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## Some First Amendment Implications of the Trademark Registration Decisions

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# SOME FIRST AMENDMENT IMPLICATIONS OF THE TRADEMARK REGISTRATION DECISIONS

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## I. INTRODUCTION

In two decisions rendered in two recent terms, the United States Supreme Court has struck down, as violative of the First Amendment, two provisions of the federal Lanham Act that barred the registration of certain kinds of

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trademarks.<sup>1</sup> In *Matal v. Tam*,<sup>2</sup> the Court invalidated the section of the statute that prohibited the registration of a mark that “[c]onsists of or comprises . . . matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”<sup>3</sup> In *Iancu v. Brunetti*,<sup>4</sup> the Court invalidated another part of the very same statutory section, namely the prohibition of registration of a mark which “[c]onsists of or comprises immoral . . . or scandalous matter.”<sup>5</sup> The constitutional problem, in each case, was that the prohibition amounted to impermissible viewpoint discrimination.<sup>6</sup> But while the ruling in *Tam* was unanimous, the decision in *Brunetti* was not, and the multiple opinions written in *Brunetti* raise some important questions regarding (a) the constitutionality of other provisions of the Lanham Act (including possible amendments in the wake of *Brunetti*); and (b) the potential resolution of issues that may arise outside the narrow context of trademark registration.

This article offers some preliminary thoughts concerning the possible implications of *Tam* and *Brunetti*. I begin with a brief primer on trademark law, for the benefit of readers who lack expertise therein.

## II. THE BASICS OF AMERICAN TRADEMARK LAW

To understand these decisions, one must have some minimal acquaintance with American trademark law. A mark serves as an indication of the source of goods or services,<sup>7</sup> and one acquires ownership of a mark by being the first to use it, in commerce,<sup>8</sup> in a particular location.<sup>9</sup> Ownership of a mark entitles one to prevent the use of a mark, by someone else, that is likely to create consumer confusion as to the source or sponsorship of that second user’s mark<sup>10</sup>—and the owner of a mark has that right under the common law of every state,<sup>11</sup>

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1. A “trademark,” according to the Lanham Act, “includes any word, name, symbol, or device, or any combination thereof—used. . . to identify and distinguish [one’s] goods . . . and to indicate the source of the goods.” A “service mark” is defined almost identically, but with reference to “services” instead of “goods.” 15 U.S.C. sec. 1127. There are no significant legal consequences flowing from the distinction. J. Thomas McCarthy, *Trademarks and Unfair Competition* 4:7 (5th ed. 2019). In this article, I will use the term “trademark,” or “mark,” to refer to both trademarks and service marks.

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

3. 15 U.S.C. § 1052(a).

4. 139 S. Ct. 2294, 2297 (2019).

5. 15 U.S.C. § 1052(a).

6. 137 S. Ct. at 1751; 139 S. Ct. at 2297.

7. *MicroStrategy Inc. v. Motorola, Inc.*, 245 F.3d 335, 341 (4th Cir. 2001).

8. *B & B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293, 1299 (2015).

9. *Natural Footwear Ltd. v. Hart, Schaffner & Marx*, 760 F.2d 1383, 1394 (3rd Cir. 1985).

10. 15 U.S.C. § 1114(1); *Fla. Int’l Univ. Bd. of Trustees v. Fla. Nat’l Univ.*, 830 F.3d 1242, 1255 (11th Cir. 2016).

11. *Int’l Order of Job’s Daughters v. Lindeburg & Co.*, 633 F.2d 912, 915–16 (9th Cir. 1980).

registration of the mark is not required. Registration is an option, however, both at the state<sup>12</sup> and federal level, and, as one would expect, registration provides certain benefits. At the federal level, one may apply for registration at the federal Patent and Trademark Office (PTO),<sup>13</sup> pursuant to the Lanham Act, and the application will be approved if the PTO is satisfied that the applicant is the first user of the mark, the mark has been used in interstate commerce,<sup>14</sup> and that it is otherwise eligible for federal registration. The primary criterion for eligibility is that the mark be “distinctive”—*i.e.*, that it is capable of distinguishing the applicant’s goods or services from those of others.<sup>15</sup> The Lanham Act sets out several categories of marks that are ineligible for registration.<sup>16</sup> Some of those categories bear a clear relationship to the overriding statutory goals of preventing consumer confusion or deception;<sup>17</sup> notably, one presumptively cannot register a mark that “so resembles a mark registered in the Patent and Trademark Office, or a mark . . . previously used . . ., as to be likely . . . to cause confusion.”<sup>18</sup> Other presumptively unregistrable marks, such as those that are “merely descriptive”<sup>19</sup> or “primarily geographically descriptive,”<sup>20</sup> lack the requisite distinctiveness.<sup>21</sup> But some of the statutory bars to registration,<sup>22</sup> like those at issue in *Tam* and *Brunetti*, which date back to the Act’s inception in 1946, serve other, unidentified policy goals.<sup>23</sup> Thus, for example, one cannot

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12. Gene Quinn, *State vs. Federal Trademarks, Which is Right for Your Business?*, IP Watchdog (Nov. 25, 2017), <https://www.ipwatchdog.com/2017/11/25/state-federal-trademarks-right-business/id=90214/>.

13. 15 U.S.C. § 1051(a).

14. *Christian Faith Fellowship Church v. Adidas AG*, 841 F.3d 986, 989 (Fed. Cir. 2016).

15. 15 U.S.C. § 1052.

16. 15 U.S.C. § 1052(a)–(e).

17. 15 U.S.C. § 1052(a) (“deceptive”), (e)(1) (“deceptively misdescriptive”), and (e)(3) (“primarily geographically deceptively misdescriptive”).

18. 15 U.S.C. § 1052(d). But, “if the [PTO] determines that confusion . . . is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons . . .” *Id.*

19. 15 U.S.C. § 1052(e)(1).

20. 15 U.S.C. § 1052(e)(2).

21. But these types of marks, along with some others, may acquire the requisite distinctiveness—commonly called “secondary meaning”—over time, and thus be entitled to registration. *See* text at note 166, *infra*, and 15 U.S.C. § 1052(f).

22. *See* 15 U.S.C. § 1052(a)–(c), and text at notes 176–88, *infra*.

23. “The central purpose of trademark registration is to facilitate source identification . . . Whether a mark is disparaging bears no plausible relation to that goal.” *Matal v. Tam*, 137 S. Ct. at 1768 (Kennedy, J., concurring in part and concurring in the judgment).

register a mark which consists of a national flag,<sup>24</sup> or (presumptively) the name of a deceased President of the United States during the life of his widow.<sup>25</sup>

When federal registration is denied by virtue of one of these provisions, the mark owner may nonetheless continue to use the mark in commerce.<sup>26</sup> What, then, does a mark owner lose by failing to attain federal registration of a mark? Registration on the so-called “principal register”<sup>27</sup> confers a variety of benefits, most notably these: prima facie evidence of the validity and ownership of a mark, and the exclusive right to use it;<sup>28</sup> a nationwide right of priority with respect to the mark;<sup>29</sup> constructive notice, to the world, of the registrant’s claim of ownership of the mark;<sup>30</sup> the possible attainment of “incontestability” of the mark;<sup>31</sup> and the right to use, with the mark, one of the forms of notice of registration set forth in the statute.<sup>32</sup> The essential point is that denial of federal registration, on the basis of the content of the mark, does not prevent use of the mark, but does deprive the owner of some significant benefits.<sup>33</sup>

### III. THE FIRST AMENDMENT RULINGS

#### A. *Prior to Tam*

What, then, was the proper judicial response to a First Amendment challenge to a statutory bar to registration based on the content of a mark? Note,

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24. 15 U.S.C. § 1052(b).

25. 15 U.S.C. § 1052(c).

26. *Brunetti*, 139 S. Ct. 2294, 2303 (2019) (Roberts, C.J., concurring in part and dissenting in part). Whether a mark that is unregistrable federally may be registered at the state level is not entirely clear. *Compare* *In re Tam*, 808 F.3d 1321, 1344 (Fed. Cir. 2015) (*en banc*), *with id.* at 1375 (Lourie, J., dissenting).

27. Everything I have said about federal trademark registration, thus far, has been said with reference to the PTO’s so-called “principal register.” 15 U.S.C. § 1051–52. There is also a “supplemental register,” 15 U.S.C. § 1091, on which registration is easier, but which affords far fewer benefits. 15 U.S.C. § 1094.

28. 15 U.S.C. § 1057(b).

29. 15 U.S.C. § 1057(c). This means that, contrary to the common law rule (pursuant to which trademark rights can be enforced only in geographic areas in which the mark owner uses the mark), a federal registrant enjoys exclusive rights, with regard to use of the mark, even in states in which the registrant has never used it. But that priority must yield to common law rights established by use of the same or similar mark, prior to federal registration, in a particular geographic area. 15 U.S.C. § 1115(b)(5). *See* *Natural Footwear Ltd. v. Hart, Schaffner & Marx*, 760 F.2d 1383, 1395 (3rd Cir. 1985).

30. 15 U.S.C. § 1072.

31. *Id.* § 1115(b). Whereas registration equals prima facie evidence of validity, ownership, and exclusive right to use a mark, “incontestability,” achieved over time, confers “conclusive evidence” of those legal consequences. *See* *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189 (1985).

32. *Id.* § 1111.

33. *See also* 15 U.S.C. § 1124, which provides a registered trademark owner protection against importation of infringing merchandise.

first, that trademarks have been treated as forms of speech, thereby bringing the First Amendment into play.<sup>34</sup> Most marks, by far, would be viewed as exemplars of “commercial speech,”<sup>35</sup> which explains why the prevention of use of a mark which is likely to create consumer confusion as to source or sponsorship poses no First Amendment problem; “false or misleading” commercial speech receives no First Amendment protection.<sup>36</sup> But a mark, particularly a service mark, will not necessarily be deemed “commercial.”<sup>37</sup> Should a content-based ban on registration of a mark be subjected, then, to the well-established analysis for determining the constitutionality of regulations of commercial speech,<sup>38</sup> or perhaps to strict judicial scrutiny, as content-based regulations of speech otherwise usually are?<sup>39</sup>

Consider now the meaning of the two provisions at issue in *Tam* and *Brunetti*.

