

Ban On Disparaging Trademarks Deemed Unconstitutional

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Intellectual Property Alert

6.21.17

On June 19, 2017, the United States Supreme Court issued its long-awaited and highly anticipated ruling in the trademark case *Matal v. Tam*, 2017 U.S. LEXIS 3872. The case began when Simon Tam, the frontman of an Asian-American rock band named *The Slants*, filed a federal trademark registration application for the mark THE SLANTS in connection with "entertainment, namely, live performances by a musical band."

The Trademark Office denied the application under Section 52(a) of the Lanham Act, (the disparagement clause), which prohibits the registration of trademarks that may "disparage . . . or bring . . . into contemp[t] or disrepute" any "persons, living or dead," after holding that the word "slants" has historically been used as a derogatory term for individuals of Asian descent. Mr. Tam has attested that the band adopted the name in order to reclaim the racial slur.

Mr. Tam filed a lawsuit in federal court. The *en banc* Federal Circuit found that the disparagement clause was facially unconstitutional and a violation of the free speech clause of the First Amendment. The Supreme Court has now affirmed.

The Court rejected the government's arguments that: (i) trademarks are government speech; (ii) trademarks are a form of government subsidy, and (iii) the constitutionality of the disparagement clause should be tested under a new "government-program" doctrine.

The Court found the case law cited by the government to be largely irrelevant to the issues specific to this case and declined to expand the scope of what could be considered government speech. Furthermore, the Court determined that the disparagement clause is not viewpoint neutral, as it specifically bans offensive speech, though it applies this viewpoint equally across all groups. Justice Alito, author of the Court's opinion, clearly stated that "[s]peech may not be banned on the ground that it expresses ideas that offend."

The ruling was 8-0, with four justices joining a concurring opinion. Justice Neil Gorsuch did not participate in the case.

The Court's ruling will surely impact another famous trademark case: *Pro-Football, Inc. v. Blackhorse*, 62 F. Supp. 3d 498, otherwise known as the Redskins case. The case was put on hold pending the outcome of *Matal v. Tam*. In light of the Supreme Court's ruling, it appears the Washington Redskins are the likely victors, as the arguments against registration of the Redskins trademarks also rely on the disparagement clause of the Lanham Act.

Advocates for free speech have declared the Court's ruling to be a milestone victory. The ruling does, however, create opportunity for the federal registration of offensive trademarks, and these should be expected.

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