

## Can the PTO Find Its Way with Jesus?

Lee B. Burgunder

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# CAN THE PTO FIND ITS WAY WITH JESUS?

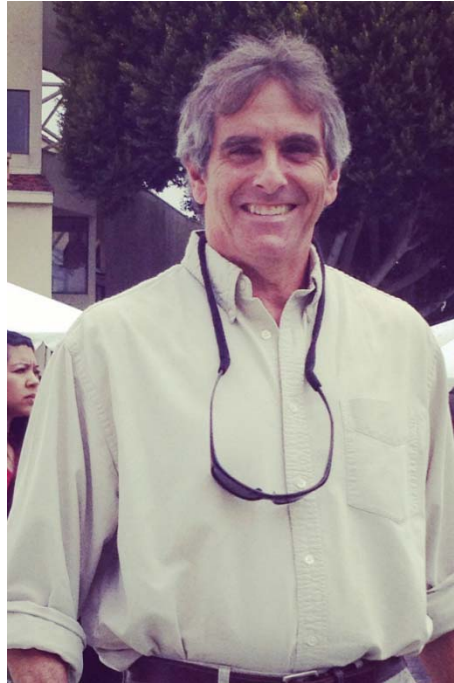
LEE B. BURGUNDER\*

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## INTRODUCTION

Recently, several newspapers and media sources reported that an Italian apparel company had registered the word “Jesus” as a trademark in the United States for clothing and other goods, and was wielding its trademark as a weapon against other companies that were seeking rights to use the name of Jesus with their wares.<sup>1</sup> For instance, among other actions, the company filed oppositions to prevent trademark registrations for *Jesus First*, *Sweet Jesus*, *JesusUp* and *Jesus Couture*, which in each instance was enough for the applicants to give up without a fight.<sup>2</sup> One company, though, with an application for *Jesus Surfed*, initially decided to hold its ground by challenging the opposition and calling for the cancellation of the JESUS mark due to disparagement.<sup>3</sup> This article argues that the Patent and Trademark Office (“PTO”) made the correct call regarding disparagement in this instance. However, the agency was wrong to grant one company the power to exercise excessive control through trademarks over use of the word “Jesus” on products, such as t-shirts, that are often used to portray an owner’s personality, preferences or emotions (hereinafter called “expressive products”).<sup>4</sup> The article also explains that the PTO has been too quick to sanction other phrases that include “Jesus” within them, and should

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1. See, e.g., Jacob Gershman, *If You Take These Jeans’ Name in Vain, Prepare to Meet Their Maker*, WALL. ST. J., Feb. 25, 2013, <http://online.wsj.com/news/articles/SB10001424127887324432004578302060560501092>; Billie Hollowell, *What are ‘Jesus Jeans’ and Why Are They Sparking Legal Battles in (and Over) Christ’s Name?*, THE BLAZE, (Aug. 31, 2014), <http://www.theblaze.com/stories/2013/02/25/what-are-jesus-jeans-and-why-are-they-sparking-legal-battles-in-and-over-christs-name/> (last visited Mar. 17, 2014).

2. Information on these selected oppositions can be found on the Patent and Trademark Office website ([www.uspto.gov](http://www.uspto.gov)) by searching for the respective trademark application serial numbers: *Jesus First* (SerialSee, JESUS FIRST, Registration No. 76703629; SWEET JESUS, Registration No. 77628334; JESUS UP, Registration No. 85139476; JESUS COUTURE, Registration No. 77709224).

3. Michael J. Anton filed an intent-to-use application for “Jesus Surfed” on bandanas, hats, sweatshirts and t-shirts on May 30, 2012. U.S. Trademark Application Serial No. 85638044 (filed May 30, 2012). The PTO published the application for opposition on October 30, 2012, and Jesus Jeans S.R.L. (the current owner of the JESUS trademark) filed an opposition on February 20, 2013. *Jesus Jeans S.R.L. v. Anton*, No. 91209383 (T.T.A.B. Apr. 1, 2013). On April 1, 2013, Anton filed an answer to the opposition and a counterclaim requesting that the PTO cancel the registration for JESUS. *Id.* The parties jointly filed a motion to stay proceedings on November 6, 2013 on the grounds that they had entered settlement negotiations. *Id.* The Trademark Trial and Appeal Board (hereinafter “T.T.A.B.”) granted the motion to stay proceedings on December 2, 2013. *Id.* On February 8, 2014, the parties submitted a stipulation with the T.T.A.B., indicating that Anton had agreed to withdraw his trademark application for *Jesus Surfed*. *Id.* Accordingly, as part of the settlement, Jesus Jeans S.R.L. also dismissed its opposition and Anton dismissed its counterclaims to that opposition. *Id.* Subsequently, on July 7, 2014, Anton filed a new application for *Jesus Surfed* for “online retail services featuring religious and themed apparel.” U.S. Trademark Application Serial No. 86329975 (filed Jul. 7, 2014).

4. Besides t-shirts, examples of expressive products include baseball caps, mugs, bumper stickers, and refrigerator magnets, among others.

start requiring proof of secondary meaning before registering them as standard character marks for expressive products.<sup>5</sup>

### I. HOW DID ANYONE BESIDES JESUS GET A REGISTRATION FOR JESUS?

The PTO has been registering trademarks that include the word “Jesus” since the 1960’s for all kinds of merchandise, including expressive products, which are the focus here.<sup>6</sup> A quick trademark search shows that there currently are over 500 live applications or registrations for such marks.<sup>7</sup> The Lanham Act actually prevents registration of matter that may “falsely suggest a connection with persons, living or dead.”<sup>8</sup> This provision is primarily intended to align federal registration principles with publicity and sponsorship rights.<sup>9</sup> Although

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5. A standard character mark provides protection to the words, letters or numbers without regard to how they might be displayed, such as with specific fonts, colors, arrangements or additional design elements. Stylized (or design) marks, on the other hand, cover a representation of the characters in a specified format. *See Representation of the Mark*, US PATENT & TRADEMARK OFFICE, <http://www.uspto.gov/trademarks/basics/mark.jsp> (last modified December 14, 2011). For this reason, stylized design marks may be immediately distinctive, due to the unique design, even when the included characters do not adequately serve identification functions by themselves. *See, e.g., In re Jackson Hole Ski Corp.*, 190 U.S.P.Q. 175 (T.T.A.B. 1976). For a thorough discussion of registration principles for stylized marks, *see In re Sadoru Group, Ltd.*, 105 U.S.P.Q.2d 1484 (T.T.A.B. 2012). Thus, although this article argues that companies need to demonstrate secondary meaning before obtaining registration for Jesus-related trademarks on expressive products, they still could get immediate protection for distinctive stylized or design marks, as long as the standard characters are disclaimed in the application from coverage. TRADEMARK MANUAL OF EXAMINING PROCEDURE §1213 (5th ed. Sept. 2007) [hereinafter TMEP].

6. The first registered mark incorporating the word Jesus that is listed on the PTO website was REORGANIZED CHURCH OF JESUS CHRIST OF LATTER DAY SAINTS. REORGANIZED CHURCH OF JESUS CHRIST OF LATTER DAY SAINTS, Registration. No. 0808988. As of August 19, 2014, the PTO had received 1773 applications for marks referencing Jesus. This Information was determined by using the Trademark Electronic Search System (“TESS”) on the PTO’s website at <http://www.uspto.gov>.

7. As of August 19, 2014, TESS indicated 586 live applications and registrations referencing the word, Jesus. *Id.*

8. Lanham Act, 15 U.S.C. § 1052(a) (2006).

9. State laws protect publicity rights under the common law or governing statutes. The basic purpose of publicity rights is to protect the economic interests that famous individuals create through their personal achievements. *See, e.g., Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 575–76 (1977); *Memphis Dev. Found. v. Factors Etc., Inc.*, 616 F.2d 956, 957 (6th Cir.) *cert. denied*, 449 U.S. 953 (1980). Thus, the right is intended to prevent members of the public from obtaining unjust enrichment by appropriating the commercial value of a person’s identity. *Zacchini*, 433 U.S. at 581 n.2. Similarly, the Lanham Act prevents the use of any name that is likely to cause confusion as to the sponsorship of goods or services. Lanham Act 15 U.S.C. § 1125(a)(1)(A) (2006). The bar on registering recognizable names logically prevents an individual from staking a claim to a trademark when use of that mark would interfere with someone else’s publicity or sponsorship rights. *See, Lee B. Burgunder, Opportunistic Trademarking of Slogans: It’s No Clown Issue, Bro*, 31 *Cardozo Arts & Ent. L. J.* 769, 784–85.

the PTO, in theory, might have attempted to use this clause to prevent registration for all uses of the term “Jesus,” it has chosen to not do this, presumably because few people would believe that Jesus or his heirs have endorsed the products bearing his name.<sup>10</sup> For the same reasons, the PTO has allowed registrations for the names of other historically famous figures, such as MADONNA,<sup>11</sup> DA VINCI,<sup>12</sup> REMBRANDT,<sup>13</sup> and BEETHOVEN.<sup>14</sup>

The PTO considers several factors when it reviews trademark applications, including those for Jesus-related marks. First, it considers if the word “Jesus,” by itself or with other terms, is generic for the product in question. As an analogy, the agency would not register the single word “shirt,” for a shirt because the term is generic for the product. The rationale for the denial is that a generic word cannot be a distinctive indicator of source.<sup>15</sup> Rather, consumers will understand it as the name of the product class.<sup>16</sup> Additionally, allowing one company to obtain exclusive rights to a generic term would be economically unfair to competitors since they would have to overcome the barrier of informing customers that they sell equivalent products.<sup>17</sup> Trademarks, after all, are only intended to streamline the search process for consumers without providing inherent competitive advantages.<sup>18</sup> Thus, the PTO might take issue with an application for “Jesus” if it were to serve as a

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10. Cf. *Comedy III Prod. Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 802 (Cal. 2001) (stating that the right of publicity is invoked when the appropriation of a celebrity’s likeness creates a misleading impression that the celebrity is endorsing a product). Michael Anton alleged in his counterclaim to Jesus Jeans S.R.L.’s opposition that the JESUS mark should be cancelled because it falsely suggests a connection with the teachings of Jesus Christ and Christianity. *Jesus Jeans S.R.L. v. Anton*, No. 91209383 (T.T.A.B. Apr. 1, 2013). This argument misconstrues the purpose of the statutory limitation, and it is not discussed further in this article.

11. E.g., MADONNA, Registration No. 3545635 (for wine); MADONNA, Registration No. 1473554 (for entertainment services).

12. E.g., DA VINCI, Registration No. 3989906 (vaporizers); DA VINCI, Registration No. 85191249 (for film and photograph editing software and hardware).

13. E.g., REMBRANDT, Registration No. 2806648 (for cheese); REMBRANDT, Registration No. 71210631 (for artists’ colors).

14. E.g., BEETHOVEN, Registration No. 3905515 (for pesticides); BEETHOVEN, Registration No. 85292575 (for jewelry).

15. E.g., *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (A generic term refers to the genus of which a particular product is a species).

16. E.g., Lee B. Burgunder, *Trademark Protection of Live Animals: The Bleat Goes On*, 10 J. MARSHALL REV. OF INTELL. PROP. L., 715, 721 (2011).

17. E.g., *Abercrombie*, 537 F.2d at 10 (stating that protection of generic terms “must be denied since this in effect would confer a monopoly not only of the mark, but of the product by rendering a competitor unable effectively to name what it was endeavoring to sell.”); *W. T. Rogers Co., Inc. v. Keene*, 778 F.2d 334, 339 (7th Cir. 1985) (claiming that trademark protection for a generic word would impair competition by allowing the trademark holder to monopolize a scarce input).