Case law established that the determination of whether a mark was “disparaging” (at least in the context of disparagement of an identified group,<sup>40</sup> as in *Tam*) was to be determined by looking to the reactions of a substantial composite of the allegedly disparaged group.<sup>41</sup> Were ordinary First Amendment principles to be employed, this provision would surely be stricken as an instance of impermissible viewpoint discrimination.<sup>42</sup>

As to “scandalous or immoral” marks (the subject of *Brunetti*), courts often said this: “In order to prove that [a] mark is scandalous, the PTO must demonstrate that the mark is ‘shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable . . . .’”<sup>43</sup> Alternatively, it was said: “A

34. “Today, however, it is unquestionably true that trademarks are protected speech under Supreme Court commercial speech jurisprudence. . . . [T]he Supreme Court held that the trade name of an optometrist is commercial speech. *Friedman v. Rogers*, 440 U.S. 1, 11 (1979). . . . Because a trademark identifies the source of a product or service for users, it is protected commercial speech.” *In re Tam*, 785 F.3d 567, 575 (Fed. Cir. 2015) (Moore, J., “additional views”). See also *Rubin v. Coors Brewing Co.*, 514 U.S. 476 (1995). The Supreme Court, in *Tam*, appeared to view this conclusion as too clear to even warrant any comment.

35. Commercial speech is most often described, for First Amendment purposes, as “speech which does ‘no more than propose a commercial transaction.’” *Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60, 66 (1983).

36. *Central Hudson Gas & Electric Corp. v. Public Service Comm’n of N.Y.*, 447 U.S. 557, 563 (1980).

37. See text at notes 143–46, *infra*.

38. See text at note 148, *infra*.

39. *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2226–27 (2015).

40. As Justice Alito stated in *Tam*: “A mark that disparages a ‘substantial’ percentage of the members of a racial or ethnic group necessarily disparages many ‘persons,’ namely, members of that group.” 137 S. Ct. at 1756 (citation omitted).

41. *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 124–25 (D.D.C. 2003).

42. See *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017).

43. *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

showing that a mark is vulgar is sufficient to establish that it ‘consists of or comprises immoral . . . or scandalous matter.’<sup>44</sup> Whether “commercial” or not, should the impediment to registering a “vulgar” mark have been stricken pursuant to the courts’ longstanding protection of “offensive” speech?<sup>45</sup>

But recall that even an unregistered mark may be used and may receive protection under the common law. Until *Tam*, the prevailing judicial view (which I will call the “minimal burden” approach) appeared to be, as one court expressed it, that “the refusal to register a mark does not proscribe any conduct or suppress any form of expression because it does not affect the applicant’s right to use the mark in question.”<sup>46</sup> Denial of registration was therefore not seen as a burden on speech sufficient to trigger any First Amendment analysis.

### B. *Tam*

These bars to registration thus appeared to be constitutionally unproblematic, until *Tam*’s challenge to the “disparagement” clause reached the Court of Appeals for the Federal Circuit. *Tam*, the lead singer of a band called “The Slants,” sought federal registration of “THE SLANTS” as a service mark, but the PTO rejected his application as “disparaging” to Asians. Based on circuit precedent, the Court rejected *Tam*’s First Amendment challenge to the statutory ban on registration of such words, but offered a separate opinion in which Judge Moore called for the Court to revisit that governing precedent.<sup>47</sup> That led to that court’s *en banc* ruling, which did just that, and invalidated the ban on registration of “disparaging” marks.<sup>48</sup> Denial of registration, said Judge Moore, had “a chilling effect on speech.”<sup>49</sup> The Supreme Court unanimously affirmed,<sup>50</sup> without even commenting explicitly on the minimal-burden approach that had held sway for so long.

The ruling was squarely based on the concept of viewpoint discrimination. Writing for the Court, Justice Alito stated that the disparagement provision “offends a bedrock First Amendment principle: Speech may not be banned on the

44. *In re The Boulevard Entertainment, Inc.*, 334 F.3d 1336, 1340 (Fed. Cir. 2003).

45. See text at notes 196–98, *infra*.

46. *In re The Boulevard Entertainment, Inc.*, 334 F.3d at 1343; *accord*, *In re Tam*, 785 F.3d 567, 572 (Fed. Cir. 2015); *In re Mavety Media Group*, 33 F.3d 1367, 1374 (Fed. Cir. 1994); *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A.1981). That most of these rulings were made by the United States Court of Appeals for the Federal Circuit is no accident; per the Lanham Act, 15 U.S.C. § 1071(a), that is the appellate court with jurisdiction to hear appeals from denials of registration by the PTO. (The predecessor to that court, up until 1982, was the Court of Customs and Patent Appeals.)

47. *In re Tam*, 785 F.3d 567, 573 (Fed. Cir. 2015) (Moore, J., “additional views”).

48. *In re Tam* 808 F.3d 1321, 1339–55 (Fed. Cir. 2015) (*en banc*).

49. *Id.* at 1345.

50. 137 S. Ct. 1744 (2017).

ground that it expresses ideas that offend.”<sup>51</sup> But beyond that key assertion (and the Court’s rejection of Tam’s statutory argument<sup>52</sup> and the PTO’s “government speech” argument<sup>53</sup>), unity gave way to two separate opinions, each representing the views of four Justices.<sup>54</sup> The government, of necessity, had argued that the usual rules of First Amendment analysis (identified above) should not be applied in this context. In furtherance of this attempt to escape heightened judicial scrutiny, the government argued that the PTO’s registration scheme should be (a) deemed to be “government speech;” (b) analogized to government programs subsidizing speech; or (c) analyzed “under a new doctrine that would apply to ‘government-program’ cases.”<sup>55</sup> Each of these positions was essentially, if not formally, a “minimal burden” argument, and Alito rejected each one in turn,<sup>56</sup> joined by only three Justices except in his repudiation of the “government speech” argument. Perhaps notably, in his rejection of the “government program” argument, Alito said this:

Potentially more analogous are cases in which a unit of government creates a limited public forum for private speech. When government creates such a forum, in either a literal or “metaphysical” sense, some content- and speaker-based restrictions may be allowed. However, even in such cases, what we have termed “viewpoint discrimination” is forbidden.

Our cases use the term “viewpoint” discrimination in a broad sense, and in that sense, the disparagement clause discriminates on the bases of “viewpoint” . . . . Giving offense is a viewpoint.<sup>57</sup>

In a footnote, he added: “We leave open the question whether this is the appropriate framework for analyzing free speech challenges to provisions of the Lanham Act.”<sup>58</sup>

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51. *Id.* at 1751.

52. *Id.* at 1755–56.

53. *Id.* at 1757–60.

54. Justice Gorsuch took no part in the decision. *Id.* at 1750.

55. *Id.* at 1757–63.

56. *Id.*

57. *Id.* at 1763. Justice Alito’s assertion, in *Tam*, that “giving offense” invariably amounts to viewpoint discrimination has been appropriately criticized. Clay Calvert, *Merging Offensive-Speech Cases With Viewpoint-Discrimination Principles: The Immediate Impact of Matal v. Tam on Two Strands of First Amendment Jurisprudence*, 27 WM. & MARY BILL OF RTS. J. 829 (2019). The concurring opinions in *Brunetti*, see the discussion at notes 77–100 *infra*, bolster the argument that Alito’s generalization was overbroad. See also Kent Greenfield, *Trademarks, Hate Speech, and Solving a Puzzle of Viewpoint Bias*, 2019 S. CT. REV. 183, 219–23.

58. *Matal v. Tam*, 137 S. Ct. at 1763 n. 16.



Finally, Alito—again writing only for four Justices—brushed aside the government’s argument that the disparagement clause should survive as a regulation of commercial speech, declining to decide whether commercial-speech analysis was applicable here because the clause would fail to withstand even that lower level of scrutiny.<sup>59</sup> No matter how the government interest underlying the provision is articulated, he said, “its unmistakable thrust is this: The Government has an interest in preventing speech expressing ideas that offend . . . [T]hat idea strikes at the heart of the First Amendment.”<sup>60</sup>

Justice Kennedy wrote a concurring opinion, joined by three other Justices, asserting that “the viewpoint discrimination rationale renders unnecessary any extended treatment of other questions raised by the parties.”<sup>61</sup> What appeared notable, at the time he wrote them, were these general statements by Justice Kennedy concerning viewpoint discrimination:

As the Court is correct to hold, § 1052(a) constitutes viewpoint discrimination—a form of speech suppression so potent that it must be subject to rigorous constitutional scrutiny. The Government’s action and the statute on which it is based cannot survive this scrutiny.<sup>62</sup>

A law found to discriminate based on viewpoint is an “egregious form of content discrimination,” which is “presumptively unconstitutional.”<sup>63</sup>

[T]he viewpoint based discrimination at issue here necessarily invokes heightened scrutiny.<sup>64</sup>

“Commercial speech is no exception,” the Court has explained, to the principle that the First Amendment “requires heightened scrutiny whenever the government creates a regulation of speech because of disagreement with the message it conveys.”<sup>65</sup>

But compare:

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59. *Id.* at 1763-65. He added, in a footnote, that “we leave open the question whether *Central Hudson* provides the appropriate test for deciding free speech challenges to provisions of the Lanham Act.” *Id.* at 1764, n. 17.

60. *Id.* at 1764.

61. *Id.* at 1765 (Kennedy, J., concurring in part and concurring in the judgment).

62. *Id.*

63. *Id.* at 1766 (*quoting* Kennedy’s opinion in *Rosenberger v. Rector and Visitors of Univ. of Va.*, 515 U.S. 819, 829–30 (1995)).

64. *Id.* at 1767.

65. *Id.*, *quoting* *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566 (2011).

[C]ommercial speech . . . does not serve as a blanket exemption from the First Amendment’s requirement of viewpoint neutrality.<sup>66</sup>

And:

It is telling that the Court’s precedents have recognized just one narrow situation in which viewpoint discrimination is permissible: where the government itself is speaking or recruiting others to communicate a message on its behalf.<sup>67</sup>

The first four statements, by referring expressly or impliedly to “heightened scrutiny,” suggest that a finding of viewpoint discrimination does not end the analysis. But the latter two statements arguably imply the contrary, as do the pertinent pronouncements of Justice Alito—who said nothing in his opinion about any “scrutiny” of viewpoint discrimination. So, which is it? We will return to this point.

