



Disparaging Trademarks:
The *Skin-ny* on *The Slants*

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Outline

- Background
- The Slants case (In Re Tam)
- The Redskins case (Blackhorse v. Pro-Football)
- Potential for Supreme Court involvement
- Discussion

Disparaging Trademarks

- Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), bars the registration on either the Principal or the Supplemental Register of a designation that consists of or comprises matter which, with regard to persons, institutions, beliefs, or national symbols, does any of the following:
 - (1) disparages them;
 - (2) falsely suggests a connection with them;
 - (3) brings them into contempt; or
 - (4) brings them into disrepute.

Examination

- In an ex parte case involving disparagement of a non-commercial interest, the following two-part test applies in determining whether a proposed mark is disparaging:
 - (1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and
 - (2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

Examination

- In such cases, the examining attorney must make a prima facie showing that a substantial composite, although not necessarily a majority, of the referenced group would find the proposed mark, as used on or in connection with the relevant goods or services, to be disparaging in the context of contemporary attitudes.
- The question of disparagement must be considered in relation to the goods or services identified in the application and the manner of use in the marketplace.

Examples

- KHORAN for wines
- SQUAW and SQUAW ONE for clothing and retail services
- HEEB for clothing and entertainment services
- THE CHRISTIAN PROSTITUTE for clothing

In Re Tam



Procedural History

- First applied in 2010, refused due to 2(a), failed to file a brief on appeal.
- Second application refused, TTAB refused due to 2(a) in 2013.
- Appealed to Federal Circuit
 - First Decision – Affirmed
 - En Banc – Overturned, December 2015.

Majority Opinion

- Unconstitutional restraint on speech
- First Amendment “forbids government regulators to deny registration because they find the speech likely to offend others.”
- Viewpoint discrimination does not survive strict scrutiny.

Dissents

- Would have not found this mark disparaging, but would not have ruled the section unconstitutional.

Commentary

- Some believe the 2(a) unconstitutional holding will not stand review.

Current Developments

- Tam's lawyers asked for a Writ of Mandamus to compel the USPTO to issue the registration certificate, but that was denied last Wednesday by the Federal Circuit.

Blackhorse, et al
v.
Pro-Football, Inc.



Procedural History

- Prior case filed in 1992; DC Circuit reversed a TTAB decision of disparagement, but not on the merits of the issue in 2009.
- Cancellation filed in 2006; suspended due to prior case.
- June 18, 2014 - TTAB ruled that the trademarks were disparaging, and cancelled registrations.
- Affirmed by the E. District of Virginia, July 8, 2015.
- On appeal to 4th Circuit

Opinion

- No effect on ability to use, so 2(a) does not affect speech; gov't speech is exempt from 1st Amendment scrutiny.
- Found that it may disparage a substantial composite of Native Americans, from the time registered in 1967 to 1990.

Discussion

- How about registration of “TRADEMARK GEEK” for legal services?
- Other Examples
- What will the Supreme Court do, if the 4th Circuit rules as below?

Thank You!

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