

Blog Post

# Supreme Court Holds Ban on Immoral or Scandalous Trademarks Unconstitutional

June 30, 2019

On June 24, 2019, the United States Supreme Court, in *Iancu v. Brunetti*, reviewing the trademark application for “FUCT,” held that the Lanham’s Act’s provision, prohibiting the registration of “immoral[] or scandalous” trademarks, 15 U.S.C. 1052(a)(1), violated the First Amendment to the United States Constitution. This blog has followed the evolving judicial views concerning “disparaging” trademarks, culminating in the Supreme Court’s decision in *Matal v. Tam*, 137 S. Ct 1744 (June 19, 2017) (our coverage can be found [here](#)) and the related issue of “immoral or scandalous” trademarks as last addressed by the Federal Circuit in *In re Brunetti*, 877 F.3d 1330 (Fed. Cir. 2017)([here](#)), and as to which the United States Supreme Court granted *certiorari*.

Respondent Erik Brunetti founded a clothing line that uses the trademark “FUCT.” In connection with that clothing line, he filed an application to have “FUCT” registered as a United States Trademark. Although Brunetti asserted that the mark was pronounced as four letters, one after the other – that is, F-U-C-T – the Court recognized, as did the examining attorney at the United States Patent and Trademark Office (USPTO) and the Trademark Trial and Appeal Board (TTAB), that it might be pronounced and read differently – that is, as the past participle of a well-known word of profanity. The USPTO and the TTAB – applying its test of whether a “substantial composite of the general public” would

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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” – denied registration, finding that the mark was “highly offensive” and “vulgar” and that the mark had “decidedly negative sexual connotations.” The TTAB also considered evidence of how Brunetti used the mark in context on Brunetti’s website and products and found that it communicated “misogyny, depravity, [and] violence.”

Brunetti appealed this determination to the Court of Appeals for the Federal Circuit, which found that the prohibition against registering immoral or scandalous marks violated the First Amendment. The Supreme Court affirmed, in an opinion by Justice Kagan, joined by Justices Thomas, Ginsburg, Alito, Gorsuch, and Kavanaugh.

The Supreme Court first reviewed its decision in *Matal v. Tam*, 137 S. Ct. 1744, 582 U.S. \_\_\_ (2017), which found unconstitutional the Lanham Act’s bar on the registration of “disparage[ing]” trademarks. The Court noted that although the eight-Justice Court divided evenly between two opinions and could not agree on the overall framework for deciding the case, all Justices agreed on two propositions. First, if a trademark registration bar is viewpoint-based, it is unconstitutional. Second, the disparagement bar was viewpoint-based. Thus, in *Tam*, the Justices found unanimous common ground in that the government may not discriminate against speech based on the ideas or opinions it conveys. Accordingly, the Court observed that, under *Tam*, that “[i]f the “immoral or scandalous” bar similarly discriminated on the basis of viewpoint, it must also collide with the First Amendment.”

The Court then reviewed the meaning of “immoral” and “scandalous” and found those terms “not mysterious.” The Court used dictionary definitions

of “immoral” and “scandalous” to lay bare the problem with the statute and found that the terms and the statute on its face “distinguishes between two opposed sets of ideas: those aligned with conventional moral standards and those hostile to them; those inducing societal nods of approval and those provoking offense and condemnation.” The Court explained that the statute favors the former, and disfavors the latter. The Court then found that the facial viewpoint bias in the law results in viewpoint discrimination, pointing out that the USPTO itself describes the “immoral and scandalous” criterion using much of the same language as the dictionary definitions that the Court cited. The Court also provided examples of how the USPTO allowed registrations when the mark was viewed as expressing more accepted values and views, and rejected registrations when the mark expressed a view offensive to many Americans.

