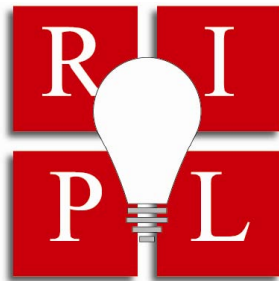


# THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



## THE F WORD - AN EARLY EMPIRICAL STUDY OF TRADEMARK REGISTRATION OF SCANDALOUS AND IMMORAL MARKS IN THE AFTERMATH OF THE *IN RE BRUNETTI* DECISION

VICENC FELIU

### ABSTRACT

This article seeks to create an early empirical benchmark on registrations of marks that would have failed registration as “scandalous” or “immoral” under Lanham Act Section 2(a) before the Court of Appeals for the Federal Circuit’s *In re Brunetti* decision of December 2017 and to briefly examine the possible outcome of the Supreme Court’s grant of *certiorari* on that case. The *Brunetti* decision followed closely behind the Supreme Court’s *Matal v. Tam* and put an end to examiners denying registration on the basis of Section 2(a). In *Tam*, the Supreme Court reasoned that Section 2(a) embodied restrictions on free speech, in the case of “disparaging” marks, which were clearly unconstitutional. The Federal circuit followed that same logic and labeled those same Section 2(a) restrictions as unconstitutional in the case of “scandalous” and “immoral” marks. Before the ink was dry in *Brunetti*, commentators wondered how lifting the Section 2(a) restrictions would affect the volume of registrations of marks previously made unregistrable by that same section. Predictions ran the gamut from “business as usual” to scenarios where those marks would proliferate to astronomical levels. A little more than a year out from *Brunetti*, it is hard to say with certainty what could happen, but this study has gathered the number of registrations as of March of 2019 and the early signs seem to indicate a future not much altered, despite early concerns to the contrary. In January 2019 the Supreme Court agreed to review the Federal Circuit’s decision and that review will lead to clarification on whether scandalous and immoral marks are also protected by the First Amendment. Shortly before publication of this article, on June 24th, 2019, the Supreme Court decided the *Brunetti* case. In essence, the Court upheld the Federal Circuit’s decision maintaining the unconstitutionality of Section 2(a) restrictions on registration of “scandalous” and “immoral” marks. A short postscript analyzing the Supreme Court’s decision concludes this article.

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Cite as Vicenc Feliu, *The F Word - An Early Empirical Study of Trademark Registration of Scandalous and Immoral Marks in the Aftermath of the In re Brunetti Decision*, 18 J. MARSHALL REV. INTELL. PROP. L. 404 (2019).

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I. INTRODUCTION

To a company or an artist trying to create a recognizable brand, especially in a crowded field, a name can be everything. Some businesses and artists have historically chosen edgier names or brands to help their product stand out from the “run of the mill.” Those more daring souls willing to use edgier, less traditional marks generally ran afoul of federal trademark law when trying to obtain protection for their marks through federal registration if their marks were considered to be immoral, scandalous or disparaging.<sup>1</sup> The provisions in the Lanham Act against immoral, scandalous or disparaging marks were struck down by a couple of decisions in 2017.<sup>2</sup> Commentators worried about the repercussions of both decisions, predicting that the registration system would either be flooded with scandalous mark applications<sup>3</sup> or that nothing much would change.<sup>4</sup> This article seeks to look at the results of those decisions striking down the provisions against scandalous marks and to establish an early benchmark on those results for future study.

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<sup>1</sup> Lanham Act § 2(a), 15 U.S.C. § 1052 (2012).

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead .

<sup>2</sup> *Matal v. Tam*, 137 S. Ct. 1744 (2017); *In re Brunetti*, 877 F.3d 1330 (Fed. Cir. 2017).

<sup>3</sup> David A. Bell, Jason P. Bloom & Wesley Lewis, *New Law: Federal Circuit Finds Ban On Scandalous/Immoral Trademarks Unconstitutional*, HAYNESBOONE (Jan. 3, 2018), <http://www.haynesboone.com/Alerts/ban-on-scandalous-immoral-trademarks-unconstitutional> (“The impact of this decision will extend well beyond Carlin’s seven dirty words; indeed, the subjective nature of how to apply 2(a) has resulted in a wide swath of refused marks that now may be suitable for registration.”).

<sup>4</sup> Christina S. Loza, *Matal v. Tam: Disparaging Trademarks, Like the Slants, Can Be Registered Trademarks*, ORANGE COUNTY LAW. 24, 27 (2017) (“There is, of course, a concern that the floodgates have been opened. Will every hateful person file marks and begin filling our Trademark Register with racial slurs? There is certainly a chance.”).

## II. BACKGROUND

American trademark law recognizes three kinds of trademark rights: common law, state registration rights and the rights obtained through federal registration.<sup>5</sup> Common law rights arise from first use of a mark in commerce in a geographical location.<sup>6</sup> Therefore, common law rights are “limited to the territory in which the mark is known and recognized” as a source indicator by the public.<sup>7</sup> Because common law rights arise from use, there is no registration procedure, and the person wishing to use the mark merely needs to begin using it.<sup>8</sup> However, because of the lack of registration in common law use, there is no public record of the right to use or when use began.<sup>9</sup> All states in the US have some sort of trademark registration procedures that allows a person or business entity using a mark in commerce to record the use of that mark.<sup>10</sup> State registration confers upon the user a record of use but does not grant protection beyond the geographical borders of the state. State registration is cheaper than federal registration but does not really grant the mark owner much beyond the limits of common law rights.<sup>11</sup> While federal registration of a mark is not a prerequisite for use of that mark in commerce, registration provides the mark with certain expanded benefits.<sup>12</sup> Federal registration gives the trademark owner the right to use the registered trademark symbol; the right to file a trademark infringement lawsuit in federal court and to obtain monetary remedies, including infringer’s profits, damages, costs and, in some cases, treble damages and attorneys’ fees. It also bars the registration of other confusingly similar marks, and it can serve

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<sup>5</sup> See generally James M. Treece & David Stephenson, *A Look at American Trademark Law*, 29 SW. L.J. 547, 547 (1975).

