

## Matal v. Tam

Banner & Witcoff offers the following content as a resource to help clients understand and prepare for the potential impact of this case:

Simon Tam is the founder and bassist for the dance rock band, “The Slants.” He submitted two trademark applications for THE SLANTS. The first application was in 2010, which the U.S. Patent and Trademark Office refused based on “the mark [being] disparaging to people of Asian descent under § 2(a).” Tam again applied in 2011, and the USPTO again refused Tam’s application under § 2(a). The examiner acknowledged that “even though Mr. Tam may have chosen the mark to ‘reappropriate the disparaging term,’ . . . a substantial composite of persons of Asian descent would find the term offensive.”

Tam appealed to the Federal Circuit after the Trademark Trial and Appeal Board affirmed the examiner’s refusal to register the mark. A Federal Circuit panel affirmed the TTAB’s finding that the mark was disparaging. In addition, based on binding precedent from 1981, the panel upheld the constitutionality of Section 2(a). The Federal Circuit *sua sponte* vacated the panel opinion, and ordered rehearing of the case *en banc*.

On Dec. 22, 2015, the Federal Circuit held *en banc* in *In Re Simon Shiao Tam* that the disparagement provision of Section 2(a) of the Lanham Act is unconstitutional in violation of the First Amendment. Writing for the majority, Judge Moore explained, “The government cannot refuse to register disparaging marks because it disapproves of the expressive messages conveyed by the marks. It cannot refuse to register marks because it concludes that such marks will be disparaging to others.” After considering the provision under both strict scrutiny and intermediate scrutiny, the court concluded that, in either case, the disparagement provision fails to pass constitutional muster.

The Supreme Court granted certiorari in the case, and on June 19, 2017, held 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.”

Many speculated that a victory for Tam would pave the way for reinstatement of the trademark for Washington’s professional football team, the Redskins. Six REDSKINS trademarks were cancelled in 2014 by the TTAB, based on the determination that the term disparages Native Americans. The TTAB’s decision was upheld in July 2015 by the U.S. District Court for the Eastern District of Virginia and appealed to the Fourth Circuit in *Pro-Football, Inc. v. Amanda Blackhorse et al.*

### IMPORTANT DATES

- June 19, 2017 – Supreme Court decision
- Jan. 18, 2017 – Supreme Court hears arguments
- Sept. 29, 2016 – Supreme Court grants certiorari
- Dec. 22, 2015 – Federal Circuit issues *en banc* decision
- April 20, 2015 – Federal Circuit issues panel decision

#### **COURT DOCUMENTS**

- Supreme Court decision
- Supreme Court arguments transcript
- Petition to the Supreme Court
- Federal Circuit *en banc* decision
- Federal Circuit panel decision

#### **MEDIA**

Banner & Witcoff attorneys are available to answer questions and discuss these cases. Media inquiries should be directed to Amanda Robert (312) 463-5465 or [arobert@bannerwitcoff.com](mailto:arobert@bannerwitcoff.com).