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THE LANHAM ACT'S IMMORAL OR SCANDALOUS PROVISION: DOWN, BUT NOT OUT

Michael Stephenson*

INTRODUCTION

The Lanham Act defines trademarks as “any word, name, symbol, or device, or any combination thereof used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others.”¹ Trademarks can range from the logos and symbols of global brands, like Apple, Coke, Google, and Microsoft, to the names of local stores that line the streets of small-town USA. It seems as though trademarks are everywhere, and for good reason. After all, if used effectively, trademarks can serve as efficient communication tools for businesses, as they possess the ability to instantly convey persuasive, emotional messages to consumers about a mark’s associated products or services.² Accordingly, trademark owners often spend a lot of time and money to ensure that the messages attached to their mark are positive ones and that their marks reach as many consumer eyes as possible.³

Much like the Federal Communications Commission (FCC) regulates communications by radio, television, and other broadcast media that have the ability

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¹ 5 U.S.C. § 1127 (2018).

² Giulio Ernesto Yaquinto, Note, *The Social Significance of Modern Trademarks: Authorizing the Appropriation of Marks as Source Identifiers for Expressive Works*, 95 TEX. L. REV. 739, 744 (2017) (“People rely on [trademarks] constantly, not only for commercial purposes . . . , but also for communicative purposes when it is easier to convey an idea embodied in a trademark by simply invoking the mark.”).

³ See A. Guttman, *Largest Advertisers in the U.S. in 2019*, STATISTA (July 28, 2020), <https://www.statista.com/statistics/275446/ad-spending-of-leading-advertisers-in-the-us/> (showing that eight companies spent as much as \$3 billion to ensure their marks and brands reached consumers).

to reach a large audience, the United States Patent and Trademark Office (USPTO) regulates trademarks and determines whether trademark applicants meet the statutory requirements, set forth by the Lanham Act, for federal registration.⁴ While the Lanham Act's primary purpose is to protect trademark owners against infringement and unfair competition, and the public against confusion and inaccurate information,⁵ the act contains other provisions that indicate a broader purpose. For example, as the FCC imposes regulations against indecency and obscenity from reaching a large audience,⁶ the Lanham Act similarly includes an "immoral"/"scandalous" provision that prohibits registration of trademarks that "[c]onsist[] of or comprise[] immoral . . . or scandalous matter."⁷ To determine if a mark falls under this provision, the USPTO "asks whether a 'substantial composite of the general public' would find the mark 'shocking to the sense of truth, decency, or propriety'; 'giving offense to the conscience or moral feelings'; 'calling out for condemnation'; 'disgraceful'; 'offensive'; 'disreputable'; or 'vulgar.'"⁸ Clearly, in addition to its primary purposes, the Lanham Act also serves to regulate certain content from reaching a mass audience.

For decades, critics have placed the immoral or scandalous provision under a microscope, arguing that it is unconstitutional under the First Amendment's Free Speech Clause.⁹ Despite these claims, though, the provision held steady within the Lanham Act and consistently resisted opposition. However, this all changed in 2019 when the Supreme Court finally struck down the immoral or scandalous provision

⁴ See Lanham Act, 15 U.S.C. §§ 1051–1141n (2018).

⁵ Chris Cochran, *It's "FUCT": The Demise of the Lanham Act*, 59 IDEA 333, 335 (2019) (quoting H. Peter Nesvold & Lisa M. Pollard, *Foreword—Half a Century of Federal Trademark Protection: The Lanham Act Turns Fifty*, 7 FORDHAM INTELL. PROP., MEDIA & ENT. L.J. 49, 49 (1996)).

⁶ See *Obscene, Indecent and Profane Broadcasts*, FCC, <https://www.fcc.gov/consumers/guides/obscene-indecent-and-profane-broadcasts> (last updated Jan. 13, 2021).

⁷ 15 U.S.C. § 1052(a).

⁸ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2298 (2019).

⁹ See, e.g., Megan M. Carpenter & Kathryn T. Murphy, *Calling Bulls**t on the Lanham Act: The 2(a) Bar for Immoral, Scandalous, and Disparaging Marks*, 49 U. LOUISVILLE L. REV. 465 (2011) (arguing that the sole object and purpose of trademark law is to promote fair competition, and that the immoral or scandalous provision "expands . . . well beyond [this] basic goal[]"); Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661 (1993) (maintaining that the immoral or scandalous provision is unconstitutional and violates free speech).

as unconstitutional in *Iancu v. Brunetti*.¹⁰ The Court reasoned that the provision permitted USPTO examiners to exercise “viewpoint discrimination” by either favoring or disfavoring one or more opinions of a particular controversy.¹¹ Specifically, the Court expressed disapproval of the provision’s overly broad language and of the USPTO’s inconsistency in drawing the line between unregistrable and permissible marks.¹² In the end, the Court was left with no choice but to open the door for immoral and scandalous marks to be federally registered and to receive full federal protection. At the same time, though, the Court seemed to express concerns regarding the possibility of immoral and scandalous marks becoming prevalent in society,¹³ and dissenting opinions gave a clear invitation for Congress to fill this newly created void with fresh legislation.¹⁴

This Note argues that the Lanham Act’s immoral or scandalous provision must be revitalized in light of the recent *Brunetti* decision and further proposes a new narrow, viewpoint-neutral test that will allow for more consistent and predictable results for trademark registrations that toe the line. This new test would replace the USPTO’s old viewpoint discriminatory standard while also promoting the longstanding goal of barring registration and protection of immoral and scandalous marks. This Note proceeds in three parts. Part I includes a detailed discussion of the Lanham Act, its problematic provisions, and recent case law that has shaken up the modern trademark landscape. Part II investigates the history of regulated speech and viewpoint discrimination, along with circumstances in which regulated speech is tolerated. Finally, Part III proposes a constitutionally sound, multi-prong test that would replace the Lanham Act’s recently invalidated immoral or scandalous provision.

¹⁰ See 139 S. Ct. 2294.

¹¹ *Id.* at 2299.

¹² *Id.* at 2300.

¹³ *Id.* at 2301 (describing the USPTO’s refusal to register certain immoral and scandalous marks as “understandable,” as the “marks express opinions that are, at the least, offensive to many Americans”).

