Panel 2
Intellectual Property and Sports Law
Perspectives on Native Mascots

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“Examining and Reconsidering Indian Mascots in the 21st Century”
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I. History of Mascots & Monikers in Sports (General Overview; Pre-Legal Analysis)
   a. Definition of the word “mascot” and its historic origins
      i. Merriam Webster’s Dictionary: “a person, animal, or object adopted by a group as a symbolic figure.”
      ii. In Spanish, “mascota” translates to “animal” or “pet.” The traditional notion of mascot, was not a person.
   b. Human monikers and mascots
      i. In-group monikers have never presented much controversy and are rarely, if ever discussed in mainstream discourse. (e.g., Boston Celtics, Notre Dame Fighting Irish)
      ii. Out-group monikers present a greater concern, and their appropriateness has become a source of growing controversy in recent years. (e.g., Cleveland Indians)
      iii. Uncertain monikers help to highlight the “gray area” as both matter of policy and law about creating blanket positions on particular mascots (e.g., Pennsylvania Quakers)

II. Legal and Ethical Concerns Related to Certain Mascots
   a. Government sanction and support
      i. Recent challenges to the used of Native American monikers and marks have emerged primarily under trademark law and specifically the Lanham Act, arguing that the marks are not protectable as defamatory.
      ii. There are multiple views on the balance of these concerns and First Amendment rights, as seen by recent court decisions as case law.
         1. Most recently, the potential to use removal of trademark rights to induce the change of sports team names was hampered by the First Circuit ruling involving the band “The Slants.”
         2. Further explanation of the First Amendment concerns are explored in the recent article by Marc J. Randazza, Freedom of Expression and Morality-Based Impediments to the Enforcement of Intellectual Property Rights, 16 Nevada L. Rev. 107 (2016)

III. If Trademark Law Fails, Does League Commissioner Have the Power to Change a Team Name?
   a. The Commissioner position was created by Major League Baseball in 1921 to provide broad oversight and represent the game’s collective interests.
i. Initially dealt with collective concern among public about gambling and predetermined game outcomes.

ii. The *Lasker Plan*: notion that if sports leagues adequately self-regulate, government will not feel the need to provide external oversight.

b. Sports teams allocate power to the commissioner to act in “the best interests of baseball” or to stop “conduct detrimental to the game of football.” This is broad authority.

c. Past court decisions have found commissioner has broad contractual deference when making decisions with respect to team rights.
   
   i. *Landis v. Milwaukee American Ass'n*, 49 F.2d 298 (N. D. Ill. 1931) upheld commissioner’s right to declare a player a free agent for benefit of the sport so long as the decision was not found arbitrary or fraudulent.
   
   ii. *Finley v. Kuhn*, 569 F.2d 527 (7th Cir. 1978) upheld commissioner’s right to veto the sale of players from one team to another as long as the decision was not found arbitrary or capricious.

d. NFL Personal Conduct Policy seeks to further give commissioner governance over a wide range of off-field conduct. Indeed, there is a history of commissioners attempting to police off-field speech.
   
   i. John Rocker suspension – Major League Baseball
   
   ii. Roger Goodell’s attempt to remove “N-word” from football, even when used by African-American players.
   
   iii. Issues of speech (as well as conduct) in Miami Dolphins locker room investigation surrounding bullying/abuse of Jonathan Martin.

e. Based on the foregoing, it may reasonably be within the rights of a league commissioner to order a professional sports team to change its name to promote “political correctness” even if the underlying name is found to be protectable under trademark law.
In August 2005, the National Collegiate Athletic Association (NCAA) issued a controversial decision that ‘banned’ the use of American Indian mascots by sports teams during its postseason tournaments, but will not prohibit them otherwise. Nicknames or mascots deemed ‘hostile or abusive’ would not be allowed on team uniforms or other clothing beginning with any NCAA tournament after Feb. 1, 2006.¹ The schools that were deemed to be offending schools could use the nicknames and mascots during their respective ‘regular seasons’. However, if the team wished to participate or was selected to participate in a championship tournament, the school would not be allowed to display its nickname or use its mascot.²

The NCAA Executive Committee originally focused on thirty-three schools that were asked to conduct a ‘self-evaluative study’ and were subsequently placed on the NCAA’s watch list.³ Of the original thirty-three schools, fourteen of them ‘complied with the league’s policy by either removing references to Native American culture or keeping such references out of their athletic programs.’⁴ One school, The University of North Carolina-Pembroke, was immediately taken off the ‘watch list’. UNC-Pembroke was ‘founded for the educating of Native American Indians’ and therefore permitted by the NCAA to retain its nickname (the Men are the Braves and the Women are the Lady Braves) because of ‘the foundation of the school, the history of the school and its continuous union with the Native American community.’⁵

“The remaining nineteen schools made the list of schools that the NCAA considered to have ‘hostile or abusive [racial or ethnic] mascots, nicknames or imagery.’⁶ Those schools and their nicknames are as follows: Alcorn State University Braves, Arkansas State University Indians, Bradley University Braves, Carthage College Redmen and Lady Reds, Catawba College Indians, Central Michigan University Chippewas, Chowan College Braves, Florida State Seminoles, University of Illinois at Urbana-Champaign Fighting Illini, Indiana University of Pennsylvania Indians, University of Louisiana at Monroe Indians, McMurtry University Indians, Midwestern State University Indians, Mississippi College Choctaw, Newberry College Indians, University of North Dakota Fighting Sioux, Southeastern Oklahoma State University Savagegs, University of Utah Utes, and College of William and Mary Tribe.⁷

In defense of the policy, the NCAA Executive Committee noted: ‘Colleges and universities may adopt any mascot that they wish, as that is an institutional matter. But as a national association, we believe that mascots, nicknames or images deemed hostile or abusive in terms of race, ethnicity or national origin should not be visible at the championship events that we administer’.⁸ The Executive Committee also stated: ‘Member institutions are encouraged to educate their internal and external constituents on the understanding and awareness of the negative impact of hostile or abusive symbols, names and imagery, and to create a greater level of knowledge of Native American culture through outreach efforts and other communication means.’⁹

The schools on the list that continue to use Native American mascots, imagery and nicknames, wishing to comply with the NCAA’s policy, ‘must exclude all such references

SELECTED TOPICS

Colleges and Universities
Staff and Faculty
Faculty and Board of Trustees of State University

Secondary Sources

APPENDIX IV GUIDANCE AND TECHNICAL ASSISTANCE MANUALS

ADA Compliance Guide Appendix IV

...Under the Americans with Disabilities Act of 1990 (the "ADA"), an employer may ask disability-related questions and require medical examinations of an applicant only after the applicant has been given...

APPENDIX IV: ADMINISTRATIVE LETTER RULINGS: DOL, WAGE AND HOUR DIVISION

Public Employee’s Guide to FLSA Emp. Class. Appendix IV

...(The following article appeared in the July 1995 update to the Employee’s Guide to the Fair Labor Standards Act, published by Thompson Publishing Group. It is intended to provide basic information on c...)

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FLSA Emp. Exemption Haitk. Appendix IV

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See More Secondary Sources

Briefs

Petition for Writ of Certiorari

2001 WL 1075085
Clarence Brent HAEBERLE, Petitioner, v. UNIVERSITY OF LOUISVILLE, et al., Respondents, Supreme Court of the United States, May 06, 2004

...1. The Petitioner in this case is, Clarence Brent Haebeler, an individual, Petitioner states he is not subject to the provisions of Rule 26.8 since he is not a non-governmental corporation. 2. Respondent...

Joint Appendix

2001 WL 3406724
Lawrence EDSILIAN, Petitioner, v. LYNCHBURG COLLEGE, Respondent, Supreme Court of the United States, August 30, 2001

...FN Count of Record Counsel for Petitioner: Proceedings include at events, COMES NOW the Petitioner, LEONARD EDELSIAN, PH.D. (Dr. Edelman), by his undersigned counsel, and moves this Court for entry...

Petition for a Writ of Certiorari

1999 WL 3305257
Dr. Archie HAREL, Petitioner, v. Dr. Francis LAWRENCE and Joseph Sonnea, Respondents, Supreme Court of the United States, October 23, 1999

...FN Counsel of Record: In addition to the
from their team, cheerleading, dance team, and band uniforms, as well as any other paraphernalia that might make use of this imagery at all NCAA championships. The NCAA also banned the sale of any related merchandise sold on the campuses of the offending schools. The NCAA gave offending schools until February 1, 2006 to comply with the new policy and "if the identified schools do not make changes by February 1, 2006, they will not be able to host future NCAA championships competition, unless they already have been selected as a predetermined site. In those cases, schools still would have to take reasonable steps to cover up the references to Native Americans before the competition begins." And, although not mandatory, it was even suggested by the NCAA that other non-offending schools "refuse to schedule athletic competitions with schools that use Native American imagery, mascot, or mascots." Whether "if the games be regular season or tournament games. Some schools had already decided that they would not schedule offending schools. For example, the University of Iowa and the University of Wisconsin have decided that they will not schedule athletic contests against universities that use Native American imagery in promoting their teams or allow such imagery on their campuses.

The NCAA Executive Committee did establish an appeals process, whereby offending schools can challenge the policy and therefore be allowed to continue using the offending mascot or nickname. The NCAA stated that "individual institutions may appeal their inclusion on the list of schools whose mascots are considered hostile or abusive. The Executive Committee would serve as the appellate body in that case. Also, one or more institutions may seek to amend the overall policy by submitting a request through the applicable presidential governing body. The February 1 effective date allows for both processes."

In response to this policy many schools have appealed the policy, many have changed their nicknames altogether, and others have refused to do anything. The purpose of this article is to explore the different reactions to the NCAA's ban from both the offending institutions and those institutions that took it upon themselves, usually prior to the NCAA's ban, to change their offending nicknames. Although there have been various challenges to the NCAA's decision, this article will not focus directly on the constitutionality of the NCAA's decision; rather, the paper will focus on the history that led up to the ban and how schools have reacted after the ban was instituted.

The ban has had both positive and negative effects on the members of the NCAA. As a result of the ban, a number of schools have decided to stop using offensive and hostile imagery during sporting events. However, other schools have decided to fight the NCAA's ban and, through some political backing and large monetary gifts, these schools have been allowed to retain their nicknames and mascots. The NCAA has created a double standard which at times can be difficult to understand and interpret. Part II of this article will discuss the schools that changed their nicknames and stopped using offending mascots prior to the NCAA's ban, and their reasons for doing so. Part III of this article will explain how different schools that made the list reacted to the ban, what the schools are doing about the ban today, and how the ban has had an economic impact on some of the schools on the list. Part IV will conclude with a brief discussion on the positive and negative effect of the NCAA's ban and where the NCAA should go from here.

SCHOOLS THAT CHANGED THEIR NICKNAMES AND STOPPED USING OFFENDING MASCOTS PRIOR TO THE NCAA'S BAN

Colleges and universities have been using mascots and nicknames since the 1890s. It is believed that Yale University's "Handsome Dan," an English bulldog, was the first university mascot in the United States. Since that time colleges and universities across the nation have used mascots and nicknames to invoke "pride and loyalty in its students, alumni, and supporters" and also to achieve brand recognition, consumer loyalty and trademark strength.

Choosing a college nickname and mascot varies from school to school. "The two most important factors that a college athletic program must consider when it wants to increase brand value to a national level are the goodwill its mark will evoke and the distinctiveness of its athletic label. When a University obtains and maintains a strong trademark it literally means extra dollars for the school." For these purposes, and many others, schools must take particular care in choosing their mascot and nickname because a school's nickname will lead to brand recognition, which leads to greater exposure and higher revenue for the school. Colleges and universities will often choose their nicknames for various reasons. Some schools use colors as part of their nickname such as Evansville

parties named in the caption, Rutgers, the State University of New Jersey was a party before the district court and the Court of Appeals. Pettigrew, Dr. Anne H...

See More Trial Court Documents

Ambrose v. Township of Robinson, PA
2006 WL 35904866
Ambrose v. Township of Robinson, PA United States District Court, W.D. Pennsylvania, October 11, 2006

...AMBROSE, District Judge. Pending is Defendant's Motion for Summary Judgment as to Plaintiff's Fourteenth Amendment due process claims and his First Amendment claims pursuant to 42 U.S.C. §1983, as well...

2005 WL 6718322

...Presently before the Court are the following Motions in Limine filed by Defendants in this matter: [1] DEFENDANTS MOTION IN LIMINE TO EXCLUDE EVIDENCE OF THE SUNSVILLE LAWSUIT; with brief in support. (Du...
University Purple Aces, 21 the Tulane University Green Wave, 22 or the Syracuse Orange. 23 Other schools use animals such as the Brigham Young University Cougars 24 and the Oregon State University Beavers. 25 Other schools use geographic references to help them establish an identity, such as the Appalachian State University Mountaineers 26 or The University of Miami Hurricanes. 27 Still other schools use ethnic ties to the surrounding community to choose their nickname. These include the University of Pennsylvania Quakers 28 and the University of Notre Dame Fighting Irish. 29 It is generally this last category of nicknames where the majority of social problems occur. The majority of issues arise when 21 schools decide to use Native American tribes, imagery and symbols for their nicknames and mascots. 30

A number of colleges and universities prior to the NCAA's 2005 ban took upon themselves to change their nicknames, mascots, and logos "due to their offensive nature." 31 Some of the larger profile schools to change their nicknames and mascots from Native American to non-offensive nicknames and mascots in the last fifty years are Stanford University, St. John's University, Marquette University, Dartmouth University, and the University of Oklahoma. 32

The first university to decide to change its nickname was Dartmouth University, an Ivy League school located in New Hampshire. 33 The school was founded in 1769 with the primary goal of educating the "American Indian youth in the region." 34 In the 1920s, a number of sports writers in the area began calling the Dartmouth University athletic teams the "Indians." 35 For the next fifty years this nickname was used by Dartmouth, although never formally accepted by the University. 36 However, the Indian symbol appeared on uniforms of athletic teams during this period. 37 Between 1972 and 1974 the University decided that it would no longer use the "Indian" as its unofficial mascot, and decided to use "The Big Green" as its official nickname. 38 The University stated that it recognized "the adverse effects of use of the Indian symbol upon the College's Native American Program and its students ... and the College's Board of Trustees [decided] that [the] use of the (Indian) symbol in any form [was] inconsistent with present institutional and academic objectives of the College in advancing Native American education." 39 Dartmouth decided, without any major social challenges, that the use of any Native American symbols did not promote the school's goals, and that the University would be better served with a more generic nickname. 40

"22 The University of Oklahoma decided on its own to stop using their offensive mascot "Little Red" during University-sanctioned athletic events. 41 For forty years a male member of the student body would dress in Indian apparel and excite "the crowd with 'war chants' and 'Indian dances'-mainly woo-woo-woo yells and acrobatic leaps [with] a g-stringed OU breechcloth flapping in the breeze." 42 In 1970, following a Native American sit-in at the president's office, the school's human relations committee called for the total abolishment of "Little Red." 43 Following these and other demonstrations, the University president banned "Little Red" from any University-sanctioned athletic event. 44

Stanford University was the next prominent university to change its nickname, as the school went from the Indians to the Cardinal. 45 "Stanford officially adopted the Indian nickname on Nov. 25, 1930 after a unanimous vote by the Executive Committee for the Associated Students." 46 When the resolution passed to adopt the Indian as its nickname, the resolution read, "whereas the Indian has long been unofficially recognized as the symbol of Stanford and its spirit, and whereas there has never been any official designation of a Stanford symbol, be it hereby resolved that the Executive Committee adopt the Indian as the symbol of Stanford." 47 However, in 1972 the Indian symbol was dropped after meetings between Stanford Native American students and President Richard Lyman. 46 "The 55 [Native American] students, supported by the other 358 American Indians enrolled in California colleges, felt the mascot was an insult to their culture and heritage. As a result of these talks and the ensuing publicity, the Stanford Student Senate voted 18-4 to drop the Indian symbol, and Lyman agreed." 48 After the Stanford Student Senate voted to drop the Indian as Stanford's symbol, there were two student votes, one in 1972 and another in 1975, to reinstate the Indian. However, both student votes failed, which has left the Cardinal as the school's official nickname. 49

St. John's University, located in the state of New York, was one of the more recent schools to change its nickname. St. John's originally was given the nickname "The Red Men" in 1923, because "it was around that time that then-director of athletics and football coach Ray Lynch had his players wear red uniforms in games, the local media picked up on it, and dubbed the Red Men." 50 However, the school
decided in 1994 that it was time to change its nickname. When the school decided to change from the Red Men to the Red Storm the school stated, "colleges nationwide [are] becoming more sensitive to mounting Native American concerns in reference to collegiate and professional team nicknames that reference 23 Native American culture. Although the nickname "Red Men" was instituted because the man of St. John's wore red, and did not have an original basis in Native American culture, it did eventually evolve into a nickname that referenced Native American symbology. St. John's wanted to make a change that would stay true to its tradition, but also be distinctive and unique. Thus, the new nickname Red Storm was born." St. John's is another school that took it upon itself to change its offensive nickname rather than face any public scorn.

