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The Mode and the Message: Offensiveness as a Viewpoint in First Amendment Law

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I. Introduction

If there is a bedrock principle of the First Amendment, it is that the government cannot regulate or prohibit the expression of an idea merely because society finds the idea offensive.¹ The Supreme Court has, however, upheld the government regulation of offensive ideas on occasion.² The latest arena in which the Supreme Court has grappled with such a First Amendment issue is in the context of trademark registration. Entities ranging from streetwear clothing companies to California dance-rock bands to multi-national corporations wish to protect their trademarks to distinguish their goods and to prevent competitors from utilizing their mark.³ Registering a trademark on the federal trademark register brings with it various benefits, namely constructive notice, prima facie evidence of the validity of the registered mark, and the incontestability of the mark after it has been on the register for five years.⁴ Before applicants can enjoy these benefits, they have to first clear the hurdles of the Lanham Act. The Lanham Act forbids the registration of marks that depict or represent “immoral, deceptive, or scandalous matter” or marks that “disparage.”⁵ In two recent cases, the Supreme Court struck down these provisions.⁶

In 2017, Simon Tam, the singer in a Californian Asian-American dance-rock group, applied to the Patent and Trademark Office (“PTO”) to register the group’s name, “The Slants”.⁷ The PTO refused to grant the registration on the grounds that “slants” is a derogatory, disparaging

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¹ *Texas v. Johnson*, 491 U.S. 397, 414 (1989).

² *See, e.g.*, *FCC v. Pacifica Found.*, 438 U.S. 726 (1978); *Bethel School Dist. No. 403 v. Fraser*, 478 U.S. 675 (1986).

³ *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017).

⁴ *Id.* at 1753.

⁵ 15 U.S.C. § 1052 (2019).

⁶ *See Matal v. Tam*, 137 S. Ct. 1744 (2017); *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019).

⁷ *Matal*, 137 S. Ct. at 1751.

term for people of Asian descent.⁸ The band members argued that while the term is a racial slur, by naming their band “The Slants” they were reclaiming the word and “drain[ing] its denigrating force.”⁹ Through a four Justice opinion and a four Justice concurrence, the Supreme Court overturned the PTO’s ruling and held that the disparagement standard of the Lanham Act was unconstitutional. All Justices, while disagreeing about the analytical framework of the case, agreed on two things: (1) if a trademark regulation is viewpoint-based, it is presumptively unconstitutional, and (2) the disparagement bar is viewpoint-based.¹⁰

In 2019, the Supreme Court evaluated the Lanham Act’s immoral and scandalous standard in *Iancu v. Brunetti*.¹¹ Erik Brunetti is an artist and the owner of a clothing line that uses the trademark “FUCTION.”¹² The PTO refused to register FUCTION to the trademark register, describing the mark as “highly offensive” and “vulgar” and concluding that it has “negative sexual connotations.”¹³ A majority of the Court, looking at “immoral and scandalous” as a single standard rather than considering the two words as distinct standards,¹⁴ overturned the PTO’s decision and found that the immoral and scandalous bar was viewpoint-based.¹⁵

While *Iancu v. Brunetti* was a personal victory for Erik Brunetti, it is yet unclear how exactly trademark law will develop as a result of the decision. Many legal commentators are now speculating that the Supreme Court has handed off the question to Congress. The opinion

⁸ *Id.*

⁹ *Id.*

¹⁰ *See Matal*, 137 S. Ct. Justice Alito announced the opinion of the Court in which Chief Justice Roberts, Justice Thomas, and Justice Breyer join. Justice Kennedy, joined by Justice Ginsburg, Justice Sotomayor, and Justice Kagan, concurred in the judgment.

¹¹ *See Iancu v. Brunetti*, 139 S. Ct. 2294 (2019).

¹² *Id.* at 2297.

¹³ *Id.* at 2298.

¹⁴ *Id.*

¹⁵ *Id.* at 2299.

contained both subtle and explicit hints that Congress could rewrite the Lanham Act.¹⁶ Unfortunately, the Court has not given Congress a clear guideline. An eight-Justice Court agreed that the disparagement clause violated the First Amendment, but the opinion left many open questions regarding how to analyze Lanham Act First Amendment issues.¹⁷ In *Brunetti*, the majority opinion did not rule on whether trademark registration represented a government subsidy, a limited public forum, or government speech.¹⁸ Additionally, the government and Justice Sotomayor's dissent in particular argued that the immoral and scandalous standard should not be considered a unitary standard, but rather as two distinct standards.¹⁹ They suggest that the Lanham Act could be saved by narrowing the definition of "scandalous."²⁰ Such a narrower standard would regulate marks merely because of their "mode of expression" rather than viewpoint, resulting in viewpoint neutral regulation.²¹

This Comment will attempt to determine whether a distinction between viewpoint and mode of expression is viable, and whether it sufficiently narrows the Lanham Act to cure its constitutional deficiencies. Part II will set out in greater detail trademark law and the trademark registration process. Part III will review the *Matal v. Tam* and *Iancu v. Brunetti* decisions, focusing on the various Justices' reasonings. Part IV will consider the Supreme Court's precedent in regard

¹⁶ See Samuel Hine, *The Supreme Court Just Ruled in Favor of Fuct*, GQ (June 24, 2019), <https://www.gq.com/story/fuct-iancu-v-brunetti-supreme-court-ruling>; Emily Tillett, *Supreme Court Rules FUCT Brand Should Be Allowed Trademark*, CBS NEWS (June 24, 2019), <https://www.cbsnews.com/news/supreme-court-rules-that-fuct-brand-should-be-allowed-trademark/>; Howard Michael, *Iancu v. Brunetti: Supreme Court Strikes Down "Scandalous Marks" Ban*, THE NATIONAL LAW REVIEW (July 8, 2019), <https://www.natlawreview.com/article/iancu-v-brunetti-supreme-court-strikes-down-scandalous-marks-ban>.

¹⁷ See *Matal v. Tam*, 137 S. Ct. 1744 (2017). Justice Alito's opinion left open the possibility that Lanham Act First Amendment issues could be analyzed under a public forum or commercial speech framework. *Id.* at 1763 n.16; *id.* at 1764 n.17. Furthermore, while Justices Alito, Thomas, Roberts, and Breyer found that trademark registration did not constitute a federal subsidy, the four concurring Justices did not reach the subsidy issue. See *Matal*, 137 S. Ct. As such, no majority exists as to whether federal trademark registration constitutes a federal subsidy.

¹⁸ See *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019).

¹⁹ *Id.* at 2301; *id.* at 2309 (Sotomayor, J., dissenting).

²⁰ See *Brunetti*, 139 S. Ct.

²¹ *Id.* at 2309.

to distinguishing mode of expression from viewpoint, focusing on whether the Court recognizes mode of expression as a distinct component of speech. This Part highlights the fact that the Court has not fully accepted mode of expression as a distinct component of speech and has not treated mode of expression in a consistent manner. Part V will look at communication theory to determine whether mode of expression can be separated from viewpoint and message, and, if it can, whether regulating the mode of expression is viewpoint neutral. This Part suggests that mode of expression likely cannot be separated from the message or the viewpoint of the speaker. Even if it could, regulating mode of expression inevitably regulates viewpoint. Part VI will conclude that narrowing the Lanham Act’s “scandalous” provision to merely cover modes of expression would not result in viewpoint neutrality.

II. Trademarks and Federal Registration

Trademarks were not established by federal law and historically were under the purview of the states.²² The key idea behind trademarks and trademark protection is that recognizable marks, such as “words, names, symbols, and the like,” help distinguish a business’s goods from the goods of another business and allow consumers to distinguish and purchase the goods they want.²³ The federal government began to regulate trademarks in the 1870’s, but the foundation of modern federal trademark law was the Lanham Act of 1946.²⁴ By the time the federal government became involved, the nature of trademarks had changed. By the 20th century, trademarks “had expanded far beyond phrases” that simply identified a good.²⁵ Modern trademarks often “consisted of catchy phrases that convey a message.”²⁶

²² *Matal*, 137 S. Ct. at 1751.

²³ *Id.* at 1751 (quoting *B&B Hardware, Inc. v. Hargis Indus.*, 575 U.S. 138, 142 (2015)).

²⁴ *Id.* at 1751–53.

²⁵ *Id.* at 1752.

