

Slants, Redskins and Other “Disparaging” Trademarks

By Ron Coleman

Item, per NPR News:

An Asian-American rock-band with an eyebrow-raising name has scored a big victory in the Court of Appeals for the Federal Circuit.

[The court ruled](#) that their name—The Slants—is private speech and therefore protected by the First Amendment. The government, the court writes, has no business trying to regulate it by denying the band a trademark.

At issue in the case was [Section 2\(a\)](#) of the Lanham Act, which allows the U.S. Patent and Trademark Office (PTO) to deny or cancel a trademark if it is "disparaging" of persons, institutions or national symbols.

In a 10-2 decision, the court decided parts of that section were unconstitutional. Conferring a trademark, the court argues, does not make the band's name government speech.

Here's the comparison the majority uses: "The PTO's processing of trademark registrations no more transforms private speech into government speech than when the government issues permits for street parades, copyright registration certificates, or, for that matter, grants medical, hunting, fishing, or drivers licenses, or records property titles, birth certificates, or articles of incorporation."

Shortly after I published the blog post about The Slants, I was on the phone with their frustrated trademark counsel, and agreed to accept what turned out to be the opportunity to change the law I was criticizing this series of pieces.

I've been writing about the Redskins football team and the tribulations—and, as it turns out, trials—of their REDSKINS trademark on [“Likelihood of Confusion”](#) since almost the beginning of the time I started blogging on intellectual property and free speech issues in 2005. It wasn't until 2011 that, following up on that theme, I wrote a post about the Patent and Trademark office's refusal to register the trademark THE SLANTS for an obscure “Chinatown dance band” from Portland, Oregon and linking to earlier posts that asked why ethnically “disparaging” marks such as HEEB and NIGGA were deemed unacceptable under Section 2(a)

(Continued on page 8)



MLRC Forum panelists discussing, among other topics, the Slants and Redskins trademark registration cases. Left to right: Jeff Hermes, MLRC; Gayle C. Sproul, Levine Sullivan Koch & Schulz, LLP; Nani Jansen, Media Legal Defence Initiative; Lee Rowland, ACLU's Speech, Privacy and Technology Project; Andrew Losowsky, The Coral Project at Mozilla; and your author Ronald D. Coleman, Archer & Greiner P.C.

(Continued from page 7)

of the Lanham Act despite applicants' claims of "reappropriation" while marks such as DYKES ON BIKES were allowed.

Shortly after I published the blog post about The Slants, I was on the phone with their frustrated trademark counsel, and agreed to accept what turned out to be the opportunity to change the law I was criticizing this series of pieces. At the time, however, I hardly anticipated that this was the assignment I was accepting. In retrospect, however, and as I came to understand only when I read the *en banc* decision in *In re Tam*, this outcome—the invalidation of the "disparagement" prong of the statute under the First Amendment—was actually the only way anything useful could be achieved by my efforts.

To understand why I say that, it is helpful to consider what I wrote when the original TTAB decision was issued in the NFL's appeal of the PTO's unprecedented retroactive cancellation of its REDSKINS registrations under Section 2(a) in the Blackhorse *inter partes* cancellation proceeding on Likelihood of Confusion:

The opinion is remarkably thorough and is ultimately grounded in what appear to be mountains of carefully sifted, weighed and analyzed factual evidence developed through years of litigation. In this respect it certainly represents, even if arguably at the high end, the sort of careful evidentiary record that ought to form the basis of a section 2(a) denial. Yet it is significant that the dissenting judge came to a different conclusion from that of the majority about the key issue factual issue as determined by the panel, i.e., whether the registration ran afoul of section 2(a) at the time the mark was registered.

The question of going back in time to make such determinations is inherently rife with problems, and the TTAB did not really wrestle with them. Arguably it was not within their scope of review to do so. While the goal of avoiding offense by government actions such as trademark registration is laudable, achieving that goal seems more than ever to embroil

(Continued on page 9)

(Continued from page 8)

agencies and judges in deciding highly-politicized and sensitive issues that are arguably not appropriately determined by either. Adding “time travel” to their task only makes it more onerous.