¹⁴ See *id.* at 2303–04 (Roberts, C.J., dissenting) (“The Government . . . has an interest in not associating itself with trademarks whose content is not 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 2307 (Breyer, J., dissenting) (“The 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.”); *id.* at 2317 (Sotomayor, J., dissenting) (“[T]he 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.”).

I. THE LANHAM ACT AND ITS PROBLEMATIC PROVISIONS

A. *A Brief History*

The first trademark lawsuits arose in the United States in the 1840s, but it was not until decades later in 1870 that Congress first adopted a federal statutory trademark law.¹⁵ This act was short-lived and was eventually replaced by the more narrowly crafted 1881 Trademark Act.¹⁶ The 1881 Act listed only two bars to federal registration: (a) marks that contained the name of a person, and (b) marks that were so similar to previously registered marks as to cause a likelihood of confusion, mistake, or deception for the public.¹⁷

Almost immediately after the passage of the 1881 Act, amendments were proposed and lobbied for.¹⁸ Eventually, in 1892, the first suggestion of a “scandalous” registration prohibition was made.¹⁹ After more than a decade of debate, in the updated 1905 Trademark Act, Congress included a provision that precluded the registration of any mark that “consists of or comprises immoral or scandalous matter.”²⁰ Congress then included a similar provision in 1946 with the passage of the Lanham Act, and in 1994, the language of the current provision was adopted: “[c]onsists of or comprises immoral, deceptive, or scandalous matter.”²¹

Though no direct justifications for the immoral and scandalous bars can be found within the aforementioned string of federal trademark acts or their legislative histories, scholars have suggested that the provision was adopted because “the government should not waste its resources on protecting unseemly marks.”²² Scholars have also pointed to a number of other justifications for the immoral or scandalous provision, including that “the federal government ‘should not create the appearance that it favors or approves the use of scandalous [or] immoral marks,’”

¹⁵ See ROSS HOUSEWRIGHT, *EARLY DEVELOPMENT OF AMERICAN TRADEMARK LAW* 3 (2007); Jasmine Abdel-khalik, *To Live In-“fame”-y: Reconceiving Scandalous Marks as Analogous to Famous Marks*, 25 CARDOZO ARTS & ENT. L.J. 173, 182 (2007).

¹⁶ Abdel-khalik, *supra* note 15, at 183.

¹⁷ *Id.*

¹⁸ *Id.* at 183–84.

¹⁹ *Id.*

²⁰ *Id.* at 185.

²¹ *Id.*

²² Carpenter & Murphy, *supra* note 9, at 467.

that the government “should promote . . . public health, welfare, and morals by discouraging” said marks, and that the government “should protect the sensitivities of those in public who might be offended” by said marks.²³

The works of William Henry Browne, a prominent legal scholar of the nineteenth century, seem to support these validations.²⁴ In his treatise published shortly after the 1881 Trademark Act, Browne explained that marks should not “transgress the rules of morality or public policy,” and that marks should not shock the sensibilities of anyone in the world on the basis of moral, religious, or political grounds.²⁵ So, while there may be a lack of legislative history and straightforward reasoning behind the inclusion of an immoral or scandalous provision within federal trademark law, the economic and moral justifications provided above are ones that transcend time and remain relevant today.

B. *The Clash Between the Lanham Act and the First Amendment*

Typically, the USPTO has applied the Lanham Act’s immoral or scandalous provision “as a ‘unitary provision,’ rather than treating the two adjectives . . . separately.”²⁶ To determine whether a mark fits within this provision, the USPTO “asks whether a ‘substantial composite of the general public’ would find the mark ‘shocking to the sense of truth, decency, or propriety’; ‘giving offense to the conscience or moral feelings’; ‘calling out for condemnation’; ‘disgraceful’; ‘offensive’; ‘disreputable’; or ‘vulgar.’”²⁷

However, Congress cannot simply put into place any restriction it so desires, as it must adhere to constitutional limits. At issue within the context of trademarks is the First Amendment’s Free Speech Clause.²⁸ A core idea of free speech is that the government cannot discriminate against speech based on the ideas or opinions it conveys,²⁹ which is also known as viewpoint discrimination. Put differently, a

²³ *Id.* at 468.

²⁴ Abdel-khalik, *supra* note 15, at 188–95.

²⁵ *Id.* at 194.

²⁶ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2298 (2019) (quoting *In re Brunetti*, 877 F.3d 1330, 1336 (Fed. Cir. 2017)).

²⁷ *Brunetti*, 139 S. Ct. at 2298 (quoting *In re Brunetti*, 877 F.3d at 1336).

²⁸ *Brunetti*, 139 S. Ct. at 2297–300.

²⁹ *See id.* at 2299 (“[A] core postulate of free speech law: The government may not discriminate against speech based on the ideas or opinions it conveys.”).

statutory provision disfavoring “ideas that offend,” like the immoral or scandalous provision, may not pass constitutional muster.³⁰

For example, two years prior to *Brunetti*, the Supreme Court laid significant groundwork for the eventual revocation of the Lanham Act’s immoral or scandalous provision under the First Amendment’s Free Speech Clause.³¹ In *Matal v. Tam*, a 2017 Supreme Court decision, the Court nullified the Lanham Act’s prohibition on “disparaging” trademarks, holding that the provision violated the Free Speech Clause.³² Although the disparaging provision is separate and distinct from the immoral or scandalous provision, a dive into *Tam* is worthwhile, as the Court’s analyses in both *Tam* and *Brunetti* follow a similar form.

1. Strike One: *Matal v. Tam*

In 2010, Simon Tam, founder of the Asian American band “The Slants,” applied for a trademark registration on the name of his band.³³ The USPTO rejected Tam’s application and reasoned that the likely meaning of “The Slants” was to refer to people of Asian descent, thus violating the Lanham Act’s disparaging clause,³⁴ which prohibits the registration of marks that may disparage persons, institutions, or beliefs.³⁵ Tam appealed this decision to the Federal Circuit on the issue that the disparaging clause violated the Free Speech Clause of the First Amendment. In 2015, the Federal Circuit, in an opinion by Judge Kimberly Moore, held in favor of Tam, ruling that the disparagement bar was facially unconstitutional.³⁶

In 2017, the Supreme Court affirmed this decision.³⁷ In arriving at this determination, the Court agreed on two issues: first, if a trademark regulation bar is viewpoint-based, it is unconstitutional because it violates the First Amendment’s Free Speech Clause, and second, the disparagement bar was based on viewpoint.³⁸

³⁰ *Id.* at 2299 (internal quotations omitted).

