

The Curious Case of “The Slants”

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It isn't every day that we see the Supreme Court take on a case that sits at the intersection of trademark law and the First Amendment. But that intersection has been getting more and more attention in the last few years, largely as a result of increased protests over the use of offensive or demeaning names by popular sports teams. Perhaps the most famous dispute involves the National Football League's Washington Redskins, a name that many say is an affront to Native Americans. The Redskins's use of that name, and the protection of the exclusive use of the name through U.S. trademark law, not only means that the team has a unique identifier, protected by federal law, that tells all who see it that “The Redskins” refers to the NFL team in Washington, D.C., it also means that the team can license the use of the name and capitalize on merchandising worth millions of dollars.

But if the name is offensive, should the U.S. government extend protection of it through a trademark? That's the question now before the Supreme Court, in a case brought not by the billion-dollar NFL franchise, but by a singer named Simon Tam.

Background

Tam is the front-man for an all-Asian-American dance-rock band. He formed the band in 2006 to play music and at the same time to express his views on discrimination against Asian-Americans. When Tam turned to name the band, he sought to embrace a term that has been used as a racial insult against Asian Americans, “slant.” Tam called his band “The Slants.”

By using this name, Tam drew on a tradition called “re-appropriation.” Re-appropriation is when members of a minority or marginalized group reclaim terms that have been used to insult or stigmatize them and redirect those terms to use them as badges of pride. Re-appropriation of a term can empower members of a group, because it means that the group takes ownership of the term, re-defines it, and thus controls the use of the term. But it can also

neutralize the term for others outside the group (for example, those who use the term derisively), because successful re-appropriation redefines the term to take the insult out.

So Tam's use of the name “The Slants” is designed to make a political statement. But that's not the group's only political statement. The group also produces music with lyrics that advocate for Asian pride and promote cultural heritage. And the group has used album names that re-appropriate derisive terms, like “Slanted Eyes, Slanted Hearts” (the group's first album) and “The Yellow Album” (the group's fourth). In other words, Tam seeks to make statements about Asian pride and heritage not only through the band's name, but also through its entire work. (For more on The Slants, check out their website, at www.theslants.com.) The Slants's political statements are part and parcel of the group's identity, and the group intends that its name convey a political message.

In 2011, Tam sought to register the name “The Slants” as a U.S. trademark with the U.S. Patent and Trademark Office (the PTO). Under the Lanham Act, the law governing trademarks, fed-

eral registration would give Tam and his group the right to exclusive, nationwide use of the name “The Slants” where there was no prior use of that name by others. Federal trademark registration would also mean that Tam could sue in federal court to enforce the trademark; he could obtain the assistance of U.S. Customs and Border Protection in restricting the importation of goods that infringe on the mark; and he could qualify for a simplified process for obtaining protection for the mark in countries that have signed the Paris Convention, an international treaty providing for the protection of trademarks. Finally, federal registration under the Lanham Act would give Tam a complete defense to state or common law claims of trademark dilution. (This means that a state court could not hold Tam liable for using “The Slants,” even if another person or group had protection for the use of “The Slants” under state law.)

But the trademark examiner rejected Tam's application and refused to register “The Slants.” The examiner said that the name was likely to disparage persons of Asian descent, in violation of Section 2(a) of the Lanham Act. Under that Section, the PTO cannot register a mark that “[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, institutions, beliefs, or national symbols, or bring them into contempt or disrepute.” The PTO has used this Section to deny or cancel “disparaging” marks such as Stop the Islamisation of America, The Christian Prostitute, Marriage is for Fags, Democrats Shouldn't Breed,



Members of the Asian American dance-rock band The Slants.



Simon Young (also known as Simon Tam) at the Supreme Court.

Republics Shouldn't Breed, and others. Perhaps most famously, the PTO used Section 2(a) to cancel six trademarks of the Washington Redskins NFL football team (although this decision is now on appeal and may be affected by Tam's case). The Trademark Trial and Appeal Board agreed with the examiner's decision and affirmed the decision to deny Tam the mark under Section 2(a).

Tam then appealed to the U.S. Court of Appeals for the Federal Circuit. Tam claimed that Section 2(a) of the Lanham Act and the PTO's denial of his application violated his free-speech rights under the First Amendment. The court ultimately agreed, but the government appealed to the Supreme Court.

The Law

Tam's case is difficult, because it does not fit squarely within any settled First Amendment doctrine. In other words, hornbook First Amendment rules don't apply easily to trademark registration and Section 2(a)'s restrictions, and it is not at all clear how they might govern this case.

For example, it is well-settled First Amendment doctrine that the government can say (or not say) whatever it wants—and therefore can restrict itself from saying disparaging things. But trademark registration is not purely government speech. Registration is *part* government speech (because the government itself publishes registered trademarks), and *part* merely a government *program*

or *benefit* for others' speech. As a result, registration doesn't fit squarely within this rule.

Another example: The First Amendment prohibits government from restricting speech, but it does not compel government to support speech. Indeed, government has no obligation to actively support speech at all. Trademark registration is not obviously either a government restriction on speech or government support for speech; it looks a little like both. Because trademark registration straddles this divide, it is not at all clear how, or if, this basic First Amendment rule applies.

Yet a third: Under the First Amendment, the government cannot restrict speech based on its content, or, in a government program, based on its viewpoint. The government therefore cannot restrict speech that is disparaging, while allowing speech that is not disparaging; that is a textbook example of viewpoint discrimination. But trademark registration is different than most government programs, in that the principal purpose of trademark registration is not to protect the *message* of the mark; it is merely to identify who is the producer. (Contrast that with copyright, where the purpose is to protect the *content* and the *message* of the work.) At the same time, however, many trademarks clearly have a communicative element that in any other context would enjoy First Amendment protection. (Think, for example, about Nike's "Just Do It." This both identifies the producer and communicates a mes-

sage.) Because trademarks have both an identifying element and a communicative element, it is not clear whether and how a ban on viewpoint discrimination might apply.

Finally, the Constitution prohibits the government from applying vague standards in regulating speech. But again, trademark registration isn't a traditional government *regulation* on speech. It operates more like a government program or benefit for speech.

Arguments at the Court

Because the case doesn't fit well into traditional First Amendment doctrines, the arguments feel a little like forcing a square peg into a round hole. Still, the parties frame their arguments around the bedrock First Amendment principles described above, and struggle to fit this case into settled doctrine.

The government argues that Section 2(a) does not violate the First Amendment, because it does nothing to restrict Tam's speech. In short, Tam can use "The Slants"; he just cannot get trademark protection for it. The government says that laws that *restrict* speech may violate the First Amendment, but that federal programs that *subsidize* speech (like the Lanham Act) cannot. Indeed, the government claims that it need not subsidize speech at all, if it doesn't want to. But if it does, it can "decide which activities to fund and what criteria to use for inclusion in the government program." The government points to one well-set-

tled precedent upholding the denial of federal tax-exempt status for non-profit organizations' lobbying activities and another sustaining federal regulations that prohibited the use of family-planning funds for abortion-related services. The government says that this case is no different: federal trademark registration is a government program, just like tax-exemption and federal funding, and the government can choose who can participate in any way it likes.

The government argues next that Section 2(a) is not an impermissible viewpoint-based restriction on speech. Instead, it says that Section 2(a) simply sets out criteria for a government benefit in a way that the Court has upheld. The government contends that Section 2(a)'s criteria serve legitimate government interests not to encourage the use of disparaging terms and to disassociate itself from racial slurs and other offensive speech. In short, "[t]he Constitution does not put Congress to the choice of either eliminating the federal trademark-registration program altogether or promoting the use of racial slurs in interstate commerce."

In response, Tam argues that Section 2(a) creates an impermissible viewpoint-based burden on speech. Tam says that Section 2(a) permits the registration of marks that express a positive or neutral view, but not those that express a negative view. He claims that the government's only interest is in protecting people from offensive trademarks, and that this interest is not sufficiently compelling to jus-

tify the viewpoint-based burden.

Tam argues further that trademark registration is not a government subsidy or program, because (unlike the subsidies in the Court's precedents) it involves no actual disbursement of funds. He claims that registration does not amount to government speech, because the speech involved is by the markholder, not the government. And he contends that trademarks are not commercial speech subject to certain government regulation (and he says that it would fail the commercial speech standard, anyway).

Tam argues next that Section 2(a) is inherently vague—what does “disparaging” mean?—and that the PTO has applied the provision inconsistently. He claims that the PTO's methodology, which considers whether a name disparages an entire racial or ethnic group, only compounds the problem, because the PTO does not have a determinate way to measure whether and how a name disparages an entire group. Tam contends that Section 2(a), as a vague restriction on speech, chills speech, and facilitates discriminatory enforcement. He claims that it is therefore unconstitutional.

