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Offensive Mark Owners Have an Enforcement Problem

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Liebesman, Yvette Joy, Offensive Mark Owners Have an Enforcement Problem (March 29, 2021). Houston Law Review, Vol. 59.

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SAINT LOUIS UNIVERSITY SCHOOL OF LAW
Legal Studies Research Paper Series

No. 2021-13

Offensive Mark Owners Have an Enforcement Problem

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Houston Law Review, Vol. 59

Offensive Mark Owners Have an Enforcement Problem

Yvette Joy Liebesman*

59 Houston L. Rev – (forthcoming fall 2021)

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.

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I. Introduction

In 1990, Los Angeles artist Erik Brunetti launched a clothing brand, FUCT,¹ for modern streetwear.² Although ostensibly serving as an acronym for “Friends You Can’t Trust,” Brunetti chose the mark because it was a homophone of the word “fucked” and wanted people to question its pronunciation.³ For a time beginning in 1993, Brunetti operated a brick-and-mortar storefront, and in 1999, FUCT was named as one of the top forty iconic brands in fashion.⁴ Brunetti’s approach to satire in his apparel established FUCT as a pillar of 1990s

¹ Reg # 88310879

² Samuel Hine, How O.G. Streetwear Brand FUCT Took a Free Speech Case All the Way to the Supreme Court, Jan. 30, 2019, found at <https://www.gq.com/story/fuct-erik-brunetti-supreme-court-case> (last accessed October 27, 2020); FUCT, FEDTM 85310960 (2011).

³ Samuel Hine, *supra* note 2.

⁴ Id.; FUCT: Wikipedia [https://en.wikipedia.org/wiki/FUCT_\(clothing\)#cite_note-16](https://en.wikipedia.org/wiki/FUCT_(clothing)#cite_note-16), citing *Fashion's All-Time Top 40*. London, England, United Kingdom: The Face. August 1999. p. 45.

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counterculture.⁵ With the development of Internet businesses, Brunetti took FUCT online and moved operations into his home.⁶

Although it had been a mark for almost 20 years, Brunetti did not register for a federal trademark until 2011, doing so due to a number of knock-offs. When he did, he faced a hurdle in the Lanham Act's bar on registering offensive and scandalous marks.⁷ The phonetic identity to the word "fucked" typified what the U.S. Patent and Trademark Office would deem unregistrable as offensive.⁸ After an initial setback in the U.S. Patent and Trademark Office,⁹ ultimately his appeal would serve to overturn this longstanding Lanham Act prohibition.¹⁰

Using the same reasoning applied in *Matal v. Tam*,¹¹ in *Iancu v. Brunetti*,¹² the Supreme Court held that the Lanham Act's bars on registering disparaging¹³ and offensive¹⁴ marks are unconstitutional viewpoint discrimination and thus violated the First Amendment's free speech provision.¹⁵ Had these registration bans had instead been deemed government speech,¹⁶ then

⁵ *In re Brunetti*, 877 F.3d 1330, 1337 (Fed. Cir. 2017), *aff'd sub nom. Iancu v. Brunetti*, 139 S. Ct. 2294, 204 L. Ed. 2d 714 (2019) ("Mr. Brunetti used the mark in the context of "strong, and often explicit, sexual imagery that objectifies women and offers degrading examples of extreme misogyny," with a theme "of extreme nihilism—displaying an unending succession of anti-social imagery of executions, despair, violent and bloody scenes including dismemberment, hellacious or apocalyptic events, and dozens of examples of other imagery lacking in taste.")

⁶ Samuel Hine, *supra* note 2.

⁷ 15 U.S.C. § 1052(a) [2(a)] ("No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it consists or comprises immoral . . . or scandalous matter.")

⁸ *In re Brunetti*, 2014 WL 3976439 at *3 (2014).

⁹ *Id.*

¹⁰ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2302 (2019).

¹¹ 137 S.Ct. 1744, 1765 (2017).

¹² *Iancu v. Brunetti*, 139 S. Ct. 2294, 2302 (2019).

¹³ 15 U.S.C.A. § 1052(a) (West 2006). *See also Matal v. Tam*, 137 S. Ct. 1744, 1765 (2017).

¹⁴ 15 U.S.C.A. § 1052. *See also Brunetti*, 139 S. Ct. at 2302.

¹⁵ U.S. CONST. amend. I.

¹⁶ This article uses the phrases "government speech" to include other government actions which are the equivalent of government speech and are exempt from the First Amendment free speech scrutiny.

the marks would have fallen outside the First Amendment protections,¹⁷ and could have been denied registration. “The Free Speech Clause restricts government regulation of private speech; it does not regulate government speech.”¹⁸ For example, in *Walker v. Texas Sons of Confederate Veterans*,¹⁹ the Court held that specialty license plate frames were government speech,²⁰ and thus within the purview of the State to regulate.²¹ “Government statements (and government actions and programs that take the form of speech) do not normally trigger the First Amendment rules designed to protect the marketplace of ideas.”²²

Yet rights in a mark are meaningless without the ability to enforce the mark against alleged infringers. The consequence of this is that offensive, vulgar, and scandalous marks could be denied enforcement in an infringement action, via the Customs and Border Protection (CBP),²³ or an International Trade Commission proceeding,²⁴ because enforcing them through these government actions would constitute government speech, and any First Amendment protections on which these marks received registration would not be applicable.

¹⁷ See *Matal v. Tam*, 137 S.Ct. 1744, 1757 (2017) (“The First Amendment prohibits Congress and other government entities and actors from abridging the freedom of speech; the First Amendment does not say that Congress and other government entities must abridge their own ability to speak freely. And our cases recognize that the Free Speech Clause ... does not regulate government speech.”)(internal quotations omitted).

¹⁸ *Pleasant Grove City, Utah v. Summum*, 555 U.S. 460, 467, 129 S. Ct. 1125, 1131, 172 L. Ed. 2d 853 (2009); See also *Johanns v. Livestock Mktg. Ass'n*, 544 U.S. 550, 553, 125 S. Ct. 2055, 2058, 161 L. Ed. 2d 896 (2005)(holding that “[g]overnment's own speech . . . is exempt from First Amendment scrutiny.”).

¹⁹ 135 S. Ct. 2239, 2253 (2015). See also *Tam*, 137 S. Ct. at 1748.

²⁰ *Sons of Confederate Veterans*, 135, S. Ct. at 2245-53. As discussion *infra*. while the issue before the court was whether license plate designs were governmental speech, the Court relied heavily on the discretionary nature of the Texas Department of Motor Vehicles Board in selecting or approving specialty plate designs proposed by an individual or organization. *Id.* at 2244-45.

²¹ *Id.* at 2253.

²² *Id.* at 2245-46.

²³ See *infra* section III.C. CBP is tasked with impounding counterfeit goods at ports of entry.

²⁴ See *infra* section III.C.

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While scholars have weighed in on these registration bars—in law review articles published years before the cases were even in a glimmer in the plaintiffs’ eyes,²⁵ prior to oral arguments,²⁶ and after the decisions were published.²⁷ While some have been in favor of the restrictions’ removal based on the Court’s ultimate reasoning,²⁸ or based on a different

²⁵ See, e.g., Lisa Ramsey, First Amendment Limitations on Trademark Rights, 3 INTELLECTUAL PROPERTY AND INFORMATION WEALTH: ISSUES AND PRACTICES IN THE DIGITAL AGE 147 (Peter K. Yu, ed., Praeger 2007); Megan M. Carpenter, Contextual Healing: What to Do About Scandalous Trademarks and Lanham Act 2(a), 68 HASTINGS L.J. 1, 1 (2016). Kerry Ryden, What Does in Re Fox Say? Revising the Scandalous Trademark Doctrine by Reference to the Obscene, 24 FED. CIRCUIT B.J. 435 (2015); Regan Smith, Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks, 42 HARV. C.R.-C.L. L. REV. 451, 452 (2007).

²⁶ See, e.g., Brief of Law Professors as Amici Curiae in Support of the Petitioner, *Lee v. Tam*, 2016 WL 6833413 (U.S.) (U.S., 2016) (arguing for the petitioner that finding the Lanham Act’s disparagement clause unconstitutional could allow for numerous provisions of the Trademark Act to be overturned, dismantling the modern trademark system); *Lee v. Tam*, 2016 WL 7384846 (U.S.) (U.S. 2016) (arguing for the respondent that denying trademark registration to speech deemed as “disparaging” undermines the First Amendment’s protection of free speech); Rebecca Tushnet *The First Amendment Walks into A Bar: Trademark Registration and Free Speech*, 92 NOTRE DAME L. REV. 381, 384 (2016) (arguing that the Lanham Act 2(a) disparagement bar should be held to be constitutional).

²⁷ See, e.g., Lisa Ramsey, Free Speech Challenges to Trademark Law After *Matal v. Tam*, 56 HOUSTON L. REV. 401 (2018); Sonia K. Katyal, Commentary, Brands Behaving Badly, 109 TRADEMARK REPORTER (2019) papers.ssrn.com/sol3/papers.cfm?abstract_id=3445092 (analyzing the irony of the Supreme Court’s decisions in *Tam* and *Brunetti* that attempted to encourage the reclaim of derogatory terms while also providing protection for hate speech); Robert L. Greenberg, Recent Supreme Court Trademark Decisions and Cannabis Registrations, CANNABIS L.J. (2020) https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3525029 (analyzing whether the Lanham Act’s ban on cannabis trademark registration is justifiable in light of the Supreme Court’s decisions in *Tam* and *Brunetti*); Marc Rohr, First Amendment Implications of the Trademark Registration Decisions (2020) https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3518433 (exploring the First Amendment implications of *Tam* and *Brunetti*, including the constitutionality of other Lanham Act provisions); Lackland Bloom, *The Rise of the Viewpoint-Discrimination Principle* 72 SMU L. Rev. Forum (2019); Kent Greenfield, Trademarks, Hate Speech, and Solving a Puzzle of Viewpoint Bias (March 4, 2020). SUPREME COURT REVIEW, 2019, Forthcoming; Boston College Law School Legal Studies Research Paper No. 525. Available at SSRN: <https://ssrn.com/abstract=3548716> or <http://dx.doi.org/10.2139/ssrn.3548716> https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3462712 (arguing that the anti-viewpoint-discrimination principle articulated in *Tam* and *Brunetti* has become a focal point of free speech jurisprudence).

²⁸ See, e.g., John Langworthy, A Slanted View on the Morality Bars: *Matal v. Tam*, in *Re Brunetti, and the Future of Section 2(a) of the Lanham Act*, 2 BUS. ENTREPRENEURSHIP & TAX L. REV. 477, 477 (2018) (“Given the inconsistent application of the Disparagement Clause and the potential for viewpoint discrimination, the *Tarn* Court was correct in finding it unconstitutional. For similar reasons, the court in *Brunetti* properly extended this holding to the Immoral and Scandalous Clause.”); Tanya Behnam, *Battle of the Band: Exploring the Unconstitutionality of Section 2(a) of the Lanham Act and the Fate of Disparaging, Scandalous, and Immoral Trademarks in A Consumer-Driven Market*, 38 LOY. L.A. ENT. L. REV. 1, 4 (2018) (“The *Matal* Court’s determination that section 2(a)’s disparagement clause is unconstitutional--because trademarks are private speech--was correct. Moving forward, this same holding should also be applied to section 2(a)’s ban on immoral and scandalous marks.”); Jake MacKay, *Racist Trademarks and Consumer Activism: How the Market Takes Care of Business*, 42 LAW & PSYCHOL. REV. 131, 140 (2018) (“The Court correctly applied strict scrutiny to the Disparagement Clause, and the Clause clearly discriminated based on a viewpoint. Racist or derogatory trademarks should be protected under the Lanham Act. While this view is likely to cause some discomfort, it is the only view that should be supported under the First Amendment.”).

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rationale;²⁹ others are appalled at the notion that a governmental agency is now forced to sanction,³⁰ via trademark registration,³¹ vulgarities, racial and gender invectives, and NSFW words.³² Yet neither scholars nor the courts have pondered on whether this requirement for the USPTO to register such marks extends to those tasked with enforcing them, or whether this government action takes the form of government speech.

The Supreme Court majority appears to view the act of trademark registration as more of a ministerial or executive action,³³ rather than as a discretionary government function.³⁴ Trademark registration was thus viewed as more closely related to the registration of a deed for land (the ministerial recognition of a right) than to a specialty license plate frame design (discretionary governmental expression). Registration of a trademark is not required for one to

²⁹ Russ VerSteeg, Historical Perspectives & Reflections on *Matal v. Tam* and the Future of Offensive Trademarks, 25 J. INTEL. PROP. L. 109, 148 (2017) (arguing that the disparagement clause is overbroad and vague and that it fails under the *Central Hudson* test); Alex Weidner, Examining the Impact of *Re Brunetti* on S 2(a) of the Lanham Act in *Re Brunetti*, 877 F.3d 1330 (Fed. Cir. 2017), Cert. Granted Sub Nom. *Iancu v. Brunetti*, No. 18-302, 2019 WL 98541 (U.S. Jan. 4, 2019) (Mem.), 83 Mo. L. Rev. 1153, 1167 (2018). (“While the majority [*Brunetti*] was correct in stating that giving an entirely new definition to a statute would usurp the legislative power, it failed to recognize that immoral and scandalous can be read as obscene. Thus, the concurrence proposed a reasonable construction that must be adopted rather than an unreasonable usurpation of the legislature. Essentially, the concurrence proposed pruning rather than rewriting and therefore was correct in stating the statute should be narrowed rather than invalidated.”).

³⁰ Gibbons, Llewellyn Joseph, Liberty or Licentiousness: Disinsenting Disparaging and Scandalous Marks Post-*Tam* and *Brunetti* (June 7, 2020). Available at SSRN: <https://ssrn.com/abstract=3621683>; Eloise Chin, The Perils of Offensive Trademarks: Trademark Function, Freedom of Expression, and Why We Should Be Barring the Registration of Offensive Marks (September 2, 2019). Victoria University of Wellington Legal Research Paper No. 38/2020. Available at SSRN: <https://ssrn.com/abstract=3628979> or <http://dx.doi.org/10.2139/ssrn.3628979>.

³¹ 15 U.S.C. § 1057(a); USPTO Trademark Manual of Examining Procedure, Chapter 1601.01(a) (Oct. 2018), found at <http://www.uspto.gov/trademark/guides-and-manuals/tmep-archives>

³² See, e.g., Gibbons, *supra* note 30; Roni A. Elias, Where Never Is Heard A Disparaging Word?, FED. LAW., APR. 2017, at 26, 27–28.

³³ Ministerial functions are defined as those “done under the authority of a superior; opposed to judicial: that which involves obedience to instructions, but demands no special discretion, judgment, or skill.” Black’s Law Dictionary, found at <https://thelawdictionary.org/ministerial/> (last accessed April 12, 2020); see also *Rodriguez v. Solis*, 2 Cal.Rptr.2d 50, 53 (Cal.App. 5 Dist.1991)(“A ministerial act is an act that a public officer is required to perform in a prescribed manner in obedience to the mandate of legal authority and without regard to his own judgment or opinion concerning such act’s propriety or impropriety, when a given state of facts exists.”)

