

A 'Rush' Of Offensive Trademarks? Maybe Not

By **Bill Donahue**

Law360 (June 25, 2019, 7:15 PM EDT) -- U.S. Supreme Court Justice Sonia Sotomayor is predicting that the high court's decision to strike down a ban on offensive trademark registrations will lead to a "rush" of vulgar brand names, but some experts aren't quite as worried.

Justice Sotomayor's dire prediction came in a dissent from the court's Monday ruling in *Iancu v. Brunetti* that struck down the Lanham Act's ban on the registration of "immoral or scandalous" trademarks. The court's majority said the rule violated the First Amendment because it "disfavors certain ideas."

Without that provision, Justice Sotomayor warned, the U.S. Patent and Trademark Office would have "no statutory basis to refuse (and thus no choice but to begin) registering marks containing the most vulgar, profane, or obscene words and images imaginable."

"The Court's decision today will beget unfortunate results," she wrote in a dissent largely echoed by Chief Justice John Roberts and Justice Stephen Breyer. "The coming rush to register such trademarks — and the Government's immediate powerlessness to say no — is eminently avoidable."

But as the dust settles after Monday's ruling, experts aren't sure that things are going to be as bad as all that.

"This isn't going to open the floodgates in terms of what you see walking through the mall," said Monica Riva Talley, an attorney at the firm of Sterne Kessler Goldstein & Fox PLLC.

Of course, the headlines — the Supreme Court says words like "Fuct" can be registered as trademarks! — will almost certainly lead to a short-term spike in applications for foul language and lewd imagery at the USPTO.

But even without the "immoral or scandalous" bar, most of those applications will still face a difficult road to actual registration.

Mirroring the flood of defective applications that are filed after terms like President Donald Trump's "Covfefe" go viral, the "rush" for profane marks will likely be composed primarily of deeply flawed applications. They will be filed by opportunistic applicants who think that if they act fast, they can lock down far-reaching and exclusive rights to a particular phrase.

But that's not how American trademark law works, as the USPTO will certainly tell them.

The agency will refuse many of them because the owner can't show that it's actually using the mark or intends to start using it. The USPTO will refuse others because they're merely common vulgar phrases, rather than distinctive designators of source. Still others will be declined because they're just ornamental designs, rather than actual trademarks.

So while the ban on immoral or scandalous might be gone, experts say the USPTO will have plenty of reasons to keep rejecting many of those kinds of trademark applications.

"Simply emblazoning a phrase on the front of T-shirt does not make it a trademark," said Mark Sommers, an attorney at the firm of Finnegan Henderson Farabow Garrett & Dunner LLP.

"This ruling will probably lead to stricter examination of whether these particular terms are being used as indicators of source, as opposed to mere expressions, as opposed to simple vulgarity," Sommers said.

In the longer term, Monday's ruling will allow more-legitimate applicants to successfully register their edgier trademarks, but the universe of such brands is obviously somewhat limited.

A beer company with a crass name for an IPA, a sex toy maker with an explicit name for a product or an apparel brand with a counter-culture aesthetic — companies that have built up legitimate goodwill in a "scandalous" trademark — will now be able to get the added benefits of a federal registration.

But the removal of a technicality for trademark registration will not suddenly force consumers to embrace violent, hateful or patently offensive brands. The marketplace, the true creator of substantive trademark rights, is no more receptive to those messages now than it was on Sunday.

"We're not going to all of a sudden be bombarded with obscene or offensive imagery and wording on products," said Talley, the Sterne Kessler attorney. "This ruling doesn't give marketability or public acceptance to something that isn't already there."

The rarity of such viable offensive brands is underscored by just how infrequently many trademark lawyers have actually had to deal with USPTO refusals under the now-stricken ban on scandalous material. Talley, a veteran attorney and the chair of the trademark group at Sterne Kessler, said she had handled only one or two such situations over the course of her career.

Martin Schwimmer, a longtime trademark lawyer with the firm of Leason Ellis LLP, echoed that sentiment and said he was trying to convey that message to clients in the wake of Monday's highly publicized ruling.

"What's the opposite of a client alert?" Schwimmer joked. "You almost want to tell your clients to ignore a case, even though it's getting a lot of attention, because the issue never comes up in real life."

--Editing by Jill Coffey and Emily Kokoll.