ARTICLE

FIXING WHAT'S BROKEN IN § 2 OF THE LANHAM ACT: BARRING REGISTRATION OF OBSCENE AND EGREGIOUSLY OFFENSIVE MARKS

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INTRODUCTION: ASSESSING WHAT'S BROKEN

When the Supreme Court declared the disparagement clause of § 2(a) of the Lanham Act unconstitutional in *Matal v. Tam*, a number of commentators correctly predicted that the immoral and scandalous prohibitions would soon meet

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the same fate[1] And in *Iancu v. Brunetti*, Justice Kagan, writing for the majority, held that the immoral and scandalous prohibitions of § 2(a) also run afoul of the First Amendment.[2] These events understandably lead us to wonder whether other prohibitions in § 2 can hold up under First Amendment scrutiny.[3] In the dissenting portion of his opinion, Justice Breyer succinctly notes that trademark law "by its very nature, requires the Government to impose limitations on speech."[4] He elaborates, noting that, "[t]rademark law, therefore forbids the registration of certain types of words—for example, those that will likely 'cause confusion' or those that are 'merely descriptive.'"[5] And in the lengthy dissenting portion of her opinion in *Brunetti*, Justice Sotomayor argues that the word "scandalous" should be construed "to regulate only obscenity, vulgarity, and profanity…[which] would save it from unconstitutionality."[6] Four Justices, writing separately in *Brunetti* – Chief Justice Roberts and Justices Alito, Breyer, and Sotomayor – emphatically state that Congress may write a statute that bars registration of a category of marks that are obscene and egregiously offensive. This article, relying in part on the arguments of those four justices, proposes ways that Congress might consider to amend the Lanham Act to that end.

Justice Sotomayor, while urging that the Court adopt a narrow construction of the word "scandalous" – which it did not – offers Congress a partial blueprint for amending § 2(a). She writes:

> Adopting a narrow construction for the word "scandalous"—interpreting it to regulate only obscenity, vulgarity, and profanity—would save it from unconstitutionality. Properly narrowed, "scandalous" is a viewpoint-neutral form of content discrimination that is permissible in the kind of

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[1] Matal v. Tam, 137 S. Ct. 1744, 1751 (2017).

[2] Iancu v. Brunetti, 139 S. Ct. 2294, 2297 (2019).

[3] In addition to the concern over the immoral and scandalous prohibitions, at least one other prohibition in § 2 has received recent attention. Section 2(c) forbids registration of marks that suggest affiliations with persons without their consent. This provision requires a balance between the First Amendment and the law relating to a person's right of publicity. For example, the U.S. Patent and Trademark Office refused registration for: OBAMA! I WANT MY COUNTRY, Registration No. 77,943,668 and ANYONE BUT TINYHANDS, Registration No. 87,654,919 (with a pictorial representation that clearly evoked President Trump). And in 2020, the TTAB affirmed the refusal to register TRUMP-IT. In re ADCO Indus. – Techs., L.P., 2020 WL 730361 (T.T.A.B. 2020). These rejections demonstrate that an individual's right of publicity supersedes another's putative First Amendment rights.

[4] *Brunetti*, 139 S. Ct. at 2306 (Breyer, J., dissenting).

[5] *Id.* (citing 15 U.S.C §§ 1052(d), (e)).

[6] *Id.* at 2313 (Sotomayor, J., with Breyer, J., concurring in part and dissenting in part); *see also id.* at 2308 ("Rather than read the relevant text as the majority does, it is equally possible to read that provision's bar on the registration of 'scandalous' marks to address only obscenity, vulgarity, and profanity."); *id.* at 2309 ("To say that a word or image is 'scandalous' can instead mean that it is simply indecent, shocking, or generally offensive.").

> discretionary governmental program or limited forum typified by the trademark-registration system.[7]

Now is an opportune time to reflect and to reconsider some of the goals of § 2 of the Lanham Act and its relationship to the free speech clause of the First Amendment. It is also an opportune time for Congress to amend § 2 in order to shore up the weaknesses that *Tam* and *Brunetti* have exposed.

Section 2 of the Lanham Act articulates reasons why an examining attorney may refuse registration.[8] The majority of these reasons involve false or misleading marks.[9] For example, §§ 2(a) and 2(e) prohibit registration of a mark that falsifies the derivative materials of the goods it represents.[10] Similarly, § 2(e) allows an examining attorney to refuse registration for a mark that misrepresents the geographical origin of the goods or services.[11] Further, § 2(d) forbids registration of a mark that is confusingly similar to another—in other words, if it is misleading.[12] Finally, § 2(c) prohibits registration of marks that suggest affiliations with non-consenting persons.[13] Therefore, § 2(c) effectively protects an individual's right of publicity and thus shields consumers from deceptive

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[7] *Id.* at 2313.

[8] The Lanham Act, 15 U.S.C. § 1052(a)-(f). In the *Brunetti* majority opinion, Justice Kagan acknowledges § 2's prohibitions:

> "[T]he Act directs the PTO to 'refuse registration' of certain marks. *Id.* § 1052. For instance, the PTO cannot register a mark that "so resembles" another mark as to create a likelihood of confusion. *Id.* § 1052(d). It cannot register a mark that is "merely descriptive" of the goods on which it is used. *Id.* § 1052(e). It cannot register a mark containing the flag or insignia of any nation or State. *See id.* § 1052(b). "There are five or ten more (depending on how you count)." *Brunetti*, 139 S. Ct. at 2298. Justice Breyer, in a similar fashion, remarks, "[t]rademark law therefore forbids the registration of certain types of words—for example, those that will likely 'cause confusion,' or those that are 'merely descriptive.'" *Id.* at 2306 (Breyer, J., concurring in part and dissenting in part) (citing 15 U.S.C. § 1052(d)-(e)).

He extends his point, noting: "[f]or that reason, an applicant who seeks to register a mark should not expect complete freedom to say what she wishes, but should instead expect linguistic regulation." *Id.*

[9] *See, e.g.*, *In re* Tam, 808 F.3d 1321, 1329 (Fed. Cir. 2015) ("Many of these categories bar the registration of deceptive or misleading speech, because such speech actually undermines the interests served by trademark protection and, thus, the Lanham Act's purposes in providing for registration.").

[10] 15 U.S.C. § 1052(a) (prohibiting "deceptive" marks); *id.* § 1052(e)(1) (prohibiting "deceptively misdescriptive" marks).

[11] *Id.* § 1052(e)(3) (prohibiting "primarily geographically deceptively misdescriptive" marks); *see also* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §14:23 (4th ed. 2017) (discussing false designation of geographic origin).

[12] 15 U.S.C. § 1052(d) (prohibiting marks "likely, . . . to cause confusion, or to cause mistake, or to deceive").

[13] *Id.* § 1052(c).

advertising – namely, a false impression of product endorsement.[14] Indeed, legions of cases definitively support this principle.[15]

Thus, the majority of reasons for refusal to register articulated in § 2 have the effect of preventing registration of false and/or misleading advertising. This may be important because the *Central Hudson* test – the Supreme Court's test regarding analysis of the relationship between commercial speech and the First Amendment – expressly supports the suppression of false and misleading advertising.[16] Marks that "may disparage" and marks that are "scandalous" and "immoral," however, are not necessarily either false or misleading. THE SLANTS, REDSKINS, and FUCT, for example, are trademarks which are neither misleading nor related to illegal activities.[17]

In the dissenting portion of her opinion, Justice Sotomayor expresses the view that there are indeed certain words, names, symbols, or devices that trademark law may prohibit on the basis that the putative mark is egregiously offensive:

> As for what constitutes "scandalous" vulgarity or profanity, I do not offer a list, but I do interpret the term to allow the PTO to restrict (and potentially promulgate guidance to clarify) the small group of lewd words or "swear"

[14] *See id.*

[15] *See* Haelan Lab'ys, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir. 1953); *see, e.g.*, Abdul-Jabbar v. Gen. Motors Corp., 85 F.3d 407 (9th Cir. 1996) (amended en banc); Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988); Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983); Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974); Henley v. Dillard Dep't. Stores, 46 F. Supp. 2d 587 (N.D. Tex. 1999); Zacchini v. Scripps-Howard Broadcasting Co., 351 N.E.2d 454 (Ohio 1976); Hirsch v. S.C. Johnson & Son, Inc., 280 N.W.2d 129 (Wis. 1979); s*ee also* Iancu v. Brunetti, 139 S. Ct. 2294, 2313 (2019) (Sotomayor, J., concurring in part and dissenting in part).

