John E. Ottaviani Comments On SCOTUS Brunetti Decision In Leading Intellectual Property Media

Description

John E. Ottaviani, Partner and Chair of the PS&H Intellectual Property & Technology Practice Group, was featured in two leading intellectual property publications this week, commenting on an important decision from the Supreme Court of the United States (SCOTUS). John contributed his insights to *Managing Intellectual Property* and *IPWatchdog*.

On Monday, SCOTUS issued its decision in *Iancu v. Brunetti*, in which the Court struck down a provision of the Lanham Act, the federal trademark law, that prevents the registration of "immoral" or "scandalous" trademarks. In so doing, the Court affirmed its 2017 decision issued in *Matal v. Tam*, which struck down the Lanham Act's bar on registration of trademarks that may "disparage … or bring … into contemp[t] or disrepute" any "persons, living or dead." . In both cases, SCOTUS found that the prohibitions restricted free speech, violating the First Amendment of the U.S. Constitution.

In the *Managing Intellectual Property* article, "Scandalous Trademarks: Why SCOTUS Ruling May Lack Bite," John noted that, perhaps anticipating the SCOTUS decision in *Brunetti*, there were over 200 applications for trademarks containing the F-word pending at the U.S. Patent and Trademark Office on the morning of the SCOTUS decision.

In his concurring opinion in *Brunetti*, Justice Alito suggested that Congress adopt "a more carefully focused statute that precludes the registration of marks containing vulgar terms that play no real part in the expression of ideas." John observed that "as a practical matter, the current Congress does not seem to be inclined to focus on such things."

IPWatchdog covered the SCOTUS Brunetti decision in its article, "After *Brunetti*: The Trademark Bar Reacts to Fractured Decision." Focusing on the core issue — the Court's striking down the Lanham Act's prohibition on registering "immoral" or "scandalous" trademarks — the article featured comments from John and a number of other trademark attorneys.

John commented that, "The *Brunetti* decision is not surprising, given the Supreme Court's *Matal* decision from 2017. My own view is that I agree with the majority that this provision is broad enough to prohibit registration of marks that offend because of the ideas they convey (scandalous terms), as well as marks that offend because of their mode of expression (vulgar and profane terms)."

"The majority was careful not to rewrite the provision in a manner that might make it more palatable. Justice Alito agreed that the provision should be struck down but invited Congress to adopt a more carefully focused statute that precludes the registration of vulgar terms that play no part in the expression of ideas. In my opinion, however, as a practical matter, the current Congress does not seem to be inclined to focus on such things," said John.

"It will be interesting to see whether the logic of *Matal* and *Brunetti* is extended to other restrictions on registration in the federal trademark law and the USPTO rules, such as the current USPTO policy against registration of marks for cannabis-related products and services," John concluded.

To read the Managing Intellectual Property article, please click here. (subscription required; free trial available)

To read the IPWatchdog article, please click here.

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