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The Trademark Reporter®

A FREE SPEECH RIGHT TO TRADEMARK PROTECTION?

*By Lisa P. Ramsey**

I. INTRODUCTION

Many governments refuse to register and protect as trademarks certain categories of words or symbols that are offensive to members of the public.¹ For example, Section 2(a) of the Lanham Act—the federal trademark law in the United States—bans registration of trademarks which are immoral or scandalous, or which may disparage people, institutions, beliefs, or

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1. Committee on Development and Intellectual Property, *Study on Misappropriation of Signs*, CDIP/9/INF/5 (Mar. 14, 2012), http://www.wipo.int/edocs/mdocs/mdocs/en/cdip_9/cdip_9_inf_5.pdf (discussing trademark laws of several countries, including laws that exclude from registration trademarks that are contrary to morality or public order); WIPO Secretariat, *Grounds for Refusal of All Types of Marks*, WIPO/STrad/INF/5, 16-18 (Aug. 30, 2010), <http://www.wipo.int/sect/en/wipo-strad/> (stating that 74 countries responded that they deny registration to trademarks contrary to morality or public order). Specific examples of these laws are included *infra* Part II.B.

national symbols.² In addition, Canada's Trade-marks Act prohibits the adoption, use, and registration of any scandalous, obscene, or immoral word or device used as a mark in connection with a business.³ Such laws are used to deny trademark protection to subject matter ranging from profanity, obscene images, and drug references to expression that ridicules indigenous communities, racial groups, and religions. When a statute requires trademark offices to refuse to register such "offensive" trademarks, some commentators and courts claim the statute violates the right to freedom of expression.

This free speech argument was raised by Pro-Football, Inc. in a trademark case currently pending in the Fourth Circuit Court of Appeals after a district court upheld the decision of the U.S. Patent and Trademark Office ("USPTO") to cancel six registrations of marks containing the word REDSKINS used by Washington, D.C.'s football team on the ground the mark may disparage Native Americans.⁴ A similar argument was also made in the Federal Circuit Court of Appeals by the trademark applicant in *In re Brunetti* after the USPTO refused to register the term FUCT as a mark for clothing on the ground that the word is scandalous.⁵ The right to freedom of expression was also invoked by a trademark applicant in the case *In re Tam* after the USPTO rejected Simon Tam's application to register THE SLANTS as a mark for entertainment services on the ground the mark may disparage Asian Americans. (Tam claimed his Asian-American dance-rock band "The Slants" was trying to reclaim this slur and make a statement about racial and cultural issues in the United States.) In December 2015, the Federal Circuit sitting *en banc* agreed with Tam and held that Section 2(a)'s ban on registration of trademarks that may disparage others is a facially-invalid government regulation that violates the Free Speech Clause in the First Amendment of the U.S. Constitution,⁶ which provides: "Congress

2. Trademark Act of 1946, Pub. L. No. 79-489, § 2(a), 60 Stat. 427, 428 (codified at 15 U.S.C. § 1052(a) (2012)) ("Lanham Act"). For more information about this provision, see *infra* Part II.C.

3. Trade-marks Act, R.S.C. 1985, c T-13, § 9(1)(j) (Can.) (adoption); *id.* § 11 (use); *id.* § 12(1)(e) (registration); see Teresa Scassa, *Canadian Trademark Law* 205-07 (2d ed. 2015).

4. *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080 (T.T.A.B. 2014), *aff'd*, *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015), *appeal docketed*, No. 15-1874 (4th Cir. Aug. 6, 2015), *petition for cert. filed* (U.S. Apr. 25, 2016) (No. 15-1311). This case is currently pending in the Fourth Circuit. *Pro-Football, Inc. v. Blackhorse*, No. 15-1874 (4th Cir.).

5. *In re Brunetti*, Serial No. 85310960, 2014 WL 3976439 (T.T.A.B. 2104) [not precedential] (noting the examining attorney maintained that the term "fuct" is the phonetic equivalent of "fucked" and is therefore "vulgar, profane and scandalous slang"). This case is currently pending in the Federal Circuit. *In re Brunetti*, No. 2015-1109 (Fed. Cir.).

6. *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015) (en banc), *as corrected* (Feb. 11, 2016), *cert. granted sub nom. Lee v. Tam* (U.S. Sept. 29, 2016) (No. 15-1293).

shall make no law . . . abridging the freedom of speech.”⁷ On September 29, 2016, the U.S. Supreme Court granted the USPTO’s petition for writ of certiorari seeking review of the *Tam* decision, and the Court will now consider whether the disparagement provision of Section 2(a) of the Lanham Act is constitutional under the First Amendment.⁸

Constitutions and human rights treaties recognize the right to freedom of expression and require governments to protect this right.⁹ Trademark laws can conflict with the free speech right when noncommercial expression or nonmisleading commercial expression is suppressed or punished by the government in trademark disputes.¹⁰ Yet many disagree about whether the right to freedom of expression is implicated or violated when a government refuses to allow a private party to register an offensive trademark. Commentators have considered the constitutionality and utility of laws regulating offensive trademarks in the United States, Europe, Australia, Canada, New Zealand, and other countries,¹¹ but most do not address and properly evaluate in a

7. U.S. Const., amend. I. The First Amendment also applies to state and municipal governments, not just the federal government. *Reed v. Town of Gilbert*, 576 U.S. ___, 135 S. Ct. 2218, 2226 (2015).

8. Petition for Writ of Certiorari, *Lee v. Tam* (U.S. Apr. 20, 2016) (No. 15-1293). On April 25, 2016, Pro-Football filed its own petition for writ of certiorari and asked the U.S. Supreme Court to hear its dispute before the Fourth Circuit’s disposition of its appeal because its case is “an essential and invaluable complement to *Tam*,” Petition for Writ of Certiorari Before Judgment to the United States Court of Appeals for the Fourth Circuit, *Pro-Football, Inc. v. Blackhorse* (U.S. Apr. 25, 2016) (No. 15-1311), but the Court only granted the cert petition in *Lee v. Tam*.

9. See the discussion and sources cited in Part III. See also Lisa P. Ramsey, *Reconciling Trademark Rights and Free Expression Locally and Globally*, in *International Intellectual Property: A Handbook of Contemporary Research* 341, 350-52 (Daniel Gervais ed., 2015); Lisa P. Ramsey, *Free Speech and International Obligations to Protect Trademarks*, 35 *Yale J. Int’l L.* 405, 412, 450-52 (2010).

10. See *infra* note 155 and the discussion and sources cited in Parts III and IV. See also Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 *SMU L. Rev.* 381 (2008).

11. For scholarship about Section 2(a) of the U.S. Lanham Act see, for example, Christine H. Farley, *Registering Offense: The Prohibition of Slurs as Trademarks*, in *Diversity in Intellectual Property: Identities, Interests, and Intersections* 105-129 (Irene Calboli & Srividhya Ragavan eds., 2015); Jasmine Abdel-Khalik, *To Live in In-“Fame”-Y: Reconceiving Scandalous Marks as Analogous to Famous Marks*, 25 *Cardozo Arts & Entm’t L.J.* 173 (2007); Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 *TMR* 661 (1993); 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 (2011); Theodore H. Davis, Jr., *Registration of Scandalous, Immoral, and Disparaging Matter Under Section 2(a) of the Lanham Act: Can One Man’s Vulgarity be Another’s Registered Trademark?*, 83 *TMR* 801 (1993); Christine H. Farley, *Stabilizing Morality in Trademark Law*, 63 *Am. U. L. Rev.* 1019 (2014); Shubha Ghosh, *Fuck the Draft®: Notes on the First Amendment and Trademark Law* (Feb. 28, 2016 draft on file with author), https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2737220; Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(a) Trademark*

comprehensive manner all of the relevant free expression issues that may arise in a trademark dispute. Moreover, they have not persuaded judges to follow a single approach to these issues. Court decisions in the United States regarding Section 2(a) of the Lanham Act are inconsistent with each other both in the holdings and in the rationales used to find the statute either unconstitutional or constitutional.¹² In the *Tam* case, for example, there were five different opinions in which the twelve judges

Law after Lawrence v. Texas, 9 Marq. Intell. Prop. L. Rev. 187 (2005); Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*, 101 TMR 1476 (2011); Michelle B. Lee, *Section 2(a) of the Lanham Act as a Restriction on Sports Team Names: Has Political Correctness Gone Too Far?*, 4 Sports Law. J. 65 (1997); Kimberly A. Pace, *The Washington Redskins Case and the Doctrine of Disparagement: How Politically Correct Must a Trademark Be?*, 22 Pepp. L. Rev. 7 (1994); Nell Jessup Newton, *Memory and Misrepresentation: Representing Crazy Horse*, 27 Conn. L. Rev. 1003 (1995); Ron Phillips, *A Case for Scandal and Immorality: Proposing Thin Protection of Controversial Trademarks*, 17 U. Balt. Intell. Prop. L.J. 55 (2008); Hammad Rasul, *The Washington Redskins' Deflating Hope: The Lanham Act Survives the First Amendment Challenge*, 26 Marq. Sports L. Rev. 159 (2015); Jendi Reiter, *Redskins and Scarlet Letters: Why "Immoral" and "Scandalous" Trademarks Should Be Federally Registrable*, 6 Fed. Cir. B.J. 191 (1996); Ned Snow, *Free Speech and Disparaging Trademarks*, 57 B.C. L. Rev. (forthcoming 2016) (Mar. 23, 2016 draft on file with author); Kristian D. Stout, *Terrifying Trademarks and a Scandalous Disregard for the First Amendment: Section 2(a)'s Unconstitutional Prohibition on Scandalous, Immoral, and Disparaging Trademarks*, 25 Alb. L.J. Sci. & Tech. 213 (2015); Rebecca Tushnet, *Essay: The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, 91 Notre Dame L. Rev. (forthcoming 2016) (June 21, 2016 draft on file with author); Jeffrey Lefstin, Note, *Does the First Amendment Bar Cancellation of REDSKINS?*, 52 Stan. L. Rev. 665 (2000); Regan Smith, Note, *Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks*, 42 Harv. C.R.-C.L. L. Rev. 451 (2007).

For scholarship about laws regulating offensive trademarks in other countries see, for example, Jonathan Griffiths, *Is There a Right to an Immoral Trade Mark*, in *Intellectual Property and Human Rights* 309 (Paul L.C. Torremans ed., 2008) (European Union and United Kingdom); Suzy Frankel, *Trademarks and Traditional Knowledge and Cultural Intellectual Property Rights*, in *Trademark Law and Theory: A Handbook of Contemporary Research* 433-63 (Graeme B. Dinwoodie & Mark D. Janis eds., 2008) (New Zealand); Enrico Bonadio, *Brands, Morality and Public Policy: Some Reflections on the Ban on Registration of Controversial Trademarks*, 19 Marq. Intell. Prop. L. Rev. 39 (2015) (Australia, European Union, and United Kingdom); Peter J. Chalk & Alexander Dunlop, *Indigenous Trade Marks and Human Rights: An Australian and New Zealand Perspective*, 99 TMR 956 (2009); Todd Schneider, *Sanguang: An Immoral Trademark?*, 19 J. Contemp. Legal Issues 403 (2010) (China); Amanda Scardamaglia, *Are you Nuckin Futs? Registering "Scandalous" Trade Marks in Australia*, 34 Eur. Intell. Prop. Rev. 628 (2012); Teresa Scassa, *Antisocial Trademarks*, 103 TMR 1172 (2013) (Australia, Canada, European Union, and United Kingdom); Susan Smedden, *Immoral trade marks in the UK and at OHIM: how would the Redskins dispute be decided there?* 11(4) J. of Intell. Prop. L. & Prac. 270-279 (2016); Paul Sumpter, *Intellectual Property Law and the New Morality*, 11 N.Z. Bus. L.Q. 216 (2005) (New Zealand).

12. See, e.g., *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015) (en banc), as corrected (Feb. 11, 2016), cert. granted sub nom. *Lee v. Tam* (U.S. Sept. 29, 2016) (No. 15-1293); *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015), appeal docketed, No. 15-1874 (4th Cir. Aug. 6, 2015), petition for cert. filed (U.S. Apr. 25, 2016) (No. 15-1311).

sitting *en banc* disagreed on the content and scope of U.S. free speech law and its application to the facts of the case.¹³

This article organizes the various free speech doctrines that may be relevant in a trademark dispute into a framework that may be used to more clearly and effectively evaluate the constitutionality of trademark laws, with a focus on laws regulating offensive trademarks. This article also provides an international perspective on the free speech issues raised in the cases involving the REDSKINS, FUCT, and THE SLANTS trademarks and considers whether there is (or should be) a universal free speech right to trademark registration and protection of offensive trademarks under human rights treaties or customary international law. (While countries outside the United States generally use the phrase “free expression” rather than “free speech,” the phrase “free speech” in the First Amendment covers all types of expression,¹⁴ and references to “free speech” in this article are meant to be synonymous with “free expression.”) Governments all over the world have laws banning registration of offensive trademarks, but this article focuses on United States law and Section 2(a) of the Lanham Act due to the recent controversies involving the REDSKINS, FUCT, and THE SLANTS marks and because the United States has strong protection both for trademark rights and freedom of expression.

Below in Part II, this article provides background information about international, regional, and national trademark laws relating to the registration and use of offensive language as a trademark. The article then explains in Part III that obligations to protect the right to freedom of expression in international and regional human rights treaties do not require governments to register or protect trademark rights in offensive words or symbols. Each nation has discretion to decide whether to recognize a free speech right to trademark protection, or to deny registration to marks contrary to morality or public order. Part IV sets forth a proposed framework for evaluating when trademark laws violate the right to freedom of expression, and includes six possible “elements” of a free speech violation in a trademark dispute.

Part IV applies this framework to the situation where a private party claims a free speech right to obtain registration of an

13. *Tam*, 808 F.3d at 1327-82. Judge Moore wrote the court’s opinion, which was joined by Judges Prost, Newman, O’Malley, Wallach, Taranto, Chen, Hughes, and Stoll. Under her maiden name Kimberly Pace, Judge Moore wrote an article that argued that the disparagement provision in Section 2(a) is an unconstitutional regulation of expression. Pace, *supra* note 11, at 8 (“While this article does propose a test for racial disparagement, it also argues that the Lanham Act’s content-based restrictions that deny registration to immoral, scandalous and disparaging trademarks are an unconstitutional violation of the trademark owner’s First Amendment rights.”).

14. Erwin Chemerinsky, *Constitutional Law: Principles and Policies* 965-1185 (5th ed. 2015).

offensive mark, and argues that the U.S. Supreme Court should not affirm the Federal Circuit's holding in *Tam*. Section 2(a) of the Lanham Act is constitutional because the second element of a free speech violation—suppression or punishment of expression, or some other actionable harm to expression—is not satisfied. The statute allows use of the offensive language claimed as a mark, and does not suppress the expression or punish it by requiring jail time or payment of fines or damages. A trademark law banning registration—but not use—of an offensive trademark does not implicate the First Amendment. As there is no free speech right to registration of an offensive trademark under U.S. law, Congress has discretion to decide on public policy grounds whether to deny or allow registration of such marks.

Critics of Section 2(a)'s offensive mark provisions may argue that registration of offensive marks and protection of trademark rights in such language benefits society overall by reducing consumer confusion in the marketplace. They may also argue that we should protect a trademark owner's investment of time, money, and energy in its brand, and not cancel a distinctive mark on the ground it is immoral, scandalous, or potentially disparaging years after it was registered. These are public policy or property rights arguments, not free speech arguments. They should be addressed to the legislature and not used to justify the creation in the courts of a *free speech right* to trademark registration.

The conflict between free speech rights and trademark laws today is not found in Section 2(a) or similar trademark laws that deny registration to certain subject matter based on its content. The real problem is the expansion of trademark law beyond the regulation of misleading commercial expression to allow the government to suppress and punish the unauthorized use of trademarks in noncommercial and commercial expression that is not misleading. Even though some trademark statutes and court decisions protect expressive interests in trademark law, infringement and dilution laws are still used to stifle protected expression. Moreover, most trademark disputes are resolved through the use of demand letters threatening a costly lawsuit and damage award, or notice-and-takedown requests to private parties operating social media sites, search engines, online stores, and other marketplaces of ideas, information, and products. Thus, granting a trademark registration in offensive language has the potential to chill protected expression to a much greater extent than denying registration to a mark that is immoral, scandalous, or potentially disparaging.

II. TRADEMARK LAWS BANNING REGISTRATION OF OFFENSIVE MARKS

The United States has prohibited the registration of offensive trademarks for more than a hundred years, and international trademark treaties have allowed contracting parties to refuse to register or to invalidate trademarks that are contrary to morality and public order since 1883.¹⁵ Therefore *Tam*'s holding that the "may disparage" provision of Section 2(a) of the Lanham Act is a facially-invalid law which violates the right to freedom of expression—with the result that the United States must now allow the registration of marks that may disparage others unless the U.S. Supreme Court disagrees—radically departed from the way the United States and other nations have approached trademark registrations of offensive language for the last century.

Regardless of whether they may also contain offensive words, trademarks such as REDSKINS or THE SLANTS can identify and distinguish the source of goods or services. In addition to its source-identifying meaning created by the trademark owner and the word's inherent meaning, a trademark can also convey information about the brand image of the trademark owner and the quality of its products. Trademarks can consist of words (e.g., VIRGIN for an airline), symbols (e.g., the Nike swoosh for shoes), names (e.g., LOUIS VUITTON for handbags), product configurations (e.g., Ferrari's design of its Daytona Spider car), and a variety of other signs that have the ability to convey information about the source or quality of products.

In the United States, trademarks are capable of protection if they are distinctive, not functional, and the trademark owner has priority based on use of the trademark first in the United States to identify the source of certain goods or services.¹⁶ Other nations have similar requirements for trademark protection but primarily grant priority to the company that registers the mark first with that nation's trademark office.¹⁷ Trademark rights are generally

15. See *infra* note 71 (explaining that immoral and scandalous marks have been denied registration since 1905) and Part II.A (discussing trademark treaties).

16. Use of the mark "in commerce" is required for federal trademark protection, but a trademark owner may also obtain priority in a trademark in the United States by filing an intent-to-use trademark application or a U.S. trademark application based on a foreign trademark application or registration. For information about trademark law in the United States, see Louis Altman & Rudolf Callmann, *Callmann on Unfair Competition, Trademarks and Monopolies* (4th ed. 2016); Anne Gilson LaLonde & Jerome Gilson, *Gilson on Trademarks* (2016); J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (4th ed. 2016).

17. For information about trademark laws in countries outside of the United States see, for example, Lionel Bently & Brad Sherman, *Intellectual Property Law* (4th ed. 2014); Robert G. Burrell & Michael Handler, *Australian Trade Mark Law* (2d ed. 2016); Dan C.K. Chow & Edward Lee, *International Intellectual Property: Problems, Cases, and Materials* (2d ed. 2012); Mark J. Davison, Ann L. Monotti, & Leanne Wiseman, *Australian Intellectual*

territorial (linked to the sovereign powers and borders of individual nations), and once a trademark is valid and protectable in a country, that nation's trademark laws protect the owner's trademark rights against infringement and other trademark violations.¹⁸ The trademark owner can obtain an injunction, monetary relief, and other remedies in a successful trademark lawsuit. The owner may also be able to convince private parties such as Facebook or CafePress to enforce its rights in a trademark by removing third-party posts or merchandise that infringes the mark.¹⁹

Most nations generally require registration of a trademark before the trademark owner can sue another party for trademark violations.²⁰ However, in the United States, registration is not required to sue for infringement of a valid trademark, or for dilution of a mark that is both distinctive and famous.²¹ Still, registration provides several benefits in the United States. As explained by the Federal Circuit in *Tam*:

Registration is significant. The Lanham Act confers important legal rights and benefits on trademark owners who register their marks.' *B & B Hardware, Inc. v. Hargis Ind., Inc.*, — U.S. —, 135 S. Ct. 1293, 1300, 191 L.Ed.2d 222 (2015)

Property Law (3d ed. 2016); Graeme B. Dinwoodie et. al., *International Intellectual Property Law and Policy* (2d ed. 2008); Paul Goldstein & Marketa Trimble, *International Intellectual Property Law: Cases and Materials* (4th ed. 2015); Paul Kossof, *Chinese Trademark Law: The New Chinese Trademark Law of 2014* (2014); Kenneth L. Port, *Trademark and Unfair Competition Law and Policy in Japan* (2007); Scassa, *supra* note 3; Guy Tritton et al., *Intellectual Property in Europe* (4th ed. 2014).

18. See, e.g., 15 U.S.C. § 1114(1)(a) (infringement of a registered mark); 15 U.S.C. § 1125(a)(1)(A) (false designation of origin and unfair competition, including infringement of an unregistered mark); 15 U.S.C. § 1125(c) (dilution); see *Trademark Protection and Territoriality Challenges in a Global Economy* (Irene Calboli & Edward Lee eds., 2014) (discussing the principle of territoriality in trademark law, and applications of and exceptions to this rule).

19. Private parties reduce their chances of being sued for contributory trademark infringement and other trademark violations if they remove infringing uses of marks after a trademark owner complains. Lisa P. Ramsey, *Brandjacking on Social Networks: Trademark Infringement by Impersonation of Markholders*, 58 Buff. L. Rev. 851 (2010). Facebook is a social media site that allows friends, family, and other people to connect online via posts of text, photos, and videos, www.facebook.com, and CafePress allows users to buy or create unique T-shirts, hats, stickers, and other expressive merchandise, www.cafepress.com.

20. See the sources cited *supra* note 17. One exception is when the mark is well known to the people in that country, which might be the case for the mark of a famous company. International trademark laws require contracting parties to protect trademark rights in well-known marks even when the mark is not registered in that country. Paris Convention for the Protection of Industrial Property art. 6bis, Mar. 20, 1883 (as revised at Stockholm, July 14, 1967), 21 U.S.T. 1583, 828 U.N.T.S. 305 [hereinafter Paris Convention]; Agreement on Trade-Related Aspects of Intellectual Property Rights arts. 16(2)-(3), Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments—Results of the Uruguay Round, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) [hereinafter TRIPS Agreement].

21. 15 U.S.C. § 1125(a)(1)(A); 15 U.S.C. § 1125(c).

(quotation marks omitted). These benefits—unavailable in the absence of federal registration—are numerous, and include both substantive and procedural rights. The holder of a federal trademark has a right to exclusive nationwide use of that mark where there was no prior use by others. *See* 15 U.S.C. §§ 1072, 1115. Because the common law grants a markholder the right to exclusive use only in the geographic areas where he has actually used his mark, *see* 5 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 26:32 (4th ed.) (hereinafter “McCarthy”), holders of a federally registered trademark have an important substantive right they could not otherwise obtain. Also, a registered mark is presumed to be valid, 15 U.S.C. § 1057(b), and the mark becomes incontestable (with certain exceptions) after five years of consecutive post-registration use, *id.* § 1065; *see also B & B Hardware*, 135 S. Ct. at 1310 (“Incontestability is a powerful protection.”). A markholder may sue in federal court to enforce his trademark, 15 U.S.C. § 1121, and he may recover treble damages if he can show infringement was willful, *id.* § 1117. He may also obtain the assistance of U.S. Customs and Border Protection in restricting importation of infringing or counterfeit goods, *id.* § 1124, 19 U.S.C. § 1526, and qualify for a simplified process for obtaining recognition and protection of his mark in countries that have signed the Paris Convention, *see id.* § 1141b (Madrid Protocol); Paris Convention for the Protection of Industrial Property art. 6*quinquies*, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305. Lastly, registration operates as a complete defense to state or common law claims of trademark dilution. 15 U.S.C. § 1125(c)(6).²²

Certain types of trademarks are ineligible for registration for a variety of reasons.²³ For example, if someone claims trademark rights in a word that is the ordinary name of the product, such as COMPUTER for a computer, that term cannot be registered as a trademark because it is “generic” or the “customary” name for the product. The reason is that trademark protection of generic language can harm competition and the free flow of commercial information.²⁴ Nations also ban registration of deceptive trademarks because the false or misleading words can confuse consumers in the marketplace. An example is the mark LOVEE LAMB for car seat covers that are not made of lambskin.²⁵ In

22. *In re Tam*, 808 F.3d 1321, 1328–29 (Fed. Cir. 2015) (en banc), *as corrected* (Feb. 11, 2016), *cert. granted sub nom.* *Lee v. Tam* (U.S. Sept. 29, 2016) (No. 15-1293).

23. *See supra* notes 16 and 17 for books that discuss the trademark laws containing absolute bars to registration.

24. *See* Ralph H. Folsom & Larry L. Teply, *Trademarked Generic Words*, 89 Yale L.J. 1323, 1340-46 (1980).

25. *In re Budge Mfg. Co.*, 857 F.2d 773 (Fed. Cir. 1988).

addition, the trademark provisions in the Paris Convention for the Protection of Industrial Property (“Paris Convention”) treaty require contracting parties to deny registration of national flags and other symbols of the government,²⁶ and the United States is one of many nations that have an absolute bar to registration of this type of subject matter.²⁷

The Paris Convention also allows governments to deny registration to trademarks that are contrary to morality or public order,²⁸ and the United States and other nations have laws banning registration of words or symbols that are immoral, scandalous, disparaging, or otherwise offensive or against public policy.²⁹ Proponents of laws banning registration of offensive trademarks have made several arguments in support of these regulations. Among other things, they contend that the government should protect morality and members of the public by refusing to register words or symbols that are vulgar, profane, obscene, sexist, homophobic, or which may offend or be demeaning to people who are members of certain racial, ethnic, indigenous, or religious groups.³⁰ If offensive terms are not eligible for registration, this may discourage individuals and companies from adopting such marks and encourage them to use a non-offensive trademark so they can obtain the benefits of trademark registration.³¹ Unless a country also bans use of that mark, however, the company can still express itself using that offensive term.³²

26. Paris Convention, *supra* note 20, art. 6ter(1)(a).

27. 15 U.S.C. § 1052(b) (banning registration of a mark that “[c]onsists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof”), *discussed in In re City of Houston*, 731 F.3d 1326, 1331-35 (Fed. Cir. 2013). For information about similar laws in other countries, see the books in *supra* note 17.

28. Paris Convention, *supra* note 20, art. 6quinquies(3).

29. See *infra* Part II.B. & Part II.C.

30. See, e.g., *Tam*, 808 F.3d at 1363 (Dyk, J., concurring in part and dissenting in part) (stating that “the purpose of the statute is to protect underrepresented groups in our society from being bombarded with demeaning messages in commercial advertising”); Baird, *supra* note 11, at 788 (“Withholding the many benefits of federal registration from scandalous, immoral, and disparaging trademarks has been justified on a number of public policy grounds, including ... the federal government should promote the public health, welfare, and morals by discouraging the use of scandalous, immoral, and disparaging trademarks ... [and] the federal government should protect the sensitivities of those in the public who might be offended by the use of scandalous, immoral, and disparaging trademarks.”); Farley, *Stabilizing Morality*, *supra* note 11, at 1025 (Section 2(a) “seeks to encourage civility by denying the benefits of federal registration to marks that cause deep offense to a significant portion of the public”).

31. *Tam*, 808 F.3d at 1341.

32. Tushnet, *supra* note 11, at 8-9 (noting that courts and the USPTO have argued that Section 2(a)’s “bar is acceptable because of the lack of any effect on a user’s ability or right to use the mark.”). Moreover, Megan Carpenter and Mary Garner have shown that several scandalous marks denied registration under Section 2(a) were still being used in the

Another justification for such laws is that they help avoid the appearance of government endorsement or approval of the offensive trademark.³³ In addition, supporters of the ban contend that government resources should not be spent on registering or protecting offensive trademarks.³⁴ Others argue that the

marketplace by the trademark applicant or another party. Megan M. Carpenter & Mary Garner, *NSFW: An Empirical Study of Scandalous Trademarks*, 33 *Cardozo Arts & Ent. L.J.* 321, 362-63 (2015).

33. *Tam*, 808 F.3d at 1375 (Lourie, J., dissenting) (“[I]t has been questioned whether federal registration imparts the ‘imprimatur’ of the federal government on a mark, such that registration could be permissibly restricted as government speech. I believe that such action is justified.”); Baird, *supra* note 11, at 788 (stating that one justification for Section 2(a) is that the “federal government should not create the appearance that it favors or approves the use of scandalous, immoral, and disparaging trademarks by placing them on the Principal Register”); Tushnet, *supra* note 11, at 8 (noting courts and the USPTO have argued that “the bar avoids the harm done by the government endorsement represented by a registration”).

In its brief filed in the *Tam* dispute at the Federal Circuit, the U.S. government argued that the First Amendment “does not require Congress to *assist* those who seek to use racial epithets as trademarks in interstate commerce.” En Banc Brief for Appellee at 3, *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015) (No. 14–1203); *see also id.* at 14 (“The Constitution does not preclude Congress from creating a federal trademark registration program without extending it to embrace racial epithets as commercial identifiers.”). The U.S. government made similar arguments when it asked the U.S. Supreme Court to review the Federal Circuit’s decision in *Tam*. *See* Petition for Writ of Certiorari, *supra* note 8, at 10 (“Section 1052(a) simply reflects Congress’s judgment that the federal government should not affirmatively promote the use of racial slurs and other disparaging terms by granting them the benefits of registration.”).

34. *See, e.g., Tam*, 808 F.3d at 1364 (Dyk, J., concurring in part and dissenting in part) (“[T]he statute is designed to preclude the use of government resources not when the government disagrees with a trademark’s message, but rather when its meaning ‘may be disparaging to a substantial composite of the referenced group.’”); *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981) (“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 marks not occupy the time, services, and use of funds of the federal government.”), *quoted in In re Fox*, 702 F.3d 633, 634 (Fed. Cir. 2012); Baird, *supra* note 11, at 788 (noting that one justification for Section 2(a) is that “the federal government should not squander its precious time and resources on scandalous, immoral, and disparaging trademarks”); Tushnet, *supra* note 11, at 8-9 (noting courts and the USPTO have argued that “the bar implements a decision to withhold government resources from disparaging or scandalous terms”).