Another school to change its nickname was Marquette University. The students of Marquette adopted the nickname of "Warriors" in May 1954. In February 1981, the University's mascot "Willie Wampum" made his first appearance at a Marquette basketball game. The use of Willie Wampum only lasted until 1971 when Willie was retired. However, the University retained and used the nickname "Warriors" until 1993, when Marquette announced its decision to discontinue the use of the "Warriors" name and logo. Students and alumni were immediately upset by the decision to drop the nickname. From the time that the Warrior nickname was taken away until early 2005 Marquette University students called for a reinstatement of the "Warrior" nickname. The students claimed that Marquette's new nickname the "Golden Eagles" was boring, weak and common. In 2004, Wayne Sanders, vice chair of the university's Board of Trustees, announced that he and an anonymous trustee were each prepared to pledge $1 million to the university if the institution would consider a return to the Warriors nickname by the time Marquette enters the BIG EAST Conference in 2005-06.

Marquette's president, Robert Wild, quickly rejected the donation and stated: "While I recognize that some people will be disappointed that we are not reinstating the Warriors nickname, we cannot teach one principle about respect for human dignity in our classrooms and then fail to act by that same principle when making decisions. The nickname 'Warriors' will always be part of our proud athletics tradition, and we will honor that tradition. But we live in a different era than when the nickname 'Warriors' was selected in 1954. The perspective of time has shown us that our actions, intended or not, can offend others. We must not knowingly act in a way that others will believe, based on their experience, to be an attack on their dignity as fellow human beings."

For the Marquette president, the decision to change the school's nickname was based on conversations the Board had with Native American communities in the area which led them to be "convinced that the Warriors nickname could not be separated from past imagery." Although the school lost out on the one-million-dollar donations, for the school it "became clear ... that as stewards of the university's mission, we had to be guided by conscience, not emotion."

The aforementioned schools, along with many others, decided to change offensive mascots and nicknames prior to the NCAA's ban and did so based on the schools own respect for culture and Native American tribes and communities. Some schools have offended alumni, others have lost out on substantial donations; however, the schools on their own decided to discontinue offensive and hostile nicknames and mascots.

THE SCHOOLS ON THE BANNED LIST: A MIXED BAG

From the original list of nineteen schools that made the list of schools that the NCAA considered to have "hostile or abusive racial or ethnic" mascots, nicknames or imagery, several high profile institutions immediately challenged the NCAA's authority. As a result of using the NCAA appeals process to challenge the NCAA's authority, many national profile schools have been allowed to retain their nicknames, despite the NCAA's displeasure, through the influence of powerful officials and their connections.

Other smaller profile schools reacted differently to the NCAA's ban. Some schools decided to change their nicknames, while other schools decided to ignore the ban and continue using Native American mascots and imagery. The smaller schools often do not have the same alumni base, the funds or political connections that larger institutions have, and therefore have been forced to change their nicknames.

One such school that originally decided to ignore the ban was Newberry College in South Carolina. Until recently it decided to use "Indians" as its mascot and claimed to have "no intention of changing" its nickname. Newberry College appealed the NCAA's ban, but was denied and asked to change its nickname. However, Newberry College decided,
“to stick with its nickname even though the NCAA turned down the school's request to be removed from a list of colleges whose American Indian mascots, logos and nicknames will be banned in postseason 2015 play starting next year.” In its appeal to the NCAA, Newberry College claimed that its “athletic logos include a red spear and a jagged arrowhead with the letters ‘NC’ connected inside it. A slogan on the school's Web site advises, ‘Fear the Spear’.”

Newberry College also cited the “overwhelming support by American Indians for the use of the nickname and mascot.” In response, Bernard Franklin of the NCAA said Newberry’s first argument missed the point “because it values intent over effect,” something that was not in the school’s scope to judge.

Mitchell Zies, the president of Newberry College stated, “The whole thing is nonsense. The NCAA is not the arbiter of political correctness in this country. My view is that ‘Indian’ in and of itself is not a derogatory term and is not hostile or abusive any more than Fighting Irish or Minnesota Vikings or Spartans or Trojans—all of which are human-image mascots. What are the limits of this? Are the [Presbyterian College] blue horse-wearing Highlanders insulting to people of Scottish descent?”

Newberry College changing its nickname would “indicate that we [Newberry College] did not truly believe in the validity of our appeal, or that our moral compass was subject to be swayed by the collective opinion of the NCAA Executive Council.”

In a letter to NCAA president Myles Brand, President Zies stated: “We understand that the NCAA may be embarrassed by some schools’ use of a mascot or nickname in such a way that stereotypes or demean a race or group of people. Newberry College is not one of those schools.” However, after the football team finished the 2006 regular season with a 10-1 record, the school's president changed his tune and acquiesced to the NCAA. The College has informed the NCAA that it has initiated the process of examining its nickname with the goal of resolving its dispute with the NCAA by the fall of 2008.

As a result of the College changing its “tune,” the NCAA lifted the hosting ban and the College’s athletic teams will be able to use the Indian nickname and all current imagery until the fall of 2008. Newberry College has not adopted a new nickname yet, but rather than face any sanctions Newberry decided that it would succumb to the NCAA and change its nickname.

While some schools decided to fight the NCAA’s ban, Bradley University, a small university in Peoria, Illinois, decided to comply with the ban while at the same time retaining its nickname. Bradley filed an appeal with the NCAA and was allowed to retain its nickname of “Braves” after it removed Native American symbols from its logo. The Executive Committee agreed that Bradley had previously removed all Native American imagery associated with its athletics programs and only kept the generic “Braves” nickname. Bradley had actually stopped using a mascot and Indian imagery about ten years prior to the NCAA’s 2005 ban of Native American imagery, a move that the NCAA officials applauded.

Based on information contained in Bradley's appeal, the Executive Committee found that Bradley demonstrated its ability to provide an environment that is not hostile or abusive to Native Americans and one that is consistent with the NCAA's Constitution and commitment to diversity, respect and sportsmanship. And as a result Bradley was allowed to fully participate in and host NCAA championships without restrictions, and was able to retain its nickname.

Dr. David Broski, the President of Bradley University said, “Bradley University has used the ‘Braves’ name since 1937 and we are pleased that the many generations of Bradley athletes to come will continue to bear that name, representative of the pride and tradition of our University. The University will continue to encourage in our student body the qualities of honor, courage, tenacity, loyalty, and endurance associated with the Braves name. Additionally, the University will continue its commitment to encourage our students to learn about and respect Native American peoples and traditions. Bradley does not now and will not in the future use Native American depictions in its logo.” Although Bradley was allowed to keep its nickname, the NCAA placed Bradley on a “watch list” because the school no longer used Native American imagery to promote its teams with the exception of its nickname.

The NCAA decided that it would observe the school's use of Native American imagery for five years. The NCAA now monitors Bradley's use of its nickname and imagery at games, on campus and on Web sites.

While Newberry College and Bradley have had serious restrictions placed upon them, other schools are still allowed to use Native American imagery and mascots in any athletic event, with NCAA approval. The Florida State University Seminoles, just days after the NCAA's 2005 ban, was the first university to appeal the matter to the NCAA. Florida State University’s Board of Trustees gave the school permission to sue the NCAA for the right to continue using “Seminoles” as the school's mascot. In fact the Florida legislature threatened to open an antitrust investigation into the NCAA. Even the
Governor of Florida at the time, Jeb Bush, criticized NCAA officials for their decision to penalize Florida State University for using an American Indian nickname and symbols, calling the ban "ridiculous." Governor Bush went on to say, "How politically correct can we get? The folks that make these decisions need to get out 27 more often." The comments from Governor Bush led Florida State Vice President Lee Hinkle to say, "If you have the Seminole Tribe and Gov. Bush on your side, how can you go wrong?" As a result of the political and social attention that Florida State University was receiving the NCAA, less than a month after announcing its ban, recanted and retreated on the use of "specific tribe names where an institution had a relationship with the tribe and permission to use the name in question." 

Florida State University has chosen to adopt the Seminoles and Chief Osceola as its nickname and mascot, respectively. The University uses Native American imagery in many of the school's athletic events. For example, before every home, and sometimes away, football games a student "wearing moccasins, a tasseled leather 'Indian' outfit, face paint, and a large bandanna, hoisting a large feathered lance charges down the field riding an appaloosa horse named Renegade and hurls a flaming lance downfield." The school states that only students with high moral character who are willing to undergo a two-year apprenticeship can "don the famous headdress of the Chief." 

The nickname and mascot have received approval from the Seminole tribe in Florida, and therefore the University is allowed to continue using the nickname and mascot, according to the NCAA's new policy. However, the Seminole Nation as a whole has not approved Florida State's use of Seminole imagery. The Seminole Nation of Oklahoma opposes the use of Florida State University's use of "Seminoles" as a nickname and mascot. David Narcomey, a council member for the Seminole Nation of Oklahoma, said that the Seminole Nation's council has plans to pass a resolution opposing the mascot. 

Narcomey criticized the Seminole Tribe of Florida for supporting the name. Narcomey told USA Today: "As far as the complexity of the mascot issue and the harm it brings, they don't seem to have an understanding that should be there. Their understanding is just that of the average non-Indian person." Notwithstanding the Seminole Nation of Oklahoma's opposition to Florida State University using its nickname and mascot, the NCAA withdrew Florida State from its list of sanctioned schools and Florida State was allowed to continue use of its nickname and mascot.

Two other schools received a pass from the NCAA because of their close relationship with local tribes. In examining the Central Michigan University Chippewas, the NCAA staff review committee noted the relationship between the University and the Saginaw Chippewa Indian Tribe of Michigan "as a significant factor" in taking Central Michigan off the banned list. The NCAA also allowed the University of Utah Utes to retain its nickname. "The university had sent a seven-page appeal to the NCAA on Wednesday, asking that it be removed from a list of 18 schools subject to restrictions because they have American Indian nicknames, mascots or logos." Michael Young, the president of the University of Utah stated: "We are very pleased that the NCAA has recognized our close and mutually respectful relationship with the Ute Tribe and accordingly has removed the University of Utah from their list of schools that use Native American names or imagery inappropriately. We appreciate their prompt attention to our appeal." 

Other schools have not received the same treatment from the NCAA because local tribes have refused to approve the continued use of offending nicknames and mascots. The two most well-known schools to be affected by the ban are the University of Illinois Fighting Illini, and the University of North Dakota Fighting Sioux.

The University of Illinois "Fighting Illini" has a long and storied athletic tradition in the Big Ten Conference. Although the nickname of the Fighting Illini has come under considerable scrutiny, the University's use of its mascot, Chief Illiniwek, has drawn public outcry, complaints and lawsuits. Chief Illiniwek was introduced in the late 1920s, but did not become the official mascot until an Illinois versus Army football game in 1930. Chief Illiniwek has been a staple at athletic events for eighty-one years until recently when the mascot was officially retired. During that time the Chief Illiniwek symbol had occupied "a space at the heart of University of Illinois sporting events," at prominent places throughout the University campus and even used in honorary societies and on officially licensed merchandise.

The first challenge to the Chief Illiniwek mascot occurred in 1989 when an Illinois student and member of the Spokane tribe began "a campus-wide movement in protest of..."
Chief Illiniwek” that continued until the mascot was retired. However, in 1995 the Peoria tribe approved the use of the Chief Illiniwek mascot and said, “We’re proud that the University of Illinois is the major institution in the state, a seat of learning, and they are drawing on the background of our having been there. And what more honor could they pay us.” The Peoria tribe would later retract its approval and passed a resolution in 2000 requesting that the University of Illinois end its use of Chief Illiniwek.

The next problem for the University came in 2001 when a group of Illinois students and faculty, who opposed the use of Chief Illiniwek, brought a First Amendment suit against Michael Aiken, a former chancellor of the University, in federal district court alleging a prior restraint of their right to freely communicate with prospective Illinois students. The plaintiffs in Crue v. Aiken expressed an interest in contacting prospective student-athletes to provide information and share their concern over the Chief Illiniwek controversy. Chancellor Aiken was worried that the communications could “violate recruiting guidelines of the NCAA and lead to the imposition of sanctions,” so Aiken decided to send an email to faculty, students and administrators “forbidding communication with prospective student-athletes without consent of the Director of Athletics.” The court ruled in favor of the plaintiffs and wrote, “The corresponding duties resulting from the University’s voluntary decision to be a member of the NCAA cannot mean that the University has a right or obligation to check the First Amendment rights of its students and faculty at the property line of the campus.” The students were then allowed to send letters to prospective student-athletes regarding the Chief Illiniwek debate, which would not break any NCAA recruiting rules. Although the students were allowed to contact prospective student-athletes, the University was still allowed to use Chief Illiniwek and continued to do so until the NCAA’s 2005 ban on offensive mascots.

After the 2005 ban, the University of Illinois successfully argued that its use of the term “Illini” is “defensible based on its close association with the state name.” However, the University remained on the sanctioned list because of its refusal to discontinue the use of Chief Illiniwek as a mascot or the logo of the Native American in headdress. Illinois decided to follow the example of Florida State and others schools and appeal the NCAA’s ban on its use of Chief Illiniwek. On April 28, 2006, the NCAA denied Illinois appeal and informed the school that it would be subject to restrictions if it continued to use Native American imagery during athletic events and around campus. Due to the University's refusal, the Illinois Men's tennis team was the first team to be penalized by the NCAA's policy. The team was ranked eighth in the nation and was supposed to host the first and second rounds of the NCAA tournament in 2006. However, the team was told that they would have to travel to the University of Louisville because Illinois continued to use “Native American Imagery.” After the men's tennis team was punished by the NCAA, the Crue v. Aiken lawsuit, and growing public opposition, the University of Illinois decided to review its decision of using Chief Illiniwek during athletic events. After careful consideration the school decided to retire Chief Illiniwek. The University reasoned that it would retire its mascot, “so that the University can be removed from the list of NCAA policy violators, move our institution forward and allow our student athletes to compete at the highest levels and free of sanctions.” Chief Illiniwek was retired on February 21, 2007, and as a result of its decision, the University was removed from the list of sanctioned schools and no longer be subject to any NCAA sanctions.

