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## Free Speech & Disparaging Trademarks

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# FREE SPEECH & DISPARAGING TRADEMARKS

NED SNOW\*

**Abstract:** Speech law has silenced trademark. In *In re Tam*, the Federal Circuit ruled that the First Amendment requires Congress to grant trademark protection for disparaging speech. More specifically, the Federal Circuit held unconstitutional the provision of the Federal Lanham Act that denies trademark protection for marks that disparage. The Federal Circuit's ruling, however, is not the final word on the issue. The Supreme Court has agreed to hear the *Tam* case. This Article argues against the Federal Circuit decision. As illustrated by the five different opinions from the *en banc* panel, the complexities of speech law easily lead to disparate conclusions, any one of which may seem reasonable. Yet if there is one principle of speech law that is certain, it is this: context is dispositive. The context of trademark law is particularly nuanced, so a failure to account for that context easily produces inconsistencies in the application of speech law's doctrine and policy. Tellingly, none of the Federal Circuit's five opinions consider the context of trademark law. None consider whether the majority's holding is consistent with trademark's most fundamental doctrines. None recognize that trademark law imposes other content-based criteria as conditions for protection, and has done so for over a century. The *Tam* majority merely applied speech law to the narrow provision under consideration, failing to account for the broader context of trademark law. This Article provides that context. The Article concludes that the context of trademark law implies the constitutionality of the Lanham Act's anti-disparagement provision .

## INTRODUCTION

The issue of whether a disparaging mark may receive federal trademark protection has received much attention in the past year. Courts, scholars, and the public continue to ask the simple question: Will the Redskins lose their trademark?<sup>1</sup> For the past seventy years, the Lanham Act has

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<sup>1</sup> See *Pro Football, Inc. v. Blackhorse*, Memorandum Opinion and Order, 112 F.Supp.3d 439, 450 (E.D. Va. 2015); Final Opening Brief of Appellant at 2, *Pro-Football, Inc. v. Blackhorse*, No. 15-1874 (4th Cir. Mar. 18, 2016); Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, 91 NOTRE DAME L. REV. (forthcoming), available at <http://ssrn.com/abstract=2745016>, \*1-2 [<https://perma.cc/Q2KL-CKXA>]; Jay Caspian Kang, *Dan Snyder and the Redskins Take a Loss*, NEW YORKER (June 18, 2014), <http://www.newyorker.com/news/news-desk/dan-snyder-and-the-redskins-take-a-loss> [<https://perma.cc/SY7J-WFZ9>]; Pete Williams, *Red-*

barred trademark registration for marks that “disparage,”<sup>2</sup> and the Patent and Trademark Office (“PTO”) has accordingly denied trademark protection for marks such as REDSKINS on the grounds that the marks disparage racial or other groups.<sup>3</sup> Yet in *In re Tam*, the Federal Circuit held that the anti-disparagement provision of the Lanham Act is unconstitutional on free-speech grounds, reversing decades of its own precedent.<sup>4</sup> The Supreme Court has granted a petition for certiorari on the issue.<sup>5</sup>

Analyzing the Lanham Act’s anti-disparagement provision under the First Amendment raises particularly difficult questions, both because speech law is so complex and because trademark law is so nuanced. The uncertainty that surrounds the intersection of free speech and trademark law is exemplified in *Tam*, in which an en banc panel produced five different opinions.<sup>6</sup> The five opinions set forth different interpretations of free-speech jurisprudence, all of which seem well reasoned and thorough, yet all of which reach disparate conclusions.<sup>7</sup> One crucial element, however, was missing in all the opinions. None of the judges considered whether the majority’s holding is consistent with the rest of trademark law.<sup>8</sup> None of the judges accounted for the context of trademark in applying speech law, and in speech law, context is everything.<sup>9</sup> Because the context of trademark law is particularly nu-

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*skins Ruling Could Stick This Time, Say Trademark Experts*, NBC NEWS (June 18, 2014, 7:00 PM), <http://www.nbcnews.com/news/sports/redskins-ruling-could-stick-time-say-trademark-experts-n134781> [<https://perma.cc/57JC-KVSD>].

<sup>2</sup> See Trademark Act of 1946 (Lanham Act), 15 U.S.C. § 1052(a) (2012).

