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## A Legislative Framework to Avoid a Vulgar Trademark System

JORDAN J. KILIJANSKI†

### INTRODUCTION

There has been a recent run on the United States Patent and Trademark Office to register the most vulgar and obscene trademarks possible.<sup>1</sup> After the Supreme Court's ruling in *Matal v. Tam* and *Iancu v. Brunetti* an individual is now able to register a trademark, to be used on their products and services, no matter how immoral, scandalous, or disparaging the trademark may be.<sup>2</sup> This result has left observers to view the new trademark registration system as FUCT®.<sup>3</sup>

A trademark is a device—such as words, names, or symbols—used by a merchant to identify its goods or services and to distinguish them from those of others.<sup>4</sup> Any person who uses a trademark belonging to

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1. *See, e.g.*, FUCK YOU PAY ME, U.S. Trademark Application Serial No. 88/358,352 (filed Mar. 27, 2019); PUSSY MONEY WEED, U.S. Trademark Application Serial No. 88/486,356 (filed June 24, 2019).

2. *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017); *Iancu v. Brunetti*, 139 S. Ct. 2294, 2299 (2019).

3. *Tam*, 137 S. Ct. at 1751; *Brunetti*, 139 S. Ct. at 2299; FUCT, Registration No. 5,934,763.

4. ROGER E. SCHECHTER & JOHN R. THOMAS, INTELLECTUAL PROPERTY: THE LAW OF

another in a way that is likely to confuse the consuming public about the source or sponsorship of the goods or services will be liable to the trademark holder.<sup>5</sup> Congress established a system that grants nationwide protection for federally registered trademarks, and incentivizes the promotion of trademarks in conjunction with high quality, or at least consistent quality, good and services.<sup>6</sup>

By allowing the registration of patently vulgar and obscene trademarks, these trademarks will soon become commonplace in the market, and consumers will be forced to wade through waters muddied with vulgarity to find the product they desire. While the majority of people may not want their sensibilities attacked while shopping, these vulgar trademarks will seep into commerce and on to the shelves of the local store because some people are attracted to these products. In a free market when the shop owner finds the point where appealing to the minority to sell a few items with vulgar trademarks will offset the profits lost by customers refusal to shop at that store, these vulgar marks will be displayed. The vast majority of people should not have to sacrifice their morality when shopping for groceries.

When Congress passed the Lanham Act of 1946, they codified the first set of extensive and cohesive federal trademark laws.<sup>7</sup> Prior to this codification there was basic federal and state level protection for trademarks, but the implementation of a federal registration system greatly expanded upon these protections.<sup>8</sup> The first subchapter of the Lanham Act, named the Principal Register, provides the basic requirements for eligibility for federal trademark registration, and a description of the application and registration process.<sup>9</sup> A trademark that meets the requirements of the Principal Register is afforded remedies for infringement under federal statute.<sup>10</sup>

In 2017, the Supreme Court held that a portion of the Principle Register of the Lanham Act was unconstitutional.<sup>11</sup> In *Matal v. Tam*, the

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COPYRIGHTS, PATENTS AND TRADEMARKS 539 (2003).

5. *Id.* at 541.

6. *See id.* at 546.

7. *A Guide to the Lanham Act of 1946*, LAWS (Dec. 23, 2019), <https://trademark.laws.com/lanham-act-of-1946/lanham-act-of-1946-background>.

8. *Id.*

9. *Id.*

10. *Id.*

11. *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017).

Supreme Court decided whether the federal law prohibiting registration of trademarks that may “disparage . . . or bring . . . into contemp[t] or disrepute” any “persons, living or dead” was constitutionally valid.<sup>12</sup> The Court weighed this federal law against the Free Speech Clause of the First Amendment and held that the provision was facially invalid under the Free Speech Clause.<sup>13</sup> The Court concluded that the provision of 15 U.S.C. § 1052(a) was contradictory to the bedrock First Amendment principle that “speech may not be banned on the ground that it expresses ideas that offend.”<sup>14</sup> Thus, the ruling in *Tam* invalidated a portion of the statute that determined whether trademarks were registrable on the Principal Register.<sup>15</sup> The statute no longer stated that trademark registration will be refused if the trademark were to consist of “matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”<sup>16</sup> This ruling then left the door open to challenge the other portion of § 1052(a) that states that a trademark will be refused registration if it “consists of or comprises immoral, deceptive, or scandalous matter.”<sup>17</sup>

The Supreme Court soon took on this provision of § 1052(a) by granting certiorari in the case of Erik Brunetti’s attempted registration of the mark “FUCTION.”<sup>18</sup> Here, the Court determined whether the prohibition on immoral or scandalous marks was constitutional in the light of the Free Speech Clause.<sup>19</sup> The Court held that the immoral or scandalous bar discriminates on the basis of viewpoint; thus, this bar violates First Amendment doctrine.<sup>20</sup> In doing so, the Court held that the “immoral or scandalous” bar in § 1052(a) is unconstitutional.<sup>21</sup>

During the *Brunetti* ruling, four Justices recognized the reaching impact of the ruling and offered various ways to save § 1052(a) so that it

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12. *Id.* at 1751; 15 U.S.C. § 1052(a).

13. *Tam*, 137 S. Ct. at 1751, 1755.

14. *Id.* at 1751.

15. *Id.* at 1765; 15 U.S.C. § 1052(a).

16. *Id.*

17. *Id.*

18. *Iancu v. Brunetti*, 139 S. Ct. 2294, 2298 (2019).

19. *Id.* at 2297.

20. *Id.* at 2299.

21. *Id.* at 2302; *In re Brunetti*, 877 F.3d 1330, 1357 (Fed. Cir. 2017).

would bar vulgar or obscene terms.<sup>22</sup> The proposed means consisted of narrowly keeping part of the statute<sup>23</sup> or allowing Congress to create a new statute.<sup>24</sup> Since, the majority quashed the idea of statutory surgery to keep a narrower statute, Congress must now be tasked with a rewrite of § 1052(a).<sup>25</sup>

Before a statutory rewrite of § 1052(a) can be undertaken, it must first be understood how the Supreme Court found that the majority of section 1052(a) was unconstitutional. Part I discusses the history of how and why 15 U.S.C. § 1052(a) was invalidated. Part II works to highlight the outer limits to the arguments of the judicial opinions and analyze the reasoning in view of the totality of the case lineage of *Matal v. Tam* and *Iancu v. Brunetti*. After a comprehensive understanding of the judicial barriers that have been erected, Part III discusses how new legislation can be written to provide some protection from registration of obscene and vulgar trademarks.

## I. HISTORY OF THE STATUTE AT ISSUE AND HOW IT WAS INVALIDATED

### A. *History of 15 U.S.C. § 1052(a)*

Historically, the first section of the Lanham Act of 1946, codified as 15 U.S.C. § 1051, established that the owner of a trademark used in commerce may apply for federal registration and be afforded additional benefits conferred from the registration.<sup>26</sup> The second section of the Lanham Act of 1946 set a limit on those rights.<sup>27</sup> The very first limit that Congress placed on federally registered trademarks was that the mark cannot consist of “immoral, deceptive, or scandalous matter.”<sup>28</sup> The next limit imposed by Congress was that the matter must not “disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”<sup>29</sup> Between these two limitations, it has been established that prohibition

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22. *Brunetti*, 139 S. Ct. at 2302–04, 2308.

23. *Id.* at 2308.

24. *Id.* at 2303.

25. *Id.* at 2302.

26. 15 U.S.C. § 1051.

27. 15 U.S.C. § 1052.

28. *Id.*

29. *Id.*

against marks which contain immoral or scandalous matter constitutes a distinct legal claim, as opposed to prohibition against marks which disparage or bring into contempt or disrepute persons, institutions or beliefs, or those which falsely suggest connection.<sup>30</sup>

The outdated analysis performed by the Patent and Trademark Office (“PTO”) in determining whether a trademark is immoral or scandalous is different than the test to determine whether a trademark is disparaging. While the test for an immoral or scandalous mark must be viewed in the context of the general population, the test for a disparaging mark is only viewed in the context of the referenced group.<sup>31</sup>

An immoral or scandalous trademark must be a mark that is viewed by the general public as giving offense to the conscious or moral feelings or shocking the sense of decency or propriety.<sup>32</sup> The legal analysis used to determine whether a mark will be immoral or scandalous is first that the PTO must consider the trademark in the context of the marketplace as applied to the goods described in the application for registration.<sup>33</sup> Next, the PTO considered whether the mark consists of or comprises scandalous matter determined from the standpoint of a substantial composite of the general public (not necessarily a majority), and in the context of contemporary attitudes, keeping in mind changes in social mores and sensitivities.<sup>34</sup> Additionally, a showing that a mark is vulgar is sufficient to establish that it consists of or comprises immoral or scandalous matter.<sup>35</sup>

Examples of trademarks held to be immoral or scandalous include “JACK-OFF” for adult oriented phone conversations<sup>36</sup> and “BULLSHIT” to appear on the outside of apparel accessories.<sup>37</sup> Trademarks that have been allowed that may seem immoral or scandalous are “WEEK-END

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30. *McDermott v. S.F. Women’s Motorcycle Contingent*, 81 U.S.P.Q.2d (BNA) 1212, 2006 TTAB LEXIS 390 (T.T.A.B. 2006).

