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### Cover Page Footnote

The author would like to thank Celine DeSantis and Iris Ryou for their research assistance, and Chicago-Kent Law School for hosting a valuable symposium about the Supreme Court and intellectual property.

## CHOOSING THE CONSEQUENCES OF TAM AND BRUNETTI

ALFRED C. YEN\*

In *Matal v. Tam*<sup>1</sup> and *Iancu v. Brunetti*,<sup>2</sup> the Supreme Court did something it has never done before – namely apply strict First Amendment scrutiny to trademark law. This is a big deal. Many have argued, to relatively little effect, that intellectual property laws, like trademarks, raise serious free speech problems.<sup>3</sup> It is therefore significant news for the Court to declare portions of the Lanham Act unconstitutional not once, but twice.

Like all Supreme Court decisions that break new ground, *Tam* and *Brunetti* raise questions about what comes next. In this Essay, I consider some of those possibilities and conclude that the consequences of *Tam* and *Brunetti* depend on whether future courts think the cases imply the rewriting of broad First Amendment doctrines or the opening of a new and subtle understanding about intellectual property and the First Amendment. Both of these options

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1. 137 S. Ct. 1744, 1751 (2017).

2. 139 S. Ct. 2294, 2299 (2019).

3. Examples include Lisa Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 S.M.U. L. Rev. 381 (2008) (advocating more robust application of First Amendment in trademark cases); Michael K. Cantwell, *Confusion, Dilution, and Speech: First Amendment Limitations on the Trademark Estate*, 87 Trademark L. Rep. 48 (1997) (arguing for greater First Amendment protection in trademark law); Jed Rubinfeld, *The Freedom of Imagination: Copyright's Constitutionality*, 112 Yale L. J. 1, 1 (2002) (characterizing copyright as "a kind of giant First Amendment duty-free zone" that flouts basic free speech principles); Joseph P. Bauer, *Copyright and the First Amendment: Comrades, Combatants, or Uneasy Allies*, 67 Wash. & Lee L. Rev. 831 (2010) (arguing that First Amendment interests have been denied in important copyright cases); Christina Bohannon, *Copyright Infringement and Harmless Speech*, 61 Hastings L. J. 1083 (2010) (arguing that existing copyright law conflicts with First Amendment principles by rejecting harm as a prerequisite to liability).

will require change to well-established features of existing First Amendment law.

I conduct this inquiry in two parts. First, I review some basic First Amendment doctrines, paying particular attention to the general application of strict scrutiny to the content-based regulation of speech. In so doing, I will draw particular attention to the Supreme Court's unwillingness to distinguish viewpoint-based regulation from content-based regulation for First Amendment purposes. Second, I analyze *Tam* and *Brunetti*, paying particular attention to their immediate doctrinal consequences. In particular, the cases raise the possibility that significant portions of the trademark and copyright law are unconstitutional. I argue that courts are highly unlikely to accept these consequences, and that courts will try to limit the extent to which *Tam* and *Brunetti* invalidate existing intellectual property law. Doing so will, however, almost certainly lead to significant change. I conclude with a few thoughts about the direction I would like to see the courts take.

## I. SOME FIRST AMENDMENT BASICS

Although the First Amendment states that Congress shall make “no law” abridging freedom of speech,<sup>4</sup> the Supreme Court has given laws affecting speech varying levels of constitutional scrutiny. In some cases, the Court has applied strict scrutiny, making government regulation of speech presumptively unconstitutional.<sup>5</sup> In others, the Court has imposed intermediate scrutiny, thereby exposing regulation of speech to significant, but not necessarily fatal, scrutiny.<sup>6</sup> Finally, in still other cases, the Court has used the rational basis test to give government an essentially free hand to legislate as it sees fit.<sup>7</sup> Three determinations play major roles in determining how courts review laws that affect speech interests.

