
Trademark Law—Federal Circuit Holds En Banc That Excluding Disparaging Trademarks Violates First Amendment—*In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015) (en banc)

Congress enacted the Lanham Act for two primary reasons: ensuring public confidence that a product is genuine, and preventing misappropriation of that product’s identifiers by “pirates and cheats.”¹ Section 2(a) of the Lanham Act prevents federal registration of scandalous, immoral, or disparaging trademarks.² In *In re Tam*,³ the Federal Circuit reviewed en banc whether the First Amendment allows the denial of a trademark application that the Trademark Examiner and Trademark Trial and Appeals Board (TTAB) found disparaging.⁴ Vacating the TTAB’s holding, the Federal Circuit held that the “disparaging” provision of section 2(a) of the Lanham Act violates the First Amendment right to free speech because the government has no legitimate interest in denying registration under the provision.⁵

Simon Shiao Tam, the founder of The Slants, an Asian-American band, attempted to register the band’s name as a trademark.⁶ The trademark examiner from the PTO refused to register Tam’s mark because persons of Asian descent could find the mark disparaging, therefore causing the mark to

1. S. REP. No. 79-1333, at 3 (1946) (noting reasons for enacting Lanham Act); *see also* *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 782 n.15 (1992) (Stevens, J., concurring) (highlighting congressional goals underlying Lanham Act); J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 2:1-2:2 (4th ed. 2016) (outlining trademark law’s traditional and modern goals). The Lanham Act is the primary legislative source of federal trademark law in the United States. *See generally* Lanham Act, 15 U.S.C. §§ 1051-1127 (2012) (defining United States trademark law).

2. *See* 15 U.S.C. § 1052(a) (barring registration of scandalous, disparaging, immoral, or deceptive matters).

3. 808 F.3d 1321 (Fed. Cir. 2015) (en banc).

4. *See id.* at 1334 (posing legal question on review); *see also* 15 U.S.C. § 1052(a) (denying trademark registration to disparaging matters); TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1203.03(b)(i) (17th ed. 2016) [hereinafter TMEP] (outlining grounds for examiner refusal of disparaging mark); *In re Tam*, 108 U.S.P.Q.2d (BNA) 1305, 1306 (T.T.A.B. 2013) (affirming examiner’s decision). The TTAB affirmed the examiner’s position in denying registration, as did the Federal Circuit panel. *See* 808 F.3d at 1332.

5. *See* 808 F.3d at 1328, 1357-58 (holding government interest in banning disparaging marks invalid under intermediate and strict scrutiny tests); *see also In re Tam*, 785 F.3d 567, 568 (Fed. Cir. 2015) (affirming TTAB’s initial decision). Although the Federal Circuit considered the mark disparaging, it ultimately concluded that a ban on disparaging marks should be subject to strict scrutiny under the First Amendment, and without a legitimate government interest, the ban could not stand. *See* 808 F.3d at 1328, 1357-58. The Supreme Court of the United States recently granted the U.S. Patent and Trademark Office’s (PTO) petition for certiorari on this case. *See* Petition for a Writ of Certiorari, *In re Tam sub nom. Lee v. Tam* (No. 15-1293), 2016 WL 1593780, at *8, *cert. granted* [hereinafter Petition for Certiorari] (describing reasons supporting grant of certiorari).

6. 808 F.3d at 1331 (discussing background of Tam’s band). Tam chose his band name in an attempt to “reappropriate the disparaging term.” *Id.*

be barred under section 2(a) of the Lanham Act.⁷ Tam appealed the PTO's decision to the TTAB, arguing that the PTO improperly based its decision on Tam's ethnic background.⁸ The TTAB rejected Tam's arguments and affirmed the PTO's refusal to register his mark.⁹

Further appealing to the Federal Circuit, Tam argued that the TTAB erred in finding the mark disparaging and that section 2(a) was unconstitutional.¹⁰ The Federal Circuit affirmed the TTAB's decision, holding that substantial evidence bolstered its assessment that people of Asian descent would likely find the mark offensive.¹¹ Filing an additional opinion, Judge Moore requested that the Federal Circuit review the constitutionality of section 2(a).¹² The Federal Circuit held a sua sponte hearing en banc, vacated the panel opinion, and re-examined the constitutionality of section 2(a).¹³ After the en banc review, the

7. *See id.* (highlighting examiner's reasons for refusal). Marks that offend only specific ethnic and religious groups are disparaging rather than scandalous. *See In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215, 1217 (T.T.A.B. 2010) (noting mark only scandalous if substantial portion of public considers mark offensive).

