

**THE MASCOT MANIFESTO: CHALLENGING THE
CONSTITUTIONALITY OF SECTION 2(A) OF THE
LANHAM ACT IN A HEIGHTENED ERA OF POLITICAL
CORRECTNESS**

ZACHARY S. O'DRISCOLL*

“If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.”¹

I. INTRODUCTION

When Simon Shiao Tam set out to register the trademark *The Slants* for his Asian-American rock band, he had no idea he would be uprooting the laws of intellectual property and its relationship with the First Amendment.²

Since the inception of the Lanham Act,³ a federal trademark statute, applicants have been denied from federally registering trademarks that are disparaging, scandalous, or immoral.⁴ Notably, the authority to reject a potentially disparaging trademark from being registered—unlike an immoral or scandalous trademark—rests on the subjective opinion of a single examining attorney at the United States Patent and Trademark Office (PTO).⁵ A trademark identified as “disparaging” by one examining

Copyright © 2016, Zachary S. O’Driscoll.

* J.D. candidate, May 2017, Capital University Law School; Bachelor of Science in Criminal Justice, *cum laude*, 2014, Heidelberg University. I am very grateful and deeply indebted to Professor Susan Looper-Friedman of Capital University Law School, Articles Editor Alexis Preskar, my fiancée Carri Melcher, and my mother Janet O’Driscoll whose advice, guidance, patience, and support made this work possible.

¹ *Texas v. Johnson*, 491 U.S. 397, 414 (1989).

² *See generally In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015).

³ 15 U.S.C. §§ 1051–1141 (2012).

⁴ Both the prohibitions on “scandalous” and “immoral” trademarks first appeared in the Act of 1905. Act of Feb. 20, 1905, ch. 592, § 5(a), 33 Stat. 724, 725. The “disparagement” provision, on the other hand, originated in the Lanham Act of 1946. The Lanham (Trademark) Act of 1946, Pub. L. No. 78-489, §2, 60 Stat. 427, 428 (codified at 15 U.S.C. § 1052(a) (2012)).

⁵ *Tam*, 808 F.3d at 1331 (“A single examiner, with no input from her supervisor, can reject a [trade]mark as disparaging by determining that it would be disparaging to a substantial composite of the referenced group.”). On the other hand, a trademark that may be “scandalous” or “immoral” requires an examining attorney at the PTO to consult a supervisor. *Compare* Trademark Manual of Examining Procedure (TMEP) § 1203.03 (Oct. 2016) (no mention whatsoever of an examining attorney consulting a supervisor for a

(continued)

attorney, and thus, rejected for registration, may not be considered disparaging by another.⁶ This result has muddled the PTO with regular inconsistencies when approving an application, and thus, has left the federal trademark registration program packed with imperfection.⁷

To make matters worse for the PTO, the perception of what may be disparaging is ever changing with society's growing apprehension to be politically correct in every possible instance.⁸ While it is undisputed that the original intent of political correctness may have been kind and compassionate speech, it has become an increasingly controversial topic because, the truth is, societal attitudes are always subject to change.⁹

trademark that may be disparaging), with TMEP § 1203.01 (Oct. 2016) ("To ensure consistency in examination with respect to immoral or scandalous matter, when an examining attorney believes, for whatever reason, that a mark may be considered to comprise such matter, the examining attorney must consult with his or her supervisor.").

⁶ See *Tam*, 808 F.3d at 1342 n.6. The use of the word disparage "is going to cause a great deal of difficulty in the Patent Office [I]t is always going to be just a matter of the personal opinion of the [examining attorneys] as to whether they think it is disparaging." *Hearings on H.R. 4744 Before the Subcomm. on Trade-Marks of the H. Comm. on Patents*, 76th Cong. 21 (1939) (statement of Leslie Frazer, Assistant Comm'r of Patents). See also Gabe Rottman, *Redskins Wrong, But Legal*, ACLU (Dec. 10, 2013, 10:41 AM), <https://www.aclu.org/blog/redskins-wrong-legal> [<https://perma.cc/2B8N-44UX>] ("At the end of the day . . . the ultimate determination is inherently subjective and the TTAB and reviewing courts have a significant amount of discretion in deciding what's disparaging and what's not.").

⁷ See, e.g., Megan M. Carpenter & Kathryn T. Murphy, *Calling Bulls**t on the Lanham Act: The 2(a) Bar for Immoral, Scandalous, and Disparaging Marks*, 49 U. LOUISVILLE L. REV. 465, 473–78 (2010) (discussing inconsistent examining-attorney decisions in applying Section 2(a) to trademarks).

⁸ "Political correctness" is popularly defined two ways. First, it is "[t]he inclination to avoid language and practices that might offend anyone's political sensibilities, especially in social, racial, or sexual matters." *Political Correctness*, BLACK'S LAW DICTIONARY (10th ed. 2014). Likewise, it has also been defined as "[a]n instance in which a person conforms to this inclination; euphemistic language, innocuous behavior, and nonjudgmental attitudes that are self-consciously adopted so as not to offend or insult anyone." *Id.* For specific instances of the political correctness controversy, see Cailey Gleeson et al., *Is America Becoming Too Politically Correct?*, HUFFINGTON POST (Mar. 4, 2016, 5:10 PM), http://www.huffingtonpost.com/the-mash/is-america-becoming-too-p_b_9387060.html [<https://perma.cc/V8RF-9YSW>]; Gary Shapiro, *Political Correctness Is Hurting America*, TOWNHALL (Feb. 16, 2012, 1:15 PM), http://townhall.com/columnists/garyshapiro/2012/02/16/political_correctness_is_hurting_america/page/full [<https://perma.cc/ZH9C-BYK3>]; Michael Snyder, *20 Outrageous Examples that Show how Political Correctness Is Taking over America*, TRUTH (Dec. 13, 2012), <http://thetruthwins.com/archives/20-outrageous-examples-that-show-how-political-correctness-is-taking-over-america> [<https://perma.cc/4HJR-3JFU>].

⁹ See Ben Carson, *The Redskins Name Game*, NAT'L REV. (June 25, 2014), <http://www.nationalreview.com/node/396897/print> [<https://perma.cc/4M3T-Q344>]; SANDRA E. LAMB, WRITING WELL FOR BUSINESS SUCCESS 127 (2014) ("The notion of political

(continued)

Today, Americans continue to misconstrue their constitutional liberties with a “right” to never be offended and, consequently, every word, thought, phrase, or behavior has to be scrutinized with a fine-toothed comb.¹⁰ This is especially true for trademark owners as they are left attempting to solve an impossible conundrum in order to register their trademark with the PTO—not offending *somebody*, *somehow*, *somewhere*.

Nevertheless, the issues surrounding what is deemed “disparaging” by an examining attorney at the PTO is not the central focus of this Note. Rather, this Note details, in part, why the Lanham Act—for purposes of a trademark’s federal registration—directly competes for priority with the fundamental freedom of speech protected under the First Amendment.¹¹ The First Amendment unequivocally protects the freedom of speech from being infringed upon by federal legislation.¹² Yet, there is nothing simplistic about applying trademark law as it pertains to the First Amendment. As appropriately explained by Professor Ned Snow from the University of South Carolina School of Law, “Analyzing the Lanham Act’s anti-disparagement provision under the First Amendment raises particularly difficult questions, both because speech law is so complex and

correctness declares certain topics, certain expressions, even certain gestures, off-limits. What began as a crusade for civility has soured into a cause of conflict and even censorship.”) (discussing George H. W. Bush’s commencement speech at the University of Michigan in May 1991).

¹⁰ See Carson, *supra* note 9; BJ Gallagher, *The Problem with Political Correctness*, HUFFINGTON POST (Apr. 27, 2013), http://www.huffingtonpost.com/bj-gallagher/the-problem-political-correctness_b_2746663.html [https://perma.cc/3N34-N95L].

¹¹ See *infra* Parts III, IV.

¹² JEROME A. BARRON ET AL., CONSTITUTIONAL LAW: PRINCIPALS AND POLICY CASES AND MATERIALS 985 (2012). The First Amendment of the United States Constitution provides: “Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances.” U.S. CONST. amend. I. It is important to note, however, that the First Amendment has historically recognized several well-defined and limited classes of speech where the constitutional freedoms have been restricted. For example, the classes of speech that traditionally have been excluded from First Amendment protections include: true threats, fighting words, obscenity, child pornography, incitement, and defamation. See *Virginia v. Black*, 538 U.S. 343, 352–63 (2003) (excluding true threats from First Amendment protections); *Chaplinsky v. New Hampshire*, 315 U.S. 568, 574 (1942) (excluding fighting words); *Miller v. California*, 413 U.S. 15, 23–24 (1975) (excluding obscenity); *New York v. Ferber*, 458 U.S. 747, 764–66 (1982) (excluding child pornography); *Brandenburg v. Ohio*, 395 U.S. 444, 448 (1969) (excluding incitement); *N.Y. Times v. Sullivan*, 376 U.S. 254, 279–83 (1964) (excluding defamation). Thus, because “disparaging” speech does not fall into one of these well-defined and limited classes of speech, it should receive the full protections of the First Amendment.

because trademark law is so nuanced.”¹³ For example, this issue comes to light when determining the level of constitutional protection afforded to trademarks. Whereas trademarks have typically been classified as “commercial speech” and are subject to the constitutional test of intermediate scrutiny, it is often inherently difficult to differentiate “commercial speech” from “noncommercial speech,” which receives full constitutional protections under strict scrutiny.¹⁴ But, without a Supreme Court decision dispositive on the interplay between trademark law and the First Amendment,¹⁵ U.S. courts have taken it upon themselves to apply the freedom of speech principles to the expressive nature of trademarks.¹⁶

When *The Slants* was rejected for its disparaging connotation regarding the slanted eyes of Asians, Tam’s dispute over the trademark’s denial triggered an all-out First Amendment challenge.¹⁷ In its landmark decision, the Federal Circuit invalidated the portion of the Lanham Act—the infamous Section 2(a)—that authorizes a trademark examiner at the PTO to reject a trademark that may be disparaging to others.¹⁸ As this case is now pending review before the Supreme Court of the United States at the time of this writing,¹⁹ the Federal Circuit’s decision, if adopted, has the potential to directly impact the future of trademark litigation in the United States. *The Slants* had successfully challenged the Lanham Act on free speech principles under the First Amendment, and have now paved a legal pathway for similar trademarks hanging in the balance.

Simon Shiao Tam was not the first trademark owner to challenge controversial trademarks, however. For nearly twenty years, Pro-Football,

¹³ Ned Snow, *Free Speech & Disparaging Trademarks*, 57 B.C. L. REV. 1639, 1640 (2016).

¹⁴ See, e.g., Leonardo Machado Pontes, *Trademark and Freedom of Speech: A Comparison Between the U.S. and the EU System in the Awakening of Johan Deckmyn v. Helena Vandersteen*, WORLD INTELL. PROP. ORG. 1, 3–13 (2015), http://www.wipo.int/edocs/mdocs/mdocs/en/wipo_ip/ge_15/wipo_ip/ge_15_t3.pdf [<https://perma.cc/AV3M-SRV9>].

¹⁵ *Id.* at 13.

¹⁶ *Id.*

¹⁷ *In re Tam*, 808 F.3d 1321, 1331–58 (Fed. Cir. 2015).

¹⁸ *Id.* at 1358 (“We hold that the disparagement provision of § 2(a) is unconstitutional because it violates the First Amendment.”). See also *id.* at 1334:

Strict scrutiny is used to review any governmental regulation that burdens private speech based on disapproval of the message conveyed. Section 2(a), which denies important legal rights to private speech on that basis, is such a regulation. It is therefore subject to strict scrutiny. It is undisputed that it cannot survive strict scrutiny.

¹⁹ *Lee v. Tam*, No. 15-1293, 2016 WL 1587871 (U.S. Sept. 29, 2016).