[16] *See In re Tam*, 808 F.3d at 1329 ("These restrictions on registration of deceptive speech do not run afoul of the First Amendment."); *see also* JOHN E. NOWAK & RONALD D. ROTUNDA, PRINCIPLES OF CONSTITUTIONAL LAW § 16.12(b), at 681 (4th ed. 2010) ("First, a court must determine whether the speech is truthful, nonmisleading speech concerning a lawful commercial activity."). Justice Breyer notes that the Supreme Court has not directly determined whether trademarks are, technically speaking, commercial speech: "The Court has not decided whether the trademark statute is simply a method of regulating pure 'commercial speech.'" *Brunetti*, 139 S. Ct. at 2305. Justice Breyer further explains, "[t]here may be reasons for doubt on that score. Trademarks, after all, have an expressive component in addition to a commercial one, and the statute does not bar anyone from speaking. To be sure, the statute does regulate the commercial function of trademarks." *Id.*

[17] *See* Kimberly A. Pace, *The Washington Redskins Case and the Doctrine of Disparagement: How Politically Correct Must a Trademark Be?*, 22 PEPP. L. REV. 7, 39 (1994) ("[I]mmoral, scandalous or disparaging marks are neither misleading nor fraudulent, and, therefore, the restraints on these marks do not fall outside the scope of First Amendment inquiries.").

> words that cause a visceral reaction, that are not commonly used around children, and that are prohibited in comparable settings.[18]

One of Justice Sotomayor's principal arguments urges that the Court interpret the word "scandalous" to prohibit such egregiously offensive vulgarities. As has been noted above in making her case, and as bears repeating, she states:

> Adopting a narrow construction for the word "scandalous"—interpreting it to regulate only obscenity, vulgarity, and profanity—would save it from unconstitutionality. Properly narrowed, "scandalous" is a viewpoint-neutral form of content discrimination that is permissible in the kind of discretionary governmental program or limited forum typified by the trademark-registration system.[19]

And as was mentioned briefly above, it is salient that, in addition to Justice Sotomayor, Chief Justice Roberts and Justices Alito and Breyer express the shared opinion that a carefully worded statute could bar registration of a certain group of egregiously offensive marks and simultaneously comport with the First Amendment's protection for freedom of speech. For example, Chief Justice Roberts writes, "refusing registration to obscene, vulgar, or profane marks does not offend the First Amendment . . . . The First Amendment protects the freedom of speech; it does not require the Government to give aid and comfort to those using obscene, vulgar, and profane modes of expression."[20] Justice Alito remarks: "[o]ur decision does not prevent Congress from adopting a more carefully focused statute that precludes the registration of marks containing vulgar terms that play no real part in the expression of ideas. The particular mark in question in this case could be denied registration under such a statute."[21] He continues his thought as follows:

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[18] *Brunetti*, 139 S. Ct. at 2311 (Sotomayor, J., with Breyer, J., concurring in part and dissenting in part) (footnote omitted).

[19] *Id.* at 2313. And each writing separately, Chief Justice Roberts and Justice Breyer agreed with Justice Sotomayor that the Court should construe the word "scandalous" narrowly to encompass a limited class of marks that are egregiously offensive. *See, e.g.*, *id.* at 2303 (Roberts, J., concurring in part and dissenting in part) ("As Justice Sotomayor explains, however, the "scandalous" portion of the provision is susceptible of such a narrowing construction. Standing alone, the term "scandalous" need not be understood to reach marks that offend because of the ideas they convey; it can be read more narrowly to bar only marks that offend because of their mode of expression—marks that are obscene, vulgar, or profane."); *id.* at 2304 (Breyer, J., concurring in part and dissenting in part) ("I agree with Justice Sotomayor that, for the reasons she gives, we should interpret the word "scandalous" in the present statute to refer only to certain highly "vulgar" or "obscene" modes of expression."); *id.* at 2308 (Breyer, J., concurring in part and dissenting in part) ("I would conclude that the prohibition on registering 'scandalous' marks does not "wor[k] harm to First Amendment interests that is disproportionate in light of the relevant regulatory objectives. I would therefore uphold this part of the statute.") (citations omitted).

[20] *Brunetti*, 139 S. Ct. at 2303-04 (Roberts, J., concurring in part and dissenting in part).

[21] *Id.* at 2303 (Alito, J., concurring). In fact, he adds that the problem "cannot be fixed without rewriting the statute." *Id.* at 2302.

> The term suggested by that mark is not needed to express any idea and, in fact, as commonly used today, generally signifies nothing except emotion and a severely limited vocabulary. The registration of such marks serves only to further coarsen our popular culture. But we are not legislators and cannot substitute a new statute for the one now in force.[22]

And Justice Breyer nearly perseverates on this point. According to Justice Breyer, "it is hard to see how a statute prohibiting the registration of only highly vulgar or obscene words discriminates based on 'viewpoint.'"[23] He expands his reasoning at length:

> Standing by themselves, however, these words do not typically convey any particular viewpoint. Moreover, while a restriction on the registration of highly vulgar words arguably places a content-based limit on trademark registration, it is hard to see why that label should be outcome-determinative here, for regulations governing trademark registration "inevitably involve content discrimination."[24]

Justice Breyer contends that a statute may constitutionally bar registration of egregiously offensive marks:

> How much harm to First Amendment interests does a bar on registering highly vulgar or obscene trademarks work? Not much. The statute leaves businesses free to use highly vulgar or obscene words on their products, and even to use such words directly next to other registered marks. Indeed, a business owner might even use a vulgar word as a trademark, provided that he or she is willing to forgo the benefits of registration.[25]

He concludes that, "[t]he Government has at least a reasonable interest in ensuring that it is not involved in promoting highly vulgar or obscene speech, and that it will not be associated with such speech."[26] And finally Justice Breyer opines: "[t]he Government thus has an interest in seeking to disincentivize the use of such words [*i.e.,* words that Justice Breyer refers to as 'highly vulgar or obscene'] in commerce by denying the benefit of trademark registration."[27]

Now, in the aftermath of *Tam* and *Brunetti*, since the Supreme Court majority declined the invitation of Chief Justice Roberts and Justices Sotomayor and Breyer to construe § 2(a)'s word "scandalous" to prohibit registration of marks that Justice Sotomayor referred to as "obscenity, vulgarity, and profanity," the time is ripe for Congress to amend § 2(a) and to define its language with precision. Amendment will be necessary in order to balance a degree of moral decency with the First Amendment's protections for freedom of speech. Chief

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[22] *Id.* at 2303.

[23] *Id.* at 2306 (Breyer, J., concurring in part and dissenting in part).

[24] *Id.* (citations omitted).

[25] *Id.* at 2306 (Breyer, J., concurring in part and dissenting in part).

[26] *Id.* at 2307.

[27] *Id.*

Justice Roberts, along with Justices Alito, Breyer, and Sotomayor have expressed the view that Congress may indeed write such a statute.

As foundational context, Part I of this article summarizes the categories of speech that fall outside of First Amendment protection. Part II suggests specific language that Congress will need to include in the statute to rewrite § 2 in a way that targets and effectively bars registration of marks that the Justices who wrote separately in *Brunetti* deem worthy of exclusion. Part II also proposes three avenues that Congress might take in order to fill the voids created by the *Tam* and *Brunetti* decisions. The conclusion summarizes the salient points made and implores Congress to proceed expeditiously.

I. CATEGORIES OF SPEECH UNPROTECTED BY THE FIRST AMENDMENT & THEIR RELATIONSHIP TO § 2.

There are some categories of speech that fall outside the scope of First Amendment protections; the Lanham Act may prevent registration of marks whose language and/or visual or auditory representations (i.e., words, names, symbols, or devices) come within the scope of those categories. In his concurring opinion in *Tam*, Justice Kennedy expressly acknowledged, "[t]hose few categories of speech that the government can regulate or punish – for instance, fraud, defamation, or incitement – are well established within our constitutional tradition."[28] One of the most authoritative treatises on constitutional law explains:

> The Supreme Court has allowed the punishment of speech based on content if the content . . . is limited to the proscription of: (1) speech that incites imminent lawless action; (2) speech that is integral to the commission of a crime; (3) speech that triggers an automatic violent response (so-called "fighting words" or the related "hostile audience" problem); (4) "true threats;" (5) obscenity (which the Court narrowly defines to exclude much material that the popular press often describes as pornography); (6) child pornography (a limited category of speech involving photographs and films of young children); (7) certain types of defamatory speech; and (8) certain types of commercial speech (primarily false or misleading speech connected to the sale of a service or product, or offers to engage in illegal activity).[29]

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[28] *Matal*, 137 S. Ct. at 1765 (2017).

