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Giving offense is a viewpoint

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The "disparagement clause" in Section 2 of the Lanham Act violates "bedrock" First Amendment principles and is therefore facially unconstitutional, the unanimous Supreme Court (without Justice Neil Gorsuch participating) held this week in *Matal v. Tam*, 2017 DJDAR 5793 (June 19, 2017). At issue was the Patent and Trademark Office's 2013 rejection of a trademark registration for "The Slants" — the name of Simon Tam's band, which the PTO found offensive to Asian-Americans. The court held that the PTO's refusal to register a trademark based on its determination that the term was disparaging was an impermissible viewpoint-based restriction on Tam's speech, and that the provision of the Lanham Act giving the PTO this authority is facially unconstitutional.

One of the government's primary arguments had been that the trademark register constitutes "government speech," and is therefore not constrained by the First Amendment. The court had ruled last term in *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*, 2015 DJDAR 6811, that Texas could deny an organization's application to manufacture a specialty license plate due to its offensive content. But all eight of the participating justices in *Tam* agreed that extending the government speech doctrine to the trademark register would be a bridge too far, and that the trademark register is nothing like the other fora the court has considered government speech, such as advertisements promoted by the government, monuments in city parks, or specialty license plates. The court confirmed that *Walker* "marks the outer bounds of the government-speech doctrine" and emphasized that if the government could circumvent the First Amendment "by simply affixing a government seal of approval" to private speech, the government's ability to "muffle the expression of disfavored viewpoints" would be nearly unlimited.

The court also agreed with Tam that the disparagement clause constitutes a viewpoint-based restriction on speech. In Justice Samuel Alito's straightforward formulation, "Giving offense is a viewpoint." In other words, because the disparagement clause allows only for "happy-talk" and prohibits the negative or offensive side of an issue, it is viewpoint-based. The court explained that protecting offensive speech is "at the heart of the First Amendment."

Justices Anthony Kennedy, Ruth Bader Ginsburg, Sonia Sotomayor and Elena Kagan would have stopped there, after concluding that the "viewpoint discrimination rationale renders unnecessary any extended treatment of other" arguments because viewpoint-based restrictions are subject to "rigorous constitutional scrutiny." Justice Alito (joined in this part by only Chief Justice John Roberts and Justices Clarence Thomas and Stephen Breyer) would have gone further and disposed of the government's other arguments that the trademark register constitutes a government subsidy or similar government program on which the government can impose limitations. Because Justice Gorsuch did not participate, neither of these positions carried a majority of the court.

Nor did the court resolve the important commercial speech issues raised by the parties. The government had asked the court to categorize trademarks as commercial speech subject to less constitutional scrutiny, but Justice Alito's opinion ducked that question and ruled that the disparagement clause was not even sufficiently narrowly tailored to advance a significant government interest — the base-line commercial speech test. Justice Kennedy and Justice Thomas both discussed this issue in their concurring opinions, and agreed that the disparagement clause would be subject to heightened scrutiny even if it was commercial speech (for Justice Kennedy because it is viewpoint-based, and for Justice Thomas because truthful commercial speech should always be subject to strict scrutiny). As a result, the concurring opinions suggest that at a majority of the court would hold that viewpoint-based restrictions on commercial speech are subject to heightened scrutiny.

Both Justice Alito and Justice Kennedy were careful to limit Tam's scope. Their opinions expressly hold open the question whether the same analytic framework would apply to other aspects of the Lanham Act and note that this case did not present a question regarding state consumer protection laws. The court also did not rule on other provisions of the Lanham Act, such as the provision barring "scandalous" or "immoral" trademarks, which raise similar viewpoint discrimination concerns. Many court-watchers were therefore left unsatisfied by what they viewed as a missed opportunity for the court to elucidate the important intersection between the First Amendment and trademark law.

But even the court's limited holding will have widespread impact — most notably and immediately on the Washington Redskins, whose trademark registration was canceled by the PTO under the disparagement clause. The Redskins' appeal is pending in the 4th U.S. Circuit Court of Appeals, and Tam's victory this week all but guarantees a victory for the Redskins as well.

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