²⁶ *Id.*

The Lanham Act allowed trademarks to be filed on a “principal register,” a federal register of trademarks, with the United States Patent and Trademark Office (“PTO”).²⁷ Filing a trademark registration with the PTO involves paying a fee, filing an application, and filing a verified statement.²⁸ The application needs to include the applicant’s domicile and citizenship, the date of the first use of the mark, the date of the first use of the mark in commerce, the goods connected to that mark, and a drawing of the mark.²⁹ If the mark meets all of the above requirements, registration is mandatory unless the mark falls into the Lanham Act’s other statutory provisions.³⁰

The statutory provision relevant to this Comment sets out that the PTO cannot register a trademark that “comprises immoral, deceptive, or scandalous matter; or matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”³¹ This Comment will be focusing on trademarks that fall into the “immoral and scandalous” or “disparaging” category.

In evaluating whether a trademark violates the disparagement clause, the PTO examiner applies a two-part test.³² The examiner first considers “the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace.”³³ If the PTO examiner finds that the meaning refers to “identifiable persons, institutions, beliefs or national symbols,” the examiner moves to the second step, which is determining “whether that meaning may be disparaging to a substantial composite

²⁷ 15 U.S.C. § 1051(a)(1) (2019).

²⁸ *Id.* § 1051(a).

²⁹ *Id.*

³⁰ *Id.* § 1052(a) (requiring that “[n]o trademark . . . shall be refused registration on the principal register on account of its nature unless” it falls within an enumerated statutory exception).

³¹ *Id.*

³² *Matal v. Tam*, 137 S. Ct. 1744, 1753 (2017) (quoting Trademark Manual of Examining Procedure –§1203.03(b)(i) (Apr. 2017), <http://tmep.uspto.gov>).

³³ *Id.*

of the referenced group.”³⁴ If the examiner finds that a “substantial composite . . . of the referenced group would find the proposed mark . . . to be disparaging in the context of contemporary attitudes,” there is a prima facie violation of the disparagement clause, and the burden shifts to the applicant to prove that the trademark is not disparaging.³⁵

For the immoral and scandalous clause of the Lanham Act, the PTO applies the bar as a “unitary provision,” rather than treating the two adjectives separately.³⁶ To determine whether a mark fits into the category, the PTO asks whether a “substantial composite of the general public” would find the mark “shocking to the sense of truth, decency, or propriety”; “giving offense to the conscience or moral feelings”; “calling out for condemnation”; “disgraceful”; “offensive”; “disreputable”; or “vulgar.”³⁷ If so, then the PTO may refuse to register the mark due to the “immoral and scandalous” standard in the Lanham Act.

It is important to note that registration of a trademark is not necessary for the trademark to be enforceable in court.³⁸ A valid, unregistered trademark can still be used in commerce,³⁹ and a trademark is also enforceable under state law.⁴⁰ That said, federal registration imparts “important legal rights and benefits on trademark owners who register their marks.”⁴¹ Registration on the principal, federal register (1) “serves as ‘constructive notice of the registrant’s claim of ownership’ of the mark”;⁴² (2) “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

³⁴ *Id.* at 1753–54 (quoting Trademark Manual of Examining Procedure –B1203.03(b)(i) (Apr. 2017), <http://tmep.uspto.gov>).

³⁵ *Id.* at 1754.

³⁶ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2298 (2019).

³⁷ *In re Brunetti*, 877 F. 3d 1330, 1336 (Fed. Cir. 2017).

³⁸ *Matal*, 137 S. Ct. at 1752.

³⁹ *Id.*

⁴⁰ *Id.* at 1753.

⁴¹ *B&B Hardware, Inc. v. Hargis Indus.*, 575 U.S. 138, 172 (2015).

⁴² *Id.* (quoting 15 U.S.C. § 1072 (2019)).

to use the registered mark in commerce”⁴³ and (3) can make a mark “incontestable” once a mark has been registered for five years.⁴⁴ Registration also allows the trademark holder “to stop the importation into the United States of articles bearing an infringing mark.”⁴⁵ While registration is not necessary to enjoy the benefits of a valid trademark, registering a trademark with the federal register imparts various benefits on the trademark holder. Today, there are over two million federally registered trademarks.⁴⁶

III. The Supreme Court’s Invalidation of the Disparagement Clause and the “Scandalous and Immoral” Clause

The Court invalidated the disparagement clause in the 2017 case, *Matal v. Tam*. *Matal v. Tam* concerned a trademark registration application for a California band called “The Slants.”⁴⁷ Simon Tam is the singer of the Asian-American dance-rock group, who stated that he chose the name to “reclaim” and “take ownership” of Asian stereotypes.⁴⁸ The PTO denied the application based on the disparagement clause in the Lanham Act,⁴⁹ basing its decision on the finding that “the band’s name has been found offensive numerous times.”⁵⁰ The PTO pointed to a cancelled performance by the band and several bloggers and commentators who had been offended by the band’s name.⁵¹ Tam appealed the PTO’s decision in federal court.⁵² The Federal Circuit overturned the PTO’s decision, holding that the disparagement clause is facially unconstitutional under the First Amendment Free Speech Clause.⁵³ The majority found that the clause was a

⁴³ *Id.* (quoting 15 U.S.C. § 1057(b) (2019)).

⁴⁴ *Id.* (quoting 15 U.S.C. §§ 1065, 1115(b) (2019)).

⁴⁵ *See* 15 U.S.C. § 1124 (2019).

⁴⁶ *Matal v. Tam*, 137 S. Ct. 1744, 1752 (2017).

⁴⁷ *Id.* at 1751.

⁴⁸ *Id.* at 1754.

⁴⁹ *Id.* at 1751.

⁵⁰ *Id.* at 1754.

⁵¹ *Matal*, 137 S. Ct. at 1754.

⁵² *Id.* at 1754.

⁵³ *Id.* at 1754.

viewpoint-based regulation of the expressive component of trademarks.⁵⁴ It also found that trademarks were not commercial speech.⁵⁵ The Government appealed the decision to the Supreme Court.⁵⁶

The key issue in *Matal* was whether the disparagement clause violates the First Amendment. Justice Alito addressed the government’s arguments that: (1) trademarks are government speech, not private speech; (2) trademarks are a form of government subsidy; and (3) the constitutionality of the disparagement clause should be tested under a new “government-program” doctrine.⁵⁷

Justice Alito quickly dismissed the idea that trademarks are a form of government speech. He compared *Matal* to *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, in which the Court held that Texas specialty license plates were government speech.⁵⁸ The *Walker* Court rested its decision on three factors.⁵⁹ First, the Court found that license plates convey state messages.⁶⁰ Second, license plates “are often closely identified in the public mind” with the State, since they are manufactured and owned by the State, generally designed by the State, and serve as a form of “government ID.”⁶¹ Third, Texas “maintain[ed] direct control over the messages conveyed on its specialty plates.”⁶² None of these factors apply to trademark registration. Additionally, Justice Alito noted that if trademark registration is in fact government speech then “the Federal Government is babbling prodigiously and incoherently.”⁶³ The government would be endorsing a

⁵⁴ *Id.* at 1754.

⁵⁵ *Id.* at 1754.

⁵⁶ *Matal*, 137 S. Ct. at 1755.

⁵⁷ *Id.* at 1757.

⁵⁸ 135 S. Ct. 2239, 2253 (2015).

⁵⁹ *See id.* at 2247.

⁶⁰ *Id.* at 2248.

⁶¹ *Id.*

⁶² *Id.* at 2249.

⁶³ *Matal v. Tam*, 137 S. Ct. 1744, 1758 (2017).

vast variety of products and saying contradicting things.⁶⁴ Justice Alito thus held that trademarks are private, not government speech.⁶⁵

Justice Alito also quickly dismissed the idea that trademarks are government subsidies. He concluded that trademarks are not subsidies because the government is not giving out “cash subsidies or their equivalent.”⁶⁶ Even though in past cases the Court has considered tax benefits as subsidies, he held that the federal trademark registration program is nothing like a government subsidy program.⁶⁷ The PTO does not pay money to parties seeking registration of a mark. On the contrary, an applicant for registration must pay the PTO a filing fee of \$225-\$600.⁶⁸ To maintain federal registration, the holder of a mark must also pay a fee of \$300-\$500 every 10 years.⁶⁹ Furthermore, Justice Alito stipulated that numerous government registration schemes exist, such as for motor vehicles and fishing permits, and merely because there is an incidental benefit in registering something, it cannot be said that the government is subsidizing it.⁷⁰ Justice Alito thus found that trademark registration was not a government subsidy program.