[29] JOHN E. NOWAK & RONALD D. ROTUNDA, PRINCIPLES OF CONSTITUTIONAL LAW § 16.1, at 614 (4th ed. 2010). This treatise discusses a number of these categories of unprotected speech. *See, e.g.*, *id.* § 16.5, at 643-49 (advocacy of criminal activity); *id.* § 16.5, at 645 ("Only when speech causes unthinking, immediate reaction is the protection of the First Amendment withdrawn."); *id.* § 16.5, at 648 (reciting the *Brandenburg* test used "to judge laws that restrict speech that advocates unlawful conduct"); *id.* §16.18, at 711–18 ("Fighting Words and Hostile Audiences."); *id.* § 16.18(a), at 712 (defining "fighting words" as "face-to-face words plainly likely to cause a breach of the peace by the addressee," and "*Chaplinsky*'s basic test was whether or not people of common intelligence would understand the words as likely to

In his autobiography, the late Senator Sam Ervin, a constitutional law scholar and former associate justice on the North Carolina Supreme Court, expressed these principles as follows:

> In its final analysis, the First Amendment compels the government to grant to every person within the borders of our land . . . . Freedom to convey to others with impunity by speech, writing, print, picture, signal, or any other medium of communication whatever any information or ideas he wishes *as long as what he says or publishes does not slander or libel others; invade the privacy of others; constitute obscenity or legal fraud; incite crime or violence; obstruct courts in the administration of justice, or legislative bodies in their proceedings; amount to sedition, or imperil the national security.*[30]

The *Brunetti* majority's unwillingness to adopt Justice Sotomayor's construction of the word "scandalous" demands that Congress address this lacuna if legislators, in fact, want to establish a protective barrier that will prevent registration or marks that are obscene and egregiously offensive. And while Congress is addressing that problem, it is probably prudent to include express language that bars all speech unprotected by the First Amendment.

II. FIXING THE PROBLEMS

A. Assessing The Damage & Establishing A Strategy For Revision

Currently the relevant portion of § 2(a) reads as follows:

> 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—
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> (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, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute . . . .[31]

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cause the average addressee to fight.") (citing Chaplinsky v. New Hampshire, 315 U.S. 568, 62 (1942); *id.* § 16.18(a), at 714 (quoting Justice Harlan in Cohen v. California, 403 U.S. 15 (1971) for the proposition that "one man's vulgarity is another's lyric"); *id.* § 16.18(c), at 716 (discussing important cases on threats and intimidation, such as R.A.V. v. City of St. Paul, 505 U.S. 377, 112 (1992) and Virginia v. Black, 538 U.S. 343 (2003), and summarizing the doctrine by quoting *Black*: "[i]ntimidation in the constitutionally proscribable sense of the word is a type of true threat, where the speaker directs a threat to a person or a group of persons with the intent of placing the victim in fear of bodily harm or death."); *id.* §§ 16.34-16.37, at 771-89 (obscenity); *id.* § 16.36, at 774 (definition of "obscenity" from Miller v. California, 413 U.S. 15 (1973)); § 16.37(c), at 778-80 (child pornography).

[30] SAM J. ERVIN, JR., PRESERVING THE CONSTITUTION: THE AUTOBIOGRAPHY OF SENATOR SAM J. ERVIN, JR. 209–10 (1984) (emphasis added).

[31] 15 U.S.C. § 1052 (emphasis added).

The prohibition of marks that "falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols" bars registration of marks that fraudulently suggest endorsements or an individual's right of publicity.[32] Thus those provisions are almost assuredly constitutional.[33] Similarly the prohibition of marks that "bring them [i.e., persons, living or dead, institutions, beliefs, or national symbols] into contempt, or disrepute" serves to prevent registration of marks that are defamatory, and therefore, is likewise a constitutional bar.[34]

The *Tam* and *Brunetti* decisions, however, require amendment to § 2(a). At minimum, the portion of the statute italicized above must be deleted. In the wake of *Tam*, it seems unlikely that there is any viable substitute for the disparagement clause that could prevent registration of marks that "may disparage" and simultaneously pass constitutional muster. Similarly, the prospect of resuscitating the word "immoral" is unlikely. Justice Sotomayor concedes as much: "[a]nd as for the word 'immoral,' I agree with the majority that there is no tenable way to read it that would ameliorate the problem. The word clearly connotes a preference for 'rectitude and morality' over its opposite."[35] On the other hand, Chief Justice Roberts and Justices Alito, Breyer, and Sotomayor make a strong case for the sustainability of replacing the word "scandalous" in such a way that the statute can prohibit registration of a specific category of egregiously offensive marks and also survive First Amendment scrutiny.[36]

In terms of the revision's structure, among the many options that are no doubt available to Congress, there are at least three solutions that Congress may wish to consider. One solution we could call a Precise, Surgical Approach. The second is an Addition Approach. A third might best be characterized as a Hybrid Approach. A Precise, Surgical Approach by which Congress might amend § 2(a)

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[32] *Id.*

[33] *See supra* note 15 and accompanying text.

[34] 15 U.S.C. § 1052(a).

[35] Iancu v. Brunetti, 139 S. Ct. 2294, 2309 (2019) (Sotomayor, J., with Breyer, J., concurring in part and dissenting in part).

[36] *See, e.g.*, *Brunetti*, 139 S. Ct. at 2308 (Sotomayor, J., with Breyer, J., concurring in part and dissenting in part) ("Rather than read the relevant text as the majority does, it is equally possible to read that provision's bar on the registration of 'scandalous' marks to address only obscenity, vulgarity, and profanity."); *id.* at 2309 ("To say that a word or image is 'scandalous' can instead mean that it is simply indecent, shocking, or generally offensive.") (citing multiple dictionary definitions); *id.* at 2303 (Roberts, J., concurring in part and dissenting in part) ("As Justice Sotomayor explains, however, the 'scandalous' portion of the provision is susceptible of such a narrowing construction. Standing alone, the term 'scandalous' need not be understood to reach marks that offend because of the ideas they convey; it can be read more narrowly to bar only marks that offend because of their mode of expression—marks that are obscene, vulgar, or profane."); *id.* at 2304 (Breyer, J., concurring in part and dissenting in part) ("I agree with Justice Sotomayor that, for the reasons she gives, we should interpret the word 'scandalous' in the present statute to refer only to certain highly 'vulgar' or 'obscene' modes of expression.").

would be to delete the words "may disparage," "immoral," and "scandalous" and replace them with words that will accomplish the aforementioned task of prohibiting registration of specific categories of obscene and egregiously offensive marks and also surviving First Amendment scrutiny. The Addition Approach would be to write an entirely new provision that would broadly bar registration of all marks that come within the ambit of the categories of speech that the Court has held to fall outside the protections of the First Amendment. And the Hybrid Approach would blend the first two; it would delete the portions of § 2(a) that *Tam* and *Brunetti* have declared unconstitutional and also add robust descriptions of categories of marks that constitutionally may be barred from registration.

Part C suggests specific structural methods (i.e., a "Precise, Surgical Approach," an "Addition Approach," and a "Hybrid Approach") for amending § 2. Although they differ somewhat in both form and content, all three share an important problem that initially must be resolved in order for any of them to be viable. No matter which structural approach Congress determines is best, Congress must first decide what words or terms best capture the meanings of the special categories of marks intended to be barred from registration by the legislation. And Congress must also define those words or terms in such a way that they will not meet the same fate as the terms "may disparage," "immoral," and "scandalous." Part B undertakes an analysis of this terminology issue.

