

**Keywords:** trademark registration, Lanham Act, immoral or scandalous speech, First Amendment

*Iancu v. Brunetti*

Supreme Court of the United States

No. 18-302

Decided June 24, 2019

**I. Facts**

Mr. Erik Brunetti is an artist and entrepreneur who founded a clothing line that uses the trademark FUCT, pronounced as four letters, one after the other (e.g., “F-U-C-T”), according to Mr. Brunetti. In 2011, Mr. Brunetti filed an intent-to-use application with the United States Patent and Trademark Office (“USPTO”) to trademark FUCT for various items of apparel. The USPTO rejected the application by equating FUCT to the past tense of the verb “fuck,” a word that is undoubtedly scandalous, thus making the mark, FUCT, also scandalous.

Mr. Brunetti appealed the rejection to the Trademark Trial and Appeals Board (“Board”). The Board noted in their decision that dictionary definitions clearly characterizes the word “fuck” as offensive, profane, or vulgar, and thus concluded that the mark is vulgar and therefore registrable under § 2(a). Mr. Brunetti then brought facial challenge to the “immoral or scandalous” bar in the Count of Appeals for the Federal Circuit which found the prohibition to violate the First Amendment. As usual when a lower court invalidates a federal statute, the count granted certiorari.

**II. Issue**

1) Is the “immoral or scandalous” criterion in Lanham Act viewpoint-neutral or viewpoint-based (e.g., representing an unconstitutional restriction of free speech)?

**III. Discussion**

**The Lanham Act’s bar on “immoral or scandalous” marks is an unconstitutional under the First Amendment, based on precedential analysis established in *Matal v. Tam*<sup>1</sup>, as held by the court.**

In *Matal v. Tam*, the court established that if a trademark registration bar is viewpoint-based, it is unconstitutional, therefore concluding that the disparagement bar in question was indeed unconstitutional because it was viewpoint-based. In particular, the disparagement bar did not permit registration of trademarks that were determined to be derogatory. This is the essence of viewpoint-based discrimination because the Government is only registering a subset of messages (e.g., the subset not found to be offensive). The bar thus violated the First Amendment principle that the Government cannot discriminate against ideas that offend. Thus, viewpoint discrimination doomed the disparagement bar.

In order for the “immoral or scandalous” marks provision of the Lanham Act to survive scrutiny, it must be viewpoint-neutral (as opposed to viewpoint-based). The court described how although the definitions of “immoral” and “scandalous” are not mysterious, particular application of the words as standards for registration is problematic. In the opinion, the court outlined an argument that relied on several definitions of “scandalous” to justify an assertion regarding how unpredictable registration under the Lanham Act currently is. For example, the mark, “YOU CAN’T SPELL HEALTH CARE WITHOUT THC” was rejected while the mark, “SAY NO TO DRUGS-REALTITY IS THE BEST TRIP,” was allowed. The court maintained that although the listed marks were obviously offensive to

<sup>1</sup> *Matal v. Tam*, No. 2015-1293 (Fed. Cir. June 19, 2017).

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some people in the country, *Tam* clearly established that a law disfavoring offensive ideas discriminates on viewpoint, and thus is also in violation of the First Amendment. The court ultimately decided that the immoral or scandalous bar of the Lanham Act is too broad, and thus is unconstitutional.

#### **IV. Conclusion**

The Court held that the Lanham Act's bar on registering "immoral or scandalous" matter is an unconstitutional restriction of free speech. The court maintained the holding of the Federal Circuit.

