

# The Trademark Reporter®



**The Law Journal of the International Trademark Association**

Cultural Misappropriation: What Should the United States Do?

*Lauren M. Ingram*

The Lanham Act's Immoral or Scandalous Provision: Down, but Not Out

*Michael Stephenson*

Book Review: *Likelihood of Confusion in Trademark Law*. Richard L. Kirkpatrick.

*Raffi Zerounian*

# INTERNATIONAL TRADEMARK ASSOCIATION

*Powerful Network Powerful Brands*

675 Third Avenue, New York, NY 10017-5704

Telephone: +1 (212) 642-1700

email: [wknnox@inta.org](mailto:wknnox@inta.org)

## OFFICERS OF THE ASSOCIATION

TIKI DARE .....	<i>President</i>
ZEEGER VINK.....	<i>President-Elect</i>
JOMARIE FREDERICKS.....	<i>Vice President</i>
DANA NORTHCOTT .....	<i>Vice President</i>
ELISABETH BRADLEY.....	<i>Treasurer</i>
DEBORAH HAMPTON .....	<i>Secretary</i>
ERIN HENNESSY .....	<i>Counsel</i>
ETIENNE SANZ DE ACEDO .....	<i>Chief Executive Officer</i>

## *The Trademark Reporter* Committee

### EDITORIAL BOARD

#### EDITOR-IN-CHIEF, CHAIR

GLENN MITCHELL

#### STAFF EDITOR-IN-CHIEF

WILLARD KNOX

#### Senior Editors

RAFFI V. ZEROUNIAN

PAMELA S. CHESTEK  
FABRIZIO MIAZZETTO  
BRYAN K. WHEELock

ANDREW J. GRAY  
KAREN ELBURG  
LESLEY GROSSBERG

VERENA VON BOMHARD

#### Director of Legal Resources

LIZ HANELLIN

#### Senior Staff Editor

BEVERLY HARRIS

#### Staff Editor

ELIZABETH VENTURO

#### Senior Legal Editor

ROSEMARY DESTEFANO

#### Composer

BARBARA MOTTER

#### Editors

GAIL NEVIUS ABBAS  
THOMAS AGNELLO  
EUGENY ALEXANDROV  
TARA ALLSTUN  
CHARLENE AZEMA  
DANIEL BERESKIN  
SUBHASH BHUTORIA  
JULIAN BIBB  
STEPHANIE BUNTIN  
ROBERT CAMERON  
JEANNETTE CARMADILLA  
JACQUELINE CHORN  
THEODORE H. DAVIS JR.  
MICHAEL DENNISTON  
CATHERINE ESCOBEDO  
DÉSIRÉE FIELDS  
ALEXANDRA GEORGE  
STUART GREEN

STACY GROSSMAN  
JORDI GÜELL  
MICHAEL HANDLER  
NATHAN HARRIS  
BARRY HORWITZ  
GANG HU  
BRUCE ISAACSON  
SIEGRUN KANE  
INGRIDA KARINA-BERZINA  
ELISABETH KASZNAR FEKETE  
SONIA KATYAL  
LINDSAY KOROTKIN  
SCOTT LEBSON  
SONAL MADAN  
J. DAVID MAYBERRY  
BRYCE MAYNARD  
JAMES MCALLISTER  
J. THOMAS MCCARTHY  
CATHERINE MITROS

SHANA OLSON  
R. TERRY PARKER  
LUIS HENRIQUE PORANGABA  
YASHVARDHAN RANA  
BRANDON RESS  
RICHARD RIVERA  
SUSAN RUSSELL  
FLORIAN SCHWAB  
TOM SCOURFIELD  
RINITA SIRCAR  
GIULIO ENRICO SIRONI  
RANDY SPRINGER  
CORY STRUBLE  
MARTIN VIEFHUES  
JEFFREY WAKOLBINGER  
RITA WEEKS  
JOHN L. WELCH  
MARTIN WIRTZ

#### Advisory Board

MILES ALEXANDER  
WILLIAM BORCHARD  
LANNING BRYER  
JESSICA CARDON  
SANDRA EDELMAN  
ANTHONY FLETCHER

ROBERT KUNSTADT  
THEODORE MAX  
KATHLEEN MCCARTHY  
JONATHAN MOSKIN  
VINCENT PALLADINO  
JOHN PEGRAM  
ROBERT RASKOPF

PASQUALE RAZZANO  
SUSAN REISS  
PIER LUIGI RONCAGLIA  
HOWARD SHIRE  
JERRE SWANN, SR.  
STEVEN WEINBERG

The views expressed in *The Trademark Reporter* (TMR) do not necessarily reflect those of the International Trademark Association (INTA). To fulfill its mission of delivering cutting-edge scholarship on trademarks, brands, and related intellectual property to its readers, the TMR sources content reflecting a diversity of viewpoints; the views expressed in any given article, commentary, or book review are those of the individual authors.

The TMR (ISSN 0041-056X) is published electronically six times a year by INTA, 675 Third Avenue, New York, NY 10017-5704 USA. INTA, the INTA logo, INTERNATIONAL TRADEMARK ASSOCIATION, POWERFUL NETWORK POWERFUL BRANDS, THE TRADEMARK REPORTER, and [inta.org](http://inta.org) are trademarks, service marks, and/or registered trademarks of the International Trademark Association in the United States and certain other jurisdictions.

# The Trademark Reporter®

## EDITOR'S NOTE

As our readers are aware, the International Trademark Association (INTA) annually presents the Ladas Memorial Award to outstanding papers in the field of trademark law or on matters that directly relate to or affect trademarks. The award is presented in two categories—with two Student<sup>1</sup> winners and one Professional winner. Many members of *The Trademark Reporter* (TMR) Committee volunteer to serve as judges for the Ladas Memorial Award Competition. I look forward to the opportunity each year to review papers presenting cutting-edge scholarship, often expanding the scope of debate, as well as seeing what our future colleagues are thinking and writing.

In this issue, we are proud to publish both winning 2021 Student papers: “Cultural Misappropriation: What Should the United States Do?” by Lauren M. Ingram, and “The Lanham Act’s Immoral or Scandalous Provision: Down, but Not Out” by Michael Stephenson.

In “Cultural Misappropriation,” Ms. Ingram, who graduated in 2021 with a L.L.M. from American University Washington College of Law (and is now in private practice), addresses the current debate on cultural misappropriation, generally understood to be the aping or commodification of some unique cultural aspect of a marginalized community by members of the dominant culture, without consent or against the will of the original community. There are currently few legal frameworks on which marginalized cultures can rely to protect against such misappropriation, particularly in the United States, nor is there a consensus on what constitutes cultural misappropriation. Ms. Ingram surveys legal structures, including trademark law, around the world, and considers whether such structures provide effective protection. After considering the laws of other countries, including Tunisia, the Philippines, and Panama, she concludes by proposing the creation of a *sui generis* right that can be exercised by indigenous and other marginalized communities.

---

<sup>1</sup> INTA defines the “Student” category as meaning those in the United States who are “enrolled as either full- or part-time law or graduate students.” For international students, “university enrollment is acceptable.” See Ladas Memorial Award Competition Rules & Requirements, [https://www.inta.org/wp-content/uploads/public-files/about/awards/2021\\_LADAS\\_FLYER-012521.pdf](https://www.inta.org/wp-content/uploads/public-files/about/awards/2021_LADAS_FLYER-012521.pdf).