18. See, e.g., Lee B. Burgunder, *Trademark Protection of Smells: Sense or Nonsense*, 29 AM. BUS. L. J. 459, 465 (1991).



trademark for, let say, a baby Jesus doll. However, the PTO assumes that “Jesus” is not the generic term for the usual array of expressive products, and therefore doesn’t raise the issue in the application process.<sup>19</sup>

The PTO also does not immediately register descriptive terms because customers at first understand them as descriptions of the products rather than as designators of source.<sup>20</sup> Thus, it would initially refuse registration of the term “Wrinkle-Free-Tee” for a no-iron t-shirt because, when first used, it primarily describes the product. In addition, registration might disadvantage some competitors since there is a limited supply of equally effective descriptive terms.<sup>21</sup> Over time though, due to factors like exclusive use and advertising, customers might begin to understand that “Wrinkle-Free-Tee” represents a particular source of no-iron t-shirts.<sup>22</sup> In this way, it has acquired an additional meaning beyond the description, which is as a designator of product source.<sup>23</sup> In this event, the word is said to have attained “secondary meaning” and thereby satisfies the appropriate function of a trademark.<sup>24</sup> Under these circumstances, customers might become confused if other companies were then permitted to use the term because it now has source-designating qualities.<sup>25</sup> Although registration would provide a company with exclusive rights to one of the few good ways to describe the product, the dangers from source confusion outweigh the potential negative effects on competitors, which still would have several other descriptive terms at their disposal.<sup>26</sup> Thus, the PTO will register descriptive terms, but only after the applicant proves secondary meaning.<sup>27</sup>

19. This article will later argue that the single word, Jesus, should be treated as a generic or common descriptive term for Jesus-related merchandise, such as shirts that express statements about Jesus, thus providing one reason the agency was wrong to register Jesus S.R.L.’s trademark so broadly. See *infra* notes 168–70, and accompanying text.

20. E.g., Lee B. Burgunder, *The Scoop on Betty Boop: A Proposal to Limit Overreaching Trademarks*, 32 Loy. L.A. ENT. L. REV. 257, 271 (2012). The Lanham Act prevents the registration of marks that are merely descriptive of the applicant’s goods. Lanham Act, 15 U.S.C. §1052(e) (2006).

21. See, *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1430 (7th Cir. 1985); William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 290 (1987).

22. E.g., *G. & C. Merriam Co. v. Sallfield*, 198 F. 369, 373 (6th Cir. 1912), *cert. denied*, 243 U.S. 651 (1917).

23. See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211 (2000) (stating that the phrase “acquired meaning” might be more appropriate than “secondary meaning”, which is the conventional terminology).

24. See, e.g., *id.*; *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982) (stating that secondary meaning develops when “in the minds of the public, the primary significance of a product feature or term is to identify the source of a product rather than the product itself.”).

25. E.g., Burgunder, *supra* note 20, at 272.

26. See, e.g., *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 13–14 (2d Cir. 1976)

27. The Lanham Act provides that merely descriptive terms may be registered when the mark

Regarding the word “Jesus,” the PTO again apparently takes the position that the term does not describe the qualities of a shirt or mug and so does not consider descriptiveness to be a barrier to registration.<sup>28</sup>

Although use of the term “Jesus” may not be generic for, or descriptive of typical expressive products, applicants also must prove that their use is distinctive from previous trademark registrations or uses of the term.<sup>29</sup> Since the PTO has approved dozens of registrations for phrases using the word Jesus on expressive products, a major hurdle for an applicant is convincing examiners that consumers would perceive the proposed use of “Jesus” as distinctive from existing uses of the name. In this regard, the sheer number of uses has worked to the advantage of applicants, since consumers are forced by such pervasiveness to primarily rely on elements besides the word Jesus to distinguish similar products in the marketplace.<sup>30</sup> For this reason, the PTO might be willing to register both JESUSROCKS and JESUSRULES for similar products, despite the common uses of the word “Jesus,” because consumers will tend to ignore that overlap and focus instead on the other words to distinguish source.<sup>31</sup>

This background leads to a surprising story about how a firm registered JESUS in the United States for numerous kinds of clothing, including pants and

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has become distinctive of the applicant’s goods. Lanham Act, 15 U.S.C. § 1052(f) (2006). The Act provides that the PTO may accept as proof of secondary meaning that the mark has been used exclusively and continuously by the applicant for five years. *Id.*

28. The author in his investigation of trademark registrations for phrases involving Jesus on expressive products could not find an instance in which the PTO denied registration because the word was descriptive or the applicant had not demonstrated secondary meaning. For instance, the applicant requesting registration for *Jesus Surfed* filed the application on May 30, 2012, and the PTO approved the phrase for registration just five months later without any inquiry into descriptiveness or secondary meaning. JESUS SURFED, Registration No. 85638044. Similarly, the application for *Jesus Up* was filed on September 28, 2010 and the PTO approved the mark for publication in about five months without raising any questions about the capacity of the phrase to designate source. JESUS UP, Registration No. 85139476.

29. Lanham Act, 15 U.S.C. § 1052(d) (2006).

30. TMEP §1207.01(d)(iii) (Third-party registrations may be relevant to show that the mark or a portion of the mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services); TMEP §1207(b)(iii) (Additions to marks may be sufficient to avoid a likelihood of confusion if the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted).

31. See *In re Hamilton Bank*, 222 U.S.P.Q. 174 (T.T.A.B., 1984) (stating that the reason that so many marks incorporating “KEY” have been registered for financial products is because the remaining portions of the various marks are sufficient to distinguish between the marks.). When separate marks both include the same weak or generic word, courts do not totally ignore the shared word when conducting a likelihood of confusion evaluation because the common usage may contribute to the marks’ similarity along with other factors, such as similarities in sound and meaning. *E.g.*, *AMF Inc., v. Sleekcraft Boats*, 599 F.2d 341, 351–52 (9th Cir. 1979).

t-shirts.<sup>32</sup> An Italian business that sold Jesus Jeans obtained a community trademark registration in the European Union for the sole word “Jesus” as applied to a wide spectrum of merchandise, although the applications were rejected in several countries, including Britain.<sup>33</sup> In 1999, the firm applied to obtain trademark rights in the United States based on the European registration.<sup>34</sup> The advantage of this process is that the foreign company did not have to demonstrate use in the U.S. to receive the initial registration, as long as it complied with all the other requirements, such as proving distinctiveness.<sup>35</sup> The PTO at first denied the registration due to the likelihood of confusion with several other previous registrations of marks that include the word “Jesus” for similar kinds of products.<sup>36</sup> However, the company ultimately convinced the PTO that the use of “Jesus” was so pervasive and diluted that it should essentially be ignored when comparing uses for similarities and potential confusion.<sup>37</sup> It claimed that its ownership of “Jesus” would be a “satisfactory addition to the already robust field of Jesus marks already peacefully coexisting in the clothing field.”<sup>38</sup> After reviewing this argument, the PTO approved the registration in 2007.<sup>39</sup> It was not until 2012, when the company had to demonstrate use of the mark in the United States, that the PTO first saw a specimen, which showed use of the word “Jesus” on Jesus Jeans.<sup>40</sup> By that time, the original applicant had assigned the trademark to Jesus Jeans S.R.L.

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32. Information about the history of the JESUS mark can be found on the PTO website at [www.uspto.gov](http://www.uspto.gov). JESUS, Registration No. 3232057. The PTO first registered the mark in 2007 for an extremely large range of apparel, but the list of products was reduced in 2012 according to a section 8 Declaration. The registration now applies to jackets, vests, shirts, t-shirts, pants, shorts, skirts and belts. The registration also claims the trademark as a typed drawing, which is the format used to specify a standard character mark in applications filed prior to November 2, 2003. *See* TMEP § 807.03(i).

33. Foreign Reg. No. 0618251 (Benelux Trademark Office, Dec. 15, 1997). An article in the *Wall Street Journal* stated that the application for JESUS was denied in Britain, although the country is a member of the European Union, because the registration is morally offensive to the public. Gershman, *supra* note 1. That article also indicates that applications have also been rejected in Norway, Switzerland, Australia, and China, among other countries. *Id.*

34. The original U.S. application was filed on December 7, 1999 based on section 44E of the Lanham Act. Lanham Act, 15 U.S.C. § 1126(e) (2006).

35. Under section 44E, a mark can be registered in the U.S., if otherwise eligible, based on a certified copy of a registration in a foreign country. *Id.*

36. U.S. Trademark Application Serial No. 75866210 (filed Dec. 7, 1999).

37. Basic Trademark S.A., *Supplemental Response to Office Action*, Serial No. 75866210 (Aug. 13, 2004).

38. *Id.* at 2.

39. The PTO published the mark for opposition on September 27, 2005 and registered the mark based on the foreign registration on April 24, 2007. *Supra* note 36.

40. A trademark registrant must file a declaration during the fifth year after registration that the mark is in use in U.S. commerce and must submit a specimen showing current use. Lanham Act, 15 U.S.C. § 1058(a) (2006). The specimen was a screen shot of the company’s web page, showing, among other items, use of the JESUS mark on jeans.

The PTO's decision to register the sole word "Jesus" as a trademark based on the dilution argument was an error that the agency probably now regrets. As just noted, several companies may use marks that include the same weak elements without creating a likelihood of confusion because consumers will rely on the other attributes to make the necessary distinctions in the marketplace. This is the reason, for example, that the PTO has registered PEPSI-COLA<sup>41</sup> and COCA-COLA,<sup>42</sup> despite the overall similarities created by the overlapping uses of cola. Of course, in this instance, a company could not register the word "cola" by itself, because the word is generic for soda. However, other times, the shared word may not be considered generic, but rather simply weak because it is often used, or closely associated, with particular products.<sup>43</sup> The question, then, is whether it might be acceptable to allow a registration in these circumstances for the common weak term alone.

There is at least one precedent in which the PTO did this, when it allowed a company to register the word "plus" for vitamins, food supplements, and pet products.<sup>44</sup> Despite this registration, the PTO has registered numerous other marks in the same fields that include "plus," on the grounds that the combined terms make a different commercial impression than the singular word.<sup>45</sup> The expectation, of course, was that the owner of the PLUS trademark would not challenge any use that included other elements besides the word "plus."<sup>46</sup>

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41. PEPSI-COLA, Registration No. 0824151.

42. *E.g.*, COCA-COLA, Registration No. 1752201.

43. *See, e.g.*, *Plus Products v. Redken Labs., Inc.*, 199 U.S.P.Q. 111 (T.T.A.B. 1978) (stating that "plus" is a dictionary word that is highly suggestive of something better, and that purchasers, upon encountering the word, would attribute to the term its ordinary dictionary meaning); *In re Hamilton Bank*, 222 U.S.P.Q. 174, 177 (T.T.A.B., 1984) (stating that "key" is a weak element in marks for financial industry participants because it is suggestive of the prominence and control that customers seek.).

44. PLUS, Registration No. 183787. In another instance, the PTO examiner refused to allow a company to register the sole word "KEY" for financial services because numerous other companies already had registrations for marks that combined the word "key" with other words, such as BANKEY, BLUE KEY, KEYLINE, KEYPHONE and GOLDEN KEY PASS-BOOK ACCOUNT. On appeal, the T.T.A.B. determined that confusion was not likely and ordered that the mark be registered. *In re Hamilton Bank*, 222 U.S.P.Q. at 177. This situation raised other issues, though, because the registration for KEY included design elements that in some instances helped differentiate the overall impression of the mark from the standard character uses made by other companies. To view the design of the trademark, *see* KEY, Registration No. 1293199.

