

THIS DECISION IS NOT A
PRECEDENT OF THE TTAB

Mailed: March 23, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

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In re Prosynthesis Laboratories, Inc.

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Serial No. 77902555
Filed December 30, 2009

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Oral Hearing: June 22, 2011

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Morris A. Nunes, Esq. for applicant.

Robert L. Lorenzo, Managing Attorney, Law Office 111.

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**Before Bucher, Zervas, and Mermelstein, Administrative
Trademark Judges.**

Opinion by Mermelstein, Administrative Trademark Judge:

Applicant Prosynthesis Laboratories, Inc., has applied
to register

CHINA◆FREE

for "vitamin and mineral supplements," in International
Class 5.¹

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¹ The application is based on the allegation of a bona fide
intent to use the mark in commerce. Applicant has disclaimed the
exclusive right to use "CHINA FREE" apart from the mark as shown.
Applicant submitted the following description of the mark:

The mark consists of the words "CHINA" and "FREE" separated
by a square rotated 45 degrees so that such square appears
like a "diamond" and substitutes for a hyphen between the

The managing attorney has issued a final refusal to register on the ground that the mark consists of or comprises matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols. Trademark Act § 2(a); 15 U.S.C. § 1052(a).

We reverse.

I. Preliminary Issues

A. Evidence

Applicant attached approximately forty pages of exhibits to its brief on appeal; the managing attorney has objected to this evidence as untimely. Managing Atty. Br. at 2 (unnumbered). The objected-to evidence consists of records of eight third-party registrations from the USPTO's TESS database, nine search summaries from the TEAS database, a newspaper article,² the transcript of a press conference,³ and websites showing use of two of the submitted TESS registrations.

In this case, applicant did not properly submit *any*

two words, the lowest corner of said square being tangent to the imaginary horizontal line that would intersect the bottom of each of the letters in the two words.

² McClatchy Newspapers and The Associated Press, New FDA safety rules for dietary products; Vitamins, herbal pills; Manufacturers must test all ingredients; China a leading supplier, SEATTLE TIMES, June 23, 2007.

³ Food and Drug Administration, Press Conference on Dietary Supplements (June 22, 2007) (Kimberly Rawlings, moderator).

evidence prior to appeal, relying only on argument in response to the § 2(a) refusal. In response to the managing attorney's evidentiary objection, applicant points out that in its May 28, 2010, response to the initial refusal under § 2(a), it listed ten third-party registrations in support of its argument, Reply Br. at 1, but appropriate evidence of these registrations was not submitted at the time.⁴ In his final Office action, the managing attorney neither discussed applicant's listed registrations, nor did he inform applicant that such a list was not a proper means to introduce registrations into the record.

"The record in the application should be complete prior to the filing of an appeal. The ... Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal

⁴ It is well-established that in order to make third-party registrations properly of record, "applicant should submit copies of the registrations themselves, or the electronic equivalent thereof" from the USPTO's electronic databases. *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560 n.6 (TTAB 1996) (citing *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994)). Such submissions should be made no later than six months following a final refusal or later (in the case of an appeal), pursuant to a granted motion to remand the matter to the examining attorney for further examination. Trademark Rule 2.142(d). (A motion for remand will only be granted upon a showing of good cause. It is not clear whether one would have been granted in this case had it been made.)

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is filed." Trademark Rule 2.142(d).

Because the managing attorney did not object to the applicant's listing of registrations in its response to an office action, we will consider applicant's list of third-party registrations as submitted during examination, "for whatever limited probative value such evidence may have."⁵ *In re Broyhill Furniture Indus. Inc.*, 60 USPQ2d 1511, 1513, n.3 (TTAB 2001) (examining attorney's failure timely to object to applicant's listing of registrations is a waiver of objection to consideration of the list).

Nonetheless, we sustain in full the examining attorney's objection to the untimely evidence attached to applicant's brief on appeal. It is clear that none of this material was submitted to the examining attorney during examination or upon a request for remand, and we will not consider it in the first instance on appeal. Trademark Rule 2.142(d). Although applicant listed several of the registrations in its May 28, 2010, Office action response, neither that listing nor the managing attorney's failure to object to the listing justifies applicant's submission on appeal of

⁵ To be clear, we will consider only the information regarding these registrations which was provided in applicant's May 28, 2010, Office action response. As in *Broyhill*, that evidence is of limited probative value because it does not include critical information, such as the particular goods or services for which the listed marks are registered.

the TESS registrations, TEAS search summaries, or other evidence attached to its opening brief.⁶

Applicant correctly points out that standards of evidence are more relaxed in *ex parte* examination as opposed to oppositions and cancellations. Yet our cases concerning the submission of new evidence on appeal have long-emphasized the principle that, with rare exceptions not applicable here (such as judicial notice⁷), in order to be considered, evidence must be submitted to the examining attorney during examination. In hearing an appeal, the Board's role is to review the examining attorney's final refusal or requirement based on the evidence before him during examination. It is not our place to consider new evidence and examine applications in the first instance.

⁶ Applicant is mistaken in its citation of TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 1207.03 (3d ed. 2011), in support of its argument. As we made clear in *In re City of Houston*, 101 USPQ2d 1534, 1537 n.7 (TTAB 2012), the failure to object to listed registrations is a waiver of objection only to consideration of the *list* of registrations, not to any other information concerning them which may later be untimely submitted on appeal.

⁷ Applicant did request that the Board "take judicial notice of each and all of the Registrations cited in Applicant's Brief in accord with TBMP § 704.12." App. Br. at 3, n.3. However, as TBMP § 704.12(a) makes clear, "[t]he Board does not take judicial notice of third-party registrations." *In re Carolina Apparel*, 48 USPQ2d 1542, 1543 n.2 (TTAB 1998); see also, *In re Thomas Nelson Inc.*, 97 USPQ2d 1712, 1717 n.18 (TTAB 2011).

B. Issue on Appeal

During examination and appeal, the managing attorney primarily argued that the person or institution referred to in the mark (and thus the target of the mark's alleged disparagement) is the nation of China. Managing Atty. Br. at 4 (unnumbered) ("In this case, the term 'CHINA' refers to the 'People's Republic of China, a country in Eastern Asia.'"), 5 ("consumers reasonably would understand that the wording 'CHINA FREE' in the proposed mark refers to the disparaged party, *i.e.* [,] in the People's Republic of China."). However, in response to a question at oral hearing, the managing attorney argued that the mark would also be disparaging to Chinese people, including people living in China, as well as United States residents of Chinese origin.

There is only scant reference in this file to Chinese people as an object of disparagement relevant to this case. The only reference during examination was the statement (in the first Office action to raise the issue of disparagement) that "[c]onsumers reasonably would understand that the wording CHINA FREE in the proposed mark refers to the disparaged party, *i.e.* [,] people who live in the People's Republic of China." Ofc. Action at 2 (Nov.