Michael Stephenson, a 2021 graduate of the University of Pittsburgh School of Law (and now in private practice), considers the potential for a “Wild West” of obscene, profane, and vulgar trademarks used and registered in the United States following the Supreme Court’s decisions in *Matal v. Tam* and *Iancu v. Brunetti*, which struck down, on First Amendment freedom of speech grounds, first the disparagement clause and then the prohibition on registration of immoral or scandalous marks in Section 2(a) of the Lanham Act. Mr. Stephenson argues there is a place for Congress to reinstate a bar to registration of certain categories of marks that reflect a presumed consensus as to immorality or scandalousness. Mr. Stephenson’s argument relies on the dissenting opinions in *Iancu*; he also surveys modern First Amendment jurisprudence, positing that, as there are exceptions to an absolute Constitutional free speech right, such categories may provide a road map for specifying non-registrable marks, supporting both the government’s interest in not being involved in protection of unseemly trademarks, as well as a greater degree of certainty as to what marks will or will not qualify as scandalous or immoral. Mr. Stephenson argues that the categories selected can be considered in a value-neutral fashion.

Both articles address topics as to which there is a wide range of viewpoints and will undoubtedly spur further debate on how to treat these increasingly prominent topics in trademark law. The TMR is honored to be able to publish these pieces for the benefit and edification of our members and others interested in these topics. N.B.: While both pieces have been lightly edited, largely for conformance to TMR’s style requirements, we have endeavored to leave the articles in a form close to that reviewed by the Ladas judges.

The TMR Committee congratulates this year’s Student Ladas Memorial Award winners. We think that after you read the winning pieces you will agree that the future of trademark jurisprudence is bright.

Glenn Mitchell  
*Editor-in-Chief*  
*Chair, The Trademark Reporter Committee*

---

**THE LANHAM ACT'S IMMORAL OR  
SCANDALOUS PROVISION:  
DOWN, BUT NOT OUT**

*By Michael Stephenson\**

**Table of Contents**

I.	Introduction .....	878
II.	The Lanham Act and Its Problematic Provisions .....	880
A.	A Brief History.....	880
B.	The Clash Between the Lanham Act and the First Amendment.....	882
1.	Strike One: <i>Matal v. Tam</i> .....	882
2.	Strike Two: <i>Iancu v. Brunetti</i> .....	883
3.	Aftermath of <i>Brunetti</i> .....	886
III.	The First Amendment and Regulated Speech .....	886
A.	The Free Speech Clause .....	886
B.	First Amendment Exceptions .....	888
1.	Obscenity.....	889
2.	Profanity.....	889
3.	Terrorism.....	891
4.	Drug Use .....	892
IV.	Saving the Lanham Act.....	893
A.	A New Framework.....	893
B.	Category-Specific Tests .....	894
V.	Conclusion.....	897

---

\* Winner, 2021 Ladas Memorial Award, Student Category. Associate, Buchanan, Ingersoll & Rooney PC. J.D., University of Pittsburgh School of Law (2021).

## I. INTRODUCTION

The United States Trademark Act, known as the “Lanham Act,” defines trademarks as “any word, name, symbol, or device, or any combination thereof used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others.”<sup>1</sup> They can range from the logos and symbols of global brands, like APPLE, COKE, GOOGLE, and MICROSOFT, to the names of local stores that line the streets of Small-town, USA. Nevertheless, it seems as though trademarks are everywhere, and for good reason. After all, if used effectively, trademarks can serve as an efficient communication tool for businesses, as they possess the ability to instantly convey persuasive, emotional messages about a mark’s associated products or services. Accordingly, trademark owners often spend a lot of time and money to ensure that the messages attached to their mark are positive ones and that their marks reach as many consumer eyes as possible.

Much like the Federal Communications Commission (“FCC”) regulates communications by radio, television, and other broadcast media that have the ability to reach a large audience, the United States Patent and Trademark Office (“USPTO”) regulates trademarks and determines whether trademark applicants meet the statutory requirements, set forth by the Lanham Act, for federal registration.<sup>2</sup> While the Lanham Act’s primary purpose is to protect trademark owners against infringement and unfair competition, and the public against confusion and inaccurate information,<sup>3</sup> the act contains other provisions that indicate a broader purpose. For example, as the FCC imposes regulations against indecency and obscenity from reaching a large audience,<sup>4</sup> the Lanham Act similarly includes an “immoral”/“scandalous” provision that prohibits registration of marks that “[c]onsist[] of or comprise[] immoral . . . or scandalous matter.”<sup>5</sup> To determine if a mark falls under this provision, the USPTO “asks whether a ‘substantial composite of the general public’ would find the mark ‘shocking to the sense of truth, decency, or propriety’; ‘giving offense to the conscience or moral feelings’; ‘calling out for condemnation’; ‘disgraceful’; ‘offensive’; ‘disreputable’; or ‘vulgar.’”<sup>6</sup> Clearly, in addition to its primary purposes, the Lanham Act also serves to regulate certain content from reaching a mass audience.

---

<sup>1</sup> 15 U.S.C. § 1127 (2018).

<sup>2</sup> See generally Lanham Act, 15 U.S.C. ch. 22.

<sup>3</sup> Chris Cochran, *It’s “FUCTION”: The Demise of the Lanham Act*, 59 IDEA 333, 335 (2019).

<sup>4</sup> See *Obscene, Indecent and Profane Broadcasts*, FCC, <https://www.fcc.gov/consumers/guides/obscene-indecnt-and-profane-broadcasts> (last updated Jan. 13, 2021).

<sup>5</sup> 15 U.S.C. § 1052(a).

<sup>6</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294, 2298 (2019).

For decades, critics have placed the immoral or scandalous provision under a microscope, arguing that it is unconstitutional under the Free Speech Clause of the First Amendment of the U.S. Constitution.<sup>7</sup> Despite this claim, though, the provision held steady within the Lanham Act and had consistently resisted opposition. However, this all changed in 2019 when the Supreme Court finally struck down the immoral or scandalous provision as unconstitutional in *Iancu v. Brunetti*.<sup>8</sup> The Court reasoned that the provision permitted USPTO examiners to exercise “viewpoint discrimination” by either favoring or disfavoring one or more opinions of a particular controversy.<sup>9</sup> Specifically, the Court expressed disapproval in the provision’s overly broad language and in the USPTO’s inconsistency in drawing the line between unregistrable and permissible marks.<sup>10</sup> In the end, the Court was left with no choice but to open the door for immoral and scandalous marks to be federally registered and to receive full federal protection. At the same time, though, the Court seemed to express concerns regarding the possibility of immoral and scandalous marks becoming prevalent in society,<sup>11</sup> and dissenting opinions gave a clear invitation to Congress to fill this newly created void with fresh legislation.<sup>12</sup>

This article argues that it is imperative that the Lanham Act’s immoral or scandalous provision be revitalized in light of the *Brunetti* decision and further proposes a new, narrow, viewpoint-neutral test that will allow for more consistent and predictable results. This new test can replace the USPTO’s old viewpoint-discriminatory standard while also promoting the long-standing goal of barring registration of immoral and scandalous marks. This

---

<sup>7</sup> See, e.g., Megan M. Carpenter & Kathryn T. Murphy, *Calling Bulls\*\*t on the Lanham Act: The 2(a) Bar for Immoral, Scandalous, and Disparaging Marks*, 49 U. Louisville L. Rev. 465 (2011) (arguing that the sole object and purpose of trademark law is to promote fair competition, and that the immoral or scandalous provision “expands . . . well beyond [this] basic goal[]”).

