

In re Tam: The United States Court of Appeals for the Federal Circuit Does Not Care If You Are Offended

I. OVERVIEW 237

II. BACKGROUND 238

 A. *The First Amendment*.....238

 1. The First Amendment and Content-Based Bans 239

 2. The First Amendment and Political Speech..... 240

 3. The First Amendment and Commercial Speech..... 241

 4. First Amendment and Government Speech 243

 B. *Due Process and Federal Regulation*.....244

 C. *The Constitutionality of § 2A of the Lanham Act*.....245

III. COURT’S DECISION..... 248

IV. ANALYSIS 255

I. OVERVIEW

The Slants are an Asian-American dance-rock band from Portland, Oregon.¹ Their leader, Simon Tam, named the band The Slants because he believes Asian-Americans should “take ownership” of Asian stereotypes and “not be offended by stereotypical descriptions.”² The band has existed since 2006, and Tam sought to register the mark “THE SLANTS” in 2011.³ On November 14, 2011, Tam applied to register the mark “THE SLANTS” for “[e]ntertainment in the nature of live performances by a musical band” with the U.S. Patent and Trademark Office (USPTO) (App. No. 85/472,044).⁴ The USPTO examiner refused to register the trademark, finding it was likely disparaging to “persons of Asian descent” under § 2(a) of the Lanham Act.⁵ 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.”⁶ Although Tam chose the mark to “reappropriate the disparaging term,” the examiner concluded that a substantial composite of people of Asian

1. *In re Tam*, 808 F.3d 1321, 1331 (Fed. Cir. 2015), *as corrected* (Feb. 11, 2016), *cert. granted sub nom. Lee v. Tam*, No. 15-1293, 2016 WL 1587871 (U.S. Sept. 29, 2016).

2. *Id.*

3. *Id.*

4. *Id.*

5. *Id.*

6. *Id.*

descent would be offended by it.⁷ The Trademark Trial and Appeal Board (the Board) affirmed the examiner's refusal to register the mark, stating "it is abundantly clear from the record not only that THE SLANTS . . . would have the 'likely meaning' of people of Asian descent but also that such meaning has been so perceived and has prompted significant responses by prospective attendees or hosts of the band's performances."⁸ The Board noted, "[t]he dictionary definitions, reference works and all other evidence unanimously categorize the word 'slant,' when meaning a person of Asian descent, as disparaging."⁹

Tam appealed the decision, claiming that the Board "erred in finding the mark disparaging and that § 2(a) [of the Lanham Act] is unconstitutional."¹⁰ The United States Court of Appeals for the Federal Circuit affirmed the Board's determination that the mark is disparaging.¹¹ Moreover, the court held that binding precedent from *In re McGinley* rebutted Tam's argument that § 2(a) is unconstitutional under the First and Fifth Amendments.¹² The Federal Circuit, sua sponte, ordered a rehearing en banc to review the application along with the *McGinley* decision, which held the refusal to register a mark does not implicate the First Amendment.¹³ The United States Court of Appeals for the Federal Circuit *held* § 2(a) of the Lanham Act is unconstitutional because it violates the First Amendment, and therefore concluded that "THE SLANTS" is a registrable mark.¹⁴ *In re Tam*, 808 F.3d 1321, 1358 (Fed. Cir. 2015), *as corrected* (Feb. 11, 2016).

II. BACKGROUND

A. *The First Amendment*

The First Amendment states: "Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press."¹⁵ The First Amendment "is designed and intended to remove governmental restraints from the arena of public discussion, putting the decision as to what views

7. *Id.* at 1331-32.

8. *Id.* at 1332.

9. *Id.*

10. *Id.*

11. *Id.*

12. *Id.* at 1333; see *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) (holding that the First Amendment was not implicated by section 2(a) of the Lanham Act because the applicant was still free to use the mark even though federal registration was denied).

13. *Tam*, 808 F.3d at 1334.

14. *Id.* at 1358.

15. U.S. CONST. amend. I.

shall be voiced largely into the hands of each of us, in the hope that use of such freedom will ultimately produce a more capable citizenry.”¹⁶ The Supreme Court of the United States has held that “the First Amendment means that government has no power to restrict expression because of its message, its ideas, its subject matter, or its content.”¹⁷ Consequently, heightened scrutiny is required whenever the government creates “a regulation of speech because of disagreement with the message it conveys.”¹⁸ The Court has required the same heightened scrutiny whether the speech is banned or simply burdened.¹⁹ However, as protected as free speech is, the Court has stated that the right of free speech is not absolute at all times and under all circumstances.”²⁰

1. The First Amendment and Content-Based Bans

The Supreme Court has held that regulations banning speech on a particular subject are unconstitutional under the First Amendment.²¹ In *R.A.V. v. City of St. Paul*, the Court held that a content-based ban on placing a symbol one knows is likely to cause anger in others due to race is unconstitutional.²² Moreover, the Court held that content-based restrictions must survive strict scrutiny, otherwise they are unconstitutional.²³ The Supreme Court has also held that viewpoint discrimination, the regulation of speech based on “the specific motivating ideology or the opinion or perspective of the speaker,” is subject to strict scrutiny under the First Amendment.²⁴ The Court has viewed viewpoint discrimination as a more egregious form of content-based discrimination.²⁵

16. *Cohen v. California*, 403 U.S. 15, 24 (1971).

17. *Police Dep’t of Chi. v. Mosley*, 408 U.S. 92, 95 (1972).

18. *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566 (2011).

19. *United States v. Playboy Entm’t Grp. Inc.*, 529 U.S. 803, 812 (2000).

20. *Chaplinsky v. New Hampshire*, 315 U.S. 568, 571 (1942).

21. *Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 123 (1991).

22. *See R.A.V. v. City of St. Paul*, 505 U.S. 377, 395–96 (1992) (holding that a city ordinance prohibiting bias-motivated disorderly conduct and making placement of a burning cross on private property a misdemeanor is unconstitutional).

23. *See Sable Comm’ns of Cal., Inc. v. FCC*, 492 U.S. 115, 126 (1989).

24. *Rosenberger v. Rector & Visitory of Univ. of Va.*, 515 U.S. 819, 829 (1995).

25. *Reed v. Town of Gilbert, Ariz.*, 135 S. Ct. 2218, 2230 (2015). An example of a viewpoint-based restriction is a public university withholding funding to a university newspaper because it publishes material with a religious viewpoint. *See Rosenberger*, 515 U.S. at 852.

