

THE TREATMENT OF IMMORAL, SCANDALOUS, AND DISPARAGING MARKS IN TRADEMARK LAW OF THE UNITED STATES AND TURKEY

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ABSTRACT

A trademark serves as a concise mode of communication from a seller to current or prospective buyers wherein the seller signifies an endorsement of certain goods or services. This sets them apart from similar goods or services provided by competitors. However, trademarks often do not simply identify the source of a product or service, but also to convey a broader message. This creates an intersection between trademark law and the fundamental right of freedom of expression and presents challenging legal, ethical, and societal concerns that can differ significantly from one jurisdiction to another.

*In the United States, these concerns resulted in the cancellation of registration bars for immoral, scandalous, and disparaging marks. After more than five decades of the Lanham Act's operation, the rule that bars disparaging marks was found unconstitutional in 2017 under the Supreme Court's decision in *Matal v. Tam*. Then, the rules barring immoral and scandalous marks were found unconstitutional in 2019 by the Supreme Court in *Iancu v. Brunetti*. Both decisions cited viewpoint discrimination as a violation of the First Amendment's Free Speech clause.*

By contrast, in Turkey and the European Union (EU), the registration bar for marks that are contrary to public policy and accepted principles of morality is still in effect, even though there have been some free speech concerns. This legal landscape offers an opportunity to perform a comparative analysis between jurisdictions and to observe how diverse legal systems address the complex interplay between commerce, speech, and societal norms. Through a detailed examination of legislative frameworks, judicial interpretations, and policies in the United States and Turkey, this paper embarks on a comparative analysis of the treatment of immoral, scandalous, and disparaging marks within these two jurisdictions. This paper makes numerous proposals concerning both the approaches of the United States and Turkey, considering policy and the results of empirical research.

There are five sections. The first section provides an introduction; the second section concerns U.S. trademark law; the third section reviews Turkish trademark law; the fourth section is a comparison of these jurisdictions; and the final section offers proposals. The comparison includes a discussion of international agreements concerning the treatment of marks considered immoral, scandalous, or disparaging and includes examples from European practice.

I. INTRODUCTION

Trademarks,¹ as defined in Section 45 of the Lanham Act, are “any word, name, symbol, or device, or any combination thereof” used by a person “to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”² The definition for service marks is almost the same.³ In addition to their main functions of source/origin identifying and distinguishing from competitors as defined, trademarks may have other functions like guaranteeing the consistent quality of goods or services, advertising of goods or services thus communicating with buyers or users, protecting, and increasing the investment on the goods or services.⁴ Ultimately, trademarks serve to secure the goodwill associated with the mark and the accompanying business. They enable repeat purchasing by consumers when locating preferred goods and services. These functions underlie the principles and objectives of trademark law.⁵

In furtherance of these functions and objectives, countries have statutory bars against the registration of some marks.⁶ This paper will focus on the bars against registration because, even though Section 43(a) of the Lanham Act allows for a federal cause of action for infringing an unregistered mark, and through state laws and the common law for protection,⁷ securing a place on the Principal Register

¹ *Matal v. Tam*, 582 U.S. 218, 224 (2017) (“trademarks often consisted of catchy phrases that convey a message”).

² Turk. Indus. Prop. Code [hereinafter IPC] art. 4 (“(1) Trademarks may consist of any signs like words, including personal names, figures, colors, letters, numbers, sounds and the shape of goods or their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings and being represented on the register in a manner to determine the clear and precise subject matter of the protection afforded to its proprietor”).

³ TYLER T. OCHOA, SHUBHA GHOSH, & MARY LAFRANCE, *UNDERSTANDING INTELLECTUAL PROPERTY* 462, 467 (4th ed. 2020).

⁴ See SAMI ÖZGÜR MEMİŞOĞLU, *MARKA HUKUKUNDA MUTLAK RET SEBEPLERİ [ABSOLUTE GROUNDS FOR REFUSAL IN TRADEMARK LAW]* 25 (1st ed. 2019).

⁵ See Uli Widmaier, *Use, Liability, and the Structure of Trademark Law*, 33 *HOFSTRA L. REV.* 603, 614–15 (2004); see also Jerre B. Swann, Sr. et al., *Trademarks and Marketing*, 91 *TRADEMARK REP.* 787, 807 (2001) (“[S]trong brands . . . (i) allow access to consumers’ minds; (ii) make advertising less expensive or more impactful (or both); (iii) enable a manufacturer to communicate more directly with a consumer, cushioning any vagaries of distribution; (iv) assist in attaining channel power; (v) provide a more efficient and credible means of extending into related goods, and give rise to licensing opportunities; (vi) serve as certificates of ‘authenticity’; (vii) afford resilience; and (viii) constitute an asset-brand equity—that is frequently a company’s most valuable single property”).

⁶ Mariana Bernal Fandiño, *Controversial Trademarks: A Comparative Analysis*, in *THE CAMBRIDGE HANDBOOK OF INTELLECTUAL PROPERTY AND SOCIAL JUSTICE* 448, 449 (Steven D. Jamar & Lateef Mtima eds., Cambridge Univ. Press, 2024).

⁷ Similarly, in Turkey, unregistered trademarks can be protected against infringement under Unfair Competition rules of Turkish Commercial Code, and under Article 6(3), 6(4) and 25 of Turkish Industrial Prop. Code. IPC art. 6.

provides benefits.⁸ The benefits include prima facie proof of validity and ownership of the trademark; exclusive rights to use;⁹ constructive use granting nationwide priority;¹⁰ constructive notice to others;¹¹ potential incontestable status after five years;¹² enhanced ability to prevent importation of infringing goods;¹³ and access to a broader range of legal remedies in infringement cases.¹⁴ Additionally, Turkish trademark law provides similar benefits to the owner of a registered mark, such as pursuing certain criminal and civil actions under Articles 30 and 150 of the Turkish Industrial Property Code (IPC) against the infringer that an unregistered trademark owner cannot pursue.¹⁵ Thus, when the government refuses a trademark application that consists of the trademark owner's speech, it restricts protected speech, imposes burdens on trademark holders, and conditions access to federal benefits, thereby disfavoring the speech.¹⁶

In both jurisdictions, there are multiple registration bars, some of which are supported by governmental interests beyond the general objectives of trademark law.¹⁷ For instance, the bars against immoral, scandalous, and disparaging marks serve interests such as protecting "underrepresented groups" from disparaging or racist marks; ensuring "orderly flow of commerce";¹⁸ shielding the public and children from "highly offensive" or "vulgar" terms or signs;¹⁹ preventing marks that incite criminal activities, commercializing terrorist organizations or convicted terrorists following democratic prosecutions; and stopping marks that could mislead the public by appearing to represent official institutions.²⁰

Regulation and treatment of these registration bars are different in Turkish law, which is similar to European Union Law, particularly after the latest codification of Turkish Industrial Property Code No. 6769 in 2017.²¹ Under this Code, there are absolute grounds for refusal and relative grounds for refusal in trademark registration.²² While the Turkish Patent and Trademark Office (TPTO)

⁸ MARY LAFRANCE, UNDERSTANDING TRADEMARK LAW 78 (4th ed. 2020).

⁹ 15 U.S.C. § 1057(b); 15 U.S.C. § 1115(a).

¹⁰ 15 U.S.C. § 1057(b).

¹¹ 15 U.S.C. § 1072.

¹² 15 U.S.C. § 1052.

¹³ 15 U.S.C. § 1124.

¹⁴ *Id.*; 15 U.S.C. 1117(b)(c).

¹⁵ For example, under Article 30(1), "A person who produces or provides services, puts on the market or sales, imports or exports, buys for commercial purposes, possesses, transports or stores, while infringing a trademark right through quotation or likelihood of confusion, shall be sentenced from one year to three years of imprisonment and punished with judicial fine up to twenty thousand days." IPC art. 30.

¹⁶ *Tam*, 582 U.S. at 234–35.

¹⁷ Barton Beebe & Jeanne C. Fromer, *Immoral or Scandalous Marks: An Empirical Analysis*, 8 N.Y.U. J. INTELL. PROP. & ENT. LAW 169, 200 (2019).

¹⁸ *Tam*, 582 U.S. at 245.

¹⁹ *Iancu v. Brunetti*, 588 U.S. 388, 399 (2019).

²⁰ MEMİŞOĞLU, *supra* note 4, at 245.

²¹ İLHAMİ GÜNEŞ, UYGULAMALI MARKA HUKUKU [APPLIED TRADEMARK LAW] 16 (2d ed. 2020).

²² IPC art. 5 (regulating absolute grounds for refusal in trademark registration and article 6 regulates relative grounds for refusal in trademark registration).

examines absolute grounds for refusal *ex officio*, relative grounds for refusal are only considered upon opposition raised by third parties.²³ However, a third party may use both types of grounds as a cause of action against the trademark owner to invalidate a trademark registration.²⁴ Under Article 5(1)(i) of the IPC, which regulates absolute grounds for refusal, “signs which are contrary to public policy or accepted principles of morality” are not eligible for trademark registration.²⁵

Because of the inclusion of “public policy”²⁶ in the IPC, the scope of the bar in Turkey and Europe is broader than that in the United States even before *Tam* and *Brunetti*. This concept overlaps with “accepted principles of morality;” however, it also encompasses all rules that facilitate the proper functioning of public services, ensure the security and stability of the state, and uphold legal, peaceful, and moral standards in interpersonal relationships, thus supporting the preservation of the state and its structures.²⁷

The reason these provisions survive as constitutional in Turkey and Europe, but are found unconstitutional in the United States, can be traced to differences between their respective constitutions. The First Amendment to the U.S. Constitution does not allow exceptions to freedom of speech: “the government shall make no law . . . abridging freedom of speech.”²⁸ However, both the Constitution of the Republic of Turkey²⁹ and the European Convention on Human Rights (ECHR) include exceptions for “national security,” “public order,” “public safety,” “protecting the reputation or rights and private and family life of others,” and “protecting professional secrets as prescribed by law.”³⁰ Importantly, a narrower interpretation and application of these exceptions, as well as registration bars affecting free speech, are still accepted in the doctrine.³¹

After *Tam* and *Brunetti*, the U.S. Congress has not yet enacted a new provision to replace the unconstitutional sections of trademark law, leaving the United States Patent and Trademark Office (USPTO) without direct statutory grounds to reject trademarks that are “immoral,” “scandalous,” or “disparaging.”³² Public refusal and voluntary relinquishment of some of these marks may still occur, as exemplified by the R*****S cases.³³ However, certain companies may continue targeting consumers who are drawn to controversial marks precisely because of their highly offensive natures.

²³ IPC art. 6.

²⁴ IPC art. 23 § 1.

²⁵ IPC art. 5.

²⁶ MEMİŞOĞLU, *supra* note 4, at 765, 767, 771, 773, 800.

²⁷ HAMDİ YASAMAN ET AL., SINAI MÜLKİYET KANUNU ŞERHİ [COMMENTARY TO THE INDUSTRIAL PROPERTY LAW] (3. CİLT) 491 (1st ed. 2021).

²⁸ U.S. CONST. amend. I.

²⁹ Const. of the Rep. of Turk. art. 26; Eur. Convention of Hum. Rights art. 10.

³⁰ *Id.*

³¹ MEMİŞOĞLU, *supra* note 4, at 747.

³² Ned Snow, *Immoral Trademarks after Brunetti*, 58 Hous. L. Rev. 401, 423 (2020).

³³ See *Pro Football, Inc. v. Harjo*, 565 F.3d 880 (D.C. Cir. 2009); see also *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015), *vacated* 709 Fed. Appx. 182 (4th Cir. 2018).

Similarly, some marks may be refused registration because they fail to function as trademarks, are ornamental, or contain informational matter.³⁴ However, this approach cannot fully address the gap created by the Supreme Court decisions in *Tam* and *Brunetti* and can be incoherent, lack clarity, and be based on inconsistent multifactor tests.³⁵

To address this gap and the overbreadth of Turkish regulation, this paper will conclude with proposals and observations aimed at balancing governmental interests in enforcing these bars with the significant interests associated with the freedom of speech for all parties involved in Turkey and the United States. There are three sections. The first section analyzes U.S. trademark law, including empirical research concerning the disparaging and scandalous marks; the second section discusses Turkish trademark law; and the third section offers a comparison of these jurisdictions. The comparison includes the discussion of international agreements concerning the treatment of marks considered immoral, scandalous, or disparaging and includes examples from European practice.

II. U.S. TRADEMARK LAW

A. Background Trademark Principles in U.S. Law

Trademark law concerns the legal protection for symbols, names, and phrases that businesses use to signify their products or services, which sets them apart from competitors.³⁶ This legal framework stands distinct from copyright, which fosters artistic expression and utility patents, which advance technological innovation.³⁷ Unlike the incentives in copyright and patent law, the incentives provided by trademark law aim to encourage companies to maintain consistent standards for their goods and services, rather than innovate in the domain of trademarks themselves.³⁸ This approach ensures that consumers can easily recognize and choose products or services from companies that have previously met their expectations, thereby enhancing economic efficiency through fostering competition and safeguarding consumer interests.³⁹

³⁴ Christina S. Loza, *Iancu v. Brunetti: Immoral and Scandalous Marks May Now Be Registered with the USPTO without Limitation*, 61 ORANGE CNTY. LAW. 31, 34–35 (2019).

³⁵ Lucas D. Cuatrecasas, *Failure to Function and Trademark Law's Outermost Bound*, 96 N.Y.U. L. REV. 1312, 1316 (2021).

³⁶ Jon J. Lee, *Racism and Trademark Abandonment*, 91 GEO. WASH. L. REV. 932, 956 (2023).

³⁷ U.S. CONST. art. 1, § 8 (granting Congress the power “[t]o promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries”).

³⁸ Vincent Chiappetta, *Trademarks: More Than Meets the Eye*, 2003 U. ILL. J.L. TECH. & POL’Y 35, 93 (2003); see also ROGER E. SCHECHTER & JOHN R. THOMAS, TRADEMARK LAW 10 (2021).

³⁹ Chiappetta, *supra* note 38, at 93.

The 1946 Lanham Act is the heart of U.S. trademark law at the federal level. This legislation outlines the procedures for trademark registration, offering legal protections that reinforce the mark's use in commerce and provide remedies for infringement cases.⁴⁰

Under the Lanham Act, trademarks fulfill several essential functions. They primarily act as identifiers of the source or origin of goods and services and distinguish one source from others.⁴¹ This dual role enables consumers not only to ascertain the origin of products but also to differentiate between the myriad of options available in the marketplace, facilitating informed purchasing decisions.⁴² The legal foundation for these functions is laid out in the Lanham Act, specifically under Section 45, which defines a trademark as “any word, name, symbol, or device, or any combination thereof” used by a person “to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”⁴³ The definition for service marks is almost the same.⁴⁴ Through this definition, the Act emphasizes the importance of trademarks in identifying the source and distinguishing the goods or services, underscoring their essential role in the protection of consumer interests and the promotion of fair competition in the market.⁴⁵

In addition to these roles, trademarks play a crucial role in assuring quality, cultivating brand loyalty, and facilitating the advertisement of products or services, thereby safeguarding and enhancing the trademark owner's investment.⁴⁶ Their value for merchants stems from their capacity to encapsulate the “goodwill” earned through the merchant's endeavors and to direct this goodwill towards the using merchant rather than competitors, thereby increasing the chances of continued patronage from satisfied consumers.⁴⁷ These functions further illustrate that a trademark acts as a concise method of communication from a merchant to their customers.⁴⁸ As explained below, this function of trademarks creates an intersection between trademark law and the constitutional right of freedom of expression.⁴⁹

⁴⁰ OCHOA ET AL., *supra* note 3, at 466.

⁴¹ *Id.* at 467.

⁴² ROGER E. SCHECHTER & JOHN R. THOMAS, *PRINCIPLES OF TRADEMARK LAW* 10–11 (1st ed. 2021).

⁴³ IPC art. 4 (“(1) Trademarks may consist of any signs like words, including personal names, figures, colors, letters, numbers, sounds and the shape of goods or their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings and being represented on the register in a manner to determine the clear and precise subject matter of the protection afforded to its proprietor.”).

⁴⁴ OCHOA ET AL., *supra* note 3, at 476.

⁴⁵ *See* Widmaier, *supra* note 5, at 618–19.

⁴⁶ SCHECHTER & THOMAS, *supra* note 42, at 11–12.

⁴⁷ OCHOA ET AL., *supra* note 3, at 467.

⁴⁸ *Id.*

⁴⁹ Lisa P. Ramsey, *Trademark Law Institute for Intellectual Property & Information Law Symposium: Free Speech Challenges to Trademark Law After Matal v. Tam*, 56 HOUS. L. REV. 401, 415 (2018).

Consequently, when a trademark is violated, the public's expectation to avoid confusion and the goodwill secured by the trademark owner are compromised.⁵⁰

To effectively execute their functions, trademarks must be distinctive and non-functional.⁵¹ Distinctiveness is crucial for trademarks to reliably signal the origin of goods or services and enable differentiation within the marketplace.⁵² This distinctiveness can manifest in one of two ways: inherently, where the mark is distinctive by its very nature, as seen in fanciful, arbitrary, or suggestive marks; or through acquired distinctiveness, where the mark becomes distinctive over time due to its use.⁵³ Even though it is not analyzed as often as the mark's distinctiveness, the "use"⁵⁴ requirement of a trademark under the definition of trademark and Section 1 is also crucial. Essentially, a trademark must be used in a manner consistent with the general standards of trademark use.⁵⁵ The relationship between the mark and the associated goods or services is also a critical consideration.⁵⁶ It is also necessary to preserve and monitor a trademark's distinctiveness to prevent the loss of its identifying function and protective rights over time.⁵⁷ Finally, functional features that contribute to an article's utility are excluded from trademark protection to maintain competitive fairness so competitors can freely incorporate useful features into their products.⁵⁸

B. U.S. Registration System under the Lanham Act

Generally, trademark protection at the federal level operates on a "registration" basis, a system instituted by the Lanham Act.⁵⁹ However, registering a trademark under this system remains optional.⁶⁰ Protection under common law is afforded to a trademark once it has been used in genuine sales to the public or through other qualifying activities.⁶¹

While it is not mandatory to register a trademark federally under Section 43 of the Lanham Act or through state laws for protection, securing a place on the Principal Register offers considerable advantages.⁶² First, according to Sections 7(b) and 33(a), securing a registration on the Principal Register serves as prima facie proof of the trademark's validity and the registrant's ownership, granting them

⁵⁰ OCHOA ET AL., *supra* note 3, at 467.

⁵¹ LAFRANCE, *supra* note 8, at 17.

⁵² *Id.*

⁵³ SCHECHTER & THOMAS, *supra* note 42, at 53–55.

⁵⁴ Or "bona fide intention to use in commerce" under Section 45. Alexandra J. Roberts, *Trademark Failure to Function*, 104 IOWA L. REV. 1977, 1982 (2019).

⁵⁵ Roberts, *supra* note 54, at 1981.

⁵⁶ SCHECHTER & THOMAS, *supra* note 42, at 53.

⁵⁷ *Id.* at 55.

⁵⁸ LAFRANCE, *supra* note 8, at 18.

⁵⁹ Lee, *supra* note 36, at 958.

⁶⁰ *Id.*

⁶¹ SCHECHTER & THOMAS, *supra* note 42, at 30.

⁶² OCHOA ET AL., *supra* note 3, at 503.

exclusive rights to utilize the mark in commerce related to the registered goods or services.⁶³ This is subject to any specified conditions or limitations.⁶⁴

Second, Section 7(c) stipulates that, with certain exceptions, a successful application for registration on the Principal Register will be deemed constructive use of the mark.⁶⁵ This grants the applicant priority across the nation concerning the goods or services the mark is registered for, effective from the application's filing date.⁶⁶

Third, according to Section 22, a trademark registered on the Principal Register serves as constructive notice of the registrant's ownership, thereby granting the registrant priority over later users, including in regions where the mark has not been actively used by the registrant.⁶⁷ This arrangement also prevents a later user from claiming they adopted the mark in good faith, unaware of the existing registration.⁶⁸

Fourth, a trademark listed on the Principal Register for five years may achieve incontestable status, which protects the mark against many legal challenges.⁶⁹ Additionally, Section 42 of the Act enhances a trademark owner's capacity to prevent the importation of goods that infringe on the trademark.⁷⁰ This is because only marks that are federally registered can be recorded with the U.S. Customs Service.⁷¹ Once a trademark is recorded, U.S. Customs Service agents are empowered to seize infringing goods under 19 U.S.C. § 1526, thereby offering an effective tool against international trademark violations.⁷²

Finally, when pursuing an infringement lawsuit, the owner of a trademark registered on the Principal Register is entitled to a wider selection of legal remedies, as specified in Sections 34(d), 35(b), and 35(c), compared to the owner of an unregistered mark.⁷³ To obtain the above-mentioned benefits, federal trademark registration can be pursued on two primary grounds. The first option is a "use-based" application, with its criteria detailed in Section 1(a) of the Act.⁷⁴ Alternatively, an application can be lodged on the grounds of a "bona fide intent to

⁶³ 15 U.S.C. §§ 1057(b), 1115(a).

⁶⁴ OCHOA ET AL., *supra* note 3, at 503 (citing 15 U.S.C. § 1057(b), 1115(a); Coca-Cola Co. v. Overland, Inc., 692 F.2d 1250, 1254 (9th Cir. 1982)).

⁶⁵ 15 U.S.C. § 1057(c).

⁶⁶ 15 U.S.C. § 1057(c).

⁶⁷ OCHOA ET AL., *supra* note 3, at 504 (citing *Value House v. Phillips Mercantile Co.*, 523 F.2d 424, 429 (10th Cir. 1975); *Old Dutch Foods, Inc. v. Dan Dee Pretzel & Potato Chip Co.*, 477 F.2d 150, 156-57 (6th Cir. 1973); *John R. Thompson Co. v. Holloway*, 366 F.2d 108, 115 (5th Cir. 1966); *Dawn Donut Co. v. Hart's Food Stores, Inc.*, 267 F.2d 358, 362 (2d Cir. 1959)).

⁶⁸ OCHOA ET AL., *supra* note 3, at 504 (citing *Value House v. Phillips Mercantile Co.*, 523 F.2d 424, 429).

⁶⁹ 15 U.S.C. § 1065.

⁷⁰ *Id.* at § 1124.

⁷¹ Tristan Griffin, *Mark My Word: Trademark Your Band Name*, 15 Tex. Rev. Ent. & Sports L. 177, 180 (2014).

⁷² 19 U.S.C. § 1526.

⁷³ OCHOA ET AL., *supra* note 3, at 504.

⁷⁴ SCHECHTER & THOMAS, *supra* note 42, at 32.

use” the mark, as outlined in Section 1(b).⁷⁵ Additionally, for foreign applicants, another avenue for application is available under the Paris Convention.⁷⁶ If a foreign applicant already holds a trademark registration in their home country, this foreign registration can serve as a valid foundation for an application under the Lanham Act.⁷⁷

In the procedural aspect of trademark registration in the United States, the initial step is the submission of an application, where the applicant must delineate the basis for registration, such as actual use in commerce or intent to use.⁷⁸ This application includes, among other elements, a verified statement regarding the mark's use or intended use in connection with specified goods or services, accompanied by a “specimen” showing the mark as used in commerce.⁷⁹ The application is then examined by the USPTO examining attorney, who assesses the proposed mark against the statutory requirements (including both general requirements like distinctiveness and specific and absolute registration bars that will be analyzed below) and existing marks to ensure no likelihood of confusion or other bars to registration.⁸⁰

Upon approval of the trademark application by the USPTO examiner, the mark is published in the Official Gazette to allow the public an opportunity to oppose the registration.⁸¹ When an opposition arises, it is determined by the Trademark Trial and Appeal Board (TTAB), a specialized administrative tribunal.⁸² This inter partes review process allows both the applicant and the opposer to present arguments and evidence concerning the registrability of the mark.⁸³ If the decision from the TTAB is unfavorable to the applicant or the opposer, it can be appealed to the federal courts, offering another layer of scrutiny.⁸⁴ The initial term of trademark registration is ten years, with the possibility of renewal every ten years upon filing the required maintenance documents, ensuring continued protection.⁸⁵

C. Marks Ineligible for Trademark Registration

In the framework of U.S. trademark law, Section 2 of the Lanham Act lays out the foundational criteria for registering a mark on the USPTO's Principal

⁷⁵ SCHECHTER & THOMAS, *supra* note 42, at 32.