<sup>6</sup> *Cornaby’s LLC v. Carnet, LLC*, No. 2:14-cv-00462-JNP-DBP, 2017 U.S. Dist. LEXIS 130716, at \*17 (D. Utah Aug. 15, 2017). (“[C]onsistent[] use[] [of] the Ultra Gel mark in Idaho and Utah[] create[ed] common law trademark rights in those states.”).

<sup>7</sup> See *In re Tam*, 808 F.3d 1321, 1328 (Fed. Cir. 2015) (en banc), *as corrected* (Feb. 11, 2016), *aff’d sub nom.*, *Matal v. Tam*, 137 S. Ct. 1744 (2017).

<sup>8</sup> *Cornaby’s LLC v. Carnet, LLC*, No. 2:14-cv-00462-JNP-DBP, 2017 U.S. Dist. LEXIS 130716, at \*12 (D. Utah Aug. 15, 2017) (“Rights in a trademark are determined by the date of the mark’s first use in commerce.”).

<sup>9</sup> Robert S. Bramson, *Intellectual Property as Collateral - Patents, Trade Secrets, Trademarks and Copyrights*, 36 BUS. LAW. 1567, 1604 (1981) (“[T]rademark rights exist independent of any registration or application .”).

<sup>10</sup> *State Trademark Registration in the United States*, INT’L TRADEMARK ASS’N, <https://www.inta.org/TrademarkBasics/FactSheets/Pages/StateTrademarkRegistrationsUSFactSheet.aspx> (last updated July 2014). (“The United States has a two-tiered system of trademark protection: federal and state. . . . [A] state registration gives the registrant trademark rights only within the territory of the state.”).

<sup>11</sup> *Id.* (“A federal registration has priority over a state trademark registration .”).

<sup>12</sup> Lanham Act § 1, 15 U.S.C. § 1051 (2012) (“The owner of a trademark used in commerce may request registration of its trademark on the principal register . . .”). The Lanham Act establishes two national trademark registries. See *id.* The Principal Register for trademarks that are being “used in commerce” or those to which the applicant has a “bona fide” intent to use in commerce in the near future. See *id.* §§ 1(a)(1), (b)(1), §§ 1051(a)(1), 1051(b)(1), and the Supplemental Register for trademarks that are “capable of distinguishing the applicant’s goods or services” but not yet registrable on the Principal Register. See *Id.* § 23(a), § 1091. However, as § 1(a)(1) indicates, the owner of the mark may also use that mark in commerce without the benefit of registration relying on the protection of common law rights. *Id.* §§ 1(a)(1), 1051(a)(1).

as the basis for an international trademark application.<sup>13</sup> Registration provides a statutory presumption that the mark is valid, the registrant is the owner of the mark and the registrant has the exclusive right to use the registered mark.<sup>14</sup> Without the *prima facie* presumption of validity provided by registration, the mark owner must take the route of legal action to prove ownership and validity of the mark.<sup>15</sup> Registration gives the registrant nationwide priority to use the mark based on the filing date and allows the mark to become incontestable after five years on the Principal Register, giving the registrant exclusive right, subject to certain statutory defenses, to use the mark.<sup>16</sup> After five consecutive years of continuous use in commerce, a registered mark will acquire the status of incontestable.<sup>17</sup> Incontestability does not mean that the mark is invincible but it does give the mark owner a stronger position by underscoring the mark's validity and making it safe from attack on the grounds that the mark lacks distinctiveness.<sup>18</sup> Finally, registration confers a long list of additional rights to the mark holder, including recovery of treble damages for willful infringement,<sup>19</sup> complete defense against state or common law claims of dilution,<sup>20</sup> right to prevent cyber squatters' misappropriation of domain names,<sup>21</sup> the ability to block importation of infringing goods into the U.S.,<sup>22</sup> and a simplified process for international registration with the Madrid Protocol.<sup>23</sup> These benefits make registration a desirable step, and any

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<sup>13</sup> See 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:9 (5th ed. 2018).

<sup>14</sup> 15 U.S.C. § 1057(b) (2012) ("A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark.").

<sup>15</sup> Retail Servs., Inc. v. Freebies Publ'g, 364 F.3d 535, 542 (4th Cir. 2004) ("Under the Lanham Act, the issuance of a certificate of registration arms the registrant with "prima facie evidence of the validity of the registered mark.").

<sup>16</sup> MCCARTHY, *supra* note 13, § 19:3; see also *id.* § 19:9 (listing seven of the "procedural and substantive legal advantages" of registration).

<sup>17</sup> 15 U.S.C. § 1065 (2012)

[T]he right of the owner to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable.

<sup>18</sup> Retail Servs., 364 F.3d at 548 ("The validity of the same registered mark, after qualifying for incontestable status, is conclusively presumed and may not be challenged as merely descriptive.").

<sup>19</sup> 15 U.S.C. § 1117(b) (2012) ("Treble damages for use of counterfeit mark").

<sup>20</sup> 15 U.S.C. § 1125(e)(6) (2012) ("Ownership of valid registration a complete bar to . . . with respect to that mark, that—

(A) is brought by another person under the common law or a statute of a State; and

(B)(i) seeks to prevent dilution by blurring or dilution by tarnishment .").

<sup>21</sup> § 1125(d) ("Cyberpiracy prevention").

<sup>22</sup> 15 U.S.C. § 1124 (2012) ("Importation of goods bearing infringing marks or names forbidden"); 19 U.S.C. § 1526(a)

Importation prohibited

Except as provided in subsection (d) of this section, it shall be unlawful to import into the United States any merchandise of foreign manufacture if such merchandise, or the label, sign, print, package, wrapper, or receptacle, bears a trademark owned by a citizen of, or by a corporation or association created or organized within, the United States, and registered in the Patent and Trademark Office.