Moreover, not all section 2(a) refusals merit the level of factual inquiry and careful analysis of evidentiary issues on display in the REDSKINS appeal. Most applicants have neither as much at stake the Washington Redskins did here nor the budget to apply to defending their registration. The care and effort invested in the TTAB’s decision here reflected these unusual factors, but unfortunately not every 2(a) dispute that comes to it can expect such well-developed treatment of the issues and evidence.

Finally, the policy question of whether a registration should be revoked retroactively, after decades of use by the registrant following allowance and evidently with no time limit—as long as the evidence is found to support a contemporaneous finding of disparaging meaning—is probably one that Congress should address. Its application in this case, regardless of the merits under the standards applied by the TTAB, is certainly troubling.

It’s not too daring to suggest that after *In re Tam*, this analysis can only stand on firmer ground. Speculation abounds, of course, as to just how firm, and whether the Fourth Circuit, where Blackhorse is now pending, will go as far as the Federal Circuit did in *In re Tam*; and, whether it does or not, what the ultimate fate of both or either decisions will be.

I write now to bury neither case but to praise one. I am, of course, biased, but not in the way I thought I would be when I began this adventure, or even when I began reading the en banc opinion in *In re Tam* despite knowing the outcome.

Now, first, it must be said that there are many problems related to the practical application of Section 2(a) policy and practice that are not addressed by the majority opinion in *In re Tam*. The academic literature is rich with discussion of them, but for easier reading, *see*, Ronald D. Coleman, “The Policy and Constitutional Challenges to Contemporary Application of Section 2(a) of the Lanham Act,” CLE Supplement, PTO Day Program—Trademark Track, Session: Federal Registration of Disparaging, Immoral and Scandalous Marks, March 10, 2015, (available at <http://www.jdsupra.com/legalnews/the-policy-and-constitutional-challenges-12146/>). It is also worth looking at the concurrence of Judge O’Malley, who deals with some of the constitutional “vagueness” issues raised in the majority opinion as First Amendment problems in the Fifth Amendment context, which is are getting insufficient attention in the popular and even the legal press. These are serious concerns, especially for people with trademarks and lawyers who people engage to protect them. These issues are beyond the scope of this essay, however.

And what would be the basis for the Fourth, or any other federal circuit court, to depart from the Federal Circuit’s direction on an issue of trademark law?

(Continued on page 10)

(Continued from page 9)

Most of the commentary being published on the question of the day—how will “the Slants case” affect “the Redskins case”—appears to be a variation on this formulation: “The Federal Circuit is very prestigious / influential / persuasive on trademark matters, but the Fourth Circuit is not bound by it one little bit, and a split is possible. And if that occurs—and it probably will, then Supreme-Court-ho!”

For some reason, “if that occurs” in these analyses always seems to become “it probably will.” This is, evidently, something people write to make their blog posts or newspaper columns exciting. But while reasonable people may disagree with the reasoning of the majority opinion *In re Tam*, it is hard to see how exactly the Fourth Circuit would find a way to justify concurring with the new holding of the Federal Circuit. While, as a threshold matter, the vast majority of appeals from district courts are (for better or worse) affirmed, this is a case of considerable prominence, in which a sister circuit, and a highly respected and influential one, has spoken definitively. And what would be the basis for the Fourth, or any other federal circuit court, to depart from the Federal Circuit’s direction on an issue of trademark law? Notwithstanding the truism that each circuit is independent in its own realm, at the same time every circuit that has ruled on this issue has, even if citing its own precedent, ultimately done so on the basis of *In re McGinley*, 660 F.2d (C.C.P.A. 1981).

