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Constitutional Law - Sticks & Stones May Break my Bones, but the First Amendment Will Protect Me: Federal Court of Appeals Upholds Unconstitutionality of the Lanham Trade-Mark Act's Sec. 2(a) Disparaging Provision as a Violation of First Amendment Rights - in *Re Tam*, 808 F.3D 1321 (Fed. Cir. 2015)

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**CONSTITUTIONAL LAW—STICKS & STONES
MAY BREAK MY BONES, BUT THE FIRST
AMENDMENT WILL PROTECT ME: FEDERAL
COURT OF APPEALS UPHOLDS
UNCONSTITUTIONALITY OF THE LANHAM
TRADE-MARK ACT’S § 2(A) DISPARAGING
PROVISION AS A VIOLATION OF FIRST
AMENDMENT RIGHTS.—*IN RE TAM*, 808 F.3D
1321 (FED. CIR. 2015).**

The First Amendment of the United States Constitution was designed to protect an individual’s right of speech.¹ This right, along with other public rights, faces a heightened analysis when confronted with other government regulations.² The Lanham Act (“The Act”), in particular, was designed to protect consumers against piracy and unfair competition; and, section 2(a) of The Act adds to this protection because it prohibits registering any mark that “[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with . . . beliefs or bring them into contempt or disrepute.”³ These latter restrictions cannot be justified on the basis that they further The Act’s initial intent to protect consumers from being deceived.⁴ The United States Court of Appeals confronted this analysis in *In re Tam* and affirmed that the First Amendment protects the speech of trademark applicants even when that speech is likely to offend others.⁵ However, there are many implications that flow from this controversial and convoluted decision that remain open as a

¹ U.S. CONST. amend I. The First Amendment of the United States Constitution states in full: “Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances.” *Id.*

² See *B & B Hardware, Inc. v. Hargis Indus.*, 135 S. Ct. 1293, 1317-18 (2015) (addressing government regulations referring to The Act).

³ See The Lanham Trademark Act of 1946, § 2 (current version at 15 U.S.C. § 1051) (outlining, *inter alia*, “[t]rademarks registrable on principal register”).

⁴ See *In re Mavety Media Group, Ltd.*, 33 F.3d 1367, 1373-74 (Fed. Cir. 1994) (prohibiting mark due to its scandalous and improper imagery did not confuse consumers).

⁵ See *In re Tam*, 808 F.3d 1321, 1327 (Fed. Cir. 2015), *as corrected* (Feb. 11, 2016), *cert. granted sub nom. Lee v. Tam* 137 S. Ct. 30 (2016) (addressing constitutional validity of section 2(a) disparaging provision).

result from this recent decision, which will be discussed in this case comment.

On November 14, 2011, Simon Tam (“Mr. Tam”), the front-man for *The Slants*, an all-Asian American dance-rock band, filed an application with the Patent and Trademark Office (“PTO”) seeking to register the band name.⁶ Upon review, the examiner determined *The Slants* could not be a registered trademark because it was disparaging pursuant to section 2(a) of The Act.⁷ The Trademark Trial and Appeal Board (“TTAB”) affirmed the examiner’s refusal to register the mark.⁸ Mr. Tam appealed the decision, arguing that the TTAB erred in finding the mark disparaging and, therefore, was not protected under The Act; a federal court panel, however, appealed the TTAB’s decision.⁹

After the TTAB’s decision, Mr. Tam then went on to appeal the decision, stating that section 2(a) of The Act is unconstitutional because it violates the First Amendment on its face; but binding precedent determined

⁶ See *id.* at 1331 (identifying party seeking PTO registration). Mr. Tam sought registration for “[e]ntertainment in the nature of live performances by a musical band.” *Id.* at 1331 n.2. Mr. Tam chose to register the mark desiring to “reappropriate the disparaging term,” but the PTO examiner still denied its registration stating that the term is nevertheless offensive. *Id.* at 1331-32.

⁷ See *infra* note 18 (describing unapproved marks under 15 U.S.C. § 1052(a)). This is Mr. Tam’s second attempt at registering *The Slants* with the PTO. *In re Tam*, 808 F.3d at 1331 n.2. In 2010, *The Slants* was previously denied registration from the PTO because the examiner believed the mark was disparaging under section 2(a) of The Act. *Id.* at 1331. Mr. Tam appealed, but the case was dismissed because Mr. Tam failed to file a brief. *Id.* at 1331-32. In this present application, the board examiner found that the mark is likely disparaging to “persons of Asian descent under section 2(a).” *Id.* The examiner further explained that “‘slants’ had ‘a long history of being used to deride and mock a physical feature’ of people of Asian descent,” and even though the band’s intention was to reappropriate the term to be used in a positive light, the examiner believed that “a substantial composite of persons of Asian descent” would find the term racially insensitive and offensive to their race. *Id.* at 1331-32 (citations omitted).

⁸ See *In re Tam*, 808 F.3d at 1332 (finding mark has history of mocking and deriding physical feature of people of Asian descent).

⁹ See *In Re Tam*, 785 F.3d 567, 568-69 (Fed. Cir. 2015), *reh’g en banc*, 808 F.3d 1321 (Fed. Cir. 2015), *as corrected* (Feb. 11, 2016), *cert. granted sub nom.*, *Lee v. Tam*, 137 S. Ct. 30 (2016) (TTAB discussing case background). Upon appeal, the TTAB reexamined the case; and, when it analyzed whether Mr. Tam’s band name was disparaging:

[T]he [TTAB] pointed to dictionary definitions, the band’s website, which displayed the mark next to “a depiction of an Asian woman, utilizing rising sun imagery and using a stylized dragon image,” and a statement by Mr. Tam that he selected the mark in order to “own” the stereotype it represents.