8. *See In re Tam*, 108 U.S.P.Q.2d (BNA) 1305, 1308-09 (T.T.A.B. 2013) (noting reasons for appeal to TTAB). On appeal, the TTAB looked to the mark's perceived meaning from those of Asian descent's perspective. *See id.* at 1311. Because Tam clearly meant for the mark to represent the noted meaning, even if he did not intend it to be disparaging, it could still be disparaging to a member of the referenced ethnicity. *See id.* The TTAB utilized dictionary definitions and community objections to support its finding. *See* 808 F.3d at 1332.

9. *See In re Tam*, 108 U.S.P.Q.2d (BNA) 1305, 1313 (T.T.A.B. 2013) (affirming refusal to register mark).

10. *See* 808 F.3d at 1332 (noting basis of appeal to Federal Circuit).

11. *See id.* at 1332-33 (reciting panel opinion holding). The panel found substantial evidence showing that Tam intended the mark to reference people of Asian descent, and the public could perceive it as such. *See In re Tam*, 785 F.3d 567, 570-71 (Fed. Cir. 2015). Following its precedent, the court applied a two-part test to analyze whether the mark was disparaging, and concluded that the "well-established" test was not unconstitutionally vague. *See id.* at 572. This two-part test consisted of examining the likely meaning of the questioned mark, and then determining whether that meaning may refer to a group of people and if that meaning is disparaging to that group. *See id.* at 569. Accordingly, the court held that the TTAB did not err in finding the mark disparaging. *See id.* at 571.

12. *See In re Tam*, 785 F.3d 567, 573 (Fed. Cir. 2015) (Moore, J., additional views) (urging court to review constitutionality of section 2(a)). Judge Moore evaluated three factors required for a First Amendment violation: whether the speech at issue is protected speech, whether government action is abridging that speech, and, if so, whether that government abridgment is unconstitutional when analyzed under the proper test. *See id.* at 574. Judge Moore concluded that registration is subject to the "unconstitutional conditions" test because trade names are protected commercial speech, effects of trademark registration are significant, and trademark registration is a regulatory activity, not government speech. *See id.* at 574-81; *see also infra* note 20 (exploring unconstitutional conditions doctrine). After determining that the unconstitutional conditions doctrine applied, Judge Moore concluded that the disparaging provision of section 2(a) engaged the government in viewpoint discrimination, and thus the provision should be subject to strict scrutiny. *See In re Tam*, 785 F.3d 567, 581-82 (Fed. Cir. 2015) (Moore, J., additional views). Judge Moore also noted that although the Supreme Court has yet to decide whether viewpoint discriminatory restrictions on commercial speech should be subject to strict scrutiny, the provision fails even under the intermediate scrutiny test that the Court had previously used for commercial speech. *See id.* at 582; *see also* *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 566 (1980) (presenting four-part test for determining constitutionality of commercial speech restrictions).

13. *See In re Tam*, 600 F.App'x. 775 (mem.), 775-76 (Fed. Cir. 2015) (per curiam) (ordering en banc

Federal Circuit held that the disparagement provision of section 2(a) was unconstitutional and remanded the case, overturning the precedent of *In re McGinley*,¹⁴ which stated that refusal to register a mark under section 2(a) of the Lanham Act did not suppress freedom of expression.¹⁵ Four Federal Circuit judges filed additional opinions providing concurring and dissenting views.¹⁶

McGinley previously acted as the Federal Circuit's primary authority in determining the constitutionality of section 2(a) of the Lanham Act.¹⁷ Strict

hearing).

14. 660 F.2d 481 (C.C.P.A. 1981).