Inc.—the owner of the Washington Redskins trademarks—has been fighting a similar battle in order to keep its own federally registered trademarks alive.²⁰ These trademarks, much like *The Slants*, had been denied registration by the PTO for being “disparaging” to Native Americans.²¹ But, as Pro-Football, Inc. finds itself, yet again, at the heart of the Lanham Act controversy, and pending the Supreme Court’s decision in *The Slants* case, the Federal Circuit’s once persuasive authority is now more critical than ever in directly affecting the future litigation of the *Redskins* trademarks. The Federal Circuit had just barely scratched the surface on the judicial complexity of analyzing the free speech principles of trademarks when it correctly decided that Section 2(a) of the Lanham Act is unconstitutional and an encroachment on the freedom of speech.

It is critical to understand, however, that this Note is not written to address whether the terms *Redskins*, *Slants* or other “controversial” trademarks are offensive or disparaging forms of speech.²² Rather, this Note is written to highlight that Section 2(a) of the Lanham Act directly conflicts with the free speech principles protected under the First Amendment. The Federal Circuit was the first to make this kind of determination,²³ and therefore, this Note will focus on the litigation surrounding the trademarks of the Washington Redskins as it applies to the Federal Circuit’s decision.²⁴

First, this Note will illustrate a brief history of the Washington Redskins Football Club, and the registered trademarks associated with the

²⁰ With respect to the *Harjo* proceedings, see *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999); *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96 (D.D.C. 2003); *Pro-Football, Inc. v. Harjo*, 415 F.3d 44 (D.C. Cir. 2005); *Pro-Football, Inc. v. Harjo*, 567 F. Supp. 2d 46 (D.D.C. 2008); *Pro-Football, Inc. v. Harjo*, 565 F.3d 880 (D.C. Cir. 2009). Likewise, with respect to the *Blackhorse* proceedings, see *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080 (T.T.A.B. 2014) and *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015), *appeal docketed*, No. 15-1874 (4th Cir. Aug. 6, 2015).

²¹ See, e.g., *Blackhorse*, 111 U.S.P.Q.2d at 1082.

²² As the Federal Circuit perfectly explained in *Tam*, “[N]othing we say should be viewed as an endorsement of the mark at issue Whatever our personal feelings about the mark at issue here, or other disparaging marks, the First Amendment forbids government regulators to deny registration because they find the speech likely to offend others.” *Tam*, 808 F.3d at 1357–58; but see Barbara Munson, *Indian Logo Themes: Why They Are Racist!*, <http://www.indians.org/welker/mascot1.htm> [<https://perma.cc/WR35-SEJR>]. Barbara Munson of the Oneida Nation declared, “‘Indian’ logos and nicknames create, support and maintain stereotypes of a race of people. When such cultural abuse is supported by one or many of society’s institutions, it constitutes institutional racism[,]” and “[t]he logos, along with other societal abuses and stereotypes separate, marginalize, confuse, intimidate and harm Native American[s]”

²³ See *Tam*, 808 F.3d at 1334–58.

²⁴ See *infra* Sections II.B, II.C.

franchise.²⁵ Second, this Note will lay the foundation for the discussion to follow with a thorough litigation history of the two major cases involving the Washington Redskins and their controversial trademarks.²⁶ Third, this Note will elaborate on the recent developments of *The Slants* decision.²⁷ More specifically, it will address the particulars of the Federal Circuit's landmark decision in finding Section 2(a) of the Lanham Act unconstitutional.²⁸ Lastly, this Note will articulate why the Federal Circuit's holding was correctly determined, and why the Supreme Court of the United States should adopt its analysis in regards to future trademark disputes, like the Washington Redskins, as they relate to Section 2(a) of the Lanham Act.²⁹

II. BACKGROUND

A. *Huddle Up—The Washington Redskins*

The Washington Redskins football team is one of the most storied sports franchises in the United States.³⁰ Not only has the name *Redskins* been closely identified with the Washington, D.C. professional football franchise for more than eighty years, but it has also held federal trademark registrations for nearly five decades.³¹ Originally dubbed *The Braves* as a Boston franchise back in 1932, the team was rebranded the *Boston Redskins* so as to avoid confusion with the *Boston Braves* baseball club.³² At the time the *Redskins* name was selected, four players self-identified as Native Americans, in addition to their head coach, William "Lone Star"

²⁵ See *infra* Section II.A.

²⁶ See *infra* Sections II.B, II.C.

²⁷ See *infra* Section III.A.

²⁸ See *infra* Section III.B.

²⁹ See *infra* Part IV.

³⁰ Complaint ¶ 2, Pro-Football, Inc. v. Blackhorse, 112 F. Supp. 3d 439 (E.D. Va. 2015) (No. 1:14-cv-01043-GBL-IDD) [hereinafter Complaint].

³¹ *Id.*

³² *History by Decades*, REDSKINS, <http://www.redskins.com/team/history/history-by-decades.html> [https://perma.cc/QGG3-U8HS]. The Boston Braves baseball club spent over seventy years in Boston before eventually relocating to Milwaukee. *The Story of the Braves*, BRAVES http://atlanta.braves.mlb.com/atl/history/story_of_the_braves.jsp [https://perma.cc/9HK6-GR6N]. The move was hinged on losing too much of its fan support to the Boston Red Sox, an exceptionally successful and popular American League team. *Id.* After playing in Milwaukee for nearly a decade, the team again relocated to Atlanta where it has made its permanent home. *Id.*; see also Kenneth R. Fenster, *Atlanta Braves*, NEW GA. ENCYCLOPEDIA (Aug. 9, 2004), <http://www.georgiaencyclopedia.org/articles/sports-outdoor-recreation/atlanta-braves> [https://perma.cc/UM87-ZVV9].

Dietz.³³ Ultimately, in 1937, the franchise relocated to Washington, D.C. after the National Football League approved the team's transfer.³⁴ Unbeknownst to the franchise, the Washington Redskins would soon begin their ill-fated journey plagued with controversy over their team name, logo, and trademarks.

Today, Pro-Football, Inc. owns the Washington Redskins Football Club as well as the six registered trademarks associated with the franchise's name of *Redskins*.³⁵ A registered trademark bestows upon its owner several, particular federal benefits that are unavailable under the common law in the absence of federal registration. These benefits are numerous and include: the right to sue for infringement in federal court;³⁶ the ability to recover profits, damages, costs, and, in the case of a willful infringement, treble damages;³⁷ the ability to recover reasonable attorney fees in exceptional cases;³⁸ constructive notice of a trademark's

³³ See Complaint, *supra* note 30, ¶ 34. However, in nearly a half-century since the death of Coach Dietz, controversy still surrounds his "true" heritage. Compare Richard Leiby, *The Legend of Lone Star Dietz: Redskins Namesake, Coach—and Possible Imposter?*, WASH. POST (Nov. 6, 2013), https://www.washingtonpost.com/lifestyle/style/the-legend-of-lone-star-dietz-redskins-namesake-coach--and-possible-imposter/2013/11/06/a1358a76-466b-11e3-bf0c-cebf37c6f484_story.html [https://perma.cc/BWW3-82QR], with Travis Waldron, *The 81-Year-Old Newspaper Article that Destroys the Redskins' Justification for Their Name*, THINKPROGRESS (May 30, 2014), <http://thinkprogress.org/sports/2014/05/30/3443168/redskins-founder-i-didnt-name-team-to-honor-native-americans> [https://perma.cc/2XLM-YKUN]. Without any conclusive evidence to support one finding over the other, this Note declines to address the merits of each position.

³⁴ *History by Decades*, *supra* note 32.

³⁵ See Complaint, *supra* note 30, ¶ 2; Brief of Appellant at 2, *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015) (No. 15-1874), *appeal docketed*, No. 15-1874 (4th Cir. Aug. 6, 2015). These trademarks include: (1) Registration No. 0836122 (the trademark THE REDSKINS in stylized form, for "entertainment services," namely, football exhibitions rendered in stadia and through the media of radio and television broadcasts); (2) Registration No. 0978824 (the trademark WASHINGTON REDSKINS in typed drawing form, for "entertainment services," namely, presentations of professional football contests); (3) Registration No. 0986668 (the trademark WASHINGTON REDSKINS and design, for "entertainment services," namely, presentations of professional football contests); (4) Registration No. 0987127 (the trademark THE REDSKINS for "entertainment services," namely, presentations of professional football contests); (5) Registration No. 1085092 (the trademark REDSKINS, in drawing form, for "entertainment services," namely, presentations of professional football contests); and (6) Registration No. 1606810 (the mark REDSKINETTES, in typed drawing form, for "entertainment services," namely cheerleaders who perform dance routines at professional football games and exhibitions and other personal appearances). *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080, 1083 (T.T.A.B. 2014).

³⁶ 15 U.S.C. § 1121 (2012).

³⁷ 15 U.S.C. § 1117 (2012).

³⁸ *Id.*

ownership;³⁹ prima facie evidence of the trademark's validity;⁴⁰ incontestability status;⁴¹ the right to use the federal registration symbol ®;⁴² the right to assistance from the U.S. Customs and Border Protection to block the importation of goods bearing an infringing or counterfeit trademark;⁴³ the right to exclusive nationwide use as opposed to a limited geographic area;⁴⁴ and serves as a complete defense to claims of trademark dilution under the common law or laws of a state.⁴⁵ Thus, the benefits of these federal rights, both individually and as a whole, are significant to a trademark owner.⁴⁶

On September 26, 1967, the PTO registered the first of the *Redskins* trademarks.⁴⁷ Thereafter, between 1974 and 1990, the PTO registered an additional five *Redskins* trademarks associated with the Washington franchise.⁴⁸ This all changed in 1999, however, when the Trademark Trial and Appeal Board (TTAB) cancelled each of the six registrations in the first of a series of challenges aimed at the eradicating the *Redskins* trademarks.⁴⁹ Since 1870, not one of the more than three million federally registered trademarks has ever been retroactively cancelled.⁵⁰ Rejecting a trademark at the outset of its initial registration is one thing; cancelling a trademark after over fifty years of its issuance is a whole different ballgame. This is especially true when a trademark owner, just like Pro-Football, Inc., has invested millions of dollars into protecting its brand identity that consumers, the public, and sports fans everywhere have come to rely on as a brand identifier.⁵¹ But, given the Lanham Act's prohibition on registering disparaging trademarks under Section 2(a) and the recent

³⁹ 15 U.S.C. § 1072 (2012).

⁴⁰ 15 U.S.C. § 1057(b) (2012).

⁴¹ 15 U.S.C. §§ 1065, 1115 (2012).

⁴² 15 U.S.C. § 1111 (2012).

⁴³ 15 U.S.C. § 1124 (2012); 19 U.S.C. § 1526 (2012).

⁴⁴ 15 U.S.C. §§ 1057(b), 1115 (2012).

⁴⁵ 15 U.S.C. § 1125(c)(6) (2012).

⁴⁶ See, e.g., *In re Tam*, 808 F.3d 1321, 1328 (Fed. Cir. 2015).

⁴⁷ Complaint, *supra* note 30, ¶ 21; *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 105 (D.D.C. 2003); *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 447 (E.D. Va. 2015); Brief of Appellant, *supra* note 35, at 2, 8.

⁴⁸ Complaint, *supra* note 30, ¶ 21; *Blackhorse*, 112 F. Supp. 3d at 447; Brief of Appellant, *supra* note 35, at 2, 8.

⁴⁹ See generally *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999); *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080 (T.T.A.B. 2014).

⁵⁰ Brief of Appellant, *supra* note 35, at 2. See also Lindsay Gibbs, *Washington Cites Long List of Other Offensive Trademarks to Defends Its Offensive Trademark*, THINKPROGRESS (Nov. 3, 2015), <http://thinkprogress.org/sports/2015/11/03/3718864/washington-appeal-trademark-offensive> [https://perma.cc/85XX-P45D].

