From: Lee, Yat Sye (Isadora)

Sent: 7/24/2007 9:19:12 PM

To: TTAB EFiling

CC: Bishop, Leslie; Hayash, Susan; TM Clerical Support Request

Subject: Motion for Remand, SN 78680513 (part 1 of email)

To the TTAB: Attached please find my motion for remand and office action. The 45 attachments of evidence in connection with this matter will be sent in the next few emails, in batches of 15 (due to my mailbox limitations/restrictions). I apologize for any inconvenience.

To TM Clerical Support: Please upload the attached word documents and 45 .jpg images (which will be in the subsequent emails) to TICRS and mail a copy of all to the applicant. Please note that as I will be out of the Office until Tuesday, August 28, please contact Susan Hayash if you have any questions concerning this matter.

Thank you.

Y. Isadora Lee
Trademark Examining Attorney
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Attachment Information:
Count: 2
Files: FM_remand_request.doc, 78680513FM_Action_072407.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/680513

APPLICANT: CyberNet Entertainment

CORRESPONDENT ADDRESS:
Marc J. Randazza
Weston, Garrou, DeWitt & Walters
781 Douglas Avenue
Altamonte Springs FL 32714

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

MARK: FUCKINGMACHINES

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

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Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

TRADEMARK EXAMINING ATTORNEY'S REQUEST FOR REMAND

The trademark examining attorney requests that the Trademark Trial and Appeal Board remand this case to the examining attorney under 37 C.F.R. §2.142(d) for the following reasons:

This file has been re-assigned to the undersigned examining attorney. While reviewing the file for an Appeal Brief before the TTAB (due August 7, 2007), the undersigned discovered that a Section 2(e)(1) refusal should also have been issued, in addition to the maintained and continued Section 2(a) refusal.

Remand of the case is requested in order to permit issuance of a refusal based on Section 2(e)(1), to properly address all issues raised by the application, and to complete the evidentiary record.

If jurisdiction is not restored, the undersigned requests that the date for preparing the Appeal Brief be reset to allow the attorney to properly address all issues raised by the applicant in its Brief.

Respectfully submitted,

/Y. Isadora Lee/
Trademark Examining Attorney
(J. Leslie Bishop, Managing Attorney)
Law Office 107
571-272-3897

Date: July 24, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/680513

MARK: FUCKINGMACHINES

CORRESPONDENT ADDRESS:
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RESPOND TO THIS ACTION:
http://www.uspto.gov/teas/eTEASpageD.htm

GENERAL TRADEMARK INFORMATION:
http://www.uspto.gov/main/trademarks.htm

APPLICANT: CyberNet Entertainment

CORRESPONDENT'S REFERENCE/DOCKET NO:
N/A
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OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE:

The Office has reassigned this application to the undersigned trademark examining attorney.

Upon further review of the application and in addition to all of the substantive issues and informalities raised in the Office Actions dated February 22, 2006 and October 5, 2006, which are incorporated by reference herein, the examining attorney finds that registration must also be refused under Trademark Act Section 2(e)(1) for the reasons provided below. Please note that applicant must respond to all issues raised in this Office Action within six (6) months of the mailing date of this letter. If applicant does not respond within this time limit, the application will be abandoned.

Section 2(e)(1) Refusal

Registration is refused because the proposed mark merely describes a characteristic, purpose, and feature of applicant's services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); TMEP §§1209 *et seq*.

A mark is merely descriptive under Section 2(e)(1) if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP §1209.01(b).

The determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978); *see, e.g.*, *In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (DOC in DOC-CONTROL would be understood to refer to the "documents" managed by applicant's software, not "doctor" as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (CONCURRENT PC-DOS found merely descriptive of "computer programs recorded on disk" where relevant trade uses the denomination "concurrent" as a descriptor of this particular type of operating system). "Whether consumers could guess what the product is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985); *see* TMEP §1209.01(b).

Applicant is seeking registration of the proposed mark, FUCKINGMACHINES for the following services, "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," in International Class 41.

The proposed mark is a combination of the words "fucking" and "machines." As discussed in the earlier Actions, the terms "fuck" and "fucking" are vulgar slang and defined as "have[ing] sexual intercourse with." The term "machine" is defined as "a mechanically, electrically, or electronically operated device for performing a task." The term "fucking machine" is taboo and defined as "an imaginary machine that will simulate sexual intercourse for either sex with great success." See the attached dictionary definitions from www.dictionary.com, *Merriam-Webster's Online Dictionary*, 10th Edition, and *Forbidden American English*, 1995.