In *Tam* at the Federal Circuit and U.S. Supreme Court, the U.S. government argued that it need not use government resources to encourage the use of offensive trademarks. En Banc Brief for Appellee, *supra* note 33, at 16 (“The Constitution does not require Congress to underwrite the commercial use of racist, misogynist, or bigoted terms and imagery in interstate commerce—let alone record them on the government’s Principal Register and certify their registration under the official seal of the United States Patent and Trademark Office.”); *id.* at 21 (Section 2(a) “reflects Congress’s judgment that a federal agency should not use its resources affirmatively to promote the use in commerce of racial slurs and similar disparagements as the means for avoiding confusion as to the source of goods or services.”); *id.* at 41 (“[T]he government has a legitimate interest in declining to use its resources in a manner that would encourage the use of offensive or disparaging marks.”); *id.* at 43 (“*Tam* cannot seriously dispute the government’s legitimate interest in declining to expend its resources to facilitate the use of racial slurs as source identifiers in interstate commerce.”); Petition for Writ of Certiorari, *supra* note 8, at 16 (“Congress legitimately

disparagement provision of Section 2(a) serves trademark interests. For example, Professor Michael Grynberg believes that disparaging words do not function effectively as trademarks.³⁵ Moreover, Judge Reyna contends in his dissent in *Tam* that the use of disparaging trademarks tends to disrupt commercial activity and registration of such marks does not further the Lanham Act's goal of promoting the orderly flow of commerce.³⁶

As explained by Professor Christine Farley, critics of laws denying registration to offensive marks “charge that they unconstitutionally restrict free expression, are unwarranted in an otherwise relatively value-neutral regulation of marketplace practice, introduce inherent subjectivity into registration determinations, and produce erratic and inconsistent results.”³⁷ As noted by the Federal Circuit in *Tam*, “[t]he [US]PTO’s record of trademark registrations and denials [under Section 2(a)] often appears arbitrary and is rife with inconsistency.”³⁸ This makes it difficult for companies or individuals to determine if they can register subject matter which may fall within the offensive trademark provisions in Section 2(a) and similar laws. It can also chill the use of expression as a mark that could possibly be deemed immoral, scandalous, potentially disparaging, or otherwise offensive by certain members of the public.

Regardless of whether one agrees with the critics or supporters of trademark laws banning registration of offensive marks, it is important to note that these laws are not new. They

determined that a federal agency should not use government funds to issue certificates ‘in the name of the United States of America’ conferring statutory benefits for use of racial slurs and other disparaging terms.”); *id.* at 18-19 (“But the First Amendment does not bar Congress from using the resources of the federal government to encourage some forms of expressive conduct rather than others.”); *id.* at 21 (“[T]he government also has an interest in declining to use its resources to encourage offensive or disparaging marks.”). However, the Federal Circuit in *Tam* notes that government funds are not currently used to carry out the activities of the USPTO; since 1991 “registration fees cover all of the operating expenses associated with registering marks.” *In re Tam*, 808 F.3d 1321, 1353 (Fed. Cir. 2015) (en banc), *as corrected* (Feb. 11, 2016), *cert. granted sub nom.* *Lee v. Tam* (U.S. Sept. 29, 2016) (No. 15-1293).

35. Michael Grynberg, *A Trademark Defense of the Disparagement Bar* (Aug. 1, 2016 draft on file with author), http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2817127.

36. *Tam*, 808 F.3d at 1379 (Reyna, J., dissenting) (“Section 2(a) serves the same substantial government interest as the Lanham Act as a whole—the orderly flow of commerce. Commercial speech that insults groups of people, particularly based on their race, gender, religion, or other demographic identity, tends to disrupt commercial activity and to undermine the stability of the marketplace in much the same manner as discriminatory conduct.”).

37. Farley, *Stabilizing Morality*, *supra* note 11, at 1024 (citing Carpenter & Murphy, *supra* note 11; LaLonde & Gilson, *supra* note 11, at 1477, 1482-87; Lee, *supra* note 11; Smith, *supra* note 11).

38. *In re Tam*, 808 F.3d 1321, 1342 n.7 (Fed. Cir. 2015) (en banc), *as corrected* (Feb. 11, 2016), *cert. granted sub nom.* *Lee v. Tam* (U.S. Sept. 29, 2016) (No. 15-1293) (providing examples); *Tam*, 808 F.3d at 1359-63 (O'Malley, J., concurring) (same).

have been a part of international, regional, and national trademark laws for a long time.

A. International and Regional Trademark Obligations Relating to Offensive Trademarks

At the international level, multilateral trademark treaties and trade agreements give the United States and other nations complete discretion on whether to refuse to register or invalidate the registration of trademarks that are deemed by the government to be immoral or contrary to public order. Countries have international obligations relating to the registration and protection of trademarks if they are members of the “Paris Union” that agreed to be bound by the Paris Convention.³⁹ Importantly, the United States and other Paris Union members do not have any international obligations to register offensive trademarks. To the contrary, Article 6*quinquies*(3) of the Paris Convention currently provides: “Trademarks covered by this Article may be neither denied registration nor invalidated except . . . when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public.”⁴⁰ The morality and public order language appears in the original 1883 version of this treaty, and was the only ground for refusal or cancellation of a trademark registration in the Paris Convention at that time.⁴¹ According to

39. Paris Convention, *supra* note 20; see G.H.C. Bodenhausen, Guide to Application of the Paris Convention for the Protection of Intellectual Property 9-16 (1969); Stephen P. Ladas, Patents, Trademarks and Related Rights: National and International Protection 59-278, 965-1322 (1975); Sam Ricketson, The Paris Convention for the Protection of Industrial Property: A Commentary (2015). The United States has been a member of the Paris Union since 1887 and, as of this writing, there are 176 contracting parties of the Paris Convention. World Intellectual Prop. Org., *Contracting Parties of the Paris Convention*, http://www.wipo.int/treaties/en/ShowResults.jsp?treaty_id=2 (last visited Aug. 4, 2016).

40. Paris Convention, *supra* note 20, art. 6*quinquies*(3). Note that Article 6*quinquies* of the Paris Convention also provides: “This provision is subject, however, to the application of Article 10bis.” Per Bodenhausen, this last sentence of Paris Convention Article 6*quinquies* “enables member States to refuse or invalidate the registration of a trademark if, for reasons other than those already mentioned in the Article—for example, infringement of the rights of third parties or [the] deceptive character of the mark—its registration would constitute an act of unfair competition. This, for example, could be the case if the mark, in reproducing the picture of a well-known building which is the seat of a competitor, would be liable to cause confusion with that establishment, or if the mark contained a discrediting comparison with the goods of one or more competitors.” Bodenhausen, *supra* note 39, at 117 (footnotes and emphasis omitted); see Ladas, *supra* note 39, at 1237 (explaining that this provision was added “so that it would be clearly understood that the exception with regard to marks contrary to morality or public order or deception of the public purported to include marks filed under circumstances constituting an act of unfair competition in the sense of article 10bis”) (footnotes omitted).

41. Bodenhausen, *supra* note 39, at 114 (“In the original Convention of 1883, the only ground for refusal or invalidation of the registration of trademarks covered by the Article under consideration was contained in the rule (then paragraph 4 of Article 6) that filing may be refused if the object for which it is requested is considered contrary to morality or public order.”) (citing *Actes de Paris*, I. pp. 73/4, 138); Ladas, *supra* note 39, at 1226 (noting

William Henry Browne's *A Treatise on the Law of Trade-Marks* from that time period, there was "a rule of universal application" that trademarks "must not transgress the rules of morality or public policy."⁴² G.H.C. Bodenhausen—who wrote a 1969 guide to the 1967 version of the Paris Convention—provides the following examples of these types of offensive trademarks:

A mark contrary to morality would, for example, be a mark containing an obscene picture. A mark contrary to public order would be a mark contrary to the basic legal or social concepts of the country concerned. Examples of such marks could be a mark containing a religious symbol, or a mark containing the emblem of a forbidden political party, or the emblem of a public body⁴³

The flexibility relating to denials of registration for trademarks contrary to morality or public order was not changed in 1994 when the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS Agreement") was adopted by the United States and other members of the World Trade

that before the revision of the Paris Convention at the Washington Conference, the only exception to Article 6's rule requiring registration was that "an application might be refused if the mark was 'contrary to morality or public order'").

42. William Henry Browne, *A Treatise on the Law of Trade-Marks* 464-65 (1873) ("Propriety must be the standard in the selection of something intended to serve as a symbol of commerce . . . The moral, religious, or political sensibilities of any people must not be shocked by the perversion of an emblem sacred in their eyes . . . To be a 'lawful trade-mark' the emblem must not transgress the rules of morality or public policy. The law will not aid any person to blasphemously bring obloquy upon objects and symbols consecrated to religion . . . All peoples worship God under some form or other, or at least think that they do. Their religious prejudices must not be trampled upon. We tolerate all religions, true or false. A reader of these lines may be a Chinaman. His *joss* must not be caricatured. If a scoffer should endeavor to curry favor with an infidel class by the profane use of an Agnus Dei, or of any symbol of the Alpha and Omega, or the Ineffable Name, or even of angels, apostles, saints, and martyrs, or of a thousand objects depicted by ancient art, and hallowed by associations, would any court of justice sustain a claim to a trade-mark so composed? No! This is a rule of universal application.") (footnotes omitted), *cited in* En Banc Brief for Appellee, *supra* note 33, at 45.

43. Bodenhausen, *supra* note 39, at 116. One commentator argues the phrase "in particular, of such a nature as to deceive the public" means that Article 6^{quinques} "is directed toward immorality based on deception or its tendency to cause public disorder." Marc J. Randazza, *Freedom of Expression and Morality-Based Impediments to the Enforcement of Intellectual Property Rights*, 16 Nev. L.J. 107, 120 (2015). Yet Bodenhausen explains that deceptive marks are only a "special category of trademarks" that are contrary to morality or public order: "The Revision Conference of London in 1934 added to this provision, as a special category of trademarks contrary to morality or public order, those trademarks which are of such a nature as to deceive the public. The purpose of this addition was to enable the member States to refuse or invalidate trademarks containing suggestions that the goods concerned possessed non-existing qualities, or unjustified references to rewards or to protection by a patent, etc. The provision will also apply to trademarks containing misleading indications of geographic origin." Bodenhausen, *supra* note 39, at 116 (footnotes and emphasis omitted).

Organization (“WTO”).⁴⁴ Article 15(2) of the TRIPS Agreement provides that WTO members may deny registration to trademarks on grounds other than those set forth in Article 15(1)—such as lack of distinctiveness—“provided that they do not derogate from the provisions of the Paris Convention (1967).”⁴⁵ WTO members can therefore continue to enact laws banning registration of offensive trademarks without violating their international obligations under the TRIPS Agreement.

Paris Union and WTO members have used their discretion to enact trademark laws banning registration of trademarks “contrary to morality or public order” at the regional and national level. For example, Article 7(1)(f) of the European Union Trade Mark Regulation provides that “[t]he following shall not be registered: . . . (f) trade marks which are contrary to public policy or to accepted principles of morality.”⁴⁶ In addition, Article 1708(14) of the North American Free Trade Agreement (“NAFTA”) between Canada, Mexico, and the United States provides that “[e]ach Party shall refuse to register trademarks that consist of or comprise immoral, deceptive or scandalous matter, or matter that may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs or any Party’s national symbols, or bring them into contempt or disrepute.”⁴⁷ If the USPTO begins to

44. TRIPS Agreement, *supra* note 20; see Carlos M. Correa, Trade Related Aspects of Intellectual Property Rights 178-80 (2007); Daniel Gervais, *The TRIPS Agreement: Drafting History and Analysis* 30-31 (4th ed. 2012). As of this writing, there are 164 members of the WTO. World Trade Org., *Members and Observers*, http://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm (last visited Aug. 4, 2016).

45. TRIPS Agreement, *supra* note 20, art. 15(2).

46. Council Regulation 207/2009, The Community trade mark, art. 7(1)(f), 2009 O.J. (L 78) 3, *amended by* Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market, 2015 O.J. (L 341); *see also* Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, art. 4(1)(f), 2015 O.J. (L 336) 7. The General Court affirmed the European trade mark office’s rejection of the mark PAKI for logistics and packaging services under Article 7(1)(f) after finding the term “Paki” was a derogatory term used to refer to Pakistani people and other dark-skinned immigrants from that region. Case T-526/09, *Paki Logistics GmbH v. OHIM*, 2011 E.C.R. II-0000.

47. North American Free Trade Agreement, Dec. 17, 1992, art. 1708(14), H.R. Doc. 103-159, 32 I.L.M. 289, 673 (entered into force Jan. 1, 1994), *discussed in* Scassa, *supra* note 11, at 1178. Note NAFTA is a free trade agreement rather than a treaty (it was not ratified by two-thirds of the U.S. Senate), and it is not self-executing in the United States. While the U.S. Congress must implement NAFTA for its rules to be binding on U.S. citizens, the United States is bound by international law to comply with its obligations in this trade agreement. If the United States violates its obligations under NAFTA, Canada or Mexico could file a complaint under the dispute settlement mechanisms of NAFTA and argue to a NAFTA panel that the United States is not in compliance and needs to change its laws or provide monetary restitution.

register trademarks that may disparage people, institutions, beliefs, or national symbols of Canada, Mexico, or the United States after the Federal Circuit's holding in *Tam*, then the United States will violate its trademark obligations under NAFTA. While compliance with a free trade agreement (or a treaty) is not a sufficient justification to violate a provision in the U.S. Constitution,⁴⁸ it is still surprising that this international obligation of the United States was not discussed in any of the opinions of the judges in the *Tam* case.

B. Examples of National Trademark Laws Relating to Offensive Trademarks

While the specific language in the statute and the exact meaning of the words may vary, several nations have enacted trademark legislation prohibiting registration (and sometimes even the use) of offensive trademarks.⁴⁹ This fact is relevant here not to show that nations should enact such provisions or adopt the language in the laws set forth below. Rather, these national laws, along with the international and regional laws discussed above, suggest that the custom in international law is for nations to ban registration and protection of offensive trademarks rather than recognize a free speech right to registration of such marks.

There are a variety of ways that an offensive trademark may be denied registration on a nation's trademark register. First, an offensive mark may be refused registration by a trademark office examiner during the initial examination of the trademark application for the mark. An example is the application to register THE SLANTS mark for entertainment services in *Tam*. Second, if the trademark examiner approves of the mark and allows it to be published, another party may still oppose the application on the ground that registration of the offensive mark is prohibited by the trademark statute. For example, the Boston Red Sox Baseball

48. *Boos v. Barry*, 485 U.S. 312, 323-24 (1988) (striking down content-based restriction on display of placards critical of foreign governments outside those governments' embassies despite the United States' "vital national interest in complying with international law," and noting that "the fact that an interest is recognized in international law does not automatically render that interest 'compelling' for purposes of First Amendment analysis"); *Reid v. Covert*, 354 U.S. 1, 16 (1957) ("[N]o agreement with a foreign nation can confer power on the Congress, or on any other branch of Government, which is free from the restraints of the Constitution.").

49. See the sources in note 1. Canada is one example of a country that bans the adoption, use, and registration of an offensive trademark. See *supra* note 3. The World Intellectual Property Organization (WIPO) administers the Paris Convention, and the WIPO website contains the national trademark laws of the Paris Union and WTO members. World Intellectual Prop. Org., *WIPO Lex*, <http://www.wipo.int/wipolex/en/> (last visited Aug. 4, 2016). English-language translations of non-English language trademark laws discussed in this section of the paper were obtained from this WIPO website, and the author cannot vouch for the accuracy of these translations.

Club successfully opposed an application to register a mark containing the term SEX ROD for clothing on the ground that this mark was immoral, scandalous, and may disparage others.⁵⁰ Third, once the mark is registered, others may petition the trademark office or ask a court to cancel the registration. Pro-Football, Inc.'s six registrations containing the word REDSKINS are examples of registrations that were cancelled after they were issued by the USPTO.

Given that the Paris Convention allows denial of registration and invalidation of trademarks that are “contrary to morality or public order,” it is not surprising that many Paris Union members use the words “morality” and “public order” (or the phrase “public policy”) in their statutes banning registration of offensive trademarks. For example, Article 20(k) of Chile’s Industrial Property Law provides “[t]he following may not be registered as marks: . . . (k) marks contrary to public policy, morality and proper practice, including the principles of fair competition and trade ethics.”⁵¹ In Egypt, Article 67(2) of the Law on Protection of Intellectual Property Rights states that “[t]he following shall not be registered as trademarks or components thereof: . . . (2) any mark which is contrary to public order or morality.”⁵² Per Article 123(1)(f) of Greece’s Trademark Law, “[t]he following signs shall not be registered as trademarks: . . . (f) signs which are contrary to public order or to principles of morality.”⁵³ In Japan, Article 4(1)(vii) of the Trademark Act provides that “no trademark shall be registered if the trademark: . . . (vii) is likely to cause damage to public policy.”⁵⁴ Article 4 of Mexico’s Industrial Property Law (which applies to patents in addition to trademarks) provides “[n]o patent, registration or authorization shall be granted, nor shall any publicity be given in the Gazette to any of the legal authorities or institutions governed by this Law, where their contents or substance are contrary to public policy, morality or proper practice, or if said contents or substance violate any legal provision.”⁵⁵ Article 1483(3)(2) of the Russian Civil Code provides “[n]o

50. *Boston Red Sox Baseball Club Ltd. P’ship v. Sherman*, 88 U.S.P.Q.2d 1581 (T.T.A.B. 2008).

51. Law No. 19039 art. 20(k), Enero 26, 2007, *Diario Oficial [D.O.]* (Chile).

52. Law No. 82 of 2002 (Law on the Protection of Intellectual Property Rights), *al-Jarīdah al-Rasmīyah*, vol. 22 bis, 2 June 2002, art. 67(2) (Egypt).

53. Nomos (2012:4072) [Trademark Law No. 4072/2012], *Government Gazette* 2012, A:86 (Greece).

54. Shōhyō-hō [Trademark Act], Law No. 127 of 1959 (as amended up to the revisions of Act No. 55 of 2015), art. 4(1)(vii), translated in *Trademark Act* (Act No. 127 of Apr. 13, 1959) (Japan).

55. *Ley de la Propiedad Industrial [LPI]* art. 4, *Diario Oficial de la Federación [DOF]* 27-06-1991, últimas reformas DOF 28-06-2010 (Mex.). Mexico’s other trademark registration provisions are set forth in Article 90.

trademark state registration shall be granted to designations which are or comprise elements: . . . (2) which conflict with the public interest and with humanity and moral principles.”⁵⁶ Article 2(c) of Saudi Arabia’s Law of Trademarks provides “[t]he following signs, emblems, flags and others as listed below shall not be considered or registered as trademarks: . . . (c) Any expression, sign or drawing inconsistent with public order or public morality.”⁵⁷ Finally, Section 3(3)(a) of the United Kingdom’s Trade Marks Act provides “[a] trade mark shall not be registered if it is— (a) contrary to public policy or to accepted principles of morality.”⁵⁸

Some national trademark laws banning registration of offensive marks contain additional language tailored to the needs of a particular nation, whether they are religious, political, or specific to certain indigenous groups. For example, in Afghanistan, Article 6(6) of the Trademark Registration Law provides “[t]he following symbols may not be used or registered as trademarks: . . . (6) Any marks repugnant to chastity, morality and public order.”⁵⁹ In Brazil, Article 124(III) of the Industrial Property Law refuses registration to marks that consist of “figures, drawings or any other signs that are contrary to morals and standards of respectability or that offend the honor or image of persons or attempt freedom of conscience, belief, religious cult or ideas and feelings worthy of respect and veneration.”⁶⁰ Article 10 of The Trademark Law of the People’s Republic of China provides “[t]he following words or devices shall not be used as trademarks: . . . (6) Those that discriminate against any nationality . . . (8) Those detrimental to socialist morals or customs, or having other unhealthy influences.”⁶¹ In South Korea, Article 34 of the Trademark Act prohibits the registration of “2. Any trademark which falsely indicates a connection with a state, race, ethnic group, public organization, religion or famous deceased person, or which slanders, insults or is likely to defame them” and “4. Any

56. Grazhdanskii Kodeks Rossiiskoi Federatsii [GK RF] [Civil Code] art. 1483(3)(2) (Russ.).

57. Law of Trademarks, Royal Decree No. M/21, art. 2(c), Aug. 7, 2002 (Saudi Arabia).

58. Trade Marks Act, 1994, c. 26, § 3(3)(a) (U.K.); see Griffiths, *supra* note 11, at 311-19, 322-33 (discussing the law on marks contrary to public policy and morality in the United Kingdom, and evaluating whether refusal of an application to register a mark under this provision violates the applicant’s right to freedom of expression).

59. Trademark Registration Law, art. 6(6) (2009) (Afg.).

60. Lei No. 9.279 art. 124(3), de 14 de Maio de 1996, Diário Oficial da União [D.O.U.] de 15.05.1996 (Braz.).

61. Zhonghua Renmin Gongheguo Shangbiao Fa (中华人民共和国商标法) [Trademark Law of the People’s Republic of China] (promulgated by the Standing Comm. Nat’l People’s Cong., Aug. 30, 2013, effective May 1, 2014), art. 10, §§ 6 & 8, 2013 Standing Comm. Nat’l People’s Cong. Gaz. No. 651; see Kossof, *supra* note 17, at 36 (“a mark cannot be registered if it discriminates against a national or ethnic group . . . or ‘is destructive to the morals of socialism’”).

trademark whose meaning, content, etc. conveyed to consumers is likely to harm public order, such as being contrary to moral norms, the prevailing moral sense of ordinary people, where the trademark itself is used or the trademark is used for goods.”⁶² Section 17(1)(c) of the New Zealand Trade Marks Act mentions the Māori, a group of indigenous people in that country; it states that “[t]he Commissioner must not register as a trade mark or part of a trade mark any matter - . . . (c) the use or registration of which would, in the opinion of the Commissioner, be likely to offend a significant section of the community, including Māori.”⁶³

Other nations ban registration of subject matter that is scandalous, obscene, or which is likely to offend others.⁶⁴ For example, in Australia, Section 42(a) of the Trade Marks Act provides “[a]n application for the registration of a trade mark must be rejected if: (a) the trade mark contains or consists of scandalous matter.”⁶⁵ Section 9(1)(j) of the Trade-marks Act of Canada provides “[n]o person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for, . . . (j) any scandalous, obscene or immoral word or device.”⁶⁶ In addition,

62. Sangpyobeob [Trademark Act], Act No. 71, Nov. 28, 1949, *amended by* Act No. 14033, Feb. 29, 2016, art. 34 (S. Kor.).

63. Trade Marks Act 2002, pt 2, subs 2, s 17(1)(c) (N.Z.); *see also* Frankel, *supra* note 11, at 433-63.

64. In Australia, the “scandalous” bar to registration “is most likely to operate in the area of religious or racial matters” rather than prohibit shocking matter such as profanity or sexually offensive trademarks. Davison, Monotti, & Wiseman, *supra* note 17, at 100; *see also* Burrell & Handler, *supra* note 17, at 164-69 (noting that Trade Mark Office decisions suggest that the mark must be more than merely indecent, crude, or in bad taste, and must go further than merely alluding to or suggesting an obscene term). Canada’s trademark examination manual explains that “[a] scandalous word or design is one which is offensive to the public or individual sense of propriety or morality, or is a slur on nationality and is generally regarded as offensive. It is generally defined as causing general outrage or indignation.” Canadian Intellectual Property Office, *Trade-marks Examination Manual*, IV.10.6 Paragraph 9(1)(j), <https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr03636.html#iv.10> (last modified July 14, 2016). In Canada, “[a] word is obscene if marked by violations of accepted language inhibitions or regarded as taboo in polite usage. This word is generally defined as something that is offensive or disgusting by accepted standards of morality or decency; or offensive to the senses. A word or design is immoral when it is in conflict with generally or traditionally held moral principles, and generally defined as not conforming to accepted standard[s] of morality In order to determine if a word or design is scandalous, obscene or immoral, examiners must determine whether the trademark would offend the feelings or sensibilities of a not insignificant segment of the public.” *Id.*; *see also* Hallelujah Trade Mark [1976] 93 R.P.C. 605, 610 (Eng.) (refusal to register mark HALLELUJAH for clothing because it might offend people’s religious sensibilities); Oomphies Trade Mark [1947] 64 R.P.C. 27, 29 (Eng.) (overruling denial of registration of OOMPHIES for shoes; word “oomph” was American slang for sex appeal).

65. Trade Marks Act 1995 (Cth) s 42 (Austl.); *see* Burrell & Handler, *supra* note 17, at 164-69 (discussing potential reasons for the law, examples of decisions, and the standards used in Australia to determine if a mark is scandalous).

66. Trade-marks Act, R.S.C. 1985, c. T-13, § 9(1)(j) (Can.).

Sections 11 and 12(1)(e) of Canada's Trade-marks Act ban the use and registration of such marks, respectively.⁶⁷ Section 9(2)(c) of India's Trademarks Act provides "[a] mark shall not be registered as a trade mark if - . . . (c) it comprises or contains scandalous or obscene matter."⁶⁸ Section 11 of Nigeria's Trade Marks Act prohibits the registration as a mark of "(a) any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice or be contrary to law or morality; or (b) any scandalous design."⁶⁹ In South Africa, Section 10(12) of the Trade Marks Act denies registration to "a mark which is inherently deceptive or the use of which would be likely to deceive or cause confusion, be contrary to law, be *contra bonos mores*, or be likely to give offence to any class of persons."⁷⁰ United States trademark law also bans registration of "scandalous matter" and other types of offensive marks, as discussed next.

C. Section 2(a) of the Lanham Act and the Free Speech Arguments in Tam

United States federal trademark law has prohibited the registration of scandalous and immoral trademarks since 1905, and banned trademarks that may disparage others from registration since 1946.⁷¹ Currently, Section 2(a) of the Lanham Act provides "[n]o 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

67. *Id.* § 11 (use); *id.* § 12(1)(e) (registration); see Scassa, *supra* note 3, 205-07; Scassa, *supra* note 11, at 1178, 1183.

68. The Trade Marks Act § 9(2)(c), No. 47 of 1999, India Code (1999), vol. 86.

69. Trade Marks Act (1990) Cap. (436), § 11 (Nigeria).

70. Trade Marks Act No. 194 of 1993 § 10(12) (S. Afr.).

71. Trademark Act of 1905, § 5, 33 Stat. 724, 725; Trademark Act of 1946, Pub. L. No. 79-489, § 2(a), 60 Stat. 427, 428; see *Hearings on H.R. 9041 Before the Subcomm. on Trademarks of the H. Comm. on Patents*, 75th Cong., 3d Sess. 79-113 (1938) (legislative history of Section 2(a)); see also *In re Tam*, 808 F.3d 1321, 1330 (Fed. Cir. 2015) (en banc), *as corrected* (Feb. 11, 2016), *cert. granted sub nom.* Lee v. Tam (U.S. Sept. 29, 2016) (No. 15-1293) (discussing the disparagement provision of Section 2(a) and examples of marks that were found disparaging by the USPTO); *id.* at 1374 (Lourie, J., dissenting) (noting that the U.S. government has banned registration of offensive marks since 1905 and asking "[i]s there no such thing as settled law, normally referred to as *stare decisis*?"); Farley, *Stabilizing Morality*, *supra* note 11, at 1024-25 (while the "United States has regulated the morality of marks for over a century" Section 2(a) is "not a puritanical relic" since it is consistent with international law and similar rules exist in the trademark laws of U.S. states and most European nations). State trademark statutes and the model state trademark bill in the United States contain a similar provision. See LaLonde & Gilson, *supra* note 11, at 1477; Model State Trademark Bill § 2 (1964), *reprinted in* McCarthy, *supra* note 16, § 22:8. For background information about Section 2(a) of the Lanham Act see Abdel-Khalik, *supra* note 11, at 180-98; Baird, *supra* note 11, at 666-67.

scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”⁷² Before *Tam*, the only U.S. court of appeals decision that evaluated the constitutionality of Section 2(a) was the opinion of the U.S. Court of Customs and Patent Appeals (the predecessor to the Federal Circuit) in the 1981 case *In re McGinley*.⁷³ There the court held that Section 2(a) did not violate the constitutional right to freedom of expression:

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,

72. Lanham Act § 2(a), 15 U.S.C. § 1052(a). Per the U.S. trademark examination manual, the word “scandalous” has been defined in the United States as “shocking to the sense of propriety, offensive to the conscience or moral feelings or calling out for condemnation” and includes “matter that is ‘vulgar,’ defined as ‘lacking in taste, indelicate, morally crude.’” U.S. Trademark Manual of Examining Procedure (“TMEP”), § 1203.01 (Apr. 2016 ed.), <https://mpep.uspto.gov/RDMS/TMEP/current#/current/TMEP-1200d1e3042.html> (last visited Aug. 4, 2016) (citations omitted). “Although the words ‘immoral’ and ‘scandalous’ may have somewhat different connotations, case law has included immoral matter in the same category as scandalous matter.” *Id.* The USPTO trademark examination manual further states that “[d]isparagement is essentially a violation of one’s right of privacy—the right to be ‘let alone’ from contempt or ridicule.” *Id.* § 1203.03(b) (quoting *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d 1635, 1639 (T.T.A.B. 1988)). In *Tam*, the Federal Circuit explained that “[a] disparaging mark is a mark which ‘dishonors by comparison with what is inferior, slights, deprecates, degrades, or affects or injures by unjust comparison.’” *Tam*, 808 F.3d at 1330 (quoting *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014)).