<sup>23</sup> Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, as amended on September 28, 1979, 828 U.N.T.S. 389; see *International*

business owner or artist using a brand in commerce would be well advised to seek registration.<sup>24</sup> It is clear that without registration a trademark owner would be operating at a severe disadvantage in the marketplace. The common assertion that a trademark owner can still use a mark in commerce without federal registration<sup>25</sup> makes light of the cumulative advantages obtained through that registration.<sup>26</sup>

### III. *MATAL V. TAM*

At the end of the 2016 term the Supreme Court decided *Matal v. Tam*, striking down part of Section 2(a) of the Lanham Act by relying on the First Amendment Free Speech Clause.<sup>27</sup> *Matal v. Tam* came about as the result of Simon Tam’s attempt to register “The Slants” as a trademark for the Portland, Oregon, based Asian-American rock band he leads.<sup>28</sup> The members of the band believed that by choosing “The Slants”, a term often seen as a derogatory reference to Asian-Americans, they were consciously claiming a slur as a source of ethnic pride.<sup>29</sup> The United States Patent and Trademark Office (USPTO) examined Tam’s application and, after considering linguistic uses of the term “slants” as reflected in derogatory uses related to Asian-Americans, refused registration for the use of “The Slants” as a mark, considering the term to be “disparaging” to a substantial part of the Asian-American community.<sup>30</sup>

The USPTO’s refusal of registration led to an appeal to the Federal Circuit that challenged the conclusion of that mark as “disparaging,” and, more importantly, the

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*Applications/Madrid Protocol FAQs*, USPTO (Aug. 16, 2016, 12:19 AM), <https://www.uspto.gov/trademark/laws-regulations/madrid-protocol/international-applications/madrid-protocol-faqs>. (“Any trademark owner with an application filed in or a registration issued by the USPTO and who is a national of, has a domicile in, or has a real and effective industrial or commercial establishment in the United States can submit an international application through the USPTO.”).

<sup>24</sup> Lee Ann W. Lockridge, *Abolishing State Trademark Registrations*, 29 CARDOZO ARTS & ENT. L.J. 597, 605 (2011) (“[T]he incentives to pursue federal registration . . . are now so significant as to make federal registration indispensable for any owner making an informed decision about its trademark rights. A federal registration is the only rational choice . . .”).

<sup>25</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1752 (2017) (citing 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:8 (5th ed. 2018) (“Without federal registration, a valid trademark may still be used in commerce.”)).

<sup>26</sup> *Id.* at 1753 (quoting *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1317) (“Federal registration, however, confers important legal rights and benefits on trademark owners who register their marks.”).

<sup>27</sup> Lanham Act § 2(a); 15 U.S.C. § 1052(a) (2012); *See generally* *Tam*, 137 S. Ct. 1744.

<sup>28</sup> *See Tam*, 137 S. Ct. at 1751

This case concerns a dance-rock band’s application for federal trademark registration of the band’s name, “The Slants.” “Slants” is a derogatory term for persons of Asian descent, and members of the band are Asian-Americans. But the band members believe that by taking that slur as the name of their group, they will help to “reclaim” the term and drain its denigrating force.

<sup>29</sup> *See Tam*, 808 F.3d at 1331; *see also Tam*, 137 S. Ct. at 1754 (Mr. Tam named his band The Slants “to ‘reclaim’ and ‘take ownership’ of stereotypes about people of Asian ethnicity.”).

<sup>30</sup> *In re Tam*, 108 U.S.P.Q.2d (BNA) 1305, 1310 (T.T.A.B. 2013) (finding “THE SLANTS” mark to be disqualified from registration under Section 2(a) because “a substantial composite of the referenced group find the term objectionable”).

constitutionality of the provision in the Lanham Act that allowed the rejection of “disparaging” trademarks.<sup>31</sup> In its opinion, the Federal Circuit, sitting *en banc*, issued a major constitutional decision invalidating the disparagement provision of the Lanham Act, which had been in place since 1946, and that had been used since then to reject trademark registrations considered “disparaging” by trademark examiners.<sup>32</sup> This decision reversed the Federal Circuit’s own established precedent upholding Section 2(a)’s bar on “disparaging” trademarks as not conflicting with the First Amendment.<sup>33</sup>

The *Tam en banc* decision not only overturned the Federal Circuit’s precedent on “disparaging” marks but it also set forth a new approach to free speech challenges in the context of commercial speech.<sup>34</sup> This decision asserts that courts should conduct a strict review of the government’s actions when aimed at the expressive character of a mark, while acting leniently when reviewing actions directed at the commercial-speech function of the mark.<sup>35</sup> The Federal Circuit also reasoned that section 2(a) disparagement clause discriminated both on the basis of content and viewpoint.<sup>36</sup> The court thought that the disparagement clause discriminated in content as it “applies to particular speech because of the topic discussed.”<sup>37</sup> The court also held that when “[t]he PTO rejects marks under section 2(a) when it finds the marks refer to a group in a negative way, but []permits the registration of marks that refer to a group in a positive, non-disparaging manner[,]” § 2(a) discriminates on the basis of viewpoint.<sup>38</sup> Finally, because § 2(a) acted as a restriction denying registration only based on the mark’s perceived “disparaging” message, the section failed the strict scrutiny analysis for expressive speech.<sup>39</sup>

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<sup>31</sup> “Mr. Tam argues that the Board erred in finding the mark THE SLANTS disparaging under § 2(a) of the Lanham Act and therefore unregistrable. Mr. Tam also challenges the constitutionality of § 2(a).” *In re Tam (Tam Panel Decision)*, 785 F.3d 567, 569 (Fed. Cir. 2015), *reh’g en banc granted, opinion vacated*, 600 F. App’x 775 (Fed. Cir.), and *on reh’g en banc*, 808 F.3d 1321 (Fed. Cir.), *as corrected* (Feb. 11, 2016), *aff’d sub nom.*, *Matal v. Tam*, 137 S. Ct. 1744 (2017).

<sup>32</sup> See *In re Tam*, 808 F.3d at 1358 (holding that “the disparagement provision of § 2(a) is unconstitutional because it violates the First Amendment”).

<sup>33</sup> See *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) (holding that “[n]o conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant’s First Amendment rights would not be abridged by the refusal to register his mark [under Section 2(a)]”).

<sup>34</sup> See *In re Tam*, 808 F.3d at 1338 (“The disparagement provision must be assessed under First Amendment standards applicable to what it targets, which is not the commercial-speech function of the mark . . . This is not a government regulation aimed at the commercial component of speech.”).

