

The Trademark Principal Register as a Nonpublic Form

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INTRODUCTION

De gustibus non est disputandum. There is no accounting for taste. At least when it comes to matters of expression, that is the rule engraved by the First Amendment on the American constitutional tradition.¹ For the public debate to be robust and uninhibited, speech should be allowed to flow freely, on matters large and small, in words wise or foolish, beautiful or distasteful.² But the First Amendment, of course, is not absolute;³ and a number of limitations on freedom of expression have been devised to mediate a balance between individual liberty and societal interest in orderly coexistence and government administration.

Section 2(a) of the Lanham Act⁴ prohibits registration of “scandalous,” “immoral,” and “disparaging” trademarks on the Principal Register.⁵ Federal registration carries a number of benefits not available to unregistered trademarks.⁶ Trademarks are commercial speech; and as a content-based restraint on speech, § 2(a) implicates the First Amendment.⁷ Courts that have had an opportunity to address chal-

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¹ US Const Amend I.

² See *Cohen v California*, 403 US 15, 24–25 (1971):

To many, the immediate consequence of this freedom may often appear to be only verbal tumult, discord, and even offensive utterance. These are, however, within established limits, in truth necessary side effects of the broader enduring values which the process of open debate permits us to achieve. That the air may at times seem filled with verbal cacophony is, in this sense not a sign of weakness but of strength.

³ See *Chaplinsky v New Hampshire*, 315 US 568, 571–72 (1942) (“There are certain well-defined and narrowly limited classes of speech, the prevention and punishment of which have never been thought to raise any Constitutional problem.”).

⁴ An Act to Provide for the Registration and Protection of Trade-marks Used in Commerce, to Carry Out the Provisions of Certain International Conventions, and for Other Purposes (“Lanham Act”), Pub L No 79-489, 60 Stat 427 (1946), codified as amended at 15 USC § 1051 et seq (2000).

⁵ 15 USC § 1052.

⁶ See text accompanying notes 17–21.

⁷ See Part II.B.1.

lenges to the constitutionality of § 2(a) have dismissed them without adequate analysis.⁸

This Comment discusses two critical issues that courts have ignored in addressing the constitutionality of § 2(a). First, courts have overlooked the relevance of the public forum doctrine to the question of the constitutional validity of § 2(a). It is well established that content-based restrictions are presumptively unconstitutional.⁹ The case of § 2(a) is peculiar, however, in that it imposes a restriction not on speech in the private arena but on speech on public property, the Principal Register. In such circumstances, the Supreme Court has applied the “public forum doctrine” to distinguish between three types of public fora with varying degrees of protection afforded to speech therein: traditional, designated (or limited), and nonpublic. In traditional public fora available for the exchange of ideas, like streets, parks, and sidewalks, the government may exclude speech on the basis of its content only if the exclusion is narrowly tailored and serves a compelling government interest.¹⁰ In designated public fora opened up by the government for expressive activity, the same limitations on the government’s authority to restrict speech apply.¹¹

When a forum is not traditional and the government does not designate it as a limited public forum for the exchange of ideas, it is a nonpublic forum and speech on such property may be restrained if the restrictions are reasonable and viewpoint-neutral.¹² The Principal Register is a forum created and maintained by the federal government to confer to registrants benefits not available for unregistered trademarks. Thus, the Principal Register is the forum to which the speech at issue here seeks access, and the type of the forum that the Principal Register represents will determine the level of scrutiny applied to § 2(a). Analyzing the relevant factors informing this inquiry, this Comment demonstrates that the Principal Register is a nonpublic forum.

Second, this Comment develops a framework for applying the proper test when the public forum and the commercial speech doctrines intersect. Most of the Supreme Court’s public forum jurisprudence involves core political speech, and the Court has left open the question of which of the existing two tests should apply to regulations

⁸ See text accompanying notes 50–60.

⁹ *R.A.V. v St. Paul*, 505 US 377, 382 (1992).

¹⁰ See *Perry Education Association v Perry Local Educators’ Association*, 460 US 37, 45 (1983), citing *Carey v Brown*, 447 US 455, 461 (1980).

¹¹ See *Perry*, 460 US at 46.

¹² *Id.*

of commercial speech on public property. This Comment argues that in a nonpublic forum, restrictions on commercial speech should be analyzed under the forum test of reasonableness and viewpoint-neutrality.

In Part I, this Comment lays out the general framework of the Lanham Act and the case law applying § 2(a). Part II discusses the First Amendment concerns raised by § 2(a) but ignored by the courts. Part III applies the public forum doctrine to the Principal Register to determine its public forum status. Part IV examines the proper level of scrutiny for restrictions on commercial speech on public property. It is not within the scope of this Comment to determine the ultimate validity of § 2(a) under the applicable standard.¹³ It is hoped, however, that courts will use this framework to carry out their heretofore neglected task of carefully assessing whether the modern trademark registration system is consistent with the commands of the First Amendment.

I. THE LANHAM ACT § 2(A)

The Lanham Act governs federal trademark rights. The Act lays out a comprehensive framework for obtaining federal rights in trademarks and for protection of trademark owners' rights against various forms of infringement.

Federal registration does not create a trademark;¹⁴ rather the use of a symbol to identify and distinguish the source of a product makes a trademark.¹⁵ The Lanham Act's definition of a trademark does not bear upon a mark's eligibility for registration and instead encapsulates a functional theory of trademarks: "The term 'trademark' includes any word, name, symbol, or device, or any combination thereof . . . [used] to identify and distinguish [one's] goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown."¹⁶

Although registration is not required for a trademark to be valid, federal registration provides the owner with an array of important benefits that are not available to an unregistered mark.¹⁷ For instance: (1) registration on the Principal Register is *prima facie* evidence of the validity of the mark and of the registrant's ownership and exclusive

¹³ Commentators have suggested, with varying conclusions, a number of interests that the government may assert as being advanced by § 2(a). See notes 211, 213.

¹⁴ This Comment uses the terms "trademark" and "mark" interchangeably.

¹⁵ *Application of Deister Concentrator Co.*, 289 F.2d 496, 501 (CCPA 1961); Thomas J. McCarthy, 3 *McCarthy on Trademarks and Unfair Competition* § 19:3 at 18 (West 2007).

¹⁶ 15 USC § 1127.

¹⁷ See McCarthy, 3 *McCarthy* § 19:9 at 30-32 (cited in note 15).

right to use the mark;¹⁸ (2) registration makes the mark “incontestable,” serving as conclusive evidence of the registrant’s exclusive right to use the mark, subject only to certain statutory defenses;¹⁹ (3) registration provides constructive notice of a claim of ownership eliminating any defense of good faith adoption and use of the same mark made after the date of the registration;²⁰ and (4) registration allows recovery of profits, damages, costs, treble damages, and attorneys’ fees in infringement litigation.²¹

Section 2 of the Act determines registrability of trademarks through a list of exclusionary criteria barring a mark’s registration. The focus of this Comment is on the prohibitions of § 2(a), which in pertinent part provides that “[n]o trademark . . . shall be refused registration on the principal register on account of its nature unless it . . . [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*.”²²

What attributes make a mark “scandalous,” “immoral,” or “disparaging” is not self-evident from the statute.²³ The legislative history of the Lanham Act is similarly unrevealing as to how the drafters intended the terms to be interpreted.²⁴ From the little that can be

¹⁸ 15 USC §§ 1057(b), 1115(b).

¹⁹ 15 USC §§ 1065, 1115(b).

²⁰ 15 USC § 1072.

²¹ 15 USC § 1117.

²² 15 USC § 1052(a) (emphasis added). For purposes of linguistic efficiency and in accordance with the common practice, marks that may “bring [the specified protected groups] into contempt or disrepute” will be referred to as “disparaging” marks. In addition, the case law does not contain any distinctions between “scandalous” and “immoral” marks. See *In re Mavety Media Group Ltd*, 1993 TTAB LEXIS 25, *1 n 2. Therefore, the ban on the registration of “immoral” and “scandalous” trademarks will be treated as one of the two heads of the prohibitive framework of § 2(a), and the proscription on registration of “disparaging” marks as the other.

²³ Upon receipt of an application to register a trademark, the Patent and Trademark Office (PTO) refers it to an examining attorney for an ex parte examination of its registrability. 15 USC § 1062(a). If the mark is approved for registration, it is published in the PTO Official Gazette with the registration itself typically issuing within six months. 37 CFR § 2.80 (2007). If the examiner finds the mark not registrable and issues a final rejection, an unsuccessful applicant may appeal the examiner’s decision to the Trademark Trial and Appeal Board (TTAB). 15 USC § 1070. The Board’s decision may then be appealed to the United States Court of Appeals for the Federal Circuit or, alternatively, the applicant may obtain de novo review at a United States district court. 15 USC § 1071. Prior to October 1, 1982, appeals from TTAB lay before the Court of Customs and Patent Appeals, which was subsequently merged into the Court of Appeals for the Federal Circuit. Under *South Corp v United States*, 690 F2d 1368, 1369 (Fed Cir 1982) (en banc), the decisions of the Court of Customs and Patent Appeals are binding on the Federal Circuit.

²⁴ See *Unfair Competition under Title IX of the Lanham Act*, 51 Colum L Rev 1053, 1053–54 n 8 (1951). See also *In re McGinley*, 660 F2d 481, 485 (CCPA 1981) (noting “a paucity of legislative history” of § 2(a) in shedding light on the meaning of the term “scandalous”).

gleaned from the legislative history of the statute, it is apparent that the motivating force behind the § 2(a) prohibitions was congressional sensibility about the use of certain words and names as trademarks.²⁵ While the drafters objected to ABRAHAM LINCOLN GIN and GEORGE WASHINGTON COFFEE, they did not offer any interpretive insights as to how the prohibitions should be executed. The lack of legislative guidance and the vagueness of words like “scandalous” and “immoral” led to a judicial recognition that “determination that a mark is scandalous is necessarily a highly subjective one.”²⁶ This, in turn, has generated a body of case law whose hallmark has been unpredictability.²⁷ A brief listing of a few cases suffices to demonstrate the point.

