USPTO Flagged for Roughing Applicant of Disparaging Trademark

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A recent decision by the Federal Circuit could effectively overrule the call on the field in the cancellation of the REDSKINS trademarks.

In 2014 the U.S. Patent and Trademark Office (USPTO) Trademark Trial and Appeal Board (TTAB) cancelled six Redskin trademarks that had been registered to the Washington D.C. based NFL team at the request of five Native American individuals, on the basis that the marks are disparaging. The TTAB's decision was affirmed by the United States District Court for the Eastern District of Virginia, where the court held that the disparagement provision of Section 2(a) of the Lanham Act does not violate the First Amendment right to free speech. The case is now before the Fourth Circuit on appeal.

The Federal Circuit recently found the 70-year-old rule prohibiting the registration of disparaging trademarks unconstitutional. In *In re Simon Shiao Tam* the USPTO refused registration of the mark THE SLANTS on the basis that the term was likely to disparage persons of Asian descent. The applicant, an Asian-American artist, intended to use the trademark for the name of his band. He acknowledged that he selected the term because of its derogatory nature, but with the intention of fighting bigotry rather than encouraging it.

In support of its refusal, the USPTO argued that it should be able to refuse "vile racial epithets and images" from registration and that the First Amendment was not violated because the USPTO did not prohibit use of the mark, but only refused its registration. The Federal Circuit disagreed, holding that "it is a bedrock principle underlying the First Amendment that the government may not penalize private speech merely because it disapproves of the message it conveys. That principle governs even when the government's message-discriminatory penalty is less than a prohibition."

It is widely speculated that the *Tam* decision could impact the pending REDSKINS appeal. While the Fourth Circuit is not required to follow the Federal Circuit, Federal Circuit rulings are generally given weight, as the USPTO is bound by its decisions. Should the Federal and Fourth Circuits reach a split, the stage may ultimately be set for consideration by the U.S. Supreme Court.

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While the refusal of disparaging marks was found unconstitutional in *Tam*, the Court did not address "immoral" or "scandalous" marks (also prohibited by Section 2(a) of the Lanham Act), suggesting that applications for such marks may still be flagged for a false start, at least for the time being.