

SCOTUS Paves the Way for FUCT Trademark, Causing a Bit of an Application Sh**storm at the USPTO

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by Case Collard



“FUCT.” You can pronounce it as four letters, one after the other. Or you can pronounce it like Justice Kagan as the “past participle form of a well-known word of profanity.” Either way, the word can be registered as a trademark under yet another civil rights victory at the Supreme Court: *Iancu v. Brunetti*.

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Erik Brunetti, an artist and entrepreneur, owns the clothing brand “FUCT.” FUCT is an acronym for Friends U Can’t Trust. In 2011, the PTO denied the mark’s registration, relying on Section 2(a) of the Lanham Act and found the mark to be “an extremely offensive and vulgar word that means completely broken or destroyed.” Section 2(a) states that a trademark for goods that may be distinguished from the goods of others shall not be refused unless it “consists of or comprises immoral, deceptive, or scandalous matter.”

The Trademark Trial and Appeal Board affirmed the denial. It also found the mark to be “highly offensive,” “vulgar,” and has “negative sexual connotations.” The Court of Appeals for the Federal Circuit reversed the Board’s judgment. The court found that the prohibition of immoral or scandalous marks is an unconstitutional restriction of free speech and violates the First Amendment. On June 24, 2019, the United States Supreme Court affirmed the judgment in a 6-3 decision.

Justice Kagan delivered the opinion of the Court; she was joined by Justices Thomas, Ginsburg, Alito, Gorsuch, and Kavanaugh. Following the same line of reasoning the Court took in *Matal v. Tam* (in which the Court affirmed the registrability of the mark “The Slants”), it held that Section 2(a) of the Lanham Act violated the First Amendment because it discriminated on the basis of viewpoint. Viewpoint discrimination occurs when

the government denies access to a speaker solely to suppress a viewpoint of an otherwise includable subject. In *Tam*, the Court declared unconstitutional the Lanham Act's ban on registering marks that disparage any person, living or dead. The Court reasoned that the disparagement bar allowed mark registrations that are positive, but not derogatory. Therefore, the ban constitutes viewpoint discrimination because the statute reflects the Government's disapproval of a subset of messages that it finds offensive.

Similarly, in *Brunetti*, Section 2(a) distinguishes between two opposing sets of ideas – ideas that are aligned with conventional moral standards and induce societal approval against those that are hostile to conventional moral standards and provoke offense and condemnation. And by favoring the former but not the latter, the statute again commits viewpoint discrimination. The Court dismissed the Government's argument that this ruling would restrict the PTO's ability to refuse marks that are "vulgar" (lewd, sexually explicit, or profane). The Court reasoned that the statute, as written, is not narrowly tailored to "vulgar" marks, and the "immoral or scandalous" bar sweeps too broadly. Moreover, the judicial branch is not in the business of "fashioning" new statutes.

The ACLU commented: "[t]his ruling is a victory for the First Amendment Government bureaucrats should not be deciding what speech is or is not deserving of trademark protection." In his concurring opinion, Justice Alito noted that Congress has the power to adopt a more narrowly tailored statute that bans vulgar trademarks. Until then, the race to first register profanity and equivalents is on. The PTO should brace for potentially uncomfortable incoming trademark applications.

In fact, in just the last couple of weeks since the Court's decision, there have been a number of USPTO trademark applications submitted such as "Shitbox Nation," "Champ Shit Only," and "Florida as Fuck," and many others. It remains to be seen if these applications mature into registrations. With Section 2(a) out of the picture, though, we may witness an onslaught of applications and registrations with colorful language and imagery. We will keep you apprised of any significant developments here at TheTMCA.com.