

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

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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.¹ This was the genesis of the “moral utility” doctrine.²

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*.³ This doctrine was used *inter alia* to deny protection to devices that could be used to commit fraud or that were for gambling use.⁴ For many years, this doctrine served as a moral gatekeeper on patentable subject matter.⁵ However, American jurisprudence has drifted away from this theory, leaving the gate “untended.”⁶ In *Diamond v. Chakrabarty*,⁷ 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*,

¹ *Lowell v. Lewis*, 15 F. Cas. 1018, 1019 (C.C.D. Mass. 1817) (No. 8,568).

² Margo A. Bagley, *Patent First, Ask Questions Later: Morality and Biotechnology in Patent Law*, 45 WM. & MARY L. REV. 469, 476 (2003).

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).

Inc.,⁸ the Court of Appeals for the Federal Circuit pronounced the doctrine dead.⁹

In contrast, the European Patent Office (EPO) once took the position that morality and patentability were unrelated.¹⁰ 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.”¹¹ 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.¹²

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.”¹³ “Morality,” has a circular definition—“principles concerning the distinction between right and wrong or good and bad behavior.”¹⁴ Therefore, both of these terms are fluid—changing with cultures or the times.¹⁵

Despite the fluidity of the terms, many jurisdictions recognize exclusions as permitted by Art. 27.2.¹⁶ Article 53 of the European Patent Convention re-

⁸ 185 F.3d 1364 (Fed. Cir. 1999), *aff’d*, 292 F.3d 728 (Fed. Cir. 2002).

⁹ *Id.* at 1366–68.

¹⁰ See Margaret Llewelyn, *From GATT to G.A.T.T.: Fifty Years of European Bio-IP* (Part II), 6 *BIO-SCI. L. REV.* 142, 143 (2003/2004).

¹¹ Agreement on Trade-Related Aspects of Intellectual Property Rights art. 27(2), Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, http://www.wto.org/english/docs_e/legal_e/27-trips.pdf [hereinafter TRIPS]. See generally INTELLECTUAL PROPERTY AND INTERNATIONAL TRADE: THE TRIPS AGREEMENT (Carlos M. Correa & Abdulqawi A. Yusuf eds., 2d ed. 1998) [hereinafter IP & IT]; DANIEL GERVAIS, *THE TRIPS AGREEMENT: DRAFTING HISTORY AND ANALYSIS* 421 (4th ed. 2012).

¹² TRIPS, *supra* note 11, at 331.

¹³ UNITED NATIONS CONFERENCE ON TRADE AND DEV. & INT’L CTR. FOR TRADE AND SUSTAINABLE DEV., *RESOURCE BOOK ON TRIPS AND DEVELOPMENT* 375 (2005).

¹⁴ *Definition of Morality in English*, OXFORD DICTIONARY. http://www.oxforddictionaries.com/us/definition/american_english/morality (last visited Sept. 12, 2015).

¹⁵ TRIPS is often seen as protecting intellectual property rights as a means to promote freedom of trade, rather than ends themselves, but still intellectual property policy often accounts for trade and non-trade factors when crafting intellectual property rights protection. See Marco Ricolfi, *Is There an Antitrust Antidote Against IP Overprotection Within TRIPS?*, 10 *MARQ. INTELL. PROP. L. REV.* 305, 326 (2006).

¹⁶ See M. Bruce Harper, *TRIPS Article 27.2: An Argument for Caution*, 21 *WM. & MARY ENVTL. L. & POL’Y REV.* 381, 414–15 (1997). See also Chris R. Byrnes, *Patenting Life?*

quires that patents not be granted if the patent is contrary to public order or morality.¹⁷ 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.¹⁸ 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.¹⁹

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.²⁰

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*,²¹ we must consider whether the granting of a patent is likely to encourage activity that is deemed to offend universal values.²² 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

TRIPS Article 27 & Bolivia's Proposal to Ban the Patenting of All Life Forms, 24 GEO. INT'L ENVTL. L. REV. 245, 254 (2012).

¹⁷ Harper, *supra* note 16, at 415. For example, the Norwegian Patent Act prohibits granting patents when “their commercial exploitation would be contrary to ordre 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).

¹⁸ Directive 98/44/EC, of the European Parliament and of the Council of 6 July 1998 on the Legal Protection of Biotechnological Inventions, 1998 O.J. (L213) 13, 16. *See also* Case C-34/10, *Brüstle v Greenpeace*, 2011 E.C.R. I-9849.

