

IT'S "FUCT": THE DEMISE OF THE LANHAM ACT

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ABSTRACT

The Lanham Trademark Act of 1946 introduced several tools to help trademark owners protect the long-recognized right to exclusive use of a symbol or device to distinguish one's goods. One of these tools is the Principal Register, which confers certain benefits to marks approved by the United States Patent and Trademark Office (USPTO). The USPTO's examining attorneys must abide by the guidelines contained in Section 2 of the Lanham Act when deciding which marks to approve. Notable among the bars to registration contained within Section 2 are the disparagement and the immoral or scandalous provisions, which examining attorneys often used to reject trademark applications. The Supreme Court and United States Court of Appeals for the Federal Circuit, respectively, recently declared these provisions unconstitutional under First Amendment freedom of speech principles, however. As noted by renowned scholar Rebecca Tushnet, the logic and analyses invoked by both courts are also applicable to most of the other bars contained in Section 2, as well as other parts of the Lanham Act, such as the dilution provision. If challenged, courts may also declare these provisions unconstitutional, undermining the purpose of the Lanham Act. This conclusion seems inevitable unless courts recognize their duty to construe statutes narrowly to

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preserve their constitutionality and, where possible, adopt a saving construction.

This paper explores the potential damning effects of the recent decisions of the Supreme Court and the Federal Circuit. To achieve that end this paper traces the development of the immoral or scandalous provision, reviews the relevant case law, applies the enunciated constitutional tests to the dilution provision of the Lanham Act, and notes a potential solution to prevent the demise of several sections of the Lanham Act.

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I. INTRODUCTION

Trademark protection is deeply rooted in the history of the United States. Originating at common law, the colonists continued to recognize the legal right to exclusive use of a symbol or device to distinguish goods or services and recover damages for infringement of that right.² While the common law still provides for trademark protection and regulation at the state level, Congress created a stronger system of registration at the federal level. The protection provided by several congressional acts has only increased over the years, highlighted by the passage of the Lanham Trademark Act in 1946. At its core, the Lanham Act’s purpose is to “guard[] the trademark owner against trademark infringement and unfair competition, and the public against confusion and inaccurate information.”³ However, several provisions of Section 2—which governs registration on the Principal Register—and other parts of the Lanham Act may soon fall due to recent decisions by the United States Supreme Court and the United States Court of Appeals for the Federal Circuit. Indeed, this conclusion is inevitable, and the purpose of the Lanham Act will be undermined if courts do not show restraint and adopt, where possible, saving constructions of these provisions.

² *In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879).

³ H. Peter Nesvold & Lisa M. Pollard, *Foreword - Half a Century of Federal Trademark Protection: The Lanham Act Turns Fifty*, 7 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 49, 49 (1996).

Congress's first attempt at a national regulation of trademarks led to the enactment of the Act of July 8, 1870,⁴ based on the Constitution's patent and copyright clause.⁵ The Supreme Court, however, finding no "necessary relation" between trademarks and inventions or discoveries, invalidated the act as an unconstitutional exercise of congressional power.⁶ Based on the Court's dicta, which suggested the commerce clause⁷ may be an appropriate avenue for a federal trademark regime, Congress passed the Act of March 3, 1881, to "authorize the registration of trademarks and protect the same."⁸ Congress then revised the Trademark Act in 1905 to apply to regulation of trademarks in interstate commerce in addition to commerce with foreign nations and Indian tribes.⁹ This revision also introduced the "immoral or scandalous" provision to the Trademark Act.¹⁰ Under this provision, the United States Patent and Trademark Office (USPTO), may refuse federal registration of a trademark application if the mark "consists of or comprises immoral . . . or scandalous matter."¹¹ Although the legislative history of the 1905 Act failed to indicate Congress's intent in enacting the provision,¹² the language remained when Congress next amended the Trademark Act

⁴ *Registration of Trade Marks: Joint Hearings on S. 2679 Before the Comms. On Patents*, 68th Cng. 90 (1925).

⁵ U.S. CONST. art. I, § 8, cl. 8.

⁶ *In re Trade-Mark Cases*, 100 U.S. at 94, 99.

⁷ U.S. CONST. art. I, § 8, cl. 3.

⁸ Trademark Act of Mar. 3, 1881, ch. 138, 21 Stat. 502, 502 (amended 1905) (no longer in force).

⁹ See generally H.R. REP. NO. 58–3147 (1904).

¹⁰ Act of Feb. 20, 1905, ch. 592, § 5(a), 33 Stat. 724, 725 (1905) (current version at 15 U.S.C. § 1052(a) (2012)); *In re Riverbank Canning Co.*, 95 F.2d 327, 327–28 (C.C.P.A. 1938).

¹¹ Act of July 5, 1946, Pub. L. No. 79–489, § 2(a), 60 Stat. 427, 428 (codified at 15 U.S.C. § 1052(a) (2018)).

¹² See *In re Riverbank Canning Co.*, 95 F.2d at 328 ("Its legislative history does not aid us in arriving at the intent of Congress in its enactment . . .").

in 1946. In passing the 1946 Trademark Act, commonly referred to as the Lanham Act,¹³ Congress further expanded upon the grounds for trademark refusal.

Notably, the list for refusing to grant trademark registration grew to include deceptive,¹⁴ disparaging,¹⁵ and descriptive marks.¹⁶ USPTO Trademark examiners and the Trademark Trial and Appeal Board (TTAB) routinely rejected trademark applications based on these grounds. Of these provisions, disparagement caused the most significant uproar. Specific examples of this uproar include litigation over the terms “Squaw Valley”¹⁷ and “HEEB,”¹⁸ the name of the National Football League franchise the “Washington Redskins,”¹⁹ the phrase “STOP THE ISLAMISATION OF AMERICA,”²⁰ and most recently, the name of a band, “The Slants.”²¹ Yet, in 2017, “The Slants” brought this practice to a screeching halt.

It was then, in *Matal v. Tam*, when the Supreme Court unanimously held the disparagement provision of the Lanham Act was facially invalid under First Amendment freedom of speech principles.²² However, while unanimous in its result, the Court split 4-4²³ on the proper test to apply: the “relaxed” scrutiny used in commercial speech cases or

¹³ Trademark Act of 1946 (Lanham Act), ch. 540, 60 Stat. 427 (1946) (codified at 15 U.S.C. §§ 1051–1141n (2018)).

¹⁴ 15 U.S.C. § 1052(a) (2012).

¹⁵ *Id.*

¹⁶ *Id.* at § 1052(e) (2012).

¹⁷ *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264 (T.T.A.B. June 2, 2006).

¹⁸ *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071 (T.T.A.B. Nov. 26, 2008).

¹⁹ *Pro Football, Inc. v. Harjo*, 565 F.3d 880 (D.C. Cir. 2009); *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015).

²⁰ *In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014).

²¹ *Matal v. Tam*, 137 S. Ct. 1744 (2017).

²² *Id.* at 1751.

²³ *See id.* at 1765 (“Justice GORSUCH took no part in the consideration or decision of this case.”).

the “heightened” scrutiny used in viewpoint discrimination cases.²⁴ Although each half of the Court explicitly limited their analysis to the disparagement provision,²⁵ six months later, the U.S. Court of Appeals for the Federal Circuit applied both analyses to the immoral or scandalous provision in *In re Brunetti*.²⁶ There, the Federal Circuit, reviewing Erik Brunetti’s mark “FUCT,” held that the immoral or scandalous provision also unconstitutionally infringed on the First Amendment.²⁷

According to Justice Dyk’s concurrence, however, the *Brunetti* majority ignored its obligation to “construe federal statutes so as to ‘avoid serious doubt of their constitutionality.’”²⁸ Rather than finding the provision unconstitutional, the concurrence believed the provision salvageable by “limiting [its] reach to obscene marks.”²⁹ Although both opinions agreed the mark FUCT should receive registration, looking forward, the Federal Circuit’s refusal to salvage the immoral or scandalous provision may have opened the door to more than the proliferation of offensive marks. Indeed, speculation has already begun as to which provision of the Lanham Act will be next to fall victim to the First Amendment.³⁰

²⁴ See *id.* at 1763, 1767 (Kennedy, J., concurring).

