



First Amendment Is a Friend U Can Trust to Register Offensive Trademarks

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On Monday, the U.S. Supreme Court struck down Federal law that allows the United States Patent and Trademark Office (?PTO?) to reject words and symbols that are considered immoral or scandalous, on grounds that it violates the First Amendment. This is another chapter in a battle against the second part of the same provision that prevents registration of allegedly racist or disparaging terms, like (the band) ?Slants? and (the football team) ?Redskins.?

In 2011, the PTO denied Erik Brunetti?s attempts to register the mark ?FUCTION? for his streetwear clothing line, claiming it was a profane and ?scandalous? term. According to Brunetti, in addition to a clever play on a vulgar word, FUCTION is actually an acronym for *Friends U Can?t Trust*.

Until the Redskins and Slants cases, the PTO?s FUCTION ruling was based on settled law. Section 2(a) of the Lanham Act (15 U.S.C. 1052(a)) bars registration of trademarks that comprise ?immoral? or ?scandalous? matter. This provision was in place for more than a century, until the owner of the band THE SLANTS challenged a neighboring part of section 2(a) that prevented marks ?which may disparage ? persons.? In *Matal v. Tam*, 582 U.S. ___ (2017), the Supreme Court struck down the ban on disparaging terms as unconstitutional, holding that the PTO could not deny an application for THE SLANTS based on the interpretation of the term as a racial slur.

Bolstered by the Slants case, Brunetti appealed the decision rejecting his trademark, arguing that the ban on immoral and scandalous terms similarly amounts to an unconstitutional restriction that violates freedom of speech. The PTO urged the Supreme Court to treat the first part of 2(a) differently than the ban on disparaging terms, telling the justices that the PTO could apply the ban in a limited way to marks that are lewd or profane in their mode of expression.

However, Justice Elena Kagan, writing for the majority, agreed with Brunetti and held that such restrictions infringe the First Amendment because they disfavor certain ideas, and the PTO could not selectively enforce a statute. ?The First Amendment does not allow the government to penalize views just because many people, whether rightly or wrongly, see them as offensive,? Kagan said before delivering the opinion.

Every justice agreed that the prohibition on "immoral" marks should be struck down, because it is viewpoint based by the definition of "immoral" as "inconsistent with rectitude, purity, or good morals." However, three justices penned dissents suggesting that the "scandalous" provision did not similarly violate the First Amendment. They argued that this provision could be construed to address only obscenity, vulgarity, and profanity from a neutral viewpoint.

Justice Alito also indicated that the decision does not prevent Congress from adopting a more narrowly focused statute that "precludes the registration of marks containing vulgar terms that play no real part in the expression of ideas." However, justices are not legislators and cannot create such narrow restrictions.

Entrepreneurs or businesses hoping to capitalize on marks that include foul language or marks that could otherwise be deemed immoral or scandalous are no longer left with Friends U Can't Trust by the Lanham Act. Unless Congress tweaks the law to more narrowly prohibit lewd, obscene or profane marks, profanity may not bar trademark registration, and the USPTO will likely encounter many more salty and vulgar trademark applications moving forward.

If you have additional trademark questions, please contact Amy Pruett and Jackie Knapp.

Related People

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