¹⁹ *Harvard Coll. v. Canada*, [2002] 4 S.C.R. 45, 47 (Can.).

²⁰ For example, the concept of denying patents on inventions that are contrary to “human dignity” finds support in the Universal Declaration on Bioethics and Human Rights. U.N. Educ., Sci. & Cultural Org. [UNESCO], *Universal Declaration on Bioethics and Human Rights*, General Conference Res. 36, at 28, UNESCO Doc. 33 C/Res. 36 (Oct. 19, 2005), <http://unesdoc.unesco.org/images/0014/001428/142825e.pdf>. Furthermore, the United Nations General assembly adopted the United Nations’ declaration on human cloning by a vote of 84-34-37. *See generally* Press Release, General Assembly, General Assembly Adopts United Nations Declaration on Human Cloning by Vote of 84-34-37, U.N. Press Release GA/10333 (Mar. 8, 2005), <http://www.un.org/press/ed/2005/ga10333.doc.htm>.

²¹ *See* *Diamond v. Chakrabarty*, 447 U.S. 303, 307 (1980) (noting that patent law offers “inventors exclusive rights for a limited period as an incentive for their inventiveness and research efforts”). *See also*, WILLIAM D. NORDHAUS, *INVENTION, GROWTH, AND WELFARE: A THEORETICAL TREATMENT OF TECHNOLOGICAL CHANGE* 16–17 (1969).

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 . . .”).

²⁴ See Berne Convention for the Protection of Literary and Artistic Works art. 2, Sept. 9, 1886, S. Treaty Doc. 99-27 [hereinafter Berne Convention], www.wipo.int/wipolex/en/treaties/text.jsp?file_id=283693.

²⁵ See TRIPS, *supra* note 11, at art. 15; Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, 13 U.S.T. 2, 828 U.N.T.S. 305, art. 6*quinquies* [hereinafter Paris Convention], http://www.wipo.int/edocs/lexdocs/treaties/en/paris/trt_paris_001en.pdf. See also CARLOS M. CORREA, TRADE RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS: A COMMENTARY ON THE TRIPS AGREEMENT 174–75 (2007). See generally GERVAIS, *supra* note 11; IP & IT, *supra* note 11; 1 STEPHEN P. LADAS, PATENTS, TRADEMARKS AND RELATED RIGHTS: NATIONAL AND INTERNATIONAL PROTECTION § 47, at 66 (1975); 2 STEPHEN P. LADAS, PATENTS, TRADEMARKS AND RELATED RIGHTS: NATIONAL AND INTERNATIONAL PROTECTION § 565, at 970 (1975).

²⁶ Paris Convention, *supra* note 25, art. 6*quinquies* (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.”²⁷ But, Canadian courts have not yet defined these terms. Therefore, Canadian trademark examiners²⁸ tend to look to British or American decisions for guidance.²⁹ 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,³⁰ 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.”³¹ 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.³² However, Australia recognizes that such definitions change over time, and that what was once offensive can be part of to-

²⁷ 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 INTELLECTUAL 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.*

²⁸ 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).

²⁹ 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](https://www.uspto.gov/Pages/PEPositions) (last visited Sept. 19, 2015).

³⁰ 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 1995* s 42.

³² IP AUSTRALIA: TRADE MARKS OFFICE MANUAL OF PRACTICE AND PROCEDURE pt. 30(2)(1) (2015), http://www.ipaustralia.gov.au/pdfs/trademarkmanual/trade_marks_examiners_manual.htm.

day's lexicon.³³ In a 2012 decision, a mark owner prevailed in its argument that Section 42 does not prohibit the mark "Nuckin Futs."³⁴ 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."³⁵

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."³⁶

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."³⁷ 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.³⁸ In the "SCREW YOU" case, an applicant sought protection for a trademark for a range of goods including sunglasses, hats, liquor, and sex toys.³⁹ 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 appeals⁴⁰ noted that when the relevant marketplace is a sex shop, for example,

³³ *Id.*

³⁴ See generally *NUCKIN FUTS – 1408134*, INTELL. PROP. AUSTRALIA, <http://www.ipaustralia.com.au/applicant/universal-trading-australia-pty-ltd-as-trustee-for/trademarks/1408134/> (last visited Sept. 19, 2015).

³⁵ Richard Shears, *Australian Firm Wins Right to Call Itself Nuckin Futs Despite Outrage*, DAILY MAIL.COM, <http://www.dailymail.co.uk/news/article-2088271/Australian-firm-wins-right-Nuckin-Futs.html> (last updated Jan. 18, 2012).

