

Lawyers Weigh In On High Court's Offensive-TM Ruling

Law360, New York (June 19, 2017, 8:00 PM EDT) -- The U.S. Supreme Court on Monday decided in *Matal v. Tam* that the federal government's ban on offensive-trademark registrations violates the First Amendment. Here, attorneys tell Law360 why the decision is significant.

Ron Abramson, Lewis Baach PLLC

"In today's decision, there was no dissent from any side of the spectrum. The differences in the bases for the separate opinions of the justices were nuanced, going to whether it was necessary to address additional questions such as whether registered trademarks represent government or private speech. One group said it was private speech — and thus highly protected — and a second group said it didn't matter because this type of censorship would be prohibited under either standard. There will surely be a rash of fringe, and truly offensive, trademark filings as a result of this decision. However, none of them will likely ever be major brands, thus the issue should not have great practical significance."

Alan Behr, Phillips Nizer LLP

"This was the right case to put before the Supreme Court for those with the goal of striking down the disparagement clause of the trademark law. The band was using the disparaging term ironically. It is harder to object to that, in relative terms of offensiveness, than it is to a professional football team calling itself the Redskins, which is the case put on hold — after six of the team's trademark registrations had been canceled due to offensiveness — until this one was resolved."

Arash Beral, Freeman Freeman & Smiley LLP

"The opinion reflects a sign of the times: a reversal, so to speak, of the political correctness movement. Whether that is good or bad for the country will be debated heavily, but one thing's for sure: This case marks a huge win for free speech advocates."

Pat Concannon, Nutter McClennen & Fish LLP

"The *In re Tam* Supreme Court decision could have implications beyond the Lanham Act disparaging mark prohibition provision that was struck down today. Will this result embolden others to similarly challenge Section 2a registration prohibitions on 'scandalous' and 'immoral' marks? Or what about the prohibition on registration of marks that bring beliefs into disrepute? I predict that it will. Today's ruling was specific to disparaging marks, but these other Section 2a bases for prohibiting registration of 'offensive viewpoint' marks now seem ripe for challenge."

Luke DeMarte, Michael Best & Friedrich LLP

"For years, the U.S. Patent and Trademark Office inconsistently invoked the disparagement clause of the Lanham Act to deny registration to marks which were considered disparaging. The USPTO itself even acknowledged that the determination of whether a mark is disparaging is vague and highly subjective.

This case highlighted the difficulty as Simon Tam, an Asian-American musician, told the USPTO his use of The Slants was empowering, and yet the USPTO still denied the registration of his mark as disparaging. This decision will free the USPTO from its impossible burden and bring some consistency to the examination process. In pop culture terms, everyone will remember this as the case that paved the way for the Redskins to keep their trademark registrations."

Tal Dickstein, Loeb & Loeb LLP

"Though brand owners were free to use controversial or derogatory trademarks before this decision, the court's ruling striking down on First Amendment grounds the prohibition against registration of disparaging marks will offer those brand owners greater trademark protections, including the ability to enforce trademark rights nationwide, a presumption of validity and ownership and increased remedies in cases of infringement."

Thomas A. Harvey, Coblenz Patch Duffy & Bass LLP

"Today's result was expected, but nevertheless it is deeply satisfying. It affirms a basic truth: That our government cannot decide which private viewpoints should enjoy the privileges of a basic government service like trademark registration. The USPTO's regulation contradicted this principle. I'm glad it has been corrected. The Supreme Court is moderating the message from its 2015 decision in Walker v. Sons of Confederate Veterans, which permitted states to regulate the private viewpoints expressed in specialty license plates. Justice Alito, who authored today's opinion, believed the Walker decision threatened 'private speech that the government finds displeasing.'"

Howard S. Hogan, Gibson Dunn & Crutcher LLP

"This case required the court to decide whether trademark registration is more like custom license plates, which the court previously held to be government speech — and therefore subject to restriction — or private speech that is generally protected. The court unequivocally concluded that trademark registration is not government speech and warned that courts 'must exercise great caution before extending' government-speech rules to messages that originate from private parties."

