

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Simon Shiao Tam

Mark: THE SLANTS

Serial No.: 85472044

Filing Date: November 14, 2011

Examining Attorney: Mark Shiner

Law Office: 102

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

EX PARTE APPEAL

APPLICANT'S BRIEF

TABLE OF AUTHORITIES**CASES**

<i>Greyhound Corp. v. Both Worlds Inc.</i> , 6 U.S.P.Q.2d 1635 (TTAB 1988)	7
<i>Harjo v. Pro-Football, Inc.</i> , 50 U.S.P.Q.2d 1705 (TTAB 1999)	10
<i>In re Anti-Communist World Freedom Cong., Inc.</i> , 161 U.S.P.Q. 304 (TTAB 1969)	7, 8
<i>In re Bose Corporation</i> , 192 U.S.P.Q. 213 (CCPA 1976)	15
<i>In re Heeb Media LLC</i> , 89 U.S.P.Q.2d 1071 (TTAB 2008)	9, 10
<i>In Re Hershey</i> , 6 U.S.P.Q.2d 1470 (TTAB 1988)	14
<i>In re Lebanese Arak Corp.</i> , 94 U.S.P.Q.2d 1215 (TTAB 2010)	8
<i>In re Mavety Media Group Ltd.</i> , 33 F.3d 1367 (Fed. Cir. 1994)	13
<i>In re Promo Ink</i> , 78 U.S.P.Q.2d 1301 (TTAB 2006)	15
<i>In re Reed Elsevier Properties</i> , 82 U.S.P.Q.2d 1378 (Fed. Cir. 2007)	16
<i>In re Squaw Valley Dev. Co.</i> , 80 U.S.P.Q.2d 1264 (TTAB 2006)	6
<i>Sheffield-King Milling Co. v. Theopold-Reid Co.</i> , 269 F. 716 (D.C. Cir. 1921)	18

STATUTES AND RULES

15 U.S.C. §1052(a)	2, 3, 5, 6, 9, 16, 17, 18
TMEP Rule 710.01(b)	11, 14
37 C.F.R. 2.56(b)(2)	15

PRELIMINARY STATEMENT

This is not yet another case of a member of an ethnic group seeking registration of a supposedly offensive slur on the ground that group members, or he in particular, have “embraced” the term. This is something far more serious, and implicates the subversion 15 U.S.C. §1052(a) and the policy underlying it. This is an Ex Parte Appeal of trademark explicitly refused registration on the basis of Applicant’s race.

The perverse outcome described arose from an application process rife with serious legal and procedural deficiencies. Applicant Simon Shiao Tam, founder of a band called The Slants, filed the Application that is the subject of this Ex Parte Appeal, seeking registration of THE SLANTS for “entertainment in the nature of live performances by a musical band” on November 14, 2011. The Examining Attorney refused registration, stating initially that the “likely meaning” of “THE SLANTS” was as “a negative term regarding the shape of the eyes of certain persons of Asian descent,” citing sources indicating that the word can refer to “persons of Asian descent . . . in a disparaging manner.” The Examining Attorney found that the mark, of which the dominant feature is the ordinary English word “slant,” “is an inherently offensive term.”

In a subsequent office action, however, the Examining Attorney implicitly acknowledged that the refusal was based not, or not only, on the implausible characterization of the word “slant” as inherently offensive. In that office action, the Examining Attorney addressed Applicant’s argument that, absent adequate proof of inherent offensiveness, the Application provided no basis for the “association” between the word “slant” and the Asian community. Referring to his own Internet research, the Examining Attorney explained that the association was unavoidable because “applicant is a founding member of a band (The Slants) that is self described as being composed of members of Asian descent.” It followed, therefore, that “the association of the term SLANTS with those of Asian descent is evidenced by how Applicant uses the mark – as the name of an all Asian-American band” of which he, an Asian, is a member.

