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BLACKHAWK DOWN OR BLACKHORSE DOWN? THE LANHAM ACT'S PROHIBITION OF TRADEMARKS THAT "MAY DISPARAGE" & THE FIRST AMENDMENT

RUSS VERSTEEG*

[A] function of free speech . . . is to invite dispute. It may indeed best serve its high purpose when it induces a condition of unrest, creates dissatisfaction with conditions as they are, or even stirs people to anger. Speech is often provocative and challenging. It may strike at prejudices and preconceptions and have profound unsettling effects [T]he alternative would lead to standardization of ideas either by legislatures, courts, or dominant political or community groups.¹

—Justice William O. Douglas

Introduction

During the past three decades the United States Patent and Trademark Office (PTO), the Trademark Trial and Appeal Board (TTAB), and our federal courts have examined the “may disparage” prohibition of § 2(a) of

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1. *Terminiello v. Chicago*, 337 U.S. 1, 4-5, *reh'g denied*, 337 U.S. 934 (1949).

the Lanham Act on several occasions.² The cases that have garnered the most public attention and stirred both debate and controversy have focused on the National Football League's (NFL) trademark for the Washington Redskins.³ If trademark law prevents federal registration for Native American terms such as "Redskins," is it also likely that other, more benign names such as Cleveland "Indians," Atlanta "Braves," Kansas City "Chiefs,"⁴ Golden State "Warriors" (the 2015 NBA Champions), and

2. See, e.g., Joshua R. Ernst & Daniel C. Lumm, *Does Budda Beachwear Actually Fit? An Analysis of Federal Registration for Allegedly Disparaging Trademarks in the Non-Corporate Context*, 10 WAKE FOREST INTELL. PROP. L.J. 177, 177 (2009-2010) ("While the TTAB has developed its disparaging mark jurisprudence with respect to individuals as a distinct bar to registration over the last twenty years; the Federal Courts have only considered the TTAB's treatment of these allegedly disparaging marks once during the same span of time.").

3. See, e.g., Christian Dennie, *Native American Mascots and Team Names: Throw Away the Key; The Lanham Act Is Locked for Future Trademark Challenges*, 15 SETON HALL J. SPORTS & ENT. L. 197, 199 (2005) ("The Washington Redskins' mascot, team name, and team fight song, as well as the use of other Native American names and mascots in professional, college, and high school sports have been heavily scrutinized over the last decade."); Ernst & Lumm, *supra* note 2, at 179 ("The central contention of the American Indians' claim is that the REDSKINS family of marks is disparaging, in derogation of the requirements for federal trademark registration."); Jason Finkelstein, Note, *What the Sioux Should Do: Lanham Act Challenges in the Post-Harjo Era*, 26 CARDOZO ARTS & ENT. L.J. 301, 306 (2008) ("Hundreds of collegiate and high school athletic programs have likewise adopted Native American names, mascots and logos."); Jessica M. Kiser, *How Dykes on Bikes Got It Right: Procedural Inequities Inherent in the Trademark Office's Review of Disparaging Trademarks*, 46 U.S.F. L. REV. 1, 12-16 (2011) (summarizing the Harjo litigation); Justin Reiner, *Proud Traditions: Reflections of a Lifelong Washington Redskins Fan on the Harjo Decisions & the Use of Native American Names in Sports*, 2 WILLAMETTE SPORTS L.J. 1, 2 (2005), http://willamette.edu/law/pdf/sportslaw/spring05/final_traditions.pdf ("Conflicting viewpoints and contrary perspectives are key reasons why the debate over the use of Native American names in sports continues and why the owners steadfastly oppose changing the name of their team. The support of loyal fans and staunch traditionalists provides owners with an additional reason to stay the course. Conversely, the viewpoints of Native Americans, along with the passionate opposition of the use of these names in sports by other groups, provide Native Americans with a reason to pursue further avenues of resolve.").

4. See Julie A. Hopkins & Thomas M. Joraanstad, *Challenge-Flag Thrown: The Trademark Trial and Appeal Board's Cancellation of the Redskins' Trademarks and Pro-Football's Chances on Appeal*, 10 J. BUS. & TECH. L. 267, 270 (2015) ("In 1963, the Dallas Texans relocated to Kansas City and were renamed the Chiefs, the last professional sports team to adopt a Native American mascot.").

Chicago “Blackhawks” (the 2015 Stanley Cup Champions) will also be axed (or should we say “tomahawked”)?⁵

In April of 2015, however, the Court of Appeals for the Federal Circuit (CAFC) focused its analytical lens much more sharply to ask one specific question about this issue; namely, whether the “may disparage” prohibition of § 2(a) of the Lanham Act violates the First Amendment.⁶ The case that has brought the issue to a head is *In re Tam*, a case involving the PTO’s

5. In addition to these teams, the history of professional sports has seen numerous other teams whose names and logos some might find offensive. For example, the now defunct NHL Kansas City Scouts used a logo of an Indian riding a horse. The Scouts initially wanted to use the name “Mohawks” coupled with an Indian-head logo but met opposition from the Chicago Blackhawks organization. See STEPHEN LAROCHE, CHANGING THE GAME: A HISTORY OF NHL EXPANSION 234 (Michael Holmes ed., 2014). For discussion regarding the potential for further litigation challenging team names other than the Redskins, see for example, Dennie, *supra* note 3, at 208 (“The *Harjo* court noted further that finding that such a small amount of questionable evidence sufficient to cancel these trademarks would mean that virtually all professional sports teams with similar marks would have to refrain from activity that could be construed as even mildly insulting or derogatory to Native Americans.”) (citing *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 134 (D.D.C. 2003); *id.* at 211 (“‘Redskins,’ however, is an anomaly. It is wholly distinguishable from other Native American names and symbols currently used by sports teams.”); Ernst & Lumm, *supra* note 2, at 204 (“[A] successful cancellation of the REDSKINS family of marks as a result of the *Blackhorse* cancellation proceedings will call into the question the eligibility for registration of other sports teams’ registered marks.”); Rachel Clark Hughey, *The Impact of Pro-Football, Inc. v. Harjo on Trademark Protection of Other Marks*, 14 FORDHAM INTELL. PROP., MEDIA & ENT. L.J. 327, 360 (2004) (“Many other Native Americans suggest that the term ‘redskin’ offends them, but terms like ‘braves,’ ‘Seminoles,’ and ‘Sioux’ do not. Suzan Harjo called the term ‘redskin’ ‘the worst name you can call Native Americans in the English language.’”) (footnotes omitted); see also André Douglas Pond Cummings, *Progress Realized?: The Continuing American Indian Mascot Quandary*, 18 MARQ. SPORTS L. REV. 309, 332 (2008) (“Of the primary professional sports leagues in the United States, specifically the NFL, Major League Baseball (MLB), the National Basketball Association (NBA) and the National Hockey League (NHL), each league maintains at least one club that uses an offensive American Indian moniker, mascot, and/or logo.”); cf. John R. Wallace, Note, *Discriminatory & Disparaging Team Names, Logos, & Mascots: Workable Challenges & the Misapplication of the Doctrine of Laches*, 12 RUTGERS RACE & L. REV. 203, 208 (2011) (“It is important to note that [n]ames like “Cowboys,” “Vikings,” or “Fighting Irish” do not have comparable effects because the history of each of these groups is one of inclusion and survival, rather than exclusion and potential cultural extinction.”) (quoting Justin G. Blankenship, *The Cancellation of Redskins as a Disparaging Trademark: Is Federal Trademark Law an Appropriate Solution for Words that Offend?*, 72 U. COLO. LAW REV. 415, 424 (2001)).

6. *In re Tam*, 600 F. App’x 775 (Fed. Cir. 2015).

refusal to register the mark “The Slants” for an Asian musical group.⁷ And while briefs were being submitted in *Tam* in preparation for a rehearing *en banc*, Judge Gerald Bruce Lee, of the district court of the Eastern District of Virginia, ruled in *Pro-Football v. Blackhorse*, on July 8, 2015, that the “may disparage” prohibition of § 2(a) does *not* offend the First Amendment and affirmed the TTAB’s cancellation of the Redskins’ trademarks.⁸ Then on December 22, 2015, the CAFC decided *In re Tam*, holding that the “may disparage” prohibition *does* conflict with the First Amendment and, therefore, is unconstitutional.⁹

This Article focuses on at that one very narrow issue; namely, whether § 2(a)’s prohibition of trademarks that “may disparage” violates the First Amendment.¹⁰ In short, the Article argues that § 2(a)’s prohibition of trademarks that “may disparage” is, in fact, unconstitutional, because it violates the First Amendment’s protection of free speech. This Article contends that the statutory language of § 2(a) (i.e., “may disparage”) is rooted in archaic, early Twentieth Century concepts of decency that are now outmoded given the context of contemporary First Amendment jurisprudence—a jurisprudence that today protects commercial speech.

7. See Amanda E. Compton, *N.I.G.G.A., Slumdog, Dyke, Jap, and Heeb: Reconsidering Disparaging Trademarks in a Post-Racial Era*, 15 WAKE FOREST J. BUS. & INTEL. PROP. L. 1, 23 (2014) (“Another example, involves the Asian-American rock band, The Slants. A member of the band attempted to register THE SLANTS in connection to ‘live performances by a musical band.’ The application was filed in 2011, but the applicant claimed to be using the mark since 2006. Ultimately, the mark was deemed to be disparaging and the Trademark Office refused to register the mark. To date, the band is still performing under the name The Slants.”) (footnotes omitted). See also *infra* Parts I, III, IV, and V for more detailed consideration of *In re Tam*.

8. See *Pro Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (2015).

9. 808 F.3d 1321, 1328 (Fed. Cir. 2015).

10. See LEARNED HAND, *THE BILL OF RIGHTS: THE OLIVER WENDELL HOLMES LECTURES 7-8* (1958) (“[W]here the will of the legislature declared in its statutes stands in opposition to that of the people declared by the Constitution, the judges ought to be governed by the latter rather than the former.”). There is reason to believe that the “may disparage” prohibition is unconstitutional on its face and also as applied to both the terms “Redskins” and “Slants.” See generally JOHN E. NOWAK & RONALD D. ROTUNDA, *CONSTITUTIONAL LAW* § 16.1(g), at 1264 (8th ed. 2010) (“When the Court determines whether a law is invalid on its face, it looks at not only the statutory language but also the way the courts and enforcement authorities have interpreted the language. . . . If a law is not invalid on its face, the litigant can still argue that it is invalid as applied in a specific case.”). This Article does not address the strengths and weaknesses of the doctrine of laches as it may or may not apply to § 2(a).

Part I of this Article briefly summarizes the salient cases that have considered the issue of trademark disparagement and articulated the principal rules related to § 2(a). Part II summarizes major points raised by scholarship that has focused on this issue. Part III summarizes the CAFC's April opinion in *In re Tam*, Judge Moore's "Additional Views" submitted in conjunction with the opinion, the briefs of the parties submitted for the CAFC's *en banc* hearing (with the addition of some editorial comments), and the CAFC's December 2015 *en banc* decision. Using basic First Amendment principles, Part IV first examines how contemporary First Amendment jurisprudence applies to § 2(a)'s prohibition of marks that "may disparage." Part IV then applies "commercial speech" doctrine to § 2(a) before considering Judge Lee's (Eastern District of Virginia) summary judgment decision in *Blackhorse* and its reliance on *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*¹¹ Next, this Part, like portions of the CAFC's *en banc* opinion, also suggests that copyright law may offer insight into the issue. And lastly Part IV briefly looks at the applicability of the "unconstitutional conditions" doctrine. The Conclusion offers a reminder of the importance of the First Amendment's protection of freedom of speech and suggests ways to increase the likelihood of realizing some of § 2(a)'s goals in light of the interests of the public and trademark owners.

I. Litigation Background & Summary

A. Statutory Basis

The Lanham Act is the United States' federal trademark statute.¹² Congress enacted it on July 5, 1946, and it became law on July 5, 1947.¹³ As amended, the Lanham Act's definition of a trademark includes "any word, name, symbol, or device . . . [used] to identify and distinguish . . . goods."¹⁴ Registration of a trademark on the Principal Register of the PTO provides a number of significant benefits to registrants.¹⁵

11. 135 S. Ct. 2239 (2015).

12. 15 U.S.C. §§ 1051-1072, 1091-1096, 1111-1127 (2012).

13. 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 5:4 (4th ed. 2013) ("[T]he Lanham Trademark Act was signed into law by President Truman on July 5, 1946, and took effect one year later, July 5, 1947.").

14. 15 U.S.C. § 1127; *see also* 1 MCCARTHY, *supra* note 13, § 3:1. For purposes of the discussion regarding First Amendment issues detailed *infra* Part IV, it may be useful to keep in mind that "symbolic speech" generally qualifies as "speech" entitled to First Amendment protection. *See* NOWAK & ROTUNDA, *supra* note 10, § 16.1(d) ("[T]o be considered as speech, non-verbal activity must be of a type that a reasonable onlooker would understand as

First, registration of the trademark provides constructive notice to others that the registrant owns the trademark, an important protection against potential trademark infringers. Second, registration facilitates incontestability of a trademark. . . . Third, registration allows the holder of the trademark to renew registration of it in ten year increments, thus allowing for continuous protection.¹⁶

In addition:

Although federal registration does not create a trademark or confer ownership, a registered mark enjoys numerous benefits including: (1) public notice of ownership of the mark; (2) a legal presumption of ownership of the mark and exclusive right to use the mark nationwide or in connection with the good and services registered; (3) the ability to bring actions associated with the mark in federal court; (4) a basis to obtain registration in foreign countries; and (5) U.S. Customs protection against the importation of infringing foreign goods.¹⁷

conveying some type of message.”); *id.* § 16.48 (“The Supreme Court has recognized the notion that speech may be nonverbal as far back as 1931. *Stromberg v. California* provided First Amendment protection to certain forms of symbolic expression.”) (citing *Stromberg v. California*, 283 U.S. 359 (1931)).

15. See *In re Tam*, 808 F.3d 1321, 1328-29 (Fed. Cir. 2015) (listing and explaining the many substantive and procedural benefits of federal registration); see also 3 MCCARTHY, *supra* note 13, §§ 19:9-10.

16. Kristine A. Brown, *Native American Team Names and Mascots: Disparaging and Insensitive or Just Part of the Game?*, 9 SPORTS LAW. J. 115, 121 (2002); see also Hughey, *supra* note 5, at 362 (“Without federal trademark protection, the team is still allowed to use the mark, but may not preclude others from using it. For example, if the trademark had been cancelled, the Redskins franchise would have to compete with unlicensed vendors for tee-shirt sales and other royalties.”).

17. Hopkins & Joraanstad, *supra* note 4, at 273 (footnotes omitted); see also Kimberly A. Pace, *The Washington Redskins Case and the Doctrine of Disparagement: How Politically Correct Must a Trademark Be?*, 22 PEPP. L. REV. 7, 15-16 (1994) (“While cancellation of the trademark’s federal registration does not prevent the team from continuing to use the Redskins name, it does revoke the benefits afforded by federal registration. Canceling federal registration on the basis that the trademark disparages Native Americans could eliminate the team’s exclusive right to use the trademark.”) (footnotes omitted); *id.* at 19-20 (1995) (summarizing the benefits afforded by federal registration of trademarks).

Section 2 of the Lanham Act articulates specific reasons why a trademark might be denied registration.¹⁸ Section 2 begins by stating: “No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless”¹⁹ Section 2(a) then specifies that a mark will be denied registration if it “may disparage . . . persons, . . . institutions, beliefs, . . . or bring them into contempt, or disrepute.”²⁰ Section 4(3) of the Lanham Act provides a number of reasons for which a previously registered mark might be cancelled, including instances in which the mark was registered in contravention of § 2(a).²¹

18. 15 U.S.C. § 1052.

19. *Id.*

20. *Id.* § 1052(a); see 3 MCCARTHY, *supra* note 13, § 19:77.25 (summarizing the doctrine and discussing many of the important cases, including the litigation involving *Harjo*, *Blackhorse*, and *Tam*); see also Pace, *supra* note 17, at 9 (“Section 2(a) of the Lanham Act prevents the registration of a trademark with such words as ‘nigger,’ because it would ridicule African-American people and depict them in a disparaging way.”). It is striking how similar this language is to the Sedition Act of 1798, which prohibited “publishing any false, scandalous and malicious writing or writings against the government of the United States, or either house of Congress . . . or the President . . . with intent to . . . bring them . . . into contempt or disrepute.” NOWAK & ROTUNDA, *supra* note 10, § 16.5(b) (noting that the Alien and Sedition Acts “remain the epitome of an unconstitutional abridgement of free speech.”).

21. A trademark may be canceled in circumstances where “its registration was obtained fraudulently or contrary to the provisions of . . . subsection (a) . . . of section 1052” 15 U.S.C. § 1064(3) (2012); see 3 MCCARTHY, *supra* note 13, §§ 20:40, 20:59; see also, e.g., Pace, *supra* note 17, at 21 (“While registration does constitute prima facie evidence that the trademark is valid, the mark's validity can still be attacked by any person who believes that she is damaged by the registration. If the action is taken within five years of the mark's registration, a person who believes that she is damaged by the registration can file a Petition for Cancellation of the trademark for any of the reasons that the examiner could have refused registration. After five years, a Petition for Cancellation can only be filed if the registered mark becomes generic, has been abandoned, was fraudulently obtained, or should not have been granted because the mark was inconsistent with one of the content-based prohibitions in subsections 2(a), (b), or (c) of the Lanham Act. A Petition for Cancellation, like an opposition, is heard by the TTAB. Decisions of the TTAB can be appealed to either the United States Court of Appeals for the Federal Circuit or to a United States District Court.”) (footnotes omitted); Regan Smith, *Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks*, 42 HARV. C.R.-C.L. L. REV. 451, 455 (2007) (“Challenges on any grounds that the examiner could have used initially to refuse registration can be brought within the first five years of the mark's registration; after five years, the grounds for challenges are narrower but still include, inter alia, that a mark is

In addition to refusal to register by a PTO examining attorney and cancellation, it is also possible that a trademark could be denied registration by a third party's opposition.²² In sum, then, a trademark owner may be unable to reap the benefits of registration on the Principal Register²³ due to three types of actions: 1) the trademark examining attorney refuses to register; 2) an opposer successfully opposes registration; or 3) a third party successfully cancels the registration *post hoc*.²⁴

B. Legal Principles Established

1. General

Although refusal to register, opposition, or cancellation are three distinct procedural means by which the “may disparage” prohibition of § 2(a) can deny a trademark owner the benefits of registration on the Principal Register, all three apply the same legal principles when determining whether a mark “may disparage.” We now turn to those legal principles. The origin of the “may disparage” prohibition in the Lanham Act is far from transparent.²⁵ Yet, the TTAB, the administrative body that hears appeals relating to denials of registration for reasons including the § 2(a) “may disparage” prohibition, and several federal courts have established a methodology for analyzing cases involving § 2(a)'s “may disparage” prohibition. The cases have involved trademarks associated with a variety of goods and services, including wine, beachwear, clothing, and sports (specifically football). Generally speaking, when considering whether § 2(a)'s may disparage prohibition applies to persons, the current analysis focuses on whether mark disparages a substantial composite²⁶ of those

scandalous or disparaging.”); *see also* Ernst & Lumm, *supra* note 2 (discussing the consequences of cancellation for a trademark owner).

22. 15 U.S.C. § 1063; *see* 3 MCCARTHY, *supra* note 13, §§ 20:1, 20:20. For a discussion relating to standing either to oppose or to cancel a registration, *see*, for example, Smith, *supra* note 21, at 456 (“A party bringing suit in opposition to a pending registration or moving for cancellation of a registration ‘must have a real interest in the proceedings and must have a reasonable basis for his belief of damage.’”) (citing *Ritchie v. Simpson*, 170 F.3d 1092, 1095 (Fed. Cir. 1999)).

23. *See* 15 U.S.C. §§ 1051-1072 (2012).

24. *See id.* § 1064.

25. *See infra* Section IV.A.2.c. for a more in-depth examination of this issue.

26. *In re Tam*, 808 F.3d 1321, 13330-31 (Fed. Cir. 2015) (quoting *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014)); *see* Kiser, *supra* note 3, at 17 (“However, the TTAB noted, ‘applicant's own evidence shows that not all members of the relevant public find the term HEEB to be unobjectionable;’ the letters submitted ‘suggest that there is a generational

persons at the time of the issuing of registration.²⁷ The ultimate determination of “[w]hether a trademark is disparaging ‘is ultimately a fact-bound conclusion that rests with the fact-finder.’”²⁸

One difficulty that examining attorneys, the TTAB, and courts have encountered in construing the “may disparage” prohibition is that § 2(a) also prohibits registration of marks that are immoral or scandalous.²⁹

divide in the perception of this term.”) (citing *In re Heeb Media LLC*, 89 U.S.P.Q.2d (BNA) 1071, 1076 (T.T.A.B. 2008)); Francine Ward & Stephanie Quick, *Offensive Marks: The Policing of Trademarks in a Diverse World*, 5 LANDSLIDE 52, 53 (2013) (“Whether a proposed mark is disparaging must be determined from the standpoint of a substantial composite of the referenced group in the context of contemporary attitudes. Case law does not provide a fixed number or percentage for ‘substantial composite.’ However, it is well established that a ‘majority’ is not necessarily required.”) (citing *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d (BNA) 1264, 1269 (T.T.A.B. 2012); *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1758 (T.T.A.B. 1999); *In re Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1340 (Fed. Cir. 2003); *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981)). Arguably, this raises an interesting problem. The “substantial composite” test still allows a minority of a minority to bring about trademark cancellation. This puts a great deal of power in the hands of a small group who are merely contending that their feelings have been bruised.

27. See, e.g., Brown, *supra* note 16, at 124 (“In a trademark challenge, the petitioner must demonstrate that the trademark in question was ‘disparaging’ at the time it was registered.”) (citing 15 U.S.C. § 1052(a) (2012)); Ernst & Lumm, *supra* note 2, at 186 (“[T]he TTAB specified that the ‘critical dates’ for determining whether the marks were disparaging would be the dates that the marks were issued; thus any evidence must show that the marks were disparaging at the date of issuance rather than the date of the cancellation petition.”) (citing *Harjo v. Pro-Football, Inc.*, 30 U.S.P.Q.2d 1828, 1832 (T.T.A.B. 1994)); Hughey, *supra* note 5, at 338 (“In order for a mark to be cancelled under section 2(a), the mark must have been scandalous or disparaging when it was originally granted.”) (citing 15 U.S.C. § 1064(3)); Smith, *supra* note 21, at 464 (“The Washington Redskins case also implies that a substantial composite is a very high percentage of the potentially disparaged.”).

28. Hughey, *supra* note 5, at 350; see, e.g., Hopkins & Joraanstad, *supra* note 4, at 281 & n.25 (“Whether a mark is disparaging to the referenced group is a question of fact, not law.”) (citing *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 117 (D.D.C. 2003)); *id.* at 117 n.125 (explaining that in the case of *Harjo*, “The court reiterated, however, that the court reviews *de novo* the question of whether the legal standard applied by the TTAB is the appropriate standard. [Further.] ‘[The TTAB’s] findings of fact . . . are reviewed under the substantial evidence test. The Court then turns its attention [sic] the legal principles adopted by the TTAB to help it resolve this case. The court reviews the TTAB’s legal principles *de novo*.”) (citation omitted).

29. 15 U.S.C. § 1052(a) (“immoral, deceptive, or scandalous matter . . .”) see, e.g., Smith, *supra* note 21, at 460 (“Very few words have been found to be scandalous per se. One exception to this rule was the mark ‘Bullshit’ as applied to a line of designer

Although current jurisprudence recognizes that the questions of whether a mark is “immoral,” “scandalous,” or one that “may disparage” are distinct inquiries,³⁰ this has not always been the case, and both the TTAB and the courts have occasionally fallen prey to treating these terms as synonymous.³¹

2. Greyhound, Hines, *Harjo*, & the Name “Redskins”

One of the first cases to interpret § 2(a)’s “may disparage” prohibition was *Greyhound Corp. v. Both Worlds, Inc.*³² Both Worlds sold t-shirts with a visual image that looked a great deal like the well-known logo of the Greyhound Bus Corporation. But the Both Worlds’ image depicted the dog in a squatting position, defecating (a “pooping pooch”). The TTAB held that the Both Worlds’ logo was disparaging to Greyhound and, therefore, could not be registered.³³ *Greyhound* is both unusual and interesting

handbags.”) (citing *In re Tinseltown*, 212 U.S.P.Q. (BNA) 863, 866 (T.T.A.B. 1981)); *id.* at 461 (“The court in *In re McGinley* outlined the seminal test for whether a trademark is scandalous: ‘Whether or not the mark, including innuendo, is scandalous is to be ascertained from the standpoint of not necessarily a majority, but a substantial composite of the general public.’”) (citation omitted); *see also* Dennie, *supra* note 3, at 203-04 (“Trademarks found to be scandalous generally involve marks that are clearly offensive to moral feelings such as: “Dickheads” restaurant services, “Bullshit” personal accessories, and “Bubby Trap” brassieres.”) (footnotes omitted).

30. *See, e.g.*, Pace, *supra* note 17, at 33 (“It is important to note from the outset, that the statute clearly distinguishes between the test for scandalous and immoral marks, on the one hand, and disparaging marks on the other.”); Smith, *supra* note 21, at 453 (“Courts have interpreted Section 2(a) to comprise two grounds for denial: a trademark can be either ‘scandalous’ or ‘disparaging.’”); *id.* at 463 (“[W]hile scandalousness is normally targeted at majority populations, disparagement is more often concerned with minority subgroups.”).

31. *See, e.g.*, Smith, *supra* note 21, at 463 (“Although the ‘scandalous’ and ‘disparaging’ provisions appear in the same clause of Section 2 of the Lanham Act, and are occasionally conflated in court decisions, the two appeal to very different standards. Whether a trademark is scandalous depends on the reaction from the general public; whether a trademark is disparaging depends on its effect upon the specific group allegedly being disparaged.”); Ernst & Lumm, *supra* note 2, at 183.

32. *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d (BNA) 1635 (T.T.A.B. 1988); *see also* Brown, *supra* note 16, at 124 (“The TTAB examines the nature of the trademark in light of the test for disparagement set out in *Greyhound Corp. v. Both Worlds, Inc.* In *Greyhound*, the TTAB held that in order for a trademark to be deemed ‘disparaging,’ two elements must be present: (1) the trademark must be reasonably understood as referring to the plaintiff, and (2) the trademark must be considered offensive or objectionable by a reasonable person of ordinary sensibilities.”).

33. *Greyhound*, 6 U.S.P.Q.2d (BNA) at 1640; *see also* Dennie, *supra* note 5, at 204 (“In *Greyhound v. Both Worlds, Inc.*, the TTAB held that a petitioner must establish two

because, unlike a number of the more recent cases that have involved Native Americans and religious groups, this case examined the “may disparage” prohibition in the context of a corporation. The Greyhound Corporation claimed that the Both Worlds’ pooping pooch logo was disparaging to its own (i.e., Greyhound’s) corporate symbol. Nevertheless, *Greyhound* serves as an adequate beginning point to examine the doctrine.

In re Hines, however, is the case that established the next important phase of the § 2(a) “may disparage” analysis.³⁴ Hines sought to register the mark “Budda Beachwear” for apparel.³⁵ The PTO’s examining attorney refused registration on the basis that the mark was disparaging to the religion of Buddhism.³⁶ One factor that makes *Hines* especially important is that the issue focused on whether the mark disparaged persons (i.e., Buddhists), an institution (i.e., Buddhism), and beliefs (i.e., the beliefs held by Buddhists). In particular, unlike *Greyhound*, here the TTAB addressed the nuances at play when determining whether a mark is disparaging to a group of persons. The TTAB held that the opinions of the general public were irrelevant. Rather the pivotal question is whether a substantial composite of the allegedly disparaged group feels disparaged.³⁷ According to the TTAB, the allegedly disparaged group is “those referred to, identified or implicated in some recognizable manner by the involved mark”³⁸ Thus, *Hines* departed from the concerns relating to disparagement of a

elements for a trademark to be disparaging. First, the trademark must be ‘reasonably understood’ to refer to the plaintiff. Second, a ‘reasonable person of ordinary sensibilities’ must consider the trademark offensive or objectionable. Hence, the second prong of the *Greyhound* Test is an objective standard: a reasonable person in society must find the trademark offensive and objectionable.”); Pace, *supra* note 17, at 30 (“The TTAB decided that disparagement was ‘a violation of one’s right of privacy—the right to be “let alone” from contempt or ridicule.’ In formulating its test for disparagement, the Board adopted the definition of disparagement offered by the Second Restatement of Torts pursuant to which, ‘[a] statement is disparaging if it is understood to cast doubt upon the quality of another’s land, chattels or intangible things’”) (citing RESTATEMENT (SECOND) OF TORTS § 629 (1977)); Ward & Quick, *supra* note 26, at 52 (“In *Greyhound Corp. v. Both Worlds, Inc.*, the TTAB defined ‘disparagement’ as essentially a violation of one’s right of privacy—the right to be ‘let alone’ from contempt or ridicule. Under this view, the intent of § 2(a) was primarily to protect against the registration of marks that harmed the reputation of a particular individual or company.”).

34. 31 U.S.P.Q.2d (BNA) 1685 (T.T.A.B. 1994).

35. *Id.* at 1685-86.

36. *Id.* at 1686.

37. *See id.* at 1688.