<sup>35</sup> *Id.*

<sup>36</sup> *In re Tam*, 808 F.3d at 1334 (“The Disparagement Provision, Which Discriminates Based on Disapproval of the Message, Is Not Content or Viewpoint Neutral.”).

<sup>37</sup> *Id.* at 1335 (quoting *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2227 (2015)).

<sup>38</sup> *Id.* at 1336.

<sup>39</sup> *Id.* at 1337.

The government enacted § 2(a), and defends it today, because it is hostile to the messages conveyed by the refused marks. Section 2(a) is a viewpoint-discriminatory regulation of speech, created and applied in order to stifle the use of certain disfavored messages. Strict scrutiny therefore governs its First Amendment assessment—and no argument has been made that the measure survives such scrutiny.

The Supreme Court granted *certiorari* in 2016<sup>40</sup> and held oral arguments in early 2017 to finally settle the question of the disparagement clause's constitutionality.<sup>41</sup> By mid-2017 the court issued a plurality opinion striking down the disparagement clause as unconstitutional and affirming the Federal Circuit's earlier decision.<sup>42</sup> In affirming that decision, the Court cemented the holding that trademarks are not a form of government speech or a government subsidy or program.<sup>43</sup> The Court explained that if private speech were to be "passed off as government speech by simply affixing a government seal of approval" the government would be free to "silence or muffle the expression of disfavored viewpoints."<sup>44</sup> As a result of this decision, and despite the fact that the wording of section 2(a) remains unaltered, the USPTO may no longer refuse marks on the grounds that it finds them to be disparaging.

#### IV. *IN RE BRUNETTI*

*Matal v. Tam* settled the issue of the disparaging clause's constitutionality but left unaddressed the same question on immoral or scandalous marks. In 2013 Eric Brunetti attempted to register the mark FUCT, for use in apparel, as a coined acronym for "Friends yoU Can't Trust."<sup>45</sup> The USPTO promptly refused registration on grounds that the mark violated section 2(a) of the Lanham Act as "scandalous" or "immoral."<sup>46</sup> Brunetti sought an appeal from the Trademark Trial and Appeal Board (TTAB), but the Board affirmed the examiner's refusal to register the mark on the same grounds, that the mark was scandalous.<sup>47</sup> Brunetti then appealed to the Federal Circuit and that court agreed with the Board that the mark was vulgar and therefore immoral and scandalous.<sup>48</sup> The Court came to the conclusion that FUCT is phonetically identical to the vulgarity for which it is a homonym and as such failing on the grounds of the scandalous clause of section 2(a).<sup>49</sup> The Court looked at definitions of "scandalous" including "shocking to the sense of truth, decency, or propriety," "giving offense to the conscience or moral feelings," or "disgraceful,"

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<sup>40</sup> *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2016), *cert. granted*, Lee v. Tam, 137 S. Ct. 30 (Sept. 29, 2016) (No. 16-174).

<sup>41</sup> Oral Argument, Lee v. Tam, 137 S. Ct. 30 (2016) (No. 15-1293), [https://www.supremecourt.gov/oral\\_arguments/audio/2016/15-1293](https://www.supremecourt.gov/oral_arguments/audio/2016/15-1293)[<https://perma.cc/Q49XA9SU>]; see also Marcia Coyle & Tony Mauro, *Gorsuch's SCOTUS Vote Could Soon Prove Decisive on Many Cases; Senate Confirms Gorsuch 54-45 to Fill Scalia Vacancy*, NAT'L L.J. (Apr. 7, 2017), <http://www.nationallawjournal.com/id=1202783207725/GorsuchsSCOTUS-Vote-Could-Soon-Prove-Decisive-on-Many-Cases?slreturn=20170906141452>[<https://perma.cc/4LX9-SRUN>].

<sup>42</sup> See generally *Matal v. Tam*, 137 S. Ct. 1744. Chief Justice Roberts and Justices Breyer and Kennedy joining Justice Alito's opinion, with Justices Ginsburg, Sotomayor, and Kagan joining Justice Kennedy's concurrence.

<sup>43</sup> *Id.* at 1757-64.

<sup>44</sup> *Id.* at 1758.

<sup>45</sup> *In re Brunetti*, 877 F.3d 1330, 1339 (2017).

<sup>46</sup> *Id.* at 1337.

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

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

<sup>49</sup> *Id.* ("[T]he word 'fuct' is defined by Urban Dictionary as the past tense of the verb 'fuck' and pronounced the same as the word 'fucked,' and therefore found it is 'recognized as a slang and literal equivalent of the word 'fucked,' with 'the same vulgar meaning.'").



“offensive,” or “disreputable” and concluded that Brunetti’s argument that a vulgar mark would not necessarily be scandalous was invalid.<sup>50</sup> However, based on the rationale of *Matal v. Tam*, the Federal Circuit concluded that the bar on registration of such scandalous marks, like that on disparaging marks, violated the First Amendment.<sup>51</sup> Consequently, the Court reversed the Board’s decision on the registrability of the mark and allowed registration.<sup>52</sup> With that reversal of the Board’s decision the bar on registration of scandalous marks was effectively removed. The USPTO, however, filed a Petition for Writ of Certiorari which the Supreme Court granted in January 2019.<sup>53</sup> In the petition, the USPTO recognized the Supreme Court’s ruling in *Matal v. Tam*, but it sought review arguing that Section 2(a)’s prohibition against scandalous marks should be treated differently.<sup>54</sup> The USPTO concluded that “[Section 2(a)] does not prohibit any speech, proscribe any conduct or restrict the use of any trademark.”<sup>55</sup> Rather, “[t]he scandalous-marks provision simply reflects Congress’s judgment that the federal government should not affirmatively promote the use of graphic sexual images and vulgar terms by granting them the benefits of registration.”<sup>56</sup> The point of the USPTO’s argument in the petition for the Writ of Certiorari was that Section 2(a) does not prohibit or restrict speech, but establishes permissible eligibility requirements for a federal trademark registration – requirements that are properly viewpoint-neutral.<sup>57</sup>

## V. DISCUSSION

In 2015, Professor Megan Carpenter and, then law student, Mary Garner published an article based on their empirical study of scandalous trademarks.<sup>58</sup> Their study analyzed which marks were rejected under section 2(a) and what evidence was used to reject those marks.<sup>59</sup> By looking at the marks actually being rejected they compiled a number of key terms considered “immoral” or “scandalous” by the examiners.<sup>60</sup> In order to narrow the scope of this study, we followed the position of the Federal Circuit in *Brunetti* on vulgar marks<sup>61</sup> and looked at the level

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<sup>50</sup> *Id.* (“We have previously held “the PTO may prove scandalousness by establishing that a mark is ‘vulgar.’” We are bound by these holdings.”). *Id.* (citations omitted).