### *C. Brunetti*

The inevitable question, in *Tam*’s wake, was the constitutionality of the Lanham Act’s ban on registration of “immoral or scandalous” marks.<sup>68</sup> The answer was not long in coming; two years after *Tam*, the Supreme Court, ruling on a facial challenge brought by a maker of clothing who sought to register the mark “FUCT,” held that this provision embodied the same fatal flaw as did the disparagement clause: viewpoint discrimination.<sup>69</sup> As Justice Kagan wrote, for the Court:

So the Lanham Act allows registration of marks when their messages accord with, but not when their messages defy, society’s sense of decency or propriety. Put the pair of overlapping terms together and the statute, on its face, distinguishes between two opposed sets of ideas: those aligned with conventional moral standards and those hostile to them; those inducing societal nods of approval and those provoking

66. *Id.*

67. *Id.* at 1768. I would contend that, in making this statement, Justice Kennedy overlooked two special contexts in which viewpoint discrimination is apparently permitted—namely, in the context of speech by a public high school student, *see Morse v. Frederick*, 551 U.S. 393, 437 (2007) (Stevens, J., dissenting); and speech by a government employee, *see Connick v. Myers*, 461 U.S. 138, 152-54 (1983).

68. 15 U.S.C. § 1052(a). As Justice Kagan explained, “[t]he PTO applies that bar as a ‘unitary provision,’ rather than treating the two adjectives in it separately.” *Iancu v. Brunetti*, 139 S. Ct. at 2298.

69. *Iancu v. Brunetti*, 139 S. Ct. at 2297.

offense and condemnation. The statute favors the former, and disfavors the latter.<sup>70</sup>

The government's primary argument consisted of urging the Court to accept a limiting construction of the statutory language at issue, as follows:

The Government's idea, abstractly phrased, is to narrow the statutory bar to "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." More concretely, the Government explains that this reinterpretation would mostly restrict the PTO to refusing marks that are "vulgar"—meaning "lewd," "sexually explicit or profane." Such a reconfigured bar, the government says, would not turn on viewpoint, and so we could uphold it.<sup>71</sup>

But, Kagan replied, "even assuming the Government's reading would eliminate First Amendment problems, we may adopt it only if we can see it in the statutory language," but "we cannot."<sup>72</sup>

Interestingly, Kagan, having found viewpoint discrimination, would not allow the government to try to save the provision at issue by arguing that its overbreadth was not "substantial."<sup>73</sup> "[T]his Court," she wrote, "has never applied that kind of analysis to a viewpoint-discriminatory law."<sup>74</sup> The finding of viewpoint discrimination in *Tam*, she added, "ended the matter."<sup>75</sup>

The thrust of the majority opinion was thus quite straightforward. Kagan added, in a footnote:

We say nothing at all about a statute . . . limited to lewd, sexually explicit, and profane marks. Nor do we say anything about how to

70. *Id.* at 2300.

71. *Id.* at 2301.

72. *Id.*

73. *Id.* at 2302. As I recently explained:

"Facial overbreadth . . . means, in essence . . . that a law may be invalidated under the First Amendment if it prohibits too much speech—'too much' being understood as excessive in relation to an acceptable justification for official restraint. Such a law is thus said to be 'overbroad' . . . For the doctrine to work, the speaker must persuade a court that the law is 'substantially' overbroad, 'judged in relation to the statute's plainly legitimate sweep. . .'"

Marc Rohr, *Parallel Doctrinal Bars: The Unexplained Relationship Between Facial Overbreadth and "Scrutiny" Analysis in the Law of Freedom of Speech*, 11 ELON L. REV. 95, 98–99 (2019), quoting *U.S. v. Stevens*, 559 U.S. 460, 473 (2010).

74. *Iancu v. Brunetti*, 139 S. Ct. at 2302.

75. *Id.*

evaluate viewpoint-neutral restrictions on trademark registration, because the “scandalous” bar . . . is not one.<sup>76</sup>

But other Justices did offer thoughts concerning such restrictions.

First, consider the brief concurring opinion of Justice Alito, in which he said this: “Our decision does not prevent Congress from adopting a more carefully focused statute that precludes the registration of marks containing vulgar terms that play no real part in the expression of ideas.”<sup>77</sup> He cited no authority, and made no attempt to place this conclusion in the context of any doctrinal analysis. Did he mean to suggest that, for such “vulgar” words and phrases, no First Amendment analysis was required? (I will refer to this as the “low-value speech” approach.)

Consider next the opinion of Chief Justice Roberts, dissenting in part. In his view, the “scandalous” part of the provision at issue was susceptible of a saving narrowing construction:

Standing alone, the term “scandalous” need not be understood to reach marks that offend because of the ideas they convey; it can be read more narrowly to bar only marks that offend because of their mode of expression—marks that are obscene, vulgar, or profane . . . .

[R]efusing registration to obscene, vulgar, or profane marks does not offend the First Amendment. Whether such marks can be registered does not affect the extent to which their owners may use them in commerce to identify goods. No speech is being restricted; no one is being punished. The owners of such marks are merely denied certain additional benefits associated with federal trademark registration.<sup>78</sup>

Roberts, then, appeared to be breathing life into the “minimal burden” approach to trademark-registration restrictions, an approach that had seemingly been discarded by *Tam*; viewpoint discrimination would not be allowed, even in that setting, but other limitations might be, without recourse to the usual rules of First Amendment analysis. As to what mode of analysis should apply, Roberts was unclear. He added these comments:

The Government, meanwhile, has an interest in not associating itself with trademarks whose content is obscene, vulgar, or profane. The First Amendment protects the freedom of speech; it does not require the

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76. *Id.* at 2302, n. \*.

77. *Id.* at 2303 (Alito, J., concurring).

78. *Id.* (Roberts, C.J., concurring in part and dissenting in part).

Government to give aid and comfort to those using obscene, vulgar, and profane modes of expression.<sup>79</sup>

Any restriction of that kind would, of course, be content-based, a fact that usually leads to strict judicial scrutiny. The “minimal burden” approach, however, clearly points away from that high bar—but to what alternative level of scrutiny? Roberts’ brief opinion stopped short of connecting his inclinations to established First Amendment doctrine.

Justice Sotomayor, however, made the connection clear in her opinion, a partial dissent in which Justice Breyer joined.<sup>80</sup> Like Roberts, Sotomayor would have given the word “scandalous” a saving narrowing construction,<sup>81</sup> and relied on the minimal-burden approach to uphold the ban on registration of “scandalous” marks.<sup>82</sup>

As to the first point, Justice Sotomayor said this:

[W]hile the majority offers a reasonable reading of “scandalous,” it . . . unnecessarily and ill-advisedly collapses the words “scandalous” and “immoral.” Instead, it should treat them as each holding a distinct, non-redundant meaning, with “immoral” covering marks that are offensive because they transgress social norms, and “scandalous” covering marks that are offensive because of the mode in which they are expressed.

What would it mean for “scandalous” in § 1052(a) to cover only offensive modes of expression? The most obvious ways—indeed, perhaps the only conceivable ways—in which a trademark can be expressed in a shocking or offensive manner are when the speaker employs obscenity, vulgarity, or profanity . . . . As for what constitutes “scandalous” vulgarity or profanity, I do not offer a list, but I do interpret the term to allow the PTO to restrict . . . the small group of lewd words or “swear” words that cause a visceral reaction, that are not commonly used around children, and that are prohibited in comparable settings.<sup>83</sup>

As to the second point, she said this:

Here, however, the question is only whether the Government must be forced to provide the ancillary benefit of trademark registration to . . . trademarks that use even the most extreme obscenity, vulgarity, or

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79. *Id.* at 2303–04.

80. *Id.* at 2308 (Sotomayor, J., concurring in part and dissenting in part).

81. *Id.* at 2309–11.

82. *Id.* at 2313–17.

83. *Id.* at 2311.

profanity. The stakes are far removed from a situation in which, say, Brunetti was facing a threat to his liberty, or even his right to use and enforce his trademark in commerce.<sup>84</sup>

In answering “no” to the question she posed, Sotomayor provided a doctrinal basis for her conclusion:

Properly narrowed, “scandalous” is a viewpoint-neutral form of content discrimination that is permissible in the kind of discretionary governmental program or limited forum typified by the trademark-registration system.<sup>85</sup>

She explained that “[w]hen the Court has talked about government initiatives like this one before,” it has usually spoken in terms of “limited public (or nonpublic) forum” (sic) or “government programs or subsidies.”<sup>86</sup> Under either conceptual approach, she correctly asserted, “reasonable, viewpoint-neutral content discrimination is generally permissible.”<sup>87</sup>

As a matter of established legal rules, this conclusion is more easily understood in connection with “public forum” doctrine, which, while less than perfectly coherent,<sup>88</sup> makes quite clear that a restriction of speech in a “limited” forum<sup>89</sup> or a “nonpublic” forum<sup>90</sup> need only be reasonable and viewpoint-neutral.<sup>91</sup> Recall that, in *Tam*, Justice Alito, writing for four Justices, had left open the question of whether the “limited public forum” analogy was apt in this

84. *Id.* at 2312.

85. *Id.* at 2313.

86. *Id.* at 2316, citing *Legal Services Corp. v. Velazquez*, 531 U.S. 533 (2001), and *National Endowment for the Arts v. Finley*, 524 U.S. 569 (1998).

87. *Id.* at 2316–17.

88. See Marc Rohr, *First Amendment Fora Revisited: How Many Categories Are There?*, 41 NOVA L. REV. 221 (2017) (hereinafter *Fora Categories*); Marc Rohr, *The Ongoing Mystery of the Limited Public Forum*, 33 NOVA L. REV. 300 (2009) (hereinafter *Ongoing Mystery*).

89. A “limited public forum” is typically defined as a governmental property which the government has reserved as a forum for expression “‘for certain groups or for the discussion of certain topics.’” *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2250 (2015).

90. A so-called “nonpublic forum” has long been described as “[p]ublic property which is not by tradition or designation a forum for public communication.” *Perry Educ. Ass’n v. Perry Local Educators’ Ass’n*, 460 U.S. 37, 46 (1983). As I have previously observed: “Because we are dealing, by definition, with public—and not private—property, the term [‘non-public forum’] is something of a misnomer. It would be more accurate to speak, in such a case, of a ‘public non-forum. . .’” Rohr, *Ongoing Mystery*, *supra* note 88, at 302, n. 10.

