AMERICAN CONSTITUTIONALISM

VOLUME II: RIGHTS AND LIBERTIES

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Supplementary Material

Chapter 11: The Contemporary Era – Free Speech: Advocacy

 **Iancu v. Brunetti**, \_\_\_ U.S. \_\_\_ (2019)

*Erik Brunetti created the FUCT clothing line. When his efforts to register FUCT as a trademark were rebuffed by the Patent and Trademark Office [PTO] on the ground that the Lanham Act prohibited trademarks that consist of “immoral or scandalous matter”, Brunetti promptly sued Andrei Iancu, the Director of the PTO. Brunetti claimed that Lanham Act violated the free speech clause of the First Amendment. The Court of Appeals agreed and declared the relevant provision of the Lanham Act unconstitutional. Iancu appealed to the Supreme Court of the United States.*

 *The United States Supreme Court by a 6-3 vote upheld the lower federal court. Justice Elena Kagan’s majority opinion maintained that the Lanham Act engaged in unconstitutional viewpoint discrimination, both with respect to banning “immoral” trademarks and “scandalous” trademarks. Chief Justice Roberts, Justice Sonia Sotomayor and Justice Stephen Breyer agreed that the ban on “immoral” trademark was unconstitutional, but insisted that the ban on “scandalous” trademarks passed constitutional muster. Why do the justices agree that the ban on “immoral” trademarks is unconstitutional? Why do they dispute the constitutionality of the ban on “scandalous” trademarks? Who has the better of that argument? Breyer calls on the court to abandon categorical reasoning for proportionality analysis. Proportionality analysis is the ways in which courts in most other constitutional democracies analyze rights issues. What are the elements of proportionality analysis? How does that analysis differ from categorical analysis? Which is better for First Amendment issues?*

Justice [KAGAN](https://1.next.westlaw.com/Link/Document/FullText?findType=h&pubNum=176284&cite=0301239401&originatingDoc=I6d254170966211e9b8aeecdeb6661cf4&refType=RQ&originationContext=document&transitionType=DocumentItem&contextData=(sc.Search)&analyticGuid=I6d254170966211e9b8aeecdeb6661cf4) delivered the opinion of the Court.

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This Court first considered a First Amendment challenge to a trademark registration restriction in *Matel v. Tam* (2017). . . . . There, the Court declared unconstitutional the Lanham Act’s ban on registering marks that “disparage” any “person[ ], living or dead.” . . . [A]ll the Justices agreed on two propositions. First, if a trademark registration bar is viewpoint-based, it is unconstitutional. And second, the disparagement bar was viewpoint-based.

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If the “immoral or scandalous” bar similarly discriminates on the basis of viewpoint, it must also collide with our First Amendment doctrine. . . . It is viewpoint-based. . . . When is expressive material “immoral”? According to a standard definition, when it is “inconsistent with rectitude, purity, or good morals”; “wicked”; or “vicious.” . . . So the Lanham Act permits registration of marks that champion society’s sense of rectitude and morality, but not marks that denigrate those concepts. And when is such material “scandalous”? Says a typical definition, when it “giv[es] offense to the conscience or moral feelings”; “excite[s] reprobation”; or “call[s] out condemnation.” . . . 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 offense and condemnation. The statute favors the former, and disfavors the latter. . . .

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. . . . This Court, of course, may interpret “ambiguous statutory language” to “avoid serious constitutional doubts.” But that canon of construction applies only when ambiguity exists. “We will not rewrite a law to conform it to constitutional requirements. . . . The “immoral or scandalous” bar stretches far beyond the Government’s proposed construction. The statute as written does not draw the line at lewd, sexually explicit, or profane marks. Nor does it refer only to marks whose “mode of expression,” independent of viewpoint, is particularly offensive. It covers the universe of immoral or scandalous. . . Whether or not lewd or profane. . . .