4. See U.S. Const. Amend. I (“Congress shall make no law...abridging the freedom of speech”).

5. See *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2218 (2015); *Arkansas Writers Project v. Ragland*, 481 U.S. 221, 221 (1987).

6. See *Central Hudson Gas and Electric v. Public Service Commission*, 447 U.S. 557, 566 (1980); *Florida Bar v. Went For It, Inc.*, 515 U.S. 618, 624 (1995) (restriction against direct mail solicitation of potential personal injury clients does not violate First Amendment under *Central Hudson* intermediate scrutiny).

7. See *Tennessee Secondary School Athletic Ass'n v. Brentwood Academy*, 551 U.S. 291, 300 (2007) (State high school sports association rule prohibiting recruiting did not violate First Amendment because rule discouraged conduct).

First, courts ask whether the law in question regulates speech or conduct. Although the First Amendment's application to only "speech" might make such a determination seem obvious, things get complicated because people often engage in nonverbal conduct for expressive purposes. Parades, silent protests, the burning of flags, and other conduct often communicate very specific messages. That having been said, the Supreme Court has not extended First Amendment protection to conduct simply because communication may be involved. If the First Amendment protected all communicative conduct, government would effectively lose its ability to govern. For example, people burn draft cards to protest government policy, but protecting such conduct as speech would cripple operation of the draft.<sup>8</sup> Similarly, government regulation of labor markets might be impossible if the behavior of those involved in labor negotiations were treated as speech.<sup>9</sup> Accordingly, the Supreme Court recognizes that conduct does not ordinarily receive First Amendment protection.<sup>10</sup>

The second determination asks whether a law affecting speech is content-based or content-neutral. Content-based regulations affect speech by referring to its content. These regulations include laws criminalizing the depiction of animal cruelty;<sup>11</sup> establishing differential size restrictions for political, religious, directional and commercial street signs;<sup>12</sup> and imposing higher taxes on magazines focused on particular subject areas.<sup>13</sup> The Supreme Court has generally applied strict First Amendment scrutiny to content-based regulations because government can easily abuse them to censor speech.<sup>14</sup> For example, a government that wanted to suppress communication about sports might well tax publications about sports at a higher rate. By contrast, content-neutral laws affect speech without referring to its content. Examples of content-neutral laws include bans against the posting of

8. See *United States v. O'Brien*, 391 U.S. 367, 367 (1968) (criminal prohibition against burning a draft card does not violate the First Amendment).

9. See *Giboney v. Empire Storage and Ice. Co.*, 336 U.S. 490, 503 (1949) (injunction against labor picketing did not violate First Amendment because holding otherwise would destroy a state's power to govern labor law).

10. See *Sorrell v. IMS Health, Inc.*, 564 U.S. 552, 567 (2011) ("It is true that restrictions on protected expression are distinct from restrictions on economic activity or, more generally, on nonexpressive conduct.")

11. *U.S. v. Stevens*, 559 U.S. 460 (2010).

12. *Reed v. Town of Gilbert*, 135 S. Ct. 2218 (2015).

13. *Arkansas Writers' Project, Inc. v. Ragland*, 481 U.S. 221 (1987).

14. See *Reed*, 135 S. Ct. at 2228 ("[A] law that is content based on its face is subject to strict scrutiny regardless of the government's benign motive, content-neutral justification, or lack of 'animus toward the ideas contained' in the regulated speech").

signs on public property<sup>15</sup> and requiring performers in a park to use sound-amplification equipment and technicians provided by the city.<sup>16</sup> Laws like these may indeed affect speech, but they carry a relatively low risk of censorship because they do not single out particular content for suppression. For this reason, the Supreme Court has generally applied only intermediate scrutiny to content-neutral laws.<sup>17</sup>

For purposes of this Essay, it is helpful to note that content-based regulation of speech comes in two forms, ordinary content-based regulation and viewpoint-based regulation. Ordinary content-based regulation exists whenever law uses the content of speech as the basis for differential treatment. An ordinance prohibiting speeches about immigration law constitutes ordinary content-based regulation. By contrast, viewpoint-based regulation is a subset of content-based regulation that uses the speaker's point of view to determine whether regulation applies. Thus, an ordinance prohibiting speeches that criticize the federal government's immigration policy goes beyond looking at what the speaker talks about to examine the speaker's perspective on the subject.

