

**Trademark and Unfair Competition Law
Cases and Materials, Sixth Edition**

2017 Letter Update

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CHAPTER 4 REGISTRATION OF TRADEMARKS

C. Bars to Registration

1. Section 2(a) of the Lanham Act; Immoral, Scandalous, Disparaging or Deceptive Matter and False Suggestion of a Connection

a. Immoral, Scandalous or Disparaging Marks

Page 218. Insert the following case and Note after the Questions following *In re Fox*

MATAL v. TAM

122 U.S.P.Q.2d 1757 (S. Ct. 2017)

JUSTICE ALITO delivered the opinion of the Court with respect to Parts I, II, and III-A; and an opinion with respect to Parts III-B, III-C, and IV, in which The Chief Justice, Justice Thomas, and Justice Breyer join.

This case concerns a dance-rock band's application for federal trademark registration of the band's name, "The Slants." "Slants" is a derogatory term for persons of Asian descent, and members of the band are Asian-Americans. But the band members believe that by taking that slur as the name of their group, they will help to "reclaim" the term and drain its denigrating force.

The Patent and Trademark Office (PTO) denied the application based on a provision of federal law prohibiting the registration of trademarks that may "disparage . . . or bring . . . into contemp[t] or disrepute" any "persons, living or dead." 15 U.S.C. §1052(a). 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.

I
A

...

Under the Lanham Act, trademarks that are "used in commerce" ... may be federally registered. 15 U.S.C. §1051(a)(1).... There are now more than two million marks that have active federal certificates of registration. [Citation omitted.] This system of federal registration helps to ensure that trademarks are fully protected and supports the free flow of commerce. "[N]ational protection of trademarks is desirable," we have explained, "because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation." *San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 531 (1987) (internal quotation marks omitted); *see also Park 'N Fly, Inc., supra*, [469 U.S. 189,] at 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 and to protect the ability of consumers to distinguish among competing producers").

B

Without federal registration, a valid trademark may still be used in commerce. *See* 3 McCarthy §19:8. And an unregistered trademark can be enforced against would-be infringers in several ways. Most important, even if a trademark is not federally registered, it may still be enforceable under §43(a) of the Lanham Act, which creates a federal cause of action for trademark infringement. *See Two Pesos, supra*, [505 U.S. 763,] at 768 [(1992)] ("Section 43(a) prohibits a broader range of practices than does §32, which applies to registered

marks, but it is common ground that §43(a) protects qualifying unregistered trademarks" (internal quotation marks and citation omitted)).¹

Federal registration, however, "confers important legal rights and benefits on trademark owners who register their marks." *B&B Hardware*, 575 U. S., at ___, 135 S. Ct. 1293 (internal quotation marks omitted). Registration on the principal register (1) "serves as 'constructive notice of the registrant's claim of ownership' of the mark,"[citation]; (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,'" [citation]; 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. 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.

C

The Lanham Act contains provisions that bar certain trademarks from the principal register. For example, a trademark cannot be registered if it is "merely descriptive or deceptively misdescriptive" of goods, §1052(e)(1), or if it is so similar to an already registered trademark or trade name that it is "likely . . . to cause confusion, or to cause mistake, or to deceive," §1052(d).

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. *See* §2(a), 60 Stat. 427.

When deciding whether a trademark is disparaging, an examiner at the PTO generally applies a "two-part test." The examiner first considers "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." Trademark Manual of Examining Procedure §1203.03(b)(i) (Apr. 2017), p. 1200-150, <http://tmep.uspto.gov>. "If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols," the examiner moves to the second step, asking "whether that meaning may be disparaging to a substantial composite of the referenced group." *Ibid.* If the examiner finds that a "substantial composite, although not necessarily a majority, of the referenced group would find the proposed mark . . . to be disparaging in the context of contemporary attitudes," a prima facie case of disparagement is made out, and the burden shifts to the applicant to prove that the trademark is not disparaging. *Ibid.* What is more, the PTO has specified that "[t]he fact that an applicant may be a member of that group or has good intentions underlying its use of a term does not obviate the fact that a substantial composite of the referenced group would find the term objectionable." *Ibid.*

