

# TRADEMARK TALK

## Lee v Tam

Gregory J Chinlund and Michelle Bolos explore *The Slants* case and the fate of the Lanham Act's 2(a) provision



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**The Supreme Court of the US (“SCOTUS”) will finally address the long standing controversy surrounding section 2(a) of the Lanham Act, which provides that a trademark cannot be federally registered if it “[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...”<sup>1</sup>** The dispute, currently before SCOTUS in *Lee v Tam*, began when Simon Tam sought to register the mark THE SLANTS in connection with his all-Asian dance-rock band. The US Patent and Trademark Office (“USPTO”) rejected the application claiming the mark was disparaging to the Asian community. In refusing registration, the USPTO cited evidence showing the term, ‘Slants’, has long been used to mock a physical feature of persons of Asian descent.

Despite Tam’s insistence that his intent is to reclaim the term and celebrate Asian heritage, both the Trademark Trial and Appeal Board (TTAB), and initially the US Court of Appeals for the Federal Circuit (CAFC), agreed with the USPTO. However, the CAFC reheard the case *en banc* and ultimately found the prohibition against registering “disparaging” marks to be content and viewpoint discriminatory, and thus unconstitutional.

Although *Lee v Tam* is the first case to present this issue to SCOTUS, the section 2(a) controversy has been circulating among the lower courts since 1992, when Suzan Harjo *et al* sued Pro-Football for use of the term Redskins, claiming it is disparaging to Native Americans.<sup>2</sup> However, the laches defence ultimately won the day for Pro-Football because Harjo *et al* could have initiated the case decades before, given the challenged marks were registered in the 1960s when all

of the plaintiffs were adults capable of filing suit. Recently, Amanda Blackhorse revived the fight, and this time around the case includes younger plaintiffs whose claims are not barred by laches. Blackhorse and Pro-Football have been embroiled in litigation since Blackhorse successfully convinced the TTAB to cancel several of the Redskins registrations based on the fact the marks are disparaging to Native Americans.<sup>3</sup> Blackhorse and Pro-Football urged SCOTUS to hear the *Redskins* case together with *The Slants* case given the identical issues involved. The request was denied and arguments in *The Slants* case were heard on 18 January 2017.

The issue before the court is whether the prohibition of registration for disparaging marks is facially invalid under the Free Speech Clause of the First Amendment. The government argued, among other things, that first, there is no deprivation of free speech because Tam is not estopped from using and advertising THE SLANTS, he is merely denied the protections afforded by federal registration. Secondly, the government points to the fact that the US publishes applications and issues registration certificates. As a result, the public and foreign countries subscribe to the notion that trademarks are endorsed by the government. Accordingly, the federal trademark system is a government programme, and as such, the government can legally limit access to the programme without violating the right to free speech. However, the court reminded the government that even if trademark registration were deemed a government programme, it still cannot make distinctions based on viewpoint.

All the while, Tam claims that section 2(a) violates the right to free speech because the statute is viewpoint discriminatory. The court

pushed back on Tam’s assertion that the right to free speech is burdened in the traditional sense, given the fact that Tam can continue to use THE SLANTS name whenever and wherever he wants. Further, in response to the government’s argument, Tam argued that federal registration is akin to a regulatory regime, not a government programme, and thus must comply with the First Amendment.

### Comment

Ultimately, the decision should also determine the outcome of the Washington Redskins’ decades-long battles. Quite possibly, the decision could forever change the analysis surrounding “immoral” and “scandalous” marks as well, registration for which is also currently prohibited by section 2(a), but nearly forgotten among the rhetoric surrounding these high profile cases. Critics of the statute hope SCOTUS agrees with the CAFC and finds section 2(a) unconstitutional. The desire is spurred on, at least in part, due to frustration from the USPTO’s inconsistent and seemingly arbitrary analysis when examining arguably immoral, scandalous, and disparaging marks. This decision has potential to be one of the most monumental changes in trademark law in decades. While trademark practitioners are anxiously awaiting the decision, nobody has more “skin” in the game than Pro-Football given the value of the Redskins brand, which will likely learn the fate of its registration when *The Slants* decision is announced.

### Footnotes

1. 15 USC § 1052(a).
2. *Pro-Football, Inc v Harjo*, 415 F3d 44 (DC Cir 2005).
3. See *Pro-Football, Inc v Blackhorse*, 112 F Supp 3d 439 (ED Va 2015).

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