2. The First Amendment and Political Speech

The First Amendment specifically protects an individual's right to participate in public debate through political expression.²⁶ The Supreme Court has stated that political speech is the "free discussion of governmental affairs" including "discussions of candidates, structures and forms of government, the manner in which government is operated or should be operated, and all such matters relating to political processes."²⁷ The Court has held that "the degree to which speech is protected cannot turn on a legislative or judicial determination that particular speech is useful to the democratic process."²⁸ Consequently, the Court has held that political expression is a highly protected form of speech and that laws that burden political speech are subject to strict scrutiny.²⁹ Thus, the Court has held that First Amendment protection for political speech cannot be decided by "an ad hoc balancing of relative social costs and benefits."³⁰ Courts must err on the side of protecting political speech rather than suppressing it.³¹ As such, when the Government restricts speech, it consequently bears the burden of proving the constitutionality of its actions.³²

However, the Supreme Court has also decided that political speech can constitutionally be regulated if the speech consists of so called "fighting words."³³ Fighting words are those "which by their very utterance inflict injury or tend to incite an immediate breach of the peace."³⁴ However, the Court has also stated that "[r]esort to epithets or personal abuse is not in any proper sense communication of information or opinion safeguarded by the Constitution."³⁵ For example, in *Chaplinsky v. New Hampshire*, the Court held that calling someone a "damned fascist" could be constitutionally punished because they were "fighting words" not protected by the First Amendment.³⁶ In a different opinion, the Court reasoned that "the unprotected features of the words are, despite their verbal character, essentially a 'nonspeech' element of

26. *McCutcheon v. Fed. Election Comm'n*, 134 S. Ct. 1434, 1448 (2014).

27. *Mills v. Alabama*, 384 U.S. 214, 218-19 (1966).

28. *McCutcheon*, 134 S. Ct. at 1449.

29. *Ariz. Free Enter. Club's Freedom Club PAC v. Bennett*, 564 U.S. 721, 734 (2011).

30. *United States v. Stevens*, 559 U.S. 460, 470 (2010).

31. *McCutcheon*, 134 S. Ct. at 1451.

32. *See United States v. Playboy Entm't Grp., Inc.*, 529 U.S. 803, 816 (2000).

33. *Chaplinsky v. New Hampshire*, 315 U.S. 568, 572 (1942).

34. *Id.*

35. *Cantwell v. Connecticut*, 310 U.S. 296, 309-10 (1940).

36. *Chaplinsky*, 315 U.S. at 573.

communication.”³⁷ However, the Court also stated that “[t]he government may not regulate use based on hostility—or favoritism—towards the underlying message expressed.”³⁸

3. The First Amendment and Commercial Speech

Before 1975, the Supreme Court considered commercial speech, “speech which does ‘no more than propose a commercial transaction,’”³⁹ outside the scope of the First Amendment.⁴⁰ That changed in 1975 with *Bigelow v. Virginia*, when the Court held that commercial advertisements are not stripped of First Amendment protection simply because they are commercial speech.⁴¹ In *Bigelow*, the Court decided that the State of Virginia could not ban an advertisement for abortion services in New York because the speech was protected by the First Amendment.⁴²

However, the Court has interpreted the First Amendment as granting less protection to commercial speech than other constitutionally guaranteed forms of expression.⁴³ Speech that is not purely expressive, such as commercial speech, can be constitutionally subjected to higher levels of federal regulation.⁴⁴ The Court has judged commercial speech regulations by “assessing the First Amendment interest at stake and weighing it against the public interest allegedly served by the regulation.”⁴⁵ Overall, the government can ban communication that is “more likely to deceive the public than inform it.”⁴⁶ For example, the Court has cautioned that “[a]dvertising, like all public expression, may be subject to reasonable regulation that serves a legitimate public interest.”⁴⁷ In *Friedman v. Rogers*, the Court construed a trade name, which was not a trademark, as commercial speech.⁴⁸ There, an optometrist sought to practice under a trade name, which was barred by the state of Texas.⁴⁹ The Court held that the state interest in protecting the public from

37. *R.A.V. v. City of St. Paul*, 505 U.S. 377, 386 (1992).

38. *Id.*

39. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976).

40. *See Valentine v. Chrestensen*, 316 U.S. 52, 54 (1942).

41. *Bigelow v. Virginia*, 421 U.S. 809, 818 (1975).

42. *Id.* at 824-25.

43. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 563 (1980).

44. *Id.* at 562; *see also Ohralik v. Ohio State Bar Ass’n*, 436 U.S. 447, 456-57 (1978); *Greater New Orleans Broad. Ass’n v. United States*, 527 U.S. 173, 188 (1999).

45. *Bigelow*, 421 U.S. at 826.

46. *Cent. Hudson*, 447 U.S. at 563.

47. *Bigelow*, 421 U.S. at 826.

48. *Friedman v. Rogers*, 440 U.S. 1, 11 (1979).

49. *Id.* at 5-6.

deceptive and misleading use of optometric trade names was substantial and concluded that the statute prohibiting trade names was constitutional.⁵⁰ The Court has also interpreted the First Amendment to allow the government to ban commercial speech related to illegal activity.⁵¹

The Supreme Court crafted a test to determine if a specific expression of commercial speech is protected in *Central Hudson Gas & Electric Corp. v. Public Service Commission of New York*. It stated:

At the outset, we must determine whether the expression is protected by the First Amendment. For commercial speech to come within that provision, it at least must concern lawful activity and not be misleading. Next, we ask whether the asserted governmental interest is substantial. If both inquiries yield positive answers, we must determine whether the regulation directly advances the governmental interest asserted, and whether it is not more extensive than is necessary to serve that interest.⁵²

In a later decision, the Court declared that “a governmental body seeking to sustain a restriction on commercial speech” has the burden to show “that the harms it recites are real and that its restriction will in fact alleviate them to a material degree.”⁵³ The Court explained that, “[t]he Government is not required to employ the least restrictive means conceivable, but it must demonstrate narrow tailoring of the challenged regulation to the asserted interest.”⁵⁴

Commercial speech often has a commercial and expressive element.⁵⁵ When commercial speech is regulated due to its expressive nature the Court has held that strict scrutiny applies.⁵⁶ “Commercial speech is no exception” to the need for heightened scrutiny of content-based regulations seeking to burden the communication of particular messages.⁵⁷ The standard of scrutiny that is applicable depends on which aspect of the speech is targeted by the regulation.⁵⁸ Commercial speech that is “inextricably intertwined” with expressive speech is treated as

50. *Id.* at 15.

51. *Pittsburgh Press Co. v. Pittsburgh Comm’n on Human Relations*, 413 U.S. 376, 388 (1973).

52. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 566 (1980); *see also Greater New Orleans Broad. Ass’n v. United States*, 527 U.S. 173, 183 (1999).

