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GENERAL TRADEMARK INFORMATION:
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EXAMINING ATTORNEY'S APPEAL BRIEF

Jibjab Media, Inc. (hereinafter referred to as "Applicant") has appealed the examining attorney's final refusal to register the proposed mark, A-HOLE PATROL. The application was refused on the grounds that the proposed mark is scandalous within the meaning of Section 2(a) of the Trademark Act, 15 U.S.C. Section 1052(a). The trademark examining attorney respectfully requests that the Board affirm this refusal.

STATEMENT OF FACTS

On August 14, 2006, Applicant, Jibjab Media, Inc. applied to register the mark A-HOLE PATROL as a Collective Membership Mark for services identified as, an "online social club that screens jokes submitted by users to control offensive and inappropriate content." In the first Office Action dated January 16, 2007, the Examining Attorney refused registration under Section 2(a) of the Trademark Act. The first Office Action states that the mark is disparaging and rejected the recitation of services as not identifying a collective membership. The subsequent office actions clarify that the 2(a) refusal was

issued because the wording is scandalous and immoral. Disparagement is not an issue in this case.

In its response filed July 17, 2007, Applicant presented arguments that the mark was not scandalous and amended the recitation of services. Also, on July 19, 2007, Applicant filed an Amendment to Allege Use. On August 1, 2007, the examiner issued an Office Action responding to both the July 17 and the July 19 Responses continuing the 2(a) refusal and refusing the specimen because it did not show use of the mark as a Collective Membership mark. The examiner requested a substitute specimen or in the alternative, that Applicant amends the application to a service mark application and further revises the recitation of services. On September 26, 2007, Applicant amended the application to a service mark and amended the recitation of services, which resolved the specimen issue. On October 18, 2007, the Examining Attorney issued a final refusal under Section 2(a).

On April 18, 2008, Applicant filed a Notice of Appeal and Request for Reconsideration. On May 12, 2008, the Examiner issued an action denying the Request for Reconsideration. The Trademark Trial and Appeal Board resumed the proceedings on June 2, 2008. Applicant filed a request to extent time to file its brief on August 1, 2008. The Board granted the request for an extension and the Applicant filed its brief on September 1, 2008. On September 8, 2008, jurisdiction was restored to the examining attorney.

ISSUE ON APPEAL

Whether applicant's proposed mark, A-HOLE PATROL for "online social club that screens jokes submitted by users to control offensive and inappropriate content" is scandalous and immoral.

ARGUMENTS

A. THE APPLICANT'S MARK IS SCANDALOUS AND IMMORAL UNDER SECTION 2(a) OF THE TRADEMARK ACT.

The applicant's proposed mark A-HOLE PATROL is scandalous and immoral under Section 2(a) of the Trademark Act. A substantial composite of the American public considers the term "A-HOLE" vulgar. It is an abbreviated form of the vulgar term "asshole."

Section 2(a) of the Trademark Act, 15 U.S.C. §1052 (a) states:

> 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--consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute;

The Federal Circuit has determined that showing a word is vulgar is sufficient to meet the scandalous and immoral requirements under Section 2(a). In *In re Boulevard Entertainment, Inc.*, *334 F.3d at 1336, 67 USPQ2d 1475, 1477 (Fed. Cir. 2003),* the Federal Circuit determined:

> that to justify refusing to register a Trademark under the first clause of section 1052(a), the PTO must show that the mark consists of or comprises "immoral, deceptive, or scandalous matter." *In re Mavety Media Group, Ltd*., 33 F.3d 1367, 1371 (*Fed. Cir.* 1994). A showing that a mark is vulgar is sufficient to establish that it "consists of or comprises immoral … or scandalous matter" within the meaning of section 1052(a). *See id. At 1371-74* (analyzing a mark in terms of "vulgarity"); *In re McGinley, 660 F. 2d 481, 485 (CCPA 1981)* (quoting with approval *In re Runsdorf, 171 USPQ 443, 443-44 (TTAB 1971)*, which refused registration of a mark on grounds of vulgarity). In meeting its burden, the PTO must consider the mark in the context of the marketplace as applied to the goods described in the application for registration. *McGinley, 660 F.2d at 485.* In addition, whether the mark consists of or comprises scandalous matter must be determined from the standpoint of a substantial composite of the general public (although not necessarily a majority), and in the context of contemporary attitudes, id., keeping in mind changes in social mores and sensitivities. *Mavety, 33 F.3d at 1371*.

