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IN RE TAM: TREATING TRADEMARKS AS EXPRESSIVE SPEECH

Simon Shiao Tam first sought to register the name of his band, The Slants, as a trademark in 2011.¹ At the time, Mr. Tam was seeking to use his band's name to reclaim negative Asian stereotypes.² However, the trademark examiner found that even though Mr. Tam was seeking to reappropriate the term, a substantial composite of people of Asian descent would find the stereotype offensive.³ So, the examiner refused to register the mark under the disparagement provision of section 2(a) of the Lanham Act.⁴ Mr. Tam appealed the examiner's decision to the Trademark Trial and Appeal Board (TTAB), which upheld the examiner's refusal to register the mark.⁵ Mr. Tam again appealed to the Federal Circuit, which initially upheld the examiner's decision and held that precedent foreclosed Tam's argument that section 2(a) is unconstitutional.⁶ After that decision, the Federal Circuit sua sponte ordered a rehearing en banc on the question of the constitutionality of section 2(a).⁷

The disparagement provision of section 2(a) specifies that a trademark may not be registered on the principal register if it "consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute."⁸ Until *Tam*, the Federal Circuit relied on *In re McGinley* to assert the constitutionality of section 2(a).⁹ The court in *McGinley* held that because a refusal to register a trademark does not mean that the trademark cannot be used, section 2(a) does not violate the First Amendment.¹⁰ Courts and the TTAB, supported by the decision in *McGinley* upholding the section's constitutionality, have rejected a variety of trademarks under section 2(a)'s disparagement provision, including: "Redskins"; "Stop the Islamisation of America"; "The Christian Prostitute"; and "Mormon Whiskey."¹¹

The majority in this case held that it would be unconstitutional for the government to refuse to register trademarks under the disparagement

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1. *In re Tam*, 2015 U.S.App. LEXIS 22593, *14 (Fed. Cir. 2015).
 2. *Id.* at *13
 3. *Id.* at *14
 4. *Id.*
 5. *Id.*
 6. *Id.* at *16 - *18.
 7. *Id.* at *21.
 8. 15 U.S.C.A. §1052(a) (West 2006).
 9. *Tam*, 2015 U.S.App. LEXIS 22593 at *18.
 10. *In re McGinley*, 660 F.2d 481, 484 (Fed. Cir. 1981).
 11. *Tam*, 2015 U.S.App. LEXIS 22593 at *10.

provision of section 2(a) of the Lanham Act.¹² The Court used strict scrutiny to evaluate section 2(a) because it viewed section 2(a) as a governmental regulation burdening private speech based on disapproval of the message conveyed.¹³ The Court rejected the government's argument that strict scrutiny should not apply because the speech regulated is commercial speech by noting that it is the expressive aspects of the trademarks that are regulated under 2(a), not the trademarks' ability to act as source identifiers.¹⁴ The majority also dismissed the argument that the restrictions of section 2(a) are viewpoint neutral, citing examples of the same word being allowed in some trademarks while other trademarks using the same word were barred from registration by section 2(a).¹⁵ Additionally, the Court emphasized that it does not matter whether the speech is actually banned by noting that section 2(a) burdens speech by denying trademark holders the significant benefits of a federal registration.¹⁶ After concluding that section 2(a) should be subject to strict scrutiny, the Court analyzed the provision under intermediate scrutiny to show that section 2(a) would still be unconstitutional if it were regulating commercial speech.¹⁷ Ultimately, the Court found that the government's only interest was in burdening speech that the government finds offensive.¹⁸ Consequentially, the Court held that the government had no legitimate interest to justify section 2(a), meaning that the provision is unconstitutional under the First Amendment.¹⁹

The concurring opinion, written by Judge O'Malley, argued that section 2(a) is also unconstitutionally vague.²⁰ The concurring opinion also drove home the point that section 2(a) is often applied inconsistently, making it difficult for a trademark holder to know whether the provision will be used against a certain trademark.²¹ The dissenting opinion, written by Judge Dyk also argued that section 2(a) is unconstitutional in Mr. Tam's case.²² However, the dissent argued that the majority should not have held that the statute is facially unconstitutional as applied to commercial speech.²³ Two dissenting opinions, written by Judge Lourie and Judge Reyna, argued that section 2(a) is constitutional and that the TTAB decision should be upheld.²⁴ Judge Lourie argued that stare decisis should be respected and the fact that section 2(a) is constitutional is

12. *Id.* at *5.