In re Tam, 808 F.3d at 1332. Furthermore, TTAB found that the mark was disparaging to a number of Asian people because “[t]he dictionary definitions, reference works and all other evidence unanimously categorize the word ‘slant,’ when meaning a person of Asian descent, as disparaging.” *Id.*

that section 2(a) does not violate any constitutional rights.¹⁰ Under the *McGinley* precedent, the refusal to register a mark under section 2(a) does not violate the First Amendment.¹¹ Interestingly enough, several courts, including the court that heard the case, have been widely criticized for relying on the *McGinley* analysis, which was decided almost thirty years ago.¹² Recognizing that jurisprudence on the unconstitutional conditions doctrine and the protection accorded to commercial speech has evolved significantly since *McGinley*, the court issued a *sua sponte* order rehearing *en banc* and asked the parties to file a brief addressing whether section 2(a) violates the First Amendment.¹³ Oral arguments were heard on October 2, 2015, and the court held that the First Amendment prohibits government regulators to deny registration even if it finds that speech is likely to offend others, and therefore held that the disparagement movement is unconstitutional.¹⁴ Under this ruling, the court vacated the PTO's holding

¹⁰ See *In re Tam*, 808 F.3d at 1333 (explaining First Amendment rights not affected by section 2(a)); source cited *supra* note 1 (stating First Amendment rights); *In re Tam*, 808 F.3d at 1331-33 (presenting precedent case law from *McGinley* addressing constitutional rights); *infra* note 11 and accompanying text (acknowledging mark holders' assertions that First Amendment rights at issue in denial of registration).

¹¹ *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) (finding being unregistered by PTO does not forbid use of mark). The *McGinley* analysis addressing the claims of section 2(a) violating one's constitutional right states:

With respect to . . . 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.

Id.

¹² See *id.*; see also *In re Tam*, 808 F.3d at 1333 (listing other federal court rulings applying *McGinley* analysis). The *McGinley* analysis is widely criticized as a "standard" for section 2(a) issues because the holding does not bear any citation to legal authority, and furthermore, it was decided in a time when the First Amendment was just beginning to be applied to commercial speech. *Id.* at 1333-34 (citing *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm.*, 447 U.S. 557, 556 (1980)).

¹³ See *In re Tam*, 600 Fed. Appx. 775, 775-76 (Fed. Cir. 2015) (*en banc*) (rehearing on whether bar on registration of disparaging marks violates First Amendment rights); see also *In re Tam*, 808 F.3d at 1334 (describing constitutional issue at bar). In addition to the parties' briefs, the court received ten *amici* briefs. *Id.*

¹⁴ See *In re Tam*, 808 F.3d at 1358 (holding Act's section 2(a) as unconstitutional). Aside from the majority opinion, the following judges either concurred, dissented, or concurred in part and dissented in part: (1) Judge O'Malley concurred, "I agree, moreover that § 2(a) cannot survive the searching constitutional scrutiny to which the majority subjects it under the First Amendment . . . I believe § 2(a) is also unconstitutionally vague, . . . under the Fifth Amendment to the United States Constitution."; (2) Judge Dyk, Judge Lourie, and Judge Reyna concurred in part and dissented in part, "[t]he statute [is] facially unconstitutional as applied to purely commercial speech"; and (3) Judge Lourie dissented, "I respectfully dissent . . . [o]ne wonders why a statute that dates back nearly seventy years . . . is suddenly unconstitutional as violating the First

that the mark was unregistrable and remanded the case to the PTO for further proceedings.¹⁵

Following this ruling, Tam filed a petition for writ of certiorari to the United States Court of Appeals for the Federal Circuit, and on September 29, 2016, the petition was granted.¹⁶ On January 18, 2017, the case was argued in front of the Supreme Court of the United States.¹⁷

The Act was first enacted by Congress for the purpose of providing a national system for registering and protecting trademarks, and to ensure mark holders that one's investment is protected from misappropriation by pirates and cheats.¹⁸ Federal registration of a mark grants the mark holder benefits that allow that individual substantive and procedural rights that are unavailable in the absence of such registration.¹⁹ Per The Act, the PTO must register source-identifying trademarks, unless the marks falls into a category under section 2(a), which describes marks that are precluded from registration and protection.²⁰ If a mark is denied protection by the PTO, the

Amendment. Furthermore, it is not entirely clear that a trademark . . . is protected commercial speech. The lack of a federal registration does not alter the informational function of a trademark . . .” *Id.* at 1358-82.

¹⁵ *See id.* at 1358 (finding disparagement provision of Section 2(a) unconstitutional).

¹⁶ Brief for the Respondent, *Lee v. Tam*, 137 S. Ct. 195 L. Ed. 2d 902 (2016) (No. 15-1293) (granting petition for writ of certiorari). Michelle K. Lee, the Director of the United States Patent and Trademark Office, assumed position as petitioner. Reply Brief for the Petitioner, *Lee v. Tam* 137 S. Ct. 196 L. Ed. 2d (2016) (No. 15-1293).