Although the words “immoral” and “scandalous” may have somewhat different connotations, case law has included immoral matter in the same category as scandalous matter. *See In re McGinley*, 660 F.2d 481, 484 n.6, 211 USPQ 668, 672 n.6 (C.C.P.A. 1981), *aff’g* 206 USPQ 753 (TTAB 1979) (“Because of our holding, *infra*, that appellant’s mark is ‘scandalous,’ it is unnecessary to consider whether appellant’s mark is ‘immoral.’ We note the dearth of reported trademark decisions in which the term ‘immoral’ has been directly applied.”) TMEP §1203.01. The statutory language “scandalous” has also been considered to encompass matter that is “vulgar,” defined as “lacking in taste, indelicate, morally crude.” *In re Runsdorf,* 171 USPQ 443, 444 (TTAB 1971) see also TMEP §1203.01.

Under Section 2(a), to be considered “scandalous,” a mark must be “shocking to the sense of truth, decency or propriety; disgraceful; offensive; disreputable; … giving offense to the conscience or moral feelings; … [or] calling out for condemnation.” See *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994). Whether a term is scandalous 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.

In support of this refusal, the examiner’s first Office Action included a definition of “a-hole” from the urbandictionary.com to prove that the term is commonly used in place of the term “asshole.” The Urbandictionary.com defined the term as “a polite, inoffensive manner to refer to someone as an asshole.” In addition, the examiner’s Response to the Applicant’s Request for Reconsideration included an excerpt from the

Forbidden American English book by Richard Spears, which defines “a-hole” as “asshole.” It was also note that The Forbidden American English book placed the term among a list of terms that is “usually uttered with an intention of punishing or hurting” [Examiner’s Response to Request for Reconsideration].

The examiner also included three dictionary definitions of the term “asshole,” demonstrating that the term is vulgar. Two of the definitions are from standard dictionaries:

1) asshole: Vulgar Slang. 1. The anus. 2. A thoroughly contemptible, detestable person (see the attached from the American Dictionary of the English Language).

(2) asshole: 1. usually vulgar: ANUS 2. a stupid, incompetent, or detestable person b. usually vulgar: the worst place – usually used in the phrase “asshole of the universe” (see the attached from Merriam-Webster Dictionary).

(3) asshole: 1. (vulgar) anus. 2. a contemptible or stupid. 3. (slang) the worse part of a thing or place. (see the attached from www.wordsmyth.net/live/home.

Dictionary evidence 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. TMEP §1203.01; *see In re Boulevard Entm’t, Inc.*, 334 F.3d at 1336, 67 USPQ2d at 1475 (holding the wording 1-800-JACK-OFF and JACK OFF scandalous where all dictionary definitions of “jack-off” were considered vulgar); *In re Tinseltown, Inc.*, 212 USPQ 863 (TTAB 1981) (holding the wording BULLSHIT scandalous where multiple dictionary definitions showed the primary definition is vulgar).

In addition, the examiner attached excerpts from newspaper articles gathered from the Lexis database demonstrating use of the term “a-hole” as a substitute for asshole as well as article that indicate the term “asshole” is considered scandalous and immoral by a

substantial composite of the American public. For example, an article in the *Chicago Reader*, dated September 17, 2004 (attached to the final Office Action) demonstrates that a substantial composite of the American public considers the term asshole a scandalous and immoral term. The article quoted a proposed Congressional bill, which listed asshole among a list words considered profane language:

> Commissioner Copps has been calling for broadcasters to create a new code of ethics to replace the old one. Other decency watchdogs feel the industry can no longer be trusted to police itself. Last year, after Bono declared Gangs of New York "fucking brilliant" on the Golden Globes, Republican congressmen Doug Ose of California and Lamar Smith of Texas introduced a bill that would define profane language where it had never been defined before--in Title 18 of the U.S. Code--using an expanded version of [George Carlin]'s list. It could well be the filthiest piece of legislation ever drafted: "As used in this section, the term 'profane,' used with respect to language, includes the words 'shit,' 'piss,' 'fuck,' 'cunt,' 'asshole,' and the phrases 'cock sucker,' 'mother fucker,' and '**ass hole,**' compound use (including hyphenated compounds) of such words and phrases with each other or with other words or phrases, and other grammatical forms of such words and phrases (including verb, adjective, gerund, participle, and infinitive forms)." (Emphasis added).

Along the same lines, a *New Times* article, dated September 21, 2000 (see the final Office Action dated October 18, 2007), confirmed the fact that newspapers in America resist printing the term asshole. The article stated:

> The News and the Post sometimes drew upon the very same syndicated columnists; during the test week, they published separate treatises by venerable ex-Nixon speechwriter William Safire, and both featured a Maureen Dowd tweak of George W. Bush following his identification of New York Times reporter Adam Clymer as a "major-league asshole." (This snicker-worthy subject was also tackled by Richard Reeves, Cal Thomas, new Roger Ebert sidekick Richard Roeper, Tony Kornheiser and Post editorial page editor Sue O'Brien, who joked about newspapers willing to print the words "**ass" and "hole**" separately but being too timid to put them together.