45. In an opposition proceeding brought in 1978 by the registrant of PLUS against an applicant for "pH PLUS," the applicant cited thirty-nine third-party registrations for PLUS. *Plus Products*, 199 U.S.P.Q. 111.

46. The applicant for pH PLUS argued that the registrant for PLUS, by virtue of its actions and admissions to obtain registration, should be estopped from maintaining that the term "plus" by itself should prevent another company from registering a mark in which the word "plus" is only part of a composite mark. *Id.*

Reality, however, does not always conform to theory, since the owner of the PLUS trademark subsequently opposed registrations for terms such as “pH plus”<sup>47</sup> and “meaty plus.”<sup>48</sup> Although these challenges failed, they do indicate the power that the owner of the root word has to potentially scare off others who are perfectly entitled to use the terms. In addition, registration of the diluted term can lead to thorny problems when competitors display their combination trademarks, which include that protected term in ways that highlight the shared component. For instance, the trademark owner of MEATY PLUS might designate its dog food bags with something like “meaty PLUS.” Does the company in this way create confusion with the trademark owner of PLUS, despite the fact that it owns a registration to use the phrase as it did?<sup>49</sup>

The question is whether it really is worth registering the diluted root element when so many predictable problems are likely to arise.<sup>50</sup> These issues, of course, become magnified when the marks involve expressive goods, because no longer are we simply talking about rights to identification symbols on products. Rather, the owner of a mark, such as JESUS, may challenge other companies from expressing their views about the subject in particular ways on their products.<sup>51</sup> The subsequent history of the JESUS trademark not only proves the point, but also demonstrates that the PTO has mishandled other considerations when it registers Jesus-related marks.

#### *A. Jesus® Creates Doubts about Other Trademarks for Jesus*

In 2001, a U.S. individual filed a trademark application for the mark *Jesus Jeans* to be used with clothing such as jeans, t-shirts, sweatshirts and caps.<sup>52</sup> The PTO initially refused the registration due to the similarity of the phrase with other protected marks and applications, such as the one that claimed JESUS for clothing.<sup>53</sup> The applicant ultimately convinced the examiner that

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47. *Id.* at 112.

48. *Plus Products v. Star-Kist Foods, Inc.*, 220 U.S.P.Q. 541 (T.T.A.B. 1983).

49. In the context of JESUS, a company with a standard character trademark for, let’s say, JESUSDUDS, might emphasize attention to the Jesus component of the mark, raising the plausible argument that a consumer might be confused, thinking that the phrase indicated clothing from the Jesus brand.

50. Words that are used often by multiple firms to designate the same particular features or qualities should be treated as no stronger than descriptive marks, and may in fact have become generic for a service having the identified attribute. *See infra* notes 168–171, and accompanying text. For this reason, the PTO should at least require proof of secondary meaning, if it allows registration of these terms at all. *See, e.g.*, *Abercrombie v. Hunting World, Inc.*, 537 F.2d 4, 9–10 (2d Cir. 1976).

51. *See infra* notes 147-150, 157-165, and accompanying text.

52. U.S. Trademark Application Serial No. 76305357 (Aug. 27, 2001).

53. Trademark App. Serial No. 76305357, *PTO Office Actions*, (Oct. 31, 2001), (July 3, 2003), (June 28, 2007).

registration was warranted, due again to the dilution argument.<sup>54</sup> It also stated that its mark produces a very different commercial impression than previous uses of “Jesus” on jeans.<sup>55</sup> For instance, it claimed that “Jesus Jeans” is a tongue-in-cheek play on words, while the JESUS mark suggests a devout and religious marketing approach.<sup>56</sup> Based on these arguments, the PTO registered JESUS JEANS as a standard character trademark for the selected expressive products in 2008.<sup>57</sup>

The potential repercussions from these two registrations border on the ridiculous. For instance, one company can sell Jesus-brand jeans in the United States with rights to display Jesus® Jeans, while another company is able to offer “Jesus Jeans”-brand jeans with rights to Jesus Jeans®.<sup>58</sup> Also, ironically, in its early years, Jesus® Jeans products were marketed in Italy with edgy advertising campaigns, such as one for skimpy shorts using the slogan, “He who loves me follows me.”<sup>59</sup> Obviously, this is in stark contrast to the Jesus Jeans® claim that the Jesus-brand was based on a devout and religious approach. Finally, and perhaps most nefariously, Jesus Jeans S.R.L., the owner of the Jesus brand, has filed complaints and oppositions against other companies, which have dared to use the word “Jesus” to allegedly indicate source on their products.<sup>60</sup> To think, this company argued that it had rights to JESUS because it could peacefully coexist with all the other “Jesus” users, and then it turned around and tried to prevent others from using the name.

As noted, though, many small companies simply abandoned their trademark applications for Jesus-related trademarks after Jesus Jeans S.R.L. filed oppositions, presumably because they assumed they would lose or the expenses became too great. In one instance, Jeffrey Lamont, who applied to register the phrase *Jesus Up* for clothing agreed to abandon his application on the condition that Jesus Jeans S.R.L. would allow him to use the phrase in a

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54. Trademark App. Serial No. 76305357, *Applicant’s Response to Office Action* (Aug. 31, 2007) at 8.

55. *Id.*

56. *Id.*

57. JESUS JEANS, Registration No. 3379848. The mark is registered in the typed drawing format, which is the equivalent designation for a standard character mark in applications filed before November 2, 2003. *See* TMEP § 807.03(i).

58. The owner of the JESUS JEANS trademark filed the section eight affidavit on February 7, 2014 showing continued use of the mark, just days before the required filing deadline (February 12, 2014) to avoid abandonment of the registration. Lanham Act, 15 U.S.C. § 1058(a) (2006).

59. Gershman, *supra* note 1.

60. According to a brief filed by Jesus Jeans S.R.L. opposing the registration of *Jesus Surfed*, the company had successfully opposed the registration of at least sixteen marks for Class 25 (clothing) that included the word, Jesus. Notice of Opposition, *Jesus Jeans S.R.L. v. Anton* at 2–3, (T.T.A.B. Feb. 20, 2013) available at <http://ttabvue.uspto.gov/ttabvue/v?pno=91209383&pty=OPP&eno=1>.

“descriptive religious free speech sense.”<sup>61</sup> As we shall see, this is something that Lamont already was entitled to do, despite the registration of JESUS and so Lamont essentially bargained for some assurance that he would not be sued.<sup>62</sup> If nothing else, the settlement demonstrates the power that the registered JESUS mark has to chill legitimate and constitutionally protected uses by small businesspersons who cannot afford potential litigation expenses.<sup>63</sup> These events also illustrate the unfair competitive advantage that Jesus Jeans S.R.L. is able to exercise by virtue of owning the root word that is necessary for other companies to market products expressing feelings for Jesus. As already noted with regard to generic marks, this is a strong signal that the registration provides the company undue power via the trademark system.

In 2013, a company finally had the strength to attempt a more aggressive stance against Jesus Jeans S.R.L.’s intimidating tactics.<sup>64</sup> In May 2012, Michael Anton filed an intent-to-use application to register *Jesus Surfed* as a standard character mark for bandanas, hats, sweatshirts and t-shirts, and the PTO quickly approved the application and published it in October for opposition. As it had admittedly done at least sixteen times before, Jesus Jeans S.R.L. opposed the registration, due to likelihood of confusion with its registration of JESUS for articles of clothing.<sup>65</sup> This time, though, the applicant answered the opposition, arguing, for one, that Jesus Jeans S.R.L.’s registration for JESUS should be cancelled because the company had used the mark in a manner disparaging to Jesus and Christians.<sup>66</sup> This argument came at a timely moment, given the amount of attention recently given to the propriety of a franchised professional football team controlling trademark rights to REDSKINS, which offends many Native Americans.<sup>67</sup> Although there is

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61. Consented to Amendment of Application and Consented to Dismissal of Opposition, *Jesus Jeans S.R.L. v. Lamont*, Opposition No. 91200725 (T.T.A.B. June 7, 2013) available at <http://ttabvue.uspto.gov/ttabvue/v?pno=91200725&pty=OPP&eno=21>.

62. See *infra* notes 147-150, 172-176, and accompanying text.

63. See *infra* notes 157-165, 172-176, and accompanying text.

64. Answer to Notice of Opposition and Counterclaim to Cancel Opposer’s Reg. No. 3,232,057, *Jesus Jeans S.R.L. v. Anton*, Opposition No. 91209383 (T.T.A.B. Apr. 1, 2013) available at <http://ttabvue.uspto.gov/ttabvue/v?pno=91209383&pty=OPP&eno=4>.

65. In its opposition, *Jesus Jeans S.R.L.* stated that it had successfully policed its mark against “Jesus Messiah,” “Jesus Image,” “Jesus Pwns,” “Je-Is-Us,” “Jesus Couture,” “Sweet Jesus,” “Jesus>Life,” “Jesus Loves Jeans,” “Jesus IQ,” “Jesus Saves,” “Jesus Got It Right,” “Jesus First,” “8 Up W/Jesus,” “Jesus = \_\_\_,” “Jesus Chic” and “Jesus. . .He Gets Me.” It ends the list with “et cetera.” Notice of Opposition at 2-3, *Jesus Jeans S.R.L. v. Anton*, (T.T.A.B. Feb. 20, 2013) available at <http://ttabvue.uspto.gov/ttabvue/v?pno=91209383&pty=OPP&eno=1>.

66. Answer to Notice of Opposition and Counterclaim to Cancel Opposer’s Reg. No. 3,232,057 at 6, *Jesus Jeans S.R.L. v. Anton*, Opposition No. 91209383 (T.T.A.B. April 1, 2013) available at <http://ttabvue.uspto.gov/ttabvue/v?pno=91209383&pty=OPP&eno=4>.

67. See, e.g., Jesse Witten, *Taking the Stand: Time to Retire the ‘R’ Reference?*, WASHINGTON

substantial confusion about the standards that should be applied to demonstrate disparagement, and even though many Christians may sympathize with the claim, this article will demonstrate that this argument would surely have failed if Anton had not ultimately given up the fight after almost a year of litigation.<sup>68</sup>

In addition to disparagement, Anton argued that Jesus Jeans S.R.L. should have been estopped from opposing the registration, given that the company convinced the PTO to grant its registration to JESUS based on the notion of dilution. The estoppel argument was undoubtedly compelling. Having allowed a registration for JESUS on the grounds that it could peacefully coexist with other Jesus-related marks, the PTO should never allow the registration to block others who then subsequently attempt to coexist. As history so clearly demonstrates, though, the registration has nonetheless created substantial uncertainty under traditional likelihood of confusion principles, which serves to illustrate a more fundamental conclusion – that the PTO should have never allowed a company the exclusive right to use the word “Jesus” as a trademark on expressive products, such as clothing.

