




11-2016

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## Recommended Citation

92 Notre Dame L. Rev. 381

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THE FIRST AMENDMENT WALKS INTO A BAR:  
TRADEMARK REGISTRATION  
AND FREE SPEECH

*Rebecca Tushnet\**

INTRODUCTION

Section 2 of the Lanham Act, the federal law governing trademarks, lists a number of bars that preclude registration of a trademark on the federal register.<sup>1</sup> These reasons include: the claimed matter is functional, meaning it affects the cost or quality of the underlying product or service; the claimed matter is merely descriptive, meaning that consumers don't understand that it indicates source and instead think that it just describes some characteristic of the product; the claimed matter is deceptively misdescriptive, which is like descriptiveness except not true; the claimed matter is deceptive, meaning that the untruth would be material to consumers; the claimed matter is confusingly similar to an existing registered mark or mark in use in the United States; the claimed matter is the name, photo, or signature of a living person and there's no written consent from that person to register the mark; the claimed matter is the flag or insignia of a nation or state or other U.S. political subdivision; the claimed matter creates a false association with people or institutions; the claimed matter is a geographic indication for wine or spirits but identifies a place other than the origin of the goods; and, last but not least, the claimed matter is scandalous, immoral, or disparaging.

The constitutionality of section 2 is now in doubt. Washington's football team had its disparaging marks cancelled, a decision upheld by a district court in mid-2015 and now on appeal to the Fourth Circuit.<sup>2</sup> But in Decem-

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\* Professor of Law, Georgetown. Thanks to Enrique Armijo, Jack Balkin, Deven Desai, James Grimmelman, Mark Lemley, Glynn Lunney, Lisa Ramsey, Fred Schauer, Mike Seidman, Jessica Silbey, Mark Tushnet, participants at the Harvard Faculty Workshop, the Free Expression Scholars Conference at Yale, William & Mary's Student Intellectual Property Symposium, and the American University-Washington College of Law's Trademark Works in Progress event.

1 Lanham Act § 2, 15 U.S.C. § 1052 (2012).

2 *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015). In this Article, I have chosen to use the name of Washington's professional football team only where

ber 2015, the Federal Circuit, en banc, held that section 2(a)'s disparagement bar was unconstitutional in the case of Simon Tam, an Asian-American seeking to register an anti-Asian slur in order to reclaim its negative meaning.<sup>3</sup> The government apparently agrees that this holding also invalidates section 2(a)'s scandalousness bar,<sup>4</sup> and the Supreme Court granted certiorari to review the decision in September 2016.

The Federal Circuit's *In re Tam* decision drew on significant developments in First Amendment doctrine. For example, earlier in 2015, in *Reed v. Town of Gilbert*,<sup>5</sup> the Supreme Court struck down a city's sign regulations on the theory that they were content-based and didn't survive strict scrutiny. The rule suggested by *Reed* is that all state regulations of speech that depend on an evaluation of the content of the speech to determine whether the regulation has been violated are content-based and must survive strict scrutiny. Section 2 is almost nothing but content-based.

This Article analyzes the First Amendment arguments against section 2(a)'s disparagement bar with reference to the consequences of any invalidation on the rest of the trademark statute. My fundamental conclusions are that *In re Tam* is wrongly reasoned even given the Supreme Court's increased scrutiny of commercial speech regulations, and that to hold otherwise and preserve the rest of trademark law would require unprincipled distinctions within trademark law. More generally, the Supreme Court's First Amendment jurisprudence has become so expansive as to threaten basic aspects of the regulatory state; the result of subjecting economic regulations such as trademark registration to strict First Amendment scrutiny shows the damage that can be done thereby.

I will first discuss the difficulty of applying the First Amendment to trademark law, which grants one private entity the right to suppress others' commercial speech, but also facilitates commercial transactions. Then, assuming that the First Amendment will apply in some ways, I discuss trademark registration as a kind of government endorsement, as well as other arguments that have evolved to justify the disparagement bar. I conclude that section 2 is

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others use it in quotes or titles, or as a reference to non-human objects such as potatoes; I have used the name of Simon Tam's band because I accept his intent to reclaim the term. The *Notre Dame Law Review* makes every effort to avoid printing obscenities and racial slurs unless, as in some instances in this Article, they are essential to the integrity of the piece. The judgment calls about what words have to be evoked by asterisks and context indicate the implementation difficulties of policing "scandalous" and "disparaging" marks, but, as I will argue below, difficulty is not itself constitutional invalidity.

3 *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015) (en banc), cert. granted sub nom. Lee v. Tam, 2016 WL 1587871 (U.S. Sept. 29, 2016) (No. 15-1293).

4 Beth A. Seals, *Further Erosion to Section 2(a) of the Lanham Act—What's Left?*, LEXOLOGY (Jan. 27, 2016), <http://www.lexology.com/library/detail.aspx?g=6bd23dd3-0c57-4cd9-a37b-a0208892d8e4> (discussing a Department of Justice letter brief stating that "the reasoning of *Tam* requires the invalidation of Section 2(a)'s prohibition against registering scandalous and immoral marks as well . . . ." (quoting Letter Brief of U.S. Dep't. of Justice at 2, *In re Brunetti*, No. 2015-1109 (Fed. Cir. filed Jan. 21, 2016), <http://src.bna.com/cd6>)).

5 135 S. Ct. 2218, 2224 (2015).

generally constitutional as a government determination about what speech it is willing to enforce as a trademark.<sup>6</sup> I then specifically turn to the unconstitutional conditions doctrine as a useful lens through which to view the problem. Unconstitutional conditions cases suggest that the government can ask private entities for some speech-related things in exchange for discretionary benefits, but not for others; I conclude that the disparagement bar is not an unconstitutional condition on registration, because registration—unlike other programs that have raised unconstitutional conditions questions—is speech-based all the way down.

However, for those who disagree, I then argue that disparagement can't coherently be distinguished from a number of the other bars to registration once the harsh logic of the First Amendment applies. If trademark registration as a whole is constitutionally vulnerable under a particular vision of the First Amendment, that very result counsels against adopting that vision as constitutional doctrine. Then, I defend registration as a government program inherently shaping the speech environment against some further objections drawing on analogies to other regulations, primarily copyright.

I conclude by explaining how all of this work of distinguishing and defending ordinary trademark registration—an activity that happens over one hundred thousand times per year—is a consequence of misguided application of tough First Amendment scrutiny to the modern regulatory state. Many people think the government has no business rejecting trademark registration because the claimed mark is disparaging. That may be good policy. But if the Supreme Court strikes down the disparagement bar, it will face a difficult job distinguishing other aspects of trademark law. And these difficulties signal a greater problem: the Court has lost touch with the reasons

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6 Numerous scholarly articles argue that section 2(a)'s disparagement bar is unconstitutional. See, e.g., Theodore H. Davis, Jr., *Registration of Scandalous, Immoral, and Disparaging Matter Under Section 2(a) of the Lanham Act: Can One Man's Vulgarity be Another's Registered Trademark?*, 83 TRADEMARK REP. 801, 862 (1993); 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, 235–36 (2005); Michelle B. Lee, *Section 2(a) of the Lanham Act as a Restriction on Sports Team Names: Has Political Correctness Gone Too Far?*, 4 SPORTS LAW. J. 65, 71–74 (1997); Kimberly A. Pace, *The Washington Redskins Case and the Doctrine of Disparagement: How Politically Correct Must a Trademark Be?*, 22 PEPP. L. REV. 7 (1994); Ron Phillips, *A Case for Scandal and Immorality: Proposing Thin Protection of Controversial Trademarks*, 17 U. BALT. INTELL. PROP. L.J. 55, 68 (2008); Kristian D. Stout, *Terrifying Trademarks and a Scandalous Disregard for the First Amendment: Section 2(a)'s Unconstitutional Prohibition on Scandalous, Immoral, and Disparaging Trademarks*, 25 ALB. L.J. SCI. & TECH. 213 (2015); Jeffrey Lefstin, Note, *Does the First Amendment Bar Cancellation of REDSKINS?*, 52 STAN. L. REV. 665 (2000); Jendi B. Reiter, Note, *Redskins and Scarlet Letters: Why "Immoral" and "Scandalous" Trademarks Should Be Federally Registrable*, 6 FED. CIR. B.J. 191, 197 (1996); John V. Tait, Note, *Trademark Regulations and the Commercial Speech Doctrine: Focusing on the Regulatory Objective to Classify Speech for First Amendment Analysis*, 67 FORDHAM L. REV. 897, 899, 909, 915 (1998). But see Justin G. Blankenship, *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, 443–44 (2001); Ned Snow, *Free Speech and Disparaging Trademarks*, 57 B.C. L. REV. (forthcoming 2016).

that some content-based distinctions might deserve special scrutiny. Often, as the concurrences in *Reed* noted, perfectly sensible and by no means censorious regulations that depend on identifying the semantic content of speech would fall afoul of a real application of heightened scrutiny, to no worthwhile end.

## I. SHOULD THE FIRST AMENDMENT EVEN APPLY?

It's possible to argue that trademark is a First Amendment-free zone,<sup>7</sup> as copyright basically is except for the internal restraints of the fact/expression division and fair use.<sup>8</sup> This argument has heretofore been made only in the context of suppressing third parties' speech at the behest of trademark owners: trademark law creates property rights, and private property rights can be enforced without involving the government in the suppression of speech.<sup>9</sup> But one can imagine the same argument for registration: registration's benefits are also property rights, and the government doesn't implicate the First Amendment by creating property rights, or declining to create them.

In 1987, *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Committee*<sup>10</sup> (“SFAA”) upheld a law granting the United States Olympic Committee authority to suppress any unauthorized commercial or noncommercial but “promotional” uses of “Olympic” and related symbols, going beyond ordinary

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7 Frederick Schauer has offered the classic statement of the distinction between First Amendment coverage and First Amendment protection. Frederick Schauer, *Speech and “Speech”—Obscenity and “Obscenity”: An Exercise in the Interpretation of Constitutional Language*, 67 GEO. L.J. 899, 905 n.33 (1979) (“If an activity is covered by the first amendment, regulation of that activity is evaluated in light of the heightened standard of review required by the first amendment. . . . [I]f the state can put forth a justification that withstands strict scrutiny, the activity is not protected even though it is covered.”); see also Frederick Schauer, *The Boundaries of the First Amendment: A Preliminary Exploration of Constitutional Salience*, 117 HARV. L. REV. 1765 (2004); Frederick Schauer, *Out of Range: On Patently Uncovered Speech*, 128 HARV. L. REV. FORUM 346 (2015).

8 *Eldred v. Ashcroft*, 537 U.S. 186, 219–21 (2003) (holding that as long as Congress does not go beyond the “traditional contours” of copyright—as long as it preserves fair use and the idea/expression distinction—it has essentially complete freedom to legislate on what is covered by copyright); see also *Golan v. Holder*, 132 S. Ct. 873, 890 (2012).

9 See, e.g., *Dall. Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) (finding that a pornographic movie had no right to “appropriate plaintiff’s trademark” to “convey a barely discernible message”; trademark was “in the nature of a property right,” and “need not ‘yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist’” (quoting *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567 (1972))); *Interbank Card Ass’n v. Simms*, 431 F. Supp. 131, 133–34 (M.D.N.C. 1977) (explaining that enforcing trademark rights is like enforcing property rights, and does not infringe on the First Amendment); *Nat’l Bd. of YWCA v. YWCA of Charleston*, 335 F. Supp. 615, 625 (D.S.C. 1971) (“By granting to a religious organization the exclusive use of a name, the Patent Office only deprives other religious groups of the use of *that* particular name, and such grant does not deny such other religious organizations the opportunity to establish competing groups having the same purpose but with different names.”).

10 483 U.S. 522 (1987).

trademark law.<sup>11</sup> *SFAA* was wrong when decided—among other things, it implausibly characterized a law governing specified symbols as content-neutral<sup>12</sup>—and its acceptance of suppressing noncommercial, non-deceptive speech without any showing of harm is even more dubious today, after *United States v. Alvarez*<sup>13</sup> found that lies can’t be constitutionally punished in the absence of some kind of harm.<sup>14</sup> Nonetheless, the rationale that the U.S. Olympic Committee deserved a “limited” property right clearly had persuasive force to the Court, and the *Alvarez* Court did not reject *SFAA*.<sup>15</sup>

The last notable Lanham Act case to follow the property-loophole reasoning was also in 1987.<sup>16</sup> The continuing expansion of trademark liability to movies, art, and newspaper polls started to worry the courts of appeal, leading most of them to adopt a highly speech-protective standard, at least as applied to uses of trademarks in noncommercial speech (that is, in books, movies, and other non-advertising speech).<sup>17</sup> *SFAA* did nothing to slow this shift, and understandably so. If government has a completely free hand to

11 Amateur Sports Act of 1978, Pub. L. No. 95-606, § 110, 92 Stat. 3048 (granting rights against “any person who uses [specified Olympic symbols] for the purpose of trade, to induce the sale of any goods or services, or to promote any theatrical exhibition, athletic performance, or competition”). There are similar special statutory protections for other icons such as Smokey the Bear, the Red Cross, the Boy Scouts, and the Girl Scouts. See, e.g., 18 U.S.C. § 705 (2012) (veterans’ organizations); *id.* § 706 (American National Red Cross); *id.* § 707 (4-H Club); *id.* § 711 (“Smokey Bear”); *id.* § 711a (“Woodsy Owl”); Pub. L. No. 105-225, 112 Stat. 1360, 1362 (1998) (Girl Scouts); Pub. L. No. 94-443, 90 Stat. 1475 (1976) (Daughters of the American Revolution); Pub. L. No. 88-378, 78 Stat. 325, 328 (1964) (Little League Baseball); Pub. L. No. 74-373, 49 Stat. 457, 458 (1935) (American National Theater and Academy); Pub. L. No. 64-148, 39 Stat. 227 (1916) (Boy Scouts).

12 *SFAA*, 483 U.S. at 536–37. The Court also suggested that the test for regulation of truthful commercial speech was the same as the *O’Brien* test, and that the law at issue passed *Central Hudson* scrutiny. See *id.* at 537 n.16.

13 132 S. Ct. 2537, 2551 (2012).

14 The *SFAA* Court reasoned that Congress could make a wholesale determination that any commercial or promotional use of the Olympic marks was likely to cause confusion or to dilute the value of the trademark. See *SFAA*, 483 U.S. at 539 (“Congress reasonably could conclude that most commercial uses of the Olympic words and symbols are likely to be confusing. It also could determine that unauthorized uses, even if not confusing, nevertheless may harm the USOC by lessening the distinctiveness and thus the commercial value of the marks.”). However, Congress lacked an evidentiary basis for such fact finding, even though a blanket approach might be appropriate in other circumstances.

15 See *Alvarez*, 132 S. Ct. at 2554–56 (Breyer, J., concurring) (citing *SFAA* favorably); see also *id.* at 2559 (Alito, J., dissenting).

16 *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987).

17 *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) (rejecting the “no alternative avenues” approach as applied to trademark because it was insufficiently protective of speech rights, and explaining that it “cannot indulge the facile assumption that one can forbid particular words without running a substantial risk of suppressing ideas in the process” (quoting *Cohen v. California*, 403 U.S. 15, 26 (1971) (internal quotation marks omitted) (appears in original as, “cannot indulge the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process”)).

create property rights to trump the First Amendment, after all, then all it would need to do to overturn *New York Times v. Sullivan* is define a person's good reputation as her property.<sup>18</sup> In fact, if avoiding the First Amendment were that simple, a state could simply provide Native Americans property rights in their collective image, at which point they could prevent the Washington team from using disparaging—or any—references to them.<sup>19</sup>

Even apart from property reasoning, infringing uses may have been historically unprotected because they were considered low-value, misleading commercial speech integral to a commercial transaction. However, denial of trademark registration is not solely an issue of speech being unprotected because it's low-value. Denying registration is a determination that the government chooses not to support the speech at issue (whether or not that support is characterized as the creation of a property right). A registration may bar future registrations of similar marks; a trademark right allows its owner to suppress other *uses*. If denying the right to use a mark to other parties isn't a violation of a First Amendment right, why would denying trademark protection to the claimant be a violation of a First Amendment right, when both would be using it in the same way: to indicate the source of goods or services?<sup>20</sup> The reason has to lie in the government's justification for its action. For stopping infringement, the justification is the prevention of consumer deception, but, as we will see, the justifications for denying registration are rather more complicated.<sup>21</sup>

Another constitutional jurisprudence could use the fact that a trademark confers a private right to suppress other people's speech as a reason that the government can make balancing decisions about whom to favor. If the Washington team has trademark protection for its name, it can suppress

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18 Cf. Deven R. Desai, *Speech, Citizenry, and the Market: A Corporate Public Figure Doctrine*, 98 MINN. L. REV. 455, 494–95 (2013) (discussing the phenomenon of speech suppression through trademark dilution law).