Finally, Justice Alito considered whether trademark registration creates a “government program.” He found that the “government program” doctrine merges the subsidy and government speech arguments into one and constructs a broader doctrine that could possibly cover trademarks.⁷¹ The Court refused to extend the government program doctrine to cover trademark registration, as the government program doctrine cases “occupy a special area of First Amendment case law” and are “far removed” from the realm of trademarks.⁷² Justice Alito then considered

⁶⁴ *Id.*

⁶⁵ *Id.* at 1760.

⁶⁶ *Id.* at 1761.

⁶⁷ *Id.* at 1761.

⁶⁸ 37 C.F.R. § 2.6(a)(1) (2020).

⁶⁹ *Matal*, 137 S. Ct. at 1761.

⁷⁰ *Id.*

⁷¹ *Id.*

⁷² *Id.* at 1761–62

whether the federal trademark register is a public forum.⁷³ When the government creates a public forum, in either a literal or “metaphysical” sense, some content- and speaker-based restrictions may be permissible.⁷⁴ Even in such cases, “viewpoint discrimination” is not permissible.⁷⁵ Justice Alito thus turned to whether the disparagement standard constituted viewpoint discrimination. He found that it did. Justice Alito noted that because the PTO denied registration to any mark that is offensive to a substantial percentage of the members of any group, it is viewpoint discrimination.⁷⁶ He concluded that “giving offense is a viewpoint,” and invalidated the disparagement clause.⁷⁷

All Justices agreed that trademarks are not government speech, and that the disparagement clause is viewpoint-based and therefore in violation of the First Amendment.⁷⁸ Justice Kennedy, joined by Justices Ginsburg, Sotomayor, and Kagan, wrote the four-Justice concurrence. He quickly concluded that the disparagement clause was viewpoint discrimination, because it allowed an applicant to register a “positive or benign mark” but not a “derogatory” one.⁷⁹ Justice Kennedy then addressed the government’s arguments, beginning with the assertion that the law was viewpoint neutral because it applied to any trademark that demeans or offends.⁸⁰ Citing *Rosenberger*, Justice Kennedy concluded that preventing all sides from criticizing their opponents makes a law more viewpoint-based, not viewpoint neutral.⁸¹ By requiring that a trademark be positive and non-derogatory the law “might silence dissent and distort the marketplace of ideas.”⁸²

⁷³ *Id.* at 1763.

⁷⁴ *See Rosenberger v. Rector & Visitors of the Univ. of Va.*, 515 U.S. 819, 830–31 (1995).

⁷⁵ *Id.* at 831.

⁷⁶ *Matal*, 137 S. Ct. at 1763.

⁷⁷ *Id.*

⁷⁸ *See Matal*, 137 S. Ct.

⁷⁹ *Id.* at 1766.

⁸⁰ *Id.*

⁸¹ *Id.* (citing *Rosenberger v. Rector & Visitors of the Univ. of Va.*, 515 U.S. 819, 831–832 (1995) (“The . . . declaration that debate is not skewed so long as multiple voices are silenced is simply wrong; the debate is skewed in multiple ways”)).

⁸² *Id.*

Justice Kennedy saw the requirement of viewpoint neutrality as more than simply protecting the “right to identify with a particular side,” but rather as guaranteeing a right to “create and present arguments” for various positions in ways the speaker chooses.⁸³

Justice Kennedy then addressed the government’s next argument, that the law was viewpoint neutral because registration was denied based on the expected reaction of the audience, not the applicant’s personal views.⁸⁴ Justice Kennedy concludes that a law does not become viewpoint neutral merely because the censorship is tied to the reaction of the audience.⁸⁵ The danger of viewpoint discrimination is the government attempting to remove certain ideas from the broader public debate, and that danger is exacerbated if those ideas are offensive.⁸⁶ An offensive idea can lead to reflection and more debate, resulting in a “more reasoned, more tolerant” position.⁸⁷ Additionally, Justice Kennedy found that ultimately, when it comes to Lanham Act issues, it was the PTO deciding which ideas led to the audience taking offense.⁸⁸ As such, it is difficult to remove the government’s own opinion from the PTO’s decisions.⁸⁹

Yet, unlike Justice Alito, Justice Kennedy did not reach the questions of whether trademark registration is a government subsidy or a public forum.⁹⁰ The Court’s unclear position on such questions, along with Justice Alito’s, Justice Breyer’s, Chief Justice Roberts’s, and Justice Thomas’s opposition to considering trademark registration a government subsidy or a public forum, played a key role in the *Iancu v. Brunetti* decision two terms after *Matal*.

⁸³ *Matal*, 137 S. Ct. at 1766.

⁸⁴ *Id.*

⁸⁵ *Id.*

⁸⁶ *Id.* at 1767.

⁸⁷ *Id.*

⁸⁸ *Id.*

⁸⁹ *Matal*, 137 S. Ct. at 1767.

⁹⁰ *See id.* (Kennedy, J., dissenting).

In *Iancu v. Brunetti*, Erik Brunetti, an artist and founder of the “FUCT” clothing line, attempted to register the “FUCT” trademark. The PTO did not grant registration, and a PTO attorney described the mark as “vulgar” and “unregistrable.”⁹¹ The PTO officer further thought that the mark communicated “misogyny, depravity, [and] violence,” and concluded that “whether one considers [the mark] as a sexual term, or finds that [Brunetti] has used [the mark] in the context of extreme misogyny, nihilism or violence, [it has] no question but that [the term is] extremely offensive.”⁹² The PTO thus found the mark unregistrable based on the “immoral and scandalous” clause of the Lanham Act. Brunetti then brought a facial challenge to the “immoral and scandalous” clause to the Court of Appeals for the Federal Circuit.⁹³ The appellate court found the “immoral and scandalous” clause to violate the First Amendment’s Free Speech Clause.⁹⁴

The issue for the Supreme Court was whether denying a trademark registration because the mark is “immoral and scandalous” is a violation of the First Amendment. The majority began by clarifying that because the PTO applies “immoral and scandalous” as one standard, it too would consider the two words as one standard.⁹⁵ Writing for the majority, Justice Kagan found that based on the dictionary definitions of immoral “the Lanham Act permits registration of marks that champion society’s sense of rectitude and morality, but not marks that denigrate those concepts.”⁹⁶ Based on the dictionary definitions of scandalous “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.”⁹⁷ Put together, Justice Kagan concluded that the definitions meant that the Lanham Act allows the registration of trademarks when society in general approves of them from a moral

⁹¹ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2298 (2019).

⁹² *Id.*

⁹³ *Id.*

⁹⁴ *Id.*

⁹⁵ *Id.*

⁹⁶ *Id.*

⁹⁷ *Brunetti*, 139 S. Ct. at 2300.

or decency viewpoint, but does not allow registration when society would condemn the viewpoint.⁹⁸ The law has a facial viewpoint bias which “results in viewpoint-discriminatory application.”⁹⁹

The Government argued that the statute can be narrowed to “marks that are offensive [or] shocking to a substantial segment of the public because of their mode of expression, independent of any views that they may express.”¹⁰⁰ The Government explained that such an interpretation would limit the Lanham Act to marks that are “vulgar”—meaning “lewd,” “sexually explicit or profane.”¹⁰¹ Such a regulation, according to the Government, would not turn on viewpoint and the PTO could enforce it.¹⁰² The majority did not rule on whether the government’s narrowing construction would solve the First Amendment issues because it stated that the narrow interpretation was not supported by the text of the statute in its current form.¹⁰³

Several Justices alluded to or explicitly supported Congress revising the text of the statute. Justice Alito in his concurrence made clear that “[the Supreme Court’s] decision did not prevent Congress from adopting a more carefully focused statute that precludes the registration of marks containing vulgar terms that play no real part in the expression of ideas.”¹⁰⁴ Chief Justice Roberts seemed to agree with the government’s interpretation of “scandalous.” Concurring in part and dissenting in part, he agreed with the majority’s analysis of the “immoral” clause but thought that “scandalous” was separable from immoral.¹⁰⁵ He argued that the term “scandalous” does not need to be understood as reaching marks that offend because of the ideas they convey; “it can be read

⁹⁸ *Id.*

⁹⁹ *Id.*

¹⁰⁰ *Id.* at 2301.