⁷⁶ *Id.* at 44–45.

⁷⁷ *Id.*

⁷⁸ MARK D. JANIS, TRADEMARK AND UNFAIR COMPETITION IN A NUTSHELL 142–43 (3d ed. 2021). For international registration under Madrid Protocol or Foreign Application with priority right under Paris Convention, *see id.* at 143.

⁷⁹ JANIS, *supra* note 78, at 143.

⁸⁰ *Trademark Process*, U.S. PATENT & TRADEMARK OFFICE (March 10, 2024, 8:25 PM), <https://www.uspto.gov/trademarks/basics/trademark-process#step1>.

⁸¹ *Trademark Process*, *supra* note 80.

⁸² 15 U.S.C. § 1067.

⁸³ *Id.* at § 1063.

⁸⁴ JANIS, *supra* note 78, at 150.

⁸⁵ *Id.* at 153–54.

Register.⁸⁶ This section effectively enumerates which marks shall not be eligible for registration, articulating a general principle that any trademark capable of differentiating the applicant's goods or services from those of others is registrable, provided it does not fall into the specifically outlined ineligible categories from Sections 2(a) to (e).⁸⁷

The general principle for distinctiveness and use also must align with the federal definition of a trademark or a service mark under Section 45, which defines a trademark as:

any word, name, symbol, or device, or any combination thereof—
 (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.⁸⁸

For a composite mark, the entirety of the mark will be considered by the USPTO for these analyses.⁸⁹ In addition to identifying and distinguishing requirements, as explained *infra*, use in commerce is within the scope of Congress's regulatory authority as outlined in the Commerce Clause.⁹⁰

Finally, Section 2(f) offers a route that differentiates between marks completely ineligible for registration and those that can surpass this initial hurdle by gaining secondary meaning.⁹¹ This aspect of the Act showcases its capacity to accommodate the changing nature of trademarks in the marketplace.⁹² The assessment under this section requires a case-by-case examination.⁹³ Nonetheless, it is crucial to acknowledge that this route or exemption does not apply to bars that will be analyzed below, which are categorized as “immoral,” “scandalous,” “disparaging,” or “[c]onsists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent.”⁹⁴

D. The Treatment of Immoral, Scandalous, and Disparaging Marks Pre-Tam and Brunetti

When first passed, Section 2(a) of the Lanham Act barred the registration of trademarks considered “immoral” or “scandalous,” as well as those that may

⁸⁶ LAFRANCE, *supra* note 8, at 80.

⁸⁷ JANIS, *supra* note 78, at 160–61.

⁸⁸ 15 U.S.C. § 1127.

⁸⁹ UNITED STATES PATENT AND TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) 1207.01(C)(II) (2017 ed.).

⁹⁰ LAFRANCE, *supra* note 8, at 81.

⁹¹ 15 U.S.C. § 1052(f).

⁹² SCHECHTER & THOMAS, *supra* note 42, at 73.

⁹³ *Id.* at 74.

⁹⁴ 15 U.S.C. § 1052(a)-(c).

“disparage” any person, institution, belief, or national symbols, “or bring them into contempt, or disrepute.” The TTAB regarded content that could bring persons “into contempt or disrepute” as equivalent to disparaging matter.⁹⁵ However, on June 19, 2017, the Supreme Court first held that the “disparage” mark provision of Section 2(a) discriminates based on the applicant’s viewpoint and struck it down as unconstitutional under the Free Speech Clause of the First Amendment in *Matal v. Tam*.⁹⁶ Two years after this decision, on June 24, 2019, the Supreme Court extended this reasoning to strike down the bar on “immoral” and “scandalous” marks in *Iancu v. Brunetti*, citing similar grounds of viewpoint discrimination and unconstitutionality under the Free Speech Clause.⁹⁷

These sections of the Lanham Act were seldom used in the 50 years following its enactment.⁹⁸ While businesses typically aim to avoid displeasing their customers, aligning with public sentiment and avoiding marks that may be deemed immoral, scandalous, or disparaging, there are instances where applicants seek to safeguard provocative marks.⁹⁹ These applicants may believe that such marks might grab attention, appeal to unconventional audiences, or attract consumers who identify as rebels, despite the potential risks of public disapproval.¹⁰⁰ Also, even though most businesses aim to avoid these marks, they may bring these applications when they are operating internationally in different countries with diverse cultures and regulatory frameworks.¹⁰¹ However, companies may seek to find marks that are more likely to be registered across jurisdictions, at least in major markets, with positive meaning given to the goods or services.

1. Immoral or Scandalous Marks

The prohibition against registering trademarks that are deemed immoral or scandalous dates back to the Trademark Act of 1905 and was carried forward into the Lanham Act of 1946 under Section 2(a).¹⁰² The legislative history of the intent behind this prohibition is not clear, leading to interpretations based primarily on the “ordinary and common meaning” of the terms.¹⁰³

⁹⁵ JANIS, *supra* note 78, at 162; LAFRANCE, *supra* note 8, at 90.

⁹⁶ *Tam*, 582 U.S. at 243, 247.

⁹⁷ *Iancu*, 588 U.S. at 390, 398–99.

⁹⁸ SCHECHTER & THOMAS, *supra* note 42, at 92.

⁹⁹ Enrico Bonadio, *Brands, Morality and Public Policy: Some Reflections on The Ban on Registration of Controversial Trademarks*, 19 MARQ. INTELL. PROP. L. REV. 39, 49–50 (2015).

¹⁰⁰ *Id.* at 39, 50. (“In other words, the fact that a brand is offensive may be seen by some consumers as a positive aspect of the whole commercial offer and constitute a driver of purchasing behaviours.”); SCHECHTER & THOMAS, *supra* note 42, at 92.

¹⁰¹ See Fandiño, *supra* note 6, at 453.

¹⁰² U.S. PAT. & TRADEMARK OFF., *supra* note 89, at §1203.01.

¹⁰³ *Id.* (citing *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938)).

The USPTO treats this prohibition as a single, “unitary provision” rather than interpreting the two adjectives within it independently.¹⁰⁴ In assessing a mark’s eligibility for this category, the USPTO evaluates if a “substantial composite of the general public” perceives the mark as “shocking to the sense of truth, decency, or propriety;” “giving offense to the conscience or moral feelings;” “calling out for condemnation;” “disgraceful;” “offensive;” “disreputable;” or “vulgar.”¹⁰⁵ For example, *In re Wilcher Corp.* affirmed the refusal to register the logo of a man with a penis for a nose and “Dick Heads” words under it for the restaurants and bars, concluding that the mark’s vulgar implications were offensive to a substantial segment of the general public and thus fell within the Lanham Act’s prohibition against scandalous material.¹⁰⁶ The USPTO has also denied registration for marks that suggest endorsement of drug use, such as MARIJUANA COLA and KO KANE, as well as trademarks that link religious symbols to products, like AGNUS DEI for safes and MADONNA for wine, on the grounds that they could offend the majority of individuals practicing the Christian faith.¹⁰⁷ Additionally, trademarks perceived as showing support for terrorist groups, exemplified by BABY AL QAEDA and AL-QAEDA on t-shirts, have been rejected.¹⁰⁸

To show evidence that the mark would be offensive to a “substantial composite of the general public,” the examiner was able to use a variety of evidence, including dictionary definitions, newspaper articles, and magazine articles.¹⁰⁹

The determination of whether a mark is scandalous was made in the context of the relevant marketplace for the goods or services identified in the application.¹¹⁰ Additionally, the meaning of the mark was assessed based on the prevailing societal attitudes at the time of evaluation.¹¹¹

The word “comprises” in the provision means “include,” and Congress intended to prohibit not only marks that consist of scandalous matter but also marks that include scandalous matter.¹¹² However, the Act’s jurisdiction does not cover goods that might be considered scandalous.¹¹³

With respect to its intersection with the First Amendment, the decision of the U.S. Court of Customs and Patent Appeals in *In re McGinley* was the landmark case for analysis of “immoral” and “scandalous” regarding a mark’s constitutionality until *Brunetti*.¹¹⁴ In the case of *In re McGinley*, the U.S. Court of

¹⁰⁴ *Iancu*, 588 U.S. at 391 (quoting *In re Brunetti*, 877 F.3d 1330, 1336 (C.A. Fed. 2017)).

¹⁰⁵ *Iancu*, 588 U.S. at 391.

¹⁰⁶ *In re Wilcher Corp.*, 40 U.S.P.Q.2d 1929, 1933–34 (T.T.A.B. 1996).

¹⁰⁷ *Iancu*, 588 U.S. at 395–96.

¹⁰⁸ *Id.* at 396.

¹⁰⁹ See U.S. PAT. & TRADEMARK OFF., *supra* note 89, §1203.01.

¹¹⁰ See *id.* (citing *In re Fox*, 702 F.3d 633, 638 (Fed. Cir. 2012)).

¹¹¹ See *id.* (citing *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367 (Fed. Cir. 1994)).

¹¹² See U.S. PAT. & TRADEMARK OFF., *supra* note 89, §1203.0 (citing *Fox*, 702 F.3d at 638).

¹¹³ See *In re Madsen*, 180 U.S.P.Q. 334, 335 (T.T.A.B. 1973) (explaining the TTAB’s clarification that the authority to refuse registration for scandalous marks under section 2(a) of the Act does not extend to the judgment of the goods themselves, exemplified by allowing the registration of “WEEK-END SEX” for a magazine, without delving into the potentially pornographic nature of its content).

¹¹⁴ See *In re McGinley*, 660 F.2d 481, 482 (C.C.P.A. 1981).

Customs and Patent Appeals addressed the refusal to register a trademark for a newsletter featuring a photograph of a nude man and woman, deemed immoral and scandalous under section 2(a) of the Lanham Act.¹¹⁵ The court upheld the refusal, emphasizing that the prohibition against registering scandalous marks did not infringe upon the applicant's First Amendment rights since it neither prohibited the mark's use nor suppressed any form of expression.¹¹⁶ Rather, it simply denied the benefits of federal registration.¹¹⁷ The decision articulated that the term "scandalous" had a sufficiently precise common meaning, including material that is shocking or offensive to public decency and morals.¹¹⁸ Importantly, the court highlighted that the Lanham Act's intent was not to legislate morality but to prevent the federal government from spending resources on trademarks that are contrary to public standards of decency.¹¹⁹ Thus, denying registration for content deemed immoral or scandalous has been determined not to violate First Amendment protections.¹²⁰

2. Disparaging Marks

Disparagement is a separate and distinct ground for refusing or canceling a mark under section 2(a) of the Lanham Act.¹²¹ While the congressional intent behind this provision is not explicitly clear, the U.S. Court of Appeals for the Federal Circuit in *The University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co., Inc.*¹²² interpreted it as aiming to shield the names of entities or individuals beyond the conventional scope of "trademarks" or "trade names" outlined in section 2(d).¹²³ This interpretation suggests an early effort to incorporate privacy rights protections into trademark law. The court underscored that the violation of privacy or publicity rights could stand independently of any confusion regarding product endorsement or origin, highlighting a distinctive aspect of privacy protection within this legal framework.¹²⁴

This provision became much more visible to the trademark community and general public in the early 1990s when a group of Native Americans sought to cancel the mark R*****S, which was then in use by the Washington D.C. National Football League franchise.¹²⁵ Although this mark was challenged and canceled

¹¹⁵ *McGinley*, 660 F.2d 481, at 482.

¹¹⁶ *Id.* at 484.

¹¹⁷ *See id.* at 486–87.

¹¹⁸ *Id.* at 485–86.

¹¹⁹ *McGinley*, 660 F.2d 481, at 486.

¹²⁰ *Id.* at 482, 484.

¹²¹ *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1737 (T.T.A.B. 1999).

¹²² *Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372 (1983).

¹²³ *Id.* at 1375.

¹²⁴ *Id.* at 1376.

¹²⁵ GRAEME B. DINWOODIE & MARK D. JANIS, *TRADEMARKS AND UNFAIR COMPETITION: LAW AND POLICY* 378, 756 (5th ed. 2018).

multiple times, it is still a registered and live¹²⁶ trademark and was used by the R*****S team until 2020.¹²⁷

To grasp the operational dynamics of the bar against “disparaging” marks, it is essential to examine two pivotal cases concerning the R*****S trademark. These cases are also important for understanding the unconstitutionality-related history of the provision before the *Tam* and *Brunetti* cases. The initial case, *Pro Football, Inc. v. Harjo*,¹²⁸ involves an application by seven Native Americans for the cancellation of six registered R*****S trademarks, citing them as “disparaging” and “scandalous.”¹²⁹ In 1998, the Board decided to cancel the marks on the grounds they were potentially disparaging to Native Americans, leading to potential contempt or disrepute.¹³⁰ While dismissing allegations that the marks were “scandalous,” the TTAB’s decision was informed by thoroughly examining the plain and historical meanings of “disparage” among other terms in the regulation.¹³¹ This examination included consulting dictionaries such as Webster’s and Oxford; seeking insights from experts in linguistics, society, and history; conducting surveys to gauge public perception; and noting that the regulation’s use of “may” suggests that a perception of disparagement suffices without a need for proven specific intent.¹³²

Pro Football, Inc. (PFI) also brought the constitutionality of Section 2(a) in front of the TTAB by contending that canceling their trademark registrations would infringe upon their First Amendment rights, asserting that the terms “scandalous” and “disparage” were unconstitutionally overbroad and vague, leading to violations of their First Amendment rights.¹³³ They also argued that favoring the petitioners would result in viewpoint discrimination in violation of the First Amendment.¹³⁴ Despite these claims, the Board reaffirmed its decision to strike the defenses, emphasizing its inability to address constitutional questions about section 2(a).¹³⁵ It dismissed the respondent’s arguments as either encompassed by previously struck defenses or unpersuasive, reiterating its lack of jurisdiction over constitutional validity issues.¹³⁶

¹²⁶ R*****S, Registration No. 1085092.

¹²⁷ The R*****s team later changed its name following significant controversy over its branding. For decades, the name was a point of contention. In 2020, amid heightened awareness of the Native American mascot controversy and following the George Floyd protests, pressure from NFL and team sponsors led to the retirement of the R*****s name. The team operated as the Washington Football Team for two seasons before adopting its new name, the Commanders, in 2022. *Washington Commanders*, WIKIPEDIA, https://en.wikipedia.org/wiki/washington_commanders (last updated Oct. 9, 2024, 5:46 PM).

¹²⁸ *Harjo*, 565 F.3d at 880.

¹²⁹ *Id.* at 882.

¹³⁰ *Pro-Football, Inc.*, 50 U.S.P.Q.2d at 1735, 1743, 1748.

¹³¹ *Id.* at 1737–38.

¹³² *Id.* at 1738.

¹³³ *Id.* at 1710.

¹³⁴ *Id.*

¹³⁵ *Pro-Football, Inc.*, 50 U.S.P.Q.2d at 1710.

¹³⁶ *Id.*

In the TTAB decision challenged by PFI, the district court found that laches precluded the disparagement claim because the youngest plaintiff delayed for seven years and nine months since reaching his majority before suing.¹³⁷ In its assessment of evidence of prejudice, the U.S. Court of Appeals for the District of Columbia saw no error in applying laches to the facts at issue and affirmed the decision.¹³⁸ Thus, its analysis was limited to the laches issue.¹³⁹

Even though the court did not analyze the “disparagement” issue in the *Harjo* case and instead rejected it because of the doctrine of laches, R*****S was challenged again in *Pro-Football, Inc. v. Blackhorse*.¹⁴⁰ In this case, the TTAB canceled six of PFI’s R*****S marks on the grounds that “they consisted of matter that ‘may disparage’ Native Americans and bring them into contempt or disrepute, and that the defense of laches does not bar the claims.”¹⁴¹ This decision was approved by the U.S. District Court for the Eastern District of Virginia¹⁴² and appealed by the PFI.¹⁴³ However, while it was on appeal at the U.S. Court of Appeals for the Fourth Circuit, the Supreme Court in *Matal v. Tam*¹⁴⁴ determined that section 1052(a) violates the Free Speech clause of the First Amendment, and therefore, the court vacated and remanded the case.¹⁴⁵ As such, the R*****S trademark still lives and is registered, though it is not in use, as explained above.¹⁴⁶

Although the U.S. District Court for the Eastern District of Virginia decision was remanded, a brief look at its holdings is valuable to understand the road leading to *Tam* and *Brunetti*. In that case, PFI challenged the TTAB decision on the following arguments:

- (1) Section 2(a) of the Lanham Act violates the First Amendment by restricting protected speech, imposing burdens on trademark holders, and conditioning access to federal benefits on restrictions of trademark owners' speech;
- (2) Section 2(a) of the Lanham Act is unconstitutionally vague in violation of the Fifth Amendment because it does not provide notice as to which marks ‘may disparage,’ it authorizes arbitrary and discriminatory enforcement, and it is impermissibly vague as-applied to PFI. . .
- (3) the TTAB Order violates the Due Process and Takings Clauses of the Fifth Amendment because it deprives PFI of its property

¹³⁷ *Harjo*, 565 F.3d at 881.

¹³⁸ *Id.*

¹³⁹ *Id.* at 882–86.

¹⁴⁰ *Blackhorse*, 112 F. Supp. 3d at 447, 454.

¹⁴¹ *Blackhorse*, 112 F. Supp. 3d at 447.

¹⁴² *Id.* at 448, 490.

¹⁴³ *Pro-Football, Inc. v. Blackhorse*, 709 F. App’x 182, 183 (4th Cir. 2018).

¹⁴⁴ *Tam*, 582 U.S. at 247.

¹⁴⁵ *Blackhorse*, 709 F. App’x at 183.

¹⁴⁶ The team later changed its name following significant controversy. For decades, the name was a point of contention. In 2020, pressure from the NFL and team sponsors led to the retirement of the R*****s name after the George Floyd protests. The team operated as the Washington Football Team for two seasons before adopting the new name, the Commanders, in 2022. *Washington Commanders*, *supra* note 127.

without due process and constitutes an unconstitutional taking of PFI's property;"¹⁴⁷ (4) "the record does not establish by a preponderance of the evidence that a substantial composite of Native Americans believe that the R[*****S] Marks consisted of matter that 'may disparage' them at the time of their registrations (1967, 1974, 1978, and 1990);" and (5) "the defense of laches bars Blackhorse Defendants' claims."¹⁴⁸

The first three arguments are based on unconstitutionality issues, and the other two are based on factual issues.

For constitutionality issues, the court denied the first argument with two reasons: "[f]irst, Section 2(a) of the Lanham Act does not implicate the First Amendment[, and second], the federal trademark registration program is government speech and is therefore exempt from First Amendment scrutiny."¹⁴⁹

The second and third arguments were also rejected for the following reasons:

First, Section 2(a) of the Lanham Act is not void for vagueness because (1) PFI cannot show that Section 2(a) is unconstitutional in all of its applications; (2) Section 2(a) gives fair warning of what conduct is prohibited; (3) Section 2(a) does not authorize or encourage 'arbitrary and discriminatory enforcement'; and (4) Section 2(a) is not impermissibly vague as applied to PFI, [and second], the Takings Clause and Due Process Clause claims fail because a trademark registration is not considered property under the Fifth Amendment.¹⁵⁰

Concerning the fourth argument, it was denied "because the (1) dictionary evidence; (2) literary, scholarly, and media references; and (3) statements of individuals and groups in the referenced group show that the R[*****S] Marks consisted of matter that 'may disparage' a substantial composite of Native Americans during the relevant time period."¹⁵¹ The court also ruled that a "substantial composite" is not necessarily a majority¹⁵² and, in assessing if a mark could be disparaging, the court considers the mark through the perspective of a "referenced group, as opposed to the general public in section 2(a) 'scandalous' actions."¹⁵³ Different from *Harjo*, in this case, the TTAB and the court have underlined the "Native American Objection to Use [] the Word R[*****S] for Football Teams."¹⁵⁴

¹⁴⁷ *Blackhorse*, 112 F. Supp. 3d at 447.

¹⁴⁸ *Id.* at 447.

¹⁴⁹ *Id.* at 454.

¹⁵⁰ *Id.* at 448.

¹⁵¹ *Id.* at 453.

¹⁵² *Blackhorse*, 112 F. Supp. 3d at 484.

¹⁵³ *Id.* at 488.

¹⁵⁴ *Id.* at 468.

Finally, the laches argument was denied because “Blackhorse Defendants did not unreasonably delay in petitioning the TTAB[, and] laches does not apply because of the public interest at stake.”¹⁵⁵

E. Tam, Brunetti, Other Recent Trademark First Amendment Decisions, and Empirical Research Concerning Tam and Brunetti

This section reviews and analyzes the recent U.S. Supreme Court cases of *Matal v. Tam* and *Iancu v. Brunetti* concerning the intersection of the First Amendment Free Speech Clause and trademark law. Those cases have sparked a revolution in the approach to trademark registration and protection by removing the long-standing bars to federal registration: disparaging, scandalous, and immoral marks. This section also briefly reviews two other recent Supreme Court trademark cases discussing First Amendment free speech interests: *Jack Daniel’s Properties v. VIP Products* and *Vidal v. Elster*. This section then provides a review of the literature concerning the *Matal v. Tam* and *Iancu v. Brunetti* cases, including empirical work about their impact.¹⁵⁶

In the United States, trademarks have evolved to provide an indication of origin and include expressive messages and values implicating free speech interests.¹⁵⁷ This evolution consists of the rights of people and entities acquiring and using marks as trademark holders and users, competitors, and consumers who may use those marks for expressive purposes. At the same time, the meaning of marks themselves is “directed” in a complex relationship between the holder of the mark and their audience.¹⁵⁸ Since trademark law and protection are tethered to the anchor

¹⁵⁵ *Blackhorse*, 112 F. Supp. 3d at 468.

¹⁵⁶ Other doctrines may be used to police disparaging and scandalous marks. See Loza, *supra* note 34, at 35 (noting other grounds to bar registration, including failure to function, “merely ornamental,” and “widely-used commonplace expressions”).

¹⁵⁷ See, e.g., Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1688 (1999); Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 YALE L.J. 1717 (1999); Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960 (1993); Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397 (1990); Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158 (1982). As recognized by Justice Alito in the *Matal v. Tam* opinion, “as this case illustrates, trademarks often have an expressive content. Companies spend huge amounts to create and publicize trademarks that convey a message. It is true that the necessary brevity of trademarks limits what they can say. But powerful messages can sometimes be conveyed in just a few words.” 582 U.S. at 239.