³¹ *See Matal v. Tam*, 137 S. Ct. 1744 (2017).

³² *Id.*

³³ *In re Tam*, 785 F.3d 567, 568 (Fed. Cir. 2015).

³⁴ *Tam*, 137 S. Ct. at 1754.

³⁵ *Id.* at 1748; *see also* 15 U.S.C. § 1052(a) (2018).

³⁶ *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2016) (en banc).

³⁷ *Tam*, 137 S. Ct. at 1765.

³⁸ *Id.* at 1763.

The Court determined that a core principle of free speech law is that the government cannot discriminate against speech based on the ideas or opinions it conveys.³⁹ The Court concluded that the disparagement clause reflects the government's disapproval of a subset of messages it finds offensive, which is the exact essence of viewpoint discrimination.⁴⁰ Particularly important to Justice Alito was that the Lanham Act's disparagement clause is not "narrowly drawn," as "[t]he clause reaches any trademark that disparages *any* person, group, or institution."⁴¹ The Court seemed to concede that speech that demeans based on race, ethnicity, gender, religion, age, or any other ground is undoubtedly hateful and is speech that the government cannot be expected to endorse, but nevertheless, the "proudest boast of [the Supreme Court's] free speech jurisprudence is that [it] protect[s] the freedom to express" hated thoughts.⁴²

Ultimately, the *Tam* decision not only killed the disparagement clause, but it put the immoral or scandalous provision on death row, as the immoral or scandalous provision similarly called for USPTO examiners to judge marks on the basis of viewpoint.

2. Strike Two: *Iancu v. Brunetti*

In 2011, Erik Brunetti, owner of a clothing line under the name "FUCTION," sought to register the mark FUCTION to prevent competitors and knock-offs from appropriating his brand.⁴³ The USPTO rejected Brunetti's application and reasoned that FUCTION was phonetically similar to a well-known expletive previously established as a scandalous word under the Lanham Act.⁴⁴ Brunetti appealed this decision to the Trademark Trial and Appeal Board, but they upheld the decision.⁴⁵ Brunetti followed with an appeal to the Federal Circuit on the issue that the immoral or scandalous provision violated the Free Speech Clause of the First Amendment.⁴⁶

³⁹ *Id.* at 1765 (Kennedy, J., concurring).

⁴⁰ *Id.* at 1763.

⁴¹ *Id.* at 1765 (emphasis partially omitted).

⁴² *Id.* at 1764.

⁴³ *In re Brunetti*, 877 F.3d 1330, 1337 (Fed. Cir. 2017).

⁴⁴ *Id.* at 1337–38.

⁴⁵ *Id.* at 1337.

⁴⁶ *Id.*

Less than a year after the Supreme Court decided *Tam*, the Federal Circuit ruled that the USPTO correctly labeled “FUCT” as an established scandalous word, but further ruled that the immoral or scandalous provision violated a trademark applicant’s right to free speech.⁴⁷ The court concluded that language in the form of trademarks should be considered private speech, not government speech, and be subject to First Amendment analysis.⁴⁸ Consequently, under this type of analysis, the court found that the provision was unconstitutional.⁴⁹ Importantly, the court also expressed concerns over the provision’s wide scope and its ability to cast a net that is far more extensive than necessary to serve any government interest.⁵⁰

On appeal in 2019, a unanimous Supreme Court held that the Lanham Act’s prohibition on the registration of immoral trademarks infringes on First Amendment rights.⁵¹ Further, in a 6-3 decision in favor of Brunetti, the Court held that the Lanham Act’s prohibition on the registration of scandalous marks also infringes on First Amendment rights.⁵² The majority concluded that the USPTO has refused to register marks expressing an immoral or scandalous viewpoint on, among other things, drug use, religion, and terrorism,⁵³ while also approving registration of marks expressing more accepted views on the same topics.⁵⁴ While the Court certainly does not expect the government to promote or advance any extreme ideas, a law disfavoring “ideas that offend” discriminates based on viewpoint and violates the First Amendment’s Free Speech Clause.⁵⁵ Justice Kagan, writing for the majority, particularly found issue with the breadth of the provision, stating that “[t]here are a great many immoral

⁴⁷ *Id.* at 1335.

⁴⁸ *Id.* at 1340.

⁴⁹ *Id.* at 1341.

⁵⁰ *Id.* at 1355–57.

⁵¹ See *Iancu v. Brunetti*, 139 S. Ct. 2294, 2318 (2019) (Sotomayor, J., concurring in part and dissenting in part). Like the majority, Justice Sotomayor found that the prohibition against immoral trademarks impermissibly necessitated viewpoint discrimination. *Id.* However, as detailed below, Justice Sotomayor wrote that scandalous could be read more narrowly and was joined on this point by Chief Justice Roberts and Justice Breyer. *Id.*

⁵² *Id.* at 2297.

⁵³ *Id.* at 2294, 2300–01.

⁵⁴ *Id.* at 2300–01.

⁵⁵ *Id.* at 2301 (quoting *Matal v. Tam*, 137 S. Ct. 1744, 1762 (2017)).

and scandalous ideas in the world,” and the immoral or scandalous provision “cover[ed] them all.”⁵⁶

In *Brunetti*, the government argued that the provision should be read more narrowly, and that only “marks that are offensive [or] shocking to a substantial segment of the public because of their *mode* of expression, independent of any views that they may express” should be barred from registration.⁵⁷ Essentially, this would limit the USPTO to only refusing marks that are “vulgar,” meaning “lewd,” “sexually explicit or profane.”⁵⁸ This is an important distinction from how the current provision reads, as this new interpretation would not turn on viewpoint and could not be struck down on the grounds of viewpoint discrimination.⁵⁹ The majority explained that they could not accept the government’s proposal, as the statute’s text says something markedly different.⁶⁰ However, the majority did not shut the door on such an interpretation, suggesting that if Congress chooses to act, the immoral or scandalous provision could be revived.⁶¹

Three Justices—Chief Justice Roberts, Justice Breyer, and Justice Sotomayor—each dissented in part in regard to the registration of scandalous trademarks.⁶² All three Justices felt that the “scandalous” interpretation was not as broad as the majority opinion seemed to make it, and that the USPTO would not be discriminating on the basis of viewpoint under this particular clause.⁶³

In a particularly influential dissent, Justice Sotomayor expressed concern that *Brunetti* could lead to an onslaught of new scandalous trademark applications.⁶⁴ Further, she seemed to agree with the government and advocated for a narrow construction of the word “scandalous,” interpreting it to regulate “only obscenity,

⁵⁶ *Id.* at 2302.