The University of North Dakota (UND) has decided to fight the NCAA’s ban and probably face a “potentially insurmountable obstacle” in its attempt to continue using its nickname—Fighting Sioux. UND officially adopted the name “Fighting Sioux” in honor of the first inhabitants of the region and some of the American Indian tribes of the state. Since 1930, UND has used an American Indian head as its symbol. With a storied athletic program and its use of “Fighting Sioux” for almost seventy-five years, UND was disappointed in the NCAA’s 2005 mascot and nickname ban.

Within one month of the NCAA’s announcement UND had sent off an appeal to the NCAA with the request of being able to retain its nickname. UND had three basic arguments in its appeal:

1. The nickname and logo are used with the utmost respect and class and are in no way inherently hostile or abusive.

2. UND has many substantive positive relationships with American Indians and the University has had—and continues to have—the support, including the formal support, of many Indian people.
(3) The University believes it is "totally unreasonable for the NCAA to ask us to change the terms of a contract in place whereby we would host the regional Division I men's hockey tournament in the spring." 130

Although the NCAA had already granted three appeals, 131 the NCAA denied UND's appeal. The NCAA's Bernard Franklin said that it was critical that there was opposition to UND from two of the three local Sioux tribes, in addition to a resolution by the Board of Directors of the United Tribes of North Dakota in support of the NCAA restrictions. 132

Although, the NCAA allowed UND to host the NCAA Hockey Tournament the year of the ban, the NCAA required the school to "take reasonable steps to cover up" all Indian references in March when it was to host the hockey regional in Ralph Engelstad Arena, which totaled more than 2,000 Fighting Sioux logos. 133 Three months later UND filed its second appeal with the NCAA asking to be removed from the sanctioned list. 134 UND President Charles Kupchella characterized the appeal as "more analytical and legalistic," and said the appeal is different from the first one in other ways as well. 135 Kupchella went on to state: "We do all that we do here with class. We do more here for American Indian students and American Indian people on reservations than all of the other institutions already exempted by the NCAA combined." 136 The second Appeal was also denied, leaving UND no other recourse but to sue the NCAA. In a letter to University of North Dakota stakeholders and the general public President Kupchella stated: "The NCAA leaves us no recourse but to consider litigation to make the point that the policy you have instituted is illegitimate and that it has been applied to the University of North Dakota in an unfair, arbitrary, capricious, fundamentally irrational, and harmful manner." 137

The legal battle took almost a year to resolve itself. However, on October 26, 2007, UND and the NCAA finalized a conditional agreement. The terms of the agreement allow "North Dakota until the end of November 2010 to clear its nickname with both Sioux tribes based in the state, the Spirit Lake Tribe and Standing Rock Sioux Tribe." Both tribes opposed the use of the "32 Fighting Sioux at the time the school's appeal to the NCAA was rejected by the association in September 2005. 138 The agreement also specified that any waiver granted the school after tribal approval of its "Fighting Sioux" nickname would be rescinded if either tribe withdraws its endorsement. 139 So for now, UND is off of the NCAA's sanctioned list and is allowed to host NCAA tournaments and use its "Fighting Sioux" nickname.

From the original nineteen schools that made the NCAA's sanctioned list, twelve of the cited schools have changed or indicated they will change their nicknames or mascots. 140 Five schools were removed from the NCAA list after showing in appeals that they have local tribes' approval of their nicknames, 141 and Bradley University is on a five-year NCAA "watch list," unaffected by the policy while working to assure the NCAA that it does not promote any negative or hostile feelings toward Native Americans. 142 Only one school, the Alcorn State University Braves, remains on the NCAA non-compliance list due to the fact that Alcorn State chose not to appeal, but still retained its nickname. 143 Until Alcorn State either changes its nickname or is granted approval from the NCAA, it will be subject to the penalties imposed by the NCAA.

CONCLUSION

Although the NCAA decided to respond to the extreme public and social pressure being put upon it by Native American tribes and growing public concern, the NCAA's decision was truly groundbreaking. On the other hand, professional sports team owners continue to refuse to abandon discriminatory nicknames and mascots. 144 If professional teams continue to refuse to change their nicknames, many fans of NCAA athletics will continue to be confused as to why their school had to change its nickname while a professional sports team is allowed to continue using offensive nicknames and imagery. The NCAA decided that it was more important for its organization to make a stand against hostile and offensive nicknames and imagery than to allow schools to go through the process of public scrutiny and change their nicknames on their own, as other schools had already done. If the NCAA had not passed its ban, how many of the schools would have changed their mascots in response to social pressure by Native American communities or negative public perception? Or, would schools have continued to use blatantly offensive nicknames and mascots because of the brand recognition that the schools received?

The NCAA took a major risk in deciding to pass the ban on all hostile or abusive nicknames based on race. The controversy will only intensify due to the NCAA double-standard that to some it seemed to create when the NCAA allowed some schools, such as Florida State University and the University of Utah, to continue using their Native
American nicknames and "33 mascots, while not allowing other schools, such as the Newberry College and the University of Illinois, the use of their nicknames and mascots. Florida State University and other schools used their impressive alumni and fan base to pressure the NCAA to soften its ban allowing those schools to continue using Native American nicknames, mascots, and imagery. The NCAA will continue to be scrutinized by allowing schools to retain their nicknames and mascots, and until the NCAA makes a rule that is non-waivering, the social pressure from Native American and political organizations will continue.

Footnotes

1 Spencer O. Kelly is a 2008 graduate of the Willamette University College of Law. He presently works for a law firm in Portland, Oregon.


3 Id.


5 Kelly P. O'Neill, Sioux Unhappy: Challenging the NCAA's Ban on Native American Imagery 42 TULSA L. REV. 171, note 28 (2006); citing Lielana McKindra, MOIC Forwards Recommendations from Mascots Review, NCAA News, July 4, 2005, http://www.ncaa.org (follow "The NCAA News" hyperlink; then follow "NCAA News Archive" hyperlink; then follow "2005" hyperlink; then follow "Associationwide" hyperlink; then follow "MOIC forwards recommendations from mascot review" hyperlink). The 14 schools that were left off the list were California State University-Stanislaus (Warriors), East Stroudsburg University (Warriors), Eastern Connecticut State University (Warriors), Hawaii-Manoa University (men are Warriors), Husson College (changed from Braves to Eagles), Lycoming College (Warriors), Merrimack College (Warriors), San Diego State University (Aztecs), Southeast Missouri State University (Redhawks), University of West Georgia (changed from Braves to Wolves), Stonehill College (changed from Chieftains to Skyhawks), the University of North Carolina-Pembroke (men are the Braves and women are Lady Braves), Winona State University (Warriors), and Wisconsin Lutheran College (Warriors).

Brown, supra note 8.

NCAA press release, supra note 8; See also, Franklin, supra at 436.

Id.

O'Neill, supra note 4 at 183-184.

Id.

George, supra note 3 at 104-112 (This section outlines the constitutionality of the NCAA's ban and whether the NCAA oversstepped the "mandates of both relevant legal doctrine and the terms of its own policy.").

Yale University Bulldogs, Official Athletic Site, History of The Yale Bulldog "Handsome Dan," http://yalebulldogs.cstv.com/trade/mascot.html (last visited Oct. 18, 2007) (The tradition was established by a young gentleman from Victorian England who attended Yale in the 1890s. The line now numbers 16 and the original successors have been the intimates of deans, directors, and coaches. One was lended by a head cheerleader who went on to become the Secretary of State. Another was featured on the cover of a national magazine. Yale was the first university in the United States to adopt a mascot, and to this date, none is better known than Handsome Dan).


Id. at 201.

Id.


Syracuse University Athletics, http://www.suathletics.com/ (last visited Oct. 20, 2007) (Syracuse for years used the "Saltine Warriors" as their nickname but changed from that Indian reference long before its use became a public issue. The Mascot was discontinued in 1979, please see http://www.nativevillage.org/Message WC%20from%20the%20People/timeline%20for%20Indian%20Mascots.htm (last visited Nov. 16, 2007)).


Andre Douglas Pond Cummings, "Lions and Tigers and Bears, Oh My" or "Redskins and Indians, Oh Why": Ruminations on McBride v. Utah State Tax Commission, Political Correctness, and the Reasonable Person, 36 CAL. W. L. REV. 11, 22-23 (1999); citing McBride v. Motor Vehicle Division of Utah
Ashley Michael, Schools Urged to Change Mascots, http://www.bpsports.net/bpsports.asp?id=2071, Apr. 30 2001 (last visited Oct. 18, 2007). Other schools included in the list of Division 1 schools to change their mascots include Siena College (from "Indians" to "Saints"), Saint Mary's College (from "Red Men" to "Cardinals") Eastern Washington University (from "Savages" to "Eagles") and Miami University (Ohio) (from "Redskins" to "Redhawks"). A more extensive list can be found at http://www.inwhosehonor.com/documents/mascot_changes.html (last visited Oct. 20, 2007).


Id. (The term Native American is an Anglo politically correct term, Indians generally call themselves Indians).

Id.

Id.

Id.

Id.

Id.


Id.

The University of Oklahoma Visitor Center, supra.


Id.

Id.

Id.

Id.

Id.

Id.


Id.

Id.

Id. See also, Marquette University, http://www.marquette.edu/omp/newsroom/nickname/decision.shtml (last visited Oct. 20, 2007).
Oct. 20, 2007) in a survey given by Marquette University to its students "the terms respondents most often used to describe the Golden Eagles nickname are boring (57 percent), weak (55 percent) and common (52 percent)."

67  Id.


59  Id.

60  Id.


62  George, supra note 3 at 99.


64  O'Neill, supra note 4 at 180. (Schools that decided to change their mascots and nicknames all together, The Carthage College men's teams will go by Red Men instead of Redmen, Chowan College will be known as the Hawks instead of the Indians, Midwestern State University will be the Mustangs instead of the Indians, Southeastern Oklahoma State University will be the Savage Storm instead of the Savages, Indiana University of Pennsylvania will be the Crimson Hawks instead of the Indians).

65  George, supra note 3 at 102-103; O'Neill, supra note 4 at 160; http://asunnews.asu.edu/MascotSelectionRec.htm (last visited Oct. 25, 2007). (Newberry College, Arkansas State University and Abcorn State University have been some of the more outspoken schools refusing to change their nicknames. However, Arkansas State University recently has decided to change its mascot and stop using "Indians" as its nickname, a new mascot and nickname will be initiated sometime between 2008-2009).

66  George, supra note 3 at 97-100.

67  O'Neill, supra note 4 at 181.


69  id.

70  id.

71  id.


73  O'Neill, supra note 4 at 180.


75  O'Neill, supra note 4 at 180.

76  Newberry College Reaches Agreement with NCAA on Post-Season Events, http://newberryindians.athleticsite.com/article.asp?articleID=1948 (last

77    Id.

78    George, supra note 3 at 100-101.

79    NCAA Puts Bradley on Watch List, http://

80    NCAA Allows Bradley to Keep Braves Nickname, http://
www.bubravies.com/ViewArticle.dbml?
SPSID=19447&SPID=1510&DB_OEM_ID=3400&ATCLID=271847, (last
visited Oct. 25, 2007); Id.

81    Id.

82    O'Neill, supra note 4 at 181.

83    NCAA Allows Bradley to Keep Braves Nickname, http://
www.bubravies.com/ViewArticle.dbml?
SPSID=19447&SPID=1510&DB_OEM_ID=3400&ATCLID=271847, (last
visited Oct. 25, 2007); Id.

84    Id.

85    Official Athletic Site of Florida State University, http://

86    Paul McMullen, Florida State Mascot Removed from NCAA Banned List,
http://

87    O'Neill, supra note 4 at 175.

88    Id.

sports.espn.go.com/ncaa/news/story?id=2136078 (last visited Oct. 25,
2007).

90    Id.

91    Id.

92    George, supra note 3 at 99.

93    Official Athletic Site of Florida State University, http://
seminoles.com/trads/fsu-trads-osceola.html; see also, Kenneth B.
Franklin, A Brave Attempt: Can the National Collegiate Athletic Association
Sanction Colleges and Universities with Native American Mascots? 13 J.

94    Id.

95    Id.

96    Kenneth B. Franklin, A Brave Attempt: Can the National Collegiate Athletic
Association Sanction Colleges and Universities with Native American
Mascots, 13 J. INTELL. PROP. L. 435, 442-443 (Spring 2006). See also,
Robert Laurence, Jr., Randy Lee and the Susans: An Informal, Mostly Non-
Legal Essay on the Use of Indian Nicknames for Sports Teams, 81 N.D. L.

97    Seminole Nation Opposes FSU 'Seminole' Mascot, http://

98    O'Neill, supra note 4 at 200-201.

99    See Press Release, NCAA, Statement by NCAA Senior Vice President for
Governance and Membership Bernard Franklin on Florida State University
review, available at http://www2.ncaa.org/media_and_events/press_


Id. at 32-33.


Crowley, supra note 106 at 33.

Id. at 34 and 28 (The student’s name was Charlene Teters, and although her focus was Chief Illiniwek, she also lead a group that sought to eliminate other collegiate and Professional Sports Mascots, logos, and names that referenced symbols or people).


Id.

Id. at 37-43 citing Crue v. Aiken, 204 F.Supp.2d 1120 (C.D. Ill. 2002), aff’d, 370 F3d 866 (7th Cir. 2004).

Aiken, 204 F.Supp.2d at 1134-1137.

Id. at 1146.

Crowley, supra note 106 at 41-42.

George, supra note 3 at 100.

Id.


University of Louisville "Cardinals" therefore not on the list.


O'Neill, supra note 4 at 203.


Id.


Id.

Id.

Florida State University Seminoles, Utah Utes, and Central Michigan University Chippewas. Each of the schools that received a pass from the NCAA had approval of the local tribes, and the NCAA allowed each to retain its nickname and mascots.


Id.


Id.

Id.

Letter written by President Kupchella, dated June 7, 2006, the full letter can be found at: http://www.universityrelations.und.edu/logos April/openletter_6-07-06.html (last visited Oct. 27, 2007).


Id.

Id. (Including the University of Illinois, although it did not change its nickname, the Fighting Illini, it retired Chief Illiniwek and thereby complied with the NCAA's policy).

Id. (Which includes Florida State University Seminoles, University of Utah Utes, Central Michigan Chippewas).

Id.

Id.; See also, http://www.hoopville.net/content/mascots/hostile_and_abusive.asp

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FREEDOM OF EXPRESSION AND MORALITY-BASED IMPEDIMENTS TO THE ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS

Marc J. Randazza*

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INTRODUCTION

While many national laws are enacted in order to govern national or local notions of "morality," such laws are generally limited to governing the conduct of those subject to them. However, in the case of intellectual property rights (IPRs), some nations erect barriers to the protection of IPRs on the basis of "morality." This paper will examine the implications of morality-based impediments to the enforcement of IPRs and their supportability under international agreements.

I. PATENTS AND MORALITY

In the United States, some of the earliest intellectual property jurisprudence examined morality restrictions on patent registrations. In 1817, Justice Story wrote that granting protection to inventions intended to "poison people, or to promote debauchery, or to facilitate private assassination" was unacceptable. This was the genesis of the "moral utility" doctrine.