²⁵ See *id.* at 1763–64, 1763–64 nn.16–17.

²⁶ *In re Brunetti*, 877 F.3d 1330, 1342 (Fed. Cir. 2017)

²⁷ *Id.* at 1357.

²⁸ *Id.* at 1358 (Dyk, J., concurring) (quoting *Stern v. Marshall*, 564 U.S. 462, 477 (2011)).

²⁹ *Id.*

³⁰ See, e.g., *First Amendment Freedom of Speech-Trademarks-Matal v. Tam*, 131 HARV. L. REV. 243, 252 (2017) (“*Tam* casts doubt on other areas of commercial speech regulation such as the Lanham Act’s tarnishment provision”); Rebecca Tushnet, *Section 2 Refusals are Subject to Reed Strict Scrutiny*, *Fed. Cir. Rules*, REBECCA TUSHNET’S 43(B)LOG (Dec. 20, 2017, 4:48 PM), <http://tushnet.blogspot.com/2017/12/section-2-refusals-are-subject-to-reed.html> [<https://perma.cc/27RN-Z3UQ>].

The issues identified by the Supreme Court and the Federal Circuit apply equally to the descriptiveness and insignia provisions of the Lanham Act.³¹ Like the immoral or scandalous provisions, the descriptiveness and insignia provisions do not directly advance a substantial government interest (if any exists).³² Furthermore, the dilution provision, which Congress enacted in the Federal Trademark Dilution Act of 1995,³³ is also at risk as a form of viewpoint discrimination.³⁴ If courts follow the *Brunetti* majority and refuse to find a way to save the Lanham Act's provisions, there is no telling what, if anything, will remain of the Act in a few years.

While several scholars have considered and discussed the obscenity limitation,³⁵ this article is the first to revisit the idea since it received Judge Dyk's judicial endorsement. Additionally, this article is the first to apply the obscenity analysis to marks previously rejected by the USPTO. This article also explores the potential fallout

³¹ See Tushnet, *supra* note 30.

³² See *id.*

³³ 15 U.S.C. § 1125 (2012).

³⁴ See *infra* Part III.B.2.

³⁵ See Kristian D. Stout, *Terrifying Trademarks and A Scandalous Disregard for the First Amendment: Section 2(a)'s Unconstitutional Prohibition on Scandalous, Immoral, and Disparaging Trademarks*, 25 ALB. L.J. SCI. & TECH. 213, 253 (2015) (suggesting that before the Federal Circuit reviewed *Tam* en banc and before the Supreme Court's decision, Congress could simplify the immoral or scandalous and disparagement provisions by changing the collective meaning to cover obscenity); Kerry Ryden, *What Does In re Fox Say? Revising the Scandalous Trademark Doctrine by Reference to the Obscene*, 24 FED. CIR. B.J. 435, 457–68 (2015) (comparing the scandalousness analysis to the Supreme Court's obscenity analysis); Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*, 101 TRADEMARK REP. 1476, 1534 (2011) (noting that replacing the terms immoral and scandalous with the term obscene would “narrow[] the scope of possible rejections and allow[] reference to additional case law and standards.”).

resulting from the intersection of trademark law and First Amendment jurisprudence.³⁶ To do so, Part II of this article discusses the history of the immoral or scandalous provision. Part III discusses the *Tam* and *Brunetti* cases, focusing on the First Amendment issues identified by the Supreme Court and the Federal Circuit as well as the analysis each court used respectively. Part IV discusses the disagreement between the *Brunetti* majority and concurrence on the ability to salvage the immoral or scandalous provision. Part V then applies the tests used in *Tam* and *Brunetti* to the dilution provision before mentioning the potential effect this analysis has on other provisions of Section 2. Part VI introduces the Supreme Court’s test for obscene material, looks at two applications previously rejected for violating the immoral or scandalous provision, and hypothesizes what conclusion the USPTO would reach if it applied the Supreme Court’s obscenity test. Lastly, Part VII briefly concludes the article by reiterating the effect the *Tam* and *Brunetti* decisions may have on the Lanham Act.

II. THE IMMORAL OR SCANDALOUS PROVISION

A relic of another age, the “immoral or scandalous provision” is an enigma contained within the Lanham Act. While the USPTO may deny a mark registration if it is either immoral *or* scandalous, historically, the provision has been applied in a unitary manner, with the focus solely on the mark’s scandalousness.³⁷ Due to the “paucity of legislative history,”³⁸ the TTAB and the Court of Customs and Patent

³⁶ “[B]inding precedent” foreclosed the argument that the Lanham Act implicated the First Amendment prior to *In re Tam*, 808 F.3d 1321, 1333–34 (Fed. Cir. 2015), *aff’d sub nom*, *Matal v. Tam*, 137 S. Ct. 1744 (2017).

³⁷ See *In re Brunetti*, 877 F.3d at 1336.

³⁸ *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981), *abrogated by In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015).

Appeals, the predecessor to the United States Court of Appeals for the Federal Circuit, have reviewed the dictionary definition of the term “scandalous” several times.³⁹ While this definition has not changed,⁴⁰ the judicial interpretation has. At first, a mark could be refused registration if it was “shocking to the sense of . . . propriety” or would “give ‘offense to the conscience or moral feelings.’”⁴¹ Then, in the 1971 decision, *In re Runsdorf*, the TTAB determined the term “vulgar,” meaning “lacking in taste, indelicate, [and] morally crude” could be “encompassed by the term scandalous matter.”⁴²

Subsequent opinions of both the TTAB and the Federal Circuit cemented vulgarity as a sufficient basis for establishing the scandalousness of a mark.⁴³ The USPTO ascertains whether a mark is or is not scandalous based on the context of (1) contemporary attitudes; (2) the marketplace as applied only to the goods registration is sought for; and (3) the standpoint of a substantial composite of the general public, but not necessarily a majority.⁴⁴ The USPTO has recognized that these guidelines and their application “are somewhat vague and that a determination that a mark is scandalous is necessarily a highly subjective

³⁹ See *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012), *abrogated by In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015).

⁴⁰ See *In re McGinley*, 660 F.2d at 486 (quoting FUNK & WAGNALLS NEW STANDARD DICTIONARY (1945) and WEBSTER’S NEW INTERNATIONAL DICTIONARY (2d ed. 1942)); *In re Riverbank Canning Co.*, 95 F.2d at 328 (quoting FUNK & WAGNALLS NEW STANDARD DICTIONARY (1895) and WEBSTER’S NEW STANDARD DICTIONARY (1911)).

⁴¹ *In re Riverbank Canning Co.*, 95 F.2d at 328 (quoting FUNK & WAGNALLS NEW STANDARD DICTIONARY (1895) and WEBSTER’S NEW STANDARD DICTIONARY (1911)).

⁴² *In re Runsdorf*, 171 U.S.P.Q. 443, 444 (T.T.A.B. July 28, 1971).

