

**FLAUNTING THE SCARLET LETTER:  
CONSUMER REGULATION OF  
TRADEMARK MORALITY AFTER *IANCU V.*  
*BRUNETTI***

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**I. INTRODUCTION**

No matter how shocking or offensive the word “FUCT” may be to the general public, the Supreme Court in *Iancu v. Brunetti* held that the government violated Erik Brunetti’s First Amendment right to free speech by refusing to register his clothing brand name “FUCT” as a trademark.<sup>1</sup> Under the Lanham Act, the United States Patent and Trademark Office (PTO)—the government agency in charge of registering trademarks—was required to reject “FUCT” and similar trademarks that are “immoral . . . or scandalous.”<sup>2</sup> Only the trademarks that, in the eyes of the government, met the society’s moral standard passed the trademark registration test and received the government seal of approval. A trademark like “FUCT” that was “the equivalent of [the] past participle form of a well-known word of profanity” and associated with “extreme nihilism” and “anti-social” behavior was not worthy of government approval.<sup>3</sup>

“So the Lanham Act,” Justice Kagan stated in the opinion of the Court, “allows registration of marks when their messages accord with, but not when their messages defy, society’s sense of decency or propriety.”<sup>4</sup> The statute, “on its face, distinguishes between two opposed sets of ideas: those aligned with conventional moral standards and those hostile to them; those induc[ing] societal nods of approval and those provoking offense and condemnation.”<sup>5</sup> The government’s ban on registering “immoral or scandalous” trademarks “discriminates on the basis of viewpoint” and “results in viewpoint-

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1. *See Iancu v. Brunetti*, 139 S. Ct. 2294 (2019).

2. 15 U.S.C. § 1052(a) (2012).

3. *See Brunetti*, 139 S. Ct. at 2297–98.

4. *Id.* at 2300.

5. *Id.*

discriminatory application,” thereby “collid[ing] with our First Amendment doctrine.”<sup>6</sup>

The Court’s decision in *Brunetti* to strike down the “immoral or scandalous” ban is a logical extension of its earlier decision in *Matal v. Tam*,<sup>7</sup> in which the Court invalidated “a neighboring provision”<sup>8</sup> in the Lanham Act that prohibited registering “disparaging” trademarks.<sup>9</sup> Indeed, as if picking up where it had left off in *Tam*, the Court in *Brunetti* began with a reference to *Tam* and stated that it had “made clear in *Tam*” already that “a law disfavoring ‘ideas that offend’ discriminates based on viewpoint, in violation of the First Amendment.”<sup>10</sup> Thus, the Court declared: “We hold that this [immoral or scandalous] provision infringes the First Amendment for the same reason [that the disparaging provision did]: It too disfavors certain ideas.”<sup>11</sup>

The “immoral or scandalous” ban disfavored trademarks that would “shock” or “offend” the public’s “sense of truth, decency, or propriety,”<sup>12</sup> a standard that is difficult if not impossible to grasp and certainly not for the government to define. Accordingly, the PTO was given unfettered discretion in working with this test, as evidenced by its inconsistent and unpredictable results. For instance, based on the PTO’s determination, “HAVE YOU HEARD THAT SATAN IS A REPUBLICAN?” flunked the test,<sup>13</sup> but “THE DEVIL IS A DEMOCRAT” passed the test and became a registered trademark.<sup>14</sup> Justice Gorsuch’s questions during oral argument best sum up the problem: “How is a person -- a person who wants to get a mark supposed to tell what the PTO is going to do? Is it a flip of the coin?”<sup>15</sup> Similarly, many

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6. *Id.* at 2296.

7. See Megan Carpenter, *Opinion Analysis: Long-Time Prohibition on Registration of Scandalous and Immoral Trademarks is Struck Down*, SCOTUSBLOG (June 24, 2019, 6:59 PM), <https://www.scotusblog.com/2019/06/long-time-prohibition-on-registration-of-scandalous-and-immoral-trademarks-is-struck-down/>.

8. *Brunetti*, 139 S. Ct. at 2297.

9. See *Matal v. Tam*, 137 S. Ct. 1744, 1753 (2017); 15 U.S.C. § 1052(a).

10. *Brunetti*, 139 S. Ct. at 2301.

11. *Id.* at 2297.

12. *Id.* at 2298.

13. *Id.*

14. See PETER S. MENELL, MARK A. LEMLEY & ROBERT P. MERGES, *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 972 (2019). For more examples, see also *Brunetti*, 139 S. Ct. at 2300–01, where Justice Kagan provides a lengthy list of examples of inconsistent decisions made by the PTO.

15. Transcript of Oral Argument at 21, *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019) (No. 18–302), available at [https://www.supremecourt.gov/oral\\_arguments/argument\\_transcripts/2018/18-302\\_7k47.pdf](https://www.supremecourt.gov/oral_arguments/argument_transcripts/2018/18-302_7k47.pdf).

trademark scholars “widely agree” that the current trademark registration system is “broken.”<sup>16</sup>

As a trademark speaks to the quality of the product and reputation of the seller, trademark law and regulations should facilitate commerce by protecting consumers from deceitful sellers’ unauthorized misappropriation of trademarks of high-quality products. Regulating trademarks that are “immoral or scandalous” does not achieve this goal, as shown by Erik Brunetti’s trademark case. As the founder and long-time owner of the skater fashion brand FUCT, Brunetti saw many counterfeit sellers on eBay and Amazon selling knockoff FUCT clothes and “costing him real money.”<sup>17</sup> Hence, he became motivated to register his brand name as a trademark so that he could “go after the copycats and shut them down.”<sup>18</sup> Trademark registration is not necessary since “the owner of an unregistered mark may still use it in commerce and enforce it against infringers” to use the trademark in commerce and enforce it against infringers.<sup>19</sup> However, registration gives trademark owners “valuable benefits” such as “prima facie evidence” of the mark’s validity and “constructive notice” of the registrant’s claim of ownership, thereby allowing the registered owner to defeat several defenses in trademark infringement suits.<sup>20</sup> Denying Brunetti these benefits and protection because he chose to use a trademark that the government deems “immoral or scandalous” misses the mark. Determining what is “immoral or scandalous” is neither within the government’s capability nor responsibility. Instead, trademark regulations should seek to protect Brunetti and consumers from counterfeit sellers and their low-quality products.

Now that the “disparaging” and “immoral or scandalous” bans have been struck down by the Supreme Court, how might the government regulate these marks? Congress is certainly free to rewrite the statute, since Congress “alone has the institutional competence, democratic legitimacy, and (most importantly) constitutional authority to revise statutes . . . .”<sup>21</sup> The dissents in *Brunetti* raise salient policy concerns that support rewriting rather than completely eliminating the government’s regulation of trademark morality.<sup>22</sup>

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16. Rebecca Tushnet, *Registering Disagreement: Registration in Modern American Trademark Law*, 130 HARV. L. REV. 867, 868 (2017).

17. Nina Totenberg, *Supreme Court Dances Around the F-Word with Real Potential Financial Consequences*, NPR (Apr. 16, 2019, 5:00 AM), <https://www.npr.org/2019/04/16/713632552/supreme-court-dances-around-the-f-word-with-real-potential-financial-consequence>.

18. *Id.*

19. *See Brunetti*, 139 S. Ct. at 2297.

20. *Id.* at 2297–98 (quoting 15 U.S.C. §§ 1115(a), 1072 (2012)).

21. *See Wis. Cent. Ltd. v. United States*, 138 S. Ct. 2067, 2074 (2018).

22. *See infra* Section III.B.3.

Nevertheless, the “disparaging” and “immoral or scandalous” bans should not be revived or revised. It is true, as Justice Sotomayor pointed out, that the elimination of the “immoral or scandalous” ban would leave the government with “no choice but to begin registering marks containing the most vulgar, profane, or obscene words and images imaginable.”<sup>23</sup> It is also understandable, as Justice Breyer noted, to be concerned with words like “FUCT” being used as the name of “a clothing line that includes apparel for children and infants”<sup>24</sup> and even “believe that such words should not be displayed in public spaces” where “children are likely to be present.”<sup>25</sup> However, refusing to register “FUCT” as a trademark would not necessarily result in a fewer number of shirts with the FUCT logo; instead, it may increase counterfeit uses of the FUCT logo and make it more difficult for Brunetti to win fights against misappropriators of his brand.

The Court made the right decision to invalidate the “immoral or scandalous” provision, and Congress should not attempt to resurrect it. The Court and the government agree that it is unconstitutional to “deny registration based on the views expressed” by a mark.<sup>26</sup> No matter how the “immoral or scandalous” provision is rewritten, it will be inherently viewpoint-discriminatory and thus unconstitutional. Trademark law and regulations should be designed to ensure consumer protection and fair competition: incentivize sellers to sell high-quality products and build good reputation by protecting their trademarks from unfair use.<sup>27</sup> Whether and to what extent sellers may use offensive or scandalous words as their trademarks are questions left to consumers, not the government.