The Examining Attorney’s rationale turned the entire policy justification for Section 2(a) on its head. It was a refusal to register based on the ethnic background of Applicant and his associates that was offensive. Unless reversed by the Board this formulation inevitably will involve the Patent and Trademark Office in inappropriate and constitutionally suspect inquiries concerning the ethnicity of applicants, their associates and their activities. Given this failure of proof and misapplication of law, the evidentiary record does not support the PTO’s conclusions that the Application for registration of THE SLANTS should be denied. The Board should reverse that determination.

DESCRIPTION OF RECORD

A. PROSECUTION HISTORY

The Application was initially refused on January 6, 2012 via a nonfinal office action (the “January 2012 Office Action”) on the ground that the mark THE SLANTS consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols pursuant to 15 U.S.C. §1052(a). Specifically the Examining Attorney asserted that “slants” is a derogatory term used to refer to Asian persons. Applicant filed a response to the January 2012 Office Action on May 29, 2012. A final office action refusing registration issued on June 20, 2012 (the “June 2012 Office Action”). Applicant sought reconsideration via a submission dated December 10, 2012, on which date Applicant also filed a Notice of Appeal. Reconsideration was refused on December 20, 2012.

B. EXAMINING ATTORNEY’S EVIDENCE

The Examining Attorney appended 162 attachments to the January 2012 Office Action. These consist of newspaper and magazine articles, excerpts from reference works and screen shots from Internet websites. Most are not referred to specifically in the Office Action. Many of the articles address the use of the term “slant eyes,” as opposed to “slants,” as an ethnic slur referring to Asians. A number of the exhibits concern controversies erupting over photographs of prominent people in which they are seen pulling on the skin around their eyes to simulate so-called “slanted eyes” in a childish simulation of Asian features. A large portion of the pages attached consist of online discussion groups and magazine articles in which the Applicant and others express

their personal opinions about the use of THE SLANTS by Applicant's musical band, The Slants. Another portion consists of Google Books search results yielded by searching for the phrase "SLANTS DEROGATORY" as well as photocopies of works by which the same "result" was obtained by virtue of selecting books that listed "derogatory" terms and slurs.

No additional evidence was attached to the June 2012 Office Action.

C. APPLICANT'S EVIDENCE

In his May 29, 2012 response to the first office action, Applicant included a full screen shot from the American Heritage dictionary excerpted by the Examining Attorney, showing the full range of definitions. He also analyzed the specimens submitted with the Application closely. He also included as an exhibit five exemplary registrations of the word SLANT allowed since 2008, as set out in the margin.¹ A second exhibit was a printout from the Internet version of the Oxford English Dictionary entry for the word "slant."

¹ These include, for example, the following (attached to the January 2012 Office Action as Exhibit B); there are many more in addition to these:

- SLANTS, Serial Number 85269787 (ITU), published for opposition August 2, 2011
- SLANT, Registration Number 4123704 dated April 10, 2012
- SLANT, Registration Number 3894536 dated December 21, 2010
- SLANT, Registration Number 3437238 dated May 27, 2008
- SLANT, Registration Number 3437230 dated May 27, 2008

ARGUMENT

I. LEGAL STANDARD

When considering a “disparagement” refusal under Section 2(a), the primary question is “What is the likely meaning of the matter in question . . .” in light of the circumstances. *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264 (TTAB 2006). A mark may be “inherently” disparaging or offensive, as in *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d 1635, 1640 (TTAB 1988) (mark depicting a defecating dog) or may be disparaging only in a given context, i.e., by being applied or combined in a way that is offensive to the disparaged party. *See, e.g., In re Anti-Communist World Freedom Cong., Inc.*, 161 U.S.P.Q. 304, 305 (TTAB 1969).

