

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of:	:	
CYBERNET ENTERTAINMENT, LLC	:	International Class 41
Serial Number 78/680513	:	
Filed: July 28, 2005	:	Examiner Michael Engel
For: FUCKINGMACHINES	:	Law Office 107
	:	

**BRIEF FOR APPELLANT**

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## I. INTRODUCTION

Appellant, Cybernet Entertainment, LLC (hereinafter, “Applicant,” “Appellant” or “Cybernet”) hereby appeals from the Examining Attorney’s (hereinafter “Examiner”) Second Refusal to register the above-identified mark.

The Examining Attorney refused registration of Applicant’s word mark “fuckingmachines” on the ground that in the Examiner’s opinion, the proposed mark consists of or comprises immoral or scandalous matter. The Applicant disagrees with both the factual and legal determinations of the Examiner, and respectfully requests that the Board reverse the Examiner’s decision.

## II. STATEMENT OF FACTS

On July 28, 2005, Applicant filed its application to register the word mark FUCKINGMACHINES on the principal register for “Entertainment services of an erotic/sexual nature, namely, providing a web site featuring film clips, photographs, and other multimedia materials, with access limited to adult viewers, excluding any use of the Mark other than in media or venues where erotic and adult-oriented content is provided.”<sup>1</sup> On February 26, 2006, the original Examiner issued her rejection based on Section 2(A), and on August 22, 2006, the Applicant filed a response. On October 5, 2006, the new Examiner issued his second and final refusal.

## III. ARGUMENT

### ***One man’s vulgarity is another man’s lyric***

In the majority opinion in the landmark Supreme Court case, *Cohen v. California*, 403 U.S. 25 (1971) Justice Harlan wrote:

*[W]hile [fuck], the particular four-letter word being litigated here is perhaps more distasteful than most others of its genre, it is nevertheless often true that one man’s vulgarity is another man’s lyric. Id. at 23.*

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<sup>1</sup> This is the description of goods and services arrived at after two amendments.

There can be no better foundation upon which to build Cybernet's key point in this case than Justice Harlan's recognition of the requirement that government remain neutral in matters of morality, vulgarity, and content-based restrictions. Nevertheless, the TTAB need not reach such lofty arguments in order to hold in favor of Cybernet, since the standard for determination that "fuckingmachines" is immoral or scandalous has not been met. The Examiner has erred on three grounds: 1) The term "fuck" or "fucking" does not rise to the level of condemnation required under Section 2(A), 2) the Examiner failed to apply the requirement that the mark must be examined in the context of the relevant marketplace, and 3) the Examiner's evidence has been rebutted with superior evidence.

**A. AS A FACTUAL MATTER, AMERICA NO LONGER FINDS  
"FUCKING" TO BE IMMORAL OR SCANDALOUS.**

Under Section 2(a), to be considered "scandalous," a mark must be "*shocking to the sense of truth, decency or propriety; disgraceful; offensive; disreputable; ... giving offense to the conscience or moral feelings; ... [or] calling out for condemnation,*" in the context of the marketplace as applied to goods or services described in the application. *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371, 31 USPQ2d 1923, 1925 (Fed. Cir. 1994); *In re Wilcher Corp.*, 40 USPQ2d 1929, 1930 (TTAB 1996). **Scandalousness is determined from the standpoint of "not necessarily a majority, but a substantial composite of the general public, ... and in the context of contemporary attitudes."** *Id.* Emphasis added.

Llewellyn Joseph Gibbons said, in *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(A) Trademark Law after Lawrence v. Texas*, 9 MARQ. INTELL. PROP. L. REV. 187, 248 (2005) at n. 89 ("At best, this 'substantial portion' of the general public is a vacuous point on a nebulous continuum. One that is often chosen post-hoc to justify the decision-maker's preconceived determination.").

Cybernet does not take the position that the Examiner had a personal preconceived determination, but *the USPTO* has made a preconceived determination that there is a list of words that are of such

magical quality that no legal standards need apply to proposed marks that contain those words. This can not stand.

The mark must be examined in the context of the current attitudes of the day. See *In re Mavety*, 33 F.3d at 1367. It is under the lens of the moral values and mores of *contemporary* society in which the word must be viewed. See *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.").

When Section 2(a) was written in 1905, matters of public morality were still reeling from Victorian influence. As out-moded as Section 2(a) may be, Cybernet recognizes the limited power the TTAB has to rule on this issue, but specifically preserves the issue for appeal if necessary. The TTAB does have the power to, and should recognize that the moral values and mores of contemporary society tolerate "fucking" to a great level, and in the relevant marketplace, it would be embraced rather than condemned.