There are different tests for evaluating whether a mark is potentially disparaging or scandalous in the United States. “To determine if a mark is disparaging under § 2(a), a trademark examiner of the PTO considers ‘(1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and (2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.’” *Id.* at 1330-31 (quoting TMEP, *supra*, § 1203.03(b)(i)); *see also In re Geller*, 751 F.3d at 1358 (finding mark STOP THE ISLAMISATION OF AMERICA would be disparaging to a substantial composite of American Muslims). “The determination of whether a mark is scandalous must be made in the context of the relevant marketplace for the goods or services identified in the application, and must be ascertained from the standpoint of not necessarily a majority, but a ‘substantial composite of the general public.’ As long as a substantial composite of the general public would perceive the mark, in context, to have a vulgar meaning, ‘the mark as a whole “consists of or comprises . . . scandalous matter”’ under §2(a).” TMEP, *supra*, § 1203.01 (citing *In re Fox*, 702 F.3d 633, 638 (Fed. Cir. 2012) (holding mark COCK SUCKER for a rooster-shaped chocolate lollipop was scandalous)).

73. *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981) (affirming the examiner’s rejection of a mark consisting of “a photograph of a nude man and woman kissing and embracing in a manner appearing to expose the male genitalia” for a newsletter), *abrogated by In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015) (en banc), *as corrected* (Feb. 11, 2016), *cert. granted sub nom. Lee v. Tam* (U.S. Sept. 29, 2016) (No. 15-1293).

appellant's First Amendment rights would not be abridged by the refusal to register his mark.⁷⁴

The Federal Circuit followed this holding in *McGinley* several times when trademark applicants challenged the constitutionality of Section 2(a).⁷⁵ Then in 2015 the court overturned *McGinley* in *Tam* and held the disparagement provision of Section 2(a) is unconstitutional on its face and as applied to Tam's mark THE SLANTS for entertainment services.⁷⁶

In *Tam*, the *en banc* Federal Circuit held the "may disparage" provision of Section 2(a) is a facially-invalid regulation of expression that violates the First Amendment right to freedom of expression because the government is denying registration of the potentially disparaging trademarks based on disapproval of the message conveyed by those marks.⁷⁷ Even though the statute does not suppress or punish expression, the Federal Circuit said it chills the speech of trademark owners and is an unconstitutional condition on expression because the statute deprives them of a valuable benefit solely because of the content of the message communicated by the mark.⁷⁸ The court also held the statute discriminates based on the viewpoint of the speaker in a manner repugnant to the First Amendment because the government has allowed registration of terms that celebrate (rather than offend) certain groups.⁷⁹ For example, the court noted "the PTO has registered marks that refer positively to people of Asian descent. See, e.g., CELEBRASIANS, ASIAN EFFICIENCY."⁸⁰ The court said this content-based law must be justified under the highest level of constitutional scrutiny regardless of whether the law regulates commercial expression or other speech deemed to be of low value, and concluded Section 2(a) fails strict scrutiny analysis.⁸¹ In addition, the court held a trademark registration is not government speech⁸² or a government subsidy,⁸³ which would

74. *McGinley*, 660 F.2d at 484 (footnotes omitted).

75. See, e.g., *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012) (COCK SUCKER for rooster-shaped lollipops); *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003) (JACK-OFF for adult entertainment services provided over the telephone); *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994) (BLACK TAIL for an adult entertainment magazine featuring African-American women).

76. *Tam*, 808 at 1330 n.1.

77. *Id.* at 1334-39.

78. *Id.* at 1339-45. The unconstitutional conditions doctrine will be discussed *infra* Part IV.A.2.

79. *Id.* at 1136-37. Viewpoint discrimination will be discussed *infra* Part IV.A.6.

80. *Id.* at 1336.

81. *Id.* at 1334-37 (arguing that *Reed v. Town of Gilbert*, 576 U.S. ___, 135 S. Ct. 2218, 2226-33 (2015) requires the highest level of constitutional scrutiny in this case because the law is content-based). Constitutional scrutiny is discussed *infra* Part IV.A.6.

82. *Tam*, 808 F.3d at 1345-48. Government speech doctrine is discussed *infra* Part IV.4.

enable the government to more easily regulate the content of the expression. Finally, the court said the statute would fail intermediate scrutiny analysis under the *Central Hudson* test used to evaluate the constitutionality of regulations of commercial speech if that standard applied.⁸⁴

In addition to joining the majority opinion in *Tam*, Judge O'Malley wrote a concurrence (joined by Judge Wallach).⁸⁵ Judge O'Malley argued that the "may disparage" provision of Section 2(a) was unconstitutionally vague under both the First Amendment and the Fifth Amendment of the U.S. Constitution, which provides that no person shall "be deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use, without just compensation."⁸⁶ After discussing the USPTO's inconsistent and arbitrary decisions under Section 2(a) and the statute's chilling effect on expression,⁸⁷ Judge O'Malley concluded that Section 2(a) was not constitutional because it is void for vagueness.⁸⁸

The judges in *Tam* who believed Section 2(a) is constitutional on its face or as applied to THE SLANTS mark responded to these arguments in various ways. In his partial concurrence and partial dissent, Judge Dyk agreed with the majority that the law was unconstitutional as applied to Tam's mark (which he thought was political speech), but he would have held Section 2(a) is a facially-constitutional regulation of commercial speech.⁸⁹ Judge Dyk (joined by Judges Lourie and Reyna in Parts I-IV of his opinion) said "many trademarks lack the kind of 'expressive character' that would merit First Amendment protection for offensive content, and a regulation of the use of those marks could satisfy the *Central Hudson* test for commercial speech."⁹⁰ He also stated that registration is a government "subsidy" and that awards of subsidies can be made based on their content, so Section 2(a) is not an unconstitutional condition on expression.⁹¹ In addition, Judge Dyk said the majority is incorrect that the government cannot

83. *Id.* at 1348-55. Government subsidies are discussed in the unconstitutional conditions section of *infra* Part IV.2.

84. *Id.* at 1355-57. The intermediate scrutiny test set forth in *Central Hudson* provides that a restriction on nonmisleading commercial speech is constitutional if the law directly advances a substantial government interest and is no more extensive than necessary to serve that interest. *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 565-66 (1980).

85. *Tam*, 808 F.3d at 1358-63 (O'Malley, J., concurring).

86. *Id.*; U.S. Const. amend. V.

87. *Tam*, 808 F.3d at 1359-60.

88. *Id.* at 1361-63.

89. *Id.* at 1363-64, 1373 (Dyk, J., concurring in part and dissenting in part).

90. *Id.* at 1368.

91. *Id.* at 1368-71.

award subsidies based on viewpoint, but even if it cannot, he thought Section 2(a) is a viewpoint-neutral law.⁹² Judge Dyk concluded that this regulation is “reasonable” to protect the disparaged groups when applied to commercial speech, and said the government can make the decision to not assist disparaging commercial expression.⁹³

In addition to joining part of Judge Dyk’s opinion in *Tam*, Judge Lourie argued in his dissent that it is best to apply stare decisis and defer to the legislature on whether to filter out undesirable marks from the federal trademark registration system.⁹⁴ He did not think a refusal to register a trademark denies the right of free speech, and questioned whether “a trademark, even an expressive trademark, is protected commercial speech.”⁹⁵ He said “the government does not necessarily violate an individual’s constitutional rights merely by refusing to grant registration and thereby provide additional assistance in the enforcement of trademark rights.”⁹⁶ In addition, he said the federal registration (but not *Tam*’s trademark itself) “could be permissibly restricted as government speech” because “federal registration imparts the ‘imprimatur’ of the federal government on a mark.”⁹⁷ Judge Lourie thought it was clear that owners of marks denied registration under Section 2(a) on the ground that the marks may disparage others could still obtain common law protection against unfair competition under Section 43(a) of the Lanham Act,⁹⁸ and disagreed with the majority in *Tam*, who suggested otherwise.⁹⁹

Dissenting Judge Reyna criticized the majority for holding “that Mr. *Tam*’s speech, which disparages those of Asian descent, is valuable political speech that the government may not regulate except to ban its use in commerce by everyone but Mr. *Tam*.”¹⁰⁰ Judge Reyna said trademarks are commercial speech and due to the “nature of trademarks seeking federal registration for use in interstate commerce”—which “is indisputably commercial, not political”—Section 2(a) is subject to intermediate scrutiny analysis

92. *Id.* at 1371-72.

93. *Id.* at 1372-73.

94. *Id.* at 1374-75 (Lourie, J., dissenting).

95. *Id.* at 1375.

96. *Id.*

97. *Id.*

98. *Id.*

99. *Id.* at 1344-45 & 1344 n. 11 (majority opinion).

100. *Id.* at 1376 (Reyna, J., dissenting); *see also id.* at 1378 (“But if the expressive content of the mark precludes regulation, on what authority may the government grant Mr. *Tam* the exclusive right to use this mark in commerce? Whatever standard of scrutiny protects the content of Mr. *Tam*’s trademark from government regulation, that same standard must necessarily be overcome by the government’s substantial interest in the orderly flow of commerce, or no trademark could issue.”) (emphasis in original).

even when a trademark includes a political element.¹⁰¹ Judge Reyna also argued that Section 2(a) is a content-neutral regulation of expression because the government's purpose is to address the harmful secondary effects of the speech rather than to suppress speech, and said this is another reason that intermediate scrutiny analysis applies.¹⁰² Like Judge Lourie, Judge Reyna concluded that Section 2(a) survives intermediate scrutiny analysis and found the law constitutional on its face and as applied to THE SLANTS mark.¹⁰³

All of these issues are organized in Part IV into a six-part framework that may be beneficial to legislators, courts, attorneys, and scholars who are considering whether Section 2(a) or a similar law prohibiting registration of offensive marks conflicts with the right to freedom of expression. Before discussing these free speech doctrines, however, it is important to first consider why nations protect the right to freedom of expression and when nations can limit this right to protect other public and private interests.

III. THE RIGHT TO FREEDOM OF EXPRESSION AND LIMITS ON THIS RIGHT

To properly assess whether a trademark regulation violates the right to freedom of expression in a country, courts will first need to determine whether the government has an obligation under international, regional, or national laws to protect the free expression right. As explained below, many nations are required to protect the right to freedom of expression, but U.S. and foreign courts are not required to recognize a free speech right to register an offensive trademark. Legislatures therefore have discretion to deny registration of offensive trademarks unless national courts conclude—like the Federal Circuit in *Tam*—that such laws are an unconstitutional regulation of expression or otherwise violate the constitution in that country.

A. Human Rights Treaties and the Right to Freedom of Expression

Scholars debate whether there is a universal moral right of freedom of expression and many people disagree on the content and scope of the free expression right.¹⁰⁴ Yet this right is clearly

101. *Id.* at 1376-78.

102. *Id.* at 1378-79.

103. *Id.* at 1379-82; *id.* at 1374-76 (Lourie, J., dissenting).

104. See generally Larry Alexander, *Is There a Right of Freedom of Expression?* (2005); Eric Barendt, *Freedom of Speech* (2d ed. 2007); Lawrence Ward Beer, *Freedom of Expression in Japan: A Study in Comparative Law, Politics and Society* (1984); Laurence Burgorgue-Larsen & Amaya Ubeda De Torres, *The Inter-American Court of Human Rights: Case Law and Commentary* 529-62 (2011); Karla K. Gower, *Liberty and Authority in Free*

recognized by human rights treaties and national constitutions. For example, Article 19(2) of the International Covenant on Civil and Political Rights (“ICCPR”), to which the United States and 167 other countries are currently parties,¹⁰⁵ declares: “Everyone shall have the right to freedom of expression; this right shall include the freedom to seek, receive and impart information and ideas of all kinds, regardless of frontiers, either orally, in writing or in print, in the form of art, or through any other media of his choice.”¹⁰⁶

A similar right is also included in regional human rights treaties, including the American Convention on Human Rights,¹⁰⁷ and the European Convention on Human Rights.¹⁰⁸ The American Convention on Human Rights obligates various nations in the Americas to protect the free expression right, including but not limited to Argentina, Chile, Columbia, Costa Rica, Ecuador, Nicaragua, Peru, and Uruguay.¹⁰⁹ Article 13(1) of the American Convention on Human Rights provides: “Everyone has the right to freedom of thought and expression. This right includes freedom to seek, receive, and impart information and ideas of all kinds, regardless of frontiers, either orally, in writing, in print, in the form of art, or through any other medium of one’s choice.”¹¹⁰ Similar language appears in Article 10(1) of the European Convention on Human Rights: “Everyone has the right to freedom

Expression Law: The United States and Canada (2002); Ronald J. Krotoszynski, Jr., *The First Amendment in Cross-Cultural Perspective: A Comparative Legal Analysis of the Freedom of Speech* (2006); Shigenori Matsui, *The Constitution of Japan: A Contextual Analysis* (2011); Richard Moon, *The Constitutional Protection of Freedom of Expression* (2000); Mario Oetheimer, *European Court of Human Rights and Council of Europe, Freedom of Expression in Europe: Case-law Concerning Article 10 of the European Convention of Human Rights* (2007); Robert J. Sharpe & Kent Roach, *The Charter of Rights and Freedoms* (5th ed. 2013); Michel Verpeaux, *Freedom of Expression: In Constitutional and International Case Law* (2010).

105. United Nations Treaty Collection, *Status of the International Covenant on Civil and Political Rights*, https://treaties.un.org/Pages/ViewDetails.aspx?src=TREATY&mtdsg_no=IV-4&chapter=4&clang=en (last visited Oct. 12, 2016).

106. International Covenant on Civil and Political Rights, Dec. 16, 1966, S. Exec. Doc. E, 95-2 (1978), 999 U.N.T.S. 171 [hereinafter ICCPR]. Article 19 of the Universal Declaration of Human Rights contains similar language: “Everyone has a right to freedom of opinion and expression; this right includes freedom to hold opinions without interference and to seek, receive and impart information and ideas through any media and regardless of frontiers.” Universal Declaration of Human Rights art. 19, G.A. Res. 217 (III), U.N. Doc. A/810 (Dec. 12, 1948).

107. Organization of American States, American Convention on Human Rights art. 13, Nov. 22, 1969, O.A.S.T.S. No. 36, 1144 U.N.T.S. 123 [hereinafter American Convention on Human Rights].

108. Convention for the Protection of Human Rights and Fundamental Freedoms art. 10(1), Nov. 4, 1950, 213 U.N.T.S. 222 [hereinafter European Convention on Human Rights].

109. For a list of countries who signed and ratified this human rights treaty, see <http://www.cidh.org/Basicos/English/Basic4.Amer.Conv.Ratif.htm> (last visited Oct. 12, 2016).

110. American Convention on Human Rights, *supra* note 107, art. 13(1).

of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers. This Article shall not prevent States from requiring the licensing of broadcasting, television or cinema enterprises.”¹¹¹

Nations have significant discretion to determine the contours of the free expression right because the language in these human rights treaties is broad and lacks detail as to what is covered by the right to freedom of expression. One thing that is clear, however, is that the free expression right in the ICCPR, American Convention on Human Rights, and European Convention on Human Rights does not include an explicit right to register an offensive trademark. The treaties do not mention “trademarks” at all. Of course, international human rights law is growing to include a robust sense of the government’s role in securing and safeguarding human rights, and international norms about what is and is not protected under the free expression right may change over time.¹¹² Still, there is no evidence of any current international free expression right to registration of an offensive mark in human rights treaties or customary international law. To the contrary, several states ban registration of such marks,¹¹³ and trademark and free expression treaties contain language which suggests that nations have discretion to regulate offensive language with restrictions or conditions on that expression to protect the public interest and the rights or reputations of others.

The ICCPR, American Convention on Human Rights, and European Convention on Human Rights allow member nations to regulate expression for a variety of reasons—including to protect morals, public order, and the rights or reputations of others—but the rules must be set forth in the law (i.e., in statutes, codes, or the common law rather than enforced at the discretion of the government) and “necessary” to achieve the goal of the regulation.¹¹⁴ For example, Article 19(3) of the ICCPR provides:

The exercise of the rights provided for in paragraph 2 of this article carries with it special duties and responsibilities. It

111. European Convention on Human Rights, *supra* note 108, art. 10(1); see Wolfgang Sakulin, Trademark Protection and Freedom of Expression: An Inquiry into the Conflict Between Trademark Rights and Freedom of Expression under European Law 111-15 (2011) (discussing the European Convention on Human Rights and noting that the European Court of Human Rights has held that Article 10 covers commercial information and advertisements).

112. I appreciate the comments of Rochelle Dreyfuss on this issue.

113. See *supra* Part II.B.

114. *Claude-Reyes v. Chile*, Judgment, Inter-Am. Ct. H. R. (ser. C) No. 151, ¶¶ 89-92 (Sept. 19, 2006), discussed in Eduardo Andrés Bertoni, *The Inter-American Court of Human Rights and the European Court of Human Rights: A Dialogue on Freedom of Expression Standards*, 3 Eur. Hum. Rts. L. Rev. 332, 347-48 (2009); Sakulin, *supra* note 111, at 111-15 (discussing European law); Verpeaux, *supra* note 104, at 42 (same).

may therefore be subject to certain restrictions, but these shall only be such as are provided by law and are necessary: (a) For respect of the *rights or reputations of others*; (b) For the protection of national security or of *public order* (ordre public), or of public health or *morals*.¹¹⁵

In addition, members of this human rights treaty agreed in Article 20(2) of the ICCPR that “[a]ny advocacy of national, racial or religious hatred that constitutes *incitement to discrimination, hostility or violence* shall be prohibited by law.”¹¹⁶

Similar rules allowing restrictions on free expression rights are found in Article 13 of the American Convention on Human Rights:

2. The exercise of the right [to freedom of expression] provided for in the foregoing paragraph shall not be subject to prior censorship but shall be subject to subsequent imposition of liability, which shall be expressly established by law to the extent necessary to ensure:

- a. respect for the *rights or reputations of others*; or
- b. the protection of national security, *public order*, or public health or *morals*.

...

4. Notwithstanding the provisions of paragraph 2 above, public entertainments may be subject by law to prior censorship for the sole purpose of regulating access to them for the *moral protection of childhood and adolescence*.

5. Any propaganda for war and any advocacy of national, racial, or religious hatred that constitute *incitements to lawless violence or to any other similar action* against any person or group of persons on any grounds including those of race, color, religion, language, or national origin shall be considered as offenses punishable by law.¹¹⁷

In Europe, the free expression right is limited in Article 10(2) of the European Convention on Human Rights:

The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society, in the interests of national security, territorial integrity or public safety, for the *prevention of disorder or crime*, for the protection of health or *morals*, for the protection of the *reputation or rights of others*,

115. ICCPR, *supra* note 106, art. 19(3) (emphasis added).

116. *Id.* art. 20(2) (emphasis added).

117. American Convention on Human Rights, *supra* note 107, art. 13(2)-(5) (emphasis added).

for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary.¹¹⁸

Commentators note that certain types of expression such as hate speech and misleading commercial expression fall outside the subject matter that is protected under Article 10.¹¹⁹

As the contracting parties to these human rights treaties can enact laws that restrict, punish, or put conditions on expression to protect morals, public order, and the rights or reputations of others, and to prevent incitement to discrimination, violence, and disorder,¹²⁰ surely nations can enact statutory bans on registration of marks that are contrary to morality or public order, or which harm the rights or reputations of others targeted by the offensive expression, or which incite others to unlawful activities. These laws must be “necessary,” but nations can argue the law is justified under the relevant balancing test developed by courts interpreting the treaty language.¹²¹ If nations ban profanity, obscene matter, hate speech, or misleading commercial expression,

118. European Convention on Human Rights, *supra* note 108, art. 10(2) (emphasis added).

119. Barendt, *supra* note 104, at 182-83 (noting the European Court of Human Rights “has indicated that hate speech and Holocaust denial laws are in principle compatible with the Convention”); Griffiths, *supra* note 11, at 322 (noting states have “greater freedom to restrict artistic and commercial expression” under Article 10); Sakulin, *supra* note 111, at 112-13 (“Expression that may fall outside the subject-matter of Article 10 ECHR is racist or hate speech, and . . . misleading commercial expression.”) (internal footnotes omitted). “Trademark rights fall into the category of ‘the protection of the [. . .] rights of others,’” and therefore governments can restrict the use of another’s trademark in misleading commercial expression without violating the free expression right in Article 10 of the European Convention on Human Rights. Sakulin, *supra* note 111, at 113, 149-80.

120. See, e.g., Eduardo Bertoni, *Hate Speech Under the American Convention on Human Rights*, 12 ILSA J. Int’l & Comp. L. 569 (2006); Krotoszynski, *supra* note 104, at 9, 26, 94 (discussing how in Germany and Canada protection of equality and human dignity are deemed more important than the right to freedom of expression); Verpeaux, *supra* note 104, at 48-62, 184-85, 198 (discussing limits on freedom of expression to protect morals and the rights of others in France, Germany and other countries in Europe, and noting in matters of morals there is no consensus and the margin of appreciation left to states is much greater).

121. Griffiths, *supra* note 11, at 322-33 (discussing the application by courts of Article 10 to refusals to register marks deemed contrary to morality or public policy, and arguing that such refusals do not violate Article 10). For example, the European Court of Human Rights requires (1) the limitation to be set forth in the law, (2) the limitation must strive to achieve one of the legitimate goals contained in Article 10(2), and (3) the limitation must be necessary in a democratic society. See, e.g., *Casado Coca v. Spain*, App. No. 15450/89, 18 Eur. H.R. Rep. 1 (1994) (deferring to the local courts on how to balance the interests in case involving a ban on advertising by attorneys); *Handyside v. United Kingdom*, App. No. 5493/72, 1 Eur. H.R. Rep. 737 (1976) (holding that *Handyside*’s free expression rights were not violated by the British government’s seizure of publications relating to pornography, masturbation, abortion, and drug use pursuant to the Obscene Publications Act of 1959, as the government was justified in protecting young people from being exposed to obscene material), discussed in Oetheimer, *supra* note 104, at 85; see Sakulin, *supra* note 111, at 149-80, 222-23 (discussing the European Court of Human Rights’ analysis); Verpeaux, *supra* note 104, at 29-31, 42, 46 (same).

they are more likely to find that trademark laws denying registration to offensive or deceptive marks, or trademark laws suppressing or punishing misleading commercial expression, are “necessary” to further these goals.

In the European Union, any free expression challenge to a trademark office’s refusal to register an offensive mark would be informed by the European Court of Human Rights’ case law interpreting the European Convention on Human Rights, but the Court of Justice of the European Union’s analysis would be conducted within the framework provided by the Charter of Fundamental Rights of the European Union.¹²² Article 11(1) of the Charter provides: “Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers.”¹²³

Unlike the European Convention on Human Rights, the Charter does not include a specific exception to the free expression right to protect “morals” or the “reputation or rights of others.” Instead, Article 52(1) allows limits on all of the rights and freedoms discussed in the Charter:

Any limitation on the exercise of the rights and freedoms recognised by this Charter must be provided for by law and respect the essence of those rights and freedoms. Subject to the principle of proportionality, limitations may be made only if they are necessary and genuinely meet objectives of general

122. Charter of Fundamental Rights of the European Union, Dec. 7, 2000, 2007 O.J. (C 364). I appreciate the comments of Jonathan Griffiths and Christophe Geiger on this issue. For more information about the Charter, see Christophe Geiger, *Implementing Intellectual Property Provisions in Human Rights Instruments: Towards a New Social Contract for the Protection of Intangibles*, in *Research Handbook on Human Rights and Intellectual Property* 661, 667-71 (Christophe Geiger ed. 2015); Jonathan Griffiths, “On the Back of a Cigarette Packet”—*Standardised Packaging Legislation and the Tobacco Industry’s Fundamental Right to (Intellectual) Property*, 4 *Intell. Prop. Q.* 343 (2015) (discussing Article 17 of the Charter in the context of plain packaging legislation); Lisa P. Ramsey & Jens Schovsbo, *Mechanisms for Limiting Trademark Rights to Further Competition and Free Speech*, 44 *Int’l Rev. of Intell. Prop. & Competition L.* 671, 680-82 (2013) (discussing the Charter in the trademark enforcement context). Article 52(3) of the Charter encourages the Court of Justice to consult opinions interpreting the right to freedom of expression in the European Convention on Human Rights: “In so far as this Charter contains rights which correspond to rights guaranteed by the Convention for the Protection of Human Rights and Fundamental Freedoms, the meaning and scope of those rights shall be the same as those laid down by the said Convention. This provision shall not prevent Union law providing more extensive protection.” In addition, Article 52(4) encourages the Court of Justice to examine the fundamental rights in constitutions of its member states and interpret the Charter in a manner consistent with traditions common to them: “In so far as this Charter recognises fundamental rights as they result from the constitutional traditions common to the Member States, those rights shall be interpreted in harmony with those traditions.” Charter of Fundamental Rights of the European Union, *supra*, art. 52(4).

123. *Id.* art. 11(1). Article 11(2) of the Charter also provides: “The freedom and pluralism of the media shall be respected.” *Id.* art. 11(2).

interest recognised by the Union or the need to protect the rights and freedoms of others.”¹²⁴

In addition to citing Article 52(1), supporters of the ban on registration of marks that disparage certain members of the public will also likely note that Article 21(1) of the Charter bans discrimination: “Any discrimination based on any ground such as sex, race, colour, ethnic or social origin, genetic features, language, religion or belief, political or any other opinion, membership of a national minority, property, birth, disability, age or sexual orientation shall be prohibited.”¹²⁵ Trademark owners seeking registration of offensive marks will likely argue that expression is different than discrimination, and note that Article 17(2) of the Charter declares that “[i]ntellectual property shall be protected,”¹²⁶ and Article 16 recognizes the “freedom to conduct a business.”¹²⁷ As of this writing, the Court of Justice of the European Union has not held that the right to freedom of expression requires governments in the European Union to register marks which are contrary to public policy or to accepted principles of morality.

While the right to freedom of expression (with its various limitations) is part of customary international law,¹²⁸ there is no

124. *Id.* art. 52(1).

125. *Id.* art. 21. This provision played a significant role in a copyright case involving a racist parody. Case C-201/13, *Deckmyn v. Vandersteen*, 2014 EUR-Lex CELEX LEXIS 62013CJ0201 (Sept. 2, 2014). In addition, Article 21(2) provides: “Within the scope of application of the Treaties and without prejudice to any of their specific provisions, any discrimination on grounds of nationality shall be prohibited.” Charter of Fundamental Rights of the European Union, *supra* note 122, art. 21(2).

126. *Id.* art. 17(2).

127. *Id.* art. 16.

128. See Audrey R. Chapman, *The Human Rights Implications of Intellectual Property Protection*, 5 J. Int'l. Econ. L. 861, 863 (2002); Christophe Geiger, *The Constitutional Dimension of Intellectual Property*, in *Intellectual Property and Human Rights*, *supra* note 11, at 101, 113 (noting “many authors consider that the [Universal Declaration of Human Rights] exerts a binding effect as customary international law”); see also Part III.B. (national constitutions). But see Paul H. Brietzke, *Insurgents in the ‘New’ International Law*, 13 Wis. Int'l L.J. 1, 35 n.73 (1994) (“[F]reedom of expression is widely recognized but it is not a rule of customary international law. It is one of the weakest rights in the Political Covenant (see arts. 4, 19-20): there was little political support for a stronger right, and the art. 19(3) permission to derogate from the right on grounds of national security or public order, health or morals permits an almost unlimited abuse.”); Hurst Hannum, *The Status of the Universal Declaration of Human Rights in National and International Law*, 25 Ga. J. Int'l & Comp. L. 287, 348 (1995/96) (“[T]he widespread restrictions on freedom of opinion and expression, set forth in article 19 of the [Universal Declaration of Human Rights], make it difficult to conclude that this provision is now part of customary international law, unless one accepts that the restrictions to freedom of expression which states believe are permissible can be so broad as to swallow the right itself.”). I am not aware of any scholarship arguing that customary international law recognizes a free speech right to register an offensive trademark. To the contrary, some commentators argue that there is a growing international consensus that hate speech that threatens unlawful harm or incites violence may be regulated without violating the right to freedom of expression. John C. Knechtle, *When to Regulate Hate Speech*, 110 Pa. St. L. Rev. 539 (2006).

evidence that customary international law requires nations to recognize a free speech right to register offensive trademarks. For over a century the parties to the Paris Convention explicitly agreed to give nations the right to refuse to register marks “contrary to morality or public order,” and the 1994 TRIPS Agreement did not change this rule.¹²⁹ Moreover, regional and national trademark laws currently ban registration of such marks.¹³⁰ Not only do certain nations—such as Canada—ban the use of offensive marks in connection with a business, but private parties also prohibit the use of offensive expression on their websites. For example, Facebook’s terms of service state that “You will not post content that: is hate speech, threatening, or pornographic; incites violence; or contains nudity or graphic or gratuitous violence.”¹³¹ While some nations—such as the United States—protect a free speech right to *use* profane language or expression that is racist, sexist, or otherwise offensive to a certain group,¹³² the international custom or practice is for nations to refuse to register offensive trademarks.¹³³ Of course international human rights law does not prevent the United States or other nations from recognizing a free speech right to registration of offensive trademarks, and customary international law on this issue could change after *Tam* (although this is unlikely), but for now nations have discretion to deny registration to such marks under international law.

B. National Constitutions and the Right to Freedom of Expression

The right to freedom of expression is also explicitly recognized in national constitutions, including the constitutions of Canada,

129. See *supra* Part II.A.

130. See *supra* Part II.B and the sources in note 1.

131. Facebook Statement of Rights and Responsibilities, Section 3(7), <https://www.facebook.com/legal/terms> (Jan. 30, 2015) (last visited Oct. 19, 2016); *id.* Section 3(9) (“You will not use Facebook to do anything unlawful, misleading, malicious, or discriminatory.”). In addition, Professor Farley notes that “the Internet Corporation for Assigned Names and Numbers (ICANN) recently proscribed applications for new generic top-level domains (gTLDs) that are immoral or contrary to public order.” Farley, *Registering Offense*, *supra* note 11, at 118 (citing ICANN, gTLD Applicant Guidebook 1-42, 3-4, 3-6 (June 4, 2012), <http://newgtlds.icann.org/en/applicants/agb/guidebook-full-04jun12-en.pdf>); see generally Griffin M. Barnett, *ICANN Morality Standards and the New gTLDs: A Comparative Analysis of Morality in International Trademark Law in the Internet Age*, 103 TMR 1214 (2013).

