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## Battle of the Band: Exploring the Unconstitutionality of Section 2(A) of the Lanham Act and the Fate of Disparaging, Scandalous, and Immoral Trademarks in a Consumer-Driven Market

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# **BATTLE OF THE BAND: EXPLORING THE UNCONSTITUTIONALITY OF SECTION 2(A) OF THE LANHAM ACT AND THE FATE OF DISPARAGING, SCANDALOUS, AND IMMORAL TRADEMARKS IN A CONSUMER- DRIVEN MARKET**

*Tanya Behnam*\*\*

In the 2016-2017 term, the Supreme Court issued its opinion in *Matal v. Tam*, holding that the Lanham Act's section 2(a) ban on disparaging trademarks—which prevents registration of any trademarks that the PTO deems to be disparaging to any groups or institutions—is unconstitutional. Although meant to only apply to section 2(a)'s ban on disparaging trademarks, the Court's decision increases the likelihood that section 2(a)'s still-standing ban on scandalous and immoral marks are unconstitutional as well.

This Comment first reviews the basic principles of trademark law and the Lanham Act, summarizes Simon Tam's legal battles, and briefly presents the conflicting case of *Pro-Football v. Blackhorse*. This Comment explores the failings of section 2(a)'s bans, its suppression of free speech, and its divergence from the goals of federal trademark law. Finally, this Comment analyzes *Matal*'s applicability to scandalous and immoral marks and *Matal*'s impact on future trademark registration in a consumer-driven marketplace.

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## I. INTRODUCTION

In 2013, international singer Justin Bieber received a public rebuking when, following his visit to the Anne Frank Museum in Amsterdam, he remarked that Holocaust victim Anne Frank “[h]opefully . . . would have been a Belieber.”<sup>1</sup> Recently, celebrity designer Marc Jacobs drew heavy criticism for allegedly exhibiting cultural appropriation after dressing his Caucasian runway models in dreadlock wigs during New York Fashion Week.<sup>2</sup> And former American Idol runner-up Bo Bice angrily took to the media after a fast food chain employee “referred to him as ‘that white boy’ as he waited for his order.”<sup>3</sup> These incidents reflect our increasing sensitivity to words, images, and actions we consider offensive or insulting.<sup>4</sup> People are frequently and easily offended, now more than ever before. Technological advances have connected the world, resulting in worldwide exposure and societal retribution for even isolated off-color remarks that, years ago, would likely have been brushed off.<sup>5</sup> This heightened sensitivity even manifests itself on a government level: The United States Patent and Trademark Office (PTO) has recently cancelled or refused registration to multiple trademarks for being too disparaging.<sup>6</sup>

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1. See Alan Duke, *Justin Bieber Hopes Anne Frank ‘Would Have Been a Belieber’*, CNN (Apr. 26, 2013, 2:48 PM), <http://www.cnn.com/2013/04/14/showbiz/bieber-anne-frank/> [<https://perma.cc/JG5Z-G7RD>].

2. Valeria Safronva, *Marc Jacobs’s Use of Faux Locks on Models Draws Social Media Ire*, N.Y. TIMES (Sept. 16, 2016), [http://www.nytimes.com/2016/09/18/fashion/marc-jacobs-models-dreadlocks-social-media-response-new-york-fashion-week.html?\\_r=1](http://www.nytimes.com/2016/09/18/fashion/marc-jacobs-models-dreadlocks-social-media-response-new-york-fashion-week.html?_r=1) [<https://perma.cc/347V-6CZ5>].

3. Michele Amabile Angermiller, *‘American Idol’ Alum Bo Bice Takes Aim at Popeyes Over Being Called ‘White Boy’*, BILLBOARD (Jan. 4, 2017), <http://www.billboard.com/articles/news/7647005/american-idol-bo-bice-popeyes> [<https://perma.cc/AGB5-DP8J>].

4. See Eleanor Halls, *Millennials. Stop Being Offended By, Like, Literally Everything*, GQ (Aug. 12, 2016), <http://www.gq-magazine.co.uk/article/millennials-created-generation-snowflake> [<https://perma.cc/9TWT-EDXD>].

5. Bradley Campbell & Jason Manning, *The New Millennial ‘Morality’: Highly Sensitive and Easily Offended*, TIME (Nov. 17, 2015), <http://time.com/4115439/student-protests-micro-aggressions/> [<https://perma.cc/PP2R-AZ6Y>]; Halls, *supra* note 4.

6. *In re Tam*, 808 F.3d 1321, 1330 (Fed. Cir. 2015).

In this age of political correctness, however, some social groups insist on pushing the limits on what is socially acceptable by using and glorifying the words, images, and actions that others find distressing.<sup>7</sup> By challenging stereotypes, these groups encourage dialogue about gender, race, religion, and other emotionally charged topics.<sup>8</sup> One way groups challenge negative stereotypes is by “reclaiming” an offensive word or term.<sup>9</sup> To do so, a “derogatory sign or signifier is consciously employed by the ‘original’ target of the derogation, often in a positive or oppositional sense.”<sup>10</sup> For instance, when the African American community reclaims the word “nigger,” and women reclaim the word “cunt,” they engage in value reversal, replacing the “negative connotative value” of the terms “with a positive one.”<sup>11</sup>

During the United States Supreme Court’s 2016–2017 Term, a controversial example of this unique crossroads—wherein efforts are made to both avoid and confront offensive speech—appeared on the national stage.<sup>12</sup> On June 19, 2017, the Supreme Court issued its opinion in *Matal v. Tam* (“Matal”), a case centered around one band’s efforts to publicly reclaim an offensive term.<sup>13</sup> *Matal*, previously

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7. See Anita Henderson, *What’s in a Slur?*, 78 AM. SPEECH 52, 65 (2003); Robin Brontsema, *A Queer Revolution: Reconceptualizing the Debate Over Linguistic Reclamation*, 17 COLO. RES. IN LINGUISTICS 1, 9 (2004).

8. See generally Brooke Barnett & Randy Williams, *Leading Conversations About Racism on Predominantly White Campuses*, INSIGHT INTO DIVERSITY, <http://www.insightinto.com/leading-conversations-about-racism-on-predominantly-white-campuses/> [https://perma.cc/U7T3-M83C]; Jessica Bennett, *How to Fight Back Against Sexism at Work*, COSMOPOLITAN (Aug. 16, 2016), <http://www.cosmopolitan.com/career/a61855/fight-back-sexism-workplace/> [https://perma.cc/JJ9C-VWVE]; Chiara A. Sottile, *Dakota Access Pipeline Fight Watched on Facebook Live around World*, NBC NEWS (Nov. 5, 2016, 7:06 PM), <https://www.nbcnews.com/storyline/dakota-pipeline-protests/dakota-access-pipeline-fight-watched-facebook-live-around-world-n67836> [https://perma.cc/D78K-Q7UY]; *Women Fight Back Against Sexist GOP Outside Trump Tower*, TELESUR (Oct. 12, 2016), <http://www.telesurtv.net/english/news/Women-Fight-Back-Against-Sexist-GOP-Outside-Trump-Tower-20161012-0015.html> [https://perma.cc/9WMW-SNHE].

9. Brontsema, *supra* note 7, at 1.

10. *Id.*

11. *Id.* at 9; Henderson, *supra* note 7, at 65.

12. See *Lee v. Tam*, 137 S. Ct. 30 (2016), *cert. granted*, (No. 174, 2016 Term)

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

identified as *Lee v. Tam* and *In re Tam*, documents the journey of The Slants, a band that endeavored to reclaim the derogatory term “slant.”<sup>14</sup> Despite the musical group’s growing popularity, the PTO deemed the band’s name disparaging to Asian Americans and repeatedly denied trademark protection to its lead singer Simon Tam.<sup>15</sup> In *In re Tam*, the Federal Circuit Court of Appeals struck down as unconstitutional the Lanham Act’s ban on disparaging trademarks.<sup>16</sup> This decision went head-to-head with *Pro-Football, Inc. v. Blackhorse*—then on appeal in the Fourth Circuit—in which a district court upheld the constitutionality of the Lanham Act’s section 2(a).<sup>17</sup> Then, in its June decision, the Supreme Court affirmed *In re Tam*,<sup>18</sup> a holding that greatly impacts the future of trademark registration and regulation within the United States.<sup>19</sup>

The *Matal* Court’s determination that section 2(a)’s disparagement clause is unconstitutional—because trademarks are private speech—was correct. Moving forward, this same holding should also be applied to section 2(a)’s ban on immoral and scandalous marks. Extending *Matal*’s holding to immoral and scandalous marks is essential to upholding the First Amendment’s freedoms. Moreover, fears that *Matal* will lead to a flood of federal registration of disparaging, immoral, and scandalous marks are groundless, as an overwhelming portion of the market will likely reject the use of such trademarks.

This comment focuses on the Lanham Act’s ban on disparaging, immoral, and scandalous trademarks. Specifically, this comment explores the vague nature of section 2(a)’s bans, its suppression of free speech, and its divergence from federal trademark law’s goals. Part II

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14. *In re Tam*, 808 F.3d at 1331.

15. *In re Tam*, 108 U.S.P.Q.2d 1305, at \*1313 (T.T.A.B. 2013).

16. *In re Tam*, 808 F.3d at 1358.

17. *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 489 (E.D. Va. 2015); Brief for Pro-Football, Inc. as Amicus Curiae Supporting Respondent at 2-3, *Lee v. Tam*, 137 S. Ct. 30 (2016) (No. 15-1293).

18. *Tam*, 137 S. Ct. at 1747.

19. Joanna Diakos & Thomas W. Dollar, *Trademark Law Update: SCOTUS to Decide Whether Ban on Registering ‘Disparaging Marks’ Is Unconstitutional*, NAT’L L. REV. (Nov. 8, 2016), <https://www.natlawreview.com/article/trademark-law-update-scotus-to-decide-whether-ban-registering-disparaging-marks> [<https://perma.cc/MU69-3ERY>].

discusses trademark law, including its purpose and significance. Part III examines *Matal v. Tam*, its procedural history, and The Slants' journey to achieving trademark registration. Finally, Part IV analyzes the failings of section 2(a), *Matal's* applicability to scandalous and immoral marks, and *Matal's* impact on future trademark registration.

