



# Instead of Clarifying Trademark Law, *Brunetti* Provides the Roadmap for Future Uncertainty

by John C. Connell and Anthony M. Fassano

In a pair of trademark cases, separated by only short spans of time and statutory text, the United States Supreme Court has managed to frustrate an opportunity to clarify First Amendment jurisprudence related to commercial/non-commercial speech.

## Tam

Three years ago, the United States Supreme Court decided *Matal v. Tam*, which involved a facial challenge to 15 U.S.C. §1052(a), the disparagement clause of the Lanham Act.<sup>1</sup> The lead singer of a musical group consisting of Asian Americans sought a trademark for their group's name, "The Slants."<sup>2</sup> The term is a derogatory reference to people of Asian descent, and the group's goal in choosing the name was "reclaim[ing]" and "tak[ing] ownership" of the stereotype.<sup>3</sup> The trademark application was denied by the Patent and Trademark Office (USPTO) because it found the term offensive under the two-part administrative test applied under the disparagement clause.<sup>4</sup> The applicant challenged that decision in the Federal Circuit Court of Appeals which after *en banc* review reversed the denial of registration on the ground that the disparagement clause violated the First Amendment.<sup>5</sup> The Solicitor General successfully petitioned for *certiorari* on the sole question of whether the disparagement clause was "facially invalid under the Free Speech Clause of the First Amendment."<sup>6</sup>

The decision affirmed the Federal Circuit's ruling that the disparagement clause was unconstitutional, but the splintered opinion did little to clarify the state of the jurisprudence. All eight justices agreed that the disparagement clause did violate the Free Speech Clause because it violated "the bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend."<sup>7</sup> The Court also uniformly rejected the Solicitor's argument that the mark constituted government speech, characterizing that as a "huge and dangerous extension" of that doctrine.<sup>8</sup> Four justices then rebuffed the Solicitor's arguments based on theories of "government subsidy" and "government program," while making passing reference to the supposedly analogous "public forum" doctrine.<sup>9</sup>

However, the Court then dodged an important issue: Whether a trademark constitutes commercial speech, and, relatedly, whether a trademark regulation is subject to strict or intermediate scrutiny.<sup>10</sup> In addressing this issue, Justice Alito, joined by three other justices, noted that many "trademarks have an expressive component" (as "The Slants" unquestionably had in this case). Despite prior precedential holding—that speech is fully protected where its commercial and non-commercial components are "inextricably intertwined,"<sup>11</sup> and commercial speech is "no exception" to the rule that content and viewpoint discrimination are subject to "heightened scrutiny"<sup>12</sup>—Justice Alito declined to decide the issue simply because the disparagement clause could not withstand even the commercial speech standard of intermediate scrutiny.<sup>13</sup> The primary government interest asserted to justify the disparagement clause was to prevent underrepresented groups from exposure to demeaning messages.<sup>14</sup> But this interest, as Justice Alito correctly pointed out, amounts to viewpoint discrimination and "strike[s] at the heart of the First Amendment."<sup>15</sup> The term may be offensive to some, but "[g]iving offense is a viewpoint."<sup>16</sup> In this regard, the disparagement clause was nothing more than a "happy talk clause."<sup>17</sup>

A concurring opinion, authored by Justice Kennedy and joined by Justices Ginsburg, Kagan, and Sotomayor, more definitively addressed the question of the appropriate level of scrutiny to apply.<sup>18</sup> According to Justice Kennedy, the disparagement clause embodied "the essence of viewpoint discrimination,"<sup>19</sup> which is subject to "rigorous" or "heightened" scrutiny.<sup>20</sup> This analysis is proper because the government is signaling out speech reflecting a specific subset of views (*e.g.*, negative views toward a racial group), while allowing speech expressing the



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opposite idea.<sup>21</sup> The danger of this approach is that it could "silence dissent and distort the marketplace of ideas."<sup>22</sup> "To permit viewpoint discrimination in this context is to permit Government censorship."<sup>23</sup> As if to chastise the author of the main opinion, Justice Kennedy asserted that the undeniable existence of viewpoint discrimination "renders unnecessary any extended treatment of the other questions raised by the parties."<sup>24</sup>

Justice Thomas added a separate concurrence, essentially stating that strict scrutiny was appropriate under the circumstances.<sup>25</sup>



## Brunetti

Two years later, the Court decided to hear a sequel, which many observers hoped would allow the Court to close the loop left open by *Tam*. The new case, *Iancu v. Brunetti*, involved a challenge to another provision of 15 U.S.C. §1052(a), the immoral and scandalous clause.<sup>26</sup> The trademark application at issue in *Brunetti* was for a clothing line named “FUCT,”<sup>27</sup> a dicey acronym for the far more innocuous phrase, “Friends U Can’t Trust.” Unlike the trademark in *Tam*, FUCT operates exclusively as a source identifier with no obvious non-commercial message, and thus is more aligned with commercial speech than the music group name, “The Slants.” However, the underlying objection to both trademarks is the same: offensiveness (at least to the sensibilities of some listeners).