⁵¹ *Tam*, 808 F.3d 1321, 1329–30; Complaint, *supra* note 30, ¶ 21.

spike of concern over political correctness, the authorization of these trademarks has sparked intense litigation spanning more than two decades.⁵²

B. Three and Out—The Harjo Litigation

For over twenty-five years, not a single individual sought to cancel any of Pro-Football, Inc.'s registrations.⁵³ Then in 1992, Susan Harjo, and six other Native Americans,⁵⁴ brought a petition to cancel the *Redskins* trademarks on the grounds of disparagement, claiming that the marks may bring Native Americans into “contempt” or “disrepute” in violation of Section 2(a) of the Lanham Act.⁵⁵ More specifically, this pertinent portion of the Lanham Act provides:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) 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 disrepute⁵⁶

Ultimately, in April 1999, the TTAB ordered the cancellation of the six *Redskins* trademarks because they were “disparaging” to Native Americans.⁵⁷ But on appeal to the United States District Court for the District of Columbia, the court reversed the TTAB.⁵⁸ First, the court held that the TTAB’s finding that a “substantial composite of the general public finds the word ‘[R]edskin(s)’ to be a derogatory term of reference for

⁵² See *supra* note 20 and accompanying text.

⁵³ Brief of Appellant, *supra* note 35, at 8.

⁵⁴ *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1706, 1709 (T.T.A.B. 1999). In addition to Susan Harjo, the other named plaintiffs included: Raymond P. Apodaca, Vine Deloria, Jr., Norbert S. Hill, Jr., Mateo Romero, William A. Means, and Manley A. Begay, Jr. *Id.* Each of the petitioners seeking to cancel the *Redskins* trademarks was a member of an Indian tribe that is recognized under federal law. *Id.* at 1708. Likewise, each petitioner was an active representative of his or her tribal community as well as national organizations aimed at advancing issues pertaining to Native Americans. *Id.* at 1709.

⁵⁵ 15 U.S.C. § 1052(a) (2012).

⁵⁶ *Id.* (emphasis added).

⁵⁷ *Harjo*, 50 U.S.P.Q.2d at 1749.

⁵⁸ *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 99, 145 (D.D.C. 2003).

Native Americans” was unsupported by the evidence.⁵⁹ Second, the court held that the doctrine of laches, a defense against those who fail to bring their cause of action in a timely manner, precluded consideration of the case in the first place.⁶⁰

Following the unfavorable opinion by the district court, the seven Native Americans appealed.⁶¹ This time, however, Mateo Romero, rather than Susan Harjo, was at the forefront of the appeal.⁶² The appellants argued that the district court erred in starting the clock for assessing the laches defense in 1967—the year of the first trademark’s registration—for each of the seven Native Americans, including Mateo Romero.⁶³ Because Romero was only a year old at the time of the registration, and had not yet attained the age of majority to bring a cancellation claim on his own, the appellants argued the laches defense was improperly imputed to Romero.⁶⁴ In light of that argument, the circuit court agreed with the appellant’s contention.⁶⁵ In holding that the lower court “should have measured both his delay and the resulting prejudice to Pro-Football based on the period between his attainment of majority and the filing of the 1992 cancellation petition,” the case was remanded to the district court for further evaluation.⁶⁶

On remand, the district court concluded Mateo Romero’s delay of almost eight years was also untimely and “unusually long by any standard.”⁶⁷ “[I]n light of his actual knowledge of all of the trademarks before he reached [the age of] majority . . . and the fact that he has no

⁵⁹ *Id.* at 128, 129 (quoting *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1743–44 (T.T.A.B. 1999)).

⁶⁰ *Id.* at 139. With respect to the laches defense, District Judge Kollar-Kotelly exclaimed: “The notion that Pro-Football’s trademarks would be subject to attack at any point in time would seriously undermine the entire policy of seeking trademark protection in the first place.” *Id.* “The doctrine of laches bars relief to those who delay the assertion of their claims for an unreasonable time. Laches is founded on the notion that equity aids the vigilant and not those who slumber on their rights.” *Id.* at 136. Though the common law definition of laches did not “cleanly apply” in the context of a Section 2(a) petition for the cancellation of a trademark, the district court noted it could be “easily modified” in light of this case. *Id.* at 136–37. Therefore, in successfully arguing for the laches defense, Pro-Football, Inc. had shown that the seven Native Americans’ delay in bringing the cancellation proceeding was unreasonable (through a finding of substantial delay and notice) and that prejudice to Pro-Football, Inc. had resulted from such delay. *Id.* at 139.

⁶¹ *Pro-Football, Inc. v. Harjo*, 415 F.3d 44, 46 (D.C. Cir. 2005).

⁶² *See id.* at 48.

⁶³ *Id.*

⁶⁴ *Id.*

⁶⁵ *Id.* at 49.

⁶⁶ *Id.* at 50.

⁶⁷ *Pro-Football, Inc. v. Harjo*, 567 F. Supp. 2d 46, 53–54 (D.D.C. 2008).

reasonable excuse for his delay in taking action[.]” the court found “Pro-Football, Inc. ha[d] established a lack of diligence on Defendant Romero’s part with respect to pursuing his cancellation petition.”⁶⁸ Again, the case was appealed to the United States Court of Appeals for the District of Columbia Circuit where the district court’s ruling was affirmed.⁶⁹

Following the conclusion of this lengthy legal standoff, the Supreme Court of the United States denied the *Harjo* writ for certiorari officially ending the challenges for cancellation.⁷⁰ After more than a decade, no court had ever addressed the TTAB’s original finding of disparagement on the merits.⁷¹ The Washington Redskins were now leading at half-time, but the game was far from over.

C. Calling an Audible—The Blackhorse Litigation

1. The TTAB Decision

Meanwhile, as *Harjo* was traversing between the courts and awaiting a final decision, five Native Americans—including lead petitioner Amanda Blackhorse—petitioned the TTAB to cancel the same six *Redskins* registrations.⁷² The basis of the *Blackhorse* petition was nearly identical to the one in *Harjo*: the *Redskins* trademarks are “disparaging” to Native Americans in violation of Section 2(a) of the Lanham Act.⁷³ However, these plaintiffs had been carefully chosen in order to circumnavigate the technicality of the laches defense formerly asserted by Pro-Football, Inc. in *Harjo*.⁷⁴ To their credit too, Pro-Football, Inc. was prepared to defend the

⁶⁸ *Id.* at 56.

Defendant Romero unreasonably delayed his bringing of a cancellation petition and that his eight-year delay demonstrates a lack of diligence on his part. The Court further finds that Defendant Romero’s delay has resulted in both trial prejudice and economic prejudice to Pro-Football such, that it would be inequitable to allow Defendant Romero to proceed with his cancellation petition.

Id. at 62.

⁶⁹ Pro-Football, Inc. v. Harjo, 565 F.3d 880, 881 (D.C. Cir. 2009).

⁷⁰ *Id.*, cert denied, 558 U.S. 1025 (2009).

⁷¹ Pro-Football, Inc. v. Blackhorse, 112 F. Supp. 3d 439, 450 (E.D. Va. 2015).

⁷² Blackhorse v. Pro-Football, Inc., 111 U.S.P.Q.2d 1080, 1087 (T.T.A.B. 2014). In addition to Amanda Blackhorse, the other named plaintiffs included: Philip Martin Gover of the Paiute Indian Tribe of Utah, Courtney Tsofogh of the Kiowa Tribe in Oklahoma, Marcus Briggs-Cloud of the Muscogee Nation of Florida, and Jillian Pappan. *Id.*

⁷³ *Id.* at 1082.

⁷⁴ United States Patent and Trademark Office Cancels “Disparaging” REDSKINS Trademark Registrations, JONES DAY (June 2014), <http://www.jonesday.com/united-states->

(continued)

trademarks through twelve affirmative defenses and constitutional challenges under the First and Fifth Amendments.⁷⁵ However, any decision regarding the *Blackhorse* suit was to be temporarily suspended until the conclusion of the *Harjo* litigation, which would not end until 2009.⁷⁶ Thereafter, in early March 2010, the *Blackhorse* proceedings continued.⁷⁷

Without the authority to entertain Pro-Football, Inc.'s constitutional arguments, the TTAB declined to hear these particular assertions.⁷⁸ Instead, the TTAB explained: "For purposes of clarity, our decision is intended to preserve [Pro-Football, Inc.'s] option to argue for application of the relevant defenses on appeal."⁷⁹ Eventually, the TTAB voted yet again, in a 2–1 decision, to cancel the six *Redskins* trademarks. Here, the petitioners had shown, more likely than not, that a "substantial composite" of Native Americans found the term *Redskins* to be disparaging.⁸⁰ As support for its finding of disparagement, the TTAB referred to a 1993 resolution passed by the executive council of the National Congress of American Indians (NCAI), the country's oldest and largest Native American organization.⁸¹

The record establishes that, at a minimum, approximately thirty percent of Native Americans found the term [*Redskins*] used in connection with respondent's services to be disparaging at all times including 1967, 1972, 1974, 1978 and 1990. Section 2(a) prohibits registration of matter that disparages a substantial composite, which need not be a majority, of the referenced group. Thirty percent is without doubt a substantial composite. To determine otherwise means it is acceptable to subject to disparagement 1 out of every 3 individuals, or as in this case approximately 626,095 out of 1,878,285 in 1990.

patent-and-trademark-office-cancels-disparaging-redskins-trademark-registrations-06-24-2014 [<https://perma.cc/AD86-YDKC>].

⁷⁵ See Complaint, *supra* note 30, ¶ 22. Due to the extensive information regarding both of the constitutional arguments, this Note focuses exclusively on the matters closely aligned with the First Amendment.

⁷⁶ *Id.* ¶ 23.

⁷⁷ *Id.* ¶ 27.

⁷⁸ *Id.* ¶ 29. The Trademark Trial and Appeal Board is an administrative agency that lacks the power of an Article III court to hear arguments regarding the United States Constitution. See 15 U.S.C. § 1067(b) (2012).

⁷⁹ *Blackhorse v. Pro Football, Inc.*, Cancellation No. 92046185, 18 (T.T.A.B. 2011).

⁸⁰ *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080, 1111 (T.T.A.B. 2014).

⁸¹ *Id.* at 1091, 1098.

There is nothing in the Trademark Act, which expressly prohibits registration of disparaging terms, or in its legislative history, to permit that level of disparagement of a group and, therefore, we find this showing of thirty percent to be more than substantial.⁸²

Furthermore, the TTAB dismissed Pro-Football, Inc.'s reasserted defense of laches.⁸³ To begin, the TTAB determined Pro-Football, Inc. had failed to show the *Blackhorse* petitioners unreasonably delayed in bringing their petitions of cancellation.⁸⁴ Next, the TTAB held the defense of laches, as a matter of law, could not be applied to a group of plaintiffs concerning a claim of disparagement.⁸⁵ Finally, the TTAB held the equitable defense of laches, as routinely applied to matters like this case, should not be used where there is a broader public policy issue of concern like trademarks that may disparage others.⁸⁶

Administrative Trademark Judge Marc Bergsman, the sole dissenting vote, respectfully disagreed in his eight page opinion.⁸⁷ Judge Bergsman expressed his criticisms with the majority's finding in favor of the petitioners by characterizing it as a "database dump."⁸⁸ Not only had the plaintiffs filed a petition nearly identical to the plaintiffs in *Harjo*, but they also resubmitted most of the same evidence the district court had previously held to be insufficient.⁸⁹ Judge Bergsman then concluded the

⁸² *Id.* at 1111 (emphasis omitted) (citations omitted). In addition to the 1993 resolution of the NCAI, the TTAB looked at dictionary definitions and reference books, the deposition of NCAI Executive Director JoAnn Chase, the Deposition of Harold Martin Gross, and a variety of newspaper articles, reports, official records, and letters. *See, e.g., Finding Disparagement, TTAB Orders Cancellation of Six REDSKINS Trademark Registrations*, PRACTICAL L. (June 20, 2014), <http://us.practicallaw.com/2-571-8905> [<https://perma.cc/ZLS2-4QH8>].

