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## Trademarks & The First Amendment After *Matal v. Tam*

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**TRADEMARKS & THE FIRST AMENDMENT AFTER  
MATAL V. TAM**

*Gary Myers<sup>1</sup>*

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## I. INTRODUCTION

The United States Supreme Court's unanimous ruling in *Matal v. Tam* is a landmark decision regarding the intersection between free speech and trademark law.<sup>2</sup> Addressing whether trademarks can legitimately be barred from federal trademark protection under the Lanham Act based solely on their possible disparaging content, the litigation involving an Asian-American band that sought to register the name, "The Slants," brought this important interplay into stark relief.<sup>3</sup> Writing in bold strokes, Justice Alito's opinion holds that the Lanham Act's prohibition on disparaging marks, 15 U.S.C. §1052(a), violates the Free Speech Clause of the First Amendment.<sup>4</sup> "It offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend."<sup>5</sup> Justice Kennedy's concurring opinion (which was joined by three other Justices) also broadly states: "the viewpoint discrimination rationale renders unnecessary any extended treatment of other questions raised by the parties."<sup>6</sup>

The Court's categorically worded decision will have important implications for both the First Amendment and for trademark law for years to come. The question is thus how far does the *Tam* decision reach, and whether it will upend major aspects of trademark law. This article provides an analysis of the implications of *Tam* for trademark law, both in terms of eligibility for registration and in terms of the scope of trademark protection. The article takes the view that Court correctly found the prohibition on registration of disparaging marks to be contrary to fundamental principles of free speech, and that its analysis should apply directly to the similar blanket prohibitions on registering immoral or scandalous content. The article suggests ways in which these provisions could be revised or narrowed to satisfy First Amendment scrutiny.

In contrast to the Lanham Act provisions that are now plainly unconstitutional, other prohibitions found in the Lanham Act, which preclude deceptive, confusingly similar, and functional marks, can be defended based upon traditional trademark principles that are consistent with robust First Amendment protections for free speech. This article contends that First Amendment principles do allow for most of the statutory limitations placed on trademark registration, and that – contrary to the predictions of some commentators – the ruling will not cause any significant disruption in the large majority of trademark cases. It is true, however, as at least one court has now

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<sup>2</sup> 137 S. Ct. 1744 (2017).

<sup>3</sup> See *Our Story*, <http://www.theslants.com/biography/> (last visited Dec. 14, 2018).

<sup>4</sup> See generally *Matal*, 137 S. Ct. 1744.

<sup>5</sup> *Id.* at 1751.

<sup>6</sup> *Id.* at 1765.

held, that the Lanham Act rules against immoral, scandalous, and disparaging marks must be completely reevaluated based on free speech considerations.

Finally, the article addresses whether *Tam* might eventually alter the extent to which the scope of protection trademark owners receive based on their ability to prevent confusingly similar uses and to prevent dilution by tarnishment or blurring might be subject to challenge under the First Amendment. The article finds that claims by trademark owners based on consumer confusion or dilution should generally be unaffected by the Supreme Court's decision in *Tam*.

## II. BACKGROUND

### A. U.S. TRADEMARK LAW

The Lanham Act was enacted to provide a nationwide system for the registration and protection of trademarks.<sup>7</sup> The law was designed to “protect the public so it may be confident that, in purchasing a product bearing a particular trademark which it favorably knows, it will get the product which it asks for and wants to get.”<sup>8</sup> In addition, the law enables trademark owners to protect their investment from misappropriation by free riders.<sup>9</sup> “By applying a trademark to goods produced by one other than the trademark’s owner, the infringer deprives the owner of the goodwill which he spent energy, time, and money to obtain. At the same time, the infringer deprives consumers of their ability to distinguish among the goods of competing manufacturers.”<sup>10</sup> Section 2 of the Lanham Act identifies marks that are ineligible for registration on the principal register—the fundamental avenue by which marks are protected under federal trademark law.<sup>11</sup>

An extended discussion of the history of the Lanham Act’s blanket prohibition on the registration of “scandalous” or “immoral” marks can be found in the ruling *In re Old Glory Condom Corp.*<sup>12</sup> There have been only a few recent reported cases, for example, *In re Wilcher Corp.*, which affirmed the refusal to register the mark “Dick Heads” and the accompanying logo for restaurant and bar services.<sup>13</sup>

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<sup>7</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 782 n.15 (1992) (Stevens, J., concurring) (quoting S.Rep. No. 791333, at 3 (1946)).

<sup>8</sup> *Id.*

<sup>9</sup> *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 854 n.14 (1982).

<sup>10</sup> *Id.* (citations omitted).

<sup>11</sup> Section 2(a) states: “No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—(a) [c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.” 15 U.S.C.A. § 1052 (West).

<sup>12</sup> 26 U.S.P.Q.2d 1216 (T.T.A.B. 1993).

<sup>13</sup> 40 U.S.P.Q.2d 1929 (T.T.A.B. 1996),

The Federal Circuit's ruling in *In re Mavety Media Group, Ltd.* sets forth the standard for refusals to register marks on the ground that they are immoral or scandalous.<sup>14</sup> The court stated:

We therefore leave for another day the resolution of whether a standard dictionary definition and an accompanying editorial designation of vulgarity alone sufficiently demonstrates that a substantial composite of the general public considers that word scandalous, and consequently, whether the PTO may refuse under § 1052(a) to register a mark based solely on such standard dictionary evidence. Of course, the PTO may discharge its burden of proving that Mavety's mark BLACK TAIL is scandalous under § 1052(a) through evidence such as consumer surveys regarding the substantial composite of the general public. However, we note the view of our predecessor court that the § 1052(a) prohibition against scandalous marks is not "an attempt to legislate morality, but, rather, a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government." *McGinley*, 660 F.2d at 486, 211 USPQ at 674. We therefore commend the practice adopted by the Board in another case to resolve the issue whether a mark comprises scandalous matter under § 1052(a) "in favor of [the] applicant and pass the mark for publication with the knowledge that if a group does find the mark to be scandalous . . . , an opposition proceeding can be brought and a more complete record can be established." . . . Moreover, the Board has held that under 15 U.S.C. § 1063(a) (1988), any person who *believes* that he would be damaged by registration of a mark upon the principal register, thus including interested members of the composite of the general public, has standing to challenge registration in an opposition proceeding. . . . Indeed, such a procedure establishes a meaningful opportunity for response by the applicant with evidence that a substantial composite of the general public would not consider the mark at issue scandalous in the context of contemporary attitudes and the relevant marketplace.<sup>15</sup>

These decisions ultimately turn on cultural imperatives and taboos, as sensed by the decision-makers (appellate judges, the Trademark Trial & Appeal Board, and initially the examiner). The formerly guiding trademark law principles to be

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<sup>14</sup> 33 F.3d 1367 (Fed. Cir. 1994),

<sup>15</sup> *Id.* at 1374.

discerned from the cases at issue in this article—subject now to First Amendment review and reassessment—are: (1) that trademarks may not be registered under federal law if they are scandalous or immoral (however defined from time to time); and (2) that they may be cancelled if they are or have become offensive to a substantial composite of the general public.

Under the Lanham Act, marks can be precluded from registration on grounds of offensiveness.<sup>16</sup> For example, decades-old litigation involving the Washington Redskins' trademarks, addressing whether the registrations for those marks should be cancelled as disparaging toward Native Americans, was effectively resolved by the ruling in *Matal v. Tam*.<sup>17</sup> In *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015), the district court rejected the First Amendment arguments and held that the Redskins trademarks may disparage Native Americans and thus were subject to cancellation under then-governing precedent.<sup>18</sup> Pro-Football, Inc. appealed these decisions, and litigation concerning the Washington Redskins marks continued to proceed through the courts.<sup>19</sup>

The Federal Circuit has identified some of the marks that have been denied the benefit of trademark protection on grounds of disparagement. They run the gamut:

REDSKINS;<sup>20</sup> STOP THE ISLAMISATION OF AMERICA;<sup>21</sup> THE CHRISTIAN PROSTITUTE (2013); AMISHHOMO (2013); MORMON WHISKEY (2012); KHORAN FOR WINE;<sup>22</sup> HAVE YOU HEARD THAT SATAN IS A REPUBLICAN? (2010); RIDE HARD RETARD (2009);

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<sup>16</sup> 15 U.S.C.A. § 1052(a) (West).

<sup>17</sup> See *Matal v. Tam*, 137 S. Ct. 1744 (2017).

<sup>18</sup> See also *Harjo v. Pro-Football, Inc.*, 30 U.S.P.Q.2d 1828 (T.T.A.B. 1994) (denying motion to dismiss suit to cancel registration of Washington Redskins trademark on the ground that it disparages Native Americans and striking defenses based on secondary meaning and equitable considerations), *later proceeding*, 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999) (finding certain marks to be disparaging and may bring Native Americans into contempt or disrepute).

