

ESTTA Tracking number: **ESTTA144036**

Filing date: **06/04/2007**

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

Proceeding	78680513
Applicant	CyberNet Entertainment
Applied for Mark	FUCKINGMACHINES
Correspondence Address	Marc J. Randazza Weston, Garrou, DeWitt & Walters 781 Douglas Avenue Altamonte Springs FL 32714, FL 32714 UNITED STATES mrandazza@firstamendment.com
Submission	Appeal Brief
Attachments	In Re Cybernet - Brief of Appellant.pdf (22 pages)(417344 bytes) Exhibit A - Fuckingmachines Appeal - Final.pdf (21 pages)(302172 bytes)
Filer's Name	Marc John Randazza
Filer's e-mail	mrandazza@firstamendment.com
Signature	/Marc John Randazza/
Date	06/04/2007

**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

TABLE OF CONTENTS

PAGE

I. Table of Authorities.....ii

II. Introduction.....1

III. Statement of Facts.....1

IV. Argument

A. As a factual matter, America no longer finds “fucking” to be immoral or scandalous.....6

B. The Relevant Marketplace.....8

 1. The Internet community tolerates “fuck” more than other segments of society.....9

 2. The further narrowed relevant marketplace would not find the mark to be immoral or scandalous.....12

C. The Unconstitutionality of 2(a) as Applied.....15

 1. The Examiner’s determination is a content-based restriction on expression.....15

 2. In light of *Bad Frog Brewery* and *Alameda Books* the Examiner’s determination must fail.....17

V. Conclusion.....20

TABLE OF AUTHORITIES

CASES:	PAGE NOS.:
<i>ACLU v. Gonzalez</i> ,..... 2007 U.S. Dist. LEXIS 20008 (E.D. Pa. 2007)	14
<i>Action for Children's Television v. FCC</i> ,..... 852 F.2d 1332 (D.C. Cir. 1988)	9
<i>Bad Frog Brewery, Inc. v. New York States Liquor Authority</i> ,..... 134 F.3d 87 (2d Cir. 1998)	13, 14
<i>Bell Laboratories, Inc. v. Colonial Products, Inc.</i> 644 F. Supp. 542 (S.D. Fla. 1986)	8
<i>Bolger v. Youngs Drug Prods. Corp.</i> ,..... 463 U.S. 60, 71 n.20 (1983)	14
<i>Central Hudson Gas & Electric Corp. v. Public Service Comm'n of New York</i> 447 U.S. 557 (1980)	14
<i>City of Los Angeles v. Alameda Books</i> ,..... 535 U.S. 425 (2002)	14-17
<i>Cohen v. California</i> ,..... 403 U.S. 25 (1971)	1
<i>Connection Distrib. Co. v. Gonzalez</i> 2006 LEXIS 24506 (N.D. Ohio 2006)	16
<i>Connection Distrib. Co. v. Reno</i> ,..... 46 Fed. Appx. 837 (6th Cir. 2002)	16
<i>Dr. John's Inc. v. City of Roy</i> ,..... 465 F.3d 1150 (10th Cir. 2006)	16
<i>Edenfield v. Fane</i> ,..... 507 U.S. 761, 770-71 (1993)	14
<i>Free Speech Coalition v. Gonzalez</i> 2007 LEXIS 24389 (D. Colo. 2007)	16
<i>Free Speech Coalition v. Gonzalez</i> ,..... 406 F.Supp. 2d 1196 (D. Colo. 2005)	16
<i>Greater New Orleans Broad. Ass'n. v. United States</i> ,..... 527 U.S. 173, 188 (1999)	14
<i>Greyhound Corp. v. Both Worlds Inc.</i> ,.....	4

6 U.S.P.Q.2d 1635 (TTAB 1988)	
<i>Industry Guidance on the Commission’s Case Law Interpreting</i>	9,10
<i>18 U.S.C. §1464 and Enforcement Policies Regarding Broadcast Indecency, Policy Statement,</i> <i>16 FCC Rcd 7999, 66 Fed Reg 21984 (2001)</i>	
<i>Infinity Broadcasting Corporation of Pennsylvania</i> ,.....	9
MEMORANDUM OPINION AND ORDER, 2 FCC Rcd 2705 (1987)	
<i>In re Cal. Innovations, Inc.</i>	12
329 F.3d 1334 (Fed. Cir. 2003)	
<i>In re Complaints Against Various Television Licensees</i>	9
<i>Regarding Their Broadcast on November 11, 2004, of the ABC Television Network's Presentation</i> <i>of the Film "Saving Private Ryan",</i> No. EB-04-IH-0589, 2005 FCC LEXIS 1268, at 1 (Fed. Comm. Comm'n Feb. 28, 2005)	
<i>In re Hershey</i> ,.....	5
6 USPQ2d 1470 (TTAB 1988)	
<i>In re Hines</i> ,.....	10
32 U.S.P.Q.2d 1376 (TTAB 1994)	
<i>In re Mavety Media Group Ltd.</i> ,.....	2,3,5,17
33 F.3d 1367 (Fed. Cir. 1994)	
<i>In re McGinley</i> ,.....	4,11-14
660 F.2d 481 (C.C.P.A. 1981)	
<i>In re Thomas Laboratories, Inc.</i> ,.....	3
189 USPQ 50 (TTAB 1975)	
<i>In re Thomas H. Wilson</i> ,.....	10
57 U.S.P.Q.2D (BNA) 1863 (TTAB 2001)	
<i>In re Wilcher Corp.</i>	2
40 USPQ2d 1929 (TTAB 1996)	
<i>M2 Software, Inc. v. M2 Communs., Inc.</i> ,.....	8
450 F.3d 1378 (Fed. Cir. 2006)	
<i>Pacifica Foundation</i> ,.....	9,10
56 FCC 2d 94 (1975) aff’d sub nom. <i>FCC v. Pacifica Foundation</i> , 438 U.S. 726 (1978)	
<i>Panola Land Burgers Assn. v. Shuman</i> ,.....	11
762 F.2d 1550 (11th Cir. 1985)	
<i>PC Club v. Primex Techs., Inc.</i> ,.....	8
32 Fed. Appx. 576 (Fed. Cir. 2002)	

<i>Reno v. ACLU</i> ,.....	9
521 U.S. 844 (1997)	
<i>Renton v. Playtime Theatres Inc.</i> ,.....	15
475 U.S. 41 (1986)	
<i>Rubin v. Coors Brewing Co.</i> ,.....	14
514 U.S. 476, 487 (1995)	
<i>Simon & Schuster v. N.Y. State Crime Victims Bd.</i> ,.....	13
502 U.S. 105 (1991)	
<i>University of Georgia Athletic Association v. Laite</i> ,.....	8
756 F.2d 1535 (11th Cir.1985)	
<i>Utah Licensed Bev. Ass'n v. Leavitt</i> ,.....	14
256 F.3d 1061, 1065 (10th Cir. 2001)	

OTHER AUTHORITIES:

Sari Eitches, <i>Sex on Tuesday: In Love We Lust</i> , DAILY CALIFORNIAN, Tuesday, February 15, 2005 found at http://www.dailycal.org/sharticle.php?id=17635	7
Llewellyn Joseph Gibbons, <i>Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(A) Trademark Law after Lawrence v. Texas</i> , 9 MARQ. INTELL. PROP. L. REV. 187.....	2
Eric Vanatta, <i>The F-Motion</i> , 21 CONST. COMMENT. 285 (2004).....	7

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.”¹ 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.