132. Eugene Volokh, *Freedom of Speech and of the Press*, in *The Heritage Guide to the Constitution* at 406, 410 (David F. Forte & Matthew Spalding eds., 2d ed. 2014); Krotoszynski, *supra* note 104, at 12-25 (providing an overview of freedom of speech in the United States); *Cohen v. California*, 403 U.S. 15 (1971).

133. See *supra* Parts II.A & II.B.

Germany, Japan, South Africa, and the United States.¹³⁴ As with the human rights treaties, the free expression right is not absolute in constitutional laws and can be restricted in certain circumstances.

For example, in Canada the right to freedom of expression is set forth in Section 2(b) of the Canadian Charter of Rights and Freedoms: “Everyone has the following fundamental freedoms: . . . (b) freedom of thought, belief, opinion and expression, including freedom of the press and other media of communication.”¹³⁵ Section 1 of the Canadian Constitution expressly allows restrictions on expression and other rights: “The Canadian Charter of Rights and Freedoms guarantees the rights and freedoms set out in it subject only to such reasonable limits prescribed by law as can be demonstrably justified in a free and democratic society.”¹³⁶ The Canadian Supreme Court has interpreted the right to freedom of expression to encompass most forms of expression, including commercial speech.¹³⁷ If expression falls within the Court’s broad definition of expression and the purpose or effect of the government action is to restrict that expression, then the government must show that its regulation is justified under Section 1 of the Charter.¹³⁸ The Canadian Supreme Court often defers to the legislature and concludes that Section 1 is satisfied, however, especially when laws restrict or proscribe expression to promote equality or multiculturalism.¹³⁹ Among other things, the

134. Canadian Charter of Rights and Freedoms, Part I of the Constitution Act, 1982, *being* Schedule B to the Canada Act, 1982, c 11 s 2(b) (U.K.), *reprinted in* R.S.C. 1985, app II, no 44 sched B pt I s 2 (Can.); Grundgesetz [GG] [Basic Law] art. 5, *translation at* https://www.gesetze-im-internet.de/englisch_gg/englisch_gg.html#p0030 (Ger.); Nihonkoku Kenpō [Kenpō] [Constitution], art. 21, para. 1 (Japan); S. Afr. Const. 1996 § 16; U.S. Const. amend. I; *see* Krotoszynski, *supra* note 104, at 12, 26-51, 93-104, 139-45 (discussing the laws of the United States, Canada, Germany, and Japan); Verpeaux, *supra* note at 104, at 17 (“Freedom of expression is enshrined in the majority of European constitutions, sometimes with differences in wording and name that are not always due to translation problems.”). Other nations do not have a constitutional right to freedom of expression but still protect this right in legislation. *See, e.g.,* New Zealand Bill of Rights Act 1990, s 14; Human Rights Act 1998, c. 42, § 12 (U.K.); *id.* sch. 1, pt. 1, art. 10; *see* Krotoszynski, *supra* note 104, at 183-213 (discussing freedom of expression in the United Kingdom).

135. Canadian Charter of Rights and Freedoms, *supra* note 134, s 2.

136. *Id.* s 1.

137. Scassa, *supra* note 3, at 667-68 (discussing the cases by the Canadian Supreme Court).

138. Krotoszynski, *supra* note 104, at 26-92 (discussing freedom of expression law in Canada); Scassa, *supra* note 3, at 666-69 (discussing the right to freedom of expression in the trademark context).

139. Barendt, *supra* note 104, at 172-77 (discussing Canada’s hate speech laws); Krotoszynski, *supra* note 104, at 26 (“The Supreme Court of Canada has suggested that the constitutional values of pluralism and multiculturalism enjoy some degree of priority over the freedom of expression, at least when a legislative body acts to strike a balance favoring the equality project.”); Scassa, *supra* note 3, at 668; *see also* Moon, *supra* note 104; Sharpe & Roach, *supra* note 104. A court evaluating the constitutionality of Canada’s trademark law

Court has upheld laws criminalizing “promoting hatred against an identifiable group,”¹⁴⁰ and a civil law that prohibits incitement to racial hatred.¹⁴¹ The Court also found that laws proscribing the possession, distribution, or sale of obscene materials¹⁴² and child pornography¹⁴³ did not violate the right to freedom of expression in Canada.

Like Canada, Japan protects the right to freedom of expression in its constitution but this right is not unlimited. Section 1 of Article 21 of the Japanese Constitution provides: “Freedom of assembly and association as well as speech, press and all other forms of expression are guaranteed.” In addition, Section 2 of Article 21 states: “No censorship shall be maintained, nor shall the secrecy of any means of communication be violated.”¹⁴⁴ Despite this constitutional guarantee of freedom of expression and prohibition of censorship, the Supreme Court of Japan usually defers to the legislature when it regulates expression,¹⁴⁵ and has routinely upheld laws restricting or punishing expression to protect both public and private interests.¹⁴⁶ Among other things,

would subject it to constitutional scrutiny under Section 1 of the Canadian Charter of Rights and Freedoms. Canada’s trademark regulations banning the adoption, use, or registration of offensive expression are in the trademark statute, Trade-marks Act, R.S.C. 1985, c. T-13, § 9(1)(j) (Can.) (adoption); *id.* § 11 (use); *id.* § 12(1)(e) (registration), and thus they are “prescribed by law” as required by Section 1. Thus courts must next determine if the law is a “reasonable” limit on expression that “can be demonstrably justified in a free and democratic society” under the free expression jurisprudence of the Canadian Supreme Court interpreting Section 1. As the Canadian Supreme Court has concluded that laws regulating hate speech or obscene materials are constitutional in Canada, see *infra* notes 140-142, and Canada only regulates marks used in connection with a business, a court may find the benefits of the law outweigh any harms, and conclude the law is constitutional.

140. *R v. Keegstra*, [1990] 3 S.C.R. 697 (Can.); see Barendt, *supra* note 104, at 172-74; Krotoszynski, *supra* note 104, at 52-60.

141. *Taylor v. Canadian Human Rights Comm’n*, [1990] 3 S.C.R. 892 (Can.); see Krotoszynski, *supra* note 104, at 60-64.

142. *R v. Butler*, [1992] 1 S.C.R. 452 (Can.); see Krotoszynski, *supra* note 104, at 69-72.

143. *R v. Sharpe*, [2001] 1 S.C.R. 45 (Can.); see Krotoszynski, *supra* note 104, at 79-82.

144. *Nihonkoku Kenpō* [Kenpō] [Constitution], art. 21 (Japan); see Matsui, *supra* note 104, at 196-211 (discussing freedom of expression law in Japan). In Japan, “[f]reedom of expression is generally believed to be essential not only for human dignity, but for a democratic society in which citizens have the right to govern themselves.” Matsui, *supra* note 104, at 196.

145. Matsui, *supra* note 104, at 210 (noting that “from the beginning the Supreme Court has adopted a very deferential attitude towards speech regulation” and “has never ever struck down any statute restricting freedom of expression as unconstitutional”); see also David S. Law, *The Anatomy of a Conservative Court: Judicial Review in Japan*, 87 Tex. L. Rev. 1545 (2009); David S. Law, *Why Has Judicial Review Failed in Japan?*, 88 Wash. U. L. Rev. 1425 (2011); Shigenori Matsui, *Why Is the Japanese Supreme Court So Conservative?*, 88 Wash. U. L. Rev. 1375 (2011).

146. Krotoszynski, *supra* note 104, at 139-82 (providing several examples of how the Court balances the interest in freedom of expression against other public and private interests); see also Hiroshi Itoh & Lawrence Ward Beer, *The Constitutional Case Law of Japan: Selected Supreme Court Decisions, 1961-70*, at 183-223 (1978) (discussing *Ishii et al*

the Court has upheld the constitutionality of laws that regulate political expression,¹⁴⁷ commercial expression,¹⁴⁸ criminal and civil defamation laws that protect the reputations of others,¹⁴⁹ prohibitions on the manufacture and publication of child pornography,¹⁵⁰ and a ban on obscene materials.¹⁵¹

v. Japan—The de Sade Case involving obscene sections of a book and *Ōno v. Japan—The Moxa Advertising Case* involving restrictions on advertising). Article 12 of the Japanese Constitution provides: “The freedoms and rights guaranteed to the people by this Constitution shall be maintained by the constant endeavor of the people, who shall refrain from any abuse of these freedoms and rights and shall always be responsible for utilizing them for the public welfare.” In Article 13, the Constitution states: “All of the people shall be respected as individuals. Their right to life, liberty, and the pursuit of happiness shall, to the extent that it does not interfere with the public welfare, be the supreme consideration in legislation and other governmental affairs.” Matsui, *supra* note 104, at 164-65. Per Professor Matsui, the Supreme Court has “construed article 12 and article 13 as indicating the possibility of public welfare restrictions with respect to all the rights protected by the Constitution.” *Id.* at 165-66 (citing Saikō Saibansho [Sup. Ct.] Mar. 13, 1957, 1953 (A) no. 1713, 11 Saikō Saibansho Keiji Hanreishū [Keishū] 997 (Japan) [*Koyama v. Japan—The Lady Chatterley’s Lover Case*]).

147. Krotoszynski, *supra* note 104, at 146-47 (discussing Japan’s “severe restrictions that limit political speech incident to elections”).

148. Saikō Saibansho [Sup. Ct.] Feb. 15, 1961, 15 Saiko Saibansho Keiji Hanreishū [Keishū] 347 (Japan) [*Ōno v. Japan—the Moxa Advertising Case*] (upholding a regulation of nonmisleading commercial advertising by massage therapists), *included in* Itoh & Beer, *supra* note 146, at 183-223; *see also* Beer, *supra* note 104, at 367-69. Experts on constitutional law in Japan disagree on whether Japan protects commercial expression under the right to freedom of expression. Some say commercial expression is not protected in Japan, Krotoszynski, *supra* note 104, at 220, while others state that such expression is protected but to a lesser extent than political expression. Matsui, *supra* note 104, at 159 (noting the Supreme Court of Japan “has held there is no reason to deny fundamental human rights to corporations,” and has extended free expression protection to mass media organizations); *id.* at 196-97 (stating that many commentators believe political speech deserves stronger protection than commercial speech); Nobuyoshi Ashibe, Kenpō [Constitutional Law] 186 (5th ed. 2011) (commercial speech is protected in Japan, but to a lesser extent); *cf.* Chiteki Zaisan Kōtō Saibansho [Intellectual Prop. High Ct.] Mar. 19, 2008, 2007 (Ne) no. 10057, 1269 Hanrei Taimuzu [Hanta] 288 (Japan) (declining to consider the free expression argument of the defendant in a case involving the ELLE mark).

149. Matsui, *supra* note 104, at 202-03 (discussing cases upholding the constitutionality of Article 230 of the Criminal Code and Article 709 of the Civil Code).

150. *Id.* at 206 (discussing Article 7 of the Child Prostitution and Child Pornography Prohibition Act).

151. *Id.* at 204-07 (discussing cases upholding the constitutionality of Article 175 of the Criminal Code which prohibits the sale, distribution, and public display of obscene materials and the possession of obscene materials for sale) (citing Saikō Saibansho [Sup. Ct.] Mar. 13, 1957, 1953 (A) no. 1713, 11 Saikō Saibansho Keiji Hanreishū [Keishū] 997 (Japan) [*Koyama v. Japan—the Lady Chatterley’s Lover Case*]; Saikō Saibansho [Sup. Ct.] Oct. 15, 1969, Sho 39 (A) no. 305, 23 Saikō Saibansho Keiji Hanreishū [Keishū] 1239 (Japan) [*Ishii et al. v. Japan—the de Sade Case*]); *see also* Beer, *supra* note 104, at 335-61 (discussing obscenity regulations in Japan). The Court has found, however, that certain images of male sexual organs in an imported book of portraits by famous photographer Robert Mapplethorpe were not obscene due in part to the artistic nature of the book. Matsui, *supra* note 104, at 206 (discussing Saikō Saibansho [Sup. Ct.] Feb. 19, 2008, 2003 (Gyo-Tsu) No. 157, 62 Saikō Saibansho Minji Hanreishū [Minshū] 69 (Japan) [*Asai v. Japan—the Mapplethorpe Case*]).

Unless a national constitution explicitly provides that the right to freedom of expression includes a right to register offensive language as a trademark, which is unlikely, any free speech right to trademark registration would need to be recognized (or created) by national courts interpreting the scope of their constitutional provisions protecting the right to freedom of expression. This is what the Federal Circuit did in *Tam* when it held that the Free Speech Clause in the First Amendment applies to Section 2(a) of the Lanham Act and government refusals to register trademarks that may disparage others.

Regardless of whether the U.S. Supreme Court affirms *Tam*, a U.S. court's analysis of the constitutionality of Section 2(a) of the Lanham Act would only be relevant as persuasive authority in other countries when courts consider the constitutionality of trademark laws banning registration of offensive marks. While there are some similarities in the laws of nations that protect the right to freedom of expression, the differences can be significant.¹⁵² An identical regulation of expression may be constitutional in one nation and unconstitutional in another. For example, Germany has laws prohibiting Holocaust denials and other hate speech,¹⁵³ but such regulations of political expression would be unconstitutional under the First Amendment in the United States.¹⁵⁴

***C. The Right to Freedom of Expression Should Not
Include the Right to Register Offensive Language
as a Trademark and Obtain Trademark Protection
in that Language***

As noted by commentators, over-expansive government regulations of trademarks can violate the right to freedom of expression in the United States and other countries.¹⁵⁵ While

152. See generally Barendt, *supra* note 104; Krotoszynski, *supra* note 104.

153. Barendt, *supra* note 104, at 172, 176-77, 180-01, 182-83 (discussing regulations of hate speech in Germany and the German Constitutional Court's holding that it is constitutional to make Holocaust denial a criminal offense); Krotoszynski, *supra* note 104, at 93-138 (discussing German law).

154. Barendt, *supra* note 104, at 183 (noting the general consensus among scholars is that hate speech laws "would, and should, be struck down as incompatible with the First Amendment" because the expression—however unpleasant and offensive—is protected political speech unless it falls within the narrow category of fighting words).

155. See generally Jacqueline D. Lipton, Internet Domain Names, Trademarks and Free Speech (2010); Sakulin, *supra* note 111; Rochelle C. Dreyfuss, *Reconciling Trademark Rights and Expressive Values: How To Stop Worrying and Learn To Love Ambiguity in Trademark Law and Theory*, *supra* note 11, at 261; Annette Kur & Henning Grosse Ruse-Kahn, *Enough Is Enough—The Notion of Binding Ceilings in International Intellectual Property Protection in Intellectual Property Rights in a Fair World Trade System: Proposals for Reform of TRIPS 359-407* (Annette Kur & Marianne Levin eds., 2011); Andreas Rahmatian, *Trade Marks and Human Rights*, in *Intellectual Property and Human Rights*,

human rights treaties and constitutional laws protecting freedom of expression do not explicitly recognize a free speech right to register an offensive mark, the U.S. Supreme Court and foreign courts could follow the approach of the Federal Circuit in *Tam* and recognize such a right. For the reasons set forth below, this path is not recommended. If courts want to allow registration and protection of offensive trademarks, they should justify this rule under a property rights rationale or other public policy unrelated to freedom of expression.¹⁵⁶

supra note 11, at 348-51; Ramsey, *Reconciling*, *supra* note 9; Lisa P. Ramsey, *First Amendment Limitations on Trademark Rights*, in 3 *Intellectual Property and Information Wealth: Issues and Practices in the Digital Age* 147 (Peter K. Yu ed., 2007); Rebecca Tushnet, *Truth and Advertising: The Lanham Act and Commercial Speech Doctrine*, in *Trademark Law and Theory*, *supra* note 11, at 294; Martin R.F. Senftleben, *Free Signs and Free Use: How to Offer Room for Freedom of Expression Within the Trademark System*, in *Research Handbook on Human Rights and Intellectual Property*, *supra* note 122, at 354; Margreth Barrett, *Domain Names, Trademarks, and the First Amendment: Searching for Meaningful Boundaries*, 39 Conn. L. Rev. 973 (2007); Ann Bartow, *Likelihood of Confusion*, 41 San Diego L. Rev. 721, 724-816 (2004); Michael K. Cantwell, *Confusion, Dilution, and Speech: First Amendment Limitations on the Trademark Estate*, 87 TMR 48 (1997); Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 Wis. L. Rev. 158; Rochelle C. Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 Notre Dame L. Rev. 397 (1990); Christophe Geiger, *Trade Marks and Freedom of Expression—The Proportionality of Criticism*, 38 Int'l Rev Intell. Prop. & Competition L. 317 (2007); Christophe Geiger, "Constitutionalising" Intellectual Property Law? *The Influence of Fundamental Rights on Intellectual Property in the European Union*, 37 Int'l Rev Intell. Prop. & Competition L. 371 (2006); Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. Rev. 960 (1993); Mary LaFrance, *No Reason To Live: Dilution Laws as Unconstitutional Restrictions on Commercial Speech*, 58 S.C.L. Rev. 709 (2007); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 Yale L.J. 1687 (1999); Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 Duke L.J. 147, 216-24 (1998); Pierre N. Leval, *Trademark: Champion of Free Speech*, 27 Colum. J. L. & Arts 187 (2004); Jacqueline D. Lipton, *Commerce Versus Commentary: Gripe Sites, Parody, and the First Amendment in Cyberspace*, 84 Wash. U. L. Rev. 1327 (2006); Glynn Lunney, Jr., *Trademark Monopolies*, 48 Emory L.J. 367 (1999); William McGeeveran, *The Trademark Fair Use Reform Act*, 90 B.U. L. Rev. (2010); William McGeeveran, *Rethinking Trademark Fair Use*, 94 Iowa L. Rev. 49 (2008); William McGeeveran & Mark P. McKenna, *Confusion Isn't Everything*, 89 Notre Dame L. Rev. 253 (2013); Ramsey & Schovsbo, *supra* note 122; Ramsey, *Free Speech*, *supra* note 9; Ramsey, *supra* note 10; Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 Tenn. L. Rev. 1095 (2003); Jennifer E. Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 Cardozo L. Rev. 105 (2005); Martin R.F. Senftleben, *Keyword Advertising in Europe—How the Internet Challenges Recent Expansions of EU Trademark Protection*, 27 Conn. J. Int'l L. 39 (2011); Rebecca Tushnet, *Trademark Law as Commercial Speech Regulation*, 58 S.C. L. Rev. 737 (2007); Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After Eldred*, 44 *Liquormart*, and Bartnicki, 40 Houston L. Rev. 697, 732-39 (2003); Katja Weckström, *The Lawfulness of Criticizing Big Business: Comparing Approaches to the Balancing of Societal Interests Behind Trademark Protection*, 11 Lewis & Clark L. Rev. 671 (2007).

156. Whether *Tam*, Pro-Football, or any other trademark owner have constitutionally-protected property rights in their marks is beyond the scope of this paper, and is not relevant to the issue of whether they have a free speech right to registration of an offensive trademark. For more on the topic of whether trademark rights should be regarded as property rights, see, e.g., Megan M. Carpenter, *Trademarks and Human Rights: Oil and*

Governments protect the right to freedom of expression for a number of reasons, including to aid in the discovery of truth via the marketplace of ideas, to further democratic self-governance, to promote individual autonomy, and to foster tolerance.¹⁵⁷ Regardless of whether allowing the *use* of offensive language increases the free flow of expression, helps voters make informed decisions in elections, advances autonomy interests and self-fulfillment, or promotes tolerance, allowing the *registration* of offensive language as a trademark does not further these goals. The reason is that a trademark registration grants the trademark owner the exclusive nationwide right to use that language as a mark in connection with certain goods or services (with some limited exceptions), and infringement and dilution laws allow trademark owners to enjoin the expression of others and obtain monetary relief when their trademark rights are violated. While there are good public policy reasons to protect trademarks against unauthorized use by others in misleading commercial expression and prevent unfair competition by unscrupulous traders, the right to freedom of expression should not be invoked to justify trademark registration of a desired trademark because of the potential ability of the owner to use that right to suppress expression by others.

For example, in the United States a registered mark is presumed valid and can become incontestable in litigation (among other benefits), and thus may be more easily protected under infringement and dilution laws in the courts.¹⁵⁸ Imported T-shirts, hats, or other goods displaying registered marks can be stopped at the border by customs agents, and seized or destroyed if they are deemed to be infringing or counterfeit. Registration of a trademark may also increase the effectiveness of demand letters sent to individuals or small companies, and help trademark owners convince social media sites, search engines, online stores, or other

Water—Or Chocolate and Peanut Butter, 99 TMR 892 (2009) (arguing that trademarks are property rights but such rights are not absolute); *Anheuser-Busch Inc. v. Portugal*, App. No. 73049/01, ¶¶ 72-78 (Eur. Ct. H.R. Jan. 11, 2007), <http://www.echr.coe.int> (in trademark dispute involving the mark “Budweiser” for beer, the European Court of Human Rights said that trademarks could be regarded as property rights for purposes of human rights analysis).

157. Chemerinsky, *supra* note 14, at 969-74. See also the sources in *supra* note 104.

158. See *supra* text accompanying note 22 (discussing the benefits of registration); 15 U.S.C. § 1125(c)(2)(A)(iv) (when “determining whether a mark possesses the requisite degree of recognition” to be a famous mark protected against dilution, one relevant factor is “[w]hether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register”); McCarthy, *supra* note 16, § 32:138 (discussing application of the Lanham Act rule that registration on the Principal Register “shall be prima facie evidence” of the validity of the registered mark, and noting the majority rule is that the prima facie effect of a registration shifts the burden of proof to the challenger; that party must prove the mark is invalid by a preponderance of the evidence); *id.* § 11:43 (discussing the significance and strength of the presumption of validity).

private parties hosting or distributing expression on the Internet to take down unauthorized uses of marks that allegedly violate trademark laws or the site's terms of service.¹⁵⁹ Recognizing a *free speech right* to register offensive language does not make sense because the government's registration and protection of a trademark will likely chill use of the same words or symbols by others.

The free speech rationale for striking down the "may disparage" provision of Section 2(a) of the Lanham Act is to protect the right of people or companies to express themselves by securing a trademark registration for offensive language, and to reduce the chilling effect of government regulations on this type of expression.¹⁶⁰ If Section 2(a) of the Lanham Act banned the *use* of language that is immoral, scandalous, or which may disparage others, this law would suppress and chill expression and would likely be found unconstitutional under U.S. law even if it only applied to commercial expression. But Section 2(a) does not restrict the use of offensive trademarks; it just bans the registration of such marks. This fact, combined with the fact that trademark infringement and dilution laws do suppress expression and have a chilling effect on the use of another's trademark, is important when evaluating whether Section 2(a) and similar trademark laws violate the right to freedom of expression. Courts evaluating the constitutionality of these provisions should consider the free speech interests not just of parties claiming the right to secure a registration in offensive language, but also the free speech interests of others who may want to use that language.

In the United States, trademark infringement laws do not harm expressive values when they ban misleading uses of trademarks in commercial expression because misleading commercial speech is not protected expression under the First

159. Cf. Leah Chan Grinvald, *Shaming Trademark Bullies*, 2011 Wis. L. Rev. 625 (2011); Irina D. Manta, *Bearing Down on Trademark Bullies*, 22 Fordham Intell. Prop. Media & Ent. L.J. 853 (2012); Ramsey, *supra* note 19, at 857, 867-68 (discussing notice-and-takedown procedures of social media sites). Registration of a mark may also make it easier to prevent others from registering domain names that contain the registered mark, as the Trademark Clearinghouse mechanism of Internet Corporation for Assigned Names and Numbers (ICANN) allows rights holders who register their marks with the Trademark Clearinghouse to obtain access to Sunrise registration with new generic top-level domain (gTLD) registries and notification from the Clearinghouse when a domain name matching the mark is registered. Trademark Clearinghouse ICANN New gTLDs, *Understanding the Trademark Clearinghouse*, <https://newgtlds.icann.org/en/about/trademark-clearinghouse> (last visited Oct. 10, 2016). The Trademark Clearinghouse will accept and verify registered trademarks, marks protected by statute or treaty, court-validated marks, and other marks that meet the requirements of the Trademark Clearinghouse. Accepted Trademarks, <http://www.trademark-clearinghouse.com/content/accepted-trademarks> (last visited Oct. 10, 2016).

160. *In re Tam*, 808 F.3d 1321, 1339-45 (Fed. Cir. 2015) (en banc), *as corrected* (Feb. 11, 2016), *cert. granted sub nom. Lee v. Tam* (U.S. Sept. 29, 2016) (No. 15-1293).

Amendment.¹⁶¹ If trademark offices only registered trademarks used in commercial contexts, and trademark laws only regulated misleading commercial expression, then the accused infringer's free speech rights would not be harmed when the government suppressed or punished that person's unauthorized use of another's trademark.

The problem is that today U.S. trademark laws are also used to regulate noncommercial expression and commercial expression that is not misleading. Political messages used as trademarks in commerce in connection with political action committee services or the sale of T-shirts and other expressive merchandise are currently being registered in the United States. An example is presidential candidate Donald Trump's trademark MAKE AMERICA GREAT AGAIN registered for political action committee services, fundraising in the field of politics, bumper stickers, stickers, advertising signs, printed publications, posters, pens, clothing, hats, campaign buttons, political campaign services, blogs and other online journals, social networking services, retail and online store services, and other goods and services.¹⁶²

In addition, the federal trademark infringement statutes do not explicitly require "commercial use" or "trademark use" of the mark for liability—they require use "in commerce" of the mark.¹⁶³ U.S. courts have applied trademark infringement laws to uses of marks in expression that would likely not qualify as commercial speech under the U.S. Supreme Court's First Amendment jurisprudence.¹⁶⁴ For example, in a trademark dispute involving the registered service mark UNITED WE STAND AMERICA "initially used by the principal campaign committee for Ross Perot's 1992 presidential campaign," the Second Circuit enforced the infringement statute against another political organization

161. *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 566 (1980).

162. *See, e.g.*, MAKE AMERICA GREAT AGAIN, Registration No. 4,773,272 ("Political action committee services, namely, promoting public awareness of political issues" and "Fundraising in the field of politics") (registered July 14, 2015 by Donald J. Trump and currently owned by Donald J. Trump for President, Inc.); MAKE AMERICA GREAT AGAIN, Registration No. 5,020,556 (various goods and services) (registered Aug. 16, 2016 by Donald J. Trump for President, Inc.).

163. 15 U.S.C. § 1114 (registered marks); 15 U.S.C. § 1125(a)(1) (unregistered marks).

164. *See, e.g.*, *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 362 (4th Cir. 2001); *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 88 (2d Cir. 1997); *Dr. Seuss Enters., L.P. v. Penguins Books USA, Inc.*, 109 F.3d 1394, 1396 (9th Cir. 1997); *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 771-73 (8th Cir. 1994); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 202 (2d Cir. 1979); *SMJ Group, Inc. v. 417 Lafayette Rest. LLC*, 439 F. Supp. 2d 281, 291 (S.D.N.Y. 2006); *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d 1430, 1440 (S.D.N.Y. 1997), *aff'd*, 152 F.3d 920 (2d Cir. 1998); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 728 (D. Minn. 1998); *see Ramsey, supra* note 10, at 384, 395-404 (discussing how trademark regulations do not just apply to commercial speech).

using a similar name and held the “in commerce” language refers to the power of the U.S. Congress to regulate interstate commerce and does not require “commercial use” of the mark.¹⁶⁵ It is not clear whether Congress intended to create a commercial use requirement for infringement liability, but trademark owners may point out that the trademark statute’s explicit exclusion of noncommercial use of a mark from dilution liability—but not infringement liability—suggests otherwise.¹⁶⁶ On the other hand, some U.S. appellate courts have interpreted the “in connection with any goods or services” language in the Lanham Act to require commercial use of the mark for infringement liability to protect expressive interests.¹⁶⁷ In addition, claims of trademark infringement involving expressive uses of marks in artistic and literary works sold for profit are evaluated under a more stringent test in some circuits.¹⁶⁸ As the U.S. Supreme Court has not yet addressed whether commercial use of the mark is required for infringement, an accused infringer may still be sued in a jurisdiction that extends the scope of trademark infringement law to uses of marks in noncommercial expression which is protected by the First Amendment.

U.S. federal trademark infringement laws have also been applied by courts to expression which would likely not qualify as misleading under the First Amendment jurisprudence of the U.S. Supreme Court. Infringement is no longer limited to a likelihood of confusion about the source of goods or services, and can be found where consumers are likely to be confused about affiliation, sponsorship, or consent.¹⁶⁹ For example, the Eighth Circuit held

165. *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 88 (2d Cir. 1997); *see also* 15 U.S.C. § 1127 (“The word ‘commerce’ means all commerce which may lawfully be regulated by Congress.”). For more information about the “in commerce” language in the Lanham Act, *see* Graeme B. Dinwoodie & Mark D. Janis, *Trademarks and Unfair Competition: Law and Policy* 247-49 (4th ed. 2014); Ramsey, *supra* note 19, at 873-76; *see also* McCarthy, *supra* note 16, § 23:11.50 (discussing whether “trademark use” of another’s mark or “use in commerce” as defined in Section 45 of the Lanham Act are required for infringement, and concluding there are no such requirements in the infringement statute). The UNITED WE STAND AMERICA mark was registered by United We Stand America, Inc. for “conducting voter registration drives, voter forums, polls and referendums in the field of public policy, for non-business, non-marketing purposes; and issues and candidate research activities and dissemination of information in the field of public policy.” UNITED WE STAND AMERICA, Registration No. 1,844,852 (cancelled).

166. 15 U.S.C. § 1125(c)(3)(C).

167. *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research*, 527 F.3d 1045, 1051-53 (10th Cir. 2008) (quoting 15 U.S.C. § 1125(a)(1)); *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 676-77 (9th Cir. 2005); *Taubman Co. v. Webfeats*, 319 F.3d 770, 774-75, 778 (6th Cir. 2003).