In the context of the “scandalous” and “immoral” prong of § 2(a), the Trademark Trial and Appeal Board (TTAB) refused registration to the mark SENUSSI for cigarettes for scandalousness on the ground that the teachings of the Senussi Muslim sect forbid cigarette use,²⁸ while the mark AMISH for cigars was allowed registration due to affidavits attesting, among other things, to the fact that 75 percent of Amish men smoked cigars or chewed tobacco.²⁹ Similarly, BUBBY TRAP was not registrable as a mark for brassieres³⁰ and QUEEN MARY was scandalous when applied to women’s underwear,³¹ while the mark OLD GLORY CONDOM CORP depicting a condom decorated with stars and stripes, known as “old glory,”³² and a design mark for a penis size-increasing device featuring “a melancholy, unclothed male figure ruefully contemplating an unseen portion of his genitalia,”³³ were granted registration. The marks MADONNA³⁴ and MESSIAS³⁵ were found to be scandalous for use upon wine and brandy, while

²⁵ See Hearings before the Committee on Patents Subcommittee on Trade-marks, 76th Cong, 1st Sess 19 (1939) (Thomas E. Robertson).

²⁶ *In re Hershey*, 6 USPQ2d 1470, 1471 (TTAB 1988).

²⁷ For a list of trademarks denied or allowed registration under the “scandalous” and “disparaging” rubrics, see Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 Trademark Rep 661, 669–70 n 23 (1993).

²⁸ See *In re Reemtsma Cigarettenfabriken GmbH*, 122 USPQ 339, 339 (TTAB 1959).

²⁹ See *In re Waughtel*, 138 USPQ 594, 595 (TTAB 1963) (distinguishing the case from *Reemtsma* on the ground that the facts on record demonstrate that tobacco use is not offensive to followers of the Amish religion).

³⁰ See *In re Runsdorf*, 171 USPQ 443, 443 (TTAB 1971).

³¹ See *Ex parte Martha Maid Manufacturing Co*, 37 USPQ 156, 156 (Commr Pat 1938).

³² See *In re Old Glory Condom Corp*, 26 USPQ2d 1216, 1220 (TTAB 1993).

³³ *In re Thomas Laboratories, Inc*, 189 USPQ 50, 52 (TTAB 1975).

³⁴ See *In re Riverbank Canning Co*, 95 F2d 327, 329 (CCPA 1938).

³⁵ See *In re Sociedade Agricola E. Comerical Dos Vinhos Messias*, 159 USPQ 275, 276 (TTAB 1968) (rejecting the arguments that “messiah” has a more remote connection to Jesus Christ than “madonna” to the Virgin Mary and that the word is “archaic”).

BADASS was found to be registrable as a mark for musical instruments;³⁶ JACK-OFF was found to be scandalous while JACK OFF JILL was not.³⁷

The jurisprudence surrounding trademarks deemed “disparaging” has been similarly plagued with subjectivity and hard-to-explain distinctions. DOUGH-BOY was found to be disparaging to American veterans of the World War I for use as a mark for antivenereal-disease preparation,³⁸ and a mark depicting the national symbol of the Soviet Union with an “X” superimposed on it was refused registration because it would be disparaging to Soviet citizens.³⁹ In contrast, JAP was found not to be disparaging to people of Japanese ancestry,⁴⁰ and REDSKINS was not disparaging to Native American Indians.⁴¹ An opposition claim that the mark BLACK TAIL for adult magazines was disparaging to African-American women because the word TAIL was perceived as a vulgar and derogatory reference to women as female sex objects was dismissed for failure of proof,⁴² while a group of women was allowed standing to oppose as disparaging the mark ONLY A BREAST IN THE MOUTH IS BETTER THAN A LEG IN THE HAND for restaurant services.⁴³ It appears that the success of a registration application for a trademark that may be characterized as “scandalous,” “immoral,” or “disparaging” turns more on the degree of subjective political, religious, and moral sensibilities of the particular decisionmaker than on any objectively ascertainable criteria.

The proscriptions of § 2(a) are directed at the content of trademarks and, as content-based restraints on speech, raise concerns about their conformity with the First Amendment. Despite the constitutional

³⁶ See *In re Leo Quan, Inc.*, 200 USPQ 370, 371 (TTAB 1978) (accepting applicant’s contention that the word was an acronym for “Bettencourt Acoustically Designed Audio Sound System”).

³⁷ See *In re Boulevard Entertainment, Inc.*, 334 F3d 1336, 1343 (Fed Cir 2003) (reasoning that JACK OFF JILL contains an implicit reference to a nursery rhyme involving Jack and Jill which creates a double entendre missing from the simply vulgar mark JACK-OFF).

³⁸ See *Doughboy Industries, Inc v Reese Chemical Co.*, 88 USPQ 227, 228 (PTO 1951) (rejecting the application despite the applicant’s past use of the mark on other products).

³⁹ See *In re Anti-communist World Freedom Congress, Inc.*, 161 USPQ 304, 305 (TTAB 1969) (holding that the mark was disparaging a national symbol of the USSR regardless of whether it was intended to express opposition to the Communist Party).

⁴⁰ See *In re Condas SA*, 188 USPQ 544, 544 (TTAB 1975).

⁴¹ See *Harjo v Pro-football, Inc.*, 284 F Supp 2d 96 (DDC 2003).

⁴² See *Boswell v Mavety Media Group, Ltd.*, 52 USPQ2d 1600, 1609 (TTAB 1999) (noting that the word “tail” could have many meanings and that the opponents of the trademark presented no evidence that its use in the mark was disparaging to the relevant groups).

⁴³ See *Bromberg v Carmel Self Service, Inc.*, 198 USPQ 176, 179 (TTAB 1978) (interpreting the statute to mean that anyone opposing a mark’s registration has standing to bring an action if they believe the mark to be disparaging and that they would be damaged by it).

disfavor of content-based restrictions, courts have not critically examined the First Amendment implications of § 2(a). Some scholarly attention has been dedicated to the matter but those efforts have failed to evaluate the constitutionality of § 2(a) through the lens of the public forum doctrine, the proper analytical tool for examining restrictions on speech on government property.⁴⁴

II. THE FIRST AMENDMENT

The § 2(a) prohibition on registration of “scandalous,” “immoral,” and “disparaging” trademarks implicates the First Amendment. Trademarks are commercial speech⁴⁵ and § 2(a) discriminates between the marks based on their content.⁴⁶ Content-based restrictions are presumptively unconstitutional,⁴⁷ but the case of § 2(a) is complicated by the fact that it regulates speech on government property, the Principal Register. Restrictions on speech on public property are subject to a different set of rules. The correct analytical framework is supplied by the “public forum” doctrine, which accords the government different levels of authority to regulate speech on its property depending on the type of the forum.⁴⁸ Restrictions in traditional and designated public fora are subject to strict scrutiny, while regulation of speech in a non-public forum must only be reasonable and viewpoint-neutral.⁴⁹ Oddly enough, courts that have had an opportunity to examine the validity of § 2(a) have failed even to consider these questions, dismissing the First Amendment claims on the theory that § 2(a) does not bar the *use* of the trademark as an *unregistered* mark.

⁴⁴ See, for example, Llewellyn J. Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(a) Trademark Law after Lawrence v. Texas*, 9 Marq Intel Prop L Rev 187, 247 (2005) (limiting its analysis of the public forum question to an observation that “[a]rguendo, the register of trademark is [] a public forum for the purpose of registering trademarks”); Justin G. Blankenship, Note, *The Cancellation of Redskins as a Disparaging Trademark: Is Federal Trademark Law an Appropriate Solution for Words That Offend?*, 72 U Colo L Rev 415, 438–46 (2001) (arguing that § 2(a) furthers a substantial governmental interest in preventing racial unrest under the commercial speech test as applied to the mark REDSKINS but failing to address the public forum issue); Theodore H. Davis, *Registration of Scandalous, Immoral and Disparaging Matter under Section 2(a) of the Lanham Act: Can One Man’s Vulgarly Be Another’s Registered Trademark?*, 54 Ohio St L J 331, 364–71 (1993) (analyzing § 2(a) under the unconstitutionality conditions doctrine); Baird, 83 Trademark Rep at 677–701 (cited in note 27) (offering a detailed discussion of the constitutionality of § 2(a) but not addressing the public forum doctrine).

⁴⁵ See text accompanying notes 64–68.

⁴⁶ See text accompanying notes 69–82.

⁴⁷ *R.A.V. v. St. Paul*, 505 US 377, 382 (1992).

⁴⁸ See Part III.A.

⁴⁹ See *id.*

A. Constitutional Analysis (or Lack Thereof) of § 2(a) in Courts

Courts that have addressed constitutional challenges to § 2(a) have determined that it does not violate the First Amendment. The Court of Customs and Patent Appeals in *In re McGinley*⁵⁰ was presented with a challenge to the constitutionality of § 2(a)'s ban on registration of "scandalous" marks. Although the unsuccessful applicant-plaintiff in *In re McGinley* challenged § 2(a) under the Due Process Clause of the Fifth Amendment, the court proceeded to examine the statute under the First Amendment.⁵¹ Summarily rejecting the claim, the court tersely observed that "it is clear that the PTO's refusal to register [an applicant's] mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant's First Amendment rights would not be abridged by the refusal to register his mark."⁵²

Subsequent judicial analysis of § 2(a) has been equally cursory. In *In re Mavety Media Group*,⁵³ the court, quoting the passage above, held that *In re McGinley* "forecloses [First Amendment] challenges to [§ 2(a)] as unconstitutional on its face or as applied."⁵⁴ In *Ritchie v Simpson*,⁵⁵ although the constitutional validity of § 2(a) was not before the court, the majority responded to the dissent's First Amendment concerns by observing that "the denial of federal registration of a mark does not prohibit the use of that mark."⁵⁶ In *Pro-football v Harjo*,⁵⁷ the court cited *In re McGinley* for the no-use-is-barred proposition but went on to invoke the doctrine of constitutional avoidance to resolve the claim on nonconstitutional grounds.⁵⁸ In *In re Boulevard Entertainment*,⁵⁹ the court, citing *In re McGinley* and *In re Mavety*, rejected the applicant's First Amendment argument because "[p]revious decisions of this court and our predecessor court . . . have rejected First Amendment challenges to refusals to register marks under section [2(a)]."⁶⁰

⁵⁰ 660 F2d 481 (CCPA 1981).

⁵¹ See id at 483-84.

⁵² Id at 484.

⁵³ 33 F3d 1367 (Fed Cir 1994).

⁵⁴ Id at 1374.

⁵⁵ 170 F3d 1092 (Fed Cir 1999).

⁵⁶ Id at 1099. But see id at 1103 n 1 (Newman dissenting) ("The [*In re McGinley*] ruling has received much criticism.").

⁵⁷ 57 USPQ2d 1140 (DDC 2000).

⁵⁸ See id at 1143 (denying judgment on the pleadings on the basis that the constitutional claims were premature under the avoidance doctrine and because the laches claim required a more complete record).

⁵⁹ 334 F3d 1336 (Fed Cir 2003).

⁶⁰ Id at 1343.