<sup>8</sup> See 139 S. Ct. 2294.

<sup>9</sup> *Id.* at 2299.

<sup>10</sup> *Id.* at 2300.

<sup>11</sup> *Id.* at 2301 (describing the USPTO’s refusal to register certain immoral and scandalous marks as “understandable,” as the “marks express opinions that are, at the least, offensive to many Americans”).

<sup>12</sup> See *id.* at 2303–04 (Roberts, C.J., dissenting) (“The Government . . . has an interest in not associating itself with trademarks whose content is obscene, vulgar or profane. The First Amendment protects the freedom of speech; it does not require the Government to give aid and comfort to those using obscene, vulgar, and profane modes of expression.”); *Id.* at 2307 (Breyer, J., dissenting) (“The Government has at least a reasonable interest in ensuring that it is not involved in promoting highly vulgar or obscene speech, and that it will not be associated with such speech.”); *Id.* at 2317 (Sotomayor, J., dissenting) (“[T]he Government has an interest in not promoting certain kinds of speech, whether because such speech could be perceived as suggesting governmental favoritism or simply because the Government does not wish to involve itself with that kind of speech.”).

article proceeds in three parts. Part I includes a detailed discussion of the Lanham Act, its problematic provisions, and case law that has shaken up the modern trademark landscape. Part II investigates the First Amendment, specifically the ideas of viewpoint discrimination and regulated speech. Finally, Part III will propose a framework for a new constitutionally sound provision to replace the now-invalid immoral or scandalous provision.

## II. THE LANHAM ACT AND ITS PROBLEMATIC PROVISIONS

### A. A Brief History

The first trademark lawsuits arose in the United States in the 1840s, but it was not until decades later in 1870 that Congress first adopted a federal statutory trademark law.<sup>13</sup> This act was short lived, and was eventually replaced by the more narrowly crafted 1881 Trademark Act.<sup>14</sup> The 1881 Act listed only two bars to federal registration: (a) marks that contained the name of a person, and (b) marks that were so similar to previously registered marks as to cause a likelihood of confusion, mistake, or deception for the public.<sup>15</sup>

Almost immediately after the passage of the 1881 Act, amendments were proposed and lobbied for.<sup>16</sup> Eventually, in 1892, the first suggestion of a “scandalous” registration prohibition was made.<sup>17</sup> After more than a decade of debate, in the updated 1905 Trademark Act, Congress included a provision that precluded the registration of any mark that “consists of or comprises immoral or scandalous matter.”<sup>18</sup> Congress then included a similar provision in 1946 with the passage of the Lanham Act, and in 1994, the language of the current provision was adopted: “Consists of or comprises immoral, deceptive, or scandalous matter.”<sup>19</sup>

Though no direct justifications for the immoral and scandalous bars can be found within the aforementioned string of federal trademark acts or their legislative histories, scholars have suggested that the provision was adopted because “the government should not waste its resources on protecting unseemly marks.”<sup>20</sup>

---

<sup>13</sup> See Ross Housewright, *Early Development of American Trademark Law* 3 (2007); Jasmine Abdel-khalik, *To Live in In-“fame”-y: Reconceiving Scandalous Marks as Analogous to Famous Marks*, 25 *Cardozo Arts & Ent. L.J.* 173, 182 (2007).

<sup>14</sup> Abdel-khalik, *supra* note 13, at 183.

<sup>15</sup> *Id.*

<sup>16</sup> *Id.* at 183–84.

<sup>17</sup> *Id.*

<sup>18</sup> *Id.* at 185.

<sup>19</sup> *Id.*

<sup>20</sup> Carpenter & Murphy, *supra* note 7, at 467.



Scholars have also pointed to a number of other justifications for the immoral or scandalous provision, including that “the government ‘should not create the appearance that it favors the use of scandalous [or] immoral marks,’” that the government “should promote . . . public health, welfare, and morals by discouraging” said marks, and that the government “should protect the sensitivities of those in public who might be offended” by said marks.<sup>21</sup> The works of William Henry Browne, a prominent legal scholar of the nineteenth century, seem to support these validations.<sup>22</sup> In his treatise published shortly after the 1881 Act, Browne explained that marks should not “transgress the rules of morality or public policy,” and that marks should not shock the sensibilities of anyone in the world on the basis of moral, religious, or political grounds.<sup>23</sup> So, while there may be a lack of legislative history and straightforward reasoning regarding the inclusion of an immoral or scandalous provision, the above economic and moral justifications are ones that transcend time and remain relevant today.

Evidence also suggests that such a provision is useful to promote the overall well-being of society.<sup>24</sup> For example, scientific research shows that vulgarity and other similar speech leave negative psychological and emotional impacts on their audiences.<sup>25</sup> Because vulgar words stem from a different part of our brains, as opposed to most other words,<sup>26</sup> these types of words are harder to forget and attract more attention than other “normal” words.<sup>27</sup> Further, studies have found that the modern use of profanity is associated with emotions such as sadness and anger, and people usually use this strong language in social settings to excite these emotions in both themselves and others.<sup>28</sup> All in all, this information indicates that there certainly seems to be legitimate and strong interests in keeping immoral and scandalous marks from public view.

---

<sup>21</sup> *Id.* at 468.

<sup>22</sup> Abdel-khalik, *supra* note 13, at 188–95.

<sup>23</sup> *Id.* at 194.

<sup>24</sup> *See generally* Melissa Mohr, *Holy S\*\*T: A Brief History of Swearing* (2013); Timothy Jay, Catherine Caldwell-Harris & Krista King, *Recalling Taboo and Nontaboo Words*, 121 *Am. J. Psychol.* 83 (2008).

<sup>25</sup> *See* Mohr, *supra* note 27, at 252.

<sup>26</sup> *Id.* at 250.

<sup>27</sup> *See* Jay, Caldwell-Harris & King, *supra* note 27, at 83–86.

<sup>28</sup> Katy Steinmetz, *#Cursing Study: 10 Lessons About How We Use Swear Words on Twitter*, *Time* (Feb. 19, 2014), <https://time.com/8760/cursing-study-10-lessons-about-how-we-use-swear-words-on-twitter/>.

### ***B. The Clash Between the Lanham Act and the First Amendment***

Typically, the USPTO has applied the immoral or scandalous provision “as a ‘unitary provision,’ rather than treating the two adjectives . . . separately.”<sup>29</sup> To determine whether a mark fits within this provision, the USPTO “asks whether a ‘substantial composite of the general public’ would find the mark ‘shocking to the sense of truth, decency, or propriety’; ‘giving offense to the conscience or moral feelings’; ‘calling out for condemnation’; ‘disgraceful’; ‘offensive’; ‘disreputable’; or ‘vulgar.’”<sup>30</sup>

However, Congress cannot simply put into place any restriction they so desire, as it must adhere to well-established constitutional limits. At issue within the context of trademarks and the Lanham Act is the First Amendment’s Free Speech Clause.<sup>31</sup> A core idea of free speech is that the government cannot favor or disfavor certain speech based on the ideas or opinions it conveys,<sup>32</sup> also known as “viewpoint discrimination.” Put differently, a statutory provision disfavoring “ideas that offend,” like the immoral or scandalous provision, may not pass constitutional muster, as it permits the USPTO to be selective in the ideas it allows.<sup>33</sup>

For example, two years prior to *Brunetti*, the Supreme Court laid down significant groundwork for the eventual revocation of the Lanham Act’s immoral or scandalous provision under the Free Speech Clause. In *Matal v. Tam*, a 2017 decision, the Court nullified the Lanham Act’s prohibition on “disparaging” trademarks, holding that the provision violated the First Amendment’s Free Speech Clause.<sup>34</sup> Although the disparaging provision is separate and distinct from the immoral or scandalous provision, a dive into *Tam* is worthwhile, as the Court’s analyses in both *Tam* and *Brunetti* follow a similar form.

