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Brittany Wasserstein

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# SCOTUS to Determine If “THE SLANTS” Is Offensive to Asians

BY [BRITTANY WASERSTEIN](#) / ON OCTOBER 18, 2016

On September 29, 2016, the U.S. Supreme Court decided to revisit a controversial issue surrounding the federal government’s ban on offensive trademarks, specifically whether this ban violates free speech under the First Amendment of the United States Constitution. The Federal Circuit ruled on December 22, 2015 that the seventy-year old disparagement clause of the Lanham Act (quoted below) was in fact unconstitutional since the First Amendment forbids the government from banning offensive speech.<sup>[1]</sup> At issue here is the desire for an Asian-American Rock Band from Portland, Oregon to trademark the name of their band, THE SLANTS,<sup>[2]</sup> for “Entertainment in the nature of live performances by a musical band,” in order to “reclaim” and “take ownership” of Asian stereotypes.<sup>[3]</sup>

Section 2(a) of the Lanham Act provides that a trademark shall not be refused registration due to its nature unless it “[c]onsists of or comprises immoral deceptive, or scandalous matter; or matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”<sup>[4]</sup> In 2011, the U.S. Court of Appeals for the Federal Circuit upheld the decision of the U.S. Patent and Trademark Office (“PTO”) that the band’s name cannot be afforded trademark protection because the use of the name THE SLANTS is a racial slur that would be viewed as offensive or disparaging by a majority of Asian-Americans.<sup>[5]</sup> The PTO’s Trademark Trial and Appeal Board (“TTAB”) affirmed the examining attorney’s reasoning of refusal for registration, further explaining that “dictionary definitions and other sources cited by the party ‘unanimously categorize the word slant, when meaning a person of Asian descent, as disparaging.’”<sup>[6]</sup> The Board also pointed to evidence that Asian groups had objected to respondent’s use of the mark as the name of its band and that the members of the band have admitted their use of the word as an “ethnic slur for Asians” in order to “take on stereotypes” about Asians.<sup>[7]</sup>

Generally speaking, when the PTO is faced with a First Amendment case, its defense is usually that denying an applicant a registration doesn’t cause him/her much harm.<sup>[8]</sup> It also explains that nobody is banned from using such offensive terms in their everyday life, and that a mark is still capable of protection under common law trademark rights.<sup>[9]</sup> While it is true that a trademark can still be protected under common law, this protection is exclusively limited to the geographic area(s) to which the mark has been used.<sup>[10]</sup> Of course, a trademark holder would prefer to have a federally registered mark since “the holder of a federal trademark has a right to exclusive nationwide use of that mark where there was no prior use by others.”<sup>[11]</sup> This nationwide protection provides a trademark holder with a number of legal remedies and benefits, including but not limited to, stopping counterfeit goods at the border,

putting competitor companies on notice of a brand owner's trademark rights, and providing easier access to federal courts, if necessary.<sup>[12]</sup>

PTO decisions regarding whether a mark is disparaging or not seem to be arbitrary and unpredictable.<sup>[13]</sup> It has been contended, "Section 2(a) fosters arbitrary and discriminatory enforcement driven by the subjective personal views of PTO officials"<sup>[14]</sup> and that "the often-stated maxim that 'each case must be decided on its own facts' never rings so loudly as it does in Section 2(a) refusals."<sup>[15]</sup> This same issue was addressed in June 18, 2014, when a federal judge ordered cancellation of six trademarks belonging to an American professional football team on the grounds that the trademarks consisting in whole or in part of the term THE REDSKINS was obtained contrary to Section 2(a), 15 U.S.C. § 1052(a), as disparaging to Native Americans.<sup>[16]</sup> This case was one that sparked the start for free speech debate, and it remains a contested issue. The Washington Redskins dispute pointed to instances where similar disparaging marks were treated in different ways and had been registered by the PTO. Some examples include RETARDIPEDIA website, DANGEROUS NEGRO shirts, DUMB BLONDE beer, etc.<sup>[17]</sup> If the Supreme Court decides to strike down the federal government's ban on offensive trademarks, it will be interesting to see the effect on this high-profile case as well as the future of trademark registrations and trademark law.

*Brittany Waserstein is a second-year student at Benjamin N. Cardozo School of Law and a Staff Editor of the Cardozo Arts & Entertainment Law Journal. She is an active member of Cardozo's FAME Center, as well as the Entertainment Law Society and the Fashion Law Society.*

Linkedin profile: <https://www.linkedin.com/in/brittany-waserstein-18b3b538>

<sup>[1]</sup> See *In re Tam*, 785 F.3d 567 (Fed. Cir. 2015).

<sup>[2]</sup> See Donahue, Bill, *Offensive Trademark Ban Going Down? It Probably Should*, law360 (Sept. 29, 2016 9:50 PM), <http://0-www.law360.com.ben.bc.yu.edu/articles/846252/offensive-trademark-ban-going-down-it-probably-should>.

<sup>[3]</sup> *In Re Simon Shiao Tam*, loeb & loeb, <http://www.loeb.com/publications-ipentertainmentcaselawupdates-20160701-inresimonshiaotam>.

<sup>[4]</sup> Lanham Act § 2(a), 15 U.S.C. § 1052(a) (1946).

<sup>[5]</sup> *Lee v. Tam*, No. 15A925 (filed Mar. 9, 2016).

<sup>[6]</sup> *Id.* at 5.

<sup>[7]</sup> *Id.*

<sup>[8]</sup> Donahue, *supra* note 2.

[9] *Id.*

[10] J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 26:32 (4th ed.).

[11] *Id.*

[12] Donahue, *supra* note 2.

[13] <http://pdfserver.amlaw.com/nlj/Pro-Football%20opening%20brief.pdf>

[14] <http://pdfserver.amlaw.com/nlj/Pro-Football%20opening%20brief.pdf>

[15] <http://pdfserver.amlaw.com/nlj/Pro-Football%20opening%20brief.pdf> (quoting *In re Hines*, 1994 WL 456841, at \*5 (TTAB 1994)).

[16] Ernest V. Linek, *NFL Redskins Federal Trademark Registrations Canceled*, banner & witcoff, [https://bannerwitcoff.com/media/\\_docs/library/articles/Linek%20Fall%20Winter%202014%20newsletter.pdf](https://bannerwitcoff.com/media/_docs/library/articles/Linek%20Fall%20Winter%202014%20newsletter.pdf).

[17] <http://pdfserver.amlaw.com/nlj/Pro-Football%20opening%20brief.pdf>