

# Intellectual Property and Identity in Post Pandemic

Trademarks, Rights and Identities  
Where are we now?

John R. Rudolph, Eli Lilly and Company

# DISCLAIMER

Remarks made  
by John Rudolph



are his own



and



are not remarks  
made on behalf of



Eli Lilly and  
Company.

## Trademarks and Identity

Merriam-Webster defines IDENTITY as:  
“the **distinguishing character** or personality of an individual”

Merriam-Webster defines TRADEMARK as:

“a **distinguishing characteristic or feature** firmly associated with a person or thing”

The Lanham Act defines a TRADEMARK as:

“...any word, name, symbol, or design, or any combination thereof, used in commerce to **identify and distinguish** the goods of one manufacturer or seller from those of another and to indicate the source of the goods...”

## First Amendment

"Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances."

"Trademarks are private, not government, speech."

Alito, J., *Matal v. Tam*, USSC (2017)

# A Quick Look Back - Spring, 2017

Trademark Speech in the context of the society that surrounded it was **NOT**

Subject matter that...

**“...(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute;...”**

Lanham Act section 2(a)



## Tam: Goodbye to Disparagement

June 19, 2017

- Subject matter that disparages a “substantial” percentage of the members of a racial or ethnic group necessarily disparages many “persons,” namely, members of that group. And this is not just “persons,” but also “institutions” and “beliefs.”
- It is “viewpoint” discrimination, and as such, unconstitutional.

# Freedom of Trademark Speech Evolves

Spring 2018, after Tam  
Trademark Speech in the context of  
the society that surrounds it was  
NOT

**Subject matter that...**

**...(a) Consists of or comprises  
immoral, deceptive, or scandalous  
matter; or matter which  
may disparage or falsely suggest a  
connection with persons, living or  
dead, institutions, beliefs, or  
national symbols or bring them into  
contempt, or disrepute;...**

# FloodGates OPEN:

Numerous 'offensive' trademark applications filed following Tam ruling; applicants reveal commercial hopes and exploitation fears | World Trademark Review

- ...Our research reveals that there were indeed a number of marks filed on decision day – June 19 – that include terms that might previously be assumed to be unregistrable. These included applications for the terms F\*\*K, F\*\*K YOURSELF, F\*\*KING AWESOME, TOTALLY F\*\*KING BRUTAL, F\*\*KABLE, NOF\*X CLOTHING COMPANY LLC, GOOD S\*\*T, N\*\*\*A, N\*\*\*ER PLEASE, D\*\*KSBYMAIL and C\*\*K S\*\*KER (the latter of which was deemed scandalous under Section 2(a) by the TTAB in 2012 and therefore did not proceed to registration)....



# Brunetti: Goodbye to Immoral or Scandalous

June 24, 2019:

The statute, on its face, distinguishes between two opposed sets of ideas: those aligned with conventional moral standards and those hostile to them; those inducing societal nods of approval and those provoking offense and condemnation. This facial viewpoint bias in the law results in viewpoint-discriminatory application.



# Freedom of Trademark Speech Evolves... Further

Spring 2019, after Brunetti

Trademark Speech in the context of  
the society that surrounds it was  
NOT

**Subject matter that...**

**...(a) Consists of or comprises**  
~~immoral, deceptive, or scandalous~~  
**matter; or matter which**  
~~may disparage or~~ **falsely suggest a**  
**connection with persons, living or**  
**dead, institutions, beliefs, or**  
**national symbols, or bring them**  
~~into contempt, or disrepute;...~~

# Trademarks & Individual “Personal” Identity

- Of course, any subject matter that...
  - ... (c) Consists of or comprises a name, portrait, or signature identifying a particular living individual [or a deceased individual where a spouse is alive]  
...except by his written consent...”
- ...cannot be a trademark. – This is unchanged.




Spring 2020 the PANDEMIC is upon  
the United States

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# During the Pandemic



[USPTO announces  
COVID-19 Prioritized  
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certain trademark and  
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## USPTO announces COVID-19 Prioritized Examination Program for certain trademark and service mark applications

June 15, 2020    Press Release: 20-14

The United States Patent and Trademark Office (USPTO) today announced a new COVID-19 prioritized examination program for certain trademark and service mark applications.

Under this new program, the USPTO will accept petitions to advance the initial examination of applications for marks used to identify qualifying COVID-19 medical products and services. Additionally, the USPTO will waive the fee for such petitions.