This case presented the Court with the opportunity to precisely define the appropriate level of scrutiny to apply to trademark regulations. The Court did not do so. What’s more, the case generated four concurring and dissenting opinions, which have the potential to further muddy the waters.

*Brunetti*, unlike *Tam*, did produce a majority opinion. Justice Kagan, joined by five justices, began by reading the terms “immoral” and “scandalous” together, as was the practice of the Patent and Trademark Office.<sup>28</sup> This reading differed from the approach advocated by the government, which no doubt sensed the uphill battle it would have defending the ban on “immoral” speech.<sup>29</sup> In the government’s view, the “scandalous” ban applies to different trademarks than the “immoral” ban.<sup>30</sup>

Justice Kagan went on to apply the reasoning of both opinions in *Tam* with the elegance of a simple syllogism. Both opinions agreed that a viewpoint-based trademark regulation is unconstitutional.<sup>31</sup> Both opinions agreed that the disparagement clause was viewpoint-based.<sup>32</sup> The majority in *Brunetti* found

that the immoral and scandalous clause was also viewpoint-based.<sup>33</sup> Therefore, the immoral and scandalous clause was unconstitutional.<sup>34</sup>

Justice Alito, the author of the main *Tam* opinion, joined the majority opinion, agreeing that the terms “immoral” and “scandalous” must be read together and struck down as a violation of the First Amendment.<sup>35</sup> But he wrote separately to express his view that Congress could write “a more carefully focused statute that precludes the registration of marks containing vulgar terms that play no real part in the expression of ideas.”<sup>36</sup> Under this hypothetical statute, FUCT could be denied trademark registration.<sup>37</sup> According to Justice Alito, the term “is not needed to express any idea,” and “generally signifies nothing except emotion and a severely limited vocabulary.”<sup>38</sup> To register a trademark like this “serves only to further coarsen our popular culture.”<sup>39</sup>

Chief Justice Roberts and Justices Sotomayor and Breyer concurred in part and dissented in part. All three agreed with the government’s position that the terms “immoral” and “scandalous” should be read separately, and that a ban on immoral trademarks is unconstitutional, but that the term “scandalous” could be sufficiently narrowed to pass constitutional muster.<sup>40</sup> Under this narrowed statute, FUCT could be denied a trademark.<sup>41</sup>

The three opinions used slightly different terms to describe the speech that could be constitutionally prohibited under a ban on scandalous trademarks. For Chief Justice Roberts, the ban could be directed at “obscene, vulgar, or profane” trademarks.<sup>42</sup> Justice Breyer used “highly vulgar or obscene” to express the same idea,<sup>43</sup> while Justice Sotomayor used “vulgar, profane, or obscene words and images.”<sup>44</sup> Such a ban would pass constitutional muster because it would not be directed at the content of speech, but rather at its mode of expression.<sup>45</sup>

Thus, four justices were willing to uphold a sufficiently narrow statute that would have allowed the Patent and Trademark Office to deny a trademark for FUCT. They effectively invited Congress to amend the statute to meet this standard. It could also encourage state and local governments to enact regulations to curtail speech that it deems obscene, vulgar, or profane.

## Aftermath

By its own admission, the Court in *Tam* “could not agree on the overall framework for deciding the case.”<sup>46</sup> While both opinions in *Tam* and *Brunetti* reaffirm the principle that the First Amendment does not tolerate viewpoint discrimination, the concurring and dissenting opinions in *Brunetti* leave open the question of under what circumstances could the government have a sufficient interest in regulating speech? *Tam* suggests that, even under intermediate scrutiny, preventing disparaging speech that expresses ideas that offend is not a valid government interest. “Giving offense is a viewpoint.”<sup>47</sup> Immoral and scandalous marks are as capable of offending as disparaging marks. If “happy talk” cannot be the object of government regulation, it is difficult to see how “civil talk” can be. But the *Brunetti* minority appears willing to find a valid and enforceable government interest in rewarding civility in commercial discourse. This underscores the importance of Justice Alito’s avoidance of the commercial/non-commercial speech dichotomy in *Tam*: Through that gaping hole emerged the *Brunetti* minority, and the real potential for future speech regulation.