J. Michael Keyes, Dorsey & Whitney LLP

"Today the U.S. Supreme Court held in Matal v. Tam that the 'non-disparagement clause' in Section 2a of the Lanham Act violated the First Amendment rights of Mr. Simon Tam. The court's decision is significant for a number of reasons: The court's decision makes it clear that trademarks represent individual speech deserving strong First Amendment protection. The 'non-disparagement' provision of the Lanham Act is no longer a bar to registering a trademark. Some suggest this could lead to a flood of trademark applications — and ultimate federal trademark registrations — containing all sorts of offensive or otherwise disparaging words, names and symbols. Many individual state trademark registration laws have similar 'non-disparagement' provisions in their state statutes. While none of those state statutes were directly at issue in Matal v. Tam, all of them are also likely unconstitutional as a result of the Supreme Court's ruling. The court's ruling will also impact a similar case involving the continued registration of the Washington Redskins trademarks. In that case, the USPTO and a federal district court previously held that the Washington Redskins trademarks were subject to cancellation because they are disparaging to Native Americans. The Supreme Court's ruling likely means that those Washington Redskins registrations will remain on the books at the USPTO."

Joanne Ludovici, McDermott Will & Emery LLP

"The floodgates are now open. You can use and now also federally register any trademark you want regardless of whether the government believes it's disparaging. You'll see a surge in USPTO filings for marks that may not have been filed or successfully registered previously, and that may offend communities of people; some will be opportunity-based filings, otherwise known as a waste of time and

money, like we see with trending phrases; others will be by applicants that were in a holding pattern and will now want to federally protect or expand federal protection for their brands/marks. You'll also see re-filings of applications that were previously refused registration, including recent high-profile ones, including 'Stop The Islamisation of America.' The USPTO will now be working through a backlog of applications that were suspended pending the Supreme Court ruling."

Danica Mathes, Bell Nunnally & Martin LLP

"The purpose of the Trademark Register is to reflect marketplace reality and provide notice of marks in actual commercial use. As the Federal Circuit has stated, '[T]he PTO's role is to protect owners of trademarks by allowing them to register their marks. Denial of registration does not deny the owner the right to use the mark, and thus, will not serve to protect the public from confusion.' The USPTO should not be the morality [police], and the Supreme Court's ruling allows these brands to reap the benefits of registration."

Jonathan Moskin, Foley & Lardner LLP

"In essence, the decision seems unassailable as far as it goes in finding that government registration of trademarks is not government speech. It is puzzling, however, that the court did not address the fact that registration or lack of registration of a trademark does not actually limit speech at all. Mr. Tam would be free to continue using his band's name without registration. Indeed, he has been performing and promoting the band for years without a registration. As a practical matter, the decision clears the way not only for the Redskins to maintain ownership of their marks — regardless of whether Native Americans find them offensive — but also clears the way for registration of trademarks demeaning of the prophet Muhammad or Islam in general, openly racist and misogynistic slogans and the like. Curiously, novelist Salman Rushdie, whose 70th birthday is today, once said: 'What is freedom of expression? Without the freedom to offend, it ceases to exist.' That perhaps aptly summarizes the Supreme Court's decision, which begins by noting that 'Speech may not be banned on the ground that it expresses ideas that offend.' While I agree with that sentiment, the Supreme Court has not explained how this case affects actual speech."

Shane Olafson, Lewis Roca Rothgerber Christie LLP

"The Tam decision is primarily significant because it reaffirms the First Amendment principle that the government may not penalize private speech merely because it disapproves of the message conveyed. It is interesting to note, however, that had the court reached the opposite conclusion, the public would have the same rights to speech — they just wouldn't be entitled to government-sanctioned trademark protection of that speech. From a practical standpoint, this decision opens the door for those seeking to register potentially offensive and disparaging marks, many of which were previously rejected by the U.S. Patent and Trademark Office, such as the Redskins."

John O'Quinn, Kirkland & Ellis LLP

"The court today vindicated fundamental principles of free expression, unanimously holding that the government has no business picking and choosing between the forms of expression that trademark owners select to identify themselves and their products, merely because the government has a role in registering those marks. Although unanimous in outcome, the court was divided in its rationale — including whether trademarks may be subject to reduced scrutiny under the commercial speech doctrine and whether it was sufficient to strike down the disparagement clause of 15 U.S.C. 1052a based on viewpoint discrimination alone — leaving the outer bounds of the intersection of the First Amendment and trademark law for another day."