¹⁵⁸ See also Jessica M. Kiser, *Brandright*, 70 ARK. L. REV. 489, 551 (2017) (“Failing to recognize the contribution of consumers to brands, and the incorporation of branding into social and cultural discourse, ignores the collaborative nature of this process.”).

of consumer perception, that perception is influenced by the trademark holder¹⁵⁹ as well as the audience of users, competitors, and consumers. Trademark law doctrine and policy have sought to find some form of balance between these interests through doctrinal adjustment through the application of doctrines such as the likelihood of confusion and modifications to approaches to liability, including the creation of defenses to trademark infringement and dilution.¹⁶⁰ A newer approach to finding this balance is through a view of the use as a trademark requirement to include failure to function as a basis for rejecting trademark registration. However, failure to function and related denials of registration based on ornamentation or informational matter is still subject to consumer perception. Importantly, consumers may recognize that source indication and other messages can be conveyed through a valid mark.¹⁶¹ Recently, Professor Deborah Gerhardt provided another approach that refocuses trademark doctrine on a consumer investment approach instead of a principally law and economics approach to trademark law.¹⁶²

In a series of cases concerning trademarks and the First Amendment Free Speech Clause, the U.S. Supreme Court has confronted the intersection of trademark law and expressive values. One view of these cases is that arguably, the U.S. Supreme Court has expanded the reach of the Free Speech Clause by limiting the government's ability to curtail speech in the context of trademark rights¹⁶³ while at the same time expanding the rights of trademark holders to limit speech through expanding trademark rights in cases where the source-indicating nature of

¹⁵⁹ See Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1916 (2007) (“Consumer expectations now carry all the weight for those who hope to limit trademark protection, and those expectations have proven almost infinitely pliable. Producers are able to frame just about any argument for broader protection in terms of consumer expectations, which they are in position to influence systematically through marketing.”).

¹⁶⁰ However, there are limitations to those doctrines' ability to protect First Amendment interests. See Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 SMU L. REV. 381, 384–85 (2008) (“Protected expression is frequently suppressed or chilled by trademark law because the law's current built-in First Amendment safeguards, such as the descriptive fair use doctrine, are limited and involve fact-specific determinations that often can only be resolved after discovery at summary judgment or trial—a cost many defendants cannot afford.”).

¹⁶¹ See Dustin Marlan, *Is the Word “Consumer” Biasing Trademark Law?*, 8 TEX. A&M L. REV. 367, 370 (2021) (“Much criticism has been rightly levied against trademark law's treatment of the *consumer* as a purely economic creature—passive, ignorant, and gullible.”).

¹⁶² Deborah R. Gerhardt, *The Last Breakfast with Aunt Jemima and Its Impact on Trademark Theory*, 45 COLUM. J.L. & ARTS 231, 231–32 (2022).

¹⁶³ See Xuan-Thao Nguyen, *Trademarks and Censorship in the Time of Covid-19*, 40 CARDOZO ARTS & ENT. L.J. 687, 717 (2023) (“The decisions, *Iancu v. Brunetti* and *Matal v. Tam*, respectively decided in 2019 and 2017, widely opened the floodgate for all trademarks, including opportunistic trademarks related to the COVID-19 pandemic, to be filed with the USPTO.”).

trademarks is implicated.¹⁶⁴ While these two actions may appear contradictory, the U.S. Supreme Court appears to assert principles of limited government and strong property rights. This is accomplished through constitutional limits on government action by making the federal benefits of trademark registration available to more potential marks and the reliance on the market¹⁶⁵ and property rights to ultimately address issues concerning free speech and protecting established private property rights. In a sense and with respect to the disparagement and scandalous marks bar, the government has been removed as the chooser of winners and losers of federal registration.¹⁶⁶ However, the U.S. Supreme Court is in the midst of finding this balance of free speech and intellectual property rights. For example, the question of whether other areas of trademark law, such as the prohibition of certain types of

¹⁶⁴ In *Vidal v. Elster*, 602 U.S. 286, the U.S. Supreme Court recently upheld the names bar as constitutional under the First Amendment Free Speech Clause primarily because it is viewpoint-neutral and because of the long common law history and tradition of the names bar. The *Jack Daniels* case is an example of a broadening of trademark rights even when potential expressive free speech interests are at play. The *United States Patent and Trademark Office v. Booking.com* case is a recent example of the U.S. Supreme Court's recognition of relatively broad access to and scope of trademark rights. *United States Pat. & Trademark Off. v. Booking.com B.V.*, 591 U.S. 549 (2020).

¹⁶⁵ See Devon Sanders, *Misbehaved Marks: Exploring the Implications of Iancu v. Brunetti*, 2020 B.C. INTELL. PROP. & TECH. F. 1, 12 (2020) (consumers may choose not to purchase offensively marked items and sellers may choose not to sell them); Jake Mackay, *Racist Trademarks and Consumer Activism: How the Market Takes Care of Business*, 42 L. & PSYCHOL. REV. 131, 147 (2017-2018) ("Any issues of indecency or harm that arise from negative, derogatory trademarks or other hate speech will be solved by consumers in a free marketplace, who will make decisions not to purchase goods that are unacceptable. When consumers support only those companies with acceptable trademarks, the companies that decide to use derogatory marks will be forced out of the marketplace."); Professor Jon J. Lee argues that trademark law itself makes it difficult to rid themselves of racist trademarks. See Lee, *supra* note 36, at 986 ("[B]ased on the current state of the law, they cannot completely sever their connections with their ignominious marks without risking that the marks will show up again—but this time, wielded by another entity. This circumstance[] has incentivized them to use the mark in a more limited fashion or cling on to vestiges in the hope that these strategic uses will be enough to retain their rights.").

¹⁶⁶ Cf. Jennifer M. Hetu & Julie E. Reitz, *Disparaging, Immoral, and Scandalous Trademarks: Just Because You Can, Doesn't Mean You Should*, MICH. BAR J. 22, 24 (2021) (providing a list of voluntarily changed marks by mark holders, some of which were federally registered, including "Lady Antebellum," "Dixie Chicks," "Dixie Beer," "Eskimo Pie," "Geechie Boy Mill," "Spic and Span," "Uncle Ben's," "Aunt Jemima," "Mutual of Omaha's Native American imagery," and "Land O' Lakes Native American woman image"); Loza, *supra* note 34, at 35 (noting that some practitioners have policies against filing disparaging marks and scandalous marks); Mark Conrad, *Matal v. Tam — A Victory for the Slants, A Touchdown for the Redskins, But an Ambiguous Journey for the First Amendment and Trademark Law*, 36 CARDOZO ARTS & ENT. L.J. 83, 147 (2018) ("[T]he court of public opinion could limit the potential downside of this ruling for Native Americans seeking to change the names of teams and mascots that refer to them. U.S. marketing history bears the legacy of racially or ethnically insensitive names and symbols, but at least there may be hope that we will not return to those days.").

tarnishment,¹⁶⁷ may violate the free speech clause remains even with statutory protections for some forms of expression.¹⁶⁸ As Professor Alfred Yen has emphasized, the U.S. Supreme Court may address questions raised under free speech jurisprudence and intellectual property rights in a more direct manner in the future.¹⁶⁹

1. Tam, Brunetti, and Two Cases Involving the First Amendment and Trademarks

This section will examine the *Matal v. Tam* and *Iancu v. Brunetti* cases in detail and provide a more limited review of *Jack Daniels* and the June 13, 2024 decision of *Vidal v. Elster*. In *Matal v. Tam*, Simon Tam applied for federal registration for the mark “The Slants” for a musical band.¹⁷⁰ The meaning of the term “The Slants” is derogatory for Asians.¹⁷¹ Mr. Tam, an Asian American, stated that he is attempting to reappropriate the term on behalf of Asian Americans to remove its derogatory force.¹⁷² The U.S. Patent and Trademark Office refused registration of the mark because it disparages “persons, living or dead.”¹⁷³ The Supreme Court, in a 2017 plurality opinion, affirmed the U.S. Court of Appeals for the Federal Circuit judgment and decided that the disparagement clause of the Lanham Act was impermissible viewpoint discrimination and thus unconstitutional under the First Amendment.¹⁷⁴ Justice Alito tersely stated, “It offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend.”¹⁷⁵

¹⁶⁷ FEDERAL TRADEMARK DILUTION ACT OF 1995, Pub. L. No. 104-98, 109 Stat. 985 (codified as amended at 15 U.S.C. § 1125(c) (2006)).

¹⁶⁸ See, e.g., Annick Runyon, *Obtaining Trademark Registration for Marks Containing Political Commentary: A Look Into Vidal v. Elster*, 78 U. MIAMI L. REV. 1158, 1186 (2024) (“[T]he First Amendment argument could challenge the dilution doctrine next.”); Ryder Hogan, *Examining the Unconstitutionality of Dilution by Tarnishment After Tam*, 27 AM. U. J. GENDER SOC. POL’Y & L. 465 (2019) (arguing dilution by tarnishment is unconstitutional); Lisa P. Ramsey, *Free Speech Challenges to Trademark Law after Matal v. Tam*, 56 HOUS. L. REV. 401, 408 (2018) (“[After Tam, t]his constitutional analysis will be fatal, as the dilution laws cannot even survive the Court’s intermediate scrutiny test for regulations of nonmisleading commercial speech set for in *Central Hudson*.”).

¹⁶⁹ Alfred C. Yen, *Choosing the Consequences of Tam and Brunetti*, 19 CHI.-KENT J. INTELL. PROP. 396 (2020).

¹⁷⁰ *Tam*, 582 U.S. at 223. For a discussion of Mr. Tam’s perspective, see Simon Tam, *First Amendment, Trademarks, and “The Slants”: Our Journey to the Supreme Court*, 12 BUFF. INTELL. PROP. L.J. 1, 1 (2018) (“Whether it is trademark law or protests, the price of any abridgement of free speech is paid for by the backs of the underprivileged.”).

¹⁷¹ *Id.*

¹⁷² *Id.*

¹⁷³ *Id.*

¹⁷⁴ Justice Gorsuch did not participate in the decision. *Id.* at 247.

¹⁷⁵ *Tam*, 582 U.S. at 223.

In the opinion of the Court, Justice Alito provided an overview of the history and purposes of trademark law and a description of the procedural history of the case.¹⁷⁶ In particular, he recognized that the law affords trademark protection whether or not there is federal registration, but that federal registration does provide important benefits.¹⁷⁷ However, he noted that trademarks may not be federally registered if those marks violate a bar to registration.¹⁷⁸ One of those bars includes the disparagement clause, which denies registration to marks with a meaning that is disparaging to a “substantial composite of the referenced group.”¹⁷⁹ Notably, “the [US]PTO has specified that ‘[t]he fact that an applicant may be a member of that group or has good intentions underlying the use of a term does not obviate the fact that a substantial composite of the referenced group would find the term objectionable.’”¹⁸⁰ In denying registration for the applied-for mark, the USPTO examiner pointed to evidence, including dictionary definitions that referenced the term as derogatory and that “‘the band’s name has been found offensive numerous times’—citing a performance that was canceled because of the band’s moniker and the fact that ‘several bloggers and commenters to articles on the band have indicated that they find the term and the applied-for mark offensive.’”¹⁸¹ On appeal, the *en banc* U.S. Court of Appeals for the Federal Circuit determined that the disparagement prohibition is a content-based regulation of speech and viewpoint discrimination by the government.¹⁸² The Federal Circuit noted that the clause would fail intermediate scrutiny if the disparagement clause were considered regulating commercial speech and that registered trademarks are not government speech and federal registration is not a government subsidy.¹⁸³

Justice Alito then addressed three arguments by the government that would have likely resulted in a finding that the disparagement provision is constitutional: “(1) that trademarks are government speech, not private speech, (2) that trademarks are a form of government subsidy, and (3) that the constitutionality of the disparagement clause should be tested under a new ‘government-program’ doctrine.”¹⁸⁴ Importantly, Justice Alito’s opinion concerning trademarks as government speech is the opinion of the court; however, the remaining portion of the opinion that addressed the next two arguments did not have the support of a majority of the Court.¹⁸⁵ Additionally, the final portion of Justice Alito’s opinion

¹⁷⁶ *Tam*, 582 U.S. at 228–30.

¹⁷⁷ *Id.* at 226–27.

¹⁷⁸ *Id.* at 227.

¹⁷⁹ *Id.* at 227–28.

¹⁸⁰ *Id.*

¹⁸¹ *Tam*, 582 U.S. at 228–29.

¹⁸² *Id.* at 229.

¹⁸³ *Id.*

¹⁸⁴ *Id.* at 233–34 (stating Justice Alito also rejected Simon Tam’s argument that the disparagement clause does not apply to racial groups because the statute uses the term “persons.”).

¹⁸⁵ *Id.* at 229.

finding the disparagement clause unconstitutional was also not supported by a majority of the Court.¹⁸⁶

Justice Alito, writing for the Court, found that the regulation of trademarks is not government speech and thus is subject to First Amendment speech protection. Government speech is not subjected to First Amendment speech protection because the government would be unable to function if constrained to “viewpoint-neutrality,” such as in the case of promoting an effort to recruit soldiers for a government-sanctioned war.¹⁸⁷ Justice Alito further noted the danger of recognizing government approval of private speech as government speech because “the government could silence or muffle the expression of disfavored viewpoints.”¹⁸⁸ In the context of trademark regulation, with the exception of 1052(a), the registration of trademarks does not consider the content or viewpoint of the mark it may express.¹⁸⁹ Moreover, the government is not creating or modifying the marks themselves.¹⁹⁰ Justice Alito noted: “[I]t is far-fetched to suggest that the content of a registered mark is government speech. If the federal registration of a trademark makes the mark government speech, the [f]ederal [g]overnment is babbling prodigiously and incoherently. It is saying many unseemly things.”¹⁹¹ The opinion distinguished prior cases holding there was government speech by pointing, in part, to history and the expectations of the public concerning whether government speech was present.¹⁹² Specifically, the Court distinguished the *Walker* decision involving specialty automobile license plate messaging because three important facts present in that case were absent in the present matter:

First, license plates have long been used by the States to convey state messages. . . . Second, license plates ‘are often closely identified in the public mind’ with the state, since they are manufactured and owned by the State, generally designed by the State, and serve as a form of ‘government ID.’ . . . Third, Texas ‘maintain[ed] direct control over the messages conveyed on its specialty plates.’¹⁹³

Finally, Justice Alito recognized that expanding the government speech doctrine to encompass the facts of the present case would jeopardize other federal registration systems, such as copyright registration.¹⁹⁴

In a part of his opinion not joined by a majority of members of the Court, Justice Alito rejected the next two arguments in favor of the constitutionality of the disparagement clause. First, Justice Alito rejected the application of cases “in which

¹⁸⁶ Those sections of Justice Alito’s opinion were joined by Chief Justice Roberts, Justice Thomas and Justice Breyer. *Tam*, 582 U.S. at 222.

¹⁸⁷ *Id.* at 234.

¹⁸⁸ *Id.* at 235.

¹⁸⁹ *Id.*

¹⁹⁰ *Id.* at 235.

¹⁹¹ *Tam*, 582 U.S. at 236.

¹⁹² *Id.* at 237–38.

¹⁹³ *Id.* at 238.

¹⁹⁴ *Id.* at 239.

this Court has upheld the constitutionality of government programs that subsidized speech expressing a particular viewpoint” as controlling in the present matter.¹⁹⁵ Justice Alito distinguished those cases because the trademark registration system does not provide “cash subsidies or their equivalent”; indeed, trademark registrants pay to have their trademark registered and maintained.¹⁹⁶ Second, Justice Alito rejected the idea that this case is analogous to cases involving state laws requiring public employers to have union dues removed from employee salaries for some purposes but not others.¹⁹⁷ Interestingly, Justice Alito pointed to cases wherein “a unit of government creates a ‘limited public forum for private speech’” and noted that “some content- and speaker-based restrictions may be allowed.”¹⁹⁸ However, he also noted that viewpoint discrimination was never allowed in those cases, and this was a case concerning viewpoint discrimination.¹⁹⁹

Finally, Justice Alito decided the question of whether trademarks are commercial speech or not.²⁰⁰ If trademarks are commercial speech, then the government regulation of those marks is subject to a more deferential standard of review under the *Central Hudson* decision.²⁰¹ Justice Alito did not resolve the question because the deferential standard of review was not met under the facts of this case. While the speech restriction may have been subject to a “substantial interest,” it was not “narrowly drawn.”²⁰² Even assuming that the proffered government interests were substantial, Justice Alito asserted that the disparagement clause is not narrowly tailored to serve those interests: first, “preventing ‘underrepresented groups’ from being bombarded with demeaning messages in commercial advertising”; and second, “protecting the orderly flow of commerce” by prohibiting “trademarks that ‘involv[e] disparagement of race, gender, ethnicity, national origin, religion, sexual orientation, and similar demographic classification,’” which are similar to racial discriminatory conduct.²⁰³ Here, the disparagement clause “reaches any trademark that disparages *any person, group, or institution*” and protects “every person living or dead as well as every institution.”²⁰⁴

¹⁹⁵ *Tam*, 582 U.S. at 239–40.

¹⁹⁶ *Id.* at 240–41.

¹⁹⁷ *Id.* at 242–43.

¹⁹⁸ *Id.* at 220.

¹⁹⁹ *Id.*

²⁰⁰ *Tam*, 582 U.S. at 219–20.

²⁰¹ *Id.* at 220.

²⁰² *Id.* at 220.

²⁰³ *Id.* at 245–46. Justice Alito also appears to question whether these interests would qualify as substantial government interests under *Central Hudson*. For example, he noted, “Speech that demeans on the basis of race, ethnicity, gender, religion, age, disability, or any other similar ground is hateful; but the proudest boast of our free speech jurisprudence is that we protect the freedom to express ‘the thought that we hate.’” However, the argument is that these are not just thoughts that are hated; these are expressions that directly harm historically oppressed people who are also protected under the U.S. Constitution. *Id.* at 246.

²⁰⁴ *Tam*, 582 U.S. at 246. Justice Alito ended his opinion with the following statement: “There is a deeper problem with the argument that commercial speech may be cleansed of any expression likely to cause offense. The commercial market is well stocked with

Justice Kennedy wrote a separate opinion concurring in part and in the judgment joined by Justices Ginsburg, Sotomayor, and Kagan.²⁰⁵ Justice Kennedy clearly stated that he agreed with Justice Alito that the disparagement clause is viewpoint discrimination and is unconstitutional.²⁰⁶ Justice Kennedy further explained why viewpoint discrimination was a problem in this case, even if this was a case involving commercial speech, and that it was unnecessary to address other arguments raised.²⁰⁷ Justice Kennedy stated that the disparagement bar is the “government’s disapproval of a subset of messages it finds offensive,” which is “the essence of viewpoint discrimination.”²⁰⁸ He noted:

The First Amendment’s viewpoint neutrality principle protects more than the right to identify with a particular side. It protects the right to create and present arguments for particular positions in particular ways, as the speaker chooses. By mandating positivity, the law here might silence dissent and distort the marketplace of ideas. . . . The danger of viewpoint discrimination is that the government is attempting to remove certain ideas or perspectives from a broader debate. That danger is all the greater if the ideas or perspectives are ones a particular audience might think is offensive, at least at first hearing. An initial reaction may prompt further reflection, leading to a more reasoned, more tolerant position.²⁰⁹

In addressing the reappropriation argument by *Tam*, Justice Kennedy stated, “While thoughtful persons can agree or disagree with this approach, the dissonance between the trademark’s potential to teach and the Government’s insistence on its own, opposite, and negative interpretation confirms the constitutional vice of the statute.”²¹⁰ Justice Thomas wrote separately to assert that strict scrutiny should apply to a government restricting commercial speech involving viewpoint discrimination.²¹¹

merchandise that disparages prominent figures and groups, and the line between commercial and non-commercial speech is not always clear, as this case illustrates. If affixing the commercial label permits the suppression of any speech that may lead to political or social “volatility,” free speech would be endangered.” *Tam*, 582 U.S. at 247.

²⁰⁵ *Id.* at 247.

²⁰⁶ *Id.* at 248–49.

²⁰⁷ *Id.* at 247–50.

²⁰⁸ *Id.* at 249.

²⁰⁹ *Tam*, 582 U.S. at 249–50.

²¹⁰ *Id.* at 251. In closing, Justice Kennedy stated: “A law that can be directed against speech found offensive to some portion of the public can be turned against minority and dissenting views to the detriment of all. The First Amendment does not entrust that power to the government’s benevolence. Instead, our reliance must be on the substantial safeguards of free and open discussion in a democratic society.” *Id.* at 253–54.

²¹¹ *Id.* at 257.

In the 2019 decision in *Iancu v. Brunetti*, the U.S. Supreme Court considered the argument that the scandalous and immoral bar to federal trademark registration violates the First Amendment Free Speech Clause and, thus, is unconstitutional.²¹² Erik Brunetti filed an application to federally register the word “FUCTION” for clothing.²¹³ The U.S. Patent and Trademark Office rejected registration of the mark under the scandalous and immoral bar as the mark, from the perspective of a substantial composite of the general public, is “‘shocking to the sense of truth, decency, or propriety’; ‘giving offense to the conscience or moral feelings’; ‘calling out for condemnation’; ‘disgraceful’; ‘offensive’; ‘disreputable’; or ‘vulgar.’”²¹⁴ In support of its decisions, the examiner and reviewing board relied on “Brunetti’s website and products [which] contained imagery, near the mark, of ‘extreme nihilism’ and ‘anti-social’ behavior,” which the board viewed as “communicat[ing] [sex] or ‘misogyny, depravity, [and] violence.’”²¹⁵ The U.S. Court of Appeals for the Federal Circuit determined that the scandalous and immoral bar violated the First Amendment.²¹⁶

Justice Kagan, the author of the majority opinion, reviewed basic trademark federal registration law, including the bar on registration for “marks that ‘[c]onsist[]of or comprise[] immoral[] or scandalous matter.’”²¹⁷ She further reviewed the *Tam* decision and noted that there was no agreement on “whether a Lanham Act bar is a condition on a government benefit or a simple restriction on speech.”²¹⁸ She also stated that all Justices agreed: “First, if a trademark registration bar is viewpoint-based, it is unconstitutional. And second, the disparagement bar was viewpoint-based.”²¹⁹ In answering the question of whether the scandalous and immoral bar is viewpoint-based or neutral, the Supreme Court responds it is clearly viewpoint-based and unconstitutional.²²⁰ Justice Kagan reviewed dictionary definitions of immoral and scandalous and noted that the government was suppressing the viewpoint that was contrary to what may be consistent with society’s prevailing views of decency and morality.²²¹ She provides examples of denying marks with immoral or scandalous notions concerning “drug use, religion, and terrorism” but at the same time registering marks with more socially acceptable views on those topics.²²² Additionally, Justice Kagan rejected the government’s attempt to limit the construction of the scandalous and immoral bar to “‘vulgar’—meaning ‘lewd,’ ‘sexually explicit or profane’” since the bar does not include an ambiguity allowing such an interpretation.²²³ She noted that “the ‘immoral or scandalous’ bar is substantially overbroad [and t]here are a great many immoral and

²¹² *Iancu*, 588 U.S. at 388.

²¹³ *Id.* at 390.

²¹⁴ *Id.* at 390–91.

²¹⁵ *Id.* at 392.

²¹⁶ *Id.*

²¹⁷ *Iancu*, 588 U.S. at 388.

²¹⁸ *Id.* at 392–93.

²¹⁹ *Id.* at 388.

²²⁰ *Id.*

²²¹ *Id.* at 394.

²²² *Iancu*, 588 U.S. at 395.