⁵⁷ *Id.* at 2301 (alternation in original).

⁵⁸ *Id.*

⁵⁹ *Id.* at 2301–02.

⁶⁰ *Id.* at 2301.

⁶¹ *Id.* at 2301–02.

⁶² *See id.* at 2303–04 (Roberts, C.J., dissenting); *id.* at 2304–08 (Breyer, J., dissenting); *id.* at 2308–18 (Sotomayor, J., dissenting).

⁶³ *See id.* at 2303–04 (Roberts, C.J., dissenting); *id.* at 2304–08 (Breyer, J., dissenting); *id.* at 2308–18 (Sotomayor, J., dissenting).

⁶⁴ *Id.* at 2308, 2318 (Sotomayor, J., dissenting).

vulgarity, and profanity,” thus saving the provision from unconstitutionality.⁶⁵ This narrow interpretation would create a viewpoint-neutral form of content discrimination, as restrictions on particular “modes of expression” do not inherently qualify as viewpoint discrimination.⁶⁶ These “modes of expression” are not by nature examples of “government target[ing] . . . particular views taken by speakers on a subject,” and therefore, should pass constitutional scrutiny.⁶⁷ Justice Sotomayor added that this form of discrimination should be permissible in the kind of discretionary governmental program or limited type of forum typified by the trademark registration system.⁶⁸ Ultimately, Justice Sotomayor not only advocated for the idea of prohibiting scandalous marks from registration but also provided Congress with a roadmap on how they could shape a new provision that would be constitutional.

3. Aftermath of *Brunetti*

After the *Tam* and *Brunetti* decisions, it may seem as though the prohibitions on disparaging, immoral, and scandalous marks may have met the same fate, but this is far from the case. While it appears the days ahead for any exclusions on disparaging marks are gloom, the immoral and scandalous prohibitions still have life. Between Justice Sotomayor’s dissent and the *Brunetti* majority failing to close the door on a narrowly crafted provision, the ball is now in Congress’s court to create a provision that passes potential First Amendment critique. After *Brunetti*, it is clear that the heart of the issue lies with the “immoral” provision,⁶⁹ but as Justice Sotomayor suggested, a “scandalous” provision can be revised to avoid unconstitutionality.

This Note proposes a provision that will slightly narrow the scandalous half of the old provision and try to merely salvage all that is possible from the immoral half. First, though, there are important First Amendment concepts that must be analyzed and scrutinized with regard to trademark registration.

⁶⁵ *Id.* at 2308 (Sotomayor, J., dissenting).

⁶⁶ *Id.* at 2309 (Sotomayor, J., dissenting).

⁶⁷ *Id.* at 2313 (Sotomayor, J., dissenting).

⁶⁸ *Id.*

⁶⁹ This is indicated by the *Brunetti* decision, as all nine Justices felt that the immoral provision was invalid, while only six Justices believed that the scandalous provision was invalid. *See Brunetti*, 139 S. Ct. at 2294.

II. THE FIRST AMENDMENT AND REGULATED SPEECH

A. *The Free Speech Clause*

The Free Speech Clause of the First Amendment reads: “Congress shall make no law . . . abridging the freedom of speech, or of the press.”⁷⁰ This amendment was undoubtedly a reaction against the suppression of speech and press that existed in English society, but, beyond this, there is little to no indication of what exactly the framers intended to achieve with this provision.⁷¹ For centuries, scholars have debated the meaning behind the Free Speech Clause. For example, the clause could be read with an absolutist lens, under which the First Amendment puts a complete stranglehold on Congress and prohibits virtually any law abridging the freedom of speech.⁷² However, the Supreme Court has generally rejected this view.

On the other hand, critics of the absolutist view commonly promote a more practical balancing approach, arguing that courts should weigh the competing social and individual interests in unregulated speech against legitimate social and individual interests in protecting against certain speech.⁷³ For example, First Amendment scholar Jud Campbell suggests that the founders thought that the Free Speech Clause allowed Congress to restrict speech and the press “only in the promotion of public good,” and that the First Amendment stood for a general principle that left plenty of room for debate as to how it should be applied in practice.⁷⁴ This view, rather than the absolutist view, more closely reflects reality, as it has been up to the courts to decide what speech can be regulated by the

⁷⁰ U.S. CONST. amend. I.

⁷¹ See RODNEY A. SMOLLA, SMOLLA AND NIMMER ON FREEDOM OF SPEECH 1–18 (1996); Jud Campbell, *What Did the First Amendment Originally Mean?*, RICH. L. (July 9, 2018), <https://lawmagazine.richmond.edu/features/article/-/15500/what-did-the-first-amendment-originally-mean.html>.

⁷² This absolutist view was famously used by Justices Black and Douglas. For Justice Black’s position, see *Konigsberg v. State Bar of Cal.*, 366 U.S. 36, 56 (1961) (Black, J., dissenting); *Braden v. United States*, 365 U.S. 431, 441 (1961) (Black, J., dissenting); *Wilkinson v. United States*, 365 U.S. 399, 446 (1961) (Black, J., dissenting); *Uphaus v. Wyman*, 364 U.S. 388, 392 (1960) (Black, J., dissenting); *Barenblatt v. United States*, 360 U.S. 109, 140 (1959) (Black, J., dissenting). For Justice Douglas’s position, see *N.Y. Times Co. v. United States*, 403 U.S. 713, 720 (1971) (Douglas, J., concurring); *Roth v. United States*, 354 U.S. 476, 508 (1957) (Douglas, J., dissenting); *Brandenburg v. Ohio*, 395 U.S. 444, 450 (1969) (Douglas, J., concurring).