⁸³ *See Blackhorse*, 111 U.S.P.Q.2d at 1112–14.

⁸⁴ *Id.* at 1114.

⁸⁵ *Id.* at 1112. "We hold that laches does not apply to a disparagement claim where the disparagement pertains to a group of which the individual plaintiff or plaintiffs simply comprise one or more members." *Id.*

⁸⁶ *Id.* at 1113.

⁸⁷ *Id.* at 1114–21.

⁸⁸ *Id.* at 1115.

⁸⁹ *Id.*

It is astounding that the petitioners did not submit any evidence regarding the Native American population during the relevant time frame, nor did they introduce any evidence or argument as to what comprises a substantial composite of that population thereby leaving it to the majority to make petitioners' case have some semblance of meaning.

Id.

petitioners presented inadequate evidence to support their claim of disparagement: “By this dissent, I am not suggesting that the term ‘[R]edskins’ was not disparaging in 1967, 1974, 1978, and 1990 (the registration dates at issue). Rather, my conclusion is that the evidence petitioners put forth fails to show that it was.”⁹⁰

Despite the majority’s finding, the TTAB decision, like the one in *Harjo*, was limited to cancelling the *registration* of a federal trademark, not the right to *use* the trademark itself.⁹¹ Because trademarks remain active so long as an appeal is currently pending,⁹² as the *Redskins* case currently is, what first began as a battle over a disparaging trademark would soon evolve into a grudge match over the First Amendment. Pro-Football, Inc. would have to decide whether to return to the line of scrimmage and prep for yet another legal confrontation.

2. *The District Court Review*

After Pro-Football, Inc. decided to appeal, they quickly took up offense and challenged the TTAB’s pronouncement.⁹³ Pursuant to 15 U.S.C. § 1071(b)(1), a dissatisfied party wishing to overturn an adverse TTAB decision may do so by initiating a civil action in district court in place of a Federal Circuit appeal.⁹⁴ However, if the parties reside in multiple districts, the United States District Court for the Eastern District

⁹⁰ *Id.*

⁹¹ *Media Fact Sheet: Trademark Trial and Appeal Board (TTAB) Decision in Blackhorse v. Pro Football, Inc. (TTAB Cancellation No. 92046185)*, U.S. PAT. & TRADEMARK OFF. (June 18, 2014), http://www.uspto.gov/sites/default/files/news/USPTO_Official_Fact_Sheet_on_TTAB_decision_in_Blackhorse_v_Pro_Football_Inc.pdf [<https://perma.cc/6YYL-XZFL>].

⁹² *Id.*

⁹³ *PTO’s Decision to Cancel Football Team’s “Redskins” Marks May Provide only a Symbolic Victory*, SEDGWICK L. (Aug. 2014), <http://www.sedgwicklaw.com/ptos-decision-to-cancel-football-teams-redskins-marks-may-provide-only-a-symbolic-victory-08-07-2014> [<https://perma.cc/5ZXQ-DRKV>].

⁹⁴ 15 U.S.C. § 1071(b)(1) (2012). This rule provides in pertinent part:

Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said United States Court of Appeals for the Federal Circuit, have remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the Director appoints or as provided in subsection (a) of this section.

of Virginia retains exclusive jurisdiction.⁹⁵ Accordingly, on August 14, 2014, Pro-Football, Inc. filed its complaint in the Eastern District of Virginia.⁹⁶

Under the Section 1071(b)(1) action, Pro-Football, Inc. sought a de novo review of the cancellation proceedings.⁹⁷ In addition to challenging the TTAB's finding of disparagement, Pro-Football, Inc.'s complaint asserted, among additional claims, that Section 2(a) of the Lanham Act violates the First and Fifth Amendments to the United States Constitution.⁹⁸ Both parties filed cross-motions for summary judgment with the court, and in early July 2015, the court issued its opinion.⁹⁹

The district court was quick to completely reject all of Pro-Football, Inc.'s arguments.¹⁰⁰ The opinion relied predominately on the twenty-day-old Supreme Court of the United States decision of *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*¹⁰¹ It also relied heavily on the case of *In re McGinley*—precedent from the Federal Circuit¹⁰²—which would be overturned less than six months later in the case of *In re Tam*.¹⁰³ Nevertheless, Judge Gerald Bruce Lee's holding was twofold regarding Pro-Football, Inc.'s First Amendment challenges: first, Section 2(a) does not implicate the First Amendment; and second, the federal trademark registration program is “government speech” and is exempt from First Amendment scrutiny.¹⁰⁴

a. Section 2(a) of the Lanham Act Does Not Implicate Pro-Football, Inc.'s First Amendment Rights

To support its constitutional argument that Section 2(a) of the Lanham Act restricts speech, Pro-Football, Inc. cited—or as Judge Lee regarded—“a panoply of First Amendment cases.”¹⁰⁵ The court, nevertheless,

⁹⁵ *Id.* § 1071(b)(4).

⁹⁶ See Complaint, *supra* note 30, ¶ 1.

⁹⁷ *Id.* ¶ 2. In a 15 U.S.C. § 1071(b)(1) action, the district court acts as a fact-finder and reviews the TTAB record de novo. The court can then determine whether to grant or cancel registrations. See 15 U.S.C. § 1071(b)(1).

⁹⁸ Complaint, *supra* note 30, ¶ 1.

⁹⁹ Pro-Football, Inc. v. Blackhorse, 112 F. Supp. 3d 439 (E.D. Va. 2015).

¹⁰⁰ *Id.*

¹⁰¹ *Id.* at 454, 457–59; 135 S. Ct. 2239 (2015).

¹⁰² *Blackhorse*, 112 F. Supp. 3d at 455, 463–64, 469, 472 (citing *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981)).

¹⁰³ See *infra* Parts III, IV; *In re Tam*, 808 F.3d 1321, 1330 n.1 (Fed. Cir. 2015).

¹⁰⁴ *Blackhorse*, 112 F. Supp. 3d at 447–48.

¹⁰⁵ *Id.* at 455–56 (citing *Clatterbuck v. City of Charlottesville*, 708 F.3d 549 (4th Cir. 2013) (finding that “[t]he present case does not concern a statute that prohibits or penalizes any speech as Section 2(a) of the Lanham Act does not restrict one’s ability to engage in a

(continued)

individually rejected these decisions by finding each of the cases distinguishable.¹⁰⁶ As the district court famously remarked: “Nothing about Section 2(a) impedes the ability of members of society to discuss a trademark that was not registered by the [Patent and Trademark Office].”¹⁰⁷ Thus, in Judge Lee’s view, a position this Note resolutely disagrees with, the rejection of the trademarks’ registrations would not trigger the First Amendment because the cancellation does not “burden, restrict, or prohibit [Pro-Football, Inc.’s] ability to use the marks.”¹⁰⁸ Therefore, according to the court, Section 2(a) of the Lanham Act, does not implicate the First Amendment because Pro-Football, Inc. retains its right to use its trademarks in commerce.¹⁰⁹

b. Federal Trademark Registration Is Government Speech and Exempt from First Amendment Scrutiny

The decision then shifted to determine whether federal trademark registrations are government speech, and thus, exempt from First Amendment scrutiny.¹¹⁰ Whereas the *Blackhorse* defendants contended that the federal trademark registration program is government speech,¹¹¹ Pro-Football, Inc. asserted that the registration program, on the other hand, is a restriction on private speech.¹¹² In finding for the *Blackhorse* defendants, Judge Lee presented three reasons why the federal registration program is government speech—as opposed to private speech—and is exempt from First Amendment scrutiny.¹¹³ First, the *Walker* factors articulated by the Supreme Court of the United States favored a finding of

particular form of speech.”); *Sorrell v. IMS Health, Inc.*, 131 S. Ct. 2653 (2011) (finding that “Section 2(a) does not restrict any protected expression.”); *Snyder v. Phelps*, 562 U.S. 443 (2011) (finding Section 2(a) inapplicable because “there is no tort suit against [Pro-Football, Inc.] finding it liable for its speech.”); and *Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105 (1991) (finding that Section 2(a) is distinguishable from a statute requiring particular publishers to pay a fee depending on their book’s content)). In further dismissing the *Simon* decision, Judge Lee most notably explained: “The Court finds [Pro-Football, Inc.’s] unsuccessful attempt to map incongruent First Amendment jurisprudence onto the Lanham Act unpersuasive as Section 2(a) imposes no financial penalty on speech—it simply cancels a trademark’s registration; the speech itself is uninhibited.” *Id.* at 456.

¹⁰⁶ *Id.* at 455–56.

¹⁰⁷ *Id.* at 455.

¹⁰⁸ *Id.*

¹⁰⁹ *Id.* at 457.

¹¹⁰ *See id.* 457–64.

¹¹¹ *Id.* at 457.

¹¹² *Id.*

¹¹³ *Id.* at 457–58.

government speech.¹¹⁴ Next, the mixed/hybrid speech test expressed by the Fourth Circuit in *Sons of Confederate Veterans, Inc. v. Commissioner of Virginia Dep't of Motor Vehicles* also favored a finding of government speech.¹¹⁵ Lastly, under *Rust v. Sullivan*, “the federal trademark registration program is constitutional because the federal government may determine the contents and limits of programs that it creates and manages.”¹¹⁶

i. The Walker Decision

The *Walker* decision had focused on Texas’s specialty license plate program.¹¹⁷ Under Texas law, an individual may submit a particular plate design to the Texas Department of Motor Vehicles Board (TDMV Board) and, if approved, is available for display on Texas vehicles.¹¹⁸ The TDMV Board, however, maintains complete discretion to reject a plate proposal if, among other things, “the design might be offensive to any member of the public”¹¹⁹—echoing the language of Section 2(a) of the Lanham Act.

In 2009, a specialty plate depicting the Confederate flag was suggested by the Sons of Confederate Veterans (SCV).¹²⁰ The plate was rejected for being “offensive” as well as an “expression of hate,” which prompted the SCV to file suit against the TDMV Board arguing that the denial violated the First Amendment’s Free Speech Clause.¹²¹ The case would ultimately work its way through the courts and appear before the Supreme Court of the United States.¹²² In a 5–4 decision scripted by Justice Breyer, the majority concluded that the license plate program was, in fact, government speech and did not violate the free speech guarantees protected by the First Amendment.¹²³ In doing so, the Court set forth a three-factor framework that would later guide Judge Lee’s mistaken decision in *Blackhorse*.¹²⁴

First, *Walker* revealed that the history of license plates shows that “insofar as license plates have conveyed more than state names and vehicle

¹¹⁴ *Id.*

¹¹⁵ *Id.* at 458; 288 F.3d 610, 616 (4th Cir. 2002).

¹¹⁶ *Blackhorse*, 112 F. Supp. 3d at 458 (citing *Rust v. Sullivan*, 500 U.S. 173 (1991)).

¹¹⁷ *Walker v. Tx. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2243–44 (2015).

¹¹⁸ *Id.* at 2244–45. See also TEX. TRANSP. CODE ANN. § 504.801(a), (b) (West 2012).

¹¹⁹ *Walker*, 135 S. Ct. at 2244–45; TEX. TRANSP. CODE ANN. § 504.801(c) (West 2012).

¹²⁰ *Walker*, 135 S. Ct. at 2245.

¹²¹ *Id.*

¹²² See *id.*

¹²³ *Id.* at 2244.