¹ In the opinion below, the Federal Circuit opined that although "Section 43(a) allows for a federal suit to protect an unregistered trademark," "it is not at all clear" that respondent could bring suit under §43(a) because "there is no authority extending §43(a) to marks denied under §2(a)'s disparagement provision." *In re Tam*, 808 F. 3d 1321, 1344-1345, n.11 (*en banc*), as corrected (Feb. 11, 2016). When drawing this conclusion, the Federal Circuit relied in part on our statement in *Two Pesos* that "the general principles qualifying a mark for registration under §2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under §43(a)." 505 U. S., at 768. We need not decide today whether respondent could bring suit under §43(a) if his application for federal registration had been lawfully denied under the disparagement clause.

D

Simon Tam ... chose ["The Slants"] moniker in order to "reclaim" and "take ownership" of stereotypes about people of Asian ethnicity.[Citation.] The group "draws inspiration for its lyrics from childhood slurs and mocking nursery rhymes" and has given its albums names such as "The Yellow Album" and "Slanted Eyes, Slanted Hearts." [Citation.]

Tam sought federal registration ..., but an examining attorney ..., applying the PTO's two-part framework, ... [found] that "there is . . . a substantial composite of persons who find the term in the applied-for mark offensive." The examining attorney relied in part on the fact that "numerous dictionaries define 'slants' or 'slant-eyes' as a derogatory or offensive term"...[and] that "the band's name has been found offensive numerous times"--citing a performance that was canceled because of the band's moniker and the fact that "several bloggers and commenters to articles on the band have indicated that they find the term and the applied-for mark offensive."

Tam ... [e]ventually ... took the case to federal court, where the en banc Federal Circuit ultimately found the disparagement clause facially unconstitutional under the First Amendment's Free Speech Clause. ...

...

The Government filed a petition for certiorari, which we granted in order to decide whether the disparagement clause "is facially invalid under the Free Speech Clause of the First Amendment." [Citation.]

II

.....

III

... [A]t the outset, we must consider three arguments that would either eliminate any First Amendment protection or result in highly permissive rational-basis review. Specifically, the Government contends (1) that trademarks are government speech, not 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. We address each of these arguments below. [*Editors' Note*: The discussion in the opinion rejecting arguments (2) and (3) in parts III B and C is omitted.]

A

The First Amendment prohibits Congress and other government entities and actors from "abridging the freedom of speech"; the First Amendment does not say that Congress and other government entities must abridge their own ability to speak freely. And our cases recognize that "[t]he Free Speech Clause . . . does not regulate government speech." *Pleasant Grove City v. Summum*, 555 U.S. 460, 467 (2009); see *Johanns v. Livestock Marketing Assn.*, 544 U.S. 550, 553 (2005) ("[T]he Government's own speech . . . is exempt from First Amendment scrutiny"); *Board of Regents of Univ. of Wis. System v. Southworth*, 529 U.S. 217, 235 (2000).

As we have said, "it is not easy to imagine how government could function" if it were subject to the restrictions that the First Amendment imposes on private speech. *Summum, supra*, at 468; see *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 576 U.S. ___, 135 S. Ct. 2239 (2015) (slip op., at 5-7). "[T]he First Amendment forbids the government to regulate speech in ways that favor some viewpoints or ideas at the expense of others," *Lamb's Chapel v. Center Moriches Union Free School Dist.*, 508 U.S. 384, 394 (1993), but imposing a requirement of viewpoint-neutrality on government speech would be paralyzing. 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.

...

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....