³⁶ U.S. Trademark Application Serial No. 78680513, Office Action Outgoing Mar. 17, 2008 (refusing registration of Trademark FUCKINGMACHINES).

³⁷ Case R 495/2005-G, Application of Kenneth (trading as Screw You), [2007] E.T.M.R. 7, ¶ 14 (Office for Harmonization in the Internal Market (Grand Board) July 6, 2006).

³⁸ See *Id.* ¶ 11.

³⁹ See *Id.* ¶ 1.

⁴⁰ See Commission Regulation 216/96 of 5 Feb. 1996 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market, 1996 O.J. (L 28) 11, amended by Commission Regulation 2082/2004 of 6 Dec. 2004, art 1(a), 2004 O.J. (L 360) 8 (EC). See also *Boards of Appeal*, OFF. FOR HARMONIZATION INTERNAL MKT., <https://oami.europa.eu/ohimportal/en/boards-of-appeal> (last visited Sept. 19, 2015) ("The Grand Board consists of nine members, comprising the President of the Boards of Appeal as

the marketplace would not feel scandalized, and therefore the mark could be registered for products sold in this chain of commerce.⁴¹

More importantly, however, The Grand Board recognized that there were expressive elements to a trademark, and freedom of expression principles must be considered.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.

....

... [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.⁴³

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

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; . . . giving offense to the conscience or moral feelings; . . . [or] calling out [for] condemnation.”⁴⁴

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 Presidium may refer a case to the Grand Board.”).

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

⁴² *Id.* ¶¶ 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. See *infra* Part II.B.

⁴³ *Id.* ¶¶ 15, 24.

⁴⁴ *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994) (alteration in original) (quoting *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.’”⁴⁵ 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.⁴⁶ 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.⁴⁷ 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.⁴⁸ 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.⁴⁹ This view was later supported by the Federal Circuit.⁵⁰

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.”⁵¹ 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.⁵² 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).

⁴⁵ *In re Wilcher Corp.*, 1996 WL 725479, at *1 (citations omitted) (quoting *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981) and *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1219 (T.T.A.B. 1993)).

⁴⁶ Case R 495/2005-G, Application of Kenneth (trading as Screw You), [2007] E.T.M.R. 7, ¶ 11.

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.

⁴⁸ *In re RK Netmedia, Inc.*, No. 77060742, 2009 TTAB LEXIS 389, at *4 (T.T.A.B. 2009).

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).

⁵² *See In re Engine 15 Brewing Co., LLC*, No. 86038803, at 8–9 (T.T.A.B. 2015) (non-precedential), <http://e-foia.uspto.gov/Foia/RetrievePdf?system=TTABIS&fNm=86038803-10-29-2015>.

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.”⁵³ 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.⁵⁴

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.⁵⁵

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,⁵⁶ 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

⁵³ *Id.* at 10.

⁵⁴ Case R 495/2005-G, Application of Kenneth (trading as Screw You), [2007] E.T.M.R. 7, ¶ 15.

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 ‘gray 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.

⁵⁶ *In re Tam*, No. 2014-1203, 2015 U.S. App. LEXIS 22593 (Fed. Cir. Dec. 22, 2015).

consisted of Asian Americans, and “slant” could be an ethnic slur to insult Asians.⁵⁷

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 [F]irst [A]mendment rights.”⁵⁸

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.⁵⁹ 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,⁶⁰ 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.⁶¹ 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.⁶² Trademark registration is designed to pro-

⁵⁷ The author filed a brief of amicus curiae on behalf of the First Amendment Lawyers Association (FALA) urging the Federal Circuit to overturn the section 2(a) scheme. Brief of First Amendment Lawyers Association as Amicus Curiae in Support of Simon Shiao Tam, *In re Tam*, 785 F.3d 567 (2015) (No. 2014-1203), 2015 WL 3970275.

⁵⁸ *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)).

⁵⁹ See *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981).

⁶⁰ See, e.g., *Marc Randazza Comments on CAFC “Cork Soaker” Decision*, TTABLOG, (Dec. 20 2012), <http://thettablog.blogspot.com/2012/12/marc-randazza-comments-on-cafc-cork.html>.

⁶¹ *In re Tam*, 2015 U.S. App. LEXIS 22593, at *39 (discussing the unconstitutional conditions doctrine).

