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Examining the Impact of *In re Brunetti* on § 2(a) of the Lanham Act

Alex Weidner

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NOTE

Examining the Impact of *In re Brunetti* on § 2(a) of the Lanham Act

In re Brunetti, 877 F.3d 1330 (Fed. Cir. 2017), *cert. granted sub nom. Iancu v. Brunetti*, No. 18-302, 2019 WL 98541 (U.S. Jan. 4, 2019) (mem.)

Alex Weidner*

I. INTRODUCTION

For § 2(a) of the Lanham Act,¹ 2017 proved to be a devastating year. Not only did the *Matal v. Tam* decision strike down the disparagement provision,² it served as a springboard for *In re Brunetti* to invalidate the bar against immoral and scandalous marks later that year.³ This Note examines whether the majority correctly invalidated the immoral-scandalous provision, argues that it did not, and analyzes the likelihood the remaining two provisions in the Lanham Act will be struck down by another First Amendment challenge.

Part II summarizes the facts and holding of *In re Brunetti*. Part III provides an overview of trademarks and examines the intersection of free speech with trademark law. Part IV analyzes the reasoning behind the Court's holding. Part V argues the majority was hasty in invalidating the immoral-scandalous bar completely and the concurring opinion was correct in suggesting a narrow construction of the statute that bars only the registration of obscene marks. It also examines what remains of § 2(a) and argues the remainder of the statute is safe from First Amendment challenge.

II. FACTS AND HOLDING

Erik Brunetti (“Brunetti”), an artist and entrepreneur responsible for “popularizing ‘streetwear’ having revolutionary themes, proudly subversive graphics[,] and in-your-face imagery,” filed an application at the United States Patent and Trademark Office (“USPTO”) seeking protection for the mark

* B.S., University of Missouri, 2016; J.D. Candidate, University of Missouri School of Law, 2019; Layout and Design Editor, *Missouri Law Review*, 2018-2019. I am grateful to Professor Lietzan for her insight, guidance, and support during the writing of this Note, as well as the *Missouri Law Review* for its help in the editing process.

1. 15 U.S.C. § 1052(a) (2018), *declared unconstitutional by In re Brunetti*, 877 F.3d 1330 (Fed. Cir. 2017), *cert. granted sub nom. Iancu v. Brunetti*, No. 18-302, 2019 WL 98541 (U.S. Jan. 4, 2019) (mem.).

2. 137 S. Ct. 1744, 1765 (2017).

3. *See In re Brunetti*, 877 F.3d at 1357.

FUCT⁴ to use as the brand name for a line of clothing.⁵ The Trademark Examining Attorney (“Examiner”) issued an office action rejecting the application on the grounds that the application contained immoral or scandalous matter, which was prohibited by § 2(a) of the Lanham Act.⁶

The Examiner argued FUCT was the “phonetic equivalent” of “fucked,” which was vulgar and therefore immoral or scandalous.⁷ In his reply to the office action, Brunetti provided evidence demonstrating that FUCT referenced a clothing brand and that “the public [did] not perceive [FUCT] as vulgar.”⁸ Despite this evidence, a final refusal was issued by the Examiner.⁹ Brunetti sought reconsideration of the matter, but it was similarly denied.¹⁰ Brunetti appealed the decision to the Trademark Trials and Appeals Board (“TTAB”).¹¹

The TTAB affirmed the Examiner’s rejection,¹² concluding FUCT was chosen by Brunetti because it provided plausible deniability about whether it was “merely another way to say ‘fucked’” while not fooling its target audience.¹³ The TTAB found FUCT was the functional equivalent of “fucked,” and the sole question it addressed was whether “fucked” was a scandalous term.¹⁴ In making the determination, the TTAB examined both the traditional dictionary definition of “fucked”¹⁵ and the Urban Dictionary definition of

4. To assist the reader with differentiating trademarks from the rest of the text, all marks are capitalized.

5. *In re Brunetti*, 2014 WL 3976439, at *1–2 (T.T.A.B. 2014); Brief for Applicant-Appellant Erik Brunetti at 3, *In re Brunetti*, 2015 WL 514695 (Fed. Cir. 2015) [hereinafter Brief for Appellant].

6. *In re Brunetti*, 2014 WL 3976439, at *1.

7. *Id.* In his argument, the Examiner cited the first definition that appears on Urban Dictionary, *id.* at *3, which defines the word “fuct” as the following:

The past tense of the verb fuck. Also used to express a general state of incapability.
We are so fuct!
She fuct me like a dog in heat!
That’s fuct up!
(Rural definition) Hey maw, I just fuct yer best frind.

URBAN DICTIONARY, <https://www.urbandictionary.com/define.php?term=fuct> (last visited Oct. 18, 2018).

8. Brief for Appellant, *supra* note 5, at 4.

9. *Id.*

10. *Id.* at 5.

11. *Id.*

12. *In re Brunetti*, 2014 WL 3976439, at *6.

13. *Id.* at *4.

14. *Id.* at *5.