¹⁷ *Lee v. Tam*, 137 S. Ct. 195 (2017). *See also* Oral Argument, *Lee v. Tam*, 137 S. Ct. 195 (2017) (No. 15-1293), available at https://www.supremecourt.gov/oral_arguments/audio/2016/15-1293 (providing oral argument audio recording).

¹⁸ *See id.* at 1328 (explaining codification of 15 U.S.C. § 1052); *see also* *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 782 n.15 (1992) (protecting consumer and mark holders' rights and expectations for products). Under federal law, a “trademark” is defined as “any word, name, symbol, or device, or any combination thereof” that can be used by the mark holder to “identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” 15 U.S.C. § 1127 (1988).

¹⁹ *See B & B Hardware, Inc. v. Hargis Indus.*, 135 S. Ct. 1293, 1300 (2015) (acknowledging significance of trademark registration); *Park ‘n’ Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 218 (1985) (affirming plaintiff's mark registrable provided financial benefits ripe for protection). *See also* Emily L. DeStefano, Note, *A “Real Interest”: Limiting Standing to Challenge Allegedly “Scandalous” Trademarks*, 39 *AIPLA Q. J.* 103, 108-09 (2011) (explaining federal registration benefits over common law protections).

²⁰ *See In re Tam*, 808 F.3d 1321, 1329 (Fed. Cir. 2015) (describing categories of registration which are forbidden). Under section 2(a), Congress forbids any mark that:

[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; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement

mark holder can still use the mark, but the holder will not have any legal standing afforded by the PTO, such as trademark infringement protections.²¹

However, Congress limited their explanation for codifying section 2(a) of The Act.²² Although section 2(a) of the Act has been around for seventy years, there has never been a bright-line interpretation of what is encompassed within this section.²³ Instead, the courts are forced to speculate on the intent behind this section, and must interpret the definitions of “scandalous,” “immoral,” or “disparaging” by using a subjective view.²⁴ Under the Trademark Manual of Exam Procedures (“TMEP”), the lone examiner determines whether a mark is approved.²⁵ It is noted, however, that the decision of the examiner does not need input from other examiners or supervisors when making this critical decision.²⁶ Although limited in

(as defined in section . . . 3501(9) [of Title 19]) enters into force with respect to the United States.

15 U.S.C. § 1052(a).

²¹ See *B & B Hardware*, 135 S. Ct. at 1300 (emphasizing legal importance The Act affords); Amy Howe, *Argument analysis: Justice skeptical of federal bar on disparaging trademarks*, SCOTUSblog (Jan. 19, 2017, 6:46 AM) <http://www.scotusblog.com/2017/01/argument-analysis-justices-skeptical-federal-bar-disparaging-trademarks> (pointing out trademark protection advantages).

²² See Megan M. Carpenter & Kathryn T. Murphy, *Calling Bullsh*t On the Lanham Act: The 2(A) Bar for Immoral, Scandalous, and Disparaging Marks*, 49 U. LOUISVILLE L. REV. 465, 467-68 (2011) [hereinafter *Calling Bull*] (presenting section 2(a)’s interpretation conundrum due to lack of Congressional intent).

²³ See Brief for the Respondent at 12, *Lee v. Tam*, 137 S. Ct. 195 (2016) (addressing ambiguous definition set forth by section 2(a) for seventy years).

²⁴ *Id.* at 468 (highlighting Congress’ absent explanation of codifying section 2(a) in requiring courts to speculate about Congressional intent). Furthermore, lack of precedent case law has also left the courts with little guidance on the interpretation of the words. *Id.* But see Christine Haight Farley, *Stabilizing Morality in Trademark Law*, 63 AM. U. L. REV. 1019, 1024 (2014) [hereinafter *Stabilizing Morality*] (suggesting section 2(a)’s prohibitions on disparaging marks appropriate). Although Congress barely explains why section 2(a) is enacted, public policy reveals that section 2(a)’s purpose is that “it seeks to encourage civility by denying the benefits of federal registration to marks that cause deep offense to a significant portion of the public.” *Id.* at 1025; Bruce C. Kelber, “Scalping the Redskins”: Can Trademark Law Start Athletic Teams Bearing Native American Nicknames and Images on the Road to Racial Reform?, 17 HAMLINE L. REV. 533, 560-61 (1994) [hereinafter *Scalping the Redskins*] (suggesting section 2(a) reflects government’s conscious effort to preserve funds and services for less controversial marks).

²⁵ See *In re Tam*, 808 F.3d at 1331 (describing TMEP procedures analyzing section 2(a) for determining whether a mark is “disparaging”); see also *Stabilizing Morality*, *supra* note 24, at 1023-24 (highlighting section 2(a)’s subjective difficulties).

²⁶ See *Stabilizing Morality*, *supra* note 24, at 1024 (emphasizing issues with section 2(a)). When determining if a mark is disparaging, a trademark examiner of the PTO considers:

- (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

precedent and Congressional explanations, the United States Courts of Appeals found that a disparaging mark is one that “dishonors by comparison with what is inferior, slights, deprecates, degrades, or affects or injuries by unjust comparison.”²⁷

Modern American culture of recent years has brought forth the evolution of societal tolerance, along with the development of societal injustices in the form of “hate speech.”²⁸ Although it has been noted that words have damning impact on people and their cultures, section 2(a) of The Act has been met with substantial concerns of violating one’s First Amendment rights of free expression.²⁹ Furthermore, The Act’s language is

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.