<sup>19</sup> See *Pro-Football, Inc. v. Harjo*, 415 F.3d 44 (D.C. Cir. 2005) (reversing grant of summary judgment to team based on laches defense and remanding for further consideration). See also Catherine MC. Farrelly, *Supreme Court Denies Certiorari in Trademark Challenge to Washington Redskins Name*, Gibbons IP Law Alert (Jan. 12, 2010), <https://www.iplawalert.com/2010/01/12/Supreme-Court-denies-certiorari-in-trademark-challenge-to-washington-redskins-name/>.

<sup>20</sup> *Pro-Football, Inc. v. Blackhorse*, No. 1–14–CV–01043–GBL–IOD, 112 F. Supp. 3d 439, 2015 WL 4096277 (E.D. Va. 2015) (2014 PTO cancellation determination currently on appeal in Fourth Circuit).

<sup>21</sup> *In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014).

<sup>22</sup> *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215 (T.T.A.B. Mar. 4, 2010).

ABORT THE REPUBLICANS (2009); HEEB;<sup>23</sup> SEX ROD;<sup>24</sup> MARRIAGE IS FOR FAGS (2008); DEMOCRATS SHOULDN'T BREED (2007); REPUBLICANS SHOULDN'T BREED (2007); 2 DYKE MINIMUM (2007); WET BAC/WET B.A.C. (2007); URBAN INJUN (2007); SQUAW VALLEY;<sup>25</sup> DON'T BE A WET BACK (2006); FAGDOG (2003); N.I.G.G.A. NATURALLY INTELLIGENT GOD GIFTED AFRICANS (1996); a mark depicting a defecating dog;<sup>26</sup> an image consisting of the national symbol of the Soviet Union with an "X" over it;<sup>27</sup> DOUGH-BOY for "a prophylactic preparation for the prevention of venereal diseases."<sup>28</sup>

As the Federal Circuit noted, there is no common law antecedent or precedent for the disparagement prohibition, which was put into place when the Lanham Act was enacted in 1946; immoral and scandalous marks were barred in the 1905 statute.<sup>29</sup> The initial decision regarding whether a mark is disparaging under § 2(a) is made by a single trademark examiner, applying the following test:

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

(2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.<sup>30</sup>

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<sup>23</sup> *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071 (T.T.A.B. Nov. 26, 2008).

<sup>24</sup> *Bos. Red Sox Baseball Club L.P. v. Sherman*, 88 U.S.P.Q.2d 1581 (T.T.A.B. Sept. 9, 2008) (sustaining an opposition on multiple grounds, including disparagement).

<sup>25</sup> *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264 (T.T.A.B. June 2, 2006)

<sup>26</sup> *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d 1635 (T.T.A.B. Mar. 30, 1988) (found to disparage Greyhound's trademarked running dog logo).

<sup>27</sup> *In re Anti-Communist World Freedom Cong., Inc.*, 161 U.S.P.Q. 304 (T.T.A.B. Feb. 24, 1969).

<sup>28</sup> *Doughboy Indus., Inc. v. Reese Chem. Co.*, 88 U.S.P.Q. 227 (T.T.A.B. Jan. 25, 1951).

<sup>29</sup> *In re Tam*, 808 F.3d at 1330.

<sup>30</sup> Trademark Manual of Exam. Proc. ("TMEP") § 1203.03(b)(i).

As the Federal Circuit noted, a “single examiner, with no input from her supervisor, can reject a mark as disparaging by determining that it would be disparaging to a substantial composite of the referenced group.”<sup>31</sup> Though this decision is subject to review if the trademark applicant seeks to appeal, it sets a troubling pattern from a free speech perspective.

#### B. THE FEDERAL CIRCUIT'S RULING ON THE FREE SPEECH/TRADEMARK INTERSECTION

*In re Tam*, as the case was known at the Federal Circuit level, involved an Asian-American band known as the “Slants.” Applying strict scrutiny (which requires that the prohibition is narrowly tailored to achieve a compelling governmental interest) to what it viewed as a content-based and view-point based rule, Judge Moore’s Federal Circuit *en banc* majority opinion found that the prohibition on disparaging marks was not simply a regulation of commercial speech, given that it sought to regulate expressive components of the band’s speech.<sup>32</sup> Rather, the court held that the prohibition placed a significant chill and burden on private free speech by denying trademark registration on the basis of viewpoint.<sup>33</sup> Finally, the court found that even if the prohibition was deemed a regulation of commercial speech, there was no substantial governmental interest in regulating disparaging speech.<sup>34</sup>

Tam and his bandmates formed an Asian–American dance-rock band in 2006, selecting “The Slants” as the name for the group. Tam sought to “reclaim” and “take ownership” of Asian stereotypes and childhood slurs by making use of this term for his band.<sup>35</sup> The band’s album titles include “The Yellow Album” and “Slanted Eyes, Slanted Hearts,” reflecting the band’s belief “that Asians should be proud of their cultural heritage, and not be offended by stereotypical descriptions.”<sup>36</sup> When Tam sought to register the mark, the examiner deemed it disparaging to “persons of Asian descent” because of the term’s “long history of being used to deride and mock a physical feature” of people of Asian descent.<sup>37</sup>

Tam appealed to the Trademark Trial & Appeal Board, which affirmed the refusal to register the mark; the Board concluded that the mark was disparaging to a substantial component of people of Asian descent.<sup>38</sup> It based its decision on dictionary definitions, reference works, review of the band’s website and

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<sup>31</sup> *In re Tam*, 808 F.3d at 1331.

<sup>32</sup> 808 F.3d 1321, 1334-1335 (Fed. Cir. 2015).

<sup>33</sup> *Id.* at 1336-39.

<sup>34</sup> *Id.* at 1355-1357.

<sup>35</sup> *Id.* at 1331.

<sup>36</sup> *Id.*

<sup>37</sup> *Id.* at 1331-32.

<sup>38</sup> *In re Tam*, No. 85472044, 2013 WL 5498164, at \*5-7 (T.T.A.B. Sept. 26, 2013).



statements recognizing that the term was a stereotype, and evidence that members of the Asian community objected to the use of the word “Slants.”<sup>39</sup>

On appeal to the Federal Circuit, the original panel hearing the case affirmed the conclusion that the mark was disparaging.<sup>40</sup> The panel opinion rejected Tam’s constitutional challenge because it was bound by prior precedent (from the Federal Circuit’s predecessor court) that First Amendment concerns were not implicated by a refusal to register a trademark because the trademark owner could still make use of the mark.<sup>41</sup> That prior precedent, *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981), analysis consisted of the following: “With respect to appellant’s First Amendment rights, it is clear that the PTO’s refusal to register appellant’s mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant’s First Amendment rights would not be abridged by the refusal to register his mark.”<sup>42</sup>

As the Federal Circuit *en banc* opinion noted, it was appropriate to reconsider *McGinley* in light of the passage of time, the cursory nature of the reasoning in the 1981 ruling, the lack of citation to precedent, and the changing (and broadening) scope of First Amendment protection over several decades.<sup>43</sup> The Federal Circuit concluded that the disparagement provision of the Lanham Act is unconstitutional because it violates the First Amendment.<sup>44</sup> The court applied strict scrutiny to what it viewed as a content- and viewpoint-based rule:

It is beyond dispute that § 2(a) discriminates on the basis of content in the sense that it “applies to particular speech because of the topic discussed.” *Reed*, 135 S.Ct. at 2227. Section 2(a) prevents the registration of disparaging marks—it cannot reasonably be argued that this is not a content-based restriction or that it is a content-neutral regulation of speech. And the test for disparagement—whether a substantial composite of the referenced group would find the mark disparaging—makes clear that it is the nature of the message conveyed by the speech which is being regulated. If the mark is found disparaging by the

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<sup>39</sup> *Id.*

<sup>40</sup> *In re Tam*, 785 F.3d 567, 570–71 (Fed. Cir. 2015), *reh’g en banc granted, opinion vacated*, 600 Fed. Appx. 775 (Fed. Cir. 2015).

<sup>41</sup> *Id.* at 572–73.

<sup>42</sup> *Id.* at 573.

<sup>43</sup> *In re Tam*, 808 F.3d at 1333–34.