15. *Id.* at *3. The TTAB cited macmillandictionary.com’s definition of fucked, which was:

Fuck *Vulgar Slang*
v. fucked, fuck•ing, fucks

FUCT.¹⁶ Because “fucked” was associated with “decidedly-negative sexual connotations, . . . extreme misogyny, depravity, violence, intolerance, anger, and imagery of being ‘doomed’ or a ‘loser,’” the TTAB deemed both FUCT and “fucked” to be scandalous terms barred from registration by § 2(a) of the Lanham Act.¹⁷ It affirmed the Examiner’s refusal to register the mark.¹⁸

Brunetti appealed to the U.S. Court of Appeals for the Federal Circuit, which reversed the TTAB and held “the bar in § 2(a) against immoral or scandalous marks [was] unconstitutional because it violat[ed] the [F]irst [A]mendment.”¹⁹

III. LEGAL BACKGROUND

In re Brunetti deals extensively with both trademark law and First Amendment jurisprudence. To gain a better understanding of the legal background of the court’s decision, Section A of this Part provides an overview of First Amendment law, focusing on the types of scrutiny associated with certain forms of speech. Section B then explores the interaction of First Amendment and trademark law.

A. The First Amendment

The First Amendment states, “Congress shall make no law . . . abridging the freedom of speech”²⁰ At first blush, the First Amendment appears to be a sweeping prohibition, but it is not given its literal meaning.²¹ The free speech clause offers varying levels of protection for different types of private speech²² and does not regulate government speech at all.²³ A substantial body of First Amendment jurisprudence has developed over the last century, and

v.tr.

1. To have sexual intercourse with.
2. To take advantage of, betray, or cheat; victimize.
3. Used in the imperative as a signal of angry dismissal.

v.intr.

1. To engage in sexual intercourse.
2. To act wastefully or foolishly.
3. To interfere; meddle. Often used with *with*.

Id.

16. See URBAN DICTIONARY, *supra* note 7.
17. *In re Brunetti*, 2014 WL 3976439, at *4, *6.
18. *Id.* at *6.
19. *In re Brunetti*, 877 F.3d 1330, 1357 (Fed. Cir. 2017), *cert. granted sub nom. Iancu v. Brunetti*, No. 18-302, 2019 WL 98541 (U.S. Jan. 4, 2019) (mem.).
20. U.S. CONST. amend. I.
21. See generally *In re Brunetti*, 877 F.3d at 1330.
22. *Matal v. Tam*, 137 S. Ct. 1744, 1757 (2017).
23. *Id.*

three strands of jurisprudence are relevant here. First, differing levels of scrutiny are applied to restrictions on private speech based on whether the speech is expressive,²⁴ commercial,²⁵ or obscene.²⁶ Second, when the government creates a forum for speech, restrictions on speech depend upon the nature of the forum created.²⁷ Third, although Congress holds the power of the purse,²⁸ it may not fund private programs or activities in a way that unconstitutionally burdens one's rights.²⁹

1. Categories of Private Speech

Generally, private speech is speech that is associated with a private individual or entity rather than a government.³⁰ There are many forms of private speech, with different rules governing each type.³¹ Government restrictions on expressive speech are presumptively invalid and subject to strict scrutiny if they are content-based.³² Such restrictions will be upheld only if the government can show “that the restriction furthers a compelling interest and is narrowly tailored to achieve that interest.”³³

Commercial speech is “solely related to the economic interests of the speaker and its audience.”³⁴ The First Amendment “protects commercial speech from unwarranted governmental regulation,”³⁵ but the United States Supreme Court has recognized a “commonsense distinction” between commercial and other varieties of speech.³⁶ Restrictions on commercial speech may be subject to intermediate scrutiny,³⁷ which means that the restrictions are constitutional “so long as the distinctions drawn are reasonable in light of

24. *In re Brunetti*, 877 F.3d at 1359.

25. *Id.* at 1349.

26. *Id.* at 1356.

27. *Id.* at 1345–46.

28. U.S. CONST. art. I, § 8, cl. 1.

29. *See, e.g.*, *Agency for Int'l Dev. v. All. for Open Soc'y Int'l, Inc.*, 570 U.S. 205, 214 (2013) (second alteration in original) (“[The Court has] held that the Government ‘may not deny a benefit to a person on a basis that infringes his constitutionally protect . . . freedom of speech even if he has no entitlement to that benefit.’”); *see also* *Rust v. Sullivan*, 500 U.S. 173, 207 (1991) (Blackmun, J., dissenting).

30. *See* *Matal v. Tam*, 137 S. Ct. 1744, 1757 (2017).

31. *See* sources cited *supra* notes 24–26 and accompanying text.

32. *In re Brunetti*, 877 F.3d at 1342.

33. *Id.* (quoting *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2231 (2015)).

34. *Cent. Hudson Gas & Elec. v. Pub. Serv. Comm'n*, 447 U.S. 557, 561 (1980).

35. *Id.* (citing *Va. Pharmacy Bd. v. Va. Citizens Consumer Council*, 425 U.S. 748, 762 (1976)).

36. *Id.* at 562 (quoting *Ohralik v. Ohio State Bar Ass'n.*, 436 U.S. 447, 455–56 (1978)).

