

## Ban On 'Scandalous' TMs Is Probably Dead For Good

By **Bill Donahue**

Law360 (September 18, 2018, 7:40 PM EDT) -- Will the U.S. Supreme Court revive a federal ban on the registration of profane trademarks like "Fuct," less than two years after it categorically struck down a similar rule used against the Washington Redskins? Not f\*\*\*king likely, experts say.

**Earlier this month**, the U.S. Patent and Trademark Office asked the justices to overturn a **December ruling** by the Federal Circuit that the Lanham Act's ban on "immoral or scandalous" material violated the First Amendment. The Constitution, the USPTO said, should not require the agency to "affirmatively promote the use of graphic sexual images and vulgar terms."

The petition for a writ of certiorari was something of a surprise. After all, those same justices **ruled just last summer** that a closely-related provision barring the registration of "disparaging" trademarks — **words like "Redskins"** — was unconstitutional on similar free speech grounds.

That provision, the high court wrote at the time, "offends a bedrock First Amendment principle" that "speech may not be banned on the ground that it expresses ideas that offend."


Six months later, ruling in favor of a man named Erik Brunetti who had been refused a trademark registration on the term "Fuct," the Federal Circuit similarly struck down the "scandalous" rule, citing the high court's decision.

According to the petition filed this month, USPTO believes there's enough of a distinction between the "scandalous" rule and the "disparaging" rule for the justices to treat them differently under constitutional scrutiny.

But many court watchers, like veteran First Amendment attorney Floyd Abrams, say the USPTO will face an extreme uphill climb in even getting the justices to tackle the case, let alone winning a ruling in the agency's favor.

"I find it difficult to believe," said Abrams, a partner at Cahill Gordon & Reindel LLP who has worked on a number of landmark free speech cases including the famous Pentagon Papers case. "If anything, empowering a federal agency to enforce a statutory ban embodied in [the word 'scandalous'] seems even more obviously at odds with the First Amendment."

In trying to distinguish the "scandalous" ban from the now-unconstitutional "disparaging" ban, USPTO's primary argument to the high court centers on what type of restriction each provision imposes on speech.

The high court's June 2017 ruling in **Matal v. Tam**  identified the "disparaging" ban as a form of "viewpoint discrimination" — a type of restraint on particular views that courts have found particularly problematic under the First Amendment. Justice Samuel Alito, penning the court's main opinion, wrote that "giving offense is a viewpoint."

Despite that language, the USPTO says the "scandalous" rule is instead a "viewpoint-neutral" restriction — meaning it doesn't cause the same kind of heightened free-speech concerns.

"By prohibiting the registration of such terms by all commercial actors, the scandalous-marks provision does not affect expression on only one side of an otherwise includible subject," the agency wrote. "Nor is the motivating ideology or the opinion or perspective of the speaker the rationale for the limitation."

Such viewpoint-neutral restrictions on federal registration, USPTO says, "are a long standing feature of federal trademark law," and are justified because the government does not want to provide benefits or

other resources to support offensive language or imagery.

While the two provisions are certainly not identical, some experts don't quite see "viewpoint" distinction the way USPTO does.

According to Rebecca Tushnet, a professor at Harvard Law School who focuses on the First Amendment and trademark law, the ban on "scandalous" marks raises even more constitutional concerns than the "disparaging" ban, not less.

"Unlike 'disparagement,' which protected all groups equally from disparagement, 'scandalousness' protects the majority against the opinions or moral toleration of the minority," Tushnet said. "That is definitely viewpoint-based."

The "scandalous" provision is also vaguer and broader than the provision struck down by the court, according to Abrams. Whereas it was "reasonably clear" what trademarks would be refused registration under the "disparaging" provision, Abrams says the restrictions imposed by the "scandalous" rule depend on "one's subjective judgment as to matters of propriety, taste and the like."

"One person's notion of what is scandalous would be laughable to another," Abrams said. "Indeed, the very word 'scandalous' has faded from common use precisely because there so little common understanding of just what it now conveys, as opposed to what it may have meant in Jane Austen's days."

That kind of skepticism about the USPTO's argument is not limited to First Amendment lawyers. The sentiment is also echoed by some trademark lawyers, who question whether the justices would really see much difference between two related morality bans that both seem out of place in the Lanham Act.

"What the trademark law is intended to do is to ensure that consumers are not deceived as to the source of products and services," said Susan Neuberger Weller, the head of the trademark practice at the firm of Mintz Levin Cohn Ferris Glovsky and Popeo PC. "Letting the trademark office go beyond that determination to decide immorality is going beyond what their job is supposed to be under the purpose of the trademark law."

A response to the USPTO's petition from the "Fuct" applicant, Brunetti, is due by Oct. 9.

Brunetti is represented by John R. Sommer.

The government is represented by USPTO attorneys Joseph Matal, Thomas L. Casagrande, Christina Hieber, Molly R. Silfen and Mary Beth Walker and by Noel J. Francisco, Joseph H. Hunt, Malcolm L. Steward, Jonathan Y. Ellis, Mark R. Freeman, Joshua Marc Salzman and Daniel Tenny of the U.S. Department of Justice.

The case is *Iancu v. Brunetti*, case number 18-302, at the Supreme Court of the United States.

--Editing by Alanna Weissman.