

A photograph of a forest at sunset. The sky is filled with orange and yellow clouds, and the sun is low on the horizon. In the foreground, there is a grassy field. In the background, there are many tall, thin trees with white bark, likely aspens, and some darker evergreen trees. The overall mood is serene and contemplative.

FREE SPEECH AND DISPARAGING TRADEMARKS

SEEING THE FOREST FROM THE TREES

PRESENTED BY

VIRGINIA ISAACSON

&

DAVID ANDERSEN

Matal v. Tam

137 S. Ct. 1744 (2017)



“THE SLANTS”

USPTO REFUSAL AND APPEAL

- IN 2011 TAM APPLIED WITH THE USPTO TO REGISTER THE MARK THE SLANTS FOR LIVE PERFORMANCES BY A MUSICAL BAND.
- TAM DENIED REGISTRATION UNDER SECTION 2(A) OF LANHAM ACT.
- 15 U.S.C. SECTION 1052(A) PROHIBITS THE REGISTRATION OF MARKS THAT “**MAY DISPARAGE** OR FALSELY SUGGEST A CONNECTION WITH PERSONS, LIVING OR DEAD, INSTITUTIONS, BELIEFS, OR NATIONAL SYMBOLS, OR BRING THEM INTO CONTEMPT, OR DISREPUTE”
- TAM APPEALED, BUT TTAB AFFIRMED THE REFUSAL, HOLDING THAT THE MARK WOULD DISPARAGE A SUBSTANTIAL COMPOSITE OF PERSONS OF ASIAN DESCENT.



FEDERAL CIRCUIT DECISIONS



- TAM DEFENDED HIS BAND'S USE OF THE NAME STATING THAT HIS INTENTION WAS NOT TO DISPARAGE ASIANS BUT TO RECLAIM AND TAKE OWNERSHIP OF THAT TERM.
- THE INITIAL PANEL OF THE FEDERAL CIRCUIT AFFIRMED THE TTAB'S DECISION TO REFUSE MR. TAM'S REGISTRATION UNDER SECTION 2(A).
- HOWEVER, ONE OF THE JUDGES WROTE SEPARATELY STATING THAT THE DISPARAGEMENT CLAUSE OF 2(A) WAS UNCONSTITUTIONAL BECAUSE IT DENIED FREEDOM OF SPEECH.
- THE FEDERAL CIRCUIT GRANTED *EN BANC* REVIEW AND FOUND THAT THE 2(A) DISPARAGEMENT CLAUSE VIOLATED THE FIRST AMENDMENT.

THE SUPREME COURT

- GOVERNMENT ARGUED THAT TRADEMARKS ARE GOVERNMENT SPEECH AS OPPOSED TO PRIVATE SPEECH.
- THE FREE SPEECH CLAUSE OF THE FIRST AMENDMENT PROTECTS PRIVATE SPEECH FROM INDIVIDUALS BUT DOES NOT REGULATE GOVERNMENT SPEECH OR REQUIRE THE GOVERNMENT TO MAINTAIN VIEWPOINT NEUTRALITY.
- THE COURT FOUND THAT TRADEMARKS ARE PRIVATE SPEECH BECAUSE PEOPLE IDENTIFY TRADEMARKS WITH PRIVATE COMPANIES AND NOT WITH THE GOVERNMENT.

