

American University Washington College of Law

Digital Commons @ American University Washington College of Law

Contributions to Books

Scholarship & Research

2019

Public Policy Limitations on Trademark Subject Matter: A U.S. Perspective

Christine Farley

American University Washington College of Law, cfarley@wcl.american.edu

Follow this and additional works at: https://digitalcommons.wcl.american.edu/facsch_bk_contributions



Part of the [First Amendment Commons](#), and the [Intellectual Property Law Commons](#)

Recommended Citation

Farley, Christine, "Public Policy Limitations on Trademark Subject Matter: A U.S. Perspective" (2019). *Contributions to Books*. 100.

https://digitalcommons.wcl.american.edu/facsch_bk_contributions/100

This Book Chapter is brought to you for free and open access by the Scholarship & Research at Digital Commons @ American University Washington College of Law. It has been accepted for inclusion in Contributions to Books by an authorized administrator of Digital Commons @ American University Washington College of Law. For more information, please contact kclay@wcl.american.edu.



American University Washington College of Law

Washington College of Law Research Paper No. 2019-13

PUBLIC POLICY LIMITATIONS ON TRADEMARK SUBJECT MATTER: A U.S. PERSPECTIVE

Christine Haight Farley

This paper can be downloaded without charge from
The Social Science Research Network Electronic Paper Collection

Public Policy Limitations on Trademark Subject Matter: A U.S. Perspective

Christine Haight Farley*

I. Introduction

What public policy objectives are contained in the subject matter limitations of U.S. trademark law? This question has not been a focus of attention for U.S. legal scholars, but that may be about to change. The general public policies that animate trademark law—encouraging fair competition and protecting consumers from deceptive practices—can certainly be found in some of the doctrines that constrain trademark subject matter. Some of the specific constraints found in U.S. law, however, do not align with these traditional trademark policy goals. These instances raise fascinating questions such as what policy goals are being advanced in these provisions, and are these policy goals appropriate within trademark law. These are the questions that lie behind the currently live question of whether the government’s denial of registration based on justifications outside the heart of trademark law is a valid restriction on speech.

Rather than explicitly announcing the policy goals of restricting trademarks, U.S. trademark law is somewhat tacit about the reasons behind the rules. For instance, what is the policy reason behind the prohibition on the registration of immoral, scandalous, and disparaging marks?¹ Until just a few years ago, commentators would have unthinkingly stated that the bar enables the government to protect the public from harmful marks.² That answer would have not only lacked statutory and legislative history support, but it would have failed to account for why harmful marks may still be used and even protected under federal law. While the trademark laws in other jurisdictions may be explicit about their objectives of protecting “morality” and “public order,”³ U.S. trademark has never included a reference to public order, and other than the presence of the word “immoral,” the statute provides no clue as to what concerns animated Congress’ reference to morality.⁴

* Professor, American University Washington College of Law. I am grateful to Bianca Petcu for invaluable research assistance.

¹ See Trademark (Lanham) Act of 1946, 15 U.S.C. § 1052(a)(1) (2018).

² See Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661, 788 (1993).

³ Many countries that ratified the Paris Convention implemented its permissive scheme of refusing marks that are “contrary to morality or public order” and in so doing, adopted that precise language. See International Convention for the Protection of Industrial Property, art. 6quinquies, as modified at The Hague on November 6, 1925, 47 Stat. 1789, 1804-05, T.S. 834 and London on June 2, 1934, 53 Stat. 1748, 1776-78, T.S. 941 (The Paris Convention entered into force as to the United States on May 30, 1887); Colin Manning, *Moral Bars on Trade Mark Registration*, U. C. CORK L. SCH. (Mar. 28, 2017), https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2875687 (recounting the adoption of this provision in several European national laws); Eric Bonadio, *Brands, Morality and Public Policy: Some Reflections on the Ban on Registration of Controversial Trademarks*, 19 MARQ. INTELL. PROP. L. REV. 39, 43 (2015) (reviewing the morality bars in several European jurisdictions and Australia).

⁴ 15 U.S.C. § 1052(a).

This chapter provides an account of the public policy limitations on trademark subject matter under U.S. law. Part II presents a backdrop to these limitations by explaining the general flexibility as to what constitutes a protectable mark. Part III describes the bars to registration available under Section 2 of the Lanham Act and Part IV explicates the policy rationales behind these bars. Part V reviews the recent Supreme Court decision in *Matal v. Tam* and the anticipated decision in *Iancu v. Brunetti*, which address constitutional constraints on statutory bars to registration. Finally, Part VI considers the implications of these decisions on other public policy based subject matter limitations.

II. Anything Can Be a Trademark

U.S. trademark law is regulated by the Trademark Act of 1946, commonly known as the “Lanham Act.”⁵ The Lanham Act provides for federal registration, causes of action for both registered and common-law trademarks, and remedies.⁶ In addition to the Lanham Act, trademarks in the U.S. may be protected under the common law and by state registration.⁷ The United States Patent and Trademark Office (USPTO) is instructed by the Lanham Act, but also by the Trademark Manual of Examining Procedure (TMEP).⁸ The TMEP, which is regularly updated, offers trademark examining attorneys in the USPTO, trademark applicants, and attorneys and representatives for trademark applicants with “a reference work on the practices and procedures relative to prosecution of applications to register marks in the USPTO.”⁹

Although the Lanham Act has been amended several times since 1946,¹⁰ there has been no major amendment dealing with the subject matter of trademark protection.¹¹ Caselaw on the subject

⁵ 15 U.S.C. § 1051 et seq.

⁶ 15 U.S.C. §§ 1051, 1114, 1116-19, 1124, 1125(a)-(d).

⁷ See J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:3 (5th ed. 2018).

⁸ TMEP (8 ed. Oct. 2018).

⁹ TMEP (8 ed. Oct. 2018).

¹⁰ 15 U.S.C. § 1127 (2018).