21, 2010).⁸ Applicant filed a response, in which it characterized the Office action as "alleg[ing] that the Mark disparages *the People's Republic of China*," Response at 1 (May 28, 2010) (emphasis added), and specifically argued that the mark did not refer to a "person" under the Trademark Act, *id.* at 4-5. Nonetheless, rather than correct what might have been applicant's mischaracterization of the basis for the refusal, the managing attorney replied in the final Office action that "a nation ... is an institution and thus falls within section 1052(a)'s protection. Clearly, the ordinary meaning of institution suggests the term is broad enough to include a self-governing ... nation. Therefore, the nation of CHINA falls within the purview of Section 1052(a)." Final Ofc. Action at 3 (Oct. 5, 2010) (citation and internal quotation marks omitted). Applicant was not advised in the final Office action that the mark was (or

⁸ Likewise, the Office's brief indicates that "the term 'CHINA' refers to the 'People's Republic of China, a country in Eastern Asia,'" Managing Atty. Br. at 4 (unnumbered), that "[t]he [p]roposed [m]ark [d]isparages [t]he [n]ation [o]f China," *id.* at 5, and that "consumers reasonably would understand that the wording "CHINA FREE" in the proposed mark refers to the disparaged party, *i.e.*[,] in [*sic*] the People's Republic of China," *id.* at 6. The Brief does not significantly allege that the mark disparages Chinese individuals.

was also) alleged to be disparaging to Chinese people, whether living in this country or in China.

The effect of focusing in the final refusal on whether "China" (the country) is a person or institution under the Trademark Act - to the exclusion of any mention of Chinese individuals here or abroad - was to narrow the basis for the refusal to the issue of whether the mark is disparaging to the People's Republic of China as a person or institution. Even assuming that the previous Office action had given applicant fair notice of the argument that the mark is disparaging to Chinese individuals, that ground was ceded in the Final Office Action. Accordingly, we consider the issue on appeal to be whether the mark is disparaging to the People's Republic of China.⁹

II. Applicable Law

The relevant statute provides as follows:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... [c]onsists of or comprises ... matter which may disparage ... persons, living or dead, institutions, beliefs, or national symbols, or

⁹ Aside from the question of whether applicant was on notice of the basis for the refusal to register, we note that the question of whether the mark is disparaging to individuals of Chinese descent (in this country or in China) was not developed on this record, notwithstanding that it raises significant factual and legal questions.

bring them into contempt, or disrepute....

Trademark Act § 2(a); 15 U.S.C. § 1052(a).

In determining whether a proposed mark is disparaging, we have applied a two-part test:

1. What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services?
2. If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group?

In re Lebanese Arak Corp., 94 USPQ2d 1215, 1217 (TTAB 2010) (citing *In re Heeb Media LLC*, 89 USPQ2d 1071, 1074 (TTAB 2008); *In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264, 1267 (TTAB 2006); *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1740-41 (TTAB 1999), *rev'd on other grounds*, 284 F. Supp. 2d 96, 68 USPQ2d 1225 (D.D.C. 2003) (subsequent history omitted).

III. Application of Trademark Act § 2(a)

Before turning to the question of disparagement, we consider two preliminary issues:

A. Person or Institution Under Trademark Act § 2(a)

As noted, the managing attorney's contention is that

the applied-for mark would be disparaging to China. As a threshold matter, applicant argues that Trademark Act § 2(a) does not apply in this case because "China" is not a "person[], living or dead," or an "institution[], belief[], or national symbol[]," within the meaning of Trademark Act § 2(a). App. Br. at 7 ("China is surely not a living person or a dead person....").

We are skeptical of applicant's position. See, e.g., Trademark Act § 45 (definition of "person"); *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1219 (Fed. Cir. 2009) (affirming "the Board's conclusion that the Shinnecock Indian Nation is an 'institution' and thus falls within section 1052(a)'s protection"). Nonetheless, we need not consider this question. As will be seen, we would reach the same result regardless of the answer. Accordingly, for purposes of this opinion, we will assume that China is a person or institution within the meaning of Trademark Act § 2(a).¹⁰

¹⁰ Applicant also urges that "country names [are] outside the purview" of Trademark Act § 2(a), citing *In re Sweden Freezer Mfg. Co.*, 159 USPQ 246, 248-49 (TTAB 1968), in which we held that the name of a country is not a national symbol. App. Br. at 6-9. Nonetheless, the refusal to register in this case is not based on an allegation that the name of a country would be disparaged as a national symbol. Rather, the refusal alleges that the *country itself* would be disparaged as a person or institution. While Trademark Act § 2(a) protects, *inter alia*, "persons, ...

B. Constitutionality of Trademark Act § 2(a)

Applicant contends that "even if Applicant's trademark does somehow imply or amount to some degree of disparagement, the attributive application of [Trademark Act § 2(a)] in this case to prevent registration is an unlawful abridgement of Applicant's [F]irst [A]mendment commercial speech rights." App. Br. at 10-11. We disagree.

First, the authorities applicant relies on are inapposite. Applicant cites *Mattel Inc. v. MCA Records Inc.*, 296 F.3d 894, 63 USPQ2d 1715 (9th Cir. 2002), as stating that "[t]rademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view." *Mattel*, 63 USPQ2d at 1718 (quoting *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 1 USPQ2d 1753, 1755 (1st Cir. 1987)). *Mattel* primarily involved infringement and other claims based on use of the involved marks. By contrast, the question before us today is not applicant's use of the applied-for mark, but its application for registration. The crucial difference is that applicant need not secure a registration for its mark in order to use

institutions, ... or national symbols," we are concerned here only with the first two.

it, and the USPTO's refusal to *register* a mark has no bearing on applicant's right to use it. The refusal to register applicant's applied-for mark thus imposes no restraint or limit on applicant's ability to communicate ideas or express points of view. *In re Boulevard Entm't Inc.*, 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003); *In re McGinley*, 660 F.2d 481, 211 USPQ 668, 672 (CCPA 1981).

