

Response to Office Action

Trademark: **FUCK**
Serial Number: 88/310,900
Classification: 35
Deadline: May 8, 2020
Owner: Erik Brunetti

In his second, non-final Office Action, the Examining Attorney has raised one new issue concerning Applicant's **FUCK** mark, basing his refusal on the grounds that it is a commonplace word. Applicant hereby provides the following facts and arguments in order to overcome the cited refusal.

1. Introduction

The U.S. Patent & Trademark Office should withdraw its refusal of **FUCK** in International Class 14 and approve the application for publication. The PTO refused the mark on the grounds that the applied for mark is a "widely used commonplace word." However, that is not a valid doctrine under the Lanham Act. Nor is such alleged doctrine capable of reasoned application.

A very similar term, **FUCT**, which had been judicially determined to be the equivalent of **FUCKED**, has actually been used for several decades as a brand by Applicant.¹

If the equivalent of **FUCKED** is not a "commonplace word," then why is not **FUCK**? In fact, the PTO considers **FUCK** to be registrable some of the time. So why is this particular use a "commonplace word" being refused, when the word is not in other applications?

The proper question is whether **FUCK** is capable of serving as a source identifier. The answer is "yes."

2. Discussion

A. PTO's Ground for Refusal

The PTO makes some unsupported and incorrect assumptions.

¹ *In re Brunetti*, 877 F. 3d 1330 (Fed. Cir. 2017) noted that "The Board noted that the word 'fuct' is defined by Urban Dictionary as the past tense of the verb 'fuck' and pronounced the same as the word 'fucked,' and therefore found it is 'recognized as a slang and literal equivalent of the word 'fucked,' with 'the same vulgar meaning.'" (J.A. 6-7 & n.6."). Such finding was affirmed on appeal and not reversed by the Supreme Court. The Supreme Court, rather than overruling such finding quoted with favor the description of the mark as "the equivalent of [the] past participle form of a well-known word of profanity". *Iancu v. Brunetti*, 588 U.S. _____ (2019).

“Registration is refused because the applied-for mark is a slogan or term that does not function as a trademark or service mark to indicate the source of applicant’s goods and/or services and to identify and distinguish them from others. Trademark Act Sections 1, 2, 3, and 45.

The PTO offers no evidence showing that the public could not identify **FUCK** as “identifying the source of applicant’s goods” or that it only “convey[s] an informational message.” The reason is because there is no such evidence.

B. There is No “Commonplace Words” Doctrine

The legal basis for the PTO refusal of **FUCK** is an incorrect doctrine. The “widely used commonplace” doctrine is not valid, and the refusal based upon such doctrine should be withdrawn.

i. What is a Trademark?

The starting point for determining whether a word can be a trademark is the definition of trademark in the Lanham Act.

Applicant agrees that a trademark application should be refused if the applied for term is not a trademark (i.e., generic) or is not used as a trademark (i.e., ornamental). But if it is used as a trademark, or proposed to be used as a trademark, it must be approved for publication unless there is a statutory reason for refusal, and in this matter, there is no longer such basis given that the U.S. Supreme Court has invalidated the immoral and scandalous clauses of Section 2(a) in *Iancu v. Brunetti*, 588 U.S. _____ (2019).

Section 45 of the Lanham Act provides that:

The term “trademark” includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

Brunetti’s proposed mark is a trademark under this definition. That is the end of the matter.

ii. There is No Statutory Basis for the “Commonplace Words” Doctrine

The PTO implicitly acknowledged that there is no statutory basis for the “commonplace words” doctrine because the PTO cites to no language in the Lanham Act that establishes such doctrine. In fact, the express definition of “trademark” in Section 45, quoted above, negates such contention.