¹¹ 15 U.S.C.A. § 1091(c) The few revisions that added “major” changes include the addition of causes of action for dilution and bad faith domain name registration, and the opportunity to apply for registration on an intent to use basis. Although a bar to registration for functional marks was added to Section 2 in 1998, it was not a major amendment because this bar had already been a part of common law. See Pub. L. No. 105-330, 112 Stat. 3064 (1998); Robert G. Bone, *Trademark Functionality Reexamined* 7 J. LEGAL ANALYSIS 183 (2015) (describing the history of the functionality bar in U.S. common law). Revisions to Section 2 following The North American Free Trade Agreement (NAFTA) and The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) made the primarily geographically deceptively misdescriptive bar absolute and added a bar to registering a false geographical indication for a wine or spirit. See Pub. L. No. 103-182, 107 Stat. 2114 (1993); Pub. L. No. 103-465, 108 Stat. 4809, Title V, Subtitle B, Sec. 522 (1994).

matter of trademarks has been robust in some areas, such as distinctiveness,¹² and sparse in others, such as the prohibition on the registration of flags and state emblems.¹³

What may be protected as a trademark under U.S. law is extremely broad and flexible. Section 45 of the Lanham Act clearly delineates the various types of protectable marks, including trademarks, service marks, certification marks, and collective marks.¹⁴ The definition of what constitutes a trademark is also found in this section:

The term “trademark” includes any word, name, symbol, or device, or any combination thereof— (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.¹⁵

According to this definition, whether registered or unregistered, to be protected under U.S. trademark law, a mark must meet two broad standards: It must be used in commerce, and it must be distinctive.¹⁶ The requirement of use is constitutionally based, addressed in the statute, and

¹² See *Converse v. ITC*, 909 F.3d 1110 (Fed. Cir. 2018) (determining distinctiveness of a product configuration); *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358 (Fed. Cir. 2018) (determining distinctiveness of a common word that characterizes a product category).

¹³ See *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981); See also *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1217 (TTAB 1993); See J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:77 (5th ed. 2018).

¹³ 15 U.S.C. § 1127.

¹⁴ *Id.*

¹⁵ *Id.* The 1946 Lanham Act offered the first statutory definition of a trademark in U.S. law, integrating “technical trademarks” and “trade names.” See J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 4:3 (5th ed. 2018). The present definition is a result of a 1988 amendment of the original definition, which read:

The term “trademark,” includes any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others.

This definition was no doubt drawn from the Supreme Court’s definition in *McLean v. Flemming*, 96 U.S. 245 (1878) (stating a “trade-mark may consist of a name, symbol, figure, letter, form or device, if adopted and used by a manufacturer or merchant in order to distinguish the goods he manufactures or sells ... from those manufactured or sold by others.”).

¹⁶ See J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 3.01[1] (5th ed. 2018) (“requirements for qualification of a word or symbol as a trademark” are that it be (1) a “symbol,” (2) “use[d] ... as a mark,” (3) “to identify and distinguish the seller’s goods from goods made or sold by others,” but that it not be “functional”).

further clarified by numerous federal court opinions.¹⁷ The requirement of distinctiveness is not defined in the act and is the subject of numerous cases that continue to be litigated today.¹⁸

The subject matter of trademark law has long been addressed by the federal courts. In particular, the Court of Appeals for the Federal Circuit, which decides all appeals dealing with the denial a trademark registration, and the Supreme Court have had a major impact on these rules.

In the mid-nineties, in the space of three years, the Supreme Court decided two cases that significantly expanded trademark subject matter. In *Two Pesos Inc. v. Taco Cabana*, the Supreme Court was faced with trade dress--restaurant design--that was not registered and lacked secondary meaning.¹⁹ The Court decided that trade dress that is inherently distinctive is entitled to protection despite the absence of proof of secondary meaning. The Court reasoned that only descriptive marks required secondary meaning.²⁰ The Court was persuaded that nothing in the Lanham Act dictated that either unregistered marks or trade dress be subjected to different standards.²¹ A few years later, in *Qualitex Co. v. Jacobson Products Co.*, the Supreme Court was faced with a “trademark that consists, purely and simply, of a color.”²² The Court noted that the “language of the Lanham Act describes that universe [of trademark subject matter] in the broadest of terms.”²³ “Since human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning,” the Court reasoned, “this language, read literally, is not restrictive.”²⁴ The Court pronounced that the doctrine of secondary meaning would afford any symbol—without restriction--the opportunity to become a mark. The Court therefore decided that a single color, like trade dress, is protectable under “ordinary legal trademark requirements.”²⁵

¹⁷ 15 U.S.C. § 1127; see *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 100 (1918) (“Undoubtedly, the general rule is that, as between conflicting claimants to the right to use the same mark, priority of appropriation determines the question”); *Hana Financial, Inc. v. Hana Bank*, 135 S. Ct. 907, 909 (2015) (“Rights in a trademark are determined by the date of the mark’s first use in commerce. The party who first uses a mark in commerce is said to have priority over other users”); *B & B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293, 1299, 1310 (2015) (“One who first uses a distinct mark in commerce thus acquires rights to that mark.”).

¹⁸ See *Converse v. ITC*, 909 F.3d 1110 (Fed. Cir. 2018) (determining distinctiveness of a product configuration); *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358 (Fed. Cir. 2018) (determining distinctiveness of a common word that characterizes a product category).

¹⁹ *Two Pesos Inc.*, 505 U.S. 763.

²⁰ *Id.* (“Section 2 of the Lanham Act provides that a descriptive mark that otherwise could not be registered under the Act may be registered if it “has become distinctive of the applicant’s goods in commerce.” citing *Park ‘N Fly*).

²¹ *Id.* (“There is no persuasive reason to apply to trade dress a general requirement of secondary meaning which is at odds with the principles generally applicable to infringement suits under § 43(a).”).

²² *Qualitex Co.*, 514 U.S. 159 (1995).

²³ *Id.* at 162.

²⁴ *Id.*

²⁵ *Id.*

Following these cases, what constitutes a protectable mark in U.S. trademark law is quite broad and without clear limitations, save a showing of secondary meaning.²⁶ As a result, U.S. trademark law, as compared with other jurisdictions, has been solicitous of a great variety of non-traditional marks such as trade dress, sound marks, scent marks, tactile marks, and single colors.

