IP Alert: The Slants Perform at the Supreme Court

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On January 18, 2017, the Supreme Court heard oral argument in Michelle K. Lee v. Simon Shiao Tam. The Supreme Court was the latest stop on The Slants's federal-court tour as the dance-rock band seeks to register a federal trademark on their provocative name. While the justices were not outside the Court taking selfies with the band—in contrast to the band's groupies—their critical questions for the U.S. Patent and Trademark Office (USPTO) hinted that they might be fans of the band's free-speech claim.

Background

Simon Tam, who founded the band in 2006, first submitted a trademark application for THE SLANTS in 2010. The USPTO refused the application based on "the mark [being] disparaging to people of Asian descent under § 2(a)" of the Lanham Act, which prohibits registration of immoral,

deceptive, scandalous, or disparaging trademarks. On appeal, the Trademark Trial and Appeal Board affirmed the examiner's refusal to register the mark.

Tam appealed to the Federal Circuit, where a three-judge panel affirmed the Board and, based on binding Federal-Circuit precedent, upheld the constitutionality of Section 2(a). The Federal Circuit sua sponte vacated the panel opinion, and eventually issued a 9-3 en banc opinion reversing the panel, holding that Section 2(a) is unconstitutional under the First Amendment. The Supreme Court granted certiorari on September 29, 2016.

Oral Argument

The Court had an active bench, with all of the justices—except for a characteristically silent Justice Thomas—sounding out both sides. The first question from the justices was about government registration of copyrights, and the USPTO quickly conceded that "it would be unconstitutional to deny copyright protection" to objectionable material.

Justice Kagan spent a lot of time questioning the USPTO about why the prohibition on disparaging trademarks is not "a fairly classic case of viewpoint discrimination." At one point, she characterized the USPTO's defense of the statute based on the fact that "it sweeps with such a broad brush" as being "like saying it does so much viewpoint-based discrimination that it becomes all right."

The other justices used similarly strong language with the UPSTO. Justice Kennedy analogized the government to "the omnipresent schoolteacher." Chief Justice Roberts added that "the scope of the government program" is a relevant consideration, and that this case is "about the entire trademark program."

Justice Alito suggested a hypothetical involving police and fire protection for the general public, pointing out that the government cannot say, "we're going to provide protection for some groups, but not for other groups." Justice Kagan added that such an action would be especially proscribed "if the nature of the distinction was based on the person's speech."

The first question for Tam was from Justice Kennedy, who said, to laughter in the Court, "[t]he First Amendment protects absolutely outrageous speech insofar as trademarks are concerned. . . . I think you have to take that position." Tam agreed, and maintained a similarly hardline position for much of the argument. The justices seemed concerned about the potential repercussions of striking down Section 2(a), and were not always satisfied with Tam's answers.

For example, after Tam told Justice Breyer that the hypothetical trademarks "Joe Jones is a jerk" or "Smith's beer is poison" could not be stopped, Justice Breyer responded, "Oh, my goodness." But Justice Ginsburg quickly lightened the mood with an interjection about trademarking "a slogan that has one of George Carlin's seven dirty words."

In another exchange, Justice Kennedy asked Tam whether his position was that the government should “treat trademarks just like we treat speech in a public park.” Justice Kagan continued that line of questioning, pointing out that trademark registration is different from the park, since the trademark program “provides certain benefits that the government doesn’t have to provide at all.”

Toward the end of Tam’s time, he seemingly placated Justice Breyer by affirming that his position would not “suddenly open[] the door to striking down all” the desirable government programs the justices had previously asked about. Tam further rebutted the government’s position by explaining that “disparaging messages in trademark do not interfere with [identifying] the source,” the purpose of the Lanham Act. Instead, Tam argued, “what the government objects to is” the mark holder’s use of the mark “to convey a different message.” This attempt to limit the “other message” conveyed by a mark, Tam continued, is impermissible viewpoint discrimination under the First Amendment.

Conclusion

Based on the nature of the Court’s questions, Tam has better-than-even odds at victory. The justices were deeply skeptical of the government’s position, while Tam was seemingly able to assuage the Court’s concerns. The Washington Redskins football team’s trademark dispute—which also deals with Section 2(a) of the Lanham Act—is currently on hold at the Fourth Circuit, pending the outcome of Tam’s Supreme Court case. The Court will likely issue a decision within a few months, but no later than June 2017. Banner & Witcoff will provide analysis of the decision when it is issued.

A transcript of the oral argument is available here.

A downloadable version of this article is available here.

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