Tannenbaum Helpern Syracuse & Hirschtritt LLP

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

The U.S. Tilt Toward Free Speech—

Matal v. Tam, 137 S. Ct. 1744 (2017)—THE SLANTS

In re Brunetti, 877 F.3d 1330 (2017)--FUCT

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Matal v. Tam

- For over 70 years the US Trademark Act has barred the registration of any trademark that "[c]onsists of or comprises . . . matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute" (the "Disparagement Clause")
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- *Matal v. Tam* found the Disparagement Clause unconstitutional as a free speech violation

Matal v. Tam

- The Dispute—Simon Tam seeks to register THE SLANTS for an Asian-American dance-rock band to "reclaim" or "take ownership" of the ethnic slur.
- Registration refused citing the Disparagement Clause;
- Challenged before the TTAB--affirmed
- Appealed to the Federal Circuit– reversed
- Reviewed by US Supreme Court—Disparagement Clause found unconstitutional

The Redskins

- Cancellation proceedings and litigation over the trademark registrations for THE REDSKINS football team preceded THE SLANTS dispute by many years.
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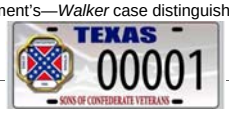
- The Redskins were beaten to the Supreme Court for suitability and procedural reasons.

Matal v. Tam

- The Supreme Court's Decision
  - Held that the 70 year old Disparagement Clause "offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend."
    - Statutory construction argument could not avoid the constitutional issue—Disparagement Clause applies to racial or ethnic groups as well as "persons" "institutions" "beliefs" and "national symbols"
    - Trademarks are private speech, not government speech—the marks express the registrants' views, not the government's—*Walker* case distinguished



Matal v. Tam

- Trademarks are not analogous to cases upholding the constitutionality of government programs that subsidize a particular viewpoint
- The academics' new "government programme" doctrine soundly rejected
- The Court avoids the issue of whether trademarks are "commercial speech" subject to lesser First Amendment scrutiny under *Central Hudson* case

Matal v. Tam

- *Tam* embodied and reinforced core American First Amendment Free Speech values:
- *"Speech that demeans on the basis or 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'"* 137 S. Ct. at 1764.

Matal v. Tam

- *Tam* embodied and reinforced core American First Amendment Free Speech values:
- "Viewpoint discrimination" is a broad term.
- Even thought the Disparagement Clause evenhandedly prohibits disparagement of all groups—that is viewpoint discrimination.
- "Giving offense is a viewpoint." 137 S. Ct. at 1763.

The Redskins

- Both the team and the Native American challengers conceded that *Tam* controlled the registerability of the REDSKINS trademarks
- Native American groups now focusing on public moral suasion

In re Brunetti

- Lanham Act § 2(a) also bars registration of any mark that "Consists of or comprises . . . Immoral or scandalous matter" (the "Scandalous Clause")
- Constitutionality challenged by Erik Brunetti—sought registration of 

for a clothing line, including children's clothing.

In re Brunetti

- Registration refused by USPTO and TTAB
- On appeal to the Federal Circuit, the government argued that *Tam* was did not control the constitutionality of the Scandalous Clause—
  - Trademarks are equivalent to a government subsidy
  - Trademark register is a limited public forum
  - Trademarks are commercial speech, subject to lesser First Amendment scrutiny.

  Federal Circuit held the Scandalous Clause governed by *Tam* and unconstitutional.

In re Brunetti

- After long consideration, the Government sought Supreme Court review of the Scandalous Clause on September 7, 2018.
- Review discretionary
- May be heard in 2019 captioned *Iancu v. Brunetti.*

Iancu v. Brunetti

- Government's principal argument—Scandalous Clause is viewpoint neutral because vulgarity does not express a viewpoint. It is merely vulgar.
- Supporting cases hold that restrictions on use of profanity and sexual images are viewpoint neutral.
- But *Tam* says giving offense is a viewpoint.

Aftermath of *Tam* and *Brunetti*

- A parade of applications for Disparaging and Scandalous trademarks:
  - -at least 20 applications for marks consisting of or containing F**K;
  - --at least 18 application for S**T or variations;
  - --at least 9 for marks containing the N-word or vartiations;
  - --at least 1 application for a mark containing S*IC;
  - --at least 1 application for KI*E

Aftermath of *Tam* and *Brunetti*

- Re-application for COCK SUCKER for "candies molded in the shape of a rooster"—previously refused registration under the Scandalous Clause.

Current USPTO Policy:

Disparagement Clause is not being enforced;

Scandalous Clause--marks that formerly would have been refused are being suspended pending possible Supreme Court review.

Other Lanham Act Provisions

- *Tam* may also affect the Consent Requirement—Lanham Act § 2(c) bars registration of a mark that "Consists of or comprises a name, portrait or signature identifying a particular living individual except by his written consent."

The Consent Requirement

- Recent Refusals for Lack of Consent:

IMPEACH 45

Trump Baby Blimp Balloons and Signs

TrumpTheTraitor

- All refused for lack of consent of Donald J. Trump

The Consent Requirement

- Somehow managed to get a registration

- Is consent requirement constitutional?
  - Not viewpoint discriminatory
  - Is requiring consent of the criticized consistent with First Amendment?
  - Is granting a government monopoly on a form of criticism consistent with the First Amendment?

Effects of *Tam* Outside the Trademark Act

- *Wandering Dago, Inc. v. Destito, 879 F.3d 20 (2d Cir. 2018)*

- *New York cannot exclude a food vendor from participating in a Lunch Program based on its ethnic slur branding.*

Effects of *Tam* Outside the Trademark Act

- American Freedom Defense Initiative v. King County, 18 WL 4623720 (9th Cir. Sept. 27, 2018
- County transit system's refusal of anti-terrorism bus ad based on a disparagement clause violates First Amendment, citing *Tam.*
- *"Giving Offense is a viewpoint, so Metro's disparagement clause discriminates, on its face, on the basis of viewpoint." Slip. Op. at 11.*

Issues

- For the US, "Free Speech" trumps "Good Taste" in trademark registration and protection.
- Does it go beyond protecting hateful and vulgar speech and put a government imprimatur on hateful and vulgar speech?
- Is that rigid approach right for all countries?
- Is in essential for reasonable free speech protection?
- Is there a role for other public policy considerations?
- How do other jurisdictions approach the issues?

THANK YOU!

QUESTIONS???

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