15. Compare 808 F.3d at 1328, 1330 n.1, 1333-34 (finding disparagement provision unconstitutional), with *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) (stating refusal to register not infringement of First Amendment rights). In reconsidering section 2(a)'s constitutionality, the Federal Circuit cited criticism of *McGinley*, its cursory analysis, and jurisprudential advancement since that decision. See 808 F.3d at 1333-34.

16. See *id.* at 1358 (O'Malley, J., concurring), 1363 (Dyk, J., concurring in part and dissenting in part), 1374 (Lourie, J., dissenting), 1376 (Reyna, J., dissenting). Judge O'Malley filed a concurrence arguing that in addition to its facial unconstitutionality, section 2(a) was also unconstitutionally vague. See *id.* at 1358 (O'Malley, J., concurring). Judge Dyk filed an opinion concurring in part and dissenting in part, agreeing that Tam's mark should not be invalidated, but stating that section 2(a) could still stand when concerning a wholly commercial mark. See *id.* at 1363, 1368, 1373-74 (Dyk, J., concurring in part and dissenting in part). Judge Lourie and Judge Reyna agreed with the bulk of Judge Dyk's opinion, but each also filed his own dissenting opinion, rejecting both the court and Judge Dyk's ultimate conclusions of the disparaging mark's unconstitutionality as applied to Tam. See *id.* at 1363 (Dyk, J., concurring in part and dissenting in part) (agreeing with majority concerning disparaging mark's unconstitutionality in Tam's case); see *id.* at 1374 (Lourie, J., dissenting) (joining Judge Dyk's position in some respects); see *id.* at 1376 (Reyna, J., dissenting) (upholding section 2(a)'s constitutionality); see also *infra* notes 40, 42-44 (discussing dissenters' reasoning).

17. See *In re McGinley*, 660 F.2d 481, 482 (C.C.P.A. 1981) (affirming examiner ability to reject scandalous marks). The Federal Circuit's predecessor, the United States Court of Customs and Patent Appeals, stated that one may still use a trademark even if the PTO refused to register the mark, and thus the provision does not infringe on First Amendment rights. See *id.* at 484; see also Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661, 685-87 (1993) (noting lack of detailed analysis in *McGinley* decision); Justin G. Blankenship, Note, *The Cancellation of Redskins As a Disparaging Trademark: Is Federal Trademark Law an Appropriate Solution for Words That Offend?*, 72 U. COLO. L. REV. 415, 444 (2001) (positing indefiniteness of *McGinley* analysis). The Federal Circuit and TTAB previously used *McGinley* precedent to justify the ban on disparaging marks. See *In re Geller*, 751 F.3d 1355, 1358, 1360-61 (Fed. Cir. 2014) (relying on previous TTAB decision, *In re Mavety Media Group Ltd.*, which *McGinley* justified); see, e.g., *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215, 1216 (T.T.A.B. 2010) (applying *McGinley* in analysis of KHORAN mark); *In re Heeb Media, LLC*, 89 U.S.P.Q.2d (BNA) 1071, 1077 (T.T.A.B. 2008) (applying *McGinley* to reject HEEB mark); *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d (BNA) 1264, 1268-69 (T.T.A.B. 2006) (applying *McGinley* in SQUAW mark analysis); *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1218 (T.T.A.B. 1993) (applying *McGinley* in permitting mark registration to prophylactics bearing American flag). Other courts have also relied on *McGinley* as justification for the ban, despite the brevity of its analysis. See *Test Masters Educ. Servs., Inc. v. Singh*, 428 F.3d 559, 578 n.9 (5th Cir. 2005) (agreeing denial of mark registration does not violate First Amendment rights); *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 455 (E.D. Va. 2015) (following circuit holdings determining mark registration refusal does not violate First Amendment rights). Various appellate briefs in *Pro-Football, Inc. v. Blackhorse* have urged the Fourth Circuit to follow *McGinley* rather than *Tam*. See 112 F. Supp. 3d 439 (E.D. Va. 2015); Final Brief for the United States at 25-27, 52-53, *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015), (No. 15-1874), 2016 WL 1104585 [hereinafter *Blackhorse U.S. Brief*]; Response Brief of Appellees at 32, *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015), (No. 15-1874), 2016 WL 1104586 [hereinafter *Blackhorse*