<sup>51</sup> *Id.* at 1341 (“The Court explained the disparagement provision ‘offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend.’”).

<sup>52</sup> *Id.* at 1357 (“We hold that the bar in § 2(a) against immoral or scandalous marks is unconstitutional because it violates the First Amendment. We reverse the Board’s holding that Mr. Brunetti’s mark is unregistrable under § 2(a).”).

<sup>53</sup> *Iancu v. Brunetti*, 877 F.3d 1330 (7th Cir.), *cert. granted*, 139 S.Ct. 782 (2019).

<sup>54</sup> *See generally*, Pet. For Writ of Cert., *Iancu v. Brunetti*, 139 S.Ct. 782 (2019) (No. 18-302).

<sup>55</sup> Pet. For Writ of Cert. at 10, *Iancu v. Brunetti*, 139 S.Ct. 782 (2019) (No. 18-302).

<sup>56</sup> *Id.* at 12.

<sup>57</sup> *Id.* at 19 (“As the Court’s *Tam* decision establishes, such criteria must be viewpoint-neutral to survive Free Speech Clause review.”).

<sup>58</sup> Megan M. Carpenter & Mary Garner, *NSFW: An Empirical Study of Scandalous Trademarks*, 33 CARDOZO ARTS & ENT. L.J. 321 (2015).

<sup>59</sup> *Id.* at 321. (“This study analyzes which marks are being rejected, what evidence is being used to reject them, and who the applicants are.”).

<sup>60</sup> *See generally id.*

<sup>61</sup> *In re Brunetti*, 877 F.3d at 1337.

of registrations after that decision. Like Justice Stewart before them<sup>62</sup>, the Federal Circuit did not define the meanings of "vulgar," "immoral," and "scandalous" in the *Brunetti* decision. The statute sets "immoral" and "scandalous" as distinct kinds of marks, yet the analysis by TTAB and the courts has focused on registration of "scandalous" marks.<sup>63</sup> "The reported decisions reflect courts' treatment of "scandalous" alone as the standard, or use the two terms together or interchangeably."<sup>64</sup> Those three terms: "vulgar," "scandalous" and "immoral," are similar to, and perhaps even synonymous with, the meaning of the Federal Communications Commission's (FCC) term "indecent."<sup>65</sup>

For the purposes of this study we will use comedian George Carlin's "The Seven Words You Can Never Say on Television" ("Seven Words")<sup>66</sup> as a gauge to measure

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<sup>62</sup> In *Jacobellis v. Ohio*, a case in which Nico Jacobellis, the manager of a movie theater in Cleveland Heights, Ohio, was convicted of violating an Ohio obscenity statute by possessing and exhibiting "The Lovers," a French film depicting an unhappy marriage and the wife's falling in love with a young archaeologist, and including in the last reel an explicit, but fragmentary and fleeting, love scene, Justice Potter Stewart, wrote of obscenity:

I shall not today attempt further to define the kinds of material I understand to be embraced within that shorthand description; and perhaps I could never succeed in intelligibly doing so. But I know it when I see it, and the motion picture involved in this case is not that.

*Jacobellis v. Ohio*, 378 U.S. 184 at 197 (1964) (Stewart, J., concurring).

<sup>63</sup> M. Christopher Bolen, Richard J. Caira, Jr. & Jason S. Wood, *When Scandal Becomes Vogue: The Registrability of Sexual References in Trademarks and Protection of Trademarks from Tarnishment in Sexual Contexts*, 39 IDEA 435, 438 (1999) ("Although the statute appears to differentiate between 'immoral' and 'scandalous' as two separate types of unregistrable marks, examiners, the TTAB, and the courts have focused their registration analysis on the meaning of 'scandalous' rather than 'immoral.' The two words have been virtually treated as a single basis for refusal of registration.")

<sup>64</sup> *Id.* n.11 (citing *McGinley*, 660 F.2d at 484, 211 U.S.P.Q. at 672) ("deciding the case solely on 'scandalous' definition, while referring to statute's prohibition of 'immoral' or 'scandalous' marks; *In re Madsen*, 180 U.S.P.Q. (BNA) 334, 335 (Trademark Tr. & App. Bd. 1973) (TTAB considered registrability on 'immoral' or 'scandalous' grounds, holding that WEEK-END SEX was neither scandalous nor immoral as magazine title").

<sup>65</sup> *Obscene, Indecent and Profane Broadcasts*, FED. COMM'NS COMM'N, <https://www.fcc.gov/consumers/guides/obscene-indecnt-and-profane-broadcasts> (last updated/reviewed Sept. 13, 2017) ("Indecent content portrays sexual or excretory organs or activities in a way that does not meet the three-prong test for obscenity."). The three-pronged test alluded to in the FCC's page is the Miller test for obscenity established by the Supreme Court in *Miller v. California*. *Miller v. California*, 413 U.S. 15, 24 (1973) ("A state offense must also be limited to works which, taken as a whole, appeal to the prurient interest in sex, which portray sexual conduct in a patently offensive way, and which, taken as a whole, do not have serious literary, artistic, political, or scientific value.")

