

MATAL V. TAM—A VICTORY FOR *THE SLANTS*, A TOUCHDOWN FOR THE *REDSKINS*, BUT AN AMBIGUOUS JOURNEY FOR THE FIRST AMENDMENT AND TRADEMARK LAW♦

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ABSTRACT

Since 1946, Section 2(a) of the Lanham Act, the law governing trademarks, prohibited the registration of trademarks deemed “immoral, deceptive, or scandalous;” or those which may “disparage” individuals. This provision was the subject of a challenge by an Asian-American dance-rock band named “The Slants” after the trademark examiner refused to register the mark because it was deemed “disparaging” to Asians. Tam, a member of the group, challenged the decision, primarily on First Amendment grounds, and the Supreme Court, in several opinions which produced a unanimous result, concluded that the provision unconstitutionally barred the registration. What was a major victory for Tam raises a number of issues which will be explored in this article. The first involves the rights of Native Americans to challenge names and logos of sports teams many deem disparaging. Although Tam limits the Section 2(a) option for Native Americans, the article asks whether there are there other ways to challenge such marks. The second issue involves the dissection of the “unanimous” opinion by the Supreme Court, which was really a series of concurrences cobbled together to produce an inconclusive whole. Because of this split, the article concludes that the court missed an opportunity to create a more definitive First Amendment standard and did not resolve the issue of whether there should be room for such a provision for trademarks that are entirely commercial and those which may have extra-commercial social and political significance.

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INTRODUCTION

For much of the last century, product names and logos have not been kind to members of minority groups. Until recently, industries have used disparaging terms and images of various ethnic and racial groups as part of their marketing campaigns, often utilizing societal stereotypes in the pursuit of selling goods. Fictitious creations, such as Aunt Jemima, the Frito Bandito, and Uncle Remus Syrup, were a common presence in the early and mid-20th century.¹ Many other products—including respected brands such as Wheaties,² Jello,³ and

¹ See Nico Long, *41 Mind-Blowing Racist Vintage Ads You Need To See*, THOUGHT CATALOG (Sept. 26, 2013), <http://thoughtcatalog.com/nico-lang/2013/09/41-mind-blowingly-racist-vintage-ads-you-need-to-see/>.

² *Id.* A Wheaties ad from the 1940s has a comic image of five U.S. soldiers in a swamp with a box of Wheaties. One says to the other: "Those Japs are getting smarter – now they are putting

Disney⁴—utilized such negative images as well. The images included depictions of African-Americans, Latinos and Asians. Stereotypical depictions of Native Americans were also prominent in many advertisements.⁵ This pattern continued into this century when Abercrombie & Fitch utilized a much-criticized T-shirt with offensive images of Asians.⁶

Psychological studies noted the potential adverse effects of such imagery and (at least one hopes) most readers and viewers would cringe at such messages today.⁷ However, in the not-too-distant past, these demeaning and caricature-laded creations were socially accepted as advertising and, for that matter, as accepted forms of non-commercial speech and expression as well.

More recently, the use of some traditionally offensive ethnic and racial terms have been utilized for different reasons, such as a form of empowerment.⁸ The word “queer” comes to mind—a heretofore derisive terms for gay person, it has morphed into a term of pride for

out Wheaties as booby traps.”

³ *Id.* An old ad for Jell-O shows two black children, a young boy and even younger girl, delivering Jell-O to a white woman, with the caption, “Mammy sent dis ovah.”

⁴ *Id.* Disney produced a film titled “Savage Sam” about a Native American who sold authentic Indian chief headdresses.

⁵ For example, Native Americans were depicted on a bottle of True American bourbon; a can of “Indian Head Hydraulic Brake Oil;” a box of “Savage Arms” 32-caliber bullets; Argo Corn Starch portrayed an “Indian Maid” as an ear of corn; a 1958 ad for a De Soto station wagon (named after the Spanish conquistador) has “Room for the whole darn tribe!;” children dressed in Native American garb adorn a 1951 advertisement for Post Toasties cereal, which declares “No skipum breakfast now!” See Edward Rothstein, *Americans’ Review: Detailed Portrait of a People*, THE WALL STREET J. (Jan. 17, 2018, 5:47 PM), <https://www.wsj.com/articles/americans-review-detailed-portrait-of-a-people-1516229238>.

⁶ The T-shirt featured caricatures of Asians with slanted eyes and rice-paddy hats and said, “Wong Brothers Laundry Service — Two Wongs Can Make It White.” After a public outcry, the shirts were pulled off of the shelves, and the company issued a public statement: “We are truly and deeply sorry we’ve offended people.” See Kashmir Hill, *More Reservations About Native American Mascots*, ABOVE THE L. (Dec. 9, 2009), <http://abovethelaw.com/2009/12/more-reservations-about-native-american-mascots/>.

⁷ See Geraud Blanks, *Skin in the Game: Providing Redress for American Sports’ Appropriation of Native American Iconography* (Aug. 2016) (unpublished M.A. thesis, University of Wisconsin-Milwaukee)(citing Stephanie A. Fryberg, Hazel Rose Markus, Daphna Oyserman, & Joseph M. Stone, *Of Warrior Chiefs and Indian Princesses: The Psychological Consequences of American Indian Mascots*, 30 BASIC & APPLIED SOCIAL PSYCHOL. 208, 208–18 (2008), available at http://www.indianmascots.com/fryberg--web-psychological_.pdf) (on file with UWM Digital Commons). The article outlines the psychological and sociological reasons for the depiction of Native American names and imagery in sports.

⁸ See Adam D. Galinsky, Kurt Hugenberg, Carla Groom & Galen Bodenhausen, *The Reappropriation of Stigmatizing Labels: Implications for Social Identity*, 5 SAGE PUBLICATIONS 221, 231–34 (Aug. 16, 2013), available at <http://faculty.wcas.northwestern.edu/bodenhausen/reapp.pdf>. “For example, some African Americans have begun to refer to other African Americans using the word ‘nigger.’ . . . They claim that they are ‘cleansing the word of its negative connotations so that racists can no longer use it to hurt blacks’ . . . Similarly, many gay rights organizations use the symbol of the pink triangle, a symbol used in Nazi Germany to identify gays, to promote awareness of discrimination against gays.” *Id.* at 231.

gay men and women.⁹ Far more controversial has been how the “N” word has been utilized by certain (usually younger) African-Americans, despite being strongly condemned by their peers and general society. An argument that has been made in favor of this particular re-appropriation is that “the more a black person uses the ‘N’ word, the less offensive it becomes.” A similar argument regarding “queer” has also been posited, noting that this kind of self-labeling has several potentially positive consequences.¹⁰ The historically negative connotations of the label are challenged by the proud, positive connotations implied by a group’s use of the term as a self-label.¹¹

Although the use of racially and ethnically insensitive language is protected under the free speech clause of the First Amendment, there is a societal interest in avoiding such speech, at least in polite company. Disparaging terms are not utilized in respectable media outlets, business conversations, as well as in academia, as many schools have enacted speech codes that prohibit such language,¹² despite the First Amendment protection of such insensitive speech.¹³

While free speech is not absolute, the contours of its limitations are narrow. National security,¹⁴ speech that is likely to cause immediate violence,¹⁵ obscenity,¹⁶ and (to a limited extent) defamation are

⁹ *Id.*

¹⁰ *Id.* (“Another example would be the emergence in the 1990s of ‘queer’ as a self-label for proud gay men and lesbians, a label that previously had been a deliberate and resented epithet.”)

¹¹ *Id.* (“Where ‘queer’ had connoted undesirable abnormality, by the fact that it is used by the group to refer to itself, it comes to connote pride in the groups’ unique characteristics. Where before it referred to despised distinctiveness, it now refers to celebrated distinctiveness. Reappropriation allows the label’s seemingly stable meaning to be open to negotiation”).

¹² See Conor Friedsdorf, *The Glaring Evidence That Free Speech Is Threatened on Campus*, ATLANTIC (Mar. 4, 2016), <https://www.theatlantic.com/politics/archive/2016/03/the-glaring-evidence-that-free-speech-is-threatened-on-campus/471825/>. The article gives a number of examples of such speech codes. “Missouri law students passed a speech code that *Above the Law* called Orwellian. Amherst students called for a speech code so broad that it would have sanctioned students for making an ‘All Lives Matter’ poster.” *Id.* The article also gives examples of schools which disinvited speakers because of their views. (“At Emory, student activists demanded that student evaluations include a field to report a faculty member’s micro aggressions to help ensure that there are repercussions or sanctions, and that the social network Yik Yak be banished from campus. Activists at Wesleyan trashed their student newspaper and then pushed to get it defunded because they disagreed with an op-ed that criticized Black Lives Matter. Dartmouth University students demanded the expulsion of fraternities that throw parties deemed racist and the[y] forced a student newspaper to change its name.”) *Id.*

¹³ See, e.g., *R. A. V. v. City of St. Paul*, 505 U.S. 377 (1992) (ruling an anti-bias ordinance unconstitutional and reversing a conviction for cross-burning).

¹⁴ See *Schenck v. United States*, 249 U.S. 47 (1919) (speech that would be permissible during times of peace might be prohibited during times of war); *N.Y. Times Co. v. United States*, 403 U.S. 714 (1971) (terminating a restraining order barring a newspaper for publishing classified data about the Vietnam War, thereby rejecting the government’s national security claims).

¹⁵ See *Brandenburg v. Ohio*, 395 U.S. 444, 447 (1969) (“... constitutional guarantees of free speech and free press do not permit a State to forbid or proscribe advocacy of the use of force or of law violation except where such advocacy is directed to inciting or producing imminent lawless action and is likely to incite or produce such action.”).

commonly cited as examples of non-protected speech.¹⁷ In addition, there are exceptions under intellectual property laws as well. Copyright holders can limit dissemination and use by others due to the monopoly status given to them under the law.¹⁸ In addition, the use of a person's name, image, or likeness is restricted under state-based right of publicity laws.¹⁹ However, trademark law had been given a unique exemption, which is the subject of this article. A provision in its governing statute prohibited the registration of trademarks that contained potentially offensive language or symbols involving a particular religion, nation, ethnic group, or belief system that a "substantial composite of the referenced group" perceived as disparaging.²⁰

The Supreme Court recently concluded that this provision violated the First Amendment, and did so unanimously.²¹ The case, *Matal v. Tam*, involved a challenge to the disparagement clause of Section 2(a) of the Lanham Act by members of an Asian-American rock band professionally known as "The Slants." As will be discussed in detail, the purpose of that name was not to demean Asians but to empower them. The case raised several interrelated constitutional and policy issues. One was whether Lanham Act Section 2(a)'s disparagement clause was considered "government speech" and thereby immunized from a First Amendment challenge. Second was, assuming that provision was not government speech (and the First Amendment free speech standards applied),²² whether the disparagement clause was speech that served to discriminate based on viewpoint so that a less disparaging mark would be registered as opposed to a more insidious mark.²³ A third issue was

¹⁶ See *Miller v. California*, 413 U.S. 15, 24 (1973) (citations omitted) ("The basic guidelines for the trier of fact must be: (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.").

¹⁷ Traditionally, defamation was not considered protected speech, but it was granted a qualified immunity under *N. Y. Times v. Sullivan*. See *N.Y. Times Co. v. Sullivan*, 376 U.S. 254 (1964) (public officials must prove actual malice).

¹⁸ See 17 U.S.C. § 106 (2006). Copyright holders have the right to (or right not so) reproduce the work, prepare derivative works, distribute copies by sale or other transfer, perform or display the work or record the work. *Id.*; see e.g., *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (1985) (rejecting the expansion of the fair use concept to create a public use exception to copyright).

¹⁹ See, e.g., CAL. CIV. CODE §§ 3344–3344.1 (West 2009); FLA. STAT. ANN. § 540.08 (West 2009); N.Y. CIV. RIGHTS LAW §§ 50–51 (West 2009); TENN. CODE ANN. §§ 47-25-1102 to -1107 (West 2009). See also Mark Conrad, *A New First Amendment Goal Line Defense – Stopping the Right of Publicity Offense*, 40 N. OHIO L. REV. 743 (2014).

²⁰ See 15 U.S.C. § 1052(a); U.S. PATENT & TRADEMARK OFFICE, TMEP § 1203.03(b) (Oct. 2017) (discussed *infra* Part II).

²¹ *Matal v. Tam*, 137 S. Ct. 1744 (2017).

²² *Id.*

²³ *Id.*

whether the restriction was based on the assumption that a trademark constituted commercial speech (thereby subject to a somewhat lower standard of First Amendment protection) or did it extend to speech that may not be commercial (and thereby subject to a stricter standard of First Amendment analysis).²⁴

While overly disparaging commercial depictions (like the examples at the beginning of this article) are far less common today, Native American images were still trademarked by 450 companies as recently as 2010.²⁵ In professional and college sports, Native American names and logos have been used for generations as team names and as their design logos. While many college teams have changed such names and altered or ended such logos, in part due to public pressure and NCAA policies,²⁶ there are professional and college sports teams which remain committed to retaining such brand names and designs.²⁷

In addition to the constitutional issues, Simon Tam's victory in the Supreme Court presents a societal question: does the invalidation of the disparagement clause open the doors to disparaging and insulting terms, phrases, or illustrations to be trademarked? With team names like the

²⁴ *Id.*

²⁵ Chris Wilson, *The 450 Companies That Still Have Indian Mascots*, TIME (June 18, 2014), <http://time.com/2894357/reds-kins-trademark-indian-interactive/> (As of 2010, "[t]he United States Patent and Trademark Office categorized logos by the images they contain. Those records included over 600 active trademarks for insignia that feature Native American men and women, registered to 450 different companies."). To be fair, many were registered to Native American groups.

²⁶ See *NCAA bans Indian mascots during postseason*, USA TODAY (Aug. 8, 2006), http://usatoday30.usatoday.com/sports/college/2005-08-05-indian-mascots-ruling_x.

²⁷ Many colleges and universities have traditionally utilized Native American names for their sports teams and have secured trademark protection. In 2013, one report stated that there were over 2100 primary school, high school, college, semi-pro, and professional teams utilizing a Native American name or mascot. See Hayley Manguia, *The 2,128 Native American Mascots People Aren't Talking About*, FIVETHIRTYEIGHT (Sept. 5, 2014), <https://fivethirtyeight.com/features/the-2128-native-american-mascots-people-arent-talking-about/>. However, many schools, prodded by the National Collegiate Athletic Association ("NCAA"), have eliminated the use of such symbols. See *List of schools that changed Native American nicknames*, USA TODAY (Sept. 24, 2013, 11:52 AM), <https://www.usatoday.com/story/sports/2013/09/12/native-american-mascot-changes-ncaa/2804337/> (includes Stanford University: Indians to Cardinal (1972); Dartmouth: Indians to Big Green (1974); Siena: Indians to Saints (1988); Eastern Michigan: Hurons to Eagles (1991); St. John's (N.Y.): Redman to Red Storm (1994); Marquette: Warriors to Golden Eagles (1994); Miami (Ohio): Redskins to RedHawks (1997); Seattle University: Chieftains to Redhawks (2000); Louisiana-Monroe: Indians to Warhawks 2006); Arkansas State: Indians to Red Wolves (2008); North Dakota: formerly dropped Fighting Sioux in 2012 with no current nickname). Others have partially eliminated the name or logo, such as Illinois, which removed Chief Illiniwek as the official mascot in 2007, but athletics teams are still called Fighting Illini. *Id.* Bradley and Alcorn State "stopped using Native American mascots but have retained their Braves nickname[s]." *Id.* William and Mary adjusted the team's "Tribe logo to remove feathers to comply with NCAA, but [a]thletics teams are still called Tribe, [as of 2007]." *Id.* However, a few schools successfully appealed to the NCAA to keep their names on the grounds that they were not "hostile or offensive." *Id.* (citation omitted). Examples are Utah (Utes), Central Michigan (Chippewas), Florida State (Seminoles), and Mississippi College (Choctaws). *Id.*

Washington Redskins and the Cleveland Indians and the depiction of such images as the Cleveland team's venerable logo, "Chief Wahoo," free from potential challenge under the disparagement clause, do those trademark owners (and their respective leagues) have carte blanche on their use and dissemination? Could it mark a return to the days of offensive ethnic or religious portrayals for products? At the time of this writing, it is too early to tell, but, as this article explores later, it is safe to say that this question is now based on business ethics and societal norms, rather than the law. The ruling seems clear: *Matal v. Tam* eliminates an important, if not crucial avenue for those aggrieved to challenge the offensive trademarks.

Many lawyers and legal scholars lauded the *Tam* ruling as a justified expansion of First Amendment jurisprudence.²⁸ In fact, Section 2(a) had a great number of detractors over the years.²⁹ There are victorious parties: certainly, Tam's rock band, which, after a long legal battle, registered "The Slants" as a trademark.³⁰ The Washington Redskins can claim victory, as a related case challenging their trademarks was dropped after the *Tam* ruling.³¹ However, as will be posited in this article, *Matal v. Tam* is a modest victory doctrinally, despite some contrary opinions.³²

This article will discuss what the court did and did not do in the *Tam* ruling. The unanimous opinion was that in name only—there were three different opinions that fused into a wobbly whole. If the court spoke with one voice, and a stronger voice, the ruling would be far more

²⁸ See articles by lawyers and legal scholars cited *infra* notes 143–197.

²⁹ Numerous scholarly articles have argued that Section 2(a)'s disparagement bar is unconstitutional. See Theodore H. Davis, Jr., *Registration of Scandalous, Immoral, and Disparaging Matter Under Section 2(a) of the Lanham Act: Can One Man's Vulgarity be Another's Registered Trademark?* 54 OHIO ST. L.J. 331, 364 (1993); Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(a) Trademark Law after Lawrence v. Texas*, 9 MARQ. INTELL. PROP. L. REV. 187, 235–36 (2005); Ron Phillips, *A Case for Scandal and Immorality: Proposing Thin Protection of Controversial Trademarks*, 17 U. BALT. INTELL. PROP. L.J. 55, 68 (2008); Kristian D. Stout, *Terrifying Trademarks and a Scandalous Disregard for the First Amendment: Section 2(a)'s Unconstitutional Prohibition on Scandalous, Immoral, and Disparaging Trademarks*, 25 ALB. L.J. SCI. & TECH. 213 (2015). For more detail, see Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, 92 NOTRE DAME L. REV. 381, 383 n.6 (2015).

³⁰ THE SLANTS, Registration No. 5332283.

³¹ See Nicole Narea, *Native Americans Drop Redskins Suit After High Court Ruling*, LAW360 (June 30, 2017), <https://www.law360.com/articles/940256/native-americans-drop-redskins-suit-after-high-court-ruling> (subscription required); see also Ian Shapira & Ann E. Marimow, *Washington Redskins win trademark fight over the team's name*, WASH. POST (June 29, 2017), https://www.washingtonpost.com/local/public-safety/2017/06/29/a26f52f0-5cf6-11e7-9fc6-c7ef4bc58d13_story.html?utm_term=.0945fc7db1c4.

³² See *Victory for The Slants*, WALL STREET J. (June 20, 2017), <https://www.wsj.com/articles/victory-for-the-slants-1497914141> ("The effort to 'cleanse' commercial speech of any offense is also a nonstarter since there are many kinds of merchandise that 'disparages prominent figures or groups and the line between commercial and non-commercial speech is not always clear.' Think anti-Trump T-shirts.")

important for trademark law and for commercial speech generally. In addition, it failed to address the precise contours of where trademark rights (and other intellectual property rights) take precedence over free speech. It also did not address the fact that a portion of Section 2(a) (which bars religiously offensive as “scandalous or immoral”) still stands (although a federal appeals court subsequently invalidated the rest of the statute a few months later).³³ And, finally, (with the exception of a short opinion by Justice Thomas) it does not address whether trademark rights are inherently commercial speech (subject to a lower standard of review) or non-commercial. In short, *Tam* could have gone much farther. As will be discussed, the most fascinating result may not be the trademark law issues, but what was *not* discussed—the very nature of commercial speech rights in a gradually shifting First Amendment landscape.

The article will (1) discuss the background of the case and lower court opinions; (2) describe the band and its motivations for choosing the term “Slants;” (3) analyze the Supreme Court opinions (as there are three); (4) outline the history and prior rulings in the Redskins litigation; (5) discuss the effect of *Tam* on owners of Native American brand names that may be disparaging; and what options, if any, they may have to challenge such registrations in the future; and (6) delineate how it does not resolve an underlying tension between the First Amendment and intellectual property law.

A. Lanham Act Section 2(a)

The Lanham Act, enacted in 1946, governs federal trademark law.³⁴ A trademark is defined as any word, name, symbol, or device, or any combination thereof (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods. . .³⁵ The main purpose of trademark protection is avoiding consumer confusion.³⁶ Yet trademark rules also serve a commercial goal: creating a brand identity by use of a “distinctive” term or design. Scholars have noted that trademarks result in a more competitive

³³ See *In re Brunetti*, No. 2015-1109, 2017 U.S. App. LEXIS 25336 (Fed. Circ. Dec. 15, 2017).

³⁴ Lanham Act, 60 Stat. 427 (1946) (current version at 15 U.S.C. §1051 (2012)).

³⁵ 15 U.S.C. §1127 (2012).

³⁶ See 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2:2 (5th ed. 2017). “In the author’s opinion, to select as paramount either protection of the trademark property or protection of consumers would be to oversimplify the dual goals of trademark law, both historical and modern. Trademark law serves to protect consumers from deception and confusion over trademarks as well as to protect the plaintiff’s infringed trademark as property. Both Congress and the Supreme Court in modern times have stressed that trademark has these two goals.”

market, and in return protect the owner of the mark from infringement or dilution.³⁷ On another level, as we will see, the proposed mark can take on a trans-commercial element with mixed commercial and an expressive, non-commercial use. For example, the mark can serve as social commentary, coupled with the sale of a product—a point that provides an expansive view of “use in commerce” and, therefore, questions whether all trademarks are commercial speech, which will be discussed later in this article.

Because the United States has a “first to use” rather than a “first to file” system of trademark registration, registration is not a pre-requisite to use. One can use an unregistered mark under “common law” rights and still have certain enforcement rights, although not all of the rights one would have if the mark was registered.³⁸ Without such trademark protection, the owner can still use the term or design, no matter how disparaging or offensive it may be.³⁹

Section 2(a) of the Lanham Act comprised two distinct components. It denied trademark protection to any mark that “consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”⁴⁰ *Tam* involved the constitutionality of second portion of this statute, known as the “disparagement clause.”⁴¹

There are public policy reasons for the Section 2(a) restrictions. One is that the government should not “favor or approve” of the use of

³⁷ See Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 787 (2004); see also Sari Sharoni, *The Mark of a Culture: The Efficacy and Propriety of Using Trademark Law to Deter Cultural Appropriation*, 26 FED. CIR. B.J. 407 (2016).

³⁸ See 2 MCCARTHY, *supra* note 36, §16:1.50 (“Most civil law nations follow the rule that ownership and priority of a trademark go to the party who was first to file an application or obtain a registration. But in the United States, the rule of priority is that ownership and priority of a trademark go to the party who was first-to-use.”).

³⁹ See *id.* §16.18 (“Cancellation of a registration does not mean loss of common law rights in a trademark.”).

⁴⁰ See 15 U.S.C. § 1052(a) (2012). *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1738 (T.T.A.B. 1999) noted the differences in proof between the two sections. “While Section 2(a) precludes registration of matter that is scandalous, it does not preclude registration of matter that is disparaging. It precludes registration of matter that *may be* (emphasis added) disparaging. There is no legislative history or precedent that specifically addresses this distinction between the two statutory provisions. . . . Thus, we believe the use of the term ‘may’ is necessary in connection with ‘disparage’ in Section 2(a) to avoid an interpretation of this statutory provision that would require a showing of intent to disparage. Such a showing would be extremely difficult in all except the most egregious cases. Rather, this provision, as written, shifts the focus to whether the matter may be perceived as disparaging.” *Id.*

⁴¹ *Matal v. Tam*, 137 S. Ct. 1744, 1748 (2017) (citing 15 U.S.C. § 1052(a) (2012)). The first section, involving the ban in “immoral” or “scandalous matter” may be subject to constitutional challenge, but the Supreme Court only agreed to hear arguments on the disparagement clause.

such marks and should not “squander” its resources protecting them.⁴² In addition, there is a government interest to protect the sensitivities of those who may be offended by such marks,⁴³ thereby discouraging the use of terms that, for example, could be offensive to the majority of people in certain groups.⁴⁴

The scope and definition of the terms “scandalous” or “disparaging” are not found in Section 2(a) or its predecessor statute, or in the legislative history of the Lanham Act, giving considerable discretion to the U.S. Patent and Trademark Office (“USPTO”) and the courts to come up with appropriate standards.⁴⁵ The USPTO has denied a number of registrations on the basis that they carry words or messages that disparage a religion, nation, or ethnic group.⁴⁶ Court determinations involving Section 2(a) have not been many and, until recently, have not involved a constitutional challenge. This is somewhat surprising, given the inherently vague nature of the statute and the potential for open-ended and inconsistent interpretation.