## II. THE TRADEMARK REGISTRATION PROCESS

### A. *What is a Trademark?*

In 1946, Congress enacted the Lanham Act (15 U.S.C. § 1051), also known as the Trademark Act of 1946.<sup>20</sup> Established under the power of the Commerce Clause, the Lanham Act “provides for a national system of trademark registration and protects the owner of a federally registered mark against the use of similar marks if such use is likely to result in consumer confusion, or if the dilution of a famous mark is likely to occur.”<sup>21</sup>

Under the Lanham Act, a trademark is defined “as including ‘any word, name, symbol, or device or any combination thereof’ used by any person ‘to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods.’”<sup>22</sup> To obtain registration, a markholder must pay a fee to the PTO, verify that the mark in question is used in commerce,<sup>23</sup> and assert that no other person has the right to use the mark.<sup>24</sup>

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20. *Matal v. Tam*, 137 S. Ct. 1744, 1752 (2017); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 763 (1992).

21. *Lanham Act*, CORNELL UNIV. LAW SCH.: LEGAL INFO. INST., [https://www.law.cornell.edu/wex/lanham\\_act](https://www.law.cornell.edu/wex/lanham_act) [<https://perma.cc/WYV5-PSKZ>].

22. *Two Pesos, Inc.*, 505 U.S. at 764. For instance, international fast-food chain McDonalds has registered trademarks for its distinctive golden arches (logo), its slogans (“I’m Lovin’ it”), its name, and even the prefix “Mc.” The PTO has deemed these words, symbols, and phrases to identify McDonalds and only McDonalds. *See Logos, MCDONALD’S*, [http://corporate.mcdonalds.com/content/mcd/newsroom/image\\_and\\_video\\_library/logos.html](http://corporate.mcdonalds.com/content/mcd/newsroom/image_and_video_library/logos.html) [<https://perma.cc/CHJ8-RS5J>].

23. Applicants may also file under an “Intent to Use” (ITU) application. Under such an application, the trademark need not be in commercial use at the time of filing; it need only be used in commerce within a certain time period following application to achieve registration dating back to the application date. 15 U.S.C. § 1052(b) (2017); *see* 15 U.S.C. § 1051 (2017).

24. 15 U.S.C. § 1051.

### B. *The Purpose of Trademark Law*

Trademark registration protects both the public and the markholder.<sup>25</sup> For a trademark to receive protection, the mark must be source identifying—it must inform consumers of the source of goods or services.<sup>26</sup> Protecting a registered mark and prohibiting all others from using it safeguards consumers against mistakenly purchasing counterfeit products.<sup>27</sup> It also protects the markholder from misappropriation of his or her investment by giving the markholder the power to prevent others from using it.<sup>28</sup> This keeps potential infringers from “reap[ing] where [they have] not sown,” and allows the markholder to fully enjoy the fruits of his or her labor.<sup>29</sup> In other words, trademark law “make[s] infringement and piracy unprofitable.”<sup>30</sup>

### C. *Why Register a Trademark?*

Trademark registration with the PTO is not a prerequisite to bringing a trademark-infringement claim.<sup>31</sup> Source-identifying marks used in commerce are generally protected under the common law and state legislation.<sup>32</sup> Registering a mark with the PTO, however, affords markholders crucial benefits not available at common law.<sup>33</sup> These

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25. S. REP. NO. 79-1333, at 3 (1946).

26. P. Sean Morris, *The Economics of Distinctiveness: The Road to Monopolization in Trade Mark Law*, 33 LOY. L.A. INT’L & COMP. L. REV. 321, 323 (2011); William T. Vuk, Note, *Protecting Baywatch and Wagamama: Why the European Union Should Revise the 1989 Trademark Directive to Mandate Dilution Protection for Trademarks*, 21 FORDHAM INT’L L.J. 861, 861 (1998).

27. Int’l Order of Job’s Daughters v. Lindeburg & Co., 633 F.2d 912, 918 (9th Cir. 1980).

28. Vuk, *supra* note 26, at 867–68.

29. Int’l News Serv. v. Associated Press, 248 U.S. 215, 239–40 (1918).

30. S. REP. NO. 79-1333, at 3

31. *In re Tam*, 808 F.3d 1321, 1374–75 (Fed. Cir. 2015).

32. *Id.* (“The markholder may still generally use the mark as it wishes; without federal registration, it simply lacks access to certain federal statutory enforcement mechanisms for excluding others from confusingly similar uses of the mark”).

33. *Should I Register My Trademark?*, U.S. PATENT AND TRADEMARK OFFICE, <https://www.uspto.gov/trademarks/basics/register.jsp> [<https://perma.cc/7QJY-ULLF>].

benefits, created by the Lanham Act, include addition of the mark to the principal register, legal presumption of ownership of the mark, constructive notice to the public of a markholder's ownership of the mark, the right to display the registered trademark symbol (®) alongside the mark, permission to bring an action regarding the mark in federal court, the ability to collect profits or damages in an infringement suit, basis for registering the mark in foreign nations, and the right to have United States Customs and Border Protection prevent other entities from importing infringing goods bearing a registrant's marks.<sup>34</sup> In other words, although a trademark not protected by the PTO may still be a defensible mark, it lacks many of the crucial advantages that the Lanham Act affords. Today, over “two million marks . . . have active federal certificates of registration.”<sup>35</sup>

#### D. Bars to Trademark Registration

Before the PTO approves a mark for federal registration, the mark must clear several hurdles, outlined in section 2 of the Lanham Act.<sup>36</sup> For instance, trademarks bearing a flag or insignia of the United States or any other state or nation cannot be registered.<sup>37</sup> Likewise, trademarks consisting of the name, signature or portrait of a living person cannot be registered without that person's consent.<sup>38</sup> Finally, the Lanham Act prohibits registration of trademarks that are merely descriptive, deceptively mis-descriptive, primarily geographically descriptive, primarily surnames, functional, or that consumers may confuse with other registered marks.<sup>39</sup>

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34. *Id.*; Michael Baroni, *Warning: Offensive Trademarks Lie Ahead*, O.C. LAWYER , <http://www.virtualonlineeditions.com/article/Warning%3A+Offensive+Trademarks+Lie+Ahead/2499689/0/article.html> [<https://perma.cc/JR33-Q879>].

35. *Tam*, 137 S. Ct. at 1752.

36. 15 U.S.C. § 1052 (2017).

37. 15 U.S.C. § 1052(b).

38. 15 U.S.C. § 1052(c) (2017). Additionally, if the trademark is of the name, signature, or portrait of a deceased United States President, the markholder cannot register the mark without written consent of the deceased President's widow. *Id.*

39. 15 U.S.C. § 1052(d)–(e) (2017).



Section 2(a) presents additional registration obstacles. It provides that trademarks comprising or consisting of “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” shall be refused trademark registration.<sup>40</sup> A disparaging mark is one that “dishonor[s] by comparison with what is inferior, slight[s], deprecate[s], degrade[s], or affect[s] or injure[s] by unjust comparison.”<sup>41</sup> For example, the PTO has, in the past, denied trademarks for phrases like JIHADI KILLER and QUEER GEAR because it deemed them disparaging to Muslims and the LGBT community, respectively.<sup>42</sup>

To determine whether a registrant’s mark is disparaging, the PTO’s trademark examiners used the following test: “(1) What is the likely meaning of the matter in question, . . . 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.”<sup>43</sup> The Lanham Act banned disparaging marks because the government purportedly “disapproves of the messages” these types of trademarks convey.<sup>44</sup>

Similarly, courts use a fact-based approach to determine whether a mark comprises scandalous or immoral matter.<sup>45</sup> To prove that a mark is scandalous,

the PTO must demonstrate that the mark is “shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable;

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40. 15 U.S.C. § 1052(a) (2017).

41. *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014).

42. Baroni, *supra* note 34; Fred Barbash, *Warning: This article on Trademarks May Include Language Deemed ‘Scandalous, Immoral or Disparaging’*, WASH. POST (Sept. 30, 2016), [https://www.washingtonpost.com/news/morning-mix/wp/2016/09/30/the-idiotic-history-of-deeming-trademarks-scandalous-immoral-or-disparaging/?utm\\_term=.ea5479bc9c31](https://www.washingtonpost.com/news/morning-mix/wp/2016/09/30/the-idiotic-history-of-deeming-trademarks-scandalous-immoral-or-disparaging/?utm_term=.ea5479bc9c31) [https://perma.cc/WA8E-VF4N].

43. *Trademark Manual of Examining Procedure*, U.S. PATENT AND TRADEMARK OFFICE § 1203.03(b)(i), <https://www.uspto.gov/trademark/guides-and-manuals/tmep-archives> (click on “January 2015” under “TMEP—Archived Editions”) [https://perma.cc/2NBD-W8XB].

44. *In re Tam*, 808 F.3d at 1327.

45. *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

... giving offense to the conscience or moral feelings; ... [or] calling out [for] condemnation.” The PTO must consider the mark in the context of the marketplace as applied to only the goods described in [the] application for registration.<sup>46</sup>

As with disparaging marks, “[w]hether or not the mark, including innuendo, is scandalous is to be ascertained from the standpoint of not necessarily a majority, but a substantial composite of the general public.”<sup>47</sup>

### III. ONE BAND’S JOURNEY TO THE TOP CHARTS AND HIGHEST COURTS

#### A. *The Slants: Rock n’ Roll with Purpose*

The Slants, who self-identify as “the first and only all-Asian American dance rock band,” have been at the center of this trademark registration controversy for years.<sup>48</sup> During this time, The Slants have built a reputation not only as musicians, but also as advocates for their fellow Asian-Americans.<sup>49</sup> Most notably, the band has made efforts to confront Asian-American stereotypes head-on. The band’s mere existence challenges the stereotype that Asian-American musicians are best suited to classical music and instruments.<sup>50</sup> To date, The Slants have released two albums with racially charged titles (“Slanted Eyes, Slanted Hearts” and “The Yellow Album”) using terms typically used to

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46. *Id.*

47. *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981).

48. Michelle Chen, *Simon Tam on Activism, Freedom of Speech, and Strange Allies*, HYPHEN (Sept. 15, 2017), <https://hyphenmagazine.com/blog/2017/09/simon-tam-activism-freedom-speech-and-strange-allies> [<https://perma.cc/JZJ2-86P8>].

49. See April Baer, *The Slants: Trading in Stereotypes*, NPR (June 11, 2008, 1:22 PM), <http://www.npr.org/templates/story/story.php?storyId=90278746> [<https://perma.cc/4FE4-L5KE>]; Katy Steinmetz, “*The Slants*” Suit: Asian-American Band Goes to Court over Name, TIME (Oct. 23, 2013), <http://entertainment.time.com/2013/10/23/the-slants-suit-asian-american-band-goes-to-court-over-name/> [<https://perma.cc/ZLY9-DHQR>].