The January 2012 Office Action fails to present a legitimate legal or factual basis to refuse this Application for THE SLANTS because it neither demonstrates that the use of the same word as a trademark for “entertainment in the nature of live performances by a musical band” is inherently disparaging, nor that any other matter found in the Application provides a basis for the Examining Attorney’s conclusion regarding the mark’s “likely meaning.” As set out below, lacking either legal precedent or a factual basis on which to find that the general “likely meaning” of THE SLANTS is derogatory one, the January 2012 Office Action effects a novel, and offensive, *ad hominem* prohibition against registration by this Applicant – a rule that Simon Shiao Tam is different from numerous other non-Asians whose “slant” registrations have been allowed.

II. THE PTO FAILED TO ESTABLISH A LEGAL OR EVIDENTIARY BASIS FOR FINDING THAT APPLICANT’S STANDARD CHARACTER MARK “THE SLANTS” IS DISPARAGING.

When determining whether a trademark submitted for registration is offensive or disparaging, the Patent and Trademark Office (“PTO”) must establish what “the **likely meaning** of the matter in question . . . **not only** dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods and/or services, and the manner in which the mark is used in the marketplace” based on “on applicant's identified goods and services.” *Squaw Valley Dev. Co., supra* (emphasis added). The instruction in *Squaw Valley* that dictionary definitions are **relevant** to the inquiry concerning disparagement, but **not dispositive**, leads to two corollaries: (1) where the dictionary definition does not, by itself, support a finding of disparagement, that fact standing alone favors Applicant; and (2) if a dictionary, or even the full scope of sources set forth in *Squaw Valley*, suggest that the trademark is amenable to multiple meanings, the burden is on the PTO to demonstrate why one meaning and not another is the likely meaning.

“Slants,” of course, is a common English word. It is the dominant portion of numerous trademark registrations placed into evidence by Applicant. Considering these facts, the Examining Attorney should have based his refusal on well-established legal grounds and a firm factual footing. As shown below, however, no such showing was made here, either in response to Applicant’s submissions or otherwise.

A. The Examining Attorney failed to cite any precedent demonstrating that a plain English word such as “slant” can be inherently disparaging.

The January 2012 Office Action declared THE SLANTS was “an inherently offensive term.” As shown by Applicant in his responses to the January 2012 Office Action, however, the word “slant,” in singular or plural form, is the dominant portion of numerous registrations, many of them quite recent, as set out in Footnote 1 *supra*. While PTO decisions respecting registration are not precedential, these registrations demonstrate a proposition that should be uncontroversial, namely that, unlike inherently offensive slurs such as HEEB, SQUAW or REDSKIN, “slant” is not inherently offensive.

Yet in each case cited by the Examining Attorney the January 2012 Office Action, the subject was a trademark, unlike THE SLANTS, whose meanings – based either on their sole or dominant definitions – were inherently offensive, or where facts evident in the applications provided a ground for a juxtaposition between the mark and its use that could only be disparaging. Thus in *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215 (TTAB 2010), the subject trademark was KHORAN, for use with alcoholic beverages forbidden to Muslims who follow the Koran. There was no neutral interpretation of the mark in juxtaposition with the use. *In re Anti-Communist World Freedom Cong., Inc.*, 161 U.S.P.Q. 304, *supra*, concerned disparagement of a “national symbol,” the hammer-and-sickle symbol of the Soviet Union and the Communist Party, whose meaning was amenable only to those associations. *In re Heeb Media LLC*, 89 U.S.P.Q.2d 1071 (TTAB 2008) concerned the trademark HEEB, an antiquated slur referring to Jews having no other meaning. The trademark in *In re Squaw Valley Dev. Co.* was SQUAW, an inherently offensive term referring to a female American Indian and meaning nothing

else. And *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705 (TTAB 1999) involved the use of the mark REDSKINS, also regarded as demeaning by American Indians and also lacking any definition other than as a description of that ethnic group.

