

From: Martin, Christine

Sent: 6/9/2015 6:11:16 AM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 79141996 - F\*\*K PROJECT - 1722-336 - EXAMINER BRIEF

\*\*\*\*\*

Attachment Information:

Count: 1

Files: 79141996.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

**U.S. APPLICATION SERIAL NO.** 79141996

**MARK:** F\*\*K PROJECT



**CORRESPONDENT ADDRESS:**

JOHN SEGBERT

EGBERT LAW OFFICES PLLC

1314 TEXAS 21ST FLOOR

HOUSTON, TX 77002

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

**APPLICANT:** GIORGIO S.R.L.

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

1722-336

**CORRESPONDENT E-MAIL ADDRESS:**

mail@egbertlawoffices.com

**EXAMINING ATTORNEY'S APPEAL BRIEF**

**INTERNATIONAL REGISTRATION NO.** 1190861

Applicant has appealed the trademark attorney's final refusal to register the mark F\*\*K PROJECT in stylized form for "Leather and imitations of leather; leather and imitation leather goods, namely bags, suitcases, backpacks, traveling bags, purses, key-cases of leather and skins, wallets, briefcases for documents; umbrellas" and "Clothing, namely, T-shirts, shirts, jumpers, trousers, skirts, jeans, jackets, underclothes, bathing suits, hats and caps, footwear" pursuant to Trademark Act Section 2(a), 15 U.S.C. §1052(a), because the proposed mark consists of or comprises immoral or scandalous matter. See TMEP §1203.01. It is respectfully submitted that this refusal should be affirmed.

#### I. FACTS

On October 18, 2013, GIORGIO S.R.L. filed a Request for an Extension of Protection to the United States for application serial number 79141996 for the mark F\*\*K PROJECT in stylized form for "Leather and imitations of leather; leather and imitation leather goods, namely bags, suitcases, backpacks, traveling bags, purses, key-cases of leather and skins, wallets, briefcases for documents; umbrellas" and "Clothing, namely, T-shirts, shirts, jumpers, trousers, skirts, jeans, jackets, underclothes, bathing suits, hats and caps, footwear."

On February 5, 2014, the examining attorney refused registration pursuant to Trademark Act Section 2(a), 15 U.S.C. §1052(a), because the proposed mark consists of or comprises immoral or scandalous matter. On March 13, 2014, the United States Patent and Trademark Office ("the Office") received a correction to the ownership from the International Bureau which identified the owners of the application as GIORGIO S.R.L., Mauro Russo, Paolo Guidi, Alessandro Antonio Ambrogio Falconieri and M&M Consulting Licensing S.R.L. On March 20, 2014, the examining attorney required amendment to applicant's entity type and citizenship. On August 18, 2014, applicant amended applicant's entity type and citizenship and presented arguments in response to the Trademark Act Section 2(a) refusal.

On October 4, 2014, the examining attorney issued a Final Action maintaining the Section 2(a) refusal and accepting applicant's amended entity type and citizenship designations. On January 22, 2015, applicant submitted a Request for Reconsideration after Final Action presenting arguments in response to the refusal. On February 5, 2015, the examining attorney denied the Request for Reconsideration.

On April 3, 2015, applicant filed the present appeal.

## II. ISSUE ON APPEAL

The sole issue on appeal is whether applicant's mark F\*\*K PROJECT in stylized form consists of or comprises immoral or scandalous matter and should be refused registration under Section 2(a) of the Trademark Act.

## III. ARGUMENT

Applicant applied to register the mark F\*\*K PROJECT in stylized form for "Leather and imitations of leather; leather and imitation leather goods, namely bags, suitcases, backpacks, traveling bags, purses, key-cases of leather and skins, wallets, briefcases for documents; umbrellas" and "Clothing, namely, T-shirts, shirts, jumpers, trousers, skirts, jeans, jackets, underclothes, bathing suits, hats and caps, footwear." Registration was refused because the applied-for mark consists of or comprises immoral or scandalous matter. Trademark Act Section 2(a), 15 U.S.C. §1052(a); see TMEP §1203.01.

