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Program 13

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**Balancing “Free Speech” and “Good Taste” in Trademarks—
International Approaches to Registration of Disparaging,
Offensive or Scandalous Trademarks**

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**Materials for
Program 13**

Disparaging or offensive trade mark registrations in the United States—are there any limits after the US Supreme Court's decision in *Matal v Tam*?

L. Donald Prutzman*

Since its passage in 1946, the United States Trademark Act, known as the Lanham Act,¹ has barred the registration of certain types of trade marks that its drafters considered inappropriate, hurtful to others or in poor taste. In particular, § 2(a) of the Lanham Act² has permitted the United States Patent & Trademark Office (USPTO) to refuse registration of a trade mark that '[c]onsists of or comprises immoral ... or scandalous matter; or matter which may disparage ... persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute'. The 2017 US Supreme Court's decision in *Matal v Tam*³ abruptly negated over 70 years of settled trade mark law and practice in holding that the second portion of that provision (the Disparagement Clause) could no longer be enforced because it is in conflict with the right of free speech that the US Constitution guarantees.⁴

The *Tam* decision, which considered whether the sign THE SLANTS for a musical group composed of Asian-Americans could be refused registration on the ground it consisted of an ethnic slur disparaging Asian-Americans, effectively settled a more prominent controversy brewing since at least 1992 over whether trade mark registrations for the Washington Redskins football team should be cancelled as disparaging of Native Americans under the Disparagement Clause.⁵ Although *Tam* arose far more recently, it reached the Supreme Court ahead of the REDSKINS case as a result of the different procedural paths that the parties chose to follow.

Tam is disturbing and unwelcome to those who perceive it an appropriate and laudable goal for government to regulate what may be granted the protection of federal trade mark registration by barring disparaging,

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This article

- The article discusses *Matal v Tam*, and its effects on United States trade mark law. *Tam* holds that the USPTO's refusal to register THE SLANTS for a musical group composed of Asian-Americans based on Lanham Act § 2(a), which bars registration of marks that disparage 'persons, living or dead' (the 'Disparagement Clause') constitutes an unconstitutional restriction of free speech. The Disparagement Clause's constitutionality has long been at issue in litigation by Native American groups seeking to cancel REDSKINS and other trade marks of the Washington Redskins football team on the ground that they disparage Native Americans. Yet, because of procedural choices along the way, *Tam* reached the Supreme Court first, and ultimately resolved the issue. The article first discusses the treatment of the constitutionality issue in the Redskins litigation and in *Tam* prior to the Supreme Court.
- The article next analyses how the court dealt with the Disparagement Clause's constitutionality. The court held that trade marks are private speech subject to full First Amendment scrutiny, not 'government speech', and that the Disparagement Clause constituted impermissible 'viewpoint discrimination'. The decision may disappoint those who hoped to keep ethnic slurs off the trade mark register, but strongly reinforced the 'bedrock' principle that robust free speech demands toleration of speech many find odious.
- Finally, the article discusses the likely effects of the *Tam* decision. These include whether *Tam* is dispositive of the Redskins litigation, whether *Tam* is dispositive of § 2(a)'s restriction of 'scandalous' trade marks and whether new legislation could constitutionally reinstate some limits on disparaging trade marks.

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1 Trademark Act of 1946, as amended, 15 U.S.C. §§ 1051–1141n.

2 15 U.S.C. § 1052(a).

3 582 U.S. ___, 137 S. Ct. 1744 (2017).

4 U.S. Const., Amend. I, which provides, in relevant part that 'Congress shall make no law ... abridging the freedom of speech.'

5 Controversy over the Redskins' team name dates from at least 20 years earlier in 1972 when the director of the Indian Legal Information Development Service wrote to, and met with, the team's then-owner Edward Bennett Williams, urging him to change the team's name. See *Harjo v Pro Football Inc.*, 50 U.S.P.Q. 1705 (T.T.A.B. 1999) at *19.

scandalous or offensive matter. However, the robust free speech guarantee that the First Amendment has traditionally provided is part of the bedrock of US government. One important price of that protection is that speech that many, even the vast majority, would consider inappropriate, even odious, cannot be barred or burdened.

In *Tam* the government and the amici supporting the constitutionality of the Lanham Act's Disparagement Provision argued that its regulation was either 'government speech' that the First Amendment does not regulate, as opposed to the private speech of the trade mark applicant, or fell into a category of speech traditionally subject to more limited First Amendment review. However, although there were some differences in the analyses, all eight Supreme Court Justices⁶ who heard the case ultimately concluded that selection and use of a disparaging trade mark expresses a 'viewpoint' of the trade mark proponent that the government may not suppress.

This article will first discuss (section I) how the controversy over the registration of alleged ethnic slurs as trade marks originated and wended its way to the court of final resort in the United States. Section II will explain and comment on how the Supreme Court dealt with the various arguments before it and concluded that the Disparagement Provision, which has been a part of US trade mark law for over 70 years, runs afoul of the First Amendment and so cannot be enforced. Finally, section III will consider the likely effects of *Tam*, including: (a) the effect of the *Tam* decision on the controversy concerning the REDSKINS trade marks; (b) the effect of the *Tam* decision on the provision of § 2(a) barring 'immoral' or 'scandalous' marks; and (c) how other provisions of the Lanham Act and trade mark law might have ultimately affected whether THE SLANTS was issued a trade mark registration, and may affect whether the slew of applications filed in the wake of *Tam* for marks comprising or including ethnic slurs, sexual or scatological references or words traditionally viewed as inappropriate in 'polite company' will succeed, and how *Tam* may affect other areas of trade mark law.