Since there is no statutory basis for the “commonplace words” doctrine, the PTO vaguely cites multiple sections (Section 1, Section 2, Section 3 and Section 45) with the hope that somewhere within such sections there is some basis for the doctrine. But the PTO does not cite which language in such sections allegedly support the doctrine. The reason is there is none.

iii. There is No Basis for the “Commonplace Words” Doctrine in the Case Law

If there is no support for the “commonplace words” refusal in the Lanham Act, the next place to look for support would be in the treatises. What does the leading treatise on trademarks say? Professor J. Thomas McCarthy deserves quotation in full:

Some courts occasionally make loose reference to the fact that plaintiff’s mark is a “common word” found in the dictionary and is therefore “weak.” But this is a non sequitur. That a word is in “common usage” is quite irrelevant. The issue is whether that word is in common usage as a mark for similar goods or services such that its distinctiveness in the customer’s mind is blurred. Some of the strongest marks are “common words” found in the dictionary. For example, SHELL, CAMEL, and APPLE. They are intrinsically strong because they are arbitrary when applied to gasoline, cigarettes and computers, respectively. They are also strong under the second prong because they are widely known and recognized by customers as marks.

The Sixth Circuit, rejecting the fallacy that a “common word” found in the dictionary, such as “classic,” is either weak or “unworthy of protection,” observed that: “The significant factor is not whether the word itself is common, but whether the way the word is used in a particular context is unique enough to warrant trademark protection.”

A similar fallacy is the argument that because a designation is a generic name for something, it cannot be a trademark for anything.

Undoubtedly, common phrases and bits of slang which are in routine, everyday use are relatively weak as trademarks simply because their common occurrence makes it difficult for them to stand out as source identifiers.

2 McCarthy on Trademarks and Unfair Competition § 11:87 (5th ed. – September 2019 update) (attached to this response for the Examining Attorney’s convenience as Exhibit “A”).

The “commonplace words” doctrine does not exist. Period. Such refusal should be withdrawn.

iv. The Commonplace Words Doctrine is Not Actually Recognized by the PTO

Does the PTO actually recognize the “commonplace words” doctrine? The answer is that generally (except for marks formerly refused as disparaging or scandalous, or that the PTO otherwise does not like) it does not recognize the doctrine.

Hundreds of widely used commonplace words serve as trademarks. In fact, they are some of the most famous and valuable trademarks. The PTO’s own actions show that commonplace words have been frequently registered from the earliest days (even predating the 1905 act) through the present:

APPLE, Reg. 1078312
BEST BUY, Regs. 1658182, 1657622
CITIZEN, Reg. 709938
DOPE, Reg. 4547955
ELLE, Reg. 758137
FOOD & WINE, Reg. 1322082
FOSSIL, Reg. 5156853
FREEDOM, Reg. 3354319
GOOD, Reg. 5288711
GUESS, Reg. 2077475
JUSTICE, Reg. 796455
ORANGE, Reg. 4322514
PARENTS, Reg. 2631504
PEOPLE, Reg. 1137391
PLAY DIRTY, Reg. 4520158
PURE, Reg. 26252 (expired), 54568
REAL SIMPLE, Reg. 4616286
SHAPE, Reg. 1498564
SUPREME, Reg. 4157110
TARGET, Reg. 837308
TIME, Reg. 629122, 1364448
UNDEFEATED, Reg. 3218703
UNITED, Reg. 805967
VOGUE, Reg. 125542

and countless others.

Rather than refusing “commonplace words,” the PTO frequently grants registration for such words.²

² The PTO sometimes correctly refuses words because they are generic as to the goods or services (DRIVE SAFELY, hopefully, is generic for automobiles; FRAGILE for stickers,

v. The “Commonplace Words” Doctrine Is Too Vague to be Rationally Applied

The PTO “must be able to articulate some sensible basis for distinguishing what may come in from what must stay out.” *Minnesota Voters Alliance v. Mansky*, 585 U.S. ____ (2018).

The PTO fails to offer any test by which it can be objectively determined that a word is used too “commonplace” to be a trademark. How often must a word be used? By whom? In what context? In the absence of an objective test, then it is just the examiner’s subjective viewpoint.