#### **1. Strike One: *Matal v. Tam***

In 2010, Simon Tam, founder of the Asian American band “The Slants,” applied for trademark protection for the name of his band.<sup>35</sup> The USPTO rejected Tam’s application and reasoned that the likely

<sup>29</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294, 2298 (2019) (quoting *In re Brunetti*, 877 F.3d 1330, 1330 (Fed. Cir. 2017)).

<sup>30</sup> *Id.*

<sup>31</sup> *See generally id.* (explaining that all trademark provisions must survive Free Speech Clause review to be valid).

<sup>32</sup> *See id.* at 2299 (“[A] core postulate of free speech law: The government may not discriminate against speech based on the ideas or opinions it conveys.”).

<sup>33</sup> *Id.* at 2299 (quoting *Matal v. Tam*, 137 S. Ct. 1744 (2017)).

<sup>34</sup> *Matal v. Tam*, 137 S. Ct. 1744 (2017).

<sup>35</sup> *In re Tam*, 785 F.3d 567, 568 (Fed. Cir. 2015).

meaning of “The Slants” was to refer to people of Asian descent, thus violating the Lanham Act’s disparaging clause,<sup>36</sup> which prohibits the registration of marks that may disparage persons, institutions, or beliefs.<sup>37</sup> Tam decided to appeal this decision to the Federal Circuit on the issue that the disparaging clause violated the Free Speech Clause of the First Amendment. In 2015, the Federal Circuit ruled in favor of Tam and held that the disparagement bar is facially unconstitutional and exercised viewpoint discrimination.<sup>38</sup>

In 2017, the Supreme Court affirmed this decision.<sup>39</sup> The Court agreed on two ideas: first, if a trademark regulation bar is viewpoint based, it is unconstitutional because it violates the First Amendment’s Free Speech Clause, and second, the disparagement bar was based on viewpoint.<sup>40</sup>

The Court determined that a core principle of free speech law is that the government cannot discriminate against speech based on the ideas or opinions it conveys.<sup>41</sup> The Court further determined that the disparagement clause reflects the government’s disapproval of a subset of messages it finds offensive, which is the exact essence of viewpoint discrimination.<sup>42</sup> Particularly important to Justice Alito was that the Lanham Act’s disparagement clause is not “narrowly drawn,” as “[t]he clause reaches any trademark that disparages *any* person, group, or institution.”<sup>43</sup> The Court seemed to concede that speech that demeans on the basis of race, ethnicity, gender, religion, age, or any other ground is undoubtedly hateful and is speech that the government cannot be expected to endorse, but nevertheless, the “proudest boast of the Supreme Court’s free speech jurisprudence is that it protects the freedom to express hated thoughts.”<sup>44</sup>

Ultimately, the *Tam* decision not only killed the disparagement clause, but it put the immoral or scandalous provision on death row, as the immoral or scandalous provision similarly called for USPTO examiners to judge the marks on the basis of viewpoint.

## 2. Strike Two: *Iancu v. Brunetti*

In 2011, Erik Brunetti, owner of a clothing line under the name “FUCT,” sought to register the mark FUCT to prevent competitors

---

<sup>36</sup> *Tam*, 137 S. Ct. at 1754.

<sup>37</sup> *Id.* at 1748.

<sup>38</sup> *In re Tam*, 785 F.3d 567.

<sup>39</sup> *Tam*, 137 S. Ct. at 1747.

<sup>40</sup> *Id.* at 1751.

<sup>41</sup> *Id.* at 1763.

<sup>42</sup> *Id.*

<sup>43</sup> *Id.* at 1764–65.

<sup>44</sup> *Id.* at 1764.

and knock-offs from appropriating his brand.<sup>45</sup> The USPTO rejected Brunetti's application and reasoned that FUCT was phonetically similar to a well-known expletive previously established as a scandalous word under the Lanham Act.<sup>46</sup> Brunetti appealed this decision to the Trademark Trial and Appeal Board, but they upheld the decision.<sup>47</sup> Brunetti followed with an appeal to the Federal Circuit on the issue that the immoral or scandalous provision violated the Free Speech Clause of the First Amendment.<sup>48</sup>

Less than a year after the Supreme Court decided *Tam*, the Federal Circuit ruled that the USPTO correctly labeled FUCT as an established scandalous word, but further ruled that the immoral or scandalous provision violated a trademark applicant's right to free speech.<sup>49</sup> The court concluded that language in the form of trademarks should be considered private speech, not government speech, and be subject to First Amendment analysis.<sup>50</sup> Consequently, under this type of analysis, the court found that the provision was unconstitutional.<sup>51</sup> Importantly, the court also expressed concerns over the provision's wide scope and its ability to cast a net that is far more extensive than necessary to serve any government interest.<sup>52</sup>

On appeal in 2019, a unanimous Supreme Court held that the Lanham Act's prohibition on the registration of immoral trademarks infringes on First Amendment rights.<sup>53</sup> Further, in a 6-3 decision in favor of Brunetti, the Court held that the Lanham Act's prohibition on the registration of scandalous marks also infringes on First Amendment rights.<sup>54</sup> The majority concluded that the USPTO has refused to register marks expressing an immoral or scandalous viewpoint on, among other things, drug use, religion, and terrorism,<sup>55</sup> while also approving the registration of marks expressing more accepted views on the same topics.<sup>56</sup> While the Court certainly does not expect the government to promote or advance any extreme ideas, a law disfavoring "ideas that offend" discriminates based on viewpoint and is in violation of the First

---

<sup>45</sup> *In re Brunetti*, 877 F.3d 1330, 1337 (Fed. Cir. 2017).

<sup>46</sup> *Id.* at 1337–38.

<sup>47</sup> *Id.* at 1337.

<sup>48</sup> *Id.*

<sup>49</sup> *Id.* at 1335.

<sup>50</sup> *Id.* at 1340.

<sup>51</sup> *Id.* at 1341.

<sup>52</sup> *See id.* at 1350, 1353.

<sup>53</sup> *See Iancu v. Brunetti*, 139 S. Ct. 2294 (2019).

<sup>54</sup> *See id.*

<sup>55</sup> *Id.* at 2300–01.

