



# THINK FORWARD

## Supreme Court Agrees to Take on USPTO's Refusal to Register Disparaging Trademarks

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On September 29, 2016, the U.S. Supreme Court agreed to decide a case challenging the constitutionality of a law prohibiting registration of degrading trademarks with the United States Trademark and Patent Office (USPTO). The case has direct implications for the Washington Redskins in its fight to defend the team name and highlights the ongoing battle between free speech and federal trademark protection.

The case before the Supreme Court, *Lee v. Tam*, focuses on an Asian-American band named "The Slants." One of the band members, Simon Shia Tam, sued the USPTO for refusing to permit the registration of the band name on the basis that the term "slants" is disparaging to people of Asian descent. Under Section 2(a) of the Lanham Act, a trademark shall be refused registration if it consists of matter which "may disparage" persons, institutions, or national symbols. On appeal, the Federal Circuit held in a 10-2 decision that the band's name was private speech and therefore protected by the First Amendment. The USPTO appealed and the Supreme Court justices must now decide whether the free speech clause of the First Amendment trumps Section 2(a).

Earlier this year, the National Football League's Washington Redskins asked the Supreme Court to review its case challenging the USPTO's decision to cancel its "Redskins" trademark registration on the basis that it is disparaging to Native Americans. The Supreme Court justices have not yet decided whether they will also hear the Redskins' case, but it is likely that the decision in the *Tam* case will have a bearing.

While the USPTO's refusal to federally register "The Slants" or "Redskins" will not prohibit use of the names, the absence of federal trademark registrations significantly impacts the trademark owners' ability to enforce their intellectual property rights and stop unauthorized uses of the names. Federal registration of trademarks confers additional rights and remedies on registered trademark owners. For example, lack of federal registration deprives trademark owners of the presumption of validity of the marks, and results in increased enforcement costs for the owner. While the fate of Section 2(a) is uncertain until the Supreme Court weighs in, this question promises to yield an interesting debate in the months ahead.

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