The words "immoral" and "scandalous" may have somewhat different connotations; however, immoral matter has been included in the same category as scandalous matter. TMEP §1203.01; see *In re McGinley*, 660 F.2d 481, 484 n.6, 211 USPQ 668, 673 n.6 (C.C.P.A. 1981) (Because of the court's holding that appellant's mark was scandalous, "it [was] unnecessary to consider whether appellant's mark [was]

‘immoral.’ [The court] note[d] the dearth of reported trademark decisions in which the term ‘immoral’ [had] been directly applied.”).

For a mark to be “scandalous,” the evidence must show that the mark would be considered shocking to the sense of decency or propriety, giving offense to the conscience or moral feelings, or calling out for condemnation. *In re Fox*, 702 F.3d 633, 635, 105 USPQ2d 1247, 1248 (Fed. Cir. 2012) (quoting *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371, 31 USPQ2d 1923, 1925 (Fed. Cir. 1994)); see TMEP §1203.01.

A mark is scandalous when the evidence demonstrates that a substantial composite of the general public (although not necessarily a majority) would consider the mark to be scandalous in the context of contemporary attitudes and the relevant marketplace. See *In re Fox*, 702 F.3d at 635, 105 USPQ2d at 1248 (quoting *In re Mavety Media Grp. Ltd.*, 33 F.3d at 1371, 31 USPQ2d at 1925-26); TMEP §1203.01.

Dictionary definitions alone may be sufficient to show that a term is vulgar if multiple dictionaries, including at least one standard dictionary, uniformly indicate that the term’s meaning is vulgar, and the applicant’s use of the term is clearly limited to that vulgar meaning. See *In re Michalko*, 110 USPQ2d at 1953 (holding ASSHOLE REPELLENT scandalous where multiple dictionary definitions of “asshole” were considered vulgar); TMEP §1203.01.

As a preliminary matter, applicant has argued that “vulgar is not the legal standard.” (Applicant’s Brief, pp. 4-5). However, evidence that a mark is vulgar is sufficient to establish that the mark is scandalous within the meaning of Trademark Act Section 2(a). *In re Fox*, 702 F.3d 633, 635, 105 USPQ2d 1247, 1248 (Fed. Cir. 2012) (citing *In re The Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1340, 67 USPQ2d 1475, 1477 (Fed. Cir. 2003)); TMEP §1203.01.

#### **A. THE WORD “FUCK” IS VULGAR AND SCANDALOUS**

The following definitions of the term “fuck” clearly establish that the term is vulgar and scandalous.

**FUCK:** 1. *usually obscene*: COPULATE 2. *usually vulgar* : MESS (October 4, 2014, Office action, p. 2-5, from the Merriam-Webster® online dictionary at [www.m-w.com](http://www.m-w.com))

**FUCK:** (*vulgar*) 1. To engage in sexual intercourse 2. (*slang*) to meddle (*with*) (February 5, 2015, Office action, from the Collins® American English Dictionary at [www.collinsdictionary.com](http://www.collinsdictionary.com))

**FUCK:** *Usage note* For many people, the word FUCK is extremely vulgar, considered improper and taboo in all of its senses... 1. to have sexual intercourse with 2. *Slang*. to treat unfairly or harshly. (February 5, 2014, Office action, p. 2-4, from [www.dictionary.com](http://www.dictionary.com))

Accordingly, the dictionary definitions of record overwhelmingly indicate that the word “fuck” is vulgar and scandalous.

Applicant argues that “[t]he fact that the term ‘fuck’ has become an integral part of common parlance, and the term is often used in a manner to express frustration, clearly demonstrates that the term is not ‘scandalous’ or ‘shocking to the public decency.’” (Applicant’s Brief, p. 8). However, the fact that profane words may be uttered more freely in contemporary American society than in the past does not render such words any less profane. *In re Tinseltown, Inc.*, 212 USPQ 863, 866 (TTAB 1981) (holding the mark BULLSHIT scandalous for handbags and other personal accessories).