<sup>56</sup> *Id.*

Amendment's Free Speech clause.<sup>57</sup> Justice Kagan, writing for the majority, particularly found issue with the breadth of the provision, stating that “[t]here are a great many immoral and scandalous ideas in the world,” and the immoral or scandalous provision “cover[ed] them all.”<sup>58</sup>

In *Brunetti*, the government argued that the provision should be read more narrowly, and that only “marks that are offensive [or] shocking to a substantial segment of the public because of their *mode* of expression, independent of any views that they may express” should be barred.<sup>59</sup> Essentially, this would limit the USPTO to only refuse marks that are “vulgar”—meaning “lewd,” “sexually explicit or profane.”<sup>60</sup> This is an important distinction from how the current provision reads, as this new interpretation would not turn on viewpoint, and could not be struck down on the grounds of viewpoint discrimination.<sup>61</sup> The majority explained that they could not accept the government’s proposal, as the statute’s text says something markedly different, but at the same time, the majority did not shut the door on such an interpretation, suggesting that if Congress chooses to act, the immoral or scandalous provision can be revived.<sup>62</sup>

Three justices, Chief Justice Roberts, Justice Breyer, and Justice Sotomayor, each dissented in part in regard to the registration of scandalous trademarks.<sup>63</sup> All three felt that the “scandalous” interpretation was not as broad as the majority seemed to make it, and that the USPTO would not be discriminating on the basis of viewpoint under this particular clause.<sup>64</sup>

In a particularly influential dissent, Justice Sotomayor expressed concern that *Brunetti* could lead to an onslaught of new scandalous trademark applications.<sup>65</sup> Further, Justice Sotomayor seemed to agree with the government and advocated for a narrow construction for the word “scandalous,” interpreting it to regulate “only obscenity, vulgarity, and profanity,” thus saving the provision from unconstitutionality.<sup>66</sup> This narrow interpretation would create a viewpoint-neutral form of content discrimination, as restrictions

---

<sup>57</sup> *Id.* at 2301.

<sup>58</sup> *Id.* at 2302.

<sup>59</sup> *Id.* at 2301.

<sup>60</sup> *Id.*

<sup>61</sup> *Id.*

<sup>62</sup> *Id.*

<sup>63</sup> *See id.* at 2303–04 (Roberts, C.J., dissenting); *Id.* at 2304–08 (Breyer, J., dissenting); *Id.* at 2308–18 (Sotomayor, J., dissenting).

<sup>64</sup> *See id.* at 2303–04 (Roberts, C.J., dissenting); *Id.* at 2304–08 (Breyer, J., dissenting); *Id.* at 2308–18 (Sotomayor, J., dissenting).

<sup>65</sup> *Id.* at 2308, 2318 (Sotomayor, J., dissenting).

<sup>66</sup> *Id.* at 2308 (Sotomayor, J., dissenting).

on particular “modes of expression” do not inherently qualify as viewpoint discrimination.<sup>67</sup> These “modes of expression” are not by nature examples of “government target[ing] . . . particular views taken by speakers on a subject,” and therefore, should pass scrutiny.<sup>68</sup> Ultimately, Justice Sotomayor not only advocated for the idea of prohibiting scandalous marks from registration, but also provided Congress with a roadmap on how they could shape a newly constructed provision.

### 3. Aftermath of *Brunetti*

After the *Tam* and *Brunetti* decisions, it may seem as though the prohibitions on disparaging, immoral, and scandalous marks may have met the same fate, but this is far from the case. While it appears the days ahead for any exclusions on disparaging marks are gloomy, the immoral and scandalous prohibitions still have life. Between Justice Sotomayor’s dissent and the *Brunetti* majority failing to close the door on a narrowly crafted provision, the ball is now in Congress’s court to create a provision that passes potential First Amendment critique. After *Brunetti*, it is clear the heart of the issue lies with the “immoral” provision,<sup>69</sup> but as Justice Sotomayor suggested, a “scandalous” provision can be crafted to avoid unconstitutionality.

As a result, this article proposes a provision that will slightly narrow the scandalous half of the old provision and try to merely salvage all that is possible from the immoral half. First, though, there are important First Amendment concepts that must be analyzed and scrutinized.

## III. THE FIRST AMENDMENT AND REGULATED SPEECH

### A. *The Free Speech Clause*

The Free Speech Clause of the First Amendment reads: “Congress shall make no law . . . abridging the freedom of speech, or of the press.”<sup>70</sup> This amendment was undoubtedly a reaction against the suppression of speech and press that existed in English society, but beyond this, there is little to no indication of what exactly the framers intended to achieve with this provision.<sup>71</sup> This has left Americans to debate for centuries over the meaning behind the Free

---

<sup>67</sup> *Id.* at 2309 (Sotomayor, J., dissenting).

<sup>68</sup> *Id.* at 2313 (Sotomayor, J., dissenting).

<sup>69</sup> This is clear, as all nine justices felt that the immoral provision was invalid, while only six justices believed that the scandalous provision was invalid. *See generally id.*

<sup>70</sup> U.S. Const. amend. I.

<sup>71</sup> Rodney A. Smolla, Smolla and Nimmer on Freedom of Speech 1–18 (1996).

Speech Clause.<sup>72</sup> For example, the clause could be read with an absolutist lens, under which the First Amendment puts a complete stranglehold on Congress and prohibits virtually any law abridging the freedom of speech.<sup>73</sup> However, the Supreme Court has generally rejected this view.<sup>74</sup>

On the other hand, critics of the absolutist view commonly promote a more practical balancing approach, which argues that courts should weigh the competing social and individual interests in unregulated speech against legitimate social and individual interests in protecting against certain speech.<sup>75</sup> For example, First Amendment scholar Jud Campbell suggests that the founders thought that the First Amendment's Free Speech Clause required Congress to restrict speech and the press "only in the promotion of public good," and that the First Amendment stood for a general principle that left plenty of room for debate as to how it should be applied in practice.<sup>76</sup> This view, rather than the absolutist view, more closely reflects reality, as it has been up to the courts to decide what speech can be regulated by the government.<sup>77</sup> Predictably, this has led to plenty of line drawing and judicially created categories of so-called "protected" and "unprotected" speech, the latter falling outside of the First Amendment's protection.

As *Brunetti* points out, the Court has often held that viewpoint discrimination, the notion that the government cannot regulate speech based on the ideas or opinions it conveys, is at the core of the First Amendment.<sup>78</sup> For example, with regard to the immoral or scandalous provision, if the Lanham Act permits registration of trademarks that promote society's sense of morality, or marks that are neither immoral nor scandalous, then it must also permit the registration of trademarks that promote the opposing viewpoint.<sup>79</sup>

---

<sup>72</sup> See Jud Campbell, *What did the First Amendment originally mean?*, Richmond Law (July 9, 2018), <https://lawmagazine.richmond.edu/features/article/-/15500/what-did-the-first-amendment-originally-mean.html>.

<sup>73</sup> This absolutist view was famously used by Justices Black and Douglas. See *Konigsberg v. State Bar of Cal.*, 366 U.S. 36, 56 (1961) (Black, J., dissenting); See *Braden v. United States*, 365 U.S. 431, 441 (1961) (Black, J., dissenting); *Wilkinson v. United States*, 365 U.S. 399, 423 (1961) (Black, J., dissenting); *Uphaus v. Wyman*, 364 U.S. 388, 392 (1960) (Black, J., dissenting); *Barenblatt v. United States*, 360 U.S. 109, 140 (1959) (Black, J., dissenting). For Justice Douglas's position, see *New York Times Co. v. United States*, 403 U.S. 713, 720 (1971) (Douglas, J., concurring); *Roth v. United States*, 354 U.S. 476, 508 (1957) (Douglas, J., dissenting); *Brandenburg v. Ohio*, 395 U.S. 444, 450 (1969) (Douglas, J., concurring).

<sup>74</sup> See, e.g., *Konigsberg*, 366 U.S. at 49.

<sup>75</sup> John R. Vile, *Ad Hoc Balancing*, First Amendment Encyclopedia (2009), <https://mtsu.edu/first-amendment/article/888/ad-hoc-balancing>.

<sup>76</sup> Campbell, *supra* note 72.

<sup>77</sup> *Id.*

<sup>78</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294, 2299 (2019).