<sup>3</sup> *Blackhorse v. Pro Football, Inc.*, 111 U.S.P.Q.2d 1080, 2014 WL 2757516 (T.T.A.B. Mar. 7, 2013).

<sup>4</sup> 808 F.3d 1321, 1328 (Fed. Cir. 2015), *cert. granted*, 2016 WL 1587871 (U.S. Sept. 29, 2016) (No. 15-1293). Compare *In re Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003) (ruling the anti-disparagement criterion of the Lanham Act does not violate the First Amendment), *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994) (same), and *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) (same), with *In re Tam*, 808 F.3d at 1327–28 (holding that First Amendment does not allow the government to refuse to register disparaging marks because it disapproves of the expressive messages conveyed by the marks).

<sup>5</sup> See *Lee v. Tam*, No. 15-1293, 2016 WL 1587871 (U.S. Sept. 29, 2016); Eugene Volokh, *Federal Appeals Court Decides ‘the Slants’ Case*, WASH. POST (Dec. 22, 2015), <https://www.washingtonpost.com/news/volokh-conspiracy/wp/2015/12/22/federal-appeals-court-decides-the-slants-case-excluding-disparaging-marks-from-trademark-registration-violates-the-first-amendment/> [<https://perma.cc/BL95-8B67>] (“Moreover, because the court has struck down part of a federal statute, the Supreme Court will likely agree to consider the case (if the government asks it to); so this isn’t the final word on the matter.”).

<sup>6</sup> See *In re Tam*, 808 F.3d at 1327–58; *id.* at 1358–63 (O’Malley, J., concurring); *id.* at 1363–74 (Dyk, J., concurring and dissenting); *id.* at 1374–76 (Lourie, J., dissenting); *id.* at 1376–82 (Reyna, J., dissenting).

<sup>7</sup> See *id.* at 1321 (majority opinion).

<sup>8</sup> See *id.*

<sup>9</sup> See, e.g., *Schenck v. United States*, 249 U.S. 47, 52 (1919) (“But the character of every act depends upon the circumstances in which it is done. The most stringent protection of free speech

anced, a failure to account for that context in applying speech law easily produces inconsistencies in doctrine and policy. Those inconsistencies are apparent in the *Tam* majority opinion.

Perhaps the most evident inconsistency between trademark law and the majority opinion is the fact that trademark law recognizes other content-based criteria as conditions for trademark registration and has done so for more than a century.<sup>10</sup> The requirements that a mark be distinctive and non-deceptive, for instance, are well-established content-based restrictions that have never created a problem with speech law.<sup>11</sup> Similarly, the Lanham Act's exclusion of trademark protection for government symbols—core protected political speech—presents no First Amendment problem.<sup>12</sup> None of the judges discussed this. The judges merely applied speech law to the narrow provision under consideration, without considering the broader context of trademark law. This Article provides that context.<sup>13</sup>

The context of trademark law undermines four premises that are essential to the majority holding. The first premise is that the anti-disparagement provision of the Lanham Act should not be analyzed under an exceptional free-speech framework, such as the framework for commercial speech or for government subsidies, which are more tolerant of content-based restrictions.<sup>14</sup> The majority's refusal to employ an exceptional framework to the bar on disparaging marks raises an indefensible implication in trademark law. Specifically, refusing to apply an exceptional framework to the anti-disparagement criterion implies that none of the other content-based criteria for trademark registration—such as the criterion of distinctiveness—should be analyzed under an exceptional framework.<sup>15</sup> Moreover, it implies that the content-based restriction that trademark law imposes on potential infringers cannot be analyzed under an exceptional framework.<sup>16</sup> And in the absence of an exceptional framework, these content-based provisions of the Lanham Act would be unconstitutional.<sup>17</sup> In short, the implica-

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would not protect a man in falsely shouting fire in a theatre and causing a panic.” (citations omitted)).

<sup>10</sup> See *infra* notes 34–163 and accompanying text.

<sup>11</sup> See 15 U.S.C. § 1052(a), (e) (2012); *infra* notes 135–163 and accompanying text.

<sup>12</sup> See 15 U.S.C. § 1052(b); *infra* notes 206–215 and accompanying text.

<sup>13</sup> Professor Rebecca Tushnet has written on this topic as well. See Tushnet, *supra* note 1, at \*1–2. She also argues that the *Tam* decision presents difficulties in “distinguishing other aspects of trademark law” for First Amendment purposes. *Id.* at \*3.