B. *The Band*

Tam is an unusual trademark case not only because of the name involved, but also for the reasons the band chose the name. A rock band composed of Asian musicians called itself “The Slants,” choosing that name after a conversation with some of Tam’s non-Asian friends.⁴⁷ The

⁴² See Megan M. Carpenter & Kathryn T. Murphy, *Calling Bullshit on the Lanham Act: The 2 (a) Bar for Immoral, Scandalous, and Disparaging Marks*, 49 U. LOUISVILLE L. REV. 365, 468 (2010).

⁴³ See *id.* at (citing Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Marks*, 83 TRADEMARK REP. 661, 788 (1993); see also *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981) (affirming the decision to register a mark that involved a nude man and woman embracing and apparently exposing male genitalia).

⁴⁴ Examples include the terms “nigger” (offensive to African-Americans), “spic” (offensive to Latinos or Hispanics), “kike” or “yid” (offensive to Jews), “wops” (offensive to Italians or Italian-Americans), “mic” (offensive to Irish or Irish-Americans), “pollack” (offensive to people from Poland or Polish-Americans), “chink” (offensive to Chinese or Chinese-Americans), “jap” (offensive to Japanese or Japanese-Americans) and “redskin” (offensive to Native Americans). For more examples, see *Offensive words for people according to nationality or ethnicity*, MACMILLAN DICTIONARY, <http://www.macmillandictionary.com/us/thesaurus-category/american/offensive-words-for-people-according-to-nationality-or-ethnicity> (last visited Nov. 12, 2017).

⁴⁵ See U.S. Patent & Trademark Office, TMEP § 1203 Refusal on Basis of Immoral or Scandalous Matter; Deceptive Matter; Matter which May Disparage, Falsely Suggest a Connection, or Bring into Contempt or Disrepute (Oct. 2016).

⁴⁶ For example, the USPTO has canceled registration for the Washington Redskins and for such marks as “STOP THE ISLAMISATION OF AMERICA, THE CHRISTIAN PROSTITUTE, AMISHHOMO, MORMON WHISKEY . . . HEEB, [and] . . . MARRIAGE IS FOR FAGS. . . .”. See Eugene Volokh, *Supreme Court will hear ‘Slants’ trademark case, which is directly relevant to the Redskins controversy*, WASH. POST (Sept. 29, 2016), https://www.washingtonpost.com/news/volokh-conspiracy/wp/2016/09/29/supreme-court-will-hear-slants-trademark-case-which-is-directly-relevant-to-the-redskins-controversy/?utm_term=.4fad0ab483d8.

⁴⁷ See *Episode 13: They Call Us The Slants*, THEY CALL US BRUCE (June 24, 2017),

musicians wished to do so not only for the commercial branding of the proposed mark, but also for a non-commercial, political reason. As the court stated, Simon Tam, one of the members of the band, chose this moniker in order to “reclaim” and “take ownership” of stereotypes about people of Asian ethnicity.⁴⁸ In an online interview I had with Simon Tam, he further stated: “Prior to making headlines about our journey at the Supreme Court, our work has almost always involved working with issues of marginalized groups. Our work around art and activism will not change; we’ll always continue fighting for causes that we champion.”⁴⁹ In a print interview, he added:

I was thinking it could also refer to our slant on life or our perspective on what it’s like to be people of color while at the same time re-appropriating this outdated and obscure slur that people have long used against my community. It’s something that Asian-American activists have been doing for decades, so it as to honor their legacy and work.⁵⁰

Mr. Tam related his personal feelings about being the victim of racism as a child and how he once told his father of his shame of being Asian.⁵¹ The group draws inspiration for its lyrics from childhood

<http://blog.angryasianman.com/2017/06/they-call-us-bruce-episode-13-call-us.html>. Simon Tam wanted to create a band that was a ‘bold portrayal’ of Asian culture. In 2007, he first set up the band. The band played 80s dance-pop music from an Asian-American perspective. They first played in Asian music festivals and anime conventions. The band wanted to highlight issues affecting the Asian-American community, such as racism and prejudice. Tam said he had the idea for the name before he set up the band. He asked some white friends what they thought all Asians have in common and the response was “slanted eyes.” He said that this would start a conversation on the issues of identity. As he said, “it was punk-rock and kick-ass.” It was a flip of the script on identity. See also Kory Grow, *Inside Asian-American Group the Slants’ Supreme Court Free-Speech Win*, ROLLING STONE (June 20, 2017), <http://www.rollingstone.com/music/news/inside-asian-american-band-the-slants-scotus-win-w488615> (discussing the choice of band name, Tam “‘started asking, ‘What’s something you think all Asians have in common? . . . They would immediately say ‘slanted eyes.’ I thought, ‘That’s interesting because it’s not true.’ It’s not a feature that’s exclusive to Asians and certainly not all Asians have slanted eyes.’”).

⁴⁸ See *Matal v. Tam*, 137 S. Ct. 1744, 1754 (2017) (citing *In re Tam*, 808 F. 3d 1321, 1331 (Fed. Cir. 2015) (en banc)). The court misidentified Tam as the “lead singer” when in fact he was not. He plays bass guitar for the group. See Grow, *supra* note 47.

⁴⁹ E-mail from Simon Tam, lead singer of The Slants, to Mark Conrad, Assoc. Prof. of Law and Ethics, Gabelli School of Business, Fordham University (July 7, 2017, 07:10 PM EST) (on file with author). Specifically, Tam stated, “we helped rescue escaping refugees from North Korea, donated 100% of the profits from our second album to cancer research around disparate rates of cancer faces by Asian American women, toured to raise money for tsunami relief efforts post-Fukushima, led workshops on diversity and inclusion across North America, helped increase voter engagement for communities of color, highlighted the struggles of the Black Lives Matter movement on stage (and in song), raised over \$1 million for charities, helped with cultural awareness in the federal prison as well as armed forces of the United States, helped on an anti-bullying campaign with President Obama, and more.”

⁵⁰ See Grow, *supra* note 47.

⁵¹ See Simon Tam, *The Slants on the Power of Repurposing a Slur*, N.Y. TIMES (June 23, 2017), <https://www.nytimes.com/2017/06/23/opinion/the-power-of-repurposing-a-slur.html?ref=opinion>

slangs and nursery rhymes and has given its albums names such as *The Yellow Album* and *Slanted Eyes, Slanted Hearts*.⁵² To further the point, Mr. Tam, in an opinion piece published in the *N. Y. Times* after the ruling, considered the name as a form of repurposing a slur.⁵³ He said:

[t]he idea of reappropriation isn't new. The process of turning negative words, symbols or ideas into positive parts of our own identity can involve repurposing a racial epithet or taking on a stereotype for sociopolitical empowerment. But reappropriation can be confusing. Sometimes people can't figure out the nuances of why something is or isn't offensive — government bureaucrats in particular.⁵⁴

The Slants is not the only rock band that has picked names that can be perceived as “disparaging.” Other bands have named themselves with terms such as “The Slits,” “The Queers,” “Queen,” “Pansy Division,” N.W.A. (Niggaz Wit Attitudes),” and “The Hillbilly Hellcats.”⁵⁵

Mr. Tam sought trademark registration for the name “Slants”⁵⁶

(“My first real lesson on the power of language was at the age of 11. On the basketball courts at school in San Diego, I was tormented by other students. They'd throw balls, punches, rocks and insults, while yelling ‘gook’ and ‘Jap.’ One day, I had enough. I threw back, ‘I’m a chink, get it right.’ Stunned, they didn’t know what to do. Confused, they stopped.”).

⁵² See Simon Tam, *Statement on Recent SCOTUS Ruling*, THE SLANTS: NEWS (June 19, 2017), <http://www.theslants.com/statement-on-recent-scotus-ruling/>. The political and social basis for utilization of the name Slants is evident. “When I started this band, it was about creating a bold portrayal of Asian American culture. The establishment of an Asian American band was a political act in of itself, even though we never considered ourselves as a political group. However, as we continued writing music about our experiences, we realized that activism would be integrated into our art as well. I’m proud our band members have helped raise over \$1 million for issues affecting Asian Americans, that we’ve worked with dozens of social justice organizations, and that we could humanize important issues around identity and speech in new and nuanced ways. So we became part art and part activism.” *Id.*

⁵³ See Tam, *supra* note 51.

⁵⁴ *Id.* There were actually two trademark filings in the *Tam* case. The second was an “ethnic neutral” application. On that second one, there was nothing ethnic or Asian-identifiable about it. The examining attorney simply copied and pasted his response from the first application. The courts never addressed this more procedural argument; instead, it addressed the constitutional arguments head-on. See *Episode 13: They Call Us The Slants*, *supra* note 47 (explaining how Tam’s counsel attempted to change tactics in filing the Slants trademark with the USPTO).

⁵⁵ See Brief of the Cato Institute et al. as Amici Curiae Supporting Respondent, *Matal v. Tam*, 137 S. Ct. 1744 (2016) (No. 15-1293). Other bands have named themselves with terms such as “The Slits,” “The Queers,” “Queen,” “Pansy Division,” N.W.A. (Niggaz Wit Attitudes),” and “The Hillbilly Hellcats.” See RANDALL KENNEDY, *NIGGER: THE STRANGE CAREER OF A TROUBLESOME WORD* (2002). Heretofore, disparaging terms have also been used in books and movies, such as the following listed in MICHAEL THOMAS FORD, *THAT’S MR. FAGGOT TO YOU: FURTHER TRIALS FROM MY QUEER LIFE* (1999); MICHAEL WARNER, *THE TROUBLE WITH NORMAL: SEX, POLITICS AND THE ETHICS OF QUEER LIFE* (1999); EVE ENSLER, *THE VAGINA MONOLOGUES* (2001); INGA MUSCIO, *CUNT: A DECLARATION OF INDEPENDENCE* (1998); ELIZABETH WURTZEL, *BITCH: IN PRAISE OF DIFFICULT WOMEN* (1998); JIM GOAD, *THE REDNECK MANIFESTO* (1997); DYKE LIFE: *FROM GROWING UP TO GROWING OLD, A CELEBRATION OF THE LESBIAN EXPERIENCE* (Karla Jay, ed. 1996); and JONATHAN EIG, *THIS WOMAN WANTS YOU TO CALL HER BASTARD, OFFSPRING* (2000).

⁵⁶ See generally *In re Tam*, 785 F.3d 567 (Fed. Cir. 2015). This case involved a second attempt to

because the band achieved a level of success, and other bands existed with the same name, resulting in potential public confusion. However, the application was rejected by the examiner for the USPTO, concluding that the term was offensive and “disparaging” because the term has been used as a reference to the “slanty” eyes of many Asian people, “bring[ing] them into contempt or disrepute persons, institutions, beliefs or national symbols under . . . Section 2(a).”⁵⁷ On appeal, the Trademark Trial and Appeal Board (“TTAB”) affirmed, based on a “dictionary definition” of the term and the effect of the term on a large number of people with an Asian background.⁵⁸ In so ruling, the Board applied a two-part test to determine “disparagement,” which involved researching dictionary definitions, coupled with the relationship of the mark and how it is used.⁵⁹ If, based on that standard, the meaning is found to refer to identifiable persons, institutions, beliefs, or national symbols and that meaning may be disparaging to a “substantial composite” of the referenced group, it would be denied registration.⁶⁰

In so concluding, the TTAB rejected the argument that the term was used as a term of empowerment by the musicians, but rather noted that the public perception of the meaning of “THE SLANTS,” as used in connection with applicant’s services, shows that meaning to be a derogatory reference to people of Asian descent.⁶¹ Mr. Tam, in his piece in the *N. Y. Times*, added his own critique to this ruling.⁶² He noted that he “supplied thousands of pages of evidence, including letters of support from prominent community leaders and organizations,

register the mark. “In 2010, Mr. Tam filed Application No. 77/952,263 seeking to register the mark . . . for ‘Entertainment, namely, live performances by a musical band.’” After abandoning the application, he attempted to register a second application, application No. 85/472,044, “seeking to register the mark THE SLANTS for essentially identical services as in the ‘263 application. In the ‘044 application, Mr. Tam claims use of the mark since 2006.’”

⁵⁷ See *In re Simon Shiao Tam*, 108 U.S.P.Q.2d (BNA) 1395, 1306 (T.T.A.B. 2013).

⁵⁸ *Id.* at 1308–9 (citing *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 1217 (T.T.A.B. 2010)); see also *Pro-Football, Inc. v. Harjo*, 284 F.Supp.2d 96, 124 (D.D.C. 2003).

⁵⁹ See *In re Simon Shiao Tam*, 108 U.S.P.Q.2d (BNA) 1395, 1309 (T.T.A.B. 2013).

⁶⁰ See *In re Tam*, 785 F.3d 567, 569 (2015) (citing *In re Geller*, 751 F.3d 1355, 1358 (2014)) (the precise test was: “(1) what is 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 in connection with the goods or services; and (2) if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group”); see also U.S. PATENT & TRADEMARK OFFICE, TMEP § 1203.03(b) (Oct. 2017).

⁶¹ See *In re Tam*, 785 F.3d at 571. (The panel cited some examples to bolster its claim including this one that involved the group. In 2010, two local Oregon-based Asian organizations, pulled support from the Slants, citing their offensive name. One band member was initially slated to give the keynote address at the Asian American Youth Leadership Conference in Portland, but was pulled after some conference supporters and attendees felt the name of the band was offensive and racist.)

⁶² Tam, *supra* note 49.

independent national surveys that showed that over 90 percent of Asian-Americans supported our use of the name. . .”⁶³ Tam added:

The battles about hate speech shouldn’t be waged at the Trademark Office, decided by those who have no connections to our communities. . . . Those rights should not hinge on the hunch of a government employee armed with wiki-joke websites [referring to the dictionary definitions used by the TTAB in its opinion]. It’s suppression of speech in the most absurd manner.⁶⁴

Not surprisingly, Mr. Tam challenged that prohibition in court on First Amendment grounds.⁶⁵

C. Case Law Involving the Disparagement Clause

The disparagement clause as we know it today dates from 1946 as part of the original Lanham Act.⁶⁶ While only the disparagement clause of Section 2(a) was challenged in *Tam*, the first portion of the provision, which bars registration of marks that are deemed “immoral and scandalous” portion, has also been subject to litigation.⁶⁷

Probably the most significant case prior to *Tam* is *In re McGinley*,⁶⁸ a 1981 ruling that may have been the first to address a First Amendment challenge to Section 2(a). In that case, the USPTO examiner rejected an application to register a mark comprising a photograph of a nude man and woman kissing and embracing in a manner appearing to expose the male genitalia. It was intended to be used in a “Newsletter Devoted to Social and Interpersonal Relationship Topics” and “Social Club Services.”⁶⁹ Although the first portion of the

⁶³ See Simon Tam, *The Slants on the Power of Repurposing a Slur*, N.Y. TIMES: OPINION (June 23, 2017), https://www.nytimes.com/2017/06/23/opinion/the-power-of-repurposing-a-slur.html?_r=1; See also Tam, *supra* note 49. (Tam added “Yet ‘slant’ is an everyday term — one that has been registered as a trademark many times, primarily by white people. After we won our case in a federal court, the Trademark Office asked the Supreme Court to review the case. That very same week, the office granted another new registration for “slant” to a company that makes industrial coils. I may be the only person denied a registration for “slant” because it was deemed offensive to Asian-Americans.”).

⁶⁴ See Simon Tam, *The Slants on the Power of Repurposing a Slur*, N.Y. TIMES: OPINION (June 23, 2017), https://www.nytimes.com/2017/06/23/opinion/the-power-of-repurposing-a-slur.html?_r=1.

⁶⁵ *Matal v. Tam*, 137 S. Ct. 1744, 1747 (2017).

⁶⁶ See Lanham Act, 60 Stat. 427 (1946) (current version at 15 U.S.C. §1051 (2012)). The provision barring registration based on disparagement first appeared in the Lanham Act in 1946. It should be noted that a similar clause was part of prior trademark laws. See, e.g., Trademark Act of 1905, 33 Stat. 724 (1905).

⁶⁷ See Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661 (1993), for more background on marks rejected based on the “immoral and scandalous” portion of section 2(a).

⁶⁸ *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981).

⁶⁹ *Id.* at 482. (The court noted that “[t]he evidence shows that the newsletter has to do with discussions of sexual topics such as bisexuality, homosexuality, masturbation, and fornication; that the services include sponsoring and arranging parties for “swinging,” which appears to be a

provision, the “immoral and scandalous” portion, as opposed to the disparagement section, was the subject of the case, the rationale was similar. The petitioner appealed to the Court of Customs and Patent Appeals,⁷⁰ which made short shrift of the First Amendment claim, relying on the fact that the illustration could still be used whether registered or not.⁷¹ This result was very much in keeping with the approach of courts in earlier years.⁷² It dovetailed a philosophy used in speech regulation cases during the middle of the last century, justifying restrictions on certain kinds and delivery of speech based on public policy grounds.⁷³

Also, the court in *McGinley* rejected claims that the lack of definitions for the terms “immoral,” “scandalous,” and “disparaging” was unconstitutionally vague.⁷⁴ Although not discussed by the *McGinley* court, it can be argued that intellectual property rights are inherently restrictive on free speech, since the owner can restrict its dissemination or can seek licensing for its use.⁷⁵ Many have criticized

form of group sex.” The USPTO, in so deciding, concluded that “appellant’s services involve various ‘mini-affairs’ between two unmarried people; sometimes two or more unmarried people” and therefore “immoral and scandalous.”)

⁷⁰ This was a court which had jurisdiction over trademark appeals before it was abolished in 1982, and jurisdiction transferred to the Federal Circuit. *See* Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25 (1982).

⁷¹ *McGinley*, 660 F.2d at 484 (The court stated: “[T]he PTO’s refusal to register appellant’s mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant’s First Amendment rights would not be abridged by the refusal to register his mark.”). In fact, the court spent more time discussing Fifth Amendment due process, addressing the argument that “immoral and scandalous” was void for vagueness—it concluded that it was not. *Id.* at 485–87.

⁷² *See, e.g., In re Riverbank Canning Corp.*, 95 F.2d 327 (C.C.P.A. 1938) (The court appeals board denied registration to the mark “Madonna” for wines as “scandalous” under the Trademark Act of 1905. The “immoral and scandalous” rationale became part of the analysis involving marks in the undergarment industry.). *See, e.g., In re Runsdorf*, 171 U.S.P.Q. (BNA) 443, 443 (T.T.A.B. 1971) (denied registration of the mark BUBBY TRAP for brassieres, as “offensive to a segment of the public sense of propriety”); Theodore H. Davis, Jr., *Registration of Scandalous, Immoral, and Disparaging Matter Under Section 2(a) of the Lanham Act: Can One Man’s Vulgarity Be Another’s Registered Trademark?*, 54 OHIO ST. L.J. 331, 350–51 (1993) (citing *Ex parte Martha Maid Mfg. Co.*, 37 U.S.P.Q. 156 Dec. Comm’r Pat., 1938 (the mark QUEEN MARY was deemed to be impermissibly scandalous when applied to women’s underwear)).

⁷³ In the areas of broadcast regulation, the courts adopted a lower degree of First Amendment protection because the broadcast spectrum was inherently “scarce.” *See* *Red Lion Broad. Co. v. FCC*, 395 U.S. 367, 391, 394 (1969). In a rough analogy to this case, the Supreme Court in *FCC v. Pacifica Found.*, 438 U.S. 726, 738 (1978), justified restrictions for “indecent broadcasts.”

⁷⁴ For more discussion as to this point, see Davis, *supra* note 72.

⁷⁵ *See, e.g.*, 17 U.S.C. § 106 (2012) (providing for exclusive rights in copyrighted works). In addition, what has become known as the “right of publicity” restricts the use of one’s name and likeness without permission. *See* *Comedy III Prod. v. Saderup*, 106 Cal.Rptr.2d 126 25 Cal.4th 387, 21 P.3d 797 (2001) (“society may recognize, as the Legislature has done here, that a celebrity’s heirs and assigns have a legitimate protectable interest in exploiting the value to be obtained from merchandising the celebrity’s image, whether that interest be conceived as a kind of natural property right or as an incentive for encouraging creative work.”) In *McGinley*, the court has never articulated a precise constitutional standard. *Cf. Zaccini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977) (the only Supreme Court case discussing this issue).

McGinley as ignoring vital First Amendment issues and, because of greater sympathy of commercial speech rights in recent years, it has been argued that it was time for reconsideration.⁷⁶ More recently, for instance, the TTAB refused registration to KHORAN wine.⁷⁷ Other cancellations (under the immoral or scandalous provision) have included religious and political marks.⁷⁸

Even less frequent have been challenges based on the second portion of Section 2(a), the disparagement clause. One case that comes reasonably close to *Tam* is *Japanese-American Citizens League v. Takada*, where a New York lower court rejected the contention made by the plaintiffs therein that “JAP” is derogatory or would subject Americans of Japanese ancestry to contempt, ridicule, or scandal.⁷⁹ The TTAB also cited the disparagement clause in refusing registration to “Stop the Islamisation of America.”⁸⁰ However, the most significant case involved the cancellation of the Washington Redskins football team trademark registration,⁸¹ which will be discussed later in detail.⁸²

Nevertheless, *Zaccini* has been criticized for its lack of specificity. See Edward Keuster, *The Conflict Between an Athlete’s Right of Publicity and the First Amendment*, 15 J. MARSHALL REV. OF INTEL. PROP. L. 117, 128. (2015). (“[T]he Supreme Court declined the opportunity to create a standardized test for all jurisdictions to use, which has forced lower courts to speculate and adopt differing tests . . . this debate would be simpler if the Supreme Court in *Zacchini* had provided a clear test for balancing the right of publicity with freedom of expression.”).

⁷⁶ See *In re Tam*, 808 F.3d 1321, 1331 (Fed. Cir. 2015).

⁷⁷ See *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215 (T.T.A.B. 2010). In a similar vein, see also *In re Heeb Media*, 89 U.S.P.Q.2d (BNA) 1071 (T.T.A.B. 2008), in which the panel deemed the mark Anti-Semitic, rejecting the trademark for “‘clothing, namely, jackets, jerseys, sweat pants, sweat shirts, track suits, t-shirts, tank tops and pants; headwear’ in International Class 25 and ‘entertainment, namely, conducting parties’ in International Class 41. The application includes a claim of ownership of Registration No. 2858011 issued on June 29, 2004 for the mark HEEB (in standard character form) for ‘publication of magazines’ in International Class 41.”).

⁷⁸ See *In re Tam*, 808 F.3d 1321, 1330 (“THE CHRISTIAN PROSTITUTE (2013); AMISHHOMO (2013); MORMON WHISKEY (2012); . . . HAVE YOUR HEARD THAT SATAN IS A REPUBLICAN? (2010); RIDE HARD RETARD (2009); ABORT THE REPUBLICANS (2009); . . . MARRIAGE IS FOR FAGS (2008); DEMOCRATS SHOULDN’T BREED (2007); REPUBLICANS SHOULDN’T BREED (2007); 2 DYKE MINIMUM (2007); WET BAC/WET B.A.C. (2007); URBAN INJUN (2007) . . . N.I.G.G.A. NATURALLY INTELLIGENT GOD GIFTED AFRICANS (1996); a mark depicting a defecating dog, *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d 1635 (T.T.A.B. 1988) (found to disparage Greyhound’s trademarked running dog logo); an image consisting of the national symbol of the Soviet Union with an “X” over it, *In re Anti-Communist World Freedom Cong., Inc.*, 161 U.S.P.Q. 304 (T.T.A.B. 1969)”). This rationale was overruled by the Federal Circuit, where it concluded that the immoral and scandalous portion of Section 2(a) was deemed unconstitutional in *In re Brunetti*, No. 2015-1109, 2017 U.S. App. LEXIS 25336 (Fed. Circ. Dec. 15, 2017), discussed *infra* note 268.

⁷⁹ See *Japanese Am. Citizens League v. Takada*, 171 U.S.P.Q. (BNA) 109 (Sup. Ct. N.Y. 1971). *In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014).

⁸⁰ See *In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014).

⁸¹ See *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d (BNA) 1080 (T.T.A.B. 2014), discussed *infra* Part I.

⁸² See *infra* Part I.