Similarly, applicant quotes at length from *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). App. Br. at 11. What applicant fails to point out is that the passage it relies on in *Ritchie* is from the *dissenting* opinion, and on a point which was specifically disavowed by the majority.¹¹ The Court said the following in response to the passage applicant cites:

The dissent also expresses at some length concerns about Mr. Simpson's First Amendment rights. The dissent fails to understand that the

¹¹ Parties may cite to dissenting opinions if they wish, although a dissent is not precedential and our authority to follow it may be (as here) severely limited. However, when citing to such an opinion, the party should indicate that it is a dissent. *E.g.*, THE BLUEBOOK, A UNIFORM SYSTEM OF CITATION 10.6.1(a) (17th ed. 2000). A dissent should never be presented - as applicant has done - as if it were the opinion of the court ("As it has been judicially established..." App. Br. at 10). Inaccurate or misleading citations waste time and do not assist the Board in resolving a dispute. See Patent and Trademark Rule 10.89(b)(1); *cf.* *Beaver v. Grand Prix Karting Ass'n, Inc.*, 246 F.3d 905, 911 n. 2 (7th Cir. 2001) (admonishing counsel for relying on precedent that had been reversed without so indicating).

denial of federal registration of a mark does not prohibit the use of that mark. Although the mark holder who is denied federal registration will not receive the benefits conferred on a federal trademark registrant, the mark holder may and can continue to use the mark.

Ritchie, 50 USPQ2d at 1028. Rather than supporting applicant's argument, the opinion of the court in *Ritchie* stands directly in opposition to it.

Second, the Trademark Trial and Appeal Board is an administrative tribunal, not an Article III court, and we have no authority to declare provisions of the Trademark Act unconstitutional. *In re Dist. of Columbia*, 101 USPQ2d 1588, 1602 (TTAB 2012) (collecting cases). Accordingly, even if we were inclined to agree with applicant we could not hold Trademark Act § 2(a) violative of applicant's First Amendment rights.

IV. Disparagement

As noted above, in a disparagement case, we first determine the likely meaning of the mark (or the part of it alleged to be disparaging). If that meaning refers to persons or institutions, we consider whether it may be disparaging to those persons or institutions. *Lebanese Arak*, 94 USPQ2d at 1217.

A. Allegedly Disparaging Elements of the Mark

Applicant's proposed mark comprises the words "CHINA

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FREE" and a design element. The managing attorney's allegations of disparagement refer only to the words. There is no argument in this case that the design in applicant's mark affects the meaning or overall impression of the words which are alleged to be disparaging.

We note that the examining attorney who initially handled the case required a disclaimer of the words "CHINA FREE," arguing that they are descriptive. Applicant complied with this requirement.¹² App. Resp. (Apr. 2, 2010). Nonetheless, a disclaimer cannot overcome a refusal to register on the ground that the mark comprises disparaging matter. Disclaimed matter is not removed from the mark, but remains part of it, *e.g.*, *In re TSI Brands Inc.*, 67 USPQ2d 1657, 1661 (TTAB 2002), and a refusal to register is proper if the applied-for mark is disparaging in whole or in part, Trademark Act § 2(a) ("Consists of or *comprises* ... matter which may disparage..." (emphasis added)). Moreover, in order for a disclaimer of unregistrable matter to have the desired effect of allowing registration of the mark as a whole, the mark must be

¹² In making the disclaimer requirement (prior to imposition of the refusal to register under § 2(a)), the examining attorney argued that CHINA FREE "is merely descriptive of a feature or characteristic of the applicant's goods which are not made in China." Ofc. Action (Mar. 26, 2010). In response, applicant provided the disclaimer without comment.

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"otherwise registrable." Trademark Act § 6(a).

Here, opposer's mark is alleged to be disparaging in that it includes the words "CHINA FREE." Because the disclaimer does not remove this wording from the mark, the mark remains subject to the § 2(a) refusal, and (if the words are disparaging) would not be "otherwise registrable." Thus neither the fact that applicant's mark includes a non-disparaging design element nor the fact that applicant has disclaimed the exclusive right to use the allegedly offending words provides applicant any relief from the refusal.

B. Likely Meaning of the Mark

There is no dispute on this record as to the immediate meaning of the mark. As applicant puts it:

The Mark describes a quality of the goods being offered, but includes a fanciful design element. The quality described is that the vitamin and nutritional supplement goods of the Applicant do[es] not knowingly contain raw materials or components sourced from any country named China....

Because Applicant has identified a market segment that Applicant believes is uncomfortable purchasing supplements for human consumption that contains [*sic*] elements sourced in China, Applicant's mark merely expresses a true fact about its goods.

Resp. to Ofc. Action (May 28, 2010); Managing Atty. Br. at 6 (unnumbered) ("the phrase "CHINA FREE" is used to

describe a product that is not made in China."); see discussion of applicant's website, *infra*.

CHINA FREE is thus used in applicant's mark to inform the prospective purchaser that applicant's goods contain no ingredients from China, and that is its likely meaning.¹³

C. Is the Proposed Mark Disparaging?

Having concluded that the clear meaning of the mark is that the goods do not contain ingredients from China, it is readily apparent that the mark thus "refer[s] to [an] identifiable person[or] institution," *In re Lebanese Arak Corp.*, 94 USPQ2d at 1217, namely China. We therefore consider "whether that meaning may be disparaging" to such person or institution. *Id.*

Marks found to be disparaging may comprise offensive words - often listed in dictionaries and other references as vulgar or derogatory. For instance, the marks SQUAW and SQUAW ONE, sought to be registered for clothing, and retail store services, were found to be disparaging based on evidence that Native Americans found the term SQUAW to be "damaging and offensive, the worst of the worst, an insult and obscene." *In re Squaw Valley Dev. Co.*, 80 USPQ2d at

¹³ The "truth" of the mark's assertion - *i.e.*, whether the goods are in fact free of ingredients from China - is not at issue here, and there is no suggestion in the record that it is incorrect.

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1276 (internal quotation marks omitted). The mark HEEB, for use in connection with clothing and entertainment services, was likewise found to be a derogatory reference to those of the Jewish faith. *In re Heeb Media*, 89 USPQ2d at 1076. And in *Boston Red Sox Baseball Club L.P. v. Sherman*, 88 USPQ2d 1581 (TTAB 2008), we sustained an opposition to registration of SEX ROD, for clothing, finding that "the mark would be viewed as a sexually vulgar version of the [Boston Red Sox'] symbol and as making an offensive comment on or about the club." *Id.* at 1590 (also finding the mark scandalous under Trademark Act § 2(a)). In cases such as these, the mark *per se* was proven to be derogatory or disparaging to the referenced individual or group.

By contrast, CHINA FREE is not alleged to be disparaging or derogatory in itself; rather it is the implication of the mark which is at issue. As noted, the likely meaning of the mark as used on the identified goods is that the applicant's vitamin and mineral supplements do not contain ingredients from China. At first glance, this would appear to be a simple factual statement merely describing a characteristic of the identified goods, *i.e.*, where they were *not* made, not much different from ubiquitous statements of origin, such as "Made in U.S.A.,"

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or negative statements of content, such as "sugar free." Nonetheless, the managing attorney contends that it is disparaging, because the statement that the applicant's goods do not contain ingredients from China implies that there is something wrong with ingredients from China; and by extension that China is accordingly to be held in a dim view.