¹⁰¹ *Id.*

¹⁰² *Id.*

¹⁰³ *Brunetti*, 139 S. Ct. at 2301.

¹⁰⁴ *Id.*

¹⁰⁵ *Id.*

more narrowly to bar only marks that offend because of their mode of expression—marks that are obscene, vulgar, or profane.”¹⁰⁶ Justice Breyer, pointing to Justice Sotomayor’s concurrence and dissent, agreed that the Court should interpret the word “scandalous” in the statute to refer only to highly “vulgar” or “obscene” modes of expression.¹⁰⁷

Justice Sotomayor offered the most comprehensive analysis of how the Government’s argument—narrowing the Lanham Act along the “scandalous” standard—could be effectuated. Justice Sotomayor argued that it is “possible to read that provision’s bar on the registration of ‘scandalous’ marks to address only obscenity, vulgarity, and profanity.”¹⁰⁸ Offensiveness could result from the views expressed, but it could also result from the way in which those views are expressed: using a manner of expression that is “shocking to [one’s] sense of . . . decency” or “extremely offensive to the sense of . . . propriety.”¹⁰⁹ She concluded that the word “scandalous” on its own is ambiguous.¹¹⁰ It can be read broadly (to cover both offensive ideas and offensive manners of expressing ideas), or it can be read narrowly (to cover only offensive modes of expression).¹¹¹ Justice Sotomayor concluded that because Congress would not have put duplicative or unnecessary words into a statute, Congress must have intended “scandalous” to be distinct from “immoral.”¹¹² Thus, while “immoral” and “disparaging” cover marks that are offensive because of the ideas they express, “scandalous” covers marks that are offensive because of their mode of expression, separate from a message or viewpoint.¹¹³

¹⁰⁶*Id.* at 2303.

¹⁰⁷ *Id.* at 2304.

¹⁰⁸ *Id.* at 2308.

¹⁰⁹ *Brunetti*, 139 S. Ct. at 2309.

¹¹⁰ *Id.*

¹¹¹ *Id.* at 2309.

¹¹² *Id.* at 2310.

¹¹³ *Id.* at 2310.

In that sense, the “scandalous” standard could be used to regulate marks that are expressed in a shocking or offensive manner, such as when the speaker employs obscenity, vulgarity, or profanity.¹¹⁴ Obscenity has been defined by the Court numerous times.¹¹⁵ As for vulgarity and profanity, Justice Sotomayor did not precisely define those terms. She stated that she “interpret[s] the term to allow the PTO to restrict . . . 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.”¹¹⁶ Justice Sotomayor argues that when narrowed, “scandalous” is a viewpoint-neutral form of content discrimination that is permissible in the kind of discretionary governmental program or limited forum typified by the trademark-registration system.¹¹⁷

IV. Supreme Court Precedent

It is unlikely that “scandalous” could be sufficiently narrowed by redefining the term as regulating mode of expression rather than viewpoint. As it stands, the Court does not have a comprehensive method of dealing with mode of expression or distinguishing modes of expression from message or viewpoint.¹¹⁸ The Court has occasionally made the distinction, but it has inconsistently applied the law to that distinction.

A. Justice Sotomayor has not sufficiently distinguished *Cohen v. California*

The natural starting point is the landmark case of *Cohen v. California*, which presents a somewhat similar situation to *Iancu v. Brunetti*. During the Vietnam War, the defendant, Cohen, entered a courthouse with the words “Fuck the Draft” prominently displayed on the back of his jacket.¹¹⁹ The defendant was convicted in Municipal Court of violating a part of a California

¹¹⁴ *Id.* at 2311.

¹¹⁵ *See, e.g., Miller v. California*, 413 U. S. 15 (1973).

¹¹⁶ *Brunetti*, 139 S. Ct. at 2311.

¹¹⁷ *Id.* at 2313.

¹¹⁸ *See Alan Howard, The Mode in the Middle: Recognizing a New Category of Speech Regulations for Modes of Expression*, 14 UCLA ENT. L. REV. 47 (2007).

¹¹⁹ *Cohen v. California*, 403 U.S. 15, 16 (1971).

statute that prohibits “maliciously and willfully disturb[ing] the peace or quiet of any neighborhood or person . . . by . . . offensive conduct”¹²⁰ The defendant testified in court that he wore the jacket as a means of informing the public of the depth of his feelings against the Vietnam War and the draft.¹²¹ The Court of Appeals affirmed and the California Supreme Court declined review.¹²² The United States Supreme Court granted certiorari.¹²³

The Court made clear in *Cohen* that the fact that unwilling onlookers may be present to see Cohen’s “distasteful mode of expression,” does not serve automatically to justify curtailing all speech capable of giving offense.”¹²⁴ The Court noted that the government’s prerogative to shut down “discourse solely to protect others from hearing it” depends on “a showing that substantial privacy interests are being invaded in an essentially intolerable manner.”¹²⁵ Otherwise, a majority could simply silence dissidents “as a matter of personal predilections.”¹²⁶ The Court then framed the issue as whether California can label Cohen’s actions as “offensive conduct” and remove a phrase from the public discourse on either the theory that it is likely to cause a violent reaction or on the theory that the States can act as “guardians of public morality” and remove words from the public vocabulary.¹²⁷

The Court dismissed the violent reaction theory quickly, by stating that the government did not present any evidence showing that sections of the public were prepared and willing to strike out against an person’s use of a curse word.¹²⁸ The Court then dismissed the public morality theory

¹²⁰ *Id.*

¹²¹ *Id.*

¹²² *Id.* at 17.

¹²³ *Id.*

¹²⁴ *Id.* at 21.

¹²⁵ *Cohen*, 403 U.S. at 21.

¹²⁶ *Id.*

¹²⁷ *Id.* at 22–23.

¹²⁸ *Id.* at 23.

on several grounds.¹²⁹ First, the Court stated that “one man’s vulgarity is another’s lyric.”¹³⁰ It is hard to draw lines as to what kind of language is vulgar and what kind of language is not. Second, the Court stated that the state “has no right to cleanse public debate to the point where it is grammatically palatable to the most squeamish among us.”¹³¹ It is difficult for government officials to make decisions in this area, which is why the Constitution left it to the individual.¹³² Finally, the Court argued that “much linguistic expression serves a dual communicative function.”¹³³ Part of communication consists of only ideas which are capable of being separated from the mode of expression, but a part of communication also expresses “otherwise inexpressible emotions.”¹³⁴

Brunetti cited *Cohen* to argue that the restriction at issue in *Iancu v. Brunetti* was viewpoint discrimination. But Justice Sotomayor argued that *Cohen* did not reach as far as Brunetti claimed it did.¹³⁵ She attempted to distinguish *Cohen* by arguing that the Court did not suggest that the State had targeted Cohen to suppress his specific, anti-war viewpoint, such that it would have accepted a similarly vulgar statement in support of the draft.¹³⁶ Rather, Justice Sotomayor suggested that the State had simply engaged in what later courts would call viewpoint-neutral content discrimination—it had regulated “the form or content of individual expression.”¹³⁷ Justice Sotomayor further argued that the *Cohen* Court’s language, stating that words are chosen for their literal meaning as well as their emotive meaning, is consistent with observing that a plain, blanket

¹²⁹ *Id.*

¹³⁰ *Id.*

¹³¹ *Cohen*, 403 U.S. at 25.

¹³² *Id.*

¹³³ *Id.* at 26.

¹³⁴ *Id.* at 26.

¹³⁵ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2314 (2019) (Sotomayor J., dissenting).

¹³⁶ *Id.*

¹³⁷ *Id.* (quoting *Cohen v. California*, 403 U.S. 15, 24 (1971)).

restriction on profanity is a viewpoint-neutral form of content discrimination.¹³⁸ *Cohen's* discussion did not go further to say that a regulation that treats all instances of profanity equally is nevertheless by nature an instance of “the government target[ing] . . . particular views taken by speakers on a subject.”¹³⁹ According to Justice Sotomayor, *Cohen* therefore did not resolve this case in Brunetti’s favor. While Brunetti, much like Cohen, was subject to content discrimination, that discrimination was a viewpoint neutral regulation of Brunetti’s mode of expression.