When the terms are combined, the resulting meaning and commercial impression are the same as and no less offensive or vulgar than the definitions and commercial impressions of the words taken separately. A mark that combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (holding SUGAR & SPICE not to be merely descriptive of bakery products). However, the mere combination of descriptive words does not automatically create a new nondescriptive word or phrase. *E.*g., In *re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988) (finding GROUP SALES BOX OFFICE descriptive for theater ticket sales services). The registrability of a mark created by combining only descriptive words depends on whether a new and different commercial impression is created, and/or the mark so created imparts an incongruous meaning as used in connection with the

services. Where, as in the present case, the combination of the descriptive words creates no incongruity, and no imagination is required to understand the nature of the services, the mark is merely descriptive. *E.g.*, *In re Copytele Inc*., 31 USPQ2d 1540, 1542 (TTAB 1994); *Associated Theatre Clubs*, 9 USPQ2d at 1662.

A term is merely descriptive if it conveys an immediate idea of the ingredients, qualities, or characteristics of the identified goods or services. *In re Abcor Dev. Corp*., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *Goodyear Tire & Rubber Co. v. Cont'l Gen. Tire, Inc.*, 70 USPQ2d 1067, 1069 (TTAB 2003); *In re TMS Corp. of Ams.*, 200 USPQ 57, 58 (TTAB 1978). Based on these definitions cited above, the proposed mark conveys an immediate idea of the characteristics of the identified services. The proposed mark, "FUCKINGMACHINES" essentially means mechanically, electrically, or electronically operated devices for performing the task of having sexual intercourse with someone.

For the purpose of a Section 2(e)(1) analysis, a term need not describe all of the purposes, functions, characteristics or features of the services to be merely descriptive. *In re Dial-a-Mattress Operating Corp*., 240 F.3d 1341, 1346, 57 U.S.P.Q.2d 1807 (Fed. Cir. 2001). It is enough if the term describes only one significant function, attribute or property. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) ("[A] mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services.") (quoting *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)).

Indeed, as clearly evidenced by applicant's specimen of record, the wording "FUCKINGMACHINES" is merely descriptive of at least one significant feature, purpose, and characteristic of applicant's entertainment services. The specimen consists of a screenshot of a website showing the words in large font: "Welcome to the Machines!" This screenshot features several photographs of various devices or machines to which dildos are attached. Prominently displayed at the top of the page is a photograph of a woman being sexually penetrated from behind by one of these machines. Immediately adjacent to this photograph is capitalized font of the wording: "FUCKINGMACHINES DOING THE HUMANLY IMPOSSIBLE." Moreover, in the title of the webpage appears text describing the erotic content of the website, which reads: "FUCKINGMACHINES! Sex at 350 rpm. Robots gone crazy give women huge orgasms. Machine fucking…" Furthermore, there is a menu bar beneath this text that lists the other pages within the website, the fourth one of which is entitled "Machines." Based on applicant's specimen, it is obvious that the highlights of applicant's services are photographs or images of devices that are having sexual intercourse with women. Thus, the proposed mark merely describes a major feature, purpose, and characteristic of its erotic entertainment services.

Based on the specimen of record and the dictionary definitions, the examining attorney concludes that the proposed mark is merely descriptive of a feature, purpose and characteristic of applicant's erotic entertainment services, which feature photographs of machines that are designed to have sexual intercourse with women. Accordingly,

registration of the proposed mark must be refused under Section 2(e)(1) of the Trademark Act.

The prior refusal under Section 2(a) of the Trademark Act is maintained and continued for the reasons set forth below. 15 U.S.C. §1052(a); 37 C.F.R. §2.64(a)

Refusal Based on Trademark Act Section 2(a)—Maintained and Continued

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*.

The F-word is still offensive to a substantial composite of the general public.

Dictionary evidence alone can be sufficient to satisfy the examiner's burden, where the mark has only one meaning. *In re Boulevard Entertainment, Inc*., 334 F.3d 1336, 1339, 67 USPQ2d 1475, 1478.

When considered within the context of applicant's specimen of record and applicant's recited services, the term "f-ing" can have no other meaning than "have[ing] sexual intercourse with (someone)." See the attached from *The New Oxford American Dictionary*, Second Edition, 2005. As discussed above, no other relevant, non-scandalous meanings of the proposed mark are evident from the record. When the term "machines" is added after the offensive term, the resulting combination (i.e., the proposed mark) essentially means devices that serve the purpose of having sexual intercourse with someone. The examining attorney need only point to the visual images contained within the specimen of record to demonstrate that the mark, FUCKINGMACHINES, as applied to applicant's services, "is 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." *See In re Mavety*, 33 F.3d 1367, 1371, 31 USPQ2d 1923, 1925 (Fed. Cir. 1994) (citing *In re Riverbank Canning Co.*, 95 F.2d 327, 37 USPQ 268 (CCPA 1938).

