Noli IP Newsletter

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Supreme Court's "Scandalous" Decision

By Mariana Paula Noli, Esq.

Some of you may have already been made aware that moving forward the U.S. Patent and Trademark Office (USPTO) will be forced to register any mark, regardless of its content as the Supreme Court's *Iancu v. Brunetti* decision finally was rendered last Monday. After the Supreme Court decided in *Matal v. Tam* that a Lanham Act prohibition against the registration of "disparaging" trademarks clashed with the First Amendment and was thus invalid, many believed that it wouldn't be long before the Supreme Court Justices struck down a similar prohibition against the

Mariana, Diane and Sam at the last IALA Monthly Dinner

Happy Summer!!!

By Erica C. Durant

It's crazy that we are already half way through the summer. Nothing says summer quite like fireworks and other Fourth of July fanfare.

On behalf of our group, I take this opportunity to wish everyone a Happy Independence Day!

Thank you to all our client for a wonderful year.

Our office will be closed Thursday, July 4th in observance of the Independence Day holiday.

We have an extraordinary year ahead of us, and the staff at Noli IP Solutions, PC looks forward to witnessing your and your company's accomplishments and triumphs!

registration of marks including “immoral” or “scandalous” material under §1052(a). And they were right, it finally happened as predicted last Monday.

In its decision, the highest justice court of the United States of America held that the nearly century-old prohibition by the USPTO on the federal registration of “immoral” or “scandalous” trademarks, more specifically, to accept the registration of "FUCT" amounted to viewpoint discrimination in violation of the First Amendment to the U.S. Constitution.

For those not familiar with the *Iancu v. Brunetti* case, here is a (very) brief summary: "FUCT" is the clothing line founded by Mr. Erik Brunetti, who took on trademark examiners after being refused registration of his trademark. In December 2017, he prevailed against the contention that the government shouldn't have to subsidize distasteful marks and got the United States Court of Appeals for the Federal Circuit to hold that the Lanham Act's ban on immoral or scandalous matter was unconstitutional. This decision came out only months after the Supreme Court opinion involving Asian American Simon Tam, the front man of The Slants, convinced a majority of justices to strike down a different provision of the Lanham Act relating to the registration of disparaging marks. There is no doubt that the *Tam* case opened the door to the decision in the *Brunetti* one.

The speech at issue in this case was the clothing company’s brand name, which comprises a word described during oral argument as *“the equivalent of [the] past participle form of a well-known word of profanity.”* This word, FUCT, had been denied trademark registration because it was determined to have “decidedly negative sexual connotations” and found to be a “a total vulgar” under this Lanham Act section.

The government argued that the trademark registration program doesn't really restrict speech. Individuals and businesses may hold trademark rights in a word or phrase used to identify goods and services in commerce, but that doesn't necessarily mean they need to and have the right to register it. Registering a trademark with the USPTO only provides certain advantages like good evidence of that trademark's validity.

The Supreme Court agrees with Brunetti that no principled reason exists for distinguishing the disparagement ban from the scandalous ban. “When is expressive material ‘immoral’’’? Answering the question, the Supreme Court Justices consulted the dictionary and found that, according “to a standard definition,” a word is immoral when it is “inconsistent with rectitude, purity, or good morals; wicked; or vicious.” The Court then concluded that the prohibition against immoral and scandalous marks is viewpoint-discriminatory because it allows registration of marks that accord with the viewpoint of purity or good morals or righteousness but denies registration to those marks that convey the opposite viewpoint. The Court concluded that a prohibition against the registration of “immoral”

or "scandalous" trademarks cannot stand in light of the Free Speech Clause of the First Amendment. So, moving forward the USPTO will be forced to register just about any mark thrown its way, regardless of content and assuming it is not generic or confusingly similar to an already registered mark.

Mandatory Trademark Declaration of Use under Oath in Argentina

By Luciana Eugenia Noli

June 3rd, 2019 became the effective start date in Argentina for the mandatory sworn declaration of use for trademarks granted five years. This declaration is mandatory for trademarks that have been granted as of January 12th, 2013 and there is a period of one year to submit the declaration. This means between the fifth and the sixth year that a trademark has been granted, a Declaration of Use Under Oath must be submitted.

For those submissions that had to be filed before June 3rd, 2019, there will be additional time provided without being considered out of date. This period will be till January 12th, 2020. Filing the Declaration of Use Under Oath jointly with the proof of payment is now a requisite to renew a trademark.

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In cases that this is not done in the stipulated period, an extra fee must be paid for each year of delay.

Congratulations Sam and Class of 2019!

Last month, Ms. Samantha Aliina Fischer graduated high school with honors ranking 20 out of 775 kids in her class. Sam is the youngest daughter of our main trademark paralegal, Ms. Diane Fischer and we are excited to share that she started a summer internship at our firm last week as she wants to become an attorney someday.