⁶² See *Rumsfeld v. Forum for Academic & Institutional Rights*, 547 U.S. 47, 59 (2006); *Doyle v. Continental Ins. Co.*, 94 U.S. 535, 543 (1876) (Bradley, J., dissenting); *Home Ins. Co. of New York v. Morse*, 87 U.S. 445, 451 (1871).

vide government benefits to trademark registrants.⁶³ As a viewpoint-based restriction on protected speech, Section 2(a) violates this doctrine.⁶⁴

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*.⁶⁵

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.⁶⁶

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.⁶⁷ 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.⁶⁸ 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.⁶⁹ 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-

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.

⁶⁸ *In re Giorgio S.R.L.*, No. 79141996, 2015 TTAB LEXIS 386, at *3 (T.T.A.B. 2015).

⁶⁹ *Pro-Football, Inc. v. Blackhorse*, No. 1:14-cv-01043-GBL-IDD, 2015 U.S. Dist. LEXIS 90091 (E.D. Va. Jul. 8, 2015) (lower court decision up on appeal to Fourth Circuit).

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 thus subject to First Amendment protection.⁷⁰ Trademarks convey messages about the type, cost, and quality of the product or service associated with the mark.⁷¹ 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.⁷²

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.⁷³ 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-

⁷⁰ *In re Tam*, 2015 U.S. App. LEXIS 22593, at *30 (citing *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 765 (1976)).

⁷¹ *Friedman v. Rogers*, 440 U.S. 1, 11 (1979).

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.

"[M]inimal information, conveyed in the context of a proposal of a commercial transaction, suffices to invoke the protections for commercial speech, articulated in *Central Hudson*." *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).

⁷³ *Bad Frog Brewery, Inc.*, 134 F.3d at 87.

tecting children from vulgarity or promoting temperance.⁷⁴ Nor was the prohibition narrowly tailored to serve that purpose.⁷⁵ 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,”⁷⁶ 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.⁷⁷

This provision is subject, however, to the application of Article *10bis*.⁷⁸ 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.”⁷⁹ 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.⁸⁰ 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.

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).

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 “[the] 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 trade mark.”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 6*quinquies* 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 6*quinquies* prohibitions “are not motivated by the fact that

⁸¹ See *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012); *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994); See also Ghazilian’s Application [2002] E.T.M.R. 57, ¶ 18 (Lord Chancellor’s Appointed Person) (Nov. 28, 2001); Masterman’s Design Application, [1991] R.P.C. 89, 91 (In the Registered Designs Appeal Tribunal) (June 27, 1991).

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.

⁸⁶ Alberto Alemanno & Enrico Bonadio, *Do You Mind My Smoking? Plain Packaging of Cigarettes Under the TRIPS Agreement*, 10 J. MARSHALL REV. INTELL. PROP. L. 450, 467 (2011).

⁸⁷ *Id.*

the registration itself would be problematic, but rather that the use of the trade mark would be.”⁸⁸

This dichotomy between registration and use seems false, however, when examined in the opposite direction. As noted above, despite the flexibility provided in Article 6*quinquies*, Article 10*bis* contains no similar flexibility. Rather, the latter article obligates member states to provide for enforcement of rights, as to prohibit unfair competition.⁸⁹ 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 morality 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 6*quinquies* 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 enacted provisions in their own trademark acts, which simply grab ahold of the word “morality” and run from there.⁹⁰

D. Free Expression and Human Rights Concerns

The majority of the literature examining trademark rights and free speech examines the negative effect that over-zealous protection of trademark rights can have on free speech principles.⁹¹ However, there is little examination of

⁸⁸ *Id.* at 470.

⁸⁹ See Paris Convention, *supra* note 25, at art. 10*bis*.

⁹⁰ 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 Regulations (CTMR). 15 U.S.C. § 1052(a) (2012); Council Regulation 207/2009 of 26 Feb. 2009 on the Community Trade Mark, art. 7(1)(f), 2009 O.J. (L78) 1, 3 (EC).

⁹¹ See generally DAVID BOLLIER, BRAND NAME BULLIES: THE QUEST TO OWN AND CONTROL CULTURE (2005); KEMBREW 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.⁹² 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.⁹³ Thus, any derogation of that right requires justification under Article 10(2).⁹⁴

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.”⁹⁵ 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.⁹⁶ However, at least one commentator has examined the issue and found that there is no infringement of Article 10 rights.⁹⁷

L. REV. 397 (1990); Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960 (1993); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687 (1999); Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 YALE L.J. 1717 (1999).

⁹² 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).