Where no other relevant, non-scandalous, meanings of the allegedly scandalous matter are evident from the record, reliance solely on dictionary definitions is sufficient to demonstrate the scandalous nature of the proposed mark. *See, e.g., In re Boulevard Entertainment, Inc.*,334 F.3d 1336, 67 USPQ2d 1475 (Fed. Cir. 2003) (1-800-JACK-OFF and JACK OFF held scandalous where all dictionary definitions of "jack-off" were considered vulgar); *In re Tinseltown, Inc.*, 212 USPQ 863 (TTAB 1981) (BULLSHIT held scandalous where all dictionary definitions of that term were considered vulgar); *but see In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1373, 31 USPQ2d 1923, 1928 (Fed.

Cir. 1994) ("[i]n view of the existence of such an alternate, non-vulgar definition," it was error to find BLACK TAIL scandalous solely on dictionary definitions).

The statutory language "scandalous" has also been understood to encompass matter that is "vulgar," defined as "lacking in taste, indelicate, morally crude." *In re Runsdorf*, 171 USPQ 443, 444 (TTAB 1971). In its Appeal Brief, applicant argues that "[t]he term "fuck" or "fucking" does not rise to the level of condemnation required under Section 2(a)" and that "[t]he mark must be examined in the context of the current attitudes of the day." Moreover, in its Response, applicant points to the various examples of contemporary usage of the term "f-ing" in the media in an effort to illustrate its point 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." App. Brief p.3.

Applicant has taken great liberty to speak for what it believes to be a substantial composite of the American public in glibly asserting: "In the year 2007 (in fact well before) the fact is, 'fucking' can no longer be considered to be *scandalous* or *shocking*" (applicant's emphasis)." App. Brief p.3. Applicant's evidence of comedians, actors, and public figures using the f-word in its varied forms does not prove that a substantial composite of the American public no longer considers the f-word and the term "f-ing" to be offensive or scandalous. In a survey on objectionable language, which was conducted in 1997, out of a total of 1,184 respondents, 83% of all respondents from various age groups considered the f-word highly objectionable. See the article from "Your verdict: Dump the dirty words," *Fort Worth Star-Telegram Newspaper*, August 31, 1997 (attached at the end of this correspondence). Also attached at the end of this correspondence are excerpts of articles that illustrate the public's perception of the vulgarity and objectionable nature of the word "f-ing." The trademark examining attorney refers to the excerpted articles from the LEXISNEXIS® computerized database. More recently, it has been noted that despite the f-word's diminished "punch" over the years, it is still considered and has "remained consistently offensive." See the attached article, "Whence the !@#$? How a dirty word gets that way," *Slate Magazine*, available at: http://64.233.169.104/search?q=cache:a0UAVD0QstMJ:slate.com/id/2167992/+word+fuck+is+offensive&hl=en&ct=clnk&cd=4&gl=us.

Additionally, several contemporary dictionary references indicate that the f-word and its present participle, "f-ing" are still considered vulgar and offensive. Despite applicant's contention that the f-word and the term "f-ing" are no longer offensive, these dictionary definitions clearly indicate that these terms in all their meanings are still considered offensive, objectionable, obscene, vulgar slang, or taboo slang in today's society. See the attached textual and online dictionary evidence from the online *The American Heritage® Dictionary*, *The American Heritage® Dictionary of the English Language*, Fourth Edition (2006), *Chambers 21st Century Dictionary*, *Collins English Dictionary*, *The Penguin English Dictionary*, www.dictionary.com, *Merriam-Webster's Online Dictionary*, 10th Edition, *Compact Oxford English Dictionary of Current English*,

www.Wordsmyth.net, and *Encarta® World English Dictionary*, North American Edition, and *American Slang Dictionary*.

Given that the standard of "scandalousness" is determined from the standpoint of a substantial composite of the general public and in the context of contemporary attitudes, it is worth noting that the f-word and the term “f-ing” are found in the reference book entitled *Forbidden American English*, which provides in part that the term is "taboo in all senses" and defined as "to copulate [with] someone." Moreover, even the term “fucking machine” is found in this dictionary, and it too is labeled as taboo and followed by notes for caution. See the attached from *Forbidden American English*, 1995. The offensiveness of the term is also referred to in the word history section of the www.dictionary.com entry, which provides in part: “The obscenity fuck is a very old word and has been considered shocking from the first, though it is seen in print much more often now than in the past.” The source of this entry from www.dictionary.com is cited as *The American Heritage ® Dictionary of the English Language*, Fourth Edition, Copyright 2000.