In the year 2007 (in fact well before) the fact is, "fucking" can no longer be considered to be *scandalous* or *shocking*. A full factual and evidentiary discussion was provided at pages 2-12 of the initial Response to Office Action, attached as Exhibit A<sup>2</sup>, and pages 2-12 are fully incorporated by reference as an integral part of this Appeal. Hereinafter, the initial Response to Office Action shall be referred to as "ROA."

In response to Cybernet's voluminous evidence in the ROA that the term "fucking" does not rise to the level of outrage required by Section 2(A) (See ROA at 2-12), the Examining Attorney wrote:

*To be considered "scandalous," a mark must be "shocking to the sense of truth, decency or propriety; disgraceful; offensive; disreputable; ... giving offense to the conscience or moral feelings; ... [or] calling out for condemnation," in the context of the marketplace as applied to goods or services described in the application. Scandalousness is determined from the standpoint of "not necessarily a majority, but a substantial composite of the general public, ... and in the context of contemporary attitudes."* (Office Action issued October 5, 2006.) (Citation omitted.)

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<sup>2</sup> Although Section 1203.01 states that "as a matter of course" papers that are already in the file should not be resubmitted as exhibits to the brief, given that the USPTO TEAS system requires formatting that has made it difficult to read, therefore out of courtesy to the Board, it is attached (without exhibits) to this Brief.



Cybernet provided volumes of clear and convincing evidence that the mark does not rise to this standard. See ROA at 2-12. In his rebuttal, the Examiner states “*the word [fucking] is still considered shocking in most formal or polite situations.*” No citation nor reference was provided.

While the word may not be “polite” in certain situations, this is not the standard by which proposed marks are to be judged under Section 2(A). The disputed mark must be evaluated in the context of the relevant marketplace – erotic entertainment consumers – not formal or polite conversations.

The mark is hardly “*calling out for condemnation,*” especially when the context of the relevant goods and services is taken into account as required under *In re Mavety*.

#### **B. THE RELEVANT MARKETPLACE**

Even if the Mark were *immoral* or *scandalous*, this determination should only be made “in the context of the marketplace as applied to goods or services described in the application.”<sup>3</sup> Therefore, even if the TTAB believes that “fuck” or “fucking” is still of such talismanic power that it would shock a substantial portion of the American public (a superstition that should be dispelled above), then the TTAB could simply look at the *relevant* marketplace – instead of America as a whole.

To determine whether a mark is scandalous or immoral, the Federal Circuit has developed a three-pronged test: (1) the mark must be shocking to the sense of truth, decency, or propriety, or call out for condemnation; (2) the mark must be considered in the context of the marketplace as applied to only the goods or services in the application for registration; and (3) the mark must be scandalous to a substantial composite of the general public, as measured from the context of contemporary attitudes. See *In re Mavety Media Group Ltd.*, 33 F.3d at 1371; *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d 1635, 1639 (TTAB 1988); *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981) (In determining whether

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<sup>3</sup> Quotation is from the Examiner’s initial rejection, but it cites the following cases: *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371, 31 USPQ2d 1923, 1925 (Fed Cir. 1994); *In re Wilcher Corp.*, 40 USPQ2d 1929, 1930 (TTAB 1996). See also, *In re Hershey*, 6 USPQ2d 1470 (“to determine whether a designation is properly refused as scandalous, the mark must be considered in the context of the marketplace as applied to the goods or services described in the application”)

appellant's mark may be refused registration as scandalous, 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).

The relevant marketplace is the erotic entertainment-consuming public. The relevant marketplace is that section of the population that is comfortable with and has an interest in consuming legal and non-obscene pornographic materials, a marketplace that would consider the word “fucking” to be rather tame.

The Examining Attorney went so far, in his final refusal, to concede that this key “relevant marketplace” argument “has some merit, and some support in ... *Mavety Media Group*.” Disappointingly, the Examiner chose to step away from this binding authority, in favor of an unpublished “policy.”

*[A]pplicant's argument, if accepted, would mean that Section 2(a) would almost never be applied to marks used in connection with pornographic goods and services. The Office has not adopted this policy, and instead determines scandalousness from the viewpoint of “a substantial composite of the general public.” As in the case of applicant's constitutional argument, any change in Office policy can only occur pursuant to an appeal to the Trademark Trial and Appeal Board. (Examiner's final refusal).*

