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U.S. Supreme Court Strikes Down Ban on "Immoral" or "Scandalous" Trademark Registrations

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On June 24, 2019, the U.S. Supreme Court held in *Iancu v. Brunetti* that the Lanham Act's prohibition on registration of "immoral" or "scandalous" trademarks violates the First Amendment. The holding was in favor of Respondent Erik Brunetti, who had been denied a trademark registration for "FUCT" in connection with various clothing items.

This decision comes two years after *Matal v. Tam*, where the U.S. Supreme Court struck down the Lanham Act's prohibition on registration of marks that "disparage" others. In *Tam*, a plurality of the Court agreed that (1) viewpoint-based bars to trademark registration violate the First Amendment, and (2) the "disparagement" bar was viewpoint based.

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The majority opinion in *Brunetti*, authored by Justice Kagan and joined by Justices Thomas, Ginsburg, Alito, Gorsuch, and Kavanagh, stated that the "immoral" or "scandalous" bar is likewise unconstitutional because it similarly discriminates on the basis of viewpoint. The majority stated that the Lanham Act's bar on "immoral" trademark registrations "permits registration of marks that champion society's sense of rectitude and morality, but not marks that denigrate those concepts." The bar on "scandalous" trademark registrations "allows registration of marks when their messages accord with, but not when their messages defy, society's sense of decency or propriety." The majority noted that the U.S. Patent and Trademark Office ("PTO") has refused to register marks that communicate "immoral" or "scandalous" views about drug use, religion, and terrorism, while approving registration of marks that express more accepted views on the same topics.

The PTO argued that the Lanham Act could be limited to remove any viewpoint bias, and that the PTO could narrowly apply the "immoral" or "scandalous" bar to prohibit registration of marks that are "immoral" or "scandalous" due to their mode of expression, independent of any views that they may express. This approach would mostly restrict the PTO to refusing marks that are lewd, sexually explicit, or profane. The majority rejected this approach, however, stating that "[t]o cut the statute off where the Government urges is not to interpret the statute Congress enacted, but to fashion a new one."

Justices Roberts, Breyer, and Sotomayor each wrote opinions that concurred in part and dissented in part. All three dissenting Justices agreed that the prohibition on "immoral" material was unconstitutional, but each would have permitted a narrow viewpoint-neutral application of the prohibition against "scandalous" material to prohibit marks that are obscene, vulgar, or profane.

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