91. *Perry Educ. Ass’n*, 460 U.S. at 46.

context;<sup>92</sup> Sotomayor, in a footnote, noted that fact, observing that no Justice in *Tam* had rejected it.<sup>93</sup>

Proceeding to find the prohibition at issue “reasonable,” she said this:

[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. While “there is no evidence that the public associates the contents of trademarks with the Federal Government,” registration nevertheless entails Government involvement in promoting a particular mark. Registration requires the Government to publish the mark, as well as to take steps to combat international infringement. The Government has a reasonable interest in refraining from lending its ancillary support to marks that are obscene, vulgar, or profane.<sup>94</sup>

Compare, finally, the separate opinion of Justice Breyer, who would also have interpreted the word “scandalous” narrowly and upheld it as so narrowed.<sup>95</sup> But, as he has done before, Breyer stated his disinclination to be bound by the usual rules of First Amendment analysis, which he views as too rigid.<sup>96</sup> Instead, employing what is essentially a balancing test, he “would ask whether the regulation at issue ‘works speech-related harm that is out of proportion to its justifications.’”<sup>97</sup> Applying that approach here, he joined Roberts and Sotomayor in finding both a minimal burden on speech<sup>98</sup> and a reasonable government interest in dissociating itself from obscene or vulgar speech.<sup>99</sup> But, in finding that the scale tipped in favor of the government in this case, he went further, adding these striking observations:

92. See text at notes 57–58, *supra*.

93. 139 S. Ct. at 2316, n. 10.

94. *Id.* at 2317. Sotomayor added that, with “scandalous” narrowly construed as she suggested, the provision would survive a facial overbreadth challenge. *Id.* at 2318.

95. *Id.* at 2304 (Breyer, J., concurring in part and dissenting in part).

96. *Id.*, citing his opinion in *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2234–36 (2015) (Breyer, J., concurring in the judgment). See Clay Calvert, Iancu v. Brunetti’s *Impact on First Amendment Law: Viewpoint Discrimination, Modes of Offensive Expression, Proportionality and Profanity*, 43 COLUM. J. L. & ARTS 37, 65–72 (2019) (hereinafter *Impact*).

97. *Id.* at 2305, quoting *United States v. Alvarez*, 567 U.S. 709, 730 (2012) (Breyer, J., concurring in the judgment). One may question why Breyer, given his different analytical approach, joined the opinion of Justice Sotomayor. He explained: “Because Justice Sotomayor reaches the same conclusions, using roughly similar reasoning, I join her opinion insofar as it is consistent with the views set forth here.” 139 S. Ct. at 2308.

98. *Id.* at 2306.

99. *Id.* at 2307.

[S]cientific evidence suggests that certain highly vulgar words have a physiological and emotional impact that makes them different in kind from most other words. These vulgar words originate in a different part of our brains than most other words. And these types of swear words tend to attract more attention and are harder to forget than other words

....

These attention-grabbing words . . . threaten to distract consumers and disrupt commerce. And they may lead to the creation of public spaces that many will find repellent, perhaps on occasion creating the risk of verbal altercations or even physical confrontations. (Just think about how you might react if you saw someone wearing a t-shirt or using a product emblazoned with an odious racial epithet.) The Government thus has an interest in seeking to disincentivize the use of such words in commerce by denying the benefit of trademark registration.

Finally, although some consumers may be attracted to products labeled with highly vulgar or obscene words, others may believe that such words should not be displayed in public spaces where goods are sold and where children are likely to be present. They may believe that trademark registration of such words could make it more likely that children will be exposed to public displays involving such words. To that end, the Government may have an interest in protecting the sensibilities of children by barring the registration of such words.<sup>100</sup>

#### IV. IMPLICATIONS OF THE OPINIONS

##### A. *Viewpoint Discrimination*

The opinions of the Justices in *Brunetti* should lay to rest any lingering confusion regarding the significance of a finding of viewpoint discrimination by a governmental entity; it is unconstitutional *per se*, with no further analysis or “scrutiny” required.

To some of us, that seemed clear all along. The concept of viewpoint discrimination was first highlighted in Supreme Court opinions setting forth the rules applicable to restrictions on access, for purposes of expressive activity, to different categories of “forums”—*i.e.*, governmentally-controlled properties or channels of communication. Justice White, writing for the Court, first laid out those rules in 1983, in *Perry Education Association v. Perry Local Educators’ Association*,<sup>101</sup> saying this:

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100. *Id.*

101. 460 U.S. 37 (1983).



Public property which is not by tradition or designation a forum for public communication is governed by different standards . . . .[T]he State may reserve the forum for its intended purposes, communicative or otherwise, as long as the regulation on speech is reasonable and not an effort to suppress expression merely because public officials oppose the speaker's view.<sup>102</sup>

White thereby identified two ways in which government, even when restricting speech in a “non-public forum,” may be found to have violated the First Amendment: (1) when it did so “unreasonably,” or (2) when it discriminated on the basis of viewpoint. He did not say that a finding of viewpoint discrimination would lead to further analysis. His clear implication was that a finding of viewpoint discrimination would *end* the analysis; the government would lose the case.

And so it remained, or so it seemed. Notably, that is exactly what happened once the Court began to perceive instances of viewpoint discrimination; such a finding appeared to be fatal to the government's case, as no consideration of possible justifications ensued.<sup>103</sup>

Yet stray comments to the contrary occasionally surfaced, like the one that caps off this pronouncement, by Chief Justice Roberts, writing for the Court in *McCullen v. Coakley* in 2014:

Petitioners contend that the Act is not content neutral for two independent reasons: First, they argue that it discriminates against abortion-related speech because it establishes buffer zones only at clinics that perform abortions. Second, petitioners contend that the Act, by exempting clinic employees and agents, favors one viewpoint about abortion over the other. If either of these arguments is correct, then the Act must satisfy strict scrutiny—that is, it must be the least restrictive means of achieving a compelling state interest.<sup>104</sup>

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102. *Id.* at 46. Later in his opinion, White referred to this kind of government property—one that had not been opened to the citizenry for expressive activity—as a “non-public forum,” *id.* at 49, a designation that quickly caught on. *E.g.*, *Cornelius v. NAACP Legal Defense & Education Fund, Inc.*, 473 U.S. 788, 806 (1985).

103. *See, e.g.*, *Good News Club v. Milford Cent. Sch.*, 533 U.S. 98, 112 (2001); *Rosenberger v. Rectors of the Univ. of Va.*, 515 U.S. 819, 836-37 (1995); *Lamb's Chapel v. Ctr. Moriches Union Free Sch. Dist.*, 508 U.S. 384, 394 (1993). *See also* *Texas v. Johnson*, 491 U.S. 397, 416-17 (1989).

104. 134 S. Ct. 2518, 2530 (2014).

Did Roberts really mean to say that there is no constitutional distinction between content discrimination and viewpoint discrimination? Proceeding to find the statute at issue content-neutral, however, he said no more about it.<sup>105</sup>

Recall, similarly, Justice Kennedy's repeated statements in *Tam*, unambiguously linking a finding of viewpoint discrimination to "rigorous" or "heightened" judicial scrutiny.<sup>106</sup> (Recall, too, that he wrote for four Justices.) He added, once, that the statute "cannot survive this scrutiny,"<sup>107</sup> but that pronouncement was purely conclusory; no evidence of any typical "scrutiny" was provided. And what scrutiny did he have in mind—some unexplained "super-strict" scrutiny, or ordinary strict scrutiny (in which case the finding of viewpoint discrimination would count for nothing)? Again, Justice Alito, in *Tam*, said nothing regarding any form of scrutiny triggered by viewpoint discrimination.

By the time the Court decided *Brunetti*, Kennedy was gone, having been replaced by Justice Kavanaugh, and no Justice, in *Brunetti*, spoke of viewpoint discrimination leading to any form of further scrutiny. Of the three Justices who had joined Kennedy's opinion in *Tam*, one (Kagan) authored the majority opinion, while another (Sotomayor) wrote a partially concurring opinion, in *Brunetti*. Neither of those opinions can be reasonably understood to mean, with respect to viewpoint discrimination, anything other than *per se* invalidity, with rare exception.<sup>108</sup> We have hopefully heard the last of any judicial statements to the contrary.

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105. *Id.* at 2530-34. Justice Scalia, concurring in the judgment, joined by Justices Thomas and Kennedy, may be said to have contributed to the confusion, by finding viewpoint discrimination (with no clear consequence), yet reaching his conclusion (the invalidity of the statute) by applying strict scrutiny, triggered by content discrimination. *Id.* at 2544-49 (Scalia, J., concurring in the judgment). Justice Alito, meanwhile, concurring in the judgment separately, found the statute viewpoint-discriminatory, which, in his view, established its invalidity. *Id.* at 2549-50 (Alito, J., concurring in the judgment). See also *R.A.V. v. City of St. Paul*, 505 U.S. 377, 391-96 (1992), in which Scalia, this time in a majority opinion, also found an ordinance to be discriminatory on the basis of viewpoint, but based his finding of invalidity on its failure, as content-discriminatory, to satisfy strict scrutiny. At least one scholar, however, views the ruling in *R.A.V.* as based on viewpoint discrimination. Greenfield, *supra* note 57, at 186, 206.

106. See text at notes 62-65, *supra*. Notably, the same approach was embraced by the majority of the Court of Appeals in *Tam*, in its *en banc* opinion. 808 F.3d 1321, 1337 (Fed. Cir. 2015).

107. See text at note 62, *supra*.

108. See note 67, *supra*, regarding exceptions to this rule. Remarkably, at least one commentator, even after *Brunetti*, believes that a finding of viewpoint discrimination triggers strict scrutiny. Greenfield, *supra* note 57, at 185, 212. (But note that, near the end of an article in which he repeatedly displays that belief, he states: "Once a law falls into the 'discriminates on the basis of viewpoint' box, it is done for." *Id.* at 228.) Professor Calvert, however, appears to agree with my conclusion that viewpoint discrimination is unconstitutional *per se*. Calvert, *Impact*, *supra* note 96, at 81.

But because the unacceptability of viewpoint discrimination sufficed to resolve the First Amendment disputes in *Tam* and *Brunetti*, no other questions raised by the opinions therein were answered.