¹ 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 A², 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.)

² 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.”³ 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

³ 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).

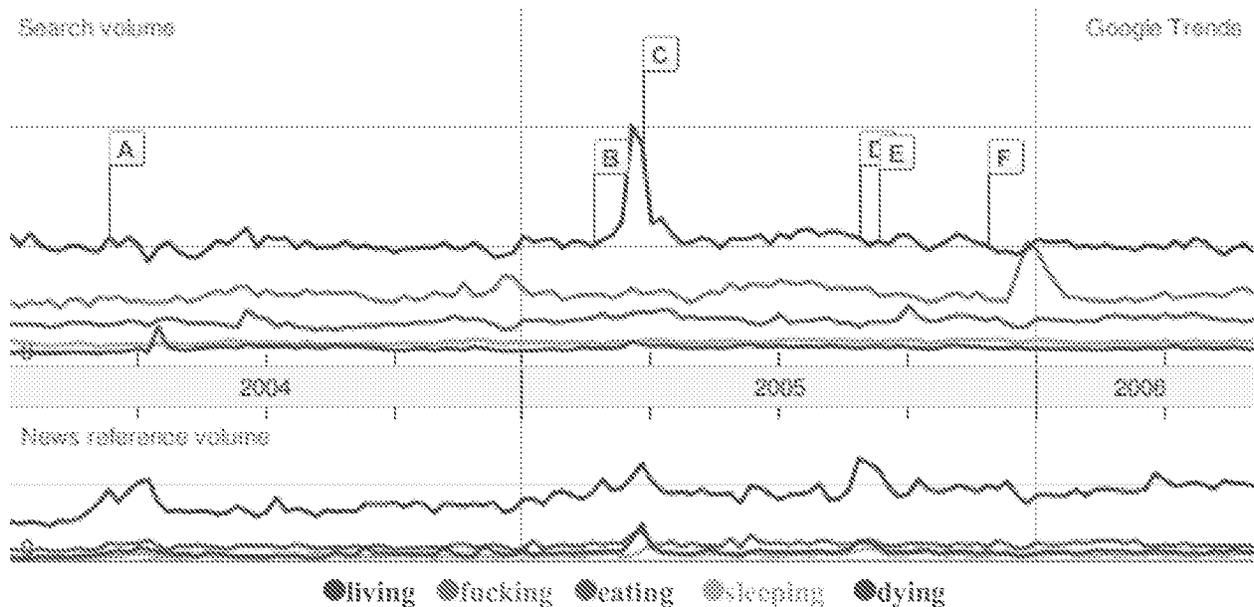
This is truly disturbing. Following the Examiner's reasoning would mean that unwritten and unspoken policies trump the Constitution, decisions of the Federal Circuit, decisions of the TTAB, and facts. Do we exist in a nation of laws, or of “unspoken and unwritten policies?” The Examiner may not evade 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.

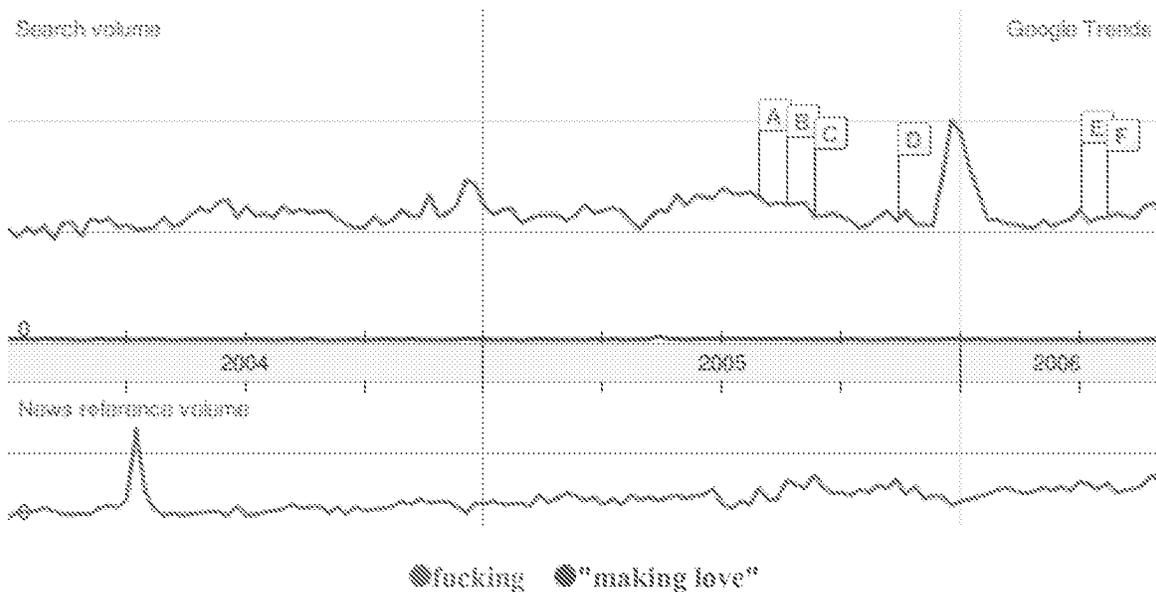
The Board will find that “fuck” is even more accepted on the Internet than in the terrestrial world.

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,”⁴ 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.”⁵ See also ROA at 2-12.

⁴ 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>.

⁵ 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.⁶ 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

⁶ 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 “indecent 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.⁷ 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.

⁷ 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 2-12.⁸

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

⁸ 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.

