

The Trademark Landscape after *Matal v. Tam*

AppDetex Webinar

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September 6, 2017

Roadmap

- Analysis of *Matal v. Tam*
- Current status of disparaging marks
- Current status and possible future of scandalous marks
- Implications of *Matal* for dilution law

Warning!

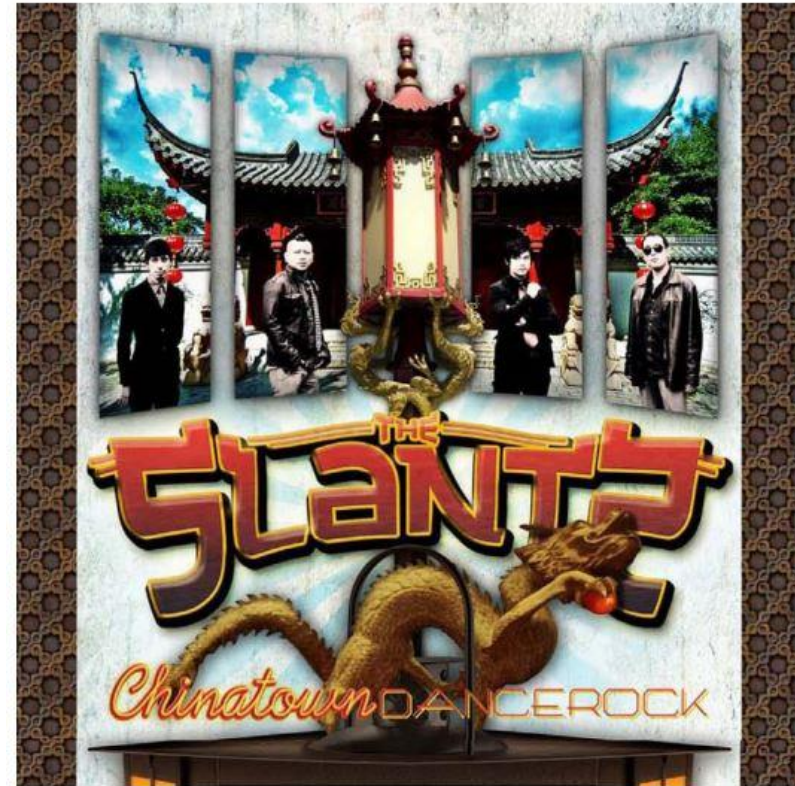
*Scandalous and
Disparaging
Content Ahead*

