consumers of the underlying goods or services.
67 See supra note 28.
verdict in the criminal case was wrong should not be a sufficient basis for allowing Ritchie to oppose the registration. As applied by the court, the “real interest” test will not yield consistent results because Ritchie’s “injury” is too remote and tenuous to stop Simpson’s commercial interest in his marks. Although the “[any person who believes” language of the Lanham Act grants broad standing in the opposition or cancellation of scandalous trademarks, the court’s ruling in Ritchie puts virtually no bounds on this provision.

The court’s application of the “reasonable basis” prong is equally suspect. The court discussed two possible methods of establishing this basis: (1) by physical traits or characteristics or (2) by showing that others share the opposer’s belief. In holding that Ritchie satisfied this element through the second method, the court left some obvious questions unanswered. For instance, how many other people must share the belief? Will one other person suffice or must there be some minimal percentage of the general public? Should this also depend on the nature of the trademark or the applicable market? This basis for establishing the reasonableness of opposing a trademark registration on section 2(a) grounds is not useful and provides little guidance in future applications. A finding that a mark is “scandalous” can be based on an inherently subjective determination such that it clashes with the objective “reasonable person” standard.

69 Indeed, the Federal Circuit has itself analogized the standing requirement to oppose a trademark registration under the Lanham Act to the high standard of Article III standing. See Jewelers Vigilance Comm., Inc. v. Ullenbergs Corp., 823 F.2d 490, 492 (Fed. Cir. 1987) (“Thus, the goal of [the Lanham Act’s standing requirement] is in harmony with the standing requirements for maintaining a law suit in an Article III court...”). This illustrates the court’s prior recognition of some limitation on the section 13 standing requirement of the Lanham Act. Others have recognized the need to limit the reach of section 13 standing; one commentator has stated:

The standing provisions of the trademark law must be administered with some limiting effect. Otherwise, they become meaningless. The concept of standing involves the idea of setting some requirements or limits on the number of persons... and the nature of the claims which will be recognized under the statute.
Kester, supra note 5, at 270.
70 See Ritchie v. Simpson, 170 F.3d 1092, 1098 (Fed. Cir. 1999).
71 See In re Hershey, 6 U.S.P.Q.2d 1470, 1471 (T.T.A.B. 1988) (referring to the standard for deciding these cases as “somewhat vague” and stating that the determination of whether a mark is scandalous is a “highly subjective one”).
standing in these cases by merely showing that others share their belief is particularly troublesome because of the impact of social and political factors that change the tides of what people perceive as "scandalous."

By allowing Ritchie to have standing, the Federal Circuit may have paved the way for even more frivolous oppositions or cancellation proceedings. The Board correctly pointed out that allowing Ritchie's opposition to proceed would mean that any person could cancel the registration of a mark because of deeply personal and intangible grounds, such as disagreement with hiring practices, political affiliations, or environmental policies. In addition, allowing such a broad basis for standing brings the application of section 2(a) closer to encroaching on the protections afforded commercial speech.

C. A Proposed Modification to the Section 13 Standing Test

In order to reduce the overreaching implications of the court's holding, the standing requirement embodied in section 13 to bring a section 2(a) challenge to a trademark registration must be more restrictive. The following framework provides a more useful analytical tool for deciding these cases. An alleged scandalous trademark can be categorized into one of two types: "per se" scandalous and personally scandalous. A "per se" scandalous mark is one that on its face would be thought of to be scandalous by almost anyone, whether by itself or in the context of the underlying goods or services. Generally, only common sense and everyday experience would be required to recognize a "per se" scandalous mark. Marks containing curses, racial slurs, blatant sexual slang, desecration of sacred religious objects or symbols, or depictions of graphic sexual material would fall into this category. A personally scandalous mark, on the other

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72 See Rubenstein, supra note 29 (noting that some trademark attorneys believe that the Ritchie and Harjo decisions "could spell trouble for many U.S. corporations").
74 See supra note 19.
75 In most cases, the trademark examining attorney would deny the registration of a "per se" scandalous mark and there would be no need for intervention by an outside party. See supra note 17.
76 See infra Part IV.B (reviewing cases where these types of marks were denied registration).
hand, is one that is not on its face offensive but can be offensive to either one person or a group of people. Because of its inherent personal nature, an opposition to this type of mark requires some basis in reasonableness. In order to satisfy this reasonableness requirement, something more than a mere showing that others share the opposer's belief must be required. To better determine that the claim of damage is reasonable, an opposer should demonstrate some personal "link" to the mark in question. As the court noted, this could take the form of an immutable trait or characteristic.\textsuperscript{7} If no such trait exists, then some other distinct link to the mark or the alleged harm it is accused of causing should be demonstrated.