³⁴ *Rodriguez v. Solis*, 2 Cal.Rptr.2d 50, 53, 1 Cal.App. 4th 495, 501–02 (Cal.App. 5 Dist.,1991)(“Discretion. . . is the power conferred on public functionaries to act officially according to the dictates of their own judgment. (citing *People ex rel. Fund American Companies v. California Ins. Co.* (1974)).

have rights in a mark, but the mark owner does incur certain benefits not available to an unregistered mark, such as constructive nationwide notice of rights and prima facie evidence of validity of the mark, among other rights.³⁵ Comparably, a real property owner, even if the deed is not recorded, still possesses property rights in the land.³⁶ Recordation of a deed provides additional rights, such as notice of ownership, mortgages, and other encumbrances, and thus protection for bona fide purchasers of value.³⁷

Yet recordation of a deed for real property and registration of a mark are only the beginning of their stories. A property owner, regardless of its recordation status, can enforce

³⁵ 15 U.S.C. § 1072 (“Registration of a Mark on the principle register... shall be constructive notice of the registrant’s claim of ownership thereof.”); *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 142–43, 135 S. Ct. 1293, 1300, 191 L. Ed. 2d 222 (2015) (“Registration is significant. The Lanham Act confers “important legal rights and benefits” on trademark owners who register their marks. Registration, for instance, serves as “constructive notice of the registrant’s claim of ownership” of the mark. It also is prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate. And once a mark has been registered for five years, it can become “incontestable.”) (internal citations and quotations omitted); *Matal v. Tam*, 137 S. Ct. 1744, 1753, 198 L. Ed. 2d 366 (2017) (“Registration also enables the trademark holder “to stop the importation into the United States of articles bearing an infringing mark.”); see also 3 McCarthy § 19:3, at 19–21, §19.9 at 19-34.

³⁶ See *Fitzgerald v. Wynne*, 1 App. D.C. 107, 115 (D.C. Cir. 1893) (“A deed is valid at common law between the parties, if signed, sealed and delivered, though not witnessed, acknowledged, or recorded.”); *James v. Nelson*, 90 F.2d 910, 917 (9th Cir. 1937); (“[I]t is clear that, under the settled public policy of Alaska, failure of recordation does not affect the validity of a deed as between parties and privies, for purposes of estoppel or otherwise.”); *S. Dairies v. Banks*, 92 F.2d 282, 285 (4th Cir. 1937) (“[I]t is well settled in North Carolina that an unrecorded deed of conveyance is good as between the parties and as against all other persons except purchasers for value from the grantor and his creditors.”); *Tenney Tel. Co. v. United States*, 82 F.2d 788, 790 (7th Cir. 1936) (“It is well settled by the law of Wisconsin that a written instrument may convey a valid title as between the grantor and grantee, even though it is not witnessed or acknowledged, as required by statute, and has not been placed of record.”).

³⁷ See, e.g., Nev. Rev. Stat. Ann. § 111.320 (West) (“Every such conveyance or instrument of writing, acknowledged or proved and certified, and recorded in the manner prescribed in this chapter or in NRS 105.010 to 105.080, inclusive, must from the time of filing the same with the Secretary of State or recorder for record, impart notice to all persons of the contents thereof; and subsequent purchasers and mortgagees shall be deemed to purchase and take with notice.”) & Nev. Rev. Stat. Ann. § 111.325 (West) (“Every conveyance of real property within this State hereafter made, which shall not be recorded as provided in this chapter, shall be void as against any subsequent purchaser, in good faith and for a valuable consideration, of the same real property, or any portion thereof, where his or her own conveyance shall be first duly recorded.”); *Duncan Townsite Co. v. Lane*, 245 U.S. 308, 311, 38 S. Ct. 99, 101, 62 L. Ed. 309 (1917) (“ [The doctrine of bonafide purchaser] is a shield by which the purchaser of a legal title may protect himself against the holder of an equity, not a sword by which the owner of an equity may overcome the holder of both the legal title and an equity.”); *Smart v. Nevins*, 298 A.2d 217, 219 (D.C. 1972) (“It is fundamental that the purpose of recordation is to protect the rights of bona fide purchasers, creditors, assignees, and others relying upon the indicia of record ownership.”); *United States v. Nava*, 404 F.3d 1119, 1129 (9th Cir. 2005) (“Under Montana law, a party who duly records a deed in the appropriate registry prevails against subsequent purchasers or encumbrancers.”)

her property rights in court against others, such as trespass and nuisance.³⁸ But a recorded deed is required for those with standing to challenge a property owner who violates covenants that run with the land,³⁹ such as land use restrictions.⁴⁰ Likewise, once an owner has rights in a mark, they may enforce their rights in the mark over later confusingly similar uses in

³⁸ “Comm. to Elect Dan Forest v. Employees Political Action Comm. (EMPAC), 260 N.C. App. 1, 7, 817 S.E.2d 738, 742 (2018)(“An owner of land has the right to exclusive possession of his property and has standing to bring suit against anyone who trespasses, even where the owner suffers no actual damage; the owner's legal right to exclusive enjoyment of his property has been invaded.”). In re WorldCom, Inc., 546 F.3d 211, 218 (2d Cir. 2008). (“Trespass law protects a person's exclusive possessory interest in property.”); San Diego Gas & Elec. Co. v. Superior Court, 13 Cal. 4th 893, 937, 920 P.2d 669, 696 (1996). (“In distinction to trespass, liability for nuisance does not require proof of damage to the plaintiff's property; proof of interference with the plaintiff's use and enjoyment of that property is sufficient.”).

³⁹ See Am. Oil Co. v. Rasar, 203 Tenn. 37, 47 (1957)(“When a covenant runs with the land liability to assume its burdens or right to use its benefits passes to the landowner's assignees. Such a covenant is a promise, the effect of which is to bind the promisor and his lawful successors to the burdened land for the benefit of the promisee and his lawful successors to the benefited land.”); Black's Law Dictionary, found at <https://thelawdictionary.org/running-with-the-land/> (last accessed June 2, 2020)(“A covenant is said to run with the land when either the liability to perform it or the right to take advantage of it passes to the assignee of that land.”).

⁴⁰ See Nutis v. Schottenstein Trustees, 41 Ohio App.3d 63, 67 (1987) (holding that property owners lacked standing and so could not seek enforcement of a restrictive covenant); Runyon v. Paley, 331 N.C. 293, 316, 416 S.E.2d 177, 193 (1992) (finding that the plaintiffs had not showed sufficient evidence to show that they have standing to enforce the restrictive covenants, either personally or as owners of any land intended to be benefitted by the restrictions); Warth v. Seldin, 422 U.S. 490, 500, 95 S. Ct. 2197, 2206, 45 L. Ed. 2d 343 (1975)(“Essentially, the standing question in such cases is whether the constitutional or statutory provision on which the claim rests properly can be understood as granting persons in the plaintiff's position a right to judicial relief.”).

commerce,⁴¹ and can do so even if their mark is not registered with the USPTO.⁴² Yet with registration incurs additional rights, as discussed *supra*.⁴³

The Supreme Court's rationales in *Brunetti* and *Tam* ignored this enforcement aspect of a mark, and thus did not opine on whether this action is government speech.⁴⁴ Yet the true strength of a mark is the owner's ability to enforce it against others through the courts and other governmental agencies.⁴⁵ Through enforcement, the government is actively condoning this speech beyond the amorphous and challenging constitutional gray area of being government sponsored or government subsidized speech,⁴⁶ and instead can be characterized as government speech. The enforcement powers are considerable: a court has discretion to order injunctive

⁴¹ 15 U.S.C. § 1125(a)(1)(A).

⁴² Registration is not necessary in order to enforce trademark rights. Under Section 43(a)(1)(A) of the Lanham Act, which provides a cause of action with regard to false designation of origin, the owner with priority of use in an unregistered mark can enforce the Mark against those who use a similar mark in commerce in a manner that is likely to cause confusion as to source or origin of a good or service. 15 U.S.C. § 1125(a)(1)

False Designation of Origin, False Descriptions, and Dilution Forbidden. Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which--

(A) Is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation connection, or association of such person with another person, or as to the origin, sponsorship or approval of his or her goods, services, or commercial activities by another person, or

(B) In commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

Shall be liable in a civil action by any person who believes that he or she is likely to be damaged by such act.

As noted *infra*, In Part IV.A., however, trademark registration is required for in order for Customs & Border Patrol (CBP) enforcement actions to prevent the importation and/or seizure of counterfeit or otherwise-infringing goods. In addition, under the Madrid Protocol, of which the United States is a signatory, in order to register Marks via its system, the Mark must be registered in its origin country. See 15 U.S.C.A. § 1141e(b) (West)(“Where the United States Patent and Trademark Office is the office of origin for a trademark application or registration, any international registration based on such application or registration cannot be used to obtain the benefits of the Madrid Protocol in the United States.”).

⁴³ See *supra* note 35 and accompanying text.

⁴⁴ Or a government action which, through enforcement is the equivalent of government speech.

⁴⁵ See *infra*, Part III.C., discussing both Customs & Border Patrol and the International Trade Commission.

⁴⁶ See generally Randall P. Bezanson & William G. Buss, The Many Faces of Government Speech, 86 IOWA L. REV. 1377(2001); Caroline Mala Corbin, Mixed Speech: When Speech Is Both Private and Governmental, 83 N.Y.U. L. REV. 605 (2008); see also *Matal v. Tam*, 137 U.S. 1744, 1763 (2017)(“the disparagement clause cannot be sustained under our government-speech or subsidy cases or under the Government’s proposed “government-program” doctrine”).

relief,⁴⁷ and/or the destruction of the infringing goods.⁴⁸ And the owner with priority use in a registered mark has the right to seek relief not just via the courts, but also through Customs and Border Patrol to prevent others from using similar words, symbols, shapes, designs, or other “speech” when the offending user is doing so in a confusing similar manner.⁴⁹ Unlike registration, court- and CBP- and ITC-actions enforcing private rights are discretionary in

⁴⁷ 15 U.S.C. § 1116 [§34(a)] (West)(“The several courts vested with jurisdiction of civil actions arising under this chapter shall have power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent and Trademark Office or to prevent a violation under subsection (a), (c), or (d) of section 1125 of this title.”)

⁴⁸ § 1118 [§36]

In any action arising under this chapter, in which a violation of any right of the [Mark owner] . . . shall have been established, the court may order that all labels, signs, prints, packages, wrappers, receptacles, and advertisements in the possession of the defendant, bearing the . . . mark or . . . the word, term, name, symbol, device, combination thereof, designation, description, or representation that is the subject of the violation, or any reproduction, counterfeit, copy, or colorable imitation thereof, and all plates, molds, matrices, and other means of making the same, shall be delivered up and destroyed.

Courts have long had discretion with regard to remedies in private actions, as long as the court does not act in an arbitrary or capricious manner. See discussion *infra*, notes 71 thru 72 and accompanying text.

⁴⁹ See *Carnival Brand Seafood Co. v. Carnival Brands, Inc.*, 187 F.3d 1307, 1309 (11th Cir. 1999)(“To prevail on a trademark infringement claim, a plaintiff must show (1) that its mark has priority and (2) that the defendant's mark is likely to cause consumer confusion.”)

There are limits to this right, such as using the word at issue in a descriptive sense and not as a Mark, as well as comparative use and other “fair uses.” See *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 321 (4th Cir. 2015)(noting that “The law provides three broad, overlapping categories within which any use of a famous mark, even if likely to cause harm or blurring, is not actionable: fair use; news reporting and news commentary; and noncommercial use.”)(citing 15 U.S.C.A. § 1125(c)(3)(A)); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 112, 125 S. Ct. 542, 544, 160 L. Ed. 2d 440 (2004)(“ § 1115(b)(4). . . provides the fair use defense to a party whose “use of the . . . term . . . charged to be an infringement is a use, otherwise than as a mark, . . . of a term . . . which is descriptive of and used fairly and in good faith only to describe the goods or services.”); 15 U.S.C.A. § 1125(c)(3)(A) provides for exclusions to dilution liability:

The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

- (A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person's own goods or services, including use in connection with--
 - (i) advertising or promotion that permits consumers to compare goods or services; or
 - (ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

See generally Yvette Joy Liebesman & Benjamin Wilson, *The Mark of a Resold Good*, 20 GEO. MASON L. REV. 157, 183-88 (2012) (describing trademark law's first sale/exhaustion and nominative fair use defenses.)

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nature.⁵⁰ Thus, even if registration triggers the mark owner's First Amendment protections against viewpoint discrimination,⁵¹ the same may not hold true for enforcement of the mark.

The upshot is that offensive, vulgar, and scandalous marks could be denied enforcement because enforcing them through these government actions would constitute government speech, and any First Amendment protections on which these marks received registration would not be applicable. Moreover, if government enforcement of a private citizen's mark does constitute government speech, then it makes more sense for the court to hold that registration of that mark is as well. As discussed *infra*,⁵² if the mark is declared unenforceable as discretionary government speech, Brunetti's registration would be worthless if the mark is unenforceable. Thus, in spite of his Supreme Court victory, Eric Brunetti could still face the challenge of whether he can actually enforce the Mark. Brunetti's registration would be FUCT, because it would thus make sense for the court to hold that registration of that mark is as well.

This Author argues that the issues in *Brunetti* should be revisited from the viewpoint that enforcement of an obscene, scandalous, or immoral mark is government speech,⁵³ and the courts could choose not to enforce these offensive marks without running afoul of *Brunetti*. Indeed,

⁵⁰ See, e.g., *Ervin v. State*, 125 S.W.3d 542, 546 (Tex. App. 2002) (finding that reviewing courts should apply an abuse of discretion standard for factual issues); *People v. Coleman*, 701 N.E.2d 1063, 1074 (Ill. 1998) (acknowledging that the Illinois Supreme Court had recognized the abuse of discretion standard as "the most deferential standard of review available."); see generally Amanda Peters, *The Meaning, Measure, and Misuse of Standards of Review*, 13 Lewis & Clark L. Rev. 233, 242-45 (2009). In addition, factual determinations are reviewed by the appellate courts for abuse of discretion. FED. R. CIV. P. 52(a)(6) ("Findings of fact, whether based on oral or other evidence, must not be set aside unless clearly erroneous, and the reviewing court must give due regard to the trial court's opportunity to judge the witnesses' credibility.").

⁵¹ It is important for the reader to distinguish between the First Amendment issue discussed here—its inapplicability to government speech—and an alleged infringer's First Amendment defense to trademark infringement.

⁵² See *infra* section IV.

⁵³ This article uses the phrases "government speech" as overarching terms to describe government speech and other government actions which are the equivalent of government speech and are exempt from the First Amendment free speech scrutiny.

under the argument described herein, a court could reconsider its holding in *Brunetti* in light of enforcement of a mark as government speech.

To fully elaborate on this argument, Part II details the differences between governmental functions that are deemed the ministerial recognition of a preexisting right, such as the recordation of a deed,⁵⁴ versus a discretionary function, which is central to the role of the judiciary and enforcement agencies.⁵⁵ It then examines the shift from the former to the latter when a rights holder moves registration to enforcement, and how enforcement of a property right is a government action.⁵⁶ Part III argues that, even if the registration of a mark is not government speech, enforcement is, and should have been considered by the *Brunetti* courts. This section begins with a synopsis of the *Iancu v. Brunetti* decision, and how none of the decisions at any court level examined the enforcement right as governmental speech; rather, the courts' decisions rely on an implied understanding on their part that the Trademark Office's registration program is the ministerial recognition of a private right rather than a government function which is discretionary in nature. This section then analogizes the shift from Trademark registration to enforcement with the Supreme Court's decision in *Shelley v. Kraemer*. Just as enforcement of the deeds in *Shelley* changed a private right into a state action, ***it is at the enforcement*** of a mark that it becomes government speech. When we bifurcate the *Shelley* decision, we see the Court first made the determination that enforcement was a government action, then it examined how this affected the property owners' Constitutional rights. Likewise, once it is established that enforcement of a mark changes it from private speech to government speech, we then analyze the Constitutional implications.

⁵⁴ See *infra*, Part II.A.

⁵⁵ See *infra*, Part II.B

⁵⁶ *Shelley v. Kraemer*, 334 U.S. 836, 845 (1948).