"Inventors and entrepreneurs are working around the clock to develop products that will help prevent, diagnose, treat, or cure COVID-19," said Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director of the USPTO. "Accelerating initial examination of COVID-19-related trademark

### CONTACT: (Media Only)

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(571) 272-8400 or  
[paul.fucito@uspto.gov](mailto:paul.fucito@uspto.gov)

# A DOMAIN NAME Can be a Trademark

Booking.com, USSC (June 30, 2020)



Who knew?

# Trademark Modernization Act of 2020

Enacted as part of the Consolidated  
Appropriations Act 2021

Passed December 27, 2020

Implementation date: December 27, 2021

One of the most significant amendments to  
the Trademarks Act since the revision Act of  
1988.

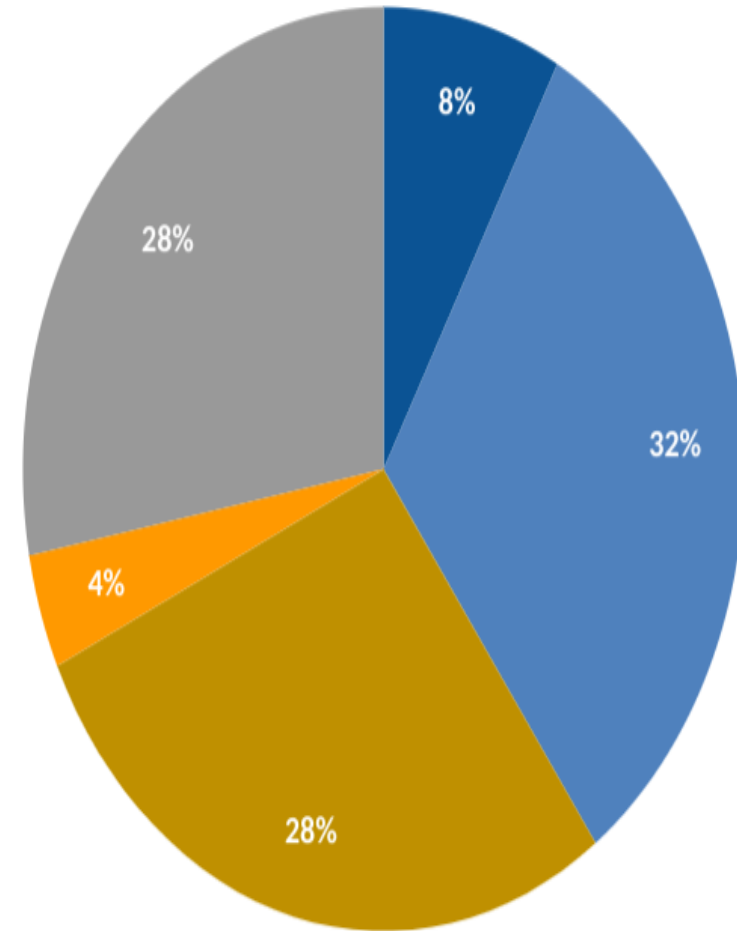
Three important changes:

- New tools to remove USPTO trademark filings that are based on inaccurate claims of use
- Discretionary shortened response deadlines to office actions
- Restores the rebuttable presumption of irreparable harm in jurisdictions that have dismissed it

# In-House TM Practice

Has the covid-19 outbreak changed your trademark practice/brand protection workload?

- Workload increased significantly
- Workload increased slightly
- Workload decreased slightly
- Workload decreased significantly
- Workload stayed about the same