Applying this standard to the \textit{Ritchie} case, Simpson's marks can hardly be considered "per se" or inherently scandalous because in order for someone to arrive at the conclusion that they are scandalous, something more than just common sense is required—a knowledge of the murders and Simpson's association with them.\textsuperscript{78} If the marks are not "per se" scandalous, then only someone with a "personal stake" in the outcome should be permitted to oppose its registration. A member of the Brown or Goldman family would conceivably have a closer nexus to the underlying cause of any reprehension toward Simpson's marks than a complete outsider such as Ritchie. The families of the two murder victims would have standing because of their personal relationship to the underlying event that made Simpson's name infamous.\textsuperscript{79} Their link to the marks and what the marks convey to them presents a much more tenable "real" interest and hence, is different from Ritchie's injury to his morals and values.\textsuperscript{80}

The court drew a favorable comparison among this case, \textit{Bromberg}, and \textit{Harjo} in that the opposers in all these cases represented very large segments of the general public.\textsuperscript{81} What

\textsuperscript{7} \textit{See} Ritchie v. Simpson, 170 F.3d 1092, 1098 (Fed. Cir. 1999).

\textsuperscript{78} Although the murders received tremendous media attention that in some ways divided the nation, \textit{see} supra notes 26–27 and accompanying text, this would not make the marks "per se" scandalous. Conceivably, there will always be many people who do not know what happened, do not believe Simpson is guilty, or just do not care to think about it anymore. This group will only increase with time.

\textsuperscript{79} Arguably, the families' link could be considered a type of immutable trait.

\textsuperscript{80} This link is related to the requirement that the harm be "beyond that of the general public" to show a real interest in the proceeding under the test used by the court in \textit{Ritchie}.

\textsuperscript{81} \textit{See} Ritchie, 170 F.3d at 1097.
the court failed to compare was that Bromberg and Harjo involved immutable traits\textsuperscript{82}—in the first case, women and in the second, Native Americans—whereas this case did not. Mr. Ritchie’s morals and values are not immutable.\textsuperscript{83} Furthermore, reliance on the fact that many people may share Mr. Ritchie’s belief is questionable because the basis for his belief is still open to debate and can possibly diminish. If, for example, someone else were to admit to murdering Nicole Brown Simpson and Ronald Goldman and it could be proven that Simpson had nothing to do with the crime, then arguably many people, like Mr. Ritchie, would change their views about Simpson and what the name connotes to them. As unlikely as this may be, if it were to occur, it would completely pull the rug out from under Ritchie’s reasons for opposing the registration of the marks. This possibility does not exist for the opposers in Bromberg and Harjo. In addition, the mark at issue in Bromberg and Harjo were arguably “per se” scandalous because only common sense and experience were required to arrive at the notion that there was something scandalous about these marks.\textsuperscript{84} This Comment expresses no opinion as to whether Simpson should be permitted to register these marks—it only contends that Mr. Ritchie is not the one to bring the opposition.

Interestingly, a few months after the Federal Circuit decided Ritchie, the TTAB again had occasion to decide the issue of standing to oppose the registration of a trademark. In Boswell v. Mavety Media Group Ltd.,\textsuperscript{85} Arnita Boswell, an African-American woman, and James Clement, a white man, opposed the registration of the mark BLACK TAIL for use on adult entertainment magazines that specialized in depicting nude or scantily-clad African-American women.\textsuperscript{86} The opponents claimed the mark disparaged African-American women and should be

\textsuperscript{82} The Ritchie court recognized the immutable trait aspect in Bromberg and Harjo. See id. at 1098.

\textsuperscript{83} The Ritchie court also conceded this point. See id.