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Justice [ALITO](https://1.next.westlaw.com/Link/Document/FullText?findType=h&pubNum=176284&cite=0153052401&originatingDoc=I6d254170966211e9b8aeecdeb6661cf4&refType=RQ&originationContext=document&transitionType=DocumentItem&contextData=(sc.Search)&analyticGuid=I6d254170966211e9b8aeecdeb6661cf4), concurring.

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Our decision is not based on moral relativism but on the recognition that a law banning speech deemed by government officials to be “immoral” or “scandalous” can easily be exploited for illegitimate ends. 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. The particular mark in question in this case could be denied registration under such a statute. The term suggested by that mark is not needed to express any idea and, in fact, as commonly used today, generally signifies nothing except emotion and a severely limited vocabulary. The registration of such marks serves only to further coarsen our popular culture. But we are not legislators and cannot substitute a new statute for the one now in force.

Chief Justice [ROBERTS](https://1.next.westlaw.com/Link/Document/FullText?findType=h&pubNum=176284&cite=0258116001&originatingDoc=I6d254170966211e9b8aeecdeb6661cf4&refType=RQ&originationContext=document&transitionType=DocumentItem&contextData=(sc.Search)&analyticGuid=I6d254170966211e9b8aeecdeb6661cf4), concurring in part and dissenting in part.

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. . . . I agree with the majority that the “immoral” portion of the provision is not susceptible of a narrowing construction that would eliminate its viewpoint bias. As Justice SOTOMAYOR explains, however, the “scandalous” portion of the provision is susceptible of such a 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. . . .

I also agree that, regardless of how exactly the trademark registration system is best conceived under our precedents, . . . refusing 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. 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 Government to give aid and comfort to those using obscene, vulgar, and profane modes of expression.

Justice [BREYER](https://1.next.westlaw.com/Link/Document/FullText?findType=h&pubNum=176284&cite=0254766801&originatingDoc=I6d254170966211e9b8aeecdeb6661cf4&refType=RQ&originationContext=document&transitionType=DocumentItem&contextData=(sc.Search)&analyticGuid=I6d254170966211e9b8aeecdeb6661cf4), concurring in part and dissenting in part.

Our precedents warn us against interpreting statutes in ways that would likely render them unconstitutional. Following these precedents, I agree with Justice SOTOMAYOR that, for the reasons she gives, we should interpret the word “scandalous” in the present statute to refer only to certain highly “vulgar” or “obscene” modes of expression.

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. . . [A] category-based approach to the First Amendment cannot adequately resolve the problem before us. I would place less emphasis on trying to decide whether the statute at issue should be categorized as an example of “viewpoint discrimination,” “content discrimination,” “commercial speech,” “government speech,” or the like. Rather, . . . I believe we would do better to treat this Court’s speech-related categories not as outcome-determinative rules, but instead as rules of thumb. After all, these rules are not absolute. The First Amendment is not the Tax Code. Indeed, even when we consider a regulation that is ostensibly “viewpoint discriminatory” or that is subject to “strict scrutiny,” we sometimes find the regulation to be constitutional after weighing the competing interests involved.

. . . . Rather than deducing the answers to First Amendment questions strictly from categories, as the Court often does, I would appeal more often and more directly to the values the First Amendment seeks to protect. . . . I would ask whether the regulation at issue “works speech-related harm that is out of proportion to its justifications.”

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The Court has not decided whether the trademark statute is simply a method of regulating pure “commercial speech.” . . . Trademarks, after all, have an expressive component in addition to a commercial one, and the statute does not bar anyone from speaking.. . .The trademark statute cannot easily be described as a regulation of “government speech,” either. The Government, however, may be loosely associated with the mark because it registers the mark and confers certain benefits upon the owner.

What about the concept of a “public forum”? . . . [O]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. The trademark registration system also bears some resemblance to cases involving government subsidies for private speech, as such programs—like trademark registration—may grant a benefit to some forms of speech without prohibiting other forms of speech.