B. Inadequacy of *In re McGinley* and Its Progeny

As has been widely suggested by commentators, the dismissal of First Amendment challenges to § 2(a) based on the applicants' unbridged right to *use* the unregistered mark entirely misses the point.⁶¹ Ability to use the particular mark without registration has nothing to do with and does not resolve the problem that the registration itself, as a grant of a valuable government benefit, is premised upon regulation of the trademark's content. A mark is refused registration because the government finds its content improper. Thus, even though an applicant may still use the mark as an unregistered trademark, denial of registration imposes a penalty for her particular choice of a mark solely because of its content. "[T]he fact that no direct restraint or punishment is imposed upon speech or assembly does not determine the free speech question. . . . [I]ndirect 'discouragements' undoubtedly have the same coercive effect upon the exercise of First Amendment rights as imprisonment, fines, injunctions or taxes."⁶² "[O]ne is not to have the exercise of his liberty of expression in appropriate places abridged on the plea that it may be exercised in some other place."⁶³ In that light, an applicant's ability to *use* a trademark cannot dispose of the question of constitutionality of § 2(a).

1. Section 2(a) as a content-based restriction on speech.

Trademarks are commercial speech entitled to First Amendment protection.⁶⁴ The nature and fundamental functions of trademarks

⁶¹ See, for example, Robert Wright, *Today's Scandal Can Be Tomorrow's Vogue: Why Section 2(a) of the Lanham Act Is Unconstitutionally Void for Vagueness*, 48 Howard L J 659, 682 (2005) (noting with respect to *In re McGinley*'s reasoning that "it is illogical to conclude that the denial of federal registration does not have at least a de minimis impact on an applicant's First Amendment rights"); Kimberly A. Pace, *The Washington Redskins Case and the Doctrine of Disparagement: How Politically Correct Must a Trademark Be?*, 22 Pepperdine L Rev 7, 48 (1994) ("Blanket reliance on the CCPA decision in [*In re McGinley*] would be inappropriate since that court glossed over the difficult constitutional challenges in a cursory manner, without articulating any analysis for its decision."); Baird, 83 Trademark Rep at 686 (cited in note 27) (describing the *In re McGinley* decision as being "without a reasoned and well articulated analysis of the difficult underlying issues"). It is hard to explain the dearth of challenges to § 2(a) and the courts' cavalier treatment of the constitutional concerns raised. One might only hazard a guess that the dismissiveness was due to a combination of judicial inertia, disproportionate deference to a prior precedent by a specialized court, TTAB's lack of constitutional authority to strike down statutes as a non-Article III tribunal, and the relative rarity of trademark owners who would risk business losses by using an "offensive" trademark.

⁶² *American Communications Association v Douds*, 339 US 382, 402 (1950).

⁶³ *Schneider v Irvington*, 308 US 147, 163 (1939).

⁶⁴ See *Virginia Pharmacy Board v Virginia Citizens Consumer Council*, 425 US 748, 770 (1976).

qualify them as commercial speech. The primary function of trademarks is to identify and distinguish the source of a seller's goods by signifying that they come from or are controlled by a single source and are of a certain level of quality and value.⁶⁵ Trademarks also serve as a "prime instrument in advertising and selling goods" and as "the most important element of commercial speech which is communicated to consumers."⁶⁶ By imparting a certain message to the world about the subject it signifies, the communicative aspect of a trademark is central to its purpose.

Commercial speech has been defined as speech that does "no more than propose a commercial transaction."⁶⁷ The trademark's functions of source identification, quality guarantee, and advertising all at their bottom serve simply to propose a commercial transaction to consumers—to get the potential consumers to buy the product bearing the mark. The Supreme Court has also held that "the mere solicitation of patronage implicit in a trade name" is "a form of commercial speech."⁶⁸ Although the case involved trade names and the Court has not taken up the question of trademarks, the logic of treating trade names as commercial speech should undoubtedly extend to trademarks because, like trademarks, trade names identify the source of and provide information about the goods or services in question.

An important feature of the prohibition on registration of trademarks that are "scandalous," "immoral," or "disparaging" is that it op-

⁶⁵ See Thomas J. McCarthy, 1 *McCarthy on Trademarks and Unfair Competition* § 3:2 at 3–4 (West 2007) (outlining four functions served by trademarks: identifying a seller's goods; signifying that all goods bearing the trademark come from a single source; signifying that all goods bearing the trademark are of equal level of quality; and advertising the goods); David C. Wilkinson, *The Community Trade Mark Regulation and Its Role in European Economic Integration*, 80 *Trademark Rep* 107, 109–11 (1990) (suggesting that a trademark performs an origin identification function, a quality guarantee function, and a publicity function); William M. Landes and Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 *J L & Econ* 265, 268–70 (1987) ("The value of a trademark is the saving in search costs made possible by the information and reputation that the trademark conveys or embodies about the brand (or the firm that produces the brand).").

⁶⁶ See McCarthy, 1 *McCarthy* § 3:2 at 3–4 (cited in note 65); Thomas J. McCarthy, 6 *McCarthy on Trademarks and Unfair Competition* § 31:139 at 222 (West 2007).

⁶⁷ *Virginia Pharmacy*, 425 US at 762, quoting *Pittsburgh Press Co v Human Relations Commission*, 413 US 376, 385 (1973).

⁶⁸ *Friedman v Rogers*, 440 US 1, 11 n 10 (1979). See also Thomas J. McCarthy, *Compulsory Licensing of a Trademark: Remedy or Penalty*, 67 *Trademark Rep* 197, 234 (1977):

It would appear that a company's trademark is the most important element of commercial speech which is communicated to consumers. If commercial speech is protected under the First Amendment to preserve a free marketplace of commercial messages and to contribute to free competition, then a trademark is at the core of the First Amendment protection.

erates as a content-based restraint on speech. Other content-neutral prohibitions contained in § 2 bar marks that convey false⁶⁹ or misleading information⁷⁰ or marks that would undermine competition,⁷¹ and thus do not raise First Amendment concerns.⁷² In contrast, § 2(a)'s prohibition of marks that impart a message that is "scandalous," "immoral," or "disparaging" is a regulation of speech based on its content. "[L]aws that by their terms distinguish favored speech from disfavored speech on the basis of the ideas or views expressed are content based."⁷³ A government interference with the "marketplace of ideas" by favoring one message or particular content over another has been traditionally viewed as problematic and goes to the heart of what the

⁶⁹ See 15 USC § 1052(a) (prohibiting registration of marks that "falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols" and of marks for wines and spirits that carry a "geographical indication" of a place "other than the origin of the goods").

⁷⁰ See 15 USC §§ 1052(b) (prohibiting marks comprising the flag, coat of arms, or insignia of sovereign units), 1052(c) (prohibiting marks comprising a name, portrait, or signature of an individual without his or her consent, or the name, portrait, or a signature of a deceased president without the widow's consent), § 1052(d) (prohibiting marks which "so resemble[]" existing registered marks "as to be likely . . . to cause confusion, or to cause mistake, or to deceive"), 1052(e)(1) (prohibiting marks which are "merely descriptive or merely deceptively misdescriptive"), 1052(e)(2)–(3) (prohibiting marks which are "primarily geographically descriptive" or "primarily geographically deceptively misdescriptive"), 1052(e)(4) (prohibiting marks that are primarily merely surnames).

⁷¹ See 15 USC §§ 1052(e)(5) (prohibiting "functional" marks), 1052(f) (prohibiting marks which may cause dilution of an existing famous mark). The provisions cited in notes 69 and 70 likewise aim to preserve fair competition by protecting the good will of the trademark owner and preventing free riding and consumer confusion; § 1052(e)(5) is different in that it is not based on the mark's subject matter. Functionality is a key concept in trademark law barring protection of designs that have such superior functional utility that competition would be hindered if the owner is allowed to claim exclusive rights to it. See Restatement (Third) of Unfair Competition § 17 at 172 (ALI 1995):

A design is functional . . . if [it] affords benefits in the manufacturing, marketing, or use of the good or services with which the design is used, apart from any benefits attributable to the design's significance as an indication of source, that are important to effective competition by others and that are not practically available through the use of alternative designs.

⁷² False and misleading commercial speech is not entitled to First Amendment protection. See *Central Hudson Gas & Electric Corp v Public Service Commission of New York*, 447 US 557, 566 (1980).

⁷³ *Turner Broadcasting System, Inc v FCC*, 512 US 622, 643 (1994). On the other hand, content-neutral restrictions are those that "place no restrictions on . . . either a particular viewpoint or any subject matter that may be discussed." *Hill v Colorado*, 530 US 703, 723 (2000). See also *id* at 737 (Souter concurring) ("[A] restriction is content based only if it is imposed because of the content of the speech . . . and not because of [the manner of] its delivery."); *Burk v Augusta-Richmond County*, 365 F3d 1247, 1254 (11th Cir 2004) ("A content-neutral conduct regulation applies equally to all, and not just to those with a particular message or subject matter in mind."), citing *Hill*, 530 US at 723; Geoffrey R. Stone, et al, *Constitutional Law* 1291 (Aspen 5th ed 2005) ("Content-neutral restrictions limit expression without regard to its content. They turn neither on their face nor as applied on the content or communicative impact of speech.").

First Amendment protects.⁷⁴ “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.”⁷⁵ Moreover, while First Amendment doctrine on commercial speech allows for some regulation of content,⁷⁶ even commercial speech, “however tasteless and excessive it sometimes may seem,”⁷⁷ cannot be restrained for its mere offensiveness.⁷⁸ For this reason, content-based restrictions on speech must be carefully scrutinized to ensure that the government does not suppress or chill ideas it disagrees with.⁷⁹ *In re McGinley* and its progeny overlook § 2(a)’s obvious tension with this principle: if the government is not allowed to ban displays of fighting words that “insult, or provoke violence on the basis of race, color, creed, religion, or gender”;⁸⁰ prerecorded dial-a-porn telephone messages;⁸¹ or motion picture displays in which “female breasts and bare buttocks were shown”⁸²—undoubtedly unpalatable speech to some—then the constitutional validity of a ban on registration of marks like MADONNA or MESSIAS is in grave doubt.

2. The problem of government-provided benefits.

It has been suggested that “[a]bridging’ within the meaning of the First Amendment may occur even if the law in question does not by its terms either prohibit or punish speech.”⁸³ Although registration on the Principal Register is a privilege and not a right, the Court has recognized that “to deny [a benefit to those] who engage in certain forms of speech is in effect to penalize them for such speech. Its deterrent effect is the same as if [they] were fine[d] . . . for this speech.”⁸⁴ In

⁷⁴ See *R.A.V.*, 505 US at 382 (“The First Amendment generally prevents government from proscribing speech . . . because of disapproval of the ideas expressed.”); *Simon & Schuster v New York State Crime Victims Board*, 502 US 105, 116 (1991) (“[T]he government’s ability to impose content-based burdens on speech raises the specter that the government may effectively drive certain ideas or viewpoints from the marketplace.”).