<sup>44</sup> *Id.*

referenced group, it is denied registration. “Listeners’ reaction to speech is not a content-neutral basis for regulation.”<sup>45</sup>

Moreover, the court noted that the prohibition discriminates not just on the basis of topic, but also its specific message or viewpoint: “It also discriminates on the basis of message conveyed, ‘the idea or message expressed’; it targets ‘viewpoints [in] the marketplace.’ It does so as a matter of avowed and undeniable purpose, and it does so on its face.”<sup>46</sup> The court noted that the government’s own arguments attempting to defend the prohibition explicitly concede its antipathy to the supposed message of Tam’s mark: “Underscoring its hostility to these messages, the government repeatedly asserts in its briefing before this court that it ought to be able to prevent the registration of ‘the most vile racial epithets and images,’ and ‘to dissociate itself from speech it finds odious.’”<sup>47</sup> So too, the legislative history shows a similar purpose on the part of Congress.<sup>48</sup>

Judge Moore’s carefully thought out Federal Circuit *en banc* majority opinion found that the prohibition on disparaging marks was not simply a regulation of commercial speech, given that it sought to regulate expressive components of the band’s speech. The court noted: “The government cannot escape strict scrutiny by arguing that § 2(a) regulates commercial speech. True, trademarks identify the source of a product or service .... But they very commonly do much more than that. And, critically, it is always a mark’s expressive character, not its ability to serve as a source identifier, that is the basis for the disparagement exclusion from registration. The disparagement provision must be assessed under First Amendment standards applicable to what it targets, which is not the commercial-speech function of the mark.”<sup>49</sup> On the facts, the court noted that Tam’s mark is inherently expressive: “Tam makes a statement about racial and ethnic identity. He seeks to shift the meaning of, and thereby reclaim, an emotionally charged word. He advocates for social change and challenges perceptions of people of Asian descent. His band name pushes people. It offends.”<sup>50</sup>

The commercial nature of a trademark does not preclude consideration of the expressive nature of this speech: “That the speech is used in commerce or has a commercial component should not change the inquiry when the government regulation is entirely directed to the expressive component of the speech. This is not a government regulation aimed at the commercial component

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<sup>45</sup> *In re Tam*, 808 F.3d at 1335 (quoting *Forsyth Cty. v. Nationalist Movement*, 505 U.S. 123, 134, 112 S.Ct. 2395, 120 L.Ed.2d 101 (1992)).

<sup>46</sup> *Id.* (quoting *Reed*, 135 S.Ct. at 2227; *Simon & Schuster*, 502 U.S. at 116).

<sup>47</sup> *Id.* at 1336 (citing government brief).

<sup>48</sup> *Id.*

<sup>49</sup> *Id.* at 1337-38

<sup>50</sup> *Id.* at 1338.

of speech.”<sup>51</sup> Rather, the Federal Circuit held that the prohibition placed a significant chill and burden on private free speech by denying trademark registration on the basis of viewpoint.<sup>52</sup> There was no argument by the government that the prohibition could survive strict scrutiny (by showing it was narrowly tailored to serve a compelling government interest).<sup>53</sup>

The Federal Circuit then rejected three defenses asserted by the government. First was a claim that § 2(a) is immune from First Amendment scrutiny because it does not ban any speech, allowing Tam to use his name for the band.<sup>54</sup> As the court noted, “[l]awmakers may no more silence unwanted speech by burdening its utterance than by censoring its content.”[...] “[T]he government’s ability to impose content-based burdens on speech raises the specter that the government may effectively drive certain ideas or viewpoints from the marketplace.”<sup>55</sup> The denial of the important benefits of trademark registration would have a chilling effect on speech, such as Tam’s band.<sup>56</sup>

Second, the government and amici asserted that trademark registration is speech by the government, allowing the PTO to grant and reject trademarks as it sees fit.<sup>57</sup> This contention was readily dispatched by the Federal Circuit:

Use of a mark by its owner is clearly private speech. Trademarks identify the source of a product, and are often closely associated with the actual product. A mark’s purpose—to identify the source of goods—is antithetical to the notion that a trademark is tied to the government. The fact that COCA COLA and PEPSI may be registered trademarks does not mean the government has endorsed these brands of cola, or prefers them over other brands. We see no reason that a markholder’s use of its mark constitutes government speech.<sup>58</sup>

The court also rejected the argument that actions allowing trademark registration, use of the ® symbol, and placement in the trademark database somehow constitute government speech, and noted by analogy that it would be outright censorship for copyright registration to depend upon whether the

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<sup>51</sup> *Id.* (citing *Virginia State Board of Pharmacy*, 425 U.S. at 765 and *R.A.V.*, 505 U.S. at 385).

<sup>52</sup> *Id.*

<sup>53</sup> *Id.* at 1339.

<sup>54</sup> *Id.* at 1340.

<sup>55</sup> *Id.* (quoting *Sorrell*, 131 S. Ct. at 2664 and *Simon & Schuster*, 502 U.S. at 116).

<sup>56</sup> *Id.* at 1341-45.

<sup>57</sup> *Id.* at 1345.

<sup>58</sup> *Id.*

government viewed copyrighted material as somehow offensive, scandalous, or disparaging.<sup>59</sup> As the court noted,

The PTO's processing of trademark registrations no more transforms private speech into government speech than when the government issues permits for street parades, copyright registration certificates, or, for that matter, grants medical, hunting, fishing, or drivers licenses, or records property titles, birth certificates, or articles of incorporation. To conclude otherwise would transform every act of government registration into one of government speech and thus allow rampant viewpoint discrimination. When the government registers a trademark, it regulates private speech. It does not speak for itself.<sup>60</sup>

The government also asserted that the prohibition only withholds a government subsidy for Tam's speech, applying the unconstitutional conditions doctrine:

even though a person has no 'right' to a valuable governmental benefit and even though the government may deny him the benefit for any number of reasons, there are some reasons upon which the government may not rely. It may not deny a benefit to a person on a basis that infringes his constitutionally protected interests—especially, his interest in freedom of speech.<sup>61</sup>

Finally, the court found that even if the prohibition was deemed a regulation of commercial speech, there was no substantial governmental interest in regulating disparaging speech.<sup>62</sup> The court noted that just because trademarks were commercial in nature does not mean “that all government regulation of trademarks is properly reviewed under the *Central Hudson* intermediate scrutiny standard. Section 2(a) bars registration of disparaging marks. This regulation is squarely based on the expressive aspect of the speech, not its commercial-speech aspects.”<sup>63</sup> Nonetheless, the Federal Circuit proceeded to apply intermediate scrutiny, first noting that “[u]nlike many other provisions of § 2, the disparagement provision does not address misleading, deceptive, or unlawful marks.”<sup>64</sup> The court next found that there was no substantial governmental

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<sup>59</sup> *Id.* at 1345-46.

<sup>60</sup> *Id.* at 1348.

<sup>61</sup> *Id.* at 1349 (quoting *Perry v. Sinderman*, 408 U.S. 593, 597 (1972)).

<sup>62</sup> *Id.* at 1355.

<sup>63</sup> *Id.*

<sup>64</sup> *Id.*

interest served by the prohibition, which sought to suppress disfavored messages.<sup>65</sup> As the court summarized: “All of the government’s proffered interests boil down to permitting the government to burden speech it finds offensive. This is not a legitimate interest. With no substantial government interests, the disparagement provision of § 2(a) cannot satisfy the *Central Hudson* test.”<sup>66</sup>

As the Federal Circuit noted in its *en banc* opinion, “Tam and his band weigh in on cultural and political discussions about race and society that are within the heartland of speech protected by the First Amendment.”<sup>67</sup> As the court concluded: “Whatever our personal feelings about the mark at issue here, or other disparaging marks, the First Amendment forbids government regulators to deny registration because they find the speech likely to offend others. Even when speech ‘inflict[s] great pain,’ our Constitution protects it ‘to ensure that we do not stifle public debate.’”<sup>68</sup>

Judges O’Malley and Wallach concurred in the *en banc* majority opinion, but also viewed the prohibition as unconstitutionally vague under the First Amendment.<sup>69</sup> Judge Dyk dissented with regard to the facial constitutional analysis, urging that the statute merely regulated commercial speech and that it sought “to protect underrepresented groups in our society from being bombarded with demeaning messages in commercial advertising.”<sup>70</sup> He agreed with the majority, however, that the prohibition was unconstitutional as applied to Tam because of the expressive nature of his particular trademark.<sup>71</sup> Finally, Judge Lourie and Reyna wrote separate dissents that would uphold the prohibition on registration of Tam’s mark.<sup>72</sup>

### C. THE SUPREME COURT’S DECISION AND OPINIONS

The Supreme Court’s opinion in *Matal v. Tam*, 137 S.Ct. 1744 (2017), is striking in a number of ways.<sup>73</sup> Justice Alito announced the judgment of the Court and delivered a unanimous opinion striking down the prohibition on

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<sup>65</sup> *Id.* at 1355-56 (citing *Sorrell v. IMS Health, Inc.*, 564 U.S. 552, 570-73 (2011); *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 69-72 (1983); *Carey v. Population Servs., Int’l*, 431 U.S. 678, 701 & n. 28 (1977)).

<sup>66</sup> *Id.* at 1357.

<sup>67</sup> *In re Tam*, 808 F.3d at 1331.

<sup>68</sup> *Id.* at 1357-78 (quoting *Snyder*, 562 U.S. at 461).

<sup>69</sup> *Id.* at 1358 (O’Malley, J. concurring).

<sup>70</sup> *Id.* at 1364 (Dyk, J., dissenting in part).

<sup>71</sup> *Id.* at 1373-74 (Dyk, J., concurring in part).

<sup>72</sup> *Id.* at 1374 (Lourie, J., dissenting); *Id.* at 1376 (Reyna, J., dissenting).