As for the concepts of “viewpoint discrimination” and “content discrimination,” \*2306 I agree with Justice SOTOMAYOR that the boundaries between them may be difficult to discern. Even so, it is hard to see how a statute prohibiting the registration of only highly vulgar or obscene words discriminates based on “viewpoint.” Of course, such words often evoke powerful emotions. Standing by themselves, however, these words do not typically convey any particular viewpoint. Moreover, while a restriction on the registration of highly vulgar words arguably places a content-based limit on trademark registration, it is hard to see why that label should be outcome-determinative here, for regulations governing trademark registration “inevitably involve content discrimination.”

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Based on this proportionality analysis, I would conclude that the statute at issue here, as interpreted by Justice SOTOMAYOR, does not violate the First Amendment.

How much harm to First Amendment interests does a bar on registering highly vulgar or obscene trademarks work? Not much. The statute leaves businesses free to use highly vulgar or obscene words on their products, and even to use such words directly next to other registered marks. Indeed, a business owner might even use a vulgar word as a trademark, provided that he or she is willing to forgo the benefits of registration. Moreover, the field at issue here, trademark law, is a highly regulated one with a specialized mission: to “hel[p] consumers identify goods and services that they wish to purchase, as well as those they want to avoid. . . . For that reason, an applicant who seeks to register a mark should not expect complete freedom to say what she wishes, but should instead expect linguistic regulation.

Now consider, by way of contrast, the Government’s interests in barring the registration of highly vulgar or obscene trademarks. . . . The Government has at least a reasonable interest in ensuring that it is not involved in promoting highly vulgar or obscene speech, and that it will not be associated with such speech. For another, scientific evidence suggests that certain highly vulgar words have a physiological and emotional impact that makes them different in kind from most other words. . . . These attention-grabbing words, though financially valuable to some businesses that seek to attract interest in their products, threaten to distract consumers and disrupt commerce. And they may lead to the creation of public spaces that many will find repellant, perhaps on occasion creating the risk of verbal altercations or even physical confrontation. . . . 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.

The upshot of this analysis is that the narrowing construction articulated by Justice SOTOMAYOR risks some harm to First Amendment interests, but not very much. And applying that interpretation seems a reasonable way—perhaps the only way—to further legitimate government interests. . . .

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Justice [SOTOMAYOR](https://1.next.westlaw.com/Link/Document/FullText?findType=h&pubNum=176284&cite=0145172701&originatingDoc=I6d254170966211e9b8aeecdeb6661cf4&refType=RQ&originationContext=document&transitionType=DocumentItem&contextData=(sc.Search)&analyticGuid=I6d254170966211e9b8aeecdeb6661cf4), with whom Justice [BREYER](https://1.next.westlaw.com/Link/Document/FullText?findType=h&pubNum=176284&cite=0254766801&originatingDoc=I6d254170966211e9b8aeecdeb6661cf4&refType=RQ&originationContext=document&transitionType=DocumentItem&contextData=(sc.Search)&analyticGuid=I6d254170966211e9b8aeecdeb6661cf4) joins, concurring in part and dissenting in part.

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. . . . Rather than read the relevant text as the majority does, it is equally possible to read that provision’s bar on the registration of “scandalous” marks to address only obscenity, vulgarity, and profanity. Such a narrowing construction would save that duly enacted legislative text by rendering it a reasonable, viewpoint-neutral restriction on speech that is permissible in the context of a beneficial governmental initiative like the trademark-registration system. . . .

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As the majority notes, there are dictionary definitions for both “immoral” and “scandalous” that do suggest a viewpoint-discriminatory meaning. See ante, at 2299 – 2300. And as for the word “immoral,” I agree with the majority that there is no tenable way to read it that would ameliorate the problem. The word clearly connotes a preference for “rectitude and morality” over its opposite.

It is with regard to the word “scandalous” that I part ways with the majority. . . . To say that a word or image is “scandalous” can instead mean that it is simply indecent, shocking, or generally offensive. That offensiveness could result from the views expressed, but it could also result from the way in which those views are expressed: using a manner of expression that is “shocking to [one’s] sense of ... decency,” or “extremely offensive to the sense of ... propriety.”