Moreover, when the f-word is typed into MSN's *Encarta*, the search result is preceded by a blatant language advisory of the potential offensiveness of the term, which requires the user to click a box before proceeding to the definition. It is particularly worth noting that in all of the listed definitions, regardless of verb, noun, or interjection form, are all preceded by the clause "a highly offensive term defined as." See the attached from *Encarta ® World English Dictionary*, North American Edition.

It appears that these various dictionary definitions contradict applicant's emphatic insistence that this is an f-word tolerant society. Indeed, if the f-word were not deemed offensive by a substantial composite of the general public, as applicant so believes, the term would hardly be labeled as "highly offensive" in MSN's *Encarta*®, an arguably modern reference.

To support its contention that the f-word and its forms are no longer offensive, applicant points to the "full factual and evidentiary discussion" provided in its Response to Office Action, of the modern usage of the term “f-ing,” by public figures, comedians, and actors. Applicant misconstrues the meaning and purpose of Section 2(a) of the Trademark Act. It should be re-emphasized as it was in the preceding Actions, that the fact that profane words may be uttered more freely in contemporary American society than was done in the past does not render such words any less profane. *In re Tinseltown, Inc*., 212 USPQ 863 (TTAB 1981) (BULLSHIT found scandalous for handbags and other personal accessories). The cited dictionary definitions above clearly reflect that the term and its present participle form are still considered offensive and taboo.

The Relevant Marketplace

To quote applicant: “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*.” App. Brief p.4. The examining attorney could not disagree more. It is

especially when the mark is considered in the context of applicant's services, that it meets the standard for scandalous as required by Section 2(a). Given the recitation of services in conjunction with applicant's specimen, there is no non-vulgar meaning to the wording "FUCKINGMACHINES."

Even if applicant were to argue that the f-word has non-scandalous meanings as an intensifier, for instance, this would not change the analysis. Where a word or phrase has multiple relevant meanings, at least one of which is arguably scandalous and at least one not, specimen use or a design element that reinforces the scandalous meaning(s) is persuasive evidence that a substantial composite of the general public will consider the term or phrase scandalous. *In re Wilcher Corp.*, 40 USPQ2d 1929 (TTAB 1996) (application for DICK HEADS with accompanying design held scandalous where the design portion comprised "a graphic, readily recognizable representation of male genitalia," and thus "the vulgar significance of applicant's mark … plays a very dominant role in the commercial impression created by the mark"); *Cf. In re Hershey*, 6 USPQ2d 1470, 1472 (TTAB 1988) (BIG PECKER held not scandalous where specimens of record showed use of the mark in connection with a picture of a bird, thus reinforcing the non-scandalous meaning of PECKER as a bird). In the instant case, the f-word and its present participle form have multiple vulgar meanings, but the pertinent definition at issue here and its scandalous nature are further reinforced by applicant's website and specimen of record.

Consistent with the holding in *In re Mavety*, the determination of the scandalousness of applicant's proposed mark, FUCKINGMACHINES, is being made "in the context of the marketplace as applied to goods or services described in the application." 33 F.3d at 1371. Applicant suggests that the determination should also be made in the context of the "relevant marketplace," which it believes to be "the erotic entertainment-consuming public." App. Brief p.5.

Applicant misconstrues the case law concerning the relevant marketplace and the determination of scandalousness. Applicant misapplies the concept of "channels of trade" analysis, which is used in Section 2(d) likelihood of confusion cases, rather than in Section 2(a) scandalous or immoral mark cases. Applicant also improperly narrows the relevant marketplace in order to suggest that the view of a segment of the population that enjoys adult and pornographic material represents a "substantial composite of the general public." Applicant's supposition that the erotic entertainment-consuming public would not deem the term offensive is not supported by germane survey evidence. Applicant points to a graph in its exhibits that illustrates how the f-word is searched more frequently on Google® than the words "living," "eating," "sleeping," and "dying." App. Brief p. 6, 7. This information, however, simply shows the frequency of searches, but does not take into account that the frequency of searches is not directly correlated with society's perception of a term's offensiveness or impropriety. Neither applicant's supposition about the narrowed relevant marketplace nor the Google® graph results says anything about whether the term "FUCKINGMACHINES" would not be deemed offensive or scandalous by individuals who are not purveyors of pornography or adult entertainment

services. Merely because an obscene term is searched more frequently than others does not mean that it has lost its status as an obscenity or offensive term.