The United States Patent and Trademark Office (USPTO) and the courts relied upon this doctrine to exclude "immoral" inventions from protection under the theory that one of the consequences of an invention's moral bankruptcy was that it lacked usefulness. This doctrine was used inter alia to deny protection to devices that could be used to commit fraud or that were for gambling use. For many years, this doctrine served as a moral gatekeeper on patentable subject matter. However, American jurisprudence has drifted away from this theory, leaving the gate "untended." In Diamond v. Chakrabarty, the United States Supreme Court began a virtually unbroken string of decisions abandoning the moral utility doctrine. Eventually in Juicy Whip, Inc. v. Orange Bang,

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1 Lowell v. Lewis, 15 F. Cas. 1018, 1019 (C.C.D. Mass. 1817) (No. 8,568).
3 See, e.g., Scott & Williams, Inc. v. Aristo Hosiery Co., 7 F.2d 1003, 1004 (2d Cir. 1925) (denying a patent to an invention that would imitate a seamed stocking, because "[t]o produce an imitative result is not patentable"); Nat'l Automatic Device Co. v. Lloyd, 40 F. 89, 90 (C.C.N.D. Ill. 1889) (denying a patent for a racing toy because it was used for gambling).
4 See Scott & Williams, Inc., 7 F.2d at 1004; Lloyd, 40 F. at 90. It seems incongruous that anyone could determine such products to lack "usefulness," but from a legal perspective, it does make sense—if the device can only be used to break the law, from a legal standpoint, it would be "useless."
5 Bagley, supra note 2.
6 Id.
7 447 U.S. 303 (1980).
In re, the Court of Appeals for the Federal Circuit pronounced the doctrine dead.

In contrast, the European Patent Office (EPO) once took the position that morality and patentability were unrelated. However, today, just as the United States is washing its hands of the moral utility doctrine, other countries seem to be finding the theory attractive—and seem to embrace it with the blessing of multilateral agreements. Article 27.2 of the Trade-Related Aspects of Intellectual Property Rights (TRIPS) agreement permits member states to exclude inventions from patentability in the name of "morality." The treaty states:

Members may exclude from patentability inventions, the prevention within their territory of the commercial exploitation of which is necessary to protect *ordre public* or morality, including to protect human, animal or plant life or health or to avoid serious prejudice to the environment, provided that such exclusion is not made merely because the exploitation is prohibited by their law.

These Art. 27.2 exclusions are difficult to define. "The term 'ordre public', derived from French law, ... expresses concerns about matters threatening the social structures which tie a society together, i.e., matters that threaten the structure of civil society as such." Morality," has a circular definition—"principles concerning the distinction between right and wrong or good and bad behavior." Therefore, both of these terms are fluid—changing with cultures or the times.

Despite the fluidity of the terms, many jurisdictions recognize exclusions as permitted by Art. 27.2. Article 53 of the European Patent Convention re-

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9 Id. at 1366-68.


13 TRIPS, supra note 11, at 331.

14 UNITED NATIONS CONFERENCE ON TRADE AND DEV. & INT’L CTR. FOR TRADE AND SUSTAINABLE DEV., RESOURCE BOOK ON TRIPS AND DEVELOPMENT 375 (2005).


quires that patents not be granted if the patent is contrary to public order or morality. In the European Union, the European Directive on the Legal Protection of Biotechnological Inventions relies on Art. 27.2 and denies patent protection to human embryos on the grounds that such patents offend human dignity. And, in Canada, in a patent case dealing with the “Oncomouse” (a mouse that was susceptible to cancer) the Canadian Supreme Court rendered a policy-based decision that “higher life forms are not patentable” subject matter.

However, morality-based prohibitions on patentability are normally geared toward prohibitions on protection for inventions that could have a destabilizing effect upon society, or other effects of measurable impact. None of these prohibitions seem to be aimed at free expression, and thus do not appear to negatively impact any Constitutional or human rights. Morality-based restrictions on patentability are normally either divorced from cultural mores, or they are simply based in universal cultural traditions.

The issues of biotechnology and morality (as difficult as the latter term may be to define) are easy to see intertwined. With a patent system largely informed by the incentive theory, we must consider whether the granting of a patent is likely to encourage activity that is deemed to offend universal values. If inventions cut against the notion of human dignity, as in (at least arguably) research involving human embryos, we can at least see that it is the actual


17 Harper, supra note 16, at 415. For example, the Norwegian Patent Act prohibits granting patents when “their commercial exploitation would be contrary to order public or morality.” Patents Act 1967, c. 1, § 1b (Act No. 8/2010) (Nor.). The Australian Patents Act expressly prohibits patent protection for human beings or the biological process for their generation. Patents Act 1990 s 18(2).


22 See Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 229 (1964) (finding “[p]atents . . . are meant to encourage invention by rewarding the inventor with the right, limited to a term of years fixed by the patent, to exclude others from the use of his invention”).
behavior inherent in such activities, which we wish to discourage. Nevertheless, it would seem to be beyond the pale to state that we would similarly refuse to grant copyright protection to text discussing the Oncomouse or even human experimentation—for copyright deals with the recordation of thoughts, with no action required.23

With that, we examine the “soft IP” arenas, as these are areas where the connection between human morality and conduct is more tenuous. While trademarks may, at least arguably, carry a state’s imprimatur upon issuance of a registration, copyrights are not granted by any state, but are a right given to the author upon creation.24 When we consider morality as a factor in granting copyright protection, the distance between conduct and rights seems vaster, and the bridging of this gap, less legitimate.

II. TRADEMARKS AND MORALITY

The most active area of morality-based impediments to IPRs arises in the context of trademark registrability. Most nations seem to have a prohibition on the registration of marks that are deemed “immoral.” The Paris Convention and the TRIPS Agreements obligate the member states to protect trademarks.25 Meanwhile, those agreements provide the right for member states to deny registration if the marks themselves are “contrary to morality or public order.”26 What those terms mean, and how different nations exercise this latitude, is of interest; however, this latitude itself may be rendered illegitimate under later agreements and under national and international laws protecting freedom of expression.

23 See 17 U.S.C. § 102(a) (2012) ("Copyright protection subsists ... in original works of authorship fixed in any tangible medium of expression ... ").
26 Paris Convention, supra note 25, art. 6quinquies (B)(iii). See also TRIPS, supra note 11, at art. 15(2) (allowing members to deny registration consistent with the Paris Convention).
A. Canadian, E.U., and Australian Approaches

The Canadian Trade-marks Act, at section 9(1)(j), prohibits registration of "any scandalous, obscene or immoral word or device." But, Canadian courts have not yet defined these terms. Therefore, Canadian trademark examiners tend to look to British or American decisions for guidance. At one time, that may have seemed logical, as the British and American approaches were largely identical. However, just as it did in the patent-morality context, the United States has diverged from the road taken by its allies and mother country. In the patent context, it abandoned morality based-restrictions. Meanwhile, when it comes to "immoral and scandalous" trademarks, the United States has traditionally been more restrictive, while other jurisdictions adopt a more permissive approach.

An Australian case demonstrates how "morality" has a fluid definition and how that country accepts modern norms. Under section 42 of the Australian Trade Marks Act of 1995, an examiner must reject a trademark application if "(a) the trade mark contains or consists of scandalous matter; or (b) its use would be contrary to law." According to the Trade Marks Office Manual of Practice & Procedure, an examiner is obliged to decide from the standpoint of the "ordinary" person whether a trade mark is shameful, offensive, or shocking, and therefore should be rejected. However, Australia recognizes that such definitions change over time, and that what was once offensive can be part of to-

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37 Trade-marks Act, R.S.C. 1985, c. T-13, § 9(1)(j) (Can.) (hereinafter Canada, Trade-marks Act). This is implemented, at the administrative level, by the Canadian Trademarks Office. CANADIAN INTELLIGENT PROP. OFFICE, TRADEMARKS EXAMINATION MANUAL § IV.10.6 para. 9(1)(j), https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr01614.html (last modified June 1, 2015) (hereinafter CTEM). However, even the CTEM notes that this section has not yet been interpreted by the courts in Canada, and thus as a matter of Canadian administrative law, the Canadian Intellectual Property Office (CIPO) calls for sect. 9(1)(j) to be interpreted by looking to U.S. and U.K. decisions regarding those nations' respective Acts, Id.

38 A trademark examiner is an administrative clerk who examines a trademark application for formal requirements, but who may also (especially in the United States) apply their own personal view of "morality" to a trademark application. See How Your Trademark Application Is Processed, CANADIAN INTELL. PROP. OFF., https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr00035.html?Open&wt_src=cipo-tm-main#examination (last visited Sept. 19, 2015).

39 An examiner is a civil servant employed by the patent office, usually with a scientific or engineering background, who examines applications to determine whether a claimed invention should be granted a patent. See Patent Examiner Positions, U.S. PAT. & TRADEMARK OFF., careers.uspto.gov/Pages/PEPositions (last visited Sept. 19, 2015).

40 However, this restrictiveness has been called into question, quite recently, in In re Tam, No. 2014-1203, 2015 U.S. App. LEXIS 22593 (Fed. Cir. Dec. 22, 2015).

31 Trade Marks Act 1993 s 42.

day's lexicon. In a 2012 decision, a mark owner prevailed in its argument that Section 42 does not prohibit the mark “Nuckin Futs.” While the mark was initially rejected due to the view that it was an “obvious spoonerism” for “Fucking Nuts,” the applicant’s counsel argued that “fuck” and “fucking” were “now part of the universal discourse of the ordinary Australian.”

In sharp contrast, the USPTO has never accepted a trademark registration that contained the term “fuck,” (nor any spoonerism thereof). One examiner summed up the American view, as accepted by the USPTO, as follows: “While the word ‘fucking’ may not elicit widespread condemnation from everyone, it is clear from the evidence attached that a significant composite of the public still feels a jolt of offense, shock, or dismay when they overhear the word uttered in public.”

In the European Union, Article 7(1)(f) of the Community Trademark Regulation (CTMR) prohibits “trade marks which are contrary to public policy or to accepted principles of morality” and through this regulation, OHIM is tasked with protecting “the right of the public not to be confronted with disturbing, abusive, insulting or even threatening trade marks.” Despite this admonishment, there is no regulation prohibiting the use of such marks; Article 106(2) of the CTMR makes it plain that this is left to the member states. The regulation only applies to registration.

In the European Union, notions of morality change depending on the relevant marketplace. In the “SCREW YOU” case, an applicant sought protection for a trademark for a range of goods including sunglasses, hats, liquor, and sex toys. The mark was deemed to be acceptable for sex toys, but not on mundane products. The Grand Board, the European Union’s highest court of trademark appeals noted that when the relevant marketplace is a sex shop, for example,

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33 Id.
36 U.S. Trademark Application Serial No. 78680513, Office Action Outgoing Mar. 17, 2008 (refusing registration of Trademark FUCKINGMACHINES).
38 See id. ¶ 11.
39 See id. ¶ 1.
the marketplace would not feel scandalized, and therefore the mark could be registered for products sold in this chain of commerce.\textsuperscript{41}

More importantly, however, The Grand Board recognized that there were expressive elements to a trademark, and freedom of expression principles must be considered.\textsuperscript{42} In this case, Article 10 came out into the forefront of the discussion. The Board commented:

While it is true to say that a refusal to register does not amount to a gross intrusion on the right of freedom of expression, since traders can still use trade marks without registering them, it does represent a restriction on freedom of expression in the sense that businesses may be unwilling to invest in large-scale promotional campaigns for trade marks which do not enjoy protection through registration because the Office regards them as immoral or offensive in the eyes of the public.

\ldots \text{[F]reedom of artistic expression is regarded as a higher priority than freedom of commercial expression and consequently it is more fiercely protected. The use of profanities in the name of art and literature is circumscribed with great reluctance in democratic and open societies. The same is true in relation to expressing opinions. A militant atheist may write an article for public consumption ridiculing religion, for example, and the State will not intervene. But a trade mark mocking, or exploiting the name of, the founder of a major world religion might nonetheless be kept off the register.}\textsuperscript{43}

Accordingly, the Board seems to have embraced the notion that freedom of expression has persuasive effect upon decisions involving refusals to register.

\textbf{B. The United States—The Conservative Sibling Lightens Up a Bit}

Under Section 2(a) of the U.S. Trademark Act, the grounds to reject a registration seem quite exacting. The mark must be "shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; \ldots giving offense to the conscience or moral feelings; \ldots [or] calling out [for] condemnation."\textsuperscript{44}

\begin{flushright}
chairperson, the chairpersons of the Boards and ordinary members selected from a specific list to make up the total of nine members. A board may refer a case allocated to it to the Grand Board if it believes that this is justified by its legal difficulty, importance or by special circumstances, for example, if the Boards of Appeal have issued diverging decisions on a point of law raised by that case. For the same reasons, the Presidency may refer a case to the Grand Board."
\end{flushright}

\textsuperscript{41} Case R 495/2005-G, Application of Kenneth (trading as Screw You), [2007] E.T.M.R. 7, \textsection 21. This contrasts with the most consistent American view—which is immoral is immoral, no matter where it may be. \textit{See infra} Part II.B.

\textsuperscript{42} \textit{Id.} \textsection 14–18. This is in sharp contrast to U.S. decisions, which have all but mocked any notion that free expression principles should be taken into account in trademark registration. \textit{See infra} Part II.B.

\textsuperscript{43} \textit{Id.} \textsection 15, 24.

\textsuperscript{44} \textit{In re} Mavety Media Grp. Ltd., 33 F.3d 1367, 1371 (Fed. Cir. 1994) (alteration in original) (quoting \textit{In re} Riverbank Canning Co., 95 F.2d 327, 328 (C.C.P.A. 1938)). Strangely enough, this decision does note that the relevant marketplace should be considered, but this
This concept of "scandalousness" is determined "from the standpoint of not necessarily a majority, but a substantial composite of the general public," and "in the context of contemporary attitudes." In other words, the standard has appeared, for decades, to be quite a high bar. However, in practice, that bar has not been very high at all. And, unlike Australia, the "contemporary attitudes" spoken of in this standard have not included any permissive attitudes.

As another contrast, the reader will recall that before the European Union authorities, notions of morality change depending on the relevant marketplace. In the "SCREW YOU" case, the Grand Board held that when the relevant marketplace is a sex shop, the relevant consumers would hardly be scandalized by racy language. In contrast, most U.S. cases have simply cast aside the "relevant marketplace" language. For example, in a case involving the mark "CUMFIESTA," the relevant marketplace was the pornography-consuming public. Certainly the pornography consuming public would hardly find such a term to be "calling out for condemnation." Nevertheless, the Trademark Trial and Appeal Board decided in that case that the scandalousness of the mark should be determined by whether a substantial composite of the general public would find it shocking, not the relevant marketplace. This view was later supported by the Federal Circuit.

Similarly, in a venerable case rejecting MADONNA for wine, the USPTO found that it should not examine the mark from the perspective of the wine-drinking public, but "we must consider the viewpoint, not of wine drinkers alone, but also of those who do not use wine as a beverage." However, in a very recent case, the TTAB seems to have perhaps had at least one drink, and thus relaxed a bit when it comes to the "relevant marketplace" standard. In that case, the applicant sought to register NUT SACK DOUBLE BROWN ALE. Since "nut sack" is U.S. slang for "scrotum," the trademark examiner, predictably, rejected the application. However, the TTAB reversed the examiner's decision, in part because the Board determined that the relevant market-

language has not, to date, ever been followed. See id.; In re Wilcher Corp., No. 74/306662, 1996 WL 725479, at *1 (T.T.A.B. 1996).


47 Id. ¶ 21. This contrasts with the most consistent American view—which is immoral is immoral, no matter where it may be. See infra this section.


49 Id. at *6.

50 In re Boulevard Entm't, Inc., 334 F.3d 1336, 1340 (Fed. Cir. 2003).

51 In re Riverbank Canning Co., 95 F.2d 327, 329 (C.C.P.A. 1938).

place would take no offense. "This is an adult beverage, the consumption of which is commonly associated with the relaxation of inhibitions . . . . We conclude that beer drinkers can cope with Applicant’s mark without suffering meaningful offense." While this decision is non-precedential, it may signal a more permissive attitude, and the adoption of the E.U. position articulated in the SCREW YOU case.