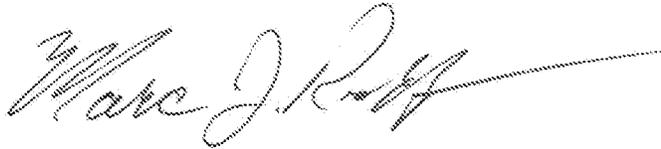
Cybernet has already demonstrated that the mark would not be “shocking to the sense of truth, decency, or propriety, or call out for condemnation” unless the control group was out of touch with contemporary society. See ROA at 2-12. The mark *may* be impolite. However, it has been shown that the mark 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



Marc J. Randazza
Florida Bar No: 625566
Mass. Bar No: 651477
781 Douglas Avenue
Altamonte Springs, Florida 32714
(407) 389-4529 (phone)
(407) 774-6151 (fax)
www.FirstAmendment.com
Attorney for Appellant

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	Cybernet Entertainment, LLC
Mark	Fuckingmachines
Serial Number	78/680513
Examining Attorney:	Michael Engel
Law office	107

AMENDMENT AND RESPONSE TO OFFICE ACTION

ACTION

This Amendment and Response to Office Action is offered in reply to the Office Action taken on February 22, 2006 regarding Serial Number 78/680513.

AMENDMENT TO APPLICATION

Please delete the current description of goods and services in International Class 41 and replace it with the following:

Entertainment, instruction, and commentary of an erotic/sexual nature, created by and for adults only, presented in images, recorded audio, recorded video, transmitted over the internet a website 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.

AMENDMENT OF SPECIMEN

Applicant responds to the examiner's finding that the original specimens were not acceptable by submitting substitute specimens for the mark "**fuckingmachines.**" These substitute specimens are attached as **composite Exhibit A**. A Declaration in support of these substitute specimens is attached as Exhibit B.

RESPONSE TO OFFICE ACTION

One man's vulgarity is another man's lyric

A. Introduction

The particular online publication that the Application seeks to protect, "Fuckingmachines.com" (with the trademark registration applied for) constitutes protected speech within the meaning of the First Amendment to the United States Constitution.

The blanket theme of the rejection is the examiner's statement:

"Fucking" is an offensive and vulgar reference to the act of sex.

The Applicant respectfully challenges this characterization of the word "fucking" and its allegedly "offensive and vulgar" root: "fuck." *Fuck* means literally "to copulate."¹ Nevertheless, this much-maligned four-letter word has no intrinsic meaning.² *Fuck* play a role as a figurative term, for example, "to fuck" can also mean "to deceive."³ It is a word of force that can assist us in our expressions of joy when used as an infix, as in *abso-fucking-lutely*⁴ *Fuck* helps us express rage when we scream "fuck you" at a football referee, or at a motorist who has just cut us off in traffic. *Fuck* can help us express pain, as it is quite frequently the first thing out of most men's

¹ See Alan Crozier, *Beyond the Metaphor: Cursing and Swearing in Ulster*, in MALEDICTA X, at 115, 122 (1988-89).

² Christopher M. Fairman, *Fuck*, CENTER FOR INTERDISCIPLINARY LAW AND POLICY STUDIES WORKING PAPER SERIES, March 2006 at page 10.

³ *Id.*

⁴ For example, "Do you want some free Superbowl tickets? – *absofuckinglutely!*"

mouths when they strike their thumb (accidentally) with a hammer. *Fuck* is a vehicle for our disappointment, when we see that our report card is not as good as we had hoped, or when our significant other is late for dinner, or leaves us all together. *Fuck* is an old friend, who can always make us laugh. “This girl's fit for a strait-jacket. I mean she's fucked three ways to the weekend. But you know what, Father? I dig it!”⁵

How many times did we double over in laughter as children when we heard Eddie Murphy call someone a motherfucker? If the undersigned is dating himself, then substitute Lenny Bruce, Dave Chappelle, or Carlos Mencia. The bottom line is, if you live in America and you haven't laughed at the word “fuck,” you probably have no sense of humor – and you certainly are not in the mainstream.⁶ It would be pretty *fucked up* if the most easily offended fringe of society dictated “morality” for the rest of us.

Fuck (if we accept the Examiner's initial determination) is *an offensive and vulgar reference to the act of sex*. However, it can also be a reference to playful sex, used by even the most proper women to describe their favorite pair of shoes as “fuck me boots” or “fuck me heels.”⁷ In fact, a Google search for these terms (with and without hyphens) reveals a staggering number of personal blogs, written by young women, who brag about their “fuck me shoes.”⁸ To these women, it appears that “fuck” is neither vulgar nor offensive, but empowering.

⁵ *Memorable Quotes from Wedding Crashers*, <http://www.imdb.com/title/tt0396269/quotes>.

⁶ The website <http://www.fuckfunny.com/> has a collection of “fuck jokes” that are so hackneyed that they aren't even funny anymore, but schoolchildren nation wide will laugh at them every year, thinking they were the first to hear them.

⁷ See, e.g., Lynn Yaeger, Elements of Style Frill Seeking Garters, Thongs, and Other Hot Topics, Village Voice, February 10th, 2003 *found at* <http://www.villagevoice.com/nyclife/0307.yaeger.41815.15.html> (“With this saucy frock Krysi is wearing a pair of super-high-heeled open-toed \$350 Agent Provocateur pumps that the store calls mini-peeps but that in the 1970s were know as Joan Crawford fuck-me pumps.”).

⁸ <http://the-hwop.tripod.com/blog/> (“I like all the seasons, when they start. But I am definitely over summer now. And last year, winter was kind of a joke, and that pissed me off, even if it turned out to be a good thing that I could wear a skirt and a tank top (and my fuck-me shoes) on Christmas Day.”); <http://blog.myspace.com/index.cfm?fuseaction=blog.view&friendID=46413915&blogID=153993224> “I finally

Fuck is, of course, at home in our bedrooms. Many normal, healthy, and happy Americans will gaze at each other with “fuck me eyes,”⁹ or as the movie *Wedding Crashers* put it, “eye fuck” each other.¹⁰ (Memorable Quotes from *Wedding Crashers* is attached as Exhibit C).