\textsuperscript{84} The sexual undertones of the slogan ONLY A BREAST IN THE MOUTH IS BETTER THAN A LEG IN THE HAND and the racial implications of REDSKINS can easily put these marks in the “per se” category.


\textsuperscript{86} See id. at 1602. The Federal Circuit had previously overturned the Board’s refusal to register this mark during the applicant’s ex-parte proceedings before the PTO. See In Re Mavety Media Group, Ltd., 33 F.3d 1367, 1375 (Fed. Cir. 1994).
denied registration under section 2(a) of the Lanham Act. The Board concluded that only Boswell had standing to oppose the mark. Purporting to distinguish Ritchie, the Board stated:

The Ritchie case is different from the one presently before us, in that it involved a motion to dismiss the claim of scandalousness in view of a lack of sufficient pleading of standing. [citations omitted] However, the [Ritchie] court pointed out that a plaintiff's allegations alone do(es) not conclusively establish standing. If challenged, the facts alleged which establish standing are part of the [plaintiff's] case, and, ... must be affirmatively proved. Thus, the inquiry in the present case is whether opposer Clement has proven his standing, not whether his allegations of standing in the notice of opposition would be sufficient for the proceeding to go forward at trial.

This distinction is without consequence. In both Boswell and Ritchie, the opponents' standing was directly challenged—the Board challenged Clement's standing and O. J. Simpson challenged Ritchie's standing. Furthermore, each opponent's

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87 See Boswell, 52 U.S.P.Q.2d at 1602. Although the "scandalous" and "disparaging" grounds for opposition are stated separately in section 2(a) of the Lanham Act, the same section 13 standing requirements apply to both. See 15 U.S.C. §§ 1052(a), 1063(a) (1994). The courts and the TTAB have been less than consistent in distinguishing between the two terms. On the one hand, the two terms have been analyzed in the same fashion and the terms are sometimes used as a pair. See Ritchie v. Simpson, 170 F.3d 1092, 1097 (Fed. Cir. 1999) (concluding that Ritchie's injury would be disparagement although the allegation was that of scandalousness). In the TTAB's rather lengthy 1999 decision to cancel the REDSKINS marks, the Board used the terms as a pair quite often. See Harjo v. Pro Football, Inc, 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999). The Board in Harjo stated that: "As with scandalousness, the determination of whether matter may be disparaging is highly subjective and, thus, general rules are difficult to postulate. We undertake, however, an analysis similar to that undertaken by the Court and Board in relation to scandalousness to make our [disparagement] determination." Id. at 1737; In re Over Our Heads, Inc., 16 U.S.P.Q.2d 1653, 1655 n.2 (T.T.A.B. 1990) (applying the same analysis to both grounds for rejection). On the other hand, disparagement has been defined as an invasion of privacy. See Greyhound Corp. v. Both Worlds, Inc., 6 U.S.P.Q.2d 1635, 1639 (T.T.A.B. 1988) (citing Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 834 (6th Cir. 1983)). The Board in Greyhound stated that this claim carries two element: (1) the communication would be reasonably understood as referring to the plaintiff, and (2) the communication would be considered offensive to a reasonable person. Id. If this standard were applied to Ritchie's claim of disparagement, it would surely fail the first prong. A finding that a mark is scandalous, however, does not automatically make it disparaging. See In re Old Glory Condom Corp., 26 U.S.P.Q.2d 1216, 1221 (T.T.A.B. 1993).

88 See Boswell, 52 U.S.P.Q.2d at 1604-05.
89 Id. (quoting Ritchie, 170 F.3d at 1099).
90 See Boswell, 52 U.S.P.Q.2d at 1604 ("The first question we must consider is
standing was ultimately decided on the basis of the pleadings. The Board held that because Clement "failed to establish facts on which he could base a reasonable belief that he would be damaged," he lacked standing in the proceeding. Although the Board was trying to say that Clement did not support his allegations as did Ritchie, it is apparent that the Board found it more relevant to the standing issue that Mr. Clement was not an African American. In other words, the immutable trait or "link" was missing. The standing issue in Ritchie and Boswell was, in all material aspects, identical. The Boswell decision is a good illustration of a tribunal jumping through the proverbial "hoops" to avoid the holding in Ritchie. The Board, powerless to overrule or ignore the Federal Circuit, was left with little choice. Decisions like this are likely to continue while Ritchie remains good law.