38. *Id.*

corporate logo (i.e., the central issue in *Greyhound*) and instead addressed the disparagement *vel non* of a group of individuals.³⁹

Although other cases subsequent to *Greyhound* and *Hines* have considered the issue of disparagement,⁴⁰ the most in-depth analysis of the § 2(a) “may disparage” prohibition evolved from the litigation brought by Susan Harjo in her attempt to challenge and cancel the trademark registrations of the Washington Redskins.⁴¹ Harjo and other plaintiffs sought to cancel the Washington Redskins trademarks, arguing that they were disparaging to Native Americans.⁴² Briefly stated, “Native Americans

39. See Dennie, *supra* note 3, at 205 (“In contrast, in *In re Hines* the TTAB held that, in determining whether a trademark is disparaging to a racial group, only the perceptions of a substantial composite of those ‘referred to, identified or implicated in some recognizable manner by the involved mark’ are relevant. Therefore, demonstrating that a mark is disparaging to a particular racial group, such as Native Americans, in a cancellation proceedings requires a two-part showing. Under the *In re Hines* standard, plaintiffs must show: (1) that the trademark is reasonably understood to refer to the plaintiffs; and (2) the ‘substantial composite’ associated with the mark find it disparaging or scandalous. Thus, the ‘substantial composite’ refers to the reasonable member of the relevant racial group, rather than the reasonable person.”); Ernst & Lumm, *supra* note 2, at 183 (discussing *In re Hines*).

40. See *infra* Section I.D., where these cases are discussed.

41. There were six different Washington Redskins trademarks. For a summary of the Harjo litigation see, for example, Brown, *supra* note 16, at 125 (“In *Harjo v Pro-Football, Inc.*, a group of Native Americans brought cancellation proceedings against the Washington Redskins football team, alleging that the team’s registered trademarks were disparaging. The petitioners asserted that the word ‘redskin(s),’ or a form of that word, appeared in each of the trademarks they sought to have cancelled; that the word ‘redskin(s)’ ‘was and is a pejorative, derogatory, denigrating, offensive, scandalous, contemptuous, disreputable, disparaging and racist designation for a Native American person;’ and that the ‘registrant’s use of the [trademarks] in the identified registrations ‘offends’ petitioners and other Native Americans.’ They further contended that ‘the [trademarks] in the identified registrations ‘consist of or comprise matter which disparages Native American persons, and brings them into contempt, ridicule, and disrepute’ and were therefore violative of section 2(a).”); Justin P. Grose, Comment, *Time to Bury the Tomahawk Chop: An Attempt to Reconcile the Differing Viewpoints of Native Americans and Sports Fans*, 35 AM. INDIAN L. REV. 695, 700-09 (2010-2011); Wallace, *supra* note 5, at 219-20; *id.* at 225-29.

42. See, e.g., Brown, *supra* note 16, at 117 (“The Native American community asserts that these names and logos portray Native Americans in a racist and degrading manner that dehumanizes them as members of society.”); Dennie, *supra* note 3, at 205 (“In *Harjo v. Pro-Football, Inc.*, a group of Native Americans brought a trademark cancellation proceeding against the Washington Redskins, alleging that the team’s registered trademarks were disparaging under the Lanham Act.”); J. Gordon Hylton, *Before the Redskins Were the Redskins: The Use of Native American Team Names in the Formative Era of American Sports, 1857-1933*, 86 N.D. L. REV. 879, 882 (2010) (“In 1992, a group of seven Native

oppose the use of American Indians as team logos, trademarks and mascots. They claim that the marks depict Indians in a racist and degrading fashion, and that they perpetuate demeaning stereotypes.”⁴³ The TTAB agreed that the marks ought to be canceled pursuant to the “may disparage” prohibition of § 2(a),⁴⁴ but after four years of appeal, the District of Columbia Court

American activists, led by Suzan Harjo, filed a complaint with the United States Patent and Trademark Office's Trademark Trial and Appeal Board (TTAB), requesting the Board decertify the team's trademark, which had been registered in 1967. The Harjo petition was based on the claim that the term ‘Redskins’ was particularly offensive to Native Americans and was the equivalent of referring to African Americans as ‘niggers.’”); Mark S. Nagel & Daniel A. Raschert, *Washington “Redskins”—Disparaging Term or Valuable Tradition?: Legal and Economic Issues Concerning Harjo v. Pro-Football, Inc.*, 17 *FORDHAM INTELL. PROP., MEDIA & ENT. L.J.* 789, 791 (2007) (“The primary legal contention from the Redskins' opponents is that Section 2 of the 1946 Lanham Act prohibits trademarks that ‘consists of . . . matter which may disparage . . . persons . . . or bring them into contempt or disrepute’ and that the term ‘Redskins’ is known in the dictionary and in the common American lexicon as ‘a disparaging term for a Native American’ and is considered ‘the most derogatory thing Native Peoples can be called in the English language.’”) (footnotes omitted); Wallace, *supra* note 5, at 207 (“There has been an initiative in the Native American community to address these disparaging logos and mascots containing Native American imagery. The movement argues ‘that such Native American team symbols are disparaging, racially discriminatory, create racially hostile environments and perpetuate racial stereotypes.’”) (footnote omitted).

43. Pace, *supra* note 17, at 11; *id.* at 12 (“Native American Indian groups have long been claiming that the Washington Redskins' trademark is particularly racist and degrading. They insist that the term ‘Redskin’ is a racial epithet, and as such, it perpetuates demeaning stereotypes of Native Americans.”).

44. See, e.g., Finkelstein, *supra* note 3, at 308 (“In 1999, in *Harjo v. Pro-Football (Harjo II)*, the TTAB ordered the cancellation of the various trademarks owned by Pro-Football incorporating the word ‘redskin.’”); *id.* at 303 (“However, four years later in *Harjo III*, the United States District Court for the District of Columbia reversed that decision on grounds that the plaintiffs did not meet the requisite burden of proof, and also because of a laches defense argued by Pro-Football and the Washington Redskins.”) (citing *Pro-Football, Inc. v. Harjo (Harjo III)*, 284 F. Supp. 2d 96, 145 (D.D.C. 2003). This decision was ultimately remanded in *Pro-Football, Inc. v. Harjo (Harjo IV)*, 415 F.3d 44 (D.C. Cir. 2005)), based on an improper application of laches. Finkelstein, *supra* note 3, at 303 (“In *Harjo II*, the Trial Trademark and Appeal Board (TTAB) held that the National Football League's Washington Redskins were in violation of the Lanham Act for using a logo-mark that was disparaging to a large number of Native Americans. The TTAB relied on section 2(a) of the Lanham Act, which prohibits the use of a trademark that is ‘scandalous’ or ‘which may disparage’ a certain group.”); Kiser, *supra* note 3, at 13 (“On April 2, 1999, the TTAB canceled these six marks stating that the term ‘redskins’ as used in Pro-Football, Inc.'s marks references Native Americans.”); Ward & Quick, *supra* note 3, at 52 (“The Trademark Trial and Appeal Board (TTAB) cancelled the trademarks, finding that the marks

ultimately reversed, ruling that the TTAB's decision regarding disparagement was not supported by substantial evidence and that the doctrine of laches barred the plaintiffs' suit.⁴⁵ But most importantly for our

may disparage Native Americans and may cast Native Americans into contempt or disrepute in violation of Lanham Act § 2(a.); Grose, *supra* note 41, at 702 (“[T]he TTAB finally ruled in favor of the petitioners, calling for the cancellation of the Washington Redskins’ trademark registration.”) (citing *Harjo II*, 50 U.S.P.Q.2d (BNA) at 1749); Jeffrey Lefstin, Note, *Does the First Amendment Bar Cancellation of REDSKINS?*, 52 STAN. L. REV. 665, 668-71 (1999-2000) (summarizing the TTAB’s decision).

45. See, e.g., Christian Dennie, *supra* note 3, at 207 (“The District Court for the District of Columbia reversed, determining that the TTAB had improperly cancelled the ‘Redskins’ trademarks. The *Harjo* district court found that the TTAB’s conclusion that the term ‘redskin’ was disparaging to Native Americans was not supported by substantial evidence. In addition, the district court recognized a laches defense.”); Ernst & Lumm, *supra* note 2, at 189 (“The district court overturned TTAB’s decision on two alternative grounds: 1) that the TTAB’s decision was unsupported by substantial evidence; and 2) that the American Indians’ cancellation petition was barred by laches.”); Finkelstein, *supra* note 3, at 309 (“Four years after the decision by the TTAB, the District Court for the District of Columbia reversed the cancellation of the ‘redskins’ marks, both for a lack of sufficient evidence to support the finding of disparagement and because of a laches defense.”) (citing *Harjo III*, 284 F. Supp. 2d at 145); Hopkins & Joraanstad, *supra* note 4, at 282 (“Despite affirming the TTAB’s test for disparagement, the court ultimately concluded that the TTAB’s holding that the marks disparaged Native Americans was unsupported by substantial evidence.”); Kiser, *supra* note 3, at 14 (“On September 30, 2003, the district court overturned the TTAB’s decision on two grounds: (1) the TTAB’s finding of disparagement was not supported by substantial evidence; and (2) the consideration of the case was precluded by the doctrine of laches, an equitable defense that applies when a plaintiff’s delay in bringing a suit has unduly burdened the defendant.”); Nagel & Raschert, *supra* note 42, at 794 (“On October 1, 2003, Judge Colleen Kollar-Kotelly ruled that the TTAB erred in its finding that there was sufficient evidence to decisively conclude that the name ‘Redskins’ was disparaging to Native Americans.”) (citing *Harjo III*, 284 F. Supp. 2d at 121); Smith, *supra* note 21, at 458 (“One of the leading cases discussing the nuances of Section 2(a) is *Pro-Football, Inc. v. Harjo*, which reversed the TTAB’s finding that the Washington Redskins’s trademark should be revoked, holding that ‘Redskins’ was not disparaging, or, in the alternative, that laches prevented the Native American challengers from bringing suit.”) (citing *Harjo III*, 284 F. Supp. 2d at 136); Ward & Quick, *supra* note 26, at 52 (“Pro-Football successfully appealed the TTAB’s decision in federal district court, where the court held that the suit was barred by the doctrine of laches and that the finding of disparagement was not supported by substantial evidence.”); Grose *supra* note 41, at 703 (“The district court determined the following: ‘The TTAB’s finding of disparagement is not supported by substantial evidence and must be reversed. The decision should also be reversed because of the doctrine of laches precludes consideration of the case.’”); see also Hughey, *supra* note 5, at 348-49 (“Pro-Football appealed the TTAB decision to the U.S. District Court for the District of Columbia. Pro-Football argued several reasons why the court should overturn the TTAB’s decision. First, it

purposes, the District Court approved the TTAB's legal test for disparagement; it reversed on other grounds (lack of substantial evidence and laches). Relying on *Hines*, the TTAB laid the foundation for the current analytical model (a two-part test) for the "may disparage" prohibition of § 2(a), even though the District Court overturned the decision for other reasons.⁴⁶

The TTAB . . . clarified that whether the marks at issue are disparaging is based on the disparaging nature of the marks when the respective registrations were issued, and not whether the marks are considered disparaging in present society. Furthermore, the TTAB stated that "scandalous" and "disparage" as used in Section 2(a) represented different statutory bars, holding that "scandalous" looked to society as a whole, while "disparage" looked only to the beliefs of the identifiable group. In doing so, the TTAB declared that the opinions of those individuals in the identifiable group are the only relevant points of view as to whether the term was disparaging. Thus, the TTAB developed the two-part test that became the standard for whether a mark should be barred for being disparaging:

(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 and services, and the manner in which the

argued that the trademarks did not disparage Native Americans and did not bring Native Americans into contempt or disrepute. Second, it asserted that section 2(a) of the Lanham Act was unconstitutional because it was a vague, overbroad, content-based restriction on speech. It further argued that section 2(a) was unduly vague in violation of the Fifth Amendment. Finally, Pro-Football contended that the cancellation petition was barred by the doctrine of laches." (footnotes omitted). For a discussion of the doctrine of laches and its application in the *Harjo* case, see, for example, Wallace, *supra* note 5, at 229-36; *see also* Hughey, *supra* note 5, at 353 ("The district court also found that, in the alternative, because of the delay in challenging the trademark, laches barred the petitioners' suit."); *id.* at 349 ("After considering motions from parties and the evidence on the record, the district court held that the TTAB's finding of disparagement was not supported by substantial evidence and the suit was barred by laches, and consequently reversed the TTAB decision.") (citing *Harjo v. Pro-Football, Inc.*, 284 F. Supp. 2d 96,141 (D.D.C. 2003)); Dennie, *supra* note 3, at 217; Grose, *supra* note 41, at 708-09.

46. *See, e.g.*, Hopkins & Joraanstad *supra* note 4, at 281 ("[T]he court upheld the two-part test crafted by the TTAB to determine whether a mark is disparaging, including limiting the relevant perceptions to only those people who are part of the identifiable group.").

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.⁴⁷

In terms of the TTAB's analysis, one crucial, legal determination stands out: although the general public's views are relevant in determining whether a mark is "scandalous," only the views of the allegedly disparaged group of people—not the general public's views—are relevant when assessing whether a mark "may disparage."⁴⁸ According to the TTAB, "it is only logical that, in deciding whether the matter may be disparaging, we look, not to American society as a whole . . . but to the views of the referenced group."⁴⁹ Thus the TTAB narrowed the assessment of disparagement by zeroing in on the feelings, the mindset, of the allegedly disparaged group.

One of the more interesting aspects of the litigation concerning the Redskins is the history of the name. When the franchise started in 1932, the team originally was named "Braves" but was renamed "Redskins" in the following year, and then in 1937, the team relocated from Boston to Washington, D.C.⁵⁰ Like many professional football teams, the Boston team initially adopted the name of its professional baseball sibling in the city, in this case, the Boston Braves.⁵¹ But after one year of playing its

47. Hopkins & Joraanstad, *supra* note 4, at 279-80 (footnotes omitted); see *In re Tam*, 808 F.3d 1321, 1330-31 (Fed. Cir. 2015) (quoting this test from the Trademark Manual of Examining Procedure (TMEP) § 1203.03(b)(i) (Jan. 2015 ed.)); see also Finkelstein, *supra* note 3, at 308-09 ("To reach this outcome, the TTAB employed the test set forth in the 1994 case *In re Hines*. This test requires looking at the 'perceptions of those referred to, identified or implicated in some recognizable manner by the involved mark.' Thus, under *Hines*, the TTAB had to find 1) that the 'redskins' trademarks owned by Pro-Football were 'reasonably understood' to refer to the plaintiffs, and then, if so, 2) that a 'substantial composite' of Native Americans found the marks 'disparaging.' Based on the evidence provided, including the testimony of linguists, dictionary definitions of 'redskin(s),' and survey evidence, the TTAB found both prongs of the test to be satisfied, and thus ruled to cancel Pro-Football's trademarks.") (footnotes omitted).

48. *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1748-49 (T.T.A.B. 1999).

49. *Id.* at 1739.

50. Hylton, *supra* note 42, at 886-90.

51. The Boston Braves baseball team was originally named the "Beaneaters." See Hopkins & Joraanstad, *supra* note 4, at 269 ("[I]n 1912, the Boston Beaneaters, now the

games at Braves Field, the team moved to Fenway Park, whereupon the owners changed the team name to Redskins, retaining the team's Native American connection while infusing the phonetic sounds of its Fenway Park neighbor "Red Sox."⁵² The team became the "Washington Redskins" when it relocated to Washington, D.C. in 1937.⁵³

The *Pro-Football, Inc. v. Harjo* litigation, however, adapting principles forged by *Greyhound* and *Hines*, established the fundamental, doctrinal analysis for evaluating the "may disparage" prohibition of § 2(a), as applied to a specific group of persons: namely, Native Americans.⁵⁴ First, the fact finder must ascertain the meaning of the mark in relation to the goods or services to which it relates. Second, in light of that meaning, the fact finder must determine whether a substantial composite of the referenced group would deem the mark disparaging.⁵⁵ Examining attorneys, the TTAB, and

Atlanta Braves, changed its name to the Boston Braves, becoming one of the first professional teams to use a Native American term as its name.").

52. Hylton, *supra* note 42, at 889 ("'Redskins' followed as a replacement name, which echoed the principle [sic] sounds of 'Red Sox,' the baseball inhabitants of Fenway Park.").

53. *See id.* at 886-90 (explaining the evolution of the Washington Redskins' team name, which actually began in 1932 as the Boston Braves, playing at Braves Field (where the professional baseball team played long before they moved first to Milwaukee and then to Atlanta) in Boston, Massachusetts); Pace, *supra* note 17, at 13 ("The team federally registered the 'Redskins' trademark in 1967, though the team actually began using the name 'Redskins' in 1933, in Boston, Massachusetts.") (footnote omitted); *See also* Reiner, *supra* note 3, at 6-7 (recounting briefly the history of the Redskins name-change and move from Boston to Washington, D.C.).

54. *See generally* Brown, *supra* note 16, at 126 ("In *Harjo*, the TTAB articulated a broad, liberal test for determining what constitutes a 'disparaging' trademark. The TTAB noted that the term 'disparage' as it appears in section 2(a) addresses an identifiable target such as a person or institution. Based on this premise, the TTAB concluded that a finding of whether a trademark was 'disparaging' would be determined by the views of the referenced group, rather than the general public. From this basis, the TTAB concluded that the trademarks challenged by *Harjo* and the other Native American petitioners were in fact disparaging, and therefore not capable of being registered under section 2(a).") (footnotes omitted); Wallace, *supra* note 5, at 347 (discussing the TTAB's analysis used to determine whether a mark is disparaging).

55. *See* Hughey, *supra* note 5, at 340 ("A mark is disparaging if it would 'dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison.' When evaluating disparagement, courts as well as the TTAB consider 'only the perceptions of those referred to, identified or implicated in some recognizable manner by the involved [trade]mark' which is to be evaluated as of the date of registration of the mark.") (footnotes omitted); *id.* at 347 ("In response to the second question, the TTAB found that 'the word "redskin," as it appears in respondent's marks in those registrations and as used in connection with the identified services, may disparage Native Americans, as perceived by a

courts have devoted a great deal of discussion to these issues. They have, for example, relied on dictionary definitions, surveys, and expert testimony trying to apply the statute to specific facts.⁵⁶

C. NCAA Position

Interestingly, “[c]ollege sports teams using Indian names was relatively rare prior to the 1920s.”⁵⁷ As the *Harjo* litigation reached its final stages,⁵⁸ the National Collegiate Athletic Association (NCAA) adopted a policy, prohibiting member institutions that used Native American names and imagery (deemed to be “hostile and abusive”) from participating in post-season play and hosting post-season tournaments.⁵⁹ “On August 5, 2005,

substantial composite of Native Americans.”); *see also* Dennie, *supra* note 3, at 204 (“Similarly, if a trademark is found to be disparaging, it will not be afforded federal protection. A trademark is disparaging if it would ‘dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison.’”) (citing *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1738 (T.T.A.B. 1999)).

56. *See* Ernst & Lumm, *supra* note 2, at 200 (quoting the test for disparagement as follows: “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 market place 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 substantial composite of the referenced group”).

57. Hylton, *supra* note 42, at 900.

58. The *Harjo* litigation was not finally put to rest until all appeals had been exhausted, which occurred when the U.S. Supreme Court denied certiorari. *Harjo v. Pro-Football, Inc.*, 558 U.S. 1025 (2009).

59. Finkelstein, *supra* note 3, at 315; *see also id.* at 303 (“[T]he NCAA set forth a detailed policy . . . for its member institutions that banned the use of ‘hostile and abusive racial/ethnic/national origin mascots, nicknames or imagery at any of the 88 NCAA championships,’ specifically targeting schools using Native American names, mascots and logos.”) (footnote omitted); *id.* at 316 (“Effective February 1, 2006, colleges and universities having such Native American mascots were to be prohibited from hosting any NCAA championships at their facilities.”); Hopkins & Joraanstad, *supra* note 4, at 270 (“In 2005, the National Collegiate Athletic Association (‘NCAA’) stated it would no longer allow the use of Native American mascots or nicknames in its postseason tournaments, simultaneously issuing a list of eighteen schools with ‘hostile or abusive’ mascots and nicknames.”). *See generally* Cummings, *supra* note 5, at 319 (“In 2005, the NCAA adopted a policy that prohibited member institutions from participating in NCAA-sanctioned postseason events if the institution maintained a mascot, moniker, nickname, or logo that was offensive to Native American citizens. In the policy announcement, the NCAA described its purpose: ‘The presidents and chancellors who serve on the NCAA Executive Committee have adopted a new policy to prohibit NCAA colleges and universities from displaying hostile and abusive

the NCAA formally announced the adoption of a policy forbidding its member institutions from employing 'hostile and abusive . . . mascots, nicknames or imagery' during NCAA championship play, specifically pertaining to Native American references."⁶⁰

Many NCAA member institutions took steps to change their mascots; others sought permission from the pertinent Native American group in order to take advantage of an appeal process that allowed schools to retain Native American mascots upon proof of adequate permission.⁶¹ The Florida State Seminoles and University of Utah Utes are probably the most well-known of those who received permission to keep their Native American names and imagery.⁶² The North Dakota Fighting Sioux and University of

racial/ethnic/national origin mascots, nicknames or imagery at any of the [eighty-eight] NCAA championships."') (footnotes omitted); Hylton, *supra* note 42, at 881 ("The National Collegiate Athletic Association (NCAA) entered the fray in 2005 by banning the use of Indian names and symbols by teams engaging in post-season play, unless teams using tribal names secured the permission of the tribe itself."); Wallace, *supra* note 5, at 210-12. For a discussion of Native American mascot names used by colleges and universities prior to 2005, see John B. Rhode, Comment, *The Mascot Name Change Controversy: A Lesson in Hypersensitivity*, 5 MARQ. SPORTS L.J. 141, 152-58 (1994-1995).

60. Finkelstein, *supra* note 3, at 315.

61. See, e.g., Cummings, *supra* note 5, at 327 ("The NCAA, after carefully considering and adopting its new policy prohibiting offensive or hostile imagery, took a decided step backward in allowing an appeals process giving university administrations that championed these derogatory and discriminatory American Indian images an opportunity to keep their hostile mascots. The NCAA made a determination that if member institutions could provide support for their continued use of American Indian mascots, then they would be removed from the postseason ban list and could continue with their hostile tradition unencumbered.") (footnotes omitted); Dennie, *supra* note 3, at 200 ("In sum, over the last thirty years more than six hundred high schools and colleges have changed their mascots and team names in response to heightened public scrutiny resulting from advocates' objections."); Finkelstein, *supra* note 3, at 316 ("Two weeks after the policy was announced, the NCAA Executive Committee approved an appeals process by which colleges and universities subject to the sanctions could challenge their individual status."); see also Nagel & Raschert, *supra* note 42, at 797 ("After many years of criticism of their name's potential inference to gun violence, the NBA's Washington Bullets changed their name to 'Wizards' in 1997."); *id.* ("Certainly, the altering of an offensive nickname, logo, or mascot offers the franchise an initial positive public relations platform on which to launch its new marketing efforts.") (footnote omitted); *id.* at 797-98 ("For the potential re-branding of a controversial name like the Washington Redskins, some fans have voiced their displeasure with the potential name change and have raised concern that their support for the team may wane if it yields to public pressure.").

62. See Cummings, *supra* note 5, at 327 ("Since its adoption of the 'one step forward, two steps back' policy, the NCAA has granted appeals to Florida State University and the

Illinois Fighting Illini were among those who went to great lengths in an effort to retain their Native American mascots.⁶³ The University of North Dakota relented and eventually retired its Fighting Sioux mascot in 2012.⁶⁴

D. Legal Principles Extended & Applied: Heeb, Khoran, & Redskins (Again!)

Two additional cases worthy of mention are *In re Heeb Media, LLC*⁶⁵ and *In re Lebanese Arak Corp.*⁶⁶ *In re Heeb* examined whether the word “Heeb” may disparage Jews, and *In re Lebanese Arak* considered whether “Khoran” may disparage Muslim beliefs. In both cases, the TTAB ruled that the marks could not be registered pursuant to § 2(a)’s “may disparage” prohibition. The word “Heeb” (for apparel) was denied registration because, as slang for “Hebrew,” it is a term considered offensive to Jews, and “Khoran” (for wine) was denied registration because those who follow the Muslim Islamic faith believe that consuming alcohol is sinful.⁶⁷

University of Utah, allowing both to keep their nicknames (Seminoles and Utes, respectively) and to keep their mascots, traditions, and mockery.”) (footnotes omitted); Wallace, *supra* note 5, at 206 (“Similar to their professional counterparts, . . . [colleges] also expose numerous people to discriminating depictions of Native Americans. For instance, the Florida State Seminoles use Chief Osceola, a man who rides out on horseback with war paint and a feather spear, as its mascot.”).

63. See Finkelstein, *supra* note 3, at 303-04; *id.* at 302 (“On one side of the disagreement stand those who believe that using the ‘Fighting Sioux’ name is an appropriate means of honoring one of the most powerful groups in the history of that part of the country. However, several other groups are adamantly opposed to the name, as well as the use of any other Native American names for athletic teams.”) (footnote omitted); Kelly P. O’Neil, Comment, *Sioux Unhappy: Challenging the NCAA’s Ban on Native American Imagery*, 42 TULSA L. REV. 171, 180-84 (2006). For additional discussion regarding the University of North Dakota and University of Illinois situations, see, for example, Cummings, *supra* note 5, at 329-32.

64. See, e.g., Grose, *supra* note 41, at 700 (“On September 9, 2010, however, [t]he North Dakota Board of Higher Education adopted a resolution directing UND officials to retire the Sioux nickname and logo.”). For additional discussion regarding the situation involving the University of North Dakota (and Marquette), see Nagel & Raschert, *supra* note 42, at 798-99.

65. 89 U.S.P.Q.2d (BNA) 1071 (T.T.A.B. 2008); see Ernst & Lumm, *supra* note 2, at 196-97 (discussing *In re Heeb Media, LLC*).

66. 94 U.S.P.Q.2d (BNA) 1215 (T.T.A.B. 2009); see Ernst & Lumm, *supra* note 2, at 198 (discussing *In re Lebanese Arak Corp.*).

67. *In re Heeb Media, LLC*, 89 U.S.P.Q.2d at 1071-72; *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d at 1221.

Admittedly, the word “Khoran” is the phonetic equivalent of the word “Koran,” the name of the holy book of Islam.⁶⁸

Amanda Blackhorse initiated the most recent litigation involving cancellation of the Washington Redskins trademarks on August 11, 2006.⁶⁹ On June 18, 2014, the TTAB, in a two-to-one decision, ordered cancellation of the Redskins’ marks, holding that they violated the “may disparage” prohibition of § 2(a).⁷⁰ Pro-Football, Inc., the owner of the Washington Redskins’ trademarks, filed an appeal, but on July 8, 2015, Judge Gerald Bruce Lee of the Eastern District of Virginia, on summary judgment, upheld the TTAB’s cancellations, ruling, among other things, that § 2(a) does not conflict with the First Amendment.⁷¹ Relying on *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*,⁷² Judge Lee held that the Principal Register of federal trademarks is “government speech” and therefore exempt from the First Amendment.⁷³

Meanwhile, the *Tam* litigation now appears to have jumped to the front of the line.⁷⁴ Simon Shiao Tam, the front-man for a musical group whose members are of Asian descent, applied for service mark registration for the name of their band, “The Slants.”⁷⁵ The PTO examining attorney refused

68. *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) at 1218, 1221.

69. *See Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 450 (E.D. Va. 2015).

70. *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d (BNA) 1080, 2014 WL 2757516, at *1, 7-8, 43 (T.T.A.B 2014); *see also Hopkins & Joraanstad*, *supra* note 4, at 283-84 (“The Blackhorse Litigation culminated in the TTAB’s cancellation of all six marks on the grounds that the term redskin(s), as used in connection with the goods and services offered under the marks, is disparaging to Native Americans.”).

71. *Blackhorse*, 112 F. Supp. 3d at 452; *see Hopkins & Joraanstad*, *supra* note 4, at 287 (“Soon after the TTAB issued its decision, Pro-Football filed suit in the federal District Court for the Eastern District of Virginia seeking to have the decision overturned.”); Ernst & Lumm, *supra* note 2, at 177 (“Ideally a Federal Court will address these hurdles in the inevitable appeal of the TTAB’s decision in *Blackhorse v. Pro-Football, Inc.*”).

72. 135 S. Ct. 2239 (2015).

73. *Blackhorse*, 112 F. Supp. 3d at 457. For a more detailed discussion of Judge Lee’s *Blackhorse* decision and *Walker*, *see infra* Section IV.C. Briefly stated, *Walker* involved the question of whether the Texas state government’s refusal to print license plates with a replica of the Confederate flag conflicted with the First Amendment. *See also Wallace*, *supra* note 5, at 207 (“[C]onfederate imagery has also been deemed discriminatory. School mascots with the images of “[t]he Confederate flag, the Rebel mascot, and other symbols associated with the antebellum South were successfully challenged in the 1970s during the implementation of court-ordered integration.”) (footnotes omitted).

74. For a more detailed examination of this case, *see infra* Parts III and V.

75. *In re Tam*, 785 F.3d 567, 568 (Fed. Cir. 2015).

registration based on the “may disparage” prohibition of § 2(a).⁷⁶ After Tam appealed to the TTAB, the TTAB affirmed the examining attorney’s decision to deny registration.⁷⁷ Tam then appealed to the CAFC, but the CAFC affirmed the TTAB and the examining attorney’s decision to deny registration on § 2(a) grounds.⁷⁸ Judge Kimberly Moore filed a separate document, entitled “Additional Views,” suggesting that the court ought to reconsider the issue of whether the “may disparage” prohibition of § 2(a) conflicts with the First Amendment.⁷⁹ On April 27, 2015, the CAFC vacated its opinion and asked the parties to brief the First Amendment issue in preparation for a hearing en banc.⁸⁰ Oral argument took place October 2, 2015,⁸¹ and the court issued its decision December 22, 2015, holding the “may disparage” prohibition of § 2(a) unconstitutional.⁸² On April 20, 2016, the USPTO filed a petition for a writ of certiorari to the United States Supreme Court.⁸³ Given the importance of the decision as a First Amendment precedent, chances are high that the Supreme Court will grant certiorari to resolve the question of whether the “may disparage” prohibition of § 2(a) violates the First Amendment.