In re Tam, 808 F.3d at 1331 (quoting Trademark Manual of Exam Proc. § 1203.03(b)(i) (Jan. 2015 ed.) (citing *In re Geller*, 751 F.3d 1355, 1355-58 (Fed. Cir. 2014))).

²⁷ See *In re Tam*, 808 F.3d at 1330 (quoting *In re Geller*, 751 F.3d 1355, 1357-58 (Fed. Cir. (2014)) (affirming rejection of disparaging mark). The applicants’ exercise of free speech was questioned after attempting to register the mark “Stop the Islamisation of America” in connection with counter-terrorism services. *In re Geller*, 751 F.3d 1355, 1356 (Fed. Cir. 2014); see also *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 119-24 (D. D.C. 2003) (assessing whether NFL team name, “Washington Redskins” is disparaging to Native Americans); *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.1635, 1638-41 (T.T.A.B. 1988) (identifying that disparaging image of greyhound dog defecating can confuse consumers of product). In *Harjo*, several Native Americans petitioners filed a complaint requesting that the TTAB cancel the trademark, “Redskins,” which was an NFL trademarked name for a professional football team. See *Harjo*, 284 F. Supp. 2d at 124 (noting public perception as irrelevant in determining if it is disparaging). After several appearances, both the TTAB and the district court system ruled that the mark, “Redskins,” was cancelled and the “Washington Redskins,” “Redskins,” and “Redskin-ettes” were no longer marks protected under The Act. See Christian Dennie, *Native American Mascots and Team Names: Throw Away the Key; The Lanham Act is Locked for Future Trademark Challenges*, 15 SETON HALL J. SPORTS & ENT. L. 197, 206 (2005) (holding discussed). This decision upheld the TTAB’s broad and liberal test for determining what can be protected under section 2(a) of The Act. *Id.* After the TTAB’s decision, the case was then taken to the district courts, which reversed the TTAB’s holding, because the court determined that there was no substantial evidence supporting that “Redskins” was disparaging to Native Americans. *Id.* Furthermore, the court also found that cancelling the mark would place the NFL franchise in an undue economic prejudice. *Id.* at 209. Although the case has been decided, several scholars consider this landmark case a prime example of the challenges faced in registering a trademark under The Act. See Todd Anten, *Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of Slurs into Section 2(a) of the Lanham Act*, 106 COLUM. L. REV. 388, 403 (2006) (declaring TTAB’s most complete procedural analysis to date through *Harjo* decision).

²⁸ See Regan Smith, *Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks*, 42 HARV. C.R.-C.L. L. REV. 451, 452 (2007) (contrasting American society from time of section 2(a) codification to present day).

²⁹ See *supra* note 1 and accompanying text (laying out First Amendment rights). See also *Pro-FootBall, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 454 (E.D. Va. 2015) (holding professional

extremely broad, stating that *any* person who feels damaged or targeted by the mark can file to cancel it.³⁰ Even so, there are few scholarly opinions or case decisions that address the constitutionality of section 2(a) or discuss whether it represents an unjustified intrusion on First Amendment

football team name, “The Redskins,” disparaging to Native Americans); *Scalping the Redskins*, *supra* note 24 and accompanying text; *Stabilizing Morality*, *supra* note 24, at 1024 (discussing unconstitutionality of section 2(a)); Jeff Royer, Comment, *Commercial Speech and Fan Websites—Searching for a Method to the Madness*, 86 J. PAT. & TRADEMARK OFF. SOC’Y 628, 630 (2004) (discussing theory that The Act only applies to commercial speech). Under *Cent. Hudson*, the Court explained that commercial speech should be afforded less protection than non-commercial speech. *Id.* (citing *Cent. Hudson, Gas & Elec. Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557, 563-67 (1980)). See also *Cent. Hudson*, 447 U.S. 557 at 565.

The Central Hudson test is applied only when commercial speech concerns lawful activity and is not misleading. Once that burden is met, the government may only regulate the speech if: (1) the asserted government interest is substantial; (2) the regulation directly advances the asserted government interest; and (3) the regulation is no more extensive than necessary.

Id. at 565 n.14. Compare *id.*, with *Taubman Co. v. Webfeats*, 319 F.3d 770, 778 (6th Cir. 2003) (explaining that internet domain names are not commercial speech, meaning The Act is not triggered).

³⁰ See 15 U.S.C. §§ 1063, 1064 (2017) (explaining process to petition cancellation of trademark); DeStefano, *supra* note 19, at 105 (discussing restrictions and limitations with section 2(a)). A seminal case that highlights the challenges of judicially-created requirements of section 2(a) is *Ritchie v. Simpson*, 170 F.3d 1092, 1097-98 (Fed. Cir. 1999). In this case, the plaintiff filed to cancel O.J. Simpson’s mark, “*The Juice*,” “*O.J. Simpson*,” and “*O.J.*” because the plaintiff claimed that it attempted to justify O.J.’s physical violence towards women, thus making the marks scandalous. DeStefano, *supra* note 19, at 105; see *Ritchie*, 170 F.3d at 1097 (holding anyone with personal stance in getting mark registered should have valid standing). Plaintiff was not directly connected to Mr. Simpson, and only challenged the mark because he believed as a Christian man, this would challenge his beliefs. DeStefano, *supra* note 19, at 105. The court held that although Ritchie did not personally know Mr. Simpson, he, nevertheless, possessed a real interest in the registration of the mark and the cancellation request was allowed. See *Ritchie*, 170 F.3d at 1097-98. This case demonstrates the broad acceptance that anyone can challenge a mark. See also DeStefano, *supra* note 19, at 103 (noting broad standing requirement is less frequently considered an issue). As one critic of the *Ritchie* decision opines:

[D]oes this decision mean that an animal rights organization has standing to oppose the registration of pet food marks because they consider the keeping of pets “animal enslavement?” Could a vegan enthusiast have standing to petition to cancel the registration of marks for meat products because she considers the killing of animals for food an immoral act? Would an environmental activist have standing to cancel the registration of a mark of a company that he considers to be an irresponsible polluter? The *O.J. Simpson* decision contains the seeds of an administrative and judicial chaos in which harassment before the Trademark Board becomes a weapon of the contentious militant, combative extremist, and well-funded activist.