Matal v. Tam

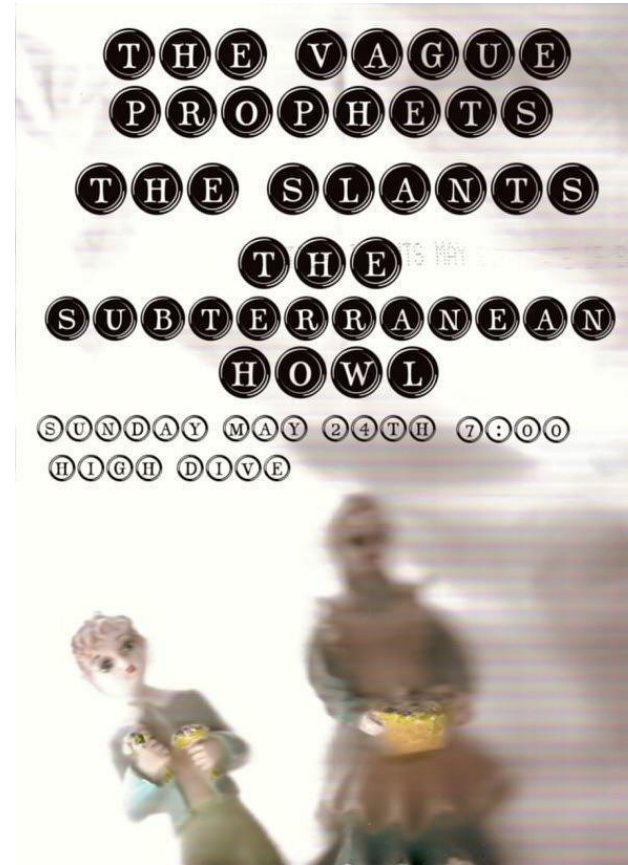
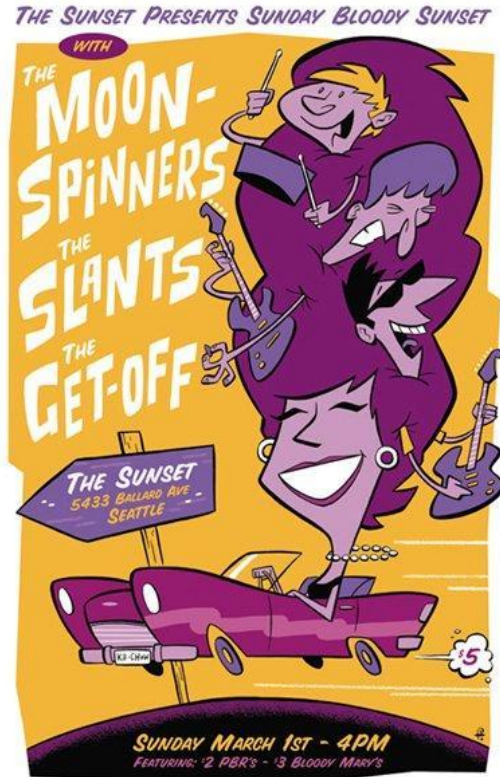
Section 2(a) of the Lanham Act

“No [distinctive] trademark . . . shall be refused registration . . . on account of its nature unless it

(a) Consists of or comprises immoral . . . or scandalous matter; or matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute . . .”



THE SLANTS original specimens



THE SLANTS second specimens

In re Tam at the Federal Circuit

- (1) Panel's affirmance, with "additional views"
- (2) Vacatur of affirmance and sua sponte order for en banc consideration
- (3) Reversal en banc

Matal v. Tam

ALITO, J., announced the judgment of the Court and delivered the opinion of the Court with respect to Parts I, II, and III–A, in which ROBERTS, C. J., and KENNEDY, GINSBURG, BREYER, SOTOMAYOR, and KAGAN, JJ., joined, and in which THOMAS, J., joined except for Part II, and an opinion with respect to Parts III–B, III–C, and IV, in which ROBERTS, C. J., and THOMAS and BREYER, JJ., joined. KENNEDY, J., filed an opinion concurring in part and concurring in the judgment, in which GINSBURG, SOTOMAYOR, and KAGAN, JJ., joined. THOMAS, J., filed an opinion concurring in part and concurring in the judgment. GORSUCH, J., took no part in the consideration or decision of the case.

Matal Majority

“The provision offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend.”

Matal Majority

- ✓ Refusal to register places a burden on speech.
- ✓ Trademarks are not government speech.
Or . . . *Registration* is not government speech. It's unclear.

Matal Plurality

- Disparaging marks express a viewpoint when they offend. “Giving offense is a viewpoint.”
- Therefore, refusal to register disparaging marks is viewpoint discrimination.

Matal Plurality

- Government: Trademarks are commercial speech.
- Tam: Trademarks are expressive speech.
- Plurality: We don't have to decide. The disparagement clause doesn't even withstand the lower scrutiny for commercial speech.

Matal Plurality

- What is the “*substantial government interest*”?
 - Preventing speech that demeans underrepresented groups?
 - Protecting the “orderly flow” of commerce?
- Is the clause “*narrowly drawn*” to serve those interests?
 - No, it’s overbroad.

Matal Concurrence (Kennedy, J.)

- Applicants can register positive or neutral marks, but not negative ones. The government is therefore removing “a subset of messages it finds offensive.”
- That’s viewpoint discrimination and impermissible censorship.