⁷³ John R. Vile, *Ad Hoc Balancing*, FIRST AMEND. ENCYCLOPEDIA, <https://mtsu.edu/first-amendment/article/888/ad-hoc-balancing> (last visited Aug. 28, 2021).

⁷⁴ Campbell, *supra* note 71.

government.⁷⁵ Predictably, this has led to plenty of line drawing and judicially created categories of so-called “protected” and “unprotected” speech, the latter falling outside of the First Amendment’s protection.⁷⁶

As *Brunetti* points out, the Supreme Court has often held that the very core of the First Amendment is that the government cannot regulate speech based on the ideas or opinions the speech conveys; in other words, it cannot engage in viewpoint discrimination.⁷⁷ For example, with regard to the immoral or scandalous provision, if the Lanham Act permits registration of trademarks that promote society’s sense of morality, or marks that are neither immoral nor scandalous, then the Lanham Act must also permit the registration of trademarks with the opposing viewpoint, or marks that are indeed immoral or scandalous.⁷⁸ Put differently, the immoral or scandalous provision distinguishes between two opposite sets of trademarks: “those aligned with conventional moral standards and those hostile to them; those inducing societal nods of approval and those provoking offense and condemnation.”⁷⁹ As such, the Lanham Act allows for protection of the former, but disfavors the latter, displaying blatant viewpoint bias and violating the First Amendment.⁸⁰

B. *First Amendment Exceptions*

However, even in the context of viewpoint discrimination, the Supreme Court has drawn lines and created categories of unprotected speech that fall outside of the Free Speech Clause, thus granting the government more freedom to regulate speech. In other words, if the government seems to regulate protected viewpoint-based speech, as is the case with the immoral or scandalous provision, the next step is to determine whether that speech fits into some narrow category of unprotected speech.⁸¹ It is important to note that these categories are not determinative of whether

⁷⁵ *Id.*

⁷⁶ See CONG. RESEARCH SERV., THE FIRST AMENDMENT: CATEGORIES OF SPEECH, <https://fas.org/sgp/crs/misc/IF11072.pdf> (last updated Jan. 16, 2019).

⁷⁷ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2299 (2019).

⁷⁸ *Id.*

⁷⁹ *Id.* at 2296.

⁸⁰ *Id.* at 2300.

⁸¹ See *United States v. Stevens*, 559 U.S. 460, 470 (2010) (discussing the “historically unprotected categories of speech”).

or not a government regulation is constitutional, but they do signal when the government generally has more leeway to regulate speech based on its content.⁸²

Types of potentially viewpoint-based speech particularly relevant to trademarks that should be examined for their fit within categories of unprotected speech are: (1) obscenity, (2) profanity, (3) drug use, and (4) terroristic speech.⁸³ These have all frequently fallen within the immoral or scandalous provision's grasp in the past, so an investigation into each is worthwhile in constructing a new constitutionally sound provision. As Justice Sotomayor pointed out in *Brunetti*, obscenity and profanity fall under the "scandalous" heading and do not necessarily turn on viewpoint.⁸⁴ On the other hand, drug use and terrorism fall under the "immoral" heading and are more likely to turn on viewpoint.⁸⁵ Nonetheless, drug use and terrorism are both explicitly mentioned in *Brunetti* as problematic,⁸⁶ so if a new provision is to be doctored, these categories must also undergo an investigation.

1. Obscenity

The Supreme Court has held that "obscenity" is a category of speech unprotected by the First Amendment, but has generally struggled to define what is "obscene."⁸⁷ The Court seemed to "solve" this problem in *Miller v. California*,⁸⁸ when it set out three guiding principles for determining whether speech is obscene: (1) whether the average person, applying contemporary community standards would find that the work, taken as a whole, appeals to a prurient interest; (2) whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law, and (3) whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value.⁸⁹

On its face, the *Miller* standard may not seem like it would fit well as a USPTO trademark regulation. For one, the first two prongs of the *Miller* test are held to the

⁸² R.A.V. v. City of St. Paul, 505 U.S. 377, 383–84 (1992).

⁸³ See *Brunetti*, 139 S. Ct. at 2300, 2308.

⁸⁴ *Id.* at 2308 (Sotomayor, J., dissenting).

⁸⁵ See *id.* at 2300.

⁸⁶ *Id.*

⁸⁷ David L. Hudson, Jr., *Obscenity and Pornography*, FIRST AMEND. ENCYCLOPEDIA, <https://www.mtsu.edu/first-amendment/article/1004/obscenity-and-pornography> (last visited Aug. 28, 2021).

⁸⁸ 413 U.S. 15 (1973).

⁸⁹ *Id.* at 25.

standards of the community, while the third prong is held to what is reasonable to a person in the United States as a whole.⁹⁰ One reason the court may have added the last prong is to serve as a check on the first two prongs, protecting speech that may be considered obscene to a specific community, but that, on a national level, might provide positive value. In the case of trademarks, though, a national standard is really the only relevant standard. While it is true that some trademarks are used only in certain regions, registering a mark with the USPTO gives a trademark owner *national* protection. Thus, a USPTO trademark examiner should consider a mark's national impact rather than its impact on any certain community.

Moreover, the third prong specifically makes an exception for works that hold serious "literary, artistic, political, or scientific" value.⁹¹ This should not be relevant to trademarks, as trademarks are meant to identify and distinguish goods or services—they do not concern artistic or political value. Ultimately, while the *Miller* test may not be the perfect fit for trademarks, it provides a workable framework that can be utilized in creating a new "immoral or scandalous" provision set forth in Part III.⁹² Notably, it provides an objective reasonable person standard and proposes a definition for "obscene," both applicable to trademarks.

2. Profanity

Even though profanity and obscenity are two distinct categories of speech, the government often tries to regulate them and punish them in a similar manner.⁹³ However, the Supreme Court has held that profanity is generally protected by the First Amendment's Free Speech Clause.⁹⁴ Still, there remain some notable exceptions. Specifically, the Court has adopted a medium-by-medium approach, analyzing profane speech over broadcast media, telephones, and cable TV.⁹⁵

With regard to broadcast media, the Court held in *FCC v. Pacifica Foundation*, that broadcasting has less First Amendment protection than other forms of

⁹⁰ *Id.* at 24.