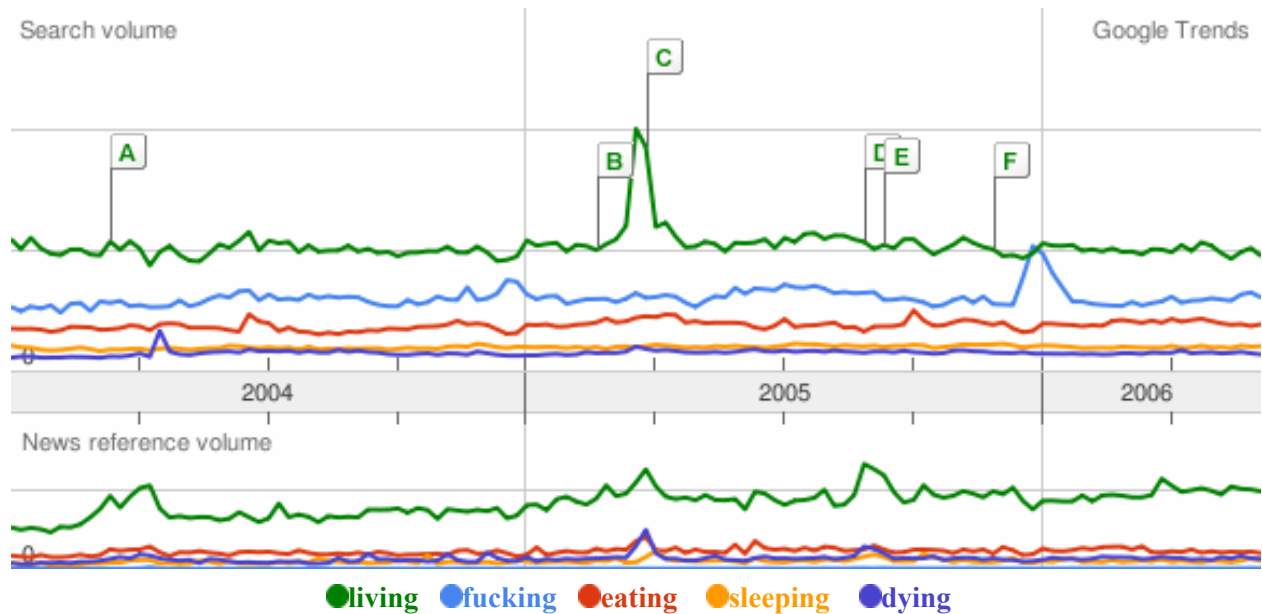
This is truly disturbing. Following the Examiner's reasoning would mean that unwritten and unspoken policies trump the Constitution, decisions of the Federal Circuit, decisions of the TTAB, and facts. Do we exist in a nation of laws, or of “unspoken and unwritten policies?” The Examiner may not evade the “relevant marketplace” analysis simply because the result will be counter to a phantom “policy” and the fact that this analysis will mandate a reversal of the Examiner's determination.

This relevant marketplace approach is firmly entrenched in Trademark Law. See, e.g., *In re Hershey*, 6 USPQ2d 1470 (TTAB 1988) (“to determine whether a designation is properly refused as scandalous, the mark must be considered in the context of the marketplace as applied to the goods or services described in the application”). With this in mind, if the TTAB is uncomfortable accepting the fact that our contemporary society has embraced “fuck,” (as has been proven by The Factual Arguments, See ROA pp. 2-12) then the Board may narrow the relevant marketplace to either the Internet, or to the adult Internet. Both would be appropriate under *In re Mavety*.

**1. THE INTERNET COMMUNITY TOLERATES “FUCK” MORE THAN OTHER SEGMENTS OF SOCIETY.**

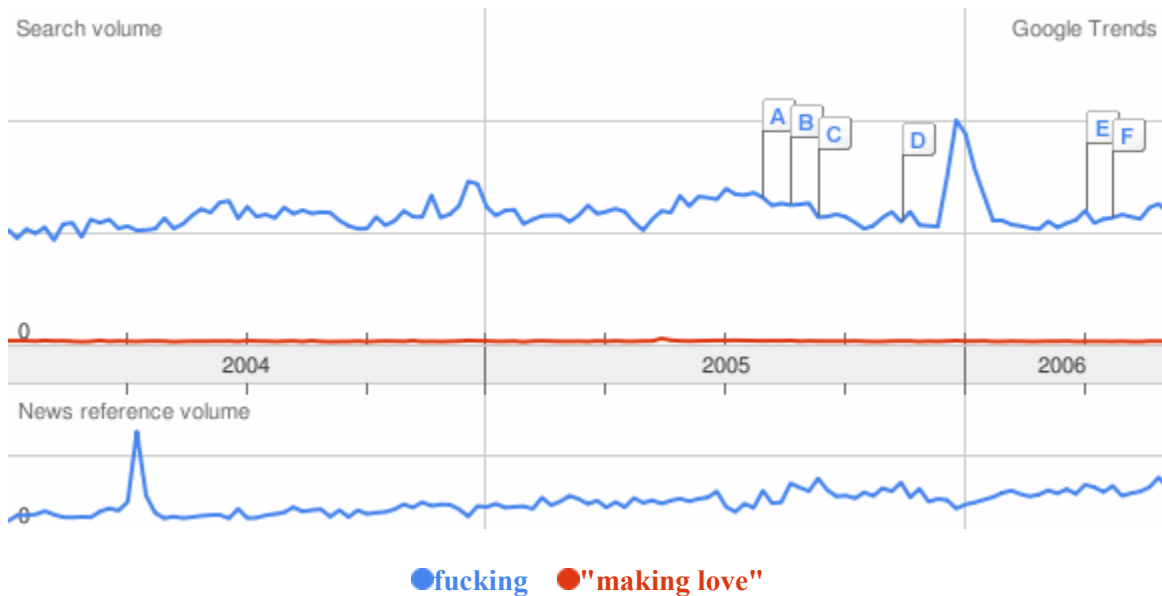
The Board will find that “fuck” is even more accepted on the Internet than in the terrestrial world.

