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It's Scandalous! – Limiting Profane Trademark Registrations after "Tam" and "Brunetti"

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It's Scandalous! – Limiting Profane Trademark Registrations after "Tam" and "Brunetti"

Cover Page Footnote

Earl F. Nelson Professor of Law, University of Missouri School of Law. I wish to thank my colleague Ilhyung Lee for thoughtful conversations regarding the issues relevant to this article and for his own contributions to the dialogue. I also thank Bridget Myers for her comments on a draft of this article. Any remaining errors are mine alone.

**IT'S SCANDALOUS! – LIMITING PROFANE
TRADEMARK REGISTRATIONS AFTER *TAM* AND
*BRUNETTI***

By Gary Myers¹

“Scandal is gossip made tedious by morality.”
— Oscar Wilde, *Lady Windermere’s Fan*

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I. INTRODUCTION

Over the course of the last two years, the Supreme Court has engaged in a long-overdue assessment of the constitutionality of federal trademark law prohibitions on the registration of offensive marks. In its unanimous 2017 decision in *Matal v. Tam*,² the Court held that the disparagement clause is a content-based provision that violates the First Amendment. In 2019, the Court in *Iancu v. Brunetti*³ held that the refusal to register the mark “FUCT” on grounds that it was immoral or scandalous would also violate the First Amendment.⁴ These cases offered an opportunity for the Court to clarify the proper role of free speech analysis in the context of the federal trademark registration system. The central holding of both cases is that content-based prohibitions related to the viewpoint or message conveyed by a trademark cannot be precluded from registration.⁵

In light of *Tam* and *Brunetti*, the Lanham Act’s provision precluding registration of any disparaging, scandalous, or immoral mark is invalid and unenforceable. This leaves the government with no statutory basis for refusing to register marks containing vulgar, profane, or obscene words and images. The question going forward, however, is whether these landmark cases would nevertheless leave open an opportunity for Congress to draft a new, more narrowly tailored prohibition on marks that would not present the same breadth of First Amendment concerns. Thus, this article explores whether a statute (along with implementing regulations) precluding the registration of vulgar, profane, and obscene marks might be drafted such that it constitutes a reasonable, viewpoint-neutral restriction on speech.

II. THE LANHAM ACT PROHIBITIONS AND THE GAME-CHANGING RULING IN *TAM*

The Lanham Act, which governs federal protection for trademarks, was passed to protect the purchasing public by providing accurate information about the source of goods and services,⁶ protect trademark owners who make

² 137 S. Ct. 1744 (2017).

³ 139 S. Ct. 2294 (2019).

⁴ *Id.* at 2297.

⁵ *See Tam*, 137 S. Ct. 1744; *Brunetti*, 139 S. Ct. 2294.

⁶ *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 782 n.15 (1992) (Stevens, J., concurring) (The Lanham Act allows purchasers to “be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get.”) (quoting S. REP. NO. 79-1333, at 3 (1946)).

investments in the goodwill of their brands,⁷ and establish a nationwide system for the registration and protection of marks.

Section 2 of the Lanham Act identifies which trademarks can be registered on the principal register and which were intended to be barred from federal registration. It states:

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 immoral, deceptive, or scandalous matter; or 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; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.⁸

For many years, trademark owners and practitioners endured the inconsistent and often arbitrary enforcement of these prohibitions, which were finally challenged by Simon Tam and his Asian–American dance-rock band in the now-famous case of *Matal v. Tam*.⁹ The group decided to name themselves, and adopt as a brand, “The Slants.”¹⁰ Their express purpose was to “reclaim” and “take ownership” of Asian stereotypes and childhood slurs by making use of this term in a positive, affirmative way.¹¹ When the group sought federal registration for

⁷ *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 854 n.14 (1982) (“By applying a trademark to goods produced by one other than the trademark’s owner, the infringer deprives the owner of the goodwill which he spent energy, time, and money to obtain. At the same time, the infringer deprives consumers of their ability to distinguish among the goods of competing manufacturers.”) (citing S. Rep. No. 79-1333, at 3 (2d Sess. 1946); H.R. Rep. No. 76-944, at 3 (1st Sess. 1939)).

⁸ 15 U.S.C. § 1052 (2012).

⁹ 137 S. Ct. 1744 (2017).

¹⁰ *Id.* at 1754.

¹¹ *Id.*

this mark, the trademark examiner refused to register it, deeming it disparaging to persons of Asian descent.¹²

After unsuccessful appeals to the Trademark Trial & Appeal Board and the Federal Circuit, Tam prevailed at the Federal Circuit¹³ en banc and eventually reached the Supreme Court. Writing a unanimous opinion on this point, Justice Alito struck down the prohibition on disparaging marks: “We now hold that this provision violates the Free Speech Clause of the First Amendment. It offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend.”¹⁴ The Court rejected the argument that the restriction was government speech, finding that it denied the important benefits of federal registration based on the content and viewpoint expressed by the trademark owner.¹⁵ The justices were split on whether to address other issues in the case, but all agreed with this fundamental proposition.¹⁶ Justice Kennedy, writing for himself and three other justices, noted in his concurrence “that the viewpoint discrimination rationale renders unnecessary any extended treatment of other questions raised by the parties.”¹⁷

III. THE BRUNETTI DECISION

Unlike the unanimous ruling in *Matal v. Tam*, the Court in *Brunetti* was divided on one of the two key issues. Justice Kagan delivered the opinion of the Court, joined by Justices Thomas, Ginsburg, Alito, Gorsuch, and Kavanaugh. The opening paragraph summarizes the history and ruling succinctly:

Two Terms ago, in *Matal v. Tam*, this Court invalidated the Lanham Act’s bar on the registration of “disparag[ing]” trademarks. Although split between two non-majority opinions, all Members of the Court agreed that the provision violated the First Amendment because it discriminated on the basis of viewpoint. Today we consider a First Amendment challenge to a neighboring provision of the Act, prohibiting the registration of “immoral[] or scandalous” trademarks. We hold that this

¹² *Id.*

¹³ *In re Tam*, 808 F.3d 1321, 1328 (Fed. Cir. 2015) (en banc).