... The Federal Government does not dream up ... marks [it registers], and it does not edit marks submitted for registration. Except as required by the statute involved here, 15 U.S.C. §1052(a), an examiner may not reject a mark based on the viewpoint that it appears to express. Thus, unless that section is thought to apply, an examiner does not inquire whether any viewpoint conveyed by a mark is consistent with Government policy or whether any such viewpoint is consistent with that expressed by other marks already on the principal register. ... [I]f the mark meets the Lanham Act's viewpoint-neutral requirements, registration is mandatory. *Ibid.* (requiring that "[n]o trademark . . . shall be refused registration on the principal register on account of its nature unless" it falls within an enumerated statutory exception). ... [An examiner's decision to register] is not reviewed by any higher official unless the registration is challenged. [Citation.] Moreover, once a mark is registered, the PTO is not authorized to remove it from the register unless a party moves for cancellation, the registration expires, or the Federal Trade Commission initiates proceedings based on certain grounds. [Citation.]

... If the federal registration of a trademark makes the mark government speech, the Federal Government is babbling prodigiously and incoherently. It is saying many unseemly things. It is expressing contradictory views.⁹ It is unashamedly endorsing a vast array of commercial products and services. And it is providing Delphic advice to the consuming public.

For example, if trademarks represent government speech, what does the Government have in mind when it advises Americans to "make.believe" (Sony), "Think different" (Apple), "Just do it" (Nike), or "Have it your way" (Burger King)? Was the Government warning about a coming disaster when it registered the mark "EndTime Ministries"?

The PTO has made it clear that registration does not constitute approval of a mark. *See In re Old Glory Condom Corp.*, 26 USPQ 2d 1216, 1220, n. 3 (TTAB 1993) ("[I]ssuance of a trademark registration . . . is not a government imprimatur"). And it is unlikely that more than a tiny fraction of the public has any idea what federal registration of a trademark means. [Citation.]

None of our government speech cases even remotely supports the idea that registered trademarks are government speech. In *Johanns*, we considered advertisements promoting the sale of beef products. A federal statute called for the creation of a program of paid advertising "to advance the image and desirability of beef and beef products." 544 U. S., at 561 (*quoting* 7 U.S.C. § 2902(13)). Congress and the Secretary of Agriculture provided guidelines for the content of the ads, Department of Agriculture officials attended the meetings at which the content of specific ads was discussed, and the Secretary could edit or reject any proposed ad. 544 U. S., at 561. Noting that "[t]he message set out in the beef promotions [was] from beginning to end the message established by the Federal Government," we held that the ads were government speech. *Id.*, at 560. The Government's involvement in the creation of these beef ads bears no resemblance to anything that occurs when a trademark is registered.

Our decision in *Summum* is similarly far afield. A small city park contained 15 monuments. [Citation.] Eleven had been donated by private groups, and one of these displayed the Ten Commandments. [Citation.]

⁹ Compare "Abolish Abortion," Registration No. 4,935,774 (Apr. 12, 2016), with "I Stand With Planned Parenthood," Registration No. 5,073,573 (Nov. 1, 2016); compare "Capitalism Is Not Moral, Not Fair, Not Freedom," Registration No. 4,696,419 (Mar. 3, 2015), with "Capitalism Ensuring Innovation," Registration No. 3,966,092 (May 24, 2011); compare "Global Warming Is Good," Registration No. 4,776,235 (July 21, 2015), with "A Solution to Global Warming," Registration No. 3,875,271 (Nov. 10, 2010).

A religious group claimed that the city, by accepting donated monuments, had created a limited public forum for private speech and was therefore obligated to place in the park a monument expressing the group's religious beliefs.

Holding that the monuments in the park represented government speech, we cited many factors. Governments have used monuments to speak to the public since ancient times; parks have traditionally been selective in accepting and displaying donated monuments; parks would be overrun if they were obligated to accept all monuments offered by private groups; "[p]ublic parks are often closely identified in the public mind with the government unit that owns the land"; and "[t]he monuments that are accepted . . . are meant to convey and have the effect of conveying a government message." [Citation.]

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.