37. *In re Brunetti*, 877 F.3d at 1350.

the[ir] purpose”³⁸ Thus, “The protection available for particular commercial expression turn on the nature both of the expression and of the governmental interests served by its regulation.”³⁹

Finally, the Court has recognized that “the unconditional phrasing of the First Amendment was not intended to protect every utterance,” and there are forms of private speech that are not protected by the First Amendment.⁴⁰ Obscenity and fighting words are two common examples of speech that are not entitled to First Amendment protection.⁴¹

2. Forum Analysis

When restrictions are placed on individuals speaking on government property, the Court’s method of “forum analysis” is applied, which “determine[s] when a governmental entity, in regulating property in its charge, may place limitations on speech.”⁴² The most common locations where forums exist are “venues that are owned and controlled by government entities.”⁴³ Some cases, however, have found forums to exist “more in a metaphysical than in a spatial or geographic sense” so long as the forum is still connected to government property.⁴⁴ In each of these forums, viewpoint-based discrimination is presumed to be unconstitutional.⁴⁵ The forums differ, however, as to the level of scrutiny applied to content-based restrictions.⁴⁶

The Court has stated there are three types of forums.⁴⁷ Traditional public forums, “such as streets and parks,” are places that exist to be used by the public for communication and discussion between citizens.⁴⁸ Similarly, designated public forums are places that are traditionally not used as a public forum

38. *Id.* at 1346 (quoting *Cornelius v. NAACP Legal Def. & Educ. Fund, Inc.*, 473 U.S. 788, 806 (1985)).

39. *Cent. Hudson Gas & Elec.*, 447 U.S. at 563.

40. *Roth v. United States*, 354 U.S. 476, 483 (1957).

41. *See, e.g., id.* at 485 (obscenity); *United States v. Williams*, 553 U.S. 285, 288 (2008) (obscenity); *Chaplinsky v. New Hampshire*, 315 U.S. 568, 572 (1942) (fighting words).

42. *In re Brunetti*, 877 F.3d at 1345 (alteration in original) (quoting *Christian Legal Soc’y of the Univ. of Cal. Hastings Coll. of the Law v. Martinez*, 561 U.S. 661, 669 (2010)).

43. *Id.* at 1346.

44. *Id.* at 1347 (citing *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 830 (1995)). In *Rosenberger*, the Court found that a student activity fund was a limited public forum even though it was metaphysical because the effects of the fund affected the university, which was government property. *Id.*

45. *Id.* at 1346.

46. *Id.*

47. *Id.* at 1345–46.

48. *Id.* (citing *Perry Educ. Ass’n v. Perry Local Educators’ Ass’n*, 460 U.S. 37, 45 (1983)).

but have been opened up for that purpose.⁴⁹ Strict scrutiny applies to government-imposed, content-based speech restrictions in both of these forums.⁵⁰ Limited public forums “are places the government has ‘limited to use by certain groups or dedicated solely to the discussion of certain subjects.’”⁵¹ In a limited public forum, content-based restrictions are subjected to intermediate scrutiny as opposed to strict scrutiny.⁵²

3. Funding Restrictions

Within the context of Congress’ spending power,⁵³ the unconstitutional conditions doctrine has been developed to address how the spending power and First Amendment interact.⁵⁴ The Constitution grants Congress the power to fund state or private activities and attach requirements to that funding.⁵⁵ If an organization disagrees with the conditions Congress has attached to the funding, the typical remedy is to not accept the funding.⁵⁶ The United States Supreme Court has found, however, that the unconstitutional conditions doctrine applies if funding conditions create an “unconstitutional burden” on an individual’s rights.⁵⁷ The Court has stated there is a constitutional line between apparent restrictions on speech that merely define the boundaries of a government program and those that seek to regulate speech.⁵⁸

Several cases have examined where exactly the constitutional line lies. In *Rust v. Sullivan*,⁵⁹ the Court upheld a Title X restriction preventing federal funding from being used in programs where abortion was a method of family planning because the restriction only affected Title X programs and did not prevent other, separate programs from providing abortions so long as federal funds were not used.⁶⁰ Because the requirement merely operated within the

49. *Id.*

50. *Id.*

51. *Id.* (quoting *Pleasant Grove City v. Summum*, 555 U.S. 460, 469 (2009)).

52. *See id.* (quoting *Cornelius v. NAACP Legal Def. & Educ. Fund, Inc.*, 473 U.S. 788, 806 (1985)).

53. U.S. CONST. art. I, § 8, cl. 1.

54. *See Matal v. Tam*, 137 S. Ct. 1744, 1760–61 (2017) (“[W]e have held that the Government ‘may not deny a benefit to a person on a basis that infringes his constitutionally protect . . . freedom of speech even if he has no entitlement to that benefit.’”).

55. *Agency for Int’l Dev. v. All. for Open Soc’y Int’l, Inc.*, 570 U.S. 205, 213 (2013).

56. *Id.* at 214.

57. *Id.* at 214–25.