<sup>66</sup> "The Seven Words You Can Never Say on Television" or "Filthy Words" is a routine by comedian George Carlin in his 1972 comedy album "Class Clown," which enumerates a list of words not fit for transmission over the air. The Seven Words were not then, and are not now, a part of an official list issued by the FCC or any other government agency but, at the time, they were considered unsuitable for broadcast on public airwaves in the U.S. George Carlin, *The Seven Words You Can Never Say on Television*, Genius, <https://genius.com/George-carlin-the-seven-words-you-can-never-say-on-television-annotated> (last visited Nov. 13, 2018). A radio broadcast of Carlin's routine by WBAI, a Pacifica Foundation FM radio station in New York City, in 1973 led to a Supreme Court case, *Fed. Comm'ns Comm'n v. Pacifica Found.*, 438 U.S. 726 (1978), that upheld the FCC's ban on the Seven Words deciding that the words were "indecent but not obscene." *Id.* at 729. The Seven Words are: shit (word 1), piss (word 2), fuck (word 3), cunt (word 4), cocksucker (word 5), motherfucker (word 6) and tits (word 7).

the number of registrations that might have been denied as “immoral” or “scandalous” under section 2(a). We settled on the use of the Seven Words, taking a cue from early commentators that the *Brunetti* decision would “extend beyond Carlin’s seven dirty words,”<sup>67</sup> expecting that if that assertion were accurate, the Seven Words would provide an appropriate weather gauge for “immoral” or “scandalous” registrations. The Seven Words are not only concerned with the sex or sexual activities of the *Miller* test for obscenity but also include the “indecent content” of “excretory organs or activities” mentioned in the FCC guidelines.<sup>68</sup> The TTAB had not only refused registration to marks as immoral or scandalous under a sexual context but also for profanity or vulgarity.<sup>69</sup> We are conscious that when dealing with ideas of what constitutes “vulgar,” “scandalous” or “immoral,” perceptions change over time according to attitudes and community standards and, as such, we chose the Seven Words because they still fall within the FCC guidelines.<sup>70</sup>

### A. Methodology

In this study we looked at all the applications for registrations, live or dead, contained in the USPTO’s Trademark Electronic Search System (TESS) database<sup>71</sup> that might contain one or more of the Seven Words. We searched not only for the accurate spelling of the Seven Words but for alternative spellings as well because, as in the case of *Brunetti*’s FUCT registration, the USPTO had rejected alternative spellings or stand-ins for vulgarities before.<sup>72</sup> We included alternative or stand-in spellings along with the proper spellings of the Seven Words for a better picture of the dataset. Word marks that included any of the Seven Words but which were obviously not intended to be alternatives, stand in’s or double entendres for the original were systematically removed from the search results.<sup>73</sup> The date of the *Brunetti* decision, 15 December 2017, is used as a benchmark, and we divided our findings by registrations made before and after that date. Furthermore, we looked at the number of monthly registrations made after December 15<sup>th</sup> to determine if there was a noticeable trend either way.

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<sup>67</sup> See *supra* note 3.

<sup>68</sup> See *supra* note 60.

<sup>69</sup> See *In re Tinseltown, Inc.*, 212 U.S.P.Q. (BNA) 863, \*3 (T.T.A.B. 1981) (“[T]he fact that profane words may be uttered more freely does not render them any the less profane. Nor does this fact amend the statute by which we are required to determine the registrability of such matter as marks.”).

<sup>70</sup> See *supra* note 60.

<sup>71</sup> TRADEMARK ELECTRONIC SEARCH SYSTEM (TESS), USPTO, <http://tess2.uspto.gov/> (last updated Mar. 31, 2019).

<sup>72</sup> Nancy Friedman, *Trademarks the Government Doesn’t Want You to See*, STRONG LANGUAGE: A SWEARY BLOG ABOUT SWEARING (Sept. 29, 2015), <https://stronglang.wordpress.com/2015/09/29/guest-post-trademarks-the-government-doesnt-want-you-to-see/>. (“The USPTO will generally not register marks that are stand-ins for vulgar words.”).

<sup>73</sup> E.g., the word P’TIT, used as an alternative spelling for the French “petit” (small), which has no connection to the corresponding TIT in the Seven Words.

### B. Aftermath

“Less than a month after the decision in *Brunetti*, there were 63 applications for marks containing the word "FUCK" in its full, uncensored, and proper spelling.”<sup>74</sup> The following numbers will be a breakdown of the number of applications for registration before and after 15 December 2017 (the *Brunetti* date), by each of the Seven Words and the status of those registrations beginning with registrations containing Word 1 in all found forms and continuing with the remaining six words in the order they appear in Carlin’s “Filthy Words” routine.<sup>75</sup>

#### 1. Word 1

The numbers reflect that Word 1 is the most popular of the Seven Words among trademark registrants. As of the end of March 2019, there were 376 registrations in TESS containing the word.<sup>76</sup> Of those registrations, 269 were made before the *Brunetti* date with 167 in dead status and 102 in live status as of that date.<sup>77</sup> Of the 107 registrations done after *Brunetti*, only one is in dead status.<sup>78</sup> Monthly registrations for Word 1 hovered in the mid-single digits in 2018, with one exception: in March of 2018 the number of registrations spiked up to 17.<sup>79</sup>

**Table 1a:**

Before 12/15/17	Rest of Dec 2017	Jan 2018	Feb 2018	Mar 2018	April 2018	May 2018	Jun e 2018	
269	4	9	7	17	4	7	4	
July 2018	Aug 2018	Sept 2018	Oct 2018	Nov 2018	Dec 2018	Jan 2019	Feb 2019	Mar 2019
7	5	8	10	8	7	2	5	3

**Table 1b:**

Dead before 12/15/17	Live before 12/15/17	Dead after 12/15/17	Live after 12/15/17	Total
167	102	1	106	376

<sup>74</sup> Drew Wilson, *Slants Rule*, L.A. LAW., May 2018, at 30, 34.

<sup>75</sup> See *supra* note 66.

<sup>76</sup> See *infra* Table 1b.

<sup>77</sup> See *infra* Table 1a.

<sup>78</sup> See *infra* Table 1a.

<sup>79</sup> See *infra* Table 1a.