### B. Trademark Registration Restrictions

The most obvious question that lingers, in the wake of *Brunetti*, is whether Congress could successfully amend the Lanham Act by striking the word “immoral” and either (a) leaving the word “scandalous” in its place (making clear, in an accompanying committee report, that “scandalous” is now to be understood as meaning what Justice Sotomayor, in *Brunetti*, said it could mean); or (b) replacing the word “scandalous” with some combination of the words “vulgar,” “profane,” and “obscene.”<sup>109</sup> (Because any limitation imposed on an “obscene” mark—if such can be imagined—would raise no First Amendment problem,<sup>110</sup> I will simply use the word “vulgar” to denote this category of marks.)<sup>111</sup>

A second question left open by *Brunetti*<sup>112</sup> is whether any of the other enumerated bases for rejecting applications for federal trademark registration<sup>113</sup> are vulnerable to First Amendment challenges. Because all of those statutory categories are content-based (but viewpoint-neutral<sup>114</sup>), and because none of them advance government interests that are likely to be deemed “compelling,” it appears that, to successfully parry any such challenges, the government must have the benefit of a level of judicial review more relaxed than the “strict scrutiny”

109. Although Professor Greenfield has opined, without detailed analysis, that “[t]here is little doubt that the Court would uphold” such a provision, Greenfield, *supra* note 57, at 224, this author is not so sure. Professor Calvert has considered the issue at length. Calvert, *Impact*, *supra* note 96, at 54–64.

110. *Miller v. California*, 413 U.S. 15, 23 (1973).

111. The potential vagueness problem that may arise from such wording must be acknowledged, if not explored, here. A law that fails to give a person of ordinary intelligence a reasonable opportunity to know what it means may be stricken as unduly vague, in violation of the Due Process Clause. *Village of Hoffman Estates v. Flipside, Hoffman Estates, Inc.*, 455 U.S. 489, 498 (1982). Despite the fact that courts are more tolerant of vagueness in statutes that impose civil rather than criminal penalties, *id.* at 499, two of the judges who joined the majority in the Court of Appeals’ *en banc* ruling in *Tam* believed that the ban on registration of “disparaging” marks was unacceptably vague. *In re Tam*, 808 F.3d 1321, 1358–63 (O’Malley, J., concurring). The fact that three Justices have already indicated their willingness to allow the term “scandalous” to encompass vulgar, profane, and obscene marks, however, may alleviate any such concerns.

112. 139 S. Ct. at 2302, n. \*.

113. 15 U.S.C. § 1052 (a)–(e).

114. *See*, with regard to “vulgar” marks, 139 S. Ct. at 2306 (Breyer, J., concurring in part and dissenting in part); *id.* at 2313 (Sotomayor, J., concurring in part and dissenting in part).

that would ordinarily be applied to a content-based restriction of expression.<sup>115</sup> Might that benefit be attainable?

One way to get it is to employ Justice Breyer’s unique balancing approach<sup>116</sup>—but it may be an approach uniquely his.<sup>117</sup> Another is the “minimal burden” approach, which, historically, appeared to obviate the need for any First Amendment analysis at all.<sup>118</sup> As we have seen, that approach was conspicuously absent in *Tam*, but made something of a comeback in *Brunetti* in the opinions of three Justices, one of those being Breyer.<sup>119</sup> Alternatively, the government’s chances improve greatly if the “limited public forum” analogy is accepted. If all else fails, and if a bar to registration is deemed to burden only commercial speech, a form of so-called “intermediate” judicial scrutiny would be employed.<sup>120</sup> I now address these possibilities, in turn.

### 1. Might the “Minimal Burden” Approach Be Resurrected?

Only Chief Justice Roberts, in *Brunetti*, appeared to rely entirely on the view that a denial of trademark registration imposes a minimal burden on speech,<sup>121</sup> while Justice Sotomayor linked it (albeit somewhat unclearly) to public-forum theory,<sup>122</sup> and Justice Breyer incorporated it into his unique revision of general First Amendment rules.<sup>123</sup> Moreover, each of those Justices expressed a willingness to lower the level of judicial scrutiny in connection with “vulgar”—*i.e.*, “low-value”—speech. Would they do so otherwise?

More importantly, might any other Justice join them in resurrecting the minimal-burden approach? None did in *Brunetti*, but none had to, given the finding of fatal viewpoint discrimination. The key question, I think, is whether it is logically possible to simultaneously accept both of the following conclusions: (a) generally, denial of trademark registration imposes so minimal a

115. *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2226–27 (2015). Note, however, that Professor Calvert has suggested, based on the concurring opinions in *Brunetti*, the possibility “that statutes targeting how something is said, and not the underlying content,” might not be treated as content-based. Calvert, *Impact*, *supra* note 96, at 76.

116. *See text at notes 96–97, supra.*

117. But see the concurring opinion of Justice Kagan, joined by Justices Ginsburg and Breyer, in *Reed v. Town of Gilbert*, 135 S. Ct. at 2238 (Kagan, J., concurring in the judgment) (“We can administer our content-regulation doctrine with a dose of common sense, so as to leave standing laws that in no way implicate its intended function.”) *See also Barr v. American Ass’n of Political Consultants, Inc.*, 140 S. Ct. 2335, 2357 (2020) (Breyer, J., concurring in part and dissenting in part) (joined by Justices Ginsburg and Kagan).

118. *See text at note 46, supra.*

119. *See text at notes 78, 84, and 100, supra.*

120. *See text at note 148, infra.*

121. *See text at note 78, supra.*

122. *See text at notes 85–87, supra.*

123. *See text at notes 98–100, supra.*

burden on speech that no First Amendment analysis is required; but, nevertheless (b) a denial based on viewpoint discrimination violates the First Amendment. But are not these two assertions mutually exclusive? Justice Sotomayor’s opinion (joined by Breyer) gave some evidence of believing both of those statements, but one may reasonably doubt that, beyond the context of “low-value” speech, any Justice is prepared to fully embrace a revived, full-fledged minimal-burden approach to First Amendment challenges to trademark registration bars. The fact that it wasn’t even discussed in the majority opinion, or in *Tam*, bolsters this conclusion.

## 2. Is the Principal Register a “Limited Public Forum”?

“For the sake of the uninitiated,” I wrote not long ago, “forum” analysis “pertains to the issue of access, for expressive purposes, to governmentally-controlled properties or channels of communication that have not traditionally been deemed available to the citizenry for such purposes.”<sup>124</sup> The significance of this doctrine is the recognition that, in such settings, the government should enjoy considerably more discretion to limit speech than it otherwise has.<sup>125</sup> The rules governing the exercise of that discretion in a so-called “non-public forum” were set forth earlier in this article.<sup>126</sup> It is clear, by now, despite initial lack of clarity on the point,<sup>127</sup> that the same First Amendment rules apply to limitations on expression in a so-called “limited public forum.”<sup>128</sup> As I wrote earlier: “Rather than being a sub-set of the designated public forum, as first appeared, the limited public forum turns out to be a non-identical twin of the non-public forum.”<sup>129</sup> A restriction of speech in such a setting, to survive judicial scrutiny, thus need only be viewpoint-neutral and “reasonable.” (While this “reasonableness” standard is a relatively low bar, it is not invariably satisfied.<sup>130</sup>)

124. Marc Rohr, *Fora Categories*, *supra* note 88, at 222.

125. “The State, no less than a private owner of property, has power to preserve the property under its control for the use to which it is lawfully dedicated.” *Adderley v. Florida*, 385 U.S. 39, 47 (1966).

126. See text at notes 88-91, *supra*.

127. Marc Rohr, *Ongoing Mystery*, *supra* note 88, at 355.

128. *Good News Club v. Milford Central School*, 533 U.S. 98, 106-07 (2001).

129. Marc Rohr, *Fora Categories*, *supra* note 88, at 233.

130. It was held to be *not* satisfied in *Minnesota Voters Alliance v. Mansky*, 138 S. Ct. 1876, 1888-91 (2018). Said Chief Justice Roberts, for the majority:

“[T]he State must draw a reasonable line. Although there is no requirement of narrow tailoring in a nonpublic forum, the State must be able to articulate some sensible basis for distinguishing what may come in from what must stay out.”

*Id.* at 1888. Again, the Court has essentially equated the nonpublic forum with the limited public forum, for analytical purposes.

But what *is* a “limited public forum”? It was probably best defined, by Justice Ginsburg, as follows, in *Christian Legal Society v. Martinez*: “[G]overnmental entities establish limited public forums by opening property ‘limited to use by certain groups or dedicated solely to the discussion of certain subjects.’”<sup>131</sup> Several years ago, when I believed it mattered, I explored the distinction between the “limited public forum” and the “non-public forum” in depth.<sup>132</sup> But, as I have indicated, that distinction (to the extent that there *is* one<sup>133</sup>) no longer matters. What does matter here, I submit, is whether the PTO’s Principal Register is a “forum” at all.<sup>134</sup>

I contend that it is not. In every case that reached the Supreme Court in which a “forum” determination was dispositive, even those in which the forum at issue was more “metaphysical”<sup>135</sup> than tangible,<sup>136</sup> it was possible to conceive of a speaker who sought access to that “forum” for the purpose of expressing himself therein. That simply is not true in this context. Rejection of an application for registration *burdens* speech, by denying the user of a particular mark (which, again, is a form of speech) the benefits of federal registration, but the applicant is *not* seeking to *speak on* (or in) the Principal Register. An applicant speaks in her application for registration, but no one is denied that opportunity. The Register is a database, in which the applicant hopes to have his mark listed.<sup>137</sup>

In its decision in *Brunetti*, the Court of Appeals for the Federal Circuit rejected the government’s “limited public forum” argument, essentially because “the trademark registration program bears no resemblance to” previously-identified limited forums.<sup>138</sup> The majority opinion in *Brunetti*, at the Supreme Court, said nothing regarding this point, but, again, Justice Alito, writing for four Justices (all of whom remain on the Court) in *Tam*, expressly declined to rule out the applicability of a “limited forum” analogy.<sup>139</sup> Meanwhile, Justice

131. 561 U.S. 661, 679, n. 11 (2010).

132. Rohr, *Ongoing Mystery*, *supra* note 88, at 326–31.

133. Some courts have appeared to view the two terms as synonyms. See, e.g., *Milestone v. City of Monroe*, 665 F.3d 774, 783 n.3 (7<sup>th</sup> Cir. 2011) (referring to “[a] limited public forum– sometimes called a ‘non-public forum.’”)