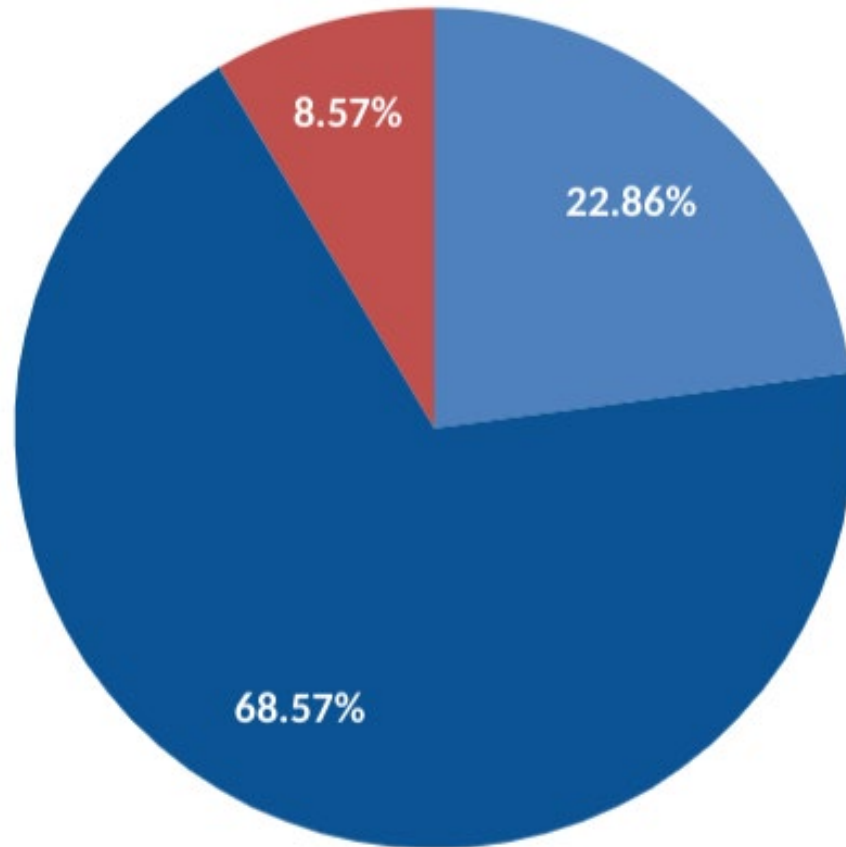
[A new normal: trademark community on life during and after the coronavirus pandemic – exclusive survey results | World Trademark Review](#)



# Private Law Firm Practice

Has the  
covid-19  
outbreak  
affected your  
firm's  
trademark  
practice?

● Yes, significantly ● Yes, somewhat ● No



[A new normal: trademark community on life during and after the coronavirus pandemic – exclusive survey results | World Trademark Review](#)

# Private Law Firm Practice

- **Over the next 12 months, which of these actual or potential risks resulting from the covid-19 outbreak are you concerned about for your firm's trademark practice?**

Client decisions to postpone brand launches/development	68.6%
Fall in client spend until end of Q2 (possibly Q3 or Q4)	65.7%
Client reluctance to enforce marks	60%
Loss of employee hours and/or productivity due to quarantine	48.6%
Headcount reductions	40%
Contractual/client obligations unable to be fulfilled	40%
Disruption from closure of courts	34.3%
Disruption from closure of IP offices	28.6%
Challenge of business interruption due to incapacity of key personnel	17.1%
Cyberattacks as a result of increased remote working	17.1%

[A new normal: trademark community on life during and after the coronavirus pandemic – exclusive survey results | World Trademark Review](#)

# USPTO/Trademarks Office 2020

- The USPTO received 738,112 trademark application classes, eclipsing 2019's record total.
- During 2020 entirely electronic processing of trademark applications rose to 88.7%, and is leading to more efficient processing, fewer errors, and more cost-effective transactions for USPTO customers.



Applications  
containing  
the word  
"COVID"



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Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Wed Apr 7 03:32:22 EDT 2021

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Start List At:  OR Jump to record:  **691 Records(s) found This page: 1 ~ 50)**

Refine Search (\*COVID\*)(COMB)

Current Search: S8: (\*COVID\*)(COMB) docs: 691 occ: 979

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	90452622		AGE OF COVID	TSDR	LIVE
2	90451856		COVID SAPIEN	TSDR	LIVE
3	90235595		LY-COV555	TSDR	LIVE
4	90196627		COVIDNATED	TSDR	LIVE
5	90191508		2020 COVID-19 PANDEMIC SOMETIMES IT TAKES A DISASTER TO MOVE YOU SOMETIMES IT TAKES A DISASTER TO OPEN YOUR EYES SOMETIMES IT TAKES A DISASTER FOR OPPORTUNITIES TO BE CREATED SOMETIME IT TAKES A DISASTER TO SEND YOU A WAKE-UP CALL SOMETIME IT TAKES A DISASTER TO CHANGE YOUR PERSPECTIVE HAS THIS CHANGED YOU OR ARE YOU SITTING AROUND WAITING FOR THE NEXT DISASTER TO HIT? "DON'T JUST SIT THERE MAKE A MOVE AND DO SOMETHING"	TSDR	LIVE
6	90151813		COVIDOR	TSDR	LIVE
7	90127014		KICKCOVID	TSDR	LIVE
8	90094321		COVID RISK NAVIGATOR	TSDR	LIVE
9	90053554	6317636	DECOVID	TSDR	LIVE
10	90449528		CLIP COVID	TSDR	LIVE
11	90448817		COVID VACCINATED	TSDR	LIVE
12	90613095		CENTERS FOR CONTINUING COVID CARE	TSDR	LIVE
13	90613088		WE ARE COVID CARE	TSDR	LIVE