This Note argues consumers are the real players in the market with the purchasing power to favor and disfavor certain trademarked products, and they are in the best position to gauge the current level of morality in society. The government should stay out of regulating trademark morality, and let consumers choose what kinds of trademarks they want to see displayed in the marketplace. Let them decide whether they want to see “immoral or scandalous” trademarks and which trademarks should be deemed immoral or scandalous. After all, what was thought to be scandalous a couple of decades ago may “now be thought merely humorous (or even quaint)” due to changes

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23. *Brunetti*, 139 S. Ct. at 2308 (Sotomayor, J., concurring in part and dissenting in part) (parenthesis omitted).

24. *Id.* at 2304 (Breyer, J., concurring in part and dissenting in part).

25. *Id.* at 2307.

26. *Id.* at 2299.

27. *See infra* Section II.A.1.

in societal attitudes.<sup>28</sup> As Judge Clevenger of the Federal Circuit pointed out, “Today’s scandal can be tomorrow’s vogue.”<sup>29</sup>

The following Part II provides a brief overview of trademark law and examines the PTO’s interpretation and application of the “immoral or scandalous” provision. Part III discusses the *Iancu v. Brunetti* decision and the four separate concurring and dissenting opinions that suggest the possibility of a congressional rewrite of the now-invalidated provision. Part IV argues against a rewrite and in support of entrusting consumers with regulating trademark morality in the market. The Note also highlights some of the broader policy implications of the *Brunetti* decision that demonstrate why this kind of trademark regulation should be left to consumers rather than to the government.

## II. TRADEMARK LAW AND THE PTO’S APPLICATION OF THE PROVISION AT ISSUE

### A. TRADEMARK LAW

#### 1. *History and Purpose*

Trademarks have co-existed with humans for the last 4,000 years.<sup>30</sup> Early merchants trading in China, Persia, Egypt, and Greece marked their clothing and pottery goods with words or symbols to identify themselves.<sup>31</sup> These marks served several purposes that resemble those of today’s trademarks. First, the early marks acted as advertisements, allowing merchants to promote their names in front of potential customers.<sup>32</sup> Second, the marks helped resolve ownership disputes by proving that the goods with a particular mark were being sold by a specific merchant.<sup>33</sup> Third, these marks provided a guarantee of quality, as merchants were putting their reputations on the line by identifying themselves with their goods.<sup>34</sup> In serving these purposes,

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28. *See In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1218 (I.T.A.B. 1993).

29. *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (1994) (discussing, amongst other cases, QUEEN MARY, in reference to women’s underwear, which was held as scandalous in *Ex parte Martha Maid Mfg. Co.*, 37 U.S.P.Q. (BNA) 156 (Comm’r Pats. 1938)).

30. MENELL ET AL., *supra* note 14, at 873 (quoting WILLIAM H. BROWNE, A TREATISE ON THE LAW OF TRADEMARKS 1–14 (1885)).

31. *Id.*

32. *Id.*

33. *Id.*

34. *Id.*

trademarks have helped reduce transaction costs by making it easier for consumers to identify desired goods quickly and accurately.<sup>35</sup>

The purpose of trademarks, then, is to help consumers distinguish between the goods that they “wish to purchase” and those that they “want to avoid.”<sup>36</sup> Hence, it is not surprising to find the roots of trademark law in the soil of anti-fraud law<sup>37</sup> as trademark-related disputes began arising among merchants and counterfeiters. Judge Joseph Story granted the first trademark injunction in 1844 against the counterfeiters of “Taylor’s Persian Thread.”<sup>38</sup> Then, in 1870 Congress enacted a federal trademark law that grounded trademark protection in the Intellectual Property Clause of the Constitution.<sup>39</sup> However, the Supreme Court struck it down and held that trademark should not be grounded in the Intellectual Property Clause, as it was not an “invention[] and discover[y] in the arts and sciences,” but rather a “useful and valuable aid or instrument of commerce” that belonged in the Commerce Clause.<sup>40</sup> Congress followed the Court’s recommendation and enacted the Trademark Law of 1905 under the Commerce Clause.<sup>41</sup> Consequently, use of a mark in commerce has long been a requirement for trademark protection.<sup>42</sup>

Although trademark registration is not required for bringing a civil action against alleged counterfeiters,<sup>43</sup> owners who register their marks enjoy additional “valuable benefits,”<sup>44</sup> including a presumptive right of validity, constructive nationwide rights, and customs rights to restrict imports of goods labeled with infringing marks.<sup>45</sup> The Lanham Act, which lays out the foundation of the modern trademark law,<sup>46</sup> specifies various requirements and restrictions regarding trademark registration—such as the prohibition of

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35. *Id.*

36. *Iancu v. Brunetti*, 139 S. Ct. 2294, 2306 (2019) (Breyer, J., concurring in part and dissenting in part) (quoting *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017)).

37. See Kenneth J. Vandeveld, *The New Property of the Nineteenth Century: The Development of the Modern Concept of Property*, 29 BUFF. L. REV. 325, 340 (1980).

38. See *Taylor v. Carpenter*, 23 F. Cas. 742 (1844).

39. MENELL ET AL., *supra* note 14, at 874.

40. *The Trade-Mark Cases*, 100 U.S. 82, 93–95 (1879).

41. MENELL ET AL., *supra* note 14, at 874.

42. *Id.*

43. See 15 U.S.C. § 1125(a) (2012).

44. *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019).

45. See 15 U.S.C. §§ 1115(a) (2016), 1072 (2011), 1125(b) (2012).

46. Mark Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1687 (1999). The Lanham Act is also known as the Trademark Act of 1946.

registering any mark that “so resembles” another mark<sup>47</sup> or that is “merely descriptive” of the good on which it is used.<sup>48</sup>

2. *At Issue: Section 2(a) of the Lanham Act*

Besides the provisions prohibiting registration of marks that are likely to deceive or confuse consumers, the Lanham Act also includes a provision prohibiting registration of marks that may shock public morality. According to section 2(a) of the Lanham Act, marks that consist of “immoral . . . or scandalous” matter “shall be refused registration.”<sup>49</sup> The legislative history of the Lanham Act, which spans across four congressional terms, does not provide much helpful guidance as to the meaning of “immoral” or “scandalous.”<sup>50</sup> Instead, this prohibition has been part of the Lanham Act for so long that it was taken as a given, without any showing of how it relates to and furthers the purpose of broader trademark law.<sup>51</sup> Hence, the PTO was left on its own to interpret and apply the statutory prohibition, which resulted in “a long line of arbitrary and contradictory decisions.”<sup>52</sup>

B. THE PTO’S INTERPRETATION AND APPLICATION

In its Trademark Manual of Examining Procedure (TMEP), the PTO explicitly states that “[t]here is little legislative history concerning the intent of Congress with regard to the [immoral or scandalous] provision.”<sup>53</sup> Accordingly, the PTO has interpreted this provision by looking into “its ordinary and common meaning.”<sup>54</sup> Based on that interpretation, it created a test that asks whether a “substantial composite of the general public” would find the mark “shocking to the sense of propriety, offensive to the conscience

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47. 15 U.S.C. § 1052(d) (2012).

48. 15 U.S.C. § 1052(e) (2012).

49. 15 U.S.C. § 1052(a) (2012). Such prohibition on “immoral or scandalous” trademarks was enacted initially as section 5(a) of the Trademark Act in 1905 and was reenacted as part of the Lanham Act in 1946. THE PATENT AND TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1203.01 (Oct. 2018), <https://tmepp.uspto.gov/RDMS/TMEP/current#/current/TMEP-1200d1e3042.html> [hereinafter TMEP].

50. TMEP, *supra* note 49, at § 1203.01.

51. Alan Behr, *The Implications are Potentially Broad, in Iancu v. Brunetti Ruling – Trademark Community Has Its Say on Implications of Momentous US Supreme Court Decision* (Tim Lince, ed.), WORLD TRADEMARK REV. (June 25, 2019), <https://www.worldtrademarkreview.com/enforcement-and-litigation/iancu-v-brunetti-ruling-trademark-community-has-its-say-implications>.

52. Brief for the American Civil Liberties Union and the ACLU of the District of Columbia at \*25, as Amici Curiae Supporting Respondent, *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019) (No. 18-302).