After the rejection of The Slants mark, Mr. Tam brought the case to the Federal Court of Appeals, which affirmed the TTAB ruling.⁸³ The three-judge appellate panel reiterated the view of the Board that despite the fact that “Slants” may have innocuous meanings, it is “clear that a large number of people would consider the term disparaging to Asians.”⁸⁴ The panel then addressed the group’s constitutional challenge, alleging that the disparagement clause served as an unwarranted restriction on Tam’s First Amendment rights. Citing *McGinley*, as well as more recent cases,⁸⁵ the panel concluded the failure to register a mark considered disparaging was not a restriction on speech rights because it does not limit the right of the group to use the term “Slants.”⁸⁶ It also summarily denied claims that the provision was “vague” and the standards employed for determining disparaging marks lacked due process. The court also rejected the notion that the USPTO applied the disparagement standard arbitrarily.⁸⁷

What makes the ruling significant are the “additional views” by one of the judges, who argued that it was time to reconsider the constitutionality of Section 2(a).⁸⁸ Although a concurrence of sorts, Judge Moore’s opinion served as a significant set-up for future rulings in this case. Written as a “macro” analysis of the relationship between the First Amendment and trademark law, this opinion urges a re-examination of the justification for the disparagement clause and urges that *McGinley*, the leading precedent, be reexamined in light of the passage of time. Moreover, Judge Moore noted that the “wide criticism” of the *McGinley* ruling and the enhanced constitutionalization of commercial speech doctrine could mean that Section 2(a)’s ban on disparaging trademarks may be on constitutional thin ice. Judge Moore observed that the band’s adoption of “Slants” was more than a brand identifier—it takes on a cultural and political avocation, as the group

⁸³ See *In re Tam*, 785 F.3d 567 (Fed. Cir. 2015).

⁸⁴ *Id.* at 569–71. (The court applied the same two-part test that the TTAB utilized and concluded that, despite evidence to the contrary submitted by Tam, “[s]ubstantial evidence supports the Board’s finding that the mark THE SLANTS is likely offensive to a substantial composite of people of Asian descent.”).

⁸⁵ *In re Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003) (“[T]he refusal to register a mark does not proscribe any conduct or suppress any form of expression because it does not affect the applicant’s right to use the mark in question.”); *In re Mavety Media Grp.*, 33 F.3d 1367, 1374 (Fed. Cir.1994); see also *In re Fox*, 702 F.3d 633, 635 (Fed. Cir.2012) (“Because a refusal to register a mark has no bearing on the applicant’s ability to use the mark, we have held that § 1052(a) does not implicate the First Amendment rights of trademark applicants.”).

⁸⁶ See *In re McGinley* 660 F.2d 481, 484 (C.C.P.A. 1981) (“The PTO’s refusal to register appellant’s mark does not affect his right to use it [citation omitted]. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant’s First Amendment rights would not be abridged by the refusal to register his mark.”).

⁸⁷ *In re Tam*, 785 F.3d at 572. (The court summarily rejected claims that the disparagement clause was unconstitutionally vague. It also rejected the argument that the clause violated the due process and equal protection clauses of the Fifth Amendment.).

⁸⁸ *Id.* at 573 (Moore, J., additional views).

selected the name to “reclaim” and “take ownership” of Asian stereotypes.⁸⁹

Trademark registration, according to the judge, is more than just an administrative process. Disagreeing with *McGinley*, Judge Moore opined that important rights of exclusive use and enforcement against infringers are limited, resulting in a “severe burden” on the use of such marks and a chilling effect on speech.⁹⁰

After concluding that trademark registration is not funded speech, Judge Moore directly addressed the constitutionality of the disparagement clause and the interplay of commercial speech doctrine and trademark law.⁹¹ After reiterating that commercial speech is undoubtedly protected speech under the First Amendment since 1976,⁹² she concluded that the government lacked any substantial interest in restricting such marks.⁹³

Clearly, the anti-disparagement provision singles out particular speech by its content, discriminating against speech that has disparaging and offensive viewpoints. Although the court did not directly address this issue, if the speech was not commercial, it would easily fail under a strict scrutiny standard, which requires a “compelling governmental interest” that is “as narrowly drawn as possible.”⁹⁴ However, since it can be argued that many, if not most trademarks are commercial in nature, the standard of review is relaxed. Courts have utilized a form of intermediate scrutiny under the so-called *Central Hudson* standard.⁹⁵ Instead of strict scrutiny, commercial speech regulation employs a multi-part test. First, commercial speech “must concern lawful activity and not be misleading.”⁹⁶ If this is the case, the inquiry becomes whether (1) “the asserted governmental interest is substantial,” (2) “the regulation directly advances the governmental interest asserted,” and (3)

⁸⁹ *Id.* at 575.

⁹⁰ *Id.* Her opinion noted that without trademark registration, owners would lose the following benefits: (1) the right to exclusive nationwide use of that mark; (2) incontestability (with certain exceptions) after five years of consecutive post-registration use; (3) the right to recover treble damages if he can show infringement was willful; (4) obtaining the assistance of U.S. Customs and Border Protection in restricting importation of infringing or counterfeit goods; (5) preventing “cybersquatters” from misappropriating his domain name. *Id.* at 576.

⁹¹ *Id.* at 580–81. (“Furthermore, the act of registering a trademark does not involve the federal treasury. In 1981, as noted by the *McGinley* court, trademark registration was ‘underwritten by public funds.’ [citation omitted]. That is no longer true today. Since 1991, PTO operations have been funded entirely by registration fees, not the taxpayer [citations omitted]. . . . Trademark registration does not implicate the Spending Clause merely because of this attenuated spending, else every benefit or program provided by the government would implicate the Spending Clause.”).

⁹² See *Va. State Pharmacy Bd. v. Va. Citizens Consumer Council*, 425 U.S. 748 (1976).

⁹³ See *In re Tam*, 785 F.3d at 585.

⁹⁴ See *Austin v. Mich. Chamber of Commerce*, 494 U.S. 652, 657, 666 (1990).

⁹⁵ The standard derives from *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557 (1980).

⁹⁶ *Id.* at 557.

the regulation “is not more extensive than is necessary to serve that interest.”⁹⁷ Judge Moore concluded that Section 2(a) did not pass this standard since the government’s interest in discouraging the use of disparaging marks that may be offensive to persons, institutions, beliefs, or national symbols, was not substantial enough to justify the ban.⁹⁸

D. *The En Banc Ruling*

Judge Moore’s role in this case did not end with this opinion, as the full panel of the circuit reconsidered the case and issued an en banc ruling penned by the same judge.⁹⁹ In the nine-to-three majority ruling, the court reversed the earlier three-judge panel ruling and opined that the disparagement clause was unconstitutional, as it condones discrimination based on the views of the speech. Taking the basic conclusion from her earlier opinion and now writing for the court, Judge Moore expanded her earlier views in her majority opinion. In short, she reiterated that the disparagement provision failed under either strict scrutiny review (appropriate for government regulation of message or viewpoint), or even intermediate scrutiny, since no legitimate interest justifying the prohibition was made by the government.¹⁰⁰ Her sensitivity to the speech rights involved in this case is demonstrated at the outset:

Courts have been slow to appreciate the expressive power of trademarks. Words—even a single word—can be powerful. . . . Tam named his band THE SLANTS to make a statement about racial and cultural issues in this country. With his band name, Mr. Tam conveys more about our society than many volumes of undisputedly protected speech.¹⁰¹

Additionally, the strong aversion for the *McGinley* ruling by this court and reliance on it by courts in a variety of federal circuits were given as reasons for re-argument en banc.¹⁰²

⁹⁷ *Id.* at 566. Some have analogized this test as mirroring the “content-neutral” standard for core First Amendment speech. If the government regulates speech only involving a “time, place or manner” restriction that does not involve viewpoint discrimination, the courts require a “substantial governmental interest” which is “narrowly tailored to a significant governmental interest.” *See Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1991). However, there is an apples and oranges quality to this distinction, since under *Central Hudson* all commercial speech restrictions, even if content-based, must go through the same or very similar standard. Hence, the importance of the somewhat artificial distinction between commercial and non-commercial speech. For more discussion, see Lee Ann W. Lockridge, *When is a Use in Commerce a Non Commercial Use?*, 37 FL. ST. U. L. REV. 337, 353–55 (2010).

⁹⁸ *See In re Tam*, 785 F.3d at 585.

⁹⁹ *See In re Tam*, 808 F.3d 1321 (Fed.Cir. 2015).

¹⁰⁰ *Id.* at 1355.

¹⁰¹ *Id.* at 1327–28.

¹⁰² *Id.* at 1333–34. The court cited *Test Masters Educ. Servs., Inc. v. Singh*, 428 F.3d 559, 578 n.9 (5th Cir. 2005) and *Pro-Football, Inc., v. Blackhorse*, 112 F. Supp. 3d 439, 454–57 (E.D. Va.

The interplay between what is commercial and what is not merited a considerable portion of the opinion. Rejecting the government's weak argument that the speech involved is content-neutral,¹⁰³ the majority opinion addressed what kind of speech and what kind of test the court should apply.

Judge Moore's opinion stated that the "viewpoint discrimination" of the disparagement ban deserved a strict scrutiny analysis. However, sensitive to the fact that commercial speech occupies a less exalted First Amendment position, the court took pains to note that the ban did not involve a commercial rationale.¹⁰⁴ In fact, the court determined that Mr. Tam's proposed trademark had a more expressive aspect over and above its commercial-speech branding. Mr. Tam explicitly selected his mark as a hybrid between non-commercial and commercial speech to create a dialogue on controversial political and social issues.

With his band name, Mr. Tam makes a statement about racial and ethnic identity. . . . He advocates for social change and challenges perceptions of people of Asian descent. His band name pushes people. It offends. Despite this—indeed, because of it—Mr. Tam's band name is expressive speech.¹⁰⁵

Therefore, Judge Moore opined, the disparagement clause results in classic viewpoint discrimination based on the nature of the expressive conduct. And, the opinion added that commercial speech is no exception to the need for heightened scrutiny of content-based impositions seeking to curtail the communication of particular information or messages.¹⁰⁶ Indeed, "[a] consumer's concern for the free flow of commercial speech often may be far keener than his concern for urgent political dialogue."¹⁰⁷ Therefore, "strict scrutiny must apply to a government regulation that is directed at the expressive component of speech."¹⁰⁸

According to the court, one who wishes to register a potentially disparaging trademark that may make a political or societal commentary may be "chilled" from doing so—a policy that is practically fatal in a constitutional analysis. In so concluding, the court rejected the claim that the disparagement clause constituted "government speech" which is

2015), holding "the Court agrees with the Federal Circuit and Fifth Circuit and holds that Section 2(a) of the Lanham Act does not implicate the First Amendment."

¹⁰³ *In re Tam*, 808 F.3d at 1335. (The court made its point bluntly: "Section 2(a) prevents the registration of disparaging marks—it cannot reasonably be argued that this is not a content-based restriction or that it is a content-neutral regulation of speech.")

¹⁰⁴ *Id.* at 1337–38.

¹⁰⁵ *Id.* at 1338.

¹⁰⁶ *Id.* at 1338–39.

¹⁰⁷ *Id.* at 1338, citing *Sorrell v. IMS Health Inc.*, 131 S. Ct. 2653, 2664 (2011).

¹⁰⁸ *See In re Tam*, 808 F.3d at 1338.

insulated from any First Amendment review.¹⁰⁹ It devoted a great deal of space, rejecting the government's arguments that registration was government speech or a government subsidy.¹¹⁰ The court cast away the government's arguments by adopting a common sense rationale: "[G]overnment registration of a mark is neither a government endorsement of the quality of the goods to which the mark is applied nor a government pronouncement that the mark is a good or reliable one in any moral or commercial sense."¹¹¹ Simply affixing a circle R next to the term does not make any more government speech than affixing a circle C (for copyright).¹¹² The court also rejected the even weaker claim that the registration constituted a government subsidy.¹¹³

Judge Moore's opinion also noted that the uncertainty in determining what is "disparaging" and what is not is unconstitutionally and practically vague, as a registrant may not have a reasonable idea of the guidelines for denial on this basis.¹¹⁴ In a footnote, the opinion cited the testimony of the Assistant Commissioner of Patents during a congressional hearing in 1939: "it is always going to be just a matter of the personal opinion of the individual parties as to whether they think it is disparaging,"¹¹⁵ adding that "further interpretation has helped little."¹¹⁶ A different footnote in the en banc opinion further explained the seeming inconsistencies of trademark registration, reciting a list of examples which aptly shows the arbitrariness of the decision-making. For example, the USPTO refused to register the marks "FAG FOREVER A GENIUS!" and "MARRIAGE IS FOR FAGS," but allowed the mark "F*A*G FABULOUS AND GAY."¹¹⁷ The

¹⁰⁹ *Id.* at 1345.

¹¹⁰ *Id.* at 1339–55.

¹¹¹ *Id.* at 1347, citing *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1219–20 n.3 (T.T.A.B. 1993).

¹¹² See 15 U.S.C. § 1111 (trademark designation) and 17 U.S.C. § 401 (copyright designation). *In re Tam*, 808 F.3d 1321, 1347 (Fed.Cir. 2015). ("Just as the public does not associate the copyrighted works *Nigger: The Strange Career of a Troublesome Word* or *Fifty Shades of Grey* with the government, neither does the public associate individual trademarks such as THE SLANTS with the government.").

¹¹³ *In re Tam*, 808 F.3d at 1351 ("[T]rademark registration is not a program through which the government is seeking to get its message out through recipients of funding (direct or indirect).").

¹¹⁴ *Id.* at 1341–42. "The § 2(a) bar on registration creates a strong disincentive to choose a 'disparaging' mark. And that disincentive is not cabined to a clearly understandable range of expressions. The statute extends the uncertainty to marks that 'may disparage.'" 15 U.S.C. § 1052(a). The uncertainty as to what *might be deemed* disparaging is not only evident on its face, given the subjective-reaction element and shifting usages in different parts of society. [footnote omitted]. It is confirmed by the record of PTO grants and denials over the years, from which the public would have a hard time drawing much reliable guidance." *Id.*

¹¹⁵ See *In re Tam* 808 F.3d at 1342 n.6 (citing Hearings on H.R. 4744 Before the Subcomm. on Trade-Marks of the H. Comm. on Patents, 76th Cong., 1st Sess. 18–21 (1939) (statement of Leslie Frazer, Assistant Comm'r of Patents)).

¹¹⁶ See *Hearings on H.R. 4744*, *supra* note 115.

¹¹⁷ See *In re Tam*, 808 F.3d at 1342 n.7. Other examples are as follows: "The USPTO denied the mark HAVE YOU HEARD SATAN IS A REPUBLICAN because it disparaged the Republican

inconsistencies demonstrated were compelling evidence of the difficulty of enforcing the disparagement restrictions. As the opinion stated, “We see no rationale for the PTO’s seemingly arbitrary registration decisions, let alone one that would give applicants much guidance.”¹¹⁸

The opinion ended with a similar analysis of commercial speech that was discussed in Judge Moore’s concurring opinion in the earlier three-judge panel ruling in *Tam*. Assuming that trademarks are commercial speech—questionable in this case for the reasons noted—the court applied *Central Hudson* and stated that the government’s rationale for preventing the registration of disparaging marks did not encompass a “substantial” interest.¹¹⁹

The case produced several additional opinions, most of which affirmed the unconstitutionality of the disparagement portion of Section 2(a) as applied against Mr. Tam but differed in the approaches taken. Two judges viewed the disparagement clause as unconstitutionally void for vagueness under the Fifth Amendment.¹²⁰ Three other members of the court concurred in part, agreeing with the conclusion that the disparagement clause was unconstitutional as to The Slants but could be justified in cases of “commercial speech,” but dissented from the majority’s conclusion that the disparagement clause was facially unconstitutional as applied to purely commercial speech.¹²¹

The majority opinion did not discuss the first portion of Section 2(a), but one of the concurring opinions did, noting that, in effect, the majority ruling invalidated the “scandalous and immoral” clause.¹²² Another opinion, dissenting, focused on the validity of the clause as purely commercial speech.¹²³

Party . . . but did not find the mark THE DEVIL IS A DEMOCRAT disparaging . . .” *Id.* Additionally, USPTO examiners “have registered DANGEROUS NEGRO, CELEBRETARDS, STINKY GRINGO, MIDGET-MAN, and OFF-WHITE TRASH—all marks that could be offensive to a substantial composite of the referenced group.” *Id.*

¹¹⁸ *Id.*

¹¹⁹ *Id.* at 1357. The government’s justifications—that the government is “‘entitled to dissociate itself from speech it finds odious’ [citation omitted], that it has a legitimate interest in ‘declining to expend its resources to facilitate the use of racial slurs as source identifiers in interstate commerce’ [citation omitted] were rejected. *Id.* at 1356. “All of the government’s proffered interests boil down to permitting the government to burden speech it finds offensive. This is not a legitimate interest.” *Id.* at 1357.

¹²⁰ *See In re Tam*, 808 F.3d 1321, 1363 (O’Malley, J. concurring) (concluding that “[t]he need for clarity is especially relevant when a law implicates First Amendment rights, as § 2(a) indisputably does. Section 2(a) does not provide a ‘person of ordinary intelligence a reasonable opportunity to know what is prohibited, so that he may act accordingly.’” [citation omitted] And the “seemingly rudderless, application of § 2(a) demonstrates the ‘arbitrary and discriminatory enforcement’ that occurs when regulations do not ‘provide explicit standards for those who apply them.’” [citation omitted]).

¹²¹ *Id.* (Dyk, J. concurring in part and dissenting in part).

¹²² *Id.*

¹²³ *Id.* (Reyna, J. dissenting). The Reyna opinion centered on the scope of the relationship between trademarks and commercial speech. Because commercial speech does not occupy the same level of governmental scrutiny as political, this opinion concluded that Section 2(a) fails

As noted in the beginning of the article, the stakes of the viability for Section 2(a) for sports teams like the Washington Redskins are large. This stems, in part, from longstanding public pressure to change their respective names (as have many college teams over the last two decades) but also to a recent court ruling that reached an opposite result from that of the en banc ruling in *Tam*.

I. THE REDSKINS' LITIGATION

For a relatively small and diverse group of people,¹²⁴ with a shared history of oppression by various Western invaders,¹²⁵ there is some irony that Native American names, designs, and mascots have been used by a number of professional, college, and high school teams for over a century.¹²⁶ The origin of Native Americans mascots in America can be traced to the late 1800s, when college and professional sports teams began using Native American tribal names.¹²⁷

“In 1970, there were more than 3,000 high schools, colleges, and professional teams using Native American mascots or logos. In the four decades since, more than two-thirds of those names have changed.”¹²⁸ As of 2014, “there are now fewer than 1,000 in use.”¹²⁹ In 2005, the NCAA issued a policy that barred colleges from using “hostile and abusive racial/ethnic/national origin mascots, nicknames or imagery at any of the 88 NCAA championships.”¹³⁰ While the Redskins, Indians and (Chicago) Blackhawks of the NHL have no plans to change their names or logos, over the past 40 years, a number of colleges and high schools have changed their team names – they include universities such

even if considered commercial speech because of its political elements. In all, four judges disagreed in some degree with the majority in some degree in their concurrences and dissents.

¹²⁴ See Jennifer Guiliano, *The Fascination and Frustration with Native American Mascots*, THE SOCIETY PAGES (Aug. 2, 2013) (citations omitted), <https://thesocietypages.org/specials/mascots/> (“According to the 2010 U.S. Census, 5.2 million people self-identify as Native American or Alaska Native (alone or in combination with another racial categorization). Nearly 2 million are members of 562 federally recognized tribes, and hold all of the rights of U.S. citizens, as well as those of their tribal citizenship. Indian tribes and individuals lay claim to over 56 million acres of land held in federal trust, and there are 326 tribal reservations administered by the U.S. government.”).

¹²⁵ Over the last five hundred years, Native Americans experienced dramatic population declines, intra- and extra-tribal warfare, and exploitation at the hands of Spanish, French, and English colonists. *Id.*

¹²⁶ See NCAA bans Indian mascots during postseason, *supra* note 27.

¹²⁷ See Blanks, *supra* note 7, at 11.

¹²⁸ Travis Waldron, *Education Group Fights To Rid Wisconsin Schools Of Native American Stereotypes*, THINK PROGRESS (Feb. 12, 2014, 3:58 PM), <https://thinkprogress.org/education-group-fights-to-rid-wisconsin-schools-of-native-american-stereotypes-51249453ced6>.

¹²⁹ *Id.*

¹³⁰ See Press Release, Nat'l Collegiate Athletic Ass'n NCAA Executive Committee Issues Guidelines for Use of Native American Mascots at Championship Events (August 5, 2005), <http://fs.ncaa.org/Docs/PressArchive/2005/Announcements/NCAA%2BExecutive%2BCommittee%2BIssues%2BGuidelines%2Bfor%2BUse%2Bof%2BNative%2BAmerican%2BMascots%2Ba%2BChampionship%2BEvents.html>.

as Stanford, Dartmouth, Marquette, St. John's (NY), and North Dakota.¹³¹ However, some colleges and universities have kept their names and even their mascots, as have many high schools.¹³²

The Redskins' trademark challenge in *Pro-Football Inc. v. Blackhorse* considered a similar constitutional challenge to Section 2(a).¹³³ There, the federal district court made an opposite determination from that of the en banc majority in *Tam*, and ultimately from the Supreme Court. The Redskins' name is a venerable one in NFL circles,¹³⁴ and its marks were registered in 1967, 1974 and 1990, respectively.¹³⁵ The history of litigation involving the Redskins' trademark is also a rich one, with a long running attempt to cancel them made over the last two decades.¹³⁶

Until *Blackhorse* considered the issue, the previous courts were stymied from deciding the merits of the disparagement clause, because they were precluded by the defense of laches. In 1996, a group of Native Americans led by Harjo, filed a petition to cancel the registrations of the Redskins marks as disparaging under Section 2(a). They won an early victory, as the TTAB, after considerable written and testimonial evidence was presented,¹³⁷ ruled that although the Redskins marks were not "scandalous or immoral" they "may disparage" Native Americans when registered based on past attitudes of the public and ordered that the registrations of the marks be cancelled.¹³⁸

¹³¹ See *List of Schools supra* note 27. (Examples include: Stanford University – Indians to Cardinal (1972); Dartmouth – Indians to Big Green (1974); St. John's (N.Y.) – Redman to Red Storm (1994); Marquette – Warriors to Golden Eagles (1994); Miami (Ohio) – Redskins to RedHawks (1997); Seattle University – Chieftains to Redhawks (2000); Arkansas State – Indians to Red Wolves (2008); North Dakota – dropped Fighting Sioux in 2012).

¹³² See, Allison Pohle, *It's 2015. Why Do 40 Mass. High Schools Still Have Native American Mascots?*, BOSTON.COM (May 20, 2015), <https://www.boston.com/news/untagged/2015/05/20/its-2015-why-do-40-mass-high-schools-still-have-native-american-mascots>.

¹³³ *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va., 2015).

¹³⁴ *Id.* at 448. The "Redskins" mark was first used by the team in 1933 when then-owner George Preston Marshall selected the name while the team was located in Boston. "Redskins" was chosen to distinguish the football team from the Boston Braves professional baseball team. He kept the team name after the team moved to Washington, D.C.

¹³⁵ See *Pro-Football, Inc. vs. Blackhorse*, 112 F.Supp.3d at 449–50 (citing Registration No. 0836122 (registered Sept. 26, 1967); Registration No. 0978824 (registered Feb. 12, 1974); Registration No. 0986668 (registered June 18, 1974); Registration No. 0987127 (registered June 25, 1974); Registration No. 1085092 (registered Feb. 7, 1978); and Registration No. 1606810 (registered July 17, 1990)). The full description of the registrations is found at *Id.*

¹³⁶ See, e.g., *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999); *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96 (D.D.C. 2003); *Pro-Football, Inc. v. Harjo*, 415 F.3d 44 (D.C. Cir. 2005); *Pro-Football, Inc. v. Harjo*, 567 F. Supp. 2d 46 (D.D.C. 2008); *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080, 2014 WL 2577516, all discussed, *infra*.

¹³⁷ Evidence included testimony from the petitioners, the owner of the team, linguistics experts, historians, social scientists, and representatives from civil rights organizations. It also included pictures, cartoons, and advertisements pertaining to respondent's football team and its fans and public surveys. See *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d at 1723; see also, *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d at 128–29.