58. *In re Brunetti*, 877 F.3d 1330, 1357 (Fed. Cir. 2017) (quoting *Agency for Int’l Dev.*, 570 U.S. at 214–15), *cert. granted sub nom. Iancu v. Brunetti*, No. 18-302, 2019 WL 98541 (U.S. Jan. 4, 2019) (mem.).

59. 500 U.S. 173 (1991).

60. *Id.* at 202.

scope of Title X's program and did not affect the activities of private individuals, it was constitutionally permissible.⁶¹ In *Agency for International Development v. Alliance for Open Society International, Inc.*,⁶² however, the Court struck down a funding condition of the United States Leadership Against HIV/AIDS, Tuberculosis, and Malaria Act ("Leadership Act") that provided federal funding for organizations combatting HIV/AIDS, tuberculosis, and malaria because the condition required the organizations to oppose prostitution, which the Court determined reached outside the scope of the Leadership Act.⁶³ In essence, a funding condition that restricts speech may be upheld so long as it does not create an "unconstitutional burden" and is within the scope of the government program, but it will be struck down if it exceeds the scope of the program and attempts to regulate the activities of private individuals. The level of scrutiny for such programs may fluctuate depending on the type of subsidy program, ranging from intermediate to strict scrutiny.⁶⁴

B. Trademarks and the First Amendment

In recent years, courts have grappled with the application of First Amendment principles to the law governing trademark registration. The Lanham Act defines a trademark as "any word, name, symbol, or device . . . [u]sed by a person . . . [t]o identify and distinguish [their] goods . . . from those manufactured or sold by others"⁶⁵ The core function of trademarks is to allow consumers to distinguish between sources of goods. Courts will enforce a trademark owner's right to exclusive use of the trademark within an area of commerce to protect this source-identifying function.⁶⁶

Because common law protections for trademarks exist, they need not be registered with the federal government to be protectable.⁶⁷ Registration, however, offers many advantages.⁶⁸ One such advantage is that registration allows for nationwide protection of a trademark,⁶⁹ while unregistered marks may only

61. *Id.*

62. 570 U.S. 205.

63. *Id.* at 209–10, 220–21.

64. *See In re Brunetti*, 877 F.3d 1330, 1342 (Fed. Cir. 2017), *cert. granted sub nom. Iancu v. Brunetti*, No. 18-302, 2019 WL 98541 (U.S. Jan. 4, 2019) (mem.).

65. 15 U.S.C. § 1127 (2018).

66. *See id.* § 1114.

67. *See id.* § 1125(a) (granting a civil cause of action for infringement of unregistered marks).

68. *See id.* § 1114 (granting a civil cause of action for infringement of registered marks); *id.* § 1065 (granting incontestability for registered marks in continuous use for over five years); *id.* § 1072 (granting constructive notice of ownership upon registration of a mark).

69. *Id.* § 1057(c).

be protectable in the limited area where they are used.⁷⁰ The benefits of registration are significant enough that most trademark owners engaging in interstate commerce seek to register their marks, which is accomplished by applying to the USPTO.⁷¹ There are, however, limits upon what types of marks may be federally registered.⁷² Among other things, § 2(a) precludes the registration of any mark that is immoral, scandalous, deceptive, or disparaging and any mark that falsely suggests a connection with a person.⁷³ In determining whether a mark may be registered, the USPTO reviews the mark under the standards imposed by the Lanham Act and decides whether it may be registered.⁷⁴ By the terms of § 2(a), the determination requires the USPTO to examine the content of the mark and thus the content of the speech.⁷⁵ This led to the question of whether § 2(a)'s requirement that the USPTO consider the content of a trademark applicant's speech violated the First Amendment.⁷⁶

In *Matal v. Tam*,⁷⁷ the United States Supreme Court attempted to answer the question. In *Tam*, Simon Tam, a member of The Slants, an Asian American rock group, attempted to register "THE SLANTS" as a trademark.⁷⁸ The USPTO denied the application on the basis of § 2(a) of the Lanham Act because the Examiner found the mark violated the provision prohibiting "the registration of trademarks that may 'disparage . . . or bring . . . into contemp[t] or disrepute' any 'persons, living or dead'" because "slants" is a derogatory term for people of Asian descent.⁷⁹ The TTAB affirmed the Examiner, but the Federal Circuit reversed.⁸⁰ The United States Supreme Court granted certiorari to determine whether the disparagement clause of § 2(a) was invalid under the First Amendment.⁸¹

The Court upheld the decision of the Federal Circuit, concluding the disparagement clause was unconstitutional because it was in violation of the First Amendment.⁸² The Court found that mere registration was insufficient to

70. *See id.* § 1115(b)(5). Section 1115(b)(5) protects individuals that used a mark in a limited geographic area prior to the registration of the same mark by another individual. *Id.* The unregistered prior user may continue to use the mark but must only use it within the limited geographic area they operated in prior to the mark being registered. *Id.* The owner of the registered mark retains rights to use the mark everywhere else. *See id.*

71. *Id.* § 1051.

72. *See id.* § 1052.

73. *Id.* § 1052(a).