Yet, Justice Sotomayor does not address all of the *Cohen* Court’s reasoning. Her argument is a viable one if the mode of expression can truly be separated from the viewpoint. The *Cohen* Court was keenly aware of how the regulation of specific, offensive words could affect viewpoint, albeit without ever using the term “viewpoint”.¹⁴⁰ In concluding his majority opinion Justice Harlan stated that the Court “cannot indulge the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process.”¹⁴¹ He continued by noting that the government might “seize upon the censorship of particular words” to ban the “expression of unpopular views.”¹⁴² The Court in *Cohen* explicitly stated that even if it considered offensive words as modes of expression, it is dubious that prohibiting words would not also run the risk of limiting viewpoints.

¹³⁸ *Id.* (Sotomayor J., dissenting).

¹³⁹ *Id.* at 2315 (Sotomayor J., dissenting) (quoting *Rosenberger v. Rector & Visitors of the Univ. of Va.*, 515 U.S. 819, 829 (1995)).

¹⁴⁰ The Court in *Cohen* frequently uses the word ‘message,’ which the Court in later cases appears to treat as synonymous with the word ‘viewpoint.’ The Supreme Court defined viewpoint discrimination as an “egregious form of content discrimination” where the motivating factor behind the government’s regulation is the “ideology or the opinion or perspective of the speaker.” *Rosenberger*, 515 U.S. 819, 829 (1995). The term ‘message’ as used by the *Cohen* Court and various other sources cited in this Comment, seems to be an adequate substitute for the word ‘viewpoint’ from the *Rosenberger* definition. See also *Turner Broad. Sys. v. FCC*, 512 U.S. 622, 641 (1994) (emphases added) (“At the heart of the First Amendment lies the principle that each person should decide for him or herself the ideas and beliefs deserving of expression, consideration, and adherence. . . . Government action that stifles speech on account of its *message* . . . contravenes this essential right. . . . These restrictions raise the specter that the Government may effectively drive certain ideas or *viewpoints* from the marketplace.”). For the purposes of this Comment, I will treat ‘message’ as synonymous with ‘viewpoint’.

¹⁴¹ *Cohen v. California*, 403 U.S. 15, 26 (1971).

¹⁴² *Id.*

The Court in *Cohen* was also aware the value profanity and offensiveness have in emotive speech and expressing emotion. It expressly stated that vulgarity, used as a tool to express emotion, directly affects the speaker’s message.¹⁴³ Justice Harlan stated that the Court cannot “sanction” the view that the Constitution, while “solicitous of the cognitive content of individual speech,” ceases to care about the “emotive function which, practically speaking, may often be the more important element of the overall *message*. . . .”¹⁴⁴ While *Cohen* did not go on to state that the government cleansing the public discourse of profanity is viewpoint-based discrimination, it was aware that regulating the use of certain words can have that effect.

It is also important to remember that the Court in *Cohen* did not need to reach the question of whether offensiveness constitutes a viewpoint. The fact that the California law was a content-based regulation of speech was enough for the *Cohen* Court to apply heightened scrutiny in the criminal context.¹⁴⁵ Thus, Justice Sotomayor’s assertion¹⁴⁵ that the *Cohen* Court did not discuss whether the state law was viewpoint discriminatory is accurate. That is not the same, however, as concluding that the Court said that the law was viewpoint neutral. The state law in *Cohen* may well have been viewpoint discriminatory, but the *Cohen* Court did not need to reach the issue of viewpoint to apply heightened scrutiny. Moreover, in light of *Matal v. Tam*, it is likely that the state law in *Cohen* was viewpoint discriminatory. Justice Alito concluded his opinion with the

¹⁴³ *Id.*

¹⁴⁴ *Id.* (emphasis added).

¹⁴⁵ Justice Sotomayor also attempts to distinguish *Cohen* as arising in the criminal context, whereas *Brunetti* did not. *Iancu v. Brunetti*, 139 S. Ct. 2294, 2312 (2019) (Sotomayor J., dissenting). Justice Sotomayor suggests that because “the stakes are far removed” from a situation where *Brunetti* would be facing a harsher, criminal punishment, his case is better suited to be subject to a limiting construction that would limit the inquiry to whether the Government “must be forced to provide” the “ancillary benefit” of federal trademark registration. *Id.* Justice Sotomayor appears to be arguing that the “severity of the speaker’s punishment is relevant to the merits of his First Amendment claim.” Michael Coenen, *Of Free Speech and Sanctions: Toward a Penalty-Sensitive Approach to the First Amendment*, 112 COLUM. L. REV. 991, 994 (2012). Such a penalty-sensitive approach suggests a “positive correlation” between the harshness of the speaker’s punishment and the strength of his First Amendment claim. *Id.* While evaluating whether penalty-sensitivity, as opposed to penalty-neutrality, could affect the outcome in *Brunetti* is important to addressing Justice Sotomayor’s argument and conclusion, it is outside of the scope of this Comment. Penalty-sensitivity has no bearing on Justice Sotomayor’s claim that the mode of expression is separable from viewpoint.

phrase: “giving offense is a viewpoint.”¹⁴⁶ Justice Kennedy, in an opinion joined by Justice Sotomayor a mere two terms before *Iancu v. Brunetti*, invalidated Justice Sotomayor’s argument in *Brunetti*. He found that merely because a law limited and regulated speech on all sides did not make it viewpoint neutral, but rather more viewpoint-based.¹⁴⁷ Regardless whether decided through Justice Alito’s or Justice Kennedy’s framework from *Matal, Cohen* would likely be considered viewpoint discriminatory today.

B. The Supreme Court is inconsistent with how it treats modes of expression

Looking beyond *Cohen v. California*, the Supreme Court’s precedent when it comes to modes of expression and their effect on viewpoint is inconclusive. Professor Alan Howard argues in his article that for the Supreme Court the crucial issue with distinguishing mode of expression from content and viewpoint began in 1986 with *City of Renton v. Playtime Theatres, Inc.*¹⁴⁸ In *Renton*, the Court rejected a First Amendment challenge to a zoning ordinance that prohibited adult motion picture theaters from being within 1,000 feet of a residential zone, single or multifamily dwelling, church, park, or school.¹⁴⁹ Based on the definitions, the ordinance was content-based on the basis of subject matter, as it applied only to sexual content. The Court nevertheless treated the law as content-neutral, because it was motivated by a decision to control the secondary effects of adult theaters and not by a motivation to restrict speech.¹⁵⁰ According to Professor Howard, *Renton* broke the classic content-based/content-neutral dichotomy the Court traditionally used and “over the years has produced a panoply of confusing and often incoherent

¹⁴⁶ *Matal v. Tam*, 137 S. Ct. 1744, 1763 (2017).

¹⁴⁷ *Id.* at 1766.

¹⁴⁸ Howard, *supra* note 118, at 52.

¹⁴⁹ *Renton v. Playtime Theatres, Inc.*, 475 U.S. 41, 48 (1986).

¹⁵⁰ *Id.*

analyses.”¹⁵¹ He argued that this case is really the beginning of several Supreme Court cases that upheld a statute based on its regulation of a mode of expression.¹⁵²

The Court has held many times that certain modes of expression can be proscribed by the government without violating First Amendment law. Justice Sotomayor’s argument attempts to equate obscenity, vulgarity, or profanity with those proscribed modes of expression. The question is thus whether mode of expression is separable from viewpoint, and, if it is, whether regulating modes of expression affects viewpoint.

i. Obscenity is outside the scope of the First Amendment and likely does not sufficiently narrow the “scandalous” standard

First, while Justice Sotomayor lists obscenity alongside vulgarity and profanity, obscenity is distinct from the other terms. The Court often describes obscenity as being outside of the First Amendment protected speech altogether.¹⁵³ Obscenity is defined narrowly by the Court. When a court must decide whether a proscribed form of communication is obscenity the basic guidelines for the trier of fact are (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.¹⁵⁴

Justice Sotomayor is correct that government can proscribe obscene language and obscene modes of expression, but a trademark like Brunetti’s, for example, would certainly not meet the standard described in *Miller v. California*. The trademark in *Matal v. Tam* would not meet the

¹⁵¹ Howard, *supra* note 118, at 52.

¹⁵² *Id.*

¹⁵³ *Miller v. California*, 413 U.S. 15, 23 (1973).