This should not be the end of the story, however, because the PTO also erred, as it so often does, when it perfunctorily assumed that Anton’s use of Jesus Surfed would serve as a trademark on bandanas and t-shirts. Thus, in a perfect world, the PTO should not only cancel Jesus Jeans S.R.L.’s trademark to JESUS, but it should also raise the bar for terms such as “Jesus Surfed” by requiring applicants to demonstrate secondary meaning. Therefore, the problems the PTO created by registering the JESUS trademark do not represent

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LAWYER, June 2014, at 31; Theresa Vargas, *In Rare Unity, Groups Protest Redskins’ Name*, WASH. POST, Nov. 26, 2013, at B1; Mike DeBonis & Aaron Davis, *D.C. Lawmakers Urge Redskins to Change Name*, WASH. POST, Nov. 6, 2013 at B1; Theresa Vargas & Annys Shin, *Obama: “I’d Think About Changing” Redskins Name*, WASH. POST, Oct. 6, 2013 at A1; Ken Belson, *Redskins’ Name Change Remains Activist’s Unfinished Business*, N.Y. TIMES, Oct. 10, 2013 at A1. The Redskins trademark was subject to a lengthy and highly publicized cancellation proceeding based on disparagement, first filed by seven Native Americans in 1992, and which effectively ended in 2008, when the D.C. Circuit Court of Appeals barred the claims of even the youngest petitioner on the grounds of laches. *Pro Football, Inc. v. Harjo*, 565 F.3d 880 (D.C. Cir. 2009), *cert. denied*, 558 U.S. 1025 (2009). In 2006, a group of younger Native Americans filed a petition with the T.T.A.B. to cancel the trademark on the grounds of disparagement. *Petition for Cancellation, Blackhorse v. Pro-Football, Inc.*, (T.T.A.B. Aug. 11, 2006) available at <http://ttabvue.uspto.gov/ttabvue/v?pno=92046185&pty=CAN&eno=1>. On June 18, 2014, the T.T.A.B. ruled that the petitioners were not barred by laches, and that six Redskins trademark registrations should be cancelled because the term was disparaging to a substantial composite of Native Americans at the times the registrations were filed. *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080 (T.T.A.B. 2014). *Pro-Football, Inc.* filed an appeal in the District Court for the Eastern District of Virginia on August 14, 2014. *See, e.g.*, Ian Shapira, *Redskins Defend Name, Ask Federal Court to Overturn Trademark Decision*, WASH. POST, Aug. 15, 2014 at B1.

68. On February 8, 2014, the parties filed a stipulation of settlement with the T.T.A.B., in which Anton agreed to withdraw the trademark application. The application was abandoned on March 8, 2014. For more information, *see supra* note 3.



an isolated incidence of a solitary mistake. Rather, the PTO has more fundamentally lost its compass when evaluating Jesus-related trademarks. The intent of this article, therefore, is to help the PTO find its way with “Jesus.”

## II. IS IT OFFENSIVE TO OWN RIGHTS TO JESUS?

Section 1052(a) of the Lanham Act provides that a mark cannot be registered if it “consists of or comprises immoral, deceptive or scandalous matter; or matter which may disparage . . . persons living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”<sup>69</sup> The Act also indicates that a mark can be cancelled at any time if the registration was obtained contrary to the provisions of section 1052(a).<sup>70</sup> Based on these conditions, Michael Anton, the applicant for *Jesus Surfed*, argued that Jesus Jeans S.R.L.’s trademark for JESUS should be cancelled because its use is offensive and disparaging to Jesus Christ, Christianity and Christians.<sup>71</sup> To substantiate this claim, Anton argued that the public associates the mark with Jesus Christ, and that Jesus Jeans S.R.L. has marketed its jeans and continues to do so with sexually suggestive advertising that is so irreverent that even the Roman Catholic Church has condemned it.<sup>72</sup> Although on first blush these arguments, if true appear to have merit, they nonetheless are not convincing based on current applications of the statute. This does not mean that all uses of “Jesus” in trademarks are fair game; there are situations in which registrations could be rejected or cancelled on the grounds that they are scandalous or disparaging.<sup>73</sup> However, the use made by Jesus Jeans S.R.L., even in light of its allegedly sexually offensive advertising, is not one of these cases.

Many of the problems related to the scandalous and disparagement provisions arise because the limitations are not directly related to the main purposes of the trademark laws, which are to reduce consumer confusion and

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69. Lanham Act, 15 U.S.C. § 1052(a) (2006).

70. *Id.* at § 1064(3).

71. Answer to Notice of Opposition and Counterclaim to Cancel Opposer’s Reg. No. 3,232,057 at 6, *Jesus Jeans S.R.L. v. Anton*, Opposition No. 91209383 (T.T.A.B. April 1, 2013) available at <http://ttabvue.uspto.gov/ttabvue/v?pno=91209383&pty=OPP&eno=4>.

72. *Id.* The brief notes that the jeans have been advertised with scantily clad women and sexual innuendo that violate Jesus Christ’s call for sexual purity. It also claims that statements in the ads, such as “He who love me follows me” and “Thou shalt not have any other jeans but me” are sacrilegious attempts at word play. *Id.* at 3–5. Jesus Jeans S.R.L., among other things, claims that the allegedly offensive marketing did not take place in the United States and that its use of the mark is not disparaging. *Id.* at 1–3

73. For instance, the USPTO recently rejected an application for *Porno Jesus* on the grounds that the mark is scandalous and disparaging to Christians. U.S. Trademark Application Serial No. 85767380 (filed Oct. 30, 2012).

further distributional efficiency.<sup>74</sup> The history of these sections leaves an unclear trail about the purposes that Congress intended to achieve.<sup>75</sup> To some observers, Congress included these restrictions to regulate morality by dissuading uses of terms and symbols considered to be morally offensive.<sup>76</sup> One court, though, claimed that it did not see the limitations as “an attempt to legislate morality, but, rather, a judgment by Congress that such marks should not occupy the time, services, and use of funds of the federal government.”<sup>77</sup> If nothing else, the inconclusive rationales for the restrictions open the door for any offended group to plausibly argue that a mark should not enjoy the benefits of federal protection, as Michael Anton clearly believed with his claim against JESUS.

The prohibitions on registering scandalous and disparaging marks are drafted in separate statements and are theoretically appraised as two separate grounds for denying protection. Scandalous marks are words or symbols that a substantial composite of the public would find disgraceful, vulgar, offensive, disreputable or shocking to the sense of decency.<sup>78</sup> A few words are *per se* scandalous, in that they would be inappropriate with any product in every circumstance.<sup>79</sup> For instance, although there have been, and still are, several

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74. *E.g.*, Jasmine Abdel-Khalik, *To Live in In-"Fame"-Y: Reconceiving Scandalous Marks as Analogous to Famous Marks*, 25 CARDOZO ARTS & ENTER. L.J. 173, 213 (2007).

75. For a good discussion of the history of these provisions, *see id.* at 186-213. *See also* Pro-Football, Inc. v. Harjo, 284 F.Supp.2d 96, 124 (D.D.C. 2003), *remanded*, Pro-Football, Inc. v. Harjo, 415 F.3d 44 (D.C. Cir. 2005) (stating that the T.T.A.B. has noted the dearth of legislative history on the disparagement provision in section 2(a)). Denial of registration would not prevent someone from using the mark, but that person could not enjoy the benefits of federal registration. *See In re McGinley*, 600 F.2d 481, 484 (C.C.P.A. 1981) (stating that “[w]ith respect to appellant’s First Amendment rights, it is clear that the PTO’s refusal to register appellant’s mark does not affect his right to use it.”) In addition, it is possible that this person would not be able to rely on federal unfair competition principles to prevent others from using confusingly similar marks. *See* Rebecca Tushnet, *Unregistrable Means Unprotectable By Sec. 43 As Well*, REBECCA TUSHNET’S 43(B)LOG, (June 4, 2014), <http://tushnet.blogspot.com/2014/06/unregistrable-means-unprotectable-by.html> (discussing *Renna v. County of Union*, NJ, 2014 WL 2435775 (D.N.J. May 29, 2014)); PETER K. YU, *INTELLECTUAL PROPERTY AND INFORMATION WEALTH: ISSUES AND PRACTICES IN THE DIGITAL AGE*, Vol. 3, 127-28 (2007). *But see* Mark McKenna, *Guest Post by Prof. McKenna: The Implications of Blackhorse v. Pro-Football, Inc.*, PATENTLY-O (June 19, 2014) <http://patentlyo.com/patent/2014/06/implications-blackhorse-football.html> (arguing that loss of registration under §1052(a) does not terminate federal unfair competition rights).

76. *See, e.g.*, Yu, *supra* note 75 at 128-29; Michelle B. Lee, *Section 2(a) of the Lanham Act as a Restriction on Sports Team Names: Has Political Correctness Gone Too Far?*, 4 SPORTS LAW J. 65, 67-70 (1997). The language of the statute itself provides strong support for this notion since it specifically prevents registration of “immoral matter.” Lanham Act 15 U.S.C. § 1052(a) (2006).

77. *McGinley*, 600 F.2d at 486.

78. *E.g.*, *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994); *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938).

79. *See e.g.*, Abdel-Khalik, *supra* note 74, at 214-18; Justin G. Blankenship, *The Cancellation*

applications for trademarks including the word “shit,” the PTO has yet to register one because use of the term is considered vulgar to a substantial composite of the public.<sup>80</sup> Clearly, “Jesus” is not a word that, by itself, would be viewed as offensive or disgraceful by the general public, so it is not *per se* scandalous.<sup>81</sup>

The definitions of many words, though, have both appropriate and vulgar meanings, and so the determination of whether marks using those words are scandalous will depend on the context of their usage in light of contemporaneous attitudes.<sup>82</sup> For instance, the word “pussy” has several innocuous meanings such as cat or wimp, but also may be interpreted as female genitalia. Therefore, the term may be just fine when applied to animal products<sup>83</sup> or if included with a design of a cat,<sup>84</sup> but may be offensive if used suggestively with energy drinks<sup>85</sup> or on condoms.<sup>86</sup> Similarly, the phrase, “Big Pecker,” clearly can have a scandalous sexual meaning, but may simply be funny if integrated in a design with a chicken having a big beak.<sup>87</sup> Thus, hypothetically, it might not be scandalous for a salvage company to use the mark “Jesus Junk.” However, one might reach a different conclusion if a penis-enlargement company, for its trademark, combined the phrase with a picture of

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*of Redskins as a Disparaging Trademark: Is Federal Trademark Law An Appropriate Solution for Words that Offend?*, 72 U. COLO. L. REV. 415, 433 (2001).

80. See *In re R.G.S. Group, Ltd.*, 1997 TTAB LEXIS 293 (T.T.A.B. 1997).

81. In contrast, a PTO trademark examiner determined in a first office action that the phrase “I KILLED JESUS” could not be registered for t-shirts because the phrase is immoral or scandalous. U.S. Trademark Application Serial No. 78414874 (filed Jan. 7, 2005). The application was abandoned.

82. See, e.g., *In re McGinley*, 660 F.2d. at 485 (C.C.P.A. 1981) (“In determining whether appellant’s mark may be refused registration as scandalous, the mark must be considered in the context of the marketplace as applied to only the goods or services described in the application for registration.”); *Mavety*, 33 F.3d at 1371 (stating that the court “must be mindful of ever-changing social attitudes and sensitivities.”).

83. E.g., PUSSY & POOCH PETHOUSE AND PAWBAR., No. 3643993. (Pussy & Pooch Pethouse and Pawbar, for specialty interiors for pets).

84. E.g., PUSSY, Registration No. 4120676 (Design mark for Pussy including a picture of a cat for cosmetics); PUSSY NATURAL ENERGY, Registration No. 4254281 (Pussy Natural Energy registered after inclusion of design depicting a cat).

85. The application to register PUSSY NATURAL ENERGY for energy drinks, was rejected by that PTO examiner on the grounds that it was scandalous, U.S. Trademark Application Serial No. 78690531 (filed Aug. 11, 2005), and the decision was affirmed by the T.T.A.B. in *In re Sheare* (May 14, 2009). The mark was subsequently registered after the applicant revised the design mark to include the picture of a cat. PUSSY NATURAL ENERGY, Registration. No. 4254281.

86. *Hello Pussy*, for condoms, U.S. Trademark Application Serial No. 77906546 (filed Jan. 6, 2010), denial due to inclusion of immoral or scandalous matter (Apr. 9, 2010).