31. *See In re Boulevard Ent., Inc.*, 334 F.3d 1336, 1340 (Fed. Cir. 2003); *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014).

32. *In re Tinseltown, Inc.*, 212 U.S.P.Q. (BNA) 863, 865, 1981 TTAB LEXIS 106, at \*7 (T.T.A.B. 1981).

33. *In re Boulevard Ent.*, 334 F.3d at 1340.

34. *Id.*

35. *Id.*

36. *Id.* at 1339.

37. *In re Tinseltown*, 212 U.S.P.Q. (BNA) at 863, 1981 TTAB LEXIS 106 at \*1.

SEX” for a magazine<sup>38</sup> and “BADASS” for bridges for stringed musical instruments.<sup>39</sup> In light of these determinations by the PTO, the appeals board, and the Circuit Court, immoral or scandalous marks must truly shock the conscious of the general public to be denied registration.

A disparaging mark is one which dishonors in comparison with what is inferior, slights, deprecates, degrades, or affects or injures by unjust comparison.<sup>40</sup> The legal analysis that the PTO would use to determine if a trademark was disparaging was a two part test.<sup>41</sup> First, the examining attorney would determine what is the likely meaning of the matter in question.<sup>42</sup> To do this the examining attorney would take into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services.<sup>43</sup> Second, if that meaning is found to refer to identifiable persons, institutions, beliefs, or national symbols, the examiner would then determine whether that meaning may be disparaging to a substantial composite of the referenced group.<sup>44</sup>

For context, some of the marks that have been denied for being disparaging are “STOP ISLAMISATION OF AMERICA” for services to understand and prevent terrorism<sup>45</sup> and “SQUAW” for clothing accessories.<sup>46</sup> Some of the trademarks held to not be disparaging have been “DYKES ON BIKES” for education and entertainment services<sup>47</sup>

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38. *In re Madsen*, 180 U.S.P.Q. (BNA) 334, 335, 1973 TTAB LEXIS 212, at \*3 (T.T.A.B. 1973).

39. *In re Leo Quan Inc.*, 200 U.S.P.Q. (BNA) 370, 370, 1978 TTAB LEXIS 102, at \*1 (T.T.A.B. 1978).

40. *See Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 124 (D.D.C. 2003).

41. *See In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014).

42. *See id.*

43. *See id.*

44. *See id.*

45. *See id.* at 1361–62.

46. *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d (BNA) 1264, 1266, 2006 TTAB LEXIS 189, at \*3 (T.T.A.B. 2006). According to Native American tribal leaders, “squaw” is currently a derogatory and offensive name for Native women. *See* Harold McNeil, *Farewell, Squaw Island. Hello, Unity Island*, BUFFALO NEWS (June 24, 2015), [https://buffalonews.com/news/local/farewell-squaw-island-hello-unity-island/article\\_64469c1b-5d89-5683-abe7-924d953e38fe.html](https://buffalonews.com/news/local/farewell-squaw-island-hello-unity-island/article_64469c1b-5d89-5683-abe7-924d953e38fe.html).

47. *McDermott v. S.F. Women’s Motorcycle Contingent*, 240 F. App’x 865, 868 (Fed. Cir. 2007).

and “JAP” for clothing.<sup>48</sup> This two part test provided some guidance to the PTO examiners to make a reasonable decision about whether a trademark is prone to disparaging a substantial amount of the referenced group, but as seen with the examples above, this test only precluded trademarks that were considerably disparaging.

In the seventy years from the inception of the Lanham Act until the Supreme Court’s ruling in *Tam*, the trademark system had some gatekeeping function that kept trademarks that were truly offensive from bombarding the public with offensive terms in commerce. Although, as shown with the examples above, this protection was inconsistent and not absolute. Despite the imperfect nature of precluding offensive terms, the protection that § 1052(a) did provide was a safety net to truly keep the worst subject matter away from the general public or specific referenced groups.

#### B. *Matal v. Tam*

The Supreme Court’s eventual ruling in *Matal v. Tam* was the first ruling to invalidate a provision of § 1052(a).<sup>49</sup> This case arises out of Simon Tam’s application to register the trademark “THE SLANTS” for a musical band.<sup>50</sup> It is well established that “slants” is a derogatory term for persons of Asian descent and Simon Tam even admits as such.<sup>51</sup> The band members are all Asian, and they believe that, by taking the slur as a band name, they will help to reclaim the term and remove the belittling connotations associated with the term.<sup>52</sup>

Simon Tam sought to register THE SLANTS for a musical band on March 5, 2010, after using the name in commerce since November 15, 2006.<sup>53</sup> Tam eventually abandoned this application after the examining attorney refused to register the application for being disparaging to people

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48. *In re Condas S.A.*, 188 U.S.P.Q. (BNA) 544, 544, 1975 TTAB LEXIS 133, at \*1 (T.T.A.B. 1975).

49. *See Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017).

50. THE SLANTS, U.S. Trademark Application Serial No. 85/472,044 (filed Nov. 14, 2011).

51. *Tam*, 137 S. Ct. at 1751.

52. *Id.*

53. THE SLANTS, U.S. Trademark Application Serial No. 77/952,263 (filed Mar. 5, 2010).

of Asian descent.<sup>54</sup> Tam again applied for registration of THE SLANTS mark on November 14, 2011.<sup>55</sup> Registration of the mark was refused by the examining attorney on the ground that applicant's mark consisted of or included matter that may disparage or bring into contempt or disrepute persons, institutions, beliefs, or national symbols under § 1052(a).<sup>56</sup> After Tam's request for reconsideration was denied, he appealed the decision to the Trademark Trial and Appeal Board ("Board").<sup>57</sup>

### 1. Trademark Trial and Appeal Board

On appeal, the submitted evidence focused on multiple points, the first of which was the dictionary definition of the term "slant" and how the Asian community as a whole perceived the term.<sup>58</sup> By using various dictionaries ranging from published works to community sourced websites, the Board found that a definition for the term "slant" in the proposed context was "offensive slang used as a disparaging term for a person of East Asian birth or ancestry."<sup>59</sup> The Board additionally found specific examples of Asian groups that found the term "slant" disparaging.<sup>60</sup> First, the Oregon Commission on Asian Affairs pulled support for "The Slants" band specifically, and cited the reason as their offensive name.<sup>61</sup> Additionally, a band member was set to give a keynote address at an Asian American Youth Leadership Conference, but conference supporters and attendees felt the name of the band was offensive and racist so the organizers chose to have someone less controversial speak.<sup>62</sup>

In review of the facts, the Board applied the two part test and first found that the likely meaning was a derogatory reference to people of Asian descent based on the dictionary definitions and the response by the Asian community to the name.<sup>63</sup> Next, in analyzing the second part of the

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54. *In re Tam*, 785 F.3d 567, 568 (Fed. Cir. 2015).

55. THE SLANTS, Registration No. 5,332,283.

56. *In re Tam*, 108 U.S.P.Q.2d 1305, 1306, 2013 TTAB LEXIS 485, at \*2 (T.T.A.B. 2013).

57. *Id.*

58. *Id.* at 1306–07, 2013 TTAB LEXIS 485, at \*3–4.

59. *Id.* at 1308, 2013 TTAB LEXIS 485, at \*7.

60. *Id.* at 1307–08, 2013 TTAB LEXIS 485, at \*5–7.

61. *Id.*

62. *Id.*

63. *Id.* at 1309, 2013 TTAB LEXIS 485, at \*10–11.

test, the Board took into account all members of the Asian American public as they may encounter the mark THE SLANTS in advertising in newspapers, billboards, or on a website.<sup>64</sup> When taking this view, the Board found that THE SLANTS was disparaging to a substantial composite of the referenced group—noting that even the applicant did not dispute that the band’s name was derived from an ethnic slur.<sup>65</sup> Therefore, the Board found sufficient legal standing to affirm the examining attorney’s refusal of registering THE SLANTS under § 1052(a).<sup>66</sup>

## 2. Federal Circuit

After Simon Tam lost the appeal with the Board, he appealed this decision to the United States Court of Appeals for the Federal Circuit.<sup>67</sup> On this appeal, Tam reasserted his claim that the mark THE SLANTS was not disparaging under § 1052(a) and was first able to challenge the constitutionality of § 1052(a).<sup>68</sup>

The Federal Circuit began by affirming the Board’s finding that the mark was disparaging under § 1052(a) by again going through the two part test to determine if a mark is disparaging.<sup>69</sup> The Federal Circuit’s application of the two part test used many of the same findings of the Board’s two part test.<sup>70</sup> First, the court found that the mark THE SLANTS likely refers to people of Asian descent by examining the record.<sup>71</sup> The record reflected that the dictionary terms explain “slants” as referring to people of Asian descent, Tam himself admits in an interview that Asians are associated with slant eyes, the band’s Wikipedia page states that the name is derived from an ethnic slur for Asians, the band uses a depiction of an Asian woman in front of the rising sun imagery, and individuals and groups have perceived the term as referring to people of Asian descent.<sup>72</sup>

With the likely meaning of the mark established, the court turned to

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64. *Id.* at 1312, 2013 TTAB LEXIS 485, at \*22.