B. Wording and Definition Issues

i. Obscene

Adding a bar to "obscene" marks should be the least controversial component of the revision process. There is a well-developed First Amendment jurisprudence regarding the word "obscene."[37] It is an understatement to say that a great deal has been written about the meaning of the word "obscenity" in its constitutional context.[38] As noted above, it is hornbook, black letter law that the First Amendment does not protect obscenity.[39] In addition, in his *Brunetti* opinion, Chief Justice Roberts bluntly states: "refusing registration to *obscene*, vulgar, or profane marks does not offend the First Amendment."[40] In a similar fashion, Justice Sotomayor agrees that barring registration of such marks can withstand constitutional challenge: "[p]rohibiting the registration of *obscene*, profane, or vulgar marks qualifies as reasonable, viewpoint-neutral, content-based regulation."[41] Justice Sotomayor emphasizes this point: "[o]f course, obscenity itself

[37] *See, e.g.*, Miller v. California, 413 U.S. 15 (1973) and its progeny.

[38] *See, e.g.*, NOWAK & ROTUNDA, *supra* note 29.

[39] *See id.* and accompanying text.

[40] *Brunetti*, 139 S. Ct. at 2303 (Roberts, J., concurring in part and dissenting in part) (emphasis added).

[41] *Id.* at 2317 (Sotomayor, J., with Breyer, J., concurring in part and dissenting in part) (emphasis added).

is subject to a longstanding exception to First Amendment protection, so it is proscribable in any event."[42] She adds, "[o]bscenity has long been defined by this Court's decision in *Miller* v. *California* . . . ."[43]

Without doubt Congress may amend § 2 of the Lanham Act to prohibit registration of marks that are obscene. That issue is, as they say in the world of sports, a slam-dunk proposition. Congress should do so without delay. Because obscene speech falls squarely outside the scope of First Amendment protection, inserting a prohibition on registration of "obscene matter" will be simple. Straightaway Congress may, for example, replace either the word "immoral" or the word "scandalous" with the word "obscene."

ii. Verging on Obscene: Vulgar; Profane; Indecent (A Rose by Any Other Name…)

a. Assessing the Issue

In addition, if Chief Justice Roberts and Justices Alito, Breyer, and Sotomayor are correct, Congress may, without running afoul of the First Amendment, also prohibit registration of a category of marks that, although they do not rise to the level of "obscenity," nevertheless are sufficiently reprehensible and/or heinous that they may be denied registration, because they fall outside the scope of First Amendment protection. The Court has held that the terms "may disparage," "immoral," and "scandalous" fail to serve as constitutionally permissible labels for this elusive category.[44] A significant problem that Congress will face in fashioning a rule to bar registration of such marks will be to devise an appropriate name for the category and to define it adequately.

There are no doubt many word choices as options for an appropriate label that may adequately capture the essence of this egregiously offensive category. Although there may be many others, three that may be promising are: 1) "vulgar" (or "highly vulgar") – a term used by Chief Justice Roberts and Justices Alito, Breyer, and Sotomayor; 2) "profane" – a term used by Justice Kagan in her majority opinion and also by Chief Justice Roberts and Justice Sotomayor; and 3) the phrase "indecent or profane" – a term borrowed from Supreme Court precedent.

b. Vulgar: A Strong Candidate

Adopting language either identical to or similar to that suggested by the Justices in their *Brunetti* opinions is one plausible, if not persuasive, approach. Justice Sotomayor and Chief Justice Roberts, for example, use the nouns "vulgarity, or profanity" (sometimes also using their adjectival forms, "vulgar," and

[42] *Id.* at 2314 n.6 (citation omitted).

[43] *Id.* at 2311.

[44] *See supra* note 16 and accompanying text.

"profane").[45] Justice Alito employs the word "vulgar."[46] And Justice Breyer refers to this category as "highly vulgar."[47] Both Chief Justice Roberts and Justice Sotomayor share the conviction that marks that are vulgar may constitutionally be barred from registration. Recall, for example, their remarks: "refusing registration to obscene, *vulgar*, or profane marks does not offend the First Amendment"[48] and "[p]rohibiting the registration of obscene, profane, or *vulgar* marks qualifies as reasonable, viewpoint-neutral, content-based regulation."[49]

The Oxford Universal Dictionary, noting its Latin origin in the word *vulgus* ("the common people") provides a number of definitions for the adjective "vulgar" in its archaic sense as, for example, "[i]n common or general use; common, customary, ordinary."[50] Explaining its use when referring to "words or names," *Oxford* says, "Employed in ordinary speech; common, familiar 1676."[51] But significantly, *Oxford* notes that the modern definition which is "[n]ow the only sense in ordinary colloq[uial] use" is "[h]aving a common and offensively mean character; coarsely commonplace; lacking in refinement or good taste."[52] The first definition in *Funk & Wagnalls New Standard Dictionary of the English Language* defines "vulgar" as follows:

> Of or pertaining to the common people, or to the common herd or crowd, consisting of, suited to, or practiced by the uneducated masses, hence, now most commonly, displaying or indicating a low, coarse, or common nature, plebeian, somewhat coarse, boorish, low, sometimes, in loose usage, *verging upon obscenity*….[53]

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[45] *See, e.g.*, *id.* at 2303-04 (Roberts, J., concurring in part and dissenting in part) ("The First Amendment protects the freedom of speech; it does not require the Government to give aid and comfort to those using obscene, vulgar, and profane modes of expression."); *id.* at 2317 (Sotomayor, J., with Breyer, J., concurring in part and dissenting in part) ("Prohibiting the registration of obscene, profane, or vulgar marks qualifies as reasonable, viewpoint-neutral, content-based regulation. Apart from any interest in regulating commerce itself, the Government has an interest in not promoting certain kinds of speech, whether because such speech could be perceived as suggesting governmental favoritism or simply because the Government does not wish to involve itself with that kind of speech.").

[46] *See, e.g.*, *id.* at 2303 (Alito, J., concurring) ("Our decision does not prevent Congress from adopting a more carefully focused statute that precludes the registration of marks containing vulgar terms that play no real part in the expression of ideas.").

[47] *See, e.g.*, *id.* at 2306 (Breyer, J., concurring in part and dissenting in part) ("[I]t is hard to see how a statute prohibiting the registration of only highly vulgar or obscene words discriminates based on 'viewpoint.'").

[48] *Id.* at 2303 (Roberts, J., concurring in part and dissenting in part) (emphasis added).

[49] *Id.* at 2317 (Sotomayor, J., with Breyer, J., concurring in part and dissenting in part) (emphasis added).

[50] THE OXFORD UNIVERSAL DICTIONARY 2374 (C.T. Onions ed., 3rd ed. 1955).

[51] *Id*.

[52] *Id*.

[53] NEW STANDARD DICTIONARY OF THE ENGLISH LANGUAGE 2666 (Funk & Wagnalls eds., 1913) (emphasis added).

The italicized phrase, *verging upon obscenity*, is particularly apt for our purposes. Indeed speech that verges upon obscenity is precisely the type of speech to which Justice Sotomayor appears to refer when she writes:

> I do not offer a list, but I do interpret the term to allow the PTO to restrict (and potentially promulgate guidance to clarify) the small group of lewd words or "swear" words that cause a visceral reaction, that are not commonly used around children, and that are prohibited in comparable settings.[54]

As noted above, the four Supreme Court Justices who address the issue in *Brunetti* use the word "vulgar" to refer to the category of marks that, although not "obscene," may be barred from registration without violating the free speech clause of the First Amendment. Justice Breyer adds the adverb "highly" in his remarks.[55] Consequently, either the term "vulgar" by itself or "highly vulgar" begins with the imprimatur of approval by four current Justices on the Court. Therefore, Congress may wish to start by considering "vulgar" or "highly vulgar" as an effective term as the name for this special category.

c. Profane & Indecent: Complex And Perhaps Troublesome Terms

In addition to "vulgar," two words that may be fruitful to consider as effective labels for the category of egregiously offensive marks are "profane" and "indecent." Both the majority and the Justices who wrote separately in *Brunetti* (with the exception of Justice Alito in his concurrence) use the words "profane" and "profanity" in this context.[56] A Supreme Court case from over forty years ago may prove helpful in this discussion.[57]

The *Brunetti* majority opinion twice uses the word "profane." First, Justice Kagan notes that "[t]he statute as written does not draw the line at lewd, sexually explicit, or *profane* marks."[58] Additionally, Justice Kagan remarks in a footnote, "[w]e say nothing at all about . . . a statute limited to lewd, sexually explicit, and *profane* marks."[59] These references to the word "profane" may be poignant because, in addition to the words "vulgar" and "vulgarity," Chief Justice Roberts

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[54] *Brunetti*, 139 S. Ct. at 2311 (Sotomayor, J., with Breyer, J., concurring in part and dissenting in part) (footnote omitted).