⁹¹ *Id.* at 26.

⁹² *See infra* Part III.

⁹³ *See* *Cohen v. California*, 403 U.S. 15 (1971).

⁹⁴ *See* David L. Hudson Jr., *Profanity*, FIRST AMEND. ENCYCLOPEDIA, <https://www.mtsu.edu/first-amendment/article/1143/profanity> (last visited Aug. 28, 2021).

⁹⁵ *See, e.g.,* *FCC v. Pacifica Found.*, 438 U.S. 726 (1978) (analyzing profanity in the broadcast media context); *Reno v. ACLU*, 521 U.S. 844 (1997) (analyzing profanity in the Internet context).

communication because of its pervasive nature.⁹⁶ The Court recognized that the government has strong interests in protecting children from “patently offensive” speech and in safeguarding the privacy of one’s home from this speech.⁹⁷ These two concerns, the Court said, were sufficient to “justify special treatment of indecent broadcasting.”⁹⁸ Lastly, the Court in *Pacifica* reasoned that radio and television stations already have a long history of government regulation and limited First Amendment protection.⁹⁹

Reaching the opposite conclusion with respect to the internet, the Court held in *Reno v. ACLU*, that it is unconstitutional to regulate profane speech over the internet.¹⁰⁰ The legitimate government interests set out in *Pacifica* are simply not present in the internet medium. For example, the internet is not invasive into the home like broadcast media, and the need to shield children is decreased.¹⁰¹ Moreover, there is no history of the government regulating the internet, at least not in 1997 when this case was decided.¹⁰² Accordingly, profane speech in broadcast media and profane speech over the internet are treated differently. And while trademarks differ from broadcast media and the internet in significant ways, trademarks can be compared to both when deciding which line of thought to follow.

To start, as previously stated, the purpose behind trademarks is to identify and distinguish goods or services. In reality, they can be used as a promotional tool just as much as they are meant to serve to avert potential consumer confusion.¹⁰³ Naturally, then, a trademark owner wants his or her mark to be seen and will spend money on advertising to ensure the mark is in the public eye.¹⁰⁴ Often, this is without any kind of consent from consumers. When it comes to profanity, this suggests that trademarks, which can be inherently invasive, should be treated in a similar manner as broadcast media, rather than the internet.

⁹⁶ *Pacifica Found.*, 438 U.S. at 748.

⁹⁷ *See id.* at 748–51.

⁹⁸ *Id.* at 750.

⁹⁹ *Id.* at 748.

¹⁰⁰ 521 U.S. 844 (1997).

¹⁰¹ *Id.* at 845.

¹⁰² *Id.*

¹⁰³ *See* Yaquinto, *supra* note 2, at 744.

¹⁰⁴ *See* Guttman, *supra* note 3.

Additionally, like broadcast media, there is a longstanding history of government regulations on trademarks.¹⁰⁵ Congress first enacted a federal trademark regime in 1870, adjusting and updating it numerous times since then,¹⁰⁶ including in 1946, when Congress¹⁰⁷ passed the Lanham Act. Further, in addition to federal law, many states add further protections to marks under state laws.¹⁰⁸ As such, the longstanding regulation of trademarks also suggests that the Court should treat marks similar to broadcast media when it comes to profanity. That is, the government's interest should be weighed against the Free Speech Clause, as in *Pacifica*.¹⁰⁹

3. Terrorism

In *Brunetti*, there is explicit mention of the USPTO's inconsistencies in granting registration for trademarks that display a "moral" view on terrorism, while denying registration for trademarks that endorse the opposite.¹¹⁰ While this distinction may be understandable, the Court has made clear that "a law disfavoring 'ideas that offend' discriminates based on viewpoint, in violation of the First Amendment."¹¹¹ For marks that reference terrorism, the most applicable area of free speech jurisprudence may be speech that advocates for illegal action,¹¹² with the most relevant case in this area being *Brandenburg v. Ohio*.¹¹³

In *Brandenburg*, a KKK leader gave a speech at a rally and said that "it's possible that there might have to be some revengeance [sic] taken."¹¹⁴ This KKK leader was convicted under the Ohio Criminal Syndicalism Act for advocating for violent actions and for assembling a group of people to carry out these actions.¹¹⁵ On appeal, the KKK leader challenged the act's validity on First Amendment free speech

¹⁰⁵ Abdel-khalik, *supra* note 15, at 180–85.

¹⁰⁶ *Id.* at 182.

¹⁰⁷ *Id.* at 185.

¹⁰⁸ *See, e.g.*, 54 PA. CONS. STAT. §§ 1001–126 (2020).

¹⁰⁹ *See FCC v. Pacifica Found.*, 438 U.S. 726 (1978).

¹¹⁰ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2300 (2019).

¹¹¹ *Id.* at 2301.

¹¹² *See Brandenburg v. Ohio*, 395 U.S. 444 (1969).

¹¹³ *See id.*

¹¹⁴ *Id.* at 446.

¹¹⁵ *Id.* at 444–45.

grounds.¹¹⁶ The Supreme Court used a two-part test to determine if the government may prohibit speech advocating the use of violence.¹¹⁷ If the speech (1) is “directed to inciting or producing imminent lawless action,” and (2) is “likely to incite or produce such action,” then the speech is not protected by the First Amendment.¹¹⁸

Admittedly, no trademark is likely to pass this test because no trademark calls for “imminent lawless action,” as required by the first prong. However, in the context of terroristic speech, it is reasonable, and arguably necessary, that the government use *proactive* regulation to prevent terroristic messages from coming to fruition. If the imminence standard is required to regulate terroristic speech, it creates room for danger because such a standard relies on a *retroactive* approach and sets a high burden to meet. In other words, a tragic event may occur before terroristic speech can be attacked.¹¹⁹ Therefore, prong one of the *Brandenburg* test does not fit squarely within the terroristic trademark context.