²²³ *Id.* at 397–99.

scandalous ideas in the world (even more than there are swearwords), and the Lanham Act covers them all.”²²⁴

Several other justices authored additional opinions. Justice Alito cautioned:

Viewpoint discrimination is poison to a free society. But in many countries with constitutions or legal traditions that claim to protect freedom of speech, serious viewpoint discrimination is not tolerated, and such discrimination has become increasingly prevalent in this country. At a time when free speech is under attack, it is especially important for this Court to remain firm on the principle that the First Amendment does not tolerate viewpoint discrimination.²²⁵

Justice Alito suggested that Congress could attempt to draft a narrower bar directed to vulgar terms that may pass constitutional review.²²⁶ Chief Justice Roberts believes that the immoral bar is not subject to a narrowing construction, but the scandalous bar is subject to an interpretation that limits it “to bar marks that offend because of their mode of expression—marks that are obscene, vulgar, or profane.”²²⁷ Chief Justice Roberts also believes that that narrowed construction would pass First Amendment scrutiny.²²⁸ Justice Breyer and Sotomayor both argue that the scandalous provision may be subject to a narrowing construction and that construction would comply with the First Amendment.²²⁹ Specifically, Justice Breyer would modify First Amendment analysis by focusing less on the category the regulation of speech may fall under and emphasizing the harm to the values underlying the First Amendment considered in conjunction with the regulatory purposes.²³⁰ Notably, Justice Breyer explained that this case did not fit any pre-existing category well; for example, trademark registration or the registry may resemble a limited public forum or be characterized “loosely” as government speech.²³¹ He concluded that a bar limited to vulgar and obscene marks does not harm First Amendment values, and the government has an interest in not being associated with those terms as well as preventing physiological and emotional harm from the usage of those terms.²³²

Justice Sotomayor predicted that there would be a “coming rush” to register scandalous and immoral marks and that the government does not have a statutory basis to refuse registration of those marks.²³³ Justice Sotomayor argued

²²⁴ *Iancu*, 588 U.S. at 399.

²²⁵ *Id.*

²²⁶ *Id.* at 400.

²²⁷ *Id.* at 401. However, as noted by Justice Kagan, the USPTO treats the immoral and scandalous bar as a “unitary bar.” *Id.* at 391.

²²⁸ *Iancu*, 588 U.S. at 401.

²²⁹ *Id.* at 401, 408.

²³⁰ *Id.* at 402–406.

²³¹ *Id.* at 404–406.

²³² *Id.* at 405–406.

²³³ *Iancu*, 588 U.S. at 409.

that the narrowing construction of the scandalous bar to prohibit the registration of obscene or vulgar marks would pass constitutional scrutiny under the First Amendment, and thus, it would result in a bar to the registration of those harmful marks.²³⁴ Justice Sotomayor, in part, pointed to limited public forums and government programs or subsidy cases to note that “reasonable, viewpoint-neutral content discrimination is generally permissible under either framework.”²³⁵ Justice Sotomayor stated:

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. Brunetti, for example, can use, own, and enforce his mark regardless of whether it has been registered. Whether he may register his mark can therefore turn on reasonable, viewpoint-neutral content regulations.²³⁶

Justice Sotomayor noted the governmental interests 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.”²³⁷

In *Vidal v. Elster*, the U.S. Supreme Court decided that the bar to federal registration concerning a trademark that “[c]onsists of or comprises a name . . . identifying a particular living individual except by his written consent” is constitutional under the First Amendment Free Speech clause.²³⁸ In that case, Steve Elster’s attempt to federally register the mark “Trump too small” with a symbol of a hand gesture on shirts and hats was rejected by the U.S. Patent and Trademark Office.²³⁹ Importantly, the Court reversed the Federal Circuit’s judgment that the names bar is unconstitutional for failing intermediate scrutiny under the First Amendment Free Speech Clause and determined that the names bar was a content-based restriction, not a viewpoint discrimination as in *Tam* and *Brunetti*.²⁴⁰ Justice Thomas reasoned, “[T]he Government is thus not singling out a trademark ‘based on the specific motivating ideology or the opinion or perspective of the speaker[; however,] [t]he names clause turns on the content of the proposed trademark—whether it contains a person’s name.’”²⁴¹ Justice Thomas stated that trademark laws should not presumptively have heightened scrutiny applied to them even if

²³⁴ *Iancu*, 588 U.S. at 415.

²³⁵ *Id.* at 422–23.

²³⁶ *Id.* at 424.

²³⁷ *Id.* at 424. Notably, Justice Sotomayor agrees with the majority that the immoral bar is unconstitutional. *Id.* at 426.

²³⁸ *Elster*, 602 U.S. at 286.

²³⁹ *Id.* at 291.

²⁴⁰ *Id.* at 310.

²⁴¹ *Id.* at 294–95.

viewpoint-neutral and content-based.²⁴² Indeed, the Supreme Court reasoned that much of trademark legislation is focused on content and that the laws concerning trademarks and the First Amendment have coexisted “harmoniously” for a long period of time, which counsels against the application of heightened scrutiny.²⁴³ In particular, the names bar has a long historical basis and is “compatible with the First Amendment.”²⁴⁴ Justice Thomas stated: “The names clause reflects this common-law tradition by prohibiting a person from obtaining a trademark of another living person’s name without consent, thereby protecting the other’s reputation and goodwill.”²⁴⁵ The Court did note that a content-based trademark restriction without a grounding in history and tradition may be subject to a different level of scrutiny.²⁴⁶ Justice Thomas concluded:

Our decision today is narrow. We do not set forth a comprehensive framework for judging whether all content-based but viewpoint-neutral trademark restrictions are constitutional. Nor do we suggest that an equivalent history and tradition is required to uphold every content-based trademark restriction. We hold only that history and tradition establish that the particular restriction before us, the names clause in §1052(c), does not violate the First Amendment.²⁴⁷

In *Jack Daniels Products v. VIP Products*, the U.S. Supreme Court held that the *Rogers* test,²⁴⁸ utilized to insulate some uses of trademarks in expressive

²⁴² *Elster*, 602 U.S. at 295.

²⁴³ *Id.* at 286–87.

²⁴⁴ *Id.* at 301.

²⁴⁵ *Id.* at 289.

²⁴⁶ *Id.* at 310. Professor Llewellyn Joseph Gibbons notes that: Under the common law of trademarks, to be a trademark, the chosen designation could not ‘transgress[] the rules of morality and public policy.’ As the author of a leading trademark treatise of the 19th century wrote, “The moral, religious or political sensibilities of any people must not be shocked by the perversion of an emblem sacred in their eyes.” There are some common law trademark cases in which the court very briefly considered morality. See Llewellyn Joseph Gibbons, *Liberty or Licentiousness: Disinsenting, Disparaging, and Scandalous Marks Post-Tam and Brunetti*, 12 HASTINGS SCI. & TECH. L.J. 83, 128–129 (2021) (first citing *Cohn v. People*, 149 Ill. 486 (1894); then citing *Hetterman v. Powers*, 43 SW 180 (Ky. App. 1897); then citing WILLIAM HENRY BROWNE, A TREATISE ON THE LAW OF TRADE-MARKS AND ANALOGOUS SUBJECT 608 (LITTLE BROWN & CO. 1873); and then citing *Ellis v. J.H. Zeillin & Co.*, 42 Ga. 91 (1871)).

²⁴⁷ *Elster*, 602 U.S. at 310. For an excellent discussion of the issues related to the case, see Samuel F. Ernst, *Trump Really is Too Small: The Right to Trademark Political Commentary*, 88 BROOK. L. REV. 839 (2023); Michael Grynberg, *The Trademark Problem of “Trump Too Small,”* 46 COLUM. J.L. & ARTS 47 (2022).

²⁴⁸ *Jack Daniels Products v. VIP Products*, 599 U.S. 140 (2023). Justice Kagan described the origins of the *Rogers* test: The defendants there had produced and distributed a film by Federico Fellini titled “Ginger and Fred” about two fictional Italian cabaret dancers (Pippo

works produced by third parties, does not apply to fact patterns involving the use of the trademark as a trademark in the expressive work.²⁴⁹ The *Jack Daniels Products* matter involved the use by the alleged infringer of modifications of Jack Daniels' famous trademarks with dog toys: "On the toy . . . the words 'Jack Daniel's' become 'Bad Spaniels.'" ²⁵⁰ The descriptive phrase "Old No. 7 Brand Tennessee Sour Mash Whiskey" turns into "The Old No. 2 On Your Tennessee Carpet."²⁵¹ Justice Kagan reasoned that if an alleged infringer uses the trademark as a trademark, then considerations concerning the First Amendment Free Speech Clause are removed.²⁵² Justice Kagan did note that there may not be a likelihood of confusion, but the *Rogers* speech protective test does not apply.²⁵³ The Court stated:

But as the *Mattel* (*i.e.*, Barbie) court noted, when a challenged trademark use functions as 'source-identifying,' trademark rights 'play well with the First Amendment.' 'Whatever first amendment rights you may have in calling the brew you make in your bathtub 'Pepsi' are 'outweighed by the buyer's interest in not being fooled into buying it.'²⁵⁴

and Amelia) who imitated Ginger Rogers and Fred Astaire. When the film was released in the United States, Ginger Rogers objected under the Lanham Act to the use of her name. The Second Circuit rejected the claim. It reasoned that the titles of "artistic works," like the works themselves, have an "expressive element" implicating "First Amendment values." At the same time, such names posed only a "slight risk" of confusing consumers about either "the source or the content of the work." So, the Court concluded that a threshold filter was appropriate. When a title "with at least some artistic relevance" was not "explicitly misleading as to source or content," the claim could not go forward. *VIP Products*, 599 U.S. at 153–54.

²⁴⁹ In a recent article, Professors Christine Haight Farley and Lisa P. Ramsey, to better protect First Amendment free speech interests, propose a new test concerning evaluating cases of infringement involving information or expressive use of names or symbols. See Christine Haight Farley & Lisa P. Ramsey, *Raising the Threshold for Trademark Infringement to Protect Free Expression*, 72 AM. U. L. REV. 1225, 1274–92 (2023) ("Our proposal is to add a broad fair use doctrine to trademark infringement law that allows for the informational or expressive use of another's mark where the accused infringer's expression is neither a false statement about its products nor likely to mislead a reasonable person about the source of the goods, services, or message.").

²⁵⁰ *VIP Products*, 599 U.S. at 144.

²⁵¹ *Id.*

²⁵² *VIP Products*, 599 U.S. at 153–54.

²⁵³ *Id.* at 154.

²⁵⁴ *Id.* at 157. In a concurrence, Justice Gorsuch noted: "I write separately only to underscore that lower courts should handle *Rogers v. Grimaldi*, 875 F.2d 994 (C.A.2 1989), with care. Today, the Court rightly concludes that, even taken on its own terms, *Rogers* does not apply to cases like the one before us. But in doing so, we necessarily leave much about *Rogers* unaddressed. For example, it is not entirely clear where the *Rogers* test comes from—is it commanded by the First Amendment, or is it merely gloss on the Lanham Act, perhaps inspired by constitutional-avoidance doctrine? For another thing, it is not obvious that *Rogers* is correct in all its particulars—certainly, the Solicitor General raises serious

2. Research Concerning *Tam* and *Brunetti*

Matal v. Tam and *Iancu v. Brunetti* have spawned a significant amount of research concerning the study and implications of those cases.²⁵⁵ This literature can be roughly grouped into two broad categories. First, some commentators have reviewed the cases considering the First Amendment doctrine and provided either proposals for legislative solutions to remove scandalous or disparaging marks from the Principal Register or different analytical approaches.²⁵⁶ Second, some

questions about the decision. See Brief for United States as *Amicus Curiae* 23–28. All this remains for resolution another day, and lower courts should be attuned to that fact.” *VIP Products*, 599 U.S. at 165.

²⁵⁵ For example, Professor Yvette Joy Liebesman argues that enforcement of trademarks that may have previously failed the disparagement and scandalous bars may be denied as government speech. See Yvette Joy Liebesman, *Offensive Mark Owners Have an Enforcement Problem*, 59 HOUS. L. REV. 57, 68 (2021).

²⁵⁶ See, e.g., Michaela A. Giuggio, *Trademarking Hate Speech: The Dangers of Inconsistency in the Federal Trademark Registration Process*, 28 LEWIS & CLARK L. REV. 199, 200 (2024) (building on prior legislative proposal and advocating for intersectional critical race lens to “standardize [USPTO] practices to properly combat . . . virulent rhetoric.”); Katherine K. Carey, *Preventing Tam’s “Proudest Boast” from Protecting the Proud Boys: A Response to Free Speech Absolutism in Trademark Law*, 71 EMORY L.J. 609, 649 (2022) (proposing legislative solution); Jordan J. Kilijanski, *A Legislative Framework to Avoid a Vulgar Trademark System*, 69 BUFF. L. REV. 909 (2021) (providing guidance for legislative proposal); Michael Stephenson, *The Lanham Act’s Immoral or Scandalous Provision: Down, But Not Out*, 82 U. PITT. L. REV. 97 (2021) (proposing legislative fix); Russ VerSteeg, *Fixing What’s Broken in §2 of the Lanham Act: Barring Registration of Obscene and Egregiously Offensive Marks*, 27 B.U. J. SCI. & TECH. 179 (2021) (advocating for surgical, addition and hybrid approach to draft legislative solution); Fady J.G. Aoun, *The Belated Awakening of the Public Sphere to Racist Branding and Racist Stereotypes in Trademarks*, 61 IDEA: L. REV. FRANKLIN PIERCE CTR. FOR INTELL. PROP. 545, 671 (2021) (“But, alas, in the United States, for Native Americans and others who had hoped to challenge stigmatizing marks in a similar way, that democratic undertaking never say competition through the law; Tam had snatched jurisprudential victory in the cruelest of ways.”); Meaghan Annett, *When Trademark Law Met Constitutional Law: How a Commercial Speech Theory Can Save the Lanham Act*, 61 B.C. L. REV. 253, 287–92 (2020) (arguing for trademark law to be treated as commercial speech); Snow, *supra* note 32, at 449–50 (arguing that Congress must act to preserve civility in the marketplace); Niki Kuckes, *Iancu v. Brunetti: Free Speech Meets “Immoral and Scandalous” Trademarks in the Supreme Court*, 25 ROGER WILLIAMS U. L. REV. 80 (2020) (analyzing *Brunetti* in light of Free Speech doctrine); Sanders, *supra* note 165 (exploring legislative, judicial and consumer fixes); Lindsay R. Johnson & Mary-Kathryn Hawes, *From the Trail of Tears to Tam: How United States Trademark Law Fails Native Americans*, 21 WAKE FOREST J. BUS. & INTELL. PROP. L. 29, 48 (2020) (“The Supreme Court’s decision in *Tam* Heightens the Divide Between Freedom of Speech and Continued Marginalization of Native Americans.”); Clay Calvert, *Merging Offensive-Speech Cases with Viewpoint-Discrimination Principles: The Immediate Impact of Matal v. Tam on Two Strands of First Amendment Jurisprudence*, 27 WM. & MARY BILL RTS. J. 829 (2019) (critiquing Supreme Court’s position that *Tam* involved viewpoint discrimination); Gary Myers, *It’s Scandalous! – Limiting Profane Trademark Registrations*

commentators have analyzed the cases through empirical studies.²⁵⁷

There have been several empirical studies concerning the subject matter of *Tam* and *Brunetti*, including the impact of those cases. This article examines four of those studies. In 2019, Professor Vicenc Feliu published a study reviewing the effects of the Federal Circuit's decision in *Brunetti* striking down the immoral and scandalous bar as unconstitutional, which was eventually affirmed by the U.S. Supreme Court.²⁵⁸ Professor Feliu noted that predictions concerning the impact of removing the immoral and scandalous bar ranged widely from a flood of new registrations to little change.²⁵⁹ In that study, Professor Feliu examined applications and registrations for trademarks filed containing George Carlin's "The Seven Words You Can Never Say on Television" or alternative spellings of those words both before and after the Federal Circuit's *Brunetti* decision to ascertain whether there has been a rise in applications and registrations after the issuance of the opinion for apparently around fifteen months.²⁶⁰ Professor Feliu concludes, "This study indicates that for the time being there doesn't seem to have been much of a flood behind the anticipated floodgates."²⁶¹

In a study published in 2019, Professors Barton Beebe and Jeanne Fromer examine word-mark trademark applications and registrations from 2003 to 2015 to understand how the Trademark Office applies the immoral and scandalous bar.²⁶²

After Tam and Brunetti, 27 J. INTELL. PROP. L. 1, 19 (2019) (advocating for legislative solution, in part, to focus on mode of expression); Ilhyung Lee, *Tam Through the Lens of Brunetti: The Slants, Fuct*, 69 EMORY L.J. ONLINE 2001, 2004 (2019) (expressing and explaining "[m]y difficulty with *Tam* is its pronouncement of a fundamental right to register a racial epithet as a mark under the federal trademark system"); Chris Cochran, *It's "Fuct": The Demise of the Lanham Act*, 59 IDEA: L. REV. FRANKLIN PIERCE CTR. FOR INTELL. PROP. 333, 351–52 (2019) (advocating for interpreting provisions narrowly to preserve constitutionality); Esther H. Sohn, *Countering the "Thought We Hate" with Reappropriation Use Under Trademark Law*, 94 N.Y.U. L. REV. 1729 (2019) (proposing reappropriation defense to trademark infringement); Doori Song, *Blackhorse's Last Stand?: The First Amendment Battle Against the Washington "Redskins" Trademark After Matal v. Tam*, 19 WAKE FOREST J. BUS. & INTELL. PROP. L. 173, 202 (2019) (stating the Supreme Court in *Brunetti* may treat scandalous and immoral bar as regulating commercial speech); Clay Calvert, *Beyond Trademarks and Offense: Tam and the Justices' Evolution on Free Speech*, 2017 CATO SUP. CT. REV. 25, 57 (2017) (raising implications of *Tam* for state laws preventing state registration of disparaging marks).

²⁵⁷ See, e.g., Michael P. Goodyear, *Queer Trademarks*, 2024 U. ILL. L. REV. 163 (2024); Vicki Huang, *Trademarks, Race and Slur Appropriation: Interdisciplinary and Empirical Study*, 2021 U. ILL. L. REV. 1605, 1614 (2021); Beebe & Fromer, *supra* note 17; Vicenc Feliu, *The F-Word—An Early Empirical Study of Trademark Registration of Scandalous and Immoral Marks in the Aftermath of the In Re Brunetti Decision*, 18 J. MARSHALL REV. INTELL. PROP. L. 404 (2019).

²⁵⁸ Feliu, *supra* note 257.

²⁵⁹ *Id.* at 418; see also Kilijanski, *supra* note 256, at 909 ("By allowing the registration of patently vulgar and obscene trademarks, these trademarks will soon become commonplace in the market, and consumers will be forced to wade through waters muddled with vulgarity to find the product they desire.").

²⁶⁰ Feliu, *supra* note 257, at 413–14.

²⁶¹ *Id.*

²⁶² Beebe & Fromer, *supra* note 17.

The study reviews the Trademark Office's actions before the U.S. Supreme Court's issuance of *Matal v. Tam* and *Iancu v. Brunetti*. The authors make multiple findings of note:

The PTO refused to register 1,901 of [3.6 million word] marks on the basis that they consisted of immoral-or-scandalous matter, though 140 applications eventually overcame that refusal and 91 proceeded to registration. We show that the PTO applies the immoral-or-scandalous prohibition in an arbitrary and viewpoint-discriminatory manner. Specifically, we show that the PTO routinely refuses registration of applied-for marks on the ground that they are immoral or scandalous under § 2(a) and confusingly similar with an already registered mark under § 2(d). In other words, the PTO routinely states that it cannot register a mark because the mark is immoral or scandalous and in any case because it has already allowed someone else to register the mark on similar goods. Furthermore, the PTO arbitrarily allowed some applied-for marks to overcome an immoral-or-scandalous refusal while maintaining that refusal against other marks. The PTO also often declines even to issue immoral-or-scandalous refusals to applied-for marks that are closely similar to other marks to which it has issued such refusals. Finally, the PTO uses the § 2(a) immoral-or-scandalous bar to refuse registration of marks whose viewpoint on such practices as drug-taking it finds objectionable.²⁶³

Notably, the authors state that numerous rejected applications contained “high-value speech” involving, for example, political commentary.²⁶⁴

In a study published in 2021, Professor Vicki Huang examines word and image marks in connection with the argument raised by Simon Tam that he was reappropriating the slur “Slants” and should be allowed to register that term.²⁶⁵ Importantly, she reviews social science literature concerning slur appropriation and notes that reappropriation of a slur by the referenced group may benefit that group, but that appropriation by the other group has negative consequences on the referenced group.²⁶⁶ In her study, Professor Huang created a list of 537 racial slurs, excluding those potential slurs “capable of a good-faith non-racial meaning.”²⁶⁷ She then searched for those terms against the trademark applications filed between January 1, 2010, and January 1, 2020.²⁶⁸ Interestingly, Professor Huang discovered a significant number of applications incorporating slurs against white Americans.²⁶⁹

²⁶³ Beebe & Fromer, *supra* note 17, at 171–72.

²⁶⁴ *Id.* at 198.

²⁶⁵ Huang, *supra* note 257, at 1614.

²⁶⁶ *Id.* at 1612–20.

²⁶⁷ *Id.* at 1623.

²⁶⁸ *Id.* at 1625.

²⁶⁹ *Id.* at 1626.

She removed those because they did not address racial minorities.²⁷⁰ After reviewing the results, she created “a working list of 409 trademark applications [with] an unambiguous, racially-oriented meaning.”²⁷¹ She then attempted to ascertain the race of the applicant and resulted in finding “312 [racially-oriented marks] for analysis comprised of 312 trademark applications representing 217 different applicants. . . .”²⁷² She noted that “the study classified 151 (48.4%) of the 312 applications as self-appropriating trademark applications, and 161 (51.6%) as other-appropriating trademark applications.”²⁷³ First, she determined a slight rise in applications for racially-oriented marks after the Supreme Court’s decision was issued in *Tam*, but nothing resembling a “flood” of applications.²⁷⁴ She notes the lack of growth is particularly interesting given the overall “exponential growth of trademark applications generally.”²⁷⁵ Second, Professor Huang found that self-appropriation applications “after *Tam* did increase in absolute and relative terms over other-appropriating applications[.] Indeed, before *Tam*, the majority of racial-oriented applications were other-appropriating [and a]fter *Tam*, this ratio reversed, with a majority of applications being coded as self-appropriating.”²⁷⁶ Post-*Tam*, she noted that self-appropriation was taken most by African-Americans.²⁷⁷ She additionally noted that there was inconsistent application of the disparagement bar pre-*Tam*.²⁷⁸ Professor Huang also stated that “the ‘n-word’ appears to be the only disparaging slur the [US]PTO continues to refuse, now under the guise of failure to function [which she notes is apparently inconsistently applied].”²⁷⁹

In a somewhat similar study to Professor Huang’s published in 2024, Professor Goodyear focuses on studying LGBTQ+ trademark applications pre- and post-*Tam* and *Brunetti*.²⁸⁰ Professor Goodyear finds that claims regarding a “flood” of disparaging or scandalous applications post-*Tam* and *Brunetti* have not materialized and that there has been a rise in LGBTQ+ applications—over double.²⁸¹ Moreover, those applications are “unanimously affirming in nature; not

²⁷⁰ Huang, *supra* note 257, at 1626.

²⁷¹ *Id.*

²⁷² *Id.* at 1628.

²⁷³ *Id.*

²⁷⁴ *Id.* at 1629–30.

²⁷⁵ Huang, *supra* note 257, at 1631.

²⁷⁶ *Id.* at 1634.

²⁷⁷ *Id.* at 1637.

²⁷⁸ *Id.* at 1637; *See also* Giuggio, *supra* note 256, at 212 (noting inconsistent application of law post-*Tam* and *Brunetti*).

²⁷⁹ Huang, *supra* note 257, at 1643.

²⁸⁰ Goodyear, *supra* note 257.

