

# Justices Skeptical That Offensive TM Ban Is Constitutional

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Law360, New York (January 18, 2017, 5:32 PM EST) -- The [U.S. Supreme Court](#) heard arguments Wednesday in the high-profile battle over the federal government's ban on offensive trademark registrations, at times sounding highly skeptical that the rule passes muster under the First Amendment.

Hearing arguments in a case pitting a rock band called The Slants against the [U.S. Patent and Trademark Office](#) — and one that will likely decide the Washington Redskins' similar case over its trademarks — all eight justices at times voiced doubts that the Lanham Act's decades-old ban on “disparaging” registrations was constitutional.

Justice Elena Kagan, questioning Deputy Solicitor General Malcolm L. Stewart, said it seemed like “a fairly classic case of viewpoint discrimination.”

“I always thought that government programs were subject to one extremely important constraint, which is that they can't make distinctions based on viewpoint,” Justice Kagan said. “So why isn't this doing exactly that?”

Justice Anthony Kennedy, meanwhile, asked whether the USPTO was trying to argue that it was “an omnipresent schoolteacher” that could monitor speech. Chief Justice John Roberts called the government's justification for the ban “circular,” and Justice Samuel Alito said the government was stretching its defense of the ban “past the breaking point.”

The Slants, an Oregon dance rock band whose members are Asian Americans, chose their name to “reappropriate” an anti-Asian slur, but were refused a trademark registration in 2013 on the grounds that it violated the Lanham Act's Section 2a, which bars the registration of trademarks that “disparage” people.

The band appealed that decision to the Federal Circuit, which [sided with it in December 2015](#). The appeals court said Section 2a unconstitutionally denied the band the benefits of trademark registrations based on their speech.

The USPTO appealed the case to the high court, which agreed to tackle the issue in September. The case is receiving even more attention because the eventual ruling will likely make or break the higher-profile parallel case of the Washington Redskins, which saw their own registrations [revoked in June 2014](#) on the grounds that they violated Section 2a by disparaging Native Americans.

On Wednesday, Justice Stephen Breyer repeatedly asked Stewart why the ban was necessary in a statute that is otherwise designed to further the fundamental goal of trademark law — that is, to protect consumers from being confused about the source goods and services.

Stewart said disparaging terms would “distract” the consumer from that source-designating message of a trademark, but Justice Breyer didn’t seem to buy it.

“I can think [of] probably, and with my law clerks, perhaps 50,000 examples of instances where the space the trademark provides is used for very distracting messages, probably as much or more so than the one at issue, or disparagement,” the justice said. “And what business does Congress have picking out this one but letting all the other distractions exist?”

To be sure, the justices also grilled John C. Connell, counsel for The Slants, questioning whether his free speech argument went a bit too far.

Could the trademark office refuse a registration that “Smith’s beer is poison?” asked Justice Breyer. What about a mark that slanders or libels an individual? asked Justice Sonia Sotomayor, citing the example of “Trump is a thief.”

Connell said that neither marks should be refused, prompting Justice Sotomayor to shoot back, “that makes no sense.”

Ronald Coleman, co-counsel for The Slants, said after Wednesday’s arguments that he was “optimistic” about the court’s leaning.

“The hardest questions thrown at us were theoretical and explored the limits of our arguments,” Coleman said. “In contrast, most of the justices seemed unconvinced of the government’s core propositions and made that clear from the outset.”

A ruling is expected by the end of the Supreme Court’s term in June.

The USPTO is represented by its own attorneys and attorneys from the [U.S. Department of Justice](#).

The band is represented by John Connell, Ronald D. Coleman and Joel G. MacMull of [Archer & Greiner PC](#) and Stuart Banner and Eugene Volokh of the University of California, Los Angeles, School of Law.

The case is Lee v. Tam, case number 15-1293, in the Supreme Court of the United States.

--Editing by Christine Chun.

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