THE SLANTS

✓ published for opposition August 30, 2017

☐ **Serial Number:** 85472044



41 - Entertainment in the nature of live performances by a musical band

Filing Date: Nov. 14, 2011

Intl/US Class(es): 41

Current Owner(s): Tam, Simon Shiao

Mark Literal(s): THE SLANTS

Mark Drawing Code: 4 -
STANDARD CHARACTER MARK

THE SLANTS

More on Disparaging Marks

Pro-Football, Inc. v. Blackhorse

- ✓ The parties agreed to dismiss the case

WASHINGTON



REDSKINS

The Redskins



Status at USPTO

The fact that “a mark may ‘disparage . . . or bring . . . into contempt or disrepute’ is no longer a valid ground on which to refuse registration or cancel a registration.”

- USPTO Examination Guide 1-17 (issued June 26, 2017)

The Good Old Days



SEX ROD

Porno Jesus

Stop the Islamisation of
America

Disparagement *Post-Matal*

- **N-WORD** (hats, tops, leather belts, triathlon tights, etc.) (ITU)
- **YOUNG NIGGAH WORLD** (multimedia entertainment) (use-based)
- **NIGGER PLEASE** (shirts) (ITU)
- **CERTIFIED STREET NIGGAZ** (caps, t-shirts) (filed Jan. 5, 2017) (ITU, had been suspended)
- **HIMNIGGA SHIT** (hats, shirts) (filed June 24, 2016) (ITU, had been suspended)
- **STILL NIGGA** (graphic t-shirts) (ITU)
- **NIGGADEMUS** (shirts) (ITU)

Disparagement *Post-Matal*

- **NIGGA** (2 apps for alcoholic beverages, 1 app for apparel) (ITU)
- **NIGGA** (online retail store services selling clothing, mugs, etc.) (ITU)
- **NIGGA BRAND** with logo and **NIGGA** (3 apps from same owner with laundry list of goods, including decorative charms for pet collars, plush toys, motion picture theatrical films, non-alcoholic cocktails, social media advertising services, charitable fundraising services, live dance performances, eggnog, shirts) (ITU)



Disparagement Post-*Matal*

- **DYKES ON BIKES** logo (organizing and participating in parades and festivals to support women motorcyclists and foster pride in sexual orientations and identities) (filed April 24, 2015)
 - Had been suspended
 - Owners already own word mark **DYKES ON BIKES** since Oct 30, 2007 for similar services



Disparagement *Post-Matal*

- **CHINK** (online retail stores for clothing, etc.) (filed June 21) (ITU)
- **SAMBO** (downloadable music, live performances by a musical group) (filed July 11) (ITU)
- **JAP** (bed linens) (filed 2015, suspended) (ITU)
- **FUNCTIONING RETARD** (bumper stickers, mugs, shirts) (filed 2016, suspended) (ITU)

Existing Registrations

- REDNECK
- HEATHEN
- GRINGO
- GYPSY
- HONKY
- WHITE TRASH
- CANUCK

Bases for Challenging Disparaging Marks *Post-Matal*

- ✓ Lack of bona fide intent to use
- ✓ Failure to function as a trademark
- ✓ Likelihood of confusion
- ✓ Tarnishment?

What happens to Section 2(a) now?

- **Communications Decency Act of 1996:**
 - It is a crime to use the Internet to display to anyone under 18 a communication that "in context, depicts or describes, in terms patently offensive as measured by contemporary community standards, sexual or excretory activities or organs." 47 U.S.C. § 223(d).
- **Reno v. ACLU, 521 U.S. 844 (1997):**
 - That provision violates the First Amendment.
- **Amendment by Congress on October 21, 1998:**
 - It is a crime to use the Internet to display to anyone under 18 a communication that "in context, depicts or describes, in terms patently offensive as measured by contemporary community standards, sexual or excretory activities or organs." 47 U.S.C. § 223(d).

