

## The Battle of the Brand: The Slants - Asian-American Band vs. the U.S. Patent and Trademark Office

The Slants, an Asian-American rock band, fought the U.S. Patent & Trademark Office (USPTO) for nearly eight years to register its name as a trademark. The USPTO argued that the name “The Slants” is a derogatory term for Asians, and therefore barred registration of the mark under the disparagement clause of the federal Trademark Act. This summer, the battle culminated in a unanimous decision of the U.S. Supreme Court (*Matal v. Tam*) holding that the Trademark Act’s disparagement clause violated the First Amendment’s protection of free speech. Therefore, the Court allowed registration of the mark.

A trademark is a word, symbol, or other designation (such as the “McDonald’s” name or the Apple logo) used by an entity to distinguish its goods or services from others. Federal registration of a trademark is not mandatory, but provides significant legal advantages, such as the exclusive right to use the mark nationally for the registered goods or services.

The Asian-American band named itself “The Slants” to “reclaim” this derogatory term for people of Asian descent and make it positive. However, the USPTO denied the application on grounds that it violated the Trademark Act clause barring registration of marks that contain “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.”



The Supreme Court held that the provision violated the Free Speech clause of the U.S. Constitution by “offending a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend.” The provision constituted viewpoint discrimination – the government was favoring some viewpoints or ideas but not others.

The “government speech” doctrine, invoked by the USPTO in this case, serves as an exception to the First Amendment’s protection of freedom of speech. Under this doctrine, the government is permitted to suppress speech the public would associate with the government. For example, states may deny symbols on specialty license plates that they deem offensive. However, the Court rejected expansion of the government speech doctrine to trademarks, stating that the public does not associate trademarks with the U.S. Government, nor do trademarks convey government messages. To protect freedom of speech, the Court stated that “trademarks are private, not government, speech.” The First Amendment protects private speech, and the government cannot prohibit an expression of an idea, conveyed in just a few words or a symbol.

The USPTO tried to defend the clause stating it had a higher goal than the First Amendment: “an interest in preventing ‘underrepresented groups’ from being ‘bombarded with demeaning messages in commercial advertising.’” The Court responded to this argument reiterating that the government cannot prevent speech, even speech that offends, otherwise First Amendment protections are at risk. The Court stated that it is inevitable that the commercial market is filled with disparaging products, and we cannot cleanse commercial speech of offensive ideas. If we are willing to suppress speech by deeming it commercial, then “free speech would be endangered.”

The full implications of the case are yet to be determined, but one National Football League team was elated by the Slants decision. In 2014, after two decades of litigation, the USPTO canceled the Washington Redskins trademark registration based on the arguments of a group of Native Americans that the name was disparaging to them and their ancestors. Presumably, the USPTO will now permit the Redskins to once again register its name as a trademark.

It remains to be seen if we will see a rise in the registration of other trademarks deemed to be racist or disparaging.

For more information on the protection of your organization’s trademarks, please contact Kenneth Liu at [kel@gg-law.com](mailto:kel@gg-law.com).

## Attorney Spotlight



### *Kenneth Liu*

*Kenneth Liu helps businesses and nonprofits protect their intellectual property, including advising them on: trademark selection, registration, and enforcement; negotiation of license agreements; litigation/dispute resolution; and management of international trademark portfolios. Mr. Liu also counsels clients on Internet, domain name, and other copyright issues, including licenses and vendor agreements, social media policies, privacy policies, and website terms of use.*

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