

USPTO Should Rethink Its Resistance To Political Slogan TMs

By **John Halski** (February 25, 2021, 6:22 PM EST)

The events of Jan. 6 at the Capitol were unprecedented on a number of counts. The images of a disorganized mob flooding into the U.S. House of Representatives and U.S. Senate chambers are seared into the national memory, perhaps forever.

As a trademark attorney, I noticed something else unusual about the day. It's admittedly mundane by comparison, but it's something I've thought a lot about since — that is, the lack of a single trademark application, either before or after that date, for one of the more common rallying cries of the movement: "Stop the Steal." An application for "We Did Stop the Steal" filed on Feb. 19 is the closest attempt.



John Halski

Maybe that's not surprising, given that many of those who might want to claim the phrase have been arrested. On top of that, "Stop the Steal" is actually an old slogan, previously used in 2016 by a controversial 527 advocacy group affiliated with former President Donald Trump's ally Roger Stone. The slogan lay dormant for years before it exploded among right-wing groups once the former president's loss became clear.

In any event, once a political slogan begins appearing on homemade signs and in posts by competing Facebook groups, the trademark applications usually follow. And those applications are often followed by a blanket of refusals from the U.S. Patent and Trademark Office.

Whatever the reason, the lack of applications led me to wonder whether someone could register "Stop the Steal" as a trademark now that it has entered the public lexicon in its own ignominious way. I believe the answer is a solid maybe for the right applicant, but that may depend on the USPTO's taking a fresh look at how it handles applications to register political slogans in general. And that is something I would say is well overdo.

The Buck Stops Here

The USPTO has taken a hard line against the registration of political slogans in recent years. In particular, the office has leaned heavily on the argument that political slogans fail to function as trademarks whatsoever. It's a trend that I believe calls for a course correction toward a more nuanced approach — one that more clearly acknowledges that political slogans may function as trademarks in certain

situations and that clearly identifies the issues when a slogan does not.

This idea is not only grounded in sound trademark principles; it could also benefit the public in general by helping to clarify who speaks for a movement, or at least who claims to do so. It is undoubtedly a messy question, with implications stretching beyond trademark law. But it is nonetheless a question that the USPTO can address within the context of established examination guidelines and precedent.

By way of example, let's consider an application to register "Stop the Steal" and apply the standards used by the USPTO against other political signs and slogans filed for registration. However, let me stress that I do not mean to draw any comparison between the underlying sentiments represented by "Stop the Steal" and those embodied by these other marks.

Rather, this exercise is intended to show that, applying the same rigor and attention to detail that the USPTO applied to these other applications, the USPTO has shown that it has all the tools it requires to turn the failure-to-function standard from a worn sledgehammer to a finely sharpened scalpel.

The Only Thing We Have To Fear

It's important first to understand a few things about what failure to function means in this context and why it has become such a boogeyman for trademark applicants. Every trademark filed with the USPTO is reviewed by an examiner to assess its registrability. This analysis is highly subjective, and the examiner is given wide discretion to decide, for example, whether a trademark is merely descriptive or likely to cause confusion with an existing trademark.

Among the questions an examiner asks is whether a putative trademark actually functions as a trademark; i.e., whether it distinguishes the source of the goods or services of one party from those of others.

There are many ways to fail this test. For example, a generic term cannot function as a trademark for the goods or services the term identifies. The word "Apple" on a Red Delicious doesn't distinguish the grocer or orchard of origin. Of course, the word "Apple" on a laptop is a different story. Likewise, an ornamental design on a T-shirt may not function as a trademark. Instead, it may function only on an informational or aesthetic level.

And then there are phrases that fail to function because they consist of merely informational matter, "merely" being the operative word. As the Trademark Manual of Examining Procedure explains, a phrase may be merely information if it (1) conveys general information about a specific good or service; (2) is pulled directly from a religious text; or (3) is a common phrase people are accustomed to hearing from various sources.

It's the last category that tends to trip up political slogans. Armed with little more than a Wikipedia entry and a handful of online search results, an examiner can find that a political slogan fails to function as a trademark and stop an application in its tracks.