Josh Schiller, Boies Schiller Flexner LLP

“The court’s opinion expressed respect for the foundational principle of the First Amendment, that speech may not be censored based on the content and ideas expressed therein. While the majority cited concerns raised by The Slants as well as numerous amici that holding trademark registration to constitute government speech would possibly lead to a similar and undesirable classification of copyright registration, all eight members of the court that heard argument on the case concluded that trademark registration was not government speech, and that, therefore, a law which targeted and censored speech because it constituted a racial slur could not stand. Surely, the Redskins will expeditiously push for the review of their pending appeal by the Fourth Circuit citing this decision and likely that case will never get to the Supreme Court once the Fourth Circuit follows this decision removing the very basis for the withdrawal of their registration nearly three years ago.”

Monica Riva Talley, Sterne Kessler Goldstein & Fox PLLC

“While the decision is headline-grabbing news for the Redskins and the previously obscure band The Slants, it likely won’t impact the branding practices for most entities. A review of the TTAB database reveals that only a very small number of trademark applications are refused on appeal on the grounds that they are disparaging. It will be interesting to see whether new brands deliberately created to disparage certain groups of individuals have any legs in today’s charged political and social climate. The perhaps greater uncertainty created by this decision is what happens to the other clauses of 15 U.S.C. Section 1052a; *Lee v. Tam* goes only to the disparagement clause of Section 2a, raising questions as to whether other types of marks that can be refused under this section — such as those deemed immoral or scandalous — may similarly conflict with the First Amendment.”

Clay Tillack, Schiff Hardin LLP

“The trademark applicant has been using the name The Slants as a way of protesting cultural stereotypes in a form of cultural reappropriation, in short, taking epithets or derogatory terms and turning them into cultural symbols of pride, just as the term ‘queer’ has been reappropriated by the LGBT community as a term of honor. The court’s decision will open the door to efforts to register trademarks that are intended to disparage certain people or groups. But the decision reaffirms the protection afforded to free speech in the marketplace, regardless of whether the speech is insulting or even hateful.”

Susan Weller, Mintz Levin Cohn Ferris Glovsky and Popeo PC

“The Supreme Court’s opinion is simple. The statute is drafted broadly. The word ‘persons’ covers all living and juristic persons as well as institutions and beliefs. Trademarks are private speech, not government speech. Thus, the government cannot censor trademarks which express an opinion or viewpoint. As the court stated: ‘Giving offense is a viewpoint.’ Thus, the statute violates First Amendment free speech. Congress might consider revising this section by demonstrating a substantial interest in restricting trademark speech, e.g., hate speech, and more narrowly defining ‘any person, group or institution.’”

John Zavitsanos, Ahmad Zavitsanos Anaipakos Alavi & Mensing PC

“This ruling is not surprising and reinforces the wisdom of the founding fathers. The whole purpose of the First Amendment is to protect unpopular speech and not just popular speech. Otherwise, there would be no need for such an amendment. This is not to say that the court in any way endorses terms like ‘Redskin,’ but we should not conflate political correctness with constitutional principles. The solution here is simple: If something is deemed offensive, apply market pressure but don’t change the scope of our Constitution.”

One attorney was inspired to provide her comment in verse:

Jane Shay Wald, Irell & Manella LLP

"I am unhappy. What a mess!
The Tam case, have you heard
The outcome? Read — and you can guess
Go register a word

That starts with N. The KKK
Will use the (R) on shirts

This isn't my most happy day
In fact, it kind of hurts.

Many lawyers will give praise
'The First Amendment's safe!'
To register each hateful phrase
They say I'm just a naif.

If I'm in trouble to refuse
A client's application
To register 'Let's kill the Jews,'
There's no time for vacation.

The court agrees to bless The Slants
My 'Pussy Grabber' mark for pants
Will register, I'll get the chance
To share this ugly trademark dance."

--Editing by Alyssa Miller.