2. Word 2

Word 2 was not as popular with trademark registrants, coming in at number four with only 58 registrations by the end of March 2019.<sup>80</sup> A total of 50 registrations had been entered in TESS before the *Brunetti* date.<sup>81</sup> Of those early applications 38 were already in dead status by the *Brunetti* date, while twelve still survived fifteen months later.<sup>82</sup> Of the eight registrations submitted after the Brunetti date seven were still on live status in March, 2019.<sup>83</sup>

Table 2a:

Before 12/15/17	Jan 2018	Mar 2018	June 2018	Aug 2018	Nov 2018	Dec 2018	Mar 2019
50	1	1	1	2	1	1	1

Table 2b:

Dead before 12/15/17	Live before 12/15/17	Dead after 12/15/17	Live after 12/15/17	Total
38	12	1	7	58

3. Word 3

Following Word 1, Word 3 was the second most popular word with registrants with 378 attempts at registration.<sup>84</sup> Almost three quarters of those applications, a total of 273, were made before the *Brunetti* date, with 180 in dead status and 93 still live by March, 2019.<sup>85</sup> All of the 105 registrations done after *Brunetti*, were still in live status by March, 2019.<sup>86</sup> Like the registrations for Word 1, these registrations hovered in the single digits throughout the eleven months after *Brunetti*, with a spike of 11 in August, 2018 and another of 16 in February, 2019.<sup>87</sup>

Table 3a:

Before 12/15/17	Rest of Dec 2017	Jan 2018	Feb 2018	Mar 2018	April 2018	May 2018	June 2018	
273	5	9	4	9	10	4	3	
July 2018	Aug 2018	Sept 2018	Oct 2018	Nov 2018	Dec 2018	Jan 2019	Feb 2019	Mar 2019
8	14	5	3	2	6	4	16	3

<sup>80</sup> See *infra* Table 2b.

<sup>81</sup> See *infra* Table 2a.

<sup>82</sup> See *infra* Table 2a.

<sup>83</sup> See *infra* Table 2a.

<sup>84</sup> See *infra* Table 3b.

<sup>85</sup> See *infra* Table 3a.

<sup>86</sup> See *infra* Table 3a.

<sup>87</sup> See *infra* Table 3a.

**Table 3b:**

Dead before 12/15/17	Live before 12/15/17	Dead after 12/15/17	Live after 12/15/17	Total
180	93	0	105	378

*4. Word 4*

Word 4 was not a popular choice, ranking second from the bottom of the Seven Words, with only seven entries in TESS.<sup>88</sup> Of those seven entries, four were made before the *Brunetti* date and all are in dead status.<sup>89</sup> The three registrations made after *Brunetti* were all live by March, 2019.<sup>90</sup>

**Table 4a:**

Before 12/15/17	Jan 2018	Jun 2018
4	2	1

**Table 4b:**

Dead before 12/15/17	Live before 12/15/17	Dead after 12/15/17	Live after 12/15/17	Total
3	1	0	3	7

*5. Word 5*

The least popular of all entries with only three attempts before the *Brunetti* date and all three in dead status.<sup>91</sup> As of March 2019 there were no other attempted registrations for this word.

**Table 5a:**

Before 12/15/17
3

**Table 5b:**

Dead before 12/15/17	Live before 12/15/17	Dead after 12/15/17	Live after 12/15/17	Total
3	0	0	0	3

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<sup>88</sup> See *infra* Table 4b.

<sup>89</sup> See *infra* Table 4a.

<sup>90</sup> See *infra* Table 4a.

<sup>91</sup> See *infra* Tables 5a, 5b.

6. Word 6

With 19 total registrations, Word 6 is number five in terms of frequency on the list.<sup>92</sup> Of that number, 17 were made before the *Brunetti* date and only 4 of those were still live in March, 2019.<sup>93</sup> The two registrations made after *Brunetti* were still live as of March, 2019.<sup>94</sup>

**Table 6a**

Before 12/15/17	May 2018	Sep 2018
17	1	1

**Table 6b**

Dead before 12/15/17	Live before 12/15/17	Dead after 12/15/17	Live after 12/15/17	Total
13	4	0	2	19

7. Word 7

Word 7 was the third most popular choice among registrants with 111 entries total.<sup>95</sup> Before the *Brunetti* date, there were 99 entries with 77 in dead status by March 2019.<sup>96</sup> The 12 registrations made after the *Brunetti* date were all still in live status as of March 2019.<sup>97</sup>

**Table 7a:**

Before 12/15/17	Jan 2018	Jun 2018	Aug 2018	Oct 2018	Nov 2018	Dec 2018	Jan 2019	Feb 2019
99	1	1	1	5	1	1	1	1

**Table 7b:**

Dead before 12/15/17	Live before 12/15/17	Dead after 12/15/17	Live after 12/15/17	Total
77	22	0	12	111

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<sup>92</sup> See *infra* Table 6b.

<sup>93</sup> See *infra* Tables 6a, 6b.

<sup>94</sup> See *infra* Tables 6a, 6b.

<sup>95</sup> See *infra* Table 7b.

<sup>96</sup> See *infra* Tables 7a, 7b.

<sup>97</sup> See *infra* Table 7b.

## VI. CONCLUSION

Prior to *Brunetti*, the USPTO appeared “willing to register crude, sexually oriented or suggestive marks, as long as there (was) some “clean” association or symbol to defuse the scandalous alternative.”<sup>98</sup> That interpretation by the USPTO paved the way for registration of marks that could have been considered “scandalous” or “immoral” if they had alternative meanings. *Brunetti* changed the need for mental gymnastics by clearing the path based on the First Amendment argument used by the Supreme Court in *Tam*. While not widespread, there was some initial concern that the loosening of restraints would cause a dramatic increase in registration of marks formerly kept out by the restraints of Section 2(a).<sup>99</sup> With the request by the USPTO for review of the *Brunetti* it appears that the USPTO is unwilling to give up completely on Section 2(a) by arguing that “scandalous” or “immoral” marks are unlike “disparaging” marks in that the refusal to register “scandalous” or “immoral” marks do violate the constitutional limitations affording protection to speech because Section 2(a) is view-point neutral.<sup>100</sup> The Supreme Court has three options in this case. It could follow the precedent set by *Tam*, it could adopt the USPTO’s proposal from the petition for cert or it could adopt Judge Dyk’s concurring opinion in *Brunetti*. In his concurrence, Judge Dyk proposed that the court is “obligated to construe the statute as to avoid . . . constitutional questions.”<sup>101</sup> He reasons that Section 2(a) should be limited to only include obscene marks, which are not covered by the First Amendment.<sup>102</sup> Judge Dyk’s concurrence in *Brunetti* would appear to be a perfect solution for the Supreme Court. The Section 2(a) bar on disparaging and scandalous marks are really two different issues with different analysis. The *Tam* decision does not make that distinction clear but if the Supreme Court were to narrow the construction of Section 2(a) to obscenity, the USPTO would be able to keep the spirit of the section while preventing the registration of “the most patently obscene marks.”<sup>103</sup>

It is still too early to tell what the results of the *Tam* and *Brunetti* decisions will be on trademark registrations of formerly banned marks or what the Supreme Court will decide when hearing the case. However, this study indicates that for the time being there doesn’t seem to have been much of a flood behind the anticipated floodgates. It is quite possible that registrations for these types of marks may increase as *Tam* and *Brunetti* become entrenched in the marketplace of ideas, but, for now, there is no empirical support for the concern that will happen.

