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Linguistic regulation doesn't include an expectation of complete freedom

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On June 24, 2019, the United States Supreme Court decided *Iancu v. Brunetti*, No. 588 U.S. __ (2019), holding that the Lanham Act's prohibition on registering federal trademarks that are "immoral" or "scandalous" violates the First Amendment.

Justice Kagan wrote the six-person majority opinion that was joined by Justices Thomas, Ginsburg, Alito, Gorsuch and Kavanaugh. The remaining justices agreed that the First Amendment requires the government to register *immoral* marks, but argued that at least some scandalous marks can be properly prohibited. In the minority viewpoint, the court should have narrowly construed that aspect of the statute to a Constitutional scope while retaining some of its effectiveness.

The majority rejects the government's proposal to limit application of this provision to "vulgar" marks, i.e. those that are "lewd," "sexually explicit or profane." Although such a construction would avoid any viewpoint discrimination, the majority holds that the "immoral or scandalous" bar "stretches far beyond the [g]overnment's proposed construction." The majority concludes that such a construction would amount to the court rewriting the statute because the plain meaning of the statutory language is broader and ensnares marks that offend because of the ideas they express, not just by their mode of expressing ideas.

This case involves the mark "FUCT" that Brunetti has been using for many years in association with his high-end skater product line. The PTO rejected his application as directed toward immoral or scandalous matter as required by the Lanham Act. Brunetti appealed.

The big question in the case was whether the court would see these restrictions as viewpoint-based —it did. The Court explains:

"So the key question becomes: Is the "immoral or scandalous" criterion in the Lanham Act viewpoint-neutral or viewpoint-based?

It is viewpoint-based. . . . [T]he Lanham Act permits registration of marks that champion society's sense of rectitude and morality, but not marks that denigrate those concepts. . . . [T]he Lanham Act allows registration of marks when their messages accord with, but not when their messages defy,

society's sense of decency or propriety. Put the pair of overlapping terms together and the 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." 588 U.S. __ (2019) at page 6.

Once the limitation is defined as *viewpoint based*, the result was easy for the Court—invalid as unconstitutional.

In *Brunetti*, four Justices expressed a view that scandalous modes of expression should be barred trademark registration. In addition to the three dissenters, Justice Alito stated in his concurring opinion that the court's opinion would not "prevent Congress from adopting a [] statute that precludes the registration of marks containing vulgar terms that play no real part in the expression of ideas." He went on to note that the mark in question in this case—FUCT—"is not needed to express any idea and, in fact, as commonly used today, generally signifies nothing except emotion and a severely limited vocabulary." Chief Justice Roberts flatly states that "refusing registration to obscene, vulgar[] or profane marks does not offend the First Amendment." Justice Breyer goes so far as to suggest that "an applicant who seeks to register a mark should not expect complete freedom to say what she wishes, but should instead expect linguistic regulation."

Perhaps the most striking rebuttal of registration as speech comes in this passage in Chief Justice Roberts' dissent:

"Whether such marks can be registered does not affect the extent to which their owners may use them in commerce to identify goods. No speech is being restricted; no one is being punished. The owners of such marks are merely denied certain additional benefits associated with federal trademark registration. The [g]overnment, meanwhile, has an interest in not associating itself with trademarks whose content is obscene, vulgar[] or profane. The First Amendment protects the freedom of speech; it does not require the [g[overnment to give aid and comfort to those using obscene, vulgar[] and profane modes of expression."

For the foreseeable future, applicants aren't faced with the Lanham Act's prohibition on registering federal trademarks that are "immoral" or "scandalous." Applicants should be cautious of upending legislation that will attempt to instill a constitutional form of linguistic regulation.

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