III. Strict Statutory Limits

In contrast to the apparent breadth of what can constitute a protectable mark and the generality of subject matter standards is a set of statutory limitations that come in the form of prohibitions on what can be registered as a mark in the United States. These bars to registration are found in Section 2 of the Lanham Act. According to this section, marks will be refused registration if they include matter that is deceptive, immoral or scandalous, falsely suggestive of a connection with persons, institutions or religions, geographical indication for wine or spirits other than the place of origin of the goods, government insignia, a living person's name, portrait or signature without written consent, likely to cause confusion with an existing mark, merely descriptive, deceptively misdescriptive, primarily geographically descriptive, primarily geographically deceptively misdescriptive, primarily merely a surname, or functional.²⁷

The 1905 Trademark Act contained a slightly smaller set of prohibitions on registration that were similar to Section 2 of the Lanham Act. These provisions, in Section 5 of the act, prohibited the registration of immoral or scandalous matter, flags and state emblems, confusingly similar marks, the name of an individual, firm, corporation, or association, not portrayed in a distinctive manner, descriptive words, merely a geographical name, a portrait of a living individual without consent.²⁸ In addition to developing and elaborating on some of these bars, the 1946 Lanham Act added bars for disparaging marks and marks that are primarily merely a surname. The bars for geographical indications and functional marks were later added in revisions of the Lanham Act.²⁹

The prohibitions on registration set out in Section 2 do not appear to have a great deal in common, and in any event, are not organized into related categories. Some subparagraphs contain a number of unrelated bars, such as Section 2(a), which deals with such unrelated categories as geographical indications and immoral marks,³⁰ while others contain only a single bar, such as Section 2(c), which addresses only the registration of the name or portrait of a living person.³¹ In addition, the

²⁶ See THE PROTECTION OF NON-TRADITIONAL TRADE MARKS: CRITICAL PERSPECTIVES (Irene Calboli & Martin Senftleben, eds., Oxford University Press, 2019) (discussing the distinctiveness requirement for non-traditional marks across jurisdictions).

²⁷ 15 U.S.C. §§ 1052(a-e) (2018).

²⁸ Trademark Act of 1905, Act of Feb. 20, 1905, 33 Stat. 724, 15 U.S.C.A. §§ 81 et seq. (1905).

²⁹ See *supra*, note 11.

³⁰ 15 U.S.C. § 1052(a).

³¹ 15 U.S.C. § 1052(c).

prohibitions do not announce consistent standards. Some bars are absolute,³² while other bars may be overcome by secondary meaning.³³ Finally, some bars are *per se*, such as the bar on the registration of flags, while others appear to require proof of deception or likely confusion.³⁴ In sum, they are quite a hodgepodge of restrictions.³⁵ Oddly, this is due only in small part to amendments that have occurred since the passage of the act.³⁶

Even though bars to registration have been a part of U.S. statutory trademark law since 1905, there now seems to be some uncertainty about the straightforward and fundamental question as to the effect of Section 2 on unregistered common law marks. While both registered and unregistered common law marks are federally protected under the Lanham Act in that both are granted causes of action, the symmetry between the two is elsewhere unclear.³⁷ It is axiomatic that registration does not give rise to trademark rights, but only grants certain benefits to a trademark owner.³⁸ That is, under U.S. trademark law, a trademark must be in existence to receive federal registration.³⁹ Therefore, if registration is cancelled, it follows that common law rights may still subsist. What is less clear is whether corollary common law rules exist for all subject matter limitations. It now appears to be an open question as to what if any effect a refusal of registration, by the USPTO or as declared by a court, would have on the common law rights in a mark.⁴⁰ Previously, the Supreme Court has stated that “it is common ground that § 43(a) protects qualifying unregistered trademarks and that the general principles qualifying a mark for registration under § 2 of the Lanham Act are

³² *In re Hoefflin*, 97 U.S.P.Q.2d 1174, 1175 (TTAB 2010) (stating that Section 2(c) “absolutely bars the registration of a designation that identifies a particular living individual absent written consent.”); TMEP § 1206 (8 ed. Oct. 2018).

³³ See 15 U.S.C. § 1052(f) (2018).

³⁴ *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372 (Fed. Cir. 1983) (“the board has applied a more stringent test under Sec. 2(a) requiring not only likelihood of confusion of source but also an intent to trade upon the goodwill of a prior user.”).

³⁵ See *In re Brunetti*, 877 F.3d 1330, 1340 (Fed. Cir. 2017) (“§ 2(a) contains a hodgepodge of differing prohibitions on registration”); Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661, 788 (1993) (“Section 2(a) is really a hodgepodge [sic] of several distinct statutory bars to federal trademark registration”); see Carl J. Minniti III, *The Lanham Act’s Unconstitutional Hodgepodge*, 17 RUTGERS J. L. & RELIGION 315 (2016).

³⁶ Only the amendment that added the registration bar on geographical indications to Section 2(a) contributed to the disorder of Section 2. See *supra* note 11.

³⁷ See 15 U.S.C. §§ 1114, 1125(a) (2018) (Section 32 grants a cause of action for federally registered marks, while section 43(a) grants a cause of action for unregistered common law marks).

³⁸ *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017) (quoting *B&B Hardware* (“[F]ederal law does not create trademarks.”)).

³⁹ 15 U.S.C. § 1051(a)(2) (“The application shall include specification of the applicant's domicile and citizenship, the date of the applicant's first use of the mark, the date of the applicant's first use of the mark in commerce, the goods in connection with which the mark is used, and a drawing of the mark”).

