

The Trademarks THE SLANTS, REDSKINS and Now FUCTION Are Registerable Trademarks Following the Supreme Court's *lanco v. Brunetti* Ruling

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In permitting the registration of the “vulgar” term FUCTION, the Supreme Court recently extended its 2016 ruling from *Matal v. Tam*, which allowed the registration of the trademark THE SLANTS for an Asian-American rock band despite objections that the term is disparaging, ruling that prohibitions of speech must be viewpoint-neutral, and not viewpoint-based.

In *Matal v. Tam*, the Supreme Court found the ban of registration of disparaging trademarks under 15 U.S.C. § 1052(a) unconstitutional because the prohibition was content-based (i.e. required a judgment about the content or meaning of a particular trademark) and resulted in a viewpoint-based restraint of free speech. Following the ruling, registration for the mark REDSKINS, previously found to be an unregistrable, disparaging term, was reinstated. Similar challenges to other disparaging mark were withdrawn.

In *lanco v. Brunetti*, the Supreme Court extended that ruling, further narrowing the scope of 15 U.S.C. § 1052(a), holding that the Lanham Act's ban on the registration of “immoral or scandalous” trademarks is also a viewpoint-based restriction of free speech, and thus it too is unconstitutional. Although these decisions will change the landscape of what types of marks are capable of being registered with the Trademark Office, their actual impact may be muted by the realities of how trademark rights vest and the enforcement mechanisms currently available for unregistered (i.e. common law) trademarks. Regardless, the *Brunetti* decision underscores the importance of properly using marks in a source identifying manner—and seeking registration where permitted—to ensure the full protections afforded under trademark law.

Before reaching the ultimate decision in the case, the court took time to note that registration is not required to establish rights in a trademark; rather, common law trademark rights vest upon use of the mark in commerce in a source-identifying manner, so the owner of an unregistered mark may still use it in commerce and enforce it against infringers. However, federal trademark registration provides many valuable benefits, including, but not limited to, a legal presumption of validity and exclusive ownership of the mark for the registered goods and services, the right to sue in federal court and in certain cases, obtain treble damages and attorney fees, and an entitlement of statutory damages in the case of counterfeiting. In addition, trademark registration protects against registration of confusingly similar marks. Not all marks, however, are capable of being registered. Section 2 of the Lanham Act expressly prohibits certain types of trademarks from being registered. For instance, the Trademark Office cannot register a mark that “so resembles” another mark as to create a likelihood of confusion. §1052(d). It cannot register a mark that is “merely descriptive” of the goods on which it is used. §1052(e). It cannot register a mark containing the flag or insignia of any nation or State. At issue in *lanco v. Brunetti* is the prohibition against registration of marks that consist of or comprise “immoral or scandalous matter.” 15 U.S.C. § 1052(a).

When Erik Brunetti sought the protections of federal registration for the trademark FUCTION as the name of his clothing line, both the Trademark Office examining attorney and the Trademark Trial and Appeal Board denied his application under Section 2(a) of the Lanham Act, arguing that the mark FUCTION is the “equivalent



of [the] past participle form of a well-known word of profanity," is "totally vulgar," "highly offensive," and has "decidedly negative sexual connotations," particularly in the manner and context in which Brunetti was using the mark. After the Federal Circuit Court of Appeals affirmed, Brunetti appealed to the Supreme Court, less than two years after the Supreme Court struck as unconstitutional the language in the Lanham Act that prohibited the registration of disparaging trademarks in *Matal v. Tam*.

Similar to *Matal v. Tam*, the Supreme Court in *Iancu v. Brunetti* was tasked with determining whether the Lanham Act's ban on registering trademarks considered "immoral or scandalous" discriminates on the basis of viewpoint and is thus unconstitutional. In *Matal v. Tam*, Justice Kennedy explained that the disparagement bar allowed a trademark owner to register a mark if it was "positive" about a person, but not if it was "derogatory." Justice Kennedy explained that this is the "essence of viewpoint discrimination...because"[t] he law thus reflects the Government's disapproval of a subset of messages it finds offensive." Extending that same rationale, in *Iancu v. Brunetti*, Justice Kagan explained that "[i]f the "immoral or scandalous" bar similarly discriminates on the basis of viewpoint, it must also collide with our First Amendment doctrine." In coming to this conclusion, the Supreme Court considered the meanings and definitions of "immoral" and "scandalous" and found that taken together, this registration bar "distinguishes between two opposed sets of ideas: those aligned with conventional moral standards and those hostile to them; those inducing societal nods of approval and those provoking offense and condemnation." On this basis, the Supreme Court found that the "immoral or scandalous" bar to registration is viewpoint-based, because it disfavors certain ideas, and is therefore unconstitutional. The Supreme Court acknowledged that prohibitions on the registration of "lewd, sexually explicit, or profane marks" for example, may be viewpoint-neutral and thus avoid colliding with the First Amendment. But, as currently written, the Lanham Act does not draw the line there, nor does it differentiate between a mode of expression, independent of viewpoint. Thus, the Supreme Court was constrained to strike down the entire "immoral or scandalous" bar to registration. It is possible that Congress may seek to amend Section 2(a) to re-write a viewpoint-neutral ban on registration of lewd, sexually explicit, or profane marks. While nothing has been proposed to date, several Justices seemed to be encouraging Congress to do so, given the potential discomfort with this decision that now allows profanity to be registered.

Following this decision, it is possible that the Trademark Office may see a short-term spike in applications for edgier marks containing terms some may consider offensive or even vulgar. However, applicant will still have to show use of the mark in a source identifying manner, and the marks will still require public acceptance and marketability for the brand to be successful.

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