Men and women use “fuck” to express passion, desire, and even love. When interviewed about her empowering experience with erotic modeling, one model (a feminist and a lesbian) commented that the mood she was searching for was to communicate the thought, “Love me, fuck me, I am beautiful, I am yours.”¹¹ Perfectly healthy people consider the act of a woman whispering in her partner’s ear, “I want you to fuck me” as anything but vulgar.¹² “Fuck me”¹³ or even “fuck me harder”¹⁴ could hardly be held to be offensive or vulgar when expressed in the spirit of seduction and not in the spirit of insult or degradation.

bought my first pair of fuck-me boots. You know, fuck-me boots -- knee high, black heeled boots. Now I've got fuck-me shoes (gold, strappy sandals with 4-inch heels), but I've never been able to find of boots before because my calves were always too fat. Today, I hit pay dirt, however, knee-high pleather boots that fit over my fat calves (OK, I'm sure my weight loss helped too). I am in ecstasy. I swear to God I almost orgasmed right there in the store. My only concern is that it's not the appropriate season to wear them and a mini-skirt out tomorrow night. I'll probably do it anyway."); <http://blog.myspace.com/index.cfm?fuseaction=blog.view&friendID=17394243&blogID=147191502> (“Fuck me shoes, I love them so much!!!”); <http://bananascabana425.blogspot.com/2006/08/these-are-few-of-my-favorite-things.html> (“Girls can’t have too many shoes, and these are the ones I adore....Janilyn purple fuck-me shoes I wore with the purple Aranaz clutch to Donna's wedding... Janilyn black fuck-me shoes classic black leather patent i foxify jeans with ... Charles & Keith pink-brown fuck-me shoes very dainty, too dainty for me but what the hell 8) VNC green-and-gold corset fuck-me shoes unbelievable, why did i get this??? ... Nine West pink snakeskin fuck-me shoes I wore at CJ's wedding 11) Unisa brown-and-gold fruity fuck-me shoes i salivated over last holiday.”).

⁹ <http://www.urbandictionary.com/define.php?term=fuck+me+eyes>

¹⁰ *Memorable Quotes from Wedding Crashers*, <http://www.imdb.com/title/tt0396269/quotes> (*John Beckwith*: Don't waste your time on girls with hats. They tend to be very proper. *Jeremy Grey*: Yeah? Well, the proper girl in the hat just eye-fucked the shit out of me.).

¹¹ Rachel Kramer Bussel, *Full-Frontal Photo Shoots - The doubts, fears, and very personal rewards of posing in the buff*, VILLAGE VOICE, Aug. 12, 2005. Found at <http://www.villagevoice.com/people/0533,bussel,66850,24.html>.

¹² See <http://tinyurl.com/nucsm> (this is a reduction of a lengthy URL for the search “whispered, I want you to fuck me,” which turned up 14,000 times on Google. The Examiner may review

¹³ A Google search for “She whispered ‘fuck me’” turns up 84,000 individual web pages with this very specific phrase.

¹⁴ See, e.g., *The Kinky Librarian*, THE POSTMODERN COURTESAN found at <http://www.postmoderncourtesan.com/archives/000623.php>.

Even if the term were “offensive” or “vulgar,” which the Applicant denies, these are not the standards for rejection under section 2(a).¹⁵ In order to deny registration, the Examiner must establish that the mark comprises immoral, deceptive, or scandalous matter.¹⁶

Prior to presentation of the Applicant’s arguments in full, the Applicant would like to grant the podium to Justice Harlan, a revered member of the United States Supreme Court, writing for the majority in the landmark Supreme Court case, *Cohen v. California*.¹⁷

*[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.*¹⁸

What can better illustrate our profoundly held national value that ideas are to be nurtured and protected than Justice Harlan’s tribute to tolerance and moral neutrality? The Applicant asks that the Examiner understand what is at stake in this seemingly humble case. This is not a case about the word “fucking” so much as it is a case about tolerance, evolution, and expression.

With that established, the Examiner must step backward from his own feelings about this maligned word, step backward from any baggage that it may carry for him, and step into the light, warmth, and beauty of our Constitution and our rule of law. Once the Examiner is there, the Examiner will agree that it is his duty to reverse his initial determination, and to permit the Mark to be published for opposition.

B. The Applicant, and the Applicant’s socio-political perspective

The Examiner’s initial determination misinterprets the Applicant’s intention.

Though “FUCKING” has other meanings, the nature of applicant’s services

¹⁵ 15 U.S.C. § 1502 (providing that registration of a trademark may be refused if it “consists of or comprises immoral, deceptive, or scandalous matter.”).

¹⁶ There is no allegation of deceptiveness, therefore this will not be addressed.

¹⁷ 403 U.S. 25 (1971)

¹⁸ *Id* at 23.

clearly indicate that the sexual meaning of the word was intended.

The Applicant proposes that the Examiner's determination as to the Applicant's intent is irrelevant. The use of the word is multi-meaninged, but whether the sexual context was intended has no bearing upon the Application, nor upon this Appeal.

Applicant believes that the human body is a thing of beauty to be celebrated, and Applicant contends that sexual expression transmits an important message of eroticism, body acceptance, and sexual freedom. Additionally, Applicant contends that the female orgasm is frequently ignored in erotica, and that traditional erotica has often displayed women as objects to be used, much like machines, for the sexual gratification of men. Applicant's publication uses machines to bring about the female orgasm in a number of ways, by use of machines specifically designed for this purpose. These machines have the ability to bring formerly non-orgasmic women to the point of sexual ecstasy, and thus release them from lifetimes of sexual dissatisfaction and repression. Applicant's publication demonstrates these devices and techniques for the enjoyment and instruction of its subscribers, and its title plays upon the imagery and terms in a purposeful manner.

This erotic message has a political component as well as its obvious sensual and instructional components, as the issue of governmental regulation of human sexuality is an ongoing matter of public concern and discourse, as is the suppression of female sexuality.

The erotic expression offered by Applicant (and sought to be protected as a legitimate online publishing business) is not intended to be, nor is it, obscene, as measured by contemporary community standards. Applicant does not intend this expression to appeal to any prurient interest. Applicant intends its works of expressive art to be expressions of eroticism,

instructional, and demonstrative of techniques for the achievement of orgasm, as a statement of criticism toward repressive sexual attitudes; as well as an expression of acceptance of sexual practices that are, while outside the traditionally-defined “mainstream,” are nonetheless enjoyed, experienced, and well within the bounds of the sexual preferences of a significant number of people in the United States and worldwide.¹⁹

Applicant’s works communicate a message that challenges the opposite message that is put forth by puritanical and repressive elements of society. Applicant’s choices are as much an act of political resistance as they are works of art and erotica.²⁰ Applicant’s publication challenges outdated, puritanical notions that are rife with the repressive intent of subjugating women by denying them expressions of messages designed to celebrate and affirm the power of female sexuality.²¹ Some cultures engage in physical mutilation of girls in order to control the female orgasm, and thus to control women in general. Our culture, while perhaps more refined in its methods, seeks a no less ignoble goal. Fucking Machines is part of the counterweight to these

