

Supreme Court Decides That the First Amendment Trumps the Denial of Protection for “Disparaging” Trademarks

Article

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On Monday, June 19, 2017, the United States Supreme Court issued a decision in the case of *Matal vs. Tam* in which it concluded that the government may not refuse to register a trademark that is potentially offensive to an individual or group of individuals. Just as the First Amendment protects offensive speech, the First Amendment’s protection now extends to trademarks that may likewise be offensive to some individuals or groups.

While this is a significant “free-speech” decision, the most direct and intended impact is to that part of United States Trademark Law relating to the “disparagement” clause – a clause that until now has allowed the United States Patent and Trademark Office (USPTO) to refuse registration, or to even retroactively cancel existing registrations, on the notion that the trademark is “disparaging.” The Court held that the disparagement clause “offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend.” Justice Kennedy pointedly stated that “[t]o permit viewpoint discrimination in this context [i.e., in the review of trademark registration applications] is to permit Government censorship.”

This decision is likely to result in a reversal of a lower court decision that allowed the USPTO to cancel the registered marks of the Washington Redskins in 2014 on the basis that the long-used name of that football team was disparaging to Native Americans or American Indians (those terms being controversial as well). Other fallout can be expected in the wake of this most recent decision by the Court.

From a business perspective, you may wish to avoid disparaging trademarks and service marks despite this ruling. While the USPTO may not bar registration of your trademark or service mark, you should take the long view in assessing your customer base to make sure that you are not creating unnecessary controversy that could drive buyers and customers away and unwittingly damage your business. Choose your trademarks carefully but if you do choose a disparaging name, know that your free-speech is likely to be protected.

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