74. *See id.* § 1051.

75. *See id.* § 1052.

76. *See, e.g., Matal v. Tam*, 137 S. Ct. 1744 (2017).

77. 137 S. Ct. 1744.

78. *Id.* at 1751, 1754.

79. *Id.* at 1751 (quoting 15 U.S.C. § 1052(a)).

80. *Id.* at 1754.

81. *Id.* at 1755.

82. *Id.* at 1765.

transform expressive ideas into government speech and trademarks were entitled to First Amendment protection.⁸³ The Court declined to address whether trademarks were purely commercial speech or a hybrid of commercial and expressive speech because the disparagement clause could not prevail under the standard of review associated with either category.⁸⁴ To prove this, the Court applied intermediate scrutiny and found the bar on disparaging trademarks unconstitutional.⁸⁵ The Court noted that neither the interest of preventing underrepresented groups from being “‘bombarded with demeaning messages in commercial advertising’” nor the interest of protecting the “‘orderly flow of commerce’” was sufficient to withstand intermediate scrutiny and thus the § 2(a) bar on disparaging marks was unconstitutional.⁸⁶

IV. INSTANT DECISION

Section A of this Part discusses the majority opinion and examines the reasoning behind the invalidation of the immoral-scandalous clause. It begins with the majority’s categorization of trademarks as private speech and then analyzes the other arguments put forward by the government before concluding with the majority’s view on the obligation to construe statutes to preserve their constitutionality. Section B then discusses the concurring opinion.

A. The Majority Opinion

With regard to whether FUCT was scandalous, the Federal Circuit agreed with the TTAB and the Examiner, concluding that “‘the [US]PTO may prove scandalousness by establishing that a mark is ‘vulgar’”⁸⁷ and “‘substantial evidence supports the [TTAB’s] finding the mark FUCT is vulgar.’”⁸⁸ It also agreed with the TTAB that FUCT was the “‘phonetic twin’ of ‘fucked’” and that the connection between the two was “‘sufficient to render the vulgarity of the word ‘fuck’ relevant to the vulgarity of [FUCT].’”⁸⁹ On the basis that “‘fucked’ was vulgar and therefore scandalous, the Federal Circuit concluded the rejection was proper unless the immoral-scandalous provision itself violated the First Amendment.”⁹⁰

The constitutionality analysis for § 2(a) performed by the Federal Circuit involved analyzing trademark registration in the context of several different

83. *Id.* at 1760.

84. *See id.* at 1764–65.

85. *Id.*

86. *Id.*

87. *In re Brunetti*, 877 F.3d 1330, 1335–36 (Fed. Cir. 2017) (quoting *In re Fox*, 702 F.3d 633 (2012)), *cert. granted sub nom. Iancu v. Brunetti*, No. 18-302, 2019 WL 98541 (U.S. Jan. 4, 2019) (mem.).

88. *Id.* at 1338–40.

89. *Id.* at 1338.

90. *See id.* at 1339–40.

First Amendment principles.⁹¹ The Court in *Tam* had already rejected the argument that trademarks were a form of government speech,⁹² leaving the Federal Circuit with the task of determining what category of private speech trademarks fell into.⁹³ It also considered whether the provision should be analyzed under the limited public forum or government subsidy doctrines.⁹⁴ The Federal Circuit then applied the appropriate level of scrutiny to determine the constitutionality of the provision.⁹⁵ If the provision was deemed unconstitutional, then the court had to consider whether there was any reasonable interpretation that could prevent the provision from being unconstitutional.⁹⁶ If no such interpretation existed, then the provision had to be struck down.⁹⁷

1. Categories of Private Speech

The Federal Circuit rejected the government's argument that trademarks were purely commercial speech.⁹⁸ While trademarks are used in commerce as a means of communicating information about the seller, the product, and the price to customers, they can also convey "powerful messages" unrelated to the source-identifying function.⁹⁹ The Federal Circuit found that such an ability made trademarks expressive speech, which required it to analyze the immoral-scandalous bar under strict scrutiny.¹⁰⁰ By the government's own concession, § 2(a)'s bar on immoral and scandalous marks could not survive such scrutiny and thus the restriction was unconstitutional.¹⁰¹

Despite this conclusion, the Federal Circuit applied intermediate scrutiny to show that even if trademarks were commercial speech, § 2(a) was unconstitutional.¹⁰² The Federal Circuit applied the four-part test outlined in *Central Hudson Gas & Electric Corp. v. Public Service Commission of New York*¹⁰³ for determining whether there is a substantial governmental interest.¹⁰⁴ The test involved determining "whether (1) the speech concerns lawful activity and is not misleading; (2) the asserted government interest is substantial; (3) the

91. *Id.* at 1337–40.

92. *Matal v. Tam*, 137 S. Ct. 1744, 1760 (2017).

93. *See In re Brunetti*, 877 F.3d at 1342–49.

94. *Id.* at 1342–48.

95. *Id.* at 1348–50.

96. *Id.* at 1355.

97. *Id.*

98. *Id.* at 1348–49.