¹⁹ For example, the “sybian,” one of the “Fucking Machines” featured in the Applicant’s collection frequently appears on “The Howard Stern Show.” On this show, Cameron Diaz, Jenna Jameson, and Carmen Electra, are well-known celebrities who have opted to ride the Sybian while on-camera. See Howard Stern, *The Girls of The Sybian*, (photo gallery) found at <http://www.howardstern.com/galleries.hs?g=37> last visited August 14, 2006; Meta Café, *Carmen Electra Rides The Sybian For Howard Stern*, (dialogue includes discussion of Cameron Diaz and Jenna Jameson riding the sybian on the show) found at <http://tinyurl.com/prryz> last visited August 14, 2006. URL reduced from http://www.metacafe.com/watch/104724/carmen_electra_rides_the_sybian_for_howard_stern/ for convenience of the reader. Additionally, as of August 14, 2006, there were approximately 160,000 web pages noting the use of the Sybian on the Howard Stern show alone. See <http://tinyurl.com/f84y7> last visited August 14, 2006, and reduced from http://www.google.com/search?client=firefox-a&rls=org.mozilla%3AenUS%3Aofficial_s&hl=en&q=sybian+%22howard+stern%22&btnG=Google+Search.

²⁰ See generally, Karen D. Pyke, *Class-Based Masculinities: The Interdependence of Gender, Class, & Interpersonal Power*, 10 GENDER & SOC’Y 527 (1996) (“Conventional theoretical perspectives on power . . . view microlevel power practices as simply derivative of macrostructural inequalities and overlook how power in day-to-day interactions shapes broader structures of inequality.”); Catharine A. Mackinnon, TOWARD A FEMINIST THEORY OF THE STATE 190-91 (1989) (“Privacy doctrine is most at home at home, the place that women experience the most force, in the family For women the measure of the intimacy has been the measure of the oppression This is why feminism has seen the personal as the political.”); Susan Moller Okin, Justice, GENDER, AND THE FAMILY 110-33 (1989) (discussing the close relationship between the supposedly distinct public and domestic spheres and the public/domestic distinction’s impact on feminist politics and theory).

²¹ C.f. Fuck Me Feminism, the Double-Edged Sword found at <http://saucebox.almeidaisgod.com/?p=76>

forces.

As a form of protected commercial speech, Applicant has a clear legal right to offer or engage in expressive activity of this nature, for the purpose of celebration, communication, and socio-politically revolutionary expression. If this challenge to a puritanical mentality toward sexual conduct, expression, and pleasure is threatening to some – this is to be expected. However, this threat should not be misinterpreted as “immoral” or “scandalous.” Nor should this “heckler’s veto” be granted to place Applicant in a disfavored state with respect to the benefits the government confers upon the Applicant and similarly situated businesses and persons. It has long been held that the government may not treat expression differently because of disagreement with the underlying message. It is a less entrenched, but equally controlling, legal principle that laws based on “morality” are no longer permissible absent the government meeting a heavy burden.²²

B. America no longer finds “fucking” to be immoral or scandalous.

The Examiner will note that the mark must be examined in the context of the current attitudes of the day. See In re Mavety Media Group Ltd., 33 F.3d 1367, 31 USPQ2d 1923 (Fed. Cir. 1994). 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.”).

The fact is that when Section 2(a) was written, it was a different day and age. In 1905, matters of public morality were still reeling from neo-Puritanical Victorian influence. The moral values and mores of contemporary society certainly tolerate “fucking” to a great level.

²² See Lawrence v. Texas, 539 U.S. 558 (2003).

In 1971, in Cohen v. California, Mr. Paul Cohen entered a Los Angeles courthouse wearing a jacket emblazoned with the words “FUCK THE DRAFT.” His subsequent arrest by offended police officers led to the determination that “FUCK THE DRAFT” was protected speech, and Mr. Cohen could not be prosecuted for it.

Although the rise of “fuck” from a word reserved for use in longshoremen’s taverns and houses of ill repute was already well under way in 1971, Mr. Cohen’s case demonstrates that even the highest court in the land, in a far more conservative age, did not consider it to be so scandalous or immoral that it deprived Mr. Cohen of his right to wear this word emblazoned on his jacket in a courthouse.

Since then, “fuck” has gotten closer and closer to the dinner table, and certainly should no longer be forced to sit outside in the rain, while we all say it, use it, laugh at it, whisper it, and embrace it.

1. American Popular Culture not Only Tolerates, but it Embraces “fuck”

In the year 2006 (in fact well before) the fact is, “fucking” can not be considered to be scandalous or shocking to very many people anymore. Our President, an avowed Born-Again Christian uses fuck liberally.²³ And the Vice President’s use of “fuck” is a common butt of late night comedy.²⁴ Senator John Kerry said, in an interview with *Rolling Stone*, “Did I expect George Bush to fuck [The Iraq War] up as badly as he did? I don't think anybody did.”²⁵

Howard Stern, dogged for years by the FCC and its attempts to impose its unelected

²³ <http://www.time.com/time/archive/preview/0,10987,1101030331-435968,00.html>;
<http://www.informationclearinghouse.info/article2835.htm> (Stories detailing Bush saying “Fuck Sadaam, we’re taking him out).

²⁴ <http://www.washingtonpost.com/wp-dyn/articles/A3699-2004Jun24.html> (“go fuck yourself”).

²⁵ *First Stop, Iraq*, TIME Magazine, <http://www.time.com/time/archive/preview/0,10987,1101030331-435968,00.html>; *Bush Or Kerry? Look Closely And The Danger Is The Same*, NEW STATESMAN, <http://www.zmag.org/content/showarticle.cfm?ItemID=5083>.

board's impression of "decency" found himself under constant attack in recent years. As a result, Stern left terrestrial radio for the freedom of satellite radio.²⁶ (Lest the Examiner point to the number of FCC complaints as an indication that Stern's antics were disfavored by a large number of people, Stern never uttered "fuck" on terrestrial radio, and his "indecent" speech was usually complained of by organized phone banks.)²⁷

Interestingly enough, with Stern's departure, his replacements have seen marked drops in listenership. At the same time, Stern's move to Sirius Satellite Radio has brought millions of new subscribers to the medium alongside ubiquitous use of the word "fuck."²⁸ See Exhibit D.