As if that were not enough of a thaw in the frigid nature of things in the United States, a recent Federal Circuit decision may augur a complete overthrow of the Section 2(a) regime altogether. Until quite recently, in fact, until the final draft of this article was ready for press, the vast majority of U.S. jurisprudence on this subject simply waved off free expression concerns as meaningless. American courts, until recently, completely dismissed both the "relevant marketplace" element and free expression concerns:

The prohibition on "immoral . . . or scandalous" trademarks was first codified in the 1905 revision of the trademark laws. This court and its predecessor have long assumed that the prohibition "is not an attempt to legislate morality, but, rather, a judgment by the Congress that [scandalous] marks not occupy the time, services, and use of funds of the federal government." Because a refusal to register a mark has no bearing on the applicant’s ability to use the mark, we have held that § 1052(a) does not implicate the First Amendment rights of trademark applicants.

This is, at best, an uncomfortable conclusion, given that the opinion is so glib and dismissive of free expression concerns. This troubled free speech advocates for years, until a recent case seems to have warmed the free speech chill caused by this results-driven and unprincipled logic.

In Re Tam, decided on December 22, 2015, signals a sea change in how the United States may look at morality issues in the trademark realm. In that case, the Federal Circuit granted en banc review to a decision barring registration of a trademark "THE SLANTS" for a musical group, because the group

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53 Id. at 10.
55 In re Fox, 702 F.3d 633, 634–35 (Fed. Cir. 2012) (alteration in original) (citations omitted). Indeed, as some have commented, mere "[e]conomic controls are sometimes used to enforce ‘grey list’ censorship." Graeme W. Austin & Amy G. Zavidow, Copyright Law Reform Through a Human Rights Lens, in INTELLECTUAL PROPERTY AND HUMAN RIGHTS 257, 267 (Paul L.C. Torremans ed., 2008). See also Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd., 502 U.S. 105, 115 (1991) (In striking down New York’s "Son of Sam" law, which prohibited criminals from profiting from writing books about their crimes, the United States Supreme Court held "[a] statute is presumptively inconsistent with the First Amendment if it imposes a financial burden on speakers because of the content of their speech"). In the Son of Sam case, the authors were still free to write, but were denied the financial benefits of their labors. See id. at 108. That was the end of that law. See id. at 123. This appears to completely dispense with the McGinley reasoning.
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consisted of Asian Americans, and “slant” could be an ethnic slur to insult Asians.\(^{37}\)

In fact, in overturning this precedent, the recent decision in *In re Tam* made it clear how void of support such a conclusion was. It justified a full overhaul of Section 2(A) jurisprudence, almost mocking courts that had relied on the *McGinley* reasoning.

Other courts’ reliance on the reasoning in *McGinley* further reinforces the importance of taking this case en banc. Without analysis, the Fifth Circuit wrote that “[w]e join our sister circuit in rejecting [the applicant’s] argument that prohibiting him from registering a mark with the PTO violates his [First] Amendment rights.”\(^{38}\)

Prior to *In re Tam*, all USPTO decisions regarding the constitutionality of the morality provisions in Section 2(A) relied upon the logically bankrupt holding in *In re Robert L. McGinley*. That case held that since trademark applicants are still free to *use* rejected trademarks, there is no abridgment of speech if the trademark is denied *registration* due to its content.\(^{39}\) However, despite the fact that this reasoning was contrary to a large body of First Amendment jurisprudence, the courts were simply unwilling to abandon it. Until *In re Tam*, the notion that *McGinley* was flawed was often espoused,\(^{40}\) but always ignored by the courts and the TTAB, both of which seemed quite comfortable to keep rejecting immoral and scandalous trademarks, despite the impact on free speech concerns.

It is flawed to argue that governmental-imposed financial impediments to expression are not censorious as long as the expression is still allowed to proceed.\(^{41}\) Under the unconstitutional conditions doctrine, the government may not condition the availability of a government benefit on an individual’s agreement to surrender a constitutional right.\(^{42}\) Trademark registration is designed to pro-


\(^{38}\) *In re Tam*, 2015 U.S. App. LEXIS 22593, at *19–21 (alterations in original) (quoting Test Masters Educ. Servs., Inc. v. Singh, 428 F.3d 559, 578 n.9 (5th Cir. 2005)).

\(^{39}\) See *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981).


\(^{41}\) *In re Tam*, 2015 U.S. App. LEXIS 22593, at *39 (discussing the unconstitutional conditions doctrine).

vide government benefits to trademark registrants. As a viewpoint-based restriction on protected speech, Section 2(a) violates this doctrine.

After decades of frustration, the First Amendment argument against Section 2(a) finally prevailed, as In re Tam explicitly overruled any support that clause might have found from In re McGinley.

More than thirty years have passed since the decision in McGinley, and in that time both the McGinley decision and our reliance on it have been widely criticized. Furthermore, the McGinley analysis was cursory, without citation to legal authority, and decided at a time when the First Amendment had only recently been applied to commercial speech. First Amendment jurisprudence on the unconstitutional conditions doctrine and the protection accorded to commercial speech has evolved significantly since the McGinley decision.

Despite this pronouncement, 2(a)’s immoral and scandalous clause may not die a quiet death. While In re Tam did not directly confront the immoral and scandalous clause, it confirmed the theory that Section 2(A) is flawed, and cannot withstand constitutional scrutiny. The dicta in In re Tam suggests that the Federal Circuit is not prepared to uphold Section 2(a) at all. Nevertheless, in a case that was decided during the pendency of In re Tam, the TTAB refused to so much as stay a decision that turned on the “immoral and scandalous” clause of Section 2(a) pending the outcome of the Tam decision—citing that Tam was only dealing with the “disparaging” section of the law. Furthermore, at the time this article went to press, the Fourth Circuit Court of Appeals, a traditionally conservative appellate court, was considering a fully-briefed case pertaining to the mark REDSKINS. That case involves the exact same legal issues as In re Tam, but the Fourth Circuit is not bound by the Federal Circuit’s decision. Accordingly, even the In re Tam decision could find itself challenged by a sister court, thus creating a split in the Circuits, and inviting the United States Su-

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63 See In re McGinley, 660 F.2d at 486 n.12 ("What is denied are the benefits provided by the Lanham Act which enhance the value of a mark.").
64 In re Tam, 2015 U.S. App. LEXIS 22593, at *120.
65 Id. at *10 n.1. ("We limit our holding in this case to the constitutionality of the § 2(a) disparagement provision. Recognizing, however, that other portions of § 2 may likewise constitute government regulation of expression based on message, such as the exclusions of immoral or scandalous marks, we leave to future panels the consideration of the § 2 provisions other than the disparagement provision at issue here. To be clear, we overrule In re McGinley, and other precedent insofar as they could be argued to prevent a future panel from considering the constitutionality of other portions of § 2 in light of the present decision.") (citation omitted).
66 Id. at *19.
67 McGinley was always questionable from an analytical standpoint. The In re Tam court simply eviscerated it. See In re Tam, 2015 U.S. App. LEXIS 22593, at *19 n.4.
preme Court to weigh in on the issue. Given its current makeup, the outcome is not pre-ordained to be friendly to free expression concerns.

So what does the future hold for Section 2(a)'s "morality clause?" Optimism demands that we predict its downfall. While the Fourth Circuit could, even before this article makes it to press, issue a decision conflicting with In re Tam, the logic in Tam seems consistent with the First Amendment. As the In re Tam court recognized, trademarks propose a commercial transaction; speech that proposes a commercial transaction is "commercial speech" and is subject to First Amendment protection. Trademarks convey messages about the type, cost, and quality of the product or service associated with the mark. The trademark is a tightly targeted bit of expressive activity that seeks to persuade a potential customer to choose one product over another, either due to the identification of goods or to the communicative element of the trademark itself.

Therefore, it seemed quite strange (at least to an American) that the European Union considered free expression principles when rejecting trademarks, while until December 22, 2015, the Federal Circuit roundly ignored such concerns in the context of registration. With In re Tam re-establishing the fact that the First Amendment protects commercial speech, even commercial speech that makes some censorship-minded individuals uncomfortable, the doctrine of unconstitutional conditions has new life in this area of law. Further, if the Fourth Circuit considers other Circuits' decisions, it seems that the Federal Circuit is on the stronger side of the argument. American courts outside the Federal Circuit seemed to augur the In re Tam decision. In Bad Frog Brewery, Inc. v. New York States Liquor Authority, the appellant sought to use a trademark of a frog presenting his middle finger to the observer. The Second Circuit held that since trademarks are commercial speech, prohibition on use of so-called "offensive" trademarks did not advance the stated governmental purpose of pro-

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72 Trademarks convey the kind of speech the First Amendment wishes to circulate into the "marketplace of ideas;" trademark holders have financial incentives to make their name acceptable to the public, and the public has the power to reject those trademarks. See Edenfield v. Fane, 507 U.S. 761, 767 (1993). By limiting this speech, and imposing unconstitutional conditions to the registration and enforcement of "immoral" and "scandalous" words, Section 2(a) limits free speech and commercial expression.
73 Bad Frog Brewery, Inc. v. N.Y. State Liquor Auth., 134 F.3d 87, 97 (2d Cir. 1998). The Supreme Court in Central Hudson determined that where speech is protected, the court must determine "whether the asserted governmental interest is substantial . . . whether the regulation directly advances the governmental interest asserted, and whether it is not more extensive than is necessary to serve that interest." Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n, 447 U.S. 557, 566 (1980).
74 Bad Frog Brewery, Inc., 134 F.3d at 87.
tecting children from vulgarity or promoting temperance. Nor was the prohibition narrowly tailored to serve that purpose. Given this logic, the Federal Circuit's decision in Tam appears to be where the law belongs, if The First Amendment is to be interpreted consistently across the Circuits.

C. International Agreements and Immoral Trademarks

Given that the Paris Convention and the TRIPS Agreements provide the right for member states to deny registration if the marks are "contrary to morality or public order," it might seem that these Agreements provide adequate justification for all views, even the American one. However, a more thorough reading of the Agreements suggests that it is not quite so simple. While the reference to "morality or public order" comes from Article 6quinquies of the Paris Convention, the Article, in its entirety, allows for prohibition of marks,

when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public. It is understood that a mark may not be considered contrary to public order for the sole reason that it does not conform to a provision of the legislation on marks, except if such provision itself relates to public order.

This provision is subject, however, to the application of Article 10bis. Once we review Article 10bis, we see that European Union countries are bound to assure their nationals of protection from unfair competition, including enacting prohibitions on acts of a nature that will create confusion among competing goods. In particular, Article 10bis (3)(i) broadly obligates signatory states to prohibit "all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor." It would seem that Article 6quinquies grants some textual support to prohibitions on registration to marks based on immorality, but it seems that the text of that provision requires something more than peering at the mark with Victorian spectacles and stating, "[T]his will not do!" It appears that the immorality spoken of in Article 6quinquies is directed toward immorality based on deception or its tendency to cause public disorder. However, this article's exhaustive review of cases did not reveal an instance of a court ever going beyond merely deeming the prohibited mark as immoral, and thus without the right to be registered.

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74 See id. at 98-100.
75 Id. at 100-01.
76 See supra notes 25-26 and accompanying text.
77 Paris Convention, supra note 25, at art. 6quinquies (B)(3).
78 Id. at art. 10bis.
79 Id. at art. 10bis, (3)(1).
80 Some of the Paris Convention's provisions are incorporated by reference into the TRIPS Agreement pursuant to its Article 2(1). See TRIPS, supra note 11, at art. 2(1).
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Such prohibitions are sometimes defended as merely reflecting a legislative desire to deprive a mark of the privilege of registration, but not as a prohibition on use of the mark.81 If we examine the prohibitions in the light of international agreements, this argument appears to have some support. For example, Article 15(4) of TRIPS states that "[t]he nature of the goods or services to which a trademark is to be applied shall in no case form an obstacle to registration of the trademark."82 This is a restatement of Article 7 of the Paris Convention.83

However, the argument that morality-based restrictions on registration are compatible with the TRIPS and Paris agreements seems to sit on a three-legged chair, especially when other international agreements are brought into play.84 While no trademark acts examined for this Article specifically exclude only goods and services connected to the adult entertainment or sex industries, this tends to be the most heavily impacted market in practical application.85 Accordingly, if a super majority of the rejected marks are from one market segment, then it is logical to conclude that there is likely a violation of Art. 15(4) of TRIPS.

Aside from that, the notion that prohibitions on registration but not on use are permissible seems almost glib. In examining plain packaging of cigarettes under TRIPS, Alberto Alemanno and Enrico Bonadio observed that use and registration of trademarks are inextricably linked.86 In that study, they observed the opposite of what we see here: that registration without use creates a "hollow formal right which is economically meaningless."87 Moreover, it seems that if a state prohibits registration of marks based on morality, and points to Article 6quinquies for justification, the state may be de-justifying its logic. Alemanno and Bonadio cite to a tobacco industry letter, which with seeming logic, states that Article 6quinquies prohibitions "are not motivated by the fact that

82 TRIPS, supra note 11, at art. 15(4).
83 See Paris Convention, supra note 25, at art. 7.
84 Article 10 of the European Convention on Human Rights (ECHR) protects freedom of expression, and has been interpreted to impact the rights of mark holders. Convention for the Protection of Human Rights and Fundamental Freedoms art. 10, Nov. 4, 1950, 213 U.N.T.S. 221 [hereinafter ECHR]. Moreover, Article 1, Protocol No. 1, has been interpreted to confer a human rights element to negative effects on property, including trade mark registrations. See Anheuser-Busch Inc. v. Portugal, 45 Eur. Ct. H.R. 36, ¶ 46 (Grand Chamber 2007).
85 No study has been conducted, but the author has practiced in this area for more than 10 years, and almost universally has seen "immoral and scandalous" rejections affect the adult entertainment industry.
87 Id.
the registration itself would be problematic, but rather that the use of the trade
mark would be. \footnote{Id. at 470.} This dichotomy between registration and use seems false, however, when
examined in the opposite direction. As noted above, despite the flexibility pro-
vided in Article 6quinquies, Article 10bis contains no similar flexibility. Ra-
ther, the latter article obligates member states to provide for enforcement of
rights, as to prohibit unfair competition.\footnote{See Paris Convention, supra note 25, at art. 10bis.} However, denying registration to a
trademark will burden enforcement. At worst, a failure to allow for registered
rights on the thin basis of morality might very well mean an inability of a mark
owner to enforce his rights, thus leading to unchecked, unfair competition.

If use is permitted, but registration is not, then it would seem that the mo-
rality police have placed their priorities backwards. Certainly if public order
were threatened by a mark, and the moral foundation of the nation were placed
at risk by it, then why would the member state merely prohibit registration, but
not prohibit the use of a mark that could cause such chaos? The ministerial act
of issuing a trademark registration is, at best, a mere clerical exercise, one often
signified by the issuance of a pretty piece of paper with a ribbon affixed (an act
that is more than compensated for by registration fees). At that point, if even a
mark were to possess such power that it could upset public morality and order,
would this limited-ministerial act prevent such a threat?