¹⁴ *Matal v. Tam*, 137 S.Ct. 1744, 1751 (2017).

¹⁵ *Id.* at 1753, 1758-60.

¹⁶ *Id.* at 1750.

¹⁷ *Id.* at 1765 (Kennedy, J. concurring). For commentary on the issues in the *Matal* case, see Gary Myers, *Trademarks & The First Amendment After Matal v. Tam*, 26 J. INTELL. PROP. L. 67, 85 (2018); Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Protection and Free Speech*, 92 NOTRE DAME L. REV. 381, 382 (2016); see also Ned Snow, *Free Speech & Disparaging Trademarks*, 55 BOSTON COLLEGE L. REV. 1639 (2016).

provision infringes the First Amendment for the same reason: It too disfavors certain ideas.¹⁸

The facts of the case were simple — Erik Brunetti is an artist and entrepreneur who developed a clothing line under the brand name FUCT.¹⁹ According to Brunetti, the name is pronounced as four separate letters: F-U-C-T.²⁰ However, as the Court noted: “But you might read it differently and, if so, you would hardly be alone. See Tr. of Oral Arg. 5 (describing the brand name as ‘the equivalent of [the] past participle form of a well-known word of profanity’).”²¹ Relying on the prohibitions on registration of immoral or scandalous marks, the U.S. Patent and Trademark Office (PTO) rejected Brunetti’s application.²²

Section 1052(a) prohibits registration of a mark that “[c]onsists of or comprises immoral, deceptive, or scandalous matter.”²³ The Court acknowledged that the PTO interprets this bar as a “unitary provision,” rather than treating the two adjectives as separate prohibitions.²⁴ This point proves important given the justices’ eventual split on a possible narrowing interpretation. Justice Kagan noted that the standard focuses on “whether a ‘substantial composite of the general public’ would find the mark ‘shocking to the sense of truth, decency, or propriety’; ‘giving offense to the conscience or moral feelings’; ‘calling out for condemnation’; ‘disgraceful’; ‘offensive’; ‘disreputable’; or ‘vulgar.’”²⁵

The Brunetti application was reviewed and rejected by both the PTO examining attorney and the Trademark Trial and Appeal Board. The stated reasons for these decisions highlight the content discrimination problem with the bar — the examining attorney deemed “FUCT” to be “a total vulgar” mark and the Board observed that the mark was “highly offensive,” “vulgar,” with “decidedly negative sexual connotations.”²⁶ Because it appeared in a context of “extreme nihilism,” the Board believed it delivered a message of “misogyny, depravity, [and] violence.”²⁷ On appeal, the Federal Circuit held the prohibition violated the First Amendment, and the Supreme Court then granted certiorari.²⁸

¹⁸ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019) (alterations in original) (citations omitted).

¹⁹ *Id.*

²⁰ *Id.*

²¹ *Id.* (alteration in original).

²² *Id.* at 2298.

²³ 15 U.S.C. § 1052(a) (2012).

²⁴ *Brunetti*, 139 S. Ct. at 2298.

²⁵ *Id.* (quoting *In re Brunetti*, 877 F.3d 1330, 1336 (D.C. Cir. 2017)).

²⁶ *Id.* (quoting the record below) (alterations in original).

²⁷ *Id.* (quoting the record below) (alterations in original).

²⁸ *Iancu v. Brunetti*, 139 S. Ct. 782 (2019).

Justice Kagan began her analysis by noting that the Court in *Tam* struck down the Lanham Act's ban on registering disparaging marks as a violation of the First Amendment.²⁹ As she pointed out, "all the Justices agreed on two propositions. First, if a trademark registration bar is viewpoint-based, it is unconstitutional. And second, the disparagement bar was viewpoint-based."³⁰ The Court "could not agree on the overall framework for deciding the case. (In particular, no majority emerged to resolve whether a Lanham Act bar is a condition on a government benefit or a simple restriction on speech)."³¹

The heart of the matter, then, becomes whether "the 'immoral or scandalous' criterion in the Lanham Act [is] viewpoint-neutral or viewpoint-based. . . [i]t is viewpoint-based."³² Justice Kagan cited a long string of definitions and interpretations demonstrating that the bar was designed to reject the proposed trademark based on governmental disapproval of the messages being conveyed.³³ For example, the Court pointed out that the marks "YOU CAN'T SPELL HEALTHCARE WITHOUT THC" for pain-relief medication and "KO KANE" for beverages were rejected, while the marks "D.A.R.E. TO RESIST DRUGS AND VIOLENCE" and "SAY NO TO DRUGS—REALITY IS THE BEST TRIP IN LIFE" were approved.³⁴

As the Court noted, the Government essentially conceded that the Lanham Act's language and the PTO's prior interpretations disfavored certain ideas based on content, but urged the Court to consider the statute's susceptibility to a

²⁹ *Id.* (citation omitted).

