On June 24, 2019, the US Supreme Court clarified that the Lanham Act’s bar on “immoral” or “scandalous” trademarks violates the First Amendment because it discriminates based on viewpoint. The decision followed the Supreme Court’s decision in *Matal v. Tam* in 2017, which struck down the Lanham Act’s bar against “disparaging” trademarks. The Court held that the United States Patent and Trademark Office (USPTO) cannot refuse trademark registration to an applicant purely because the mark is “immoral” or “scandalous.” While six Justices concurred in this result, Justice Alito wrote a separate concurrence, and three Justices wrote separate opinions concurring in part and dissenting in part. Trademark registration applicants now need not be concerned with the “immoral” or “scandalous” bar in 15 U.S.C. § 1052(a).

**Background on the Dispute between Brunetti and the US Patent and Trademark Office**

Erik Brunetti founded the clothing brand “fuct” in 1990. Two individuals filed an intent-to-use application for the mark “FUCT” for several types of apparel in 2011, and assigned the application to Brunetti, who then amended the application to allege use of the mark. The examining attorney refused to register the mark because “fuct” is the phonetic equivalent of the past tense of a vulgar word. The examining attorney found that the mark comprised immoral or scandalous matter under Section 2(a) of the Lanham Act, which provides as follows: “No trademark … shall be refused registration on the principal register on account of its nature unless it … consists of or comprises immoral … or scandalous matter.”

Brunetti requested reconsideration and appealed to the Trademark Trial and Appeal Board. The examining attorney denied reconsideration, and the Board affirmed. On appeal, the US Court of Appeals for the Federal Circuit reversed the Board’s holding. The Federal Circuit relied on *Tam*, noting that the First Amendment extends to private expression that is “offensive to a substantial composite of the general public,” and the government failed to offer a substantial interest for policing offensive speech in the context of a registration program such as the trademark registration system.

The Supreme Court granted certiorari because a lower court invalidated a federal statute.

**Supreme Court: Lanham Act’s Bar on Registration for “Immoral” or “Scandalous” Marks Violates the First Amendment**

In a 6-3 decision, the Supreme Court affirmed the Federal Circuit’s decision and held that First Amendment protections barred the USPTO from denying...
trademark registration on the grounds that the mark is immoral or scandalous.

To reach this conclusion, the Court first acknowledged its decision in *Matal v. Tam* two years ago. The *Tam* Court held that a trademark registration bar that is viewpoint-based is unconstitutional, and struck down the disparagement bar as unconstitutional for being viewpoint-based. The *Brunetti* Court undertook a similar inquiry — is the “immoral or scandalous” bar viewpoint-neutral such that it does not violate the First Amendment?

The Court found the “immoral or scandalous” bar to be viewpoint-based, thus violating the First Amendment. After considering several dictionary definitions of “immoral” and “scandalous,” the Court concluded that the statute facially distinguishes between ideas aligned with “conventional moral standards” and ideas “hostile” to “conventional moral standards.” Such a facial viewpoint bias led to “viewpoint-discriminatory application.” The Court cited examples where the USPTO has approved registration of marks “expressing more accepted views on [a] topic[],” while denying registration to marks expressing “immoral” or “scandalous” views on the same topic.

The Court pointed out one such instance, in which the USPTO denied registration for “YOU CAN’T SPELL HEALTHCARE WITHOUT THC” while approving “SAY NO TO DRUGS – REALITY IS THE BEST TRIP IN LIFE.” In another instance, the USPTO approved registration of “JESUS DIED FOR YOU” on clothing while denying “BONG HITS 4 JESUS.” Noting that the trademarks that were denied registration were offensive to many Americans, the Court reiterated its holding in *Tam* that a “law disfavoring ‘ideas that offend’ discriminates based on viewpoint.” Justice Alito also cautioned that laws banning speech “deemed by government officials to be ‘immoral’ or ‘scandalous’ can be easily be exploited for illegitimate ends.”

In its arguments before the Court, the USPTO sought to narrow the immoral or scandalous bar to “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,” but the Court rejected this interpretation as asking the Court to rewrite a law to “conform to constitutional requirements.” Referencing *Tam*, the Court noted that it did not compare “permissible and impermissible applications [of the statute],” because the finding of viewpoint bias ended the Court’s inquiry. Justice Kagan summarized the Court’s holding succinctly — there are many immoral and scandalous ideas in the world, which are all covered by the Lanham Act, so the overbreadth of the statute violates the First Amendment.

**Concurrences and Dissents in Part: “Immoral” bar is unconstitutional, but not the “scandalous” bar**

The dissenting Justices agreed with the Court that the “immoral” bar violates the First Amendment, but dissented regarding the majority’s interpretation of the
“scandalous” bar.

