

US to decide on the registrability of scandalous trademarks

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By the end of June, the US Supreme Court will have ruled on the registrability of scandalous and immoral marks in *Iancu (USPTO) v Brunetti* (No. 18-302).

The case raises the issue of whether, in light of free speech under the First Amendment, a ban on the trademark registration of “immoral” or “scandalous” marks should be struck down. Specifically, Section 2(a) of the Lanham Act, where it prohibits the registration of a mark that “consists of or comprises immoral, deceptive, or scandalous matter”.

The case is seen as the sequel to *Matal v Tam* (2017), where the Supreme Court invalidated the ban on the registration of “disparaging” trademarks (i.e. offending some category of persons or institutions) finding it unconstitutional in light of free speech. The overall rationale for the decision was that “speech may not be banned on the grounds that it expresses ideas that offend”, as remarked by Justice Samuel Alito (the mark was THE SLANTS, an Asian American dance rock band).

[Background to *Iancu v Brunetti*](#)

American designer, Erik Brunetti, had long sought to register “FUCTION”, a mark he’s been using in connection with a streetwear clothing line.



The USPTO denied registration finding the proposed mark vulgar and thus scandalous. The Trademark Trial and Appeal Board further affirmed the refusal. However, Brunetti appealed to the US Court of Appeals for the Federal Circuit (CAFC) arguing that: *i*) FUCT was not vulgar, *ii*) in any case, Section 2(a) does not expressly bar vulgar marks and *iii*) the “immoral or scandalous provision” was unconstitutional under the free speech clause.

Despite finding FUCT a vulgar term, the CAFC held that the mark could be registered (Fed. Circ. 2017). The CAFC argued that the prohibition was overly broad and that it had been inconsistently applied over the years. By citing the Supreme Court’s decision in *Matal v Tam*, the CAFC ruled that the ban on immoral or scandalous marks represented an unconstitutional content-based restriction of speech.

Constitutionality

In January, 2019, the Supreme Court agreed to review the CAFC’s decision and to rule on the constitutionality of Section 2(a), which prohibits the registration of immoral or scandalous marks.

The Supreme Court’s acceptance to review the decision came as a surprise to many IP practitioners as the issue was assumed not to be controversial after *Matal v Tam*. The latter case, however, left open whether free speech challenges to provisions of the Lanham Act should be subject to strict or intermediate scrutiny (two of the different constitutionality tests applied by US Courts).

In *Iancu v Brunetti*, the USPTO argues for the permanence of the “immoral or scandalous” provision. It claims that the provision does not restrict speech; it simply sets the conditions for the federal registration of marks.

While, Brunetti, argues for the invalidity of the ban on the registration of “immoral

or scandalous” marks, claiming that it constitutes a restriction of speech.

Among the several *amicus curiae* briefs filed with the Supreme Court, there is an interesting one supporting the argument that the provision banning immoral or scandalous marks should be made “void for vagueness” (available [here](#)). The authors’ performed analysis of over 3 million trademark applications in the U.S. showed an inconsistent application of the provision by the USPTO, with trademark registrations granted to some profane or vulgar marks but not to others.

This case is supposed to shed light on what type of trademarks can be expected to obtain registration in the US, by removing the uncertainties and unpredictability that surrounds restrictions against immoral and scandalous marks.

The striking down of the provision might hit the USPTO with numerous requests by businesses wishing to capitalise on a brand’s shock value. The proliferation of vulgar marks is something the CAFC itself finds “discomforting”, despite its decision in favour of Brunetti.

Moreover, the invalidation of the provision would further accentuate the different approaches adopted by the US and EU on this topic, discussed in this previous [blog post](#). The European Trademark law’s ban on the registration of trademarks that are “contrary to public policy or to accepted principles of morality” (art. 7 par. f, EUTMR) is apparently not viewed as challenging the principle of freedom of expression (Article 10, European Convention on Human Rights), essentially because a sign which is refused registration can still be used in business. It remains, however, that EU Member States could still prohibit, under their national laws, the use of signs which are in dubious taste, either if registration for such signs is denied or granted at European level.

Let’s wait and see what the Supreme Court has to say.