65. *Id.* at 1312, 2013 TTAB LEXIS 485, at \*22–24.

66. *Id.* at 1313, 2013 TTAB LEXIS 485, at \*24–25.

67. *In re Tam*, 785 F.3d 567, 568 (Fed. Cir. 2015).

68. *Id.* at 569.

69. *Id.* at 569–71.

70. *Id.*

71. *Id.* at 570.

72. *Id.* at 570–71.

whether the meaning may disparage a substantial composite of the referenced group.<sup>73</sup> Under this analysis, the court found that definitions universally say that “slants” is disparaging; a brochure by the Japanese American Citizens League describes the term “slant” as a derogatory term when used to reference people of Asian descent. Furthermore, news articles and blog posts discussed the offensive nature of the band’s name.<sup>74</sup> Thus, the Federal Circuit court found that THE SLANTS was a disparaging mark by showing the likely meaning of the term and that it may be disparaging to a substantial composite of the referenced group.<sup>75</sup>

At the challenge of Mr. Tam, the Federal Circuit then assessed the constitutionality of § 1052(a).<sup>76</sup> The court proceeded with a four-step inquiry. This included assessing whether the statute violated the First Amendment, whether the statute was void for vagueness, whether requisite due process was afforded, and whether the rejection violated the Equal Protection Clause.

First, when assessing whether the statute violated the First Amendment grant of Freedom of Speech, the court answered two of Tam’s contentions: that the statute was facially unconstitutional and that the benefit of registration was conditioned on the relinquishment of speech.<sup>77</sup> To resolve this dispute, the court cited precedent that states: “the PTO’s refusal to register appellant’s mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant’s First Amendment rights would not be abridged by the refusal to register his mark.”<sup>78</sup> The court then determined that § 1052(a) is not unconstitutional for violating the First Amendment because refusal to register doesn’t foreclose use of the mark.<sup>79</sup>

The second constitutional challenge was that § 1052(a)’s use of the terms “scandalous” and “disparage” were unconstitutionally vague.<sup>80</sup> The court found that it was inherently difficult to create an objective measure

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73. *Id.* at 571.

74. *Id.*

75. *Id.*

76. *Id.*

77. *Id.*

78. *Id.* at 572 (citing *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981)).

79. *See id.*

80. *Id.*

of the general public's various viewpoints.<sup>81</sup> Additionally, the court stated that the current standard gave sufficiently precise methods for the PTO and courts to apply the law and give notice to a would be registrant of what will not be granted a federal registration.<sup>82</sup> Although the court only assessed the "scandalous" term in the statute, it declared that the same rationale applies to "disparaging" marks and held that the standard is not unconstitutionally vague.<sup>83</sup>

Tam also argued that the PTO violated due process by applying the disparagement provisions arbitrarily and without clear guidelines.<sup>84</sup> Tam argued that by refusing to register his mark but granting similar marks, like "DYKES ON BIKES," the PTO violated the Due Process Clause.<sup>85</sup> Regarding this point, the court found that during registration there was no due process violation because the applicant was provided a full opportunity to prosecute his applications and to appeal the examining attorney's final rejections to the Board.<sup>86</sup> The court rejected the due process argument by reasoning that each application is considered on its own merits and third party applications do not bind the PTO to improperly register marks.<sup>87</sup>

The final constitutional argument that Tam raised was "that because the examining attorney's disparagement analysis hinged on his and his bandmates' ethnic identities, the rejection of the mark violated" the Equal Protection Clause.<sup>88</sup> The court reasoned that the denial was not on account of Mr. Tam's race.<sup>89</sup> This was because the Board reasoned that "[a]n application by a band comprised of non-Asian-Americans called THE SLANTS that displayed the mark next to the imagery used by applicant . . . would also be subject to a refusal under [§ 1052(a)]."<sup>90</sup> The court stated that they have held that a trademark refusal does not violate equal protection so long as there are nondiscriminatory reasons for denying

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81. *Id.*

82. *See id.*

83. *Id.*

84. *Id.*

85. *Id.*; *see also* U.S. CONST. amend. V.

86. *In re Tam*, 785 F.3d at 572.

87. *Id.* at 572–73.

88. *Id.* at 573.

89. *Id.*

90. *Id.*

registration.<sup>91</sup>

In publishing the opinion, Circuit Judge Moore offered additional views to the argument for the constitutionality of § 1052(a). Within Judge Moore's additional views, she analyzed three topics. First, she looked at whether trade names are protected speech.<sup>92</sup> Second, she analyzed whether § 1052(a) is an abridgment of speech.<sup>93</sup> Third, her analysis concluded with whether § 1052(a) was unconstitutional.<sup>94</sup> By looking at these three topics Judge Moore is explaining how an argument can be made for § 1052(a) to be unconstitutional if she was not bound by precedent.

When discussing whether trade names were protected speech, Judge Moore looked to recent Supreme Court decisions to determine that trademarks are protected speech under Supreme Court commercial speech doctrine.<sup>95</sup> Although commercial speech is a form of protected communication under the First Amendment, it does not receive as much free speech protection as noncommercial speech, such as political speech.<sup>96</sup> Judge Moore concluded that trade names were protected speech by finding that commercial speech is a protected form of speech and, in the case of *THE SLANTS*, the mark raised political discussion such that it is granted a higher level of First Amendment protection.<sup>97</sup>

Next, Judge Moore addresses whether § 1052(a) is an abridgment of speech.<sup>98</sup> Judge Moore undercuts the holding in *McGinley* which states that the refusal to register a mark under § 1052(a) does not bar the applicant from using the mark, and therefore does not implicate the First Amendment by showing the loss of protection from not having a registerable mark.<sup>99</sup> This holding stems from the fact that a mark-holder can obtain state common law trademark protection in lieu of federal

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91. *Id.*; see also *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174–75 (Fed. Cir. 2009).

92. *In re Tam*, 785 F.3d at 574 (Moore, J., providing additional views on *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981)).

93. *Id.* at 575.

94. *Id.* at 581.

95. *Id.* at 575.

96. David Schultz, *Commercial Speech*, FIRST AMEND. ENCYCLOPEDIA, <https://www.mtsu.edu/first-amendment/article/900/commercial-speech> (last visited Apr. 8, 2021).

97. See *In re Tam*, 785 F.3d at 575.

98. See *id.*

99. *Id.*; see also *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981).

protection. Judge Moore pointed out the numerous rights that a mark-holder loses with only common law protection. These rights include a presumption of validity after five years of registration, prevention of cybersquatters misappropriating a domain name, and access to federal remedies for trademark infringement under § 1125(a).<sup>100</sup> She also pointed to the loss of common law protection since most states have adopted the Model State Trademark Bill, which mirrors the Lanham Act, and makes it likely that an unregistrable trademark will have no state protection.<sup>101</sup>

In furthering the analysis as to whether § 1052(a) is an abridgment of speech, Judge Moore states that the unconstitutional conditions doctrine must be implicated in the denial of trademark protection.<sup>102</sup> The unconstitutional conditions doctrine states that “the government may not deny a benefit to a person on a basis that infringes his constitutionally protected . . . freedom of speech even if he has no entitlement to that benefit.”<sup>103</sup> This argument balances the government’s ability to define the limits of a program that uses government funds and the government’s inability to infringe on constitutional protections through a regulatory regime.<sup>104</sup> In 1991, PTO operations changed from being underwritten by public funds to being substantially funded by registration fees.<sup>105</sup> With this change in funding, Judge Moore notes that the unconstitutional conditions doctrine applies and the Supreme Court’s precedential analysis of the constitutionality of § 1052(a) in *McGinley* no longer suffices.<sup>106</sup>

Finally, the third topic Judge Moore addressed was whether § 1052(a) is unconstitutional.<sup>107</sup> Here, she analyzed the statute under the *Central Hudson* test, which determines the constitutionality of restrictions on commercial speech.<sup>108</sup> Judge Moore found that THE

100. *See In re Tam*, 785 F.3d at 576; 15 U.S.C. § 1125(a).

101. *See In re Tam*, 785 F.3d at 577.

