

The “F Word” Taking Center Stage at the U.S. Supreme Court

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by J. Michael Keyes



On Friday, while some of us may have been muttering a few bad words as we slogged through our post-holiday inboxes, the Supreme Court was toying with a naughty word of its own: FUCT. That's right. Late last week the Court agreed to hear a case involving a rejected trademark application for the word “FUCT” for use on

clothing. It's an interesting case and one that we will be keeping a close eye on in 2019.

Here's the basic gist of the dispute: Erik Brunetti is an L.A. based artist and clothing designer who launched a streetwear apparel brand under the rather colorful name “FUCT.” He attempted to register the trademark with the USPTO. The examiner rejected the application and cited the Lanham Act prohibition regarding registration of “scandalous” trademarks under Section 2(a). The applicant appealed to the U.S. Court of Appeals for the Federal Circuit. To virtually no one's surprise, the Federal Circuit held the “scandalous” prohibition violated the First Amendment under Federal Circuit and Supreme Court precedent, including the unanimous 2017 Supreme Court decision Matal v. Tam that struck down the “disparagement” prohibition also contained in Section 2(a). The USPTO petitioned for the U.S. Supreme Court to review the decision, and the Court obliged. WTF? We will soon find out why the Court is jumping back into the fray of Section 2(a), but we offer a few musings for your consideration:

1. This could signal that the Court wants to clarify or modify the constitutional analysis it previously set forth in *Matal v. Tam*. Or, it could be that the Supreme Court sees a principled difference between the “disparaging” and “scandalous” provisions within the same statutory section. Neither possibility seems likely, though. *Matal v. Tam* was a unanimous decision from 2017, so it wouldn't seem as though the Court would be all that interested in examining its decision anew given that the ink is barely dry on

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it. Further, many scholars and Lanham Act pundits see no meaningful difference between the two provisions of the Lanham Act. If one falls, they both fall.

2. If the Court upholds the Federal Circuit decision, we may see a glut of profane and sexually explicit trademark applications filed at the USPTO, which is what the government appears to be concerned about and why it wants the Federal Circuit's decision reversed. The government's position seems to be a bit like a solution in search of a problem. Yes, there may be some that will file vulgar trademark applications. But trademarks are registerable only if they are used to sell goods or services in commerce. While vulgar and/or sexually explicit trademarks may appeal to a slice of the overall consuming population, it seems unlikely that such trademarks are going to catch fire and live in mainstream commerce.
3. The government further argues that "international bodies" (such as foreign countries) will look askance at the U.S. for it allowing "scandalous images and terms" being registered as trademarks. Given the current state of play of our geopolitics, offending foreign countries about what's happening at our U.S. Trademark Office should probably rank pretty far down on the government's priority list.

We will be keeping our eyes (and especially our ears) open.