53. TMEP, *supra* note 49, at § 1203.01.

54. *Id.* (quoting *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938).

or moral feelings or calling out for condemnation,” or “‘vulgar,’ defined as ‘lacking in taste, indelicate, [or] morally crude.’”<sup>55</sup>

Unfortunately, this test did not work as intended when carried out in practice. As Justice Gorsuch pointed out in *Brunetti*, “there are shocking numbers of [marks] granted [registration] and ones refused that . . . do look remarkably similar.”<sup>56</sup> For example, the mark BITCH was approved and registered over 150 times, while KICKABITCH was rejected.<sup>57</sup> Other examples include: GRAMMAR NAZI (approved) versus COFFEE NAZI (rejected); F·A·G FABULOUS AND GAY (approved) versus MARRIAGE IS FOR FAGS (rejected); WHORES FROM HELL (approved) versus THE CHRISTIAN PROSTITUTE (rejected).<sup>58</sup> Justice Gorsuch asked, “How is a reasonable citizen supposed to know . . . how the government’s going to treat their mark?”<sup>59</sup>

Erik Brunetti was one such citizen, wondering why FCUK was able to pass the test eight times,<sup>60</sup> while his mark, FUCT, could not pass even once. By the end of his nearly thirty-year-long journey to successful trademark registration, he and his mark ended up all the way in the Supreme Court.

### III. IANCU V. BRUNETTI

#### A. FUCT: THE ORIGIN OF ITS GOODS AND SERVICES

Despite its showcase in the nation’s highest Court, the FUCT brand rose from a rather humble beginning in the 1980s in Venice, California, where street skateboarding culture was vibrant and thriving.<sup>61</sup> Erik Brunetti and Natas Kaupas, an entrepreneurial graphic designer and a famous professional skateboarder in their twenties, were trying to come up with a name for a new graphic design company that they were about to start together.<sup>62</sup> They thought it would be clever to call their company “FUCT” and present it as “very

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55. *Id.* (quoting *In re Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1340 (Fed. Cir. 2003) (quoting *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981) (quoting *In re Runsdorf*, 171 USPQ 443, 444 (T.T.A.B. 1971))).

56. Transcript of Oral Argument, *supra* note 15, at 19.

57. See Joint Appendix for Noel J. Francisco & John R. Sommer at 74, *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019) (No. 18-302), 2019 WL 914147.

58. *Id.*

59. Transcript of Oral Argument, *supra* note 15, at 19.

60. FCUK AT HOME also was among those approved for registration. See Francisco & Sommer, *supra* note 57, at 71.

61. See Ian Michna, *Discussing the History of Fuct & the Current Streetwear Market*, JENKEM (May 23, 2019), <http://www.jenkemmag.com/home/2019/05/23/discussing-history-fuct-current-streetwear-market/>.

62. *Id.*

corporate,” so as to have people question the pronunciation based on the way the logo looked.<sup>63</sup> Soon, one of their corporate clients suggested that they make and sell skater pants and shorts with the FUCT logo<sup>64</sup>—and that is how the FUCT brand, which caters to “wealthy rebellious skaters”<sup>65</sup> today, was born.<sup>66</sup> The skater-fashion brand continued to grow, both at home and abroad, even after Brunetti and Kaupas parted ways.<sup>67</sup> Brunetti, who remained with the brand, has since established great pride in his skater customers who have “a sense of community . . . [and are] very communal and very unified.”<sup>68</sup>

With popularity, however, came imitators and knockoffs. As Brunetti described it, big corporations and fashion houses “vulturized” street skateboarding fashion’s “real and legit” personality to compete in their “very dishonest” and cut-throat industry.<sup>69</sup> More importantly, Brunetti found numerous “copycats” on eBay and Amazon, who were selling “lots of counterfeits” that hurt the FUCT brand’s sales.<sup>70</sup> Triggered by the ongoing financial and reputational harm, Brunetti applied for trademark registration at the PTO, in hopes of “shut[ting] down the tremendous amount of bootlegging that[] [had] been happening for years.”<sup>71</sup>

Brunetti’s journey to successful registration of his mark, however, did not turn out to be so straightforward. Both the PTO and the Trademark Trial and Appeal Board (TTAB) determined that FUCT “flunked” the Lanham Act’s “immoral or scandalous” test.<sup>72</sup> Defining the mark as the slang-equivalent of “fucked,” i.e., the past participle form of the quintessential word of profanity, the TTAB concluded that FUCT was unregistrable for being just as offensive, profane, or vulgar as “fuck.”<sup>73</sup>

Nevertheless, the Federal Circuit disagreed with the TTAB’s decision and sided with Brunetti, when he brought a facial challenge to the statutory

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63. *Id.*

64. *Id.*

65. Dennis Crouch, *Oops, I Did It Again: Time to Register Those Scandalous Marks*, PATENTLYO (June 24, 2019), <https://patentlyo.com/patent/2019/06/again-register-scandalous.html>.

66. *Id.*; see Thomas Key, *Freedom of Expression Transcends Morality in US Trademark Registration*, THE IPKAT (July 14, 2019), <http://www.ipkitten.blogspot.com/2019/07/freedom-of-expression-transcends.html>.

67. Michna, *supra* note 61.

68. *Id.*

69. *Id.*

70. Totenberg, *supra* note 17.

71. Michna, *supra* note 61.

72. *Iancu v. Brunetti*, 139 S. Ct. 2294, 2298 (2019).

73. *See In re Brunetti*, 877 F.3d 1330, 1337 (Fed. Cir. 2017).

prohibition.<sup>74</sup> The court concluded that the “century-old provision” of the Lanham Act was in violation of the First Amendment.<sup>75</sup> While acknowledging that there was a question of whether the “immoral or scandalous” provision was viewpoint-neutral, the court explained that it did not need to resolve that issue: “Independent of whether the immoral or scandalous provision is viewpoint discriminatory, . . . the provision impermissibly discriminate[d] based on content in violation of the First Amendment.”<sup>76</sup> Furthermore, the court asserted that strict scrutiny should be applied in this case since the statutory prohibition targeted the expressive—and not commercial—content of speech.<sup>77</sup> When strict scrutiny is applied, the court held, the prohibition would not withstand the review.<sup>78</sup> Even if the court were to assume *arguendo* that trademarks are “purely commercial speech,” the prohibition still would not have survived the applicable intermediate scrutiny analysis.<sup>79</sup>

In sum, the court concluded that there was no reasonable definition of “scandalous” or “immoral” that would preserve the statutory prohibition’s constitutionality.<sup>80</sup> In response to the invalidation of a federal statute by a lower court, the Supreme Court then granted certiorari.<sup>81</sup>

## B. IANCU V. BRUNETTI

### 1. *The Precedent: Matal v. Tam*

As if picking up where it had left off in *Matal v. Tam*, the Court in *Iancu v. Brunetti* began the opinion by reciting its holding in the former case.<sup>82</sup> “Two terms ago, in *Matal v. Tam*,” Justice Kagan wrote, “this Court invalidated the Lanham Act’s bar on the registration of ‘disparag[ing]’ trademarks.”<sup>83</sup> In accordance with that statutory prohibition, the PTO had refused to register THE SLANTS, the name of an Asian-American band that is also a derogatory

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74. *See id.* at 1357.

75. *See id.* (Dyk, J., concurring).

76. *Id.* at 1341. The court defined content-based government restriction on speech as “a law [that] applies to particular speech because of the topic discussed or the idea or message expressed.” *See id.* at 1341–42 (quoting *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2227 (2015)).

77. *Id.* at 1340.

78. *Id.* at 1342, 1349. To survive strict scrutiny review, the government must “prove that the restriction furthers a compelling interest and is narrowly tailored to achieve that interest.” *Id.* at 1342 (quoting *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2231 (2015)).

79. *See id.* at 1350. Intermediate scrutiny requires the government to “show at least that the statute directly advances a substantial governmental interest and that the measure is drawn to achieve that interest.” *Id.* (quoting *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 572 (2011)).

80. *Id.* at 1355.

81. *See Iancu v. Brunetti*, 139 S. Ct. 2294, 2298 (2019).

82. *Id.*

83. *Id.* at 2297.

term used in reference to persons of Asian descent.<sup>84</sup> The Court there rejected the government’s argument that trademarks constitute government speech, and explained that the content of a registered trademark could not be government speech because, if that were true, the government would have been “babbling prodigiously and incoherently,” saying many “unseemly” things.<sup>85</sup> The Court warned of the danger of passing off private speech as government speech by “simply affixing a government seal of approval,” which would allow the government to “silence or muffle the expression of disfavored viewpoints.”<sup>86</sup>

The Court also refused to resolve the issue of whether trademarks constitute commercial speech, since the disparagement clause “cannot withstand even *Central Hudson* review” that applies “relaxed scrutiny” by requiring only that the restriction of speech serve a “substantial interest” and be “narrowly drawn.”<sup>87</sup> The Court concluded that such prohibition on disparaging trademarks “violates the Free Speech Clause” because it “offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend.”<sup>88</sup>

## 2. *The Majority’s Opinion*

Accordingly, the Court in *Iancu v. Brunetti* held that the “immoral or scandalous” provision “infringes the First Amendment for the same reason: It too disfavors certain ideas.”<sup>89</sup> Justice Kagan explained that the problem was not that the meanings of “immoral” and “scandalous” are mysterious. Rather,

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84. *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017). When Simon Tam, the band’s leader, questioned the PTO why it “[chose] to apply the racial connotations to this application” when it had “never done that before in the entire history of this country,” the PTO explained that “it was because [Tam] was Asian-American.” Kat Chow, *Asian-American Band Fights to Trademark Name ‘The Slants’*, NPR (Oct. 20, 2013 6:14 AM), <https://www.npr.org/sections/codeswitch/2013/10/20/236235813/asian-american-band-fights-to-trademark-name-the-slants>.