II. Scholarship Summary

A. Overview

Scholars, commentators, and pundits have written a great deal about the “may disparage” prohibition of § 2(a). The majority of scholarship has

76. Although not unprecedented, it is atypical for the applicant to be a member of the group of persons whom the trademark examining attorney thinks may experience disparagement. *See, e.g., Kiser, supra* note 3, at 10 (“This refusal to register the mark is somewhat unusual in the history of section 2(a) decisions, given that the applicants are members of the group that is allegedly disparaged by the mark: lesbians who have reappropriated the mark as a symbol of pride and rebellion in connection with their motorcycle and entertainment services marketed towards fellow women.”).

77. *In re Tam*, 108 U.S.P.Q.2d (BNA) 1305 (T.T.A.B. 2013).

78. *Tam*, 785 F.3d at 568-69.

79. *See id.* at 573-85 (Moore, J., “additional views”).

80. *In re Tam*, 600 F. App’x 775 (Fed. Cir. 2015) (en banc).

81. *Id.* (order setting oral argument) (“Oral argument en banc for this appeal is scheduled for October 2, 2015 at 10:00 a.m. in courtroom 201. This appeal will have 30 minutes per side for a total argument time of one hour. The parties shall notify the court by ECF filing by September 2, 2015 of the names of the counsel who will present oral argument.”).

82. *In re Tam*, 808 F.3d 1321, 1329, 1358 (Fed. Cir. 2015).

83. Petition for a Writ of Certiorari, *Tam*, No. 15-1293 (Apr. 20, 2016).

appeared subsequent to the onset of the *Harjo* litigation. A few commentators have squarely addressed the First Amendment issue.⁸⁴ Most appear to recognize the First Amendment potentially poses a serious threat to the vitality of § 2(a).⁸⁵ Curiously, some seem to dismiss it as if it were some type of straw man.⁸⁶ Much of the scholarship, however, has not aimed directly at the First Amendment issue but instead has focused on the propriety (or lack thereof) of using Native American names and imagery as trademarks.⁸⁷ Most writers have taken sides and have voiced strong

84. See, e.g., Pace, *supra* note 17; Smith, *supra* note 21, at 451; Lefstin, *supra* note 44, at 668-71.

85. See, e.g., Smith, *supra* note 21, at 452 (“[T]he Lanham Act’s prohibition on scandalous and disparaging marks is a troubling exception to our First Amendment civil liberties.”).

86. See, e.g., Grose, *supra* note 41, at 722-24 (discussing the potential application of the First Amendment to § 2(a) but not appearing to grasp a number of the subtleties of the doctrine and relevant Supreme Court jurisprudence). One article has dismissed the notion that a federal court of appeals will find that the “may disparage” prohibition of § 2(a) violates the First Amendment. See Ernst & Lumm, *supra* note 2, at 189 n.77 (“Without going into an in-depth constitutional analysis which would be beyond the scope of this article, it appears a court would likely reject both of Pro-Football’s constitutional claims. Pro-Football’s first constitutional claim was that its First Amendment free speech rights would be violated if its trademarks were cancelled. However, under Federal Circuit precedent, the cancellation of a mark does not contravene a party’s First Amendment free speech rights.”) (citations omitted).

87. See, e.g., Cummings, *supra* note 6, at 312 (“To some, American Indian mascots represent strength, power, reverence, and dignity. For others, Native American mascots are deeply offensive and mock ancient and sacred culture. Historically, professional and collegiate athletic teams have unabashedly sported American Indian mascots and monikers, and it has not been until recent decades that this issue has arisen as offensive or insensitive.”) (footnotes omitted). The visual images used have not been the center of attention. In its second *Harjo* opinion, the TTAB held that the imagery was not disparaging. *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1743 (T.T.A.B. 1999). Nevertheless, a number of commentators have noted the offensive nature of the Cleveland Indians’ “Chief Wahoo” imagery. See, e.g., Ernst & Lumm, *supra* note 2, at 206 (“The most notorious mascot still in use, with registered live trademarks, is the Cleveland Indians’ Chief Wahoo. Activists have referred to Chief Wahoo as ‘the most offensive racial icon in the country.’ The Cleveland Indians’ use of Chief Wahoo, ‘a grinning Indian face caricature with a feather and bright red face,’ was challenged in court in 1972 under a theory of group libel, but was settled out of court.”) (footnotes omitted); Finkelstein, *supra* note 3, at 325 (“[T]he animated ‘Chief Wahoo’ logo employed by the Cleveland Indians . . . has drawn criticism for being derogatory”); Reiner, *supra* note 3, at 8 (“Chief Wahoo is seen as a grinning, buffoonish abomination and the negative image the character projects is the reason Native Americans object to its use.”); see also Cummings, *supra* note 5, at 333 (“In Cleveland, the logo of ‘Chief Wahoo’ adorns baseball caps and almost all team memorabilia. The Chief is a

opinions.⁸⁸ But some scholarship has been relatively neutral; these writers apparently have attempted to refrain from taking sides, striving for objectivity, weighing the pros and cons of both sides of the debate in a neutral fashion.⁸⁹

B. Anti-Use of Native American Names & Imagery

Of those who have taken sides, many have expressed support for the *Harjo* and *Blackhorse* plaintiffs, and have lashed out in an angry and frustrated fashion, pillorying those who have, in their opinion, disrespected Native Americans in a most unseemly manner by continuing to use Native American names and imagery as trademarks for their sports teams.⁹⁰ Like

dark red, cartoonish caricature of an American Indian smiling broadly (the smile takes up more than one-third of the cartoon face) and wears a feather in the back of its head.”); Jack Achiezer Guggenheim, *The Indians' Chief Problem: Chief Wahoo as State Sponsored Discrimination and a Disparaging Mark*, 46 CLEV. ST. L. REV. 211 (1998); Hughey, *supra* note 5, at 361 (describing the depiction of Chief Wahoo and suggesting that it is “ripe for cancellation”); *id.* at 348 (2004) (“The TTAB found no support in the record—and, thus, rejected—the proposition that the use of Native American references or imagery by non-Native Americans was *per se* disparaging to Native Americans or that such use in connection with football was *per se* disparaging. Therefore, although the TTAB held that the trademark should be cancelled, it did not rule that the use of Native American names and images was *per se* disparaging to Native Americans.”) (footnotes omitted); Hylton, *supra* note 42, at 898 (“[T]he first version of the infamous Chief Wahoo logo did not appear until 1946. It [*i.e.*, the Cleveland baseball team] also did not print the name Indians on its uniforms until after World War II.”); Rhode, *supra* note 59 (noting that President Clinton decided not to wear a hat with Chief Wahoo at a game where he threw out the ceremonial first pitch on Opening Day of the 1994 MLB season); *see also* Hughey, *supra* note 5, at 360 (“The TTAB in *Harjo* found that the challenged drawings were not disparaging, but those marks were described as simple, benign profiles of Native Americans.”). For additional discussion regarding the Cleveland Indians’ Chief Wahoo logo, see Dennie, *supra* note 3, at 214-15.

88. One commentator has called for a complete change in the burdens placed on trademark applicants. *See* Kiser, *supra* note 3, at 29-36 (recommending that the burden be placed on an applicant to prove that the mark is *not* disparaging). This argument, however, completely ignores the importance of First Amendment doctrine in the “public interest” debate.

89. *See, e.g.*, Hylton, *supra* note 42; Ward & Quick, *supra* note 26.

90. *See, e.g.*, Wallace, *supra* note 5, at 204 (“The pervasive use of the Native American likeness as spectacle in sport can be very damaging and should be addressed by both the legal community and public opinion in general.”). One commentator decries the performance of a white college student clad in American Indian dress at sporting events. *See* Cummings, *supra* note 5, at 311 (“He will spend the next four to six hours desecrating, mimicking, and debasing an entire tribe of American Indians and, by association, an entire race of

the *Harjo* and *Blackhorse* plaintiffs, these writers emphasize the offensive nature⁹¹ of the marks and the negative emotional and psychological damage that Native Americans suffer as a result of the hatred and ridicule that they perceive to be caused by such trademarks.⁹² The complaints about these alleged negative consequences appear sincere and genuine.⁹³

C. Pro-Use of Native American Names & Imagery

But others frame the debate differently. The opposing viewpoint supports the use of Native American team names and logos, contending that the names and images honor the traditions and the positive spirit and characteristics of American Indian culture.⁹⁴ The Redskins ownership has

Americans.”); *id.* at 314 (“The mascot that dresses up like an Indian chief is mocking sacred rituals, mimicking hallowed traditions, and caricaturizing a proud race in debilitating ways.”). Yet presumably in other circumstances, Native American ceremonial dances and exhibitions are considered honorific theatre. *See also* Grose, *supra* note 41.

91. Interestingly, the Supreme Court invalidated, on First Amendment grounds, a Texas statute regarding flag desecration in circumstances where “the actor knows [his actions] will seriously offend one or more persons” *Texas v. Johnson*, 491 U.S. 397, 400 n.1 (1989).

92. *See, e.g.*, Grose, *supra* note 41, at 696 (“There is mounting evidence, however, to suggest that these types of names have detrimental effects on the well-being and self-esteem of Native American children.”); *id.* at 701 (“But in light of recent studies documenting the harmful psychological effects of the continued use of such team names, it is difficult to make the argument that Native Americans are unharmed.”). For example, testimony from the *Harjo* litigation alleged: “the use of Native American stereotypes has a negative effect on the self-esteem of Native American children” and that “the use of stereotyping objectifies and dehumanizes the individual.” *Id.* at 705-06 (internal quotation marks omitted); *see also* Wallace, *supra* note 5, at 209 (“The continued and pervasive use of Native American images and likenesses is a ‘painful legac[y] of an era in advertising that relied on the use of racial or ethnic minorities as the basis for logos, without much attention to the psychological harms such logos can cause.’”) (citation omitted). *See generally* Ernst & Lumm, *supra* note 2.

93. *See, e.g.*, Grose, *supra* note 41, at 710-22 (discussing the negative emotional effects of the use of Native American names and mascots by sports teams).

94. *See, e.g.*, Brown, *supra* note 16, at 119 (“Supporters for the use of the names argue that, by doing so, they are ‘honoring’ Native American culture and therefore are not demeaning the culture.”) (citing Nell Jessup Newton, *Memory and Misrepresentation: Representing Crazy Horse*, 27 CONN. L. REV. 1003, 1013 (1995)); *id.* at 119 (“Rather, they suggest that these names reflect positive attributes of Native Americans such as dedication, courage, and pride.”) (citing Richard Justice, *Washington Redskins*, SPORTING NEWS, Mar. 30, 1992, at 29); Cummings, *supra* note 5, at 316-17 (“Still, those that support the continued use of hostile American Indian imagery have hunkered down, believing that they are resisting the political correctness movement and are in fact supporting tradition and honoring native peoples.”); Dennie, *supra* note 3, at 213-14 (“Professional and college sports teams typically adopted Native American names and symbols, not to offend, but rather, to emulate

advanced this argument for decades.⁹⁵ One commentator posits this position in a rather matter-of-fact manner, claiming that “many professional sports teams such as baseball's Cleveland ‘Indians’ and football's Washington ‘Redskins’ have decided to honor American history through the use of Native American references in their names and logos.”⁹⁶ Similarly, another commentator states that “the vast majority of Native American-based names and symbols are not offensive and, indeed, carry positive connotations of Native American culture.”⁹⁷ Yet another remarks that

the historic bravery and athleticism of Native American culture. These teams want to be respected and admired. Arguably, team owners, university presidents, and school boards choose Native American mascots and team names to promote ‘courage, strength, boldness, and resourcefulness.’ Thus, teams honor Native Americans because teams often associate Native Americans with qualities and virtues to which they aspire. Furthermore, sport has a close connection to war and the field of battle. The virtues embodied in Native American culture, such as resourcefulness and calculated precision, are traits necessary to build a champion on the field of battle and the athletic field. This correlation honors the battles and struggles Native Americans have faced throughout history.” (footnotes omitted); Ernst & Lumm, *supra* note 2, at 203 (“Further complicating the social policy issues underlying the question of racial-group disparagement is the argument that the use of American Indian imagery is not intended to be denigrating, but rather to be a representation of honor and tradition, both of the team and the tribe.”); Hylton, *supra* note 42, at 902 (“Although the general treatment of Native Americans by the mainstream American culture throughout history was patronizing, insensitive, and immoral at times, the early use of Native American team names does not, in the context of sports team names, appear to have been particularly disparaging. Teams were named after Native Americans as patriotic gestures, as geographic identifiers, and occasionally as humorous references, but almost never with the intention of insulting or making fun of Native Americans specifically.”); Reiner, *supra* note 3, at 2-3 (“Ironically, driving the passion of many owners and sports’ fans to retain Native American names in sports is the perceived notion that the use of Native American names connotes honor and respect, thereby precluding any argument that there is any intent to injure or harm.”).

95. See, e.g., Pace, *supra* note 17, at 15 (quoting former Redskins owner Jack Kent Cook: “I admire the Redskins name. I think it stands for bravery, courage and a stalwart spirit, and I see no reason why we shouldn't continue to use it.”) (citation omitted).

96. Finkelstein, *supra* note 3, at 306 (footnotes omitted); see also *id.* at 333 (“[T]eams and schools, such as UND, appear to use such Native American references as a means of honoring the true founders of our nation. ‘If Americans didn't hold Indians in high regard, tribal names wouldn't find their way onto all kinds of consumer products, such as the Jeep Cherokee and the Dodge Dakota. . . . The Army wouldn't name their helicopters after tribes: the Apache Longbow . . . and the Blackhawk.’”) (footnote omitted). Also consider the “Red Man” brand of chewing tobacco.

97. Dennie, *supra* note 3, at 220. See also *id.* (“In most cases, these teams do little to discriminate against minority groups and have nothing but the best intentions in regards to Native American names, chants, and traditions.”).

“[p]eople don't name teams after things they hate. A team name is designed to project certain qualities fans and athletes can admire and emulate, whether it's toughness, ferocity, or regional pride.”⁹⁸

And, historically speaking, it appears as though the positive qualities associated with Native Americans are precisely what both college and professional teams typically had in mind when they adopted American Indian team names, mascots, and imagery. Professor Hylton explains:

In the 1910s and 1920s, professional and college teams began to formally adopt Native American team names . . . because of a growing association in the public mind between Native Americans and success in athletics, particularly baseball, football, and track and field. Thanks to the accomplishments of individual athletes like Jim Thorpe, Chief Meyers, and Chief Bender and of teams like the Carlisle and Haskell Indian Schools, the independent Nebraska Indians baseball team, and the Orang Indians of the NFL, a new association developed between Indians and athletic proficiency. With such a perception embraced, names referred [to] Native Americans' acquired skills in American team sports rather than [to] supposedly savage qualities.⁹⁹

The original Major League Baseball “Braves,” for example, intended to honor American Indians’ positive attributes. “The first major league baseball team to intentionally adopt a Native American team name was the Boston National League team in 1912, and in doing so, it made clear reference to the idea that Indians had special athletic skills.”¹⁰⁰ And when

98. John J. Miller, *Fighting Sue: The Unsavory War Against Indian Symbols*, 1 VA. SPORTS & ENT. L.J. 291, 291 (2002).

99. Hylton, *supra* note 42, at 890-91; *see also id.* at 896 (“Until the first decade of the twentieth century, the attachment of a Native American name to a baseball club was usually intended to emphasize the ‘American’ nature of the game of baseball. Having such a name was more likely to occur in the Eastern United States where Native Americans were treated as a historical phenomenon or an abstraction. Use of a Native American name also provided a humorous alternative to simply referring to a team by its city name. The choice of names does not appear to have had any particular reference to the athletic prowess of Native Americans; that is, until the first decade of the twentieth century.”).

100. *Id.* at 896-97; *see also id.* at 897 (“Ward's [(co-owner of the team)] decision appears to have been influenced by a number of factors. His co-owner, James Gaffney, was a member of New York City's Democratic Tammany Hall political machine, whose operatives were known jokingly as ‘braves.’ Moreover, the name ‘Braves’ resonated with Boston's

the Major League Baseball team in Cleveland changed its name to “Indians,” it did so “in honor of Louis Sockalexis, the first Native American to play professional baseball, who was regarded as ‘a marvel’ by his teammates and coaches. Therefore, the ‘Indians’ name was adopted in honor of a former star player associated with the Cleveland franchise.”¹⁰¹

Many who support the use of Native American trademarks warn that using the “may disparage” prohibition of § 2(a) to combat Native American names and imagery as trademarks is a cop-out, merely acquiescing to the hypersensitivity of contemporary society’s willingness to give in to political correctness.¹⁰² One commentator has soberly warned that “[t]he United States has transformed into a society filled with affirmative action and political correctness, due in part to the Civil Rights movement of the mid to late-twentieth century.”¹⁰³ Perhaps facetiously, others have noted that Christians have not yet challenged the Los Angeles Angels, the New Orleans Saints, the Arizona State Sun Devils, nor the Duke Blue Devils.¹⁰⁴

history of pretend ‘braves’ who threw the British tea overboard during the Boston Tea Party. In addition, the term ‘Boston Braves’ had earlier been attached to the Honorable Artillery Company, an honorary military unit based in Boston. Although it traced its origins back to 1638, the Honorable Artillery Company’s function by the end of the nineteenth century was entirely ceremonial, and its ranks were drawn from the city’s social elite.”).

101. Dennie, *supra* note 3, at 214 (footnote omitted).

102. *See, e.g.,* Smith, *supra* note 21, at 456 (“The Lanham Act effectively allows small special interest groups to curtail others’ speech, raising the risk that trademarks are governed by political correctness rather than free speech values. For example, a conservative Christian group may have standing against a pro-gay rights trademark.”); *see also* Grose, *supra* note 41, at 701 (acknowledging the argument: “The team owners and fans assert that there is a tradition behind the team names and mascots. They believe that the movement to change the team names is simply the product of a progressive and ‘politically correct’ modern society.”); Rhode, *supra* note 59, at 159.

103. Reiner, *supra* note 3, at 3.

104. *See* Dennie, *supra* note 3, at 201 (“In addition, traditionalists point to hypersensitivity among some Native Americans as the real source of this controversy. Traditionalists note that other sports teams use potentially controversial team names but that the propriety of those names is not seriously debated or challenged. For instance, although the Los Angeles Angels of Anaheim and the New Orleans Saints could potentially offend non-Christians, they have not evoked controversy. Similarly, the Arizona State Sun Devils and the Duke Blue Devils could be offensive to Christians, but have not been the target of opposition.”) (footnotes omitted); Rhode, *supra* note 59, at 142 (“Furthermore, do names like the California Angels and the New Orleans Saints offend non-Christians? What about the Arizona State Sun Devils and the Duke Blue Devils—do they offend Christians?”) (footnote omitted). It is also possible to extend this concern to even further extremes, to team names such as the San Diego Padres, Pittsburgh Steelers, Dallas Cowboys, Green Bay

III. *In re Tam* (“*Slants*” case)

A. Introduction

Simon Tam first applied for federal trademark registration for his musical group THE SLANTS in 2010.¹⁰⁵ After the examining attorney refused registration on grounds that the mark was disparaging to people of Asian descent, Tam abandoned that application, but then filed a second application on November 14, 2011.¹⁰⁶ “The examining attorney again found the mark THE SLANTS disparaging and declined to register it.”¹⁰⁷ In September 2013, the TTAB affirmed the examining attorney’s refusal.¹⁰⁸ And on April 20, 2015, the CAFC affirmed the TTAB’s decision.¹⁰⁹ But only a week later, on April 27, 2015, the CAFC vacated that decision and ordered a rehearing *en banc*.¹¹⁰ The court asked the parties to address one isolated issue on appeal: “Does the bar on registration of disparaging marks in 15 U.S.C. § 1052(a) violate the First Amendment?”¹¹¹ Because Part IV will consider First Amendment doctrine in greater detail, the summaries here in Part III will merely outline the discussions and arguments of the CAFC (both the April 22, 2015 opinion as well as the *en banc* decision of December 22, 2015), and Judge Moore’s “Additional Views.”

B. CAFC Decision (April 20, 2015)

Judge Moore’s opinion affirmed the TTAB’s decision, which in turn had affirmed the examining attorney’s refusal of registration on the basis of the “may disparage” prohibition of § 2(a).¹¹² The decision noted that a disparaging mark “dishonors by comparison with what is inferior, slights, deprecates, degrades, or affects or injures by unjust comparison.”¹¹³ Judge Moore acknowledged that one meaning of “slants” was a reference to

Packers, and the hundreds of schools which use “Rebels” as a mascot. Additionally, a number of business use the word “Dixie” as part of their trademarks.

105. *In re Tam*, 785 F.3d 567, 568 (Fed. Cir. 2015).

106. *Id.*

107. *Id.*

108. *Id.* at 568-69; *see also In re Tam*, 108 U.S.P.Q.2d (BNA) 1305 (T.T.A.B. 2013).

109. *Tam*, 785 F.3d at 573.

110. *In re Tam*, 600 F. App’x 775, 775 (Fed. Cir. 2015).

111. *Id.*

112. *Tam*, 785 F.3d at 569.

113. *Id.* (citing *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014)) (alterations omitted).

persons of Asian descent,¹¹⁴ and also that the term is a racial slur.¹¹⁵ The opinion agreed that the TTAB was correct in holding that a substantial composite of persons of Asian descent would find the mark “The Slants” disparaging.¹¹⁶ Regarding Tam’s argument that § 2(a) conflicts with the First Amendment, Judge Moore quoted *In re McGinley* and conceded that the CAFC is constrained to follow the precedent of *McGinley*:

With respect to appellant’s First Amendment rights, it is clear that the PTO’s refusal to register appellant’s mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant’s First Amendment rights would not be abridged by the refusal to register his mark.¹¹⁷

The opinion concluded by briefly addressing—but dismissing—Tam’s arguments that the statute was void due to vagueness, that his due process rights have had been abridged, and that it robbed him of equal protection.¹¹⁸

114. *Id.* at 570 (“There is no dispute that the term ‘slants’ has a number of meanings, one of which refers to people of Asian descent.”).

115. *Id.* (“The record also contains the band’s entry in Wikipedia, which states that the band’s name is ‘derived from an ethnic slur for Asians.’”) (citation omitted).

116. *Id.* at 571 (“Substantial evidence supports the Board’s finding that the mark THE SLANTS is likely offensive to a substantial composite of people of Asian descent.”); *Id.* (“Additionally, the record includes a brochure published by the Japanese American Citizens League describing the term ‘slant,’ when used to refer to people of Asian descent, as a ‘derogatory term’ that is ‘demeaning’ and ‘cripple[s] the spirit.’”).

117. *Id.* at 572 (citing *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981)); *see also* Brown, *supra* note 16, at 122 (“In *In re McGinley*, the United States Court of Customs and Patent Appeals asserted that section 2(a) was not ‘an attempt to legislate morality, but, rather, a judgment . . . that such [trademarks] not occupy the time, services, and use of funds of the government.’”) (quoting *McGinley*, 660 F.2d at 486); Pace, *supra* note 17, at 36 (“Only one court has addressed the constitutionality of section 2(a), and it concluded, without any analysis, that First Amendment rights were not at issue because the trademark owner was not denied the right to use the mark, but merely denied the benefits afforded by federal registration.”) (citing *McGinley*, 660 F.2d at 484). For further discussion of *McGinley*, *see* Smith, *supra* note 21, at 454 (“[S]ome have proposed that the government should not expend funds to register trademarks that are scandalous or disparaging to the public.”) (citing 1 JEROME GILSON, TRADEMARK PROTECTION AND PRACTICE § 3.04(4) (6th ed. 1980)); *id.* (“Yet, as a dissent from a registration denial noted, ‘more “public funds” are being expended in the prosecution of this appeal than would ever result from the registration of the mark.’”) (citing *McGinley*, 660 F.2d at 487); Lefstin, *supra* note 44, at 676-77.

118. *Tam*, 785 F.3d at 572-73.

C. Judge Moore's "Additional Views"

Once she took care of her obligation of writing the court's opinion, Judge Moore added her "Additional Views."¹¹⁹ She forthrightly asserted, "It is time for this Court to revisit *McGinley*'s holding on the constitutionality of § 2(a) of the Lanham Act."¹²⁰ She noted that the *McGinley* court's dismissal of the First Amendment challenge to § 2(a) failed to cite "any legal authority," and that it was cursory at best.¹²¹

More than thirty years have passed since *McGinley*, and in that time both the *McGinley* decision and our reliance on it have been widely criticized. Furthermore, First Amendment jurisprudence on the "unconstitutional conditions" doctrine and the protection accorded to commercial speech has evolved significantly since the *McGinley* decision.¹²²

She explained that trademarks and trade names are a kind of commercial speech and emphasized that even the government has conceded that point.¹²³ The discussion continued with more about *McGinley* and enumerated the benefits that federal registration provides to trademark owners.¹²⁴ Judge Moore next explained the "unconstitutional conditions" doctrine and why she believed that it applies to § 2(a),¹²⁵ concluding, "[t]he government cannot hinge the benefits of federal trademark registration on constitutionally protected speech—here, the applicant's selection of a suitable mark—unless the government's actions pass constitutional scrutiny."¹²⁶

She then moved forward, reasoning that the "may disparage" prohibition of § 2(a) constitutes both an impermissible content-based and viewpoint-

119. *Id.* at 573 (Moore, J., "additional views"). This document, strictly speaking, is neither a concurrence nor a dissent. Much of the argument appears to be drawn from her 1994 law review article, Pace, *supra* note 17, at 15-16.

120. *Tam*, 785 F.3d at 573 (Moore, J., "additional views").

121. *Id.* at 573 ("In *In re McGinley*, our predecessor court held without citation to any legal authority in just a few sentences that § 2(a) does not implicate the First Amendment . . .").

122. *Id.* at 573-74 (footnote omitted).

123. *Id.* at 575 ("Indeed, the government has conceded that '[t]rademarks are a form of commercial speech.' Because a trademark identifies the source of a product or service for users, it is protected commercial speech.") (citation omitted).

124. *Id.* at 575-77.

125. *Id.* at 577-81.

126. *Id.* at 581.

based brand of discrimination regarding freedom of speech.¹²⁷ The discussion turned next to an analysis of trademarks as commercial speech. As commercial speech, any statutory restrictions on trademarks are subject to the Supreme Court's test developed in *Central Hudson Gas & Electric Corporation v. Public Service Commission*.¹²⁸ One particular Achilles' heel stressed by Judge Moore is that one prong of the *Central Hudson* test asks whether the government's interest in imposing a restriction on speech is "substantial."¹²⁹ She argued, however,

The government has not put forth any substantial interests that would justify § 2(a)'s bar against disparaging marks. One purpose of the disparagement provision of § 2(a) is evident on its face, and it is message-based: to discourage the use of trademarks that are disparaging to persons, institutions, beliefs, or national symbols. The legislative history reinforces the conclusion that Congress enacted § 2(a) because it disapproved of the message conveyed by disparaging marks.¹³⁰

Citing Supreme Court precedents, the argument explained that suppressing speech that some people may deem offensive is not even a *legitimate* government objective, much less a *substantial* one.¹³¹

Anticipating the argument made by Judge Gerald Lee in *Blackhorse*,¹³² Judge Moore contended that trademarks are decidedly *private* speech—not

127. *Id.* at 581-82.

128. *Id.* at 582-85 (citing *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 566 (1980)).

129. *Id.* at 582.

130. *Id.* at 582-83 ("See Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the House Comm. on Patents, 76th Cong., 1st Sess. 18-21 (1939) (statement of Rep. Thomas E. Robertson) (Rep. Maroney) ('[W]e would not want to have Abraham Lincoln gin.'). This is plainly true of the reason for denying registration here, as in other disparagement cases."). Of course, today we have Samuel Adams Lager.

131. *Id.* at 583 ("While the government may argue that it has an interest in discouraging the use of disparaging marks that may be offensive to persons, institutions, beliefs, or national symbols, this is not a legitimate government interest. See *Sorrell*, 131 S.Ct. at 2670. The Supreme Court has 'consistently held that the fact that protected speech may be offensive to some does not justify its suppression.' *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 71, 103 S.Ct. 2875, 77 L.Ed.2d 469 (1983). It is a 'bedrock principle underlying the First Amendment . . . that the Government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.' *United States v. Eichman*, 496 U.S. 310, 319, 110 S.Ct. 2404, 110 L.Ed.2d 287 (1990).").

government speech—and therefore are subject to the principles of the First Amendment.¹³³ She noted that “[a]lthough the government publishes registered trademarks in the Trademark Principal Register, it does so not to communicate a particular message or select a particular viewpoint; rather, it publishes trademarks to provide notice that a mark has been registered.”¹³⁴

She concluded her remarks by reemphasizing her commercial speech analysis and also by punctuating the importance of reconsidering *McGinley*, taking into account the context of both contemporary First Amendment jurisprudence and contemporary practices in the PTO.

