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Trademark Trouble: When the F-Word Fails to Function

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Recent Supreme Court decisions underscore how viewpoint-based refusals of trademark applications are unconstitutional. But can these viewpoint-based refusals survive under the "failure-to-function" doctrine instead?

Background: Supreme Court Struck Down Bar on Registration of "Disparaging," "Immoral," and "Scandalous" Marks

Eight years ago, in *Matal v. Tam*, 137 S. Ct. 1744 (2017), the United States Supreme Court struck down the Lanham Act's bar on registering trademarks that "disparage" persons, institutions, beliefs, or national symbols. The Court's decision in *Tam* was in response to the United States Patent and Trademark Office (USPTO)'s refusal to register an Asian American band's name, "THE SLANTS." There, the Court held that: (1) viewpoint-based trademark restrictions are unconstitutional under the First Amendment's Free Speech Clause; and (2) the disparagement clause was viewpoint-based and, therefore, unconstitutional.

Two years later, in *Iancu v. Brunetti*, 588 U.S. 388 (2019), the Supreme Court heard Erik Brunetti's challenge to a neighboring provision of the Lanham Act: the ban on registering "immoral or scandalous" marks. In that case, Brunetti sought to register the name of his clothing brand "F-U-C-T." While pronounced as four discrete letters, the government alleged that the applied-for mark was "the equivalent of the . . . past participle form of a well-known" obscenity. There, the Court held that the bar on registering "immoral or scandalous" trademarks constituted viewpoint discrimination and was, consequently, a violation of the First Amendment.

The USPTO Subsequently Invoked the "Failure-to-Function" Doctrine as a Basis for Refusing Brunetti's Applications for "F***"

In addition to his application for the mark "FUCT," Erik Brunetti filed four intent-to-use applications for the mark "F***" (spelled and pronounced as the present tense form of FUCT) in connection with various consumer goods and associated retail store services. While Brunetti's application for the mark "FUCT" was pending before the Supreme Court in *Iancu v. Brunetti*, his concurrent intent-to-use applications for F*** were suspended by the examining attorney assigned to review the applications. Upon resolution of *Brunetti*, the USPTO examining attorney re-examined the applications and subsequently refused registration based on a conclusion that the applied-for mark "fails to function" as a trademark. Notably, this basis for refusal was not raised until after the Court's *Brunetti* decision, striking the "immoral or scandalous" basis of refusal as impermissibly viewpoint-based.

The Examiner Found That the Applied-For Mark is "Commonly Used" and Thus Less Likely to be Perceived as a Source Identifier

In support of the foregoing "failure-to-function" refusals, the examining attorney offered evidence in the form of articles and dictionary definitions, which, according to the examiner, "illustrates that the term is commonly used as a versatile expression conveying a wide range of emotion, from disdain to joy." *See* Examiner's Brief Filed with the Trademark Trial and Appeal Board at p. 12, available here. The examining attorney argued that "[b]ecause consumers are accustomed to seeing this term or expression commonly used in everyday speech

by many different sources, they would not perceive the use of the term as a mark identifying the source of Applicant's goods and/or services but rather as only conveying an informational message or sentiment."

The Examiner Relied on Evidence Showing Ornamental Use of the Applied-For Mark

The examiner also sought out and relied upon evidence from third-party sources such as Amazon and Etsy to show the word "F***" used in a decorative or ornamental fashion on several of the goods listed in Brunetti's applications, including phone cases, jewelry, wallets, and tote bags. The examiner explained such evidence "illustrates that many competitors use the term as an informational message on jewelry, bags, phone cases, and many other items" and that "[t]o allow the Applicant to appropriate the term for its proposed goods and services would prevent competitors from using the commonplace term to promote their own goods and services."