³⁰ *Id.* at 2299 (citations omitted).

³¹ *Id.* at 2298-99. The opinion elaborated on the areas of agreement as follows:

The Justices thus found common ground in a core postulate of free speech law: The government may not discriminate against speech based on the ideas or opinions it conveys. In Justice Kennedy's explanation, the disparagement bar allowed a trademark owner to register a mark if it was "positive" about a person, but not if it was "derogatory." That was the "essence of viewpoint discrimination," he continued, because "[t]he law thus reflects the Government's disapproval of a subset of messages it finds offensive." Justice [Alito] emphasized that the statute "denie[d] registration to any mark" whose disparaging message was "offensive to a substantial percentage of the members of any group." The bar thus violated the "bedrock First Amendment principle" that the government cannot discriminate against "ideas that offend." Slightly different explanations, then, but a shared conclusion: Viewpoint discrimination doomed the disparagement bar.

Id. at 2299 (alterations in original) (citations omitted).

³² *Id.*

³³ *Id.* at 2299-300.

³⁴ *Id.* at 2300 (citations omitted).

limiting construction that would remove the viewpoint discrimination.³⁵ This interpretation would focus upon the mode of expression, limiting the bar to vulgar, lewd, sexually explicit, or profane words, regardless of the message being conveyed.³⁶ The Court rejected this solution:

This Court, of course, may interpret “ambiguous statutory language” to “avoid serious constitutional doubts.” But that canon of construction applies only when ambiguity exists. “We will not rewrite a law to conform it to constitutional requirements.” So even assuming the Government’s reading would eliminate First Amendment problems, we may adopt it only if we can see it in the statutory language. And we cannot. The “immoral or scandalous” bar stretches far beyond the Government’s proposed construction. The statute as written does not draw the line at lewd, sexually explicit, or profane marks. Nor does it refer only to marks whose “mode of expression,” independent of viewpoint, is particularly offensive. It covers the universe of immoral or scandalous—or (to use some PTO synonyms) offensive or disreputable—material. Whether or not lewd or profane. Whether the scandal and immorality comes from mode or instead from viewpoint. To cut the statute off where the Government urges is not to interpret the statute Congress enacted, but to fashion a new one.³⁷

Having rejected the proposal for a limiting construction, the majority readily found the statute unconstitutional. The Court rejected the Government’s last grasp at an argument—that the provision should only be struck down as applied in this case, given that it might have some lawful applications in other contexts: “this Court has never applied that kind of analysis to a viewpoint-discriminatory law.”³⁸ Moreover, the Court deemed the Lanham Act bar to be overbroad: “There are a great many immoral and scandalous ideas in the world (even more than there are swearwords), and the Lanham Act covers them all. It therefore violates the First Amendment.”³⁹

Justice Alito filed a concurring opinion designed to make two foundational points. First, he reaffirmed a broad concept of free speech:

³⁵ *Id.* at 2301.

³⁶ *Id.*

³⁷ *Id.* at 2301-02 (citations omitted).

³⁸ *Id.* at 2302.

³⁹ *Id.*

Viewpoint discrimination is poison to a free society. But in many countries with constitutions or legal traditions that claim to protect freedom of speech, serious viewpoint discrimination is now tolerated, and such discrimination has become increasingly prevalent in this country. At a time when free speech is under attack, it is especially important for this Court to remain firm on the principle that the First Amendment does not tolerate viewpoint discrimination. We reaffirm that principle today.⁴⁰

Second, he noted that Congress could draft a narrowly tailored statute barring the registration of vulgar marks, such as the one in this case, “that play no real part in the expression of ideas. . . The term suggested by that mark is not needed to express any idea and, in fact, as commonly used today, generally signifies nothing except emotion and a severely limited vocabulary. The registration of such marks serves only to further coarsen our popular culture.”⁴¹

Chief Justice Roberts, concurring in part and dissenting in part, also made two fundamental points.⁴² First, he agreed with the majority that the ban on registering an immoral mark is not susceptible to a narrowing construction, but believed that such a construction *could* be given to the prohibition on scandalous marks. Second, he stated that “[t]he First Amendment protects the freedom of speech; it does not require the Government to give aid and comfort to those using obscene, vulgar, and profane modes of expression.”⁴³

Justice Breyer also concurred in part and dissented in part.⁴⁴ Like the Chief Justice, he agreed with Justice Sotomayor that the “scandalous” bar could be interpreted to “apply only to certain highly ‘vulgar’ or ‘obscene’ modes of expression.”⁴⁵ Justice Breyer believes that First Amendment cases should be viewed primarily from a balancing approach, rather than a categorical one. Categorical approaches use what he views as rigid frameworks to analyze each case.⁴⁶ He would focus on whether the restriction in question “wor[ks] harm to First Amendment interests that is disproportionate in light of the relevant regulatory objectives?”⁴⁷ Applying this rubric, Justice Breyer agreed with Justice Sotomayor’s view that the “scandalous” bar is constitutional if applied only to vulgar or obscene modes of expression:

⁴⁰ *Id.* at 2302-03 (Alito, J., concurring).

⁴¹ *Id.* at 2303.

⁴² *Id.* (Roberts, C.J., concurring in part and dissenting in part).

⁴³ *Id.* at 2303-04.

