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Supreme Court: You Can Trademark Whatever the ®®®® You Want (Maybe?)

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On June 24, 2019, the Supreme Court's decision in *Iancu v. Brunetti*, 588 U.S. __ (2019), struck down the Lanham Act's ban on registering "immoral" or "scandalous" marks, furthering the recent line of Supreme Court decisions that reaffirm the importance of the First Amendment right to freedom of speech, and also further opening the doors to federal registration of colorful marks.

Background – Striking Down the Bar on Registration of "Disparaging" Marks

Two years ago, in *Matal v. Tam*, 137 S. Ct. 1744 (2017), the Supreme Court struck down the portion of the Lanham Act's ban on registering marks that "disparage" any person. The Court held that viewpoint-based bars to registration are unconstitutional under the Free Speech clause of the First Amendment. The Court further held that the Lanham Act's disparagement bar was viewpoint-based, and therefore unconstitutional. The *Tam* case removed the barrier to trademark registration for the name of the Asian-American dance-rock band "The Slants." Additionally, the *Tam* case had timely implications for Pro Football's Washington Redskins (as previously reported here and here).

Court Strikes Down Ban on Registration of "Immoral" and "Scandalous" Marks

The Court's decision in *Brunetti,* continued the work it began in the *Tam* case by addressing two neighboring provisions of the Lanham Act barring registration of "scandalous" and "immoral" marks. In *Brunetti*, the Court reaffirmed that viewpoint-based bars to registration are unconstitutional under the Free Speech clause of the First Amendment by holding that the Lanham Act's ban on registration of "immoral or scandalous" marks is also viewpoint-based, and therefore unconstitutional.

The trademark applicant, Erik Brunetti, is the founder of a clothing brand called FUCT. For what it is worth, Brunetti claims to pronounce the mark as four discrete letters, "F-U-C-T." However, regardless of Brunetti's intent, the Court observed the "common perception" that the mark is in practice pronounced as "the equivalent of the past participial of a well-known word of profanity."

The Court did not need to decide whether a viewpoint-based bar to registration is unconstitutional, as it already resolved that issue two years earlier in *Matal v. Tam*. The Government agreed that under *Tam* it may not "deny registration based on the views expressed" by a mark because "the criteria for federal trademark registration" must be "viewpoint-neutral to survive Free Speech Clause review." Instead, the Government tried to defend the "immoral or scandalous" criterion in the Lanham Act was viewpoint-neutral, and the Court disagreed.

The test that the USPTO generally applies to the "immoral or scandalous" bar asks whether a "substantial composite of the general public" would find the mark "shocking to the sense of truth, decency, or propriety"; "giving offense to the conscience or moral feelings"; "calling out for condemnation"; "disgraceful"; "offensive"; "disreputable"; or "vulgar." As to the FUCT mark, the USPTO Examining Attorney determined that the mark was "totally vulgar." On review, the Trademark Trial and Appeal Board found the mark "highly offensive" and "vulgar," with "decidedly negative sexual connotations." According to the Board, imagery on Brunetti's website

and content near the FUCT mark demonstrated "extreme nihilism" and "anti-social behavior," and that the mark communicated "misogyny, depravity, [and] violence."

Testing the statute together with the typical dictionary definitions of "immoral" and "scandalous," the Court found that "the Lanham Act allows registration of marks when their messages accord with, but not when their messages defy, society's sense of decency or propriety." Such a viewpoint bias in the law results in viewpoint-discriminatory application. To demonstrate that bias, the Court pointed to a sampling of marks that the USPTO inconsistently allowed or rejected, and the only way to reconcile the results is an acknowledgement of a viewpoint bias. The examples identified by the Court are instructive and fascinating, but explicitly listing them in this alert would likely result in a rejection by most email servers.

A unanimous Court found that the term "immoral" is necessarily viewpoint-based, but a minority of the Justices tried to defend that the "scandalous" bar is ambiguous and open to an interpretation consistent with the Government's position that it could be viewpoint-neutral. The Government supported, and the dissent would have accepted, a viewpoint-neutral interpretation of the statute to bar "marks that are offensive [or] shocking to a substantial segment of the public because of their *mode* of expression, independent of any views that they may express." However, the majority of the Court did not accept that proposal "because the statute says something markedly different."

Impact of Decision

The *Brunetti* case is another viewpoint-based evisceration by the Court of trademark registration bars under the Lanham Act. Additionally, as a First Amendment case, it is a rare opportunity for relative ideological unity in an otherwise divided Court. However, *Brunetti* is not an open door for "foul-mouthed" entrepreneurs looking to capitalize on newly opened territories for four-letter word registrations that are no longer prohibited. For one, there remain a number of other viewpoint-neutral (and content-neutral) barriers to trademark registration that are consistent with the fundamental requirements of trademark law, such as that a mark be used in commerce to indicate the source of the goods or services to function as a trademark, or that the mark not serve a "merely ornamental" purpose. Additionally, some of the Justices signaled that there could be viewpoint-neutral bars to registration that could prohibit registration of "vulgar" marks without violating the First Amendment. However, such language is not presently in the Lanham Act today, and an amendment by Congress would be required before the Government is allowed to prohibit registration of a trademark on the basis of its vulgarity alone.