



School of Law
UNIVERSITY OF GEORGIA

Prepare.
Connect.
Lead.

Journal of Intellectual Property
Law

Volume 25 | Issue 1

Article 8

April 2017

Historical Perspectives & Reflections on "Matal v. Tam" and the Future of Offensive Trademarks

Russ VerSteeg
New England Law, Boston

Follow this and additional works at: <https://digitalcommons.law.uga.edu/jipl>



Part of the [Intellectual Property Law Commons](#)

Recommended Citation

Russ VerSteeg, *Historical Perspectives & Reflections on "Matal v. Tam" and the Future of Offensive Trademarks*, 25 J. INTELL. PROP. L. 109 (2017).

Available at: <https://digitalcommons.law.uga.edu/jipl/vol25/iss1/8>

This Article is brought to you for free and open access by Digital Commons @ University of Georgia School of Law. It has been accepted for inclusion in Journal of Intellectual Property Law by an authorized editor of Digital Commons @ University of Georgia School of Law. [Please share how you have benefited from this access](#) For more information, please contact tstriepe@uga.edu.

HISTORICAL PERSPECTIVES & REFLECTIONS ON *MATAL V. TAM* AND THE FUTURE OF OFFENSIVE TRADEMARKS

*Russ VerSteeg**

TABLE OF CONTENTS

I.	INTRODUCTION	110
II.	<i>MATAL V. TAM</i>	113
	A. OVERVIEW.....	113
	B. SUMMARY OF <i>MATAL V. TAM</i>	115
	1. <i>Overview</i>	115
	2. <i>Justice Alito's Opinion</i>	115
	3. <i>Justice Kennedy's Concurring Opinion</i>	122
	4. <i>Justice Thomas's Concurring Opinion</i>	124
	C. IMMEDIATE IMPACT	124
III.	FOUNDATIONS OF TRADEMARK LAW AND THE FIRST AMENDMENT.....	127
	A. CORE TRADEMARK PRINCIPLES	127
	1. <i>Trademarks as Property</i>	127
	2. <i>Trademarks as Protection from Fraud and Deceit</i>	134
	3. <i>Trademarks and Reputation</i>	136
	4. <i>Trademarks and Religious Sensitivity</i>	140
	B. CORE FREE SPEECH PRINCIPLES	143
IV.	A PROPOSAL.....	148
V.	CONCLUSION	156

* Professor, New England Law | Boston. I would like to thank Lauren Oliva for her outstanding research assistance. Thanks also to Roger Schechter (no relation to Frank Schechter) for sharing helpful historical documents.

I. INTRODUCTION

On June 19, 2017, the United States Supreme Court rendered its decision in *Matal v. Tam (Tam)*.¹ Writing for the Court, Justice Alito held that the “may disparage” provision of § 2(a) of the Lanham Act (disparagement clause) is unconstitutional because it violates the Free Speech clause of the First Amendment.² In an article published in the summer of 2016, *Blackhawk Down or Blackhorse Down? The Lanham Act’s Prohibition of Trademarks that “May Disparage” & the First Amendment*, I argued that this was the likely outcome for many reasons.³ My principal arguments were that, if analyzed under traditional First Amendment principles, the disparagement clause is both overbroad and vague,⁴ and that, if analyzed under commercial speech principles, the provision fails to pass muster under the *Central Hudson* test.⁵

Justice Alito embraced reasoning similar to mine, focusing on the First Amendment to explain why the provision is unconstitutional.⁶ *Blackhawk Down or Blackhorse Down?* and Justice Alito’s opinion both examine the complex nexus of the intersection between the First Amendment and trademark law. The Court’s opinion synthesizes doctrine and policy that bridge these two critical fields—namely Constitutional Law and Intellectual Property Law. But this Article steps back, “zooms out,” to consider not the complexities of those branches of law, but rather the “big picture” of the broader foundations of them.

¹ 137 S. Ct. 1744 (2017).

² *Id.* at 1751. For a relatively concise yet thorough overview of the Free Speech clause of the First Amendment, see, e.g., JOHN E. NOWAK & RONALD D. ROTUNDA, PRINCIPLES OF CONSTITUTIONAL LAW 613–789 (4th ed. 2010). Justice Alito’s decision is clear, fairly concise, and thorough. See GILMORE GRANT, THE AGES OF AMERICAN LAW 16 (1977) (“Judges are trained to explain the reasons for their decisions. They may not always be successful, but the opinions of our better judges set a model for rational and humane discourse which the rest of us can only envy.”).

³ Russ VerSteeg, *Blackhawk Down or Blackhorse Down? The Lanham Act’s Prohibition of Trademarks that “May Disparage” & the First Amendment*, 68 OKLA. L. REV. 677 (2016); *id.* at 770 (“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.”).

⁴ VerSteeg, *supra* note 3, at 730–48. For a discussion of “overbreadth,” see generally NOWAK & ROTUNDA, *supra* note 2, § 16.2, at 631–32. For a discussion of “vagueness,” see generally *id.* § 16.3, at 633–34.

⁵ VerSteeg, *supra* note 3, at 748–55. See *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of New York*, 447 U.S. 557, 100 S. Ct. 2343, 65 L. Ed. 2d 341 (1980). See also NOWAK & ROTUNDA, *supra* note 2, § 16.12(b), at 680–82.

⁶ See *infra* Part I.B.

2017] HISTORICAL PERSPECTIVES AND REFLECTIONS 111

To this end, this Article considers the Supreme Court's *Tam* decision, drawing primarily (but by no means exclusively) on the perspectives of five historical and jurisprudential scholars in particular: Sir William Blackstone;⁷ Professor Frank

⁷ See generally DAVID A. LOCKMILLER, SIR WILLIAM BLACKSTONE (1938); LEWIS C. WARDEN, THE LIFE OF BLACKSTONE (1938); William Blake Odgers, *Sir William Blackstone*, 27 YALE L.J. 599 (1918); William Blake Odgers, *Sir William Blackstone*, 28 YALE L.J. 542 (1919); Douglas H. Cook, *Sir William Blackstone: A Life and Legacy Set Apart for God's Work*, 13 REGENT U. L. REV. 169, 177 (2001); Sir William Blackstone (July 10, 1723–February 14, 1780) is primarily remembered today for his four-volume treatise on English law, *Commentaries on the Laws of England* (1765–1769). And this Article relies heavily on that text for principles of property law, fraud and deceit, matters related to law and reputation, and the connection between freedom of expression and religion. Shortly after publication, the *Commentaries* became a principal text for those studying law in both England and North America. Blackstone briefly practiced law but devoted most of his career to lecturing and writing on the subject. He also served for nine years in the House of Commons in Parliament. In the final decade of his life, he sat as a judge in the Court of Common Pleas. Although not immune to contradictions, his explanations of legal doctrine were praised for their directness and clarity.

Schechter;⁸ Senator Sam Ervin;⁹ Professor Jerome Hall;¹⁰ and, Professor Grant Gilmore.¹¹ This is not a random assortment of strangers. Rather, each man

⁸ See generally William G. Barber, *A "Rational" Approach for Analyzing Dilution Claims: The Three Hallmarks of True Trademark Dilution*, 33 *AIPLA Q.J.* 25, 28 (2005); Robert G. Bone, *Schechter's Ideas in Historical Context and Dilution's Rocky Road*, 24 *SANTA CLARA COMPUTER & HIGH TECH. L.J.* 469, 474 (2008); Steven Wilf, *The Making of the Post-War Paradigm in American Intellectual Property Law*, 31 *COLUM. J.L. & ARTS* 139, 158 (2008); *Amy Schechter, Daughter of Dr. Solomon Schechter, Held for Murder in Strike*, <http://www.jta.org/1929/07/23/archive/amy-schechter-daughter-of-dr-solomon-schechter-held-for-murder-in-strike> (last visited Aug. 13, 2017); David Schechter, *How Solomon Schechter's Daughter Became a Card-Carrying Communist*, <http://forward.com/culture/longform/321372/how-solomon-schechters-daughter-became-the-life-of-her-party/> (last visited Aug. 13, 2017); Professor Frank Schechter (June 24, 1890–September 26, 1937) is best known for his writing on trademark history and trademark dilution theory. Most of the information in this Article relating to the early history of Trademark law comes from his book, *The Historical Foundations of Law Relating to Trademarks* (1925). He served in World War One in Eastern France. It was there that he was exposed to poisonous gas that probably contributed to his premature death from respiratory illness. Professor Schechter earned both undergraduate and law degrees at Columbia. In 1929 when his sister, Amy was on trial in North Carolina for her alleged involvement in the murder of a police officer, he traveled there to assist in her defense.

⁹ See generally Jeffrey L. Vagle, *Laird v. Tatum and Article III Standing in Surveillance Cases*, 18 *U. PA. J. CONST. L.* 1055, 1065 (2016); Douglas S. Onley, *Treading on Sacred Ground: Congress's Power to Subject White House Advisers to Senate Confirmation*, 37 *WM. & MARY L. REV.* 1183 (1996); James R. Dickenson, *Sen. Sam Ervin, Key Figure In Watergate Probe Dies*, *WASH. POST* (1985), <http://www.washingtonpost.com/wp-srv/national/longterm/watergate/stories/ervinobit.htm> (last visited Aug. 13, 2017); *Senate Select Committee on Presidential Campaign Activities (The Watergate Committee)*, U.S. Senate Historical Office, Washington, D.C., https://www.senate.gov/artandhistory/history/common/investigations/pdf/Watergate_investigation_citations.pdf (last visited Aug. 13, 2017); Samuel James Ervin (September 27, 1896–April 23, 1985) served in numerous public service capacities during his distinguished career. A World War One veteran and graduate of the University of North Carolina at Chapel Hill and Harvard Law School, he practiced law, served in the North Carolina House of Representatives and in the United States Senate, and was also an associate justice of the North Carolina Supreme Court. As a junior senator, he was appointed to the committee that investigated the misdeeds of Senator Joseph McCarthy. And in the twilight of his political career, he gained national recognition as the Chairman of the committee that investigated the Watergate scandal. He was universally acknowledged as the Senate's pre-eminent scholar and authority on United States Constitutional Law. His autobiography, *Preserving the Constitution: The Autobiography of Sam Ervin*, provides the basis in this Article regarding the Founding Fathers' views on the meaning of the First Amendment in particular, and the Constitution in general.

¹⁰ See generally Gerhard O.W. Mueller, *Criminal Theory: An Appraisal of Jerome Hall's Studies in Jurisprudence and Criminal Theory*, 34 *IND. L. REV.* 206 (1959); *Jerome Hall, 91, Legal Scholar Who Was Professor and Author*, *N.Y. TIMES* (1992), <http://www.nytimes.com/1992/03/11/us/jerome-hall-91-legal-scholar-who-was-professor-and-author.html>; Jerome Hall (February 4, 1901–March 2, 1992) spent most of his professional life as a professor of law at the University of Indiana at Bloomington. He earned his undergraduate and law degrees at the University of Chicago and was a Fulbright scholar. He practiced corporate law in Chicago, Illinois in the 1920's. During the 1930's Hall earned advanced legal degrees at Columbia and Harvard. His scholarship focused primarily on Criminal Law, Comparative Law, and Jurisprudence. His work incorporated an interdisciplinary approach, and he also left his mark on the international shape of law, doing work on behalf of the U.S. State Department assisting in drafting laws in Korea, India, Japan, and the Philippines. In addition to his teaching and writing, Professor Hall held positions of distinction in numerous academic and civic organizations, and received honors and awards of recognition for his

offers a unique point of view regarding the role of law in general, and each also adds expertise to the conversation that informs our modern-day understanding of the more specific foundations of the legal principles of trademark law and constitutional law.

Part Two of this Article summarizes the Supreme Court's opinion in *Tam*. This part also speculates about the immediate ramifications of the decision for the future of registration of marks that some individuals and groups deem offensive. Justice Alito invokes trademark history as a means of providing context for his decision.¹² On the theory that historical perspective often helps us better understand and confront contemporary issues, Part Three follows Justice Alito's lead and reaches into the roots of law to provide perspective regarding several legal principles and relationships that provide the foundations for trademark law and policy. Part Three explores the historical and jurisprudential foundations of both trademark law and the First Amendment, analyzing, in particular, the tension inherent in the disparagement clause of § 2(a) and the freedom of speech, guaranteed by the First Amendment. This Part relies primarily on the observations of Blackstone, Schechter, and Ervin. Part Three closes by taking an even broader view of these issues, reflecting in particular on a more macroscopic jurisprudential analysis. Part Four proposes one potential solution to relieve some of the tension between those concerned that offensive trademarks will overtake the American marketplace versus those who wish to champion the cause of freedom of speech. The Conclusion briefly summarizes the main points of the Article.

II. *MATAL V. TAM*

A. OVERVIEW

The *Tam* decision has little to do with the types of trademark issues that ordinarily concern the general public. The general public, which typically gets its

contributions to law and society. Here, his book, *Foundations of Jurisprudence* supplies insights and lends valuable perspective.

¹¹ See generally Friedrich Kessler, *Grant Gilmore As I Remember Him*, 92 YALE L.J. 4 (1982); Robert A. Hillman, *The Triumph of Gilmore's the Death of Contract*, 90 NW. U. L. REV. 32 (1995); Richard Danzig, *The Death of Contract and the Life of the Profession: Observations on the Intellectual State of Legal Academia*, 29 STAN. L. REV. 1125 (1977); Peter Linzer, *Law's Unity – an Essay for the Master Contortionist*, 90 NW. U.L. REV. 183 (1995); Grant Gilmore (1910–1982) is perhaps best known for his controversial book, *The Death of Contract*, published in 1974. Professor Gilmore, who specialized primarily in Commercial Law, received a Ph.D. in Romance Languages at Yale University, where he taught French before beginning his legal studies. While teaching law at Yale, he helped draft the Uniform Commercial Code. He wrote *The Ages of American Law* (1977) as his career drew to a close, and this Article leans on that book as a principal source for broad historical context.

¹² *Tam*, 137 S. Ct. at 1751 (“Trademarks and their precursors have ancient origins, and trademarks were protected at common law and in equity at the time of the founding of our country.” (citations omitted)).

information about trademarks from reports in the media regarding infringement disputes, probably knows far more about cases concerning trademark infringement rather than the subtleties surrounding the First Amendment and the technical aspects of § 2 of the Lanham Act.¹³ Section 2(a) of the Lanham Act contains provisions that explain why certain trademarks may be disqualified from federal registration.¹⁴ But before even considering the topic of trademark registration, it is helpful to first examine the very basis of legal protection for trademarks. In the history of trademark law, scholars and judges have addressed the threshold issue of whether the legal protections for trademarks should be focused primarily on an owner's *property rights* in a mark or on the public's interest in *protection from fraud and deceit*.¹⁵ To a certain extent, these twin concerns, prominent in the history of the evolution of trademark doctrine, are also germane to the *Tam* decision. A person who applies to register a mark that may disparage persons, institutions, or beliefs is primarily interested in protecting his property rights by the acquisition of additional protections afforded to federal registrants.¹⁶ And, although neither fraud nor deceit are true concerns relating to marks that may disparage, nevertheless the perceptions of certain members of the public are a vital interest; specifically relevant are the perceptions of the people who feel disparaged. Consequently, these two bedrock interests—the interests of trademark owners in protecting their property rights and the interests of the members of the public—are also key interests affected by the *Tam* decision. Hence, it will be useful to keep in mind these two important interests.

¹³ *Id.* at 1759 (“And it is unlikely that more than a tiny fraction of the public has any idea what federal registration of a trademark means. ‘The purchasing public knows no more about trademark registrations than a man walking down the street in a strange city knows about legal title to the land and buildings he passes.’” (citations omitted)).

¹⁴ *Id.* at 1753 (“The Lanham Act contains provisions that bar certain trademarks from the principal register.”); see also VerSteege, *supra* note 3, at 683.

¹⁵ Part III examines these historical concerns in greater detail. See, e.g., FRANK I. SCHECHTER, *THE HISTORICAL FOUNDATIONS OF LAW RELATING TO TRADE-MARKS* 141 (1925) (“[I]here is a steady stream of substantial English authority holding the common law action for trade-mark infringement to be one of deceit. . . .”); *id.* at 143 (“In 1902 in *Addley Bourne v. Swan & Edgar, Ltd.* the leading authorities on this point were reviewed by Farwell, J., who concluded that, although in cases of trade-mark infringement no fraudulent misrepresentation had been made to the *plaintiff*, nevertheless, whether correctly or not, the law was definitely settled that the proper common law action for trade-mark infringement is an action in deceit.” (footnotes omitted)). See also Benjamin G. Paster, *Trademarks – Their Early History*, 59 TRADEMARK REP. 551, 566 (1969) (“No such theory was accepted in the common law courts, and in them fraud remained an essential ingredient of a cause of action for the infringement of a trademark down to the date of the amalgamation effected by the Judicature Acts.”).

¹⁶ *Tam*, 137 S. Ct. at 1750 (“Federal registration . . . ‘confers important legal rights and benefits on trademark owners who register their trademarks.’” (citations omitted)).

B. SUMMARY OF *MATAL V. TAM*

1. *Overview.* After the United States Patent and Trademark Office (PTO) denied registration for “The Slants” as a service mark, pursuant to § 2(a) of the Lanham Act, which prohibits registration of marks that “may disparage . . . persons . . .,” the Trademark Trial and Appeal Board (TTAB) affirmed the PTO examining attorney’s refusal of registration.¹⁷ The Court of Appeals for the Federal Circuit (CAFC), en banc, later reversed the TTAB, holding that the disparagement clause violates the Free Speech clause of the First Amendment.¹⁸ Then, shortly after the United States Supreme Court granted certiorari to hear the *Tam* case, the Fourth Circuit Court of Appeals suspended its consideration of the *Blackhorse* case, pending the outcome of *Tam*.¹⁹

Justice Alito wrote three sections of the *Tam* opinion that hold the disparagement clause unconstitutional.²⁰ In short, he writes, “this provision violates the Free Speech Clause of the First Amendment. It offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend.”²¹ Justice Kennedy wrote a two-part concurring opinion (joined by Justices Ginsburg, Kagan, and Sotomayor), concurring in part and concurring in judgment.²² Two sections of Justice Alito’s opinion are unanimous—Part I and Part III.A. Only Justices Roberts, Breyer, and Thomas joined in Parts III.B, III.C, Part IV, and the introductory paragraph of Part III. Justice Thomas did not join Part II, and he wrote a brief concurring opinion.

2. *Justice Alito’s Opinion.* Justice Alito begins Part I.A by briefly describing relevant trademark statutes and some historical and jurisprudential background of trademark law.²³ Part I.B then explains a number of nuances regarding protection for unregistered trademarks and details the benefits provided by federal registration of a mark on the Principal Register.²⁴ Part I.C follows by outlining the operation of § 2(a) of the Lanham Act and the role it plays in

¹⁷ *Id.* at 1754.

¹⁸ *Id.*

¹⁹ *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015). See *Supreme Court to Weigh in on Disparaging Trademarks*, MANATT, PHELPS & PHILLIPS (Dec. 15, 2016), <https://www.manatt.com/Insights/Articles/2016/Supreme-Court-to-Weigh-in-on-Disparaging-Trademark> (Pro-Football, Inc., appealed the case to the Fourth Circuit in October 2015. “After the petition for certiorari was filed with the Supreme Court in *Tam*, Pro-Football, Inc., filed a rare ‘certiorari before judgment’ petition with the Court which, if granted, would have allowed Blackhorse to be joined with *Tam* for Supreme Court consideration, even though the Fourth Circuit had not yet ruled in the case. The Supreme Court denied Pro-Football, Inc.’s petition on October 3, 2016, but on October 19, 2016, the Fourth Circuit agreed to postpone Blackhorse until after the Supreme Court’s decision in *Tam* as the *Tam* decision could directly affect the outcome in Blackhorse.”).

²⁰ 137 S. Ct. at 1751.

²¹ *Id.*

²² *Id.* at 1765–74.

²³ *Id.* at 1751–62.

²⁴ *Id.* at 1752–53.

establishing the doctrine that applies to determine whether an applicant's mark qualifies for registration on the Principal Register.²⁵ Here, Justice Alito also identifies § 2(a)'s disparagement clause as the *causus belli* in this case:

At issue in this case is one such provision, which we will call “the disparagement clause.” This provision prohibits the registration of a trademark “which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.” § 1052(a). This clause appeared in the original Lanham Act and has remained the same to this day.²⁶

He also describes the mechanics of how the PTO and courts traditionally have assessed whether a mark violates the disparagement clause.²⁷ Finally, Part I ends by noting that Simon Tam “chose this moniker [i.e., “The Slants”] in order to ‘reclaim’ and ‘take ownership’ of stereotypes about people of Asian ancestry.”²⁸ This part also outlines the path that the litigation took to reach the Court.²⁹ Justice Alito pointedly notes that the Court granted certiorari expressly “in order to decide whether the disparagement clause ‘is facially invalid under the Free Speech Clause of the First Amendment.’”³⁰

Part II summarily dispatches Tam's argument that “the [disparagement] clause does not reach marks that disparage racial or ethnic groups.”³¹ Tam had argued “that the term ‘persons’ includes only natural and juristic persons’ not ‘non-juristic entities such as racial and ethnic groups.’”³² According to Justice Alito, the plain language of § 2(a) contradicts this argument.³³

²⁵ *Id.* at 1750.

²⁶ *Id.* at 1753.

²⁷ *Id.* at 1753–54.

²⁸ *Id.* at 1754. *See also* VerSteeg, *supra* note 3, at 698, n.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.”).

²⁹ 137 S. Ct. at 1754.

³⁰ *Id.* at 1755. In the petition for certiorari, the Solicitor General, on behalf of the Director of the UPTO noted that “Section 2(a) . . . provided that no trademark shall be refused registration on account of its nature unless, *inter alia*, it [c]onsists of . . . matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.” The question presented was therefore “[w]hether the disparagement provision in 15 U.S.C. 1052(a) is facially invalid under the Free Speech Clause of the First Amendment.” Brief for Petitioner at I, *Lee v. Tam*, 2016 WL 1593780 (U.S.) (Appellate Petition, Motion, and Filing No. 15-1293 at 1). On September 29, 2016, the Supreme Court of the United States granted the petition for writ of certiorari in an opinion which stated simply: “Petition for writ of certiorari to the United States Court of Appeals for the Federal Circuit granted.” *Lee v. Tam*, 137 S. Ct. 30 (2016). For a discussion of “facial invalidity” and “as applied invalidity,” see, e.g., NOWAK & ROTUNDA, *supra* note 2, § 16.1, at 629–30.

³¹ 137 S. Ct. at 1755.

³² *Id.*

³³ *Id.* at 1756.

All eight participating justices joined Part III.A, which leaves little doubt that this section is the most important of the Court's opinion. Because "[t]he Free Speech Clause . . . does not regulate government speech," if, as the Government contended, trademarks registered on the Principal Register constitute "government speech," then the First Amendment cannot invalidate the disparagement clause.³⁴ Justice Alito succinctly observes that "imposing a requirement of viewpoint-neutrality on government speech would be paralyzing," adding that "[w]hen a government entity embarks on a course of action, it necessarily takes a particular viewpoint and rejects others."³⁵ He offers, by way of example, the government's pro-war posters created during World War II, which promoted "enlistment, the purchase of war bonds, and the conservation of scarce resources."³⁶ To drive his point home, Justice Alito emphasizes that, although the World War II posters clearly "expressed a viewpoint . . . the First Amendment did not demand that the Government balance the message of these posters by producing and distributing posters encouraging Americans to refrain from engaging in these activities."³⁷ Nevertheless, he adds a stern warning regarding the necessity of exercising "great caution before extending our government speech precedents."³⁸

In holding that registered trademarks cannot be characterized as a form of government speech, he first notes that the Government neither originates an applicant's mark nor edits it.³⁹ Rather, he emphasizes that none of the § 2 bars to registration—except the disparagement clause—permits disqualification for registration "based on the viewpoint that it appears to express."⁴⁰ "Instead, if the mark meets the Lanham Act's viewpoint-neutral requirements, registration is mandatory."⁴¹ In a somewhat chastising tone, he bluntly asserts, "[i]n light of all this, it is far-fetched to suggest that the content of a registered mark is

³⁴ *Id.* at 1757. For a discussion of the First Amendment's relationship to the government speech doctrine, see, e.g., NOWAK & ROTUNDA, *supra* note 2, § 16.4, at 634–43.

³⁵ 137 S. Ct. at 1757.

³⁶ *Id.* at 1758.

³⁷ *Id.*

³⁸ *Id.* ("But while the government-speech doctrine is important—indeed, essential—it is a doctrine that is susceptible to dangerous misuse. 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. For this reason, we must exercise great caution before extending our government-speech precedents.")

³⁹ *Id.* at 1748 ("The Federal Government does not dream up these marks, and it does not edit marks submitted for registration."). The court below also held that trademarks were not government speech. *In re Tam*, 808 F.3d 1321, 1345 (Fed. Cir. 2015) ("Trademarks are not understood to convey a government message or carry a government endorsement."). In fact, Judge Moore bluntly stated, "[t]his argument is meritless." *In re Tam*, 808 F.3d 1321, 1340 (Fed. Cir. 2015).

⁴⁰ 137 S. Ct. at 1758.

⁴¹ *Id.*

government speech.”⁴² Indeed, the PTO itself has previously held “that registration does not constitute approval of a mark.”⁴³

The opinion then discusses three prominent cases where the Court previously held that the speech in question was, in fact, correctly labeled as government speech—and thus not subject to First Amendment scrutiny⁴⁴—but directly asserts, “[n]one of our government speech cases even remotely supports the idea that registered trademarks are government speech.”⁴⁵ The Court first looks at the *Johanns* case, which is probably the easiest to comprehend.⁴⁶ The advertising in question was created pursuant to a federal statute and government departments and employees directly participated in the drafting of the advertisements.⁴⁷ *Summum* involved the display of monuments in a public city park.⁴⁸ There, the Court articulated specific factors that led it to conclude the selection of monuments for display in the public city park should be categorized as government speech.⁴⁹ But summarizing his analysis of the *Summum* factors as they apply to registered trademarks, Justice Alito concludes:

Trademarks share none of these characteristics. Trademarks have not traditionally been used to convey a Government message. With the exception of the enforcement of 15 U. S. C. § 1052(a), the viewpoint expressed by a mark has not played a role in the decision whether to place it on the principal register. And there is no evidence that the public associates the contents of trademarks with the Federal Government.⁵⁰

He next addresses *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, characterizing that case as probably representing “the outer bounds of the

⁴² *Id.* This holding vindicates Judge Moore’s view expressed in her “additional views.” See *In re Tam*, 785 F.3d 567, 574 (Fed. Cir. 2015). It also overrules Judge Lee’s decision in *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.”).

⁴³ 137 S. Ct. at 1759 (citing *In re Old Glory Condom Corp.*, 26 U.S.P.Q. 2d 1216, 1220 n.3 (T.T.A.B. 1993)).

⁴⁴ *Id.*

⁴⁵ *Id.*

⁴⁶ *Id.* at 1759.

⁴⁷ *Id.* For an overview and discussion of *Johanns*, see, e.g., NOWAK & ROTUNDA, *supra* note 2, § 16.4, at 639.

⁴⁸ 137 S. Ct. at 1759. For a discussion of *Summum*, see, e.g., NOWAK & ROTUNDA, *supra* note 2, § 16.4, at 634–36.

⁴⁹ 137 S. Ct. at 1759–60. See VerSteege, *supra* note 3, at 758–63 (analyzing the *Summum* factors and their relationship to federal trademark registration).

⁵⁰ 137 S. Ct. at 1760. See VerSteege, *supra* note 3, at 762 (When, analyzing how the factors articulated in *Walker*—derived from *Summum*—apply to federal trademark registration, “[r]egistered trademarks share none of these characteristics that evince messages conveyed on behalf of the government”).

government speech doctrine.”⁵¹ In *Walker*, the Court held that the messages communicated on specialty license plates made by the Texas Department of Motor Vehicles were not subject to First Amendment scrutiny, because the messages were government speech.⁵² After noting those factors “distilled from *Summum*,” Justice Alito nevertheless distinguishes *Walker*, concluding that, “none of these factors are present in this case.”⁵³

Holding that *Johanns*, *Summum*, and *Walker* are “vastly different” from “the federal registration of trademarks,” he reasons that the opposite conclusion “would constitute a huge and dangerous extension of the government speech doctrine.”⁵⁴ He specifically warns that if trademark registration were considered government speech—and therefore not subject to First Amendment scrutiny—there would be nothing to prevent the same analysis from applying to copyright registration.⁵⁵ He emphasizes that, even though the brevity of trademarks necessarily limits their ability to express ideas, nevertheless, “powerful messages can sometimes be conveyed in just a few words.”⁵⁶ He succinctly concludes, “[t]rademarks are private, not government speech.”⁵⁷

In Part III.B, Justice Alito explains why he believes that federal trademark registration is not a government subsidy.⁵⁸ He briefly states that, as a rule, “government is not required to subsidize activities that it does not wish to promote.”⁵⁹ But he distinguishes the cases cited for support by the Government, stating, “[u]nlike the present case, the decisions on which the Government relies all involved cash subsidies or their equivalent.”⁶⁰ He points out, in particular, that the opposite is true in the case of federal trademark registration—far from receiving payment for using the service, trademark applicants must pay an application fee and ongoing maintenance additional fees.⁶¹ Justice Alito adds that the non-monetary benefits derived from federal registration simply do not rise to

⁵¹ 137 S. Ct. at 1760.

⁵² *Id.* (citing *Walker*, 135 S. Ct. 2239 (2015)).

⁵³ *Id.* See VerSteeg, *supra* note 3, at 755–65 (analyzing *Walker* and *Summum*).

⁵⁴ 137 S. Ct. at 1760. See VerSteeg, *supra* note 3, at 764 (“Both the monuments in *Summum* 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.”).

⁵⁵ 137 S. Ct. at 1760. See VerSteeg, *supra* note 4, at 765–67 (drawing analogies to Copyright registration); *id.* at 766 (“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.”); *id.* at 767 (“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.”).

⁵⁶ 137 S. Ct. at 1760.

⁵⁷ *Id.*

⁵⁸ *Id.* at 1760–62.

⁵⁹ *Id.* at 1761.

⁶⁰ *Id.*

⁶¹ *Id.*

the level of being categorized as a subsidy any more than the benefits derived by the public from other government programs and services, such as police, fire fighters, the court system, public parks, highways, copyright and patent registration, land records, commercial filings, and a variety of government licensing functions, such as driver's licenses, motor vehicle registrations, as well as hunting, fishing, and boating permits.⁶²

In Part III.C, Justice Alito responds to the Government's novel argument that federal trademark registration should be exempt from First Amendment scrutiny because it constitutes a special type of "government-program."⁶³ Justice Alito takes the position that the Government's proposed "new doctrine that would apply to 'government-program' cases, which "simply merges our government-speech cases and . . . subsidy cases in an attempt to construct a broader doctrine that can be applied to the registration of trademarks."⁶⁴ Although he summarizes the cases cited by the Government in support of its new "government-program" theory, Justice Alito ultimately dismisses the theory, partly because those cases involve facts "far removed from the registration of trademarks."⁶⁵

Justice Alito takes a metaphorical detour in the latter portion of Part III.C. He suggests that the "limited public forum" cases are "[p]otentially more analogous" to the case at bar than are the cases that the Government had cited for its "government-program" theory.⁶⁶ But he quickly concludes, "even in such cases, what we have termed 'viewpoint discrimination' is forbidden."⁶⁷ At this juncture, he devotes two paragraphs to discuss the jurisprudence of viewpoint discrimination.⁶⁸ In sum, he notes the seriousness of the First Amendment's role as a check on viewpoint discrimination in general.⁶⁹ He likewise stresses the principle itself, "[i]f there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable."⁷⁰ He concludes this part of the opinion, asserting that, "the disparagement clause cannot be saved

⁶² *Id.* The Court of Appeals also held that federal trademark registration is not a government subsidy. *In re Tam*, 808 F.3d 1321, 1348–55 (Fed. Cir. 2015).

⁶³ 137 S. Ct. at 1761–63.

⁶⁴ *Id.* at 1761–62.

⁶⁵ *Id.* at 1762.

⁶⁶ *Id.* at 1763. See VerSteeg, *supra* note 3, at 763 ("rather than classifying federal trademark registration as "government-speech," it might be more appropriate to classify it either as a "public forum," "non-public forum," or, as Justice Alito's dissent in *Walker* suggested for the Texas specialty license plates, federal trademark registration might be classified as a "limited public forum."). For a general discussion of the public forum doctrine, see e.g., NOWAK & ROTUNDA, *supra* note 2, §§ 16.27–16.28, at 737–56.

⁶⁷ 137 S. Ct. at 1763.

⁶⁸ *Id.* In the opinion below, the CAFC held that the disparagement clause constitutes viewpoint discrimination. *In re Tam*, 808 F.3d 1321, 1328 (Fed. Cir. 2015) ("The government regulation at issue amounts to viewpoint discrimination. . . .").

⁶⁹ 137 S. Ct. at 1763.

⁷⁰ *Id.* (quoting *Texas v. Johnson*, 491 U.S. 397, 414 (1989)).

by analyzing it as a type of government program in which some content- and speaker-based restrictions are permitted.”⁷¹

Part IV of the opinion addresses the question of whether trademarks should be classified as commercial speech, and therefore analyzed under the lower-level degree of First Amendment scrutiny established by the Court in *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm’n of N.Y.*⁷² Briefly stated, if trademarks are classified as commercial speech, § 2(a)’s disparagement clause would be subject to intermediate scrutiny, using the *Central Hudson* test; whereas if trademarks are not classified as commercial speech, then the disparagement clause would be subject to the more rigorous standard of strict scrutiny.⁷³ But having posed the question, Justice Alito dodges it: “We need not resolve this debate . . . because the disparagement clause cannot withstand even *Central Hudson* review.”⁷⁴ He then explains the *Central Hudson* test and applies it to the disparagement clause.⁷⁵ In this process, Justice Alito identifies the Government’s alleged interests (in support of upholding the constitutionality of the disparagement clause) as: (1) prevention of “speech expressing ideas that offend,” and (2) protection of “the orderly flow of commerce.”⁷⁶ Nevertheless, without directly coming to a legal conclusion regarding the substantiality of those interests,⁷⁷ Alito holds that the disparagement clause is not sufficiently narrowly tailored to achieve those

⁷¹ *Id.*

⁷² 447 U.S. 557 (1980). For an overview and discussion of *Central Hudson*, see e.g., NOWAK & ROTUNDA, *supra* note 2, § 16.12, at 680–82.

⁷³ 137 S. Ct. at 1764. In the opinion below, the CAFC, en banc, held that the disparagement clause conflicted with the Free Speech clause using strict scrutiny. *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.”).

⁷⁴ 137 S. Ct. at 1763. See *In re Primus*, 436 U.S. 412, 438 n.32 (1978) (Justice Powell remarked that the distinction between commercial and non-commercial speech “will not always be easy to draw.”). For an additional perspective on this issue and the case *Friedman v. Rogers*, 440 U.S. 1, 99 S. Ct. 887, 59 L.Ed.2d 855 (2004), see NOWAK & ROTUNDA, *supra* note 2, § 16.12, at 697 (“In upholding the ban on trade names the majority refrained from establishing rigid rules for the regulation of commercial speech.”). The court below also held that the disparagement clause fails to pass muster under the commercial speech analysis, applying the *Central Hudson* test. *In re Tam*, 808 F.3d 1321, 1355–57 (Fed. Cir. 2015).

⁷⁵ 137 S. Ct. at 1763–64. See VerSteeg, *supra* note 3, at 748–55 (discussing application of the *Central Hudson* test to the disparagement clause).

⁷⁶ 137 S. Ct. at 1764.

⁷⁷ The *Central Hudson* test requires that in order to withstand First Amendment scrutiny, the Government’s interest in achieving its goal must be “substantial.” *Central Hudson*, 447 U.S. at 566. See *In re Tam*, 785 F.3d 567, 582 (Fed. Cir. 2015) (Judge Moore’s “Additional Views,” arguing that “The government has not put forth any substantial interests that would justify § 2(a)’s bar against disparaging marks.”); *In re Tam*, 808 F.3d 1321, 1355–57 (holding that none of the government’s alleged interests were substantial).

interests.⁷⁸ “[I]t goes much further than is necessary to serve the interest[s] asserted.”⁷⁹ In short he characterizes it as “far too broad.”⁸⁰

3. *Justice Kennedy’s Concurring Opinion.* Justice Kennedy’s concurring opinion—joined by Justices Ginsburg, Sotomayor, and Kagan—aligns itself with Parts I, II, and III.A of Justice Alito’s opinion. According to Justice Kennedy, he is going to the trouble of writing separately to flesh out “in greater detail why the First Amendment’s protections against viewpoint discrimination apply to the trademark here.”⁸¹ In addition, Justice Kennedy contends “that the viewpoint discrimination rationale renders unnecessary any extended treatment of other questions raised by the parties.”⁸²

Like Justice Alito’s discussion of viewpoint discrimination, Justice Kennedy begins by examining the fundamental tenets of the doctrine. He notes that viewpoint discrimination is actually a subspecies of content discrimination.⁸³ He next explains that, because the disparagement clause makes it possible for “an applicant . . . [to] register a positive or benign mark but not a derogatory one,” it “thus reflects the Government’s disapproval of a subset of messages it finds offensive.”⁸⁴ Justice Kennedy reasons, therefore, that “[t]his is the essence of viewpoint discrimination.”⁸⁵ One-by-one he refutes the Government’s

⁷⁸ 137 S. Ct. at 1764. For more on the *Central Hudson* “narrowly tailored” requirement of see e.g., NOWAK & ROTUNDA, *supra* note 2, § 16.12, at 682. See also VerSteeg, *supra* note 3, at 753–55 (examining this element of the *Central Hudson* test, and arguing: “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 Amendment, the government needs to show that § 2(a) is narrowly tailored to achieve the government’s goals” and concluding, “The phrase ‘may disparage’ is too broad and vague to possibly be considered ‘narrowly tailored.’”); *id.* at 737–48 (analyzing in detail why the vague and overbroad words “may” and “disparage” render the disparagement clause insufficiently narrowly tailored to promote a substantial government objective); *id.* at 707 (recounting Judge Moore’s view that trademarks should be classified as commercial speech). Interestingly, the court below did not reach the “narrowly tailored” issue. See VerSteeg, *supra* note 2, at 725 (“Judge Moore does not even analyze whether § 2(a) directly and materially advances the government’s interests and is narrowly tailored to accomplish them.”).

⁷⁹ 137 S. Ct. at 1765.

⁸⁰ *Id.*

⁸¹ *Id.*

⁸² *Id.*

⁸³ *Id.* at 1766 (“A law found to discriminate based on viewpoint is an ‘egregious form of content discrimination,’ which is presumptively unconstitutional.”).

⁸⁴ *Id.* See VerSteeg, *supra* note 3, at 734 (“It is clear that the ‘may disparage’ prohibition of § 2(a) is a content-based 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.” (footnote omitted)). See also NOWAK & ROTUNDA, *supra* note 2, § 16.1, at 623, discussing cases involving flag desecration (“Indeed, these laws did not ban all burning of flags; these laws allowed a flag to be burned in a respectful manner as a means of disposing of a used flag. Because laws banning desecration of the flag involve symbolic speech and are not content related, the court invalidated them.”). For more about symbolic speech, see *infra* Part II.C.

⁸⁵ 137 S. Ct. at 1766.

arguments that the clause is viewpoint neutral, and explains that using “the reaction of the speaker’s audience” [i.e., the perceptions of the putatively disparaged group of persons] as a litmus test for application of the disparagement clause poses a threat.⁸⁶ “The danger of viewpoint discrimination is that the government is attempting to remove certain ideas and perspectives from the broader debate.”⁸⁷

Like Justice Alito’s opinion, Justice Kennedy’s concurrence also addresses the issue of whether trademarks should be classified as commercial speech, resulting in application of the *Central Hudson* intermediate scrutiny standard. In addition, like Justice Alito, Kennedy acknowledges the question of “whether trademark registration should be considered a federal subsidy.”⁸⁸ In Justice Kennedy’s view, the mere fact that the disparagement clause itself constitutes viewpoint discrimination alone “necessarily invokes heightened scrutiny.”⁸⁹ He expressly declares that, “commercial speech is no exception.”⁹⁰ He notes that trademarks play an important role in modern “everyday life,” and concludes that the effect of the disparagement clause’s nullification of trademark registration based on viewpoint discrimination “in this context . . . permit[s] Government censorship.”⁹¹

Before closing, Justice Kennedy remarks that “confusing or misleading” marks may still be refused registration pursuant to other provisions of the Lanham Act,⁹² and that product labeling and other consumer protection requirements are not at issue.⁹³ He reminds us that “[t]he central purpose of trademark registration is to facilitate source identification,” and that the putatively disparaging nature of marks “bears no plausible relation to that goal.”⁹⁴ He eloquently sums up:

A law that can be directed against speech found offensive to some portion of the public can be turned against minority and dissenting views to the detriment of all. The First Amendment does not entrust that power to the government’s benevolence. Instead, our

⁸⁶ *Id.*

⁸⁷ *Id.* at 1767.

⁸⁸ *Id.*

⁸⁹ *Id.*

⁹⁰ *Id.* (“[T]o the extent that trademarks qualify as commercial speech, they are an example of why that term or category does not serve as a blanket exemption from the First Amendment’s requirement of viewpoint neutrality.”).

⁹¹ *Id.* at 1768. *See also* Part IV *infra* regarding the relevance of Justice Kennedy’s observation here to a workable definition for “immoral” and “scandalous matter.”

⁹² 137 S. Ct. at 1768. *See VerSteeg, supra* note 3, at 751 (explaining that “the majority of reasons for refusal to register in § 2 have the effect of preventing registration of false or misleading advertising”).

⁹³ *Id.*

⁹⁴ 137 S. Ct. at 1769.

reliance must be on the substantial safeguards of free and open discussion in a democratic society.⁹⁵

4. *Justice Thomas's Concurring Opinion.* Justice Thomas wrote a concurring opinion as well. His brief concurrence simply stresses two points. First, he states that his reason for not joining Part II of the Court's opinion is that Tam had not argued that the disparagement clause fails to reach non-juristic persons (e.g., racial and ethnic groups) when the case was before the TTAB or CAFC. Hence he says that he perceives "no reason to address" that issue.⁹⁶ Second, he reaffirms his belief that strict scrutiny should always apply to situations where "the government seeks to restrict truthful speech in order to suppress the ideas it conveys. . . ."⁹⁷ But he "join[s] Part IV of Justice Alito's opinion because it correctly concludes that the disparagement clause . . . is unconstitutional even under the less stringent test announced in *Central Hudson*."⁹⁸

C. IMMEDIATE IMPACT

The *Tam* decision is likely to affect the nature of trademark registrations in the United States for many years to come. One of the most significant and immediate results of the *Tam* decision occurred within days after the opinion was released. On June 21, 2017, attorneys for Pro-Football asked the Fourth Circuit Court of Appeals to "reverse the judgment of the district court, vacate the district court's order directing the PTO to schedule cancellation of Pro Football's trademark registrations [of the Washington Redskins football team,] and remand the case with instructions to grant summary judgment to Pro-Football."⁹⁹ But, beyond the direct effect that the opinion will have on the Slants band and the Redskins football team, more generally speaking, PTO trademark examining attorneys will no longer have discretion to impose their own opinions to prohibit registration of marks that *might* bruise the feelings of groups and individuals, using the disparagement clause. In addition, individuals and groups who suffer such bruised feelings will no longer be capable of using § 2(a) as a weapon to oppose and cancel the registrations of marks that they deem offensive to them.¹⁰⁰

By freeing up the marketplace in this manner, trademark applicants will select their trademarks in a climate where they will be at liberty to pick marks that may, in fact, offend persons, institutions, or beliefs. But, presumably, they will do so

⁹⁵ *Id.*

⁹⁶ *Id.*

⁹⁷ *Id.*

⁹⁸ *Id.*

⁹⁹ Letter from Lisa S. Blatt, Counsel for Pro-Football to Patricia S. Conner, Clerk of the Court.

¹⁰⁰ See 15 U.S.C. § 1063 (opposition); 15 U.S.C. § 1064(3) (cancellation). See *infra* Part IV, which suggests that an appropriate definition of "immoral" and "scandalous matter" may provide a means to prevent registration of some marks that would fall outside the scope of the protections of the First Amendment.

at their peril. They will simply run the risk that their disparaging marks will create negative criticism and rally opponents to boycott their products or services. Public and consumer opinion will drive the marketplace rather than an examining attorney's rejection. As long as their adopted marks do not fall into the category of unprotected speech¹⁰¹ and as long as their marks are not otherwise disqualified under the other of subsections of § 2, which define the metes and bounds of valid trademarks,¹⁰² trademark applicants may choose marks that some will find distasteful and offensive. But, according to *Matal v. Tam*, that is the nature of First Amendment freedom.¹⁰³

Trademarks are the names and symbols by which sellers identify and distinguish their goods and services from those of others.¹⁰⁴ The names and symbols provide consumers information with which they can make choices. Some trademark owners have even chosen names that they know lack consumer appeal, and yet have stuck with such names. Recall for instance the admission by the Smucker's Corporation in its advertising which stated: "With a name like Smucker's it has to be good."¹⁰⁵ Presumably, those who wish to sell goods or services take into account multiple factors when selecting trademarks. Those who wish to "start from scratch," so to speak, may coin a word or symbol by selecting a fanciful mark.¹⁰⁶ Those who choose arbitrary marks typically select

¹⁰¹ See *infra* Part IV.

¹⁰² 137 S. Ct. at 1763–65. Part IV briefly considers some of the issues raised by *In re Brunetti*, 877 F.3d 1330 (Fed. Cir. 2017), and focuses, in part, on defining the words "immoral" and "scandalous" in a way to prohibit registration of marks that cross the line separating "may disparage" and matter that is either "unprotected" by the First Amendment or within the scope permissible under the reasoning of *FCC v. Pacifica Foundation*, 438 U.S. 726 (1978).

¹⁰³ See *infra* Part III.B.

¹⁰⁴ RESTATEMENT OF THE LAW (THIRD), UNFAIR COMPETITION § 9. DEFINITIONS OF TRADEMARK AND SERVICE MARK (AM. LAW INST. XXXX) ("A trademark is a word, name, symbol, device, or other designation, or a combination of such designations, that is distinctive of a person's goods or services and that is used in a manner that identifies those goods or services and distinguishes them from the goods or services of others. A service mark is a trademark that is used in connection with services."). The Lanham Act defines "trademark" as including "any word, name symbol or device . . . [used] to identify and distinguish . . . goods." 15 U.S.C. § 1127. Interestingly, given that many trademarks are, in fact, symbolic in a non-linguistic sense, such marks may, for purposes of First Amendment analysis, come within the scope of what the Court has called "symbolic speech." For a discussion of symbolic speech and its relationship to the First Amendment, see, e.g., NOWAK & ROTUNDA, *supra* note 2, § 16.1, at 621–24; *id.* § 16.29, at 756–58 (discussing several important symbolic speech cases, such as *United States v. O'Brien*, 391 U.S. 367 (1968) (burning draft cards), *Tinker v. Des Moines Independent School District*, 393 U.S. 503 (1969) (black armbands worn by high school students to protest the war in Vietnam, and *Texas v. Johnson*, 491 U.S. 397 (1989) (flag desecration)).

¹⁰⁵ The J.M. Smucker Company owns United States Trademark Registration Numbers 850,303 and 3,082,687 for the mark "WITH A NAME LIKE SMUCKER'S IT HAS TO BE GOOD," which mark incorporates the SMUCKER'S trademark in its entirety. The J.M. Smucker Company v. The Weston Firm, P.C., 2013 WL 875794, Trial Pleading No. 5:13-cv-448 (N.D. Ohio 2013).

¹⁰⁶ See MCCARTHY ON TRADEMARKS §§ 11:8, 11:15 ("Fanciful marks consist of 'coined' words that have been invented or selected for the sole purpose of functioning as a trademark." (footnote

words or symbols that they believe have some type of positive association in consumers' minds.¹⁰⁷ Those who pick suggestive marks typically do so because they hope that consumers will appreciate the subtle, often nuanced, humor and cleverness that is part and parcel of the power of suggestion.¹⁰⁸ Those who decide to use descriptive marks usually do so in an effort to be direct and forthright with consumers to convey the ingredients and qualities of what they are offering to the public.¹⁰⁹

But whether sellers select a fanciful, arbitrary, suggestive, or descriptive mark, they all have one thing in common. They all choose a mark whose appearance, sound, or meaning they think will appeal in some way to their targeted consumers. Occasionally, a seller misjudges his audience, but presumably, most sellers do their best to maximize positive consumer associations between their chosen trademarks and their goods or services. So, when a seller picks a mark that some segment of the population considers offensive or disparaging to them, their institutions, or their beliefs, presumably the seller risks losing sales to that segment of the population and others who sympathize with those who perceive that disparagement. Essentially the *Tam* decision gives such sellers sufficient rope to hang themselves in this manner.¹¹⁰

omitted)); see also *Ashley Furniture Indus. v. SanGiacomo N.A. Ltd.*, 187 F.3d 363, 369 (4th Cir. 1999).

¹⁰⁷ See MCCARTHY, *supra* note 106, § 11:11 (“Arbitrary marks comprise those words, symbols, pictures, etc., that are in common use but which, when used with the goods or services in issue, neither suggest nor describe any ingredient, quality or characteristic of those goods or services.” (footnote omitted)).

¹⁰⁸ See *id.* § 11:67 (“The more imagination that is required on the potential customer’s part to get some direct description of the product from the designation, the more likely the designation is suggestive, not descriptive.” (footnote omitted)); *id.* § 11:66 (“The descriptive-suggestive borderline is hardly a clear one. Its exact location in any give situation is hazy and only subjectively definable.”). See also *id.* § 11:62.

¹⁰⁹ See *id.* § 11:16 (explaining that courts commonly state that a putative mark is “descriptive” if it immediately relates the nature, contents, or characteristics of its associated product). Also note that surnames, technically speaking, frequently are descriptive, because a surname used as a mark typically (though not categorically) describes the producer or endorser of a product or service. See also TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1211 Refusal on Basis of Surname. See, e.g., *Taylor Wine Co. v. Bully Hill Vineyards*, 569 F.2d 731 (2d Cir. 1978); *Zobmondo Entm’t v. Falls Media*, 602 F.3d 1108 (9th Cir. 2010); *Sec. Ctr. v. First Nat’l Sec. Ctrs.*, 750 F.2d 1295 (5th Cir. 1985); *Peaceable Planet v. Ty, Inc.*, 362 F.3d 986, 989 (7th Cir. 2004) (“The reluctance to allow personal names to be used as trademarks reflects valid concerns. . . . One of the concerns is a reluctance to forbid a person to use his own name in his own business.”); *In re Quadrillion Publ’g Ltd.*, 2000 T.T.A.B. LEXIS 562, 563 (Aug. 9, 2000) (“The Trademark Examining Attorney has refused registration under Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4), on the ground that applicant’s mark is primarily merely a surname. We affirm the refusal to register.”); *In re Joint-Stock Company “Baik,”* 84 U.S.P.Q.2d (BNA) 1921, 1925 (T.T.A.B. 2007) (the TTAB held that “BAIK” was a rare surname and thus not primarily merely a surname. In his concurring opinion, Judge Seeherman’s stated, “if a term does not have the ‘look and feel’ of a surname, it should not be refused registration even if there is evidence to show that it is, in fact, a surname”).

¹¹⁰ See JEROME HALL, FOUNDATIONS OF JURISPRUDENCE 147 (1973) (“[L]lewellyn regarded laymen’s behavior as ‘part of the law’ and he also included ‘in the field of law’ not only the behavior

III. FOUNDATIONS OF TRADEMARK LAW AND THE FIRST AMENDMENT

A. CORE TRADEMARK PRINCIPLES

As was mentioned, early in his opinion, Justice Alito refers to the historical origins of trademark law.¹¹¹ Thus, Part III of this Article explores a number of significant principles and relationships from those origins in order to assess whether they support the disparagement clause.

1. *Trademarks as Property.* Modern trademark law recognizes that trademarks are a form of property, which sellers acquire by using a mark in commerce.¹¹² Thus, when Simon Tam and his band decided to call themselves The Slants, they acquired federal trademark rights in that name once they used it in a manner sufficient to constitute interstate commerce. Courts have deemed trademarks as a type of property at least since the mid-fifteenth century.¹¹³

of officials, their practices, and their contacts with laymen but, also 'sets of accepted formulae which judges recite, seek light from, try to follow, . . . various persons' ideas of what the law is; and especially their views of what it or some part of it ought to accomplish. . . . Farther from the center lies legal and social philosophy . . . Part of law, in many aspects, is all of society, and all of man in society.' (quoting LLEWELLYN, JURISPRUDENCE 40-41 (1962)).

¹¹¹ See *supra* note 23 and accompanying text.

¹¹² See generally *Central Manufacturing, Inc. v. Brett*, 492 F.3d 876 (7th Cir. 2007); see, e.g., *Blue Bell, Inc. v. Farah Mfg. Co.*, 508 F.2d 1260, 1265 (5th Cir. 1975) ("The gist of trademark rights is actual use in trade."); *Thoroughbred Legends, LLC v. Walt Disney Co.*, 2008 U.S. Dist. LEXIS 19960m, at *11 n.13 (N.D. Ga. Feb. 12, 2008) ("A plaintiff in a trademark infringement lawsuit must not only show that it used its mark in commerce, but also that it used the mark as a *trademark*, whether the mark is registered or not." (citation omitted)); *In re Dell Inc.*, 71 U.S.P.Q.2d (BNA) 1725 (T.T.A.B. 2004); *In re Gastown, Inc.*, 326 F.2d 780 (C.C.P.A. 1964); *Zazu Designs v. L'Oreal, S.A.*, 979 F.2d 499, 503 (7th Cir. 1992) ("Use" is neither a glitch in the Lanham Act nor a historical relic. By insisting that firms use marks to obtain rights in them, the law prevents entrepreneurs from reserving brand names in order to make their rivals' marketing more costly."); *White v. Paramount Pictures Corp.*, 1997 WL 76957, at *2 (Fed. Cir. 1997) ("Section 45 of the Act defines the term 'use in commerce' to mean 'the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.' 15 U.S.C. § 1127. The 'ordinary course of trade' requirement is the result of the amendments to the Act made by the Trademark Law Revision Act of 1988, Pub. L. 100-667, 102 Stat. 3935 (1988) ('Revision Act'). The Revision Act provided for a new concept of trademark use than that which had been employed in the past. Prior to the Revision Act's effective date of November 16, 1989, 'token' use of a trademark was enough for registration purposes. Under the current law, applicants for registration can file either based on use or intent to use the mark. Therefore, the Revision Act eliminated the necessity for a token use system to reserve a mark, and instituted the requirement that the use must be in the 'ordinary course of trade.' 15 U.S.C. § 1127."). See also *Tam*, 582 U.S. ____, (2017) Opinion of Alito, J. slip op. at 3 ("Under the Lanham Act, trademarks that are "used in commerce" may be placed on the "principal register," that is, they may be federally registered." (citing 15 U. S. C. § 1051(a)(1)).

¹¹³ SCHECHTER, *supra* note 15, at 109 ("The importance of the case of the mark of the Double Crescent is twofold in that it shows (i) that by 1452 the cutler's mark had become of sufficient value to be the subject of litigation for its restoration and (2) that the notion of property in a mark had developed so far that the widow of the owner of a mark, as long as she remained in business, was entitled to retain the use of the mark (*marquam suam pristinam*), even subsequent to her remarriage." (footnote omitted)). See also Edward S. Rogers, *Some Historical Matter Concerning Trade-Marks*, 9 MICH.

Whether trade-marks are accurately called property or not, it is clear that some of the rights that are incident to property do attach to them; and therefore . . . it may be convenient to speak of trade-marks as “property,” as a short way of expressing a limited truth that requires ampler means for a complete and accurate statement. . . .”¹¹⁴

As a form of property, modern trademark owners consider their marks as a distinct and important business asset. Interestingly, the law was actually rather slow to recognize trademarks as assets. Schechter identifies this development as having occurred in the seventeenth century.¹¹⁵ Many ancient legal systems recognized that legal rights to property may originate by means of possession and

L. REV. 29, 36 (1910) (describing a will dated July 1574, Rogers states: “That these symbols were regarded as valuable property is evident. . . .”); GRANT, *supra* note 2, at 110 (“The study of our legal past is helpful to lawyers and judges and legislators in the same way that the study of recorded games is helpful to a chess player. But the principal lesson to be drawn from our study is that the part of wisdom is to keep our theories open-ended, our assumptions tentative, our reactions flexible. We must act, we must decide, we must go this way or that. Like the blind men dealing with the elephant, we must erect hypotheses on the basis of inadequate evidence. That does no harm—at all events it is the human condition from which we will not escape—so long as we do not delude ourselves into thinking that we have finally seen our elephant whole.”).

¹¹⁴ SCHECHTER, *supra* note 15, at 156. *See also id.* at 171 (“Using the term property in its modern legal sense, viz., as a right having a pecuniary value which will be protected by the legal agencies of society, rights in or pertaining to trade-marks may be classified as property.”); *id.* (“However, the classification of trade-marks as property is not essential to their protection since equity should, in any event, prevent the destruction or impairment of the probable expectancy of trade or custom, of which the trade-mark is a symbol as well as a creative factor.” *See also* Paster, *supra* note 15, at 566 (“In the case of *Millington v. Fox* the Lord Chancellor, Lord Cottenham (without citing any authorities and ignoring *Blanchard v. Hill*) held that equity would enjoin trade-mark infringement even though such infringement was without intent to defraud and in ignorance of plaintiff’s ownership of the trademark involved. This decision led by obvious deduction to the recognition of a right of property arising from the use of a trademark. Thereafter protection of trademarks in equity became based upon a theory of property rights.” (citing *Millington v. Fox*, (1838) 3 Myl & Cr 338, and T.A. Blanco White, *Kerly’s Law of Trade Marks and Trade Names*, at 4 (9th ed. 1966))); Edward S. Rogers, *The Lanham Act and the Social Function of Trade-Marks*, 14 LAW & CONTEMPORARY PROBLEMS 173, 182 (1949) (“The word ‘property’ as applied to trade-marks * * * is an unanalyzed expression of certain secondary consequences of the primary fact that the law makes some rudimentary requirements of good faith.” (quoting Oliver Wendell Holmes in *Dupont v. Masland* (244 U. S. 100, 102))). *See, e.g.*, *International Order of Job’s Daughters v. Lindeburg & Co.*, 633 F.2d 912, 919 (9th Cir. 1980) (“A trademark is, of course, a form of business property. *See* MCCARTHY, *supra* note 106, §§ 2:6–2:7. But the ‘property right’ or protection accorded a trademark owner can only be understood in the context of trademark law and its purposes. A trademark owner has a property right only insofar as is necessary to prevent consumer confusion as to who produced the goods and to facilitate differentiation of the trademark owner’s goods.”).

¹¹⁵ SCHECHTER, *supra* note 15, at 101 (“[I]n the seventeenth century, the modern concept of a trade-mark as an asset of value begins to appear.”). *See also id.* at 122–23 (“[W]hile the affixing of that mark may have worked to the detriment of its user, since thereby defective workmanship could be traced and punished, long before the use of marks ceased to be compulsory, their users began to [123] realize the possibility of those marks as an asset, *i.e.*, as a symbol of good-will.”).

use.¹¹⁶ Blackstone specifically mentions “occupation,” which the Romans called “*occupatio*,” as a conventional means of acquiring ownership of property.¹¹⁷ Yet, as Schechter acknowledges, “[i]t is worthy of note that the second volume of *Blackstone’s Commentaries*, which appeared in 1766, contains no reference whatsoever to the subject of trade-marks in his discussion (Bk. II, Chap. XXVI) of ‘Titles to Things Personal by Occupancy,’ although among the ‘things personal’ there enumerated are patents and copyrights.”¹¹⁸ But Blackstone emphasizes the paramount importance of property in the British system of the eighteenth century, stating, “The third absolute right, inherent in every Englishman, is that of property: which consists in the free use, enjoyment, and disposal of all his acquisitions, without any control or diminution, save only by the laws of the land.”¹¹⁹

Since this section of the Article examines the relationship between the foundations of legal acquisition of property and trademarks, one important point to emphasize is that, like much legal acquisition of property, acquisition of trademark rights begins with the *use* of the trademark.¹²⁰ The trademark registration process does not create trademark rights *per se*, but federal trademark registration adds significant benefits to a trademark owner’s layers of legal protection.¹²¹ Registration of trademarks has its roots in the Middle Ages. Some of the guilds required merchants and craftsmen to register their proprietary marks.¹²² Initially, registration with the guild was required so that consumers and

¹¹⁶ See, e.g., J.A.C. THOMAS, TEXTBOOK OF ROMAN LAW 138 (1976) (“[P]ossession did in fact have considerable connexion with ownership. . . .”); *id.* at 157–63 (explaining the relationship between *possessio* and *usucapio*); BARRY NICHOLAS, AN INTRODUCTION TO ROMAN LAW 107–15, 122–30 (1972).

¹¹⁷ * WILLIAM BLACKSTONE, COMMENTARIES * 205 (Forward by Richard J. Goldstone, 2009 American Bar Association). According to Blackstone, title by occupancy vests as follows: “[W]hatever moveables are found upon the surface of the earth, or in the sea, and are unclaimed by any owner, are supposed to be abandoned by the last proprietor; and therefore belong, as in a state of nature, to the first occupant or fortunate finder.” See also THOMAS, *supra* note 116, at 166–68; NICHOLAS, *supra* note 116, at 130–36.

¹¹⁸ SCHECHTER, *supra* note 15, at 129 (footnote omitted). See also Paster, *supra* note 15, at 564 (“Giles Jacob in 1723 in his *New Law Dictionary* says that a ‘mark of goods . . . is what ascertains the Property or Goodness thereof &c. And if one Man shall use the Mark of another, to the intent to do him Damage, Action upon the Case lieth. 2 Cro. 471.’ The second volume of Blackstone’s *Commentaries* (1766) contains no reference whatever to the subject of trademarks in his discussion (Book II, Ch.XXVI) of ‘Titles of Things Personal by Occupancy’ although among the ‘things personal’ there enumerated are patents and copyrights.”).

¹¹⁹ BLACKSTONE, *supra* note 117, at 12.

¹²⁰ See *Blue Bell, Inc. v. Farah Mfg. Co.*, 508 F.2d 1260, 1265 (5th Cir. 1975) (“The gist of trademark rights is actual use in trade.”).

¹²¹ See *Tam*, 582 U.S. ___, (2017) Opinion of Alito, J. slip op. at 5; See VerSteeg, *supra* note 3, at 682.

¹²² See generally SCHECHTER, *supra* note 15, at 47–63. See also L.E. Daniels, *The History of The Trade-Mark*, 7 BULLETIN OF THE UNITED STATES TRADEMARK ASSOCIATION 239, 248 (1911) (“[In Medieval Europe,] ‘the trade-mark seems to have been imposed by the gild upon all goods produced by its members, the mark both showing the origin of the goods and acting as a stamp to

competitors would be able to identify the manufacturer of a product in the event that the product later proved substandard, injurious, or otherwise defective.¹²³ It was much later that any type of registry was established for the purpose of securing or strengthening a mark owner's rights.¹²⁴ "It was not until 1875 . . . that the first British trade-mark registration statute was enacted. In 1870 the first United States statute providing for the registration of marks was passed and, this statute being held unconstitutional, a similar one was re-enacted with the objectionable features eliminated in 1876."¹²⁵

Nevertheless, registration aimed at securing and strengthening rights is a vital aspect of the *Tam* case. To a large degree what triggers application of First Amendment principles in the *Tam* litigation is that, by denying federal registration for a mark that "may disparage," the government chills a mark owner's freedom of speech, because a putative applicant is far less likely to select a mark and apply for federal registration of a mark if she fears that the PTO will deny registration, based on the viewpoint of the message (i.e., the allegedly disparaging nature) of the mark selected.¹²⁶ And that is one of the principal reasons why the CAFC, in its opinion below, held that the Government's denial of those benefits to marks that "may" cause disparagement is unconstitutional.¹²⁷

guarantee quality."); Paster, *supra* note 15, at 556 ("As a rule, when one became a master craftsman, he was required to choose a mark, obliged to use it on all goods he produced, and to retain it his entire life. Use of a mark was obligatory, part of the duty to the community, and demanded by the strict social order of craft guilds of the Middle Ages." (footnote omitted)); Abraham S. Greenberg, *The Ancient Lineage of Trade-Marks*, 33 J. PAT. OFF. SOC'Y, 876, 881 (1951) ("Guild regulations required every product of a member craftsman to display the unique mark of the guild, and, in addition, the special recorded brand or trade-mark of the individual artisan."); *id.* at 885 ("In 1619 the gold beaters' guild at Nurnberg established a compulsory trade-mark register for the purpose of recording the names of all master workmen and their respective trade-marks. This register now is preserved among the official archives of the city.").

¹²³ SCHECHTER, *supra* note 15, at 47 ("Their expressed purpose was to facilitate the tracing of 'false' or defective wares and the punishment of the offending craftsmen."). See also Sidney A. Diamond, *The Historical Development of Trademarks*, 65 THE TRADEMARK REPORTER 265, 280 (1975) ("[T]he guild marks which were the principal development of the mediaeval period very largely were compulsory marks whose primary purpose was to fix the blame for inferior workmanship."); *Plasticolor Molded Products v. Ford Motor Company*, 713 F. Supp. 1329, 1331 (1989) ("[T]he trademark as we know it today most likely originated with the medieval guilds of Europe, who often required members to identify their products 'to facilitate the tracing of 'false' or defective wares and the punishment of the offending craftsman.'" (quoting Schechter)).

¹²⁴ SCHECHTER, *supra* note 15, at 140.

¹²⁵ *Id.* (footnotes omitted); see also Paster, *supra* note 15, at 568 ("It was not until 1875 that the ignorance and indifference of Parliament in this matter of registration was finally overcome and the first British trademark registration statute enacted. In 1870 the first United States statute providing for the registration of trademarks was passed, that statute being held unconstitutional. A similar statute was reenacted in 1876 with the objectionable features of the earlier law eliminated." (footnotes omitted)); *Trade-Mark Cases*, 100 U.S. 82 (1879).

¹²⁶ See VerSteege, *supra* note 3, at 722.

¹²⁷ See *id.* ("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. 'The general principle is clear: "Lawmakers may no more silence unwanted speech by burdening its

For millennia, sellers have used names, letters, and other symbols to signify to potential buyers the source of goods and services. The ancient Greeks stamped names and symbols on amphora when shipping wine and oil.¹²⁸ The Roman city of Pompeii has ample evidence of shopkeepers, who wrote their names on the doors and gates that served as entryways for their business establishments.¹²⁹ By the time of Sir William Blackstone in the mid-1700's, English law had begun forging foundational principles regarding what was fair and otherwise appropriate for sellers to use as trademarks. In particular, Blackstone notes that corporations were required to designate a company name for legal purposes: "When a corporation is erected, a name must be given to it;

utterance than by censoring its content." And the court explicitly recognized that the '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.' (footnotes omitted).

¹²⁸ SCHECHTER, HISTORICAL FOUNDATIONS, *supra* note 15, at 20. For more regarding the use of such marks in ancient Greece, see e.g., Gerald Ruston, *On the Origin of Trademarks*, 45 THE TRADE MARK REPORTER 127, 132 (1955) ("In the best period of Greek Art, from about 400 B.C. onwards, many vases, jars and other pottery objects were marked in various ways; potters', painters' and official marks are all known."); Paster, *supra* note 15, at 553 ("Greek pottery commonly displays pictures representing the adventures of classical heroes, but there also appears a mark on the base of the pots believed to signify the origin of the product. Few examples of Grecian sculpture lack the inscription of the sculptor's name. On decorated pieces, the name of the decorator is also included. Kohler reports that beside the maker's name, cup handles for the use at the Ceramicus of Athens often displayed abstract trademarks in the form of figures of Mercury's staffs, oil jugs, bees and lions' heads." (footnotes omitted)); Greenberg, *supra* note 122, at 878 ("A study of the ancient Greek potters' creations (lamps, vases, cups, amphora) revealed pictorial trade-marks of considerable fancy. For example, a cock, a hand, flowers, a cow's head (shades of Borden's "Elsiel"), a crab, an anchor, a lyre, a mask.").

¹²⁹ See generally Daniels, *supra* note 122, at 246 ("Signs for inns, now so common in England and Germany, were often seen in old Roman towns. In Pompeii was an inn having the sign of an elephant and the notice, '*Hospitium hic locatur, triclinium, cum tribus lectis et com (modis)*' – 'Here is an inn, with a dining-room that has three comfortable couches.'"); Ruston, *supra* note 128, at 133 ("The cities of Pompeii and Herculaneum have yielded considerable quantities of finds of interest. Amongst others are a number of shop and inn signs, carved on stone. Some of the former were: a goat-a dairy; a mule-driven corn mill-the baker; a man beating a boy-the school master."); Greenberg, *supra* note 122, at 880 ("The signboard has an ancient background. The inn sign was often seen in the old Roman towns. In excavated Pompeii was found an inviting inn sign displaying the picture of an elephant with the statement:– 'Here is an inn, with a dining room that has three comfortable couches.'"); WILLIAM HENRY BROWNE, TREATISE ON THE LAW OF TRADE-MARKS AND ANALOGOUS SUBJECTS (FIRM-NAMES, BUSINESS-SIGNS, GOOD-WILL, LABELS, &C.) (1898) § 6, 6 ("Among the ruins of Herculaneum and Pompeii have been discovered signs crudely painted, or graven in stone, or modeled in relievio in terra-cotta, and inserted in the pilasters at the side of the open shop-fronts."); Rogers, *supra* note 113, at 31 ("Signs for inns and shops were as well known as they are now."). See also MARK S. LEE, ENTERTAINMENT AND INTELLECTUAL PROPERTY LAW § 2:3 Historical background (August 2017 update); B & B Hardware, Inc. v. Hargis Industries, Inc., 135 S. Ct. 1293, 1299 (2015); MCCARTHY ON TRADEMARKS, *supra* note 106, § 5:1 Early origins of trade symbols (4th ed.) (June 2017 update).

and by that name alone it must sue, and be sued, and do all legal acts.”¹³⁰ And in Blackstone’s England, lawyers had already grasped the notion that intangible rights—such as trademarks—constituted a category of property: “incorporeal are not the object of sensation, can neither be seen nor handled, are creatures of the mind, and exist only in contemplation.”¹³¹ And, as further evidence that eighteenth-century British lawyers recognized other intangible rights closely associated with trademarks, Blackstone, as has been noted, expressly acknowledged both copyrights and patents.¹³²

And even to the extent that, since 1988, United States trademark law has recognized a limited, preliminary right to marks that have been adopted but not yet used in commerce—via the Intent-To-Use filing process¹³³—Blackstone’s English laws recognized that initial pursuit of property acquisition could create limited, preliminary rights. According to Blackstone: “[I]f a man starts any game within his own grounds, and follows it into another’s, and kills it there, the property remains in himself. And this is grounded on reason and natural justice: for the property consists in the possession; which possession commences by the finding in his own liberty, and is continued by the immediate pursuit.”¹³⁴

Professor Frank Schechter detailed the historical development of trademarks in his notable work *The Historical Foundations of Law Relating to Trade-Marks*.¹³⁵

¹³⁰ BLACKSTONE, *supra* note 117, at 72. See also *id.* at 73 (“To have a common seal. For a corporation, being an indivisible body, cannot manifest it’s [sic] intentions by any personal act or oral discourse: it therefore acts and speaks only by it’s [sic] common seal.”).

¹³¹ *Id.* at 78.

¹³² See *id.* at 205 (“There is still another species of property, which being grounded on labour and invention, is more reducible to the head of occupancy than any other. And this is the right, which an author may be supposed to have in his own literary compositions: so that no other person without his leave may publish or make profit of the copies.”). See also *id.* at 417 (“[S]tatute 21 Jac. I. c. 3. . . . declares . . . monopolies to be contrary to law and void; (except as to patents, not exceeding the grant of fourteen years, to new authors of new inventions. . . .”).

¹³³ 15 U.S.C. § 1051(b) [Lanham Act § 1(b)] (b) Application for bona fide intention to use trademark. See, e.g., *M.Z. Berger & Co., Inc. v. Swatch AG*, 787 F.3d 1368, 1378 (Fed. Cir. 2015) (“The Board concluded that Berger merely intended to reserve a right in the mark and thus lacked the requisite intent. Because substantial evidence supports the Board’s determination, we affirm.”); *id.* at 1374 (“The Trademark Law Revision Act of 1988 (TLRA) contemplated the very scenario presented by this case. The TLRA changed the Lanham Act by permitting applicants to begin the registration process before actual use of the mark in commerce at the time of filing, so long as the applicant had a “bona fide intention . . . to use [the] mark in commerce” at a later date. 15 U.S.C. § 1051(b)(1) (emphasis added); *id.* at 1374 (“The prior version of the Lanham Act required that a trademark applicant already be using the mark in commerce at the time of the application’s filing to qualify for trademark registration.”); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d (BNA) 1503, *4 (T.T.A.B. 1993) (“The determinative issue raised by the parties’ motions therefore becomes whether the absence of any documents evidencing applicant’s claimed intention to use its mark may be sufficient to constitute objective proof of a lack of a bona fide intention to use.”).

¹³⁴ BLACKSTONE, *supra* note 117, at 208.

¹³⁵ See *supra* Introduction. In addition to Professor Schechter’s work, there are a number of works that provide ample information on the history of trademarks. See, e.g., BROWNE, *supra* note 129;

Although making some passing references to the proprietary marks of ancient merchants,¹³⁶ Schechter explores in far greater detail the developments of such marks in the British Isles and Northern Europe, beginning in the Middle Ages.¹³⁷ And in addition to addressing the development of trademarks and trademark law in general, Schechter recounts the genesis of trademarks in the guilds and in several specific trades, such as cutlery, cloth makers, printers and publishers, and bakers.¹³⁸ Especially relevant to the disparagement clause of § 2(a), Schechter devotes considerable attention to the question of whether early trademark law recognized trademarks as a unique kind of property.¹³⁹ Essentially he concludes that property law does indeed lie at the core of the recognition of an owner's trademark rights.¹⁴⁰ It is, in fact, fair to say that the earliest ancestors of modern legal doctrine contemplated that trademark owners were entitled to property rights in their marks. So history supports Simon Tam and his band's entitlement to consider their trademark "The Slants" as their property.¹⁴¹

Similarly, modern trademark doctrine recognizes, as actionable, conduct that damages an owner's mark in numerous ways. And again, Blackstone's discussion of damage to property shares the same basic concepts:

As to the damage that may be offered to things personal, while in the possession of the owner, as hunting a man's deer, shooting his dogs, poisoning his cattle, or in any wise taking from the value of any of his chattels, or making them in a worse condition than before, these are injuries too obvious to need explanation.¹⁴²

Rogers, *supra* note 113, at 29; Daniels, *supra* note 122, at 239; Ruston, *supra* note 128, at 127; Diamond, *supra* note 117, at 265; Paster, *supra* note 15, at 551; Greenberg, *supra* note 122, at 876.

¹³⁶ SCHECHTER, *supra* note 15, at 20.

¹³⁷ *Id.* at 19–37.

¹³⁸ *Id.* at 38–77.

¹³⁹ *Id.* at 146–71. See also *Tam*, 582 U.S. ___, (2017) Opinion of Alito, J. slip op. at 3 (remarking that, in 1946 when the Lanham Act was passed, trademarks, as is still true today, "often consisted of catchy phrases that convey a message").

¹⁴⁰ SCHECHTER, *supra* note 15, at 171 ("Using the term property in its modern legal sense . . . rights in or pertaining to trade-marks may be classified as property.").

¹⁴¹ See, e.g., *id.* at 127 ("[I]t was not until the beginning of the eighteenth century that the lawyers or at any rate law-writers and lexicographers were evidently beginning to think at all in general terms of trade-marks and when they did so, their definitions of trade-marks indicated a still very considerable uncertainty on their part as to the exact function of a mark and as to the basis of complaint for the mis-use of a mark."); *id.* at 128 ("In 1732 Jacob, in his *New Law Dictionary*, again says that a "mark of goods" is what ascertains the Property or Goodness thereof &c. And if one Man shall use the Mark of another, to the intent to do him Damage, Action upon the Case lieth. 2 *Cro.* 471.").

¹⁴² BLACKSTONE, *supra* note 117, at 284. See also *id.* at 271–72 ("This action, of *trespass*, or transgression, *on the case*, is an universal remedy, given for all personal wrongs and injuries without force; so called because the plaintiff's whole case or cause [272] of complaint is set forth at length in the original writ.").

Interestingly, in his recounting of the development of trademark law from the Middle Ages to the beginning of the Twentieth Century, Schechter refers to only one trademark that was remotely risqué (i.e., a mark that may have been disparaging to persons, institutions, or beliefs). In that instance, a sixteenth-century British printer had copied a French design of the Roman goddess Virtue, whose depiction was described as “a very ungainly and not too decent lady.”¹⁴³ But Schechter neither editorializes nor comments on the matter further. Apparently, neither those involved at the time nor Schechter considered a representation of a “not too decent lady” as having been improper to use as a trademark.¹⁴⁴ Perhaps this potentially offensive representation of Virtue raised no red flags simply because its potentially offensive character was irrelevant to its status as a form of property owned by the printer. Similarly, the disparagement clause has nothing to do with the fundamental property law principles that serve as the foundations of trademark law and policy.

2. *Trademarks as Protection from Fraud and Deceit.* In addition to basic acquisition of property rights, Blackstone discusses commercial law principles that reflect the roots of trademark infringement law.¹⁴⁵ In modern United States trademark law, generally speaking, trademark infringement occurs when a defendant’s use of a mark is likely to cause confusion to an appreciable number of relevant consumers.¹⁴⁶ The core concern that this principle addresses is that, due to a mistake caused by confusion, stemming from the similarity of a plaintiff’s and defendant’s marks, potential consumers might purchase the infringer’s goods rather than the trademark owner’s goods.¹⁴⁷ In simple terms, a cause of action for trademark infringement has a number of goals. One of those goals is to protect consumers by providing legal redress for the fraud and deception perpetrated on the public by an infringer.¹⁴⁸ For example, if another band were

¹⁴³ SCHECHTER, *supra* note 15, at 70.

¹⁴⁴ *Id.* (“John Bydell’s figure of Virtue (a very ungainly and not too decent lady) is copied from a device used by Jacques Sacon, a Lyons printer of the beginning of this century.”).

¹⁴⁵

¹⁴⁶ RESTATEMENT (THIRD) (AM. LAW INST. 1995). OF UNFAIR COMPETITION § 21 PROOF OF LIKELIHOOD OF CONFUSION: MARKET FACTORS. *See, e.g.*, *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979); *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1360 (C.C.P.A. 1973); *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1527 (4th Cir. 1984); *E. & J. Gallo Winery v. Consorzio del Gallo Nero*, 782 F. Supp. 457, 461 (N.D. Cal. 1991); *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 256 (2d Cir. 1987); *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 1319 (Fed. Cir. 2014) (The CAFC affirmed a decision by the TTAB in which the TTAB analyzed likelihood of confusion using the *Dupont* factors: “The Board conducted the likelihood of confusion inquiry pursuant to the thirteen factors set forth in *Application of E.I. DuPont DeNemours*, 476 F.2d 1357, 1361 (C.C.P.A. 1973)”); *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1307 (2015) (“The real question, therefore, is whether likelihood of confusion for purposes of registration is the same standard as likelihood of confusion for purposes of infringement. We conclude it is, for at least three reasons.”).

¹⁴⁷

¹⁴⁸ Part III.B of this Article addresses in greater detail the relationship between trademarks and the First Amendment. But here it is worth noting that when a government “seeks to regulate to

to adopt the name "The Slants" or a name confusingly similar to it, consumers might mistakenly purchase tickets to that band's concert or might mistakenly purchase a CD or MP3-download of that band's music instead of Simon Tam's band. In addition, a cause of action for trademark infringement seeks to prevent the unjust enrichment that might occur when duped consumers pay money for concert tickets, CD's, or downloads to an infringer.¹⁴⁹ Furthermore, a cause of action for trademark infringement provides some redress for any diminution of the owner's reputation caused by an infringer's use of a confusingly similar mark.¹⁵⁰ And indeed Blackstone states the fundamental doctrine, which supports the concept of trademark infringement:

When I once have gained a rightful possession of any goods, or chattels, either by just occupancy or by a legal transfer, whoever by fraud or force dispossesses me of them is guilty of a transgression against the law of society, which is a kind of secondary law of nature.¹⁵¹

Beyond describing the general outlines of fraud and deceit, Blackstone also discusses in some detail specific examples of deception and fraud, and explains that such dishonesty lies at the heart of different species of commercial injuries. For example, he writes, "If anyone cheats me with false cards or dice, or by false weights and measures, or by *selling me one commodity for another*, an action on the case also lies against him for damages, upon the contracts which the law always implies, that every transaction is fair and honest."¹⁵² Regarding deceit in particular, which, as has been noted, is an underlying issue in trademark infringement, he comments, "In contracts likewise for sales, it is constantly understood that the seller undertakes that the commodity he sells is his own; and if it proves otherwise, an action on the case lies against him, to exact damages for

prevent fraud, its law must be carefully tailored to achieve this purpose without unduly limiting speech." NOWAK & ROTUNDA, *supra* note 2, § 16.28 at 754. See *id.* (citing and discussing *Village of Schaumburg v. Citizens for a Better Environment*, 444 U.S. 620, 100 S. Ct. 826, 63 L.Ed.2d 73 (1980)).

¹⁴⁹ See, e.g., *Bishop v. Equinox Int'l Corp.*, 154 F.3d 1220, 1223 (10th Cir. 1998) ("The infringer's use of the markholder's property to make a profit results in unjust enrichment that may properly be remedied through an award of profits . . ."); *Bishop v. Equinox Int'l Corp.*, Nos. 97-5161, 96-5167, 1998 WL 650080, at *3 (10th Cir. 1998) ("A number of courts recognize that a trademark is a protected property right . . . The infringer's use of the markholder's property to make a profit results in unjust enrichment that may properly be remedied through an award of profits, 'even if the defendant and plaintiff are not in direct competition.' *Maltina Corp.*, 613 F.2d at 585. . . . This theory of unjust enrichment has long been the rule in this Circuit.")

¹⁵⁰ See *infra* Section III.A.3 for more on the reputational interests protected by trademarks.

¹⁵¹ BLACKSTONE, *supra* note 117, at 281.

¹⁵² *Id.* at 291 (emphasis added).

this deceit.”¹⁵³ And in a remark which captures the essence of a trademark infringer’s wrongdoing, Blackstone writes, “[T]here is also a particular remedy, entitled an action of *deceit*, to give damages in some particular cases of fraud; and *principally where one man does any thing in the name of another*.”¹⁵⁴

As is true with the principle that, legally, trademarks are a form of property, whether a mark may disparage persons, institutions, or beliefs has no bearing whatsoever on its potential to perpetrate fraud or to deceive consumers in a manner likely to cause consumer confusion.¹⁵⁵ And in his concurring opinion, Justice Kennedy made this point quite clear, remarking: “This case does not present the question of how other provisions of the Lanham Act should be analyzed under the First Amendment. It is well settled, for instance, that to the extent a trademark is confusing or misleading the law can protect consumers and trademark owners.”¹⁵⁶

3. *Trademarks and Reputation.* It is common, although by no means a categorical truth, for an infringer’s goods or services to be inferior to the goods or services of the owner of a mark.¹⁵⁷ Thus, a trademark owner’s reputation (i.e., the perceptions that others have with regard to an individual or corporation) often suffers when consumers mistakenly purchase the inferior quality goods of someone who has usurped the owner’s mark. It will be useful, therefore, briefly

¹⁵³ *Id.* See also *id.* at 416 (“Cheating is another offense, more immediately against the public trade; as that cannot be carried on without punctilious regard to common honesty and faith between man and man. Hither therefore may be referred that prodigious multitude of statutes, which are made to restrain and punish deceits in particular trades, and which . . . are chiefly of use among trades themselves. **** Lastly, any deceitful practice, in cozening another by artful means, whether in matters of trade or otherwise, as by playing with false dice, or the like, is punishable with fine, imprisonment, and pillory. And, by the statutes 33 Hen. VIII. C. 1. and 30 Geo. II. C. 24. If any man defrauds another of any valuable chattels by colour of any false token, counterfeit letter, or false pretense, or pawns or disposes of another’s goods without the consent of the owner, shall suffer such punishment by imprisonment, fine, pillory, transportation, whipping, or other corporal pain, as the court shall direct.”).

¹⁵⁴ *Id.* at 291 (emphasis added).

¹⁵⁵ See VerSteege, *supra* note 3, at 751 (“A mark that ‘may disparage,’ however, is not necessarily either false or misleading.”).

¹⁵⁶ *Tam*, 137 S. Ct. at 1768.

¹⁵⁷ See, e.g., *Adidas-America, Inc. v. Payless Shoesource*, 546 F. Supp. 2d 1029, 1065 (D. Or. 2008) (“[A]didas has submitted evidence that Payless’ stripe designs negatively impact consumer perceptions of the [A]didas brand as a source of quality footwear.”); see also SCHECHTER, *supra* note 15, at 54–56 (describing a case from 1440 where a baker from outside of London sold bread which bore the mark identical to that of a London baker. According to the description, one of the principal problems that the London baker complained of was that the outsider’s bread was of inferior quality.); *id.* at 55 (“Hobold was afraid of being called to account if Halle’s bread was found unsatisfactory. . . .”); Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CALIF. L. REV. 1581, 1644 (2006) (“[T]he likelihood of bridging the gap factor, and the comparative quality of the parties’ goods factor [considered only by the Second and D.C. Circuits], are remarkable for the degree to which courts either ignore them or bend them to conform to the outcome of the test.”).

to examine the notion of reputation and its relationship to trademarks—especially potentially disparaging trademarks—in greater detail.

One of the most important aspects of trademarks is that they represent a seller's reputation.¹⁵⁸ Trademarks are the means by which the public recognizes goods and services originating from any given seller (i.e., the source of the product or service).¹⁵⁹ Thus consumers, in part, rely on their impressions of a seller's reputation when they make decisions about whether to purchase goods and services. No doubt, multiple factors are involved in consumer choices regarding reputation. A seller's trademark has the power to convey to potential consumers information about diverse aspects of a seller's reputation regarding matters such as quality, integrity, value, and even social conscience (e.g., whether the seller has a reputation for being environmentally friendly, treating its employees fairly with wages, benefits, and healthy and safe workplaces, and the like). Arguably, a seller who selects a trademark that an appreciable number of consumers regard as distasteful or offensive is likely to lose those consumers and those who sympathize with their point of view. Hence, sellers who contemplate adopting disparaging or offensive trademarks must undergo a cost-benefit analysis to determine the probability of the negative impact that their adoption of such a mark will create a reputation so negative that it will decrease sales.¹⁶⁰

Indeed, reputation, or as those in the trademark business say "goodwill," is one of the most important aspects of the value of trademarks to sellers.¹⁶¹

¹⁵⁸ *Tam*, 137 S. Ct. at 1752 (quoting *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 531 (1987) ("[T]rademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation."); *id.* (quoting *Park 'N Fly Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) ("The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business . . ."). *See also* *Yale Elect. Corp. v. Robertson*, 26 F.2d 972, 974 (2d Cir. 1928) ("[A merchant's] mark is his authentic seal; by it he vouches for the goods which bear it; it carries his name for good or ill. If another uses it, he borrows the owner's reputation, whose quality no longer lies within his own control.").

¹⁵⁹ *Tam*, 137 S. Ct. at 1751 (2017) (noting that a trademark "helps consumers identify goods and services that they wish to purchase, as well as those they want to avoid").

¹⁶⁰ *See* VerSteeg, *supra* note 3, at 770–71 ("[I]f 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 the First Amendment, will provoke change." (footnote omitted)); *see also* HALL, *supra* note 110, at 148 ("For Weber, social action was the prime datum of sociology and he drew a hard line between the professional or doctrinal study of law and the sociology of law; the legal sociologist studies social action 'oriented to law.'") (referring to the scholarship of Max Weber).

¹⁶¹ *See* *Tam*, 137 S. Ct. at 1752 (2017) (quoting *Park 'N Fly Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198, (1985) ("The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business . . ."); *see also* *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412 (1916) ("The redress that is accorded in trademark cases is based upon the party's right to be protected in the goodwill of a trade or business. The primary and proper function of a trademark is to identify the origin or ownership of the article to which it is affixed."); Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 549 (2006) ("It is customary to refer to trademark law as protecting a seller's goodwill in

Blackstone emphasizes the importance of laws that protect reputation. According to Blackstone, “The right of personal security consists in a person’s legal and uninterrupted enjoyment of his life, his limbs, his body, his health, and his reputation.”¹⁶² And he adds, “The security of his reputation or good name from the arts of detraction and slander, are also rights to which every man is entitled, by reason and natural justice; since without these it is impossible to have the perfect enjoyment of any other advantages or right.”¹⁶³

As this observation of his suggests, Blackstone notes that reputation is an important issue as it relates to the debate concerning allegedly disparaging or offensive marks. It is important from the perspective of both the seller (i.e., the trademark applicant) as well as the persons who perceive offense with a disparaging trademark. On the one hand, a seller who adopts a potentially disparaging mark risks damaging its own reputation. On the other hand, persons who feel slighted by a seller’s adoption of such a mark generally believe that their reputation has been damaged by the use of a symbol that they consider disparaging.¹⁶⁴ Hence, this issue requires that we analyze both the interests at stake for sellers’ reputations and also those persons who feel slighted when the law permits sellers to adopt disparaging marks.

First, as has been noted, to the extent that a trademark owner’s own reputation suffers as a result of his adoption and use of a mark that some consider offensive, he has chosen that mark at his peril. Presumably, he has taken a calculated risk that the loss of potential consumers, who react negatively to the offensive nature of the mark, will be minimal, or at least outweighed by others who do not perceive the same offense or do not otherwise sympathize with those who do take offense. The willingness of some sellers to adopt marks that others may consider disparaging or otherwise offensive may be interpreted as an indication that an appreciable segment of sellers in the modern marketplace is willing to risk losing some customers in order to gain others—others, who either don’t care or who might actually be attracted to the risqué or controversial nature of such a mark.¹⁶⁵ Alternatively, if a mark owner is unaware of the potentially

its mark. This familiar and well-accepted proposition has been part of the law since the latter half of the nineteenth century. There is, however, a serious problem with this proposition. Characterizing trademark law in terms of goodwill protection ultimately conflicts with the well-recognized consumer-oriented goals of trademark law.”); Rogers, *supra* note 114, at 176 (“Trade-marks symbolize reputation, good or bad, and the trade-mark is valuable in exact proportion to the goodness or badness of the reputation which it symbolizes. In this way, as Mr. Jefferson said, trade-marks contribute to fidelity. Thus, I suggest that the encouragement of signs of identity, whatever form they may take, stimulates competition by making possible free choice between competing merchants.” (footnote omitted)).

¹⁶² BLACKSTONE, *supra* note 117, at 9.

¹⁶³ *Id.* at 11.

¹⁶⁴ See e.g., VerSteeg, *supra* note 3, at 700–01 (briefly summarizing scholarship that reflects the opinions of those, such as Native Americans, who have suffered from disparaging trademarks).

¹⁶⁵ See HALL, *supra* note 110, at 159 (“Action by very large numbers of lay persons has considerable effect on official action. The extreme cases in our experience of widespread violation

offensive nature of the mark when he adopts it (e.g., either because of ignorance or insensitivity), he nevertheless always has the option to change the mark to something non-disparaging (and perhaps to publicly apologize as well). For example, even before the NCAA took an official position regarding Native American mascots, some colleges and universities dropped their Indian mascots voluntarily.¹⁶⁶ And the NBA franchise that is today known as the Washington Wizards changed its name from “Bullets” to “Wizards” in response to the pejorative connotations associated with gun violence in and around the nation’s

of the liquor prohibition law, the default of farmers in the depression and their massive resistance to enforcement of mortgage and other debts, and more recent cases of civil disobedience reveal the importance of the relation of violation to the official action that is needed to transform the law in the books into social reality.”; *id.* at 147 (“[L]lewellyn regarded laymen’s behavior as a ‘part of law’ and he also included ‘in the field of law’ not only the behavior of officials, their practices, and their contacts with laymen but, also, ‘sets of accepted formulae which judges recite, seek light from, try to follow, . . . various persons’ ideas of what the law is; and especially their views of what it or some part of it ought to accomplish . . . Farther from the center lies legal and social philosophy . . . Part of law, in many aspects, is all of society, and all of man in society.’” (quoting LLEWELLYN, *supra* note 110, at 40–41)); *see also* William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 269 (1987) (“In short, a trademark conveys information that allows the consumer to say to himself, ‘I need not investigate the attributes of the brand I am about to purchase because the trademark is a shorthand way of telling me that the attributes are the same as that of the brand I enjoyed earlier’”); *id.* at 270 (“The value of a trademark is the saving in search costs made possible by the information or reputation that the trademark conveys or embodies about the brand (or the firm that produces the brand). Creating such a reputation requires expenditures on product quality, service, advertising, and so on. Once the reputation is created, the firm will obtain greater profits because repeat purchases and word-of-mouth references will generate higher sales and because consumers will be willing to pay higher prices for lower search costs and greater assurance of consistent quality.”); Jeremy N. Sheff, *Biasing Brands*, 32 CARDOZO L. REV. 1245, 1252 (2011) (“It is unlikely that any modern consumer can, on reflection, honestly characterize their myriad and varied purchasing decisions as a series of calculations to determine likelihood of preference-satisfaction based on a synthesis of product information conveyed by a trademark with product information obtained independently. Many, if not most, consumer transactions—from purchasing a pack of gum at a drugstore checkout, to ordering a beer at a bar, to pre-ordering the latest tech gadget online—are considerably less systematic and analytical than the search-costs model can account for.”); *id.* at 1252 (“The marketing literature has developed tools for analyzing consumer decision-making, and particularly for analyzing the effect of trademarks (and of the related construct, brands) on that decision-making.”); *id.* at 1252–53 (“Trademarks have multiple effects on consumers, each of which has different normative implications. First, and consistent with the search-costs model, trademarks inform consumers: They provide consumers with objective information about the products and services to which they are affixed. Second, trademarks persuade consumers: Marketing efforts can generate or change consumer preferences to align with whatever qualities—including subjective qualities—are perceived to be offered by a marked product. The persuasive function of trademarks and advertising has long been a subject of intense debate in the economic and legal academic literatures.”).

¹⁶⁶ *See* VerSteeg, *supra* note 3, at 694–96 (discussing the NCAA regulations and policy relating to Native American mascots, names, and imagery considered “hostile and abusive”).

capital.¹⁶⁷ To be sure, there are economic and social risks involved with choosing a trademark that is potentially disparaging or otherwise offensive.

But the disparagement perceived by groups of people, such as persons of Asian ancestry, who feel disparaged by a band that calls itself “The Slants,” or Native Americans, who feel disparaged by a professional football team called “The Redskins,” is mostly irrelevant to the issue of reputation as it relates to trademarks. Admittedly, Blackstone expressly states that, “injuries affecting a man’s *reputation* or good name, are, first, by malicious, scandalous, and slanderous *words*, tending to his damage and derogation.”¹⁶⁸ Hence, at first blush, Blackstone appears to support the notion that a government may be within its rights to deny registration for marks that may disparage persons, institutions, or beliefs. He further notes that, “[a] second way of affecting a man’s reputation is by printed or written labels, pictures, signs, and the like; which set him in an odious or ridiculous light, and thereby diminish his reputation.”¹⁶⁹ Nevertheless, Blackstone also knew the importance of drawing a firm line between defamatory words or visual images versus what he refers to as “mere scurrility, or opprobrious words”: “But mere scurrility, or opprobrious words, which neither in themselves import, nor are in fact attended with any injurious effects, will not support an action.”¹⁷⁰ Apparently then, “coarseness or indecency of language” appear to have been outside the scope of conduct deemed actionable in Blackstone’s England.

Thus, insofar as a mark that “may disparage” can negatively affect the reputation of either its owner or those who perceive disparagement, logic and history again suggest that the potentially disparaging nature of a mark has little, if any, appreciable relevance to its ability to function as an indicator of source.

4. *Trademarks and Religious Sensitivity.* Several of Blackstone’s discussions that are especially relevant to the disparagement clause deal with British laws that punished speech that offended religion and religious institutions. Before *Tam*, a number of mainstream cases involving trademarks rejected by the PTO under the § 2(a) disparagement clause involved applications for marks that the examining attorney considered disparaging because of their relationship to

¹⁶⁷ See *Harlem Wizards Entertainment v. NBA Properties, Inc.* 952 F. Supp. 1084 (1997).

¹⁶⁸ BLACKSTONE, *supra* note 117, at 272.

¹⁶⁹ *Id.* at 273; see also *id.* (“[A]s to signs or pictures, it seems necessary always to shew, by proper *innuendo*’s and averments of the defendant’s meaning, the import and application of the scandal, and that some special damage has followed. . . .”); *id.* at 413 (“Of a nature very similar to challenges are *libels*, *libelli famosi*, which, taken in their largest and most extensive sense, signify any writings, pictures, or the like, of an immoral or illegal tendency; but in the sense under which we are now to consider them, are malicious defamations of any person, and especially a magistrate, made public by either printing, writing, signs or pictures, in order to provoke him to wrath, or expose him to public hatred, contempt, and ridicule.”).

¹⁷⁰ BLACKSTONE, *supra* note 117, at 273. Scurrility has been defined as: “The quality of being scurrilous; buffoon-like jocularly; coarseness or indecency of language, esp. in invective and jesting.” *Scurrility*, OXFORD UNIVERSAL DICTIONARY (3rd ed. 1955).

religion. For example, in *In re Hines*, the TTAB upheld the PTO examining attorney's refusal to register the mark "Budda Beachwear," "on the basis that the mark was disparaging to the religion of Buddhism."¹⁷¹ Similarly, the TTAB affirmed the examiner's refusal of "Khoran" for wine in *In re Lebanese Arak Corp.*¹⁷² Because the mark, "Khoran," is the phonetic equivalent of "Koran," the name of Islam's holy book, and because the followers of "the Muslim Islamic faith believe that consuming alcohol is sinful,"¹⁷³ the mark "Khoran" used in conjunction with wine was deemed disparaging to Muslims and the Muslim faith.¹⁷⁴ Additionally, the case *In re Heeb Media* affirmed the PTO's refusal to register the mark "Heeb" for apparel, "because, as slang for 'Hebrew,' it is a term considered offensive to Jews."¹⁷⁵ Blackstone recounts several statutes in his day that likewise targeted speech that disparaged religion. For example,

[B]y the statute 1 Edw. VI. c. 1. And 1 Eliz. C. 1. that whoever reviles the sacrament of the Lord's Supper shall be punished by fine and imprisonment; and by the statute 1 Eliz. C. 2 if any minister shall speak anything in derogation of the book of common prayer, he shall, if not benefited, be imprisoned one year for the first offense, and for life for the second. . . .¹⁷⁶

He mentions another: "[I]t is enacted by statute 3 Jac. I. c. 21. that if in any stage play, interlude, or shew, the name of the holy trinity, or any of the persons therein, be jestingly or profanely used, the offender shall forfeit 10*l.* one moiety to the king, and the other to the informer."¹⁷⁷ In addition, without mentioning any particular statute, he says,

And if *any person* whatsoever shall, in plays, songs, or other open words, speak anything in derogation, depraving, or despising of the said book, or shall forcibly prevent the reading of it, or cause any other service to be used in it's stead, he shall forfeit for the first offense an hundred marks; for the second, four hundred; and for the third shall forfeit all his goods and chattels, and suffer imprisonment for life.¹⁷⁸

¹⁷¹ VerSteeg, *supra* note 3, at 687 (citing 31 U.S.P.Q.2d (BNA) 1685, 1686 (T.T.A.B. 1994)).

¹⁷² *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215 (T.T.A.B. 2010).

¹⁷³ VerSteeg, *supra* note 3, at 696.

¹⁷⁴ *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d at 1221.

¹⁷⁵ VerSteeg, *supra* note 3, at 697; *In re Heeb Media, LLC*, 89 U.S.P.Q.2d at 1071–72.

¹⁷⁶ BLACKSTONE, *supra* note 117, at 369.

¹⁷⁷ *Id.* at 374.

¹⁷⁸ *Id.* at 369–70.

Furthermore, Blackstone writes that, under the common law, persons guilty of blasphemy are subject to a fine, incarceration, and bodily harm.¹⁷⁹

Arguably the cases cited above, where marks were rejected because of negative religious connotations, may well represent instances of PTO trademark examining attorneys putting their thumbs on the scales in a manner that conflicts with the Establishment Clause of the First Amendment. To be sure, certain members of religious groups benefitted as a result of the refusals of registration in *Hines*, *Heeb Media*, and *Lebanese Arak*. On the surface, these cases appear to conflict with the both the Establishment Clause and the Free Exercise Clause, since, “[b]oth clauses prevent the government from singling out specific religious sects for special benefits or burdens.”¹⁸⁰ Generally speaking, our First Amendment jurisprudence holds that, “[t]he use of religious beliefs as any type of standard for the granting of government benefits . . . might violate both the establishment and free exercise clauses by violating a religious neutrality principle that is central to both.”¹⁸¹ Yet the incidental benefits conferred by the PTO’s refusal to register *Buddha Beachware*, *Heeb*, and *Koran* may be sufficiently attenuated to escape conflict with either the Establishment or Free Exercise Clause.¹⁸²

Blackstone notes that British law punished such speech expressly because “Christianity is part of the laws of England.”¹⁸³ When one considers the serious effort on the part of the Framers of the United States Constitution to ensure a firm separation of church and state via the First Amendment,¹⁸⁴ It seems wholly improper that trademark examiners have applied § 2(a)’s disparagement clause to disfavor marks that are potentially offensive to religious groups, since the Framers worked meticulously to ensure a firm separation of church and state through the First Amendment.

¹⁷⁹ *Id.* at 374 (“[B]lasphe^my against the Almighty, by denying his being or providence; or by contumelious reproaches of our savior Christ. Whither also may be referred all profane scoffing at the holy scripture, or exposing it to contempt and ridicule. These are offenses punishable at common law by fine and imprisonment, or other infamous corporal punishment, for christianity is part of the laws of England.” (emphasis original)).

¹⁸⁰ NOWAK & ROTUNDA, *supra* note 2, § 17.1, at 790. See also *id.* § 17.6, at 830 (“The government may not . . . give benefits to people solely because of their religious beliefs.”).

¹⁸¹ *Id.* § 17.6, at 831.

¹⁸² *Id.* § 17.1, at 790 (“Unfortunately, situations arise where the government may have no choice but to incidentally help or hinder religious groups or practices.”); *id.* § 17.1, at 792 (“When examining a law that provides incidental aid to religion, the Supreme Court will question whether . . . the law creates an impermissible entanglement between government and religion.”); *id.* § 17.3, at 794 (explaining the Supreme Court’s test for evaluating potential establishment clause violations).

¹⁸³ BLACKSTONE, *supra* note 117, at 374. See *id.* at 411 (“[M]ere quarrelsome words, which are neither an affray nor an offense in any other place, are penal here [i.e., “in a church or churchyard”].”).

¹⁸⁴ See generally NOWAK & ROTUNDA, *supra* note 2, at 790–857.

B. CORE FREE SPEECH PRINCIPLES

Although the cases mentioned above—cases involving rejection of marks that may have been disparaging because of religious connotations—may illustrate a First Amendment problem vis-a-vis the Establishment Clause of the First Amendment, the *Tam* Court's decision struck down the disparagement clause of § 2(a) due to its conflict with the Freedom of Speech Clause.¹⁸⁵ The First Amendment, in part, reads: "Congress shall make no law . . . abridging the freedom of speech, or of the press."¹⁸⁶ Interestingly, the First Amendment, historically, has found ardent supporters among both liberals and conservatives. For example, Justice Brennan wrote, "the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable."¹⁸⁷ Similarly, Justice Scalia opined that the First Amendment forbids the government to regulate speech "based on hostility—or favoritism—towards the underlying message expressed."¹⁸⁸ Strict adherence to First Amendment principles frequently touches sensitive nerves and has the capacity to cause extreme emotional conflict.¹⁸⁹ But this discomfort is part of the price Americans pay for freedom. Frankly, a restriction that prohibits the registration of trademarks that "may disparage" is unlikely to pose a danger remotely as serious as a restriction that prohibits the content or viewpoint expressed in speech of a purely political nature. This admission, in part, is reflected in the Supreme Court's creation of special First Amendment rules of analysis pertaining to commercial speech.¹⁹⁰ Nevertheless, the foundational principles that animate Freedom of Speech doctrine serve as compelling reminders of why § 2(a)'s disparagement clause conflicts with the First Amendment.

Senator Ervin explains the goal of the First Amendment, as "the Founding Fathers rightly believed that truth alone makes men free. They desired, most of

¹⁸⁵ *Tam*, 137 S. Ct. at 1744.

¹⁸⁶ U.S. CONST. amend. 1. See also ERVIN, PRESERVING THE CONSTITUTION 212 ("The Founding Fathers embodied these guarantees in the [First] Amendment for two reasons, one philosophical and the other pragmatic. As philosophers, the Founding Fathers believed that free and full flow of information and ideas teaches men the truth which frees them from the worst sort of tyranny, i.e. tyranny over the mind; and as pragmatists, they believed that [the] free and full flow of information and ideas is vital to the civil and political institutions they established. The Founding Fathers were right on both counts."); NOWAK & ROTUNDA, *supra* note 2, § 16.1, at 615 ("Although the freedom of belief, or freedom of thought, is not explicitly mentioned in the First Amendment, it is the core value of all of the clauses [in] the First Amendment. . . . Justice Jackson explained that . . . freedom of belief was inviolate.").

¹⁸⁷ *Texas v. Johnson*, 491 U.S. 397, 414 (1989).

¹⁸⁸ *R.A.V. v. City of St. Paul*, 505 U.S. 377, 386 (1992).