50. Lisa Bernier, *11 Asian Musicians Proving that Great Music Knows No Race*, MIC (Mar. 12, 2014), <https://mic.com/articles/85035/11-asian-musicians-proving-that-great-music-knows-no-race#.AuPLgmMIZ> [<https://perma.cc/3FKV-P2FX>].

describe stereotypical Asian features and skin-tone.<sup>51</sup> The band's name itself is a direct reference to the musicians' Asian-American heritage. Band-founder Simon Tam has explained that the meaning behind the band's name is trifold; it alludes to the band members' "slant on life," it refers to the slanted guitar chords used in their music, and, most importantly, it confronts a derogatory slang term directed toward Asians.<sup>52</sup>

Use of the word "slant" as a derogatory term toward Asian-Americans has been recorded as early as 1943.<sup>53</sup> It was this derogatory usage of the term that led the PTO to deny trademark registration to the band in December 2012 on the grounds that it was disparaging to persons of Asian descent at the time of registration.<sup>54</sup>

*B. Trademark Trial and Appeal Board Finds Section 2(a)  
Constitutional*

Following the PTO's initial denial of trademark for THE SLANTS, Tam appealed to the Trademark Trial and Appeal Board (TTAB).<sup>55</sup> In its appeal, Tam clarified the band's purpose in using the term "slant" as a commentary on Asian-American stereotypes and further questioned section 2(a)'s ban on disparaging marks.<sup>56</sup> In 2013, the TTAB upheld the PTO's refusal to register THE SLANTS.<sup>57</sup> In its opinion, the TTAB held that despite Tam's intent to reclaim the term "slant," the meaning was nonetheless "a highly disparaging reference to people of Asian descent."<sup>58</sup> Furthermore, the board held that section 2(a) of the Lanham Act was immune from First Amendment strict

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51. *Discography*, THE SLANTS, <http://www.theslants.com/discography/> [<https://perma.cc/K84L-ZAFW>].

52. *In re Tam*, 108 U.S.P.Q.2d 1305, at \*1305 (T.T.A.B. 2013); Steinmetz, *supra* note 49.

53. *Slant*, DICTIONARY.COM, <http://www.dictionary.com/browse/slant?s=t> [<https://perma.cc/HK7B-W9V2>].

54. *In re Tam*, 108 U.S.P.Q.2d at \*1305.

55. *Id.*

56. *Id.*

57. *Id.* at 1307.

58. *Id.*

scrutiny because Tam could still use the band name in commerce.<sup>59</sup> In other words, because Tam was not forbidden from using “The Slants” as his band name, speech was not so restricted for section 2(a) to undergo strict scrutiny evaluation.<sup>60</sup>

### C. *The Federal Circuit Court of Appeals Overturns the TTAB*

Tam appealed the TTAB’s decision to the Federal Circuit Court of Appeals.<sup>61</sup> At first, the court affirmed the TTAB’s decision, finding evidence that THE SLANTS is “likely offensive to a substantial composite of people of Asian descent.”<sup>62</sup> Then, in late 2015, the court, sitting en banc, reversed the TTAB’s holding and remanded the case to the board for further proceedings.<sup>63</sup> In its decision, the court held that the Lanham Act is not immune to First Amendment strict scrutiny, and that registration under the Lanham Act does not qualify as government speech and cannot be considered a government subsidy.<sup>64</sup> This decision, which focused solely on the disparaging-marks segment of section 2(a), effectively deemed the disparagement proscription unconstitutional.<sup>65</sup>

According to the court, section 2(a)’s ban on disparaging marks is antithetical to the policy behind the Lanham Act—the ban fails to prevent consumer confusion or deceit, and it does not protect certain

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59. *Id.* at 1313.

60. *Id.* at 1309. Strict scrutiny evaluation is the strictest standard of review employed in cases alleging a constitutional violation. Among other questions, strict scrutiny analysis asks whether the government interest is compelling, and, if so, whether the law is narrowly tailored enough to achieve that government interest. See Roy G. Space & David Yokum, *Scrutinizing Strict Scrutiny*, 40 VT. L. REV. 285, 293–98 (2015). As compared to its counterparts—intermediate scrutiny and rational basis scrutiny—strict scrutiny is the hardest to survive. The TTAB’s designation of section 2(a) as not deserving strict scrutiny, therefore, made it more likely that the statute would be found constitutional.

61. *In re Tam*, 808 F.3d 1321, 1322 (Fed. Cir. 2015).

62. *In re Tam*, 785 F.3d 567, 571 (Fed. Cir. 2015).

63. *In re Tam*, 808 F.3d at 1328.

64. *Id.*

65. *Id.*

markholders' investment in their marks.<sup>66</sup> Rather, the ban denies "the protections of registration for reasons quite separate from any ability of the mark to serve the consumer and investment interests underlying trademark protection."<sup>67</sup>

In striking down section 2(a) as unconstitutional, the court first determined that the disparagement clause discriminates on the basis of both content and viewpoint.<sup>68</sup> Specifically, it held that section 2(a) discriminates on the basis of content in the sense that it "'applies to particular speech because of the topic discussed.'"<sup>69</sup> It further held that when "[t]he PTO rejects marks under section 2(a) when it finds the marks refer to a group in a negative way, but . . . permits the registration of marks that refer to a group in a positive, non-disparaging manner[,] [s]ection 2(a) . . . discriminates on the basis of viewpoint."<sup>70</sup> Because it involves content and viewpoint discrimination, the court explained, section 2(a) is subject to strict scrutiny.<sup>71</sup> And as a restriction that denies trademark registration solely based on the disparaging message that a mark is perceived to convey, the court concluded that section 2(a) fails strict scrutiny analysis.<sup>72</sup>

The court underscored its conclusion by observing section 2(a)'s financial effect on markholders.<sup>73</sup> "[T]he Government offends the First Amendment when it imposes financial burdens on certain speakers based on the content of their expression."<sup>74</sup> Federally registering a

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66. *Id.* at 1329–30.

67. *Id.* at 1329.

68. *Id.* at 1335.

69. *Id.* (quoting *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2227 (2015)).

70. *Id.* at 1336.

71. *Id.* at 1334, 1337 (explaining that "[s]trict scrutiny is used to review any governmental regulation that burdens private speech based on disapproval of the message conveyed," and holding that strict scrutiny applies to and invalidates "[c]ontent-based laws—those that target speech based on its communicative content.").

72. *Id.* at 1337.

73. *Id.* at 1340–41.

74. *Rosenberger v. Rector & Visitors of the Univ. of Va.*, 515 U.S. 819, 828 (1995).

trademark provides a markholder with a valuable “asset”<sup>75</sup> that confers significant financial benefits.<sup>76</sup> By preventing markholders from federally registering marks that are determined to be disparaging, section 2(a) effectively “burdens some speakers and benefits others.”<sup>77</sup>

The court rejected the government’s argument that strict scrutiny does not apply because trademark registration qualifies as government speech.<sup>78</sup> Rather, the court held that by registering a trademark, the PTO is regulating private speech.<sup>79</sup>

When the Government registers a trademark, the only message it conveys is that a mark is registered. The vast array of private trademarks are not created . . . , owned[,] . . . monopolized . . . , [or] sized and formatted by the Government, . . . understood as performing any Government function . . . , aligned with the Government, or . . . used as a platform for Government speech.<sup>80</sup>

According to the court, consumers do not equate federal registration of a mark with government approval of that mark,<sup>81</sup> and the PTO itself clarified that the office “does not endorse any particular product, service, mark, or registrant” when it approves a mark for federal registration.<sup>82</sup> Instead, the court equated trademark registration with more mundane government authorizations such as street parade

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75. *Id.* at 1340.

76. Lee Ann W. Lockridge, *Abolishing State Trademark Registrations*, 29 CARDOZO ARTS & ENT. L.J. 597, 605 (2011); *see also* B&B Hardware, Inc. v. Hargis Indus., 135 S. Ct. 1293, 1300 (2015); Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189, 199–200 (1985) (listing advantages of federal trademark registration, including constructive notice of a registrant’s ownership claim over a mark, a markholder’s exclusive right to use the registered mark, and a trademark’s incontestability after a five-year period).

77. *In re Tam*, 808 F.3d at 1340.

78. *Id.* at 1345.

79. *Id.* at 1348.

80. *Id.* at 1346.

81. *Id.*

82. *Id.* at 1347.

permits, copyright registration certificates, or hunting licenses.<sup>83</sup> The court further reasoned that even if the PTO had granted trademark registration to THE SLANTS, the general public would likely not have interpreted the registration as the government's endorsement of the band.<sup>84</sup>

Strict scrutiny also applies because trademark registration does not amount to a government subsidy.<sup>85</sup> According to the court, the government does not send a message of any kind to the public when it approves registration of a trademark.<sup>86</sup> “[T]he Lanham Act derives from the Commerce Clause, not the Spending Clause,”<sup>87</sup> because it does not confer any direct monetary benefits to registrants.<sup>88</sup> Taxpayers do not fund trademark registration.<sup>89</sup> Instead, markholders’ “registration fees cover all of the operating expenses associated with registering marks.”<sup>90</sup>

The court concluded that because section 2(a)'s disparagement provision does not pass strict scrutiny, it is unconstitutional under the First Amendment.<sup>91</sup> The majority acknowledged that its decision “may lead to the wider registration of marks that offend vulnerable communities.”<sup>92</sup> It noted, however, that allowing for and “tolerat[ing]

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83. *Id.* at 1347–48.

84. *Id.* at 1347.

85. *Id.* at 1348–49.

86. *Id.* at 1351.

87. *Id.* at 1354.

88. *Id.* at 1353.

89. *Id.*

90. *Id.*

91. *Id.* at 1358.

92. *Id.* at 1357–58.

insulting and . . . outrageous speech”<sup>93</sup> is crucial to preserving “the freedoms protected by the First Amendment.”<sup>94</sup>

*D. The Alternative Response to Constitutionality:  
Blackhorse v. Pro-Football, Inc.*

In their fight for trademark registration, The Slants found an unlikely and controversial ally in an NFL football team: the Washington Redskins. Although the Redskins have owned their trademarks for decades, the team’s battle with the PTO began around the same time as The Slants.’ Their stories are interwoven.

The Redskins first registered the Redskins trademarks in 1967.<sup>95</sup> Almost fifty years later, in June 2014, the TTAB cancelled the team’s trademarks under the section 2(a) disparagement ban in *Pro-Football, Inc. v. Blackhorse*.<sup>96</sup> The TTAB reasoned that “at the time of their registrations[,] the marks consisted of matter that both ‘may disparage’ a substantial composite of Native Americans and bring them into contempt or disrepute.”<sup>97</sup> Over the years, in addition to using the term “redskins,” “the team has consistently associated itself with Native American imagery.”<sup>98</sup> It has used logos of a Native American man and spears, Native American headdresses, traditional Native American clothing, and black braided-hair wigs for the team’s marching band and cheerleaders.<sup>99</sup>

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93. *Boos v. Barry*, 485 U.S. 312, 322 (1988).