53. *Greater New Orleans*, 527 U.S. at 188.

54. *Id.*

55. *Riley v. Nat’l Fed’n of the Blind of N.C., Inc.*, 487 U.S. 781, 796 (1988).

56. *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566-67 (2011).

57. *Sorrell*, 564 U.S. at 566.

58. *R.A.V. v. City of St. Paul*, 505 U.S. 377, 385 (1992).

expressive speech and any regulation of that speech is subject to strict scrutiny.⁵⁹

4. First Amendment and Government Speech

Courts do not extend First Amendment protection when the program or property in dispute is classified as government speech.⁶⁰ The First Amendment restricts government regulation of private speech; it does not regulate government speech.⁶¹ To determine if the program or property is government speech, courts have first looked to the historical uses of the government program or property.⁶² Second, they have considered how closely the public associates the program or property with the state.⁶³ Third, courts have looked at the level of control the government maintains over the message.⁶⁴ The federal government has the power to determine the contents and limits of programs it creates and manages.⁶⁵

In *Pleasant Grove City v. Summum*, the Supreme Court held monuments displayed on public property are government speech.⁶⁶ The Court noted, governments have traditionally used monuments to speak to the public, citizens interpret the monuments as conveying a message on the property owner's behalf, and the city controls the messages sent to the public by maintaining final authority over which monuments are selected.⁶⁷

Similarly, in *Walker v. Texas Division, Sons of Confederate Veterans Inc.*, the Court held that state license plates were government speech, and thus the state could regulate the messages and designs that appeared on them.⁶⁸ The Court noted that state issued license plates have long been used to communicate messages from the states, the public closely associates license plate designs with the states, and the state maintains direct control over the messages displayed on the plates.⁶⁹

59. *Riley*, 487 U.S. at 796.

60. *Pleasant Grove City v. Summum*, 555 U.S. 460, 467 (2009). *See also* Bd. of Regents of Univ. of Wis. Sys. v. Southworth, 529 U.S. 217, 229 (2000).

61. *Johanns v. Livestock Mktg. Ass'n*, 544 U.S. 550, 553 (2005).

62. *Pleasant Grove*, 555 U.S. at 471-72.

63. *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2248 (2015).

64. *Id.* at 2249.

65. *Rust v. Sullivan*, 500 U.S. 173, 194 (1991) (upholding a regulation denying use of Federal Title X funds for abortion related services).

66. *Pleasant Grove*, 555 U.S. at 470.

67. *See id.* at 470-73.

68. *Walker*, 135 S. Ct. at 2253.

69. *Id.* at 2248-49.

B. *Due Process and Federal Regulation*

Due process is another Constitutional limitation on federal regulation. The Fifth Amendment states “[n]o person shall . . . be deprived of life, liberty or property, without due process of law.”⁷⁰ To be constitutional, a law must “give the person of ordinary intelligence a reasonable opportunity to know what is prohibited, so that he may act accordingly.”⁷¹ The Court held that “a vague law impermissibly delegates basic policy matters to policemen, judges, and juries for resolution on an *ad hoc* and subjective basis, with the attendant dangers of arbitrary and discriminatory application.”⁷² A vague law forces citizens to “steer far wider of the unlawful zone, than if the boundaries of the forbidden areas were clearly marked.”⁷³

Moreover, if a law interferes with free speech, a more stringent vagueness test will apply.⁷⁴ First,

regulated parties should know what is required of them so they may act accordingly; second, precision and guidance are necessary so that those enforcing the law do not act in an arbitrary or discriminatory way . . . rigorous adherence to those requirements is necessary to ensure that ambiguity does not chill protected speech.⁷⁵

This test allows for the protection of speakers under the First and Fifth Amendments “from arbitrary and discriminatory enforcement of vague standards.”⁷⁶

For example, a policy outlawing disparaging speech was construed by the United States Court of Appeals for the Sixth Circuit in *Dambrot v. Central Michigan University*.⁷⁷ The Sixth Circuit held the policy was void for vagueness.⁷⁸ The policy prohibited

any intentional, unintentional . . . behavior that subjects an individual to an intimidating, hostile or offensive . . . environment by . . . (c) demeaning or slurring individuals through . . . written literature because of their racial or ethnic affiliation; or (d) using symbols, [epithets] or slogans that infer negative connotations about the individual's racial or ethnic affiliation.⁷⁹

70. U.S. CONST. amend. V.

71. *Grayned v. City of Rockford*, 408 U.S. 104, 108 (1972).

72. *Id.* at 108-09.

73. *Baggett v. Bullitt*, 377 U.S. 360, 372 (1964).

74. *Vill. of Hoffman Estates v. Flipside, Hoffman Estates, Inc.*, 455 U.S. 489, 499 (1982).

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

76. *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 588 (1998).

77. *Dambrot v. Cent. Mich. Univ.*, 55 F.3d 1177, 1184 (6th Cir. 1995).

78. *Id.*

79. *Id.* at 1182.

The Sixth Circuit stated that in order to decide what is considered negative or offensive one must make a subjective reference, and different people find different things offensive.⁸⁰ The court also noted that determining what is offensive is wholly delegated to the university and this “unrestricted delegation of power” gives further support to the holding that the policy is unconstitutionally vague.⁸¹

C. The Constitutionality of § 2A of the Lanham Act

Under its authority to regulate interstate commerce,⁸² Congress enacted the Lanham Act, which created federal trademark protection.⁸³ Congress passed the Lanham Act in order to create a national system for registering and protecting trademarks used in interstate and foreign commerce.⁸⁴ A trademark is “any word, name, symbol, or device or any combination thereof” used by any person “to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”⁸⁵ Section 2(a) of the Lanham Act states that no trademark shall be registered if it “comprises 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.”⁸⁶ The guidelines for applying this section ask examiners to determine:

- (1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; 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.⁸⁷

The Lanham Act is intended to prevent deceptive and misleading use of marks, and “protect persons engaged in . . . commerce against unfair

80. *Id.* at 1184.

81. *Id.*

82. *See* U.S. CONST. art. I, § 8, cl. 3.

83. Lanham Act, 15 U.S.C. § 1051 (2012).

84. *See* *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767-68 (1992).

85. *Id.* at 768 (citing 15 U.S.C. § 1127 (2012)).

86. 15 U.S.C. § 1052(a) (2012).