¹⁵⁴ *Id.* at 24.

obscenity standard because it is not sexual in nature. As such, narrowing “scandalous” to mean obscene modes of expression is under-inclusive for Justice Sotomayor’s purposes. In order to sufficiently narrow “scandalous,” profanity and vulgarity must be considered as modes of expression independent from viewpoint.

ii. The Supreme Court’s treatment of profanity and vulgarity has been inconsistent and inconclusive

The Court has been inconsistent in its case law both as to whether profanity and vulgarity are modes of expression and as to whether the government may regulate profanity and vulgarity. *Cohen* sets forth several arguments as to why profanity and vulgarity are important aspects of viewpoint and should not be considered mere modes of expression. While *FCC v. Pacifica Foundation* has contradicted *Cohen* on some grounds, the Court has not regularly applied the reasoning from *Pacifica Foundation* to other cases and the reasoning seems to be limited to the context of the broadcast medium. Since *Pacifica Foundation*, the Court has not articulated a definite stance on modes of expression and their regulation.

In *FCC v. Pacifica Foundation*, the Court upheld the ability of the Federal Communications Commission to prohibit and punish indecent language over television and radio.¹⁵⁵ The case arose out of a radio station in New York playing comedian George Carlin’s monologue on the “seven dirty words.”¹⁵⁶ The Court held that while the government could not prohibit these words, it could ban them from being aired over the broadcast media, stating that “patently offensive, indecent material presented over the airwaves confronts the citizen, not only in public, but also in the privacy of the home, where the individual’s right to be left alone plainly

¹⁵⁵ See *FCC v. Pacifica Found.*, 438 U.S. 726 (1978).

¹⁵⁶ *Id.* at 748.

outweighs the First Amendment rights of an intruder.”¹⁵⁷ The Court weighed in favor of regulation because broadcasting is accessible to children, “even those too young to read.”¹⁵⁸ Justice Harlan, writing for the majority, expressly stated that if the government’s regulation of Carlin’s offensive monologue “could be traced to its political content . . . First Amendment protection might be required.”¹⁵⁹ In his opinion, Justice Harlan thus drew a distinction between the message and the mode of expression, namely the use of profanity and vulgarity, but still left open the possibility that First Amendment protections could apply if the regulation were tied to viewpoint.

At first glance, the *Pacifica Foundation* decision seems to support Justice Sotomayor’s position that vulgarity and profanity are modes of expression. The *Pacifica Foundation* decision seems to be at odds with *Cohen*. For one, it suggests that the Court can cleanse the broadcast media in order to make it safe for children, something that *Cohen* expressly rejected in the public realm. Justice Harlan even seemed to distinguish between mode of expression and content; *Cohen v. California* cast doubts on such distinctions. The case also suggests that *Cohen* may not be set in stone. Pointing to *Pacifica Foundation*, Justice Sotomayor may say that while her reasoning seems to contradict the Court’s dicta from *Cohen*, the Court has also contradicted *Cohen* in the past. The fact that the Court appeared to distinguish *Cohen* in *Pacifica Foundation* can thus lend credence to Justice Sotomayor’s treatment of *Cohen*.

Unfortunately for Justice Sotomayor, the Court seems reluctant to expand *Pacifica Foundation*, as it has not been willing to extend it beyond the free radio broadcast medium. For example, in *Sable Communications v. FCC*, the Court held that it is unconstitutional for a federal statute, designed to eliminate the “dial-a-porn” industry, to prohibit indecent speech.¹⁶⁰ The Court

¹⁵⁷ *Id.*

¹⁵⁸ *Id.* at 749.

¹⁵⁹ *Id.* at 735.

¹⁶⁰ *Sable Communications v. FCC*, 492 U.S. 115, 128 (1989).

rested its decision on a lack of a “captive audience” as callers were generally willing listeners.¹⁶¹ Additionally, in *United States v. Playboy Entertainment Group, Inc.* the Court used strict scrutiny to declare unconstitutional a provision of the Cable Act regulating sexual speech.¹⁶² The Cable Act intended to limit the broadcast of sexually explicit channels to certain hours in order to prevent signal bleed—a situation where people receive images from cable channels to which they do not subscribe.¹⁶³ The Court held that the law was content-based discrimination as it applied only to non-obscene sexual images, but not to any other type of images.¹⁶⁴ The law did not survive strict scrutiny, because there were other less restrictive measures the government could have employed.¹⁶⁵ Given that the Court was unwilling to extend *Pacifica’s* reasoning to cable television, it is unlikely that the Court would extend *Pacifica* to trademark registration. Nevertheless, *Pacifica* appears to set out a distinction between viewpoint and mode of expression when it comes to profanity and vulgarity.

Since *Pacifica Foundation*, Justice Stevens seemed to have been a proponent of separating mode of expression from content or viewpoint. In his concurrence in *Consolidated Edison Co. v. Public Service Commission of New York*, Justice Stevens argued that there are two types of offensiveness: offensiveness independent of the message of the speaker, and offensiveness because the listener disagrees with the speaker.¹⁶⁶ He argued that offensiveness of form, or mode of expression, can be appropriate for regulation.¹⁶⁷ In *Bolger v. Youngs Drug Products Corp.* the majority struck down a federal statute that prohibited sending unsolicited advertisements for

¹⁶¹ *Id.*

¹⁶² See *United States v. Playboy Ent. Grp., Inc.*, 529 U.S. 803 (2000).

¹⁶³ *Id.* at 804.

¹⁶⁴ *Id.*

¹⁶⁵ *Id.*

¹⁶⁶ *Consolidated Edison Co. v. Pub. Serv. Comm’n. of New York*, 447 U.S. 530, 546–48 (1980) (Stevens, J., concurring in the judgment).

¹⁶⁷ *Id.* at 548 (Stevens, J., concurring in the judgment).

contraceptives through the mail.¹⁶⁸ Justice Stevens noted in his concurrence that he agreed with the majority because the law regulates “communications for their ideas or for their style.” He stated, however that “regulations of form and context may strike a constitutionally appropriate balance” between the speaker’s right to express a message and a listener’s interest in “the quality of his environment.”¹⁶⁹ Justice Stevens seemed to be drawing a distinction between mode of expression and ideas or content, and asserting that in some instances limiting a speaker’s freedom of expression can be appropriate.

At the same time, there are several examples of Justices advocating that mode of expression cannot be separated from the viewpoint or the message. Justice Harlan’s opinion in *Cohen* is one example. Another is Justice Brennan’s dissent in *Pacifica*, where he stated that the idea that the message is separable from the “vehicle for its expression” is “transparently fallacious.”¹⁷⁰ Justice O’Connor in her opinion for the Court in *City of Erie v. Pap’s A.M.* stated that there may be cases where “banning the means of expression so interferes with the message that it essentially bans the message.”¹⁷¹ These Justices suggest that the mode of expression is sufficiently linked to the message or viewpoint that regulating one will affect the other.

In short, the Supreme Court has not applied the distinction between mode of expression and the viewpoint of the speaker “in a proper and systematic manner.”¹⁷² The Court is unclear as to whether mode of expression can be separated from the content or the message. If it can, the Court is further unclear on how modes of expression ought to be treated. Over the years, the Justices have either not touched on the issue, or have had diverging opinions. On the current Court,

¹⁶⁸ *Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60 (1983).

¹⁶⁹ *Id.* at 84 (Stevens, J., concurring).

¹⁷⁰ *FCC v. Pacifica Found.*, 438 U.S. 726, 773 (1978) (Brennan, J., dissenting).

¹⁷¹ *City of Erie v. Pap’s A.M.*, 529 U.S. 277 (2000).

¹⁷² Howard, *supra* note 118, at 55.

the notion that mode of expression can be separated from the content or the message seems to have support from Justices Sotomayor, Breyer, Roberts, and Alito. The other Justices did not discuss the issue in *Iancu v. Brunetti*. It appears to be an open question.