Not one of the decisions cited by the PTO in either of its Office Actions involved denial of registration for a plain English word, such as “slants,” that only **could, but need not**, have a disparaging connotation and hence could not be inherently offensive. Each one of them involved a trademark that could only be offensive based on the four corners of the application – where the mark itself (i.e., the word or term), the description or the specimens demonstrated a disparaging use. Extending the holdings of these cases to a situation such as presented by this Application – where registration sought is for a standard English word having multiple meanings, and where nothing in the Application provides an evidentiary basis for an unsavory association – would constitute a significant and unwarranted extension of 15 U.S.C. §1052(a), as set out in detail below.

B. The Examining Attorney’s Internet research failed to demonstrate that the English word “slant” is in general an offensive or derogatory term.

In the January 2012 Office Action, the Examining Attorney relied on what he described as “dictionary definitions” to support his contention that the likely meaning of THE SLANTS is as “a negative term regarding the shape of the eyes of certain persons of Asian descent” and “an inherently offensive term that has a long history of being used to deride and mock a physical feature of those individuals.” But the Examining Attorney failed to heed the guidance of Rule 710.01 in the January 2012 Office Action, which states, “In appropriate cases, the examining attorney may . . . present evidence that may appear contrary to the USPTO’s position, with an appropriate explanation as to why this

evidence was not considered controlling.” The Examining Attorney, however, chose the fourth, or, arguably, the sixth definition of the word “slants” given by the *American Heritage Dictionary* – a dictionary on which he relied – while providing no explanation of the obvious question: Why the prior five entries were not controlling or even worthy of consideration, especially considering that the *American Heritage Dictionary* itself states that “Entries containing more than one sense are arranged for the convenience of the reader **with the central and often the most commonly sought meaning first.**”² A copy of the “slant” entry in the very dictionary relied upon by the Examining Attorney was submitted in response to the Office Action, and is quoted in relevant part (i.e., with respect to the word’s definition as a noun) below:³

SLANT

n.

1. **a.** A line, plane, course, or direction that is other than perpendicular or horizontal; a slope.
b. A sloping thing or piece of ground.
2. Printing A virgule.
3. **a.** A personal point of view or opinion: an article with an unconventional slant.
b. A bias: an anti-religious slant.
4. Offensive Slang Used as a disparaging term for a person of East Asian birth or ancestry.

Neither office action explains the omission of the “central and most common meaning” of the word “slant” above. The June 2012 Office Action did not even acknowledge the nine non-disparaging definitions of “slant” in the *Oxford English Dictionary* submitted

² The American Heritage Dictionary of the English Language website, found at http://ahdictionary.com/word/how_touse.html, last visited May 2, 2012. (Emphasis added.)

³ “Slant” in *The American Heritage Dictionary of the English Language*, found at <http://ahdictionary.com/word/search.html?q=slant&submit.x=0&submit.y=0>, last visited May 2, 2012.

by Applicant,⁴ much less explain how a finding of inherent offensiveness could plausibly withstand such evidence. The reason for the Examining Attorney's refusal to so much as admit the existence of non-derogatory definitions for the common word "slant" is not hard to divine. Doing so would subvert the baseless and nonsensical finding that the word "slant" is "inherently offensive."

Seeking to overcome this flaw with sheer volume, the January 2012 Office Action quoted and appended the results of what purported to be an extensive inquiry regarding the word "slants" in various published works. But as explained below, few of these sources are either dictionaries or even conventional reference works. For example, one book relied on by the Office Action, *The Color of Words: An Encyclopaedic Dictionary of Ethnic Bias in the United States*, is described as a "dictionary **of terms associated with racial discrimination.**"⁵ The Examining Attorney's reliance on such a compendium here, however, constitutes a "converse error," also known as the logical fallacy of "affirming the consequent." Much as a censor will inevitably "confirm" his own prurient interests if he peruses suspect material imaginatively enough,⁶ "proofs" brought from works such as *The Color of Words* will, axiomatically, support almost any pre-existing suspicion that a word may have **some** derogatory meaning. But they provide no guidance about – and certainly not proof of – what the Examining Attorney was actually charged to ascertain: whether a mark's **likely meaning, given the full range of possibilities**, is

⁴ See, e.g., the *Oxford English Dictionary*, reproduced as Exh. A to Applicant's Response to the January 2012 Office Action, showing the ethnic-slang definition of "slant" as the **tenth** out of ten definitions.

