

Examination Guide 2-18
**Examination Guidance for Compliance with Section 2(a)'s Scandalousness
Provision While Constitutionality Remains in Question during Period to
Petition for Certiorari to U.S. Supreme Court**
Issued May 24, 2018

Section 2(a) of the Lanham Act, 15 U.S.C. §1052(a), bars registration of marks that consist of or comprise immoral or scandalous matter (“the scandalousness provision”). In December 2017, the U.S. Court of Appeals for the Federal Circuit held that the scandalousness provision violates the First Amendment of the Constitution because it impermissibly restricts free speech. *In re Brunetti*, 877 F.3d 1330, 125 USPQ2d 1072 (Fed. Cir. 2017). On April 12, 2018, the court denied the request for a rehearing. *See In re Brunetti*, No. 2015-1109 (Fed. Cir. Apr. 12, 2018) (per curiam). The period to petition for a writ of certiorari in *Brunetti* expires on July 11, 2018, unless extended by the U.S. Supreme Court. *See* Sup. Ct. R. 13.

Consistent with normal procedures and the USPTO’s broad discretion to manage its own docket, the USPTO will continue to examine applications for compliance with the scandalousness provision while the constitutionality of the provision remains subject to potential U.S. Supreme Court review. *See* 37 C.F.R. §2.67; TMEP §§716, 716.02(d). As explained in Examination Guides 01-16 and 01-17, when examining new applications, examining attorneys will issue an advisory refusal on the ground that a mark consists of or comprises scandalous or immoral matter under Section 2(a), in addition to any other examination issues raised in the application. If a mark’s registrability under this provision 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. 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 current or future suspension of an application based on the scandalousness provision of Section 2(a) will remain in place until either: (a) the time for filing a petition for certiorari in *Brunetti* (including any extensions granted) expires, with no petition being filed; or (b) if a petition for certiorari is filed, the later of (1) denial of certiorari or (2) termination of U.S. Supreme Court proceedings in the case. Thereafter, the USPTO will determine whether additional suspension or procedural guidance is needed. If not, examining attorneys will take appropriate action in each case and proceed accordingly.