V. Lessons from Communication Theory

Professor Howard, while arguing that mode of expression can be separated from the content and ideas, stated that “some modes of expression may be so intertwined with the particular message” that “requiring the speaker to alter his mode of expression runs the risk of altering the message itself.”¹⁷³ He considers the example of Picasso’s painting, *Guernica*.¹⁷⁴ He admits that it is “hard to conceive of separating the mode of the expression from the message” of *Guernica*.¹⁷⁵ At the same time, however, he suggests that “it is conceivable that one could articulate in words the gist of what Picasso intended to communicate about the Spanish Civil War when he painted *Guernica*.”¹⁷⁶ Communication theory seems to suggest, however, that any attempt at describing what Picasso communicated through *Guernica* in words would be vastly under-inclusive. A painting says more than a paragraph of words. Furthermore, even if one could find words to fully describe *Guernica*, the medium used would inevitably affect the way people view it. For example, a glance at *Guernica* the painting would give a larger sense of what Picasso was trying to communicate than a glance at *Guernica* the book. Given the dearth of consistent Supreme Court precedent, the question that needs answering is whether changing or regulating the modes of expression affects the message or viewpoint of the speaker.

¹⁷³ Howard, *supra* note 118, at 56.

¹⁷⁴ *Id.*

¹⁷⁵ *Id.*

¹⁷⁶ *Id.*

Marshall McLuhan's seminal book, *The Medium is the Message*, argues that the medium is more important in communication than the message itself.¹⁷⁷ While heavily focused on how communications media were influenced by emerging technologies, McLuhan argues that "[s]ocieties have always been shaped more by the nature of the media by which men communicate than by the content of the communication."¹⁷⁸ McLuhan's starting point is that all media are an extension of a human faculty.¹⁷⁹ As such, media evoke "unique ratios of sense perception," such that the extension of "one sense alters the way we think and act."¹⁸⁰ Illustrating his point with the example of the alphabet and the printing press, he argues that prior to those technologies the key human faculty and the "dominant organ of sensory and social orientation" was the ear.¹⁸¹ In those times, people lived in an "acoustic space" where speech was the main source of information.¹⁸²

Then came the alphabet and the printing press. Both fundamentally changed the way societies think by fostering "a process of specialism and of detachment."¹⁸³ The two technologies created "the portable book" which could be read in privacy and isolation.¹⁸⁴ Literacy enabled people to have the "power of detachment" and "non-involvement."¹⁸⁵ By its very structure the alphabet—a "construct of fragmented bits and parts which have no semantic meaning in themselves"—forced people to think linearly and be dependent on the "presentation of connected and sequential facts or concepts."¹⁸⁶

¹⁷⁷ See MARSHALL MCLUHAN, *THE MEDIUM IS THE MESSAGE* (Ginko Press 2001) (1967).

¹⁷⁸ *See id.*

¹⁷⁹ McLuhan, *supra* note 178, at 26.

¹⁸⁰ McLuhan, *supra* note 178, at 41.

¹⁸¹ McLuhan, *supra* note 178, at 44.

¹⁸² McLuhan, *supra* note 178, at 48.

¹⁸³ McLuhan, *supra* note 178, at 8.

¹⁸⁴ McLuhan, *supra* note 178, at 50.

¹⁸⁵ *Id.*

¹⁸⁶ McLuhan, *supra* note 178, at 44–45.

Electronic circuitry profoundly changed the way society thinks once again. McLuhan declared that people now live in a “global village . . . a simultaneous happening.”¹⁸⁷ Electric circuitry “involves men with one another.”¹⁸⁸ Gone are the days of reading a book or newspaper in isolation; today “information pours upon us, instantaneously and continuously.”¹⁸⁹ McLuhan argued that people can no longer be limited with linear “block-by-block, step-by-step” thinking, as instantaneous communication makes sure that “all factors of the environment and of experience coexist in a state of active interplay.”¹⁹⁰ To McLuhan, the idea that the message, idea, or content of communication can be separated from the medium is an impossibility. The way people think is firmly linked to the medium of communication and people often do not fully appreciate how the medium affects the message.

While the “mode of expression” discussed by Justice Sotomayor in *Brunetti* refers to a slightly different concept than the “medium” discussed by McLuhan, McLuhan’s principles are still valid in analyzing Justice Sotomayor’s argument. In the same sense that medium has a profound effect on communication, the mode of expression has a profound effect on the message or viewpoint of speech. The key concept from McLuhan’s book is not merely that the medium is the message, but rather that the medium is often not thought about. People tend not to think about how they received information but focus on the information itself. This creates an environment where manipulating the way a certain message is received can change the message itself, and, in turn, perhaps create a more powerful message. Profanity and vulgarity do not simply amplify a message, they change it.

¹⁸⁷ McLuhan, *supra* note 178, at 63.

¹⁸⁸ *Id.*

¹⁸⁹ *Id.*

¹⁹⁰ *Id.*

In the context of art, the mode of expression cannot be separated from the content or the message of an art piece. According to Amy Sabrin, mode of expression comprises the means by which subject matter and viewpoint are expressed.¹⁹¹ She argues that whether the style or form enhances or interferes with the viewpoint is “perhaps the most important factor—and often the most debated one”¹⁹² Sabrin also discusses the role offensiveness plays in artistic endeavors. Sabrin states that even art that expresses “repulsive” views, such as art that is sexist, racist or violent, can have “technical,” merit.¹⁹³ She uses Leni Riefenstahl's pro-Hitler propaganda films of World War II and some rap music and music videos as examples of works that express repulsive and offensive views, but have artistic merit.¹⁹⁴ The more fundamental problem with disqualifying offensive viewpoints is that viewpoint is “perhaps the most subjective element of content.”¹⁹⁵ It is precisely the types of work that offend that “may be intentionally or unintentionally complex, contradictory, or ambiguous.”¹⁹⁶ In short, she argues that it is hard to separate the offensiveness from the message, when offensiveness may be the message or a major component of the message.

Considering McLuhan's and Sabrin's works in tandem begins to demonstrate the difficulties of separating mode of expression and viewpoint. As an example, consider the California band, The Slants, from *Matal v. Tam*. While the name refers to a derogatory term, the band believe that the name will help reclaim the term and “drain its denigrating force.”¹⁹⁷ McLuhan would argue that the band chose to express a message in a certain way—through trademark registration and the use of a racial slur—and the medium chosen is just as important as

¹⁹¹ Amy Sabrin, *Thinking about Content: Can it Play an Appropriate Role in Government Funding of the Arts*, 102 YALE L. J. 1209, 1219 (1993).

¹⁹² Sabrin, *supra* note 191, at 1220.

¹⁹³ Sabrin, *supra* note 191, at 1221.

¹⁹⁴ *Id.*

¹⁹⁵ *Id.*

¹⁹⁶ *Id.*

¹⁹⁷ *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017).

the message itself. Applying McLuhan’s idea of media evoking “ratios of sense perception,” profanity and the medium of trademark registration offer “The Slants” a mode of expression like no other. The trademark necessarily means that “The Slants” name will always be associated with the band,¹⁹⁸ and the offensiveness gives the band a wider reach than an inoffensive trademark could. The fact that bloggers and commentators are engaged in a public discussion about the band’s name is indicative of that fact. While it is true that there are other ways of “drain[ing] the denigrating force” from a racial slur, it is also hard to conceive of a way to express exactly what the band aimed to express by calling themselves “The Slants” through other modes of expression without sacrificing meaning, message, and viewpoint. Sabrin would similarly argue that the offensiveness of the name “The Slants” serves a purpose. It is doubtful that regulating the mode of expression would not also tamper with that purpose.

The use of offensive language serves many functions that help further reinforce the author’s or speaker’s message and ideas. One example of such a phenomenon is in the context of political campaigns. An Italian study decided to try to pin down the effects of swearing and vulgar language on voters during a hypothetical local election.¹⁹⁹ A sample of the electorate was split up and given one of two blog posts by a hypothetical local politician.²⁰⁰ One blog post contained vulgar language, while the other contained “neutral” language.²⁰¹ The study found that using vulgar language in a blog post generally increased the perceived informality of a source and “improved the impression about the source.”²⁰² Citing Marshall McLuhan, the study found that when “the

¹⁹⁸ If the band truly want to reclaim the word “slants” and drain it of its denigrating force, then various benefits of federal trademark registration ensures that the word will be associated with the band for years to come. Registration ensures that the message will not be lost.

¹⁹⁹ Nicoletta Cavazza & Margherita Guidetti, *Swearing in Political Discourse: Why Vulgarity Works*, 33 J. LANGUAGE & SOC. PSYCHOL. 537, 540 (2014).

²⁰⁰ Cavazza & Guidetti, *supra* note 199, at 540.