¹³⁸ The TTAB utilized a two-part standard noted earlier in making its determination: (1) What is

The team sought to overturn the order, and after both parties made motions for summary judgment, the district court reversed the TTAB, holding that (1) the TTAB's failed to adequately prove a case for disparagement, and (2) the doctrine of laches precluded consideration of the case.¹³⁹

Engaging in a de novo fact-based inquiry, the court concluded that the TTAB's finding that the Redskins' marks "may disparage" Native Americans was "unsupported by substantial evidence." The district court questioned the effectiveness of the surveys and articles used, as well as the TTAB's reliance on a dictionary definition of the term "Redskins."¹⁴⁰ In addition, the court dismissed the claim on the basis of laches, as the challenge was untimely.¹⁴¹ Given that the trademarks were, by and large, registered in the 1960s and 1970s, a two-decade delay was substantial and caused prejudice to Pro-Football and the Redskins. *Harjo* was appealed and the appeals court ruled that the district misapplied the standard for laches and remanded.¹⁴² Then, on remand, the district court once again reiterated its dismissal of the claim as barred by laches, noting that a seven-year period before bringing the

the meaning of the matter in question, as it appears in the marks and as those marks are used in connection with the goods and services identified in the registrations? (2) Is the meaning of the marks one that may disparage Native Americans? See *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d at 1705. The panel concluded: "[f]rom this evidence we have concluded, *supra*, that the word 'redskin(s)' has been considered by a substantial composite of the general population, including by inference Native Americans, a derogatory term of reference for Native Americans during the time period of relevance herein. We have also concluded . . . that the word 'Redskins' in respondent's marks in the challenged registrations, identifies respondent's football team and carries the allusion to Native Americans inherent in the original definition of the word. Evidence of respondent's use of the subject marks in the 1940's and 1950's shows a disparaging portrayal of Native Americans in connection with the word 'Redskin(s)' that is more egregious than uses of the subject marks in the record from approximately the mid-1960's to the present. However, such a finding does not lead us to the conclusion that the subject marks, as used in connection with the identified services during the relevant time periods, are not still disparaging of and to Native Americans under Section 2 (a) of the Act. The character of respondent's allusions to Native Americans in its use of the subject marks is consistent with the general views towards Native Americans held by the society from approximately the 1940's forward. *Id.* at 1745.

¹³⁹ See *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d at 96.

¹⁴⁰ *Id.* at 96, 125–26. In deciding that there were no material facts in dispute, the court granted summary judgment for the Redskins. Since no single piece of evidence was enough to determine that the term was disparaging, the TTAB was forced to craft together facets of evidence to buttress this conclusion, and this court was not convinced that "substantial evidence" existed to do this. *Id.* at 125–26. It noted that the TTAB misapplied the burden of proof required in such cases. *Id.* at 129.

¹⁴¹ *Id.* at 113–14. ("The best time to resolve this case was 1967 or shortly thereafter. The net result of the delay is that there is no direct or circumstantial evidence in the record that, at the times the trademarks were registered, the trademarks at issue were disparaging; even though the Native Americans contend that during this entire time period the trademarks were disparaging. Hence, the evidence used by the TTAB to support its disparagement conclusion was purely inferential.")

¹⁴² See *Pro-Football, Inc. v. Harjo*, 415 F.3d at 44 (holding that the district court mistakenly started the clock for assessing laches in 1967 – the time of the first mark's registration – for all seven Native Americans, even though one, Mateo Romero, was at that time only one year old.)

action was an undue delay.¹⁴³ This decision was ultimately upheld on appeal.¹⁴⁴

Therefore, *Harjo* did not conclusively answer the central issue of whether the term *Redskin* was disparaging. In a new strategy, six different parties (all Native Americans) challenged the team's marks in 2010 in what has become the *Blackhorse* case.¹⁴⁵ Although there was voluminous evidence presented in both the *Harjo* and the *Blackhorse* cases, the TTAB, in a lengthy ruling which included one dissent, narrowed the evidence to "that [which] most directly reflects the sentiments of Native Americans."¹⁴⁶ Still, there was much testimony from linguistics experts, depositions (for and against the use of the term) from those in Native American groups, letters of protest, and other documentary evidence about the history and usage of the term that was presented. After digesting all of this evidence, the majority of the TTAB concluded that, under the two-part standard utilized for disparagement cases at the time,¹⁴⁷ the Redskins' mark was disparaging by a preponderance of the evidence during the period of the team's trademark registrations.¹⁴⁸ While there was much discussion about how many Native Americans or Native American groups thought the term was a slur, the majority of the Board concluded that a "substantial composite" of Native Americans thought that the term was disparaging, even if it was not a majority.¹⁴⁹ The TTAB also concluded that the claim was not barred by laches.¹⁵⁰ The dissenting opinion concluded that the

¹⁴³ See *Pro-Football, Inc. v. Harjo*, 567 F.Supp.2d at 56 (stating "In sum, the Court concludes that Defendant Romero's delay was undue, in light of his actual knowledge of all of the trademarks before he reached majority.").

¹⁴⁴ See *Harjo*, 565 F.3d 880 (D.C. Cir. 2009), cert. denied, 558 U.S. 1025 (2009). The district court did not abuse its discretion in its determination.

¹⁴⁵ The parties in this case stipulated, with a few exceptions, that the *Harjo* record be submitted into evidence. See *Blackhorse*, 111 U.S.P.Q.2d 1080, 2014 WL 2577516.

¹⁴⁶ *Id.* at *24 n. 45.

¹⁴⁷ *Id.* at *44 n. 121.

¹⁴⁸ *Id.* at *72 n. 216.

¹⁴⁹ *Id.* at *71–72 n. 215–16 ("The record establishes that, at a minimum, approximately thirty percent of Native Americans found the term REDSKINS used in connection with respondent's services to be disparaging at all times including 1967, 1972, 1974, 1978 and 1990. Section 2(a) prohibits registration of matter that disparages a substantial composite, which need not be a majority, of the referenced group. Thirty percent is without doubt a substantial composite. To determine otherwise means it is acceptable to subject to disparagement 1 out of every 3 individuals, or as in this case approximately 626,095 out of 1,878,285 in 1990. There is nothing in the Trademark Act, which expressly prohibits registration of disparaging terms, or in its legislative history, to permit that level of disparagement of a group and, therefore, we find this showing of thirty percent to be more than substantial.").

¹⁵⁰ *Id.* at *74–75 n. 220 (" . . . the disparagement pertains to a group of which the individual plaintiff or plaintiffs simply comprise one or more members It is difficult to justify a balancing of equities where a registrant's financial interest is weighed against human dignity). The court also concluded that there was no showing "that any one of the plaintiffs has unreasonably delayed in bringing the petition to cancel . . . or [] that [it] has been prejudiced, i.e., that there has been economic prejudice due to the delay." *Id.* at *78 n. 222.

evidence presented was insufficient to support cancellation.¹⁵¹

The case then went to district court and constitutional challenges to the disparagement clause of Section 2(a) were brought for the first time.¹⁵² The court rejected the petitioners' application to cancel six trademarks owned by the team, concluding that the disparagement prohibition does not infringe upon the mark owner's First Amendment rights because "[no] conduct is proscribed[] and no tangible form of expression is suppressed," and even if it did, such an infringement would be "government speech" that is exempted from First Amendment application.¹⁵³ In so deciding, the court adopted precedent in similar cases in the Fifth and Federal Circuits (the latter all but reversed by that same circuit in *Tam*).¹⁵⁴

The *Blackhorse* court took a more traditional administrative law approach, treating trademark approval under the Lanham Act as discretionary decision-making by the USPTO and not as an action that suppresses speech. In this respect, the court discussed the "distinct" difference between a "trademark" and a "registration" of a trademark. So, even if the trademark registration was canceled (which was the goal of the respondents), the team could still "use the Redskins Marks in commerce."¹⁵⁵ What is at issue here is the registration of the Redskins Marks and the benefits associated with registration, not the use of the marks.¹⁵⁶

The court then addressed the constitutional issues and relied on the persuasive authority of several rulings from different Federal Appeals courts to conclude that First Amendment rights do not apply to cancellations of registration. It specifically cited the heretofore discussed and criticized *In re McGinley* and a Fifth Circuit ruling which stood for the proposition that there were no constitutional infirmities in rejecting or canceling scandalous marks.¹⁵⁷ In keeping with the limited view of the expressive importance of the registration, the court opined that "[c]ancelling the registration of a mark under Section 2(a) of the Lanham Act does not restrict the public debate on public issues, as the

¹⁵¹ *Id.* at *81 (Bergsman, J., dissenting). Because the same evidence as Harjo was used in this case, the dissenting judge concluded that it remained insufficient to determine disparagement.

¹⁵² *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015) (noting that challenges were made on First Amendment free speech grounds and Fifth Avenue vagueness).

¹⁵³ *Id.* at 455.

¹⁵⁴ *See Test Masters Educ. Servs. v. Singh*, 428 F.3d 559, 578 n.9 (5th Cir. 2005); *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981).

¹⁵⁵ *See Blackhorse*, 112 F. Supp. 3d at 453.

¹⁵⁶ *Id.* at 454.

¹⁵⁷ *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981); *Test Masters Educ. Servs. v. Singh*, 428 F. 3d 559, 570 (5th Cir. 2005). *See Test Masters Educ. Servs.* 428 F.3d at 570, n. 91. The court also cited other rulings, which included *Ritchie v. Simpson*, 170 F.3d 1092, 1099 (Fed. Cir. 1999) ("denial of federal registration of a mark does not prohibit the use of that mark"), as cited in *Blackhorse*, 112 F.Supp.3d at 455.

mark owner is still able to use the mark in commerce.¹⁵⁸

Given the importance accorded to the commercial v. non-commercial speech issue in the *Tam* ruling by the en banc panel of the Federal Circuit, this court's disregard for protected speech implications was rather surprising.

In another key difference from the en banc *Tam* ruling, the court in *Blackhorse* concluded that trademark registration constituted government speech and was therefore exempt from First Amendment scrutiny.¹⁵⁹ It gave three bases for this determination: (1) analogizing trademark registration to a state's issuance of specialty license plates (where the government can restrict certain controversial proposals, such as the use of a Confederate flag);¹⁶⁰ (2) reiterating that trademark law's "central purpose" of giving notice to such marks worldwide and concomitant with the "degree of editorial control" utilized by the government;¹⁶¹ and (3) determining that the government may determine the contents and limits of its programs it creates.¹⁶² This holding was ultimately reversed by the Supreme Court in *Matal v. Tam* and, despite the government's involvement in the trademark process, I would agree with both the en banc and Supreme Court conclusions. Trademark registration is at least one step removed from a federal or state program that controls content on official items like license plates or on funded programs dispensing medical assistance. The opinion also addressed a number of Fifth Amendment vague or arbitrary enforcement claims against the disparagement provision, but concluded that each of them failed.¹⁶³

¹⁵⁸ *Blackhorse*, 112 F.Supp.3d at 457.

¹⁵⁹ *Id.*

¹⁶⁰ See *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015) (the court concluded that a ban on request for "offensive" license plates was valid, as government speech since historically states used license plates to convey certain messages and are "essentially, government IDs."). *Id.* at 2242.

¹⁶¹ See *Sons of Confederate Veterans, Inc. v. Comm'r of Va. Dep't of Motor Vehicles (SCV)*, 288 F.3d 610, 618 (4th Cir. 2002) (The court adopted a mixed use/hybrid speech test that has governed the Fourth Circuit courts). The case involved similar facts to *Walker*, *supra* note 160.

¹⁶² See *Rust v. Sullivan*, 111 S.Ct. 1759, 1753 (1991) (concluding that governmental speech doctrine upheld regulations restricting the use of funds by grantees under Title X of the Public Health Act, 42 U.S.C. §§ 300-300a-6). *Id.* The regulations prohibited doctors from engaging in abortion counseling, referral, and activities advocating abortion as a means of family planning in Title X projects. See 42 U.S.C. § 300a-6. They were free to perform abortions and engage in abortion advocacy through programs that were independent from their Title X projects. 42 C.F.R. § 59.9 (1989) . . . Government can "selectively fund a program to encourage certain activities it believes to be in the public interest, without at the same time funding an alternative program" without violating the Constitution. See *Blackhorse*, 112 F. Supp. 3d at 462.

¹⁶³ See *Blackhorse*, 112 F. Supp. 3d at 464-67. The court held that Section 2(a) is not void for vagueness because (1) [Pro Football-Inc.] cannot show that Section 2(a) is unconstitutional in all of its applications; (2) [It] gives fair warning of what conduct is prohibited; (3) [It] does not authorize or encourage "arbitrary and discriminatory enforcement"; and (4) [It] is not impermissibly vague as applied to [Pro Football]. In addition, the Takings Clause and Due Process Clause claims failed because a trademark registration is not considered property under the

After disposing of the constitutional questions, *Blackhorse* then addressed whether the term was disparaging under Section 2(a). In granting summary judgment for the Redskins, the court, echoing the TTAB, concluded that the Redskins' mark is one that "may disparage" a substantial composite of Native Americans,¹⁶⁴ based on a wide array of documentary evidence, including literary, scholarly, and media references; and statements of individuals and groups.¹⁶⁵

The application of this TTAB standard represents one of the most problematic aspects of the interpretation of Section 2(a).¹⁶⁶ What exactly is a "substantial composite?" The Trademark Manual of Examining Procedure ("TMEP") offers no adequate guidance as to how to identify a "substantial composite," of a particular group or how to determine whether that "substantial composite" considers the mark disparaging. "It effectively requires the examiner first to hypothesize an audience and then to guess at the hypothetical audience's reaction to a particular term."¹⁶⁷

In addition, this failure to define the standard with even a modicum of precision, has led to "bizarre and contradictory" decisions, according to the American Civil Liberties Union ("ACLU"), which filed an amicus brief in the *Tam* case. Citing some examples, the USPTO rejected "Wanker" for use on clothing, but registered it for use on beer.¹⁶⁸ It rejected "Pussy Power" as a mark for entertainment services, but accepted "PussyPowerRevolution" for use on clothing.¹⁶⁹ One scholar, focusing on the question of the registration of sexual content, noted the "contradictory and confusing determinations about the registrability of [such] marks because of the explicit bar to registering

Fifth Amendment.

¹⁶⁴ *Id.* at 472. (The conclusion was based on definitions of the term through dictionary and other evidence during the relevant period – the time at which the marks were registered. "[T]he Court rejects PFI's challenges and finds that the record evidence of eleven dictionary definitions and their usage labels describing "redskins" as "offensive" or "contemptuous," along with Dr. Barnhart's testimony that "redskins" "might be offensive," weigh towards finding that between 1967 and 1990, the Redskins Marks consisted of matter that "may disparage" a substantial composite of Native Americans."). *Id.* at 475.

¹⁶⁵ *Id.* at 490.

¹⁶⁶ See United States Patent and Trademark Office, Trademark Manual of Examining Procedure (TMEP) § 3403(b).

¹⁶⁷ See Brief for the ACLU as Amici Curiae at 21, *Lee v. Tam*, 808 F.3d 1321 (2015) (No. 14-1203), 2015 WL 9287035.

¹⁶⁸ *Id.* at 22 (citing U.S. Trademark Application Serial No. 78,610,369 (filed Apr. 16, 2005) and Registration No. 2,036,108).

¹⁶⁹ *Id.* (comparing U.S. Trademark Application Serial No. 77,387,209 (filed Feb. 2, 2008) with Registration No. 4,507,246. "The PTO rejected 'Titmouse' for use on computer cursor control devices, but 'TitmouseInc.' is a registered mark used for animation production services." *Id.* "The PTO rejected 'Madonna' as a trademark for wine as scandalous, but accepted a different 'Madonna'—also for the sale of wine." *Id.* "The PTO rejected 'Cocaine,' for use on soft drinks, but accepted it for use on clothing." *Id.*

marks deemed immoral or scandalous.¹⁷⁰

According to an amicus brief written by the designer Eric Brunetti during the en banc review of *Tam*, this inconsistency poses constitutional infirmity way past trademarks.¹⁷¹ In his brief, he noted, almost apocalyptically, that if the Lanham Act could have a provision limiting trademark registration based on disparagement, what would stop Congress from amending the copyright laws to include such a provision for “disparaging works” or corporate law restricting a state from granting a certificate of incorporation or otherwise discriminating against a “disparaging” corporate name,¹⁷² or even the broadcast law realm.¹⁷³

Blackhorse was appealed to the Fourth Circuit, but, in deference to the Supreme Court consideration of *Tam*, it did not hear arguments nor render a ruling. When asked about the Redskins’ trademark claim, Tam noted: “from an ethical perspective, I don’t think they deserve anything, [But] [f]rom a business perspective, they have done everything that would allow one to have a trademark. But I think Native Americans are entitled to reparations, perhaps funded by the football team.”¹⁷⁴

II. THE SUPREME COURT’S *TAM* OPINION

As noted earlier, the court’s unanimous opinion was really two groups of rulings with a common core. The justices agreed on the government speech claim, with concurring opinions that focused on different aspects of free speech and viewpoint discrimination.¹⁷⁵ The

¹⁷⁰ See Jennifer Rothman, *Sex Exceptionalism in Intellectual Property*, 23 STAN. L. & POL’Y REV. 119, 124 (2012) (“Gender and sex discrimination also seep into USPTO adjudications. As discussed, references and depictions of genitalia are disfavored; however, references to male genitalia seem to fare better than those to female anatomy.”).

¹⁷¹ See Amicus Brief for Erik Brunetti in Support of Respondent at 8, *Lee v. Tam*, 808 F.3d 1321 (2015) (No. 14-1203), 2015 WL 9287035.

¹⁷² *Id.* See also *In Bad Frog Brewery v. New York State Liquor Authority*, 134 F.3d 87 (2d Cir. 1998) (Court concluded that state’s refusal to permit a beer company to use a picture of a frog on beer company’s label violated the First Amendment); *Kalman v. Cortes*, 723 F. Supp. 766 (E.D. Pa. 2010) (state refused to register I Choose Hell Productions LLC as an entity name due to a state statute that barred corporate names containing “[w]ords that constitute blasphemy, profane cursing or swearing or that profane the Lord’s name.”). See also *Wandering Dago, Inc. v. New York State Office of Gen. Servs.*, 992 F. Supp. 2d 102 (N.D.N.Y. 2014) (owner’s corporate name is expressive speech under the First Amendment).

¹⁷³ See *Red Lion Broadcasting v. FCC*, 395 U.S. 367, 388 (1969) (“[B]ecause the frequencies reserved for public broadcasting were limited in number, it was essential for the Government to tell some applicants that they could not broadcast at all because there was room for only a few.”) *Id.* Broadcasting laws traditionally gave the government greater powers to regulate the airwaves on a concept of scarcity of bandwidth.

¹⁷⁴ See Kory Grow, *Inside Asian-American Group the Slants’ Supreme Court Free-Speech Win*, ROLLING STONE (June 20, 2017), <http://www.rollingstone.com/music/news/inside-asian-american-band-the-slants-scotus-win-w488615>.

¹⁷⁵ To break this down further, Justice Alito wrote for the court, but the entire court only joined Parts I and III-A. Six other justices joined Justice Alito in Part II (Justice Thomas was the one exception). Alito’s opinion with respect to Parts III-B, III-C, and IV, was joined by Justices

opinions are rather short, and, in my view, could have addressed deeper First Amendment questions.

Before it discussed the main constitutional issues, the court rejected an argument first raised by Mr. Tam in his certiorari petition that the disparagement clause did not apply to trademarks that disparage racial or ethnic groups, but only “persons.”¹⁷⁶ Justice Alito then addressed the First Amendment claims, first focusing on the issue of whether a trademark registration is “government speech” and thereby an exception from the First Amendment’s free speech guarantee.

The government speech issue occupied a fair amount of time during the oral arguments,¹⁷⁷ so it is not surprising that the Court discussed it at reasonable length. During oral arguments, many of the justices appeared skeptical of the government’s view that the disparagement clause of Section 2(a) was immune from First Amendment scrutiny under the “government speech” doctrine.¹⁷⁸ Justice Alito rejected its application in this case, in a portion of the opinion that joined by other justices, except Justice Thomas.¹⁷⁹ Government speech is a relatively recent doctrine that permits the government to express viewpoints in its own speech, without triggering claims of viewpoint discrimination.¹⁸⁰ In effect, it immunizes such speech from constitutional attack and, for that reason, it has been used sparingly. Courts have, for example, applied the government speech immunity to situations where the government made posters promoting the war effort or where a state prints advertisements or notices encouraging people not to smoke or drive while intoxicated. The government speech doctrine

Roberts, Thomas and Breyer. Justice Kennedy, joined by Justices Ginsburg, Kagan and Sotomayor penned an additional concurrence. Justice Thomas wrote a separate, very short concurrence.

¹⁷⁶ See *Matal v. Tam*, 137 S.Ct. 1744, 1755 (2017). The Court noted that Tam never raised this argument before the PTO or the Federal Circuit, and had the government not accepted this argument, the court would not have even considered it. But, because the government did—seeking to avoid a constitutional determination on the disparagement clause, the Court was constrained to address it on the merits, noting that “[W]e have often stressed” that it is “importan[t] [to] avoid[d] the premature adjudication of constitutional questions” and that “we ought not to pass on questions of constitutionality . . . unless such adjudication is unavoidable,” *Clinton v. Jones*, 520 U. S. 681, 690 (1997).

¹⁷⁷ See Transcript of Oral Argument, *Matal v. Tam*, 137 S.Ct. 1744 (2017)(No. 15-1293). See also, Erica Goldberg, *Oral Argument in Lee v. Tam: Justice by Justice*, IN A CROWDED THEATER (BLOG), Jan. 18, 2017, <https://inacrowdedtheater.com/2017/01/18/oral-argument-in-lee-v-tam-justice-by-justice/>. In particular, Justices Roberts, Kagan and Breyer focused on the governmental speech issue.

¹⁷⁸ For example, Chief Justice Roberts asked: “I’m . . . concerned that your government program argument is . . . circular. The claim is you’re not registering on my mark because it’s disparaging, and your answer is, well, we run a program that doesn’t include disparaging trademarks, so that’s why you’re excluded. It . . . doesn’t seem to me to advance the argument very much.” Transcript of Oral Argument, *Matal v. Tam*, 137 S.Ct. 1744 (2017)(No. 15-1293).

¹⁷⁹ See *Tam*, 137 S.Ct.at 1760(“Trademarks are private, not government, speech.”).

¹⁸⁰ See Joseph Blocher, *Viewpoint Neutrality and Government Speech*, 62 BOSTON COL. L. REV. 696 (2011).

has its share of critics, because it points to a conflict. On the one hand, government speech rewards precisely what the rest of the First Amendment forbids—viewpoint-based limitations on private speech.¹⁸¹ On the other hand, “it is not easy to imagine how government could function” if it was subject to the restrictions that the First Amendment imposes on private speech. To do so would be “paralyzing.”¹⁸²

The leading cases on government speech focused on the governmental statements and opinions. A recent case—and one that the government relied on, since it has some superficial similarity to *Tam*—was *Walker v. Texas Division, Sons of Confederate Veterans*.¹⁸³ The State of Texas rejected an application by the respondents of a specialty license plate featuring a Confederate battle flag.¹⁸⁴ The Sons of Confederate Veterans sued, arguing that the prohibition violated their First Amendment free speech rights. In a 5-4 ruling, the Court concluded that the decision was immune from challenge because it was government speech, even though the plates would be custom-designed. Some have criticized this ruling as stepping away from the government-mandated speech discussed earlier.¹⁸⁵ A few years earlier, in another Supreme Court case, the Court invoked the government speech doctrine when it allowed a local government to accept certain privately donated monuments, but not others.¹⁸⁶ Other government speech cases have involved a ban on abortion counseling and a requirement to pay a fee to promote beef consumption.¹⁸⁷

It was an overreach to apply the government speech immunity to trademark registration. A trademark registration application is not created by the government, but by an individual or a firm. The proposed

¹⁸¹ *Id.* at 728.

¹⁸² *Matal v. Tam*, 137 S.Ct. 1744, 1757(2017).

¹⁸³ *Id.* See also *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S.Ct. 2239 (2015).

¹⁸⁴ After a period of public comment, the board voted unanimously against issuing the plate. The Board explained that it had found “it necessary to deny th[e] plate design application, specifically the confederate flag portion of the design, because public comments ha[d] shown that many members of the general public find the design offensive” and “advocating expressions of hate directed toward people or groups that is demeaning to those people or groups.” *Walker*, 135 S.Ct. at 2258.

¹⁸⁵ See Erwin Chemerinsky, *The Troubling Government Speech Doctrine*, AMERICAN CONSTITUTION SOCIETY BLOG, <https://www.acslaw.org/acsblog/the-troubling-government-speech-doctrine> (June 9, 2015).

¹⁸⁶ See *Pleasant Grove City v. Summum*, 555 U.S. 460 (2009). In that case, the Court, in an opinion by Justice Alito, rejected a claim by a religious organization that the city had to include a monument to be donated by Summum inscribed with the Seven Aphorisms in a city park, “similar in size and nature” to the one devoted to the Ten Commandments that was accepted by the town.