⁴⁴ *Id.* at 2304 (Breyer, J., concurring in part and dissenting in part).

⁴⁵ *Id.*

⁴⁶ *Id.* at 2304-05.

⁴⁷ *Id.* at 2306 (citations omitted).

How much harm to First Amendment interests does a bar on registering highly vulgar or obscene trademarks work? Not much. The statute leaves businesses free to use highly vulgar or obscene words on their products, and even to use such words directly next to other registered marks. Indeed, a business owner might even use a vulgar word as a trademark, provided that he or she is willing to forgo the benefits of registration.⁴⁸

Finally, Justice Sotomayor filed an opinion concurring in part and dissenting in part, expressing concern about the lack of an enforceable ban on any vulgar words or images: “The Court’s decision today will beget unfortunate results. With the Lanham Act’s scandalous-marks provision . . . struck down as unconstitutional viewpoint discrimination, the Government will have no statutory basis to refuse (and thus no choice but to begin) registering marks containing the most vulgar, profane, or obscene words and images imaginable.”⁴⁹ In her view, joined by three other justices, the Lanham Act’s prohibition could be construed to preclude “only obscenity, vulgarity, and profanity. Such a narrowing construction would save that duly enacted legislative text by rendering it a reasonable, viewpoint-neutral restriction on speech that is permissible in the context of a beneficial governmental initiative like the trademark-registration system.”⁵⁰ Importantly, her approach received support from Chief Justice Roberts, Justice Breyer, and (at least implicitly) from Justice Alito.⁵¹

Elaborating on her view, Justice Sotomayor acknowledged and agreed with the majority that the ban on *immoral* marks is unconstitutional, as it “clearly connotes a preference for ‘rectitude and morality’ over its opposite.”⁵² The term “scandalous,” however, is ambiguous, and “can be read broadly (to cover both offensive ideas and offensive manners of expressing ideas), or it can be read narrowly (to cover only offensive modes of expression).”⁵³ This, in her view, makes it possible to have a limiting construction on the scope of the ban. This approach is buttressed, she contends, by the use of three different prohibitions in section 1052(a):

With marks that are offensive because they are disparaging and
marks that are offensive because they are immoral already

⁴⁸ *Id.*

⁴⁹ *Id.* at 2308 (Sotomayor, J., concurring in part and dissenting in part).

⁵⁰ *Id.*

⁵¹ *See id.* at 2302–04.

⁵² *Id.* at 2309 (citation omitted).

⁵³ *Id.*

covered, what work did Congress intend for “scandalous” to do? A logical answer is that Congress meant for “scandalous” to target a third and distinct type of offensiveness: offensiveness in the mode of communication rather than the idea. The other two words cover marks that are offensive because of the ideas they express; the “scandalous” clause covers marks that are offensive because of the mode of expression, apart from any particular message or idea.⁵⁴

IV. FASHIONING A CONSTITUTIONALLY PERMISSIBLE STATUTE

Now that the Supreme Court has struck down the Lanham Act prohibitions on registering disparaging, scandalous, and immoral marks, there is no constitutionally valid prohibition on the registration of offensive or scandalous trademarks whatsoever — regardless of how these might be defined. The question in light of *Tam* and *Brunetti* is whether Congress can enact a newly revised prohibition without violating the First Amendment. Commentators note that there is a compelling need for a limit on content that can be registered as a federal trademark.⁵⁵

Clues can be found in the justices’ opinions, particularly in *Brunetti*. Justice Kagan’s majority opinion rejected the proposal to give a limiting construction in the following statement:

The statute as written does not draw the line at lewd, sexually explicit, or profane marks. Nor does it refer only to marks whose “mode of expression,” independent of viewpoint, is particularly offensive. It covers the universe of immoral or scandalous—or (to use some PTO synonyms) offensive or disreputable—material. Whether or not lewd or profane. Whether the scandal and immorality comes from mode or instead from viewpoint. To cut the statute off where the Government urges is not to interpret the statute Congress enacted, but to fashion a new one.⁵⁶

This language is instructive towards fashioning a statute that might pass constitutional muster. In effect, to be permissible under the First Amendment, the prohibition must focus on the mode of expression — the use of particular

⁵⁴ *Id.* at 2310.

⁵⁵ See, e.g., Ilhyung Lee, *Tam Through the Lens of Brunetti: THE SLANTS, FUCTION, 69 EMORY L.J. ONLINE 2001 (2019)*.

⁵⁶ *Brunetti*, 139 S. Ct. at 2301-02 (citation omitted).

words or images that are lewd, profane, or sexually explicit — rather than on the meaning, viewpoint, or message being conveyed by the mark.