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This section also illustrates the vast and important government benefits a mark owner receives when enforcing their mark both through the Courts, Customs enforcement, and the ITC. In Part IV, this Author argues that alleged infringers could argue that enforcement of a mark is government speech, and a court could choose not to enforce immoral, vulgar, scandalous or offensive marks without running afoul of *Brunetti*, or even lead to a revisiting of that decision. This section then puts brakes on the runaway train of courts with unfettered discretion regarding trademark enforcement. Any discretion with regard to enforcement must be limited to avoid having the enforceability of a mark be based on the whims of the jurist, jury, Customs agent, or ITC administrative law judge tasked with enforcement of a mark. This discretion can be constrained by utilizing the similar language restrictions that the Federal Communication Commission uses to limit the broadcast of specific words.⁵⁷ This article concludes that *Brunetti* is not the end of the story with regard to legally enforceable rights for vulgar and obscene marks. Without the ability to enforce a mark, registration is meaningless. And it is at enforcement where these marks become government speech.

II. Ministerial Roles, Discretionary Decisions, and State Actions

The delineation between those governmental roles which are labeled ministerial versus those which are discretionary has various and profound impacts.⁵⁸ This section discusses the lack of discretion inherent in government actors' duties deemed ministerial, especially with

⁵⁷ See, e.g., 18 U.S.C.A. § 1464 (1994) ("Whoever utters any obscene, indecent, or profane language by means of radio communication shall be fined under this title or imprisoned not more than two years, or both."). See also the late George Carlin's famous "Filthy Words" (a.k.a. "Seven Words You Can Never Say on Television") litigation. *F.C.C. v. Pacifica Found.*, 438 U.S. 726, 744, 98 S. Ct. 3026, 3037, 57 L. Ed. 2d 1073 (1978) (holding that the First Amendment does not deny government power to restrict the public broadcast of indecent language, though the court maintained that the exercise of such power must be extremely narrow, and noting that "the Commission's definition of indecency will deter only the broadcasting of patently offensive references to excretory and sexual organs and activities." *Pacifica* at 743).

⁵⁸ See generally, John M. Rogers, A Fresh Look at Agency "Discretion", 57 TUL. L. REV. 776 (1983)

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regard to those which function to merely record or recognize a pre-existing private right. This section then examines the move from a ministerial to a discretionary state action via a discussion of the holding in *Shelley v. Kraemer*, and the concept that enforcement of a property right is a government action.

A. The Ministerial Action and its Lack of Discretion

Ministerial functions are defined as those “done under the authority of a superior; opposed to judicial: that which involves obedience to instructions, but demands no special discretion, judgment, or skill.”⁵⁹ The classification of an administrative duty as either ministerial or discretionary has many ramifications beyond trademark law. For example, qualified immunity for governmental officials can be based on whether their performance is deemed to be ministerial or discretionary.⁶⁰ There is a level of qualified immunity for governmental officials for discretionary actions, the same is not true for ministerial actions.⁶¹ This delineation is also

⁵⁹ Black’s Law Dictionary, found at <https://thelawdictionary.org/ministerial/> (last accessed April 12, 2020); see also *Rodriguez v. Solis*, 2 Cal.Rptr.2d 50, 53 (Cal.App. 5 Dist.1991)(“A ministerial act is an act that a public officer is required to perform in a prescribed manner in obedience to the mandate of legal authority and without regard to his own judgment or opinion concerning such act’s propriety or impropriety, when a given state of facts exists.”)

⁶⁰ See *Harlow v. Fitzgerald*, 457 U.S. 800, 818 (1982)(holding that “government officials performing discretionary functions generally are shielded from liability for civil damages insofar as their conduct does not violate clearly established statutory or constitutional rights of which a reasonable person would have known.”).

⁶¹ See, e.g., *Marson v. Thomason*, 438 S.W.3d 292 (Ky.,2014)(The question of when a task is ministerial versus discretionary has long plagued litigants and the courts. Generally, a governmental employee can be held personally liable for negligently failing to performing a ministerial act.”); see also *Evon v. Andrews*, 211 Conn. 501, 505, 559 A.2d 1131, 1133–34 (1989)(“While a municipality itself was generally immune from liability for its tortious acts at common law ... its employees faced the same personal tort liability as private individuals.” A municipal employee however, has a qualified immunity in the performance of a governmental duty, but he may be liable if he misperforms a ministerial as opposed to a discretionary act.... The word ‘ministerial’ ‘refers to a duty which is to be performed in a prescribed manner without the exercise of judgment or discretion.’”)(internal citations and quotations omitted); *Williams v. Housing Authority of City of Bridgeport*, 159 Conn. App. 679, 691 (“under §52-557b(a)(2)(B), the defendants are immune from liability for tortious violations of a discretionary duty, but are not extended immunity for tortious violations of a ministerial duty.”); *Esposito v. State*, No. 515963, 976 N.Y.S. 2d 597, 2013 N.Y. Slip Op. 08162, 2013 WL 6283972 (N.Y.A.D. 3 Dept., Dec. 05, 2013)(“government action, if discretionary, may not be a basis for liability, while ministerial actions may be, but only if they violate a special duty owed to the claimant. “)(internal citations omitted); *Grady v. Town of Somers*, 294 Conn. 324, 338 (Conn., 2009) “Discretionary act immunity reflects a value judgement that, despite injury to a member of the public, the broader interest in having government officers and employees free to exercise judgment and discretion in their official functions, unhampered by fear of second-guessing and retaliatory lawsuits, outweighs the benefits to be had

relevant regarding an aggrieved party's ability to pursue a writ of mandamus.⁶² While a writ of mandamus is the proper avenue to force a government official to perform a ministerial function, it is not available for discretionary functions.⁶³ Indeed, one of the first cases that most law students learn is *Marbury v. Madison*,⁶⁴ which, at its heart, involved enforcing a Writ of Mandamus against an official who refused to perform a ministerial duty.⁶⁵

from imposing liability for that injury"); MI ST 691.1407 Immunity from tort liability; exceptions; judges, legislator, official, and guardian ad litem ("lower-level employees are entitled to governmental immunity under the Michigan Governmental Tort Liability Act for intentional act... if (3) the acts were discretionary, as opposed to ministerial"); MD CTS & JUD PRO §5-507(a)(1). Municipal corporations, ("One is entitled to public official immunity only when he is acting as a public official rather than in some other capacity and only when his tortious conduct occurred while he was performing discretionary, as opposed to ministerial, acts in furtherance of his official duties."); see generally John Logan, Municipal Tort Liability and Immunity: Revisiting the "Ministerial" versus "Discretionary" Distinction, 86 CONN. B.J. 313 (2012).

⁶² See, e.g., *Bd. of Liquidation v. McComb*, 92 U.S. 531, 541, 23 L. Ed. 623 (1875)("[I]t has been well settled, that, when a plain official duty, requiring no exercise of discretion, is to be performed, and performance is refused, any person who will sustain personal injury by such refusal may have a *mandamus* to compel its performance.")

⁶³ See *Wilbur v. U.S. ex rel. Kadrie*, 281 U.S. 206, 218, 50 S. Ct. 320, 324, 74 L. Ed. 809 (1930)

("Mandamus is employed to compel the performance, when refused, of a ministerial duty, this being its chief use. It also is employed to compel action, when refused, in matters involving judgment and discretion, but not to direct the exercise of judgment or discretion in a particular way nor to direct the retraction or reversal of action already taken in the exercise of either."); see also *Gaines v. Thompson*, 74 U.S. 347, 348, 19 L. Ed. 62 (1868)(holding that matters resting in the judgment and discretion of officers as representing the Executive Department are not subject to writs of mandamus.); *U.S. ex rel. Riverside Oil Co. v. Hitchcock*, 190 U.S. 316, 325, 23 S. Ct. 698, 702, 47 L. Ed. 1074 (1903)("Mandamus has never been regarded as the proper writ to control the judgment and discretion of an officer as to the decision of a matter which the law gave him the power and imposed upon him the duty to decide for himself.").

⁶⁴ *Marbury v. Madison*, 5 U.S. 137, 152, 2 L. Ed. 60 (1803) ("A mandamus gives no right, but only puts the party in a way to try his right. It lies to compel a ministerial act which concerns the public.")(internal citations omitted).

⁶⁵ *Marbury v. Madison*, 5 U.S. 137, 2 L. Ed. 60 (1803). *Marbury v. Madison* concerned Secretary of State Madison's refusal to deliver William Marbury's commission as a Justice of the Peace, for which he had been nominated by John Adams and confirmed by the Senate, but not delivered to Marbury prior to Thomas Jefferson took office. Jefferson instructed his Secretary of State James Madison to not deliver the commission. Marbury filed a writ of mandamus in the Supreme Court to force Madison to deliver his commission. While the Supreme Court ultimately held that the statute Congress had passed that gave the Supreme Court jurisdiction over types of cases like Marbury's was unconstitutional. The Court did affirm, however

that any ministerial officer having public duties to perform, should be above the compulsion of law in the exercise of those duties. As a ministerial officer he is compellable to do his duty, and if he refuses, . . . a specific civil remedy to the injured party can only be obtained by a writ of mandamus.

Marbury v. Madison, 5 U.S. 137, 149-150 (1803).

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Many ministerial functions are merely the governmental recognition of a pre-existing private right, such as the right to transfer ownership of deeded land,⁶⁶ or the right to marry. Beyond its duty to ensure that all of the statutorily required elements are present,⁶⁷ the Recorder of Deeds does not have the discretion to reject a real property deed.⁶⁸ Likewise, for the issuance of a marriage license or recordation of a marriage certificate, county clerks have no discretion regarding performance of these functions—licenses must be issued to all those who meet the legal requirements, and when presented valid marriage certificates must be recorded.⁶⁹

⁶⁶ See Edwin W. Patterson, Ministerial and Discretionary Official Acts, MICHIGAN LAW REVIEW, Vol 20. No. 8, 848, 858. (Jun. 1922)(“Recording a deed, is one of the simplest official acts having far-reaching consequences upon private interest”)

⁶⁷ Id. at 855 (“the recorder of deeds, for instances, when an instrument is presented for record, must interpret the recording act, and likewise interpret the instrument, and apply the statute to the particular facts;”); 13 VAC 10-20-110.

Transfers of ownership. The proposed ownership entity requesting approval of a transfer of ownership must submit a written request to the statutory. [I]t should contain: (i) a detailed description of the terms of the transfer; (ii) all documentation to be executed in connection with the transfer; (iii) information regarding the legal, business and financial status and experience of the proposed ownership entity and of the principals therein, including current financial statements; (iv) an analysis of the current physical and financial condition of the development, including a current audited financial report for the development; (v) information regarding the experience and ability of any proposed management agent; and (vi) any other information and documents relating to the transfer.

⁶⁸ See, e.g., Tex. Prop. Code Ann. § 12.001(a) (West)(“Instruments Concerning Property. An instrument concerning real or personal property may be recorded if it has been acknowledged, sworn to with a proper jurat, or proved according to law.”); Va. Code Ann. § 17.1-227 (West)(“All deeds. . . shall, unless otherwise provided, be recorded in a book to be known as the deed book. All deeds . . . submitted for recordation in the deed books of the appropriate office of the clerk of court shall be prepared according to the requirements for deeds and deeds of trust as set forth in §§ 55.1-300 and 55.1-316, as applicable.”)

⁶⁹ See, e.g., Me. Rev. Stat. tit. 19-A, § 652(1) (“Marriage license issued. After the filing of notice of intentions of marriage . . . the clerk or the State Registrar of Vital Statistics shall deliver to the parties a marriage license specifying the time when the intentions were recorded.”); WY ADC 048.0059.8 § 1 (“County Clerk’s Responsibility. The County Clerk or a designated representative shall: 1. Obtain the information required to complete the marriage license on the Vital Statistics Services Applications Questionnaire or authorized intake form; 2. Secure the signature of each person to be married on the certificate; 3. Review the license upon its return for completeness and accuracy; 4. Submit the file within the statutory allotted time.”); see also 25 TX ADC § 181.25(g) (“Application for Marriage License and Affidavit of Correction to Marriage License, [U]pon receipt of the notarized affidavit, the county clerk shall file it as an amendment to the marriage license. [i] the county clerk shall include a copy of the affidavit with any future certified copy of the marriage license issued by the clerk.”); *Miller v. Davis*, 123 F. Supp.3d 924, 941 (E.D. K., 2015)(“The State prescribes the form that [Kimberly] Davis must use in issuing marriage licenses. She plays no role in composing the form, and she has no discretion to alter it. Moreover, county clerk’ officers issue marriage licenses on behalf of the State, not on behalf of a particular elected clerk.”).

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B. Discretionary Acts as State Actions

Discretion is perhaps the opposite of ministerial—the action at issue is based on the individual assessment of a government official. It “is the power conferred on public functionaries to act officially according to the dictates of their own judgment.”⁷⁰ A court cannot compel via injunction or mandamus that over which an officer has discretionary authority,⁷¹ and decisions may only be reviewed by the courts for abuse of discretion.⁷² It provides a level of immunity for public officials.

Discretionary act immunity reflects a value judgment that—despite injury to a member of the public—the broader interest in having government officers and employees free to exercise judgment and discretion in their official functions, unhampered by fear of second-guessing and retaliatory lawsuits, outweighs the benefits to be had from imposing liability for that injury. In contrast, municipal officers are not immune from liability for negligence arising out of their ministerial acts, defined as acts to be performed in a prescribed manner without the exercise of judgment or discretion. This is because society has no analogous interest in permitting municipal officers to exercise judgment in the performance of ministerial acts.⁷³

This differentiation between ministerial and discretionary actions is also evident with regard to the relevant standard of review—for the discretionary action of an administrative agency, on

⁷⁰ *Rodriguez v. Solis*, 2 Cal.Rptr.2d 50, 53, 1 Cal.App. 4th 495, 501–02 (Cal.App. 5 Dist., 1991)(citing *People ex rel. Fund American Companies v. California Ins. Co.* (1974)).

⁷¹ See, e.g., *McCarl v. Rogers*, 48 F.2d 1023, 1023 (D.C. Cir. 1931)(“[W]here a statute vests discretion in an executive officer, the exercise of that discretion, unless arbitrary or capricious, is not subject to control by mandamus or mandatory injunction.”)

⁷² See, e.g., *Butnaru v. Ford Motor Co.*, 84 S.W.3d 198, 211 (Tex. 2002)(“under an abuse of discretion standard, the court of appeals cannot overrule the trial court's decision unless the trial court acted unreasonably or in an arbitrary manner, without reference to guiding rules or principles. Moreover, the court of appeals cannot substitute its judgment for the trial court's reasonable judgment even if it would have reached a contrary conclusion. The trial court does not abuse its discretion if some evidence reasonably supports the trial court's decision.”)(internal citations omitted)

⁷³ *Doe v. Petersen*, 903 A.2d 191, 197, 279 Conn. 607, 615 (Conn. 2006)(internal citations and quotation marks omitted); see also John Logan, *Municipal Tort Liability and Immunity: Revisiting the “Ministerial” versus “Discretionary” Distinction*, 86 CONN. B.J. 313, 313–14 (2012)(elaborating that “municipal governmental immunity operates as a cloak protecting cities and towns from tort responsibility in the negligent performance of most discretionary governmental acts. Where public officials are engaged upon a governmental duty ... so long as they act in good faith, in the exercise of an honest judgment, and not in abuse of their discretion, or maliciously or wantonly, they cannot be held liable.”)(internal quotations and citations omitted).

appeal the court analyzes the agency's decision based on whether the finder of fact or decision-maker abused their discretion in reaching their decision.⁷⁴ This distinction is at the heart of the decisions discussed in this article—specifically, they are based on differentiating between ministerial recognition of private speech and discretionary government speech. An example of the latter is *Walker v. Texas Division, Sons of Confederate Veterans*,⁷⁵ where the Supreme Court held that Texas's specialty license plate designs constituted discretionary government speech, and thus fell outside of the First Amendment's Free Speech Clause.⁷⁶

⁷⁴ Administrative Procedure Act, 5 U.S.C.A. § 706(2)(A) (West)

Scope of Review. To the extent necessary to decision and when presented, the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of an agency action. The reviewing court shall hold unlawful and set aside agency action, findings, and conclusions found to be arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law

(internal citations and quotations omitted). See also *Motor Vehicle Mfrs. Ass'n of U.S., Inc. v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43–44, 103 S. Ct. 2856, 2866–67, 77 L. Ed. 2d 443 (1983)

The scope of review under the “arbitrary and capricious” standard is narrow and a court is not to substitute its judgment for that of the agency. Nevertheless, the agency must examine the relevant data and articulate a satisfactory explanation for its action including a “rational connection between the facts found and the choice made.” In reviewing that explanation, we must “consider whether the decision was based on a consideration of the relevant factors and whether there has been a clear error of judgment. Normally, an agency rule would be arbitrary and capricious if the agency has relied on factors which Congress has not intended it to consider, entirely failed to consider an important aspect of the problem, offered an explanation for its decision that runs counter to the evidence before the agency, or is so implausible that it could not be ascribed to a difference in view or the product of agency expertise. The reviewing court should not attempt itself to make up for such deficiencies: We may not supply a reasoned basis for the agency's action that the agency itself has not given. We will, however, uphold a decision of less than ideal clarity if the agency's path may reasonably be discerned.” For purposes of these cases, it is also relevant that Congress required a record of the rulemaking proceedings to be compiled and submitted to a reviewing court, and intended that agency findings under the Act would be supported by “substantial evidence on the record considered as a whole. (internal citations and quotations omitted).

