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Offensive Mark Owners Have an Enforcement Problem

Houston Law Review, Vol. 59, 2021

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Abstract

In *Iancu v. Brunetti*, the Supreme Court held that the Lanham Act 2(a) bars for "immoral" or "scandalous" marks are facially unconstitutional viewpoint discrimination, and thus violate a trademark owner's First Amendment rights. *Brunetti*, as well as its predecessor, *Matal v. Tam*, focused entirely on how the government might generate viewpoint discrimination at the point of trademark registration. The Court did not consider whether enforcement of trademarks—via courts of law, Customs and Border Protection, or the International Trade Commission—is government speech, and thus exempt from First Amendment free speech scrutiny. Yet the Court's seminal holding of *Shelley v. Kraemer* illustrates that once the judicial enforcement of a private right has been declared a government action, the court then determines what constitutional considerations are at issue. Analogously, enforcement of a mark should be deemed government speech, and the constitutional implications regarding the applicability of the First Amendment must be addressed from this position.

This Author argues that, even if registration triggers First Amendment protections for the mark owner against viewpoint discrimination, the same does not hold true for the enforcement of a mark against alleged infringers. The surprising upshot is that offensive, vulgar, and scandalous marks could be denied enforcement in an infringement action, a Customs seizure, or an International Trade Commission proceeding, because enforcing them through these government actions would constitute government speech and not be subject to First Amendment protections. Moreover, if these enforcement actions of a private citizen's mark would constitute government speech, then any registration is meaningless if the mark is unenforceable. It would thus make sense for the court to hold that registration of that mark is government speech as well..

Keywords: trademark, first amendment, offensive marks

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