<sup>14</sup> See *infra* notes 46–58 and accompanying text.

<sup>15</sup> See *infra* notes 49–58 and accompanying text.

<sup>16</sup> See *infra* notes 61–132 and accompanying text.

<sup>17</sup> See *infra* notes 61–132 and accompanying text.

tion of the majority's first premise would eliminate trademark law altogether.

The majority's second premise is that the anti-disparagement criterion does not support the purpose of trademark law.<sup>18</sup> The majority relied on a faulty assumption to derive this premise—namely, that the purposes of trademark law are limited to preventing consumer confusion and protecting goodwill of a markholder.<sup>19</sup> Courts and scholars agree that these are not the only purposes of trademark law.<sup>20</sup> Indeed, preventing consumer confusion and protecting markholder goodwill support broader purposes, such as promoting efficiency in, and proliferation of, the commercial marketplace.<sup>21</sup> The anti-disparagement criterion supports these broader purposes.<sup>22</sup> The majority's second premise therefore falters.

The third premise is that the anti-disparagement criterion is viewpoint discriminatory.<sup>23</sup> The majority reasoned that because the Lanham Act denies protection for views that disparage, but the Act grants protection for views that praise, the Act must be discriminatory.<sup>24</sup> This reasoning, however, calls into question other content-based criteria for trademark protection.<sup>25</sup> Specifically, the majority's reasoning implies that the criterion of non-deceptiveness and the criterion of secondary meaning are viewpoint discriminatory.<sup>26</sup> Hence, the implication of the third premise contravenes well-established trademark law.

The fourth premise is that the uncertainty in applying the anti-disparagement criterion suggests its unconstitutionality.<sup>27</sup> This conclusion ignores other well-established criteria for trademark protection that yield just as much uncertainty.<sup>28</sup> Trademark is fraught with vague standards that guide content-based analyses in order to determine markholder rights.<sup>29</sup> The anti-disparagement criterion is no different. If that criterion is unconstitutional for reasons of uncertainty, so is the rest of trademark law.

This Article concludes that the doctrinal underpinnings of the majority opinion are untenable and that the context of trademark implies the consti-

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<sup>18</sup> See *In re Tam*, 808 F.3d at 1354.

<sup>19</sup> See *id.*

<sup>20</sup> See *infra* notes 164–216 and accompanying text.

<sup>21</sup> See *infra* notes 164–216 and accompanying text.

<sup>22</sup> See *infra* notes 164–216 and accompanying text.

<sup>23</sup> See *In re Tam*, 808 F.3d at 1336–37.

<sup>24</sup> See *id.*

<sup>25</sup> See *infra* notes 217–262 and accompanying text.

<sup>26</sup> See *infra* notes 217–262 and accompanying text.

<sup>27</sup> See *In re Tam*, 808 F.3d at 1341–42.

<sup>28</sup> See *infra* notes 264–299 and accompanying text.

<sup>29</sup> See *infra* notes 264–299 and accompanying text.

tutionality of the anti-disparagement criterion. Part I challenges the majority's premise that the anti-disparagement criterion should not be analyzed under an exceptional free-speech framework.<sup>30</sup> Part II argues that the anti-disparagement criterion supports the purpose of trademark law.<sup>31</sup> Part III disagrees with the majority's premise that the anti-disparagement criterion is viewpoint discriminatory.<sup>32</sup> Part IV addresses the uncertainty surrounding the application of the anti-disparagement criterion.<sup>33</sup>

## I. THE ANALYTICAL FRAMEWORK

Perhaps the most important issue in deciding speech cases is the issue of framework. Absent an exceptional framework for evaluating restrictions, the Supreme Court has made clear that government "has no power to restrict expression because of its message, its ideas, its subject matter, or its content."<sup>34</sup> Laws that target the content of speech are subject to a presumptive framework of strict scrutiny. The strict-scrutiny framework imposes a high standard for justifying a content-based restriction: the restriction must be narrowly tailored to serve a compelling government interest.<sup>35</sup> A compelling government interest represents an interest "of the highest order,"<sup>36</sup> such as "protecting the physical and psychological well-being of minors"<sup>37</sup> or protecting national security.<sup>38</sup>

The strict-scrutiny framework of analysis is not without exception. The Supreme Court has designated that certain situations and certain classes of content fall outside the strict-scrutiny standard of review.<sup>39</sup> For instance,

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<sup>30</sup> See *infra* notes 34–163 and accompanying text.