scrutiny applies when the government denies the legal right to private speech based on government disapproval of that speech.¹⁸ The same is true when the government denies a party a benefit because of that party's protected speech or association, and in turn, chills private speech discriminatorily.¹⁹ This unconstitutional conditions doctrine prevents government benefits from being conditioned on the waiver of a constitutional right.²⁰ Registered trademarks have clear benefits over unregistered marks, placing owners of unregistered marks at a disadvantage.²¹

If trademarks are protected speech, then the unconstitutional conditions doctrine may apply when the government denies one.²² Government speech, however, is not subject to the same requirements as First Amendment protected speech.²³ Because the federal government manages trademark registration, it is unclear how the speech that trademarks embody should be categorized.²⁴

Appellee Brief].

18. See *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2226 (2015) (requiring narrow tailoring and compelling state interest for laws targeting content-based speech). The government must have compelling reasons to discriminate by topic or message conveyed. See *id.* at 2227.

19. See *Perry v. Sindermann*, 408 U.S. 593, 597 (1972) (noting government cannot deny benefits on bases infringing upon constitutional interests).

20. See *Perry v. Sindermann*, 408 U.S. 593, 597 (1972) (defining unconstitutional conditions doctrine). The unconstitutional conditions doctrine provides that:

[E]ven though a person has no 'right' to a valuable governmental benefit and even though the government may deny him the benefit for any number of reasons, there are some reasons upon which the government may not rely. It may not deny a benefit to a person on a basis that infringes his constitutionally protected interests—especially, his interest in freedom of speech. For if the government could deny a benefit to a person because of his constitutionally protected speech or associations, his exercise of those freedoms would in effect be penalized and inhibited.

Id.

21. See *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1300 (2015) (reviewing advantages of registered trademarks). Registration is prima facie evidence of a mark's validity, and it allows causes of action under Lanham Act section 32(1). See MCCARTHY, *supra* note 1, §§ 19:9, 25:26 (listing benefits provided by registered mark ownership). Registering a mark affords the mark holder several advantages, including: conferring federal jurisdiction for infringement actions; providing for the ability to recover treble damages and attorney's fees in federal court; acting as prima facie evidence of the mark's validity; creating the ability for a mark to become incontestable; serving as constructive notice of an ownership claim; and preventing unlawful importation of items bearing an infringing mark. See *id.*; see also Lanham Act, 15 U.S.C. § 1072 (2012) (declaring registration constructive notice of ownership); § 1114(1) (providing cause of action for infringement of registered marks); § 1115(a) (declaring evidentiary value of registered mark); § 1115(b) (discussing evidentiary value of incontestable mark); § 1124 (banning importation of goods bearing mark infringing on registered mark).

22. See Jeffrey Lefstin, Note, *Does the First Amendment Bar Cancellation of Redskins?*, 52 STAN. L. REV. 665, 699 (2000) (discussing application of unconstitutional conditions doctrine to trademark registration).

23. See *Pleasant Grove City v. Summum*, 555 U.S. 460, 467 (2009) (noting Free Speech Clause restricts regulation of private speech and does not regulate government speech). Private speech is an individual's or organization's message; this is contrary to government speech, where the government maintains direct control over the content and message. See *id.* at 467-69 (observing differences between private and government speech).