⁵ *Library Journal*, quoted by Amazon.com at the entry for the work found at <http://www.amazon.com/The-Color-Words-Encyclopaedic-Dictionary/dp/1877864420>, last visited May 2, 2012.

⁶ The humorist Dick Cavett is quoted as saying, specifically, "Censorship feeds the dirty mind more than the four-letter word itself."

disparaging. The full scope of this fallacy is demonstrated by the pages and pages of excerpts from Google Books search results returned by inputting the words “slant” and “derogatory.” This was an exercise guaranteed to “prove” of the desired outcome, but ultimately it provides no support for the finding of inherent offensiveness asserted as the ground for refusal.

In any event, the limited usefulness, as best, of the lists and sources relied on by the Examining Attorney is demonstrated by the most casual inspection of their contents. For example, The January 2012 Office Action relies in part on an anonymous website called the “Racial Slurs Database” found at <http://gyral.blackshell.com/names.html>. Examining that list “proves” that, along with “slants,” the following English words are also “disparaging” and presumably not eligible for trademark registration:

- Apple
- Banana
- Cans
- Beanie
- Brother
- Bumblebee
- Cabdriver
- Canal

These are just a few examples of entries, starting with the letters “A” and proceeding only through “C,” found in the work relied on by the Examining Attorney as a definitive dictionary of slurs and proof that “slant” is an inherently offensive word. Similarly, the Wikipedia entry referred to in the January 2012 Office Action lists the words “ape,” “brownie,” “crow,” “gin,” “shine,” “spade,” “tiger” and “Yankee.”⁷ These lists are not “dictionary definitions,” and have little or no bearing at all on the serious legal question of whether the “likely meaning” of a given word is disparaging or offensive.

⁷ Wikipedia, “List of Ethnic Slurs,” found at http://en.wikipedia.org/wiki/List_of_ethnic_slurs, last visited February 19, 2013.

Ultimately, the PTO erred here by disregarding the TMEP Rule that advises careful, balanced explanations when quoting dictionaries. Nor did the reams of “bad word” lists appended to the January 2012 Office Action constitute meaningful evidence of the **likely** meaning of the word to any particular group or anyone in general. For these reasons, the PTO failed to provide an evidentiary basis for its finding that THE SLANTS, when used in connection with a band providing musical performances, is inherently offensive.

III. THE EXAMINING ATTORNEY ERRED IN FINDING THAT USE OF THE MARK BY APPLICANT, AN ASIAN, CONSTITUTED DISPARAGING USE OF THE MARK IN ASSOCIATION WITH ASIANS.

To justify refusal to register a trademark under the first clause of section 1052(a), the PTO must, in addition to weighing the factors set forth in the last quotation, “consider the mark in the context of the marketplace as applied to only the goods described in [the] application for registration.” *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994). And while there is no question that an examining attorney may refer to outside materials for purposes of assessing whether a mark suspected of being disparaging is regarded as such by the affected group, it is not the PTO’s practice, nor should it be, to conduct a “disparagement search” on every application for a trademark registration. *See also, In Re Hershey*, 6 U.S.P.Q.2d 1470 (TTAB 1988) (focusing analysis on specimens); *In re Bose Corporation*, 192 U.S.P.Q. 213 (CCPA 1976) (“an application for registration must be adjudged in light of the specimens of record”).