94. *Snyder v. Phelps*, 562 U.S. 443, 458 (2011).

95. *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 448 (E.D. Va. 2015).

96. *Pro-Football, Inc.*, 112 F. Supp. 3d at 451. Note, however, that “the cancellation of the Redskins trademark has never gone into effect. Under federal law, that only happens after the Redskins unsuccessfully exhaust all of their appeals. As a consequence, the Redskins have maintained all of the benefits of federal trademark registration during the controversy.” Michael McCann, *Why the Redskins Scored a Victory in the Supreme Court’s Ruling in Favor of The Slants*, SPORTS ILLUSTRATED (Jun. 19, 2017), <https://www.si.com/nfl/2017/06/19/washington-redskins-name-slants-trademark-supreme-court> [<https://perma.cc/Q2AE-M7D2>].

97. *Pro-Football, Inc.*, 112 F. Supp. 3d at 451 (citation omitted).

98. *Id.* at 469–70.

99. *Id.*



In July 2015, the Eastern District Court of Virginia affirmed the TTAB's decision in *Pro-Football* and upheld the constitutionality of the Lanham Act's disparagement ban.<sup>100</sup> Months later, the Federal Circuit Court of Appeals reached the opposite conclusion in *In re Tam*.<sup>101</sup> Following its defeat in the Eastern District Court of Virginia, respondent *Pro-Football* appealed and asked the Fourth Circuit to postpone oral argument until after the Supreme Court delivered its decision in *Lee v. Tam*.<sup>102</sup> Between the *In re Tam* decision and the Supreme Court's ruling in *Matal v. Tam* (formerly *Lee v. Tam*), "[t]he PTO . . . halted the processing of all trademark applications raising disparagement issues, including Tam's."<sup>103</sup>

### *E. The Supreme Court Weighs in on Disparagement, Once and for All*

On September 29, 2016, the Supreme Court granted certiorari in *Lee v. Shiao Tam*;<sup>104</sup> its eight members heard oral arguments on the matter on January 18, 2017.<sup>105</sup> In a June 19, 2017, plurality opinion, the Court unanimously struck down the Lanham Act's disparagement clause as unconstitutional.<sup>106</sup>

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100. *Id.* at 465.

101. *In re Tam*, 808 F.3d at 1328.

102. Joanna Diakos & Thomas W. Dollar, *Trademark Law Update: SCOTUS to Decide Whether Ban on Registering 'Disparaging Marks' Is Unconstitutional*, NAT'L L.J. REV. (Nov. 8, 2016), <https://www.natlawreview.com/article/trademark-law-update-scotus-to-decide-whether-ban-registering-disparaging-marks> [<https://perma.cc/MU69-3ERY>]; see also Brief for *Pro-Football, Inc.* as Amicus Curiae Supporting Respondent at 3, *Lee v. Tam*, 137 S. Ct. 30 (2016) (No. 15-1293).

103. *Band Front Man Asks U.S. High Court to Consider Trademark Disparagement*, 17-11 MEALEY'S LITIG. REP. TRADEMARKS (2016).

104. *Lee v. Tam*, 137 S. Ct. 30 (2016), *cert. granted*, (No. 174, 2016 Term).

105. Oral Argument, *Lee v. Tam*, 137 S. Ct. 30 (2016) (No. 15-1293), [https://www.supremecourt.gov/oral\\_arguments/audio/2016/15-1293](https://www.supremecourt.gov/oral_arguments/audio/2016/15-1293) [<https://perma.cc/Q49X-A9SU>]; see also Marcia Coyle & Tony Mauro, *Gorsuch's SCOTUS Vote Could Soon Prove Decisive on Many Cases; Senate Confirms Gorsuch 54-45 to Fill Scalia Vacancy*, NAT'L L.J. REV. (Apr. 7, 2017), <http://www.nationallawjournal.com/id=1202783207725/Gorsuchs-SCOTUS-Vote-Could-Soon-Prove-Decisive-on-Many-Cases?sreturn=20170906141452> [<https://perma.cc/4LX9-SRUN>].

106. See generally *Matal v. Tam*, 137 S. Ct. 1744 (2017). Chief Justice Roberts and Justices Breyer and Kennedy joined Justice Alito's opinion, while Justices Ginsburg, Sotomayor,

First, the Court held that “the disparagement clause applies to marks that disparage the members of a racial or ethnic group,” and not merely to natural or juristic persons as Tam had initially contended.<sup>107</sup> In affirming the Federal Circuit’s determination that the disparagement clause violates the First Amendment, the Court held that trademarks are private speech and not a form of government speech, subsidy, or program.<sup>108</sup>

In finding that trademarks do not constitute government speech, the Court noted that the federal government neither creates nor edits registered trademarks.<sup>109</sup> It reasoned that if trademarks were in fact government speech, then the federal government would be “babbling prodigiously and incoherently,” saying “unseemly things,” “expressing contradictory views,” and “endorsing a vast array of commercial products and services.”<sup>110</sup>

Moreover, the Court noted that none of its previous decisions involving government speech contended that trademarks are a form of government speech.<sup>111</sup> Trademarks are unlike monuments, for instance, which governments have used “to speak to the public since ancient times.”<sup>112</sup> And private speech cannot be “passed off as government speech by simply affixing a government seal of approval”; if the government were allowed to do so, it would have free rein to “silence or muffle the expression of disfavored viewpoints.”<sup>113</sup>

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and Kagan joined Justice Kennedy’s concurrence. This article’s analysis of that case focuses on Justice Alito’s opinion.

107. *Id.* at 1757.

108. *Id.* at 1757–64.

109. *Id.* at 1758.

110. *Id.* at 1758–59 (asking rhetorically: “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)? Was the Government warning about a coming disaster when it registered the mark ‘EndTime Ministries?’”) (internal footnotes omitted).

111. *Id.* at 1759.

112. *Id.*

113. *Id.* at 1758..

Next, the Court determined that trademark registration does not equate to a government subsidy.<sup>114</sup> “The PTO does not pay money to parties seeking registration of a mark,” but rather, the applicant pays the PTO an initial registration fee plus additional fees to maintain its mark over time.<sup>115</sup> The use of government funds in examining and publishing marks does not mean that trademark registration is therefore a government subsidy, as “just about every government service requires the expenditure of government funds.”<sup>116</sup>

The Court also refuted the government’s attempt to retain the disparagement clause as a type of government program.<sup>117</sup> Though “some content- and speaker-based restrictions may be allowed” “[w]hen government creates . . . a forum, in either a literal or ‘metaphysical’ sense,” viewpoint discrimination, such as that found under section 2(a)’s disparagement clause, is still forbidden.<sup>118</sup> Thus, the Court reaffirmed the long-standing rule that “the public expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers.”<sup>119</sup>

Finally, the Court held that the disparagement clause “cannot withstand even Central Hudson review.”<sup>120</sup> In other words, the Lanham Act’s restrictions on disparaging trademarks do not serve a substantial interest and are not narrowly drawn.<sup>121</sup> Although the government argued “an interest in preventing ‘underrepresented groups’ from being

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114. *Id.* at 1761 (dismissing as inapplicable the notion that “government is not required to subsidize activities that it does not wish to promote”).

115. *Id.*

116. *Id.*

117. *Id.*

118. *Id.* at 1763.

119. *Id.* (citing *Street v. New York*, 394 U.S. 576, 592 (1969)).

120. *Id.* at 1764. The government also argued an interest in “protecting the orderly flow of commerce.” *Id.* In rejecting this argument, the Court noted that “the disparagement clause is not ‘narrowly drawn’ to drive out trademarks that support invidious discrimination.” *Id.* at 1764–65. Instead, “[t]he clause reaches any trademark that disparages *any person, group, or institution.*” *Id.* at 1765. Thus, “[i]t is not an anti-discrimination clause; it is a happy-talk clause” that “goes much further than is necessary to serve the interest asserted.” *Id.*

121. *Id.* at 1764.

‘bombarded with demeaning messages in commercial advertising,’ the Court stressed that one of the government’s most critical responsibilities is to protect the First Amendment.<sup>122</sup> “Speech that demeans on the basis of race, ethnicity, gender, religion, age, disability, or any other similar ground is hateful; but the proudest boast of our free speech jurisprudence is that we protect the freedom to express ‘the thought that we hate.’”<sup>123</sup>

#### IV. LOOKING TO THE PAST AND THE FUTURE: EXAMINING THE PTO’S MISSTEPS AND EXPLORING WHAT *MATAL V. TAM* SIGNIFIES FOR SECTION 2(A) OF THE LANHAM ACT

Although section 2(a)’s language has yet to be updated, in the wake of *Matal v. Tam*, the PTO may no longer refuse trademark registration solely because it deems a mark disparaging.<sup>124</sup> Nevertheless, the *Matal v. Tam* decision was limited to section 2(a)’s ban on disparaging marks; it did not address section 2(a)’s remaining provisions, including its ban on immoral and scandalous marks.<sup>125</sup> Given the Court’s narrow ruling, the question now is whether these provisions will also be deemed unconstitutional.

We may have the answer before long. In 2011, streetwear fashion designer Erik Brunetti attempted to trademark the term FUCT for his company Fuct Manufacturing Co.<sup>126</sup> The PTO denied Brunetti’s application because it contained “‘vulgar, profane and scandalous slang’” (i.e., an immoral and scandalous mark), and the TTAB affirmed that decision in August 2014.<sup>127</sup> “Brunetti appealed to the Federal Circuit, arguing that the Lanham Act’s prohibition on scandalous marks violates the First Amendment,” but “[t]he court stayed the case while

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122. *Id.*

123. *Id.*

124. See Patrick H.J. Hughes, PTO Updates Trademark Examiners’ Guide to Reflect ‘Slants’ Decision, Westlaw Intellectual Prop. Daily Briefing, June 29, 2017, at 1, 2017 WL 2804035 (summarizing how the PTO plans to comply with the *Matal* Court’s decision).

125. *Matal v. Tam*, 137 S. Ct. 1744, 1765 (2017).

126. *In re Brunetti*, 2014 WL 3976439, at \*1–2 (T.T.A.B. 2014).