⁷⁵ *Texas v Johnson*, 491 US 397, 414 (1989).

⁷⁶ See text accompanying notes 190–93.

⁷⁷ *44 Liquormart, Inc v Rhode Island*, 517 US 484, 496 (1996).

⁷⁸ *Bolger v Young Drug Products Corp.*, 463 US 60, 71 (1983), quoting *Carey v Population Services International*, 432 US 678 (1977).

⁷⁹ See *Police Department of Chicago v Mosley*, 408 US 92, 95–96, 98–99 (1972).

⁸⁰ See *R.A.V.*, 505 US at 391–92.

⁸¹ See *Sable Communications of California, Inc v FCC*, 492 US 115, 126 (1989) (holding that indecent but nonobscene speech is protected under the First Amendment).

⁸² See *Erznoznik v Jacksonville*, 422 US 205, 209 (1975).

⁸³ See Melville B. Nimmer, *Nimmer on Freedom of Speech* § 4.07 at 4–33 (Matthew Bender 1984).

⁸⁴ *Speiser v Randall*, 357 US 513, 518 (1958).

Speiser v Randall,⁸⁵ the Court held that “a discriminatory denial of a tax exemption for engaging in speech is a limitation on free speech.”⁸⁶ Simply because what is denied is a “privilege,” it does not follow that “its denial may not infringe speech.”⁸⁷ Similarly, in *Perry v Sindermann*,⁸⁸ the Court held that a state college may have violated a teacher’s First Amendment rights by refusing to renew his contract—the employee’s lack of a contractual or tenure right to re-employment notwithstanding—when the basis of the nonrenewal was the employee’s public criticism of his superiors on matters of public concern:

[E]ven though a person has no “right” to a valuable governmental benefit and even though the government may deny him the benefit for any number of reasons . . . [i]t may not deny a benefit to a person on a basis that infringes his constitutionally protected interests—especially, his interest in freedom of speech.⁸⁹

Section 2(a) operates precisely in this manner.

Neither is § 2(a) a case of a selective nonsubsidy of government benefits. The First Amendment distinguishes between the government’s right not to subsidize speech that falls outside or distorts its own programs and imposing a penalty for the exercise of one’s rights in free speech. The former is permissible; the latter is not. The prohibition of § 2(a) is more like a penalty than a selective nonsubsidy of speech.

The Court addressed the distinction between “penalty” and “nonsubsidy” in *Rust v Sullivan*.⁹⁰ *Rust* involved a challenge to Department of Health and Human Services regulations limiting “the ability of Title X fund recipients to engage in abortion-related activities,” including provision of information about abortion services.⁹¹ In upholding the regulations against a First Amendment challenge, the Court held:

The Government can, without violating the Constitution, selectively fund a program to encourage certain activities it believes to be in the public interest, without at the same time funding an alternative program which seeks to deal with the problem in another way. . . . A refusal to fund protected activity, without

⁸⁵ 357 US 513 (1958).

⁸⁶ *Id.* at 529 (reversing the denial of property tax exemptions to war veterans for their refusal to execute a loyalty oath).

⁸⁷ *Id.* at 518.

⁸⁸ 408 US 593 (1972).

⁸⁹ See *id.* at 596–97 (explaining that to allow the government to deny benefits based on constitutionally protected activity would impermissibly penalize that activity).

⁹⁰ 500 US 173 (1991).

⁹¹ *Id.* at 177–78.

more, cannot be equated with the imposition of a “penalty” on that activity. There is a basic difference between direct state interference with a protected activity and state encouragement of an alternative activity consonant with legislative policy.⁹²

The Court went on to explain that “when the Government appropriates public funds to establish a program it is entitled to define the limits of that program.”⁹³ One might argue that § 2(a) involves just such a situation: in setting up the Principal Register, the government has established its own program and has defined its limits in a way that excludes offensive matter. The analogy, however, is false. The Court elaborated on the meaning of *Rust* in subsequent cases. In *Rosenberger v Rector and Visitors of the University of Virginia*,⁹⁴ the Court clarified that the government is permitted to “regulate the content of what is or is not expressed [with its subsidy] *when it is the speaker or when it enlists private entities to convey its own message.*”⁹⁵ By establishing the Principal Register, the government neither speaks nor enlists private parties to convey the *government’s* message. Trademarks carry the owner’s message, not the federal government’s. The Principal Register is not the government’s policy statement but a medium through which private expressive activity is channeled.⁹⁶ As the Court later observed, “Congress cannot recast a condition on funding as a mere definition of its program in every case, lest the First Amendment be reduced to a simple semantic exercise.”⁹⁷ Rather than being a discretionary nonprovision of the benefit of registration, cast as a parameter of the federal “trademark program,” § 2(a) acts as a penalty on the

⁹² Id at 193 (quotation marks and citations omitted).

⁹³ Id at 194.

⁹⁴ 515 US 819 (1995).

⁹⁵ Id at 833–34 (emphasis added).

⁹⁶ Compare *Legal Services Corp v Velazquez*, 531 US 533, 542 (2001) (holding that legal representation of indigent clients by attorneys funded by Congress was private speech because such a “lawyer speaks on behalf of his or her private . . . client” and “represents the interests of indigent clients”), and *Rosenberger*, 515 US at 834–35 (observing that the “distinction between the [public] University’s own favored message and the private speech of students [eligible for University Student Activities Fund support] is evident” because the students “are not the University’s agents, are not subject to its control, and are not its responsibility”), with *Rust*, 500 US at 193 (holding that the challenged regulations “are designed to ensure that the limits of the federal program . . . to encourage family planning” were observed). See also *Velazquez*, 531 US at 542 (distinguishing *Rust* and clarifying that “[t]he Court in *Rust* did not place explicit reliance on the rationale that the counseling activities of the doctors under Title X amounted to governmental speech”); *Rosenberger*, 515 US at 833 (explaining that in *Rust* “the government did not create a program to encourage private speech but instead used private speakers to transmit specific information pertaining to its own program”).

⁹⁷ *Velazquez*, 531 US at 547.

exercise of a private right to freedom of speech.⁹⁸ *In re McGinley*-type reasoning fails even to acknowledge this difficulty.

3. Unconstitutional burdens on speech.

Disadvantaging the exercise of free speech rights is no less offensive to the First Amendment than direct government regulation. In *Simon & Schuster v Members of New York State Crime Victims Board*,⁹⁹ the Court unanimously rejected the proposition that the government may financially burden speech on the basis of its content.¹⁰⁰ At issue in *Simon & Schuster* was New York's so-called "Son of Sam" law, which required the income of a convicted or accused criminal from publication of books describing his or her crime(s) to be placed into a special escrow account that would then be used to satisfy civil judgments against the criminal for the victim(s).¹⁰¹ Finding the law to be "plainly impos[ing] a financial disincentive only on speech of a particular content"—speech about the crimes of the author—the Court applied strict scrutiny to invalidate it.¹⁰² The Court reiterated that "[a] statute is presumptively inconsistent with the First Amendment if it imposes a financial burden on speakers because of the content of their speech" and reasoned that "[t]he government's ability to impose content-based burdens on speech raises the specter that the government may effectively drive certain ideas and viewpoints from the marketplace."¹⁰³

Section 2(a)'s content-based ban does not impose a direct financial burden such as that discussed in *Simon & Schuster*. But in light of the multiple benefits of federal registration, the ban limits a trademark owner's ability to protect her trademark to the fullest extent available to registered trademarks and thereby chills her freedom of expression. Federal registration benefits such as nationwide notice and prima facie evidence of incontestability of the trademark help to avoid litigation and make protection against infringement cheaper.¹⁰⁴ Section

⁹⁸ The Court has struck down similar penalties on private expression. See, for example, *Rutan v Republican Party*, 497 US 62, 71 (1990) ("Conditioning continued public employment on an employee's having obtained support from a particular political party violates the First Amendment because of the coercion of belief that necessarily flows from the knowledge that one must have a sponsor in the dominant party in order to retain one's job.") (quotation marks and citation omitted); *Wieman v Updegraff*, 344 US 183, 190–91 (1952) (rejecting the conditioning of compensation on a loyalty oath as imposing penalties for engaging in First Amendment activities).

⁹⁹ 502 US 105 (1991).

¹⁰⁰ See *id.* at 123. See also *Rosenberger*, 515 US at 828.

¹⁰¹ See *Simon & Schuster*, 502 US at 108.

¹⁰² *Id.* at 116.

¹⁰³ *Id.* at 115–16 (citation omitted).

¹⁰⁴ See text accompanying notes 17–21.

2(a) thus provides a financial disincentive against use of marks that may be found to be “scandalous,” “immoral,” or “disparaging.”

4. The ban on registration of “disparaging” trademarks as a viewpoint-based restraint.

Although *In re McGinley* did not involve a “disparaging” mark, its reasoning overlooks the fact that the ban on registration of “disparaging” marks raises special concerns as a viewpoint-based restraint. The line between content-based restrictions and viewpoint restrictions, which are a subclass of the former, is often hard to discern.¹⁰⁵ The Court has not offered clear guidance as to when a restriction crosses the line from a purely content-based restraint and ventures into the realm of viewpoint discrimination.¹⁰⁶ In a simplified characterization, a viewpoint restraint is one that allows one view on a certain subject but disallows another. For instance, a law allowing praise of the Iraq War but not criticism of it would be viewpoint-based, while a law that would ban the discussion of the War altogether would be content-based. In that light, § 2(a)’s singling out of “disparaging” marks is a viewpoint-based regulation because it allows registration for marks that glorify, praise, or promote “persons, . . . institutions, beliefs, or national symbols” but not for marks that take the opposite view. Thus, a trademark DOWN WITH THE KKK might be ineligible for registration while a mark LONG LIVE HEZBOLLAH might be registrable, for the former is “disparaging” and the latter is not.¹⁰⁷

Viewpoint-based restrictions are presumptively unconstitutional.¹⁰⁸ These restrictions are particularly disfavored due to their tendency to distort the marketplace of ideas.¹⁰⁹ By restricting or excising from discourse a particular viewpoint, viewpoint-based restraints disadvantage only one side of the public debate and thus inhibit a full exposition of ideas.¹¹⁰ “[T]he First Amendment forbids the government to regulate

¹⁰⁵ See *Rosenberger*, 515 US at 829 (explaining that viewpoint discrimination is an “egregious form of content discrimination”).