85. *See Matal*, 137 S. Ct. at 1758. The Court has defined commercial speech as speech that does “no more than propose a commercial transaction . . .” *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council Inc.*, 425 U.S. 748, 762 (1976) (quoting *Pittsburgh Press Co. v. Human Relations Comm’n*, 413 U.S., 376, 385 (1973)).

86. *Matal*, 137 S. Ct. at 1758.

87. *See id.* at 1763–64 (quoting *Cent. Hudson Gas & Electric Corp. v. Public Service Comm’n*, 447 U.S. 557, 564–65 (1980)). A restriction on commercial speech is subject to a four-part analysis that tests whether (1) the speech concerns “lawful activity and [is] not . . . misleading”; (2) the “asserted governmental interest” to be served by the restriction is “substantial”; (3) the restriction “directly advances the governmental interest asserted”; and (4) “whether [the restriction] is not more extensive than is necessary to serve that interest.” *Cent. Hudson*, 447 U.S. at 566.

88. *Matal*, 137 S. Ct. at 1751.

89. *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297–98 (2019).

the problem was that the provision that discriminated against marks meeting such criteria was viewpoint-based.<sup>90</sup> The provision at issue, she argued, allowed registering marks “when their messages accord with, but not when their messages defy, society’s sense of decency or propriety.”<sup>91</sup> In other words, it distinguished between “two opposed sets of ideas”: those “aligned with conventional moral standards” versus those “hostile to them”; those “inducing societal nods of approval” versus those “provoking offense and condemnation.”; hence, “the statute favors the former, and disfavors the latter.”<sup>92</sup>

The Court also rejected the government’s proposal to apply a narrowing construction to the statute to remove viewpoint bias.<sup>93</sup> Justice Kagan questioned, “How . . . can the Government claim that the ‘immoral or scandalous’ bar is viewpoint-neutral? The Government basically asks us to treat [the PTO’s inconsistent] decisions . . . as PTO examiners’ mistakes.”<sup>94</sup> She contended that the government was instructing the Court to “ignore” that the text of the statute, “on its face, disfavor[ed] some ideas.”<sup>95</sup> The government’s assertion was that the Court should try to construe the statute in a way that renders it constitutional, i.e., to narrow the prohibition to “marks that are offensive [or] shocking to a substantial segment of the public because of their *mode* of expression,” regardless of any viewpoints that they might express.<sup>96</sup> Justice Kagan rejected “that canon of construction,” which is applicable “only when ambiguity exists.”<sup>97</sup> Here, no such ambiguity existed, and the statute as written “[did] not draw the line at lewd, sexually explicit, or profane marks,” let alone at marks whose mode of expression was offensive.<sup>98</sup> She concluded that “once the ‘immoral or scandalous’ bar is interpreted fairly, it must be invalidated.”<sup>99</sup>

### 3. *The Four Separate Opinions*

Much debate over the majority’s decision ensued: Chief Justice Roberts and Justices Alito, Breyer, and Sotomayor each filed his or her own concurring or concurring-in-part-and-dissenting-in-part opinions.<sup>100</sup> Justice Alito, for

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90. *Id.* at 2299.

91. *Id.* at 2300.

92. *Id.*

93. *Id.* at 2301.

94. *Id.*

95. *Id.*

96. *Id.* (quoting Transcript of Oral Argument, *supra* note 15, at 11).

97. *Id.*

98. *Id.*

99. *Id.*

100. *See id.*

instance, joined the majority in full yet wrote a separate concurring opinion to emphasize how “important [it was] for this Court to remain firm on the principle that the First Amendment does not tolerate viewpoint discrimination,” especially “[a]t a time when free speech is under attack.”<sup>101</sup> Moreover, he made clear that the members of the Court “are not legislators and cannot substitute a new statute for the one now in force,” noting that the majority’s decision “does not prevent Congress from adopting a more carefully focused” provision.<sup>102</sup>

On the other hand, Chief Justice Roberts and Justice Breyer joined the majority only in part and each filed an opinion concurring in part and dissenting in part.<sup>103</sup> They both agreed with Justice Sotomayor’s argument that the majority erred in treating the “immoral” and “scandalous” prongs as one provision, when the latter is “susceptible of . . . a narrowing construction.”<sup>104</sup>

Specifically, Justice Breyer expressed in detail his disagreement with the Court’s usual practice of taking a categorical approach to First Amendment questions.<sup>105</sup> Instead of focusing on categorizing the statute at issue “as an example of ‘viewpoint discrimination,’ ‘content discrimination,’ ‘commercial speech,’ ‘government speech,’ or the like,” he asserted, “I would appeal more often and more directly to the values the First Amendment seeks to protect,”<sup>106</sup> and focus on whether the statute “works speech-related harm that is out of proportion to its justifications.”<sup>107</sup>

Justice Breyer also addressed the practical effect of the majority’s decision. “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.”<sup>108</sup> He contended that the government may have an interest in protecting “the sensibilities of children” by prohibiting trademark registration of words like FUCT that “should not be displayed . . . where children are likely to be present.”<sup>109</sup>

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101. *Id.* at 2302–03 (Alito, J., concurring).

102. *Id.* at 2303.

103. *See id.* at 2302–06 (Roberts, C. J., concurring in part and dissenting in part).

104. *Id.* at 2303.

105. *See id.* at 2304–08 (Breyer, J., concurring in part and dissenting in part).

106. *Id.* at 2304–05.

107. *Id.* at 2305 (quoting *United States v. Alvarez*, 567 U.S. 709, 730 (2012)).

108. *Id.* at 2307.

109. *Id.* Regarding the question of “whether the First Amendment permits the Government to rely on [the narrowly constructed] statute . . . to deny the benefits of federal trademark registration to marks like the one at issue here, which involves the use of the term ‘FUCT,’” Justice Breyer stated, “I believe the answer is ‘yes.’” *Id.* at 2304.

Justice Sotomayor, with whom Justice Breyer joined, voiced the strongest dissent against the majority's decision.<sup>110</sup> At the outset, Justice Sotomayor conceded and agreed with the majority that there was "no tenable way to read" the word "immoral," as it "clearly connotes a preference for 'rectitude and morality' over its opposite."<sup>111</sup> Nonetheless, she argued that the word "scandalous," although "on its own . . . is ambiguous," could mean "simply indecent, shocking, or generally offensive" and thus could be saved from invalidation.<sup>112</sup> The majority, therefore, "ill-advisedly collapse[d]" the two words, when it should have treated "immoral" as covering marks that are "offensive because they transgress social norms" and "scandalous" as covering marks that are "offensive because of the *mode* in which they are expressed."<sup>113</sup> She concluded that she would apply a narrowing construction to the "scandalous" prong to address "only obscenity, vulgarity, and profanity" and reject Brunetti's facial challenge.<sup>114</sup>

The majority responded to Justice Sotomayor's argument in a footnote, explicitly "reject[ing] the dissent's statutory surgery."<sup>115</sup> "[T]he dissent thinks that the term 'scandalous' can be read [narrowly] as the Government proposes," the majority noted, "[b]ut that term is not 'ambiguous,' as the dissent argues . . . it is just broad."<sup>116</sup>

As Justice Alito suggested, Congress can decide whether to enact a new statute to replace section 2(a). With the majority's decision in hand, Congress now faces several options: for instance, it may adopt "a more carefully focused" provision.<sup>117</sup> It can take Justice's Sotomayor's approach of a narrowing construction by reviving only the "scandalous" prong of the provision.<sup>118</sup> Alternatively, Congress can decide to do nothing with the invalidated provision altogether, keeping the PTO's trademark registration system free of any test for immoral or scandalous marks. For the reasons below, this Note argues that Congress should resist any temptation to rewrite the "immoral or scandalous" statute. Instead, Congress should leave the task of regulating trademark morality to consumers, who are positioned to be the

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110. "The Court's decision today will beget unfortunate results." *Id.* at 2308 (Sotomayor, J., concurring in part and dissenting in part).

111. *Id.* at 2309.

112. *Id.*

113. *Id.* at 2311 (emphasis added).

114. *Id.* at 2313.

115. *Id.* at 2302 n\*.

116. *Id.*

117. *Id.* at 2303 (Alito, J., concurring).

118. *Id.* at 2308.

most effective and efficient regulators of potentially immoral or scandalous trademarks in the market.