19 Perhaps a takings problem would arise, as the Washington team has already claimed with respect to the cancellation in progress. But after the government paid for any taking, the team's claim should be extinguished.

20 See *In re Tam*, 808 F.3d 1321, 1378 (Fed. Cir. 2015) (Reyna, J., dissenting) (“But if the expressive *content* of the mark precludes regulation, on what authority may the government grant Mr. Tam the exclusive right to use this mark in commerce? Whatever standard of scrutiny protects the content of Mr. Tam's trademark from government regulation, that same standard must necessarily be overcome by the government's substantial interest in the orderly flow of commerce, or no trademark could issue.”). Another Asian-American musical group, or for that matter a racist group, could seek to make the same statement as Mr. Tam, or its opposite, and they would have the same political speech interests, precisely because the term is disparaging.

21 As I have explained elsewhere, anti-dilution laws should be recognized as unconstitutional regulations of non-deceptive commercial speech. See Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507 (2008); Rebecca Tushnet, *More than a Feeling: Emotion and the First Amendment*, 127 HARV. L. REV. 2392 (2014); see also Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 194–95 (concluding similarly).

the speech of others that infringes on its government-created rights. And yet those others will have equal interests in using their names to make statements about the world, or about themselves.<sup>22</sup> For example, when one entity claims a trademark right to exclude others from identifying themselves, or the communities they serve, as “Mormon,” the free speech interests of the non-rightsholders are profoundly implicated.<sup>23</sup>

Although the mere choice of a name might be characterized as purely self-regarding and self-actualizing, the attempt to register a mark and claim exclusive rights to its use cannot be so understood; it inherently limits what other people can do. Thus, while the denial of registration under section 2(a) appears to many to put the government’s thumb on the scale on a matter of public concern, the registration is *also* a thumb on the scale, as the Washington team is proving constantly by claiming that the long-standing nature of its registration is itself a justification for holding that its mark is valid. The justification for granting some private parties the rights to suppress others’ speech is that doing so helps create an orderly and efficient market. But we should recognize that this rationale inherently relies on the government’s deep involvement in creating and structuring the market. As I will detail below, this involvement also justifies the government’s desire to avoid implicating itself in disparagement and discrimination.

Whatever rule the government makes will affect the speech environment. Once we recognize that fact, saying that each rule has to survive strict scrutiny doesn’t make much sense. Unfortunately, this is a tough argument to make in our current constitutional order, which tends to assume the existence of particular baselines, such as that the government will not just protect but register many trademarks.

## II. PRIOR JUSTIFICATIONS FOR THE BAR ON REGISTERING DISPARAGING MARKS

While trademark registration has no exact analogies in current First Amendment caselaw, it may be useful to think of registration as performing a market-enhancing function, furthering Congress’s goal that commerce flow freely and cleanly. Allowing some registrations will contribute to a desirable market structure, while denying other, overreaching applications for registration will also contribute to that structure. Once we know what the government’s goals are, we should ask whether there is a rational relationship between the registration system and the kind of market the government

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22 See, e.g., *Parks v. LaFace Records*, 329 F.3d 437, 449 (6th Cir. 2003) (“[U]nmodified application of the likelihood of confusion factors in trademark cases [ ] gives no weight to First Amendment concerns. Instead, it treats the name of an artistic work as if it were no different from the name of an ordinary commercial product. . . . The names artists bestow on their art can be part and parcel of the artistic message. . . . If Parks possesses a right to police the use of her name, even when that right can be exercised only to prevent consumer confusion, she has the means to restrict the public discourse to some extent.” (citations omitted)).

23 See Vera Ranieri, *Not Mormon®, But Still Mormon*, EFF DEEPLINKS (Feb. 9, 2016), <https://www.eff.org/deeplinks/2016/02/not-mormonr-still-mormon>.



wants to create. There must be an allocation of economic power somewhere—whether that is done by creating a limited monopoly on a mark or by denying it—and the government’s choice among those options should simply be reasonable, at least with respect to the regulation of commercial speech.

What, then, should the government’s ideal of the market be? One view of the relationship between commerce and society can be described as “doux-commerce”: commercial relations improve overall human relations because market transactions encourage trust, interdependence, and attentiveness to others’ needs.<sup>24</sup> Consistent with this vision, trademark registration promotes a market economy in which people are open to interactions with institutions identified by trademarks rather than by specific personalities, and in which goods and services are available on a more or less equal basis to all who can pay for them. Within this structure, section 2(a) contributes to making the market open towards all potential participants by denying government support to discrimination.<sup>25</sup>

The disparagement bar also, as Michael Grynberg has argued, serves to exclude from registration words that are so full of meaning already that their ability to function as indications of origin—the basic duty of a trademark—is sharply limited, at least for the group targeted by a disparaging term.<sup>26</sup> The disparagement bar thus is part of a system that overall encourages producers to choose “empty vessels”—trademarks that allow consumers to search for brand information without distractions triggered by the disparaging meaning of a term. These disparagement-based distractions are equivalent to the “stereotype threat” that impairs performance on tests when members of historically low-performing groups are reminded of their membership in a relevant group. Although a disparaging term is protected as expression by the First Amendment, as a commercial identifier it is poorly suited to doing a trademark’s job.

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24 ALBERT O. HIRSCHMAN, *THE PASSIONS AND THE INTERESTS: POLITICAL ARGUMENTS FOR CAPITALISM BEFORE ITS TRIUMPH* 56–63 (1977) (providing historical background for the “douceur of commerce”); ALBERT O. HIRSCHMAN, *RIVAL INTERPRETATIONS OF MARKET SOCIETY: CIVILIZING, DESTRUCTIVE, OR FEEBLE?*, 20 J. ECON. LIT. 1463, 1465–66 (1982) (summarizing the claim that a market economy would encourage people to be “more honest, reliable, orderly, and disciplined, as well as more friendly and helpful, ever ready to find solutions to conflicts and a middle ground for opposed opinions”); CAROL ROSE, *THE COMEDY OF THE COMMONS: CUSTOM, COMMERCE, AND INHERENTLY PUBLIC PROPERTY*, 53 U. CHI. L. REV. 711, 775–76 (1986) (discussing the idea that commerce can promote sociability and decrease conflict, including by encouraging traders to sympathize with strangers).

25 One argument that opponents of the disparagement bar often make is that the market will take care of truly offensive marks. Consumers will refuse to buy, and the offensive seller will go out of business. But that argument does not deal with disparaging marks that target only subsets of the population; a market can segment so that racists, or even people who just do not care about harm to the target group, can support the trademark owner. Such segmentation, while possible, works against the government’s interest in a broad, open market.

26 Michael Grynberg, *A Trademark Defense of the Disparagement Bar*, 126 YALE L.J. FORUM 178 (2016).

With this background, I turn to the debate over the constitutionality of the disparagement bar. When the disparagement bar has been challenged on First Amendment grounds, pre-*Tam* courts and the PTO have offered three responses: first, the bar avoids the harm done by the government endorsement represented by a registration; second, the bar implements a decision to withhold government resources from disparaging or scandalous terms; and third, the bar is acceptable because of the lack of any effect on a user's ability or right to use the mark.

#### A. *Government Endorsement*

The first justification, that registration is a form of endorsement, seems to depend on public understanding of the meaning of registration. Last Term, *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*<sup>27</sup> allowed a state government to refuse to approve a Confederate Veterans logo for personalized license plates even though it approved a large number of other specialized license plates. The Court ruled that the plate design constituted governmental speech, and thus the government was not bound to neutrality in its decisions.<sup>28</sup>

If registration is the government's agreement that a term is appropriate for federal registration, equivalent to the government's agreement that a term is appropriate for placement on a license plate, then there is no problem with refusing the registration. This is the reasoning recently adopted by the district judge deciding the Washington football team's case. By contrast, the *Tam* majority in the Federal Circuit disagreed, concluding that trademark registration didn't signal a government imprimatur to the general public.<sup>29</sup> To the best of my knowledge, however, there is no systematic empirical evidence about what the public thinks of registration.<sup>30</sup>

Many of the factors cited by the Supreme Court in *Confederate Veterans* have analogues in trademark registration. There is a long history of government registration of trademarks after extensive substantive examination, like the long history of governmental approval of license plates on substantive grounds.<sup>31</sup> Moreover, the PTO maintains or cancels the registration depend-

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27 135 S. Ct. 2239 (2015).

28 *Id.* at 2246–50. Along with public understanding, the Court pointed to the government's degree of control over what went on license plates to justify its conclusion. Of course, that rationale poses serious risks of circularity unless bolstered by some other factor.

29 *In re Tam*, 808 F.3d 1321, 1345–47 (Fed. Cir. 2015).

30 Anecdotally, some lawyers don't perceive registration as endorsement, while others do, with no overwhelming pattern. See *Should Trademarks And License Plates Be Treated The Same?*, LAW360 (July 17, 2015), <http://www.law360.com/articles/679616/should-trademarks-and-license-plates-be-treated-the-same> (explaining that of the twenty lawyers who opined, eleven concluded that registration didn't reflect government endorsement, eight said it did or constituted a limited public forum, and one had no real conclusion.).

31 *Confederate Veterans*, 135 S. Ct. at 2248. Cf. *McBride v. Motor Vehicle Div. of Utah State Tax Comm'n*, 977 P.2d 467, 470 (Utah 1999) (holding that REDSKINS plate should be recalled if offensive to a reasonable person); John Heilprin, *Utah Republican Is Liberal*

ing on subsequent events, similar to Texas's continuing control over specialty plates.<sup>32</sup> Like the Texas Department of Motor Vehicles Board, the PTO must approve every proposed registration and dictates its scope, including any required disclaimers of generic or descriptive components of the mark.<sup>33</sup> Like entities seeking specialized message license plates instead of bumper stickers conveying the same message, individuals choose registrations over unregistered marks in order to get the benefits of federal recognition—although, unlike the situation with license plates, many of those benefits are administrative.<sup>34</sup> As to license plates, the Court concluded that “[t]he fact that private parties take part in the design and propagation of a message does not extinguish [its] governmental nature.”<sup>35</sup>

Because disparagement in particular is about insulting the dignity of individuals or groups, the endorsement argument also draws strength from other cases in which avoiding governmental endorsement of private discrimination trumped otherwise strong interests.<sup>36</sup> As Carol Rose explained in the context of real property rights, when the government decides that something is within the legitimate scope of a property right, such as enforcing a racially restrictive covenant, it is involved in the resulting discrimination.<sup>37</sup> Upholding a racially restrictive covenant as a property right requires a determination that it's at least reasonable to conclude that discrimination enhances property values, giving effect to a “customary norm of racial disparagement.”<sup>38</sup> The government's willingness to accept this conclusion can itself be under-

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*With Apologies as U.S. Taxpayer Advocate*, SALT LAKE TRIB., Mar. 14, 1999, at A1 (reporting that, applying this standard, the relevant commission recalled the plate); *Personal License Plates Offend*, SAN DIEGO UNION-TRIB., Mar. 10, 2000, at A1 (reporting that Washington team fan was asked to surrender RDSKINS plate because of an American Indian's complaint).

32 See *Confederate Veterans*, 135 S. Ct. at 2248 (discussing how Texas issues the plates, regulates their disposal, and owns the designs).

33 *Id.* at 2243.

34 *Id.* at 2249 (stating that individuals choose specialty plates over bumper stickers because they hope to convey the impression that “the State has endorsed th[e] message”).

35 *Id.* at 2251; see also *Pleasant Grove City v. Summum*, 555 U.S. 460, 470–71 (2009). The *Tam* majority reasoned that private trademarks aren't “created by the government, owned or monopolized by the government, sized and formatted by the government, immediately understood as performing any government function (like unique, visible vehicle identification), aligned with the government, or (putting aside any specific government-secured trademarks) used as a platform for government speech.” *In re Tam*, 808 F.3d 1321, 1346 (Fed. Cir. 2015). But those things, with the exception of sizing to fit on a license plate, aren't done by the government with respect to specialized plates either; it isn't the specialty logo that serves as “unique, visible” identification (to the contrary, the point of specialty plates is to share an identity with others).

36 See, e.g., *Shelley v. Kraemer*, 334 U.S. 1 (1948).

37 Carol M. Rose, *The Story of Shelley v. Kraemer*, in *PROPERTY STORIES* 169, 196–97 (Gerald Korngold & Andrew P. Morriss eds., 2004).

38 *Id.* at 197.

stood as discriminatory state action.<sup>39</sup> The government endorsement of the discriminatory behavior or slur then does harm over and above the private action.<sup>40</sup>

The key question is then whether registration is, at least in part, the government speaking to endorse a mark. Registration certificates clearly bear the PTO's imprimatur. But do ordinary people understand the difference between the ® symbol, the TM symbol, and nothing? The Supreme Court didn't look for empirical evidence about audience perception in the *Confederate Veterans* case when it determined that license plates were government speech.<sup>41</sup> And given that at least some of the outrage expressed over the football team's name is that it has official government recognition as a registered mark, the registration may indeed be serving as a kind of government imprimatur to some people.

There's a related body of law of relevance: the Establishment Clause cases, in which one test is whether government "endorses" religion with some action. Courts assess endorsement from an objective but not empirical perspective, assuming a person with reasonable levels of historical knowledge

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39 *Id.*; see also *Palmore v. Sidoti*, 466 U.S. 429 (1984) (invalidating custody determination based on the harm to the child that would be caused by racist reaction to the child's being in the custody of an interracial couple). *Cf. Lee v. Superior Court*, 11 Cal. Rptr. 2d 763 (Cal. Ct. App. 1992) (allowing the change of a legal name to a racial epithet might be state sanction of a racial epithet, contrary to Fourteenth Amendment prohibition on official racial discrimination); Julia Shear Kushner, Comment, *The Right to Control One's Name*, 57 UCLA L. REV. 313, 341–42 (2009) (noting states' interest in preventing other citizens from being forced to use an "inherently offensive" name).

40 There's a related argument based on secondary effects, as in the nude dancing cases. See *Tam*, 808 F.3d at 1378–79 (Reyna, J., dissenting) (first citing *City of Erie v. Pap's A.M.*, 529 U.S. 277 (2000) (upholding a ban on fully nude dancing); then citing *Barnes v. Glen Theatre*, 501 U.S. 560 (1991) (same)); see also *Tam*, 808 F.3d at 1380 ("Although the Majority distinguishes between conduct and speech, the distinction is without a difference in this context. Whether a restaurant named 'SPICES NOT WELCOME' would actually serve a Hispanic patron is hardly the point. The mere use of the demeaning mark in commerce communicates a discriminatory intent as harmful as the fruit produced by the discriminatory conduct." (citation omitted)). Proponents of cancellation argue that seeing stereotypes of Native Americans harms both Native Americans and non-Native Americans, the latter of whom unconsciously learn that Native Americans are not real people but historical artifacts, rendering attention to Native Americans' interests in the present unnecessary. See C. RICHARD KING, *REDSKINS: INSULT AND BRAND* (2016); Terence Dougherty, Note, *Group Rights to Cultural Survival: Intellectual Property Rights in Native American Cultural Symbols*, 29 COLUM. HUM. RTS. L. REV. 355 (1998). While these types of harm arguments generally fail with respect to most non-sexual speech regulations, they may have more force if the question is whether the government can refrain from supporting private discrimination.