When government deploys viewpoint-based regulation of speech, it necessarily promotes one set of ideas over others by identifying some viewpoints for favorable promotion over others. This strikes directly at the heart of the First Amendment and easily explains why the Supreme Court would declare such regulation presumptively unconstitutional. By contrast, ordinary content-based regulation threatens the First Amendment a bit less because favoring certain content over others does not necessarily imply favoring particular viewpoints. A law prohibiting speeches about immigration does not favor speeches favorable to government policy over speeches hostile to it.

This distinction between viewpoint-based and content-based regulation suggests that the First Amendment could treat these two forms of regulation differently. For example, First Amendment

15. See *Metromedia, Inc. v. City of San Diego*, 453 U.S. 490 (1981) (holding there to be a prohibition on the erection of outdoor advertising displays within the city does not violate First Amendment); *Members of City Council of City of Los Angeles v. Taxpayers for Vincent*, 466 U.S. 789, 807 (1984) (upholding prohibition against posting of signs on public property and characterizing statute in *Metromedia* as "content-neutral").

16. See *Ward v. Rock Against Racism*, 491 U.S. 781 (1989).

17. *Id.* (applying intermediate level scrutiny to content-neutral regulation); *Turner Broadcasting System, Inc. v. F.C.C.*, 512 U.S. 622, 642 (1994) (regulations unrelated to content of speech subject to intermediate scrutiny).

doctrine could declare viewpoint-based regulation presumptively unconstitutional while making it easier for content-based regulation to survive First Amendment review. Importantly, the Supreme Court has generally rejected this possibility. The Court has instead chosen to apply strict scrutiny to all forms of content-based regulation, whether ordinary or viewpoint-based.

The reason for this is simple and powerful. According to the Court, viewpoint-based discrimination may be a particularly odious form of content-based discrimination, but the censorship risks associated with ordinary content-based regulation are still too significant to accept. For example, in *Reed v. Town of Gilbert*,<sup>18</sup> the court struck down a local ordinance that regulated the placement and size of street signs by their subject matter. In so doing, the Court conceded that the city had not adopted the ordinance for censorial purposes. Nevertheless, the Court wrote, “Innocent motives do not eliminate the danger of censorship presented by a facially content-based statute, as future government officials may one day wield such statutes to suppress disfavored speech.”<sup>19</sup> Similarly, in *Arkansas Writers v. Ragland*,<sup>20</sup> the Court invalidated a law exempting certain types of magazines from sales tax. The Court again recognized that the law did not constitute viewpoint-based discrimination, but it quoted with approval language from an earlier case: “[t]he First Amendment’s hostility to content-based regulation extends not only to restrictions on particular viewpoints, but also to prohibition of public discussion of an entire topic.”<sup>21</sup>

Finally, the third determination separates content-based regulation of speech from content-based regulation of commercial speech. If the regulation applies to ordinary speech, then strict scrutiny follows. However, if the regulation applies to commercial speech, only intermediate scrutiny applies.<sup>22</sup> Courts separate these two forms of speech in order to preserve the effective regulation of commerce. One might think of commerce as a form of conduct, but commerce inevitably involves speech because those selling goods and services must advertise, propose prices, and describe what they sell.

18. *Reed*, 135 S. Ct. at 2231 (2015).

19. *Id.* at 2229.

20. *Arkansas Writers Project v. Ragland*, 481 U.S. 221, 234 (1987).

21. *Id.* at 230.

22. See *Central Hudson Gas and Electric v. Public Service Commission*, 447 U.S. 557, 566 (1980); *Florida Bar v. Went For It, Inc.*, 515 U.S. 618, 624-25 (1995) (commercial speech reviewed under *Central Hudson* intermediate scrutiny).