... [T]he case on which the Government relies most heavily, *Walker*, ... likely marks the outer bounds of the government-speech doctrine. Holding that the messages on Texas specialty license plates are government speech, the *Walker* Court cited three factors distilled from *Summum*. [Citation.] First, license plates have long been used by the States to convey state messages. [Citation.] Second, license plates "are often closely identified in the public mind" with the State, since they are manufactured and owned by the State, generally designed by the State, and serve as a form of "government ID." [Citation.] Third, Texas "maintain[ed] direct control over the messages conveyed on its specialty plates." [Citation.] As explained above, none of these factors are present in this case.

In sum, the federal 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. For if the registration of trademarks constituted government speech, other systems of government registration could easily be characterized in the same way.

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? [Citation.]

The Government attempts to distinguish copyright on the ground that it is "the engine of free expression," but as this case illustrates, trademarks often have an expressive content. Companies spend huge amounts to create and publicize trademarks that convey a message. It is true that the necessary brevity of trademarks limits what they can say. But powerful messages can sometimes be conveyed in just a few words.

Trademarks are private, not government, speech.

...

IV

Having concluded that the disparagement clause cannot be sustained under our government-speech or subsidy cases or under the Government's proposed "government-program" doctrine, we must confront a dispute ... on the question whether trademarks are commercial speech and are thus subject to the relaxed scrutiny outlined in *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n of Central Hudson Gas & Electric Corp.*, 447 U.S. 557 (1980). The Government and *amici* supporting its position argue that all trademarks are commercial speech. They note that the central purposes of trademarks are commercial and that federal law regulates trademarks to promote fair and orderly interstate commerce. Tam and his *amici*, on

the other hand, contend that many, if not all, trademarks have an expressive component. In other words, these trademarks do not simply identify the source of a product or service but go on to say something more, either about the product or service or some broader issue. The trademark in this case illustrates this point. The name "The Slants" not only identifies the band but expresses a view about social issues.

We need not resolve this debate ... because the disparagement clause cannot withstand even *Central Hudson* review.¹⁷ Under *Central Hudson*, a restriction of speech must serve "a substantial interest," and it must be "narrowly drawn." [Citation.] This means ... that "[t]he regulatory technique may extend only as far as the interest it serves." [Citation.] The disparagement clause fails this requirement.

It is claimed that the disparagement clause serves two interests. ... [T]he Government asserts an interest in preventing "underrepresented groups" from being "bombarded with demeaning messages in commercial advertising. [Citation.]... [I]ts unmistakable thrust is this: The Government has an interest in preventing speech expressing ideas that offend. ... [T]hat idea strikes at the heart of the First Amendment. 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." *United States v. Schwimmer*, 279 U.S. 644, 655 (1929) (Holmes, J., dissenting).

The second interest asserted is protecting the orderly flow of commerce. [Citations.] Commerce, we are told, is disrupted by trademarks that "involv[e] disparagement of race, gender, ethnicity, national origin, religion, sexual orientation, and similar demographic classification." [Citation.] Such trademarks are analogized to discriminatory conduct, which has been recognized to have an adverse effect on commerce. [Citations.]

A simple answer ... is that the disparagement clause is not "narrowly drawn" to drive out trademarks that support invidious discrimination. The clause reaches any trademark that disparages *any person, group, or institution*. It applies to trademarks like the following: "Down with racists," "Down with sexists," "Down with homophobes." It is not an anti-discrimination clause; it is a happy-talk clause. In this way, it goes much further than is necessary to serve the interest asserted.

The clause is far too broad in other ways as well. The clause protects every person living or dead as well as every institution. Is it conceivable that commerce would be disrupted by a trademark saying: "James Buchanan was a disastrous president" or "Slavery is an evil institution"?

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

For these reasons, we hold that the disparagement clause violates the Free Speech Clause of the First Amendment. The judgment of the Federal Circuit is affirmed.

It is so ordered.

Justice Gorsuch took no part in the consideration or decision of this case.

JUSTICE KENNEDY, with whom Justice Ginsburg, Justice Sotomayor, and Justice Kagan join, concurring in part and concurring in the judgment.

...

