

# **“THE TASTE OF ANY PUBLIC”: HOW INTELLECTUAL PROPERTY LAW ILLUMINATES THE FAILINGS OF THE MILLER TEST**

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## INTRODUCTION

*Joe is a pornographer and an inventor. You may not like or approve of what he does, but he is a businessman like anyone else. His business, though, is regulated by a bizarre and inconsistent set of standards. Joe has made a pornographic film. He registers his copyright in the film and it is granted by the Copyright Office, conferring on Joe the exclusive right to distribute and reproduce the film, among other things. The film itself includes a scene that depicts a woman using a sex toy, a new kind of dildo whose design Joe has submitted to the U.S. Patent and Trademark Office (“USPTO”) for a patent. The patent is granted, giving Joe the right to exclude others from copying his design. His product, though, cannot be sold in certain states because obscenity law bars its sale. Joe calls the company that produces such films and sex toys “SeXXX,” and tries to register his trademark so that no one else in his industry can use it. The USPTO denies his trademark registration, because the name is “scandalous.” The results of this scenario for Joe, then, are as follows: he owns a copyright in his film, but if someone illegally downloads it or posts it on a website and Joe sues for copyright infringement, he makes himself vulnerable to criminal prosecution for having made the film in the first place.<sup>1</sup> He cannot vindicate the copyright that the government conferred on him (lest that same government prosecute him for obscenity); the sex toy that appears in the film was granted a patent by the government, but its sale is illegal in many places (meaning that viewers can watch it, but can’t actually use it). And all of this operates under a business moniker that enjoys no trademark protection, even though the products this business has created do enjoy both copyright and patent protection.*

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1. Obscenity law, broadly, makes transportation of obscene matters for sale or distribution a criminal offense, punishable by fines and even prison terms. 18 U.S.C. § 1465 (2006).

Believe it or not, the above scenario is not so far-fetched. The threshold issue that pervades Joe's problems is that of obscenity and how the law defines and deals with it. The *Miller* test, which governs what is deemed obscene, has become obsolete. Applying *Miller* to the area of intellectual property brings the problems with the test and its application into stark relief—and if *Miller* fails in the area of IP, it fails generally. To clear up the inconsistencies that flow from applying *Miller* to intellectual property, trademark law should fall in line with the other IP regimes, and obscenity should be governed not by *Miller*, but by the strict scrutiny standard.<sup>2</sup> These changes would serve the dual purpose of solving the intractable problem of the community standard as well as ensuring that speech regulations were based on actual harm, rather than moral whims. Part I examines how *Miller* was established as the governing test for obscenity. Part II looks to the intellectual property regimes as evidence of *Miller*'s obsolescence; specifically, how and why copyright, trademark, and patent operate wholly outside of *Miller*'s guidelines when dealing with obscenity. Part III argues that the community standard as set forth in *Miller* is unworkable in today's digital society as applied to intellectual property. Part IV argues that this jumble of conflicting rules results in unnecessary layers of speech restriction, in inconsistent outcomes, and in unacceptably unpredictable results, concluding that it is time for an overhaul of obscenity doctrine.

## I. BACKGROUND

### A. *The First Amendment and Obscenity: from "I Know it When I See it" to the Miller Test*

The text of the First Amendment unequivocally protects an individual's right to speak without fear of government sanction by stating, "Congress shall make no law . . . abridging the freedom of speech."<sup>3</sup> Obscene speech, however, falls outside of that protection. Believed to have no value, obscenity has been treated by the courts as less worthy of protection than hate speech or explicitly violent speech (which do enjoy First Amendment

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2. Strict scrutiny is the highest level of review applied by courts when content-based regulations are leveled against speech and requires the government to show a compelling interest in regulating the speech and a narrowly tailored approach. For a further discussion of strict scrutiny, see *infra* note 135 and accompanying text.

3. U.S. CONST. amend. I.

protections).<sup>4</sup> The public, the courts' reasoning goes, should not be subjected to valueless expression that offends their morals, so that expression can be banned.

*Roth v. United States* gave rise to the first of the modern obscenity tests, stating that obscenity is material where the “dominant theme taken as a whole appeals to the prurient interest,” and which the “average person, applying contemporary community standards” would disapprove of.<sup>5</sup> *Roth* was the first case to definitively establish that obscenity is speech not protected by the First Amendment, because it is “utterly without redeeming social importance.”<sup>6</sup> A few years later, in *Jacobellis v. Ohio*, Justice Potter Stewart famously stated that all speech is protected except for “hard-core pornography,” which defies a hard-and-fast description or test, but “I know it when I see it.”<sup>7</sup> Since that time, courts have grappled with what constitutes obscenity, spawning a doctrine they have called “somewhat tortured.”<sup>8</sup> Justice Harlan summed it up by stating, “The upshot of all this divergence in viewpoint is that anyone who undertakes to examine the Court's decisions since *Roth* which have held particular material obscene or not obscene would find himself in utter bewilderment.”<sup>9</sup> Nine years after *Roth*, in *Memoirs v. Massachusetts*, the court held that *Roth*'s presumption that obscenity was without redeeming social importance was in error; rather, prosecutors actually needed to prove that the work was indeed “without redeeming social value.”<sup>10</sup> At first glance this appears to be a move toward a more lenient standard, but courts quickly realized that the *Memoirs* test required prosecutors to prove a negative—that a work was entirely without value—and that was an impossible burden to meet.<sup>11</sup> So, in a swing the other way, the court in *Miller v. California* replaced that standard with the less stringent requirement that a work lack “serious literary, artistic, political, or scientific value.”<sup>12</sup>

The *Miller* test, established in 1973, remains the governing test today. *Miller* dictates that a work is obscene if (1) the average person, applying

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4. Indeed, the Court in *Roth v. United States* stated that obscenity falls outside the First Amendment because it is not even speech at all. 354 U.S. 476 (1957). For a discussion of speech protections for hate speech and violent speech, see *infra* notes 153-54 and accompanying text.

5. *Roth*, 354 U.S. at 489-90.

6. *Id.* at 484.

7. 378 U.S. 184, 196 (1964).

8. *Miller v. California*, 413 U.S. 15, 20 (1973).

9. *Interstate Circuit, Inc. v. City of Dallas*, 390 U.S. 676, 707 (1968) (Harlan, J., dissenting).

10. *Memoirs v. Massachusetts*, 383 U.S. 413, 418 (1966).

11. *Miller*, 413 U.S. at 23.

12. *Id.* at 24.

contemporary community standards, would find that the work, taken as a whole, appeals to the prurient interest, (2) the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law; and (3) if the work, taken as a whole, lacks serious literary, artistic, political or scientific value.<sup>13</sup>

*B. I Know it When I See it, But What About When You See it?*

The *Miller* standard, then, defines obscenity in terms of what it is not, rather than what it is. To add to the confusion, it depends not on any inherent quality of the work itself, but on what our reaction to it might be. The speaker (or the creator of an obscene work) can go to prison for the listener's *reaction* to that work, regardless of the speaker's intent—and regardless of whether another similarly situated listener would find the work non-obscene. As Justice Douglas stated in his dissent in *Miller*, “Obscenity—which even we cannot define with precision—is a hodge-podge. To send men to jail for violating standards they cannot understand, construe, and apply is a monstrous thing to do in a Nation dedicated to fair trials and due process.”<sup>14</sup>

Since its adoption, *Miller* has posed myriad problems since the test itself does not define obscenity—but never more so than today, with the ubiquity of the Internet. Leaving aside the extremely subjective nature of what qualifies as “prurient” or “patently offensive,” or whether something has “literary, artistic, political, or scientific value,” the real conundrum of *Miller* today is what or who the relevant community is by which to judge those things. To begin with, there is no other constitutional question in which a community standard is relevant; if religious speech is protected in one state, it is protected in another. If a person's 6<sup>th</sup> Amendment rights are violated in one neighborhood, they are violated in another. Only in obscenity jurisprudence is the community standard the requisite standard by which to decide whether a constitutional protection applies. The court in *Miller* addressed this issue by explaining its reasoning thusly:

Under a National Constitution, fundamental First Amendment limitations on the powers of the States do not vary from community to community, but this does not mean that there are, or should or can be, fixed, uniform national standards of precisely what appeals to the ‘prurient interest’ or is ‘patently offensive.’ These are essentially questions of fact, and our Nation is simply too big and too diverse for this Court to reasonably expect that such

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13. *Id.*

14. *Id.* at 43-44 (Douglas, J., dissenting).

standards could be articulated for all 50 States in a single formulation, even assuming the prerequisite consensus exists.<sup>15</sup>

The Internet, though, challenges the basic assumption underlying the *Miller* test. A local standard is nearly impossible to establish in the age of the Internet. In cyberspace, who is the local community? That of the creator, or the recipient? And which recipient? The answers to these questions matter, because they make the difference between full speech protection and no speech protection—and potentially criminal prosecution for disseminating an obscene work. As the defendant pornographer in *Extreme Associates* put it, “There’s a difference between watching entertainment and feeling hey, that’s not my, you know, cup of tea . . . and saying, ‘You know what? The person who made that should go to prison.’”<sup>16</sup>

Whether or not one believes that prosecutorial resources should be spent pursuing the creators of works made, bought, and viewed by consenting adults, when obscenity is prosecuted, it is serious business.<sup>17</sup> The pornographers in *Extreme Associates*, for instance, faced up to fifty years in prison for distributing obscenity online.<sup>18</sup> And no matter which side of the issue one leans toward, the standard used to judge the merits of such cases is troubling. When the government decided to prosecute the defendants in *Extreme Associates*, it chose Pennsylvania as the local community (rather than say, California, where the films had been produced).<sup>19</sup> Since the works were online, the government could literally have chosen any community in the nation to try the case, and it chose wisely—Pennsylvania is a conservative “local community.” This kind of forum shopping by prosecutors defeats the very purpose of having a standard at all—in every single case, the prosecution could show that a work meets the *Miller* test for obscenity, if it chooses the right community in which to bring the case.

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15. *Id.* at 30.