Government may wish to prevent consumer deception by requiring disclosure of information sellers might prefer to keep hidden, but such regulation involves forcing an advertiser to speak against her will. Strict First Amendment scrutiny of such commercial regulation would render such a law presumptively unconstitutional, making effective commercial regulation extremely difficult. The use of intermediate scrutiny instead gives government room to pass effective commercial regulation while also forcing government to have strong justification for its behavior.<sup>23</sup>

## II. TAM AND BRUNETTI

Before *Tam* and *Brunetti*, courts did not apply elevated forms of First Amendment scrutiny to trademark and copyright statutes.<sup>24</sup> This outcome matches a judicial understanding that intellectual property statutes regulate commercial conduct, not speech. *Tam* and *Brunetti* disrupt this understanding of the law.

In *Tam*, the plaintiff Simon Tam sued over the government's refusal to register the mark "Slants" for Tam's rock band. The government did so because "slants" is also a derogatory term for persons of Asian descent,<sup>25</sup> and Section 2(a) of the Lanham Act denied registration to marks that "may disparage . . . persons, living or dead, institutions, beliefs, or national symbols or bring them into contempt, or disrepute."<sup>26</sup> Tam protested to no avail that he wanted to give the term a positive meaning by using it for his band, whose members were of Asian descent.<sup>27</sup>

The Supreme Court ruled in Tam's favor. In doing so, the Court noted that Section 2(a) of the Lanham Act violated a "bedrock" First Amendment principle against banning speech because it offends.<sup>28</sup>

23. See *Zauderer v. Office of Disciplinary Counsel of Supreme Court of Ohio*, 471 U.S. 626, 651 (1985) ("[W]e hold that an advertiser's rights are adequately protected as long as disclosure requirements are reasonably related to the State's interest in preventing deception of consumer.").

24. See Lisa Ramsey, *Free Speech Challenges to Trademark After Matal v. Tam*, 56 Houston L. Rev. 401, 411-12 (2018) (courts avoided First Amendment scrutiny of trademark prior to *Tam*); Jed Rubinfeld, *supra* note 3 (noting that copyright is never reviewed seriously under the First Amendment).

25. *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017).

26. 15 U.S.C. §1052(a).

27. *Tam*, 137 S.Ct. at 1751, 1754 (Tam "chose this moniker in order to 'reclaim' and 'take ownership' of stereotypes about people of Asian ethnicity").

28. *Id.* at 1751.



Section 2(a) therefore deprived Tam of registration's benefits on the basis of viewpoint, making the provision unconstitutional.

*Tam* is somewhat confusing because the justices produced three separate opinions about the proper level of scrutiny to apply, with none commanding a majority.<sup>29</sup> Fortunately, the Court soon spoke again about the proper level of scrutiny in *Brunetti*. In that case, the plaintiff attempted to register the mark "FUCT" for a line of clothing. The PTO refused registration, relying on portions of Section 2(a) that denied registration to scandalous or immoral marks. The plaintiff sued, arguing that the First Amendment rendered these parts of Section 2(a) unconstitutional. Not surprisingly, the Court again invalidated the provision under attack, citing *Tam* as support. More importantly, six justices agreed that the viewpoint discrimination embodied in Section 2(a) of the Lanham Act was presumptively unconstitutional and therefore deserving of strict scrutiny.<sup>30</sup>

*Tam* and *Brunetti's* application of strict scrutiny invokes the branch of First Amendment jurisprudence that generally prohibits government from enacting content-based regulations of speech. This invocation has striking implications for trademark and copyright law because the relevant statutes are riddled with content-based discrimination.