⁴⁰ Dicta in the Federal Circuit’s opinion in *In re Tam* called this into question. *In re Tam*, 808 F. 3d 1321, 1344–45, n.11 (en banc), as corrected (Feb. 11, 2016) (“there is no authority extending §43(a) to marks denied under §2(a)’s disparagement provision.”).

for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a).”⁴¹ In 2017, however, the Supreme Court explicitly chose to side step this question.⁴²

IV. Why These Bars?

What is the public policy behind the hodgepodge of subject matter limitations contained in Section 2? The Lanham Act is not particularly revealing on the policy goals that animate it. At the end of a section of definitions, Section 45, the Act states that

The intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.⁴³

This language comes the closest to explicitly stating the reasons for Congress’s enactment of a trademark act. In this provision, we can see clearly the public policy of protecting consumers against confusion and protecting the goodwill of trademark owners.⁴⁴ Congress also makes clear its intention to implement international treaties in the act.

⁴¹ *Two Pesos Inc. v. Taco Cabana*, 505 U. S., 763, 768 (1992).

⁴² *Matal v. Tam*, 137 S. Ct. 1744, 1753 n.1 (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.”).

⁴³ 15 U.S.C. § 1127 (2018).

⁴⁴ Congressman Lanham, who sponsored the bill that became the act, and for whom it is named, stated: “The purpose of [the Act] is to protect legitimate business and the consumers of the country.” 92 CONG. REC. 7524 (1946). The Senate Report elaborated:

The purpose underlying any trade-mark statute is twofold. One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trade-mark owner.

S. REP. NO. 1333, 3 (1946). In *Park ‘N Fly v. Dollar Park & Fly*, the Supreme Court confirms these policy goals: “The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.” *Park ‘N Fly v. Dollar Park & Fly*, 469 U.S. 189, 198 (1985).

There is no mention in this provision, however, for any other public policy goal such as protecting the public against marks that could be harmful in any other way. Surprisingly, there is also no more than a hint about the public policy of ensuring free competition.⁴⁵

The majority of the bars contained in Section 2 do not further the goals of the Lanham Act as stated in Section 45.⁴⁶ Certainly, the prohibitions on the registration of deceptive marks and marks that make a false connection in Section 2(a), confusingly similar marks in Section 2(d), and deceptively misdescriptive and primarily geographically deceptively misdescriptive marks in Section 2(e) all appear to be related to the goal of preventing consumer confusion. Other registration bars, such as for marks that are merely descriptive, primarily geographically descriptive, primarily merely a surname, relate to the definitional requirement of distinctiveness. Certain other prohibitions, however, seem unrelated to the traditional trademark policy goals of prevention confusion or requiring distinctiveness. The prohibition on the registration of disparaging, scandalous, immoral, and functional marks all appear to relate to public policy goals that exist beyond the confines of Section 45's stated policy goals. Even the prohibition on registering marks that contain an inaccurate geographical indication for wine or spirits, flags and state emblems, or a non-consenting living person's name, portrait, or signature, are unrelated to preventing confusion since they are not conditioned on the consumer's mistaken beliefs.⁴⁷

⁴⁵ The legislative history does include a reference to competition: "To protect trademarks, therefore, is to protect the public from deceit, to foster fair competition, and to secure to the business community the advantages of reputation and good will by preventing their diversion from those who have created them to those who have not. This is the end to which this bill is directed." S. REP. NO. 1333, 4 (1946) (emphasis added). The meaning of "fair competition" in this passage, however, is not the equivalent of "free competition," but more likely the equivalent of "not unfair competition." This passage also contains this sentence, which clarifies the intended meaning of "competition:" "trade-marks, indeed, are the essence of competition, because they make possible a choice between competing articles by enabling the buyer to distinguish one from the other," *Id.*

⁴⁶ The Court of Appeals for the Federal Circuit stated the same:

various provisions of the Lanham Act do not align with this as an exclusive or even a primary policy objective. *See* § 2(e) (prohibiting a mark which "(2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them ... (4) is primarily merely a surname," or "(5) comprises any matter that, as a whole, is functional."). Therefore, we find it difficult to conclude that the provisions in § 2 of the Lanham Act, including § 2(b), were all intended to protect the public from "pirates and cheats."

In re City of Houston, 731 F.3d 1326, 1330 (Fed. Cir. 2013).

Likewise, the Trademark Trial and Appeal Board has stated

The prevention of confusion or deception is not the only concern of Trademark Act § 2. That section sets out a number of grounds for refusal of registration that have nothing to do with confusion. For example, Trademark Act § 2(a) prohibits registration of immoral or scandalous matter, and Section 2(e) sets out a variety of subject matter which is not registrable because - for various reasons - it is not considered to be a trademark - at least not without a showing of distinctiveness.

The Government of the District of Columbia, 101 U.S.P.Q.2d 1588 (TTAB 2012).

⁴⁷ The inclusion of a bar on registering "a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods" was intended to implement Article 23 of the TRIPS Agreement, which obligates member states to prohibit the use and registration of geographical indications for wines and spirits not originating in the place indicated even where the use or registration would not be misleading. *See* Agreement on Trade-Related Aspects of Intellectual Property Rights art. 23, Apr. 15, 1994, Marrakesh Agreement

The legislative history on the bars on registration in both the 1905 Act and the Lanham Act runs from nonexistent to scant. There was only one exchange during a 1939 hearing in the House of Representatives that sheds light on what Congress was trying to achieve in drafting some of these provisions. In this exchange, it was suggested that any use of the name of any president, living or long dead, should be prohibited in Section 2(c).⁴⁸ There was a discussion about not wanting “Abraham Lincoln gin” or “George Washington coffee.”⁴⁹ One representative stated, however, that while “Abraham Lincoln gin” should be prohibited, “George Washington coffee” should be allowed.⁵⁰ It was also stated that the abuses of presidents’ names should be taken care of by Section 2(a).⁵¹ These exchanges suggest that Congress was concerned with protecting the reputation of Presidents and that it envisioned a variety of means to achieve this goal. Ultimately, this protection was written to endure only during the life of the president and his widow.⁵²

Without the aid of legislative intent, courts and commentators have tendered some proposals about the public policy goals behind these prohibitions on registration. For instance, it has been suggested that Section 2(c)’s bar on the registration of the name or portrait of a living person is animated by a concern for privacy and the right of publicity.⁵³ In the 1930’s when Section 2(c) was drafted and considered, the right to privacy was in its infancy,⁵⁴ but could well have inspired this provision. The right of publicity, however, significantly postdates this provision.⁵⁵ Whatever the policy goal of Section 2(c) may be, it is definitely not to prevent falsely suggesting a connection with a person since that goal is accomplished in Section 2(a).⁵⁶

Establishing the World Trade Organization, Annex 1C, Legal Instrument-Results of the Uruguay Round, 33 I.L.M. 1125 (1994) [hereinafter TRIPS].

