

# Forward to the past: The Slants' attorneys ponder trademark disparagement

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The U.S. Supreme Court will soon issue a decision in the case of *Lee v. Tam*, cert. granted, 137 S. Ct. 30 (2016).

In that appeal, the government has challenged the ruling issued by the U.S. Court of Appeals for the Federal Circuit in *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2016).

The full Federal Circuit said the denial of Tam's application for trademark registration of "The Slants" was unconstitutional because it violated the First Amendment.

At stake is the continued vitality of the disparagement clause of Section 2(a) of the Lanham Act, 15 U.S.C.A. § 1052(a).

That clause authorizes the PTO to prohibit the registration of any trademark that "may disparage ... persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute."

The issue has galvanized support and opposition, but not exactly as one would expect. The positions taken by various interest groups, whether political, ethnic or racial, have not been uniform.

This has made for some unusual bedfellows. Alliances have been forged between the likes of the U.S. Chamber of Commerce and the American Civil Liberties Union, among other unlikely allies.

On the other hand, the same general reference group has expressed conflicting views, with dividing lines drawn between the Korematsu Center and the Pacific Legal Foundation, both representing Asian interests.

Bottom line: Some people take offense, and some do not.

## HOW WOULD THE WORLD LOOK?

What the world would look like if the PTO could no longer reject trademark registration applications on the ground that they "may disparage"?

Would our sensibilities be constantly barraged by an incessant cacophony of offensive language? Would the divisions among us increase? Would our good intentions be able to withstand the onslaught?

There is no conclusive answer to these questions. Instead, there is only speculation and conjecture.

But the same kind of consequential questions could be posed if the PTO were allowed to ban offensive trademarks.

That is, would the government's power to determine the propriety of speech save us from offensive language or socio-political divisions, much less facilitate our best aspirations?

Or would such government control exacerbate the inherent tensions, like a tight lid on a pressure cooker?

The history of the disparagement clause confirms that it was not intended to protect racial and ethnic groups.

The clause was added in 1939 to one of the bills that became the Lanham Act in 1946.<sup>1</sup>

It is very unlikely that members of Congress were concerned about trademarks that were disparaging to racial or ethnic groups in a period when much worse forms of discrimination were common and civil rights legislation was not even on the horizon.

Unsurprisingly, therefore, there is no evidence that the disparagement clause was intended to halt the registration of such trademarks. Rather, when the clause was discussed in Congress, the only examples of disparagement anyone mentioned concerned natural persons such as Abraham Lincoln and George Washington, and juristic persons such as the New York Athletic Club and Harvard University.<sup>2</sup>

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The historical record strongly supports the conclusion that the purpose of the disparagement clause was not to protect minority groups but, instead, to bring American trademark law into conformity with American treaty obligations.

One of the primary objectives of the Lanham Act was, as the House and Senate reports both explained, "[t]o carry out by statute our international commitments."<sup>3</sup>

Indeed, the full title of the Lanham Act is "an act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes."<sup>4</sup>

At the time, the most recent of these international conventions was the Inter-American Convention for Trade Mark and Commercial Protection, which the United States ratified in 1931.<sup>5</sup>

Thus, the notion that trademark registration was intended to be an oasis of inoffensiveness in a world full of turmoil and conflict is mistaken; in fact, it is a fiction.



Registrations such as a “Black Sambo” mark for candy; “Honey Chile” food, registered in 1950, consisting of an image of a “pickaninny”; a “Him Heep Big Trader” mark for auto repair, registered in 1952, consisting of an image of a Native American speaking to a motorist; a “Golliwogg” mark for perfumes, registered in 1952; a “Wampum Injun” mark for corn chips, registered in 1962; and a “U-Need-Um” mark for tires, which was registered in 1965 and included an unflattering image of a Native American, are merely the ones that can be reprinted in relatively polite company.

The suggestion that a certain kind of otherwise legitimate trademark should continue to be rejected to maintain that fiction is unsupportable, unrealistic and unconstitutional.

It was not until 1999 — more than half a century after the enactment of the Lanham Act — that the PTO’s Trademark Trial and Appeal Board first found a mark non-registrable under the disparagement clause because it included a word offensive to a racial or ethnic group. In *Harjo v. Pro-Football Inc.*, No. 21,069, 1999 WL 375907 (T.T.A.B. 1999), the TTAB found the mark “Redskins” disparages Native Americans.<sup>6</sup>

Since 1999, the TTAB has refused registration to several other marks on similar grounds.<sup>7</sup>

The PTO’s change of view is readily understandable.

In recent years there has been an enormous change for the better in mainstream sensibilities concerning the use of derogatory words referring to racial, ethnic and religious groups.

Epithets that were once common are now far outside the bounds of acceptable social discourse.

The PTO — with the best of intentions — has responded to this change in sensibilities by refusing to register marks that disparage such groups.

Unfortunately, however, by doing so it has read into Section 2(a) a grant of power to engage in social engineering that Congress never intended to bestow on it.

That interpretation runs afoul of the First Amendment right to free speech.

Removing the limitation of the disparage-ment clause will restore the capacity to speak freely without government constraint.

The government control exercised by the PTO is tantamount to censorship based on the government’s determination of what is and what is not offensive speech.