I. The Disparagement Clause's unexpected route to the United States Supreme Court

a. Redskins One—The 'Harjo' Cancellation Proceeding

The Disparagement Clause's odyssey culminating in Supreme Court review commenced in September 1992 when Suzan Shown Harjo and six other Native Americans commenced a proceeding before the Trademark Trial and Appeal Board (TTAB)⁷ to cancel six trade mark registrations including or comprising the word 'Redskins' or a close equivalent (the 'Redskin Registrations') owned by Pro-Football, Inc., the owner and operator of the Washington Redskins football team (hereafter Pro-Football).⁸ The Harjo parties alleged that the Redskin Registrations violated the Disparagement Clause, and constituted immoral or scandalous matter that should be also denied registration under Lanham Act § 2(a) (the 'Scandalous Clause'). In response, in addition to denying that the marks were disparaging or scandalous, Pro-Football asserted, among other affirmative defences, that the Disparagement and Scandalous Matter Clauses were unconstitutional as violative of the First Amendment's free speech protection and that the Cancellation Proceeding was barred by the equitable defence of laches because the Harjo group had delayed too long in bringing the proceeding, to Pro-Football's prejudice.⁹

The Board disposed of the constitutional challenge and the laches defence early on. In ruling on the Harjo group's motion to strike certain affirmative defences, the Board held that it simply had 'no authority to declare provisions of the Lanham Act unconstitutional'.¹⁰ The Board treated the availability of a laches defence to claims of disparagement and scandalousness as a question of first impression. It held that where, as in this case, cancellation petitioners were acting to vindicate 'a broader interest—an interest beyond the personal interest being asserted by the present petitioners—in preventing a party from receiving the benefits of registration' of a disparaging or scandalous mark laches is not available.¹¹

⁶ Nine Justices sit on the US Supreme Court. However, the court's newest Justice, Neil M. Gorsuch, did not participate in this decision because argument took place prior to his joining the court.

⁷ The Trademark Trial and Appeal Board (hereafter the TTAB or Board) is an administrative tribunal within the US Patent & Trademark Office that considers primarily: (a) Opposition proceedings initiated by affected members of the public within thirty days of publication to oppose the registration of marks that have been approved by the Trademark Examining Attorney and published in the 'Official Gazette' for public opposition; (b) Cancellation proceedings brought by affected members of the public at any time to cancel existing trade mark registrations; and (c)

appeals from final determinations of Trademark Examining Attorneys, typically refusals to register on various grounds. Opposition and Cancellation proceedings are called 'inter partes proceedings' and captioned '[Opposer or Cancellation Petitioner] v [Applicant or Registrant]'. Appeals from Examiners' actions are called 'ex parte' proceedings" and captioned 'In Re [Applicant]'.

⁸ Cancellation No. 92021069 (T.T.A.B.), filed 10 September 1992.

⁹ Answer of Pro-Football, Inc., filed 16 December 1992.

¹⁰ *Harjo v Pro-Football, Inc.*, 30 U.S.P.Q.2nd 1828 at *6 (T.T.A.B. 1994).

¹¹ *Id.* at *4.

After five more years of litigation, the Board finally found, on a voluminous record, that the Redskin Marks were disparaging of Native Americans and ordered them cancelled. The Board, however, denied the petition to cancel on the ground that the marks consist of or comprise scandalous matter.¹² One may well wonder how it could take five years to determine what seems obvious to anyone who has seen more than a few US movies or TV westerns—that ‘redskin’ is a disparaging reference to Native Americans, an ethnic slur.

Further, as it turns out, the voluminous record was not even sufficient to sustain the TTAB’s determination. Pro-Football appealed the decision to the United States District Court for the District of Columbia, based in Washington, D.C.¹³ That court, in 2003, reversed the TTAB’s cancellation order, finding that the Board’s decision was not based on ‘substantial evidence’. In addition, the District Court reversed the Board’s laches ruling, held that laches is an available defence in § 2(a) cancellation proceedings, and held that it was a dispositive defence for Pro-Football because the Harjo group had waited too long to seek cancellation to the prejudice of Pro-Football.¹⁴ Pro-Football raised its constitutional challenge before the District Court, but that court declined to consider it under the ‘doctrine of constitutional avoidance’ which dictates that a court avoid reaching constitutional questions unless the party raising them fails to prevail on its non-constitutional claims.¹⁵

The Harjo group then appealed to the Court of Appeals for the DC Circuit and secured a partial reversal of the laches determination. That court held that the district court’s laches determination was potentially faulty because one of the Harjo petitioners was possibly a minor during a portion of the alleged period of undue delay and remanded the case for a new determination

as to that petitioner.¹⁶ On remand, the district court again found that laches applied to that petitioner,¹⁷ and the appellate court affirmed that decision.¹⁸ The Harjo group sought review by the US Supreme Court, but its petition for certiorari, the method by which discretionary Supreme Court review is sought, was denied.¹⁹ Thus, in summary, after 17 years of litigation, Pro-Football prevailed in the Harjo Cancellation Proceeding without the need for adjudication of its constitutional challenge to the Disparagement Clause.

b. Redskins Two—The ‘Blackhorse’ Cancellation Proceeding

Likely anticipating that the laches problem would doom the Harjo Cancellation Proceeding, on 11 August 2006, another group of Native Americans headed by Amanda Blackhorse commenced a new Cancellation Proceeding seeking cancellation of the same Redskin Registrations.²⁰ To try to overcome the laches problem, the Blackhorse petitioners were limited to Native Americans who were minors at the time the TTAB granted the Harjo petition to cancel and the petition was filed within a year of the District Court’s reversal. This tactic turned out to be successful.²¹ The TTAB suspended proceedings on the Blackhorse petition until the Harjo litigation concluded in 2009.

On 18 June 2014, the Board issued a new decision ordering cancellation of the Redskin Marks, based on the Harjo record and additional evidence the Blackhorse parties submitted.²² Pro-Football again chose the District Court method of review rather than an appeal to the Federal Circuit, but this time review was sought in the Eastern District of Virginia rather than the District of Columbia.²³ The different court ruled decidedly differently. On 8 July 2015, the court issued a

12 *Harjo v Pro-Football, Inc.*, 50 U.S.P.Q.2nd 1705 (T.T.A.B. 1998).

13 It is important to understand that losing parties before the TTAB have two routes by which to seek review. The party can appeal to the US Court of Appeals for the Federal Circuit, a specialized court that hears nationwide appeals in patent cases, appeals from TTAB decisions and certain other miscellaneous types of appeals. Further discretionary review is also potentially available in the US Supreme Court. Alternatively, the losing party can seek review by commencing a new lawsuit in a US District Court (a trial level court) of competent jurisdiction. The district court route allows the parties to introduce additional evidence for the court to consider in reviewing the TTAB’s determination and also offers an additional bite at the cherry for both parties because the district court’s decision can be appealed to the appropriate Circuit Court of Appeals, in addition to the potential Supreme Court discretionary review. The one significant drawback to the district court appellate route for losing applicants in ex parte cases is that the appealing party is required to pay the Patent & Trademark Office’s costs and attorneys’ fees regardless of who ultimately wins. Lanham Act § 21, 15 U.S.C. § 1071; 37 C.F.R. § 2.145.

