What the %@#&? Supreme Court Strikes Down Ban on Immoral or Scandalous Trademarks

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The Supreme Court struck down the Lanham Act's prohibition on registering "immoral or scandalous" trademarks in its recent decision in *Iancu v. Brunetti*. Erik Brunetti is an artist who created a clothing line that uses the trademark FUCT. When he sought to register the mark, the U.S. Patent and Trademark Office ("USPTO") denied his application, citing the Lanham Act's prohibition on registering trademarks that contain immoral or scandalous matter. It is not hard to imagine that the mark would bring to mind perhaps the most famous four-letter curse word in American culture. Brunetti appealed and argued that the prohibition violates the First Amendment.

The Supreme Court agreed with Brunetti and held that the Lanham Act's prohibition on registering immoral or scandalous trademarks is unconstitutional because it discriminates on the basis of viewpoint. By way of example, the Court pointed out how the USPTO registered the mark "D.A.R.E. TO RESIST DRUGS AND VIOLENCE" but refused to register "BONG HITS 4 JESUS" because it "suggests that people should engage in an illegal activity [in connection with worship]" and since "Christians would be morally outraged by a statement that connects Jesus Christ with illegal drug use."

The Supreme Court's rationale follows the same line of thinking from its decision in *Matal v. Tam*, two years ago, when the Court held that the ban on registering marks that "disparage" any person living or dead was unconstitutional. In that case, the Court also held that if a trademark registration bar is viewpoint-based, then it is unconstitutional under the First Amendment.

Does this mean that American consumers are likely to see an influx of brand names containing lewd, sexually explicit, and profane slogans? Not necessarily. While the Lanham Act's prohibition had prevented the ***registration*** of immoral or scandalous marks, there is nothing that previously prevented individuals or businesses from ***using*** immoral or scandalous marks in commerce and enforcing the mark against potential infringers. Registration simply provides trademark owners with additional, valuable benefits such as the legal presumption of national ownership of a trademark. In other words, the landscape for offensive marks being used in the marketplace is unlikely to change too much, but owners will have an easier time protecting and enforcing these types of marks.

Questions? Let Eric know.

Eric Clendening is a member of Flaster Greenberg's Intellectual Property and Litigation Departments. He focuses his practice on intellectual property litigation and commercial litigation, including contract disputes, employment litigation, and other commercial disputes. He also advises clients on protecting and enforcing intellectual property rights online, including the resolution of domain name disputes and matters concerning e-commerce, online speech and conduct, and related intellectual property issues involving trademarks and copyrights.

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