

F-Word TM Ruling Highlights Key Defect Of Salacious Terms

By **Jane Shay Wald** (August 30, 2022, 6:44 PM EDT)

In re: Erik Brunetti[1] is less an exercise in deja vu than a testament to the Trademark Trial and Appeal Board's **adherence** to principle: To qualify for registration, the mark must identify an applicant as the single — though possibly anonymous — source of the goods and services offered in connection with the proposed term.



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The Aug. 22 precedential Brunetti decision, coupled with the June 24, 2021, In re: Snowflake Enterprises LLC decision,[2] is also a testament to the board's well-supported position that the Lanham Act offers more than one way to skin a cat.

The board stands firm that terms that fail to function as trademarks cannot register, even if they are disparaging, scandalous or immoral within the meaning of the former Section 2(a) — Title 15 of the U.S. Code, Section 1052(a) — the recently overturned provisions of the Lanham Act.

What happened here? While Iancu v. Brunetti, the "fuct" case for streetwear apparel, was still pending before the U.S. Supreme Court, Brunetti filed new applications to register F-word for merchandise in Classes 9, 14, 18 and retail services in Class 35. These were stayed, and ultimately examined and refused. Brunetti appealed to the TTAB.

On Aug. 22, the board affirmed the examining attorney's refusal to register these marks under Sections 1, 2, 3, and 45 of the Trademark Act, Title 15 of the U.S. Code, Sections 1051-53 and 1127, on the ground that the F-word "is a slogan or term that does not function as a trademark or service mark to indicate the source of the applicant's goods or services and to identify and distinguish them from others."

When a proposed mark fails to identify or distinguish the source of goods or services, it does not meet the statutory definition of a mark. Since it is not a mark, it cannot be registered.

Remember the 2017 Matal v. Tam decision?[3] And the 2019 Iancu v. Brunetti decision?[4] Of course you do! The Supreme Court struck down Section 2(a) of the Trademark Act as violating the First Amendment in both those cases.

The statutory sections that precluded registration of marks based on disparagement — "The Slants" — and for being scandalous or immoral — "Fuct" — were found unconstitutional viewpoint discrimination.

Some wailed in horror that there would be nothing to stop registration of the F-word — even without the cute misspelling — and warned that registration of the N-word would be next. Indeed, the Supreme Court itself predicted a statutory requirement for registration of the latter.

In *Iancu v. Brunetti*, footnote 5, Justice Sonia Sotomayor wrote:

There is at least one particularly egregious racial epithet that would fit this description as well. While *Matal v. Tam*, 582 U. S. ____ (2017), removed a statutory basis to deny the registration of racial epithets in general, the Government represented at oral argument that it is holding in abeyance trademark applications that use that particular epithet. As a result of today's ruling, the Government will now presumably be compelled to register marks containing that epithet as well rather than treating it as a "scandalous" form of profanity under §1052(a).

Failure to function was not before the Supreme Court; they seemed, moreover, entirely unaware of it as a basis for refusal.

Some saw business opportunities and raced to the U.S. Patent and Trademark Office with applications for racist and scandalous terms for a variety of goods and services, with mixed results. Many were met with "failure to function" refusals.

Some trademark examiners propounded an informal advisory, alerting applicants who were refused on the basis of failure to function that claims of acquired distinctiveness wouldn't work. Neither would amending to the supplemental register.

The defect isn't the lack of secondary meaning, but the complete and incontrovertible failure of any possibility of source identification. Such refusals are not based on descriptiveness or weakness; they cannot be overcome with evidence of acquired distinctiveness.

Failure to function is settled law. Relatively recent examples of refusals for failure to function include:

- "I ♥ DC" for clothing[5];
- "Texas Love" for hats and shirts[6]
- "Past Present Future" for T-shirts reflecting an affinity with Floyd Mayweather[7];
- "Team Jesus" for clothing and educational and entertainment services[8];
- "God Bless the USA" for home decor[9];
- "Black Lives Matter" for a variety of goods and services[10];
- "Magic Number 108" for T-shirts[11]; and
- "40-0" for apparel.[12]

The 43 applicants for Covfefe?[13] Ditto. The Trademark Manual of Examining Procedure, Section 1202.04(b), addressing widely used messages often supports these refusals.