We have yet to be presented with any substantial government interests that would justify the PTO’s refusal to register disparaging marks. Without this, § 2(a) cannot satisfy the *Central Hudson* test. It is time to revisit the holding in *McGinley* in light of subsequent developments in the law and the trademark registration funding regime.¹³⁵

As was mentioned, on April 27, 2015, the CAFC vacated its April 20 opinion and decided *sua sponte* to rehear the case en banc with all active members of the court.¹³⁶

D. Summary of Brief on Behalf of Appellant for En Banc Hearing (June 11, 2015)

Tam’s brief stressed two points: (1) because trademarks are commercial speech, they are entitled to First Amendment protection; and (2) the “may disparage” prohibition of § 2(a) conflicts with the First Amendment both on

132. *Pro Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 457 (E.D. Va. 2015) (“[T]he federal trademark registration program is government speech and is thus exempt from First Amendment scrutiny.”). *See also infra* Section IV.C.

133. *Tam*, 785 F.3d at 584.

134. *Id.*; *see also id.* at 585 (“The trademark is printed on private property, in fact commercial goods, not on any government property. The purpose served by trademarks, to identify the source of the goods, is antithetical to the notion that the trademark is tied to the government.”).

135. *Id.* at 585.

136. Order Granting Sua Sponte Hearing En Banc, *Tam*, No. 14-1203 (Fed. Cir. Apr. 27, 2015) (“The panel opinion of April 20, 2015 is vacated, and the appeal is reinstated.”); *id.* at 2 (“The parties are requested to file new briefs. The briefs should address the following issue: Does the bar on registration of disparaging marks in 15 U.S.C. § 1052(a) violate the First Amendment?”).

its face and as applied.¹³⁷ As an initial matter, the brief pointed out the key functions of the Lanham Act: “The purposes of the Act are to protect a trademark holder’s right to benefit from its own goodwill; to protect established marks from appropriation; and to protect the consuming public from confusing, misleading, or false and deceptive marks which create a misimpression between a product and its source.”¹³⁸ In simple terms, Tam’s point is, “Section 2(a) of the Act serves no commercial purpose advanced by trademark registration.”¹³⁹ Tam also articulated the many benefits derived from trademark registration and explained that these advantages are superior to the ownership privileges of unregistered marks.¹⁴⁰ Tam noted the curious place that § 2(a) occupies in the statute relative to the other subsections of § 2 and observed that it was a late addition to the federal statutory scheme.¹⁴¹ Tam contrasted § 2(a) with other subsections of § 2—(b)(c)(d) and (e)—in order to point out its anomalous effect and to explain why it is an outlier, unrelated to the key goals of trademark law and policy.¹⁴² “Indeed, the PTO’s role as a referee of political correctness concerning ethnic and racial discourse has nothing to do with advancing the commercial purposes of trademark registration established under the Act.”¹⁴³ Tam concluded this portion of the brief, stating:

The §2(a) prohibition of disparaging marks is an aberration which does not serve the commercial purposes of trademark law, the free and accurate flow of commercial speech, or any other legitimate government interest. Instead, §2(a) mandates that the

137. Brief On Behalf of Appellant For *En Banc* Hearing at 6, *In re Tam*, 785 F.3d 567 (Fed. Cir. 2015) (No. 14-1203) (“The bar on registration of disparaging marks in §2(a) of the Act violates the First Amendment. . . . Trademarks are a form of commercial speech, protected under the First Amendment.”); *id.* at 6-7 (arguing that § 2(a) is a “content-based regulation of speech” and that it is “content-based” on its face and “viewpoint-discriminatory as applied” to Tam.).

138. *Id.* at 6.

139. *Id.* at 8.

140. *Id.* at 9-10.

141. *Id.* at 12 (“The bar on registering disparaging marks did not exist prior to the 1946 codification of U.S. trademark law. See *Trade-Mark Cases*, 100 U.S. at 94 (noting that exclusive right to use [a] mark was ‘simply founded on priority of appropriation. We look in vain in the statute for any other qualification or condition’). Under the earlier federal trademark statutes and common law, the PTO registered, and courts enforced, arguably disparaging marks.”).

142. *Id.* at 11.

143. *Id.* at 13.

PTO make content-based moral judgments to exclude truthful, non-confusing marks and is at odds with the purposes of the Act.¹⁴⁴

The brief then shifted to the topic of commercial speech.¹⁴⁵ This section of the brief began by citing *Friedman v. Rodgers*¹⁴⁶ for the proposition that trade names are a kind of commercial speech,¹⁴⁷ and that, when the government denies benefits based on expression, that denial of benefits conflicts with the First Amendment.¹⁴⁸ According to Tam, “Given that trademarks are commercial speech, the PTO’s assessment of the expressive meaning of a mark as disparaging or not under §2(a) is an impermissible regulation of speech by the government.”¹⁴⁹

The brief next identified weaknesses in the court’s reasoning in *McGinley*.¹⁵⁰ One particular problem is that the *McGinley* court, and others since, had very little substance on which to rely when speculating about the congressional intent of § 2(a).¹⁵¹ Tam argued that “[t]he rationale of *McGinley* fails to account adequately for the chilling effect on the free expression of commercial speech caused by the burden § 2(a) imposes on an owner’s ability to benefit from the substantive and procedural rights attendant to registration.”¹⁵²

Tam then tied his discussion of *McGinley* to an explanation of why he believes that § 2(a) imposes an “unconstitutional condition” on trademark applicants.¹⁵³ The unconstitutional conditions doctrine, in turn, is closely related to Congress’s authority pursuant to the Spending Clause of Article I, § 8, clause 1 of the Constitution. Quoting precedent, Tam explained, under the Spending Clause, “Congress has the power both to allocate funds for public purposes as well as ‘an ancillary power to ensure that those funds are properly applied to the prescribed use.’”¹⁵⁴ Summarizing the relevant Spending Clause principles derived from case law, Tam reasoned “the

144. *Id.* at 14.

145. *Id.* at 14-16; *id.* at 14 (“[C]ommercial speech, like other varieties, is protected.”).

146. 440 U.S. 1 (1979).

147. Brief on Behalf of Appellant for *En Banc* Hearing, *supra* note 137, at 15.

148. *Id.* at 15-16.

149. *Id.* at 16.

150. *Id.* at 17-20.

151. *Id.* at 16-17.

152. *Id.* at 18.

153. *Id.* at 20-23.

154. *Id.* at 19 (quoting *Rust v. Sullivan*, 500 U.S. 173, 145 n.4 (1991)).

constitutionality of a regulation turns on whether the receipt of governmental benefits pursuant to that regulation is conditioned on requirements imposed within or without the limits of the government program itself.”¹⁵⁵ Tam then concluded, therefore, that § 2(a) runs afoul of the First Amendment because it “penalizes the mark-holder for no reason other than official disapproval of what, in an agency’s judgment, that mark ‘may’ mean.”¹⁵⁶

Tam then devoted considerable attention to the argument that strict scrutiny should apply.¹⁵⁷ Strict scrutiny (i.e., the requirement that, in order to be deemed constitutional, a statute must be narrowly drafted to achieve a compelling governmental interest) applies to content-based regulations. Section 2(a) is content-based because, “[b]y its very terms, §2(a) focuses on, and cannot be justified without reference to, the expressive content of the potentially disparaging mark.”¹⁵⁸

The brief next argued that, if *Central Hudson* applies to trademarks as a form of commercial speech, §2(a) is still unconstitutional.¹⁵⁹ Tam analyzed the *Central Hudson* test and finds fault, especially in the government’s purported reasons for (i.e., its “interest” in) the “may disparage” prohibition of § 2(a). Tam posited,

The only conceivable interest the government may have in the suppression of disparaging trademarks through §2(a) is protecting the public, or a subset of the public, from offensive expression. However, the potential of a listener’s offense is “classically not justification[] validating the suppression of expression protected by the First Amendment.”¹⁶⁰

Lastly, he maintained that § 2(a) is both a content-based restriction that is unconstitutional on its face¹⁶¹ and a viewpoint-based restriction that is unconstitutional as applied to him.¹⁶²

155. *Id.* at 22.

156. *Id.* at 23.

157. *Id.* at 23-25.

158. *Id.* at 24 (citation omitted).

159. *Id.* at 25-28.

160. *Id.* at 26-27 (quoting *Carey v. Population Servs. Int’l*, 431 U.S. 678, 701 (1977)).

161. *Id.* at 28.

162. *Id.* at 29-30.

E. Summary of En Banc Brief for Appellee (July 16, 2015)

The principal thrust of the United States' brief is that the First Amendment does not apply to this case, and therefore, there is no need to consider either a traditional First Amendment analysis or a commercial speech analysis.¹⁶³ The United States argued that the First Amendment does not apply because the federal trademark registration system merely provides benefits to a trademark owner; it does not convey trademark rights.¹⁶⁴ And, the argument maintained, the government (Congress) is within its rights to withhold the benefits of registration for marks that are disparaging.¹⁶⁵ Thus, like Judge Lee's decision in *Blackhorse*, which argues that the First Amendment does not apply because the federal trademark registration system is government speech, not private speech,¹⁶⁶ there is no need to assess the merits of either traditional or commercial speech First Amendment doctrine.¹⁶⁷

The government's brief began by rephrasing the issue: "The question in this case is whether the First Amendment requires Congress to open the Principal Register of the United States to trademarks that comprise racial slurs, and thereby embrace those racial slurs as instruments of federal law."¹⁶⁸ Actually, that is not the question that the court asked to be briefed. The question is not about "racial slurs"; it is about the application of the First Amendment to § 2(a) of the Lanham Act. Perhaps the government framed the issue in this inflammatory manner, hoping to strike a nerve in its readers? Nevertheless, it is an interesting debate tactic.

As was mentioned, the government's main contention is that the First Amendment is inapplicable: "But section 2(a) does not in any way abridge Tam's speech. Rather, the statute limits the marks eligible for federal registration and for certain associated legal benefits that facilitate enforcement of the mark against infringers."¹⁶⁹ The brief recounted the history of trademark law, registration, and protection in the United States¹⁷⁰ and noted, in particular, that the predecessor trademark act, the 1905

163. En Banc Brief for Appellee at 2-3, *In re Tam*, 785 F.3d 567 (Fed. Cir. 2015) (No. 14-1203).

164. *Id.* at 3.

165. *Id.* at 6.

166. *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 462 (E.D. Va. 2015).

167. En Banc Brief for Appellee, *supra* note 163, at 3.

168. *Id.* at 1.

169. *Id.* at 2.

170. *Id.* at 4-9.

Trademark Act, prohibited most of the kinds of marks currently barred by § 2(a), but that it did not prohibit marks that “may disparage.”¹⁷¹ The government then discussed many of the benefits that a registrant acquires by virtue of federal registration.¹⁷² Providing additional background, the government then discussed Tam’s trademark application, the refusal by the PTO, and the TTAB’s decision.¹⁷³ Next comes a summary of the CAFC’s decision on April 20, 2015, Judge Moore’s Additional Views, the vacating of the decision, and the order for *en banc* reconsideration on April 27, 2015.¹⁷⁴

The heart of the government’s argument is that § 2(a) cannot restrict freedom of speech because trademark registration is optional.¹⁷⁵ “The Constitution does not preclude Congress from creating a federal trademark registration program without extending it to embrace racial epithets as commercial identifiers.”¹⁷⁶ According to the government, federal registration merely provides procedural advantages and withholding those advantages does not abridge free speech.¹⁷⁷ The government’s brief also maintained that it is not “an ‘unconstitutional condition’ for Congress to prohibit federal registration of disparaging marks.”¹⁷⁸ The government further noted that the standard of review for holding a statute unconstitutional on its face is exceptionally high.¹⁷⁹

The United States then discussed *McGinley* and argued that *McGinley* was correct in holding that § 2(a) does not restrict speech.¹⁸⁰ Here the brief reminded us that people are free to use unregistered marks and that a lack of

171. *Id.* at 5-6.

172. *Id.* at 6-8.

173. *Id.* at 9-12.

174. *Id.* at 12-13.

175. *Id.* at 14 (“Congress has set up an optional federal registration scheme, and section 2(a) constitutes an exercise of Congress’s broad authority to define the limits of a federal program.”).

176. *Id.*

177. *Id.* at 14-16.

178. *Id.* at 15 (“The Supreme Court recently reiterated that the unconstitutional conditions doctrine is implicated only if Congress seeks to leverage federal benefits or subsidies to regulate constitutionally protected conduct *outside* of the federal program in question. *See Agency for Int’l Dev. v. Alliance for Open Soc’y Int’l, Inc.*, 133 S. Ct. 2321, 2328 (2013).”).

179. *Id.* at 16 (“To prevail in a facial challenge to an Act of Congress, a plaintiff normally must show that ‘no set of circumstances exists under which [the challenged law] would be valid or that the statute lacks any plainly legitimate sweep.’”) (citation omitted).

180. *Id.* at 17-21.

federal registration in no way prevents them from expressing themselves in any manner that they choose.¹⁸¹ According to the government, § 2(a) “reflects Congress’s judgment that a federal agency should not use its resources affirmatively to *promote* the use in commerce of racial slurs and similar disparagements as the means for avoiding confusion as to the source of goods or services.”¹⁸² The government argued that federal registration merely provides additional benefits to a trademark owner, that Congress has decided to whom it wishes to provide those benefits, and that Congress has the authority to decide the criteria for receiving those benefits.¹⁸³

Perhaps being a bit alarmist and/or hyperbolic, the government suggested that, if Tam wins this case, the PTO will be forced to register “the most vile racial epithets.”¹⁸⁴ Continuing this line of reasoning, it forecasted that the PTO would be “constitutionally compelled to record scandalous words and lewd photographs on its Principal Register, in order to facilitate the enforcement of those marks in commerce as well.”¹⁸⁵ This warning of doom may or may not be true, but it ignores the fact that this court is not currently reviewing the “scandalous” and “immoral” prohibitions of § 2(a)—prohibitions that presumably could still prevent registration of “the most vile racial epithets,” “scandalous words and lewd photographs”—but rather this court is reviewing only the “may disparage” prohibition.¹⁸⁶ It also fails to acknowledge that the Copyright Office is currently required by law to register copyrights for similarly offensive materials.¹⁸⁷

In any event, the government argued in this section of its brief that Congress is within its rights to impose the “may disparage” restriction. Quoting *Rust v. Sullivan*,¹⁸⁸ the government notes:

181. *Id.* at 18. (“Tam does not and cannot contend that he needs a federally registered mark in order to engage in any expressive activity. Tam does not need federal trademark registration to use the name he chose for his band.”).

182. *Id.* at 21.

183. *Id.* at 22-28.

184. *Id.* at 22.

185. *Id.* at 23 (“The Constitution does not put Congress to the choice of either eliminating the federal trademark registration program altogether or extending it to embrace racial epithets and lewd photographs as commercial identifiers.”).

186. *Id.* at 22-23.

187. Presumably the government considers the use of this hyperbolic and exaggerated, inflammatory rhetoric necessary in its role as zealous advocate. For additional discussion regarding the applicability of Copyright principles to this issue, see *infra* Sections IV.D., V.A.1, V.A.3, and V.A.5.

188. 500 U.S. 173 (1991).

[T]he Supreme Court upheld “Department of Health and Human Services (HHS) regulations which limit the ability of Title X fund recipients to engage in abortion-related activities.” The Court confirmed that “[t]he Government can, without violating the Constitution, selectively fund a program to encourage certain activities it believes to be in the public interest, without at the same time funding an alternative program which seeks to deal with the problem in another way.” “In so doing,” the Court explained, “the Government has not discriminated on the basis of viewpoint; it has merely chosen to fund one activity to the exclusion of the other.”¹⁸⁹

Continuing this general train of thought, the government explained that the *McGinley* court merely “recognized that section 2(a) represents ‘a judgment by the Congress that [certain] marks not occupy the time, services, and use of funds of the federal government.’”¹⁹⁰ The government then took the next logical step—arguing its view that the unconstitutional conditions doctrine is inapplicable in this case.¹⁹¹

The government also maintained that the federal trademark registry ought not be classified as a “public forum.”¹⁹² It contended that “[t]he facts of this case underscore that section 2(a) has neither the intention nor the effect of promoting any viewpoint or eliminating any viewpoint from the marketplace of ideas,”¹⁹³ and, in addition, reasoned that “[s]ection 2(a) is viewpoint neutral.”¹⁹⁴ The argument that follows posited that the government has a legitimate interest in prohibiting registration of disparaging trademarks, relying in particular on *Walker*¹⁹⁵ for the proposition that “private speakers cannot compel the government to publish

189. En Banc Brief for Appellee, *supra* note 163, at 24.

190. *Id.* at 30 (citing *In re Fox*, 702 F.3d 633, 634 (Fed. Cir. 2012) and *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981)).

191. *Id.* at 32-34 (discussing several cases in support of its position).

192. *See id.* at 35-37 (“Federal trademark registration does not create a forum for the expression of ideas.”).

193. *Id.* at 39.

194. *Id.* at 40. The CAFC expressly rejected this argument, holding, “A mark that is viewed by a substantial composite of the referenced group as disparaging is rejected. It is thus the viewpoint of the message conveyed which causes the government to burden the speech. This form of regulation cannot reasonably be argued to be content neutral or viewpoint neutral.” *In re Tam*, 808 F.3d 1321, 1337 (Fed. Cir. 2015).

195. *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2251-53 (2015).

material the government rejects, and that the government is entitled to dissociate itself from speech it finds odious.”¹⁹⁶ The government’s view is that, in a manner similar to the way that the Sons of Confederate Veterans were not permitted to force the Texas Department of Motor Vehicles to publish license plates with an image of a Confederate flag, “Tam cannot force the government to register vile racial epithets”¹⁹⁷ Aligning itself further with the reasoning in *Walker*, the United States noted, “Although the USPTO does not endorse any particular product, service, mark, or registrant, the government’s publication of disparaging marks on its Principal Register would convey to the public that the United States regards racial slurs as appropriate source identifiers for goods and services in commerce.”¹⁹⁸ In closing, the government briefly mentioned the possible application of *Central Hudson*, and asserts, without any genuine analysis, that § 2(a) “would withstand scrutiny” under the *Central Hudson* test.¹⁹⁹

F. Summary of Reply Brief On Behalf Of Appellant For En Banc Hearing, (August 4, 2015)

In the Introduction to his reply brief, Tam invoked *R.A.V. v. City of St. Paul*,²⁰⁰ and quoted Justice White’s concurring opinion: “The mere fact that expressive activity causes hurt feelings, offense, or resentment does not render the expression unprotected.”²⁰¹ He accused the government of mischaracterizing the real issue in the case and also of mischaracterizing the nature of the federal trademark registration system.²⁰² The brief

196. En Banc Brief for Appellee, *supra* note 163, at 41.

197. *Id.* at 42.

198. *Id.* at 44.

199. *Id.* at 45-46 (“But especially in light of the provision’s limited and indirect effect on Tam’s protected expression, the statute would withstand scrutiny even if the standard applicable to restrictions on commercial speech set out in *Central Hudson Gas & Electric Corp. v. Public Service Commission*, 447 U.S. 557 (1980), were thought to apply.”).

200. 505 U.S. 377, 386-87 (1992).

201. Reply Brief on Behalf of Appellant for *En Banc* Hearing at 1, *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015) (No. 14-1203).

202. *Id.* at 2 (“[T]he government reformulates the question as to whether Congress intended to open the Register to ‘embrace those racial slurs as instruments of federal law’. [sic] The government insists that registration somehow transforms the government into the ‘owner’ of registered trademarks—which, as private commercial speech, are unquestionably a form of protected expression—and an ‘underwriter’ of selective enforcement of trademarks whose content it approves. This mischaracterization of the statutory scheme for trademark registration is novel but has no basis in the Lanham Act’s language, statutory history, or case law.” (footnote omitted) (citation omitted)).

challenged several of the government's arguments. First, it challenged the government's position that trademark registration amounts to a "subsidy" and countered that "Tam is not seeking a penny of taxpayer funds or even an iota of 'government assistance' to enforce the rights to which he is entitled under trademark law."²⁰³ The brief then addresses *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*²⁰⁴ and contends that the government is mistaken to believe that this case applies in such a way to render the federal trademark registration system a kind of government speech.²⁰⁵ Tam carefully examined the factors relied upon in *Walker* to assess government speech and concluded that "the registration of a private trademark is not a medium of government speech."²⁰⁶ To illustrate his point, Tam listed several trademarks that have been registered that appear to be antithetical to U.S. government policies; these registrations suggest that the U.S. Government is not the speaker endorsing these messages.²⁰⁷ This section of the brief concluded with one simple assertion: "Section 2(a) clearly does not implicate government speech."²⁰⁸

The next major section of Tam's reply brief revisited the unconstitutional conditions doctrine. Tam argued that the government "attempts to redefine the trademark registration system enacted by Congress as a regime for excluding certain categories of speech, thereby setting §2(a)'s regulation of speech *inside* the contours of the program."²⁰⁹ He explains the point as follows:

To the extent that §2(a) purports to authorize the government to leverage this program against speech disfavored by the government, such leverage imposes the pre-condition of content propriety on registrable marks, without which otherwise-qualified marks are denied the significant benefits of the Act.

203. *Id.* at 3-4.

204. 1355 S. Ct. 2239, 2246-49 (2015).

205. Reply Brief on Behalf of Appellant for *En Banc* Hearing, *supra* note 203, at 5-10.

206. *Id.* at 6-7.

207. *Id.* at 7-8 (noting numerous examples of "(1) marks espousing support for a particular religion," such as: "GIVE JESUS A CHANCE" and "KNIGHTS IN SATAN'S SERVICE"; "(2) marks that would seem to conflict with American foreign policy," such as: "RUSSIA MADE ME"; "(3) marks that conflict with the government's war on drugs," such as: "ILC – I LOVE COCAINE,"; and "(4) other marks that seem inconsistent with generally sound public policy," such as: "ALCOHOL ABUSE." (citations omitted)).

208. Reply Brief on Behalf of Appellant for *En Banc* Hearing, *supra* note 203, at 10.

209. *Id.* at 11.

This is constitutionally offensive as an abridgement of speech, and the government offers no contrary substantive analysis.²¹⁰

Tam next challenged the government's position that § 2(a) is "viewpoint-neutral."²¹¹ "On its face, §2(a) explicitly requires the government, in the manner of a government censor, to sort and treat differently marks whose content it determines are offensive from those it does not."²¹² He pointed to anomalous and inconsistent trademark registrations (based on the content and viewpoints expressed) and challenged the government's interpretations of several cases, which Tam believed does *not* stand "for the proposition that the First Amendment permits the government to refrain from giving assistance to private speakers."²¹³

Lastly, the reply brief focused on the applicability of *Central Hudson*²¹⁴ and contended that the government's interests in upholding § 2(a)'s "may disparage" prohibition "fall short."²¹⁵ Tam reminded the court that, "under *Central Hudson*, any government interests must be 'substantial.'"²¹⁶ According to Tam, neither of the two interests claimed by the government were "substantial."²¹⁷ In addition, he noted that the *Central Hudson* test requires that, in order to pass First Amendment muster, a statute: "(1) must directly advance the government interest and 'alleviate [the alleged harms] to a material degree', and (2) must not be more extensive than necessary to serve the government's interest."²¹⁸ Here Tam argued that § 2(a) fails again: "The government has made no showing that refusing to register offensive marks alliviates [sic] racial intolerance or even protects the public from exposure to offensive commercial speech. The government has admitted it does no such thing."²¹⁹ And similarly, he posited that the statute is both

210. *Id.* at 12.

211. *Id.* at 13-17.

212. *Id.* at 13.

213. *Id.* at 14-15.

214. *See Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 562-64 (1980).

215. Reply Brief on Behalf of Appellant for *En Banc* Hearing, *supra* note 203, at 17.

216. *Id.*

217. *See id.* ("The government identified only two interests that might possibly justify the existence of §2(a): public policy against racially offensive speech and the desire to permit the States to discriminate against offensive trademarks. Neither withstands constitutional scrutiny.").

218. *Id.* at 17-18 (citation omitted).

219. *Id.* at 18.

overinclusive and overbroad, which demonstrates that it is decidedly more extensive than necessary.²²⁰

Tam concluded, stating: “The government’s proffered interests cannot support §2(a)’s unconstitutional burden on speech and this court should strike down §2(a) as unconstitutional.”²²¹

G. Summary of the CAFC En Banc Decision (December 22, 2015)

On December 22, 2015, the CAFC, en banc, held that the “may disparage” prohibition of § 2(a) is unconstitutional because it fails under a First Amendment strict scrutiny analysis.²²² Writing for the court, at the outset Judge Moore acknowledged: “It is a bedrock principle underlying the First Amendment that the government may not penalize private speech merely because it disapproves of the message it conveys.”²²³ Furthermore, the court reasoned that § 2(a) “would also be unconstitutional under the intermediate scrutiny traditionally applied to regulation of the commercial aspects of speech.”²²⁴ The court directly asserted its conclusion in the caption of Part I of its discussion: “Section 2(a)’s Denial of Important Legal Rights to Private Speech Based on Disapproval of the Message Conveyed Is Subject to, and Cannot Survive, Strict Scrutiny.”²²⁵

Judge Moore explained that § 2(a)’s “may disparage” prohibition is both content-based and viewpoint-based discrimination.²²⁶ She stated simply: “And § 2(a) does more than discriminate on the basis of topic. It also discriminates on the basis of message conveyed, ‘the idea or message expressed,’ it targets ‘viewpoints [in] the marketplace.’ It does so as a matter of avowed and undeniable purpose, and it does so on its face.”²²⁷ Judge Moore pointed out that, “[f]rom its enactment in 1946 through its defense of the statute today, the government has argued that the prohibited marks ought not to be registered because of the messages the marks

220. *Id.*

221. *Id.* at 19.

222. *See In re Tam*, 808 F.3d 1321, 1328 (Fed. Cir. 2015) (“The government regulation at issue amounts to viewpoint discrimination, and under the strict scrutiny review appropriate for government regulation of message or viewpoint, we conclude that the disparagement proscription of § 2(a) is unconstitutional.”).

223. *Id.* at 1327.

224. *Id.* at 1328.

225. *Id.* at 1334.

226. *Id.* at 1335-37.

227. *Id.* at 1335 (citations omitted).

convey.”²²⁸ Thus she concluded that § 2(a) plainly constitutes viewpoint discrimination.²²⁹

Having concluded that § 2(a)'s “may disparage” prohibition is both content-based and viewpoint-based discrimination, the opinion next held that strict scrutiny applies to evaluate its constitutionality.²³⁰ The CAFC contended that strict scrutiny applies because it is the expressive quality of trademarks that trigger the “may disparage” prohibition of § 2(a) not their commercial character.²³¹ In fact, the CAFC emphasized that the PTO only refuses to register marks on the basis of § 2(a)'s “may disparage” prohibition in cases where it is the expressive quality of the mark that causes the disparagement: “Importantly, *every time* the PTO refuses to register a mark under § 2(a), it does so because it believes the mark conveys an expressive message—a message that is disparaging to certain groups.”²³² To punctuate the point, the court concluded: “Every single time registration is refused or cancelled pursuant to the disparagement provision, it is based upon a determination by the government that the expressive content of the message is unsuitable because it would be viewed by the referenced group as disparaging them.”²³³ Thus, in the court's view, although trademarks have a “dual character” in that they may be considered commercial speech on one level, because it is the non-commercial, expressive nature of a mark that triggers the application of § 2(a)'s “may disparage” prohibition, strict scrutiny applies.²³⁴ “In particular, commercial speech that is ‘inextricably intertwined’ with expressive speech is treated as expressive speech under the First Amendment when the expressive aspect is being regulated.”²³⁵

Part II of the CAFC's opinion addressed and rejected three arguments advanced by the government in support of the constitutionality of § 2(a).²³⁶ First, the government argued that, because refusing to register a mark does not prohibit an applicant from using that mark, a refusal to register pursuant

228. *Id.* at 1336.

229. *See id.* (“When the government discriminates against speech because it disapproves of the message conveyed by the speech, it discriminates on the basis of viewpoint.”).

230. *Id.* at 1337-39.

231. *Id.* at 1338 (“[M]arks often have an expressive aspect over and above their commercial-speech aspect.”).

232. *Id.*

233. *Id.*

234. *Id.* at 1338-39.

235. *Id.* at 1339 (citing *Riley v. Nat'l Fed'n of the Blind*, 487 U.S. 781, 796 (1988)).

236. *Id.* at 1339-55.

to § 2(a) does not ban any speech.²³⁷ But the CAFC makes it clear that a government regulation may violate the First Amendment even if it does not completely ban speech.²³⁸ According to the court, when a governmental “denial of a benefit would chill exercise of the constitutional right” of freedom of speech, that denial violates the First Amendment.²³⁹ “The general principle is clear: ‘Lawmakers may no more silence unwanted speech by burdening its utterance than by censoring its content.’”²⁴⁰ And the court explicitly recognized that the “may disparage” prohibition poses precisely this type of Sword of Damocles situation: “Denial of these benefits creates a serious disincentive to adopt a mark which the government may deem offensive or disparaging.”²⁴¹ The chilling effect of § 2(a) is even more pronounced because, “[e]ven if an applicant obtains a registration initially, the mark may be challenged in a cancellation proceeding years later.”²⁴² Furthermore, the court elaborated, explaining that any common law rights or rights that may be obtained by state trademark registration in the absence of federal registration pale in comparison to the rights available through federal registration.²⁴³ Thus the court concluded: “Denial of federal trademark registration on the basis of the government’s disapproval of the message conveyed by certain trademarks violates the guarantees of the First Amendment.”²⁴⁴

The opinion next addressed the government’s argument that trademarks constitute “government speech” and therefore are immune from First Amendment scrutiny.²⁴⁵ The court wasted no time in asserting, “[t]his argument is meritless [sic]. Trademark registration is a regulatory activity. These manifestations of government registration do not convert the

237. *Id.* at 1339 (“The government argues that § 2(a) does not implicate the First Amendment because it does not prohibit any speech.”) (citing En Banc Brief for Appellee, *supra* note 163, at 17).

