

**THE SUPREME COURT AND THE SLANTS:  
LEANING TOWARD A DIFFERENT RULE ON DISPARAGEMENT IN TRADEMARKS**

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Last week, the Supreme Court heard oral argument in *Lee v. Tam*. Simon Tam, founder of an Oregon-based rock band, The Slants, had sought federal trademark protection for the band's name. The United States Patent and Trademark Office rejected the application since under the Lanham Act,<sup>1</sup> it proscribes trademarks if they are "offensive," in this case, to Asians. Sitting *en banc*, the Court of Appeals for the Federal Circuit found the ban unconstitutional as violative of the First Amendment.<sup>2</sup>

This case appears fairly straightforward, and the Supreme Court will most likely affirm. During argument, justices raised doubts about any government program that favors some forms of speech but rejects others that might disparage certain groups. This is called viewpoint discrimination. Justice Elena Kagan explained: "The point is that I can say good things about something, but I can't say bad things about something . . . and I would have thought that that was a fairly classic case of viewpoint discrimination." It is, and Justice Kennedy or Breyer will probably write the affirmance. What will be interesting is whether the Court tackles the thorny Fifth Amendment question raised by the concurrence in the Federal Circuit. This may be unlikely since the Supreme Court tends to move incrementally, however, it will need to address the issue of how to deal with what limits the Lanham Act may impose.

As a coda, the Washington Redskins of the National Football League have their own dog in this fight. The Court of Appeals for the Fourth Circuit was to have heard oral argument in December, 2016. However, that case has been stayed pending the result of the *Tam* case, which has the same legal issue as the Fourth Circuit case, but the latter is considerably more complex, involving the cancellation of the Redskins' mark as well as having considerably much more value at stake.<sup>3</sup>

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<sup>1</sup> The Lanham Act provides a national system for registering and protecting trademarks used in interstate and foreign commerce. Section 2(a) of that federal legislation is a hodgepodge of restrictions. Among them is the bar on registration of 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."

<sup>2</sup> Two judges authored a concurring opinion that they would go further and find Section 2(a) unconstitutionally vague under the Fifth Amendment. Two judges dissented.

<sup>3</sup> Procedurally, the USPTO and its Trademark Trial and Appeals Board had originally cancelled six marks in a split decision, which was upheld by the U.S. District Court for the Eastern District in Virginia that specifically held that the name 'Redskins' was disparaging to "a substantial composite of Native Americans" at the time each of the marks was registered." Instead of going to the Court of Appeals for the Federal Circuit, the owner of the marks, Pro-Football, Inc., a wholly-owned subsidiary connected to the Washington Redskins, filed in the Fourth Circuit. Then, Pro-Football, Inc. sought certiorari prior to any Fourth Circuit judgment, but that petition was denied. With the case ready for oral argument, it was stayed pending *Tam*.