



MBHB *snippets* Alert

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Supreme Court Strikes Down Ban on Offensive Trademarks

By Eric R. Moran

Today, the U.S. Supreme Court issued an opinion in *Iancu v. Brunetti*, No. 18-302, finding that the Lanham Act prohibition against registration of scandalous or immoral trademarks violates the First Amendment of the U.S. Constitution. The *Brunetti* decision follows closely behind the Court's 2017 opinion in *Matal v. Tam*, which struck down the Lanham Act's prohibition of disparaging marks under similar First Amendment grounds.

In *Brunetti*, Erik Brunetti sought to register the trademark FUCT for use in connection with a clothing line. Although, according to Brunetti, the mark is pronounced as four letters F, U, C, T, the U.S. Patent and Trademark Office ("USPTO") read it as "the equivalent of [the] past participle form of a well-known word of profanity" and determined that the mark was "vulgar" and had "decidedly negative connotations." The USPTO, accordingly, refused registration under 15 U.S.C. § 1052(a), which prohibits registration of marks that consist of or comprise "immoral" or "scandalous" matter.

On appeal to the Trademark Trial and Appeal Board ("TTAB"), the TTAB reviewed evidence of use of the mark. The TTAB "found that Brunetti's website and products contained imagery, near the mark, of 'extreme nihilism' and 'antisocial' behavior," and that "the mark communicated 'misogyny, depravity, [and] violence.'" The TTAB found "no question" that the mark is "extremely offensive," and affirmed the Examining Attorney. On appeal from the TTAB, the Court of Appeals for the Federal Circuit found the Lanham Act prohibition to violate the First Amendment.

In *Brunetti*, Justice Kagan wrote for the Court and referred immediately to its 2017 decision in *Tam* that the disparagement clause of section 1052(a) violates the First Amendment's Free Speech Clause. In *Tam*, a musician, Simon Tam, applied for federal registration with the

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USPTO in 2011 for the mark THE SLANTS for use in connection with his Asian-American rock band. The USPTO found that the mark would be disparaging to those of Asian descent and refused to register the mark. The U.S. Supreme Court, however, held that the disparagement clause violated the First Amendment “because it discriminated on the basis of viewpoint.”

In particular, in *Tam*, the eight-Justice Court split between two non-majority opinions. Although the Justices did not agree on the overall framework for deciding the case, they all agreed on two propositions: “First, if a trademark registration bar is viewpoint-based, it is unconstitutional. . . . And second, the disparagement bar was viewpoint-based.” As summarized in *Brunetti*, the Court held in *Tam* that “[t]he government may not discriminate against speech based on the ideas or opinions it conveys.”

In *Brunetti*, the Court turned to these propositions to analyze the “immoral” and “scandalous” clauses of the same Lanham Act provision. According to the Court, “[i]f the ‘immoral or scandalous’ bar similarly discriminates on the basis of viewpoint, it must also collide with our First Amendment doctrine.” The question becomes, according to the Court, is the “immoral or scandalous” test viewpoint-neutral or viewpoint-based?

The Court held viewpoint-based, and that the “immoral or scandalous” clause of the Lanham Act “results in viewpoint-discriminatory application.” The Court pointed out that the USPTO has used the clause to refuse registration of “marks communicating ‘immoral’ or ‘scandalous’ views about (among other things) drug use, religion, and terrorism. But all the while, it has approved registration of marks expressing more accepted views on the same topics.” The Court further found that the “immoral or scandalous” bar broadly “covers the universe of immoral or scandalous—or . . . offensive or disreputable—material,” and was not moved that some applications of the clause may be permissible.

In sum, the Court held that the bar is “substantially overbroad”:

There are a great many immoral and scandalous ideas in the world (even more than there are swearwords), and the Lanham Act covers them all. It therefore violates the First Amendment.

Kagan, J., delivered the opinion of the Court, in which Thomas, Ginsburg, Alito, Gorsuch and Kavanaugh, JJ., joined. Alito, J., filed a concurring opinion. Roberts, C. J., and Breyer, J., filed opinions concurring in part and dissenting in part. Sotomayor, J., filed an opinion concurring in part and dissenting in part, in which Breyer, J., joined.

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The opinion can be found at https://www.supremecourt.gov/opinions/18pdf/18-302_e29g.pdf.

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