<sup>73</sup> See *Matal v. Tam*, 137 S.Ct. 1744 (2017).

disparaging marks.<sup>74</sup> Specifically, Parts I, II, and III–A of his opinion were joined by all participating justices.<sup>75</sup> Justice Gorsuch did not participate, so this part of the opinion was a unanimous 8–0 conclusion; the remainder of his opinion, Parts III–B, III–C, and IV, were joined by Chief Justice Roberts, Justice Thomas, and Justice Breyer.<sup>76</sup>

The Court’s bottom line ruling stated: “We now hold that 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.”<sup>77</sup>

The Court began its analysis with a summary of the development of trademark protection under state law and the common law, and its eventual protection under federal law for reasons of national uniformity.<sup>78</sup> The Court noted that even without federal registration, a valid trademark may still be used in commerce and may be enforced under § 43(a) of the Lanham Act.<sup>79</sup> The Court also noted the importance of federal registration, which confers a variety of rights and benefits:

Registration on the principal register (1) “serves as ‘constructive notice of the registrant’s claim of ownership’ of the mark,” [*B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S.Ct. 1293, 1300 (2015)] (quoting 15 U.S.C. § 1072); (2) “is ‘prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate,’ “ *B & B Hardware*, 575 U.S. at —, 135 S.Ct. at 1300 (quoting § 1057(b)); and (3) can make a mark “‘incontestable’ “ once a mark has been registered for five years,” *ibid.* (quoting §§ 1065, 1115(b)); see *Park ‘N Fly*, 469 U.S. at 193, 105 S.Ct. 658. Registration also enables the trademark holder “to stop the importation into the United States of articles bearing an infringing mark.” 3 *McCarthy* § 19:9, at 19–38; see 15 U.S.C. § 1124.”<sup>80</sup>

After addressing a statutory argument made by Tam, Justice Alito turned to the Government’s contentions: “(1) that trademarks are government speech, not

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<sup>74</sup> *Id.*

<sup>75</sup> *Id.*

<sup>76</sup> *Id.*

<sup>77</sup> *Id.* at 1751.

<sup>78</sup> *Id.* at 1748.

<sup>79</sup> *Id.* at 1752.

<sup>80</sup> *Id.* at 1753.

private speech, (2) that trademarks are a form of government subsidy, and (3) that the constitutionality of the disparagement clause should be tested under a new ‘government-program’ doctrine.”<sup>81</sup>

Addressing the unique category of government speech, the Court noted: “When a government entity embarks on a course of action, it necessarily takes a particular viewpoint and rejects others. The Free Speech Clause does not require government to maintain viewpoint neutrality when its officers and employees speak about that venture.”<sup>82</sup>

The Court provided illustrations from World War II, including posters to promote the war effort, such as urging enlistment, purchasing of war bonds, and conservation of resources.<sup>83</sup> Justice Alito then noted the fundamental danger posed by a wide-ranging government speech doctrine: “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.”<sup>84</sup>

The Court noted that the federal government does not create, edit, or endorse marks that are proposed for registration, and that it cannot deny registration based on viewpoint.<sup>85</sup> If merely registering a mark renders the mark governmental, then “the Federal Government is babbling prodigiously and incoherently. It is saying many unseemly things. It is expressing contradictory views. It is unashamedly endorsing a vast array of commercial products and services. And it is providing Delphic advice to the consuming public.”<sup>86</sup>

Justice Alito proceeded to distinguish the Court’s government speech. *Johanns* concerned advertisements promoting the sale of beef products that were approved and sponsored by the Secretary of Agriculture.<sup>87</sup> *Sumnum* involved a city-run and funded park contained 15 monuments that had been selected and approved by the city to be placed on the grounds.<sup>88</sup> Finally, the closest case to the present dispute, *Walker*, “likely marks the outer bounds of the government-speech doctrine.”<sup>89</sup> Addressing messages on Texas specialty license plates, the Court noted that license plates are manufactured and designed by the states, and

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<sup>81</sup> *Id.* at 1757.

<sup>82</sup> *Id.*

<sup>83</sup> *Id.* at 1758.

<sup>84</sup> *Id.*

<sup>85</sup> *Id.*

<sup>86</sup> *Id.*

<sup>87</sup> *Johanns v. Livestock Marketing Assn.*, 544 U.S. 550 (2005).

<sup>88</sup> *Pleasant Grove City v. Sumnum*, 555 U.S. 460 (2009).

<sup>89</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1760 (2017) (citing *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015)).

they have long been used by the States to convey various state messages.<sup>90</sup> Moreover, Texas retained direct control over the messages conveyed on the plates.<sup>91</sup>

Trademarks, the Court noted, share none of these characteristics.<sup>92</sup> Trademarks have not traditionally been used to convey a Government message, and 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.<sup>93</sup> And there is no evidence that the public associates the contents of trademarks with the Federal Government.<sup>94</sup>

Thus, the Court determined that “registration of trademarks is vastly different from the beef ads in *Johanns*, the monuments in *Summum*, and even the specialty license plates in *Walker*. Holding that the registration of a trademark converts the mark into government speech would constitute a huge and dangerous extension of the government-speech doctrine.”<sup>95</sup>

The Court then expressed its concern that if registration of trademarks was government speech, then other registration systems could easily be so characterized: “Perhaps the most worrisome implication of the Government’s argument concerns the system of copyright registration. If federal registration makes a trademark government speech and thus eliminates all First Amendment protection, would the registration of the copyright for a book produce a similar transformation?”<sup>96</sup> Rejecting the Government’s attempt to distinguish copyrights on the ground that they are “the engine of free expression,” the Court noted that trademarks can also have expressive content or convey a message. In sum, “[t]rademarks are private, not government, speech.”<sup>97</sup>

To this point, Justice Alito was writing for a unanimous Court. Justice Kennedy, writing for himself and three other Justices, states in his concurrence “that the viewpoint discrimination rationale renders unnecessary any extended treatment of other questions raised by the parties.”<sup>98</sup>

Justice Alito, writing for four of the eight Justices who heard the case, proceeded to address a line of cases involving government programs subsidizing speech that expressed a particular viewpoint.<sup>99</sup> As he notes, “we have held that the Government ‘may not deny a benefit to a person on a basis that infringes his constitutionally protected . . . freedom of speech even if he has no entitlement

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<sup>90</sup> *Id.* at 2248.

<sup>91</sup> *See Id.* at 2249.

<sup>92</sup> *Matal v. Tam*, 137 S.Ct. at 1760.

<sup>93</sup> *Id.*

<sup>94</sup> *Id.*

<sup>95</sup> *Id.*

<sup>96</sup> *Id.*

<sup>97</sup> *Id.*

<sup>98</sup> *Id.* at 1765, (Kennedy, J. concurring).

<sup>99</sup> *Matal v. Tam*, 137 S.Ct. at 1760.



to that benefit.”<sup>100</sup> Moreover, each of these cases involved cash subsidies or their equivalent.<sup>101</sup>

In contrast, Justice Alito noted, federal trademark registration does not involve funding for applicants; instead applicant must pay the PTO a filing fee, which ranges \$225–\$600.<sup>102</sup> Those who hold federal registrations must pay a fee of \$300–\$500 every ten years in order to maintain the registration.<sup>103</sup> Indeed, these payments support the operation of the trademark registration system.<sup>104</sup>

Next, the Government argued for a new doctrine applicable to government programs, citing two cases involving the collection of union dues by a public employer. Justice Alito viewed these cases as similar to the subsidy cases.<sup>105</sup> Although there were no cash subsidies to the unions,

they conferred a very valuable benefit—the right to negotiate a collective-bargaining agreement under which non-members would be obligated to pay an agency fee that the public employer would collect and turn over to the union free of charge. As in the cash subsidy cases, the laws conferred this benefit because it was thought that this arrangement served important government interests.<sup>106</sup>

Justice Alito then addressed cases in which the government created a limited public forum for private speech.<sup>107</sup> Although some content- and speaker-based restrictions may be allowed in these settings, the court has prohibited the government from engaging in “viewpoint discrimination.”<sup>108</sup> Here, the

<sup>100</sup> *Id.* (quoting *Agency for Int’l Dev. v. Alliance for Open Soc’y Int’l, Inc.*, 570 U.S. 205, 214 (2013)).

<sup>101</sup> *Id.*; *See Rust v. Sullivan*, 500 U.S. 173(1991) (“[F]unds [for] private parties for family planning services”); *Nat’l Endowment for Arts v. Finley*, 524 U.S. 569(1998) (cash grants for artists); *United States v. Am. Library Assn., Inc.*, 539 U.S. 194(2003) (“[F]ederal funding for public libraries”); *see also Regan v. Taxation With Representation of Wash.*, 461 U.S. 540(1983); *Cammarano v. United States*, 358 U.S. 498 (1959).

<sup>102</sup> *Matal*, 137 S. Ct. at 1761 (citing 37 C.F.R. § 2.6(a)(1)).

<sup>103</sup> § 2.6(a)(5); *see also* 15 U.S.C. § 1059(a).

<sup>104</sup> *Matal*, 137 S.Ct. at 1749.

<sup>105</sup> *Id.*

<sup>106</sup> *Id.* at 1762 (discussing *Davenport v. Washington Ed. Assn.*, 551 U.S. 177, 181–182(2007) and *Ysursa v. Pocatello Ed. Assn.*, 555 U.S. 353(2009)).