⁹³ See, e.g., Enrico Bonadio, *Brands, Morality and Public Policy: Some Reflections on the Ban on Registration of Controversial Trademarks*, 19 MARQ. INTELL. PROP. L. REV. 39, 55, 59 (2015). See also *French Connection Ltd. v. Woodman* [2007] E.T.M.R. 8, ¶ 60 (Lord Chancellor’s Appointed Person) (May 17, 2006). See generally Burkhardt Goebel, *Trademarks As Fundamental Rights—Europe*, 99 TRADEMARK REP. 931 (2009).

⁹⁴ 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.

⁹⁵ See Jonathan Griffiths, *Is There a Right to an Immoral Trademark*, in INTELLECTUAL PROPERTY AND HUMAN RIGHTS, *supra* note 55, at 309, 327.

⁹⁶ Case R 495/2005-G, *Application of Kenneth (trading as Screw You)*, [2007] E.T.M.R. 7, ¶ 15 (Office for Harmonization in the Internal Market (Grand Board) July 6, 2006).

⁹⁷ 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*⁹⁸ 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.⁹⁹ The Lisbon Court of Appeal eventually ruled that the Portuguese intellectual property office should refuse to grant a registration of BUDWEISER as a trademark.¹⁰⁰ The Portuguese Supreme Court upheld the decision.¹⁰¹

The American company filed a case before the European Court of Human Rights¹⁰², 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 1.¹⁰³ 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 1.¹⁰⁴ Additionally, it recognized that Council Regulation¹⁰⁵ (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.”¹⁰⁶ Finally, the ECHR acknowledged that Article 17(2) of the Charter of Fundamental Rights guaranteed the right of property, including intellectual property.¹⁰⁷

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 1.¹⁰⁸ 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

⁹⁸ *Anheuser-Busch Inc. v. Portugal*, 45 Eur. Ct. H.R. 36, ¶¶ 66–68 (Grand Chamber 2007).

⁹⁹ *Id.* ¶ 14.

¹⁰⁰ *Id.* ¶ 22.

¹⁰¹ *Anheuser-Busch Inc. v. Portugal*, [2007] 44 Eur. Ct. H.R. 42, ¶ 16 (2005); *Anheuser-Busch Inc.*, 45 Eur. Ct. H.R. 36 at ¶ 24.

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.

¹⁰³ *See Anheuser-Busch Inc.*, 45 Eur. Ct. H.R. 36 at ¶ 46.

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).

¹⁰⁶ *Anheuser-Busch Inc.*, 45 Eur. Ct. H.R. 36 at ¶¶ 36–37.

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 1.¹⁰⁹ 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.¹¹⁰ 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."¹¹¹

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."¹¹² 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.¹¹³ Accordingly, the optimistic prediction is that the standards will merge to one that only rejects trademark pro-

¹⁰⁹ *Id.*

¹¹⁰ *See Id.* ¶ 87.

¹¹¹ Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(A) Trademark Law After Lawrence v. Texas*, 9 MARQ. INTELL. 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).

¹¹² ECHR, *supra* note 84.

¹¹³ 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 land 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.

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 EHCR 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.

¹¹⁸ *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154, 166 (2010).

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.”¹²⁰ 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.”¹²¹ Meanwhile, Continental Europe’s underpinnings of copyright law tend to be couched in “author’s rights.”

[P]ost 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.”¹²²

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.¹²³

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.¹²⁴ The first decision interpreting the act was *Burnett v. Chetwood*,¹²⁵ in which the plaintiff complained that the defendant copied his *Archaeological Philosophica*, which

tion for the purpose of enforcement, do have registration schemes. These voluntary registrations provide copyright owners with evidentiary presumptions, and are usually only a matter of filling out a form and then depositing a copy of the work. *Id.*

¹²⁰ Daniel J. Gervais, *Intellectual Property and Human Rights: Learning to Live Together*, in INTELLECTUAL PROPERTY AND HUMAN RIGHTS, note 48, at 3, 6.

¹²¹ JULIE E. COHEN ET AL., COPYRIGHT IN A GLOBAL INFORMATION ECONOMY 7 (2d ed. 2006).

¹²² Jane C. Ginsburg, *A Tale of Two Copyrights: Literary Property in Revolutionary France and America*, 64 TUL. L. REV. 991, 992 (1990).

¹²³ See generally Gervais, note 120.

¹²⁴ 8 Anne, c. 19 (1710) (Eng.).