134. Note Justice Kennedy’s statement, in *Arkansas Educational Television Comm’n v. Forbes*, 523 U.S. 666, 677 (1998), after discussing traditional and designated public fora, that “[o]ther government properties are either non-public fora or not fora at all.” See also *U.S. v. American Library Ass’n, Inc.*, 539 U.S. 194, 205 (2003).

135. E.g., *Cornelius v. NAACP Legal Defense and Educational Fund, Inc.*, 473 U.S. 788 (1985).

136. E.g., *U.S. v. Kokinda*, 497 U.S. 720 (1990).

137. But recall that the Court in *Tam* rejected the characterization of this database as “government speech,” 137 S. Ct. at 1760, a designation which would have obviated the need for any further First Amendment scrutiny.

138. *In re Brunetti*, 877 F.3d 1330, 1347 (Fed. Cir. 2017).

139. See text at notes 57–58, *supra*.

Sotomayor, joined by Justice Breyer in *Brunetti*, invoked the concept somewhat obliquely in support of her “minimal burden” analysis.<sup>140</sup>

Might five Justices find the concept—or something close enough thereto—applicable here? Skepticism seems appropriate.

### 3. Is Commercial-Speech Analysis Applicable?

Commercial speech, as a First Amendment concept, is typically defined as “speech which does ‘no more than propose a commercial transaction.’”<sup>141</sup> The typical trademark, which identifies the source of goods or services, would seem to qualify.<sup>142</sup> But not all trademarks are typical. As one court has observed:

[T]he trademark infringement and false designation of origin provisions of the Lanham Act . . . do not employ the term “noncommercial.” They do state, however, that they pertain only to the use of a mark “in connection with the sale, offering for sale, distribution, or advertising of any goods or services,” or “in connection with any goods or services.” But courts have been reluctant to define those terms narrowly. Rather, . . . “[t]he term ‘services’ has been interpreted broadly” and so “[t]he Lanham Act has . . . been applied to defendants furnishing a wide variety of non-commercial public and civic benefits.”<sup>143</sup>

Recall that Justice Alito, writing for four Justices in *Tam* (a case involving a somewhat artistic mark), declined to decide whether commercial speech analysis was applicable,<sup>144</sup> saying this en route to that non-decision:

The Government and *amici* supporting its position argue that all trademarks are commercial speech. They note that the central purposes of trademarks are commercial and that federal law regulates trademarks to promote fair and orderly interstate commerce. *Tam* and his *amici*, on the other hand, contend that many, if not all, trademarks have an expressive component. In other words, these trademarks do not simply identify the source of a product or service but go on to say something more, either about the product or the service, or some broader issue.

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140. See text at notes 85–87, *supra*. Breyer, writing separately, mused that “one can find some vague resemblance between trademark registration and what this Court refers to as a ‘limited public forum’ created by the government for private speech.” *Iancu v. Brunetti*, 139 S.Ct. at 2305.

141. *Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60, 66 (1983).

142. See *Rubin v. Coors Brewing Co.*, 514 U.S. 476 (1995); *Friedman v. Rogers*, 440 U.S. 1 (1979); and text at notes 34–35, *supra*.

143. *Lamparello v. Falwell*, 420 F.3d 309, 314 (4<sup>th</sup> Cir. 2005).

144. See text at note 59, *supra*. The point was also sidestepped by Justice Kennedy, writing for four other Justices, *Matal v. Tam*, 137 S. Ct. at 1767 (Kennedy, J., concurring in part and concurring in the judgment).

The trademark in this case illustrates this point. The name ‘The Slants’ not only identifies the band but expresses a view about social issues.<sup>145</sup>

Given this duality, Alito ultimately “[left] open the question whether *Central Hudson* provides the appropriate test for deciding free speech challenges to provisions of the Lanham Act.”<sup>146</sup> In her majority opinion in *Brunetti* (as noted earlier), Justice Kagan expressly declined to “say anything about how to evaluate viewpoint-neutral restrictions on trademark registration.”<sup>147</sup> We have therefore been left with no hint of whether anyone on the Court would employ commercial speech analysis in this context. If so, the governing *Central Hudson* test would allow the suppression of false or misleading speech, but otherwise require a “substantial” government interest and a regulation that “directly advances” that interest without doing so overinclusively.<sup>148</sup>

#### 4. Could a Ban on Registration of “Vulgar” Marks Be Upheld?

If a sufficient number of Justices were inclined to employ intermediate scrutiny, might a ban on registration of “vulgar” marks survive? Would the government be seen as having a sufficiently “substantial” interest in such a ban? Alternatively, if limited-forum analysis were deemed to apply, would such a ban satisfy the less-demanding “reasonableness” requirement?

Either analysis must begin by articulating a plausible government interest. In *Brunetti*, Justice Sotomayor spoke of the government’s interest “in refraining from lending its ancillary support to” such marks,<sup>149</sup> while Justice Breyer spoke of the government’s interest in disassociating itself from such speech.<sup>150</sup> It is far from clear that any interest of that kind would be deemed “substantial,” as intermediate scrutiny would require.<sup>151</sup> Recall that Breyer went on to identify other government interests supporting a ban on the registration of vulgar marks:

145. *Id.* at 1764.

146. *Id.*, note 17.

147. *Iancu v. Brunetti*, 139 S. Ct. at 2302, n. \*.

148. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 566 (1980). But Justice Thomas, as he reminded us in his brief concurrence in *Tam*, has long advocated the general use of strict scrutiny even in commercial speech cases. 137 S. Ct. at 1769 (Thomas, J., concurring in part and concurring in the judgment).

149. *Iancu v. Brunetti*, 139 S.Ct. at 2317 (Sotomayor, J., concurring in part and dissenting in part).

150. *Id.* at 2307 (Breyer, J., concurring in part and dissenting in part).

151. The Court of Appeals, in *Brunetti*, ruled that “the government’s general interest in protecting the public from marks it deems ‘off-putting’” was not a substantial interest. *In re Brunetti*, 877 F.3d 1330, 1351 (Fed. Cir. 2017).



preventing the disruption of commerce, preventing altercations, and protecting the sensibilities of children.<sup>152</sup> Any one of those might suffice.

But it seems far less likely that such a ban would be found to satisfy the parts of the *Central Hudson* test requiring a demonstrable “fit” between means and ends. For one thing, the Court has incorporated into this form of supposedly “intermediate” scrutiny a demanding “proof” requirement; the burden of justifying a restriction of commercial speech, said Justice Kennedy,

is not satisfied by mere speculation or conjecture; rather, a governmental body seeking to sustain a restriction on commercial speech must demonstrate that the harms it recites are real and that its restriction will in fact alleviate them to a material degree.<sup>153</sup>

As the Court of Appeals noted in its *Brunetti* opinion, a registration ban does not prevent use of the mark, thus failing to achieve the goal of protecting the sensibilities of the citizenry.<sup>154</sup> That Court complained, as well, that the exclusion of “immoral or scandalous” marks was so fraught with subjectivity and unpredictability that the fourth prong of the *Central Hudson* test—requiring no more regulation than necessary—could also not be satisfied.<sup>155</sup>

For another, the Court has arguably required that the government’s rationale, when it regulates commercial speech, bear some relationship to the commercial nature of the speech. Thus, in *City of Cincinnati v. Discovery Network, Inc.*,<sup>156</sup> the Court struck down an ordinance that, in an effort to promote aesthetics and safety, treated newsracks dispensing “commercial handbills” worse than other newsracks, because the city’s interests had nothing to do with the commercial nature of the disfavored newsracks. For the majority, Justice Stevens said this:

Cincinnati has not asserted an interest in preventing commercial harms by regulating the information distributed by respondent publishers’ newsracks, which is, of course, the typical reason why commercial speech can be subject to greater governmental regulation than noncommercial speech.<sup>157</sup>

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152. See text at note 100, *supra*.

153. *Edenfield v. Fane*, 507 U.S. 761, 770–71 (1993).

154. *Brunetti*, 877 F.3d at 1353.

155. *Id.* at 1354.

156. 507 U.S. 410 (1993).

157. *Id.* at 426.

Similarly, it can be argued that the harms identified by Justices Sotomayor and Breyer (other than the vague suggestion of disruption of commerce) are not “commercial” in nature.<sup>158</sup>

If, instead, the “limited forum” analysis were to be employed, there seems little doubt that all of the suggested government interests would be deemed “reasonable”—particularly given the fact that three Justices have already revealed their approval of that conclusion, either expressly<sup>159</sup> or implicitly.<sup>160</sup>

Finally, with respect to “vulgar” marks, the “low-value speech” approach reflected in Justice Alito’s *Brunetti* opinion<sup>161</sup> would also support such a registration ban.

## 5. Are Other Bars to Trademark Registration Vulnerable to First Amendment Challenges?

As noted briefly above, the Lanham Act lists many more categories of unregistrable marks.<sup>162</sup> For the purposes of this discussion, they can be separated into four macro-categories: those whose exclusion comports with (a) the fundamental requirement of distinctiveness as a condition of receiving legal protection, (b) the laudable goal of preventing consumer deception, or (c) the overriding statutory goal of preventing consumer confusion as to source or sponsorship; and (d) those whose rationale for rejection is more difficult to divine.

In the first group are marks that are “merely descriptive of” the applicant’s goods or services<sup>163</sup> or “primarily geographically descriptive of them.”<sup>164</sup> But an applicant can overcome either of these presumptive hurdles by showing that its mark has attained “secondary meaning”<sup>165</sup>—meaning that a substantial segment of the relevant group of consumers has come to think of the mark primarily as an indication of source, rather than as a descriptive term.<sup>166</sup> Compare a “generic” mark—one which consists of “the common name of a product or

158. Justice Kennedy, in *Tam*, observed that “[w]hether a mark is disparaging bears no plausible relation to” the goal of facilitating source identification. 137 S. Ct. at 1768.

159. See text at notes 94 and 99, *supra*.

160. See text at note 79, *supra*.

161. See text at note 77, *supra*. See also Gary Myers, *It’s Scandalous—Limiting Profane Trademark Registrations After Tam and Brunetti*, 27 J. INTELL. PROP. LAW 1, 17-18 (2019). I discuss the concept of “low-value speech” in Part III-C, *infra*.

