

Wiley Rein Helps Secure First Amendment Win Striking Down Ban on Registering 'Disparaging' Trademarks

RULING HAS IMPLICATIONS FOR SEPARATE APPEAL OVER REDSKINS MARK

December 22, 2015

Today, Wiley Rein LLP partner Megan L. Brown and a team of appellate and trademark attorneys helped secure a significant victory in a major *en banc* case striking down the Lanham Act's bar on registering "disparaging" trademarks as inconsistent with the First Amendment. The decision in the case, *In re Tam*, by the U.S. Court of Appeals for the Federal Circuit is a major development in First Amendment law.

The firm had filed an *amicus* brief on behalf of The Rutherford Institute and the Cato Institute, arguing that "The Lanham Act's disparagement bar, and its application by the government, openly require the government to discriminate" against speech some might find offensive, and so "cannot co-exist with the First Amendment." The *amicus* brief described the Lanham Act's bar as akin to a "heckler's veto" and argued that the government must meet strict scrutiny. Citing numerous examples of other arguably offensive marks registered, *amici* urged the Federal Circuit to get the government out of the business of policing offense.

The Federal Circuit agreed, holding that "[t]he government cannot refuse to register disparaging marks because it disapproves of the expressive messages conveyed by the marks." Because "[t]he government regulation at issue amounts to viewpoint discrimination," the court continued, "under the strict scrutiny review appropriate for government regulation of message or viewpoint, we conclude that the disparagement proscription of § 2(a) is unconstitutional." The court

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found many of the government's arguments were too broad and would have empowered the government improperly to intrude into private expressive activities. The decision was far from unanimous. Two judges would have gone farther and found the law impermissibly vague, while several others dissented, arguing among other things that the speech at issue here is lower-value and can be restricted by the government to avoid having the government even implicitly support the messages conveyed.

The case stems from a challenge brought by an Asian-American rock band called "The Slants," which was denied trademark registration after the U.S. Patent and Trademark Office found the trademark disparaging to Asians. A three-judge panel of the Federal Circuit affirmed the decision. But then the entire Federal Circuit—without being asked—decided to hear the case and to consider whether Section 2(a) violates the First Amendment.

Today's decision is significant because it will have implications for a related challenge to Section 2(a) of the Lanham Act, pending before the Fourth Circuit in *Pro-Football, Inc. v. Blackhorse*, a case challenging the cancellation of trademarks used by the Washington Redskins football team. The district court in that case tracked much of the reasoning of the now-vacated panel decision in *In re Tam*. It also hewed closely to the Supreme Court of the United States' recent decision in *Walker v. Texas Division, Sons of Confederate Veterans*, concluding that Section 2(a) does not implicate the First Amendment and that trademark registration is government speech. Wiley Rein attorneys filed an *amicus brief* in *Pro-Football*, raising many of the same arguments the Federal Circuit has now endorsed. The Fourth Circuit case remains pending, with oral argument yet to occur.

Ms. Brown is counsel of record to The Rutherford Institute and the Cato Institute. Also on brief were Wiley Rein partners Joshua S. Turner, and Christopher Kelly, of counsel Jennifer L. Elgin, and associate Dwayne D. Sam.