87. U.S. PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL EXAMINING PROC. § 1203.03(b)(i) (Oct. 2015 ed.) [hereinafter TRADEMARK MANUAL].

competition.⁸⁸ Under the Lanham Act, an applicant can seek to register a trademark through an administrative process within the USPTO.⁸⁹ The benefits of trademark registration have been described as:

(1) Federal jurisdiction for infringement without the necessity of any required amount in controversy. . . . (2) In federal court, profits, damages and costs are recoverable and treble damages and attorney's fees are available. (3) A registration on the Principal Register is prima facie evidence of the validity of the registered mark, of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark. . . . (4) A Principal Register registration may become incontestable as conclusive evidence of the registrant's exclusive right to use of the mark, subject to certain statutory defenses. (5) A Principal Register registration is constructive notice of a claim of ownership so as to eliminate any defense of good faith adoption and use made after the date of registration. (6) For registrations resulting from applications filed after November 16, 1989, the registrant is entitled to a "constructive use date," nationwide in effect, as of the filing date of the application, except as to a defined class of persons. (7) A Principal Register registration may be used to stop the importation into the United States of articles bearing an infringing mark.⁹⁰

The constitutionality of § 2(a) was first discussed by the Court of Appeals for the Federal Circuit in 1981, in *In re McGinley*. A mark featuring a naked man and woman used in connection with advertisements for "swinging" parties was found to be immoral or scandalous by the trademark examiner under § 2(a).⁹¹ The United States Court of Customs and Patent Appeals concluded that the denial of registration did not abridge the petitioners First Amendment rights because he was still free to use the mark.⁹² Nor was the statute void for vagueness.⁹³ The court concluded that the mark was scandalous and affirmed the denial of registration.⁹⁴ The court noted they did not see this as an attempt by congress to legislate morality.⁹⁵

88. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 28 (2003) (citing 15 U.S.C. § 1127 (2000)).

89. 15 U.S.C. § 1051 (2012).

90. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:9 (4th ed. 1996).

91. *In re McGinley*, 660 F.2d 481, 482 (C.C.P.A. 1981), *abrogated by*, *In re Tam*, 808 F.3d 1321 (Fed Cir. 2015).

92. *Id.* at 484.

93. *Id.* at 485.

94. *Id.* at 487.

95. *Id.* at 486.

McGinley foreclosed constitutional challenges to § 2(a) in the Federal Circuit, as noted in *In re Mavety Media Group, Ltd.*⁹⁶ There, the Federal Circuit reiterated the idea that the First Amendment is not implicated by the refusal to register a trademark because the applicant is still free to use it.⁹⁷ It also noted that a void for vagueness argument is likewise foreclosed by *McGinley*.⁹⁸

The United States Court of Appeals for the Third Circuit followed the Federal Circuit's holding in *McGinley* that a party's right to use a trademark is not dependent on its registration in *Santana Products Inc. v. Compression Polymers Inc.*⁹⁹ The United States Court of Appeals for the First Circuit also cited *McGinley* for the proposition that a refusal by the USPTO to register a mark does not prevent the owner from using the mark.¹⁰⁰

The constitutionality of § 2(a) under the First and Fifth Amendments was also discussed by the United States District Court for the Eastern District of Virginia in *Pro-Football, Inc. v. Blackhorse*.¹⁰¹ In *Blackhorse*, five Native Americans alleged that the trademarked name "REDSKINS" was disparaging to Native Americans under § 2(a) and thus should not be registered.¹⁰² Pro-Football, Inc. (PFI) argued that:

(1) Section 2(a) of the Lanham Act violates the First Amendment by restricting protected speech, imposing burdens on trademark holders, and conditioning access to federal benefits on restrictions of trademark owners' speech; (2) Section 2(a) of the Lanham Act is unconstitutionally vague in violation of the Fifth Amendment because it does not provide notice as to which marks 'may disparage,' it authorizes arbitrary and discriminatory enforcement, and it is impermissibly vague as-applied to PFI; and (3) the TTAB Order violates the Due Process and Takings Clauses of the Fifth Amendment because it deprives PFI of its property without due process and constitutes an unconstitutional taking of PFI's property.¹⁰³

In regards to the First Amendment claim, the district court held that "cancelling the registrations of the Redskins Marks under Section 2(a) of the Lanham Act does not implicate the First Amendment as the

96. *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994), *abrogated by*, *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015).

97. *Id.*

98. *Id.*

99. *Santana Prod., Inc. v. Compression Polymers, Inc.*, 8 F.3d 152, 155 (3d Cir. 1993).

100. *Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 819 (1st Cir. 1987).

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

102. *Id.* at 447.

103. *Id.*

cancellations do not burden, restrict, or prohibit PFI's ability to use the marks."¹⁰⁴

Furthermore, the district court concluded trademark registration is government speech and thus exempt from First Amendment scrutiny.¹⁰⁵ Discussing the *Walker* factors, the court stated that trademark registration conveys the message that the government has approved the trademark, the public closely associates trademark registration with the federal government, and "the federal government exercises editorial control over the federal trademark registration program."¹⁰⁶

The court also held § 2(a) is not void for vagueness under the Fifth Amendment.¹⁰⁷ In holding § 2(a) not void for vagueness, the court stated, "(1) PFI cannot show that Section 2(a) is unconstitutional in all of its applications; (2) Section 2(a) gives fair warning of what conduct is prohibited; (3) Section 2(a) does not authorize or encourage 'arbitrary and discriminatory enforcement'; and (4) Section 2(a) is not impermissibly vague as applied to PFI."¹⁰⁸ The court also decided "the Takings Clause and Due Process Clause claims fail because a trademark registration is not considered property under the Fifth Amendment."¹⁰⁹ In conclusion, the district court invalidated the REDSKINS Trademark, holding, "the (1) dictionary evidence, (2) literary, scholarly, and media references, and (3) statements of individuals and groups in the referenced group show that the Redskins Marks consisted of matter that 'may disparage' a substantial composite of Native Americans."¹¹⁰

III. COURT'S DECISION

In the noted case, The United States Court of Appeals for the Federal Circuit applied strict scrutiny to determine the constitutionality of § 2(a) of the Lanham Act. The Federal Circuit stated "[s]trict scrutiny is used to review any governmental regulation that burdens private speech based on disapproval of the message conveyed."¹¹¹ The court applied strict scrutiny to § 2(a) of the Lanham Act because it denies legal rights to private speech due to disapproval of the message.¹¹²

104. *Id.* at 455.

105. *Id.* at 457.

106. *Id.* at 458-59.

107. *Id.* at 464.

108. *Id.*

109. *Id.*

110. *Id.* at 467.

111. *In re Tam*, 808 F.3d 1321, 1334 (Fed. Cir. 2015).