¹²⁴ *Id.* at 2247. As support for the Supreme Court’s holding, the majority relied primarily on the analysis of *Pleasant Grove City v. Summum*, 555 U.S. 460 (2009). See *id.* at 2246–53.

identification numbers, they long have communicated messages from the States.”¹²⁵ For Judge Lee, this factor weighed in favor of government speech for the *Blackhorse* defendants because “the federal trademark registration program communicates the message that the federal government has approved the trademark.”¹²⁶

Second, *Walker* expressed that the general public closely associates an official state license plate with its issuing state.¹²⁷ Not only are the Texas license plates “essentially government IDs[,]” but “a person who displays a message on a Texas license plate likely intends to convey to the public that the State has endorsed that message.”¹²⁸ Likewise, Judge Lee found this second factor weighed in favor of government speech.¹²⁹ For example, because the public closely associates the ® insignia with federal registration, the trademark is a manifestation of the federal government’s endorsement of the trademark.¹³⁰

Finally, *Walker* held that Texas maintains direct control over what is displayed on its specialty license plates.¹³¹ By designating power to the TDMV Board to grant or reject a design, Texas maintains control over what it presents to its constituency.¹³² For Judge Lee, this third factor also weighed in favor of the *Blackhorse* defendants.¹³³ Similar to the TDMV Board in *Walker*, the PTO retains the authority to deny or cancel a trademark’s registration.¹³⁴ In doing so, the federal government is simply “exercising [its] editorial discretion over what is published in the Official Gazette” and what appears to the public on the Principal Register.¹³⁵ Therefore, because the First Amendment “does not preclude the government from exercising editorial discretion over its own medium of expression,” this *Walker* factor—along with the others—led Judge Lee to

¹²⁵ *Id.* at 2248.

¹²⁶ *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 458 (E.D. Va. 2015).

¹²⁷ *Walker*, 135 S. Ct. at 2248–49.

¹²⁸ *Id.* at 2249.

¹²⁹ *Blackhorse*, 112 F. Supp. 3d at 458–59.

¹³⁰ *Id.*

¹³¹ *Walker*, 135 S. Ct. at 2249.

¹³² *Id.*

¹³³ *Blackhorse*, 112 F. Supp. 3d at 459.

¹³⁴ *Id.*

¹³⁵ *Id.* The Official Gazette is a “weekly publication of the [PTO] that includes regular and special notices of the [o]ffice.” UNITED STATES PATENT AND TRADEMARK OFFICE, <https://www.uspto.gov/learning-and-resources/glossary> [https://perma.cc/MTQ4-J658]. Similarly, the Principal Register is the “primary trademark register of the [PTO]. When a [trade]mark has been registered on the Principal Register, the [trade]mark is entitled to all the rights provided by the Trademark Act.” *Id.*

find the federal trademark registration program is government speech and exempt from First Amendment scrutiny.¹³⁶

ii. The Fourth Circuit's Mixed-Hybrid Speech Test

In addition to the *Walker* factors, Judge Lee held that the federal trademark registration program qualified as government speech under the Fourth Circuit's mixed/hybrid speech test.¹³⁷ Under this test, four factors are considered when determining whether a certain kind of speech is that of the government:

- (1) the central purpose of the program in which the speech in question occurs;
- (2) the degree of editorial control exercised by the government or private entities over the content of the speech;
- (3) the identity of the literal speaker; and
- (4) whether the government or the private entity bears the ultimate responsibility for the content of the speech.¹³⁸

Under the first factor, Judge Lee found the government had long played a role in protecting trademarks, and the federal registration program was part of this process.¹³⁹ The program was designed to provide federal protection to trademarks; it was not designed as an avenue to express one's private views or interests.¹⁴⁰ Rather, the *use* of the trademark in commerce would yield the expression a trademark owner desired.¹⁴¹ Therefore, for the district court, the purpose of the program weighed in favor of government speech.¹⁴²

Next, the district court concluded that the second and third factors were also in favor of government speech.¹⁴³ So long as "editorial control" was "regularly exercised" the second factor would be met.¹⁴⁴ Under Section 2(a) of the Lanham Act, the PTO regularly exerts its power to

¹³⁶ *Blackhorse*, 112 F. Supp. 3d at 459 (quoting *Muir v. Ala. Educ. Television Comm'n*, 688 F.2d 1033, 1044 (5th Cir. 1982)).

¹³⁷ *Id.* at 459–60.

¹³⁸ *Id.* at 460 (quoting *Sons of Confederate Veterans, Inc. v. Comm'r of Va. Dep't of Motor Vehicles*, 288 F.3d 610, 618 (4th Cir. 2002)).

¹³⁹ *Id.*

¹⁴⁰ *Id.* at 460–61.

¹⁴¹ *Id.* at 461.

¹⁴² *Id.*

¹⁴³ *Id.*

¹⁴⁴ *Id.*

reject trademark registrations that fall within the prohibitions of the statute.¹⁴⁵ In addition, the third factor was met since the “literal speaker” is the government itself.¹⁴⁶ The PTO publishes both the Official Gazette and the Principal Register to inform the public of registered trademarks within the federal program.¹⁴⁷ Therefore, Judge Lee concluded that both of these factors weighed in favor of government speech.¹⁴⁸

Finally, the fourth factor regarding responsibility of the speech was the only one that swayed Judge Lee’s vote in favor of private speech.¹⁴⁹ When a trademark’s federal registration is challenged, it is the trademark owner who must defend the action, not the federal government.¹⁵⁰ Therefore, Pro-Football, Inc. was called to defend its *Redskins* trademarks, and not the federal government, when the *Blackhorse* defendants petitioned to cancel them.¹⁵¹ With three of the four factors in favor of government speech, Judge Lee ruled accordingly.¹⁵²

iii. *The Government May Determine the Contents and Limits of Its Programs*

Judge Lee then shifted to determine the contents and limits of the registration program.¹⁵³ Under the Supreme Court’s decision in *Rust v. Sullivan*, the government is entitled to define the limits of a program when public funds are appropriated.¹⁵⁴ Furthermore, *Rust* established that the government can “selectively fund a program”—without violating the Constitution—that “encourage[s] certain activities it believes to be in the public interest.”¹⁵⁵ To this degree, the district court concluded that Congress deciding that disparaging trademarks are not to receive federal registration is well within its “constitutional boundaries.”¹⁵⁶ In concluding

¹⁴⁵ *Id.*

¹⁴⁶ *Id.*

¹⁴⁷ *Id.*

¹⁴⁸ *Id.*

¹⁴⁹ *Id.* at 461–62.

¹⁵⁰ *Id.* at 462.

¹⁵¹ *See id.* at 447.

¹⁵² *Id.* at 462.

¹⁵³ *Id.*

¹⁵⁴ *Id.*; 500 U.S. 173, 194 (1991).

¹⁵⁵ *Blackhorse*, 112 F. Supp. 3d at 462 (quoting *Rust*, 500 U.S. at 193).

¹⁵⁶ *Id.* at 463. Consistent with this notion, the Federal Circuit held in *McGinley*:

In providing that marks comprising scandalous matter not be registered, Congress expressed its will that such marks not be afforded the statutory benefits of registration. We do not see this as an attempt to legislate morality, but, rather, a judgment by the Congress that such

(continued)

that *Walker*, the mixed/hybrid test, and *Rust* favor a finding of government speech, the district court classified the federal trademark registration program as government speech, and therefore, exempt from First Amendment scrutiny.¹⁵⁷ With the clock ticking away and approaching the two minute warning, the future of the *Redskins* trademarks would now likely be determined by its final set of downs.

III. RECENT DEVELOPMENTS

A. *The Hail Mary Pass—In re Tam*

Not long after the *Blackhorse* decision, the Court of Appeals for the Federal Circuit took a contrary position on the disparaging trademarks/First Amendment issue with its holding in *In re Tam*.¹⁵⁸ In doing so, the Federal Circuit abrogated the controversial decision of *In re McGinley*, which the United States District Court for the Eastern District of Virginia had previously relied on for support in the *Blackhorse* decision.¹⁵⁹

Simon Shiao Tam, the leader of an Asian-American rock band dubbed *The Slants*, chose the name for his band to “reappropriate” the Asian stereotype regarding “slanted eyes.”¹⁶⁰ In an attempt to affirm that *The Slants* was a prideful manifestation of his cultural heritage as opposed to an ethnic slur, Tam filed an application with the PTO to register the trademark.¹⁶¹ However, an examining attorney at the PTO found *The Slants* disparaging to “people of Asian descent” and refused to register the trademark.¹⁶² Despite Tam’s self-identification with the ethnic slur, the examiner determined that Tam’s “good intentions” underlying the use of *The Slants* trademark did not change the fact that a substantial composite of Asian-Americans found the term objectionable.¹⁶³

marks not occupy the time, services, and use of funds of the federal government.

In re McGinley, 660 F.2d 481, 486 (C.C.P.A. 1981).

¹⁵⁷ *Blackhorse*, 112 F. Supp. 3d at 464.

¹⁵⁸ See 808 F.3d 1321, 1358 (2015).

¹⁵⁹ *Id.* at 1330 n.1 (“To be clear, we overrule *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981), and other precedent insofar as they could be argued to prevent a future panel from considering the constitutionality of other portions of § 2 in light of the present decision.”).

¹⁶⁰ *Id.* at 1331–32. At one point the band’s Wikipedia page displayed the following message: “We want to take on these stereotypes that people have about us, like the slanted eyes, and own them. We’re very proud of being Asian—we’re not going to hide that fact. The reaction from the Asian community has been positive.” *Id.* at 1332.

¹⁶¹ *Id.* at 1331.

¹⁶² *Id.* at 1336.

¹⁶³ See *In re Simon Shiao Tam*, 108 U.S.P.Q.2d 1305, 1312 (T.T.A.B. 2013).

After *The Slants* was rejected by the PTO, the TTAB affirmed the trademark's disqualification.¹⁶⁴ As support for its finding of disparagement, the TTAB turned to dictionary definitions, among other things, like it previously had in rejecting the trademarks in *Blackhorse*.¹⁶⁵ The definitional evidence of the word "slant" was "abundantly clear" in showing a negative connotation when associated with "people of Asian descent."¹⁶⁶ Thus, the TTAB affirmed the examiner's rejection of *The Slants* as a disparaging trademark under Section 2(a) of the Lanham Act.¹⁶⁷

Subsequently, a panel of the Federal Circuit affirmed the TTAB's decision for the same reasons.¹⁶⁸ Though Tam challenged the rejection on constitutional grounds, the court found the First Amendment objections were foreclosed by binding precedent in the decision of *In re McGinley*.¹⁶⁹ In summary, however, the *McGinley* opinion was written without any analysis or citation to legal authority—both critical points that ultimately led to its abrogation by the Federal Circuit.¹⁷⁰ The limited extent of this decision declared in its entirety:

With respect to appellant's First Amendment rights, it is clear that the PTO's refusal to register appellant's mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant's First Amendment rights would not be abridged by the refusal to register his mark.¹⁷¹

Thus, according to the court in *McGinley*, because a trademark owner retains his right to *use* the trademark in commerce, he does not trigger the First Amendment.¹⁷² Yet, despite opining the panel's decision to reject *The Slants* trademark, an opinion bound by the *McGinley* precedent, Circuit Judge Kimberly Moore authored an accompanying afterword

¹⁶⁴ *Id.* at 1313.

¹⁶⁵ *Id.* at 1312.

¹⁶⁶ *Id.* "[I]t is abundantly clear from the record not only that THE SLANTS . . . would have the 'likely meaning' of people of Asian descent but also that such meaning has been so perceived and has prompted significant responses by prospective attendees or hosts of the band's performances."

¹⁶⁷ *Id.* at 1313.

¹⁶⁸ *In re Tam*, 785 F.3d 567, 571–73 (Fed. Cir. 2015).