⁴³ See, e.g., *In re Fox*, 702 F.3d at 638 (holding the statutory bar does not exclude double entendres); *In re Boulevard Ent., Inc.*, 334 F.3d 1336, 1340 (Fed. Cir. 2003).

⁴⁴ *In re Fox*, 702 F.3d at 635.

one.”⁴⁵ This subjectivity is one of several factors that led the Federal Circuit to conclude the immoral or scandalous provision violated the United States Constitution and received consideration by the Supreme Court before it found the same for the disparagement provision.⁴⁶

III. LAYING THE GROUNDWORK FOR DISASTER

In *Matal v. Tam*, the Supreme Court was asked to determine the facial validity of the disparagement provision of the Lanham Act under the Freedom of Speech Clause of the First Amendment.⁴⁷ The basis for this Constitutional question arose from Simon Shao Tam’s desire to obtain Federal trademark protection for the name of his band, “The Slants,” to “reclaim’ and ‘take ownership’ of stereotypes about people of Asian ethnicity.”⁴⁸ The USPTO examining attorney, however, rejected the application under the disparagement provision due to the perceived offensiveness of the mark.⁴⁹ After appealing to the TTAB and losing, Mr. Tam appealed his case to federal court.⁵⁰ Sitting en banc in the first instance, the U.S. Court of Appeals for the Federal Circuit vacated the TTAB’s holding and declared the disparagement provision facially invalid.⁵¹ Subsequently, the United States government appealed to the Supreme Court of the United States where it ultimately lost.⁵² Although the Supreme Court’s decision, discussed below, “d[id] not dictate the facial invalidity of the immoral-scandalous

⁴⁵ *In re Hershey*, 6 U.S.P.Q.2d 1470, 1471 (T.T.A.B. Mar. 10, 1988); *see also Matal v. Tam*, 137 S. Ct. 1744, 1756 n.5 (2017).

⁴⁶ *See Tam*, 137 S. Ct. at 1756 n.5; *In re Brunetti*, 877 F.3d at 1355.

⁴⁷ *Tam*, 137 S. Ct. at 1755.

⁴⁸ *Id.* at 1754.

⁴⁹ *Id.*

⁵⁰ *Id.*

⁵¹ *Id.*

⁵² *Id.*

provision,”⁵³ the Federal Circuit adopted and applied the Court’s analysis in reaching its conclusion in *Brunetti*.

Like Mr. Tam, Eric Brunetti challenged the constitutionality of the immoral or scandalous provision under the First Amendment. At issue before the Federal Circuit was the rejection of Mr. Brunetti’s trademark application for his clothing brand, “FUCT.”⁵⁴ The examining attorney rejected the mark because he “reasoned” the word FUCT is similar to the past tense of the vulgar word “fuck.”⁵⁵ Dissatisfied, Mr. Brunetti challenged the examiners’ determination and appealed to the TTAB, which denied his plea.⁵⁶ After rejecting two of Mr. Brunetti’s arguments, the court focused on his constitutional challenge.⁵⁷ In both instances, the reviewing court engaged in an analysis of the corresponding provision as a regulation of commercial and expressive speech.⁵⁸

A. Commercial Speech

Commercial speech “does no more than propose a commercial transaction.”⁵⁹ Under First Amendment jurisprudence, commercial speech receives protection from “unwarranted governmental regulation.”⁶⁰ Commercial speech, however, receives less protection than that provided to other forms of guaranteed expression.⁶¹ Accordingly,

⁵³ *In re Brunetti*, 877 F.3d at 1357 (Dyk, J., concurring).

⁵⁴ *Id.* at 1337 (majority opinion).

⁵⁵ *Id.*

⁵⁶ *Id.*

⁵⁷ *See id.* at 1337, 1339, 1340.

⁵⁸ *Compare Tam*, 137 S. Ct. at 1763–65 and *Tam*, 137 S. Ct. at 1765–69 (Kennedy, J., Concurring) with *In re Brunetti*, 877 F.3d at 1348–55.

⁵⁹ *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976) (internal citation omitted).

⁶⁰ *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 557 (1980).

⁶¹ *Id.* at 562–63.

courts apply “relaxed” or “intermediate” scrutiny standards when examining regulations involving commercial speech.⁶² Whether the regulation passes constitutional muster depends on the outcome of the analysis described by the Supreme Court in *Central Hudson*.⁶³ Under the *Central Hudson* analysis, the reviewing court must consider whether: (1) the speech concerns lawful activity and is not misleading; (2) the regulation serves a substantial government interest; (3) the regulation directly advances the government interest; and (4) the regulation is narrowly tailored.⁶⁴

1. Tam

While the government proffered several arguments in favor of the disparagement provision’s constitutionality,⁶⁵ the Court rejected them all. Instead, the Court focused on “a dispute between the parties[:]” whether trademarks are commercial speech.⁶⁶ The government argued *all* trademarks are commercial speech because they assist consumers in identifying the source of goods and services.⁶⁷ Furthermore, federal regulation of trademarks promotes “fair and orderly interstate commerce.”⁶⁸ In contrast, Mr. Tam argued, and the Court recognized that “many, if not all, trademarks [also] have an expressive component.”⁶⁹ Often trademarks say something more about the product, service, or a larger issue while identifying the source. For instance,

⁶² See, e.g., *Tam*, 137 S. Ct. at 1763.

⁶³ *Cent. Hudson Gas & Elec. Corp.*, 447 U.S. at 557 (1980).

⁶⁴ *Id.* at 566.

⁶⁵ See *Tam*, 137 S. Ct. at 1757 (“[T]he Government contends (1) that trademarks are government, not private speech, (2) that trademarks are a form of government subsidy, and (3) that the constitutionality of the disparagement clause should be tested under a new ‘government-program’ doctrine.”).

⁶⁶ *Id.* at 1763.

⁶⁷ See *id.* at 1764

⁶⁸ *Id.*

⁶⁹ *Id.*

consumers may prefer Adidas over Nike athletic wear due to sweatshop accusations against the latter.⁷⁰ Similarly, The Slants simultaneously identifies Mr. Tam's band while expressing a view on social issues.⁷¹ Indeed, "powerful messages can sometimes be conveyed in just a few words."⁷²

Half of the Court, joining an opinion by Justice Alito, recognized the importance of the commercial speech question.⁷³ They refused to resolve it, however, because the disparagement provision could not survive the *Central Hudson* analysis.⁷⁴ According to Alito's opinion, the disparagement provision failed both the second and fourth prongs.⁷⁵ The interest claimed by the government—protecting of underrepresented groups from harassment—struck at the "proudest boast of [the Court's] free speech jurisprudence"—the freedom to express unpopular opinions.⁷⁶ Alito's opinion also refused to find the provision narrowly tailored due to its breadth.⁷⁷ The provision allowed the USPTO to deny registration for trademarks disparaging *all* persons (living or dead), groups, and institutions.⁷⁸ The breadth of denial was well beyond that necessary to prevent interference with the government's interest in the orderly flow of interstate commerce.⁷⁹ Accordingly, the Court declared the disparagement provision unconstitutional.⁸⁰

⁷⁰ See generally Marc Bain, *Nike is Facing a New Wave of Anti-Sweatshop Protests*, QUARTZ (Aug. 1, 2017), <https://qz.com/1042298/nike-is-facing-a-new-wave-of-anti-sweatshop-protests/> [<https://perma.cc/M37D-MG2A>].

⁷¹ *Tam*, 137 S. Ct. at 1764.

⁷² *Id.* at 1760.

⁷³ See *id.* at 1763–64.

⁷⁴ *Id.* at 1764.