In addition to marks which are *per se* disparaging (such as HEEB or SQUAW), we have found in some cases that marks which are not themselves offensive can be disparaging when used on particular goods. For instance, the marks MADONNA and MESSIAS, for wine and brandy, SENUSSI, for cigarettes, and KHORAN for wine, were all found to be scandalous or disparaging because the use of the marks on the identified goods was found likely to offend the religious sensibilities of various groups. *In re Riverbank Canning Co.*, 95 F.2d 327, 37 USPQ 268, 269 (CCPA 1938) (1905 Act) ("Of course, the word 'Madonna' is not *per se* scandalous. We do not understand that appellant contends that a mark must be scandalous *per se* to come within the prohibition of the statute. Every one would concede that an application to register the name of the Supreme Being as a trade mark would be properly rejected under the provision of the statute here under consideration. It is therefore

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obvious that, in determining whether a mark 'consists of or comprises ... scandalous^[14] matter,' consideration ordinarily must be given to the goods upon which the mark is used."); *In re P.J. Valckenberg, GMBH*, 122 USPQ 334 (TTAB 1959) (MADONNA); *In re Reemtsma Cigarettenfabriken G.M.B.H.*, 122 USPQ 339 (TTAB 1959) ("The application of the name of any religious order or sect to a product whose use is forbidden to the followers or adherents of such sect or order is an affront to such persons and tends to disparage their beliefs. The use of 'SENUSSI' on cigarettes, therefore, would be scandalous within the purview of Section 2(a) of the Act of 1946 and is not entitled to registration."); *In re Sociedade Agricola E. Comerical Dos Vinhos Messias, S.A.R.L.*, 159 USPQ 275 (TTAB 1968) ("The word 'Messias' is the full equivalent of the word 'Messiah'.... We do not agree with applicant that to the American public the word 'Messiah' is less definite and restrictive referring to Jesus Christ than is the word 'Madonna' referring to the Virgin Mary."); *In re Lebanese*

¹⁴ As we explained in *Lebanese Arak*, for historical reasons, *Riverbank Canning* and other older cases involving "marks which would offend the sensibilities of an ethnic or religious group" were analyzed under the "scandalous" provisions of Trademark Act § 2(a), and the 1905 Act before it. Such marks are now properly considered as potentially disparaging, *Lebanese Arak*, 94 USPQ2d at 1216-17, although we look to the earlier "scandalous" cases as precedent.

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Arak Corp., 94 USPQ2d at 1220 (use of "KHORAN," the equivalent of Koran, the sacred text of Islam, on wine, which is prohibited to adherents of that religion, would be disparaging to Muslims). Thus, the fact that CHINA FREE is not alleged to be *per se* disparaging does not negate the refusal to register; we must still consider the meaning of the term in relation to the identified goods to determine if it would be disparaging to a substantial composite of the identified group.

The managing attorney contends that

[a] reasonable person of ordinary sensibilities would consider this reference offensive or objectionable because the proposed wording "CHINA FREE" implies that there is something negative about retail goods made in China. ... The applicant has not argued otherwise. Instead, the applicant readily admits ... that it has "identified a market segment that [it] believes is uncomfortable purchasing supplements for human consumption that contains elements sourced in China." (emphasis supplied). The applicant further admits that the proposed mark "expresses a true fact about its goods."

Managing Atty. Br. at 8 (citations omitted). In support of his position, the managing attorney has made of record a variety of materials from the internet which purportedly shows that applicant uses its mark "on nutritional supplements directed to a market segment that is full of paranoia about the nation of China and products made in China." *Id.*

While agreeing on the meaning of the mark, applicant sees things in a different light. Applicant argues that many consumers in the U.S. market have legitimate concerns about the wholesomeness of certain products from China:

"The motivation for development and marketing of such a brand arose from the circumstances of heavily publicized instances of problems with misidentified, adulterated and/or impure ingredients from China." App. Br. at 1-2.

In support of its argument, applicant cites materials attached to its brief. But as discussed above, this evidence was untimely, and has not been considered.

Nonetheless, the managing attorney's evidence sheds light on some of applicant's argument. This evidence includes the following information from applicant's website and others:¹⁵

1. Opurity website. [no date or URL given] (This appears to be applicant's own website.¹⁶)

¹⁵ In all cases, text is emphasized as in the original source.

¹⁶ Applicant neither admits nor denies that this is its website. Resp. to Ofc. Action at 2 (May 28, 2010) ("[T]he Office based its action, at least in part, on information supposedly gleaned from the Applicant's website. Assuming *arguendo*, that anything within the website can somehow fairly be construed as disparagement...."). The bottom of each web page bears the mark ProSynthesis Laboratories and a copyright notice naming ProSynthesis as the proprietor. While it seems likely that there is some relationship between applicant ProSynthesis Laboratories and Opurity, it is not clear whether the latter is a separate entity to which applicant's mark is licensed or merely a trademark under which applicant does business.

Where most vitamins come from

People might think that companies make their own products, or that at least they are made in the U.S. All too often that is no longer true. Eight million shipping containers arrive at the Port of Los Angeles alone, most of them from China.

A high – and growing – percentage of the vitamins made in the world are made in China. A full 90% of the world’s Vitamin C is made in China.

Vitamins in China are not generally made by the Chinese division of an American Company. Rather, they are made by a Chinese company. The American company is buying critical ingredients from entirely independent Chinese companies, with all of the risks that entails.

...

Your multivitamin says “Made in USA,” but some of the vitamin ingredients are made in China.

Everything we know says that it is impossible to make a complete multi-vitamin multi-mineral supplement ... only from ingredients Made in the USA. Moreover, we believe all of the major multi-vitamin, multi-mineral brands, as well as smaller brands, use some vitamins from China, which is known to have quality problems.

...

How can they say “Made in USA?”

...

We wanted, for our own health and safety, to take a multi-vitamin with no ingredients from China. As we began to investigate, we became more and more concerned. First, we believe all standard multi-vitamins sold in the US use some vitamins, some ingredients, from China. Worse, we became deeply concerned about the quality and contamination risks of those ingredients.

...

We WANT to trust the drugs and over-the-counter medicines and vitamins you buy. [sic] In fact, we NEED to be able to trust them. But can we?

Every multivitamin is a group of ingredients sourced from around the world. Our sources are the US, Canada, Western Europe and Japan. Not China.

[News reports are cited about tainted or defective Chinese products, including heparin, foods contaminated with melamine and diethylene glycol, and defective drywall.]

...

How Bad is it that My Multi-Vitamin ingredients are from China?

It depends on what health risks you are willing to take. And on how much you know about how Chinese manufacturing usually operates. And how important it is to save 19 cents a day – because you don't have to use the cheap from-China ingredients multi-vitamin. You can use opurity.