The owners of those other marks (such as APPLE and TIME) will be surprised to know that under the commonplace words doctrine all their applications must now be refused. Presumably their existing registrations are subject to cancellation if not incontestable. Even if incontestable, assuming the “commonplace words” doctrine actually arises under Section 2 (as asserted by the PTO), such registrations might well be subject to cancellation, since Section 14(3) provides that Section 2(a) is an exception to incontestability under Section 15. Either trademark law is upended, or the commonplace words doctrine is invalid.

Turning specifically to **FUCK** and its phonetic equivalents, the PTO has often decided that it is not commonplace word.

FUCT (Class 25), Reg. 5934763 (*Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019) (FUCT described as “the equivalent of [the] past participle form of a well-known word of profanity”); *see also In re Brunetti*, 877 F.3d 1330, 1338 (Fed. Cir. 2017) (“[s]ubstantial evidence supports the Board’s finding that “fuct” is a “phonetic twin” of “fucked,” the past tense of the word “fuck.”))

FUCT (Class 35), App. Serial No. 87/581032 (Published April 21, 2020)

TIME TO FUCK?, App. Serial No. 87/904129 (Published December 10, 2019)

NAMASTE AS FUCK, Reg. 5999466

FVCT STREET WEAR, Reg. 4515888 (as is well known, many inscriptions use V for U since there was no U in the Latin alphabet, also, e.g. BVLGARI, Reg. 5486656)

FCUK, Reg. Nos. 2520614, 2920270, 3028227, 4167152, 5301912, 5932518

FUCK SLEEP, Reg. 6015995

FUKKK, App. Serial No. 87/134846 (Published January 21, 2020)

FUCK CANCER THE MUSICAL, App. Serial No. 88/077828 (approved for publica.)

PROUDLY MADE IN USA for anything made in the USA), or refuses the specimens because they are ornamental (I LOVE YOU on bracelets), and incorrectly bases its refusal on “commonplace words.” However, that does not prove that such doctrine exists, or that it is valid under the Lanham Act.

Other profanity are not deemed to be “commonplace words.”

STUPID MORNING BULLSHIT, Reg. 5980498

SHIT YEAH!, Reg. 6041759

FUCK THIS SHIT SHOW, Reg. 6018964

SEE SHIT, App. Serial No. 88/286088 (allowed).

Apparently only the PTO has the crystal ball to tell when **FUCK** is too commonplace and when it is not. But it does not give the same crystal ball to all examiners.

The only consistency is if the applicant took the PTO to the Supreme Court, then his use is refused by the PTO. Applicants using **FUCK** who did not take the PTO to the Supreme Court are more likely not to be deemed “commonplace.”

In short, there is no possible way of determining when the “commonplace words” doctrine applies and when it does not. Accordingly, it cannot be a valid legal principle.

vi. The PTO’s “Etsy Rule:” If Used on a Mug On Etsy, It is an Unregistrable Commonplace Word

The PTO has created a novel theory, that if a word is used on a mug offered on Etsy.com, then it is an unregistrable commonplace word. This rule, which we will refer to as the “Etsy Rule” is not found in any treatise or case (at least to the knowledge of Applicant’s counsel).

Moreover, as a matter of actual practice, the PTO does not apply the Etsy Rule. The evidence submitted herewith shows that the PTO does not apply the Etsy Rule. Applicant printed the first three pages of Esty mugs. See Exhibit “B”. On those three pages, nine of the words on the mugs were registered or at least not refused as “commonplace words:”

BEST FRIENDS, Reg. 3741945

CONSCIENTIOUS, Reg. 5552162

CUP OF JOE, Reg. 5492030

DON'T GO BACON MY HEART, Reg. 453771 and 5851253

EAT A BAG OF DICKS, App. 86/798858 (refused only because scandalous; not because “commonplace words”).