<sup>107</sup> *Id.* at 1763 (citing *Good News Club v. Milford Central School*, 533 U.S. 98, 106–107(2001); *Rosenberger v. Rector and Visitors of Univ. of Va.*, 515 U.S. 819, 831(1995); *Lamb’s Chapel v. Ctr. Moriches union free Sch. Dist.*, 508 U.S., 384, 392–393).

<sup>108</sup> *Id.* at 1757 (citing *Lamb’s Chapel*, 508 U.S. at 831).

prohibition on any speech that gives offense is, Justice Alito noted, viewpoint based.<sup>109</sup>

Justice Alito then addressed whether trademarks are commercial speech analyzed under the more generous standard of *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n of N.Y.*<sup>110</sup> Although trademarks undoubtedly have commercial purposes, they can—and often do—also have expressive components.<sup>111</sup> “The trademark in this case illustrates this point. The name ‘The Slants’ not only identifies the band but expresses a view about social issues.”<sup>112</sup> Justice Alito’s opinion did not resolve whether the commercial speech standard should govern, because he indicated that the disparagement clause fails to meet the Central Hudson test’s requirements that a restriction on speech must serve a “substantial interest” and must be “narrowly drawn.”<sup>113</sup>

The Government proffered two interests to justify the prohibition. The first, preventing underrepresented groups from receiving demeaning messages in commercial advertising, runs counter to the First Amendment, as noted earlier in the opinion.<sup>114</sup> Justice Alito noted: “Speech that demeans on the basis of race, ethnicity, gender, religion, age, disability, or any other similar ground is hateful; but the proudest boast of our free speech jurisprudence is that we protect the freedom to express ‘the thought that we hate.’”<sup>115</sup>

With regard to the second interest—protecting the orderly flow of commerce from disruption by disparaging marks—Justice Alito found that the clause is not narrowly drawn to achieve this result.<sup>116</sup> Further, he stated:

There is also a deeper problem with the argument that commercial speech may be cleansed of any expression likely to

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<sup>109</sup> *Id.* at 1763 (citing *Street v. New York*, 394 U.S. 576, 592(1969) (“the public expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers.”); *Texas v. Johnson*, 491 U.S. 397, 414(1989) (“If 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.”); *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 55–56(1988); *Coates v. Cincinnati*, 402 U.S. 611, 615(1971); *Bachellar v. Maryland*, 397 U.S. 564, 567(1970); *Tinker v. Des Moines Independent Community School Dist.*, 393 U.S. 503, 509–514(1969); *Cox v. Louisiana*, 379 U.S. 536, 551(1965); *Edwards v. South Carolina*, 372 U.S. 229, 237–238(1963); *Terminiello v. Chicago*, 337 U.S. 1, 4–5(1949); *Cantwell v. Connecticut*, 310 U.S. 296, 311 (1940); *Schneider v. State (Town of Irvington)*, 308 U.S. 147, 161 (1939); *De Jonge v. Oregon*, 299 U.S. 353, 365(1937).

<sup>110</sup> *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm’n of N.Y.*, 447 U.S. 557 (1980).

<sup>111</sup> *Id.*

<sup>112</sup> *Id.* at 1764.

<sup>113</sup> *Id.* (citing *Central Hudson*, 447 U.S. at 564–565).

<sup>114</sup> *Id.*

<sup>115</sup> *Id.* (quoting *United States v. Schwimmer*, 279 U.S. 644, 655(1929) (Holmes, J., dissenting)).

<sup>116</sup> *Id.* at 1764–65.

cause offense. The commercial market is well stocked with merchandise that disparages prominent figures and groups, and the line between commercial and non-commercial speech is not always clear, as this case illustrates. If affixing the commercial label permits the suppression of any speech that may lead to political or social “volatility,” free speech would be endangered.<sup>117</sup>

As noted previously, Justice Kennedy stated in his concurrence that § 1052(a) constitutes viewpoint discrimination.<sup>118</sup> He observed that this is “a form of speech suppression so potent that it must be subject to rigorous constitutional scrutiny. The Government’s action and the statute on which it is based cannot survive this scrutiny.”<sup>119</sup> He noted that categories of speech that can be punished based on viewpoint are well established—such as fraud, defamation, and incitement.<sup>120</sup> Justice Kennedy rejected the government’s claim that it was an equal opportunity censor, precluding all types of offensive speech:

The First Amendment’s viewpoint neutrality principle protects more than the right to identify with a particular side. It protects the right to create and present arguments for particular positions in particular ways, as the speaker chooses. By mandating positivity, the law here might silence dissent and distort the marketplace of ideas.<sup>121</sup>

Nor does it matter that the suppression of speech was focused on the government seeking to address an audience reaction or offense.<sup>122</sup> Regarding the issue of trademarks as commercial speech, Justice Kennedy again reiterated that viewpoint discrimination, even in the commercial context, is inherently suspect.<sup>123</sup> He notes that “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.”<sup>124</sup>

Finally, Justice Kennedy noted the broader import of the holding in the *Tam* case:

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<sup>117</sup> *Id.* at 1765.

<sup>118</sup> *Id.* (Kennedy, J. concurring).

<sup>119</sup> *Id.*

<sup>120</sup> *Id.*

<sup>121</sup> *Id.* at 1766.

<sup>122</sup> *Id.*

<sup>123</sup> *Id.*

<sup>124</sup> *Id.* at 1768.

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 reliance must be on the substantial safeguards of free and open discussion in a democratic society.<sup>125</sup>

Justice Thomas, concurring in part, agreed with Justice Alito's constitutional analysis and conclusions, writing separately to reiterate his view that restrictions on commercial speech should be analyzed using strict scrutiny.<sup>126</sup> He agreed with Justice Alito's conclusion that the disparagement clause "is unconstitutional even under the less stringent test announced in *Central Hudson*."<sup>127</sup>

#### D. IMPLICATIONS AND COMMENTARY

Much of the academic commentary regarding the intersection between First Amendment principles and the registration of offensive marks has taken a view that allows government actors —trademark examiners, with review by the courts—to determine which marks are or are not entitled to the crucial benefits of federal trademark law. For example, Professor Rebecca Tushnet, in her article, "The First Amendment Walks into a Bar: Trademark Protection and Free Speech," which was written prior to the Supreme Court's unanimous decision,<sup>128</sup> makes two fundamental contentions. First, her article contends that the Federal Circuit decision in *In re Tam* was "wrongly reasoned even given the Supreme Court's increased scrutiny of commercial speech regulations, and that to hold otherwise and preserve the rest of trademark law would require unprincipled distinctions within trademark law."<sup>129</sup> Her broader contention is that "the Supreme Court's First Amendment jurisprudence has become so expansive as to threaten basic aspects of the regulatory state; the result of subjecting economic regulations such as trademark registration to strict First Amendment scrutiny shows the damage that can be done thereby."<sup>130</sup> This article disputes both of these propositions.

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<sup>125</sup> *Id.* at 1769.

<sup>126</sup> See *Id.* at 1769 (citing *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 572(2001) (THOMAS, J., concurring in part and concurring in judgment); 44 *Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 518(1996).

<sup>127</sup> *Id.*

<sup>128</sup> Rebecca Tushnet, THE FIRST AMENDMENT WALKS INTO A BAR: TRADEMARK PROTECTION AND FREE SPEECH, 92 *Notre Dame L. Rev.* 381 (2016); see also Ned Snow, FREE SPEECH & DISPARAGING TRADEMARKS, 55 *B.C. L. Rev.* 1639 (2016).

<sup>129</sup> *Id.* at 382.

<sup>130</sup> *Id.*

With regard to Tushnet's First Amendment argument, she views the issuance of a trademark registration as a sufficient endorsement of the mark to allow the government to be the arbiter of the scope of proper trademark discourse:

the government *could* express an opinion about what the boundaries of appropriate public discourse are, and it could accept both Apple and Microsoft as contenders, just as it can approve a no-pets restrictive covenant and an all-pets-allowed covenant for a residential community because both are rational. Allowing a particular plate, or a particular mark, expresses only the opinion that it's appropriate for its environment, without saying that it's correct.<sup>131</sup>

Yet, as noted above, this is precisely what the First Amendment prevents the government from doing—determining the boundaries of public discourse. And the Supreme Court — without dissent — agreed with this proposition.<sup>132</sup>

Next, Tushnet states:

If the government endorsement argument fails, however, the next standard justification for refusing disparaging marks registration is persuasive. The [disparagement] bar doesn't save government resources, because it takes a lot of judicial and administrative resources to enforce section 2(a). Also, if section 43(a) of the Lanham Act remains available to protect against confusing uses of unregistered disparaging marks, then government resources are still being devoted to protecting such marks.<sup>133</sup>

Again, the Federal Circuit's analysis on this point is more persuasive, and the Supreme Court agreed.

Tushnet then makes the following argument:

The third justification for the disparagement bar, lack of effect on the ability or right to use the mark, is the most complicated and also ultimately the strongest. . . . [T]here's still nothing stopping anyone, including the Washington football team, from using a disparaging term on a T-shirt or uniform and thus there is no cognizable harm inflicted on them. Although the

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<sup>131</sup> *Id.* at 392.