16. Sienna Baskin, Comment, *Deviant Dreams: Extreme Associates and the Case for Porn*, 10 N.Y. CITY L. REV. 155, 155 (2006).

17. When the government in 2005 announced its new priority to prosecute obscene pornography, one FBI agent questioned whether this was the best use of the government’s resources by saying, “I guess this means we’ve won the war on terror.” *Id.*

18. *Id.* at 157. This case was one of the first brought under the new wave of obscenity prosecutions, likely because the films in question, which included choking, urination, simulated suffocation, and adults pretending to be children, were considered extreme even by porn industry standards. One commentator called the films “so repugnant and evil that it’s difficult to justify their existence, let alone comprehend why anyone . . . would want to make this kind of garbage in the first place.” Janelle Brown, *Porn Provocateur*, SALON (June 20, 2002), [http://www.salon.com/2002/06/20/lizzy\\_borden/](http://www.salon.com/2002/06/20/lizzy_borden/).

19. *United States v. Extreme Assocs. Inc.*, 431 F.3d 150, 150 (3d Cir. 2005).

## II. THE INTELLECTUAL PROPERTY REGIMES AND OBSCENITY: HOW IP TRIES TO CLEAN UP *MILLER*'S MESS

At first glance, it may seem that obscenity is only sporadically or rarely prosecuted, so why fret over the test that is used?<sup>20</sup> Because even if the government never chose to prosecute obscenity, it always has the option to do so. More importantly, the very specter of prosecution is enough to keep one from vindicating his rights in some cases, and in others, those very rights are abridged to begin with. In either instance, the government is curtailing or denying rights based on a flawed test. And in fact, obscenity *is* prosecuted, though less often since 2011, when Obama dismantled the Obscenity Prosecution Task Force started by the Department of Justice in 2005.<sup>21</sup> Obscenity prosecutions have waxed and waned with the politics of each administration, but even supporters of increased prosecution have acknowledged their difficulty in the age of the Internet.<sup>22</sup>

Where the “hodge-podge” of standards that governs obscenity is increasingly problematic, in today’s digital economy, is in the area of intellectual property. Copyright, trademark, and patent, taken together, cover nearly every kind of product that obscenity law governs: pornography (on- or offline, print or movie, film or video), sex toys, and the trade names under which they are all produced.

Pornography is nothing if not a booming business.<sup>23</sup> And businesses of any sort must protect their intellectual property in order to continue thriving. These days, the vast majority of pornography appears online (for the purposes

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20. Indeed, proponents of *Miller* argue that its parameters are so narrow and difficult to meet that it is barely prosecutable, and thus poses no danger of overbreadth. It is a specious argument, however, that *Miller* is a workable test because it is nearly impossible to effectively apply. See Barry McDonald, *Stuff So Raunchy, It's Illegal*, L.A. TIMES (June 30, 2008), <http://www.latimes.com/opinion/la-op-mcdonald-stagliano30-2008jun30-story.html#page=1> (arguing that *Miller* should remain the governing test for obscenity).

21. Larry Abramson, *Federal Government Renews Effort to Curb Porn*, MORNING EDITION, NATIONAL PUBLIC RADIO (Sept. 27, 2005), <http://www.npr.org/templates/story/story.php?storyId=4865348>. The Obama administration folded the aims of the task force into the Criminal Division’s Child Exploitation and Obscenity Section, drawing criticism from conservative groups who saw the move as being soft on porn. Josh Gerstein, *Eric Holder Accused of Neglecting Porn Fight*, POLITICO (Apr. 16, 2011), <http://www.politico.com/news/stories/0411/53314.html>.

22. *Id.*

23. Pornography is a multibillion dollar industry; over 70 percent of men and 30 percent of women admit to consuming pornography, and largely online. *Porn Sites Get More Visitors Each Month than Netflix, Amazon, and Twitter Combined*, HUFFINGTON POST (May 4, 2013), [http://www.huffingtonpost.com/2013/05/03/internet-porn-stats\\_n\\_3187682.html](http://www.huffingtonpost.com/2013/05/03/internet-porn-stats_n_3187682.html). Pornography sites get more than 450 million unique viewers per month (compare to 110 million for Amazon.com, for instance). *Id.*

of this discussion, “pornography” refers to the obscene variety, rather than the sexually-explicit-but-not-over-the-First-Amendment-line variety),<sup>24</sup> either on pay-per-view websites, as free content, or otherwise. The Internet has been both good and bad for the porn industry.<sup>25</sup> On the one hand, pornography has proliferated, as people can access anything they want with a few clicks of a mouse, with a minimum of effort, and no stigmatizing public walk into the local adult theater. On the other hand, the availability of porn online also means that more and more people can easily download, re-post, or copy the clips or films they access, whether for personal use or profit (committing countless acts of copyright infringement in the process), depriving the work’s creator the profits he would normally have earned from paying customers. The ability to vindicate one’s copyright in such works becomes important under these circumstances; similarly, if one patents a new kind of sex toy, a significant portion of its value lies in the ability to keep others from developing and selling the same product. And, of course, if one wants consumers of such products and films to know the origin of the product and develop a sense of loyalty toward that brand, one should operate under a trade name that others in the same industry cannot use. How obscene and sexually explicit materials are treated by the intellectual property regimes, then, is a matter of great importance both to the creators and the consumers of such products.

#### A. *Dangerous Undertakings: Copyright Law*

Copyright arises naturally (that is, without the need for formal application/registration) upon a work’s creation if it meets three criteria: it must be a work of authorship, original to the author (a “modicum” of creativity is enough),<sup>26</sup> and it must be fixed in a tangible medium of expression.<sup>27</sup> A work that meets those elements thus creates in its author six exclusive, enumerated rights, which include the right of reproduction, distribution, and digital transmission.<sup>28</sup> While copyright arises automatically for an original and fixed work of authorship, registration bestows on the copyright holder the ability to vindicate those rights should they be infringed,

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24. The Court in *Jacobellis v. Ohio* attempted to distinguish between sexually explicit speech (courts often refer to this as “soft-core pornography”) and obscenity, which it termed “hard-core pornography.” *Jacobellis v. Ohio*, 378 U.S. 184, 201 (1964) (Warren, C.J., dissenting). The *Miller* test now forms the line between the two; the former enjoys the full benefit of First Amendment protections, while the latter enjoys none.

25. Thirty percent of all data transferred across the Internet is pornography.

26. *Feist Publ’n, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 346 (1991).

27. 17 U.S.C. § 102 (1990).

28. 17 U.S.C. § 106 (2002).

and impacts the kinds of remedies available to him.<sup>29</sup> For instance, in the case of an Internet pornographer, assuming a showing of creativity is met and the work is fixed (digitally, for example), in order to enjoin others from reproducing (by downloading the work onto a personal computer, for instance) or distributing (posting it to one's website), or to collect damages for such infringement, the pornographer would have to own a validly registered copyright in the work.<sup>30</sup> With the prevalence of file sharing and illegal downloading of pornography,<sup>31</sup> copyright registration becomes an important—if not highly necessary—tool for the creator of the work to monetize his efforts. If he cannot protect his work product or profit from it, he may eventually stop making it and the public will no longer have access to it.<sup>32</sup> And this creation and access, like it or not, is what the Copyright Act aims to protect.

In the 1903 case of *Bleistein v. Donaldson Lithograph Co.*, Justice Holmes famously said, “It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations . . . the taste of any public is not to be treated with contempt.”<sup>33</sup> Judges are not supposed to be in the business of deciding which works merit copyright protection and which works do not; after all, copyright arises upon a showing of originality and fixation, not quality. That prohibition is, in part, what paved the way for copyright protection for obscene works.

Copyright has not always been available for obscenity, and not even for mildly scandalous works, initially; James Joyce's classic *Ulysses* was denied

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29. 17 U.S.C. § 411(a) (2008).

30. *Id.*

31. Violet Blue, *Every Inch Counts: Porn Filesharing Lawsuits Crest 30K Defendants*, ZDNET (Nov. 8, 2010, 7:19 PM), <http://www.zdnet.com/article/every-inch-counts-porn-filesharing-lawsuits-crest-30k-defendants/>.

32. Some have argued that this is reason enough to deny copyright to pornography. Prominent anti-pornography legal scholar Ann Bartow, for instance, has argued that granting copyright to any kind of pornography (even the non-obscene variety) is bad for society because copyright protection means increased monetization, resulting in increased production and distribution of such works. See Ann Bartow, *Copyright Law and Pornography: Reconsidering Incentives to Create and Distribute Pornography*, 39 U. BALT. L.F. 75, 82 (2008). *But see* Jennifer Rothman, *Sex Exceptionalism in Intellectual Property*, 23 STAN. L. & POL'Y REV. 119, 155 (2012) (arguing that denying copyright protection, rather than granting it, actually increases its availability and dissemination because the works are freely available to copy and distribute. Further, she notes that pornography has been a highly profitable business since long before it was afforded copyright protection, and thus there is little reason to conclude that granting copyright would suddenly incentivize creators to make more of it.).

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

copyright, for instance, because it was deemed obscene.<sup>34</sup> That all changed with two major cases that established copyright protection for pornography, and which suggested that even obscene pornography can enjoy copyright protection.