102. *See id.*

103. *Rumsfeld v. F. for Acad. & Institutional Rts., Inc.*, 547 U.S. 47, 59 (2006) (alteration in original) (citation omitted).

104. *See In re Tam*, 785 F.3d at 578–80.

105. *See id.* at 580.

106. *Id.* at 581.

107. *See id.*

108. *Id.* The *Central Hudson* test states: “commercial speech . . . must concern lawful activity and not be misleading. Next, we ask whether the asserted governmental interest is substantial. If both inquiries yield positive answers, we must determine whether the regulation

SLANTS mark was not illegal or misleading and the Government failed to put forth a substantial interest.<sup>109</sup> Judge Moore found that without any substantial government interest, § 1052(a) cannot satisfy the *Central Hudson* test.<sup>110</sup>

### 3. Federal Circuit En Banc Review

After Judge Moore set out the argument for invalidating § 1052(a)'s disparagement clause as unconstitutional, an en banc hearing in the Federal Circuit was ordered sua sponte.<sup>111</sup> The hearing was set to address the sole issue of “[d]oes the bar on registration of disparaging marks in 15 U.S.C. § 1052(a) violate the First Amendment?”<sup>112</sup>

In the en banc decision of the Federal Circuit, Judge Moore wrote for the majority of the court, and first held that the disparagement provision of § 1052(a) is subject to strict scrutiny because it burdens private speech based on disapproval of the message conveyed.<sup>113</sup> The court then concluded that the provision could not survive strict scrutiny.<sup>114</sup> The court concluded that invalidating a trademark for disparaging a certain group discriminates on the basis of viewpoint.<sup>115</sup> Section 1052(a) is viewpoint discriminatory on its face because the PTO will not register a mark that refers to a group in a negative way, but it permits the registration of marks that refer to a group in a positive, non-disparaging manner.<sup>116</sup> Thus, § 1052(a) is perceived as a viewpoint-discriminatory regulation of speech, created and applied in order to stifle the use of certain disfavored messages.<sup>117</sup>

Next, the court held that prohibition on the registration of disparaging trademarks was not a regulation of commercial speech.<sup>118</sup>

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directly advances the governmental interest asserted, and whether it is not more extensive than is necessary to serve that interest.” See *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 566 (1980).

109. See *In re Tam*, 785 F.3d at 582.

110. See *id.* at 585.

111. *In re Tam*, 600 F. App’x 775 (Fed. Cir. 2015).

112. *Id.*

113. *In re Tam*, 808 F.3d 1321, 1334 (Fed. Cir. 2015).

114. *Id.*

115. *Id.*

116. *Id.* at 1336.

117. *Id.* at 1337.

118. *Id.*

Although the speech is ultimately commercial, as it will be used with a product or service, the court here states that it is critical to note that the mark's expressive character, not its ability to serve as a source identifier, is the basis for the exclusion from registration for being disparaging.<sup>119</sup> When the commercial speech is "inextricably intertwined" with expressive speech, it is treated as expressive speech under the First Amendment when the expressive aspect is being regulated.<sup>120</sup> Because the speech being regulated by the disparagement provision is considered expressive speech, it is afforded special protection under the First Amendment.<sup>121</sup> Since § 1052(a) discriminates on the basis of the content of the message conveyed by the speech, it is presumptively invalid, and must satisfy strict scrutiny to be found constitutional.<sup>122</sup>

Although § 1052(a) does not ban speech, the court finds that the prohibition on the registration of disparaging trademarks significantly chills private speech on discriminatory grounds.<sup>123</sup> The court starts with the general premise that "if the government could deny a benefit to a person because of his constitutionally protected speech . . . , his exercise of those freedoms would in effect be penalized and inhibited. This would allow the government to produce a result which it could not command directly."<sup>124</sup> This means that if the government can obtain the same effect as banning speech by denying benefits associated with the speech, the government act is in violation of the First Amendment. Here, the court cites to three government actions that effectively chill someone from registering a disparaging trademark. These are threatened denial of registration and litigation costs associated with challenging this denial, the uncertainty of the validity of a disparaging mark, and the lack of state law protection after most states adopted a form of the Lanham Act called the Model State Trademark Act.<sup>125</sup> All of these actions contribute to effectively chilling the speech of a potentially disparaging trademark.

The court also denies the Government's contention that trademark registration is government speech as "[t]he Free Speech Clause restricts

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119. *Id.* at 1338.

120. *Id.* at 1339 (citing *Riley v. Nat'l Fed'n of the Blind*, 487 U.S. 781, 796 (1988)).

121. *Id.*

122. *Id.*

123. *Id.*

124. *Id.* at 1340 (quoting *Perry v. Sindermann*, 408 U.S. 593, 597 (1972)).

125. *Id.* at 1341–44.

government regulation of private speech; it does not regulate government speech.”<sup>126</sup> Here the court claims that use of a mark by its owner is clearly private speech and strengthens this argument by analogizing trademarks with copyrights that are considered not to be public speech.<sup>127</sup> The court denies that the right to put the ® symbol on a registered mark, the issuance of a certificate of registration, and being listed on a government database are all accoutrements of copyright registration and thus cannot be government speech.<sup>128</sup>

Next, the court holds that the message based discrimination is not merely the government’s shaping of a subsidiary program.<sup>129</sup> Here the court cites to the unconstitutional conditions doctrine that states that “the government may not deny a benefit to a person on a basis that infringes his constitutionally protected . . . freedom of speech even if he has no entitlement to that benefit.”<sup>130</sup> Here the court finds that trademark registration is a regulatory regime and not a government subsidiary program.<sup>131</sup> If trademark registration were a government subsidiary program, it would include the authority to impose limits on the use of such funds to ensure they are used in the manner Congress intends, even when these limits exclude protected speech or other constitutionally protected conduct.<sup>132</sup> The court concludes that because the benefits bestowed on mark-holders are valuable not monetary; funded by registration fees and not the taxpayer; and the Lanham Act is derived from the Commerce Clause, not the Spending Clause, trademark registration is a regulatory regime and not granted the breadth of a subsidiary program.<sup>133</sup>

Finally, the court finds that even though § 1052(a) regulates expressive speech, it will fail to meet a lower standard of intermediate scrutiny if it were classified as commercial speech.<sup>134</sup> The *Central*

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126. *Id.* at 1345 (citing *Pleasant Grove City v. Summum*, 555 U.S. 460, 467 (2009)).

127. *Id.* at 1345–48.

128. *Id.* at 1345–47.

129. *Id.* at 1348.

130. *Rumsfeld v. F. for Acad. & Institutional Rts., Inc.*, 547 U.S. 47, 59 (2006) (quoting *Board of Comm’rs, Wabaunsee Cnty. v. Umbehr*, 518 U.S. 668, 674 (1996)).

131. *In re Tam*, 808 F.3d at 1353.

132. *Id.* at 1349.

133. *Id.* at 1352–54.

134. *Id.* at 1355.

*Hudson* test is applied to determine if commercial speech is consistent with the First Amendment.<sup>135</sup> The court finds that there is nothing illegal or misleading about disparaging marks in general, and the government cannot assert a substantial government interest in preventing disparaging marks.<sup>136</sup> Although the argument is that the goal in not registering disparaging marks is to “declin[e] to expend its resources to facilitate the use of racial slurs as source identifiers in interstate commerce,” the court rejects this as permitting the government to burden speech it finds offensive.<sup>137</sup> The court finds that there is no legitimate government interest and finds that the disparagement provision fails the *Central Hudson* test.

The Federal Circuit’s en banc hearing found the disparagement provision of § 1052(a) unconstitutional and held that the First Amendment protected Mr. Tam’s speech, and the speech of other trademark applicants.<sup>138</sup>

#### 4. Supreme Court

After the Federal Circuit found the disparagement clause facially unconstitutional under the First Amendment’s Free Speech Clause, the Supreme Court granted certiorari and affirmed the judgment of the lower court, with Justice Alito delivering the majority opinion.<sup>139</sup>

In the majority opinion the Court rules that the disparagement clause facially discriminated on the basis of viewpoint and “the First Amendment forbids the government to regulate speech in ways that favor some viewpoints or ideas at the expense of others.”<sup>140</sup> The majority opinion denies the argument that trademarks are government, not private speech with a prudential and doctrinal argument.

In the prudential argument the Court argues that the federal government does not dream up the marks, and it does not edit marks submitted for registration and if private speech could be passed off as

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135. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 566 (1980).

136. *In re Tam*, 808 F.3d at 1355.

137. *Id.* at 1356–57.

138. *Id.* at 1357.

139. *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017).