¹²⁵ *Burnett v. Chetwood* (1721) 35 Eng. Rep. 1008; 2. Mer. 441.

was originally in Latin, and distributed it in English.¹²⁶ The Lord Chancellor agreed with the defense that a translation did not meet the statute's definition of unlawful copy.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."¹²⁸

This doctrine of judicial superintendency continued throughout the years. In *Southey v. Sherwood*, Lord Eldon refused to enjoin unlawful distribution of a libelous poem, "Wat Tyler."¹²⁹ He did the same in *Murray v. Benbow*, when confronted with a blasphemous work, ruling that no publication injurious to religion could find copyright protection.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.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.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.¹³³

In the twentieth century, the U.K. courts continued their superintendency, reaffirming the doctrine in *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.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

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).

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. *Chetwood*, 35 Eng. Rep. at 1009; 2 Mer. at 441.

¹²⁸ *Id.* at 1009; 2 Mer. at 441.

¹²⁹ *Southey v. Sherwood* (1817) 35 Eng. Rep. 1006, 1006, 1008; 2 Mer. 435, 435, 440.

¹³⁰ *Murray v. Benbow*, Law Report, TIMES (London), Feb. 2, 1822, at 4.

¹³¹ *Southey*, 35 Eng. Rep. at 1008; 2 Mer. at 440.

¹³² *Stockdale v. Onwhyn* (1826) 108 Eng. Rep. 65, 65–66; 5 B. & C. 174, 176, 178 (regarding a book about the life of a courtesan denied copyright protection as contrary to public policy).

¹³³ *Baschet v. London Illustrated Standard Company* [1900] 1 Ch. 73, 74.

¹³⁴ *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

¹³⁵ *Id.* at 269–70.

¹³⁶ *Id.* at 270.

¹³⁷ See Jeremy Phillips, *Copyright in Obscene Works: Some British and American Problems*, 6 ANGLO-AM. L. REV. 138, 140–44 (1977).

¹³⁸ See generally *Attorney-General v. Guardian Newspapers Ltd. (No. 2)* [1990] 1 A.C. 109; *Hyde Park Residence Ltd. v. Yelland* [1999] R.P.C. 655.

¹³⁹ *Yelland*, [1999] R.P.C. at 665.

¹⁴⁰ Copyright, Designs, and Patent Act 1988, c. 48 § 171(3) (UK), <http://www.legislation.gov.uk/ukpga/1988/48/section/171>.

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 Zi 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 Huibian 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).

¹⁴² Yulan Kuo & Yu-Jia Yen, *Pornographic Films Are Not Works Under Taiwanese Copyright Law*, INTELLECTUAL ASSET MGMT. (Apr. 24, 2013), www.taiwanlaw.com/file/vents/20130426.pdf (noting the tension between TIPO and the Taiwan Supreme Court ruling). See also Zhang Zhongxin, *Pornographic Writings Should Be Able to Enjoy Copyright*, TAIWAN L. 1 (May 2010).

¹⁴³ Case 250 of 1999 (“展，且與著作權法之立法目的有違，基於既得權之保障仍需受公序良俗限”) (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.

¹⁴⁷ See Ye Tak, 盜版片侵害著作權 首判有罪 [A Piece of Pirated Copyright Infringement Found Guilty of First], CHINATIMES.COM (Feb. 21, 2014, 4:10 A.M.), <http://www.chinatimes.com/newspapers/20140221000845-260106>.

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 *Pasickniak v. Dojacek*, 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.

¹⁵⁰ See *Pasickniak v. Dojacek*, [1928] 2 D.L.R. 545, para. 1, 11 (Can. Man. C.A.).

¹⁵¹ See *Aldrich v. One Stop Video*, [1987] 13 BCLR (2d) 106, para. 123 (Can. B.C. Sup. Ct.).

¹⁵² *Id.*

¹⁵³ See *Liberty Media Holdings, LLC v. Swarm Sharing Hash File*, 821 F. Supp. 2d 444 (D. Mass. 2011).

¹⁵⁴ *Id.* at 447 n.2. This argument is being raised in copyright litigation nationwide promoted by pro-copyright theft organizations as a valid means of working to abolish all copyright protection for erotic expression. See, e.g., *Wong v. Hard Drive Prod., Inc.*, No. 12-CV-469-YGR, 2012 WL 1252710 (N.D. Cal. Apr. 13, 2012); *Next Phase Distrib., Inc. v. John Does 1–27*, 284 F.R.D. 165, 171 (S.D.N.Y. 2012); *Discount Video Ctr., Inc. v. Does 1–29*, 285 F.R.D. 161 (D. Mass. 2012); Defendant's First Amended Answer and Counterclaim at 50–51, *Malibu Media, LLC v. Fantalis*, Case No. 1:12-cv-00886 (D. Colo. July 16, 2012).