41 See generally *Walker v. Tex. Division, Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015); see also *Williams-Yulee v. Fla. Bar*, 135 S. Ct. 1656, 1667 (2015) (upholding a regulation on judicial elections under strict scrutiny while noting that "[t]he concept of public confidence in judicial integrity does not easily reduce to precise definition, nor does it lend itself to proof by documentary record").

and understanding.<sup>42</sup> If that reasonably informed observer is also the measure of understanding here, then the argument for treating registration as government endorsement is much stronger. As I've seen in discussing the Washington football team's mark with a number of reporters, it's relatively easy to grasp the difference between registration and trademark protection, and it's even easier to understand the difference between the broad right to use a term and the much more limited ability to assert a trademark in it.<sup>43</sup> Given that fact, by analogy section 2(a) is, if anything, an easier case than *Confederate Veterans*.

The *Confederate Veterans* dissent argued that, given how many different license plates are approved, no one could reasonably perceive a government endorsement of each one.<sup>44</sup> That's even more true for trademark registrations—the government couldn't endorse both an Apple Mac and a Windows PC, or be a fan of Texas A&M and of the UT Longhorns. But that claim is an oversimplification—the government *could* express an opinion about what the boundaries of appropriate public discourse are, and it could accept both Apple and Microsoft as contenders, just as it can approve a no-pets restrictive covenant and an all-pets-allowed covenant for a residential community because both are rational. Allowing a particular plate, or a particular mark, expresses only the opinion that it's appropriate for its environment, without saying that it's correct.<sup>45</sup>

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42 See, e.g., *Capitol Square Review and Advisory Bd. v. Pinette*, 515 U.S. 753, 780 (1995) (O'Connor, J., concurring in part and concurring in the judgment) (stating that the reasonable observer considers history and context in determining meaning of government action); *Cressman v. Thompson*, 798 F.3d 938, 958 (10th Cir. 2015) ("As the contours of the Establishment Clause's reasonable-observer test have been sketched over the years, it has become clear that this reasonable observer is not the everyday casual gawker." (citing *Weinbaum v. City of Las Cruces*, 541 F.3d 1017, 1031 n.16 (10th Cir. 2008))); *Felix v. City of Bloomfield*, 36 F. Supp. 3d 1233, 1246–47 (D.N.M. 2014) ("The endorsement analysis is objective; it requires the Court to assume the mindset of a reasonable observer who is aware of the purpose, context, and history of the symbol. Like the 'reasonably prudent person' of tort law, this observer's knowledge is not limited to 'the information gleaned simply from viewing the challenged display.'" (citations omitted) (quoting *Weinbaum*, 541 F.3d at 1031)); see also *Spence v. Washington*, 418 U.S. 405, 409–10 (1974) (per curiam) (considering social and political context in determining whether an individual engaged in symbolic speech).

43 Amanda Blackhorse, the named individual petitioner for cancellation of the Washington team's mark, has said: "I know that the cancellation of the trademark does not mean that the team has to change their name. I think our biggest thing with this is that, you know, their name, the 'R' word, does not deserve federal protection," indicating that she, at least, makes that distinction. Amanda Blackhorse, *Meet the Navajo Activist Who Got the Washington Redskins' Trademark Revoked: Amanda Blackhorse*, DEMOCRACY NOW! (June 19, 2014), [http://www.democracynow.org/2014/6/19/meet\\_the\\_navajo\\_activist\\_who\\_got](http://www.democracynow.org/2014/6/19/meet_the_navajo_activist_who_got).

44 Cf. *Kushner*, *supra* note 39, at 338–39 (relying on pre-*Confederate Veterans* precedent to conclude that official name changes are not government speech because they do not condone private individuals' messages).

45 See *In re Tam*, 808 F.3d 1321, 1375–76 (Fed. Cir. 2015) (Lourie, J., dissenting) ("Similarly to specialty license plate designs, federally registered trademarks can be identified with two message contexts: one from the provider of goods or services, who has chosen

Another model that might make sense for registration, though again there is no perfect analogy, is that of the nonpublic forum. When the government makes a resource available to certain speakers, it sometimes can limit those speakers to particular content, although it must remain viewpoint neutral.<sup>46</sup> One key feature of a nonpublic forum is that participants are generally selected through “individual, non-ministerial judgments” by the government.<sup>47</sup> The substantive examination involved in trademark registration qualifies as just such a detailed, individualized inquiry.<sup>48</sup>

Whether or not registration is “government speech,” then, the government is involved enough in the trademark system to justify the disparagement bar.

### B. Government Resources

If the government endorsement argument fails, however, the next standard justification for refusing disparaging marks registration is persuasive. The bar doesn’t save government resources, because it takes a lot of judicial and administrative resources to enforce section 2(a). Also, if section 43(a) of the Lanham Act remains available to protect against confusing uses of unregistered disparaging marks,<sup>49</sup> then government resources are still being devoted to protecting such marks. Section 43(a) protection likely requires even more judicial resources, insofar as there is no more presumption of validity under section 43 as there is for a registered mark and therefore an

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to use a certain mark to link its product or services to itself, and one from the government, which has deemed the mark qualified for the federal registration program. . . . [W]hile a trademark alone, as a word placed on private property, is not government speech, once it claims that federally registered status, it becomes more than the private owner’s speech.”).

46 See, e.g., *Int’l Soc’y for Krishna Consciousness v. Lee*, 505 U.S. 672, 679 (1992) (explaining that in a nonpublic forum, where access standards are subject to the most “limited review,” a “challenged regulation need only be reasonable, as long as the regulation is not an effort to suppress the speaker’s activity due to disagreement with the speaker’s view”); cf. *Redmond v. Jockey Club*, 244 Fed. App’x 663, 668 (6th Cir. 2007) (holding that the horse naming registry didn’t violate First Amendment by refusing to register horse under the name SALLY HEMINGS, even though benefits of participating in certain races were available only upon registration, because bar on offensive names was reasonable in light of the purpose of the registry).

47 *Ark. Educ. Television Comm’n v. Forbes*, 523 U.S. 666, 680 (1998); see also *Cornelius v. NAACP Legal Def. & Educ. Fund*, 473 U.S. 788, 806 (1985) (holding that a federal charity drive was a nonpublic forum because each participant needed to be individually approved).

48 Lilit Voskanyan, Comment, *The Trademark Principal Register as a Nonpublic Forum*, 75 U. CHI. L. REV. 1295, 1317–20 (2008) (concluding that, although the registration system is inclusive, it is still individualized and not ministerial, and thus is a nonpublic forum). *But see id.* at 1327 (concluding that disparagement is impermissibly viewpoint-based).

49 An assumption made by a number of the defenses of section 2(a), though not one with which I agree. I address this question in another paper. Rebecca Tushnet, *Registering Disagreement: Registration in Modern American Trademark Law*, 130 HARV. L. REV. (forthcoming 2017).

inquiry into protectability must be made in each case.<sup>50</sup> The “resources” argument is best understood as another version of the argument against government support of a disparaging term, and should either factor into the endorsement analysis above or be rejected as insufficient on its own.

### C. *The Right to Use*

The third justification for the disparagement bar, lack of effect on the ability or right to use the mark, is the most complicated and also ultimately the strongest. This justification has two variants. First, as noted above, it’s possible that section 43(a) of the Lanham Act or state-law protection against confusing uses of unregistered marks would exist despite the fact that a mark is unregistrable because it’s disparaging.<sup>51</sup> Second, even if there’s no section 43(a) protection against confusing uses by other people, there’s still nothing stopping anyone, including the Washington football team, from using a disparaging term on a T-shirt or uniform and thus there is no cognizable harm inflicted on them. Although the government can rarely suppress speech based on its content, it also isn’t required to support or facilitate in amplifying the reach of privately produced disparaging content.

Even if non-registration protection remains available, the first variant of the “free to use” argument is unsatisfying. There are significant differences between the benefits of registered and unregistered marks, including nationwide scope, presumption of validity/incontestability after five years, the ability to use a U.S. registration to secure rights under foreign registration systems, and the ability to invoke counterfeiting laws.<sup>52</sup> If withholding those benefits is acceptable because of the government’s involvement in enforcing rights in a disparaging term, or because of the harm done by disparaging terms, then it should also be acceptable to impose the further wall between discriminatory speech and government support created by not providing any

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50 *Cf.* *LaTouraine Coffee Co. v. Lorraine Coffee Co.*, 157 F.2d 115, 125 n.26 (2d Cir. 1946) (Frank, J., dissenting) (“The underlying question in this and similar [trademark] cases is precisely whether, considering the conflicting social interests, the plaintiff should be accorded governmental aid through an order of a governmental agency, a court. Only if the government, through a court, grants that aid does the plaintiff have a ‘property right.’ For convenience, that phrase may be used as a shorthand label for the fact that plaintiff has received, or will receive, such assistance; it should not, however, be said or thought that he is so aided because he has such a ‘right.’”).

51 *Compare In re Tam*, 808 F.3d 1321, 1344 n.11 (Fed. Cir. 2015) (stating that section 43(a) protections are unavailable to unregistrable marks), *with* *Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697, 706 (4th Cir. 2016) (“[T]he plain language of [section] 43(a) does not require that a plaintiff possess or have used a trademark in U.S. commerce as an element of the cause of action.”).

52 Andrew Stockment, *Trademarks 101 Part 2: The Benefits of Federal Registration*, A.B.A.: YOUNG LAW DIV., (last visited Sept. 23, 2016) [http://www.americanbar.org/groups/young\\_lawyers/publications/the\\_101\\_201\\_practice\\_series/trademarks\\_101\\_part\\_2\\_the\\_benefits\\_of\\_federal\\_registration.html](http://www.americanbar.org/groups/young_lawyers/publications/the_101_201_practice_series/trademarks_101_part_2_the_benefits_of_federal_registration.html).

private right to suppress others' confusing uses at all.<sup>53</sup> We should treat section 2(a) the same whether or not we believe that common-law protection or section 43(a) remains available for a disparaging mark.

The continued freedom to use a term whose registration is denied, however, does bear on the appropriate First Amendment analysis. The registration bars can usefully be examined from the perspective of unconstitutional conditions doctrine, which, while far from coherent, focuses our attention on crucial aspects of the registration system arising from its regulatory nature: Is the only constitutionally permissible purpose of trademark registration to improve the information quality of truthful or non-deceptive signals that consumers receive? Even if so, can our concept of "quality" consider the harm done to significant segments of the population by having disparaging or scandalous terms commercialized?

### III. THE ROLE OF UNCONSTITUTIONAL CONDITIONS ANALYSIS

At the outset, I acknowledge that unconstitutional conditions doctrine is an enormous hairball.<sup>54</sup> The government may not coerce private speech through withholding otherwise justified benefits, for example by requiring food stamp recipients to endorse Democrats or to abstain from watching sexually explicit films. But unconstitutional conditions doctrine faces huge problems of determining what counts as coercion, or as the appropriate baseline from which to measure an entitlement.<sup>55</sup> The *Tam* majority, nonetheless, relied on the doctrine in invalidating the disparagement bar.<sup>56</sup>

I disagree that section 2 imposes unconstitutional conditions. Trademark registration is in its entirety about regulating speech: who gets to register and use which communicative symbols. The baseline against which to measure section 2 is therefore not "the government doesn't interfere with a speaker's communication": registration, and the related infringement remedy, are all about dictating who can use which symbols for source identification. Relatedly, trademarks can communicate (at least) two different things—but the only thing the government protects *as a trademark* is the communication "this symbol stands for a particular producer." Under section

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53 See generally *Sorrell v. IMS Health Inc.*, 131 S. Ct. 2653, 2664 (2011) ("[T]he 'distinction between laws burdening and laws banning speech is but a matter of degree' and [ ] the 'Government's content-based burdens must satisfy the same rigorous scrutiny as its content-based bans.'" (quoting *United States v. Playboy Entm't Grp., Inc.*, 529 U.S. 803, 812 (2000))).

54 See, e.g., LOUIS MICHAEL SEIDMAN & MARK V. TUSHNET, *REMNANTS OF BELIEF: CONTEMPORARY CONSTITUTIONAL ISSUES* 79 (1996); Mitchell N. Berman, *Coercion Without Baselines: Unconstitutional Conditions in Three Dimensions*, 90 GEO. L.J. 1, 3 (2001) ("The Supreme Court's failure to provide coherent guidance on the subject is, alas, legendary."); Cass R. Sunstein, *Why the Unconstitutional Conditions Doctrine is an Anachronism (with Particular Reference to Religion, Speech, and Abortion)*, 70 B.U. L. REV. 593 (1990).

55 See Kathleen M. Sullivan, *Unconstitutional Conditions*, 102 HARV. L. REV. 1413, 1420 (1989) ("[D]eciding under what circumstances government offers, like private offers, are coercive is an inevitably normative inquiry.").

56 *In re Tam*, 808 F.3d 1321, 1339–41 (Fed. Cir. 2015).



2(a), any speaker can continue to use any symbol it wants, but it can only get a registration for matter that does not run afoul of any exclusion—for the Washington football team, the team colors and logo.

In 1979, the Supreme Court said that trademarks have “no intrinsic meaning” and thus that there was no First Amendment problem with the government barring certain trademarks for fear they might be deceptive.<sup>57</sup> It’s unclear why meaning needs to be intrinsic to be protected, but one way to read what the Court was saying is that the source indication function of trademark is the communication that is protected in commercial speech. The relevant protected matter is the (truthful) link between producer and product, which is a particular kind of semantic meaning, and the other semantic content of the trademark is irrelevant to that. The primary drafter of the Lanham Act, Edward Rogers, put it this way:

[T]he trade mark in and by itself is of little importance[;] it is but the visible manifestation of a much more important thing, a business good will[;] the good will is the substance, the trade mark merely the shadow, and . . . this business good will is the property to be protected against invasion.<sup>58</sup>

Under this view, a hypothetical world in which Apple was named Microsoft, and vice versa, would not be meaningfully different from our own.

In First Amendment terms, as a source indicator, a mark is neither truthful nor untruthful in advance of legally enforceable meaning,<sup>59</sup> and—unlike ordinary communication, where changing the words can change the meaning, as the “F[\*\*\*] the Draft” case, *Cohen v. California*,<sup>60</sup> teaches us—a change of mark does not change what is communicated by the trademark function, which is the only thing trademark law regulates: this is who I am/this is my source. Google *is* Alphabet. And it is Alphabet, the legal entity, even if it continues to be called Google in everyday parlance.

Because the trademark function can be separated from the other communicative functions of a symbol, it may be regulated without having harmful effects on those other functions.<sup>61</sup> While the *Tam* majority saw section 2(a)

57 *Friedman v. Rogers*, 440 U.S. 1, 12 (1979).

58 Edward S. Rogers, *Comments on the Modern Law of Unfair Trade*, 3 ILL. L. REV. 551, 555 (1909) (footnote omitted); see also Beverly W. Pattishall, *Trade-Marks and the Monopoly Phobia*, 50 MICH. L. REV. 967, 971 (1952) (“The benefits of achieving [trademark protection] are twofold: first, the consumer is assured of getting the product he wants; second, the merchant is assured of the fruits of his labor, the benefits of his good will, the results of his enterprise (be it good or bad), and the ability to compete with others in terms of his own reputation, his own products, and his own private identity. A consideration of these fundamentals reveals that basically it is the intangible thing, the individual identity, which must be protected—as may be necessary—not any individual word or mark, as such, which is relied upon to achieve that identity.”).

59 Felix S. Cohen, *Transcendental Nonsense and the Functional Approach*, 35 COLUM. L. REV. 809, 815 (1935) (explaining that trademark value stems from the willingness of the government to suppress unauthorized uses on the trademark claimant’s behalf).

60 *Cohen v. California*, 403 U.S. 15 (1971).