See Boswell, 52 U.S.P.Q.2d at 1605 ("[W]e look only to Mr. Clement's own assessment of how he believes he is damaged, ... and the evidence which he has submitted in support thereof.").

See id. It is doubtful that the Board would have decided to grant Clement standing had he obtained 4,000 signatures from white males attesting that they share his belief as Ritchie did to oppose Simpson's marks. See supra note 46.

See Boswell, 52 U.S.P.Q.2d at 1605. It is doubtful that the Board would have decided to grant Clement standing had he obtained 4,000 signatures from white males attesting that they share his belief as Ritchie did to oppose Simpson's marks. See supra note 46.

Clement alleged that the BLACK TAIL mark was disparaging because any objective observer of race relations in the United States today recognizes that violations of the rights of members of the African American community, and acts of disrespect to members of said community by members of the majority community, are likely to lead to (a) an antagonistic attitude on the part of the many members of the minority community, (b) a sharpening of racial bigotry on the part of any already racially prejudiced members of the majority community, (c) a worsening of relations between the two communities, and (d) in the worst case, violence between members of the two communities. Id. at 1604. In other words, Clement was alleging that the mark disparaged his belief that a worsening of race relations would damage him as a member of the majority community. The Board failed to explain how this type of damage is any different than Ritchie's claim that Simpson's marks disparaged Ritchie's Christian beliefs.
IV. REGISTRATION OF THE "O. J." MARKS IN LIGHT OF SECTION 2(A) OF THE LANHAM ACT

The sole issue before the Federal Circuit in Ritchie was whether the opposer had standing. The ultimate issue, however, is whether the marks are in fact scandalous under section 2(a). The question of how to determine whether a mark is scandalous and the decisions that have evolved have attracted the attention of several commentators and will not receive an exhaustive review here. A brief review of the significant decisions regarding scandalous marks is sufficient to put the Simpson marks in context.

A. The Standard for Applying Section 2(a)'s "Scandalous" Provision

Over fifty years ago, the United States Court of Customs and Patent Appeals (CCPA), the predecessor court to the Federal Circuit, applied a dictionary definition to determine whether a mark is scandalous within the meaning of section 2(a) of the Lanham Act. The court stated that a scandalous mark is "shocking to the sense of truth, decency, or propriety; disgraceful; offensive... giving offense to the conscience or moral feelings; exciting reprobation, calling out condemnation." This standard survives today and the Federal Circuit has applied it in its own decisions. In 1981, the CCPA first used the often-repeated "substantial composite" rubric and went on to say that the mark "must be considered in the context of the marketplace as applied to only the goods or services described in the application for registration." In other words, "whether an applicant's mark is likely to offend must be judged not in

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95 It appears that Simpson has abandoned the registration of these marks. See, e.g., U.S. Trademark Serial No. 74551770, available at http://tess.uspto.gov; U.S. Trademark Serial No. 74670837, available at http://tess.uspto.gov; U.S. Trademark Serial No. 74670836 available at http://tess.uspto.gov. Simpson can, however, re-apply for registration at any time and hence, the question of whether the marks are in fact scandalous may not remain moot.

96 See, e.g., Baird, supra note 5; Pace, supra note 20; Davis, supra note 37; M. Christopher Bolen, When Scandal Becomes Vogue: The Registerability of Sexual References in Trademarks and Protection of Trademarks and from Tarnishment in Sexual Contexts, 39 IDEA 435 (1999).

