U.S. Patent and Trademark Office's Refusal to Register Disparaging Trademarks Struck Down on First Amendment Grounds

The U.S. Court of Appeals for the Federal Circuit, in a 9-3 decision in ***In re Tam***, has declared a provision of the federal trademark law unconstitutional as violating the First Amendment guarantee of free speech. The provision in question permits the U.S. Patent and Trademark Office ("USPTO") to refuse to register disparaging marks.

The case involves a trademark application by a band to register "THE SLANTS" for "entertainment in the nature of live performances by a musical band." The USPTO and the Trademark Trial and Appeal Board refused to register the mark on the grounds that it was disparaging to people of Asian descent. The founder of the band, who is of Asian descent, named the band "THE SLANTS" in part to "reappropriate" and take back control of the word that has long been seen as a racial slur targeting Asians.

The essence of the court's holding is that "[t]he government cannot refuse to register disparaging marks because it disapproves of the expressive messages conveyed by the marks. It cannot refuse to register marks because it concludes that such marks will be disparaging to others." The court went on to declare that "even when speech 'inflicts great pain,' our Constitution protects it 'to ensure that we do not stifle public debate.'"

Undoubtedly an appeal will be taken to the U.S. Supreme Court. And the case will further the public controversy over the name of the National Football League's "Washington Redskins" team, whose registration for the mark "REDSKINS" was recently cancelled under this same provision of the federal trademark law. In the meantime, we will need to wait and see whether the USPTO will now approve applications for these types of marks, will accept the applications but "suspend" them until the courts provide clearer guidance, or will continue to refuse to accept these applications.

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