



**Rock Bands, "Redskins," &  
Registrations: The Federal Circuit  
Strikes Down Statute on "Disparaging"  
Trademarks**

January 28, 2016



## Moderator



**Mike Keyes**

- IP Litigation and Trial Partner
  - Co-editor of Dorsey's IP Blog, [TheTMCA.com](http://TheTMCA.com)
- [@JMichaelKeyes](https://twitter.com/JMichaelKeyes)  
[Keyes.mike@dorsey.com](mailto:Keyes.mike@dorsey.com)

## Today's Panelists



**Mr. Simon Tam**



@SimonTheTam



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## Today's Panelists



**Professor Robert Chang**



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## Today's Panelists



**Mr. Mat dos Santos**



@MatPDX



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## Today's Panelists



**Ms. Charlene Krogh**

[krogh.charlene@dorsey.com](mailto:krogh.charlene@dorsey.com)



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## Section 2(a) of the Lanham Act

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

(a) Consists 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, or bring them into contempt, or disrepute...



Rep. Fritz Lanham

15 U.S.C. § 1052(a) (emphasis supplied).



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## Application to Register "The Slants"



- Section 1(a) application for "Entertainment, namely, live performances by a musical band."
- "Registration is refused because the applied-for mark consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols."
- Nov. 8, 2011 application is abandoned



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## Second Application to Register "The Slants"

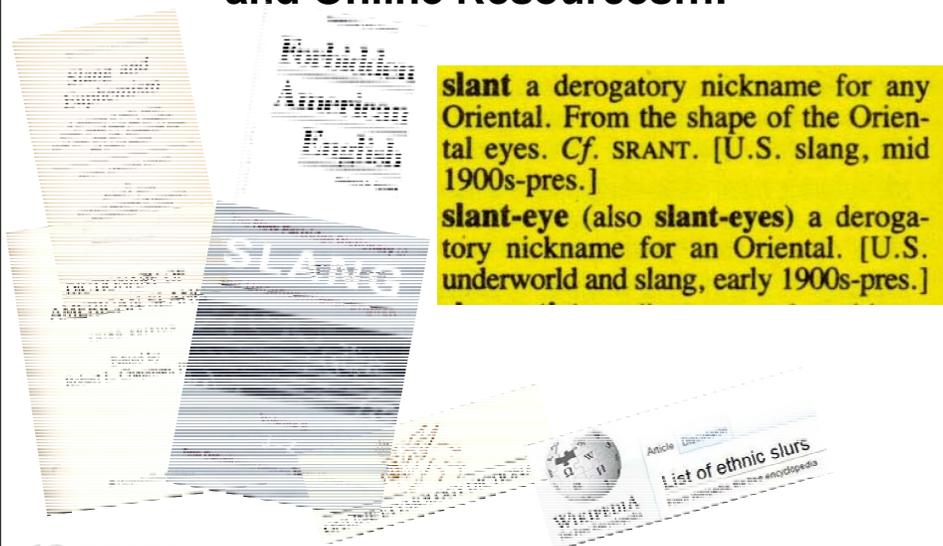


- Section 1(a) application for "Entertainment in the nature of live performances by a musical band."
- "Registration is refused because the applied-for mark consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols."



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## Examiner Considered Various Printed and Online Resources....

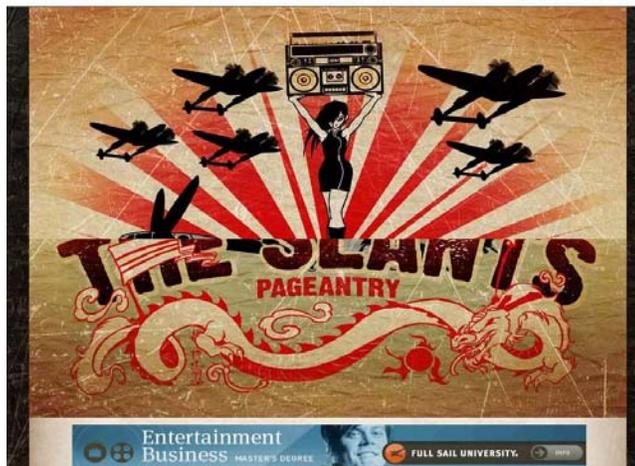


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## Examiner Considered News Stories and Online Comments....



## Examiner Considered Material on The Slants' website



### Refusal is Appealed to TTAB...And Upheld



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### Refusal is affirmed by panel of U.S. Court of Appeals for Federal Circuit



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## U.S. Court of Appeals for Federal Circuit Sitting *En Banc* Reverses



***"We hold that the disparagement provision of § 2(a) is unconstitutional because it violates the First Amendment. We vacate the Board's holding that Mr. Tam's mark is unregistrable, and remand this case to the Board for further proceedings."***



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## What Does an Asian American Dance Band Have in Common with the Washington R-skins?