140. *Id.* at 1757 (citing *Lamb’s Chapel v. Ctr. Moriches Union Free Sch. Dist.*, 508 U.S. 384, 394 (1993)).

government speech by simply affixing a government seal of approval, government could silence or muffle the expression of disfavored viewpoints.<sup>141</sup>

The doctrinal argument is that, in *Walker*, the Court found the outer bounds of the government speech doctrine when it held that the messages on Texas specialty license plates are government speech.<sup>142</sup> The license plates were government speech because license plates have long been used by the states to convey state messages, the public associates license plates with the state, and Texas maintained direct control over the messages conveyed on its specialty plates.<sup>143</sup> Since trademarks don't align with any of these rationales, the Court held that trademark registration was vastly different than the license plates in *Walker*.<sup>144</sup> Thus, the majority holds that trademarks are private, not government speech and are not afforded extra protection for viewpoint discrimination.<sup>145</sup>

The majority of the court is unable to agree that the Government's argument that trademarks are a form of government subsidy, and that the constitutionality of the disparagement clause should be tested under a new "government program" doctrine should be denied.<sup>146</sup> Although four Justices split the Court's decision on these two topics (Justice Gorsuch took no part in the opinion), the four Justices concurred with the holding.<sup>147</sup> Justice Kennedy authored the opinion for the concurrence and found that "[§] 1052(a) constitutes viewpoint discrimination—a form of speech suppression so potent that it must be subject to rigorous constitutional scrutiny. The Government's action and the statute on which it is based cannot survive this scrutiny."<sup>148</sup> The concurrence finds that there are few categories of speech that the government can regulate or punish including fraud, defamation, and incitement and that the disparagement clause was not one of the exceptions.<sup>149</sup>

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141. *Id.* at 1758.

142. *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 576 U.S. 200, 204 (2015).

143. *Tam*, 137 S. Ct. at 1760 (citing *Walker*, 576 U.S. at 206–14).

144. *Id.*

145. *Id.*

146. *Id.* at 1751.

147. *Id.* at 1765 (Kennedy, J., concurring).

148. *Id.*

149. *Id.*

## C. Iancu v. Brunetti

After the ruling in *Matal v. Tam* held that the disparagement provision of § 1052(a) was unconstitutional, it was only a matter of time until someone challenged the constitutionality of the rest of the statute. What was left in the statute was that a trademark could not consist of “immoral, deceptive, or scandalous matter.”<sup>150</sup> The deceptive portion of this statute is not addressed because two tenets of trademark law are to make the customer experience more efficient and protect a mark-holder’s investment. A deceptive mark would directly undermine these goals. What is addressed is whether a mark can be immoral or scandalous and this was challenged by Erik Brunetti.

On May 3, 2011, Erik Brunetti filed for registration of the word mark FUCT, to be used on athletic apparel and children and infant’s apparel.<sup>151</sup> The registration was denied by the examining attorney at the PTO as the examining attorney found the mark vulgar and as such containing immoral or scandalous matter.<sup>152</sup> The legal determination that was used to deny registration was to consider the term in the context of the marketplace as applied to applicant’s identified goods.<sup>153</sup> Furthermore, the analysis must be made from the standpoint of a substantial composite of the general public, and in terms of contemporary attitudes.<sup>154</sup> The Board heard the appeal of this decision and affirmed the refusal to register.<sup>155</sup>

## 1. Trademark Trial and Appeal Board

The Board’s findings provide a factual setting for the case. The examining attorney found that “fuct” is the phonetic equivalent of the word “fucked” and the past tense of the word “fuck.”<sup>156</sup> In light of these findings, Mr. Brunetti contended that the term “fuct” is not so scandalous as to justify the refusal to register, that the mark FUCT is a coined word

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150. 15 U.S.C. § 1052(a).

151. TEAS Plus Application for “FUCT” mark, USPTO TSDR CASE VIEWER (May 3, 2011), <https://tsdr.uspto.gov/documentviewer?caseId=sn85310960&docId=FTK20110506074222#docIndex=30&page=1>.

152. *In re Brunetti*, No. 85310960, 2014 WL 3976439, at \*1 (T.T.A.B. 2014).

153. *Id.* at \*2.

154. *Id.*

155. *Id.* at \*1.

156. *Id.*

that has no meaning other than his brand name and the statutory bar of scandalous and immoral is too broad in light of evolving First Amendment jurisprudence, *i.e.*, *Matal v. Tam*.<sup>157</sup> Mr. Brunetti also later contended that FUCT is an acronym for “Friends U Can’t Trust.”<sup>158</sup> The Board answers these contentions in turn, but explicitly denies to answer whether § 1052(a) is constitutional as an agency cannot make a decision on constitutionality.<sup>159</sup>

First, the Board shows that dictionary evidence concludes that the term “fuck” is vulgar. The Board references many dictionaries that characterize the word “fuck” as offensive, extremely offensive, and highly offensive.<sup>160</sup> Additionally, the term “fuct” has been defined through Urban Dictionary, a community-edited dictionary, as “the past tense of the verb fuck.”<sup>161</sup> This was found to be enough evidence to prove that the term “fuct” is sufficiently vulgar to be “immoral or scandalous matter.”

Second, the Board links Mr. Brunetti’s clothing line to the two definitions of “fucked.” In terms of the definition that has sexual connotations, the Board found that images on Mr. Brunetti’s website contained explicit sexual imagery that objectified women.<sup>162</sup> This was enough to link the meaning of the mark to a substantial definition of the term “fucked” and not just an arbitrary set of letters. Regarding the other definition of “fucked” that refers to “having no chance of success,” the Board found an overarching theme of Mr. Brunetti’s clothing and website to be a rejection of moral principles and embodying anti-social imagery of despair.<sup>163</sup> By linking these definitions to the mark FUCT, it shows that FUCT was chosen precisely to be offensive, yet ambiguous enough to provide plausible deniability.<sup>164</sup>

The Board affirmed the denial of registration of the mark FUCT. They found that, in 2014, a substantial composite of the general public

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157. *Id.*

158. *Id.* at \*3.

159. *Id.* at \*5.

160. *Id.* at \*3.

161. *Id.*

162. *Id.* at \*4.

163. *See id.*

164. *See id.*

would find the mark vulgar.<sup>165</sup> Thus, the mark was properly refused under § 1052(a)'s "scandalous or immoral matter" standard.

## 2. Federal Circuit Court

Mr. Brunetti appealed the Board's decision to United States Court of Appeals for the Federal Circuit and Judge Moore authored the opinion, as she did in *Matal v. Tam*. The Federal Circuit found that the mark at issue did comprise of immoral or scandalous matter, but the court found that § 1052(a)'s bar on registering immoral or scandalous marks is unconstitutional.<sup>166</sup>

First, the court determines that the mark FUCT is vulgar and therefore scandalous.<sup>167</sup> The court stated that "the PTO may prove scandalousness by establishing that a mark is 'vulgar.'"<sup>168</sup> The court here relies on the same evidence as the Board did to come to this conclusion. The court finds that the mark is vulgar and that there is a clear link between the mark FUCT and the word "fucked."<sup>169</sup> Mr. Brunetti's arguments that Urban Dictionary is an unreliable dictionary, that the examining attorney used random images from outdated products to show a link between the mark and a definition, and the fact that he only received a single complaint in over twenty years of operation are all struck down by the court.<sup>170</sup> The court here found that the vulgarity of the mark is overwhelming to defeat any contention and it is thus scandalous matter.<sup>171</sup>

Next, the court turned to whether § 1052(a) was constitutional and found that the bar on immoral or scandalous marks infringed the First Amendment.<sup>172</sup> The court found that neither the majority or concurring opinions of *Tam* reached an answer to the question of whether the immoral or scandalous provisions of § 1052(a) were constitutional.<sup>173</sup> On this appeal, the Government conceded that the bar on registering immoral

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165. *Id.* at \*5.

166. *In re Brunetti*, 877 F.3d 1330, 1335 (Fed. Cir. 2017).

167. *Id.* at 1337.

168. *Id.* at 1336 (quoting *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012)).

169. *Id.* at 1338.

170. *See id.* at 1338–39.

171. *See id.* at 1339–40.

172. *Id.* at 1340.

173. *Id.* at 1341.

or scandalous marks is a content-based restriction on speech.<sup>174</sup> The Government did assert that § 1052(a)'s content-based bar on registering immoral or scandalous marks does not implicate the First Amendment because trademark registration is either a government subsidy program or limited public forum, the two specific arguments that the Supreme Court failed to reach a majority decision on in *Tam*.<sup>175</sup>

The court here again denies that trademark registration is a subsidiary program.<sup>176</sup> Once again, the court reiterates their main reasoning to conclude that the trademark registration system is a registration program rather than a subsidiary program. First, federal trademark law does not derive from the Spending Clause and directly implicate Congress' power to spend and control government property.<sup>177</sup> Next, trademark registration is mostly paid for by applicants, not taxpayers.<sup>178</sup> Finally, the benefits that trademark registration bestows on the applicant are valuable and not analogous to a grant of federal funds.<sup>179</sup> By this rationale the court denies that trademark registration is a subsidiary program with censorship authority.<sup>180</sup>

Next, the court determined that trademark registration is not a limited public forum where the government may place limitations on speech.<sup>181</sup> This argument stems from the principle that "the government need not permit all forms of speech on property that it owns and controls."<sup>182</sup> There are three types of forums that the trademark speech may fall into. The first two do not permit restrictions based on viewpoint and those are traditional public forums such as streets and parks and designated public forums where government property that has not traditionally been regarded as a public forum is intentionally opened up for that purpose.<sup>183</sup> The last type of public forum is a limited public forum

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174. *Id.* at 1342.