Lest the Examiner begin to believe that Stern, or comedians have a monopoly on the word "fuck" on Satellite Radio, the band Buckcherry recently recorded "Crazy Bitch," which they did not intend to release as a single.²⁹ However, once the unedited song and its lyrics that include "You're crazy but I like the way you fuck me!" reached XM and Sirius, it became the one of Satellite Radio's most requested songs.³⁰ See Exhibit E for the song lyrics.

When it comes to entertainment, we could be accurately described as a "fuck tolerant society." Samuel L. Jackson, Joe Pesci, Robert Diniro, and Al Pacino, are four of America's most beloved actors, and their gratuitous use of the word "fuck" is hardly a cause of national shame, but these quotes have made these actors iconic.

- *"This is paradise, I'm telling you, this town is like a great big pussy*

²⁶ See Clay Calvert, *The First Amendment, the Media, and the Culture Wars: Eight Important Lessons from 2004 about Speech, Censorship, Science and Public Policy*, 41 CAL. W. L. REV. 325, 357 (2005).

²⁷ Id at 328-55 (discussing the organized assault on free speech by small groups).

²⁸ See *Sirius Cash: Lots of stock for shock Jock*, NEWSDAY, Jan. 6, 2006, at A13; *Playing it by ear: Howard Stern's Sirius debut*, USA TODAY, (Jan. 9, 2006) found at http://www.usatoday.com/life/people/2006-01-09-stern-recap_x.htm

²⁹ <http://theedge.bostonherald.com/musicNews/view.bg?articleid=152294&srvc=edge;>
<http://buckcherry.com/LitUp/showflat.php?Number=14348> .

³⁰ <http://www.radiorevolt.com/comment.php?comment.news.502> ;
<http://www.roadrun.com/blabbermouth.net/news.aspx?mode=Article&newsitemID=49273>

- *just waiting to get fucked.*” - Al Pacino in *Scarface*
- “I make you laugh, I’m here to fucking amuse you?” – Joe Pesci in *Goodfellas*
- “Listen you fuckers you screwheads, here’s a man who would not take it anymore, a man who stood up against the scum, the cons, the dogs, the filth, the shit. Here is someone who stood up.” – Robert DeNiro in *Taxi Driver*.

And who could possibly live and breathe in America, and not be able to identify this iconic scene from *Pulp Fiction*?

Jules: Does [Marsellis Wallace] look like a bitch?

Brett: What?

Jules: *Shoots Brett in the shoulder* Does he LOOK like a bitch?!

Brett: No!

Jules: Then why’d you try to fuck him like a bitch, Brett?

The Movie *Casino* features the word “fuck” 398 times, in a film that is 178 minutes long, or 2.24 “fucks per minute.” This isn’t the undersigned’s terminology. See *List of Films that Most Frequently use the Word Fuck*, http://en.wikipedia.org/wiki/List_of_films_ordered_by_uses_of_the_word_%22fuck%22 (attached as Exhibit F). *Jay and Silent Bob Strike Back*, 248 fucks, 2.38 fucks per minute. *Platoon*, a mere 159 fucks, or 1.56 fucks per minute. *White Men Can’t Jump*, 141 fucks, and 1.21 fucks per minute. A full list of the films that most frequently use “fuck” is attached as Exhibit G. This is not limited to the big screen, nor is it limited to male-oriented media. *Sex and the City*, a critically acclaimed HBO series uses the word with great artfulness in a post-feminist manner.

I was once with a guy the size of one of those little miniature golf pencils. I couldn’t tell if he was trying to fuck me or erase me.

Sex and the City, Episode 12, “O Come all Ye Faithful.” See Exhibit H.

As noted above, women are certainly making empowered usage of the word “fuck,” (see discussion of “fuck me shoes” *supra*). “Fuck buddy,” is an almost exclusively female term for a

“casual relationship,” or what men might refer to as a “booty call.” Again, *Sex and the City* provides an excellent illustration:

*Carrie: A fuck buddy is a guy you probably dated once or twice and it didn't really go anywhere, but the sex is so great you sort of... keep him on call.*³¹

This brief could go on for thousands of pages, if the undersigned were prepared to burden the examiner with months of reading on the subject. Suffice to say that the Examiner should take notice that “fuck” is accepted, and even beloved. Perhaps if you sent out a survey to your local community asking if they love the word “fuck,” you might get one opinion, but Americans vote with their wallets. We buy subscriptions to Satellite Radio by the millions and then request “Crazy Bitch” again and again. We spend millions of dollars at the movies, and aside from a very small minority, we don’t mind if the word “fuck” is tossed about with great aplomb, and “fuck” in a movie certainly never cost anyone an Oscar. *Sex and The City* is more than a TV show, it is a phenomenon among young professional neo-feminist women. Yet nobody is scandalized by *Women are for friendships, men are for fucking*.³²

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.”³³ Therefore, even if the Examiner 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

³¹ <http://www.sexandthecityquotes.com/episodes/the-fuck-buddy-quotes.html>

³² *Sex and the City*, Episode 30, “Ex and the City.” See Exhibit H.

³³ 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”)

be dispelled above), then the Examiner could simply look at the *relevant* marketplace – instead of the marketplace as a whole.

This approach is long-embraced in Trademark Law. See 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”). And, this approach is in line with other forms of regulation of expression. For example, in Ginsburg v. New York, the United States Supreme Court affirmed the conviction of a shopkeeper who sold pornography to a child.³⁴ However, this case embraced the notion that the marketplace in general (including children) could tolerate a bar on certain types of expression, while the marketplace consisting only of adults would not tolerate such restrictions.³⁵

This very same perspective was embraced by Reno v. ACLU.

We are persuaded that the CDA lacks the precision that the First Amendment requires when a statute regulates the content of speech. In order to deny minors access to potentially harmful speech, the CDA effectively suppresses a large amount of speech that adults have a constitutional right to receive and to address to one another. That burden on adult speech is unacceptable if less restrictive alternatives would be at least as effective in achieving the legitimate purpose that the statute was enacted to serve.

With this in mind, if the Examiner is uncomfortable determining that we have, as a nation, embraced “fuck,” then the Examiner may narrow the relevant marketplace to either the internet, or to the adult internet.