While TMEP Rule 710.01(b) provides that “Articles downloaded from the Internet are admissible as evidence of information available to the general public, and of

the way in which a term is being used by the public,” such research has only been found probative on the questions of (a) whether a mark is used descriptively or (b) whether a mark identified as potentially disparaging is so perceived by the subject group as a general proposition. That Rule also provides that “The examining attorney must check applicant's own website for information about the goods/services,” but neither office action included excerpts from The Slants’ own website. All the material evidencing Applicant’s supposed use of the mark was dated from 2010 or earlier – at least a year prior to the date of the Application.

Despite the haphazard nature of the research on which he relied, the Examining Attorney’s stated in the June 2012 Office Action that his Internet dossier about Applicant was an appropriate evidentiary exercise because it provided what he deemed an accurate picture of Applicant’s ethnically-oriented use of the mark.. “To hold otherwise would be to allow the clever construction of an application to avoid a disparaging finding, resulting in expensive opposition and cancellation proceedings by affected third[.]parties.”

But the Application was not refused registration on the ground of a failure of evidence under 37 C.F.R. 2.56(b)(2). As to the specimens, they are three advertisements for the band, none of which suggest a connection between the word “slant” and anything having to do with Asian people. No substitute specimen was requested by the Examining Attorney. This is not a case such as *In re Promo Ink*, 78 U.S.P.Q.2d 1301 (TTAB 2006), where the applicant argued unsuccessfully that the examining attorney improperly “created a specimen” for an Intent to Use application, which requires no specimen at all. The situation here is, at best, akin to that in *In re Reed Elsevier Properties*, 82

U.S.P.Q.2d 1378 (Fed. Cir. 2007), where research into an applicant's use was justified as defining "the genus of services at issue" for purposes of evaluating descriptiveness.

Here, however, the only "genus" relevant to the refusal here is ethnicity. And as addressed more fully below, while such an inquiry would technically correspond to the stated basis of the PTO's refusal, it would have been patently offensive and unlawful. Ultimately, as set forth above the evidentiary basis on which the Examining Attorney did make his decision was flawed in numerous respects, and constituted error.

IV. THE REFUSAL OF REGISTRATION WAS BASED IMPROPERLY ON THE IDENTITY AND ETHNIC BACKGROUND OF APPLICANT.

Disregarding the analysis submitted by Applicant in response to the January 2012 Office Action, the June 2012 Office Action frankly enunciated the real, and troubling, ground for the PTO's refusal to register as follows:

Here, the evidence is uncontested that applicant is a founding member of a band (The Slants) that is self described as being composed of **members of Asian descent**. . . . Thus, **the association of the term SLANTS with those of Asian descent** is evidenced by how Applicant uses the mark – **as the name of an all Asian-American band**. Further, applicant (and his fellow band members) has repeatedly indicated that the name THE SLANTS is in fact a direct reference to the derogatory meaning of the term and in fact, they are embracing the derogatory meaning of the term. One of the members of the band is quoted as stating . . .

[FN 1] Notably, this is not applicant's first time before the United States Patent and Trademark Office seeking registration of the mark THE SLANTS for live musical performances. . . .

June 2012 Office Action at 2 (emphasis added). These excerpts unmasked an implied admission that while the Application provides no grounds for a 2(a) refusal, **this particular** Applicant would not be allowed not register THE SLANTS as a trademark

because it refers to him, a person of “Asian descent,” along with his “all Asian-American band.” Use of this trademark by these people, according to the Office Action, constituted a perpetual, ubiquitous “derogatory association” with themselves.

These grounds for refusal constituted error at least two reasons, discussed below:

(1) They improperly condition registration on the ethnic background of an applicant, and
(2) they amount to an unprecedented prohibition against registration by a particular individual or group of people because of their past use of a mark.

A. The refusal of registration here was improperly tied by the PTO to the ethnic background of Applicant.

The refusal here was explicitly, and improperly, premised on the ethnic identity of Applicant and the other members of his band. “Here,” wrote the Examining Attorney, explaining the “association” between the mark and the Asian community, “applicant is a founding member of a band . . . composed of members of Asian descent. . . . [The] association of the term SLANTS with those of Asian descent is evidenced by how Applicant uses the mark – as the name of an all Asian-American band.”