<sup>79</sup> *Id.*

Put differently, the immoral or scandalous provision distinguishes between opposite sets of trademarks: “those aligned with conventional moral standards and those hostile to them; those inducing societal nods of approval and those provoking offense and condemnation.”<sup>80</sup> As such, the Lanham Act allows for the former, but disfavors the latter, displaying blatant viewpoint bias and violating the First Amendment.<sup>81</sup>

### ***B. First Amendment Exceptions***

However, even in the context of viewpoint discrimination, the Supreme Court has drawn lines and created above-mentioned categories of unprotected speech, falling outside of the Free Speech Clause and granting the government more freedom to regulate speech. In other words, if the government seems to regulate viewpoint-based speech, as is the case with the immoral or scandalous provision, the next step is to determine whether that speech fits into some narrow juridically created category of unprotected speech.<sup>82</sup> It is important to note, though, that these categories are not determinative of whether a government regulation is constitutional or not, but rather signal that the government generally has more leeway to regulate speech based on its content.<sup>83</sup>

Types of speech particularly relevant to trademarks that should be examined for their fit within categories of unprotected speech are: (1) obscenity, (2) profanity, (3) drug use, and (4) terroristic speech. These have all frequently fallen within the immoral or scandalous provision’s grasp in the past, so an investigation into each is worthwhile in constructing a new constitutionally sound provision. As Justice Sotomayor pointed out in *Brunetti*, obscenity and profanity fall under the definition of “scandalous” and do not necessarily turn on viewpoint.<sup>84</sup> On the other hand, drug use and terrorism fall under the “immoral” heading and are more likely to turn on viewpoint. Nonetheless, drug use and terrorism are both explicitly mentioned in *Brunetti* as problematic,<sup>85</sup> so if a new provision is to be doctored, they must also undergo an investigation.

---

<sup>80</sup> *Id.* at 2296.

<sup>81</sup> *Id.* at 2300.

<sup>82</sup> *See* United States v. Stevens, 559 U.S. 460, 470 (2010) (discussing the “historically unprotected categories of speech”).

<sup>83</sup> *R.A.V. v. City of St. Paul*, 505 U.S. 377, 383–84 (1992).

<sup>84</sup> *Brunetti*, 139 S. Ct. at 2308, 2318 (Sotomayor, J., dissenting).

<sup>85</sup> *See id.* at 2300.



## 1. Obscenity

The Supreme Court has held that “obscenity” is a category of speech that is unprotected by the First Amendment but has generally struggled to define what is “obscene.” The Court seemed to “solve” this problem in *Miller v. California*, when it set out three guiding considerations for determining whether speech is obscene: (1) whether the average person, applying contemporary community standards would find that the work, taken as a whole, appeals to a prurient interest; (2) whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law, and (3) whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value.<sup>86</sup>

On its face, the *Miller* standard may not seem like it would fit well as a USPTO trademark regulation. For one, the first two prongs of the *Miller* test are held to the standards of the community, while the third prong is held to what is reasonable to a person in the country as a whole.<sup>87</sup> One reason the Court may have added the last prong is to serve as a check on the first two prongs, protecting speech that may be considered obscene to a specific community, but on a national level might provide positive value. In the case of trademarks, though, a national standard is really the only relevant standard. While it is true that some trademarks are used only in certain regions, registering a mark with the USPTO gives a trademark owner *national* protection. Thus, the USPTO should be thinking of a mark’s national impact rather than its impact on any certain community.

Second, the third prong specifically makes an exception for works that hold serious “literary, artistic, political, or scientific” value.<sup>88</sup> This should not be relevant to trademarks, as trademarks are meant to simply identify and distinguish goods or services and do not concern artistic or political value. Ultimately, while the *Miller* test may not be the perfect fit for trademarks, it provides a workable framework that can be utilized in creating a new immoral or scandalous provision, set forth in Part III.<sup>89</sup>

## 2. Profanity

Even though profanity and obscenity are distinct categories of speech, the government has often regulated and punished them in a similar manner.<sup>90</sup> However, the Supreme Court has held that profanity is generally protected by the First Amendment’s Free

---

<sup>86</sup> See *Miller v. California*, 413 U.S. 15, 24 (1973).

<sup>87</sup> *Id.* at 25.

<sup>88</sup> *Id.* at 24.

<sup>89</sup> See Part III.

<sup>90</sup> See *Cohen v. California*, 403 U.S. 15 (1971).

Speech Clause.<sup>91</sup> Still, there remain some notable exceptions. The Court has adopted a medium-by-medium approach, analyzing profane speech over broadcast media, over Internet, and over cable TV separately.<sup>92</sup>

With regard to broadcast media, the Court held in *FCC v. Pacifica Foundation* that broadcasting has less First Amendment protection than other forms of communication because of its pervasive nature.<sup>93</sup> The Court recognized that the government has strong interests in protecting children from “patently offensive” speech and in safeguarding the privacy of one’s home from this speech.<sup>94</sup> These two concerns, the Court said, were sufficient to “justify special treatment of indecent broadcasting.”<sup>95</sup> Lastly, the Court in *Pacifica* reasoned that radio and television stations have a long history of government regulation and limited First Amendment protection.<sup>96</sup>

Reaching the opposite conclusion with respect to the Internet, the Court held in *Reno v. ACLU* that it is unconstitutional to regulate profane speech over the Internet.<sup>97</sup> This is justifiable, as the legitimate government interests set out in *Pacifica* are simply not present in the Internet medium. For example, the Internet is not invasive into the home like broadcast media, and the need to shield children is decreased.<sup>98</sup> Moreover, there was no history of the government regulating the Internet.<sup>99</sup> Accordingly, profane speech in broadcast media and profane speech over the Internet are treated differently, and while trademarks differ from broadcast media and the Internet in significant ways, they can be compared to each in deciding which line of thought to follow.

To start, as previously stated, the purpose behind trademarks is to identify goods or services and to distinguish these goods or services from someone else’s. In reality, they are used as a promotional tool just as much as they are used to avert potential consumer confusion. Naturally then, a trademark owner wants his or her mark to be seen and will spend money to ensure the mark is in the public eye. When it comes to profanity, this suggests that

---

<sup>91</sup> See David L. Judson Jr., *Profanity*, First Amendment Encyclopedia, <https://www.mtsu.edu/first-amendment/article/1143/profanity> (last updated Aug. 2017).

<sup>92</sup> See, e.g., *Federal Communications Commission v. Pacifica*, 438 U.S. 726 (1978) (analyzing profanity in the broadcast media context); *Reno v. American Civil Liberties Union*, 521 U.S. 844 (1997) (analyzing profanity in the Internet context).

<sup>93</sup> *Pacifica*, 438 U.S. 726.

<sup>94</sup> See *id.* at 748–51.

<sup>95</sup> *Id.*

<sup>96</sup> *Id.*

<sup>97</sup> *Reno*, 521 U.S. 844.