¹⁸⁷ See, e.g., *Rust v. Sullivan* 500 U.S. 173, 193 (1991) (In upholding a government program for abortion counseling, “The Government can, without violating the Constitution, selectively fund a program to encourage certain activities it believes to be in the public interest, without at the same time funding an alternate program which seeks to deal with the problem in another way.”); see also *Johanns v. Livestock Marketing Assn.*, 544 U.S. 550, 553 (2005) (A requirement that an assessment on all sales and importation of cattle is governmental speech and exempt from First Amendment review).

mark is created by one or a group of individuals to identify their brand. And, the registration of the mark is admittedly a government activity, but one that cannot be equated with a government statement on public health or safety.¹⁸⁸ Therefore, the court ultimately denied this “far-fetched” claim.¹⁸⁹ To argue otherwise, Justice Alito noted, would result in the Federal Government “babbling prodigiously and incoherently” (a quote that may be one of the more notable in Justice Alito’s tenure on the bench).¹⁹⁰

The opinion noted that with the exception of Section 2(a), the Lanham Act’s standard for trademark registration is content-neutral.¹⁹¹ Disregarding it, the Trademark examiner does not make value judgments as to which marks are “better” or “nobler” than others. It does not edit or change the mark. Once the mark fits the requirements of the law, it is up to others to challenge it as directly infringing or likely to cause confusion.¹⁹²

Following up on this point, the opinion found an expressive element in trademarks (thereby refusing to distinguish it from copyright registration), and notes that “Companies spend huge amounts to create and publicize trademarks that convey a message . . . powerful messages can sometimes be conveyed in just a few words.”¹⁹³ This opens up the

¹⁸⁸ The Court stated: “The Federal Government does not dream up these marks, and it does not edit marks submitted for registration. Except as required by the statute involved here, 15 U. S. C. §1052(a), an examiner may not reject a mark based on the viewpoint that it appears to express. Thus, unless that section is thought to apply, an examiner does not inquire whether any viewpoint conveyed by a mark inconsistent with Government policy or whether any such viewpoint is consistent with that expressed by other marks already on the principal register.” *See Matal v. Tam*, 137 S.Ct. 1744, 1758 (2017).

¹⁸⁹ Justice Alito added, almost sarcastically: “If the federal registration of a trademark makes the mark government speech, the Federal Government is babbling prodigiously and incoherently. It is saying many unseemly things. It is expressing contradictory views. It is unashamedly endorsing a vast array of commercial products and services. And it is providing Delphic advice to the consuming public.” *Tam*, 137 S.Ct. at 1758.

¹⁹⁰ *Id.* at 1758–59. If a trademark is government speech, “it is unashamedly endorsing a vast array of commercial products and services. For example, if trademarks represent government speech, what does the Government have in mind when it advises Americans to ‘make-believe’ (Sony) ‘Think different’ (Apple), ‘Just do it’ (Nike), or ‘Have it your way’ (Burger King)?” To add an obvious point, the reason why the Patent and Trademark Office argued the governmental speech claim— and the justices questioned counsel as intently as they did— is that if successful, it undercuts the need to examine the central tenet of the Slangs claim: that their denial of the mark, and, by extension the disparagement clause permitting such denial, constitutes unconstitutional viewpoints discrimination, thereby violating their First Amendment rights.

¹⁹¹ *Tam*, 137 S.Ct. at 1758.

¹⁹² *See* 15 USC § 1063(a) (“Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds”); *see also* 15 USC § 1064 (“A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged”)

¹⁹³ *See Tam*, 137 S.Ct. at 1760.

question of whether trademarks are only commercial in nature or can have extra-commercial practices.

After rejecting the government speech issue, it was not difficult for the Court to conclude that the disparagement clause constitutes unconstitutional viewpoint discrimination. But it does so in several concurring opinions. The first, where Justice Alito was joined by three justices of the Court,¹⁹⁴ quickly dispensed of arguments that trademark registration was immune from challenge because it was a type of subsidized government program in which some content- and speaker-based restrictions are permitted.¹⁹⁵

Justice Alito also rejected (implicitly) the argument by a number of distinguished law professors in the intellectual property field, writing in an amicus brief, that trademark registration is a purely “discretionary act” directly only at “trademark function, not substantive speech rights.”¹⁹⁶ This opinion further refuted the basic argument made by the professors that pointed to regulatory aim, rather than substantive loss of rights even if the regulation impairs speech based on content.¹⁹⁷ Despite

¹⁹⁴ See *id.* at 1760–66 (referring to sections III-B and III-C and IV where Justices Breyer, Kennedy and Thomas joined that portion of the opinion. Justices Kennedy, Ginsberg, Sotomayor and Kagan issued a separate concurring opinion on that portion of the case.).

¹⁹⁵ *Id.* at 1763. The court noted: “The PTO does not pay money to parties seeking registration of a mark. Quite the contrary is true: An applicant for registration must pay the PTO a filing fee of \$225–\$600. 37 CFR §2.6(a)(1) . . . The Federal Circuit concluded that these fees have fully supported the registration system for the past 27 years.” *Id.* at 1761 (citing *In re Tam*, 808 F.3d 1321, 1353 (Fed. Cir. 2015)).

¹⁹⁶ See Brief for Law Professors as Amici Curiae in Support of the Petitioner at 16, *Matal v. Tam*, 137 S.Ct. 1744 (2017)(No. 15-1293). The brief was submitted by Christine Haight Farley, American University College of Law and Rebecca Tushet, Georgetown University Law Center, as counsel of record and included: Jasmine Abdel-khalik, University of Missouri-Kansas City School of Law; Margo Bagley, Emory University School of Law; Mark Bartholomew, University at Buffalo School of Law; Ann Bartow, University of New Hampshire School of Law; Irene Calboli, Texas A&M University School of Law; Michael Carroll, American University Washington College of Law; Amanda Compton, Charleston School of Law; Sean M. Fiil Flynn, American University Washington College of Law; Leah Chan Grinvald, Suffolk University Law School; Michael Grynberg, DePaul University College of Law; Paul Heald, University of Illinois College of Law; Robert A. Heverly, Albany Law School; Peter Jaszi, American University Washington College of Law; Peter J. Karol, New England School of Law; Sonia Katyal, Berkeley Law; Jessica M. Kiser, Gonzaga University School of Law; Raymond Ku, Case Western Reserve University; Stacey M. Lantagne, University of Mississippi School of Law; Yvette Joy Liebesman, Saint Louis University School of Law; Lee Ann Lockridge, Louisiana State University Paul M. Herbert Law Center; Mark McKenna, Notre Dame School of Law; Lateef Mtima, Howard University School of Law; Xuan-Thao Nguyen, Indiana University McKinney School of Law; Victoria Phillips, American University Washington College of Law; Ken Port, Mitchell Hamline School of Law; Joshua Sarnoff, DePaul University College of Law; Roger E. Schechter, George Washington University Law School; Liza Vertinsky, Emory University School of Law; Julie Cromer Young, Thomas Jefferson School of Law.

¹⁹⁷ The arguments made by amici were probably the best that could be made for the government in this case. They differentiated trademarks from the rights conferred in a copyright, noting that the refusal to register a trademark does not mean the speech is censored, since the mark can still be used. So, a disparaging mark can still be used in a disparaging way if the holder so decides. Like defamation, trademark registration is content-based, but viewpoint neutral. *Id.* at pp. 4, 8, 15–16.

the fact that the law professors did not prevail, one commentator called their brief a “masterly” and “nuanced” argument.¹⁹⁸ In addition, seven of the eight justices easily concluded that the disparagement clause not only applies to individuals, but to “groups,” citing the “plain meaning of the statute.”¹⁹⁹

Although the court spoke with a unanimous voice on the governmental speech and benefits of trademark issues, it lacked a strong focus in regard to two other key points. The first involved the question of whether the trademark in question constituted commercial speech (and therefore subject to a lesser degree of constitutional protection). The latter involved the central element of viewpoint discrimination.

As noted earlier commercial speech has been a peculiar player in the First Amendment rulebook. Not even considered protected speech until 1976,²⁰⁰ it has been now clearly protected under the First Amendment, but subject to government regulation based on a standard considered either an “intermediate” scrutiny or “intermediate-plus” scrutiny test, depending on who you ask.²⁰¹ This case brings up the issue as to whether a trademark is inherently commercial speech or if it could have non-commercial expressive elements (subject to the more demanding “strict scrutiny” standard). Justice Alito, writing for the four concurring justices noted above, was able to take an easy way out by simply concluding that the disparagement clause failed to pass constitutional muster even under the “relaxed” commercial speech standard. Therefore, he did not have to address the question of whether a trademark is inherently commercial or not.²⁰²

¹⁹⁸ See Erica Goldberg, *Lee v. Tam: Offensive Trademarks at the Supreme Court: Speech Rights and Government Prerogative*, IN A CROWDED THEATER (Dec. 6, 2016), https://inacrowdedtheater.com/2016/12/06/lee-v-tam-offensive-trademarks-at-the-supreme-court-speech-rights-and-government-prerogative-a-series-3/?iframe=true&theme_preview=true#more-1127.

¹⁹⁹ See *Matal v. Tam*, 137 S.Ct. at 1763. For a more detailed explanation, see Erica Goldberg, *The Opinion in Matal v. Tam*, IN A CROWDED THEATER (June 19, 2017), <https://inacrowdedtheater.com/2017/06/19/the-opinion-in-matal-v-tam-final-post-in-a-series/>.

Tam did not raise this argument prior to the appeal. And since it was not a part of the accepted certiorari petition, the court would not consider it. However, the seven members of the court felt that it had to be addressed before reaching the constitutional question of the disparagement clause. The clause applies to marks that disparage “persons.” “A mark that disparages a “substantial” percentage of the members of a racial or ethnic group, Trademark Manual §1203.03(b)(i) necessarily disparages many “persons,” namely, members of that group. Tam’s argument would fail even if the clause used the singular term “person,” but Congress’ use of the plural “persons” makes the point doubly clear.” *Matal v. Tam*, 137 S.Ct. at 1753–54.

²⁰⁰ See *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council*, 425 U.S. 748 (1976) (constitutionalizing commercial speech in rejecting a state law prohibiting advertisements of drugs).

²⁰¹ See, e.g., *Free Speech after Reed v. Town of Gilbert*, 129 HARV. L. REV 1981, 1983 (2016) (“In practice, however, the content distinction is quite messy and only roughly tracks the division between permissible and impermissible regulation.”).

²⁰² See *Matal v. Tam*, 137 S.Ct. at n.17 (“We leave open the question whether *Central Hudson* provides the appropriate test for deciding free speech challenges to provisions of the Lanham

The opinion cursorily applied the *Central Hudson* test used in commercial speech cases to determine whether the government's interests is substantial enough or narrow enough to justify the restrictions.²⁰³ Two interests argued by the government passed the test: (1) The Government's in preventing speech expressing ideas that offend; and (2) protecting the orderly flow of commerce, which would be "disrupted" by trademarks "disparage[ing] race, gender, ethnicity, national origin, religion, sexual orientation, and similar demographic classification."²⁰⁴ Nevertheless, given the broad First Amendment protection against "hate speech," the argument for the restriction of "disparaging" speech was easily dismissed as it "strikes at the heart of the First Amendment"²⁰⁵ and it failed the *Central Hudson* test as "far too broad."²⁰⁶

It was unfortunate that the court did not address the commercial v. non-commercial issue head-on, because the band's use of the term "Slants" points out an important weakness of the commercial speech doctrine, at least in the area of trademarks and other areas of intellectual property, such as right of publicity²⁰⁷—speech seemingly used for a commercial purpose may take on non-commercial attributes.

The other regrettable aspect of this ruling was that the court's discussion of viewpoint discrimination was not more robust. While the court was unanimous in its view on the government speech issue, it did not speak with one voice when discussing viewpoint discrimination and commercial speech. In the portion of the opinion where Justice Alito wrote for himself and only three members of the court,²⁰⁸ he quickly rejected government claims that the speech was government subsidized, an understandable point, since that flowed from the fraught claim that it was government speech.²⁰⁹

Act.).

²⁰³ The application of the test, first enunciated in *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n of N.Y.*, 447 U.S. 557 (1980), discussed earlier in the article.

²⁰⁴ See *Matal v. Tam*, 137 S.Ct. at 1764 (citing *In re Tam*, 808 F. 3d, at 1379–81 (Reyna, J., dissenting); Brief for Petitioner at 49, *In re Tam*, 808 F.3d 1321 (No. 15-1293); Brief for Native American Organizations as Amicus Curiae in Support of Petitioner at 18–21, *Matal v. Tam*, 137 S.Ct. 1744 (No. 15-1293).

²⁰⁵ *Tam*, 137 S.Ct. at 1764; also see *R. A. V. v. City of St. Paul*, 505 U.S. 337, 402–03 (1992), *supra* cited in *Tam*, S.Ct. at 1764 ("the proudest boast of our free speech jurisprudence is that we protect the freedom to express 'the thought that we hate.'").

²⁰⁶ *Id.* ("The clause reaches any trademark that disparages *any person, group, or institution*. It applies to trademarks like the following: 'Down with racists,' 'Down with sexists,' 'Down with homophobes.' It is not an anti-discrimination clause; it is a happy-talk clause. In this way, it goes much further than is necessary to serve the interest asserted.").

²⁰⁷ See sources cited *supra* note 18.

²⁰⁸ See *In re Tam*, 808 F. 3d at 1379–81 (Reyna, J., dissenting); Brief for Petitioner at 49, *In re Tam*, 808 F.3d 1321 (2015) (No. 15-1293); Brief for Native American Organizations as Amicus Curiae in Support of Petitioner at 18–21, *Matal v. Tam*, 137 S.Ct. 1744 (2015) (No. 15-1293).

²⁰⁹ See *Matal v. Tam*, 137 S.Ct. at 1761 ("For the most part, this argument simply merges our government-speech cases and the previously discussed subsidy cases in an attempt to construct a

Four justices concurred in an opinion by Justice Kennedy.²¹⁰ Their focus was on the question on viewpoint discrimination, concluding that other issues (such as commercial v. non-commercial speech) are secondary. In so doing, these justices may have—intentionally or not—cracked open the growing issue of how commercial a trademark is and whether that should even be relevant in terms of First Amendment protection.

Recall that Justice Alito said that the justifications for the disparagement clause failed even under the “easier” *Central Hudson* test and ended the inquiry there. Justice Kennedy tackled the issue from a different point: he noted that since the statute denies trademark registration on the basis of content, it is presumptively unconstitutional, commercial speech or not.²¹¹ The potential laudable goal of insulating the public from offensive speech is not within the purview of the Patent and Trademark Office, as reasonable people can differ as to what is disparaging and what is not²¹² and, in making such determinations, the trademark examiners are determining which marks are “benign” and which are “harmful.” Hence, the viewpoint discrimination.

In what can be considered a subtle jab at the notion of political correctness that has occupied much debate on campus and elsewhere,²¹³ Justice Kennedy noted that it was not the business of the trademark office to reject trademarks because of the potential negative effects to a certain audience. “While thoughtful persons can agree or disagree with this approach, the dissonance between the trademark’s potential to teach and the Government’s insistence on its own, opposite, and negative interpretation confirms the constitutional vice of the statute,” the concurrence noted.²¹⁴

broader doctrine that can be applied to the registration of trademarks.”).

²¹⁰ Justices Ginsburg, Sotomayor and Kagan joined. *Id.* at 1744.

²¹¹ *Id.* at 1766 (“The Government may not insulate a law from charges of viewpoint discrimination by tying censorship to the reaction of the speaker’s audience.”).

²¹² *Id.*

²¹³ See Tammy Bruce, *The Rot of Political Correctness*, THE WASHINGTON TIMES (Apr. 19, 2017), <http://www.washingtontimes.com/news/2017/apr/19/political-correctness-continues-to-run-amok/> (“For the last 25 years, under the guise of ‘political correctness,’ we’ve been watching the inexplicable flow into our culture. The idiotic demands of political correctness in the 1980s, ironically relying on the decency of the American people for their acquiescence, was just the prep course, an amuse bouche before the main course of creating social chaos and destruction.”). For a different view, see Osita Nwanevu, *The Kids Are Right*, Slate, March 17, 2017, http://www.slate.com/articles/news_and_politics/cover_story/2017/03/there_s_nothing_outrageous_about_stamping_out_bigoted_speech.html (“The critics of political correctness have largely shirked opportunities to explore these questions seriously and open-mindedly, instead preferring to render student activists as uncharitably as possible.”).

²¹⁴ See *Matal v. Tam*, 137 S.Ct. at 1765 (concurring opinion by Justice Kennedy); (“Indeed, a speech burden based on audience reactions is simply government hostility and intervention in a different guise. The speech is targeted, after all, based on the government’s disapproval of the speaker’s choice of message. And it is the government itself that is attempting in this case to decide whether the relevant audience would find the speech offensive. For reasons like these, the

Justice Kennedy's analysis of the commercial speech issue goes beyond the opinion by Justice Alito. Although both opinions express skepticism about the limitations of trademarks to commercial speech terms, Justice Kennedy's opinion may be an opening into the future of the commercial speech v. non-commercial speech dichotomy. As noted earlier, although commercial speech is indeed protected speech, the courts have utilized a less onerous standard for governmental restriction of such speech, as encapsulated in the *Central Hudson* test.²¹⁵ Except for a passing reference to the protection of consumers,²¹⁶ Justice Kennedy virtually ignores that issue in his opinion and basically infers that viewpoint discrimination is per se unconstitutional, no matter what kind of speech it involves. He states: "To the extent trademarks qualify as commercial speech, they are an example of why that term or category does not serve as a blanket exemption from the First Amendment's requirement of viewpoint neutrality."²¹⁷ This concurrence does not limit trademarks to commercial speech, noting that "non-profit" entities also register trademarks in order "to compete in a real economic sense for funding and other resources as they seek to persuade others to join their cause."²¹⁸

Justice Thomas also wrote a very short concurrence, advocating the expansion of commercial speech rights by enacting a strict scrutiny test.²¹⁹ This is not surprising, since Justice Thomas has been skeptical of reduced First Amendment protection for commercial speech for some time.²²⁰

As a result of *Matal v. Tam*, the five Native Americans in *Blackhorse* dropped their claim against the Redskins, ending a quarter-century effort to revoke their trademark registrations. In addition, the U.S. Department of Justice abandoned the case, recommending in a

Court's cases have long prohibited the government from justifying a First Amendment burden by pointing to the offensiveness of the speech to be suppressed." *Id.* at 1767.

²¹⁵ See *Central Hudson Gas & Electric Corp. v. Public Service Commission*, 447 U.S. 557 (1980).

²¹⁶ See *Matal v. Tam*, 137 S.Ct. at 1752.

²¹⁷ *Id.* at 1767.

²¹⁸ *Id.* at 1768 (Justice Kennedy noted: "Nonprofit organizations—ranging from medical-research charities and other humanitarian causes to political advocacy groups—also have trademarks, which they use to compete in a real economic sense for funding and other resources as they seek to persuade others to join their cause . . . [t]o permit viewpoint discrimination in this context is to permit Government censorship.").

²¹⁹ *Id.* at 1769 (Thomas concurring).

²²⁰ See 44 *Liquormart v. Rhode Island*, 517 U.S. 484, 518 (Thomas, J. concurring) ("I do not join the principal opinion's application of the *Central Hudson* balancing test because I do not believe that such a test should be applied to a restriction of "commercial" speech, at least when, as here, the asserted interest is one that is to be achieved through keeping would be recipients of the speech in the dark.") For an analysis of Justice Thomas's commercial speech jurisprudence, see Matthew D. Bunker and Clay Calvert, *Contrasting Concurrences of Clarence Thomas: Deploying Originalism and Paternalism in Commercial and Student Speech Cases*, 26 *GEORGIA STATE UNIV. L. REV.* 321 (2010).

letter to the Fourth Circuit that the court should decide in favor of the Redskins.²²¹ The court indeed did just that, vacating the cancellation of the team's trademarks.²²²

A. *Reactions to the Supreme Court Ruling*

The decision rendered received generally positive comment. Simon Tam stated: "After an excruciating legal battle that has spanned nearly eight years, we're beyond humbled and thrilled to have won this case at the Supreme Court. This journey has always been much bigger than our band: it's been about the rights of all marginalized communities to determine what's best for ourselves."²²³ He added: "The Supreme Court has vindicated First Amendment rights not only for . . . The Slants, but all Americans who are fighting against paternal government policies that ultimately lead to viewpoint discrimination."²²⁴ As a parting shot, the group dedicated its newest CD to the USPTO, titling it "The Band Who Must Be Named."²²⁵ "Music is the best way we know how to drive social change: it overcomes social barriers in a way that mob-mentality and fear-based political rhetoric never can."²²⁶ Redskins' owner Daniel Snyder expressed his joy: "I am THRILLED. Hail to the Redskins."²²⁷

Attorneys in the intellectual property field were generally supportive, but some noted potential pitfalls. A former USPTO director noted: "Probably the right legal answer, but it may become a bit of a classic "be careful what you ask for." Just as we're trying to "lessen the polarization and crudeness" of public discourse, I'm worried that this [ruling] may have something of a negative result."²²⁸ Another noted IP

²²¹ See Nicole Narea, *Native Americans Drop Redskins Suit After High Court Ruling*, LAW360 (June 30, 2017), <https://www.law360.com/articles/940256/native-americans-drop-redskins-suit-after-high-court-ruling> (subscription required).

²²² See *Pro Football, Inc. v. Blackhorse*, No. 15-1874, 2018 Fed. Appx WL 460653 (4th Cir. Jan. 18, 2018). The court vacated and remanded the case.

²²³ See Robert Barnes, *Supreme Court: Rejecting trademarks that 'disparage' others violates the First Amendment*, THE WASHINGTON POST (June 19, 2017), https://www.washingtonpost.com/politics/courts_law/supreme-court-rejecting-trademarks-that-disparage-others-violates-the-first-amendment/2017/06/19/26a33ffa-23b3-11e7-a1b3-faff0034e2de_story.html?utm_term=.23dec8ed537c.

²²⁴ See *Supreme Court Sides with the Slants*, RAFU SHIMPO (LOS ANGELES JAPANESE DAILY NEWS) (June 20, 2017), <http://www.rafu.com/2017/06/supreme-court-sides-with-the-slants/>. Mr. Tam framed the issue in terms of rights of the LGBTQ community. "For too long, people of color and the LGBTQ community have been prime targets under Section 2(a) of the Lanham Act, simply because we believe in the deliberate disarmament of toxic language and symbols. We've had to endure the Trademark Office working in isolation of our groups to navigate the troubled waters of identity politics and shifting language and culture, without any sense of cultural competency, consistency in enforcement of rules, and only giving the benefit of doubt to the most privileged members of society. *Id.*

²²⁵ See THE BAND WHO MUST NOT BE NAMED (In Music We Trust Records 2017).

²²⁶ See sources cited in *supra* note 209.

²²⁷ See sources cited in *supra* note 209.

²²⁸ See Gene Quinn and Renee C. Queen, *Industry Reaction to SCOTUS First Amendment*

attorney echoed this concern by saying, “The Court’s decision will open the door to efforts to register trademarks that—unlike “The Slants”—are intended to disparage certain people or groups. But the decision reaffirms the protection afforded to free speech in the marketplace regardless of whether the speech is insulting or even hateful.”²²⁹ A third, echoing the divided opinions by the court in the case, stated “Although this case was decided 8-0 . . . the concurring opinions by Justice Kennedy (with whom 3 justices joined) and Justice Thomas showcase different rationales and reflect the hotbed of dispute underlying this case.”²³⁰ Another commentator aptly noted: “Love it or hate it, the language and logic of Monday’s ruling highlighted the fact that Section 2(a) has always been an odd fit inside the Lanham Act—a highly subjective rule rooted in far different policy concerns than the statute’s core trademark goals of protecting consumers from confusion in the marketplace.”²³¹ On the political spectrum, a comment from a writer from the National Review was very supportive. Given existing First Amendment jurisprudence, there would have been a constitutional earthquake if SCOTUS hadn’t ruled for Tam.”²³²

B. *The Ramifications*

Matal v. Tam generated debate within Asian-American groups and some were not entirely supportive of the band’s position. Asian-Americans Advancing Justice, an advocacy group whose goal is to advance civil and human rights for Asian-Americans, along with eleven other groups,²³³ filed an amicus brief that attempted to strike a middle ground. While sympathizing with The Slants and their right to choose that name, it saw that unfettered claims of “reclamation” of heretofore offensive terms could lead to the continued use of the “Redskins” term by a professional athletic team as contrary to the goals of what The

Decision in Matal v. Tam, IPWATCHDOG (June 20, 2017), <http://www.ipwatchdog.com/2017/06/20/industry-reaction-scotus-first-amendment-decision-matal-v-tam/id=84791/> (statement by Former Director of the USPTO and now Senior Partner, Polsinelli firm).

²²⁹ *Id.* (statement by Clay Tillack, Partner, Schiff Hardin).

²³⁰ *Id.* (statement by Charles R. Macedo, Partner, Amster, Rothstein & Ebenstein LLP).

²³¹ See Bill Donohue, *Even Before Slants, Offensive TM Ban Always An Awkward Fit*, LAW360 (June 20, 2017), https://www.law360.com/sports/articles/936415/even-before-slants-offensive-tm-ban-always-an-awkward-fit?nl_pk=6ada3079-4db3-4c29-8042be5ea277a863&utm_source=newsletter&utm_medium=email&utm_campaign=sports.

²³² See David French, *Free Speech Wins (Again) at the Supreme Court*, NATIONAL REVIEW (June 19, 2017), <http://www.nationalreview.com/corner/448771/free-speech-wins-again-supreme-court>.