The fact is that the prohibition latitude found in Article 6quinquies is ill
explained. Without such explanation, this latitude is difficult to justify when it
is interpreted in a manner that permits a member state to deny registration on
the basis of morality, before first examining the Article as a whole in order to
divine its actual purpose. Nevertheless, most member states seem to have en-
acted provisions in their own trademark acts, which simply grab ahold of the
word "morality" and run from there.\footnote{For example, The Canadian Trade Marks Act, at Section 9(1)(j) prohibits registration of
"any scandalous, obscene or immoral word or device." Canada, Trade-marks Act, supra note 27. Similarly, Section 2(a) of the United States Trademark Act prohibits the registration of "immoral or scandalous" trademarks, as does Article 7(1)(f) of the Community Trade Mark
2009 on the Community Trade Mark, art. 7(1)(f), 2009 O.J. (L78) 1, 3 (EC).}

D. Free Expression and Human Rights Concerns

The majority of the literature examining trademark rights and free speech
evaluates the negative effect that over-zealous protection of trademark rights
can have on free speech principles.\footnote{See generally DAVID BOILLIER, BRAND NAME BULLIES: THE QUEST TO
OWN AND CONTROL CULTURE (2005); KEMBERW MCLEOD, FREEDOM OF EXPRESSION: OVERZEALOUS
COPYRIGHT BOZOS AND OTHER ENEMIES OF CREATIVITY (2005); Rochelle Cooper Dreyfuss,
Expressive Genericity: Trademarks As Language in the Pepsi Generation, 65 NOTRE DAME
how trademarks actually are free speech in and of themselves, and how content-based restrictions on protection violate free speech principles. That tide seems to be changing, as there is a growing body of law and literature interpreting Article 10 of the European Convention on Human Rights ("ECHR") as protecting an applicant's freedom of expression. Thus, any derogation of that right requires justification under Article 10(2).

This analysis makes it clear that the effect of denials of protection is not without significant effect upon the mark owner's free speech rights. While it may not be a direct gag upon expression, it will have a significant "chilling" effect. This was explicitly recognized in Application of Kenneth (trading as ScrewYou). In that case, as discussed above, the Grand Board explained that the lack of a registration would be likely to impact a firm's willingness to invest money into a campaign, as the lack of protection would artificially suppress the brand's profitability. However, at least one commentator has examined the issue and found that there is no infringement of Article 10 rights.

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There is scholarship that suggests free speech concerns are not entirely alarming in this realm, if refusal of registration has no practical implications for use of the mark. See Marco Ricolfi, Trademarks and Human Rights, in INTELLECTUAL PROPERTY LAW AND HUMAN RIGHTS 453, 459–60 (Paul L. C. Torremans ed., 3d ed. 2015).


See ECHR, supra note 84. Article 10—Freedom of expression:

1. Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers. This Article shall not prevent States from requiring the licensing of broadcasting, television or cinema enterprises.

2. The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society, in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary.

Id.

See Jonathan Griffiths, Is There a Right to an Immoral Trademark, in INTELLECTUAL PROPERTY AND HUMAN RIGHTS, supra note 55, at 309, 327.


See Griffiths, supra note 95, at 329–30 (collecting cases).
Whether Article 10 rights are implicated or not—and there is at least an argument that they are—the decision in Anheuser-Busch v. Portugal raises a human-rights angle to the issue of property rights in trademark registration. In that case, the well known American beer maker clashed with the prior user of the “Budweiser” mark, because the Czech predecessor opposed the American company’s quest to register BUDWEISER in Portugal. The Lisbon Court of Appeal eventually ruled that the Portuguese intellectual property office should refuse to grant a registration of BUDWEISER as a trademark. The Portuguese Supreme Court upheld the decision.

The American company filed a case before the European Court of Human Rights, arguing that Article 1 of its First Protocol provides every natural person a right to the peaceful enjoyment of his possessions, and that the refusal to register the trademark amounted to a violation of Article 1. The ECHR ruled in Anheuser-Busch’s favor on several grounds. First, it held that a trademark and its application were indeed “possessions” under Article 1. Additionally, it recognized that Council Regulation (EC) No. 40/941 of 20 December 1993 establishes a right to a Community trademark, and Article 24 of the Regulation establishes the Registration as “property.” Finally, the ECHR acknowledged that Article 17(2) of the Charter of Fundamental Rights guaranteed the right of property, including intellectual property.

The most important part of the holding is that the “legitimate expectations” of a trademark registration may be “properly” subject to Article 1 of Protocol 1. However, the issue turns on whether there is a dispute as to the applicability of natural law in whether the registration is granted. When the right is clear, then there is a property interest. Accordingly, the Grand Board agreed that if

99 Id., ¶ 14.
100 Id., ¶ 22.
102 The European Convention of Human Rights is an international treaty to protect human rights and fundamental freedoms, adopted by all Council of Europe member states. ECHR, supra note 84. The Convention established the European Court of Human Rights, where any person who feels his or her rights may have been violated under the Convention may file a claim. ECHR, supra note 84, at art. 19.
104 Id., ¶ 78.
105 Council Regulations are legal acts passed by the European Council and Parliament that are directly applied and become immediately enforceable in all member states simultaneously. Conversely, Directives are legal acts that obligate member states to achieve the objectives listed, but leave implementation at the national level to each member state. See generally Council Directive 95/46, 1995 O.J. (L 281) 31 (EC).
107 Id., ¶ 38.
108 Id., ¶ 65.
there is a legitimate question as to the competing parties' interests in a mark, there will be no violation of Article 1. However, the Council's language seems to suggest that a failure to register that is "unreasonable" and "arbitrary" would violate Article 1. Since no national authority has ever articulated a standard for "immorality" (nor could one likely do so), it seems any rejection on this basis would be per se arbitrary.

Ultimately, the ECHR did not overturn the Portuguese Supreme Court because there was an absence of arbitrariness or manifest unreasonableness in the decision, and thus the judgment did not interfere with Article 1 rights. However, in the context of a denial of registration on the basis of "immorality," it almost seems impossible for the decision to be void of arbitrariness. By its very nature, the word "morality" seems to attract an arbitrary decision. In the case of Section 2(a) of the U.S. Trademark Act, Llewellyn Joseph Gibbons wrote, "[a]t best, this 'substantial portion' of the general public is a vacuous point on a nebulous continuum. One that is often chosen post-hoc to justify the decision-maker's preconceived determination."\footnote{Id.}

E. The Sum of the Parts—Trademark Conclusion

It seems that the pre-Tam prohibitions in America were mired more in tradition than logic, and that section 2(a) was simply awaiting the right court to connect the dots laid out by a large body of First Amendment jurisprudence, as it did in In re Tam, whose future is at this point uncertain. In the European Union, it seems that there has been a cultural shift, whereby the European Union overtook "the land of the free" when it comes to First Amendment-style principles. Article 10 of the ECHR establishes that "[e]veryone has the right to freedom of expression . . . without interference by public authority."\footnote{See Id. § 87.} This extends to commercial speech. As such, it seems that prohibitions on the registration of marks on the basis of their morality will receive increasing levels of justification. Given In re Tam, rejection on the basis of morality in the United States just might be at an end. Meanwhile, the nascent body of law in the European Union seems to be requiring greater levels of justification in order to comply with Article 1 and 10 of the ECHR.\footnote{Llewellyn Joseph Gibbons, Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(A) Trademark Law After Lawrence v. Texas, 9 MARQ. INT’L PROP. L. REV. 187, 206 n.89 (2005). See also Sonia K. Katyal, Trademark Intersectionality, 57 UCLA L. REV. 1601, 1623 n.80 (2010) (collecting literature).} Accordingly, the optimistic prediction is that the standards will merge to one that only rejects trademark pro-

\footnote{ECHR, supra note 84.}
\footnote{As suggested by professor Ricolfi, any such interference "should address pressing social needs, be proportional and accompanied by adequate reasoning." Ricolfi, supra note 92, at 472.}
tection when there is a compelling reason to do so, and one which governs the orderly maintenance of a non-confusing marketplace, rather than one where intellectual property rights are simply a tool for a "proxy battle" in ongoing culture wars.114

III. COPYRIGHT PROTECTION AND NOTIONS OF MORALITY

In the context of copyright protection, we find less explicit morality-based restrictions on enforcement than we do in the patent or trademark context. This is perhaps largely because under the Berne and TRIPS agreements, copyright protection is intended to attach upon creation rather than allowing any dependency upon registration.115 Therefore, member states might feel more bound by agreement, with automatic protection mechanisms, than they do in the context of other IPRs, where there is a layer of administrative action between the IPR owner and the desired protection.

Interestingly enough, the agreements allow discrimination by a country against its own authors.116 However, the United States uniquely avails itself of this privilege, by requiring registration of American works before they may be enforced in U.S. courts.117 Meanwhile, foreign works may be enforced without registration.118 Accordingly, the issue of morality in the patent and trademark context is, at least initially, a matter of administrative law. But, when it comes to copyrights, the morality of a work will only come into play at the time of enforcement. At that point, the matter will stand before a court, which is usually in a more responsible position than an administrative agency, in regards to constitutional rights.119 In this environment, freedom of expression is going to be more front-and-center.

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114 This is not to suggest that denials for "morality" reasons should be considered to be completely unjustified. If a mark were to be seen as a threat to national security, territorial integrity, or public safety, to prevent crime or disorder, etc., then Article 10(2) of the ECHR would tolerate such restrictions. Id. at 471. However, it is very difficult to imagine how a mere trademark registration could create a threat to a national border.

115 See Berne Convention, note 23, at art. 5(2) (prohibiting any formalities in order for an author to enjoy copyright protection); TRIPS, supra note 11, at art. 9 (incorporating inter alia this paragraph).

116 Berne Convention, supra note 24, at art. 5(3).

117 17 U.S.C. § 411(a) (2012). In the United States, a work is copyrighted upon creation. However, the absence of a registration bars enforcement of the copyright in court. But, the copyright owner may register either before filing suit, or even simultaneously, depending upon the jurisdiction. Any registration made within three months of publication, or prior to the infringement, will provide the owner with extra benefits including the award of attorneys’ fees (if the plaintiff prevails) and the availability of statutory damages. See id. §§ 411–12.


119 See generally WIPO Secretariat, Standing Comm. on Copyright & Related Rights, Survey of National Legislation on Voluntary Registration Systems for Copyright and Related Rights, WIPO Doc. SCCR/13/2 (Nov. 9, 2005). Most countries, while not requiring registra-
"There have always been perceived conflicts between copyright and rights such as freedom of expression, but [at least in the United States] it was also argued in parallel that copyright was intended to be an engine of free expression." Under the driving copyright theory in the United States, copyright law exists "to provide a marketable right for the creators and distributors of copyrighted works, which in turn creates an incentive for production and dissemination of new works." Meanwhile, Continental Europe's underpinnings of copyright law tend to be couched in "author's rights." Post revolutionary French laws and theorists portray the existence of an intimate and almost sacred bond between authors and their works as the source of a strong literary and artistic property right. Thus, France's leading modern exponent of copyright theory, the late Henri Desbois, grandly proclaimed: "The author is protected as an author, in his status as a creator, because a bond unites him to the object of his creation."

The notion of denying copyright protection to a work on the basis of morality is probably the most troubling impediment to IPRs from a free expression perspective, regardless of the theory one might embrace. Such impediments seem most likely to be a tool of censorship or the imposition of a predetermined means of thought. If a government or court makes a decision about the value of a work based on its content, this runs afoul of most free speech regimes in so-called "free countries." In fact, if we embrace the continental "author's rights" model, making such judgment calls seems to infringe upon not only the author's right as a creator, but it seems to infringe upon notions of human rights.

A. United Kingdom—The Courts Maintain "Superintendency"

The United Kingdom has a centuries-old common law tradition of making policy-based decisions on copyright cases. In fact, the United Kingdom's modern age of copyright begins in 1710 with the Statute of Anne. The first decision interpreting the act was Burnett v. Chetwood, in which the plaintiff complained that the defendant copied his Archaeological Philosophica, which

\footnotesize{\begin{itemize}
  \item \footnote{Daniel J. Gervais, Intellectual Property and Human Rights: Learning to Live Together, in INTELLECTUAL PROPERTY AND HUMAN RIGHTS, note 48, at 3, 6.}
  \item \footnote{Julie E. Cohen et al., Copyright in a Global Information Economy 7 (2d ed. 2006).}
  \item \footnote{Jane C. Ginsburg, A Tale of Two Copyrights: Literary Property in Revolutionary France and America, 64 TUL. L. REV. 991, 992 (1990).}
  \item \footnote{See generally Gervais, note 120.}
  \item \footnote{8 Anne, c. 19 (1710) (Eng.).}
  \item \footnote{Burnett v. Chetwood (1721) 35 Eng. Rep. 1008; 2. Mer. 441.}
\end{itemize}}
was originally in Latin, and distributed it in English.\textsuperscript{126} The Lord Chancellor agreed with the defense that a translation did not meet the statute’s definition of unlawful copy.\textsuperscript{127} Nevertheless, the Court decided in the plaintiff’s favor. The Lord Chancellor reasoned that the book contained “strange notions,” and that it would likely cause harm if the less-educated were able to read it (given that the less educated classes would read English, and would thus be susceptible to its corruptions). With that, the Lord Chancellor pronounced, “[The Court has] a superintendency over all books, and might in a summary way restrain the printing or publishing any that contained reflections on religion or morality.”\textsuperscript{128}

This doctrine of judicial superintendency continued throughout the years. In \textit{Southey v. Sherwood}, Lord Eldon refused to enjoin unlawful distribution of a libelous poem, “Wat Tyler.”\textsuperscript{129} He did the same in \textit{Murray v. Benbow}, when confronted with a blasphemous work, ruling that no publication injurious to religion could find copyright protection.\textsuperscript{130} It was likely not lost on him that in so ruling, he simply allowed the works to pass into the public domain, thus increasing the spread of the libel and blasphemy. Nevertheless, Lord Eldon’s position was that he was ruling simply on issues of property.\textsuperscript{131} By the time licentious works found their way before a powdered wig, the doctrine was well in place and thus a book about the sexual exploits about the life of a courtesan was denied protection.\textsuperscript{132} Even notions of international comity were set aside in the name of morality, as the Court of Appeal denied relief to a plaintiff seeking damages and an injunction over infringement of two “indecent” photographs, despite the fact that they were protected by French copyrights.\textsuperscript{133}

In the twentieth century, the U.K. courts continued their superintendency, reaffirming the doctrine in \textit{Glyn v. Weston Feature Film Company} and declaring “immoral tendency” to be sufficient grounds to deny protection to Elenor Glyn’s “Three Weeks,” given that it was a tale of adultery.\textsuperscript{134}

Stripped of its trappings, which are mere accident, it is nothing more nor less than a sensual adulterous intrigue. And it is not as if the plaintiff in her treatment

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\textsuperscript{126} For a wealth of citations of ancient cases denying copyright protection, see 13 C.J. COPYRIGHT AND LITERARY PROPERTY § 99, at 1016–17 (William B. Hale ed., 1917) (collecting cases).

\textsuperscript{127} The Court was persuaded by what one might call an early “fair use” argument—that the translator “has bestowed his care and pains upon it,” and therefore it was not an infringement, but rather a new work. \textit{Sherwood}, 35 Eng. Rep. at 1009; 2 Mer. at 441.

\textsuperscript{128} \textit{Id.} at 1009; 2 Mer. at 441.


\textsuperscript{131} \textit{Southey}, 35 Eng. Rep. at 1008; 2 Mer. at 440.


\textsuperscript{133} \textit{Baschet v. London Illustrated Standard Company} [1900] 1 Ch. 73, 74.

\textsuperscript{134} \textit{Glyn v. Weston Feature Film} [1916] 1 Ch. 261, 261.
of it were content to excuse or palliate the conduct described. She is not even satisfied with justifying that conduct. She has stooped to glorify the liaison in its inception, its progress, and its results; and she has not hesitated to garnish it with meretricious incident at every turn.