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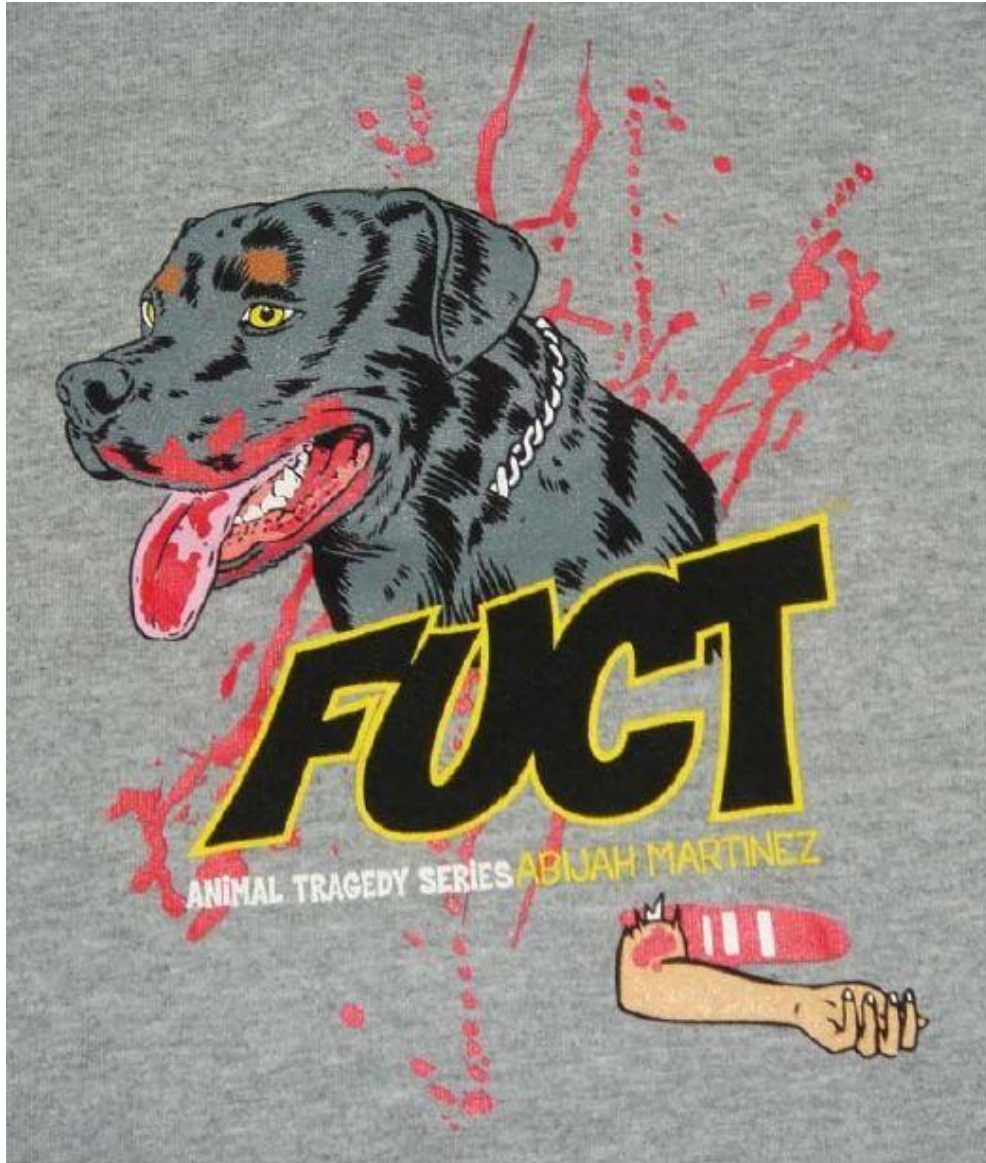
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- **Reno v. ACLU, 521 U.S. 844 (1997):**
 - That provision violates the First Amendment.
- **Amendment by Congress on October 21, 1998:**
 - It is a crime to use the Internet to display to anyone under 18 a communication that "*is obscene or child pornography.*" 47 U.S.C. § 223(d) (current).