In 1979, the maker of an adult film sued for copyright infringement when two people obtained copies of his film *Behind the Green Door* and exhibited it in movie theaters (a violation of the public performance right).<sup>35</sup> The defendant asserted the “unclean hands” defense, claiming that the work was not protected in the first place because it was obscene, and thus no infringement could be possible.<sup>36</sup> The court in *Mitchell Bros.* discussed the various reasons why obscenity should be protected by copyright, specifically that Congress enacted the Copyright Act to promote creativity and denying protection to any kind of work is at odds with that goal.<sup>37</sup> The court’s holding explicitly prevented an unclean hands defense to copyright infringement for obscene works, and, importantly, suggested that there is no bar to copyright protection in the first instance, because the doctrine of aesthetic non-discrimination as laid out in *Bleistein* precludes the Copyright Office from making qualitative evaluations of a work’s merit.<sup>38</sup>

The second key case to discuss the issue was *Jartech v. Clancy*, which also held that obscenity is not a defense to copyright infringement.<sup>39</sup> The court (citing *Belcher v. Tarbox*, 486 F.2d 1087 (9th Cir. 1973))<sup>40</sup> again held that the Copyright Act does not contemplate the views or quality of the work, and therefore protection is available for obscenity.<sup>41</sup> Although the Supreme Court has never weighed in on the issue, taken together, these two cases suggest that copyright protection is available for obscene works.<sup>42</sup>

The vast majority of obscene pornography is disseminated over the Internet,<sup>43</sup> and because these are “creative” works fixed in a tangible medium

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34. Indeed, the publisher of the magazine that first excerpted it for American readers was nearly sent to prison; in a landmark case, the Second Circuit ultimately held that the book did not “have the effect of promoting lust,” and deemed it not obscene and allowed its release in America. Joe Sergi, *Obscenity Case Files: United States v. One Book Called “Ulysses”*, CBLDF.COM (Apr. 24, 2013), <http://cblfd.org/2013/04/obscenity-case-files-united-states-v-one-book-called-ulysses/>.

35. *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 854 (5th Cir.1979).

36. *Id.*

37. *Id.* at 856.

38. *Id.*

39. 666 F.2d 403, 407 (9th Cir. 1982).

40. *Belcher v. Tarbox*, 486 F.2d 1087 (9th Cir. 1973).

41. *Jartech*, 666 F.2d at 406.

42. *But see* Rothman, *supra* note 32, at 143 (noting that this is not a foreclosed issue; some courts still don’t allow copyright for any type of pornography and others have suggested they will not protect obscene works).

43. *See supra* note 23.

of expression, they fall under the purview of copyright.<sup>44</sup> There are two problems facing copyright if it were to apply *Miller* to this brand of obscenity. The first is the issue of the Internet. A work of obscenity posted online can be and often is accessed by millions of people, all over the world—making virtually every local community the relevant one. Is the creator of the work required to know the moral standards of every community in the world? Or is the only one that matters the most conservative jurisdiction in the country, where the prosecutor chooses to bring the case? It is impossible to block certain content from certain communities, so once something is posted online, it is available to literally everyone—there is no telling where and by whom it might be accessed; when that something is pornography, it is a safe bet that it will be accessed nearly everywhere. A minority opinion, then, has the power to put someone out of business even when the majority has no objection.

The second problem is that copyright is a federal regime, so protection for a work is meant to be uniform across the country.<sup>45</sup> The courts in *Mitchell Bros.* and *Jartech* were not dealing with online porn; they were dealing with old fashioned, run-of-the-mill adult theaters. And even so, both of those courts determined that the community standard set forth in *Miller* was an unworkable one when applied to copyright, for this reason. The Fifth Circuit in *Mitchell Bros.* noted that the community standard dictated by *Miller* would create impossible practical difficulties in enforcement: works would be protected by copyright in some communities but not in others, depending on what each local community deemed obscene.<sup>46</sup> Citing the same concerns as the *Mitchell* court, the Ninth Circuit in *Jartech* noted that since obscenity is judged by a community standard, denying copyright to obscene works would effectively mean protection in certain communities and not in others.<sup>47</sup> Such an approach would reduce a federal regime to a state-by-state, or community by community, one. In copyright, then, rather than apply the *Miller* test to

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44. Whether these kinds of works are actually creative (within the meaning of the Copyright Act) is questionable, of course. Some have argued that copyright should be denied to obscene works because pornography is made up of “scenes a faire,” or narrative structures and story elements that are always present in a particular genre, and are thus not protectable by copyright. *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763, 765 (9th Cir. 2003). A scene about a gang bang, the argument goes, always must include one person having sex with multiple partners—there’s nothing original to the creator there, and thus copyright should be denied. Similarly, the merger doctrine precludes copyright for ideas which can only be expressed in one or two ways; if there is only one way to express the idea of a certain kind of sexual intercourse, the merger doctrine would dictate no, or at least very thin, copyright protection for such an idea. *Id.*; see also Rothman, *supra* note 32, at 144-45.

45. See Rothman, *supra* note 32, at 153.

46. *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 858 (5th Cir. 1979).

47. *Jartech v. Clancy*, 666 F.2d 403, 406 (9th Cir. 1982).

works to determine whether they are protectable, courts have explicitly stated that the community standard is unworkable and has chosen, instead, to ignore *Miller* altogether.<sup>48</sup>

### B. *Immorality and Scandal: Trademark Law*

Where copyright applies to creative works, trademark applies to “words, symbols, and devices” that designate goods or services and are used in commerce—more commonly known as brand names, logos, and the like.<sup>49</sup> The Lanham Act, enacted in 1946 as the federal trademark statute, states as its goals the protection of both consumers and manufacturers from source identity confusion.<sup>50</sup> Such protection ensures consumer efficiency and protects a product or brand’s good will in the marketplace, because consumers know the source of the products they see (and do not have to waste time figuring out whether a product is made by the company they think it is made by), and the effort a brand makes to build its reputation is not undermined by competitive products whose source is unclear to the consumer.<sup>51</sup> Just as copyright arises naturally upon creation and fixation, trademark arises automatically upon use of the mark in commerce.<sup>52</sup> Assuming the elements of “use in commerce” are met, a valid trademark is born, and lasts as long as the mark continues to be used and maintains its distinctiveness.<sup>53</sup> And as in copyright, to claim infringement under section 1114 of the federal Lanham Act, a mark holder must have a validly registered mark.<sup>54</sup> So while not necessary for a trademark to arise, registration with the USPTO is necessary to enjoy benefits such as a presumption of validity, incontestability, and a constructive national footprint (no competing brand in

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48. As noted in Rothman, *supra* note 32, at 143, other courts have left the issue of copyrightability for obscenity open, or have rejected it altogether. See, e.g., *Devils Films, Inc. v. Nectar Video*, 29 F. Supp. 2d 174 (S.D.N.Y. 1998) (denying order of seizure and preliminary injunction to pornographer on the basis that courts should not use their resources to help those who produce obscene works, and questioning whether copyright is available to them).

49. GRAIME B. DINWOODIE & MARK D. JANIS, *TRADEMARKS AND UNFAIR COMPETITION: LAW AND POLICY* 97 (2004).

50. See Megan M. Carpenter & Kathryn T. Murphy, Comment, *Calling Bullsh\*\*t on the Lanham Act*, 49 U. LOUISVILLE L. REV. 465, 466 (2011).

51. See TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH 48 (Graime B. Dinwoodie & Mark D. Janis, eds., 2008).

52. 15 U.S.C. § 1051 (2002).

53. 15 U.S.C. § 1058 (2010).

54. Registration on the national register is only necessary to bring an infringement claim under the federal Lanham Act; a state common law trademark infringement claim may be brought even for unregistered mark.

any market can use the same mark) even where the mark is only actually used in one geographic market.<sup>55</sup>

The Lanham Act is largely silent on matters of quality or content of a mark: if a mark is used in commerce, and other formalities are met, the mark receives a registration. There is one striking exception to this content-neutral assessment, however. The Lanham Act prohibits registration for works that “consist[] of or comprise[] immoral, deceptive, or scandalous matter.”<sup>56</sup> Judged by a “substantial composite of the public,” if a mark is even deemed “vulgar” (to say nothing of “obscene”), it will be denied registration.<sup>57</sup> The Trade-Mark Act of 1905 was the first to bar registration to “immoral or scandalous matter,” a prohibition that later became section 2(a) of the Lanham Act.<sup>58</sup>

What is considered over the line is very different in trademark than in the other IP regimes, or in obscenity law. The *Miller* test, it would seem, does not go far enough for trademark’s taste—many marks that would pass the *Miller* test for obscenity would fail trademark’s much more restrictive “scandalous” test.<sup>59</sup> What is vulgar or scandalous is not necessarily obscene, though what is obscene is certainly vulgar or scandalous. Prurience, as defined in *Miller*, is “a shameful or morbid interest in nudity, sex, or excretion, which goes substantially beyond customary limits of candor in description or representation of such matters.”<sup>60</sup> In trademark, on the other hand, a mark is denied registration if it is merely “immoral” or “scandalous”<sup>61</sup>—a much lower standard than that for obscenity. As some scholars have noted, “[a] Section 2(a) proceeding is even less democratic than an obscenity trial: the decision is made by judges and administrative agencies on a national level and a minority of hypothetically offended people can override the community standard of taste.”<sup>62</sup>

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55. 15 U.S.C. § 1115 (2002).

56. 15 U.S.C. § 1052 (2006).

57. See *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367 (Fed. Cir. 1994); *In re Boulevard Entm’t Inc.*, 334 F.3d 1336, 1340 (Fed. Cir. 2003).

58. See *Carpenter & Murphy*, *supra* note 49, at 467. Both the statute and the legislative history, though, are silent as to the reasons for the prohibition on scandalous marks, leaving courts to speculate on Congress’s intent. Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and Immoral and the Disparaging: Section 2(a) Trademark Law after Lawrence v. Texas*, 9 MARQ. INTELL. PROP. L. REV. 187, 233 (2005).

59. The Lanham Act, of course, was written nearly thirty years before the *Miller* test was established, and reflects the more conservative morals of the day; it has not since amended its scandalousness restriction to mirror federal obscenity law or to better account for modern social mores.

60. *Miller v. California*, 413 U.S. 15 at 48 n.1 (1973).

61. 15 U.S.C. § 1052 (2006).