But *McGinley* was, of course, decided by the very court that is now called the Federal Circuit. And it is no longer good law. Moreover, the fundamental reason it is no longer good law is not, with all due respect to the “wither *stare decisis*?” plaint of Judge Louire in dissent, not a result of an arbitrary policy decision by the *en banc* majority. Rather, it is a result of vast changes in First Amendment jurisprudence originating in the United States Supreme Court, not in the Federal Circuit.

The Federal Circuit’s reconsideration and abrogation of *McGinley* is also premised on changes to the Lanham Act that affect the way the Trademark Office is funded, which has, since the time *McGinley* was decided, changed from a “taxpayer-funded” to a “user-funded” basis. This technical distinction is significant, because the *McGinley* court relied on it. It may yet turn out to be an important part of future appellate consideration of *In re Tam*, *Blackhorse*, or some consolidated version of the two cases. Either way, this, too, is an ineluctable fact with which no court could disagree, reasonably or otherwise.

So on what basis, exactly, could the Fourth Circuit going to base its disagreement with at least the outcome in *In re Tam*?

One should be not be naïve. Courts, as we see, can be full of surprises. But from a flat-footed survey of the jurisprudential landscape, far from assuming an impending circuit split, the presumption should be the opposite. It is not clear from what well the Fourth Circuit would be drawing in rejecting the holding of *In re Tam*—how it could rely on the very precedent that

(Continued on page 11)

(Continued from page 10)

that case rendered invalid and leapfrog over the considerable body of First Amendment jurisprudence on which the majority based its opinion.

What, then, about the concurrence and the dissents? By most lights, in these are to be found raw material the PTO and the *Blackhorse* will use to sway the judges on the Fourth Circuit that the Federal Circuit was wrong about its own precedent. How exactly those arguments could be reworked for the benefit of the *Blackhorse* plaintiffs, who are not in identical shoes to those of the government in *In re Tam*, remains to be seen. But for purposes of this discussion, and given my limitations in discussing the details of legal arguments our client may yet have to submit, I would rather come back to my opening comments, and the passage from my earlier post. For in the course of this process I came to learn why this is, after all, not the administrative law, intellectual property or law of evidence appeal that I thought it was. Ironically, however, to see why I say this requires some familiarity with the underlying procedural history of *In re Tam* and the underlying PTO record.

To understand what is at work in *In re Tam* and in the battle of Section 2(a), one has to dig deeper even than the first round of Federal Circuit briefing, where, as a matter of decorum, the appellate team decided to tread more lightly than we had at the agency level. Thus we omitted passages such these, which were included in the brief submitted to the TTAB (emphasis added):

The Examining Attorney’s rationale turned the entire policy justification for Section 2(a) on its head. It was a refusal to register based on the ethnic background of Applicant and his associates that was offensive. Unless reversed by the Board this formulation inevitably will involve the Patent and Trademark Office in inappropriate and constitutionally suspect inquiries concerning the ethnicity of applicants, their associates and their activities. . . .

The refusal here was explicitly, and improperly, premised on the ethnic identity of Applicant and the other members of his band. “Here,” wrote the Examining Attorney, explaining the “association” between the mark and the Asian community, “applicant is a founding member of a band . . . composed of members of Asian descent. . . . [The] association of the term SLANTS with those of Asian descent is evidenced by how Applicant uses the mark – as the name of an all Asian-American band.” By the Examining Attorney’s logic, the same exact application submitted by a non-Asian would be entitled to registration. THE SLANTS, the PTO admits, is not inherently offensive, as, for example, HEEB and SQUAW are. THE SLANTS could be registered as a trademark – just not by Asians. It should go without saying that the law does not support refusal of registration based on the ethnic descent of an applicant, such as occurred here.

The Lanham Act is silent as to how many Asian members of The Slants would need to be fired from the band to avoid offending Asians by registration of this trademark.

