MAKE AMERICA NAUGHTY AGAIN: THE RISK OF RISQUÉ TRADEMARKS

Posted on February 21, 2018 by Michael A. Kahn

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Two years ago, in a post entitled "Is Your Brand Naughty or Nice? The New Santa at the Trademark Office", I discussed some rulings at the U.S. Trademark Office that suggested that those old fuddy-duddies might be relaxing their view of what types of trademarks violate the immoral/scandalous rule in the Lanham Act. In addition to giving a shout-out to the Office's registration of my new favorite beer trademark—Nut Sack Brown Ale—I offered the following observations on two trademark registration disputes that were working their way up through the courts:

> *In re Tam involved the rejection of an Asian-American music band's application to register their name, THE SLANTS. That rejection was based on the other provision of Section 2(a) of the Trademark Act, namely, the one that bans registration of "disparaging" trademarks. But on the appeal late last year, the Federal Circuit ruled that Section 2(a)'s ban on "disparaging" trademarks is unconstitutional.*
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> *"While the Trademark Office may yet ask the Supreme Court to review that ruling it has for now conceded—in connection with the appeal of the refusal to register FUCT as "scandalous and immoral"—that the Federal Circuit's reasoning in In re Tam also requires elimination of the Lanham Act's prohibition on the registration of scandalous and immoral marks.*

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Indeed, with those two ruling on appeal (and thus unresolved), I created a hypothetical for the students in my First Amendment law school course in which the question was whether they could obtain a federal trademark registration for the brand of the following bottle of hot sauce, which I happened upon in an upscale kitchen store in Boulder, Colorado.

© The Hottest F***kin'

But by the time we reached that week of the class, the courts had already provided the answer, and in the process significantly reshaped an entire realm of law governing what can and can't be registered as a federal trademark.

Trademark Trouble: "Disparage" and Immoral

By way of background, Section 2(a) of the Lanham Act (15 U.S.C. § 1052(a)), which governs that question, states that no trademark shall be refused registration unless it "consists of or comprises immoral … or scandalous matter; or matter which may disparage … persons, living or dead, . . . or bring them into contempt, or disrepute . . ."

The Slants case had involved the "disparage" provision of that Section 2(a) while FUCT involved the immoral/scandalous provision. And in both cases, the trademark at issue did indeed run afoul of the statutory language. And thus in both cases, the high court—the U.S. Supreme Court in the Slants case, the Federal Circuit Court of Appeals in the FUCT case—held that the relevant restriction in Section 2(a) violated the First Amendment and was thus unenforceable.

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Both decisions had to grapple with the reality that a trademark owner's right to use a trademark does not depend upon whether that trademark is registered. The Asian-American rock band The Slants was founded under that name more than a decade ago and could continue to perform under that name regardless of the outcome of their registration battle.

So, too, FUCT is a clothing brand founded back in 1990 by American artist and designer Erik Brunetti, and had already been operating under that trademark for more than two decades when Mr. Brunetti decided to seek a registration for his brand.

Nevertheless, the Supreme Court deemed the "disparagement" restriction an impermissible viewpoint discrimination by the government in The Slants case while the Federal Circuit in the FUCT case held that the refusal to register trademarks consisting of immoral or scandalous matter necessarily bans speech based on content, in violation of the First Amendment.

What will be the impact of these two decisions? Will the U.S. trademark register become a haven for offensive and vulgar commercial brands? Indeed, the Federal Circuit Court conceded in its ruling

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that "he trademark at issue is vulgar," that "the use of such marks in commerce is discomforting," and that "we are not eager to see a proliferation of such marks in the marketplace."

It's too soon to tell whether there will be such a proliferation—especially since the application process can be lengthy and expensive and, moreover, it can be challenging to try to market your goods and services under a brand that offends a large portion of your consumer audience.

Pending 4-letter words Trademarks: "truck" and "fit"

Nevertheless, in seeking an answer to the "proliferation" question your humble scribe conducted on your behalf a search of the US Trademark Office data base for pending applications that include one of the two most familiar 4-letter words—namely, the one that rhymes with "truck" and the one that rhymes with "fit."

As for that first one, I can report that there are more than 90 pending applications to register a trademark that includes the F-word, including **OFF** (for "charitable fundraising"—yes, you read that right), **PROUD AS** (for entertainment services), **CALM THE DOWN** (for tea) and, of course, **CLUSTER** (for beer, which somehow seems appropriate, at least based on my recollection of supposedly brilliant plans hatched by college students around closing time in bars). One clever company actually obtained a registration for **FAUQ-YEAH!** for athletic apparel.

As for that 4-letter word for excrement, you will not be shocked to learn that there are more than 100 pending applications, including, of course, **HAPPENS** (for card games), **HOLY** (for t-shirts), **PIECE OF** (for athletic apparel), and **YOU DON'T LEARN IN COLLEGE** (for "Business training in the field of leadership development").

Risqué Risk: Four-Letter Words as a Brand

But is there a takeaway for that clever entrepreneur or marketer who has no desire to adopt a four-letter word as a brand? Absolutely. Up until these two decisions—and especially the FUCT one—there was always the risqué risk, namely, that a mildly risqué trademark might get rejected as "immoral" or "scandalous." You literally could not predict how a Trademark Examiner would react—an ongoing uncertainty that the Federal Circuit Court highlighted with the example of the handling of various applications to register trademarks that included the acronym MILF. (If you don't know the meaning of that acronym, I suggest you visit Urban Dictionary.)

Here is what the Court explained:

> *One commentator has written that, of the forty marks containing the acronym MILF . . . as of 2011, twenty marks received an office action refusing registration based on § 2(a), while twenty did not. * * * It is difficult to understand what distinguished the refused marks, which included GOT MILF (clothing), MILF MANIA (adult online services), MILF SEEKER (adult entertainment services), and FROM SOCCER MOM TO MILF (self-help books for women), from the marks which were registered, including DIARY OF A MILF (adult online services),*

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> *BACKROOM MILF (adult online services), FAT MILF (sandwich), and MILF NEXT DOOR (adult online services).*

And thus the Courts have eliminated the risqué risk, and in the process they have eliminated one important unpredictable factor in the trademark registration process.

Out of deference to any faint-hearted readers and to avoid the need for trigger warnings, we have BLEEPed out the words the rhyme with "truck" and "fit."

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