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US Perspectives: In US, Growing Battle Over Offensive Trademarks

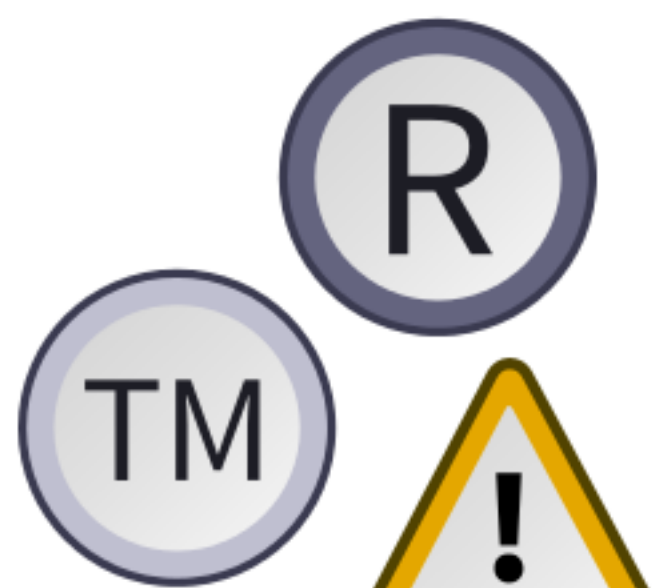
26/04/2016 BY STEVEN SEIDENBERG FOR INTELLECTUAL PROPERTY WATCH — LEAVE A COMMENT

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The US Patent and Trademark Office (USPTO) is not admitting defeat. It is still refusing to register trademarks that disparage people, even though this policy violates the First Amendment's guarantee of free speech, according to a December decision by the Federal Circuit Court of Appeals. The USPTO has appealed the court ruling, and many experts expect the Supreme Court will soon rule on whether there is constitutional protection for disparaging marks.

The USPTO claims it is merely following America's trademark statute. Section 2(a) of the Lanham Act declares that the following material cannot be registered as trademarks: "immoral, deceptive, or scandalous matter, or matter which may disparage ... persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute."



Two cases now before the courts challenge the constitutionality of Section 2(a)'s ban on disparaging marks. The more famous of these cases concerns the American professional football team that calls itself the "Redskins." A group of native Americans is seeking to kill the team's federal trademark registration for "Redskins," asserting it is a bigoted and disparaging term for native Americans. In

response, the team denies that "Redskins" is disparaging, and even if it is disparaging, the team asserts that the Lanham Act's prohibition on disparaging marks violates the First Amendment. Both the USPTO and a federal district court in Virginia ruled in favor of the native Americans and struck the federal registration. The team is appealing these decisions to the 4th Circuit Court of Appeals, in *Pro-Football, Inc. v. Blackhorse* [pdf].

The second case is less well known, but more advanced in the judicial process. It centers on an Asian-American rock band that calls itself "the Slants." The band tried to register its name as a trademark, but the USPTO rejected the application, because "slant" is a disparaging term for East Asian individuals. The band appealed the decision to the Federal Circuit, and on 22 December, the en banc court found in favor of the band, declaring in *In re Tam* [pdf] that Section 2(a)'s ban on disparaging marks was unconstitutional.

Undaunted, the USPTO is still refusing to grant trademark registration to marks it finds disparaging, including "Slants." And on 20 April, the agency asked the Supreme Court to review the Federal Circuit's ruling.

Going Up

Tam raises important issues that interest the high court. "The Supreme Court has been active in recent years on IP cases and free speech cases," said Roberta Jacobs-Meadway, a partner in the Philadelphia office of the Eckert Seamans law firm. She added, "I think the Supreme Court is reasonably likely to grant certiorari in this case, especially if 4th Circuit affirms [the lower court decision in *Pro-Football*], because then you will have a clear circuit conflict"

Still, *Tam* may not be the Section 2(a) case that reaches the high court. A better case beckons – concerning the Redskins. "The primary significance of "redskins" is offensive, but maybe that is not the primary significance of 'slants' [For that reason,] I think the Slants case is too nuanced to be a good subject for a cert petition. Usually the Supreme Court likes to take issues that are more clear cut," said Douglas Masters, a partner in the Chicago office of the Loeb & Loeb law firm.