238. *Id.* at 1340.

239. *Id.*

240. *Id.* (citing *Sorrell v. IMS Health, Inc.*, 131 S. Ct. 2653, 2664 (2011)).

241. *Id.* at 1341.

242. *Id.* at 1343.

243. *Id.* at 1343-45; *see id.* at 1344 (“The government’s suggestion that Mr. Tam has common-law rights to his mark appears illusory.”).

244. *Id.* at 1345.

245. *Id.* at 1345-48; *see id.* at 1345 (“[T]he government appears to argue that trademark registration and the accoutrements of registration—such as the registrant’s right to attach the ® symbol to the registered mark, the mark’s placement on the Principal Register, and the issuance of a certificate of registration—amount to government speech.”).

underlying speech to government speech.”²⁴⁶ Judge Moore summarized *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*,²⁴⁷ in which “the Supreme Court detailed the indicia of government speech.”²⁴⁸ Unlike vehicle license plates issued by a state, Judge Moore pointed out that, “[t]rademarks are not understood to convey a government message or carry a government endorsement.”²⁴⁹ In addition, neither the registration symbol (®) nor the registration certificate “convert private speech into government speech.”²⁵⁰ “In short, the act of registration, which includes the right (but not the obligation) to put an ® symbol on one’s goods, receiving a registration certificate, and being listed in a government database, simply cannot amount to government speech.”²⁵¹

Thirdly, in its brief, the government had cited and quoted *Rust v. Sullivan*.²⁵²

[T]he Supreme Court upheld “Department of Health and Human Services (HHS) regulations which limit the ability of Title X fund recipients to engage in abortion-related activities.” The Court confirmed that “[t]he Government can, without violating the Constitution, selectively fund a program to encourage certain activities it believes to be in the public interest, without at the same time funding an alternative program which seeks to deal with the problem in another way.” “In so doing,” the Court explained, “the Government has not discriminated on the basis of viewpoint; it has merely chosen to fund one activity to the exclusion of the other.”²⁵³

246. *Id.* at 1345-46.

247. 135 S. Ct. 2239 (2015).

248. *Tam*, 808 F.3d at 1346 (citing *Walker*, 135 S. Ct. 2239).

249. *Id.* at 1347.

250. *Id.*

251. *Id.* at 1348; *see id.* (“The PTO’s processing of trademark registrations no more transforms private speech into government speech than when the government issues permits for street parades, copyright registration certificates, or, for that matter, grants medical, hunting, fishing, or drivers licenses, or records property titles, birth certificates, or articles of incorporation. To conclude otherwise would transform every act of government registration into one of government speech and thus allow rampant viewpoint discrimination. When the government registers a trademark, it regulates private speech. It does not speak for itself.”).

252. 500 U.S. 173 (1991).

253. En Banc Brief for Appellee, *supra* note 163, at 24 (citations omitted).

The CAFC, however, reasoned that trademark registration does not amount to a government subsidy,²⁵⁴ and, as such, the “denial of an otherwise-available benefit [i.e., trademark registration] is unconstitutional at least where, as here, it has a significant chilling effect on private speech.”²⁵⁵ Judge Moore discussed this issue at length, ultimately concluding: “Were we to accept the government’s argument that trademark registration is a government subsidy and that therefore the government is free to restrict speech within the confines of the trademark program, it would expand the ‘subsidy’ exception to swallow nearly all government regulation.”²⁵⁶

Part III of the opinion articulated the reasons why the “may disparage” prohibition of § 2(a) is unconstitutional even if trademarks are considered “commercial speech” and, therefore, it is subject to intermediate scrutiny.²⁵⁷ The court first reiterated that § 2(a) is subject to strict scrutiny as “expressive speech.”²⁵⁸ Judge Moore admitted, however, that “[t]rademarks have at times been referred to as commercial speech,” because “[t]hey are, after all, commercial identifiers, the symbols and words by which companies distinguish and identify their brands.”²⁵⁹ The United States Supreme Court established the methodology for analyzing the constitutionality of commercial speech in *Central Hudson*.²⁶⁰ Under the *Central Hudson* test, if the commercial speech at issue concerns a lawful activity and is not misleading, then the court asks “whether ‘the asserted governmental interest is substantial,’ and whether the regulation ‘directly and materially advanc[es]’ the government’s asserted interest and is narrowly tailored to achieve that objective.”²⁶¹

The court, thus, applied the *Central Hudson* test to § 2(a). First, Judge Moore noted that, “[u]nlike many other provisions of § 2, the disparagement provision does not address misleading, deceptive, or unlawful marks. There is nothing illegal or misleading about a disparaging

254. *Tam*, 808 F.3d at 1348-55.

255. *Id.* at 1348-49 (citation omitted).

256. *Id.* at 1354; *see also id.* at 1355 (“The government may not place unconstitutional conditions on trademark registration.”).

257. *Id.* at 1355-57.

258. *Id.* at 1355.

259. *Id.*

260. *Central Hudson Gas & Elec. v. Public Serv. Comm’n*, 447 U.S. 557, 566 (1980).

261. *Tam*, 808 F.3d at 1355 (alteration in original) (first quoting *Central Hudson*, 447 U.S. at 566, and then quoting *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 555-56 (2001)).

trademark”²⁶² Secondly, the court addressed the government’s arguments that its interest in suppressing disparaging marks is substantial.²⁶³ The opinion discussed the four arguments advanced by the government as “substantial interests,”²⁶⁴ but summarized those arguments by noting that, “[a]ll of the government’s proffered interests boil down to permitting the government to burden speech it finds offensive,” and concluded that, “[t]his is not a legitimate interest.”²⁶⁵ Consequently, Judge Moore does not even analyze whether § 2(a) directly and materially advances the government’s interests and is narrowly tailored to accomplish them. Instead, the opinion succinctly stated: “With no substantial government interests, the disparagement provision of § 2(a) cannot satisfy the *Central Hudson* test. We hold the disparagement provision of § 2(a) unconstitutional under the First Amendment.”²⁶⁶

In its conclusion, the court acknowledged that its holding may well result in a certain amount of bruised feelings but, nevertheless, asserted that such consequences are sometimes unavoidable, given the importance of freedom of speech:

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. Even when speech “inflict[s] great pain,” our Constitution protects it “to ensure that we do not stifle public debate.”²⁶⁷

Judge O’Malley, joined by Judge Wallach, concurred with the majority opinion, but wrote separately to say that “§ 2(a) is also unconstitutionally vague, rendering it unconstitutional under the Fifth Amendment to the

262. *Id.*

263. *Id.* at 1555-57.

264. The government argued that it has a significant interest in suppressing disparaging trademarks because: 1) it should be “entitled to dissociate itself from speech it finds odious,” *En Banc Brief for Appellee, supra* note 163, at 41; 2) it should be allowed not “to expend its resources to facilitate the use of racial slurs as source identifiers in interstate commerce,” *id.* at 43; 3) it “has a compelling interest in fostering racial tolerance,” *id.*; and, 4) it has a substantial interest in “allowing States to make their own determinations about whether trademarks should be unenforceable on grounds of public policy,” *id.* at 44.

265. *Tam*, 808 F.3d at 1357.

266. *Id.*

267. *Id.*

United States Constitution.”²⁶⁸ Judge O’Malley stressed that “§ 2(a)’s inherent ambiguity makes it difficult for would-be applicants to discern its boundaries and leads to inconsistent and unreliable actions on the part of the government as it seeks to regulate on the basis of content.”²⁶⁹

Judge Dyk wrote a separate opinion, concurring in part and dissenting in part.²⁷⁰ Judges Lourie and Reyna joined Judge Dyk with respect to the first four parts of Judge Dyk’s opinion.²⁷¹ Judge Dyk captured the essence of the reasoning, stating: “The majority is correct that the bar on registration of disparaging marks is unconstitutional as applied to Mr. Tam. But in my view the majority errs in going beyond the facts of this case and holding the statute facially unconstitutional as applied to purely commercial speech.”²⁷² Judge Dyk maintained that § 2(a) is not a blanket license for the government to suppress speech with which it disagrees.²⁷³ Rather Dyk contended that “the statute is designed to preclude the use of government resources not when the *government* disagrees with a trademark’s message, but rather when its meaning ‘may be disparaging to a *substantial composite of the referenced group*.’”²⁷⁴ Hence, Judge Dyk reasoned that the “may disparage” prohibition of § 2(a) is not facially unconstitutional but only unconstitutional as applied to Tam’s purportedly political speech: “the statute is constitutional as applied to purely commercial trademarks, but not as to core political speech, of which Mr. Tam’s mark is one example.”²⁷⁵ One especially logical criticism of the majority opinion raised by Dyk is his concern that not all trademarks convey the degree of socio-political commentary that Tam’s “Slants” mark conveys.²⁷⁶ He notes: “While I agree that some marks, including Mr. Tam’s, have an expressive component, it would seem beyond debate that many do not, as is the case with respect to routine product identifiers.”²⁷⁷ Therefore, he maintained that, when

268. *Id.* at 1358 (O’Malley, J., concurring).

269. *Id.* at 1361 (O’Malley, J., concurring).

270. *Id.* at 1363 (Dyk, J., concurring in part, dissenting in part).

271. *Id.*

272. *Id.*

273. *Id.*

274. *Id.* at 1364 (Dyk, J., concurring in part, dissenting in part).

275. *Id.*

276. *Id.* at 1367 (Dyk, J., concurring in part, dissenting in part).

277. *Id.*

trademarks are analyzed as commercial speech, § 2(a) is valid under *Central Hudson*.²⁷⁸

Part II of Judge Dyk's opinion disagreed with the majority's view that trademark registration is not a government subsidy.²⁷⁹ Because he believes that trademark registration is a form of government subsidy, Judge Dyk maintained that the government may deny that subsidy on the basis of content.²⁸⁰ According to Judge Dyk, "That trademark registration is a subsidy is not open to doubt. Contrary to the majority's characterization, federal trademark registration is not a 'regulatory regime.' Section 2(a) does not regulate any speech, much less impose a blanket ban. It merely deprives a benefit."²⁸¹

In Part III, Dyk challenged the majority's assertion "that subsidies require viewpoint neutrality"²⁸² but argued, nevertheless, that, "§ 2(a) is in any event viewpoint neutral."²⁸³ He explained this point by stating that "the bar on registration of disparaging marks operates in a 'neutral fashion' by looking only to the views of the referenced group."²⁸⁴

In Part IV, Judge Dyk posited that "the protection of disparaged groups" presents a sufficiently important governmental interest "to justify its regulation defined in terms of 'reasonableness.'"²⁸⁵ To a large degree, Dyk anchored this argument on the theory that "commercial speech is different" from "core protected speech," which requires that, "groups must tolerate the disparagement in pursuit of the greater goal of a free marketplace of ideas."²⁸⁶ He concluded Part IV, remarking that "[w]e need not decide

278. *Id.* at 1368 (Dyk, concurring in part, dissenting in part) ("In short, many trademarks lack the kind of 'expressive character' that would merit First Amendment protection for offensive content, and a regulation of the use of those marks could satisfy the *Central Hudson* test for commercial speech—a substantial government interest reflected in a narrowly tailored regulation. The majority's contrary conclusion seems to me to be unsupported."). Curiously, however, Judge Dyk makes this assertion in a conclusory fashion but fails to articulate in a step-by-step manner just how § 2(a)'s "may disparage" prohibition satisfies the three-part *Central Hudson* test.

279. *Id.*

280. *Id.*

281. *Id.* (citation omitted).

282. *Id.* at 1371 (Dyk, J., concurring in part, dissenting in part).

283. *Id.*

284. *Id.*; see also *id.* at 1372 (Dyk, J., concurring in part, dissenting in part) ("[I]t is based on an objective, 'neutral' assessment of a non-government perspective—in this case, a 'substantial composite of the referenced group.'").

285. *Id.* at 1372 (Dyk, J., concurring in part, dissenting in part).

286. *Id.*

whether this interest is sufficiently compelling to justify a ban of disparaging commercial speech. It is more than sufficient to justify the government's 'decision not to assist' disparaging commercial expression."²⁸⁷

Part V maintained that, for purposes of First Amendment analysis, distinguishing between the core/expressive content of trademark speech versus its commercial character is not a difficult task.²⁸⁸

But in Part VI, Judge Dyk agreed with the majority's view that § 2(a) is unconstitutional *as applied to Tam*.²⁸⁹ He emphasizes that Tam selected the mark, THE SLANTS, intentionally trying to make a socio-political statement.²⁹⁰

Given the indisputably expressive character of Mr. Tam's trademark in this case, the government's recognized interests in protecting citizens from targeted, demeaning advertising and proscribing intrusive formats of commercial expression—interests that are sufficient to justify the provision as applied to commercial speech—are insufficient to justify application of the provision to Mr. Tam.²⁹¹

Hence, Judge Dyk concluded: "Accordingly, because no government interest can justify restricting Mr. Tam's core speech on the basis of its capacity to injure others, § 2(a) is invalid as applied."²⁹²

Judge Lourie joined with Parts I-IV of Judge Dyk's opinion but wrote separately to "dissent with respect to the result reached by the majority, holding the disparagement provision of § 2(a) unconstitutional as violating the First Amendment."²⁹³ Fundamentally, Judge Lourie agreed with the government's position that "the refusal of the USPTO to register a trademark is not a denial of an applicant's right of free speech. The markholder may still generally use the mark as it wishes; without federal registration, it simply lacks access to certain federal statutory enforcement

287. *Id.*

288. *Id.* at 1373 (Dyk, J., concurring in part, dissenting in part).

289. *Id.*

290. *Id.* ("Mr. Tam chose THE SLANTS at least in part to reclaim the negative racial stereotype it embodies: 'We want to take on these stereotypes that people have about us, like the slanted eyes, and own them. We're very proud of being Asian—we're not going to hide that fact.'").

291. *Id.* at 1373-74 (Dyk, J., concurring in part, dissenting in part).

292. *Id.* at 1374 (Dyk, J., concurring in part, dissenting in part).

293. *Id.* at 1374 (Lourie, J., dissenting).

mechanisms for excluding others from confusingly similar uses of the mark.”²⁹⁴ He noted that, even in the absence of federal registration, a trademark owner still maintains common law protection²⁹⁵ and also adheres to the view that trademarks are government speech.²⁹⁶ Thus, Judge Lourie contended that the PTO’s decision to deny Tam’s registration ought to be affirmed.²⁹⁷

Judge Reyna dissented, arguing that trademarks are commercial speech and that, as commercial speech, § 2(a) passes constitutional muster under an intermediate scrutiny standard.²⁹⁸ Judge Reyna expressed the opinion that § 2(a) is intended “to promote the orderly flow of commerce”²⁹⁹ and that, “[c]ommercial speech that insults groups of people, particularly based on their race, gender, religion, or other demographic identity, tends to disrupt commercial activity and to undermine the stability of the marketplace in much the same manner as discriminatory conduct.”³⁰⁰

He then explained that promoting the orderly flow of commerce is a substantial government interest and that § 2(a) survives intermediate scrutiny because it presents what Judge Reyna characterizes as a “modest burden” to suppress discriminatory commercial speech.³⁰¹ Curiously, however, Judge Reyna failed to articulate why he thinks that § 2(a) meets the *Central Hudson* requirement that the statute in question must be narrowly tailored to directly achieve the government’s substantial interest. The best he can offer on this point is to substitute a balancing test in place of the *Central Hudson* test, which demands that the statute in question be narrowly tailored to directly achieve a substantial government interest. According to Reyna: “When we balance the government’s substantial interest in the orderly flow of commerce against the modest imposition of § 2(a) on a narrowly tailored portion of particularly low-value speech, the standards of intermediate scrutiny are satisfied.”³⁰² But in order to uphold Judge Reyna’s position on this matter, we would need to re-write the third prong of the *Central Hudson* intermediate scrutiny test; namely, change it

294. *Id.* at 1374-75 (Lourie, J., dissenting).

295. *Id.* at 1375 (Lourie, J., dissenting).

296. *Id.*

297. *Id.* at 1376 (Lourie, J., dissenting).

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

299. *Id.* at 1378 (Reyna, J., dissenting).

300. *Id.* at 1379 (Reyna, J., dissenting).

301. *Id.* at 1379-82 (Reyna, J., dissenting).

302. *Id.* at 1382 (Reyna, J., dissenting).

into a balancing test rather than a requirement that the statute be narrowly tailored to directly advance a substantial government interest.

IV. First Amendment Analysis

A. First Amendment Overview & Traditional Analysis

1. Basic Principles

The First Amendment provides, in part: “Congress shall make no law . . . abridging the freedom of speech, or of the press”³⁰³ At the outset, it is helpful to acknowledge that the TTAB does not have the authority to rule on whether the “may disparage” prohibition of § 2(a) violates the First Amendment.³⁰⁴ This task falls squarely on the shoulders of the federal courts.³⁰⁵ The United States Supreme Court is, of course, the ultimate authority when it comes to construing the First Amendment. Thus, Supreme Court views relating to freedom of speech are the most important.

Modern First Amendment doctrine began to change and take on its contemporary shape in the 1960s—long after the passage of the Lanham Act in 1946, and even longer after § 2(a)’s “may disparage” language was added to the bill in the 1930s.³⁰⁶ “In the last third of the twentieth century, the [U.S.

303. U.S. CONST. amend. I; *see* HAND, *supra* note 10, at 1 (“Congress proposed the first eight [amendments to the Constitution] in the same year that the Constitution was ratified, 1789, and they were themselves ratified in 1791.”).

304. *See* Nagel & Raschert, *supra* note 42, at 793 (“The Trial Trademark [sic] and Appeal Board issued a pretrial order in March 1994 that struck down Pro-Football’s constitutional defenses as beyond the scope of the Board’s authority.”) (citing *Harjo v. Pro-Football, Inc.*, 30 U.S.P.Q.2d (BNA) 1828, 1844-45 (T.T.A.B. 1994)); *see also* Pace, *supra* note 17, at 48 (“Respondents also raised a number of challenges to the constitutionality of section 2(a) both on its face and in its application. They claimed that Section 2(a) is unconstitutional because it abridges their freedom of speech, is unconstitutionally overbroad and is void for vagueness. However, the TTAB never reached the merit of these challenges because it determined, correctly, that such findings were beyond its authority as an administrative tribunal.”) (footnotes omitted); Lefstin, *supra* note 44, at 667.

305. Nevertheless, because the District of Columbia reversed the TTAB’s decision in the *Harjo* case by ruling that the TTAB’s decision lacked the support of substantial evidence and because of laches, that court avoided grappling with the First Amendment issue. *See* Nagel & Rascher, *supra* note 42, at 794 (“Though rescinding the petitioners standing based upon laches, the court did not resolve any constitutional issues pertinent to the case.”) (citing *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 145 (D.D.C. 2003)).

306. *See* DANIEL A. FARBER, *THE FIRST AMENDMENT* 65 (4th ed. 2014); *see also* Pace, *supra* note 17, at 36 (“Congress did not consider the relevance of the First Amendment when it enacted Section 2(a). This is apparent because the Lanham Act was promulgated long

Supreme] Court developed a basic framework for the analysis of the government's ability to restrict expressive activity, which the Court continues to use."³⁰⁷ The First Amendment requires that courts strive to promote freedom for speakers by restricting government interference with speech.³⁰⁸ Learned Hand once said that the First Amendment "rests upon the premise that there is no proposition so uniformly acknowledged that it may not be lawfully challenged, questioned, and debated."³⁰⁹ Justice Brennan, writing for the majority in *Texas v. Johnson*, articulated the essence of the First Amendment when he wrote, "[T]he government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable."³¹⁰ Justice Scalia expressed similar thoughts in *R.A.V. v. City of St. Paul*, remarking that the First Amendment prevents the government from regulating speech "based on hostility—or favoritism—towards the underlying message expressed."³¹¹ "Both *Johnson* and *R.A.V.* rest on the

before First Amendment protections were extended to commercial speech."). For additional discussion regarding commercial speech, see *infra* Section IV.B.

307. NOWAK & ROTUNDA, *supra* note 10, § 16.1(a), at 1252.

308. See FARBER, *supra* note 306, at 238 ("The central goal of most First Amendment doctrine is to limit the government's ability to interfere with speech. In accordance with this goal, the emphasis is on ensuring the liberty of the speaker."); HAND, *supra* note 10, at 2 ("That these [i.e., the rights protected by the Bill of Rights] were rights arising out of 'Natural Laws,' 'inherent' in the structure of any society, or at least any civilized society, were notions widely accepted at the end of the eighteenth century, and behind them lay a long history, going back to at least the beginning of our era."); NOWAK & ROTUNDA, *supra* note 10, § 16.1(b), at 1254 ("All of the clauses of the First Amendment are tied together by the concept of freedom of belief.").

309. HAND, *supra* note 10, at 57 ("Hence it has been again and again unconditionally proclaimed that there are no limits to the privilege so far as words seek to affect only the hearers' beliefs and not their conduct.").

310. 491 U.S. 397, 414 (1989) (involving a statute that prohibited desecration of the American flag); see also *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2226 (2015); *Spence v. Washington*, 418 U.S. 405 (1974) (per curiam) (also involving flag desecration); *Police Dep't of Chicago v. Mosley*, 408 U.S. 92, 95 (1972) ("[A]bove all else, the First Amendment means that the government has no power to restrict expression because of its message, its ideas, its subject matter, or its content."); NOWAK & ROTUNDA, *supra* note 10, § 16.49(d), at 1480 (discussing cases involving flag burning and flag desecration).

311. 505 U.S. 377, 386 (1992); see also FARBER, *supra* note 306, at 119-20 (quoting *R.A.V.*, 505 U.S. 377) (A local ordinance punished as a misdemeanor anyone who "place[d] on public or private property a symbol . . . including, but not limited to, a burning cross or Nazi swastika" in circumstances where "one knows or has reasonable grounds to know" the conduct "arouses anger, alarm, or resentment in others on the basis of race" Justice Scalia's opinion refused to allow the government to regulate speech "based on hostility—or

fundamental premise that the government has no business repressing even false and hateful ideas.”³¹² In a number of cases, applying this principle to expressions that many people find utterly deplorable—such as pornography, vulgar language, Nazi parades, and racially charged displays of bigotry and hatred (*e.g.*, KKK rallies)—has proven to be a difficult and bitter pill to swallow. Yet the extreme cases test the mettle of the Constitution and our fundamental freedoms.³¹³ As a rule, history has shown that “tolerance works better than suppression in maintaining the democratic order.”³¹⁴ Professor Farber suggests that the key question to ask is: “Has the government written a permissible rule for regulating this conduct?”³¹⁵ The right question to ask is whether Congress wrote § 2(a) in such a way that it is permissible to refuse to register marks that “may disparage.” Analyzing an especially sensitive and difficult situation in *Collin v. Smith*,³¹⁶ Professor Farber elaborates:

[T]he Nazis’ beliefs are repugnant to our “core values” and to “much of what we cherish in civilization.” Nevertheless, under the First Amendment, “there is no such thing as a false idea”; even the Nazis are entitled to compete in the marketplace of ideas. In a companion case, the Illinois Supreme Court, while admitting that the sight of swastikas is “abhorrent to the Jewish citizens of Skokie” and that the memories evoked are “offensive to the principles of a free nation,” concluded with some reluctance that

favoritism—towards the underlying message expressed” and held that the ordinance violated the First Amendment.); NOWAK & ROTUNDA, *supra* note 10, § 16.39(b)-(d), at 1413-16 (discussing *R.A.V.*); Smith, *supra* note 21, at 471-72 (“In *R.A.V. v. City of St. Paul*, the Court wrote that “[t]he First Amendment does not permit [the government] to impose special prohibitions on those speakers who express views on disfavored subjects.”) (alterations in original) (quoting *R.A.V.*, 505 U.S. at 391).

312. FARBER, *supra* note 306, at 5; *see also id.* at 65 (“Today . . . it is a bedrock principle that the government has no power to ban ideas, no matter how dangerous or undemocratic those ideas may seem.”); *id.* at 119 (“Indeed, the government might use the censorship of particular words as a pretext for eliminating certain ideas.”).

313. *Id.* at 15 (“As shown by its willingness to defend with equal fervor the rights of those who burn flags and those who burn crosses, the Court clearly now views the protection of free speech as one of its core responsibilities.”).

314. *Id.* at 8; *see also id.* at 9 (“The best argument for free expression is to look back in history and around the world at societies that have lacked it—societies that have ranged from dismal to terrifying.”); *see also id.* at 79 (“Proponents of the marketplace of ideas rely on public debate to eliminate harmful ideas, and in the meantime hope that the debate against them will invigorate more acceptable viewpoints.”).

315. *Id.* at 49.

316. 578 F.2d 1197 (7th Cir.), *cert. denied*, 439 U.S. 916 (1978).

“it is entirely clear that this factor does not justify enjoining defendants’ speech.”³¹⁷

The Supreme Court has taken a firm stance when dealing with the intersection of painful emotions and the First Amendment. One case involving extreme emotional anguish stands out: *Snyder v. Phelps*.³¹⁸ In *Snyder*, the father of a deceased soldier sued persons who had picketed his son’s military funeral, carrying signs that read “God hates the USA” and “Thank God for Dead Soldiers.”³¹⁹ The father alleged intentional infliction of emotional distress.³²⁰ But the Court ruled that the First Amendment shielded the picketers’ speech because it related to a matter of public concern.³²¹ Arguably, the use of Native American logos as trademarks has also now risen to the level of public concern as well. Professor Farber, commenting on such cases, acknowledges that “[n]one of these cases show any strong sympathy with the victims of ridicule or misrepresentations.”³²²

Arguably, the language of § 2(a) of the Lanham Act, which prohibits registration of trademarks that “may disparage,” constitutes either a content-based or viewpoint-based (or both) regulation of speech.³²³ “Content-based

317. FARBER, *supra* note 306, at 128 (first quoting *Collin*, 578 F.2d at 1200, 1204, and then quoting *Village of Skokie v. Nat’l Socialist Party*, 373 N.E.2d 21, 24 (Ill. 1978)); *see also id.* at 128 (4th ed. 2014) (“The display of the swastika could not be banned as the visual equivalent of ‘fighting words’ (any more than flag burning could be banned).”); NOWAK & ROTUNDA, *supra* note 10, § 16.6(d), at 1270-71 (attributing the “marketplace of ideas” economic metaphor to Justice Oliver Wendell Holmes).

318. 562 U.S. 443 (2011).

319. *Id.* at 448-49.

320. *Id.* at 449-50.

321. *Id.* at 455, 460.

322. FARBER, *supra* note 306, at 109.

323. The CAFC expressly held that § 2(a) constitutes viewpoint discrimination. *In re Tam*, 808 F.3d 1321, 1328 (Fed. Cir. 2015) (“The government regulation at issue amounts to viewpoint discrimination . . .”). The distinction between content-based versus viewpoint-based regulations is not always clear-cut. *See Reed v. Town of Gilbert*, 135 S. Ct. 2218 (2015) (Alito, J., concurring) (“Content-based laws merit this protection because they present, albeit sometimes in a subtler form, the same dangers as laws that regulate speech based on viewpoint.”); FARBER, *supra* note 306, at 23 (“Within the category of content-based regulations, those relating to the viewpoint expressed by the speaker are more heavily disfavored than those based on subject matter or other message characteristics.”); Smith, *supra* note 21, at 466 (“Interestingly, no court has yet found that Section 2(a) constitutes an impermissible restriction on free speech.”); *id.* at 467-68 (“Many have suggested that Section 2(a) represents an unjustified restriction on First Amendment freedoms.”) (citing *Pace*, *supra* note 17; *Lefstin*, *supra* note 44); *Lefstin*, *supra* note 44, at 679-81 (discussing

laws—those that target speech based on its communicative content—are presumptively unconstitutional and may be justified only if the government proves that they are narrowly tailored to serve compelling state interests.”³²⁴ Justice Thomas has explained that “[a] law that is content based on its face is subject to strict scrutiny regardless of the government’s benign motive, content-neutral justification, or lack of ‘animus toward the ideas contained’ in the regulated speech.”³²⁵ Simply stated, the § 2(a) “may disparage” prohibition denies trademark registration to marks that have the potential to offend persons, institutions, or beliefs.³²⁶ It is clear that the “may disparage” prohibition of § 2(a) is a content-based and/or viewpoint-based restriction. Consider the paradigmatic example of Native American names and imagery. Indian logos, names, and even ceremonial dances are permitted to show honor, tradition, and respect but not allowed if a substantial composite of Native Americans sues and complains that they are disparaging.³²⁷

content-based and viewpoint-based analysis). But for our purposes, the distinction is negligible and mostly irrelevant.

324. *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2226 (2015); *id.* at 2227 (“Government regulation of speech is content based if a law applies to particular speech because of the topic discussed or the idea or message expressed.”). *Reed* is a case involving the regulation of signs. Signs serve functions that are in many respects similar to trademarks—they call attention to products and/or services by reaching out to convey a message to the public.

325. *Id.* at 2228 (quoting *Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 429 (1993)); *see also id.* at 2229 (“Innocent motives do not eliminate the danger of censorship presented by a facially content-based statute, as future government officials may one day wield such statutes to suppress disfavored speech.”); FARBER, *supra* note 306, at 23 (“Government regulations linked to the content of speech receive severe judicial scrutiny.”).

326. *See* FARBER, *supra* note 306, at 30-31 (“Offensiveness is usually considered a content-related characteristic, because the degree of offense is likely to relate to the conduct’s perceived meaning.”); *see also id.* at 36 (“Listeners are expected to decide for themselves what they want to hear and whether they believe it. Those who are offended by speech are expected to take care of themselves. The audience is not considered to be in need of protection.”).

