

WTF? USPTO to Continue Refusing Scandalous and Immoral Marks...For Now

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In light of ongoing litigation over an applicant's effort to register the mark FUCT for wearing apparel, the USPTO recently issued an Examination Guide concerning the review of trademark applications under Section 2(a) of the Lanham Act, which bars registration of marks that consist of or comprise immoral or scandalous matter. The constitutionality of this "scandalousness" provision was put into play after the United States Supreme Court ruled in June 2017 in *Matal v. Tam* that the statutory bar on registering "disparaging" marks constituted an improper

discriminatory "viewpoint" restriction under the First Amendment. *Tam* established the right of a rock band with Asian-American members to obtain a federal trademark registration for the name The Slants, which the band contended should be viewed not as a derogatory name for Asian-Americans, but rather as a term "reclaimed" by them to "drain its denigrating force."

When *Tam* was decided, many trademark experts predicted that the scandalousness prohibition in Section 2(a) would likely suffer the same fate as the disparagement provision. That indeed occurred on the circuit court level in December 2017, when the Court of Appeals for the Federal Circuit held in *In re Brunetti* that the scandalousness provision, relied on by the USPTO to refuse registration of the FUCT mark, violates the First Amendment. We [blogged](#) about the *Brunetti* decision late last year, in which the court analyzed whether immoral and scandalous marks are different from disparaging marks because the concept of disparagement necessarily involves a viewpoint analysis, whereas the prohibition on immoral and scandalous marks could be viewed as a viewpoint neutral restriction on commercial speech. The majority opinion in *Brunetti* held

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that the scandalousness provision (interpreted to include vulgar terms) “impermissibly discriminates” based on content in violation of the First Amendment. One judge on the appellate panel issued a concurring opinion that would have upheld the scandalousness provision of Section 2(a) for marks that are obscene and therefore not protected under the First Amendment. Rehearing was denied in *Brunetti* on April 12, 2018, and the period in which to petition for a writ of certiorari expires on July 11, 2018.

In this procedural context, the USPTO Examination Guide advises that in accordance with its “broad discretion to manage its own docket,” the USPTO will continue to examine applications for compliance with the scandalousness provision while the constitutionality of the provision remains subject to potential U.S. Supreme Court review. If an examining attorney believes that a mark will violate the scandalousness provision, an advisory refusal will be issued, in addition to any other issues that may be raised by the application. If the asserted scandalousness is the only issue barring registration, the examining attorney will suspend action on the application.

The suspension of the application will remain in place “until either: (a) the time for filing a petition for certiorari in *Brunetti* (including any extensions granted) expires, with no petition being filed; or (b) if a petition for certiorari is filed, the later of (1) denial of certiorari or (2) termination of U.S. Supreme Court proceedings in the case.”

So stay tuned for developments after July 11, 2018!