127. *Id.* at \*1, \*3 (reasoning that “the term ‘Fuct’ is the phonetic equivalent of the word ‘Fucked,’ the past tense form of the verb ‘fuck’”).

the Supreme Court heard *Matal v. Tam*.”<sup>128</sup> Following the *Matal* holding, the Federal Circuit ordered the *In re Brunetti* parties to submit supplemental briefs “explaining how the constitutionality of the immoral and scandalous provision should be resolved in light of the Supreme Court’s decision.”<sup>129</sup>

In striking down section 2(a)’s disparagement clause as unconstitutional, the *Matal* Court upheld the spirit of the First Amendment, invalidated an arbitrarily applied ban, and supported trademark registration’s underlying policy.<sup>130</sup> With *In re Brunetti*, the Federal Circuit Court has the opportunity to do the same.<sup>131</sup> This section explores the negative impact section 2(a) had on the Lanham Act’s clarity, efficacy, and goals prior to *Matal v. Tam*, why allowing trademark registration of disparaging, immoral, and scandalous marks will likely not create a sudden influx of those marks, and how *Matal v. Tam* may affect section 2(a)’s ban on immoral and scandalous marks in the near future.

#### A. Section 2(a)’s Vagueness Creates Uncertainty for Markholders and Consumers.

An examination of section 2(a) reveals a statute that is inconsistent, unpredictable, and contradictory. Section 2(a)’s vague nature allows the PTO’s trademark examiners to subjectively determine whether an applicant’s marks are disparaging. In the United States, vague laws are prohibited for two reasons: First, “regulated parties should know what is required of them so they may act accordingly.”<sup>132</sup> Second, “precision and guidance are necessary so that those enforcing the law do not act in an arbitrary or discriminatory way.”<sup>133</sup> Yet, a close

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128. Jan Wolfe, *Court Likely to Lift Ban on Vulgar Trademarks After ‘Slants’ Ruling*, 24 WESTLAW J. INTELLECTUAL PROP. 1, 8 (2017).

129. Jennifer Ko Craft, *Why High Court Is Right About Offensive Trademarks*, LAW 360 (June 28, 2017, 5:18 PM), <https://www.law360.com/articles/939421/why-high-court-is-right-about-offensive-trademarks> [<https://perma.cc/GG4R-DLLZ>].

130. *See Tam*, 137 S. Ct. at 1744.

131. *See generally In re Brunetti*, 2014 WL 3976439.

132. *FCC v. Fox Television Stations, Inc.*, 132 S. Ct. 2307, 2317 (2012).

133. *Id.*

examination of the PTO's track record reveals that the office had no history of uniformly registering or rejecting similar marks.<sup>134</sup> To the contrary, "[t]he PTO often decides, in [a] contradictory manner, whose speech gets the 'privilege' of a registered trademark . . . [a]nd whose doesn't."<sup>135</sup> For instance, looking at generally similar marks, the PTO granted registration for the trademark JIHAD WATCH, but refused registration for the trademark JEW WATCH; granted registration for the trademark EVILCHRISTIANS, but denied registration for the mark STOP ISLAMISATION OF AMERICA; and accepted the mark THE DEVIL IS A DEMOCRAT, while rejecting the mark HAVE YOU HEARD SATAN IS A REPUBLICAN.<sup>136</sup>

Even more egregiously, the PTO often treated "identical terms differently."<sup>137</sup> For instance, "[t]he PTO has registered FAGDOG on some occasions, and on other occasions has found FAGDOG disparaging."<sup>138</sup> And, although it denied the mark HEEB under section 2(a) for being disparaging toward Jews, HEBE, the alternative spelling of the word, is registered.<sup>139</sup>

Most relevant to the PTO's prior rejection of THE SLANTS are the marks that have been registered to other bands that bear terms offensive based on race and gender. In the past, the PTO has registered the trademark WHITE TRASH COWBOYS for an all-white rock band as well as N.W.A., an abbreviation for "Niggaz With Attitude," for an all-black rap group.<sup>140</sup> The PTO's inconsistent approach to evaluating

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134. Michael Baroni, *Warning: Offensive Trademarks Lie Ahead*, OC LAWYER, <http://www.virtualonlineeditions.com/article/Warning%3A+Offensive+Trademarks+Lie+Ahead/2499689/0/article.html> [https://perma.cc/JR33-Q879].

135. *Id.*

136. *Id.*; see generally *In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014); Brief for Respondent at 54 *Lee v. Tam*, 137 S. Ct. 30 (2016) (No. 15-1293).

137. Brief for Pro-Football, Inc. as Amicus Curiae Supporting Respondent at 13, *Lee v. Tam*, 137 S. Ct. 30 (2016) (No. 15-1293).

138. Brief for Respondent, *supra* note 136, at 54.

139. Emily M. Kustina, Comment, *Discriminatory Discretion: PTO Procedures and Viewpoint Discrimination under Section 2(A) of the Lanham Act*, 164 U. PA. L. REV. 513, 527 (2016).

140. Brief for Pro-Football, Inc., *supra* note 137, at 10.

disparaging marks continued even amidst its litigation with Tam; after the PTO rejected THE SLANTS, it registered the mark REFORMED WHORES to a female comedy band.<sup>141</sup>

As discussed in Section II, *supra*, prior to *Matal*, PTO trademark examiners were instructed to ask two questions when determining whether a registrant's mark was disparaging: "(1) What is the likely meaning of the matter in question, . . . 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."<sup>142</sup> This two-prong test provided little guidance on how to determine whether a mark was disparaging. As a result, the PTO's trademark examiners granted and denied registration based on their "subjective whims."<sup>143</sup> Although trademark examiners were meant to exercise a policy of deference toward applicants in determining section 2(a) compliance,<sup>144</sup> "analysis of the actual procedures undertaken by examiners reveals that deference [was] employed in name only, with examiners substituting their own discretionary judgment of . . . disparagement for that of the public or disparaged group."<sup>145</sup>

The subjective test the PTO used was not limited to a trademark examiner's literal evaluation of a mark. In making their decisions, the PTO's trademark examiners often looked beyond the potentially disparaging term and paid careful attention to the registrant's identity and his or her purpose for using the mark.<sup>146</sup> For example, a non-profit,

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141. *Id.*

142. *Trademark Manual of Examining Procedure*, U.S. PATENT AND TRADEMARK OFFICE § 1203.03(b)(i), <https://www.uspto.gov/trademark/guides-and-manuals/tmep-archives> (click on "January 2015" under "TMEP—Archived Editions") [<https://perma.cc/2NBD-W8XB>].

143. Baroni, *supra* note 134.

144. Kustina, *supra* note 139, at 519 (explaining that "[a]ccording to the TTAB and the courts, the PTO is supposed to resolve any doubts as to the disparaging or scandalous nature of a mark in favor of the applicant and then allow for opposition proceedings to assess any section 2(a) issues before the mark is registered on the Principal Register").

145. *Id.* at 520.

146. *See, e.g., In re Tam*, 808 F.3d 1321, 1337 (Fed. Cir. 2015); *see also* Joe Garofoli, *Attorneys Find Dykes on Bikes Patently Offensive, Reject Name*, S.F. GATE (July 14, 2005, 4:00 AM), <http://www.sfgate.com/politics/joegarofoli/article/Attorneys-find-Dykes-on-Bikes-patently-offensive-2655626.php> [<https://perma.cc/JR33-Q879>].

pro-LGBT group was repeatedly refused registration of its trademark DYKES ON BIKES until the markholder could show that “the term was often enough used with pride” among the LGBT community.<sup>147</sup> “Thus, an applicant [could] register a mark if he shows it is perceived by the referenced group in a positive way, even if the mark contains language that would be offensive in another context.”<sup>148</sup> Not only was this confusing, it was also illogical: the referenced group’s positive perception of a mark does not eliminate its disparaging history.

This dependency on the trademark examiner’s understanding of words or phrases for which registration was sought left markholders vulnerable at the time of registration and beyond. Without a readily identifiable and predictable standard, applicants with a potentially disparaging mark had no way of knowing whether their mark would pass the PTO’s subjective and varied standards.<sup>149</sup> Additionally, the conflicting applications of section 2(a)’s provision reveal that the PTO was not merely considering the words, phrases, or images used; it was also considering who the markholder was, what the mark was representing, and how society perceived the mark at the time of application.<sup>150</sup>

Moreover, under that system, a markholder with a potentially disparaging mark could never feel fully secure in his or her trademark registration.<sup>151</sup> “Even if an applicant obtain[ed] a registration initially, the mark [could] be challenged in a cancellation proceeding years later.”<sup>152</sup> This is precisely what occurred in *Pro-Football*, where the team registered (and renewed) six Redskins-related marks between the years 1967 and 1990, only to have the TTAB cancel those registrations in 2014.<sup>153</sup> “Thus, after years of investment in promoting a registered

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147. *In re Tam*, 808 F.3d at 1337; *see generally* Garofoli, *supra*, note 146.

148. *In re Tam*, 808 F.3d at 1337.

149. *Id.* at 1342–43.

150. Lisa P. Ramsey, *A Free Speech Right to Trademark Protection?*, 106 TRADEMARK REPORTER 797, 808 (2016); *see also* Baroni, *supra* note 134.

151. *In re Tam*, 808 F.3d at 1342–43.

152. *Id.*

153. Brief for Pro-Football, Inc., *supra* note 137, at 1.



mark and coming to be known by it,” markholders, like the Redskins, were perpetually at risk of their marks being cancelled.<sup>154</sup> The cancellation of a mark years after registration exposed that mark to extreme market vulnerability,<sup>155</sup> forcing “the mark’s owner to find a new mark and make substantial new investments in educating the public, . . . and . . . establishing recognition of the new mark.”<sup>156</sup>

Similar marks, like disparaging marks, have also been treated differently under section 2(a)’s tests. For instance, although the PTO published marks for TWATTY and TWATTYTRAX, the PTO later rejected the mark TWATTYGIRL on immoral or scandalous grounds.<sup>157</sup> “The trademark MILF has been approved 23 times, but refused 20 times. Marks including each of the following have been both approved and refused: ANAL, ASS, BITCH, COCK, POTHEAD, SHIT, SLUT, WHORE.”<sup>158</sup>

Unlike with disparaging and similar marks, the PTO has applied its standard for denying scandalous and immoral marks fairly consistently. The PTO’s determination of which marks are scandalous or immoral, like with disparaging marks, “is largely subjective because of a lack of defined legislative intent and the PTO’s failure to specifically articulate standards for applying these bars to registration.”<sup>159</sup> As mentioned in Section II, *supra*, to prove that a mark is scandalous,

the PTO must demonstrate that the mark is “shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . giving offense to the conscience or moral feelings; . . . [or]

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154. *In re Tam*, 808 F.3d at 1343.