Applicant argues that the article titled “Whence the !@# \$? How a dirty word gets that way” supports applicant’s position that “fuck” is not a vulgar or scandalous word. However, applicant has mischaracterized the statements made in the material. Specifically, applicant asserts that the article states that “the FCC would no longer levy indecency fines on broadcasters who accidentally allowed the

term ‘fuck’ on the airwaves.” (Applicant’s Brief, p. 7) Applicant adds that “the FCC reasoned that the word ‘fuck’ is commonly used to express frustration rather than sexual obscenity.” *Id.* However, applicant’s statements are inaccurate. Rather, the author of the article indicates that a *federal appeals panel* said the FCC *could* decline to levy indecency fines in cases of accidental use of the word with the *federal appeals panel* reasoning that the word is used to express frustration. (October 4, 2014, Office action, p. 17). Moreover, in a discussion of the origin of the word “fuck”, the article states that “[f]uck has always been an offensive word...” and “... fuck has remained consistently offensive...” (Office action, p. 17). Thus, despite briefly discussing use of the term to express frustration, the article supports the examining attorney’s position that the word “fuck” is a vulgar and scandalous word.

#### **B. THE WORD “F\*\*K” IN THE APPLIED FOR MARK STANDS IN FOR THE WORD “FUCK”**

As demonstrated by the evidence of record, the word F\*\*K in the mark is a variant of “fuck.” The examining attorney notes the following:

- (1) “F\*\*k Earth! Elon Musk wants to send million people to mars to ensure humanity’s survival” which quotes Elon Musk as saying “Fuck Earth! Who cares about Earth?” (October 4, 2014, Office action, pp. 12-16, p. 13)
  
- (2) From [www.tMz.com](http://www.t TMZ.com), an account wherein Justin Bieber and a photographer have an altercation and the photographer is described as having cussed out Bieber. Under a video containing the wording “WARNING: EXPLICIT LANGUAGE” the following dialogue:
  - “I’LL F\*\*KING BEAT THE F\*\*K OUT OF YOU”
  - “f\*\*k off back to America”
  - “f\*\*king little moron”
  - “What the f\*\*k you say?”
  - “... you heard what I f\*\*king said, mate.”
  - “I’ll f\*\*king beat the f\*\*k out of you.”(February 5, 2015, Office action, pp. 15-16)
  
- (3) Lily Allen Lyrics from the song identified as “F\*\*k You” from the website [www.metrolyrics.com](http://www.metrolyrics.com) wherein the lyrics include the wording “Fuck you, fuck you very, very much.” (February 5, 2015, Office action, pp. 27-29)

- (4) From the website Huffington Post, an article titled "Jon Stewart Has A Question For Rand Paul: 'What the F\*\*k Are You Talking About?'" which includes the following: "'What the fuck are you talking about?' Stewart asked after hearing Paul's remarks." (February 5, 2015, Office action, pp. 32-33)
- (5) F\*\*K – A Documentary: "This documentary takes a look on all sides of the infamous F-word. It's taboo, obscene and controversial..." (October 4, 2014, Office action, pp. 23-31, p. 23)
- (6) Cee Lo Green Lyrics from the song identified as "F\*\*k You!" from the website [www.metrolyrics.com](http://www.metrolyrics.com) (February 5, 2014, Office action, pp. 9-13)

Applicant argues that the internet evidence of record submitted by the applicant fails to "give any indication as to the potential meaning of the term 'f\*\*k'." (Applicant's Brief, p. 6) and the examining attorney has "presupposed that the term 'f\*\*k' is being used as a substitute for 'fuck,' even though the evidence does not directly indicate that the word 'f\*\*k' is intended to be a censored version of the term 'fuck'." (Applicant's Brief, p. 6). However, the term "f\*\*k" is clearly used in place of the word "fuck" in several instances. For example, Elon Musk is initially quoted as saying "F\*\*k Earth!" and later quoted as saying "Fuck Earth!" (October 4, 2014, Office action, pp. 12-16, p. 13); Jon Stewart is quoted as saying "What the F\*\*k Are You Talking About?" and later quoted as saying "What the fuck are you talking about?" (February 5, 2015, Office action, pp. 32-33); the lyrics from "F\*\*k You" include the words "Fuck you, fuck you very, very much." (February 5, 2015, Office action, pp. 27-29); and the evidence regarding "F\*\*K – A Documentary" specifically refers to the "taboo, obscene and controversial" F-word. (October 4, 2014, Office action, pp. 23-31, p. 23). In sum, the evidence of record clearly demonstrates that the word "f\*\*k" is used in place of the word "fuck."