²⁰¹ *Id.*

²⁰² Cavazza & Guidetti, *supra* note 199, at 544.

source is the message” and informality is perceived by voters as “a positive surprise,” swearing and profanity can be a useful method of getting political consensus.²⁰³ The study also suggests that the positive effect of vulgarity seems to apply to the whole electorate.²⁰⁴ The effects “did not vary as a function of participants’ gender, education, involvement in politics, and self-reported position on the left–right political spectrum.”²⁰⁵ In the political sphere, profanity and vulgarity can serve important functions that help define the politician and his or her ideas and viewpoints.

Another example of the effective use of vulgarity is in the television series *South Park*. While *South Park* often employs “lewd toilet humor,” it often addresses important, contemporary issues.²⁰⁶ Joe Thorogood argues that the two sides of *South Park*—the serious, political side and the toilet humor side—actually feed off of each other. He argues that the lewd humor is “a central and vital technique” that creates a unique sense of satire that does not resemble “conventional political humor.”²⁰⁷ *South Park* consistently blends the trashy and lewd with geopolitics and social commentary.²⁰⁸

Thorogood asserts that the use of profanity to tackle important issues has deep historical roots, and points to the writings of Mikheal Bakhtin, an early 20th century writer whose writings employed infantile humor.²⁰⁹ Bakhtin wrote about the concept of “carnival,” a situation where “frivolity and chaos associated with carnival celebrations invert the normal functioning of order.”²¹⁰ He also developed the idea of “body grotesque,” a lowering of what is perceived as high

²⁰³ *Id.*

²⁰⁴ Cavazza & Guidetti, *supra* note 199, at 545.

²⁰⁵ *Id.*

²⁰⁶ Joe Thorogood, *Satire and Geopolitics: Vulgarity, Ambiguity and the Body Grotesque in South Park*, 21 *GEOPOLITICS* 215, 216, 223 (2016).

²⁰⁷ Thorogood, *supra* note 206, at 224.

²⁰⁸ Thorogood, *supra* note 206, at 225.

²⁰⁹ Thorogood, *supra* note 206, at 221.

²¹⁰ *Id.*

culture to the level of the lewd in the form of bodily functions.²¹¹ Bakhtin and Thorogood argue that such methods contained “revolutionary potential,” as in the face of carnival and body grotesque social hierarchy faded away and was replaced with a sense of equality.²¹²

South Park, according to Thorogood, is a modern continuation of the themes of carnival and body grotesque. In one notable episode, one of *South Park*'s main characters attempts to pin the fault for the September 11, 2001 attacks on one of his classmates.²¹³ This premise leads to an episode exploring the concepts of 9/11 conspiracy theories.²¹⁴ In the process, the episode includes images of a United States president killing a leader of a 9/11 conspiracy organization, a student defecating in a school bathroom, and images of the Twin Towers in flames with a primary school student's face superimposed on the wreckage.²¹⁵ All of these images can be patently offensive. Yet, the body grotesque and carnival aspects enhance the episode's messages and viewpoints, whatever one might think of them. Through lewd humor *South Park* explores the United States government's fear of geopolitical threats from within its borders, the government's fragility and incompetence after 9/11, and the ridiculous nature of conspiracy theories.²¹⁶ *South Park*'s creators, Trey Parker and Matt Stone, spoke about their dislike of conspiracy theories in the episode commentary.²¹⁷ They consciously decided that rather than rationally debunk conspiracy theories, as has been done before, they would lower them to a lewd and childish level.²¹⁸ There is no doubt that the mode of expression could be described as offensive, but insisting that *South Park* and its

²¹¹ Thorogood, *supra* note 206, at 222.

²¹² Thorogood, *supra* note 206, at 222 (stating “[e]verybody eats and shits at the carnival”).

²¹³ Thorogood, *supra* note 206, at 228.

²¹⁴ Thorogood, *supra* note 206, at 229.

²¹⁵ Thorogood, *supra* note 206, at 228.

²¹⁶ Thorogood, *supra* note 206, at 229.

²¹⁷ *Id.*

²¹⁸ *Id.*

creator's express their viewpoint in a non-offensive way would deprive them of a powerful tool for expressing their viewpoint.

Regulating the mode of expression inevitably affects viewpoint. Swearing can be a powerful tool for politicians, and toilet humor can be a powerful tool for expressing viewpoints and opinions. Justice Sotomayor stated in *Iancu v. Brunetti* that “[r]estrictions on particular modes of expression do not inherently qualify as viewpoint discrimination; they are not by nature examples of the government target[ing] . . . particular views taken by speakers on a subject.”²¹⁹ This statement rests on two key assumptions: (1) that modes of expression are separable from viewpoint and (2) that the modes of expression in question, namely obscenity, vulgarity and profanity, as defined by Justice Sotomayor, do not express a viewpoint. As to the first assumption, whether in the context of mass media or in the context of art, the mode or way of expressing a message seems to be intertwined with the message or viewpoint itself. As to the second assumption, vulgarity and profanity are and can be used in various contexts in ways that enhance and express the viewpoint.

VI. Conclusion

Matal v. Tam and *Iancu v. Brunetti* presented a clash of First Amendment ideologies between the Justices on the current Supreme Court. The key issue is one of viewpoint neutrality. In *Brunetti*, the majority of the Court, namely Justices Kagan, Thomas, Ginsburg, Gorsuch, and Kavanaugh, held that if a law regulates ideas that offend, then it is a viewpoint-based regulation.²²⁰ Justices Alito, Roberts, Breyer, and Sotomayor, in their various dissents and concurrences suggest that regulating all offensive, vulgar, or profane speech is viewpoint neutral. According to them, a law that regulates vulgar, profane, or obscene modes of expression does not regulate viewpoint

²¹⁹ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2313 (2019) (Sotomayor J., dissenting).

²²⁰ *Id.* at 2301.

because it does not take sides. It regulates evenhandedly, regardless of “particular” views on a subject.²²¹ These two views are at odds with each other and are explored in this Comment within the context of the Lanham Act.

Justice Sotomayor argues in her dissent in *Iancu v. Brunetti* that by separating the “immoral and scandalous” standard in the Lanham Act into two distinct standards, the word “scandalous” could be defined to only regulate the mode of expressing a trademark rather than the viewpoint or message of the applicant. Justice Sotomayor suggested defining “scandalous” to proscribe modes of expression that are obscene, vulgar, and profane. Such a content-based but viewpoint-neutral construction would allow the government to regulate a government program or a government subsidy scheme. The immediate problem with Justice Sotomayor’s argument is that Supreme Court precedent is unclear as to whether trademark registration constitutes a government program or a government subsidy. Even if trademarks were a government subsidy or a government program, the question remains whether regulating solely modes of expression is constitutionally permissible and whether it would truly result in viewpoint neutrality.

First, there is a dearth of Supreme Court precedent addressing whether the mode of expression is a distinct aspect of speech and, if so, how such an aspect ought to be treated by regulators. Second, the available precedent shows that when the Court has addressed modes of expression, it has done so in an inconsistent and inconclusive manner. After the *Brunetti* decision Congress is left without guidance in the task of rewriting the Lanham Act. This Comment argues that such a narrowing construction would not alleviate the First Amendment problems facing the Lanham Act. More broadly, the mode of expression, while a distinct part of speech, cannot be cleanly separated from the message or viewpoint of the speaker.

²²¹ *Id.* at 2314 (Sotomayor J., dissenting) (stating that mode of expression is not “by nature . . . government targeting particular views”).

As suggested by communication theory, even if modes of expression were cleanly separable from viewpoint, regulating or prohibiting certain modes of expression would inevitably affect viewpoint. Communication theory does not support Justice Sotomayor's argument that obscenity, vulgarity, and profanity can be redefined as viewpoint neutral modes of communication. Profanity and vulgarity are chosen by the speaker to convey a specific message. For example, the message in Picasso's *Guernica* could be conveyed in various ways. Yet *Guernica* would not be able to convey Picasso's viewpoint as eloquently and accurately if Picasso were limited to only certain colors or to only drawing animals, not human figures. Would Simon Tam's band convey the same message and viewpoint if they were not called The Slants? Would Erik Brunetti's streetwear brand convey the same ethos if it were not named FUCT? The vulgarity and profanity of these names greatly contribute to the messages and viewpoints behind them. Ultimately, as Justice Alito concluded in *Matal*, "giving offense is a viewpoint."²²²

²²² *Matal v. Tam*, 137 S. Ct. 1744, 1763 (2017).