Applicant misconstrues *In re Mavety* in equating what it believes to be the relevant marketplace in this case (i.e., erotic entertainment-consuming public that is "comfortable with and has an interest in consuming legal and non-obscene pornographic materials" App. Brief p.5) with the substantial composite of the general public. The facts in the instant case are distinguishable from those in *In re Mavety*. In reaching its decision that the mark, "BLACK TAIL," was not scandalous, the court considered that the wording could have other non-vulgar meanings in the context of the adult entertainment magazine, because of the variety of non-vulgar and non-offensive definitions of "tail." Unlike the term "tail," however, the f-word and its present participle form do not have non-vulgar definitions. Moreover, the other definitions of the f-word are not equally applicable to define "FUCKINGMACHINES" in the context of the erotic entertainment-consuming public and in the context of applicant's services. Applicant mangles the holding of *In re Mavety* in contending that the proposed mark at issue is not scandalous because the erotic entertainment-consuming public may not regard the mark as scandalous or offensive. What applicant has categorized as "that section of the population that is comfortable with and has an interest in consuming legal and non-obscene pornographic materials" and that "would consider the word "f-ing" to be rather tame," (App. Brief p. 5) however, can hardly be deemed a substantial composite of the general public.

By emphasizing that the relevant marketplace consists of the erotic-entertainment consuming public, applicant blithely overlooks the fact that within the context of applicant's services, the term "f-ing" in applicant's mark has no non-vulgar, non-offensive meaning as understood by most members of the general public. See the attached textual and online dictionary definitions. Indeed, based on the photographs and text displayed in applicant's website (see attached specimen of record), applicant's entertainment services involve a website that features photographs of a woman being penetrated from behind with a device or machine, in a sexual manner and various similar machines for the same purpose.

When viewed in the context of applicant's erotic entertainment services, as so required by *In re Mavety*, and as illustrated so clearly by applicant's website, the only definition of the f-word relevant here is the definition that would be understood not only by a substantial composite of the general public, but also by applicant's erotic entertainment-consuming "relevant market." It requires no imagination by anyone to immediately recognize that the term at issue in the mark, FUCKINGMACHINES, can mean nothing other than "have[ing] sexual intercourse with" something or someone. Regardless of how one characterizes the relevant marketplace, the pertinent definition of the term "fucking" in FUCKINGMACHINES, is understood to be offensive and scandalous by a substantial composite of the general public. See the attached dictionary definitions and excerpted articles.

<u>Applicant's Arguments Regarding Unconstitutionality</u>

Applicant correctly acknowledges that the TTAB has no authority to declare provisions of the Lanham Act unconstitutional and that the CCPA has already considered and rejected constitutional challenges to Section 2(a) refusals.

Applicant, however, is mistaken in claiming that *In re Robert L. McGinley* was incorrectly decided. 660 F.2d 481, 211 USPQ (BNA) 668. This case was decided in 1981 and has not been overruled or superseded. Applicant presents no evidence to support the contention that "multiple cases" and "years of more developed controlling law" have "discredited" *McGinley*. App. Brief p. 12. To this day, the USPTO has never registered a mark containing the f-word.

Applicant's First Amendment rights are not being abridged by this refusal under Section 2(a) of the Lanham Act. Applicant is free to use the mark in commerce as often and as widely as it wishes. No commercial speech is being abridged by this refusal under Sections 2(a) and 2(e)(1) of the Trademark Act. The USPTO's refusal to register the proposed mark does not affect the applicant's right to use it. *See McGinley*, 660 F.2d at 484. As in *McGinley*, with regard to applicant's use of its mark, "[n]o conduct is proscribed, and no tangible form of expression is suppressed." *Id*. More recently, in 2003, the court upheld the USPTO's refusal to register the marks "JACK-OFF" and "1-800-JACK-OFF" under Section 2(a) and also confirmed that the refusal was not a violation of the applicant's First Amendment rights because the refusal did not proscribe any conduct or suppress any form of expression, as it did not affect the company's right to use the marks. *See In re The Boulevard Entertainment, Inc.*, 334 F.3d 1336, 67 USPQ2d (BNA) 1475. In this decision, the court stated that its previous decisions and those of its predecessor court have consistently rejected First Amendment challenges to refusals to register marks under Section 1052(a). This case has also not been overruled or superseded.

Furthermore, applicant's reference to *In re California Innovations, Inc*. is not on point and the case is distinguishable from the case at bar. 329 F.3d 1334. In *In re California*, the issue at stake was whether the mark was geographically deceptively misdescriptive. Not only is each trademark case decided on its own facts and merits, but the court's mention of the "harsh consequence of non-registrability under the amended Lanham Act" should not be taken as a blanket statement by the Court of Appeals for the Federal Circuit that applicant's First Amendment rights have been abridged simply because the Office has refused to register the mark FUCKINGMACHINES based on Section 2(a) grounds. Nor is the case, *Simon & Schuster, Inc*. (502 U.S. 105 (1991)) relevant, because the issues of New York's Son of Sam law and state interest bear little relevance in this particular context of Section 2(a) of the Trademark Act.