<sup>31</sup> See *infra* notes 164–216 and accompanying text.

<sup>32</sup> See *infra* notes 217–262 and accompanying text.

<sup>33</sup> See *infra* notes 263–299 and accompanying text.

<sup>34</sup> *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2226 (2015) (quoting *Police Dep't of Chi. v. Mosley*, 408 U.S. 92, 95 (1972)); see *Brown v. Entm't Merchs. Ass'n*, 564 U.S. 786, 790 (2011); *Ashcroft v. ACLU*, 535 U.S. 564, 573 (2002); see also *Simon & Schuster, Inc. v. N.Y. State Crime Victims Bd.*, 502 U.S. 105, 118 (1991) ("If there is a bedrock principle underlying the First Amendment, it is that the Government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable." (quoting *United States v. Eichman*, 496 U.S. 310, 319 (1990))).

<sup>35</sup> *Reed*, 135 S. Ct. at 2226.

<sup>36</sup> See *Wisconsin v. Yoder*, 406 U.S. 205, 215 (1972).

<sup>37</sup> See *Sable Comm'ns of Cal., Inc. v. FCC*, 492 U.S. 115, 126 (1989) ("We have recognized that there is a compelling interest in protecting the physical and psychological well-being of minors.").

<sup>38</sup> See *Haig v. Agee*, 453 U.S. 280, 307 (1981) ("It is obvious and unarguable that no governmental interest is more compelling than the security of the Nation." (quotation omitted)).

<sup>39</sup> *Brown*, 564 U.S. at 791 ("From 1791 to the present, the First Amendment has permitted restrictions upon the content of speech in a few limited areas, and has never included a freedom to disregard these traditional limitations." (quoting *United States v. Stevens*, 130 S. Ct. 1577, 1584

where the government is speaking or where the restriction targets content of a commercial nature, courts evaluate the content-based restrictions through an exceptional framework that is less protective of speech.<sup>40</sup> Exceptional frameworks allow government significantly more discretion in restricting speech content.<sup>41</sup>

The issue in the trademark context is whether the anti-disparagement criterion should be evaluated under the presumptive framework of strict scrutiny or, alternatively, under an exceptional free-speech framework. It is arguable that the anti-disparagement criterion should be analyzed under any of three exceptional frameworks: (1) the government-subsidy framework;<sup>42</sup> (2) the commercial-speech framework;<sup>43</sup> and (3) the limited-public-forum framework.<sup>44</sup> Any of these frameworks could allow government to exercise subject-matter content discrimination in regulating trademark registration, depending on how the regulation relates to the purpose of trademark law.<sup>45</sup>

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(2010)). Nevertheless, some speech falls outside the general rule prohibiting government discrimination based on content. *See, e.g.*, *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 562–63 (1980) (upholding government regulation of commercial speech); *Brandenburg v. Ohio*, 395 U.S. 444, 447–49 (1969) (prohibiting inciteful speech); *Roth v. United States*, 354 U.S. 476, 485 (1957) (allowing regulation of obscene speech); *Chaplinsky v. New Hampshire*, 315 U.S. 568, 572 (1942) (allowing local governments to curtail “fighting words”). In addition, certain circumstances warrant limited government regulation of some speech content. *See, e.g.*, *Walker v. Tex. Div. Sons of Confederate Veterans*, 135 S. Ct. 2239, 2245 (2015) (holding that government speech may be limited based on content in certain circumstances); *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 587–88 (1998) (holding that the government may choose not to subsidize some speech with discretionary spending); *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995) (holding that the government may regulate speech made in a limited public forum of the government's own creation).

<sup>40</sup> *See Walker*, 135 S. Ct. at 2245 (government speech); *Finley*, 524 U.S. at 587–88 (government subsidies); *Rosenberger*, 515 U.S. at 829 (limited public forum); *Cent. Hudson*, 447 U.S. at 562–63 (commercial speech exception); *Brandenburg*, 395 U.S. at 447–49 (incitement exception); *Roth*, 354 U.S. at 485 (obscenity exception); *Chaplinsky*, 315 U.S. at 572 (fighting words exception).