112. *Id.*

First the court stated that the disparagement provision is not content or viewpoint neutral.¹¹³ “Content based regulations are presumptively invalid.”¹¹⁴ Applying the standard of review set forth by the Supreme Court in *Reed v. Town of Gilbert*, the court stated that content based regulations may only be justified if the government proves they are narrowly tailored to serve a compelling state interest.¹¹⁵ The court also noted that “[t]he First Amendment requires heightened scrutiny whenever the government creates ‘a regulation of speech because of disagreement with the message it conveys.’”¹¹⁶ “This is true whether the regulation bans or merely burdens speech.”¹¹⁷ The court noted, “[i]t is beyond dispute that § 2(a) discriminates on the basis of content in the sense that it ‘applies to particular speech because of the topic discussed.’” Preventing the registration of disparaging marks is clearly a content based restriction according to the court.¹¹⁸ “[T]he test for disparagement—whether a substantial composite of the referenced group would find the mark disparaging—makes clear that it is the nature of the message conveyed by the speech which is being regulated.”¹¹⁹ “When the government refuses to register a mark under § 2(a), it does so because it disapproves of ‘the message a speaker conveys’ by the mark.”¹²⁰ Further evidence of the government’s disapproval comes from the government repeatedly asserting that it should be able to prevent “the most vile racial epithets and images.”¹²¹

Second, the Federal Circuit decided that the Lanham Act’s disparagement provision is viewpoint discriminatory on its face.¹²² The “PTO rejects marks under § 2(a) when it finds the marks refer to a group in a negative way, but it permits the registration of marks that refer to a group in a positive, non-disparaging manner.”¹²³ In the noted case, the USPTO refused to register Tam’s mark because it found the mark “disparaging” to those of Asian descent; meanwhile the USPTO has registered marks that refer positively to those of Asian descent such as CELEBRASIONS and ASIAN EFFICIENCY.¹²⁴

113. *Id.*

114. *Id.* (citing *R.A.V. v. City of St. Paul*, 505 U.S. 377, 382 (1992)).

115. *Tam*, 808 F.3d at 1334 (citing *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2226 (2015)).

116. *Id.* at 1335 (quoting *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566 (2011)).

117. *Id.* at 1335.

118. *Id.* at 1335.

119. *Id.*

120. *Id.* at 1336 (citing *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2227 (2015)).

121. *Id.* at 1336.

122. *Id.* at 1336.

123. *Id.*

124. *Id.*

Third, the court decided the disparagement provision regulates the expressive nature of the mark, not its function as commercial speech.¹²⁵ Therefore, the disparagement provision must be assessed under the First Amendment standards applicable to expressive speech.¹²⁶ The court reasoned that because the name “THE SLANTS” makes a statement about racial identity and seeks to change the perceptions towards people of Asian descent, it is expressive speech.¹²⁷ Every time registration is refused under § 2(a) it is because the government concludes some group would be offended by the expressive content.¹²⁸ The court cited *Sorrell* for the proposition that “commercial speech is no exception” to the need for heightened scrutiny of content-based restrictions seeking to hinder communication of particular messages.¹²⁹ The court stated that this is not a regulation aimed at the commercial component of speech.¹³⁰ The court noted that government regulation often affects speech that has a dual character.¹³¹ The same speech at issue can be banned due to one feature, such as obscenity, but not on the basis of another, such as opposition to the government.¹³² The court noted that commercial speech that is “inextricably intertwined” with expressive speech is treated as expressive speech under the First Amendment when the expressive aspect is targeted by the regulation.¹³³ The court concluded that “[b]ecause § 2(a) discriminates on the basis of the content of the message conveyed by the speech, it follows that it is presumptively invalid, and must satisfy strict scrutiny to be found constitutional.”¹³⁴

Fourth, the Federal Circuit rejected the government’s argument that § 2(a) does not implicate the First Amendment because Tam is still free to name his band whatever he wants.¹³⁵ The court cited *Pitt News v. Pappert*, for the proposition that the threat to First Amendment free speech comes from imposing a financial burden that can influence or suppress speech.¹³⁶ “[I]f the government could deny a benefit to a person

125. *Id.* at 1337.

126. *Id.* at 1338.

127. *Id.*

128. *Id.*

129. *Id.* (quoting *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566 (2011)).

130. *See id.*

131. *Id.* at 1339.

132. *R.A.V. v. City of St. Paul*, 505 U.S. 377, 386 (1992). One could constitutionally be punished for burning a flag under an ordinance prohibiting outdoor fires, but not under an ordinance against dishonoring the flag. *Id.*

133. *Tam*, 808 F.3d at 1339 (citing *Riley v. Nat’l Fed’n of the Blind of N.C., Inc.*, 487 U.S. 781, 796 (1988)).

134. *Id.*

135. *See id.* at 1340.

136. *Id.* (citing *Pitt News v. Pappert*, 379 F.3d 96, 111-12 (3d Cir. 2004)).

because of his constitutionally protected speech or associations, his exercise of those freedoms would in effect be penalized and inhibited.”¹³⁷ “This would allow the government to produce a result which it could not command directly.”¹³⁸ The court quoted *Sorrell* to say that “[l]awmakers may no more silence unwanted speech by burdening its utterance than by censoring its content.”¹³⁹ The court discussed the significant and financially valuable benefits of registration to markholders, and noted that denial of those benefits would create a serious disincentive to adopt a mark, which the government may deem offensive or disparaging.¹⁴⁰ Furthermore, the court stated that the prospect of high costs in litigation to obtain the registration and protect it in a cancellation proceeding are further disincentives from choosing a mark that may be disparaging.¹⁴¹ The fact that there may be some form of common law protection available for the mark did not alter the court’s conclusion.¹⁴²

Next, the Federal Circuit rejected the argument that trademark registration is a form of government speech which the government can grant and reject without implicating the First Amendment. The court stated that trademark registration is a regulatory activity.¹⁴³ However, government registration does not convert the underlying speech to government speech.¹⁴⁴ If that was the case, copyright registration would also be government speech.¹⁴⁵ The government could then also theoretically prohibit copyright registration to any work considered immoral, scandalous, or disparaging.¹⁴⁶

The court distinguished trademark registration from specialty license plates which were held to be government speech in *Walker v. Texas Division, Sons of Confederate Veterans*.¹⁴⁷ It noted that license plates have long been used to communicate messages from the states, the state owns the design on the plates, and the states dictate how unused plates are to be disposed.¹⁴⁸ Moreover, state license plates and their designs are often closely associated with the state itself and that a

137. *Id.* at 1340 (quoting *Perry v. Sindermann*, 408 U.S. 593, 597 (1972)).