[55] *Id.* at 2306 (Breyer, J., concurring in part and dissenting in part).

[56] *See, e.g.*, *id.* at 2301; *id.* at 2303 (Roberts, J., concurring in part and dissenting in part); *id*. at 2307 (Breyer, J. concurring in part and dissenting in part); *id.* at 2308 (Sotomayor, J., with Breyer, J., concurring in part and dissenting in part).

[57] *See infra* notes 67–85 and accompanying text.

[58] *Brunetti*, 139 S. Ct. at 2301 (emphasis added).

[59] *Id.* at 2302 n.* (emphasis added). Although the majority also uses the terms "lewd" and "sexually explicit" in a similar context, the concurring and dissenting Justices use these terms in ways that seem largely insignificant. Justice Breyer uses the phrase "sexually explicit" only once. *Id.* at 2307 (Breyer, J., concurring part and dissenting in part). Justice Sotomayor uses the word "lewd" only three times, twice in parentheticals. *Id.* at 2310-11, 2314 (Sotomayor, J., with Breyer, J., concurring in part and dissenting in part).

and Justice Sotomayor also use the words "profane" and "profanity" to refer to the category of marks that could be barred from registration and not violate the First Amendment.[60]

An examination of the dictionary definitions, however, suggests that these words are probably less serviceable than the word "vulgar." *The Oxford Universal Dictionary*, noting first that the word comes from the Latin *profanus*, meaning "before (i.e. outside) the temple," defines the adjective "profane" in part as follows: "[n]ot pertaining or devoted to what is sacred or biblical, . . . [u]nhallowed; ritually unclean or polluted; . . . heathen, pagan . . . [c]haracterized by disregard or contempt of sacred things; irreverent, blasphemous, impious, irreligious, wicked."[61] It defines "profanity" as, "[t]he quality or condition of being profane; profaneness; profane conduct or speech . . . ."[62] *Funk & Wagnalls New Standard Dictionary of the English Language* defines the adjective "profane" in part as, "[e]xercising or manifesting irreverence, disrespect, or undue familiarity toward the Deity or religious things; blasphemous."[63] *Funk and Wagnalls* offers a multitude of synonyms: "blasphemous, godless, impious, irreligious, sacrilegious, secular, temporal, unconsecrated, ungodly, unhallowed, unholy, unsanctified, wicked, worldly."[64] And it defines "profanity" in part as, "[p]rofane

[60] *See, e.g.*, *supra* notes 6, 7, 18, 19, 20, 40, 41, 45, 48, 49 and accompanying text; *Brunetti*, 139 S. Ct. at 2303 (Roberts, J., concurring in part and dissenting in part) ("I also agree that, regardless of how exactly the trademark registration system is best conceived under our precedents—a question we left open in *Tam*—refusing registration to obscene, vulgar, or profane marks does not offend the First Amendment."); *id.* at 2303–04 ("The Government, meanwhile, has an interest in not associating itself with trademarks whose content is obscene, vulgar, or profane. The First Amendment protects the freedom of speech; it does not require the Government to give aid and comfort to those using obscene, vulgar, and profane modes of expression."); *id.* at 2313 (Sotomayor, J., with Breyer, J., concurring in part and dissenting in part) ("Adopting a narrow construction for the word "scandalous"—interpreting it to regulate only obscenity, vulgarity, and profanity—would save it from unconstitutionality."); *id.* at 2314 ("A restriction on trademarks featuring obscenity, vulgarity, or profanity is similarly viewpoint neutral, though it is naturally content-based."); *id.* at 2317 ("Prohibiting the registration of obscene, profane, or vulgar marks qualifies as reasonable, viewpoint-neutral, content-based regulation."); *id.* at 2317–18 ("The Government has a reasonable interest in refraining from lending its ancillary support to marks that are obscene, vulgar, or profane. . . [s]peech that is vulgar, offensive, and shocking is not entitled to absolute constitutional protection under all circumstances.") (internal citations and quotation marks omitted); *id.* at 2318 ("The Government need not, however, be forced to confer on *Brunetti's* trademark (and some more extreme) the ancillary benefit of trademark registration, when 'scandalous' in §1052(a) can reasonably be read to bar the registration of only those marks that are obscene, vulgar, or profane.").

[61] THE OXFORD UNIVERSAL DICTIONARY, *supra* note 50, at 1592.

[62] *Id.*

[63] NEW STANDARD DICTIONARY OF THE ENGLISH LANGUAGE, *supra* note 53, at 1422.

[64] *Id.*

speech or act, . . . [t]he state or quality of being profane; irreverence in spirit or conduct."[65]

One significant problem, then, with using either the word "profane" or "profanity" as a label for this special category is the decidedly religious connotation of the definitions. Thus, in addition to the free speech issue, using "profane" or "profanity" as a label might also create establishment clause problems.[66] In addition, given the potentially broad scope of material that might be considered profane or including profanity pursuant to these definitions, undoubtedly there are many, many words and images that more than likely do come under the umbrella of First Amendment protection. For example, words such as "damn," "shit," "and "hell" probably are profane under these definitions. Yet such words probably are closer to fitting into the categories of "immoral" or "scandalous" than the special category sought to be prohibited in the proposed revision of § 2.

The principal basis for suggesting the word "indecent" arises from the 1978 Supreme Court Opinion, *FCC* v. *Pacifica Foundation*.[67] *Pacifica* is among the cases that Justice Sotomayor cites for the proposition that certain marks bordering on obscenity may be barred from registration without violating the First Amendment – and incidentally Justice Breyer also cites *Pacifica*.[68] The *Pacifica* Court held that the Federal Communications Commission could, to a certain degree, regulate the speech contained in comedian George Carlin's famous monologue "Filthy Words."[69] Justice Sotomayor summarizes *Pacifica* in a parenthetical, stating, "regulator's objection to a monologue containing various 'four-letter words' was not to its 'point of view, but to the way in which it was expressed.'"[70]

Before proceeding, it should be acknowledged that the FCC regulation at issue in *Pacifica* used both the words "indecent, or profane" (separated by a comma and the word "or").[71] Consequently, it is not crystal clear whether the Court's analysis of those words treated them as distinct terms or together in combination.

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[65] *Id.*

[66] *See* NOWAK & ROTUNDA, *supra* note 29, § 17.6, at 831 ("The use of religious beliefs as any type of standard for the granting of government benefits . . . might violate both the establishment and free exercise clauses by violating a religious neutrality principle that is central to both.").

[67] FCC v. Pacifica Found., 438 U.S. 726, 728 (1978) (deciding whether the FCC has the authority to regulate radio broadcasts that are indecent but not obscene).

[68] Iancu v. Brunetti, 139 S. Ct. 2294, 2311 (2019) (Sotomayor, J., with Breyer, J., concurring in part and dissenting in part); *id.* at 2306 (Breyer, J., concurring in part and dissenting in part).

[69] *See Pacifica*, 438 U.S. at 726.

[70] *Brunetti*, 139 S. Ct. at 2311 (Sotomayor, J., with Breyer, J., concurring in part and dissenting in part).

[71] *Pacifica*, 438 U.S. at 736 ("No person within the jurisdiction of the United States shall utter any obscene, indecent, or profane language by means of radio communication.")

Here, at the threshold of our closer look at the word "indecent," we must acknowledge at least three weaknesses that may counsel against adopting this language borrowed from *Pacifica*. First, as was noted, because the FCC regulation involved in *Pacifica* used the words "indecent, or profane" together, it is not clear whether, if employed separately, the word "indecent" alone would have the same meaning. Second, in light of some of the negative aspects of the word "profane" noted above,[72] it is uncertain if not doubtful whether the simple fact that the Court upheld the FCC regulation in *Pacifica* would have the force to ensure the constitutionality of a word so potentially ambiguous as "profane" if Congress were to adopt it in its revision of § 2. Third, the word "indecent" may likewise suffer from the same lack of precision as the words "immoral" and "scandalous," which were held unconstitutional in *Brunetti*. Nevertheless, even though the language of the FCC regulation in question in *Pacifica* may to a degree create problems if adopted by Congress in revising § 2, because there is also some potential benefit, it will still be worthwhile to explore the word "indecent" and the context of *Pacifica* in greater detail.