97 See In re Riverbank Canning Co., 95 F.2d 327, 328 (C.C.P.A. 1938).

98 Id.

99 See, e.g., In re Mavety Group, Ltd., 33 F.3d 1367, 1371 (Fed. Cir. 1994).

100 In re McGinley, 660 F.2d 481, 485 (C.C.P.A. 1981).
isolation but in the entire context of the marks' use.”\textsuperscript{102} A determination that a mark is scandalous is a legal conclusion based on underlying facts.\textsuperscript{103}

B. The Shifting Tides of Social Tolerance for Alleged Scandalous Marks

Within this less than perfect framework, courts and the TTAB over the years have become increasingly tolerant of marks alleged to be scandalous—the result of contemporary attitudes toward topics and words that were once shunned.\textsuperscript{104} For example, in 1938, the CCPA held that the mark MADONNA for use on wine was scandalous under section 2(a) of the Lanham Act.\textsuperscript{105} The same year, it was also held that the use of QUEEN MARY on women's underwear was scandalous.\textsuperscript{106} Twenty-one years later, the TTAB held that the mark bearing the name of a Moslem sect, SENUSSI, was scandalous when used on cigarettes.\textsuperscript{107} In 1968, the mark BUBBY TRAP for use on woman's brassieres was held to run afoul of section 2(a) because Webster's Third New International Dictionary defined the word as “Breast, now often considered vulgar.”\textsuperscript{108} Forty years after MADONNA was denied registration, the Board relied on the CCPA's rationale\textsuperscript{109} and held that the mark MESSIAS used on wine and brandy was also scandalous.\textsuperscript{110}

In contrast to these rejections, certain questionable marks...

\textsuperscript{103} See Mavety, 33 F.3d at 1371.
\textsuperscript{104} The Federal Circuit has recognized this shift in the public's attitude. See id. ("[W]e must be mindful of ever-changing social attitudes and sensitivities . . . . Proof abounds in nearly every quarter, with the news and entertainment media today vividly portraying degrees of violence and sexual activity that, while popular today, would have left the average audience of a generation ago aghast.").
\textsuperscript{105} See In re Riverbank Canning Co., 95 F.2d 327, 329 (C.C.P.A. 1938) ("[W]e also believe that there are many wine users who, knowing that the excessive use of wine is a great evil and not uncommon, would be shocked by such use of said mark upon wine, especially in view of the fact that such mark would probably be displayed, among other places, in barrooms."). After the trademark statute was revised in 1946, this mark was again denied registration for use on wines. See In re P. J. Valckenberg, G.M.B.H., 122 U.S.P.Q. 334, 334–35 (T.T.A.B. 1959).
\textsuperscript{109} See supra note 105 and accompanying text.
have survived a section 2(a) scandalousness challenge. For example, as early as 1952, the mark LIBIDO for use on women's perfumes was held not to be scandalous. In 1973, the Board concluded that the name WEEK-END SEX for a magazine devoted to sexual relationships did not violate section 2(a).

Specifically, the Board stated that "[i]n resolving the issue as to registerability of the mark . . . consideration must be given to the moral values and conduct fashionable at the moment, rather than that of past decades . . . ." The Board, apparently concerned with the effect of its holding, warned that "what is scandalous or immoral is merely a matter of degree and that this decision should not be interpreted as a precedent for the allowance of clearly immoral or scandalous matter as applied to applicant's goods." In 1988, the Board reversed the trademark examining attorney's refusal to register BIG PECKER BRAND for use on T-shirts despite the examiner's evidence that the third definition of the word "pecker" in the 1981 version of Webster's Third New International Dictionary was "penis - often considered vulgar." The Board found it relevant that the name was used in conjunction with a long-beaked bird and that there was little evidence that people understood "pecker" to

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111 See Ex parte Parfum L'Orle, Inc., 93 U.S.P.Q. 481, 482 (Ch. P. Ex. 1952) ("It is notorious that the perfume trade uses names and advertisements of a suggestive nature and this matter has received some attention in the literature.").


113 Id. (emphasis added). The Board apparently did not feel that way the second time it denied registration to a religious term applied to wine. See supra note 110. It would be interesting whether a religious term used as a trademark on wine would be denied registration today. Also, it is not clear what effect an "at the moment" approach has, if any, on the res judicata implications of a prior determination of scandalousness. In other words, if today an examiner were to reject the registration of the MADONNA mark for use on wine, should the CCPA's 1938 Riverbank Canning holding bind the Board? See supra note 105 and accompanying text. In at least one instance, the Board did not feel bound by precedent, even by a reviewing federal court.