Scandalous Marks

Status at USPTO

The USPTO “continues to examine applications for compliance with [the scandalousness] provision . . . Any suspension . . . based on [that] provision will remain in place until the Federal Circuit issues a decision in *Brunetti*.”

- USPTO Examination Guide 1-17 (issued June 26, 2017)



In re Brunetti

Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps; Children's and infant's apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments

In re Brunetti

“Fucked’ and its phonetic twin, ‘fuct,’ are both vulgar terms. . . [W]e have no question but that these are still extremely offensive terms in the year 2014.”

- *In re Brunetti*, 2014 TTAB LEXIS 328 (T.T.A.B. 2014)

Offensiveness

Matal plurality:

The disparagement bar “denies registration to any mark that is offensive to a substantial percentage of the members of any group. But that is viewpoint discrimination: **Giving offense is a viewpoint.**”

USPTO in *Brunetti*:

“Offensive” in *Matal* refers to an unpopular opinion, not vulgar subject matter. Prohibiting profanity and lewdness is viewpoint-neutral.

Government Interest?

- USPTO in *Brunetti*
 - “promoting the use of non-scandalous trademarks in commerce”
- But is scandalousness clause “narrowly drawn” to promote non-scandalous trademarks?

Fuck The Draft

“Surely the State has no right to cleanse public debate to the point where it is grammatically palatable to the most squeamish among us. . . . [W]e think it is largely because governmental officials cannot make principled distinctions in this area that the Constitution leaves matters of taste and style so largely to the individual.”

- Cohen v. California, 403 U.S. 15, 25 (1971)

Scandalous Mark Rejections

- Sexual References
- Profanity and Vulgarity
- Drug References
- Violence

MOMSBANGTEENS

CUM FIESTA

CUM GIRLS



Dick Heads

no fucks given

NO BULLSHIT

Listen Up Asshole

Cocaine

Marijuana Cola

K
O
K
A
I
N
E

Obama Bin Laden

AL-QAEDA



Overbreadth of “Scandalous”?

- Federal Circuit in *Brunetti* argument:
 - Where can the lines be drawn on scandalousness?
 - Level of inconsistency at USPTO is “shocking”

What About Tarnishment?

Dilution by Tarnishment

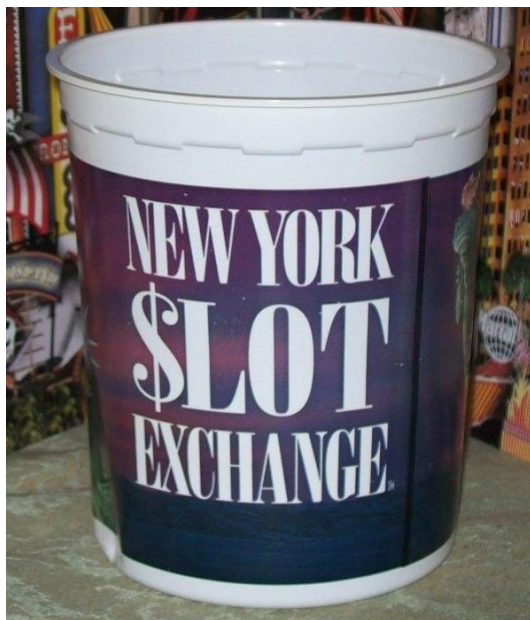
“association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark”

– 15 U.S.C. § 1125(c)(2)(C)

Dilution by Tarnishment

It isn't actionable to use another party's famous mark "in connection with . . . identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner."

– 15 U.S.C. § 1125(c)(3)(A)(ii)



www.barbiesplaypen.com (circa 1999)

Warning: This is a xxx sex and porn site intended for adults only! If you are not of legal age to view pornography in the area from which you are viewing this porn - you must leave now! If you are offended by porn material or such material is not legal in the area from which you are viewing this porn site press exit below.

Conclusion

Contact Info (neither disparaging nor scandalous)

- For more about Anne and how to order her treatise, visit her adequate website at annegilsonlalande.com.
- Send her an e-mail at trademarkbook@comcast.net.