#### **V. Concurring Opinion – Alito**

In his concurring opinion, Alito stresses how now more than ever protecting against viewpoint discrimination is important. "At a time when free speech is under attack, it is especially important for this Court to remain firm on the principle that the First Amendment does not tolerate viewpoint discrimination." *Concurring Opinion*, page 1. Alito urges Congress to adopt "a more carefully focused statute that precludes the registration of marks containing vulgar terms that play no real part in the expression of ideas" since the court is "not legislators and cannot substitute a new statute for the one now in force." *Id.*

#### **VI. Concurring in Part, Dissenting in Part Opinions – Roberts, Breyer, Sotomayor**

In the concurring in part, dissenting in part opinion of Roberts, Roberts describes how during proceedings, the Government conceded that the "immoral or scandalous" provision is read broad enough to reach not only marks that offend because of their mode of expression (e.g., vulgarity and profanity) but also marks that offend because of the *ideas they convey*, and how the Government urged the provision be given a narrowing construction. *See Roberts Opinion*, page 1 (Emphasis added). Roberts emphasized that the court rejects the proposal to narrow the "immoral or scandalous" provision on the ground that it would rewrite the statute. However, Roberts also states that "refusing registration to obscene, vulgar, or profane marks does not offend the First Amendment." *Id.*, page 2. In conclusion, Roberts appears of the opinion that although the "immoral or scandalous" provision is unconstitutional due to being vague and inconsistently applied to non-applicable offensive ideas, Roberts would be in support of restricting profanity (e.g., true *obscene, vulgar, or profane marks*).

In the concurring in part, dissenting in part opinion of Breyer, Breyer agrees with Sotomayor and asserts that the court should interpret "scandalous" in the present statute to refer *only* to certain highly "vulgar" or "obscene" modes of expression. Breyer suggests that the First Amendment permits the Government to rely on this statute under the narrow definition to deny trademark registration because 1) more attention should be paid to the values which the First Amendment seeks to protect and not a strict, category-based analysis of statutes to determine constitutionality, and 2) refusing to register highly vulgar or obscene words is not viewpoint-based discrimination since these words do not typically convey a viewpoint. Breyer advocated for application of the question: "Does the regulation at issue work harm to First Amendment interested disproportionate in light of relevant regulatory objectives?"

In applying the simple question, Breyer concludes that not much harm would be done to the First Amendment by leaving the statute in place. In particular: 1) the Government leaves businesses free to use highly vulgar or obscene words on products, even next to registered non-highly vulgar or non-obscene marks, 2) the Government even lets business owners use the highly vulgar or obscene word as a

trademark, provided they forgo the benefits of registration, 3) trademark registration is inherently a restriction of speech since the Government prevents registration of marks that will cause confusion or are merely description (thus, already lacks complete freedom of speech), and 4) the Government has a role in protecting children and public sensibilities that should not be ignored. Breyer, in conclusion, agreed that “immoral or scandalous” provision is unconstitutional but should be retained in lieu of a more narrow reading of “immoral or scandalous” as “highly vulgar or obscene.”

In the concurring in part, dissenting in part opinion of Sotomayor, Sotomayor outlines a precedent-based justification for reading “immoral” separate from “scandalous.” Sotomayor and Breyer agree on a standard for “scandalous” that would permit the USPTO to restrict “the small group of lewd words or ‘swear’ words that cause a visceral reaction, that are not commonly used around children, and that are prohibited in comparable settings.” Sotomayor also discusses how a limiting construction in this case is appropriate since no major public liberties are at stake (e.g., since trademark registration is already an axillary benefit and not required to have a trademark and no parties are harmed by not having a registered trademark). Finally, Sotomayor discusses how the Government has an interest in not lending its support to marks that are obscene, vulgar, or profane. Sotomayor ends the opinion by citing a decision from 1895, “the cardinal principle of statutory construction is to save and not to destroy,” and explaining that the majority reading destroys the Lanham Act, while her reading would save it. In conclusion, Sotomayor advocated for a narrower construction.

## **VI. Appendix**

Excerpt from the Lanham Act:

### §1052 TRADEMARKS REGISTRABLE ON PRINCIPAL REGISTER; CONCURRENT REGISTRATION

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) *Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.*

**Lanham Act of 1946, 15 U.S.C. §1052(a)**

Example use of mark FUCT by Mr. Brunetti:

