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# Offensive TMs At High Court: Everything You Need To Know

By **Bill Donahue**

Law360, New York (January 17, 2017, 9:38 PM EST) -- The highest-profile trademark case in years will be argued before the U.S. Supreme Court on Wednesday, pitting a rock band and a billion-dollar football team against the federal government — and the First Amendment against laws limiting offensive speech. To get you up to speed, here's everything you need to know.

## What's at issue here?

The justices are weighing the Lanham Act's Section 2a, which bars the U.S. Patent and Trademark Office from registering any trademark that "may disparage" people — namely, whether the provision violates the First Amendment rights of those who want to register such offensive words as trademarks.

Though the Washington Redskins aren't directly involved in the case, Section 2a is the same provision cited in **the high-profile 2014 ruling** that revoked the football team's trademark registrations on the grounds that the name is offensive to Native Americans. The court's decision, coming in a separate case involving an Oregon rock band called The Slants, will likely make or break the team's case, too.

Section 2a has been on the books since 1946, a testament to the fact that few questioned its legality until recently. For years, courts ruled that it didn't violate the First Amendment because it doesn't actually bar real-life use of the offending mark or prevent the owner from enforcing common law trademark rights.

## How did we get here?

Simon Tam, the lead singer of The Slants, applied in 2010 to register his band's name as a federal trademark. He and his band mates are of Asian descent, and they say they chose the name to "reappropriate" and disarm an anti-Asian slur.

But an examiner at the trademark office didn't see it that way, ruling that the name would violate Section 2a's ban on "disparaging" marks and rejecting the application. Tam appealed to the Trademark Trial and Appeal Board, but that body **upheld the examiner's decision in 2013**.

Tam then appealed to the Federal Circuit, which initially affirmed the ruling but then issued an unusual after-the-fact order withdrawing the earlier decision and setting the stage for the en banc court to weigh in on whether Section 2a violated the First Amendment rights of applicants like Tam.

In December 2015, the full court **sided with Tam**, expressly overturning decades-old Federal Circuit precedent that Section 2a was constitutional. Though such marks often "convey hurtful speech that harms members of oft-stigmatized communities," the appeals court said that "the First Amendment protects even hurtful speech."

"The government cannot refuse to register disparaging marks because it disapproves of the expressive messages conveyed by the marks," the court wrote.

The USPTO filed a petition for a writ of certiorari in April, and the high court granted cert in September.

### **Where do the Redskins factor into all of this?**

The team, which saw its own registrations canceled under Section 2a by the TTAB in June 2014, has spent the last two years fighting its own separate court battle, raising similar First Amendment arguments. But the team chose a more procedurally lengthy appellate route than Tam did, opting for a so-called de novo review at a district court rather a direct appeal to the Federal Circuit. As a result, The Slants made it to the high court first.

That the Redskins aren't directly involved at the Supreme Court is not for a lack of effort, though.

Back in April, the team filed an extraordinary motion asking the high court to hear its case immediately alongside The Slants, before the intermediary Fourth Circuit even had a chance to weigh in. In doing so, the team said its lawyers, hailing from BigLaw firms Arnold & Porter Kaye Scholer LLP and Quinn Emanuel Urquhart & Sullivan LLP, were "best positioned" to ensure a full "adversarial process" over the issue — a claim that some court watchers interpreted as a dig at the smaller firm handling The Slants' case.

The high court shot down that motion in October, a week after it agreed to hear The Slants' case. The Fourth Circuit has since stayed the Redskins case in favor of the pending high court case, and the team has filed amicus briefs in the band's case.

There are theoretically ways the outcomes of the two cases could diverge, but experts mostly say that trademark registrations of the billion-dollar sports NFL franchise are likely going to live or die according to what the high court says about those of the tiny rock band.

"They're either going to stand or fall together," said Susan Neuberger Weller, the chair of the trademark practice at Mintz Levin Cohn Ferris Glovsky and Popeo PC.

### **What's the government's position?**

That there is a big difference between discriminating against speech and simply declining to use public funds to actively support something — in this case, racial slurs — that the government deems is against the public interest.

"Nothing in the First Amendment requires Congress to encourage the use of racial slurs in interstate commerce," the USPTO wrote in its brief to the high court.

The agency makes that central argument in different ways, but one to keep an eye on during Wednesday's arguments is the so-called government speech doctrine: the idea that expression by the government is exempt from First Amendment protections.

The doctrine got a big thumbs-up from the high court in June 2015, when the justices ruled that license plates were government speech, meaning Texas wasn't violating the First Amendment by refusing requests to adorn them with the Confederate flag.

That ruling was already applied in the Redskins' parallel case, where a district judge upheld Section 2a as constitutional by finding that trademark registrations were analogous to those Texas license plates. Unsurprisingly, the USPTO is asking the justices to do the same in The Slants' case.

"Just as any motorist who wished to display a Confederate battle flag on his vehicle could do so on a bumper sticker without the state's assistance, respondent can use the term 'slants' in any way he wants even if his trademark cannot be registered," the agency wrote. "Just as the state of Texas could permissibly disassociate itself from a symbol it viewed as offensive to the public, the federal government can permissibly disassociate itself from disparaging trademarks."

For outside observers, that line of argument gives the court a chance to offer needed clarification on the extent of "government speech."

"I'll be very curious to see if the justices press them on the boundaries of government speech doctrine," said Megan L. Brown, a partner with Wiley Rein LLP. "Its application in the license plate case was already arguably aggressive, and this would be an even bigger leap."

### **What's Tam's position?**

That withholding the benefits of a registration is a serious burden that the First Amendment requires the government to justify — and that "shielding people from being offended" simply isn't good enough.

"The First Amendment does not allow the government to impose burdens on speech for the purpose of protecting listeners against offense," the band's brief to the high court read. "Disparaging trademarks understandably arouse disgust, but disgust is not a valid basis for restricting expression."

Given the high court's previous treatment of free speech cases, court watchers say they wouldn't be shocked if the justices are receptive to the argument that the USPTO has failed to offer up a sufficient reason for its restriction on speech.

"If you go back and look, there is usually a very serious harm that's being prevented with a restriction of speech," Mintz Levin's Weller said. "A real danger of physical injury or child pornography or libel. You don't really have that same kind of harm here."

Tam also weighed in on the government speech doctrine during briefing, saying a registration was decidedly different than a license plate.

"Unlike license plates, trademarks are not a form of government ID the public thinks of as government speech," Tam wrote. "Unlike license plates, the government does not control the design or the content of trademarks."

### **Has the case drawn outside attention?**

It sure has: Dozens of amicus briefs supporting one side or the other have been filed, many with high-profile authors.

Unsurprisingly, the Redskins filed a brief supporting Tam that said Section 2a "blatantly violates the First Amendment." Like it did in its own case, the team also cited a variety of offensive marks that made it past the ban to prove that the rule is applied in a "wildly inconsistent" manner: "Baked By A Negro," "Retardapedia," "Yid Dish" and so on.

Also weighing in on Tam's side was the American Civil Liberties Union, the International Trademark Association, the U.S. Chamber of Commerce, prominent First Amendment professors and many more.

The USPTO received fewer briefs in support of its case but got a strong one from Amanda Blackhorse and the other Native American activists who brought the case against the Redskins. It is illogical, they argued, that the First Amendment would grant greater trademark rights, which themselves limit free speech.

Also supporting the USPTO were a wide group of minority bar associations, as well as trademark lawyers who warned that much of trademark law involves content-based determinations and that a ruling striking down Section 2a might accidentally invalidate the rest of the Lanham Act.

The USPTO is represented by its own attorneys and attorneys from the U.S. Department of Justice.

The band is represented by John Connell, Ronald D. Coleman and Joel G. MacMull of Archer & Greiner PC, and Stuart Banner and Eugene Volokh of the University of California, Los Angeles, School of Law.

The case is Lee v. Tam, case number 15-1293, in the Supreme Court of the United States.

--Editing by Christine Chun and Catherine Sum.

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