Nevertheless, with regard to applicant's contention that no governmental interest was ever articulated, the examining attorney must reiterate that no First Amendment right of the applicant has been curtailed. As the court stated in *McGinley* and then again in *In re Mavety*, "we note the view of our predecessor court that the §1052(a) prohibition against scandalous marks is not 'an attempt to legislate morality, but, rather, a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal

government.'" *In re Mavety*, 33 F.3d at 1374 (citing *McGinley*, 660 F.2d at 486, 211 USPQ (BNA) at 674).

Finally, in response to applicant's commentary on the previous examiners' dictionary evidence, applicant should note that where multiple dictionaries "uniformly indicate that a word is vulgar, and the applicant's use of the word is clearly limited to the vulgar meaning of the word," the examining attorney has met its burden of showing that the mark at issue comprises or consists of scandalous matter by referring to dictionary definitions alone. *See In re The Boulevard Entertainment*, 334 F.3d at 1341.

Based on the dictionary definitions and Internet website articles attached, as well as applicant's specimen of record, the wording "fucking" when viewed in the context of applicant's services is vulgar and objectionable sexual slang and would be deemed scandalous and offensive by a substantial composite of the general public. Thus, in line with the holdings in *McGinley*, *In re Mavety* and *In re The Boulevard Entertainment, Inc.*, applicant's mark, FUCKINGMACHINES, consists of scandalous matter, in the context of the marketplace as applied to the services described in applicant's application.

Accordingly, registration of the proposed mark is refused under Section 2(a) of the Trademark Act.

Although the trademark examining attorney has refused registration, applicant may respond to the refusals to register by submitting evidence and arguments in support of registration.

Applicant's Response

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: TEAS Plus applicants should submit the following documents using the Trademark Electronic Application System (TEAS) at http://www.uspto.gov/teas/index.html: (1) written responses to Office actions; (2) preliminary amendments; (3) changes of correspondence address; (4) changes of owner's address; (5) appointments and revocations of attorney; (6) amendments to allege use; (7) statements of use; (8) requests for extension of time to file a statement of use, and (9) requests to delete a §1(b) basis. If any of these documents are filed on paper, they must be accompanied by a $50 per class fee. 37 C.F.R. §§2.6(a)(1)(iv) and 2.23(a)(i). Telephone responses will not incur an additional fee. NOTE: In addition to the above, applicant must also continue to accept correspondence from the Office via e-mail throughout the examination process in order to avoid the additional fee. 37 C.F.R. §2.23(a)(2).

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LexisNexis® Search Results of News Articles

1)

Village Voice (New York, NY)

November 30, 2004, Tuesday

SECTION: Features; Pg. 30

LENGTH: 1256 words

HEADLINE: THE OCTOPUSSARIAN DRUGSTORE COWBOY

BYLINE: R.C. Baker

BODY:
...all because, back in the '50s, he looked at his cameras, typewriters, stage sets, and canvases and "saw it all as one **fucking** piece." A tad **vulgar**, sure. But never stupid. Leslie's show, which includes daily screenings of his films, continues at Allan Stone Gallery, ...

2)

University Wire

April 21, 2004 Wednesday

SECTION: CD REVIEW

LENGTH: 855 words

HEADLINE: TV on the Radio get 'Blood Thirsty' on new album

BYLINE: By Marcello De Feo, Colorado Daily; SOURCE: U. Colorado

DATELINE: BOULDER, Colo.

BODY:
...on CU's football team? Did they act inappropriately? How do you think they're taking all of the publicity?
DYBTB: They are feeding. They are flying. They are **fucking**.
MD: Well, that's a little obscure -- not to mention **vulgar**. Can you expound on that a bit?
DYBTB: Watch a room full of roosters turned to cocks runnin' wild, ...

3)

OC Weekly

August 13, 1999, Friday

SECTION: Film; Pg. 28

LENGTH: 526 words

HEADLINE: SHOW ME LOVE

BODY:
...rumored to have gotten together with 70,000 guys (a mere estimate). Despite her seemingly privileged position, Elin is also fed up with "**fucking** Amal" (the original title of this film; it was deemed too **vulgar** for overseas showing). Utterly bored one evening, Elin convinces her sister to go to Agnes' birthday party, which, as expected, ...

4)

University Wire

October 31, 1997

LENGTH: 666 words

HEADLINE: Fraternity at U. Kentucky gets two years for hazing incident

BODY:
...Tony Blanton, Clarkson wrote, "I did specifically hear one person yell at another in a very degrading and **vulgar** manner. The person screamed, 'You'll take it like a **fucking** man. Everybody else has **fucking** taken it, and you will **fucking** too.'" UK officers reportedly found Ellegood "showered in ...

