

Federal Circuit Holds Lanham Act Prohibition Against Registration of Scandalous and Immoral Marks Is FUCT

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On December 15, 2017, a Federal Circuit panel held the Lanham Act prohibition against registration of “immoral” or “scandalous” marks (interpreted to include vulgar terms) unconstitutionally restricts free speech, and therefore the Patent and Trademark Office’s refusal to register the mark FUCT for clothing was improper. In re Brunetti, 2017

U.S. App. LEXIS 25336. The case can be seen as an obvious extension of the Supreme Court’s recent and unanimous holding that the Lanham Act’s prohibition against the registration of disparaging marks is likewise unconstitutional. See Matal v. Tam, 582 U.S. ____ (2017).

Perhaps because the various opinions in *Matal v. Tam* cautioned that it shouldn’t be read to necessarily strike down aspects of the Lanham Act other than the disparagement prohibition, the Federal Circuit again waded deep into the thickets of First Amendment jurisprudence. The government attempted to distinguish immoral and scandalous marks from disparaging marks on the basis that prohibiting disparaging marks constitutes viewpoint discrimination and was therefore subject to strict scrutiny, whereas prohibiting immoral and scandalous marks is a viewpoint neutral restriction of commercial speech and therefore subject to intermediate scrutiny. In this author’s view, the Federal Circuit could have held that the immoral and scandalous prohibition also constitutes viewpoint discrimination when, for example, the immoral and scandalous prohibition have been used to reject marks seen as blasphemous. But the panel went on to hold that the prohibition of scandalous and immoral marks is unconstitutional even under intermediate scrutiny.

One judge on the panel would have upheld the scandalous and immoral prohibition for

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marks that are obscene and therefore not protected by the First Amendment, but the other judges declined to make any such carve out; time will tell if this judge's view or anything else will embolden the government to seek an *en banc* rehearing or otherwise seek to undo the panel decision in whole or in part.

Assuming the panel decision stands, one may wonder if other Lanham Act prohibitions of the registration of certain marks based on their content are subject to a similar First Amendment challenge.

None of the opinions cast doubt on by far the most common bases of rejection—that marks are confusingly similar to other marks or are merely descriptive. But a number of miscellaneous prohibitions against the registration of marks based on content, for example, the prohibition against the registration of marks comprising governmental flags, may now be questioned. While the seemingly important issue of whether these prohibitions should be evaluated under strict or intermediate scrutiny remains undetermined, so far the courts have found the restrictions to be unconstitutional regardless.