162. See text at notes 16-25, *supra*.

163. 15 U.S.C. § 1052(e)(1).

164. *Id.* § 1052(e)(2).

165. *Tartell v. South Florida Sinus and Allergy Center, Inc.*, 790 F.3d 1253, 1257 (11<sup>th</sup> Cir. 2015); *OBX-Stock, Inc. v. Bicast, Inc.*, 558 F.3d 334, 342 (4<sup>th</sup> Cir. 2009). The concept is codified at 15 U.S.C. § 1052(f).

166. *Tartell*, 790 F.3d at 1257.

service”—which can never enjoy trademark protection,<sup>167</sup> as the Lanham Act clearly implies.<sup>168</sup> Note that all of these rules exist at common law, as well as under the Lanham Act.<sup>169</sup> And bear in mind that anyone can *use* a descriptive or generic mark; they simply will have no legal protection therefor.

In the second group are “deceptive” marks,<sup>170</sup> marks that are “deceptively misdescriptive of” the applicant’s goods or services,<sup>171</sup> and those that are “primarily geographically deceptively misdescriptive of them.”<sup>172</sup> Of these, only “deceptively misdescriptive” marks can be registered with a showing of secondary meaning.<sup>173</sup> This macro-category is special, in that one may not only be disabled from registering a deceptive mark; false-advertising laws may prevent its *use* as well.<sup>174</sup>

The third macro-category above is represented, unambiguously, only by the provision barring the registration of a mark that “so resembles a mark registered in the [PTO], or a mark . . . previously used, . . . as to be likely . . . to cause confusion.”<sup>175</sup>

The remaining statutory categories of disqualified marks are these: first, a mark that “[c]onsists of or comprises . . . matter which may . . . falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols”<sup>176</sup> (hereinafter “false suggestion of connection”); second, a mark that

167. *Royal Crown Co., Inc. v. The Coca-Cola Co.*, 892 F.3d 1358, 1366 (Fed. Cir. 2018).

168. 15 U.S.C. § 1064(3).

169. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2<sup>nd</sup> Cir. 1976); J. Thomas McCarthy, *Trademarks and Unfair Competition* 14:1 (5<sup>th</sup> edition 2019).

170. 15 U.S.C. § 1052(a). A “deceptive” mark is misdescriptive of some characteristic of the product, when prospective purchasers are likely to believe the misdescription and be influenced by it. *In re Budge Mfg. Co.*, 857 F.2d 773, 775 (Fed. Cir. 1988). “Deceptive” marks are also denied common law protection. *In re Spirits Int’l N.V.*, 563 F.3d 1347, 1354 (Fed. Cir. 2009).

171. *Id.* § 1052(e)(1).

172. *Id.* § 1052(e)(3). *See also* that part of § 1052(a) pertaining to geographical misdescriptions of the place of origin of wines or spirits.

173. *Id.* § 1052(f). Comparisons of, and distinctions between, these particular categories can be found in *In re California Innovations, Inc.*, 329 F.3d 1334, 1336-40 (Fed. Cir. 2003), and *Gold Seal Co. v. Weeks*, 129 F. Supp. 928, 934-35 (D.D.C. 1955), *aff’d*, 230 F.2d 832 (D.C. Cir. 1956).

174. The Lanham Act contains a false advertising prohibition, at 15 U.S.C. § 1125(a)(1)(B). In addition, “[t]he Federal Trade Commission has the authority to act against ‘unfair or deceptive acts or practices,’ including false or misleading statements in advertising, where those statements harm consumers. The law in some states provides for similar remedies, frequently under the state’s version of the Uniform Deceptive Trade Practices Act.” Graeme B. Dinwoodie and Mark D. Janis, *Trademarks and Unfair Competition: Law and Policy* 870 (4<sup>th</sup> ed. 2014).

175. 15 U.S.C. § 1052(d). (But note the possibility of concurrent registrations of the same mark by different users, if the Director of the PTO determines that confusion “is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used.” *Id.*)

176. *Id.* § 1052(a). *See, e.g., In re Shinnecock Smoke Shop*, 571 F.3d 1171 (Fed. Cir. 2009).

“[c]onsists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof”<sup>177</sup> (hereinafter “government insignia”); third, a mark that “[c]onsists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent”<sup>178</sup> (hereinafter “living individual”); fourth, a mark that “[c]onsists of or comprises a . . . name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow”<sup>179</sup> (hereinafter “deceased president”); and, fifth, a mark which “is primarily merely a surname.”<sup>180</sup> Only the last of these may be registered<sup>181</sup> (or protected under the common law<sup>182</sup>) if a showing of secondary meaning can be made.

The reasons for these categories of ineligible marks are not always obvious, but some have been authoritatively suggested, and, even in the absence of any such suggestions, we can speculate.

A mark which “falsely suggests a connection”—with *anything*—can easily be understood as deceptive, and thus may plausibly be added to our second macro-category. (We will overlook the potential overlap with the “deceptive” and “deceptively misdescriptive” categories). We are then left to wonder why a separate category of ineligible marks comprises names of living persons unless they consent; if the concern here is, again, a false suggestion of a connection, that concern has already been addressed. Or is this provision motivated by a concern about “privacy,” even in the absence of a false suggestion of a connection? This rationale has been suggested.<sup>183</sup>

The “deceased president” provision also seems to overlap, in part, with the “false suggestion of connection” prohibition, and, oddly, it is limited, in its application beyond that, to references to *deceased* presidents (but even then there’s no problem if the “widow” doesn’t mind). So, pursuant to this particular provision, registration of a mark embodying a portrait of George H.W. Bush would not be barred (because his wife is also deceased), but registration of a mark consisting of a portrait of Jimmy Carter (still alive, as of this writing),

177. *Id.* § 1052(b).

178. *Id.* § 1052(c).

179. *Id.*

180. *Id.* § 1052(e)(4).

181. *Id.* § 1052(f).

182. McCarthy, *supra* note 169, 13:2.

183. Gilbert/Robinson, Inc. v. Carrie Beverage—Missouri, Inc., 989 F.2d 985, 989 (8<sup>th</sup> Cir. 1993); University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc., 703 F.2d 1372, 1376 (Fed. Cir. 1983); Trademark Manual of Examining Procedure sec. 1206, www.TMEP/uspto.gov (October 2018) (“The purpose of requiring the consent of a living individual to the registration of his or her name, signature, or portrait is to protect rights of privacy and publicity that living persons have in the designations that identify them.”)

after his death, would be—unless Mrs. Carter allowed it. This prohibition *seems*, then, to be motivated by solicitude for the feelings of a presidential “widow.”

Is the “government insignia” provision motivated, as well, by a concern about a false implication of governmental imprimatur? But here, too, there is arguable redundancy, as the “false suggestion of connection” provision includes a reference to “national symbols.” (Admittedly, the “flag” provision is not limited to “national” insignia.) Might the “flag” provision have been motivated, then, by respect for such symbols, such that no one gets to wrap his product in a flag, as it were, even if secondary meaning could be shown? So it seems. According to Professor McCarthy, this absolute bar to registration

is apparently founded upon the thinking that these kinds of governmental insignia, such as a national flag or seal, should not be registered as symbols of origin for commercial goods and services. That is, these kinds of governmental insignia ought to be kept solely to signify the government and not be sullied or debased by use as symbols of business and trade.<sup>184</sup>

(But keep in mind that this is a bar to registration, not to use, of such marks.)

Finally, what about marks that are “primarily surnames”? In his treatise on trademark law, Professor McCarthy says this:

Personal names [surnames and first names] are placed by the common law into that category of noninherently distinctive terms which require proof of secondary meaning for protection . . . . The key is whether the public will likely perceive the term as a personal name . . . .<sup>185</sup>

But why are personal-name marks presumptively unprotected? It has been suggested that the rule rests on the belief that, generally, a personal name lacks the distinctiveness required for trademark protection.<sup>186</sup> Professor McCarthy has written:

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184. McCarthy, *supra* note 169, 19:78.

185. McCarthy, *supra* note 169, 13:2.

186. See *In re Etablissements Darty et Fils*, 759 F.2d 15, 17 (Fed. Cir. 1985). According to the Restatement (Third) of Unfair Competition, § 14 cmt. e (1995):

The rationale of requiring proof of secondary meaning for personal names is somewhat analogous to that applicable to descriptive terms. The known multiplicity of similar personal names may make consumers hesitant to assume a common source for products bearing a particular name.

A possible rationale for the requirement of secondary meaning in personal name marks is that such marks are analogous to descriptive terms. A personal name is like a descriptive term in that it is not inherently distinctive because it merely describes some attribute of the product (the name of a person who is involved in the business) . . . .<sup>187</sup>

In addition, he adds, “no one seller should have the right to prevent others from using a descriptive term to honestly describe their goods or services by telling the name of a person involved.”<sup>188</sup> The Lanham Act’s “surname” registration bar, then, may be understood as advancing the “distinctiveness” requirement for trademark protection.

Might any of these bars to registration be vulnerable to a First Amendment challenge? To my knowledge, no such legal challenges have been brought in the past, probably, in part, because the “minimal burden” approach was firmly in place as a result of First Amendment arguments raised unsuccessfully by disappointed users of “immoral or scandalous” marks.<sup>189</sup> As we have seen, that approach may not have been entirely abandoned.<sup>190</sup> Even if too few Justices are willing to embrace that approach, the “limited public forum” analogy, if adopted, would, again, allow these prohibitions to stand on a simple showing of “reasonableness” (since none of them are viewpoint-based). But, again, that is a questionable conclusion,<sup>191</sup> leaving us with the likelihood that these bars to registration would be subjected to intermediate judicial scrutiny as burdens on commercial speech.

Per that analysis, I submit that it is almost inconceivable that a court would invalidate any of the statutory limitations that are designed to further the goals of preventing deception, dispelling consumer confusion, or requiring distinctiveness as a condition for legal protection. These goals should be deemed to be substantial state interests, and the denial of legal protection to such marks should be seen as advancing those interests. To the extent that any of these statutory provisions mirrors the common law (*i.e.*, tradition), the argument for its validity should be even stronger. But the “deceased president” and “government insignia” categories seem vulnerable to challenge; the apparent government interests supporting these provisions are not only weak, but non-commercial as well.