See also *Valeant Pharm. Int'l v. Sebelius*, No. SACV080449AGAGRX, 2009 WL 10674128, at *4 (C.D. Cal. Sept. 14, 2009)

Under the Administrative Procedures Act (“APA”), a reviewing court may set aside an agency action if it is arbitrary, capricious, an abuse of discretion or otherwise contrary to law. But courts do not rubberstamp agency actions, as doing so would be “tantamount to abdicating the judiciary's responsibility under the Administrative Procedures Act. The Supreme Court had made clear that the essence of judicial review of administrative action is scrutiny of the decision-making process.”(internal citations and quotations omitted).

⁷⁵ *Walker v. Texas Sons of Confederate Veterans*, 135 S.Ct. 2239 (2015).

⁷⁶ *Id.* at 2244; U.S. Const. amend. I (“Congress shall make no law . . . bridging the freedom of speech.”)

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The Sons of Confederate Veterans (“SCV”) applied for a specialty license frame which was to feature a Confederate battle flag and the words SONS OF CONFEDERATE VETERANS, as well as the organization’s logo.⁷⁷ After the Texas Department of Motor Vehicles Board rejected the design, the SCV sued the Board on the theory that the rejection violated the Free Speech Clause of the First Amendment as unconstitutional viewpoint discrimination, and sought to force the Board to approve their plate design.⁷⁸ While the SCV was unsuccessful at the District Court, the SCV did what losers do—they appealed. They had better luck with the Fifth Circuit, where a divided court held that the license plate designs were private speech protected by the First Amendment, and the Board had “engaged in constitutionally forbidden viewpoint discrimination.”⁷⁹ The SCV’s victory was short-lived, however.⁸⁰ The Supreme Court reversed, holding that the license plate designs were discretionary government speech, and thus were not subject to the censorship prohibitions of the First Amendment.⁸¹

Key to the Supreme Court’s reasoning that the Board’s actions qualified as government speech was the recognition of the discretionary nature of the Board’s decision over what designs to choose.⁸² The Court noted that “the Board had the authority to create new specialty license

⁷⁷ Id. at 2245.

⁷⁸ Id. The discretionary nature of the Board’s decision is apparent even in the filing of the lawsuit; were the license plate design approvals considered more ministerial in nature, then the SCV would instead have chosen to ask for a Writ of Mandamus rather than an injunction requiring the Board to approve the plate design. Id..

⁷⁹ Id.

⁸⁰ Id.

⁸¹ Id. (“When government speaks, it is not barred by the Free Speech Clause from determining the content of what it says.”)(citations omitted).

⁸² Id. at 2242–43.

The State exercises final authority over the messages that may be conveyed by its specialty plates, it takes ownership of each specialty plate design, and it has traditionally used its plates for government speech. These features of Texas specialty plates militate against a determination that Texas has created a public forum. Finally, the plates are not a nonpublic forum, where the “government is ... a proprietor, managing its internal operations. The fact that private parties take part in the design and

plates on its own initiative.”⁸³ This discretionary nature was also illustrated in the statute’s language in which the state “maintains direct control over the messages conveyed on its specialty plates. Texas law provides that the State has sole control over the design, typeface, color, and alphanumeric pattern for all license plates [and] the Board must approve every specialty plate design.”⁸⁴

It is this direct control over the message— “this final approval authority [which] allows Texas to choose how to present itself and its constituency,”⁸⁵ that makes the decision as to what specialty license frame designs are approved of a discretionary nature, rather than ministerial, and a substantial portion of the majority’s reasoning was that this amounted to discretionary government speech.⁸⁶ The Court emphasized that “Texas law vests in the Board authority to approve or to disapprove an application for a number of reasons, if the design might be offensive to any member of the public... or for any other reason established by rule.”⁸⁷ The government was not merely providing a forum for private speech, but rather was engaging in expressive conduct.⁸⁸

propagation of a message does not extinguish the governmental nature of the message or transform the government's role into that of a mere forum provider.
(internal quotations and citations omitted).

⁸³ Id. at 2244.

⁸⁴ Id. at 2249

⁸⁵ Id. at 2250-51.

⁸⁶ The Court also held that the “forum analysis” is not applicable because the State is speaking on its own behalf, rather than it being private speech on government property, and that license plates are neither a “designated public forum,” a “limited private forum” or a “nonpublic forum.” See Id. at 2250-51.

⁸⁷ Id. at 2244-45. .

⁸⁸ Id. at 2251 (“[W]e conclude that Texas’s specialty license plates are not a “nonpublic for[um],” which exists “[w]here the government is acting as a proprietor, managing its internal operations. With respect to specialty license plate designs, Texas is not simply managing government property, but instead is engaging in expressive conduct.”)(internal citations omitted).

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C. Shelley v. Kraemer –Moving from a Ministerial to a Discretionary Action

Moving from ministerial registration of a property right to discretionary enforcement changes the nature of government involvement.⁸⁹ The foundational concepts of government benefits through enforcement of a private right is present in both contract and property law: the definition of a contract is an agreement that is enforceable in court,⁹⁰ and the “bundle of sticks” encompassing property rights is only as strong as the extent to which they can be enforced by a court.⁹¹

This section looks at the Supreme Court’s decision in *Shelley v. Kraemer*, and discusses the move of the same property right from a ministerial registration to discretionary enforcement, and the Court’s declaration that enforcement of a property right is a government action. At issue in *Shelley* was the purchase of a home in Saint Louis, MO,⁹² which had deed language prohibiting the ownership or occupancy by African Americans.⁹³ J.D. and Ethel Shelley

⁸⁹ See *Shelley v. Kraemer* at 13-14 (holding that so long as the purposes of the restrictive covenant agreements were effectuated by voluntary adherence to their terms, it is no state action; but when adherence to the restrictive agreements can be secured only by judicial enforcement, then this action by courts and judicial officers in their official capacities is a state action.).

⁹⁰ Restatement (Second) of Contracts § 1 (1981)(“A contract is a promise or a set of promises for the breach of which the law gives a remedy, or the performance of which the law in some way recognizes as a duty.”); see also E. Allan Farnsworth, *The Past of Promise: An Historical Introduction to Contract*, 69 COLUM. L. REV. 576, 578 (1969)(expounding on the historical definition of a contract as “a promise or set of promises which the law will enforce.”).

⁹¹ Anna di Robilant, *Property: A Bundle of Sticks or A Tree?*, 66 VAND. L. REV. 869, 870 (2013); Hansen v. U.S., 65 Fed. Cl. 76, 100 (Fed. Cl. 2005)(“The definition of property as a series of rights, commonly conceptualized as a bundle of sticks, formed the foundation of early takings jurisprudence in the United States.”); Denise Johnson, *Reflections on the Bundle of Rights*, 32 VERMONT LAW REVIEW 247 (2007).

⁹² *Shelley v. Kraemer* was the consolidation of two cases involving the same issue—ejectment and voiding of the transfer of property to a purchaser who did not conform with the discriminatory racial deed restrictions. See *Shelley v. Kraemer*, 334 U.S. 1, 4-8 (1948).

⁹³ *Id.* at 4-5 (“...the said property is hereby restricted to the use and occupancy for the term of Fifty (50) years from this date, so that it shall be a condition all the time and whether recited and referred to as (sic) not in subsequent conveyances and shall attach to the land, as a condition precedent to the sale of the same, that hereafter no part of said property or any portion thereof shall be, for said term of Fifty-years, occupied by any person not of the Caucasian race, it being intended hereby to restrict the use of said property for said period of time against the occupancy as owners or tenants of any portion of said property for resident or other purpose by people of the Negro or Mongolian Race.”). See also *ALI, Restatement (3rd) of Property (Servitudes)*.

purchased a lot in the subdivision with the help of a person who acted as their proxy.⁹⁴ Other members of the subdivision sued for ejectment and revocation of the deed,⁹⁵ as owners in the subdivision with reciprocal negative servitudes.⁹⁶ While they were unsuccessful in the lower courts, the Supreme Court held that this private agreement and deed language became a state action when the other property owners asked the courts to enforce the deed restriction.⁹⁷ The Court held “that the actions of courts and of judicial officers in their official capacities is to be regarded as action of the Government.”⁹⁸ But for the active intervention of the courts to enforce the discriminatory restrictions in a subdivision’s covenants, “supported by the full panoply of state power,” the Shelley’s would have been free to live in the home they purchased.⁹⁹

See also Collins v. Rodgers, 938 So. 2d 379, 385 (Ala. 2006): (providing the definition of an reciprocal negative easement, noting that “the parties agree[d] that the chain of title to tract 26 contains no reference to and makes no mention of a 100-foot building setback. Therefore, the covenant the residents [sought] to enforce is, as to tract 26, not an express one but a restrictive covenant by implication. A restrictive covenant by implication is sometimes referred to as a “reciprocal negative easement” or an “implied servitude.”).

⁹⁴ Shelley, 334, U.S. at 5 (“...pursuant to a contract of sale, petitioners Shelley, who are Negroes, for valuable consideration received from one Fitzgerald a warranty deed to the parcel in question.”).

⁹⁵ Id. at 6 (“...respondents, as owners of other property subject to the terms of the restrictive covenant, brought suit in Circuit Court of the city of St. Louis praying that petitioners Shelley be restrained from taking possession of the property and that judgment be entered divesting title out of petitioners Shelley and revesting title in the immediate grantor or in such other person as the court should direct.”).

⁹⁶ See Sanborn v. McLean 206 N.W. 496, 497 (Supreme Ct of Michigan, 1925)(holding that reciprocal negative easements/servitudes arise “out of a benefit accorded land retained, by restrictions upon neighboring land sold by a common owner. Such a scheme of restriction must start with a common owner; it cannot arise and fasten upon one lot by reason of other lot owners conforming to a general plan. If a reciprocal negative easement attached to defendants’ lot, it was fastened thereto while in the hands of the common owner of it and neighboring lots by way of sale of other lots with restrictions beneficial at that time to it.”)

⁹⁷ Shelley, 334 U.S. at 21-22 (“Respondents urge, however, that since the state courts stand ready to enforce restrictive covenants excluding white persons from the ownership or occupancy of property covered by such agreements, enforcement of covenants excluding colored persons may not be deemed a denial of equal protection of the laws to the colored persons who are thereby affected. This contention does not bear scrutiny. The parties have directed our attention to no case in which a court, state or federal, has been called upon to enforce a covenant excluding members of the white majority from ownership or occupancy of real property on grounds of race or color.”).

⁹⁸ Id. at 14.

⁹⁹ Id. at 19.

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Nothing prevents even unenforceable restrictions from being written into a deed and having that deed filed with the Register of Deeds.¹⁰⁰ There are many enforceable restrictions, such as set-backs and other non-discriminatory restraints.¹⁰¹ The recordation of the deed is a ministerial function of the government, and as long as the deed meets the statutory requirements, it must be recorded.¹⁰² Enforcement of the deed restriction, on the other hand, is a central to the discretionary function of the courts, and through that state action incurs a government benefit and triggers constitutional protections.¹⁰³ This same reasoning can be applied to the registration and enforcement of marks.

III. Ministerial Registration versus Discretionary Enforcement of Marks

¹⁰⁰ See, e.g. *Dancy v. Clark*, 24 App. D.C. 487, 499 (D.C. Cir. 1905) (“Undoubtedly the recorder of deeds is in the category of ministerial officers, and has no jurisdiction to pass upon the validity of instruments of writing presented to him for record. . . . He is by the law required to receive and file, or receive and record, as the case may be, such instruments as have been duly executed, and which purport on their face to be of the nature of the instruments entitled to be filed or recorded.”).

¹⁰¹ See, e.g., *Collins v. Rodgers*, 938 So. 2d 379, 385 (Ala. 2006) (holding valid a 100-foot building setback restriction); *Hall v. Gullledge*, 145 So. 2d 794, 796 (Ala. 1962) (holding valid a restriction that the property “be used for residence purposes only, and not for any purpose of business or trade.”); see also *Maitland v. Pelican Beach Properties, Inc.*, 892 F.2d 245 (3rd Cir. 1989) (upholding a restriction prohibiting hotels on the property).

¹⁰² *Dancy*, 24 App. D.C. at 499.

¹⁰³ see *Cordts v. Griffis*, 18-13017, 2020 WL 1274966, at *16 (E.D. Mich. Mar. 16, 2020) (“Within this exception, state action by private parties has been found when the executive or judicial arm of state government has provided assistance in perpetrating unconstitutional conduct. (citing *Shelley v. Kraemer*, 334 U.S. 1, 68 S.Ct. 836, 92 L.Ed. 1161 (1948) (state action found where private party resorted to state courts to enforce discriminatory private deed restrictions)); see also Restatement (Third) of Property (Servitudes) § 3.1 (2000) Validity of Servitude: general rule: “A servitude... is valid unless it is illegal or unconstitutional or violates public policy.”; see also 42 U.S.C.A §3601 of the Fair Housing Act, which “prohibits discrimination by direct providers of housing, such as landlords and real estate companies as well as other entities, such as municipalities, banks or other lending institutions and homeowners insurance companies whose discriminatory practices make housing unavailable to persons because of: race or color, religion. Sex, national origin, familial status, or disability”). Title VIII of the Fair Housing Act of 1968, 42 U.S.C. § 3604(c) (1970), makes it unlawful, with certain exceptions, “[t]o make, print, or publish, or cause to be made, printed, or published any notice, statement, or advertisement, with respect to the sale or rental of a dwelling that indicates any preference, limitation, or discrimination based on race, color, religion, or national origin, or an intention to make any such preference, limitation, or discrimination.”

¹⁰³ See, e.g., *Collins v. Rodgers*, 938 So. 2d 379, 385 (Ala. 2006) (holding valid a 100-foot building setback restriction); *Hall v. Gullledge*, 145 So. 2d 794, 796 (Ala. 1962) (holding valid a restriction that the property “be used for residence purposes only, and not for any purpose of business or trade.”)

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This differentiation between registration and enforcement provides an avenue for revisiting the Supreme Court's *Brunetti* opinion regarding whether registering a trademark is government speech.¹⁰⁴ This section first discusses the USPTO's ministerial function of registering trademarks, and the limited nature of its decision-making ability of trademark examiners. It then provides a synopsis of the *Iancu v. Brunetti* decision, and how none of the decisions at any court level examined enforcement as government speech; rather, the courts' decisions rely on an implied understanding on their part that the Trademark Office's registration program is the ministerial recognition of a private right rather than discretionary government speech. Finally, this section analogizes deed restriction enforcement in *Shelley* to the governmental enforcement of registered marks via the courts, CBP or the ITC, to support this Author's argument that even if the registration of a mark does not constitute government speech, enforcement does, and should have been considered by the *Brunetti* courts.