14 *Pro-Football, Inc. v Harjo*, 284 F. Supp. 2nd 96 (D.D.C. 2003).

15 *Pro-Football, Inc. v Harjo*, 57 U.S.P.Q.2nd 1140, 1142–43 (D.D.C. 2000).

16 *Pro-Football, Inc. v Harjo*, 415 F.3d 44 (D.C. Cir. 2005).

17 *Pro-Football, Inc. v Harjo*, 567 F. Supp. 2nd 46 (D.D.C. 2008).

18 *Pro-Football, Inc. v Harjo*, 565 F.3d 880 (D.C. Cir. 2008).

19 *Harjo v Pro-Football, Inc.*, 558 U.S. 1025 (2009).

20 Cancellation No. 92046185 (T.T.A.B.).

21 See *Pro-Football, Inc. v Blackhorse*, 112 F. Supp. 3rd 439, 488–89 (E.D. Va. 2015).

22 *Blackhorse v Pro-Football, Inc.*, 111 U.S.P.Q.2nd 1080 (T.T.A.B. 2014).

23 Pro-Football would doubtless have preferred to appeal to the District of Columbia District Court where it had previously gained a favorable result. However, an intervening change in the law concerning where jurisdiction could be obtained over the new petitioners mandated resort to the Eastern District of Virginia instead. As of 16 September 2011, the relevant jurisdictional provision of § 21 of the Lanham Act, 15 U.S.C. § 1071(b)(1), (4), was amended to change the applicable venue where adverse parties reside ‘in a plurality of districts not embraced within the same state’ from the District Court in the District of Columbia to the Eastern District of Virginia.

decision affirming the Board's cancellation of the Redskin Registrations, rejecting Pro-Football's constitutional challenges to the Disparagement Clause, and rejecting the laches defence.²⁴

The court rejected Pro-Football's First Amendment challenge on three grounds. First, the court reasoned that because the cancellation order affected only the federal registrations of the Redskin Registrations and did not prevent Pro-Football from continuing to use the marks as unregistered common law trade marks, the First Amendment was not implicated. Since Pro-Football could still use the marks its free speech rights were not impaired.²⁵

Secondly, the court characterized the federal trade mark registration programme as 'government speech', to which the First Amendment does not apply, rather than private speech, which the government may not impair. The court relied primarily on the 2015 Supreme Court 2015 decision in *Walker v Tex. Div., Sons of Confederate Veterans*,²⁶ which held that Texas' refusal to issue speciality automobile licence plates depicting the Confederate flag²⁷ at the request of the Sons of Confederate Veterans on the ground that many members of the public found the Confederate flag offensive constituted government speech, not private speech. In the court's view, the federal trade mark registration programme was analogous to Texas' speciality licence plate programme.

Finally, the court reasoned that the federal trade mark registration programme is constitutional because the government may determine the contents and limits of its programmes. The court relied on *Rust v Sullivan*,²⁸ which stands for the principle that when the government creates and manages its own programme, it may determine the contents and limits of that programme without violating the First Amendment.

Pro-Football appealed the adverse decision to the United States Court of Appeals for the Fourth Circuit. However, on 15 November 2016 that court placed the case 'in abeyance' pending the Supreme Court's decision in *Tam*.²⁹ Thus, after 24 years of litigation Pro-Football's constitutional claims would not be the first

to reach the Supreme Court and the Redskins would have to sit on the sidelines while the issues were resolved in another case.

c. THE SLANTS Application

Simon Tam is the frontman for a dance-rock band composed of Asian-Americans called 'The Slants'. He chose that name to 'reclaim' and 'take ownership' of a well-known ethnic slur referring to Asians. On 14 November 2011, he applied for federal registration of the mark THE SLANTS for 'entertainment in the nature of live performances by a musical band'.³⁰ Not surprisingly, the Examining Attorney refused registration pursuant to the Disparagement Clause and the Board affirmed in a 26 September 2013 decision.³¹ The Board rejected Tam's argument that the mark, as he used it, was not disparaging but rather an attempt to wrest ownership of the term from those who intend disparagement by using it, noting that the relevant consideration is not the Applicant's intent, but whether a 'substantial composite of the referenced group' might nevertheless find the mark disparaging.

Tam also argued that the Disparagement Clause was unconstitutional. Rather than merely stating that the Board lacks authority to consider constitutionality of the Lanham Act, as it did in the *Harjo* proceeding, the Board rejected the constitutional argument, reasoning that the First Amendment was not implicated because the refusal to register the mark does not prevent Tam from using it, only from receiving the benefits of federal registration—the same rationale that the Eastern District of Virginia court invoked in *Blackhorse*.

Tam appealed the Board's decision to the Federal Circuit Court of Appeals.³² Initially, the Federal Circuit affirmed the Board's decision on both the Disparagement Clause and the First Amendment argument, in a decision by the normal panel of three judges.³³ However, the full court sua sponte vacated the panel's decision and ordered rehearing en banc limited to the question of whether the Disparagement Clause violates the First Amendment.³⁴ The primary reason for the en banc review according to the court was that *In re*

24 *Pro-Football, Inc. v Blackhorse*, 112 F. Supp. 3rd 439, 488-89 (E.D. Va. 2015).

25 *Id.* at 455-7. This determination was in accord with old, but subsisting, case law holding, with very thin analysis, that restrictions on trade mark registration did not implicate the First Amendment because the mark could still be used in unregistered form. *In re McGinley*, 660 F.2nd 481 (C.C.P.A. 1981).

26 ___ U.S. ___, 135 S. Ct. 2239 (2015).

27 The flag of the short-lived Confederate States of America, which attempted to secede from the United States, leading to the American Civil War of 1861-5.

28 500 U.S. 173 (1991).

29 Appeal No. 15-1874, Order, 11/15/2016, Dkt. No. 121 (4th Cir.).

30 Application Serial No. 85/472044.

31 *In re Tam*, 108 U.S.P.Q.2nd 1305 (2013).

32 One likely reason for this choice of appellate route, rather than district court review, was that in an ex parte proceeding Tam would have had to bear the Patent & Trademark Offices' costs and attorneys' fees, whether he won or lost, in the district court, but not before the Federal Circuit. See above, n 13.

33 *In re Tam*, 785 F.3rd 567 (Fed. Cir. 2015).

34 *In re Tam*, 600 Fed. Appx. 775 (Fed. Cir. 2015).

McGinley,³⁵ the precedent supporting the notion that a refusal to register a mark does not implicate the First Amendment because use of the mark is not barred, is old, based on minimal reasoning and arguably no longer good law.

In a split decision, the en banc court, consisting of 12 judges, held the Disparagement Clause facially unconstitutional.³⁶ The court overruled *In re McGinley*, primarily because it found fundamentally unsound the concept that denial of a trade mark registration based on its expressive content did not implicate the First Amendment. Even though use of the mark was not barred the court found denial of the benefits of federal registration to be a significant burden on expression. As the court put it, "The general principle is clear: "Lawmakers may no more silence unwanted speech by burdening its utterance than by censoring its content."³⁷ The court noted that 'federal trademark registration bestows *truly* significant and financially valuable benefits upon markholders',³⁸ including the right to exclusive nationwide use,³⁹ prima facie evidence of the mark's validity and ownership,⁴⁰ the ability to stop importation of goods bearing the mark and the ability to recover treble damages for willful infringement.⁴¹

On 20 April 2016, the Director of the US Patent & Trademark Office requested Supreme Court review of the Federal Circuit's decision.⁴² Five days later, not wanting to be upstaged by Mr Tam, Pro Football took the unusual step of petitioning the Supreme Court for a writ of certiorari before judgment in *Blackhorse*, which at the time was pending before the Fourth Circuit. The Redskins asked the Supreme Court to bypass the Fourth Circuit and hear its case, either instead of *Tam* or in tandem with *Tam*, or defer hearing *Tam* until the Fourth Circuit ruled. The Redskins argued that its case was a better vehicle to consider the issues involved because it included as issues whether the Disparagement Clause was unconstitutionally vague, whether the delay

between the registration of its marks and their cancellation violated the Fifth Amendment's Due Process clause,⁴³ and the non-constitutional issue of whether the Disparagement Clause even applies to groups such as Native Americans, as opposed to specific persons or institutions.⁴⁴

In fact, however, *Tam* was a much better vehicle for Supreme Court review. It cleanly presented the issue of whether the Disparagement Clause was facially unconstitutional, uncluttered with fact-laden arguments over vagueness or Due Process. *Tam* was also unburdened by issues concerning how and whether laches applies in Cancellation proceedings. It allowed the parties and the court to focus solely on the most important issue.

The Supreme Court agreed. It accepted certiorari in *Tam*⁴⁵ and denied certiorari in *Blackhorse*.⁴⁶ Thus THE SLANTS beat the Redskins to the Supreme Court.

II. The Supreme Court finds the Disparagement Clause unconstitutional in *Matal v Tam*⁴⁷

In a decision issued on 19 June 2017, the US Supreme Court affirmed the Federal Circuit's decision and held that the Disparagement Clause was unconstitutional on its face as violative of the First Amendment's protection of freedom of speech. After being part of the Lanham Act for more than 70 years, the court found that the Disparagement Clause, 'offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend.'⁴⁸ Justice Samuel A. Alito, Jr authored the majority opinion. All eight participating Supreme Court justices concurred in the affirmation, although several wrote separate opinions disagreeing with various aspects of Justice Alito's opinion.

35 660 F.2nd 481 (C.C.P.A. 1981).

36 *In re Tam*, 808 F.3rd 1321 (Fed. Cir. 2016) (en banc). Two of the twelve judges dissented.

37 808 F.2nd at 1340, quoting *Sorrell v IMS Health, Inc.*, ___ U.S. ___, 131 S. Ct. 2653, 2664 (2011).

38 *Id* (emphasis in original).

39 15 U.S.C. §§ 1072, 1115.

40 15 U.S.C § 1057(b).

41 15 U.S.C. §§ 1117, 1124.

42 Petition for Writ of Certiorari of Michelle K. Lee, 20 April 2016, 2016 WL 1593780.

43 U.S. Const., Amend V, provides in pertinent part, '[n]o person shall be . . . deprived of life, liberty, or property, without due process of law'. Pro-Football sought to argue that the 50-year delay between its first registration and the cancellation order deprived it of its registrations without due process of law because critical evidence was lost, and witnesses died, in the interim. Petition of Pro-Football, Inc. for Writ of Certiorari Before Judgment, 25nApril 2016, 2016 WL 1659323 at *3-4.

44 *Id*.

45 *Lee v Tam*, Order Granting Certiorari, 29 September 2016, 137 S. Ct. 30 (2016).

46 *Pro-Football, Inc. v Blackhorse*, Order Denying Certiorari Before Judgment, 2 October 2016, 137 S. Ct. 44 (2016).

47 The name of the case can be a potential source of confusion. Because the case originated as an ex parte appeal from an Examiner's refusal to register the trade mark, it was captioned *In re Tam* through the proceedings in the Federal Circuit. When Michelle K. Lee, the then-Director of the Patent & Trademark Office, petitioned the Supreme Court for certiorari, the case was captioned *Lee v Tam* and so remained throughout the briefing and argument. After argument, but before decision, Lee resigned as Director and had not been replaced. When the decision was promulgated, her name was replaced with that of Joseph Matal, who was then performing the functions and duties of the Director, and the caption became *Matal v Tam*.

48 137 S. Ct. at 1751.

a. Statutory construction of the Disparagement Clause could not avoid the constitutional issue

Before tackling the relevant First Amendment issues, the court considered and rejected Tam's argument, never presented to the Federal Circuit or the Board, that the Disparagement Clause, properly construed, applies to 'persons, living or dead, institutions, beliefs, or national symbols' but not racial or ethnic groups such as Asians. Normally the court would not consider an argument not presented below. However, because the construction Tam urged, if correct, would avoid the constitutional issue, the court made an exception, relying on precedents stressing the importance of avoiding unnecessary constitutional questions.⁴⁹