¹⁸⁹ See, e.g., *Collin v. Smith*, 578 F.2d 1197 (7th Cir.) (Nazi parade); *Snyder v. Phelps*, 562 U.S. 443 (2011) (protest held at a military funeral).

¹⁹⁰ See generally *Central Hudson*, 477 U.S. 557 (1980) (The Supreme Court created the Central Hudson test).

all, that the people for whom they were creating a government should be politically, intellectually, and spiritually free.¹⁹¹

According to Ervin, the Founding Fathers,

could not guarantee that Americans would actually know the truth. But they could guarantee that Americans would have the right to know the truth, and make that right effective by conferring upon the people and denying to the government the power to determine what truth is. And that is precisely what they did by the First Amendment.¹⁹²

Given that trademark law itself was in its infancy at the time of the drafting and ratification of the First Amendment, some might question whether it is even proper for us today to apply its principles to trademarks and the federal registration process. Yet the evolution of First Amendment jurisprudence has demonstrated the judiciary's willingness to apply the First Amendment to the ever-expanding, ever-developing means of "speech," otherwise known as "communication." Senator Ervin addresses this very issue.

When they first drafted and ratified the First Amendment, the Founding Fathers decreed that the freedoms it secures should extend into the future and apply to all activities falling within their scope, even though such activities were never envisaged by them. As a consequence, the First Amendment freedoms embodied in the phrase "freedom of speech or of the press" confer upon those who broadcast information or ideas by radio or television the constitutional right to do so, subject, however, to certain limitations. . . .¹⁹³

Thus, the freedom of speech protected by the First Amendment presumably extends therefore to trademark registration, although trademark registration was not yet implemented as a government activity when the Founding Fathers wrote and ratified the First Amendment.

As a government agency, the PTO distributes the keys that allow trademark owners to unlock and enjoy a number of substantive legal advantages granted by federal registration.¹⁹⁴ In an analogous fashion, as a government agency, the

¹⁹¹ ERVIN, *supra* note 186, at 209. *See also id.* ("[I]t [i.e., the First Amendment] forbids any governmental abridgement of its freedoms, which are aptly designed to make effective the right of the people to know the truth, and to govern themselves accordingly.").

¹⁹² *Id.* at 209.

¹⁹³ *Id.* at 211.

¹⁹⁴ *Tam*, 137 S. Ct. at 1753 ("Federal registration . . . confers important legal rights and benefits on trademark owners who register their marks." (citations omitted)).

Federal Communications Commission (FCC) also distributes the keys that allow broadcasters to operate and enjoy the legal advantages provided by issuing broadcast licenses. Consider how these remarks of Senator Ervin's regarding the FCC's restrictions on radio and television broadcasters might apply, by analogy, to the PTO's application of the disparagement clause, restricting trademark registrations.

Governmental regulation of radio and television broadcasters must be narrowly restricted. Otherwise, it will violate the First Amendment, which undoubtedly forbids government to deny to a broadcaster freedom to broadcast the news or programs it chooses or the views it entertains. I submit, moreover, that the FCC flouts the First Amendment if it revokes or refuses to renew a license to broadcast merely because it dislikes the political views the broadcaster expresses. . . .¹⁹⁵

And Ervin emphasizes this very point, stating again:

During recent times, persons exercising powers of government have done many things incompatible with the First Amendment. Among them were these things. . . . The refusal of the Federal Communications Commission to renew licenses of religiously affiliated radio stations because their broadcasts were displeasing to adherents of other creeds and segments of the public. . . .¹⁹⁶

The disparagement clause of § 2(a) was a paternalistic law, which allowed the Government to deny trademark registrations that the PTO examining attorneys believed would harm the feelings of some people. Senator Ervin views this goal as inconsistent with First Amendment principles: "It is not the function of government in a free society to protect its citizens against thoughts or associations it deems dangerous, or to stigmatize its citizens for thoughts or associations it thinks hazardous."¹⁹⁷

Americans cherish freedom as one of their most important values. As is true in many legal disputes, the sustainability of the disparagement clause pitted the competing interests of two groups of people against one another. Those competing interests illustrate the conflict inherent between them; and, that inherent conflict centered on the interest that both groups have in what each

¹⁹⁵ ERVIN, *supra* note 186, at 212.

¹⁹⁶ *Id.* at 214–15. In Part IV, the similarity between the FCC and the PTO as government agencies will help inform suggestions for revision to the Lanham Act's definition of the words "immoral" and "scandalous." Senator Ervin's observations about the relationship between the FCC and the First Amendment are especially relevant.

¹⁹⁷ ERVIN, *supra* note 186, at 216.

perceived to be its rights to a certain kind of freedom.¹⁹⁸ One group, sellers of goods and services, desires the freedom to select and secure rights to trademarks that they consider beneficial for their businesses.¹⁹⁹ They generally seek to maximize profits by selecting marks that they hope will appeal to their customers. That appeal may be attributable to a variety of factors, one of which may be the controversial (some might say “edgy” or “spicy”) nature of the message conveyed by a mark. As has been noted, sellers who choose controversial marks risk alienating some segments of their potential consumer base.²⁰⁰ But the *Tam* decision allows that the freedom to undertake that risk is guaranteed by the First Amendment. On the other hand, the second group, people who feel disparaged by such marks, presumably want the freedom not to be subjected to the emotional/psychological pain that the presence of such marks in the public marketplace causes to them. As between the interests of these two groups—sellers who want freedom to select controversial trademarks versus members of the public who seek freedom from emotional injury—the Supreme Court’s *Tam* decision teaches that the First Amendment tips the scales in favor of the sellers to select and protect controversial marks.²⁰¹

The emotionally-charged desires of those offended by trademarks that “may disparage” them must take a backseat to the higher-order goals of the First Amendment.²⁰² Senator Ervin would have applauded the *Tam* decision for its recognition that, as a rule, the First Amendment guarantee of freedom of expression must supersede the interests of individuals and groups of individuals, who merely wish to avoid bruised feelings. According to Ervin:

Like all freedom, freedom of speech and of the press are always in
peril; and the price of their keeping is eternal vigilance, and an

¹⁹⁸ See *id.* (“The foes of freedom never tire. Consequently, freedom is always in jeopardy. The price of its keeping is eternal vigilance, and an unceasing readiness to guard and defend it.”).

¹⁹⁹ See, e.g., HALL, *supra* note 110, at 6 (“For still other legal philosophers, the most important question to ask about law is its functional competence, its ability to do the jobs that are vitally important, e.g., to maintain order, allocate values fairly, and promote social welfare.”); *id.* at 42 (“Freedom, for Kant, is the basic value from which all other values flow and on which they depend; conformity to external duties is the *sine qua non* of ‘the kingdom of ends,’ where each individual has the maximum freedom compatible with the like for all other persons.” (quoting and citing IMMANUEL KANT, *THE PHILOSOPHY OF LAW* 45 (William Hastie ed., 1887)).

²⁰⁰ See *supra* Part III.A.3.

²⁰¹ See *Snyder v. Phelps*, 562 U.S. 443, 454, 455 (2011) (Judgment in favor of a father for intentional infliction of emotion distress against Westboro Baptist fundamentalist church for protesting near the funeral of his son who had died in military service was reversed by the U.S. Supreme Court on constitutional First Amendment grounds. The speech of the church members who picketed near the funeral was held to be of public concern and therefore was entitled to protection under the First Amendment.).

²⁰² See HALL, *supra* note 110, at 46 (“[T]he themes that rules of law (and congruent actions) having ethical significance, are intelligible and must be distinguished from desires and emotions, that (sound) rules of law and actions are intrinsically valuable and, also, useful, and that their validity can be objectively tested. . . .”).

unceasing readiness to guard and defend them. Strange as it may seem, freedom has many foes, even among those who profess to love it. Some men are annoyed by the abuse of freedom by others and advocate its abridgment to prevent its further abuse. Other men fear the exercise of freedom by others and demand its curtailment to quiet their fears. And government itself tends to dislike freedom in general because it obstructs the exercise of arbitrary power and freedom of speech and of the press in particular because they are the instruments which expose official mismanagement and misconduct.²⁰³

Some will, no doubt, criticize the Supreme Court's decision to invalidate the disparagement clause by arguing that it contradicts the express design of Congress, and these critics may allege that the decision dismantles the carefully balanced doctrinal structure that the PTO and courts have crafted to construe § 2(a) over the course of several decades. The bench and bar have, after all, become familiar with the application of the law in its settled form. Jurisprudential scholar, Professor Jerome Hall, reflects upon these very concerns:

[T]here is a tendency to accept and approve what is familiar or customary. But to make that the sole, sweeping basis of the origin and the present meaning of moral ideas flies in the face of common experience and the frequent use of moral language, sometimes in direct criticism of what is familiar or customary.²⁰⁴

The First Amendment provides broad latitude for both political and commercial discourse. Senator Ervin reminds us that it provides a stage for all, without regard to whether the speaker's message is wise or unwise, casts light or imposes darkness, or reflects insight or stupidity.²⁰⁵ But the consensus of the Founding Fathers was that freedom of speech is necessary for a free society. And

²⁰³ ERVIN, *supra* note 186, at 214. *See also id.* (“[T]he Founding Fathers embodied in the First Amendment the guaranties of freedom of speech and of the press to give our people security against laws and all other governmental actions that are designed to suppress the communication of information or to stifle the expression of ideas.”). *See also id.* at 210 (“First Amendment freedoms are often grossly abused; and, in consequence, society is sorely tempted at times to demand or countenance their curtailment by government to prevent their abuse. Our country must steadfastly spurn this temptation if it is to remain the land of the free. This is so because the only way to prevent the abuse of freedom is to abolish freedom.”).

²⁰⁴ HALL, *supra* note 110, at 60.

²⁰⁵ *See* ERVIN, *supra* note 186, at 210 (“The First Amendment is impartial and inclusive. It bestows its freedoms on all persons within our land, regardless of whether they are wise or foolish, learned or ignorant, profound or shallow, brave or timid, devout or ungodly, and regardless of whether they love or hate our country and its institutions.”).

as long as modern America embraces that same consensus, we must continue to accept the negative effects along with the positive. Grant Gilmore writes:

The function of law, in a society like our own, is altogether more modest and less apocalyptic. It is to provide a mechanism for the settlement of disputes in the light of broadly conceived principles on whose soundness, it must be assumed, there is a general consensus among us. If the assumption is wrong, if there is no consensus, then we are headed for war, civil strife, and revolution, and the orderly administration of justice will become an irrelevant, nostalgic whimsy until the social fabric has been stitched together again and a new consensus has emerged. But, so long as the consensus exists, the mechanism which the law provides is designed to insure that our institutions adjust to change, which is inevitable, in a continuing process which will be orderly, gradual, and, to the extent that such a thing is possible in human affairs, rational.²⁰⁶

IV. A PROPOSAL

Now that the Supreme Court has given sellers license to register marks that “may disparage,” the PTO will undoubtedly see an increase in applications to register marks that some will consider offensive. And, as has been suggested, to a certain extent market forces will play a significant role in the success or failure of products and services sold under such disparaging or offensive marks. Adolf Hitler-brand ice cream, for example, is unlikely to prove to be a national best seller any more than Nigger-brand shoe polish. Open-mindedness and a thick-skinned attitude towards this development will help Americans weather this storm.

One issue that posed a particular problem regarding the constitutionality of the disparagement clause was its overbreadth and vagueness. Both words—“may” and “disparage”—elude precise definition.²⁰⁷ Without question, precision in defining statutory (or any other legal terminology) is a primary goal. Professor Jerome Hall writes that the “salient feature” of linguistic jurisprudence “is concentration on the use of words.”²⁰⁸ According to Hall, “[O]rdinary words are used in a technical legal sense, and it requires a great deal of study, in effect a legal

²⁰⁶ GRANT, *supra* note 2, at 109–10.

²⁰⁷ See VerSteege, *supra* note 3, at 737–48 (discussing in detail the vague and overbroad character of the words “may” and “disparage”).

²⁰⁸ HALL, *supra* note 110, at 78 (“So far as any generalization may be ventured, it may be said that their [*i.e.*, examples of linguistic jurisprudence] salient feature is concentration on the use of words.” (citations omitted)).

education, to understand how those terms are used.”²⁰⁹ But when the language used is vague, as was the case with “may disparage,” he admonishes that the problem of interpretation is especially difficult because, “what seems to be a simple question turns out to be a very large array of problems that involve whole philosophies of law and an inevitable degree of subjectivity.”²¹⁰

Diversity of opinion is powerful.²¹¹ Those who solve problems often do so by embracing a fresh perspective and approaching problems in novel ways. The *Tam* opinion gives those who sell products and services an opportunity to register trademarks that some members of our society will consider disrespectful and offensive. As has been acknowledged, to some degree the marketplace will dictate whether sellers who take such risks will find success using disparaging marks. The Founding Fathers would have approved.²¹² But arguably there are some marks that are so vulgar and offensive that they would be objectionable to our society’s commonly accepted standards of decency. Presumably, our federal trademark law ought to be capable of drawing a line that will prevent registration of what the Government’s lawyers have characterized as “the most vile racial epithets”²¹³ and “scandalous words and lewd photographs.”²¹⁴

Fortunately, in addition to its now-obsolete and defunct disparagement clause, § 2(a) also prohibits registration of marks that comprise “immoral, deceptive or scandalous matter.”²¹⁵ The law regarding the word “deceptive” is fairly well established; cases have provided thorough guidance in construing “deceptiveness.”²¹⁶ But, although there is some case law construing the words

²⁰⁹ *Id.* at 82.

²¹⁰ *Id.* at 135.

²¹¹ See ERVIN, *supra* note 186, at 212 (1984) (“Freedom of speech and of the press are the things that distinguish our country most sharply from totalitarian regimes. They enable our country to enjoy a diversity of ideas and programs, and to escape the standardization of ideas and programs totalitarian tyranny requires.”).

²¹² See *e.g.*, *id.* at 210 (“The Founding Fathers believed—and I think rightly—that the best test of truth is its ability to get itself accepted when conflicting ideas compete for the minds of men. And, so, the Founding Fathers staked the existence of America as a free society upon their faith that it has nothing to fear from the exercise of First Amendment freedoms, no matter how much they may be abused, as long as it leaves truth free to combat error.”).

²¹³ En banc brief for Appellee at 22, *In re Tam*, 785 F.3d 567 (Fed. Cir. 2015) (No. 14-1203).

²¹⁴ En banc brief for Appellee at 23, *In re Tam*, 785 F.3d 567 (Fed. Cir. 2015) (No. 14-1203).

²¹⁵ 15 U.S.C. § 1052(a) (2006). See also VerSteeg, *supra* note 3, at 685–86; *id.* at 686 n.31; Greyhound Corp. v. Both Worlds, Inc., 6 U.S.P.Q.2d (BNA) 1635 (T.T.A.B. 1988) (“Such definitions include ‘shocking to the sense of . . . decency, or propriety . . . offensive. . . .’” (quoting FUNK AND WAGNALLS NEW STANDARD DICTIONARY (1945))). This Board has also determined that ‘vulgar,’ defined as lacking in taste, indelicate and morally crude, is also considered scandalous matter (citing *In re Runsdorf*, 171 U.S.P.Q. (BNA) 443 (T.T.A.B. 1971)).

²¹⁶ See *e.g.*, *In re Budge Manufacturing Co.*, 857 F.2d 773 (Fed. Cir. 1988); Bayer Aktiengesellschaft v. Stamatios Mouratidis, 2010 TTAB LEXIS 218, at *16 (T.T.A.B. May 21, 2010) (“In view of the foregoing we find that applicant’s mark ORGANIC ASPIRIN for dietary supplements for human consumption is both deceptively misdescriptive under Section 2(e)(1) and deceptive under Section 2(a).”).

“immoral” and “scandalous,” it is far from crystal clear. For example, *In re Fox* considered whether the mark “Cock Sucker” could be registered.²¹⁷ In affirming the PTO’s determination that the mark could not be registered under § 2(a)’s “scandalous” bar, the CAFC observed:

[W]hat constitutes “immoral . . . or scandalous matter” has evolved over time. The formal legal framework, however, has remained consistent: in order to refuse a mark, “the [Patent and Trademark Office (PTO)] must demonstrate that the mark is ‘shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . giving offense to the conscience or moral feelings; . . . [or] calling out [for] condemnation.’” [T]he PTO may prove scandalousness by establishing that a mark is “vulgar.”²¹⁸

And in a case currently before the CAFC, *In re Brunetti*, the TTAB stated that, “the word ‘vulgar’ captures the essence of the prohibition against registration,” and thus held that the applicant’s mark “FUCT” likewise was unregistrable under § 2(a)’s “scandalous” bar.²¹⁹

On December 15, 2017, a three-judge panel of the CAFC agreed that the mark “FUCT” “comprises immoral or scandalous matter,” but held, “that § 2(a)’s bar on registering immoral or scandalous marks is an unconstitutional restriction of free speech.”²²⁰ More specifically, the CAFC stated that the immoral or scandalous provision “impermissibly discriminates based on content in violation of the First Amendment.”²²¹ Judge Moore reasoned that, because “the immoral or scandalous prohibition targets the expressive components of [] speech,”²²² and “regulates the expressive components of speech, not the commercial

²¹⁷ 702 F.3d 633 (Fed. Cir. 2012).

²¹⁸ *In Re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012) (internal citations and quotations omitted). See generally Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*, 101 TRADEMARK REP. 1476 (2011). See, e.g., *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d 1635, 1638 (T.T.A.B. 1988) (“The cases have referred to dictionary definitions extant at the time the Lanham Act was enacted as indicating the matter encompassed by the term ‘scandalous’. Such definitions include ‘shocking to the sense of . . . decency, or propriety, . . . offensive . . .,’ *Funk and Wagnalls New Standard Dictionary*, (1945). This Board has also determined that ‘vulgar,’ defined as lacking in taste, indelicate and morally crude, is also considered scandalous matter. *In re Runsdorf*, 171 U.S.P.Q. 443 (T.T.A.B. 1971) (‘BUBBY TRAP’ for brassieres.)”).