I USED TO BE COOL, Reg. 3750245 and 5469024

NEVER UNDERESTIMATE THE POWER OF A WOMAN, Reg. 0833357

THE MOUNTAINS ARE CALLING, Reg. 5070183

WITCHES BREW, Reg. 3916934

In short, the evidence relied upon by the PTO shows there is no commonplace words doctrine. Rather, words used on Etsy mugs are frequently registered.

vii. Conclusion About Commonplace Words Doctrine: It Does Not Exist

The commonplace words doctrine is contrary to the clear language of Section 45. As so clearly pointed out by McCarthy, it is simply not a valid doctrine. Nor is such doctrine capable of reasoned application. In fact, the doctrine is being applied randomly based apparently, on the examining attorney's own personal preference.

C. If **FUCT**, **FCUK** and **FVCT** Are Capable of Being Trademarks, Then **FUCK** Is Also

Brunetti has been using **FUCT** as a trademark since the early 1990s. It clearly has been used as a trademark. **FCUK** is a well-known brand with several federal registrations. **FVCT** has been registered multiple times.

If **FUCT** (and these other trademarks) can serve as a valid trademark, there is no basis for asserting that **FUCK** is a unique exception and somehow cannot serve as a trademark.

D. The PTO Is Unconstitutionally Regulating Viewpoint

i. The PTO is Using “Commonplace Words” As a Pretext to Refuse Scandalous Marks

The “commonplace words” doctrine is being used as a pretext to impact speech that the PTO finds offensive. In *Brunetti* and *Tam*, the Court held that the PTO could not prohibit the registration of marks that were disparaging or scandalous.

The PTO's first office action is required to contain all grounds for refusal. 37 C.F.R. §2.61(a). Section 704.01 of the TMEP provides: “The examining attorney's first Office action must be complete, so the applicant will be advised of all requirements for amendment and all grounds for refusal, with the exception of use-related issues. . . .”

The PTO had preliminarily refused **FUCK** because it was scandalous. To the extent the PTO had other issues, they are to be raised in the first office actions. In this case, the examining attorney raised issues about the identification. But the “commonplace words” doctrine was not cited.

It was only after the Supreme Court's decision in *Brunetti* that the PTO “discovered” that the proper ground of refusal was not Section 2(a) but the “commonplace words” doctrine.

While additional issues can be raised after the first office action, that is not what is happening here. In addition to this application, there are other applications that were refused only under Section 2(a). It was only after the U.S. Supreme Court invalidated the disparaging, immoral and scandalous clauses did the PTO “discovered” that it had incorrectly refused such applications under Section 2(a), but that the allegedly correct ground for refusal was the “commonplace words” doctrine.

To be blunt, the PTO is thumbing its nose at the highest court in the land. That is shameful.

ii. Applicant's Mark Conveys a Message

The TTAB has already decided that Applicant's related mark conveys a message. The Trademark Trial & Appeal Board held that Applicant's brand "critique[s] capitalism, government, religion and pop culture." *In re Brunetti*, S/N 85/310960. If the Free Speech Clause does not protect speech about government, politics, religion and culture, then it is difficult to see what the First Amendment protects. Brunetti intends to use this mark for the same purpose. Just as in *Cohen v. California*, 403 U.S. 15 (1971), use of **FUCK** is integral to the message.

The refusal to approve Applicant's mark is because of the PTO's perception of the message conveyed by Brunetti and his mark. The PTO is glad to register marks that convey messages the PTO supports, namely ones that approve of capitalism, the government, religion and culture. For example, **FUCK CANCER THE MUSICAL**, App. Serial No. 88/077828, has been approved for publication because the PTO approves of that message. But for messages it does not approve, such as Brunetti, the applications are refused under the pretext of "commonplace words."

The refusal is an unconstitutional application of the Lanham Act.

3. Conclusion

The "commonplace words" doctrine is legally incorrect. Factually **FUCK** is capable of serving as a brand name just as its sister brand **FUCT** does. The application must be approved for publication. Respectfully submitted,

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Exhibit "A" – McCarthy on Trademarks and Unfair Competition
Exhibit "B" – Printout of Etsy mugs results