A. Registration as the ministerial recognition of a preexisting right in a Mark

Unlike patents and copyrights,¹⁰⁵ the Lanham Act recognizes the preexisting rights in a mark. "[F]ederal law does not create trademarks. Trademarks and their precursors have ancient

¹⁰⁴ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2299 (2019)([A]ll the Justices agreed on two propositions. First, if a trademark registration bar is viewpoint-based, it is unconstitutional. And second, the disparagement bar was viewpoint-based.").

¹⁰⁵ *Wheaton v. Peters*, 33 U.S. 591, 592, 8 L. Ed. 1055 (1834)

In the eight[h] section of the first article of the constitution of the United States it is declared, that congress shall have power 'to promote the progress of science and the useful arts, by securing, for a limited time, to authors and inventors, the exclusive right to their respective writings and inventions.' The word 'secure,' as used in the constitution, could not mean the protection of an acknowledged legal right. It refers to inventors, as well as authors: and it had never been pretended by any one, either in this country or in England, that an inventor has a perpetual right, at common law, to sell the thing invented.

It is presumed, that the copyright recognized in the act of congress, and which was intended to be protected by its provisions, was the property which an author has, by the common law, *in his manuscript*, which would be protected by a court of chancery; and this protection was given, as well to books published under the provisions of the law, as to manuscript copies.

Congress, by the act of 1790, instead of sanctioning an existing perpetual right in an author in his works, created the right secured for a limited time by the provisions of that law.

origins, and trademarks were protected at common law and in equity at the time of the founding of our country”¹⁰⁶ The registration of a mark recognizes these preexisting rights; as such, courts have long viewed the roles of USPTO examiners in registering marks as a ministerial one, rather than discretionary.¹⁰⁷

In order for an agency to be one with discretionary functions, the agency must have policy-making authority, the ability to interpret its effectuating legislation, and have substantive rule-making authority.¹⁰⁸ Yet Congress has refused to grant the U.S. Patent and Trademark Office this authority.¹⁰⁹ Looking at the other side of the USPTO’s function, scholars such as

¹⁰⁶ *Matal v. Tam*, 137 S.Ct. 1744, 1751 (2017)(internal citations and quotations omitted).

¹⁰⁷ See Ryan Vacca, Acting Like an Administrative Agency: The Federal Circuit En Banc, 76 MO. L. REV. 733, 754–55 (2011)(“Although Congress regularly delegates its rulemaking and policy-setting authority in highly complex areas to administrative agencies, Congress has not delegated this authority to the PTO. Currently, the PTO’s only rulemaking authority is to set regulations governing the conduct of proceedings in the PTO. The Federal Circuit repeatedly has rejected claims that the PTO has authority to engage in substantive rulemaking.”)(internal citations omitted).

¹⁰⁸ See generally Administrative Procedure Act, 5 U.S.C §500-584 (1946); see also, e.g., *Motor Vehicle Mfrs. Ass’n of U.S., Inc. v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 41, 103 S. Ct. 2856, 2865, 77 L. Ed. 2d 443 (1983) (“Both the Motor Vehicle Safety Act and the 1974 Amendments concerning occupant crash protection standards indicate that motor vehicle safety standards are to be promulgated under the informal rulemaking procedures of § 553 of the Administrative Procedure Act.”)(internal citations omitted); See also Orin S. Kerr, Rethinking Patent Law in the Administrative State, 42 WM. & MARY L. REV. 127, 141 (2000)(“In general, legislatures create licensing regimes by delegating authority to administer the regime to an administrative agency in the executive branch. The legislature may indicate a few principles that should govern how the agency determines who receives a license, but the agency itself typically enjoys substantial discretion to determine most of the criteria, and to apply them as it sees fit.”); see also *infra*, notes 153 thru 161 and accompanying text, regarding the International Trade Commission’s policy- and rule-making authority.

¹⁰⁹ 35 U.S.C.A. § 1(a) (West)

In carrying out its functions, the United States Patent and Trademark Office shall be subject to the policy direction of the Secretary of Commerce, but otherwise shall retain responsibility for decisions regarding the management and administration of its operations and shall exercise independent control of its budget allocations and expenditures, personnel decisions and processes, procurements, and other administrative and management functions in accordance with this title and applicable provisions of law. Those operations designed to grant and issue patents and those operations which are designed to facilitate the registration of trademarks shall be treated as separate operating units within the Office.

35 U.S.C.A. § 1(a) (West); see also Vacca, *supra* note 107 (noting that the USPTO has limited rule-making authority regarding fee-setting and interpretive rules); Rayan Tai, Substantive Versus Interpretative Rulemaking in the United States Patent and Trademark Office: The Federal Circuit Animal Legal Defense Fund Decision, 32 IDEA 235, 238–39 (1992) (“An agency with broad rulemaking power can also make interpretative rules, versus an agency with no delegated rule making power that can only make interpretative rules.”); Charles E. Miller & Daniel P. Archibald, Interpretive Agency Rulemaking vs. Statutory District Court Review-Jurisdiction in Ex Parte

Professors Dan Burk, Mark Lemley, and Ryan Vacca have “viewed the USPTO as having only a ministerial role to play in the patent system-- examining patent applications and issuing patents for new inventions,”¹¹⁰ with extremely limited policy-making authority.¹¹¹ Patent examiners lack discretion and limitations with regard to their decisions to approve or deny applications,¹¹² are thus categorized as a having ministerial rather than discretionary function. Professors Burk and Lemley note that it is this contemplation of enforcement is outside the

Patent Reexaminations, 92 J. PAT. & TRADEMARK OFF. SOC'Y 498, 500 (2010)(Noting that “[t]he Court of Appeals for the Federal Circuit. . . consistent with Supreme Court precedent, has repeatedly held that the rulemaking authority of the Patent and Trademark Office . . . is limited by statute to the issuance of [non-substantive] rules “not inconsistent with law” that are either purely administrative, i.e., “which -- (A) govern the conduct of proceedings in the Office,” or interpretive, i.e., which express the agency’s views as to the meaning of particular statutes that govern its function, structure or operations.”).

¹¹⁰ Sarah Tran, Policy Tailors and the Patent Office, 46 U.C. Davis L. Rev. 487, 491–92 (2012)(citing Dan L. Burk & Mark A. Lemley, The Patent Crisis and How the Courts Can Solve It 13, 167-68 (2009)).

¹¹¹ See, e.g., Burke & Lemley, *supra* note 110, at 167-68 (“the PTO has virtually no policy staff and. . . little experience or apparent inclination to take a leadership role in setting patent policy.”); Vacca, *supra* note 107.

¹¹² Burk & Lemley, *supra* note 110, at 13 (“Examiners . . . review the application to determine whether the invention meets the statutory criteria for obtaining a patent.”). Professor Orin Kerr succinctly describes the nature of the examiner’s review process.

The PTO and its over three thousand patent examiners serve a narrowly circumscribed role in the private law patent system. The PTO has a ministerial task: to apply a legal standard determined by Congress and the courts to the facts presented to it by the patent applicant. If a patent applicant puts forward facts that meet the legal standard established by Congress in Title 35 of the U.S. Code, the PTO must issue the patent. If the applicant cannot put forward facts that meet the congressional standard, the PTO has no choice but to deny the application. Neither the patent examiners who first inspect new applications, nor the PTO's Board of Patent Appeals and Interferences (BPAI), which reviews adverse decisions, has any substantive power to interpret the offer's terms or discretion to decide whether an applicant is entitled to a patent. Patent examiners and the BPAI must evaluate patent applications and reach decisions based on the courts' interpretation of Congress's offer, rather than their own.

Kerr, *supra* note 108, at 138–40 (citing *Mannington Mills, Inc. v. Congoleum Corp.* 595 F.2d 1287, 1294 (3d Cir. 1979) (“[T]he granting of the patents per se [is] in substance [a] ministerial activity.”); *Brenner v. Ebbert*, 398 F.2d 762, 764 (D.C. Cir. 1968) (“[The] issuance of a patent . . . is a relatively ministerial act”); *Nobelpharma AB v. Implant Innovations, Inc.*, 930 F. Supp. 1241, 1253 (N.D. Ill. 1996) (noting that a patent examiner is a “ministerial official whose function is to apply policy set by others . . . to specific facts in ex parte proceedings”; *Grant v. Raymond*, 31 U.S. 218, 240 (1832) (Marshall, C.J.) (“If the prerequisites of the law be complied with, [the patent examiner] can exercise no judgment on the question whether the patent shall be issued.”); George E. Frost, Judge Rich and the 1952 Patent Code-A Retrospective, 76 J. PAT. & TRADEMARK OFF. SOC'Y 343, 350-51 (1994) (noting that the job of patent examiners is “to examine patent applications-not generate the law or make new law”).(additional internal citations omitted).

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purview of USPTO examiners patents, which makes that agency ill-equipped to set policy or perform the rule making functions that are normally part of an agency's duties.¹¹³

In addition, Professor Kelly Casey Mullally has distilled this ministerial role and the strict adherence to a rubric that USPTO examiners must use in their review of patent applications.

The examiners operate out of a voluminous and detailed reference work, the Manual of Patent Examining Procedure (MPEP), that does not have the force of law but that sets forth the agency's understanding of patent law. Although patent examiners apply the same legal rules that courts apply, they are not lawyers and they serve only a ministerial function, at least in the sense that examiners do not make the law or policy but merely administer the law created by Congress and the courts. The MPEP accordingly attempts to distill the law in an algorithmic fashion for making decisions based on substantive or procedural patent law so that examiners may apply the law to a given patent application using a step-by-step rubric.¹¹⁴

Professor Mullally goes on to note that “[t]he MPEP also provides language that examiners can simply copy into the written Office Actions that explain their decisions.

Ultimately, even complicated doctrine has to be condensed to a routinized, regimented format for examiners to apply within the limited time they have for each application.”¹¹⁵ As explored by Professor Orin Kerr, the patent system (and by extension the Trademark registration system), is closer to a private ordering than of the regulatory nature that normally associated with the

¹¹³ Burk & Lemley, *supra* note 110, at 106-07 (“The Patent and Trademark Office interacts regularly with those seeking patents [and trademarks], but very little with third parties affect by the patents [and trademarks] they grant.”).

¹¹⁴ Kelly Casey Mullally, Legal (Un)certainity, Legal Process, and Patent Law, 43 Loy. L.A. L. Rev. 1109, 1126–27 (2010)(internal citations omitted)

¹¹⁵ *Id.* at 1127–28 (2010)(internal citations omitted).

governmental functions of the granting of licenses and permits.¹¹⁶ Rather, he describes the patent system as one involving the private law regimes of contracts, torts, and property rights.¹¹⁷

This same rationale can be used regarding the other half of the USPTO—that trademark examiners also have only a ministerial role to play in the trademark registration system, and it is merely the recognition of private property rights. Trademark examiners review trademark applications and either issue or reject registrations based on specific criteria set forth in the Lanham Act and the Manual for Trademark Examining Procedure (MTEP).¹¹⁸ Indeed, the evaluation performed by trademark examiners is less rigorous than that performed on the patent side of the agency.¹¹⁹ A trademark examiner evaluates a registration application to ensure it is not barred under Section 2 for functionality, being merely descriptive, generic, or another of the

¹¹⁶ Kerr, *supra* note 108, at 135.

¹¹⁷ *Id.* at 134 (“In short, the patent laws create an offer, and the filing of a meritorious patent application constitutes an acceptance. The government’s quid pro quo is an intangible property right called a patent, which grants the owner the full range of traditional property rights over the use of the discovered invention.”)(internal citations omitted.)

¹¹⁸ 15 U.S.C. § 1052; see generally Manual for Trademark Examining Procedure § 800 (application requirements)

¹¹⁹ A patent examiner evaluates an application as to whether the invention is new, useful, and non-obvious, is statutory subject matter, and has been drafted properly with regard to disclosures and claims. See generally MPEP § 700 (Examination of Applications) and § 900 (Prior Art, Classification, and Search)

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limited prohibitions on registration.¹²⁰ It starts from the view that the registration should be granted, *unless* it falls within one of the exclusions specified in Section 2.¹²¹

B. *Iancu v. Brunetti* and Overlooking Enforcement as Government Speech

The Trademark Examining Attorney and the TTAB rejected Eric Brunetti's attempt to register his mark, FUCTION for athletic apparel, children's and infant's apparel,¹²² as comprising immoral or scandalous matter, barred under Section 2(a) of the Lanham Act,¹²³ as one of the most offensive words in the English Language.¹²⁴ The word, which the USPTO viewed as the

¹²⁰ 15 U.S.C. § 1052 (Lanham Act, §2) ("No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless...") MTEP § 1202.02 ("When an applicant applies to register a product design, product packaging, color, or other trade dress for goods or services, the examining attorney must separately consider two substantive issues: (1) functionality; and (2) distinctiveness."); MTEP § 1209.01

Fanciful, arbitrary, and suggestive marks, often referred to as "inherently distinctive" marks, are registrable on the Principal Register without proof of acquired distinctiveness.

Marks that are merely descriptive of the goods or services may not be registered on the Principal Register absent a showing of acquired distinctiveness . . . Merely descriptive marks may be registrable on the Supplemental Register in applications under §1 or §44 of the Trademark Act.

Matter that is generic for the goods or services is not registrable on either the Principal or the Supplemental Register under any circumstances.

(internal citations omitted)

¹²¹ 15 U.S.C. § 1052; MTEP § 12'07, 1209, 1210; *Guantanamo Cigar Co. v. Corporacion Habanos, SA*, 729 F.Supp.2d 246, 252 (denying registration of a geographically deceptively misdescriptive mark).

¹²² *In Re Brunetti*, 2014 WL 3976429 (2014). Marks are for source. Merely putting a word on an item of apparel does not confer rights in a Mark. However, usually a mark owner will use the name of the business—and thus the source of the goods—for both the brand name and the slogan/word displayed on the apparel.

See MicroStrategy Inc. v. Motorola, Inc., 245 F.3d 335, 342 (4th Cir. 2001) ("Although in the proper context . . . slogan . . . can serve as a trademark, a . . . slogan is certainly not by definition a trademark. Rather, . . . slogans *often* appear in such a context that they do not identify and distinguish the source of goods or services. In such cases, they are neither protectable nor registrable as trademarks") (citing 1 McCarthy § 7:20); § 7:23. Slogans as marks—Common phrases used as slogans, 1 McCarthy on Trademarks and Unfair Competition § 7:23 (5th ed.) (noting that "political slogans, which when applied to things like bumper stickers and t-shirts, do not serve as trademarks for those goods."); *In Re Hulting*, 107 U.S.P.Q.2d 1175 (T.T.A.B. 2013) ("The mere fact that applicant's slogan appears on the specimens, even separate and apart from any other indicia which appear on them, does not make it a trademark. To be a mark, the term, or slogan, must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods in question."); see generally Malte Farnaes, *Where's the Beef? Slogans As Marks Under the Lanham Act*, 19 J. CONTEMP. LEGAL ISSUES 81 (2010)

¹²³ 15 U.S.C. § 1052(a); Brunetti TTAB decision at *1.

¹²⁴ Brunetti TTAB at *3 , n.3.

phonetic equivalent of “Fucked” considers the term “vulgar, profane and scandalous slang.”¹²⁵

In its affirmation of the examiner’s rejection, the TTAB noted its lack of discretion in reaching its decision:

We readily recognize the statutory limitations of this tribunal. It is abundantly clear that the Trademark Trial and Appeal Board is not the appropriate forum for reevaluating the impacts of any evolving First Amendment jurisprudence within Article III courts upon determinations under Section 2(A) of the Lanham Act, or for answering Constitutional arguments of legal commentators or blog critics.¹²⁶

Relevant as well is the absence of any discussion regarding enforcement of the mark.

