FUNKHOUSER VEGOSEN LIEBMAN & DUNN LTD.

Legal Update

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GOVERNMENT CAN'T DISPARAGE DISPARAGING TRADEMARKS

By Peter T. Berk

On June 19, 2017, the United States Supreme Court struck down a limitation on trademark registration. In *Matal v. Tam*, the Court held that a restriction on "disparaging" trademarks violated the First Amendment.

Section 2(a) of the Lanham Act provided that a trademark could not be registered for "matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols." This was known as the "disparagement clause." In the *Tam* case, Simon Tam, a musician of Asian descent, sought to register the mark THE SLANTS for his rock band asserting that he chose the mark to reclaim the disparaging term. The United States Patent and Trademark Office had denied the registration on the grounds that the term was disparaging to Asian Americans.

While the Court's opinion covers many issues (including what is government speech, what constitutes a government program or subsidy, *etc*.), and while some justices wrote separately on specific points, the Court held that the disparagement clause violates the First Amendment to the Constitution. The various justices disagreed on whether the disparagement clause was subject to "relaxed scrutiny" requiring that the clause serve a "substantial interest" and be "narrowly drawn," or subject to heightened scrutiny as viewpoint discrimination. But all of the justices agreed that, under whichever test they believed applied, the disparagement clause was unconstitutional.

What does this mean? A few things:

- trademark applications that were suspended pending the outcome of this case will now proceed and we expect that any objection under the disparagement clause will be withdrawn;
- we expect that the registrations for the REDSKINS trademarks will remain in force; and
- while the Supreme Court did not address the other provisions of Section 2(a) (prohibiting "scandalous" or "immoral" matter for example), the other subjective bases for denial should also fall by the wayside.

What should you do? If you applied to register a trademark that was denied based on Section 2(a), or if you did not file a trademark application because of Section 2(a), you should consult with an attorney about whether to file a new application. FVLD's attorneys would be glad to assist you.

FVLD publishes updates on legal issues and summaries of legal topics for its clients and friends. They are merely informational and do not constitute legal advice. We welcome comments or questions. If we can be of assistance, please call or contact Peter T. Berk 312.701.6870 pberk@fvldlaw.com, Twitter: @BerkPeter, LinkedIn: www.linkedin.com/in/pberk, or your regular FVLD contact.

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