As the board explained, "consumers ordinarily take widely used, commonplace messages at their ordinary meaning, and not as source indicators, absent evidence to the contrary," noting that Brunetti had presented no evidence to the contrary — as he could not, as his applications were filed on an intent to use basis.

The board emphasized here, as it does in every failure to function case, that the critical inquiry in determining whether the proposed mark functions as a trademark or service mark is how the public perceives it.

The board explained:

Matter may be merely informational and fail to function as a trademark if it is a common term or phrase that consumers of goods or services identified in the application are accustomed to seeing used by various sources to convey ordinary, familiar, or generally understood concepts or sentiments. Such widely used messages will be understood as merely conveying the ordinary concept or sentiment normally associated with them, rather than serving any source-identifying function.

The examining attorney's evidence fell into two general categories; the board agreed that this evidence doubly supported a failure to function. The first category of evidence showed ubiquity of the word. The following tidbits show the flavor of some of the ubiquity evidence:

A 2019 article from Vogue noted that public use of the F-word is "flowing freely." [14]

Another 2019 article on the website of novelty retailer Spencers Gifts LLC asked, "Why, exactly, is the [F-word] so special, and why does it appear on so many of our most popular t-shirts, hats, socks and even fleece blankets? Well, for one thing, [it] is an all-purpose word." [15]

From an avalanche of similar evidence of record, the board agreed with the examining attorney that consumers are used to seeing the F-word and "would not perceive the use of the term as a mark identifying the source of Applicant's goods and/or services, but rather as only conveying an informational message or sentiment."

The second bucket of evidence included substantial evidence used to decorate all manner of merchandise, including third-party use on all the goods in Brunetti's applications.

The board observed, on the evidence, that the F-word "is arguably one of the most expressive words in the English language — an 'all purpose' word." Given the conclusion that the word is all-purpose, perhaps the USPTO ought not to have rejected "Fuct" as scandalous or immoral in the first place?

Applicant Brunetti's arguments were unpersuasive. He pointed to a Wikipedia chart showing that 100% of the 100 most commonly used words in the English language are registered, concluding that since the evidence shows the F-word is less common than all of the 100 registered words, then it must be registered too.

The board rejected Brunetti's premise, because "mere commonality is not the test." The test is whether purchasers and prospective purchasers of the identified goods and services would understand the term as identifying the source or origin of such goods and services.

The applicant raised *Iancu v. Brunetti* for the position that his marks must be registered.

Since the Supreme Court only determined the 2(a) refusal at issue, Brunetti's arguments were unavailing.

To bring his arguments closer to the Supreme Court "viewpoint discrimination" slap-down, Brunetti argued that his proposed mark was protected by the First Amendment because he intended to use it through his merchandise and services to express sentiments vis-à-vis capitalism, government, religion and pop culture.

The board emphasized that these concepts would be more likely to be perceived as imparting information than signifying source.

Brunetti further argued that the PTO showed constitutionally improper content discrimination because some marks that included the F-word were registered. The board countered with "even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect' as applicant's mark, it does not bind the Board."

While the new Brunetti case is hot off the press, it was foreshadowed by the board last year in an almost identical case, involving a refusal to register a variation of the N-word — the In re: Snowflake case referred to above.

There too, the board found the term failed to function as a trademark due to its ubiquity. In that case, the board agreed with the examining attorney that the term failed to function as a mark for the goods identified in the application "because the proposed mark is a commonplace term widely used by a variety of sources that merely conveys an ordinary, familiar, and well-recognized concept or sentiment."

The applicant argued that *Matal v. Tam* entitled it to register the variation of the N-word.