The Refusal Survived Appeal

The Trademark Trial and Appeal Board (TTAB or Board) upheld the examiner's refusal of the marks based on a failure to function. In doing so, the Board found that the evidence of record establishes that the applied-for word "F***" expresses well-recognized familiar sentiments and that relevant consumers are accustomed to seeing the word in widespread use on the types of goods identified in Brunetti's applications. Accordingly, the Board concluded that the word "F***" does not function as a trademark distinguishing Brunetti's goods and services in commerce.

Brunetti Asserted "Failure-to-Function" is a "Novel" Doctrine Used to Circumvent Bans on Viewpoint-Based Refusals

In response to the Board's decision, Brunetti asserted that failure-to-function is an "invalid" substantive refusal lacking statutory basis. Brunetti accused the USPTO of weaponizing a *procedural* doctrine to "evade the Supreme Court's decisions" in *Tam* and *Brunetti*, thereby creating a new backdoor *substantive* doctrine.

Under this well-established procedural doctrine, if a submitted specimen "demonstrates merely ornamental use" of an applied-for mark, then the USPTO can issue a refusal of the mark for failing to function as a trademark. In his briefings, Brunetti argued that the USPTO has since expanded this procedural refusal to create a "novel, substantive doctrine" under which some words can never be registered. He noted that "it was not a coincidence" that these same words "would have been refused under Section 2(a) prior to *Tam* and *Brunetti*."

In addition to asserting that the new failure-to-function doctrine was invalid, Brunetti contended that it lacked consistent standards and contradicted "fundamental principles of trademark law." Brunetti alleged that the refusals of his applications were "predetermined," as evidenced by the USPTO's continuous "discovery of new grounds."

Illustrating this point, Brunetti pointed to the justifications offered by the USPTO for why "F***" could not be registered and explained how the evidence did not support their rationale. Brunetti submitted that all of the USPTO's evidence of "use" was ornamental, which cannot "preclude a term from being perceived as a trademark." On the contrary, Brunetti pointed to examples of other "widely used" words and phrases that are registered: "LOVE," "APPLE," and "DELTA." Consequently, Brunetti argued that if the USPTO's approach was correct, these words should also be unregistrable.

Federal Circuit Expressed Skepticism During Oral Arguments

On March 10, 2025, a panel of Federal Circuit judges heard oral arguments on behalf of Mr. Brunetti and the USPTO.

During oral arguments, the court questioned how the USPTO could judge how a mark would be perceived by consumers, where, as here, the mark is not yet being used by the applicant in connection with its goods and services. Notably, in its briefing, the USPTO criticized Brunetti for failing to present evidence that consumers would perceive the word "F***" as a source identifier. However, when asked during oral arguments what type of evidence Brunetti was supposed to present to show consumer perception, the attorney for the USPTO failed to provide any examples. Instead, the USPTO's attorney opined that "it would probably be difficult given the nature of this particular proposed mark in the classes for which [Brunetti] has applied for it, to demonstrate that consumers are going to understand it as, as a trademark."

The court also expressed concern regarding the USPTO's apparent inability to articulate an established standard or rule for determining whether a designation fails to function as a trademark. With respect to the alleged commonality of the applied-for word "F***," one member of the Federal Circuit panel repeatedly asked the attorney for the USPTO how Brunetti's proposed mark differs from marks such as APPLE and SHELL. Another member of the panel seemed concerned that the USPTO's application of the "failure-to-function" doctrine in the instant case would allow examiners to invoke the doctrine as a means of refusing marks that are deemed to be scandalous.

Conclusion

The Supreme Court has consistently held that viewpoint-based trademark refusals are unconstitutional. Echoing concerns raised by the Federal Circuit, the lack of articulable standards – coupled with the USPTO's seemingly inconsistent application of the failure-to-function doctrine (or application at whim) – would lead a reasonable person to suspect that the substantive failure-to-function refusal asserted by the USPTO in denying Brunetti's trademark applications is being used as a backdoor approach to circumvent the Supreme Court's prohibition on viewpoint-based trademark refusals.

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