13. *Id.* at *21.

14. *Id.* at *30.

15. *Id.* at *27.

16. *Id.* at *37.

17. *Id.* at *79.

18. *Id.* at *85.

19. *Id.*

20. *Id.* at *86 (O'Malley, J. Concurring).

21. *Id.* at *88 - *89.

22. *Id.* at *100 (Dyk, J. Dissenting).

23. *Id.*

24. *Id.* at *132 (Reyna, J. Dissenting); *Id.* at *127 (Lourie, J. Dissenting).

settled law.²⁵ Judge Reyna argued that Mr. Tam’s speech is commercial, not the type of valuable political speech that should be protected by the First Amendment.²⁶

Without the *Tam* decision, the goals of trademark law are not met for a small subset of trademarks—those deemed to be disparaging. At one point, the Court outlined the two goals of trademark law, which are, generally, to serve as source identifier so that the public knows the goods it is getting are what it wanted and to protect trademark holders from others using their trademarks.²⁷ One of the major benefits of federal registration is exclusive nationwide use of a trademark where there is no prior use of the mark by anyone else.²⁸ Without federal registration, another band could call itself The Slants and perform in an area where Mr. Tam’s band had not performed. If that happened, both goals of trademark law would not be met. Because the band had the same name, consumers could buy tickets to the performance, wrongfully assuming that they had purchased tickets to see Mr. Tam’s band. Additionally, the band would be able to use the trademark and would gain priority over Mr. Tam for use of the name in that particular geographical area. That outcome is now prevented, assuming that the TTAB does not find other grounds for refusing Mr. Tam’s registration.

The Court’s decision in *Tam* also serves important social goals. Social scientists have noted that many disparaging words are now being “reclaimed” by the populations those words were once used against.²⁹ A 2003 study noted that reclaiming words or negative stereotypes can help both stigmatized groups and individuals to fight stereotypes and prejudice.³⁰ This type of reappropriation is what Mr. Tam was attempting by naming his band The Slants.³¹ In the original TTAB proceeding, the board said that because a substantial subset of persons of Asian descent would find the term offensive, it was irrelevant that Mr. Tam was attempting to reappropriate the word.³² However, with language quickly changing and a standard as shaky as a substantial subset of affected persons, the PTO may end up hurting the progression of minority and stigmatized groups by burdening their attempts to reclaim disparaging words and to fight prejudice.

The *Tam* decision is also important to artistic entities. Artistic entities, like bands, use trademark law in the same way as commercial enti-

25. *Id.* at *127 (Lourie, J. Dissenting).

26. *Id.* at *132 (Reyna, J. Dissenting).

27. *Id.* at *5 - *6 (Majority Opinion).

28. *Id.* at *6 - *7.

29. Adam Galinsky, et al., *The Reappropriation of Stigmatizing Labels: Implications for Social Identity*, NORTHWESTERN UNIVERSITY (2003), <http://faculty.wcas.northwestern.edu/bodenhausen/reapp.pdf>.

30. *Id.* at 231-32.

31. *Tam*, 2015 U.S.App. LEXIS 22593 at *13-14.

32. *Id.* at *15.

ties, but convey different messages through their trademarks. The court rightly dismissed the argument that trademarks are purely commercial speech. While many trademarks employed by traditional corporate entities are not expressive, artistic entities, such as The Slants, can benefit from trademark protection and choose trademarks for expressive reasons. Having a murky provision such as section 2(a)'s disparagement provision burdening the speech of artistic entities is clearly unconstitutional and unproductive from a policy perspective.

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