²⁸¹ *Id.* at 163; *Cf.* Timothy T. Hsieh, *The Hybrid Trademark and Free Speech Forged from Matal v. Tam*, 7 N.Y.U. J. INTELL. PROP. & ENT. L. 1, 19 (2018) (“This paper predicts that there will not be a substantial increase in offensive mark filings, due to goodwill concerns and common business sense. Additionally, the fact that the Disparagement Clause survived for nearly 70 years despite major First Amendment concerns suggests that issues with disparaging marks are relatively uncommon.”).

a single disparaging use of the slurs in trademarks was identified over the entire nine-year period.”²⁸²

F. The Rise of Failure to Function

In her dissenting opinion, Justice Sotomayor described the impact of the decision: “[T]he Court’s decision today will beget unfortunate results.”²⁸³ Like every groundbreaking decision by the Supreme Court, *Tam* and *Brunetti* prompt inquiries about the future implications.²⁸⁴ As of today, Congress has not enacted another provision (a provision maybe that targets only mode of expression)²⁸⁵ to replace unconstitutional provisions, and since then, the USPTO has no direct statutory grounds for rejecting to register marks that are “immoral,” “scandalous,” or “disparaging.”²⁸⁶ However, whether the USPTO is completely powerless against these marks requires further doctrinal discussions, such as that regarding failure to function.

One may ask first, “Well, why should the USPTO reject these marks?” The failure-to-function doctrine also answers this question. Some marks cannot function as a trademark, and protection of these trademarks would avoid the principles or general purpose of trademark law as discussed above and would harm both businesses and the public at large.²⁸⁷

Before delving into the failure-to-function concept, it is essential to note that simply because it is currently possible to register certain marks does not mean it is advisable. As demonstrated above in *Pro-Football, Inc. v. Blackhorse*, despite the R*****S trademarks being repeatedly rejected for registration, it eventually held a successful, registered trademark. Even so, the team changed its name to the “Commanders” following significant controversy and reaction from the public over its branding.²⁸⁸ There are also similar examples for marks such as “Quaker Oats,” “B&G Foods,” or “Dixie Chicks.”²⁸⁹ This may show that the government is not necessarily the most effective regulator for these marks, particularly as societal acceptance for such terms associated with consumer goods and services declines.²⁹⁰ However, even this may be true when the government decides about ideas on behalf of a “substantial composite” of the general public. First, societal acceptance or public determination does not always work in a fast and tolerating way—for example, PFI changed its name after decades—and second, as the Supreme Court signaled in *Brunetti*, content-neutral examination focusing on the mode of expression would serve better for trademarks purposes.²⁹¹ Finally, it is also possible

²⁸² Hsieh, *supra* note 281.

²⁸³ *Iancu*, 588 U.S. at 409.

²⁸⁴ Yen, *supra* note 169, at 396–97.

²⁸⁵ Snow, *supra* note 32, at 408–409.

²⁸⁶ *Id.* at 423.

²⁸⁷ *Id.* at 420.

²⁸⁸ Hetu & Reitz, *supra* note 166, at 24.

²⁸⁹ Lee, *supra* note 36, at 949.

²⁹⁰ Hetu & Reitz, *supra* note 166, at 24.

²⁹¹ *Iancu*, 588 U.S. at 424.

some consumers may be interested in some trademarks just because of their controversial nature.

The concept of failure-to-function as a trademark primarily arises at the registration phase.²⁹² It presents a critical test or guiding principle and asks whether consumers will perceive the matter as a trademark.²⁹³ It takes its roots mostly from the definition of “trademark” under section 45 of the Lanham Act, which says:

the term ‘trademark’ includes any word, name, symbol, or device, or any combination thereof—(1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.²⁹⁴

When reviewing an application to verify “use,” the examiner must assess if the provided specimen demonstrates that the mark successfully identifies the applicant’s goods or services, distinguishes them from others, and indicates their source.²⁹⁵ When the specimen does not meet these criteria, the examiner has grounds to refuse the application because the subject matter fails to function as a trademark under Sections 1, 2, and 45 of the Lanham Act.²⁹⁶

Distinctiveness stands as the main criterion for the protectability of most trademarks.²⁹⁷ A valid trademark must distinguish the associated goods or services from those provided by other sources, either inherently or through use.²⁹⁸ Generally, if a term or phrase is not considered descriptive or generic and does not fall under any other prohibitions specified in the Lanham Act, it is most likely eligible for protection when used in interstate commerce.²⁹⁹

Typically, the USPTO prioritizes the distinctiveness of a mark over its use as a mark, namely examining attorneys concentrating on “what the mark is, rather than what the mark does.”³⁰⁰ However, for protection, a trademark must also be used in a manner consistent with the general way of trademark use.³⁰¹ For example, it must be positioned where consumers expect to find it and distinctly differentiated from adjacent text and imagery to capture attention.³⁰² Additionally, it needs to be

²⁹² Roberts, *supra* note 54, at 1985 (though it may emerge in adversarial contexts such as opposition or cancellation proceedings or disputes over priority). Additionally, there are related rejections such as “merely ornamental” or informational matter.

²⁹³ *Id.* at 2040.

²⁹⁴ 15 U.S.C. § 1127.

²⁹⁵ DINWOODIE & JANIS, *supra* note 125, at 561.

²⁹⁶ Roberts, *supra* note 54, at 2001.

²⁹⁷ *Id.* at 1980.

²⁹⁸ OCHOA ET AL., *supra* note 3.

²⁹⁹ Roberts, *supra* note 54, at 1980.

³⁰⁰ *Id.* at 1977.

³⁰¹ *Id.* at 1981.

³⁰² *Id.* at 1980.

employed in relation to goods or services that are part of interstate commerce or whose sales impact interstate commerce.³⁰³ Without meeting these standards, it fails to function as a trademark to consumers and, therefore, does not qualify for federal protection. Thus, using the mark plays a critical role in determining how likely the public will perceive the matter as a trademark.³⁰⁴ When a trademark is highly distinctive, such as fanciful or arbitrary, minimal use as a mark may qualify for registration.³⁰⁵ Conversely, when a mark is less distinctive, like suggestive marks, more substantial use as a mark may be necessary to qualify for registration.³⁰⁶

This concept is sometimes referenced as “the last line of defense” in the doctrine,³⁰⁷ and it gains even more importance following the decisions in *Tam* and *Brunetti*, where the Supreme Court invalidated the prohibition against registering immoral, scandalous, and disparaging marks, leaving failure-to-function as a crucial tool to assess the registrability of a mark.³⁰⁸ For example, recently, the USPTO has increasingly employed the failure-to-function doctrine to contest applications for marks that do not effectively fulfill their trademark roles due to their semantic implications.³⁰⁹ This approach led to the rejection of the initial attempt to register “I can't breathe” as a trademark, with the examining attorney determining it to be merely informational.³¹⁰

In 2021, Snowflake Enterprises, LLC sought to register a standard character mark N***A for clothes.³¹¹ Even though the applicant admitted the dislike against this word by the general public or black Americans, he requested registration by relying on *Tam* and *Brunetti*.³¹² However, the examining attorney rejected the first finding that the Supreme Court did not mandate that marks deemed disparaging, scandalous, or immoral must automatically be registered, acknowledging that such marks could be denied on legal bases other than Section 2(a).³¹³ The rejection was grounded not in Section 2(a) but because the proposed mark did not meet the functional requirements as set out in Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051-1052, 1127, thereby bypassing claims of viewpoint discrimination or First Amendment issues.³¹⁴ The examining attorney emphasized that even expressive messages or marks could be declined registration if deemed to be commonplace terms, messages, or expressions.³¹⁵ This view of the examining attorney was approved by the TTAB; “the basis for the failure to function refusal under Sections 1, 2, and 45 of the Trademark Act is that Applicant’s

³⁰³ Roberts, *supra* note 54, at 1980.

³⁰⁴ *Id.* at 1981.

³⁰⁵ *Id.* at 1988.

³⁰⁶ *Id.*

³⁰⁷ Cuatrecasas, *supra* note 35, at 1317.

³⁰⁸ *Id.* at 1318.

³⁰⁹ Grynberg, *supra* note 247, at 57.

³¹⁰ *Id.*

³¹¹ In re Snowflake Enters, LLC, No. 87496454, 2021 TTAB LEXIS 229, at *1-2 (T.T.A.B. June 24, 2021).

³¹² *Id.* at *11–12.

³¹³ *Id.* at *16.

³¹⁴ *Id.*

³¹⁵ *Id.* at *16.

proposed mark is a ‘commonplace term widely used by a variety of sources that merely conveys an ordinary, familiar, well-recognized concept or sentiment.’”³¹⁶ “Matter that is widely used to convey ordinary or familiar concepts or sentiments, or social, political, religious, or similar informational messages that are in common use, would not be perceived as indicating source and is not registrable as a mark.”³¹⁷ The TTAB concluded that “N***a” is a commonly used slang term in the United States, including in clothing, and, given its widespread use as a non-trademark matter, prospective purchasers are unlikely to perceive it as an indication of the source of the applicant’s products.”³¹⁸

In 2024, the TTAB issued a non-precedential opinion in *In re Dan Gatsby*.³¹⁹ In that case, Dan Gatsby applied to register F*CKSHITUP for clothing.³²⁰ The trademark examining attorney ultimately denied the application based on failure to function:

Applicant’s proposed mark F*CKSHITUP fails to function as a mark because it is “a commonplace term, message or expression widely used by a variety of sources that merely conveys an ordinary, familiar, well-recognized concept or sentiment.” The Examining Attorney made of record pages from various websites offering shirts and other goods bearing the phrase “F*ck Shit Up” and phrases including those words, a Wikipedia entry captioned “F*ck Shit Up,” and pages from the URBAN DICTIONARY defining the phrase “f*ck shit up.” . . . The Examining Attorney made of record entries on the website at hinateive.com regarding the meaning of the phrase “f*ck shit up;” a page from the REVERSO DICTIONARY discussing various meanings of “f*ck” and “f*ck up;” a page from wordnik.com defining “f*ckshit;” a page from slangdefine.org discussing the phrase “F*ck Your Shit Up;” pages from etsy.com and ebay.com displaying clothing and other goods bearing the phrases “F*ck Shit Up,” “F*ck This Shit,” “Just Here to F*ck Shit Up,” “We’re Here to F*ck Shit Up,” “Let’s F*ck Some Shit Up,” “Today is a Good Day to F*ck Shit Up,” “Let’s F*ck Shit Up,” “Let’s F*ck This Shit Up,” “I’m Gonna Go F*ck Shit Up. You Coming?,” “get out there and f*ck shit up,” “I’m a F*ck Up I F*ck Shit Up,” “F*ck Shit Up and Listen to F*cking Metal,” “Eat Pizza and F*ck Shit Up,” and “I Come I F*ck Shit Up I Leave.”³²¹

³¹⁶ *Snowflake Enters*, No. 87496454 at *36–37.

³¹⁷ *Id.* *37 (citing to Team Jesus, 2020 USPQ2d 11489, at *3).

³¹⁸ *Id.* at *69.

³¹⁹ *In re Dan Gatsby*, No. 87984095, 2024 WL 3025971 (T.T.A.B. June 7, 2024).

³²⁰ *Id.* at *1.

³²¹ *Gatsby*, No. 87984095 at *2–3.

On appeal, Gatsby argued that failure to function was improperly used as a pretext to reject marks with speech the Trademark Office finds offensive to avoid *Tam* and *Brunetti*.³²² The TTAB rejected that argument, reasoning, in part, that nothing in *Tam* or *Brunetti* prevents the Trademark Office from refusing a mark on other grounds and that viewpoint discrimination was not present.³²³ In reviewing the usage of the mark, the TTAB stated: “We find that Applicant’s proposed mark is far more likely to be read, pronounced, and understood simply as a combination of the words ‘f*ck,’ ‘shit,’ and ‘up’ than as a ‘coined term that does not have a specific meaning.’”³²⁴ The TTAB further found that the evidence demonstrated that consumers will purchase goods with the mark for the message—“somebody causing mayhem or chaos (literally or figuratively, humorously or maliciously).”³²⁵

Another example is Eric Brunetti’s other trademark application, F*CK.³²⁶ The TTAB rejected that application with almost the same justifications.³²⁷

In conclusion, while the failure-to-function doctrine may not entirely prevent the registration of all marks that would have been denied under the previous section 2 bars or a potential new statute focusing solely on the mode of expression or marks that are obscene, vulgar, or profane as suggested by the Supreme Court,³²⁸ it still upholds the core principles of trademark law. As a result, the USPTO is likely to issue a greater number of rejections based on “failure to function as a mark,” “merely ornamental,” and “widely-used commonplace expressions,”³²⁹ serving as a last line of defense against the registration of certain marks, despite criticism for being “incoherent and lacking clarity.”³³⁰

III. TURKEY’S TRADEMARK LAWS

A. Background Trademark Principles

The first regulation for trademark protection in Turkey dates back to 1872.³³¹ Since then, numerous changes and different regulations have been implemented.³³² However, the trademark protection system became more dynamic

³²² *Gatsby*, No. 87984095 at *7.

³²³ *Id.* at *14–15.

³²⁴ *Id.* at *17.

³²⁵ *Id.* at *23 (Wellington, dissenting) (arguing that the mark on a hangtag was sufficient to demonstrate that consumers would perceive it as a mark).

³²⁶ *In re Brunetti*, 2022 TTAB LEXIS 297, at *1, n.3 (explaining he did the application just four months before the Supreme Court decision, but it was after the U.S. Court of Appeals for the Federal Circuit’s decision for unconstitutionality). *Iancu v. Brunetti*, 139 S.Ct. 2294 (2019).

³²⁷ *In re Brunetti*, 2022 TTAB LEXIS at *3.

³²⁸ *Brunetti*, 139 S. Ct. at 2302.

³²⁹ Loza, *supra* note 34, at 33.

³³⁰ Cuatrecasas, *supra* note 35, at 1317–19.

³³¹ GÜNEŞ, *supra* note 21, at 2.

³³² *Id.*

after Turkey joined the European Union Customs Union in 1995.³³³

In 2017, regulations governing registered trademarks, geographical indications, traditional specialty guarantees, designs, patents, and utility models were consolidated into a single code aligned with the Turkish Constitution, International Agreements,³³⁴ and EU regulations.³³⁵ This code is known as the Turkish Industrial Property Code No. 6769 (IPC). Despite the intellectual nature of patents, utility models, and design rights under intellectual property law, the term “industrial” is preferred to underscore their practical and real-world applications within the industry.³³⁶ As defined in Article 1, the purpose and scope of this Code are:

(1) [...] to protect the rights relating to trademarks, geographical signs, designs, patents, utility models, and traditional product names, thereby contributing to technological, economic, and social progress. (2) This Code encompasses applications, registrations, and post-registration processes regarding trademarks, geographical signs, design, patent, utility model and traditional product names and legal and criminal sanctions concerning the violation of these rights.³³⁷

Under Article 4 of the IPC, a trademark:

may consist of any signs like words, including personal names, figures, colors, letters, numbers, sounds and the shape of goods or their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings and being represented on the register in a manner to determine the clear and precise subject matter of the protection afforded to its proprietor.³³⁸ Under this definition, there are three elements of a trademark: “sign,” “distinctiveness,” and “clarity and preciseness.”³³⁹

³³³ Council Decision 1/95 of 22 December 1995, Implementing the Final Phase of the Customs Union, 1995 O.J. (L 035) 1.

³³⁴ Const. of the Rep. of Turkey, Nov. 7, 1982, art. 90 (“International agreements duly put into effect have the force of law. [...] In the case of a conflict between international agreements, duly put into effect, concerning fundamental rights and freedoms and the laws due to differences in provisions on the same matter, the provisions of international agreements shall prevail.”).

³³⁵ GÜNEŞ, *supra* note 21, at 14.

³³⁶ *Id.*

³³⁷ IPC art. 1.

³³⁸ *Id.* art. 4.

³³⁹ CAHIT SULUK ET AL., *FİKRİ MÜLKİYET HUKUKU [INTELLECTUAL PROPERTY LAW]* 184 (7th ed. 2023).

The sign element functions as a symbol representing an enterprise, appealing to the target audience, communicating information and messages perceptible through any of the five senses, and encompassing anything that can be externally observed.³⁴⁰ Concerning the second element of distinctiveness, the division between abstract and concrete qualities is crucial. Distinctive quality is divided into two: abstract and concrete.³⁴¹ Signs that fail to differentiate one undertaking's products or services from those of others cannot be registered as trademarks under Article 4 of the IPC, which emphasizes "abstract distinctiveness."³⁴² This means that if a sign does not possess distinctiveness for any conceivable product or service, it lacks the required abstract distinctiveness.³⁴³ Conversely, "concrete distinctiveness" is evaluated by determining whether a sign can specifically distinguish the goods or services for which registration is sought from those offered by others.³⁴⁴ If the sign does not serve this distinguishing function for particular goods or services, it lacks concrete distinctiveness.³⁴⁵ Similar to the United States, under Article 5(2), "[i]f a trademark has been used before the application, and through this use, has acquired distinctive character in respect of the goods and services subject to the application[.]" it can be registered as a trademark.³⁴⁶

The final element specifies that any sign can be a trademark if it is identifiable.³⁴⁷ With the recent regulation changes, a sign no longer needs to be depicted through a drawing or represented graphically for trademark registration.³⁴⁸ Consequently, the Code adapts flexibly to technological advancements, accommodating the registration of unconventional marks such as sounds or scents.³⁴⁹

In Turkish trademark law, trademarks are generally classified into primary functions, which include distinguishing the goods or services from those of competitors and indicating the product's source or undertaking's origin.³⁵⁰ Additionally, trademarks serve economically-oriented functions, such as

³⁴⁰ SULUK ET AL., *supra* note 339 at 185.

³⁴¹ Melek Doğan, *Marka Hukukunda Multak Red Nedenleri [Reasons for Absolute Rejection in Trademark Law]* 6 (May 23, 2019) (Master's Thesis, Akdeniz University) (on file with Akdeniz University).

³⁴² SULUK ET AL., *supra* note 339, at 185.

³⁴³ *Id.*

³⁴⁴ *Id.*

³⁴⁵ *Id.*

³⁴⁶ IPC art. 5(2).

³⁴⁷ YESİM AKER, *MARKA TESCİL SÜRECİNDE TÜRK PATENT VE MARKA KURUMU KARARLARINA KARŞI BAŞVURULABİLECEK HUKUKİ YOLLAR [LEGAL REMEDIES THAT CAN BE TAKEN AGAINST TURKISH PATENT AND TRADEMARK OFFICE DECISIONS DURING THE TRADEMARK REGISTRATION PROCESS]* 26 (1st ed. 2021).

³⁴⁸ *Id.*

³⁴⁹ SULUK ET AL., *supra* note 339, at 185–86.

³⁵⁰ EMRE ÇETİN, *MARKA HUKUKUNDA NİSPİ RED NEDENLERİ VE HÜKÜMSÜZLÜK DAVALARI – FİKRİ MÜLKİZET HUKUKU MONOGRAFİLERİ [RELATIVE REASONS FOR REJECTION AND INVALIDITY CASES IN TRADEMARK LAW – INTELLECTUAL PROPERTY LAW MONOGRAPHS]* 30 (1st ed. 2023).

guaranteeing the quality of goods and services, facilitating advertising and communication with the consumer, and protecting and enhancing investments made in goods and services.³⁵¹

B. Turkey's Trademark Registration System

In Turkey, registration is not mandatory to obtain trademark rights; a person can also acquire a trademark through first use.³⁵² However, under Section 7(1) of the IPC, “[t]rademark protection provided by this Code shall be acquired by registration.”³⁵³ As an exception, unregistered marks benefit from IPC protections only under Sections 6(3) and (4), which allow the owner to oppose a trademark registration based on the “right to a non-registered trademark or to another sign used in the course of trade that was acquired prior to the date of application.”³⁵⁴ Additionally, the owner of “well-known marks within the context of Article 6 bis of the Paris Convention” can also oppose registrations without registering his own trademark.³⁵⁵ Apart from these provisions, unregistered trademarks are protected under the unfair competition clauses in the Turkish Code of Obligations No. 6908 and the Turkish Commercial Code No. 6102.³⁵⁶

Registration brings certain benefits under the IPC, such as the right to prevent unauthorized use of the trademark (IPC Article 7(2)), the right to prohibit, prevent, and remove the trademark from being used in reference works in a way that gives the impression of a generic name (IPC Article 8),³⁵⁷ validity of the trademark,³⁵⁸ or perusing certain criminal and civil actions under Articles 30 and 150 of the IPC against the infringer that an unregistered trademark owner cannot pursue.³⁵⁹

The trademark application process in Turkey, which has some similarities to the U.S. system, begins with an applicant applying to the Turkish Patent and Trademark Office (TPTO).³⁶⁰ The application must include a representation of the trademark, a list of goods or services for which the application is filed, and evidence

³⁵¹ ÇETİN, *supra* note 350, at 30.

³⁵² Doğan, *supra* note 341, at 10.

³⁵³ IPC art. 7 § 1.

³⁵⁴ *Id.* art. 6 § 3.

³⁵⁵ *Id.* art. 6 § 4.

³⁵⁶ ÇETİN, *supra* note 350, at 38.

³⁵⁷ *Id.*

³⁵⁸ GÜNEŞ, *supra* note 21, at 7.

³⁵⁹ For example, under Article 30(1), “A person who produces or provides services, puts on the market or sales, imports or exports, buys for commercial purposes, possesses, transports or stores, while infringing a trademark right through quotation or likelihood of confusion, shall be sentenced from one year to three years of imprisonment and punished with judicial fine up to twenty thousand days.” IPC art. 30 § 1.

³⁶⁰ TANER SAVAŞ & MURAT SAYGIN, TÜRK PATENT VE MARKA KURUMU UYGULAMALARI VE YARGITAY KARARLARI IŞIĞINDA MARKA TESCİL SÜRECİ [TRADEMARK REGISTRATION PROCESS IN LIGHT OF TURKISH PATENT AND TRADEMARK OFFICE PRACTICES AND SUPREME COURT DECISIONS] 44 (2d ed. 2022).

of the application fee payment.³⁶¹ The trademark must distinguish the goods or services of one undertaking from those of others and be representable on the register in a manner that clearly defines the scope of protection provided to the proprietor.³⁶²

Upon submission, the TPTO conducts a formal examination to check for absolute reasons for refusal in trademark registration as outlined under Article 5.³⁶³ If the application meets all conditions, it is published for two months, during which third parties may oppose the registration based on both relative and absolute grounds for refusal.³⁶⁴ If the TPTO rejects the application or if there are oppositions, the decision or the opposition is reviewed by the Re-Examination and Evaluation Board.³⁶⁵ Decisions made by the Board can be appealed to the civil courts, which specialize in intellectual property law.³⁶⁶ Once the application clears all hurdles without opposition or if any oppositions are resolved in favor of the applicant, the trademark is registered and entered in the registry, with its details published in the Bulletin.³⁶⁷ The registered trademark is protected for ten years from the application date, with the possibility of renewal for additional ten-year periods.³⁶⁸

C. Marks Ineligible for Trademark Registration

Articles 4, 5, and 6 of the IPC establish the foundational criteria for marks that are ineligible for trademark registration. Article 4 defines what constitutes a trademark, while Articles 5 and 6 enumerate the specific bars to registration.³⁶⁹ As previously analyzed in Section III.A. “Background Trademark Principles,” the definition provided in Article 4 highlights three essential elements of a trademark: “sign,” “distinctiveness,” and “clarity and preciseness.”³⁷⁰ These elements are crucial requirements also for the registration of a trademark.³⁷¹

The regulations governing registration bars in Turkish law, particularly after the latest codification of the IPC in 2017, differ from those of U.S. law and align more closely with European Union law.³⁷² The IPC distinguishes between

³⁶¹ IPC art. 11. Additionally, Article 14 provides for international trademark applications under the Madrid Protocol. *Id.* art. 14.

