

# Supreme Court: *Iancu v. Brunetti*

By [Richard Z. Lehv](#)

## Prohibition of “Immoral or Scandalous” Marks Struck Down

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The United States Supreme Court struck down as unconstitutional the provision of Section 2(a) of the U.S. Trademark Act that prohibits the registration of any mark that “consists of or comprises immoral . . . or scandalous matter.” The decision comes two years after the Court, in *Matal v. Tam*, 582 U. S. \_\_\_\_ (2017), struck down the prohibition in Section 2(a) against registration of a mark that “may disparage” persons or groups of persons.

In *Iancu v. Brunetti*, Mr. Brunetti applied to register FUCT as a trademark for a clothing line. The USPTO Examiner refused registration on the ground that the proposed mark was “immoral or scandalous.” He appealed to the Trademark Trial and Appeal Board, which agreed with the Examiner. He then appealed to the U.S. Court of Appeals for the Federal Circuit, which held that the prohibition against “immoral or scandalous” marks was a violation of the right of free speech, guaranteed under the First Amendment to the U.S. Constitution. The USPTO then asked the Supreme Court to review that decision. Oral argument was held in April.

Six justices of the Court, in an opinion written by Justice Kagan, agreed that the prohibition on “immoral or scandalous” marks is unconstitutional. The Court found that the USPTO does not define “immoral” and “scandalous” separately, but treats them as a “unitary provision.” The Court pointed out that the USPTO’s definitions of this unitary provision are extremely broad. “To determine whether a mark fits in the category,” the Court said, “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.’” Given the vagueness of these terms, PTO decisions have been highly inconsistent. The Court gave examples of marks that the PTO has refused under this provision of Section 2(a), while allowing highly similar marks.

In addition to leading to inconsistent results, the Court held, the prohibition on “immoral or scandalous” marks was not viewpoint neutral. The Court re-affirmed its holding in *Tam* that “[t]he government may not discriminate against speech based on the ideas or opinions it conveys.” It concluded:

So the Lanham Act allows registration of marks when their messages accord with, but not when their messages defy, society’s sense of decency or propriety. . . . [T]he statute, on its face, 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.

Finally, Court said the “immoral or scandalous” prohibition was “substantially overbroad.” As Justice Kagan explained in concluding her decision, “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.”

All nine Justices appear to agree that the prohibition against “immoral” marks was unconstitutional, but three Justices dissented on the ground that the prohibition of “scandalous” marks could be saved if interpreted to mean “obscene, profane, or vulgar.” The six-Justice majority seemed to suggest that such a statutory clause could survive a constitutional challenge, but that it would not be appropriate for the Court to rewrite the statute in this manner, and any such proposed change would have to come from Congress.

The *Brunetti* decision means that the PTO can no longer reject marks on the ground that they are “immoral or scandalous.” However, the PTO can still reject obscene or vulgar marks on other grounds,

including that the proposed mark fails to function as a trademark, that it is merely a commonplace phrase printed on a t-shirt, or that it is laudatory, or merely descriptive, or deceptively misdescriptive. In addition, the PTO has been looking closely at specimens of use, and can reject an application if the specimen seems not to be genuine, but prepared merely to support the filing of an application.

—RZL

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