1. The internet community tolerates “Fuck” more than other segments of society.

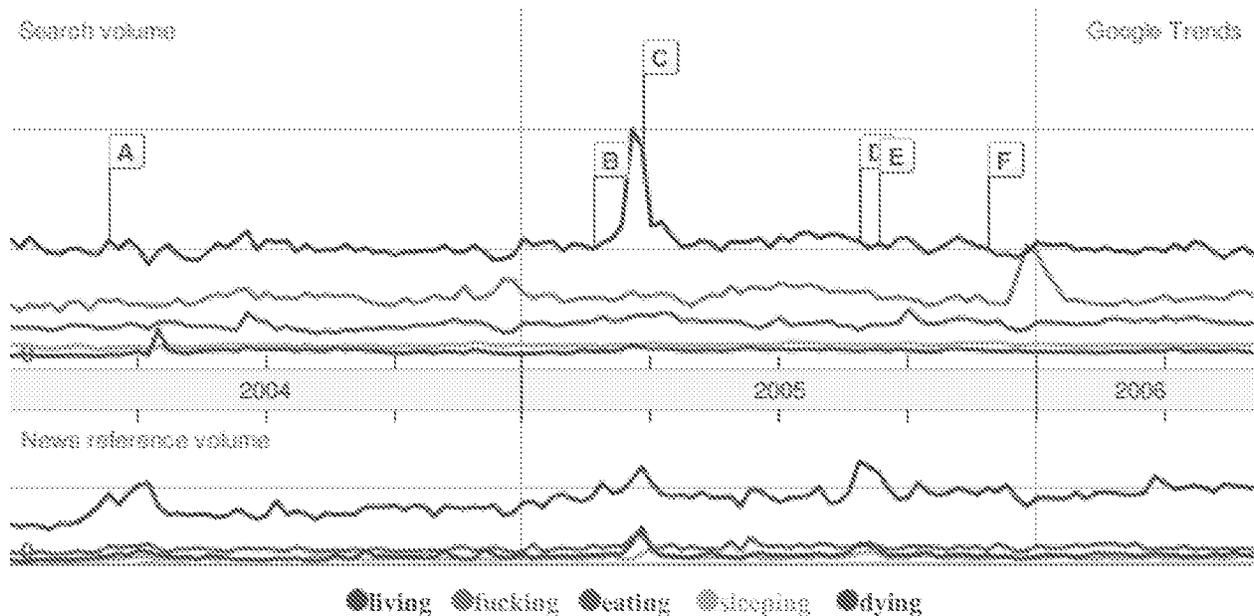
In the alternative, if the Examiner would like to narrow the study from America in

³⁴ 390 U.S. 629 (1968).

³⁵ Id at 631.

general to simply the American internet user, the Examiner 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.”³⁶ See Exhibit I.



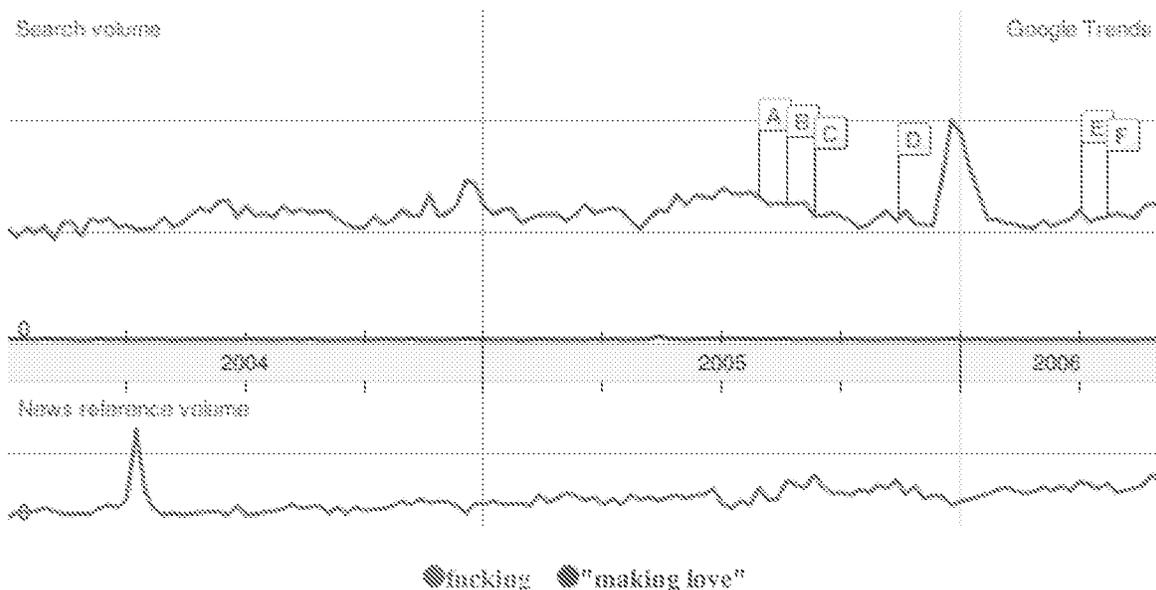
If the examiner does not have the benefit of seeing the graph in color, the lines are listed in top to bottom order, with “living” as the top line, and “dying” at the bottom.

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 Examiner 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 the Applicant would not be incorrect in

³⁶ This appears to be perhaps the result of some holiday cheer.

stating that “fucking” is not as scandalous or shocking as some may believe – especially not in the internet context.

Lest the Examiner believe that these queries are out of context, the Applicant provides the following – a comparison between “fucking” and “making love.” See Exhibit J.



While The Daily Californian asked its readers what the difference is between “fucking” and “making love,”³⁷ 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 quantify this age old question – 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.”³⁸ This does not indicate that we find

³⁷ 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>.

³⁸ These numbers change daily, but the Examiner is invited to conduct a Google search for these terms and count for

“fucking” to be immoral or scandalous anymore – in fact, it seems that we are more uncomfortable with love than with fucking.

All of the above Google trends charts were limited to United States IP addresses – demonstrating that in contemporary America, we appear to be 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.”³⁹

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 the Applicant’s amendment, 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.

Entertainment, instruction, and commentary of an erotic/sexual nature, created by and for adults only, presented in images, recorded audio, recorded video, transmitted over the internet a website 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 the Amendment, the Applicant’s expressive activity is transmitted to a limited marketplace of consumers consisting of an consensual audience, all over the age of 18 years, desirous of receiving and enjoying the message conveyed by works relating to human sexual interest and sensual subtleties.⁴⁰ In order to enter the site, the user must agree to all of the following terms:

himself.

³⁹ 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).

⁴⁰ 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.