Based on the discussion *supra*, this is not surprising.

The Federal Circuit, citing to *Matal v. Tam*,¹²⁷ reversed the TTAB, instead holding “that § 2(a)’s bar on registering immoral or scandalous marks is an unconstitutional restriction of free speech,”¹²⁸ and reversed “the Board’s holding that Mr. Brunetti’s mark is unregistrable.”¹²⁹

Judge Moore briefly mentions that “[t]he government must expend certain federal funds, including . . . costs associated with trademark enforcement, in connection with trademark registration,”¹³⁰ but, like the TTAB’s decision, the Federal Circuit did not analyze or discuss enforcement as government speech.¹³¹ The only other mention of trademark enforcement as

¹²⁵ Id. at *1.

¹²⁶ Id. at *5.

¹²⁷ Brunetti, 877 F.3d at 1351 (“[T]he government does not have a substantial interest in promoting certain trademarks over others. The Supreme Court rejected the government’s claim that trademarks are government speech. Our conclusion that trademark registration is neither a government subsidy nor a limited public forum forecloses any remaining interest the government may have in approving only marks it “has deemed to be most suitable.” (citing to *Tam*, 137 S.Ct. at 1757–63)(plurality rejecting the government subsidy argument) (Alito, J.).

¹²⁸ *In re Brunetti*, 877 F.3d 1330, 1335 (Fed. Cir. 2017), *aff’d sub nom. Iancu v. Brunetti*, 139 S. Ct. 2294, 204 L. Ed. 2d 714 (2019)

¹²⁹ Id. In the TTAB’s defense, it decided Brunetti prior to the Supreme Court’s decision in *Matal v. Tam*.

¹³⁰ Id. at 1344 (citing *Tam*, 137 S.Ct. at 1761)

¹³¹ Judge Moore’s discussion regarding government resources is focused on the Constitution’s Spending clause as a rejected rationale for rejecting Eric Brunetti’s mark. “[T]o the extent government resources are tangentially involved with trademark registration, “just about every government service requires the expenditure of government funds.” Id. (citing *Tam*, 808 F.3d at 1353 (“Trademark registration does not implicate the Spending Clause merely

government speech was in dicta in the Federal Circuit's *en banc* opinion in *Tam*, where the court noted that the argument was not proffered by the government, and the court focuses on the use of the mark.¹³² In both *Tam* and *Brunetti*, the Supreme Court declined to address the issue of whether Trademark enforcement was governmental speech.¹³³ Rather, the Court based its decisions solely that barring registration of disparaging, immoral, and scandalous marks under Section 2(a) constitutes viewpoint discrimination of private speech,¹³⁴ which could not survive rigorous constitutional scrutiny.¹³⁵

None of the decisions in *Iancu v. Brunetti* at any court level contemplated trademark enforcement as a governmental benefit or government speech.¹³⁶ Rather the Court's decision relies on an implied understanding by the Court that the Trademark Office's registration program is of a ministerial nature rather than discretionary one.

because of this attenuated spending, else every benefit or regulatory program provided by the government would implicate the Spending Clause.”). The government’s involvement in processing and issuing trademarks does not transform trademark registration into a government subsidy.”)).

¹³² *In re Tam*, 808 F.3d at 1345 (“the government does not argue that a mark-holder's use or enforcement of its federally registered trademark is government speech. Use of a mark by its owner is clearly private speech. Trademarks identify the source of a product, and are often closely associated with the actual product. A mark's purpose—to identify the source of goods—is antithetical to the notion that a trademark is tied to the government.”).

¹³³ *Matal v. Tam*, 137 S. Ct. 1744, 1760–61, 198 L. Ed. 2d 366 (2017)(We next address the Government's argument that this case is governed by cases in which this Court has upheld the constitutionality of government programs that subsidized speech expressing a particular viewpoint. These cases implicate a notoriously tricky question of constitutional law. We have held that the Government may not deny a benefit to a person on a basis that infringes his constitutionally protected ... freedom of speech even if he has no entitlement to that benefit. But at the same time, government is not required to subsidize activities that it does not wish to promote.”) (internal citations and quotations omitted); *Iancu v. Brunetti*, 139 S. Ct. 2294, 2298–99, 204 L. Ed. 2d 714 (2019)(noting that in *Tam*, “no majority emerged to resolve whether a Lanham Act bar is a condition on a government benefit or a simple restriction on speech.”).

¹³⁴ See *Tam*, 137 S.Ct. at 1760 (“Trademarks are private, not government, speech.”).

¹³⁵ *Id.* at 1765, 198 L. Ed. 2d 366 (2017)(“§ 1052(a) constitutes viewpoint discrimination—a form of speech suppression so potent that it must be subject to rigorous constitutional scrutiny. The Government's action and the statute on which it is based cannot survive this scrutiny.”).

¹³⁶ *Iancu v. Brunetti*, 139 S.Ct. 2294 (2019); *In re Brunetti*, 877 F.3d 1330 (Fed. Cir. 2017); *In re Brunetti*, 2014 WL 3976439 (T.T.A.B. 2014).

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C. Direct Government Actions Entrenched in the Enforcement of Marks

Ownership of a mark—either registered or unregistered—is inconsequential unless it is enforceable. This section illustrates the government’s critical role in the enforcement of registered marks—through the Courts, Customs enforcement, and International Trade Commission (ITC) proceedings. Even if the registration of a mark is private speech, enforcement changes the equation and should have been considered by the *Brunetti* courts. After all, the benefits which registration confers benefits on the mark are most evident at enforcement.¹³⁷ While enforcement can be in the form of private cease & desist letters between the mark owner and the alleged infringer, without the threat of the remedies of injunctions, damages, and seizures—all of which require government action—any private enforcement attempt would be meaningless.

As discussed *supra*,¹³⁸ like the property deeds at issue in *Shelley v. Kramer*, trademark registration is similarly viewed by the Court as more a ministerial recordation of a private right than a state action or benefit—closer to the Recorder of Deeds registering a deed than the DMV approving a specialty license plate design. And just as enforcement of the deeds in *Shelley* changed a private right into a state action, *it is at the enforcement* of a mark that it becomes government speech. In other words, the plaintiffs in *Shelley* were attempting to enforce their private servitude rights in court, and this changed the dynamic from a private right to a state

¹³⁷ *Brunetti*, 139 S.Ct. at 2297-98 (“[R]egistration gives trademark owners valuable benefits. For example, registration constitutes “prima facie evidence” of the mark’s validity [in an infringement claim]. And registration serves as “constructive notice of the registrant’s claim of ownership,” which forecloses some defenses in infringement actions.”).

¹³⁸ See *supra* notes 94 to 99 and accompanying text

action,¹³⁹ and after the Court made this determination, it then examined how this affected the property owners' Constitutional rights. Likewise, once it is established that enforcement of a mark changes it from private speech to government speech, we then analyze the Constitutional implications of that declaration.

As for the former—the morphing from private speech to government speech via enforcement—a mark owner can seek remedies as private rights of action,¹⁴⁰ and a court has

¹³⁹ *Shelley v. Kraemer*, 334 U.S. 1, 18 (1948) (“It has been the consistent ruling of this Court that the action of the States...includes action of state courts and state judicial officials...it has never been suggested that state court action is immunized. . . simply because the action is that of the judicial branch of the . . . government.”)

Similar to contracts and torts actions, owners of valid Marks can seek remedies as private rights of action, and a court has discretion regarding enforcement of a private right of action, as long as that discretion is not abused. See Farnsworth, *supra* note 90 (“By affording legal sanctions for the enforcement of promises, society hopes to make it more likely than it would otherwise be that promises will be kept; private decision is supported by public force.”).

A private right of action takes the form of either a tort or a breach of contract. Trademark infringement would resemble a tort with regard to remedies; there is no agreement that the plaintiff is seeking to either have enforced, or seek remedies for its breach. Black’s Law Dictionary defines a private right of Action as “[a]n individual's right to sue in a personal capacity to enforce a legal claim.”

RIGHT OF ACTION, Black's Law Dictionary (11th ed. 2019)

¹⁴⁰ See *Clamp-All Corp. v. Cast Iron Soil Pipe Inst.*, No. CIV. A. 84-1325-Z, 1987 WL 9760, at *5 (D. Mass. Mar. 31, 1987), *aff'd*, 851 F.2d 478 (1st Cir. 1988) (“The Third Circuit has adopted a very broad reading of § 43, holding that it grants a private right of action in Federal Court for all claims of economic injury resulting from a false description or representation, whether or not that description had anything to do with registered trademarks.”); see also *Genus Lifesciences Inc. v. Lannett Co., Inc.*, 378 F. Supp. 3d 823, 832 (N.D. Cal. 2019), reconsideration denied, No. 18-CV-07603-WHO, 2019 WL 4168958 (N.D. Cal. Sept. 3, 2019) (“The Lanham Act creates a private right of action for competitors to bring claims for false or misleading advertising.”). Both 15 U.S.C. § 1114 (1) [§ 32(1)] and 15 U.S.C. § 1125(a)(1)(A) [§43(a)(1)(A)] provide for civil causes of action.

Any person who shall, without the consent of the registrant— use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, ***shall be liable in a civil action*** by the registrant for the remedies hereinafter provided. (emphasis added)

15 U.S.C. § 1114 (1) [§ 32(1)]

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods,

discretion regarding enforcement, as long as that discretion is not arbitrary or abused.¹⁴¹ A determination that enforcement of a mark is government speech would give courts latitude in whether immoral, scandalously offensive or vulgar marks are to be enforced in this private right of action against alleged infringers. Courts, however, only one venue where this state action—the enforcement of a mark (and the morphing of private speech into government speech)—occurs. First, there is an even stronger argument that the ability of Customs and Border Protection (“CBP”) to directly seize infringing goods entering our country is government speech. As this author has previously written,¹⁴² CBP has the authority and discretion under both the Lanham Act¹⁴³ and the Tariff Act of 1930¹⁴⁴ to seize counterfeit goods at ports of entry

services, or commercial activities by another person *shall be liable in a civil action* by any person who believes that he or she is or is likely to be damaged by such act. (emphasis added).

15 U.S.C.A. § 1125(a)(1)(A) [§43(a)(1)(A)].

¹⁴¹ See, e.g., *Klipsch Grp., Inc. v. ePRO E-Commerce Ltd.*, 880 F.3d 620, 627 (2d Cir. 2018) (“A district court abuses its discretion if it (1) bases its decision on an error of law or uses the wrong legal standard; (2) bases its decision on a clearly erroneous factual finding; or (3) reaches a conclusion that, though not necessarily the product of a legal error or a clearly erroneous factual finding, cannot be located within the range of permissible decisions.”).

¹⁴² Yvette Joy Liebesman, *Ex Parte Seizures Under the DTSA and the Shift of IP Rights Enforcement*, 1 BUS. ENTREPRENEURSHIP & TAX L. REV. 390 (2017). CBP personnel regularly seize counterfeit and otherwise infringing toys, computers, DVD, handbags, apparel, shoes, and consumer electronics. (citing Reinaldo Rodriguez, *CBP Intellectual Property Rights Seizure Statistics FY 2016*, TAGGART INT’L, LTD. (Jan. 23, 2017), <https://www.taggart-intl.com/cbp-intellectualproperty-rights-seizure-statistics-fy-2016/>; see also Thomas C. Frohlich, Alexander E.M. Hess, & Vince Calio, *9 Most Counterfeited Products in the USA*, USA TODAY (Mar. 29, 2014), <https://www.usatoday.com/story/money/business/2014/03/29/24-7-wall-stcounterfeited-products/7023233/>).

¹⁴³ 15 U.S.C. § 1124 (2012) (“[N]o article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer, or trader, or of any manufacturer or trader located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trademark registered in accordance with the provisions of this chapter . . . shall be admitted to entry at any customhouse of the United States[.]”); 19 C.F.R. § 133.21(b)(1) (2016) (“CBP may detain any article of domestic or foreign manufacture imported into the United States that bears a mark suspected by CBP of being a counterfeit version of a mark that is registered with the U.S. Patent and Trademark Office.”).

¹⁴⁴ See 19 U.S.C. § 1526(b) (2012) (“Any such merchandise imported into the United States in violation of the provisions of this section shall be subject to seizure and forfeiture for violation of the customs laws.”); see also Customs Border Protection Increases Seizure of Counterfeit and Pirated Goods in 2008, SHIPMAN & GOODWIN LLP (Apr. 3, 2009), <http://www.shipmangoodwin.com/customs-border-protection-increasesseizure-of-counterfeit-and-pirated-goods-in-2008>.

Both § 42 of the Lanham Act¹⁴⁴ and § 526 of the Tariff Act prohibit the importation of merchandise bearing a registered trademark without the mark owner’s consent.

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when the goods attempt to enter our stream of commerce.¹⁴⁵ The U.S. Code and the Code of Federal Regulations governing importations and customs are replete with directives and authorizations by which Customs officers may seize infringing articles. Under 19 C.F.R. § 133.21(b)(1), for example, “CBP may detain any article of domestic or foreign manufacture imported into the United States that bears a mark suspected by CBP of being a counterfeit version of a mark that is registered with the U.S. Patent and Trademark Office and is recorded with CBP.”¹⁴⁶

¹⁴⁵ Liebesman, *supra* note 142, n. 24 (“because there are situations where it be difficult for CBP agents to determine when goods are, in fact, counterfeit, enforcement is discretionary.”)(citing *Olympus Corp. v. U.S.*, 792 F.2d 315, 320 (2d Cir. 1986)) (“The administrative difficulties inherent in requiring the Customs Service to exclude gray market goods make clear why Customs has long and consistently interpreted section 526 to allow it to refuse to exclude the goods. Absent this bright line for administrative enforcement, the Customs Service would expend resources excluding goods when later private litigation could disclose that the markholder lacked isolable domestic good will and was merely engaging in price discrimination or other behavior questionable as a matter of antitrust law. Regulations that attempted to permit exclusion only of goods the markholders of which possessed discrete domestic good will would . . . place the Customs Service in the position of having to determine at the time of border crossing whether the domestic trademark holder had developed an independent public image in this country.”) (internal citation and quotations omitted)).

¹⁴⁶ 19 C.F.R. § 133.21(b)(1) See also 15 U.S.C.A. § 1124 (West)

No article of imported merchandise which shall copy or simulate a trademark registered in accordance with the provisions of this chapter or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, . . . shall be admitted to entry at any customhouse of the United States; and, in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader, . . . may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trademark, issued in accordance with the provisions of this chapter, to be recorded in books which shall be kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, . . . and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs.

15 U.S.C. 1124

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The authority is broad and discretionary,¹⁴⁷ and although the CBP has established procedures by which a mark owner may submit a Written Enforcement Request,¹⁴⁸ mere registration of the mark is all that is required for Customs to seize suspected infringing goods.¹⁴⁹ This reliance on direct government enforcement of their mark is a huge benefit to the rights owners. Instead of the mark owner expending funds and availing of the courts to enforce its

¹⁴⁷ 19 C.F.R. § 162.23(b)(3)

Permissive seizures. The following, if introduced or attempted to be introduced into the United States contrary to law, may be seized pursuant to section 596(c), Tariff Act of 1930, as amended (19 U.S.C. 1595a(c)) [m]erchandise or packaging in which copyright, trademark or trade name protection violations are involved (including, but not limited to, a violation of sections 42, 43 or 45 of the Act of July 5, 1946 (15 U.S.C. 1124, 1125 or 1127), sections 506 or 509 of title 17, United States Code, or sections 2318 or 2320 of title 18, United States Code).

Id. See also 19 CFR § 151.1 (“Merchandise to be examined. The port director shall examine such packages or quantities of merchandise as he deems necessary for the determination of duties and for compliance with the Customs laws and any other laws enforced by the Customs Service.”).