¹⁰⁶ See *id.* at 831 (acknowledging that the distinction between content-based and viewpoint discrimination “is not a precise one”).

¹⁰⁷ See, for example, *R.A.V.*, 505 US at 391–92 (invalidating an ordinance proscribing fighting words on the basis of race, color, creed, religion, or gender because it would allow one to “hold up a sign saying . . . that all ‘anti-Catholic bigots’ are misbegotten; but not that all ‘papists’ are, for that would insult and provoke violence ‘on the basis of religion’”).

¹⁰⁸ *Rosenberger*, 515 US at 830.

¹⁰⁹ See generally Geoffrey R. Stone, *Content Regulation and the First Amendment*, 25 Wm & Mary L Rev 189 (1983) (discussing the special concerns raised by viewpoint-based restrictions).

¹¹⁰ See *id.* at 197–200.

speech in ways that favor some viewpoints or ideas at the expense of others.”¹¹¹ Moreover, viewpoint-based restraints are impermissible in any type of forum under the arguably more pro-regulation public forum doctrine.¹¹² Simply rejecting a First Amendment attack on § 2(a) because the statute does not bar the *use* of the rejected trademark ignores the fact that, at least with respect to “disparaging” marks, § 2(a) imposes a constitutionally invalid restriction based on viewpoint.

III. THE PUBLIC FORUM DOCTRINE

The constitutional analysis of § 2(a) is peculiar in that under the Lanham Act framework, a trademark is speech that seeks access to government property, the Principal Register. This is a critical distinction because regulation of speech on government property is subject to a different framework of rules than purely private speech. While the inscription “Fuck the Draft” on a jacket is protected expression,¹¹³ it is nearly inconceivable that the First Amendment must protect the “right” to scribble the same phrase on the wall in the lobby of the Pentagon. Recognizing the need to allow the government, as a property owner, to control access to its property and to preserve its purposes,¹¹⁴ the Court has created the public forum doctrine to assess the constitutionality of regulations of speech on government property.¹¹⁵ The doctrine distinguishes between three types of government property—a

¹¹¹ *Members of the City Council of the City of Los Angeles v Taxpayers for Vincent*, 466 US 789, 804 (1984).

¹¹² See Part III.A. See also *Perry Education*, 460 US at 57 (Brennan dissenting) (“[T]he Court disregards the First Amendment’s central proscription against viewpoint discrimination, in any forum, public or nonpublic.”). Viewpoint-discriminatory regulations were upheld in *Rust*, because the regulations involved discretionary funding of the government’s own program. But as the Court explained in striking down viewpoint-based denials of government benefits, “viewpoint-based restrictions are improper when the government does not itself speak or subsidize transmittal of a message it favors but instead expends funds to encourage a diversity of views from private speakers.” *Velazquez*, 541 US at 542. In the context of § 2(a), the government neither speaks itself nor subsidizes its own message through private speakers. See Part II.B.2.

¹¹³ *Cohen v California*, 403 US 15, 26 (1971).

¹¹⁴ See *Greer v Spock*, 424 US 828, 836 (1976) (upholding a regulation banning the distribution of political material on a military base because the government, “no less than a private owner of property, has power to preserve the property under its control for the use to which it is lawfully dedicated”); *Adderley v Florida*, 385 US 39, 48 (1966) (affirming the conviction of a group of protestors for trespass onto jail property because the First Amendment guarantees do not mean “that people who want to propagandize protests or views have a constitutional right to do so whenever and however and wherever they please”).

¹¹⁵ For the history and evolution of the public forum doctrine, see generally Robert C. Post, *Between Governance and Management: The History and Theory of the Public Forum*, 34 UCLA L Rev 1713 (1987); Daniel A. Farber and John E. Nowak, *The Misleading Nature of Public Forum Analysis: Content and Context in First Amendment Adjudication*, 70 Va L Rev 1219 (1984).

traditional or quintessential public forum, a designated or limited public forum, and a nonpublic forum. The type of the forum determines the level of scrutiny applied to the regulation.

A. The Doctrine

The public forum doctrine divides government property into three distinct types of fora. The “traditional” or “quintessential” public forum is “defined by the objective characteristics of the property, such as whether, ‘by long tradition or by government fiat,’ the property has been ‘devoted to assembly and debate.’”¹¹⁶ These fora—streets, parks, and sidewalks—have “immemorially been held in trust for the use of the public” and are open for expressive activity regardless of the government’s intent.¹¹⁷ The government may impose a content-based exclusion in these fora only upon a showing of a compelling government interest and only if the exclusion is narrowly drawn to achieve that interest.¹¹⁸

The second category is the “designated” or “limited” public forum, property that the government “has opened for use by the public as a place for expressive activity”¹¹⁹ by part¹²⁰ or all of the public. That is, in contrast to traditional public fora, “designated public fora . . . are created by purposeful governmental action.”¹²¹ The government intent to open up such a forum is critical.¹²² Although the government is not required to open up such a forum, once it does so, it is bound by the same rules that govern the traditional public forum.¹²³

¹¹⁶ *Arkansas Education Television Commission v Forbes*, 523 US 666, 667 (1998), citing *Perry Education Association v Perry Local Educators’ Association*, 460 US 37, 45 (1983).

¹¹⁷ *Perry Education*, 460 US at 45, citing *Hague v CIO*, 307 US 496, 515 (1939). See also *United States v Grace*, 461 US 171 (1983) (holding that public sidewalks are traditional public fora and therefore an ordinance could not prohibit distribution of literature on the sidewalk outside the Supreme Court).

¹¹⁸ *Perry Education*, 460 US at 45. The government may also enforce narrowly tailored, content-neutral regulations pertaining to the time, place, and manner of expression in a public forum if they “serve a significant government interest, and leave open ample alternative channels of communication.” *Id.* (citations omitted). See also *Ward v Rock against Racism*, 491 US 781, 803 (1989) (applying this principle to a city’s sound-amplification guidelines). This principle, however, does not apply to § 2(a)’s content-based restrictions.

¹¹⁹ *Perry Education*, 460 US at 45.

¹²⁰ See *id.* at 46 n 7 (“A public forum may be created for a limited purpose such as use by certain groups [such as student groups], or for the discussion of certain subjects [such as school board business].”). Hence, the designation of the forum as a “limited” public forum.

¹²¹ *Forbes*, 523 US at 677.

¹²² See *Cornelius v NAACP Legal Defense & Educational Fund, Inc.*, 473 US 788, 802 (1985) (“The government does not create a public forum by inaction or by permitting limited discourse, but only by intentionally opening a nontraditional forum for public discourse.”).

¹²³ *Perry Education*, 460 US at 46.

Finally, all the remaining public property is a nonpublic forum. The government may restrict access to such fora if the regulation of speech is reasonable and “not an effort to suppress expression merely because public officials oppose the speaker’s view.”¹²⁴

B. The Principal Register as a Forum

As a source of federal trademark rights, the Register is the relevant forum for free speech scrutiny. That the grant of access to the governmental property is accompanied by expression in private fora does not change the locus of the public forum inquiry. Even though trademarks perform their core functions in the private marketplace, the Register itself is the forum where the rights of the speaker are asserted, defined, and conveyed to the rest of the world. In the analogous context of a thoroughbred naming registry, the Sixth Circuit in *Redmond v The Jockey Club*¹²⁵ applied the public forum doctrine to determine the constitutionality of the Club’s refusal to register the plaintiff’s horse under the name SALLY HEMINGS.¹²⁶ The thoroughbred could have enjoyed a fine racing career regardless of its name. But the additional benefits of participating in certain races were available only upon the registration of the horse, so the registry was the proper subject of the public forum analysis. As in *Redmond*, a trademark owner’s ability to obtain registration determines her access to benefits that stem from federal registration.¹²⁷

In framing its vision of the public forum doctrine, the Court has differentiated between the government’s actions as a proprietor and as a regulator.¹²⁸ This apparent dichotomy between the government’s role as a “proprietor” and a “lawmaker” might be misunderstood to suggest that the government cannot act as a regulator when it is acting as a proprietor and that, consequently, when it is acting as a regulator, the public forum doctrine does not apply. Yet, the government’s exercise of one of these roles does not preclude the other. When the Court applied the public forum doctrine in cases like *International Society*

¹²⁴ *Id.*

¹²⁵ 244 Fed Appx 663 (6th Cir 2007).

¹²⁶ See *id.* at 668 (explaining that the registry was a limited public forum). The court assumed that the Club, acting under the grant of authority from the Kentucky Horse Racing authority, was a state actor.

¹²⁷ See text accompanying notes 17–21.

¹²⁸ See *International Society for Krishna Consciousness v Lee*, 505 US 672, 678 (1992) (“Where the government is acting as a proprietor, managing its internal operations, rather than acting as lawmaker with the power to regulate or license, its action will not be subjected to the heightened review to which its actions as a lawmaker may be subject.”).

for *Krishna Consciousness v Lee*,¹²⁹ *Cornelius v NAACP Legal Defense & Educational Fund, Inc.*,¹³⁰ and *Perry Education Association v Perry Locals Educators' Association*,¹³¹ the fact that the government was acting as a proprietor did not detract from the fact that it was also acting as a lawmaker regulating the operation of airport terminals, charity drives in a federal workplace, and management-labor relations in a school district.¹³² Similarly, while § 2(a) regulates the federal registration of trademarks, the regulation does not negate the fact that the government is simultaneously acting as a proprietor controlling access to its forum. The proper meaning of the proprietor/regulator distinction, therefore, should be understood to emphasize the public forum doctrine's threshold distinction between the government's authority to restrict speech on its property and its authority to do so with respect to all other speech.¹³³

In that light, § 2(a) calls for a public forum analysis. The Principal Register is federal property that provides a distinct source of rights,¹³⁴ and the PTO acts as a gatekeeper to screen access in dispensing these rights. It is true that the Register is not the kind of property that has "internal operations" that need to be "manag[ed]."¹³⁵ The access criteria to the Register are what defines the Register itself, and there are no other internal operations beyond the registration parameters. This truism, however, does not undermine the proprietary character of the Principal Register. What distinguishes § 2(a) from the government's nonproprietary, regulatory endeavors is that in addition to regulating economic rights, § 2(a) defines them in terms of access to a governmental forum; and it does so in a way that turns on the content of expression seeking entry to the forum. In other words, the government acts as a proprietor controlling the "quality" of the discourse in a forum of its creation.

¹²⁹ 505 US 672 (1992).

¹³⁰ 473 US 788 (1985).

¹³¹ 460 US 37 (1983).