⁷⁵ *Id.*

⁷⁶ *Id.*

⁷⁷ *Id.* at 1764–65

⁷⁸ *Id.*

⁷⁹ *Id.* at 1765.

⁸⁰ *Id.*

2. Brunetti

Based on the government’s “alternative argument” that trademarks were commercial speech, the Federal Circuit looked to *Tam* for guidance and applied the *Central Hudson* analysis to the immoral or scandalous provision.⁸¹ Unlike the Supreme Court, the Federal Circuit analyzed all four prongs.⁸² The immoral or scandalous provision “clearly” satisfied the analysis’s first prong.⁸³ The provision’s concern is offensive language, not “misleading, deceptive, or unlawful marks.”⁸⁴ Like the disparagement provision, the court determined the immoral or scandalous provision failed to advance a substantial government interest.⁸⁵ The interests identified by the government—protecting public order and morality, shielding examiners, and encouraging non-scandalous marks in commerce—did not justify the suppression of speech the government sought.⁸⁶

Even if the court acknowledged the substantiality of the government’s claimed interests, the immoral or scandalous provision did not directly advance them, for rejecting an applicants’ application for federal trademark protection does not prevent them from using and exposing the public to their mark(s).⁸⁷ Thus, “to the extent that the government seeks to protect the general population from scandalous material . . . it has completely failed.”⁸⁸ Furthermore, regardless of the government’s interest, the immoral or scandalous provision was not narrowly

⁸¹ See *In re Brunetti*, 877 F.3d at 1340–42.

⁸² Compare *Tam*, 137 S. Ct. at 1763–65 with *In re Brunetti*, 877 F.3d at 1350–55.

⁸³ See *In re Brunetti*, 877 F.3d at 1350.

⁸⁴ *Id.* at 1350.

⁸⁵ See *id.* at 1350–51.

⁸⁶ *Id.*

⁸⁷ *Id.* at 1353.

⁸⁸ *Id.*

tailored.⁸⁹ The USPTO inconsistently applied a vague and subjective test to applications it reviewed for scandalousness.⁹⁰ Often, “[n]early identical marks [were] approved by one examining attorney and rejected as scandalous or immoral by another.”⁹¹ Accordingly, the court held the immoral or scandalous provision unconstitutional under intermediate scrutiny.⁹² Both courts also found the provisions unconstitutional under the more exacting scrutiny used for regulations of expressive speech.⁹³

B. Expressive Speech

Laws targeting the expressive part of a message are among the most egregious types of speech-based government regulations. Indeed, “it is a fundamental principle of the First Amendment that the government may not punish or suppress speech based on disapproval of the ideas or perspectives the speech conveys.”⁹⁴ Such regulations “are presumptively invalid,” and are only sustainable if they can survive strict scrutiny.⁹⁵ Strict scrutiny requires the government to “prove that the restriction furthers a compelling interest and is narrowly tailored to achieve that interest.”⁹⁶ There are “two distinct but related limitations” on expressive speech regulations:

⁸⁹ *Id.*

⁹⁰ *See id.* at 1353–55.

⁹¹ *Id.* at 1353–54.

⁹² *See id.* at 1355.

⁹³ *Compare Tam*, 137 S. Ct. at 1765 (Kennedy, J., Concurring) with *In re Brunetti*, 877 F.3d at 1348–49.

⁹⁴ *Tam*, 137 S. Ct. at 1765 (Kennedy, J., concurring) (citing *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 828–29 (1995)).

⁹⁵ *See Rosenberger*, 515 U.S. at 830 (stating that viewpoint-based restrictions are presumptively unconstitutional); *R.A.V. v. City of St. Paul*, 505 U.S. 377, 382 (1992) (stating that content-based restrictions are presumptively unconstitutional).

⁹⁶ *In re Brunetti*, 877 F.3d at 1342 (quoting *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2231 (2015)).

content-based and viewpoint-based.⁹⁷ The Federal Circuit reviewed the former type of these regulations in *Brunetti*, while half of the Supreme Court reviewed the latter in *Tam*.⁹⁸

1. Immoral or Scandalousness (*Brunetti*) – A Content-Based Regulation

Simply stated, content-based regulations attempt to restrict a broad category or topic of discussion, regardless of the position espoused.⁹⁹ While the government argued in *Brunetti* for the viewpoint neutrality of the immoral or scandalous provision, the court refused to resolve that issue.¹⁰⁰ Instead, the court “conclude[d] the provision impermissibly discriminate[d] based on content in violation of the First Amendment.”¹⁰¹ The court, looking to the USPTO’s test for reviewing applications for scandalousness,¹⁰² determined “[t]here [was] no question that the immoral or scandalous prohibition target[ed] the expressive components of the speech.”¹⁰³ Under the immoral or scandalous provision, the USPTO could prevent registration of *all* speech it believed would offend a substantial composite of the general public.¹⁰⁴ Such decisions amounted to “value judgments about the expressive message behind the trademark” and had no relation to source identification.¹⁰⁵ Because the immoral or scandalous determination hinged on the expressive component of trademarks, the court concluded there was “no

⁹⁷ *Reed*, 135 S. Ct. at 2229–30.

⁹⁸ *Compare Tam*, 137 S. Ct. at 1765–69 (Kennedy, J., concurring) *with In re Brunetti*, 877 F.3d at 1348–49.

⁹⁹ *See Reed*, 135 S. Ct. at 2230.

¹⁰⁰ *In re Brunetti*, 877 F.3d at 1341.

¹⁰¹ *Id.*

¹⁰² *See In re Fox*, 702 F.3d at 635.

¹⁰³ *In re Brunetti*, 877 F.3d at 1349.

¹⁰⁴ *See id.*

¹⁰⁵ *Id.*

dispute” over the provision’s unconstitutionality under strict scrutiny.¹⁰⁶

2. Disparagement (*Tam*) – A Viewpoint-Based Regulation

Viewpoint discrimination is a “subtype” of content discrimination.¹⁰⁷ The test for viewpoint discrimination is, “[a]t its most basic,” whether the government has targeted a message, or subset of messages, for disfavor due to the view expressed.¹⁰⁸ According to Justice Kennedy, viewpoint discrimination “remains of serious concern in the commercial context.”¹⁰⁹ Because of this rule of law, Justice Kennedy, writing for half the Court in *Tam*, eschewed the commercial speech question and focused on the disparagement provision’s discriminatory nature.¹¹⁰

In rejecting trademark applications under the disparagement provision, the government engaged in “the essence” of viewpoint discrimination.¹¹¹ While marks expressing benign or positive messages about people, groups, or institutions received federal registration, the USPTO rejected offensive or derogatory marks regarding these same categories.¹¹² Although the disparagement provision affected all derogatory trademarks equally, the fact of the matter was that the provision denied registration to trademarks based on the message conveyed, and thus was

¹⁰⁶ *Id.*

¹⁰⁷ *Tam*, 137 S. Ct. at 1766 (Kennedy, J., concurring).

¹⁰⁸ *Id.* (citing *Cornelius v. NAACP Legal Defense & Ed. Fund, Inc.* 473 U.S. 788, 806 (1985)).

¹⁰⁹ *Id.* at 1767 (citing *Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60, 65, 71–72 (1983)).

¹¹⁰ *See id; supra* Part III.A for a discussion of the commercial speech question

¹¹¹ *Id.* at 1766.

¹¹² *See Tam*, 137 S. Ct. at 1766.

unconstitutional.¹¹³ While this was the end of the analysis for the Supreme Court, the Federal Circuit faced one additional issue: the possibility of finding a saving construction of the provision at issue.