²³³ The other amici included: Asian Americans Advancing Justice—Atlanta; Asian Americans Advancing Justice—Chicago; Asian Law Alliance; Asian Pacific American Labor Alliance, AFL-CIO; Asian Services in Action, Inc.; The Institute for Asian Pacific American Leadership & Advancement; Laotian American National Alliance; National Council of Asian Pacific Americans; National Federation of Filipino American Associations; OCA—Asian Pacific American Advocates; Southeast Asia Resource Action Center. See Amicus Brief for Asian American Advancing Justice, et al, *Lee v. Tam*, 137 S.Ct. 1744 (2017)(No. 15-1293).

Slants wished.²³⁴ So, amici sought to keep Section 2(a) in place because invalidation of the disparagement clause would be “overbroad,” allowing commercial entities like the NFL and its Washington franchise to utilize disparaging names describing minority or oppressed communities, without suitable protections for those communities.²³⁵ It also argued that Tam’s “personal goals” should not override the basic policies behind the Lanham Act, which are to “facilitate national trade and commerce.”²³⁶ Under a sensitized application of Section 2(a), the amici reasoned, a more consistent administrative approach to reclamation of a prior pejorative term can be made.²³⁷

However, *Matal v. Tam* was a case with favorable facts and a sympathetic party—a rock band using a term that was intended to empower, not to insult. But the Supreme Court’s ruling does create a harmful side effect: protection for those who wish to trademark names intending to demean, caricature, or inject crude humor. And, the ruling increased protection for sports teams utilizing Native American marks, whatever the motivation for the use of those names and logos.

Here is an illustration of this dilemma envisioned by some of those commentators. What if I (a Caucasian person) wish to create a band mocking Asians and call it the “Slits” (clearly a reference regarding people having narrow eyes, often used in an offensive way) to refer to people from Asia²³⁸ and then trademark that name? Assuming that the band would use the term in commerce, it would be likely approved. Or, what if I wish to trademark the name “Blackfaces” for my band, with a design of a person in blackface? Or, given the current controversy over immigration issues, what if I would want to sing the praises of restrictions on immigrants from Mexico by creating a band with the name of “Wet Backs?” To add further insult, let’s say the goal of these bands would be to make a political statement—as a “white power” band and perform and sell my materials, which would clearly have a racist edge. In these cases, as well as with real bands which appeal to racists and anti-Semites, for example,²³⁹ the reasons behind the names are quite

²³⁴ *Id.* at 1749.

²³⁵ Brief for Asian Americans Advancing Justice AAJC and Other Civil Rights and Advocacy Groups as Amici Curiae in Support of Neither Party at 2, 137 S.Ct. 1744 (2017) (No. 15-1293). Amici noted that invalidation of Section 2(a) “invites and incentivizes commercial appropriation of derogatory slurs without counterbalancing statutory protection for reclamation by minority and oppressed communities.” *Id.*

²³⁶ *Id.* at 5.

²³⁷ *Id.* at 14. “Neither should their private expressive intent override the government’s interest in not subsidizing disparaging.” Instead the amici proposed a three-part test: These factors include: (1) whether the mark is part of a reclamation effort; (2) the potential harmful effects of the term, and (3) how expressive the mark is. *Id.* at 17.

²³⁸ See Oxford Learner’s Dictionary, <http://www.oxfordlearnersdictionaries.com/us/definition/english/slitty-eyed>.

²³⁹ Beth A. Messner, Art Jipson, Paul J. Becker & Bryan Byers, “The Hardest Hate: A Sociological Analysis of Country Hate Music,” *Popular Music and Society* Vol. 30, Issue 4

different from the reasons given by The Slants. This is not a trivial concern. As of 2012, it was estimated that between one hundred and one hundred fifty white power music bands operated in the United States.²⁴⁰ In terms of their branding, the bands typically choose names that reflect explicit themes of hatred, violence, or antagonism to authority, and bands have utilized names such as “Aggravated Assault,” “Aggressive Force,” and “Armed and Deadly,” as well as names like “Definite Hate,” “Jew Slaughter,” and “Final Solution.”²⁴¹ Many have performed; some have recorded.

Often, a trademark attempts to inject a certain level of humor, but what if the humor is offensive to individuals or groups? One set of products titled “We Rub You” is branded on Korean marinade and hot sauce and is intended to be a “cute way to say ‘We Love You’” because “the Korean alphabet lacks a distinct L/R or V/B.”²⁴² Like The Slants, the owners re-appropriated a stereotype of Asians having trouble pronouncing those letters and used it for a business advantage. Before *Tam*, the TTAB may have had to weigh whether a substantial composite of people of that group would be offended or not—something particularly difficult when it comes to humor.²⁴³ The mark, however, was registered.²⁴⁴

I asked Mr. Tam about the potential for disparaging trademarks registered in the wake of the decision that bears his name. He responded as follows: “Some believe that the Pandora’s Box or floodgate for hate speech has been opened and that the market will be inundated with disparaging trademark registrations. However, I believe that is a fear-based, slippery slope argument. There are several reasons to consider why this will be an unlikely scenario.”²⁴⁵ He added:

First, in order to obtain a trademark registration, the applicant has to have a legitimate good or service in connection with that mark or a bona fide intent to use. The novelty of applying for a trademark registration isn’t worth the cost or effort for those who simply wish to be unseemly. Trademark Office rejections for lack of intent to use

(2007); See also, “The Sounds of Hate—The White Power Music Scene in the United States in 2012,” Anti-Defamation League, (no date), <https://www.adl.org/sites/default/files/documents/assets/pdf/combating-hate/Sounds-of-Hate-White-Power-Music-Scene-2012.pdf> (“Today, white power music is well established in the United States, where it has existed for three decades. Hate music arose originally in Great Britain in the 1970s [as part of a racist skinhead culture]”).

²⁴⁰ See *Anti-Defamation League Report*, at p. 2.

²⁴¹ *Id.* at 5.

²⁴² See Stephanie Klose, *Food Artisans: We Rub You*, SERIOUS EATS (Mar. 2013), <http://newyork.seriousseats.com/2013/03/food-artisans-we-rub-you-korean-sauces.html>.

²⁴³ While I do not assume that this is offensive per se, the terms and the reasons for it could be subject to a challenge by those who may honestly think so.

²⁴⁴ WE RUB YOU, Registration No. 4255185.

²⁴⁵ See E-mail from Simon Tam, *supra* note 49.

remains constitutional and that practice will continue regardless of the marks applied for. Second, an application requires a name and address on the registration. Few would like to be remembered for their opprobrium brought on through the perpetuation or use of scandalous, immoral, or disparaging terms.²⁴⁶

Ron Coleman, the attorney for The Slants wrote:

Trademark law does not give you ways to ‘own’ clever—or asinine—phrases or slogans. Merely plastering a meme or rallying cry on some garbaggio ‘goods’ doesn’t make a catchphrase, or even the name of a real provider of goods or a service, a trademark for garbaggio goods either. Most of these would-be horror registrations are at best garbaggio-goods specials. Very few people are prepared to build businesses around disgusting trademarks. Doing so is not what we call ‘good business.’²⁴⁷

Mr. Tam does not want to associate with these kinds of expression and this possibility is an unfortunate byproduct of the ruling. In responding to the societal ramifications of such potentially disparaging marks, he noted:

How I feel about how individuals use speech is a different matter altogether. What is ethical or respectful isn’t always what is required by law. There’s a mythical notion out there that we have a so-called political correctness police. However, no one is going to be arrested for being a jerk or for using offensive language. The reality is that people can say whatever they’d like, they just should understand that there may be social consequences involved: someone may be hurt, someone may misinterpret what we say or how that information is presented, someone may use their speech and say harmful things in response. So if people want to use so-called disparaging (or to that extent, scandalous and immoral) speech, then there will be consequences. But those consequences will and should be decided by the affected communities, not the government.²⁴⁸

The use of Native American names and logos on professional, college, and high school teams does not involve such a direct and vicious attack as utilized by white power rock bands. The use of “Braves,”²⁴⁹ “Indians,”²⁵⁰ and “Seminoles,”²⁵¹ do not demonstrate this

²⁴⁶ See *id.*

²⁴⁷ Ron Coleman, *Après Tam, le déluge? Nah.*, LIKELIHOOD OF CONFUSION (May 12, 2017), <http://www.likelihoodofconfusion.com/apres-tam-deluge-disparagement/>.

²⁴⁸ See E-mail from Simon Tam, *supra* note 49.

²⁴⁹ The Braves is still used as a team name by Bradley University as well as Atlanta’s National League baseball team. See BRADLEY UNIVERSITY, <http://bradleybraves.com/> (last visited Oct. 24, 2017); *The Official Site of the Atlanta Braves*, MLB.COM, <https://www.mlb.com/braves>, (last visited Oct. 24, 2017).

²⁵⁰ The Indians is still used by Cleveland’s American League baseball team and the Spokane

kind of malevolent intent. However, for many, it is still offensive. The question is how, in the wake of *Tam*, can there be any recourse to avoid disparaging terms as registered trademarks for those in commercial businesses? Ultimately, despite the noble ideal of Section 2(a), the subjectivity, vagueness, and inconsistency of this provision is what doomed it.

C. *Post-Tam Options for the Redskins, Indians and Braves (Even if they lost the mark, they still win!)*

Even if Mr. Tam had lost and *Blackhorse* was affirmed, it does not mean that established sports teams lose all their rights. In fact, as we will see, teams like the Redskins would still have been in the legal driver's seat.

Even before addressing that question, under U.S. trademark law, a trademark holder can use a mark even if it is not registered under the Lanham Act—the so-called “common-law” use.²⁵² As the district court aptly noted in its ruling of *Blackhorse*, the failure to register a trademark or the successful cancellation of a trademark does not mean there is no mark and no rights. For example, the Redskins utilized the team name well before the first marks were registered in 1967.²⁵³ The name is a part of the team's brand. It is known by millions of fans and non-fans. So, even if the Supreme Court upheld the disparagement provision, and as a result, the Redskins' marks were cancelled based on the district court's *Blackhorse* ruling, the venerable nature of the Redskins name and connection with the team would allow the team to retain common law trademark rights.²⁵⁴ The U.S. system of trademark law allows such use (though most countries do not) because of the “first use” system.²⁵⁵ Consequently, if some related business wishes to utilize the name—say a business owned by Native Americans selling T-shirts that state “Down with the NFL's Redskins” with a slash over the team's Native American logo, the NFL and the team still retain rights to enforce the mark if the

(Washington) Minor League baseball team, which is an affiliate of the MLB's Texas Rangers. See *The Official Site of the Cleveland Indians*, MLB.COM, <https://www.mlb.com/indians> (last visited Oct. 24, 2017); *The Official Site of the Spokane Indians*, MiLB.COM, www.milb.com/index.jsp?sid=t486 (last visited Oct. 24, 2017).

²⁵¹ The Seminoles is still used by Florida State University. See *Florida State Seminoles Official Athletic Site*, FLORIDA STATE UNIVERSITY, <http://seminoles.com/> (last visited Nov. 12, 2017).

²⁵² See 3 MCCARTHY *supra* note 36 § 19.9.

²⁵³ As noted earlier, the team started using the name in 1933. See *supra* note 135.

²⁵⁴ See Mark P. McKenna, *The Implications of Blackhorse v. Pro-Football, Inc.*, PATENTLYO BLOG, (June 19, 2014), <https://patentlyo.com/patent/2014/06/implications-blackhorse-football.html>.

²⁵⁵ See 2 MCCARTHY, *supra* note 36, § 16:18; see also, *Haviland & Co. v. Johann Haviland China Corp.*, 269 F. Supp. 928, 935 (S.D.N.Y. 1967) “[T]he basic premise [is] that a trademark is not acquired by registration. The right to a trademark stems from prior appropriation and use.”; 2 MCCARTHY, *supra* note 36, § 16:1 (Most civil nations utilize the first to file rule, which established trademark priority.).

team could argue likelihood of confusion or infringement.²⁵⁶ In addition, team owner Daniel Snyder and the NFL could still license that name (as registration is not so required) and reap financial awards because the NFL and the team would still retain common law rights, which trump any subsequent registration attempts by another party.²⁵⁷ What they would lack is certain rights (hardly unsubstantial) such as prima facie evidence of the validity of the registered mark, the registrant's ownership, and exclusive right to use the registered mark as well as statutory damages and the utilization of the government's power to seize goods bearing any of registered mark, since only goods bearing registered trademarks are subject to forfeiture.²⁵⁸

In addition, the NFL and the team can still file a claim under Section 43(a) of the Lanham Act²⁵⁹ for unfair competition due to a "false endorsement" of the Redskins name. This section is a federalization of state-based unfair competition standards,²⁶⁰ which was ultimately accepted by the Supreme Court in 1992²⁶¹ and later included as an amendment to the Lanham Act in 1999.²⁶² As Professor McCarthy stated: "[S]ection 43(a) has undergone an amazing transformation at the hands of the federal judiciary. [It] has risen from obscurity as a largely ignored subsection . . . to today's unrivaled legal instrument to combat unfair competition."²⁶³

Section 43(a) has been more frequently connected with the right of publicity in that someone is using a celebrity or athlete's name to sell

²⁵⁶ 2 MCCARTHY, *supra* note 36 § 19.3 (A failure to successfully register does not disturb existing state or federal unregistered rights in a mark).

²⁵⁷ 2 MCCARTHY, *supra* note 36 §16:18.50 ("Neither application for nor registration of a mark at the federal level wipes out the prior nonregistered, common law rights of others." (citation omitted)).

²⁵⁸ 3 *id.* § 19:9. These rights also include constructive notice of a claim of ownership so as to eliminate any defense of good faith adoption and use made after the date of registration. *See also* 19 U.S.C. § 1526 (2012).

²⁵⁹ 15 U.S.C. § 1125(a)(1) (2012). It provides: "(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act."

²⁶⁰ 1 MCCARTHY, *supra* note 36, § 1:19.

²⁶¹ *See* *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 776 (1992) (where the court interpreted Section 43(a) as having created a federal cause of action for infringement of unregistered trademarks). There was also a 1999 amendment that formally created a claim for infringement for trade dress under Section 43(a). *See* 15 U.S.C. § 1125(c) (2012).

²⁶² *See* 15 U.S.C. § 1125 (2012).

²⁶³ *See* J. Thomas McCarthy, *Lanham Act § 43(a): The Sleeping Giant is now Wide Awake*, 59 LAW & CONTEMP. PROBS. 45, 46 (1996).

goods.²⁶⁴ It centers on false endorsement, which occurs when a celebrity's identity is connected with a product or service in such a way that consumers are likely to be misled about the celebrity's sponsorship or approval of the product or service.²⁶⁵ Like a trademark infringement, it focuses on likelihood of confusion between the celebrity name/likeness or unregistered mark and the alleged "false" use. So, sports athletes or organizations like the Redskins or Indians could utilize this option. For example, if a Native American group decided to utilize the term "Redskins" in similar type and logo (along with a depiction of Native Americans) in order to contribute to a sports team featuring Native American youngsters, and sells t-shirts and football jerseys with that name and depiction, the NFL Redskins would have a viable claim under Section 43(a).

Before the Supreme Court's ruling, there was some debate as to whether a rejection or a cancellation under the disparagement clause would limit these rights, because a 2014 district court case refused to apply Section 43(a) to such a situation. However, that issue is now moot in the wake of *Tam*.²⁶⁶ However, even if the court upheld Section 2(a), this would be a difficult argument to win, as Section 43(a) makes it actionable to use "any word, . . . or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact" (emphases added).²⁶⁷

²⁶⁴ See 5 MCCARTHY, *supra* note 36, § 28:15; see also, *White v. Samsung Electrs. Am., Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1988) ("[Lanham Act § 43(a)] permits celebrities to vindicate property rights in their identities against allegedly misleading commercial use by others. . . . [C]ourts routinely recognize a property right in celebrity identity akin to that of a trademark holder under § 43(a)."); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 925 (6th Cir. 2003) (citing *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989)) (painting that depicted Tiger Woods winning his first Master's Tournament was sufficiently transformative to be protected under the First Amendment, and Section 43(a) should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression).

²⁶⁵ *ETW Corp.*, 332 F.3d at 925.

²⁶⁶ See *Renna v. County of Union*, 88 F. Supp. 3d 310 (D.N.J. 2014), (recognizing the general rule that unregistered marks are protectable under the federal trademark statute to the same extent as registered marks and holding that marks that are deemed unfit subjects for protection under section 2 of the federal trademark statute were similarly disqualified for protection under the general unfair competition section [section 43(a) of the same statute]). For more discussion, see Jim Liles & Bob Morgan, *The Redskins trademark decision - great media interest, overhyped reaction*, TECH. L. SOURCE (June 20, 2014), <http://www.technologylawsources.com/2014/06/articles/intellectual-property-1/the-redskins-trademark-decision-great-media-interest-overhyped-reaction/>.

²⁶⁷ See 15 U.S.C. § 1125(a)(1) (2012); see also Brief of Amicus Curiae on Behalf of the International Trademark Association in Support of Respondent, *Matal v. Tam*, 137 S. Ct. 1744 (2017) (No.15-1291). Professor McCarthy in his treatise also criticized this view. See 3 MCCARTHY, *supra* note 36, § 19:78 (criticizing the view that unregistrable marks are not actionable under section 43 of the Lanham Act, stating, "[t]here is no statutory or case law support for such a view.").

III. OPTIONS FOR THOSE WHO WISH TO CHALLENGE POTENTIALLY DISPARAGING TRADEMARKS

As a corollary to the section above, while the Redskins and Indians would retain rights even if they lost their registrations, they hold the cards now that Mr. Tam and his trademark were victorious. Clearly, *Matal v. Tam* limits the opportunities for those to challenge heretofore disparaging trademarks. Then, what other avenues are open to those who wish to object to registrations for Native American names and symbols (or for overt hate speech)? The options are not many, and the prospects of success are not bright.

A. *The Future of the “Scandalous and Immoral” Portion of Section 2(a)*

After *Matal v. Tam*, the first portion of Section 2(a) prohibiting registration on the basis of “immoral, deceptive, or scandalous matter” remained intact. However, that was short-lived because a few months later, the Federal Circuit rendered that portion unconstitutional. That court, in an opinion in *In re Brunetti*,²⁶⁸ concluded that the provision constituted content-based discrimination.²⁶⁹ Brunetti challenged the TTAB’s denial of the term “Fuct” on the grounds that it was scandalous subject matter.²⁷⁰ While the appeals panel admitted that the term was “vulgar” and subject to the “immoral and scandalous” provision of Section 2(a),²⁷¹ it nevertheless ruled that the provision was a content-based restriction on freedom of speech²⁷² and not a government subsidy.²⁷³ The opinion, penned by the same judge who wrote the en banc ruling in *Tam*, also ruled that strict scrutiny should be the standard because whether commercial or not, the speech “targets expressive conduct” despite the fact that a trademark “convey[s] a commercial message.”²⁷⁴ As a fallback position, the court ruled that even if the trademark is purely commercial, the restriction fails under the *Central Hudson* test.²⁷⁵ One concurring opinion noted that the provision should

²⁶⁸ See *In re Brunetti*, No. 2015-1109, 2017 U.S. App. LEXIS 25336 (Fed. Circ. Dec. 15, 2017).

²⁶⁹ *Id.* at *19.

²⁷⁰ See *In re Brunetti*, 2014 WL 3976439 (T.T.A.B. 2014).

²⁷¹ See *In re Brunetti*, *supra* note 268 at *8.

²⁷² *Id.* at *19. In fact, the government conceded the point.

²⁷³ *Id.* at *23 (“Trademark registration does not implicate Congress’ power to spend funds. An applicant does not receive federal funds upon the PTO’s consideration of, or grant of, a trademark.”).

²⁷⁴ *Id.* at *35 (“Trademarks certainly convey a commercial message, but not exclusively so. There is no doubt that trademarks “identify the source of a product or service, and therefore play a role in the ‘dissemination of information as to who is producing and selling what product, for what reason, and at what price. [citations omitted] However, trademarks—including immoral or scandalous trademarks—also “often have an expressive content.”).

²⁷⁵ *Id.* at *38–*47.

remain intact, but read narrowly to only include obscene material.²⁷⁶

Although it is very likely that this opinion would be accepted by other Federal Circuits, even if we assume that the immoral and scandalous clause is still good law, it would be difficult to apply this section to block a registration based on a Native American or another racial or ethnic group. In 2010, the USPTO declared that the proper ground for refusing registration to marks that would offend the sensibilities of an ethnic or religious group is not the “immoral or scandalous” bar, but rather is the disparagement section.²⁷⁷ Any attempts to challenge such marks were strictly based on that section.²⁷⁸

One of the TTAB rulings in *Harjo* noted that in deciding what is “scandalous” one looks at the reaction of American society as a whole to establish whether the proposed trademark violates social mores in such a manner and extent that it is “shocking to the sense of truth, decency or propriety,” or offensive to the conscience or moral feelings of “a substantial composite of the general public.”²⁷⁹ On the other hand, the panel noted, disparagement constitutes the “ordinary and common meaning” of “persons, living or dead, institutions, beliefs or national symbols” and also noted that intent is not required to make this determination.²⁸⁰ This statutory interpretation would have precluded this attempt to piggyback on that portion of Section 2(a) (assuming that it would remain enforceable).

B. *State Trademark Laws*

States have adopted their own trademark laws, often to cover situations where the registrant is not engaged in interstate commerce, but rather has a very localized business, like the logo of a small radio station. Although the great majority of states do not have a disparagement provision in their respective laws, at least one state does.

²⁷⁶ *Id.* at *60 (Dyk, J., concurring). This opinion took issue with Judge Moore’s view that there was no method of reading the immoral and scandalous clause narrowly.

²⁷⁷ See 3 MCCARTHY, *supra* note 36, § 19.77.

²⁷⁸ *Id.*

²⁷⁹ *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1738 (T.T.A.B. 1999) (citations omitted).

²⁸⁰ See *id.* (citations omitted), (“[T]he ‘ordinary and common meaning’ of the word ‘disparage’ has an entirely different focus, as disparagement has an identifiable object which, under Section 2(a) of the Trademark Act, may be ‘persons, living or dead, institutions, beliefs or national symbols.’” The panel added, “[a] further difference between scandalousness and disparagement is found in the language of Section 2(a). While Section 2(a) precludes registration of matter that is scandalous, it does not preclude registration of matter that is disparaging. It precludes registration of matter that may be disparaging. . . . Thus, we believe the use of the term ‘may’ is necessary in connection with ‘disparage’ in Section 2(a) to avoid an interpretation of this statutory provision that would require a showing of intent to disparage. Such a showing would be extremely difficult in all except the most egregious cases. Rather, this provision, as written, shifts the focus to whether the matter may be perceived as disparaging.”), *rev’d*, 284 F. Supp. 2d 96 (D.D.C. 2003).

In such cases, there is a question as to the disparagement provision's enforceability either by statute or administrative determination. Suffice it to say, challenges to those portions will be a matter of time.²⁸¹

For instance, Texas has a regulation prohibiting names that would be "deemed so grossly offensive as to be unacceptable as an entity name."²⁸² Another example, though not as directly on point, relates to the somewhat related issue of corporate business names. Pennsylvania enacted a statute prohibiting registrations that include words constituting "blasphemy, profane cursing or swearing or that profane the Lord's name in vain," but, not surprisingly, it was repealed after it was ruled unconstitutional.²⁸³ First Amendment considerations have already provided a basis for striking down corporate name filing prohibitions, and the *Tam* decision confirms the correctness of that position.

C. Abandonment

Once a trademark is deemed "abandoned" it falls into the public domain and is free for all to use.²⁸⁴ As a result, others may have rights to use and register that formerly protected trademark. However, there is a caveat: abandonment does not necessarily end trademark rights by the prior holder. A notable sports case involved the "Baltimore Colts" after the NFL team moved to Indianapolis, where the appeals court enjoined a Canadian Football team from using the term "Baltimore CFL Colts"²⁸⁵ because of public confusion. Despite the fact that the "Baltimore Colts" mark was abandoned, the team still existed in the same form (despite moving to a new city), and the new city name did not entitle the new Baltimore team to use the "Colts" mark.

²⁸¹ See Roberta Jacobs-Meadway & Tyler Harttraft, *The Potential Reach Of High Court's New Slant On Trademarks*, LAW360 (July 5, 2016 11:56 AM), <https://www.law360.com/articles/890345/the-potential-reach-of-high-court-s-new-slant-on-trademarks>.

²⁸² See 1 TEX. ADMIN. CODE § 79.33 (2017). In addition, Pennsylvania enacted a statute in 2015 prohibiting the registration of business entity names that included words constituting "blasphemy," "profane cursing," or taking the Lord's name in vain. 15 PA. STAT. AND CONS. STAT. ANN. § 202(c)(2)(ii) (West 2015). But, the statute but was quickly repealed after being found to violate both the Establishment Clause and Freedom of Speech Clause of the First Amendment. See Jacobs-Meadway & Harttraft, *supra* note 281.