Similarly, Justice Alito stated the following in his concurring opinion:

Our decision does 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*. The particular mark in question in this case could be denied registration under such a statute. The term suggested by that mark is not needed to express any idea and, in fact, as commonly used today, generally signifies nothing except emotion and a severely limited vocabulary. The registration of such marks serves only to further coarsen our popular culture.⁵⁷

Chief Justice Roberts, concurring in part and dissenting in part, contended that a narrowing construction could be given to the prohibition on scandalous marks.⁵⁸ Further, he stated that “[t]he First Amendment protects the freedom of speech; it does not require the Government to give aid and comfort to those using *obscene, vulgar, and profane modes of expression*.”⁵⁹

Justice Breyer also agreed with Justice Sotomayor that “we should interpret the word ‘scandalous’ in the present statute to refer only to certain highly ‘vulgar’ or ‘obscene’ modes of expression.”⁶⁰ If applied only to vulgar or obscene modes of expression, he viewed the harm to First Amendment interests to be minimal. Elaborating on this point, he noted that:

[T]he field at issue here, trademark law, is a highly regulated one with a specialized mission: to “hel[p] consumers identify goods and services that they wish to purchase, as well as those they want to avoid.” As I have noted, that mission, by its very nature, requires the Government to impose limitations on speech. . . . Now consider, by way of contrast, the Government’s interests in barring the registration of *highly vulgar or obscene trademarks*. For one thing, when the Government registers a mark, it is necessarily “involv[ed] in promoting” that mark. The Government has at least a reasonable interest in ensuring that it is not involved in promoting highly vulgar or obscene speech,

⁵⁷ *Id.* at 2303 (Alito, J., concurring) (emphasis added).

⁵⁸ *Id.* (Roberts, C.J., concurring in part and dissenting in part).

⁵⁹ *Id.* at 2303-04 (emphasis added).

⁶⁰ *Id.* at 2304 (Breyer, J., concurring in part and dissenting in part) (internal citations omitted).

and that it will not be associated with such speech. For another, scientific evidence suggests that certain highly vulgar words have a physiological and emotional impact that makes them different in kind from most other words.⁶¹

Importantly for purposes of this discussion, Justice Breyer observed that the list of offensive terms:

[H]as changed over time: In the last few centuries, the list has evolved away from words of religious disrespect and toward words that are sexually explicit or that crudely describe bodily functions. And the list of swear words may be evolving yet again, perhaps in the direction of including race-based epithets.⁶²

Finally, he noted that the government may have an interest in preventing highly vulgar or obscene words from being displayed in public spaces and retail establishments where children are likely to be present.⁶³

In Justice Sotomayor's view, the Lanham Act's prohibition could be construed to preclude "only *obscenity, vulgarity, and profanity*. Such a narrowing construction would save that duly enacted legislative text by rendering it a reasonable, viewpoint-neutral restriction on speech, which is permissible in the context of a beneficial governmental initiative like the trademark-registration system."⁶⁴ In her view, the prohibition on immoral or scandalous marks should be viewed as "holding a distinct, nonredundant meaning, with 'immoral' covering marks that are offensive because they transgress social norms, and 'scandalous' covering marks that are offensive because of the mode in which they are expressed."⁶⁵

Justice Sotomayor's opinion does offer a general roadmap for how a revised statute might be framed to meet constitutional concerns — albeit by Congress rather than through a limiting construction from the Court. The revised statute, perhaps in combination with PTO guidance, would be aimed solely at offensive modes of expression: obscenity, vulgarity, or profanity. Obscenity can be

⁶¹ *Id.* at 2306-07 (emphasis added) (citations omitted).

⁶² *Id.* at 2307 (citations omitted).

⁶³ *Id.* (citing *Denver Area Ed. Telecommunications Consortium, Inc. v. FCC*, 518 U.S. 727, 743 (1996) (plurality opinion) (governmental interest in "protec[ting] children from exposure to patently offensive sex-related material" (alteration in original)); *Ginsberg v. New York*, 390 U.S. 629, 640 (1968) ("interest in the well-being of its youth").

⁶⁴ *Id.* at 2308 (Sotomayor, J., concurring in part and dissenting in part) (emphasis added).

⁶⁵ *Id.* at 2311.

delineated by the standard set forth in *Miller v. California*.⁶⁶ The *Miller* test requires three elements to deem material as obscene:

- (a) whether ‘the average person, applying contemporary community standards’ would find that the work, taken as a whole, appeals to the prurient interest;
- (b) whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law; and
- (c) whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value.”⁶⁷

This well-established three-part test can be incorporated into any prohibition on registration of obscene marks.

Vulgarity or profanity would be limited to a “small group of lewd words or ‘swear’ words that cause a visceral reaction, that are not commonly used around children, and that are prohibited in comparable settings.”⁶⁸ Justice Sotomayor cites a variety of provisions that cover similar content in contexts such as radio broadcasts and Coast Guard regulations.⁶⁹ As she notes, “[e]veryone can think of a small number of words (including the apparent homonym of Brunetti’s mark) that would. . . plainly qualify.”⁷⁰

Would Justice Sotomayor’s proposed language satisfy the *Brunetti* majority’s concerns if enacted through a combination of legislation and PTO action? The key is whether such a restriction could be deemed content-neutral:

While the line between viewpoint-based and viewpoint-neutral content discrimination can be “slippery,” it is in any event clear that a regulation is not viewpoint discriminatory (or even content discriminatory) simply because it has an “incidental effect” on a

⁶⁶ See 413 U.S. 15, 24-26 (1973).

⁶⁷ *Id.* at 24 (citations omitted).

⁶⁸ *Brunetti*, 139 S. Ct. at 2311 (Sotomayor, J., concurring in part and dissenting in part).

⁶⁹ See *id.* (citing 18 U.S.C. § 1464 (prohibiting “obscene, indecent, or profane language” in radio communications); *FCC v. Pacifica Foundation*, 438 U.S. 726, 746, 746 n.22 (1978) (opinion of Stevens, J.) (discussing a regulator’s monologue containing various “four-letter words”); 46 C.F.R. § 67.117(b)(3) (2018) (Coast Guard regulation prohibiting vessel names involving “obscene, indecent, or profane language, or . . . racial or ethnic epithets”); see also Leslie G. Jacobs, *The Public Sensibilities Forum*, 95 NW. U.L. REV. 1357, 1416–17, 1417 n.432 (2001) (citing one state agency’s list of words).