62. Gibbons, *supra* note 58, at 237.

Though it bars registration for marks falling into these categories, the Lanham Act provides no guidance as to the meaning of “immoral” or “scandalous”; the Trademark Trial and Appeals Board (“TTAB”)<sup>63</sup> itself has called terms “somewhat vague” and “highly subjective.”<sup>64</sup> Courts have generally collapsed “immoral” and “scandalous” into one, commonly referring to both as scandalous.<sup>65</sup> The first case to wrestle with the meaning of “scandalous” was *In re Riverbank Canning Co.*, in which the court determined that the word “scandalous” should be interpreted through “its ordinary and common meaning,” which was “[c]ausing or tending to cause scandal; . . . shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable, . . . [g]iving offense to the conscience or moral feelings; . . . [or] calling out [for] condemnation.”<sup>66</sup>

So how does the USPTO determine the “ordinary and common meaning” of a word? The same way anyone else would: by looking it up in the dictionary. Looking to the dictionary meaning represents “an effort to distill the collective understanding of the community with respect to language and . . . constitute more than a reflection of the individual views of either the examining attorney or the dictionary editors.”<sup>67</sup> Trademark, then, looks to the reaction the national audience at large—not one specific community—might have to a mark.<sup>68</sup> Two early cases established that dictionary meaning is enough, where there is only one applicable meaning, to infer what the substantial composite of the public would think.<sup>69</sup> In *In re Mavety Media Group*, the purveyor of an adult magazine called *Black Tail* was initially denied registration by the USPTO on grounds that its mark, Black Tail, was scandalous because Webster’s New Collegiate Dictionary defined the term “tail” as “sexual intercourse—usu[ally] considered vulgar.”<sup>70</sup> The TTAB affirmed the rejection, and the publisher appealed.<sup>71</sup> The court held that the

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63. The TTAB is the “administrative body that decides ex-parte appeals, oppositions, cancellations and concurrent use proceedings” within the USPTO; once an examiner has rejected an application on the basis of scandalousness, for instance, the applicant can appeal that decision to the TTAB. *Trademark Trial and Appeal Boards FAQs*, available at <http://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/trademark-trial-and-appeal-board-ttab> (last visited Sept. 27, 2015).

64. *Carpenter & Murphy*, *supra* note 58, at 468.

65. *Id.*

66. *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938).

67. *In re Boulevard Entm’t Inc.*, 334 F.3d 1336, 1340 (Fed. Cir. 2003).

68. In cases of marks that are “disparaging,” however, courts will look at whether the specific group or class of people referenced by the mark would view it as disparaging or pejorative. 15 U.S.C. §1052 (2006).

69. *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367 (5th Cir. 1994).

70. *Id.* at 1369.

71. *Id.*

mark was not in fact scandalous (and therefore was subject to trademark registration), because “tail” also has a common dictionary meaning of “rear end,” in addition to “sexual intercourse.”<sup>72</sup> Had the term “tail” had only one recognized meaning, that of “sexual intercourse,” the mark would have been deemed scandalous. The court held that the dictionary meaning of a term can be determinative of whether a substantial composite of the public would find a term scandalous, but where there are multiple definitions of a word, the fact that *one* of them might be found vulgar is not enough to deny registration.<sup>73</sup>

Using that line of reasoning, in *In re Boulevard Entertainment*, trademark registration was denied for the marks “1-800-Jack-Off” and “Jack-Off” for a phone sex line.<sup>74</sup> There, the court held that when there is only one common meaning of a term, the dictionary meaning is enough evidence that it is scandalous.<sup>75</sup> The examiner consulted four dictionaries, all of which defined the term as an “offensive or vulgar reference to masturbation.”<sup>76</sup> Boulevard argued that within its trade and among its advertisers, “jack-off” is not a scandalous or vulgar term (indeed, it is a desirable one), but the court held that the relevant standard is the entire composite of the public—not only the industry in which the term is being used.<sup>77</sup> The court also recognized that dictionaries can become outdated, and may no longer reflect the substantial composite’s understanding of a term; it is the burden of the mark applicant to offer, in that case, other evidence that “the dictionary characterization of the term in question no longer accurately reflects commonly held views.”<sup>78</sup> While “Jack-Off” was denied registration, the USPTO did grant registration to the seemingly similar “Jack Off Jill” mark; there, registration was granted because the term was a play on words with the nursery rhyme “Jack and Jill.”<sup>79</sup> A double entendre, apparently, is less offensive—even when it relies on precisely the same words—than a straightforward use of the term.

The scandalous nature of a mark may also depend on the context (the symbols associated with the word, or the type of product or service it denotes, for instance). For example, the mark “Dick Heads’,” a possessive used to denote the restaurant of owner Richard Head, would likely have been granted registration. However, in conjunction with its logo, a graphic depiction of the name, the answer was a resounding no. The TTAB noted that marks that

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72. *Id.*

73. *Id.* at 1373-74.

74. *In re Boulevard Entm’t Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003).

75. *Id.* at 1340-41.

76. *Id.* at 1341.

77. *Id.* at 1342.

78. *Id.* at 1341.

79. *Id.* at 1343.

include “a readily recognizable representation of genitalia” are a substantial distance along the spectrum toward “egregious.”<sup>80</sup>

Going the other direction, the mark for “Big Pecker Brand” was initially denied as being a vulgar reference to the word “penis,” but the TTAB reversed when it considered the mark in its entirety, which included a drawing of a bird.<sup>81</sup> In that light, the mark did not necessarily denote anything vulgar.<sup>82</sup> The court in *In re Old Glory Condom Corp.*, in considering the registrability of condoms featuring an American flag design, dictated that “whether applicant’s mark would be likely to offend must be judged not in isolation but in the entire context of the mark’s use.”<sup>83</sup> Despite *Old Glory*’s mandate that context be taken into account in order to provide more consistent results, post-1993 cases illustrate no such consistency. For instance, Queer Gear for a clothing brand was successfully registered, while Clearly Queer (also for clothing) was denied.<sup>84</sup> Technodyke was registered for a lesbian-oriented website, while DykeTV, a lesbian-oriented television channel, was denied.<sup>85</sup> Both BullsBalls and BigBoy Nuts, graphic depictions of male genitalia meant to decorate the back of a car or truck, were registered; Comfyballs, an underwear brand, was denied.<sup>86</sup>

One early court to discuss the scandalous standard stated, “[T]he § 1052(a) prohibition against scandalous marks is not an attempt to legislate morality, but, rather, a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government.”<sup>87</sup> The goal of the Lanham Act and the trademark regime, however, is to protect consumers from confusion and protect a manufacturer’s good will and effort. Denying scandalous marks trademark registration furthers neither of these

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80. *In re Wilcher Corp.*, 40 U.S.P.Q.2d. (BNA) 1929, 1934 (T.T.A.B. 1996).

81. *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470, 1472 (T.T.A.B. 1988).

82. *Id.*

83. *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1218 (T.T.A.B. 1993).

84. Carpenter & Murphy, *supra* note 58, at 473.

85. *Id.*

86. Harry Bradford, ‘Comfyballs’ Underwear Denied Trademark Because ‘Balls,’ HUFFINGTON POST (Dec. 11, 2014), [http://www.huffingtonpost.com/2014/12/11/comfyballs-trademark\\_n\\_6304094.html](http://www.huffingtonpost.com/2014/12/11/comfyballs-trademark_n_6304094.html).

87. *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981). Courts have continued to echo the sentiment that the government should not use its resources on trademark registration for scandalous marks to support their continued prohibition; however, the costs of registration for any mark have long been funded by user fees. Additionally, if Section 2(a) no longer barred such registrations, the USPTO would actually save time and money it costs to refuse, review, and carry on Board proceedings when its refusals are appealed. Anne Gilson LaLonde & Jeremy Gilson, *Trademark Laid Bare: Marks that May be Scandalous or Immoral*, THE TRADEMARK REPORTER, 1476 Vol. 101 (Sept.-Oct. 2011), [http://www.brinksgilson.com/files/article\\_trademarks\\_laid\\_bare\\_\\_gilsonlalonde\\_2011.pdf](http://www.brinksgilson.com/files/article_trademarks_laid_bare__gilsonlalonde_2011.pdf).

goals. A consumer's moral reaction to a mark, no matter how reprehensible he may find it, has no bearing on what he understands to be its source of origin. The other content-relevant prohibitions in the Lanham Act deal with deceptive marks, which makes sense given that consumer confusion is front and center of trademark's goals.<sup>88</sup> But scandalousness is outside the scope of consumer confusion entirely—and also says nothing of a manufacturer's need to protect its reputation.<sup>89</sup> Rather, the scandalous standard seeks to protect consumers not from confusion, but from *being offended*.<sup>90</sup> Even this dubious rationale, however, does not bear up under scrutiny. Barring registration for a mark does not prohibit its use in the marketplace; rather, it prohibits the mark holder from obtaining a valid trademark and enjoying the rights that confers, such as enjoining another from using a confusingly similar mark. Consumers, then, can still be subject to the offensive mark regardless of its registration status.<sup>91</sup>

Trademark has also opted against using the *Miller* “local community” standard to evaluate the worthiness of a trademark registration in cases of vulgar marks. Like copyright, trademark is a federal regime and affords national protection to a registered mark; a local community standard would result in protection for a mark in some markets and not in others. In a marketplace in which most businesses have an online presence and most products are available for purchase from anywhere in the world via the Internet, the local community standard fails to account for the reality of trademark usage today. Instead, trademark uses a standard called the “substantial composite of the public.”<sup>92</sup> This standard is akin to a national, rather than local, standard. It represents “the standpoint of not necessarily a majority, but a substantial composite of the general public,” and “in the context of contemporary attitudes.”<sup>93</sup> Rather than looking at the community

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88. *See supra* note 50, at 48.

89. Trademark infringement via dilution by tarnishment protects a manufacturer from such a scenario, and even then, we are dealing with a validly registered mark.

90. The scandalousness prohibition arguably also violates the First Amendment as a content-based restriction on speech. *Boulevard* and a handful of other cases have argued that the scandalous bar to registration violates the First Amendment as a content-based restriction. Courts have held that the scandalousness exception does not violate the First Amendment because it is not content-based speech suppression—companies can still use the mark, they just cannot register it. *See also* Gibbons, *supra* note 58, at 224. Furthermore, speech that offends—unpopular and minority opinion—is precisely the kind of speech that the First Amendment was written to protect.

91. *See* LaLonde & Gilson, *supra* note 87 (noting that a more effective way of removing scandalous marks from the marketplace is to leave such subjective judgments to consumers themselves; if they are unwilling to buy something that is sold under too offensive a mark, it will eventually cease to be offered).