327. The CAFC makes the exact point: “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.” *In re Tam*, 808 F.3d 1321, 1336 (Fed. Cir. 2015); *see also* FARBER, *supra* note 306, at 32 (“The phrase ‘viewpoint discrimination’ is not self-explanatory. Presumably, the idea is that some perspectives on a topic are allowed while opposing views are not.”); Finkelstein, *supra* note 3, at 332 (“[A]s was noted in *Harjo III*, the context for using the name is critical, and this is what differentiates a disparaging use from a festive use in the sporting arena.”) (citing *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 145 (D.D.C. 2003); Wallace, *supra* note 5, at 208 (“[I]t is imperative to be aware of the sharp distinction between tribute and rebuke for

Although the First Amendment protections are robust, there are, nevertheless, a limited number of categories of speech considered to fall outside the protections of the First Amendment. Libel, incitement to violence, obscenity,³²⁸ child pornography, fighting words,³²⁹ and false advertising are the categories of speech traditionally considered “unprotected speech.”³³⁰ But trademarks such as “The Slants” or “Redskins” or even the Cleveland Indians’ Chief Wahoo logo do not constitute libel, incitement to violence, obscenity, child pornography, fighting words, or false advertising.

Even those who are only casually familiar with the complexities of the First Amendment have probably heard of Justice Holmes’s famous example of “falsely shouting fire in a theatre and causing a panic,” and his framing the First Amendment question as “whether the words used are used in such circumstances and are of such a nature as to create a clear and present danger that they will bring about the substantive evils that Congress has a right to prevent.”³³¹ Under even the somewhat old-fashioned clear-and-present-danger test articulated by Justice Holmes in *Schenck v. United States*, it seems that Congress does not have a right to prevent registration of marks that “may disparage.”³³²

An important case that modified, or at least clarified, the clear-and-present-danger test is *Brandenburg v. Ohio*.³³³ *Brandenburg* involved a KKK member who participated in rallies and openly discussed advocacy of violence. “The Court . . . held advocacy of violence [is] protected by the First

the historical Native American image, as it is one easily abused and misrepresented in modern culture. Moreover, the use of ‘American Indian dress, dance, and tradition . . . for purely entertainment purposes has a particularly deleterious effect because it trivializes the very basis of many cultural and religious beliefs.’ In this way, the use of Native American imagery for sports logos can create a distinct schizophrenia of identity for Native Americans attempting to maintain a sense of cultural history.”) (quoting Blankenship, *supra* note 5, at 424).

328. For insights and discussion regarding “obscenity,” see generally NOWAK & ROTUNDA, *supra* note 10, §§ 16.56-16.61, at 1513-38.

329. *See id.* § 16.37, at 1409 (“Yet fighting words also can be an incitement to unthinking, immediate, violent *action*, just like falsely shouting fire in a crowded theater immediately incites action (that is, a riot). The immediate reaction means that there is no time to debate, to trust the free marketplace of ideas.”).

330. *See id.* § 16.1(b), at 1253-55; FARBER, *supra* note 306, at 33.

331. *Schenck v. United States*, 249 U.S. 47, 52 (1919); *see* NOWAK & ROTUNDA, *supra* note 10, § 16.13(b), at 1292.

332. For a discussion of the clear and present danger doctrine, see, for example, NOWAK & ROTUNDA, *supra* note 10, §§ 16.12-16.15, at 1291-1303.

333. 395 U.S. 444 (1969).

Amendment as long as the advocacy did not incite people to *imminent* action.”³³⁴ According to the Court, the government lacks the power “to forbid . . . advocacy of the use of force or of law violation except where such advocacy is directed to inciting or producing imminent lawless action and is likely to incite or produce such action.”³³⁵ “Later cases proclaim as central to the First Amendment the principle that every idea, no matter how hateful, is entitled to full constitutional protection.”³³⁶ “[W]e have learned that we can live rather comfortably while accommodating a fair amount of political craziness around the fringes of society.”³³⁷

Although many forms of expression are protected under the high threshold of the clear-and-present-danger test, the Court has upheld statutes that prohibit true threats. The defendants in *Virginia v. Black*³³⁸ violated a state cross-burning statute. Intent to intimidate was an element of the crime.³³⁹ Here the Supreme Court found that there was intimidation “where a speaker directs a threat to a person or group of persons with the intent of placing the victim in fear of bodily harm or death.”³⁴⁰ The Court held that a state may constitutionally ban cross burning with intent to intimidate because such a statutory ban would prevent a “true threat.” This case involves an example of a threat that crosses the line from mere intimidation to an actual “true threat” constituting one of “those forms of intimidation that are most likely to inspire fear of bodily harm.”³⁴¹ The Virginia cross-burning statute is a far cry from § 2(a)’s “may disparage” prohibition; likewise burning a cross in front of someone’s house is a far cry from using the word “Redskins” and a visual

334. NOWAK & ROTUNDA, *supra* note 10, § 16.15(c), at 1301 (2010); *see* FARBER, *supra* note 306, at 77 (“[U]nder *Brandenburg*, advocacy of violence can be prohibited only when (1) it is directed to inciting imminent lawless action, and (2) it is likely to produce such action.”).

335. *Brandenburg*, 395 U.S. at 447.

336. FARBER, *supra* note 306, at 86; *see also id.* (In the wake of *Brandenburg*, “[t]he burden is now placed on advocates of government regulation to show that the ‘suppression of ideas’ is not their agenda.”).

337. *Id.*; *see also* NOWAK & ROTUNDA, *supra* note 10, § 16.1(d), at 1259-60.

338. 538 U.S. 343 (2003).

339. *Id.* at 348; *see* FARBER, *supra* note 306, at 84 (“Under the statute, burning a cross was prima facie evidence of the required intent to intimidate.”).

340. *Black*, 538 U.S. at 360.

341. *Id.* at 363.

image of an American Indian, reminiscent of the Buffalo nickel, as trademarks.³⁴²

One commentator has described the case of the Native Americans in the *Harjo* and *Blackhorse* litigations as follows: “The Native Americans . . . simply wish to attend sporting events and read the sports section in the newspaper without feeling uncomfortable or upset because of the mocking logos.”³⁴³ It is abundantly clear that the First Amendment cannot permit a statute to restrict speech on the basis that it might make someone feel uncomfortable or upset them.³⁴⁴ “Since Section 2(a) contains a content-based restriction that conditions the benefits accorded by federal registration upon a finding that the trademark is not immoral, scandalous, or disparaging, it abridges the trademark owner’s First Amendment rights. The government is, in effect, attempting to suppress speech through the denial of trademark registration.”³⁴⁵

2. *Overbreadth & Vagueness*³⁴⁶

a) *Overview*

Modern First Amendment doctrine holds that a statute may be void if it is overbroad or if its language is too vague.³⁴⁷ “Under the First Amendment overbreadth doctrine, an individual whose own speech or conduct may be

342. See FARBER, *supra* note 306, at 119 (“Under current law, the offensiveness of certain forms of expression provides a basis for government regulation only under narrow circumstances. First, deliberate efforts to incite a violent response from the audience probably can be banned under the ‘fighting words’ doctrine. Second, captive audiences can be protected from offensive speech, but only where the speech constitutes an ‘intolerable invasion of privacy’ (particularly within the home).”).

343. Grose, *supra* note 41, at 701.

344. See FARBER, *supra* note 306, at 119 (“This set of doctrines limits the state’s ability to ban hate speech purely on the basis of its offensiveness or emotional impact.”).

345. Pace, *supra* note 17, at 38.

346. Much of the discussion in this section is also relevant to the discussion below in Section IV.B. “Commercial Speech Analysis,” because, if statutory language is either overbroad or vague (or both), arguably it is not “narrowly tailored” to achieve an objective. See also NOWAK & ROTUNDA, *supra* note 10, § 16.8(e), at 1277 ([I]t is not entirely clear to what extent the overbreadth doctrine applies to so-called commercial speech. . . . [I]f speech is deemed to be commercial speech, then the overbreadth analysis is probably inapplicable. . . . Although the Court will not employ overbreadth analysis to invalidate a regulation of commercial speech that is designed to stop false or misleading commercial practices, the Court will require the government to regulate commercial speech in a manner that is ‘not more extensive than necessary’ to serve a substantial government interest.”).

347. See generally *id.* §§ 16.8 through 16.9, at 1274-81.

prohibited is permitted to challenge a statute on its face ‘because it also threatens others . . . who desire to engage in legally protected expression but who may refrain from doing so rather than risk prosecution or undertake to have the law declared partially invalid.’”³⁴⁸ Furthermore, “[t]he vagueness rule is related to the Court’s longtime concern over standardless administrative discretion in speech cases.”³⁴⁹ For example, using the void-for-vagueness doctrine, the Supreme Court held unconstitutional a New York statute that banned “sacrilegious” movies.³⁵⁰ In another important case construing vagueness, the Southern District of Indiana held unconstitutional a state statute that regulated speech depicting the “sexually explicit subordination of women.”³⁵¹ The key word that rendered the statute unconstitutional for its vagueness was “subordination.”³⁵² One especially pernicious characteristic of the vagueness of the “may disparage” prohibition of § 2(a), and similar to a statute prohibiting “sacrilegious” movies or materials with sexual “subordination,” is that its lack of clarity increases the likelihood that “it might have an *in terrorem* effect and deter persons from engaging in protected activities.”³⁵³ The language of § 2(a) is both overbroad and vague. Interestingly, both of the key words—“may” and “disparage”—contribute to its overbreadth and vagueness.

348. Board of Airport Comm’rs v. Jews for Jesus, Inc., 482 U.S. 569, 574 (1987) (quoting Brockett v. Spokane Arcades, Inc., 472 U.S. 491, 503 (1985)).

349. FARBER, *supra* note 306, at 55. Arguably, this is precisely the problem that § 2(a)’s “may disparage” prohibition presents, because it allows a trademark examining attorney standardless discretion when determining whether to allow or deny registration for an applicant whose mark “may disparage.” See also NOWAK & ROTUNDA, *supra* note 10, § 16.9(b), at 1280-81 (“Several rationales justify special judicial strictness to insure that laws that regulate speech, a fundamental constitutional right, are not vague.”).

350. Joseph Burstyn, Inc. v. Wilson, 343 U.S. 495 (1952).

351. Am. Booksellers Ass’n, Inc. v. Hudnut, 598 F. Supp. 1316, 1320 (S.D. Ind. 1984), *aff’d*, 771 F.2d 323 (7th Cir. 1985), *aff’d sub nom.*, Hudnut v. Am. Booksellers Ass’n, Inc., 475 U.S. 1001 (1986), *reh’g denied*, 475 U.S. 1132 (1986).

352. *Id.* at 1338; see HAND, *supra* note 10, at 12 (“The issues that arise are often extremely baffling, and the answers are not obvious. They demand, not only a detached approach, but a training in verbal analysis by no means general among legislators, even though they are usually lawyers.”).

353. NOWAK & ROTUNDA, *supra* note 10, § 16.9(b), at 1281.

b) “May”

The word “may” renders the prohibition overbroad and vague.³⁵⁴ By definition the word “may” ordinarily implies mere possibility not probability. The 1937 *Funk & Wagnalls New Standard Dictionary of the English Language* defines “may.”

1. To have permission; be allowed; have the physical or moral opportunity; as, you *may* go; you *might* have seen his love in what he did. . . .
2. To be contingently possible; as, it *may* be; you *may* get off, altho you do not deserve it. In this contingent sense of the word *may*, it is frequently used to form compound tenses of the subjunctive or potential modes of other verbs.³⁵⁵

But interestingly, and perhaps most importantly, this standard dictionary published at the very time that the “may disparage” prohibition of § 2(a) was being drafted has a separate entry defining the word “may” in a legal context. “6. *Law*. To have liberty or power to: often (in the construction of statutes) held to mean *must*, as imposing obligation, tho in every other use *may* has only a permissive or discretionary connotation.”³⁵⁶ This suggests that the drafters likely intended the “may disparage” language to have this stronger, obligatory meaning, “must disparage.” Yet, apparently, the TTAB and courts have failed to recognize and apply this historically contemporary meaning. The TTAB has expressed the view that the word “may” in § 2(a) simply means that *intent* to disparage is not required.³⁵⁷ Although this

354. *See Pace, supra* note 17, at 33 (“The statute does not prohibit ‘matter which disparages;’ rather, it prohibits ‘matter which *may* disparage.’ The latter is certainly a broader prohibition than the former. This Article argues that, unlike the test for scandalous matter, which is limited to an inquiry of whether the matter is scandalous at the time the applicant is seeking registration, the presence of the word ‘may’ in the disparagement language expresses Congress’ intent that marks that could or might be disparaging, even if they are not considered so at the time of the application, should be barred from federal registration.”).

355. FUNK & WAGNALLS NEW STANDARD DICTIONARY OF THE ENGLISH LANGUAGE 1531 (Isaac K. Funk ed., 1937) [hereinafter FUNK & WAGNALLS].

356. *Id.*

357. *See, e.g., Smith, supra* note 21, at 473 (quoting the TTAB’s *Harjo* decision for the proposition that the word “may” in § 2(a) does not require intent to disparage: “Thus, we believe the use of the term ‘may’ is necessary in connection with ‘disparage’ in Section 2(a) to avoid an interpretation of this statutory provision that would require a showing of intent to disparage.”).

construction is plausible, it is certainly neither a particularly obvious nor a necessarily accurate construction.

Although the drafters of the Lanham Act may have intended the meaning of “must disparage” as indicated by the 1937 *Funk & Wagnalls*, they certainly were capable of expressing a higher degree of probability than that which the word “may” ordinarily suggests when that is what they intended. The standard of “likely . . . to cause confusion, or to cause mistake, or to deceive”³⁵⁸ for example implies a greater degree of probability by using the word “likely” rather than the word “may.”³⁵⁹ “Likely” at a minimum implies that something has at least close to a 50% probability of occurrence. In this regard “likely” is similar to the legal term “foreseeable.”³⁶⁰ But § 2(a) does not state “is likely to disparage” and, unless we interpret “may” in its obligatory sense suggested by the 1937 *Funk & Wagnalls*, it fails to impose a rule that requires any appreciable degree of probability. By using the word “may,” Congress left the door open to arguments that even a scintilla of evidence of disparagement would suffice. As such, § 2(a) is overbroad.

The Supreme Court has on a number of occasions articulated its statutory construction of the word “may.” Unfortunately, the cases do not necessarily solve the riddle. For example, the Court recently stated that “[t]he word ‘may’ customarily connotes discretion” and noted that “[t]hat connotation is particularly apt where . . . ‘may’ is used in contraposition to the word ‘shall’”³⁶¹ Similarly, in *United States v. Rodgers*, the Court remarked

358. 15 U.S.C. § 1052(d) (2012).

359. See 1 MCCARTHY, *supra* note 13, § 23:1; *id.* § 23:3.

360. See, e.g., W. Jonathan Cardi, *Purging Foreseeability*, 58 VAND. L. REV. 739, 743 (2005) (“*Black’s Law Dictionary* defines the term ‘foreseeability’ as ‘[t]he quality of being reasonably anticipatable.’ According to *Random House*, the verb ‘to foresee’ means ‘to have prescience of; to know in advance.’” (footnote omitted)); Banks McDowell, *Foreseeability in Contract and Tort: The Problems of Responsibility and Remoteness*, 36 CASE WESTERN RES. L. REV. 286, 290 (1985-86) (“Foreseeability is used in everyday language to describe actual, subjective awareness of possible future occurrences. It carries a sense of prevision, a consciousness of the possibilities of future happenings, and also implies the ability to plan for those future possibilities. A foresighted person sees into the future and takes necessary precautions to protect himself and others while taking advantage of opportunities. Thus, foreseeability is an integral part of prudent human behavior. To the extent that we expect humans to be rational beings, they must be charged with some degree of foreseeability.” (footnote omitted)); *id.* at 295 (“What the court expects a defendant should have foreseen is what the ‘reasonable man’ would have foreseen.”).

361. *Jama v. Immigration & Customs Enf’t*, 553 U.S. 335, 346 (2005); see also *Anderson v. Yungkau*, 329 U.S. 482, 485 (1947) (construing the word “may” as

that “[t]he word ‘may,’ when used in a statute, usually implies some degree of discretion” but also added that “legislative intent to the contrary or . . . obvious inferences from the structure and purpose of the statute” could necessitate a different conclusion.³⁶² In *United States v. Thoman*, a late-nineteenth century case discussing the word “may” and citing even earlier cases, the Court said that the meaning of the word “may” “depends on the context of the statute, and on whether it is fairly to be presumed that it was the intention of the legislature to confer a discretionary power or to impose an imperative duty.”³⁶³ Additionally, in *Moore v. Illinois Central Railroad Company*, construing an amendment to the Railway Labor Act of 1934, where Congress changed “shall” (which had been in the 1926 version of the statute) to “may,” the Court said that the change was merely a clarification that the Act was not “based on a philosophy of legal compulsion.”³⁶⁴ Hence the Court interpreted “may” to indicate nothing stronger than mere possibility. There is at least one case, however, where the Court interpreted the word “may” to mean “probability” and not “mere possibility.”³⁶⁵ But Justice Day expressly stated that that interpretation was based on the specific language and context clues in the statute (the Clayton Act) itself—namely the inclusion of the word “substantially.”³⁶⁶ Therefore, the Supreme

“permissive” in Rule 25(a) of the Federal Rules of Civil Procedure); *Livers v. Anderson*, 326 U.S. 219, 223 (1945) (remarking that “may” does not mean “must” nor does it imply that something is mandatory); *Farmers’ & Merchs.’ Bank of Monroe v. Fed. Reserve Bank of Richmond*, 262 U.S. 649, 662-63 (1923) (“It is true that in statutes the word ‘may’ is sometimes construed as ‘shall.’ But that is where the context, or the subject-matter, compels such construction. *Supervisors v. United States*, 4 Wall. 435. Here it does not. This statute appears to have been drawn with great care. Throughout the act the distinction is clearly made between what the Board and the reserve banks ‘shall’ do and what they ‘may’ do.”).

362. 461 U.S. 677, 706 (1983); *see also* *Cortez Byrd Chips, Inc. v. Bill Harbart Constr. Co.*, 529 U.S. 193, 198-99 (2000) (quoting *Rodgers*).

363. 156 U.S. 353, 359 (1895) (citations omitted).

364. 312 U.S. 630, 635 (1941).

365. *Standard Fashion Co. v. Magrane-Houston Co.*, 258 U.S. 346, 356-57 (1922); *see also* *Corn Prods. Ref. Co. v. F.T.C.*, 324 U.S. 726, 742 (1945). Citing *Standard Fashion*, the Court said: “As we have said, the statute does not require that the discriminations must in fact have harmed competition, but only that there is a reasonable possibility that they ‘may’ have such an effect.” *Id.*

366. *Standard Fashion Co.*, 258 U.S. at 356-57 (“Section 3 condemns sales or agreement where the effect of such sale or contract of sale ‘may’ be to substantially lessen competition or tend to create monopoly. It thus deals with consequences to follow the making of the restrictive covenant limiting the right of the purchaser to deal in the goods of the seller only. But we do not think that the purpose in using the word ‘may’ was to prohibit the mere possibility of the consequences described. It was intended to prevent such agreements as

Court precedents illustrate the malleable nature of the word “may.” It spans a continuum reaching from mere possibility, to probability, to mandate—depending on the circumstances. Because the Court has acknowledged that “may” typically implies varying degrees of discretion and because the Court has also recognized that it has many shades of meaning, depending on the context and circumstances, the logical conclusion is that the “may disparage” prohibition of § 2(a) is both overbroad and vague.

Butler v. Michigan involved a Michigan statute that criminalized books that had the potential to harm minors.³⁶⁷ The Supreme Court held that the statute was both overbroad and vague.³⁶⁸ It was overbroad for the same reason that the “may disparage” prohibition of § 2(a) is overbroad—the *mere possibility* of causing harm casts too wide a net. In the words of the Court, “Surely, this is to burn the house to roast the pig.”³⁶⁹ The plain meaning of the word “may” renders § 2(a) overbroad, and the interpretations offered by the TTAB and the Supreme Court also demonstrate why it is vague.

c) “Disparage”

Similarly, § 2(a)’s use of the word “disparage” is vague. The Lanham Act, itself, does not define the term “disparage.”³⁷⁰ Most commentators who have looked into the issue have noted with surprise that the legislative history of the “may disparage” prohibition of § 2(a) is of little use, and the CAFC poignantly noted that “[i]t had no roots in the earlier trademark

would under the circumstances disclosed probably lessen competition, or create an actual tendency to monopoly. That it was not intended to reach every remote lessening of competition is shown in the requirement that such lessening must be substantial.”)

367. 352 U.S. 380 (1957); *see also* NOWAK & ROTUNDA, *supra* note 10, § 16.61(b)(1), at 1525-26 (discussing *Butler*).

368. *See Butler*, 352 U.S. at 382-84.

369. *Id.* at 383.

370. *See Compton*, *supra* note 7, at 18 (“No statutory definition of what constitutes a disparaging mark is provided in the Lanham Act. Due to this lack of a basic framework, the Trademark Office and the TTAB has been left to create its own definition and test for determining if a mark is disparaging.”) (footnote omitted); Kiser, *supra* note 3, at 8 (“An analysis of potentially disparaging trademarks is further complicated by the fact that the legislature failed to include a definition of what constitutes a ‘disparaging’ mark under section 2(a). At first, the USPTO and the TTAB solved this problem by either conflating the treatment of disparaging marks with the jurisprudence on obscene or scandalous marks, or by barring registration only when the disparagement appeared ‘obvious’ in the eyes of the examining attorney or the TTAB.”) (footnote omitted).

statute or the common law.”³⁷¹ In the legislative hearings regarding the bill, the Assistant Commissioner of Patents, Leslie Frazer, acknowledged that the word “disparage” was likely “to cause a great deal of difficulty in the Patent Office, because . . . it is always going to be just a matter of personal opinion of the individual parties as to whether they think it [i.e., the applicant’s mark] is disparaging.”³⁷² Commissioner Frazer concluded by requesting, “I would like very much to see some other word substituted for that word ‘disparage.’”³⁷³ Representative Lanham, for whom the Act is named, immediately concurred and asked for suggested revisions.³⁷⁴ Unfortunately, there is nothing in the record to indicate that there was any subsequent follow-through on this important issue.

In her law review article twenty years ago, Judge Moore suggested that “[s]ince the legislative history does not reveal Congress’ intent in using the word ‘disparage,’ it should be given its ordinary and common meaning at the time of the Lanham Act’s enactment. Dictionaries of that time defined ‘disparage’ as ‘[t]o speak slightly of; to undervalue; to discredit,’ and ‘to dishonor by bringing discredit or reproach upon . . . depreciate, cheapen.’”³⁷⁵

371. *In re Tam*, 808 F.3d 1321, 1330 (Fed. Cir. 2015); *see, e.g.*, Hopkins & Joraanstad, *supra* note 4, at 275 (“Unfortunately, the legislative history of the Lanham Act does not offer much insight as to what constitutes what is ‘scandalous,’ ‘immoral,’ or when a mark may ‘disparage.’”); Kiser, *supra* note 3, at 7 (“The legislative history for section 2(a) does not indicate the legislature’s goals for, or reasoning behind, adding this disparagement prohibition to federal trademark registration . . .”). For more on the legislative history of the Lanham Act, *see generally* 1 MCCARTHY, *supra* note 13, § 5:4.

372. *Hearing on H.R. 4744 Before the Subcomm. On Trademarks, H. Comm. on Patents*, 76th Cong. 18 (1939) (statement of Leslie Frazer) [hereinafter *Hearing on H.R. 4744*].

373. *Id.*

374. Mr. Lanham replied, “That seems to me, in the light of administration, to be a very pertinent suggestion, and if you gentlemen can clarify that with verbiage you suggest it would be helpful.” *Id.* at 21 (statement of Rep. Fritz Lanham). Given the nearly universal agreement that the word “disparage” is a vague term, it is somewhat surprising that Judge Lee, in considering Fifth Amendment challenges to § 2(a), disagreed, holding that the “may disparage” language of § 2(a) is not vague. *See Pro-Football v. Blackhorse*, 112 F. Supp. 3d 439, 464-68 (E.D. Va. 2015); *cf. HAND, supra* note 10, at 19 (“What does a body of men like a legislature ‘mean’ by the words contained in a statute? What ‘points’ are ‘present’ to their minds? Indeed what ‘points’ were common in the minds of a majority of those who voted? These are unanswerable questions[.] All we know is that a majority has accepted the sequence of words in which the ‘law’ has been couched, and that they expect the judges to decide whether an occasion before them is one of those that the words cover.”).

375. Pace, *supra* note 17, at 32 (footnotes omitted); *see also Cummings, supra* note 5, at 322 (“Under the Lanham Act, ‘disparagement’ is defined as ‘dishonor by comparison with

Indeed, during the 1930s when the “may disparage” language was added to the bill, the Oxford English Dictionary provided several definitions of “disparage”: (1) “To match unequally; to degrade or dishonour by marrying to one of inferior rank”; (2) “To bring discredit or reproach upon; to dishonour, discredit; to lower in credit or esteem”; (3) “To lower in position or dignity; to degrade”; (4) “To lower in one’s own estimation; to cast down”; (5) “To speak of or treat slightly; to treat as something lower than it is; to undervalue; to vilify.”³⁷⁶

The 1937 *Funk & Wagnalls New Standard Dictionary of the English Language* defines “disparage,” in part, as follows:

1. To regard or speak of slightly. . . .
2. To affect or injure by unjust comparison, as with that which is unworthy, inferior, or of less value or importance; as, I do not say this to *disparage* your country.
3. [Rare] To degrade in estimation by detractive language or by dishonoring treatment; lower; dishonor; as, such conduct *disparages* religion.
4. To degrade by marrying below one’s rank or station.³⁷⁷

These definitions range from very slight or minor negativity—“discredit,” “lower in position,” “speak slightly,” “affect . . . by unjust comparison,”—to rather harsh—“vilify.”³⁷⁸ As such, § 2(a)’s “may disparage” prohibition has the potential to prevent registration of marks that

what is inferior.”) (citing *Harjo*, *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1738 (T.T.A.B. 1999)); Hughey, *supra* note 5, at 346 (“The TTAB, relying on the dictionary, defined disparaging as matter that ‘may dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison.’”) (citing *Harjo*, 50 U.S.P.Q.2d (BNA) at 1738); *id.* at 358-59 (“A disparaging mark is one that dishonors by association with that which is inferior or slight, or that deprecates, degrades, or injures by unjust comparison.”) (citing *Harjo*, 50 U.S.P.Q.2d (BNA) at 1738); Kiser, *supra* note 3, at 8-9 (citing and quoting definitions of “disparage” drawn from *Hines* and *Harjo*).

376. OXFORD ENGLISH DICTIONARY 476 (1933) (reprinted 1961). In *Blackhorse*, Judge Lee also considered various dictionary definitions of “disparage.” See *Blackhorse*, 112 F. Supp. 3d 439; see also JEROME HALL, FOUNDATIONS OF JURISPRUDENCE 82 (1973) (“[O]rdinary words are used in a technical legal sense, and it requires a great deal of study, in effect a legal education, to understand how those terms are used.”).

377. FUNK & WAGNALLS, *supra* note 355, at 728 (illustration after definition number one omitted).

378. Some commentators have taken liberties with the statute’s wording. For example, one student author offered his own interpretation, declaring that, “[b]y its own language, the Lanham Act provides a basis for the cancellation of a trademark that is considered distasteful or harmful to individuals or groups.” Grose, *supra* note 41, at 701.

have a wide range of interpretations, even marks that possess a faint possibility of discrediting persons, institutions, or beliefs. In her law review article, Judge Moore explains the matter succinctly:

Tribunals have agreed that determining whether a mark is disparaging is highly subjective. The TTAB, which is charged with enforcing the Lanham Act, has held that the terms “scandalous” and “disparage” are “somewhat vague.” These terms render Section 2(a) void for vagueness because they fail to provide the public and the PTO with sufficient guidance as to which trademarks should be prohibited registration. These vague and highly subjective tests do not provide meaningful guidance for the PTO.³⁷⁹

It is apparent in the legislative history that none of the concerns discussed during the hearings related to scenarios like those present in *Hines*, *Heeb Media*, or, for that matter, *Harjo* and *Blackhorse* (i.e., scenarios involving the disparagement of groups of persons).³⁸⁰ Rather, the scenarios discussed concerned the potential disparagement of former Presidents (e.g., Benjamin Harrison, George Washington, and Abraham Lincoln).³⁸¹ In her analysis of the legislative history, Professor Compton perceptively notes:

379. Pace, *supra* note 17, at 50 (footnotes omitted); see *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654 (T.T.A.B. 1990) (“Because the guidelines are somewhat vague and because the determination is so highly subjective, we are inclined to resolve doubts on the issue of whether a mark is scandalous or disparaging in favor of applicant and pass the mark for publication with the knowledge that if a group does find the mark to be scandalous or disparaging, an opposition proceeding can be brought and a more complete record can be established.”); see also Kiser, *supra* note 3, at 18 n.115 (quoting this language and summarizing the case).

380. See Compton, *supra* note 7, at 11-15.

381. *Hearing on H.R. 4744*, *supra* note 372, at 18.

Mr. Robertson. . . . Why should the Congress of the United States, for example, permit Benjamin Harrison's name . . . to be used as a trade-mark on any article, device, or merchandise, even though dead?

Mr. Marony. In other words, we would not want to have Abraham Lincoln gin.

Mr. Robertson. No, sir; we would not.

Mr. Fenning. Or George Washington coffee.