If we compare the number of Google® searches for the following terms: fucking, eating, sleeping, living, and dying, it appears that Americans are most preoccupied with living, but after that, “fucking” beats out the other essential gerunds by placing a strong Second in this five way race, and at one point in January 2006, “fucking” actually surpassed “living.”



If the TTAB does not have the benefit of seeing the graph in color, the lines are listed in top to bottom order, with “living” as the top line, and “dying” at the bottom. Of course, searches for “living” are not limited to that one term. A user could have searched for “Martha Stewart Living” or “Living in Chicago” and contributed to the search volume, just as one could have searched for “fucking aristocrats” or “fucking brilliant.” However, the TTAB can not escape the fact that if the word “fucking” has been typed into the Google search engine more times than “eating” “sleeping” or “dying”, then Cybernet would not be incorrect in stating that “fucking” is not as scandalous or shocking as some may believe – especially not in the context of the Internet – the relevant marketplace.

Lest the TTAB believe that these queries are out of context, Cybernet provides the following – a comparison between “fucking” and “making love.”



While The Daily Californian asked its readers what the difference is between “fucking” and “making love,”<sup>4</sup> and got a number of varied philosophical responses (demonstrating acceptance of the term, “fucking”), an analysis of Google searches shows that we can actually finally answer this age old question – the difference is billions of Google searches. Further evidence of “fucking” beating “making love” is evidenced by the sheer number of web pages that contain the two terms. There are approximately 92,700,000 web pages that contain the term “fucking,” compared to 4,340,000 that contain “making love.” This indicates that we have come to grips with and have embraced “fucking” – in fact, it seems that we as a society, are more uncomfortable with love than with fucking.

The above Google trends charts were limited to United States IP addresses – demonstrating that in contemporary America, we are quite comfortable with “fucking.” One commentator has even said that fuck “is a more commonly used word than mom, baseball, hot dogs, apple pie, and Chevrolet.”<sup>5</sup> See also ROA at 2-12.

<sup>4</sup> Sari Eitches, *Sex on Tuesday: In Love We Lust*, DAILY CALIFORNIAN, Tuesday, February 15, 2005 found at <http://www.dailycal.org/sharticle.php?id=17635>.

<sup>5</sup> See Eric Vanatta, *The F-Motion*, 21 CONST. COMMENT. 285, 288-89 (2004) (noting *fuck* had 24.9 million hits compared to *baseball*, its closest competitor, with only 13.6 million hits).

**2. THE FURTHER NARROWED RELEVANT MARKETPLACE WOULD NOT FIND THE MARK TO BE IMMORAL OR SCANDALOUS.**

Given the limitations placed on the relevant channels of trade in the description of goods and services pursuant to Cybernet's description of goods and services, the contours of the marketplace should be comfortably demarcated far from any territory where a potential viewer would find the use of the term "fucking" to be scandalous. The goods and services of the proposed mark are:

**Entertainment services of an erotic/sexual nature, namely, providing a web site featuring film clips, photographs, and other multimedia materials, with access limited to adult viewers, excluding any use of the Mark other than in media or venues where erotic and adult-oriented content is provided**

As illustrated in description, Cybernet's expression is transmitted to a limited marketplace of consumers consisting of a consenting adult audience, desirous of receiving and enjoying the message conveyed by works relating to human sexual interest and sensual subtleties.<sup>6</sup> See ROA at 9-10.

Determinations under trademark law hinge upon the definition of the relevant marketplace or "channels of trade." See, e.g., *M2 Software, Inc. v. M2 Communs., Inc.*, 450 F.3d 1378, 1383 (Fed. Cir. 2006) (no likelihood of confusion when identical marks were used to brand products in different channels of trade); *PC Club v. Primex Techs., Inc.*, 32 Fed. Appx. 576, 577 (Fed. Cir. 2002) (degree of care potential consumers will exercise when purchasing one product over another can mitigate likelihood of confusion); *Bell Laboratories, Inc. v. Colonial Products, Inc.*, 644 F. Supp. 542, 544 (S.D. Fla. 1986) (marketing channels used is operative to the likelihood of confusion analysis); *University of Georgia Athletic Association v. Laite*, 756 F.2d 1535 (11th Cir.1985) (same). To enter the channel of trade for Cybernet's goods and services, a potential consumer will have ample fair warning that he or she is about to enter a realm of sexual expression. See ROA at 10-11. The relevant marketplace – limited by the description of services – is the "red light district" of the online world.