24. Cf. *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2253 (2015) (holding

Furthermore, trademarks have elements of both expressive and commercial speech.²⁵

The Supreme Court usually treats commercial speech differently than other types of private, expressive speech, by holding regulation over commercial speech to a lower constitutional standard.²⁶ Under the intermediate scrutiny standards to which commercial speech is subject, courts utilize a four-part test devised in *Central Hudson Gas & Electric Corp. v. Public Service Commission of New York*²⁷ (*Central Hudson* test) to determine whether regulation is appropriate.²⁸ The government can implement regulations on commercial speech provided that the commercial speech is lawful and not misleading; the government has a substantial interest in regulating the speech; the regulation advances that same government interest; and the regulation is not unnecessarily extensive.²⁹

In *Tam*, the Federal Circuit applied strict scrutiny to invalidate section 2(a).³⁰ The court held that the disparagement provision was neither content nor viewpoint neutral, and thus, failed the strict scrutiny analysis.³¹ Although trademarks have aspects of commercial speech, the court reasoned that section 2(a), in reality, suppressed the expressive components of a mark.³² The Federal

specialty license plates constitute government speech). Allowing trademark registration does not mean that the government endorses that trademark. See MCCARTHY, *supra* note 1, § 19:3.50. Nevertheless, government endorsement is a factor that can convert a message from private speech into government speech. See Walker v. Texas Div., Sons of Confederate Veterans, Inc., 135 S. Ct. 2239, 2251 (2015) (holding Texas's license plates constitute government speech because observers reasonably interpret message coming from state).

25. See Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(a) Trademark Law After Lawrence v. Texas*, 9 MARQ. INTELL. PROP. L. REV. 187, 225-26 (2005) (considering mark either commercial speech or pure speech); see also Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 966 (1993) (discussing legal ramifications of trademarks moving beyond simple source identification).

26. See *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 588-89 (1980) (Rehnquist, J., dissenting) (noting Court gives commercial speech "subordinate position" to noncommercial expression); see also *R.A.V. v. City of St. Paul*, 505 U.S. 377, 388-89 (1992) (noting different characteristics justify different treatment of commercial speech); *Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447, 456 (1978) (indicating Court limits First Amendment treatment of commercial speech); Gibbons, *supra* note 25, at 227 (discussing level of scrutiny applied to different forms of speech).

27. 447 U.S. 557 (1980).

28. See *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 573 (1980) (Blackmun, J., concurring) (defining Court's intermediate scrutiny test).

29. See *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 566 (1980) (majority opinion) (outlining four-part test to determine if commercial expression protected).

30. See 808 F.3d at 1334 (determining strict scrutiny should apply).

31. See *id.* at 1334-37 (examining method with which section 2(a) regulates speech and finding neither content nor viewpoint neutrality). The court determined that section 2(a) discriminates against content because it targets the topic and basis of the message expressed in the speech. See *id.* at 1335. The court also reasoned that because positive racial marks are allowed, but disparaging marks are not, the government violated viewpoint neutrality. See *id.* at 1336.

32. See *id.* at 1338-39 (noting strict scrutiny applies to expressive speech). The court emphasized that the case "exemplif[ie]d how marks often have an expressive aspect over and above their commercial-speech aspect." *Id.* at 1338.

Circuit, applying the unconstitutional conditions doctrine, also rejected the government's argument that the provision does not ban speech—stating while the government's argument may be true, it discriminatorily chills private speech.³³

The Federal Circuit also rejected the argument that trademark registration is a form of government speech exempt from strict scrutiny.³⁴ Further applying the unconstitutional conditions doctrine, the court rejected the government's argument that trademark registration was a subsidy falling outside a strict scrutiny analysis.³⁵ To bolster its rationale, the Federal Circuit then applied the *Central Hudson* test, finding section 2(a) unconstitutional even when applied to purely commercial speech under the intermediate scrutiny standard.³⁶ In its analysis, the court recognized that jurisprudence on commercial speech protection “has evolved significantly since the *McGinley* decision.”³⁷ The Federal Circuit ultimately held that the disparaging provision of section 2(a) fails under both strict and intermediate scrutiny, and overturned *McGinley* as it relates to disparaging marks.³⁸

The *Tam* decision leaves many questions regarding the scope of section 2(a)'s validity unanswered, despite the Federal Circuit's intent to clarify the issue.³⁹ Likewise, the court made little assertion as to the proper test—and