IV. STOKING THE FIRE

A. *Kindling the Flame (Brunetti Majority)*

Although the court has a duty, when possible, to “construe statutes narrowly to preserve their constitutionality,” the majority did not believe this possible with the immoral or scandalous provision.¹¹⁴ Amalgamizing points from 1960’s precedent, the majority stated it is “permissible to construe a statute in a manner that preserves its constitutionality only where the construction is reasonable.”¹¹⁵ And, according to the majority, it was unreasonable to confine immorality and scandalousness to obscenity.¹¹⁶ For purposes of First Amendment cases, obscenity, as defined by the Supreme Court, is limited to “obscene material ‘which deals with sex,’” and is reviewed under the *Miller* test.¹¹⁷ While all obscene marks are immoral or scandalous because “the threshold for objectionable matter is lower for what can be described as ‘scandalous’ than for ‘obscene,’” the inverse is not true.¹¹⁸

Similarly, since the USPTO historically used the provision to bar religious marks in addition to obscene

¹¹³ *Id.* (citing *Rosenberger*, 515 U.S. at 831–32 (1995)) (“By mandating positivity, the law here might silence dissent and distort the marketplace of ideas.”).

¹¹⁴ *In re Brunetti*, 877 F.3d at 1355.

¹¹⁵ *Id.*

¹¹⁶ *Id.*

¹¹⁷ *Miller v. California*, 413 U.S. 15, 20 n.2 (1973). The *Miller* test is outlined *infra* Part VI.B.

¹¹⁸ *Brunetti*, 877 F.3d at 1355–56 (quoting *In re McGinley*, 660 F.2d 481, 487 n.9 (C.C.P.A. 1981)).

marks, the majority believed it wrong to limit the provision to obscenity. Such an argument, however, presupposes proper application of the immoral or scandalous provision historically by the USPTO.¹¹⁹ Furthermore, the majority noted that “none of the dictionary definitions [cited by the concurrence] define ‘immoral’ or ‘scandalous’ in sexual terms.”¹²⁰ Ironically, none of these definitions define immoral or scandalous in vulgar terms either—a reading the Federal Circuit itself endorsed in *In re Boulevard Entertainment, Inc.*¹²¹ Still, however, the majority believed it the job of the legislature, not the court, to limit the provision.

B. *Dousing the Flame (Brunetti Concurrence)*

By refusing to limit the immoral or scandalous provision to obscenity, Judge Dyk believed the majority ignored its duty to “construe statutes narrowly to preserve their constitutionality.”¹²² As opposed to the reasonableness standard the majority suggested, Judge Dyk, citing to more recent cases, noted that “[a] saving construction of a statute need only be ‘fairly possible,’ and ‘every reasonable construction must be resorted to.’”¹²³ Indeed, applying this standard, the Supreme Court has a “long history of narrowing the scope of [statutes similarly worded to the immoral or scandalous provision] to cover only obscene speech,” the “most prominent examples” are federal obscenity statutes.¹²⁴

¹¹⁹ See discussion *infra* Part VI.A.

¹²⁰ *In re Brunetti*, 877 F.3d at 1356.

¹²¹ *In re Blvd. Entm't*, 334 F.3d 1336, 1340 (Fed. Cir. 2003), *abrogated by In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015).

¹²² *In re Brunetti*, 877 F.3d at 1357 (Dyk, J., concurring).

¹²³ *Id.* at 1358 (quoting *Nat'l Fed'n of Indep. Bus. v. Sebelius*, 567 U.S. 519, 563 (2012)).

¹²⁴ *Id.*

At first, these statutes only covered the shipment of “obscene, lewd, or lascivious” materials.¹²⁵ Over time, Congress amended these definitions to cover a wider variety of materials. Still, the Supreme Court consistently “construed this broader language narrowly to apply only to obscenity in order to avoid constitutional doubts.”¹²⁶ Although the term “obscene” does not appear in the immoral or scandalous provision, the drafters’ refusal to include the term “suggests” there was no intention to “differentiate ‘immoral’ or ‘scandalous’ material from obscenity.”¹²⁷

Linguistically, immorality and scandalousness are closely related. Dictionary definitions from 1905 listed the two as synonyms. The words also share other mutual terms.¹²⁸ According to Judge Dyk, the combination of all these facts obligated the court to narrow the provision.¹²⁹ By holding the immoral or scandalous provision unconstitutional using the same analyses enunciated by the Supreme Court, the Federal Circuit opened the doors for much of, if not the rest of Section 2 and other sections of the Lanham Act to fall.

V. THE APOCALYPSE

After the Supreme Court’s decision in *Tam*, practicing attorneys and scholars began rumbling about the effect the decision would have on other provisions of the

¹²⁵ *Id.* (quoting *Swearingen v. United States*, 161 U.S. 446, 450 (1896) (internal quotations omitted)).

¹²⁶ *Id.* (citing *Hamling v. United States*, 418 U.S. 87, 114 (1974); *United States v. 12 200–Ft. Reels of Super 8mm. Film*, 413 U.S. 123, 129–30, 130 n.7 (1973); *Manual Enters., Inc. v. Day*, 370 U.S. 478, 482–83 (1962)).

¹²⁷ *Id.* at 1359.

¹²⁸ *Id.*

¹²⁹ *Id.* at 1360.

Lanham Act.¹³⁰ While *Tam* only gave a slight glimpse of the *Central Hudson* analysis applied to trademarks, *Brunetti* provided a full application of the analysis. Both decisions also fully demonstrated how strict scrutiny applies to trademarks.¹³¹ Together, these decisions created a guide for finding other sections, and nearly every other basis for refusal under Section 2 of the Lanham Act unconstitutional, undermining the purpose of the Act itself.

A. *The Dilution Provision*

Looking to strict scrutiny first, as the Federal Circuit did in *Brunetti*, the dilution provision is likely to fall as a form of viewpoint discrimination. Professor Rebecca Tushnet first suggested this outcome in a tweet on June 19, 2017, the day the Supreme Court released the *Tam* opinion.¹³² She directed her followers to her “pre-*Tam* writing,” *More than a Feeling: Emotion and the First Amendment*.¹³³ Therein, Professor Tushnet described dilution as “conduct that harms a trademark even in the absence of confusion, by ‘whittling away’ its value in some mysterious way.”¹³⁴ Trademark holders can use the dilution provision to “prevent[] commercial actors from interfering with the singular meaning of a mark even if no one is ever

¹³⁰ See, e.g., Rebecca Tushnet (@rtushnet), TWITTER (June 19, 2017, 8:00 AM), <https://twitter.com/rtushnet/status/876816965813379073> [<https://perma.cc/E8EJ-LRXP>] (post and reply messages).

¹³¹ *Compare Tam*, 137 S. Ct. at 1765–69 (2017) (Kennedy, J., concurring) with *In re Brunetti*, 877 F.3d at 1348–49.

¹³² See, e.g., Rebecca Tushnet (@rtushnet), TWITTER (June 19, 2017, 8:00 AM), <https://twitter.com/rtushnet/status/876816965813379073> [<https://perma.cc/E8EJ-LRXP>] (post and reply messages).

¹³³ Rebecca Tushnet (@rtushnet), TWITTER (June 19, 2017, 12:27 PM), <https://twitter.com/rtushnet/status/876884044402892802> [<https://perma.cc/UPD9-H57Y>].