¹⁷ . . . [W]e leave open the question whether *Central Hudson* provides the appropriate test for deciding free speech challenges to provisions of the Lanham Act. And nothing in our decision should be read to speak to the validity of state unfair competition provisions or product libel laws that are not before us and differ from §1052(d)'s disparagement clause.

As the Court is correct to hold, §1052(a) constitutes viewpoint discrimination--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.

The Court is correct in its judgment, and I join Parts I, II, and III-A of its opinion. This separate writing explains in greater detail why the First Amendment's protections against viewpoint discrimination apply to the trademark here. It submits further that the viewpoint discrimination rationale renders unnecessary any extended treatment of other questions raised by the parties.

I

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. [Citation.] Aside from these and a few other narrow exceptions, it is a fundamental principle of the First Amendment that the government may not punish or suppress speech based on disapproval of the ideas or perspectives the speech conveys. [Citation.]

The First Amendment guards against laws "targeted at specific subject matter," a form of speech suppression known as content based discrimination. [Citation.] This category includes a subtype of laws that go further, aimed at the suppression of "particular views . . . on a subject." [Citation.] A law found to discriminate based on viewpoint is an "egregious form of content discrimination," which is "presumptively unconstitutional." *Rosenberger [v. Rector and Visitors of Univ. of Va.]*, [515 U.S. 819] at 829-830 [1995)].

...[T]he test ... is whether--within the relevant subject category--the government has singled out a subset of messages for disfavor based on the views expressed. [Citation.] In the instant case, the disparagement clause ... identifies the relevant subject as "persons, living or dead, institutions, beliefs, or national symbols." 15 U.S.C. §1052(a). Within that category, an applicant may register a positive or benign mark but not a derogatory one. The law thus reflects the Government's disapproval of a subset of messages it finds offensive. This is the essence of viewpoint discrimination.

The Government ... argues ... that the law is viewpoint neutral because it applies in equal measure to any trademark that demeans or offends. This misses the point. A subject that is first defined by content and then regulated or censored by mandating only one sort of comment is not viewpoint neutral. To prohibit all sides from criticizing their opponents makes a law more viewpoint based, not less so. [Citation.] By mandating positivity, the law here might silence dissent and distort the marketplace of ideas.

The Government next suggests that the statute is viewpoint neutral because the disparagement clause applies to trademarks regardless of the applicant's personal views or reasons for using the mark. Instead, registration is denied based on the expected reaction of the applicant's audience. ...

The Government may not insulate a law ... by tying censorship to the reaction of the speaker's audience. ... The danger of viewpoint discrimination is that the government is attempting to remove certain ideas or perspectives from a broader debate. That danger is all the greater if the ideas or perspectives are ones a particular audience might think offensive, at least at first hearing. An initial reaction may prompt further reflection, leading to a more reasoned, more tolerant position.

Indeed, a speech burden based on audience reactions is simply government hostility and intervention in a different guise. The speech is targeted ... based on the government's disapproval of the speaker's choice of message. And it is the government itself that is attempting in this case to decide whether the relevant audience would find the speech offensive. For reasons like these, the Court's cases have long prohibited the government from justifying a First Amendment burden by pointing to the offensiveness of the speech to be suppressed. [Citation.]

...

II

The parties dispute whether trademarks are commercial speech ... The ... issue may turn on whether certain commercial concerns for the protection of trademarks might, as a general matter, be the basis for regulation. However that issue is resolved, the viewpoint based discrimination at issue here necessarily invokes heightened scrutiny.

"Commercial speech is no exception,"... to the principle that the First Amendment "requires heightened scrutiny whenever the government creates a regulation of speech because of disagreement with the message it conveys." *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566 (2011) (internal quotation marks omitted). Unlike content based discrimination, discrimination based on viewpoint, including a regulation that targets speech for its offensiveness, remains of serious concern in the commercial context. *See Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60, 65, 71-72 (1983).

... In the realm of trademarks, the metaphorical marketplace of ideas becomes a tangible, powerful reality.... [M]arks 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. To permit viewpoint discrimination in this context is to permit Government censorship.