⁷⁰ See *Brunetti*, 139 S. Ct. at 2311.

certain subset of views. Some people, for example, may have the viewpoint that society should be more sexually liberated and feel that they cannot express that view sufficiently without the use of pornographic words or images. That does not automatically make a restriction on pornography into viewpoint discrimination, despite the fact that such a restriction limits communicating one's views on sexual liberation in that way.⁷¹

Further, she cites the example of fighting words, which “are categorically excluded from the protection of the First Amendment not because they have no content or express no viewpoint (often quite the opposite), but because their content embodies a particularly intolerable (and socially unnecessary) *mode* of expressing *whatever* idea the speaker wishes to convey.”⁷²

The most difficult free speech case to distinguish, as Justice Sotomayor's opinion recognizes,⁷³ is *Cohen v. California*,⁷⁴ where the Supreme Court struck down the criminal conviction for disturbing the peace of a person wearing a jacket with the words “Fuck the Draft” whilst walking the corridor of a courthouse. She contrasts this criminal law context with the federal regulatory setting in which the trademark ban would be enforced.⁷⁵ First she notes that trademark rights:

[A]rise through use, not registration. Regardless of whether a trademark is registered, it can be used, owned, and enforced against would-be infringers. . . Registration, in short, is a helpful system, but it is one that the Government is under no obligation to establish and that is collateral to the existence and use of trademarks themselves.⁷⁶

She then observes that the Court has treated these types of governmental initiatives as one of two categories. The first is a limited public (or nonpublic) forum, such as a program providing funds to recognized student groups or a program allowing approved charitable organizations to solicit donations from

⁷¹ *Id.* at 2313 (citations omitted).

⁷² *Id.* at 2314 (citations and quotations omitted).

⁷³ *Id.* at 2314–15.

⁷⁴ 403 U.S. 15 (1971).

⁷⁵ *Brunetti*, 139 S. Ct. at 2314–15.

⁷⁶ *Id.* at 2316 (Sotomayor, J., concurring in part and dissenting in part).

federal employees.⁷⁷ The second involves a government program or subsidy, such as a program providing funds to legal services organizations or a grant program for the arts.⁷⁸

In these contexts, she notes, “[r]egardless of the finer distinctions between these labels, reasonable, viewpoint-neutral content discrimination is generally permissible under either framework.”⁷⁹ Applying this categorical analysis to the present case, she contends:

Whichever label one chooses here, the federal system of trademark registration fits: It is, in essence, an opportunity to include one’s trademark on a list and thereby secure the ancillary benefits that come with registration. Just as in the limited-forum and government-program cases, some speakers benefit, but no speakers are harmed. Brunetti, for example, can use, own, and enforce his mark regardless of whether it has been registered. Whether he may register his mark can therefore turn on reasonable, viewpoint-neutral content regulations.⁸⁰

This leads to the heart of Justice Sotomayor’s view on the scope of permissible regulation of offensive trademarks: “[p]rohibiting the registration of obscene, profane, or vulgar marks qualifies as reasonable, viewpoint-neutral, content-based regulation.”⁸¹ The Government has a legitimate interest to not associate itself with this type of speech.⁸²

In assessing the new type of trademark statute that could pass constitutional muster after *Tam* and *Brunetti*, it is important to see how the majority addressed the suggestion that the “scandalous” bar could be given a narrowing interpretation. Justice Kagan’s majority opinion addressed how to interpret this broad term:

⁷⁷ *Id.* (citing *Christian Legal Soc’y Chapter of Univ. of Cal., Hastings College of Law v. Martinez*, 561 U.S. 661, 669–670, 682 (2010) (evaluating a program providing funds to recognized student groups); *Rosenberger v. Rector and Visitors of Univ. of Va.*, 515 U.S. 819, 823–824, 829–830 (1995) (same); *Cornelius v. NAACP Legal Defense & Ed. Fund, Inc.*, 473 U.S. 788, 790–791, 799–801, 806 (1985) (program allowing approved charitable organizations to solicit donations from federal employees)).

⁷⁸ *Brunetti*, 139 S. Ct. at 2316 (citing *Legal Serv. Corp. v. Velazquez*, 531 U.S. 533, 536, 543–544 (2001) (program providing funds to legal services organizations); *Nat’l Endowment for Arts v. Finley*, 524 U.S. 569, 573, 585–587 (1998) (grant program for the arts)).

⁷⁹ *Brunetti*, 139 S. Ct. at 2316–17 (citing *Christian Legal Soc’y*, 561 U.S. at 679; *Velazquez*, 531 U.S. at 543–544, 548–549; *Ysursa v. Pocatello Ed. Ass’n.*, 555 U.S. 353, 355 (2009)).

⁸⁰ *Id.* at 2317.

⁸¹ *Id.*

⁸² *Id.* (citing *Ysursa*, 555 U.S. at 359–360; *Cornelius*, 473 U.S. at 809).