168. *See, e.g., Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900-02, 906-07 (9th Cir. 2002) (*Barbie Girl* song). *See infra* note 185 (discussing the *Rogers* balancing test).

169. 15 U.S.C. § 1125(a)(1); Ramsey, *supra* note 10, at 417-421; *see generally* McKenna & Lemley, *supra* note 155.

that the “Mutant of Omaha” logo displayed on the front of T-shirts and other expressive merchandise infringed Mutual of Omaha’s trademarks.¹⁷⁰ In addition, U.S. trademark laws prohibiting the dilution of famous marks in commercial expression do not require proof “of actual or likely confusion, of competition, or of actual economic injury.”¹⁷¹ It is not clear that trademark laws regulating such nonmisleading expression would survive constitutional scrutiny under the stringent test for content-based regulations of expression set forth in *Reed* and *Sorrell*.¹⁷² Either these expansive trademark laws violate the right to freedom of expression, or the government has more leeway to regulate trademarks compared to other types of expression than the U.S. Supreme Court’s current First Amendment jurisprudence suggests.

Trademark laws do have some built-in free-speech safeguards.¹⁷³ Most trademark statutes deny trademark protection to generic terms or descriptive language that lacks acquired distinctiveness.¹⁷⁴ Trademark offices also refuse to register informational or decorative subject matter and other marks which fail to function as a trademark, such as BLACK LIVES MATTER

170. *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 398 (8th Cir. 1987).

171. 15 U.S.C. § 1125(c)(1).

172. *See Reed v. Town of Gilbert*, 576 U.S. ___, 135 S. Ct. 2218, 2226-33 (2015) (“Content-based laws—those that target speech based on its communicative content—are presumptively unconstitutional and may be justified only if the government proves that they are narrowly tailored to serve compelling state interests.”); *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 565-67 (2011) (requiring heightened judicial scrutiny for content-based regulations when the government regulates speech because of disagreement with the message it conveys, and applying this rule to regulations of commercial expression that impose “more than an incidental burden on protected expression”); *Retail Dig. Network, LLC v. Appelsmith*, 810 F.3d 638, 648 (9th Cir. 2016) (“[W]e rule that *Sorrell* modified the *Central Hudson* test for laws burdening commercial speech. Under *Sorrell*, courts must first determine whether a challenged law burdening non-misleading commercial speech about legal goods or services is content- or speaker-based. If so, heightened judicial scrutiny is required.”). It is also not clear dilution laws would satisfy the intermediate scrutiny test for regulations of nonmisleading commercial expression set forth in *Central Hudson*. *See Rebecca Tushnet, Truth and Advertising: The Lanham Act and Commercial Speech Doctrine*, in *Trademark Law and Theory*, *supra* note 11, at 312-22; LaFrance, *supra* note 155, at 711; Paul Alan Levy, *The Trademark Dilution Revision Act—A Consumer Perspective*, 16 *Fordham Intell. Prop. Media & Ent. L.J.* 1189, 1192-93 (2006); Ramsey, *supra* note 10, at 425-27 & n. 269; *see also* Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 *Tex. L. Rev.* 507 (2008). The *Central Hudson* test holds that a restriction on nonmisleading commercial speech is only constitutional if the law directly advances a substantial government interest and is no more extensive than necessary to serve the interest. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 565-66 (1980).

173. For a discussion of U.S. trademark law, *see generally* Ramsey, *supra* note 10; Ramsey, *First Amendment*, *supra* note 155. For a discussion of international trademark laws and trademark laws of other countries, *see generally* Ramsey, *Reconciling*, *supra* note 9; Ramsey, *Free Speech*, *supra* note 9. *See also* the sources in *supra* note 155.

174. *See* the sources in notes 1, 16, and 17.

or I ♥ DC displayed on the front of clothing.¹⁷⁵ In Europe, marks must be used “in the course of trade”—in a commercial context—for liability.¹⁷⁶ Australia’s trademark statute requires an allegedly infringing mark to be used “as a trade mark” for liability and does not contain a cause of action for dilution.¹⁷⁷

In addition, some nations have statutory defenses for descriptive fair use;¹⁷⁸ comparative advertising;¹⁷⁹ parody, criticism, and commentary;¹⁸⁰ news reporting and news

175. D.C. One Wholesaler, Inc. v. Chien, Opposition No. 91199035 & Cancellation No. 92053919 (T.T.A.B. Oct. 4, 2016) [not precedential] *available at* <http://ttabvue.uspto.gov/ttabvue/ttabvue-91199035-OPP-67.pdf>; U.S. Trademark Application Serial No. 86,501,005 (filed Jan. 12, 2015 by Michael Southern for clothing, and rejected on Mar. 18, 2015 because the mark BLACK LIVES MATTER for clothing “merely conveys an informational social, political, religious, or similar kind of message”); *see* John L. Welch, “I ♥ DC” Fails to Function as a Trademark for Clothing, TTAB Blog (Oct. 6, 2016), <https://thettablog.blogspot.com/2016/10/i-dc-fails-to-function-as-trademark-for.html>; Abe Sauer, *As Black Lives Matter Rush Shows, All Trademark Applications Matter*, Brandchannel (Aug. 12, 2015), <http://www.brandchannel.com/2015/08/12/trademarks-081215/>.

176. Council Regulation 207/2009, of 26 February 2009 on the Community trade mark, art. 9, 2009 O.J. (L 78) 5 (EC) [EU Trade Mark Regulation], *amended by* Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market, 2015 O.J. (L 341); Council Directive 2008/95/EC, of 22 October 2008 to approximate the laws of the Member states relating to trade marks, art. 5, 2008 O.J. (L 299/25) (EC) [EU Trade Mark Directive], *amended by* Directive 2015/2436, of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, art. 10, 2015 O.J. (L 336) 11; Case C-206/01, Arsenal Football Club Plc v. Reed, 2002 E.C.R. I-10273, para. 40 (holding that “use in the course of trade” in Article 5 of the EU Trade Mark Directive means use of another’s marks that “takes place in the context of commercial activity with a view to economic advantage and not as a private matter”).

177. Trade Marks Act 1995 (Cth) s 120 (Austl.); Burrell & Handler, *supra* note 17, at 4-6, 369-92, 412-16.

178. *E.g.*, 15 U.S.C. § 1115(b)(4) (affirmative defense for “use, otherwise than as a mark, of the party’s individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin”); 15 U.S.C. § 1125(c)(3)(A) (exclusion from dilution liability for descriptive fair use of a famous mark “other than as a designation of source for the person’s own goods or services”); EU Trade Mark Regulation, *supra* note 176, art. 12 (limitations on the effects of an EU trade mark); EU Trade Mark Directive, *supra* note 176, art. 14 (same).

179. *E.g.*, 15 U.S.C. § 1125(c)(3)(A) (exclusion from dilution liability for nominative fair use of a famous mark “other than as a designation of source for the person’s own goods or services” including use in connection with “advertising or promotion that permits consumers to compare goods or services”); Trade Marks Act 1995 (Cth) s 122(1)(d) (Austl.) (stating there is no infringement of a registered mark when “the person uses the trade mark for the purposes of comparative advertising”); Burrell & Handler, *supra* note 17, at 427.

180. *E.g.*, 15 U.S.C. § 1125(c)(3)(A) (exclusion from dilution liability for nominative fair use of a famous mark “other than as a designation of source for the person’s own goods or services” including use in connection with “identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark

commentary;¹⁸¹ and noncommercial use of another's mark.¹⁸² Courts have also protected expressive values by interpreting the scope of trademark rights narrowly, such as by finding there is no likelihood of confusion or dilution when a trademark is used by a defendant in parody, criticism, or commentary, or when the defendant is not selling any goods or services.¹⁸³ Courts also apply speech-protective trademark doctrines developed in the common law. Examples include the nominative fair use doctrine, which is applied when an accused infringer is using the mark to refer to the trademark owner,¹⁸⁴ and the *Rogers* balancing test, used in trademark cases involving unauthorized use of another's mark in the titles or content of artistic or literary expression.¹⁸⁵

owner"); see *Radiance Found. v. NAACP*, 786 F.3d 316, 330-31 (4th Cir. 2015) (applying the nominative fair use exemption from dilution liability when non-profit organization used the phrase "National Association for the Abortion of Colored People" on a website to complain about the NAACP's position on abortion).

181. *E.g.*, 15 U.S.C. § 1125(c)(3)(B).

182. *E.g.*, 15 U.S.C. § 1125(c)(3)(C); see *Radiance*, 786 F.3d at 331-32 (holding this use of the NAACP mark was a noncommercial use of the mark); *Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302 (N.D. Ga. 2008) (holding that sale of parody T-shirts could qualify as noncommercial speech and be exempt from dilution claims); *Lucasfilm Ltd. v. Media Mkt. Grp.*, 182 F. Supp. 2d 897 (N.D. Cal. 2002) (finding "Starballz" pornographic movie did not dilute the Star Wars mark because this parody was a noncommercial use of the mark).

183. *E.g.*, *Radiance*, 786 F.3d at 321-24 (finding no trademark infringement liability because defendant did not use the NAACP's mark "in connection with the sale, offering for sale, distribution, or advertising of any goods or services"); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260-63 (4th Cir. 2007) (finding no infringement or dilution based on sale of Chewy Vuiton dog toy parody of LOUIS VUITTON handbags); *Lamparello v. Falwell*, 420 F.3d 309, 313-15 (4th Cir. 2005) (finding no infringement when Reverend Falwell's trademark was used in the domain name of a website critical of him); *Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482 (10th Cir. 1987) (holding "Lardashe" parody of Jordache blue jeans did not infringe the JORDACHE mark); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29-34 (1st Cir. 1987) (holding "L.L. Bean's Back-To-School-Sex-Catalog" parody did not violate L.L. Bean's trademark rights); *ProtectMarriage.com v. Courage Campaign*, 680 F. Supp. 2d 1225 (E.D. Cal. 2010) (holding modified logo used on website that did not sell any products did not infringe plaintiff's mark); *Smith*, 537 F. Supp. 2d 1302 (granting summary judgment after finding no infringement or dilution of Wal-Mart marks by critic who displayed the phrases Walocaust, Wal-Qaeda, and Freedom-Hater-Mart on parody T-shirts); see also Ramsey, *supra* note 10, at 447-50.

184. *Toyota Motor Sales, U.S.A. Inc. v. Tabari*, 610 F.3d 1171, 175-80 (9th Cir. 2010); *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 2002); *MPS Entm't, LLC v. Abercrombie & Fitch Stores, Inc.*, 110 U.S.P.Q.2d 1287 (S.D. Fla. 2013).

185. The *Rogers* balancing test requires courts to construe trademark law to apply "only where the public interest in avoiding consumer confusion outweighs the public interest in free expression." *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989). The *Rogers* balancing test provides that "[a]n artistic work's use of a trademark that otherwise would violate the Lanham Act is not actionable unless the use of the mark has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless it explicitly misleads as to the source or the content of the work." *E.E.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) (internal quotations omitted) (discussing the *Rogers* test). This test is currently applied in trademark disputes involving the unauthorized use of another's mark in the title or content of an artistic or literary work.

Yet expression is still not adequately protected in United States trademark law.¹⁸⁶ For example, the USPTO has registered descriptive terms that lack secondary meaning such as PARK ‘N FLY for airport parking services, and informational slogans such as IF YOU SEE SOMETHING, SAY SOMETHING for promoting public awareness of public safety and security issues.¹⁸⁷ Moreover, after five years on the trademark register, such trademarks can become incontestable and no longer challenged on the ground that they lack distinctiveness.¹⁸⁸ In addition, the U.S. statutory descriptive fair use defense to trademark infringement is limited—it only applies to words or symbols used otherwise than as a mark to describe the goods or services—and contains factual questions that often cannot be resolved on a motion to dismiss or motion for

E.g., *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1239-42 (9th Cir. 2013) (holding use of retired football player’s likeness in a video game did not violate Section 43(a)); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900-02, 906-07 (9th Cir. 2002) (holding use of mark Barbie in title and content of *Barbie Girl* song was not infringement); *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1276-79 (11th Cir. 2012) (holding university claiming trademark rights in football uniforms could not prevail in infringement action against artist who included uniforms in paintings of famous football scenes in the university’s history, and sold prints and calendars incorporating those paintings); *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099-1101 (9th Cir. 2008) (holding that use of a similar name and décor of a real strip club in a video game did not infringe trademark rights); *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 924-37 (6th Cir. 2003) (finding no false endorsement when an artist included an image of Tiger Woods in a painting); *Mattel Inc. v. Walking Mt. Prods.*, 353 F.3d 792, 806-07 (9th Cir. 2003) (finding no infringement by photographer who included the Barbie doll in various poses in photographs); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp.*, 886 F.2d 490, 493-97 (2d Cir. 1989) (finding no infringement when owner of the study guide CLIFFS NOTES brought infringement action against the publisher of “Spy Notes” parody); *Twentieth Century Fox Television v. Empire Distribution, Inc.*, 161 F. Supp. 3d 902 (C.D. Cal. 2016) (finding no infringement based on use of EMPIRE mark in title of *Empire* television show); *Fortres Grand Corp. v. Warner Bros. Entm’t, Inc.*, 947 F. Supp. 2d 922, 931-34 (N.D. Ind. 2013) (finding no infringement based on use of CLEAN SLATE mark in content of *Dark Knight Rises* film); *Novalogic, Inc. v. Activision Blizzard*, 41 F. Supp. 3d 885, 897-904 (C.D. Cal. 2013) (finding no infringement when video game *Call of Duty—Modern Warfare 3* used DELTA FORCE mark and logo); *Louis Vuitton Malletier S.A. v. Warner Bros. Entm’t Inc.*, 868 F. Supp. 2d 172, 177-84 (S.D.N.Y. 2012) (granting motion to dismiss of Warner Brothers in trademark infringement action by Louis Vuitton based on use of a bag similar to Louis Vuitton bag in the content of *The Hangover: Part II* film).

186. See generally Ramsey, *supra* note 10.

187. *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189 (1985); IF YOU SEE SOMETHING, SAY SOMETHING, Registration No. 3,217,091 (registered Mar. 13, 2007 by Metropolitan Transportation Authority); Annie Karni, *MTA sees something—says stop!* New York Post (Sept. 4, 2011), http://www.nypost.com/p/news/local/mta_sees_something_says_stop_B5W9Moodq0Vl8d6NbvW5RO (discussing MTA’s enforcement of its mark against T-shirt sellers and Harvard University police); see also Ramsey, *Reconciling*, *supra* note 9, at 363-75 (discussing the USPTO’s registration of popular slogans and informational phrases).

188. 15 U.S.C. §§ 1065, 1115(b); *Park ‘N Fly*, 469 U.S. at 197-200 (discussing the incontestability provision), criticized in Kenneth L. Port, *The Illegitimacy of Trademark Incontestability*, 26 Ind. L. Rev. 519 (1993).

summary judgment.¹⁸⁹ For example, when the owner of the incontestable mark DELICIOUS for footwear sued Victoria's Secret for infringement based on its display of the word "Delicious" on the front of a tank top, the Ninth Circuit held the descriptive fair use defense must be heard by a jury because there was a genuine issue of material fact as to whether Victoria's Secret used "Delicious" as a mark and whether this word was used "only to describe" the company's goods.¹⁹⁰ The display of language on the front of clothing is usually not descriptive of the goods and may be classified as a trademark use since many trademark owners (including Victoria's Secret) display their marks on the front of clothing and other expressive merchandise.

In addition, nominative fair use doctrine may help accused infringers in cases involving comparative advertising, parody, criticism, or commentary, but not if the defendant is using this expression because of its inherent meaning or to comment about society rather than to refer to the plaintiff. The *Rogers* balancing test is only relevant in cases involving the use of marks in the titles or content of artistic or literary works, and some courts do not apply the *Rogers* test if the expression is deemed to be commercial, such as an advertisement for a video game.¹⁹¹ There is no statutory exemption or defense in federal trademark infringement law for news reporting, news commentary, comparative advertising, or noncommercial or nontrademark use of a mark, and thus bloggers, competitors, T-shirt designers, humorists, and other people engaging in such expression may not be able to determine if a threatened infringement lawsuit will be successful.¹⁹² Even if the accused infringer would likely prevail on summary judgment or at trial, many individuals and small

189. 15 U.S.C. § 1115(b)(4); *see, e.g.*, *Fortune Dynamic, Inc. v. Victoria's Secret Store Brand*, 618 F.3d 1025, 1039-43 (9th Cir. 2010). Courts also send other trademark defenses to the jury rather than resolve them on summary judgment. *See e.g.*, *Parks v. LaFace Records*, 329 F.3d 437, 448-59 (6th Cir. 2003) (in false endorsement dispute involving use of name of Rosa Parks in the title of a song, the court held the *Rogers* balancing test applied but reversed the district court's finding of no infringement on summary judgment and remanded for a jury trial because the artistic relationship between the title and the content of the song was "open to reasonable debate"). On the other hand, some courts do resolve trademark cases before trial. *See, e.g.*, *Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302 (N.D. Ga 2008) (granting summary judgment to defendant on Wal-Mart's infringement and dilution claims).

190. *Fortune Dynamic*, 618 F.3d at 1039-43.

191. *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1015-18 (3d Cir. 2008) (in action for false endorsement based on use of a famous broadcaster's voice in a commercial about the upcoming release of Madden NFL 2006, court held the advertisement was commercial speech and was not protected under the First Amendment).

192. There are some common law defenses to infringement available, such as for comparative advertising, *see, e.g.*, *Smith v. Chanel, Inc.*, 402 F.2d 562 (9th Cir. 1968) (competitor's advertisement for imitation perfume), but accused infringers may not find out about them without consulting a trademark attorney.

businesses may not be able to afford to litigate a trademark dispute. Moreover, providers of services on the Internet may take down unauthorized uses of marks at the request of trademark owners to avoid liability without considering whether this use is infringing or allowed under trademark law.

An example may demonstrate why protection of trademark rights today is more likely to suppress and chill freedom of expression than the denial of a trademark registration. Trademark registration of offensive language is similar to the government granting the Ku Klux Klan (“KKK”) a parade permit that enables it to not only express racist or anti-Semitic messages in a parade at a certain time and place, but also prevent other hate groups from expressing those exact same racist or anti-Semitic words or symbols in a parade on any day or in any location. Just as there is no free speech right to a parade permit that can be used to prevent others from using certain offensive language in a parade, it does not make sense to recognize a *free speech right* to trademark registration and protection of offensive language that could be used to stop infringing or diluting uses of that language in a slogan or displayed on a T-shirt or website. Under the Federal Circuit’s reasoning in *Tam*, the KKK could obtain a trademark registration for certain racist words or symbols used as a mark in commerce in connection with political action committee services, blogs, social networking services, or the sale of T-shirts or bumper stickers, and prevent others from using the registered mark in the exact same way.¹⁹³ Of course, the KKK would have to show that that the mark is distinctive—that consumers associate that language with the KKK’s “goods” or “services”—and this accused infringer’s use of the mark was likely to cause confusion,¹⁹⁴ but it seems strange to interpret the Free Speech Clause in the First Amendment to give one entity a trademark right that can be used to suppress and punish other people’s expression.¹⁹⁵

193. Trump has a registration for these types of goods and services. See *supra* note 162 (discussing the MAKE AMERICA GREAT AGAIN trademark registrations).

194. The KKK would not need to show likelihood of confusion about the source of the goods; a likelihood of confusion about affiliation, sponsorship or consent is sufficient. Moreover, the statute does not explicitly require the KKK to prove commercial use or a trademark use of the mark for infringement liability. If the mark becomes famous, a dilution claim may also be available regardless of whether this use of the mark is confusing or competed with the KKK’s goods or services. The descriptive fair use defense would not apply here for T-shirts and other expressive merchandise since the offensive words do not describe the clothing. Nominative fair use doctrine is irrelevant since the accused infringer is likely not using the offensive language to refer to the KKK. This is not comparative advertising. While the *Rogers* balancing test would apply to use of the offensive mark in the title or content of films, songs, video games, books, and other artistic or literary works sold by an accused infringer, it may not apply to expression on T-shirts and other merchandise unless a court deems the expression to be artistic or literary.

195. Cf. Griffiths, *supra* note 11, at 328-33 (arguing that the right to freedom of expression is not implicated by the European Union trademark law banning registration of

These potential conflicts of trademark rights and free speech rights do not just arise in trademark disputes involving offensive trademarks, but they are important because Pro-Football, Tam, and their supporters are arguing that trademark owners have a free speech right to a registration which helps them enforce trademark rights against others. If the offensive trademark provisions in Section 2(a) do not adequately protect the property rights invested in a mark or do not benefit society overall, they should be repealed by Congress for these reasons, but not because the right to freedom of expression compels such a result. Expression will be chilled regardless of whether the government denies registrations for offensive marks or grants registrations for such marks. The main difference is that the law denying registration may affect one person's decision to use the offensive mark, while the law granting registration may chill the expression of everyone else who also wants to use that language in the marketplace. If a trademark law bans registration of offensive language but still allows use of this expression, courts evaluating the constitutionality of the trademark law should think carefully about deferring to the legislature on the social utility of this law. If the legislature is democratically elected, it may be in a better position than a judge (or group of judges) to weigh the various public and private interests implicated by that trademark law that bans registration of offensive marks.

Should we recognize a free speech right to trademark registration and protection of offensive marks if the government disapproves of the message conveyed by the trademark and wants to discourage its use in the marketplace to protect morality and the public? Some scholars believe that freedom of expression is implicated whenever expression "is regulated because of a message that the regulator wishes to suppress, alter, or otherwise affect."¹⁹⁶ The Federal Circuit in *Tam* claimed that Section 2(a) is an unconstitutional content-based law because the government wants to discourage the use of offensive language as a trademark and encourage the selection of non-offensive trademarks.¹⁹⁷ Yet it is

marks contrary to morality and public order since the law does not suppress expression, and noting that offensive trademark laws would satisfy constitutional balancing in Europe because other social values usually prevail over free expression rights in Europe); Sakulin, *supra* note 111, at 21 (arguing that "[t]here is a severe dogmatic problem when assuming that the grant, refusal, or limitation of trademark rights may impair the right to freedom of expression of the relevant trademark right holder" because (1) the right holder can still use the sign in trade and (2) a trademark right is the "antithesis of freedom of expression" since it allows the right holder to prevent others from using the sign).

196. Alexander, *supra* note 104, at 55; *id.* at 9 (arguing that freedom of expression is implicated whenever expression "is suppressed or penalized for the purpose of preventing a message from being received").

197. *In re Tam*, 808 F.3d 1321, 1334-39 (Fed. Cir. 2015) (en banc), *as corrected* (Feb. 11, 2016), *cert. granted sub nom. Lee v. Tam* (U.S. Sept. 29, 2016) (No. 15-1293).

clear from the Lanham Act that the government also wants to discourage the use in commerce of language that infringes or dilutes the trademarks of others, and encourage the use of distinctive words or symbols as trademarks rather than generic or descriptive terms. Does that mean all of these content-based trademark laws automatically violate the right to freedom of expression or are subject to strict scrutiny analysis regardless of whether the law suppresses or punishes expression, or whether it is regulating commercial or noncommercial expression?¹⁹⁸ The constitutional analysis by the Federal Circuit in *Tam* suggests this is the correct approach for the disparagement provision in Section 2(a).¹⁹⁹ The court did not discuss whether its free speech analysis in *Tam* should be applied to other provisions of the trademark laws, including laws that ban and punish infringement and dilution of trademarks, and laws denying registration to other subject matter such as generic and descriptive terms.

Critics of the immoral, scandalous, or “may disparage” language of Section 2(a) may argue the constitutional analysis should be different since that provision is focused on morality concerns and the harm to people or groups targeted by the expression, while the provisions on infringement, dilution, distinctiveness, and generic and descriptive terms further trademark law’s goal of helping consumers identify and distinguish among competing goods or services advertised and sold in commerce.²⁰⁰ Regardless of the government’s reasons for enacting all of these trademark laws, focusing the constitutional analysis on the purpose of the government in regulating the expression is problematic in the trademark context, and would not further the various justifications for protecting the right to freedom of expression. Such a focus ignores the fact that granting a trademark registration in offensive language and protecting that trademark right against others could eventually result in the suppression and punishment of the *exact same messages* of others under trademark infringement or dilution laws.

Moreover, recent U.S. Supreme Court decisions suggest that the focus should not be on the government’s stated purpose for the law. Per the Court in *Reed*, “A law that is content based on its face is subject to strict scrutiny regardless of the government’s benign motive, content-neutral justification, or lack of ‘animus toward the ideas contained’ in the regulated speech.”²⁰¹ Yet a content-based

198. See *infra* Part IV.A.6.b for a discussion of the difference between content-neutral and content-based regulations.

199. *Tam*, 808 F.3d at 1334-39.

200. But see Grynberg, *supra* note 35 (arguing that the disparagement provision in Section 2(a) can be justified on the ground that disparaging marks do not function effectively as trademarks).

201. *Reed v. Town of Gilbert, Ariz.*, 576 U.S. ___, 135 S. Ct. 2218, 2228 (2015).

trademark law need not be subject to strict scrutiny analysis in the United States if that law does not suppress or punish expression, or cause other actionable harm to the right to freedom of expression. Such a law does not implicate the First Amendment, as explained next.

IV. DOES A TRADEMARK LAW REGULATING OFFENSIVE LANGUAGE SATISFY ALL THE ELEMENTS OF A FREE SPEECH VIOLATION?

Courts and scholars disagree on whether trademark laws banning registration of offensive marks violate the right to freedom of expression, and often they do not engage in this analysis in a systematic manner or correctly evaluate all of the issues that may arise under that country's free speech jurisprudence.²⁰² Below, this Part provides a framework of free expression issues to consider in the trademark law context, with a focus on whether there is a free speech right in the United States to registration and protection of trademark rights in an offensive mark.

A government or private party accused of violating the right to freedom of expression in a trademark dispute may argue the free expression right in a constitution, human rights treaty, or other law is not violated by that nation's trademark law because under that country's laws (1) trademark disputes are between private parties (i.e., there is no government action);²⁰³ (2) there is no suppression or punishment of expression, or other actionable harm to freedom of expression, in this trademark dispute;²⁰⁴ (3) trademarks do not qualify as protected "expression;"²⁰⁵ (4) this

202. See, e.g., *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015) (en banc), *as corrected* (Feb. 11, 2016), *cert. granted sub nom.* *Lee v. Tam* (U.S. Sept. 29, 2016) (No. 15-1293); *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015), *appeal docketed*, No. 15-1874 (4th Cir. Aug. 6, 2015), *petition for cert. filed* (U.S. Apr. 25, 2016) (No. 15-1311); and the sources cited in *supra* note 11.

203. In the United States, some courts have held that the constitutional requirement of state action is not satisfied in private civil trademark litigation. *E.g.*, *Empire Home Servs., L.L.C. v. Empire Iron Works, Inc.*, No. 05-CV-72584, 2007 WL 1218717, at *8 (E.D. Mich. Apr. 23, 2007) (finding defendant's constitutional argument unpersuasive because "government restraints on commercial speech" are "simply not present in an intellectual property dispute between two private parties"); *Reddy Commc'ns, Inc. v. Envtl. Action Found., Inc.*, 199 U.S.P.Q. 630, 633-34 (D.D.C. 1977); *Interbank Card Ass'n v. Simms*, 431 F. Supp. 131, 133-34 (M.D.N.C. 1977). This is not correct. See Ramsey, *supra* note 10, at 385, 407-09; *infra* Part IV.A.1.

204. See, e.g., *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981). This issue is discussed *infra* Part IV.A.2.

205. In the United States, some courts explicitly or implicitly argue that certain uses of a mark which are actionable under trademark infringement laws do not qualify as First Amendment "speech" because the expression is used to identify the source of a product rather than communicate a message. *E.g.*, *SMJ Grp. v. 417 Lafayette Rest. LLC*, 439 F. Supp. 2d 281, 291 (S.D.N.Y. 2006); *Gucci Am., Inc. v. Hall & Assocs.*, 135 F. Supp. 2d 409,

is speech of the government or a corporation rather than expression of an individual;²⁰⁶ (5) a categorical exclusion from free expression protection applies to this type of expression regulated by the trademark law;²⁰⁷ or (6) the law is subject to less rigorous scrutiny because the expression is commercial or the law is a content-neutral regulation of expression, and the law satisfies the relevant balancing test in national, regional, or international laws requiring protection of the right to freedom of expression.²⁰⁸ Several of these arguments were made by the government and judges in the trademark disputes involving the REDSKINS and THE SLANTS marks.²⁰⁹ As explained below, some of these

418 (S.D.N.Y. 2001); *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d 1430, 1440 (S.D.N.Y. 1997), *aff'd*, 152 F.3d 920 (2d Cir. 1998). This is not correct. *See Ramsey, supra* note 10, at 385, 409-12; *infra* Part IV.A.3.

206. *See, e.g., In re Tam*, 808 F.3d at 1376 (Lourie, J., dissenting); *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 458-62 (E.D. Va. 2015), *appeal docketed*, No. 15-1874 (4th Cir. Aug. 6, 2015), *petition for cert. filed* (U.S. Apr. 25, 2016) (No. 15-1311). Section 2(a) does not regulate government speech. *See infra* Part IV.A.4.

207. While trademark infringement law primarily regulates misleading commercial expression, which is not protected expression, trademark laws also regulate noncommercial expression and commercial expression that is not misleading. *See Ramsey, supra* note 10, at 385, 414-21; *see infra* Part IV.A.5 & Part IV.A.6.a.