²¹⁹ 2014 TTAB LEXIS 328, at 14-15 (T.T.A.B. 2014) (“We have seen from the dictionary definitions of record that ‘fucked’ and its phonetic twin, ‘fuct,’ are both vulgar terms. Whether one considers ‘fucked’ as a sexual term, or finds that Applicant has used ‘fucked/fuct’ in the context of extreme misogyny, nihilism or violence, we have no question but that these are still extremely offensive terms in the year 2014.”).

²²⁰ *In re Brunetti*, 877 F.3d 1330, 1336 (Fed. Cir. 2017).

²²¹ *Id.* at 1341.

²²² *Id.* at 1349.

components of speech...it should be subject to strict scrutiny."²²³ And Judge Moore went further still, holding that, "Section 2(a)'s bar on the registration of immoral or scandalous marks is unconstitutional even if treated as a regulation of purely commercial speech reviewed according to the intermediate scrutiny framework established in *Central Hudson*."²²⁴ She held that the Government failed to prove that it has a substantial government interest.²²⁵ In addition, Judge Moore's opinion held that the Government was unable to "meet the third prong of *Central Hudson*, which requires the regulation directly advance the government's asserted interest."²²⁶ And the Government has requested a rehearing en banc.

Consequently, now, in the aftermath of *Tam*, may be an especially opportune time for lawmakers to define the words "immoral" and "scandalous" in a way that balances a degree of moral decency with the First Amendment's protections for Freedom of Speech. Indeed there are some categories of speech that fall outside the scope of First Amendment protections. In his concurring opinion in *Tam*, Justice Kennedy expressly acknowledges, "Those few categories of speech that the government can regulate or punish—for instance, fraud, defamation, or incitement—are well established within our constitutional tradition."²²⁷ More specifically, those categories include: (1) Libel; (2) Incitement to Violence; (3) Obscenity; (4) Child Pornography; (5) Fighting Words; and, (6) False Advertising.²²⁸ The *Tam* opinion does not address registration of marks that are "immoral" or "scandalous matter," but only marks that "may disparage."

²²³ *Id.*

²²⁴ *Id.* at 1350 (citing *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of New York*, 447 U.S. 577 (1980)) (internal citations omitted).

²²⁵ *Id.* (stating that "*Central Hudson*'s second prong, requiring a substantial government interest, is not met."); *id.* at 1531 (stating that "the government has failed to identify a substantial interest justifying its suppression of immoral or scandalous trademarks.").

²²⁶ *Id.* at 1354–55 (stating that "the government has failed to demonstrate that its restriction will advance the interests it asserts and that it is narrowly tailored to achieve that objective.").

²²⁷ *Tam*, 137 S. Ct. at 1765.

²²⁸ See, e.g., NOWAK & ROTUNDA, *supra* note 2, § 16.1, at 666 ("The Supreme Court has allowed the punishment of speech based on content if the content is limited to the proscription of: (1) speech that incites imminent lawless action; (2) speech that is integral to the commission of a crime; (3) speech that triggers an automatic violent response (so-called "fighting words" or the related "hostile audience" problem); (4) "true threats;" (5) obscenity (which the Court narrowly defines to exclude much material that the popular press often describes as pornography; (6) child pornography (a limited category of speech involving photographs and films of young children); (7) certain types of defamatory speech; and (8) certain types of commercial speech (primarily false or misleading speech connected to the sale of a service or product, or offers to engage in illegal activity.)). See also ERVIN, *supra* note 186, at 209–10 ("In its final analysis, the First Amendment compels the government to grant to every person within the borders of our land . . . Freedom to convey to others with impunity by speech, writing, print, picture, signal, or any other medium of communication whatever, any information or ideas he wishes as long as what he says or publishes does not slander or libel others; invade the privacy of others; constitute obscenity or legal fraud; incite crime or violence; obstruct courts in the administration of justice, or legislative bodies in their proceedings; amount to sedition, or imperil the national security."); *id.* at 210 ("As appears from

Thus, one sensible approach in the post-*Tam* era, as the bench and bar move ahead into the uncharted waters of a principal register that allows registration of marks that “may disparage,” will be, at least in part, to define the words “immoral” and “scandalous matter” as including precisely those categories. For example, the definition might state,

The words “immoral” or “scandalous matter” include but are not limited to content that contains or comprises categories of speech considered to fall outside of First Amendment protection (*i.e.*, “unprotected speech”); including: 1) Libel; 2) Incitement to Violence; 3) Obscenity; 4) Child Pornography; 5) Fighting Words; and, 6) False Advertising.

Admittedly, although these categories have not been defined with laser-like precision, the Supreme Court has forged a rather comprehensive jurisprudence for most that is fairly well developed.²²⁹

But it is also possible that the definition of “immoral” and “scandalous matter” could be broader and benefit from the lessons of *FCC v. Pacifica*

this statement, First Amendment Freedoms are not absolute. According to a famous observation of Justice Oliver Wendell Holmes, no one is at liberty to shout ‘fire’ in a crowded theater. To add illustrations, the Amendment does not privilege anyone to call an honest man a thief, or a virtuous woman a whore, or to provoke another to violence by addressing foul epithets to him.”). *See also* VerSteege, *supra* note 3, at 735–37 (discussing these categories and comparing the complaints of Native Americans regarding sports mascots to the plight of the plaintiffs in cases such as *Virginia v. Black* (538 U.S. 343 (2003)), where defendants burned a cross on their property in an effort to intimidate them); BLACKSTONE, *supra* note 117, at 413 (“The direct tendency of these libels is the breach of the public peace, by stirring up the objects of them to revenge, and perhaps bloodshed.”).

²²⁹ For discussions of a number of these categories of unprotected speech, *see e.g.*, NOWAK & ROTUNDA, *supra* note 2, § 16.5, at 665–70 (advocacy of criminal activity); *id.* § 16.5, at 699 (“[O]nly when speech causes unthinking, immediate reaction is the protection of the First Amendment withdrawn.”); *id.* § 16.5, at 702 (reciting the *Brandenburg* test used “to judge laws that restrict speech that advocates unlawful conduct”); *id.* § 16.18, at 711–18 (“Fighting Words and Hostile Audiences.”); *id.* § 16.18(a), at 769 (discussing *Chaplinsky v. New Hampshire*, 315 U.S. 568, 62 (1942) as having defined “fighting words” as “face-to-face words plainly likely to cause a breach of the peace by the addressee,” and stating “*Chaplinsky’s* basic test was whether or not people of common intelligence would understand the words as likely to cause the average addressee to fight.”); *id.* § 16.18(a), at 772 (quoting Justice Harlan in *Cohen v. California*, 403 U.S. 15 (1971) for the proposition that “one man’s vulgarity is another’s lyric”); *id.* § 16.18(c), at 773 (discussing important cases on threats and intimidation, such as *R.A.V. v. City of St. Paul* 505 U.S. 377, 112 (1992) and *Virginia v. Black*, 538 U.S. 343 (2003), and summarizing the doctrine by quoting *Virginia v. Black*: “Intimidation on the constitutionally proscribable sense of the word is a type of true threat. Where the speaker directs a threat to a person or a group of persons with the intent of placing the victim in fear of bodily harm or death.”); *id.* §§ 16.34–16.37, at 835–55 (obscenity); *id.* § 16.36, at 838 (definition of “obscenity” from *Miller v. California*, 413 U.S. 15 (1973); *id.* § 16.37(c), at 778–80 (child pornography)).

Foundation.²³⁰ In *Pacifica*, “[t]he Court held that the FCC does have the statutory authority and constitutional power to regulate a radio broadcast that is ‘indecent’ but not ‘obscene’ in the constitutional sense, at least under circumstances where the indecent broadcast would be available to a high percentage of children.”²³¹ Curiously, in *Brunetti*, the CAFC considered the potential impact of *Pacifica* but rejected its reasoning, stating, “The government’s interest in protecting the public from profane and scandalous marks is not akin to the government’s interest in protecting children and other unsuspecting listeners from a barrage of swear words over the radio in *Pacifica*. A trademark is not foisted upon listeners by virtue of its being registered. Nor does registration make a scandalous mark more accessible to children.”²³² But it might be useful to examine *Pacifica* more closely.

In *Pacifica*, according to the Supreme Court, the FCC exercised its power to regulate radio broadcasting, relying primarily on “18 U.S.C. § 1464 (1976 ed.), which forbids the use of ‘any obscene, indecent, or profane language by means of radio communications.’”²³³ And in a footnote, the Court explained that broadcasting, as a form of expression, deserved,

special treatment because of four important considerations: (1) children have access to radios and in many cases are unsupervised by parents; (2) radio receivers are in the home, a place where people’s privacy interest is entitled to extra deference; (3) unconsenting adults may tune in a station without any warning that offensive language is being or will be broadcast; and (4) there is a scarcity of spectrum space, the use of which the government must therefore license in the public interest. Of special concern to the Commission as well as parents is the first point regarding the use of radio by children.²³⁴

Clearly, the *Pacifica* majority based its holding, in significant part, on the pervasive, ubiquitous nature of radio broadcasting and its omnipresence in daily life. According to the Court, radio broadcasting is “a uniquely pervasive presence in the lives of all Americans”²³⁵ and “is uniquely accessible to children, even those too young to read. . . .”²³⁶ The Court noted in particular: “Patently offensive, indecent material presented over the airwaves confronts the citizen, not only in

²³⁰ 438 U.S. 726 (1978). The CAFC is acutely aware of *Pacifica*. In fact, the CAFC cited *Pacifica* in *In re Fox*, noting that, “the word ‘cocksucker’ is generally patently ‘indecent’ under 18 U.S.C. § 1464 [i.e., the statute relevant in that case].” 702 F.3d 633, 637 n.1 (Fed. Cir. 2012).

²³¹ NOWAK & ROTUNDA, *supra* note 2, § 16.8, at 661.

²³² *In re Brunetti*, 877 F.3d at 1353.

²³³ *Pacifica*, 438 U.S. at 726.

²³⁴ *Id.* at 731 n.2 (internal citations omitted).

²³⁵ *Id.* at 748.

²³⁶ *Id.* at 749.

public, but also in the privacy of the home, where the individual's right to be left alone plainly outweighs the First Amendment rights of an intruder."²³⁷

Registered trademarks share most of these same characteristics as radio broadcasting.²³⁸ Trademarks bombard our senses nearly every hour of the day via multiple communications platforms, including radio, television, Internet, street signage, and print media. In his concurring opinion in *Tam*, Justice Kennedy makes this very same observation:

These marks make up part of the expression of everyday life, as with the names of entertainment groups, broadcast networks, designer clothing, newspapers, automobiles, candy bars, toys, and so on. Nonprofit organizations—ranging from medical-research charities and other humanitarian causes to political advocacy groups—also have trademarks, which they use to compete in a real economic sense for funding and other resources as they seek to persuade others to join their cause.²³⁹

Thus, contrary to the CAFC's dismissal of the potential analogy of radio broadcasting to the proliferation of trademarks in our daily lives, including a ban on "indecent or profane" words, names, symbols or devices as part of the definition of the words "immoral" and "scandalous," may pass constitutional muster under *Pacifica*.²⁴⁰ This is especially true since the refusal to register such immoral or scandalous marks simply decreases the likelihood that putative applicants will select immoral or scandalous marks. And at oral argument for *In re Brunetti*, counsel for the parties and the CAFC panel devoted a considerable amount of discussion to the possibility of applying *Pacifica*. Judge Dyk, in

²³⁷ *Id.* at 748 (citation omitted).

²³⁸ Trademarks are analogous to radio broadcasting in at least the first three "important considerations" articulated by the Court in footnote 2.

²³⁹ See *Tam*, 582 U.S. ___, (2017) Opinion of Kennedy, J. slip op. at 6 (internal citations omitted). See also Ralph S. Brown, Jr., *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 YALE L.J. 1165, 1168 (1948) ("The buying public submits to a vast outpouring of words and pictures from the advertisers, in which, mingled with exhortations to buy, is a modicum of information about the goods offered.").

²⁴⁰ The *Pacifica* Court included a transcript of the George Carlin monologue "Filthy Words," as an appendix to the opinion. *Pacifica* at 751–55. Although it does not necessarily identify which words qualify as "indecent" or "profane" within the meaning of the statute, Carlin's monologue provides some guidance. For example, he suggests that there are seven words that are verboten: "The original seven words were, shit, piss, fuck, cunt, cocksucker, motherfucker, and tits." *Pacifica* at 751. By way of explanation, he explains, "Those are the ones that will curve your spine, grow hair on your hands and (laughter) maybe, even bring us, God help us, peace without honor (laughter) urn, and a bourbon. (laughter)." *Pacifica* at 751. After humorously examining those words for the lion's share of the monologue, he then later adds three more words to his list: "I found three more words that had to be put on the list of words you could never say on television, and they were fart, turd and twat, those three. (laughter)." *Pacifica* at 755.

particular, suggested that the court could narrowly construe the language of § 2(a) in a manner that would treat the terms “immoral” or “scandalous” as equivalent to *Pacifica*’s “indecent.”²⁴¹ And in his concurring opinion, he expressed the viewpoint that the court is “obligated to construe the statute to avoid these constitutional questions” and noted that, “[a] saving construction of a statute need only be ‘fairly possible,’ and ‘every reasonable construction must be resorted to.’”²⁴² Judge Dyk urged that, “One such fairly possible reading is available to us here by limiting the clause’s reach to obscene marks, which are not protected by the First Amendment.”²⁴³ Presumably, if trademarks were analyzed as commercial speech under the *Central Hudson* test, one could reasonably argue that protecting children and others from “profane” or “indecent” material would constitute an important Government interest, and that interpreting § 2(a) narrowly—using *Pacifica* as the benchmark—would constitute “narrow tailoring.”²⁴⁴

Hence, if one were to include—relying on *Pacifica*—a prohibition on “indecent or profane” words, names, symbols, or devices in the “immoral” and “scandalous matter” definition, that definition might read as follows:

The words “immoral” and “scandalous matter” include, but are not limited to content that contains or comprises categories of speech considered to fall outside of First Amendment protection (*i.e.*, “unprotected speech”); including but not limited to: 1) Libel; 2) Incitement to Violence; 3) Obscenity; 4) Child Pornography; 5) Fighting Words; 6) False Advertising; and 7) Indecent or Profane Matter. The meaning of the words “Indecent or Profane” in this definition is used in the manner articulated by the United States Supreme Court in *FCC v. Pacifica*, 438 U.S. 726, 98 S. Ct. 3026, 57 L. Ed. 2d 1073 (1978).

²⁴¹ Curiously counsel for the Government was hesitant, even when invited by the court, to argue that protection of children was a substantial government interest in upholding the “immoral” or “scandalous” language of § 2(a). Counsel for the Government did, however, argue that the words in the Carlin monologue, depicting graphic depictions of sex, genitalia, and similar material would be prohibited. Counsel for Brunetti was not willing to concede that the court is at liberty to interpret the statute narrowly.

²⁴² *In re Brunetti*, 877 F.3d. 1358 (Dyk, J., concurring) (citations omitted).

²⁴³ *Id.*

²⁴⁴ Thus, *Brunetti* may ultimately prove to be the case that forces the courts to decide whether trademarks constitute “commercial speech.” Also note that this suggested interpretation simply disagrees with three conclusions of Judge Moore’s majority opinion: (1) that trademarks alleged to be immoral or scandalous must be subject to strict scrutiny; (2) that the Government has failed to prove an important governmental interest; and, (3) that § 2(a)’s immoral or scandalous provision is not sufficiently narrowly tailored.

Whether by judicial decision, PTO regulation, or an act of Congress,²⁴⁵ defining the words “immoral” and “scandalous matter” in this manner has the potential to draw a much clearer line between permissible versus impermissible trademarks than the vague and overbroad language of “may disparage.”²⁴⁶ Such a definition of “immoral” and “scandalous matter” also should provide clearer guidance for PTO examining attorneys, provide reassurance for those who fear registration of marks that are excessively vulgar, and most importantly, it should allow the First Amendment to continue to function as an appropriate arbiter of what is acceptable for federal trademark registration in the United States.

V. CONCLUSION

Part II of this Article summarized the Supreme Court’s *Matal v. Tam* opinion. *Tam* makes it clear that the Free Speech clause of the First Amendment nullifies the disparagement clause of § 2(a) of the Lanham Act. It also clarifies that federally registered trademarks are *not* government speech. Part III explored the historical origins of several fundamental, foundational principles of trademark law and trademark law’s relationship with reputation and religion. In particular, it considered that: (1) trademarks are a form of property; (2) trademark law developed, in part, to protect consumers from fraud and deceit; (3) trademarks have the power to affect reputations; and, (4) trademarks have had a unique relationship with religious beliefs. This Part also concluded that none of these foundational principles or relationships mandate that federal law prohibit registration of marks that might disparage persons, institutions, or beliefs. Part III also explained that the principles that animate the First Amendment shed light on why the Free Speech clause renders the disparagement clause of § 2(a) of the Lanham Act unconstitutional. Part IV offered a possible solution to help prevent truly objectionable trademark registrations while maintaining the freedom of speech that is vital to our liberty as Americans. Presumably, as Americans, we can balance a number of competing interests while still maintaining a functioning system of federal trademark registration. That system should be capable of enhancing economic efficiency, allowing robust freedom of expression, and maintaining at least a modest degree of public decency.

²⁴⁵ Judge Moore indirectly invited Congress to amend the statute: “The concurrence proposes that we ‘narrow the immoral-scandalous provision’s scope to obscene marks in order to preserve its constitutionality.’ While the legislature could rewrite the statute to adopt such a standard, we cannot.” *In re Brunetti*, 877 F.3d at 1355 (internal citations omitted).

²⁴⁶ See GRANT, *supra* note 2, at 90 (“The obvious alternative to a judicial solution of such problems is a legislative solution. A legislative committee, unlike a court, can analyze a problem in depth and cut through to a rational solution.”).