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. *See, e.g., 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"). This case also does not involve laws related to product labeling or otherwise designed to protect consumers. *See Sorrell, supra*, at 579 ("[T]he government's legitimate interest in protecting consumers from commercial harms explains why commercial speech can be subject to greater governmental regulation than noncommercial speech" (internal quotation marks omitted)). These considerations, however, do not alter the speech principles that bar the viewpoint discrimination embodied in the statutory provision at issue here.

[T]he Court's precedents have recognized just one narrow situation in which viewpoint discrimination is permissible: where the government itself is speaking or recruiting others to communicate a message on its behalf. [Citations.] The exception is necessary to allow the government to stake out positions and pursue policies. [Citation.] But it is also narrow, to prevent the government from claiming that every government program is exempt from the First Amendment. ...

... The central purpose of trademark registration is to facilitate source identification. To serve that broad purpose, the Government has provided the benefits of federal registration to millions of marks identifying every type of product and cause. Registered trademarks do so by means of a wide diversity of words, symbols, and messages. Whether a mark is disparaging bears no plausible relation to that goal. ... [O]ur cases are clear that viewpoint discrimination is not permitted where, as here, the Government "expends funds to encourage a diversity of views from private speakers," *Velazquez, supra*, at 542, 121 S. Ct. 1043 (internal quotation marks omitted).

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.

For these reasons, I join the Court's opinion in part and concur in the judgment.

JUSTICE THOMAS, CONCURRING IN PART AND CONCURRING IN THE JUDGMENT.

I join the opinion of Justice Alito, except for Part II. Respondent failed to present his statutory argument either to the Patent and Trademark Office or to the Court of Appeals, and we declined respondent's invitation to grant certiorari on this question.

I also write separately because "I continue to believe that when the government seeks to restrict truthful speech in order to suppress the ideas it conveys, strict scrutiny is appropriate, whether or not the speech in question may be characterized as 'commercial.'" [Citations.]

Note: Implications of Matal v. Tam?

The Supreme Court's decision clearly finds that the disparagement clause of Section 2(a) violates the First Amendment's protection of free speech. All eight Justices who participated in the decision (Justice Gorsuch did not participate) agreed with that result, albeit via different paths. The decision thus had an immediate impact on the long-running battle between Native American groups and Pro Football, Inc., owner of REDSKINS registrations covering the Washington Redskins' football services and related merchandise. The more recent attempt to cancel the REDSKINS registrations as disparaging to Native Americans was successful, both at the TTAB and at the district court levels, the latter of which upheld the constitutionality of the clause. *See Blackhorse v. Pro-Football, Inc.*, 112 F. Supp. 3d 439 (E.D. Va. 2015) (excerpted at page 219 of the casebook). On appeal, the Fourth Circuit stayed decision pending the Supreme Court's decision in *Tam*. After the decision, both the Native American challengers and the Department of Justice have admitted defeat in light of *Tam* in letters addressed to the Fourth Circuit.

The decision also had an immediate impact on USPTO practice. While the Supreme Court was considering the case, the USPTO suspended all applications in which a disparaging refusal had issued. After *Tam*, in Examination Guide 1-17, the USPTO states that disparagement is no longer a valid ground to deny registration and that:

Applications that received an advisory refusal under the disparagement provision and were suspended ... will be removed from suspension and examined for any other requirements or refusals. If an application was previously abandoned after being refused registration under the disparagement provision, and is beyond the deadline for filing a petition to revive, a new application may be filed.

<https://cdn2.hubspot.net/hubfs/454850/Exam%20guide%2001-17-1.pdf>.

