

Supreme Court Weighs in on First Amendment Rights and  
Trademarks Viewed as Disparaging

**Lee v. Tam**

Is a Trademark Law case filed on September 6, 2016 before SCOTUS. A short two months later, the petition was granted on December 14<sup>th</sup>, 2016 singling this to be one of the major cases of the October 2016 term. On Wed. Jan 18<sup>th</sup>, 2017 SCOTUS held oral arguments on Tam's appeal before the current 8 member Court.

**Facts of the Case:**

Simon Tam describes himself as an “Asian-American musician, lecturer, and political activist.” In 2006, he formed a rock band named The Slants, to bring attention to discrimination against Asian-Americans. The term “The Slants” has been used negatively to refer to some Asians based on the shape of their eyes and as a name mocking a physical feature of those individuals. Tam contends however, that by using the name The Slants, he was “following in the long tradition of re-appropriation, in which members of minority groups have reclaimed terms that were once directed at them as insults and redirected the terms outward as badges of pride.”

In 2011 Tam applied to The United States Patent and Trademark Office (**USPTO**) to register the name The Slants as a Trademark. A Trademark is a distinctive mark, motto, device, or emblem, which a manufacturer stamps, prints, or otherwise affixes to goods produced, so that they may be identified in the market, and for which their origin can be vouched. The **USPTO** reviews trademark applications for federal registration and determines whether an applicant meets the

requirements for federal registration. The Trademark Office receives 300,000 trademark applications every year. Upon receiving Tam's application for federal registration of The Slants, the USPTO rejected the registration based on Section 2(a) of the Lanham Act, which bars the government from approving trademarks that contain "matter which may disparage persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." Congress enacted the Lanham Act in 1946 to provide a national system for registering and protecting trademarks used in interstate and foreign commerce. Registration is significant because it confers important legal rights and benefits on trademark owners who register their marks.

Disappointed by the ruling of the USPTO, Tam appealed to the USPTO's appeals board, but **they upheld the original decision**. The USPTO acknowledged that Tam had good intentions underlying his use of the phrase ***The Slants***, but it concluded that his good intentions could not "obviate the fact that" many Asian-Americans object to the term. To support its finding that the mark likely referred to people of Asian descent, the Board pointed to dictionary definitions, the band's website, which displayed the mark next to "a depiction of an Asian woman, utilizing rising sun imagery and using a stylized dragon image," and a statement by Mr. Tam who described the genesis of the band's name by explaining: "I was trying to think of things that people associate with Asians. Obviously, one of the first things people say is that we have slanted eyes." The band's Wikipedia page stated that the band's name is "derived from an ethnic slur for Asians." The

Wikipedia entry quoted Mr. Tam: “We want to take on these stereotypes that people have about us, like the slanted eyes, and own them. We’re very proud of being Asian—we’re not going to hide that fact. The reaction from the Asian community has been positive.”

### **Ruling by The U.S. Court of Appeals**

Thereafter Tam Appealed from the decision of the USPTO to the U.S. Court of Appeals for the Federal Circuit. Mr. Tam appealed, arguing that the Board erred in finding the mark disparaging and that § 2(a) is unconstitutional. On appeal, the Court reversed. It agreed that the mark Tam was seeking to register was “disparaging,” but it concluded that the Lanham Act’s ban on the registration of disparaging marks violates the Constitution under the First Amendment.

### **The Government’s Argument before SCOTUS**

The Government has argued that the Lanham Act is fully consistent with the constitution because Under Section 2(a), the Federal Government is not restricting speech; it is simply not providing government funds for some speech. The Government asserts that Tam and his band can still call themselves The Slants, advertise themselves as The Slants, and sign contracts as the Slants, but they just can’t stop someone else from trying to use the same trademark. The Government also relied on a recent 2015 SCOTUS case **which was based on a decision by the State of Texas to NPOT allow the**

**confederate flag on state license plates because the design might be offensive to the public.** In that case, the issue was whether messages that are displayed on specialty tags are a form of government speech, so that officials can decide which to allow or to forbid. In the Texas case, the Petitioner's sought to preserve the memory and reputation of soldiers who fought for the Confederacy sought state approval for a plate design that included the Confederate battle flag. Ultimately, after a series of conflicting votes, a state agency turned down that design, saying that many people regard the rebels' flag as associated with hatred toward groups. The Texas Division of the Sons of Confederate Veterans sued, and ultimately won a decision by the U.S. Court of Appeals for the Fifth Circuit, declaring that **specialty plate messages are a form of private speech**, and that the state agency had engaged *in forbidden viewpoint discrimination* by NOT allowing the design. However, the Supreme Court **overturned that decision in June of 2015** saying that license plates **are** government speech and are consequently subjected to content restrictions unlike private speech.

### **Tam's Argument**

Tam argued that the disparagement provision was contrary to the first amendment because it discriminates based on the content of the trademark. Tam claimed that the provision "permits the registration of marks that express a positive or neutral view but bars the registration of marks that express a negative view." (This is called view point discrimination.) In other words, Tam asserts, that the disparagement provision is so vague, and it gives so much discretion to PTO

examiners, it violates the Constitution. He also contended that having the mark registered, gave him important legal rights. Tam further countered that someone who registers a trademark does not receive any funds from the Government. Unlike a government issued license plate registration, a trademark does not constitute government speech, but is instead speech by the owner of the trademark. Thus, the public would not think that these statements are made by the Government. Simply put, Tam's attorney stated during oral argument that he "is being denied the benefits of legal protections that are necessary for him to compete in the marketplace with another band." Tam also argues that Section 2(a) of the Lanham Act, only bars the disparagement of "persons," a term that does not extend to racial and ethnic groups.

### **Other Significance**

The Slant's **battle with the USPTO could have a significant effect** on another group who are in the same fight, **the Washington Redskins**. In 2014, **the USPTO cancelled the team's trademark provisions by relying on the disparagement provisions**. A Federal District Court upheld that decision and the team's case is now on hold in the U.S. Circuit Court of Appeals for the 4<sup>th</sup> Circuit. The team requested that the Supreme Court hear their case at the same time as Tam's but the request was denied!