¹³² See *id.* at 681 ("The practices of privately held transportation centers do not bear on the government's regulatory authority over a publicly owned airport"); *Cornelius*, 473 US at 805–06 (noting the government's interest, as an employer, in regulating the federal workplace); *Perry Education*, 460 US at 47–48 (discussing the school district's authority to preserve the interschool mail system for school-related business).

¹³³ See text accompanying notes 113–24.

¹³⁴ See text accompanying notes 17–21.

¹³⁵ *Lee*, 505 US at 678.

The Court has also recognized that the “metaphysical” nature of the forum is no bar to the application of the public forum doctrine.¹³⁶ Rather than being limited to physical property, the doctrine is concerned with access to particular channels of communication. For instance, the Court applied the public forum doctrine to “metaphysical” fora like the university student activity fund in *Rosenberger*,¹³⁷ to the federal employee charity drive in *Cornelius*,¹³⁸ and to the interschool mail system in *Perry Education*.¹³⁹ As in these cases, the government property to which trademarks seek access—the Principal Register—functions as a forum where elements of speech are accommodated.

Finally, it is the Principal Register itself and not the entire trademark system that is the relevant forum for purposes of the doctrine. In *Cornelius*, the relevant forum was not the entire federal workplace but the Combined Federal Campaign fund (CFC);¹⁴⁰ and in *Forbes* the relevant forum was the political candidate debate and not the full broadcast program of the television station.¹⁴¹ This is so because in determining the scope of the forum, the focus is “on the access sought by the speaker.”¹⁴² Accordingly, the relevant forum here is the Principal Register because it is the particular medium to which trademark owners seek access. One cannot apply for registration without owning a valid trademark in the first place. Necessarily, then, the forum to which an applicant seeks access is not the trademark system in general but the forum of the Principal Register. This point further demonstrates the inadequacy of *In re McGinley*’s reasoning: the public forum doctrine would be rendered meaningless if restrictions on speech on government property could be simply brushed aside by a reference to the individual’s ability to exercise his First Amendment rights elsewhere.

C. The Public Forum Doctrine in Application

As discussed above, the nature of the forum determines the level of scrutiny of the regulation. Content-based regulations in a traditional or designated forum are subject to strict scrutiny, while the same regulations in a nonpublic forum are reviewed only for reasonableness

¹³⁶ See *Rosenberger*, 515 US at 830 (“The [Student Activity Fund] is a forum more in a metaphysical than in a spatial or geographic sense, but the same principles are applicable.”).

¹³⁷ See *id.* at 830.

¹³⁸ See 473 US at 800.

¹³⁹ See 460 US at 45.

¹⁴⁰ See 473 US at 801.

¹⁴¹ See 523 US at 675.

¹⁴² *Cornelius*, 473 US at 801, citing *Greer*, 424 US at 836; *Perry Education*, 460 US at 45. See also generally *Lehman v City of Shaker Heights*, 418 US 298 (1974).

and viewpoint-neutrality. It is clear that the Principal Register is not a traditional forum, as it is neither a public street nor a park or sidewalk.¹⁴³ As will be demonstrated below, the Principal Register is not a designated forum either but rather a nonpublic forum.

The government does not create a public forum “by inaction or by permitting limited discourse, but only by intentionally opening a nontraditional forum for public discourse.”¹⁴⁴ Government intent is therefore critical to this assessment. To ascertain such intent, the Court looks to the “policy and practice” of opening the forum for “indiscriminate use.”¹⁴⁵ This includes consideration of whether the government has made its property “generally available” or whether, instead, it instituted a “selective access” regime to its forum.¹⁴⁶ The government does not create a designated forum when it restricts access through a system of selective, individualized permissions for members of a certain category of speakers.¹⁴⁷ Thus, a public forum does not exist when the government makes “individual, non-ministerial judgments” as to whether to grant access to the forum.¹⁴⁸ On the other hand, the government creates a designated forum when it makes a forum broadly available to the general public or to a class of speakers.¹⁴⁹

The analysis also focuses on the “nature of the property and its compatibility with expressive activity.”¹⁵⁰ When the nature or purpose of the governmental forum is inconsistent with a broad exercise of free speech rights by the general public, there is no public forum.¹⁵¹ “The mere fact that an instrumentality is used for the communication of ideas does not make a public forum.”¹⁵² Finally, the fact that the government uses the property for commercial purposes indicates that there is no limited forum.¹⁵³ The idea is that when the government en-

¹⁴³ See *Perry Education*, 460 US at 45.

¹⁴⁴ *Cornelius*, 473 US at 802.

¹⁴⁵ *Perry Education*, 460 US at 47 (explaining that a designated public forum would be created if the mail system were open to the general public, but that the school district’s limitations on its use meant that it was a nonpublic forum).

¹⁴⁶ *Forbes*, 523 US at 678–79.

¹⁴⁷ *Id* at 679.

¹⁴⁸ *Id* at 680 (explaining that the government did not create such a forum with the CFC in *Cornelius*).

¹⁴⁹ *Id* at 679.

¹⁵⁰ *Cornelius*, 473 US at 802.

¹⁵¹ See text accompanying notes 171–82.

¹⁵² *Perry Education*, 460 US at 49 n 9.

¹⁵³ See *Lee*, 505 US at 682 (reasoning that because an airport serves a primarily commercial purpose, it “cannot fairly be said that an airport terminal has as a principal purpose promoting ‘the free exchange of ideas’”), citing *Cornelius*, 473 US at 800. See also *Lehman*, 418 US at 303:

gages in commerce, it is entitled to make reasonable choices as to the sort of speech it entertains on its property.

1. The Principal Register—the government’s “policy” and “practice” in opening it up.

In assessing the government’s “policy and practice” in opening up and maintaining the forum, the Court considers whether the government has made its property “generally available” for “indiscriminate use by the general public,” or, to the contrary, only allows “selective access.”¹⁵⁴ The text of § 2(a) and the legislative history of the Lanham Act provide some insight into congressional intent in setting up the Act’s registration framework. One has to bear in mind the caveat that when it comes to the question of opening up a designated public forum, legislative history may be an indirect guide at best because the drafters almost certainly were not thinking in terms of “public fora” or “opening up the governmental property to expressive activity.”¹⁵⁵

The text of § 2(a) suggests that the registration system leans more towards inclusion rather than exclusion. The logical structure of the statutory language commands the PTO to register all trademarks unless they fall into certain enumerated categories: “No trademark . . . shall be refused registration on the principal register on account of its nature unless it (a) Consists of or comprises immoral, . . . scandalous, . . . or [disparaging] matter.”¹⁵⁶ This language suggests that trademarks are presumptively registrable unless they fall under one of the specified prohibitions.

The legislative history of the Act invites construction in the same vein. The statements of the drafters reveal that “[t]he purpose of this bill is to *simplify and make registration more liberal*, to dispense with mere technical prohibitions and arbitrary provisions, to make procedure simple and inexpensive, and relief against infringement prompt

In much the same way that a newspaper or periodical, or even a radio or television station, need not accept every proffer of advertising from the general public, a city transit system has discretion to develop and make reasonable choices concerning the type of advertising that may be displayed in its vehicles.

¹⁵⁴ *Forbes*, 523 US at 678–79; *Perry Education*, 460 US at 47.

¹⁵⁵ The drafters would not have had reason to consider the constitutional implications of § 2(a) when enacting it in 1946. “Public forum” as a term of art was first employed by the Court in 1972. See *Mosley*, 408 US at 95–96 (introducing the concept by reference to First Amendment and equal protection concerns about government discrimination against speech based on its content).

¹⁵⁶ 15 USC § 1052.

and effective.”¹⁵⁷ This stated objective of simplifying and liberalizing the registration process evinces government intent to allow for a broader access to the Principal Register.

The practice of TTAB and the courts has also reflected the inclusive posture of the Act. In *In re Old Glory Condom Corp.*,¹⁵⁸ TTAB noted that “the registration scheme of the Trademark Act is one more inclined to inclusion than exclusion.”¹⁵⁹ The same understanding may be gleaned from the TTAB and judicial practice of resolving doubts in favor of the applicant.¹⁶⁰

These indications in favor of the inclusiveness of the Principal Register cannot be conclusive, however. In considering the “policy and practice” of the enforcement of § 2(a), one should not overlook the fact that § 2 *in its totality* does not provide a forum “for indiscriminate use.” Section 2 is not limited to the prohibitions of its subsection (a) but rather contains numerous exclusionary criteria, which if present disqualify a mark from registration.¹⁶¹ Thus, although the registration system may be inclined towards inclusion, that stance itself does not eliminate the selective nature of the registration mechanism, much less transform the Register into one available for “general access.” The question is then what truly constitutes “general access” by the public at large or by a specific group as opposed to a system of selective inclusion.

a) General access versus selective access. The distinction between “general access” and “selective access” has been critical in a number of public forum cases. The Court has described the selective/general access distinction in the following terms:

A designated forum is not created when the government allows selective access for individual speakers rather than general access for a class of speakers.

. . .

On the one hand, the government creates a designated public forum when it makes its property generally available to a certain

¹⁵⁷ Bill Providing for the Registration of Trade-marks Used in Commerce, to Carry Out the Provisions of Certain International Conventions, and for Other Purposes, HR Rep No 76-944, 76th Cong, 1st Sess 2 (1939) (Fritz Lanham) (emphasis added).

¹⁵⁸ 26 USPQ2d 1216 (TTAB 1993).

¹⁵⁹ *Id* at 1219 n 3.

¹⁶⁰ See, for example, *In re In over Our Heads Inc.*, 16 USPQ2d 1653, 1654 n 1 (TTAB 1990) (“Because the guidelines are somewhat vague and because the determination is so highly subjective, we are inclined to resolve doubts on the issue of whether a mark is scandalous or disparaging in favor of applicant.”).

