Examination Guide 01-16
Examination for Compliance with Section 2(a)'s Scandalousness and Disparagement Provisions While Constitutionality Remains in Question
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Section 2(a) of the Lanham Act, 15 U.S.C. § 2(a), bars registration of marks that consist of or comprise immoral or scandalous matter ("the scandalousness provision"), or matter which may disparage persons, institutions, beliefs, or national symbols, or bring them into contempt or disrepute ("the disparagement provision"). Both the scandalousness and disparagement provisions of Section 2(a) are the subject of active court litigation involving their constitutionality. The outcome of these pending court actions is relevant to the issue of registrability of marks with the USPTO. Consistent with normal USPTO procedures, the USPTO will be suspending action on pending applications involving marks subject to refusal under these provisions in Section 2(a), as discussed below. *See* 37 C.F.R. §2.67; TMEP §§716-716.02.

The constitutionality of the scandalousness provision is an issue that the USPTO expects to be decided by the Federal Circuit in *In re Brunetti* (No. 15-1109). The constitutionality of the disparagement provision is an issue in two cases in the federal courts of appeal: *In re Tam* (No. 14-1203, Federal Circuit), and *Pro-Football v. Blackhorse* (No. 15-1874, Fourth Circuit). The *Pro-Football* appeal remains pending before the U.S. Court of Appeals for the Fourth Circuit. The *Tam* appeal was decided by the U.S. Court of Appeals for the Federal Circuit on December 22, 2015. The Federal Circuit held that the disparagement provision is facially unconstitutional under the First Amendment, abrogating prior circuit precedent that had found the provision constitutional. *In re Tam*, 808 F.3d 1321, 1358, 117 USPQ2d 1001, 1025 (Fed. Cir. 2015) (*en banc*), as corrected (Feb. 11, 2016). The *Tam* decision remains subject to potential Supreme Court review. 28 U.SC. §1254; *see also* Application of Michelle K. Lee to Extend the Time to File a Petition for a Writ of Certiorari, March 9, 2016 (Supreme Court No.15A925).

The USPTO continues to examine applications for compliance with the scandalousness and disparagement provisions in Section 2(a) according to the existing guidance in the Trademark Manual of Examining Procedure § 1203. While the constitutionality of these provisions remains in question and subject to potential Supreme Court review, for any new applications the USPTO will issue only advisory refusals on the grounds that a mark consists of or comprises scandalous, immoral, or disparaging matter under Section 2(a). If a mark's registrability under these provisions in Section 2(a) is the only issue, the examining attorney will identify the reasons for the advisory refusal and suspend action on the application in the first Office action. For all applications, including those initially examined before the Federal Circuit's decision in *Tam*, if the examining attorney made other requirements or refusals in the first Office action, action on the application will be suspended when the application is in condition for final action on those other requirements or refusals. 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. Any suspension of an application based on the disparagement provision of Section 2(a) will remain in place until at least the last of the following occurs: (1) the period to petition for a writ of certiorari (including any extensions) in *Tam* expires without a petition being filed; (2) a petition for certiorari is denied; or (3) certiorari is granted and the U.S. Supreme Court issues a decision.