92. 15 U.S.C. § 1052 (2006).

93. *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1217 (T.T.A.B. 1993).

in which, say, a particular brand is sold, and judging that community's reaction to it, the substantial composite takes in to account the overall general public, inclusive of the many viewpoints that public may be comprised of. As one court noted, "Although constantly at odds, progressive views and conservative or traditional thinking participate alike in the formation of the composite of the general public. . . [w]e recognize the inherent difficulty in fashioning a single objective measure like a substantial composite of the general public from the myriad of subjective viewpoints. . . ."<sup>94</sup> In the case that created this standard, the dissenting judge expressed concern about it, stating, "I am at a loss to know what it means or how one can have a 'composite' of a class such as 'the general public.'"<sup>95</sup> So while a national standard may better account for the way trademark operates, determining how such a class might react to a mark is clearly rife with the same difficulties as a local standard.

C. "*Injurious to Morals*": Patent Law

The same clause of the Constitution that established copyright gave rise to patent protection; Article I grants Congress the power to "promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."<sup>96</sup> Congress allowed patents of any "new and useful process, machine, manufacture or composition of matter."<sup>97</sup> Patent law balances the same interests as that of copyright: namely, protecting and encouraging innovation while also recognizing the public's interest in access to new inventions. Because the ability to adapt, perfect, and add on to new inventions is considered essential for innovation and a fair marketplace, patent holders enjoy the exclusive right to their inventions for the shortest period of time of the three intellectual property regimes—only twenty years.<sup>98</sup> Once that period has expired, the public is free to build on inventions in a way that benefits everyone.

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94. *In re Mavety*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

95. *In re McGinley*, 660 F.2d 481, 487 (C.C.P.A. 1981) (Rich & Baldwin, JJ., dissenting).

96. U.S. CONST. art. 1, § 8, cl. 8.

97. 35 U.S.C. § 101 (1952).

98. *Id.* Copyright lasts for the duration of the life of the author plus seventy years, while trademark lasts as long as the mark continues to be used in commerce and maintains its distinctiveness.

To be eligible for a patent, an invention must be patentable subject matter, novel, nonobvious, and useful.<sup>99</sup> Section 101 of Title 35 U.S.C. sets out the subject matter that can be patented:

*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*<sup>100</sup>

In *Diamond v. Chakrabarty*, the Supreme Court noted that in adopting the above language, Congress intended the Patent Act to include “anything under the sun that is made by man.”<sup>101</sup> In 2005, the USPTO issued interim guidelines for patent examiners to determine if a given invention meets the statutory requirements of being a useful process, manufacture, composition of matter or machine.<sup>102</sup> These guidelines require that a process must produce a “concrete, useful and tangible result” to be patentable.<sup>103</sup> The guidelines point out that “the expansive term ‘any’ in Section 101 represents Congress’s intent not to place any restrictions on the subject matter for which a patent may be obtained. . . .”<sup>104</sup>

Despite this broad reading of Congress’s intent, historically there were moral limitations on what could be patented. In an early patent case, Justice Story stated that inventions that are “injurious to the well-being, good policy, or sound morals of society” are unpatentable, particularly those that are constitute “new inventions to poison people, or to promote debauchery, or to facilitate private assassination.”<sup>105</sup> Courts and the USPTO continued to deny patents based on this moral limitation until 1977. Then, in an important TTAB decision, the rejection based on moral grounds of a patent for a slot machine was reversed.<sup>106</sup> The Board found that there was no language in the statute that required rejecting the application, but rather that a rejection required “the passing of a moral judgment by the Patent and Trademark Office, a judgment which it is in no way qualified to make.”<sup>107</sup> It set out a new governing standard for determining patentability in such cases: that

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99. 35 U.S.C. § 103 (2011).

100. 35 U.S.C. § 101 (1952).

101. 447 U.S. 303, 309 (1980).

102. *Interim Guidelines for Examination of Patent Application for Patent Subject Matter Eligibility*, 1300 U. OFF. GAZ. PAT. 142 (Nov. 22, 2005), WL 6575342.

103. *Id.*

104. *Id.*

105. *Lowell v. Lewis*, 15 F. Cas. 1018, 1019 (C.C.D. Mass.1817).

106. *Ex parte Murphy*, Sagan, Rosenthal, & Ostrowski, 200 U.S.P.Q. 801, 3-4 (Pat. & Tr. Office Bd.App. Apr. 29, 1977).

107. *Id.* at 1.

“everything [is] useful within the meaning of the law, if it is used (or designed and adapted to be used) to accomplish a good result,” even if it is sometimes, or perceived by some to be, “injurious to morals.”<sup>108</sup>

Moral limitations are now virtually nonexistent. Accordingly, anything that meets the statutory requirements is eligible for patent protection. Patent law, then, operates like copyright; an invention need only be novel, useful, and nonobvious, with no consideration of its morality (or lack thereof). In fact, “sexual appliances” are a now their own designated subclass, defined as “subject matter which comprises means to substitute for or enhance the act of human copulation.”<sup>109</sup> Accordingly, design and utility patents have been granted for such devices as the “Oscillating Intercourse Simulator,”<sup>110</sup> the “Transparent Crotch,”<sup>111</sup> the “Masturbation-Powered Motion Controller,”<sup>112</sup> and the “Double Anchor Strapless Dildo.”<sup>113</sup> Litigation in the area of sex toy patents has thus modernly centered not on whether something is too obscene to be patented, but rather on whether it meets the other statutory requirements of novelty, usefulness, and non-obviousness. A recent opinion by Judge Richard Posner humorously highlights this distinction. In *Ritchie v. Vast Resources, Inc.*, the plaintiff obtained a patent for glass dildos made with borosilicate glass (the stuff used by Pyrex).<sup>114</sup> This kind of glass contains silica, which makes the devices “slippery,” “lubricious,” and “resistant to heat, chemicals, electricity and bacterial absorptions.”<sup>115</sup> Defendant Vast Resources began marketing its own borosilicate glass dildos, thus violating Ritchie’s patent. The lower court found for Ritchie, but the Seventh Circuit reversed, holding that Pyrexed glass sex devices are not patentable, on the grounds that they are an “obvious” invention that does “not involve sufficient inventiveness to merit patent protection.”<sup>116</sup> So it is not that slippery glass

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108. *Id.* at 2.

109. Marc Abrahams, *Sexual Appliance Have a Subclass, Says Patent Office*, BOS. GLOBE (July 28, 2014), <http://www.betaboston.com/news/2014/07/28/sexual-appliances-have-subclass-says-the-patent-office/> (noting the terminology “copulation enhancement” is considered to be inclusive of any device, appliance, or paraphernalia which provides a sexual aid or a substitute genitalia).

110. Molly Fitzpatrick, *10 Incredibly Strange Sex-Related Patents that Unfortunately Exist*, DATA REPORT (Nov. 7, 2013), <http://www.thedatereport.com/dating/conversation-starters/10-incredibly-strange-sex-related-patents-that-unfortunately-exist/>.

111. Luke McKinney, *The 7 Most Terrifying Sex Toys Ever Patented*, CRACKED (Feb. 26, 2011), [http://www.cracked.com/article\\_19060\\_the-7-most-terrifying-sex-toys-ever-patented.html](http://www.cracked.com/article_19060_the-7-most-terrifying-sex-toys-ever-patented.html).

112. *Id.*

113. Amanda Hess, *The Dildos of the Future*, WASH. CITY PAPER (July 30, 2009), <http://www.washingtoncitypaper.com/blogs/sexist/2009/07/30/the-dildos-of-the-future/>.

114. Kashmir Hill, *Judge Richard Posner Knows His Sex Toys*, ABOVE THE LAW (Apr. 27, 2009), <http://abovethelaw.com/2009/04/judge-richard-posner-knows-his-sex-toys/>.

115. *Id.*

116. *Id.*

dildos are too obscene for patent protection—it is that they are too obvious. *Of course*, Posner seems to be saying, *glass dildos should be slippery*.

Patent law requires that the invention not be obvious to *one ordinarily skilled in the relevant art* at the time the invention was made (emphasis added).<sup>117</sup> Patent law uses neither the local nor the national community standard; rather, patent looks to the relevant field the invention applies to, and tests the obviousness prong against that hypothetical audience. The necessary question is, “Would this invention be obvious to an expert in the relevant field?” If it would be obvious to this imaginary individual, then the patent claim fails the test.<sup>118</sup> For patent, which deals with inventions of new products, this is a logical and necessary standard; a local community standard would not adequately protect the interests of patent—namely, to allow for a robust field of creation and invention—because lay people do not have the expertise to judge the technical merits of any given invention. As the Patent Act itself puts it, would the invention be obvious to “a person having ordinary skill in the art?”<sup>119</sup> As applied to sex toys, this is a fairly comical standard. Who is skilled in the art of sexual appliances? And how would that be proved? Nevertheless, the standard against which an invention’s obviousness (or lack thereof) is judged is that of those in the business of creating sex toys. In the case of sexual appliances, people might otherwise judge according to their moral reaction to the product rather than its utility, novelty, and non-obviousness; these evaluations are better judged by the experts in the relevant field. *Miller*’s community standard would not and could not work, then, in the area of obscene patent applications. So long as the invention is novel, useful, and non-obvious to those in the business of creating sex toys, the patent is granted.

### III. THE UNWORKABLE COMMUNITY STANDARD

The three IP regimes aim to balance essentially the same interests: to incentivize and protect creation or investment/effort, while also providing for a robust public domain. All three are federal regimes. And two of them, trademark and patent, are governed by the very same authority: the USPTO. So why aren’t their approaches to obscenity uniform? Because *Miller* does not work when applied to IP, largely thanks to the local community standard. Each regime is thus writing its own rules.

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117. 35 U.S.C. § 103 (2011).