Author Ellen Rupert Shell, in her 2009 Book, "Cheap: The High Cost of Discount Culture" writes:

Substandard and fake goods are so common in China that the Chinese have an expression, heixin (pronounced hey-sin) to describe those who make, sell or profit from them. Heixin roughly translates as "black heart."

...

How do you feel about the Chinese melamine scandal that killed six Chinese infants, and sickened over 300,000 according to news reports? How do you feel about the Chinese melamine that killed and sickened pets in the US?

Does it bother you that the melamine problems are continuing, even into early 2010?

How do you feel about counterfeit Heparin (a medical blood thinner) linked to 19 deaths in the United States in 2008? ...

How do you feel about the interiors of homes in the U.S. crumbling due to Chinese Drywall?

How do you feel about this series of Pulitzer Prize winning articles?

[Describing a series of articles about “how dangerous and poisonous pharmaceutical ingredients from China have flowed into the global market” and a New York Times article about exploding phones which also noted that the Chinese government’s own inspections revealed that “**nearly 20 percent of the nation’s food and consumer products are substandard or tainted...** [and also that] *[f]ood is laced with industrial chemicals, formaldehyde, industrial wax and dangerous coloring dyes; baby clothes are contaminated with dangerous chemicals, children’s snack food is doused with excessive amounts of preservatives and old food waste is repackaged and sold as new.*]

...

Q: How are opurity™ vitamins different?

A: We make the industry’s first guarantee: No ingredients from China.

It’s been a hard two years to get to where we can actually make that guarantee. Some vendors asked why we were asking about China when no other companies were. Some companies wouldn’t make promises, or vaguely said that they “right-source.” Some companies made promises but were not judged trustworthy.

...

Q: Do you expect the quality of ingredients from China to improve over time?

A: Probably not. The short answer is, “The Tiger Doesn’t Change Its Stripes.” The reason we say that is that the quality problems in China are deep-seated, and often cultural – and cultural items change slowly, if at all.

2. Phyllis Schlafly, *Americans Need China-Free Food*, Worldview Times, posted Aug. 14, 2007 (www.worldviewweekend.com (Sept. 18, 2010)).

This article discusses reports of various problems with Chinese imports, including lead in toys, melamine in pet food, diethylene glycol in toothpaste, and seafood tainted with chemicals. The article alleges that the problems became so bad that China "execute[d] its top food and drug regulator," and that "[i]t would take a couple of generations and many billions of dollars to bring Chinese food up to U.S. health and safety standards. Nearly half of China's Population lives without sewage treatment, and the water isn't safe, whether from the tap or in sea or pond." Following the article are a number of reader comments echoing the author's concern (and one comment noting that the U.S. has had many of its own problems with food safety).

3. David Flores, *Chinese Vitamin and Herb Safety Questioned*, posted Sept. 30, 2010 (www.articlesbase.com (Oct. 3, 2010)).

As the horror stories about Chinese imports get scarier and scarier, American political leaders are stepping up their rhetoric regarding the safety of the food and other products that are imported from China.

Sen. Charles "Chuck" Schumer, (D) N.Y., believes American consumers are in greater danger than initially realized from food and other products coming in from China. ... *"There is no question that too many Chinese manufacturers and food producers put the bottom line ahead of safety,"* said Schumer. *"Agencies regulating the safety of imported goods need to do more to address this worsening crisis. The fact that every week we have to frantically pull Chinese goods off store shelves shows that our safeguards are falling."*

A major concern of the lawmakers is that he [*sic*] discovery of the toxic chemical melamine in pet food and powdered milk produced and imported from China could be the proverbial "tip of an iceberg" of other tainted products – as of yet undiscovered. And there is some evidence that fuels this further concern. For instance, the FDA's *Import Refusal Reports* in recent years have consistently shown China as a top violator of these regulations. ... U.S. officials are demanding, and rightly so, that the Chinese do more to safeguard the food and drugs they export to America.

4. Sustainable Food News, *Manufacturer Promotes Organic-Based Supplements and Foods as 'China-Free,'* posted

July 10, 2007 (www.organicconsumers.org (May 3, 2010)).

This story reports on a purveyor of "whole food nutritional supplements for consumers and their pets," which is "preparing to roll out a 'China-Free' label...."

"The reason we keyed in on the China thing was the number of headlines [about contaminated products linked to Chinese manufacturing], and the fact that about 80 percent of all Ascorbic acid (Vitamin C) is from China," Davis told Sustainable Food News.

(alterations in original).

5. *Supplement Maker Touts 'China Free' Products*, Morning Edition, National Public Radio (July 12, 2007) (www.npr.org (May 21, 2010)). From the transcript:

Food for Health International, a supplements maker, started labeling its ... capsules as China Free. The company says most vitamins and supplements come from China. But it wants to set itself apart.

Okay, since politicians say we shouldn't depend so much on Chinese food and safety regulations, one U.S. company is taking matters into its own hands.

Our last word in business today is China-free products. That's how the supplement maker Food for Health International is promoting its supplements. It has started labeling its ... capsules China-free.

The company says vitamins and supplements from China, [sic] so it wants to set itself apart, and not just with its products for people. Food for Health promises that its healthy dog supplements are also China-free. So even if your dog's pet food is tainted, you can be pretty sure his vitamin pills are pure.

6. *China-Free Products* (website) (china-free-products.blogspot.com [no date given])

CHINA-FREE

DEFINITION chi-na-free **adj.** A term proposed for use on food labels to show that products are not made in China.

CONTEXT In light of recent health and safety scares regarding Chinese-made food and products, a U.S.-based company called Food for Health International has announced plans to put “China-free” stickers on its goods. The subtext: These products won’t make you sick or have harmful contaminants like melamine.

USAGE Given recent recalls of items from toys to toothpaste, China-free labeling could catch on, though consumers would do well to remember that not all products from China are tainted and not all tainted products are from China.

7. *'China-free': Should you promote your 'Made in USA' status?*, Business Management Daily, posted Oct. 1, 2008 (no URL or date given).

Feeling pressure to join the “China-free” movement? You’re not alone. Many businesses in recent months have contemplated the issue, driven by growing consumer concern that some products from China may be tainted and unsafe. The sentiment comes after large scale toy recalls over dangerous lead levels and contaminated pet food, toothpaste, fruits and vegetables and other products hit U.S. shelves this summer.

In response, a Utah-based food and vitamin company decided to label its products “China-free.” A host of other companies followed suit.

8. Brand Channel, Abe Sauer, *Vitamin Brand Sells Itself As China-Free*, (March 17, 2010) (www.brandchannel.com (May 21, 2010)).

From lead-tainted toys and poisoned milk products to deadly dog food, the reputation of quality control standards for the “Made in China” brand has taken a severe beating.