¹⁶⁹ *Id.* at 571–72.

¹⁷⁰ *In re Tam*, 808 F.3d 1321, 1333–34 (Fed. Cir. 2015).

¹⁷¹ *Id.* at 1333 (citations omitted) (quoting *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981)).

¹⁷² *See McGinley*, 660 F.2d at 484.

known as “additional views.”¹⁷³ Under this analysis, Judge Moore urged the court to contemplate two positions: the reconsideration of the archaic holding of *In re McGinley* and whether Section 2(a) of the Lanham Act is unconstitutional.¹⁷⁴

More than thirty years had passed since *McGinley* was decided.¹⁷⁵ In the interim, First Amendment jurisprudence had significantly evolved, and the Federal Circuit’s reliance on *McGinley* had been widely criticized.¹⁷⁶ This was largely due to the fact the *McGinley* decision was “ cursory” and decided without any “citation to legal authority” as previously stated.¹⁷⁷ Worse yet, other courts had relied on *McGinley* for lackluster legal support, reinforcing Judge Moore’s concern for reexamining *McGinley* as it applies to Section 2(a) of the Lanham Act.¹⁷⁸ As a result, the persuasiveness of Judge Moore’s post-decision analysis prompted an en banc review of *In re Tam*.¹⁷⁹ The original decision was vacated only seven days after its issuance for a rehearing before a wider panel of appellate judges at the Federal Circuit.¹⁸⁰ Going forward, the future of First Amendment jurisprudence in the Federal Circuit, and the reliance by other

¹⁷³ *Tam*, 785 F.3d at 573–85 (Moore, J., additional views).

¹⁷⁴ *Id.* at 573–74.

¹⁷⁵ *Id.* at 573.

¹⁷⁶ *Id.* at 573–74. Judge Moore then goes on to cite over a dozen examples that support how the Federal Circuit has been criticized for its reliance on *McGinley*. *Id.* at 573 n.1.

¹⁷⁷ *Id.*; *In re Tam*, 808 F.3d 1321, 1333–34 (Fed. Cir. 2015).

¹⁷⁸ *Tam*, 808 F.3d at 1334. In applying *McGinley*, the Fifth Circuit opined without analysis: “We join our sister circuit in rejecting [the applicant’s] argument that prohibiting him from registering a mark with the PTO violates his [F]irst [A]mendment rights.” *Id.* (alterations in original) (quoting *Test Masters Educ. Servs., Inc. v. Singh*, 428 F.3d 559, 578 n.9 (5th Cir. 2005)). Likewise, the Eastern District of Virginia relied on *McGinley* for its holding in *Blackhorse*: “[T]he Court agrees with the Federal Circuit and Fifth Circuit and holds that Section 2(a) of the Lanham Act does not implicate the First Amendment.” *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 457 (E.D. Va. 2015).

¹⁷⁹ FED. R. APP. P. 35(a).

A majority of the circuit judges who are in regular active service and who are not disqualified may order that an appeal or other proceeding be heard or reheard by the court of appeals en banc. An en banc hearing or rehearing is not favored and ordinarily will not be ordered unless:

- (1) en banc consideration is necessary to secure or maintain uniformity of the court's decisions; or
- (2) the proceeding involves a question of exceptional importance.

¹⁸⁰ *In re Tam*, 785 F.3d 567 (Fed. Cir. 2015), *vacated*, 600 F. App'x 775 (Fed. Cir. 2015), *reh'g en banc*, 808 F.3d 1321 (Fed. Cir. 2015).

courts on the *McGinley* decision, would be determined by the outcome of the en banc rehearing.

B. The Play Is Under Review—The En Banc Opinion

The parties were asked to file a brief regarding one specific question: “Does the bar on registration of disparaging marks . . . violate the First Amendment?”¹⁸¹ In a 9–3 decision, the Federal Circuit determined that it does.¹⁸² In doing so, the majority opinion struck down Section 2(a) of the Lanham Act on a number of grounds including three matters of notable importance: (1) Section 2(a) of the Lanham Act cannot survive strict scrutiny; (2) trademark registration is not government speech; and (3) Section 2(a) of the Lanham Act is not a government subsidy that is exempt from the strict scrutiny analysis.¹⁸³

1. Section 2(a) of the Lanham Act Cannot Survive Strict Scrutiny

Whenever the government creates a regulation for speech because it disagrees with the message conveyed, the First Amendment mechanically triggers a review of heightened scrutiny.¹⁸⁴ “This is true whether the regulation bans or merely burdens speech”¹⁸⁵ because “[t]he government’s content-based burdens must satisfy the same rigorous scrutiny as its content-based bans.”¹⁸⁶ A regulation is deemed “content-based” when it involves the overall “topic” or “subject matter” of the speech, whereas a “viewpoint” regulation targets the very “substance” of the speech or idea conveyed.¹⁸⁷ Thus, because Section 2(a) denies an applicant federal registration rights depending on both the content of the speech—disparaging trademarks—and the substance of speech conveyed—trademarks the government rejects because it disapproves of the message communicated—Section 2(a) of the Lanham Act must pass strict scrutiny in order to regulate a trademark.¹⁸⁸

Accordingly, the Federal Circuit was quick to dismiss all of the government’s assertions.¹⁸⁹ To begin with, the government expressed that

¹⁸¹ *Tam*, 808 F.3d at 1334.

¹⁸² *Id.* at 1357–58.

¹⁸³ *See id.* at 1334–58. Due to length, this Note will not exhaust every constitutional aspect of the *In re Tam* decision regarding the First Amendment.

¹⁸⁴ *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566 (2011).

¹⁸⁵ *Tam*, 808 F.3d at 1335.

¹⁸⁶ *Id.* (quoting *United States v. Playboy Entm’t Grp., Inc.*, 529 U.S. 803, 812 (2000)).

¹⁸⁷ *Id.* at 1334–35. *See also* *Reed v. Town of Gilbert, Ariz.*, 135 S. Ct. 2218, 2227 (2015).

¹⁸⁸ *See Tam*, 808 F.3d at 1334.

¹⁸⁹ *Id.* at 1335–39.

the Lanham Act should be able to prevent the registration of “the most vile racial epithets and images.”¹⁹⁰ It also contended that it should be free “to dissociate itself from speech [that] it finds odious.”¹⁹¹

However, when the PTO denied *The Slants* trademark for being “disparaging” to Asian-Americans, it disapproved of the trademark on the basis of the message conveyed, and discriminated based on viewpoint, a “particularly ‘egregious form of content discrimination.’”¹⁹² In addition, the government articulated that Section 2(a) was viewpoint-neutral in eliminating particular “words” rather than a particular “viewpoint.”¹⁹³ Yet, the court dismissed this argument, too, and declared the disparagement provision of Section 2(a) “discriminatory on its face.”¹⁹⁴ The opinion went on to state, “The PTO rejects marks under § 2(a) when it finds the marks refer to a group in a negative way, but it permits the registration of marks that refer to a group in a positive, non-disparaging manner.”¹⁹⁵

To support this contention, the court compared the PTO’s denial of *The Slants* with its approval of two, topically-similar trademarks—*Celebrasians* and *Asian Efficiency*—that each refer to Asian-Americans in a positive fashion.¹⁹⁶ The court then dismissed the argument that opposing viewpoints are treated “identically” if they use a disparaging term.¹⁹⁷ In doing so, the court alluded to the registrations of *Dykes on Bikes* and *Squaw Valley* where the registrations were granted in connection with one particular matter, but denied in connection with another. By referencing these two registered trademarks, the Federal Circuit perfectly demonstrated that the PTO’s bar on registering disparaging trademarks “cannot reasonably be argued to be content neutral or viewpoint neutral.”¹⁹⁸ Therefore, as a result of the government’s failure to advance a compelling interest to justify the registration regulations, the Federal Circuit held that Section 2(a) could not survive strict scrutiny, and its prohibition against disparaging trademarks is unconstitutional.¹⁹⁹

¹⁹⁰ *Id.* at 1336 (internal citations omitted).

¹⁹¹ *Id.*

¹⁹² *Id.* at 1334–35 (quoting *Reed*, 135 S. Ct. at 2223, 2230).

¹⁹³ *Id.* at 1337.

¹⁹⁴ *Id.* at 1336.

¹⁹⁵ *Id.*

¹⁹⁶ *Id.*

¹⁹⁷ *Id.* at 1337.

¹⁹⁸ *Id.*

¹⁹⁹ *Id.*

2. *Trademark Registration Is Not Government Speech*

Faced with difficulties in defending content- and viewpoint-based discriminatory regulations of speech, the government argued trademark registration is, instead, “government speech” and outside the protections of the First Amendment.²⁰⁰ Because an owner’s use of a trademark is clearly identified with private speech, the government argued that trademark registration—in connection with the federal registration symbol ®, placement of the trademark on the Principal Register, and a certificate of federal registration—converts the private speech of trademarks into government speech.²⁰¹ Nevertheless, the court found this particular principle “meritless” and dismissed each portion of the government’s argument.²⁰²

The Federal Circuit expressed that when the government registers a trademark, it does not speak for itself; it simply regulates private speech.²⁰³ As support for this justification, the court analogized trademark registration with the registration of copyrights.²⁰⁴ Not only is the copyright symbol © available to an applicant who registers his work, but the registered copyrights are also listed in a government database, and the copyright owner receives a certificate of registration.²⁰⁵ Thus, the mere “indicia of registration,” for the Federal Circuit, would not convert private speech of copyrights or trademarks into government speech.²⁰⁶ To hold otherwise would allow the government to prohibit the registration of any copyrightable work deemed immoral, scandalous, or disparaging to others by simply attaching the © symbol to a piece of work.²⁰⁷

To further support this contention, the court shifted its discussion toward the recent Supreme Court holding of *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*²⁰⁸ As previously discussed, this is the same decision that influenced Judge Lee to find against Pro-Football, Inc. in *Blackhorse*.²⁰⁹ In *Walker*, because Texas’s specialty license plate program constituted “government speech,” Texas could refuse to display

²⁰⁰ *Id.* at 1339. “The Free Speech Clause restricts government regulation of private speech; it does not regulate government speech.” *Id.* at 1345 (quoting *Pleasant Grove City v. Summum*, 555 U.S. 460, 467 (2009)).

²⁰¹ *Id.* at 1345.

²⁰² *Id.*

²⁰³ *Id.* at 1348.

²⁰⁴ *Id.* at 1346.

²⁰⁵ *Id.*

²⁰⁶ *Id.*

²⁰⁷ *Id.*

²⁰⁸ *Id.* See also 135 S. Ct. 2239 (2015).

²⁰⁹ *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 454, 457–59 (E.D. Va. 2015).

the Confederate flag on plates throughout the state.²¹⁰ But when it comes to federal trademark registration, the government neither owns an individual's trademark designs, nor its associated goods, as the state of Texas owned the license plate designs in *Walker*.²¹¹ Accordingly, the Federal Circuit distinguished the holding in *Walker* as it applies to the registration of trademarks.²¹²

First, with respect to the registration symbol, trademark owners are not required to affix the ® symbol on their goods.²¹³ Hence, the public would be less likely, if at all, to associate a registered trademark with the federal government, or to even consider the registered trademark as a reflection of government endorsement.²¹⁴ “Just as the public does not associate the copyrighted works *Nigger: The Strange Career of a Troublesome Word* or *Fifty Shades of Grey* with the government, neither does the public associate individual trademarks such as [*The Slants*] with the government.”²¹⁵

Second, simply placing a registered trademark on the Principal Register does not amount to government speech.²¹⁶ The court determined that the Principal Register is nothing more than an internet database found on the PTO's website.²¹⁷ “If being listed in a government database . . . [was] enough to convert private speech to government speech, nearly every action the government takes—every parade permit granted, every property title recorded, every hunting or fishing license issued—would amount to government speech.”²¹⁸

Finally, although a trademark applicant receives a registration certificate from the PTO, the certificate differs greatly from the license plates in *Walker*.²¹⁹ A trademark applicant is free to do with the certificate

²¹⁰ *Walker*, 135 S. Ct. at 2253.