Now it is clear law that copyright cannot exist in a work of a tendency so grossly immoral as this, a work which, apart from its other objectionable features, advocates free love and justifies adultery where the marriage tie has become merely irksome. It may well be that the Court in this matter is now less strict than it was in the days of Lord Eldon, but the present is not a case in which in the public interest it ought, as it seems to me, to be at all anxious to relax its principles. We are constantly hearing of the injurious influence exercised upon the adventurous spirit of our youth by the penny dreadful which presents the burglar in the guise of a hero and so excites the imagination of the juvenile reader that, adopting in the spirit of true adventure the life of his idol, he presently finds himself in the dock branded by an unfeeling world as a common thief. So is a glittering record of adulterous sensuality masquerading as superior virtue, as it does in this book, calculated, with consequences as inevitable as they are sure to be disastrous, to mislead into the belief that she may without danger choose the easy life of sin many a poor romantic girl striving amidst manifold hardships and discouragements to keep her honour untarnished.135

Judge Younger was not merely content to withhold the benefit of copyright, but queried whether the publication should not also be censored.136 Throughout the Victorian era, U.K. courts routinely denied protection to works that were deemed immoral.137 And, advancing to the modern age, it seems that U.K. courts have declined to relinquish their superintendency. Even in the late twentieth and early twenty-first century, U.K. courts cited Glyn with approval.138

In Hyde Park Residents Limited v Yelland,139 Jacob J. held that “in principle public policy can prevent copyright enforcement completely.” U.K. courts have, in more recent times, even had statutory authority upon which to rest their analysis. Under Section 171(3) of the Copyright Patents and Designs Act 1988, U.K. courts have recognized that they still have the power to deny enforcement on public policy grounds. As the act states, “[n]othing in this Part affects any rule of law preventing or restricting the enforcement of copyright, on grounds of public interest or otherwise.”140

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135 *Id.* at 269–70.
136 *Id.* at 270.
B. Taiwan Changes Direction

In 1999, a Taiwanese criminal court decision determined that pornographic works were not subject to copyright protection under Art. 3 of the Taiwanese Copyright Act.141 After this decision, commentators noted the tension between the Taiwanese Intellectual Property Office (TIPO) and the Taiwanese courts.142 In Case 250 of 1999, the Taiwanese Supreme Court held that because pornography is against social order and the public interest, it is not subject to copyright protection.143 This decision was affirmed in Taiwan High Court Appeal No. 94 of 2005.144 However, TIPO maintained the position that as long as the works are original, they are copyrightable, even if deemed to be legally obscene.145 This is likely due to the fact that TIPO is in a superior position vis a vis the Taiwanese Supreme Court to evaluate international intellectual property agreements, and the Taiwanese Supreme Court position is contrary to international accords.146 However, as of February 2014, the Taiwanese Supreme Court appears to have accepted TIPO's view.147 Despite this, given the language from news reports about the ruling,148 it appears that the Taiwanese high court reluctantly recognized the copyrightability of the pornographic content contained in the subject Japanese film. This was due to the fact that international treaties (namely TRIPS) created an obligation to protect pornographic works if they are copyrighted in their country of origin.149 Essentially, Taiwan only recognizes its

141 Case 250, 1999, Supreme Court First Criminal Judgment Compilation Book page 35, 534–37. (Xingshi Huihian Jan. 21, 1999), Supreme Court of Republic of China, 4th Division, Criminal Court (“術或其他學術範圍之創作而言，色情光碟片不屬之”) [hereinafter “Case 250 of 1999”] (holding that pornography is an unprotected category of copyright).
143 Case 250 of 1999 (“風，且與著作權法之立法目的有礙，基於既得權之保障仍需公序良俗”)(the basis for a lack of copyrightability is the support of good morals). See also Kuo & Yen, supra note 142.
144 See Zhongxin, supra note 142.
145 Kuo & Yen, supra note 142.
146 Taiwan is not a signatory to the Berne Convention, but it is a signatory to TRIPS, which incorporates Art. 5 of Berne by reference. See TRIPS, supra note 11, at art. 9.
148 At the time this article was completed, the ruling itself was unavailable. However a recap of the case can be found here: Jason Pan, Court Backs Porn Studio in Landmark Copyright Case, TAIPEI TIMES (May 20, 2015), http://www.taipeitimes.com/News/taiwan/archives/2015/05/20/2003618727.
149 See Zhongxin, supra note 142 (discussing how Taiwan’s entry into the WTO required full recognition of all Japanese copyrighted works, regardless of the content thereof). Com-
treaty obligation to foreign pornographic works seeking copyright protection, and only where the copyright has been granted in their country of origin. Domestic Taiwanese pornography is not similarly protected. Canada—The Common Law Rejected, No Prohibition

In North America, these prohibitions have withered away in favor of a content-neutral evaluation. In Canada, obscenity was once grounds to deny copyright protection to a work, as the country relied on the U.K. common law. In Pasieckiak v. Dofajtek, the defendant argued that a Ukrainian language book was legally obscene, and thus copyright did not attach to it; while the trial court agreed, the appellate court reversed on the grounds that the work was not actually obscene.150 However, once the Canadian Charter of Rights and Freedoms came into being, this prohibition faded.151 In Aldrich v. One Stop Video,152 the British Columbia Supreme Court rejected the old common law rules, and held that there is nothing in the Canadian Copyright Act that should deny an author the benefit of the Act on policy grounds.

C. The United States—Should Be Resolved, but It May Not Be

In the United States, there has been a recent trend in attempting to establish (or re-establish) the rule that pornography is not copyrightable. This began with a mere footnote issued in a case in the United States District Court for the District of Massachusetts. In 2011, U.S. District Court Judge William G. Young issued an order in Liberty Media Holdings v. Swarm Sharing Hash File.153 Footnote two of the order reviewed the law’s evolution toward recognizing copyright protection for erotica—including, even extending, protection to legally obscene materials.154 Judge Young correctly observed that this precise question had not yet been directly answered by the First Circuit Court of Appeals.155 But does such a notion have any legitimacy?156

pare historical lack of such comity in Baschet v. London Illustrated, where the United Kingdom denied protection to two French photographs due to their “indecent” nature. [1900] 1 Ch. 73, 74.

152 Id.
155 Liberty Media Holdings, 821 F. Supp. 2d at 447 n.2. This circuit covers federal appeals for Massachusetts, Rhode Island, New Hampshire, Maine, and Puerto Rico. About the Court,
The concept that erotica should not be copyrightable is not without historical support in the United States. In 1867, the Circuit Court of California held that the defendant’s profane parody play, "The Black Crook," lacked entitlement to copyright protection because of its contents.\textsuperscript{157} The court found that "it is the duty of all courts to uphold public virtue, and discourage and repel whatever tends to impair it."\textsuperscript{158} The court looked beyond the bare requirement of originality in assessing the play's copyrightability, and deprived the owner of any protection for a work that today would be described as a dark comedy.\textsuperscript{159}

Interestingly enough, in denying copyright protection on the basis of "morality," U.S. courts historically tended to do so on racist grounds. In Broder v. Zeno Mauvais Music Co.,\textsuperscript{160} another California court objected to the use of the word "hottest" in the song "Dora Dean," and found that the song lacked copyrightability for as long as the word "hottest" remained within its composition.\textsuperscript{161} The court wrote that "the word 'hottest,' as used in the chorus of song 'Dora Dean,' has an indecent and vulgar meaning, and that for that reason the song cannot be protected by copyright."\textsuperscript{162} In Simonton v. Gordon, a book told the story of a Caucasian man's sexual affair with a West African woman, and it was deemed to be too far outside the mainstream to receive copyright's benefits.\textsuperscript{163}

The U.S. Supreme Court articulated the modern test for whether a work is entitled to copyright protection in Bleistein v. Donaldson Lithographing Com-

\textsuperscript{157} Martinek v. Maguire, 16 F. Cas. 920, 923 (C.C.D. Cal. 1867).
\textsuperscript{158} Id. at 922.
\textsuperscript{159} See generally id.
\textsuperscript{160} Broder v. Zeno Mauvais Music Co., 88 F. 74 (C.C.N.D. Cal. 1898).
\textsuperscript{161} Id. at 79. At the time, "hottest" was only used in African American vernacular.
\textsuperscript{162} Id. Interestingly enough, the discussion itself might be deemed immoral as it relied upon a quite racist determination of "colored" language.
In this decision, the Court established an objective test for copyrightability based on the work's originality. If the work has an original element to it, then it is entitled to copyright protection. The Bleistein court rejected a content-based test, holding that “[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of [creative works].”

The Bleistein test makes it clear that courts should not make moral judgments about an artist’s works before granting the artist the protections that have been bestowed upon him as an unequivocal right. When we view this through American eyes, we of course view it through the lens of the First Amendment. But even in the absence of American influence, international norms seem to scowl at the notion of morality-based copyright restrictions. For instance, under Article 2, section 1 of the Berne Convention, signatory nations agreed to recognize the copyrightability of cinematic works regardless of their content. While international agreements provide for copyright protection despite the work’s content, it would seem that even if the agreements were interpreted to allow for morality-based restrictions, they would violate fundamental rights in both the United States and the European Union.

Despite the recent chorus calling for pornography to be locked out of the copyright club in the United States, by all appearances, Congress has not seemed to wish for any content-based restrictions on copyrightability. In enacting the current Copyright Act, Congress expressed a specific intent to avoid inquiry into the contents of copyrightable works and their respective merits:

The phrase 'original works of authorship,' [§ 102] which is purposely left undefined, is intended to incorporate without change the standard of originality estab-

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165 Id.
166 Id. 250–51.
167 See id. at 251.
168 See id. The very DNA of the U.S. Constitution is incompatible with drawing distinctions between different types of speech. See generally The COMPLETE BILL OF RIGHTS (Neil H. Cogan, ed., 2d ed. 2015). The Framers rejected proposed language for the First Amendment that would have limited its protection to decent speech. Id. at 148. Some time between July 21–28, 1789, Roger Sherman of Connecticut proposed an amendment to the House Committee of Eleven which included the language: “The people have certain natural rights which are retained by them when they enter into society. Such are the rights . . . of Speaking, writing and publishing their Sentiments with decency and freedom . . . .” Id. This amendment was effectively rejected by the committee in its July 28 report, favoring language that was closer to the First Amendment that was ultimately adopted. Id. See also Kenneth R. Bowling, "A Tub to the Whale" The Adoption of the Bill of Rights, in THE BILL OF RIGHTS AND THE STATES: THE COLONIAL AND REVOLUTIONARY ORIGINS OF AM. LIBERTIES 46, 51 (P.T. Conley & J.P. Kaminski, eds., 1992) (“[Roger] Sherman’s attempt to limit Madison’s absolute guarantee of the freedoms of speech and press by requiring that the words be decent failed in the committee”).
169 Berne Convention, supra note 24, at art. 2(1). This likely is the source of the tension between the Taiwanese Supreme Court and TIPO.
lished by the courts under the present copyright statute. This standard does not include requirements of novelty, ingenuity, or esthetic merit, and there is no intention to enlarge the standard of copyright protection to require them.\(^7\)

In addition to practical limitations of content review, both the U.S. Copyright Office and the U.S. Attorney General have recognized that "for policy reasons it may not be thought appropriate for the Register [of Copyrights] to undertake to be a conservator of public morals."\(^8\) Copyright has specifically and deliberately grown to be content-neutral.\(^9\) By the 1909 Copyright Act's enactment, Congress eliminated all provisions that could serve as content-based restrictions to copyright registration.\(^10\) In pre-1909 versions, Congress removed provisions enabling content-based restrictions on copyright protection after courts found that such restrictions could be used to limit copyright protections.\(^11\) The 1856 Copyright Act's language limited protection to works "designed or suited for public representation," but Congress deleted this language from the 1870 act.\(^12\) In the wake of *Bleistein*, the 1909 Copyright Act washed away content-based limitations on copyright protection, and they have never returned.

Further, there are controlling decisions in three jurisdictions rejecting such content-based limitations. In *Mitchell Brothers Film Group v. Cinema Adult Theater*, the Fifth Circuit rejected the proposition that copyright protection is not available for legally obscene works.\(^13\) Observing the limitations on time and place inherent in finding a work obscene, the Fifth Circuit cautioned that any obscenity exception to copyright protection would "fragment" the copyright system's uniform national standards.\(^14\) When faced with arguments regarding erotic copyrights, the *Mitchell Brothers* court issued a firm rebuff:

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In contrast Congress has placed explicit content-related restrictions in the current statutes governing the related areas of trademarks and patents. The Latham Act prohibits registration of any trademark that "consists of or comprises immoral, deceptive, or scandalous matter," 15 U.S.C. § 1052(a), and inventions must be shown to be "useful" before a patent is issued.

*Id.* Accordingly, Congress could seek to add an "immoral and scandalous" prohibition to Title 17, if it so desired. See *Id.* This would be unconstitutional, as is Section 2(a) of the Trademark Act, but it would at least demonstrate some congressional intent. See *Id.* at 856.

\(^10\) *Id.* at 854–55.

\(^11\) *Id.* at 855 n. 4.

\(^12\) *Id.* at 858.

\(^13\) *Id.* at 857–58. See also *Flexible Lifeline Sys. v. Precision Lift, Inc.*, 654 F.3d 989, 998–1000 (9th Cir. 2011) (promoting uniform interpretation of copyright law nationwide); *JustMed, Inc. v. Byce*, 600 F.3d 1118, 1124 (9th Cir. 2010) (promoting uniform interpretation of copyright law nationwide); *Cmtv. for Creative Non-Violence v. Reid*, 490 U.S. 730, 740 (1989).
"Because... a copyright infringement action furthers the congressional goal of promoting creativity, the courts should not concern themselves with the moral worth of the plaintiff."178

This sentiment comported with the Register of Copyright's decades-old policy of remaining agnostic when it came to administrative impediments to registration.179

Congress has concluded that the constitutional purpose of its copyright power, "[to promote the Progress of Science and useful Arts]," U.S.Const. art. 1, § 8, cl. 8, is best served by allowing all creative works (in a copyrightable format) to be accorded copyright protection regardless of subject matter or content, trusting to the public taste to reward creators of useful works and to deny creators of useless works any reward. It is not surprising that Congress would choose to rely on public acceptability as a measure of a work's worth rather than on the judgment of such public officials as the Register of Copyrights and federal and state judges.180

The Ninth Circuit reached an identical conclusion in *Jarretech, Inc. v. Clancy*.181 In that case, the court noted that the community standards element in the obscenity analysis varies widely from community to community.182 It is important to note that in the United States, "obscenity" is a term for content that is specifically exempted from First Amendment protection. Americans can be, and are, put in prison for production and distribution of obscene content.183 However, obscenity is measured by looking at "contemporary community standards," and thus is different from time to time and even town to town.184 The power of the *Mitchell Bros.* and *Jarrettech* cases together is unmistakable: even content that could land its creator in prison would still be subject to copyright protection. Furthermore, consistency in copyright appears to be of greater importance than managing morality. The *Jarrettech* court noted that the "[a]cceptance of an obscenity defense would fragment copyright enforcement,

178 *Mitchell Bros.*, 604 F.2d at 862.
179 Dan W. Schneider, *Authority of the Register of Copyrights to Deny Registration of a Claim to Copyright on the Ground of Obscenity*, 51 CHI.-KENT L. REV. 691, 704–05 (1975) (discussing policy changes at the copyright office in light of constitutional concerns and attorney general opinions).
180 *Mitchell Bros.*, 604 F.2d at 855 (footnote omitted).
181 *Jarrettech, Inc. v. Clancy*, 666 F.2d 403, 405 (9th Cir. 1982).
182 *Id.* at 406.
protecting registered materials in a certain community, while, in effect, authorizing pirating in another locale.\textsuperscript{185}

Years later, the Seventh Circuit reaffirmed this principle, holding that "even illegality is not a bar to copyrightability."\textsuperscript{186} In that case, Judge Richard Posner underscored Congress's intent to create the Copyright Act's "express objective of creating national, uniform copyright law" that is consistently and predictably applied.\textsuperscript{187}

D. Australia—A Forceful Repudiation of Content-Based Restrictions

Australia has clearly rejected morality-based restrictions on copyrightability. In \textit{Venus Adult Shops Pty Ltd v. Fraserside Holdings Ltd},\textsuperscript{188} the Federal Court of Australia reviewed the trends and history of North American and U.K. law, and came to the conclusion that content-based restrictions are intolerable Down Under. The court noted that there is no "public interest defense" to copyright infringement, and cited to \textit{Collier Constructions Pty Ltd v. Foskett Pty Ltd}.\textsuperscript{189} In that case, the court made a very strong statement: "there is no legislative or other warrant for the introduction of such a concept into the law of this country."\textsuperscript{190} The \textit{Fraserside} court unequivocally pronounced the death of any morality-based restrictions on copyright infringement by stating that, "[t]here is therefore no statutory basis under existing Australian copyright law for a finding that copyright does not subsist because the content of the relevant work or subject matter offends against community values or standards."\textsuperscript{191}

The repudiation of the U.K. rule was unequivocal: "[T]here is no basis for a conclusion that the scope of copyright protection is qualified by a reference to community standards and the content of the copyright work or other subject matter."\textsuperscript{192} The concurrence by Judge Finkelstein was just as forceful, with a full rejection of the theory that copyright would not attach to pornography, and further rejecting the notion that a court had any power to create such policy-based categories.\textsuperscript{193}

\textsuperscript{185} \\textit{Jaritech, Inc.}, 666 F.2d at 406. See also Miller, 413 U.S. at 24; Paris Adult Theatre I v. Slaton, 413 U.S. 49, 54–55 (1973); United States v. 2,200 Paper Back Books, 565 F.2d 566, 570 (9th Cir. 1977).