Like the reluctant newspapers, although the Trademark Office has registered the term "ass," neither the term "asshole" nor any rendition of it, e.g., "a-hole" are registered.

Applicant admits that the term asshole in articles and song lyrics is vulgar, but argues that its mark is not "Asshole Patrol" (Applicant's brief, page 3). Applicant argues the terms a-hole and asshole are "distinguishable when it comes to social acceptance and contemporary attitudes" (Applicant's Request for Reconsideration, Page 3). However, in its Request for Reconsideration, Applicant states that it "does not dispute that the term "a-hole" can have a negative connotation, namely, that it can refer to a person as a jerk" (Applicant's Request for Reconsideration, page 2). Yet, Applicant argues "a-hole" is not offensive pointing to the Urbandictionary.com's statement that "a-hole" as a "polite" substitute for the term "asshole." Applicant concludes that a "polite" term therefore cannot be scandalous.

When the first Office Action was issued on January 16, 2007, there were two entries for the word "a-hole" in the Urban Dictionary. The first entry was the definition upon which the Applicant builds his case, that the term is a "polite, [in]offensive manner to refer to someone as an asshole" (Applicant's Brief, page 2). On the contrary, when the examiner issued the final action on October 18, 2007, the Urban Dictionary had several entries for the word "asshole" (see the final Office Action dated October 18, 2007) that strongly indicate the term is scandalous. The second entry defined asshole as "an annoying and obnoxious person;" the third entry defined asshole as "a real prick, a jiving, slippery mother f* who really rubs humanity the wrong way;" and the sixth entry defined asshole as "a person so useless that nothing good ever comes out of them. In fact, the only thing that ever does come out of them is shit" (See the final Office Action dated October 18, 2007). Thus, the same dictionary that rendered "a-hole" a polite and inoffensive way to refer to someone as an asshole at the same time rendered "asshole" as

"a person who is so useless that NOTHING good ever comes out of them" (emphasis added) *Id*, "a prick, a jiving, slippery mother f*" and an "annoying and obnoxious person" *Id*. It is arguably counterintuitive to politely refer to someone as an asshole, given the scandalous nature of the term. The Urban Dictionary is a slang dictionary of words composed by ordinary people who submit definitions. For example, each entry shows the name or screen name of the person who entered the definition along with the date of entry (See the Urban Dictionary excerpts submitted with the final Office Action, dated October 18, 2007). Since the Urban Dictionary is a non-standard dictionary, it is constantly updated as demonstrated by the differences in the entries over the nine month period between the first and final Office Actions. Therefore, the Applicant's total reliance on one definition from the Urban Dictionary submitted with the first Office Action must be balanced by the other entries in that same dictionary as well as the entries from the standard dictionaries cited above, e.g., the American Dictionary of the English Language and Merriam Webster.

In further support of its argument, Applicant submitted what it contends is evidence that the term a-hole is readily acceptable in today's society. For example, use of the term by Jay Leno and best selling author Robert Sutton, as well as the popular NBC Sketch featuring the two characters know as a "Two A-holes" (Applicant's brief, page 7). Contrary to the Applicant's argument, there is no evidence that the term "a-hole" is considered polite by the American public. The substitution by Leno and NBC of "a-hole" in place of "asshole" does not change the vulgar connotation. Although it is a different way of saying asshole, it has the same connotation and meaning. There is no alternative non-scandalous meaning for the term "a-hole.'" It means asshole, which is

vulgar. 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).

In a case similar to the case at bar, *In re Daniel Zaharoni, 2005 TTAB Lexis 3, (January 4, 2005, not precedent),* the TTAB affirmed the refusal of "THE COMPLETE A**HOLE'S GUIDE TO . . ." for a "series of books providing information relating to advice, counseling, self-help, and humor," under Section 2(a)**,** on the ground that applicant's mark comprises immoral or scandalous matter. The facts of the *Zaharoni* case are highly similar to the case at bar. Although *Zaharoni* is not precedent, it is nonetheless instructive. Applicant, Zaharoni, agreed that most readers would infer that the term "a**hole" refers to the word "asshole," but that use of the term "a**hole" reflects "a concerted effort by Applicant, and by others that use the term, to present a 'cleaned up,' non-scandalous alternative for the word 'asshole.'" *In re Daniel Zaharoni, 2005 TTAB Lexis 3, 5 (January 4, 2005).* The Board determined "obviously, if 'asshole' were not vulgar, there would be no need or an alternative." *Id* at 9. Further, the Board was not convinced that the term a**hole was either cleaned-up or non-vulgar. "The fact that the

term "a**hole" appears in articles at various Internet websites does not persuade us that the public would regard the term as non-scandalous. It is common knowledge that all types of material appears on the Internet, some of it scandalous in nature. Thus, the mere appearance of the term "a**hole" on the Internet says nothing about how the public would regard the term. There is no evidence in this record that the term "a**hole" has appeared in general interest publications that are widely distributed to the public." [*Id* at 10] The determination of whether a mark is scandalous must be made in the context of the relevant marketplace for the goods or services identified in the application, and must be ascertained from the standpoint of not necessarily a majority, but a "substantial composite of the general public." *In re McGinley*, 660 F.2d at 485, 211 USPQ at 673.

