

SUPREME COURT INVALIDATES BAN ON “IMMORAL” OR “SCANDALOUS” TRADEMARKS

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On Monday, June 24, 2019 in a 6-3 decision, the Supreme Court of the United States struck down the Lanham Act provision that prohibited the registration of “immoral” or “scandalous” ideas. *Iancu v. Brunetti* began when the United States Patent and Trademark Office (USPTO) refused the apparel mark “FUCTION,” determining that it was “too vulgar.” In its decision this week, the Supreme Court decided that the Lanham Act provision violated the right to freedom of speech guaranteed by the First Amendment.

“The most fundamental principle of free speech law is that the government can’t penalize or disfavor or discriminate against expression based on the ideas or viewpoints it conveys,” Justice Elena Kagan said in announcing the decision. Kagan was joined in the majority by Justices Clarence Thomas, Ruth Bader Ginsburg, Samuel A. Alito Jr., Neil M. Gorsuch, and Brett M. Kavanaugh.

“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,” Justice Kagan wrote. “The [US]PTO has refused to register marks communicating ‘immoral’ or ‘scandalous’ views about (among other things) drug use, religion, and terrorism. But all the while, it has approved registration of marks expressing more accepted views on the same topics.”

Registration of a trademark is not required to use the mark. In this case, for example, Brunetti had been using “FUCTION” for his clothing line since 1990; however, registration with the USPTO can bring great value to a product or brand. A trademark registration can serve as *prima facie* evidence when proving the mark’s validity. Registration also constitutes a notice of ownership, and provides the ability to sue in federal court along with the possibility of various statutory damages. This Supreme Court ruling broadens the scope of acceptable subject matter for trademark registrations and provides the opportunity for entities to bring greater value to their businesses based on such marks that previously may have been seen as “immoral” or “scandalous.”

In light of this Supreme Court decision, Tucker Ellis recommends re-evaluating client trademark portfolios and product/service lines since federal protection will be available to new types of marks. Additionally, if a pending mark application is rejected for being “immoral” or “scandalous,” Tucker Ellis recommends waiting for the USPTO to issue a new office action or contacting the examiner of record for the matter. Clients should also be aware that, as a result of this decision, the USPTO will likely see an uptick in trademark applications filed, which, in turn, will lengthen the typical timeline for trademark application approvals.

ADDITIONAL INFORMATION

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