Supremes Rule in Favor of The Slants in a Sweeping Trademark Decision

By Maryann Zaki and Craig Stone

In June, the United States Supreme Court issued an eagerly anticipated decision involving a social justice activist, musician Simon Tam. Applicant and appellee Tam is the lead singer of a band named The Slants, and owner of trademark application U.S. Ser. No. 85/472,044 seeking to register his band’s name in connection with entertainment services in Class 41. Tam’s eight-year protracted battle with the U.S. Patent and Trademark Office finally ended with the Supreme Court deciding 8-0 in Tam’s favor and affirming the Federal Circuit’s opinion striking down the “disparagement” portion of 15 U.S.C. § 1052(a) (also known as Section 2(a) of the Lanham Act) as unconstitutional. The ruling overturns the USPTO’s rejection of Tam’s application and clears the path to federal registration.

Section 2(a) has existed for 71 years, since the Lanham Act was enacted in 1946. The relevant portion of Section 2(a) reads:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . [c]onsists 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 . . . .

The precedential ruling immediately impacted another well-known pending case involving a series of Washington Redskins trademarks and corresponding federal registrations cancelled by the USPTO in 2014 and appealed to the Supreme Court. In light of the holding in Matal v. Tam, the U.S. Department of Justice recently delivered a letter to the Clerk of the Court for Court of Appeals for the Fourth Circuit explaining “oral argument is unnecessary [and] the Court should reverse the judgment of the District Court and remand the case in favor of the [Redskins].”

Seeking Federal Registration

After forming his new band, following a recommendation of an attorney friend, Tam filed his first federal application in March 2010 to register THE SLANTS in connection with “[e]ntertainment, namely, live performances by a musical band” in Class 41. Simon stated the band named themselves...
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The Slants “as a way of seizing control of a racial slur, turning it on its head and draining its venom. It was also a respectful nod to Asian-American activists who had been using the epithet for decades. But the Trademark Office didn’t buy it.”

Four months later the PTO issued an Office Action rejecting the application on the grounds that the mark was disparaging under § 1052(a). The Examining Attorney explained in the Office Action that the “attached evidence shows the likely meaning of ‘THE SLANTS’ to be ‘a term that [refers] to Asian persons with slanted eyes.’ This refers to ‘those of Asian descent in a disparaging manner because it is typically associated with a use that derides and mocks a physical feature of persons of Asian descent.’ The Examining Attorney then attached supporting evidence in the form of several online screen captures from Urban Dictionary and Wikipedia. The Examining Attorney also referenced the band’s own website, asserting the band even acknowledged the derogatory nature of the term by admission. The Examining Attorney also submitted online evidence of Miley Cyrus using her fingers to pull her eyes outward in a “slanting” position in an attempted derogatory gesture.

What followed over the next several years were several more rejections and Office Action responses, an abandonment of his original application, and even more rejections and responses. Tam appealed the disparagement refusal to the Trademark Trial and Appeal Board in 2012 and was again rebuffed, with the Board affirming the Examining Attorney’s rejection in its 2013 precedential decision.

Despite the ruling, Tam remained determined and resilient. He appealed to the Federal Circuit, during which one of his pro bono lawyers “threw in” an argument that Section 2(a) was unconstitutional. The Federal Circuit ultimately decided en banc in Tam’s favor on that argument.

The Supreme Court affirmed the Federal Circuit in June. In its unanimous decision, the Supreme Court held that trademarks are private speech, and the disparagement provision violates the Free Speech Clause of the First Amendment. The Supreme Court rejected each of the government’s arguments that Section 2(a)’s disparagement provision was constitutional and struck down the provision.

In the final paragraphs of the opinion, Justice Alito wrote:

It is not an anti-discrimination clause; it is a happy-talk clause . . . . The commercial market is well stocked with merchandise that disparages prominent figures and groups, and the line between commercial and non-commercial speech is not always clear, as this case illustrates. If affixing the commercial label permits the suppression
of any speech that may lead to political or social “volatility,” free speech would be endangered.

The Slants Tour Texas and Tam Visits STCLH in April

In April, as The Slants were making their way across Texas during the band’s spring 2017 tour, Simon Tam made a quick stop at South Texas College of Law in Houston to share his life story and perspective on his fight to register his band’s name. The original plan was for Simon to present his perspective in a lecture forum and then have the band perform a free concert in the atrium following the discussion.

Unfortunately, the plan did not unfold as scheduled. The band’s tour bus experienced mechanical issues, forcing Tam to abandon his bandmates and fly to Houston for the evening presentation. After finally arriving in Houston, Tam impressed the crowd with his perspective on being raised by his first-generation American parents, as well as describing notable film and music influences that inspired him to ultimately craft his message and musical platform to exalt Asian-American culture. The well-attended event was a fantastic success and Tam stayed for more than 90 minutes following the conclusion of his presentation to answer questions posed by enthusiastic lingering attendees.

Tam explained, “We’re fighting for more than a band name. We’re fighting for the right of self-determination for all minorities . . . . I started The Slants nearly a decade ago because I wanted to change people’s assumptions . . . . I named the band The Slants because it represented our perspective—or slant—on life as people of color. It was a deliberate act of claiming an identity, as well as a nod to Asian-American activists who had been using the term for decades.”

Finale and Takeaways

Now that Tam’s application has a clear path to registration, what’s next for the thirty-something Supreme Court winner and rock star? In June, Simon wrote an op-ed published by the New York Times following the decision. In early August, Simon announced on LinkedIn that he has launched his own “marketing firm that focuses on cultural competent messaging, content writing/pitching for niche industries (like law firms and arts organizations) and increasing capacity for organizations who need but can’t afford to hire communications staff.” It sounds like Simon found the next best fit in continuing to use his experiences to improve understanding and inclusiveness. You can follow Tam on Twitter here.
Clients interested in registering marks that may have previously been deemed disparaging by the PTO should note that such marks can no longer be refused registration on that basis. In fact, the Tam ruling has resulted in a slew of federal application filings to test the newly opened waters. While some have criticized the ruling believing it will lead to a influx of individuals seeking to register racially offensive words, Tam remains convinced that almost all of such applications would actually be from individuals reclaiming terms or using them to advance justice in some way.

Furthermore, the remaining portions of Section 2(a) currently remain intact and still prohibit trademarks for “immoral, deceptive, or scandalous matter.” Currently, there is an appeal pending at the Federal Circuit objecting to the constitutionality of the “scandalous or immoral” language of the statute. In that appeal, the trademark applicant seeks to register the term FUCT for, among other things, “athletic apparel” in Class 25 (In re Brunetti, Case No. 15-1109 (Fed. Cir. filed Nov. 6, 2015)). While it remains to be seen how the court will decide, the Federal Circuit heard arguments in November 2016, and a decision may be delivered soon now that the Tam opinion has published. Listen to the In re Brunetti oral arguments here.

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