¹³⁴ Rebecca Tushnet, *More Than a Feeling: Emotion and the First Amendment*, 127 HARV. L. REV. 2392, 2396 (2014).

mistaken about any fact at all.”¹³⁵ This protection spans beyond the acknowledged commercial purpose of trademarks, source identification, and into the meaning of the brand itself.¹³⁶

Effectively, the provision provides a vehicle through which influential and well-known brands can protect their marks from disparagement.¹³⁷ This issue is very similar, if not identical to Justice Alito’s issue with the disparagement provision in *Tam*.¹³⁸ The only marks subject to civil enjoinder or barred from federal registration are those that cast famous marks in a poor light.¹³⁹ In viewpoint discrimination terms, the provision targets trademarks “the government has singled out [as] a subset of messages for disfavor based on the views expressed.”¹⁴⁰ Similar to the disparagement provision, which covered all persons, institutions, beliefs, and national symbols, the dilution provision covers all famous marks.¹⁴¹

The provision itself only references marks that harm or impair the famous mark’s reputation;¹⁴² there is no issue with marks that enhance or promote a famous mark. Simply put, the “law[] reflects the Government’s disapproval of a subset of messages it finds offensive [to other trademarks].”¹⁴³ Accordingly, if the disparagement provision could not survive strict scrutiny as a form of viewpoint discrimination, it is doubtful the dilution provision could survive either. Further, it is unlikely that the

¹³⁵ *Id.* at 2398.

¹³⁶ *See id.* at 2401.

¹³⁷ *See id.* at 2403.

¹³⁸ *See Tam*, 137 S. Ct. at 1764–65.

¹³⁹ *See Tushnet*, *supra* note 134 at 2401.

¹⁴⁰ *Tam*, 137 S. Ct. at 1766 (2017) (Kennedy, J., concurring) (citing *Cornelius*, 473 U.S. at 806.).

¹⁴¹ *Compare* 15 U.S.C. § 1052(a) (2012) *with* 15 U.S.C. § 1125(c) (2012).

¹⁴² *See* 15 U.S.C. § 1125(c) (2012).

¹⁴³ *Tam*, 137 S. Ct. at 1766 (Kennedy, J., concurring).

dilution provision could pass muster under intermediate scrutiny.

Like the immoral or scandalous provision, the dilution provision “clearly meets the first prong of the *Central Hudson* test.”¹⁴⁴ The dilution provision “does not address misleading, deceptive, or unlawful marks[;]” rather, it targets marks that “impair” or “harm” famous marks.¹⁴⁵ That is as far as the provision gets, however, as it quickly fails the second prong of the analysis.

The Federal Circuit acknowledged that “the government does not have a substantial interest in promoting certain trademarks over others.”¹⁴⁶ By design, the dilution provision favors famous trademarks over their non-famous counterparts. Indeed, when the Judiciary Committee presented the Trademark Dilution Act to Congress, the provision’s stated purpose was to “protect famous trademarks from subsequent uses that blur the distinctiveness of the mark or tarnish or disparage it, even in the absence of a likelihood of confusion.”¹⁴⁷ As such, it is unlikely that the government could proffer, or that a court could infer, a substantial interest capable of saving the provision.

However, if the provision could somehow survive the second prong, it is possible that a court would find the provision directly advanced the government’s interest, thus surviving the third prong. Unlike the disparagement and immoral or scandalous provisions, the dilution provision allows famous mark owners to prevent the use of the diluting mark(s)—section (c)(1) grants the ability to sue to enjoin the use of the diluting mark through a civil suit.¹⁴⁸

¹⁴⁴ *In re Brunetti*, 877 F.3d at 1350.

¹⁴⁵ *Id.*

¹⁴⁶ *Id.* at 1351; *see also* Tushnet, *supra* note 30 (noting the same).

¹⁴⁷ H.R. REP. NO. 104-374, at 2 (1995) (Conf. Rep.).

¹⁴⁸ 15 U.S.C. § 1125(c)(1) (2012).

The fourth prong—whether the provision is narrowly tailored—also creates an interesting question in and of itself. Some courts invoke the dilution analysis in parody cases,¹⁴⁹ while others believe the dilution analysis is non-applicable because parodies are a protected form of non-commercial speech.¹⁵⁰ Although this is different from the “inconsistent application” that plagued the immoral or scandalous provision,¹⁵¹ the Federal Circuit suggested inconsistent application is one in the same regardless of the context in which it arises. In *Brunetti*, the Federal Circuit cited to a Supreme Court case dealing with the inconsistency of terms within the Communications Decency Act when it stated that inconsistent application creates “uncertainty [that] undermines the likelihood that the [provision] has been carefully tailored.”¹⁵² The dilution provision is not the only section of the Lanham Act facing these issues, however.

B. Other Provisions

As Professor Tushnet noted in her blog article on December 20, 2017, several other provisions of the Lanham Act would fail the *Central Hudson* analysis.¹⁵³ Specifically, Professor Tushnet named the deceptiveness and descriptiveness provisions.¹⁵⁴ Upon closer examination, however, the deceptiveness provision falls outside the scope of *Central Hudson* and thus could not fail the analysis. According to the Supreme Court, “there can be no constitutional objection to the suppression of commercial

¹⁴⁹ See, e.g., *World Wrestling Fed’n Entm’t Inc. v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413, 443 (W.D. Pa. 2003).

¹⁵⁰ See, e.g., *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 906 (9th Cir. 2002).

¹⁵¹ *In re Brunetti*, 877 F.3d at 1353.

¹⁵² *Id.* (quoting *Reno v. Am. Civil Liberties Union*, 521 U.S. 844, 871 (1997)) (alterations in original).

¹⁵³ See Tushnet, *supra* note 30.

¹⁵⁴ See *id.*

messages that do not accurately inform the public about lawful activity.”¹⁵⁵ This category also includes misleading or *deceiving* messages.¹⁵⁶ Logically, it follows that this First Amendment principle also shields the deceptiveness provision from heightened scrutiny.¹⁵⁷

So, while the deceptiveness provision could survive both forms of First Amendment scrutiny, it seems there is nothing left to protect the rest of Section 2. As Professor Tushnet suggested, each provision ultimately fails the third prong: “§ 2[] does not directly prevent applicants from using their marks.”¹⁵⁸ If courts continue to scrutinize Section 2 of the Lanham Act like the majority in *Brunetti*, all that may remain are the deceptiveness and likelihood of confusion provisions.¹⁵⁹ If courts instead followed the canon of construction suggested by Judge Dyk’s concurrence in *Brunetti*,¹⁶⁰ they may find a panacea capable of saving the Lanham Act’s provisions.

VI. A PANACEA

A. *Aiding the Fight*

Stripping away the terms “immoral” or “scandalous,” and looking just at the judicially accepted definition of the phrase, marks depicting obscene material naturally fit the bill. By declaring the immoral or scandalous provision unconstitutional, and refusing to limit it to

¹⁵⁵ *Cent. Hudson Gas & Elec. Corp.*, 447 U.S. at 563.

¹⁵⁶ *See id.* at 563–64; Va. State Bd. of Pharmacy, 425 U.S. at 771; *In re Brunetti*, 877 F.3d at 1350.

¹⁵⁷ *See Cent. Hudson Gas & Elec. Corp.*, 447 U.S. at 563.

¹⁵⁸ *In re Brunetti*, 877 F.3d at 1353; Tushnet, *supra* note 30.

¹⁵⁹ *See* Tushnet, *supra* note 30 (stating the likelihood of confusion test may survive the third prong but would likely fail the fourth prong of the *Central Hudson* analysis).