The court properly found the argument 'meritless'. Since the Disparagement Clause prohibits the registration of marks that may disparage 'persons, living or dead', the court had no trouble concluding that a mark that disparages an entire racial or ethnic group 'necessarily disparages many "persons",' namely members of that group.⁵⁰ In response to Tam's assertion that the numerous marks already on the register that many would regard as disparaging to racial and ethnic groups (the Redskins Registrations, for example) demonstrates the correctness of his interpretation, the court noted that, '[r]egistration of the offensive marks that Tam cites is likely attributable not to the acceptance of his interpretation of the clause but to other factors—most likely the regrettable attitudes and sensibilities of the time in question.'⁵¹

b. Trade marks are private speech, not government speech

The court then addressed the government's main argument that, because trade marks are 'government speech' rather than the private speech of the trade mark applicant, the Disparagement Clause does not violate the First Amendment. Justice Alito acknowledged that under the Supreme Court's precedents government's own speech is exempt from First Amendment scrutiny. However, he also noted the need to confine the government speech doctrine to reasonable limits:

But while the government-speech doctrine is important—indeed, essential—it is a doctrine that is susceptible to

dangerous misuse. If private speech could be passed off as government speech by simply affixing a government seal of approval, government could silence or muffle the expression of disfavored viewpoints. For this reason, we must exercise great caution before extending our government speech precedents.⁵²

In the court's view, registration of a trade mark could not be government speech because: (a) the Government 'does not dream up these marks, and it does not edit marks submitted for registration', (b) proposed marks are not checked to determine whether they conform to Government policy or whether the viewpoint they express is consistent with that of other registered marks, (c) an examiner's decision to register is not reviewed by any higher governmental authority unless a registration is challenged and (d) once a mark is registered it may not be removed from the register at the behest of the Patent & Trademark Office. The court stated that, '[i]n light of all this, it is far-fetched to suggest that the content of a registered mark is government speech'⁵³ and, '[n]one of our government speech cases even remotely supports the idea that registered trademarks are government speech.'⁵⁴

At least with respect to *Walker v Tex. Div., Sons of Confederate Veterans*, discussed above, that is an overstatement. The court neglected to deal with, or mention, that in *Walker*, under Texas' speciality licence plate programme the public could request speciality licence plates and the state would review them for acceptability. Texas' refusal to allow a speciality plate depicting the Confederate flag on the ground that a significant segment of the public would find it offensive is at least arguably analogous to refusing registration of THE SLANTS on the same ground. If Texas' issuance of speciality licence plates suggested by the public is government speech it is not 'far-fetched' to argue that the Patent & Trademark Office's registration of trade marks the public applies for could be government speech.

The court was not, however, willing to take the government speech doctrine that far, noting that *Walker* 'likely marks the outer bounds of the government-speech doctrine'.⁵⁵ The principled basis for distinguishing *Tam* from *Walker*, although perhaps not wholly satisfying to some, is that the public is used to viewing licence plates as a vehicle for conveying government

49 137 S. Ct. at 1755. Justice Clarence Thomas disagreed, stating that he saw no reason to address the statutory construction argument. 137 S. Ct. at 1769. Interestingly, this is the same statutory construction argument that the Redskins had urged made *Blackhorse* a better vehicle for Supreme Court review of the Disparagement Clause in their petition for certiorari before judgment. This may have prompted Tam to try to raise it in his brief even though he had not made the argument before.

50 137 S. Ct. at 1756.

51 *Id.*

52 137 S. Ct. at 1758.

53 *Id.*

54 137 S. Ct. at 1759.

55 137 S. Ct. at 1760.

messages and as something that comes from the state, while the public does not associate trade marks, as they experience them, with the government, as 'it is unlikely that more than a tiny fraction of the public has any idea what federal registration of a trademark means.'⁵⁶

The court's greatest concern with accepting the government speech argument was that 'if the registration of trademarks constituted government speech, other systems of government registration could easily be characterized the same way,' with '[p]erhaps the most worrisome implication being copyright registration.'⁵⁷ The court expressed concern that if federal registration made a trade mark government speech then federal registration of a copyright might also have to be deemed government speech. If so, then the First Amendment would not prevent the denial of a copyright registration based on the content of the work if the government deemed that content 'offensive', 'disparaging' or otherwise disfavoured. Like trade marks, a copyright need not be registered at the time it is infringed to be entitled to legal protection. However, also like trade marks, registered copyrights are entitled to stronger legal protection.⁵⁸ The government's attempt to blunt the analogy by distinguishing copyright registration as particularly concerned with free expression failed. The court responded that 'as this case illustrates, trademarks often have an expressive content.' Although 'the necessary brevity of trademarks limits what they can say . . . powerful messages can sometimes be conveyed in just a few words.'⁵⁹

The court thus decisively concluded that although trade mark registration may be a government act, the trade marks themselves are private, not government, speech.

c. Trade marks are not analogous to cases upholding the constitutionality of government programmes that subsidize a particular viewpoint

The court also rejected the government's argument that regulation of trade mark registrations through the Disparagement Clause is constitutional under cases holding that the government is not required to

subsidize activities that it does not wish to promote. The court noted that all of the cases the government relied on involved provision of cash subsidies or their equivalent.⁶⁰ It characterized a federal trade mark registration as 'nothing like the programs at issue in' those cases and found them 'not instructive in analyzing the constitutionality of restrictions on speech imposed in connection with' a government registration scheme because such schemes involve the registrants paying money to the government to apply for the registration and maintain it rather than receiving cash or its equivalent from the government.⁶¹ Distinguishing the government benefit cases merely because they involve payment of money to the programme beneficiaries, whereas trade mark registrants pay money to the government, may not be wholly adequate. After all, even though trade mark applicants pay money, they also receive a valuable government benefit. Is that benefit entirely different because it is not money?

d. The court soundly rejected the government's attempt to create a new 'government-programme' doctrine to support the Disparagement Clause's constitutionality

The government also urged, and the court rejected, that that a broader group of cases finding constitutional 'government programmes' permitting labour unions to deduct dues from their members' wages for collective bargaining activities, but not for certain political activities⁶² and the creation by a governmental unit of a limited public forum for private speech,⁶³ combined with the cash subsidy cases supported the constitutionality of the Disparagement Clause. The court reasoned that none of those cases permitted 'viewpoint discrimination' but the Disparagement Clause does, explaining:

Our cases use the term 'viewpoint' discrimination in a broad sense, and in that sense, the disparagement clause discriminates on the bases of 'viewpoint'. To be sure, the clause evenhandedly prohibits disparagement of all groups. It applies equally to marks that damn Democrats and Republicans, capitalists and socialists, and those arrayed on both sides of every possible issue. It denies registration to

56 137 S. Ct. at 1759.

57 137 S. Ct. at 1760.

58 See 17 U.S.C. §§ 411, 412.

59 137 S. Ct. at 1760.