99. *Id.* (quoting *Matal v. Tam*, 137 S. Ct. 1744, 1760 (2017)).

100. *Id.* at 1349.

101. *Id.*

102. *Id.* at 1350–55.

103. 447 U.S. 557, 566 (1980).

104. *In re Brunetti*, 877 F.3d at 1350.

regulation directly advances that government interest; and (4) . . . the regulation is ‘not more extensive than necessary to serve that interest.’”¹⁰⁵

The Federal Circuit found that neither the second, the third, nor the fourth requirements were met.¹⁰⁶ With regard to the second requirement, the Federal Circuit found that the government’s interest in suppressing speech merely because it offends society was not substantial because it was contrary to the “‘bedrock First Amendment principle’ that ‘[s]peech may not be banned on the ground that it expresses ideas that offend.’”¹⁰⁷ The third requirement was not met because prohibiting registration of the mark would not suppress speech due to the fact that, regardless of whether he had a federally registered trademark, Brunetti could use “FUCTION” on his clothing.¹⁰⁸ Finally, the fourth requirement was deemed not to have been met because the USPTO’s inconsistent application of the provision undermined the likelihood the provision was narrowly tailored.¹⁰⁹ Because all four requirements of the test were not satisfied, the Federal Circuit concluded the immoral-scandalous provision did not survive either intermediate or strict scrutiny and was unconstitutional.¹¹⁰

The majority also briefly addressed the concurring opinion’s argument that the provision could be saved by narrowing it to bar only the registration of obscene marks.¹¹¹ It concluded the definitions of “immoral” and “scandalous” were so far removed from the definition of “obscene” that to construe the provision to prohibit only the registration of obscene marks would usurp the power of the legislature.¹¹²

2. Forum Analysis

The Federal Circuit then considered the issue of whether trademark registration was a limited public forum,¹¹³ which would allow for intermediate scrutiny of the immoral-scandalous bar, regardless of whether trademarks were expressive speech.¹¹⁴ The government contended that, like the student activity fund in *Rosenberger*,¹¹⁵ the principal register was a metaphysical limited public forum.¹¹⁶ The Federal Circuit rejected this argument, concluding that while the United States Supreme Court has permitted some forums to be more “metaphysical” than “spatial or geographic,” they nonetheless had to be “tethered

105. *Id.* (quoting *Cent. Hudson Gas & Elec. v. Pub. Serv. Comm’n*, 447 U.S. 557, 566 (1980)).

106. *Id.* at 1350–54.

107. *Id.* at 1351 (quoting *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017)).

108. *Id.* at 1353.

109. *Id.* at 1353–54 (citing *Reno v. ACLU*, 521 U.S. 844, 871 (1997)).

110. *Id.* at 1355, 1357.

111. *Id.* at 1355.

112. *Id.* at 1356–57.

113. *Id.* at 1345.

114. *See id.* at 1346.

115. *See* discussion of *Rosenberger* *supra* note 44.

116. *In re Brunetti*, 877 F.3d at 1346–47.

to government properties.”¹¹⁷ Trademarks, which are owned and used by private entities, do not share this attribute.¹¹⁸ Trademarks are not connected to government properties but instead “make up part of the expression of everyday life.”¹¹⁹ As such, the Federal Circuit held restricting speech would “chill speech anywhere from the Internet to the grocery store” and restrict speech in areas far beyond those owned by the government.¹²⁰ The Federal Circuit further found the mere placement of registered trademarks on the principal register was insufficient to transform trademark registration into a limited public forum because the principal register simply functions as a “database” and is ancillary to trademark registration.¹²¹

3. Funding Restrictions

The Federal Circuit rejected the government’s argument that trademarks were a form of government subsidy program that would entitle the restriction on speech to intermediate scrutiny.¹²² According to the government subsidy framework articulated in *Agency for International Development*, attaching conditions to government funds, including those which are apparent restrictions on speech, is constitutional so long as the restrictions define the contours of the subsidy program rather than seek to regulate speech.¹²³ Trademark registration, however, neither implicated Congress’ spending power nor functioned as a “subsidy equivalent.”¹²⁴ When registering a mark, the applicant pays the USPTO, not vice versa, and private rather than federal funding is involved in the transaction.¹²⁵ Although the USPTO does use federal funds, they are only “tangentially” involved with trademark registration.¹²⁶ Thus, the court held “[t]he government’s involvement in processing and issuing trademarks does not transform trademark registration into a government subsidy.”¹²⁷

4. Saving Interpretation

Referencing a canon of statutory construction that statutes should be construed so as to preserve their constitutionality whenever possible, the Federal

117. *See id.* at 1347 (citing *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 830 (1995)).

118. *See id.*

119. *Id.* at 1348.

120. *Id.*

121. *Id.*

122. *Id.* at 1345.

123. *Agency for Int’l Dev. v. All. for Open Soc’y Int’l, Inc.*, 570 U.S. 205, 214–15 (2013).

124. *In re Brunetti*, 877 F.3d at 1344.