\textsuperscript{186} \textit{Flava Works, Inc. v. Gunter}, 689 F.3d 754, 755 (7th Cir. 2012). See also \textit{Belcher v. Tarbox}, 486 F.2d 1087, 1089 (9th Cir. 1973) (affirming copyrightability of material containing fraudulent misrepresentations).


\textsuperscript{188} \textit{Venus Adult Shops Pty Ltd v. Fraserside Holdings Ltd}, (2006) 157 FCR 442, 465 (Austl.).

\textsuperscript{189} \textit{Id.}

\textsuperscript{190} \textit{Id.}

\textsuperscript{191} \textit{Id.}

\textsuperscript{192} \textit{Id. at 471.}

\textsuperscript{193} \textit{Id. at 480.}
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The court did leave a bit of room for policy considerations to come into
play, but only as a means of informing a court’s discretion in rendering awards.
When relevant, subject matter that offends the community values may be used
to influence the award of particular remedies. However, the court noted, “the
scope of such an exercise of discretion would seem to be narrow.”

E. Fundamental Rights and Content-Based Restrictions on Copyright
Protection

In the United States, First Amendment principles have not yet been called
upon to stand in the way of content-based restrictions on copyright protection.
Nevertheless, as discussed above, they should theoretically stand as a shield
against such fragmentation. That said, the First Amendment has been little
comfort to trademark owners who have run afoul of the U.S. prohibition in Sec-

tion 2(a) of the U.S. Trademark Act.

Outside the United States, international agreements should have equal or
greater footing to stand as an obstacle to content based restrictions, and may be
called upon to get the United Kingdom back in line in accordance with its in-
ternational obligations. Articles 27 and 15 of the Universal Declaration of Hu-
man Rights (UDHR) protects the right to the moral and material interests re-
sulting from artistic productions and user’s rights to participate in the cultural
life of the community—to freely bask in all forms of expression. And, quite
frankly, that expression should be free of the judgments of intellectual pluto-
crats. “Culture must not be viewed as an esoteric activity of a superior social
elite.” In fact in light of Article 27(2) of the UDHR and Article 15(1)(c) of the
U.N. Covenant on Economic, Social, and Cultural Rights, copyright has
been observed to be a “human right equal to freedom of expression.”

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194 Gervais, note 120.
195 For example, in 2015 Simon Tam filed for trademark registration of his band name “THE
SLANTS” which was rejected under 2(a) as racist, or more precisely “disparaging.” In re
Tam, 785 F.3d 567 (Fed. Cir. 2015). The Tam opinion was vacated on April 27, 2015 and is
set for rehearing en banc to determine whether 2(a)—or at least portions of 2(a)—violates
the First Amendment. In re Tam presents itself as a prime example of the potential for free
speech issues in trademark ownership and may also prevail as the case that alters or even
eliminates this problem. See also Pro-Football, Inc. v. Blackhorse, No. 1:14-cv-01043-GBL-
and cancelling registration); Anne Gilson LaLonde & Jerome Gilson, Trademarks Laid
Bare: Marks That May Be Scandalous or Immoral, 101 TRADEMARK REP. 1476, 1540–45
(2011) (providing an index of rejected marks).
196 See Gervais, supra note 120, at 14. See also Estelle Derclaye, Intellectual Property
Rights and Human Rights: Coinciding and Cooperating, in INTELLECTUAL PROPERTY AND
HUMAN RIGHTS, supra note 55, at 133, 134.
197 Gervais, note 120, at 16.
198 Ysilde Gendreau, Copyright and Freedom of Expression in Canada, in INTELLECTUAL
PROPERTY AND HUMAN RIGHTS, supra note 55, at 219, 220.
while, Article 19 of the UDHR protects freedom of expression explicitly.\textsuperscript{260} Given this fact, it would be a violation of the UDHR to deny one human right (the copyright of one's works) while simultaneously violating another (freedom of expression) and the U.N. Covenant.

In the European Union, there is a trend that recognizes this theory of copyright as a "human right." Protocol 1 of the ECHR protects property rights. In \textit{Dima v. Romania},\textsuperscript{261} the European Court of Human Rights reviewed a copyright claim in light of Protocol 1. While the European court deferred to the Romanian courts on the issue of copyrightability, it acknowledged that Art. 1, Protocol 1 protects copyrights.\textsuperscript{262} If we accept the theory that morality-based restrictions on copyrightability are supportable, it invites arguments that threaten both copyright as a notion, and free speech principles. If accepted, this theory would impose new restrictions (or revive long-discredited ones) on what constitutes protectable subject matter under the U.S. Copyright Clause.\textsuperscript{263} This theory would rewrite the established test for copyrightability—which at this time is a simple measurement of the original effort put forth by the creator. If the work meets the minimum level of creativity, it receives protection. The notion that pornography might not be copyrightable contradicts the Copyright Act, as well as the Berne and TRIPS agreements, and would create at least one content-based restriction on what genres of works are entitled to copyright protection—which would most certainly invite more content-based exceptions.\textsuperscript{264}

The fact is, copyright protection is content-neutral under all international agreements. Even in the absence of these agreements, free speech principles in both the United States and elsewhere seem to frown upon any notion of a content-based restriction on copyrightability.

**CONCLUSION**

A limitation on patentability of inventions seems to be a legitimate policy decision. The U.S. approach of discarding all notions of morality in patentability appears to be a policy-based approach seeking to incentivize invention


\textsuperscript{262} Id. at 9. See also Melnychuk v. Ukraine, App. No. 28743/03, 2005-IX Eur. Ct. H.R. ¶ 7 (recognizing that IPRs are protected under Article 1).

\textsuperscript{263} U.S. CONST. art. I § 8 cl. 8.

\textsuperscript{264} Even if this theory were limited to legally "obscene" works, it would not only create a Constitutional problem, but a practical one—fragmenting copyright law on the basis of local community standards that change from time to time and place to place. See Miller v. California, 413 U.S. 15, 24 (1973) (holding that obscenity is measured by contemporary community standards).
without impediment. Other nations have clearly rejected this view, and are choosing to deny patent protection when such protection could incentivize commercial activity that could cut against human dignity. Whatever the justification, and whatever the wisdom of the justification, it does not appear that any such restrictions stand to run afoul of any free expression principles. Therefore, while there may be market-based objections to such prohibitions, there are no human rights bases to object to morality based restrictions on patents.

With respect to trademarks, there is textual acquiescence to prohibitions on "immoral" trademarks in international IPR agreements. However, there seems to be an internal conflict in the agreements. It also seems that governmental agencies are, to varying degrees, mired in conservative tradition. However, until recently, it would have been accurate to say that the E.U. and the common law world were drifting away from the United States and the conservative tradition. The EU, Canada, and Australia were all, to some extent embracing relaxation on strict standards of morality impeding the registration of "immoral" marks. In the United States, there seems to be a strong Constitutional argument against morality restrictions, and the In re Tam decision makes that clear. But, when it comes to sexual expression, the USA's underlying power of prudishness should never be counted out. Further, despite the Constitutional mandate against government censorship, the USPTO has always been unwilling to budge from an expansive view of its duties as a moral arbiter, unless it is forcibly dislodged from its current position.

In contrast, other nations seem to embrace permissiveness. This permissiveness comes from multiple sources, including recognition of the merits of the "relevant marketplace" analysis, a view of changing social mores, and upholding the free speech rights of the mark owners. Ultimately, it would seem that morality-based restrictions on trademark registrations are, especially in light of Anheuser-Busch v. Portugal, likely to be viewed under a more exacting standard than they have been in the past. This is evidenced by the SCREW YOU case, and its tip-of-the-hat to Article 10 of the ECHR.

The most troubling morality based IPR restrictions, from a theoretical perspective, are those confronting copyrights. Copyright law's goal has been to reward originality (under common law systems) and to protect the integrity of the author's rights (in civil law systems). "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations," which is why copyright law has turned a blind eye to the content of an original work and conferred it with rights and privileges solely based on its originality.

International agreements seem to prohibit the denial of copyright protection on policy grounds, as recognized by the Taiwanese Intellectual Property Office, and most recently the Taiwanese Supreme Court. In addition to the con-

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flict with free speech principles, it seems that a lack of protection for copyrighted works on the basis of their immorality would be counterproductive. If there is a policy decision that such works are problematic, then it would seem to be counter-productive to render all these “harmful” works to the public domain. While there are law enforcement responses to obscene works, the government cannot be expected to police every bit of distribution. However, if even legally obscene works can provide a private incentive to limit distribution through infringement suits, the governmental interest of limiting dissemination of disfavored works would seem to be better served by allowing copyright owners to assert their rights against infringers, even if the content is otherwise illegal.

However, the truly troubling side of a content-based test for copyrights is that it invites the government, bureaucrats and courts alike, to engage in value judgments when it comes to free expression. This has already been identified as a problem in the context of trademarks, but for the most part, it would impact free speech rights of mark holders on a theoretical and economic basis; however, it would not tend to be such an overarching tool for thought control. Content-based copyright restrictions would seem to invite statist elements to determine what kind of expression—indeed what thoughts—are unacceptable, and to place a finger (or even a fist) on the scale of justice, thus distorting the marketplace of ideas. As the United States Supreme Court once held, “one man’s vulgarity is another’s lyric.”\(^{206}\) And, as we learn time and again, a “morality” based judgment is inevitably amorphous and blurry, and requires us to trust those in power to make decisions for us, which does not bode well for notions of individual liberty. As Justice Finkelstein noted:

The inquiry will inevitably involve both moral and political considerations, ... [In truth, a judge is not well suited to the task and, as often as not, will reach the wrong result.]

There have been many ill-considered decisions about which works are obscene. The list of obscene works includes (in no particular order): Lawrence’s Lady Chatterley’s Lover, Joyce’s Ulysses, Nabakov’s Lolita, Huxley’s Brave New World, Balzac’s Droll Stories, Reed’s Ten Days that Shook the World, Stead’s Letty Fox: Her Luck and A Little Tea, a Little Chat, Winsor’s Forever Amber and Roth’s Portnoy’s Complaint. Inevitably a list of non-copyright works will, at some point, contain more great literary works.\(^{207}\)

Those who champion such restrictions are often near-sighted, and cheer for these restrictions, not seeing far enough into the future to realize that values that differ from theirs can change in short time. Those in power, or in the majority, can quickly find themselves in the minority. Regulations on thought and speech then become tools to calcify power, to restrict creative and revolution-


\(^{207}\) Venus Adult Shops Pty Ltd v. Fraserside Holdings Ltd (2006) 157 FCR 442, 480 (Austl.).
ary thought, and then free expression becomes yet another myth, with the "freedom" used only to stifle the marketplace of ideas, and not to feed it.

There is nothing wrong with a personal desire to see one's own notion of "morality" adopted by others. However, the force of law, even when simply a finger on the scales of justice, has a great tendency for abuse. While there is great guidance in the jurisprudence of multiple nations, and international agreements protecting individual liberties, perhaps the most inspirational conclusion should be left to a powerful dissent penned by Justice Oliver Wendell Holmes, which forms the foundation of much of the First Amendment jurisprudence in the United States. It has reverberated throughout the common law and civil law worlds, and should perhaps serve as guidance for us as we consider if one man's morality should influence whether we protect something as important as intellectual property rights in expressive content:

But when men have realized that time has upset many fighting faiths, they may come to believe even more than they believe the very foundations of their own conduct that the ultimate good desired is better reached by free trade in ideas . . . the best test of truth is the power of the thought to get itself accepted in the competition of the market, and that truth is the only ground upon which their wishes safely can be carried out.208

Despite this aspirational and inspirational theory, there will always be those who seek to impose their own sense of "morality" upon others. With intellectual property rights being of such prominent international and economic importance, it is no surprise that this eternal conflict plays out in the copyright and trademark offices worldwide.

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The Biggest Problem With The Team Name Redskins Lies With The NFL's Unique Labor Market

NFL Commissioner Roger Goodell recently penned a letter to Congress seeking to defend the NFL team from Washington D.C.'s use of the moniker "Redskins" even though Merriam-Webster’s Dictionary defines the term as being "usually offensive" to Native-American ethnic groups.

Goodell’s letter purports that the team name is not actually offensive because it is meant to honor a former Native American head coach, and it "stands for strength, courage, pride and respect," rather than for the scalps of murdered Native-Americans.

The NFL commissioner’s letter may perhaps persuade some members of Congress. However, it ignores one of the biggest problems with the continued use of the moniker.

Even if the team name truly had an innocent intent (a claim I’ll leave for historians to debate), its continued use creates an awful situation for young football players of Native American decent.

Indeed, it does not require too much of an imagination to presume that one day there will be a Native American football player that will have his rights selected in the NFL draft by the football team from Washington, D.C.
When this happens, that football player will be left with a Hobson’s choice. If he wants to play professionally, he will have to play for the team with a moniker that historically has yielded a negative connotation about his ethnicity.

This is a concern that Commissioner Goodell is remiss to ignore.

Let’s leave no doubt — an NFL team is not a traditional business that competes for workers in a free labor market. To the contrary, since Congress allowed the American Football League and National Football League to combine into one big league, the NFL has served as the only collection of teams to employ premier professional football labor in the United States. The NFL’s Collective Bargaining Agreement then further reduces prospective rookie football players’ choice of employers by allowing each player only to negotiate with the single NFL team that selects his rights in the NFL draft.

Moreover, the NFL Collective Bargaining Agreement does not have a clause that allows players to opt out of being selected by a particular team — not even on moral or public policy grounds.

Thus, any Native American football player could be selected by the football team from Washington, D.C. — making him a “Redskin” in the eyes of his teammates, the league, and the public.

And no matter how many times Commissioner Goodell may tell this player that being “Redskin” is a badge of honor, nothing could ever fully remove the sting of an epithet.

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