61 The Supreme Court has made a related distinction in cases in which commercial speech is not “inextricably intertwined” with noncommercial speech, allowing the commer-

as regulating based on the expressive, not the commercial, elements of speech,<sup>62</sup> the majority had it backwards.<sup>63</sup> The content of expression is important to figuring out if a symbol is capable of being a trademark, but denying trademark rights regulates *only* the commercial aspects of the speaker's message. If the trademark owner wants to communicate other things about itself (including "we wish to insult Native Americans" or "we wish to reclaim a slur"), it can use other symbols in conjunction with its mark.

This distinction—which allows the government to regulate the mark, but not to exercise any leverage over the speaker's other speech—is consistent with the leading unconstitutional conditions cases. In *Rust v. Sullivan*,<sup>64</sup> the Court explained that unconstitutional conditions generally involve "situations in which the Government has placed a condition on the *recipient* of the subsidy rather than on a particular program or service, thus effectively prohibiting the recipient from engaging in the protected conduct outside the scope of the federally funded program."<sup>65</sup> The Supreme Court more recently repeated its distinction between conditions that specify what activities Congress wants to subsidize (legitimate) and those that seek to leverage the subsidy to affect speech outside the government program (illegitimate).<sup>66</sup>

Denying Washington's football team any trademark rights in any symbol as long as it also used the team name would be an unconstitutional penalty for the exercise of First Amendment rights. But denying it the right to any

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cial elements to be regulated under *Central Hudson*. See Bd. of Trs. of State Univ. of N.Y. v. Fox, 492 U.S. 469, 474 (1989) ("No law of man or of nature makes it impossible to sell housewares without teaching home economics, or to teach home economics without selling housewares. Nothing in the [regulation] prevents the speaker from conveying, or the audience from hearing, these noncommercial messages, and nothing in the nature of things requires them to be combined with commercial messages.").

62 *In re Tam*, 808 F.3d 1321, 1355 (Fed. Cir. 2015).

63 Actually, as Ned Snow points out, it's a mistake to categorize "commercial" communication as the opposite of "expressive"—trademarks help consumers make decisions precisely by being communicative, which is to say expressive. Snow, *supra* note 6, at 113-19.

64 500 U.S. 173 (1991); see also *id.* at 193 ("A refusal to fund protected activity, without more, cannot be equated with the imposition of a 'penalty' on that activity." (quoting *Haris v. McRae*, 448 U.S. 297, 317 n.19 (1980))).

65 *Id.* at 197; see also *Tam*, 808 F.3d at 1370 (Dyk, J., concurring in part and dissenting in part) (arguing that the federal government "is not obligated to provide these benefits of a trademark enforcement mechanism" as long as "trademark holders remain free to use their marks—however disparaging—as far as the federal government is concerned."). Any chilling effect or disincentive is a common effect of a failure to subsidize, and is not problematic as long as it isn't designed to limit speech outside the subsidized program. See Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661, 695 (1993) (arguing that *Rust v. Sullivan*, 500 U.S. 173 (1991), supports the constitutionality of section 2(a)'s scandalousness bar).

66 *Agency for Int'l Dev. v. All. for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2328 (2013); see also *Tam*, 808 F.3d at 1369 (Dyk, J., concurring in part and dissenting in part).

trademark it wants is not. To analogize to the *Confederate Veterans* case,<sup>67</sup> the speaker is free to put a Confederate flag bumper sticker on his bumper. He just can't have it on the license plate.<sup>68</sup>



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To address an analogy a skeptical Federal Circuit judge used at the *In re Tam* oral argument, rather than withdrawing police protection from a parade because the parade is using a disfavored term, the government is providing police protection, but requiring the parade organizers to fill out the permit forms with a non-disparaging legal name.<sup>70</sup>

Under section 2(a), Washington's football team can keep its name and continue to get the government's help suppressing counterfeits and the other benefits of registration by relying on its non-disparaging logo and its non-disparaging color combination. It just can't get the government's help by invoking only this particular disparaging symbol.<sup>71</sup> Likewise, "Mr. Tam is free to communicate his chosen message within or without commerce, so long as he is willing to permit others to do the same."<sup>72</sup> If the whole product

67 Walker v. Tex. Div., Sons of Confederate Veterans, 135 S. Ct. 2239 (2015).

68 See also *Agency for Int'l Dev.*, 133 S. Ct. at 2329-30 (discussing the ease of working around restriction as a reason to accept content-based nature of government program). Cf. *Lee v. Superior Court*, 11 Cal. Rptr. 2d 763, 765-66 (Cal. Ct. App. 1992) (analogizing the judiciary's ability to change a person's legal name to the DMV's discretion to reject requests for personalized license plates "that may carry connotations offensive to good taste and decency," and noting that, "if [an applicant] had requested a license plate with the word, 'nigger,' his application would be rejected" (quoting CAL. VEH. CODE § 5105 (West 2016))); Leslie Gielow Jacobs, *The Public Sensibilities Forum*, 95 Nw. U. L. Rev. 1357, 1431 (2001) (noting the continued availability of bumper stickers when vanity license plates are rejected). The bumper sticker option makes the *Tam* majority's discussion of viewpoint-based benefit denials, 808 F.3d at 1348-50, somewhat beside the point. See *Regan v. Taxation with Representation of Wash.*, 461 U.S. 540, 548-49 (1983) (upholding the subsidy of certain organizations for lobbying and noting the relatively simple work-around for unsubsidized organizations to get similar treatment); see also *Leathers v. Medlock*, 499 U.S. 439, 452 (1991) (discussing *Regan*).

69 Domoni, *Bigot Bumper*, FLICKR (June 2, 2007), <https://www.flickr.com/photos/templeofme/531062906/>.

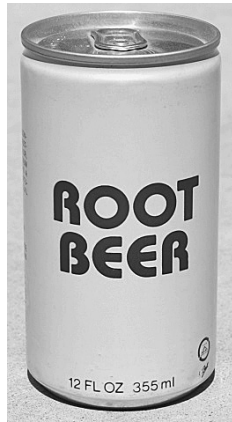
70 Oral Argument at 11:20, *Tam*, 808 F.3d 1321, [http://www.cafc.uscourts.gov/oral-argument-recordings/search/audio.html?title=In+re+Tam&field\\_case\\_number\\_value=&field\\_date\\_value%5Bvalue%5D%5Bdate%5D=](http://www.cafc.uscourts.gov/oral-argument-recordings/search/audio.html?title=In+re+Tam&field_case_number_value=&field_date_value%5Bvalue%5D%5Bdate%5D=).

71 Or, if section 43 is still available, it just can't have a registration.

72 *Tam*, 808 F.3d at 1381 (Reyna, J., dissenting).

or service offered by the producer is our unit of analysis, then the government's unwillingness to take part in the disparaging or racist aspects of the message communicated by the mark may itself be a sufficient interest to justify the exclusion, given that the government is not gaining any leverage over the message appearing outside the registered matter, any more than it has leverage over the message appearing on a bumper sticker because it has the power to approve or disapprove license plates.<sup>73</sup>

What if the speaker doesn't want to use anything *but* the scandalous/disparaging term to identify itself? In this situation alone, it would be forced to change its overall message in order to receive trademark protection.



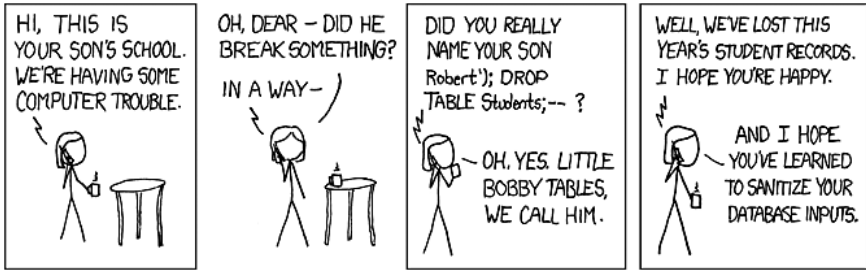
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But so would a producer who wanted to sell cans of root beer in white cans with ROOT BEER in big black letters as the only symbol—that's generic for root beer. So would a non-Barq's producer who wanted to sell cans of root beer with "BARQ's" written on them. The producer is already being forced to shape its message in many ways if it wants to take advantage of the trademark system, which is not the same as the usual unconstitutional conditions situation. The government must weigh in on the validity of a speaker's choice of marks if the mark is to be enforced against others. That is, because the entire system of trademark registration is a system of speech regulation, it is very different from the unconstitutional conditions cases finding that the government overstepped its bounds.

Relatedly, there's an extensive history of the government deciding that only some names can be formal, "government" names. Some names just don't serve the government's legitimate needs:

<sup>73</sup> Cf. Sunstein, *supra* note 54, at 607 ("In the spending context, the government may be able to invoke justifications that are tightly connected to, and become legitimate because of, the very fact that it is engaging in those activities. In the public school setting, for example, government can plausibly justify its selectivity by the need to ensure that public funds are not spent on religious activities.")

<sup>74</sup> Allen, *Albertson's Generic Root Beer, 1980*, FLICKR (July 14, 2012), <https://www.flickr.com/photos/roadsidepictures/7569568348/>.



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This isn't just a hypothetical: Jennifer Null, like others with her surname, can't use most modern computer databases because her name is a term used to separate database fields.<sup>76</sup> The Nulls' problem is created by a content-based system, and the government probably lacks a compelling interest in having any given name processing system and would indeed be better advised to use parameterized statements<sup>77</sup>—but it would be very strange to say that the government violated the Nulls' First Amendment rights by refusing to recognize their names as names.

When it comes to personal names by which human beings are known, the rule is generally that a person may adopt, and ask other private actors to use, any name she chooses. But the government need not accept that self-designation if it would risk deception, interfere with administration (as special characters or thousand-letter names could), or involve the government in appearing to endorse a discriminatory name. The First Amendment reasoning in such cases is the same as for marks that fail section 2—as long as the person is free to use her chosen name, the government's refusal to make the name change official does not violate her free speech rights.<sup>78</sup> While the

75 *Exploits of a Mom*, XKCD (last visited Sept. 13, 2016), <https://xkcd.com/327/> (Alt-text: “[h]er daughter is named Help I’m stuck in a driver’s license factory.”).

76 Chris Baraniuk, *These Unlucky People Have Names That Break Computers*, BBC (Mar. 25, 2016), <http://www.bbc.com/future/story/20160325-the-names-that-break-computer-systems> (also discussing issues with single-letter surnames, people with only a single name, and extremely long surnames).

77 See *About Bobby Tables and SQL Injection*, BOBBY TABLES: A GUIDE TO PREVENTING SQL INJECTION (last visited Sept. 13, 2016), <http://bobby-tables.com/about.html>.

78 *Lee v. Superior Court*, 11 Cal. Rptr. 2d 763, 764 (Cal. Ct. App. 1992) (rejecting a legal name change to a racial epithet and holding that “[a]ppellant has the common law right to use whatever name he chooses. He may conduct whatever social experiment he chooses. However, he has no statutory right to require the State of California to participate therein.”); see also *In re Variable for Change of Name v. Nash*, 190 P.3d 354, 356 (N.M. Ct. App. 2008) (“Petitioner has a right under the common law to assume any name that he wants so long as no fraud or misrepresentation is involved. . . . Petitioner may make a political statement by changing his name, but once he seeks the state’s imprimatur he is subject to the court’s discretion in granting the government’s approval of the name.” (first citing *In re Ferner*, 685 A.2d 78, 80 (N.J. Super. Ct. Law Div. 1996); then citing *In re Rivera*, 627 N.Y.S.2d 241, 244 (N.Y. Civ. Ct. 1995)). Cf. Kushner, *supra* note 39, at 339 (arguing that, while the government may not refuse official recognition to name changes on arbitrary grounds, it may deny official recognition to “names with offensive content, because

*Tam* majority claimed that trademark owners couldn't "realistically have two brand names, one inoffensive, non-disparaging one (which would be able to secure registration) and a second, expressive, disparaging one (which would be unregistrable and unprotectable),"<sup>79</sup> that dual system of official and unofficial names is in fact common in the real world with respect to personal names—we speak of the famous judge Learned Hand, for example, but his friends knew him as Bunny; Stefani Germanotta has not changed her legal name, but is generally known by her stage name, Lady Gaga.<sup>80</sup> This practice also finds ready analogies in brands that make unprotectable generic terms large parts of their branding, such as SUBWAY'S FOOTLONG, or in the Washington team's indisputably valid trademarks for its logo and colors.

Under various theoretical approaches to unconstitutional conditions, moreover, section 2(a) seems legitimate. For example, Kathleen Sullivan has offered a theory of unconstitutional conditions that relies on a distributive understanding of constitutional rights.<sup>81</sup> Among other things, people with fewer resources, she argues, shouldn't be forced to give up constitutional rights to access things—like money to pay for food—that people with more resources have without surrendering their constitutional rights.<sup>82</sup> This theory would seem to approve section 2's exclusions, which are distributionally neutral. Dan Snyder can continue to use the mark if he wants to, even without the government's aid.<sup>83</sup>

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such content-based restrictions will be found to be reasonably related to the purpose of the [limited public] forum" of official names).

79 808 F.3d 1321, 1351 (Fed. Cir. 2015).

80 See GERALD GUNTHER, *LEARNED HAND: THE MAN AND THE JUDGE* 2 (2d ed. 2011); Kate Beaudoin, *The Story of How Lady Gaga Became Famous Will Make You Like Her Even More*, MUSIC.MIC (Mar. 10, 2015), <https://mic.com/articles/112334/the-story-of-how-lady-gaga-became-famous-will-make-you-like-her-even-more#.FLyJ4sp25>. Cf. Patrick McKenzie, *Falsehoods Programmers Believe About Names*, KALZUMEUS (June 17, 2010), <http://www.kalzumeus.com/2010/06/17/falsehoods-programmers-believe-about-names/> (discussing numerous situations in which naming conventions and behavior differ from formal recording systems).

81 Sullivan, *supra* note 55, at 1421 ("Unconstitutional conditions implicate three distributive concerns. The first is the boundary between the public and the private realms, which government can shift through the allocation of benefits as readily as through the use or threat of force. Whatever the reason to preserve a realm of private autonomy from government encroachment, unconstitutional conditions present the same structural threat to that realm: they permit circumvention of existing constitutional restraints on direct regulation. The second distributive concern of unconstitutional conditions doctrine is the maintenance of government neutrality or evenhandedness among rightholders. The third is the prevention of constitutional caste: discrimination among rightholders who would otherwise make the same constitutional choice, on the basis of their relative dependency on a government benefit.").

82 *Id.* at 1497–99.

83 The rule is distributionally neutral in other ways: all speakers can choose protectable marks, so there's no necessary redistribution among speakers as a result of the exclusions; poor speakers aren't particularly dependent on government for trademark protection (if anything they are less likely to invoke it). Cf. Sullivan, *supra* note 55, at 1490 ("[A]n unconstitutional condition can skew the distribution of constitutional rights among

Simon Tam has a case for further harm, claiming that he's lost record deals because record companies want to be able to secure a registration for any name a band uses. However, the private choices of third parties probably shouldn't weigh into the First Amendment calculus here—an employer that won't make matching donations to an employee's chosen charity unless it has 501(c)(3) nonprofit status doesn't thereby increase the First Amendment constraints on the government in approving charities. This is especially true where, as here, the claimed problem would arise whatever the reason for the refusal to register was—the record contract would also be denied if Mr. Tam wanted to perform as THE DOORS (confusing) or ROCK BAND (generic), because those names aren't registrable either.

Mitchell Berman and Seth Kreimer, among others, have argued that one useful way of analyzing the unconstitutional conditions question is to ask whether, if the government knew its condition wouldn't work at deterring or punishing speech, would it prefer to extend the benefit to the targeted person or to withhold it anyway?<sup>84</sup> As Berman points out:

[T]he Pentagon's decision to buy time for armed forces recruitment commercials only during televised sporting events also burdens the exercise of First Amendment rights of a broadcaster that chooses to replace its weekly college basketball telecasts with reruns of *Murder, She Wrote*. It therefore becomes critical to determine whether the burden is a penalty.<sup>85</sup>

The government wants to reach people who watch basketball; even if it knew that it would have no effect on the amount of basketball broadcast, it would still want to restrict its funding in this way. On this reasoning, section 2(a)'s exclusions are not unconstitutional conditions, given that the consistent position of the government is that it is legitimate to keep using the challenged symbol even if it's not registered. The government's formal position towards a disparaging mark is the same as its position towards functional matter: use it if you want, but don't use it as an indicator of source.