208. In trademark disputes in the United States, some courts have characterized what is arguably noncommercial expression as commercial expression. *E.g., World Wrestling Fed'n Entm't v. Bozell*, 142 F. Supp. 2d 514, 525-26 (S.D.N.Y. 2001); *People for the Ethical Treatment of Animals v. Doughney*, 113 F. Supp. 2d 915, 919 (E.D. Va. 2000), *aff'd on other grounds*, 263 F. 3d 359, 362-63 (4th Cir. 2001); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 735 (D. Minn. 1998). In addition, some U.S. courts erroneously treat trademark laws like content-neutral speech regulations, and argue that trademark rights “need not yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist.” *E.g., Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) (internal quotes omitted); *Univ. of Kan. v. Sinks*, 565 F. Supp. 2d 1216, 1262 (D. Kan. 2008) (citing *Dallas Cowboys*, 604 F.3d at 206); *cf. San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522 (1987) (holding that the law prohibiting certain uses of the Olympics words and symbols was a content-neutral regulation of expression that satisfied intermediate scrutiny under the *O'Brien* test). These holdings are not correct; trademark laws are content-based regulations of commercial and noncommercial expression in the United States. *Ramsey, supra* note 10, at 421-46; *infra* Part IV.A.6.

209. Examples of these arguments will be included below in the sections discussing these issues. The Federal Circuit also said that the uncertainty created by Section 2(a) “contributes significantly to the chilling effect on speech” and explained that “uncertainty of speech-affecting standards has long been recognized as a First Amendment problem” under overbreadth doctrine and “Fifth Amendment vagueness standards as they have been specifically applied in the First Amendment setting.” *Tam*, 808 F.3d at 1342 (citing *Broadrick v. Oklahoma*, 413 U.S. 601, 613, 615 (1973) (overbreadth doctrine); *Reno v. ACLU*, 521 U.S. 844 871-72 (1997) (discussing the chilling effect of vague laws); *Village of Hoffman Estates v. Flipside, Hoffman Estates, Inc.*, 455 U.S. 489, 499 (1982) (noting “a more stringent vagueness test should apply” when the law interferes with the right of free speech); *Fed. Comm’n v. Fox Television Stations, Inc.*, ___ U.S. ___, 132 S. Ct. 2307, 2317-18 (2012) (stating that the void for vagueness doctrine addresses due process concerns)). As several trademark laws are vague and not narrowly tailored to achieve their goals, *Tushnet, supra* note 11, at 35-38; *see also Graeme B Dinwoodie, Lewis & Clark Law School Ninth Distinguished IP Lecture: Developing Defenses in Trademark Law*, 13 *Lewis &*

arguments are incorrect under U.S. free speech law as applied to Section 2(a) of the Lanham Act, but they may be correct in other trademark contexts and in other jurisdictions. If just one of these arguments is correct (e.g., there is no suppression or punishment of expression, or other actionable harm to expression), then the trademark law may not implicate the right to freedom of expression in that country; in such a situation, all the elements of a “free speech violation” are not satisfied.

When determining whether a trademark law conflicts with the right to freedom of expression in a country, courts should first determine the “elements” that must be satisfied for there to be a free speech violation under that nation’s constitution, human rights treaties, or other laws protecting the right to freedom of expression.²¹⁰ Second, courts should determine whether all of these elements of a free speech violation in that country are established, with the burden of proof resting on the government or the private party who is using trademark law to allegedly violate the right to freedom of expression.²¹¹ Just like the elements of a cause of action for trademark infringement,²¹² if any of these elements of a free speech violation is missing, then the trademark law does not violate the free expression right under the laws of that country. Admittedly, this proposed framework for evaluating the constitutionality of a trademark law oversimplifies several complicated doctrines in freedom of expression law, and it focuses on U.S. free speech doctrine. In addition, the framework will not apply in constitutional analysis of other laws which require consideration of different issues. Nevertheless, in trademark disputes these issues have all been raised (but usually not all in the same opinion, brief, or law review article), and it is helpful to consider each issue in an organized and comprehensive manner.

Clark L. Rev. 99, 115-17, 122 (2009); Tushnet, *Gone*, *supra* note 172 (discussing dilution laws), it is unlikely the U.S. Supreme Court will find Section 2(a) unconstitutional solely on this basis since this reasoning might require the invalidation of other trademark laws that are vague and overbroad. The chilling effect of Section 2(a) is discussed *infra* Part IV.A.2.

210. This test assumes the court has already determined that the government has an obligation under a constitution, human rights treaty, or other law to protect the right to freedom of expression. See *supra* Part III.A & B.

211. See *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 567 (2011) (noting the government has the burden to show the law is consistent with the First Amendment); *Edenfield v. Fane*, 507 U.S. 761, 768-71 (1993); *Zauderer v. Office of Disciplinary Counsel of the Supreme Court of Ohio*, 471 U.S. 626, 646 (1985) (stating “the free flow of commercial information is valuable enough to justify imposing on would-be regulators the costs of distinguishing the truthful from the false, the helpful from the misleading, and the harmless from the harmful”); see also *Ramsey*, *supra* note 10, at 421 (stating that “the burden of proof on the misleading or commercial nature of the speech should remain with the trademark holder or the government”).

212. See, e.g., Ninth Circuit Manual of Model Civil Jury Instructions, 15.5 Infringement—Elements and Burden of Proof—Trademark (15 U.S.C. § 1114(1), <http://www3.ce9.uscourts.gov/jury-instructions/node/233> (last visited June 13, 2016)).

While some commentators have argued that U.S. courts should subject trademark laws to more First Amendment scrutiny, courts generally do not engage in constitutional analysis of trademark laws.²¹³ Instead of applying strict scrutiny or intermediate scrutiny analysis, U.S. courts usually protect expressive values in trademark cases by interpreting the statute in speech-protective ways or creating speech-protective trademark rules in the common law, such as a commercial use requirement for infringement liability.²¹⁴ This approach of avoiding constitutional analysis of trademark laws was abruptly changed when the Federal Circuit held in *Tam* that Section 2(a) is unconstitutional under the First Amendment. This decision may lead courts to analyze the constitutionality of other trademark laws and also find them unconstitutional.

Below, this Part first sets forth a framework of issues for courts to consider if they are asked to evaluate whether a trademark law violates the right to freedom of expression, with a focus on U.S. law and Section 2(a) of the Lanham Act. Next this Part argues that the constitutional analysis may differ if a government enacts a law denying registration or protection of a copyright in offensive expression.

A. Potential Elements of a Free Speech Violation in Trademark Disputes

The elements for a violation of the right to freedom of expression by a trademark law in a country will depend on the content and scope of that country's trademark and free expression laws. Below are six possible elements of a free speech violation in a trademark dispute; they all contain issues to consider in the United States, and many will also be relevant in other countries. For example, under the proposed framework, the elements of a free speech violation in a trademark dispute in the United States are: (1) government action; (2) suppression or punishment of expression, or some other actionable harm to expression; (3) this use of the trademark qualifies as expression; (4) this is expression of an individual or non-government entity, rather than government speech; (5) this expression is not categorically excluded from protection; and (6) the trademark law does not satisfy constitutional scrutiny.

In trademark disputes in the United States involving enforcement of trademark rights against others accused of

213. See, e.g., Ramsey, *supra* note 10, at 450-53. For an argument against invoking the right to freedom of expression to constrain trademark rights, see Robert Burrell & Dev Gangjee, *Trade Marks and Freedom of Expression: A Call for Caution* 41 Int'l Rev. of Intell. Prop. & Competition L. 544 (2010).

214. Ramsey, *supra* note 10, at 447-50, 454-57.

infringement, the first four elements of a free speech violation are usually satisfied: (1) there is government action in the form of trademark laws or court orders; (2) there is suppression or punishment of this use of another's trademark with injunctions, monetary relief, or other penalties; (3) the defendant's use of the trademark constitutes expression (i.e., it communicates the source or quality of the goods or services, or other information or ideas); and (4) the defendant is typically an individual or non-government entity. Yet, even if the right to freedom of expression is implicated by a trademark law (i.e., elements 1-4 are satisfied), the law does not violate the free expression right if (5) the law regulates expression that is categorically refused protection under the First Amendment, such as misleading commercial expression. An example is when courts apply trademark infringement law to stop or punish a competitor's misleading use of a trademark to sell commercial products. The government also does not violate the right to freedom of expression if (6) the trademark law satisfies constitutional scrutiny. For example, a trademark infringement law banning the misleading use of the marks of political or religious groups to cause confusion about the source of free noncommercial goods or services could arguably satisfy strict scrutiny analysis under the U.S. Constitution even though the law regulates noncommercial use of another's mark.²¹⁵

On the other hand, the free speech right may be violated by a trademark law in the United States if (1) the government (2) suppresses or punishes (3) the expression (4) of an individual or non-government entity, and (5) this is noncommercial expression or nonmisleading commercial expression (which is not categorically excluded from free speech protection in the United States) and (6) the trademark law does not survive constitutional scrutiny. An example would be a court order in trademark litigation that enjoins noncommercial use of another's mark in a domain name linked to a website that contains criticism or parody of that trademark owner, and which does not contain any misleading expression.²¹⁶ While the court may believe this use of the mark causes a likelihood of confusion regarding whether the trademark owner consented to its use or is affiliated with the website, a government injunction banning further use of the

215. Ramsey, *supra* note 10, at 444.

216. In one case with similar facts the Fourth Circuit held that an arguably noncommercial use of a trademark was commercial expression and affirmed the district court's finding of trademark infringement and other trademark violations. *See People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 362-63 (4th Cir. 2001) (affirming summary judgment for plaintiff where defendant used the PETA mark in the domain name peta.org that linked to a "People Eating Tasty Animals" website parody; PETA asked the court to enjoin use of the PETA mark and order the transfer of the domain name to PETA).

trademark owner's mark by that individual implicates the free speech right and is unlikely to survive the strict constitutional scrutiny used for content-based regulations of nonmisleading expression.²¹⁷

As discussed in more detail below, when Section 2(a) of the Lanham Act bans the registration of a mark that is immoral or scandalous or which may disparage others, there is government action (element 1), the trademarks qualify as expression (element 3), the law applies to the expression of people and non-government entities (element 4), and most of the offensive language banned from registration under Section 2(a) is not categorically excluded from protection under the right to freedom of expression in the United States (element 5). This article argues, however, that the offensive mark provisions of Section 2(a) do not implicate the First Amendment because Section 2(a) does not suppress or punish the trademark owner's use of the expression, or cause some other actionable harm to expression (element 2). If the U.S. Supreme Court disagrees, and finds the First Amendment is implicated by this law, the Court should subject this content-based law regulating commercial and noncommercial expression to strict constitutional scrutiny (element 6), which is usually fatal,²¹⁸ or explain why the constitutionality of trademark laws should not be evaluated under the Court's traditional First Amendment jurisprudence.

1. Government Action: Who Is Regulating the Expression?

When determining whether a trademark law implicates or violates the right to freedom of expression, courts may want to first focus on who is regulating the expression. In the United States, the free speech guarantee "restricts only government action, not action by private employers, property owners, householders, churches, universities, and the like."²¹⁹ Most other countries also require government action (also known as "state action") for a free speech violation, although there are some exceptions, such as Germany.²²⁰ If the law in a country provides that the right to

217. *Reed v. Town of Gilbert*, 576 U.S. ___, 135 S. Ct. 2218, 2226-33 (2015); *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 565-75 (2011); *see also* Ramsey, *supra* note 10, at 384-85, 424-25, 445; *id.* at 417-21 (discussing how trademark infringement law is applied to commercial uses of trademarks that would not qualify as misleading under the U.S. Supreme Court's free speech jurisprudence).

218. *Reed*, 135 S. Ct. at 2226-33; *In re Tam*, 808 F.3d at 1334-37.

219. Volokh, *supra* note 132, at 409; *see also* Krotoszynski, *supra* note 104, at 98-102.

220. Krotoszynski, *supra* note 104, at 99 (citing Dieter Grimm, *Human Rights and Judicial Review in Germany*, in *Human Rights and Judicial Review: A Comparative Perspective* 276 (David M. Beatty, ed. 1994); Dieter Grimm, *Judicial Activism*, in *Judges in Contemporary Democracy: An International Conversation* 17, 21 (Robert Badinter &

freedom of expression is not implicated without some sort of involvement by the government—such as a statute that prohibits or punishes expression, or a court order enforcing such a law²²¹—then the first element of a free speech violation in a trademark dispute is government action.²²²

Government action in trademark enforcement. There is government action in trademark disputes when governments protect trademark rights. This would include the legislature's enactment of a statute banning the use of counterfeit marks or the unauthorized use of another's trademark which may infringe or dilute that mark. There is also government action when a court enjoins the use of that trademark with an injunction, or punishes the defendant's use of the mark with jail time, fines, or an award of monetary relief. In the United States, it does not matter that civil litigation involving expression is initiated by a private party rather than the government; if the government is involved in enforcing the private party's rights and it suppresses or punishes expression to protect those rights, then there is government action and this element of a free speech violation is satisfied.²²³ Government enforcement of private trademark rights therefore

Stephen Breyer eds. 2004)); Mark Tushnet, *Weak Courts, Strong Rights: Judicial Review and Social Welfare Rights in Comparative Constitutional Law* (2008) (discussing the law in Canada and Germany); Mark Tushnet, *The Issue of State Action/Horizontal Effect in Comparative Constitutional Law*, 1 Int'l J. Const. L. 79 (2003) (discussing the law in Canada, Czech Republic, Germany, South Africa, and the United States); see also Griffith, *supra* note 11, at 323 (noting the European Convention on Human Rights binds only contracting state parties); Sakulin, *supra* note 111, 111-12 (same). For example, Japan has a state action requirement. Krotoszynski, *supra* note 104, at 142. Yet, as noted by Professor Krotoszynski, "[t]o the extent freedom of speech faces serious threats in Japan, those threats are much more a function of privately imposed constraints than of official government repression or censorship . . . It is not always the government that is the enemy of freedom of expression; corporations, churches, and communities can be far more effective at stifling dissent than bureaucrats and misguided police chiefs." *Id.* at 141 (internal citations omitted).

221. Chemerinsky, *supra* note 14, at 1015-16 (noting statutes prohibiting speech and authorizing criminal punishment must satisfy constitutional scrutiny, and also court orders and licensing systems precluding speech without a permit); see also *id.* at 532-42 (explaining that the "state action" doctrine applies to governments at all levels, including federal, state, and local, and to the conduct of government officers in all branches, including legislative, judicial, and administrative).

222. Note the focus of this element is on the word "government"—who is regulating the expression—not on the word "action"; in the proposed framework, the action by that party is the second element of a free speech violation, which focuses on what that party does (e.g., suppression, punishment, denial of a benefit due to expression) or does not do (e.g., registration) to the expression. In addition, the expression of the government—government speech—is addressed in the fourth element of the framework.

223. See *N.Y. Times v. Sullivan*, 376 U.S. 254, 265 (1964) (finding state action in a civil libel lawsuit between private parties where the Alabama court enforced a law which imposed invalid restrictions on the freedoms of speech and the press, and holding that "[t]he test is not the form in which state power has been applied but, whatever the form, whether such power has in fact been exercised").

qualifies as state action in the United States.²²⁴ On the other hand, if a nation believes that the right to freedom of expression is a negative liberty that only prohibits government censorship and punishment of expression, then a court may find there is no free speech violation if a private party enforces its trademarks in court against another private party and obtains an injunction and damages.

Government action in trademark registration. A government statute or regulation prohibiting a trademark office from registering an offensive trademark is also government action. In addition, there is government action when the trademark office denies registration of offensive language, or a court orders cancellation of a registration for such a mark. In the trademark cases involving the REDSKINS, THE SLANTS, and FUCT trademarks there is government action, and therefore courts must evaluate the other elements of a free speech violation to determine if the law is constitutional.

Regulation of trademarks by private parties. A government action element of a free speech violation would not be met if private parties restrict expression in trademark disputes without the involvement of the government. For example, Facebook bans infringing use of a trademark in its terms of service and has removed posts containing unauthorized use of a trademark after receiving complaints about trademark violations from trademark owners.²²⁵ This conduct by a private party suppresses expression, but it is not government action (and it may be justified if this use of the mark is infringing). If there is no infringing use of the mark and the complainant is a trademark bully who is abusing Facebook's notice-and-takedown system to stop criticism or parody of the company, then removal of the post by Facebook may harm the free flow of information and ideas but it does not constitute a free speech violation in a country that has a government action requirement. If someone complains in litigation about this private suppression of expression that incorporates another's trademark, and a court upholds the private party's contractual right to remove expression, this involvement by the

224. *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 30 n.2 (1st Cir. 1987); *U.S. Jaycees v. Phila. Jaycees*, 639 F.2d 134, 146 n.9 (3d Cir. 1981); *McCarthy*, *supra* note 16, § 31:143; *Denicola*, *supra* note 155, at 190 n.146; *Ramsey*, *supra* note 10, at 407-09.

225. Facebook Statement of Rights and Responsibilities, Section 4(1) (Jan. 30, 2015) (last visited Oct. 19, 2016), <https://www.facebook.com/terms> (Facebook reserves the right to remove or reclaim a username if "a trademark owner complains about a username that does not closely relate to a user's actual name"); *id.* Section 5(1) ("You will not post content or take any action on Facebook that infringes or violates someone else's rights or otherwise violates the law."); *id.* Section 5(5) ("If you repeatedly infringe other people's intellectual property rights, we will disable your account when appropriate."); *Ramsey*, *supra* note 19, at 852-54, 867-68 (discussing trademark disputes on social media sites and their terms of service banning infringement).

government may qualify as state action depending on the constitutional laws of that country.²²⁶

2. Suppression, Punishment, and Other Actionable Harms to Expression: How Does the Regulation Harm Expression?

When determining whether a trademark law violates the right to freedom of expression, the second issue courts should focus on is how this regulation harms expression. If a country's free speech doctrine states that the right to freedom of expression may be implicated by suppression or punishment of expression and other types of regulations that harm expression without banning or penalizing it (such as a law that compels expression), then the second element of a free speech violation in that country would include suppression or punishment of expression and these other types of harms. In this article, the phrase "suppression" is used to refer to a court injunction or law that is a prior restraint on expression,²²⁷ and "punishment" refers to jail time or a court order requiring payment of a fine or an award of monetary remedies. As explained below, a denial of a benefit (such as a tax exemption, monetary subsidy, or trademark registration) due to the content of expression is a different type of harm compared to suppression or punishment of expression as those terms are used in the article.

Suppression or punishment of the use of another's trademark. The "harm to expression" element of a free speech violation would be satisfied in a trademark enforcement dispute where the government suppressed or punished the infringing, diluting, or counterfeit use of another's trademark.²²⁸ This includes

226. *Cf. Shelley v. Kraemer*, 334 U.S. 1 (1948) (holding that state court enforcement of racially restrictive covenants constituted state action and violated the Equal Protection Clause of the U.S. Constitution), *discussed in* Chemerinsky, *supra* note 14, at 552-53 (discussing the entanglement exception to the state action doctrine, which provides that "the Constitution applies if the government affirmatively authorizes, encourages, or facilitates private conduct that violates the Constitution" including judicial enforcement actions; he notes judges are government actors and judicial remedies are state action, but *Shelley* remains controversial because "ultimately everything can be made state action under it").

227. Lemley & Volokh, *supra* note 155, at 216-24 (discussing prior restraint doctrine in the trademark context).

228. Injunctive relief is available in trademark disputes upon a finding of a trademark violation and a showing of irreparable harm. *See* *Herb Reed Enters., LLC v. Florida Entm't Mgmt. Inc.*, 736 F.3d 1239, 1247-50 (9th Cir. 2013); *see also* Case C-487/07, *L'Oréal v. Bellure*, 2009 E.C.R. I-5185 (brand owners can seek injunctive relief for infringement in the online marketplace of eBay); Case C-278/08, *BergSpechte v. Trekking*, 2010 E.C.R. I-2517 (noting that the court may enjoin use of another's mark in keyword advertising). In the United States, a few courts have considered whether certain injunctions in trademark disputes violate the right to freedom of expression. *See, e.g., Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1016 (9th Cir. 2004) (holding that a lower court's injunction

a trademark statute that gives courts discretion to enjoin use of a trademark, award damages, or require jail or payment of a fine for a trademark violation. It also includes court orders enforcing these laws, such as an injunction prohibiting infringing or diluting use of the mark, or an award of money to the trademark owner.²²⁹ If the defendant's use of the mark constitutes misleading commercial expression, then the trademark law would be constitutional in the United States under the fifth element of a free speech violation even though this second "harm to expression" element was satisfied.

Suppression or punishment of the use of certain language as a trademark. While Section 2(a) of the Lanham Act only bans the registration of offensive terms, Canada's trademark law also prohibits the adoption or use in connection with a business of any scandalous, obscene, or immoral word or device "as a trademark or otherwise."²³⁰ Thus this Canadian trademark law, and court enforcement of the law, would satisfy the "harm to expression" element of a free speech violation and require consideration of the other elements of a free speech violation in Canada.

No suppression or punishment of expression upon denial of a trademark registration. As noted in *McGinley*, and more recently by the Eastern District of Virginia in *Pro-Football* and the dissenting judges in *Tam*,²³¹ Section 2(a)'s ban on registration of offensive expression does not suppress or punish that expression. The trademark owner can continue to use that language in commercial and noncommercial expression, and enforcement of the law does not result in a jail term, fines, or civil liability.

If a country requires suppression or punishment of expression for a free speech violation, then this element (element 2) is not satisfied by a law that only prohibits registration of an offensive trademark. In such circumstances there is no violation of the right to freedom of expression and further consideration of the constitutionality of the trademark law (element 6) is unnecessary;

prohibiting use of the Nissan trademark to make disparaging remarks and negative comments about Nissan was a viewpoint-based regulation of speech).

229. *Cf. Citizens United v. Fed. Election Comm'n*, 558 U.S. 310, 336-37 (2010) (ban on expression backed by criminal sanctions implicated the First Amendment).

230. Trade-marks Act, R.S.C. 1985, c. T-13, § 9(1)(j) (Can.) (adoption); *id.* § 11 (use); see also Scassa, *supra* note 3, at 205-07.

231. *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981); *In re Tam*, 808 F.3d 1321, 1368, 1370 (Fed. Cir. 2015) (en banc) (Dyk, J., concurring in part and dissenting in part), *as corrected* (Feb. 11, 2016), *cert. granted sub nom. Lee v. Tam* (U.S. Sept. 29, 2016) (No. 15-1293); *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 455-57 (E.D. Va. 2015), *appeal docketed*, No. 15-1874 (4th Cir. Aug. 6, 2015), *petition for cert. filed* (U.S. Apr. 25, 2016) (No. 15-1311).

the law does not implicate the right to freedom of expression.²³² On the other hand, if a country's free speech laws provide that harms to expression beyond suppression and punishment can implicate the right to freedom of expression, then courts must evaluate whether the law causes this harm to expression. In the United States, laws that do not ban or penalize expression may still be subject to constitutional scrutiny if the unconstitutional conditions doctrine applies, as discussed next.

Unconstitutional conditions doctrine should not be relevant when the government refuses to register trademarks. As explained by Professor Erwin Chemerinsky, "The unconstitutional conditions doctrine is the principle that the government cannot condition a benefit on the requirement that a person forgo a constitutional right."²³³ For example, in the United States there is generally a First Amendment right to criticize the government,²³⁴ complain about your employer,²³⁵ engage in editorializing,²³⁶ lobby public officials,²³⁷ argue for reform of the law,²³⁸ and publish a religious magazine,²³⁹ among other things. If the government conditions receipt of a tax exemption, monetary subsidy (such as welfare benefits), or another government benefit based on a requirement that the person refrain from constitutionally-protected expression, this law may be subject to constitutional scrutiny under the unconstitutional conditions doctrine.²⁴⁰

232. Cf. *Authors League of America, Inc. v. Oman*, 790 F.2d 220, 222-23 (2d Cir. 1986) (holding the manufacturing clause of the Copyright Act which denies full copyright protection to works imported in violation of 17 U.S.C. § 601 (1985) did not implicate the First Amendment right to freedom of expression because the author can still distribute the work even if the author cannot receive copyright protection for it).

233. Chemerinsky, *supra* note 14, at 1028; see also Kathleen M. Sullivan, *Unconstitutional Conditions*, 102 Harv. L. Rev. 1413 (1989).

234. *Bd. of County Comm'rs v. Umbehr*, 518 U.S. 668 (1996) (Board of County Commissioners terminated government contract in retaliation for independent contractor's criticism of county and the board; Court held First Amendment applied and used the *Pickering* balancing test); *Speiser v. Randall*, 357 U.S. 513, 518-19 (1958).

235. *Perry v. Sindermann*, 408 U.S. 593, 597-98 (1972).

236. *Fed. Comm'ns Comm'n v. League of Women Voters of Cal.*, 468 U.S. 364 (1984).

237. *Regan v. Taxation with Representation of Wash.*, 461 U.S. 540, 546 (1983).

238. *Legal Servs. v. Velazquez*, 531 U.S. 533 (2001).

239. *Rosenberger v. Rector of the Univ. of Virginia*, 515 U.S. 819, 828-37 (1995).

240. *Velazquez*, 531 U.S. 533 (restriction on the activities of lawyers receiving funds from the federal Legal Services Corporation); *Rosenberger*, 515 U.S. at 834 (state refusal to provide funds to a Christian student group that published a religious magazine); *League of Women Voters*, 468 U.S. 364 (federal statute prohibited noncommercial educational broadcasting station from engaging in editorializing if it received a grant from the Corporation for Public Broadcasting, even if it used non-federal money for the editorializing); *Sindermann*, 408 U.S. at 597 (denial of employment to professor because of his public criticism of the college's policy); *Speiser*, 357 U.S. at 518-19 (California law conditioned receipt of a veterans' property tax exemption on signing a declaration

Note, however, that there are exceptions to this rule.²⁴¹ For example, if the government is providing federal funds to support a particular government program, such as the National Endowment for the Arts' funding of artists, the government can make decisions on what to fund based on the content of the expression, although it cannot engage in viewpoint discrimination.²⁴² As explained by the U.S. Supreme Court, the Spending Clause of the U.S. Constitution gives Congress "the authority to impose limits on the use of [government] funds to ensure they are used in the manner Congress intends," including by attaching "conditions that define the limits of the government spending program—those that specify the activities that Congress wants to subsidize."²⁴³ However, Congress cannot attach "conditions that seek to leverage funding to regulate speech outside the contours of the program itself,"²⁴⁴ such as by conditioning receipt of funding to help combat the spread of HIV/AIDS to organizations that have policies affirmatively opposing prostitution and sex trafficking.²⁴⁵

Citing this First Amendment doctrine, the Federal Circuit in *Tam* held that Section 2(a) of the Lanham Act imposes an unconstitutional condition on trademark owners when it denies the benefits of trademark registration to offensive trademarks. Per

disavowing a belief in overthrowing the U.S. government by force or violence); see also Chemerinsky, *supra* note 14, at 582-83, 1028-33 (discussing the unconstitutional conditions doctrine and these cases). Note some of these cases do not expressly invoke the unconstitutional condition doctrine but commentators believe the Court applied the doctrine in these cases. *Id.*

241. *Rust v. Sullivan*, 500 U.S. 173, 192-200 (1991) (declining to apply unconstitutional conditions doctrine to federal regulation that prohibited recipients of federal funds for family planning services from providing abortion-related counseling because the government distributed those funds to promote the conveying of a particular message); *Regan*, 461 U.S. at 546, 548 (The Court upheld a provision of the federal tax law that conditioned tax-exempt status on the requirement that the organization not participate in lobbying or partisan political activities, and noted there was no attempt to suppress ideas. Per the Court, "Congress has not infringed any First Amendment rights or regulated any First Amendment activity. Congress has simply chosen not to pay for TWR's lobbying."). Chemerinsky argues these cases are inconsistent with the Court's doctrine. He believes these cases may reflect implicit balancing by the Court with the Justices weighing the burden on speech imposed by a condition against the government's justifications for the requirement, or may simply turn on the views of the Justices in the particular cases. Chemerinsky, *supra* note 14, at 1029-33.

242. *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569 (1998) (action by artists against the National Endowment for the Arts, claiming that denials of grant applications violated artists' constitutional rights).

243. *Agency for Int'l Dev. v. All. for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2328 (2013) (citing *Rust*, 500 U.S. at 195 n.4); see also *United States v. Am. Library Ass'n*, 539 U.S. 194, 211-12 (2003) (plurality) (where the government conditioned public libraries' receipt of federal money on their use of Internet filtering software, stating "when the Government appropriates public funds to establish a program it is entitled to define the limits of that program") (quoting *Rust*, 500 U.S. at 194).

244. *Agency for Int'l Dev.*, 133 S. Ct. at 2328.

245. *Id.* at 2330-31.

the court, the law discourages a trademark owner from using its desired mark because it cannot obtain a registration for it,²⁴⁶ and the premise “that denial of a benefit would chill exercise of the constitutional right” of freedom of expression “undergirds every unconstitutional conditions doctrine case.”²⁴⁷ The Federal Circuit rejected the arguments of the government and dissenting judges in *Tam* that Section 2(a) provides a government subsidy that is exempt from strict scrutiny analysis or application of the unconstitutional conditions doctrine.²⁴⁸

I agree with the Federal Circuit that Section 2(a) is not a law providing a monetary subsidy,²⁴⁹ but disagree that the unconstitutional conditions doctrine should apply in the context of the government’s denial of a trademark registration. The reason is that Section 2(a) of the Lanham Act is substantially different from the laws in these other cases that invoke the unconstitutional conditions doctrine. The differences include (1) the condition imposed on the recipient of the benefit, and (2) the benefit sought by the party claiming a free speech violation.

First, Section 2(a) does not require the trademark owner to forgo its constitutionally-protected right to freedom of expression to receive this benefit of registration. The trademark owner can continue to use offensive language as a trademark or otherwise regardless of whether it also registers marks that meet the criteria of Section 2(a) of the Lanham Act. To qualify for registration, the mark must not be immoral, scandalous, or potentially disparaging, but this condition on *registration* of a mark (like the requirement that a mark not be generic or deceptive) is not a condition on the *expression* of the trademark owner. This is a critical fact that makes Section 2(a) so different from the other laws that required the recipient of a benefit to agree to not criticize the government,²⁵⁰ not engage in editorializing,²⁵¹ not lobby public officials,²⁵² or not argue for reform of the law.²⁵³ Put another way,

246. *In re Tam*, 808 F.3d 1321, 1334, 1348-55 (Fed. Cir. 2015) (en banc), *as corrected* (Feb. 11, 2016), *cert. granted sub nom. Lee v. Tam* (U.S. Sept. 29, 2016) (No. 15-1293).