125. *Id.*

126. *Id.*

127. *Id.*

Circuit also considered other potential interpretations of § 2(a).¹²⁸ Ultimately, it concluded no reasonable interpretation of the statute would survive strict scrutiny¹²⁹ and it struck down the bar against registering immoral or scandalous trademarks.¹³⁰

The majority disagreed with the concurrence's contention that "immoral" and "obscene" should be given the same definition in order to create an interpretation of the provision that would preserve its constitutionality.¹³¹ It stated the United States Supreme Court made it clear obscenity only involves that "which deals with sex" and that of the dictionaries cited by the concurrence define either "immoral" or "scandalous" in sexual terms.¹³² Because "immoral" and "scandalous" lack an explicitly sexual definition, the majority held the immoral-scandalous provision bars substantively different material than what would be covered by a bar on obscenity.¹³³ Additionally, the majority held to construe the provision in the manner suggested by the concurring opinion would be to rewrite the provision rather than narrow it and would usurp the power of the legislature.¹³⁴

B. The Concurring Opinion

In his concurring opinion, Judge Timothy B. Dyk agreed that the majority reached the correct decision with regard to Brunetti and that the immoral-scandalous provision was constitutionally problematic.¹³⁵ He disagreed, however, with the majority's finding that there was no constitutional construction that could save the provision from invalidation.¹³⁶ Judge Dyk emphasized the duty of courts to, "where possible, construe federal statutes so as to avoid serious doubt of their constitutionality."¹³⁷ Because of this duty, he would have construed the statute to bar only marks that are obscene rather than strike down the provision in its entirety.¹³⁸

Judge Dyk argued that a constitutional construction of the immoral-scandalous provision could be reached by reading it, in light of obscenity case law, to prohibit only the registration of obscene marks.¹³⁹ He contended that dictionaries from the time of the 1905 enactment of the immoral-scandalous provision list "immoral" as a synonym of "obscene" and that the two words should

128. *Id.* at 1355.

129. *Id.* at 1349.

130. *Id.* at 1357.

131. *Id.* at 1355–56.

132. *Id.* at 1356.

133. *Id.* at 1356–57.

134. *Id.* at 1357.

135. *Id.* at 1358 (Dyk, J., concurring).

136. *Id.*

137. *Id.* (quoting *Stern v. Marshall*, 564 U.S. 462, 477 (2011)).

138. *Id.*

139. *Id.* at 1358.

be given the same meaning.¹⁴⁰ Because interpreting the immoral-scandalous provision to prohibit only the registration of obscene marks would provide a constitutional construction, Judge Dyk argued the Federal Circuit was obliged to adopt that construction rather than invalidate the provision entirely.¹⁴¹ Judge Dyk nevertheless concurred in the result because there was “no suggestion that [FUCT was] obscene” and therefore the mark was registrable regardless.¹⁴²

V. COMMENT

The majority erred in invalidating the immoral-scandalous provision. As indicated in Judge Dyk’s concurring opinion, the immoral-scandalous provision should have been narrowed rather than invalidated. As explained below, the rest of § 2(a) should be safe from a challenge on First Amendment grounds.

A. The Immoral-Scandalous Provision Should Have Been Narrowed

The majority’s invalidation of the immoral-scandalous provision was premature. Both the majority and concurring opinions acknowledged that courts have a duty to attempt to find a reasonable construction of a statute in order to prevent its invalidation.¹⁴³ The majority, however, asserted two primary arguments for refusing to narrow the statute.¹⁴⁴ First, it argued that the definitions of “immoral” and “scandalous” are fundamentally different from that of “obscene.”¹⁴⁵ Second, it stated that limiting the immoral-scandalous provision to only bar the registration of scandalous materials would effectively usurp the legislature’s power because such a construction would effectively rewrite the statute to take on a definition not intended by the legislature.¹⁴⁶

The majority takes an unnecessarily literal view of the definitions of immoral, scandalous, and obscene. While none of the definitions cited by the majority define “immoral” or “scandalous” in explicitly sexual terms,¹⁴⁷ a nuanced view of the definitions includes references to sex. The definitions cited by the majority define immoral as “not moral” or “contrary to good morals.”¹⁴⁸ The United States Supreme Court has frequently considered morality-based legislation concerning sexual matters.¹⁴⁹ Such cases reveal that morality, and

140. *Id.* at 1359.

141. *Id.* at 1359–60.

142. *Id.* at 1360–61.

143. *Id.* at 1358, 1360.

144. *Id.* at 1355–57 (majority).

145. *Id.* at 155–56.

146. *Id.* at 1356–57.

147. *Id.* at 1356.

148. *Id.*

149. *See generally, e.g.,* *Lawrence v. Texas*, 539 U.S. 558 (2003) (striking down a law prohibiting “deviate sexual intercourse” between two persons of the same sex); *Roe v. Wade*, 410 U.S. 113 (1973) (striking down a law prohibiting any abortion except “by

therefore immorality, can involve that which deals with sex and can therefore involve obscenity.