118. *Id.*

119. *Id.*

As discussed, *Miller* represents a set of standards written over fifty years ago, when our general feeling about what constituted obscenity and the way we consumed it were different. Applying those standards today has proven troubling, to say the least. The local community standard set forth in the first prong of the *Miller* test is all-important: if a specific community does not view the work as prurient, then the entire test fails and the work is not deemed obscene.<sup>120</sup> So who that community is spells the difference between obscene and non-obscene, and all the attendant penalties or privileges. But who is the relevant community today? This is an increasingly difficult question to answer as technology shrinks the world to a smaller and smaller size; goods and services once only accessible via brick and mortar stores are now available online from literally any corner of the globe. “Community” is no longer solely a geographic concept; it is no longer strictly defined by a line or boundary on a map, or the limits of a neighborhood, city, state, or even country. Thanks to social media and the connectivity of the Internet, people define themselves more and more according to communities of their own design, based on shared interests or common values rather than on geographic location.<sup>121</sup> A community thus developed is likely even more cohesive and reflective of its members’ morals and tastes than any neighborhood could be; this kind of opt-in community is far more likely to share the same idea of what is prurient or offensive than, say, a state the size of California, which comprises many hundreds of smaller communities that vary widely in terms of level of conservatism. If an obscenity charge was brought against an adult movie theater in my own Los Angeles neighborhood, for example, it defies imagination how a court might determine what the local community standard would be, even judged by a small neighborhood, given its racial, ethnic, socioeconomic, and political diversity—much less the entirety of Los Angeles, or California. It would be much less daunting to try and determine whether a community of Jehovah’s Witnesses, or the International Federation of Trekkers,<sup>122</sup> or the Swifties,<sup>123</sup> or the Girl Scouts of America, or the *50 Shades of Grey* fan club, would find a dirty movie theater unbearably offensive. But, since *Miller* was written to address actual physical locations such as theaters (because that was all that existed at the time), only the physical neighborhood in which the theater sat was relevant. Only the moral

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

121. See Trevor Puetz, Note, *Facebook: The New Town Square*, 44 SW. L. REV. 385, 402 (2014) (arguing that social media has become an indispensable tool for self-expression, allowing users to express their interests, affiliations, and values, and connect with others who share them, in real time and across the globe).

122. Star Trek fans.

123. Taylor Swift fans.

barometers of the people who were forced to actually walk past that theater were engaged. The court in *Miller* reasoned that “[s]ex and nudity may not be exploited without limit by films or pictures exhibited or sold in places of public accommodation any more than live sex and nudity can be exhibited or sold without limit in such public places.”<sup>124</sup> Shielding people from moral offense in those places of “public accommodation” was the driving force in *Miller* and the cases that preceded it. Even then, though, were people actually forced to engage with obscene material? Notably, Justice Douglas, in his dissenting opinion in *Miller*, did not think so: “There is no ‘captive audience’ problem in these obscenity cases. No one is being compelled to look or to listen.”<sup>125</sup> He was referring to adult theaters where, at most, a passerby was forced to confront the existence of the theater, but not what was playing inside. Of course, when the Internet is at issue, there is even less of a “captive audience” problem, because one has to *choose* to access obscene material—it does not randomly appear. No one is forced to pass PornHub.com on his way to Amazon.com, and no one outside the privacy of the room is accidentally compelled to see it. Nor, of course, is anyone compelled to purchase a sex toy, or buy a product sold under an offensive brand name.

Today, we are no longer dealing with actual movie theaters showing obscene films; rather, obscene pornography now lives primarily online, where only the user of the computer that has actively accessed it can see it. Nonetheless, *Miller* is still the governing test, so we are bound to accept the local community as a geographic one—even if that is not the most finely calibrated means of assessing whether something is or is not acceptable to that community. But how do we know which geographic community that is, when the obscene work in question is available online? Nearly every kind of copyrighted work is available for viewing and accessing online; trademarked brands conduct more and more of their business over the Internet, making their goods and services available in any market (indeed, the Internet is a critical tool for trademark holders, because placing products for sale online puts them into every market, which establishes a national footprint for the mark); and patented inventions are similarly advertised and sold online, with no ability to restrict their Internet presence in certain markets. Intellectual property, then, is a critical piece of the obscenity puzzle: if *Miller* cannot effectively be applied to IP, then what can it be applied to?

Adult theaters, dirty bookstores, or sex toy shops are not intellectual property, but they are not obscenity either—it is the products viewed or sold inside that trigger obscenity law, and those things *are* intellectual property.

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124. *Miller*, 413 U.S. 15, 25-26 (1973).

125. *Id.* (Douglas, J., dissenting).

Leaving that aside, though, physical things in physical locations are the only thing that *Miller* and its local community standard can, practically speaking, effectively regulate.<sup>126</sup> But actual retail locations for such things today are overwhelmingly outnumbered and outweighed by online retailers. Even if we assume that a dirty theater is itself subject to *Miller*, the number of such theaters is negligible in comparison to the obscenity that is bought, sold, advertised, and traded online—all of which represents someone's intellectual property. And things like public nudity and public sex are regulated by state lewd behavior laws, not by obscenity law.<sup>127</sup> Intellectual property, then, is most often what is at issue when obscenity law is invoked. When IP is taken out of the mix, there is so little left for *Miller* to regulate that it is no longer a practical or useful test.

#### IV. SHIFTING THE BURDEN: A PROPOSAL FOR STRICT SCRUTINY

The community standard as set forth in *Miller* fails to work for any of the intellectual property regimes. Copyright abandons it entirely, because that regime seeks a uniform level of protection for copyrighted works across the country. Trademark also strives to achieve uniform national protection, and so has developed a standard closer to a national community standard—difficult though that may be to determine. And patent considers neither of these, looking instead at whether the experts in the field would find an invention novel, useful, and non-obvious. IP, therefore, is setting its own standards for who the community is by which to judge its output, based on what makes the most sense for each area. But these inconsistent approaches lead to the kind of bizarre and unpredictable results that Joe, our hypothetical pornographer, was faced with. Some kinds of material seek both copyright and trademark protection, and others both trademark and patent.<sup>128</sup> When the results between and among the IP regimes differ, then the applicant suffers. There is no way for that applicant to revise his application, creative work, brand, or product to ensure a consistent result, because such reliable prediction is impossible when the very standards by which the work is judged

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126. As discussed in Part III, *supra*, whether a local community standard discerns community morals effectively is highly speculative.

127. Brian Palmer, *Why is Public Nudity Illegal?*, SLATE (Nov. 28, 2012), [http://www.slate.com/articles/news\\_and\\_politics/explainer/2012/11/why\\_is\\_public\\_nudity\\_illegal\\_the\\_offense\\_principle\\_the\\_bible\\_and\\_taboos.html](http://www.slate.com/articles/news_and_politics/explainer/2012/11/why_is_public_nudity_illegal_the_offense_principle_the_bible_and_taboos.html).

128. For example, when the shape of a product is ornamental and also serves as a source of origin indicator, it may have both trade dress and patent protection; an item of clothing might have elements protected by both a design patent and a trademark; Mickey Mouse and other characters are often both copyrighted and trademarked; a vocal performance might be protected by both trademark and copyright.

vary so widely. The consumer and market suffer too, because some applicants will cease to create new product at all, lest they risk investment that is not rewarded by IP protection in certain places, or at all.

Even if we aren't concerned with those cases of inter-IP overlap, the standards created by each regime are, all three, at odds with *Miller* and First Amendment obscenity law. How, then, is anyone to know which set of rules governs his work? In patent, for example, one government body confers patent protection, while *Miller* prohibits the sale of the very same device in many jurisdictions.<sup>129</sup> One could patent a sex toy, then, and a viewer can watch that sex toy used in a pornographic film (itself copyrighted, but its dissemination regulated by *Miller*), but one cannot actually use it—since buying an obscene device (a sex toy) is still illegal in some places.<sup>130</sup> The court in *Texas v. Acosta*, for instance, held that sex toys are analogous to prostitution and public sex, and could therefore be regulated or banned under obscenity law.<sup>131</sup> In *Regalado v. State*, a store clerk was convicted for possession with intent to sell an obscene device, defined in Texas as “a device including a dildo or artificial vagina, designed or marketed as useful primarily for the stimulation of human genital organs.”<sup>132</sup> The Flexi-lover, the sex toy in question, fit within that definition, and the conviction was upheld.<sup>133</sup> In a famous two-sentence concurrence that seems to recognize the silliness of regulating such a thing, Justice Brown said, “Here we go raising the price of dildos again. Since this seems to be the law. . . I must concur.”<sup>134</sup>

If the designer of the Flexi-lover had known that the time, effort, and many thousands of dollars necessary to secure a patent on his product would be in vain because obscenity law would prohibit its sale, would he have bothered? Probably not. *Well, no great loss to the marketplace there*, some might argue. But a loss to innovation in the marketplace is exactly what patent law seeks to prevent. And if the USPTO does grant the patent, shouldn't the expectation be that selling the device itself is not against the law? Further, if the court says the USPTO is in no way qualified to make

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129. See, e.g., Karthik Subramanian, *It's a Dildo in 49 States, but it's a Dildon't in Alabama: Alabama's Anti-Obscenity Enforcement Act and the Assault on Civil Liberty and Personal Freedom*, 1 ALA. C.R. & C.L. L. REV. 111, 113 (2011).

130. *Id.*

131. *Texas v. Acosta*, No. 08-04-00312-CR, WL 2095290 (Tex. App. Ct. Aug 31, 2005).

132. *Regalado v. Texas*, 872 S.W.2d 7, 8 (Tex. App. Ct. 1994).

133. *Id.* at 10.

134. *Id.* at 11.

moral judgment,<sup>135</sup> then why is the very same office making those same moral judgments when it comes to trademark?<sup>136</sup>

Copyright grapples with similar issues; when copyright is granted to an obscene work, but the owner of the copyright cannot vindicate it when it has been infringed because disseminating the work in the first place violates obscenity law, how do the two sets of rules coexist, and how does the creator know which set governs it?