60 The government cited *Rust v Sullivan*, 500 U.S. 173 (1991), in which a federal law provided funds to private parties for family planning services, *Nat. Endowment for Arts v Finley*, 524 U.S. 569 (1998), in which cash grants were awarded to artists, *United States v American Library Ass'n, Inc.*, 539 U.S. 194 (2003), involving federal funding for public libraries, and two cases in which the Court the award of tax benefits as comparable

to cash subsidies, *Regan v Taxation With Representation of Wash.*, 461 U.S. 540 (1983), and *Cammarano v United States*, 358 U.S. 498 (1959).

61 137 S. Ct. at 1760–1.

62 *Davenport v Washington Ed. Assn.*, 551 U.S. 177 (2007); *Yursa v Pocatello Ed. Assn.*, 555 U.S. 353 (2009).

63 *Eg, Good News Club v Milford Central School*, 533 U.S. 98 (2001); *Rosenberger v Rector and Visitors of Univ. of Va.*, 515 U.S. 819 (1995); *Lamb's Chapel v Center Moriches Union Free School Dist.*, 508 U.S. 384 (1993).

any mark that is offensive to a substantial percentage of the members of any group. But in the sense relevant here, that is viewpoint discrimination: Giving offense is a viewpoint.⁶⁴

However, the government's new 'government programme doctrine' argument may have more merit than the court recognized. The court noted, for example, that the laws at issue in the labour union cases 'conferred a very valuable benefit', that was not a cash subsidy⁶⁵ but failed to recognize that adding these cases to the cash subsidy cases undercut the rationale it had used to distinguish trade mark registration from the cash subsidy cases, namely, the involvement of a cash subsidy. In other words, cash subsidies are not the only situations in which government programmes subsidizing a particular viewpoint survived First Amendment scrutiny.

In grounding its rejection of the government's proposed new doctrine on its view that none of the programmes in the cases supporting it involved 'viewpoint discrimination', the court relied heavily on the 'bedrock principle' underlying the First Amendment that the government may not prohibit expression based on the viewpoint expressed. Accordingly, 'the disparagement clause cannot be saved by analyzing it as a type of government program in which some content- and speaker-based restrictions are permitted.'⁶⁶

e. It makes no difference whether trade marks are considered 'commercial speech'

Finally, the court addressed arguments by both parties and their supporting amici concerning whether trade marks should be classified as 'commercial speech' to which lesser First Amendment scrutiny applies, and, if so, whether the Disparagement Clause can survive that lesser scrutiny. 'Commercial speech' has been defined as 'dissemination of information as to who is producing and selling what product, for what reason, and at what price.'⁶⁷ The Supreme Court established the following intermediate-scrutiny framework for determining the constitutionality of restrictions on commercial speech in *Cent. Hudson Gas & Elec. v. Pub. Servs. Comm'n of N.Y.*:

1. Commercial speech must concern lawful activity and not be misleading;
2. If so, restrictions on commercial speech are constitutional if the government asserts a 'substantial' governmental interest in the restriction, and

3. The restriction directly and materially advances the government's asserted interest and is narrowly tailored to achieve that objective.⁶⁸

The court declined to even address whether trade marks could be considered commercial speech because it found that, even if they were, the Disparagement Clause could not survive the *Central Hudson* test. The government advanced two asserted governmental interests. The first was articulated in several ways, but in the court's view, 'no matter how the point is phrased, its unmistakable thrust is this: The Government has an interest in preventing speech expressing ideas that offend.' Because this asserted interest 'strikes at the heart of the First Amendment' it cannot justify the Disparagement Clause even if the trade mark THE SLANTS were purely commercial speech.⁶⁹

The second alleged governmental interest was 'protecting the orderly flow of commerce'. The contention was that commerce is disrupted by trade marks that disparage race, gender, ethnicity, national origin, sexual orientation and similar classifications. The court stated, however, that the Disparagement Clause is not 'narrowly tailored to achieve' the objective of blocking only trade marks that support invidious discrimination. Rather, '[t]he clause reaches any trademark that disparages *any person, group, or institution.*' (Emphasis in original.) It also protects every person living or dead and every institution. This overbreadth goes beyond the strictures of *Central Hudson* and so renders the Disparagement Clause unconstitutional even if trade marks are viewed as purely commercial speech.⁷⁰

In summary, the core First Amendment free speech values underlie the court's decision in *Matal v Tam*. As Justice Alito recalled:

Speech that demeans on the basis of race, ethnicity, gender, religion, age, disability, or any other similar ground is hateful, but the proudest boast of our free speech jurisprudence is that we protect the freedom to express 'the thought that we hate'.⁷¹

That fundamental principle justified the erasure of 70 years of settled trade mark law and practice under the Lanham Act.

III. The aftermath of *Matal v Tam*— What does the future hold for disparaging and offensive trade marks?

Matal v Tam decided that Tam's trade mark registration for THE SLANTS was wrongly refused pursuant to

64 137 S. Ct. at 1763 (citations omitted).

65 137 S. Ct. at 1762.

66 *Id.*

67 *Va. State Bd. Of Pharmacy v Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 765 (1976).

68 447 U.S. 557, 566 (1980).

69 137 S. Ct. at 1764.

70 137 S. Ct. at 1764–5.

71 137 S. Ct. at 1764, quoting *United States v Schwimmer*, 279 U.S. 644, 655 (1929) (Holmes, J., dissenting).

the Disparagement Clause because that clause is facially unconstitutional and unenforceable. How will that affect the future of disparaging and scandalous trade marks, and perhaps other trade mark doctrines?

a. Will Simon Tam maintain his registration for THE SLANTS?

The decision in *Matal v Tam* did not, a fortiori, mean that Tam would get and will be able to maintain the registration sought. However, things now appear to be headed in that direction. Promptly after the decision, the Patent & Trademark Office issued a new Examination Guide advising examiners that the Disparagement Clause 'is no longer a valid ground on which to refuse registration or cancel a registration'.⁷² Tam's application was returned to the examiner for further examination. At that point the examiner could have raised any other applicable requirements or grounds for refusal. One possibility might have been a descriptiveness refusal pursuant to § 2(e)(1) of the Lanham Act.⁷³ Arguably, if 'slants' is now an acceptable trade mark term for Asians, then THE SLANTS would be descriptive of a musical group composed of Asians and registration would interfere with the ability of other Asian musical groups to describe themselves as a group composed of 'slants' (assuming any would want to).