A refusal on failure-to-function grounds can be especially devastating insofar as it can prevent registration of the mark for any goods or services. Thus, it so happens that "Black Lives Matter" has been denied registration as a trademark not only for political services but also for such apolitical goods as wine and hand sanitizer.

This is what really sets the failure-to-function refusal apart. By comparison, a word that is generic for some goods may be entirely registrable for others, as in "Apple" for computers. And a design that is merely ornamental on the face of a T-shirt may still function as a trademark on the tag. But failure to function can be the death knell for a trademark regardless of where or how it is used.

Unsurprisingly, the broad discretion given to examiners also leads to wildly incongruous results. For example, the USPTO approved "Abolish Abortion" for registration yet refused "Just Say Absolutely No To Abortion" because it merely conveys an informational message.

In another example, the USPTO refused to register the phrase "Random Acts of Kindness" for failure to function despite approving the very same phrase in several other simultaneously filed applications. This resulted in a rare instance of the Trademark Trial and Appeal Board's reversing the examiner's refusal on appeal.

In yet another recent decision, the TTAB cited the USPTO's refusal of "Once a Marine, Always a Marine" as an example of a phrase that failed to function as a trademark. The cited application was refused in 2010 "because the evidence showed that it is a common motto used by, and in support of, the U.S. Marines."

What the TTAB failed to mention is that, since 2010, the USPTO approved the very same mark for registration — twice. In both cases, the applicant was the U.S. Marine Corps, which goes to show the importance of context.

Trust But Verify

Returning to our hypothetical application, it's safe to assume that an application for "Stop the Steal" would initially be refused on the grounds that it is commonly used and conveys a political message. The examiner would likely rely on photos of protestors brandishing the phrase and cite the Wikipedia entry that describes "Stop the Steal" as "a far-right campaign and protest movement."

As things typically go these days, this would likely be the end of the story, give or take a futile appeal to the TTAB. But it should be just the beginning of the analysis. When it comes to political slogans in particular, a closer look at the prosecution history of a few prominent cases provides a guide map to a clearer, more consistent criteria for registration or refusal.

"No More RINOs!"

Anyone who has faced a failure-to-function refusal for a political slogan knows the 2013 *In re: Hulting d/b/a No More RINOs!* TTAB decision, or at least the citation. Going solely by the typically used parenthetical, the decision stands for the axiom that a phrase that would be perceived merely as a commonly used political message cannot be registered.

In fact, the decision arguably functions as a per se rule against the registration of political slogans — the sort of analysis divorced from context that the U.S. Supreme Court recently chastised the USPTO for in the 2020 *USPTO v. Booking.com BV* decision.

The full story is that "No More RINOs!" was initially approved for publication without objection. The examiner changed course once the applicant submitted the necessary specimen of use, which led the examiner to object that the mark as used on a bumper sticker was merely ornamental. In other words,

the problem was the manner of use, not the message.

The examiner only later refused the application on failure-to-function grounds, briefly taking the position that no one may obtain trademark rights to "No More RINOs!" — period. However, the examiner ultimately softened that position and argued before the TTAB that the slogan failed to function as a trademark on political paraphernalia specifically. And on that basis, the TTAB upheld the refusal.

While the case has come to stand for a far more draconian message, a closer look at the underlying rationale leaves us with our first guidepost on the map to registration. In our hypothetical application, does "Stop the Steal" merely convey a message as used? Or does it also function as a trademark when the use of the phrase by the applicant is considered in context?

Women's March

As brand launches go, "Women's March" could have been the envy of companies everywhere. Starting with a single Facebook post in November 2016, the "Women's March" brand exploded into a household name almost overnight.

By January 2017, the rallying cry and the organization that grew around it, Women's March Inc. galvanized millions and sparked hundreds of gatherings worldwide. But WMI faced a problem when it filed to register "Women's March" as a trademark: The "Women's March" movement had grown beyond the organization.

The examiner initially refused WMI's application on the grounds that "Women's March" was merely descriptive of public advocacy and that it was merely ornamental as used on WMI's goods. The applicant responded with a healthy stack of evidence purporting to show that consumers recognized "Women's March" as WMI's trademark specifically, which convinced the examiner to approve the application for publication.