87. *In re Hershey*, 6 U.S.P.Q.2d 1470 (T.T.A.B., 1988). *But see In re Fox*, 702 F.3d 633 (Fed. Cir. 2012) (finding “cock sucker” along with the design of a rooster scandalous for chocolate suckers molded in the shape of a rooster.).

a man looking down at his privates.<sup>88</sup>

A disparaging mark is one that brings dishonor by comparison with something inferior, or that deprecates, degrades, or injures by an unjust comparison.<sup>89</sup> Unlike with scandalous marks, which are supposed to be evaluated with reference to a substantial composite of American society as a whole, disparagement more narrowly focuses on the views of the referenced group.<sup>90</sup> Interestingly, there have been times, mostly in the distant past, when a mark could be scandalous even when only a particular group might find it offensive.<sup>91</sup> For instance, an application for *Senussi* on cigarettes was deemed scandalous because it was the name for a Moslem sect whose followers forbade the use of cigarettes.<sup>92</sup> This was despite the fact that a substantial composite of the public would not even recognize the word “Senussi” nor be offended by its use on cigarettes. Today, the T.T.A.B. has made it clear that these cases reached the right conclusion, but should have been approached under the rubric for disparagement, since the focus was on the religious sensibilities of a particular group. As a consequence, the meaning of disparagement has been broadened to include any circumstance in which registration “would offend the sensibilities of an ethnic or religious group,” even if it does not serve to make the members feel inferior.<sup>93</sup> In addition, one can assume that those decision makers finding marks to be scandalous to religious orders would have reached the same conclusions today using the disparagement standards.

The following two-part test is used to determine if a proposed mark should be denied registration or cancelled because it is disparaging:

- (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; and
- (2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging

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88. See *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981) (finding scandalous a mark comprised of a nude man and woman embracing in a manner appearing to expose male genitalia).

89. *Pro-Football, Inc. v. Harjo*, 284 F.Supp.2d 96, 124 (D.D.C. 2003),

90. *Id.*

91. Lynda J. Oswald, *Challenging the Registration of Scandalous and Disparaging Marks Under the Lanham Act: Who Has Standing to Sue?*, 41 AM. BUS. L. J. 251, 269–70 (2004).

92. *In re Reemtsma Cigarettenfabriken G.M.B.H.*, 122 U.S.P.Q. 339 (TTAB 1959).

93. See *In re Lebanese Arak Corp.* 94 U.S.P.Q.2d 1215, at \*3 (T.T.A.B. 2010).

to a substantial composite of the referenced group.<sup>94</sup>

The first part of the test can be equated to the contextual approach used to address whether a mark is scandalous.<sup>95</sup> Thus, if a mark can have several meanings, then one needs to consider the context of how the mark is designed and used to resolve market perceptions. For instance, the definition of a “dough boy” includes (1) a piece of bread that is rolled thin and fried in deep fat, and (2) an American infantryman in World War I. Given this, the PTO refused to register the term for an anti-venereal prophylactic preparation because the packaging featured depictions of American soldiers, which made it pretty clear how the term would be interpreted.<sup>96</sup> Likewise, when dealing with marks that include “Jesus,” one would have to decide if the word refers to Christ or rather another individual who happens to be named Jesus. Although in almost all cases the reference will most likely pertain to Jesus Christ, the name nonetheless may take on a different meaning if the mark, for instance, were designed with a large Mexican sombrero.<sup>97</sup>

Assuming the name refers to Christ, though, one then has to appraise whether the manner of its use on the products upon which it appears would be disparaging to a substantial number of Christians. In addition, the mark must be disparaging at the time of registration.<sup>98</sup> This requirement has been a thorn for those who have requested cancellation of the REDSKINS marks because adult plaintiffs may only have a certain amount of time after registration to bring suit, given that this is the time when their alleged injury first arose.<sup>99</sup> It also means that a company that obtains a registration including the name of

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94. *E.g., id.; In re Heeb Media L.L.C.*, 89 U.S.P.Q.2d 1071 (T.T.A.B. 2008); *see also* Pro-Football, Inc. v. Harjo, 284 F.Supp.2d 96, 125 (D.D.C. 2003),

95. *See Harjo*, 284 F. Supp. 2d at 125 (stating that “the question of disparagement must be considered in relation to the goods or services identified by the mark in the context of the marketplace.”).

96. *Doughboy Indus., Inc. v. The Reese Chem. Co.*, 88 U.S.P.Q. 227 (C.C.P.A. 1951). The board determined that American soldiers would find their association with condoms and venereal disease to be disparaging. *Id.*

97. *See, e.g., In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d 1653, at \*1 (T.T.A.B. 1990) (the design mark of Moonies on dolls refers to dropping trousers rather than members of the Unification Church (founded by Reverend Moon) because the design of the two o’s form the caricature of a naked buttocks).

98. *E.g., Harjo*, 284 F. Supp. 2d at 125.

99. The doctrine of laches may prevent opponents from bringing cancellation proceedings based on disparagement when a delay in filing unreasonably prejudices the registrant. *See* Pro-Football, Inc. v. Harjo, 415 F.3d 44 (D.C. Cir. 2005). *But see* Marshak v. Treadwell, 240 F.3d 184, 193-94 (3d Cir. 2001) (stating that a cancellation proceeding under section 1064(3) is not subject to any time limit). The laches defense, if available at all, only applies to undue delays after the petitioner reaches the age of majority. *Harjo*, 415 F.3d at 48.

Jesus could not lose that registration because of a change of morals or because of something the trademark owner later did with the product that was perceived as disparaging.<sup>100</sup>

The key question, then, is under what circumstances can the use of “Jesus” on products be considered offensive. At the outset, some Christians might believe that it is offensive to use the name of Jesus Christ to commercially market products at all. This is not a totally unprecedented thought.<sup>101</sup> For instance, William Henry Browne, an influential nineteenth century legal scholar indicated in his writings that registration of religious symbols would be improper regardless of the goods with which they are associated.<sup>102</sup> Also, in one instance, the PTO rejected the registration of *Agnus Dei* (with a design) for metallic tabernacle safes because the PTO found it offensive to “commercialize an emblem of such highly sacred religious significance.”<sup>103</sup> Nevertheless, the PTO and reviewing bodies have never since applied such a sweeping *per se* rule for religious symbols, rather, they have consistently evaluated them with a contextual approach that considers the nature of their association with the relevant goods and services.<sup>104</sup>

There are several instances in which a reviewing body has upheld an examiner’s decision to deny registration of a religious term because the members of the relevant religion would find the relationship of the term with the product to be offensive. As already mentioned, the PTO rejected registration for *Sennusi* on cigarettes because adherents of the Moslem sect forbid the use of cigarettes.<sup>105</sup> Similarly, the PTO previously rejected *Messias*

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100. This is an odd result if the purpose of the statute is to somehow detach the force of federal authority from immoral acts. If this were the case, one would assume that a targeted group should be able to challenge a disparaging mark at any time that the mark becomes disparaging, even if the offense first arises after registration. This is not an unprecedented approach with the Lanham Act. For instance, marks may be cancelled at any time if they become generic, even if the genericism occurs after registration. Lanham Act, 15 U.S.C. § 1064(3) (2006). The same is true if marks become functional. *Id.* The current language of the Lanham Act does not allow disparaging marks to be treated in this way, however, because the registration can only be cancelled if it were *obtained* contrary to the provisions of section 102(a) (emphasis added). *Id.*

101. See Abdel-Khalik, *supra* note 74, at 191 (stating that under the pre-1905 common law, “Congress intended the registration prohibition to protect any religion’s terms and images from use by trademark owners.”).

102. Abdel-Khalik, *supra* note 74, at 194.

103. *Ex parte* Summit Brass & Bronze Works, Inc., 59 U.S.P.Q. 22 (Dec. Comm’r Pat. 1943). See Abdel-Khalik, *supra* note 74, at 203-204.

104. See Abdel-Khalik, *supra* note 74, at 202-204; Cf. *In re* Lebanese Arak Corp. 94 U.S.P.Q.2d 1215, at \*9 (T.T.A.B. 2010) (stating that “we disagree with the suggestion by the dissent that the ground for disparagement is appropriate only if the mark *per se* is disparaging, without regard to the goods or services in connection with which the mark is used.”).

105. *In re* Reemtsma Cigarettenfabriken G.M.B.H., 122 U.S.P.Q. 339 (T.T.A.B. 1959).

for wine and brandy,<sup>106</sup> *Khoran* for wine,<sup>107</sup> and *Madonna* for wine.<sup>108</sup> Based on this history, one can surmise that the PTO would reject applications for marks that associate Jesus with products that currently would offend Christians because they contradict the philosophy of Jesus. Thus, the PTO would probably object to applications for marks referencing Jesus that are intended to be used on products, such as guns, birth control or sex toys, which Christians may find degrading.<sup>109</sup>

The primary topic here, though, are Jesus-related marks for expressive products, such as t-shirts, hats, bumper stickers and mugs. In these instances, Christians would not find the association of Jesus with the types of products to be offensive, as they may with guns or condoms. Thus, in these instances, the mark must be disparaging in and of itself without an associated inference derived from the identified product. To begin, the word “Jesus” by itself, cannot be disparaging on such products because there are no disparaging connotations of the singular word. As such, it differs from *Heeb*, which the PTO rejected because it would be disparaging to a substantial composite of Jewish individuals, despite possible positive connotations accepted by younger members of the Jewish faith.<sup>110</sup> However, companies can construct phrases including the word “Jesus,” which would be disparaging. In this vein, the PTO recently rejected an application for *Jesus Porno* because it associates Jesus Christ with pornography, and according to the agency, Christians of all types believe that pornography is directly contrary to the teachings of Jesus.<sup>111</sup> Also,

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106. *In re Sociedade Agricola E. Comercial Dos Vinhos Miessias, S.A.R.L.*, 159 U.S.P.Q. 275 (T.T.A.B. 1968).

107. *Lebanese Arak Corp.*, 94 U.S.P.Q.2d at \*10.

108. *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938).. The PTO recently registered MADONNA for wine, demonstrating that there has been a change in moral attitudes since 1938. MADONNA, Registration No. 3545635. As the Federal Circuit has stated about scandalous marks, “[t]oday’s scandal can be tomorrow’s vogue.” *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

109. The PTO apparently might not object to the association of Jesus with spirits since it granted a notice of allowance of “JESUS JUICE” for wine. PTO, *Notice of Allowance*, U.S. Trademark Application. Serial No. 78360553 (filed Aug. 16, 2005). The applicant abandoned the application on Dec. 15, 2005 after the PTO received a letter of protest from an evangelical minister.

110. *In re Heeb Media L.L.C.*, 89 U.S.P.Q.2d. 1071, at \*5 (T.T.A.B. 2008) (affirming the PTO’s refusal to register Heeb for clothing and entertainment services). Previously, the PTO did register “HEEB” for magazines. HEEB, Registration No. 2858011. Some observers have argued that the examiner made a mistake in this instance. *E.g.*, Jessica M. Kiser, *How Dykes on Bikes Got it Right: Procedural Inequities Inherent in the Trademark Office’s Review of Disparaging Trademarks*, 46 U.S.F.L. Rev. 1, 17 (2011) (stating that “Heeb Media’s one registration was granted erroneously.”).

111. Trademark App. Serial No. 85767380, *Office Action* (Mar. 7, 2013). The application was for DVDs and videos in the field of adult entertainment, but the opinion only notes that fact in a parenthetical, thus implying that the association of porno with Jesus might have been sufficiently disparaging, even if the mark were used with other kinds of goods. Similarly, the PTO refused to

if a mark includes a design with Jesus, for instance shooting a pistol, then the PTO likely would find the overall mark to be disparaging to Christians.<sup>112</sup> Finally, the design of the mark might be problematic if it were positioned in an objectionable way.<sup>113</sup> For example, if the application sought rights to position the word “Jesus” down the crotch of men’s jeans, Christians might perceive the association of Jesus with male genitalia as disparaging.