Id. at 104.

freedoms.³¹ Some scholars have noted, however, that First Amendment jurisprudence should recognize an ever-evolving change in the meanings behind words and names, rather than chilling its meanings and social relations through time and enforcing unnecessary regulation by enforcing section 2(a).³²

In *In re Tam*, the United States Court of Appeals considered whether section 2(a) of The Act violates the First Amendment of the United States Constitution.³³ The court examined the breadth of applying strict scrutiny to section 2(a) of The Act, and determined that because the regulation is based on the expressive aspect of the speech, any mark being reviewed under section 2(a) should be viewed as expressive speech.³⁴ Therefore, the court determined that the limited and narrow protections under commercial-speech do not apply, making The Act's section 2(a) unconstitutional.³⁵

The court reasoned that section 2(a) regulates expressive speech, not commercial speech, and therefore, strict scrutiny is appropriate.³⁶ Before coming to this conclusion, the government argued that trademark registration is a form of government; thus, it has a legitimate interest in refusing to spend

³¹ See Smith, *supra* note 28, at 467-68 (noting lack of constitutional analysis and authorities' decisions on alternate grounds); Jeffrey Lefstin, Note, *Does the First Amendment Bar Cancellation of Redskins?*, 52 STAN. L. REV. 665, 708 (2000) (suggesting issue analysis from other constitutional doctrines).

³² See *Broadrick v. Okla.*, 413 U.S. 601, 613, 615 (1973) (recognizing issues failing constitutional protection being overbroad); see also Pamela C. Chalk, *The Trust Value of Trademarks: Influencing Who We Are and Who We Want to Be*, 12 J. CONTEMP. LEGAL ISSUES 20, 23 (2001). Recognizing the negative effects of chilling meanings has been highlighted in recent opinions, as one Judge stated:

[W]ords are not always fungible, and that the suppression of particular words "runs a substantial risk of suppressing ideas in the process." [Y]et this recognition always has been balanced against the principle that when a word acquires value "as the result of the organization and the expenditure of labor, skill, and money" by an entity, that entity constitutionally may obtain a limited property right in the word.

Id. at 20 (quoting *San Francisco Arts & Ath., Inc. v. U.S. Olympic Comm.*, 403 U.S. 522, 531-32 (1987)).

³³ See *In re Tam*, 808 F.3d 1321, 1345-47 (Fed. Cir. 2015) (applying strict scrutiny in analyzing "The Slants" under The Act's section 2(a) prohibition).

³⁴ See *id.* at 1354-55 (determining expressive speech applies when using section 2(a) analysis and therefore renders this subsection unconstitutional).

³⁵ See *id.* (quoting Br. Of Amicus Curiae First Amendment Lawyer's Ass'n at 7) (citations omitted). "Individuals and businesses refrain from using certain terms as trademarks for fear the PTO might see the terms as immoral, scandalous, or derogatory, in violation of section 2(a). Such self-censorship narrows the spectrum of speech in the public marketplace." *Id.* at 1341.

³⁶ *Id.* at 1345 (holding section 2(a) unconstitutional). "Denial of federal trademark registration on the basis of the government's disapproval of the message conveyed by certain trademarks violates the guarantees of the First Amendment." *Id.*

funds to protect racially charged slurs to be placed in interstate commerce.³⁷ However, the court pointed out that trademark registration is user-funded instead of tax-payer funded, and is not exempt from strict scrutiny.³⁸ Applying strict scrutiny rather than intermediate scrutiny is fatal to section 2(a), thus making it unconstitutional for violating the First Amendment.³⁹

³⁷ See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 782 (1992) (explaining intent of The Act); *In re Tam*, 808 F.3d at 1356-57 (addressing government's failed arguments to bar disparaging trademarks).

³⁸ See *In re Tam*, 808 F.3d at 1354 (striking down codifier's reasoning). The issuance of a certificate signed by the United States Patent and Trademark Office ("USPTO") is not enough to transfer private expression or registration into government speech. *Id.* at 1348. Unlike government monuments, record property titles, street parades, license plates, and copyright registrations, the government does not require a mark holder to publicly display this certificate signed by the Director of the USPTO. *Id.* Instead, the mark holder is free to do what they wish with the certificate. *Id.*; see also *Patent Process Overview*, United States Patent and Trademark Office, <http://www.uspto.gov/patents-getting-started/patentbasics/types-patent/patentprocess-overview#step7> (last modified Nov. 24, 2014) (listing steps in patent certificate issuance process). The mere issuance of a certificate cannot simply convert one's free speech into government speech to the extent that the government is entitled to regulate its content to the point of violating one's First Amendment rights. See *In re Tam*, 808 F.3d at 1354. If the certification was permitted to transform free speech into government speech, it would place a severe risk of allowing viewpoint discrimination. *Id.*