Justice Sotomayor pointed out that under multiple dictionary definitions, scandalous marks need not be immoral, but can be merely “indecent, shocking, or generally offensive.” Thus, a reasonable limiting construction of the “scandalous” bar would apply only to “offensive modes of expression,” but not “offensive ideas.” The language of the statute includes “scandalous,” “immoral,” and “disparage,” where “disparaging” marks are those which offend because they deride a particular person or group, and “immoral” marks are those that offend because they transgress widely held moral beliefs. Thus, Congress must have intended for “scandalous” marks to have a different definition – “marks that offend in the mode of communication rather than the idea.” The majority should not have collapsed “immoral” and “scandalous,” especially since they are separated by the unrelated word “deceptive” in the statute. Thus, the “scandalous” bar should be limited to “swear” words that “cause a visceral reaction, that are not commonly used around children, and that are prohibited in comparable settings.”

Justice Sotomayor also noted that the stakes in Brunetti’s situation were lower than if there were threats to Brunetti’s liberty or his right to use his mark in commerce, and the Court has previously applied a reasonable limiting construction to “avoid constitutional infirmities.” She held that a reasonable limiting construction of “scandalous” rendered the bar “a viewpoint-neutral kind of discretionary governmental program or limited forum.” A regulation is not viewpoint discriminatory just because it has an “incidental effect” on a certain subset of view, and restrictions on particular modes of expression do not automatically constitute viewpoint discrimination. Thus, “fighting words” may not be extended First Amendment protection since the mode of expressing an idea may be “intolerable.” “Fighting words” can be seen as similar to obscene, vulgar, or profane trademarks, and treating these marks as viewpoint discrimination goes against “decades of precedent.”

Justice Sotomayor then recognized that the federal trademark registration system was “collateral to the existence and use of trademarks themselves,” and the Court has traditionally labeled such government initiatives as either a “limited public (or nonpublic) forum” or “government programs or subsidies.” Under both labels, viewpoint-neutral content discrimination is permissible, and barring obscene, profane, or vulgar marks falls within reasonable viewpoint-neutral content discrimination, and the government has a reasonable interest in not lending support to such marks.

Chief Justice Roberts further emphasized that no free speech is being restricted under these bars, because federal trademark registration confers certain benefits, but does not preclude the trademark owner from using the mark in commerce to identify goods. The federal government is not required to enable such “obscene, vulgar, and profane” modes of expression.

Justice Breyer expressed his concerns that the Court’s “category-based
approach” to the First Amendment has been overly rigid. Stating that the “First Amendment is not the Tax Code,” he noted that the relevant inquiry should be whether the regulation “works speech-related harm that is out of proportion to its justifications.” It is unclear whether the Lanham Act regulates expressive speech or pure commercial speech, as trademarks may comprise both components. It is also unclear whether the statute regulates government speech, because the federal government is “loosely associated” with the mark through federal registration. He further noted Brunetti’s similarity to a “limited public forum” and cases “involving government subsidies for private speech,” concluding that the statute does not “clearly fit within any of the existing outcome-determinative categories.”

Justice Breyer further noted that vulgar or obscene words “evoke powerful emotions,” but fail to convey a particular viewpoint. He emphasized that trademark registration applicants should “expect linguistic regulation,” because this provision of the Lanham Act forbids trademark registration for words that, for example, are likely to cause confusion or are merely descriptive. The government also has an interest in protecting children’s sensibilities, not being associated with vulgar and obscene marks, and disincentivizing the use of such marks in commerce, because such highly vulgar words have a “physiological and emotional” impact that may “threaten to distract consumers and disrupt commerce.” Thus, although he agreed with the Court that the “immoral” bar violates the First Amendment, he believed that the “scandalous” bar should be upheld, and the USPTO should have the latitude to apply the “scandalous” bar to deny registration to vulgar marks.

Potential Impact of the Court’s Decision

The Court’s Brunetti decision makes clear to trademark registration applicants that trademarks may no longer be denied registration on the grounds that the marks are “immoral” or “scandalous.” The USPTO may see a surge in trademark registration applications as trademark owners rush to file applications for their “immoral” or “scandalous” trademarks. Although federal trademark registration confers certain ancillary benefits, the use of “immoral” or “scandalous” marks may not be in the business interests of the trademark owner, however. The USPTO has been just one bar to widespread use of “immoral” and “scandalous” marks – the marketplace may not take to such marks simply because they are federally registered.

In his concurring opinion, Justice Alito invited Congress to draft a statute focusing on barring the registration of trademarks “containing vulgar terms that play no real part in the expression of ideas.” According to Justice Alito, such a statute would deny Brunetti trademark registration since the mark “generally signifies nothing except emotion and a severely limited vocabulary.” But without a change in the statute, “immoral” and “scandalous” marks are here to stay.
Section 2(a) is “F**T” – the US Supreme Court strikes down the bar on “immoral” or “scandalous” trademarks
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