Because we have already examined the word "profane" by itself, let us consider the word "indecent" in isolation. *Funk & Wagnalls* defines "indecent" in part as, "[o]ffensive to common propriety or adjudged to be subversive of morality; offending against modesty or delicacy; unfit to be seen or heard; immodest; gross; obscene."[73] *The Oxford Universal Dictionary* defines "indecent" as, "[u]nbecoming; in extremely bad taste; unseemly. . . . Offending against propriety or delicacy; immodest; suggesting or tending to obscenity."[74] Although the "suggesting or tending to obscenity" language probably comes close to the intended meaning of this category, perhaps "profane" nevertheless contains such a degree of ambiguity that it still might not be a wise choice.

Neither *Tam* nor *Brunetti* overruled nor limited *Pacifica*. Rather *Tam* and *Brunetti* simply declined to extend *Pacifica* to construe § 2(a)'s words "disparage," "scandalous," and/or "immoral" as functional equivalents of "indecent, or profane," the language contained in the FCC regulation at issue in *Pacifica*. Consequently, one possible way to craft language to amend § 2 in a constitutionally permissible manner, would be to borrow the language from that FCC regulation – language that the Supreme Court has held may, to a certain extent, bar registration of the types of marks that Justice Sotomayor urged in her dissent. Plausibly that language might serve as a viable substitute to replace the words "disparage," "scandalous," and "immoral."

In *Pacifica*, "[t]he Court held that the FCC does have statutory and constitutional power to regulate a radio broadcast that is 'indecent' but not 'obscene' in the constitutional sense, . . . at least under circumstances when the indecent broadcast would be available to a high percentage of children."[75] Interestingly,

[72] *See supra* notes 57-66 and accompanying text.

[73] NEW STANDARD DICTIONARY OF THE ENGLISH LANGUAGE, *supra* note 53, at 1247.

[74] THE OXFORD UNIVERSAL DICTIONARY, *supra* note 50, at 913.

[75] NOWAK & ROTUNDA, *supra* note 29, § 16.8, at 661.

when *Brunetti* was on appeal, the U.S. Court of Appeals for the Federal Circuit (CAFC) considered the potential impact of *Pacifica* but rejected its reasoning, stating:

> The government's interest in protecting the public from profane and scandalous marks is not akin to the government's interest in protecting children and other unsuspecting listeners from a barrage of swear words over the radio in *Pacifica*. A trademark is not foisted upon listeners by virtue of its being registered. Nor does registration make a scandalous mark more accessible to children.[76]

However, there is a reasonable argument to be made that the CAFC's conclusion failed to appreciate some of the subtle, but material, similarities between radio broadcasts and the extensive reach of the advertising impact of trademarks. In *Pacifica*, according to the Supreme Court, the FCC exercised its power to regulate radio broadcasting, relying primarily on "18 U.S.C. § 1464 (1976 ed.), which forbids the use of 'any obscene, indecent, or profane language by means of radio communications.'"[77] In a subsequent footnote, the Court explained that broadcasting, as a form of expression, required:

> special treatment because of four important considerations: (1) children have access to radios and in many cases are unsupervised by parents; (2) radio receivers are in the home, a place where people's privacy interest is entitled to extra deference; (3) unconsenting adults may tune in a station without any warning that offensive language is being or will be broadcast; and (4) there is a scarcity of spectrum space, the use of which the government must therefore license in the public interest. Of special concern to the Commission as well as parents is the first point regarding the use of radio by children.[78]

The *Pacifica* majority, then, based its holding in part on the pervasive, ubiquitous nature of radio broadcasting and its omnipresence in daily life. According to the Court, radio broadcasting is "a uniquely pervasive presence in the lives of all Americans" and "is uniquely accessible to children, even those too young to read."[79] The Court noted in particular: "[p]atently offensive, indecent material presented over the airwaves confronts the citizen, not only in public, but also in the privacy of the home, where the individual's right to be left alone plainly outweighs the First Amendment rights of an intruder."[80] Registered trademarks share most of these same characteristics as radio broadcasting.[81] Trademarks bombard our senses nearly every hour of the day via multiple communications

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[76] *In re* Brunetti, 877 F.3d 1330, 1353 (Fed. Cir. 2017).

[77] FCC v. Pacifica Found., 438 U.S. 726, 726 (1978).

[78] *Id.* at 732 n.2 (citations omitted).

[79] *Id*. at 748-49.

[80] *Id.* at 748.

[81] Trademarks are analogous to radio broadcasting in at least the first three "important considerations" articulated by the Court in footnote 2. *Id.* at 748.

platforms, including radio, television, Internet, street signage, and print media. In his concurring opinion in *Tam*, Justice Kennedy makes this very same observation:

> These marks make up part of the expression of everyday life, as with the names of entertainment groups, broadcast networks, designer clothing, newspapers, automobiles, candy bars, toys, and so on. Nonprofit organizations – ranging from medical-research charities and other humanitarian causes to political advocacy groups – also have trademarks, which they use to compete in a real economic sense for funding and other resources as they seek to persuade others to join their cause.[82]

In *Brunetti*, Justice Breyer echoes these concerns. Justice Breyer alludes to the government's interest in protecting children first when he notes that Brunetti's clothing, "includes apparel for children and infants."[83] He then elaborates upon this concern:

> [A]lthough some consumers may be attracted to products labeled with highly vulgar or obscene words, others may believe that such words should not be displayed in public spaces where goods are sold and where children are likely to be present. They may believe that trademark registration of such words could make it more likely that children will be exposed to public displays involving such words. To that end, the Government may have an interest in protecting the sensibilities of children by barring the registration of such words. See *Denver Area Ed. Telecommunications Consortium, Inc.* v. *FCC*, 518 U. S. 727, 743 . . . (1996) (plurality opinion) (noting the Government's interest in "protecting children from exposure to patently offensive sex-related material"); *Ginsberg* v. *New York*, 390 U. S. 629, 640 . . . (1968) (noting the government's "interest in the well-being of its youth").[84]

Thus, contrary to the CAFC's dismissal of the potential analogy of radio broadcasting to the proliferation of trademarks in our daily lives, a ban on "indecent, or profane" words, names, symbols or devices might pass constitutional muster under the reasoning of *Pacifica*. This is especially true since the refusal to register such indecent marks simply decreases the likelihood that putative applicants will select such marks.[85]

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[82] Matal v. Tam, 137 S. Ct. 1744, 1768 (2017) (Kennedy, J., concurring) (citations omitted); *see also* Ralph S. Brown, Jr., *Advertising and the Public Interest: Legal Protection of Trade Symbols,* 57 YALE L.J. 1165, 1168 (1948) ("The buying public submits to a vast outpouring of words and pictures from the advertisers, in which, mingled with exhortations to buy, is a modicum of information about the goods offered.").

[83] Iancu v. Brunetti, 139 S. Ct. 2294, 2304 (2019) (Breyer, J., concurring in part and dissenting in part).

[84] *Id.* at 2307.

[85] Both Justice Breyer and Justice Sotomayor in *Brunetti* emphasize such a bar's potential as a deterrent. For example, Justice Breyer remarks, "[t]he Government thus has an interest in seeking to disincentivize the use of such words [*i.e.,* words that Justice Breyer refers to as

If Congress were to label this category "indecent, or profane," USPTO trademark examining attorneys and courts may find some interpretive guidance in *Pacifica*. Specifically, the *Pacifica* Court included a transcript of the George Carlin monologue "Filthy Words," as an appendix to the opinion.[86] Although it does not necessarily identify which words qualify as "indecent," or "profane" within the meaning of the regulation, Carlin's monologue provides some guidance. For example, Carlin says that there are seven words that are verboten: "[t]he original seven words were, shit, piss, fuck, cunt, cocksucker, motherfucker, and tits."[87] By way of explanation, he says, "[t]hose are the ones that will curve your spine, grow hair on your hands and (laughter) maybe, even bring us, God help us, peace without honor (laughter) um, and a bourbon. (laughter)."[88] After humorously examining those words for the lion's share of the monologue, he then later adds three more words to his list: "I found three more words that had to be put on the list of words you could never say on television, and they were fart, turd and twat, those three. (laughter) . . . ."[89]