However, the examiner found no new ground for refusal and has passed the application to publication. The application was published on 29 August 2017. Any person who believed he or she would be damaged by registration of THE SLANTS could have initiated an Opposition proceeding before the Board within thirty days of publication. However, no one did. On 14 November 2017, US Trademark Registration No. 5,332,283 for THE SLANTS was issued to Simon Tam. It is, of course, possible for someone to raise the descriptiveness point in a future cancellation proceeding.

b. How will *Matal v Tam* affect cancellation of the Redskins registrations?

When certiorari was granted in *Tam*, Pro-Football's appeal from the affirmance in *Blackhorse* of the cancellation of the Redskins Marks was pending before the Fourth Circuit. The *Tam* decision gave rise to considerable speculation as to whether *Tam* was dispositive of *Blackhorse* as well. Two days after *Tam* was issued, the

Fourth Circuit Clerk issued a notice in *Blackhorse* asking the parties 'to state their positions on the need for oral argument of this appeal following the Supreme Court's decision in' *Tam*.⁷⁴

On 22 June 2017, counsel for Pro-Football advised the court that in its view, 'oral argument is unnecessary because *Tam* squarely controls the outcome of *Blackhorse* and 'mandates reversal of the district court's judgment.' Pro-Football also requested 'that the Court reverse the judgment of the district court, vacate the district's order directing the PTO to schedule cancellation' of the Redskins Registrations 'and remand the case with instructions to grant summary judgment to Pro-Football'.⁷⁵ Approximately a week later, counsel for the *Blackhorse* group and the Department of Justice advised the court that they concurred with Pro-Football that *Tam* was dispositive and the *Blackhorse* group consented to the entry of the relief that Pro-Football requested.⁷⁶

Although the *Blackhorse* group has thrown in the towel on seeking cancellation of the Redskins Registrations, they intend to continue their fight to use moral suasion to convince advertisers, politicians, fans and the public to pressure the Redskins to stop using the marks as part of their broader efforts to oppose the use of Native American mascots and imagery in the sports world.

c. Does *Matal v Tam* mean that the branch of § 2(a) barring registration of 'immoral' or 'scandalous' trade marks is also unconstitutional?

Lanham Act § 2(a) also permits the Patent & Trademark Office to refuse registration of a mark that '[c]onsists of or comprises immoral, . . . or scandalous matter'⁷⁷ (the 'Scandalousness Clause'). Reasonable minds can differ as to whether *Tam* is broad enough to render the Scandalousness Clause unconstitutional. As it happens, a case, *In re Brunetti*,⁷⁸ is pending before the Federal Circuit that will address that question. The case involves an application to register the sign FUCT as a trade mark for a variety of apparel items, including children's apparel. Not surprisingly, the examining attorney refused registration based on the Scandalousness Clause and the TTAB affirmed.⁷⁹ The applicant appealed to the Federal Circuit. As with *Blackhorse* the case was on hold pending the Supreme Court's decision in *Tam*. The day after that decision the Federal Circuit

72 Examination Guide 1—17, issued 26 June 2017.

73 15 U.S.C. § 1052(e)(1).

74 Dkt. No. 125, Appeal 15-1874 (4th Cir. 21 June 2017).

75 *Id.*, Dkt. No. 126.

76 *Id.*, Dkt. Nos. 127, 128.

77 15 U.S.C. § 1052(a)

78 No. 15-1109 (Fed. Cir.)

79 *In re Brunetti*, 2014 WL 3976439 (T.T.A.B. 1 August 2014).

issued an order asking for letter briefs explaining how the appeal should be resolved in light of the *Tam* decision.⁸⁰

On 20 July 2017, the government, in its letter brief, took the position that *Tam* is not dispositive of the constitutionality of the Scandalousness Clause and that the clause is valid.⁸¹ The government argues essentially that, unlike disparaging trade marks, the Lanham Act's restriction of scandalous or immoral trade marks is viewpoint neutral. In other words, trade marks containing profanity, or scatological or explicit sexual material, do not express a viewpoint, they are simply scandalous or immoral. The argument draws support from a number of cited decisions, including Supreme Court decisions holding that bans on profanity, sexually explicit imagery, depiction of sexual or excretory activities, or 'lewd and indecent speech' are viewpoint neutral.

The argument has a chance of succeeding, although it may have trouble overcoming the Supreme Court's broad construction of 'viewpoint' in *Tam*, particularly its pronouncement that '[g]iving offense is a viewpoint'.⁸² After all, the primary purpose of choosing a trade mark that falls within the Scandalousness Clause is to 'give offence' to that segment of the population that will be offended by it.

Oral argument of *Brunetti* was held on 29 August 2017. The court seemed unreceptive to the government's argument⁸³ but no decision has yet been issued. It will be interesting to see how the Federal Circuit and possibly the Supreme Court deal with the issues raised.

d. Has *Matal v Tam* opened the floodgates to applications for disparaging and scandalous trade marks?

The answer is most decidedly yes. Within days of the *Tam* decision, a variety of parties began filing numerous applications for registration of 'offensive' trade marks and the parade continues to date. For example, since 19 June 2017 there have been at least eight new applications for marks containing the F-word,⁸⁴ at least 11 for marks containing the S-word or variations,⁸⁵ at

least nine for marks containing or consisting of the N-word or variations,⁸⁶ at least one for an ethnic slur for Puerto Ricans⁸⁷ and a reapplication for COCK SUCKER for 'candies molded in the shape of a rooster'⁸⁸ that was previously refused registration under the Scandalousness Clause.

However, whatever the result in *Brunetti*, other provisions of the Lanham Act may prevent registration of some of the above marks. Many of these new applications are for clothing and other items that often display informational messages and the proposed trade marks appear likely to be most suitable for use as informational matter, for example a message on a t-shirt or knick-knack. If so used, they may be vulnerable to refusal on the ground that they fail to function as a trade mark, known as an ornamental or failure-to-function refusal. For example, BEST. DAD. EVER. for clothing received such a refusal because it is merely informational matter that exhibits a message on a t-shirt but fails to indicate the origin of the goods.⁸⁹

The Patent & Trademark Office may be anticipating stepping up ornamental or failure-to-function refusals for marks that might formerly have been refused under the Disparagement or Scandalousness Clauses. In July 2017, the Office issued an extensive new Examination Guide concerning 'Merely Informational Matter'.⁹⁰ Although it does not mention application to disparaging or scandalous marks, we may see some of the new 'offensive' trade mark applications weeded out on this ground.

e. How might *Tam* affect other, interrelated areas of trade mark law?