By the Examining Attorney’s logic, the same exact application submitted by a non-Asian would be entitled to registration. THE SLANTS, the PTO admits, is not inherently offensive, as, for example, HEEB and SQUAW are. THE SLANTS could be registered as a trademark – **just not by Asians**. It should go without saying that the law does not support refusal of registration based on the ethnic descent of an applicant, such as occurred here.

Indeed, it is no less troubling that the Examining Attorney noted that there was no “rebuttal” to his assertion that The Slants were an “all Asian-American” band. The only

possible “rebuttal” would have been a submission proving that the band was **not** entirely Asian and hence entitled to registration, a patently offensive proposition. In any case, the standard to which such “evidence,” if submitted, would have been applied is unclear, for the Lanham Act is silent as to how many Asian members of The Slants would need to be fired from the band to avoid offending Asians by registration of this trademark.

B. The refusal of registration here was improperly tied by the PTO to the personal identity and application history of the Applicant.

Besides suggesting racial definitions redolent of laws from other times and places rather than the criteria typically associated with our law of trademarks and unfair competition, the PTO’s stated grounds of refusal to register this Application raise a less dramatic, but still problematic, traditional, legal concern: It amounts to a prohibition against registration, for which there is no legal basis, dependent on the identity of the person, rather than the content of the application. Again quoting the June 2012 Office Action, “Notably, this is not applicant’s first time before the United States Patent and Trademark Office seeking registration of the mark THE SLANTS for live musical performances. . . .” Under the Examining Attorney’s rationale, **no** application by Applicant for THE SLANTS could ever overcome the “stain” of his past use of that mark in connection with an “all Asian-American band.”

There is no legal basis for such an outcome, however. A person applying to register a trademark facially similar to an application by him that was previously refused is not barred by *res judicata* concerning a new, different application. *See, Sheffield-King Milling Co. v. Theopold-Reid Co.*, 269 F. 716 (D.C. Cir. 1921). Indeed it is less the

asserted sameness of the mark in the two applications on which the Examining Attorney relies in refusing registration; it is the sameness of Applicant.

As demonstrated in the foregoing sections, this refusal cannot have not based on a competent evidentiary record that THE SLANTS is inherently offensive or derogatory; the record is clear that “slant” is a word with multiple meanings, of which the ethnic slur on which the refusal is purportedly based is attenuated, to say the least. Nor does the Application itself provide such evidence. The refusal, rather, is based on who the Applicant is. It follows that if anyone else on earth – Asian or otherwise – submitted an application to register THE SLANTS that was identical to the Application here, registration would have been allowed. Concomitantly, Applicant could never register THE SLANTS no matter the content of the application.

This result would be a surprising and troubling reading of 15 U.S.C. §1052(a), and one that is not supported by law, policy or common sense. Neither the ethnic identity of Applicant, the extent to which he associates in his use of the mark with other Asians, the degree to which he makes use of his own cultural heritage, or his identity in any sense at all should be of relevance concerning registration of THE SLANTS as a trademark for “entertainment in the nature of live performances by a musical band.”

CONCLUSION

For all the foregoing reasons, Applicant respectfully submits that the Examining Attorney has failed to meet his burden to demonstrate that Applicant's mark THE SLANTS consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols pursuant to 15 U.S.C. §1052(a) and requests that the grant this Ex Parte Appeal and allow the registration of Applicant's mark THE SLANTS on the Principal Register.

Respectfully submitted,

GOETZ FITZPATRICK, LLP

By: 
Ronald D. Coleman

One Penn Plaza, 44th Floor
New York, New York 10119
(212) 695-8100
Attorneys for Applicant

Dated: February 19, 2013