Michael Anton objected to the registration of JESUS for jeans because Jesus Jeans S.R.L. marketed its clothes with sexual innuendo, contrary to moral positions reflected in the bible.<sup>114</sup> Although marketing may be relevant to address whether the public understands that JESUS means Jesus Christ, it cannot be a factor in evaluating whether the mark, once determined to refer to Jesus, is disparaging.<sup>115</sup> Rather, the PTO only can appraise the other elements of the mark, the associated products, and the manner in which the mark appears on those products.<sup>116</sup> There are both practical and constitutional reasons for this conclusion. As a practical matter, the PTO’s judgment about morality is a static decision that must be made at the time of registration, without regard to how the trademark owner may later or tangentially use the trademark to cause offense.<sup>117</sup> For instance, the PTO registered HOOTERS with the design of an owl for restaurant services, despite the possible disparaging connotation of the word, because the design accentuated its innocuous meaning in the context of restaurants in general.<sup>118</sup> The PTO is not then charged with policing the kinds of restaurant services the trademark owner might establish or the possibly disparaging ways the mark is used to market those services. Obviously, trademark owners often change their business plans or sell their rights to others

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register *Drunk for Jesus* as a trademark for shirts due to disparagement. Trademark App. Serial No. 85428786, *Office Action* (Jan. 23, 2012). Some phrases may have a double-entendre, which are not disparaging in light of the goods to which the registration specifically applies. An example would be HOOKERS FOR JESUS, which is registered for charitable services that organize women’s groups to undertake projects for the benefit of the homeless, among others. HOOKERS FOR JESUS, Registration No. 3743882. The word “hookers” in this context, means those who crochet.

112. *Cf.*, *In re McGinley*, 600 F.2d 481 (C.C.P.A. 1981) (finding scandalous a mark for a sexually oriented newsletter that comprised a photograph of a nude man and woman kissing and embracing in a manner appearing to expose male genitalia.).

113. One criterion for disparagement is “the manner in which the mark is used in the marketplace in connection with the goods or services.” *See supra* note 94, and accompanying text.

114. *Supra* note 66 at 3–6.

115. *Cf.* *Pro-Football, Inc. v. Harjo*, 284 F.Supp.2d 96, 126–27 (D.D.C. 2003), (Although the vast majority of media uses of the term Redskins referred to the Washington’s football club, it would be disingenuous to ignore the Native American imagery associated with the marks.).

116. *See supra* note 94, and accompanying text.

117. *See supra* notes 98–99, and accompanying text.

118. HOOTERS, Registration No. 1320029.



with different intentions.<sup>119</sup> Thus, the PTO can only conceivably consider the nature of the mark in the context of covered products with the evidence it has before it at the time of registration. Addressing how the mark is, or may be, advertised clearly is outside the purview of what the PTO is authorized to do.<sup>120</sup>

The PTO would also violate the First Amendment if it were to use trademark laws to punish companies that advertise in offensive ways. Admittedly, there is some controversy whether the PTO should even be able to deny registration on the grounds of disparagement since that might deter individuals from marking their products with statements that the government finds objectionable.<sup>121</sup> At least, though, in this instance, the agency's decisions are directly related to the core of its mission, which is to enhance market efficiency and ethics by granting exclusive rights to identification symbols.<sup>122</sup> For this reason, constitutional objections are typically overcome due to the importance of the government's objective in relation to the impact on free speech.<sup>123</sup> However, the government would clearly be overstepping its constitutional grounds if it were to use the potential loss of trademark registration as leverage to control statements that are not even part of the regulated trademark.<sup>124</sup> Just imagine if the Federal Government threatened to cancel Comedy Central's trademark because John Stewart made disparaging comments about Christianity on his show or perhaps closer to the point, if it

119. *Cf.*, *In re Heeb Media L.L.C.*, 89 U.S.P.Q.2d. 1071, at n.5 (T.T.A.B. 2008) (The TTAB rebutted applicant's argument that the audience for *Heeb* products understand the term in a non-disparaging way by stating, "inasmuch as the identification of goods and services is not limited to clothing and entertainment services offered by Jews for Jews, this registration could be assigned to anyone, and these goods and services could be offered in all channels of trade to all classes of consumers.").

120. The plain meaning of the Lanham Act demands this result, since it provides that "[n]o trademark . . . shall be refused registration . . . on account of its nature unless it consists of . . . scandalous matter . . . or matter which may disparage. . . ." (emphasis added). Lanham Act, 15 U.S.C. § 1052(a) (2006). Advertising for a product is distinct from the nature and composition of the trademark that is used with the product to identify source.

121. *See, e.g.*, Blankenship, *supra* note 79, at 438–443; Yu, *supra* note 75, at 129–30.

122. *See, e.g.*, *Central Hudson Gas & Elec. Corp. v. Publ. Serv. Comm'n of N.Y.*, 447 U.S. 557, 564 (1980) (a government restriction of commercial speech is constitutional only if it satisfies each condition of a three prong test: (1) the government must assert a substantial interest for the restriction; (2) the regulation on speech must advance that interest directly; and (3) the regulation must be no broader than necessary to achieve the government's interest.).

123. *See, e.g.*, Alan E. Garfield, *The First Amendment as a Check on Copyright Rights*, 23 HASTINGS COMM. & ENT. L. J. 587, 591-92 (2001). *Cf. In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1373–74 (Fed. Cir. 1994) (The prohibition on registering scandalous marks does not violate the First Amendment because a refusal to register does not affect the right to use a mark nor suppress any tangible form of expression.); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 319 n.6 (C.C.P.A. 1976).

124. A government regulation on commercial speech must directly further the government interest in protecting trademarks. *See Central Hudson*, 447 U.S. at 564.

targeted Madonna's trademark after she sang a disparaging song on stage.<sup>125</sup> Really, this is no different than what Michael Anton asked the PTO to do with Jesus Jeans S.R.L.'s trademark for JESUS. Obviously, in each of these situations, the disconnection between the governmental purpose and the restriction on speech makes the cancellation an unconstitutional interference with the First Amendment.<sup>126</sup>

Based on this analysis, Michael Anton's argument that JESUS is a disparaging trademark due to the advertising of the product does not hold water. This does not mean that there are not ways to use "Jesus" in a trademark that would be scandalous or disparaging. Nonetheless, most applicants who seek trademarks that name "Jesus" on expressive products typically want to say laudatory things about him. Indeed, what they desire is not something that disparages Jesus Christ, but rather sole rights to say something that glorifies him. Michael Anton's application for *Jesus Surfed* is a case in point. Unfortunately, it is with these applications that the PTO has been making its biggest mistake, by perfunctorily assuming that Jesus-related statements automatically serve the requisite trademark functions on expressive products.

### III. WHAT DO YOU MEAN I CAN'T SAY THAT ABOUT JESUS?

The purveyors of expressive products typically attach some importance to the physical attributes of their wares, such as the quality of materials, fit, and appearance. However, without question, they also care very much about the statements displayed on their products. In fact, consumers often are primarily attracted to these products because they want to publicly communicate something that is important to them, whether it's a three-peat championship win, that Jesus Rules, or that they really like Apple products. Thus, companies selling expressive products may pretend that their trademarks are all about the tags or the inconspicuous identification labels, but the reality is that they want exclusive rights to prominently display particular statements so that they can increase the appeal of their products. For this reason, one really cannot talk about trademark rights for these kinds of expressive products without appraising how those rights will affect others who may want to compete by prominently conveying the same messages on their merchandise.

#### *A. Are Statements about Jesus on Expressive Products Functional?*

Since expressive products are intended to provide information about the owner's interests, feelings, or personalities, the statements they make are

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125. COMEDY CENTRAL, Registration No. 1745015 (for television broadcasting services); MADONNA, Registration No. 1473554 (for entertainment services).

126. See *Central Hudson*, 447 U.S. at 564.

integral to each product's overall concept or function. For this reason, slogans and other comparable forms of communication should be treated for trademark purposes just like any other important features of product design. For obvious reasons, this includes slogans that refer to Jesus, including shorthand statements that symbolize a larger phrase or idea. Thus, even one word references, such as "LiveJesus," are meant to communicate particular sentiments, whether they are positive, negative or simply in jest.<sup>127</sup>

Although trademarks were once limited to technical words and images that were attached to products, they now extend to trade dress, which encompasses attributes such as packaging, odor, sound, color, and product design.<sup>128</sup> Protection of product designs, in particular, raise special trademark concerns on two fronts (1) the potential for inappropriate effects on competition<sup>129</sup> and (2) the high probability that the design does not initially serve an identification function.<sup>130</sup>

The first issue regarding competition is addressed with a doctrine called functionality.<sup>131</sup> The root of functionality is to ensure that trademarks do not interfere with patent policies by protecting unpatented product features that the patent laws say should be free for all to use.<sup>132</sup> Thus, based on the notion of functionality, trademarks do not protect important utilitarian features of an article.<sup>133</sup> Patents also are devised to provide the appropriate incentives needed

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127. LIVEJESUS, Registration No. 85694686 (Jan. 22, 2013), for specified clothing, including t-shirts, hats, sweatshirts and beanies, and jewelry items.

128. *See, e.g.*, *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 212 (2000) (The breadth of the elements actionable under the Lanham Act "has been held to embrace not just word marks or symbol marks, but also 'trade dress' – a category that originally included only the packaging, or 'dressing' of a product, but in recent years has been expanded by many courts of appeals to encompass the product's design."). *See In re Clarke*, 17 U.S.P.Q. 2d 1238 (T.T.A.B. 1990) (scent of plumeria blossoms on sewing thread may serve as trademark); *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159 (1995) (Product color may serve as a trademark); *In re General Electric Broadcasting Co. Inc.*, 199 U.S.P.Q. 560 (T.T.A.B. 1978) (NBC three-tone chimes may serve as trademark).

129. *See, e.g.*, *Qualitex*, 514 U.S. at 165; *W. T. Rogers Co., Inc. v. Keene*, 778 F.2d 334, 339–40 (7th Cir. 1985).

130. *See e.g.*, *Samara*, 529 U.S. at 212–13.

131. According to the Supreme Court, a product attribute is functional and cannot serve as a trademark "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article."). *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.10 (1982)

132. *See, e.g.*, Burgunder, *supra* note 16, at 725; Kerry S. Taylor, Note, *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 17 BERKELEY TECH. L.J. 205, 214–17. *See also* *TraFFix Devices, Inc. v. Mkg. Displays, Inc.*, 532 U.S. 23, 34 (2001) ("The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity.").