For example, the very granting of trademark protection depends on whether the claimant's speech (i.e. the mark) is generic, descriptive, suggestive, fanciful, or arbitrary.<sup>31</sup> Those who would otherwise own valid trademarks lose the right to use them if the marks "tarnish" other famous marks.<sup>32</sup> Similarly, copyright protection depends on whether the work in question is "original."<sup>33</sup> The Copyright Act also grants different rights to various forms of expression. For example, musical compositions get full protection from unauthorized public performance, while musical recordings get such protection only when the unauthorized performance is digital.<sup>34</sup>

29. *Matal v. Tam*, 137 S. Ct. 1744 (2017).

30. *Iancu v. Brunetti*, 139 S. Ct. 2294, 2299 (2019).

31. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-11 (2d Cir. 1976) (identifying categories of marks and their consequences for protection).

32. See 15 U.S.C. §1125(c) (providing relief for dilution by tarnishment).

33. See 17 U.S.C. 102(a) (extending protection to "original" works).

34. See Copyright Act of 1976, 17 U.S.C. §106(4) (2012) (extending general public performance rights to most types of copyrighted works); 17 U.S.C. §106(6) (extending public performance rights to sound recordings only when the work is performed by digital audio transmission).

If *Brunetti* and *Tam* stand for the proposition that strict scrutiny applies to content-based provisions of copyright and trademark law, dramatic change could follow. Each of the provisions mentioned above, plus many others, would become presumptively unconstitutional. Chaos would soon follow as basic provisions of intellectual property governing commerce would simply disappear. Claimants and users of creative works and trademarks would not know whether their works were still protected, or whether protection had simply evaporated.

Personally, I do not believe that the Supreme Court intended for *Tam* and *Brunetti* to lead to such results, nor do I think that courts would allow this to happen. However, avoiding this result will require disavowing either case law applying strict scrutiny to virtually all forms of content-based regulation or case law that rejects serious First Amendment review of intellectual property law.

To see this, consider that the most obvious way to avoid chaos would be the limitation of *Tam* and *Brunetti* to their facts – namely cases of viewpoint-based discrimination in trademark law. This strategy would allow the review of “ordinary” content-based regulation under more lenient intermediate or rational basis scrutiny, making it much easier to avoid mass invalidation of basic trademark and copyright law. This strategy is of course entirely plausible, and perhaps even sensible. However, using it would require turning away from well-established case law that refuses to distinguish between viewpoint-based and content-based regulation of speech.

This refusal exists for good reason. Viewpoint-based discrimination is the most obvious and objectionable form of content-based discrimination. Laws subsidizing speeches favorable to the mayor or those punishing speeches criticizing government policy constitute naked and obvious attempts to control the ideas people consider, but they are not the only laws that raise this risk. Government could also suppress free thought by regulating speech on the basis of its subject matter or mode of expression. That is why oppressive regimes ban the publication of books about particular topics and outlaw music and dancing.

The risks associated with content-based regulation have led the Supreme Court to declare it presumptively unconstitutional, even when the law in question was not passed for the purpose of favoring

some viewpoints over others. For example, in *Reed v. Town of Gilbert*,<sup>35</sup> the Court invalidated a local ordinance requiring permits for the posting of outdoor signs. The ordinance also exempted 23 categories of signs from this requirement. Of these signs, “ideological signs” received the most favorable treatment, with “political signs” receiving somewhat less favorable treatment, and other signs getting even less favorable treatment.<sup>36</sup>

The Court struck down this ordinance by applying strict scrutiny. In so doing, the Court specifically rejected the notion that the town’s benign motives could obviate the need for strict scrutiny. The Court wrote, “Innocent motives do not eliminate the danger of censorship presented by a facially content-based statute, as future government officials may one day wield such statutes to suppress disfavored speech.”<sup>37</sup> This meant that “[A] law that is content based on its face is subject to strict scrutiny regardless of the government’s benign motive, content-neutral justification, or lack of ‘animus toward the ideas contained’ in the regulated speech.”<sup>38</sup>

Cases like *Reed*<sup>39</sup> problematize the strategy of limiting *Tam* and *Brunetti* to viewpoint-based regulation in intellectual property. If the First Amendment treats viewpoint-based regulation differently from ordinary content-based regulation in trademark, one might well infer that same practice should follow elsewhere. However, the Supreme Court has already explained why such a distinction would be wrong outside of intellectual property. Thus, if the courts decide to limit *Tam* and *Brunetti* by distinguishing viewpoint-based from content-based regulation in trademark, they might also have to undertake the extremely controversial project of rewriting significant portions of existing First Amendment law.