The Examining Attorney's final refusal relies upon the assertion that "broadcasters *can be* fined by the FCC for letting [fuck] go out over the airwaves." (emphasis added). Much like Section 2(a), fines

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<sup>6</sup> See Fucking Machines splash page. <http://fuckingmachines.com/>. This initial page contains no graphic content, but requires the user to affirm that he or she is visiting the site voluntarily and that he or she is over the age of 18.

issued by the FCC are supposed to be evaluated in the context of the relevant marketplace. Even the FCC recognizes that when a government agency makes a determination of indecency, it must proceed cautiously and with appropriate restraint. See *Action for Children's Television v. FCC*, 852 F.2d 1332, 1344 (D.C. Cir. 1988) (“the FCC may regulate [indecent] material only with due respect for the high value our Constitution places on freedom and choice in what people may say and hear.”) Such restraint seems lacking in the Examiner’s Refusal.

Cybernet does not concede that the FCC’s standards should be applied to trademarks. Important to note is the fact that the FCC would have no jurisdiction over the relevant marketplace of online communications, which are not subject to broadcast indecency restrictions. *Reno v. ACLU*, 521 U.S. 844 (1997). Nevertheless, even the FCC applies a “relevant marketplace” standard. The Commission defines “indecent speech” as language that, in context, depicts or describes sexual or excretory activities or organs in patently offensive terms as measured by *contemporary community standards for the broadcast medium*. See *Infinity Broadcasting Corporation of Pennsylvania*, MEMORANDUM OPINION AND ORDER, 2 FCC Rcd 2705 (1987) (subsequent history omitted) (citing *Pacifica Foundation*, 56 FCC 2d 94, 98 (1975), *aff’d sub nom. FCC v. Pacifica Foundation*, 438 U.S. 726 (1978)). To support a finding of indecency, “the broadcast must be *patently offensive as measured by contemporary community standards for the broadcast medium*.” *Industry Guidance on the Commission’s Case Law Interpreting 18 U.S.C. §1464 and Enforcement Policies Regarding Broadcast Indecency, Policy Statement*, 16 FCC Rcd 7999, 8002, 66 Fed Reg 21984 (2001). **(Emphasis added.)**

Even broadcast television will tolerate “fuck” when the relevant surrounding content is considered, and consumers are not “ambushed.” See *In re Complaints Against Various Television Licensees Regarding Their Broadcast on November 11, 2004, of the ABC Television Network's Presentation of the Film "Saving Private Ryan"*, No. EB-04-IH-0589, 2005 FCC LEXIS 1268, at 1 (Fed. Comm. Comm'n Feb. 28, 2005).

Even in its environment of hysteria ushered in by the infamous “wardrobe malfunction” in 2004, when the FCC makes indecency determinations, the “full context in which the material appeared is

critically important.” *Industry Guidance on the Commission’s Case Law Interpreting 18 U.S.C. §1464 and Enforcement Policies Regarding Broadcast Indecency, Policy Statement*, 16 FCC Rcd 7999, 8002, 66 Fed Reg 21984 (2001). In *Pacifica*, the Court noted that “context is all-important.” 438 U.S. at 750. In so holding, the Court observed that “indecency is largely a function of context – it cannot be adequately judged in the abstract.” *Id.* at 742.

The Examining Attorney’s prediction that Section 2(a) would almost never be applied to adult products is untrue, alarmist, and illogical. Section 2(a) would still bar marks in the adult-entertainment marketplace. For example, racist, defamatory, or misleading marks would still be properly barred from registration. Marks referring to child pornography, bestiality, or incest (all illegal activities) could continue to be banned. Furthermore, a decision to allow this mark to proceed to publication would not be binding upon future Examining Attorneys. “The Board is not bound by prior decisions of Trademark Examining Attorneys, and that each case must be decided on its own merits and on the basis of its own record, in accordance with relevant statutory, regulatory and decisional authority.” *In re Thomas H. Wilson*, 57 U.S.P.Q.2D (BNA) 1863 (TTAB 2001). In fact, even a decision by the TTAB would not necessarily be binding, unless the TTAB specifically designated it as citable as precedent of the TTAB. Following the law, in this case, would not bring about the demise of Section 2(A) as a whole.