⁴⁸ *Hearing on H.R. 4744 Before the Subcommittee on Trade-Marks of the H. Committee on Patents*, 76th Cong. 18 (1939), reprinted in *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 1379 (Fed. Cir. 1983).

⁴⁹ *Id.*

⁵⁰ *Id.*

⁵¹ *Id.*

⁵² 15 U.S.C. § 1052(c) (2018) (The text at the time of that hearing did not refer to the identity of a President: “(c) Consists of or comprises the name, portrait, or signature of a living individual unless by his written consent.”).

⁵³ *In re Hoefflin*, 97 U.S.P.Q.2d 1174, 1176 (TTAB 2010) (stating that Section 2(c) “is intended to protect the intellectual property right of privacy and publicity that a living person has in his/her identity”).

⁵⁴ Samuel D. Warren and Louis Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890) (often credited as spawning the new right to privacy. New York was the first state to enact a privacy law in 1903. This statute prohibits the use of the name, portrait, or picture of any living person without prior consent for “advertising purposes” or “for the purposes of trade”).

⁵⁵ *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953). (In his decision, Judge Jerome Frank distinguished the “right of publicity” from the “right of privacy” by focusing on the economic interests involved, rather than the personal interests characteristic of the right of privacy. *Haelan* is also cited as the first articulation of these interests as the “Right of Publicity”).

⁵⁶ 15 U.S.C. § 1052(a) (prohibiting the registration of a mark that would “falsely suggest a connection with persons, living or dead.”).

Section 2(b) of the Lanham Act prohibits the registration of marks that include a flag, coat of arms, or other insignia (or any simulation thereof) of any government from a municipality to a foreign nation. A similar prohibition first appeared in the 1905 Trademark Act.⁵⁷ This prohibition resembles Article 6*ter* of the Paris Convention⁵⁸ and may be a result of that international obligation.⁵⁹

Commentary on Article 6*ter* of the Paris Convention indicates that the policy goal is to respect sovereign control of flags and state emblems.⁶⁰ Although certain uses of flags and state emblems may cause confusion as to the source of origin of goods, it would appear that this concern is not the reason for either the treaty or statutory prohibition.⁶¹ In the case of the treaty provision, two standards are specified: one for intergovernmental organizations; and one for flags and state emblems. In the case of intergovernmental organizations, member states are only obligated to protect them when the use or registration would likely cause confusion.⁶² In contrast, as Professor Bodenhausen makes clear in his authoritative guide to the Paris Convention, the obligation to

⁵⁷ See Act of Feb. 20, 1905, ch. 592, § 5(b), 33 Stat. 724, 725–26, *repealed by* Trademark (Lanham) Act of 1946, ch. 540, 60 Stat. 427 (interestingly, the 1905 Act also prohibited the registration of any designation that indicated a fraternal society, institution, organization, club, or society incorporated in the United States).

⁵⁸ See International Convention for the Protection of Industrial Property, as modified at The Hague on November 6, 1925, 47 Stat. 1789, 1804-05, T.S. 834 and London on June 2, 1934, 53 Stat. 1748, 1776-78, T.S. 941 (The Paris Convention entered into force as to the United States on May 30, 1887).

⁵⁹ Article 6*ter* was introduced in 1925, thus before the 1946 Lanham Act, but after the 1905 Act. G.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property* 95 (1969). However, the 1883 text of the Paris Convention provided that registration of a mark by a member state “may be refused, if the object, for which it is asked, is considered contrary to morals and to public order.” Paris Convention, art. 6 (1883). A protocol accompanying the 1883 convention offered further guidance on Article 6. It stated that “it is understood that the use of public armorial bearings and decorations may be considered contrary to public order, in the sense of the final paragraph of Article 6.” Paris Convention, Final Protocol art. 4 (1883).

⁶⁰ G.H.C. BODENHAUSEN, *GUIDE TO THE APPLICATION OF THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY* 96 (1969) (“The reasons for this are that such registration or use would violate the right of the State to control the use of symbols of its sovereignty.”) (citations omitted). A WIPO report repeats this formulation. WIPO, *Article 6*ter* of the Paris Convention: Legal and Administrative Aspects*, SCT/15/3 (2005) p. 4 (“The reason for this exclusion is that registration or use of such emblems would encroach upon the right of the State concerned to control the use of the symbols of its identity and sovereignty.”) [hereinafter WIPO]. In addition, according to one commentary, delegates had argued that commercial uses were a “profaning” of these signs. See Actes 1911, p. 298; SAM RICKETSON, *THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY: A COMMENTARY* 560 (Oxford University Press, 2015). Moreover, previous to the Hague Act, the Final Protocol of the Paris Act had included marks that included “public armorial bearings and decorations” as marks that may be refused registration as being contrary to public order. *Id.*

⁶¹ Bodenhausen states that in addition to the loss of sovereign control, the use of flags and state emblems “might mislead the public with respect to the origin of goods to which such marks would be applied.” Bodenhausen, *supra* note 60, at 96. In similar fashion, the WIPO report also notes this possibility: “Moreover, use of a State emblem as a trademark by an unrelated or unauthorized person is likely to mislead the public as to the origin or sponsorship of the goods to which the mark is attached.” WIPO, *supra* note 60.

