



# THINK FORWARD

## In re Brunetti: Toppling the Bar on Bad Words

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On December 15, 2017, the United States Court of Appeals for the Federal Circuit issued a unanimous ruling declaring unconstitutional Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), which prohibits the registration of “immoral” or “scandalous” trademarks.

### Brief Background

Mr. Erik Brunetti sought to register the word mark “FUCT,” in connection with clothing. The examining attorney at the United States Patent and Trademark Office (“USPTO”) refused registration under Section 2(a) of the Lanham Act, on the basis that the mark was vulgar, and therefore “immoral” or “scandalous.” The Trademark Trial and Appeal Board (“TTAB”) upheld the examining attorney’s decision on appeal. Mr. Brunetti then appealed the TTAB’s decision to the Federal Circuit. The Federal Circuit requested additional briefing from the parties following the Supreme Court’s decision in *Matal v. Tam*, 137 S.Ct. 1744 (2017), which held that Section 2(a)’s prohibition on registering “disparaging” trademarks is unconstitutional under the First Amendment.

### Decision

The Federal Circuit reversed the TTAB’s decision. In support, the Federal Circuit relied heavily on Anne Gilson LaLonde and Jerome Gilson’s *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*, 101 Trademark Rep. 1476 (2011).

The Federal Circuit first concluded that substantial evidence supported the TTAB’s finding that the “FUCT” mark was vulgar, and therefore not registrable under Section 2(a). However, the Court held that Section 2(a)’s bar on registering immoral or scandalous marks is unconstitutional under the First Amendment, as an improper content-based restriction on free speech.

The Court held that Section 2(a)’s immorality and scandalousness provision regulates the expressive speech components of a trademark, such that the constitutionality of the provision is subject to strict scrutiny. The Court found that under the strict scrutiny standard “[t]here is no dispute that Section 2(a)’s bar on the registration of immoral and scandalous marks is unconstitutional.” Further, the Court found that Section 2(a)’s bar on immoral and scandalous marks was unconstitutional, even if it was treated as a regulation of purely commercial speech under an intermediate scrutiny framework. The Court found that “the government does not have a substantial interest in protecting the public from scandalousness and profanities,” among other things.

### Effect of the Decision

As of this writing, the government has not filed a writ of certiorari to appeal the Federal Circuit's decision. The Court's decision in this case likely will lead to an increase in the number of trademark registration applications before the USPTO that would have previously been rejected on the basis of vulgarity, scandalousness, or other standards of morality.

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