138. *Id.*

139. *Id.* (quoting *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566 (2011)).

140. *Id.* at 1340-41.

141. *Id.* at 1342-43.

142. *Id.* at 1345.

143. *Id.* at 1346.

144. *Id.*

145. *Id.*

146. *Id.*

147. *Id.* (distinguishing *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2253 (2015)).

148. *Id.*; *see also Walker*, 135 S. Ct. at 2248.

message on a state license plate is likely to convey that the state endorsed the message.¹⁴⁹ In contrast, “[w]hen the government registers a trademark, the only message it conveys is that a mark is registered.”¹⁵⁰ The USPTO often “registers marks that no one could say the government endorses,” such as GANJA UNIVERSITY and MURDER 4 HIRE, among more offensive marks.¹⁵¹ The government’s own brief even stated that “‘the USPTO does not endorse any particular product, service, mark, or registrant’ when it registers a mark.”¹⁵² The court concluded that if “being listed in a government database or published in a list of registrations were enough to convert private speech to government speech, nearly every action the government takes—every parade permit granted, every property title recorded, every hunting or fishing license issued—would amount to government speech.”¹⁵³

The Federal Circuit also rejected the argument that § 2(a) merely withholds a government subsidy for Tam’s speech, and thus the denial is valid as part of a government subsidy program.¹⁵⁴ The Supreme Court has repeatedly invalidated denials of benefits based on disapproval of private speech when the speech is not part of a government speech program.¹⁵⁵ Denial of an otherwise-available benefit is unconstitutional when it has a significant chilling effect on private speech.¹⁵⁶ Moreover, the unconstitutional conditions doctrine provides that the government may not deny a benefit to a person for a reason that infringes his constitutionally protected interests—including freedom of speech.¹⁵⁷ The court stated that denying a benefit is the same as penalizing a person for their speech.¹⁵⁸ All the subsidy cases where the government was allowed to limit freedom of expression have involved government funding or government property.¹⁵⁹ The court concluded that trademark registration is not a subsidy because it simply redefines the nature of the markholder’s rights against other citizens, and deprives others of the ability to use the mark.¹⁶⁰

149. *Walker*, 135 S. Ct. at 2248.

150. *Tam*, 808 F.3d at 1346.

151. *Id.* at 1346.

152. *Id.* at 1347.

153. *Id.* at 1347-48.

154. *Id.* at 1348.

155. *Id.*

156. *Bd. of Cty. Comm’rs, Wabaunsee Cty. v. Umbehr*, 518 U.S. 668, 674 (1996).

157. *Perry v. Sindermann*, 408 U.S. 593, 597 (1972).

158. *Speiser v. Randall*, 357 U.S. 513, 518 (1958).

159. *Tam*, 808 F.3d at 1351.

160. *Id.* at 1353.

Furthermore, since the USPTO is funded by registration fees, not taxes,¹⁶¹ the Federal Circuit concluded that trademark registration does not implicate the spending clause simply because some federal funds are spent on enforcement and employee benefits.¹⁶² If that were the case, every federal benefit or regulatory program would implicate the spending clause.¹⁶³ Again, the court compared trademark registration to copyright registration and stated it would be unreasonable to say the government subsidizes an author when it grants a copyright.¹⁶⁴ The court declared that if the government's position was correct, Congress could pass a law denying copyright registration to works containing "racial slurs," "religious insults," "ethnic caricatures," and "misogynistic images."¹⁶⁵ Additionally, the court noted that the congressional authority to regulate trademarks through the Lanham Act derives from the Commerce Clause, not the Spending Clause.¹⁶⁶

Finally, the Federal Circuit concluded that § 2(a) is unconstitutional even if it were analyzed under the *Central Hudson* intermediate scrutiny test for commercial speech.¹⁶⁷ Unlike the other provisions of § 2, § 2(a) does not prohibit misleading, deceptive, or unlawful marks, and the court concluded that there was nothing misleading, deceptive, or unlawful about Tam's mark.¹⁶⁸ First, the court stated, only a substantial government interest must justify the regulation.¹⁶⁹ Section 2(a) fails the test at this step because the interest of the government depends on disapproval of the message,¹⁷⁰ and disapproval of a message is not a sufficient interest to pass intermediate scrutiny.¹⁷¹

If disapproval of a message was sufficient to pass intermediate scrutiny, the government could also claim an interest in refusing to issue permits to racist, sexist, or homophobic protests.¹⁷² The Federal Circuit noted that "case law does not recognize a substantial interest in discriminatorily regulating private speech to try to reduce racial

161. *Figueroa v. United States*, 466 F.3d 1023, 1028 (Fed. Cir. 2006).

162. *Tam*, 808 F.3d at 1353.

163. *Id.*

164. *Id.*

165. *Id.* at 1354.

166. *Id.*

167. *Id.* at 1355.

168. *Id.*

169. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 566 (1990).

170. *Tam*, 808 F.3d at 1355.

171. *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 572 (2011).

172. *Tam*, 808 F.3d at 1356.

intolerance.”¹⁷³ Furthermore, the court noted that it is hard to see how § 2(a) “‘directly and materially advance[es]’ the state’s interest in racial tolerance and is narrowly tailored to achieve that objective.”¹⁷⁴ In conclusion, the court stated: “Whatever our personal feelings about the mark at issue here, or other disparaging marks, the First Amendment forbids government regulators to deny registration because they find the speech likely to offend others.”¹⁷⁵ Even if speech “inflict[s] great pain,” the Constitution protects it “to ensure that we do not stifle public debate.”¹⁷⁶

Judge O’Malley wrote a concurrence in which she agreed that § 2(a) cannot survive strict scrutiny and argues it is also void for vagueness under the Fifth Amendment.¹⁷⁷ In her opinion, applicants and the Board must guess at what may have the potential to disparage a wide range of people, institutions and beliefs.¹⁷⁸ She also pointed to the inconsistency in registration decisions; HAVE YOU HEARD SATAN IS A REPUBLICAN was rejected under § 2(a), while THE DEVIL IS A DEMOCRAT was accepted.¹⁷⁹

Judge Dyk wrote a concurrence in part and a dissent in part in which he agreed that a bar on registration of disparaging marks is unconstitutional as applied to Tam. However, he believed the majority went beyond the facts of the case by holding the statute facially unconstitutional as applied to purely commercial speech.¹⁸⁰ According to Judge Dyk, Tam’s mark is “core political speech” and thus the regulation of his speech is unconstitutional under strict scrutiny.¹⁸¹ However, he did not believe that the government must support or tolerate disparaging trademarks in the name of commercial speech.¹⁸² For example, facially or sexually disparaging speech in the workplace may constitute a violation of Title VII.¹⁸³ Judge Dyk also expressed concern that the Majority’s ruling may invalidate the bar on scandalous marks and similar provisions in the Model State Trademark Act.¹⁸⁴

173. *Id.* at 1357.