⁶² See Paris Convention, art. 6*ter*(1)(c)(“The countries of the Union shall not be required to apply the said provisions when the use or registration referred to in subparagraph (a), above, is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.”).

protect flags and state emblems “is absolute and may not depend on suggestions of any connection between the trademark and the emblem.”⁶³ Likewise, Section 2(b) of the Lanham Act, as well as Section 5 of the 1905 Act, similarly apply *per se*, and do not depend on a finding of deception, confusion, or a false suggestion of a connection.⁶⁴

The prohibition on the registration of functional marks should be far more straightforward. This prohibition is relatively new to the statutory scheme, having been enacted only in 1998, but has been a feature of U.S. common law since the late nineteenth century.⁶⁵ Nonetheless, commentators disagree about the public policy this limitation on subject matters serves: be it promoting competition, enforcing a natural right to copy, facilitating downstream innovation, or channeling innovation to patent law.⁶⁶ In its most recent functionality case, the Supreme Court neglected to elucidate the policy goal behind this doctrine, which may have contributed to the decision’s failure to clarify the applicable tests.⁶⁷ In the case of the functionality bar, it is not that the animating policy is unaccounted for so much as it is ambiguous. In any event, the public policy behind the functional bar appears to be somewhat peripheral to the objectives of preventing confusion and protecting goodwill stated in Section 45.

V. The Government’s Interest in Regulating Registration

Recent litigation in the United States has pointedly raised the question of whether all of the limitations on registration contained in the Lanham Act can withstand constitutional challenge. Two recent cases, *Matal v. Tam* and *Iancu v. Brunetti*, have directly challenged two of the statutory constraints on what can be registered as a mark in the U.S.⁶⁸ In *Tam*, the U.S. Supreme Court ruled

⁶³ See Bodenhausen, *supra* note 60, at 98; see also Stephen P. Ladas, PATENTS, TRADEMARKS, AND RELATED RIGHTS: NATIONAL AND INTERNATIONAL PROTECTION 1246 (1975); SAM RICKETSON, THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY: A COMMENTARY 566-568 (Oxford University Press, 2015) (“confusion on the part of the public is not required here by the terms of Article 6ter;” “it is not conditioned on the presence of confusion as in the case of international government organizations.”) Moreover, both Bodenhausen and Ladas state that Article 6ter is a self-executing provision.

⁶⁴ Marks that may suggest a false connection with an institution are barred in Section 2(a). The Trademark Trial and Appeal Board makes this point in a recent case:

In fact, if prevention of confusion were the “central purpose” of Trademark Act § 2(b), it would be superfluous, because registration of marks which would cause confusion is prohibited under Trademark Act § 2(d), and Trademark Act § 2(a) prohibits registration of marks which would be deceptive or falsely suggest a connection with others. To the contrary, rather than simply being a special case of confusion, registration of governmental insignia is prohibited by Trademark Act § 2(b) regardless of whether confusion would result.

The Government of the District of Columbia, 101 U.S.P.Q.2d 1588 (TTAB 2012) (emphasis added).

⁶⁵ See Pub. L. No. 105-330, 112 Stat. 3064 (1998); Robert G. Bone, *Trademark Functionality Reexamined*, 7 J. LEGAL ANALYSIS 183 (2015) (describing the history of the functionality bar in U.S common law).

⁶⁶ *Id.* at 184.

⁶⁷ See *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001).

⁶⁸ See *Matal v. Tam*, 137 S. Ct. 1744 (2017); see *In re Brunetti*, 877 F.3d 1335 (Fed. Cir. 2017).

that the denial of registration to disparaging marks was an unconstitutional restriction of free speech.⁶⁹ As a result, the USPTO may no longer apply this statutory provision. The Supreme Court struck down as unconstitutional a second trademark registration bar. The court ruled in *Iancu v. Brunetti*⁷⁰ that the government may no longer deny trademark registration to marks that are “scandalous” or “immoral.” Thus, as a result of this litigation, the list of limitations on trademark subject matter has recently contracted and may further contract.

In *Matal v. Tam* the Supreme Court reviewed the statutory prohibition on the registration of a trademark that “consists of or comprises . . . matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”⁷¹ The USPTO and the lower courts found that under this provision, the applied-for mark THE SLANTS was disparaging to people of Asian descent and must be denied registration.⁷² In addition to challenging this finding, the applicant, Simon Tam, raised a constitutional challenge to the provision. The argument was that even though the provision only denies registration leaving the mark owner free to use the mark, it nevertheless has a “chilling effect” on free speech because in denying the significant benefits that come with registration, the government is steering mark owners away from certain speech.⁷³

In striking down the challenged law in an unanimous decision, the Supreme Court held that the disparaging marks provision of the Lanham Act “offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend.”⁷⁴ The provision violates the First Amendment because it facially discriminates based on viewpoint.⁷⁵ Viewpoint discrimination is presumptively unconstitutional and subject to a strict scrutiny analysis.⁷⁶ The Court found that the disparagement bar did not survive strict scrutiny because the government’s interest in denying registration to disparaging marks was neither compelling nor narrowly tailored.⁷⁷

⁶⁹ *Matal v. Tam*, 137 S. Ct. 1744 (2017).

⁷⁰ 588 U.S. ____ (2019).

⁷¹ 15 U.S.C. § 1052.

⁷² See *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015).

⁷³ Brief for Respondent, *Matal v. Tam*, 137 S. Ct. 1744 (2017), 2017 WL 2621315 at *33.

⁷⁴ See *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017) (Alito, J.).

⁷⁵ See *id.* at 1763.

⁷⁶ *Id.* at 1748.

⁷⁷ *Id.* at 1749.