(Continued on page 12)

(Continued from page 11)

Indeed, it is no less troubling that the Examining Attorney noted that there was no “rebuttal” to his assertion that The Slants were an “all Asian-American” band. The only possible “rebuttal” would have been a submission proving that the band was not entirely Asian and hence entitled to registration, a patently offensive proposition. In any case, the standard to which such “evidence,” if submitted, would have been applied is unclear, for the Lanham Act is silent as to how many Asian members of The Slants would need to be fired from the band to avoid offending Asians by registration of this trademark.

This language is gone, but the point did remain through the first round of briefing in the Federal Circuit.

Now, there is another, related point: The entire basis of the finding that THE SLANTS was disparaging—whether the supposed statements of Simon Tam; his ethnic identity; the makeup of his “Asian-American band”; the ethnic-associated use of THE SLANTS—was anywhere in the evidentiary record of the application to register THE SLANTS from which the appeal that *In re Tam* originated. It all was from a previous application, alluded to vaguely in the opinion, which does not address, however, the fact that all the evidence on which its finding of disparaging meaning was premised is found in that original, abandoned, 2010 application.

The back story: When The Slants called me up in 2011 because of the blog post, I looked at their pending (2010) application, and knew that it was doomed under Section 2(a). This view was not one I came to in spite of my blog writing about disparaging marks but **because** of what I had observed in the process of researching and writing them, as well as considering cases that had come my way from prospective clients related to the issue. I saw how the PTO was treating “disparaging” marks and it was clear to me that there was inconsistency and what could only be described as an essentially “politically correct” agenda, permitting “reappropriation” for some groups and not for others.

Indeed, I had written a blog post called “Jiggering it out at the PTO,” which focused on the PTO’s rejection of an application by *Heeb* magazine to register the mark HEEB on the grounds that it was disparaging to Jews, despite their “reappropriation” argument and despite the fact that the same applicant already had a live registration for other goods of the trademark... HEEB. (Found at <http://www.likelihoodofconfusion.com/jiggering-out-the-pto/>). It was clear to me, I wrote, that while once-disparaging terms for homosexual and other people could be reappropriated, this could never be the case for ethnic and racial slurs for the simple reason that the PTO was, quite understandably on a certain level, building a wall around the one trademark it absolutely, positively could never register:

In short, *bubbele*, the PTO — which has found a way to register numerous terms once considered derogatory when referring to those, fabulous or otherwise, who have adopted non-standard sexual practices — can’t open this Pandora’s box. The PTO acknowledges, implicitly, the objectively demonstrable fact that words that once shocked and offended are

(Continued on page 13)

(Continued from page 12)

now ironic, defiant playthings of the hip, comfortably assimilated (in a multi-culti way) descendants of the former targets of some kinds of opprobrium. But the PTO ignores this fact when it comes to trademarks for kikes, *shvartsers* and the rest of us.

Get the point? “Hip.”

Well, it doesn’t ignore it, or the inconsistency involved, so much as hide behind a thick lens of pretended obtuseness, relying on “proof” of offensiveness such as outdated dictionaries and statements by such cultural barometers as the Anti-Defamation League.

No, it’s okay to “get it” when it comes to alternative-lifestyle terminology. But the PTO is, as we said, boxed in on the issue of racial slurs. For it is above all terrified of the prospect of what would happen politically if it issued a NIGGA or NIGGER trademark registration for anything, anyone, any time.

And if they can’t have theirs, the Jews can’t have ours, either. Sorry, my heeb.

And that, it seemed, was the way it was. For while later in my career I have had some good moments fighting off baseless trademark infringement claims based on what were essentially free speech claims clothed in trademark language—i.e., “no one could be confused by this”—in cases such as *Boarding Sch. Review, LLC v. Delta Career Educ. Corp.*, 108 U.S.P.Q.2d 1785 (S.D.N.Y. 2013) and *deVere Group GmbH v. Opinion Corp.*, 877 F. Supp. 2d 67 (E.D.N.Y. 2012)—I had given up I gave up trying to throw the First Amendment at the Lanham Act after my unpleasant experience in *Jews for Jesus v. Brodsky*, 993 F.Supp. 282 (D.N.J.), *aff’d*, 159 F.3d 1351 (3d Cir.1998).