247. *Id.* at 1340.

248. *Id.* at 1348, 1351; En Banc Brief for Appellee, *supra* note 33, at 29 (“Congress has at least as much discretion to determine which terms and symbols should be registered and published by a federal agency as it would to determine which private entities should receive federal funds.”); *Tam*, 808 F.3d at 1368-70 (Dyk, J., concurring in part and dissenting in part).

249. *Tam*, 808 F.3d at 1353 (stating “[t]he benefits of trademark registration, while valuable, are not monetary,” and “the system of trademark registration is a regulatory regime, not a government subsidy program”).

250. *Bd. of County Comm’rs v. Umbehr*, 518 U.S. 668 (1996); *Speiser v. Randall*, 357 U.S. 513, 518-19 (1958).

251. *Fed. Comm’ns Comm’n v. League of Women Voters of Cal.*, 468 U.S. 364 (1984).

252. *Regan v. Taxation with Representation of Wash.*, 461 U.S. 540, 546 (1983).

253. *Legal Services v. Velazquez*, 531 U.S. 533, 534-38 (2001).

Section 2(a) is a restriction on the words that can be registered, and not on the words that can be used by the person who obtains the benefit of registration of a trademark that does not violate Section 2(a).

While the government may not want to expend government resources in registering offensive marks or appear to endorse the use of such marks,²⁵⁴ Section 2(a) is not like the laws in the federal funding cases—in which limits were imposed on the expression of recipients of the money—because Section 2(a) does not award public money to trademark owners (there is no disbursement of funds) and the law does not impose any limits on expression or compel private parties to engage in expression.²⁵⁵ Even if Section 2(a) imposes a “financial disincentive to the use of [offensive] marks in commercial communication,”²⁵⁶ or has a chilling effect on the use of offensive language as a mark,²⁵⁷ this is not due to any requirement to forgo constitutionally-protected expression. The Lanham Act’s prohibition on the registration of generic and deceptive terms also creates a financial disincentive to use such language as a mark and has similar chilling effects on use of the expression, but—like Section 2(a)—these laws do not ban the use of this language, nor do they ban any expression. The chilling effect of a law should not by itself be sufficient to make that law an unconstitutional condition on expression, especially when that law still allows use of the expression upon either receipt or denial of the benefit.

Second, the benefits of registration under the Lanham Act are valuable,²⁵⁸ but they are significantly dissimilar to the benefits in the cases that apply the unconstitutional conditions doctrine. There is no tax exemption, monetary subsidy, or similar government benefit at issue here. A person did not lose his job because of his expression. The Federal Circuit notes that “the scope of the subsidy cases has never been extended to a ‘benefit’ like recognition of legal rights in speakers against private interference.”²⁵⁹ True, but the U.S. Supreme Court has also not applied the unconstitutional conditions doctrine to trademark law or the grant of a private right to suppress and punish another’s

254. *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981) (“We do not see this as an attempt to legislate morality, but, rather, a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government.”); *see also* En Banc Brief for Appellee, *supra* note 33, at 16, 21, 41, 43.

255. Thus it does not run afoul of the rule in *Agency for Int’l Dev. v. All. for Open Soc’y Int’l, Inc.*, 133 S. Ct. 2321, 2328 (2013).

256. Lefstin, *supra* note 11, at 678, *cited in Tam*, 808 F.3d at 1341.

257. *Tam*, 808 F.3d at 1339-45.

258. *See supra* text accompanying note 22 (summary of benefits set forth in the *Tam* decision).

259. *Tam*, 808 F.3d at 1351.

expression that uses the same language as that private party. Unlike a trademark registration, a tax exemption or monetary subsidy does not give the recipient an exclusive nationwide right to use language as a mark for the registered goods or services, or to obtain the assistance of the government to restrict the importation of infringing or counterfeit goods that display that expression. When facts are not analogous, we should question whether a free speech doctrine created for one set of facts should apply in different circumstances.²⁶⁰

A refusal to register an offensive trademark is also not similar to a hypothetical law in which the government refuses to protect the real property rights of Pro-Football or Tam, or does not provide lights or police protection for their entertainment services, because they use marks that may disparage others.²⁶¹ Unlike Section 2(a)'s regulation of what words can be registered as trademarks, such laws and actions have no nexus or connection to the offensive language. Moreover, such benefits—the enforcement of property rights in land against trespassers or the provision of lights or police protection during a football game or concert—do not give Pro-Football or Tam the exclusive nationwide right to stop others from using the words REDSKINS or THE SLANTS in the marketplace.

Courts should not extend the unconstitutional conditions doctrine to Section 2(a) because the justification for striking down laws that impose unconstitutional conditions on expression—reducing the law's chilling effect on expression—does not apply in this context. Denial of a registration may actually decrease the chilling effect on speech since registration provides a presumption of validity of the mark, and others may refrain from using the mark due to the registration, the cost of litigation, and the uncertainty of whether a trademark lawsuit will be successful. Reasonable people may disagree on whether a mark is sufficiently distinctive or famous for protection, whether defendant's unauthorized use of the mark infringes or dilutes that mark, or whether a defense applies. Regardless of whether a defendant's use of a registered mark infringes or dilutes that mark, it seems odd to recognize a *free speech right* to suppress or punish the expression of others under the unconstitutional conditions

260. *But cf.* Ned Snow, *Content-Based Copyright Denial*, 90 Indiana L.J. 1473, 1490-97 (2015) (arguing that the unconstitutional conditions doctrine applies if an economic benefit is denied to a copyright owner, but concluding that a content-based copyright denial still does not violate the First Amendment).

261. Pro-Football's brief filed in the Fourth Circuit said that denying a registration of a trademark is just like turning off the lights "at a Redskins night game because the government disfavors the name, and defend[ing] the action because the Redskins can still play in the dark." Opening Brief of Appellant, *Pro-Football, Inc. v. Blackhorse*, No. 15-1874, at 5 (4th Cir. Oct. 30, 2015). The other examples were raised by people who commented on the paper.

doctrine. The U.S. Supreme Court should instead hold that the U.S. trademark law denying registration of immoral, scandalous, or potentially disparaging trademarks does not implicate the First Amendment because the trademark owner can still use the language claimed as a trademark in noncommercial and commercial expression, and no one is placed in jail or required to pay any money due to the use of this offensive expression.

If the Court finds Section 2(a) to be constitutional because it does not suppress or punish expression or cause other actionable harm to expression, critics may argue that the legislature could therefore enact a new law explicitly prohibiting registration of trademarks that are critical of the government. At first glance, such a law appears to be extremely problematic from a free expression perspective. Yet denying trademark registration to commentary critical of the U.S. government could actually increase the free flow of that expression. An example will illustrate this point.

Assume that the U.S. government believes that presidential candidate Donald Trump's slogan MAKE AMERICA GREAT AGAIN suggests that the United States of America is not currently great, and decides to cancel the trademark registrations containing that phrase under the disparagement provision of Section 2(a), or a new law that bans registration of trademarks critical of the government. Will cancellation of this registration discourage Trump from using this phrase as a trademark on hats and T-shirts and encourage him to select another slogan that he can register? Maybe. But allowing the marks to remain on the trademark register will likely decrease the use of this expression in a similar way by other parties, as a trademark registration makes it easier for Trump to chill expressive use of this language using demand letters and private enforcement of trademark rights. Per news reports, Trump has already asked politicians not to use the phrase "Make America Great Again" in speeches and complained when merchandising websites such as CafePress sold T-shirts displaying this language on the front of the clothing.²⁶² These politicians and companies would likely win in court if Trump sued them for trademark violations, but due to the time and expense of litigation some people will likely just self-censor their expression and not use the registered slogan in ways that might trigger trademark

262. David Martosko, *EXCLUSIVE: Trump trademarked slogan 'Make America Great Again' just DAYS after the 2012 election and says Ted Cruz has agreed not to use it again after Scott Walker booms it TWICE in speech*, Daily Mail.com (May 12, 2015, 11:28 p.m.), <http://www.dailymail.co.uk/news/article-3077773/Trump-trademarked-slogan-Make-America-Great-just-DAYS-2012-election-says-Ted-Cruz-agreed-not-use-Scott-Walker-booms-TWICE-speech.html>; Heather Long, *Donald Trump trademarks "Make America Great Again,"* CNN Money (Oct. 8, 2015 10:34 a.m.), <http://money.cnn.com/2015/10/08/investing/donald-trump-make-america-great-again-trademark/>.

liability. If the government truly wants to discourage the overall use of language that is immoral, scandalous, potentially disparaging, or critical of the government, then allowing trademark registration and protection of that language might do the trick since granting a trademark registration will likely chill the unauthorized use of the registered language by others.²⁶³

While Section 2(a)'s bar on registration of an offensive mark does not prevent use of the mark, a remaining question is whether this law also prevents the trademark owner from pursuing a claim for infringement under Section 43(a) of the Lanham Act against competitors who use the mark to confuse consumers.²⁶⁴ Registration of a mark is not required for protection of the mark in the United States, and a distinctive and nonfunctional mark may still be protected against false designations of origin and unfair competition under Section 43(a). Some commentators argue that enforcement of trademark rights in offensive marks should not be allowed under Section 43(a) because it would circumvent the policy reasons for Section 2(a)'s rule banning registration of immoral, scandalous, or potentially disparaging marks.²⁶⁵ The Federal Circuit said in *Tam* that it was not clear whether the owner of an offensive mark could sue under Section 43(a), and noted the U.S. Supreme Court said in *Two Pesos* that "it is common ground that § 43(a) protects qualifying unregistered trademarks and that general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a)."²⁶⁶ In addition, the *Tam* majority noted that the district court in *Renna* held that government flags cannot be protected under Section 43(a) since they cannot be registered under Section 2(b) of the Lanham Act.²⁶⁷

On the other hand, dissenting judge Lourie in *Tam*, the International Trademark Association, and other commentators have argued that owners of marks denied registration under

263. Perhaps the United States should reconsider allowing registration of political slogans used in commerce as trademarks, as trademark protection for such marks can chill expression more than Section 2(a). Whether it should do this is beyond the scope of this article.

264. 15 U.S.C. § 1125(a)(1)(A).

265. Baird, *supra* note 11, at 791 (arguing that government resources should not be spent enforcing Section 43(a) and allowing Section 43(a) claims would encourage the use of offensive terms as marks).

266. *Tam*, 808 F.3d at 1344 (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992)).

267. *Tam*, 808 F.3d at 1344 n.11 (citing *Renna v. Cty. of Union*, 88 F. Supp. 3d 310, 320 (D.N.J. 2014) ("I am persuaded that Section 2 declares certain marks to be unregistrable because they are inappropriate subjects for trademark protection. It follows that such unregistrable marks, not actionable as registered marks under Section 32, are not actionable under Section 43, either.")).

Section 2(a) can still sue for violations of Section 43(a) of the Lanham Act.²⁶⁸ Some courts have allowed unfair competition claims under Section 43(a) in cases involving non-registerable generic terms, trade names, and titles of single literary works where the defendant was passing off its goods or services as those of the plaintiff.²⁶⁹ In addition, the *Two Pesos* case dealt with a different issue—whether the trade dress of a restaurant can be protected under Section 43(a) without proof of acquired distinctiveness—rather than the subject matter exclusions from registration in Section 2. Moreover, other courts and trademark expert Professor McCarthy disagree with *Renna*'s holding about Section 2(b) and Section 43(a).²⁷⁰

Regardless of whether *Renna* is correct with regard to the relationship between Section 43(a) and the ban on registration of government symbols in Section 2(b), courts can find a reason to treat offensive marks differently in the trademark provisions of the Paris Convention. The Paris Convention requires contracting parties to this trademark treaty to ban the use without authorization by the government of flags and other government symbols as trademarks, and not just refuse their registration. Article 6ter(1)(a) of the Paris Convention provides:

The countries of the Union agree to refuse or to invalidate the registration, *and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks*, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty

268. See *Tam*, 805 F.3d at 1375 (Lourie, J., dissenting) (citing International Trademark Association's En Banc Amicus Brief, http://www.inta.org/Advocacy/Documents/2015/In%20Re%20Tam_En%20Banc%20Amicus%20Brief%20for%20INTA.pdf); see also Baird, *supra* note 11; Farley, *Registering Discontent*, *supra* note 11, at 124.

269. See, e.g., *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162 n.2 (Fed. Cir. 2002) ("While titles of single works are not registrable, they may be protected under section 43(a) of the Lanham Act upon a showing of secondary meaning."); *Blinded Vet. Ass'n v. Blinded Am. Vet. Found.*, 872 F.2d 1035 (D.C. Cir. 1989) (third party use of generic term with de facto secondary meaning may violate unfair competition laws if it passes off its services as those of another); *Accuride Int'l, Inc. v. Accuride Corp.*, 871 F.2d 1531, 1534 (9th Cir. 1989) ("The major legal distinction between trademarks and trade names is that trade names cannot be registered and are therefore not protected under 15 U.S.C. § 1114. However, analogous actions for trade name infringement can be brought under section 43(a).") (citation omitted); see also Jake Linford, *A Linguistic Justification for Protecting "Generic" Trademarks*, 17 Yale J.L. & Tech. 110, 166-69 (2015).

270. *Bros. of the Wheel M.C. Exec. Council, Inc. v. Mollohan*, 909 F. Supp. 2d 506, 542 (S.D. W. Va. 2012) (noting availability of protection under Section 43(a) for flag design even if design unregistrable). Professor McCarthy notes that the statement in *Renna* that unregistrable marks are not actionable under Section 43 is erroneous; he says "[t]here is no statutory or case law support for such a view." McCarthy, *supra* note 16, § 19:78.

adopted by them, and any imitation from a heraldic point of view.²⁷¹

Article 6*quinquies*(3) of the Paris Convention allows contracting parties to ban the registration of trademarks contrary to morality or public order, but it does not require the United States or other Paris Union members to prohibit their registration or use.²⁷² Moreover, Article 10*bis* of the Paris Convention requires contracting parties to protect companies against unfair competition.²⁷³ If U.S. courts want to interpret U.S. trademark laws to be consistent with the international treaty obligations of the United States,²⁷⁴ they can refuse Section 43(a) protection to government symbols (since they should not be used as marks without the government's authorization under Article 6*ter*(1)(a)), but still permit Section 43(a) unfair competition claims against parties who use the distinctive marks of others that are denied registration under Section 2(a) on the ground that the marks are immoral, scandalous, or potentially disparaging to others.

Thus, an unfair competition cause of action could be available against competitors under Section 43(a) to parties whose otherwise valid common law trademarks are denied registration under the immoral, scandalous, or potentially disparaging mark provision in Section 2(a). At the same time, the constitutionality of Section 2(a) does not depend on whether owners of offensive marks can sue for violations of Section 43(a) because Section 2(a) does not suppress or punish expression, impose an unconstitutional condition on expression, or result in other actionable harm to expression for the reasons set forth above.²⁷⁵ If courts decline to enforce trademark rights in such marks under Section 43(a), or if Congress decides to prohibit their enforcement under this unfair competition law, this

271. Paris Conv., *supra* note 20, art. 6*ter*(1)(a) (emphasis added). But Article 6*ter*(1)(c) of the Paris Convention clarifies that the government need not ban the use or registration of such marks if they do not “suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.” *Id.*, art. 6*ter*(1)(c).

272. Paris Convention, *supra* note 20, art. 6*quinquies*(3).

273. *Id.* art. 10*bis*.

274. Under the *Charming Betsy* canon, courts should interpret ambiguous language in a statute in such a way so as to avoid a conflict with international law. Curtis A. Bradley, *The Charming Betsy Canon and Separation of Powers: Rethinking the Interpretive Role of International Law*, 86 Geo. L.J. 479 (1998) (citing *Murray v. Schooner Charming Betsy*, 6 U.S. (2 Cranch) 64, 118 (1804)). Moreover, if the United States complies with its treaty obligations, it is in a better position to argue that other nations should follow their treaty obligations relating to unfair competition laws and intellectual property rights.

275. See also the discussion of this issue in Tushnet, *supra* note 11, at 13-15 (discussing the relationship between Section 2(a) and Section 43(a)); *id.* at 15-24 (arguing that Section 2(a) does not impose unconstitutional conditions); *id.* at 30 & n. 91 (discussing *Renna* and the absolute bar for registration of flags and other government symbols).

decision would also be constitutional under the First Amendment for the same reason: The party claiming trademark rights can still use the offensive language subject to other laws which ban the use of this expression, such as obscenity laws.

3. Expression: What Is Being Regulated?

Another issue that may arise in a free expression challenge to a trademark law is whether the trademark law is regulating expression or something else that does not implicate the right to freedom of expression, such as non-expressive conduct or economic activity. In addition to words, symbols, and other traditional forms of written, aural, and visual expression (for example, a poem, a song, a sculpture, or a speech communicated by sign language), expressive use of symbols and other conduct also qualifies as “expression” that is protected by the free expression right in Europe, the United States, and other countries. This type of expression is called “symbolic speech,” and examples include displaying or waving a flag, burning a flag, wearing an armband, or wearing a red square pinned to your clothing to express yourself on a social or political issue.²⁷⁶ The third element of a free speech violation therefore considers whether the law is regulating “expression” (or “speech”) as that term is used in constitutions, human rights treaties, or other laws that protect the right to freedom of expression.

Trademarks contain expression. Use of a trademark to identify the manufacturer of a shoe may not be akin to using words or symbols to criticize the government or promote a social movement,²⁷⁷ but most uses of trademarks should still qualify as protected “expression.”²⁷⁸ Words, names, symbols, designs, and product configurations can all qualify as trademarks when used in commerce in connection with the sale of goods or services, but they are usually only protected under trademark law if they identify and distinguish the source of goods or services. Trademarks can also communicate information about the brand image of the company and its product quality. Examples include the terms

276. Volokh, *supra* note 132, at 409 (discussing cases); Teresa Scassa, *Protest Symbol in the Public Domain—For Now*, Teresa Scassa Blog (Mar. 7, 2016), http://www.teresascassa.ca/index.php?option=com_k2&view=item&id=209:protest-symbol-in-the-public-domain-for-now&Itemid=79 (discussing how Canadians pinned a red square to their clothing in protest, and failed attempts by a company to obtain a trademark registration in the symbol); Sakulin, *supra* note 111, at 112 (noting the use of symbols is protected under Article 10 of the European Convention on Human Rights).

277. *Cf. Tam*, 808 F.3d at 1368 (Dyk, J., concurring in part and dissenting in part) (stating that “many trademarks lack the kind of ‘expressive character’ that would merit First Amendment protection for offensive content”).

278. *See Ramsey*, *supra* note 10, at 409-12; Snow, *supra* note 11, at 112-19 (discussing the speech value in source identification).

NIKE and JUST DO IT, the Nike swoosh symbol, a distinctive design on the surface of Nike's product packaging for shoes, or the distinctive and nonfunctional product configuration of the shoe itself. The words REDSKINS and THE SLANTS identify and distinguish the source of entertainment services, and can also make a social or political statement when used as marks. For both of these reasons, these marks contain expression. As trademark rights cannot exist unless the alleged mark communicates information about the source or quality of the product, trademarks constitute expression and this third element of a free speech violation is satisfied.

Use of another's trademark is expression. When someone uses another's trademark such as THE SLANTS or REDSKINS without authorization this also constitutes expression regardless of whether this trademark use confuses consumers, conveys information, or makes a political statement.²⁷⁹ This expression may be misleading commercial expression, such as counterfeit copies of the NIKE mark on shoes sold by one of Nike's competitors, and thus categorically unprotected under the First Amendment (element 5), but it is still expression. So is a truthful comparative advertisement saying "Champion shoes are less expensive than Nike shoes"; this is nonmisleading commercial expression. Other expressive uses of marks include a consumer's gripe site on a website critical of Nike, Inc. located at the domain name nikesucks.com and display of the phrase JUST DID IT or JUST DON'T DO IT on a T-shirt. In trademark disputes, this third element of a free speech violation—whether "expression" is being regulated—is usually satisfied when a trademark is involved, and thus courts must consider the other elements of a free speech violation to determine if the law is constitutional.

4. Individuals and Non-Government Entities: Whose Expression Is Regulated?

A fourth issue that may arise in a free speech challenge to a trademark law relates to the identity of the person or entity whose expression is regulated. Individuals and groups of people (such as Native Americans) clearly have the "human" right to freedom of expression. Some countries, such as the United States and members of the European Union, also protect the "fundamental" right to freedom of expression of corporations and other commercial entities.²⁸⁰ In such countries, the fourth element of a

279. Ramsey, *supra* note 10, at 409-12.

280. *Citizens United v. Fed. Election Comm'n*, 558 U.S. 310, 342-43 (2010) ("The Court has recognized that First Amendment protection extends to corporations.... This protection has been extended by explicit holdings to the context of political speech.... Under the rationale of these precedents, political speech does not lose First Amendment

free speech violation is satisfied if the expression is from an individual, a nonprofit group of individuals, or a commercial entity. If a nation generally does not protect the expression of commercial entities from government regulation, however, then laws regulating such expression are more likely to be found constitutional or in compliance with obligations under human rights treaties (element 6).²⁸¹

In addition, if “government speech” is being regulated, under U.S. law there is no free speech violation unless the government is compelling private citizens to convey its message.²⁸² The government can usually control what is expressed when the government is a speaker, employer, or educator.²⁸³ The government speech doctrine allows the government to make content-based decisions relating to government expression, especially when the public might think the government is endorsing the expression communicated to the public. The U.S. Supreme Court recently applied this doctrine in *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*, and held that it was constitutional for the government to reject a design containing the Confederate flag for a government-issued license plate because this was government speech.²⁸⁴ Thus, in the United States and other nations with a similar approach to this issue, the fourth

protection ‘simply because its source is a corporation.’ . . . The Court has thus rejected the argument that political speech of corporations or other associations should be treated differently under the First Amendment simply because such associations are not ‘natural persons.’”) (citations omitted); Sakulin, *supra* note 111, at 166-67 (discussing European law).

281. See, e.g., *Herrera Ulloa v. Costa Rica*, Merits, Reparations and Costs, Judgment, Inter-Am. Ct. H.R. (ser. C) No. 107, ¶¶ 96-100 (July 2, 2004) (holding the American Convention on Human Rights does not apply to newspapers and other legal entities), discussed in Burgorgue-Larsen & Torres, *supra* note 104, at 583.

282. *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015).

283. Volokh, *supra* note 132, at 411 (discussing cases).

284. *Walker*, 135 S. Ct. at 2245-46 (“When government speaks, it is not barred by the Free Speech Clause from determining the content of what it says . . . That freedom in part reflects the fact that it is the democratic electoral process that first and foremost provides a check on government speech . . . Thus, government statements (and government actions and programs that take the form of speech) do not normally trigger the First Amendment rules designed to protect the marketplace of ideas.”); *id.* at 2246 (noting “as a general matter, when the government speaks it is entitled to promote a program, to espouse a policy, or to take a position”); see also *Rust v. Sullivan*, 500 U.S. 173, 194 (1991) (refusing “[t]o hold that the Government unconstitutionally discriminates on the basis of viewpoint when it chooses to fund a program dedicated to advance certain permissible goals, because the program in advancing those goals necessarily discourages alternative goals”); *Legal Servs. Corp. v. Velazquez*, 531 U.S. 533, 541 (2001) (when the government “disburses public funds to private entities to convey a government message, it may take legitimate and appropriate steps to ensure that its message is neither garbled nor distorted by the grantee”); *id.* (Therefore, “viewpoint-based funding decisions can be sustained in instances . . . in which the government used private speakers to transmit specific information pertaining to its own program.”). *Velazquez* says *Rust* must be understood as resting on the conclusion that it involved “government speech.” *Id.*

element of a free speech violation is not satisfied unless the identity of the speaker whose expression is being regulated in a trademark dispute is an individual or non-government entity.

Expression of individuals and non-government entities in trademark enforcement. In trademark litigation, typically the party claiming a free expression right to use another's trademark is an individual or company accused of infringement or other trademark violations, not the government. Regardless of whether that defendant is a counterfeiter or a critic of the trademark owner, this fourth element of a free speech violation will be satisfied if the defendant is a human being or a noncommercial group of people. If a country's free expression doctrine also applies to expression by corporations and other commercial entities, then this element will also be satisfied if the defendant accused of trademark violations is a company.

Expression of individuals and non-government entities in trademark registration. The district court in *Pro-Football* and Judge Lourie in his dissent in *Tam* held that the government speech doctrine applies to Section 2(a) because, among other things, the public may believe the government endorses offensive marks when it approves of adding them to the trademark register.²⁸⁵ Professor Rebecca Tushnet also argues that we should treat trademark registration as a form of endorsement by the government and allow the government to express an opinion about the boundaries of appropriate public discourse in the trademark context.²⁸⁶ As noted previously, the *Tam* majority refused to apply the government speech doctrine to the offensive mark provision in Section 2(a).²⁸⁷

The Federal Circuit is correct that the government speech doctrine does not apply in the context of registrations or denials of registrations for a trademark adopted and used by a private party. When it registers (or refuses to register) a mark, the USPTO may be communicating to the public that the mark satisfies (or fails to satisfy) the requirements in Section 2(a), but Section 2(a) does not regulate this communication about the decision to register nor does it regulate anything the government says about the mark; it prohibits the act of registration of offensive trademarks. The

285. *In re Tam*, 808 F.3d 1321,1374-76 (Fed. Cir. 2015) (en banc) (Lourie, J., dissenting), as corrected (Feb. 11, 2016), cert. granted sub nom. *Lee v. Tam* (U.S. Sept. 29, 2016) (No. 15-1293); *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 457-64 (E.D. Va. 2015), appeal docketed, No. 15-1874 (4th Cir. Aug. 6, 2015), petition for cert. filed (U.S. Apr. 25, 2016) (No. 15-1311).

286. Tushnet, *supra* note 11, at 9-13.

287. *Tam*, 808 F.3d at 1339. In its brief filed with the Fourth Circuit, *Pro-Football* listed a number of offensive trademarks that were registered by the USPTO to illustrate that "no one today thinks registration reflects government approval." Opening Brief of Appellant, *Pro-Football, Inc. v. Blackhorse*, No. 15-1874, at 24 (4th Cir. Oct. 30, 2015).

trademark register and USPTO website contain a list of registered marks, and the USPTO website also lists marks that are being considered for registration and marks that are rejected for registration, but Section 2(a) does not regulate the publication of these lists of trademarks; it regulates whether certain marks can be registered. Moreover, while the trademarks denied registration under Section 2(a) contain expression, this is expression of Pro-Football, Tam, and other private parties, and not expression of the government unless the government is applying for registration of a trademark.

Regardless of whether some people might think the government is endorsing or approving of the trademarks it accepts for registration, the government speech doctrine is not relevant when considering the constitutionality of a law banning registration of offensive language as a mark because the mark is usually the speech of a private party. Thus, in a free speech challenge to Section 2(a) or a similar trademark law, this fourth element of a free speech violation will be satisfied when the trademark applicant or registrant is an individual such as Tam. It will also be met in countries that protect the free expression rights of companies such as Pro-Football. In such cases, a U.S. court must next consider whether a categorical exclusion for this type of expression applies.

5. No Categorical Exclusion for this Expression: Is this Regulation Justified Because a Categorical Exclusion from Protection Applies to This Expression?

Some countries have free expression laws which allow the government to constitutionally regulate certain categories of expression without having those laws subject to judicial scrutiny of the proper balance between the benefits and harms of the specific law regulating the expression. For example, in the United States the U.S. Supreme Court has stated that certain categories of expression are generally denied free speech protection, including misleading commercial expression, incitement of imminent illegal activity, fighting words, obscene expression, and child pornography.²⁸⁸ This is a form of “definitional” balancing rather than “ad hoc” balancing, and laws regulating these categories of

288. *R.A.V. v. City of St. Paul*, 505 U.S. 377, 393 (1992) (fighting words); *New York v. Ferber*, 458 U.S. 747, 773-74 (1982) (child pornography); *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 566 (1980) (misleading commercial expression); *Brandenburg v. Ohio*, 395 U.S. 444, 447 (1969) (incitement of imminent illegal activity); *Roth v. United States*, 354 U.S. 476, 483 (1957) (obscene matter); *see also* Volokh, *supra* note 132, at 410-15; Frederick Schauer, *The Boundaries of the First Amendment: A Preliminary Exploration of Constitutional Salience*, 117 Harv. L. Rev. 1765 (2004).

expression are normally not subject to strict or intermediate scrutiny under the First Amendment.²⁸⁹ Thus, a possible fifth element of a free speech violation is that there is no categorical exclusion for this type of expression that is regulated by a country's trademark law.

In addition, in the copyright law area the U.S. Supreme Court created a doctrine similar to a categorical exclusion for expression when it declined to evaluate the constitutionality of a new copyright law under the Court's traditional strict scrutiny or intermediate scrutiny analysis. In *Eldred*, the U.S. Supreme Court said that suppression or punishment of the use of another's copyrighted expression implicates the First Amendment, but copyright law is constitutional (and is not subject to further constitutional scrutiny) unless Congress alters the traditional contours of protection, such as by protecting copyright in ideas or eliminating the copyright fair use defense.²⁹⁰ The U.S. Supreme Court has not created a similar categorical exclusion from constitutional scrutiny for regulations of trademarks. Perhaps it will do this in *Lee v. Tam* as a way to find the disparagement provision in Section 2(a) consistent with the First Amendment.²⁹¹

Trademarks and uses of trademarks that constitute misleading commercial expression. If a country refuses to protect misleading commercial expression under the right to freedom of expression, then the government can regulate the commercial use of trademarks that are misleading. For example,

289. Ramsey, *supra* note 10, at 450-57 (discussing definitional balancing and ad hoc balancing in U.S. free speech law).