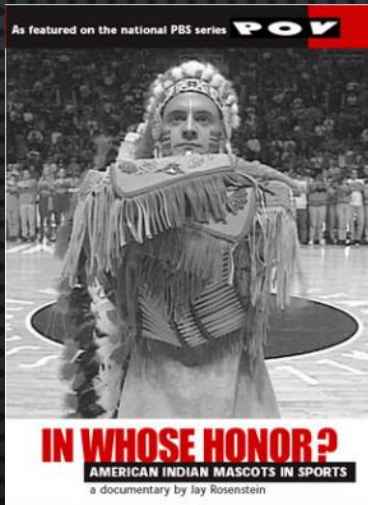


SUPREME COURT CONT'D



- JUSTICE ALITO: GIVEN THE WIDE VARIETY OF MARKS IN THE MARKETPLACE THAT IF THE PUBLIC ASSOCIATED ALL THESE MARKS WITH GOVERNMENT SPEECH ONE WOULD SAY THAT THE “FEDERAL GOVERNMENT IS BABBLING PRODIGIOUSLY AND INCOHERENTLY.”
- JUSTICE ALITO: “IF PRIVATE SPEECH COULD BE PASSED OFF AS GOVERNMENT SPEECH BY SIMPLY AFFIXING A GOVERNMENT SEAL OF APPROVAL, GOVERNMENT COULD SILENCE OR MUFFLE THE EXPRESSION OF DISFAVORED VIEWPOINTS.”
- RESULT: SUPREME COURT HELD 8-0 THAT THE 2(A) DISPARAGEMENT CLAUSE VIOLATED THE 1ST AMENDMENT BECAUSE IT WAS VIEWPOINT DISCRIMINATION.

WHAT OTHER MARKS OR GROUPS ARE AFFECTED?



SOME EXAMPLES OF DISPARAGING MARKS FILED SINCE TAM DECISION

Chink

kike

Nigga



BYU

LOOKING FORWARD

THE ENTIRE 2(A) SECTION STATES:

THE USPTO MAY REFUSE REGISTRATION OF A MARK THAT “CONSISTS OF OR COMPRISES **IMMORAL**, **DECEPTIVE**, OR **SCANDALOUS MATTER**; OR MATTER WHICH MAY DISPARAGE OR FALSELY SUGGEST A CONNECTION WITH PERSONS, LIVING OR DEAD, INSTITUTIONS, BELIEFS OR NATIONAL SYMBOLS, OR BRING THEM INTO CONTEMPT, OR DISREPUTE”

WHAT IS THE FUTURE OF THE IMMORAL AND SCANDALOUS MATTER PORTION OF SECTION 2(A)?



In re Brunetti



- ERIK BRUNETTI APPLIED IN 2011 FOR THE MARK FUCT FOR APPAREL INCLUDING CHILDREN AND INFANT CLOTHING.
- HE WAS DENIED REGISTRATION BASED ON THE “IMMORAL OR SCANDALOUS MATTER” LANGUAGE OF 2(A).
- THIS CASE IS PENDING BEFORE THE FEDERAL CIRCUIT AND ORAL ARGUMENTS WERE HEARD BEFORE THE *TAM* DECISION WAS HANDED DOWN.
- THE FEDERAL CIRCUIT HAS ASKED FOR SUPPLEMENTAL BRIEFING AND IT SEEMS LIKELY THAT THIS LANGUAGE WILL BE DECLARED UNCONSTITUTIONAL AS WELL.

OPENING THE FLOODGATES



IS ANYONE NOW FREE TO
REGISTER THE MOST VILE OF
WORDS OR IMAGES AS
TRADEMARKS?

OTHER OBSTACLES TO REGISTRATION

ON WHAT OTHER GROUNDS ARE
DISPARAGING, SCANDALOUS,
OR IMMORAL MARKS LIKELY
TO BE REJECTED?

- FAILURE TO FUNCTION?
- ORNAMENTATION?
- OTHER GROUNDS?



CONSTITUTIONALITY OF OTHER BARS TO REGISTRATION

- FLAG OR COAT OF ARMS OF THE U.S., OR ANY STATE OR MUNICIPALITY, OR ANY SIMULATION THEREOF?
- NAME, PORTRAIT, OR SIGNATURE OF LIVING PERSON?
- DECEPTIVELY MISDESCRIPTIVE MARKS?



REGISTRATION OF DISPARAGING, IMMORAL, AND SCANDALOUS MARKS INTERNATIONALLY



HOW WILL THIS IMPACT ABILITY
TO REGISTER THESE KINDS OF
MARKS INTERNATIONALLY?

IMPACT ON NON-TRADEMARK CASES

WHAT FREE-SPEECH
IMPLICATIONS ARE THERE IN
OTHER CONTEXTS (UPCOMING
SUPREME COURT CASES)?



*Masterpiece Cakeshop v.
Colo. Civil Rights Comm'n*



*Janus v. Amer. Fed'n
of State, Cty., and
Mun. Employees*