A number of cases and commentators have also suggested germaneness to the program's aims as a standard for determining whether a condition is unconstitutional: you can be denied Temporary Assistance for Needy Families because you are making too much money, but not because you protested

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rightholders because it necessarily discriminates facially between those who do and those who do not comply with the condition. . . . [T]o the extent that a condition discriminates de facto between those who do and do not depend on a government benefit, it can create an undesirable caste hierarchy in the enjoyment of constitutional rights.”).

84 See, e.g., Berman, *supra* note 54, at 37 (“If (counterfactually) the government knew that granting or withholding an offered benefit would have no effect on the exercise of a particular right, and would nonetheless withhold the benefit, then it lacks a (but-for) purpose to discourage exercise of the right. If it would grant the benefit under the hypothetical assumption, then its purpose in withholding the benefit when the assumption is abandoned is indeed to deter exercise of the right, which is to say that the withholding of the benefit is a penalty, which makes the conditional threat coercive.”); see also Seth F. Kreimer, *Allocational Sanctions: The Problem of Negative Rights in a Positive State*, 132 U. PA. L. REV. 1293 (1984).

85 Berman, *supra* note 54, at 80.

the government.<sup>86</sup> Because registration is inherently about the content of the registrant's mark, though, germaneness here reduces to the prior question of whether it's legitimate for the government to have this preference for non-disparaging marks. As long as the government is heavily involved in defining and enforcing trademark rights, the government's hands-off position on disparagement should be constitutional.

#### IV. THE CORROSIVE EFFECT OF TREATING SECTION 2(A) AS SUSPECT CONTENT-BASED REGULATION

Suppose one finds all these arguments unpersuasive. What then? Disparagement and scandalousness aren't the only grounds on which registration can be denied. This Part explains how difficult it would be to cabin most forms of First Amendment scrutiny just to those aspects of registration attacked in *Tam*. I will first situate trademark within commercial speech doctrine, which gives special weight to regulating false and misleading speech, and then demonstrate that, if subjected to strict or even intermediate scrutiny, other parts of the registration system would also perform as poorly as disparagement.

##### A. *The Relevance of Commercial Speech*

If we define "content-based" as literally as *Reed*<sup>87</sup> does, all of the exclusions in section 2, with the exception of utilitarian functionality, are content-based—they require an evaluation of the meaning of the symbol at issue. *Reed* is not, however, the only consideration, because *Reed* did not consider the continuing vitality of commercial speech doctrine.<sup>88</sup> The adoption of a symbol as an indication of the source of goods or services—that is, the adoption of a trademark—is generally commercial speech.<sup>89</sup> While nonprofits

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86 The *Tam* majority mischaracterizes unconstitutional conditions doctrine as being about what the government can do to get its own message out. *In re Tam*, 808 F.3d 1321, 1352 (Fed. Cir. 2015). But the unconstitutional conditions doctrine applies to a far broader range of programs than those in which the government is trying to send its own message; it applies when the government is trying to achieve a legitimate *aim*.

87 *Reed v. Town of Gilbert*, 135 S. Ct. 2218 (2015).

88 So far, lower courts have generally held that "*Reed* does not concern commercial speech, and therefore does not disturb the framework which holds that commercial speech [regulation] is subject only to intermediate scrutiny as defined by the *Central Hudson* test." *Contest Promotions, LLC v. City & Cty. of S.F.*, No. 15-cv-00093, 2015 WL 4571564, at \*4 (N.D. Cal. July 28, 2015); *see also Dana's R.R. Supply v. Attorney Gen.*, 807 F.3d 1235, 1248 (11th Cir. 2015); *Chiropractors United for Research & Educ., LLC v. Conway*, No. 3:15-CV-00556, 2015 WL 5822721, at \*5 (W.D. Ky. Oct. 1, 2015); *CTIA—The Wireless Ass'n v. City of Berkeley*, 139 F. Supp. 3d 1048, 1061 (N.D. Cal. 2015); *Cal. Outdoor Equity Partners v. City of Corona*, No. CV 15-03172, 2015 WL 4163346, at \*9–10 (C.D. Cal. July 9, 2015).

89 *Denicola*, *supra* note 21, at 193 ("The adoption of a symbol as a trademark is a form of commercial speech. The trademark ordinarily communicates information concerning source or quality. . . . The purpose remains to attract prospective consumers, and the use thus serves as 'part of a proposal of a commercial transaction.'" (footnote omitted) (quoting *Friedman v. Rogers*, 440 U.S. 1, 11 (1979))); *see also Friedman*, 440 U.S. at 11 & n.10



and noncommercial speakers in the First Amendment sense such as the *New York Times* can own trademarks, the function of the trademark is still to identify them as sources of goods or services in commerce.<sup>90</sup> Likewise, although team jerseys may be used by their purchasers to communicate love of Washington's football team, the team, as seller, uses the name to identify itself to those in the market for team merchandise.<sup>91</sup> (Even those who deny that trademarks are commercial speech revert to that doctrine under pressure. While the *Tam* majority claimed that commercial speech rules didn't apply, it relied only on commercial speech doctrine when it stated that section 2's prohibitions on deceptive and confusing marks posed no constitutional problem, a claim that would be untrue if trademarks were noncommercial speech.<sup>92</sup>)

Under the *Central Hudson* rule governing commercial speech, false or misleading commercial speech may be banned.<sup>93</sup> In addition, the 1979 case of *Friedman v. Rogers* allowed Texas to require optometrists to use their per-

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("[T]he mere solicitation of patronage implicit in a trade name" is "a form of commercial speech."); *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 457 n.6 (E.D. Va. 2015) ("Because trademarks are source-identifiers that 'reduce[ ] the customer's cost[ ] of shopping and making purchasing decisions,' . . . they necessarily pertain to commercial transactions and are thus commercial speech . . ." (quoting *Dastar Corp. v. Twentieth Century Film Corp.*, 539 U.S. 23, 34 (2003))); *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 U.S.P.Q.2d 1497, at \*1508 (T.T.A.B. 2015) (trademark is inherently commercial speech, making the registration decision a commercial speech decision).

90 See *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 88 (2d Cir. 1997) (allowing use of Lanham Act to enjoin name of political party that was leading donors to send money to the wrong entity).

91 See *In re Tam*, 808 F.3d 1321, 1377 (Reyna, J., dissenting) ("All three factors [the Supreme Court used to identify commercial speech] are necessarily also present in trademarks. Trademarks are used to identify specific products and to advertise the sources of those products. Trademarks, and in particular those federally registered for exclusive use in interstate commerce, are necessarily tools of commerce used with an 'economic motive.'").

92 *Id.* at 1329 (majority opinion) (citing only commercial speech cases in stating that bars on registration of marks that are likely to "cause confusion, or to cause mistake, or to deceive," Lanham Act section 2(d), or that are "deceptively misdescriptive," section 2(e), "do not run afoul of the First Amendment"). If, as other portions of the decision claim, trademarks aren't commercial speech (or registration isn't commercial speech), *id.* at 1337–38, 1355, then those decisions aren't relevant and the harm rule of *Alvarez* would seem to apply. Furthermore, if deception from commercial speech is merely potential, not inherent or actual—surely the case for all deceptively misdescriptive marks and many confusing marks—the government must require a disclaimer, and isn't allowed to impose an outright ban. See, e.g., *Pearson v. Shalala*, 164 F.3d 650, 655–59 (D.C. Cir. 1999). But the PTO never instructs applicants that they must include disclaimers of affiliation, or of the deceptively misdescriptive meaning at issue, in their marks in order to receive a registration. True, a disclaimer requirement would fit poorly with the idea of trademark as shorthand for commercial information, but that very consideration suggests that the *Tam* court is mistaken to so blithely equate the remaining section 2 bars with completely unprotected false or misleading commercial speech.

93 *Cent. Hudson Gas & Elec. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557 (1980).

sonal names, rather than chain names or other trademarks, because the Court held that trademarks didn't have inherent informational content and thus a ban on certain trademarks didn't interfere with information transmission:

[T]he restriction on the use of trade names has only the most incidental effect on the content of the commercial speech of Texas optometrists. As noted above, a trade name conveys information only because of the associations that grow up over time between the name and a certain level of price and quality of service. . . . Since the Act does not prohibit or limit . . . informational advertising [such as advertising about prices,] the factual information associated with trade names may be communicated freely and explicitly to the public.<sup>94</sup>

Because trademarks don't have inherent meaning, in other words, government regulation of which trademarks certain professionals could use did not assume paternalistically that consumers would misuse truthful information, which is the usual problem the Supreme Court has with direct bans on truthful, nonmisleading commercial speech.<sup>95</sup> Optometrists could communicate "the factual information"<sup>96</sup> at issue—their association with a larger chain—freely; they just couldn't use a symbol for that factual information as their trademark.

Judge Dyk's partial dissent in *Tam* likewise appealed to the dual function of symbols as source-indicators and as conveyors of information (or perhaps persuasion). He contended that there was no legitimate informational value in disparaging marks, and thus nothing meriting their First Amendment protection *as source indicators*:

It is certainly difficult to imagine, for example, how the disparaging elements of an advertisement such as "CHLORINOL SODA BLEACHING—we are going to use Chlorinol and be like de white nigger," or "The Plucky Little Jap Shredded Wheat Biscuit," or "Dr. Scott's Electric Hair Brush—will not save an Indian's scalp from his enemies but it will preserve yours from dandruff," further any legitimate "informational function" associated with the relevant product.<sup>97</sup>

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94 440 U.S. 1, 15–16 (1979).

95 The facts of *Friedman* make clear that distinguishing between (apparently illegitimate) paternalism and (legitimate) consumer protection may be no easy task. Texas banned the use of certain trade names so that optometry chains couldn't get the advantages of extensive recognition through using a brand name across locations and time, on the theory that consumers needed to know the name of the particular optometrists who'd examine them and that they could be fooled into thinking that quality was the same as they'd had in the past. See *id.* at 12–13. Why this wasn't just fear of consumers using truthful information—"this location is part of a chain"—badly is not fully explained by the Court. See *id.* at 21 (Blackmun, J., concurring in part and dissenting in part).

96 *Id.* at 16 (majority opinion).

97 808 F.3d at 1373 (Dyk, J., concurring in part and dissenting in part) (footnotes omitted) (first quoting Julian Casablancas, *15 Shockingly Racist Vintage Ads*, BUSINESS PUNDIT (Dec. 17, 2012), <http://www.businesspundit.com/15-shockingly-racist-vintage-ads/>; then quoting *Recreation's Advertiser*, RECREATION, Jan. 1906, at 493; then quoting BRIAN D. BEHN-

Thus, no principle required that disparaging terms be recognized as trademarks, even if they could not and should not be banned.

A court relying on *Friedman* could perhaps stop there and uphold section 2(a). Given the changes in First Amendment doctrine since *Friedman* was decided, however, and given *Friedman*'s own failure to draw a clear line between the non-informative and the misleading, it is worth considering what would happen to trademark registration, and trademark law as a whole, if full First Amendment scrutiny were brought to bear on it. With this exercise, I hope to show that such a move would be misguided; the mistake is treating registration as if it were a speech ban rather than as a government program.

### B. *What Real Scrutiny of Registration Would Look Like*

In other contexts, regulations of truthful, nonmisleading commercial speech must actually serve a substantial government interest and be no more restrictive than necessary to serve that interest. Since false and misleading commercial speech can just be banned, the government can probably take the lesser action of refusing to support it. Thus, any bars sufficiently related to deception might pass muster, but the other bars would have to survive *Central Hudson* or strict scrutiny.<sup>98</sup>

#### 1. Deception-Adjacent Bars

Which section 2 bars are sufficiently related to consumer deception and therefore arguably acceptable under heightened scrutiny, even if consumer

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KEN & GREGORY D. SMITHERS, *RACISM IN AMERICAN POPULAR MEDIA: FROM AUNT JEMIMA TO THE FRITO BANDITO* 39 (2015)).

98 Cf. Denicola, *supra* note 21, at 194–95 (expressing doubt that misappropriation and dilution rationales for allowing trademark owners to suppress others' uses could survive *Central Hudson* scrutiny, absent consumer confusion). One possible alternative standard could be taken from analogy to mandatory disclosure cases. The *Zauderer* line of cases deals with the government mandating additional speech, rather than outright barring particular commercial speech. See *Zauderer v. Office of Disciplinary Counsel*, 471 U.S. 626 (1985). *Zauderer* involved attorney advertising that told laypeople that if the lawyer lost their case, there'd be no fee. *Id.* at 629. The Supreme Court held that the state could require an additional disclosure clarifying that fees and costs were different things and that, if they lost, they'd still be liable for costs. *Id.* at 652. The Court did not require the mandatory disclosure to satisfy *Central Hudson*, but applied something like rational basis review—as long as the required disclosure was truthful and noncontroversial, and not unduly burdensome, it was constitutional. *Id.* at 651.

A refusal to provide trademark protection is much more like requiring disclosures than like a speech ban: it may create an economic burden and thus a possible disincentive for the speech, but it doesn't suppress that speech directly. The analogy to disclosure is in the indirect burden on non-false commercial speech, not on the exact mechanism by which the burden occurs. But is it "unduly" burdensome to deny trademark registration or, in its entirety, trademark protection? This question can't be answered except normatively—denial of registration isn't like a disclosure that takes three minutes to recite when most ads are only thirty seconds long. Undue burden is probably best assessed under the general category of unconstitutional conditions, discussed in the previous Part.

protection might not have been their initial impetus? The ban on registering deceptive marks seems obvious. Marks that create a false association with persons, institutions, or religions also have some kind of deceptiveness built in, as do geographically deceptively misdescriptive marks.<sup>99</sup> However, issues of tailoring and evidence would remain. If barring use of deceptive marks is possible, then all the subject matter-specific, deception-adjacent bans such as those banning use of a person's name without consent seem to fail the least restrictive means test. The less restrictive means already present in the statute is to make an individualized determination rather than to deter all uses of marks within a class, even if that class runs a higher than average risk of being deceptive.

Likewise, the ability of the PTO to use inference and common sense, without considering the actual marketplace context of a mark's use that might avoid deception in practice, might make deceptiveness refusals overinclusive. As it stands, the PTO can refuse registration even when the applicant shows that matter outside the applied-for mark makes actual deception unlikely,<sup>100</sup> or when a term has a non-deceptive meaning that can be clarified by the rest of a product's packaging.<sup>101</sup> If, as courts are beginning to suggest, prophylactic anti-confusion rules aren't narrowly tailored enough to survive strict scrutiny,<sup>102</sup> and regulators have to try allowing both the potentially confusing speech and the disclaimer first, then trademark law's unwillingness to consider disclaimers outside the applied-for matter seems constitutionally suspect.

Separately, refusing registration doesn't stop the use of the mark to deceive people, meaning that the harm inflicted on the applicant doesn't necessarily further the government's interest. Indeed, if the government's refusal is correct, then by hypothesis the applicant's use of a deceptive term is material to consumers, thus helping to sell the product. Even absent a registration, the applicant would have every incentive to continue using the deceptive term, even if it adopted an additional trademark. An outright ban

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99 This fact is all the more relevant after the Federal Circuit rewrote the test in *In re Cal. Innovations, Inc.*, 329 F.3d 1334, 1337 (Fed. Cir. 2003), to require that geographic misdescriptiveness be materially deceptive to consumers. The United States adopted an additional exclusion for geographic terms for wine and spirits as part of our obligations under TRIPS. 15 U.S.C. § 1052(a) (2012). The only thing that must be shown to trigger this alcohol-specific bar is that the term does indicate a place other than the origin of the goods, so it need not be believed (*ALASKA CHARDONNAY*) nor material to consumer decisions, but this might still be justified on a prophylactic deception-avoidance rationale.