#### IV. CONSUMERS AS THE REGULATORS OF TRADEMARK MORALITY

Entrusting consumers with the task of regulating trademark morality resolves several legal and practical problems posed by the test in the PTO's trademark registration process. Consumers have what the PTO does not: purchasing and boycotting power that influences businesses seeking to promote their brands to consumers. Additionally, it is consumers, not the PTO, who can best measure the current temperature of public sentiment and sense of morality. Lastly, policy implications of the Court's decision in *Brunetti*—such as upholding First Amendment values, promoting predictability and the equal treatment of trademark applicants, and adhering to trademark law's intended purpose—also demonstrate why evaluation of trademark morality is best left in the hands of consumers.

##### A. CONSUMERS' PURCHASING AND BOYCOTTING POWER: THE REAL DISINCENTIVE TO USING IMMORAL OR SCANDALOUS TRADEMARKS

In practice, it is consumers' taste and their own sense of morality, rather than a hypothetical test set up by the government, that can best gauge which trademarks are offensive to the public and which ones are not. Since the fate of a trademark ultimately depends on whether and how much it is used in commerce, trademark registration and its accompanying benefits become meaningless if the mark is not even in use. Therefore, consumers' purchasing decisions, which drive the usage and popularity of trademarks in the market, inevitably exert significant influence on business owners' branding and marketing decisions—as illustrated by the actions of Gap and the Redskins.

###### 1. *Gap*

The actions of the clothing retailer company Gap serve as a good example of a brand owner's response to consumer influence. In 2016, Gap publicized an ad featuring a taller Caucasian girl posing next to and resting her arm on top of the head of a shorter African-American girl (as shown in Figure 1A).<sup>119</sup> As soon as the ad went live, it ignited a huge public outrage and criticism against the casting of the black child as “an armrest.”<sup>120</sup> One Twitter comment, which received more than a thousand Likes, read: “@GapKids proving girls

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119. John Kell, *Gap Apologizes For 'Racist' Ad*, ENTREPRENEUR (Apr. 5, 2016), <https://www.entrepreneur.com/article/273593>.

120. *Id.*

can do anything . . . unless she's Black. Then all she can do is bear the weight of White girls."<sup>121</sup> Without any hesitation or delay, Gap immediately issued an apology and replaced the image with a different one (as shown in Figure 1B) that looked similar but less offensive.

Figure 1A: The Original Version of the Ad by Gap



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121. Fatima La’Juan (@TheTherapyDiva), TWITTER (Apr. 2, 2016, 2:21 PM), [https://twitter.com/TheTherapyDiva/status/716375045421944832?ref\\_src=twsrc%5Etfw%7Ctwcamp%5Etweetembed%7Ctwterm%5E716375045421944832&ref\\_url=https%3A%2F%2Ffortune.com%2F2016%2F04%2F05%2Fgap-pulls-controversial-ad-image%2F](https://twitter.com/TheTherapyDiva/status/716375045421944832?ref_src=twsrc%5Etfw%7Ctwcamp%5Etweetembed%7Ctwterm%5E716375045421944832&ref_url=https%3A%2F%2Ffortune.com%2F2016%2F04%2F05%2Fgap-pulls-controversial-ad-image%2F).

Figure 1B: The Edited Version After Consumer Complaint



This controversy demonstrates how essential it has become for big brands like Gap to “navigate the turbulent nature of social media,” where anything from ad campaigns to new products can be “harshly criticized in a matter of hours.”<sup>122</sup> As brand owners are well aware that such criticism and backlash can slash profits and even lead to a complete boycott, they understandably react quickly to consumers’ feedback by “pulling the offensive material and issuing a swift apology, as Gap did in this instance.”<sup>123</sup>

Although this incident is an example of consumers reacting to a controversial ad, rather than a controversial trademark, it nevertheless shows that business owners would be even more careful when it comes to choosing and promoting their trademarks. An advertisement may be ephemeral and separable from the product, but a trademark is often permanently imprinted onto and thus inseparable from the product that consumers decide to buy and own. Therefore, it would be much more difficult to rectify the kind of mistake that Gap made, had that mistake involved a trademark instead of a mere seasonal ad, the latter of which Gap was able to quickly take down and isolate from its brand.

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122. Kell, *supra* note 119.

123. *Id.*

Therefore, the natural process—in which consumers react disapprovingly to what they find as offensive or shocking messages, and businesses respond promptly by making necessary changes to conform to contemporaneous public sentiment—renders superfluous any government regulation of trademark morality on behalf of consumers. Consumers would be unlikely to take home a product that bears a trademark they find offensive—let alone wish to be perceived by others as being associated with that trademark—especially if, like the FUCT apparel, the product is one that consumers wear or carry in public. As the following example shows, the success and lifespan of a particular trademark depend on its usage in the market, which is largely driven by consumers themselves—regardless of the trademark’s registration status.

## 2. REDSKINS

REDSKINS is both the name of a national football team and a word viewed by many Native Americans as “a deeply offensive slur.”<sup>124</sup> For nearly half a century, Native American leaders have been urging the football team to change its name, and also have been challenging the validity of the REDSKINS trademark registration based on the Lanham Act’s “disparagement” provision.<sup>125</sup> The team has refused to change its name but did agree to replace “Scalp ’em” in the team’s fight song with “Beat ’em” and to get rid of the cheerleaders’ black braided wigs.<sup>126</sup> Daniel Snyder, the current owner, has sworn that he will never change the name of his football team: “It’s that simple. NEVER — you can use caps,” he said in an interview.<sup>127</sup> Even former President Barack Obama, who expressed his personal view that he would change the name if he were the owner, could not convince Snyder.<sup>128</sup>

Then, the decision in *Matal v. Tam* came down, in which the Court invalidated the “disparagement” provision in support of THE SLANTS.<sup>129</sup> This meant that the Native Americans who had been fighting long legal battles against the Washington Redskins team had to “call[] it quits” and concede that

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124. Ian Shapira & Ann E. Marimow, *Washington Redskins Win Trademark Fight Over the Team’s Name*, WASH. POST (June 29, 2017), [https://www.washingtonpost.com/local/public-safety/2017/06/29/a26f52f0-5cf6-11e7-9fc6-c7ef4bc58d13\\_story.html?utm\\_term=.b5cb74ceed07](https://www.washingtonpost.com/local/public-safety/2017/06/29/a26f52f0-5cf6-11e7-9fc6-c7ef4bc58d13_story.html?utm_term=.b5cb74ceed07).

125. *Id.*

126. *Id.*

127. *Id.*

128. *Id.*

129. *Matal v. Tam*, 137 S. Ct. 1744 (2017); 15 U.S.C. § 1052(a).

“[t]here’s no more challenge to make.”<sup>130</sup> Snyder, on the other hand, did not hesitate to express his excitement: “I am THRILLED! Hail to the Redskins.”<sup>131</sup>

The practical effect, however, would not have been much different for REDSKINS, had the decision in *Matal v. Tam* come out the other way. Even if the Court had not decided to invalidate the “disparagement” provision—and even if the Native Americans somehow had won the legal battle against “the most entrepreneurial of haters”<sup>132</sup> by successfully invalidating the trademark registration of REDSKINS—that mark nevertheless would survive and continue to thrive in the market so long as its fans continue to consume it and associate with it as part of their identities as they do so today. In other words, even as an *unregistered* mark, REDSKINS would still be emblazoned on team jerseys and flags, being “displayed . . . where children are likely to be present,” just as it had been as a registered trademark, only without the ® symbol.<sup>133</sup> As unfortunate as it is that the Redskins team and its owner are not as receptive to external feedback as Gap was, trademark law has proven itself to be unhelpful in this case. What may be helpful, instead, is the public awareness of the trademark’s offensiveness and the resulting decrease in the public’s consumption of and association with the REDSKINS brand. Therefore, it is consumers’ purchasing and boycotting power that can drive this trademark out of the marketplace, rather than the cancellation of its trademark registration with the PTO. So long as consumers continue to support a brand and choose not to change their consumption behavior, that brand will live on in the marketplace regardless of whether it is granted or denied trademark registration.

## B. FLUIDITY IN WORDS’ DEFINITIONS AND PUBLIC SENTIMENT

Meanings that society attaches to words and symbols evolve over time, making it difficult for the PTO to decide which ones are meant to offend or shock “society’s sense of decency or propriety” today.<sup>134</sup> Public sentiment changes over time as well, and such fluid nature of public sentiment and words’

130. Shapira & Marimow, *supra* note 124.

131. JP Finlay, *Dan Snyder ‘THRILLED’ with Supreme Court Decision that Should Protect Redskins Name*, NBC SPORTS (June 19, 2017), <https://www.nbcsports.com/washington/washington-redskins/dan-snyder-thrilled-supreme-court-decision-should-protect-redskins-name>.

132. Sonia K. Katyal, *Commentary: Brands Behaving Badly*, 109 L.J. INT’L TRADEMARK ASS’N 819, 824 (2019); *see also* *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d 1705, 1747 (BNA) (noting that Redskins fans “engag[e] in antics that clearly poke fun at Native American culture and portray Native Americans as savages and buffoons”).

