

EVERYBODY VS. PROFITEERS

In Re: Go & Associates, LLC, No. 2022-1961 (Fed. Cir. Jan. 22, 2024)

By: Ifti Zaim & Emad Mahou | January 26, 2024

In an opinion made precedential at the PTAB's request, the Court of Appeals for the Federal Circuit ("CAFC") affirmed a PTAB determination that a trademark application for the wordmark "EVERYBODY VS. RACISM" committed a "cardinal sin" under the Lanham Act by undermining the source-identifying function of a trademark. The Act conditions the registration of any mark on its ability to identify and distinguish the goods and services of the owner from those of others. Still, the PTAB found, and the CAFC agreed, that this mark was not source-identifying and instead co-opted political expression.

On June 2, 2020, Go filed its application on "EVERYBODY VS. RACISM" for use on such goods as tote bags, T-shirts, and other clothing, as well as services such as "[p]romoting public interest and awareness of the need for racial reconciliation." The examiner rejected the application, reasoning that the mark failed to function as a source identifier for Go's goods and services. Rather, the examiner found that the mark was an informational social or political message that merely conveys support for or affiliation with the ideals conveyed therein. The Trademark Trial and Appeal Board affirmed.



On appeal, the CAFC reiterated that what makes a trademark a trademark is its source-identifying function, and this inquiry is not just limited to just determining whether the mark is generic or merely descriptive. What matters is how the mark is used and what consumers in the market perceive the mark to mean. The CAFC reasoned that a mark is not registerable if consumers do not perceive the mark as source-identifying and such unregistrable marks include those comprising of "informational matter," such as slogans or phrases commonly used by the public.

The examiner found extensive use of the claimed phrase on clothing items by third parties in an informational and ornamental manner to convey anti-racist sentiments. Further evidence showed that the phrase frequently appeared in opinion pieces, music, podcasts, and organizations' websites in support of efforts to eradicate racism. Notably, Go did not dispute that those uses were not its own. Instead, Go argued that the mark had rarely been used before it began to use it, and that its "successful policing" of the mark led to a significant drop in web searches for the mark (notably achieving the opposite of 'raising awareness,' a purpose for which Go claimed the mark in its trademark application). The CAFC affirmed the Board's findings as supported by the evidence and rejected Go's appeal on the basis that Go merely sought that the CAFC re-weigh the evidence considered by the Board (which it would not do).

Go further argued that the Board's "per se" refusal of its application on the basis that it claimed informational matter is unconstitutional as a content-based restriction on speech not justified by a compelling or substantial governmental interest. The CAFC found this argument meritless and grounded in the faulty premise that the PTO's reliance on the informational matter doctrine results in per se refusals regardless of whether the mark is source-identifying or not. Additionally, the CAFC reasoned that there are widely used slogans that nonetheless function as source identifiers, for example, "TRUMP TOO SMALL," which the CAFC reversed the Board's refusal to register the mark and held the board's decision to be unconstitutional.

As the dust settles, it is clear that while the PTO allows trademarks on phrases and slogans, it will only do so if the phrase or slogan is source-identifying. Contrary to Go's argument, however, barring trademarks on political expression is not an unconstitutional impingement on free speech. Gating the free expression of political ideas behind trademark monopolies and licensing fees, however, would impinge on free speech.