174. *Id.*

175. *Id.* at 1358.

176. *Snyder v. Phelps*, 562 U.S. 443, 461 (2011).

177. *Tam*, 808 F.3d at 1358 (O’Malley, K., concurring).

178. *Id.*

179. *Id.* at 1359.

180. *Id.* at 1363 (Dyk, T., concurring in part and dissenting in part).

181. *Id.* at 1364.

182. *Id.*

183. *Id.* at 1365.

184. *Id.* at 1364.

Judge Lourie dissented on the grounds that he would have affirmed the USPTO's refusal to register Tam's trademark.¹⁸⁵ His principal objection to the majority opinion was *stare decisis*.¹⁸⁶ He noted that the statute has been around for seventy years and questioned why the Federal Circuit would now suddenly find it unconstitutional.¹⁸⁷

Judge Reyna dissented on the grounds that the registration of trademarks is commercial speech and should be analyzed under intermediate scrutiny.¹⁸⁸ Judge Reyna reasoned that the refusal to register marks under § 2(a) is "an appropriate regulation that directly advances the government's substantial interest in the orderly flow of commerce."¹⁸⁹

IV. ANALYSIS

In the noted case, the Federal Circuit broke with prior decisions by holding (1) that § 2(a) is subject to strict scrutiny under the First Amendment, (2) that the prohibition on registration of disparaging marks is not a regulation of commercial speech, and (3) that the registration of trademarks is not government speech.¹⁹⁰ More specifically, the Federal Circuit overruled *In re McGinley*.¹⁹¹

First, the court correctly refutes the argument that the First Amendment is not implicated by denying trademark registration because Tam is still free to use the mark.¹⁹² If the government could deny a benefit to someone because of disagreement with his or her speech, his or her exercise of free speech would be inhibited and this would allow the government to indirectly regulate speech it disagrees with.¹⁹³ The court rightly notes that the expressive feature of the mark is what is being regulated.¹⁹⁴ As the Court held in *R.A.V. v. City of St. Paul*, when the expressive nature of the mark is being regulated, strict scrutiny applies.¹⁹⁵ Section 2(a) has nothing to do with the mark's commercial function.¹⁹⁶

185. *Id.* at 1374 (Lourie, A., dissenting).

186. *Id.*

187. *Id.*

188. *Id.* at 1376 (Reyna, J., dissenting).

189. *Id.*

190. *Id.* at 1334, 1338, 1345 (Moore, J., majority).

191. *Id.* at 1330 n.1.

192. *In re McGinley*, 660 F.2d 481, 482 (C.C.P.A. 1981); *Tam*, 808 F.3d at 1340.

193. *Perry v. Sindermann*, 408 U.S. 593, 597 (1972).

194. *Tam*, 808 F.3d at 1338.

195. *R.A.V. v. City of St. Paul*, 505 U.S. 377, 385 (1992).

196. *Tam*, 808 F.3d at 1338.

The mark is clearly not misleading or related to an illegal activity.¹⁹⁷ Rather, the government denied the registration because it feels the mark is offensive.¹⁹⁸ This puts the speech within the protection of the First Amendment.¹⁹⁹ The court correctly applied strict scrutiny to this burden on speech.

Second, the Federal Circuit was correct in its analysis that the registration of trademarks is not government speech. The court properly distinguishes the specialty license plates in *Walker* from trademark registration.²⁰⁰ State issued license plates have been used to communicate messages from the states while “the fact that COCA COLA and PEPSI may be registered trademarks does not mean the government has endorsed these brands of cola, or prefers them over other brands.”²⁰¹ The USPTO routinely registers trademarks the government does not endorse such as GANJA UNIVERSITY and MURDER 4 HIRE.²⁰² As the court quoted in *Tam*, “[G]overnment registration of a mark is neither a government endorsement of the quality of the goods to which the mark is applied nor a government pronouncement that the mark is a good or reliable one in any moral or commercial sense.”²⁰³ Moreover, the public does not equate trademark registration with a governmental endorsement.²⁰⁴ Even if the third *Walker* factor, the level of government control, leans towards trademark registration being government speech, the first two lean against it so the court correctly concluded it is not government speech.

Third, the Federal Circuit appropriately rejects the argument that trademark registration is a government subsidy.²⁰⁵ The denial of an otherwise-available benefit is unconstitutional where it has a significant chilling effect on private speech.²⁰⁶ The court notes that, “the scope of the subsidy cases has never been extended to a ‘benefit’ like recognition of

197. See, e.g., *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 563 (1990); *Pittsburgh Press Co. v. Pittsburgh Comm’n on Human Relations*, 413 U.S. 376, 388 (1973).

198. *Tam*, 808 F.3d at 1355.

199. See, e.g., *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566 (2011); *R.A. V.*, 505 U.S. at 385.

200. *Id.* at 1346; *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2248 (2015).

201. *Tam*, 808 F.3d at 1345.

202. U.S. Reg. No. 4,070,160; U.S. Reg. No. 3,605,862.

203. Jeffrey Lefstin, *Does the First Amendment Bar Cancellation of Redskins?*, 52 STAN. L. REV. 665, 684 (2000).

204. *Tam*, 808 F.3d at 1347.

205. *Id.* at 1348.

206. *Bd. of Cty. Comm’rs, Wabaunsee Cty., Kan. v. Umbehr*, 518 U.S. 668, 674 (1996).

legal rights in speakers against private interference.”²⁰⁷ Trademark registration is a regulatory scheme not a subsidy like a tax exemption.²⁰⁸

An interesting question is whether § 2(a) could survive intermediate scrutiny. Based on *Sorrell*, the Federal Circuit concluded it could not survive intermediate scrutiny because disapproval of the message is not a substantial government interest.²⁰⁹ While it is true *Sorrell* says the interest cannot be based on disapproval of a message, perhaps the government could come up with a different substantial interest that would satisfy the court.²¹⁰ Another circuit could agree that the government has a substantial interest in “declining to expend its resources to facilitate the use of racial slurs as source identifiers in interstate commerce.”²¹¹ It seems reasonable for the government to have an interest in not extending benefits to those who use the most vile racial epithets and slurs.²¹² Does the government have the power to deny registration to so called “fighting words?”²¹³ The court in *Tam* seems to conclude that there is no barrier whatsoever and even the most heinous and offensive trademarks could be registered.²¹⁴

Another plausible angle to find § 2(a) unconstitutional would be declaring it void for vagueness. The USPTO’s own guidelines for enforcing § 2(a) can easily be construed as vague.²¹⁵ The guidelines state:

- (1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; 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.²¹⁶

207. *Tam*, 808 F.3d at 1351.