¹⁶⁰ *See supra* Part IV.B for the discussion of Judge Dyk’s concurring opinion.

obscenity, the majority blatantly ignored the definitional match and instead opened the door for the proliferation of discomfiting marks.¹⁶¹

As referenced in Part IV.A *supra*, though not a point raised by Judge Dyk, the majority’s argument in *Brunetti* presupposes proper application of the immoral or scandalous provision by the USPTO historically. In rejecting the obscenity limitation, the majority relied on the fact that “many of the early cases applying the immoral or scandalous provision involved blasphemous marks touching on religion, which were not obscene.”¹⁶² At the same time, the majority noted, however, that “[b]ecause the scandalousness determination is made in the context of contemporary attitudes, the concept of what is actually immoral or scandalous changes over time.”¹⁶³ The fact that examiners used the provision to strike down religious words or symbols during the 1930s,¹⁶⁴ a period of religious involvement in the lives of those affected by the Great Depression,¹⁶⁵ does not mean this application was proper in and of itself at the time and should control today.

Indeed, in *In re Riverbank Canning Co.*, the first case dealing with the immoral or scandalous provision,¹⁶⁶ two judges dissented, refuting the majority’s logic for rejecting the registration of the term “Madonna” for wine.¹⁶⁷ If

¹⁶¹ *In re Brunetti*, 877 F.3d at 1355, 1357.

¹⁶² *Id.* at 1355–56.

¹⁶³ *Id.* at 1336.

¹⁶⁴ See cases cited in *In re Brunetti*, 877 F.3d at 1336.

¹⁶⁵ The Gale Group, *Religion 1931–1939*, ENCYCLOPEDIA.COM (2002), <https://www.encyclopedia.com/education/news-and-education-magazines/religion-1931-1939> [<https://perma.cc/GS72-WRFB>]; Levi Fox et al., *Religion During the Depression*, THE NEW YORKER MAGAZINE (Oct. 13, 1934), <http://xroads.virginia.edu/~ug02/newyorker/religion.html> [<https://perma.cc/P99T-9ZFX>].

¹⁶⁶ See *In re Riverbank Canning Co.*, 95 F.2d at 328; *In re Brunetti*, 877 F.3d at 1336.

¹⁶⁷ See *In re Riverbank Canning Co.*, 95 F.2d at 329–31.

anything, the fact that the USPTO, after rejecting the mark twice,¹⁶⁸ finally granted registration for “Madonna” wine in 2008 signals this change.¹⁶⁹

Of course, the movement away from barring registration of religious words or symbols coincides with a shift in contemporary attitudes.¹⁷⁰ Recently, “the vast majority of [US]PTO rejections under the immoral-scandalous provision . . . have related to sex.”¹⁷¹ Similarly, the focus of the cases which the Federal Circuit has reviewed under the immoral or scandalous provision is the same—sex.¹⁷² It is difficult to comprehend the “unreasonable[ness]” of limiting the immoral or scandalous provision to obscenity when USPTO examining attorneys, claiming to act on contemporary attitudes, primarily reject marks related to sex.¹⁷³

Even more “unreasonable” is the majority’s conclusion, which “leaves the government with no authority to prevent the registration of even the most patently obscene marks.”¹⁷⁴ Such a conclusion is inconsistent with the accepted purpose of the immoral or scandalous provision. As previously mentioned, no legislative history exists to discern the Congressional intent in passing the immoral or scandalous provision.¹⁷⁵ Still, however, the principal of legislative inaction suggests Congress consented to the USPTO’s use of the provision to bar registration of marks that are “shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . giving offense to the conscience or moral feelings; . . . or calling out

¹⁶⁸ See *In re Brunetti*, 877 F.3d at 1336.

¹⁶⁹ MADONNA, Registration No. 3,545,635.

¹⁷⁰ See *In re Brunetti*, 877 F.3d at 1360, 1360 n.8 (Dyk, J., concurring).

¹⁷¹ *Id.* at 1360.

¹⁷² See *id.* at 1360, 1360 n.7.

¹⁷³ See *id.* at 1360.

¹⁷⁴ *Id.* at 1360–61.

¹⁷⁵ See *supra* note 13 and accompanying text.

for condemnation.”¹⁷⁶ If anything falls within this definition, it is obscene material. By refusing to limit the immoral or scandalous provision to obscenity, the Federal Circuit has exposed the public to potential marks much worse than anything anticipated by the framers of the immoral or scandalous provision.

B. The Magic Bullet: Obscenity and Application of the Obscenity Test

Under the immoral or scandalous provision, the TTAB refused registration of Brad Francis Sherman’s “Sex Rod” mark¹⁷⁷ and Both Worlds, Inc.’s logo of “a dog in the act of defecating.”¹⁷⁸ In addition to finding the marks scandalous, the TTAB found both marks unregistrable on disparagement grounds.¹⁷⁹ Given the unconstitutionality of the disparagement and immoral or scandalous provisions, both marks would now be able to receive federal registration, no questions asked.¹⁸⁰ If the obscenity limitation implored by Judge Dyk was the applicable standard, however, the

¹⁷⁶ *In re Brunetti*, 877 F.3d at 1336 (internal quotations omitted).

¹⁷⁷ *Boston Red Sox Baseball Club Ltd. P’ship v. Sherman*, 88 U.S.P.Q.2d 1581, 1593 (T.T.A.B. Sept. 9, 2008).

SEX ROD

¹⁷⁸ *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d 1635, 1641 (T.T.A.B. Mar. 30, 1988).



¹⁷⁹ *Id.*; *Boston Red Sox Baseball Club Ltd. P’ship*, 88 U.S.P.Q.3d at 1593.

¹⁸⁰ The T.T.A.B. also rejected Both World’s mark because “it is likely to cause confusion with [Greyhound’s] running dog symbol.” *Greyhound Corp.*, 6 U.S.P.Q.2d at 1641. However, for purposes of this article, this ground is irrelevant.

analysis for Both World's logo becomes a much closer question.

In *Miller v. California*, the Supreme Court enunciated a three-prong test for determining whether an item depicts or describes obscene material.¹⁸¹ Under this test, courts must ask:

- (a) whether the average person, applying contemporary community standards would find that the work, taken as a whole appeals to the prurient interest; (b) whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law; and (c) whether the work, taken as a whole, lacks serious literary, artistic, political or scientific [SLAPS] value.¹⁸²

While the Both World logo does not patently fall within the elements of the *Miller* Test, it does fall within the “plain examples of what a state could define for regulation under part (b) of the [*Miller* Test].”¹⁸³ These examples include representations or descriptions of ultimate sexual acts, normal or perverted, actual or simulated; masturbation; excretory functions; and lewd genital exhibition.¹⁸⁴ Because

¹⁸¹ *Miller*, 413 U.S. at 19–20, 22–24.

¹⁸² *Id.* at 24 (internal citations omitted). While an important part of applying the *Miller* test, defining the applicable contemporary community standard for use in a national register is beyond the scope of this article. For more thoughts on defining this standard, see Christopher Thomas McDavid, Comment, *I Know It When I See It: Obscenity, Copyright, and the Cautionary Tale of the Lanham Act*, 47 U. LOUISVILLE L. REV. 561, 567 (2009) (discussing the application of a community standard to a federal provision in the context of copyright); Lindsey M. Hay, “*The Taste of Any Public*”: *How Intellectual Property Law Illuminates the Failings of the Miller Test*, 45 SW. L. REV. 165, 180–81 (2015) (comparing the difficulties of defining community and local standards).

¹⁸³ *Miller*, 413 U.S. at 24–25.

¹⁸⁴ *See id.* at 25.

the logo depicts an excretory function,¹⁸⁵ its eligibility for registration would turn on the outcome of the judicial inquiry—particularly whether the logo has any serious artistic value.