We find the [decisions between 1938 and 1971] to be of little precedential value in deciding the case now before us. Most of these older cases involved a perceived offense to religious sensibilities . . . . Moreover, what was considered scandalous as a trademark or service mark twenty, thirty or fifty years ago may no longer be considered so, given the changes in societal attitudes. Marks once thought scandalous may now be thought merely humorous (or even quaint) . . . .


114 Madsen, 180 U.S.P.Q. at 335.

mean only penis.\textsuperscript{116} The concurring opinion in this decision made the point that the applicant's success in selling the T-shirts with this mark was evidence that it was not objectionable to the public.\textsuperscript{117}

Decisions in the 1990s have also shown a trend toward greater tolerance for seemingly objectionable marks. In 1990, the Board allowed the registration of the mark MOONIES depicted with the two "OO" in the shape of buttocks to be registered for use on dolls that dropped their pants to expose the buttocks.\textsuperscript{118} The trademark examiner had rejected the application on the grounds that it was scandalous matter that disparaged the Unification Church founded by the Reverend Sun Myung Moon.\textsuperscript{119} The Board also reversed an examiner's rejection of a mark consisting of a condom decorated in the stars and stripes of the American flag.\textsuperscript{120} The Board was persuaded by the applicants' portrayal of their fight against AIDS as a patriotic act.\textsuperscript{121} A year later, the Federal Circuit overturned the Board's affirmation of an examiner's refusal to register the mark BLACK TAIL for use on magazines depicting nude or scantily-clad African-American women.\textsuperscript{122} Despite recognizing the weakness of the "substantial composite" standard, the Federal Circuit felt compelled to follow the precedent laid down by the CCPA in the 1981 McGinley decision\textsuperscript{123} and thereby passed on

\textsuperscript{116} See id. at 1472.
\textsuperscript{117} See id. (Cissel, M., concurring). Applicants defending a scandalousness challenge to their marks have not used this "commercial success" argument often.
\textsuperscript{119} See id. at 1653. The Board admitted that this decision was "a close case" and that they were "not free of doubt," but nevertheless erred on the side of allowing the registration because if the mark were in fact scandalous or disparaging to a group, an opposition proceeding could be instituted after publication in the gazette. See id. at 1654; see also supra notes 114-15 and accompanying text.
\textsuperscript{121} See id.
\textsuperscript{122} See In re Mavety Media Group, Ltd., 33 F.3d 1367, 1375 (Fed. Cir. 1994). The court in Mavety remanded the case to the Board to either support its contention that the mark is scandalous or pass the mark for publication in the gazette. See id. The Board ultimately let the mark pass for publication, which led to an opposition proceeding by an African-American woman and a white man. See supra notes 85-95 and accompanying text.
\textsuperscript{123} See Mavety, 33 F.3d at 1371 ("While we recognize the inherent difficulty in fashioning a single objective measure like a substantial composite of the general public from the myriad of subjective viewpoints, we are duty bound to apply the standard set forth by our predecessor court.").
the opportunity to change the standard. In 1999, the Board continued to display a high level of tolerance for potentially objectionable marks by reversing the refusal to register an animated depiction of a frog appearing to give the finger and the mark FRIGGIN’ BARNYARD for use on refrigerator magnets.

Although liberal attitudes have pervaded over the past twenty years or so, some marks simply crossed the line. In 1981, a mark consisting of a photograph of a nude man and woman embracing in a way that exposed the male genitalia for use on a newsletter devoted to such sexual topics as bisexuality, masturbation, and “swinging” was held to be scandalous within the meaning of section 2(a) of the Lanham Act. The same year, the mark BULLSHIT for use on apparel and accessories was held to be scandalous and therefore unregisterable. Similarly, the Board upheld Greyhound Bus Company’s challenge to the registration of a mark depicting a defecating greyhound for use on shirts on grounds that it is scandalous. In 1996, the Board upheld the examiner’s refusal to register the mark DICK HEADS for restaurant and bar services noting that even with today’s attitudes, the mark went too far. These decisions illustrate that today the sky is not the limit when it comes to registering an objectionable trademark.