Next, the Court considered the Government’s contention that the Court could uphold the constitutionality of the statute because it is “susceptible of” a limiting construction that would remove the viewpoint bias.” The Court rejected the “abstractly phrased” Government’s suggestion to narrow the statutory 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,” e.g., those that are lewd, sexually explicit, vulgar or profane. The Court based its rejection because, while the Court “of course, may interpret ‘ambiguous statutory language’ to ‘avoid serious constitutional doubts’, that canon of construction only applies when an ambiguity exists and, here, the Court would need to rewrite the law to conform it to constitutional requirements. Here, the Court could not see the Government’s proposal in its reading of the statute and, therefore, could not adopt such a construction. It found that the statute as written covers a universe of immoral or scandalous material, whether or not lewd or profane

Finally, the Court rejected the Government's attempt to invoke the Court's First Amendment overbreadth doctrine, and uphold the statute against facial attack because its unconstitutional applications are not substantial in comparison to the statute's legitimate applications. The Court noted that this doctrine had never been applied to a viewpoint discriminatory law and, in any case, found the statute substantially overbroad. Accordingly, the Court found the "immoral and scandalous" bar viewpoint-based and violative of the First Amendment.

Justice Alito, concurring, agreed with the majority, but noted that "[o]ur decision does not prevent Congress from adopting a more carefully focused statute that precludes the registration of marks containing vulgar terms that play no part in the expression of ideas [such as the mark at issue in Brunetti]."

Justice Sotomayor, joined by Justice Breyer, concurred in part and dissented in part from the majority opinion, believing it will lead to an "unfortunate" and "avoidable" "rush" to register "marks containing the most vulgar, profane, or obscene words and images imaginable." Justice Sotomayor believed that the "scandalous" provision should be narrowly construed to address only obscenity, vulgarity and profanity and, therefore, "a reasonable, viewpoint-neutral restriction on speech that is permissible in the context of a beneficial governmental initiative like the trademark registration system." Read this way, it would cover only offensive modes of communication and, therefore, not violate the First Amendment. Justice Sotomayor found the restriction reasonable because she felt that no speakers are harmed because, among other things, even if barred, Brunetti could use, own, and enforce his mark regardless of whether it has been registered. (Although Justice Sotomayor noted that there are benefits to registration that an owner of a registered trademark would have). As for the "immoral" portion of the provision, Justice Sotomayor agreed with the majority that there was

no tenable way to read the word “immoral” in a way to avoid a viewpoint-discriminatory meaning.

Chief Justice Roberts also concurred in part and dissented in part, agreeing that “the ‘immoral’ portion of the provision is not susceptible of a narrowing construction that would eliminate its viewpoint bias.” However, Chief Justice Roberts agreed with Justice Sotomayor’s opinion that the “scandalous” portion of the provision is susceptible to a narrowing construction to bar marks that offend because of their mode of expression – marks that are obscene, vulgar or profane.

Justice Breyer also concurred in part and dissented in part. Justice Breyer agreed with Justice Sotomayor that the “scandalous portion of the provision is susceptible of such a narrowing construction to refer only to “certain highly vulgar or obscene modes of expression,” but his reasoning differed from Justice Sotomayor. In his view, a category based, outcome determinative approach to the First Amendment, such as “viewpoint discrimination,” “content discrimination” or “commercial speech,” cannot adequately resolve the issue presented to the Court. Instead, Justice Breyer urged that it would be better to treat the Court’s speech-related rules as rules of thumb and ask whether the “regulation at issue ‘works speech-related harm that is out of proportion to its justifications.’” Based upon such proportionality analysis, Justice Breyer agreed with Justice Sotomayor that the statute “as interpreted by Justice Sotomayor” does not violate the First Amendment, as he found that “not much” harm befalls to the First Amendment by a bar on registering highly vulgar or obscene trademarks. However, Justice Breyer agreed with the majority opinion that the bar on registering immoral marks violates the First Amendment.

In light of these decisions, it will be interesting to see if there is, indeed, a rush to register “marks containing the most vulgar, profane, or obscene

words and images imaginable” (as Justice Sotomayor fears) and whether Congress tries to adopt “a more carefully focused statute that precludes the registration of marks containing vulgar terms that play no part in the expression of ideas” (as the concurring opinion of Justice Alito suggests), adopts some other limiting statute or does nothing, permitting the registration of every kind of mark, vulgar or otherwise, that meets the surviving requirements of the Lanham Act.

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