What is less clear is the impact the decision will have on other provisions in the Lanham Act. Although all the Justices found that the disparagement clause violates the First Amendment and that trademarks do not come within the government speech exception, they did not agree whether strict scrutiny or intermediate scrutiny should apply. Justice Alito's opinion in Part IV, joined by three other Justices, finds that it does not matter because the disparagement clause fails both tests. Justice Kennedy's concurring opinion, also joined by three other Justices, contends that a rigorous level of scrutiny is warranted whether or not trademarks are categorized as commercial speech because the disparagement provision engages in viewpoint discrimination. Justice Thomas, although joining all parts of Justice Alito's opinion except for Part II, separately states that strict scrutiny is warranted "when the government seeks to restrict truthful speech in order to suppress the ideas it conveys ... whether or not the speech in question may be characterized as 'commercial'". Does this mean he agrees with Justice Kennedy's determination that rigorous scrutiny applies even though Justice Thomas joined Part IV of Justice Alito's opinion? Why or why not?

The most vulnerable provision to an attack after *Tam* is the immoral and scandalous prong of Section 2(a) applied by the Federal Circuit in barring the COCK SUCKER and Rooster design mark from registration. *In re Fox, supra*. The test applied there requires establishing that a mark is "vulgar," "shocking

to the conscience” or “offensive” in connection with the applied-for goods “in the context of contemporary attitudes” “from the standpoint of not necessarily a majority, but a substantial composite of the general public.” How do you think that case would come out now? If Marsha Fox re-applied for this mark, would it be registered? This question is likely to be answered soon as the Federal Circuit has an appeal from the Board’s decision that FUCTION for apparel is scandalous and immoral. *In re Brunetti*, 2014 TTAB LEXIS 328 (T.T.A.B. 2014). The Federal Circuit has requested additional briefs from the parties in light of *Tam*. *In re Brunetti*, No. 2015-1109 (Fed. Cir. June 20, 2017). How should the court rule? What if a mark rises to the level of obscenity? Would the provision be facially invalid in that case?

Prior to the Supreme Court’s decision in *Tam*, Professor Rebecca Tushnet contended that section 2(a) is generally constitutional as set forth below:

I conclude that §2(a) is generally constitutional as a government determination about what speech it is willing to approve, if not endorse. If the Supreme Court disagrees, it will face a difficult job distinguishing other aspects of trademark law. And these difficulties signal a greater problem: the Court has lost touch with the reasons that some content-based distinctions might deserve special scrutiny. Often, perfectly sensible and by no means censorious regulations that depend on identifying the semantic content of speech would fall afoul of a real application of heightened scrutiny, to no good end.

Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Regulation and Free Speech*, 92 Notre Dame L. Rev. 381 (2016).

Now that *Tam* has declared the disparagement prong unconstitutional, consider the constitutionality of other bars to registration when encountering them later in this Chapter. For example, section 2(c) prohibits registration of “a name, portrait or signature identifying a particular living individual [without consent]” or of “a deceased president of the United States, during the life of his widow [without consent of the widow]”. Does this provision suppress expressive speech? What if the individuals are public figures? If Nancy Reagan were still alive, could someone be barred from registering RONALD REAGAN SUCKS for baby bottles? Would this now pass constitutional muster?

Also consider in later chapters whether any statutory provisions present constitutional issues. For example, the tarnishment and blurring prongs of dilution considered in Chapter 9 protect famous marks even without a finding of likelihood of confusion. If, for instance, CHARBUCKS for coffee were found to dilute the STARBUCKS mark either because it tarnishes or blurs the distinctiveness of that mark, should that raise a constitutional issue? *Cf. Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, *infra*, Chapter 9.B. Was Professor Tushnet correct to raise concerns about “a real application of heightened scrutiny, to no good end”?

Page 218—231, Delete *Harjo Note, Blackhorse v. Pro-Football, Inc.*, Questions following *Blackhorse*, Federal Circuit decision *In re Tam* and Questions following *In re Tam*.

CHAPTER 5 LOSS OF TRADEMARK RIGHTS

A. Genericism

Page 304. *Elliott v. Google, Inc.* was affirmed. 856 F.3d 1225 (9th Cir. 2017).

CHAPTER 8 DEFENSES TO INFRINGEMENT

C. Other Limitations on Trademark Protection: Expressive Use

Page 672. *Gerlich v. Leath* was affirmed. 2017 U.S. App. LEXIS 10455 (8th Cir. June 17th, 2017).