¹⁴⁸ See Department of Homeland Security, *What Every Member of the Trade Community Should Know About: CBP Enforcement of Intellectual Property Rights*, found at https://www.cbp.gov/sites/default/files/assets/documents/2017-Feb/enforce_ipr_3_0.pdf (last accessed June 5, 2020); see also Jeffrey H. Kaufman, *The Use of U.S. Customs To Enforce the Client’s IP Rights* 4-6, presented October 27, 2005 at the AIPLA 2005 Annual Meeting (found at <https://www.oblon.com/A11960/assets/files/News/319.pdf>), and provides a synopsis of the CBP’s enforcement guidance:

[A]fter registering a mark with the PTO, a trademark owner may apply to record its mark with the Customs Service Intellectual Property Rights Branch.

...

After recording trademark... registrations with Customs, trademark... owners will want to work closely with Customs to take actions against infringing imports. For example, when a trademark... owner becomes aware of or suspects that infringing products are entering the U.S., such owners should...(1) meet with the Intellectual Property Rights (IPR) Branch; (2) submit a Written Enforcement Request; and (3) Educate customs officials at ports of entry.

...

A trademark... owner should prepare a Written Enforcement Request. To the extent known, the request should provide as much detail as possible about each infringing good and each infringer...

...

If the IPR branch determines that the goods are violative of a trademark... it will enter into a database the information provided by the trademark ... owner regarding such infringement.

...

Customs may examine, take samples from, detain, and deny entry of imported goods bearing marks reasonably suspected of copying or simulating a registered mark in violation of [the Lanham Act].

Id. at 4-7.

¹⁴⁹ 19 C.F.R. § 162.21(a) (“Property may be seized ... by any Customs officer who has reasonable cause to believe that any law or regulation enforced by Customs and Border Protection or Immigration and Customs Enforcement has been violated, by reason of which the property has become subject to seizure or forfeiture.”).

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mark, they instead rely on taxpayer dollars and federal employees acting within the scope of their duties to do so. It has morphed the mark owner's registration from being a First Amendment free speech right into direct government action against the alleged counterfeiter and infringer.

Via the CBP, it is no longer the mark owner enforcing its trademark rights via a private right of action.¹⁵⁰ Now it is direct governmental intervention preventing the counterfeit and otherwise infringing goods from entering the U.S. stream of commerce. In other words, it is the government itself taking a discretionary state action against the alleged infringer to enforce the mark—and this has thus morphed trademark enforcement into government speech. Via these customs seizures, the government is now having its employees who monitor our ports of entry to directly seize the importer's goods and determine the course of action to be taken concerning the disputed merchandise.¹⁵¹ Adding to the argument, as explained *supra*, that CBP enforcement is government action and/or government speech is the fact that goods are seized at the discretion of the Customs official.¹⁵² This direct enforcement—this government seizure of property—reinforces this Author's argument that Trademark enforcement is government speech, and enforcement of offensive and vulgar marks should be assessed under this paradigm.

A second direct government actor enforcing trademark rights is the International Trade Commission (ITC),¹⁵³ who provide a substantial government benefit to the owner of a

¹⁵⁰ See discussion *supra*.

¹⁵¹ 19 C.F.R. § 162.21(a)

¹⁵² See *supra* note 145.

¹⁵³ 19 U.S.C. § 1337(a)(1)(C)(West)

the following are unlawful, and when found by the Commission to exist shall be dealt with, in addition to any other provision of law, as provided in this section: The importation into the United States, the sale for importation, or the sale within the United States after importation by the owner, importer, or consignee, of articles that infringe a valid and enforceable United States trademark registered under the Trademark Act of 1946.”

Id.

registered mark. Under the Tariff Act of 1930, the ITC (or as it was then called, the Tariff Commission) was afforded rule-making authority,¹⁵⁴ as well as investigative powers over acts of unfair competition related to international trade.¹⁵⁵ It is the primary governmental agency that investigates alleged unfair imports via their authority under 19 U.S.C. § 1337 (referred to by the agency as “Section 337” based on the previous codification of the statute).¹⁵⁶ The ITC investigates assertions of infringement “regarding intellectual property rights, including allegations of patent infringement and trademark infringement by imported goods. . . .as well as registered . . . trademarks. . . and false advertising.”¹⁵⁷ It is a quasi-executive branch agency, led by commissioners who are nominated by the President and confirmed by the Senate.¹⁵⁸ These Commissioners have the ability to investigate alleged import violations

the Commission's own motion, upon request of the President or the United States Trade Representative, upon resolution of the Committee on Ways and Means of the House of Representatives or the Committee of Finance of the Senate, upon resolution of either branch of Congress, or upon application, petition, complaint, or request of private parties.¹⁵⁹

In other words, it can investigate and enforce registered marks owned by private individuals on its own initiative or via a request made by the executive or legislative branch, even without it being formally requested by the mark owner. The ITC’s fact-finding

¹⁵⁴ § 1335 (West)(“The commission is authorized to adopt such reasonable procedures and rules and regulations as it deems necessary to carry out its functions and duties.”).

¹⁵⁵ See generally Sapna Kumar, *Regulating Digital Trade*, 67 FLA. L. REV. 1909, 1915–16 (2015)

¹⁵⁶ United States International Trade Commission: About unfair import investigations, found at https://www.usitc.gov/intellectual_property/about_section_337.htm#337tools (last accessed June 6, 2020).

¹⁵⁷ United States International Trade Commission: About unfair import investigations, found at https://www.usitc.gov/intellectual_property/about_section_337.htm#337tools (last accessed June 6, 2020).

¹⁵⁸ 19 U.S.C.A. § 1330(a) (West)(“Membership. The United States International Trade Commission (referred to in this subtitle as the “Commission”) shall be composed of six commissioners who shall be appointed by the President, by and with the advice and consent of the Senate.”).

¹⁵⁹ 19 C.F.R. § 201.7

adjudications are conducted by Article I Administrative Law Judges.¹⁶⁰ After a finding of infringement, these quasi-executive-branch adjudicators have several remedies at their disposal to prevent the imports from entering the country's stream of commerce, including "an exclusion order that directs Customs to stop infringing imports from entering the United States," as well as the issuance of "cease and desist orders against named importers and other persons engaged in unfair acts that violate Section 337."¹⁶¹

Even if one deems that it is not a state action or government speech when a mark owner enforces its mark via a private right of action in a court of law, the authority granted to the ITC regarding imports is direct government action of enforcement of a mark, and can therefore be reasonably classified as government speech.

IV. Limiting *Brunetti* Through Enforcement as Government Speech

Alleged infringers could argue that because enforcement of an obscene mark is a government speech, it is within a court's discretion to refuse to enforce immoral, scandalous or offensive marks without running afoul of *Brunetti*. Such an argument would also be an avenue by which the Supreme Court could reconsider its decision in *Brunetti* regarding the

¹⁶⁰ § 207.112(a) ("An opportunity for a hearing before an administrative law judge shall be provided for each action initiated under § 207.102 of this subpart. The purpose of such hearing shall be to receive evidence and hear argument in order to determine whether a charged party has committed a prohibited act and if so, what sanctions are appropriate."); see also United States Trade Commission: Administrative Law Judges Bios, found at https://www.usitc.gov/alj_bios ("The primary role of our ALJs is to conduct the trial phase of Commission investigations under section 337 of the Tariff Act of 1930 (19 U.S.C. 1337). The Chief ALJ assigns the investigation to one of the ALJs, who rules on motions during the trial stage. After the trial, the ALJ makes an initial determination as to whether a violation of section 337 exists, and makes findings of fact and law and recommendations as appropriate.").

¹⁶¹ United States International Trade Commission: About unfair import investigations, found at https://www.usitc.gov/intellectual_property/about_section_337.htm#337tools (last accessed June 6, 2020).

governmental speech aspect of mark registration.¹⁶² However, limits would be needed on this judicial and agency discretion to avoid eviscerating all of trademark law.

A. Enforcement of a Mark as Government Speech

As noted *supra*, when determining whether a mark's registration could be classified as government speech, it is important to look beyond the actions of the Patent and Trademark Office's registration, which only considers the MTEP rubrics.¹⁶³ Enforcement of trademark rights is a discretionary function, and can be effectuated not just by the judiciary, but also two government agencies.¹⁶⁴ By assessing the mark from the point of view of enforcement, immoral, scandalous, and offensive marks can be limited at the point of enforcement—an argument can also be used to challenge validity by an alleged infringer. Thus, while registration may not be governmental speech, enforcement of a mark—either via the courts, customs, or the ITC—should be classified as such.¹⁶⁵

¹⁶² *Iancu v. Brunetti*, 139 S. Ct. 2294, 204 L. Ed. 2d 714 (2019)

¹⁶³ See generally Manual for Trademark Examination Procedures, Chapters 800, 900, 1200 & 1400

¹⁶⁴ See *supra* notes 47 to 48 and accompanying text

¹⁶⁵ Enforcement of a mark can be thought of as constitutional censorship—what a Mark owner is asking the court or CBP is to enjoin another from exercising their first amendment free speech right. It is limited to purely commercial speech to avoid having this discretion used to enjoin another's speech from encroaching on a defendant's First Amendment speech rights. See generally Ramsey, Lisa P., Increasing First Amendment Scrutiny of Trademark Law, 61 S. METHODIST UNIV. L. REV 381 (2008); see also *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of New York*, 447 U.S. 557, 561, 100 S. Ct. 2343, 2349, 65 L. Ed. 2d 341 (1980)(articulating the test for determining whether a particular commercial speech regulation is constitutionally permissible.); *Thompson v. W. States Med. Ctr.*, 535 U.S. 357, 367, 122 S. Ct. 1497, 1503–04, 152 L. Ed. 2d 563 (2002)(Although commercial speech is protected by the First Amendment, not all regulation of such speech is unconstitutional.); *Zauderer v. Office of Disciplinary Counsel of Supreme Court of Ohio*, 471 U.S. 626, 637, 105 S. Ct. 2265, 2274, 85 L. Ed. 2d 652 (1985)("[C]ommercial speech doctrine rests heavily on 'the 'common-sense' distinction between speech proposing a commercial transaction ... and other varieties of speech...'"); *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 762, 96 S. Ct. 1817, 1825–26, 48 L. Ed. 2d 346 (1976)("Our question is whether speech which does "no more than propose a commercial transaction is so removed from any "exposition of ideas," and from " "truth, science, morality, and arts in general, in its diffusion of liberal sentiments on the administration of Government," " that it lacks all protection. Our answer is that it is not."); *Bolger v. Youngs Drug Prod. Corp.*, 463 U.S. 60, 67–68, 103 S. Ct. 2875, 2880–81, 77 L. Ed. 2d 469 (1983) (addressing the issue of how to classify speech with both noncommercial and commercial elements); *IMS Health Inc. v. Sorrell*, 630 F.3d 263, 274 (2d Cir. 2010), *aff'd*, 564 U.S. 552, 131 S. Ct. 2653, 180 L. Ed. 2d 544 (2011)("[T]he mere presence of non-commercial information in an otherwise commercial presentation does not transform the communication into fully protected speech.") .

Courts generally have equitable authority to determine whether to grant relief,¹⁶⁶ and judicially-created equitable doctrines fill in gaps that were omitted during a statute's legislative creation. For example, Judge Friendly in *Abercrombie & Fitch v. Hunting World* developed the heavily-relied upon levels of distinctiveness used to measure both the strength of a mark, and whether it is inherently distinctive or requires the acquisition of secondary meaning in order to be a valid mark.¹⁶⁷ Trademark law's nominative Fair Use defense,¹⁶⁸ and its First Sale doctrine,¹⁶⁹ are also judicially created. Applying this discretion to the Lanham Act would permit a court to make an equitable determination to refuse enforcement of marks that are generally found to be offensive, vulgar or scandalous. Indeed, the Lanham Act specifically states that courts, when determining remedies are to do so "according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation"¹⁷⁰ of a mark owner's rights. By assessing at the point of enforcement rather than registration, a court would

¹⁶⁶ See *Hecht Co. v. Bowles*, 321 U.S. 321, 329–30, 64 S. Ct. 587, 592, 88 L. Ed. 754 (1944) ("The essence of equity jurisdiction has been the power of the Chancellor to do equity and to mould each decree to the necessities of the particular case. Flexibility rather than rigidity has distinguished it. The qualities of mercy and practicality have made equity the instrument for nice adjustment and reconciliation between the public interest and private needs as well as between competing private claims.."); see generally Samuel L. Bray, *The Supreme Court and the New Equity*, 68 VAND. L. REV. 997 (2015).

¹⁶⁷ *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (noting that caselaw identifies "four different categories of terms with respect to trademark protection. Arrayed in an ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these classes are (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful."); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 112 S. Ct. 2753, 2757, 120 L. Ed. 2d 615 (1992) ("Marks are often classified in categories of generally increasing distinctiveness; following the classic formulation set out by Judge Friendly [in *Abercrombie & Fitch v. Hunting World*], they may be (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.").

¹⁶⁸ See generally Yvette Joy Liebesman and Benjamin Wilson, *The Mark of a Resold Good*, 20 GEO. MASON L. REV. 157, 183-88 (2012) (discussing the judicial construct/creation of trademark nominative fair use and which circuits have adopted it as an affirmative defense.); Restatement (Third) of Unfair Competition § 24 (1995) ("One is not subject to liability . . . for using another's trademark, trade name, collective mark, or certification mark in marketing genuine goods or services the source, sponsorship, or certification of which is accurately identified by the mark.").

¹⁶⁹ *Id.* at 189 ("While first sale is legislatively created in the Copyright Act, trademark and patent first sale (or exhaustion) affirmative defenses are long-recognized judicial constructs.").

¹⁷⁰ 15 U.S.C.A. § 1116 (West) See also 15 U.S.C. 1117(a) ("When a violation of any right of the [Mark owner]. . . shall have been established in any civil action arising under this chapter, the plaintiff shall be entitled . . . **subject to the principles of equity**, to recover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action.") (emphasis added)

have the ability to revisit the offensiveness bar of the Lanham Act to reach the opposite conclusion without actually reversing *Brunetti*.

B. Using Enforcement to Revisit the *Brunetti* Decision

The arguments herein could be used to both follow *Brunetti*'s holding with regard to registration, yet provide a safe harbor for the courts to refuse enforcement of such marks that would have previously been barred from registration under the Section 2(a) prohibition of registration of immoral or scandalous matter.¹⁷¹ This linkage between enforcement and government speech would also provide the opportunity to reverse *Brunetti*, and reinstate the “immoral” and “scandalous” bars to trademark registration. As discussed *supra*,¹⁷² when the Court held in *Brunetti* and *Tam* that registration of marks was not government speech, it did not discuss enforcement as government speech. This omission provides the Court with the opportunity to preserve the holding in *Brunetti* with regard to registration, yet find that there is a governmental benefit or state action with regard to enforcement, and thereby reestablishing the Section 2(a) ban on a limited set of obscene or scandalous words from being used as valid marks.

The Court's decision in *Tam* would not be affected if this enforcement mechanism is applied, with an exception. Based on the limitations described *infra*, the holding in *Tam* would be inapplicable when the disparaging mark incorporates a patently offensive or vulgar word, such as the N-word, the C-word, or the F-bomb.¹⁷³ *Tam* was generally correctly decided, and

¹⁷¹ 15 U.S.C. § 1052(a) (Lanham Act, §2(a)) (“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it consists or comprises immoral . . . or scandalous matter.”)

¹⁷² See *supra* notes 127 to 135 and accompanying text.

