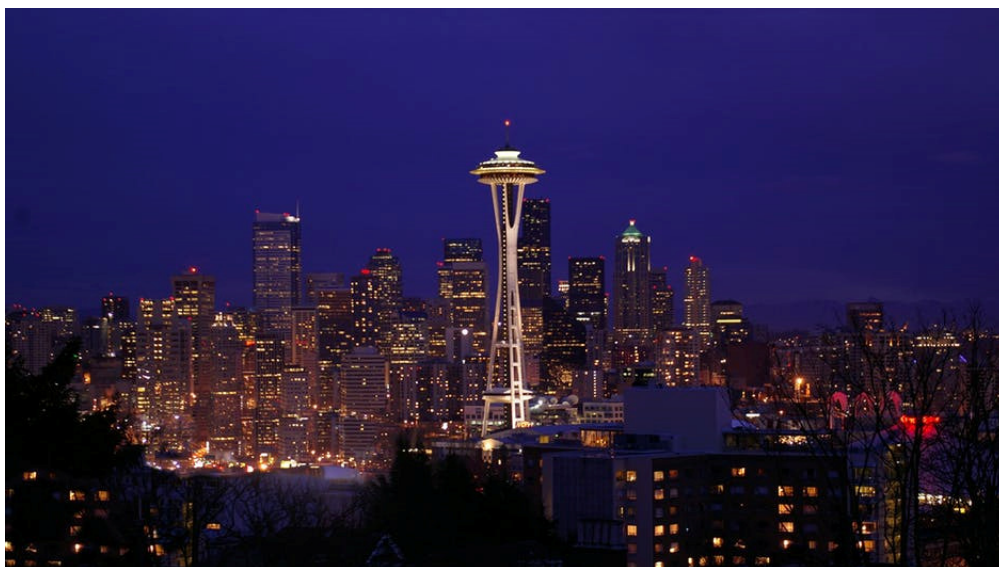


United States Supreme Court Rules Law Prohibiting Registration Of Disparaging Trademarks Is Unconstitutional



Section 15 U.S.C. § 1052(a) of the federal trademark statute authorizes the United States Patent and Trademark Office (the "PTO") to refuse registration of trademarks that may disparage or falsely suggest an association with persons institutions, beliefs, or national symbols, or bring them into contempt or disrepute. This rule is generally referred to as the "Disparagement Clause".

Simon Tam is a member of the musical group "The Slants". The term "slants" is short for "slanty eyed," a racial slur used to refer to Asians. The band was founded in Portland, Oregon in 2006. All members of The Slants are of Asian or Pacific Islands ethnicity and the band members are well known for their involvement with the Asian American community, often playing at large cultural festivals and sending a message against racist stereotypes through their music.

On November 14, 2011, Simon Tam filed a trademark registration application with the PTO seeking to register the mark "THE SLANTS" for "Entertainment in the nature of live performances by a musical band," based on his use of the mark since 2006. The examiner found that the mark likely referred to people of Asian descent in a disparaging way, explaining that the term "slants" had "a long history of being used to deride and mock a physical feature" of people of Asian descent. Even though Mr. Tam may have chosen the mark to re-appropriate the disparaging term, the examiner found that a substantial composite of persons of Asian descent would find the term offensive. For those reasons, the PTO examiner refused to register the mark, deeming it likely disparaging to persons of Asian descent under the Disparagement Clause.

Tam appealed this refusal to the United States Court of Appeals for the Federal Circuit¹. This appeal was accepted in December 2015 when the Court ruled that the Disparagement Clause was an unconstitutional infringement of free speech. The PTO tried to defend their position before the Federal Circuit by saying that they should be able to deny protection to the most vile racial epithets and images. However, the Federal Circuit ruled that "When the government discriminates against speech because it disapproves of the message conveyed by the speech, it discriminates on the basis of viewpoint." The Federal Circuit bolstered its position that the Disparagement Clause is subjective viewpoint discriminatory because the PTO refused to register "The Slants", however the PTO had previously registered marks such as "Celebrasians" and "Asian Efficiency". The court determined that the disparaging provision is viewpoint discriminatory and therefore unconstitutional. The Federal Circuit came to the determination that even though trademarks inherently deal more with commercial speech versus expressive speech, when the government cancels a mark under the Disparagement Clause, it is affecting more of the expressive aspects of speech and not the commerciality of it.