Mr. Rogers. There was a good deal of discussion last year about that very thing, and considerable difficulties seem to arise in connection with it which ever way we jump. I quite agree that Abraham Lincoln gin ought not to be

What is absent from this debate on this portion of the Act is the concern or desire to enact a law that protects individuals . . . unless that individual is well known. With this in mind, the drafters of the Lanham Act appear to be more concerned about “trademark disparagement” (false or misleading claims about another’s trademark, goods or services, or business) and less about trademarks that might disparage others personally (even non-trademark holders).³⁸²

In this regard, the drafters seem to have been worried about cases like *Greyhound*, where one mark might disparage another’s mark.³⁸³ And one intriguing possibility is that the First Restatement of Torts, promulgated in 1938, just one year before the hearings relating to the wording of § 2(a) took place, may have influenced the drafters of the Lanham Act. It stands to reason that the drafters must have been aware of the First Restatement. Section 624 of the First Restatement, which imposes liability for the tort of disparagement, provides:

One who, without a privilege to do so, publishes matter which is untrue and disparaging to another’s property in land, chattels or intangible things under such circumstances as would lead a reasonable man to foresee that the conduct of a third person as purchaser or lessee thereof might be determined [sic] thereby is liable for pecuniary loss resulting to the other from the impairment of vendibility thus caused.³⁸⁴

used, but I would not say the use of G. Washington on coffee should not be permissible. We attempted to take care of it in subsection (a) of section 2: “Consists of or comprises immoral, deceptive, or scandalous matter; or matter which tends to disparage persons, living or dead, institutions, beliefs, or national symbols, or to bring them into contempt.” That would take care of the abuses, but it would not prevent the perfectly legitimate uses of names.

Id.; see also *In re Tam*, 808 F.3d 1321, 1336 (Fed. Cir. 2015).

382. Compton, *supra* note 7, at 12 (footnotes omitted); see also Ward & Quick, *supra* note 26, at 52 (“The Lanham Act does not provide a definition of ‘disparaging,’ and there is little legislative history on this section. According to the Federal Circuit, the legislative history of the Lanham Act indicates that § 2(a) was intended to preclude registrations that conflict with another’s rights, such as the right of privacy and the right of publicity.”) (citing *University of Notre Dame du Lac v. J.C. Gourmet Food Imps.*, 703 F.2d 1372, 1375-76 (Fed. Cir. 1983)).

383. See *supra* Section I.B.2.

384. RESTATEMENT OF TORTS § 624 (AM. LAW INST. 1938).

Section 629 of the First Restatement defines “disparagement”:

Matter which is intended by its publisher to be understood or which is reasonably understood to cast doubt upon the existence or extent of another’s property in land, chattels or intangible things, or upon their quality, is disparaging thereto, if the matter is so understood by its recipient.³⁸⁵

Both the language and concepts embodied in these First Restatement sections seem to reflect outdated, nearly archaic, sensibilities. They were certainly written in an era long before modern First Amendment doctrine began to take on its contemporary shape. Still, it is particularly relevant that this provision expressly includes “intangible things,” given that trademarks are such an important subset of intangible property. Comment a. further explains: “The definition in this Section includes not only statements by words or other conduct, or both, which expressly or by implication deny the existence or extent of another’s legally protected interest in land, chattels and intangible things, but also statements which attack the quality of the land and other things.”³⁸⁶ The core concepts of “disparagement” under this provision, then, include: (1) a denial of the existence of property; (2) a denial of the extent of an interest of a person’s interest in property; and (3) an attack on the quality of a person’s property. These concerns certainly sound similar to the concerns expressed in the Lanham Act hearings³⁸⁷ and also similar to the issues present in *Greyhound*.³⁸⁸ If these First Restatement sections relating to disparagement are indeed the smoking gun that explains the genesis of the “may disparage” prohibition of § 2(a), then the cases that have attempted to apply it to groups of persons using ordinary definitions of “disparage” have missed the mark by a wide margin.

385. *Id.* § 629.

386. *Id.* § 629 cmt. a. Another possible explanation for the sudden appearance of the word “disparage” in the 1939 draft of the Lanham Act is the case *Hahn v. Duveen*, 133 Misc. 871, 234 N.Y.S. 185 (Sup. Ct. 1929). In *Hahn*, the owner of a painting purported to be an original by Leonardo Da Vinci sued an art critic for disparagement. The critic publicly asserted that the painting was not an original Da Vinci, even though his opinion contradicted the opinion of a well-known French critic, who had previously rendered his opinion that the painting was an original. The jury was unable to reach a decision and the case was settled before retrial. See Ralph E. Lerner and Judith Bresler, Practising Law Institute, Art Law (4th Ed. 2012), Chapter 7 Expert Opinions and Liabilities pp. 493-97.

387. See *supra* notes 12, 126, 274-79, 283, 285-86; *infra* notes 293, 480, 567, and accompanying texts.

388. See *supra* Section I.B.2.

It is certain, nevertheless, that the concern raised during the legislative hearings was real: determining the meaning of “disparage” is highly subjective.³⁸⁹ The subjective nature of the word “disparage” serves as additional proof of just how vague the “may disparage” prohibition of § 2(a) really is.³⁹⁰ And the greater the degree of vagueness in the language, the less it appears to be “narrowly tailored” in a manner that comports with commercial speech analysis, discussed below in Section IV.B.³⁹¹ In order to be “narrowly tailored,” the language would need greater precision.

On its face, the statute is both overbroad and vague and thus violates the First Amendment.³⁹² Consequently, traditional First Amendment analysis recommends that, as both overbroad and vague, the “may disparage” prohibition of § 2(a) cannot withstand First Amendment scrutiny.

B. Commercial Speech Analysis³⁹³

1. Trademarks As Commercial Speech & Central Hudson

As source identifiers, trademarks can be considered a form of commercial speech. “Commercial speech may be understood as speech of any form that advertises a product or service for profit or for other business purpose.”³⁹⁴ In *Friedman v. Rogers*, the Supreme Court showed no hesitation in treating a Texas statute relating to trade names as a law about commercial speech.³⁹⁵ In fact, Justice Powell’s opinion assumes that trade

389. See *supra* notes 12, 126, 274-79, 283, 285-86; *infra* notes 293, 480, 567, and accompanying texts. See also, e.g., Compton, *supra* note 7, at 24 (“The most notable problem with the application of the disparaging test is that it is too subjective and instills too much power in one person (the examining attorney) to determine the validity of the term as a trademark.”); Kiser, *supra* note 3, at 9 (“Determining whether a trademark is disparaging is still a very subjective matter despite the two-part test clarified in *Harjo I.*”).

390. See Hall, *supra* note 376, at 135 (“The difficulty results from the fact that what seems to be a simple question turns out to be a large array of problems that involve whole philosophies of law and an inevitable degree of subjectivity.”).

391. See *infra* Section IV.B.

392. See FARBER, *supra* note 306, at 53-57; see also Pace, *supra* note 17, at 48-49 (arguing that § 2(a) is unconstitutional for three reasons: (1) it is an abridgement of freedom of speech; (2) it is overbroad; and (3) it is void for vagueness).

393. See generally 1 MCCARTHY, *supra* note 13, § 31:139.25; Ann K. Wooster, *Protection of Commercial Speech Under the First Amendment—Supreme Court Cases*, 164 A.L.R. Fed. 1d (2000).

394. NOWAK & ROTUNDA, *supra* note 10, § 16.26, at 1352.

395. 440 U.S. 1, 11 (1979), *reh’g denied*, 441 U.S. 917 (1979); see Wooster, *supra* note 393 (discussing *Friedman*); Lefstin, *supra* note 44, at 673-76 (same); see also NOWAK & ROTUNDA, *supra* note 10, § 16.31(c)(xviii), at 1384-87.

names are a kind of commercial speech. The Lanham Act defines a trademark to include “any word, name, symbol, or device, or any combination thereof” that functions “to identify and distinguish” the goods or services of the mark’s owner.³⁹⁶ Thus, a trademark’s principal functions are to “identify” the owner’s goods and to “distinguish” the owner’s goods. The “distinguish” function requires that marks be sufficiently different from one another so that consumers can tell the difference between goods and services offered by one trademark owner from the goods and services offered by others.³⁹⁷ The “identification” function describes a psychological phenomenon of cognitive association. Consumers who perceive the mark mentally associate that mark with a specific product or service. The identification function, then, serves as a mental version of “connect-the-dots,” whereby consumers’ minds connect, associate, or correlate a mark with a specific product or service.³⁹⁸ Identification is also among the goals of advertising; advertisers want consumers to associate or correlate the message of the advertisement with their company’s products and services. Justice Powell once said that the line that separates commercial speech from non-commercial speech “will not always be easy to draw.”³⁹⁹ Nevertheless, given the functions of trademarks, coupled with Justice Powell’s interpretation in *Friedman*, it is both reasonable and logical to classify trademarks as a form of advertising and, therefore, as commercial speech.⁴⁰⁰

396. 15 U.S.C. § 1127 (2012).

397. This function is the reason why a mark is refused registration if it is likely to cause confusion with another’s mark. *See id.* § 1052(d).

398. *See* 1 MCCARTHY, *supra* note 13, § 3:2 (“To identify one seller’s goods and distinguish them from goods sold by others.”).

399. *In re Primus*, 436 U.S. 412, 438 n.32 (1978).

400. Pace, *supra* note 17, at 35 (“As commercial speech, a trademark is entitled to protection under the First Amendment.”) (citing numerous authorities—both cases and scholarship—for the proposition that trademarks constitute commercial speech, which is entitled to limited First Amendment protection); *see also* Smith, *supra* note 21, at 467 (“[T]rademark protection should be seen as commercial speech, subject to the Supreme Court’s test outlined in *Central Hudson Gas and Electric Corp. v. Public Service Commission of New York*.”) (citing *Central Hudson Gas & Elec. v. Public Serv. Comm’n*, 447 U.S. 557 (1980)); Wallace, *supra* note 5, at 214-15 (“Sports team logos and mascots can be considered commercial speech because ‘they provide consumers with information about the identity and quality of sports teams.’ Commercial speech, unlike political speech, ‘receives limited First Amendment protection.’”) (footnote omitted).

As a rule, the First Amendment shields truthful advertising, but its protection is not as strong as in the case of political speech.⁴⁰¹ Nevertheless, there have been instances where members of the Supreme Court have urged that truthful advertising ought to be treated the same as political speech in terms of the First Amendment.⁴⁰² Presumably, names and logos of both sports teams and rock bands come within the category of “truthful advertising.” In essence, today the Supreme Court treats commercial speech as a hybrid. The seminal case, *Central Hudson*, established the First Amendment analysis that applies to commercial speech.

In commercial speech cases, then, a four-part analysis has developed. 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 a 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.⁴⁰³

This *Central Hudson* test has become the judicial standard for analyzing the intersection of commercial speech and the First Amendment.⁴⁰⁴ Thus, to

401. See FARBER, *supra* note 306, at 16 (“Truthful advertising, however, clearly receives some constitutional protection, though not as much as political speech—some might call it ‘less protected’ speech.”).

402. See *id.* at 172 (“[S]ome Justices have insisted . . . [that] truthful advertising should receive exactly the same constitutional protection as other speech such as political advocacy.”).

403. *Central Hudson*, 447 U.S. at 566; see, e.g., Lefstin, *supra* note 44, at 673; Pace, *supra* note 17, at 38-43 (analyzing and discussing the *Central Hudson* test’s applicability to the “may disparage” prohibition of § 2(a)).

404. See, e.g., *Thompson v. W. States Med. Ctr.*, 535 U.S. 357, 367 (2002) (applying the *Central Hudson* test in a case involving advertising of compounded drugs); *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 553-71 (2001) (applying the *Central Hudson* test in a case involving advertising of tobacco and smokeless tobacco products); *Greater New Orleans Broad. Ass’n, Inc. v. United States*, 527 U.S. 173, 183-196 (1999) (applying the *Central Hudson* test in a case involving advertising of gambling); *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 499-517 (1996) (applying the *Central Hudson* test in a case involving advertising of prices for alcoholic beverages). See generally also *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1520-22 (9th Cir. 1993) (Kozinski, J. dissenting).

appropriately assess the constitutionality of the “may disparage” prohibition of § 2(a), courts must use the *Central Hudson* test.⁴⁰⁵

2. Lawful & Non-Misleading Activity

Section 2 of the Lanham Act articulates reasons why an examining attorney may refuse registration.⁴⁰⁶ The majority of reasons relate to a mark being either false or misleading.⁴⁰⁷ For example, §§ 2(a) and 2(e) prohibit registration if a mark falsely claims that the goods that it represents are made from materials that they are not.⁴⁰⁸ Similarly, § 2(e) also allows an examining attorney to refuse registration for a mark that conveys a false impression regarding the geographical origin of the goods or services.⁴⁰⁹ Section 2(d) prohibits registration if a mark is confusingly similar to the mark of another—in other words, if it is misleading.⁴¹⁰ Thus, the majority of reasons for refusal to register in § 2 have the effect of preventing registration of false and/or misleading advertising. This is important because the *Central Hudson* test expressly supports the suppression of false and misleading advertising.⁴¹¹ A mark that “may disparage,” however, is not necessarily either false or misleading. The Slants and Redskins, for example, are trademarks, which are legitimate. They are neither misleading nor related to illegal activities.⁴¹²

405. See NOWAK & ROTUNDA, *supra* note 10, § 16.31(b), at 1358-60; see also Lefstin, *supra* note 44, at 682-90 (discussing the possible application of the four-part *Central Hudson* test to § 2(a)).

406. 15 U.S.C. § 1052(a)-(f) (2012).

407. *Id.*; see also *In re Tam*, 808 F.3d 1321, 1329 (Fed. Cir. 2015) (“Many of these categories bar the registration of deceptive or misleading speech, because such speech actually undermines the interests served by trademark protection and, thus, the Lanham Act’s purposes in providing for registration.”).

408. 15 U.S.C. § 1052(a) (prohibiting “deceptive” marks); *id.* § 1052(e) (prohibiting “deceptively misdescriptive” marks).

409. *Id.* § 1052(e) (prohibiting “primarily geographically deceptively misdescriptive” marks); see also 1 MCCARTHY, *supra* note 13, §§ 14:1-14:45.

410. 15 U.S.C. § 1052(d) (prohibiting marks “likely . . . to cause confusion, or to cause mistake, or to deceive”).

411. See *In re Tam*, 808 F.3d at 1329 (“These restrictions on registration of deceptive speech do not run afoul of the First Amendment.”); see also NOWAK & ROTUNDA, *supra* note 10, § 16.31(b), at 1359 (“First a court must determine whether the speech is truthful, nonmisleading speech concerning a lawful commercial activity.”).

412. See Pace, *supra* note 17, at 39 (“[I]mmoral, scandalous or disparaging marks are neither misleading nor fraudulent, and, therefore, the restraints on these marks do not fall outside the scope of First Amendment inquiries.”).

3. Substantial Government Interest⁴¹³

In *Central Hudson*, the Court considered the state's interest in energy conservation to be "substantial."⁴¹⁴ Presumably the government's interest in prohibiting registration of marks that disparage persons, institutions, or beliefs is important, but whether it can be classified "substantial" is a different question.⁴¹⁵ In *Greater New Orleans Broadcasting Association, Incorporated v. United States*, Justice O'Connor reasoned that the government's desire to reduce a number of the social problems associated with gambling was a substantial interest.⁴¹⁶ Judge Moore offers this perspective:

While promoting racial harmony is a substantial government interest, there is no evidence that Section 2(a) accomplishes this goal. One would have to proffer, at a minimum, tangible evidence of disruption caused by the use of immoral, scandalous or disparaging marks. In *Sambo's Restaurants, Inc. v. City of Ann Arbor* [663 F.2d 686 (6th Cir. 1980)], where both parties stipulated that the trade name 'Sambo's' was offensive to black people and 'conveys to some citizens a pernicious racial

413. See Wooster, *supra* note 393, §§ 3, 6, 9-11, 13-15, 17[b], 20 (analyzing and explaining cases where the Court has held the government's interest to be "substantial" or not).

414. See NOWAK & ROTUNDA, *supra* note 10, § 16.31(b), at 1359.

415. See *supra* text accompanying note 413; see also Pace, *supra* note 17, at 40-41 ("[T]he protection of the health and welfare of the citizens constitutes a substantial government interest. However, there is no evidence that denying registration for immoral, scandalous, or disparaging trademarks will protect health and welfare. At most, these trademarks will offend. The fact that some members of society, or even a majority of society, might be offended by the trademark is not sufficient to deny otherwise protected First Amendment rights. The government's interest in discouraging offensive speech is not a substantial interest that warrants suppression of constitutional rights.") (footnotes omitted); *id.* at 42-43 (explaining that, although some may claim that the government has a substantial interest in not using government funds for registering disparaging trademarks, the current PTO fee structure indicates that this is not the case) ("It also seems obvious that more time would be expended refusing registration than it would in granting registration due to the applicant's right to appeal."); Smith, *supra* note 21, at 471 ("While Section 2(a) may represent an unreasonable restriction on commercial speech depending upon the trademark in question and the government interest advanced, no court has analyzed a Section 2(a) motion under the *Central Hudson* test. Precisely what substantial government interest is involved remains murky.").

416. *Greater New Orleans Broad. Ass'n v. United States*, 527 U.S. 173, 186-87 (1999).

stereotype of blacks as inferior,' the court held that the trade name was a protected First Amendment expression that could not be regulated. The court reasoned that mere stipulation that the mark affects racial harmony is insufficient evidence to surmount First Amendment scrutiny.⁴¹⁷

Preventing some kinds of disparagement may very well be categorized as "substantial." For example, the desire to curb disparagement related to gender, race, and class might well be "substantial." Nevertheless, the "may disparage" prohibition of § 2(a) is not specific to any particular type of invective; it casts a wide net. Without specificity, it is difficult to assert categorically that the government's interest is substantial. And "[t]he government regulation will fail if the interest is not sufficiently substantial to justify a restriction on speech"⁴¹⁸

4. *Direct Advancement, Narrowly Tailored*

In the event that trademarks are deemed to fall within the category of "commercial speech" for purposes of First Amendment analysis, technically speaking the overbreadth and vagueness doctrines do not apply.⁴¹⁹ Nevertheless, the "narrowly tailored" requirement of the *Central Hudson* test is very similar in terms of the results that flow from its application to any given statute. Section 2(a) does not directly advance the governmental interest. At best, § 2(a) merely indirectly curbs disparaging trademarks because it simply bans registration of them; it does not categorically prohibit their use. In order for § 2(a) to comport with the First

417. Pace, *supra* note 17, at 41 (footnotes omitted). See also Finkelstein, *supra* note 3, at 333 ("The use of a Native American name and mascot by a sports team is a far cry from a distiller seeking to distribute an alcoholic beverage under the label 'Crazy Horse' without appropriate approval, especially given the rampant stereotypical portrayals of 'drunk Indians' in popular culture."); Smith, *supra* note 21, at 470 ("Similarly, the Sixth Circuit struck down attempts by the city of Ann Arbor, Michigan, to deny a sign permit to a restaurant named 'Sambo's' because the name 'conveys to some citizens a pernicious racial stereotype of blacks as inferior.' While 'Sambo's' clearly was commercial speech and '[p]lainly, racial harmony and equality is a substantial state interest,' the city did not demonstrate that regulation would sufficiently advance its interest to justify the comparable restriction on speech. The court noted that 'even though exposure to the 'Sambo's' signs may offend some citizens, the ability of the City "to shut off discourse solely to protect others from hearing it is dependent upon a showing that substantial privacy interests are being invaded in an essentially intolerable manner.'") (footnotes omitted).

418. See NOWAK & ROTUNDA, *supra* note 10, § 16.31(b), at 1359.

419. See *supra* Section IV.A.2.

Amendment, the government needs to show that § 2(a) is narrowly tailored to achieve the government's goals. According to Professor Farber,

What the government does need to show is that speech regulations are narrowly tailored to achieve their goals. "[W]hen there are obviously less restrictive ways for the state to achieve its goal, or when much of the regulation's coverage is gratuitous in terms of the state's asserted interest, it is difficult to maintain with a straight face that the regulation is narrowly tailored."⁴²⁰

As explained above, in the discussion of overbreadth and vagueness,⁴²¹ with regard to both the word "may" and the word "disparage," the "may disparage" language is very broad. The word "may" opens the door widely to include literally *any* probability whatsoever.⁴²² By definition the word "may" in a statute implies a mere scintilla of a possibility. The word "may" is a decidedly lower threshold than "is likely" or "probable" or "foreseeable."⁴²³ Consequently, as written, "may disparage" cannot meet the *Central Hudson* requirement of directly advancing the government's interest in a manner not more extensive than necessary. "The government regulation will fail . . . if the means used to advance interest either do not directly advance the government interest or do so with an unnecessary burden on the ability to communicate the commercial message."⁴²⁴

In sum, it seems highly unlikely that the "may disparage" prohibition of § 2(a) can pass the *Central Hudson* test. The Slants and Redskins, for example, are trademarks, which are legitimate. They are neither misleading nor related to illegal activities. The next question is whether the government's interest is "substantial"? As was suggested, although the government's interest in prohibiting registration of marks that disparage persons, institutions, or beliefs may be *important*, it is doubtful that it can be classified as "substantial." Next, the *Central Hudson* test asks whether the government's regulation "directly" advances the government interest. Apparently, § 2(a) fails to directly advance the governmental interest because, at most, it merely indirectly reduces the likelihood that people will adopt disparaging trademarks, because it bars federal registration of them. Lastly, the *Central Hudson* test requires that the regulation be narrowly

420. FARBER, *supra* note 306, at 169.

421. *See supra* Section IV.A.2.

422. *See supra* Section IV.A.2.b.

423. *See supra* Section IV.A.2.b.

424. NOWAK & ROTUNDA, *supra* note 10, § 16.31(b), at 1359.

tailored to the governmental interest. The phrase “may disparage” is too broad and vague to possibly be considered “narrowly tailored.”⁴²⁵

C. Blackhorse *Decision & Walker*

1. Overview

When Judge Lee rendered his decision on July 8, 2015, affirming the TTAB’s cancellation of the Redskins’ trademarks, he held that the First Amendment did not apply to the “may disparage” prohibition of § 2(a) because, he said, the federal trademark registration program was *government* speech not private speech.⁴²⁶ According to Judge Lee, “[T]he federal trademark registration program is government speech and is therefore exempt from First Amendment scrutiny.”⁴²⁷ In addition, he held “that the federal trademark registration program is not commercial speech.”⁴²⁸ He based his conclusion that registered trademarks should be classified as government speech on the Supreme Court’s decision the previous month, *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*, wherein Justice Breyer held that the specialty license plate designs

425. Smith, *supra* note 21, at 470.

These cases suggest that, if actually forced to decide a case on commercial speech grounds as applied to trademark regulation, the Supreme Court and circuit courts might agree with the dissenting opinion in *Ritchie*, which noted:

[A]bridgement may result from a law that merely burdens an exercise of speech . . . “even though a person has no ‘right’ to a valuable governmental benefit and even though the government may deny him the benefit for any number of reasons, . . . [the government] may not deny a benefit to a person on a basis that infringes his constitutionally protected interests—especially, his interest in freedom of speech.”

Id. (citing *Ritchie v. Simpson*, 170 F.3d 1092, 1103 (Fed. Cir. 1999) (Newman, J., dissenting)).

426. *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 455 (E.D. Va. 2015); *id.* at 464 (“Because the federal trademark registration program is government speech, it is exempt from First Amendment scrutiny.”). Judge Lee’s opinion also considered several additional legal issues and arguments, including the Fifth Amendment takings clause, *id.* at 467, the substantive provisions of § 2(a), *id.* at 467-68, and laches, *id.* at 488-89.

427. *Id.* at 448.

428. *Id.* at 457. Given the discussion in Part IV regarding commercial speech, and especially Justice Powell’s classification of trade names as commercial speech in *Friedman v. Rogers*, this holding seems circumspect. *See* 440 U.S. 1, 12 (1979).

issued by the Texas Department of Motor Vehicles were government speech, and, therefore, not protected by the First Amendment.⁴²⁹

Judge Lee's reliance on *Walker* is based on an erroneous interpretation. A careful reading of *Walker* reveals that the reasons why Justice Breyer decided that the designs of the specialty license plates at issue were government speech are absent in *Blackhorse*. The Texas specialty license plate program is materially different from the federal trademark registration program. The two could not be more dissimilar.

Justice Breyer describes the Texas specialty license plates as typically displaying both slogans and graphics. He notes that the Texas Department of Motor Vehicles Board (Board) is the entity that decides whether to approve designs suggested by others. For example, the Board has approved specialty plates with slogans such as "Keep Texas Beautiful" and "Mothers Against Drunk Driving."⁴³⁰ In fact, the Board has approved over 350 such specialty plate designs.⁴³¹ The word "Texas" appears on all specialty plates, and the State requires that all cars registered in the state have a government-issued license plate for identification purposes (although persons who want a specialty plate pay extra).⁴³²

"The relevant statute says that the Board 'may refuse to create a new specialty license plate' for a number of reasons, for example 'if the design might be offensive to any member of the public'"⁴³³ The Sons of Confederate Veterans (SCV) proposed a specialty license plate design that included "[a] faint Confederate battle flag . . . on the lower portion of the plate."⁴³⁴ After an initial rejection, the SCV reapplied, and "[t]he Board invited public comment on its website and at an open meeting."⁴³⁵ After receiving comments, "the Board voted unanimously against issuing the plate."⁴³⁶ The Board explained its decision, noting that "many members of the general public find the design offensive" and also said that "a significant portion of the public associate the Confederate flag with

429. *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2246 (2015) ("In our view, specialty license plates issued pursuant to Texas's statutory scheme convey government speech."); see *Blackhorse*, 112 F. Supp. 3d at 458.

430. *Specialty License Plates*, TEXAS DMV, <http://txdmv.gov/motorists/license-plates/specialty-license-plates> (last visited Apr. 18, 2016).

431. *Walker*, 135 S. Ct. at 2255 (Alito, J., dissenting).

432. *Id.* at 2243 (majority opinion).

433. *Id.* at 2244-45.

434. *Id.* at 2245.

435. *Id.*

436. *Id.*

organizations advocating expressions of hate directed toward people or groups that is demeaning to those people or groups.”⁴³⁷

2. Walker's Legal Principles

Justice Breyer articulates the controlling law as follows: “When government speaks, it is not barred by the Free Speech Clause from determining the content of what it says.”⁴³⁸ According to Breyer, this rule is necessary because the government must have the freedom “to select the messages it wishes to convey.”⁴³⁹ He emphasizes that the First Amendment does not apply to situations where the government is the speaker, because, “when the government speaks it is entitled to promote a program, to espouse a policy, or to take a position. In doing so, it represents its citizens and it carries out its duties on their behalf.”⁴⁴⁰ Throughout the opinion, the Court repeatedly states that it is basing its decision regarding the Texas specialty license plates on its 2009 holding in *Pleasant Grove City v. Summum*, where the Court held that a city government’s decision regarding the approval *vel non* of monument placements (e.g., statues) in a city-owned public park was “government speech.”⁴⁴¹ The decision in *Walker* analogizes the Texas specialty license plate program to monument displays in a public park. The *Walker* Court emphasizes the following similarities: 1) the historical tradition that “[g]overnments have long used monuments to speak to the public”;⁴⁴² 2) “persons who observe donated monuments routinely—and reasonably—interpret them as conveying some message on the property owner’s behalf.”⁴⁴³ And “observers” of such monuments, as a consequence, ordinarily “appreciate the identity of the speaker”;⁴⁴⁴ and 3)

437. *Id.* (citations omitted); *see also id.* at 2262 (quoting this language) (Alito, J., dissenting).

438. *Id.* at 2245 (majority opinion); *see also id.* at 2245 (“Thus, government statements (and government actions and programs that take the form of speech) do not normally trigger the First Amendment rules designed to protect the marketplace of ideas.”); NOWAK & ROTUNDA, *supra* note 10, § 16.11, at 1284 (“Generally, when a government entity speaks, it may say what it wishes, and select the views that it wants to promote.”).

439. *Walker*, 135 S. Ct. at 2246 (citing *Pleasant Grove City v. Summum*, 555 U.S. 460, 468 (2009)).

440. *Id.*

441. *See* NOWAK & ROTUNDA, *supra* note 10, § 16.11, at 1284 (“The placement of a permanent monument in a public park is government speech and therefore is not subject to scrutiny under the Free Speech Clause.”).

442. *Walker*, 135 S. Ct. at 2248 (quoting *Summum*, 555 U.S. at 470).

443. *Id.* at 2247.

444. *Id.*

“throughout our Nation’s history, the general government practice with respect to donated monuments has been one of selective receptivity. And we observed that the city government in *Summum* ‘effectively controlled’ the messages sent by the monuments in the [p]ark by exercising ‘final approval authority’ over their selection.”⁴⁴⁵ Justice Alito’s dissent criticizes the majority’s application of these three factors, questioning whether the Court’s analogies are sound.⁴⁴⁶

3. Applying Walker to Trademark Registration

In *Blackhorse*, Judge Lee purportedly applies these same three factors.⁴⁴⁷ Nevertheless, even assuming *arguendo* that the *Walker* majority’s reasoning is correct with respect to the Texas specialty license plate program, the analogies are incongruent with respect to the PTO’s federal registration of trademarks.