And what of trademark, which imposes more speech restrictions than the First Amendment's obscenity doctrine itself? If a business were to rely on the rules of *Miller* when naming its brand to ensure it would not be restricted in the marketplace, it could and probably would still run afoul of trademark's own, much less forgiving, set of standards.<sup>137</sup>

Confused? With good reason. To clarify the many layers of inconsistency, I argue for two major changes to the "hodge-podge" of obscenity jurisprudence. First, trademark should fall in line with the other two intellectual property regimes and allow registration for obscene, and scandalous, marks. Such a change would still further the goals of the Lanham Act—to protect consumers and manufacturers from source of origin confusion—while eliminating one arguably unnecessary level of speech restriction. Additionally, this change would assure that all three regimes were in alignment with one another, providing a predictable set of IP standards for creators to deal with. No community or composite of the public would judge the mark's registrability, and no speech would be restricted by the unpredictable sensibilities of such a hypothetical class. Trademark, then, would operate the way copyright and patent do: creators would receive their registration based on formal guidelines, not content. Then, where appropriate, First Amendment obscenity restrictions would kick in. But in order for obscenity law to be a fair and reliable backstop, we need a test that takes into account developments in technology and the way we encounter and consume obscenity today. A test, in other words, that actually works.

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135. See *supra* note 102.

136. One notable difference between trademark and the other IP regimes is that both copyright and patent are rights conferred by the Constitution itself, in the Progress Clause. Trademark, by contrast, is conferred by federal statute, which arose from common law state rights. Courts in none of the three IP regimes have cited to this reason, however, for granting or not granting protection to an obscene work, invention, or brand.

137. In addition to possibly violating the First Amendment's content-neutral requirement, trademark's regulation of scandalous marks is also arguably fatally vague, and should be void on those grounds. The court in *In re McGinley* noted that there is a significant question as to whether the terms "scandalous" and "vulgar" are "sufficiently precise to enable the PTO and the courts to apply the law fairly and to notify a would-be registrant that the mark he adopts will not be granted a federal registration." 660 F.2d 481, 486 (C.C.P.A. 1981).

Once it becomes clear how intellectual property deals with obscenity, we must turn our attention to how obscenity deals with intellectual property. Obscenity is one on a list of other forms of unprotected speech, in company with true threats, incitement to violence, defamation, and false speech.<sup>138</sup> Each of those forms of speech poses risks of real, tangible, and identifiable harms with identifiable victims;<sup>139</sup> the harm the government seeks to protect against with the obscenity doctrine, on the other hand, is one of moral offense. Even assuming a work, a product, or a brand name is morally offensive to every single individual in every community, is offending one's sensibilities really akin to true threats or incitement to violence? Obscenity alone, unlike the other forms of unprotected speech, deals with conduct that is largely itself legal—but obscenity law allows the government to criminalize the *representation* of that legal conduct.<sup>140</sup>

Obscenity should, instead, be subject to strict scrutiny. Strict scrutiny requires that when the government imposes content-based speech restrictions, it must show a compelling government interest and that the regulation is narrowly tailored to achieve that interest.<sup>141</sup> Applying strict scrutiny would take moral objection out of the mix and replace it with an analysis of actual harm. Obscenity, consumed by consenting adults and today largely in private, should not be treated by the law in the same way it treats other forms of unprotected speech. And where the government *could* prove direct harm on the level of incitement, threats, or defamation, strict scrutiny would still allow it to ban the speech. Regulating garden-variety Internet pornography, on the other hand, would rightfully be more difficult under this standard. The government would need to point to a tangible harm that consensual, affirmative opt-in viewing causes (or that selling sex toys causes, or that conducting business under an offensive moniker causes), and its regulations would need a finely tuned fit that did not regulate more speech than necessary. Under *Miller*, people may hesitate to disseminate works, marks, or inventions that are close to the line (indeed, thanks to the

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138. ERWIN CHEMERINSKY, *CONSTITUTIONAL LAW* 1304 (4th ed. 2013).

139. For instance, in order for incitement to violence to fall outside of First Amendment protection, the government is required to prove that the speech causes imminent harm, has a likelihood of producing illegal action, and that the speaker intended to cause imminent illegal action. *Brandenburg v. Ohio*, 395 U.S. 444, 447 (1969).

140. See John Tehranian, *Sanitizing Cyberspace: Obscenity, Miller, and the Future of Public Discourse on the Internet*, 11 J. INTELL. PROP. L. 1, 4 (2003).

141. See Stephen Siegel, *The Origin of the Compelling State Interest Test and Strict Scrutiny*, AMERICAN JOURNAL OF LEGAL HISTORY, VOL. 48, (2006) (explaining that strict scrutiny imposes three hurdles on the government when it regulates speech on the basis of content: it shifts the burden of proof to the government; requires the government to have a “compelling state interest;” and demands that the regulation promoting the compelling interest be “narrowly tailored” to achieve it).

community standard, there is no telling where that line might be drawn), for fear of prosecution. The vagaries of the law therefore result in a chilling of speech—the elimination of not only obscene speech, but much legitimate, protected speech as well. Strict scrutiny would require regulations that are the least restrictive, to prevent regulation of more speech than is necessary to achieve the government’s interest—assuming it could point to a truly compelling interest in regulating or banning the speech in the first place.

Where the government has sought to impose content-based restrictions on other forms of speech, it has often cited the “secondary effects” of the speech, rendering the restrictions content-neutral (and thus subject to the less rigorous intermediate scrutiny standard, which requires only an “important” government interest).<sup>142</sup> Opponents of pornography often cite the secondary effects of increased violence toward and degradation of women. But to regulate speech based even on intermediate scrutiny, those secondary effects would also need to be proven, and thus far, no such correlation has actually been established.<sup>143</sup> Studies have proven no definitive correlation between pornography consumption and violence against women, and some results have even suggested that access to pornography leads to *less* violence against women.<sup>144</sup> Some have argued that the sex industry is bad for the performers themselves; strict scrutiny would allow for regulations on those productions that subject their performers to harmful conditions.<sup>145</sup> If the claimed secondary effect is that obscenity causes the oppression of all women (including, presumably, the 30% that choose to consume pornography themselves)<sup>146</sup>, some tangible proof of that harm would be required, as well as a means of addressing it without abridging speech that does no such harm. In the unlikely event that “oppression of women” could be concretely qualified and quantified, both strict and intermediate scrutiny would likely still leave room for certain kinds of pornography, such as that made for and

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142. See *City of Renton v. Playtime Theaters*, 475 U.S. 41, 49 (1986).

143. See *Tehrani*, *supra* note 140, at 6 (noting that Andrea Dworkin and Catherine McKinnon’s work may be the strongest link between pornography and the general oppression of women).

144. See Tracy Clark-Flory, *Does Porn Cause Violence?*, SALON (May 14, 2013), [http://www.salon.com/2013/05/15/does\\_porn\\_cause\\_violence/](http://www.salon.com/2013/05/15/does_porn_cause_violence/) and Amelia Thompson-DeVeaux, *Pornography Could Deter Sexual Violence, Experts Say*, CARE2.COM (Aug. 6, 2011), <http://www.care2.com/causes/pornography-could-deter-sexual-violence-experts-say.html>. Of course, where negative secondary effects could be proven, the government would be free to regulate the speech using intermediate scrutiny.

145. For instance, Ann Bartow notes the prevalence of trafficked women or “forced filming,” where the performers in a pornographic video are unwilling participants. For these types of productions, the government would easily meet strict scrutiny and such works would rightfully be illegal to produce and disseminate. Ann Bartow, *Pornography, Coercion, and Copyright Law 2.0*, 10 VAND. J. ENT. & TECH. L. 799, 817 (2008).

146. *Id.*

by women, or male-on-male pornography, which likely cannot be shown to oppress women. Regulations could target only those forms of obscenity that cause proven direct or secondary effects.

Another secondary effect commonly cited in support of banning pornography is the “Coolidge effect,” which posits that exposure to pornography increases dopamine levels in the brain, because dopamine surges for anything novel—especially something sexual in nature.<sup>147</sup> Men who regularly consume pornography become habituated to that dopamine surge, and therefore need more and continual sexual novelty to feel it. In turn, their real-life relationships suffer. According to some studies, after regular exposure to pornography, men rate their partners “lower not only on attractiveness, but also on warmth and intelligence.”<sup>148</sup> The Internet and the constant novelty it affords becomes more attractive than the day-to-day realities of sex with the same partner. The government’s interest here, then, would be the promotion or support of marriage (or, possibly, procreation generally). The logic of this argument, of course, supports only banning obscenity for married people (or, even more narrowly, those married couples who do not watch pornography together). Presumably, pornography should be available for everyone else. If the government could successfully defend the position that the secondary Coolidge effect was an important interest to protect against, it would be faced with the daunting challenge of determining exactly to whom it applied, and tailoring its restrictions to apply only to them.

Perhaps the most common rallying cry in the anti-pornography movement is that it is simply bad for the moral fabric of the nation. The anti-pornography group Morality in Media, comprised of a “who’s who of conservative Christian organizations,” believes that America is “suffering the ravages of [a] pornography pandemic.”<sup>149</sup> The main argument of groups like Morality in Media is that pornography is simply immoral. Indeed, Justice Douglas recognized that the issue readily lends itself to such an emotionally charged response, calling obscenity “a highly emotional, not rational, question.”<sup>150</sup> Of course, just as we are afforded the freedom to practice the religion of our choosing, we are free to choose not to interact with obscenity. To proscribe its use by someone *else*, on the other hand, should require a rational (i.e., legal), not emotional, basis. If one existed, in the form of a

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147. Gary Wilson, *Without the Coolidge Effect There Would Be No Internet Porn*, YOUR BRAIN ON PORN (Aug. 8, 2001), <http://yourbrainonporn.com/porn-novelty-and-the-coolidge-effect>.

148. Jennifer Vegas, *Flirty Strangers Sway How Men See Partners*, ABC SCI. (Mar. 26, 2007), <http://www.abc.net.au/science/articles/2007/03/26/1881621.htm>.

149. Josh Israel, *This is the Way the War on Pornography Ends*, THINK PROGRESS (Oct. 8, 2014), <http://thinkprogress.org/justice/2014/10/08/3577238/failed-war-on-pornography-2/>.