Finally, allowing the mark to be published for opposition is not the end of the road. Should any member of the public determine that the mark is, indeed, calling out for condemnation, they would be free to oppose the mark’s registration. See *In re Hines*, 32 U.S.P.Q.2d 1376 (TTAB 1994) (publishing the mark “BUDDHA BEACHWEAR” for opposition, allowing members of the Buddhist religion to oppose the mark on the grounds that it was “imperative that the board be careful to avoid interposing its own judgment for that of Buddhists.”)

At that point, the burden will no longer be upon the USPTO to provide evidence contrary to that provided by Cybernet, but rather this “morality policing” will be properly privatized and taken out of the government’s hands. If a “substantial composite” of the public is sufficiently scandalized, then an opposition action may be brought. At that point, any citizen with proper standing who seeks to oppose

the mark may conduct studies, provide full evidence, and Cybernet will be able to provide its own contradictory evidence. At that point, the factual determination may find its way before the TTAB again, but at least then Cybernet will have its fair day in court, and the evidence will be properly evaluated, and the USPTO will remain neutral – as it should.

If the USPTO is not prepared to interpose its own judgment for that of Buddhists, why will the USPTO interpose its judgment for that of the most easily shocked and offended members of society who are so far outside the mainstream that they would be improperly described as “a substantial composite” of any segment of the public? It should not.

### **C. THE UNCONSTITUTIONALITY OF 2(A) AS APPLIED**

Cybernet recognizes that an administrative tribunal such as the Trademark Trial and Appeal Board has no authority to declare provisions of the Lanham Act unconstitutional. See *Panola Land Burgers Assn. v. Shuman*, 762 F.2d 1550 (11th Cir. 1985). Similarly, the Board has no authority to determine whether Section 2(a) is overbroad or vague, and merely preserves this issue for appeal, should the TTAB not rule in Cybernet’s favor. However, the Board may apply First Amendment principles to the Examining Attorney’s determination, and if it does so, the Examining Attorney’s decision must be reversed.

#### **1. THE EXAMINER’S DETERMINATION IS A CONTENT-BASED RESTRICTION ON EXPRESSION**

The USPTO’s prohibition of scandalous or immoral marks has been harshly criticized.<sup>7</sup> Thus far, all USPTO decisions regarding the constitutionality of Section 2(A) rely upon *In re Robert L. McGinley*, 660 F.2d at 481. Cybernet takes the position that *McGinley* was improperly decided and was a mere attempt to shoehorn the personal prejudices of the three judges who held against registration into whatever constitutional crack they might be able to find. In fact, the two judges who dissented in that opinion seem to have gotten it right.

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<sup>7</sup> See, e.g., Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: § 2(A) Trademark Law After Lawrence v. Texas*, 9 MARQ. INTELL. PROP. L. REV. 187, 224 (2005).



*I find the record does not support a fact I believe the majority thinks is controlling but I speculate since I do not really know why the majority holds the mark to be scandalous.*

*The majority appears to rely on the Riverbank (MADONNA for wine) case decided in 1938. It was a three-to-two decision and I feel the dissenters took the sounder position. I think the decision is no longer of precedential value in view of the social changes in the ensuing 43 years. The majority cites Riverbank in apparent support of using as a basis for decision the imagined feelings of "a substantial composite of the general public." There is no such expression in Riverbank and I am at a loss to know what it means or how one can have a "composite" of a class such as "the general public."*

*I would reverse. More "public funds" are being expended in the prosecution of this appeal than would ever result from the registration of the mark. See *In re McGinley*, 660 F.2d 481, 487 (C.C.P.A. 1981) (RICH, J. dissenting).*

In 1981, perhaps the three judge majority was prepared to rely upon 43 year old social mores. However, continued reliance upon *McGinley*, means that we are now relying upon 69 year old sensibilities, with 69 years of First Amendment and trademark jurisprudence that completely discredits the results-based reasoning in *McGinley*.

Although Cybernet would welcome an overruling of *McGinley*, the Appellant recognizes that the TTAB is not in a position to do so. Nevertheless, the TTAB is certainly in a position to recognize that even if *McGinley* were properly decided, it has been superseded by multiple cases that have calcified the previously more amorphous area of commercial speech law and the law surrounding the constitutionally of restrictive laws based on morality.

*McGinley* erroneously held that since trademark applicants were still free to use the trademarks in question, then there was no abridgment of speech. See *McGinley* 660 F.2d at 484. However, this reasoning is unsupported by a vast body of First Amendment jurisprudence, and more importantly, it has been discredited by years of more developed controlling law.

Since *McGinley*, the Federal Circuit has recognized that non-registration is, indeed, a government-imposed penalty. *In re Cal. Innovations, Inc.*, 329 F.3d 1334, 1340 (Fed. Cir. 2003) (describing non-registration as the "penalty of non-registrability" and a "harsh consequence"). In the case at bar, the USPTO is imposing this penalty solely on the basis of the content of Cybernet's expression. No governmental interest has been articulated, let alone a substantial one, for this content-

based decision. This is clearly unconstitutional behavior. See, e.g., *Simon & Schuster v. N.Y. State Crime Victims Bd.*, 502 U.S. 105 (1991).