1. *I am at least 18 years of age.*
2. *I will not redistribute any material from this site.*
3. *I will not allow any minors to access this site or any material found herein.*
4. *Any material I download from this site is for my own personal use, I will not show it to a minor.*
5. *Sexually explicit material depicting bondage, S/M and other fetish activities is allowed by the local law governing my region.*
6. *I was not contacted by the suppliers of this material and I willingly choose to download it.*
7. *I agree that pictures depicting men or women being penetrated by objects such as vibrators or dildos, is not obscene or offensive in any way. In addition I do not believe that such material could be considered obscene or offensive.*
8. *I have carefully read the above and agree to all of them*

This information is provided for a dual purpose – to demonstrate the fact that the relevant marketplace and channels of trade are constrained by the eight conditions above (hereinafter “the Eight Conditions”) and to demonstrate that this is not a mark that is distributed to a general audience, nor that requires protection outside of the audience and marketplace delineated by the Eight Conditions.

It is well-established that determinations under trademark law hinge upon the definition of the relevant marketplace or “channels of trade.”⁴¹ To enter the channel of trade for the Applicant’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. The relevant marketplace – limited by the description of services – is essentially the “red light district” of the online media world. In that

⁴¹ 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 (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).

realm, websites deal with sexual topics in a graphic and often degrading manner. Women are depicted as being used by men, with an entire genre of adult entertainment (bukkake) devoted to images of men ejaculating on women, often on their faces. This relevant marketplace is a marketplace where scatological humor is found, see <http://www.modestypanel.com/snackorscat/>, alongside scatological pornography (*no citation provided out of respect for the examining attorney, but if the examining attorney wishes to do a Google search for “scat porn,” the Examiner is welcome to*). In the relevant marketplace, a Google search for “urination porn” brings up almost 400,000 web pages devoted to the subject.⁴²

RELEVANT MARKETPLACE CONCLUSION

The fact is that in the United States, “fucking” has lost its sting. However, if the Examiner narrows the relevant marketplace to the internet, then “fucking” is certainly an impotent term. If the relevant marketplace is narrowed further to the world of adult materials, then fucking is downright bland. In Sable Communications v. FCC, the Supreme Court held unconstitutional a complete prohibition on the creation of “obscene or indecent communication” on the grounds that children needed to be protected from hearing such communications. The justification was that this restriction went too far, since it denied adults (the relevant market) access to the communication in order to shield the irrelevant market (children).

Based on the above facts, and following the above-cited authority, the Examiner should find that “fucking” is generally accepted as a non-scandalous term. In the alternative, the Examiner could find that on the internet, “fucking” is not a scandalous or immoral term. And as a fallback position, the Examiner should find that “fucking” is neither scandalous nor immoral in

⁴² <http://www.google.com/search?num=100&hl=en&lr=&client=firefox-a&rls=org.mozilla%3AenUS%3Aofficial&q=urination+porn&btnG=Search>.

the context of the relevant sub-market of online adult media.

THE UNCONSTITUTIONALITY OF 2A

Trade names convey messages about the type, cost and quality of the product or service associated with the mark.⁴³ The fact is, that trademarks propose a commercial transaction, and under long-established Supreme Court precedent, speech that proposes a commercial transaction is “commercial speech” and thus subject to First Amendment protection.⁴⁴ The trademark is a tightly targeted bit of expressive activity that seeks to persuade a potential customer to choose one product over another, either due to the identification of goods or to the communicative element of the trademark itself.

The USPTO’s prohibition of scandalous or immoral marks has been harshly criticized.⁴⁵ Thus far, all USPTO decisions regarding the constitutionality of Section 2(A) rely upon the improperly decided case In re Robert L. McGinley.⁴⁶ 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 constitutionality of restrictive laws based on morality.

McGinley held that since trademark applicants were still free to use the trademarks, then there was no abridgment of speech. However, this reasoning is simply shoddy and unsupported by a vast body of First Amendment jurisprudence. 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

⁴³ See *Friedman v. Rogers*, 440 U. S. 1, 11 (1979).

⁴⁴ *Virginia State Bd. Of Pharmacy v. Virginia Citizens Consumer Council*, 425 U.S. 748, 762 (1976).

⁴⁵ 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).

⁴⁶ 660 F.2d 41 (1981).

Amendment if it imposes a financial burden on speakers because of the content of their speech.”⁴⁷ The authors were still free to write, but were denied the financial benefits of their labors. This appears to completely dispense with the McGinley reasoning.

In Bad Frog Brewery, Inc. v. New York States Liquor Authority,⁴⁸ analyzed a similar issue. 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.

Finally, there can be no clearer authority for the death of Section 2(A) than Lawrence v. Texas.⁴⁹ “The fact a State’s governing majority has traditionally viewed a particular practice as immoral is not a sufficient reason for upholding a law prohibiting the practice.”⁵⁰ “Morality” is no longer a valid reason to confer or deny a governmental benefit – instead the government must articulate a reason why registration of “fuckingmachines” might be harmful, and then apply that reason to the particular circumstances at hand, in a narrow manner. The government has done none of this in this case, nor in any other 2(A) denial.

REQUEST FOR ALTERNATIVE RELIEF

Should the examiner, after reviewing the facts and legal arguments set forth above, still determine that “fuckingmachines” is unsuitable for the Principal Register, the Applicant requests that the Examiner grant the alternative relief of listing this Mark on the Supplemental Register as

⁴⁷ Simon & Schuster v. New York State Crime Victims Bd., 502 U.S. 105, 115 (1991).

⁴⁸ 134 F.3d 87 (2d Cir. 1998).

⁴⁹ 539 U.S. 558 (2003).

⁵⁰ *Id.* at 577.

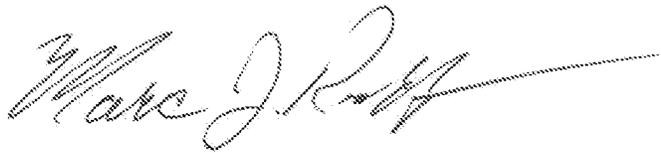
provided for in 15 U.S.C. § 1091; 37 C.F.R. §§ 2.47 and 2.75(a);p TMEP §§ 801.02(b), 815, and 816 *et. seq.*

CONCLUSION

For the reasons set forth above, Applicant holds the position that the proposed mark, “fuckingmachines,” is not 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. The Applicant respectfully requests that the Applicant’s Mark proceed to registration on the Principal Register, or in the alternative, on the Supplemental Register.

Additional evidence is attached as composite exhibit K.

WESTON, GARROU, DEWITT & WALTERS



Lawrence G. Walters
Florida Bar No: 776599
Marc J. Randazza
Mass. Bar No: 651477
Florida Bar No: 625566
781 Douglas Avenue
Altamonte Springs, Florida 32714
(407) 389-4529 (phone)
(407) 774-6151 (fax)
www.FirstAmendment.com
Attorneys for Applicant