During the  
Pandemic:  
Steady flow  
of  
Applications

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TESS was last updated on Wed Apr 7 03:32:22 EDT 2021

Search: \*F###K\*

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Start List At:  OR Jump to record:  **1021 Records(s) found (This page: 1 ~ 50)**

Refine Search (\*fuck\*)[COMB] Submit  
Current Search: S2: (\*fuck\*)[COMB] docs: 1021 occ: 1185

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	90236433		OVERLAND AS FUCK	TSDR	LIVE
2	90232460		UNFUCK YOUR DAY	TSDR	LIVE
3	90222348		F*CK THE SMALL TALK	TSDR	LIVE
4	90221308		FUCK SOCIETY KILL SOBRIETY	TSDR	LIVE
5	90210704		FUCKING AWESOME	TSDR	LIVE
6	90210698		FUCKING AWESOME	TSDR	LIVE
7	90617267		FUCK THEM KIDS BY FULL TIME PARENTS.	TSDR	LIVE
8	90448547		FUCK IT I'M SINGLE	TSDR	LIVE
9	90612806		FUCK YOU PAY ME	TSDR	LIVE
10	90612790		FUCK YOU PAY ME	TSDR	LIVE
11	90612775		FUCK YOU PAY ME	TSDR	LIVE

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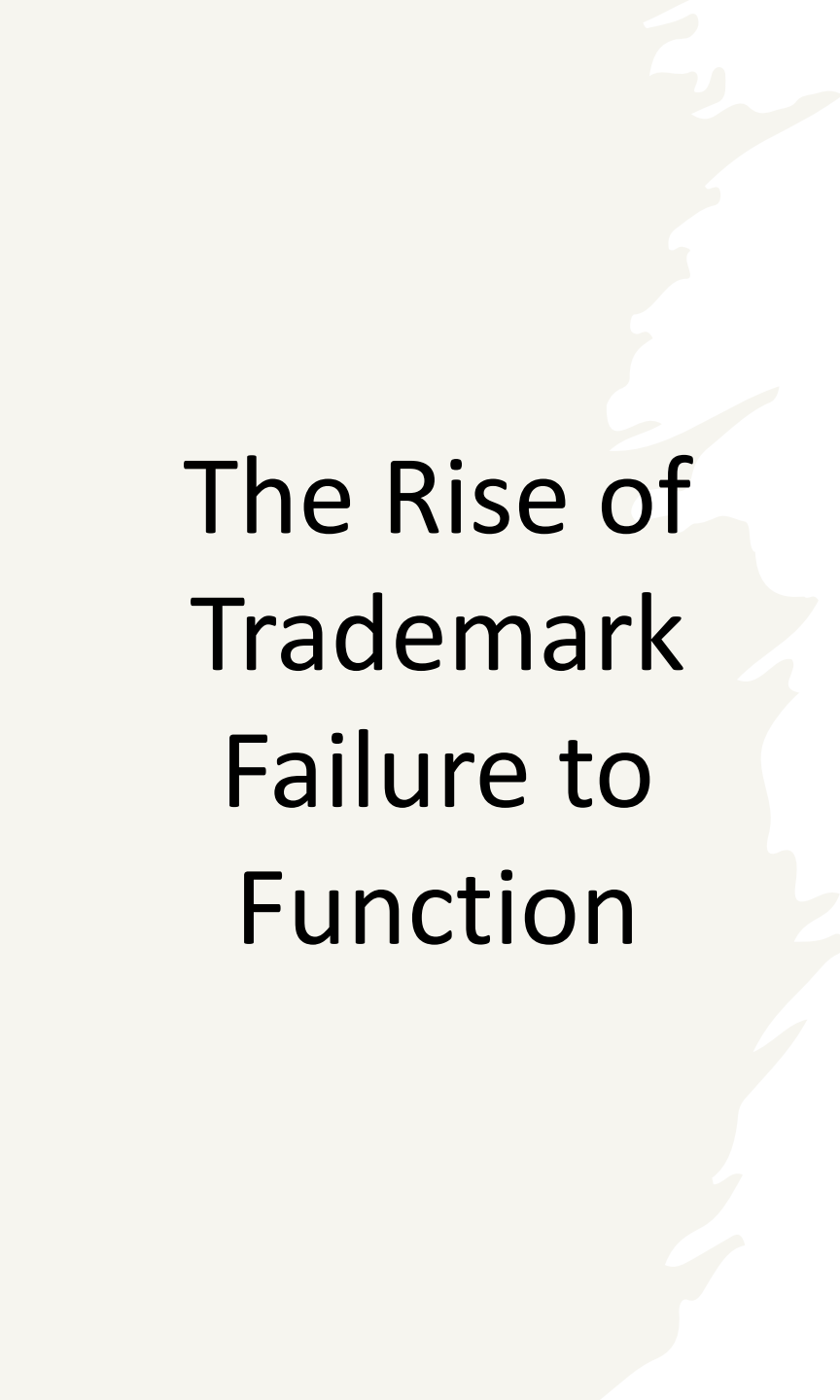
Search: \*S###T\*

TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT SEARCH OG PREV LIST NEXT LIST IMAGE LIST BOTTOM HELP  
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Start List At:  OR Jump to record:  **1075 Records(s) found (This page: 1 ~ 50)**

Refine Search (\*shit\*)[COMB] Submit  
Current Search: S4: (\*shit\*)[COMB] docs: 1075 occ: 1371

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	90452460		HIPPIE BUDDHA SHIT	TSDR	LIVE
2	90452266		SHITTER'S FULL	TSDR	LIVE
3	90451405		BACK ON MY BULLSHIT (B.O.M.B)	TSDR	LIVE
4	90232145		NO BUM SHIT	TSDR	LIVE
5	90226457		RE@L_____SHIT	TSDR	LIVE
6	90108897	6312924	SH*T I LEARNED THE HARD WAY	TSDR	LIVE
7	90194363		LISHITONG	TSDR	LIVE
8	90447458		SALUTATIONS N SHIT	TSDR	LIVE
9	90289566		YOU'RE AWESOME KEEP THAT SHIT UP	TSDR	LIVE
10	90265211		MARISHITEN	TSDR	LIVE



# The Rise of Trademark Failure to Function

## **Trademark Failure to Function**

[Alexandra J. Roberts](#)\*

104 IOWA L. REV. 1977 (2019).

[Trademark Failure to Function - Iowa Law Review - The University of Iowa College of Law \(uiowa.edu\)](#)

## **Using Failure to Function Doctrine to Protect Free Speech and Competition in Trademark Law**

[Lisa P. Ramsey](#)\*

104 IOWA L. REV. ONLINE 70 (2020).

[Using Failure to Function Doctrine to Protect Free Speech and Competition in Trademark Law - Iowa Law Review - The University of Iowa College of Law \(uiowa.edu\)](#)

## **The TTAB Continues Its Recent Trend of Failure-to-Function Refusals**

By [Melissa E. Scott](#) on December 7, 2020

[The TTAB Continues Its Recent Trend of Failure-to-Function Refusals | Above the Fold \(foxrothschild.com\)](#)

## Failure To Function Viewpoint Neutrality

§§1, 2, and 45 of the Trademark Act, [15 U.S.C. §§1051, 1052,](#) and [1127](#), provide the statutory basis for refusal to register on the Principal Register subject matter that, due to its inherent nature or the manner in which it is used, does not function as a mark to identify and distinguish the applicant's goods.

# What About the Flood of “Offensive” Subject Matter?

- Those Applications for or including “F\*\*K”?
- Brief survey says;
  - Haven’t been assigned to an examiner yet
  - “...Registration is refused because the applied-for mark is a slogan or term that does not function as a trademark or service mark...



What About those  
Applications for or  
including “Covid?”

Brief survey says:

- Haven't been assigned to an examiner yet
- “...Registration is refused because the applied-for mark is a slogan or term that does not function as a trademark or service mark...

# Trademarks, Identity: POST PANDEMIC

Trademarks efficiency

Trademarks performing the role they  
were created for: Source  
Identity/Identifiers

Trademarks Law more closely aligned to  
First Amendment right

Individual freedom of expression