



U.S. SUPREME COURT RULES THAT “FUCT” IS FINE

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Maybe you feel that the title to this article is “immoral” or “scandalous,” or maybe you don’t. Either way, in light of the U.S. Supreme Court’s seminal decision in *Iancu v. Brunetti*, whether a word or term is “immoral” or “scandalous” is no longer relevant to whether that word or term can receive federal trademark protection.

In a much-anticipated decision authored by Justice Kagan on June 24, 2019, the Supreme Court, in a six-to-three decision, held that the provision of the Lanham Act that barred the registration of “immoral” or “scandalous” trademarks (“the scandalous provision”) was unconstitutional.

As background, in 1990, Erik Brunetti, an established artist and designer, launched the clothing brand FUCT – pronounced similarly to the third word on George Carlin’s list of seven dirty words. According

to Mr. Brunetti, FUCT functions as an acronym for the phrase “Friends U Can’t Trust.” In May 2011, Mr. Brunetti filed a trademark application to register FUCT in connection with clothing apparel. In January 2013, the U.S. Patent and Trademark Office (USPTO) issued a final rejection of the application on the grounds that the mark consisted of immoral or scandalous matter. In response, Mr. Brunetti requested reconsideration of the USPTO’s final rejection, and also appealed that rejection to the Trademark Trial and Appeal Board (TTAB). Mr. Brunetti’s request for reconsideration was denied, and the TTAB affirmed the USPTO’s final rejection.

In September 2014, Mr. Brunetti appealed the TTAB’s decision to the Court of Appeals for the Federal Circuit (Federal Circuit). The Federal Circuit affirmed the

TTAB’s decision, finding that there was substantial evidence supporting the conclusion that the FUCT mark “comprised immoral or scandalous matter.” But the Federal Circuit concluded that the scandalous provision “is an unconstitutional restriction of free speech” and “reversed the [TTAB’s] holding that Mr. Brunetti’s mark is unregistrable.” The Federal Circuit determined that the scandalous provision “impermissibly discriminates based on content in violation of the First Amendment.”

Since the Federal Circuit invalidated a federal statute, the Supreme Court decided to review the Federal Circuit’s decision. In doing so, the Supreme Court looked to its 2017 decision in *Matal v. Tam* and concluded that the scandalous provision – much like the disparagement provision at issue in *Tam* – violated the First

Amendment. In *Tam*, the Supreme Court declared that the provision of the Lanham Act that barred registration of disparaging trademarks was unconstitutional because it discriminated based on viewpoint.

In *Brunetti*, the Supreme Court reasoned that the Lanham Act's scandalous provision also discriminated based on viewpoint because the scandalous provision disfavored certain ideas. In reaching this determination, the Supreme Court observed that:

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. Put the pair of overlapping terms together and the statute, on its face, distinguishes between two opposed sets of ideas: those aligned with conventional moral standards and those hostile to them; those inducing societal nods of approval and those provoking offense and condemnation. The statute favors the former and disfavors the latter. Love rules? Always be good? Registration follows. Hate rules? Always be cruel? Not according to the Lanham Act's "immoral or scandalous" bar.

In its decision, the Supreme Court highlighted several instances where the USPTO engaged in viewpoint discrimination by approving certain trademarks and denying other trademarks. For example, the USPTO approved federal trademark registrations for D.A.R.E. TO RESIST DRUGS AND VIOLENCE and SAY NO TO DRUGS – REALITY IS THE BEST TRIP IN LIFE, but it refused federal trademark registrations for KO KANE and YOU CAN'T SPELL HEALTHCARE WITHOUT THC. Likewise, the USPTO approved a federal trademark registration for PRAISE THE LORD, but it refused a federal trademark registration for BONG HITS FOR JESUS.

After underscoring several of these examples, the Supreme Court asked the hypothetical question: "How, then, can the Government claim that the 'immoral or scandalous' bar is viewpoint-neutral?" Answer: They cannot. But the Government tried. Specifically, the Government advanced the argument that the scandalous provision, despite its plain language, was susceptible to a more limited construction that eliminates any perceived viewpoint discrimination.

That limited construction, according to the Government, would restrict the USPTO to rejecting federal trademark protection for trademarks that were lewd, sexually explicit, or profane as opposed to trademarks that were, generally, immoral or scandalous.

The Supreme Court rejected the Government's attempt to apply such a limitation on a statute that was otherwise plain on its face. Recognizing that it had the authority to interpret ambiguous language to "avoid serious constitutional doubts," the Supreme Court determined that there was no ambiguity with respect to the scandalous provision and that it would not rewrite the provision to make it constitutional. The Supreme Court held that the scandalous provision stretched "far beyond" the Government's suggestion that it should be limited to just trademarks that were lewd, sexually explicit, or profane. And in determining that the scandalous provision violated the First Amendment, the Supreme Court held that:

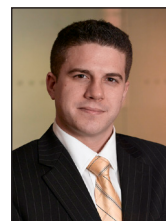
There are a great many immoral and scandalous ideas in the world (even more than there are swear words), and the Lanham Act covers them all.

Going forward, the possibility remains that Congress could, in the future, look to enact more limited legislation that may pass constitutional muster. Consistent with the arguments advanced by the Government in *Brunetti*, Congress could, for example, seek to introduce more targeted legislation that prevents the registration of trademarks that are lewd, sexually explicit, or profane, as opposed to immoral or scandalous. To that end, in his concurring opinion, Justice Alito plainly stated, "[o]ur decision does not prevent Congress from adopting a more carefully focused statute that precludes the registration of marks containing vulgar terms that play no real part in the expression of ideas...but we are not legislators and cannot substitute a new statute for the one now in force." To date, it appears that no such legislation is pending.

One thing is eminently clear: The pathway to securing federal protection for trademarks that may be considered "immoral" or "scandalous" is now significantly less encumbered. The question remains, however, how many businesses will avail themselves of this pathway?

If it is any barometer, a preliminary review of the USPTO database conducted by these authors indicates that, as of the date

of this article, approximately 60 trademark applications have been filed in the USPTO since *Brunetti* was decided that contain some iteration of the word commonly known as the "f word." Expectedly, many of these trademark applications were filed on an "intent to use" basis and, as a result, whether these trademark applications will actually mature into federal trademark registrations remains uncertain. This is because the owners of these trademark applications will, at some point, need to demonstrate use of these trademarks in commerce before a federal trademark registration will issue. But whether it makes good business sense to use a "scandalous" or "immoral" trademark in commerce is a question for the businesspeople – not the lawyers.



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¹ Rivkin Radler LLP, as counsel of record, participated in the preparation of an amicus brief filed with the Supreme Court on behalf of the New York Intellectual Property Law Association, which advanced arguments that were consistent with the Supreme Court's ultimate holding.