<sup>132</sup> *See Matal v. Tam*, 137 S.Ct. 1744 (2017).

<sup>133</sup> Tushnet, *supra* note 128, at 393.

government can rarely suppress speech based on its content, it also isn't required to support or facilitate in amplifying the reach of privately produced disparaging content.<sup>134</sup>

On the contrary, one of the weaker arguments ever proposed for denying trademark protection based on government fiat is that the owner of the mark is not totally prohibited from making use of the mark—it is only being denied the crucial benefits of the Lanham Act. Those benefits were highlighted in Judge Moore's *en banc* Federal Circuit opinion:

The holder of a federal trademark has a right to exclusive nationwide use of that mark where there was no prior use by others. *See* 15 U.S.C. §§ 1072, 1115. Because the common law grants a markholder the right to exclusive use only in the geographic areas where he has actually used his mark, *see* 5 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 26:32 (4th ed.) (hereinafter “McCarthy”), holders of a federally registered trademark have an important substantive right they could not otherwise obtain. Also, a registered mark is presumed to be valid, 15 U.S.C. § 1057(b), and the mark becomes incontestable (with certain exceptions) after five years of consecutive post-registration use, *id.* § 1065; *see also B & B Hardware*, 135 S.Ct. at 1310 (“Incontestability is a powerful protection.”). A markholder may sue in federal court to enforce his trademark, 15 U.S.C. § 1121, and he may recover treble damages if he can show infringement was willful, *id.* § 1117. He may also obtain the assistance of U.S. Customs and Border Protection in restricting importation of infringing or counterfeit goods, *id.* § 1124, 19 U.S.C. § 1526, and qualify for a simplified process for obtaining recognition and protection of his mark in countries that have signed the Paris Convention, *see id.* § 1141b (Madrid Protocol); Paris Convention for the Protection of Industrial Property art. 6 quinquies, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305. Lastly, registration operates as a complete defense to state or common law claims of trademark dilution.<sup>135</sup>

As the court further elaborated, “while it is true that a trademark owner may use its mark in commerce even without federal registration, it has been widely

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<sup>134</sup> *Id.* at 394.

<sup>135</sup> *In re Tam*, 808 F.3d 1321, 1328-29 (Fed. Cir. 2015) (*en banc*).

recognized that federal trademark registration bestows truly significant and financially valuable benefits upon markholders.”<sup>136</sup>

Next, Professor Tushnet analyzes the unconstitutional conditions doctrine, acknowledging that it “is a enormous hairball.”<sup>137</sup> The heart of her analysis is the following:

Because the trademark function can be separated from the other communicative functions of a symbol, it may be regulated without having harmful effects on those other functions. While the *Tam* majority saw section 2(a) as regulating based on the expressive, not the commercial, elements of speech, the majority had it backwards. The content of expression is important to figuring out if a symbol is capable of being a trademark, but denying trademark rights regulates only the commercial aspects of the speaker’s message. If the trademark owner wants to communicate other things about itself (including “we wish to insult Native Americans” or “we wish to reclaim a slur”), it can use other symbols in conjunction with its mark.”<sup>138</sup>

Again, Tushnet misses the expressive nature of the mark in question, something recognized by both the majority and the three-judge partial concurrence in the *Tam* Federal Circuit *en banc* decision, as well as by the Supreme Court; merely repackages the argument that a rejected trademark owner can express itself in other ways and interprets the unconstitutional conditions doctrine in an overly narrow way.

It is clearly established that content-based burdens on protected expression are subject to the same constitutional scrutiny as outright bans on speech. As the Supreme Court noted in *United States v. Playboy Entertainment Group, Inc.*, “[t]he distinction between laws burdening and laws banning speech is but a matter of degree. The Government’s content-based burdens must satisfy the same rigorous

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<sup>136</sup> *Id.* at 1340 (citing *B & B Hardware*, 135 S.Ct. at 1300; *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 199–200 (1985) (valuable new rights were created by the Lanham Act); McCarthy on Trademarks and Unfair Competition, at § 19:9, 19:11 (5th ed. 2018) (“Registration of a mark on the federal Principal Register confers a number of procedural and substantive legal advantages over reliance on common law rights. . . . Registration on the Principal Register should be attempted if it is at all possible.”)).

<sup>137</sup> Rebecca Tushnet, “The First Amendment Walks into a Bar: Trademark Registration and Free Speech,” 92 Notre Dame L. Rev. 381 (2016), at 395.

<sup>138</sup> *Id.* at 396-97.

scrutiny as its content-based bans.”<sup>139</sup> Hence, “[l]awmakers may no more silence unwanted speech by burdening its utterance than by censoring its content.”<sup>140</sup>

### III. ANALYSIS

#### A. THE DISPARAGING, IMMORAL & SCANDALOUS PROHIBITIONS OF SECTION 2 ARE CONTENT-BASED IN VIOLATION OF THE FIRST AMENDMENT

“Content-based laws—those that target speech based on its communicative content—are presumptively unconstitutional and may be justified only if the government proves that they are narrowly tailored to serve compelling state interests.”<sup>141</sup> As noted in *Police Department of Chicago v. Mosley*,<sup>142</sup> “the First Amendment means that the government has no power to restrict expression because of its message, its ideas, its subject matter, or its content.”<sup>143</sup> As the Federal Circuit noted, “Viewpoint-based regulations, targeting the substance of the viewpoint expressed, are even more suspect.”<sup>144</sup> Therefore, “[t]he First Amendment requires heightened scrutiny whenever the government creates ‘a regulation of speech because of disagreement with the message it conveys.’”<sup>145</sup>

The prohibition on registration of disparaging marks, as well as those with immoral or scandalous content, cannot be squared with the First Amendment. Thus, beyond the issue the Supreme Court addressed when it ruled in *Matal v. Tam*—whether the disparagement clause is contrary to the First Amendment—the restrictions on immoral and scandalous marks should be struck down for similar reasons. On this point, Professor Tushnet is correct—those restrictions cannot be distinguished from the disparagement provision.<sup>146</sup> As Professor Snow notes,<sup>147</sup> all of these prohibitions are long-standing, but they have not received serious analysis under modern U.S. free speech doctrines. When so analyzed, as noted above and as found by the Supreme Court, they violate the First Amendment.<sup>148</sup> The Federal Circuit has now reached that conclusion in *In*

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<sup>139</sup> 529 U.S. 803, 812 (2000).

<sup>140</sup> *Sorrell*, 131 S.Ct. at 2664; see also *Rosenberger*, 515 U.S. at 828 (“[T]he government offends the First Amendment when it imposes financial burdens on certain speakers based on the content of their expression.”).

<sup>141</sup> *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2226 (2015) (citing *R.A.V. v. City of St. Paul*, 505 U.S. 377, 382 (1992)).

<sup>142</sup> 408 U.S. 92, 95 (1972).

<sup>143</sup> *Id.*

<sup>144</sup> *In re Tam*, 808 F.3d at 1334-35.

<sup>145</sup> *Sorrell v. IMS Health Inc.*, 131 S. Ct. 2653, 2664 (2011) (quoting *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989)).

<sup>146</sup> See Latham Act § 2, 15 U.S.C. §1052 (2012).

<sup>147</sup> See *Snow*, *supra* note 128.

<sup>148</sup> *Id.*



*re Brunetti*.<sup>149</sup> Brunetti appealed from a decision by the Trademark Trial and Appeal Board affirming an examiner's refusal to register the mark "FUCT" on grounds that it was immoral or scandalous under the Lanham Act.<sup>150</sup> The court found that the mark was immoral or scandalous, but held that the prohibition on registering immoral or scandalous marks violated the First Amendment in light of *Matal v. Tam*.<sup>151</sup>

Most importantly, for purposes of any possible revision of trademark law to comport with First Amendment principles, the *Brunetti* court rejected the argument that it could narrowly construe the statute to prohibit only obscene marks: "It is not reasonable to construe the words immoral and scandalous as confined to obscene material. There is no dispute that an obscene mark would be scandalous or immoral; however, not all scandalous or immoral marks are obscene. All apples are fruit, but not all fruits are apples."<sup>152</sup> It seems the court is again correct that a narrowing construction is not plausible in light of the language and prior case law interpreting this prohibition.<sup>153</sup> Thus, the court concluded that it "cannot stand in the shoes of the legislature and rewrite a statute."<sup>154</sup> Such a rewriting would, it seems, need to be the result of congressional action, as discussed below.

As this article goes to press, the Supreme Court has granted certiorari and will review the *Brunetti* decision. Based on the analysis above, the Court should affirm the Federal Circuit, as its ruling in *Brunetti* is entirely consistent with the Court's decision in *Tam*. A discussion of an alternative ground for affirming — based upon a claim that the scandalous or immoral prohibition is unconstitutionally vague, is beyond the scope of this article.<sup>155</sup>

Another area of constitutional infirmity is the Lanham Act prohibition on registration of marks that "may disparage or falsely suggest a connection with ... beliefs, or national symbols, or bring them into contempt, or disrepute ...."<sup>156</sup> To the extent this provision seems to preclude the registration of marks based on their viewpoint — disparaging a belief or a national symbol — it would be flawed under the First Amendment. A comparison can be drawn to the well-known flag-burning case, *Texas v. Johnson*.<sup>157</sup> In that case, the Supreme Court

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<sup>149</sup> *In re Brunetti*, 877 F.3d 1330 (Fed. Cir. 2017).