³⁶² *Id.* art. 4 § 1.

³⁶³ GÜNEŞ, *supra* note 21, at 16.

³⁶⁴ SAVAŞ & SAYGIN, *supra* note 360, at 62.

³⁶⁵ IPC art. 17.

³⁶⁶ SAVAŞ & SAYGIN, *supra* note 360, at 84.

³⁶⁷ *Id.* at 172.

³⁶⁸ IPC art. 23.

³⁶⁹ *Id.* arts. 4–6.

³⁷⁰ *Id.* art. 4.

³⁷¹ RAUF KARASU ET AL., FİKRİ MÜLKİYET HUKUKU [INTELLECTUAL PROPERTY LAW] 184–85 (7th ed. 2023).

³⁷² GÜNEŞ, *supra* note 21, at 16–17.

absolute³⁷³ and relative grounds³⁷⁴ for refusal in trademark registration. While the TPTO examines absolute grounds for refusal *ex officio*, relative grounds for refusal are only considered upon objections raised by third parties.³⁷⁵ Nonetheless, both types of grounds can be grounds for legal action to invalidate a trademark registration.³⁷⁶

In Turkey, unlike the United States, trademark use is not a requirement for registration, but the law imposes a duty on trademark owners to use their marks.³⁷⁷ According to Article 9(1) of the IPC, if a trademark is not used genuinely in Turkey for the goods or services for which it is registered, within five years from the date of registration and without a justified reason, it is subject to cancellation.³⁷⁸ The

³⁷³ Under Article 5(1) of IPC, following signs set out below shall not be registered as trademark: a) Signs which may not be trademark according to Article 4. b) Signs which are devoid of any distinctive character. c) Signs which consist exclusively or includes as an essential element of signs or indications which serve in trade to designate the kind, type, characteristics, quality, quantity, intended purpose, value, geographical origin, or the time of production of goods or of rendering of the services or other characteristics of goods or services. ç) Signs which are identical to or indistinguishably similar to a trademark, [...] d) Signs which consist exclusively or includes as an essential element of signs or indications used by everyone in the trade area or which serves to distinguish members of a particular professional, vocational or commercial group from others. e) Signs which consist exclusively of the shape or another characteristic [...] f) Signs which would deceive the public, [...] g) Signs which shall be refused pursuant to Article 6ter of the Paris Convention. ğ) Signs other than those covered by Article 6ter of the Paris Convention [...] h) Signs that contain religious values or symbols; ı) Signs which are contrary to public policy or to accepted principles of morality; i) Signs which consist of a registered geographical sign or which contain a registered geographical sign. IPC art. 5 § 1.

³⁷⁴ Under Article 6 of IPC: (1) An application for trademark registration shall be refused upon opposition if there exists a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trademark, due to identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered. (2) [...] (3) If a right to a non-registered trademark or to another sign used in the course of trade was acquired prior to the date of application or the date of the priority claimed for the application for registration of a trademark, the trademark application shall be refused upon opposition of the proprietor of that prior sign. (4) Trademark applications which are identical or similar to the well-known marks within the context of Article 6 bis of the Paris Convention, shall be refused upon opposition in respect of the identical and similar goods or services. (5) [...] (6) An application for registration of a trademark shall be refused upon the opposition of the right holder if it consists of a person's name, trade name, photography, copyright or any other intellectual property right of another. (7) [...] (8) An application for registration of a trademark identical to or similar to a registered trademark with identical or similar goods or services, that is filed within two years following the expiration of the protection of the registered trademark due to non-renewal shall be refused upon opposition of previous trademark proprietor provided that the trademark has been used during this period. (9) Trademark applications filed in bad faith shall be refused upon opposition. IPC art. 6.

³⁷⁵ GÜNEŞ, *supra* note 21.

³⁷⁶ IPC art. 25 § 1.

³⁷⁷ GİZEM ÇOŞĞUN, SİNAİ MÜLKİYET KANUNU KAPSAMINDA MARKANIN KULLANILMASI 27 (1st ed. 2018).

³⁷⁸ IPC art. 9 § 1.

trademark owner is allowed a grace period of five years to commence use of the mark.³⁷⁹ While there are no criminal or compensatory penalties for non-use, inactivity for five years can lead to the possibility of the trademark being canceled.³⁸⁰ This requirement is designed to prevent the stalling of free trade and industry through frivolous or malicious registrations.³⁸¹

Partial cancellation of the trademark is also possible if it is used for some of the goods or services for which it is registered but not for others.³⁸² Essentially, the use of the core distinctive elements of the mark is considered sufficient to meet the usage obligation.³⁸³ Furthermore, if a mark was initially used but then not utilized for five consecutive years, the owner may struggle to protect his trademark in an infringement case, as he may face a “non-use defense” from other parties under Articles 25(7) and 19(2).³⁸⁴

D. Treatment of Immoral, Disparaging, and Scandalous Marks

In Turkey, as elsewhere, some businesses adopt aggressive marketing strategies that involve using provocative trademarks, including those that could be considered immoral, scandalous, or disparaging. These marks aim to cut through market noise by creating a memorable and controversial brand image to increase market share.³⁸⁵ Some of them can achieve their objectives because many members of the public can find these marks attractive.³⁸⁶ In Turkish law, there are no literal equivalents to the bars against immoral, disparaging, and scandalous marks found in the Lanham Act.³⁸⁷ Nevertheless, Turkish legislation includes bars for “signs which are contrary to public policy or to accepted principles of morality” in Article 5(1)(i) of the IPC.³⁸⁸

Below, the primary focus will be on Article 5(1)(i), which is under absolute grounds for refusal and reviewed ex-officio by the TPTO.³⁸⁹ This provision prohibits the registration of “signs which are contrary to public policy or accepted principles of morality.”³⁹⁰ It will be analyzed in detail due to its close resemblance to corresponding bars in U.S. law against “immoral,” “scandalous,” and

³⁷⁹ IPC art. 9 § 1.

³⁸⁰ GÜNEŞ, *supra* note 21.

³⁸¹ *Id.*

³⁸² ÇOŞĞUN, *supra* note 377.

³⁸³ GÜNEŞ, *supra* note 21, at 279.

³⁸⁴ IPC art. 25 § 7, 19 § 2.

³⁸⁵ MEMİŞOĞLU, *supra* note 4, at 747.

³⁸⁶ Enrico Bonadio, *Brands, Morality and Public Policy: Some Reflections on the Ban on Registration of Controversial Trademarks*, 19 MARQ. INTELL. PROP. L. REV. 39, 50 (2015).

³⁸⁷ 15 U.S.C. § 1052.

³⁸⁸ IPC art. 5 § 1(i).

³⁸⁹ GÜNEŞ, *supra* note 21, at 75.

³⁹⁰ IPC art. 5 § 1(i).

“disparaging” marks, particularly in terms of addressing public morality and policy or its viewpoint-discriminative feature.³⁹¹

Additionally, Article 6(9) states that “trademark applications filed in bad faith shall be refused upon opposition.”³⁹² Unlike its counterpart in the EU,³⁹³ where such a provision is treated as absolute grounds for refusal, in Turkey, this rule falls under the category of relative grounds for refusal.³⁹⁴ This means that it is subject to examination by the TPTO or the courts only if an opposition is filed.

This rule reflects a fundamental principle of the Turkish Civil Code, which states that “[e]very person must act in good faith in the exercise of their rights and in the performance of their obligations.”³⁹⁵ Although a literal interpretation of these rules might suggest it could apply to the contentious provisions discussed in this paper, particularly to disparaging marks, its application is, in fact, more restricted.

The concept of “bad faith” in Turkish trademark law is not explicitly defined within the statutes but is shaped by judicial decisions and doctrinal interpretations.³⁹⁶ The Court of Cassation defines bad faith in trademark law as:

applications and registrations for the purpose of taking unfair advantage of someone else's trademark by misusing the trademark protection provided through registration in a manner contrary to its purpose, or for the purpose of backup, trademark trade or blackmail, which are not actually used, are considered to be in bad faith.³⁹⁷

The existence of bad faith should be determined by considering the characteristics of each concrete case.³⁹⁸

Definitions in the doctrinal opinions are also almost the same.³⁹⁹ As evidenced by its definition, this registration bar functions as a comprehensive measure requiring a detailed, case-by-case factual analysis to ascertain the

³⁹¹ UĞUR ÇOLAK, TÜRK MARKA HUKUKU [TURKISH TRADEMARK LAW], 263–64. (5th ed. 2023).

³⁹² IPC art. 6 § 9.

³⁹³ Council Directive 2015/2436, art. 4(2), 2015 O.J. (L 336/8) (EU) (“A trademark shall be liable to be declared invalid where the application for registration of the trade mark was made in bad faith by the applicant.” Similarly, in European Union Trademark Regulation Article 59(1) “An EU trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:” (b)” where the applicant was acting in bad faith when he filed the application for the trade mark.”). Commission Regulation 2017/1001, art. 59(1), 2017 O.J. (L 154) (EU).

³⁹⁴ IPC art. 6 § 9.

³⁹⁵ Turkish Civil Code art. 2.

³⁹⁶ Özge Erer Evşen, Sınai Mülkiyet Kanunu Kapsamında Marka Hukukunda Kötü Niyetli Tescil ve Kötü Niyetli Tescilin Hukuki Sonuçları [Malicious Registration in Trademark Law and Legal Consequences of Malicious Registration within the Scope of Industrial Property Law] 47 (Jan. 1, 2020) (Master's Thesis, Çankaya University) (DSpace Repository).

³⁹⁷ Türkiye Cumhuriyeti Yargıtay Başkanlığı [Court of Cessation of the Republic of Turkey] Jul. 16, 2008, Case No. 2008/11-501 E., 2008/507 K.

³⁹⁸ *Id.*

³⁹⁹ See EVŞEN, *supra* note 396, at 48.

subjective and personal intent⁴⁰⁰ behind the application or registration of a trademark rather than evaluating the message or communication conveyed by the trademark. Consequently, this aspect will not be analyzed further in this paper.

E. Signs That are Contrary to Public Policy or Accepted Principles of Morality

1. Purpose and Definitions

In Turkish trademark law, which almost mirrors the European Union Trademark Regulation (EUTMR) 2017/1001 Article 7(1)(f) that prohibits the registration of trademarks contrary to public policy or accepted principles of morality, the purpose of this bar is expressed as denying legal and economic contributions of government to marks that do not align with fundamental and contemporary values of democratic societies.⁴⁰¹ This idea underscores the necessity of limiting market-based freedoms to protect public decency and prevent commercial exploitation of sensitive content and particularly targets marks that are openly offensive or promote authoritarian regimes or terrorist organizations, violence, drug use, or demeaning religious and ethnic groups.⁴⁰²

The term “public policy” in the context of Turkish law, as mentioned in the legislation, is not clearly defined. It is composed of two ambiguous words, “public” and “policy,” and refers to a set of legal norms established for the benefit of society, whose adherence and protection are in the interest of the entire community and the state.⁴⁰³ Although the definition of “public policy” is complex and its meaning remains ambiguous, often varying between countries and over time, in Turkey, it is evaluated according to the conditions present at the time the application is made.⁴⁰⁴ Furthermore, public policy may encompass all rules that facilitate the proper functioning of public services, ensure the security and stability of the state, and uphold legal, peaceful, and moral standards in interpersonal relationships, thereby supporting the preservation of the state and its structures.⁴⁰⁵

Under the Trademark Review Guide of the TPTO, trademarks that incite crime, threaten democratic order, contain racism or discrimination, or contain symbols associated with terrorist organizations are examples of marks considered contrary to public policy and are therefore ineligible for registration, ensuring they do not endorse activities harmful to societal norms and national security.⁴⁰⁶ Because many of these activities are governed by specific legal codes relating to the actions themselves—such as legislation on tobacco products that directly prohibits the

⁴⁰⁰ In the *Harjo* case, it is found that no specific intent is necessary for “disparaging” mark evaluation. *Harjo*, 50 U.S.P.Q.2D (BNA) at 1738.

⁴⁰¹ MEMİŞOĞLU, *supra* note 4, at 749.

⁴⁰² *Id.*

⁴⁰³ ÇOLAK, *supra* note 391, at 259.

⁴⁰⁴ *Id.*

⁴⁰⁵ YASAMAN ET AL., *supra* note 27, at 491.

⁴⁰⁶ TÜRK PATENT VE MARKA KURUMU [TURKISH TRADEMARK PATENT AND TRADEMARK OFFICE] [TPTO] TRADEMARK REVIEW GUIDE art. 11.1 (2021).

commercial use of expressions encouraging their consumption—the infringement of these regulations typically signifies a breach of public policy, and therefore, some scholars in the doctrine argue that the “public policy” bar can be analyzed objectively.⁴⁰⁷ However, the determination of the bar’s purpose and the need to consider public perception and values also introduce a subjective element.

Before delving into the definition of “accepted principles of morality” within trademark law, it is valuable to note how frequently this concept overlaps with “public policy” during the assessment of trademark applications, such as those involving marks with offensive content. This overlap often complicates the distinction between these two criteria.⁴⁰⁸

The legislature used the term “genel ahlak” in the Turkish version of the Code for “accepted principles of morality.”⁴⁰⁹ The literal translation of these words to English would be “general morality.”⁴¹⁰ However, in legal doctrine, it is often described as the standard of judgments and understanding of morality adopted by the majority of society at a given time, necessitating its translation as “accepted principles of morality.”⁴¹¹ Established in Turkish law in 1886, this bar aims to protect individuals’ material, spiritual, and social integrity, sometimes incorporating religious and etiquette norms and reflecting societal values of their time.⁴¹² As these norms are unwritten and the concept varies by culture, time, and worldview, objectively assessing whether a trademark application violates these principles requires careful consideration of the specific facts of each case against the prevailing ethical standards at the time of application, similar to evaluations of public policy.⁴¹³

2. Sample Applications of the Provision

Whether a sign is contrary to public policy or accepted principles of morality should be assessed not by the applicant’s intent but by the sign’s inherent qualities and the message it conveys, considering the holistic perception together with all its elements in the application.

For determination of the public perception or standard of judgment, assessment should focus on the views of individuals in Turkey with “normal sensitivity” and “reasonable” judgment, rather than personal or regional biases.⁴¹⁴ This evaluation must consider the societal context at the time of the trademark application, considering that religious and moral values can evolve due to international developments, political decisions, and economic changes. “FETULLAH GÜLEN” trademark can be an example of this situation. This

⁴⁰⁷ MEMİŞOĞLU, *supra* note 4, at 751.

⁴⁰⁸ DOĞAN, *supra* note 341, at 96.

⁴⁰⁹ MEMİŞOĞLU, *supra* note 4, at 772.

⁴¹⁰ Translator, CAMBRIDGE DICTIONARY, <https://dictionary.cambridge.org/translate/> (last visited Jan. 27, 2025).

⁴¹¹ GÜNEŞ, *supra* note 21, at 125.

⁴¹² ÇOLAK, *supra* note 391, at 259.

⁴¹³ *Id.* at 260.

⁴¹⁴ TPTO TRADEMARK REVIEW GUIDE art. 11.3 (2021).

trademark is the first and last name of a religious opinion leader of the Gülen Movement, and before 2013, his organization was one of the most powerful organizations in Turkey.⁴¹⁵ However, after 2013 and specifically after the 2016 coup, he and his organization were subjected to multiple prosecutions and found as a terrorist organization in the field of law and also in the view of the general public in Turkey.⁴¹⁶ Because of this change, this trademark was later found contrary to public policy.⁴¹⁷

In addition to these, the compatibility of a trademark with public policy and moral principles can vary depending on the specific goods and/or services proposed.⁴¹⁸ For instance, while the term “HOOKER” might be registrable for shipping supplies or furniture, it may not be permissible for men’s magazines.⁴¹⁹ Similarly, in another decision of the Board,⁴²⁰ a trademark application for “double happiness” intended for goods in Class 34 (cigarettes, tobacco) was rejected.⁴²¹ The reasoning was based on ongoing significant campaigns and legal actions against the health hazards of cigarettes and tobacco products in Turkey and worldwide.⁴²² Given that the phrase “double happiness” could be interpreted by consumers as suggesting that the product provides double the satisfaction or happiness due to its features, it was considered to be potentially encouraging and enticing in a way that contradicts public health policies—a critical aspect of public policy.⁴²³ This discrepancy highlights how the perception of a term’s acceptability can vary significantly depending on the specific goods or services associated with the trademark application.

While dictionary definitions can provide an initial indication that a word may carry an offensive meaning in the relevant language, the key factor should be the perception of the relevant public.⁴²⁴ The mere fact that a sign has negative connotations does not automatically make it contrary to public policy or accepted principles of morality.⁴²⁵ For example, the term “Fcuk” is registered as a trademark by the TPTO, illustrating that not all potentially provocative terms are considered unacceptable if the public perception does not find them offensive or immoral.⁴²⁶

⁴¹⁵ Aslı Aydıntaşbaş, *The good, the bad and the Gülenists*, EUR. COUNCIL ON FOREIGN REL. (Sept. 23, 2016), https://ecfr.eu/publication/the_good_the_bad_and_the_gulenists7131/.

⁴¹⁶ *Id.*

⁴¹⁷ *See generally* IPC.

⁴¹⁸ GÜNEŞ, *supra* note 21, at 125.

⁴¹⁹ This term is currently registered in TPTO under class 20 (furniture) with the application number 2009/19311. Similarly, for the “SCREW YOU” trademark application, EUIPO decided that it is not offensive or disturbing to the relevant public for preservatives and sex toys. ÇOLAK, *supra* note 391, at 260.

TPTO TRADEMARK REVIEW GUIDE art. 11.3 (2021).

⁴²⁰ TPTO, *supra* note 414, at art. 11.2 (citing YİDK, 2014-M-11771 numbered decision).

⁴²¹ *Id.*

⁴²² *Id.*

⁴²³ *Id.*

⁴²⁴ *Id.*

⁴²⁵ TPTO, *supra* note 414, at art. 11.3.

⁴²⁶ *Id.* art. 11.2.

In another decision,⁴²⁷ the Board upheld the refusal to register the trademark application for the term “wog,” depicted in application number 2013/53165.⁴²⁸ The term was identified as derogatory slang particularly used in British and Australian English to disparage Middle Eastern people, including Turks.⁴²⁹ As a result, the trademark was found to be contrary to public policy and accepted principles of morality, warranting its rejection for services related to land, sea, and air transportation.⁴³⁰ Interestingly, despite this rejection, a search in the trademark database later revealed that the same trademark was accepted for publication in 2024 for goods under Classes 9 and 11.⁴³¹

The applicability of this provision extends beyond marks that are immoral, scandalous, or disparaging; it also encompasses trademarks that could mislead the public by appearing to represent official institutions.⁴³² For example, the application for “Veri Koruma Kurumu”⁴³³ (Data Protection Authority) is rejected because it resembles the real official institution name of the “Personal Data Protection Authority,” and therefore is contrary to public policy. However, the application for “Türk Fil Kurumu” (Turkish Elephant Agency) is accepted as a trademark because, despite giving the impression of an official institution, it is a fictitious and imaginative name and unlikely to be perceived as an official institution.⁴³⁴

3. Relation to Freedom of Expression

Under Article 26 of the Constitution of the Republic of Turkey, “[e]veryone has the right to express and disseminate his/her thoughts and opinions by speech, in writing or in pictures”⁴³⁵ However, under the same article, “[t]he exercise of these freedoms may be restricted for the purposes of national security, public order, public safety, . . . protecting the reputation or rights and private and family life of others, or protecting professional secrets as prescribed by law”⁴³⁶

The grounds for freedom of expression are not limited in Turkish law because under Article 90 of the Constitution, “[i]nternational agreements duly put into effect have the force of law.⁴³⁷ [I]n the case of a conflict between international agreements, duly put into effect, concerning fundamental rights and freedoms and the laws due to differences in provisions on the same matter, the provisions of international agreements shall prevail.”⁴³⁸ Thus, any international agreement related

⁴²⁷ TPTO, *supra* note 414, at art. 11.2.

⁴²⁸ *Id.*

⁴²⁹ *Id.* art. 11.3.

⁴³⁰ *Id.*

⁴³¹ TPTO App. No. 2024/019212.

⁴³² TPTO, *supra* note 414, at art. 11.3.

⁴³³ TPTO App. No. 2017/107397.

⁴³⁴ TPTO App. No. 2013/48938; TPTO TRADEMARK REVIEW GUIDE art. 11.3.

⁴³⁵ CONSTITUTION OF THE REPUBLIC OF TURKEY, 2017, art. 26.

⁴³⁶ *Id.*

⁴³⁷ *Id.*

⁴³⁸ *Id.* art. 90.

to the freedom of expression is above the Turkish Intellectual Property Code in the hierarchy of norms.

Turkey is a party to the European Convention on Human Rights (ECoHR), which states in Article 10 that “[e]veryone has the right to freedom of expression.”⁴³⁹ And in Subsection 2 of the same article, “[t]he exercise of these freedoms . . . may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary . . . in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or rights of others”⁴⁴⁰

Given the legal hierarchy established by the Turkish Constitution, decisions or interpretations made by European courts, including the European Court of Human Rights (ECHR), significantly influence Turkish law.⁴⁴¹ This influence is especially relevant in matters of freedom of expression, where ECHR decisions help shape the interpretation and application of corresponding national laws.⁴⁴² Furthermore, the European Union Trademark Regulation (EUTMR) 2017/1001 Article 7(1)(f), which prohibits the registration of trademarks that are contrary to public policy or accepted principles of morality, closely mirrors provisions found in Turkish trademark law.⁴⁴³

Turkish legal doctrine recognizes that the freedom of speech provisions in both the Constitution and the ECHR extend to trademarks or other distinctive expressions that convey commercial information.⁴⁴⁴ This interpretation is also upheld by the European Court of Human Rights.⁴⁴⁵ It is also acknowledged that the refusal of trademark registration deprives an applicant of certain benefits⁴⁴⁶ that come with trademark registration, although the use of a trademark without registration is still possible.⁴⁴⁷ Consequently, such a refusal indirectly restricts freedom of expression.⁴⁴⁸

⁴³⁹ ECHR, art. 10.

⁴⁴⁰ *Id.*

⁴⁴¹ CONSTITUTION OF THE REPUBLIC OF TURKEY, 2017, art. 90.

⁴⁴² As previously explained, within the Turkish legal hierarchy, international agreements concerning fundamental rights and freedoms such as the European Convention on Human Rights hold supremacy over domestic legislative codes, including the Turkish Industrial Property Code. *Id.*

⁴⁴³ YASAMAN ET AL., *supra* note 27, at 491.

⁴⁴⁴ MEMİŞOĞLU, *supra* note 4, at 793.

⁴⁴⁵ *Casado Coca v. Spain*, [1994] ECHR 8, App. No. 15450/89 (Eur.).

⁴⁴⁶ As explained *supra* registration brings certain benefits under the IPC such as the right to prevent unauthorized use of his trademark (IPC article 7(2)), the right to prohibiting, preventing and removing its trademark from being used in reference works in a way that gives the impression of a generic name (IPC art. 8), and validity of the trademark or perusing certain criminal and civil actions under Article 30 and 150 of the IPC against the infringer that a unregistered trademark owner cannot pursue. ÇETİN, *supra* note 350, at 38. ONUR SARI, TÜRK VE ABD HUKUKU BAĞLAMINDA MARKA HAKKI EDİNME SÜRECİ [TRADEMARK RIGHT OBTAINING PROCESS IN THE CONTEXT OF TURKISH AND U.S. LAW], 27 (1ST ED. 2020).

