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The U.S. Supreme Court Swears the Lanham Act Violates the First Amendment. Again.

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On June 24, 2019, the U.S. Supreme Court held that Section 2(a) of the Lanham Act, prohibiting registration of a trademark that "[c]onsists of or comprises immoral or scandalous matter" violates the First Amendment. *Iancu v. Brunetti*, No. 18-302, 588 U.S. ___ (2019). This decision is consistent with the Court's 2017 decision in *Matal v. Tam*, 137 S. Ct. 1744, 582 U.S. ___ (2017), that the prohibition on registration of "disparaging" marks violates the First Amendment.

A bit of background is in order. Prior to the *Tam* case, Section 2(a), as codified in 1905 and re-enacted in the Lanham Act of 1946, prohibited registration of any mark that "[c]onsists 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." It is important to keep in mind that Section 2(a) was first enacted in 1905 (almost 115 years ago) and re-enacted in 1946 (more than 70 years ago). What was deemed "immoral or scandalous" in the early 1900s during the Victorian and Edwardian eras was probably not so immoral or scandalous in the aftermath of World War I and the 1920s, and even less likely to be immoral or scandalous in 1946. And what was "immoral or scandalous" in 1946 probably wouldn't raise an eyebrow today.

Brunetti filed an application in the U.S. Patent and Trademark Office (USPTO) to register the mark FUCT for clothing. Notwithstanding his explanation that the mark was actually pronounced "F-U-C-T," the trademark examiner refused registration on the grounds that the mark was "immoral or scandalous" under Section 2(a) of the Lanham Act. Brunetti appealed to the Trademark Trial and Appeal Board, which upheld the examiner's refusal.

Brunetti then appealed to the Federal Circuit Court of Appeals, which *reversed* the TTAB on the grounds that, to the extent Section 2(a) of the Lanham Act prohibited registration of "immoral or

scandalous" matter, it violated the First Amendment and was therefore unconstitutional.

The Supreme Court granted certiorari on petition from the director of the USPTO. The Court[1] first discussed its earlier decision in *Tam*. There, the USPTO had refused to register the mark SLANTS for a music group made up of Asian-Americans on the grounds that it violated that portion of Section 2(a) prohibiting registration of any mark that "disparages any persons, living or dead." The Court determined first that, if a bar to registration is "viewpoint-based," then it is unconstitutional and, second, that the disparagement bar was, in fact, viewpoint-based.

Turning to the case at hand, the Court, reviewing marks that did and did not make the "immoral or scandalous" cut, stated that the statute favors marks that comport with morally decent standards and disfavors those that don't. By giving the USPTO the subjective ability to determine whether a mark is or is not likely to offend, and only register the former but not the latter, the statute is allowing the government to provide statutory benefits and protection only to some private speech, but deny it to others, solely on the basis of subjective viewpoint.

Accordingly, the Court affirmed the decision of the Federal Circuit and held that the portion of Section 2(a) prohibiting registration of "immoral or scandalous" marks is violative of the First Amendment and therefore illegal as unconstitutional.

But wait, there's more to Section 2(a). That section also prevents registration of marks that "falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, **or bring them into contempt or disrepute.**" Could there be another "viewpoint" bias and First Amendment violation case on the horizon?

[1] Justice Kagan delivered the opinion for the 6-3 majority, joined by Justices Thomas, Ginsburg, Alito, Gorsuch, and Kavanaugh. Justice Alito also concurring; Chief Justice Roberts and Justice Breyer each concurring in part and dissenting in part; Justice Sotomayor concurring in part and dissenting in part, joined by Justice Breyer.

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