Finally, Tam argues that Section 2(a) does not bar registration of “The Slants,” even if Section 2(a) is constitutional. Tam says that “The Slants” is not disparaging under Section 2(a); instead, it is exactly the opposite—a re-appropriated term used as a badge of pride. He asserts that the PTO was wrong to deny registration based on whether “The Slants” disparages an entire racial or ethnic group. He

claims that the Act requires the PTO instead to apply Section 2(a) only when a name disparages “persons,” not groups. “The Slants,” he says, does not meet this test.

Oral Arguments

It's always difficult to predict a result in a Supreme Court case based on oral arguments, and that's perhaps especially true here. That's because the justices focused on all of these issues, with aggressive questions for both parties, with few clear signs of how they were leaning. It's also because this case does not necessarily divide the justices along conventional ideological lines.

In questioning the government, the justices focused particularly on the viewpoint-based criteria under Section 2(a). They also asked about the purposes of trademark protection, wondering whether the Lanham Act was designed to protect a markholder's substantive message, or just to identify the holder. (If the former, the First Amendment is more likely to restrict the government.)

In questioning Tam's attorney, the justices focused on the nature of trademark protection. Is it government speech? Is it a government program? Or is it more like a forum for speech, like a park, or a university campus? The answers to these questions will tell whether Section 2(a)'s viewpoint-based criteria can stand up to First Amendment scrutiny.

But despite the active questioning at oral argument, the Court gave few signs of how it is likely to rule.

Discussion Questions

What is a trademark? Why might an individual or a group (e.g., sports teams, bands) want to trademark their name? What protections does trademarking afford?

Do you think it is appropriate for groups (e.g., sports teams, bands) to have names that some people might find offensive? If a name has been used for a long time, as in the case of the Washington Redskins, does that make a difference? More, or less, acceptable?

Do you think the federal government should offer trademark protections to a group's potentially offensive name? Do you think the First Amendment protects a group's right to name themselves? To trademark that name?

If a group is “reappropriating” a term, should that be taken into consideration during the trademark application process, as in the case of “The Slants”?

Do you think the government's current criteria to avoid “disparaging” trademarks are adequate? If not, what criteria might replace them?

Implications

However the Court rules, the case will have significant implications that sweep well beyond Tam's claim to trademark "The Slants." As mentioned above, the Redskins' case is currently in the lower courts. A federal judge upheld the PTO's cancellation of the Redskins' trademarks, ruling that "Redskins" was disparaging to "a substantial composite of Native Americans" when each of the marks was registered. The Redskins appealed, but the case is on hold pending the outcome of Tam's case. (The Redskins asked the Supreme Court to review their case along with Tam's, but the Court declined.)

The Redskins' case illustrates the high stakes involved to markholders: Losing federal trademark protection would mean that markholders could not protect their marks against others' uses in the federal system, potentially costing markholders substantial revenue and exclusive name rights. In the Redskins' case, this could mean millions of dollars in lost licensing fees and merchandising, because others could use the name without fear of federal trademark enforcement actions.

But at the same time, denial or cancellation of federal trademark protection does not mean that a person cannot use the name. Tam could still use "The Slants," and the Redskins could still use "The Redskins," even if they do not receive federal trademark protection. They simply would not get the benefits of federal trademark protection. Moreover, individuals could still seek trademark protection at the state level. But this would provide protection only within the state, not nationwide. Moreover, states may have restrictions similar to Section 2(a), so that Tam, the Redskins, and others might not qualify at the state level, either.

Although most of the arguments in the case center on the free speech issues, the Court could rule on narrower grounds. In particular, the Court could simply rule that the PTO misapplied Section 2(a) in rejecting Tam's application. (Tam sets the stage for this kind of ruling by

arguing that the PTO erroneously considered disparagement to a group, not to "persons," in evaluating his application.) If so, the Court could simply remand the case with instructions on interpreting Section 2(a), without ruling on its constitutionality. This kind of ruling could limit the application of Section 2(a), but it would not strike the provision.

If the Court engages the constitutional arguments, look for the Court to determine as an initial matter whether the First Amendment even applies. The Court could dodge the harder constitutional issues simply by ruling, as the government argues, that Section 2(a) does not impose a burden on speech, because trademark registration is a benefit or subsidy, and because Section 2(a) does not restrict speech. If so, the Court would uphold Section 2(a), although it might limit it, as above.

If the Court sees Section 2(a) as a burden on speech, however, the Court

is almost certain to rule in Tam's favor, striking down the provision as unconstitutionally vague or as a viewpoint-based restriction on speech. (The Court has consistently expressed its distaste for content-based restrictions on speech in recent years. Viewpoint-based restrictions are even more suspect.) In either instance, a ruling on the constitutional issue is likely to have major implications for intellectual property law. 🌐

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