100 See, e.g., *In re Volk Art, Inc.*, 1998 WL 377661, at \*4 (T.T.A.B. 1998) (rejecting applicant's argument that actual sales context would avoid confusion caused by term that could be misleading in the abstract).

101 See, e.g., *In re Wadhwa*, 2016 WL 1045678, at \*2-6 (T.T.A.B. 2016) (finding that "EM" was a term for supplements containing "effective microorganisms," not contained in applicant's goods, though they did contain "essential minerals" or "electrolyte minerals").

102 See *Pursuing America's Greatness v. Fed. Election Comm'n*, No. 15-5264 (D.C. Cir. Aug. 2, 2016).

on the use of the deceptive term would be appropriately tailored to the government's interest, but refusing registration wouldn't be.

The bar on registering marks confusingly similar to marks already registered or in use also seems, at first look, highly connected to deception.<sup>103</sup> However, the standard used to refuse registration doesn't take real likelihood of confusion into account, because it deliberately abstracts away from marketplace context, including additional distinguishing features that in practice always appear next to a supposedly confusing mark. For example, if Tam's THE SLANTS is ultimately registered, an application to register THE SLANTS would be refused for a second band even if in reality the second band always accompanied the term with a clear distinguishing feature, such as "the really racist ones." Thus, the PTO doesn't measure real likelihood of confusion, and the reason isn't that confusion in the abstract is so likely to overlap with confusion in reality that a more fact-intensive test is unwarranted. Instead, the reason is to make the registration system work by providing a searchable, understandable list of what terms are off-limits to other businesses. Having two separate THE SLANTS registrations for identical services would be inconsistent with that systemic objective—but administrative convenience is generally not a sufficient justification for limiting First Amendment rights.

Separately, the test for the bar on registering nongeographic deceptively misdescriptive marks requires that the misdescription, while likely to be believed by consumers, be immaterial to them—otherwise, the mark would be outright deceptive and unregistrable. Deceptively misdescriptive marks, because they deceive only about immaterial matters, are registrable if they attain secondary meaning, which means that consumers recognize them as indicators of source. But under *United States v. Alvarez*,<sup>104</sup> which invalidated a criminal penalty imposed on lying as such without an additional element of harm, this immateriality would seem to doom the bar, given the lack of harm to consumers.

The bar on registering a name, picture, or signature of a living person (or president whose widow or widower still lives) without the person's written consent also seems plausible as a legislative prediction at the wholesale level about the risk of false endorsement. If such predictions are allowed, it might well survive—although the discrimination in favor of a dead president with a living widow/er seems problematic, since it's hard to see why creating a connection with a dead president is worse than creating a connection with any other well-known person who died and left a widow(er).<sup>105</sup>

Even the bar on registering flags and other indicia of states, nations, and other political units arguably has some relationship to preventing deception,

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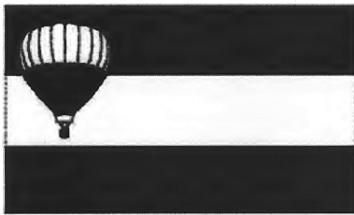
103 See *In re Tam*, 808 F.3d 1321, 1329 (Fed. Cir. 2015) (stating that such bars were constitutionally unproblematic).

104 132 S. Ct. 2537, 2545, 2551 (2012) (plurality opinion).

105 Cf. *R.A.V. v. City of St. Paul*, 505 U.S. 377, 388 (1992) (concluding that it is worse to assassinate a president than to kill an ordinary citizen, and thus penalties for the former can be enhanced without violating the First Amendment).

in that this is a subclass of signifiers whose potential for abuse is so great that Congress could legitimately make a blanket rule without requiring case by case evaluation.<sup>106</sup> Nonetheless, like the bar on deceptive marks, there's a risk that this bar is not fit for the purpose of preventing deception, since it doesn't block actual use. Moreover, it's notable that no deception need be shown to trigger the insignia bar: consumers need not even recognize the flag as a flag of a nation. For example, a district court recently cancelled one of RE/MAX's registered marks—the one on the top right of the image below—because it was identical to the flag of the Netherlands, even though RE/MAX produced a survey indicating that almost all Americans have no idea what the flag of the Netherlands looks like.<sup>107</sup> Such an absolute bar, involving no deception, would seem dubious under strict scrutiny, or even under *Central Hudson*.

**The '854 Trademark**



**The '048 Trademark**



**The '592 Trademark**



106 See *Renna v. Cty. of Union*, 88 F. Supp. 3d 310 (D.N.J. 2014). But why exclude even the actual political entity from registering its own flag or insignia? That seems overbroad if the concern is only deceptiveness in the ordinary sense; the Swiss government wouldn't deceive consumers by marking its products with the Swiss flag. See Paris Convention for the Protection of Industrial Property, art. 6ter(1)(a), Mar. 20, 1883, 13 U.S.T. 2, 828 U.N.T.S. 305, as last revised at Stockholm on July 14, 1967, 21 U.S.T. 1538, 828 U.N.T.S. 303, and amended on Sept. 28, 1979 [hereinafter Paris Convention] (prohibiting registration and "use . . . as trademarks" without authorization of competent authorities of "armorial bearings, flags, and other State emblems" and other official signs of Paris Union countries). The *Renna* court offered one justification: trademark rights are poorly suited to the appropriate scope of a government's right to prevent unauthorized use of its insignia, and could too easily be used to suppress critical speech about a government entity. *Renna*, 88 F. Supp. 3d at 323. Instead, anti-impersonation rules not tied to commercial uses should do the necessary work.

107 RE/MAX LLC v. M.L. Jones & Assocs., Ltd., No. 5:12-CV-768, 2014 WL 7405461, at \*3 n.2 (E.D.N.C. Dec. 30, 2014).

Additionally, RE/MAX had a standalone registration for the three bars, but in the real world, the bars always appear with the balloon design and RE/MAX's name superimposed on them, further preventing consumers from making any actual connection with the Netherlands.<sup>108</sup> Here again, the distinctive character of registration makes it hard to link up with confusion-based rationales.

## 2. Information-Related Bars

What about section 2 bars related to factual information transmitted to consumers, but not so much to deception? For example, merely descriptive (or deceptively misdescriptive, or geographically misdescriptive) marks are not deceptive when a trademark claimant uses them. Instead, there are policy reasons why we want other producers to be free to use them as well. Claimants could cause harm to the marketplace by gaining monopoly rights over them. Is that enough of a justification to sustain these bars, given that they are content-discriminatory by our excitingly broad definition of content discrimination?

We could assert that the bar on registering descriptive terms survives strict scrutiny, but I don't see how that can be true without doing serious damage to the concept of strict scrutiny. For example, we already have a less restrictive alternative than barring registration in the very same statute: we could allow registration of descriptive marks, and give everyone else a descriptive fair use defense, just as we do now when a descriptive term has secondary meaning and *is* registrable.<sup>109</sup> This defense allows other producers to use a term in its descriptive sense, but not as a trademark, fairly and in good faith—so there can be a valid trademark in “LOOKS LIKE A PUMP, FEELS LIKE A SNEAKER” for shoes, while a competitor can say of its own high-heeled pump “Think Of It As A Sneaker With No Strings Attached.”<sup>110</sup> Of course, having the descriptive fair use defense is not as good for competitors as full freedom to use a descriptive term lacking secondary meaning. But is that marginal difference enough to survive full First Amendment scrutiny? To say yes, we should be willing to say that all the government needs to refuse registration is a pretty good reason—bringing us back to the normative question of acceptable reasons.

The real reason the government denies trademark protection to merely descriptive uses is not to punish the claimant for its speech, but because there's not a sufficient justification to grant a private right in such terms, especially given the needs of others to use them. One core purpose of trademark is to allow consumers to rely on nonfunctional symbols as indicators of source, so they can use those symbols to select the products and services they want. By definition, a descriptive term without secondary meaning doesn't work that way for consumers (just as the disparaging meaning of a disparag-

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108 *Id.* at \*3.

109 Lanham Act § 33(b)(4), 15 U.S.C. § 1115(b)(4) (2012).

110 *U.S. Shoe Corp. v. Brown Grp., Inc.*, 740 F. Supp. 196, 197 (S.D.N.Y. 1990).

ing term may be so insulting that it detracts from any identification function, at least for the targeted group), so a producer who uses such a term can be excluded from the government program. *Central Hudson's* framework can probably accommodate this rationale, but not strict scrutiny.

One final non-deceptive, but information-related, consideration comes from our treaty obligations. For example, the provisions for wines and spirits, and for geographically deceptively misdescriptive marks, are required by our adherence to the Paris Convention<sup>111</sup> and to NAFTA, and we could take note of an apparent international consensus that misstatements about certain matters are wrongful even if they are not material.

The fact that the acid logic of current First Amendment protection makes the bar on registering merely descriptive or misdescriptive terms seem even arguably questionable shows that something has gone seriously wrong with the Supreme Court's condemnation of content-based regulation, which has now become detached from the underlying justifications that one might reasonably give for worrying about content-based regulation. This is compounded by the difficulty of using a test about suppressing speech to evaluate whether the government can refuse to give a registration, or even a private right of action, to a commercial speaker.

### 3. Utilitarian Functionality

Utilitarian functionality is a doctrine precluding protection under trademark law, either for registration or in infringement cases, where the feature at issue makes the product or service better or cheaper. Functionality is a pure situation in which communicative conduct is regulated because of its noncommunicative elements.<sup>112</sup> The governing standard for evaluating regulations that suppress communicative elements of conduct comes from *United States v. O'Brien*.<sup>113</sup> By definition, a symbol that is functioning as a mark, but also possesses utilitarian functionality, is not barred from registration or protection because of anything about its ability to communicate the source of a product. Instead, functional matter is barred from protection because of the other things it does, just as the government supposedly punished O'Brien for burning his draft card not because of his anti-war message

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111 Paris Convention, *supra* note 106, at art. 6ter(1)(a) (requiring a bar on registration and use of "armorial bearings, flags, and other State emblems" and other official signs of Paris Union countries without permission from the relevant entity).

112 "Aesthetic functionality," in which the sensory characteristics of a product are practically or socially of such importance to the product that free access to those characteristics is necessary for fair competition, arguably requires an assessment of a symbol's communicative impact. One example of aesthetic functionality might be a heart-shaped box for holding candy for Valentine's Day. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17, illus. 8 (AM. LAW. INST. 1995). Aesthetic functionality might be another content-based limitation on trademark rights; nonetheless, it is perfectly justifiable and might even survive strict scrutiny.

113 391 U.S. 367 (1968).



but because it needed that draft card for other purposes.<sup>114</sup> Indeed, unlike *O'Brien* itself, where (despite the Court's implausible denial of bad motive) disagreement with O'Brien's anti-war speech clearly affected the government's decisions, there's no reason to disbelieve the government's content-indifferent rationale for the functionality exclusion.

Nonetheless, the government rule has effects on speech—it discourages the communicative use of functional features, because you can't get protection for them. Under *O'Brien*, a law that burdens expressive conduct is unconstitutional, even absent any bad state purposes, unless “it furthers an important or substantial governmental interest; . . . and if the incidental restriction on alleged First Amendment freedoms is no greater than is essential to the furtherance of that interest.”<sup>115</sup>

In some sense the exclusion for functional matter is motivated by the government's desire to shape the universe of communicative devices so that it doesn't overlap with the universe of functional features. There's just nothing wrong with that desire even if it's characterized as speech-related. This is why Justice Breyer and the Justices in agreement with him are right that the term “content-based” as recently used in *Reed* is unsustainably overbroad. For functionality, the government interest is substantial and the restriction is exactly coterminous with the government interest. So at least functionality would survive *Central Hudson* and *O'Brien* scrutiny both as a bar to registration and as a total bar to protection.

### C. *The Lanham Act Is Broadly Vulnerable Under Enhanced Scrutiny*

Overall, it seems unlikely that any but functionality and the specifically deception-related provisions of section 2 could survive strict scrutiny, and even a number of them are shaky because only one—deceptiveness—requires the PTO to show that the deception would affect consumer decisions (materiality).<sup>116</sup> Even likely confusion with an existing trademark doesn't require any showing that consumers would change their behavior because of the confusion or that the senior trademark owner would suffer any other harm. That rule would seem to make section 2 much like the Stolen Valor Act, which was struck down for lack of a sufficient connection between deception and harm.<sup>117</sup>

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114 *Id.* at 382.

115 *Id.* at 377.

116 Even deceptiveness doesn't involve an assessment of materiality in actual purchasing decisions, only in the abstract based on the goods and services listed in the application, so the applicant can't show that sales channels or other context will avoid deception.

117 It's true that the *Alvarez* concurrence and dissent used trademark as an example of a non-problematic regime, but I place little weight on that, not only because Justice Breyer's concurrence got the details of trademark law quite wrong, but also because the Court wasn't asked to perform any analysis of trademark law in itself. See Rebecca Tushnet, *Stolen Valor and Stolen Luxury*, in *THE LUXURY ECONOMY AND INTELLECTUAL PROPERTY: CRITICAL REFLECTIONS* 123 (Barton Beebe et al. eds., 2015).

And it would be difficult to stop with these registration issues. Priority rules allowing various claimants to trump others' uses even before beginning their own uses, on the basis of foreign rights or "intent to use" filings with the PTO, don't rely on the prevention of confusion as their justification; even if we treated the common law of trademark as a neutral baseline, such provisions derogate from the common law. Incontestability, a statutory provision under which a registered mark that is unchallenged for five years can become immune to challenge on the ground that it doesn't in fact serve as a source signifier, looks a lot like a way to suppress others' truthful, non-deceptive speech,<sup>118</sup> and the administrative convenience/quiet-title rationale for incontestability seems fairly weak in a First Amendment framework.<sup>119</sup> Rules allowing trademark owners to change the quality or composition of their goods without changing the associated trademark also seem to promote deception, rather than to protect consumers.

Furthermore, if strict First Amendment scrutiny is the order of the day, the causes of action for infringement of a registered mark, in section 32, and infringement of an unregistered mark, in section 43(a), would also have to be evaluated with a skeptical eye; they are equally content-based.<sup>120</sup> One court has already struck down an election-related rule barring political action committees from using the name of a candidate without that candidate's permission. Even assuming that the prevention of confusion is a compelling interest, the court ruled, the existence of the untried, less restrictive alternative of allowing continued use plus a disclaimer of any affiliation meant that the ban was not narrowly tailored.<sup>121</sup> Not much separates that decision from trademark law.

## 1. The Special Problem of Vagueness

The risks of First Amendment scrutiny should be particularly apparent with respect to the argument that disparagement is unconstitutionally vague. The *Tam* majority offered numerous examples of hard-to-distinguish results

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118 Cf. *P.R. Coffee Roasters LLC v. Pan Am. Grain Mfg. Co.*, No. 3:15-CV-02099, 2015 WL 8551102, at \*10 (D.P.R. Dec. 11, 2015) (commenting that protection for merely descriptive marks without secondary meaning would unconstitutionally suppress free speech).

119 There's a strong connection here with one original rationale for denying much constitutional protection to commercial speech, which is the risk of diluting speech protection generally. The temptation could be to consider administrative convenience a substantial enough governmental interest to uphold incontestability. But if administrative convenience is enough to constitute a substantial government interest here, why not for all sorts of speech regulations directed at other harms, where administrative convenience may justify suppressing lots of non-harmful speech?

120 See *Snow*, *supra* note 6, at 104. Also, there are special rules for "certification" and collective marks; certification marks must not be used in a discriminatory fashion, excluding producers who meet the standards for certification adopted by the certifying organization. 15 U.S.C. § 1064(5)(D) (2012). How this rule could survive strict scrutiny is unclear.