Then came the oppositions — plural. Some of the opposing parties claimed that they had priority over the trademark, while others argued that "Women's March" failed to function as a trademark. All insisted that WMI did not speak for the entire movement. As it happened, the matter resolved itself once WMI voluntarily withdrew its application, effectively ending the dispute at the USPTO at least.

In this case, the system worked, and we have our next guidepost. Having established that "Stop the Steal" expresses a political message, can our hypothetical applicant produce evidence showing, as used, that consumers also perceive the slogan as its trademark? Let's not concern ourselves over whether other parties may object to our applicant's claims. That's what oppositions are for.

The Swastika

In the 2016 *Matal v. Tam* decision, the Supreme Court held that the First Amendment prevents the USPTO from denying trademarks under the disparagement clause of the Lanham Act. In the aftermath, trademark attorneys braced for the inevitable wave of controversial and insensitive trademark applications. Sure enough, just a few days after *Tam* issued, someone filed to register the swastika as a trademark for fabrics.

The USPTO sat on that application for over two years, waiting for the court to issue a decision in *lanca v.*

Brunetti. This case concerned the prohibition of immoral and scandalous marks, which the USPTO would certainly have cited against the swastika if it could. For better or for worse, in 2019, the court struck down that provision of the Lanham Act as well. The situation called for creativity from the examiner, and necessity was again the mother of invention.

The examiner initially argued that the swastika does not function as a trademark since it is a universal symbol (undoubtedly true) that consumers will not perceive as an indicator of source (possibly true). Instead, he argued consumers would perceive it as "an indicator that the product was associated with Nazi beliefs, white supremacy or as a general symbol of hate."

This argument suffered from at least two potential problems. The first was called out by the applicant right away: that the refusal relied on the same sort of viewpoint discrimination that the Supreme Court held unconstitutional in *Tam and Brunetti*. The second problem is perhaps more troubling, which is that the American Nazi party exists, and, under the First Amendment, it has the right to exist and promote itself.

Thus, while it is unclear whether the swastika functions as a trademark for the applicant, a company called Snowflake Enterprises LLC, it seems undeniable that it could function as a trademark for a self-identified Nazi organization, regardless of the moral revulsion we may feel at seeing a true symbol of hate on a federally issued document.

That brings us to the second ground for refusal subsequently raised by the examiner, namely, that the applicant is not actually a Nazi nor a genuine spokesperson for a Nazi organization.

Specifically, the examiner found evidence that the applicant lacked a bona fide intent to use the mark in commerce, citing public statements by the applicant that he was seeking the trademark to "beat back white supremacists."

By his own words, the applicant showed that he had no intention of using the swastika as a trademark. The applicant has contested this characterization of his words in a response to the refusal.

Thus, it no longer matters whether the symbol functions as a trademark since the application is void. This example also provides us with our third guidepost. Does our hypothetical applicant have a bona fide intent to use "Stop the Steal" as a trademark?

Or is the true intent to monopolize a political expression for some other nontrademark purpose? This may be a difficult question to answer without a deep dive into the facts. But then examiners are given wide discretion to seek information for exactly that purpose.

Yes We Can!

I do not pretend that any of these standards of review are simple or immune to inconsistent outcomes of their own.

But I do believe that the heavy reliance by the USPTO on failure-to-function refusals, often with minimal evidence and threadbare arguments in support, has not only increased the inconsistency but also the incoherence of the examination process. When the very slogans cited by the TTAB as examples of failure to function as trademarks are also registered as trademarks by the USPTO, the situation calls for reassessment.

If someday someone files to register "Stop the Steal," the question cannot be merely whether the phrase expresses an opinion, or whether it is commonly used based on a cursory online search. The specific context of how the phrase is used by the applicant, how that use is perceived by consumers, and, even in some cases, the underlying intent of the applicant must be analyzed as well.

Again, the fact that no one has tried to register the slogan by itself may say it all. But if someone wants to try, the examiner should hear them out, seek out any information necessary to make a fair judgment, and then make a fully informed decision separating out mere political slogans from actual trademark use.

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