133. *TraFFix Devices Inc.*, 532 U.S. at 32–33.

to create useful and attractive product features.<sup>134</sup> To this end, the functionality doctrine also prevents trademarks from unduly conferring market benefits, by, for instance, protecting useful or aesthetically appealing product attributes that other companies need to reasonably compete.<sup>135</sup> The Lanham Act makes it abundantly clear that functionality trumps all other considerations no matter the time or circumstances, by, among other things, preventing registration of functional features<sup>136</sup> and allowing for them to be cancelled at any time.<sup>137</sup>

When addressing expressive products that include references to Jesus, the focus of functionality is whether trademark protection would cause competitors to suffer “a significant non-reputation related disadvantage.”<sup>138</sup> In this regard, courts have sometimes ruled that an aesthetic design is functional when it serves as an important ingredient in the commercial success of the product.<sup>139</sup> For instance, the floral design on a plate was deemed functional because customers primarily chose the plate so that they could display the china pattern.<sup>140</sup> Likewise, one might argue that prominent statements about Jesus on expressive products are functional because customers primarily purchase the products to

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134. The U.S. economic system is based on the notion that free markets promote public welfare. *See, e.g.*, *Eastern Wine Corp. v. Winslow-Warren, Ltd.*, 137 F.2d 955, 958 (2d Cir. 1943). However, inventors and product designers may forego creative activities if others are free to take their ideas as soon as the creators disclose them to the public. *See* Paul Goldstein, *The Competitive Mandate: From Sears to Lear*, 59 CALIF. L. REV. 873, 878 (1971). Patents, as well as copyrights, are intended to address the economic disincentives resulting from free competition, by giving inventors and artists a limited period of exclusive use to that they have an opportunity to profit from their creativity. *E.g.*, *Burgunder*, *supra* note 20, at 267. *See* *Bonito Boats Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1988).

135. *See* *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 170 (1995) (stating that if a product design’s value lies in its ability to confer a significant benefit that cannot practically be duplicated by the use of alternative designs, then the design is functional).

136. Lanham Act, 15 U.S.C. § 1052(e)(5) (2006).

137. *Id.* at § 1064(3). The Act also requires a person suing for infringement of a trade dress to prove that the material is not functional. *Id.* at § 1125(a)(3).

138. *Traffix Devices, Inc. v. Mkg. Displays, Inc.*, 532 U.S. 23, 33 (2001). The Supreme Court provided that this is the sole measure of functionality for aesthetic (as opposed to utilitarian) product features. Statements on expressive products about Jesus (or anything else, for that matter) can only be functional in aesthetic terms since they don’t affect utilitarian qualities, such as the fit or durability, of the merchandise. *See*, *Burgunder*, *supra* note 9, at 791.

139. *E.g.*, *Pagliero v. Wallace China Co.*, 198 F.2d 339, 343–34 (9th Cir. 1952); (concluding that floral design of china pattern was aesthetically because it was an important reason in its commercial success); *Industria Arredamenti Fratelli Sapori v. Charles Craig, Ltd.*, 725 F.2d 18, 20 (2d Cir. 1984) (The design of an Italian sofa was aesthetically functional because it enhanced saleability); *Damn I’m Good, Inc. v. Sakowitz, Inc.*, 514 F.Supp. 1357 (S.D.N.Y. 1981) (The phrase, *Damn I’m Good*, did not identify source and was functional because it was an important ingredient in the products’ commercial success).

140. *Pagliero*, 198 F.2d 339.

display the sentiments.<sup>141</sup> Following this logic, most prominent Jesus-based statements could never serve as trademarks on expressive products, even if customers understood them to represent source.<sup>142</sup> Having said this, the important ingredient test for functionality has had a checkered past, and most courts have rejected or questioned its application.<sup>143</sup> For this reason, this article does not advocate applying the draconian approach here. However, perhaps it should serve as a warning to be more cautious before granting trademark rights to Jesus-related statements on expressive products.

An aesthetic attribute would also be deemed functional if the feature is more desirable or provides greater market power than other designs that competitors might conceivably use with their products.<sup>144</sup> So, if “Jesus 4 Me” were one of only a very few excellent ways to express a love for Jesus, then it might be unfair to give companies rights to those few possibilities. However, the result seems unlikely since there are an enormous number of expressions that people might create that are equally effective in articulating this emotion. Thus, the functionality doctrine should not serve as an absolute bar to obtaining trademark rights in expressions involving Jesus. Having said this, a functionality issue may be more credible when the issue is about protecting the sole word “Jesus.” Despite the theoretical basis for the dilution doctrine, Jesus S.R.L., the owner of JESUS, has a credible threat against anyone wanting to consistently make a Jesus-related statement on an expressive product, on the grounds that the appropriation of its entire mark causes a likelihood of confusion.<sup>145</sup> Since the trademark owners of other Jesus-related phrases cannot so widely make this claim, Jesus S.R.L. has a relative competitive advantage

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141. See, Burgunder, *supra* note 9, at 792.

142. The notable exception would be if the Jesus-related statement had become well known in another context to represent source. Although customers might purchase the shirt because they wanted to display the slogan, the attraction results from the reputation previously developed by the organization through its other activities identified with the slogan. For this reason, the statement is not functional on the expressive products because the demand is not created by a non-reputation related attribute, as required by the Supreme Court in *Traffix Devices Inc.*, 532 U.S. at 33. Cf. *Au-Tomotive Gold, Inc., v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1064, 1074 (9th Cir. 2006) (ruling that application of “Audi” on key chains was not functional because the demand derived from the goodwill of the automaker’s trademark.).

143. See, e.g., *Keene Corp. v. Paraflex Indus., Inc.*, 653 F.2d 822, 825 (3d Cir. 1981). For a history of aesthetic functionality and problems related to the “important ingredient” test, see *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.* 696 F.3d 206, 219–22 (2d Cir. 2012); *Au-Tomotive Gold*, 457 F.3d at 1067–72.

144. See, e.g., *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 170 (1995); *Louboutin*, 696 F.3d at 221–22; *W. T. Rogers Co., Inc. v. Keene*, 778 F.2d 334, 339–40 (7th Cir. 1985).

145. Cf. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 213 (2000) (stating that consumers should not be deprived of the benefits of competition with regard to the aesthetic purposes that product design serves by a rule of law that facilitates plausible threats of suit against new entrants.).

simply by virtue of its exclusive rights to JESUS. Nevertheless, the functionality doctrine may be a slightly awkward way to address the problem, and as we shall see, genericism may be the better approach.<sup>146</sup> In any event, the bottom line is that a trademark should never provide a competitive advantage unrelated to its owner's goodwill, and so, at the end of the day, one of the doctrines should prevent the result.<sup>147</sup>

*B. Can Statements about Jesus on Expressive Products Be Distinctive?*

Trademarks are identification symbols that are attached to products in order to represent source. As the range of features serving as trademarks has expanded to attributes such as product designs, the concept of attachment has moved from the physical to the conceptual. Thus, a viewer who sees the phrase "Jesus Freak" on a t-shirt must at least be able to conceptually separate the statement from the overall shirt design and then use it to identify the source of the product.<sup>148</sup> Recently, the Supreme Court determined that customers would almost never, at first, automatically make that conceptual leap, but that over time they might make the connection, especially if the seller takes steps, through advertising or other actions to highlight the attribute's trademark significance.<sup>149</sup> In other words, when the shirt is originally sold, customers will believe that "Jesus Freak" is simply an expression on the shirt, but over time they may understand that it primarily serves to identify source.<sup>150</sup> For this reason, the t-shirt seller has no right to prevent others from prominently displaying "Jesus Freak" on their shirts until that seller can demonstrate that the phrase has attained secondary meaning.<sup>151</sup>

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146. See *infra* notes 166–169, and accompanying text.

147. Ownership in the JESUS mark clearly establishes competitive advantages with expressive products, since the word is so important to consumer demand. The same issues might also arise with other products, let's say a refrigerator, if consumers would prefer a refrigerator that displays the name of Jesus to an identical refrigerator that says something else, such as Whirlpool. This issue is outside the purview of this article, but one that could be easily tested by marketing professionals.

148. See *Samara*, 529 U.S. at 212; *Duraco Prod., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431, 1449–50 (3d Cir. 1994). JESUS FREAK is a registered trademark for clothing, including t-shirts, sweatshirts, caps and hats, among other items. JESUS FREAK, Registration. No. 3118307.

149. *Samara*, 529 U.S. at 212, 216.

150. According to the Supreme Court, product designs are not "inherently distinctive," as suggestive or fanciful trademarks are, and so should not be accorded trademark rights until the applicant proves that they have acquired source-identification functions. *Id.* at 211–12.

151. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 216 (2000). Secondary meaning can be proven by a non-exclusive list of factors, including: the extent of sales and advertising leading to buyer association; length of use; exclusivity of use; the fact of copying; customer surveys; customer testimony; the use of the mark in trade journals; the size of the company; the number of sales; the number of customers; and actual confusion. See *Ford Motor Co. v. Summit Motor Prod., Inc.*, 930 F.2d 277, 292 (3d Cir. 1991).

The only exception to the secondary meaning requirement is if “Jesus Freak” had already become famous for representing an organization or product in another context. In that event, the phrase already has attained a form of secondary meaning, since viewers recognize it as representing the alternate source.<sup>152</sup> The Lanham Act provides for such immediate protection through what are called sponsorship rights and they apply with equal force to Jesus-related marks.<sup>153</sup> For this reason, a clothing manufacturer might need to get permission before applying “Jews for Jesus” on its wares because the phrase is already a well-known trademark for a non-profit organization.<sup>154</sup>

Although a product design is too integral to the product to serve immediately as a trademark, product packaging is different, because it is simply the veneer that covers the basic product. For this reason, packaging is somewhat like a mark that is placed on a separate product, meaning that if it is inherently distinctive, then it can immediately identify source.<sup>155</sup> So, it should be clear that when the phrase “Jesus Freak” appears on an expressive product, it does not serve as a trademark because it merely advances the product’s primary purpose of informing others about one’s intense devotion to Jesus. However, if the standard phrase is written in a very distinctive way, then the design elements that, in a sense, envelope the phrase may represent source just like inherently distinctive packaging. For this reason, a clothing manufacturer should be able to gain immediate registration for a distinctive stylized design of “Jesus Freak,” but with a clear disclaimer that its trademark protection of the overall design does not cover use of the phrase itself.<sup>156</sup> This would mean that competitors could not copy the distinctive style elements that have trademark

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152. The PTO recognizes this in TMEP §1202.03. (“Ornamental matter that serves as an identifier of a ‘secondary source’ is registrable on the principle register. For example, ornamental matter on a t-shirt (e.g., the designation ‘NEW YORK UNIVERSITY’) can convey to the purchasing public the ‘secondary source’ of the t-shirt (rather than the manufacturing source).”).

153. Lanham Act, 15 U.S.C. § 1125(a)(1)(A). Due to sponsorship rights, Nike might have the right to prevent other companies from stating “Just Do It” on their expressive products, since customers will associate the slogan with Nike and likely believe that the company authorized its use with the product. See, e.g., Burgunder, *supra* note 9, at 784; Irene Caboli, *The Case for a Limited Protection of Trademark Merchandising*, 11 U. ILL. L. REV., 865, 880–86 (2011); Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82:5 NOTRE DAME L. REV. 1839, 1911–12 (2007).

154. JEWS FOR JESUS, Registration No. 1252889, (design mark for religious pamphlets); JEWS FOR JESUS, Registration No. 3226873, (standard character mark for religious services).

155. E.g., *Two Pesos Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992) (restaurant décor may be inherently distinctive). See *Samara*, 529 U.S. at 214–15 (explaining that restaurant décor may be inherently distinctive because it is more like packaging than a product design.).