33. *See id.* at 1339-40 (applying unconstitutional conditions doctrine and stating strict scrutiny applies). The court examined the effects section 2(a) had on the selection of trademarks and concluded that a party would be deterred from adopting a mark that could be found disparaging given the benefits a registered mark has over an unregistered one. *See id.* at 1340-42; *see also supra* note 21 and accompanying text (discussing differences between registered and unregistered marks). The court further posited on the uncertainty as to what various parties may consider disparaging, noting the lack of reliability and consistency in grants and denials of trademarks that create uncertainty and Fifth Amendment vagueness problems. *See id.* at 1341-42, 1342 n.7. Compare 808 F.3d at 1361-63 (O'Malley, J., concurring) (presenting Fifth Amendment argument to invalidate section 2(a)), with Baird, *supra* note 17, at 681-82 (arguing all of section 2(a) survives vagueness standards). Additionally, any state protections of such a mark would likely also be barred via similar provisions, as most state trademark statutes are based on a model grounded in the Lanham Act. 808 F.3d at 1343-44 (majority opinion).

34. *See* 808 F.3d at 1348 (concluding act of registration cannot constitute government speech).

35. *See id.* at 1354 (demonstrating weakness of government subsidy argument). The court reasoned that if courts expanded the strict scrutiny subsidy exception to trademark registration, the exception would stretch to “nearly all government regulation.” *See id.*

36. *See id.* at 1355-57 (determining government lacks legitimate interest to ban disparaging marks even under intermediate scrutiny analysis).

37. *See id.* at 1334 (citing *In re Tam* 785 F.3d 567, 574 (Fed. Cir. 2015) (Moore, J., additional views)).

38. *See* 808 F.3d at 1357-58 (concluding disparagement provision of section 2(a) lacks constitutionality). “[Section] 2(a) does more than discriminate on the basis of topic. It also discriminates on the basis of message conveyed It does so as a matter of avowed and undeniable purpose, and it does so on its face.” *Id.* at 1335. The Federal Circuit, in its conclusion, made it clear that its decision does not mean it endorses the mark at issue, nor other disparaging marks. *See id.* at 1357-58. Many registered trademarks express messages that the government is unlikely ever to endorse. *See id.* at 1346-47. In her concurrence, expanding on the court's question of statutory vagueness, Judge O'Malley declared that she would also hold the disparagement provision of section 2(a) unconstitutionally vague under the Fifth Amendment, regardless of whether the First Amendment also invalidated it. *See id.* at 1358 (O'Malley, J., concurring).

39. *See id.* at 1330 n.1 (majority opinion) (limiting holding to disparaging marks only); *see also id.* at

level of scrutiny—to use in determining the validity of a Lanham Act provision.⁴⁰ The court declared that strict scrutiny should apply to section 2(a), yet analyzed the statute under intermediate scrutiny as well.⁴¹ Judge Reyna’s dissenting opinion in *Tam* presents a strong argument that under intermediate scrutiny, the government may have a legitimate interest supporting the provision.⁴² Alternatively, Judge Dyk’s opinion notes that, because the provision limits no speech beyond the federal trademark program, it may not “run afoul of the unconstitutional conditions doctrine.”⁴³

These uncertainties solidify the beliefs of those who question the holding’s validity and consider the court’s analysis misguided and incomplete.⁴⁴ The Federal Circuit factored in other courts’ reliance on *McGinley* in its ultimate decision to review the case’s validity concerning disparaging marks; by the same token, the dissenting opinions’ principles may similarly persuade other circuits not to follow the Federal Circuit’s holding in *Tam*, or convince the Supreme Court to overturn *Tam*.⁴⁵ For instance, briefs in a similar case pending in the Fourth Circuit, including a brief from the federal government, urging the courts to reject the *Tam* approach.⁴⁶

A large subjective element exists in determining whether a mark is disparaging or scandalous, as well as in determining where the line falls between the two categories.⁴⁷ By allowing registration of disparaging marks,

1364 (Dyk, J., concurring in part and dissenting in part) (postulating majority holding effectively invalidates scandalous marks and state provisions analogous to section 2(a)).