On the contrary, a more proactive approach to regulating terroristic trademarks would be a “substantial likelihood” standard, as seen in prong two of the *Brandenburg* test. A “[s]ubstantial likelihood [approach] means that, not only must the threat of harm be possible, but the speaker must be likely to achieve his or her goal of causing that harm without government intervention.”¹²⁰ This proactive approach would work perfectly in the trademark context, as it allows the USPTO to regulate trademarks during the registration process, before violence occurs. If nothing else, it creates a useable template for the new provision this Note proposes in Part III.¹²¹

4. Drug Use

In *Brunetti*, there is also explicit mention of the USPTO’s inconsistencies in granting registration for trademarks involving drug use.¹²² While taking a stance on drugs seems to be at the heart of viewpoint discrimination, speech that reasonably

¹¹⁶ *Id.* at 445.

¹¹⁷ *Id.* at 447.

¹¹⁸ *Id.*

¹¹⁹ Zachary Leibowitz, *Terror on Your Timeline: Criminalizing Terrorist Incitement on Social Media Through Doctrinal Shift*, 86 FORDHAM L. REV. 795, 821–22 (2017).

¹²⁰ *Id.* at 822.

¹²¹ See *infra* Part III.

¹²² *Iancu v. Brunetti*, 139 S. Ct. 2294, 2300 (2019).

encourages illegal drug use has been identified by the Supreme Court as a category of unprotected speech.¹²³

In *Morse v. Frederick*, a high school student displayed a banner with the message “Bong Hits 4 Jesus.”¹²⁴ His school principal proceeded to confiscate the banner and suspended the student.¹²⁵ The student challenged the suspension and claimed that the principal violated his First Amendment free speech rights.¹²⁶ The Supreme Court held that punishment for speech on school grounds is only appropriate if such speech will substantially interfere with the work of the school, and that the punishment here did not violate the First Amendment.¹²⁷ The holding was justified by explaining that the government and schools have a compelling interest in preventing illegal drug use among young students.¹²⁸ The breadth of the *Morse* holding has been debated, but it is generally believed that *Morse* is very narrow and applies to punishing student speech encouraging illegal drug use.¹²⁹

If *Morse* specifically applies to speech in a school setting, then its application to the trademark setting must be *extremely* narrow. Trademarks are meant to reach a wide audience, meaning that unless a trademark is meant to specifically target children and promote illegal drug use in a school setting, a rule like *Morse* likely cannot be applied. This means trademarks involving drug use will likely remain protected.

III. SAVING THE LANHAM ACT

A. A New Framework

In constructing a new immoral or scandalous provision, a couple key initial considerations must be accounted for. First, as the Court pointed out in *Brunetti*, the old provision was far too overbroad and led to inconsistent grants of registration,¹³⁰

¹²³ See *Morse v. Frederick*, 551 U.S. 393 (2007).

¹²⁴ *Id.* at 397.

¹²⁵ *Id.* at 398.

¹²⁶ *Id.* at 399.

¹²⁷ *Id.* at 403.

¹²⁸ See Erwin Chemerinsky, *How Will Morse v. Frederick Be Applied?*, 12 LEWIS & CLARK L. REV. 17 (2008).

¹²⁹ *Id.* at 21.

¹³⁰ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2300 (2019).

so a new provision must be sufficiently narrow to generate consistent results. Also, the Court indicated that it was more open to the idea of a scandalous provision, as such a provision is less likely to turn on viewpoint than an immoral provision.

With these considerations in mind, a new provision should not be a single overarching, unitary provision as in the past; instead, there should be a clear line between the immoral provision and the scandalous provision. Further, there should be distinct categories within each of the immoral and scandalous provisions. Specifically, within the scandalous provision, there should be two categories: (a) obscenity and (b) profanity, mirroring the suggestions set forth by Justice Sotomayor in *Brunetti*.¹³¹ Additionally, under the immoral provision, the categories should be even more narrow and unambiguously enumerated. For the purpose of this Note, the categories (c) terrorism and (d) drug use will take focus, as these were two major categories the Court focused on in *Brunetti*.¹³² It is worthwhile to note that these last two categories are certainly not the only categories that can fall under an immoral heading.¹³³ In fact, Congress can add as many categories as necessary. However, as explained by *Brunetti*, if Congress wants to prohibit the registration of immoral marks, Congress must be exceedingly narrow and specific in the marks considered to be problematic. So, if other “immoral” marks are to be barred, they should be added by name to the provision.

Moreover, to determine if a specific mark will fail under either the immoral or scandalous provisions, the USPTO should follow a two-part examination. The first part asks which provision, either immoral or scandalous, and which category the problematic trademark falls within. For example, a mark focused on marijuana falls under the immoral provision and under the “drug use” category. The second part entails applying a category-specific test to the trademark. These category-specific tests, set forth below, are modeled after previously established Supreme Court decisions introduced in Part II.

To summarize, the first prong of this proposed two-prong test puts a trademark in the appropriate bucket. This ensures that the provisions are not too broad and overreaching—if a trademark does not fall within an enumerated bucket, the immoral and scandalous provisions will not apply. Similarly, the second prong applies a bucket-specific Supreme Court-approved First Amendment analysis to the mark. This ensures the new immoral or scandalous provision is constitutionally sound, as

¹³¹ *Id.* at 2308 (Sotomayor, J., dissenting).

¹³² *Id.* at 2300.

¹³³ *Id.* (noting that religion, for example, can also fall under the immoral heading).

decisions will no longer turn on viewpoint. Naturally, this will lead to more consistent results.

B. *Category-Specific Tests*

The provision's first category addresses obscenity. The test for obscene marks should be as follows:

In deciding if a mark is obscene and unregistrable, a USPTO examiner should consider: (1) whether the average person, applying national standards, would find the mark obscene; and (2) whether the work depicts or describes, in a patently offensive way, sexual conduct.

The above language follows the test set forth in *Miller*.¹³⁴ However, instead of *Miller*'s community standard, this test uses a national standard. This is important because trademark registration gives an owner rights to their mark in every state, not just one community. Further, the third prong of the *Miller* test was not included, as trademarks should not concern themselves with "literary, artistic, political, or scientific value." Rather, trademarks are meant to identify goods and services, not to serve as standalone works of art. Overall, this new category is narrow enough to lead to consistent results, but broad enough to keep obscene marks from being registered, serving both government and First Amendment interests.