208. *Id.* at 1353.

209. *Id.* at 1355; see *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 572 (2011) (stating that a law cannot survive intermediate scrutiny if the substantial interest is “suppressing a disfavored message”).

210. *Sorrell*, 564 U.S. at 572.

211. *Tam*, 808 F.3d at 1356.

212. *Id.*

213. *Chaplinsky v. New Hampshire*, 315 U.S. 568, 572 (1942). Fighting words are words “which by their very utterance inflict injury or tend to incite an immediate breach of the peace.” *Id.*

214. *Tam*, 808 F.3d at 1357-58.

215. *Tam*, 808 F.3d at 1358 (O’Malley, K., concurring).

216. TRADEMARK MANUAL, *supra* note 87.

This means that an examiner can deny a mark if it potentially disparages a small part of the identified referenced group.²¹⁷

How does the examiner decide what potentially disparages a small part of the referenced group? The arbitrary results can be seen by comparing similar marks, one of which was denied and the other granted, for example: HAVE YOU HEARD SATAN IS A REPUBLICAN, which was rejected because it disparaged the Republican Party, with THE DEVIL IS A DEMOCRAT, which was accepted.²¹⁸ Another arbitrary example, with two different results involving the exact same mark, can be seen in the mark HEEB. The USPTO granted registration for a magazine called HEEB, and then later denied registration to the same applicant for HEEB as the name of a clothing line, stating that it was disparaging to Jewish people.²¹⁹ These are arbitrary results which one could not predict and are likely to lead to a chilling effect on speech by forcing citizens to “steer far wider” of the unregistrable zone than if the unregistrable zone was easily determinable.²²⁰ Another circuit will likely consider these arbitrary applications as evidence that the statute should be considered void for vagueness.²²¹

One wonders if the court was simply convinced by Tam’s message and reasoning behind choosing his mark. If Tam was not of Asian descent and named his band THE SLANTS because he disliked Asians and wanted to offend them, would the court have ruled in the same way? It is easier to argue that Tam should be able to register his mark because he is trying to create a discussion about race and “own” the stereotype it represents. But does that also mean that marks which are purposely offensive and derogatory should be registered as well? The dissent points out this statute has been around for seventy years, and questions why it is now suddenly unconstitutional.²²²

Notably, although the United State District Court for the Eastern District of Virginia’s decisions are not precedential for the Federal Circuit, the Federal Circuit’s holdings contradict those of the Eastern District’s holdings in *Pro-Football, Inc. v. Blackhorse*.²²³

217. *Tam*, 808 F.3d at 1359.

218. *Id.*

219. *In re HEEB Media, LLC*, 89 U.S.P.Q.2d 1071, 2008 WL 5065114, at *1 (TTAB 2008).

220. *FCC v. Fox Television Stations, Inc.*, 132 S. Ct. 2307, 2317 (2012); *Speiser v. Randall*, 357 U.S. 513, 526 (1958).

221. *Fox Television Stations, Inc.*, 132 S. Ct. at 2317-20.

222. *Tam*, 808 F.3d at 1374 (Lourie, A., dissenting).

223. *See Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 448 (E.D. Va. 2015) (holding that the cancellation of a mark does not burden or prohibit the team from using the mark

Nevertheless, one way THE SLANTS can be differentiated from the REDSKINS trademark is by classifying THE SLANTS as political speech. Tam is making a statement about race to challenge perceptions of Asian people. While his speech does not fit perfectly into the definition of political speech,²²⁴ he can argue his speech is protected political speech because the First Amendment “is designed and intended to remove governmental restraints from the arena of public discussion.”²²⁵ The government cannot burden an individual’s right to participate in a public debate through political expression.²²⁶ Thus, because Tam is making a public political statement, the government should not be allowed to burden that statement. Because the REDSKINS are not making a political statement with their mark, one could argue it is more constitutionally acceptable to burden that speech.

THE SLANTS have stated they do not think the REDSKINS trademark should be registered.²²⁷ Unlike the REDSKINS, THE SLANTS is not an inherent racial slur.²²⁸ Also, Tam is a member of the referenced group unlike the owners of the REDSKINS.²²⁹ Moreover, the overwhelming majority of Asian Americans support the name THE SLANTS, while that is not the case with Native Americans and the REDSKINS.²³⁰ Tam has stated that the name REDSKINS reinforces stereotypes of savage Native Americans, while THE SLANTS breaks stereotypes about Asian Americans.²³¹ He has referred to the owner of the REDSKINS as a racist and said “[i]t is possible to support free speech while opposing hate speech.”²³² Tam differentiates the messages of THE SLANTS from the REDSKINS, and does not want people to be discouraged “from using wit, irony, or reappropriation to disarm the malicious.”²³³

therefore the First Amendment is not implicated, and that registration is government speech which is exempt from First Amendment scrutiny).

224. *Mills v. Alabama*, 384 U.S. 214, 218-19 (1966) (defining political speech as “discussions of candidates, structures and forms of government, the manner in which government is operated or should be operated, and all such matters relating to political processes”).

225. *Cohen v. California*, 403 U.S. 15, 24 (1971).

226. *McCutcheon v. Fed. Election Comm’n*, 134 S. Ct. 1434, 1448 (2014).

227. Simon Tam, *Misleading Headlines About Slants/Redskins Alliance*, SLANTS (Sept. 19, 2016), <http://www.theslants.com/misleading-headlines-about-slantsredskins-alliance/> [hereinafter Tam, *Misleading Headlines*].

228. Simon Tam, *The Difference Between the Redskins Case and Ours*, SLANTS (Apr. 26, 2016), <http://www.theslants.com/the-difference-between-the-redskins-case-and-ours/>.

229. *Id.*

230. *Id.*

231. *Id.*

232. Tam, *Misleading Headlines*, *supra* note 227.

233. *Id.*

Section 2(a) is correctly subjected to strict scrutiny even though Tam can still use his mark if registration is denied. Trademark registration is not government speech and § 2(a) is likely also void for vagueness. Furthermore, THE SLANTS can be differentiated from truly offensive marks like the REDSKINS by referring to THE SLANTS mark as political speech. The United States Court of Appeals for the Federal Circuit has opened the floodgates for the registration of offensive marks, but there should be some type of levee to keep out the most extremely offensive flooding.

Colin Casciato*

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