Typically, the work depicted or described is “the best evidence of what [it] represents,” and thus, the use of expert or lay testimony is unnecessary in obscenity cases.¹⁸⁶ Although the logo is unsightly and may cause some discomfort to viewers, that does not remove the artistic value. Indeed, artists have long used stool as a medium, albeit in different forms, for their art. Pablo Picasso allegedly used his daughter’s excrement as a paint;¹⁸⁷ Piero Manzoni famously canned his feces and sold it as *Artist’s Shit*;¹⁸⁸ Andres Serrano displayed sixty-six photos of poop at the Yvon Lambert Gallery in New York.¹⁸⁹ Even amateurs

¹⁸⁵ See *Greyhound Corp.*, 6 U.S.P.Q.2d at 1641



¹⁸⁶ See *Paris Adult Theatre I v. Slaton*, 413 U.S. 49, 56 (1973).

¹⁸⁷ Richard Johnson, *Pablo Picasso Used Daughter’s Feces as Paint*, PAGE SIX (Oct. 30, 2016, 3:47 PM), <https://pagesix.com/2016/10/30/pablo-picasso-used-daughters-feces-as-paint/amp/> [<https://perma.cc/AM7C-N3FZ>].

¹⁸⁸ *Piero Manzoni, Artist’s Shit, 1961*, TATE, <http://www.tate.org.uk/art/artworks/manzoni-artists-shit-t07667> [<https://perma.cc/BZZ8-GX3X>] (last visited Apr. 23, 2018).

¹⁸⁹ Lynn Yaeger, *Andres Serrano’s ‘Shit’ Show*, VILLAGE VOICE (Aug. 27, 2008, 10:43 AM), <https://www.villagevoice.com/2008/08/27/andres-serranos-shit-show/> [<https://perma.cc/GQJ2-JL67>]. Andres Serrano is best known for his controversial photo entitled *Piss Christ*, which depicts a plastic crucifix submerged in a glass tank of Serrano’s urine (another form of bodily excrement). See, e.g., Amanda Holpuch, *Andres Serrano’s Controversial Piss Christ Goes on View in New York*, THE GUARDIAN (Sept. 28, 2012), <https://www.theguardian.com/artanddesign/2012/sep/28/andres-serrano-piss-christ-new-york> [<https://perma.cc/EAH8-6SWL>].

dabbling in fecal painting attracts a large crowd.¹⁹⁰ If pictures and paintings that portray (or are made of) actual feces have artistic merit, there is no reason to deny the Both World's logo artistic merit for the defecation it displays.

This conclusion remains true when one compares Both World's logo to a piece of "art" declared obscene by a jury, Ira Isaacs's *Hollywood Scat Amateurs No. 7*.¹⁹¹ While Mr. Isaacs argued his scat videos were a constitutionally protected form of shock art, neither the jury nor his porn industry peers agreed.¹⁹² In fact, these videos were so offensive that Mr. Isaacs's attorney could not even bear to watch them.¹⁹³ Clearly, there is a line as to what constitutes obscenity when it comes to poop. And, in this author's opinion, Both World's Logo falls on the artistic side of the line.

Looking forward, even the Federal Circuit conceded that its decision would result in the proliferation of marks that are "lewd, crass, or even disturbing."¹⁹⁴ Indeed, it is not hard to imagine an application for a design mark depicting a

¹⁹⁰ John Metcalfe, *A Gloriously Offensive, Poop-Based Art Show Opens in San Francisco*, CITYLAB (Aug. 9, 2013), <https://www.citylab.com/design/2013/08/gloriously-offensive-art-show-san-francisco-i-poop-you/6476/> [<https://perma.cc/6VGY-BM8J>].

¹⁹¹ Victoria Kim & Aida Ahmad, *Fetish Filmmaker Convicted of Obscenity Charges*, LOS ANGELES TIMES (Apr. 28, 2012), <http://articles.latimes.com/2012/apr/28/local/la-me-obscenity-trial-20120428> [<https://perma.cc/8SLK-VXFW>].

¹⁹² The Associated Press, *Adult Film Producer Convicted in Obscenity Trial*, N.Y. DAILY NEWS (Apr. 27, 2012, 8:54 PM), <http://www.nydailynews.com/news/national/adult-film-producer-convicted-obscenity-trial-article-1.1068971> [<https://perma.cc/Z6WZ-5HPV>].

¹⁹³ Frank Shyong, *Maker of Porn Films Gets 4 Years in Prison in Federal Obscenity Case*, LOS ANGELES TIMES (Jan. 16, 2013, 2:09 PM), <http://latimesblogs.latimes.com/lanow/2013/01/porn-filmmaker-prison-sentence-obscenity.html> [<https://perma.cc/JCC9-BTH5>].

¹⁹⁴ *In re Brunetti*, 877 F.3d at 1357.

male penis described as a “big veiny triumphant bastard.”¹⁹⁵ Likewise, a logo depicting a male penis ejaculating is likely not too unimaginative for some industries to want as a trademark. Another conceivable example is that of stick figure silhouettes engaged in sexual acts to represent a brand of sex toys or sex shop. Honestly, the list of what people could choose to identify their goods with is endless.

Under the majority’s holding in *Brunetti*, the public will face an onslaught of these marks. If the immoral or scandalous provision were limited to the obscene, however, such marks would be unregistrable. At the least, individuals genuinely desiring to register trademarks teetering on the edge of obscenity would have to design their logos with greater taste than if no bar existed. The obscenity requirement would prevent the worst images, while still allowing those with artistic value to obtain registration and receive federal protection as source identifiers. While the definition of the immoral or scandalous provision matches well with obscenity, and the analysis is, for the most part, easily applied to trademarks,¹⁹⁶ the job may be harder when it is time to analyze other provisions. While there may not be a perfect match for courts to draw upon, they should still develop a method to save Section 2’s provisions where possible.

VII. CONCLUSION

The Lanham Act’s purpose is to “guard[] the trademark owner against trademark infringement and unfair competition, and the public against confusion and inaccurate information.”¹⁹⁷ While the unconstitutionality of the disparagement and immoral or scandalous provisions does not affect this purpose, the analyses invoked by the Supreme

¹⁹⁵ *SUPERBAD* (Columbia Pictures 2007).

¹⁹⁶ See *Miller*, 413 U.S. at 24; *supra* note 182 and accompanying text.

¹⁹⁷ See *Nesvold & Pollard*, *supra* note 3.

Court and U.S. Court of Appeals for the Federal Circuit may. As this article demonstrates, these analyses also apply to several other provisions of the Lanham Act. If challenged, courts may find these other provisions also unconstitutionally violate First Amendment freedom of speech principles. If that occurs, marks capable of infringing or causing confusion will flood the market, severely undermining the stated purpose of the Lanham Act. Courts need to construe statutes narrowly to preserve their constitutionality and, where possible, adopt a saving construction of the provisions of the Lanham Act to prevent this result.

Although the Federal Circuit refused to find a saving construction of the immoral or scandalous provision in *Brunetti*, Judge Dyk's concurring opinion provides guidance as to how courts can save the Lanham Act's provisions. Where possible, courts should interpret the Lanham Act's provisions to match already existing judicial analyses. Since application of the obscenity limitation to the immoral or scandalous provision is reasonable, if the government appeals the Federal Circuit's holding, the Supreme Court should grant cert and declare Judge Dyk's interpretation correct. This limitation is necessary not only to protect the marketplace from the proliferation of offensive marks but also to set the tone to save the Lanham Act from an apocalyptic meltdown.