155. See Michelle B. Lee, *Section 2(A) of the Lanham Act as a Restriction on Sports Team Names: Has Political Correctness Gone too Far?*, 4 SPORTS L.J. 65, 68–69 (1997) (explaining that “individuals who argue for the cancellation of the registration of team names have said they want the registrations canceled so that the value of the trademarks will be so dramatically reduced that the owners will voluntarily cancel the marks”).

156. *In re Tam*, 808 F.3d at 1342–43.

157. *In re Ava Watkins*, 2005 WL 548042, at \*1 (T.T.A.B. 2005); Kustina, *supra* note 139, at 521.

158. Brief for Erik Brunetti as Amicus Curiae Supporting Plaintiff, *Lee v. Tam*, 137 S. Ct. 30 (2016) (No. 15-1293).

159. Kustina, *supra* note 139, at 516.

calling out [for] condemnation.” The PTO must consider the mark in the context of the marketplace as applied to only the goods described in [the] application for registration.<sup>160</sup>

Yet, here the PTO has applied this standard consistently: “In the scandalousness context, the most ‘vulgar’ words were denied registration most frequently and most consistently.”<sup>161</sup> Terms like “[f]uck” and “asshole” received no registrations whatsoever, and . . . [v]ery few marks using ‘shit’ were granted.”<sup>162</sup>

One explanation for these varied outcomes may be that trademark examiners find it easier to collect evidence of scandalousness than of disparagement. “For scandalousness, most examiners rely on dictionary definitions that deem the word to be offensive, vulgar, profane, or scandalous to support a section 2(a) determination.”<sup>163</sup> For disparagement, however, dictionary definitions and internet searches are considered “lower-quality, less-reliable information” and “the PTO lacks the resources to assemble high-quality evidence[—]such as surveys, personal affidavits, petitions, and expert linguistic analysis[—]to assess” the public’s actual perception.<sup>164</sup>

#### *B. Section 2(a) Conflicts with Basic First Amendment Rights.*

The Supreme Court’s holding in *Matal*—that section 2(a)’s disparagement clause is unconstitutional—is aligned with our national interest in unimpeded freedom of speech. Although the government does not always approve of messages conveyed in public debate, it permits citizens to use deprecating and degrading language, if they so choose, with little to no restrictions.<sup>165</sup> These permissions, referred to as

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160. *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

161. Kustina, *supra* note 139, at 526.

162. *Id.* at 527.

163. *Id.* at 528.

164. *Id.* at 521.

165. *See Snyder v. Phelps*, 580 F.3d 206, 214 (4th Cir. 2009) (holding that “[a]s a general matter, the fact that society may find speech offensive is not a sufficient reason for suppressing it. Speech that is called hateful, or speech that is unpopular, or speech with which you strongly disagree, may still be protected speech. The Government, including the courts, can place reasonable time, place, and manner restrictions on how protected speech may be expressed.

the “breathing space” afforded by the First Amendment,<sup>166</sup> illustrate the government’s long-standing dedication “to protect[ing] even hurtful speech on public issues to ensure that we do not stifle public debate.”<sup>167</sup>

It is well established that “speech cannot be restricted simply because it is upsetting.”<sup>168</sup> In *Snyder v. Phelps*, the Supreme Court held that the Westboro Baptist Church’s picketing of a soldier’s funeral with hurtful signs and slogans was constitutionally protected speech.<sup>169</sup> Some of those signs, such as “Fag troops,” “God hates fags,” and “Fags doom nations,” used the exact type of language prohibited under section 2(a)’s disparagement ban.<sup>170</sup> Markholders who choose to use similarly disparaging marks have now been granted the same protection in the form of federal trademark registration, a protection that, logically, should be extended to scandalous and immoral marks. The “few categories of speech that the government can regulate or punish—for instance, fraud, defamation, or incitement—are well established within our constitutional tradition.”<sup>171</sup> Scandalous and immoral marks, like disparaging marks, do not fall into these categories. Trademarks, which are created, promoted, and funded by the markholder,<sup>172</sup> should not receive differential treatment simply because the PTO must approve them prior to registration. Allowing federal registration of potentially disparaging, scandalous, and immoral trademarks both protects and is mandated by the First Amendment.

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These restrictions must be narrowly tailored, and should balance the interests of all the people involved”).

166. *Boos v. Barry*, 485 U.S. 312, 322 (1988).

167. *Snyder v. Phelps*, 562 U.S. 443, 460–61 (2011).

168. *Id.* at 458; *see also* *Brown v. Entm’t Merchants Ass’n*, 564 U.S. 786, 798 (2011) (holding that “disgust is not a valid basis for restricting expression”).

169. *Snyder*, 562 U.S. at 463.

170. *Id.* at 448.

171. *Tam*, 137 S. Ct. at 1765.

172. *In re Tam*, 808 F.3d at 1353 (explaining that “since 1991 [PTO] appropriations have been funded entirely by [trademark] registration fees, not the taxpayer”).

C. *Section 2(a) Contravenes Federal Trademark Law's Objectives.*

Section 2(a)'s ban on disparaging, immoral, and scandalous trademarks also undermines the trademark system's purpose. The Lanham Act's other restrictions support trademark protection's public policy; they limit markholders from registering marks likely to "cause confusion . . . mistake . . . or to deceive,"<sup>173</sup> as well as marks that are "deceptively misdescriptive."<sup>174</sup> Viewed under a policy lens, section 2(a)—with its "hodgepodge of restrictions"—is out of place.<sup>175</sup> In fact, section 2(a)'s restrictions directly conflict with Lanham Act's objectives.<sup>176</sup> By allowing the PTO to revoke a mark's protection whenever it deems it offensive, section 2(a) can be used to injure a markholder after he or she "has invested millions of dollars protecting its brand identity and consumers have come to rely on the mark as a brand identifier."<sup>177</sup>

By denying trademark protection to The Slants from December 2012 to June 2017, the Lanham Act imposed a heavy burden on the band—it restricted Tam's sole claim to the band name, as evidenced by "other bands [that] have named themselves The Slants."<sup>178</sup> This hurt the band in two ways: it negatively affected them financially, and it led to consumer confusion.

First, other bands' ability to freely name themselves "The Slants" greatly restricted Tam's financial earnings.<sup>179</sup> Without federal trademark protection, Tam and his band could not fully benefit from the mark they spent years cultivating. Instead, others using the mark

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173. 15 U.S.C. § 1052(d) (2017).

174. 15 U.S.C. § 1052(e) (2017); *In re Tam*, 808 F.3d at 1329.

175. *In re Tam*, 808 F.3d at 1329.

176. *Id.*

177. *Id.* at 1330.

178. Ian Shapira, *The Slants and the Redskins: 'We Are Unlikely Allies,' Band's Founder Says*, WASH. POST (Dec. 23, 2015), [https://www.washingtonpost.com/local/the-slants-and-the-redskins-we-are-unlikely-allies-the-bands-founder-says/2015/12/23/a16c3ce4-a9b8-11e5-9b92-dea7cd4b1a4d\\_story.html](https://www.washingtonpost.com/local/the-slants-and-the-redskins-we-are-unlikely-allies-the-bands-founder-says/2015/12/23/a16c3ce4-a9b8-11e5-9b92-dea7cd4b1a4d_story.html) [<https://perma.cc/64T4-FU5W>].

179. P. Sean Morris, *The Economics of Distinctiveness: The Road to Monopolization in Trade Mark Law*, 33 LOY. L.A. INT'L & COMP. L. REV. 321, 323 (2011).

profited from Tam's "sweat-of-the-brow,"<sup>180</sup> contravening the Lanham Act's purpose and placing a financial burden on the markholder.<sup>181</sup> This financial burden, itself a form of speech suppression<sup>182</sup> and offensive to the First Amendment,<sup>183</sup> is magnified by a markholder's limited protections under the common law. And "[w]ithout the recognition of nationwide constructive use conferred by federal registration, a competitor can swoop in and adopt the same mark for the same goods in a different location."<sup>184</sup> Likewise, Tam and The Slants were also prevented from stopping "importation of goods bearing [the band's] mark," and could not "recover treble damages for willful infringement."<sup>185</sup>

Second, the lack of absolute trademark protection afforded to The Slants prior to June 2017 led to consumer confusion. Congress created the Lanham Act, in large part, to protect "the consuming public from deception."<sup>186</sup> Yet, here the PTO's refusal to register "The Slants" caused consumer confusion and led to public deception. For instance, the existence of another band named The Slants resulted in fans mistakenly buying concert tickets under the false impression that they were going to see Tam's band.<sup>187</sup> These mistakes were the direct result of confusion and deception caused by section 2(a)'s disparagement ban.<sup>188</sup> Ultimately, the ban enabled the exact behavior it was designed

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180. "Sweat of the Brow" is an intellectual property law doctrine that first appeared in copyright cases. The "underlying notion" behind the term was "that copyright was a reward for the hard work that went into compiling facts." *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 352 (1991).

181. S. REP. NO. 79-1333, at 3 (1946).

182. *Pitt News v. Pappert*, 379 F.3d 96, 106 (3d Cir. 2004).

183. *Rosenberger v. Rector & Visitors of the Univ. of Va.*, 515 U.S. 819, 828 (1995).

184. *In re Tam*, 808 F.3d at 1343.

185. *Id.*

186. Lynda J. Oswald, *Challenging the Registration of Scandalous and Disparaging Marks Under the Lanham Act: Who Has Standing to Sue?*, 41 AM. BUS. L. J. 251, 257 (2004).

187. Shapira, *supra* note 178.

188. *Id.*

to deter: the misappropriation of Tam’s mark and the confusion and deception of his fans.<sup>189</sup>

*D. Eliminating Section 2(a) Will Not Create a Sudden Influx of Disparaging, Scandalous, or Immoral Trademarks.*

Proponents of section 2(a)’s disparagement provision maintained that without the ban, the federal government would “affirmatively promote the use of racial slurs and other disparaging terms.”<sup>190</sup> However, the Lanham Act’s previous blanket ban on disparaging, scandalous, and immoral marks is not the only means for preventing distasteful trademarks; other methods are available to minimize the number of potentially disparaging and scandalous trademarks registered.