<sup>150</sup> 15 U.S.C. § 1052(a).

<sup>151</sup> *In re Brunetti*, 877 F.3d 1330, 1355 (Fed. Cir. 2017).

<sup>152</sup> *Id.* at 1355-56.

<sup>153</sup> *Id.* at 1356.

<sup>154</sup> *Id.* at 1357.

<sup>155</sup> See 2019 Westlaw 98541 (January 4, 2019).

<sup>156</sup> 15 U.S.C. 1052(a) (2018).

<sup>157</sup> 491 U.S. 397 (1989).

held that laws prohibiting flag burning do not pass muster under the First Amendment.<sup>158</sup>

As noted above, some commentators have predicted that a broad First Amendment ruling would undermine nearly all of trademark law's limitations on registration.<sup>159</sup> On the contrary, the other prohibitions found in the Lanham Act, such as those which preclude deceptive marks, confusingly similar marks, personal names, governmental insignia, and functional marks, can be defended based upon traditional trademark principles that are consistent with a robust First Amendment.

Deceptive and confusingly similar marks can still be barred, as restrictions on registration of deceptive speech that do not violate the First Amendment.<sup>160</sup> The same conclusion is likely to hold as to matter that falsely suggests an association with national symbols.

Justice Kennedy's concurrence addressed some of the implications of *Tam*. As he noted, "to the extent a trademark is confusing or misleading the law can protect consumers and trademark owners."<sup>161</sup> Consumer protection laws more generally are also lawful, so long as they do not involve viewpoint discrimination.<sup>162</sup> These laws clearly serve a consumer protection function and do not discriminate based on viewpoint.

The prohibition on registration of governmental insignia precludes a mark that "[c]onsists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof."<sup>163</sup> This prohibition might initially seem to pose First Amendment concern. The most relevant prior case on this point is *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, in which the Supreme Court held that an athletic association does not have a First Amendment right to use the word "Olympic" to promote athletic events in light of the United States Olympic Committee's property right in the exclusive use of the word

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<sup>158</sup> *Id.*

<sup>159</sup> See Snow, *supra* note 128.

<sup>160</sup> *In re Tam*, 808 F.3d 1321, 1329 (Fed. Cir. 2016) (*en banc*); see *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 563 (1980) ("The government may ban forms of communication more likely to deceive the public than to inform it."); see also *Friedman v. Rogers*, 440 U.S. 1, 13, 15–16 (1979); *Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447, 462–63 (1978).

<sup>161</sup> *Tam*, 137 S. Ct. at 1768 (Kennedy, J., concurring) (citing *FTC v. Winsted Hosiery Co.*, 258 U.S. 483, 493 (1922) ("The labels in question are literally false, and . . . palpably so. All are, as the Commission found, calculated to deceive and do in fact deceive a substantial portion of the purchasing public").

<sup>162</sup> See *Tam*, 137 S. Ct. at 1768 (Kennedy, J., concurring) ("This case also does not involve laws related to product labeling or otherwise designed to protect consumers.") (citing *Sorrell*, *supra*, at 579, 131 S. Ct. 2653).

<sup>163</sup> 15 U.S.C. § 1052(b).

“Olympic.”<sup>164</sup> The Court rejected the claim despite the expressive, as opposed to a purely commercial, purpose in using the word “Olympic” by the sponsors of what was then called the “Gay Olympics.”<sup>165</sup> Applying the reasoning of this case to the broad prohibition on registration of governmental insignia, it could be argued that allowing registration of such marks would create a likelihood of confusion or association with the relevant governmental entity. Under this rationale, this prohibition is likely to withstand scrutiny.

Similarly, a prohibition on registering marks that adopts the name of a person can be squared with the First Amendment. In *Zacchini v. Scripps-Howard Broadcasting Co.*, the Supreme Court held that a right of publicity claim involving appropriation of a “human cannonball” act was not barred by The First Amendment.<sup>166</sup> This ruling would suggest that the general right of a person to prevent appropriation of their name or other identifiers for commercial/trademark purposes would be upheld against a First Amendment challenge. The Lanham Act provision, which prohibits registration of a mark that “may disparage or falsely suggest a connection with persons, living or dead” is broad, but arguably permissible as a way to protect the right of publicity and reputation of individuals.<sup>167</sup>

Functional aspects of a product do not fall within the ambit of speech, and thus are not subject to First Amendment scrutiny because in essence they do not involve speech at all. Further, the Lanham Act’s prohibition on the use of governmental insignia can be squared with the First Amendment in light of *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*,<sup>168</sup> as discussed above.

In short, contrary to the view of some commentators, most of the reasonable restrictions on registration found in trademark law would remain in place after the First Amendment analysis proposed here. What the Supreme Court has effectively struck down are the Victorian prohibitions found in section 2(a) of the Lanham Act. These provisions could be revised in a manner that would be consistent with the First Amendment. Specifically, the Lanham Act could preclude the registration of marks that are deemed to be obscene under traditional First Amendment analysis.

With regard to obscenity, *Miller v. California* stated: “This much has been categorically settled by the Court, that obscene material is unprotected by the

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<sup>164</sup> 483 U.S. 522 (1987).

<sup>165</sup> *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, 483 U.S. 522, 525(1987).

<sup>166</sup> 433 U.S. 562 (1977).

<sup>167</sup> 15 U.S.C. 1052(a) (2017).

<sup>168</sup> 483 U.S. 522 (1987).

First Amendment.”<sup>169</sup> The regulation of obscenity is limited, however, to “works which depict or describe sexual conduct. That conduct must be specifically defined by the applicable state law, as written or authoritatively construed.”<sup>170</sup> More specifically, obscenity involves only “works which, taken as a whole, appeal to the prurient interest in sex, which portray sexual conduct in a patently offensive way, and which, taken as a whole, do not have serious literary, artistic, political, or scientific value.”<sup>171</sup> The *Miller* Court proceeded to establish its now traditional three-part test:

(a) whether ‘the average person, applying contemporary community standards’ would find that the work, taken as a whole, appeals to the prurient interest, (b) whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law; and (c) whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value.<sup>172</sup>

Applying the traditional test found in *Miller v. California* to trademark law, it would be permissible for the Lanham Act to be amended to prohibit obscene marks as defined above. The language can be drawn from the *Miller* test itself.

Similarly, in the line of cases based on *New York Times Co. v. Sullivan*,<sup>173</sup> and its progeny, the Court addressed circumstances in which defamatory content can be penalized. There is a complex array of rules in this line of cases, which distinguish between types of targets of defamation (public officials and public figures versus private individuals),<sup>174</sup> types of subject matter (matters of public concern versus matters that are not of public concern),<sup>175</sup> and levels of fault (actual malice, negligence, or strict liability).<sup>176</sup>

The complex constitutional rules governing defamation would make fashioning a rule precluding the registration of defamatory trademarks rather difficult. The framework could be established by a series of court decisions construing these disparagement prohibitions using a set of rules fashioned from the *New York Times v. Sullivan* line of cases. A central point is that group libel is not actionable, and thus the Lanham Act could not simply adopt a prohibition

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<sup>169</sup> *Miller v. California*, 413 U.S. 15, 23 (1973).

<sup>170</sup> *Id.* at 24.

<sup>171</sup> *Id.*

<sup>172</sup> *Id.* (citations omitted).

<sup>173</sup> *See New York Times Co. v. Sullivan*, 376 U.S. 254 (1964).

<sup>174</sup> *See Gertz v. Robert Welch, Inc.*, 418 U.S. 323 (1974); *Milkovich v. Lorain Journal Co.*, 497 U.S. 1(1990).

<sup>175</sup> *See Dun & Bradstreet, Inc. v. Greenmoss Builders, Inc.*, 472 U.S. 749(1985).

<sup>176</sup> *See Gertz v. Robert Welch, Inc.*, 418 U.S. 323 (1974); *Masson v. New Yorker Magazine, Inc.*, 501 U.S. 496 (1991).

on registering marks that defame a group (such as an ethnic group), as opposed to a single or small number of individuals.

Finally, fighting words and incitement are forms of speech that can be constitutionally penalized under First Amendment jurisprudence. This principle can be found in cases such as *R.A.V. v. City of St. Paul, Minn.*,<sup>177</sup> *Chaplinsky v. State of New Hampshire*,<sup>178</sup> and *Brandenburg v. Ohio*.<sup>179</sup> It seems unlikely, however, that a trademark could pose the imminent threat of harm necessary in order to be deemed constitutionally unprotected.