¹⁶¹ See 15 USC § 1052 (a)–(f). See also notes 69–71.

class of speakers, as the university made its facilities generally available to student groups in *Widmar*. On the other hand, the government does not create a designated public forum when it does no more than reserve eligibility for access to the forum to a particular class of speakers, whose members must then, as individuals, obtain permission to use it.¹⁶²

In *Widmar v Vincent*,¹⁶³ a public university was found to have created a limited public forum for registered student organizations by implementing a policy that made its meeting facilities “generally open” to such organizations.¹⁶⁴ On the other hand, in *Perry Education*, which involved claims of access to a school district’s internal mail system by rival teacher organizations, the Court held that the internal mail system was not a limited public forum because the school district had not “opened its mail system for indiscriminate use by the general public” or for “entities of similar character” to those that were admitted. Instead, it had reserved the mail system exclusively for a select teachers’ union.¹⁶⁵ The Court explained these holdings in *Cornelius*: “In contrast to the general access policy in *Widmar*, school board policy did not grant general access to the school mail system. The practice was to require permission from the individual school principal before access to the system to communicate with teachers was granted.”¹⁶⁶ In *Cornelius* itself, the Court held the CFC charity drive was not a designated forum because “the Government’s consistent policy has been to limit participation in the CFC to ‘appropriate’ [nonpolitical] voluntary agencies and to require agencies seeking admission to obtain permission from federal and local Campaign officials.”¹⁶⁷

Like the situations in *Perry Education* and *Cornelius*, and unlike the blanket permission policy adopted in *Widmar*, a trademark owner can obtain registration only if she satisfies the criteria of § 2 in the judgment of the PTO.¹⁶⁸ Even assuming that trademark owners are “a particular class of speakers” — rather than “individual speakers” — that have exclusive access to the Register,¹⁶⁹ the individual members of that class must obtain permission from the PTO in an individual fashion.

¹⁶² *Forbes*, 523 US at 679.

¹⁶³ 454 US 263 (1981).

¹⁶⁴ *Id.* at 267.

¹⁶⁵ See *Perry Education*, 460 US at 47–48.

¹⁶⁶ *Cornelius*, 473 US at 803.

¹⁶⁷ *Id.* at 804.

¹⁶⁸ See 15 USC § 1052. See also note 23.

¹⁶⁹ Trademark owners may be viewed to have exclusive access to the Register because one cannot obtain registration without a trademark.

The PTO acceptance is not ministerial because it involves a substantive judgment by the examining attorney about the registrability of the mark in light of the registration criteria of the Act.¹⁷⁰ This eligibility determination system is more in line with “selective access” than a “general access” scheme promoting “indiscriminate use.” In the absence of other evidence of “purposeful” opening up of a forum, the policy and the enforcement practice of the Act showcases the selective access attributes of a nonpublic forum.

b) *The forum and its compatibility with expressive activity.*

i) *Selectivity.* In addition to the question of selectivity of access, the Principal Register’s “nature and compatibility with expressive activity” are significant factors in determining its public forum status.¹⁷¹ The Court has stated that “the government does not create a public forum by . . . permitting limited discourse”¹⁷² or by “reserv[ing its property] for other intended purposes, communicative or otherwise.”¹⁷³ The government, “no less than a private owner of property, has power to preserve the property under its control for the use to which it is lawfully dedicated.”¹⁷⁴ In *Greer v Spock*,¹⁷⁵ a case involving claims of the right of access to a military base by political candidates, the Court found that the government did not open up a limited public forum when broad public access to its property would interfere with the mission of the institution.¹⁷⁶ Unlike *Greer*, the nature of the Principal Register is not in itself “inconsistent with expressive activity.”¹⁷⁷ The speech element of trademarks fits the design of the Register well, and there are no disciplinary, security, or similar considerations that render expressive activity on it problematic.

At the same time, however, the Principal Register is not like the university facilities in *Widmar*, the primary purpose of which was to foster exchange of ideas through “the intellectual give and take of campus debate.”¹⁷⁸ The Principal Register is hardly a forum for debate about the relative merits of ideas, even though the expressive aspect

¹⁷⁰ See 15 USC § 1052. See also note 23.

¹⁷¹ *Lehman*, 418 US at 302–03.

¹⁷² *Cornelius*, 473 US at 802.

¹⁷³ *Hazelwood School District v Kuhlmeier*, 484 US 260, 267 (1988).

¹⁷⁴ *Greer*, 424 US at 836, quoting *Adderley*, 385 US at 47.

¹⁷⁵ 424 US 828 (1976).

¹⁷⁶ See *id.* at 837–40 (“[T]he business of a military installation . . . [is] to train soldiers, not to provide a public forum.”). See also *Adderley*, 385 US at 39, 47 (holding that the sheriff could lawfully ban demonstrators from jail grounds because the area in question was “reserved for jail uses”).

¹⁷⁷ *Cornelius*, 473 US at 803.

¹⁷⁸ *Widmar*, 454 US at 267–68 n 5, quoting *Healy v James*, 408 US 169, 180 (1972).

of trademarks is an integral component of the material selected or excluded.¹⁷⁹ The stated objective of the Lanham Act is “the protection of trade-marks, securing to the owner the goodwill of his business and protecting the public against spurious and falsely marked goods.”¹⁸⁰ The legislative purpose of the Act was therefore not to open the Register up for an “intellectual give and take,”¹⁸¹ but to “reserve the forum for its intended purposes”¹⁸² of promoting the goals of trademark law.

ii) *Commercial enterprise.* When the government uses its property as a “commercial enterprise,” the forum is likely to be characterized as nonpublic. The Court has emphasized that the fact that the government was engaged in a “commercial enterprise” was indicative of the government’s intent not to open up its property to “the free exchange of ideas.”¹⁸³ In assessing whether an airport terminal was a designated forum or a nonpublic forum, the Court observed in *Lee* that “[a]s commercial enterprises, airports must provide services attractive to the marketplace. In light of this, it cannot fairly be said that an airport terminal has as a principal purpose promoting ‘the free exchange of ideas.’”¹⁸⁴ Similarly, in *Lehman*, the fact that the city used the space on the city transit system as a commercial venture was determinative of its status as a nonpublic forum. The Court found that the city must retain “discretion to develop and make reasonable choices concerning the type of advertising that may be displayed in its vehicles.”¹⁸⁵

Unlike the fora in *Lee* and *Lehman*, the Principal Register cannot be described as a “commercial enterprise.” The PTO does charge fees for application for registration,¹⁸⁶ but such a fee-collection regime can hardly be viewed as a “commercial enterprise.” It is, rather, a logistical device to defray the costs of the administration of the registration process. If one were to consider all fee collection to be commercial ventures, the inevitable absurdity of this logic would be that collection of fees for issuance of US passports¹⁸⁷ and Freedom of Information Act

¹⁷⁹ See text accompanying notes 64–68.

¹⁸⁰ HR Rep No 76-944 at 2 (cited in note 157).

¹⁸¹ *Widmar*, 454 US at 267–68 n 5.

¹⁸² *Perry Education*, 460 US at 46.

¹⁸³ See *Lee*, 505 US at 682, quoting *Cornelius*, 473 US at 800; *Lehman*, 418 US at 303.

¹⁸⁴ 505 US at 682, quoting *Cornelius*, 473 US at 800.

¹⁸⁵ *Lehman*, 418 US at 303.

¹⁸⁶ See 15 USC § 1051.

¹⁸⁷ See Department of State, Bureau of Consular Affairs, *Passport Fees* (Feb 1, 2008), online at http://travel.state.gov/passport/get/fees/fees_837.html (visited June 8, 2008).

(FOIA) requests¹⁸⁸ would transform the Departments of State and Justice respectively into “commercial enterprises.” A more reasonable interpretation of the *Lee-Lehman* “commercial enterprise” factor is that the very nature of government activity must be commercial. Both the advertising and airport operations had a distinct profit-making character. That is not the case here. The trademark registration system is not a commercial enterprise designed to turn profits. Rather, its purpose is centered on protecting consumers and trademark owners. The “commercial enterprise” factor, therefore, is absent from the Lanham Act framework.

iii) The Principal Register is a nonpublic forum. The preceding analysis demonstrates that the Principal Register is a nonpublic forum. At first glance, the language, the legislative history, and the interpretative practice of the Lanham Act by the courts seem to indicate that the Principal Register was open for general access as a limited forum. Yet a closer examination of the purpose of the Register and the selectivity of the registration mechanism counsels strongly in favor of the nonpublic forum status of the Register. The Court has made it clear that “selective access, unsupported by evidence of a purposeful designation for public use, does not create a public forum.”¹⁸⁹ Because such evidence is substantially lacking here, the Principal Register must be a nonpublic forum.

Interestingly, this does not automatically determine the proper standard of scrutiny applied to § 2(a). The case of the Principal Register is unique in that it concerns *commercial speech* in a nonpublic forum. The Court’s public forum jurisprudence thus far has concerned core political speech. Therefore, to answer the question presented here, one needs to understand what the operative test is when it is commercial speech that is being regulated on government property.

IV. COMMERCIAL SPEECH IN A PUBLIC FORUM

The First Amendment canon has not explicitly addressed the question of the proper test for reviewing restrictions on commercial speech in the context of the public forum doctrine. Nearly all of the Court’s public forum cases involved political or religious speech entitled to the highest level of protection. What happens when it is commercial speech—ordinarily protected by an intermediate level of

¹⁸⁸ See Department of Justice, *Freedom of Information Act Fees and Fee Waivers*, online at http://www.usdoj.gov/oip/04_1_2.html (visited June 8, 2008).

¹⁸⁹ *Cornelius*, 473 US at 805.

scrutiny—that is being suppressed on government property? The Court has not given a definitive answer.

A. When Commercial Speech and Public Forum Doctrines Intersect

Commercial speech is entitled to First Amendment protection, albeit of limited measure.¹⁹⁰ Regulations of commercial speech are subject to an intermediate level of scrutiny and are permissible only if they satisfy the four-part test laid down in *Central Hudson Gas & Electric Corp v Public Service Commission of New York*.¹⁹¹ First, in order for commercial speech to come within the orbit of the First Amendment, it must concern lawful activity and not be misleading. Second, the regulation must be designed to pursue a substantial government interest. If the answers to the first two questions are positive, then the regulation in question will survive scrutiny if it directly and significantly advances the government interest¹⁹² and if it is no more extensive than necessary to serve that interest.¹⁹³ On the other hand, as discussed above, traditional and designated fora are subject to strict scrutiny, while regulations in a nonpublic forum must be reasonable and viewpoint-neutral.¹⁹⁴

It is plain then that the commercial speech standard is distinct from the public forum test. *Central Hudson*—with its requirement that the government interest in restraining speech be substantial and that the restraint be no more extensive than necessary—offers a less demanding test of the government’s action than the traditional and designated public forum’s requirements of a compelling government interest and narrow tailoring of the regulation.¹⁹⁵ On the other hand, the commercial speech standard is more protective of speech than the nonpublic forum test, which only requires that the regulation be reasonable and viewpoint neutral.¹⁹⁶ The question of which standard to apply may therefore be crucial to the ultimate outcome. As the discus-

¹⁹⁰ See *Virginia Pharmacy Board v Virginia Citizens Consumer Council*, 425 US 748, 772 (1976) (“Although commercial speech enjoys First Amendment protection, . . . a different degree of protection is necessary to insure that the flow of truthful and legitimate commercial information is unimpaired.”).