But even the groups referenced by such speech do not necessarily agree that the content is offensive.

In the *Harjo* case, the position of Amanda Blackhorse as amicus for the government was not supported by a 2016 Washington Post national poll, in which seven in 10 Native Americans said that “they did not feel the word ‘Redskin’ was disrespectful to Indians.” Eight in 10 said “they would not be offended if a non-native called them that name,” according to the poll.<sup>8</sup>

## WHO IS RIGHT?

So, who has the better view?

The question is valid, but the answer is to be supplied not by the government but by ongoing social discourse.

If the Supreme Court, as we anticipate, agrees, there could be trademarks added to the principal register that, under Section 2(a), may have been rejected.

They would not be missed by most of us, but this is not the standard of free expression. Rather, it is the very occasion of offense that invokes the protection of the First Amendment.

Two messages from Supreme Court holdings make this clear.

The high court said in *Hustler Magazine Inc. v. Falwell*, 485 U.S. 46 (1988), quoting *Federal Communications Commission v. Pacifica Foundation*, 438 U.S. 726 (1978): “The fact that society may find speech offensive is not a sufficient reason for suppressing it. Indeed, if it is the speaker’s opinion that gives offense, that consequence is a reason for according it constitutional protection.”

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In *United States v. Eichman*, 496 U.S. 310 (1990), quoting *Texas v. Johnson*, 491 U.S. 397 (1989), the high court said, “If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.”

What will the world look like when hurtful, nasty slurs are allowed to be registered?

We doubt that the world will look much different at all.

Trademark registration is not, contrary to popular conception, a way to obtain a monopoly on phrases or slogans, be they clever or nasty.

Merely plastering a meme or rallying cry on a T-shirt or tote bag does not make it a trademark.

While many will apply, few will be allowed — and even fewer will see the filing of a Section 8 affidavit of use on their fifth anniversaries.

Very few people are prepared to build businesses around offensive trademarks. Doing so is not good business.

Trademarks that are not connected with ongoing commercial concerns do not remain trademarks, registered or not.

Likewise, the expensive novelty of spending hundreds of dollars to apply to register gross or hateful marks for no legitimate reason will wear out quickly.

Indeed, prospective applicants will learn that they have to put their names and addresses on trademark registrations, or those of a lawyer, which will deter some tasteless “joy riders” as well.

So yes, it is likely that some outrageous new trademarks will work their way through the PTO and be allowed registration.

But in all probability that is where they will stay, to die the ignominious deaths that they deserve.

They will not be missed — but neither will the suppression and wasted resources engendered by Section 2(a) of the Lanham Act.

## NOTES

<sup>1</sup> H.R. 4744, 76th Cong., 1st Sess. § 2(a) (1939).

<sup>2</sup> Trade-Marks: Hearings on H.R. 4744 Before the Subcomm. on Trade-Marks of the H. Comm. on Patents, 76th Cong., 1st Sess. 19-21 (1939).

<sup>3</sup> H.R. Rep. No. 219, 79th Cong., 1st Sess. 4 (1945); S. Rep. No. 1333, 79th Cong., 2d Sess. 5 (1946).

<sup>4</sup> 60 Stat. 427 (1946).

<sup>5</sup> 46 Stat. 2907 (1931). See Stephen P. Ladas, *The Lanham Act and International Trade*, 14 LAW & CONTEMP. PROBS. 269, 270 (1949) (“Prior to the adoption of the Lanham Act, our federal trade-mark legislation did not accord, in several respects, with the stipulations of the international or Pan American Conventions”); Harry Aubrey Toulmin Jr., *THE TRADE-MARK ACT OF 1946* at 6 (1946) (“The bill ... eliminates those sources of friction with our Latin-American friends”).

<sup>6</sup> The U.S. District Court for the District of Columbia reversed the TTAB’s decision, finding that a finding of disparagement was not supported by substantial evidence and that the doctrine of laches precluded consideration of the case. *Pro-Football Inc. v. Harjo*, 284 F. Supp. 2d 96 (D.D.C. 2003).

<sup>7</sup> See *In re Squaw Valley Dev. Co.*, No. 76511144, 2006 WL 1546500 (T.T.A.B. May 23, 2006), holding that SQUAW disparages Native Americans; *In re Heeb Media LLC*, No. 78558043, 2008 WL 5065114 (T.T.A.B. Nov. 26, 2008), holding that a “Heeb” mark disparages Jews; *In re Lebanese Arak Corp.*, No. 77072261, 2010 WL 766488 (T.T.A.B. Mar. 4, 2010), holding that “Khoran,” used for wine, disparages Muslims; *In re Geller*, No. 77940879, 2013 WL 2365001 (T.T.A.B. Feb. 7, 2013) holding that “Stop the Islamisation of America” disparages Muslims; *In re Beck*, No. 85767380, 2015 WL 1458229 (T.T.A.B. Mar. 19, 2015), holding that a “Porno Jesus” mark disparages Christians.

<sup>8</sup> John Woodrow Cox, Scott Clement & Theresa Vargas, *New Poll Finds 9 in 10 Native Americans Aren’t Offended by Redskins Name*, WASH. POST, May 19, 2016.

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