Applicant also argues that consumers will likely interpret the coined word differently, and the term F\*\*K in the applied-for mark "could refer to an infinite number of socially acceptable words such as 'fork' or 'flack'" and "[i]t is also possible that the letters 'f' and 'k' are initials of different words and the

asterisk symbols serve a merely decorative use...”. (Applicant’s Brief, pp. 3-5). However, as demonstrated by the aforementioned evidence of record, it is clear that “f\*\*k” is commonly used in place of the word “fuck.” Additionally, the applicant has not submitted a single piece of evidence which demonstrates use of the term “f\*\*k” in place of a word other than the obscene word. Thus, it is reasonable to conclude that the average consumer would perceive the term F\*\*K in the applied-for mark to represent the word “fuck.”

### **C. THE WORD F\*\*K IS SCANDALOUS AND VULGAR**

The term “f\*\*k” is equivalent to the word “fuck” and is vulgar and therefore scandalous within the meaning of Section 2(a) of the Lanham Act. This position is supported by the aforementioned internet evidence wherein the term “f\*\*k” is used in place of the word “fuck” and is used in the same vulgar manner.

The Trademark Trial and Appeal Board (the “Board”) has previously found marks containing vulgar words with letters represented by asterisks to be vulgar. *See In re Daniel Zaharoni*, Serial No. 76351811 (January 4, 2005) [not precedential] (wherein the Board found that the wording A\*\*HOLE in the applied-for mark was scandalous where the evidence demonstrated that the word “asshole” is vulgar and that the term A\*\*HOLE is a term for “asshole”. Specifically, the Board was “not convinced that the term ‘a\*\*hole’ is ‘cleaned-up’ and non-vulgar.” *Id at 9.*)

Additionally, as demonstrated by evidence of record from the Trademark Electronic Search System (TESS) comprising a search of all applied-for F\*\*K or F\*CK marks, the Office has never permitted registration of F\*\*K or F\*CK marks. The examining attorney notes that there have been 16 other applications for F\*\*K or F\*CK marks and none were allowed to register. (February 5, 2015, Office action pp. 40-41).

Applicant cites U.S. Trademark Registration No. 4142745, for the mark \$#! MY DAD SAYS, to support the assertion that the applied-for mark is not scandalous. (Applicant's Brief, p. 10). However, each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973). The mark \$#! MY DAD SAYS can be distinguished from the applied-for mark F\*\*K PROJECT because the registered mark includes a term entirely comprised of symbols without any direct connection to a vulgar word while the applied-for mark includes the term F\*\*K, which the aforementioned evidence clearly demonstrates is commonly used in place of the vulgar word "fuck."

Applicant also cites *In re Big Effin Garage, LLC*, Serial Nos. 77595225 and 77595240 (November 23, 2010) [not precedential] to support the assertion that substitutes for vulgar terms are not vulgar. The cited case can be distinguished from the present case because the marks at issue in *Big Effin Garage* contained the terms EFFIN and F'N which are nonliteral, slang forms of a word, and do not directly stand in for the vulgar term "fuck" or "fucking." Specifically, consumers would likely pronounce the marks in the cited case as "effing" rather than "fucking." In contrast, the evidence of record has demonstrated that the term "f\*\*k" is commonly used in place of the word "fuck" and therefore, would be pronounced and interpreted by consumers as "fuck."

Finally, in support of applicant's argument that the applied-for mark is not scandalous, applicant notes that "the same mark has been registered in numerous other countries..." (Applicant's Brief, p. 8). However, Section 2(a) of the Trademark Act is not the relevant law in other countries and the decisions of other countries are not binding on the Office.

#### IV. CONCLUSION

For the foregoing reasons, the examining attorney respectfully requests that the refusal to register F\*\*K PROJECT on the Principal Register under Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), be affirmed.

Respectfully submitted,

/Christine Martin/

Examining Attorney

Law Office 104

(571) 272-1630

[christine.martin@uspto.gov](mailto:christine.martin@uspto.gov)

Chris Doninger

Managing Attorney

Law Office 104