40. See *id.* at 1328 (majority opinion) (invalidating disparagement provision under both strict and intermediate scrutiny). While the majority subjected the provision to both strict and intermediate scrutiny, Judge Dyk would have invalidated the provision only regarding *Tam*’s mark, and would have analyzed individual marks according to their character of expression. See *id.* at 1373-74 (Dyk, J., concurring in part and dissenting in part) (declaring no government interest in rejecting *Tam*’s mark). In contrast, Judge Reyna would have defined trademarks as commercial speech requiring an intermediate scrutiny standard. See *id.* at 1376 (Reyna, J., dissenting) (upholding section 2(a)’s constitutionality, stating section 2(a) passes intermediate scrutiny).

41. See *id.* at 1355 (majority opinion) (applying *Central Hudson* test after performing strict scrutiny test).

42. See 808 F.3d at 1381 (Reyna, J., dissenting) (arguing section 2(a) meets intermediate scrutiny standard). Judge Reyna argued that the provision only imposes a “modest ‘burden’ on speech,” and is merely an incidental restriction on the First Amendment. See *id.* Judge Reyna noted that the government’s interest in “the orderly flow of commerce” should be balanced against the “modest imposition” of section 2(a), and that outcome would satisfy intermediate scrutiny standards. See *id.* at 1382.

43. See *id.* at 1370-71 n.6 (Dyk, J., concurring in part and dissenting in part) (noting majority opinion fails to justify violation of unconstitutional conditions doctrine).

44. See *id.* at 1374 (Lourie, J., dissenting) (positing denial of trademark registration not violation of First Amendment); *id.* at 1382 (Reyna, J., dissenting) (proposing government interest outweighs value of disparaging speech); see also Blackhorse U.S. Brief, *supra* note 17, at 25-27 (posing concerns resulting from *Tam* opinion); Blackhorse Appellee Brief, *supra* note 17, at 32 (requesting Fourth Circuit reject *Tam* holding).

45. See 808 F.3d at 1334 (providing court reliance as reasoning for en banc order); *supra* notes 42-44 and accompanying text (discussing dissenting opinion rejections of *Tam* reasoning).

46. See Blackhorse U.S. Brief, *supra* note 17, at 25-27 (highlighting errors in *Tam* analysis); Blackhorse Appellee Brief, *supra* note 17, at 32 (stating *Tam* decided incorrectly).

47. See 808 F.3d at 1342 n.6 (discussing vague definition of disparaging mark); see also *id.* at 1363 (O’Malley, J., concurring) (advocating subjective nature of words used in statute); Blankenship, *supra* note 17,

but still refusing scandalous ones, the examiner or TTAB may simply elect to revise its guidelines and categorize marks that would have previously been considered disparaging as immoral or scandalous, thereby circumventing this decision.⁴⁸ For many disparaging marks, a clever party could argue and present evidence that a “substantial composite of the general public” would also find the mark scandalous.⁴⁹ In declining to further apply the holding to scandalous marks, the court ignores the question of whether the ban on immoral or scandalous marks is also unconstitutional and, perhaps, even encourages a challenge to those provisions.⁵⁰

In re Tam uproots commonly referenced—but weakly supported—precedent. The court’s focus on disparaging marks, rather than on section 2(a) in its entirety, leaves questions about scandalous or immoral marks unresolved. With its grant of certiorari, the Supreme Court now needs to decide whether it will limit its ultimate decision to disparaging marks, or answer those unresolved questions.

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at 432 (noting subjective aspect to scandalous determination).

48. See TMEP, *supra* note 4, § 1203.01 (providing rules for trademark examiners regarding section 2(a) matter); see also 808 F.3d at 1363 (O’Malley, J., concurring) (postulating TTAB’s opinion on subjective nature of section 2(a)).

49. See *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1218, 1221 n.4 (T.T.A.B. 1993) (noting terms “scandalous” and “disparaging” have independent definitions).

50. See 808 F.3d at 1330 n.1 (suggesting future panels consider constitutionality of other portions of section 2); see also *id.* at 1364 (Dyk, J., concurring in part and dissenting in part) (noting majority opinion may effectively invalidate scandalous marks). The U.S. government’s petition for certiorari appealing the *Tam* decision also raises this concern. See Petition for Certiorari at *23-24.