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.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."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.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.*,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.¹⁶¹ The court wrote that "the word 'hottest,' as used in the chorus of song 'Dora Dean,' has an indelicate and vulgar meaning, and that for that reason the song cannot be protected by copyright."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.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-*

U.S. COURT OF APPEALS FOR THE FIRST CIRCUIT, www.ca1.uscourts.gov/about-court (last visited Sept. 12, 2015).

¹⁵⁶ A plaintiff in Minnesota wrote: "Hard Drive's Work is not eligible subject matter for copyright because it is illegal, immoral, or obscene. . . . Hard Drive is not entitled to any judicial remedies for alleged infringement of its Work because that Work is illegal, immoral, or obscene." Complaint for Declaratory Judgment at 6-7, *Abshire v. Hard Drive Prod., Inc.*, No. 13-CV-00380 (D. Minn. Feb. 15, 2013). Preliminarily, "pornography" has no legal meaning, and therefore any argument that "pornography" lacks any entitlement to copyright protection has a fundamental flaw. Even in *Miller v. California*, the Court declined to give pornography a legal meaning, and used a footnoted dictionary definition of the word. *Miller v. California*, 413 U.S. 15, 18 n.2 (1973). Since then, many courts have recognized that the term lacks a clear legal definition. *Farrell v. Burke*, 449 F.3d 470, 486 (2d Cir. 2006) ("[A] number of cases in this Court and others have held or strongly suggested that the term [pornography] is inherently vague."); *United States v. Thompson*, 653 F.3d 688, 695 (8th Cir. 2011); *United States v. Guagliardo*, 278 F.3d 868, 872 (9th Cir. 2002) ("[A] probationer cannot reasonably understand what is encompassed by a blanket prohibition on 'pornography.' The term itself is entirely subjective."); *United States v. Loy*, 237 F.3d 251, 263-65 (3d Cir. 2001).

¹⁵⁷ *Martinetti v. Maguire*, 16 F. Cas. 920, 923 (C.C.D. Cal. 1867).

¹⁵⁸ *Id.* at 922.

¹⁵⁹ See generally *id.*

¹⁶⁰ *Broder v. Zeno Mauvais Music Co.*, 88 F. 74 (C.C. N.D. Cal. 1898).

¹⁶¹ *Id.* at 79. At the time, "hottest" was only used in African American vernacular.

¹⁶² *Id.* Interestingly enough, the discussion itself might be deemed immoral as it relied upon a quite racist determination of "colored" language.

¹⁶³ *Simonton v. Gordon*, 12 F.2d 116, 117-24 (S.D.N.Y. 1925).

pany.¹⁶⁴ In this decision, the Court established an objective test for copyrightability based on the work's originality.¹⁶⁵ If the work has an original element to it, then it is entitled to copyright protection.¹⁶⁶ 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]."¹⁶⁷

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.¹⁶⁸ 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.¹⁶⁹ 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-

¹⁶⁴ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 248–51 (1903).

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.¹⁷⁰

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.”¹⁷¹ Copyright has specifically and deliberately grown to be content-neutral.¹⁷² By the 1909 Copyright Act’s enactment, Congress eliminated all provisions that could serve as content-based restrictions to copyright registration.¹⁷³ 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.¹⁷⁴ 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.¹⁷⁵ 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.¹⁷⁶ 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.¹⁷⁷ When faced with arguments regarding erotic copyrights, the *Mitchell Brothers* court issued a firm rebuff:

¹⁷⁰ H.R. Rep. No. 94-1476, at 51 (1976), as reprinted in 1976 U.S.C.C.A.N. 5659, 5664.

¹⁷¹ Copyrights—Denial of Registration of Claims Because of Content, 41 Op. Att’y Gen. 395, 402 (1958).

¹⁷² See *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852, 855 (5th Cir. 1979).

In contrast Congress has placed explicit content-related restrictions in the current statutes governing the related areas of trademarks and patents. The Lanham Act prohibits registration of any trademark that “[c]onsists 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.

¹⁷³ *Id.* at 854–55.

¹⁷⁴ *Id.* at 855 n. 4.

¹⁷⁵ *Id.*

¹⁷⁶ *Id.* at 858.

