

Supreme Court: USPTO Ban on “Offensive” Trademark Registrations Unconstitutional

Tuesday, June 25, 2019

Once again, the US Supreme Court has rejected a federal ban on certain trademarks on the grounds that such a ban violates the First Amendment.

On June 24, the Court affirmed a US Court of Appeals for the Federal Circuit (“CAFC”) ruling finding in favor of clothing brand FUCT and founder Erik Brunetti and held that the US Patent and Trademark Office’s (“USPTO”) refusal to register the brand name under 15 U.S.C § 1052(a) was unconstitutional. Brunetti sought a federal trademark registration for “FUCT” in 2011, but the USPTO rejected the application after determining that the name is offensive and vulgar. Brunetti appealed to the CAFC, which reversed in 2017, finding that the USPTO correctly concluded that the mark did comprise immoral or scandalous matter, but the bar to registration under §1052(a) was nonetheless an unconstitutional restriction on free speech. The Supreme Court granted certiorari on January 4, 2019.

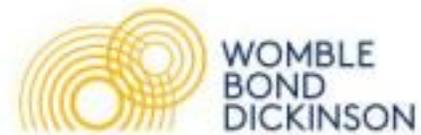
Justice Elena Kagan wrote for the 6-3 majority stating that the Lanham Act’s ban on immoral or scandalous marks is viewpoint discrimination rather than viewpoint-neutral, which violates the First Amendment’s right of free speech.

The Court provided examples of how the USPTO has historically engaged in viewpoint discrimination, and approved registrations for terms that may be considered more favorable or “aligned with conventional moral standards,” (such as “D.A.R.E. TO RESIST DRUGS AND VIOLENCE,” “PRAISE THE LORD,” for a game, and “WAR ON TERROR MEMORIAL”), and rejected those that “provoke offense and condemnation,” (such as “BONG HITS 4 JESUS,” “MADONNA” for wine, and “BABY AL QAEDA”). These USPTO practices create a gatekeeping function that refuses registration to a broad scope of immoral or scandalous marks, not just those that may be considered vulgar, lewd or sexually explicit, which the government may have an interest in protecting against.

The ruling in *lanu v. Brunetti* does for offensive trademarks what the Court’s 2017 ruling in *Matal v. Tam* achieved for disparaging trademarks. In *Matal*, the Court held that the USPTO cannot reject trademark registrations simply because the terms may be considered disparaging to particular groups. The dispute in question saw the rock band The Slants challenge the USPTO after the band was denied a trademark registration for its name. The USPTO’s justification for rejecting the claim was that the band’s name is taken from an offensive term for people of Asian heritage.

Similarly, in *Pro-Football, Inc., v. Amanda Blackhorse* (January 2018), the US Court of Appeals for the Fourth Circuit vacated a District Court ruling in favor of the §1052(a) bar for the Washington Redskins logo, remanding the case to the District Court for analysis in light of the *Matal* decision.

There are a few key takeaways from *Brunetti* and similar cases regarding immoral, scandalous and disparaging marks. First, registering marks that fall within any of these three categories will likely be met with far less resistance than in the past. Notwithstanding any other issues that may arise in the application process, a mark



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that might be considered immoral, scandalous, or disparaging should be eligible for registration now that §1052(a) has been found unconstitutional. Second, while many Justices were loath to interpret §1052(a) in a way that would make it constitutional, the Court nonetheless left open the possibility for Congress to amend the statute to narrowly fit the government's interest in prohibiting the registration of obscene or vulgar marks. So, while immoral, scandalous, and disparaging marks may now be cleared for registration, if Congress decides to step in, the Supreme Court seemed to suggest that legislation could be crafted to deny registration to profane marks on a "viewpoint neutral" basis. Finally, regardless of whether you think this is a good or bad decision, there is an opportunity here for brand owners to push the limits with their branding and marketing efforts, and we are sure to see applications for marks that are outside the comfort zone of many people.

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