⁴⁴⁷ ÇOLAK, *supra* note 391, at 263.

⁴⁴⁸ MEMİŞOĞLU, *supra* note 4, at 797.

Although the restrictive effect on freedom of expression is acknowledged, it does not necessitate the repeal of either Article 5(1)(i) of the IPC or Article 7(1)(f) of the EUTMR. Both the Turkish Constitution and the European Convention on Human Rights permit restrictions on freedom of speech for the sake of public order and morals.⁴⁴⁹ For this reason, case law, and scholarly opinions have supported a narrower interpretation of these provisions.⁴⁵⁰ Thus, while the rejection of a trademark registration may sometimes infringe upon freedom of expression through improper application of the rule, the restricting rules themselves remain legally valid.

For such restrictions to be legally justified, they must meet specific criteria: they must have a legal basis; they must aim to achieve a legitimate interest under Article 26 of the Turkish Constitution or Article 10(2) of the ECHR; and they must be necessary in a democratic society.⁴⁵¹

Because both Article 5(1)(i) of the IPC and Article 7(1)(f) of the EUTMR provide a legal basis for such restrictions under Article 26 of the Turkish Constitution and Article 10(2) of the ECHR, the last criterion focuses on a case-by-case, fact-based analysis.⁴⁵² For example, in the past, the application for the community word mark F*CKEN (F*CK) was rejected due to its contravention of accepted principles of morality.⁴⁵³ Similarly, in the “Fack Ju Göhte” case,⁴⁵⁴ both the European Union Intellectual Property Office (EUIPO) and the General Court initially refused the trademark application, citing it as contrary to public morals.⁴⁵⁵ However, the Court of Justice of the European Union (CJEU) overturned this decision, emphasizing that the concept of “accepted principles of morality” referred to “the fundamental moral values and standards to which a society adheres at a given time,” which are likely to change over time, and should be analyzed in view of the social context; the cultural, religious, or philosophical diversities”; and “the Regulations in a way that ensures respect for fundamental rights and freedoms.”⁴⁵⁶ The CJEU highlighted that the mark, being the name of a popular comedy film series in Germany, was perceived by viewers as humorous or satirical, which,

⁴⁴⁹ CONSTITUTION OF THE REPUBLIC OF TURKEY, 2017, art. 26; European Convention on Human Rights (ECHR) art. 10, Sept. 3, 1953.

⁴⁵⁰ ÇOLAK, *supra* note 391, at 264.

⁴⁵¹ MEMİŞOĞLU, *supra* note 4, at 798. *See also* Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y., 447 U.S. 557, 564 (1980) (outlining criteria that must be satisfied to justify regulating commercial speech, such as a state’s “substantial interest”).

⁴⁵² SARI, *supra* note 446, at 276.

⁴⁵³ Case T-52/13, Eřag Trademark Co. v. OHIM, ECLI:EU:T:2013:596, ¶ 24 (Nov. 14, 2013). Similarly, “Ficken Liquors” trademark also rejected. *Id.*

⁴⁵⁴ Case T-69/17, Constain Film Produktion v. EUIPO, ECLI:EU:T:2018:27 (Jan. 24, 2018).

⁴⁵⁵ Case T-69/17, *supra* note 454, at ¶¶ 4, 11.

⁴⁵⁶ Cheryl Payne & Julius Stobbs, *Trade Mark case: FACK JU GÖHTE – Constantin Film Produktion v EUIPO*, WOLTERS KLUWER: KLUWER TRADEMARK BLOG (Mar. 19, 2020), <https://trademarkblog.kluweriplaw.com/2020/03/19/trade-mark-case-fack-ju-gohte-constantin-film-produktion-v-euipo/>.

combined with its educational use by the Goethe Institute, did not create an offense against public policy or morality.⁴⁵⁷

IV. COMPARATIVE ANALYSIS OF THE APPROACHES IN THE UNITED STATES AND TURKEY

In today's global market, enterprises increasingly adopt aggressive marketing strategies not only to capture and retain customer bases but also to stand out in a crowded marketplace.⁴⁵⁸ Trademarks serve as the primary tool for companies to communicate with current and potential customers, and some businesses resort to provocative and potentially offensive trademarks to create a memorable, aggressive, and sometimes shocking brand image. These strategies aim to cut through the market noise and boost market share by targeting specific demographics, such as the youth, and may intentionally alienate conservative sections of society to strengthen the brand's appeal to its intended audience.⁴⁵⁹ Such practices can sometimes yield higher commercial profits by capitalizing on the controversy or by using marginalized social or ethnic groups in their marketing campaigns.⁴⁶⁰ However, these trademarks also face various legal barriers in terms of registration and protection due to their potential to offend public morals and policy.

There are both national and international rules for these legal barriers. On the international front, key treaties like the Paris Convention for the Protection of Industrial Property, the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), and the Madrid System for the International Registration of Marks facilitate a more standardized approach to trademark registration across borders.⁴⁶¹ These frameworks aim to simplify the process for businesses operating internationally, ensuring that trademarks registered in one country can achieve recognition and similar protection in others, subject to local laws.⁴⁶² This requirement for harmonization also created some international organizations such as the World Intellectual Property Organization (WIPO).⁴⁶³

In the context of the European Union, harmonization is further emphasized through directives and regulations such as the European Union Trademark Regulation (EUTMR), which sets uniform standards for trademark registration and enforcement across member states.⁴⁶⁴ This includes handling trademarks that may

⁴⁵⁷ YASAMAN ET AL., *supra* note 27, at 497.

⁴⁵⁸ Bonadio, *supra* note 99, at 43.

⁴⁵⁹ *Id.* at 43.

⁴⁶⁰ MEMİŞOĞLU, *supra* note 4, at 747.

⁴⁶¹ KARASU ET AL., *supra* note 371, at 58.

⁴⁶² Irene Calboli, *Trademarks: International Harmonization of National Laws*, ELGAR ENCYCLOPEDIA COMPAR. L., Jan. 9, 2014, at 8.

⁴⁶³ There are even organizations like INTA that have advocacy groups. See *Harmonization of Trademark Law and Practice Committee*, INTA, <https://www.inta.org/committees/harmonization-of-trademark-law-and-practice-committee/> (last visited Apr. 14, 2024).

⁴⁶⁴ MEMİŞOĞLU, *supra* note 4, at 69.

conflict with public policy or morality, which are often assessed under similar criteria across the EU to prevent disparities in trademark protection.⁴⁶⁵

Both the United States and Turkey are parties to some of these agreements; however, despite some similarities, as will be analyzed below, differences in their cultural and legal norms create significant variations in the treatment of immoral, scandalous, and disparaging marks, specifically after the decision of the Supreme Court in *Tam* and *Brunetti*.⁴⁶⁶

This section will first discuss the importance of international agreements for uniformity in trademark law, then compare the approaches of the United States and Turkey towards offensive trademarks, noting their differences and similarities. It proposes adjustments to better handle immoral, scandalous, and disparaging marks for both countries, with narrowly drawn statutes, by aiming to achieve a more unified and effective system for managing trademarks nationally and internationally, ensuring that commercial interests, trademark principles, and fundamental freedoms are safeguarded alongside societal values.

A. International Treaties and the Need for Uniformity in a Global Economy Balanced with Respect for Individual Country Values and Norms

The first treaty to be discussed is the Paris Convention for the Protection of Industrial Property, which dates back to 1883 with the last revision made in 1979.⁴⁶⁷ The Convention creates a Union between member countries⁴⁶⁸ and aims to harmonize the protection of industrial property rights, including trademarks by affording a minimum level of protection within the member countries.⁴⁶⁹ It mandates equal treatment for nationals of all member states, ensuring no discriminatory practices in trademark protection within the Union (national treatment).⁴⁷⁰ It provides the possibility of claiming priority based on an earlier application from one member country to another, facilitating simpler and faster processes for registrants expanding internationally.⁴⁷¹

Under Article 6, the Paris Convention grants member states the autonomy to establish their own trademark registration rules: “(1) The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation.”⁴⁷² However, it also introduces the ‘*telle quelle* principle,’

⁴⁶⁵ EUR. UNION TRADEMARK REGUL. (EUTMR) 2017/1001 art. 7(1)(f), 2017 O.J. (L 154) 1.

⁴⁶⁶ MEMİŞOĞLU, *supra* note 4, at 775–76, 797, 807.

⁴⁶⁷ P. Sean Morris, *Private Intellectual Property Regulation in Public International Law*, 26 U.C. DAVIS J. INT’L L. & POL’Y 147, 151 n.8 (2020).

⁴⁶⁸ Paris Convention for the Protection of Industrial Property art. 1(1), Mar. 20, 1883, 21 U.S.T. 1583 [hereinafter Paris Convention].

⁴⁶⁹ *Id.* art. 25.

⁴⁷⁰ *Id.* art. 2–3.

⁴⁷¹ *Id.* arts. 4, 11; *WIPO-Administered Treaties*, WIPO, https://www.wipo.int/wipolex/en/treaties/ShowResults?search_what=C&treaty_id=2 (last visited Apr. 15, 2024).

⁴⁷² *Id.* art. 6.

which translates to ‘as is’ in French.⁴⁷³ This principle mandates that a trademark registered in one member state must be accepted for registration in the same form in other member states, thus promoting consistency in trademark registrations across borders.⁴⁷⁴ Article 6 stipulates that “(1) Every trademark duly registered in the country of origin shall be accepted for filing and protected as is in the other countries of the Union, subject to the reservations indicated in this Article.”⁴⁷⁵ One such reservation allows for the rejection of trademarks that are “contrary to morality or public order.”⁴⁷⁶ Nonetheless, this reservation specifies that “a mark may not be considered contrary to public order for the sole reason that it does not conform to a provision of the legislation on marks, except if such provision itself relates to public order.”⁴⁷⁷

The United States joined this treaty in 1887, and Turkey followed in 1925.⁴⁷⁸ As explained above, Turkey currently uses very similar language as an absolute registration bar.⁴⁷⁹ However, in the U.S., this bar was categorized under different names: immoral, scandalous, and disparaging.⁴⁸⁰ As will be explained in the next section, these bars are narrower than the bar against marks that are “contrary to morality or public order.”⁴⁸¹ Thus, we can say it complied with the Convention. Following the Supreme Court decisions in *Tam* and *Brunetti*, there is no such restriction in the Lanham Act anymore.⁴⁸² In the “The Rise of Failure to Function” section, we discussed whether failure to function and other doctrines could be used to bar some marks that would have been rejected before *Tam* and *Brunetti*. Although it is possible to use this doctrine for some marks, whether it is in harmony with the Paris Convention is another question. The reservation clause that members can utilize is not limited to bars against trademarks that are “contrary to morality or public order.”⁴⁸³

⁴⁷³ Graeme B. Dinwoodie, *Trademarks and Territory: Detaching Trademark Law from the Nation-State*, 41 HOUSTON L REV 886, 903 (2004).

⁴⁷⁴ *Id.* at 903–04.

⁴⁷⁵ Paris Convention, *supra* note 468, art. 6quinquies (A)(1).

⁴⁷⁶ *Id.* art. 6quinquies (B)(3).

⁴⁷⁷ *Id.*

⁴⁷⁸ *WIPO-Administered Treaties*, *supra* note 471.

⁴⁷⁹ GÜNEŞ, *supra* note 21, at 520.

⁴⁸⁰ 15 U.S.C. § 1052(a).

⁴⁸¹ Specifically, because of the “public policy” bar; public policy may encompass all rules that facilitate the proper functioning of public services, ensure the security and stability of the state, and uphold legal, peaceful, and moral standards in interpersonal relationships, thereby supporting the preservation of the state and its structures. YASAMAN ET AL., *supra* note 27, at 491.

⁴⁸² *Tam*, 582 U.S. at 247; *Iancu*, 588 U.S. at 398.

⁴⁸³ Paris Convention, *supra* note 468, art. 6quinquies (B)(1–2) (“Trademarks covered by this Article may be neither denied registration nor invalidated except in the following cases: 1. when they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed; 2. when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed;”).

In addition to creating the Union, the Convention establishes an organization under Article 15, the International Bureau, to perform administrative tasks.⁴⁸⁴ However, this organization was later incorporated into the World Intellectual Property Organization,⁴⁸⁵ which is one of the specialized agencies of the United Nations (UN), created in 1967 by the Convention Establishing the World Intellectual Property Organization.⁴⁸⁶ This organization also has similar objectives: to promote the protection of intellectual property throughout the world through cooperation among States and to ensure administrative cooperation among the Unions.⁴⁸⁷

To achieve these objectives, this special agency administers the filing of trademark applications in multiple countries with a single application under the Madrid Agreement Concerning the International Registration of Marks (Madrid Agreement) and the Protocol Relating to the Madrid Agreement (Madrid Protocol).⁴⁸⁸ The system established by these is called the Madrid System, and there are 130 member countries, including both the United States and Turkey.⁴⁸⁹ After receiving the application, WIPO forwards it to the national offices of the countries specified by the applicant.⁴⁹⁰ These offices independently review the application and grant the respective national trademarks.⁴⁹¹ These marks confer the same rights and adhere to the same regulations as if the applications had been submitted directly to each individual country.⁴⁹² Therefore, these treaties focus on the procedural system of registration rather than substantive grounds for refusal.

Another significant international agreement is the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), established by the World Trade Organization (WTO) in 1994.⁴⁹³ TRIPS, which includes all WTO members including both Turkey and the United States, aims to harmonize and set down minimum standards for many forms of intellectual property regulation as part of the global trade framework.⁴⁹⁴ TRIPS often references the Paris Convention, reinforcing its principles and adding new rules, thus ensuring the incorporation of

⁴⁸⁴ Paris Convention, *supra* note 468, art. 15.

⁴⁸⁵ Minde Glenn Browning, *International Trademark Law: A Pathfinder and Selected Bibliography*, 4 IND. INT'L & COMP. L. REV. 339, 341 (1994).

⁴⁸⁶ *About WIPO*, WIPO, <https://www.wipo.int/about-wipo/en/> (last visited Oct. 7, 2024).

⁴⁸⁷ Paris Convention, *supra* note 468, art. 1 (establishing the World Intellectual Property Organization).

⁴⁸⁸ Morris, *supra* note 467, at 175.

⁴⁸⁹ *Madrid Protocol Countries*, JAMES & WELLS, <https://www.jamesandwells.com/wp-content/uploads/madrid-protocol-countries-list.pdf> (last visited Apr. 20, 2024).

⁴⁹⁰ Calboli, *supra* note 462, at 7.

⁴⁹¹ *Id.* at 8.

⁴⁹² *Id.*

⁴⁹³ *TRIPS — Trade-Related Aspects of Intellectual Property Rights*, WORLD TRADE ORG., https://www.wto.org/english/tratop_e/trips_e/trips_e.htm (last visited Apr. 20, 2024).

⁴⁹⁴ Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, <https://www.wipo.int/wipolex/en/text/305736> [hereinafter TRIPS] (“Members, desiring to reduce distortions and impediments to international trade, and taking into account the need to promote effective and adequate protection of intellectual property rights, and to ensure that measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade[.]”).

its foundational standards into the broader international trade system.⁴⁹⁵ However, while the Paris Convention includes a provision in Article 27(2) allowing members to exclude patents from protection “to protect order public or morality,” it notably does not extend this specific exclusion to trademarks.⁴⁹⁶

Even though both the United States and Turkey are not members of the EU,⁴⁹⁷ EU regulations significantly influence global harmonization of trademark law, and they can show how a “regional” economy can be balanced with respect for individual country values and norms.⁴⁹⁸ The European Union Intellectual Property Office, as an independent legal agency of the EU, extends its work to the harmonization of registration practices and the development of common tools in cooperation with its partners from national and regional intellectual property offices throughout the EU, as well as users and other institutional partners.⁴⁹⁹ The EU trademark registration system has an autonomous structure and operates independently from the member state systems; registration of a Union trademark⁵⁰⁰ occurs under the auspices of EUIPO.⁵⁰¹

As mentioned above in the Turkish Law section, the EU also has absolute grounds for refusing “trademarks which are contrary to public policy or to accepted principles of morality.”⁵⁰² Understanding how a Union with 27 members can apply “public policy” and “accepted principles of morality” concepts in harmony requires an independent and substantial analysis. Therefore, here, we will give a sample case and move on to the next section.

In the case of *Couture Tech Ltd. v. Office for Harmonisation in the Internal Market* (OHIM),⁵⁰³ the General Court addressed a community figurative mark (EU trademark) application representing the Soviet coat of arms.⁵⁰⁴ This case provides a clear example of how the European Union’s trademark system, while autonomous, does not disregard the perceptions and specific conditions of its member states when applying regulations. Specifically, Article 7(1)(f) of Regulation No. 207/2009, concerning the refusal of marks contrary to public policy or accepted principles of

⁴⁹⁵ See Lisa P. Ramsey, *Free Speech and International Obligations to Protect Trademarks*, 35 YALE J. INT’L L. 405, 410 (2010) (making general comments on how both Paris Convention and TRIPS standards are applied in the same situations).

⁴⁹⁶ TRIPS, *supra* note 494, art. 27(2).

⁴⁹⁷ Turkey has been an applicant to accede to the EU since 1987 and has been a member of the European Union Customs Union since 1995, as well as a member of another Europe-wide IP law institution, the European Patent Office, since 2000. See *Türkiye*, EUROPEAN COMM’N, https://neighbourhood-enlargement.ec.europa.eu/enlargement-policy/turkiye_en (last visited Oct. 10, 2024).

⁴⁹⁸ Ulrich Loewenheim, *Harmonization and Intellectual Property in Europe*, 2 COLUM. J. EUR. L. 481, 481 (1996).

⁴⁹⁹ *Who we are*, EUIPO, <https://www.euipo.europa.eu/en/the-office/about-us> (last visited Apr. 20, 2024).

⁵⁰⁰ Named as Community Trade Mark (CTM) until 23 March 2016.

⁵⁰¹ *Guidelines for Examination*, EUR. UNION INTELL. PROP. OFF. 5 (Mar. 31, 2024), <https://guidelines.euipo.europa.eu/binary/2214311/2000000000>.

⁵⁰² EUTMR art. 7(1)(f), 2017 O.J. (L 154).

⁵⁰³ Case T-232/10, *Couture Tech Ltd. v. Office for Harmonisation in the Internal Market* (OHIM), 2011 E.C.R. II-6472.

⁵⁰⁴ *Id.*

morality, requires an assessment that considers the diverse perceptions across the Union.⁵⁰⁵ This regulation demands that the review of a mark's acceptability must account for the specific societal context of individual member states, which may vary significantly due to cultural, historical, or social reasons.⁵⁰⁶

In this instance, the General Court upheld the refusal to register the mark, emphasizing that the relevant public in Hungary would perceive the Soviet symbols included in the mark, namely, the hammer and sickle and the five-point red star, as contrary to public policy or morality.⁵⁰⁷ This perception was influenced by Hungarian legislation that prohibits the use of symbols associated with despotism, reflecting a distinct national historical experience and moral standards.⁵⁰⁸ The court's decision illustrates how EU trademark law accommodates the moral and public order standards of individual member states while maintaining a coherent system across the Union. This approach ensures that trademarks registered in the EU respect the varied cultural and historical contexts of its diverse membership.

In conclusion, international treaties like the Paris Convention and the TRIPS Agreement or international organizations like WIPO or EUIPO aim for uniformity in trademark laws globally or regionally while respecting individual country norms. This balance is crucial for trademarks potentially seen as immoral or scandalous, as cultural perceptions can vary widely across and within countries over time. The European Union's handling of such trademarks, exemplified by the *Couture Tech Ltd. v OHIM* case, underscores the importance of considering local views in trademark regulation. However, cultural perceptions of potentially immoral or scandalous trademarks can vary significantly not only between countries but also within a single country over time, as evidenced by previous cases such as R*****S or FETULLAH GÜLEN.

B. Specific Similarities and Differences Between the United States and Turkey

Both the U.S. and Turkey are signatories to major international trademark treaties, such as the Paris Convention, the Madrid Agreement, and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). This membership obliges both countries to adhere to certain basic standards of trademark protection and registration, ensuring a degree of uniformity that facilitates international business operations.

In both jurisdictions, the definitions of trademarks are similar, and their functions are nearly identical; they identify the source and distinguish one undertaking's goods and services from others—allowing them to provide protection

⁵⁰⁵ 2009 O.J. (L 78), art. 7(1)(f).

⁵⁰⁶ See Case T-232/10, *supra* note 503, at 6483 (holding “it is necessary to take account not only of the circumstances common to all Member States of the European Union, but also of the particular circumstances of individual Member States which are likely to influence the perception of the relevant public within those States”).

⁵⁰⁷ *Id.* at 6491.

⁵⁰⁸ *Id.* at 6489.

and incentives for both undertakings and customers.⁵⁰⁹ They also have similar requirements to fulfill these functions. The defining provisions in both jurisdictions first require a sign or combinations of signs and mandate that it be capable of identifying and distinguishing. Each jurisdiction recognizes that distinctiveness can be inherent, where the mark is distinctive by its very nature,⁵¹⁰ or acquired over time due to its use.⁵¹¹ Similarly, they both require trademarks to be non-functional.⁵¹²

In U.S. law, “use” is another requirement for trademark registration. Essentially, a trademark must be used in a manner that aligns with the general standards of trademark use.⁵¹³ A trademark application must include, among other elements, a verified statement regarding the mark's use or intended use in connection with specified goods or services, accompanied by a “specimen” showing the mark as used in commerce.⁵¹⁴ However, in Turkish law, unlike U.S. law, trademark use is not a requirement for registration, but the law imposes a duty on trademark owners to use their marks.⁵¹⁵ When this duty is not fulfilled by genuine use in Turkey within five years after registration,⁵¹⁶ or if the trademark is not used genuinely for any five-year period after registration, non-use can lead to the possibility of the trademark being canceled.⁵¹⁷

This difference between the two jurisdictions shows that, while failure to function can be used as an effective registration bar (with even more importance following the decisions in *Tam* and *Brunetti*), in Turkey, it cannot apply as effectively as in the United States, because at the registration phase, the TPTO has no authority to assess whether a trademark is used in a manner consistent with trademark use.

Both jurisdictions allow for the protection of trademarks even without registration, and both provide significant benefits for registered trademarks.⁵¹⁸ In the United States, registration offers benefits such as prima facie proof of validity and ownership, exclusive rights to use, constructive use granting nationwide priority, constructive notice to others, potential incontestable status after five years, enhanced ability to prevent importation of infringing goods, and access to a broader range of legal remedies in infringement cases.⁵¹⁹ In Turkey, registration confers

⁵⁰⁹ 15 U.S.C.A. § 1127 (2006); IPC art. 4.

⁵¹⁰ In Turkey, distinctive quality is divided into two categories: abstract and concrete. Signs that fail to differentiate one undertaking's products or services from those of others cannot be registered as trademarks under Article 4 of IPC, which emphasizes “abstract distinctiveness.” Conversely, “concrete distinctiveness” is evaluated by determining whether a sign can specifically distinguish the goods or services for which registration is sought from those offered by others. KARASU ET AL., *supra* note 371, at 185.

⁵¹¹ SCHECHTER, *supra* note 42, at 53–55; IPC art. 5(2).

⁵¹² LAFRANCE, *supra* note 8, at 9; IPC art. 5(1)(e).

⁵¹³ Roberts, *supra* note 54, at 1981.

⁵¹⁴ *Id.* at 2043.

⁵¹⁵ ÇOŞĞUN, *supra* note 377, at 27.

⁵¹⁶ IPC art. 9(1) (providing a grace period of five years to the trademark owner to commence use of the mark).