121 *Pursuing America's Greatness v. Fed. Election Comm'n*, No. 15-5264 (D.C. Cir. Aug. 2, 2016).

rejecting or registering highly similar terms as disparaging or not. And it's true that there are lots of inconsistencies in the results. But vagueness is also a huge problem with the rest of the bars, which can be equally unpredictable. The PTO takes the position that the result in one case isn't binding in the next case, even if the facts are highly similar; that position isn't limited to section 2(a) disparagement cases.<sup>122</sup> There is an individualized determination in each case, and the examples cited by the *Tam* majority often involved different factual records about what members of the targeted group would think when they saw the mark.<sup>123</sup>

If vagueness is a constitutional flaw in disparagement, then, most of the other bars;<sup>124</sup> or distinctions between inherently distinctive, immediately registrable marks versus descriptive marks that can only be registered upon a showing of secondary meaning;<sup>125</sup> or the "use as a mark" precedents requiring trademark use instead of ornamental use for registration; or infringement standards themselves<sup>126</sup> should also fall to a vagueness challenge.

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122 See, e.g., *In re Nett Designs, Inc.*, 236 F.3d 1339 (Fed. Cir. 2001); *In re Couriarte Express Int'l, Inc.*, 222 U.S.P.Q. (BNA) 365, 366 (T.T.A.B. 1984) ("That each case must be determined on its own facts is a proposition so well established that no authority need be cited in support of it.").

123 See *In re Tam*, 808 F.3d 1321, 1337 (Fed. Cir. 2015) (citing the PTO's registration of DYKES ON BIKES "after the applicant showed the term was often enough used with pride among the relevant population"); see also *McDermott v. S.F. Women's Motorcycle Contingent*, 240 Fed. App'x 865, 866 (Fed. Cir. 2007) (recounting the initial refusal and subsequent successful registration after applicant submitted evidence that lesbians would not perceive the mark as disparaging).

124 See *Snow*, *supra* note 6, at 156–58 (noting that other bars are also vague and uncertain).

125 There is, for example, a circuit split on whether CHICKEN OF THE SEA for tuna is inherently distinctive or descriptive. Compare *Van Camp Sea Food Co. v. Packman Bros.* 79 F.2d 511, 511–12 (3d Cir. 1935) (per curiam) (descriptive), with *Van Camp Sea Food Co. v. Alexander B. Stewart Orgs.*, 50 F.2d 976, 979 (C.C.P.A. 1931) (suggestive). For further discussion of the difficulty of marking the line between suggestive and descriptive, see also *Thompson Med. Co. v. Pfizer Inc.*, 753 F.2d 208, 213 (2d Cir. 1985) ("It cannot be gainsaid that the judiciary is ill-equipped to distinguish between the descriptively suggestive and the suggestively descriptive mark. In addition, societal vicissitudes demand that the categories retain fluidity to accommodate a particular mark's evolving usage over time. . . . [I]t is necessary to surmise the mental processes of those in the marketplace at whom the mark is directed." (footnote omitted)); *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979) ("The line separating [suggestive and descriptive marks] is uncertain; extrapolating the line from precedent would be impossible. . . . [T]he distinction between descriptive and suggestive marks may be inarticulable . . ."); *Snow*, *supra* note 6, at 153–55 (elaborating on the vagueness of the line); cf. *Thompson Med. Co.*, 753 F.2d at 213 n.8 ("[B]ecause generic marks cannot be protected even upon a showing of secondary meaning, courts increasingly have been called upon to delineate the chimerical line between the descriptive and the generic.").

126 See, e.g., Graeme W. Austin, *Trademarks and the Burdened Imagination*, 69 BROOK. L. REV. 827, 874 (2004) ("[T]he general uncertainty as to the sufficiency and type of confusion required contributes to the general impression that trademark liability is founded on an unsteady pile of vague standards. Sometimes, courts deciding trademark infringement cases do articulate applicable standards with apparent precision. But the precision

Consider refusals under section 2(d) based on likely confusion with a previously used mark: the PTO reversed a refusal to register BLACK BARK for restaurant services, finding it unlikely to cause confusion with the registered mark BLACK BARK BRISKET for meat and prepared meat.<sup>127</sup> By contrast, COLOMBIANO COFFEE HOUSE for restaurant services and COLUMBIAN for coffee were closely related and therefore confusingly similar.<sup>128</sup>

As another example, the first stylized version of the word “lite” below is registrable (with “lite” disclaimed, meaning that the trademark doesn’t provide any rights in the word itself) because the stylization is sufficient to create a separate commercial impression; the second is not:



When my students ask me for a rule distinguishing these two cases (and others), I can only tell them that no system this large can be perfectly consistent and that they need to train their judgment. The PTO’s official position is:

Whether or not the disclaimed literal components of a designation sought to be registered are displayed in an inherently distinctive fashion is necessarily a subjective matter which must be determined based on a viewer’s first impression.

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achieved may sometimes be illusory, particularly since courts determine liability based upon an holistic evaluation of the evidentiary ‘factors.’”); Robert G. Bone, *Taking the Confusion Out of “Likelihood of Confusion”: Toward a More Sensible Approach to Trademark Infringement*, 106 Nw. U. L. REV. 1307, 1335 (2012) (“[T]he [likely confusion] test’s genesis as an ad hoc compromise without a guiding policy rationale contributes to its vague and open-ended character. . . . And armed with a confusion-only infringement analysis and a vague and open-ended test, judges have wide latitude to impose liability on questionable grounds—such as anti-free riding—as long as they can find a plausible confusion risk.”).

127 *In re DLMW-BBQ, LLC*, 2016 BL 167592 (T.T.A.B. 2016).

128 *In re Accelerate s.a.l.*, 101 U.S.P.Q.2d (BNA) 2047, 2050–51 (T.T.A.B. 2012); *see also, e.g., In re Randakk’s Cycle Shakk, LLC*, 2015 BL 142187, at \*1–5 (T.T.A.B. 2015) (approving registration of RANDAKK’S CYCLE SHAKK for online retailing of motorcycle parts, including electric motors, notwithstanding the preexisting mark RANDAX for “electronic motors for land vehicles”); *In re Columbia Ins. Co.*, 2015 BL 167330, \*7 (T.T.A.B. 2015) (refusing LYTNING for protective industrial boots in light of LIGHTNING GLOVES for disposable latex gloves).

129 *In re Miller Brewing Co.*, 226 U.S.P.Q. (BNA) 666, 670 (T.T.A.B. 1985).

130 *In re Pollio Dairy Prods. Corp.*, 8 U.S.P.Q.2d (BNA) 2012, 2013–14 (T.T.A.B. 1988).

Because of this, the fact that examining attorneys have considered the stylization of other, different marks to be sufficient to make those marks distinctive is of limited probative value.<sup>131</sup>

Examples could easily be multiplied indefinitely because of the rule that each registration is determined independent of past decisions. Recently, the Federal Circuit affirmed the PTO's refusal to register a stylized version of CHURRASCOS (grilled meat) for restaurant services:



The only hitch was that the applicant already had a registration for the standard character form, CHURRASCOS, for the same services—that is, its registered mark was broader and had fewer distinctive features than its applied-for mark.<sup>132</sup> Nonetheless, the court of appeals held, the PTO had not erred. Though a registered mark is presumed valid, that presumption doesn't carry over to a new mark, even one that “happens to be similar (or even nearly identical).”<sup>133</sup> No matter what the registration issue is, then, the PTO maintains that each application is assessed on its own merits, including the factual record developed by the examiner for that particular application.<sup>134</sup>

The result is that the registration system is not highly predictable except at the probabilistic level (we can predict the approximate percentage of applications that will mature to registration), which is another way of saying that the standards are vague enough that divergent outcomes are common. There are now hundreds or thousands of applications each year. It would be actually astonishing if even the consistency available in obscenity cases were achievable in this flood. Asking the hundreds of examiners (at any given time) for more than rough consistency in results would be like asking America's public school teachers to make their content-based assessments of English papers with enough precision that they'd all give the same grades to the same papers.

The inherent inconsistency in a merits-based system is one reason why the Court has granted government flexibility in making content-based decisions in analogous situations: many systems of government grants couldn't survive if required to be strictly consistent in every case, and the benefits of having trademark registration (or public school teachers) are great enough to justify the inevitable inconsistencies. This is what it means to have a regulatory state, and it's another reason why, if the state is going to maintain a trademark system granting the benefits of registration after substantive exam-

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131 *In re Sadoru Grp., Ltd.*, 2012 WL 3875730, at \*2, \*6 (T.T.A.B. 2012) (citing *In re Grande Cheese Co.*, 2 U.S.P.Q.2d (BNA) 1447, 1449 (T.T.A.B. 1986)) (affirming refusal to register stylized Japanese word for motorcycle seats and seat pads with word disclaimed).

132 *In re Cordua Rests., Inc.*, 823 F.3d 594, 598 (Fed. Cir. 2016).

133 *Id.* at 600.

134 *See, e.g., In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003).

ination, it needs flexibility and tolerance inconsistent with traditional strict scrutiny or even heightened *Central Hudson*-style scrutiny.

## 2. Justifying Registration Requires Treating It as a Government Program, Not as a Speech Ban

Several decades ago, Lilian BeVier argued that trademark infringement liability was desirable, while general bans on false advertising weren't, because consumers can't protect themselves against trademark confusion the way they can protect themselves against other forms of deception.<sup>135</sup> Unfortunately for free speech absolutists who also like trademark law, that's implausible in many cases.<sup>136</sup> Consumers can use the place of purchase, small details, vendor reputation, the presence of a guarantee, and numerous other indicia to identify counterfeits, and in the absence of counterfeiting there are usually many more signifiers of actual source. Expansive trademark doctrines extend trademark liability far past common-law fraud, for example to cover "initial interest confusion" in which consumers are only briefly confused and know the truth when they make their purchases.<sup>137</sup> It's hard to imagine how strict scrutiny could preserve the non-fraud-like elements of current trademark law.

*Central Hudson*-style intermediate scrutiny might leave the Lanham Act with fewer holes. Still, the government's ability to go after particular deceptive uses of marks directly through consumer protection law, rather than denying registration before any harm has actually been shown or requiring disclaimers, might make most of section 2 overbroad even under *Central Hudson*'s supposedly laxer scrutiny. The current registration system targets possible or potential deception, not actual deception. The same is true with infringement liability.

## V. OBJECTIONS TO ALLOWING THE GOVERNMENT BROAD FREEDOM TO DEFINE REGISTRABILITY

### A. Viewpoint Discrimination

One objection: If my reasoning is correct, then could Congress deny trademarks to Democrats? What about any trademarks that incorporated the Democratic donkey and red, white, and blue? Viewpoint discrimination can be illegitimate in many more instances than content discrimination—that a disparagement bar is constitutional doesn't license Congress to grant trademarks only to Republicans.<sup>138</sup>

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135 Lillian R. BeVier, *Competitor Suits for False Advertising Under Section 43(a) of the Lanham Act: A Puzzle in the Law of Deception*, 78 VA. L. REV. 1, 20–21 (1992).

136 See Roger E. Schechter, *Additional Pieces of the Deception Puzzle: Some Reactions to Professor BeVier*, 78 VA. L. REV. 57, 66–67 (1992).

137 See *Grotirian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 523 F.2d 1331, 1342 (2d Cir. 1975).

138 *R.A.V. v. City of St. Paul*, 505 U.S. 377, 388–389 (1992), indicates that governments can't decide that assaults against Republicans because they are Republicans will be subject

The existing exclusions in section 2 should be understood as content-based rather than viewpoint-based. Contrary to the holding of *In re Tam*,<sup>139</sup> the ban on disparaging marks should be characterized as content-based—a registered mark can’t disparage anyone, abortionist or anti-choice zealot.<sup>140</sup> The Federal Circuit en banc majority claimed that “[t]he legal significance of viewpoint discrimination is the same whether the government disapproves of the message or claims that some part of the populace will disapprove of the message.”<sup>141</sup> But this framing cleverly equivocates on “some part of the populace”—that statement would be plausible *if* the “part of the populace” at issue was static and unchanging no matter what mark was at issue. However, if the “part of the populace” whose views are considered changes depending on the specifics of the applied-for mark, no particular group or set of viewpoints receives protection denied to everyone else.

Congress didn’t disagree with any *particular* message or attempt to avoid disparagement of any *particular* target.<sup>142</sup> Like defamation, which is content-based but not viewpoint-based, the disparagement bar protects everyone. In other words, falsely and in bad faith praising someone, with resulting unwarranted gain to his reputation, is not actionable, while falsely and in bad faith denigrating someone, with resulting unwarranted harm to his reputation, is defamatory. While the content of speech is very much relevant, the only “viewpoint” being consistently suppressed is the viewpoint that defamation is a perfectly fine thing.

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to harsher punishment, or that only false advertising that degrades men will be banned. Cf. Sunstein, *supra* note 54, at 611 (arguing that government funding choices on aesthetic, qualitative, and content-based grounds are all acceptable and distinguishable from viewpoint-based discrimination).

139 808 F.3d 1321, 1335–37 (Fed. Cir. 2015). To elaborate further: if, in context, the term “slants” connotes meaning related to window-shades, or “redskins” connotes peanuts, then the PTO will register marks containing those terms. Whenever a substantial component of the referenced group would perceive that a term they consider derogatory as applied to them is being applied to them, however, then registration will be refused, regardless of the applicant’s viewpoint. This is a distinction based on content—people referring to peanuts can register the term—but not on viewpoint. The applicant’s speech or viewpoint isn’t part of the evaluation; instead, it’s the overall meaning of the term at issue, in the context of its surroundings.

140 See *Ridley v. Mass. Bay Transp. Auth.*, 390 F.3d 65, 82–87 (1st Cir. 2004) (considering a ban on disparaging subway ads). Sunstein considers similar restrictions on hate speech in government arts funding to be viewpoint-based, but nonetheless acceptable given the effects of government support. Sunstein, *supra* note 54, at 614–15 (“[Hate speech] is not merely offensive, but also helps produce a distinctive set of harms, including a perpetuation of second-class citizenship for certain groups. Government[s] might have sufficient reason to refuse to fund such speech even if [they] may not criminalize it.”).

141 *Tam*, 808 F.3d at 1336.

142 See *id.* at 1372 (Dyk, J., concurring and dissenting) (“[T]he standard is not based on the government’s disagreement with anything. Rather, it is based on an objective, ‘neutral’ assessment of a non-government perspective—in this case, a ‘substantial composite of the referenced group.’ . . . [T]here is no ‘realistic possibility that official suppression of ideas is afoot.’” (quoting *Davenport v. Wash. Educ. Ass’n.*, 551 U.S. 177, 189 (2007))).

The Supreme Court has held that a law barring only “fighting words” based on race and religion discriminates on the basis of viewpoint because other types of fighting words are allowed, including those based on political affiliation or homosexuality; the Court concluded that the government can’t allow one side of an argument to “fight freestyle” while the other is constrained.<sup>143</sup> By contrast, disparagement based on membership in any group is covered by section 2(a). In the world of trademark registration, no one is licensed to fight freestyle; consistent with the *doux-commerce* rationale, we are all “to follow Marquis of Queensbury rules” in our registered trademarks.<sup>144</sup>

Furthermore, the disparagement exclusion denies registrations both to people trying to disparage a group and people trying to reclaim terms on behalf of the disparaged group.<sup>145</sup> If a substantial composite of the group described would find the term disparaging, registration is barred. Thus, the disparagement bar is also neutral as to the applicant’s viewpoint on the particular disparaged group at issue<sup>146</sup>—whereas viewpoint discrimination in the past has been tied to the viewpoint of the person who is losing out because of her speech, such as a speaker denied school funding because *her* viewpoint was religious instead of nonreligious.<sup>147</sup> So, for example, if an applicant applied for CELEBRASIANS for an advocacy group that sought to

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143 *R.A.V.*, 505 U.S. at 391 (noting that the ordinance in *R.A.V.* targeted only specific kinds of “abusive invective,” excluding others, including those based on political affiliation or homosexuality); *id.* at 392 (government can’t allow one side to “fight freestyle” while the other is constrained). Jack Balkin, in conversation, offered the example of HAPPY JEW for bagels (probably registrable) versus SMELLY JEW for bagels (unregistrable), to argue that section 2(a) is viewpoint-based. But neither Jew nor Gentile can register this term, nor can anyone register SMELLY GENTILE. Moreover, as Balkin suggested, to the extent that the section 2(a) bar furthers Congress’s general purpose of making commerce orderly and open to all, disparaging terms can be singled out even under *R.A.V.* because their special treatment is an instance of the overall justification for the registration system. I thank Jack Balkin for pressing me on this point.