When *Brunetti* was on appeal before the CAFC, at oral argument, counsel for the parties and the judges discussed at length the possibility of applying a standard similar to the one used in *Pacifica*. Judge Dyk, in particular, suggested that the court could narrowly construe the language of § 2(a) in a manner that would treat the terms "immoral" or "scandalous" as equivalent to "obscene."[90] And in his concurring opinion, in a fashion similar to views expressed in *Brunetti* by Chief Justice Roberts and Justices Breyer and Sotomayor, Judge Dyk argued that the court was "obligated to construe the statute to avoid these constitutional questions" and noted that, "[a] saving construction of a statute need only be 'fairly possible,' and 'every reasonable construction must be resorted to.'"[91] Judge Dyk urged that, "[o]ne such fairly possible reading is available to us here

"highly vulgar or obscene] in commerce by denying the benefit of trademark registration." *Id.* at 2307. According to Justice Sotomayor, "[h]ere, however, the question is only whether the Government must be forced to provide the ancillary benefit of trademark registration to preexisting trademarks that use even the most extreme obscenity, vulgarity, or profanity." *Id.* at 2312 (Sotomayor, J., with Breyer, J., concurring in part and dissenting in part); *see also id.* at 2318 ("The Government need not, however, be forced to confer on Brunetti's trademark (and some more extreme) the ancillary benefit of trademark registration.").

[86] FCC v. Pacifica Found., 438 U.S. 726, 751–55 (1978).

[87] *Id.* at 751.

[88] *Id.*

[89] *Id.* at 755.

[90] *In re* Brunetti, 877 F.3d. 1330, 1359 (Fed. Cir. 2017). Curiously, counsel for the Government was hesitant, even when invited by the court, to argue that protection of children was a substantial government interest in upholding the "immoral" or "scandalous" language of § 2(a). *See id.* at 1342. Counsel for the Government did, however, argue that the words in the Carlin monologue, depicting graphic depictions of sex, genitalia, and similar material would be prohibited. *See id.* at 1352. Counsel for Brunetti was not willing to concede that the court is at liberty to interpret the statute narrowly. *See id.* at 1339.

[91] *In re Brunetti*, 877 F.3d. at 1358 (Dyk, J., concurring) (citations omitted).

by limiting the clause's reach to obscene marks, which are not protected by the First Amendment."[92] Presumably, if trademarks were analyzed as commercial speech under the *Central Hudson* test, one could reasonably argue that protecting children and others from "indecent, or profane" material would constitute an important Government interest, and that interpreting § 2(a) narrowly – using *Pacifica* as the benchmark—would constitute "narrow tailoring."[93]

Nevertheless, given the broad scope of the words "profane," "profanity," and "indecent," as well as the uncertainty regarding whether a prohibition on registration of matter that is "indecent" or "profane" or "profanity" would pass constitutional muster in the wake of *Tam* and *Brunetti*, it is probably more reasonable to focus on the other word that the Justices who wrote separately in *Brunetti* suggest; namely, "vulgar." On balance, the imprimatur afforded by the use of the word "vulgar" by Chief Justice Roberts and Justices Alito, Breyer, and Sotomayor in their *Brunetti* opinions suggests that Congress would do well to consider employing "vulgar" as the appropriate label for the category of marks that, although not obscene, are so egregiously offensive that they may be barred from trademark registration without offending the free speech clause of the First Amendment.

d. Defining The Egregiously Offensive Category

No matter what name or label Congress determines is best to refer to the category of egregiously offensive marks – "vulgar," "indecent," "profane," some combination of these words, or anything else – it will be prudent to add a definition of the word or phrase in 15 U.S.C § 1127 (§ 45 of the Lanham Act). In an effort to clarify and bolster the definition, it might be wise to expressly refer to views articulated by the Justices who wrote separately in *Brunetti*. It also might be sensible to refer to *Pacifica*. Additionally, Congress ought to expressly state that the category is limited only to speech that is viewpoint neutral.

Borrowing from Justice Sotomayor's opinion in *Brunetti*, the definition might state that this category applies only to "marks that are offensive because of the mode of expression, apart from any particular message or idea."[94] In making his argument that the word "scandalous" should be read narrowly, Chief Justice Roberts also recognizes the importance of this distinction: "[s]tanding alone, the

[92] *Id.*

[93] Interestingly, although *Brunetti* provided an opening for the Supreme Court to offer an opinion regarding whether trademarks constitute "commercial speech," the Court did not seize that opportunity. *See* Iancu v. Brunetti, 139 S.Ct. 2294, 2305 (2019). It is interesting also to note that Judge Dyk's suggested interpretation disagrees with three conclusions of Judge Moore's majority CAFC opinion: (1) that trademarks alleged to be immoral or scandalous must be subject to strict scrutiny; (2) that the Government has failed to prove an important governmental interest; and, (3) that § 2(a)'s immoral or scandalous provision is not sufficiently narrowly tailored. *In re Brunetti*, 877 F.3d. at 1357-60.

[94] *Brunetti*, 139 S. Ct. at 2310 (Sotomayor, J., with Breyer, J., concurring in part and dissenting in part).

term 'scandalous' need not be understood to reach marks that offend because of the ideas they convey; *it can be read more narrowly to bar only marks that offend because of their mode of expression—marks that are obscene, vulgar, or profane*."[95] Justice Sotomayor contends that barring registration of marks *on the basis of their mode of expression* is analogous to the Supreme Court's refusal to provide First Amendment protection for "fighting words."[96] This point must be emphatic. Even the *Brunetti* majority recognized the grave importance of the line between the category of marks that could be barred as viewpoint neutral versus marks that could not (i.e., if the rule were to discriminate based on viewpoint). For example, in summarizing *Tam*, the majority remarks, "[t]he Justices thus found common ground in a core postulate of free speech law: The government may not discriminate against speech based on the ideas or opinions it conveys."[97] Explaining the holding in *Tam*, the majority states, "[v]iewpoint discrimination doomed the disparagement bar."[98]

The definition of this category, inserted in the appropriate alphabetical order, might read as follows:

> The term "Vulgar"/"Indecent, or Profane" means any speech that is highly offensive because of its mode of expression, apart from any particular message or idea, including "the small group of lewd words or 'swear' words that cause a visceral reaction, that are not commonly used around children, and that are prohibited in comparable settings." *See* Iancu v. Brunetti, 588 U.S. at ___, 139 S. Ct. 2294, 2311, 204 L. Ed. 2d 714 (2019) (Opinion of Justice Sotomayor, concurring in part and dissenting in part). The term includes the category of speech held not protected by the free speech clause of the First Amendment in *FCC v. Pacifica*, 438 U.S. 726, 98 S. Ct. 3026, 57 L. Ed. 2d 1073 (1978).

In order to add clarity, the legislative history of this definition might benefit from expressing reliance not only on *Pacifica* but also on the *Brunetti* opinions

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[95] *Id.* at 2303 (Roberts, J., concurring in part and dissenting in part) (emphasis added).

[96] *Id.* at 2314 (Sotomayor, J., with Breyer, J., concurring in part and dissenting in part) ("By the same token, 'fighting words are categorically excluded from the protection of the First Amendment' not because they have no content or express no viewpoint (often quite the opposite), but because 'their content embodies a particularly intolerable (and socially unnecessary) *mode* of expressing *whatever* idea the speaker wishes to convey.'"); *see also id.* (citing R.A.V. v. St. Paul, 505 U.S. 377, 383 (1992)).

[97] *Id.* at 2299.

