

**Disparaging Trademarks in the US:  
The Redskins, the Slants  
and the First Amendment**

April 1, 2016

## § 2(a) of the Lanham Act – Bars to Registration

No trademark [...] shall be refused registration [...] unless it

(a) consists of [...] matter which may disparage [...] persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; [...]

# Standard applied by USPTO

- (1) 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**
- (3) At the time of registration.

## REDSKINS

- Trademarks registered in 1967, 1974, 1978
- 2006: cancellation proceeding by Blackhorse
- 2014: TTAB finds marks to be disparaging
- 2014 Appeal filed with District Court Alexandria

## THE SLANTS – In Re Tam

- 2011: trademark application filed
- Examiner refuses registration
- 2013: TTAB affirms refusal
- 2013: Appeal filed with Federal Circuit

## REDSKINS

- July 2015: Court affirms TTAB:  
“2(a) does not implicate the First Amendment”
- Oct 2015: Appeal filed with 4<sup>th</sup> Circuit

## THE SLANTS – In Re Tam

- April 2015: Fed. Cir. affirms TTAB
- April 2015: Fed. Cir. orders rehearing en banc sua sponte
- Dec 2015: Fed. Cir. en banc decision

**Court of Appeal for the Federal Circuit**  
***In Re Tam* en banc**

*Does the bar on registration of disparaging marks in 15 U.S.C. § 1052(a) violate the First Amendment?*

**Yes, § 2(a) is unconstitutional** as far as disparagement (Moore, Prost, Newman, O'Malley, Wallach, Taranto, Chen, Hughes, Stoll)

It depends: Dyk (concurring in part and dissenting in part)  
No: Lourie (dissenting), Reyna (dissenting)

**Why is speech banned when registration is refused?  
Any applicant can still use the mark.**

*McGinley* (CCPA 1981): First Amendment not implicated

“And while it is true that a trademark owner may use its mark in commerce even without federal registration, it has been widely recognized that **federal trademark registration bestows truly significant and financially valuable benefits** upon markholders.”

## **Isn't a trademark registration gov't speech?**

The PTO's processing of trademark registrations does not transform private speech into government speech.



## **Are trademarks expressive speech or commercial speech?**

Trademarks are more than just commercial source identifiers

### **Expressive speech**

- Political aspects of THE SLANTS
- The disparagement provision regulates expressive speech
- It depends on disapproval of the message
- It burdens speech that the gov't finds offensive

**Strict scrutiny applies** – requires compelling gov't interest

## **Are trademarks expressive speech or commercial speech?**

### **Even if trademarks were commercial speech**

- Intermediate scrutiny applies
  - requires substantial gov't interest
- § 2(a) does not meet intermediate scrutiny

“The entire interest of the government in § 2(a) depends on disapproval of the message.”

## Is a trademark registration a subsidy?

- Denial of the registration is content-based and
- has a stifling effect on speech:
- strict scrutiny applies even if it's a subsidy.

“Even when speech “inflict[s] great pain,” our Constitution protects it “to ensure that we do not stifle public debate.””

## What now?

- Disparagement provision in § 2(a) is unconstitutional in the Federal Circuit
- The USPTO is bound by it but it has not yet registered THE SLANTS
- No writ of certiorari submitted to Supreme Court yet
  
- Redskins case in the 4<sup>th</sup> Circuit:
  - 4<sup>th</sup> Circuit not bound by Federal Circuit
  - Case still in briefing stage

# Thank you!

Contact details:

Magdalena Berger

t: +1 951 667 5289

e: [mb@platz-ip.com](mailto:mb@platz-ip.com)

w: <http://platz-ip.com>

 [www.linkedin.com/in/magdalenenaberger](http://www.linkedin.com/in/magdalenenaberger)