Another important area of concern involves the issue of whether *Matal v. Tam* might undermine the scope of trademark protection for “famous” marks under the Federal Trademark Dilution Act (“FTDA”).<sup>180</sup> Relevant statutory provisions state that “the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner’s mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.”<sup>181</sup> The statute essentially provides for two types of claims – dilution by blurring and by tarnishment. The blurring claims are likely to survive scrutiny based on the reasoning of *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*,<sup>182</sup> as discussed above in the context of trademark protection for governmental insignia and for the “Olympics” mark. Once a mark has attained sufficient fame to be protected under the dilution statute, it is entitled to protection from other commercial uses that would blur its distinctiveness. The tarnishment claim is probably most analogous to the defamation analysis discussed above, and some potential might exist for a First Amendment challenge in that context. It is probably only in this area that the ability to bring a dilution claim might be affected by the constitutional analysis of *Matal v. Tam*. At the same time, if famous marks can constitutionally be given protection against confusingly similar uses and uses that cause dilution of their distinctiveness, then commercial uses that might tarnish the trademark would seem to also be precluded. As an example, if Exxon is protected from trademark infringement if a competing oil company used a similar name and from dilution if the Exxon mark was used to sell pianos, then it would seem to also follow that Exxon could prevent its mark from being used to sell sex toys or pornography.

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<sup>177</sup> 505 U.S. 377, 408 (1992).

<sup>178</sup> 315 U.S. 568, 769 (1942).

<sup>179</sup> 395 U.S. 444, 449 (1969).

<sup>180</sup> Lanham Trade-Mark Act, §§ 43(c)(1), 45, 15 U.S.C. §§ 1125(c)(1), 1127.

<sup>181</sup> 15 U.S.C. §1125(C) (2012).

<sup>182</sup> 107 S. Ct. 2971 (1987).

## B. POST-TAM COMMENTARY

In his article, entitled, “The Hybrid Trademark and Free Speech Right Forged from *Matal v. Tam*,” Timothy T. Hsieh addresses whether the ruling will lead to a flood of filings for offensive marks. His prediction is “that there will not be a substantial increase in offensive mark filings, due to goodwill concerns and common business sense. Additionally, the fact that the Disparagement Clause survived for nearly seventy years despite major First Amendment concerns suggests that issues with disparaging marks are relatively uncommon.”<sup>183</sup> In general, Hsieh is certainly correct that most trademark owners do not seek to use these types of marks to represent them in the marketplace. There are, however, a number of categories of parties that are likely to desire to register offensive or disparaging marks – (1) those who sell products of a sexual nature or other types of products for which an offensive term might be suitable; (2) those seeking to market a product for its shock value, such as a t-shirt with an offensive term on it; (3) those, like Mr. Tam, who seek to reclaim disparaging terms; and (4) those who seek affirmatively to give offense or disparage.<sup>184</sup> This last category of speakers were the natural targets of the Lanham Act’s prohibitions, but the *Tam* ruling clearly establishes that they cannot be singled out for censorship, however offensive their intentions might be.<sup>185</sup>

Moreover, it is likely that efforts to register offensive or disparaging marks were rare because applicants and their attorneys were well aware of the Lanham Act’s prohibitions on them. Thus, such efforts to register were probably often deterred by the likelihood that examiners would reject the marks, and that those decisions would be upheld on appeal.

One way in which to examine this prediction is to assess whether a meaningful number of trademark applications have been filed that might have been rejected in the past. The author of this article conducted a search of the US PTO website to see if there were any recent trademark applications that contained two of the famous George Carlin “seven dirty words” – shit and piss.<sup>186</sup> The Carlin monologue became famous in legal circles for leading to the Supreme Court decision in *Federal Communications Commission v. Pacifica Foundation*,<sup>187</sup> which held that the FCC had the power to regulate “indecent” material when it was transmitted on broadcast television. In fact, a number of

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<sup>183</sup> *Id.* at 19.

<sup>184</sup> In re Brunetti, 877 F.3d at 1349 (“trademarks—including immoral or scandalous trademarks—also ‘often have an expressive content.’ For immoral or scandalous marks, this message is often uncouth. But it can espouse a powerful cause.”) (quoting *Tam*, 137 S. Ct. at 1760).

<sup>185</sup> See *Matal*, 137 S.Ct. at 1760.

<sup>186</sup> George Carlin, *Seven Words You Can Never Say on Television*, Class Clown (Atlantic Records 1972).

<sup>187</sup> 438 U.S. 726 (1978).

trademarks have been filed since the ruling in *Tam*. For example, marks using these two of George Carlin's "seven dirty words" include:

I SMOKE CIGARS TO PISS YOU OFF, filed August 6, 2018

RUNS ON BALD EAGLE PISS AND FREEDOM, filed January 22, 2018

PISSPERFECT, filed August 22, 2017

PISS TEST, filed February 18, 2018

IT'S LIFE. . . SHIT HAPPENS, August 3, 2018

NO POOR SHIT, August 2, 2018

DO AWESOME SHIT, July 19, 2018

These marks and many other examples can be found on the USPTO website, [uspto.gov](http://uspto.gov). Although a comprehensive survey of these patterns is beyond the scope of this article, it does appear that trademark applicants are seeking to register marks that might previously have been questioned or challenged on grounds of disparagement, immorality, or scandalousness.

Mark Conrad, in his article, "*Matal v. Tam* — A Victory for the Slants, A Touchdown for the Redskins, But an Ambiguous Journey for the First Amendment and Trademark Law,"<sup>188</sup> notes that *Matal v. Tam* "ends the use of trademark law to bar speech that is offensive and disparaging. However, it did not close the book on the tension between government regulation of intellectual property and free speech, as it did not resolve a deeper doctrinal question of the *kind* of First Amendment protection accorded trademarks."<sup>189</sup> Conrad focuses on the fact that the two main opinions in the case (written by Justices Alito and Kennedy) do not address the underlying issue of whether the "commercial speech" doctrine applies to trademarks in some, none, or all circumstances. Conrad is correct that these opinions did not address this question, although it sufficiently established the core principle that the registration of trademarks — like most government action — cannot be based on the government's approval

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<sup>188</sup> Mark Conrad, *Matal v. Tam* — A Victory for the Slants, a Touchdown for the Redskins, but an Ambiguous Journey for the First Amendment and Trademark Law, 36 CARDOZO ARTS & ENT. L.J. 83, 147 (2018).

<sup>189</sup> *Id.* at 147 (emphasis in the original).

or disapproval of the viewpoint of the trademark holder.<sup>190</sup> This principle provides guidance in many types of cases in which trademarks might be analyzed.

Conrad suggests that courts should “create an inference of constitutional protection unless the mark is ‘strictly’ commercial.”<sup>191</sup> Under this approach, section 2(a)’s prohibitions could still be upheld in the case of purely commercial trademarks. The difficulty with this argument is that marks can readily be found to have at least some expressive element. Consider the four previously discussed categories of marks likely to be proposed for registration in light of *Matal v. Tam*: (1) those who sell products of a sexual nature or other types of products for which an offensive term might be suitable; (2) those seeking to market a product for its shock value, such as a t-shirt with an offensive term on it; (3) those, like Mr. Tam, who seek to reclaim disparaging terms; and (4) those who seek affirmatively to give offense or disparage.<sup>192</sup> The only category of mark that could arguably be deemed purely commercial would be the first group of marks, and yet even these contain some expressive element. The seller of a sexually-oriented product is likely to be able to establish that using a highly suggestive or offensive term was an expressive choice. Those seeking to register a mark for its shock value, to reclaim a disparaging term, or to give offense/disparage are clearly seeking to make an expressive use of their marks, thus placing them squarely within the logic and reasoning of *Matal v. Tam*.<sup>193</sup> In short, it will be a rare case indeed where a mark would be deemed purely commercial.

#### IV. CONCLUSION

This article contends that First Amendment principles do allow for most of the statutory limitations placed on trademark registration, but that the Lanham Act rules against immoral, scandalous, and disparaging marks are no longer enforceable and could be redrafted – in much narrower form—by Congress based on speech considerations. Under modern free speech doctrines, each of these three prohibitions were properly deemed unconstitutional under United States law. On the other hand, the prohibitions against registration of confusingly similar marks, deceptive marks, government insignia, personal names, and functional terms should survive First Amendment scrutiny. In addition, trademark owners should be able to continue to prevent commercial uses of marks based on principles of trademark infringement through a likelihood of confusion and based on dilution of famous marks through either blurring or

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<sup>190</sup> *Id.*

<sup>191</sup> *Id.* at 146.

<sup>192</sup> *In re Brunetti*, 877 F.3d at 1349 (“trademarks—including immoral or scandalous trademarks—also ‘often have an expressive content.’ For immoral or scandalous marks, this message is often uncouth. But it can espouse a powerful cause.”) (quoting *Tam*, 137 S. Ct. at 1760).

<sup>193</sup> *Id.*



tarnishment. Essentially, the overlay of First Amendment analysis can be applied in each of these areas. Contrary to the suggestion of some commentators, *Matal v. Tam* will not upend traditional trademark doctrines in these areas. It will, however, end the practice of governmental censorship of trademark registrations based on the perceived potential offense that the mark might cause and other similar morality-based objections. As the Supreme Court noted in *Matal*, “[s]peech may not be banned on the ground that it expresses ideas that offend.”<sup>194</sup>

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<sup>194</sup> *Matal*, 137 S. Ct. at 1751.