290. *Eldred v. Ashcroft*, 537 U.S. 186, 221 (2003) (holding that copyright laws are not categorically immune from challenges under the First Amendment, but "further First Amendment scrutiny is unnecessary" when "Congress has not altered the traditional contours of copyright protection") (citing *Harper & Row Pub., Inc. v. National Enters.*, 471 U.S. 539, 560 (1985); *cf. San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522 (1987)); *see also Golan v. Holder*, 132 S. Ct. 873, 890 (2012) (noting the traditional contours of copyright protection include the "idea/expression dichotomy" and the fair use defense; the Court "concluded in *Eldred* that there was no call for the heightened review petitioners sought in that case" and reached "the same conclusion" in this case) (citing *Eldred*, 537 U.S. at 221 ("Protection of [an author's original expression from unrestricted exploitation] does not raise the free speech concerns present when the government compels or burdens the communication of particular facts or ideas.")); *see also Ramsey, supra* note 10, at 414, 446 (discussing cases); Volokh, *supra* note 132, at 411 (same).

291. Professor Netanel notes that U.S. appellate courts have used definitional balancing in trademark law after *Golan*. Neil Netanel, *First Amendment Constraints on Copyright After Golan v. Holder*, 60 UCLA L. Rev. 1082, 1091-92 (2013) ("Notably, courts considering First Amendment defenses to federal trademark infringement claims have repeatedly carved out specific privileges to trademark infringement or have interpreted trademark law to comport with First Amendment strictures rather than defining trademark law as a content-based or content-neutral speech regulation None of [these] cases ask[] whether trademark law's speech restrictions might be justified under strict or intermediate scrutiny. Rather they simply assume that certain uses of trademarks are First Amendment-protected speech and thus enjoy an absolute privilege from civil liability under trademark law.").

the USPTO could clearly reject a registration for LOVEE LAMB for synthetic car seat covers not made of lambskin without violating the First Amendment if this deceptive mark qualifies as misleading commercial expression. Not only may the government deny registration to a misleading trademark used in commercial expression, but it can also use false advertising laws²⁹² to suppress or punish misleading expression in the marketplace without implicating the free expression right because the “no categorical exclusion for this expression” element is not satisfied.

Infringing uses of trademarks are also not protected under the First Amendment if they constitute misleading commercial expression. An example is a competitor’s counterfeit copies of the NIKE mark on shoes that are not sold by Nike, Inc. In such a case, the fifth element of a free speech violation would not be satisfied and any criminal or civil penalty for this trademark violation (such as jail time, a fine, or an injunction or monetary relief) would likely be found constitutional in the United States. On the other hand, if the defendant’s unauthorized use of another’s mark does not qualify as misleading commercial expression, such as the diluting but nonmisleading use of a famous mark, then a U.S. court evaluating the constitutionality of the trademark dilution law will need to determine whether the law can survive constitutional analysis under the Court’s First Amendment jurisprudence (element 6).²⁹³

Trademarks containing other excluded categories of expression. If a nation excludes incitement to illegal activity, fighting words, obscene expression, child pornography, or other categories of expression from protection under the right to freedom of expression,²⁹⁴ then it should also be able to refuse to register this expression as a trademark, and ban or punish the use of this expression as a trademark, without violating the right to freedom of expression. Note, however, that this categorical exception rule may not apply in the United States if the government is engaging in viewpoint discrimination within a category of expression.²⁹⁵ As Section 2(a) regulates some subject matter that is not categorically excluded from constitutional protection, this fifth element of a free speech violation (“no categorical exclusions for this expression”) is satisfied for a facial challenge to Section 2(a), and courts must evaluate whether the other elements of a violation of the right to freedom of expression are met. If the U.S. Supreme Court believes that the second element of a free speech violation (suppression or

292. See, e.g., 15 U.S.C. § 1125(a)(1)(B).

293. Ramsey, *supra* note 10, at 421-46 (discussing intermediate and strict scrutiny analysis in trademark disputes).

294. See *supra* note 288 (discussing U.S. law).

295. See *R.A.V. v. City of St. Paul*, 505 U.S. 377, 387-88, 391 (1992).

punishment of expression, or other actionable harm to expression) is satisfied by Section 2(a), then it will need to evaluate whether Section 2(a) satisfies constitutional scrutiny (element 6).

6. The Regulation of Expression Fails the Relevant Balancing Test Created by Courts Applying Constitutional Laws and Human Rights Treaties Protecting Freedom of Expression

There is no universal approach to analyzing whether a trademark law violates the right to freedom of expression, and a comparative discussion of the free expression jurisprudence of several nations is beyond the scope of this article. In many countries, however, the particular level of constitutional scrutiny or the exact balancing test applied by courts may depend on certain factors, including whether the expression is commercial or noncommercial, whether the law is a content-based or content-neutral regulation, or whether the law is regulating expression in a government forum. Below, the article briefly addresses these issues with a focus on United States law, but the analysis may also be useful for judges in other jurisdictions who are deciding how to resolve potential conflicts between trademark and free expression rights.²⁹⁶

In *Tam* the judges disagreed about whether strict scrutiny or intermediate scrutiny analysis should be applied to evaluate the constitutionality of the “may disparage” language in Section 2(a). The majority in *Tam* held that strict scrutiny of the law is required under *Reed*—regardless of whether the law regulates commercial expression—because Section 2(a) is a content-based regulation and the government disapproves of the offensive language being regulated.²⁹⁷ The dissenting judges in *Tam* held that this law only regulated commercial expression, and thus was subject to *Central Hudson’s* intermediate scrutiny analysis.²⁹⁸ Judge Reyna also argued that Section 2(a) is a content-neutral regulation of expression subject to intermediate scrutiny analysis because it regulates the secondary effects of speech.²⁹⁹ The judges did not evaluate whether the government forum doctrine applied in this

296. See *supra* note 121 (discussing the free expression analysis under the European Convention on Human Rights).

297. *In re Tam*, 808 F.3d 1321, 1336 (Fed Cir. 2015) (en banc), *as corrected* (Feb. 11, 2016), *cert. granted sub nom.* Lee v. Tam (U.S. Sept. 29, 2016) (citing *Reed v. Town of Gilbert*, 576 U.S. ___, 135 S. Ct. 2218, 2226 (2015)). See *supra* note 172 for the test.

298. *Id.* at 1365-68 (Dyk, J., concurring in part and dissenting in part) (applying the test in *Cent. Hudson Gas & Elec. Corp. v. Public Serv. Comm’n of NY*, 447 U.S. 557, 566 (1980)). See *supra* note 172 for the test.

299. *Id.* at 1378-79 (Reyna, J., dissenting).

case, and the government declined to pursue this approach during oral argument before the Federal Circuit,³⁰⁰ but some commentators have argued this doctrine could apply to the trademark register or the trademark registration system.³⁰¹

As discussed in more detail below, this article argues that trademark laws such as Section 2(a) currently regulate both commercial and noncommercial expression, and are content-based rather than content-neutral laws. As the trademark register and trademark registration system are part of a regulatory regime and are not a “forum” for expression by private parties, the article also contends that the U.S. Supreme Court’s government forum doctrine is not relevant when evaluating the constitutionality of Section 2(a).

a. Trademark Laws Can Regulate Commercial and Noncommercial Expression

If a country (such as Japan) generally permits government regulations of commercial expression, or subjects such laws to lesser scrutiny under balancing tests in that country’s free expression laws,³⁰² courts will need to determine if the trademark law only regulates trademarks used in commercial contexts. If so, this law is less likely to violate the right to freedom of expression. In the United States, commercial expression is usually defined as expression that does no more than propose a commercial transaction,³⁰³ and regulations of such expression have been subjected to intermediate scrutiny analysis under the test in *Central Hudson* rather than the strict scrutiny analysis used for evaluating the constitutionality of regulations of noncommercial expression.³⁰⁴ After *Sorrell*, however, heightened scrutiny analysis for content-based regulations of expression may be required in the

300. *Id.* at 1353 n.12 (majority opinion) (noting that government’s counsel at oral argument disclaimed that the government forum approach was appropriate in the context of trademark regulation).

301. *See infra* Part IV.A.6.c.

302. *See supra* note 148 (Japanese constitutional law on commercial expression).

303. *Harris v. Quinn*, 134 S. Ct. 2618, 2639 (2014); *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council*, 425 U.S. 748, 762 (1976); *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1017 (9th Cir. 2004) (applying this definition of commercial speech in a trademark case). Some courts have set forth a broader definition of commercial expression. *See Jordan v. Jewel Food Stores*, 743 F.3d 509 (7th Cir. 2014) (noting that expression can be commercial even where speech does something more than, or in addition to, proposing a commercial transaction).

304. *See., e.g., Bd. of Trs. of the State Univ. of N.Y. v. Fox*, 492 U.S. 469, 473-74, 482 (1989); *Cent. Hudson Gas & Elec. Corp. v. Public Serv. Comm’n of NY*, 447 U.S. 557, 566 (1980).

United States regardless of whether the expression is commercial or noncommercial.³⁰⁵

As I have explained elsewhere in the context of U.S. trademark law,³⁰⁶ trademark laws primarily regulate commercial expression, but they also occasionally regulate noncommercial expression. Even though most trademarks are used by trademark owners and other parties to identify and distinguish commercial goods or services, political and religious organizations have registered trademarks in the United States and enforced these marks against competitors.³⁰⁷

The REDSKINS and THE SLANTS marks for entertainment services can identify the source of the services (which seems more commercial) and convey the inherent meaning of the words (which seems more political). Several judges in the *Tam* case classified THE SLANTS mark as political expression because the Asian-American rock band was trying to reclaim this term and make a political and social statement, but the mark is also used by the band to propose a commercial transaction when it advertises its services. For example, if a poster or email advertisement for the band's concert said "Tickets are now available for THE SLANTS show at the House of Blues," this use of THE SLANTS mark is at least partially commercial since consumers will use the mark to identify and distinguish Tam's band from other bands, and then purchase tickets for THE SLANTS concert. At the same time, Tam's use of this mark on the poster or in the email could start a public conversation about offensive terms, and thus may qualify as mixed commercial-noncommercial speech or noncommercial expression under U.S. First Amendment doctrine because it does more than propose a commercial transaction.³⁰⁸ As offensive marks may be used in commercial or noncommercial contexts, and rejection of the registration under Section 2(a) does not depend on the commerciality of this use, it does not make sense to categorize

305. *Citizens United v. Fed. Election Comm'n*, 558 U.S. 310, 336-37 (2010); *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 565-67 (2011); see Jake Linford, *The Institutional Progress Clause*, 16 Vand. J. Ent. & Tech. L. 533, 542-43 (2014) (noting that *Citizens United* and *Sorrell* suggest the Court is moving closer to strict scrutiny analysis for commercial speech and a commitment to a speaker-neutral First Amendment in both the political and commercial arenas).

306. Ramsey, *supra* note 10, at 390-404 (discussing increasing First Amendment protection for commercial speech and application of trademark laws to commercial and noncommercial expression); Ramsey, *supra* note 19, at 887-88.

307. *E.g.*, *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 88 (2d Cir. 1997); *Gen. Conference Corp. of Seventh-Day Adventists v. Perez*, 97 F. Supp. 2d 1154, 1164 (S.D. Fla. 2000) (holding use of the registered SEVENTH-DAY ADVENTIST mark for church services, books, and other goods and services by an unaffiliated church infringing the marks of the national religious organization).

308. *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 66-68 (1983), discussed in *Tam*, 808 F.3d at 1377 (Reyna, J. dissenting).

the expression as either commercial or noncommercial here. It can be both. For this reason, heightened scrutiny of the trademark law is appropriate in the United States since the law regulates noncommercial expression and is a content-based law, as discussed next.

b. Trademark Laws Are Content-Based Regulations

If a country subjects content-based regulations of expression to higher scrutiny under balancing tests in that country's free expression laws, courts will also need to determine if the trademark law regulates expression based on its content. In the United States, content-neutral regulations of expression are generally subject to less scrutiny than content-based regulations.³⁰⁹ I agree with the Federal Circuit that Section 2(a) is a content-based regulation of expression.³¹⁰

As I have discussed in more detail in other work, trademark laws are content-based laws because the government must examine the content of the message when deciding how to regulate that expression.³¹¹ Section 2(a) is not similar to content-neutral laws that regulate the time, place, or manner of expression (such as the sound levels at concerts),³¹² or to regulations of expressive conduct (such as burning a flag),³¹³ because Section 2(a) requires the government to make decisions on what to register as a trademark based on the meaning of the words. This law is similar to the content-based law punishing the public display of profanity in *Cohen v. California*.³¹⁴

Trademark infringement and dilution laws are also content-based regulations of expression because the court must examine the content of the defendant's expression to determine if this use of the mark is infringing or diluting. For example, in infringement actions courts determine whether the parties' marks are similar in sight, sound, or meaning. Moreover, if the trademark owner

309. *Reed v. Town of Gilbert*, 576 U.S. ___, 135 S. Ct. 2218, 2226-33 (2015); *Texas v. Johnson*, 491 U.S. 397, 406 (1989); *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989).

310. *In re Tam*, 808 F.3d 1321, 1321-58 (Fed. Cir. 2015) (en banc), *as corrected* (Feb. 11, 2016), *cert. granted sub nom.* *Lee v. Tam* (U.S. Sept. 29, 2016) (No. 15-1293). Some commentators argue that the Court should not apply heightened scrutiny in the trademark context because this would call into question "all content-based restrictions that trademark law imposes on speech." Snow, *supra* note 11, at 126; *see* Tushnet, *supra* note 11, at 24-39.

311. Ramsey, *supra* note 10, at 431-37.

312. *See, e.g.*, *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989).

313. *See, e.g.*, *Texas v. Johnson*, 491 U.S. 397, 406 (1989).

314. *Cohen v. Calif.*, 403 U.S. 15, 26 (1971) (where defendant was punished for wearing a jacket with the words "Fuck the Draft" in the corridor of a courthouse, holding "absent a more particularized and compelling reason for its actions, the State may not, consistently with the First and Fourteenth Amendments, make the simple public display here involved of this single four-letter expletive a criminal offense").

prevails, the court punishes the defendant's use of specific words or symbols protected as a mark, and enjoins further use of that language as a mark in an injunction. Of course, the trademark law may be constitutional if it regulates misleading commercial expression, but it is still a content-based law. The free flow of expression is not adequately protected if we deem trademark laws to be content-neutral regulations, and subject them to a lower level of constitutional scrutiny for this reason.³¹⁵

In addition to arguing that Section 2(a) is a content-based regulation, the *Tam* majority and some commentators also argue that Section 2(a) facially discriminates based on the viewpoint of the speaker.³¹⁶ Professor Tushnet and the dissenting justices in *Tam* persuasively argue that this is incorrect.³¹⁷ The statute on its face bans immoral, scandalous, or potentially disparaging marks from registration, and examiners and courts usually focus on the content of the words used in connection with certain goods or services, and what they mean to a substantial composite of the relevant group, rather than the identity of the speaker or anyone's intent or viewpoint when they apply the law.³¹⁸ This law is very different compared to the law banning fighting words that was found to discriminate based on viewpoint in *R.A.V.*: "Whoever places on public or private property a symbol, object, appellation, characterization or graffiti, including, but not limited to, a burning cross or Nazi swastika, which one knows or has reasonable grounds to know *arouses anger, alarm or resentment in others on the basis of race, color, creed, religion or gender* commits disorderly conduct and shall be guilty of a misdemeanor."³¹⁹ Moreover, the U.S. Trademark Office's cancellation of the REDSKINS marks and denial of Tam's application to register THE SLANTS to reclaim the term suggests that the government did not apply the law in a manner that discriminates against viewpoint in those decisions.

315. *E.g.*, *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 202 (2d Cir. 1979).

316. *In re Tam*, 808 F.3d 1321, 1328, 1336-37 (Fed. Cir. 2015) (en banc), *as corrected* (Feb. 11, 2016), *cert. granted sub nom.* *Lee v. Tam* (U.S. Sept. 29, 2016) (No. 15-1293); Lefstin, *supra* note 11, at 676, 679-81.

317. *Tam*, 808 F.3d at 1371-72 (Dyk, J., concurring in part and dissenting in part); Tushnet, *supra* note 11, at 39-43. Note, however, that the USPTO could apply the law in a way that discriminates based on the viewpoint of the speaker.

318. *See supra* note 72 (discussing the TMEP rules regarding Section 2(a)).

319. *R.A.V. v. City of St. Paul*, 505 U.S. 377, 380 (1992) (emphasis added). As explained by the Court, "Displays containing some words—odious racial epithets, for example—would be prohibited to proponents of all views. But 'fighting words' that do not themselves invoke race, color, creed, religion, or gender—aspersions upon a person's mother, for example—would seemingly be usable *ad libitum* in the placards of those arguing *in favor* of racial, color, etc., tolerance and equality, but could not be used by those speakers' opponents." *Id.* at 391.

While the Trademark Office has allowed registration of terms that are not immoral, not scandalous, or not potentially disparaging, such as ASIAN EFFICIENCY, this is based on the content of the trademark, and not on the speaker's identity, intention, or viewpoint. Just as Tam can use THE SLANTS in a positive way to reclaim a racial slur, a non-Asian American person could use the mark ASIAN EFFICIENCY in a derogatory way to ridicule Asians or reinforce stereotypes about them. It would be problematic from a free expression, equal protection, and practical standpoint if we required the government to discern the characteristics of the applicant (e.g., Asian-American, Native American, African-American, white, etc.) and his or her intent (e.g., criticism, commentary, ridicule, or celebration of Asian-Americans, Native Americans, African-Americans, whites, etc.) and then use this information to determine whether to grant or deny a registration for a mark that is deemed to be immoral, scandalous, or potentially disparaging. Even if there are good policy reasons to allow Tam to register THE SLANTS as a mark for his rock band's entertainment services, the constitutionality of Section 2(a) should not depend on the identity of the trademark applicant or that person's purpose in selecting the mark.

***c. The Trademark Register and the
Trademark Registration System
Are Not Government Forums for Expression***

The government forum or "public forum" doctrine divides government property into three types of fora: the traditional public forum, the limited public forum, and the nonpublic forum. It is more difficult for the government to regulate expression communicated in public forums such as parks, streets, sidewalks, or post offices when compared to nonpublic forums, such as a government workplace or an elementary school,³²⁰ or limited public forums such as student organization resources or student publications.³²¹

Some commentators argue that the government forum doctrine is relevant when evaluating the constitutionality of

320. *Perry Educ. Ass'n v. Perry Local Educators' Ass'n*, 460 U.S. 37, 45-46 (1983) (finding school mail system was a nonpublic forum); *see, e.g., Ark. Educ. Television Comm'n v. Forbes*, 523 U.S. 666, 677 (1998) (holding debate was either a nonpublic forum or not a forum at all); *Cornelius v. NAACP Legal Def. & Educ. Fund, Inc.*, 473 U.S. 788 (1985) (holding charitable contribution program was a nonpublic forum); *see also* Chemerinsky, *supra* note 14, 1189 ("Public forums are government-owned properties that the government is constitutionally obligated to make available for speech"); *id.* at 1189-1200 (discussing public forum doctrine); Volokh, *supra* note 132, at 411 (same).

321. *See, e.g., Christian Legal Soc'y v. Martinez*, 561 U.S. 661 (2010) (student organization resources); *Rosenberger v. Rector & Visitors of the Univ. of Va.*, 515 U.S. 819 (1995) (student publications).

Section 2(a) because the government is providing resources to facilitate private speech when it operates the trademark register and protects registered marks in the trademark registration system.³²² However, the forums for expression in the government forum cases are substantially different compared to the trademark register and the trademark registration system. Trademark owners usually express themselves in the marketplace, and not on the trademark register, in the Official Trademark Gazette, or on the USPTO website. As discussed in Part IV.A.4, the register is the place where the USPTO adds marks that are registered. It is not usually a forum for private parties to place their marks to convey information and ideas. While the government publishes these marks in various places, Section 2(a) does not regulate these publications of expression. It simply denies registration to certain subject matter. Thus the government forum doctrine is not relevant when courts evaluate the constitutionality of Section 2(a).

***d. Options for the U.S. Supreme Court
If It Wants to Find Section 2(a) Constitutional
under the First Amendment***

If Section 2(a) implicates the First Amendment, the law's ban on registration of immoral, scandalous, or potentially disparaging marks should be subject to strict scrutiny analysis under the U.S. Supreme Court's current First Amendment jurisprudence. Intermediate scrutiny of the law is not appropriate since Section 2(a) is not a content-neutral regulation and regulates both commercial and noncommercial expression. Thus the offensive trademark provisions of Section 2(a) may only be constitutional if: (1) the Court holds that the second element of a free speech violation (suppression or punishment of expression, or other actionable harm to expression) is not satisfied, (2) the Court finds that this content-based law satisfies strict scrutiny analysis, or (3) the Court creates a new trademark-specific free speech doctrine that excludes this trademark law from traditional First Amendment analysis.

322. Some commentators argue that the trademark register should be classified as a nonpublic forum. *See, e.g.,* Sonia K. Katyal, *Trademark Intersectionality*, 57 UCLA L. Rev. 1601, 1669-82 (2010) (arguing that the trademark register is similar to vanity license plates); Hammad Rasul, *The Washington Redskins' Deflating Hope: The Lanham Act Survives the First Amendment Challenge*, 26 Marq. Sports L. Rev. 159, 171-79 (2015) (same); *see also* Leslie Gielow Jacobs, *The Public Sensibilities Forum*, 95 Nw. U. L. Rev. 1357, 1358-64, 1385 n.233 (2001) (stating that Section 2(a) conditions "the distribution of speech opportunities on meeting public sensibilities standards" when discussing nonpublic forums). Others argue the trademark register is more like a limited public forum. *See, e.g.,* Lefstin, *supra* note 11, at 702-07; Snow, *supra* note 11, at 109-10 (arguing the "trademark system functions as a metaphysical forum that Congress created for limited commercial purposes"); Stout, *supra* note 11, at 249-51.

For the reasons set forth in Part III.C. and Part IV.A.2 above, the Court should find that Section 2(a) does not implicate the First Amendment since the law only bans the registration (and not the use) of offensive trademarks. If the Court disagrees, it should hold that Section 2(a) is a content-based regulation of commercial and noncommercial expression, that the trademark register is not a government forum, and trademark registrations are not government speech, for the reasons set forth above. Whether the Court should apply strict scrutiny analysis to Section 2(a) or create a new trademark-specific free speech doctrine is beyond the scope of this article.

***B. The Differences Between Trademark Laws
and Copyright Laws May Justify Different
Constitutional Analysis of Laws Regulating
Trademarks and Copyrights***

In *Tam*, the Federal Circuit argued that a copyright law that allowed the government to deny a copyright registration based on the immoral, scandalous, or potentially disparaging content of the artistic or literary work would be an unconstitutional regulation of expression under the First Amendment, and said this fact offers additional support for the argument that the “may disparage” language in Section 2(a) of the Lanham Act is unconstitutional.³²³ The constitutionality of a government prohibition of copyright registration and protection for works of authorship that contain offensive content is beyond the scope of this article. Regardless, the constitutional analysis of such a copyright law would likely be different because the two intellectual property laws are different in various ways.³²⁴

First, the subject matter and goals of copyright and trademark law are quite distinct, and this fact may influence the analysis under the second element (suppression or punishment of expression, or other actionable harm to expression) and sixth element (constitutional scrutiny) of the proposed framework for a free speech violation. In copyright law, one acquires rights by creating an original work of authorship that is fixed in a tangible medium of expression, such as a poem written on paper or a computer. In the United States, the government primarily protects copyright to produce incentives to create and disseminate expression, and the Intellectual Property Clause of the U.S.

323. *In re Tam*, 808 F.3d 1321, 1346-48, 1353-55 (Fed. Cir. 2015) (en banc), *as corrected* (Feb. 11, 2016), *cert. granted sub nom. Lee v. Tam* (U.S. Sept. 29, 2016) (No. 15-1293).

324. For information about copyright laws in the United States, see David Nimmer & Melville B. Nimmer, *Nimmer on Copyright* (2016); Willard F. Patry, *Patry on Copyright* (2016). *See also* Snow, *supra* note 11, at 133-34 & n.162; Snow, *supra* note 260, at 1478-79; Tushnet, *supra* note 11, at 43-44.

Constitution specifically allows Congress to grant copyright protection to authors to promote the progress of science and the useful arts.³²⁵ The U.S. Supreme Court has also declared that copyright is the engine of free expression, and that copyright laws are constitutional as long as Congress does not alter the traditional contours of protection.³²⁶

If the U.S. government denies an author a copyright registration for an offensive novel first published in the United States, and thereby prevents her from suing in a U.S. court for copyright infringement, this decision would likely reduce the author's profits because others could copy her work and charge less or distribute it for free. This would decrease the incentive for that author to create this new expression, and the public may not receive this message that the government deems to be offensive. A court may find this harm to incentives to create expression satisfies the second element of a free speech violation in my framework above (although it is not clear that it would do so), or the court may determine that the content-based law does not survive constitutional scrutiny under the Court's First Amendment jurisprudence for these reasons.

Unlike copyright, governments generally do not protect exclusive rights in trademarks to encourage the creation of more trademarks. Rather, they protect trademark rights to enable consumers to identify and distinguish goods and services in the marketplace, encourage trademark owners to invest in selling products of a consistent quality, and discourage fraud and unfair competition in the marketplace, among other goals. In the United States, Congress gets its power to regulate trademarks from the Commerce Clause of the U.S. Constitution,³²⁷ not the Intellectual Property Clause. While some trademarks are made-up fanciful marks, and these types of marks have stronger protection than descriptive terms claimed as trademarks, most trademarks (and especially offensive trademarks) are selected from our current language. Trademark rights are created upon registration or use of this previously-existing language in connection with certain goods or services. Even if there is no trademark registration for offensive terms, members of the public still have access to that language and are likely to still use it because of its inherent meaning. A company who is denied trademark rights for offensive language may (or may not) continue to use this language as part of a trademark or otherwise, and so can everyone else subject to other laws that regulate this expression, such as obscenity laws. Unlike

325. U.S. Const. art. I, § 8, cl. 8.

326. *Eldred v. Ashcroft*, 537 U.S. 186, 221 (2003); *see also* *Golan v. Holder*, 132 S. Ct. 873, 890 (2012).

327. U.S. Const. art. I, § 8, cl. 3.

a copyright law which denied registration to offensive expression, Section 2(a) does not discourage the creation of offensive expression, so it is less harmful to free expression values.

Another significant difference between copyright and trademark laws relates to the scope of rights and what type of use of the intellectual property triggers liability. Independent creation of offensive expression protected by copyright law is not infringing. But a trademark defendant can infringe a trademarked word or symbol without copying the plaintiff's trademark. It is possible that another party will use words such as FUCT on a T-shirt or RAGING BITCH in connection with the sale of beer,³²⁸ because of the inherent offensive meaning of the expression rather than to confuse consumers about the source or quality of the products. An accused infringer may not even realize someone claims trademark rights in the offensive language until the demand letter arrives in the mail. That individual or company may want to reclaim the word just like THE SLANTS rock band, or appeal to people who like profanity, slurs, or sexual images. Registering trademark rights in offensive language will help the trademark owner prevent dissemination of this offensive language in commerce by others who infringe or dilute the mark without any increase in the creation of new offensive language, which is arguably inconsistent with the right to freedom of expression.

Regardless of whether courts recognize a free speech right to copyright registration of offensive expression, it does not make sense to recognize a free speech right to registration of an offensive trademark. Providing exclusive nationwide trademark rights in this subject matter via registration will not create more expression and will instead likely result in the suppression, punishment, and chilling of the expression of others.

V. CONCLUSION

The Federal Circuit was wrong when it held in *Tam* that the disparagement provision of Section 2(a) of the Lanham Act is a facially-invalid regulation of expression under the First Amendment. Offensive expression will likely be chilled if governments allow (rather than deny) registration of offensive trademarks. If a rock band member cannot register THE SLANTS

328. While the USPTO denied Brunetti's application for the mark FUCT for clothing, *see supra* note 5, it granted the application to register RAGING BITCH for "[b]rewed malt-based alcoholic beverages in the nature of a beer." RAGING BITCH, Registration No. 4,063,379 (registered Nov. 29, 2011 by Flying Dog Brewery). The government has unsuccessfully attempted to stop Flying Dog from using the RAGING BITCH label, which includes a picture of a wild female dog in addition to the registered phrase. Jacob Sullum, *The Petty Tyranny of Beer Label Censors*, *Forbes.com* (May 19, 2016), <http://www.forbes.com/sites/jacobsullum/2016/05/19/how-raging-bitch-bad-frog-and-dirty-bastard-escaped-beer-label-censorship/#5ef0a126f218>.

as a mark and obtain the benefits of registration, he may still use that expression. He may also adopt a different non-disparaging name, slogan, or logo that can be registered. If he can register THE SLANTS mark, the public may be chilled from using these words in various ways. As trademark registrations help trademark owners obtain the government's assistance in suppressing and punishing use of the registered expression by others, we should not recognize a *free speech right* to secure that registration. The decision on whether to prohibit or allow registration of offensive language under trademark law should be left to national legislatures unless a court finds the law clearly violates the right to freedom of expression or other rights under that nation's constitution or human rights treaties.

The recent *Tam* and *Pro-Football* cases have increased the focus by courts and commentators on the potential conflict between the right to freedom of expression and trademark laws. This is a positive development and will help ensure that trademark laws are not abused to suppress, punish, and chill protected expression. At the same time, it is critical that we avoid applying free expression doctrines such as the unconstitutional conditions doctrine, the government speech doctrine, government forum doctrine, or laws regulating content-neutral regulations of expression to trademark registration law when those doctrines do not fit. Perhaps the U.S. Supreme Court will take the opportunity presented by *Tam* to create a new trademark-specific free expression doctrine that balances trademark rights, the right to freedom of expression, and other public interests at issue in a trademark dispute. Regardless of what the Court does in *Tam*, however, this article provides a framework for considering the constitutionality of trademark laws in the United States and other countries.
