Intellectual Property Alert:
Supreme Court Not a Fan of Trademark Ban

*The Court held 8–0 that the Lanham Act’s ban on offensive trademarks is unconstitutional*

By R. Gregory Israelsen

June 21, 2017 — On Monday, June 19, 2017, the Supreme Court held in *Matal v. Tam* that the disparagement clause of the Lanham Act violates the Free Speech Clause of the First Amendment, and therefore is unconstitutional. The disparagement clause—which prohibits federal registration of trademarks “that may ‘disparage or bring into contempt or disrepute’ any ‘persons, living or dead’”—the Court explained, “offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend.”

**Background**

The Supreme Court’s opinion is the climax in Simon Tam’s long-running battle to obtain a trademark registration for his dance-rock band’s name, THE SLANTS. Tam first submitted a trademark application in 2010, but the U.S. Patent and Trademark Office refused the application for being “disparaging to people of Asian descent.” Tam lost on appeal at the Trademark Trial and Appeal Board, as well as at a panel of the U.S. Court of Appeals for the Federal Circuit. His fortunes changed, however, when the Federal Circuit later issued a 9–3 *en banc* opinion holding that Section 2(a) of the Lanham Act—the provision under which Tam’s application was rejected—was unconstitutional. The Supreme Court eventually granted certiorari, and heard oral arguments in January 2017, which Banner & Witcoff analyzed at the time.

**Opinion**

The Court’s decision is a decisive victory for Tam. All eight justices considering the case agreed that the Lanham Act’s disparagement clause is facially invalid under the First Amendment. Because the Lanham Act’s disparagement clause is unconstitutional, the USPTO’s refusal of Tam’s application based on that section was also impermissible.

All the justices agreed that offensive speech is protected by the First Amendment, even in the trademark context. For example, Justice Alito’s opinion explained that the Supreme Court has “said time and time again that ‘the public expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers.’” Additionally, Justice Kennedy wrote that “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.” The danger of allowing the
government to restrict offensive speech, Justice Kennedy explained, is that “[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 justices also all agreed that “trademarks are private, not government, speech.” The USPTO
had argued that registered trademarks are government speech, which the First Amendment does not
regulate. The Court rejected the idea, saying “it is far-fetched to suggest that the content of a
registered mark is government speech. If the federal registration of a trademark makes the mark
government speech, the Federal Government is babbling prodigiously and incoherently.” Many
registered trademarks say “unseemly things,” “express[] contradictory views,” “unashamedly
endors[e] a vast array of commercial products and services,” and “provid[e] Delphic advice to the
consuming public.” “And there is no evidence that the public associates the contents of trademarks
with the Federal Government.”

The Court noted the “most worrisome implication” of the idea that trademarks constitute
government speech “concerns the system of copyright registration,” this was also the subject of
the justices’ first question at oral argument. In its opinion, the Court asked, “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?” Acknowledging that
“trademarks often have expressive content,” and that “powerful messages can sometimes be
conveyed in just a few words,” the Court rejected the USPTO’s attempts to distinguish copyright as
being “the engine of free expression.”

Ultimately, Justice Kennedy explained, the Court’s objective is to protect “a diversity of views from
private speakers.” And “our reliance must be on the substantial safeguards of free and open
discussion in a democratic society.”

Impact

Despite the parade of horribles prophesied by Tam’s opponents, the Court’s decision is unlikely to
have a significant impact—or even be noticeable—in the lives of most Americans. As the Court
stated, “it is unlikely that more than a tiny fraction of the public has any idea what federal
registration of a trademark means.” Thus, when businesses select names for themselves or their
products or services, they are generally more focused on the marketing power of those names, not
whether those names might ultimately be eligible for trademark protection. Those who seek to
offend—or, like Tam, “reclaim[] an offensive term for [a] positive purpose”—are similarly
unlikely to choose their message based on federal-trademark-registration eligibility.

The most famous exception to this argument is the Washington Redskins football team. The team’s
trademark registration was cancelled in 2014 under the disparagement clause of Section 2(a) of the
Lanham Act. The team’s appeal is currently before the U.S. Court of Appeals for the Fourth Circuit,
which placed the case in abeyance in November 2016, pending the Supreme Court’s decision in
Tam. Because the Supreme Court’s holding invalidated Section 2(a)’s disparagement clause
altogether, the team is likely to prevail in its appeal.
Modern society provides many tools, such as social media, for opposition to those who wish to brand themselves with offensive terms. Yet the government may not join in that opposition, at least not by regulating trademarks or most other private speech. “[T]he proudest boast of our free speech jurisprudence is that we protect the freedom to express ‘the thought that we hate.’”

The Court’s full opinion is available [here](#).

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*i Matal v. Tam, No. 15-1293 (Jun. 19, 2017).*

ii *Id.,* slip op. at 1-2.

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

iv *Matal* at 1.

v All the justices joined the Opinion of the Court authored by Justice Alito. Chief Justice Roberts and Justices Thomas and Breyer joined a further opinion by Justice Alito. Justice Kennedy authored a concurrence joined by Justices Ginsburg, Sotomayor, and Kagan. Justice Thomas also authored a concurrence.

vi *Matal* at 22-23.

vii *Matal* at 4 (Kennedy, J.).

viii *Id.* at 8.

ix *Matal* at 18.

x *Id.* at 14-15.

xi *Id.* at 15.

xii *Id.* at 17.

xiii *Id.* at 18.


xv *Matal* at 18.

xvi *Matal* at 7 (Kennedy, J.).

xvii *Id.* at 8.

xviii *Matal* at 15.

xix *Matal* at 4 (Kennedy, J.).

xx *Matal* at 25 (Alito, J.).