<sup>98</sup> *Id.*

<sup>99</sup> *Id.*

trademarks are inherently invasive and should be treated in a similar manner as broadcast media, rather than the Internet. Additionally, like broadcast media, there is a long-standing history of government regulations on trademarks.<sup>100</sup> Congress first enacted a federal trademark regime in 1870, adjusting and updating it numerous times since then,<sup>101</sup> including in 1946 when Congress passed the Lanham Act.<sup>102</sup> Further, state law adds its own protections to marks in addition to federal law.<sup>103</sup> As such, long-standing regulation of trademarks also suggests that the Court should treat them in a similar manner as broadcast media when it comes to profanity. That is, the government's interest should be weighed against the Free Speech Clause, as in *Pacifica*.<sup>104</sup>

### 3. Terrorism

In *Brunetti*, there is explicit mention of the USPTO's inconsistencies in granting registration for trademarks that display a "moral" view on terrorism, while denying registration to trademarks that endorse the opposite.<sup>105</sup> While this is understandable, the Court has made clear that "a law 'disfavoring ideas that offend' discriminates based on viewpoint, in violation of the First Amendment."<sup>106</sup> For marks that reference terrorism, the most applicable area of free speech jurisprudence may be speech that advocates for illegal action,<sup>107</sup> and the most relevant case in this area is *Brandenburg v. Ohio*.<sup>108</sup>

In *Brandenburg*, a KKK leader gave a speech at a rally and said that "it's possible that there might have to be some revengeance [sic] taken."<sup>109</sup> This KKK leader was convicted under the Ohio Criminal Syndicalism Act for advocating for violent actions and for assembling a group of people to carry out these actions.<sup>110</sup> On appeal, the KKK leader challenged the act's validity on First Amendment free speech grounds.<sup>111</sup> To determine if the government may prohibit speech advocating for the use of violence, the Supreme

---

<sup>100</sup> See Abdel-khalik, *supra* note 13.

<sup>101</sup> *Id.*

<sup>102</sup> *Id.*

<sup>103</sup> See, e.g., 54 Pa. Cons. Stat. §§ 1101–1126 (2020).

<sup>104</sup> See *Federal Communications Commission v. Pacifica*, 438 U.S. 726 (1978).

<sup>105</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294, 2300 (2019).

<sup>106</sup> *Id.*

<sup>107</sup> See *Brandenburg v. Ohio*, 395 U.S. 444 (1969).

<sup>108</sup> See *id.*

<sup>109</sup> *Id.* at 446.

<sup>110</sup> *Id.* at 444–45.

<sup>111</sup> *Id.* at 445.

Court established a two-prong test.<sup>112</sup> If the speech (1) is “directed to inciting or producing imminent lawless action,” and (2) is “likely to incite or produce such action,” then the speech is not protected by the First Amendment.<sup>113</sup>

Admittedly, no trademark is likely to pass this test because no trademark calls for “imminent lawless action,” as required by the first prong. However, in the context of terroristic speech, it is reasonable and arguably necessary that the government use *proactive* regulation to prevent terroristic messages from coming to fruition. If the imminence standard is required to regulate terroristic speech, it creates room for danger because such a standard relies on a *retroactive* approach and sets a high burden to meet.<sup>114</sup> In other words, a tragic event may already occur before terroristic speech can be attacked.<sup>115</sup> Therefore, prong one of the *Brandenburg* test does not fit squarely in the terroristic trademark context.

On the contrary, a more proactive approach would be a “substantial likelihood” standard, similar to the one seen in prong two of the *Brandenburg* test. A substantial likelihood approach means that, not only is the threat of harm possible, but the speaker must be likely to achieve his or her goal of promoting harm without government intervention.<sup>116</sup> This would work perfectly in the trademark context, as it would allow the USPTO to regulate terroristic marks during the registration process before violence occurs. If nothing else, it creates a useable template for the new provision proposed in Part III.<sup>117</sup>

#### 4. Drug Use

In *Brunetti*, there is also explicit mention of the USPTO’s inconsistencies in granting registration for trademarks involving drug use.<sup>118</sup> While taking a stance on drugs seems to be at the heart of viewpoint discrimination, speech that reasonably encourages illegal drug use has been identified by the Supreme Court as a category of unprotected speech.<sup>119</sup>

---

<sup>112</sup> *Id.*

<sup>113</sup> *Id.*

<sup>114</sup> Zachary Leibowitz, *Terror on Your Timeline: Criminalizing Terrorist Incitement on Social media Through Doctrinal Shift*, 86 Fordham L. Rev. 795, 821–22 (2017).

<sup>115</sup> *Id.*

<sup>116</sup> *Id.* at 822.

<sup>117</sup> See Part III.

<sup>118</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294, 2300 (2019).

<sup>119</sup> See *Morse v. Frederick*, 551 U.S. 393 (2007).

In *Morse v. Frederick*, a high school student displayed a banner with the message “Bong Hits 4 Jesus.”<sup>120</sup> His school principal proceeded to confiscate the banner and suspended the student.<sup>121</sup> The student challenged the suspension and claimed that the principal violated his First Amendment free speech rights.<sup>122</sup> The Supreme Court held that the suspension did not violate the First Amendment, and punishment for speech on school grounds is appropriate only if such speech will substantially interfere with the work of the school.<sup>123</sup> The Court justified its holding by explaining that schools have a compelling interest in preventing illegal drug use among young students.<sup>124</sup> The breadth of the *Morse* holding has been debated, but it is generally believed that *Morse* is very narrow and applies only to student speech encouraging illegal drug use.<sup>125</sup>

If *Morse* specifically applies to speech in a school setting, then its application to the trademark setting must be *extremely* narrow. Trademarks are meant to reach a wide audience, meaning that unless a trademark is meant to specifically target children and promote illegal drug use in a school setting, a rule like *Morse* likely cannot be applied, and trademarks involving drug use will likely remain protected.

#### IV. SAVING THE LANHAM ACT

##### A. A New Framework

In constructing a new immoral or scandalous provision, a couple of key initial considerations must be accounted for. First, as the Court pointed out in *Brunetti*, the old provision was far too broad and led to inconsistent grants of registration,<sup>126</sup> so a new provision must be sufficiently narrow and generate consistent results. Also, the Court was noticeably more open to the idea of a scandalous provision as opposed to an immoral provision, as the former is less likely than the latter to turn on viewpoint.

With these considerations in mind, a new provision should not be a single overarching, unitary provision as in the past—instead, there should be a clear line between the immoral provision and the scandalous provision. Further, there should be distinct categories within each of the immoral and scandalous provisions. Specifically, within the scandalous provision, there should be two categories:

<sup>120</sup> *Id.* at 397.

<sup>121</sup> *Id.* at 398.

<sup>122</sup> *Id.* at 399.

<sup>123</sup> *Id.* at 402.

<sup>124</sup> See Symposium: *Speech and the Public Schools After Morse v. Frederick: How Will Morse v. Frederick Be Applied?*, 12 Lewis & Clark L. Rev. 17 (2008).

<sup>125</sup> *Id.* at 21.

<sup>126</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294, 2300 (2019).

(a) obscenity and (b) profanity. These categories mirror the suggestions set forth by Justice Sotomayor in *Brunetti*.<sup>127</sup> Additionally, under the immoral provision, the categories should be even more narrow and unambiguously enumerated. For the purpose of this article, the categories (c) terrorism and (d) drug use will take focus, as these were two major categories focused on in the *Brunetti* decision.<sup>128</sup> It is worthwhile to note that these last two categories are certainly not the only categories that can fall under an immoral heading.<sup>129</sup> In fact, Congress can add as many categories as necessary. However, as explained by *Brunetti*, if Congress wants to prohibit the registration of immoral marks, Congress must be exceedingly narrow and specific in the marks considered to be problematic. So, if other “immoral” marks are to be barred, they should be added to the provision.