Now, one brand is exploiting the brand’s sullied image by making the panic over “China-made” into the pillar of its brand-building strategy; but is it too much?

Opurity vitamin ads are turning up on various blogs across the web. The first I saw was on a right-wing political blog. It probably would not have stood out except that the ad featuring [sic] a horrifying image of a factory spewing thick pollution into the sky with the eye-popping copy “Don’t trust your health to China... Warning: Multivitamin companies entrust your health to vitamin ingredients made in China. Do you....”

... Opurity's overall messaging is not any less dramatic than its ads: "China Free Multivitamin Choice" [sic] Opurity is based in Virginia and positions itself with an alarming tone, warnings and, frequently, CAPS LOCK. The brand's ads link to a site that rattles off statistics that implies the danger of Chinese-made drugs is ... CHINA! ... It is possible that Opurity's positioning will appeal to already paranoid customers. However, the punch-in-the-face volume and fear-mongering core of Opurity's positioning probably does the brand a serious disfavor.

Its histrionic positioning will likely lead to diminishing returns and end up exhausting more rational customers. However, any success the brand has will immediately be in danger of irrelevancy, because Opurity forgets to focus on the benefits of its product, defining itself only through the failings of others. Furthermore, its brand could easily be duplicated.

- Among other responses to this article, Jerome Krachenfels (allegedly from Opurity) commented that Opurity was "receptive to the argument that we are too ... overheated in our tone[,] ... [but] we *do* believe that the issue is even more serious than our tone." In support, Mr. Krachenfels cited reports in the New York Times and a book titled *A Toxic Pipeline*, and noted that even big pharmaceutical companies have been "burned" by adulterated products from China.

The managing attorney's evidence thus supports applicant's contention that there is in fact concern among some United States consumers, politicians of various stripes, writers (some of whom bill themselves as particularly knowledgeable about food and drug issues), and at least some United States producers and purveyors of vitamins and nutritional supplements. This evidence shows that there is substantial public concern over issues of the safety of food and pharmaceuticals imported from China, and that this concern has some apparent basis in fact.

An investigation of the truth of the matters asserted in the cited sources is beyond the purview of this decision and we need not address it. And while we do not hold that the approach suggested by applicant and others - eschewing nutritional supplements containing ingredients from China - is the most rational or effective reaction to any such concerns, we cannot find on this record that it is wholly irrational or merely a pretext for animus against China.

The managing attorney points out - with some justification - that the tone in some of the articles and other evidence of record is strident, or as one of the commentators put it in describing what appears to be applicant's own website, a bit too "CAPS LOCK."¹⁷ However, the fact that some internet commentary could be seen as excessive doesn't determine whether China would be disparaged by applicant's mark. What others have to say about the general issue of Chinese manufacturing is not particularly persuasive on the question before us.

On the other hand, applicant's own website is clearly relevant to our consideration of the mark at issue, and the managing attorney has included extensive excerpts in the

¹⁷ We note that in online communications, text in all capital letters is seen by many as the electronic equivalent of shouting. See Fed. R. Evid. 201(b)(1).

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record. This material is relevant to the extent it reflects applicant's intent:

Disparagement is essentially a violation of one's right of privacy - the right to be "let alone" from contempt or ridicule. See *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 218 USPQ 1, 3 (6th Cir. 1983). It has been defined as the publication of a statement which the publisher intends to be understood, or which the recipient reasonably should understand, as tending "to cast doubt upon the quality of another's land, chattles, or intangible things." Restatement (Second) of Torts § 629 (1977). The two elements of such a claim are (1) that the communication reasonably would be understood as referring to the plaintiff; and (2) that the communication is disparaging, that is, would be considered offensive or objectionable by a reasonable person of ordinary sensibilities. See *Eagle's Eye, Inc. v. Ambler Fashion Shop, Inc.*, 627 F. Supp. 856, 227 USPQ 1018, 1023 (E.D. Pa. 1985); see also Altman, Callmann Unfair Competition, 4th ed., § 11.01, et seq.

Greyhound Corp. v. Both Worlds Inc., 6 USPQ2d 1635, 1639 (TTAB 1988) (citations revised); see also *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1589-90 (TTAB 2008) (citing *Dunkin' Donuts of Am., Inc. v. Metallurgical Exoproducts Corp.*, 840 F.2d 917, 6 USPQ2d 1026 (Fed. Cir. 1988) (evidence of intent relevant to Section 2(a) claim of disparagement)).

Consistent with some of the managing attorney's argument, we find applicant's website to be rather strident, one-sided, and somewhat alarmist. Applicant seems to admit as much, if we are to believe that a comment

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posted by "Jerome Krachenfels"¹⁸ in response to an article about applicant's marketing efforts was indeed posted by a representative of applicant. See Brand Channel, Abe Sauer, *Vitamin Brand Sells Itself As China-Free*, (March 17, 2010). In response to Mr. Sauer's criticism of the Opurity website, Mr. Krachenfels states that Opurity is "receptive to the argument that we are too ... overheated in our tone[,] ... [but] we *do* believe that the issue is even more serious than our tone." *Id.* After discussing some of the issues and citing to books and articles on the topic, he asks rhetorically, "OK, so how to 'sound the alarm' without sounding like an alarmIST? How do you stay on the positive side of the coin, when what we are offering is a way to avoid a negative?" *Id.*

Mr. Krachenfels' comment bears some logic: the selling point of applicant's multi-vitamins is that they do not contain ingredients from China, and in order to sell them, it is inevitable that applicant must explain why they are alleged to be better than other multi-vitamins which are widely-available, apparently at a lower price. Applicant's website certainly does that. Applicant minces no words about what it perceives to be problems with

¹⁸ Mr. Krachenfels signed his comment "Jerome/OPURITY (tm) Vitamins" so we assume he is associated with applicant.

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Chinese manufacturing practices, and offers no pretense about presenting a balanced viewpoint of any success stories from China's growing economy.

But what applicant may see as either spreading the truth about genuine concerns or aggressive marketing, the managing attorney sees as the heart of the problem:

Purchasers of the applicant's goods would certainly make inferences that there is something negative about vitamins and mineral supplements made in China. Applicant's use of the proposed mark "CHINA FREE" on vitamin and mineral supplements promotes an unsupported stereotype that all products originating from China are of an inferior quality. Given the widespread availability of such goods in the United States, this inference is clearly misleading.

While recent events have highlighted that some Chinese manufacturers do not make quality products, promoting a stereotype that ALL Chinese manufacturers make poor quality goods is simply untrue. To the contrary, one can get a "great quality product made at a great price" from China. Simply stated, an incredible amount of product is made in China. In fact, an icon of the U.S. automotive industry, General Motors will have its Buick Lacrosse designed in China. ... China is a nation with an ancient civilization dating to 2700 B.C. It is famous for architectural wonders such as the Great Wall of China and the Forbidden City. China is well-known for its contribution to the well-being of society through its development of traditional herbs and teas.