The provision's second category addresses profanity. The test for profane marks should be as follows:

In deciding if a mark is especially profane and unregistrable, a USPTO examiner should consider: (1) if the content is "grossly offensive" language that is considered a public nuisance; and (2) the context and setting of the mark's use.

This test mirrors the standards set forth in *Pacifica* and FCC regulations.¹³⁵ The first prong is simply the suggested definition of "profane" set forth by the FCC.¹³⁶ Further, the second prong accounts for the context and setting of the mark's use. For example, if the mark is used in a way that makes it highly visible to children, it will

¹³⁴ See *Miller v. California*, 413 U.S. 15, 24 (1973).

¹³⁵ See *FCC v. Pacifica Found.*, 438 U.S. 726, 748–49 (1978); *Obscene, Indecent and Profane Broadcasts*, *supra* note 6 ("Profane content includes 'grossly offensive' language that is considered a public nuisance.").

¹³⁶ *Pacifica Found.*, 438 U.S. at 748–49; *Obscene, Indecent and Profane Broadcasts*, *supra* note 6.

likely be rejected. On the other hand, if the mark is for products used exclusively by adults or a mature audience, it will likely be granted registration and protection. Like the obscenity category, this profanity provision is narrow, unambiguously defines “profanity,” and describes the considerations, namely the context and setting, to be accounted for in an analysis. Not only should this lead to more consistent results, but it should pass any First Amendment challenge.

The provision’s third category addresses terrorism. The test for marks that may be interpreted to have a terroristic message should be as follows:

In deciding if a mark reflects a terroristic message in an inappropriate manner, a USPTO examiner should consider: (1) if the speech is directed at producing lawless action; and (2) if the speech is substantially likely to produce such action if there is no government intervention.

This test follows the factors considered in *Brandenburg*. While the *Brandenburg* test included an “imminent” standard, as discussed in Section II.B.3, an imminence requirement creates room for danger, as it is mainly a retroactive approach.¹³⁷ To combat this issue, the test above includes a proactive “substantial likelihood” standard.

A few examples of proposed terroristic marks the Court included in *Brunetti* are: “WAR ON TERROR MEMORIAL,” “AL-QAEDA” on t-shirts, and “BABY AL QAEDA” on t-shirts.¹³⁸ Under the proposed standard, WAR ON TERROR MEMORIAL would be registrable, as this speech is not directed at lawless action, nor is it likely to produce such action. However, AL-QAEDA, the name of a well-known terror group and orchestrators of terroristic attacks that have killed thousands,¹³⁹ will likely be denied registration. Printing the mark on a t-shirt likely implies that the terror group is being promoted or endorsed, and given the group’s murderous history, it is not out of the question that promoting such a group will lead to increased violence. Finally, a mark like BABY AL QAEDA, which was denied registration under the old provision, will likely be granted registration under this proposed provision because the speech is not necessarily pointed at producing lawless action, as the word “baby” shows shades of parody or satire.

¹³⁷ See *supra* Section II.B.3.

¹³⁸ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2300 (2019).

¹³⁹ *Al-Qaeda Terrorist Attacks by Number of Deaths from 1993 to 2010*, STATISTA (May 3, 2011), <https://www.statista.com/statistics/272757/al-qaeda-terrorist-attacks-by-death-toll/>.

Overall, this proposed provision is more narrowly tailored and should lead to more consistent results. Only true terroristic speech, which is speech that is not afforded First Amendment protection, will be targeted.

The provision's final category addresses marks related to drug use. While this part will be exceedingly narrow and apply to few mark applications, it may nonetheless be useful to include in a proposed immoral or scandalous provision for clarity.

In deciding if a mark reflects a message that promotes drug use, a USPTO examiner should consider: (1) if a mark is specifically directed at promoting drug use; (2) if a mark is specifically directed at school-aged children; and (3) if the mark actually promotes drug use among school-aged children.

This standard follows the *Morse* opinion and is consistent with the compelling government interest in preventing illegal drug use among young students.¹⁴⁰

A few examples of proposed marks the Court included in *Brunetti* are: "SAY NO TO DRUGS—REALITY IS THE BEST TRIP IN LIFE" and "MARIJUANA COLA" for beverages.¹⁴¹ Under the proposed standard, the first mark will plainly be granted registration because it does not promote drug use, even if it may target school-aged children.¹⁴² The second mark will also likely be granted registration because, even if it may seem to promote drug use, there is no clear indication that it is targeting school-aged children. However, an example of a mark that may be denied registration under this proposed provision is "SMOKE WEED" on a t-shirt line targeting young adults. This mark would be denied registration because it meets all three prongs of the test.

Again, while this final category is narrow and will rarely be used to deny registration, if nothing else, it demonstrates the kind of tailoring Congress will need to engage in to save the immoral or scandalous provision.

¹⁴⁰ See *Morse v. Frederick*, 551 U.S. 393, 408–09 (2007).

¹⁴¹ *Brunetti*, 139 S. Ct. at 2300.

¹⁴² See generally *Just Say No*, HISTORY (May 13, 2017), <https://www.history.com/topics/1980s/just-say-no> (last updated Aug. 21, 2018) (referencing an anti-drug ad campaign in schools using the slogan "Just Say No").

As a final note, the *Brunetti* opinion also explains that there have been a great number of inconsistencies in the USPTO's granting marks about religion.¹⁴³ Because freedom of religion is engrained in the First Amendment of the Constitution,¹⁴⁴ there is likely no provision that could pass constitutional muster. Thus, all religious marks should be granted, assuming that they pass other statutory requirements, of course.

IV. CONCLUSION

All in all, in light of the recent *Brunetti* decision, it is imperative that the Lanham Act's immoral or scandalous provision be revitalized. If not, there may be an influx of obscene, profane, and vulgar marks, among others, being registered with the USPTO and gaining prevalence in society. Because the Court left the ball in Congress's court to create a narrow and consistent provision, Congress must do just that. As this Note points out, the proposed provision will carry out the purpose of the old provision, while still passing constitutional muster. In other words, the proposed provision will realize the best of both worlds, as it upholds free speech rights while keeping certain trademarks from the public eye.

¹⁴³ *Id.*

¹⁴⁴ U.S. CONST. amend. I.