187. McCarthy, *supra* note 169, 13:3.

188. *Id.* See also *Peaceable Planet, Inc. v. Ty, Inc.*, 362 F.3d 986, 989 (7<sup>th</sup> Cir. 2004).

189. See text at note 46, *supra*.

190. See text at notes 78, 82–84, and 98, *supra*.

191. See text at notes 135–38, *supra*.

C. *Is There a Future for the Concept of “Low-Value” Speech?*

It has been a “bedrock principle” of First Amendment law, for nearly five decades, if not longer, that, absent a “captive audience” situation,<sup>192</sup> speech cannot be punished or suppressed merely because it offends.<sup>193</sup> A prime reason for this “rule” is the perceived impossibility of drawing clear and appropriate lines of demarcation between speech that could or could not be outlawed, were the rule to be altered.<sup>194</sup> But three of the opinions in *Brunetti* may lead a reasonable reader to wonder whether any Justice is now prepared to allow some regulation of “vulgar” speech, based on its ostensibly “low value.”<sup>195</sup>

Granted, as Justice Sotomayor recognized,<sup>196</sup> a willingness to allow denial of registration of a “vulgar” mark is quite different from a willingness to allow its use to be disallowed. But, still, Justice Alito, in an admittedly brief concurrence, referred to “vulgar terms that play no real part in the expression of ideas.”<sup>197</sup> And Justice Breyer spoke at length of the harmful effects of “these types of swear words.”<sup>198</sup> And Sotomayor, while linking her view of such language to the “minimal burden” approach, would allow the PTO to deny registration, as “scandalous” marks, to “the small group of lewd words or ‘swear’ words that cause a visceral reaction, that are not commonly used around children, and that are prohibited in comparable settings”<sup>199</sup>—a position seemingly compatible with the difficult task of drawing lines in this end of the speech spectrum.

The notable exception to the Court’s “bedrock principle” regarding speech that offends is, of course, its 1978 decision in *FCC v. Pacifica Foundation*, upholding the sanction imposed by the Federal Communications Commission on a radio station for broadcasting the famous George Carlin “Filthy Words” monologue (which featured some very vulgar words indeed) during daytime hours.<sup>200</sup> For the majority, Justice Stevens, in an opinion that lacked any formal analytical structure, emphasized the special nature of the broadcast medium,<sup>201</sup>

192. *Cohen v. California*, 403 U.S. 15, 21 (1971).

193. *Texas v. Johnson*, 491 U.S. 397, 414 (1989).

194. *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 55 (1988); *Cohen*, 403 U.S. at 25.

195. See generally Larry Alexander, *Low Value Speech*, 83 NW. L. REV. 547 (1989). Professor Calvert has also raised this question. Calvert, *Impact*, *supra* note 96, at 79–81.

196. See text at note 84, *supra*.

197. See text at note 77, *supra*.

198. See text at note 100, *supra*.

199. See text at note 83, *supra*. She did not clarify her reference to “comparable settings.”

200. 438 U.S. 726 (1978).

201. *Id.* at 748.

its entry into “the privacy of the home,”<sup>202</sup> and its accessibility to children.<sup>203</sup> In a part of his opinion joined only by two other Justices, Stevens—even while reiterating that “the fact that society may find speech offensive is not a sufficient reason for suppressing it”—<sup>204</sup> said this, regarding the offending content of the Carlin monologue:

These words offend for the same reasons that obscenity offends. Their place in the hierarchy of First Amendment values was aptly sketched by Mr. Justice Murphy when he said: “Such utterances are no essential part of any exposition of ideas, and are of such slight social value as a step to truth that any benefit that may be derived from them is clearly outweighed by the social interest in order and morality.”<sup>205</sup>

The offending words could thus be banned from midday broadcasts. Justice Powell, joined by Justice Blackmun, stated that, while he concurred in the judgment, he did “not subscribe to the theory that the Justices of this Court are free generally to decide on the basis of its content which speech protected by the First Amendment is most ‘valuable’ and hence deserving of the most protection, and which is less ‘valuable’ and hence deserving of less protection.”<sup>206</sup> The *Pacifica* ruling, unique in its bypassing the application of strict scrutiny to a content-based regulation of speech, has never been overruled.

“Cable” television, it soon turned out, would be treated differently (so that content restrictions thereon would be subject to strict scrutiny), based on the questionable distinction that, presumably unlike broadcast television, “cable television is not an uninvited intruder.”<sup>207</sup> The distinction has subsequently been questioned by some Justices.<sup>208</sup>

The FCC, while the details of its regulatory scheme have changed over time,<sup>209</sup> has continued to enforce the statutory ban on “indecent or profane”

202. *Id.*

203. *Id.* at 749.

204. *Id.* at 745.

205. *Id.* at 746, quoting *Chaplinsky v. New Hampshire*, 315 U.S. 568, 572 (1942).

206. 438 U.S. at 761 (Powell, J., concurring in part and concurring in the judgment).

207. *Community Television of Utah, Inc. v. Wilkinson*, 611 F.Supp. 1099, 1113 (D. Utah 1985), *aff’d sub nom. Jones v. Wilkinson*, 800 F.2d 989 (10<sup>th</sup> Cir. 1986), *aff’d sub nom. Wilkinson v. Jones*, 480 U.S. 926 (1987).

208. *Denver Area Educ. Telecomm. Consortium, Inc. v. FCC*, 518 U.S. 727, 744 (1996) (plurality opinion of Breyer, J.), 812–14 (Thomas, J., dissenting).

209. See *FCC v. Fox Television Stations, Inc. (Fox II)*, 132 S. Ct. 2307, 2312–14 (2012). The post-*Pacifica* history of this regulatory regime is revealed, in part, in *Action for Children’s Television v. FCC*, 58 F.3d 654 (D.C. Cir. 1995).



language on broadcast radio or television.<sup>210</sup> The Supreme Court has, thus far, declined to revisit the First Amendment questions raised by these restrictions,<sup>211</sup> but at least two Justices have voiced criticism of the *Pacifica* ruling. In a concurring opinion in the first *Fox* decision, in 2009, Justice Thomas said this:

I write separately . . . to note the questionable viability of the two precedents that support the FCC's assertion of constitutional authority to regulate the programming at issue in this case. [Here he cited *Pacifica* and *Red Lion Broadcasting Co. v. FCC*.<sup>212</sup>] [These decisions] were unconvincing when they were issued, and the passage of time has only increased doubt regarding their continued validity . . . .<sup>213</sup>

Even if this Court's disfavored treatment of broadcasters under the First Amendment could have been justified at the time of *Red Lion* and *Pacifica*, dramatic technological advances have eviscerated the factual assumptions underlying those decisions. Broadcast spectrum is significantly less scarce than it was 40 years ago . . . .<sup>214</sup>

Moreover, traditional broadcast television and radio are no longer the "uniquely pervasive" media forms they once were . . . . I am open to reconsideration of *Red Lion* and *Pacifica* in the proper case.<sup>215</sup>

In *Fox II*, in 2012, the late Justice Ginsburg said this:

In my view, the Court's decision in *FCC v. Pacifica Foundation* was wrong when it issued. Time, technological advances, and the Commission's untenable rulings in the cases now before the Court show why *Pacifica* bears reconsideration.<sup>216</sup>

The "cases now before the Court" in *Fox II* involved nudity or the "isolated" utterance of expletives that would be on anyone's list of vulgar words.<sup>217</sup> While neither Justice Thomas nor Justice Ginsburg addressed the concept of "low-

210. 18 U.S.C. § 1464. See also 47 U.S.C. sec. 303.

211. *Fox*, 132 S. Ct. at 2320; *FCC v. Fox Television Stations, Inc. (Fox I)*, 129 S. Ct. 1800, 1819 (2009).

212. 395 U.S. 367 (1969), upholding FCC rules requiring broadcast stations to afford free reply time to the target of a personal attack on a station's airwaves. Justice White, for the Court, emphasized the "scarcity of broadcast frequencies."

213. 129 S. Ct. at 1819–20 (Thomas, J., concurring).

214. *Id.* at 1821.

215. *Id.* at 1822.

216. *Fox II*, 132 S. Ct. 2321 (Ginsburg, J., concurring in the judgment).

217. *Id.* at 2315–16.

value” speech, their disapproval of *Pacifica* makes clear enough their rejection of it as a viable constitutional principle.

Counterposed against Justice Thomas are the three Justices (again, Alito, Breyer, and Sotomayor) whose opinions in *Brunetti* sparked this discussion. The remaining four members of the Court, as of this writing—Roberts, Kagan, Gorsuch, and Kavanaugh—said nothing in *Brunetti* about the value of “vulgar” speech; it may or may not be telling that they bypassed the opportunity to join any of the three opinions that did. Might any of them support the “low-value speech” concept in a future case in which the issue is squarely raised, perhaps a revisiting of *Pacifica*, or even a reconsideration of *Cohen v. California*?<sup>218</sup> The arc of First Amendment law tends toward ever greater protection of speech, but the opinions of three Justices in *Brunetti* raise reasonable doubts, I submit, concerning the Court’s willingness to abandon its adherence to its outlier decision in *Pacifica*.

## V. CONCLUSION

The Court’s rulings in *Brunetti* and *Tam* make clear that, as a general principle of First Amendment law, viewpoint discrimination on the part of government will not be tolerated. That alone suffices to explain the Court’s invalidation of the Lanham Act’s “disparagement” and “immorality” bars to federal registration of trademarks. But the concurring opinions in *Brunetti* raise the possibility that a viewpoint-neutral amendment to the Act prohibiting the registration of “vulgar” marks *might* withstand a First Amendment challenge. The constitutionality of such a legislative response to *Brunetti* might rest on the characterization of the PTO’s Principal Register as a limited public forum, the resurrection of the seemingly-discredited (by *Tam*) “minimal-burden” view of denials of registration, and/or a willingness to treat “vulgar” marks as “low-value” speech. The likelihood of any of those approaches commanding a Supreme Court majority, however, seems small. Meanwhile, other provisions of the Lanham Act that bar registration of particular categories of marks, for non-commercial reasons, now appear vulnerable to First Amendment challenges. Finally, those same concurring opinions suggest that the concept of “low-value” speech is not extinct, a suggestion that has implications for other First Amendment contexts.

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218. *Cohen*, 403 U.S. 15 (1971), famously upheld the First Amendment right to wear a jacket bearing the words “Fuck the Draft” in a corridor of a county courthouse.