175. *Id.*

176. *Id.*

177. *Id.*

178. *Id.* at 1344.

179. *Id.*

180. *Id.* at 1345.

181. *Id.*

182. *Id.* (citing *Int'l Soc. for Krishna Consciousness, Inc. v. Lee*, 505 U.S. 672, 678 (1992)).

183. *Id.* at 1346.

where the government can reasonably restrict speech, such as a city bus or a military cemetery.<sup>184</sup> The court found that because trademarks are used in commerce, the trademark registration program bears no resemblance to these limited public forums and rejected this argument.<sup>185</sup>

Finally, the court found that there was no reasonable definition of the statutory terms scandalous and immoral which would preserve their constitutionality.<sup>186</sup> The court attempted to constrain scandalous or immoral to mean either obscene material or terms with sexual connotations, but could not do so.<sup>187</sup> The court reasoned that “there is no dispute that an obscene mark would be scandalous or immoral; however, not all scandalous or immoral marks are obscene.”<sup>188</sup> Thus, the court refused to doctor the statute to make the terms work with the intent of forbidding obscene or lewd matter.

The Federal Circuit concluded by holding that the bar in § 1052(a) against immoral or scandalous marks was unconstitutional because it violated the First Amendment.

### 3. Supreme Court of the United States

This case eventually made its way up to the Supreme Court to determine the validity of the immoral or scandalous provision of § 1052(a). In this decision the Court holds that the bar on the registration of “immoral” or “scandalous” trademarks discriminates on the basis of viewpoint and, thus, violates the First Amendment.<sup>189</sup>

Justice Kagan writes for the Court and relies on the proposition established in *Tam* that if a trademark registration bar is viewpoint-based, it is unconstitutional.<sup>190</sup> Here, all the Court had to find was that the immoral or scandalous bar discriminated on the basis of viewpoint to find it unconstitutional.<sup>191</sup> Since the Government did not argue that the immoral or scandalous bar did not discriminate based on viewpoint, the Court holds that the immoral or scandalous bar was unconstitutional in

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184. *Id.*

185. *Id.* at 1347.

186. *Id.* at 1355.

187. *Id.* at 1355–56.

188. *Id.* at 1355.

189. *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019).

190. *Id.* at 2299.

191. *Id.*

light of the First Amendment.<sup>192</sup>

The Court in turn affirms the judgement of the Federal Circuit and held that the bar on the registration of “immoral” or “scandalous” trademarks discriminates on the basis of viewpoint and, thereby violating the First Amendment.<sup>193</sup>

## II. GUIDEPOSTS ESTABLISHED FOR THE CONSTITUTIONAL RESURRECTION OF § 1052

As the judicial barriers were being constructed around § 1052, one major theme was lurking in the background of the decisions and at the forefront of the multiple dissents in part. This theme was an effort to save the statute in some form as the Justices knew the treacherous impact of invalidating § 1052(a). This theme is self-evident because a tension can be felt in the Justices’ writing as many were uncomfortable with the result of declaring § 1052 unconstitutional.

It is important to note that this uneasy feeling did not come solely from dissenting Justices. This was first evidenced in the Federal Circuit’s en banc opinion, written by Judge Moore, regarding THE SLANTS trademark. The Federal Circuit’s en banc hearing found the disparagement provision of § 1052(a) unconstitutional, but immediately distanced themselves from THE SLANTS trademark by saying that “nothing we say should be viewed as an endorsement of the mark at issue.”<sup>194</sup> It is clear that the court understands that there is an offensive nature to the trademark at issue so much so that they are willing to clarify their condemnation of it, an opportunity not afforded to the PTO.

This trend continues in the Federal Circuit *In re Brunetti* decision. The court prefaced its holding by admitting that “the use of such marks in commerce [will be] discomfiting, and [the court is] not eager to see a proliferation of such marks in the marketplace.”<sup>195</sup> The court then makes the association of trademarks to copyrights, both operating under a federal system, and the existence of vulgar copyrights.<sup>196</sup> This is a way to justify that the public is already inundated with vulgar material so the addition of more vulgarity to the public realm is of no consequence.

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192. *See id.* at 2302.

193. *See id.*

194. *In re Tam*, 808 F.3d 1321, 1357 (Fed. Cir. 2015).

195. *In re Brunetti*, 877 F.3d 1330, 1357 (Fed. Cir. 2017).

196. *See id.*

This tension was also felt in *Brunetti*, after the Government contended that the Court should narrow the statute to bar “marks that are offensive [or] shocking to a substantial segment of the public because of their mode of expression, independent of any views that they may express.”<sup>197</sup> The goal of this interpretation would be to exclude only marks that are vulgar, sexually explicit, or profane.<sup>198</sup> The Court refuses to limit the statute as the statute is not ambiguous enough to allow this type of interpretation and the Court cannot effectively rewrite a statute as it sees fit.<sup>199</sup> After hearing this argument and potentially sparked by the ramifications of the eventual decision, one concurring and three concurring in part and dissenting in part opinions are offered to lay the foundation for a new statutory provision.

This concurrence was from Justice Alito, the author of the *Tam* decision. In his concurrence, he notes that although the Court cannot alter the statute in effect, the decision did not prevent Congress from adopting a more carefully focused statute that precludes the registration of marks containing vulgar terms that play no real part in the expression of ideas.<sup>200</sup> He views the mark FUCT, and others like it, as not needed to express an idea since the marks contain nothing more than emotion and a severely limited vocabulary.<sup>201</sup>

Although the majority in *Brunetti* interprets the immoral bar and the scandalous bar to have the overlapping meaning of ideas that are hostile to moral standards, the three Justices who dissented in part viewed the scandalous bar as different than the immoral bar.<sup>202</sup> The first of these was Chief Justice Roberts who offers an opinion concurring in part and dissenting in part, to argue that although the immoral bar cannot be saved, the scandalous bar certainly can be.<sup>203</sup> He agrees with Justice Sotomayor that scandalous can be narrowly viewed to only include marks that are obscene, vulgar, or profane and that the government has an interest in not associating itself with such trademark.<sup>204</sup>

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197. *Brunetti*, 139 S. Ct. at 2301.

198. *Id.*

199. *See id.* at 2301–02.

200. *Id.* at 2303 (Alito, J., concurring).

201. *Id.*

202. *See* Ned Snow, *Immoral Trademarks After Brunetti*, 58 HOUS. L. REV. 401, 436–37 (2020).

203. *Brunetti*, 139 S. Ct. at 2303 (Roberts, J., concurring in part and dissenting in part).

204. *Id.*

The next concurring in part and dissenting in part opinion is authored by Justice Breyer who also joins Justice Sotomayor in her opinion. In this opinion he agrees that the immoral bar cannot be saved and the scandalous bar can by allowing it to refer only to highly vulgar or obscene modes of expression.<sup>205</sup> Justice Breyer does not approve of the stringent denial of any “viewpoint discriminatory” matter as he believes there should be a sort balancing test to see if the regulation poses a danger to the speech the First Amendment is trying to protect.<sup>206</sup> He would “ask whether the regulation at issue ‘works speech-related harm that is out of proportion to its justifications.’”<sup>207</sup> Justice Breyer goes on to provide compelling rationale for the “highly vulgar or obscene” bar and states that “[t]he Government has at least a reasonable interest in ensuring that it is not involved in promoting highly vulgar or obscene speech, and that it will not be associated with such speech.”<sup>208</sup>

Finally, Justice Sotomayor offers the most persuasive opinion in an attempt to save the scandalous bar. She begins her opinion bleakly by stating that “[t]he Court’s decision today will beget unfortunate results.”<sup>209</sup> She argues that the scandalous term should be preserved only to bar obscenity, vulgarity, and profanity.<sup>210</sup> She provides convincing statutory interpretation, that shows that although the courts has seen the statute as containing an immoral and scandalous bar, “immoral” and “scandalous” are actually separated by an unrelated word—deceptive—and should be viewed separately.<sup>211</sup> She then goes on to provide examples of words that are not protected by the First Amendment, such as fighting words or defamatory words, and concludes that the reinterpreted scandalous bar should be viewed the same.<sup>212</sup> She also concludes that the “Government has a reasonable interest in refraining from lending its ancillary support to marks that are obscene, vulgar, or profane.”<sup>213</sup>

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205. *Id.* at 2304 (Breyer, J., concurring in part and dissenting in part).