³⁹ See *In re Tam*, 808 F.3d at 1345 (applying strict scrutiny results in fatal assessment of section 2(a) of The Act); see also Brief of First Amendment Lawyer's Ass'n, as Amicus Curiae in Support of Respondent at 13, *In re Tam*, 808 F.3d 1321 (2015) (No. 15-1293) "Individuals and businesses refrain from using certain terms as trademarks for fear the PTO might see the terms as immoral, scandalous, or derogatory, in violation of section 2(a). Such self-censorship narrows the spectrum of speech in the public marketplace." *Id.*; Carl J. Minniti III, *The Lanham Act's Unconstitutional Hodgepodge*, 17 RUTGERS J.L. & RELIGION 315, 322-24 (2016) (highlighting The Act's inconsistencies). Scholars have noted the blatant problems associated with the violation of First Amendment rights and content-based regulations. *Id.* As court justices have pointed out: First Amendment permits restrictions upon the content of speech in a few limited areas, which are of such slight social value as a step to truth that any benefit that may be derived from them is clearly outweighed by the social interest in order and morality." *Id.* at 322 (quoting *Virginia v. Black*, 538 U.S. 343, 358-59 (2003)). Even worse than laws targeting content are those laws that discriminate among viewpoints. *Id.* As Justice Clarence Thomas noted in *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2230 (2015), allowing the government to regulate speech based on "the specific motivating ideology or the opinion or perspective of the speaker" is just another way to engage in content discrimination. *Id.* Justice Thomas continues to hone into this point by discussing *Consol. Edison Co. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 530, 546 (1980). *Id.* In *Consol. Edison Co.*, the Supreme Court refuted a previous ruling which banned utility companies from inserting controversial issues as well as unpopular public policy issues into billing statements; Justice John Paul Stevens noted:

[A] regulation of speech that is motivated by nothing more than a desire to curtail expression of a particular point of view on controversial issues of general interest is the purest example of a "law abridging the freedom of speech, or of the press." A regulation that denies one group of persons the right to address a selected audience on "controversial issues of public policy" is plainly such a regulation.

Furthermore, due to the vagueness of the disparaging prohibition in The Act, section 2(a) is also unconstitutional under the Fifth and Fourteenth Amendments because the doctrine requires specificity in drafting statutory language, which section 2(a) fails to do by merely listing its criteria for denying protection under anything that is “scandalous,” “immoral,” or “disparaging.”⁴⁰ The uncertain nature of section 2(a) places a chilling effect on speech, and The Act’s provision is so vague that even without a First Amendment challenge, it is still unconstitutional under the Fifth Amendment.⁴¹

It is clear that the disparaging provision of The Act is unconstitutional on its face, and as the majority correctly noted, holds no teeth when applying strict scrutiny.⁴² The majority is thus correct in

Id. (citing *Consol. Edison Co. v. Pub. Serv. Comm’n of NY*, 447 U.S. 530, 546 (1980) (Stevens, J., concurring)).

⁴⁰ See *In re Tam*, 808 F.3d at 1342 n.6 (“[T]he PTO admitted that ‘[t]he guidelines for determining whether a mark is scandalous or disparaging are somewhat vague and the determination of whether a mark is scandalous or disparaging is necessarily a highly subjective one.’”) (alterations omitted); see also Robert H. Wright, *Today’s Scandal Can Be Tomorrow’s Vogue: Why Section 2(a) of the Lanham Act is Unconstitutionally Void for Vagueness*, 48 HOW. L.J. 659, 661 (2005) (discussing unconstitutionality of section 2(a) under several constitutional rights). The wording in section 2(a) is too broad in scope because “a statute which either forbids or requires the doing of an act in terms so vague that men of common intelligence must necessarily guess at its meaning and differ as to its application violates the first essential due process of law.” *Id.* (citing *Conally v. Gen. Const. Co.*, 269 U.S. 385, 391 (1926) (criticizing ambiguous wording of statutes violates due process rights)). See also *F.C.C. v. Fox Television Stations, Inc.*, 132 S. Ct. 2307, 2317 (2012) (addressing concerns of applying vague law regulation speech). The Supreme Court commented that:

[E]ven when speech is not at issue, the void for vagueness doctrine addresses at least two connected but discrete due process concerns: first, that regulated parties should know what is required of them so they may act accordingly; second, precision and guidance are necessary so that those enforcing the law do not act in an arbitrary or discriminatory way.

Id. As such, a sincere effort is vital in ensuring that ambiguity does not stop First Amendment rights afforded by the U.S. Constitution. *Id.*

⁴¹ See *In re Tam*, 808 F.3d at 1358 (O’Malley, and Wallach, JJ., concurring) (plurality opinion) (emphasizing alternate reasoning to unconstitutionality of The Act’s section 2(a) provision). For section 2(a) of The Act to survive the vagueness issue, the Supreme Court requires that it “give the person of ordinary intelligence a reasonable opportunity to know what is prohibited, so that he may act accordingly.” *Id.* at 1360 (quoting *Grayned v. City of Rockford*, 408 U.S. 104, 108 (1972)). As such, First Amendment concerns require a stringent vagueness test. *Id.* Under the First Amendment, there are special concerns that arise from content-based regulations of speech because of the obvious chilling effects on free speech. *Id.* (citing *Reno v. ACLU*, 521 U.S. 844, 872 (1997)). There must be precision in controlling content-based regulations because it is “an area so closely touching our most precious freedoms.” *Id.* (citing *Edenfield v. Fane*, 507 U.S. 761, 777 (1993)).