If courts prove unwilling to do this, a second possibility for limiting *Tam* and *Brunetti* emerges. This would involve explaining exactly how intellectual property interacts with the First Amendment

35. *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2218 (2015).

36. *Id.* at 2224.

37. *Id.* at 2229.

38. *Id.* at 2228.

39. Other cases taking the same position include *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410 (1993) (city prohibition against distribution of “commercial handbills” on public property is content-based regulation regardless of city’s motive); *Simon & Shuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 117 (1991) (no evidence of “improper censorial motive” needed to establish content-based regulation and strict scrutiny); *Minneapolis Star & Tribune Co. v. Minnesota Comm’r of Revenue*, 460 U.S. 575, 592 (1983) (“illicit legislative intent” not required for violation of the First Amendment).

for the purpose of determining when content-based regulation in intellectual property is constitutional. This too is uncharted territory. As noted earlier, courts have consistently refused to apply anything more than the rational basis test to copyright and trademark law. This does not mean, however, that thinking more deeply about the relationship of intellectual property to the First Amendment is doomed to failure. For example, defamation cases were once generally free of First Amendment scrutiny until *New York Times v. Sullivan*.<sup>40</sup> Since that case, however, the Supreme Court has developed a fairly elaborate set of constitutional rules within which libel law must operate.<sup>41</sup> Doing likewise for trademark and copyright would surely be challenging, but it might also result in a constructive judicial response to the criticism that courts do not take the free speech implications of intellectual property seriously enough.

### III. CONCLUSION

In this Essay, I have sketched out two ways in which *Tam* and *Brunetti* could have major impact on intellectual property and First Amendment law. One involves a concerted effort to distinguish viewpoint-based discrimination from ordinary content-based discrimination for the purpose of applying more lenient scrutiny to content-based discrimination. The other contemplates new explanations about how intellectual property relates to the First Amendment. Obviously, *Tam* and *Brunetti* do not tell courts which of these possibilities to pursue, or whether another option not discussed here makes even more sense. However, I hope that courts decide to think more deeply about the relationship between intellectual property and the First Amendment. Two reasons support this hope.

First, I think that applying lower levels of scrutiny to ordinary content-based regulation would be a mistake. If strict scrutiny no longer applies to those types of laws, governments will deploy content-based regulation and then concoct reasons to justify laws of questionable constitutionality. The Supreme Court has spoken clearly many times about how content-based laws raise unacceptable risks of censorship. Making it easier for content-based laws to survive

40. 376 U.S. 254 (1964).

41. See *Gertz v. Robert Welch, Inc.*, 418 U.S. 323 (1974) (requiring differing levels of proof about recklessness and fault as a prerequisite to recovery in libel); *Dun & Bradstreet, Inc. v. Greenmoss Builders, Inc.*, 472 U.S. 749 (1985) (allowing strict liability for libelous statements of purely private concern).

constitutional scrutiny raises the chances for oppressive government behavior with little chance of positive social return.

Second, I agree that courts have not paid enough attention to tensions between intellectual property and the First Amendment. Accordingly, new opinions that do more than simply declare intellectual property laws constitutional would be most welcome. I suspect that serious application of *Tam* and *Brunetti* to trademark and copyright will reveal many constitutionally suspect distinctions in the law of intellectual property. Grappling with those distinctions, removing some of them, and improving the effect that intellectual property has on our society would be very constructive, and a fitting choice for the consequences of *Tam* and *Brunetti*.