Even after the Supreme Court struck down section 2(a)’s disparagement ban as unconstitutional, the PTO still faces little danger of bombardment by an influx of disparaging trademark applications. While it is true that pre-existing disparaging marks can now receive registration, and that many new marks that would have previously been rejected as disparaging can now be registered,<sup>191</sup> the uncertainty and concern over the effects of the Supreme Court’s holding is likely unfounded. On a day-to day-basis, the average person faces a low number of unregistered disparaging marks.<sup>192</sup> The United States, as a nation, continues to be defined by its traditional and conservative values.<sup>193</sup> As a result, businesses and individuals have learned that it is

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189. *Id.*

190. Petition for Writ of Certiorari, *Lee v. Tam*, 137 S. Ct. 30 (No. 15-1293) at \*10.

191. *Why You Should Give A \$\*%! about Words that Offend*, NPR (May 13, 2013, 5:20 AM), <http://www.npr.org/2013/05/13/180811135/why-you-should-give-a-about-words-that-offend> [https://perma.cc/VP6J-V59D].

192. In the United States, consumers can still find goods and services with immoral, scandalous, or disparaging names. For instance, customers can get their doors trimmed at Beaver’s Trim Shop in Texas, can purchase lumber from Dykes Lumber Company in New Jersey, and hire a handyman through LP Coplete Hoe Repair in New York. Though perhaps not named in good taste, names like these are scarce and carry a connection to the owner or the type of good or service provided by the company. John Boitnott, *15 of the Worst Business Names in History*, INC. (Sept. 30, 2014), <http://www.inc.com/john-boitnott/15-of-the-worst-business-names-in-history.html> [https://perma.cc/3GFM-E5RD].

193. *See generally The American-Western European Values Gap*, PEW RESEARCH CENTER (Feb. 29, 2012), <http://www.pewglobal.org/2011/11/17/the-american-western-european->

generally good practice to lean toward neutral or positive representations when selecting names, images, and sounds for their marketed goods and services.<sup>194</sup> Fear of unease, contempt, and even boycott drives most markholders to shy away from selecting and promoting negative and disparaging trademarks.<sup>195</sup> *Matal v. Tam*'s effective removal of section 2(a)'s ban on disparaging trademarks is unlikely to change this fundamental business practice.

By prohibiting the PTO from rejecting marks solely on the basis of disparagement, the Court eliminated the government's means of "disapprov[ing] of the messages conveyed by disparaging marks."<sup>196</sup> However, given our nation's continued sensitivity to certain words and images,<sup>197</sup> the court of public opinion will likely assume section 2(a)'s previous role. Because consumers possess great purchasing power, they can, in a sense, regulate the number of registered disparaging trademarks used.<sup>198</sup> Even minority groups and those potentially

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values-gap/ [https://perma.cc/6QGV-VY4U], (finding that Americans are more socially conservative, religious, and less tolerant of homosexuality than European counterparts); Sarah-Jane Stratford, *Conservative Americans are more terrified of sex than violence*, THE GUARDIAN (Nov. 4, 2013, 1:18 PM), https://www.theguardian.com/commentisfree/2013/nov/04/blue-is-the-warmest-colour-shocking [https://perma.cc/TX8D-GYXM]; *Why You Should Give A \$\*%! about Words that Offend*, *supra* note 191.

194. See generally Vince Bridgman, *Why You Should Care about the Name You Give Your Company*, BPLANS, <http://articles.bplans.com/when-company-names-go-bad/> [https://perma.cc/4PCN-S7KX]; Susan Ward, *5 Rules for Choosing a Business Name*, BALANCE, <https://www.thebalance.com/rules-for-choosing-a-business-name-2948575> (last updated Feb. 21, 2017) [https://perma.cc/Z6YZ-8R84]; Joanna Wiebe, *How to Name a Product —Do This, Avoid That*, COPYHACKERS (July, 2012), <https://copyhackers.com/2012/07/how-to-name-a-product> [https://perma.cc/W9Y8-8B2P]; Krystal Peak, *Company names exposed: The good, the bad and the truly awful*, S.F. BUS. TIMES (Nov. 4, 2011), <http://www.bizjournals.com/sanfrancisco/blog/2011/11/whats-in-a-name-the-good-and-the-bad.html> [https://perma.cc/2KL2-D4SZ] (discussing branding expert Alexandra Watkins' "12-point 'Smile or Scratch' test to help businesses test their brands or product names—posing the question, 'When you hear the company name does it make you smile or scratch your head?'").

195. See Bridgman, *supra* note 194; Wiebe, *supra* note 194.

196. *In re Tam*, 808 F.3d at 1327.

197. *Why You Should Give A \$\*%! about Words that Offend*, *supra* note 191 (asserting that although the United States has become more accepting of some swear words over time, there is always a category of swear words that remain off limits, and that today, this category includes "the racial slurs and epithets that sum up people in some way").

198. *Power at Last*, THE ECONOMIST (Mar. 31, 2005), <http://www.economist.com/node/3810230> [https://perma.cc/PTV9-RMYT].

disparaged by the terms possess this potent and influential power.<sup>199</sup> Offended groups can avoid, ignore, protest, or even boycott a registered trademark deemed truly offensive.<sup>200</sup> Consumers can not only decline to purchase goods or services associated with a mark deemed disparaging, they can also make a conscious effort to purchase from a competitor with a neutral or positive mark.<sup>201</sup> The potential for such action incentivizes creators and owners of goods and services to steer clear of names that may be deemed racist, sexist, homophobic, xenophobic, bigoted, or offensive to other group identities.

A crucial illustration of this alternative to a section 2(a) disparagement ban can be found in the Washington Redskins' most recent experience. As described above, the Washington Redskins' football team has come under attack for its trademarked team name and logo, marks which many find disparaging to Native Americans.<sup>202</sup>

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199. See generally Bridget Brennan, *Top 10 Things Everyone Should Know about Women Consumers*, FORBES (Jan. 21, 2015), <http://www.forbes.com/sites/bridgetbrennan/2015/01/21/top-10-things-everyone-should-know-about-women-consumers/#2059dea8289> [<https://perma.cc/M9L9-EAGJ>] (explaining that “[w]omen drive 70-80% of all consumer purchasing, through a combination of their buying power and influence,” meaning that “even when a woman isn’t paying for something herself, she is often the influence or veto vote behind someone else’s purchase”); Janie Boschma, *Black Consumers Have ‘Unprecedented Impact’ in 2015*, ATLANTIC (Feb. 2, 2016), <http://www.theatlantic.com/politics/archive/2016/02/black-consumers-have-unprecedented-impact-in-2015/433725/> [<https://perma.cc/63NV-HE9Q>]; Jeff Green, *LGBT Purchasing Power Near \$1 Trillion Rivals Other Minorities in 2015*, BLOOMBERG (Jul. 20, 2016, 10:00 AM), <http://www.bloomberg.com/news/articles/2016-07-20/lgbt-purchasing-power-near-1-trillion-rivals-other-minorities> [<https://perma.cc/GA8T-98ZT>] (explaining that in 2015, “[t]he combined buying power of U.S. lesbian, gay, bisexual and transgender adults rose . . . to \$917 billion”); Nielsen: *Asian-American Buying Power Increased by More than \$50 Billion in One Year—Expected to Hit \$1 Trillion by 2018*, NIELSEN (Nov. 6, 2015), <http://www.nielsen.com/ma/en/press-room/2015/nielsen-asian-american-buying-power-increased-by-more-than-50B-in-one-year.html> [<https://perma.cc/JWY4-7XMB>], (explaining that in 2014, “Asian-American buying power increased 7% from \$718 billion to \$770 billion . . . and continues to rise”).

200. 1-3 ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 3.04 (2017) (noting that “if a mark were truly offensive to a substantial portion of the public, consumers would refuse to buy the associated goods or services, which could effectively “remov[e] the mark from the marketplace”).

201. In the past, courts have proposed leaving consumer behavior-related choices to the marketplace. For instance, in *Basile v. H&R Block, Inc.*, 563 Pa. 359, 371 (2000), the court was asked to determine whether tax preparation company H&R Block violated agency law through deceitful business practices. Although the court failed to find an agency relationship, it opined that “[i]f Block’s method of doing business is worthy of the condemnation that appellees suggest, presumably the marketplace will react to correct it.”

202. *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 482 (E.D. Va. 2015); Angela R. Riley & Kristen A. Carpenter, *Owning Red: A Theory of Indian (Cultural) Appropriation*, 94



Despite the backlash against the mark's use, team owner Daniel Snyder decided to keep the Redskins' name and logo as is.<sup>203</sup> His refusal to heed public opinion seems to have cost the team. Because Snyder refused to change the team's marks to something less offensive to Native Americans, the team has been prevented from becoming "a national powerhouse like the Cowboys."<sup>204</sup> More obviously, the Redskins' devotion to its disparaging trademark has hurt its financial growth potential.<sup>205</sup> In mid-2014, at the height of the Redskins controversy, Redskins merchandise sales were down 35%, even though overall NFL merchandise sales were up 3%.<sup>206</sup> And even now that the Redskins' trademark was deemed constitutional, consumers show no signs of letting up. As recently as August 2017, Kirk Cousins was the only Redskins player to make the Top 50 Player Sales List (based on overall sales of all licensed products).<sup>207</sup> Perhaps a change to a less controversial name would increase ticket and merchandise sales and restore the team's positive perception lost as a result of its trademark dispute and subsequent litigation.<sup>208</sup>

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TEX. L. REV. 859, 911 (2016); Peter Keating, *Washington Has Everything to Lose*, ESPN (Sept. 2, 2014), [http://www.espn.com/nfl/story/\\_/id/11419303/washington-redskins-losing-money-keeping-name](http://www.espn.com/nfl/story/_/id/11419303/washington-redskins-losing-money-keeping-name) [<https://perma.cc/3HPP-KGGK>].

203. Keating, *supra* note 202.

204. *Id.*

205. *Id.*

206. Chris Isidore, *Redskins Gear Stiff-Armed by Fans*, CNN MONEY (Sept. 4, 2014, 3:57 PM), <http://money.cnn.com/2014/09/04/news/companies/redskins-merchandise/> [<https://perma.cc/QE98-J9NH>];

*see also* Ryan Wilson, *Report: Redskins Merchandise Sales Dropped Sharply in Last Year*, CBS SPORTS (Sep. 7, 2014), <http://www.cbssports.com/nfl/news/report-redskins-merchandise-sales-dropped-sharply-in-last-year/> [<https://archive.is/oqAYz>] (reporting that Redskins sales were poorer than many teams who failed to make the playoffs in 2014, and that "[n]o NFL team has seen a sharper drop in year-over-year merchandise sales in the past year than the Redskins").