144 *R.A.V.*, 505 U.S. at 391.

145 See *id.* (explaining that a hypothetical statute that prohibited “odious racial epithets . . . to proponents of all views” would not discriminate on the basis of viewpoint); Jacobs, *supra* note 68, at 1424 (noting that many denials of disparaging vanity license plates come from people of the targeted heritage seeking to reclaim terms; “the recall of a single term can affect multiple points of view”).

146 See *Boos v. Barry*, 485 U.S. 312, 315–19 (1988) (plurality) (upholding law against display of any sign within 500 feet of a foreign embassy if the sign would tend to bring that foreign government into “public odium” or “disrepute”; restriction was not viewpoint-based because looking at policies of foreign governments was a neutral method of identifying covered speech); see also *Ridley v. Mass. Bay Transp. Auth.*, 390 F.3d 65, 90 (1st Cir. 2004) (“[G]uidelines prohibiting demeaning or disparaging ads are themselves viewpoint neutral.”); *id.* at 91 (“[T]he state is not attempting to give one group an advantage over another in the marketplace of ideas.”); cf. *Ark. Educ. Television Comm’n v. Forbes*, 523 U.S. 666, 683 (1998) (denying participation in political debate to candidate with minimal public support was not viewpoint-based, because participation would be denied to anyone who lacked sufficient support, no matter what views he held).

147 See *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 831 (1995).



bar Asian immigration, the mark wouldn't be disparaging even if the group was.

The *In re Tam* majority's error was to find viewpoint discrimination because the bar relies on figuring out what a group of people understands the meaning of a term to be, in context. That's not a regulation that is based on the viewpoint of the speaker. Simon Tam insists that he's reclaiming the term "slants"; the Washington team insists that it respects and celebrates Native Americans.<sup>148</sup> We don't have to question their sincerity or make any inquiry into what they actually think to apply the disparagement bar. Moreover, the error of conflating the speaker's viewpoint with the audience's understanding, if taken seriously, would indicate that the deceptiveness bar is also viewpoint-based.<sup>149</sup> Terms that convey materially false meanings about a good or service are unregistrable (regardless of whether intent to deceive is present), but descriptive terms that convey immaterial false meanings are registrable with secondary meaning. It's materiality—a subjective, observer-based inquiry—that makes the difference, just as the perception of the target group makes the difference for disparagement.

Another way to see the disparagement bar is as working together with the false connection bar. Taken together, the bars create a viewpoint-neutral ban on use of the identity of a person or group of which one is not a part. If a mark disparages, it probably doesn't cause a false connection; if it causes a false connection, it probably doesn't disparage, and together they make up a unified content-based prohibition.<sup>150</sup> For example, DONALD TRUMP should not be registrable for piñatas without Trump's consent, regardless of whether one views the juxtaposition of the mark with the goods as disparaging or approving. Such a view is consistent with the legislative history, in which disparagement was initially touted as a way to avoid false connections.<sup>151</sup> Tam, unlike most applicants for disparaging marks, is a member of

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148 The use of a disparaging term as a mark might be thought to express the viewpoint "this is an okay thing to say," but at that point viewpoint and content have united in an unhelpful way; it's equally true to claim that using a deceptive mark expresses the viewpoint "this deceptive term is okay to use."

149 See Snow, *supra* note 6, at 145.

150 See *Bos. Red Sox Baseball Club Ltd. v. Sherman*, 88 U.S.P.Q.2d (BNA) 1581 (T.T.A.B. 2008) (finding that SEX ROD in Red Sox font was scandalous and disparaging of the Red Sox, but not likely to cause confusion or section 2(a) false connection for the very reason that it was disparaging); *id.* at 1591, 1593 ("The fact that . . . applicant's mark may evoke or bring to mind opposer's mark does not in itself necessarily compel a finding of likelihood of confusion as to source . . . the public would not . . . believe that opposer, a famous and reputable organization, would be associated with a mark that disparages itself.").

151 In congressional hearings, lawyer Edward Rogers—also the primary drafter of the Lanham Act—condemned sellers who obtained "vicarious credit to goods by putting a great man's name on them," and suggested barring marks that "bring [someone] into disrepute or ridicule [by] anyone in the place or community he resides." *Trade-Marks: Hearings on H.R. 9041 Before the Subcomm. on Trade-Marks of the H. Comm. on Patents*, 75th Cong. 80–81 (1938). Later testimony suggested that the disparagement and scandalousness bars would allow the PTO to refuse, for example, ABRAHAM LINCOLN gin—a classic

the group he targets—but perfect individual fit isn’t necessary if the overall law is viewpoint neutral.

Admittedly, the line between content- and viewpoint-based regulation is controversial and not very helpful without a theory of what the particular rule at issue is for.<sup>152</sup> But that problem returns us to the government’s legitimate purposes in running a registration scheme.<sup>153</sup>

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false connection. *Trade-Marks: Hearings on H.R. 4744 Before the Subcomm. on Trade-Marks of the H. Comm. on Patents*, 76th Cong. 19–20 (1939). Still later, the bill was amended to insert the additional prohibition against “falsely suggest[ing] a connection with,” immediately following the ban on disparagement. H. JOURNAL, 77th Cong., 2d Sess. 542 (1942); *see also Trade-Marks: Hearings on H.R. 4744 Before the Subcomm. on Trade-Marks of the H. Comm. on Patents*, 76th Cong. 21 (1939), *reprinted in* Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co., 703 F.2d 1372, 1381 (Fed. Cir. 1983) (including the statement of Thomas E. Robertson, former Commissioner of Patents, which suggested that the disparagement bar needed to be broadened because “it does not cover the use of an ex-President’s name . . . in a respectful manner on goods on which the family might not desire it used”).

152 *See, e.g., Rosenberger*, 515 U.S. at 831 (noting that the distinction between content and viewpoint discrimination “is not a precise one”); Berman, *supra* note 54, at 83 (“That it is unconstitutional for the government to act for the purpose of promoting speech favoring the Democrats (as opposed to, say, the Republicans) does not necessarily entail that it is unconstitutional for it to act . . . for the purpose of promoting speech favoring democracy (as opposed to, say, totalitarianism). Whether the latter is likewise unconstitutional depends, to be sure, upon one’s interpretation of the substantive content of the First Amendment, in particular ‘on what sorts of motivations it allows government to have.’” (footnotes omitted) (quoting GEOFFREY R. STONE ET AL., *CONSTITUTIONAL LAW* 1765 (3d ed. 1996))); Jacobs, *supra* note 68, at 1363–64 (2001) (discussing the need to understand viewpoint discrimination contextually, depending on the purpose of the government program at issue).

153 One possible response to my argument is that, if the justification for the disparagement is the desire to avoid connecting the government with the registration of a disparaging or scandalous term, then the rule should be that we assess the contested term’s meaning today. Instead, the PTO will only refuse to register or cancel a term that was disparaging or scandalous at the time of the application. Thus, the government will accept a mark that becomes disparaging despite being neutral at the time it was adopted, and can’t completely divorce itself from the endorsement it wishes to resist. Amos ‘n Andy might be an example: while the name is not disparaging in the abstract, the racist content of the Amos ‘n Andy shtick might have taught the public to associate the term with pernicious stereotypes about African-Americans over time. The full name of the NAACP, the National Association for the Advancement of Colored People, is a name that could be scandalous if adopted today, for different reasons.

A current meaning standard, however, would create real problems for my constitutional analysis, because there could be untrademarkable goods and services. Suppose the Ku Klux Klan rebranded itself as the Garden Auxiliary; once it became known that the Garden Auxiliary was the KKK, it too would be a term of odium. Perhaps the best answer is that the existence of a group, product, or service can’t itself be scandalous or disparaging in the relevant sense. Only a trademark can be scandalous or disparaging in the way it evokes some concept (or group) that is not itself the product or service, but is instead a commercialized use of a term that should not be commercialized. The PTO will issue registrations for sex toys and other products that are not matters for polite conversation in all audiences, as long as the products are legal.

B. *Analogies to Copyright or Regulation of Creative Works*

On the same theory of withdrawing support, could the government refuse to grant copyright to disparaging works or obscenity? Upholding the disparagement bar would not entail this consequence because of the difference between what is protected in copyright and trademark. Copyright protects the expression in a work; to mandate that the work be non-disparaging or nonobscene to get protection is to mandate a change in the work itself as a condition of the benefits of protection.<sup>154</sup> But because trademark is about protecting a source link rather than a work in itself, the Washington team can have the unregistrable word present on everything that is protected by its rights in the team colors and logo. That is, the business can continue to use the symbol the government doesn't like on the very products and services for which it seeks trademark protection and still have its trade interests protected as long as it chooses some other symbol to make the link between itself and its goods and services.

It is worth noting, however, that the government could indeed withdraw or refuse to grant copyright protection to categories of works without violating the First Amendment. Architectural works, for example, were excluded from copyright protection for two centuries with no First Amendment problems. Consider also the lack of copyright protection for fashion design, or for recipes and perfumes. Professor Christopher Buccafusco has cogently argued that tastes and smells often produce sensory experiences that are the equivalent of visual and aural art,<sup>155</sup> rendering current copyrightability rules content-based. Again, then, the question is whether the exclusions are sufficiently related to a legitimate purpose for the government's program, and this legitimate purpose may even come from the categories of creative activity the government wishes to encourage.

The trademark function also distinguishes registration from New York's unconstitutional "Son of Sam" law, which allowed the state to escrow money received from a criminal's expression about his crimes.<sup>156</sup> Even assuming there is a constitutional right to profit from one's expression, Washington's team can continue to sell the same jerseys without financial sanction, and with trademark protection, and the government will not escrow the resulting

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154 We do mandate that the work be expressive (as well as conceptually separable from the useful aspects of an object in the case of pictorial, graphic, and sculptural works) and not purely factual, so we do already make some content-based judgments in copyright.

155 See Christopher Buccafusco, *Making Sense of Intellectual Property Law*, 97 CORNELL L. REV. 501, 540–41 (2012).

156 *Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd.*, 502 U.S. 105, 108 (1991). The Court determined that the "Son of Sam" law was a content-based statute because it "single[d] out income derived from expressive activity for a burden the State place[d] on no other income, and it [wa]s directed only at works with a specified content." *Id.* at 116; see also *Rosenberger*, 515 U.S. at 828 ("[G]overnment offends the First Amendment when it imposes financial burdens on certain speakers based on the content of their expression." (citing *Simon & Schuster, Inc.*, 502 U.S. at 115)).

income nor tax the sales any differently than it does for other NFL teams' jerseys.<sup>157</sup>

## VI. TRADEMARK LAW AS FIRST AMENDMENT MICROCOSM

Trademark law presently is host only to a small outpost of free speech doctrine, but that situation seems poised to change. And trademark law might provide a good opportunity to rethink the recent judicial assault on ordinary economic regulations carried out by way of regulating commercial speech.

Consider the simplest case for government intervention, deceptive marks. Deception involves an interaction between the mark and the identified product or service itself, which presumably in the abstract is unprotected by the First Amendment. SUPER SILK for fabric not made of silk is deceptive and never registrable or protectable. SUPER SILK for materials made of silk is merely descriptive, and registrable and protectable upon a showing of secondary meaning. REDSKINS for potatoes is the same. The restrictions here are not speaker-based in the ordinary sense but producer-based, which might be a good way to think about commercial speech generally. Assessing the relation between the product and the symbol is a necessary part of any functioning trademark system. And that's not a bad thing, even as current Supreme Court doctrine seems to condemn "content-based" regulation wholesale.

Current First Amendment categories don't work well with trademarks for several interrelated reasons. First, there are often at least two speakers' interests at stake—the claimant and the defendant or opposer, as Judge Dyk's *In re Tam* opinion pointed out. Second, trademark is a system of economic regulation, where the economic transactions are facilitated through speech that is regularly non-falsifiable, or only true or false to the extent that the law protects a claimant's rights. Third, registration and infringement are closely related but distinct inquiries, and a right to use a symbol isn't necessarily a right to register it. Registration, as its name indicates, is a creature of the regulatory state; applying libertarian First Amendment doctrines to it leaves us with nowhere to stand as a baseline. The corrosive First Amendment that emerges from *Reed* can't even conceptualize registration as a coherent government project.

Because of all these features, trademark is a useful testing ground for the idea that regulations of false and misleading commercial speech will somehow survive strict scrutiny, and therefore we can have our cake (a libertarian First Amendment) and eat it safely and with confidence that it is in fact cake, too (robust regulation of commercial activity). As the previous Parts have shown, such a claim is premised on the mistaken assumption that false and misleading speech will be easy to identify. It is not. Section 2(a)'s current

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157 See *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 456 (E.D. Va. 2015) ("Section 2(a) imposes no financial penalty on speech—it simply cancels a trademark's registration; the speech itself is uninhibited.").

troubles are related to those of the FDA, whose control over promotion of off-label uses of medications has recently been successfully challenged as a violation of the First Amendment.<sup>158</sup> Other ordinary commercial speech regulations, such as the Fair Debt Collection Practices Act, are no safer. That law extensively regulates how debt collectors may communicate with debtors and others. Congress specifically prohibited the use of threats (traditionally unprotected speech), profane language (not traditionally unprotected), and threats to publicize the existence of the debt (likewise).<sup>159</sup> Debt collectors are also not allowed to publicize the existence of the debt even in the absence of threats to do so—a content-based restriction on speech to non-debtors, or possibly even a viewpoint-based restriction, given that speech about how a person pays her bills on time is unregulated.<sup>160</sup> These are the kinds of regulations that are currently protected by commercial speech doctrine; its demise would profoundly disrupt the modern regulatory state.

More generally, once an economic regulation is exposed to the modern First Amendment, that regulation may have difficulty surviving, no matter how sensible it is. This is either a problem with First Amendment doctrine, or it's a problem with the modern rejection of *Lochner*. I believe it's the former. Much commercial activity involves and even requires speech to occur. The basic idea behind strict scrutiny for content- or viewpoint-based regulation was to protect against unfair government suppression of speakers, who might have important information to share with audiences as well as autonomy interests of their own in speaking. But if we are really that suspicious of government economic regulation picking winners and losers by way of speech, then we shouldn't even have trademark registration, and maybe not even infringement cases.

My preferred response would instead be to rethink First Amendment doctrine as applied to ordinary economic regulations. Whether section 2(a)'s ban on disparaging marks survives constitutional scrutiny is only a small part of that broader issue. In particular, having a trademark registration system (and trademark law in general) means that the government spends substantial resources making content-based distinctions among different claimed marks. That's not a strike against trademark law; it's a consequence of the fact that content-based distinctions are part of a well-functioning system of regulating commercial transactions. The government can validly reject a trademark application because the claimed mark is actually a generic term for the product—such as COMPUTER for computers—or because the claimed mark is confusingly similar to another producer's—such as GOOGLE for computer chips, claimed by some entity other than Alphabet. Content discrimination forms the basis of the trademark system. The only question is what kinds of content-based distinctions are legitimate.

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158 See *Amarin Pharma, Inc. v. U.S. Food & Drug Admin.*, 119 F. Supp. 3d 196, 237 (S.D.N.Y. 2015).

159 15 U.S.C. §§ 1692d, 1692f (2012).

160 *Id.* § 1692c(b).

I would leave most such determinations for the legislature, for better or worse.<sup>161</sup>

There is one other alternative. Nothing requires actual doctrine to be coherent, consistent, or equally suspicious of different types of regulations. There remains the possibility of continued ad hoc-ism, where the Court applies its strict scrutiny only to some parts of a system, often the ones that protect less politically powerful groups. But that would be the worst result of all.

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161 *Cf.* *United States v. Am. Library Ass'n*, 539 U.S. 194, 205 (2003) (plurality opinion) (noting that public libraries “necessarily consider content in making collection decisions and enjoy broad discretion in making them”); *Ark. Educ. Television Comm’n v. Forbes*, 523 U.S. 666, 673 (1998) (holding that public television broadcasters necessarily exercise editorial discretion).