²⁸³ See 15 PA. STAT. AND CONS. STAT. ANN. § 202(c)(2)(ii) (West 2015) (declared as a First Amendment violation in *Kalman v. Cortes*, 723 F. Supp. 2d 766, 806 (E.D. Pa. 2010)); See also Amicus Brief for Erik Brunetti in Support of Respondent, *supra* note 171.

²⁸⁴ See 3 MCCARTHY, *supra* note 36, § 17.1.

²⁸⁵ See *Indianapolis Colts, Inc. v. Metro. Baltimore Football Club Ltd. P'ship*, 34 F.3d 410, 413 (7th Cir.1994) (citations omitted) ("The Colts' abandonment of a mark confusingly similar to their new mark neither broke the continuity of the team in its different locations—it was the same team, merely having a different home base and therefore a different geographical component in its name—nor entitled a third party to pick it up and use it to confuse Colts fans, and other actual or potential consumers of products and services marketed by the Colts or by other National Football League teams, with regard to the identity, sponsorship, or league affiliation of the third party, that is, the new Baltimore team.").

It would be theoretically possible for the Redskins or the Indians to change their team names and end the use of the trademarks and logos. If that would be the case, and the teams and the respective leagues end all uses of those marks in connection with present or retro goods, then consider if a Native American rights group files for registration and uses the now-abandoned marks. The group, could, theoretically utilize the Redskins name and logo on T-shirts or other goods, including a slogan underneath (such as “Native American Rights—Let’s End This Image”) as items in commerce under trademark law. So, the new trademark holder would have protected rights to use these marks (as re-appropriation of what they feel is a derogatory term).

This scenario, however, is highly unlikely. First, it is doubtful that even if the Redskins or Indians change their names or the Indians ban Chief Wahoo, their rights to those marks end. Indeed, residual rights continue. That was what the court in *Colts* noted—that, in effect, the NFL Colts retained a priority due to the continuing association with the former mark.²⁸⁶ Despite changing attitudes, there will be still be a market for the “old” Native American marks, either through “retro” uniforms or through the sale of old uniforms through a secondary distributor like eBay. To make matters even worse, the Native American group, if it should choose, would likely have to register the mark under the same classification as the Redskins’ marks, adding to the likelihood of public confusion.²⁸⁷

D. Challenges on Claims of “Deception”

The Lanham Act contains provisions that permit the USPTO to refuse registration of a proposed mark that consists of “deceptive” matter or when used to “deceptively misdescribe” the goods in question.²⁸⁸ The USPTO’s Trade Trial and Appeal Board Manual of Procedure (“TBMP”) permits challenges to trademark applications by “natural and juristic person[s]” who believe they are damaged by the registration of that mark.²⁸⁹ Those grounds may include marks that are “deceptive,” “misdescriptive,” or “bringing an individual into disrepute.”²⁹⁰ Additionally, challenges can be made for marks based on

²⁸⁶ See 3 MCCARTHY, *supra* note 36, §17.2.

²⁸⁷ See Trademark Electronic Search System (TESS) Results of Washington Redskins, U.S. PATENT & TRADEMARK OFFICE, <http://tmsearch.uspto.gov/> (follow “Basic Word Mark Search (New User)” hyperlink; then search term for “Washington Redskins”). The team has trademarks registered in classes 19 (clothing) and 25 (entertainment services).

²⁸⁸ See 15 U.S.C. §§ 1052(a), (e) (2012).

²⁸⁹ Persons include a “firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.” U.S. PATENT & TRADEMARK OFFICE, Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 303.02 (June 2016).

²⁹⁰ U.S. PATENT & TRADEMARK OFFICE, Trademark Manual of Examining Procedure (TMEP) § 1203.02 (Oct. 2016).

“likelihood of confusion, deception or mistake.”²⁹¹ For example, say that the Redskins logo can be claimed as a “noble” image. A party could argue that such a justification is false, deceptive, or even fraudulent, given the general disdain for the term.

Many scholars have noted the constitutional tension between non-registration of marks on “deceptive” or “misleading” grounds and free speech.²⁹² Section 2(e) of the Lanham Act prohibited registration if the trademark is inherently deceptive or misleading, leading to potential infringement claims.²⁹³ As such, there should not be any constitutional defense to any form of commercial speech that is fraudulent. The problems, however, are how to determine what kind of trademark usage is misleading and whether such an infringing use can constitute a misleading use per se.²⁹⁴ In addition, the en banc ruling in *Tam* skirted the pigeonholing of trademarks as commercial speech, pointing to the commercial speech doctrine when the Court stated that prohibition on deceptive and confusing marks posed no constitutional problem.²⁹⁵ This begs the question of whether this would be the case if a trademark (or all trademarks) was not considered “commercial.”²⁹⁶

E. *Defamation and Broadcasting Regulations*

Could a disparaging name or logo be so offensive to particular members of a group as to lead one or more members to entertain a defamation claim? A successful action for libel or slander by members of a group of people is high unlikely. The Restatement of Torts notes the difficulty of applying laws that center on individual loss of reputation due to a false statement on a disparaging symbol for a group of people.²⁹⁷ One who publishes defamatory content about a group or class of persons is subject to liability to an individual member only (not the group per se) and that can only occur if the group is so small that the matter can reasonably be understood to refer to that member.²⁹⁸

²⁹¹ See, e.g., *James Burrough Ltd. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 276, n.16 (7th Cir. 1976).

²⁹² See Tushnet, *supra* note 29; see also Lockridge, *supra* note 97.

²⁹³ 15 U.S.C. § 1052(e) (2012).

²⁹⁴ Such questions are beyond the scope of what would be covered. For a full treatment, see Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 SMU L. REV. 381, 411–21 (2008). For example, such questions include: are all infringements tantamount to deceptive use, and is the standard of likelihood of confusion a pre-requisite to determine deception

²⁹⁵ See *In re Tam*, 808 F.3d 1321, 1329 (2015).

²⁹⁶ See Tushnet, *supra* note 29, for a thorough examination of the general conflict between trademark law and the First Amendment.

²⁹⁷ RESTATEMENT (SECOND) OF TORTS, § 564A cmt. A (AM. LAW INST. 1977).

²⁹⁸ See RESTATEMENT (SECOND) OF TORTS, § 564A (AM. LAW INST. 1977). See, e.g., *Neiman-Marcus Co. v. Lait*, 107 F. Supp. 96 (S.D.N.Y. 1952). A book that stated that “most of the [Neiman-Marcus] sales staff are fairies” and that some of the company’s saleswomen were “call girls” demonstrates the parameters of group libel. Fifteen of the twenty-five salesmen and thirty of the three hundred and eighty-two saleswomen at the store, along with the store itself, brought

Even disregarding any First Amendment issues inherent in this constitutionalized tort,²⁹⁹ trying to pin a term like “Redskins” to a group or even an individual would be a non-starter. It would be a stretch to determine falsity and damage to one’s reputation. And, on the subject of damages, trying to determine specific damages to those individuals bringing the lawsuit would be next to impossible. The only possibility to find damages would be if the logo of the team had disparaging characteristics of a particular person and was “of and concerning” a particular plaintiff. For example, the depiction of “Chief Wahoo” linked to an actual Native American who could then allege harm and loss of reputation, could conceivably be successful. In fact, there were several lawsuits alleging defamation focusing on the Chief Wahoo logo.³⁰⁰ One of them, filed in 1972, was settled.³⁰¹

Because over-the-air television and radio broadcasting has been subject to more content regulation than other media,³⁰² it has been argued that the Federal Communications Commission (“FCC”) could deny renewal of a broadcast license for “repeated and deliberate” use of the term “Redskins” or related references to Native Americans and other racial or ethnic groups on the air. One petitioner made such a claim in seeking to deny a radio station’s license renewal, based on his reading of the Communications Act’s restrictions on “obscene” and “profane” programming.³⁰³ The FCC, in denying the objection to the renewal, concluded that the term was not obscene nor profane under the

suit for defamation. *Id.* at 97. The court held that the salesmen had a valid cause of action, but the saleswomen did not because the group of salesman was small enough to refer to any individual member of the group. *Id.* at 100. The saleswomen were too large a group for the “call girls” statement to refer to any individual member of the group. *Id.*

²⁹⁹ See *N.Y. Times Co. v. Sullivan*, 376 U.S. 254 (1964) (public officials must prove actual malice); *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 348 (1974) (ruled that strict liability for defamation is unconstitutional for private figures and concluded that states require plaintiffs to prove a minimum of negligence, along with falsity).

³⁰⁰ Jessica Meiselman, *Beyond the World Series: “The Cleveland Team’s” Legal Battle*, THE WHITE BRONCO (Oct. 26, 2016), <http://thewhitebronco.com/2016/10/beyond-the-world-series-the-cleveland-teams-battle-in-court/>.

³⁰¹ *Id.* (“In 1972, the Cleveland American Indian Center sued the team for \$9 million for libel, slander and defamation stemming from the use of Chief Wahoo. The case settled out of court.”).

³⁰² See *Red Lion Broad. Co. v. FCC*, 395 U.S. 367 (1969).

³⁰³ See John F. Banzhaf III, Preliminary Formal Petition to Deny Renewal of Station’s FCC Broadcast License Pursuant to 47 U.S.C. §309(d) As Well As Any Other Applications, Motions, or Requests or, in the Alternative, an Informal Objection to All of the Above Primarily Because of Its Deliberate, Continued, and Unnecessary Broadcast, During Prime Time, of a Racist Racially Derogatory Word and its Deliberate Promotion of that Term by Other Broadcasters, In the Matter of Broadcast Station WWXX, 94.3 FM, (Sept. 2, 2014), https://licensing.fcc.gov/cgi-bin/prod/cdbs/forms/prod/getimportletter_exh.cgi?import_letter_id=53274 (“The agency would never countenance stations broadcasting words like “N*gg*rs, Sp*cs, W*tb*acks, Ch*nks, K*kes, C*nts, F*gs, etc., even as the name of a team or musical group. if the N-word (like all the others) is impermissible because it offends many blacks, the repeated and unnecessary use of the R-word should also be because it similarly offends many Indians.”).

Commission's meaning of those terms.³⁰⁴

F. Copyright

It may be possible to copyright the logo for the illustration of the Redskins or Chief Wahoo, as long as it is a creative work.³⁰⁵ Trademark and copyright law differ in conception and protection, as the goal of copyright is to protect the expression of an idea while the goal of trademark is to protect use of a word, phrase or logo.³⁰⁶ As copyright law does not have an anti-disparagement provision, one could copyright a book, film, photo or design that is racially or ethnically offensive. Although use is not necessary to maintain a copyright, public pressure could be brought to bear to prevent the copyright holder from using or licensing the work. Since the term of the copyright can last for the life of the creator plus seventy years, or ninety-five years for a work for hire,³⁰⁷ the reluctance of the copyright holder to use, assign or license the logo would be a de facto ban on its dissemination. Therefore, the owner can let it sit unused but still retain rights to it.³⁰⁸

G. Legislative Attempts—U.S. and International

There have been a few attempts to enact legislation to specifically restrict the use of Native American names and logos, but in light of the

³⁰⁴ See Letter from Peter H. Doyle, Chief, Audio Division Media Bureau, FCC, to John F. Banzhaf III (Dec. 18, 2014) (regarding Matter of Broadcast Station WWXX, 94.3). The letter stated: "Banzhaf does not allege that the term 'Redskins' depicts or describes sexual conduct in any way. Accordingly, we reject his argument that the term 'Redskins' is akin to obscenity." *Id.* at 2–3. The letter also rejected the profanity claim, stating, "While the Commission has 'recognize[d] that additional words, such as language conveying racial or religious epithets, are considered offensive by most Americans,' it made clear its intent 'to avoid extending the bounds of profanity to reach such language given constitutional considerations.'" *Id.* at 3 (footnote omitted).

³⁰⁵ See 1 McCarthy, *supra* note 36, § 6:17.50 ("In general, there is no reason why a given work cannot be the subject of both trademark and copyright protection. For example, pictures and logo designs used as marks are no less copyrightable pictures and designs merely because they appear on labels and in advertisements.")

³⁰⁶ See 1 McCarthy, *supra* note 36, § 6:3 ("Copyright law does not protect an idea, only the expression of an idea. Copyright deals with visual and aural expression and the communication of information and ideas reduced to tangible form.⁵ For example, an idea for a story about a historical event is not copyrightable—only the written expression is copyrightable.[citation omitted] Trademark law does not protect an idea for a using a certain designation as a mark. . . . Trademark rights grow out of use, not mere invention. To acquire ownership of a trademark, one must actually use the designation in the marketplace as a mark in the sale of goods or services.")

³⁰⁷ See 17 U.S.C. §§ 302(a),(c) (2012).

³⁰⁸ See *Sony Corp. of Am. v. Universal City Studios, Inc.* 464 U.S. 417, 451 (1984) ("[E]very commercial use of copyrighted material is presumptively an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright . . ."). Note that even a copyrighted work that is restricted is still subject to the "fair use" defense, as noted in 17 U.S.C. § 107 (2012).

court's conclusions in *Tam*, any such limitation would be invalidated. In 2015, a California congressman introduced legislation that would have denied trademark protection for sports teams that use a “derogatory slur” for Native Americans as their nickname.³⁰⁹ Local governmental bodies in Washington, D.C. and Cleveland considered resolutions criticizing the Redskins and Indians, respectively.³¹⁰

Since Major League Baseball has one team in Canada,³¹¹ Canadian law may be utilized to restrict the use of a potentially disparaging mark. A complaint in the Ontario Human Rights Tribunal was filed against the Cleveland Indians, alleging that the name and Chief Wahoo logo constituted a violation of the province's Human Rights Code.³¹² A tangential, but theoretical, possibility may occur if the NFL establishes a franchise in the United Kingdom or continental Europe. Then domestic European law and/or international treaties may apply in preventing those marks from protection in countries where the teams may play.

International trademark registration of the Redskins or Indians could be problematic. The venerable Paris Convention allows governments to deny registration to trademarks that are “contrary to morality or public order.”³¹³ One can argue that this includes refusing to register words or symbols that may offend or be demeaning to people who are members of certain racial, ethnic, indigenous, or religious groups.³¹⁴ Members of the World Trade Organization (“WTO”) may enact restrictions on registration for “immoral” marks, which have been

³⁰⁹ Ian Shapira, *California congressman wants to bar federal trademark protection for 'Redskins'*, WASH. POST, (Feb. 4, 2015), https://www.washingtonpost.com/news/local/wp/2015/02/04/california-congressman-wants-to-bar-federal-trademark-protection-for-redskins/?utm_term=.bf055c6bb4fa. The legislation, introduced by Representative Mike Honda, a Democrat from California, was titled The Non-Disparagement of Native American Persons or Peoples in Trademark Registration Act.” H.R. 1278, 113th Cong. (2013).

³¹⁰ In 2013, the Washington D.C. City Council approved a resolution stating that the use of the term “redskin” was “racist and derogatory” but did not carry any penalties for the use. See M. DeBonis & A. Davis, *D.C. Council calls on Redskins to ditch 'racist and derogatory' name*, WASH. POST (Nov. 5, 2013), https://www.washingtonpost.com/local/dc-politics/dc-council-calls-on-washington-redskins-to-ditch-racist-and-derogatory-name/2013/11/05/17cbbd66-4646-11e3-bf0c-cebf37c6f484_story.html?utm_term=.e2af4dba593b. In 2014, an Ohio state senator introduced a resolution to “encourage” the Cleveland Indians to change their name and mascot, which failed to pass. See Blanks, *supra* note 7, at 16; see also *supra* note 61.

³¹¹ See *The Official Site of the Toronto Blue Jays*, MLB.COM, <https://www.mlb.com/bluejays> (last visited Nov. 12, 2017).

³¹² See generally Human Rights Code, R.S.O. 1990, c. H.19 1990 (Can.); *Cardinal v. Cleveland Indians Baseball Co.*, 134 O.R. 3d 6929 (Can. Ont. Sup. Ct.) (dismissing claims alleging discrimination in goods and services because claimant failed to complete required form).

³¹³ See Paris Convention for the Protection of Industrial Property, art. 6bis, Mar. 20, 1883 (revised July 14, 1967), 21 U.S.T. 1583.

³¹⁴ See Lisa P. Ramsey, *A Free Speech Right to Trademark Protection?*, 106 TRADEMARK REP. 797 (2016).

known to include those which disparage groups of people.³¹⁵ The North American Free Trade Agreement (“NAFTA”), which created a free trade zone between the United States, Canada and Mexico, also includes a provision that is very similar to Section 2(a).³¹⁶ In the wake of *Tam*, one wonders about the viability of this section, since the portion dealing with U.S. trademarks has no force, creating inconsistent enforcement, as it would presumably remain enforceable against Canada or Mexico. Professor Ramsey aptly noted that this issue was not addressed in the various courts’ opinions in the *Tam* cases.³¹⁷

With the exception of the United States, the near universality of this kind of ban of offensive marks and its application to disparaging terms through interpretation or actual text could give rise to an argument that it has become a rule of customary international law.³¹⁸ In addition, the domestic trademark laws of a number of countries include restrictions against “immoral” marks based on human rights principals. Examples include Chile, Egypt, Mexico, Japan, Russia, China, and Great Britain.³¹⁹ Australia’s law is more specific, as it bans registrations that are “likely to offend a significant section of the community.”³²⁰ In addition, the concept of freedom of expression is not as all-encompassing as that of the United States, where even hate speech is protected. In many countries, broad freedoms of expressions can be limited when it “promotes hatred against certain groups.”³²¹

The *Tam* ruling opens up a gap between the United States and the international community. Under the Madrid Protocol, a U.S. trademark holder can file for trademark protection in one hundred and fourteen countries. However, those countries can reject the application under

³¹⁵ *Id.* at 811; *see also*, Agreement on Trade-Related Aspects of Intellectual Property Rights arts. 16(2), (3), Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, , 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994), (the TRIPS Agreement).

³¹⁶ *See* North American Free Trade Agreement, art. 1708(14), Can.-Mex.-U.S., Dec. 17, 1992, 32 I.L.M. 289, 673 (entered into force Jan. 1, 1994); *see also* Ramsey, *supra* note 314 at 812.

³¹⁷ *See* Ramsey, *supra* note 314, at 812.

³¹⁸ Customary international law is defined as a general practice of international norms, as defined by custom. *See* Statute of the International Court of Justice, art. 38(1)(b), 1 I.C.J. Acts & Docs 26, http://legal.un.org/avl/pdf/ha/sicj/icj_statute_e.pdf.

³¹⁹ *See* Law No. 19039 art. 20(k), Enero 26, 2007, DIARIO OFICIAL [D.O.] (Chile); Law No. 82 of 2002 (Law on the Protection of Intellectual Property Rights), *al-Jaridah al-Rasmiyah*, vol. 22 bis, 2 June 2002, art. 67(2) (Egypt); Nomos (2012:4072) [Trademark Law No. 4072/2012], [EPHEMERIS TES KYVERNESEOS TES HELLENIKES DEMOKRATIAS] [E.K.E.D.] 2012, A:86 (Greece); Shōhyō-hō [Trademark Act], Law No. 127 of 1959 (as amended up to the revisions of Act No. 55 of 2015), art. 4(1)(vii), translated in Trademark Act (Act No. 127 of Apr. 13, 1959) (Japan); Ley de la Propiedad Industrial [LPI] art. 4, Diario Oficial de la Federación [DOF] 27-06-1991, últimas reformas DOF 28-06-2010 (Mex.); Mexico’s other trademark registration provisions are set forth in Article 90; Grazhdanskii Kodeks Rossiiskoi Federatsii [GK RF] [Civil Code] art. 1483(3)(2) (Russ.); Trade Marks Act 1994, c. 26, § 3(3)(a) (U.K.) (as discussed in Ramsey, *supra* note 314 at 813–814, n.50–56, 58).

³²⁰ *See* Trade Marks Act 2002, sub 17(1)(c) (N.Z.).

³²¹ *See* R. v. Keegstra, [1990] 3 S.C.R. 697 (Can.).

their domestic trademark laws and, given the broad policy—both expressed in treaties and local law—it is likely that most nations would reject a now-permitted disparaging mark registered with the USPTO.³²²

Although it is too early to say for sure, it is possible that those marks would have no protection in the many countries which would deny registration—a big deal, as most countries require filing and reject common law use. Also, groups that oppose those symbols could sell merchandise with those marks (employing them in a negative way or as part of their agenda to rid these symbols). Could a Canadian Native American organization sell shirts with the slash over the Redskins' symbol? Or in another country? It is very possible.

Additionally, there is the question of whether one could use those symbols at all. This is a broader question of freedom of speech. While most nations would allow the sale and distribution of disparaging marks, some nations may restrict the name, symbol, or logo outright.³²³

H. *Extra-Legal Attempts to Forcing Change*

There is no question that the Supreme Court's *Tam* ruling ends the threats to cancel or deny registrations for trademarks depicting Native Americans or others in the United States. However, while the opponents of such trademarks may not have the law on their side, they could have the court of public opinion to help them. The success of changing such names on college teams has been previously noted.³²⁴ The result can also impact the leagues, which license their merchandise and share the revenues derived from sales. In what could be a bad omen, sales of Redskins' merchandise dropped by forty-three percent in 2014 (when the USPTO canceled the registrations of six Redskins' marks and before the district court in *Harjo* overturned that ban) compared to sales the preceding year.³²⁵ In addition, fifty U.S. Senators sent an open letter to

³²² See Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, arts. 2, 5, June 27, 1989, S. TREATY DOC. NO. 106-41(2000).

³²³ For example, Germany outlaws that use of the swastika. See STRAFGESETZBUCH [StGB] [Penal Code], § 86a (outlaws the distribution or public use of symbols of unconstitutional groups, in particular, flags, insignia, uniforms, slogans and forms of greeting), <http://www.iuscomp.org/gla/statutes/StGB.htm#86a>. In 2006, an interesting twist to this issue occurred when the city of Stuttgart considered filing charges against a mail-order company, which specializes in anti-fascist paraphernalia and designed merchandise with a crossed-out swastika reminiscent of a no-parking sign or a little stick person throwing a swastika into a garbage can. See Sabina Casagrande, *Stuttgart Seeks to Ban Anti-Fascist Symbols*, DEUTSCHE WELLE (Apr. 4, 2006), <http://www.dw.com/en/stuttgart-seeks-to-ban-anti-fascist-symbols/a-1952743>. The case, which was eventually thrown out, caused a nationwide controversy, with the head of the country's Green Party reporting herself to the police for wearing a crossed-out swastika button in protest. See Joshua Keating, *Germany Banned Its Ugly Historic Symbols. Should We Do That Too?*, SLATE (June 24, 2015), http://www.slate.com/blogs/the_slatest/2015/06/24/germany_banned_its_ugly_historic_symbols_should_we_do_that_too.html.

³²⁴ See *supra* note 27.

³²⁵ See Chris Isidore, *Redskins Gear Stiff-Armed by Fans*, CNNMONEY.COM (Sept. 4, 2014),

NFL Commissioner Roger Goodell urging him to recommend a name change for the team.³²⁶ Although there has been pressure to change the Washington Redskins' name, owner Daniel Snyder has adamantly refused.³²⁷ It has yet to be determined if pressure from Native American groups and others will ultimately force his hand or lead to pressure from the NFL or other owners for him to do so.

Gradually, the Cleveland Indians' ownership decided to limit the prominence of the "Chief Wahoo" logo (which it will abandon in 2019), possibly due, in part, to the effect of demonstrations that have greeted the team on its opening home game for over a quarter-century.³²⁸ Another incremental change is seen in Topps' policy regarding its new and retro baseball cards.³²⁹ The company dropped Chief Wahoo from Indians card designs as well as the old Braves "screaming Indian" logo (which has long been discarded by the team).³³⁰ In 2005, the American Psychiatric Association advocated for a broader ban, passing a resolution recommending the "immediate retirement of all American Indian mascots, symbols, images, and personalities by schools, colleges, universities, athletic teams, and organizations" based on its conclusion that such symbols cast a "negative impact on the self-esteem of American Indian children."³³¹

<http://money.cnn.com/2014/09/04/news/companies/redskins-merchandise/>.

³²⁶ See Maya Rhodan, *50 Senators Demand Washington Redskins Change Their Name*, TIME (May 22, 2014), <http://time.com/108893/washington-redskins-name-senators/>.

³²⁷ See *Redskins President Says Team Won't Change Name Even if it Hinders New Stadium Options*, USA TODAY, (Aug. 17, 2015, 11:10 AM), <https://www.usatoday.com/story/sports/nfl/redskins/2015/08/17/redskins-president-dismisses-name-change--dc-stadium/31842361/>.