Moreover, the Slants case has a procedural weakness. "*Tam* doesn't have two opposing parties, just Tam and the USPTO. So it not as compelling as if there were a party on both sides [as there is in *Pro-Football*]," said Masters.

[Update On 25 April, before the 4th Circuit had ruled, the professional football team petitioned the US Supreme Court to hear the Redskins case. This is an extremely unusual request, but it might be successful, since the high court may wish to hear this case in conjunction with the Slants case. "Having the two cases together will give the Supreme Court a fuller picture when deciding if this part of the Lanham Act violates free speech," said Katherine Basile, a partner in the Palo Alto office of the Reed Smith law firm.]

Battle on High

Should the issue reach the Supreme Court, as many experts expect it will, supporters of Section 2(a) may have a difficult row to hoe.

"Some members of court have been focused on extending 1st Amendment protections," said Masters. Partially because of this, he added, "The court would likely find the application of the disparagement rule to violate the 1st Amendment"

Another strike against the USPTO is the agency's seemingly arbitrary application of Section 2(a). The agency, for instance, registered "Dykes on Bikes," but rejected "2 Dyke Minimum." It registered "Dago Swagg," but rejected "Dago Mary's." It registered "Wild Injun" but rejected "Urban Injun."

"Once you start letting the government make these distinctions [about what is and isn't disparaging], you start getting all sorts of inconsistent, content-based decisions," said Jacobs-Meadway.

Supporters of Section 2(a), however, may be able to defend the statute. "There's a good argument that because the Lanham Act is not prohibiting speech, it should be constitutional. Federal registration [of a mark] gives certain enforcement benefits and some presumptions, but withholding that registration does not prohibit speech," said Katherine Basile, a partner in the Palo Alto office of the Reed Smith law firm.

Offensive Outlier

Should the Supreme Court agree with the Federal Circuit – and rule that Section 2(a)'s prohibition of disparaging marks violates the 1st Amendment – some other restrictions imposed by Section 2(a) would be seriously undermined. "If limits on disparaging marks are unconstitutional, then limits on immoral or scandalous matter would also fall," said Basile.

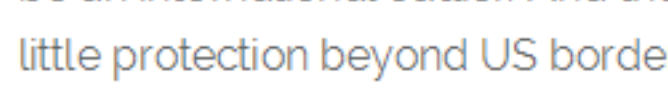
Some experts think the fallout may not reach quite so far. The prohibition on scandalous marks will survive, according to Masters, because that refers to obscene material, and "obscene images or words have historically been outside of 1st Amendment protection."

Even if that analysis is correct, striking down Section 2(a)'s limits on disparaging and immoral marks would likely result in a fair number of new and offensive federally registered marks. "But we have to accept offensive speech, and I think that is the direction we are moving towards [in trademarks]," said Masters.

Perhaps, but countries outside the US have drawn the line at offensive marks. Marks that disparage other people are contrary to morality or public order and thus cannot be registered in England, Australia, and many other nations. The General Court of the European Union, for instance, rejected registration of "Paki Logistics," because it contained a derogatory term for individuals of Pakistani heritage.

In short, if the US allows registration of disparaging and immoral marks, it will be an international outlier. And the owners of those offensive marks will receive little protection beyond US borders.

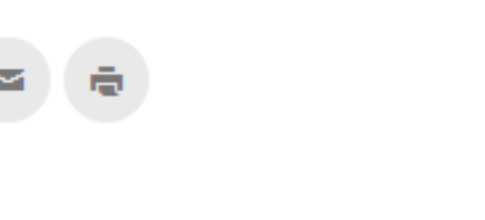
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