The obvious danger of this approach is that it places the emphasis not on the speech itself, but rather on the effect that the speech has on the audience. Audiences, however, are not monolithic; the listeners’ varied experiences mean that the speaker’s words can affect them differently. Moreover, as Justice Breyer points

out, “the list of offensive swear words has changed over time.”<sup>48</sup> This is because individuals’ attitudes toward particular words change over time. The effect of particular words varies across time and across listeners, and the chance that some speech may be offensive will lead to regulation of the speech almost certainly infringing the speaker’s First Amendment rights. This runs counter to the principle that “the public expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers,” a statement the Court has reiterated several times in the 50 years since *Street v. New York*.<sup>49</sup>

Inherent in the approach of the four concurring and dissenting opinions in *Brunetti* is a value judgment about the speech in question. In Justice Alito’s opinion, the speech “serves only to further coarsen our popular culture,” and thus that value is very little.<sup>50</sup> The speech in *Tam*, on the other hand, was political and anti-racist, and thus could be said to be more “valuable” than the speech in *Brunetti*. But, as Justice Alito pointed out in *Tam*, laws against speech found offensive by some “can be turned against minority and dissenting views to the detriment of all.”<sup>51</sup>

Under these circumstances, is it properly the role of government to be making these value judgments in regulating speech? Would it be possible to characterize unpopular speech as lacking a viewpoint, so that prohibitions on such speech would not amount to viewpoint discrimination? If so, how firm is the First Amendment’s “bedrock” protection for offensive speech? Would the language used in *Tom Sawyer* pass a government civility code? Should the government be the arbiter of popular culture at all, or should that be the sole responsibility of the populace from which that culture springs? Is that not precisely what has occurred in the case of the Washington Football *Redskins*, whose name survived legal scrutiny (riding

*Tam*’s coat-tails) only to now die after being subject to the trial of public opinion? And is it not that same public marketplace, rather than government, that the First Amendment exclusively recognizes as the crucible of ideas?

In the wake of these decisions, the issue of the appropriate level of scrutiny to apply to trademark regulations is unanswered. In fact, it remains to be seen what effect the majority versus minority opinions in *Brunetti* will have on the confluence of the First Amendment and trademark law. So long as the distinction between commercial and non-commercial speech endures, that uncertainty will linger. ☺

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### Endnotes

1. 137 S.Ct. 1744 (2017).
2. *Id.* at 1754.
3. *Id.*
4. *Id.*
5. *Id.*
6. *Id.* at 1755.
7. *Id.* at 1751.
8. *Id.* at 1760.
9. *Id.* at 1763.
10. *Compare id.* at 1764 with *id.* at 1767.
11. *Riley v. Natl. Federation of the Blind of No. Carolina, Inc.*, 487 U.S. 781, 796 (1988).
12. *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 567 (2011).
13. 137 S.Ct. at 1764 (citing *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm’n of N.Y.*, 447 U.S. 557 (1980)).
14. *Id.*
15. *Id.*
16. *Id.* at 1763.
17. *Id.* at 1765.
18. *Id.* at 1767 (Kennedy, J., concurring).
19. *Id.* at 1766.
20. *Id.* at 1765, 1767.
21. *Id.* at 1766.
22. *Id.*
23. *Id.* at 1768.

24. *Id.* at 1765.
25. *Id.* at 1769 (Thomas, J., concurring)
26. 139 S.Ct. 2294 (2019).
27. *Id.* at 2297.
28. *Id.* at 2298.
29. *Id.* at 2301.
30. *Id.*
31. *Id.* at 2299.
32. *Id.*
33. *Id.*
34. *Id.* at 2302.
35. *Id.* at 2302 (Alito, J., concurring).
36. *Id.* at 2303.
37. *Id.*
38. *Id.*
39. *Id.*
40. *Id.* at 2303 (Roberts, C.J., concurring in part and dissenting in part), 2304 (Breyer, J., concurring in part and dissenting in part), 2308 (Sotomayor, J., with whom Justice Breyer joins, concurring in part and dissenting in part).
41. *Id.* at 2303 (Roberts, C.J., concurring in part and dissenting in part), 2304 (Breyer, J., concurring in part and dissenting in part), 2308 (Sotomayor, J., with whom Justice Breyer joins, concurring in part and dissenting in part).
42. *Id.* at 2303 (Roberts, C.J., concurring in part and dissenting in part).
43. *Id.* at 2304 (Breyer, J., concurring in part and dissenting in part).
44. *Id.* at 2308 (Sotomayor, J., with whom Justice Breyer joins, concurring in part and dissenting in part).
45. *Id.* at 2303 (Roberts, C.J., concurring in part and dissenting in part), 2304 (Breyer, J., concurring in part and dissenting in part), 2311 (Sotomayor, J., with whom Justice Breyer joins, concurring in part and dissenting in part).
46. *Id.* at 2298.
47. 137 S.Ct. at 1763.
48. 139 S.Ct. at 2307.
49. 394 U.S. 576, 592 (1969).
50. 139 S.Ct. at 2303.
51. 137 S. Ct. at 1769.