In this case, "a-hole" is synonymous with the scandalous and immoral term "asshole." In fact, in the context of the Applicant's mark, it is clear that the term "a-hole" is intended to carry the commonly accepted and vulgar meaning of "asshole." The Applicant intends to refer to persons who place offensive and inappropriate material on the Jibjab website as assholes. Thus, Applicant calls its screeners, the A-Hole Patrol, because they patrol the website for entries by people deemed as assholes for the subject matter they submit.

Applicant contends through Tom Gillons, Director of Operations of Jibjab that out of the approximately 40,000 user support emails from the Jibjab online community, none have ever complained that "the mark is viewed as offensive, vulgar, profane, indecent, or otherwise inappropriate." (See Declaration of Mr. Gillons). The absence of complaints does not establish that the term is not offensive or disparaging to members of applicant's online community. Applicant admitted in its brief that membership in the A-hole Patrol

is voluntary and therefore, "[i]f any member believed the term was disparaging to them, they always have the option of not joining or withdrawing from the club." [Applicant's brief, page 10]. The fact that an offended person could withdraw from the community without making a complaint, provides one reasonable explanation as to why Mr. Gillons has never encountered any user complaints about the mark.

The more egregious the allegedly scandalous nature of a mark, the less evidence is required to support a conclusion that a substantial composite of the general public would find the mark scandalous. *See In re Wilcher Corp.*, 40 USPQ2d 1929, 1934 (TTAB 1996) (finding that "the inclusion in a mark of a readily recognizable representation of genitalia certainly pushes the mark a substantial distance along the continuum from marks that are relatively innocuous to those that are most egregious"); TMEP §1203.01.

For example, in, *Boston Red Sox Baseball Club Limited Partnership v. Brad Francis Sherman*, Opposition No. 91172268 (September 9, 2008) [precedent], sustaining the Red Sox Club's opposition to proposed mark **SEX ROD** in the stylized form for clothing items (including infant wear, baby bibs, and girdles), the Board found that the mark was both scandalous and disparaging under Section 2(a). The Opposer, the Club, submitted that the slang usage of the term "rod" was vulgar because it referred to the male "penis." Brad Francis Sherman argued that the mark "represented the at once clever yet sophomoric sense of humor that prevails in those venues in which apparel bearing the SEX ROD stylized mark would likely be worn, e.g., ball parks, sports bars and university campuses." *Id*. The TTAB determined "even assuming for the sake of argument that 'SEX ROD' is a parody of the opposer's 'RED SOX' marks, as applicant asserts – there is nothing in the parody itself which changes or detracts from the vulgar meaning

inherent in the term. In other words, the parody, to the extent there is one, is itself vulgar." *Id.* Here, as in the *SEX ROD* case, there is nothing in the context of the Applicant's use of the term "A-Hole" which changes or detracts from the vulgar meaning inherent in the term. The slang version of the term "asshole" is no less vulgar than the term "asshole" itself.

B. THIRD PARTY REGISTRATIONS ARE NOT PERSUASIVE

In support of registration, Applicant presented evidence of several registrations with terms that it argues are offensive. Each case is decided on its own facts, and each mark stands on its own merits and prior decisions and actions of other examining attorneys in registering different marks are without evidentiary value and are not binding upon the Office. *AMF Inc. V. American Leisure Products, Inc., 177 USPQ 268, 269 (CCPA 1973); In re International Taste, Inc., 53 USPQ 2d 1604 (TTAB 2000).* Although, the third party registrations are without evidentiary value and not binding upon the Office, the examiner notes that none of the registered marks submitted by the Applicant contain the word "a-hole" or "asshole." This underscores the scandalous nature of both terms. While maybe neither "ass" nor "a" standing alone is scandalous, both combined with "hole" are scandalous and immoral.

CONCLUSION

For the foregoing reasons, refusal on the grounds that the proposed mark is scandalous and

immoral within the meaning of Section 2(a) of the Trademark Act, 15 U.S.C. Section 1052(a) should be upheld. The trademark examining attorney respectfully requests that the Board affirm this refusal.

Respectfully submitted,

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