First, with regard to historical tradition, the *Walker* Court notes that license plates, like monuments in a public park, “long have communicated messages from the States.”⁴⁴⁸ According to the Court, “Texas, too, has selected various messages to communicate through its license plate designs.”⁴⁴⁹ The federal trademark registration system is very different. Aside from trademarks owned by federal, state, or municipal governments, the vast majority of registered trademarks are comprised of words, names, symbols, and devices selected and communicated by the private owners of those marks. The government does not select phrases or images for companies that apply for trademarks. There is no history or tradition of governments communicating by means of trademarks that are owned by non-government entities. According to Judge Lee in *Blackhorse*, the federal trademark registration program “communicates the message that the federal government has approved the trademark.”⁴⁵⁰ But a message of approval is not what either *Walker* or *Summum* is about. Those cases are about the

445. *Id.* (quoting *Summum*, 555 U.S. at 471, 473) (citation omitted).

446. *Id.* at 2254-63 (Alito, J., dissenting).

447. *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 458 (E.D. Va. 2015).

448. *Walker*, 135 S. Ct. at 2248 (citing *Summum*, 555 U.S. at 470) (“Governments have long used monuments to speak to the public.”). Justice Alito’s dissent agrees as regards to monuments. *Id.* at 2259 (“Governments have always used public monuments to express a government message, and members of the public understand this.”) (Alito, J., dissenting).

449. *Id.* at 2248 (majority opinion).

450. *Blackhorse*, 112 F. Supp. 3d at 458 (citing 15 U.S.C. §§ 1072, 1127).

actual message that the government speaker was communicating—not mere countenance.

Second, Justice Breyer emphasizes that, like the park monuments in *Sumnum*, people who see Texas license plates on vehicles reasonably interpret the plates “as conveying some message on . . . behalf [of the Texas government].”⁴⁵¹ In support of this proposition, he notes that, “a license plate is a government article serving the governmental purposes of vehicle registration and identification” and that “Texas also owns the designs on its license plates.”⁴⁵² Judge Lee concludes that this second *Walker* factor supports his determination that trademarks are government speech. He notes that federally registered trademarks use “the insignia for federal trademark registration ®,” which, he asserts “is a manifestation of the federal government’s recognition of the mark.”⁴⁵³ Judge Lee thus presumes that this shows that “the public closely associates federal trademark registration with the federal government”⁴⁵⁴ But Lee is stretching logic beyond reason. In fact none of the sub-factors that Justice Breyer articulates to explain this point apply to federal trademark registration. First, trademark owners own the designs of the marks, not the government. In addition, a trademark registration does not serve to register the entity that owns the trademark in a manner similar to the way that a license plate serves as evidence of vehicle ownership. Nor does a trademark registration function to identify its owner in a manner similar to the way that a license plate identifies both the vehicle itself and the owner of the vehicle. Justice Breyer concludes that license plates function “essentially . . . [as] government IDs.”⁴⁵⁵ Trademark registration, on the other hand, does not function as a government-issued form of identification for its owner. Trademark registration on the Principal Register provides added protections for a trademark owner and serves an important notice function by alerting both competitors and the public that the owner asserts property rights in the mark.⁴⁵⁶ On this same topic, Justice Breyer also states that both the vehicle owner and the government intend to express the government’s endorsement

451. *Walker*, 135 S. Ct. at 2247 (citing *Sumnum*, 555 U.S. at 471).

452. *Id.* at 2248.

453. *Blackhorse*, 112 F. Supp. 3d at 458.

454. *Id.* at 458-59.

455. *Walker*, 135 S. Ct. at 2249.

456. *See* 3 MCCARTHY, *supra* note 13, § 19:9.

of the messages on license plates.⁴⁵⁷ Federal trademark registration, on the other hand, does not indicate either the owner's desire to have the government's blessing of the message nor does it express the government's agreement with the mark's message. Trademark owners apply for federal registration to secure the benefits afforded by registration.⁴⁵⁸ The government's goal is primarily to provide notice of the proprietary claims of trademark owners, not to express agreement or endorsement of the messages conveyed by trademarks.

The third factor that Justice Breyer relies on to support his analogy between the monuments in *Summum* and the specialty license plates in *Walker* is what he refers to as "selective receptivity."⁴⁵⁹ The concept is simple. For example, when a city government makes a decision about which statues to erect in a public park, it acts as the arbiter of both the medium and the message. Decision makers are responsible for aesthetic judgments about the displays as well as the ideas and ideals conveyed by those displays. It is common, for example, for parks commissioners to erect statues of statesmen, leaders, and soldiers. Similarly, public parks often have monuments with names of individuals who served in government offices and/or the military—and frequently commemorate those who died while serving their country. "The city in *Summum* simply selected monuments that presented the image that the city wanted to project to visitors in the park."⁴⁶⁰ Justice Breyer asserts that, in like manner, "Texas maintains direct control over the messages conveyed on its specialty plates. Texas law provides that the State 'has sole control over the design, typeface, color, and alphanumeric pattern for all license plates.'"⁴⁶¹ In *Blackhorse*, Judge Lee refers to this *Walker* factor as "editorial control."⁴⁶² He quotes § 2(b), (c), (d), and (e) in an effort to demonstrate the PTO's power "to deny or cancel a mark's registration, and thus control what appears on the Principal Register."⁴⁶³ But Judge Lee misunderstands the nature of the control granted by these subsections of § 2 and also the

457. *Walker*, 135 S. Ct. at 2249 ("Indeed, a person who displays a message on a Texas license plate likely intends to convey to the public that the State has endorsed that message. . . . Texas's license plate designs convey government agreement with the message displayed.").

458. *See, e.g., supra* text accompanying notes 15-16.

459. *Walker*, 135 S. Ct. at 2247.

460. NOWAK & ROTUNDA, *supra* note 10, § 16.11, at 1284.

461. *Walker*, 135 S. Ct. at 2249 (citing the relevant Texas statute).

462. *Blackhorse*, 112 F. Supp. 3d at 459.

463. *Id.* at 458.

process used to apply them. These subsections represent the criteria used by examining attorneys to determine whether an applicant's mark meets the legal definition of a trademark, and to ensure that it does not convey false and/or misleading (i.e., confusing) information to the public.⁴⁶⁴ To be sure, the process of federal trademark registration entails a completely different kind and degree of editorial control from that exercised by the city in *Summum* and the state in *Walker*.

First, *the nature of the reasons for denial* of registration found in subsections (b), (c), (d), and (e) of § 2 are materially different from the nature of the reasons for denial found in subsection (a). As was mentioned,⁴⁶⁵ those subsections all provide means to deny marks that are false and/or misleading. Section 2(b) prohibits the use of government images such as flags or coats of arms, which would falsely mislead consumers to think that a government endorses the product. Section 2(c) prohibits the use of names, portraits, or signatures of individuals and deceased presidents, which likewise would falsely mislead consumers to think that those individuals endorse the products. Section 2(d) prohibits marks that are misleading because they are likely to cause confusion and therefore could be deceptive. Section 2(e) prohibits marks that are merely descriptive or false in the sense that they are deceptively misdescriptive. A "merely descriptive" mark is a mark that lacks a secondary meaning.⁴⁶⁶ The adverb "merely" is what indicates that the mark lacks secondary meaning. Without secondary meaning, a descriptive mark is unable to "identify" an applicant's goods, because, without the cognitive link of secondary meaning, descriptive terms simply convey to consumers the contents, qualities, or characteristics of goods.⁴⁶⁷ In addition, § 2(e) prohibits registration of marks that are functional, which serves to prevent registration of a mark that is likely to conflict with the purposes of patent law.⁴⁶⁸ Consequently, the nature of the "editorial control" of the PTO to which Judge Lee refers is not "editorial" in the same sense of park monument selection or license plate design selection. Subsections (b), (c), (d), and (e) grant the authority to deny registration on grounds that a mark

464. *See supra* Section IV.B.2.

465. *See supra* Section IV.B.2.

466. *See* 1 MCCARTHY, *supra* note 13, § 11:2.

467. *See id.* § 11:16.

468. 15 U.S.C. § 1052(e) (prohibiting registration of marks that are "as a whole . . . functional").

is false and/or misleading—grounds that are categorically outside the scope of First Amendment protection.⁴⁶⁹ Subsection (a) is completely different.

Secondly, *the “editorial” process involved in applying the criteria* of these subsections of § 2 is entirely different from the process involved with monument and license plate design selection. It is the applicant—not the government—who selects the design of her mark. The PTO’s examining attorney does not have control over the mark. At most an examining attorney carries on a dialogue with an applicant via office actions regarding problems with an application, such as the provisions of § 2. But office action dialogue bears no meaningful similarity to the kind of input nor the degree of input that a city government imposes when selecting and approving park statues and monuments; nor does it bear any meaningful similarity to the kind or degree of input that the state of Texas imposes when selecting and approving specialty license plates.

In concluding the portion of his opinion in *Walker*, explaining the three factors, Justice Breyer summarizes several of his main points:

And other features of the designs on Texas’s specialty license plates indicate that the message conveyed by those designs is conveyed on behalf of the government. Texas, through its Board, selects each design featured on the State’s specialty license plates. Texas presents these designs on government-mandated, government-controlled, and government-issued IDs that have traditionally been used as a medium for government speech. And it places the designs directly below the large letters identifying “TEXAS” as the issuer of the IDs. “The [designs] that are accepted, therefore, are meant to convey and have the effect of conveying a government message, and they thus constitute government speech.”⁴⁷⁰

Registered trademarks share none of these characteristics that evince messages conveyed on behalf of the government. The PTO does not 1) select trademark designs; 2) present trademarks as a form of government-mandated, government-controlled, or government-issued IDs that have even remotely, much less “traditionally,” been used as a medium of government speech; 3) require placement of registered trademarks to be displayed graphically underneath any identifier of government ownership, such as

469. *See supra* Section IV.B.2.

470. *Walker*, 135 S. Ct. at 2250 (quoting *Sumnum*, 555 U.S. at 472).

“USA Registered.” The only government identifier is the registration symbol ®, which is relatively small and merely indicates that the mark has met the registration criteria established by the Lanham Act. It does not indicate that the government agrees with or endorses the message of the mark’s owner. Therefore, registered trademarks, unlike the Texas specialty license plates, can neither be considered to be “accepted” nor “meant to convey and have the effect of conveying a government message.”⁴⁷¹

4. “Forum” Considerations, Insight From the Dissent, & Summary of the Applicability of Walker to Trademark Registration

Rather than classifying the federal trademark registry as “government speech,” it is possible that it may be more appropriate to classify it instead as either a “public forum,” analogous to sidewalks and public parks, which have traditionally provided space for public discourse.⁴⁷² It is also possible that the trademark registry is actually a nonpublic forum of the sort that traditionally has been available for private speech. In *Walker*, Justice Breyer concludes that “forum analysis” is unnecessary “[b]ecause the State is speaking on its own behalf, [and therefore] the First Amendment strictures that attend the various types of government-established forums do not apply.”⁴⁷³ However, in making his point, Justice Breyer contrasts the Texas specialty license plate program with *Lehman v. Shaker Heights*, a decision in which the Court construed advertising space on city buses as a nonpublic forum where “the messages were located in a context (advertising space) that is traditionally available for private speech.”⁴⁷⁴ In his dissent, Justice Alito characterizes the Texas specialty plates as a “limited public forum.”⁴⁷⁵ Whether the trademark registry is classified as a public forum, a limited public forum, or nonpublic forum, the “may

471. *Id.* at 2249.

472. See generally NOWAK & ROTUNDA, *supra* note 10, §§ 16.1(f), 16.47(c), at 1262-64, 1449-67. See also Lefstin, *supra* note 44, at 702-07 (discussing the possible application of the public forum doctrine to § 2(a)).

473. *Walker*, 135 S. Ct. at 2249.

474. *Id.* at 2252.

475. *Id.* at 2262 (“What Texas has done by selling space on its license plates is to create what we have called a limited public forum. It has allowed state property (i.e., motor vehicle license plates) to be used by private speakers according to rules that the State prescribes.”) (Alito, J., dissenting); see also NOWAK & ROTUNDA, *supra* note 10, § 16.47(c)(ii), at 1450-53.

disparage” prohibition of § 2(a) violates the First Amendment, because it is certainly not a content-neutral, time, place, or manner restriction.⁴⁷⁶

Justice Alito’s dissent (joined by Justices Roberts, Scalia, and Kennedy) begins by pointing out the dire consequence of classifying speech as “government speech.” By classifying speech as “government speech,” the majority in effect plays a trump card, which avoids the need to analyze the facts of the case using the First Amendment. “The Court’s decision passes off private speech as government speech and, in doing so, establishes a precedent that threatens private speech that government finds displeasing. Under our First Amendment cases, the distinction between government speech and private speech is critical.”⁴⁷⁷ Alito calls this a “dangerous” precedent,⁴⁷⁸ and urges that, “what Texas did here was to reject one of the messages that members of a private group wanted to post . . . because the State thought that many of its citizens would find the message offensive.”⁴⁷⁹ He concludes that to do so “is blatant viewpoint discrimination.”⁴⁸⁰

In addition to criticizing the majority’s application of the three main factors drawn from *Sumnum*,⁴⁸¹ the dissent also points out that “spatial limitations played a prominent part in our analysis” in *Sumnum*.⁴⁸² Justice Alito notes the obvious—that unlike a public park, there is a virtually inexhaustible supply of possible specialty license plate designs that Texas could adopt.⁴⁸³ The same is true of the federal trademark registry. There is no practical limit on the number of marks that can be registered.

Both the monuments in *Sumnum* and the license plates in *Walker* are very different from trademarks registered on the Principal Register. Trademarks registered on the Principal Register do not necessarily convey messages or images that the United States Government wants to project. It is not the government speaking, it is the owners of the trademarks. Justice

476. See NOWAK & ROTUNDA, *supra* note 10, § 16.1(f), at 1262-64.

477. *Walker*, 1355 S. Ct. at 2254 (Alito, J., dissenting).

478. *Id.* at 2255 (“But the precedent this case sets is dangerous.”) (Alito, J., dissenting).

479. *Id.* at 2256 (Alito, J., dissenting).

480. *Id.*

481. 1) The historical tradition of government speech in the venue; 2) The perceptions of observers that the venue is providing government speech; and, 3) The “selective receptivity” of messages by the government.

482. *Walker*, 1355 S. Ct. at 2259 (Alito, J., dissenting).

483. See *id.* at 2261 (“The only absolute limit on the number of specialty plates that a State could issue is the number of registered vehicles. The variety of available plates is limitless, too. Today Texas offers more than 350 varieties. In 10 years, might it be 3,500?”) (Alito, J., dissenting).

Alito's dissent explains that "[t]here is a big difference between government speech (that is, speech by the government in furtherance of its programs) and governmental blessing (or condemnation) of private speech."⁴⁸⁴ Professor McCarthy makes the same claim: "The government, by registering a mark, does not thereby give its approval or imprimatur to the propriety, suitability [sic], or tastefulness of the mark or of the suitability or quality of the goods or services with which it is used."⁴⁸⁵ Judge Moore makes this point emphatically: "issuance of a trademark registration does not amount to a government endorsement of the [trademark]," and punctuates the point remarking: "Since awarding registration does not amount to government endorsement of the mark, withholding registration does not serve the function of removing the government's imprimatur on scandalous, immoral or disparaging marks."⁴⁸⁶ Besides, the mere "government ownership of property does not exempt it from these general First Amendment rules."⁴⁸⁷ Hence, the Principal Register ought not be classified as "government speech."⁴⁸⁸

*D. Analogies to Copyright Law, Its First Amendment Jurisprudence (e.g., Protection of Pornography & Other Alleged Obscenities), & Fair Use*⁴⁸⁹

Two lessons from another field of Intellectual Property law provide additional food for thought. Courts have considered whether copyright law ought to protect works that many find distasteful and/or offensive. Citing the need for a robust First Amendment, the Supreme Court has ruled that even pornography and other types of offensive, hurtful, and disparaging

484. *Id.*

485. 3 MCCARTHY, *supra* note 13, § 19:3.50.

486. Pace, *supra* note 17, at 40 (quoting *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1219 (T.T.A.B. 1993)).

487. FARBER, *supra* note 306, at 202.

488. In addition to reliance on *Walker*, Judge Lee also discusses two other cases to support his view that the federal trademark registration program is government speech, *Sons of Confederate Veterans, Inc. v. Comm'r of Va. Dep't of Motor Vehicles*, 288 F.3d 610 (4th Cir. 2002), and *Rust v. Sullivan*, 500 U.S. 173 (1991). The factors and analyses in those cases add nothing to the doctrine that is materially distinct from the factors and analysis articulated in *Walker*. See *Pro-Football v. Blackhorse*, 112 F. Supp. 3d 439, 459-60 (E.D. Va. 2015) (discussing the four-part "mixed/hybrid speech test" of *SVC*); *id.* at 463-64 (discussing *Rust*).

489. See generally NOWAK & ROTUNDA, *supra* note 10, § 16.36(c), at 1406-08. Several of the *amici curiae* in *In re Tam* also pointed out analogies to copyright doctrine.

content are entitled to First Amendment protection.⁴⁹⁰ In one of the most prominent cases to consider the issue in the context of obscenity, the Supreme Court (Justice Brennan) remarked, “All ideas having even the slightest redeeming social importance—unorthodox ideas, controversial ideas, even ideas hateful to the prevailing climate of opinion—have the full protection . . . unless excludable because they encroach upon the limited area of more important interests.”⁴⁹¹ Imagine for a moment the reaction if Congress were to attempt to prevent registration of copyright for works that “may disparage persons, institutions, or beliefs.” It seems quite certain that such a statute would fail First Amendment scrutiny.

A second lesson drawn from copyright law pertains to the doctrine of fair use.⁴⁹² In copyright law, fair use reflects First Amendment doctrine.⁴⁹³ The Copyright Act provides as follows:

[T]he fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;

490. The Federal Circuit’s opinion makes a similar connection to copyright law, explaining that works registered under copyright law are not government speech. *In re Tam*, 808 F.3d 1321, 1345-48 (Fed. Cir. 2015); *see also, e.g., NOWAK & ROTUNDA, supra* note 10, §§ 16.57-16.60, at 1515-24; *see also Pace, supra* note 17, at 24 (“[C]opyright protection has been extended to material that is obscene or scandalous. Courts have justified the extension of copyright protection to obscene works on the ground that society’s view of what is moral and immoral continually changes; what one generation considers obscene, a later generation might consider of great literary merit.”) (citing *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852, 857 (5th Cir. 1979), *cert. denied*, 445 U.S. 917 (1980)); *supra* note 177 and accompanying text; *infra* Sections V.A.1, V.A.3, and V.A.5;.

491. *Roth v. United States*, 354 U.S. 476, 484, (1957), *reh’g denied*, 355 U.S. 852 (1957).

492. *See* 17 U.S.C. § 107 (2012).

493. *See, e.g., Harper & Row v. Nation Enters.*, 471 U.S. 539 (1985).

(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

(4) the effect of the use upon the potential market for or value of the copyrighted work. The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.⁴⁹⁴

The Fair Use doctrine recognizes that certain socially beneficial purposes may be exempt from the ordinary constraints of copyright infringement analysis. One of the broadest exemptions under this doctrine exists for “criticism.” Copyright jurisprudence views criticism as a vital, if not necessary, cause for exemption. And during the past twenty-five years the most extensive fair use protection for any kind of criticism has been for parody.⁴⁹⁵ In fact, a careful reading of the flagship parody case, *Campbell v. Acuff-Rose Music, Inc.*, demonstrates that a genuine parody enjoys virtually complete immunity in terms of liability for Copyright infringement.⁴⁹⁶ One of the core reasons for this broad immunity for parody is that it is an important form of social criticism to which people rarely give their consent. The same concern applies with equal force to trademarks that some feel “may disparage” them. By definition, the function of parody is to criticize and ridicule persons, institutions, or beliefs.⁴⁹⁷ In that sense, a parody inherently disparages persons, institutions, or beliefs. Given that modern Supreme Court copyright jurisprudence has developed in such a way that there is nearly a “parody exception,” it would be anomalous if American Intellectual Property Law were to provide such vigorous protection for parody through Copyright and yet refuse to protect marks that “may disparage” in its federal trademark law. The First Amendment expressly allows just this kind of commentary, criticism, and expression of contradictory opinion. It allows racist, disparaging, condescending, and even pornographic expression. These are protected to promote a vibrant democracy, free press, and open debate. Refusing to register trademarks that “may disparage” is an overbroad and vague restriction—throwing Trademark law out of balance with Copyright—that the First Amendment simply cannot countenance.

494. 17 U.S.C. § 107.

495. *See, e.g., Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

496. *See generally id.*

497. *See id.* at 580; *see also* WILLIAM F. PATRY, PATRY ON FAIR USE §§ 3:88-89, 3.95, at 416-21, 431 (2015 ed.).

*E. Unconstitutional Conditions*⁴⁹⁸

Finally, one argument that some have advanced is that the “may disparage” prohibition of § 2(a) cannot possibly run afoul of the First Amendment because a denial or cancellation of federal trademark registration pursuant to § 2(a) does not restrict or prevent the mark’s use, but rather it merely prevents federal registration.⁴⁹⁹ And, the argument goes, although federal registration provides a registrant many benefits, a mere denial of those benefits does not call the First Amendment into question.⁵⁰⁰ In her “Additional Views,” Judge Moore contends that denying the benefits of federal trademark registration does, in fact, rise to the level of a First Amendment concern.⁵⁰¹ “The Supreme Court has held that the government cannot condition access to a benefit on the waiver of a constitutionally protected right under the ‘unconstitutional conditions’ doctrine.”⁵⁰² In his book, *The First Amendment*, Professor Daniel Farber poses this very question: “Can the government condition some benefit on the applicant’s abstention from undesirable expression?”⁵⁰³ Professor Farber points to

498. See generally NOWAK & ROTUNDA, *supra* note 10, § 16.11(d), at 1286-90.

499. See, e.g., Smith, *supra* note 21, at 468 (“They often state, in one form or another, that Section 2(a) does not violate free speech because ‘although the mark holder who is denied federal registration will not receive the benefits conferred on a federal trademark registrant, the mark holder may and can continue to use the mark.’ Whether the continued ability to use the mark absent federal registration complies with established First Amendment doctrine, however, is unclear; thus, it is possible that a well-crafted challenge could be successful.”) (footnote omitted); Lefstin, *supra* note 44, at 699-702 (analyzing the application of the unconstitutional conditions doctrine to § 2(a)).

500. See NOWAK & ROTUNDA, *supra* note 10, § 16.1(a), at 1252 (“In a few instances, the government has attempted to influence expressive activities by granting and denying monetary benefits.”). One such example is *United States v. National Treasury Employees Union*, 513 U.S. 454 (1995), invalidating, on First Amendment grounds, a statute that had prohibited federal employees from receiving compensation for giving speeches or writing articles. See also NOWAK & ROTUNDA, *supra* note 10, § 16.52(c), at 1506-07 (discussing this case).

501. See *supra* Section III.C. See also Pace, *supra* note 17, at 37 (“While it is true that a denial of registration does not prevent the trademark owner from continuing to use his trademark in conjunction with his products, it does deny the trademark owner the benefits afforded by federal registration. Denial of registration will certainly act as an economic deterrent and discourage use of the trademark.”) (footnotes omitted).

502. Pace, *supra* note 17, at 37-38 & n.197 (citing numerous cases and secondary authority in the accompanying footnote).

503. FARBER, *supra* note 306, at 47.

*Speiser v. Randall*⁵⁰⁴ and explains: “*Speiser* involved a California tax exemption for veterans that required a loyalty oath opposing the forceful overthrow of the government. The Court held that to ‘deny an exemption to claimants who engage in certain forms of speech is in effect to penalize them for such speech.’”⁵⁰⁵ Logically, in an analogous fashion, when the PTO denies trademark registration to applicants whose trademarks “may disparage,” it likewise penalizes them for such speech.⁵⁰⁶ Although a denial of registration is not, technically speaking, a “prior restraint,” it does have a similar effect to a prior restraint. The “may disparage” prohibition of § 2(a) is likely to dissuade or discourage the use of marks that “may disparage” and consequently chill speech.⁵⁰⁷ Thus it creates *de facto* censorship.

Conclusion

Trademark examining attorneys, the TTAB, and the federal courts have struggled mightily to apply the “may disparage” prohibition of § 2(a) of the Lanham Act. A great deal of the struggle is due to a combination of factors, including its vagueness and the volatile emotions of those persons who feel offended by some marks. The central issue in both *Blackhorse* and *Tam* involves the complex relationship between federal trademark law (and policy) and the First Amendment. Judge Moore’s majority opinion and the other opinions in *In re Tam* (as well as the briefs of the parties) show that there are strong arguments on both sides of this issue. The precedent of *McGinley*, the unconstitutional conditions doctrine, and the question of whether trademarks should be treated as commercial speech under the *Central Hudson* test combine to make this a multi-faceted problem. Both Justice Breyer’s decision in *Walker* and Judge Lee’s decision in

504. 357 U.S. 513 (1958).

505. FARBER, *supra* note 306, at 47 (quoting *Speiser*, 357 U.S. at 518); *see also* Pace, *supra* note 17, at 37 (discussing the unconstitutional conditions doctrine, and quoting the same language from *Speiser*).

506. *See* Smith, *supra* note 21, at 469 (“A comparison of trademark registration to other cases concerning the withholding of governmental benefits based on the content of speech shows that the registrant’s free speech concerns likely outweigh any proffered governmental interest in morality or tolerance. The Supreme Court ruled that the Postmaster General could not revoke the second-class mail rate for Esquire, Inc. on the grounds that *Esquire* magazine was indecent and morally improper.”) (citing *Hannegan v. Esquire, Inc.*, 327 U.S. 146, 158 (1946)).

507. For an explanation and discussion of “prior restraint,” *see* NOWAK & ROTUNDA, *supra* note 10, § 16.16-16.17, at 1303-12.

Blackhorse, during the summer months of 2015, have added an additional layer of complexity to the debate.

This Article argues that the “may disparage” prohibition of § 2(a) conflicts with the First Amendment for five reasons. First, traditional First Amendment analysis indicates that it is a vague and overbroad content/viewpoint-based restriction. Second, if trademarks are analyzed as a kind of commercial speech, § 2(a) fails the *Central Hudson* test. Third, a careful reading of *Walker* demonstrates that federal trademark registration is not government speech and thus is not exempt from First Amendment scrutiny. Fourth, principles drawn from copyright law, another important branch of intellectual property, suggest additional reasons why First Amendment protection is important for trademark policy in the context of § 2(a)’s “may disparage” prohibition. Finally, the unconstitutional conditions doctrine identifies the reasons why withholding the benefits of federal registration pursuant to § 2(a) creates an abridgement of free speech.

Professor Compton has persuasively argued that § 2(a) should be amended to delete the words “disparage or.” In effect this is precisely what would occur if the U.S. Supreme Court were to rule that the “may disparage” prohibition violates the First Amendment.⁵⁰⁸ This would retain the other aspects of § 2(a) and the ability of that provision to prevent the registration of marks that convey false and misleading information. In this manner, it would still serve a purpose similar to other subsections of § 2 that, for example, prohibit the registration of marks that are likely to confuse consumers or to convey false information about the contents of goods or the geographic origin of goods.⁵⁰⁹

Rather than artificially manipulating trademark law to eliminate marks that “may disparage,” sound First Amendment policy recommends that the marketplace solve the problem. Thus, if enough people refuse to support The Slants or Washington Redskins—or any other marks that “may disparage”—due to their objections to the offensive nature of those names or images, that conduct (i.e., refusal of support), and not an abridgement of

508. Compton, *supra* note 7, at 35 (“My preferred approach to resolving the inherent inconsistencies that are sure to arise under the Trademark Act is to amend it so that disparaging marks could be registered. I particularly believe this to be the best approach because it is more in line with the legislative intent of preventing directed attacks at an identifiable individual or institution. Additionally, the current law has proven to be vague in terms of setting clear guidelines for resolving these disputes, and application of the disparagement test is highly subjective.”).

509. *See, e.g.*, 15 U.S.C. § 1052(a)-(e) (2012); *see also supra* Section IV.B.2.

the First Amendment, will provoke change.⁵¹⁰ That is part of what the First Amendment doctrine is designed to encourage. “Just as the ancient Romans eventually learned that executing Christians did not suppress Christianity, modern Governments should realize that forbidding people to talk about certain topics does not encourage public stability. It only creates martyrs.”⁵¹¹

510. See *supra* note 466 and accompanying text. The ACLU suggests this concept in its brief in the *Tam* case. Brief of the American Civil Liberties Union, the American Civil Liberties Union of Oregon, and the American Civil Liberties Union of the Nation’s Capital as *Amici Curiae* in Support of Appellant, at 7, *In re Tam*, 785 F.3d 567 (Fed. Cir. 2015) (No. 14-1203) (“[I]n the trademark context . . . a literal marketplace allows members of the public to register protest through boycotts of a mark holder’s products or services, or through other traditional First Amendment means.”); see also Compton, *supra* note 7, at 23-24 (“[c]onsumers who are offended by goods that bear a disparaging mark can voice their concerns by protesting to the company’s use of the term, or otherwise ‘vote with their wallet’ by not purchasing the goods. Such efforts may drive a company to adopt another brand in order to avoid the bad press and loss of revenue by using the disparaging term. For this reason, the Trademark Office should err on the side of registration.”) (footnote omitted); Pace, *supra* note 17, at 9 (“It would be economically unwise for a company to use a trademark that is offensive to African-Americans. A company’s trademark is its commercial identity. If a company’s symbol is offensive, those who are offended will not buy the company’s product. For this reason companies are constantly changing their trademarks to appeal to consumers.”); *id.* at 10 (explaining by way of example that the Quaker Oats Company has routinely changed the graphics of its Aunt Jemima trademark in an effort to be “diligent in assuring that their trademark conforms with contemporary societal views of acceptability”).

511. NOWAK & ROTUNDA, *supra* note 10, § 16.6(g), at 1271.