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It is foundational “that a statute is to be read as a whole, since the meaning of statutory language, plain or not, depends on context.” Accordingly, and relatedly, courts should, to the extent possible, read statutes so that “ ‘no clause, sentence, or word shall be superfluous, void, or insignificant.’” Here, Congress used not only the word “scandalous,” but also the words “immoral” and “disparage,” in the same block of statutory text—each as a separate feature that could render a mark unregistrable. . . . With marks that are offensive because they are disparaging and marks that are offensive because they are immoral already covered, what work did Congress intend for “scandalous” to do? A logical answer is that Congress meant for “scandalous” to target a third and distinct type of offensiveness: offensiveness in the mode of communication rather than the idea. . . .

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What would it mean for “scandalous” . . . 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. . . . Of course, “scandalous” offers its own limiting principle: if a word, though not exactly polite, cannot be said to be “scandalous,” e.g., “shocking” or “extremely offensive,” it is clearly not the kind of vulgarity or profanity that Congress intended to target. Everyone can think of a small number of words (including the apparent homonym of Brunetti’s mark) that would, however, plainly qualify.

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Adopting a narrow construction for the word “scandalous”—interpreting it to regulate only obscenity, vulgarity, and profanity—would save it from unconstitutionality. 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.

Content discrimination occurs whenever a government regulates “particular speech because of the topic discussed or the idea or message expressed Viewpoint discrimination is “an egregious form of content discrimination” in which “the government targets not subject matter, but particular views taken by speakers on a subject.” While the line between viewpoint-based and viewpoint-neutral content discrimination can be “slippery,” it is in any event clear that a regulation is not viewpoint discriminatory (or even content discriminatory) simply because it has an “incidental effect” on a certain subset of views. . . . For example, a ban on lighting fires in the town square does not facially violate the First Amendment simply because it makes it marginally harder for would-be flag-burners to express their views in that place.

A restriction on trademarks featuring obscenity, vulgarity, or profanity is similarly viewpoint neutral, though it is naturally content-based. Brunetti invokes *Cohen v. California* (1971), to argue that the restriction at issue here is viewpoint discriminatory. . . Yes, Brunetti has been, as Cohen was, subject to content discrimination, but that content discrimination is properly understood as viewpoint neutral. And whereas even viewpoint-neutral content discrimination is (in all but the most compelling cases, such as threats) impermissible in the context of a criminal prosecution like the one that Cohen faced, Brunetti is subject to such regulation only in the context of the federal trademark-registration system. . . .

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. . . . Trademark registration, meanwhile, confers several ancillary benefits on trademark-holders who meet Congress’ specifications, including for example, additional protections against infringers.. Registering a mark in the Government’s searchable register puts the world on notice (whether actual or constructive) that a party is asserting ownership of that mark. Registration, in short, is a helpful system, but it is one that the Government is under no obligation to establish and that is collateral to the existence and use of trademarks themselves. There is no evidence that speech or commerce would be endangered if the Government were not to provide it at all.

When the Court has talked about governmental initiatives like this one before, it has usually used one of two general labels. In several cases, the Court has treated such initiatives as a limited public (or nonpublic) forum. In other situations, the Court has discussed similar initiatives as government programs or subsidies. In each of these situations, a governmental body established an initiative that supported some forms of expression without restricting others. Some speakers were better off, but no speakers were worse off. . . . Regardless of the finer distinctions between these labels, reasonable, viewpoint-neutral content discrimination is generally permissible under either framework. . . .

Whichever label one chooses here, the federal system of trademark registration fits: It is, in essence, an opportunity to include one’s trademark on a list and thereby secure the ancillary benefits that come with registration. Just as in the limited-forum and government-program cases, some speakers benefit, but no speakers are harmed. . . .

Prohibiting the registration of obscene, profane, or vulgar marks qualifies as reasonable, viewpoint-neutral, content-based regulation. Apart from any interest in regulating commerce itself, the 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. . . . 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. . . .

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