⁴² See sources cited *supra* note 29 and accompanying text (maintaining free speech strict scrutiny standards, regardless if mark present, is protected by constitutional rights); see also Smith,

eliminating the precedent found in *McGinley* acknowledging that under all considerations, the First Amendment cannot be overlooked when discussing trademark law.⁴³ By recognizing that PTO examiners are given tremendous power to determine what is disparaging under The Act, the courts should consider a more controlled view when handling the approval process of such mark registration.⁴⁴

It is clear that Mr. Tam was not attempting to federally register *The Slants* mark for malicious purposes.⁴⁵ Tam and his band members are not disparaging Asian-Americans, but celebrating their heritage like a badge of pride instead.⁴⁶ Even Justice Ginsburg noted the missteps of the PTO registration process when she poignantly opined at oral arguments, “[d]oes it not count at all that everyone knows that The Slants is using this term not at all to disparage, but simply to describe?”⁴⁷ The examiner reviewing Mr. Tam’s application should not have used the term out of context, but rather, should have looked at the evolution of the term, and the intent of the mark holder’s desire for federal registration.⁴⁸ Even then, however, the government should not directly interfere with one’s First Amendment rights, *even if* government regulators find that this speech will likely offend others.⁴⁹ Furthermore, several justices of the Supreme Court appear to agree in this

supra note 28, at 476 (mentioning expanding TTAB’s idea of disparagement test to more rigorous test than before).

⁴³ See *In re Tam*, 808 F.3d at 1333-35 (discussing and abrogating *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981)).

⁴⁴ See Smith, *supra* note 28, at 481 recognizing severe mishandling of one’s First Amendment rights poses serious problems for 15 U.S.C. § 1021(a)).

⁴⁵ See *In re Tam*, 808 F.3d at 1332 (reasoning Mr. Tam’s desire to register name was to own negative stereotype it represents). In counteracting the negative stereotype the slanted eyes represent among the Asian community, Mr. Tam explained that he chose this name because “I [Mr. Tam] was trying to think of things that people associate with Asians. Obviously, one of the first things people say is that we have slanted eyes.” *Id.* at 1333 (citations omitted). Mr. Tam went on to say “[w]e [The Slants] want to take on these stereotypes that people have about us, like the slanted eyes, and own them. We’re very proud of being Asian—we’re not going to hide that fact.” *Id.*

⁴⁶ Brief for the Respondent, *Lee v. Tam*, 137 S. Ct. 195 L. Ed. 2d 902 (2016) (No. 15-1293) (granting petition for writ of certiorari)

⁴⁷ Oral Argument at 16:34, *Lee v. Tam*, 137 S. Ct. 195 (2017) (No. 15-1293), available at https://www.supremecourt.gov/oral_arguments/audio/2016/15-1293.

⁴⁸ See *id.* Denial of the registration mark, on the basis of the examiner’s interpretation of disparaging, was found by applying dictionary definitions, reference works and outside evidence, such as *The Slant*’s Wikipedia page, which showed that the mark would most likely be used to refer to people of Asian descent. *Id.*

⁴⁹ See *id.* at 1358 (citing *Snyder v. Phelps*, 562 U.S. 443, 461 (2011) (explaining church’s homosexual veteran’s funeral protest protected by First Amendment even if causing pain to family members)) (limiting speech cripples freedom of public debate). “Our Constitution protects [the First Amendment] to ensure that we do not stifle public debate.” *Id.* at 461.

instant matter, noting that section 2(a) lacks any connection to the ultimate purpose for codifying The Act in the first place.⁵⁰

The balance of finding civility among “hate speech” is convoluted and seemingly impossible to assess without inserting subjective views on the issues.⁵¹ In the instant case, Mr. Tam’s intentions for attempting to re-appropriate a negative term into a positive embracement of one’s identity should not have been barred by the PTO examiner.⁵² Nevertheless, government regulators should not impose one’s own view on disparaging material because doing so creates a chilling effect on free speech, which undermines the evolution of our ever-changing society that has thrived on open dialogue between its citizens.⁵³

Even though the most recent decision holds section 2(a) as unconstitutional, if Congress wishes to keep this section of The Act, then Congress should look to alternatives in modifying section 2(a); one method of resolving this constant issue is for Congress to amend The Act in order to bring it up to date with contemporary First Amendment jurisprudence.⁵⁴ This can be done by changing the language of The Act by replacing section 2(a)’s wording from “scandalous,” “immoral,” and “disparaging” and simplifying the terms to collectively mean “obscene.”⁵⁵ Doing so allows the PTO and TTAB to apply the *Miller* test in determining whether a trademark can be registered, which sets out a clear set of questions in determining if an act or words are in fact “obscene.”⁵⁶ Even though one can argue that

⁵⁰ See Amy Howe, *Argument analysis: Justice skeptical of federal bar on disparaging trademarks*, SCOTUSBLOG (Jan. 19, 2017, 6:46 AM) <http://www.scotusblog.com/2017/01/argument-analysis-justices-skeptical-federal-bar-disparaging-trademarks> (describing most recent oral arguments).

⁵¹ See Smith, *supra* note 28, at 452-53 (evolving cultural norms and dialogue provide unstable grounds for applying constitutional protections).

⁵² See *In re Tam*, 808 F.3d at 1358 (vacating TTAB’s decision and remanding for further proceedings).