When the government imposes a penalty based on the content of expression, it must overcome the heavy burden of strict scrutiny in order for that penalty to be imposed. For example, in striking down New York's "Son of Sam" law, which prohibited criminals from profiting from writing books about their crimes, the Supreme Court held "[a] statute is presumptively inconsistent with the First Amendment if it imposes a financial burden on speakers because of the content of their speech." See *Simon & Schuster*, 502 U.S. at 115. In that case, authors were still free to write, but were merely denied some financial benefits of their labors – the Supreme Court found this to be an unconstitutional restriction on expression.

This dispenses with *McGinley's* flawed reasoning that economic penalties on expression are not content-based restrictions on expression. Subsequent cases have determined that trademarks are, indeed, commercial speech. See, e.g., *Bad Frog Brewery, Inc. v. New York States Liquor Authority*, 134 F.3d 87 (2d Cir. 1998). In the case at bar, if Cybernet is not permitted to protect its well-developed and widely recognized trademark on an equal footing with other marks, and is relegated to the "cheap seats" in the trademark stadium – mere common law trademark rights – there will be a significant penalty in the form of non-registrability and its attendant financial and commercial deprivation solely because the mark contains the word "fuck." While this may not ban commercial adult entertainment, if this decision stands, then adult media companies, or any other companies that seek to engage in commercial speech of this type, will find themselves at a distinct financial disadvantage over other entities that are not similarly situated.

Accordingly, the USPTO appears to have chosen an unwritten "office policy" over the statute, case law, and the Constitution. This can not stand.

## 2. IN LIGHT OF BAD FROG BREWERY AND ALAMEDA BOOKS, THE EXAMINER'S DETERMINATION MUST FAIL

Subsequent to *McGinley*, the Second Circuit analyzed a similar issue in *Bad Frog Brewery, Inc.*, 134 F.3d at 87. In that case, the appellant sought to use a trademark of a frog “giving the finger” to any and all passerby on bottles of liquor. The Second Circuit held that since *trademarks are commercial speech*, prohibition on use of so-called “offensive” trademarks did not advance the stated governmental purpose of protecting children from vulgarity or promoting temperance, nor was it narrowly tailored to serve that purpose. Even if it had, this likely would not have been a proper purpose. See, e.g., *ACLU v. Gonzalez*, 2007 U.S. Dist. LEXIS 20008 (E.D. Pa. 2007) (“Indeed, perhaps we do the minors of this country harm if First Amendment protections, which they will with age inherit fully, are chipped away in the name of their protection.”).

“[T]he party seeking to uphold a restriction on commercial speech carries the burden of justifying it.” *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 71 n.20 (1983). This burden “is not satisfied by mere speculation or conjecture”; to meet this burden, the USPTO “must demonstrate that the harms it recites are real and that its restriction will in fact alleviate them to a material degree.” *Edenfield v. Fane*, 507 U.S. 761, 770-71 (1993). In addition, a speech regulation “may not be sustained if it provides only ineffective or remote support for the government's purpose.” *Greater New Orleans Broad. Ass'n. v. United States*, 527 U.S. 173, 188 (1999) (quoting *Central Hudson Gas & Electric Corp. v. Public Service Comm'n of New York*, 447 U.S. 557 (1980)). These mandates are “critical,” for otherwise, “[the government] could with ease restrict commercial speech in the service of other objectives that could not themselves justify a burden on commercial expression.” *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 487 (1995) (quoting *Edenfield*, 507 U.S. at 771). See also *Utah Licensed Bev. Ass'n v. Leavitt*, 256 F.3d 1061, 1065 (10th Cir. 2001) (articulating the above analysis and citing above cases).

In the instant case, what is the governmental purpose? None has been articulated. Nevertheless, assuming *arguendo* that there is a governmental purpose, the Examiner's determination must fail.

In *City of Los Angeles v. Alameda Books*, 535 U.S. 425 (2002), the U.S. Supreme Court held that if the government seeks to restrict First Amendment protected activity in order to combat compelling harms such as prostitution, crime, and lower property values, it may only do so if it reasonably relies upon competent evidence to do so. The government may rely on evidence “reasonably believed to be relevant” for demonstrating the connection between a regulation and the stated governmental interest. *City of Los Angeles v. Alameda Books*, supra, citing, *Renton v. Playtime Theatres Inc.*, 475 U.S. 41, 51-52 (1986). However, a challenger may then cast doubt upon the government's rationale or evidence. *Id.* The burden then shifts to the government to rebut the challenger's evidence. *Id.*

In this case, the Examiner provided an online dictionary entry as “evidence” that the mark is “vulgar,” and from that, he extrapolated that a substantial composite of the American public would find it “shocking, scandalous, and calling out for condemnation.” Cybernet then provided 10 pages of discussion as to why the Examiner was wrong, along with hundreds of pages of more compelling evidence. See ROA at 2-12 and sources cited. The Examiner provided no competent rebuttal evidence.