133. *See Iancu v. Brunetti*, 139 S. Ct. 2294, 2307 (2019) (Breyer, J., concurring in part and dissenting in part).

134. *Id.* at 2300.

meanings undermine any trademark registration system that requires the PTO to fix a particular meaning onto a word so as to determine whether that word is “immoral or scandalous.” Such decision on trademark registrability of a word—which locks the word’s meaning at the time of review—becomes susceptible to being outdated or challenged if the public subsequently changes its sentiment towards the word, or, if the word itself changes in meaning. Therefore, the determination as to whether a word is offensive to the general public should be made by the contemporaneous public, rather than the examiners at the PTO who rely on dictionary definitions.

Take the following OK-sign as an example. Zina Bash—a former White House staffer and clerk to then-nominee Brett Kavanaugh—was sitting at the Supreme Court nomination hearing in 2018, where she was shown on camera as if making an OK sign with her hand resting on her arm.<sup>135</sup> Unbeknownst to her, however, the OK sign had been gathering much attention in the media after several segments of far-right groups and white supremacists launched the so-called “Operation O-KKK” in 2017 in an effort to claim the OK sign as a symbol of white supremacy.<sup>136</sup> Bash’s hand gesture immediately ignited an “online furor,” despite attempts by her husband (and U.S. Attorney) John Bash to assure “[e]veryone tweeting this vicious conspiracy theory” that Zina—who is Jewish, part Mexican, and a descendant of Holocaust survivors—would never associate herself with such meaning.<sup>137</sup> As this short-lived but nevertheless highly controversial incident demonstrates, both a symbol’s meaning and social attitudes towards that symbol are susceptible to rapid change that can take place in a matter of a year or two.

If the OK sign in this scenario had been reviewed under the PTO’s “immoral or scandalous” trademark ban, would it have passed the test? If the white supremacists were to succeed in their Operation O-KKK to claim the OK sign as their own, the PTO may have had to consider denying trademark registration on the basis that the sign would shock or offend a substantial composite of the public. But if such offensive meaning did not permanently stick to the OK sign and instead faded away after a while, the PTO then would have had to reassess the meaning and perhaps start approving the sign for trademark registration again.

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135. Mahita Gajanan, *A Kavanaugh Supporter Was Accused of Making a White Power Symbol. She’s a Descendant of Holocaust Survivors*, TIME (Sept. 5, 2018), <https://time.com/5386860/zina-gelman-bash-white-power-symbol/>.

136. *How the “OK” Symbol Became a Popular Trolling Gesture*, ADL (May 1, 2017), <https://www.adl.org/blog/how-the-ok-symbol-became-a-popular-trolling-gesture>; *4CHAN-OPERATIONOKKK.JPG*, SOUTHERN POVERTY LAW CENTER, <https://www.splcenter.org/files/4chan-operationokkkjpg> [<https://perma.cc/F4PQ-QXLP>].

137. Gajanan, *supra* note 135.

Thus, the government should not attempt to fix a particular meaning onto a symbol and guess whether the general public would find it offensive. Instead, the general public should decide for itself as to whether, based on contemporaneous public sentiment, it finds the meaning of the symbol offensive enough to ban it from the market. Put simply, the question of whether “a substantial composite of the general public” would find a mark shocking or offensive<sup>138</sup> is best answered by the general public itself, not the government. When a substantial composite of the general public indeed finds a mark—registered or unregistered—offensive or scandalous, it may choose to avoid purchasing products associated with that mark and eventually drive it out of the market; alternatively, it may induce the business owner directly to abandon the mark for a less offensive one. This organic process is adaptive to changes in words’ meanings and social attitudes over time, thereby enabling regulation of trademark morality to be both effective and efficient.

C. POLICY IMPLICATIONS OF ENTRUSTING CONSUMERS WITH TRADEMARK REGULATION

1. *First Amendment Values in Potentially Scandalous Words*

By invalidating the “immoral or scandalous” provision, the Court in *Iancu v. Brunetti* also has implicitly acknowledged the value in using offensive words. Whether or not to use swear words is a choice—and a meaningful one—that a person makes in not only the *mode* of their expressions but also the *attitude* and *meaning* of their ideas.<sup>139</sup> Labeling swear words as mere modes of expression trivializes the irreplaceability and uniqueness of swear words as stand-alone expressions of ideas. As Professor Franklyn Haiman pointed out, the message “Fuck the Draft” at issue in *Cohen v. California* cannot be replaced by phrases like “Repeal the Draft” or “Resist the Draft” that just do not carry the same meaning.<sup>140</sup> How people use swear words may be part of their “deep emotional investment in a personal identity” that they use to represent themselves out in the world, to differentiate themselves from others, and to express their feelings and attitudes about others.<sup>141</sup>

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138. See TMEP, *supra* note 49, at § 1203.01.

139. Brief for Cato Institute et al. as Amici Curiae Supporting Respondent at 13, *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019).

140. See Franklyn S. Haiman, *Speech v. Privacy: Is There a Right Not to Be Spoken To?*, 67 NW. U. L. REV. 153, 189 (1972) (referring to *Cohen v. California*, 403 U.S. 15 (1971)).

141. Cato Institute, *supra* note 139, at 13. (quoting TIMOTHY JAY, *WHY WE CURSE: A NEURO-PSYCHO-SOCIAL THEORY OF SPEECH* 82 (1999)).

The Court's decision thus implicitly recognizes that, since people use language as a mode of their thoughts,<sup>142</sup> a ban on certain types of language—including “even the most viscerally offensive words and images that one can imagine”<sup>143</sup>—constitutes a ban on people's thoughts. The Court previously has established that “forbid[ding] particular words . . . run[s] a substantial risk of suppressing ideas in the process.”<sup>144</sup> Such a ban by the government then erodes people's freedom to choose what ideas to express and how to exchange those ideas with others. But the government has no right to “cleanse public debate to the point where it is grammatically palatable to the most squeamish among us.”<sup>145</sup> Without the government's say in determining which ideas are acceptable, people should be able to “bid[ ] for the minds of men in the market place [sic] of ideas”<sup>146</sup> and to let that marketplace sort out which ideas are going to be accepted as moral or valuable.

It is worth noting that there are many scholars who argue that obscene speech should not be excluded from First Amendment protection.<sup>147</sup> Excluding obscenity from the area of protected speech on the basis that it is “utterly without redeeming social importance”<sup>148</sup> impermissibly allows the government to make value judgments on people's thoughts.<sup>149</sup> Additionally, just as the PTO has struggled to determine what is “immoral or scandalous,” the Court, too, has “struggled to define what is ‘obscene.’”<sup>150</sup> Justice Potter Stewart, for example, had stated that the Court was “faced with the task of trying to define what may be indefinable.”<sup>151</sup> He then declared, “I shall not today attempt further to define [it] . . . and perhaps I could never succeed in intelligibly doing so. But I know it when I see it, and [this] motion picture . . . is not that.”<sup>152</sup> Due to such difficulty in coming up with a workable definition, some scholars argue that obscenity should not be a category of unprotected speech.<sup>153</sup> Nonetheless, as long as obscene speech remains unprotected under

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142. Eran Asoulin, *Language as an Instrument of Thought*, GLOSSA (Nov. 16, 2016), [https://www.glossa-journal.org/articles/10.5334/gjgl.34/\[https://perma.cc/NZ7T-PV6J\]](https://www.glossa-journal.org/articles/10.5334/gjgl.34/[https://perma.cc/NZ7T-PV6J]).

143. See *Brunetti*, 139 S. Ct. at 2318 (Sotomayor, J., concurring in part and dissenting in part).

144. *Cohen*, 403 U.S. at 26.

145. *Id.* at 25.

146. *United States v. Rumely*, 345 U.S. 41, 56 (1953) (Douglas, J., concurring).

147. See ERWIN CHEMERINSKY, *CONSTITUTIONAL LAW: PRINCIPLES AND POLICIES* 1110 (6th ed. 2019).

148. *Roth v. United States*, 354 U.S. 476, 484 (1957).

149. See CHEMERINSKY, *supra* note 147, at 1308.

150. *Id.* at 1067.

151. *Jacobellis v. Ohio*, 378 U.S. 184, 197 (1964) (Stewart J., concurring).

152. *Id.*

153. See CHEMERINSKY, *supra* note 147, at 1112.

the First Amendment, the Court must continue to attempt to draw the line between what is obscene and what is not.

