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## SCOTUS's Second Take on Trademark Registration as Speech

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# Guest Post by Prof. Farley: SCOTUS's Second Take on Trademark Registration as Speech

[patentlyo.com/patent/2019/06/scotuss-trademark-registration.html](https://patentlyo.com/patent/2019/06/scotuss-trademark-registration.html)

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By Professor Christine Haight Farley, American University Washington College of Law. Here, Professor Farley offers her take on *Iancu v. Brunetti*. You can read Dennis's write-up [here](#).

The Supreme Court has now struck down as unconstitutional a second trademark registration bar. The court ruled yesterday in *Iancu v. Brunetti* that the government may no longer deny trademark registration to marks that are “scandalous” or “immoral.” In 2017, the court struck down a provision that denied trademark registration to marks that are “disparaging” in *Matal v. Tam*. Both registration bars appear in Section 2(a) of the Lanham Act.

Many commentators had seen the cases as so similar that they wondered why the court had even granted certiorari. Perhaps as a result, the case provoked less interest from amicus brief authors. The conventional wisdom was that the court’s opinion in *Tam* left no room to uphold this provision.

In *Tam*, the court ruled that denying trademark registration to marks that disparage constitutes viewpoint discrimination because the government was sorting out “ideas that offend.” The court reconfirmed that viewpoint discrimination is presumptively unconstitutional. In his concurrence, Justice Kennedy described viewpoint discrimination as “a form of speech suppression so potent that it must be subject to rigorous constitutional scrutiny.”

For the *Brunetti* majority, this was a simple case. Indeed, Justice Kagan, who wrote the majority opinion joined by Thomas, Ginsburg, Alito, Gorsuch, and Kavanaugh, dispensed with the case in ten and a half tight pages even as she devoted a full page to examples of marks that were refused registration (comparing them to similar marks that were approved for registration). The opinion is short and sweet: this is the same case as *Tam*.

According to the majority, the provision at issue “disfavors ideas” and as such is substantively indistinguishable from the provision in *Tam*. Here, “the Lanham Act allows registration of marks when their messages accord with, but not when their messages defy, society’s sense of decency or propriety.”

The final page or so of the majority opinion is devoted to explaining why the statute cannot be saved by the “limiting principle” offered by the government. This is the part of the opinion about which there is dissent.

The majority rejects the government’s proposal to limit application of this provision to “vulgar” marks—“lewd,” “sexually explicit or profane” marks. Although such a construction would avoid any viewpoint discrimination, the majority holds that the “immoral or scandalous” bar “stretches far beyond the Government’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.

Here, in the majority opinion’s only footnote, the majority rebuffs the dissenters characterizing their approach as “statutory surgery.” The majority disagrees that the statute is in any way ambiguous and therefore subject to reinterpretation.

Chief Justice Roberts, Justice Breyer, and Justice Sotomayor each filed separate opinions. Although each concurred that the registration bar on mark that are “immoral” amounts to unconstitutional viewpoint discrimination, each would have limited the court’s constitutional sword to strike down only this provision. Each accepted the government’s limiting principle as an appropriate means to avoid a finding that an act of Congress is unconstitutional.

Justice Breyer began his opinion by citing the court’s precedent that, where fairly possible, the court should endeavor to find a statute constitutional. Interestingly, in *Tam* the court did not, as the majority put it, “pause to consider whether the disparagement clause might admit some permissible applications (say, to certain libelous speech) before striking it down.”

It is in this space, that I believe the *Brunetti* decision offers a new and interesting perspective on the court’s approach to the First Amendment. 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, the author of the majority opinion in *Tam*, 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.”

Justice Alito’s lack of solicitude toward a portion of the marks targeted by the scandalous provision was echoed by Justices Roberts, Breyer, and Sotomayor. 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.”

These sympathetic sentiments toward the government’s interest in regulating vulgarity is in sharp contrast to *Tam*, in which no Justice expressed any support for the government’s regulation of racial epithets. In *Tam*, the majority stated that “trademarks often have an expressive content” and Kennedy stated that “marks make up part of the expression of everyday life.” In *Brunetti*, in the context of vulgar marks, no Justice made mention of “expressive marks” beyond the majority’s conclusion that the provision targets ideas that offend.

In *Brunetti*, it would also appear that some Justices have retreated from the idea that a registration refusal is a burden on speech. I’ve already mentioned Justice Breyer’s suggestion that applicants ought to expect linguistic regulation. Perhaps the most striking rebuttal of registration as speech comes in this passage in Chief Justice Roberts’ opinion:

“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 Government, 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 Government to give aid and comfort to those using obscene, vulgar, and profane modes of expression.”

Such statements will likely surprise anyone who has read the *Tam* decision—unless that person attended the oral arguments in *Brunetti*. Although, as I have suggested, commentators expected the *Brunetti* case to closely follow *Tam*, the dialogue in oral arguments were a good clue that at least some members of the court were seeing something different in the *Brunetti* case. Whereas in *Tam*, the court appeared to be overwhelmingly concerned with the free speech rights of Simon Tam who was presented a civil rights activist, in *Brunetti*, it seems suddenly to have dawned on the court that at issue was the obligation of the government to register a white supremacist’s application for the N-word.

This new unease comes through most clearly in the opening lines of Justice Sotomayor’s opinion:

“The Court’s decision today will beget unfortunate results. With the Lanham Act’s scandalous-marks provision, 15 U. S. C. §1052(a), struck down as unconstitutional viewpoint discrimination, the Government will have no statutory basis to refuse (and thus no choice

but to begin) registering marks containing the most vulgar, profane, or obscene words and images imaginable.”

In his opinion, Justice Breyer remarks, “Just think about how you might react if you saw someone wearing a t-shirt or using a product emblazoned with an odious racial epithet.” Yes, Justice Breyer, many of us were thinking about exactly that in the *Tam* case as it caused the Redskins to recover their mark. Undoubtedly, Justice Breyer has seen a few of these t-shirts around DC.

Just three cases have caused a recent interest in these trademark registration provisions: first the Redskins case (*Blackhorse v. PFI*), then *Tam*, and finally *Brunetti*. Previously, the constitutionality of these provisions was settled by the Court of Customs and Patent Appeals, the predecessor to the Court of Appeals for the Federal Circuit, in *In re McGinley*. On the constitutional issue alone, these three cases have produced seventeen opinions. Even still, many important questions have been explicitly sidestepped such as to what extent, if any, the commercial speech doctrine plays, whether viewpoint neutral content discriminatory registration bars pass muster, or whether trademark registration may be considered as a government program or subsidy. In light of what has transpired, perhaps the *McGinley* court’s approach has some virtues. In *McGinley*, the court circumvented the constitutional issue by finding that the government’s refusal to register a mark does not affect the right to use it: “No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant’s First Amendment rights would not be abridged by the refusal to register his mark.” Moreover, as Justice Sotomayor noted in a footnote, the *McGinley* court bifurcated “scandalous” from “immoral” in precisely the manner that the dissenters suggest would save that bar from being struck down as unconstitutional.

In the end, the implications of this case are narrow. As to First Amendment jurisprudence, we perhaps glean a few more clues as to how to determine what constitutes a viewpoint. Beyond that, we learn that at least four members of the court would support regulating vulgar expression. As to trademark law, it would appear that no further statutory or doctrinal vulnerabilities emerge from this decision that had not been portended by *Tam*. This decision, however, does pave a path forward for amending the Lanham Act to add a bar to the registration of marks that are “scandalous in their mode of expression,” or are “vulgar, lewd, sexually explicit, or profane.”