[98] *Id.*; *see also id.* at 2301 ("The statute as written does not draw the line at lewd, sexually explicit, or profane marks. Nor does it refer only to marks whose 'mode of expression,' independent of viewpoint, is particularly offensive."); *id.* at 2302 n.* ("We say nothing at all about a statute that covers only the latter—or, in the Government's more concrete description, a statute limited to lewd, sexually explicit, and profane marks. Nor do we say anything about how to evaluate viewpoint-neutral restrictions on trademark registration, . . . because the 'scandalous' bar (whether or not attached to the 'immoral' bar) is not one.").

of Chief Justice Roberts and Justices Alito, Breyer, and Sotomayor. For example, key passages that would be prudent to include in the record are as follows:

> • "What would it mean for 'scandalous' in § 1052(a) to cover only offensive modes of expression? The most obvious ways—indeed, perhaps the only conceivable ways—in which a trademark can be expressed in a shocking or offensive manner are when the speaker employs obscenity, vulgarity, or profanity."[99]
>
> • "Everyone can think of a small number of words (including the apparent homonym of Brunetti's mark) that would, however, plainly qualify."[100]
>
> • "[A] plain, blanket restriction on profanity (regardless of the idea to which it is attached) is a viewpoint-neutral form of content discrimination."[101]

Both Justices Breyer and Sotomayor acknowledge the prospect that arriving at a workable definition is likely to be difficult no matter how it is worded. Justice Breyer, for example, suggests that the USPTO establish a protocol that ensures a careful review of problematic marks:

> Of course, there is a risk that the statute might be applied in a manner that stretches it beyond the few vulgar words that are encompassed by the narrow interpretation Justice Sotomayor sets forth. That risk, however, could be mitigated by internal agency review to ensure that agency officials do not stray beyond their mandate. In any event, I do not believe that this risk alone warrants the facial invalidation of this statute.[102]

Justice Sotomayor forthrightly voices a similar concern but remains optimistic that such a statute is viable: "[e]ven so, hard cases would remain, and I would expect courts to take seriously as-applied challenges demonstrating a danger that the provision had been used to restrict speech based on the views expressed rather than the mode of expression."[103]

As for defining the term, whether it be "vulgarity," "indecent, or profane," or another moniker chosen by Congress as an effective name or label for the types of expression targeted by the Justices who wrote separately in *Brunetti*, a definition included in 15 U.S.C § 1127 (§ 45 of the Lanham Act) will be necessary to decrease the likelihood of ambiguity. The definition proposed above could serve as a starting point for drafting such a definition.

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[99] *Id.* at 2311 (Sotomayor, J., with Breyer, J., concurring in part and dissenting in part).

[100] *Id.*

[101] *Id.* at 2315.

[102] *Id.* at 2307-08 (Breyer, J., concurring in part and dissenting in part).

[103] *Id.* at 2318 (Sotomayor, J., with Breyer, J., concurring in part and dissenting in part).

C. Structural Approaches

i. Precise, Surgical Approach

Let us now consider the precise language that Congress could adopt to surgically revise § 2(a). First, deletion of the phrase "may disparage" is undoubtedly required. Second, as acknowledged earlier, substituting "immoral" with "obscene" is an easy fix. In addition, two substitute words or phrases were suggested above that could replace "scandalous": 1) "vulgar" and 2) "indecent, or profane."

Here then are two viable versions of a revised § 2(a):

> Consists of or comprises obscene, deceptive, or vulgar matter; or matter which falsely suggests a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute….
>
> Consists of or comprises obscene, deceptive, or indecent, or profane matter; or matter which falsely suggests a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute….

ii. Addition Approach

Another way to address the fallout from *Tam* and *Brunetti* is for Congress to write a new provision. In some respects, this option may be preferable to the Precise, Surgical Approach. The Supreme Court's First Amendment jurisprudence has developed significantly since the Lanham Act was passed in 1946. As noted above in Part I, Supreme Court precedent has brought into sharp focus specific categories of speech that the First Amendment does not protect – unprotected speech. As a result, although drafting a new provision might create some degree of overlap, redundancy is not necessarily negative when it comes to drafting statutes. For example, §§ 2(a) and 2(c) overlap to a certain extent.

A new provision to § 2 might simply list the categories of unprotected speech as barred categories. In addition to listing those well-established categories, however, in order to encompass the material that Chief Justice Roberts and Justices Alito, Breyer, and Sotomayor characterize as "vulgarity," that category will need to be expressly identified and defined. Congress will need to decide what term best captures the intended meaning. The two terms suggested above – "vulgarity" and "indecent, or profane," – might serve that function. An additional § 2 provision might read as follows:

> Consists of or comprises (1) speech that incites imminent lawless action; (2) speech that is integral to the commission of a crime; (3) speech that triggers an automatic violent response; (4) "true threats;" (5) speech that is obscene; (6) speech that is vulgar/indecent, or profane; (7) child pornography; (8) defamatory speech; and (9) false or misleading commercial speech connected to the sale of a service or product, or offers to engage in illegal activity.

If Congress were to add such a provision, this provision would clarify much of what currently exists in § 2 and also bar registration of the types of marks that prompted Chief Justice Roberts and Justices Alito, Breyer, and Sotomayor to write separately in *Brunetti*. At least one question would remain; namely, where to add this provision? Perhaps it could be appended to § 2(a). Perhaps it could be added as § 2(g). Congress should be capable of making a reasonable decision regarding where to insert it.

iii. Hybrid Approach

The Hybrid Approach may be superior to both the Precise, Surgical Approach or the Addition Approach. If done properly, the Hybrid Approach would remove the parts of § 2(a) that *Tam* and *Brunetti* have declared unconstitutional and add language to § 2(a) that strengthens and clarifies its bars as well as the bars established in §§ 2(b)-(f). For the same reasons previously explained in analyzing the Precise, Surgical and Addition Approaches, the Hybrid Approach would also require that Congress decide what term best captures the intent of Justice Sotomayor's word "vulgarity," (*e.g.,* "vulgarity," "indecent, or profane," or some other appellation) and define that term in § 45.

The following is a revised version of § 2(a) using the hybrid approach. Words crossed through are words that must be deleted because of *Tam* and *Brunetti*. Bolded text is suggested language.

> Consists of or comprises ~~immoral,~~ deceptive~~, or scandalous~~ matter; or matter which ~~may disparage or~~ falsely suggest**s** a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; **or speech that incites imminent lawless action; speech that is integral to the commission of a crime; speech that triggers an automatic violent response; "true threats;" speech that is obscene; speech that is vulgar/indecent, or profane; child pornography; defamatory speech; false or misleading commercial speech connected to the sale of a service or product, or offers to engage in illegal activity**; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.

CONCLUSION

Tam and *Brunetti* have removed the shielding force of three bars to registration that have been ingrained in § 2(a) since the Lanham Act came into effect during the summer of 1947. Examining attorneys may no longer refuse registration of a mark on the basis that it "may disparage," is "immoral," or is "scandalous." The entreaties of Judge Dyk in the CAFC, Chief Justice Roberts and Justices Breyer and Sotomayor in the Supreme Court to construe the term "scandalous" as to prevent registration of egregiously offensive marks fell on

deaf ears within their respective courts. However, their concern is no doubt shared by many. In essence, their concern is simple: the USPTO should have the authority to bar registration not only of obscene marks but also of marks on the grounds that, although not obscene, are too highly offensive.[104] The separate opinions of Chief Justice Roberts and Justices Alito, Breyer, and Sotomayor in *Brunetti* provide useful starting points in defining which marks should be barred, and *Pacifica* adds another valuable and instructive point of reference.

Congress has an opportunity to act by amending § 2. Such an amendment has the potential to draw a much clearer line between permissible versus impermissible trademarks than the vague and overbroad language of "may disparage," "immoral," and "scandalous." Such an amendment should provide clearer guidance for PTO examining attorneys, provide reassurance for those who fear registration of marks that are excessively vulgar, and most importantly, allow the First Amendment to continue functioning as an appropriate arbiter of what is acceptable for federal trademark registration in the United States.

This article has endeavored to formulate a strategy to amend § 2 of the Lanham Act to harmonize § 2 with the First Amendment's freedom of speech clause and expressly bar registration of marks for unprotected speech. It has offered three possible ways to amend the Lanham Act to reflect and comply with the holdings in *Tam* and *Brunetti*. Although these proffered solutions differ in structure, all three are designed to achieve the same basic results. All three proposed approaches would prevent registration of obscene and egregiously offensive marks and maintain the freedom of speech that is vital to our liberty as Americans. Presumably, as Americans, we can balance a number of competing interests while still maintaining a functioning system of federal trademark registration. The federal trademark registration system should be capable of enhancing economic efficiency, allowing robust freedom of expression, and maintaining at least a modest degree of public decency.

[104] *See, e.g.*, *id.* at 2308 (Sotomayor, J., with Breyer, J., concurring in part and dissenting in part) ("With the Lanham Act's scandalous-marks provision, 15 U.S.C. § 1052(a), struck down as unconstitutional viewpoint discrimination, the Government will have no statutory basis to refuse (and thus no choice but to begin) registering marks containing the most vulgar, profane, or obscene words and images imaginable.").