

“Hot Topics” in Intellectual Property

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The Slants Case and the Trademark Protection Debate

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A January 2017 release from Simon Tam's dance rock group The Slants is called "The Band Who Must Not Be Named" — and for good reason.

Despite making music for more than a decade, the world's first all Asian-American dance rock band had been unable to get its name registered as a federal trademark. The U.S. Patent and Trademark Office (PTO) had rejected Tam's trademark applications on the grounds that "Slants" is a disparaging term under the Trademark Act's 2(a) section. So in January of 2017, The Slants took their case to the U.S. Supreme Court.

The issue partly involved the First Amendment right of free speech. But it also centered on the real meaning of section 2(a) of the Trademark Act (also known as the Lanham Act), which bars trademarks if the word or mark consists of “immoral, deceptive, or scandalous matter; or matter which may disparage persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”

During oral arguments, Justice Ruth Bader Ginsburg asked, "Does it not count at all that everyone knows that The Slants are using this term not at all to disparage, but simply to describe? It takes the sting out of the word."

In response, the representative from the Trademark Office acknowledged that “Mr. Tam's sincere intent appeared to be to reclaim the word, to use it as a symbol of Asian-American pride rather than to use it as a slur.” However, he added, there is also “a lot of evidence in the form of Internet commentary that many Asian-Americans, even those who recognized that this was Mr. Tam's intent, still found the use of the word as a band name offensive.”

Closely watching this case were the owners, players, and fans of the Washington Redskins NFL football team. Team owner Daniel Snyder's effort to keep six trademark registrations that were cancelled by the Trademark Office in 2014 hinged on how the Supreme Court ruled in the Slants case. At the time, the Redskins' own appeal was still pending in federal court.

To be sure, Tam and his fellow band members didn't like comparing their case to that of the Redskins — a name that the rock group's website said represents "a long history of oppression." But at their core, both of their cases spoke to the subjective nature of trademarks.

Consider, for example, that while denying trademarks for The Slants and the Redskins, the government has approved hundreds of other arguably “immoral, scandalous, or disparaging” names — including Yellowman, Retardipedia, Crippled Old Biker Bastards, and Boobs as Beer Holders.

Besides, said The Slants' lawyers, Tam chose that name as a way of regaining respect for Asian-Americans. "Simon Tam is not a bigot," they noted in court papers. "He is fighting bigotry with the time-honored technique of seizing the bigots' own language."

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Their cause was endorsed in friend-of-the-court briefs from 20 other groups, ranging from the American Civil Liberties Union to the U.S. Chamber of Commerce. One brief was filed by San Francisco Dykes on Bikes, a group of motorcycle-riding lesbians whose name won federal registration but whose logo did not. According to the brief filed by Dykes on Bikes, the Trademark Office has stood by its rejection “despite the fact that not one lesbian has ever raised any objection to registration of 'Dykes on Bikes.’”

On the other hand, the Supreme Court also received briefs from some minority groups who agreed with the government's position that The Slants should not receive a trademark.

In June of 2017, the Supreme Court issued a unanimous, landmark ruling in *Matal v. Tam* siding with The Slants. Justice Samuel A. Alito, Jr. held that Section 2(a) of the Lanham Act violated “a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend.”

The Supreme Court’s ruling has had a substantial impact on how the First Amendment has been applied in subsequent trademark cases. In January of 2018, The Washington Redskins won their dispute when the U.S. Court of Appeals for the Fourth Circuit vacated decisions that had canceled the team’s federal trademark registrations.