Writing for four justices,⁷⁸ Justice Alito found that the disparaging marks provision also failed the *Central Hudson* test,⁷⁹ which dictates an intermediate scrutiny analysis.⁸⁰ To survive intermediate scrutiny,⁸¹ the regulation must further an important government interest, and must do so by means that are substantially related to that interest.⁸² In this case, the government could not easily identify the government's interest that the provision advances. The question of the government's interest came up in oral arguments both in the Court of Appeals for the Federal Circuit and the Supreme Court. During oral argument in the Supreme Court, Justice Breyer questioned the USPTO's deputy solicitor general about the purpose of the disparagement provision.⁸³ Surprising most legal commentators, he responded that the provision was consistent with broader trademark policy because disparaging marks were a distraction to the public.⁸⁴ The lack of a clearly identifiable rationale for this provision in the legislative history is something addressed in the scholarship.⁸⁵

In his concurring opinion, Justice Kennedy stated that this “case does not present the question of how other provisions of the Lanham Act should be analyzed under the First Amendment.”⁸⁶ Nonetheless, Justice Kennedy went part way to answer this question by observing that trademark law does not run afoul of the First Amendment when it prohibits the use of confusing and misleading trademarks.⁸⁷ Although this statement is only dicta, it explicitly raises the question of exactly when trademark law may run afoul of the First Amendment when it prohibits the non-misleading use of trademarks or denies registration for other reasons.

While the Supreme Court was deciding *Tam*, another case was waiting in the wings. Within two years of deciding *Tam*, the Supreme Court had before it the precise question anticipated by Justice Kennedy of how another provision of the Lanham Act should be analyzed under the First Amendment. In *Iancu v. Brunetti*, at issue was the constitutionality of the Lanham Act's prohibition on the registration of scandalous and immoral marks.⁸⁸ The case involved Erik

⁷⁸ Although the decision was unanimous, the Court produced two opinions each representing for justices. Justice Gorsuch did not participate. See *Matal v. Tam*, 137 S. Ct. 1744, 1747, 1749 (2017).

⁷⁹ *Id.* at 1749.

⁸⁰ See *Central Hudson Gas & Electric Corp. v. Public Service Commission*, 447 U.S. 557, 566 (1980) (subjecting restrictions on commercial speech to intermediate scrutiny).

⁸¹ The Supreme Court created this test in *Craig v. Boren*, 429 U.S. 190 (1976).

⁸² *Craig v. Boren*, 429 U.S. 190 (1976).

⁸³ Transcript of Oral Argument at 7-8, *Matal v. Tam* 137 S. Ct. 1744 (2017).

⁸⁴ *Id.* at 8.

⁸⁵ Christine Haight Farley, *Registering Offense: The Prohibition of Slurs as Trademarks*, in DIVERSITY IN INTELLECTUAL PROPERTY: IDENTITIES, INTERESTS, AND INTERSECTIONS (Irene Calboli & Srividhya Ragavan, eds., Cambridge University Press 2015); Christine Haight Farley, *Stabilizing Morality in Trademark Law*, 63 AM. U. L. REV. 101 (2014).

⁸⁶ *Matal v. Tam*, 137 S. Ct. 1744, 1773-74 (2017) (Kennedy, J.).

⁸⁷ *Id.*

⁸⁸ 588 U.S. ____ (2019).

Brunetti’s application for the trademark “FUCT” for apparel, which was refused by the USPTO under Section 2(a) of the Lanham Act as scandalous and immoral,⁸⁹ and therefore unregistrable.⁹⁰

The main issue in *Brunetti* was whether the registration bar for scandalous and immoral marks is also a regulation of the expression of a viewpoint and thus unconstitutional under *Tam*. According to the majority, this provision “disfavors ideas” and as such is substantively indistinguishable from the provision in *Tam*.⁹¹ Here, “the Lanham Act allows registration of marks when their messages accord with, but not when their messages defy, society’s sense of decency or propriety.”⁹²

It would appear that no further statutory or doctrinal vulnerabilities emerge from this decision that had not been portended by *Tam*. This decision, however, does pave a path forward for amending the Lanham Act to add a bar to the registration of marks that are “scandalous in their mode of expression,” or are “vulgar, lewd, sexually explicit, or profane.”

In *Tam*, the justices did not agree on everything. In *Brunetti*, the justices expressed disagreement. Chief Justice Roberts, Justice Breyer, and Justice Sotomayor each filed separate opinions. Although each concurred that the registration bar on mark that are “immoral” amounts to unconstitutional viewpoint discrimination, each believed that the “scandalous” bar could be saved by accepting the government’s proposed limiting application of this provision to marks that are “vulgar,” “lewd,” “sexually explicit or profane.”

In addition to these three justices, Justice Alito, the author of the majority opinion in *Tam*, stated in his concurring opinion that the court’s opinion would not “prevent Congress from adopting a [] statute that precludes the registration of marks containing vulgar terms that play no real part in the expression of ideas.”⁹³ He went on to note that the mark in question in this case—FUCT—“is not needed to express any idea and, in fact, as commonly used today, generally signifies nothing except emotion and a severely limited vocabulary.”⁹⁴

In *Brunetti*, it would appear that some Justices have retreated from the idea that a registration refusal is a burden on speech. Justice Breyer flatly stated that “an applicant who seeks to register a mark should not expect complete freedom to say what she wishes, but should instead expect linguistic regulation.”⁹⁵ Perhaps the most striking rebuttal of registration as speech comes in this passage in Chief Justice Roberts’ opinion:

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;

⁸⁹ The USPTO has long followed the established precedent of treating the two terms, “scandalous” and “immoral,” as a unitary provision. *See In re Brunetti*, 877 F.3d 1330, 1336 (Fed. Cir. 2017).

⁹⁰ *Id.* at 1335.

⁹¹ 588 U.S. ___, at ___ (2019).

⁹² *Id.* at ___.

⁹³ *Id.* at ___.

⁹⁴ *Id.* at ___.

⁹⁵ *Id.* at ___.

no one is being punished. The owners of such marks are merely denied certain additional benefits associated with federal trademark registration. The Government, meanwhile, 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.⁹⁶

Thus, in *Brunetti*, the court seemed more inclined to endeavor to find the statute constitutional than it did in *Tam*. Perhaps in *Brunetti*, it became clear to the court that at issue was whether the government should be obligated to register a white supremacist's application for the N-word. Even though *Tam* involved a purported racial epithet, the court did not express any unease such as what comes through in the opening lines of Justice Sotomayor's opinion:

The Court's decision today will beget unfortunate results. ...[T]he Government will have no statutory basis to refuse (and thus no choice but to begin) registering marks containing the most vulgar, profane, or obscene words and images imaginable.⁹⁷

Just three cases have caused a recent interest in these trademark registration provisions: first the Redskins case (*Blackhorse v. PFI*),⁹⁸ then *Tam*, and finally *Brunetti*.⁹⁹ On the constitutional issue alone, these three cases have produced seventeen opinions. Even still, many important questions have been explicitly sidestepped such as to what extent, if any, the commercial speech doctrine plays, whether viewpoint neutral content discriminatory registration bars pass muster, or whether trademark registration may be considered as a government program or subsidy. For these reasons, perhaps there will be more such cases to come.

