

Immoral and Scandalous Trademarks Are Now Allowed According to Today's U.S. Supreme Court Decision

Monday, June 24, 2019

On June 24, 2019, the Supreme Court handed down its decision in *Iancu v. Brunetti*, addressing whether, in light of its previous holding in *Matal v. Tam*, the Lanham (Trademark) Act's prohibition on registration of "immoral" and "scandalous" trademarks represents a violation of the First Amendment. Six justices joined the majority opinion, which held that both the immoral and the scandalous provisions of the Lanham Act do not square with the First Amendment and, thus, must be invalidated.

Respondent Erik Brunetti founded a clothing line that uses the trademark and brand name 'FUCTION'. When Brunetti attempted to register his trademark with the United States Patent and Trademark Office (USPTO), the registration was denied on the grounds that the mark was "a total vulgar" and therefore could not be registered. Brunetti appealed, arguing that, particularly in light of *Tam* (which held that the disparagement clause of the Lanham Act represented a First Amendment Violation), the Lanham Act's exclusion of immoral and scandalous marks as eligible for federal registration by the USPTO also represented unconstitutional viewpoint discrimination.

The government argued that the ban on such marks was viewpoint-neutral, and, in any case, could be constructed in a limiting way such that the only prohibition would be to marks that are offensive or shocking due to their mode of expression, regardless of the views presented by the marks. Doing this, according to the government, would result in only vulgar—lewd, sexually explicit, and profane—marks being refused registration, which would make the prohibition constitutional.

The Supreme Court disagreed, explaining that "the statute says something markedly different". The Lanham Act, as written "does not draw the line at lewd, sexually explicit, or profane marks...[or] refer only to marks whose "mode of expression," independent of viewpoint, is particularly offensive." Moreover, the Supreme Court explained, while the Lanham Act clearly has a legitimate purpose, it is still not permitted to engage in viewpoint-based discrimination. As an illustration, the Supreme Court pointed to several contradictions by the USPTO when it came to attempts to register a trademark ('KO KANE' rejected as a trademark for beverages while 'SAY NO TO DRUGS—REALITY IS THE BEST TRIP IN LIFE' registered; 'BONG HITS 4 JESUS' refused registration due to the belief that "Christians would be morally outraged" but 'JESUS DIED FOR YOU' allowed registration on clothing).

Between *Tam* and *Brunetti*, the Lanham Act has now lost its ability to exclude a wide swath of potential trademarks. Previously, Examining Attorneys with the USPTO were permitted to refuse registration of a trademark, even if it was not phonetically equivalent to a curse word (as in the present case), if the Examining Attorney felt that the trademark was, or could potentially be, offensive or outside the "accepted" viewpoint. This is why 'BONG HITS 4 JESUS' was refused registration but 'JESUS DIED FOR YOU' was allowed; as the Supreme Court opinion notes, one mark suggests irreverence while the other suggests religious faith and, while some may find the first mark offensive, it is not the place of the USPTO to police what is and is not objectionable. Marks that are disparaging, explicit, immoral, and/or scandalous are now eligible for registration with the USPTO. Brunetti should now be granted federal registration for his clothing brand and enjoy the additional protections that come from having the USPTO backing a trademark.



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