⁵¹⁷ *Id.*

⁵¹⁸ *Tam*, 582 U.S. at 225–26.

⁵¹⁹ *Id.* at 226–27; *Brunetti*, 588 U.S. at 390–91.

rights to prevent unauthorized use, prohibit generic use in reference works, validate the trademark officially, and pursue specific criminal and civil actions against infringers that are not available to unregistered trademark owners.⁵²⁰ Because of these benefits, in both jurisdictions, it is accepted that refusal of registration deprives these advantages and also abridges freedoms.⁵²¹

Even though the general definitions of trademark and the main requirements for trademark registration are similar in both jurisdictions except for the use requirement, specific registration bars and their regulations vary significantly. In the United States, registration bars are governed by Section 2 of the Lanham Act, and the USPTO examiner assesses these ex officio after a trademark application is submitted.⁵²² If bars do not apply, the application is published in the Official Gazette for 30 days, during which third parties can oppose the registration on the same grounds outlined in Section 2.⁵²³ By contrast, in Turkey, which aligns closely with the European system, there are two types of registration bars: absolute grounds for refusal and relative grounds for refusal. The first is analyzed ex officio by the examiner, while the second is only considered if a third party objects to the trademark application after it is published in the Official Gazette following approval for absolute grounds.⁵²⁴ During and after publication, third parties can also object on the basis of absolute grounds.⁵²⁵ For example, if the sign and goods are “identical to or indistinguishably similar to a trademark” previously registered, it will be analyzed ex officio under Article 5(1)(ç) of the IPC, but if a sign and goods are merely similar and could create a likelihood of confusion, it will only be analyzed upon opposition from third parties under Article 6(1) of the IPC.⁵²⁶

Both jurisdictions aim to bar marks that could harm public decency or are offensive, vulgar, or exploitative of sensitive content, as allowed under the Paris Convention.⁵²⁷ In the United States, bars for immoral, scandalous, and disparaging marks were regulated under Section 2 of the Lanham Act, along with deceptive marks.⁵²⁸ However, the USPTO treated immoral and scandalous marks as a unitary provision, while treating other categories separately.⁵²⁹ In Turkey, without using the same words in the U.S. law, and mostly aligning with the language of the Paris Convention and European law, there is a bar against marks “contrary to public policy or accepted principles of morality.”⁵³⁰ Public order and public morality are distinct terms, but typically, the Court of Cassation and the USPTO examine them jointly.⁵³¹

⁵²⁰ ÇETİN *supra* note 356, at 38; GÜNEŞ *supra* note 21, at 7.

⁵²¹ See 15 U.S.C. § 1063.

⁵²² SCHECHTER & THOMAS, *supra* note 42, at 39.

⁵²³ 15 U.S.C.A. §§ 1062–63 (2020 & 2006).

⁵²⁴ GÜNEŞ, *supra* note 21, at 437.

⁵²⁵ IPC art. 18.

⁵²⁶ IPC arts. 5(1)(ç), (6)(1).

⁵²⁷ ÇOLAK, *supra* note 391, at 259.

⁵²⁸ 15 U.S.C. § 1052.

⁵²⁹ *Iancu*, 588 U.S. at 391 (quoting *In re Brunetti*, 877 F.3d 1330, 1336 (C.A. Fed. 2017)).

⁵³⁰ IPC art. 5(1)(i).

⁵³¹ DOĞAN, *supra* note 341, at 96.

In the United States, prior to the *Tam* and *Brunetti* decisions, a mark was assessed to determine if a “substantial composite of the general public” perceived the mark as “shocking to the sense of truth, decency, or propriety”; “giving offense to the conscience or moral feelings”; “calling out for condemnation”; “disgraceful”; “offensive”; “disreputable”; or “vulgar.”⁵³² Similarly, in Turkey, the evaluation under “accepted principles of morality” involves examining the standard of judgments and understanding of morality adopted by the majority of society at a given time and assessing whether the trademark harms the material, spiritual, and social integrity and values of the public.⁵³³

Both jurisdictions analyze their respective provisions in relation to the goods and services identified in the application.⁵³⁴ Similarly, both consider the public's perception and accept that the understanding of these concepts can evolve with prevailing societal attitudes at the time of evaluation.⁵³⁵ However, because of the inclusion of “public policy” in the IPC, the scope of prohibition is broader than that in the United States even before *Tam* and *Brunetti*.

The concept of “public policy” generally overlaps with “accepted principles of morality”;⁵³⁶ however, it also encompasses all rules that facilitate the proper functioning of public services, ensure the security and stability of the state, and uphold legal, peaceful, and moral standards in interpersonal relationships, thus supporting the preservation of the state and its structures.⁵³⁷ This, for example, includes barring trademarks that “disparage” a substantial composite of the public or a referenced group,⁵³⁸ such as marks containing racist or discriminatory signs. However, in addition to these, public policy may cover rules that ensure the security and stability of the state.⁵³⁹ Thus, this provision can work to bar trademark applications that might mislead the public by appearing to represent official institutions, as in the “Data Protection Authority” example, or refuse the “double happiness” trademark for cigarettes or tobacco because it contradicts public health policies—a crucial aspect of public policy.⁵⁴⁰

In both countries, trademarks are recognized to function as a concise method for communicating information and messages.⁵⁴¹ As previously discussed, in both jurisdictions, the refusal of trademark registration not only deprives the applicant of certain benefits but also necessitates evaluations from the viewpoint of a “substantial composite of the general public,” with an additional layer of public policy considerations in Turkey.⁵⁴² However, while the United States deemed such provisions as unconstitutionally limiting free speech under the First Amendment, similar provisions continue to be enforced in Turkey and the EU. This divergence

⁵³² See *Iancu*, 588 U.S. at 391.

⁵³³ See GÜNEŞ, *supra* note 21, at 125; ÇOLAK, *supra* note 391, at 259.

⁵³⁴ See generally MEMİŞOĞLU, *supra* note 4.

⁵³⁵ *Id.*

⁵³⁶ DOĞAN, *supra* note 341, at 96.

⁵³⁷ YASAMAN ET AL., *supra* note 27, at 491.

⁵³⁸ GÜNEŞ, *supra* note 21, at 520.

⁵³⁹ U.S. Const. art. 1 § 8.

⁵⁴⁰ See ÇOLAK, *supra* note 391, at 259.

⁵⁴¹ OCHOA ET AL., *supra* note 3, at 466; KARASU ET AL., *supra* note 371, at 185.

⁵⁴² MEMİŞOĞLU, *supra* note 4, at 765, 767, 771, 773, 800.

primarily results from the distinct legal frameworks governing free speech in these jurisdictions, which operate under civil law systems. Unlike the U.S. Constitution, which offers no exceptions for free speech, both the Turkish Constitution and Article 10 of the European Convention on Human Rights allow for restrictions on speech for reasons such as national security, public order, public safety, protecting the reputation or rights of others, and preserving private and family life, or safeguarding professional secrets as prescribed by law.⁵⁴³ Therefore, even though these provisions may impinge on free speech, they remain valid under Turkish and EU law. If the regulatory frameworks of Turkey or the EU were applied within the United States, they would likely face the same challenges that led to the decisions in *Matal v. Tam* and *Iancu v. Brunetti*.

This, however, does not grant a free pass for the TPTO and courts to apply these provisions arbitrarily. They must be applied narrowly with a solid legal basis and respect for freedoms.⁵⁴⁴ This approach does not necessarily align with the fixed narrow interpretation proposed by the government and is also supported by Justices Roberts, Breyer, and Sotomayor in the *Brunetti* case⁵⁴⁵—such as restricting the Patent and Trademark Office to refusing marks that are explicitly “vulgar,” meaning “lewd,” “sexually explicit,” or “profane,” and saving the provision to repeal.⁵⁴⁶ Instead, it calls for a case-by-case, fact-based analysis that ensures a balanced application of trademark laws, safeguarding both public interests and individual freedoms.

V. PROPOSALS FOR CHANGE AND CONCLUSION

There is an undeniable significant interest protected by the First Amendment.⁵⁴⁷ However, it is also widely accepted that there is a substantial governmental interest in protecting “underrepresented groups” from disparaging or racist treatment in many contexts;⁵⁴⁸ shielding the public and children from “highly offensive” or “vulgar” terms or signs; as well as preventing marks that incite criminal activities or commercialize terrorist organizations or terrorists convicted following democratic prosecutions, and marks that could mislead the public by appearing to represent official institutions.⁵⁴⁹

⁵⁴³ PC art. 5(1)(i); EUTMR art. 7(1)(f), 2017 O.J. (L 154).

⁵⁴⁴ See IPC art. 4.

⁵⁴⁵ The statement of concurring Justice Alito in the *Brunetti* case is worthwhile to remember: “Viewpoint discrimination is poison to a free society. But in many countries with constitutions or legal traditions that claim to protect freedom of speech, serious viewpoint discrimination is now tolerated, and such discrimination has become increasingly prevalent in this country.” *Iancu*, 588 U.S. at 388.

⁵⁴⁶ *Id.*

⁵⁴⁷ *In re Elster*, 26 F.4th at 1334.

⁵⁴⁸ See generally Huang, *supra* note 257; Mackay, *supra* note 165; Victoria F. Phillips, *Beyond the Trademark: The Washington Redskins Case and the Search for Dignity*, 92 CHI.-KENT L. REV. 1061, 1061 (2017).

⁵⁴⁹ See 15 U.S.C. 1117(b)–(c), 1124; see also U.S. Const. art. 1 § 8.

As previously discussed, some of these marks may be filtered by consumers or the public, as seen in the case of the R*****S,⁵⁵⁰ Quaker Oats, or Dixie Chicks.⁵⁵¹ However, while it is possible that such marks can appeal to many people in the population, certain companies may specifically aim to target consumers who are drawn to controversial marks precisely because of their highly offensive nature. Additionally, people, even within the referenced group, may disagree with respect to the meaning of marks with multiple meanings, the level of offensiveness of those marks,⁵⁵² and in certain contexts, whether more of a lean toward protecting Free Speech may be required such as in describing a historical situation. Importantly, the bars on registration were just that—bars on federal registration. Groups can continue to utilize those terms in commerce and may even receive common law trademark protection. Moreover, societal acceptance or rejection of such marks can be slow to evolve, as demonstrated by the prolonged controversy surrounding the R*****S, during which an “underrepresented group”⁵⁵³ continued to be disparaged. This slow pace can exacerbate the harm to these groups, underscoring the need for more proactive regulatory measures that can swiftly address and mitigate such issues. However, at the same time, the ability to have those marks registered by certain groups allows others to track those groups as they “out” their racist beliefs, for example.⁵⁵⁴

Similarly, some marks may be refused registration because they fail to function as trademarks. This approach can help bar marks that do not distinguish due to their semantic implications, such as being commonplace terms, names, merely ornamental, or not used in a manner typical of trademarks, etc.⁵⁵⁵ However, many marks that are distinctive and function as trademarks may still be highly offensive.⁵⁵⁶ The government interests mentioned above are interests that go beyond the government interests with trademark law’s main functions.⁵⁵⁷ Additionally, this

⁵⁵⁰ See *Harjo*, 565 F.3d at 882.

⁵⁵¹ See generally *Lee*, *supra* note 36.

⁵⁵² Notably, courts have recognized changing social perceptions with respect to the offensiveness of terms. *Tam*, 582 U.S. at 223.

⁵⁵³ The team changed its name following significant controversy over its branding. For decades, the name was a point of contention. In 2020, amid heightened awareness of the Native American mascot controversy and following the George Floyd protests, pressure from NFL and team sponsors led to the retirement of the R*****s name. The team operated as the Washington Football Team for two seasons before adopting the new name, the Commanders, in 2022. *Washington Commanders*, WIKIPEDIA, https://en.wikipedia.org/wiki/Washington_Commanders. (Oct. 11, 2024, 1:18 PM).

⁵⁵⁴ Gratitude to Professor Michael Olivas.

⁵⁵⁵ See GÜNEŞ, *supra* note 21; IPC arts. 5–6.

⁵⁵⁶ See IPC art. 30(1). Although there can be arguments that it is not functioning as a trademark due to its commonplace widely use in public discourse, Brunetti successfully registered his trademark “FUCT” and other similar marks following the Supreme Court’s decision, despite the Court characterizing it as “highly offensive.” FUCT, Registration No. 6,230,977; FUCT, Registration No. 6,441,606.

⁵⁵⁷ MEMİŞOĞLU, *supra* note 4, at 749. For example, in Turkey, one criticism of the regulations that bar marks contrary to public policy and accepted principles of morality is that these marks do not directly harm consumers or mislead them; therefore, this provision falls outside the primary functions of trademark law. *Id.*

theory can be incoherent, lacking clarity, and being based on inconsistent multifactor tests.⁵⁵⁸ Moreover, a failure-to-function bar may be unconstitutional as applied to specific scenarios. The TTAB's decision in *In re Dan Gatsby* is interesting because Mr. Gatsby provided a hangtag with the trademark on it to prove trademark usage.⁵⁵⁹ Certainly, consumers will realize that words on a hangtag that are not descriptive of the product or service are likely a trademark as long as distinctiveness requirements are satisfied. From a viewpoint of a hangtag as a traditional presentation of a trademark use that consumers are conditioned to understand as a trademark, the court seems to require a consumer survey or testimony as to trademark usage. If the facts were changed and instead of the mark in *Gatsby* there is an arguably disparaging mark then depending on the mark, there could be a constitutional issue as applied to that case even though the failure to function doctrine is itself facially valid.

Some governmental interests mentioned above may possibly be achieved with provisions that do not discriminate based on viewpoint—targeting only the mode of expression, thus addressing marks that are obscene, vulgar, or profane. Such regulations must be narrowly tailored to avoid being overbroad. However, there may be issues with respect to determining when something is obscene, vulgar, or profane. This could raise issues with respect to whether there may be a constitutional problem with how the statute is applied depending on the context and the mark.

Moreover, some of these interests are inherently challenging to regulate without introducing viewpoint discrimination. For instance, protecting democracy and underrepresented groups by refusing trademarks that disparage them may inherently involve viewpoint discrimination. At this juncture, legislators must decide whether to draft provisions as narrowly as possible to attempt to comply with the First Amendment. This approach may possibly grant the government the flexibility to use specific exceptions and to interpret provisions narrowly, safeguarding both public interests and individual freedoms when confronted with First Amendment challenges notwithstanding potential issues with the application of the statute.

In *Brunetti*, although concurring Justice Alito insisted that the Supreme Court should firmly reject viewpoint discrimination, he acknowledged that “in many countries with constitutions or legal traditions that claim to protect freedom

⁵⁵⁸ Lucas D. Cuatrecasas, *Failure to Function and Trademark Law's outermost Bound*, 96 NYU L. REV. 1312, 1316 (2021). Mr. Cuatrecasas states: [T]he failure-to-function doctrine is incoherent. Overall, it lacks clarity. On a more granular level, the doctrine rests on inconsistent multifactor tests whose factors the TTAB adds, subtracts, modifies, reconceptualizes, and weighs differently across cases, giving the USPTO little meaningful criteria by which to decide what marks merit registration. This inconsistency poses threats. On the one hand, the doctrine's lack of stable criteria creates incentives to flood the USPTO with meritless applications in the hopes of pushing through a weak or invalid mark. On the other hand, an unclear doctrine may raise the costs of market entry and of building a brand by making it riskier for brands to adopt certain marks in the first place. It likewise risks making it harder for consumers to differentiate between brands, an outcome directly opposed to trademark law's goals. *Id.*

⁵⁵⁹ *In re Dan Gatsby*, 2024 WL 3025971 at *1, *22 (Trademark Tr. & App. Bd. 2024).

of speech, serious viewpoint discrimination is now tolerated.”⁵⁶⁰ Contrary to Justice Alito, dissenting Justice Breyer supported a narrower interpretation and argued that the trademark statute does not neatly align with existing definitive legal categories for the First Amendment by questioning the necessity of strictly adhering to these classifications.⁵⁶¹ Instead, he advocated for a focus on the First Amendment’s protected interests, proposing a more fundamental query: whether the regulation in question disproportionately harms First Amendment rights relative to its regulatory objectives.⁵⁶² Justice Breyer’s view aligns more closely with those adopted by European countries, which have more limited free speech protections under the European Convention on Human Rights, which allows exceptions for free speech.⁵⁶³ When language fails to draw a clear provision that protects one interest without infringing upon another, it is more effective to conduct case-by-case, factual analyses. By narrowing the less substantial interest but still safeguarding both interests proportionally, this method may be better than establishing rigid, categorical lines that do not allow a narrower interpretation. But still, any statutes that can potentially abridge freedoms as a side effect must be narrowly drawn to achieve government interest. For example, the majority in *Brunetti* has the better side of the argument because before being narrowly interpreted, a provision should be drawn narrowly. Thus, the interpretation would not be rewriting the legislation passed by Congress. Ultimately, cases decided on an individual basis may be subject to the values of the decisionmaker. Thus, other countries with allowable broader bars to rejection than the United States may benefit from a list of offensive terms, particularly those impacting minority or immigrant groups, to provide consistency in the application of broader bars. At the same time, a list can be problematic as people can be very creative concerning alternative spellings and racist expressions. Some countries may benefit from the approach taken by New Zealand, which has a representative group of a minority group to opine on attempted registrations and the contents of the list of terms.⁵⁶⁴

Turkey adopts the European system and mirrors the prohibition against marks “contrary to public policy or to accepted principles of morality” in European law.⁵⁶⁵ If such a provision were implemented in the United States, it would likely be deemed unconstitutional because, under this rule, an applicant could register a positive or benign mark but not a derogatory or immoral one, which depends on the government’s analysis according to the perception of the general public. In this

⁵⁶⁰ *Iancu*, 588 U.S. at 398.

⁵⁶¹ *Id.* at 401.

⁵⁶² *Id.* at 398.

⁵⁶³ Alexander Tsesis, *Justice Breyer’s Balanced Reasoning on Free Speech: A Comparative Analysis*, 21 FIRST AMEND. L. REV. 395, 396 (2023).

⁵⁶⁴ See *Māori Advisory Committee and Māori Trade Marks*, N.Z. INTELL. PROP. OFF., <https://www.iponz.govt.nz/get-ip/trade-marks/practice-guidelines/current/maori-advisory-committee-and-maori-trade-marks/> (last visited Oct. 11, 2024).

⁵⁶⁵ IPC art. 5(1)(i).

manner, it operates as a “happy talk” provision that is not narrowly drawn.⁵⁶⁶ Under legal positivism,⁵⁶⁷ because the Turkish Constitution includes exceptions to freedom of speech, it allows for this provision, thereby rendering it constitutional. However, in a democratic society, the nature of the law necessitates narrowly tailored legal regulations when they can impact fundamental rights. Even though a narrower interpretation is advocated in legal doctrine, it still provides an opportunity to misuse the provision and potentially undermines the separation of powers by essential interpretations.

The empirical evidence concerning the impact of the *Tam* and *Brunetti* cases is interesting. As previously discussed, there was not a “flood” of applications for disparaging or scandalous marks.⁵⁶⁸ Indeed, there was an arguably positive effect of an increase in the application of apparent reappropriation registrations.⁵⁶⁹ Other countries could consider narrowing their bars to allow for greater protection of speech and may not realize the feared mass registration of offensive marks. Moreover, even though *Tam* and *Brunetti* allow for more marks to be registered in the United States, multinational companies may still consider whether a mark is registrable in other jurisdictions before attempting to register that mark in the United States. This may continue to result in a tamping down on the number of potentially offensive marks filed in the United States. In the United States, Congress has not yet enacted a new provision to replace the unconstitutional sections of trademark law, leaving the USPTO without direct statutory grounds to reject trademarks that are “immoral,” “scandalous,” or “disparaging.”⁵⁷⁰ As previously discussed, the failure-to-function doctrine can offer limited assistance, but it also

⁵⁶⁶ The statute, on its face, distinguishes between two opposed sets of ideas: those aligned with conventional moral standards and those hostile to them. For example, LGBT rights in Turkey are not respected by either the government or likely a substantial composite of the general public; see *LGBTQ rights in Turkey*, WIKIPEDIA (Sept. 29, 2024, 6:11 AM) https://en.wikipedia.org/wiki/Lgbt_rights_in_turkey#:~:text=lesbian%2c%20gay%2c%20bisexual%2c%20and,most%20other%20muslim%2dmajority%20countries. Since the TPTO does not publish its decisions and cases seldom reach higher courts like the Court of Cassation or the Supreme Court, it is challenging to find specific cases. However, a search through the TPTO’s trademark database reveals no registered trademarks containing the words “biseksüel,” “lezbiyen,” or “lgbt,” and some related applications have been rejected. In contrast, in the United States, there are numerous registered trademarks that include the English equivalents of these words. An interesting case in the United States to consider is the application of the disparagement clause on a trademark used to refer to lesbians, “Dykes on Bikes”; see *McDermott v. San Francisco Women's Motorcycle Contingent*, 240 Fed. Appx. 865, 866–67 (Fed. Cir. 2007). Thus, marks in Turkey which are “reappropriations” are likely not allowed.

⁵⁶⁷ Leroy Marceau, *Relation of Natural to Positive Law*, 18 NOTRE DAME L. REV. 22, 22–23 (1942).

⁵⁶⁸ Feliu, *supra* note 257, at 418.

⁵⁶⁹ Huang, *supra* note 257, at 1614–15.

⁵⁷⁰ As explained above, it can be discussed whether rejecting some trademarks filed through the international system, without the statutory grounds required by Article 6 quinquies of the Paris Convention, potentially lead to an infringement of the United States’s international obligations under the Paris Convention Article 25. Huang, *supra* note 257, at 1606.

has risks like inconsistent, arbitrary, and unclear application. A potential new statute that focuses solely on the mode of expression or on marks that are obscene, vulgar, or profane, as suggested by the Supreme Court,⁵⁷¹ might better serve these governmental interests.⁵⁷² However, constitutional issues remain. Regarding disparaging marks, any statute will likely, by its nature, risk viewpoint discrimination; however, if it is narrowly drafted and the legislative intent for its narrow application is made clear, it might withstand the necessary scrutiny.⁵⁷³ Again, even if held constitutional on its face, applications of that statute may fail constitutional scrutiny.

⁵⁷¹ *Iancu*, 588 U.S. at 399.

⁵⁷² For examples related to legislative fixes to *Tam* and *Brunetti*, see Giuggio, *supra* note 256, at 205–06 (building on prior legislative proposal and advocating for intersectional critical race lens to “standardize [USPTO] practices to properly combat . . . virulent rhetoric.”); Katherine K. Carey, *Preventing Tam’s “Proudest Boast” from Protecting the Proud Boys: A Response to Free Speech Absolutism in Trademark Law*, 71 EMORY L.J. 609, 649 (2022) (proposing legislative solution); Kilijanski, *supra* note 255, at 909–12 (providing guidance for legislative proposal); Michael Stephenson, *The Lanham Act’s Immoral or Scandalous Provision: Down, But Not Out*, 82 U. PITT. L. REV. 973, 978–82 (2021) (proposing legislative fix); Russ VerSteeg, *Fixing What’s Broken in §2 of the Lanham Act: Barring Registration of Obscene and Egregiously Offensive Marks*, 27 B.U. J. SCI. & TECH. 179, 180–85 (2021) (advocating for surgical, addition, and hybrid approach to draft legislative solutions).

⁵⁷³ Alexander Tsisis, *Justice Breyer’s Balanced Reasoning on Free Speech: A Comparative Analysis*, 21 FIRST AMEND. L. REV. 395, 416 (2023). This is despite the majority in the Supreme Court’s unwillingness to seriously engage with regulatory purposes, instead discounting them as violative of free-speech principles.