



the federal circuit strikes ban on registering "immoral" or "scandalous" trademarks

MSK Client Alert

December 28, 2017

The U.S. Court of Appeals for the Federal Circuit ("Federal Circuit") has struck down the Lanham Act's ban on the registration of "immoral" or "scandalous" trademarks as an unconstitutional restriction of free speech under the First Amendment. See *In re: Erik Brunetti*, No. 2015-1109 (Fed. Cir. Dec. 15, 2017). The ruling comes less than six months after the U.S. Supreme Court's decision in *Matal v. Tam*, 137 S. Ct. 1744 (2017), in which it similarly struck down the Lanham Act's ban on "disparaging" marks as unconstitutional under the First Amendment.

In *In re: Erik Brunetti*, the Federal Circuit reversed the Trademark Trial and Appeal Board's ("Board") ruling that the mark FUCT is not registrable for various items of apparel because it is a derivative of the word "fucked," and therefore comprises immoral or scandalous matter under Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a). The Federal Circuit held that while the Board did not err in concluding that the mark is vulgar, and therefore scandalous, Section 2(a)'s "bar on registering immoral or scandalous marks is an unconstitutional restriction of free speech."

The Federal Circuit concluded that the test used by the U.S. Patent and Trademark Office to prohibit immoral or scandalous marks, which is whether a "substantial composite of the general public" would find the mark "shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; giving offense to the conscience or moral feelings; or calling out for condemnation," targets the expressive components of speech, and makes value judgments about the expressive messages behind trademarks.

View Full Alert

practice areas

entertainment & ip litigation
intellectual property