Trademarks/Registration

ACLU Gets Chance to Argue in 'Slants'
Registration Case But Redskins Will Not

ACLU But Not Redskins Will Argue in 'Slants' Case

In re Tam, Fed. Cir., No. 2014-1203, 9/3/15

Development: The Redskins' role as a litigant before another court likely killed its bid to argue in the Slants case.

Outlook: If the Fourth Circuit and Federal Circuit come out with clashing decisions then the constitutionality of a federal prohibition on registration of disparaging trademarks is quite likely headed to the Supreme Court.

- ***Development:*** *The Redskins' role as a litigant before another court likely killed its bid to argue in the Slants case.*
- ***Outlook:*** *If the Fourth Circuit and Federal Circuit come out with clashing decisions then the constitutionality of a federal prohibition on registration of disparaging trademarks is quite likely headed to the Supreme Court.*

By Anandashankar Mazumdar

Sept. 4 --The American Civil Liberties Union will be allowed to argue before the U.S. Court of Appeals for the Federal Circuit that a provision of federal trademark law that prohibits registration of disparaging terms violates free speech rights, according to an order issued Sept. 3 by the court that also denied permission to the Washington Redskins to participate in oral argument in the case (*In re Tam*, Fed. Cir., No. 2014-1203, 9/3/15).

On Oct. 2, the full appeals court will hear arguments regarding whether Simon Shiao Tam's First Amendment rights were infringed when the Patent and Trademark Office refused to register the name of his music group, "the Slants," in a case that could wind up before the U.S. Supreme Court.

The PTO found that to be a term that disparaged a significant segment of the Asian-American population.

The ACLU has filed an amicus brief arguing that the provision of the trademark law that rejects disparaging terms for registration is unconstitutional under the First Amendment.

The Redskins are pursuing a similar argument in a case before the U.S. Court of Appeals for the Fourth Circuit.

Amid that activity, an American Bar Association task force is examining the constitutional question.

The Federal Circuit's refusal to allow the Redskins to participate in argument was not surprising, according to trademark practitioners who spoke to Bloomberg BNA, given that they would be taking the same side as the ACLU, but as a litigant in the Fourth Circuit case, rather than as a relatively neutral advocate such as the civil liberties group.

Rejection of Redskins' Bid Not Surprising.

"I think the fact that one's in the Fourth Circuit and one's in the Federal Circuit is part of the reasoning of the court," James L. Bikoff of Smith, Gambrell & Russell LLP, Washington, told Bloomberg BNA. "I think the fact is that the ACLU is sort of an impartial body who represents the public and their views the court may want to consider in terms of the oral arguments, whereas, the Redskins are in a separate court and they're a party that has an interest in the proceedings and the court might not want to interfere with the other circuit."

Bikoff, who heads the American Bar Association's committee on trademark litigation, said that the group has assigned a task force to look into the question of the constitutionality of the relevant statute, Section 2(a) of the Lanham Act, 15 U.S.C. §1052(a).

Trip to High Court in Case of Circuit Split Likely.

Bikoff said that should the two appeals courts rule differently on this issue, it could end up before the U.S. Supreme Court.

"I think this is the kind of issue the Supreme Court would take," Bikoff said.

Eric Ball of Fenwick & West LLP, Mountain View, Calif., also said that a trip to the Supreme Court was very likely.

"I think there's a better than 50 percent chance that we could get to the Supreme Court.'
--Eric Ball, Fenwick & West

"I think there's a better than 50 percent chance that we could get to the Supreme Court," he said.

Ball said he did not think that "we have a window yet on what the Fourth Circuit will do," but that it was quite feasible that the Fourth Circuit would affirm the Eastern District and uphold Section 2(a).

If Judge Kimberly Ann Moore's opinion in the Federal Circuit panel decision is any indication of the full bench's views, Ball said, then it was also possible that the full court would find Section 2(a) unconstitutional.

"I think it's going to be really curious," Ball said. "I can see the Federal Circuit having some kind of opinion that in some way overturns 2(a) and I can see the Fourth Circuit coming out the other way just by affirming. Then you would have a split and then you're off to the Supreme Court."

Source Material:

In re Tam

Amicus Brief of the ACLU:
June 19, 2015

Amicus Brief of Pro-Football Inc. (the Redskins):
June 18, 2015

Asian-American Musician Seeks to 'Take Back' Slur.

This story begins in 2006 when Simon Shiao Tam of Portland, Ore., decided to found a dance-rock band made up entirely of Asian-American musicians.

Tam chose the name "the Slants," seeking to "reclaim" the term, which has been used as a slur for persons of East Asian background.

In 2010, Tam filed an application with the PTO for a federal trademark registration on the name, but it was refused after the Trademark Trial and Appeal board found that "slants" was disparaging under Section 2(a) .

Section 2(a) states that the PTO shall refuse registration of a term that

> 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.

In April, a three-judge panel of the Federal Circuit affirmed the TTAB's opinion .

Moore filed a separate opinion stating that Section 2(a) "severely burdens" protected commercial speech.

Soon after that decision was issued, the full Federal Circuit vacated the panel's position and decided to take up the matter en banc.

Same Issue Arises in Redskins Case.

The question of whether Section 2(a) violates the constitution has also come up in the Redskins case, before the Fourth Circuit .

The U.S. District Court for the Eastern District of Virginia ruled that the term "Redskins" was disparaging to a significant component of Native Americans and thus ordered the cancellation of six trademark registrations that the football team had obtained from 1967 to 1990.

The Redskins--represented by the corporate entity Pro-Football Inc.--filed an amicus brief in the Tam matter supporting Tam's and the ACLU's arguments regarding the constitutionality of Section 2(a).

By Anandashankar Mazumdar

To contact the reporter on this story: Anandashankar Mazumdar in Washington at amazumdar@bna.com

To contact the editor responsible for this story: Tony Dutra in Washington at adutra@bna.com

---