It said that because a common racial epithet invariably has an expressive component, it functions as a trademark and must register. The board sharply disagreed, saying "In *Tam*, the mark THE SLANTS was in use in connection with applicant's band and there was no dispute that THE SLANTS functioned as a mark."

The board clarified that many trademarks identify the source of a product or service — as they must, to be trademarks at all — and in addition say something more. This "something more" may be about the product or service or some broader issue. The Slants' name identified the band as the source of its entertainment services, and also expressed a view about social issues. The Supreme Court did not hold that "The Slants" functioned as a mark just because it expressed a view about social issues.

Presaging the new Brunetti case, the board, in *Snowflake*, stated:

[N]othing in *Tam* or *Brunetti* prohibits the USPTO from refusing to register an offensive or vulgar term if the term is ineligible for registration under provisions of the Trademark Act other than the specific ones invalidated in those cases.

The presence of other N-word terms on the register is of no precedential value in the board's determination that applicant has no constitutional right to register N---a as it is otherwise ineligible for registration based on its failure to function as a mark.[16]

The board in *Snowflake* found that third-party use evidence established that the N-word variation was ubiquitous, including on apparel of the type identified by the applicant, so that consumers would not be likely to indicate the applicant as the sole source of the claimed goods under the mark.

The board raised an interesting though not outcome-determinative point regarding a paradox in the applicant's bid to have the slur registered as a brand for its clothing. The applicant urges that by using the slur, it is "reclaiming" it. Presumably, the idea is to rob the term of its pejorative sting, akin to evolution of the word "queer."

The board noted that several third-party users of the applicant's mark on clothing "appear to be doing exactly the same thing." Trademark registration is a tool to preclude others' use and registration of the mark for the same, similar or related goods. "[O]ther sellers of clothing bearing the word would instantly become potential infringers" if the applicant

secured a registration's benefit of exclusivity.

Granting the registration to the applicant "would achieve the absurd result of hampering others in their use of the common phrase for clothing and other products."

Of course, the same could be said of Simon Shiao Tam's goal of reclaiming "The Slants." And of Erik Brunetti's goal of trademarking the F-word for political and social commentary.

Whatever the message may be, the term must point uniquely to the applicant as the source of the goods or services or it is not a mark at all.

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[1] [In re Erik Brunetti](#), case numbers 88308426, 88308434, 88308451 and 88310900 (TTAB August 22, 2022).

[2] [In re Snowflake Enterprises, LLC](#), No. 87496454 WL 2888343 (TTAB June 24, 2021).

[3] [Matal v. Tam](#), 137 S. Ct. 1744 (2017).

[4] [Iancu v. Brunetti](#), 139 S. Ct. 2249 (2019).

[5] [D.C. One Wholesaler v. Chien](#), 120 USPQ2d 1710 (TTAB 2016).

[6] [In re Texas Love LLC](#), 2020 USPQ2d 11290 (TTAB 2020).

[7] [In re Mayweather Promotions, LLC](#), 2020 USPQ2d 11489 (TTAB, 2020).

[8] [In re Team Jesus LLC](#), 2020 USPQ2d 11489 (TTAB 2020).

[9] [In re Lee Greenwood](#), No. 87/168,719, 2020 WL 7074687 (T.T.A.B. Dec. 1, 2020).

[10] e.g., Ser. No. 88/956,472.

[11] [In re DePorter](#), 129 USPQ2d 1298 (TTAB 2019).

[12] [University of Kentucky v. 40-0, LLC](#), No. 91/224,310, 2021 WL 839189 (TTAB March 4, 2021).

[13] [In re Gillard](#), No. 87469115 WL 646095 (TTAB January 11, 2019).

[14] <https://www.vogue.com/article/the-f-word-is-on-the-effing-rise>.

[15] <https://www.spencersonline.com/blog/why-we-love-the-word-fuck/>.

[16] Jeffrey Greene and Rose Kautz, Expert Analysis, "The State of Scandalous Trademarks Post-Brunetti," Law360, April 16, 2020.