The best “evidence” that the Examining Attorney could provide in this case is the opinion of an unnamed dictionary editor. A single dictionary editor's opinion that a term is “vulgar” does not create the presumption, let alone prove, that a “substantial composite of the general public” would then believe that the term is “calling out for condemnation” – especially when such “evidence” has been refuted, as it has been in the ROA at 2-12.<sup>8</sup>

Cybernet takes the position that an online dictionary's determination that “fucking” is vulgar, and thus would be shocking or scandalous to a substantial composite of the American public, is absurd, and fails the “reasonably believed to be relevant” test provided by *Alameda Books*. The undersigned may log on to “Urban Dictionary” or “Wikipedia” and modify any entry he likes, with no repercussions. The Examiner's evidence would have been more credible if he had simply stated the conclusion as his own personal opinion – at least then there would be source accountability. Instead, he elected to rely upon “evidence” provided by an anonymous online source. Under *Alameda Books*, while the government may

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<sup>8</sup> This is to say nothing for the fact that “vulgarity” is not mentioned in Section 2(A).

rely on any evidence that is reasonably believed to be relevant for demonstrating a connection between speech and a substantial, independent government interest, “the government may not “get away with shoddy data or reasoning.” 535 U.S. at 438 (citation and internal quotations omitted).

Let us assume, *arguendo*, that it was reasonable to rely upon this shoddy source. *Alameda Books* then gives the affected business the right to rebut the government’s evidence. See, e.g., *Dr. John’s Inc. v. City of Roy*, 465 F.3d 1150, 1165 (10th Cir. 2006) (articulating *Alameda Books* standard); *Free Speech Coalition v. Gonzalez*, 2007 LEXIS 24389 (D. Colo. 2007); *Connection Distrib. Co. v. Reno*, 46 Fed. Appx. 837 (6th Cir. 2002); *Connection Distrib. Co. v. Gonzalez*, 2006 LEXIS 24506 (N.D. Ohio 2006); *Free Speech Coalition v. Gonzalez*, 406 F.Supp. 2d 1196, 1206 (D. Colo. 2005).

Cybernet has provided volumes of evidence that cast direct doubt upon the Examining Attorney’s rationale. See ROA at 2-12. See also. In this “battle of rationales,” the Examining Attorney has barely taken the field, let alone demonstrated any supporting reasoning.

The “evidence” provided by the Examiner can be called nothing short of inadequate when presented alongside Cybernet’s evidence. Even if the Examiner has shown some articulable interest (which it has failed to do), it may not simply point to such questionable evidence to support a pre-ordained determination that certain words are “off limits” at the USPTO. This is especially true in light of overwhelming evidence that disproves the government’s position. *Alameda Books*, 535 U.S. at 425.

Cybernet has already demonstrated that the mark would not be “shocking to the sense of truth, decency, or propriety, or call out for condemnation” unless the control group was out of touch with contemporary society. See ROA at 2-12. The mark *may* be impolite. However, it has been shown that the mark is neither “shocking to the sense of truth, decency, or propriety” nor “calling out for condemnation.” Cybernet has shown that the word “fuck” could not reasonably be considered to be scandalous to a “substantial composite of the general public as measured in the context of contemporary attitudes.” See ROA at 2-12.

#### IV. CONCLUSION

When weighing the mandates of a decision of the Supreme Court (*City of Los Angeles v. Alameda Books, Inc.*, 535 U.S. at 425, and the Federal Circuit (*In re Mavety Media Group Ltd.*, 33 F.3d at 1367, on one side, and an unpublished (and presumably unwritten) “policy” of the USPTO on the other, the decision should be rendered consistent with the decision of those courts – and not out of an unfounded fear that 2(A) would somehow be rendered ineffective in the context of pornographic materials. Each mark is taken on a case-by-case basis, and the Examining Attorney can hardly be faulted for rendering a non-binding decision that is consistent with controlling and binding case law.

For the reasons set forth above, Applicant holds the position that the proposed mark, “fuckingmachines,” is neither scandalous, nor immoral. In the alternative, the Mark is not scandalous or immoral to the relevant marketplace, which is (further alternatively) either the Internet, or the adult oriented portion of the Internet. Cybernet respectfully requests that Cybernet’s Mark proceed to registration on the Principal Register. Once such has been achieved, if anyone wishes to contest the registration, the opposition period will provide ample opportunity to do so.

**WESTON, GARROU, DEWITT & WALTERS**



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