New Law: Federal Circuit Finds Ban On Scandalous/Immoral Trademarks Unconstitutional

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As part of a now-infamous 1972 monologue, comedian George Carlin listed the "Seven Words You Can Never Say on Television," colorfully repeating each throughout his routine. While many of those words remain unacceptable for the airwaves, they may now be suitable for federal trademark registration, thanks to a recent decision from the Federal Circuit Court of Appeals.

Last month, the Federal Circuit issued its opinion in *In re: Brunetti*,[1] the first major decision analyzing Lanham Act Section 2(a) in the wake of the June 2017 decision in *Matal v. Tam*.[2] In *Tam*, the U.S. Supreme Court unanimously affirmed a Federal Circuit *en banc* decision striking down the Lanham Act's prohibition on the registration of "disparaging" trademarks. As was largely expected, the Court relied heavily on *Tam* to hold that a closely related provision prohibiting registration of "immoral" or "scandalous" marks also could not survive First Amendment scrutiny.

Appellant Erik Brunetti is a fashion designer who sells clothing under the brand FUCT. The U.S. Patent and Trademark Office (USPTO) refused registration for the brand, citing the Section 2(a) bar on immoral or scandalous marks. Brunetti appealed to the Federal Circuit Court of Appeals, arguing both that the TTAB lacked sufficient evidence that a substantial composite of the public would find the mark vulgar and that the Lanham Act's prohibition on immoral or scandalous marks was unconstitutional.

The government principally argued at the Federal Circuit that the ban is viewpoint-neutral and therefore constitutional, but the Court declined to consider that issue.

Applying strict scrutiny review, the Court found that the ban on immoral or scandalous marks is "based in the government's belief that the rejected mark conveys an expressive message—namely, a message that is scandalous or offensive to a substantial composite of the general population." It consequently held that the ban gives rise to content-based discrimination, which is unconstitutional.

This decision should survive any challenges in light of *Tam*. It overturns a century-old federal restriction on trademark registrations and will have significant ramifications for those seeking federal protection for edgy or offensive marks. The impact of this decision will extend well beyond Carlin's seven dirty words; indeed, the subjective nature of how to apply 2(a) has resulted in a wide swath of refused marks that now may be suitable for registration.[3] Examples include words or designs with sexual innuendos, referring to religious figures, or having a double meaning that includes a drug reference, regardless of whether such marks are intended to be humorous.

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[1] No. 2015-1109 (D.C. Cir. Dec. 15, 2017) (slip op.).

[2] 137 S. Ct. 1744 (2017).

[3] For a few examples of previously refused marks under the 2(a) ban on immoral and scandalous marks, *see, e.g.*, *In re Riverbank Canning Co.*, 95 F.2d 327, 329 (CCPA 1938) (MADONNA for

wine); *Ex parte Martha Maid Mfg. Co.*, 37 U.S.P.Q. 156 (Comm'r Pat. 1938) (QUEEN MARY for women's underwear); *In re Reemtsma Cigarettenfab- riken G.M.B.H.*, 122 U.S.P.Q. 339 (T.T.A.B. 1959) (SEaNUSSI [a Muslim sect that forbids smoking] for cigarettes); *In re Sociedade Agricola E. Comerical Dos Vinhos Messias, S.A.R.L.*, 159 U.S.P.Q. 275 (T.T.A.B. 1968) (MESSIAS for wine and brandy).