Both Supreme Court decisions held that the registration bars were unconstitutional because they were viewpoint-based. Left as an open question is what the appropriate test or standard of scrutiny is when trademark regulations are not viewpoint-based.¹⁰⁰ We will have to wait to learn whether content-based trademark restrictions are subject to strict scrutiny or, as commercial speech, intermediate scrutiny.

VI. Reconsidering Public Policy Limitations

The broad reading of the First Amendment in *Tam* and *Brunetti* will likely have an impact beyond these cases. If another court decides that trademark registration bars are subject to either strict or intermediate scrutiny, certain other limitations on subject matter contained in the Lanham Act may

⁹⁶ *Id.* at ____.

⁹⁷ *Id.* at ____.

⁹⁸ 112 F. Supp. 3d 439 (E.D. Va. 2015).

⁹⁹ Previously, the constitutionality of these provisions was settled by the Court of Customs and Patent Appeals, the predecessor to the Court of Appeals for the Federal Circuit, in *In re McGinley*. 660 F.2d 481 (C.C.P.A. 1981).

¹⁰⁰ *Matal v. Tam*, 137 S. Ct. 1744, 1767–68 (Kennedy, J.).

be vulnerable. In *Tam*, Justice Kennedy stated that “[t]he central purpose of trademark registration is to facilitate source identification,” and “[w]hether a mark is disparaging bears no plausible relation to that goal.”¹⁰¹ According to this reasoning, any limitation on the registration of a mark must relate to the public policy facilitating source identification in order to survive constitutional scrutiny.¹⁰²

As a *Brunetti* a result, other public policy limitations on registration may also be in jeopardy. Section 2 of the Lanham Act contains other registration bars that are not directed at facilitating source identification. For instance, Section 2(a) prohibits the registration of inaccurate geographical indications of origin for wine or spirits, Section 2(b) prohibits the registration of flags and state emblems, and Section 2(c) prohibits the registration of the names or portraits of specific living persons absent written consent.¹⁰³ While each of these bars may prevent registrations that could be considered false or misleading, significantly these provisions are not aimed at that objective and are not conditioned on such a finding. Would these prohibitions then survive strict or intermediate scrutiny? Would they even survive the lowest level of scrutiny, rational basis, which demands that the law’s means be "rationally related" to a conceivable and legitimate state end?¹⁰⁴ The absence of any clear policy behind the bar on disparaging marks caused trouble for the government in *Tam*. These other non-misleading-based bars similarly suffer from not having a clearly identifiable policy rationale.

Many of the subject matter limitations contained in Section 2 relate to international treaty obligations. For the most part, the Paris Convention adopted a permissive scheme with regard to the refusal of trademarks. Under Paris Convention Article 6*quinquies*, member states may, but are not obligated to, refuse marks that are “contrary to morality or public order.”¹⁰⁵ Both the bar on flags and state emblems and the bar on inaccurate geographical indications for wines and spirits, however, are mandatory obligations under the Paris Convention or the TRIPS Agreement.¹⁰⁶ In these instances only, there is a question of whether an international treaty obligation creates a compelling government interest that would satisfy strict scrutiny. The Supreme Court has not yet

¹⁰¹ *Id.* at 1768 (Kennedy, J.).

¹⁰² In addition to Section 2 bars, the Lanham Act also includes a provision that creates a ground for opposing the registration of a mark based on dilution. *See* 15 U.S.C. § 1063(a) (“Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may, upon payment of the prescribed fee, file an opposition ...”). This provision, like certain other registration bars, does not relate to the public policy facilitating source identification.

¹⁰³ 15 U.S.C. §§ 1052(a)-(c).

¹⁰⁴ *Lochner v. New York*, 198 U.S. 45 (1905) (Holmes’ dissent is the first mention of rational basis).

¹⁰⁵ *See* International Convention for the Protection of Industrial Property art. 6*quinquies*, as modified at The Hague on November 6, 1925, 47 Stat. 1789, 1804-05, T.S. 834 and London on June 2, 1934, 53 Stat. 1748, 1776-78, T.S. 941.

¹⁰⁶ *See id.*; TRIPS, *supra* note 47.

so held.¹⁰⁷ However, even if it were so inclined, the fact that these bars to registration only partially implement treaty obligations would complicate that analysis.¹⁰⁸

VII. Conclusion

The Supreme Court's recent decisions in *Tam* and *Brunetti* have provoked a momentary focus on the public policy behind the Lanham Act's diverse subject matter restrictions. Together these cases clarify that the First Amendment constrains what limitations the U.S. government may place on the subject matter of trademarks. As a result of these cases, U.S. trademark law may diverge from other jurisdictions as the constitutional protection of speech has caused an expansion of trademark subject matter. We may now add the freedom of expression to the list of public policy concerns that shape trademark subject matter.

¹⁰⁷ See *Boos v. Barry*, 485 U.S. 312, 322-24 (1988) (“[T]he fact that an interest is recognized in international law does not automatically render the interest 'compelling' for purposes of First Amendment analysis.”).

¹⁰⁸ Article 6*ter* of the Paris Convention obligates member states to both refuse registration and prevent the use of marks that contain flags and state emblems. See *supra* note 57. Section 2(b) only prohibits the registration of such marks. Likewise, Article 23 of TRIPS obligates member states to provide the legal means for interested parties to prevent the use of inaccurate geographical indications for wine and spirits in addition to refusing their registration. See TRIPS *supra* note 47. Section 2(a) addresses only the registration bar.