5)

Miami New Times (Florida)

January 9, 1997, Thursday
Correction Appended

SECTION: Features

LENGTH: 8172 words

HEADLINE: A Key Battle;

The Conch Coalition and Taras Lyssenko claimed environmentalists were out to destroy the culture and economy of the Keys. Voters listened.

BYLINE: By Sean Rowe

BODY:
...betrayal. "Every treasure hunter was pissed off to the hilt," Lyssenko notes. "But they're Southern gentlemen. They might say, 'Joe, that was totally unacceptable.' What I said on the tape was 'Joe! You're a **fucking** asshole!' I have a tendency to be **vulgar** at times." (Lyssenko also mentioned on the tape that Kimbell's roadside treasure museum was so ugly it ought to be bulldozed.) The incident didn't quite end there, however. In a bizarre twist, another audio ...

COMPANY: FLORIDA KEYS NATIONAL (69%);

6)

Riverfront Times (St. Louis, Missouri)

October 4, 2006 Wednesday

SECTION: NEWS; Columns

LENGTH: 214 words

HEADLINE: Jet Pilot;
(Houlihan's Clayton)

BYLINE: By Timothy Lane

BODY:
...a cockpit. Besides, he's too old now; that ship sailed. Never entered port. But that's not the reason he gives me.
"My **fucking** eyes," he says. "**Fucking** vision's no good!"
His brain is on fire: How many expletives can fit into a single sentence? **Vulgar**? Maybe but no matter: He was never under any obligation to be clear-headed or articulate - what use is there in doctoring a ...

7)

Dallas Observer (Texas)

October 26, 1995, Thursday

SECTION: News Shorts

LENGTH: 526 words

HEADLINE: Buzz

BYLINE: By Glen Warchol

BODY:
...being attributed to him (also incorrectly in your previously printed "transcript"). If your high school name is ac-cepted, it would accurately be named Goddamned (More Useless Than) Tits on a Boar Hog Dan **Fucking** Peavy High School.
However, Mr. Peavy, the reformed-former-user-of-offensive-language, is not in favor of that; the language would be too **objectionable**. It would also be too long a name and I think it would be hard to find an appropriate mascot.
Please do not further damage the reputation of Mr. Peavy, the reformed- former-user-of-offensive-language, for ...

COMPANY: FORT WORTH MORTGAGE (50%); WARTHOG DAN FUCKING PEAVY HIGH SCHOOL (62%);

8)

United Press International

January 21, 1986, Tuesday, BC cycle

SECTION: Washington News

LENGTH: 278 words

DATELINE: WASHINGTON

BODY:
...drunken driver.
As George attempted to interview witnesses and clear the street, Callahan shouted various epithets at him.
Editors: Note **objectionable** language in following graf:
According to court records, Callahan called George a "**fucking** asshole."

9)

Fort Worth Star-Telegram (Texas)

August 31, 1997, Sunday FINAL AM EDITION

SECTION: EDITORIAL/OPINIONS; Pg. 3, Editorial

LENGTH: 965 words

HEADLINE: Your verdict: Dump the dirty words

BYLINE: Phil Record, Star-Telegram Writer

BODY:
You exceeded my expectations and fulfilled my hope.
I'm speaking about your reaction to the recent survey about how you view use of certain words or phrases in the newspapers. A total of 1,184 of you responded. That is by far the largest response to any of the unscientific surveys I have conducted in past years (the previous record was 802 responses).
I was hoping most of you would find objectionable for newspaper usage all of the words or phrases listed in the survey. You did - by a big margin.
I realize that most of those who participated in the survey probably are very sensitive about the use of these words and phrases, but I suspect that the results of the survey are reflective of the attitudes of many readers.
If the responses are indicative of the attitude of most of our readers they tell us you don't approve of the use of obscenities (lewd language), profanities (showing disrespect for God, Jesus and other sacred things), vulgarities (crude language) and racial slurs in the Star-Telegram.
The results also support our policy of permitting use of words that are generally considered to be offensive only when there are compelling reasons to do so.
A quick review for those of you who may not have read the Aug. 10 column that carried the survey:
I asked readers if they found the use of certain words and phrases in the newspaper objectionable, and if they did find them objectionable I asked them to signify the degree of the objection. The words and phrases were: The S-word (for excrement); ass (for buttocks); using references to God or Jesus in exclamations; the F-word (for sexual intercourse), and the N-word (a racial epithet).
In reference to the last word, I probably should have said the six-letter N-word because several readers said they thought I was referring to the word Negro, and they had no trouble with it.
We had to discard 12 of the survey forms because readers merely used check marks instead of the numeral ratings (1 for not objectionable, 2 for slightly objectionable, 3 for somewhat objectionable and 4 for highly objectionable).
Not all respondents indicated their opinions about all of the words or phrases. And, as I had predicted, most of the participants