Tam could have wide-ranging effects on other settled areas of trade mark law that involve issues of disparagement or 'bad taste'. One example may be the tarnishment branch of the Federal Trademark Dilution Act⁹¹ (FTSA) and state trade mark dilution statutes.⁹² One purpose of the FTDA is to protect famous trade marks 'from subsequent uses that . . . tarnish or disparage' the mark.⁹³ The FTDA defines tarnishment as the 'association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of

80 Dkt. No. 58, No. 15-1109 (Fed. Cir. 20 June 2017).

81 Dkt. No. 60, No. 15-1109 (Fed. Cir. 20 July 2017).

82 137 S. Ct. 1763. The government stresses, however, that this pronouncement was made in a portion of Justice Alito's Opinion that only four of the eight Justices joined, so it may not be viewed as binding precedent.

83 Oral argument lasted over an hour. An audio recording is available online at <<https://www.courtlistener.com/audio/31454/in-re-erik-brunetti/>>.

84 Application Serial Nos. 87/551970, 87/546008, 87/544136, 87/529626, 87/507937, 87/496378, 87/495990 and 87/495590.

85 Application Serial Nos. 87/554425, 87/518138, 87/545646, 87/543229, 87/531881, 87/530837, 87/519861, 87/518009, 87/513152, 87/512087 and 87/511242, .

86 Application Serial Nos. 87/495357, 87/541664, 87/534946, 87/507483, 87/507414, 87/499736, 87/496567, 87/496554 and 87/495358.

87 Application Serial No. 87/539183.

88 Application Serial No. 87/495435.

89 Application Serial No. 86/160320.

90 Examination Guide 2-17, July 2017.

91 Lanham Act § 43(c), 15 U.S.C. § 1125(c).

92 Eg. N.Y. Gen. Bus. Law § 360-1 (New York); 6 Del. C. § 3313 (Delaware).

93 *Moseley v V Secret Catalogue, Inc.*, 537 U.S. 418, 431 (2003) (citing H.R. REP. NO. 104-374, at 1029 (1995)).

the famous mark.⁹⁴ Whether the tarnishment branch of federal and state trade mark dilution laws survives *Tam* is open to question. The FTDA provides for injunctive relief against the use of a mark ‘that is likely to cause dilution . . . by tarnishment of [a] famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.’⁹⁵ Under *Tam* a trade mark directed at the ‘reputation’ of a famous mark is likely expressing a viewpoint concerning that mark or the products or services sold under it. Accordingly an FTDA injunction might be inconsistent with the First Amendment.

The First Amendment already restricts the granting of relief against arguably tarnishing trade marks that parody a famous mark.⁹⁶ Would it do the same under *Tam* where parody or satire was not discernable?⁹⁷ Or might the tarnishing marks be deemed commercial speech which could allow the dilution statutes to survive the less demanding *Central Hudson* First Amendment analysis?

f. Can new, narrowly drawn legislation bar registration of ethnic slurs as trade marks?

It is questionable whether an amendment to the Lanham Act narrowly drawn to bar only registration of marks disparaging racial or ethnic groups could survive constitutional scrutiny. Even if trade marks were construed to be commercial speech, a question left undecided in *Tam*, the court made it clear that a governmental interest in protecting groups from demeaning ethnic slurs in commerce could not be an adequate justification for the restriction under *Central Hudson*. The court seemed more open to the possibility of accepting protection of the orderly flow of commerce as an adequate government

interest, because racial or ethnic disparagement is similar to discriminatory conduct, which has been recognized to have an adverse effect on commerce. It found unconstitutionality in *Tam* because the Disparagement Clause was not narrowly drawn to ‘drive out trademarks that support invidious discrimination’. If a new Lanham Act provision were narrowly drawn in that fashion it could conceivably survive *Central Hudson* scrutiny. However, the court in *Tam* seemed sceptical that trade marks could ever be mere commercial speech because they have an expressive element. As Justice Alito stated it, ‘If affixing the commercial label permits the suppression of any speech that may lead to political or social “volatility”, free speech would be endangered.’⁹⁸

Conclusion

Many are uncomfortable with the idea that the government must allow disparaging, offensive, vulgar trade marks to be dignified by, and receive the benefits of, federal trade mark registration and would prefer restrictions that preserve ‘civility’ and ‘decency’ and protect racial and ethnic minorities from offence. However, the result in *Matal v Tam* reminds us that the price of the robust free speech protection the First Amendment provides is the toleration of ‘the speech we hate’. On balance, the benefits of robust free speech likely outweigh the detriments. However, *Tam*’s upset of 70 years of settled trade mark law could have far-reaching consequences causing some to question whether full-blown First Amendment protection is necessary or appropriate in the trade mark context.

94 15 U.S.C. § 1125(c)(2)(C).

95 15 U.S.C. § 1125(c)(1).

96 Eg, *Mattel, Inc. v Walking Mountain Prods.*, 353 F.3d 792, 812 (9th Cir. 2003) (photographs of nude Barbie doll attacked by vintage kitchen appliances shielded from a tarnishment claim by the First Amendment); *Louis Vuitton Malletier S.A. v Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007) (CHEWY VUITON and stylized CV for stuffed dog toys and beds protected by First Amendment as a parody of LOUIS VUITTON and stylized LV for luxury luggage).

97 For example, in *Pfizer, Inc. v Sachs*, 652 F. Supp. 2nd 512 (S.D.N.Y. 2009), the defendant advertising company threatened to use female models riding a missile bearing the mark VIAGRA and distributing condoms

to promote its outdoor advertising business. The court preliminarily enjoined the display and granted summary judgment for Pfizer, rejecting defendant’s argument that its use of the VIAGRA mark was a statement concerning erectile dysfunction protected by the First Amendment. Would *Tam* require a different result today? Similarly, would *Tam* require a different result in *Deer & Co. v MTD Prods., Inc.*, 41 F.3d 39 (2nd Cir. 1994), in which the court enjoined the use of an altered version of the JOHN DEERE logo as a frightened deer running away from the competitor’s tractor under a state dilution statute. The defendant was arguably expressing a viewpoint concerning the quality of the plaintiff’s products.

98 137 S. Ct. at 1765.