²¹¹ *See id.* at 2248.

²¹² *Tam*, 808 F.3d at 1347.

²¹³ *Id.* *See also* 15 U.S.C. § 1111 (2012) (“[A] registrant of a mark registered in the Patent and Trademark Office, *may give notice* that his mark is registered by displaying with the mark the words “Registered in U.S. Patent and Trademark Office” or “Reg. U.S. Pat. & Tm. Off.” or the letter R enclosed within a circle . . .”) (emphasis added).

²¹⁴ *Tam*, 808 F.3d at 1346–47. “[G]overnment registration of a mark is neither a government endorsement of the quality of the goods to which the mark is applied nor a government pronouncement that the mark is a good or reliable one in any moral or commercial sense.” *Id.* at 1347 (quoting J. THOMAS MCCARTHY, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:3.50 (4th ed. 2015)).

²¹⁵ *Id.*

²¹⁶ *Id.*

²¹⁷ *Id.*; UNITED STATES PATENT AND TRADEMARK OFFICE, <https://www.uspto.gov/trademarks-application-process/search-trademark-database> [<https://perma.cc/9S3Z-PKEK>].

²¹⁸ *Tam*, 808 F.3d at 1347–48.

²¹⁹ *Compare id.* at 1348, with *Walker v. Tx. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2248–49 (2015).

as he wishes; he is not required to publicly display the document like a license plate on a vehicle nor is he dictated on what he must do with the certificate.²²⁰ The act of registration, per the Federal Circuit, is simply incompatible with the notions of government speech making it within the protections of the First Amendment.

3. *Section 2(a) Is Not a Government Subsidy*

Lastly, the Federal Circuit rejected the idea that Section 2(a)'s "message-based discrimination is merely the government's shaping of a subsidy program."²²¹ In order for trademark registration to qualify as a governmental subsidy, it must arise under the Spending Clause of the Constitution.²²² When a program stems from the Spending Clause, Congress may define the limits of the program and attach conditions to the activities they seek to subsidize.²²³ However, the Federal Circuit carefully articulated that the Lanham Act does not stem from the Spending Clause at all.²²⁴ Rather, it derives from the Commerce Clause because the Lanham Act's most central purpose is to regulate trademarks used in commerce.²²⁵ In addition, the en banc panel determined the federal trademark registration program is not a government subsidy because it is not a system "through which the government is seeking to get its message out through recipients of funding"²²⁶ "Instead, a registered trademark redefines the nature of the markholder's rights as against the rights of other citizens, depriving others of their ability to use the mark."²²⁷ Therefore, in finding the federal trademark registration program outside the scope of a governmental subsidy, the Federal Circuit dismissed the government's argument, like each of the others, and held in favor of Tam and *The Slants* when concluding that Section (2) of the Lanham Act is unconstitutional.

²²⁰ *Tam*, 808 F.3d at 1348.

²²¹ *Id.*

²²² *Id.* at 1349–50. The Spending Clause of the United States Constitution grants Congress the power "[t]o lay and collect Taxes, Duties, Imposts and Excises, to pay the Debts and provide for the common Defence and general Welfare of the United States" U.S. CONST. art. I, § 8, cl. 1.

²²³ *Tam*, 808 F.3d at 1350 (citing *Agency for Int'l Dev. v. All. for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2328 (2013)).

²²⁴ *Id.* at 1354.

²²⁵ *Id.* "The purpose of the Lanham Act is to regulate marks used in interstate commerce, prevent customer confusion, and protect the goodwill of markholders . . . not to subsidize markholders.

²²⁶ *Id.* at 1351.

²²⁷ *Id.* at 1353.

IV. FOURTH AND GOAL—THE FUTURE OF THE REDSKINS TRADEMARKS

The Federal Circuit's landmark decision in *In re Tam* paved a legal pathway for the future of the *Blackhorse* litigation.²²⁸ Now that a critical component of the district court's supporting precedent in *Blackhorse* has been overruled, the decision has an excellent possibility of being overturned on appeal in the United States Court of Appeals for the Fourth Circuit.²²⁹ The likelihood of this being overturned, however, currently rests in the hands of the Supreme Court of the United States.²³⁰ At this level, the Supreme Court has the ability to adopt, modify, or reject the Federal Circuit's holding in *In re Tam*. If the Supreme Court chooses to adopt this exceedingly persuasive authority as written, a position this Note strongly agrees with, this decision would effectively bind any court dealing with the constitutionality of Section 2(a) of the Lanham Act. Included in this would be the United States Court of Appeals for the Fourth Circuit and the future of the pending *Blackhorse* litigation. However, with uncertainty as to how the Supreme Court will decide on the matter of *In re Tam*, this Note will briefly analyze the outcome of the *Blackhorse* litigation should the Supreme Court adopt the holding and analysis of the Federal Circuit without any modifications.

A. Section 2(a) Most Certainly Implicates the First Amendment Because It Burdens, Restricts, and Prohibits Pro-Football, Inc.'s Ability to Use the Redskins Trademarks

In *Blackhorse*, the district court reasoned that Section 2(a) of the Lanham Act does not implicate the First Amendment because the denial or cancellation of trademark registration does not “burden, restrict, or prohibit

²²⁸ It is evident from Judge Moore's opinion that the *Blackhorse* decision was considered during writing:

[Section] 2(a)'s exclusions can undermine those interests because they can even be employed in cancellation proceedings challenging a mark many years after its issuance and after the markholder has invested millions of dollars protecting its brand identity and consumers have come to rely on the mark as a brand identifier.

Id. at 1329–30.

²²⁹ *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 455 (E.D. Va. 2015) (relying on *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981), *overruled by In re Tam*, 808 F.3d 1321, 1330 n.1 (Fed. Cir. 2015)).

²³⁰ See *supra* note 19 and accompanying text.

[Pro-Football, Inc.'s] ability to use the marks.”²³¹ However, this rationale was mistaken for several, specific reasons. As support for his holding, Judge Lee relied on excerpts from the *In re McGinley* decision.²³² But as previously referenced, the nature of the *McGinley* decision was so widely controversial it prompted Judge Kimberly Moore to author the “additional views” analysis.²³³

One of the most significant portions of this analysis provided: “It is time for this Court to revisit *McGinley*’s holding on the constitutionality of § 2(a) of the Lanham Act.”²³⁴ This analysis triggered the Federal Circuit to vacate its holding of *In re Tam* and rehear the case en banc before a wider panel of appellate judges.²³⁵ In light of this, it is bewildering that Judge Lee would rely on the *McGinley* decision for support in *Blackhorse*, when just three months earlier, Judge Moore had challenged the very essence of this controversial holding. Not only was *McGinley* decided without “citation to legal authority,” but the Federal Circuit had been “widely criticized” for its reliance on this decision.²³⁶

Both the *McGinley* and *Blackhorse* Courts found that a trademark denied federal registration does not prohibit an applicant from using the trademark in commerce.²³⁷ While this assertion may be true, it is inherently misleading because the common law and statutory schemes of 46 states virtually mirror the prohibitions on registering disparaging trademarks as stated in Section 2(a) of the Lanham Act.²³⁸ Thus, rejecting an applicant’s federal trademark registration denies him not only the benefits specifically provided by the Lanham Act, but also deprives the applicant of any trademark protection at the state and local levels that the *Blackhorse* decision leads a trademark owner to believe they retain.

²³¹ *Blackhorse*, 112 F. Supp. 3d at 455.

²³² *Id.*

²³³ *See supra* Section III.A.

²³⁴ *In re Tam*, 785 F.3d 567, 573 (Fed. Cir. 2015) (Moore, J., additional views).

²³⁵ *See supra* Section III.A.; *In re Tam*, 808 F.3d 1321, 1334 (Fed. Cir. 2015).

²³⁶ *Tam*, 785 F.3d at 573 n.1.

²³⁷ *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981); *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 455 (E.D. Va. 2015).

²³⁸ *See* J. THOMAS MCCARTHY, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 22:5 (4th ed. 2016); CYNTHIA CLARK NORTHRUP, THE AMERICAN ECONOMY: A HISTORICAL ENCYCLOPEDIA 412 (2003); *Trademarks*, WASH. SEC. STATE, <https://www.sos.wa.gov/corps/Trademarks.aspx> [<https://perma.cc/UNT5-9A2Q>]; *INTA’s Model State Trademark Bill: Modernizing and Harmonizing U.S. State Trademark Laws*, INTA (Oct. 1, 2009), <http://www.inta.org/INTABulletin/Pages/INTAsModelStateTrademarkBillModernizingandHarmonizingUSStateTrademarkLaws.aspx> [<https://perma.cc/3G2W-54AQ>].

It is undisputed that the benefits of trademark registration are significant. The “Lanham Act confers ‘important legal rights and benefits’ on trademark owners who register their marks.”²³⁹ In the absence of registration, a trademark owner is denied exclusive nationwide use of their trademark throughout the United States; loses the right to sue for infringement in federal court; loses the ability to recover profits, damages, costs, and, in the case of a willful infringement, treble damages; loses the ability to recover reasonable attorney fees in exceptional cases; loses notice of a trademark’s ownership; loses validity of the trademark; loses incontestability status; loses the right to use the federal registration symbol ®; loses the right to assistance from the U.S. Customs and Border Protection to block the importation of goods bearing an infringing or counterfeit trademark; and loses its complete defense to claims of trademark dilution under the common law or laws of a state.²⁴⁰

Furthermore, a trademark owner is burdened even *before* a registration application is filed. The prohibitions of Section 2(a) serve as a disincentive to register *any* trademark that may fall to the PTO’s mighty sword when rejecting potentially disparaging trademarks. Indeed, as if this unfathomable obstacle was not already enough of a disincentive, a trademark can be cancelled any time and even decades after its original issuance, just like the *Redskins* trademarks, thus, restricting the owner’s rights and use at uncertain points in the future. As a result, a trademark owner is left with no choice but to abandon a trademark and reinvest time, money, and other necessary resources into developing a brand-new trademark in order to receive the valuable benefits of federal registration. This amounts to a full prohibition on a disparaging trademark and stands at odds with Judge Lee’s holding when he authored the *Blackhorse* decision.²⁴¹

Even *if* a trademark owner is able to continue using an unregistrable trademark, there is nevertheless a restriction on the owner’s trademark rights because he is confined to using the mark in a limited geographic area.²⁴² Obviously, this undesirous outcome—coupled with the loss of federal benefits awarded to a registered trademark owner—are both clearly inconsistent with Judge Lee’s holding in *Blackhorse*. A trademark’s

²³⁹ *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1300 (2015) (quoting J. THOMAS MCCARTHY, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:3 (4th ed. 2015)).

²⁴⁰ See *supra* notes 36–45 and accompanying text.

²⁴¹ *Blackhorse*, 112 F. Supp. at 464.

²⁴² See, e.g., *Tally-Ho, Inc. v. Coast Cmty. Coll. Dist.*, 889 F.2d 1018, 1023 (11th Cir. 1989).

cancellation does in fact burden, restrict, and prohibit a trademark owner's ability to use his trademarks in commerce.