fell into the over-50 age category.
You will find the results in the accompanying charts.
You will note that only high school and middle school students did not find all of the words or phrases somewhat or highly objectionable. Only the N-word really turned them off. I hope this does not mean that mainstream newspapers in future generations will be peppered with obscenities, profanities and vulgarities.
Several weeks ago a number of editors were pondering how readers reacted to different words. Some said they doubted that many readers were offended when God or Jesus were used in exclamations in the paper. We seldom receive complaints when such profanities appear in the paper.
Executive Editor Jim Witt said he found two things of significance about the survey: 1. the number of readers who object to the use of ass and profanities in the newspaper, and 2. how the feelings of readers and Star-Telegram staff members differed on the use of the word ass and profanities.
Witt said we will consider exercising greater restraint when it comes to use of these words in the future.
How would I have voted? I would rate the profanities, the F-word and the N-word as highly offensive, ass and the S-word as somewhat offensive.
RESULTS OF SURVEY ON OBJECTIONABLE LANGUAGE

Survey ran Aug. 10; responses by Aug. 17
Public response total: 1,184
(Not all respondents answered each question.)

The Question: Rate the words and phrases listed below from 1 to 4 as to how objectionable you find their use in a newspaper.
1 not objectionable
2 slightly objectionable
3 somewhat objectionable
4 highly objectionable

ALL RESPONDENTS

RATINGS	1	2	3	4
S-word	124 (11%)	88 (7%)	101 (9%)	865 (73%)
Ass	161 (14%)	72 (6%)	157 (13%)	780 (67%)
God or Jesus	76 (7%)	48 (4%)	108 (9%)	912 (80%)
F-word	76 (7%)	43 (4%)	72 (6%)	963 (83%)
N-word	17 (2%)	41 (4%)	117 (10%)	950 (84%)

STUDENTS FROM ARLINGTON'S MARTIN HIGH SCHOOL JOURNALISM CLASSES AND
FORT WORTH'S HANDLEY MIDDLE SCHOOL CLASSES

RATINGS 1 2 3 4
S-word 103 (51%) 68 (34%) 14 (7%) 15 (8%)
Ass 121 (67%) 35 (19%) 17 (9%) 9 (5%)
God or Jesus 45 (24%) 29 (16%) 45 (24%) 65 (36%)
F-word 59 (32%) 36 (19%) 51 (28%) 38 (21%)
N-word 17 (9%) 14 (8%) 32 (17%) 121 (66%)

OTHERS UNDER 35
RATINGS 1 2 3 4
S-word 7 (11%) 1 (2%) 6 (10%) 47 (77%)
Ass 8 (13%) 2 (3%) 11 (18%) 40 (66%)
God or Jesus 6 (10%) 3 (5%) 2 (3%) 49 (82%)
F-word 5 (8%) 0 1 (2%) 53 (90%)
N-word 2 (3%) 3 (5%) 2 (3%) 53 (89%)

THOSE 35 to 49
RATINGS 1 2 3 4
S-word 5 (3%) 6 (4%) 28 (17%) 121 (76%)
Ass 9 (6%) 11 (7%) 35 (22%) 105 (65%)
God or Jesus 9 (6%) 4 (2%) 17 (11%) 128 (81%)
F-word 4 (2%) 3 (2%) 9 (6%) 144 (90%)
N-word 0 5 (3%) 13 (8%) 141 (89%)

THOSE 50 OR OLDER
RATINGS 1 2 3 4
S-word 3 (.4%) 13 (1.6%) 51 (7%) 676 (91%)
Ass 18 (2%) 22 (3%) 91 (12%) 621 (83%)
God or Jesus 14 (2%) 11 (1%) 41 (6%) 661 (91%)
F-word 4 (.5%) 4 (.5%) 9 (1%) 716 (98%)
N-word 14 (2%) 18 (3%) 68 (9%) 624 (86%)

SELECTED STAR-TELEGRAM STAFF MEMBERS
RATINGS 1 2 3 4
S-word 0 2 (7%) 7 (25%) 19 (68%)
Ass 2 (7%) 8 (29%) 10 (35%) 8 (29%)
God or Jesus 3 (12%) 5 (19%) 10 (38%) 8 (31%)
F-word 0 0 2 (7%) 25 (93%)
N-word 0 0 1 (4%) 26 (96%)

- Data compiled by administrative assistant Marcia Melton

LOAD-DATE: September 2, 1997