Managing Atty. Br. at 10-11 (internal quotation marks and citations omitted).

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While we respect the managing attorney's position, we think it goes further than warranted by the evidence in this record. Nothing on applicant's website disputes the fact that China produces a large volume of goods for the United States market. Indeed, and particularly with respect to applicant's goods, applicant's point is that "[a] high - and growing - percentage of the vitamins made in the world are made in China. A full 90% of the world's Vitamin C is made in China." Opurity website.

But contrary to the managing attorney's argument, we do not perceive applicant's message as "promoting a stereotype that ALL Chinese manufacturers make poor quality goods...." Rather, applicant merely points out that most multivitamins include ingredients from China, and that China has been the source of some well-publicized problems, in particular, with the occasional production of defective, tainted, or counterfeit food and pharmaceutical products. Applicant does not say - as the managing attorney contends - that "ALL Chinese manufacturers make poor quality goods," or even that all Chinese pharmaceuticals are poorly manufactured. Given the huge volume of goods imported from China, the problem would be very much larger if all Chinese goods from all Chinese manufacturers were of poor quality. Rather, applicant's point appears to be that in light of

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some known incidents (some of which allegedly resulted in deaths) that consumers should be cautious of - and indeed avoid - Chinese pharmaceuticals. "Q: How bad is it that my multi-vitamin ingredients are from China? A: It depends on what health *risks* you are willing to take." Opurity website (emphasis added; capitalization altered).

If applicant's reports of Chinese manufacturing problems are true, they are concerning in themselves. But it is far from clear from applicant's website or any other evidence of record that such problems affect more than a relatively small percentage of Chinese manufacturing. The thrust of applicant's website is instead that regardless of the actual probability of encountering multivitamins containing defective Chinese ingredients, it is better to avoid such a risk by buying applicant's non-Chinese sourced product. Applicant's appeal may indeed be hyperbolic, but the record indicates that applicant's position is shared by others.

Moreover, while applicant clearly takes a dim view of both Chinese manufacturing and Chinese government oversight, it is hard to conclude on this record that applicant's position is clearly motivated by a dislike of China. The material on applicant's website is replete with references to incidents involving mishaps in the Chinese

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pharmaceutical or food industry. Both applicant's website and the other materials of record include citations to sources for this information, including the mainstream press, statements by U.S. politicians, the United States Food and Drug Administration, purported experts on food and pharmaceutical safety, and others. Again, it could be argued that applicant exaggerates the significance of these incidents, and that its reaction is more extreme than is warranted. But applicant does not appear to be alone in this regard, and there is nothing in this record to suggest that it has fabricated information merely to cast China in a bad light.

In this regard, the managing attorney points to remarks on applicant's website which he finds to be particularly offensive:

The applicant's website even goes so far as to make a stereotypical claim about Chinese culture. Making reference to a purported ancient proverb, "*The Tiger Doesn't Change Its Stripes*," (which may or may not actually be Chinese in origin), its website attributes the "quality problems in China" as being "*deep-seated and often cultural...[.]*" This assertion is clearly offensive and derogatory not only to the nation of China but also to people of Chinese origin.

Managing Atty. Br. at 9.

While we cannot fully explore applicant's intent on this record, it is not clear to us that these comments were

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intended to be anything but warnings about what applicant alleges to be serious problems in Chinese manufacturing.

The comment appears on applicant's website as follows:

Q: Do you expect the quality of ingredients from China to improve over time?

A: Probably not. The short answer is, "The Tiger Doesn't Change its Stripes". The reason we say that is that the quality problems in China are deep-seated and often cultural - and cultural items change slowly, if at all.

The managing attorney opines that the "tiger" aphorism may be Chinese in origin. The managing attorney apparently takes this statement to be one about the very nature of Chinese people, rather than applicant's observation about the current state of Chinese manufacturing and the prospects for change. Again, it is not clear that this was applicant's intent. While the reference to "deep-seated and often cultural" quality problems in China might possibly refer to some perceived defect in the character of the Chinese people, it could just as well be a reference to problems in the culture of some manufacturers in a rapidly developing economy (*i.e.*, the "corporate culture"), and applicant's perception that the Chinese government is currently unable to regulate manufacturers so as to provide

reasonable assurance of safety for products such as ingredients for multi-vitamins.¹⁹

In sum, we find that applicant and some others hold strong feelings about the risks allegedly posed by certain products manufactured in China. But we cannot find clear evidence on this record that applicant's motivation is to disparage China.

As discussed, the specific question in considering the second prong of the disparagement analysis is whether the meaning of the mark - *i.e.*, that applicant's nutritional supplements contain no ingredients from China - "may be disparaging to a substantial composite of the referenced group." We have determined that the "referenced group" in this case is the nation of China.

We find little or nothing in this record that would shed light on whether China would find CHINA FREE as used on nutritional supplements to be disparaging. Unlike some other cases, in which we have relied to some extent on dictionary definitions describing a term as "vulgar," *e.g.*, *Boulevard Entm't*, 67 USPQ2d at 1478, or "derogatory," *e.g.*,

¹⁹ Of course, one might easily point out that such criticisms are not unique to China. There has been no shortage of writers vilifying the corporate culture of some sectors of the United States economy in the wake of some well-publicized corporate scandals.

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Heeb Media, 89 USPQ2d at 1076, we have no such evidence in this case. The managing attorney, noting the dictionary evidence of record argues that

[t]he term "FREE" is defined as "relieved from or lacking something and especially something unpleasant or burdensome <free from pain> <a speech free of political rhetoric> - often used in combination <error-free>..." MERRIAM-WEBSTER ONLINE DICTIONARY www.merriam-webster.com/dictionary/free (May 21, 2010). Therefore, the phrase "CHINA FREE" is used to describe a product that is not made in China. It is used to try to placate people's fears about buying a certain product because it is "lacking something unpleasant or burdensome." *Id.* Therefore, consumers reasonably would understand that the wording "CHINA FREE" in the proposed mark refers to the disparaged party, *i.e.* [,] in the People's Republic of China. A reasonable person of ordinary sensibilities would consider this reference offensive or objectionable because the proposed wording "CHINA FREE" implies that there is something negative about retail goods made in China.

Managing Atty. Br. at 5 (citation revised).

As noted, it is undisputed that the term CHINA FREE refers in this case to the fact that applicant's products do not contain ingredients from China. The cited dictionary definition reveals that one possible interpretation of the term is that applicant's goods "lack[] ... something unpleasant or burdensome." And the internet evidence does demonstrate that many consumers view Chinese food and pharmaceutical products with suspicion due to publicized reports of contamination, adulteration and

similar problems. Thus one could conclude that "[a] reasonable person of ordinary sensibilities would consider ... "CHINA FREE" [to] impl[y] that there is something negative about retail goods made in China," although that is not the only possible conclusion.