156. See TMEP §1213 (on disclaimer of Elements in Marks). The PTO explains that a disclaimer of a component of a composite mark means that no rights are being asserted in the disclaimed component standing alone, and that the registration represents only such rights that flow from use of the composite mark. *Id.* See *Sprague Electric Co. v. Erie Resistor Corp.*, 101 U.S.P.Q. 486, 486–87 (Dec. Comm’r Pat. 1954).

significance, for that would surely confuse customers about source, but those manufacturers still would be able to relay the essential message about being a Jesus Freak. Of course, if over time, the phrase “Jesus Freak” attained secondary meaning by identifying the source of the original manufacturer, then that seller could gain exclusive rights to the phrase as well.<sup>157</sup>

*C. Does the First Amendment Trump Trademarks for Statements about Jesus?*

Freedom of speech is a treasured right in the United States, and the government must have important or compelling reasons to impose limitations on the expression of ideas.<sup>158</sup> For instance, the Copyright Act prevents duplication of original expressions to satisfy the important objective of motivating creative works.<sup>159</sup> Copyrights do not protect short statements, though, because they do not require sufficient creative effort to merit interference with the First Amendment.<sup>160</sup> The government, of course, has passed a law that governs short phrases and symbols through trademarks, but for the very different reason to prevent consumer confusion. Thus, one always must be mindful that trademarks are not intended to provide incentives to create clever slogans; rather the goal is to facilitate source identification. So, a statement may be really imaginative, but that is not a reason to limit others from duplicating it via trademarks. Instead, one needs to make sure that the phrase really is understood as a designation of source. When considering statements about Jesus on expressive products, this is best accomplished by requiring proof of secondary meaning.<sup>161</sup>

Even when trademark protection is appropriate, the Lanham Act takes pains to make sure that free speech rights are not implicated.<sup>162</sup> For instance, artists

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157. Lanham Act, 15 U.S.C. § 1056(b) (2006). (No disclaimer shall affect the registrant’s right to register the disclaimed matter if that matter has become distinctive of the goods or services); TMEP § 1213.11 (Acquiring Rights in Disclaimed Matter). *See* Quaker Oil Corp. v. Quaker State Oil Ref. Corp., 161 U.S.P.Q. 547, 549–50 (T.T.A.B. 1969), *aff’d*, 453 F.2d 1296 (C.C.P.A. 1972).

158. *See, e.g.*, N.Y. Times, v. Sullivan, 376 U.S. 254, 269–70 (1964); Universal City Studios, Inc. v. Corley, 273 F.3d 429, 450 (2d Cir. 2001).

159. *See, e.g.*, Feist Pub’n, Inc. v. Rural Tel. Serv. Co., Inc., 499 U.S. 340, 349–50 (1991); Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975).

160. *See* U.S. Copyright Office, Circular 34, *Copyright Protection Not Available for Names, Titles or Short Phrases*. *See also* Feist, 499 U.S. at 359 (“There remains a narrow category of works in which the creative spark is utterly lacking or is so trivial as to be virtually nonexistent. Such works are incapable of sustaining valid copyright.”).

161. *See*, Burgunder, *supra* note 9, at 797–98.

162. *See, e.g.*, Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 973 (1993); Margreth Barrett, *Domain Names, Trademarks and the First Amendment: Searching for Meaningful Boundaries*, 39 CONN. L. REV. 973, 979–81 (2007); Pratheepan Gulasekaram, *Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works*, 80 WASH. L. REV. 887, 899–922 (2005).



who integrate trademarks into works involving parody usually do not infringe due to judicious applications of the likelihood of confusion analysis.<sup>163</sup> Other times, those using trademarks are relieved of liability when they add sufficient transformational content.<sup>164</sup> What is most important for the discussion here is that these approaches typically do not provide sanctuary to those who merely duplicate a trademark and use it on related or competitive products.<sup>165</sup> This means that if a company owns a trademark for “Jesus Freak” when used with clothing, then it will have a credible claim against a competitor who might prominently display it on its merchandise.<sup>166</sup> This is despite the fact that the phrase might not identify source in this context and so should be free under the First Amendment for anyone to say. For this reason, the PTO needs to be very careful before granting trademark rights to statements on expressive products, because the result may be an unwarranted chill on the freedom of speech.

#### IV. SWEET JESUS, IT’S JUST A TRICK!

When evaluating the propriety of trademark registration for expressive products, the PTO makes the same mistake with Jesus-related phrases as it makes more generally with slogans; it fails to recognize that the applicant’s purpose is most typically to control prominent displays of the phrase rather than to facilitate source-identification.<sup>167</sup> Since the PTO doesn’t recognize how the objectives differ with expressive products, it evaluates registration using the same principles as it does for other kinds of merchandise. However, it makes two stunning errors by ignoring the marketing realities.

As previously noted, the PTO must consider whether an applicant’s mark can serve a distinct identification function for the product.<sup>168</sup> To this end, the PTO should never register generic words or phrases, and it should wait to register descriptive terms until the applicant can demonstrate secondary meaning. Regarding the application for JESUS, when used with wearing apparel, the PTO apparently assumes that Jesus is distinctive because it is unrelated to the function of clothing. However, given the special circumstances with expressive products, the PTO has improperly defined the relevant product

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163. *See, e.g.*, *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1007–10 (9th Cir. 2001); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, L.L.C.*, 464 F. Supp. 2d 495 (E.D. Va. 2006); *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161 (C.D. Cal. 1998).

164. *See, e.g.*, *Comedy III Prod. Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001)

165. *See id.* at 811.

166. *Cf. Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214 (2000) (stating that legitimate uses may be deterred not only by successful suit, but by the plausible threat of successful suit.).

167. *See, Burgunder, supra* note 9, at 782.

168. *See supra* notes 15–27, and accompanying text.

market.<sup>169</sup> With expressive products, the applicant is not merely interested in placing an identification tag or symbol with the product; rather the goal is to prominently emblazon the merchandise with the statement. So, when considering statements about Jesus, market realities suggest that the product definition is not simply t-shirts or mugs, but instead is something much more limited, such as “products that comment on Jesus” or, for short, “Jesus merchandise.” So, the question is whether the singular word “Jesus” is a generic description for the entire class of Jesus merchandise. If the answer does not seem completely obvious, think about whether a mountain bike company should have sole rights to the word, “mountain.” In other words, its products would be “mountain” mountain bikes. The absurdity of this notion is no different than allowing a company to have sole rights to JESUS Jesus merchandise. Since the word “Jesus” is the one unifying element across the entire product class, it cannot be viewed as anything but generic for that class.<sup>170</sup> Thus, the PTO was correct in perceiving that the word, Jesus, is very weak due to extensive use. Where it went astray was in thinking that it could have *any* trademark significance at all when associated with expressive products bearing that name. Thus, the PTO erred when it granted a registration for the singular word “Jesus” for various types of expressive products.<sup>171</sup>

Although the generic word “Jesus” cannot be claimed by itself as a trademark, it might be distinctive when combined with other words. For this reason, a phrase such as “Jesus Surfed” is not the generic designation for all Jesus merchandise, and so is capable of designating source. However, it

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169. For a discussion of the importance of appropriately defining the product class before making judgments about the competitive effects from trademark protection, *see* Burgunder, *supra* note 16, at 729–30.

170. *Cf.* *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (equating “common descriptive names” with generic terms.). In the same way, cotton is not a generic word for a shirt, it would be inappropriate to register the word as a standard character mark for cotton shirts because it is a common descriptive term for that specific kind of shirt. Cotton is registered for various products, including garments, but as a design mark that specifically disclaims the word “cotton” apart from the design. COTTON, Registration No. 1255361.

171. Jeans are not necessarily expressive products to the same degree as t-shirts and hats. Thus, one might argue that jeans are not Jesus merchandise as defined here and that the PTO should not prevent registration of JESUS for jeans on the grounds of genericism. Nonetheless, since jeans are in the same class as t-shirts and hats, by virtue of being clothing, the registration would still allow the trademark owner to raise credible claims of infringement against those using “Jesus” on Jesus merchandise. To prove the point, Jesus Jeans S.R.L. claimed that the use of “Jesus Surfed” on hats infringed its JESUS trademark, even though Jesus Jeans S.R.L. deleted hats and caps from its registration on Oct. 5, 2012. Notice of Opposition at 2–3, *Jesus Jeans S.R.L. v. Anton*, (T.T.A.B. Feb. 20, 2013) *available at* <http://ttabvue.uspto.gov/ttabvue/v?pno=91209383&pty=OPP&eno=1> (claiming that the applicant for *Jesus Surfed* was attempting to register the name for related goods in the same channels of trade). In any event, the registration still covers other clothing products besides jeans, including t-shirts.

certainly is not inherently distinctive for its product class. Rather it should be viewed as descriptive for Jesus merchandise that prominently conveys a particular emotional sentiment – here peaceful reflection. Thus, the term should be registered as a standard character mark only after the company can prove that “Jesus Surfed” has acquired secondary meaning beyond a description of reflective Jesus merchandise. This, of course, is a good solution, because it mirrors what the company also must do to obtain exclusive rights to prominent displays of the phrase on its merchandise. As with prominent displays, it is equally true here that the company could immediately register a distinctive stylized version or design that includes the phrase, because the artistry would render the entire image to be suggestive or arbitrary.<sup>172</sup> In this event, the registration would not prevent others from using the unadorned descriptive phrase, at least until it attains secondary meaning.

The other mistake that the PTO makes is perhaps the more egregious. In order for a word to represent source, consumers must recognize that the word is being used as a trademark. The PTO acknowledges that prominent words on expressive products do not immediately convey a trademark function.<sup>173</sup> That is why proof of secondary meaning is required in this context.<sup>174</sup> However, the PTO will immediately register the term if the specimen shows a small discrete use or if it is displayed on a tag or label.<sup>175</sup> Even if one takes the position that “Jesus Surfed” is not technically descriptive for expressive merchandise, registration would still render the wrong result.

The PTO needs to recognize that the submission of a tag or label as a specimen has simply become a trick to dupe examiners into allowing the registration. Clearly, the applicant wants the registration so that it can have exclusive rights to display “Jesus Surfed” prominently on t-shirts, hats, sweatshirts and bandanas. In theory, a registration would only give it exclusive rights to include hang tags or discrete labels with its wares, but there is no doubt that Anton would oppose any other company that used the phrase on competing products. The litigious posture of the Jesus@-brand clothing company bears this out. In theory, those companies that prominently display Jesus Surfed would not violate any rights, at least until the phrase had attained secondary meaning. But what would you do if a trademark owner showed you a registration for the exact same phrase covering the same products that you are

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172. *See supra* note 5.

173. TMEP §1202.03)f(1).

174. TMEP §1202.03(1).

175. TMEP §1202.03(a) (stating that “[a] small, neat and discrete word or design feature . . . may be likely to create the commercial impression of a trademark.”); TMEP §904.04 (Material Appropriate as Specimens for Trademarks, including labels and tags).

selling?<sup>176</sup> Based on typical likelihood of confusion principles, you probably would think it best to simply give up rather than fight a contest that you actually should win.<sup>177</sup> Thus the result is that the registration has served no useful function besides deterring legitimate speech.

Solving the problem is simple. An applicant who wants trademark rights for a Jesus-related phrase as a standard character mark on expressive products must prove secondary meaning before obtaining registration. In light of the *Abercrombie* distinctiveness spectrum for standard character terms, this is probably the correct outcome. But beyond that, it prevents the obvious chilling effect that registration will invariably have on those wanting to make prominent uses of the same term.

### CONCLUSION

The PTO's willingness to register JESUS for expressive products and the resultant controversies and complaints illustrate that this topic merits greater attention and clarity. The public obviously needs to better understand when a registration might be disparaging, and whether offensive advertising or use of a trademark should be grounds for opposition or cancellation. Perhaps of greater importance, the PTO must reconsider its policies about registering Jesus-related trademarks for expressive products so that they are more consistent with the goals of the trademark system. Although it may be appropriate for the PTO to immediately register designs that reference Jesus, the agency should deny the registrations for standard character marks until the applicant demonstrates secondary meaning.

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176. *See, e.g.*, *AMF Inc., v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979). (explaining that with competing goods, likelihood of confusion is determined by comparing the similarity of the marks.)

177. *Cf. Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 213 (2000) (finding that a blanket rule requiring proof of secondary meaning for protection of product designs is justified because of plausible threats of a lawsuit).