

Examination Guide 1-17

Examination Guidance for Section 2(a)'s Disparagement Provision after *Matal v. Tam* and Examination for Compliance with Section 2(a)'s Scandalousness Provision While Constitutionality Remains in Question **Issued June 26, 2017**

Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), bars registration of marks that consist of or comprise matter which may disparage persons, institutions, beliefs, or national symbols, or bring them into contempt or disrepute (“the disparagement provision”), and marks that consist of or comprise immoral or scandalous matter (“the scandalousness provision”). These provisions were challenged in separate court actions as unconstitutional under the Free Speech Clause of the First Amendment. See *Matal v. Tam*, No. 15-1293 (U.S. Supreme Court on petition for certiorari from *In re Tam*, No. 14-1203 (Federal Circuit) (disparagement provision) and *In re Brunetti*, No. 15-1109 (Federal Circuit) (scandalousness provision). In 2015, the Federal Circuit held that the disparagement provision constitutes viewpoint discrimination and is facially unconstitutional under the First Amendment’s Free Speech Clause. *In re Tam*, 808 F.3d 1321, 1358, 117 USPQ2d 1001, 1025 (Fed. Cir. 2015) (*en banc*), as corrected (Feb. 11, 2016). On June 19, 2017, the Supreme Court of the United States decided *Matal v. Tam*, 582 U.S. ____ (2017), which affirmed the judgment of the Federal Circuit. *Id.* The Federal Circuit has ordered the parties to submit supplemental briefing in *Brunetti* explaining how the constitutionality of the scandalousness provision should be resolved in light of the Supreme Court’s decision in *Tam*.

As explained in Examination Guide 01-16, the USPTO has been suspending action on pending applications involving marks subject to refusal under the disparagement and scandalousness provisions until the *Tam* and *Brunetti* litigations conclude. The USPTO issues this updated guidance to explain how the USPTO will examine applications following the Supreme Court’s decision in *Tam*.

In *Tam* the Supreme Court held that the disparagement provision violates the Free Speech Clause of the First Amendment. Accordingly, that a mark may “disparage . . . or bring . . . into contempt, or disrepute” is no longer a valid ground on which to refuse registration or cancel a registration. The portions of Trademark Manual of Examining Procedure (TMEP) §1203 that relate specifically to examination under the disparagement provision no longer apply. Applications that received an advisory refusal under the disparagement provision and were suspended pursuant to Examination Guide 01-16 will be removed from suspension and examined for any other requirements or refusals. If an application was previously abandoned after being refused registration under the disparagement provision, and is beyond the deadline for filing a petition to revive, a new application may be filed.

Because the constitutionality of the scandalousness provision remains pending before the Federal Circuit in *Brunetti*, the USPTO continues to examine applications for compliance with that provision according to the existing guidance in the TMEP and Examination Guide 01-16. Any suspension of an application based on the scandalousness provision of Section 2(a) will remain in place until the Federal Circuit issues a decision in *Brunetti*, after which the USPTO will re-evaluate the need for further suspension.