In any event, if there was going to be a fight, it was way over the horizon. The lawyerly approach was to let this application die, and file a new one—with no Chinese imagery. “Slants” is a word, and it’s an English word. You’re a band, I told Simon Tam, and it’s your band’s name. Let’s just put in your application for a band called The Slants, use some generic specimens, and get you your registration. That I was willing to do pro bono.

Little did I know that the PTO would not let Simon Tam and the Slants abandon their previous application. And I was astonished when TTAB held, on appeal, that the PTO could determine “trademark use” based on the ethnic identity of the applicant himself and the members of those who use his trademark with him—because, after all, that’s who he really was, and the PTO knew what he really meant when he was applying the second time.

Little did I know, as events developed, that it would take a constitutional wooden stake through the heart of Section 2(a) to kill at least this part of it, right through that frosty morning

I was astonished when TTAB held, on appeal, that the PTO could determine “trademark use” based on the ethnic identity of the applicant himself and the members of those who use his trademark with him—because, after all, that’s who he really was, and the PTO knew what he really meant when he was applying the second time.

(Continued on page 14)

(Continued from page 13)

in Washington when I almost overslept my appearance before the three-judge panel that sprung the constitutional issue on us, to my astonishment.

But now I am quite convinced that this way—the First Amendment based invalidation of the statute—is, indeed, the only way the thing could die, and that it has to die for just these reasons. The PTO could have easily given Simon Tam’s second application a fair shake, but doing so would have, after all, resulted in generation of fresh evidence that he was, in fact, using the mark, THE SLANTS, in exactly the same way as he had been using it at the time of the the first mark—in connection with an Asian-themed band. This is his message. The PTO was sloppy, and insensitively so, in using his ethnic identity, and that of his bandmates, as a shorthand for these facts.

And it is not quite right that the procedural errors and shortcuts we identified in the examination process were not acknowledged by the TTAB or the Federal Circuit which, in its en banc opinion, merely “reinstated” the finding of disparaging meaning based on these errors—which, ultimately, is getting at something of an empirically meaningful ... something ... about a mainly, but perhaps not entirely, obscure ethnic slur—even if the PTO had not come close to meeting its burden to prove it.

No small part of the constitutional problem with Section 2(a) is that it generates just so much procedural legerdemain. It should surprise no one whose experience in advocacy extends beyond hornbooks that the procedural course necessary to get the statute in the appellate sights has itself involved some judicial sleight of hand; the advocates, for our part—and by now it has become quite the team effort—have merely held on to this juridical toboggan, including as it has the unusual and most pleasant, for us anyway, experience of a *sua sponte* vacatur and remand, for dear life with each twist and turn.

And all this is why the Redskins should win in the Fourth Circuit, joining the Federal Circuit and acknowledging that Section 2(a) has provided thrills and spills enough. This is supposed to be trademark law. The courts should, and by the Constitution are bound to, uphold *In re Tam*, eliminate the “disparagement” bar and return the trademark experts of the Patent and Trademark Office to the task for which they are trained and at which they excel, examining trademarks, and relieving them from the hopeless effort of examining hearts.

Ron Coleman is a partner at Archer & Greiner PC and represented The Slants in this matter. This article is based in part on his “[Likelihood of Confusion](#)” blog post entitled “How about those Redskins”

The courts should, and by the Constitution are bound to, uphold *In re Tam*, eliminate the “disparagement” bar and return the trademark experts of the Patent and Trademark Office to the task for which they are trained and at which they excel, examining trademarks, and relieving them from the hopeless effort of examining hearts.