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128 See Greyhound Corp. v. Both Worlds, Inc., 6 U.S.P.Q.2d 1635, 1639 (T.T.A.B. 1988). This was one of the only cases where the opposer was a corporate entity rather than an individual or group of people.
We believe that the evidence of record is sufficient, given the graphic nature of the mark, to establish prima facie that the mark would be offensive to the conscience or moral feelings of a substantial composite of the general public, notwithstanding the fact that contemporary attitudes towards sexual matters are more liberal than they were just a generation ago. . . . [W]here registration is refused on the ground that a mark consists of or comprises immoral or scandalous matter, the amount of proof required to support the rejection depends upon the nature of the mark, with less evidence being required in those cases involving the more egregious marks.

Id.

130 Marks that contain outright vulgarity stand a good chance of being denied
C. *Simpson's Marks under the Scandalousness Test*

In light of the decisions that have evolved over the past several decades expressing contemporary liberal attitudes, it would be highly unlikely that the marks O. J., O. J. SIMPSON, and THE JUICE would be found to be scandalous within the meaning of the section 2(a) of the Lanham Act. Under the "substantial composite" framework, the TTAB or the Federal Circuit would be hard pressed to find that a substantial composite of the general public regards these marks to be "shocking to the sense of truth, decency, or propriety; disgraceful; offensive...giving offense to the conscience or moral feelings; exciting reprobation, calling out condemnation." The general public's personal feelings about Simpson should not be permitted to play a role in this inquiry. The fact that Simpson has maintained his innocence and was acquitted by a jury of the murder charges cannot be ignored when considering these marks against the standard for scandalous marks. Furthermore, even if members of the Brown or Goldman families were to establish standing to oppose or cancel these marks, they would hardly make up the "substantial composite" that the current standard requires. Therefore, even though Ritchie won the standing issue, he would most likely lose a section 2(a) challenge to Simpson's marks on the merits.

**CONCLUSION**

Despite the broad language of the Lanham Act's provision for opposing trademark registrations, there is a need for some meaningful restrictions to help determine who has standing to oppose or cancel a trademark registration. Without such restrictions, the potential exists that mere intermeddlers will be able to interfere with the legitimate registration of trademarks, affecting both the federal courts and the TTAB with oppositions on frivolous grounds. The *Ritchie* holding may also have a chilling affect on future registrants of marks as the court has opened the flood gates for members of the general public to oppose or cancel registrations for tenuous and esoteric reasons.

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registration under section 2(a). Such marks have included IF YOU'RE FULL OF SHIT... YOU'RE A FRIEND OF MINE for sewer cleaning services, BITCH WOMAN for greeting cards, SHITHEAD for assorted novelty items, and CROCK OF S.H.I.T. for plant food. See Baird, supra note 5, at 719.

131 In re Riverbank Canning Co., 95 F.2d 327, 328 (C.C.P.A. 1938).
With the Federal Circuit's holding in *Ritchie*, a disturbing precedent has been set whose ultimate effect may not be evident for years to come because of the uncommon nature of these types of oppositions. It is not contended that the proposed framework for analyzing the standing requirements in a scandalous challenge to a mark establishes a "bright-line" test that is easily applicable to all cases. A bright-line test is impossible given the inherent subjectivity of the inquiry. The proposed standard does, however, attempt to apply the section 13 standing requirement of the Lanham Act with some restrictive effect—something sorely lacking in the troublesome section 2(a) statutory provision. It would not be surprising if *Ritchie* and the TTAB's 1999 decision to cancel the Washington Redskins trademark registrations serve as catalysts for a court to take another hard look at the constitutionality of section 2(a).

The TTAB and the courts have been faced with a very difficult task in deciding whether a trademark is scandalous under section 2(a). The decisions that have emerged illustrate how both federal and administrative trademark judges have struggled to apply a very amorphous standard. Ultimately, these decisions were driven largely by the social norms of the times—the result of the subjective nature of what is scandalous or immoral and the ever-evolving tenor of societal views. Although the courts and the TTAB have shown greater, albeit not unlimited, tolerance for the registration of questionable marks, it seems highly unlikely in the modern age that the underlying circumstances surrounding the notoriety of O. J. Simpson would render these marks scandalous within the meaning of section 2(a) of the Lanham Act. As the Federal Circuit aptly put it, "[t]oday's scandal can be tomorrow's vogue."132

132 *In re Mavety Media Group, Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).