206. *Id.*

207. *Id.* at 2305 (citing *United States v. Alvarez*, 567 U.S. 709, 730 (2012)).

208. *See id.* at 2306–07 (Sotomayor, J., concurring in part and dissenting in part).

209. *Id.* at 2308.

210. *Id.*

211. *See id.* at 2310–11.

212. *See id.* at 2313–14.

213. *Id.* at 2317.

## III. HOW TO WRITE NEW LEGISLATION

The multiple opinions published throughout *Tam* and *Brunetti* prove that there must be some protection against registering certain types of trademarks. Justice Sotomayor warned of a “coming rush to register such trademarks—and the Government’s immediate powerlessness to say no—is eminently avoidable.”<sup>214</sup> This rush has already begun by applicants attempting to register what can only be seen as the most “vulgar, profane, or obscene” trademark that an applicant can possibly register.<sup>215</sup> So long as these trademarks are used in commerce and are not misleading or run afoul with some other provision of the Lanham Act, they will end up being registered.

The overall policy rationale to avoid publishing these types of marks is evident, but may be lost on some. Justice Breyer articulates the most persuasive rationale for stopping the dissemination of these mark in that “the Government may have an interest in protecting the sensibilities of children.”<sup>216</sup> Protecting the sensibilities of children is paramount in our country and has been done for decades through the Federal Communications Commission’s (“FCC”) obscene, indecent, or profane material on television and radio.<sup>217</sup> Even as society is introduced to advances in technology, the concept of protecting children from certain content is relied upon by parents everywhere. To this effect, parental controls have been implemented into digital video services, video games, mobile devices, and many other forms of software.<sup>218</sup> Without the PTO’s ability to deny “vulgar, profane, or obscene” trademarks there is no agency, government or otherwise, protecting our children from this

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214. *Id.* at 2308.

215. *See, e.g.*, FUCK YOU PAY ME, *supra* note 1; PUSSY MONEY WEED, *supra* note 1.

216. *Brunetti*, 139 S. Ct. at 2307 (Breyer, J., concurring in part and dissenting in part) (citing *Denver Area Ed. Telecomms. Consortium, Inc. v. FCC*, 518 U.S. 727, 743 (1996)).

217. *See Obscene, Indecent and Profane Broadcasts*, FCC, <https://www.fcc.gov/consumers/guides/obscene-indecnt-and-profane-broadcasts> (Jan. 13, 2021).

218. *See Use Parental Controls on Your Child’s iPhone, iPad, and iPod Touch*, APPLE (Sept. 22, 2020), <https://support.apple.com/en-us/HT201304>; *YouTube Kids Parental Guide*, GOOGLE, <https://support.google.com/youtubekids/answer/6172308?hl=en> (last visited Mar. 20, 2020); *Family & Online Safety*, MICROSOFT XBOX, <https://beta.support.xbox.com/help/family-online-safety/browse> (last visited Mar. 20, 2020); Dalvin Brown, *Spotify Upgrades Family Plan Subscription, Rolls Out Parental Controls for Music Service*, USA TODAY (Aug. 20, 2019, 11:36 AM), <https://www.usatoday.com/story/tech/talkingtech/2019/08/19/spotify-adds-long-requested-parental-control-feature-family-plan/2049557001>.

content as there are no parental controls for life.

Justice Moore would have us believe that children are already exposed to odious content. She ends her opinion in *Brunetti* by explaining that “there are . . . a cadre of similarly offensive images and words that have secured copyright registration by the government. There are countless songs with vulgar lyrics, blasphemous images, scandalous books and paintings, all of which are protected under federal law.”<sup>219</sup> She may be right, but as a general public we are not inundated with odious content unless we choose to be. These vulgar lyrics that she speaks of are censored on the radio through the FCC or through the streaming service. The blasphemous images are not posted on the street corner, they are in a gallery where the copyright owner can charge admission. The scandalous books can be vetted by book reviewers before a reader picks it up. This is not the same for trademarks. Trademarks are posted in such a manner as to draw attention to itself and products. Without protections in place a child can view the vulgar trademarked name in their corner store with a parent powerless to intervene.

While as a society we initially think of functions like parental controls to protect children, these systems, and others, are used to protect the sensibilities of adults as well. An adult may not want to listen to profane music, and they can easily achieve this goal by listening to the radio and filtering out explicit songs on the streaming services.<sup>220</sup> Additionally, the Motion Picture Association’s film ratings system may be intended to help parents determine if a film is appropriate for their children, but it is also appropriate for adults to use to protect their own sensibilities.<sup>221</sup> Among other factors, the film ratings system has a direct correlation between how many “expletives” are used and how suitable the film is for children.<sup>222</sup> One can easily understand the likelihood of vulgar or obscene content by the rating of a film and, as such, may choose to forgo watching a restrictively rated movie in favor of one less restrictively rated and very likely more wholesome. This ability of avoidance of vulgar or obscene should not limited to entertainment and

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219. *In re Brunetti*, 877 F.3d 1330, 1357 (Fed. Cir. 2017).

220. *See How to Filter Out Explicit Songs on Spotify in a Few Quick Steps*, SPOTIFY (Oct. 4, 2019), <https://newsroom.spotify.com/2019-10-04/how-to-filter-out-explicit-songs-on-spotify-in-a-few-quick-steps/>.

221. *See Classifications and Rating Rules*, MOTION PICTURE ASS’N 1 (July 24, 2020), [https://www.filmratings.com/Content/Downloads/rating\\_rules.pdf](https://www.filmratings.com/Content/Downloads/rating_rules.pdf).

222. *See id.* at 7.

should be present for adults who go about their everyday tasks in the marketplace.

It is undeniable that there must be some protection from the dissemination of “vulgar, profane, or obscene” trademarks. Although the straightforward argument to make is the protection of the “sensibilities of children,” the sensibilities of adults that do not wish to partake in certain content is also relevant. With a hallmark of trademark law being to make the consumer experience more efficient, adults may not wish to wade through the trash of obscene or vulgar trademarks in hopes of purchasing the product they desire. It is clear that some protection must be provided and the Legislature must be the one to do so.<sup>223</sup>

A. *Can the Disparagement Provision Be Implemented in a Different Form?*

The Supreme Court has made it clear that “if a trademark registration bar is viewpoint-based, it is unconstitutional.”<sup>224</sup> The PTO’s two-part test consists of determining the likely meaning of a term, and then finding if it is disparaging to the group referenced. This test looks only to if one group disapproves of the term while presumably the group offering the term approves of it. This two-part test is inherently viewpoint-based and the effects of the test stemming from the disparagement provision are inherently viewpoint-based as well. As such, the provision is unlikely to be saved as it lived. This is not to say that disparagement should be entirely conceded through trademark law as the final proposed legislation can include a ban on contentless race-based epithets.<sup>225</sup>

B. *Can the Immoral Standard Be Implemented in a Different Form?*

Through the way that the dissenters who defended the scandalous standard intentionally differentiated the scandalous bar from the immoral bar, the likely answer is no.<sup>226</sup> The Supreme Court in *Brunetti* found that immoral means “inconsistent with rectitude, purity, or good morals” and determined it to be viewpoint-based.<sup>227</sup> Justice Sotomayor didn’t attempt

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223. See *Iancu v. Brunetti*, 139 S. Ct. 2294, 2308 (2019) (Breyer, J., concurring in part and dissenting in part).

224. *Id.* at 2299 (majority opinion).

225. See discussion *infra* Section III.D.

226. See Snow, *supra* note 202.

227. *Brunetti*, 139 S. Ct. at 2299.

to defend this finding and even took steps to perform statutory surgery to carve the immoral standard away from the scandalous standard, as they were traditionally read together.<sup>228</sup> Through the opinion in *Brunetti* and the dissents, it is clear that no attempt should be made to save a form of the immoral standard, partly because it is inherently viewpoint-based and partly because it was used only as a redundant way to say scandalous, in § 1052(a).

C. *Can the Scandalous Standard Be Implemented in a Different Form?*

The answer is yes, and it is what should eventually be done. In *Brunetti*, the Supreme Court did not rule this out; rather, the Court only decided not to narrow the statutory language of the scandalous provision.<sup>229</sup> The Court writes that “[t]he statute as written does not draw the line at lewd, sexually explicit, or profane marks.”<sup>230</sup> The issue in *Brunetti* was not whether the basis for the scandalous provision was unconstitutional, but whether the court could interpret the statute to read as constitutional. The subsequent answer was no.