This decision in favor of Tam and The Slants was appealed to the Supreme Court. On June 19, 2017, the Supreme Court unanimously affirmed the Federal Circuit's ruling that the Disparagement Clause violates the First Amendment's Free Speech Clause. Justice Alito delivered the opinion of the Court, stating:

"We now hold that this provision violates the Free Speech Clause of the First Amendment. It offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend."

In the words of the Court, trademarks are private speech protected by the First Amendment. The court stated that making a statement through a trademark, which is deemed offensive by another is a viewpoint, cannot be prevented according to freedom of speech. Justice Samuel Alito cited the 1929 Supreme Court Case *United States vs. Schwimmer*, which elaborated on the meaning of free speech:

"Speech that demeans on the basis of race, ethnicity, gender, religion, age, disability, or any other similar grounds is hateful; but the proudest boast of our free speech jurisprudence is that we protect the free to express the thought that we hate²."

The Supreme Court ruling in TAM affects a trademark that has far more commercial value than The Slants-that of the NFL team the Washington Redskins.

On September 10, 1992, seven Native Americans led by activists Suzan Harjo filed a petition with the PTO to cancel the trademark registrations owned by the Redskins' corporate entity, Pro-Football, Inc. The Washington Redskins defended itself, arguing that most Native Americans were not offended by the name, and that the activists hadn't proved that the name was widely considered an offensive slur. The legal battle went on for seven years until in 1999 the PTO canceled the registration of the mark "REDSKINS" on the grounds that the marks may disparage Native Americans and may bring them into contempt or disrepute. The Washington Redskins appealed the decision to a district court in the District of Columbia in *Pro-Football, Inc. v.*

Harjo³. In 2005 the Court reversed the PTO's decision on the grounds of insufficient evidence of disparagement. Subsequent appeals have been rejected on the basis of laches, which means that the specific Native American plaintiffs had pursued their rights in an untimely and delayed manner.

Following the failure of Suzan Harjo's petition, Amanda Blackhorse, a Navajo activist, and four other Native Americans filed their own petition with the PTO, seeking again to revoke the Washington Redskin's registrations.

In June 2014, the PTO ruled in Blackhorse's favor, scheduling the cancellation of the Washington Redskins' registrations. The Washington Redskins appealed, but in 2015 the U.S. District Court in Alexandria ruled again in favor of Blackhorse. U.S. District Judge Gerald Bruce Lee's decision affirmed an earlier ruling by the federal Trademark Trial and Appeal Board which had declared the team's trademarks as offensive to Native Americans and therefore ineligible for federal trademark protection. The U.S. District Court rejected the team's argument that the vast majority of Native Americans had no objection to the name when the trademarks were granted between 1967 and 1990. Instead, the judge questioned why the team ever chose the name, pointing out that Webster's Collegiate Dictionary defined the word as "often contemptuous" in 1898, "seventy years prior to the registration of the first Redskins Mark."

The Washington Redskins disagreed, citing infringement of their First Amendment right to free expression, taking their case to the U.S. Court of Appeals for the 4th Circuit in Richmond, where it had been on hold pending the Supreme Court's decision in Simon Tam's The Slants case. Now that the Supreme Court has ruled in The Slants' favor, the legal challenge against the Washington Redskins appears to have been defeated.

For businesses that want to have confrontational or socially provocative trademarks, the path to registering those marks is now available. On the other hand, businesses need to be careful what they wish for. Launching a trademark or brand that may offend a particular ethnic group may be permissible according to the US Supreme Court, however could result in serious damage to a business' or brand's public image.

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