As the categories of today's speeches often overlap and thus are not mutually exclusive of one another, this Note agrees with Justice Breyer that the Court should take a more flexible proportionality approach—instead of the strict categorical approach—when reviewing the constitutionality of speech-restricting statutes. He suggested treating the Court's "speech-related categories not as outcome-determinative rules, but instead as rules of thumb" in asking whether the statutory restriction "works speech-related harm that is out of proportion to its justifications."<sup>154</sup> Despite any difficulty in weighing proportions between the speech-related harm and the government's interest, adopting the proportionality analysis may be desirable for future First Amendment cases to allow the Court to conduct review without having to try to squeeze the speech at issue into a particular category. This is especially the case when that speech, considered in its given context, may not fit nicely into one category. For example, "I REALLY DON'T CARE, DO U?" written across the back of a jacket arguably could be viewed as its maker's commercial speech that promotes the brand's theme or campaign. At the same time, it also could be viewed as political speech and even government speech when First Lady, Melania Trump, wears the jacket on a trip to visit detained immigrant children in Texas.<sup>155</sup>

Still, to the extent that this Note agrees with Justice Breyer's proportionality approach, it does not agree with his conclusion. In comparing the weight of the speech-related harm posed by the "immoral or scandalous" prohibition against that of its justifications, Justice Breyer concluded that the latter outweighs the former and therefore the statute does not violate the First Amendment.<sup>156</sup> He argued that the speech-related harm here was "[n]ot much," since the provision does not completely shut down the speech but merely denies certain benefits; businesses are free to continue using their marks, even when denied trademark registration.<sup>157</sup> By contrast, the government may have interests in preventing "creation of public spaces that many will find repellant" and "protecting the sensibilities of children."<sup>158</sup> However, those interests do not seem justified when considering both the

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154. *Iancu v. Brunetti*, 139 S. Ct. 2294, 2304–05 (2019) (Breyer, J., concurring in part and dissenting in part) (quoting *United States v. Alvarez*, 567 U.S. 709, 730 (2012)).

155. See Katie Rogers, *Melania Trump Wore a Jacket Saying 'I Really Don't Care' on Her Way to Texas Shelters*, NY TIMES (Jun. 21, 2018), <https://www.nytimes.com/2018/06/21/us/politics/melania-trump-jacket.html>.

156. *Brunetti*, 139 S. Ct. at 2305–06.

157. *Id.* at 2306.

158. *Id.* at 2307.

government's record of inconsistency in reviewing similarly offensive marks and the lack of such interests in other government registration systems, e.g., for copyright and patent. By contrast, there are substantial speech-related harms caused by the trademark prohibition, e.g., restriction on freedom of speech and unequal treatment of trademark applicants. Therefore, even under Justice Breyer's proportionality approach, the "immoral or scandalous" prohibition is still unconstitutional, and thus invalid.

Hence, leaving the trademark regulation to consumers prevents the government from discriminating against those who use offensive words to express their thoughts and identities. As the opinions of both the majority in *Matal v. Tam* and Justice Breyer in *Iancu v. Brunetti* indicate, trademarks have "an expressive component in addition to a commercial one . . ." <sup>159</sup> Eliminating such discrimination places offensive words on the same legal ground as inoffensive words, allowing consumers to associate more freely and easily with certain marks and expressions of ideas.

The decision to cease the "immoral or scandalous" ban also recognizes the reality that people may use offensive marks to pursue more than mere financial values. Justice Breyer argued that swear words are "attention-grabbing words . . . financially valuable to some businesses that seek to attract interest in their products."<sup>160</sup> What he may have overlooked, however, is that those who use potentially offensive words, especially in commerce, may be doing so with the full awareness that such usage comes with risks—that the public attention they are about to receive by cursing may not be so financially beneficial. When a clothing brand chooses FCUK as its name, for instance, it has embraced "the risqué element, the apparent avoidance through mis-ordering, the in-your-face-ness of *fuck*, which they appear to sidestep but in fact highlight."<sup>161</sup> The government should stand clear of mark owners' path to the market and their right to express their ideas and identities in the form of trademarks. The true value in using an offensive mark, then, will be determined by consumers who will see and react to it.

## 2. *Predictability and Equal Treatment in the Trademark Registration Process*

The Court's invalidation of the "immoral or scandalous" prohibition also promotes both predictability of rules and equal treatment of applicants in the government's trademark registration system. In support of denying FUCT's trademark registration, the dissents argued that the government has an interest

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159. *Id.* at 2305.

160. *Id.* at 2307.

161. Cato Institute, *supra* note 139, at 13 (quoting RUTH WAJNRYB, EXPLETIVE DELETED: A GOOD LOOK AT BAD LANGUAGE 187 (2005)).

in not being “associated with” highly vulgar and offensive words and in seeking to “disincentivize the use” of such words.<sup>162</sup> Justice Breyer pondered, “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.”<sup>163</sup> Nevertheless, as the above REDSKINS example illustrates, the government has undercut such claimed interest by approving trademark registration for words like REDSKINS. The Washington football fans wearing jerseys and waving flags emblazoned with the REDSKINS trademark are precisely what Native Americans and their children have been seeing for the last half a century. From the public’s perspective, it may be difficult to discern the justification for the government’s interest when that interest has been clouded by the government’s inconsistent treatment of potentially offensive marks.

It may be true, as Chief Justice Roberts asserted, that the government is not required “to give aid and comfort” to those using profane or vulgar words.<sup>164</sup> However, a problem arises when the government gives aid and comfort to some but not others who use words that “do look remarkably similar.”<sup>165</sup> For example, when the government approves BITCH but rejects KICKABITCH, the government cannot be said to be pursuing its interest in disincentivizing the use of vulgar words; rather, it is arbitrarily discriminating between two similarly vulgar words.

Indeed, in the eyes of trademark applicants who seek statutory benefits and rightfully expect equal review of their marks in the registration process, the government’s determination at the end of that process has been as unpredictable as a “flip of a coin.”<sup>166</sup> Even if what trademark registration provides is “merely . . . certain additional benefits,” the government should give those benefits equally to mark owners and let them compete fairly—against one another and also against counterfeiters.<sup>167</sup> In furtherance of the purpose of trademark law, the government’s job is to armor trademark owners—including owners of FCUK and FUCT alike—with those statutory benefits and enable them to fight off confusing and deceptive knockoffs more effectively. By treating all words equally, regardless of their offensiveness or vulgarity, the government would strengthen its stance that its act of “registration does not constitute approval of a mark.”<sup>168</sup> In sum, the government’s equal treatment of marks in its trademark registration process

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162. *See Brunetti*, 139 S. Ct. at 2307.

163. *Id.*

164. *Id.* at 2303–04 (Roberts, C.J., concurring in part and dissenting in part).

165. Transcript of Oral Argument, *supra* note 15, at 19.

166. *Id.* at 21.

167. *Brunetti*, 139 S. Ct. at 2303.

168. *Matal v. Tam*, 137 S. Ct. 1744, 1759 (2017).

would put trademark applicants on clearer notice of what is registrable and allow trademark owners to compete fairly with one another and against counterfeiters.

### 3. *Adherence to Trademark Law's Intended Purpose*

Lastly, leaving the task of regulating trademark morality to consumers allows trademark law to better adhere to its original purpose. The purpose of trademark law is to help consumers identify desired goods quickly and accurately by reducing any confusion or deception in their commercial transactions. Considering offensiveness or scandalousness of certain marks, and denying registration on such grounds, interfere with the goal of reducing trademark confusion and deception. By refusing to register FUCT, the government undermines the strength of trademark law in helping to sort out counterfeit sellers, whose products are designed to confuse and deceive consumers.

In similar registration systems such as those for copyright and patent, the government does not regulate morality as it is not relevant to the purpose of the underlying laws, i.e., to “promote the Progress of Science and useful Arts.”<sup>169</sup> Consequently, the general public is left to evaluate the morality of copyrighted or patented works and to make subsequent determinations on its own. Although trademark law is inherently different from copyright and patent laws in that the former is rooted in the Commerce Clause, regulating morality is still not part of the purpose of trademark law. Unless and until the government can provide a legitimate justification for its interest in regulating morality in trademarked words but not in copyrighted works or patented inventions, it remains questionable as to why only trademark law should diverge from its intended purpose to regulate morality.

In particular, unlike in trademark law, the government does not impose any ban on registering offensive or shocking materials under copyright or patent laws. For example, Erik Brunetti was able to obtain copyright registration for his book, titled *FUCT*, which features on its front cover a hat with the FUCT logo (see Figure 2).<sup>170</sup> Moreover, it is not difficult for the general public to find books with even more blunt titles: *On Bullshit* (2005), *Shit My Dad Says* (2009), and *Go the Fuck to Sleep* (2011), are some of the copyright-protected books that are on the *New York Times* best-seller list.<sup>171</sup> Similarly, three top songs on the *Billboard* chart in March 2011 were “Fuck You!”

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169. U.S. Const., Art. I, § 8, cl. 8.

170. U.S. Copyright No. TX0008351677 (issued July 6, 2016).

171. Cato Institute, *supra* note 139, at 18 (quoting MELISSA MOHR, *HOLY SH\*T: A BRIEF HISTORY OF SWEARING* 247 (2013)).

