

Federal Circuit Blocks Trademark for Being Disparaging to Muslims

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Quick View

Section 2 of the Lanham Act contains a variety of limitations on trademark registration.² Some are widely used—for example, the prohibition on merely generic marks. Others rarely come into play, including a registration bar for any mark containing “matter which may disparage.”³ In its first ever interpretation of this statutory provision, the Federal Circuit in *In re Geller* affirmed a decision of the Trademark Trial and Appeal Board (TTAB) that denied federal registration to the mark STOP THE ISLAMISATION OF AMERICA. The Federal Circuit agreed with the TTAB that the mark would be disparaging to a substantial composite of the American Muslim community. The stakes are high here because the Federal Circuit is the typical route for appeals of TTAB decisions, and a highly anticipated decision from the TTAB on disparagement involving the WASHINGTON REDSKINS mark is due soon.

Pamela Geller and Robert Spencer tried to register their STOP THE ISLAMISATION OF AMERICA mark in connection with services of “understanding and preventing terrorism.” Geller and Spencer are known for their criticism of Islam, particularly their opposition to the construction of a mosque and Islamic Center near the former site of the World Trade Center. Organizations started by Geller and Spencer, including Stop the Islamisation of America, have been designated as hate groups in the United Kingdom and attracted widespread criticism in this country. This background appeared to influence the Federal Circuit’s view as to whether Geller and Spencer’s mark was disparaging.

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² See 15 U.S.C § 1052.

³ See *id.* § 1052(a) (“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute”).

The Federal Circuit began its analysis by endorsing the TTAB's two-prong test for disparagement inquiries. Under the first prong of that test, a court must determine the likely meaning of the mark in question. Under the test's second prong, the court examines whether the likely meaning refers to an identifiable group and, if so, whether that meaning is disparaging to a substantial composite of that group. The Federal Circuit spent most of its time on the first prong, examining the evidence for the TTAB's finding that "Islamisation" has a public meaning referring to conversion or conformance to Islam. It endorsed the TTAB's use of online dictionaries, but also ratified its consideration of essays posted by Geller and Spencer on their own website as well as anonymous reader comments posted on the same website. With regard to the essays, the Federal Circuit read them as advocating suppression of the entire Islamic faith, rather than merely critiquing particular political groups like the Muslim Brotherhood. The essays called for opposing mosque-building, which the Federal Circuit implied was tantamount to an attack on Islam itself. With regard to the website comments, the TTAB cited posts like "Islam is evil" and "There's only one thing you can do and that's say no to Islam and the Islamization of America." Geller said that these were "cherry-picked anonymous comments" deserving of no evidentiary weight. Nevertheless, the Federal Circuit affirmed the use of such evidence in determining the likely meaning of the applicants' mark. From there, it was not surprising that the court, in evaluating the test's second prong, found that STOP THE ISLAMISATION OF AMERICA refers to American Muslims and that this group would be offended by a mark associating Islam with terrorism.

In many ways, the Federal Circuit's opinion is not surprising. The reported decisions evaluating whether marks are disparaging or "scandalous" (another registration prohibition under Section 2) reveal longstanding concern over marks that can offend the sensibilities of particular religious or ethnic groups. For example, a 1938 case heard by the Federal Circuit's predecessor, the Court of Customs and Patent Appeals, involved the mark MADONNA in connection with wine. Denying registration, the CCPA relied on its own intuition that intoxicating liquors like wine cause various "evils" while the Madonna in Christianity "stands as the highest example of the purity of womanhood, and the entire Christian world pays homage to her as such."⁴

What *In re Geller* suggests, however, is current judicial discomfort with the disparagement provision of the Lanham Act and an attempt to build a larger doctrinal edifice to justify its existence. The two-prong test endorsed by the Federal Circuit looks like scaffolding meant to make the

⁴ *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938).

disparagement analysis seem more rigorous than it really is. After all, once the court determined the likely definition of STOP THE ISLAMISATION OF AMERICA, it seems like the determination that the mark was disparaging to American Muslims was pretty obvious. The Geller decision also authorizes an expansion in the amount of evidence that should be brought to bear in determining whether a particular group is being disparaged. Do we really want examiners at the PTO building lengthy cases regarding the likely interpretation of a potentially disparaging term by doing things like sifting through anonymous reader comments? It might be better to simply rely on dictionary definitions, which in this case would have been enough to conclude that the applicant's mark was meant to "stop" an entire religion.

In a recent article, I maintain that judges frame trademark decisions (and intellectual property law decisions in general) in the seemingly neutral language of efficiency and economic analysis but, beneath the surface, there are often hotly contested moral considerations that drive judicial outcomes. Today, it is not considered appropriate for judges to apply moral intuition to their decisions, particularly in the utilitarian-based world of intellectual property law. But this happens all the time in trademark law, from findings of infringement to mark validity to geographic restrictions. But it is usually done behind the scenes. Section 2(a)'s prohibition on disparagement, however, offers a seemingly blank check for judges to engage in just this sort of unfettered analysis of right and wrong. The legalistic approach adopted in Geller shows that the Federal Circuit is nervous about cashing this blank check. Disparagement issues will continue to appear, but it is likely that courts will decide these issues only reluctantly and with a preference for anchoring determinations in seemingly neutral doctrinal frameworks and comprehensive sources of "likely meaning."

Cited as:

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