150. *Miller v. California*, 413 U.S. 15, 46 (1973) (Douglas, J., dissenting).

tangible harm or a measurable secondary effect, the government would be free to regulate the obscenity.

In the case of patents and trademarks, as compared with copyright (which governs pornography), secondary effects—to say nothing of the compelling interests required by strict scrutiny—would be even harder to establish. While the state has a legitimate interest in protecting citizens from being forced to view sexual conduct in public, it has no such defensible interest in proscribing sexual conduct that occurs behind closed doors, or in preventing the fleeting feeling of distaste that might accompany seeing an offensive product or brand name on a shelf.<sup>151</sup> As Emily Stark has argued, “The state may rightly prevent the use of a sexual device on Main Street, but it should not be able to prevent the purchase of a sexual device on Main Street.”<sup>152</sup> Protecting consumers from the ability to buy certain products, or from the inconvenience of turning their heads, does not rise to the level of an important, much less compelling, government interest. The original policy underpinnings of *Miller*—protecting unsuspecting citizens from unwanted assaults by obscene materials—would still be supported under a strict scrutiny model. In places of public accommodation, the government could point to the secondary effect of decreased property values, for instance, to regulate the placement of an adult theater or an sex toy shop; but it would be faced with a justifiably more difficult challenge to regulate the buying and selling of obscene materials over the Internet within the privacy of one’s own home—or even in a brick and mortar retail location.

Certainly, there are many situations in which there is an actual, concrete harm at issue, and the government would meet its burden in such cases (as long as the regulations were narrowly tailored). In cases where the behavior depicted is itself illegal, such as rape, for instance, the speech could be banned if the government could establish that viewers of such materials perpetrate violence against women at a higher rate than others—a more easily proven causal link because it targets a specific harm. Opponents of obscenity often point to the protection of children as justifying a ban on obscene materials; strict scrutiny would still ensure that the government could ban child pornography outright, as well as in cases where a child’s interest was directly implicated, because protecting children has long been held to be a compelling government interest.<sup>153</sup>

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151. *Lawrence v. Texas* famously struck down anti-sodomy laws in recognition of sexual privacy. 539 U.S. 558 (2003).

152. Emily L. Stark, *Get a Room: Sexual Device Statutes and the Legal Closeting of Sexual Identity*, 20 GEO. MASON U. CIV. RTS. L.J. 315, 323 (2010).

153. *United States v. Williams*, 553 U.S. 285, 288 (2008) (The court noted that child pornography is always banned, and stated, “We have held that a statute which proscribes the

As the law stands now, there is a presumption that obscenity is generally harmful and offensive, and the burden is on its creator to prove that such harms are overcome by “serious literary, artistic, political, or scientific value.”<sup>154</sup> Presumptions alone are not enough to justify abridging constitutional protections, and in the case of obscenity, that presumption simply no longer holds water. Statistics on pornography raise serious questions about its lack of value, for clearly it is worth something to the vast majority of the population. In addition to whatever personal enjoyment a viewer might value, pornography arguably serves an important societal function: it de-marginalizes and de-stigmatizes certain kinds of sex once thought aberrant, such as homosexual sex or interracial sex.<sup>155</sup> Sex toys can serve a similar purpose, furthering non-normative ideas about sexual conduct.<sup>156</sup> But these functions are not enough to clear the *Miller* threshold, and strict scrutiny would require the government to prove the countervailing concrete harms.

Applying strict scrutiny to IP would, in addition to preventing overly broad speech restrictions, solve the problem of the community standard that exists when a work, mark, or invention runs afoul of *Miller*. Our hypothetical pornographer Joe would no longer be faced with the inability to vindicate his copyright or trademark in certain locations but not others, or the inability to sell his products in some states but not others, or the threat of prosecution for doing either. The community standard would be irrelevant—if the government could not establish a concrete, tangible harm stemming from any of Joe’s activities, he would be free to pursue them. If it could, and its regulations were narrowly tailored to address it, he wouldn’t—but the outcome would no longer hinge on the widely disparate and nearly impossible to discern moral attitudes of the innumerable communities his business reaches.

Even proponents of the *Miller* test have largely acknowledged that the local community standard prong is no longer workable, and many have advocated for a national standard to take its place (leaving the other prongs intact).<sup>157</sup> A national standard, though, still begs the question of whose

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distribution of all child pornography, even material that does not qualify as obscenity, does not on its face violate the First Amendment”). See also Alan E. Garfield, *Protecting Children from Speech*, 57 FLA. L. REV. 565 (2010) (arguing that courts easily find a compelling government interest in shielding children from speech their parents deem inappropriate, in part stemming from the substantive right of parents to direct the upbringing of their children).

154. *Miller*, 413 U.S. 15 at 24.

155. See Rothman, *supra* note 32, at 145; see also Tehranian, *supra* note 140, at 15.

156. See Stark, *supra* note 152, at 323-24.

157. See, e.g., *Ashcroft v. ACLU*, 542 U.S. 656 (2004) (in which Justice O’Connor noted that “given Internet speakers’ inability to control the geographic location of their audience,” a national

morals take priority—the most or the least conservative. Applying the most conservative standard would necessarily curtail a great deal of speech that is inoffensive to the majority; applying the least would effectively render the test unnecessary, because everything would pass it. A national standard ultimately poses as many problems as a local one, and subjective reactions to a work would still be the lynchpin of the analysis. Whether local or national, a community standard allows a majority veto on minority speech—precisely what the First Amendment seeks to protect against.

Rather, a regulation in any given community should succeed only if it passed strict scrutiny, and that would require more than simply demonstrating that the values of that community are particularly conservative. As in other areas of content-based speech regulation, the analysis would focus on actual harm. If the government could prove a tangible harm, it is likely that such a harm could be proven and applied consistently across the board, in any community—because that harm would no longer be tied to something as elusive as the moral code of a given physical location.

## CONCLUSION

Justice Holmes cautioned that “the taste of any public is not to be treated with contempt.”<sup>158</sup> The *Miller* test is ill-equipped to discern both who that public is, and what its tastes might be. First Amendment obscenity doctrine should be universal and applicable enough that it can carry the load, without IP making up its own rules. If *Miller* is not working in an area where it really matters, in businesses where intellectual property is disseminated or bought and sold online, then it is neither practical nor effective. And *Miller* is a conjunctive test—something must meet all three prongs to be deemed obscene—so if one prong is unworkable in today’s digital marketplace, the entire test is unworkable. The IP regimes should be in alignment, and trademark law should be able to support its policy goals while relying on a test that does not restrict more speech than necessary. First Amendment speech protections were designed to protect unpopular minority opinions and expression that offends. As Justice William Brennan stated, “If there is a bedrock principle underlying the First Amendment, it is that the government

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standard may be the only way to constitutionally regulate the Internet); Tim K. Boone, *The Virtual Network: Why Miller v. California’s Local Community Standard Should Remain Unchanged in the Wake of the Ninth Circuit’s Kilbride Decision*, 6 LIBERTY U. L. REV. 347, 375-76 (2012) (arguing that despite the many advocates for a national standard, the existing local community standard works because the third prong of *Miller* works as a check against the most prudish communities and jurors).

158. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 252 (1903).

may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.”<sup>159</sup> Even under the dubious proposition that, as a culture, we uniformly believe that obscenity holds no value, the “bedrock principle” that Justice Brennan refers to dictates that we protect it. No matter how disagreeable we might find obscenity to be (or how much we dislike the purveyors of the very extreme Extreme Associates films), one thing is certain: we value our freedom of speech—we routinely cite the protection of that right as the reason we go to court and go to war, even and especially when we do not agree with the speech itself. Curtailing the right to say and do unpopular things flies in the face of this notion; to square it with obscenity, we need a complete overhaul of a doctrine that has become obsolete.

Even hate speech, such as cross burning and other racist speech, is protected expression subject to strict scrutiny; courts are not willing to impose a content-based ban on such speech based on the audience’s potential reaction to it (which is, of course, exactly what is considered under *Miller*).<sup>160</sup> Courts have upheld the rights of Nazis and the Klu Klux Klan,<sup>161</sup> for instance, rejecting moral outrage as a basis for regulating speech. Recognizing that obscenity—consumed by willful, consenting adults—is not the moral equivalent of cross burning or other (fully protected) hate speech, it should be banned only where the government can pass strict scrutiny, just as with any other content-based restriction on speech. And trademark law restricts even more speech than *Miller* itself allows, which raises serious First Amendment concerns in addition to the issues such restrictions pose within the IP arena.

The First Amendment, designed to protect offensive speech, recognizes broader protections of expression than for actions. It is only with regard to obscenity that the notion is reversed: the law criminalizes the representation of sex far more expansively than the behavior itself.<sup>162</sup> The government should be required to justify banning speech on more than the vague notion of a moral code; it should be required to prove that the speech causes tangible, concrete harms and that its regulations are narrowly tailored to prevent those harms without restricting more speech than necessary.

In his *Miller* dissent, Justice Douglas said, “The idea that the First Amendment permits punishment for ideas that are ‘offensive’ to the

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159. *Texas v. Johnson*, 491 U.S. 397, 414 (1989).

160. *See R.A.V. v. City of St. Paul, Minn.*, 505 U.S. 377 (1992).

161. *See Nat’l Socialist Party v. Village of Skokie*, 434 U.S. 43 (1977); *Brandenburg*, 395 U.S. 444.

162. David Cole, *Playing by Pornography’s Rules: The Regulation of Sexual Expression*, 143 U. PA. L. REV. 111, 114 (1994).

particular judge or jury sitting in judgment is astounding. No greater leveler of speech or literature has ever been designed. To give the power to the censor . . . is to make a sharp and radical break with the traditions of a free society.”<sup>163</sup> If, as a free society, we are comfortable allowing obscenity law to act as such a leveler of speech, shouldn’t we have a test that actually works?

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163. *Miller v. California*, 413 U.S. 15, 44 (1973) (Douglas, J., dissenting).

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