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Trademark Trial and Appeal Board not flip about the bird

By Steven L. Baron and Natalie A. Harris

The Trademark Trial and Appeal Board (“TTAB”) ruled hands down against the maker of a beverage bottle that gives consumers the finger.¹ On September 19, 2011, the TTAB affirmed the United States Patent and Trademark Office’s (“USPTO”) refusal to register a trademark application for “a bottle in the shape of a hand with the middle finger extended upwards” on the grounds that the proposed mark is “immoral” or “scandalous” within the meaning of 15 U.S.C. § 1052(a).²

On March 12, 2008, Luxuria, s.r.o. (“Luxuria”), a Czech company, filed an application based on its international registration³ depicting a beverage bottle flashing “the universal signal of discontent”⁴ for beers and other alcoholic and nonalcoholic beverages.⁵ Following the USPTO’s refusal, Luxuria appealed to the TTAB.

After the parties submitted their respective appeal briefs, Luxuria filed a remand request for consideration of additional evidence.⁶ The allegedly late-breaking evidence included articles suggesting that the middle finger is losing its shock value;⁷ can be used to express something as benign as excitement over new shoes⁸ and is often used “in a cheeky and fun manner, between friends.”⁹ The TTAB determined that Luxuria failed to demonstrate “good cause” for the requested remand, in part because it was not clear that the material was not previously available.¹⁰ The TTAB allowed Luxuria to file a second request for remand supported by a showing of good cause, specifically recommending an affidavit regarding Luxuria’s efforts during prosecution to obtain the additional evidence.¹¹ Luxuria did file a second request for remand, but did not lift a finger with respect to providing details about the steps it took to search for the evidence during prosecution. Accordingly, the TTAB denied Luxuria’s request for remand.¹²

Luxuria filed its reply brief and attached the *very same* evidence it had sought to make of record through its prior requests for remand.¹³ Luxuria crossed its fingers, hoping the TTAB would turn a blind eye. However, the TTAB caught Luxuria red-handed: “We cannot help but note the convergence between applicant’s actions toward the Board and the message conveyed by its mark.”¹⁴ As a result, the TTAB disregarded Luxuria’s entire reply brief, including the attached evidence.

Luxuria may have let an opportunity slip through its fingers by failing to make its evidence of record. The TTAB acknowledged that “[w]hether the mark consists of or comprises scandalous matter must be determined from the standpoint of a substantial composite of the general public (although not necessarily a majority), and in the context of contemporary attitudes.”¹⁵ Furthermore, some evidence properly in the record suggested that “the finger” “can be a strange, friendly greeting for some” and that the gesture can be found in film, television and political contexts.¹⁶ Luxuria may have laid its finger on critical evidence demonstrating the changing nature of the general public’s perception of “the bird,” but its

procedural misstep cooked the goose.

The TTAB concluded that the gesture depicted by Luxuria's mark is the visual equivalent of the extremely offensive expletive "f*** you," and noted that "[j]ust as these words would be considered scandalous and immoral if used as a trademark. . .the visual depiction of these words by the finger gesture shown in applicant's mark is equally scandalous and immoral."¹⁷ The TTAB's decision to point the finger at Luxuria appears particularly arbitrary in light of USPTO records reflecting live registrations for FUK U CONDOMS,¹⁸ BIG PECKER wine¹⁹ and BONG SCHLONG crocheted fabric covers for glass water pipes and male penises.²⁰ It seems the TTAB may not quite have its finger on the pulse of contemporary attitudes towards scandal and immorality. ■

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- 1.
2. *In re Luxuria s.r.o*, 100 USPQ 2d 1146 (TTAB 2011).
3. According to the WIPO database for the Madrid System for the International Registration of Marks, Luxuria's mark (International Registration No. 969241) is registered in Australia, Japan, Namibia, Norway and Zambia. The same mark was refused registration in Belarus, China, Cuba, Cypress, Morocco, Mozambique, Serbia, Russian Federation, Singapore, Turkey and the Ukraine. <<http://www.wipo.int/romarin/detail.do?ID=0>>.
4. *People v. Meyers*, 352 Ill.App.3d 790, 794 (2nd Dist. 2004).
5. *In re Luxuria*, 100 USPQ 2d at 1146.
6. *In re Luxuria*, 100 USPQ 2d at 1147.
7. TTAB Proceeding No. 79055664, Applicant's Request To Suspend and Remand Appeal For Consideration of Additional Evidence, filed Nov. 30, 2009 at Ex. A (*Martha Irvine, Is the Middle finger Losing Its Shock Value?*, *Columbian*, Feb. 26, 2003).
8. *Id.* at Ex. B (*Ira P. Robbins, Digitus Impudicus: The Middle Finger and the Law*, 41 U.C. Davis L. Rev. 1403, 1407-8 (2008)).
9. *Id.* at p.3 and Ex. C.
10. *In re Luxuria*, 100 USPQ 2d 1147.
11. *Id.*
12. *Id.*

13. *Id.*

14. *Id.* at 1148, *fn* 3.

15. *Id.* at 1148 (citing *In re Boulevard Ent., Inc.*, [334 F. 3d 1336](#) (Fed. Cir. 2003)).

16. *Id.* at 1150.

17. *Id.* at 1151.

18. U.S. Serial No. 85322631

19. U.S. Serial No. 3621024



20. *The mark consists of the stylized text “BongSchlong protector.” The word “protector” appears under the letters “Schlong” in “BongSchlong.” The stem of the letter “B” is made from a phallus symbol. (U.S. Serial No. 85344882).*

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