¹⁷⁷ *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); *Cnty. 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, “[t]o 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 *Jartech, 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 Brothers* and *Jartech* 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 *Jartech* 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 *Jartech, Inc. v. Clancy*, 666 F.2d 403, 405 (9th Cir. 1982).

¹⁸² *Id.* at 406.

¹⁸³ *United States v. Extreme Assocs., Inc.*, 431 F.3d 150, 162 (3d Cir. 2005) (reversing trial court’s dismissal of obscenity indictment and remanding case for further proceedings before trial court; defendants ultimately accepted plea deal including jail time in 2009); further proceedings at Judgment and Probation/Commitment Order, *United States v. Isaacs*, No. CR-07-732-GHK, 2008 WL 4346780, (C.D. Cal. Sept. 19, 2008) (sentencing defendant to 48 months of incarceration on production and distribution of obscenity charges); Amended Judgment on a Criminal Case, *United States v. Little*, No. 8:07-CR-170-T-24MSS, 2008 WL 151875, (M.D. Fla. June 17, 2011) (sentencing Paul Little, a/k/a Max Hardcore, to 41 months of incarceration based on distribution of obscenity charges).

¹⁸⁴ *See Miller v. California*, 413 U.S. 15, 24 (1973).

protecting registered materials in a certain community, while, in effect, authorizing pirating in another locale.”¹⁸⁵

Years later, the Seventh Circuit reaffirmed this principle, holding that “even illegality is not a bar to copyrightability.”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.¹⁸⁷

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

Australia has clearly rejected morality-based restrictions on copyrightability. In *Venus Adult Shops Pty Ltd v. Fraserside Holdings Ltd*,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 *Collier Constructions Pty Ltd v. Foskett Pty Ltd*.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.”¹⁹⁰ The *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.”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.”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.¹⁹³

¹⁸⁵ *Jartech, 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).

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

¹⁸⁷ *Cmty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 740 (1989).

¹⁸⁸ *Venus Adult Shops Pty Ltd v. Fraserside Holdings Ltd*, (2006) 157 FCR 442, 465 (Austl.).

¹⁸⁹ *Id.*

¹⁹⁰ *Id.*

¹⁹¹ *Id.*

¹⁹² *Id.* at 471.

¹⁹³ *Id.* at 480.

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."¹⁹⁴

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,¹⁹⁵ 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 Section 2(a) of the U.S. Trademark Act.¹⁹⁶

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 international obligations. Articles 27 and 15 of the Universal Declaration of Human Rights (UDHR) protects the right to the moral and material interests resulting from artistic productions and user's rights to participate in the cultural life of the community—to freely bask in all forms of expression.¹⁹⁷ And, quite frankly, that expression should be free of the judgments of intellectual plutocrats. "Culture must not be viewed as an esoteric activity of a superior social elite."¹⁹⁸ 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."¹⁹⁹ Mean-

¹⁹⁴ *Id.* at 465.

¹⁹⁵ Gervais, note 120.

¹⁹⁶ 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-IDD, 2015 WL 4096277, at *1 (E.D. Va. July 8, 2015) (finding "Redskins" trademark racist 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).

¹⁹⁷ *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.

¹⁹⁸ Gervais, note 120, at 16.

¹⁹⁹ Ysolde 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.²⁰⁰ 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 *Dima v. Romania*,²⁰¹ 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.²⁰²

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.²⁰³ 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.²⁰⁴

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

²⁰⁰ Universal Declaration of Human Rights, G.A. Res. 217 A (III), U.N. Doc. A/RES/3/217 A (Dec. 10, 1948).

²⁰¹ Ana E. Santos, *Rebalancing Intellectual Property in the Information Society: The Human Rights Approach*, CORNELL L. SCH. INTER-U. GRADUATE STUDENT CONF. PAPERS, Apr. 27, 2013, at 10.

²⁰² *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).

²⁰³ U.S. CONST. art. I § 8 cl. 8.

²⁰⁴ 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,”²⁰⁵ 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-

²⁰⁵ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

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. . . . [I]n truth, a judge is not well suited to the task and, as often as not, will reach the wrong result.

[T]here 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-

²⁰⁶ Cohen v. California, 403 U.S. 15, 25 (1971).

²⁰⁷ *Venus Adult Shops Pty Ltd v. Fraserside Holdings Ltd* (2006) 157 FCR 442, 480 (Austl.).

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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.

²⁰⁸ *Abrams v. United States*, 250 U.S. 616, 630 (1919) (Holmes, J., dissenting).