Robert S. Chang  
changro@seattleu.edu



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CENTER for LAW and EQUALITY  
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## Fred T. Korematsu Center for Law and Equality



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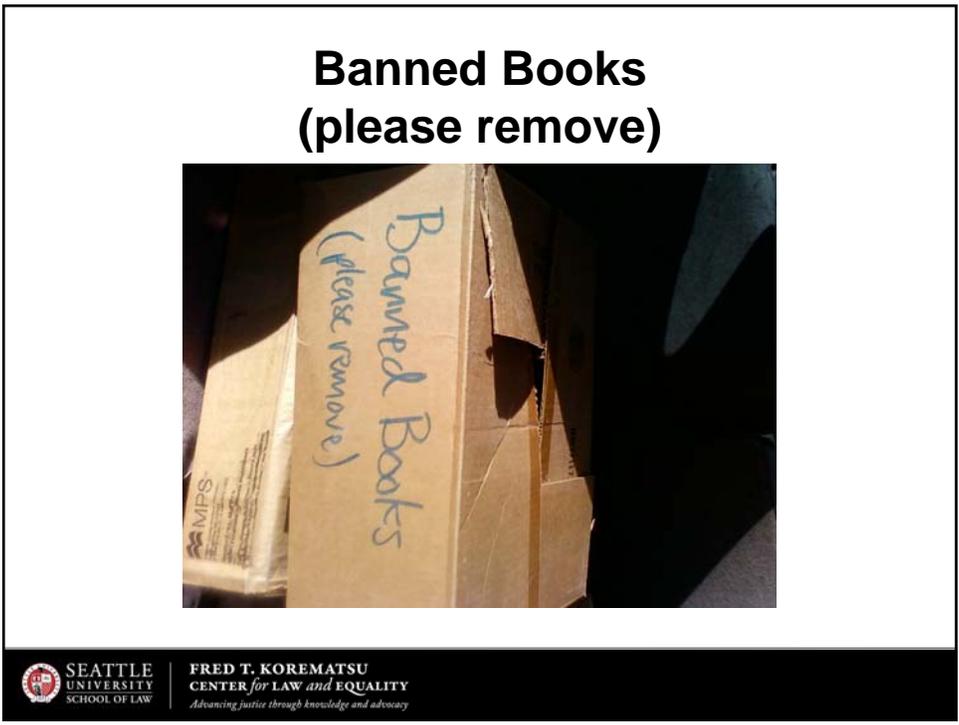
## A Sampling of Issues We've Addressed

- Juror bias directed against a Japanese American attorney
- National origin bias and family law
- Cross-racial eyewitness testimony and jury instructions
- Constitutionality of Washington's death penalty
- What does "because" mean with regard to protection against retaliation in the Title VII context?
- Juvenile life without parole
- Race and the criminal justice system
- Due process requirements when a Native foster child is confined to a private psychiatric hospital



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## What Does an Asian American Dance Band Have in Common with the Washington R-skins?



And why did the Korematsu Center get  
Involved in both cases?



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## First Amendment Challenge to Section 2(A) of the Lanham Act

### Federal Circuit

- In re Tam

as applied and facial  
challenge

### Fourth Circuit

- Pro-Football, Inc. v.  
Blackhorse



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### First Amendment

Congress shall make no law  
. . . abridging the freedom of  
speech . . . .

### Lanham Act

No trademark by which the goods  
of the applicant may be  
distinguished from the goods of  
others shall be refused  
registration . . . on account of its  
nature unless it –

(a) Consists of or comprises  
immoral, deceptive, or scandalous  
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## NAPABA/SABA-DC/Korematsu Center Amicus Brief - Introduction

### Racially restrictive covenants

- Private discrimination
- County deed registries
- Enforcement in courts
  
- But see Shelley v. Kraemer, 334 U.S. 1 (1948)

### Racially disparaging trademarks

- Private discrimination
- Federal Trademark Registry
- Enforcement in courts
  
- Federal Circuit en banc ruling; What will Fourth Circuit do? SCOTUS?



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## U.S Board on Geographic Names

### Domestic Geographic Names Policies

- Policy V: Derogatory Names

In the case of domestic geographic names, the U.S. Board on Geographic Names will not adopt a name for Federal usage that is determined by the Board to be derogatory to a particular racial or ethnic group, gender, or religious group.

. . .

The Board will not adopt a name proposal that includes the word "Jap" or the word "Nigger" whether or not it is in current local usage and regardless of by whom proposed.



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## The Intersection of Trademark, Public Accommodations Law, and the First Amendment

- "Muslim Free Zone"

CAIR Florida, Inc. v. Teotwawki Investments,  
LLC, d/b/a Florida Gun Supply (No. 15-cv-  
61541 – Bloom/Valle, S.D. Fla.)



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## So too goes the "immoral" and "scandalous" provision of Section 2(a)?



U.S. Trademark App. For "FUCT"

*In re Brunetti*, No. 2015-1109

***"We therefore agree that the proper disposition of this case under the law of this Court is to vacate and remand the Board's decision for further proceedings, as in Tam, because the reasoning of Tam requires the invalidation of Section 2(a)'s prohibition against registering scandalous and immoral marks as well."***

Letter of January 21, 2016 to the Federal Circuit, U.S. Department of Justice



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