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Trademark Practice Update: Scandalous? Immoral? It's all Good

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On December 15, 2017, the U.S. Court of Appeals for the Federal Circuit held that the Lanham Act's prohibitions on registering scandalous and immoral marks discriminated based on content, and violated the First Amendment (In re Brunetti, No. 2015-1109, 2017 WL 6391161 (Fed. Cir. 2017). The decision was not unexpected, given the U.S. Supreme Court's ruling earlier this year in *Matal v. Tam*, which similarly found the prohibition on disparaging marks to be unconstitutional (137 S. Ct. 1744 (June 19, 2017)).

What does this mean to brand owners? The ability to use a trademark was never at issue in either of these cases, simply the ability to protect a mark by federal registration. However, it will now be easier for the owners of disparaging, scandalous, and immoral brands to enforce their rights against infringers and counterfeiters. Federal registration provides notice of ownership, and certain presumptions in terms of ownership, validity, and exclusive rights as to the covered goods and services. Perhaps more importantly, federal registration allows the owner to record a registration with U.S. Customs and Border Protection, and can be used to enforce rights with online search engines, obtain social media user names, and used in combating online counterfeiting.

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Article By

[Monica Riva Talley](#)

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