



Happy Valentine's Day

Mesmer & Deleault, PLLC
41 Brook Street, Manchester, NH 03104
Seacoast Office: One New Hampshire Ave., Suite 125
Portsmouth, NH 03801



Tip of the Month

Viewpoint Discrimination in the U.S. Trademark Office

The Lanham Act, enacted July 5, 1946, is the primary federal trademark statute of law in the United States. The Act prohibits a number of activities, including trademark infringement, trademark dilution, and false advertising. The Act also discloses what terms/words cannot be registered as a federal trademark.

Section 2(a) of the Act states that "no trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it -

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; . . . "

In practice, the U.S. Trademark Office has rigorously enforced Section 2(a) of the Act based on the Trademark Office's viewpoint with regard to trademark applications that attempted to register a mark that violated this provision of the Act.

Recently, the Trademark Office's enforcement of Section 2(a) was challenged on constitutional grounds.

In one case Matal v. Tam, the mark in question was THE SLANTS for entertainment in the nature of live performances by a musical band, which was the name of a dance rock group. The dance rock group is the world's first all Asian-American dance rock band that had been making music for more than a decade. The issue partly involved the First Amendment right of free speech, but also centered on the real meaning of Section 2(a) regarding terms appearing to disparage persons living or dead. Needless to say, the case went all the way to the U.S. Supreme Court.

In June 2017, the U.S. Supreme Court issued a unanimous landmark ruling siding with the dance rock group. The holding stated that Section 2(a) violated a first amendment principle; Speech may not be banned on the ground that it expresses ideas that offend.

In a second case Iancu v. Brunetti, the mark in question was FUCTION for Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps; Children's and infant's apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments. FUCTION stood for "Friends U Can't Trust." The issue in this case also partly involved the First Amendment right of free speech, but also centered on the term as immoral or scandalous. The Federal Circuit Court of Appeals sided with Brunetti relying on the Supreme Court ruling in the Tam case. The U.S. Trademark Office appealed to the U.S. Supreme Court.

In June 2019, the U.S. Supreme Court issued a majority opinion again on first amendment grounds. Unlike the unanimous ruling in the Tam case, the court ruled in favor of Brunetti in a 6-3 majority. The difference here is that the Court had to make the decision because of the vagueness of the terms "immoral" and "scandalous" in the Act.

If you or your company needs help in registering a federal trademark for a term that could be disparaging to persons living or dead, or could be immoral or scandalous, help can be obtained from the trademark attorneys at Mesmer & Deleault by calling 603-669-1971 or by email at mailbox@biz-patlaw.com

Frank B. Mesmer, Jr.
Robert R. Deleault
Sarita L. Pickett
Joshua N. Mesmer



(603) 668-1971

Fax (603) 622-1445

E-mail: mailbox@biz-patlaw.com

Website: www.biz-patlaw.com