The distinction drawn by the majority attempts to completely separate that which is immoral or scandalous from that which is obscene and ignores the fundamental interconnectedness of the two concepts. The majority acknowledges that “[t]here is no dispute that an obscene mark would be scandalous or immoral”¹⁵⁰ If the concepts were truly separate, as the majority indicates, then such a result would not occur. Despite that fact, the majority still refused to construe the statute simply because “not all scandalous or immoral marks are obscene.”¹⁵¹ Such logic is flawed. Obscene marks are simply a subset of immoral or scandalous marks; that is, the definition of an immoral or scandalous mark naturally encompasses that which is obscene.

Because obscene marks are a subset of immoral or scandalous marks, the majority was incorrect in stating that narrowing the statute would usurp the legislative power. While the majority was correct in stating that giving an entirely new definition to a statute would usurp the legislative power, it failed to recognize that immoral and scandalous can be read as obscene. Thus, the concurrence proposed a reasonable construction that must be adopted rather than an unreasonable usurpation of the legislature. Essentially, the concurrence proposed pruning rather than rewriting and therefore was correct in stating the statute should be narrowed rather than invalidated.

Because a reasonable construction of the statute exists and is sufficient to preserve the statute’s constitutionality, and because a court must not strike down a statute as unconstitutional if a reasonable construction exists,¹⁵² the majority erred in finding the immoral-scandalous provision unconstitutional. The concurring opinion was correct in its analysis and conclusion that the provision should be narrowed in scope rather than struck down.

B. The Remainder of § 2(a) of the Lanham Act Is Safe from First-Amendment Challenge

After the *Tam* and *Brunetti* decisions, two of the five statutory bars of § 2(a) remain: (1) the bar on deceptive marks and (2) the bar on marks that falsely suggest a connection with a person.¹⁵³ Both provisions can withstand strict scrutiny and are safe from a First Amendment challenge.

The government has a compelling interest in preventing the registration of deceptive trademarks. The fundamental purpose of trademarks is to be used by consumers in commerce to identify and distinguish their goods from the

medical advice for the purpose of saving the life of the mother”); *Griswold v. Connecticut*, 381 U.S. 479 (1965) (striking down Connecticut law imposing punishment on those who uses contraceptives).

150. *In re Brunetti*, 877 F.3d at 1355.

151. *Id.*

152. *Id.* at 1358 (Dyk, J., concurring).

153. 15 U.S.C. § 1052(a) (2018).

goods of others.¹⁵⁴ Deceptive marks obfuscate the source of goods and make it harder for consumers to distinguish the goods they wish to purchase from those they deem inferior. The narrowly tailored requirement is also satisfied because the provision only prevents the registration of marks that are deceptive.

The compelling interest supporting the bar on falsely suggestive marks is similar to, but slightly weaker than, that of the interest supporting the bar on deceptive marks. Marks that falsely suggest a connection with a person make it difficult for consumers to identify the source of a good and, consequently, frustrate the source-identifying function of a trademark. There is a compelling interest in preventing this type of confusion. Unlike deceptive marks, however, there is a greater possibility the mark would not actually cause confusion because consumers would see through the false connection. Another possibility is that this type of confusion would be more easily remedied by adding a disclaimer to the product than would a product sold under a deceptive mark. Despite these possibilities, it is still likely that preserving the source-identifying function would be deemed a sufficiently compelling interest to survive scrutiny. By only prohibiting trademarks that falsely suggest a connection, the prohibition is narrowly tailored.

Because the two remaining provisions are capable of surviving strict scrutiny, it is likely that they are safe from First Amendment challenge.

VI. CONCLUSION

In *In re Brunetti*, the Federal Circuit invalidated the immoral-scandalous provision on the ground that it conflicted with the First Amendment, which allowed the mark FUCT to be registered.¹⁵⁵ While allowing FUCT to be registered was proper, the majority erred in concluding there was no reasonable interpretation of the immoral-scandalous provision that could preserve its constitutionality. It is improper to prevent the registration of marks that are merely “immoral” or “scandalous,” but First Amendment jurisprudence indicates it would proper to narrow the bar to prevent only the subset of immoral or scandalous marks that are also obscene. Because courts have a duty to preserve the constitutionality of a statute unless there is no reasonable interpretation,¹⁵⁶ the majority failed its duty when it rejected a rational interpretation of the immoral-scandalous provision. The concurring opinion, which suggested preserving the statute by limiting its reach to obscene marks,¹⁵⁷ had the correct analysis of the case.

With the immoral-scandalous and disparagement provisions deemed unconstitutional, only two portions of § 2(a) remain.¹⁵⁸ Both remaining provisions, however, have a compelling interest that the immoral-scandalous and

154. *Id.* § 1127.

155. *In re Brunetti*, 877 F.3d at 1357.

156. *See id.* at 1358 (Dyk, J., concurring).

157. *Id.* at 1357–61.

158. *See* 15 U.S.C. § 1052(a).

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disparagement provisions were lacking – an interest in preserving the source identification function of trademarks. Both are also narrowly tailored and capable of withstanding strict scrutiny. The remaining provisions are likely safe from First Amendment challenge, which means that while the disparagement and immoral-scandalous provisions are FUCT, the remaining provisions almost certainly are not.

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