WHAT THE F? - SCOTUS RULES THAT DIRTY WORDS CAN BE REGISTERED AS TRADEMARKS UNDER THE FIRST AMENDMENT

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In June 2019, the United States Supreme Court ruled that a provision of the U.S. Trademark (Lanham) Act that bars the registration of "immoral or scandalous" trademarks violates the First Amendment of the Constitution because it discriminates on the basis of viewpoint and disfavors certain ideas. *Iancu v. Brunetti*. 588 U S. ___ (2019).

The ruling followed by two years a decision by the Supreme Court that found unconstitutional a similar provision of the Trademark Act prohibiting the registration of trademarks that disparage persons, institutions, beliefs, or national symbols. *Matal v. Tam*, 582 U.S. ___, 137 S.Ct. 1744 (2017)(the *Slants* case).

Erik Brunetti, an artist and entrepreneur who founded a clothing line that uses the trademark FUCT, applied to register his trademark with the U.S. Patent and Trademark Office (PTO). According to Brunetti, the trademark (which functions as the clothing's brand name) is pronounced as four letters, one after the other: F-U-C-T.

However, Justice Kagan, in her opinion for the Court, noted that some people might read the term differently and, if so, they would hardly be alone. In fact, as was stated in oral argument before the Court, the brand name might be regarded as "the equivalent of the past participle form of a well-known word of profanity". That common perception is what caused problems for Brunetti when he tried to register his trademark with the U.S. Patent and Trademark Office (PTO).

Although registration of a trademark is not required in order to use it and have enforceable rights against infringers, registration with the PTO provides a number of valuable rights. Registration constitutes "prima facie evidence" of the mark's validity, constructive notice of the registrant's claim of ownership, and the ability to make it "incontestable" after five years of registration. A trademark must be used in commerce, and not so resemble another's person's mark as to create a likelihood of confusion. A trademark cannot be merely descriptive, and until the Supreme Court invalidated the criteria, a

trademark could not be registered if it disparaged a person, living or dead, or is "immoral or scandalous." 15 U.S.C. §1052.

So when Brunetti attempted to register his brand name, the PTO rejected it as scandalous or immoral. In determining whether a mark belongs in that category, the PTO asks 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."

The trademark examining attorney found the mark totally vulgar and, on appeal, the Trademark Trial and Appeal Board found it "highly offensive" and "vulgar," with "decidedly negative sexual connotations. The Board also reviewed Brunetti's website and products and said that they showed "extreme nihilism" and "anti-social" behavior, indicating that the mark communicated "misogyny, depravity, and violence," and was extremely offensive whether considered in that context or just as a sexual term.

After the Court of Appeals for the Federal Circuit ruled the scandalous or immoral clause unconstitutional under the First Amendment, the Supreme Court affirmed. In the *Slants* case, which involved an Asian-American band attempting to register its name even though it is a derogatory term for persons of Asian descent, the Court had ruled that the Trademark Act's disparagement bar was unconstitutional because it was "viewpoint-based." It is a core tenet of free speech law that the government may not discriminate against speech based on the ideas or opinions it conveys.

Justice Kagan noted that using its criteria of offensiveness, the PTO refused over the years to register trademarks communicating "immoral" or "scandalous" views about such issues as drug use, religion, and terrorism, while approving marks expressing more accepted views on those topics. For example, the PTO rejected marks conveying approval of drug use such as MARIJUANA COLA and KO KANE for beverages, but registered marks with sayings such as D.A.R.E. TO RESIST DRUGS AND VIOLENCE and SAY NO TO DRUGS — REALITY IS THE BEST TRIP IN LIFE.

The PTO also refused registration for BONG HITS 4 JESUS and trademarks associating religious terms with products (AGNUS

DEI for safes and MADONNA for wine) because they could be offensive to Christians, but approved PRAISE THE LORD for a game and JESUS DIED FOR YOU on clothing. The PTO also rejected marks indicating support for al-Qaeda (BABY AL QAEDA and AL-QAEDA on t-shirts) as shocking to one's sense of decency, yet registered a mark with the words WAR ON TERROR MEMORIAL.

Justice Kagan noted that the rejected marks express opinions that are offensive to many Americans, but that a law disfavoring "ideas that offend" discriminates on the basis of viewpoint and cannot stand. Moreover, the statute as written is not limited to lewd, sexually explicit, or profane marks but is broad enough to cover the entire universe of material that some might find immoral, scandalous, disreputable or offensive. "There are a great many immoral and scandalous ideas in the world (even more than there are swear words), and the Lanham Act covers them all. It therefore violates the First Amendment."

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