

NOVEMBER/DECEMBER 2016

VOLUME 22 NUMBER 6

DEVOTED TO
INTELLECTUAL
PROPERTY
LITIGATION &
ENFORCEMENT

*Edited by Gregory J. Battersby
and Charles W. Grimes*

IP

Litigator



Wolters Kluwer



Trademark Litigation

James L. Gannon, II

A Disparaging Trademark?

Supermarket tabloids love to report on the legal battles of musicians; from Michael Jackson's trial on charges of sexual abuse, to Britney Spears' conservatorship, to Justin Bieber's DUI, the more salacious the story, the better. Even the more reputable news outlets get in on the action from time to time, as long as the musician in question is a major name. But the Supreme Court of the United States is set to hear a case involving a rock band out of Portland, Oregon, and it has the possibility of changing trademark law forever.

The Slants are an Asian-American band who want to trademark their name, but the United States Patent and Trademark Office (USPTO) is having none of it. The USPTO has twice refused to grant them a trademark, arguing that the mark "consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols." In making this argument, the USPTO is relying on the Lanham Act, which contains an explicit prohibition on potentially disparaging marks. Since the law has

been around and enforced for nearly 70 years, there's probably no chance of overturning it, is there? Well, that's where things get interesting.

The band had argued that the "offensive connotations of the word [slant] have diminished to the point where the use of the word is obsolete or archaic as a form of disparagement, and indeed, Asians today increasingly view 'slant' as a proud informal term of self-reference." The USPTO wasn't buying this argument, so The Slants did what all good bands do—they took their show on the road. In this case, that meant booking a gig across the Potomac: They filed an appeal at the Court of Appeals for the Federal Circuit (CAFC) in Washington, DC. [*In Re Simon Shiao Tam*, 2014-1203, Appeal from the US Patent and Trademark Office, Trademark Trial and Appeal Board in No. 85/472,044, December 22, 2015.] In this case, not only did they argue that the mark was not disparaging, but they also argued that a prohibition on disparaging marks violated their First Amendment right to free speech.

The band's first outing at the CAFC didn't go well, as a three-judge panel upheld the USPTO's

decision. However, the band continued to fight, and later had their case heard by the full CAFC (12 judges in total). It was on December 22, 2015, that they were awarded their first victory. In a 10 to 2 decision, the CAFC held that the disparagement provision of the Lanham Act was unconstitutional. But their tour of the federal court system doesn't stop there. On September 29, 2016, the Supreme Court agreed to hear arguments on the case in the upcoming (now present) term, and you can be certain that they won't be the only ones listening. The Washington Redskins, who are involved in a similar lawsuit regarding disparaging trademarks, have a fairly vested interest in the case, given that they had their trademark cancelled by the USPTO in 2014 for the same reasons.

In all, it is a fascinating saga that invokes both intellectual property and free speech issues and goes to show the lengths to which people will go to protect their brands.

James L. Gannon, II is an associate with Montgomery McCracken. He focuses his practice on intellectual property matters, including the drafting and prosecuting of applications for patents, trademarks and copyrights, both domestically and abroad. Additionally, he counsels business owners on a variety of topics relating to the protection of their intellectual property assets.

Copyright © 2016 CCH Incorporated. All Rights Reserved.

Reprinted from *IP Litigator*, November/December 2016, Volume 22, Number 6, page 28, with permission from Wolters Kluwer, New York, NY, 1-800-638-8437, www.wklawbusiness.com