Moreover, to determine if a specific mark will fail under either the immoral or scandalous provisions, the USPTO should follow a two-part examination. The first part will ask in which provision—immoral or scandalous—and category the problematic trademark falls within. For example, a mark focused on marijuana falls under the immoral provision and under the “drug use” category. Next, the second part will entail applying a category-specific test to the trademark. These category-specific tests, set forth below, are modeled after previously established Supreme Court decisions introduced in Part III.<sup>130</sup>

To summarize, the first prong of this proposed two-prong test puts the trademark in the appropriate bucket. This ensures that the provisions are not too broad and overreaching—if a trademark does not fall within an enumerated bucket, the immoral and scandalous provisions will not apply. Similarly, the second prong applies a bucket-specific Supreme Court–approved First Amendment analysis to the mark. This makes the new immoral or scandalous provision constitutionally sound, as decisions will no longer turn on viewpoint. Naturally, this will lead to more consistent results.

### ***B. Category-Specific Tests***

The provision’s first category addresses obscenity. The test for obscene marks should be as follows:

In deciding if a mark is obscene and unregistrable, a USPTO examiner should consider: (1) whether the average person, applying national standards, would find the mark obscene;

---

<sup>127</sup> *Id.* at 2308 (Sotomayor, J., dissenting).

<sup>128</sup> *Id.* at 2300.

<sup>129</sup> *Id.* (noting that religion, for example, can also fall under the immoral heading).

<sup>130</sup> See Part III.

and (2) whether the work depicts or describes, in a patently offensive way, sexual conduct.

The above language follows the test set forth in *Miller*.<sup>131</sup> However, instead of *Miller*'s community standard, this test uses a national standard. This is important because trademark registration gives an owner national rights. Further, the third prong of the *Miller* test was not included, as trademarks should not concern themselves with "literary, artistic, political, or scientific value." This was not included because trademarks are meant to identify goods and services, not to serve as a standalone work of art.

The provision's second category addresses profanity. The test for profane marks should be as follows:

In deciding if a mark is especially profane and unregistrable, a USPTO examiner should consider: (1) if the content is "grossly offensive" language that is considered a public nuisance; and (2) the context and setting of the mark's use.

This test mirrors the standards set forth in *Pacifica* and in current FCC regulations.<sup>132</sup> The first prong is simply the suggested definition of "profane" set forth by the FCC.<sup>133</sup> The *Pacifica* Court held that the government has a strong interest in protecting children from "patently offensive" speech and in safeguarding the privacy of one's home from this speech."<sup>134</sup> Thus, the second prong accounts for the context and setting of the mark's use. For example, if the mark is used in a way that makes it highly visible to children, it will likely be rejected. On the other hand, if the mark is for products used exclusively by adults or a mature audience, it will likely be granted registration and protection.

The provision's third category addresses terrorism. The test for marks that seem to have a terroristic message should be as follows:

In deciding if a mark reflects a terroristic message in an inappropriate manner, a USPTO examiner should consider: (1) If the speech is directed at producing lawless action; and (2) if the speech is substantially likely to produce such action if there is no government intervention.

This test follows the factors considered in *Brandenburg*. While the *Brandenburg* test included an "imminent" standard, as discussed in Part III, an imminence requirement creates room for danger, as it

<sup>131</sup> See *Miller v. California*, 413 U.S. 15 (1973).

<sup>132</sup> See *Federal Communications Commission v. Pacifica*, 438 U.S. 726 (1978); see also *Consumer Guide: Obscene, Indecent, and Profane Broadcasts*, FCC (2016), [https://www.fcc.gov/sites/default/files/obscene\\_indecent\\_and\\_profane\\_broadcasts.pdf](https://www.fcc.gov/sites/default/files/obscene_indecent_and_profane_broadcasts.pdf) [hereinafter *Consumer Guide*].

<sup>133</sup> *Consumer Guide*, *supra* note 118.

<sup>134</sup> *Pacifica*, 438 U.S. at 748–51.

is mainly a retroactive approach.<sup>135</sup> To combat this issue, the test above includes a proactive “substantial likelihood” standard.

A few examples of proposed terroristic marks the Court included in *Brunetti* are: “WAR ON TERROR MEMORIAL,” “AL-QAEDA” on t-shirts, and “BABY AL QAEDA” on t-shirts.<sup>136</sup> Under the proposed standard, “WAR ON TERROR MEMORIAL” would be registrable, as this speech is not directed at lawless action, nor is it likely to produce such action. However, “AL-QAEDA,” the name of a well-known terror group and orchestrators of terroristic attacks that have killed thousands,<sup>137</sup> will likely be denied registration. Printing this mark on a t-shirt, for example, likely implies that the terror group is being promoted or endorsed, and given the group’s violent history, it is likely that promoting such a group will lead to increased violence. Finally, a mark like “BABY AL QAEDA,” which was denied registration under the old provision, will likely be granted registration under this proposed provision because the speech is not necessarily pointed at producing lawless action, as the word “baby” shows shades of parody or satire.

Overall, this new proposed provision is more narrowly tailored, and should lead to more consistent results. Only true terroristic speech, which is speech that is not afforded First Amendment protection, will be targeted.

The provision’s final category addresses drug use. This part will be exceedingly narrow and will apply to few mark applications. Nonetheless, it may be useful to include in a proposed immoral or scandalous provision for clarity. In deciding if a mark reflects a message that promotes drug use, a USPTO examiner should consider:

- (1) If a mark is specifically directed at promoting drug use;
- (2) if a mark is specifically directed at school-aged children;
- and (3) if the mark actually promotes drug use among school-aged children.

This standard follows the *Morse* opinion and is consistent with the compelling government interest in preventing illegal drug use among young students.<sup>138</sup>

A few examples of proposed marks the Court included in the *Brunetti* are: “SAY NO TO DRUGS—REALITY IS THE BEST TRIP IN LIFE” and “MARIJUANA COLA” for beverages. Under this new standard, the first mark will obviously be granted registration because it does not promote drug use, even if it may target school-

---

<sup>135</sup> See Part III.

<sup>136</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294, 2300 (2019).

<sup>137</sup> *Al-Qaeda Terrorist Attacks by Number of Deaths from 1993 to 2010*, Statista (May 3, 2011), <https://www.statista.com/statistics/272757/al-qaeda-terrorist-attacks-by-death-toll/>.

<sup>138</sup> See *Morse v. Frederick*, 551 U.S. 393 (2007).



aged children. The second mark will also likely be granted registration because, even if it may seem to promote drug use, there is no clear indication that it is targeting school-aged children. However, an example of a mark that may be denied registration under this proposed provision is “SMOKE WEED” on a t-shirt line targeting young adults. This would meet all three prongs of the test and would be denied registration.

As a final note, the *Brunetti* opinion also explains that there have been a great number of inconsistencies in the USPTO granting marks about religion. Because freedom of religion is engrained in the First Amendment of the Constitution,<sup>139</sup> and there is no provision that could pass constitutional muster. Thus, all religious marks should be passed, assuming they pass other statutory requirements, of course.

## V. CONCLUSION

All in all, it is imperative that the Lanham Act’s immoral or scandalous provision be revitalized in light of the *Brunetti* decision. If not, as the Justice Sotomayor predicts, there will be an influx of obscene, profane, and vulgar marks, among others, being registered with the USPTO and gaining prevalence in society. The Court left the ball in Congress’s court to act and create a narrow, consistent provision, and Congress must do just that. As this article points out, this proposed provision will carry out the purpose of the old provision, while still passing constitutional muster. In other words, the best of both worlds will be realized, as free speech rights are adhered to, while certain inappropriate trademarks are kept from the public eye.

---

<sup>139</sup> U.S. Const. amend. I.