⁵³ See Smith, *supra* note 2, at 457 (embracing society’s diverse views in acknowledging conservative and liberal undertones are not one in the same).

⁵⁴ See Kristian D. Stout, *Terrifying Trademarks and a Scandalous Disregard for the First Amendment: Section 2(A)’s Unconstitutional Prohibition on Scandalous, Immoral, and Disparaging Trademarks*, 25 ALB. L.J. SCI. & TECH. 213, 253 (2015) (suggesting alternative methods in modifying section 2(a) to make it constitutional).

⁵⁵ See *id.* (discussing suggestions in modifying The Act’s language).

⁵⁶ See *id.*; see also *Miller v. California*, 413 U.S. 15, 24 (1973) (defining test for obscenity). The court applied a set of questions in determining whether a term is obscene on the following grounds:

(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

“obscene” is just as overly vague as the terms presently included in The Act, the *Miller* test is relatively straightforward.⁵⁷ However, applying this application would require a command from the Supreme Court of the United States, or a revision from Congress, which may take a substantial amount of unnecessary time to modify and approve.⁵⁸ Furthermore, Congress can consider striking down the entire disparagement agreement all together.⁵⁹ Removing the disparagement provision will not harm the rest of The Act, as the intent of The Act is to “regulate commerce within the control of Congress by making actionable the deceptive and misleading use of the marks in commerce . . . to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks.”⁶⁰

The *In re Tam* court, explored the scope and validity of the First Amendment when examining section 2(a) of The Act’s disparaging provision, and correctly held that under strict scrutiny, this unnecessary provision is found to be unconstitutional. In this instant case, the government regulators who examined Mr. Tam’s registration request incorrectly failed to assess Mr. Tam’s intent of claiming the mark, which was not for malicious purposes. Instead of using the term in a racist manner, Mr. Tam wanted to embrace a negative connotation and attempt to bring people of Asian heritage together and address the stigma that personal appearances are not

the applicable state law; and (c) whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value[.]

Id. at 24.

⁵⁷ See *id.* at 24-25 (applying *Miller* test to section 2(a) is relatively straight forward).

What is clear, and will clarify the “scandalous” or “disparaging” ambiguity at present, is that while “obscene” speech may be curtailed, merely “indecent” speech cannot be restricted by virtue of its content. Importantly, sexual expression may be “indecent” and not “obscene,” and thus deserve protection. For instance, in *Reno v. American Civil Liberties Union*, the Court noted that ambiguous legislation that curtails “indecent” sexual speech deserves heightened scrutiny when it held: “in evaluating the free speech rights of adults, we have made it perfectly clear that ‘sexual expression which is indecent but not obscene is protected by the First Amendment.’”

Stout, *supra* note 54, at 254.

⁵⁸ See Stout, *supra* note 54, at 254 (discussing procedural process necessary to modify Section 2(a)). It should be noted, that the Supreme Court heard arguments for this case in January 2017. Oral Argument, *Lee v. Tam*, 137 S. Ct. 195 (2017) (No. 15-1293), available at https://www.supremecourt.gov/oral_arguments/audio/2016/15-1293. At the time of publication, the opinion is forthcoming. See *Lee v. Tam*, 137 S. Ct. 30 (2017).

⁵⁹ See Stout, *supra* note 54, at 254 (striking down disparagement provision will not harm The Act’s intent). As extensively explained, the intent is essential to understanding why removing the disparaging provision will not harm the rest of The Act. *Id.*

⁶⁰ 15 U.S.C. § 1127 (2012) (addressing original intent provided by The Act).

damning to one's culture, which the examiners failed to consider. Instead of shaming one's appearance, from which they cannot change, Mr. Tam aimed to re-appropriate the racist term to become acceptable, and subsequently transform it into a positive term in popular culture. Indeed, the court is correct in striking down the disparagement provision of The Act, and it is correct to assume that even if government regulators believe that a mark will likely offend others, it should not preclude one from claiming the mark because doing so creates a chilling effect on individual freedoms, which this country was founded on. With the upcoming opinion released by SCOTUS in the foreseeable future, the fate of The Slants and other members of other ethnicities, cultures, genders, religions and nationalities seeking validation for appropriation finally reach the attention of the highest court in the United States.

The disparaging provision in The Act largely serves no purpose to the original intent of the statute. Moreover, it represents a major risk of violating First Amendment rights afforded to citizens. As a country, we should adapt to the progressive nature of open and free speech, and permit patent federal mark registration to any mark absent the consideration of whether it is disparaging or not. Legal doctrines, like language, are not static. Even though laws should be applied consistently, they should be applied in the ever-changing societal norms of the present. Given that minority creators and artists have historically been denied the benefits of intellectual property protection, intellectual property rights are even more important in this context; where, as these aforementioned artists and creators have been denied intellectual property protection in the past, credit and acknowledgment in their craft is imperative to them. Preventing such marks challenges our society's opportunity to grow in building an open dialogue discussing other's stances, beliefs, and views. As such, an overly broad interpretation of the prohibitions in section 2(a) would chill the transformative use of works of art, and minority voices will be cast aside and neglected. Admittedly, it may be challenging to argue that a nearly seventy-year old statute has been unconstitutional since its creation. However, such an abridgement of time should not hinder Congress' consideration in reinterpreting the intent of a statute. Instead, The Act and the government regulators should, as the founding fathers intended, let the American citizens speak for themselves.

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