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<sup>98</sup> *Supra* note 58.

<sup>99</sup> *Supra* note 4.

<sup>100</sup> Pet. For Writ of Cert. at 19, *Brunetti*, 139 S.Ct. 782 (2019) (No. 18-302) (“Unlike the disparagement provision that the Court struck down in *Tam*, the scandalous-marks provision is viewpoint-neutral.”).

<sup>101</sup> *In re Brunetti*, 877 F.3d at 1358.

<sup>102</sup> *Id.* (“One such fairly possible reading is available to us here by limiting the clause’s reach to obscene marks, which are not protected by the First Amendment.”).

<sup>103</sup> *Id.* at 1361.



## VII. POSTSCRIPT

In June of 2019, the Supreme Court settled the question by upholding the Federal Circuit’s decision that Lanham Act’s Section 2(a) prohibition against registration of “immoral” or “scandalous” marks violates the First Amendment.<sup>104</sup> In her majority opinion, Justice Kagan emphasized that, to survive review, registration criteria for federal trademark protection must be viewpoint-neutral leading to the question of whether the immoral or scandalous bar is viewpoint-neutral or viewpoint based.<sup>105</sup> According to Kagan, the Act allows “registration of marks that champion society’s sense of rectitude and morality, but not marks that denigrate those concepts.”<sup>106</sup> By fostering exclusion of marks that defy the societal sense of decency and propriety, the Act distinguishes between two opposing sets of ideas resulting in viewpoint discrimination.<sup>107</sup> The majority opinion then centers on supporting *Tam*’s finding that a “law disfavoring ideas that offend discriminates based on viewpoint, in violation of the First Amendment.”<sup>108</sup>

The idea of a narrower bar preventing registration for vulgar terms proposed by Judge Dyk in his dissent at the Federal Circuit found traction with four of the Justices but that was not enough to carry it over the top.<sup>109</sup> Justice Sotomayor saw the majority’s finding of viewpoint discrimination as a failure to recognize that the terms “immoral” and “scandalous” do not present a unified standard.<sup>110</sup> Sotomayor proposes that “scandalous” standing alone is ambiguous and that the term can be narrowed to cover only “offensive modes of expression.”<sup>111</sup> She reasons that the statute uses the words “disparage” and “immoral” to cover “marks that are offensive because they are disparaging and marks that are offensive because they are immoral,”<sup>112</sup> but that “scandalous” should not be conflated with “immoral” as it can

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<sup>104</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294, 2302 (2019) (“There are a great many immoral and scandalous ideas in the world . . . and the Lanham Act cover them all. It therefore violates the First Amendment. We accordingly affirm the judgment of the Court of Appeals.”).

<sup>105</sup> *Id.* at 2299 (“[T]he criteria for federal trademark registration’ must be ‘viewpoint-neutral to survive Free Speech Clause review.’ . . . . So the key question becomes: Is the ‘immoral or scandalous’ criterion in the Lanham Act viewpoint-neutral or viewpoint-based?”) (internal citations omitted).

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

<sup>107</sup> *Id.* at 2300 (“[T]he Lanham Act allows registration of marks when their messages accord with, but not when their messages defy, society’s sense of decency or propriety. Put the pair of overlapping terms together and the statute, on its face, distinguishes between two opposed sets of ideas . . .”).

<sup>108</sup> *Id.* at 2301 (internal quotation marks omitted).

<sup>109</sup> Alito, Roberts, Breyer and Sotomayor all supported either a reading of the statute separating the interpretations of “immoral” and “scandalous” and narrowing the construction of “scandalous” to just those marks that could be considered vulgar or obscene (Roberts, Breyer and Sotomayor) or urging Congress to adopt a more carefully drawn version of the statute precluding registration for vulgar terms (Alito). See generally *id. at 2302* (Alito, J., concurring); *id. at 2303* (Roberts, C.J., concurring in part and dissenting in part); *id. at 2304* (Breyer, J., concurring in part and dissenting in part); *id. at 2308* (Sotomayor, J., joined by Breyer, J., concurring in part and dissenting in part).

<sup>110</sup> *Id.* at 2308 (Sotomayor, J., joined by Breyer, J., concurring in part and dissenting in part) (“The majority finds viewpoint discrimination here by treating the terms ‘scandalous’ and ‘immoral’ as comprising a unified standard . . .”).

<sup>111</sup> *Id.* at 2309.

<sup>112</sup> *Id.* at 2310.

cover a “distinct type of offensiveness: offensiveness in the mode of communication rather than the idea.”<sup>113</sup> Sotomayor believes that “[a]dopting a narrow construction for the word “scandalous”—interpreting it to regulate only obscenity, vulgarity, and profanity” can save the Section 2(a) from unconstitutionality.<sup>114</sup> Sotomayor worries that there may be a rush to register marks with vulgar, profane or obscene words as their primary feature and that the Government is left powerless to avoid that rush.<sup>115</sup> This short preliminary study proves that the rush really didn’t materialize after *Tam* and that it is unlikely that it will materialize because of this decision.

Sotomayor’s analysis of the statute is a solid interpretation of how Section 2(a) could have been saved allowing complete latitude to the First Amendment and yet using “scandalous” to prevent registration of obscene, vulgar or profane terms. She came close to carrying the day but ultimately, the three other Justices that agreed with her were not enough.

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

<sup>114</sup> *Id.* at 2313.

<sup>115</sup> *Id.* at 2308.