“Tonight (I’m Fucking You),” and “Fuckin’ Perfect.”<sup>172</sup> Then there is “Real N\*\*\*\* Roll Call,” which is not only registered with the U.S. Copyright Office<sup>173</sup> but also a winner of the Guinness World Record for having the most swear words in one song—295 to be exact.<sup>174</sup>

Figure 2: Front Cover of the Book *FUCT* by Erik Brunetti



172. *Id.* (quoting MOHR, *supra* note 171, at 246).

173. U.S. Copyright No. V3529D821 (issued Oct. 28, 2005) (censorship added).

174. Kate Hutchinson, *The List: A Brief History of Swearing in Music*, REDBULL (July 22, 2013), <https://www.redbull.com/int-en/a-brief-history-of-swearing-in-music>.

The government would not deny copyright registration for a song entitled “BITCH” while approving one entitled “KICKABITCH,” and thus any interest it asserts to vest in making such a distinction between vulgar words in trademark law does not hold much water. Moreover, that copyright and trademark laws exist to serve different purposes, e.g., that prohibiting curse words in copyrightable works may work against promoting creativity, still does not save the government’s justification. In practice, the general public—including children whom the government claims to seek to “protect” from exposure to offensive trademarks—is not likely to appreciate the different purposes that copyright law and trademark law serves when it sees a shirt and a book emblazoned with the same FUCT logo. Indeed, the public’s inability to see such distinction is underscored by the fact that copyrighted works and trademarked words overlap today.

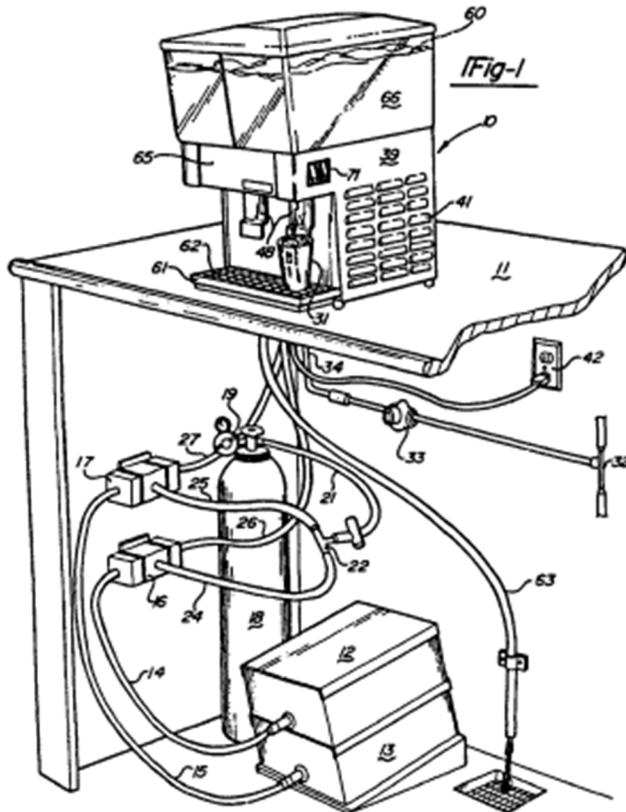
Likewise, the government does not regulate fraud in patent registration, a criterion that carries little relevance to the underlying purpose of patent law. Consider the invention shown below in Figure 3: a juice dispensing system that *appears* to blend fresh juice in a mixer on top but actually dispenses its juice from a tank hidden underneath.<sup>175</sup> The Federal Circuit affirmed the validity of this invention’s patent registration on the grounds that this invention, although imitating freshness to defraud the public, still had *utility* within the meaning of the patent statute.<sup>176</sup> As the PTO does not regulate fraud in patent registrations, the public is left to evaluate that factor on its own. Similarly, leaving it up to the public to evaluate scandalousness or offensiveness in trademarks would allow trademark law to better adhere to its intended purpose and not diverge away from that purpose.

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175. See *Juicy Whip, Inc. v. Orange Bang, Inc.*, 185 F.3d 1364 (Fed. Cir. 1999).

176. *Id.*; see also 35 U.S.C. § 101 (2012) (“Whoever invents or discovers any new and *useful* process, machine, manufacture, or composition of matter, or any new and *useful improvement* thereof, may obtain a patent therefor . . . .”) (emphasis added).

Figure 3: U.S. Patent No. 5,575,405



These examples also weaken the *Brunetti* dissents' argument in support of refusing registration of marks like FUCT on the ground that the government has "a reasonable interest" in ensuring that it is not involved in "promoting highly vulgar or obscene speech, and that it [is not] associated with such speech."<sup>177</sup> Although the dissents conceded that trademarks are private speech and not government speech," they contended that, when the government registers a mark, it is "necessarily 'involv[ed] in promoting' that mark";<sup>178</sup> upon registering a mark, the government is required to publish the mark "as well as to take steps to combat international infringement."<sup>179</sup> However, that interest is not reasonable as it clashes with the fact that the government regularly registers copyrights in creative works that are obscene, vulgar, or profane.

177. *Iancu v. Brunetti*, 139 S. Ct. 2294, 2307 (2019) (Roberts, C.J., concurring in part and dissenting in part).

178. *Id.* at 2307 (quoting Sotomayor, J., *Brunetti*, 139 S. Ct. at 2317–18 (concurring in part and dissenting in part)).

179. *Id.* at 2317 (Sotomayor, J., concurring in part and dissenting in part).

Furthermore, the government should not worry about being perceived as supporting trademarks it registers, since the Court in *Matal v. Tam* has already assured that there is no evidence that the public “associates the contents of trademarks with the Federal Government.”<sup>180</sup> If there were any evidence of such association, there seems to be no reason the same public should think differently about copyrighted works and patented inventions that the government also registers. Under that scenario, the government’s concern then should not be uniquely focused on trademark registration. Thus, denying trademark registration—on the basis that the government has an interest in not promoting certain kinds of speech—not only undermines the immediate trademark registration system, but also constitutes “a huge and dangerous extension” of such restriction as “other systems of government registration could easily be characterized in the same way.”<sup>181</sup>

No government-created test can substitute, let alone outperform, consumers’ own moral standards. Just as it is up to the general public to evaluate the morality of uncensored explicit songs and deceptive juice dispensers, it should be up to the same general public to evaluate the morality of offensive brand names. That way, trademark morality can be more effectively and efficiently tested, and the government can avoid regulating beyond the realm originally intended for trademark law.

## V. CONCLUSION

The majority in *Iancu v. Brunetti* made the right decision in invalidating the “immoral or scandalous” provision of the Lanham Act, and in deciding not to apply a narrowing construction to the “scandalous” prong. Accordingly, Congress should not reintroduce questions of “scandalousness” by rewriting the statute. Instead, it should leave the task of sorting out such matters to consumers who have been the de facto regulators of trademark morality thus far.

The government does not need to worry when entrusting consumers with this task, since consumers are well-equipped with their power to purchase products bearing trademarks they favor as well as the power to boycott products bearing trademarks they find highly offensive or scandalous. A government restriction on “immoral or scandalous” marks has not determined the ultimate fate and success of trademarks in the marketplace, and no new replacement statute will.

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180. *Matal v. Tam*, 137 S. Ct. 1744, 1759–60 (2017).

181. *Id.* at 1760; see *Brunetti*, 139 S. Ct. at 2317.

Congress nevertheless may be triggered to replace the statute if, and as Justice Sotomayor predicts, people seek to take advantage of the *Iancu v. Brunetti* decision and flood the PTO with trademark applications for the “most viscerally offensive words” possible.<sup>182</sup> Nonetheless, empirical evidence has proved otherwise. A study that focused on the change in the volume of trademark registration applications for such words following the *In re Brunetti* decision (that the Supreme Court subsequently affirmed in *Iancu v. Brunetti*) indicates “a future not much altered, despite early concerns to the contrary.”<sup>183</sup> The absence of “a flood behind the anticipated floodgates” may suggest that the actual commercial value of highly offensive words is not as substantial as may have been expected.<sup>184</sup> Provided that this trend in volume follows the *Iancu v. Brunetti* decision, it may alleviate the concern for commercial abuse of curse words as mere attention-grabbing modes of expression.

Regardless of any effects felt at the PTO, the *Iancu v. Brunetti* decision was an important move for upholding First Amendment values in free speech, for promoting equal treatment of trademark applicants, and for bringing trademark law closer to its intended purpose. More importantly, the decision has allowed people to flaunt the scarlet letters of their choice as registered trademarks, and it is up to consumers to decide whether those letters are unworthy of acceptance in the marketplace. With the PTO out of the picture, consumers now stand as the sole regulators of trademark morality—and should remain so.

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182. *See Brunetti*, 139 S. Ct. at 2318 (Sotomayor, J., concurring in part and dissenting in part).

183. Vicenc Feliu, *The F Word – An Early Empirical Study of Trademark Registration of Scandalous and Immoral Marks in the Aftermath of the In re Brunetti Decision*, 18 JOHN MARSHALL REV. INTELL. PROP. L. 404, 404 (2019).

184. *Id.* at 418.