Even if we accept the managing attorney's proposition, however, it demonstrates only that CHINA FREE says "something negative about *retail goods made in China*." (emphasis added). By contrast, the issue in this case is whether the mark disparages *China* itself, not goods produced there. To the extent that the managing attorney relies on any inherent disparaging meaning in the mark, we note that he has not offered any evidence which tends to suggest that China would consider the mark disparaging. Any such finding on our part would be based entirely on speculation.

We are not naïve, and we suspect that China may not *like* applicant's proposed mark, which may enable purchasers to choose nutritional supplements without ingredients from that country.²⁰ But there is likely a difference between what one may not like and what is disparaging under the

²⁰ We hasten to add, however, that a refusal to register would do nothing to prevent applicant from using these words or others to convey the same information.

Trademark Act. But in any event, our opinion (or that of the managing attorney) is of little relevance. It is no substitute for evidence of the views of the referenced person or group, or at least some evidence from which those views might be reasonably inferred. As the Federal Circuit noted, "[E]ven if the members of this panel personally find the mark BLACK TAIL disgustingly scandalous, the legal conclusion that a trademark comprises scandalous matter must derive from the perspective of the substantial composite." *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 31 USPQ2d 1923, 1926 (Fed. Cir. 1994). As the Board put it:

Although the Court in *In re Mavety Media Group Ltd.* was discussing the public reaction to a scandalous mark, and the present case involves a mark that may disparage a religion or religious figure, the principles expressed by the Court still apply. Thus ... it is imperative that the Board be careful to avoid interposing its own judgment for that of Buddhists.

In re Hines, 32 USPQ2d 1376, 1377 (TTAB 1994) (reversing refusal of BUDDA BEACHWEAR and design as disparaging); see *Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1608 (TTAB 1999) ("We would also add that opposers have provided no evidence, beyond the dictionary definitions themselves, that women in general, or African American women in

particular, believe themselves to be disparaged by the use of BLACK TAIL.").

We are, of course, aware that the Office is limited in the resources it may bring to bear during *ex parte* examination. While the Office cannot, for instance, conduct surveys²¹ in support of a refusal such as the one at issue here, other evidence may exist which provides a reasonable predicate for an *ex parte* determination of the meaning of the mark to "a substantial composite of the referenced group," or in this case, to the referenced person. A number of such indirect sources were of record in *In re Squaw Valley Dev. Co.*, 80 USPQ2d at 1272-75. That record comprised three dictionary definitions, variously noting that "squaw" is "offensive," "-usu. used disparagingly," and that the term "had developed multiple derogatory associations"; several state resolutions and statutes defining "squaw" as an offensive term and replacing its use in place names; statements "attributed to ... Native American activists and of legislators who share the views of such activists," including statements regarding the specific SQUAW VALLEY marks at issue; and a number of articles indicating that many Native Americans

²¹ While not required in a Board proceeding, a well-conducted survey can be highly probative.

found both "squaw" and place names incorporating that term to be highly derogatory. See also *In re Heeb Media*, 89 USPQ2d at 1072 (relying on various publications and on dictionary evidence defining HEEB as a derogatory term for a Jew).

By contrast, the best evidence in this case in support of a finding that CHINA FREE is disparaging to China may be the definition of "free" as meaning, *inter alia*, "relieved from or lacking something and especially something unpleasant or burdensome." But unlike the definitions which were submitted in cases such as *In re Squaw Valley* and *In re Heeb Media*, there is no indication that this term is in itself considered to be derogatory, offensive, or disparaging.²² While we do not rule out the possibility

²² We note, however, that even a dictionary definition indicating that a term is derogatory or offensive may not be sufficient where the term has both offensive and inoffensive meanings:

Even if a standard dictionary definition and its editorial label of vulgar usage show that a substantial composite of the general public would consider the word to be scandalous, we still would hold that based solely on the dictionary sources, the Board erred in this particular case in concluding that the mark BLACK TAIL comprises scandalous matter. ... [I]n addition to the vulgar definitions ..., the standard dictionaries cited ... in this case also set forth non-vulgar definitions ... that are equally applicable.... [T]he Board, without more, erred in concluding that in the context of the [goods,] the substantial composite of the general public would necessarily attach to the mark ... the vulgar meaning ..., rather than the admittedly non-vulgar meaning....

that the term might be used here with the intent to slight China or that it might be perceived by China in such a way, it is also possible that it is not. As the Federal Circuit has emphasized, the touchstone of disparagement is the meaning of the mark to the referenced group. See *In re Mavety Media Group*, 31 USPQ2d at 1926. And whatever we may think of applicant's mark, the opinion of the Office or of this Board is no substitute for evidence (direct or indirect) of the opinion of the relevant individual or group. See *id*; *In re Hines*, 32 USPQ2d at 1377.

V. Conclusion

We have fully considered all of the argument and evidence of record, including any matters which we have not specifically discussed.

This is a difficult case, and not entirely free from doubt. Nonetheless, we conclude that the evidence of record does not support the refusal of registration under Trademark Act § 2(a). As we have noted in the past,

In the absence of evidence as to which of these definitions the substantial composite would choose, the PTO failed to meet its burden of proving that Mavety's mark is within the scope of Section 1052(a) prohibition.

In re Mavety Media Group Ltd., 31 USPQ2d at 1928 (reversing refusal to register BLACK TAIL for adult magazines as scandalous).

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we are inclined to resolve doubts on the issue of whether a mark is scandalous or disparaging in favor of applicant and pass the mark for publication with the knowledge that if a group does find the mark to be scandalous or disparaging, an opposition proceeding can be brought and a more complete record can be established.

In re In Over Our Heads Inc., 16 USPQ2d 1653, 1654-55 (TTAB 1990); *In re Mavety Media Group*, 31 USPQ2d at 1928 ("We ... commend the practice adopted by the Board in another case to resolve the issue whether a mark comprises scandalous matter under Section 1052(a) in favor of [the] applicant and pass the mark for publication with the knowledge that if a group does find the mark to be scandalous ..., an opposition proceeding can be brought and a more complete record can be established." (internal quotation marks omitted)).

We add that our decision does not constitute endorsement or approval of the mark but merely recognizes that the Trademark Act presumes that a mark should be approved for publication in the absence of appropriate evidence that it is not registrable. We note that our decision is without prejudice to any *inter partes* proceeding which might be filed by an aggrieved party. It is possible that we would reach a different result on a

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more complete record such as may be adduced in an *inter partes* proceeding.

Decision: The refusal to register under Trademark Act § 2(a) is reversed.