Remember that the dictionaries define it to mean offensive, disreputable, exciting reprobation, and so forth. Even if hived off from “immoral” marks, the category of scandalous marks thus includes *both* marks that offend by the ideas they convey *and* marks that offend by their mode of expression. And its coverage of the former means that it discriminates based on viewpoint. We say nothing at all about a statute that covers only the latter — or, in the Government’s more concrete description, a statute limited to lewd, sexually explicit, and profane marks.⁸³

In viewing categories of unprotected speech, other “modes of expression, such as fighting words or extremely loud noises, could also be called shocking or offensive in certain contexts, but it is hard to see how they would apply in the context of a trademark.”⁸⁴ Justice Sotomayor noted that obscenity can clearly be prohibited, a proposition that all of the justices presumably agree with: “Of course, obscenity itself is subject to a longstanding exception to First Amendment protection, so it is proscribable in any event.”⁸⁵ Addressing vulgarity and profanity, on the other hand, she noted that “they are not subject to any such exception, and a regulation like § 1052(a)’s ban on the registration of scandalous marks is not ‘justified without reference to the content of the regulated speech’ in the way that a simple regulation of time, place, or manner is.”⁸⁶

Significantly, Justice Sotomayor highlighted one particular word for specific discussion:

There is at least one particularly egregious racial epithet that would fit this description as well. While *Matal v. Tam* removed a statutory basis to deny the registration of racial epithets in general, the Government represented at oral argument that it is holding in abeyance trademark applications that use that particular epithet. As a result of today’s ruling, the Government will now presumably be compelled to register marks containing that epithet as well rather than treating it as a “scandalous” form of profanity under § 1052(a).⁸⁷

⁸³ *Id.* at 2302 n.* (internal citation omitted). She also notes that “[n]or do we say anything about how to evaluate viewpoint-neutral restrictions on trademark registration—because the “scandalous” bar (whether or not attached to the “immoral” bar) is not one.” *Id.* (internal citation omitted).

⁸⁴ *Id.* at 2311 n.3 (citing *R.A.V. v. City of St. Paul*, 505 U.S. 377 (1992)).

⁸⁵ *Id.* at 2314 n.6 (citing *Brown v. Entm’t Merch. Ass’n*, 564 U.S. 786, 791 (2011)).

⁸⁶ *Id.* (citing *Ward v. Rock Against Racism*, 491 U.S. 781, 791, (1989) (emphasis deleted)).

⁸⁷ *Id.* at 2312 n.5 (citations omitted).

Justice Sotomayor noted that treating regulations on obscene, vulgar, and profane content “as viewpoint discrimination would upend decades of precedent.”⁸⁸

Applying the suggestions for a legislative rewrite that would be consistent with both the majority and partial dissents in *Brunetti*, along with the unanimous Court in *Tam*, the following principles should govern the drafting process. First, the prohibition must be viewpoint neutral. It cannot prohibit terms simply because they offend some groups or express a viewpoint that some find repulsive. Second, the prohibition must focus on the mode of expression, not on the message being conveyed. Third, the mode of expression must fit within constitutionally recognized boundaries in the same or similar contexts. Thus, the trademark should be reasonably considered defamatory, obscene, or indecent in order to be barred from registration.

Defamatory speech is given limited protection, depending on the statement’s target and the level of public concern in its content. The analysis is governed by the *New York Times v. Sullivan*⁸⁹ line of cases, which gives public figures and officials less protection from defamation than private individuals, and which gives more protection to speech concerning public matters than to that of private interest. As previously noted, obscenity can be prohibited completely, so long as it satisfies the *Miller v. California* test.⁹⁰

Important lessons can be drawn from the case of *FCC v. Pacifica Foundation*.⁹¹ In that 1978 decision, the Supreme Court upheld the FCC’s prohibition on the use of indecent material—specifically the “seven dirty words” in that case.⁹² Those words were “shit, piss, fuck, cunt, cocksucker, motherfucker, and tits.”⁹³ Importantly, the Court noted that “[i]n this case it is undisputed that the content of Pacifica’s broadcast was “vulgar,” “offensive,” and “shocking.” Because content of that character is not entitled to absolute constitutional protection

⁸⁸ *Id.* at 2314. She further noted: “It would also risk destabilizing government practice in a number of other contexts. Governments regulate vulgarity and profanity, for example, on city-owned buses and billboards, on registered vessels, and at school events.” *Id.* at 2314 n.7 (citing *Am. Freedom Def. Initiative v. Mass. Bay Transp. Auth.*, 989 F. Supp. 2d 182, 183 (D. Mass. 2013); 46 C.F.R. § 67.117(b)(3) (pertinent Coast Guard regulations); *Bethel School Dist. No. 403 v. Fraser*, 478 U.S. 675, 677–678, 685 (1986)).

⁸⁹ 376 U.S. 254 (1964). For commentary on this line of cases, see, e.g., Harry Kalven Jr., *The New York Times Case: A Note on “the Central Meaning of the First Amendment,”* 1964 SUP. CT. REV. 191 (1964); Rodney Smolla, *Let the Author Beware: The Rejuvenation of the American Law of Libel*, 132 U. PA. L. REV. 1 (1983); 2 FOWLER HARPER ET AL., *THE LAW OF TORTS*, §§ 5.0-.30 (2d ed. 1986). See also Richard A. Epstein, *Was New York Times v. Sullivan Wrong?*, 53 U. CHI. L. REV. 782, 818 (1986).

⁹⁰ See 413 U.S. 15, 24-26 (1973).

⁹¹ 438 U.S. 726 (1978).