207. Scott Allen, *Four Cowboys, Plus Colin Kaepernick, Rank ahead of Any Redskins in Merchandise Sales*, WASH. POST (Aug. 1, 2017), [https://www.washingtonpost.com/news/dc-sports-bog/wp/2017/08/01/four-cowboys-plus-colin-kaepernick-rank-ahead-of-any-redskins-in-merchandise-sales/?utm\\_term=.2027ff22f257](https://www.washingtonpost.com/news/dc-sports-bog/wp/2017/08/01/four-cowboys-plus-colin-kaepernick-rank-ahead-of-any-redskins-in-merchandise-sales/?utm_term=.2027ff22f257) [<https://perma.cc/WR8L-BQ68>]. It is worth noting that even Colin Kaepernick, the NFL player who caused controversy by refusing to stand for the National Anthem, ranked over ten spots higher than Kirk Cousins on the Top 50 list. *Id.*

208. Or perhaps the Redskins can learn from Florida State University's approach to using the Native American Seminole as their school mascot: "For almost 70 years, Florida State has

In addition to dealing financial blows to markholders with disparaging marks, consumers can—and do—use their voices to speak out against the use of such trademarks. For example, in recent years, popular protests against, and growing distaste for, the Redskins has lead sportscasters to avoid using the team’s name on television, prompted newspapers to refuse to publish the name,<sup>209</sup> and even caused a reduction in the team’s number of Twitter followers.<sup>210</sup>

This form of consumer-based market regulation would even be effective for marks like THE SLANTS, chosen to reclaim once-disparaging language. If the negative language has truly regained positive meaning amongst a substantial composite of the referenced group, then the market will likely respond with neutrality or even acceptance and buy-in. On the other hand, if the disparaging term has not yet lost its offensive meaning or been repossessed by the targeted group, that mark’s owner can likely expect the form of backlash experienced by Snyder and the Washington Redskins, perhaps on a smaller scale and stage.<sup>211</sup>

These same market concerns apply to markholders who choose to select scandalous or immoral marks. In *In re FOX*, the Federal Circuit affirmed a trademark examiner’s decision to reject registration of the mark COCK SUCKER under grounds that the mark was scandalous.<sup>212</sup> Although it is by no means a household name, this brand of rooster-shaped lollipops has existed since 1979.<sup>213</sup> These lollipops are mostly

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worked closely, side by side, with the Seminole Tribe of Florida in a relationship that is mutually supportive and built on respect.” The University considers the Seminoles’ history and traditions in representing the tribe during games and frequently consults the tribe to ensure accuracy and authenticity. The University has received enthusiastic support from the Seminole Tribal Council, a distinction Florida State takes seriously. Autumn A. Arnett, *The Future of Native American Imagery in Sports*, ATLANTIC (Nov. 21, 2015), <http://www.theatlantic.com/education/archive/2015/11/native-imagery-in-college-sports/417036/> [<https://perma.cc/8W4J-R7CV>].

209. Andrew Beaujon, *Here’s a List of Outlets and Journalists Who Won’t Use the Name ‘Redskins’*, POYNTER (June 19, 2014), <http://www.poynter.org/2014/heres-a-list-of-outlets-and-journalists-who-wont-use-the-name-redskins/256258/> [<https://perma.cc/KHV9-Q2HX>].

210. Isidore, *supra* note 206.

211. Keating, *supra* note 202 (noting that in September 2014, the Washington Redskins ranked “20th in the NFL with 319,000 Twitter devotees,” although “[t]he team should have [had] roughly 60,000 more . . . which would place it 16th in the league”).

212. *In re Fox*, 702 F.3d 633, 634 (Fed. Cir. 2012).

213. *Id.* at 635.

displayed in retail-outlets accessible “to fans of the University of South Carolina and Jacksonville State University, both of which employ gamecocks as their athletic mascots.”<sup>214</sup> The lollipops may also serve as an amusing gag gift or novelty: distributed as gifts at bachelorette parties or shared between juvenile friends.<sup>215</sup> Its defining characteristic—the name Cock Sucker—does the product’s success a greater disservice than a neutral or positive name would. Although children make up a large portion of the candy and lollipop market’s target audience, they are not the target market here. Parents—who supply children with their candy—are probably less likely to purchase Cock Sucker-branded lollipops for their children over more appropriately-named options like Tootsie Pops or Dum-Dums.

Government fear of losing control over the nation’s morality is unfounded; the PTO was already less effective than consumer forces at deterring the use of scandalous and immoral marks. For instance, although Cock Sucker lollipops were denied trademark registration, Fox could use the unregistered Cock Sucker mark.<sup>216</sup> A more effective means of deterring the use of immoral, offensive, and vulgar content would be for retail stores, en masse, to refuse to carry the offending lollipops, for only “adult-themed” stores to purchase the lollipops, or for shopkeepers to place the lollipops on a higher and less visible shelf. The *Fox* court itself pointed out that if the plaintiff was “correct that the mark at issue ‘bring[s] [nothing] more than perhaps a smile to the face of the prospective purchaser, . . . then the market will no doubt reward her ingenuity.”<sup>217</sup> The market can—and often does—decide how much exposure a product receives, how popular it will become, and how many sales it will garner. In a nation generally hesitant to embrace scandalous and vulgar images, terms, and products, finding great success with a scandalous mark is a challenging feat, with or without PTO approval.

In his concurring opinion in *Matal*, Justice Kennedy wrote that “[t]he First Amendment does not entrust” the power to protect the public from offensive speech “to the government’s benevolence.

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214. *Id.*

215. Similarly, in *In re Brunetti* the TTAB acknowledged that the scandalous mark at issue in its case—’FUCTION’—represents a “niche market,” one that is strong but small nevertheless. *In re Brunetti*, 2014 WL 3976439, at \*11.

216. *In re Fox*, 702 F.3d at 640.

217. *Id.* at 639.

Instead, our reliance must be on the substantial safeguards of free and open discussion in a democratic society.”<sup>218</sup> Fear of low sales and bad publicity will compel most trademark registrants to choose marks that are less offensive or polarizing and more neutral, safe, and harmless. This form of market-based trademark regulation is the type of safeguard Justice Kennedy envisioned in *Matal*, a realistic compromise between the government’s desire to protect consumers from disparaging, scandalous, and immoral language and our nation’s dedication to protecting its First Amendment rights.

#### *E. Section 2(a)’s Future*

Experts seem to believe that the *Matal* “decision will apply equally to the section 2(a) bar for ‘immoral’ and ‘scandalous’ terms.”<sup>219</sup> Significantly, following the Federal Circuit’s decision in *Tam*, the government itself “conceded that the holding . . . requires the invalidation of Section 2(a)’s prohibition against registering scandalous and immoral marks as well.”<sup>220</sup> “[W]hen the USPTO denies registration to marks that it deems to be “immoral” or “scandalous,” it does so on the basis that the government disapproves of the expressive message conveyed in the mark.”<sup>221</sup> Disapproval of a message, which was not enough for the *Matal* Court, is unlikely to save the fate of section 2(a)’s ban on scandalous or immoral marks in *In re Brunetti*.

*Matal* has already determined that trademarks are neither government speech, nor a form of government subsidy, nor a type of government program.<sup>222</sup> If the government cannot silence a hateful mark, it is unlikely it can silence a distasteful one. In finding section 2(a)’s disparagement clause unconstitutional, *Matal* was clear: “[T]he government never can attempt to regulate speech based on its

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218. *Tam*, 137 S. Ct. at 1769.

219. J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §19:77 (5th ed., 2017).

220. *Id.*

221. *Id.*

222. *Tam*, 137 S. Ct. at 1757–64.

offensiveness.”<sup>223</sup> Like the terms REDSKINS or SLANT, the term FUCT is undoubtedly offensive to many.<sup>224</sup> The government, however, should not be allowed to reject scandalous marks while barred from rejecting disparaging ones. If *Matal* instructs us to protect the freedom to express even hateful thoughts,<sup>225</sup> this directive should logically include speech considered immoral or scandalous.

## V. CONCLUSION

Scholars have hailed *Matal* as “the most important free speech case of the year.”<sup>226</sup> It is worth noting that because The Slants have won, so have the Redskins. As Simon Tam and his band celebrate finally being able to benefit from a trademark they assert is reclaiming a derogatory term, so too do the Redskins regain their ability to profit from their racially insensitive trademarks. Yet, our consumer-regulated market dictates that this should not be a cause for concern. By accepting certiorari for Tam over the Redskins, the Supreme Court clearly chose the more sympathetic plaintiff. American consumers, however, will likely not be as sympathetic to holders of disparaging trademarks.

With *Matal v. Tam*, the Supreme Court altered the Lanham Act to better align it with our changing societal standards and to conform with the U.S. Constitution. The Federal Circuit now has an opportunity to make the same great strides with *In re Brunetti*. Section 2(a) of the Lanham Act is vague, creates uncertainties for trademark examiners and markholders, impedes our First Amendment right to free speech, and stands in stark conflict with the Lanham Act’s purpose and trademark law’s principles. Denying trademark registration to disparaging, scandalous, and immoral marks exposes markholders to financial harm, while allowing others to reap where the original markholder has sown. It also exposes consumers to possible confusion and deceit.

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223. Erwin Chemerinsky, *Waiting for Gorsuch October Term 2016*, 20 Green Bag, 2d 351, 357 (2017); see also Tam, 137 S. Ct. at 1751 (holding that “[s]peech may not be banned on the ground that it expresses ideas that offend”).

224. *In re Brunetti*, 2014 WL 3976439, at \*5.

225. *Tam*, 137 S. Ct. at 1764.

226. Erwin Chemerinsky, *Waiting for Gorsuch October Term 2016*, 20 GREEN BAG 2d 351, 357 (2017).

Eliminating section 2(a)'s ban on disparaging, scandalous, and immoral marks is the best solution to the problems it currently presents. And, a finding that these provisions of section 2(a) are unconstitutional is unlikely to inundate the PTO with trademark applications for disparaging marks. Rather, our consumer-driven market will continue to ensure that controversial or derogatory products and services will find less success than their counterparts.

Our nation is in a different place now than when Simon Tam first began his legal battle. Recent events have displayed an uptick in racial, political, and gender tensions and sensitivities, particularly in the wake of the 2016 U.S. Presidential election.<sup>227</sup> Despite this, *Matal* reaffirms the notion that free speech must remain free, even if it is hateful.

In 2017, The Slants released their latest album, entitled "The Band Who Must Not Be Named," a play on their years spent in trademark limbo while fighting for their right to federal trademark recognition. After a long battle, The Slants have finally won their right to freedom of expression; their efforts now afford many others that same right.

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227. See *Post-Election Spike in Hate Crimes Persists in 2017*, PBS (Aug. 13, 2017), <http://www.pbs.org/newshour/bb/post-election-spike-hate-crimes-persists-2017/> [https://perma.cc/UQE9-9UQX].