³²⁸ See Nicole Bogart, *Change Their Name? A History of Protest Over Chief Wahoo*. GLOBAL NEWS, (Oct. 12, 2016, 1:29 p.m.), <http://globalnews.ca/news/2998193/should-the-cleveland-indians-change-their-name-a-history-of-protest-over-chief-wahoo/>. ("Over the years the team has scaled back the use of Chief Wahoo. Before the start of the 2016 season, Indians owner Paul Dolan announced that the team would use a block letter "C" as its main logo, instead of the chief's face. Only a small glimpse of Wahoo can be seen on players' sleeves . . . Banners and promotional material at Progressive Field, the team's home stadium, often exclude Wahoo's image. In fact, Chief Wahoo is notably missing from the entire team history section on the Indians' official MLB website."). More recently, under pressure from Major League Baseball, the team decided to end the use of the logo in the 2019 season. In a statement, MLB Commissioner Rob Manfred said that the team "ultimately agreed with my position that the logo is no longer appropriate for on-field use in Major League Baseball, and I appreciate [principal owner] Mr. Dolan's acknowledgment that removing it from the on-field uniform by the start of the 2019 season is the right course." See David Waldstein, *Cleveland Indians will Abandon Chief Wahoo Logo Next Year*, N.Y. TIMES (Jan. 29, 2018), <https://www.nytimes.com/2018/01/29/sports/baseball/cleveland-indians-chief-wahoo-logo.html?rref=collection%2Fsectioncollection%2Fsports&action=click&contentCollection=sports®ion=rank&module=package&version=highlights&contentPlacement=1&pgtype=sectionfront>.

³²⁹ See Craig Calcaterra, *Topps Has Eliminated Chief Wahoo From Both New and Throwback Card Designs*, NBC Sports (July 21, 2017, 1:44 PM), <http://mlb.nbcsports.com/2017/07/21/topps-has-eliminated-chief-wahoo-from-both-new-and-throwback-card-designs/>.

³³⁰ *Id.*

³³¹ See American Psychological Association, *APA Resolution Recommending the Immediate*

One way to show displeasure at the continued use of Native American names (or at least ones that are deemed particularly derogatory) involves attempts by sports writers and broadcasters to refrain from using those particular names, instead using general descriptive terms such as the “Washington Football Team” or the “Cleveland” or “Atlanta” baseball teams to make their point.³³² In recent years, a Toronto Blue Jays announcer did not use “Indians” during a baseball league championship series,³³³ and commentators Tony Dungy, Phil Simms, and Bob Costas refrained from using “Redskins” during the 2014 NFL season.³³⁴

Yet, one should not underestimate the arguments against a name change. Despite an impressive array of Native American groups and civil rights organizations that back a change,³³⁵ significant opposition exists. Changing the names of the Redskins, Indians, (Kansas City) Chiefs, and Chicago Blackhawks³³⁶ would alter the brand identity for the teams, and many fans would resent the actions, some claiming it as a form of political correctness run amok.³³⁷ It also could be seen as an overreaction. Recently, a writer for the *Washington Post* reversed his position and began to re-use the Redskins name on the basis of a 2016 *Washington Post* poll that concluded 90% of Native Americans did not object to the name.³³⁸ This result is similar to a 2004 poll by the

Retirement of American Indian Mascots, Symbols, Images, and Personalities by Schools, Colleges, Universities, Athletic Teams, and Organizations, (2005), <https://www.apa.org/about/policy/mascots.pdf>.

³³² See, e.g., Joseph Flynn, *Blue Jays Announcer Jerry Howarth Won't Say "Indians" During ALCS*, Vice Sports (Oct. 12, 2016 1:34 PM), https://sports.vice.com/en_us/article/bmq4em/blue-jays-announcer-jerry-howarth-wont-say-indians-during-alcs.

³³³ *Id.*

³³⁴ See Blanks, *supra* note 7, at 20-21.

³³⁵ See *List of Washington Redskins Name Change Advocates*, WIKIPEDIA, https://en.wikipedia.org/wiki/List_of_Washington_Redskins_name_change_advocates#cite_note-113 (last visited Nov. 14, 2017).

³³⁶ The Blackhawks have been able to escape the controversy over the use of their name, in part, due to the fact that ice hockey does not have the level of popularity of football or baseball in the United States. However, the Blackhawks are a venerable team, one of the “Original Six” NHL teams and have utilized their logo—a Sauk Indian from Virginia named Ma-ka-tai-me-she-ki-kiak, otherwise known as Chief Black Hawk, who ironically, fought to keep his people in the State of Illinois. See Steve Inskeep, *How Is the Blackhawks' Name Any Less Offensive Than the Redskins'?*, THE ATLANTIC (June 19, 2015), <https://www.theatlantic.com/entertainment/archive/2015/06/blackhawks-redskins-name/396356/>.

³³⁷ See Scott Allen, *Mike Ditka says Redskins name debate is 'so stupid it's appalling'*, WASH. POST (Aug. 19, 2014), https://www.washingtonpost.com/news/dc-sports-bog/wp/2014/08/19/mike-ditka-says-redskins-name-debate-is-so-stupid-its-appalling/?utm_term=.d8da11a294f4.

³³⁸ See Robert McCartney, *I'm dropping my protest of Washington's football team name*, WASH. POST (May 20, 2016), https://www.washingtonpost.com/opinions/im-dropping-my-protest-of-washingtons-football-team-name/2016/05/19/b09e8e7e-1cfe-11e6-8c7b-6931e66333e7_story.html?utm_term=.f51d00b822a5 (He writes that he personally would not use the name nor buy the team's gear, and he refrains from using the term on air. Nevertheless, he states, “it feels presumptuous for us to say we know Indians' interests better than they do. We

Annenberg Institute.³³⁹ This view relates back to the en banc opinion by the Federal Circuit in *Tam*, rejecting the idea of a litmus test as to what is “disparaging” and what is not, permitting society, rather than the legislature, to make that determination. It also calls into question what a “composite” of a group is that could make a determination as to what should or should not be trademarked.³⁴⁰

IV. QUESTIONS AFTER *TAM*

A. *Commercial v. Non-Commercial Basis*

Justice Alito did not resolve—but opened the door—to more philosophical questions: whether the different standards of commercial versus non-commercial makes sense at a time when the boundaries between “pure” expression and business-based speech are more and more artificial and whether the balance of First Amendment rights and trademark regulations should be justified under the assumption that they are inherently commercial. He considered these questions in a backhanded way. As Professor Lederman notes, in his plurality opinion, “[Justice Alito] appears to be implying that trademark restrictions are subject to commercial speech ‘*Central Hudson* review’ at a *minimum*.”³⁴¹ However, the court could have chosen to address the issue of relative First Amendment jurisprudence dividing commercial versus non-commercial speech but did not have to confront the issue because the government interests were so minimal in this case and failed under the more permissive *Central Hudson* test.

It is possible that this was the reason Justice Alito (and, to an extent, Justice Kennedy in his concurrence) only cursorily discussed commercial speech, focusing more on government speech and (in a concurrence) on viewpoint discrimination. The one justice who did

can’t credibly claim that 9 out of 10 Indians somehow just don’t realize they’re being insulted. Some Indians told The Post that they actively support the name, because its use means Native Americans haven’t been forgotten. In light of the new facts, we non-Indian critics should stop pressing the team to change its name. We should drop the cause, even if we privately dislike the moniker. We shouldn’t let the name stand in the way of building a new stadium. If we really want to help Indians, we should instead advocate for better schools, job opportunities and social services for them.”)

³³⁹ See *Most Indians Say Name of Washington ‘Redskins’ Is Acceptable While 9 Percent Call It Offensive*, ANNENBERG PUB. POL’Y CTR. (Sept. 24, 2004), <http://www.annenbergpublicpolicycenter.org/most-indians-say-name-of-washington-redskins-is-acceptable-while-9-percent-call-it-offensive>.

³⁴⁰ See *Tam*, 808 F.3d at 1341-42 (“The uncertainty as to what *might be deemed* disparaging is not only evident on its face, given the subjective-reaction element and shifting usages in different parts of society.”)

³⁴¹ See Marty Lederman, *Some Preliminary Thoughts on Matal v. Tam, Trademarks, and the First Amendment*, BALKANIZATION (June 20, 2017), <https://balkin.blogspot.com/2017/06/some-preliminary-thoughts-on-matal-v.html>.

address the core speech issue was Justice Thomas. In his short concurrence, he proposed the end of this increasingly artificial division,³⁴² a view he has also expressed in other rulings.³⁴³

This unresolved question is significant for general First Amendment jurisprudence, and it is particularly important for trademark law. Do all trademarks constitute commercial speech? Do some fall directly into the commercial speech category while others do not? Or, is it best to simply eliminate the distinction, granting the same (or almost the same) First Amendment rights as non-commercial speech? The implications could be significant for the future of trademarks.³⁴⁴

I think the day may be coming when the courts will abandon this distinction in constitutional cases involving trademarks (and possibly all forms of commercial speech, but that would be the subject for another article).³⁴⁵

B. *The Definitional Conundrum*

Over the years, the courts have had a difficult time defining exactly what “commercial” means. Some courts have noted that it is speech that “does no more than propose a commercial transaction,”³⁴⁶ while others have described it as “expression related solely to the economic interests of the speaker and its audience.”³⁴⁷ As noted earlier, some justices have expressed reservations about the continued existence of a separate commercial speech standard,³⁴⁸ with one court cautioning

³⁴² *Matal v. Tam*, 137 S. Ct. 1744, 1769 (Thomas, J., concurring).

³⁴³ See e.g., 44 *Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 518 (1996) (Thomas, J., concurring) (rejecting the *Central Hudson* test in a case involving a state ban on the advertising of retail liquor prices).

³⁴⁴ One issue not addressed in this article is that of trademark dilution, but it is worth a passing mention as it is very commercial-speech centric. Congress explicitly excluded “any noncommercial use of a mark” from coverage of the Federal Trademark Dilution Act of 1995 (“FTDA”) and the Trademark Dilution Revision Act of 2006 (“TDRA”) See Pub. L. No. 104-98, 109 Stat. 985 (1995) (codified at 15 U.S.C. § 1125(c)). 134. Pub. L. No. 109-312, 120 Stat. 1730 (2006) (amending 15 U.S.C. § 1125(c)); 15 U.S.C. § 1125(c)(3)(C) (2006). For more explanation, see Ramsey, *supra* note 314, at 411. There is no definition of dilution in these statutes, but one court defined it as “the gradual whittling away of the trademark’s distinctiveness through use by third parties on nonconfusing, noncompeting products.” See *Hyatt Corp. v. Hyatt Legal Services*, 736 F.2d 1153, 1158 (7th Cir. 1984). Moreover, Professor McCarthy explains that it “looks at the response of the trademark owner, asking whether the value of the mark will be diminished by someone else using a mark similar to the first mark.” See 2 MCCARTHY, *supra* note 36, § 11.22.

³⁴⁵ The history of commercial speech jurisprudence is one of definitional complexity and difficulty in applying the *Central Hudson* test. For a detailed discussion on this issue, see Ramsey, *supra* note 314.

³⁴⁶ See *Bolger v. Youngs Drugs Prods. Corp.*, 463 U.S. 60, 66–68 & n.13 (1983) (holding that informational pamphlets on topics such as “Condoms and Human Sexuality” were commercial speech).

³⁴⁷ See *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557, 561 (1980).

³⁴⁸ See *Matal v. Tam*, 137 S. Ct. 1744, 1769 (2017) (Thomas, J., concurring); see also *Greater New Orleans Broadcasting Ass’n, Inc. v. United States*, 527 U.S. 173, 197 (1999) (Thomas, J., concurring) (“there is no philosophical or historical basis for asserting that ‘commercial’ speech is of ‘lower value’ than ‘noncommercial’ speech.”); 44 *Liquormart v. Rhode Island*, 517 U.S. at

that courts must be careful not to “place too much importance on the distinction between commercial and noncommercial speech.”³⁴⁹

This uncertainty applies to trademarks. Admittedly, in many, if not most registrations, the trademark is clearly commercial speech. Billboards with ads hawking the “good taste” of a particular brand of cigarette constitute commercial speech. TV commercials selling a particular brand of soap are clearly commercial. But others may have a non-commercial basis. What about advertisements by companies intended to extoll the benefits of their firms, like in helping the environment or refuting claims that they exploit foreign workers? The California Supreme Court issued a sharply divided opinion concluding that the speech was commercial even though it dealt with refuting claims of poor worker conditions.³⁵⁰ That case, *Kasky v. Nike*, serves as an apt demonstration of the difficulty in drawing a line between what is commercial versus what is non-commercial.³⁵¹ If commercial speech is defined as speech that does not do more than propose a commercial transaction, then what about those who may buy an item from a famous brand for the reason of making a political statement? Consider an environmentally conscious high-tech company sells T-shirts with the phrase “Less Paper—More Trees” accompanied by a small logo of the firm. Also consider mixed speech—speech that has both commercial and non-commercial elements. Courts cannot easily split which part of the speech is commercial or not, so they ruled that the speech was non-commercial and subject to the higher standard of scrutiny as long as the commercial and non-commercial aspects were “intertwined.”³⁵²

501, 510–14 (Justice Stevens, writing for a plurality of the Court, said when the government “entirely prohibits the dissemination of truthful, nonmisleading commercial messages . . . there is far less reason to depart from the rigorous review that the First Amendment generally demands.”). For more explanation, see Ramsey, *supra* note 314, at 394.

³⁴⁹ See *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 422–23 (1993).

³⁵⁰ See *Kasky v. Nike*, 45 P.3d 243 (2002) (In that case, the court held, by a four to three majority, corporation’s false statements are commercial and subject to state law barring false and misleading messages, even though they dealt with labor conditions in the firm’s factories, rather than the direct sale of their products.). The dissenting opinions strongly disagreed, concluding that Nike’s statements were not traditional commercial speech, but rather statements of public concern. *Id.* at 263, 268. “Nike’s statements regarding its labor practices in China, Thailand, and Indonesia provided vital information on the very public controversy concerning using low-cost foreign labor to manufacture goods sold in America. Nike’s responses defended against adverse reports that its overseas manufacturers committed widespread labor, health, and safety law violations. Far from promoting the sale of its athletic products . . .”) *Id.* at 265.

³⁵¹ *Id.*

³⁵² See *Vill. of Schaumburg v. Citizens for a Better Env’t*, 444 U.S. 620, 632 (1980) (“because charitable solicitation does more than inform private economic decisions and is not primarily concerned with providing information about the characteristics and costs of goods and services, it has not been dealt with in our cases as a variety of purely commercial speech.”); see also *Nat’l Fed’n of the Blind v. Riley*, 487 U.S. 781, 796 (1988), (concluding that noncommercial, fully protected speech of charitable solicitation was “inextricably intertwined” with the mandated commercial speech, leading to full protection for all of the speech). For a more detailed discussion of this issue, see Lockridge, *supra* note 97, at 357–59.

Think, once again, of *The Slants* case. The goals of “The Slants” trademark were analogous to the mixed use cases noted above. As Simon Tam makes clear, he wanted to make a political point but also wanted to use the term in commerce to identify the band.³⁵³ And he is certainly not the only one. Charities, non-profit organizations, educational organizations, and other non-business organizations use trademarks. Political organizations have also trademarked their terms.³⁵⁴ Each of these situations is a far cry from creating a name and logo for a brand of soap.

But, even assuming that a precise definition of commercial speech is utilized (and assuming the Supreme Court someday crafts one), the application to trademarks presents an additional level of difficulty. Should trademark law adopt this distinction between products limited to a “commercial purpose” and products that may have certain commercial or pecuniary uses but also involves a broader scope?

I wonder if the International Trademark Association (“INTA”) foresaw this problem when it filed its amicus brief to the Supreme Court. As the largest organization for trademark professionals in the United States and the world,³⁵⁵ INTA has a very strong interest in protecting trademarks as part of cohesive system for registration and enforcement. As a result, arguing in favor of the constitutionality of Section 2(a) would be presumed. But this was not so—the INTA’s brief argued that the disparagement clause, as written *was* unconstitutional as void for vagueness under the Fifth Amendment of the Constitution as it provides “little guidance” for trademark examiners and potential registrants.³⁵⁶

The brief proposed a middle ground. It rejected the government speech status of trademark registration, (not a big surprise), but unlike the holding in the Federal Circuit’s en banc ruling in *Tam*, INTA advocated that trademarks are squarely commercial speech, even if they may have non-commercial elements. Therefore, INTA argued, trademark laws are only subject to intermediate scrutiny, thereby rejecting a strict scrutiny analysis just because the band’s purpose for

³⁵³ See Email from Simon Tam, *supra* note 49.

³⁵⁴ See Ramsey, *supra* note 314, at 396, n.96 (citing Registration No. 3,166,180), (mark registered by MoveOn.org Civil Action Corporation for “Organizing, planning, arranging and conducting events relating to politics, political campaigns, media relations, public policy, leadership, networking, and the legislative process”).

³⁵⁵ Founded in 1878, the International Trademark Association (“INTA”) is a not-for-profit global organization dedicated to the support and advancement of trademarks and related intellectual property. INTA has more than 7,000 member organizations from 190 countries. Its members include trademark and other brand owners, as well as law firms and other professionals who regularly assist brand owners in the creation, registration, protection, and enforcement of their trademarks. See Brief of Amicus Curiae on Behalf of the International Trademark Association in Support of Respondent, *Lee v. Tam*, 137 S. Ct. 30 (2016) (No.15-1291).

³⁵⁶ *Id.* at 7–8.

utilizing the “Slants” name was “intertwined” with non-commercial elements.³⁵⁷ Consequently, INTA wanted a viable and more precisely defined Section 2(a) of the Lanham Act. In reality, this would be a tough row to hoe. Disparaging names utilized for “mixed use” purposes could potentially invoke strict scrutiny and result in courts utilizing general “hate speech” jurisprudence to ban such restrictions.³⁵⁸

C. A Possible New Test

First Amendment balancing tests have been utilized in areas such as defamation³⁵⁹ and “false light” privacy.³⁶⁰ For public figures, the standards for these traditional common law causes of actions are constitutionalized, giving defendants a presumption of First Amendment protection unless it can be determined by clear and convincing evidence that “malice” was shown.³⁶¹ I have proposed a somewhat similar constitutional immunity in the area of right of publicity.³⁶²

This idea dovetails Circuit Judge Dyk’s concurring opinion in the Federal Circuit’s en banc *Tam* ruling.³⁶³ Writing for himself and two other judges, he admitted that Section 2(a) should not “tolerate” offensive trademarks in cases where the trademark is “purely commercial” but should not be applied to “core” political speech, such as Tam’s trademark.³⁶⁴ Many trademarks lack the kind of “expressive character” that would merit First Amendment protection for offensive content.³⁶⁵ Therefore, the intermediate scrutiny of *Central Hudson*

³⁵⁷ *Id.* at 15–26 (“No law or man or nature makes it impossible to name a musical group without making a social statement on bigotry, or to make a social statement on bigotry without naming a musical group. Nothing in Section 2(a) prevents Mr. Tam from conveying, or his audience from hearing, his social message.”)

³⁵⁸ See *R. A. V. v. City of St. Paul*, 505 U.S. 337, 402–03 (1992).

³⁵⁹ See generally *N.Y. Times Co. v. Sullivan*, 376 U.S. 254 (1964).

³⁶⁰ False light privacy is a ambiguous hybrid between defamation and privacy, but the area is one of the few in privacy to have a set constitutional test. Invasion of privacy by “false light” involves a publication which places plaintiff in a false light highly offensive to a reasonable person. See 1 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 5:112 (2d ed. 2017). However, a false light case does not involve a false statement per se, but it does involve a false inference or imputation that is “of and concerning” the plaintiff. Because of its close proximity to defamation, the Supreme Court in *Time, Inc. v. Hill* applied the *N. Y. Times* malice test to public figures who may claim invasion of privacy under the “false light” category. *Time, Inc. v. Hill* 385 U.S. 374 (1967).

³⁶¹ See *Time, Inc.* 385 U.S. 374

³⁶² See Conrad, *supra* note 19, at 798–99, 807. The standard proposed would be that the right of publicity would overcome a First Amendment defense if it involved a “sole commercial purpose.” If not, then the speech would be constitutional protected unless there was an element of malice that could be determined.

³⁶³ *In re Tam*, 808 F.3d 1321, 1363 (Fed. Cir. 2015) (Dyk, J., concurring in part and dissenting in part).

³⁶⁴ *Id.* at 1364.

³⁶⁵ *Id.* at 1368.

would serve as an effective standard.³⁶⁶

But that test—while on the right track and within the contours of present First Amendment jurisprudence—does not quite address the issue of what exactly is and is not commercial, noting the less than precise definition of “commercial” by the courts over the years.³⁶⁷ Yet, in the majority of cases, trademarks are simply considered brand identifiers with no political or social commentary. Nonetheless, there are two potential problems. First, this divide does not give a demarcation of how many “non-commercial attributes” a mark has to have to be “pure speech” nor does it deal with what would happen if the commercial speech doctrine comes to an end.

I think it is better to refine this approach: create an inference of constitutional protection unless the mark is “strictly” commercial. It would not be difficult to overcome this presumption in many cases, but in those cases where any potentially disparaging or offensive mark contains *any* non-commercial speech elements would prevent the trademark examiner from denying registration. This serves as a proper balance, in my view, to the rights of trademark owners like Tam, but also recognizes that many, if not most, trademarks do not merit this kind of protection and may allow some protection for those in society who feel aggrieved by such names and marks. Such an approach could conceivably allow for the reinterpretation of Section 2(a) expressly limited to trademarks that are entirely “commercial.” Admittedly, it may still be difficult to pass the *Central Hudson* standard, but at least a narrowly-tailored law would give the government a chance to do so.

However, this could all be short-lived if the Supreme Court abandons the *Central Hudson* standard. Over the last three decades the Supreme Court’s views on freedom of speech protection in the business context has increased, and the *Central Hudson* standard has become more protective of speech.³⁶⁸ In addition, a growing chorus of scholars has advocated treating commercial speech on the same constitutional plane as political or artistic speech.³⁶⁹ If *Central Hudson* is overruled one day, trademarks could no longer be judged from a strict commercial versus non-commercial basis, and there would be no way to prevent a disparaging or offensive trademark from registration unless deception or

³⁶⁶ *Id.* at 1364.

³⁶⁷ *Id.* at 1373.

³⁶⁸ See Rodney A. Smolla, *Lawyer Advertising and the Dignity of the Profession*, 59 ARK. L. REV. 437, 452 (2006) (“The arc of the Supreme Court’s commercial speech decisions in recent years has been unmistakable: in case after case the Court has enforced the First Amendment protections set forth in *Central Hudson* with increasing rigor, expanding protection for commercial speech, and expressing ever-heightening skepticism and impatience for governmental restrictions on advertising grounded in protectionism and paternalism.”).

³⁶⁹ See *Rubin v. Coors Brewing Co.*, 514 U.S. 476 (1995); *Lorillard Tobacco v. Riley*, 533 U.S. 525 (2001). As noted earlier, Justice Thomas, in particular, has stated his preference for the elimination of *Central Hudson*; see also *Lorillard*, 533 U.S. at 570 (Thomas, J., concurring).

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fraud could be determined. It is hardly ideal, but this may be the best practical solution to a vexing First Amendment question. In that case, no court would have to worry about the increasingly difficult distinction between commercial and non-commercial speech. However, the qualified privilege approach mentioned above would give some groups disparaged by insulting trademarks a fighting chance to contest the mark.

CONCLUSION

For the reasons noted earlier in the article, *Matal v. Tam* was a perfect case for invalidating the disparagement provision of Section 2(a). The denial of registration for The Slants smacked of viewpoint discrimination and lacked any reasonable constitutional justification. Therefore, the Lanham Act cannot permit the USPTO to impose value judgments by refusing to register marks that it considers disparaging. For people or groups that could be hurt by offensive trademark names and logos, the result may cause pain. However, the court of public opinion could limit the potential downside of this ruling for Native Americans seeking to change the names of teams and mascots that refer to them. U.S. marketing history bears the legacy of racially or ethnically insensitive names and symbols, but at least there may be hope that we will not return to those days.

The ruling accomplished its immediate goal: permitting the group to register the name Slants.³⁷⁰ It ends the use of trademark law to bar speech that is offensive and disparaging. However, it did not close the book on the tension between government regulation of intellectual property and free speech, as it did not resolve a deeper doctrinal question of the *kind* of First Amendment protection accorded trademarks. While lower courts have been more lucid on this issue, the high court's concurring opinions (except for Justice Thomas's) do not directly address the question of whether all or some trademarks should be subject to either a "commercial speech" or "non-commercial speech" standard or whether it is even possible to divide trademarks into "purely commercial" or "mixed commercial and expressive" categories. Without that resolution, this tension will continue.

As a result of their hard-won battle, The Slants received their trademark registration.³⁷¹ And it was signed by petitioner Joseph Matal.

³⁷⁰ And indeed, their name was registered on November 14, 2017. *See supra* note 30.

³⁷¹ *See id.*