⁹² *Id.*

⁹³ Appendix to Opinion of Court at 751, *FCC v. Pacifica Found.*, 438 U.S. 726 (1978).

under all circumstances, we must consider its context in order to determine whether the Commission's action was constitutionally permissible."⁹⁴

Although many have criticized this decision,⁹⁵ it probably expresses the sensibilities of most Americans — that these words should not be part of ordinary conversation directed at broad audiences, particularly when children are likely to be present. As the Court reiterated in *Hustler Magazine, Inc. v. Falwell*,⁹⁶ “speech that is “vulgar,” “offensive,” and “shocking” is ‘not entitled to absolute constitutional protection under all circumstances.’” The *Pacifica* Court defended and justified the rule based on the intrusiveness of the message and the context of the narrow broadcast spectrum at the time.⁹⁷ Since the case was decided, the spectrum scarcity rationale has weakened considerably, but the intrusiveness argument still holds some weight.

Arguably, the same can arguably be said about trademarks. Trademarks are intrusive in both the marketplace and in the media. Trademarks appear prominently on billboards, in storefronts, on webpages, on clothing and accessories, and in all forms of media, including broadcast, cable, streaming, satellite, and internet. If anything, they are more pervasive than entertainment programming that might cross the indecency line.

Moreover, like broadcast spectrum licenses, a trademark registration gives the recipient a variety of governmentally granted benefits not enjoyed by the general public or those who do not hold registered trademarks. The government can thus impose some restrictions on these recipients, so long as it does so on a viewpoint-neutral basis.

Implementing this analysis, a proposed amendment to the Lanham Act might 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 *obscene, vulgar, and profane matter*. . .⁹⁸

⁹⁴ 438 U.S. at 747-48.

⁹⁵ See, e.g., J.M. Balkin, *Media Filters, the V-Chip, and the Foundations of Broadcast Regulation*, 45 DUKE L.J. 1131, 1136 (1996) (criticizing multiple arguments for restricting violent and indecent television broadcasts); Coileen E. O'Connor, *American Horror Story: The FCC's Chilling Indecency Policy*, 33 NOTRE DAME J.L. ETHICS & PUB. POL'Y 531, 545 (2019) (explaining how “there is no longer any justification for imposing elevated speech restrictions on broadcast television.” *Id.*).

⁹⁶ 485 U.S. 46, 56 (1988) (quoting *Pacifica*, 438 U.S. at 747).

⁹⁷ See *Pacifica*, 438 U.S. at 748.

⁹⁸ See 15 U.S.C. § 1052 (2012) (emphasis added to signal proposed amended language by the author).

The contours of this restriction could then be developed by the PTO, which could issue guidance regarding the types of marks whose mode of expression would run afoul of this new statute.⁹⁹

The prohibition on obscene marks could follow the *Miller* test, and the potential prohibition on indecent marks could follow the *Pacifica* analysis. The indecency standard can and does extend beyond the “seven dirty words,” including, for example, indecent imagery. A particular challenge is posed by racially derogatory marks, with the N-word being the most prominent example. As of this writing, nine trademarks have been registered making use of a word substantially similar to it.¹⁰⁰ The holding in *Tam* seems to preclude a prohibition of racial slurs, leaving a possible argument that the N-word is somehow different from other racial slurs. It seems unlikely that a majority of the Court would accept this distinction in light of *Tam*, but the PTO could issue a prohibition on it under the indecency umbrella, which could then be tested in the courts. Crucially, any statutory or PTO-promulgated prohibition should specifically indicate that it is severable from any other prohibition, so that if any one prohibition is struck down, the remaining bars would still be in effect.

In sum, any new prohibition enacted by Congress would need to be focused on the mode of expression, rather than on the message conveyed. A revised Lanham Act provision could focus on obscene, vulgar, and profane words and images. Such a provision, along with implementing guidance from the Patent and Trademark Office, could well be deemed a permissible and content-neutral regulation on which marks gain the benefit of federal trademark registration.

V. CONCLUSION

The Supreme Court’s decisions in *Tam* and *Brunetti* struck down statutory provisions that had limited trademark registrations of offensive content for over seventy years. The *Brunetti* majority, for reasons which were understandable given the history of how the prohibition was interpreted, refused to apply a limiting construction. Nonetheless, the justices’ opinions provide a roadmap for a revised statute that can pass constitutional muster. Thus, Congress could amend the

⁹⁹ A further prohibition on defamatory marks would likely need to hew closely to the categories of protected and unprotected speech found in the defamation case law, as noted previously. See *supra* text accompanying notes 79-81. A full discussion of such a provision is beyond the scope of this article.

¹⁰⁰ These marks are: REAL MAN—REAL NIGGA GOOD WOMAN—BAD BITCH, Registration No. 88,419,152; WHITE NIGGA, No. 88,156,862; REAL NIGGAS, Registration No. 88,540,893; NIGGA, Registration No. 87,507,483, 87,496,454, 87,507,414, 87,499,736; ROTTONS- RICH OFF THOUGHTS THAT OTHER NIGGAS SAID, Registration No. 87,483,653; MUDD NIGGA\$, Registration No. 87,862,949.

Lanham Act to include a narrowly tailored prohibition on marks employing a mode of expression that can be lawfully barred under the First Amendment. The statute could preclude the registration of obscene, vulgar, and profane marks. Further, the provision could authorize the Patent and Trademark Office to prescribe regulations to implement this ban in a manner that would constitute a reasonable, viewpoint-neutral restriction on speech in the context of a governmentally issued registration scheme.