B. Section 2(a) Fails the First Amendment Because It Allows the PTO to Engage in Content- and Viewpoint-Based Discrimination

“The First Amendment requires heightened scrutiny whenever the government creates ‘a regulation of speech because of disagreement with the message it conveys.’”²⁴³ The same standard applies whether the regulation bans or merely burdens speech.²⁴⁴ Thus, a content-based regulation—one targeting speech for its communicative conduct—is presumptively invalid and will be constitutional only if the government demonstrates a compelling interest to regulate the speech by the most narrowly-tailored means. Viewpoint-based regulations are even more egregious and “raise[] the specter that the government may effectively drive certain ideas or viewpoints from the marketplace.”²⁴⁵ So, when Judge Lee affirmed the denial of the *Redskins* trademarks, he turned a blind eye to the government violating both of these regulatory provisions.²⁴⁶

It is indisputable that Section 2(a) of the Lanham Act bars the registration of disparaging speech.²⁴⁷ A trademark that may be disparaging like *The Slants* or *The Redskins* is denied registration by the PTO when referencing a group in a negative manner.²⁴⁸ Yet, as referenced earlier, a trademark that refers to the same group in a positive or “non-disparaging” fashion receives all the benefits associated with federal registration.²⁴⁹ This presents a conflicting application for topically-similar trademarks, simply because the government denies only the registration of trademarks it disagrees with as a result of its expressive characteristics or speech.

Worse, the PTO's registration program is “rife with inconsistency” because a trademark's approval is conditioned on the subjective opinion of an examining attorney at the PTO.²⁵⁰ Hence, the registration program has led to inconsistent results further complicating the matter. For instance, as the Federal Circuit noted in detail, various occasions of conflicting

²⁴³ *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566 (2011) (quoting *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989)).

²⁴⁴ *In re Tam*, 808 F.3d 1321, 1335 (Fed. Cir. 2015).

²⁴⁵ *Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 116 (1991).

²⁴⁶ *Blackhorse*, 112 F. Supp. 3d at 490.

²⁴⁷ 15 U.S.C. § 1052(a) (2012).

²⁴⁸ *Tam*, 808 F.3d at 1336.

²⁴⁹ *Id.*

²⁵⁰ *Id.* at 1342 n.7.

registrations for disparaging trademarks has led to arbitrary and unpredictable results.²⁵¹ The trademark *Have You Heard Satan Is A Republican* was denied registration while *The Devil Is A Democrat* was approved.²⁵² Likewise, the trademark *F*A*G Fabulous And Gay* surpassed the Section 2(a) gatekeeper while *Fag Forever A Genius!* and *Marriage Is For Fags* were both rejected.²⁵³ In addition, *Dangerous Negro*, *Celebretards*, *Stinky Gringo*, *Midget-Man*, and *Off-White Trash* all receive the benefits of federal trademark registration despite their disparaging reflection on the referenced group.²⁵⁴ Thus, deciding whether a trademark is “disparaging” in the first place amounts to a restraint on protected speech that demands a substantial justification under the strict scrutiny analysis. Without it, Section 2(a) is an unconstitutional exercise in content- and viewpoint-based discrimination.

C. The Federal Trademark Registration Program is Not Government Speech Because Judge Lee’s Blackhorse Opinion Misinterprets Walker

When Judge Lee held the trademark registration program is “government speech,” as opposed to “private speech,” he misconstrued the *Walker* three-factor framework in several different aspects.²⁵⁵ The *Walker* factors, when correctly applied, lead to the opposite conclusion.

Under the first *Walker* factor, the Texas license plates were considered government speech because they have historically “communicated messages from the States.”²⁵⁶ But when Judge Lee stated that “the federal trademark registration program communicates the message that the federal government has approved the trademark,” he incorrectly implied that *every* private trademark registered within the federal program is, in fact, *approved* by the government.²⁵⁷ For example, no one associates *Coca-Cola* soft drinks, *Apple* computers, *Nabisco* food products, *Rawlings* baseball equipment, or *Redman* tobacco with the government. Nor would a reasonable person believe that the government approves of *Take Yo Panties Off* clothing; *Big Titty Blend* coffee; *Dumb Blonde* beer; or even *Midget-Man* condoms.²⁵⁸ If one concluded otherwise as Judge Lee implied

²⁵¹ *Id.*

²⁵² *Id.*

²⁵³ *Id.*

²⁵⁴ *Id.*

²⁵⁵ *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 458–59 (E.D. Va. 2015).

²⁵⁶ *Walker v. Tx. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2248 (2015).

²⁵⁷ *Blackhorse*, 112 F. Supp. 3d at 458.

²⁵⁸ Brief of Appellant, *supra* note 35, at 4.

in *Blackhorse*, then how would the government justify the trademark registrations of *Marijuana for Sale*, *Licensed Serial Killer*, *Jesus Swag*, *Afro Buddha*, and *Murder 4 Hire*?²⁵⁹ Associating a trademark's registration with the government's "stamp of approval" in this manner would mean the government approves of illegally endorsing crime, while unconstitutionally endorsing religion. These vivid examples illustrate why the district court's opinion in *Blackhorse* has flaws. Thus, the only logical conclusion is that Judge Lee improperly weighed this factor in favor of the *Blackhorse* defendants.

Judge Lee also mistakenly applied the second *Walker* factor to the facts of the case in *Blackhorse*. As a basis for the original holding in *Walker*, the Supreme Court found that Texas license plates were government speech because the general public closely associates the name TEXAS, found at the top of the license plate, with the state itself.²⁶⁰ Furthermore, the license plates constituted government speech because the State of Texas owns the designs in question.²⁶¹ So, the key distinction Judge Lee glosses over is that the State of Texas (a governmental entity) owned the specialty plates in *Walker*, whereas in *Blackhorse*, Pro-Football, Inc. (a private entity) owns each of the *Redskins* trademarks.²⁶² The private ownership of a trademark is clearly distinguishable from a state-owned article like the license plates in *Walker*.

Moreover, in *Walker*, the Texas license plates were compared to "government IDs" due to their purpose of serving as a vehicle's registration and identification.²⁶³ But unlike a specialty license plate, a privately-owned trademark does not function as a government-issued form of identification for its owner. Rather, trademarks are a common law right that come into existence through use in commerce by private parties. When an applicant registers a trademark, it is done solely for the purpose of acquiring federal benefits, not necessarily for the "governmental identification" aspect of the federal registration symbol ®. In addition, because trademark owners are not required to affix the ® symbol on their goods, the Federal Circuit correctly concluded that the public is even less likely, if at all, to associate a registered trademark with the federal

²⁵⁹ Brief of Appellant, *supra* note 35, at 24; JESUS SWAG, Registration No. 5,042,802; AFRO BUDDHA, Registration No. 5,096,493.

²⁶⁰ *Walker*, 135 S. Ct. at 2248–49.

²⁶¹ *Id.* at 2248.

²⁶² Compare *id.* at 2251, with *Blackhorse*, 112 F. Supp. 3d at 449.

²⁶³ *Walker*, 135 S. Ct. at 2249.

government.²⁶⁴ Thus, Judge Lee inaccurately weighed this factor in favor of the *Blackhorse* defendants.

Lastly, under the third *Walker* factor, Texas maintained direct control over what was displayed on its specialty plates meriting great weight in favor of government speech.²⁶⁵ To support this contention, the *Walker* opinion expressed that not only does “Texas maintain[] direct control over the messages conveyed on its specialty plates,” but also it “has sole control over the design, typeface, color and alphanumeric pattern for all license plates.”²⁶⁶ Yet, when authoring the *Blackhorse* opinion, Judge Lee specifically disregarded the latter portions of this *Walker* language in an effort to support his decision.²⁶⁷ By doing so, Judge Lee expressed that the PTO maintains control in granting or rejecting a trademark as well as exercising its “editorial discretion” as to what appears on the Principal Register.²⁶⁸

These notions, however, are inconsistent with nature of trademarks because it is the applicant himself—and not the government—who maintains control over his trademark.²⁶⁹ Privately owned trademarks are an exclusive expression of the owner, not the government. Just as the government cannot force *Pepsi* to change its colors to purple and orange, the government has no discretion in requiring *Adidas* to add a fourth bar to its iconic, three-striped design. Rather, the only authority the government retains—for purposes of a trademark’s registration—lies in the regulatory provision of Section 2(a) when rejecting disparaging trademarks. “There is simply no meaningful basis for finding that consumers associate registered private trademarks with the government.”²⁷⁰ Accordingly, because all three of the *Walker* factors, if properly applied, weigh in favor of private speech, the district court’s decision was incorrect. Therefore, the *Walker* factors show that trademarks seeking federal registration are unequivocally private speech.

²⁶⁴ *In re Tam*, 808 F.3d 1321, 1347 (Fed. Cir. 2015).

²⁶⁵ *Walker*, 135 S. Ct. at 2249.

²⁶⁶ *Id.* (quoting TEX. TRANSP. CODE ANN. § 504.005(a) (West 2013)).

²⁶⁷ *See Blackhorse*, 112 F. Supp. 3d at 458.

²⁶⁸ *Id.* at 459.

²⁶⁹ *See Tam*, 808 F.3d at 1348.

²⁷⁰ *Id.* at 1346.

D. The Federal Trademark Registration Program Is Not a Government Subsidy

Finally, the Federal Circuit properly decided that the federal trademark registration program is not a government subsidy.²⁷¹ In the district court's reliance on *Rust v. Sullivan*, Judge Lee declared that "the government may determine the contents and limits of its programs."²⁷² Yet, *The Slants* decision revealed that Judge Lee's holding was mistaken and misguided.

Although Judge Lee accurately expressed that the government can "selectively fund a program" without violating the Constitution, he failed to opine that it may do so only in "instances . . . in which the government use[s] private speakers to transmit specific information pertaining to its own program."²⁷³ The government does not use individual trademark owners to transmit specific information to or from the PTO. Rather, an applicant uses the PTO strictly as a medium to acquire the federal benefits afforded to the owner of a registered trademark.

Moreover, if the registration program were derived under the Spending Clause, then Congress would be free to attach "conditions that define the limits of the government spending program . . . [for] the activities Congress wants to subsidize."²⁷⁴ However, as previously articulated, the Lanham Act is derived from the Commerce Clause and not the Spending Clause.²⁷⁵ Hence, because the registration of a trademark does not implicate the spending power of commerce, the Federal Circuit properly concluded that trademark registration is not a government subsidy.²⁷⁶

V. VICTORY FORMATION—FREE SPEECH WINS

When Simon Shiao Tam set out to register the trademark *The Slants* for his Asian-American rock band, he had no idea that he would be uprooting the laws of intellectual property and its relationship with the First Amendment.

By challenging his right to register a trademark the PTO determined was "disparaging," Tam eviscerated the biggest obstacle standing between federal registration and his trademark—the *McGinley* decision itself. The direct effect of *The Slants* decision is unfathomable. The decision

²⁷¹ *Id.* at 1339.

²⁷² *Blackhorse*, 112 F. Supp. 3d at 462.

²⁷³ *Id.* (quoting *Rust v. Sullivan*, 500 U.S. 173, 193 (1991)); *Tam*, 808 F.3d at 1350 (quoting *Legal Servs. Corp. v. Velazquez*, 531 U.S. 533, 541 (2001)).

²⁷⁴ *Tam*, 808 F.3d at 1350 (quoting *Agency for Int'l Dev. v. All. for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2328 (2013)).

²⁷⁵ See *supra* note 225 and accompanying text.

²⁷⁶ *Tam*, 808 F.3d at 1352–53.

undoubtedly changes the future of controversial trademarks that are penalized for their perceived perception of “offensiveness.” It also throws a lifeline to dozens of similar trademarks that are likely headed toward a Section 2(a) challenge in the future: namely, the Cleveland Indians, the Chicago Blackhawks, the Notre Dame Fighting Irish, the Duke University Blue Devils, the Capital University Crusaders, and the Wake Forest Demon Deacons. It is up to the public, and not the government, to be the final arbitrator of what speech it deems acceptable, false, offensive, and even disparaging in society. Section 2(a) of the Lanham Act is undoubtedly an overstep of the government’s power to discriminate against trademarks that “may disparage.” It is also an undeniable encroachment on the freedom of speech under the First Amendment and should be found unconstitutional.