¹⁹¹ 447 US 557, 564–66 (1980).

¹⁹² See *id.* at 564. See also *44 Liquormart, Inc v Rhode Island*, 517 US 484, 505 (1996) (strengthening the *Central Hudson* test by requiring a state to show that a restriction advances the state interest significantly).

¹⁹³ See *Central Hudson*, 447 US at 565.

¹⁹⁴ See Part III.A.

¹⁹⁵ See *id.*

¹⁹⁶ *Id.*

sion will show, in the case of a nonpublic forum, the forum test of reasonableness and viewpoint-neutrality should control.

Virtually all public forum cases the Court has decided have involved political speech. The exceptions are *City of Cincinnati v Discovery Network, Inc.*¹⁹⁷ and *Board of Trustees of SUNY v Fox*,¹⁹⁸ but both cases failed to provide any guidance as to the right standard of review of a regulation of commercial speech on government property. *Discovery Network* involved a city ban on the distribution of commercial handbills from news racks on public property. The publications in question were commercial speech, and the news racks were located on city streets, a traditional public forum. Mysteriously, however, the Court did not even mention the public forum doctrine and proceeded to apply the commercial speech standard.¹⁹⁹

In *Fox*, the Court had an opportunity to resolve the question but explicitly declined to address it.²⁰⁰ *Fox* involved a resolution by a public university to prohibit private commercial enterprises from operating on its premises. The district court had applied the public forum analysis and determined that the school dormitories did not constitute a public forum. The court of appeals had applied the *Central Hudson* test.²⁰¹ The Court declined to address the underlying question of which standard should apply and instead reversed the court of appeals on the grounds that it misconceived the meaning of *Central Hudson*.²⁰²

One might infer from this that in cases of commercial speech in a public forum, the commercial standard controls. While that stance in *Fox* and *Discovery Network* might be correct, to understand what the

¹⁹⁷ 507 US 410 (1993).

¹⁹⁸ 492 US 469 (1989).

¹⁹⁹ See id at 416.

²⁰⁰ See 493 US at 473 n 2.

²⁰¹ See id at 472–73.

²⁰² See id at 477 (holding that the fourth prong of the *Central Hudson* test need not meet the least-restrictive-means standard as suggested by the court of appeals). Lower courts have not added much clarity either. Consider generally *Sciarrino v City of Key West*, 83 F3d 364, 366–67 (11th Cir 1996) (applying the commercial speech standard to the city ordinance banning advertising canvassing in public locations without mentioning of the public forum doctrine); *Lueth v St. Clair County Community College*, 732 F Supp 1410, 1414–15 n 3 (ED Mich 1990) (finding that the student newspaper was a public forum but holding, without any reference to authority, that the public forum test “applies only to noncommercial speech”). For a discussion of the problem, see generally Andi Chang, *The Ninth Circuit’s Exotic Dance with the Commercial Speech Doctrine*, 1 Nev L J 226 (2001) (proposing that courts apply the standard of commercial speech); Irena S. Ayers, *What Rudy Hasn’t Taken Credit for: First Amendment Limits on Regulation of Advertising on Government Property*, 42 Ariz L Rev 607 (2000) (identifying the confusion of the courts in applying the public forum doctrine to commercial speech regulations).

correct rule should be in all cases, the respective objectives of the public forum and commercial speech doctrines should be considered.

The Court has justified the lower level of protection for commercial speech because of its “objectivity” and greater “hardiness.”²⁰³ According to the Court, commercial speech is more objective because its truth is “more easily verifiable” than that of political commentary or news reporting.²⁰⁴ Commercial speech is also more durable because, advertising being “the *sine qua non* of commercial profits, there is little likelihood of its being chilled by proper regulation and foregone entirely.”²⁰⁵ Furthermore, there are “commonsense differences” between commercial and political speech suggesting that the former is of lower value to the First Amendment.²⁰⁶

If such is the case, then indeed there is no reason to ratchet up scrutiny of “low” value commercial speech to the “compelling interest” test of traditional and designated fora merely because the speech happens to occur on government property. If content-based restrictions on core speech are subject to strict scrutiny both in a (traditional and designated) public forum and in the private sphere, then a similar principle of symmetry dictates that the incidence of commercial speech on public property should not change its low value status and the reduced level of protection accorded it for that reason.

Conversely, when commercial speech is in a nonpublic forum, the proper test should be the nonpublic forum requirements of reasonableness and viewpoint-neutrality. Given the premise of the nonpublic forum category—that as a proprietor, the government is afforded greater latitude in regulating access to its own property—the government’s proprietary control should not be diminished by virtue of the fact that “low value” speech seeks to enter it. If core political speech cannot so diminish government’s discretion, then certainly commercial speech cannot accomplish more.

One might argue that because political speech in a nonpublic forum is protected only with a standard of reasonableness and viewpoint-neutrality, the lower-value commercial speech should get even less protection. This may be true as a matter of logic; but because there has not been a case in the Court’s forum jurisprudence when the

²⁰³ See *Virginia Pharmacy*, 425 US at 771–72 n 24. For a criticism of the Court’s commercial speech distinction, see generally Alex Kozinski and Stuart Banner, *Who Is Afraid of Commercial Speech?*, 76 Va L Rev 627 (1990).

²⁰⁴ *Virginia Pharmacy*, 425 US at 771–72 n 24.

²⁰⁵ *Id.*

²⁰⁶ *Id.*

majority found a regulation in a nonpublic forum to be unreasonable, the reasonableness test already appears to lack much bite.²⁰⁷ In that light, anything less than the reasonableness test would effectively amount to no protection for commercial speech at all, something that the Court explicitly repudiated.²⁰⁸

The distinct objectives of the two doctrines suggest that even in a traditional forum, commercial speech does not raise the same concerns that animate the heightened scrutiny of restrictions on core speech in public fora. While the potential for government abuse of power by exclusion of unpopular opinions or groups from public fora justifies strict scrutiny, the Court's stated "objectivity" of commercial speech reduces the need for such a level of protection. Similarly, while the public forum doctrine is more concerned with ensuring that traditional avenues of communication are available to people who lack access to other, costlier alternatives,²⁰⁹ the "hardiness" of commercial speech is believed to guarantee its ability to survive restraints.

Consequently, in a traditional or designated public forum, government restrictions on commercial speech should be analyzed under the *Central Hudson* four-part framework. When, however, commercial speech is in a nonpublic forum, the nonpublic forum test of reasonableness and viewpoint-neutrality should control. Because the Principal Register is a nonpublic forum, the constitutionality of § 2(a) will thus depend on whether it is a reasonable and viewpoint-neutral restraint on speech.

B. A Task for the Courts

While exclusions from nonpublic fora are typically likely to be upheld, the validity of § 2(a) is far from certain. The Court has stated that "[t]he reasonableness of the Government's restriction of access to a nonpublic forum must be assessed in light of the purpose of the forum and all the surrounding circumstances."²¹⁰ It is fairly clear that the prohibition on registration of "scandalous," "immoral," and "disparaging" trademarks does not further the Lanham Act's objective of protecting the owner against infringement or the public against confusion. Courts and commentators have suggested a number of government interests that are served by § 2(a). The most commonly suggested ones

²⁰⁷ See *Lee*, 505 US at 690–92 (O'Connor concurring).

²⁰⁸ See *Virginia Pharmacy*, 425 US at 770.

²⁰⁹ See *Stone*, 25 Wm & Mary L Rev at 219 n 111 (cited in note 109).

²¹⁰ *Cornelius*, 473 US at 809. See also *Perry Education*, 460 US at 49.

are preventing “scandalous,” “immoral,” and “disparaging” marks from “1) carrying the imprimatur of the federal government, 2) receiving the support of public funds, 3) being the subject of exclusive ownership, 4) [] being encouraged through the trademark registration scheme, and 5) interfering with the public’s health and welfare.”²¹¹ Since these interests are not directly related to the purpose of the Principal Register, presumably they fall under the rubric of “all the surrounding circumstances” noted by the Court.²¹² Subsequent commentary has discussed these circumstances in detail and mostly rejected them as insufficient.²¹³

Even if § 2(a) satisfies the “reasonableness” prong of the nonpublic forum test, as discussed in Part II.B.4, the prohibition on registration of “disparaging” marks is most likely a viewpoint-based restriction. Viewpoint discrimination is presumptively unconstitutional in any forum.²¹⁴ At least in its “disparaging” prong, then, § 2(a) is likely unconstitutional.

CONCLUSION

As was stated from the outset, it is beyond the scope of this Comment to assess the validity of § 2(a). It set up a framework for properly analyzing the constitutionality of § 2(a)’s content-based ban. Should a challenge to § 2(a) be mounted again, it should be examined under the public forum doctrine. As a restriction on speech in a non-public forum, it should be held to a standard of reasonableness and viewpoint neutrality. There is considerable doubt that § 2(a) meets this

²¹¹ Baird, 83 Trademark Rep at 699 (cited in note 27). See also Cathryn L. Claussen, *Ethnic Names and Logos—Is There a Legal Solution?*, 6 Marq Sports L J 409, 412 (1996) (suggesting a government interest in preventing racial unrest); Davis, 54 Ohio St L J at 369–73 (cited in note 44) (noting that courts have upheld state interests in preventing obscenity, child pornography, fighting words, and defamation).

²¹² See *Cornelius*, 473 US at 809; *Lee*, 505 US at 687 (O’Connor concurring) (“Consideration of a forum’s special attributes is relevant to the constitutionality of a regulation since the significance of the governmental interest must be assessed in light of the characteristic nature and function of the particular forum involved.”). Commentators who have discussed these interests have done so not in the context of the public forum doctrine but within the framework of the “substantial interest” portion of the *Central Hudson* test. See generally Claussen, 6 Marq Sports L J 409 (cited in note 211); Davis, 54 Ohio St L J 331 (cited in note 44).

²¹³ See, for example, Gibbons, 9 Marq Intel Prop L Rev at 233–36 (cited in note 44) (arguing that all proffered justifications for § 2(a) “are merely attempts to cover militant prudery with a fig leaf of legitimacy in the commercial context” and that “even if credible,” they do not save § 2(a) from unconstitutionality); Pace, 22 Pepperdine L Rev 7 at 40–43 (cited in note 61) (dismissing the proposed government interests in avoiding the appearance of government approval, protecting the health and the welfare of the public, and preventing the expenditure of public funds on offensive marks as insufficient and unsubstantiated).

²¹⁴ See Part III.A.

test, but to determine that, it is important to start with a proper framework of analysis. The hope is that this and other commentary examining possible government interests in excluding scandalous and disparaging matter from the Principal Register will assist the courts in carrying out that task.