The general theme of the concurrences and dissents to *Brunetti* is that the scandalous term must be narrowed in any successive legislation. Chief Justice Roberts writes that “‘scandalous’ need not be understood to reach marks that offend because of the ideas they convey; it can be read more narrowly to bar only marks that offend because of their mode of expression—marks that are obscene, vulgar, or profane.”<sup>231</sup> He is advocating for a focus on the mode of expression, which was argued by the Government to defeat the viewpoint bar. Justice Breyer offers that “we should interpret the word ‘scandalous’ in the present statute to refer only to certain highly ‘vulgar’ or ‘obscene’ modes of expression.”<sup>232</sup> Finally, Justice Sotomayor argues that “[p]rohibiting the registration of obscene, profane, or vulgar marks qualifies as reasonable, viewpoint-neutral, content-based regulation.”<sup>233</sup> By taking the majority opinion into account as well as the dissenting opinions, it is likely that the Court would allow a statutory bar on obscene, vulgar, and profane marks which stems

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228. *Id.* at 2309 (Sotomayor, J., concurring in part and dissenting in part).

229. *Id.* at 2301 (majority opinion).

230. *Id.*

231. *Id.* at 2303 (Roberts, J., concurring in part and dissenting in part).

232. *Id.* at 2304 (Breyer, J., concurring in part and dissenting in part).

233. *Id.* at 2317 (Sotomayor, J., concurring in part and dissenting in part).

from a narrowing construction of scandalous marks.

#### D. Proposed Legislation

Although the Supreme Court intentionally left the door open for a statutory rewrite of the scandalous provision of § 1052(a), a statutory rewrite should not be taken lightly with the ever evolving First Amendment jurisprudence. Just forty years ago in *McGinley*, the Federal Circuit ruled that refusal to register a trademark under the immoral or scandalous bar did not affect applicant's right to use it and thus did not abridge his First Amendment rights.<sup>234</sup> With the First Amendment being afforded wider protection, any statutory rewrite should be able to withstand a foreseeable First Amendment expansion.

The proposed legislation must be two-fold. First, a tangible government interest must be implicated in trademark law. Second, there must be a concrete way to ensure that viewpoint is not implicated.

The first portion of a statutory rewrite must be to give the government a tangible interest in ensuring that it does not promote obscene, vulgar, or profane speech. Chief Justice Roberts and Justices Breyer and Sotomayor agree that “[t]he Government has at least a reasonable interest in ensuring that it is not involved in promoting vulgar or obscene speech, and that it will not be associated with such speech.”<sup>235</sup> This may be so, but Judge Moore of the Federal Circuit was not persuaded that there was a government interest in trademark registration. This stems from the fact that, in 1991, the PTO's operations went from being underwritten by public funds to being substantially funded by registration fees.<sup>236</sup> This change made the trademark system wholly a statutory regime and not at all a subsidiary.

In response to this hurdle and to allow the government to express a tangible government interest, the PTO funding must change back to being underwritten by public funds, at least in part. By underwriting the trademark system with public funds, it exemplifies that the trademark system is not just in place to effectuate business needs but also to minimally regulate communication. In turn, any judge who wishes to

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234. *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981), *abrogated by In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015).

235. *See Brunetti*, 139 S. Ct. at 2306–07 (Breyer, J., concurring in part and dissenting in part).

236. *See In re Tam*, 785 F.3d at 580.

ensure the survival of a new trademark provision against obscene, vulgar, or profane marks can latch on to this new fee implementation as the funds will truly be used for public benefit.

This change back to being underwritten by public funds will be the first step in ensuring that a new statute barring obscene, vulgar, or profane speech will be able to survive the scrutiny of the courts. This new implementation of funding the PTO through public funds must be implemented as a tax, routed through the Treasury. As part of the trademark system includes a benefit granted to every citizen, the tax dollars must come from the people, but only in part. Similar to how regulatory fees are distinct from application fees in the FCC, so too can these public funds be in addition to the current application fee.<sup>237</sup> By implementing this system, the trademark registration process will be structured more as a subsidiary system with the authority to impose limits on the use of such funds to ensure they are used in the manner Congress intends.

The second statutory make up, is that Congress must state the intent to bar obscene, vulgar, or profane marks explicitly through a statute. One way to implement this statute would be to simply rephrase § 1052(a) to include a bar on obscene, vulgar, or profane marks. This would state: “No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—(a) Consists of or comprises . . . deceptive, [obscene, vulgar, or profane matter] . . . .”<sup>238</sup>

There are two main problems with this approach. The first, is that the new statute may survive under the Roberts Court, but may eventually be held unconstitutional with changes in First Amendment jurisprudence. Secondly, this rewrite would preserve the inconsistencies that were present when the PTO attempted to classify immoral or scandalous or disparaging marks.<sup>239</sup> Specifically, the PTO struggled with the disparagement provision as it became “impossible to fully enforce [because] its application became ‘highly subjective.’”<sup>240</sup> Although the

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237. See *Regulatory Fees*, FCC, <https://www.fcc.gov/licensing-databases/fees/regulatory-fees> (last visited Mar. 20, 2020).

238. 15 U.S.C. § 1052 (where proposed revisions are shown by alteration to the existing language).

239. See *supra* text accompanying notes 36–39, 45–48 (providing examples of trademarks that were granted or denied protection seemingly inconsistently).

240. Snow, *supra* note 202, at 434.

disparagement provision always had a degree of individuality to the analysis, this subjectivity could infect a minimal statutory rewrite when rational people disagree over what constitutes an obscene, vulgar, or profane mark.

The better way to grant the statutory authority to bar obscene, vulgar, or profane marks would be to explicitly grant the Department of Commerce the authority to hold words out as unregistrable after notice and comment rulemaking. This would be a grant of statutory authority to allow the Department of Commerce and subsequently the PTO to put a trademark applicant on notice of a running list of words that cannot appear in any trademark.

A word barred cannot be seen as a viewpoint barred. Statutory interpretation has taught the legal profession that “[w]ords are not pebbles in alien juxtaposition; they have only a communal existence; and not only does the meaning of each interpenetrate the other, but all in their aggregate take their purport from the setting in which they are used.”<sup>241</sup> A singular word cannot express a viewpoint unless used in conjunction with another word. For example, simply stating the word “cancer” creates no viewpoint, but adding a word to create the phrase “eradicate cancer” expresses a definitive viewpoint. Also, words, especially profane words, can have almost an immeasurable amount of meanings. A word like “fuck” has been likened to silly putty, where one can stretch it to just about any meaning that you need to.<sup>242</sup> When words are written, as is usually done with a trademark, and appear in a vacuum, there is no viewpoint conveyed because of the lack of context and potential ambiguity of the definition.

This “running list” of barred words (and types of images) would allow obscene, vulgar, and profane marks to be barred, as well as the worst race-based epithets.<sup>243</sup> In addition to that list, the phonetic equivalent and derivatives of the words on the list would also be barred. A list can easily be generated by using the tactics that the Board uses to evaluate a trademark application.<sup>244</sup> The difference is that this list would then need to go through notice and comment rule making so that the

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241. *NLRB v. Federbush Co.*, 121 F.2d 954, 957 (2d Cir. 1941).

242. *History of Swear Words: F\*\*\*k* (Netflix Jan. 5, 2021).

243. See Sonia K. Katyal, *Brands Behaving Badly*, 109 TRADEMARK REP. 819, 824–27 (2019) (discussing the run on registering the worst race-based epithets and the intentions of some applicants).

244. See *supra* Sections I.B.1, I.C.1.

public can weigh in on what words may meet the obscene, vulgar, and profane threshold. The notice and comment rulemaking process and subsequent publication in the Federal Register also has the effect of putting potential applicants on notice of the barred words. This solves the problem of allowing viewpoints to be expressed through trademarks in two ways. First, a viewpoint is unlikely to be expressed through a singular word. Second, even if so, a person can still express their viewpoint, they just may not do so by utilizing a limited number of barred words.

This also solves the problem of the public being inundated with abysmal language during their shopping experience. The counterpoint may be that people will be inundated by new and similar meaning words, but that is what is meant to be preserved. The “list” leaves the door open for businesses to conjure up creative ways to express a previously vulgarly expressed viewpoint and allows for the freedom of speech. This protects the sensibilities of children and the average consumer because even if there was a clever way to express a vulgar concept, that actual word would not be present.

Finally, the list may and should be updated on a yearly or multi-yearly basis by the Department of Commerce to include newly obscene, vulgar, or profane words and potentially purge words that may no longer meet the obscene, vulgar, or profane threshold. The courts have stated that obscene, vulgar, and profane words have evolved over time as these types of words arose from religious phrases and have evolved into words based on sexual or excretory functions. While the evolution of unique obscene, vulgar, and profane words may have slowed in the past century or more, the emergence of more acronyms used in the English language should prompt the Department of Commerce to be on guard for new words to bar. By the Department of Commerce being able to update the list, it allows for an evolution of the bar on certain obscene, vulgar, and profane words.

#### CONCLUSION

The proposed legislation for filling the major hole left by § 1052(a) must be two-fold. First, a tangible government interest must be implicated in trademark law by using tax dollar to fund the trademark system. Second, there must be a concrete way to ensure that viewpoint is not implicated and this can be achieved by the Department of Commerce publishing a list of words barred from trademark registration.