¹⁷³ See generally Gibbons, *supra* note 30.

even when examining the enforcement of such marks, applying this limited prohibition on certain words as marks would not result in *Tam*'s blanket reversal. Disparaging marks may still be limited via the enforcement mechanism herein where the words or symbols at issue fall within a narrowly defined, previously affirmed, class of obscene or vulgar words.¹⁷⁴

C. Unregistered Marks and State Registration as Vehicles to Challenge *Brunetti*

In order to challenge the holding in *Brunetti* based on enforcement, there must first be an infringement suit or other means which adjudicates the allegedly infringing mark. The Lanham Act itself provides the underlying statutory scheme upon which relief can be granted to the plaintiff.¹⁷⁵ There are several ways this could occur. First, an alleged infringer could raise the issue of validity of the Plaintiff's registered mark as a defense in an infringement suit under Section 32(1), challenging the plaintiff's prima facie assertion,¹⁷⁶ based on the arguments herein. The government's arguments regarding registrability of obscenities and profanities that are purportedly used as marks would be equally applicable to their enforcement.¹⁷⁷

¹⁷⁴ See *infra* IV.D.; see also *Miller v. California*, 413 U.S. 15 (1973).

¹⁷⁵ Fed. R. Civ. P. 12(b)(6) ("a party may assert the following defense[] by motion: failure to state a claim upon which relief can be granted"); *Bennett v. Spear*, 520 U.S. 154, 162, 117 S. Ct. 1154, 1161, 137 L. Ed. 2d 281 (1997) ("[A] plaintiff's grievance must arguably fall within the zone of interests protected or regulated by the statutory provision or constitutional guarantee invoked in the suit.").

¹⁷⁶ 15 U.S.C. § 1114(1)[§ 32(1)](civil liability for infringing on a registered Mark).

¹⁷⁷ To date, few courts have opined on whether the full list of unregistrable marks are under Section 2 are unenforceable under Section 42(a)(1)(A), though courts will not enforce a purported mark that is generic, functional, or in other ways barred from registration. See *Matal v. Tam*, 137 S. Ct. 1744, 1753, 198 L. Ed. 2d 366 (2017) ("We need not decide today whether respondent could bring suit under § 43(a) if his application for federal registration had been lawfully denied under the disparagement clause."); see also *In re Tam*, 808 F.3d 1321, 1344 (Fed. Cir. 2015), as corrected (Feb. 11, 2016), *aff'd sub nom. Matal v. Tam*, 137 S. Ct. 1744, 198 L. Ed. 2d 366 (2017) ("courts have suggested that § 43(a) is only available for marks that are registrable under § 2. See *Two Pesos*, 505 U.S. at 768, 112 S.Ct. 2753 (section 43(a) "protects qualifying unregistered trademarks and ... the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a)"); *Yarmuth-Dion, Inc. v. D'ion Furs, Inc.*, 835 F.2d 990, 992 (2d Cir.1987) (requiring a plaintiff to "demonstrate that his [unregistered] mark merits protection under the Lanham Act"); see also *Renna v. Cty. of Union*, 88 F.Supp.3d 310, 320 (D.N.J.2014) ("Section 2 declares certain marks to be unregistrable because they are inappropriate subjects for trademark protection. It follows that such unregistrable marks, not actionable as registered marks under Section 32, are not actionable under Section 43, either."). And we have found no case allowing a § 43(a) action on a mark rejected or cancelled under § 2(a)."); see also Rebecca Tushnet, *Registering Disagreement: Registration in Modern American*

Second, if the Plaintiff is asserting rights in an unregistered mark under Section 43(a)(1)(A),¹⁷⁸ then the alleged infringer could challenge the validity of the mark under the same—though failing—arguments made by the TTAB when it denied registration to Eric Brunetti.¹⁷⁹ While registration is *prima facie* evidence of the validity of a mark,¹⁸⁰ when litigating a false designation of origin claim of an unregistered mark under Section 43(a)(1)(A), the plaintiff must, as part of their *prima facie* case, establish the validity of their mark.¹⁸¹ The alleged infringer would then be able to raise as a defense the “enforcement as government speech” discussed *supra*. The alleged infringer could argue (maybe successfully) that the conjoined judicial recognition of the validity and enforcement of a mark is government speech, and it is thus exempt from First Amendment viewpoint discrimination considerations. The alleged infringer could thus request that the court refuse to enforce the plaintiff’s mark, or even resurrect the §2(a) bar on immoral or scandalous marks to invalidate the plaintiff’s mark.

Third, a similar argument could be made via an ITC proceeding to challenge to the seizure of imported goods by Customs and Border Patrol.¹⁸² In these latter two actions, the argument that direct governmental seizure of infringing imported goods, and challenge to that

Trademark Law, 130 HARV. L. REV. 867, 885 (2017)(noting that there is a “question whether a claimed designation qualifies as a trademark is . . . independent of the question of registrability.”). Professor Tushnet argues that “there are reasons to think that to think that the exclusions in section 2 reflect public policies that also apply to unregistered marks.” And supports her contention by pointing out that section 2 registration bars on generic and merely descriptive marks, among others, would be unenforceable as unregistered marks.).

¹⁷⁸ 15 U.S.C. §1125(a)(1)(A).

¹⁷⁹ *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019).

¹⁸⁰ 15 U.S.C.A. § 1115 (West)

Any registration . . . of a mark registered on the principal register . . . and owned by a party to an action shall be admissible in evidence and shall be *prima facie* evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein.)

¹⁸¹ *Yellow Cab Co. of Sacramento v. Yellow Cab of Elk Grove, Inc.*, 419 F.3d 925, 928 (9th Cir. 2005)(“when a mark is not registered, the presumption of validity does not apply; therefore, the plaintiff is left with the task of satisfying its burden of proof of establishing a valid mark absent application of the presumption.”)

¹⁸² See discussion *supra*.

seizure, is government speech, and is the strongest indication that a mark's registration is government speech.

A final avenue for challenging the validity of a vulgar, scandalous, or immoral mark is via a state trademark/unfair competition statute or common law. Most states have a similar bar to registration,¹⁸³ though via *Tam* and *Brunetti*, these are also invalidated unconstitutional viewpoint discrimination.¹⁸⁴ State trademark examiners, however, could use the argument raised in this article regarding enforcement to defend any challenge to a rejected mark based on a scandalous or immoral determination.

D. Preventing the evisceration of all of Trademark Law

To hold that enforcement of a mark is a government action or government speech could—if taken to the extreme—result in the evisceration of the entirety of the Lanham Act. Indeed, the Court in *Tam* was concerned that mere governmental support in the form of sponsorship or subsidy could turn almost all private speech into government speech, and thus immune to First Amendment free speech considerations.¹⁸⁵ While an appellate court could hold that a jurist abused their discretion in particular instances, this is not the optimal way to handle or restrict the breadth of a court or border patrol agent's ability to decide which marks are worthy of enforcement.

If too much discretion is allowed, a jurist could use their own proclivities and dislikes to refuse enforcement of marks they personally find offensive. One could imagine a staunch

¹⁸³ With the exception of Colorado, Maine, and Wisconsin, state trademark and unfair competition statutes mimic the language in the Lanham Act regarding registration bars for scandalous, immoral, and disparaging marks.

¹⁸⁴ No state has yet begun to remove the language from its trademark/unfair competition statute, nor has there been a challenge to these registration bars at the state level.

¹⁸⁵ *Matal v. Tam*, 137 U.S. 1744, 1758 (2017) (“[W]hile the government-speech doctrine is important—indeed, essential—it is a doctrine that is susceptible to dangerous misuse. If private speech could be passed off as government speech by simply affixing a government seal of approval, government could silence or muffle the expression of disfavored viewpoints. For this reason, we must exercise great caution before extending our government-speech precedents.” To government subsidized speech).

Chicago Cubs fan on the bench refusing to enforce the mark of their arch-rivals, the Saint Louis Cardinals. While an appellate court could find that such a decision is an abuse of discretion, avoiding such abuse is preferable to having the litigation continue in order to reach that holding.

A solution which avoids any abuse of discretion by Cubs-fan jurists can be found by transferring limits found in other areas of speech law, where certain words are legally allowed to be censored. Using the FCC's prohibitions and definitions could solve the potential that this argument could be used against any plaintiff enforcing their mark, and eviscerate all trademark law, and provide the USPTO with the ability to once again refuse registration of marks containing the prohibited words.

For example, with regard to the problem of vagueness of definitions expressed by the majority in *Brunetti*, a court could solve this by applying the rationale in Justice Sotomayor's dissent,¹⁸⁶ and narrowly defining "scandalous" to mean obscenity, vulgarity, or profanity,¹⁸⁷ which would be in line with the Court's obscenity doctrine.¹⁸⁸

As articulated by Justice Sotomayor, the definition of "obscene" is not vague—the decision of *Miller v. California*¹⁸⁹ affirmed that obscenity can be constitutionally defined, construed and applied to pass constitutional muster.¹⁹⁰ She also noted that scandalous vulgarity or profanity could be defined based on the FCC's definition, which confines that list to a small

¹⁸⁶ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2308 (2019) (Sotomayor, J. dissenting) ("As for what constitutes 'scandalous' vulgarity or profanity, I do not offer a list, but I do interpret the term to allow the PTO to restrict (and potentially promulgate guidance to clarify) the small group of lewd words or 'swear' words that cause a visceral reaction, that are not commonly used around children, and that are prohibited in comparable settings.") (internal citations omitted).

¹⁸⁷ *Inacu*, 139 S. Ct. 2294, 2311 (2019) (Sotomayor, J. dissenting).

¹⁸⁸ *Miller v. California*, 413 U.S. 15, 24 (1973).

¹⁸⁹ *Id.* at 24-26 *Miller* provides the following guideline for the trier of fact in an obscenity determination: "(a) whether 'the average person, applying contemporary community standards' would find that the work, taken as a whole, appeals to the prurient interest; (b) whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law; and (c) whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value." (internal citations omitted)

¹⁹⁰ *Id.* at 23-24.

group of lewd words or “swear” words that cause a visceral reaction, that are not commonly used around children, and that are prohibited in comparable settings,¹⁹¹ including the prohibition of obscene, indecent or profane language in radio communications in 18 U.S.C. § 1464.¹⁹² Words which meet the definition of vulgarity have also been clearly defined by the courts “to mean ‘morally crude’ or ‘marked by coarseness of speech or expression[.]’ . Alternatively, it means ‘making explicit and offensive reference to sex or bodily functions; coarse and rude.’”¹⁹³ Indeed, “[i]t has long been held that despite the sanctity of the First Amendment, speech that is vulgar or profane is not entitled to absolute constitutional protection.”¹⁹⁴ And obliging the government to enforce a vulgar mark should be considered one of those situations.

One could also use—both as a limiting vehicle and this author’s enforcement argument— Justice Breyer’s dissent in *Brunetti*. He noted that while some consumers may be attracted to products labeled with highly vulgar or obscene words, others may believe that such words should not be displayed in public spaces where goods are sold and where children are likely to be present.¹⁹⁵ The Court has long held that “First Amendment jurisprudence recognizes an interest in protecting minors from exposure to vulgar and offensive spoken language, as well as limitations on the otherwise absolute interest of the speaker in reaching an unlimited

¹⁹¹ *Denver Area Ed. Telecommunications Consortium, Inc. v. FCC*, 518 U. S. 727, 743 (1996) (plurality opinion) (noting the Government’s interest in “protec[ting] children from exposure to patently offensive sex-related material”); *Ginsberg v. New York*, 390 U. S. 629, 640 (1968) (noting the government’s “interest in the well-being of its youth”).

¹⁹² 18 U.S.C.A. § 1464 (West)(“Whoever utters any obscene, indecent, or profane language by means of radio communication shall be fined under this title or imprisoned not more than two years, or both.”). The FCC has defined profane content, defined as “grossly offensive language that is considered a public nuisance.” Federal Communications Commission, *Obscene, Indecent and Profane Broadcasts*, found at <https://www.fcc.gov/consumers/guides/obscene-indecnt-and-profane-broadcasts>

¹⁹³ “*Knotts v. Oregon Trail Sch. Dist.* 46, No. 3:15-CV-02296-AC, 2017 WL 4861521, at *4 (D. Or. Oct. 26, 2017)(internal citation omitted).

¹⁹⁴ *Bonnell v. Lorenzo*, 241 F.3d 800, 821 (6th Cir. 2001).

¹⁹⁵ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2307 (2019) (Breyer, J. dissenting).

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audience where the speech is sexually explicit and the audience may include children.”¹⁹⁶

Governmental refusal to support a vulgar mark through an enforcement action would be in line with the Courts rationale in *Denver Area Ed. Telecommunications Consortium, Inc. v. FCC*,¹⁹⁷ where the Court held that the Government has an interest in protecting the sensibilities of children, and thus the FCC was allowed to enforce a prohibition against vulgar or obscene words.¹⁹⁸

This argument regarding enforcement as government speech and the necessary associated limitations is also in line with Chief Justice Roberts in his *Brunetti* dissent.¹⁹⁹

Whether such marks can be registered does not affect the extent to which their owners may use them in commerce to identify goods. No speech is being restricted; no one is being punished. . . . [but] The Government, . . . has an interest in not associating itself with trademarks whose content is obscene, vulgar, or profane. The First Amendment protects the freedom of speech; it does not require the Government to give aid and comfort to those using obscene, vulgar, and profane modes of expression.²⁰⁰

Even though this was a not a rationale accepted by the majority in *Brunetti* with regard to registration, applying it to enforcement would not be in conflict with that decision, and could find legs when a mark owner is asking a court to enforce its vulgar or obscene mark as a way to overturn *Brunetti* and reinstituting the narrow the scope of the bar as outlined above.

¹⁹⁶ Bethel Sch. Dist. No. 403 v. Fraser, 478 U.S. 675, 676, 106 S. Ct. 3159, 3161, 92 L. Ed. 2d 549 (1986), citing FCC v. Pacifica Foundation, 438 U.S. 726, 98 S.Ct. 3026, 57 L.Ed.2d 1073 and Ginsberg v. New York, 390 U.S. 629, 88 S.Ct. 1274, 20 L.Ed.2d 195 (1968).

¹⁹⁷ *Denver Area Ed. Telecommunications Consortium, Inc. v. FCC*, 518 U. S. 727, 743 (1996) (plurality opinion) (noting the Government’s interest in “protec[ting] children from exposure to patently offensive sex-related material”); *Ginsberg v. New York*, 390 U. S. 629, 640 (1968) (noting the government’s “interest in the well-being of its youth”).

¹⁹⁸ *Denver Area Ed. Telecommunications Consortium, Inc. v. FCC*, 518 U. S. 727, 743 (1996).

¹⁹⁹ *Iancu v. Brunetti*, 139 S.Ct. 2294, 2303 (2019)(Roberts, CJ, dissenting)

²⁰⁰ *Id.*

V. Final Thoughts

This article illustrates how the government's role in trademark enforcement is arguably government speech, and thus could be used to deny relief to the owner of an obscene or vulgar mark in an infringement action. Enforcement refusal would be harmonious with the line of decisions discussed *supra*, though any refusal to enforce a mark owner's rights would have to be narrowly construed to avoid arbitrary non-enforcement to any trademark a particular jurist finds objectionable.

It is yet to be determined is whether the courts will adopt this reasoning to refuse enforcement of a mark based on offensiveness or vulgarity, and whether the Supreme Court will agree. It will be interesting to see if infringers of F-U-C-T or Cocksuckers²⁰¹—or other even more offensive, reprehensible, vulgar words and egregious racial epithets— will find a court that is receptive to this argument. This article has demonstrated that it is reasonable for courts to limit *Tam* and *Brunetti*, and even advocate for a reversal of the latter. If a mark Owner asking a court, Customs, or the ITC to enforce their mark, these governmental bodies should have a limited right to use their discretion to “Just Say No.”²⁰² And by linking enforcement to registration, the USPTO's would once again be able to prohibit the registration of a short list of vulgar epithets.

²⁰¹ *In re Fox*, 702 F.3d 633 (Fed. Cir. 2012).

²⁰² CNN, *CNN: 1986: Nancy Reagan's 'Just say no' campaign*, YOUTUBE (Feb. 28, 2011), <https://www.youtube.com/watch?v=lQXgVM30mIY>.