<sup>41</sup> *See Walker*, 135 S. Ct. at 2245 (government speech); *Finley*, 524 U.S. at 587–88 (government subsidies); *Rosenberger*, 515 U.S. at 829 (limited public forum); *Cent. Hudson*, 447 U.S. at 562–63 (commercial speech exception); *Brandenburg*, 395 U.S. at 447–49 (incitement exception); *Roth*, 354 U.S. at 485 (obscenity exception); *Chaplinsky*, 315 U.S. at 572 (fighting words exception).

<sup>42</sup> *See In re Tam*, 808 F.3d at 1368–71 (Dyk, J., concurring) (analyzing trademark as a subsidy that allows for content-based restrictions and concluding “[t]hat trademark registration is a subsidy is not open to doubt”).

<sup>43</sup> *See id.* at 1376–78 (Reyna, J., dissenting) (analyzing anti-disparagement criterion under commercial-speech framework).

<sup>44</sup> *Cf. Ned Snow, Content-Based Copyright Denial*, 90 IND. L.J. 1473, 1486–89 (2015) (explaining application of limited-public forum doctrine for content of intellectual property in context of copyright law).

<sup>45</sup> In *Tam*, the Government also argued for another exceptional free-speech framework—the framework for government speaker. *See* 808 F.3d at 1339. That framework within the exceptional frameworks mentioned above is not included here because the majority's dismissal of that frame-

This Part, however, does not examine the intricacies of these frameworks and their arguable application to the trademark context. Judge Dyk's concurrence and Judge Reyna's dissent in *Tam* already provide much of that analysis.<sup>46</sup> Instead, this Part provides only a brief explanation of how these exceptional frameworks might apply in evaluating content-based restrictions in trademark law.<sup>47</sup> After that brief analysis, this Part examines whether other areas of trademark law suggest that some sort of exceptional framework must govern the analysis of the anti-disparagement criterion.<sup>48</sup>

### A. Exceptional Frameworks in Speech Law

The first exceptional free-speech framework that arguably should govern the analysis of the anti-disparagement criterion is the government-subsidy framework. Courts apply this framework when evaluating content-based restrictions that accompany government subsidies.<sup>49</sup> For instance, this framework applies where government adopts content-based standards as a criterion for funding artistic works.<sup>50</sup> Arguably, trademark rights constitute a subsidy that Congress provides to private speakers.<sup>51</sup> The anti-disparagement criterion is a content-based condition for receiving the benefits of trademark registration, so this framework seems potentially applicable.

The second framework occurs where speech content is of a commercial nature.<sup>52</sup> For instance, this framework applies in evaluating whether a state can restrict deceptive advertising.<sup>53</sup> Arguably, trademarks constitute

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work appears correct. *See id.* at 1345–48. Nevertheless, Professor Tushnet provides a plausible argument for the government-speaker framework under the rationale of the Supreme Court's decision in *Walker*. 135 S. Ct. at 2239; *see* Tushnet, *supra* note 1, at \*7–11.

<sup>46</sup> *See* 808 F.3d at 1368–71 (Dyk, J., concurring and dissenting) (suggesting that both the commercial speech and government subsidy frameworks may apply); *id.* at 1376–82 (Reyna, J., dissenting) (concluding that trademarks are quintessential commercial speech).

<sup>47</sup> *See infra* notes 49–60 and accompanying text.

<sup>48</sup> *See infra* notes 61–163 and accompanying text.

<sup>49</sup> *See* *Davenport v. Wash. Educ. Ass'n*, 551 U.S. 177, 188–89 (2007) (“[I]t is well established that the government can make content-based distinctions when it subsidizes speech.”); *Finley*, 524 U.S. at 588 (“Congress may selectively fund a program to encourage certain activities it believes to be in the public interest . . . .” (quoting *Rust v. Sullivan*, 500 U.S. 173, 193 (1991))).

<sup>50</sup> *See, e.g., Finley*, 524 U.S. at 572, 587–88.

<sup>51</sup> *See In re Tam*, 808 F.3d at 1368–71 (Dyk, J., concurring and dissenting).

<sup>52</sup> *Cent. Hudson*, 447 U.S. at 562–63 (“[O]ur decisions have recognized ‘the “commonsense” distinction between speech proposing a commercial transaction, which occurs in an area traditionally subject to government regulation, and other varieties of speech.’ The Constitution therefore accords a lesser protection to commercial speech than to other constitutionally guaranteed expression.” (citations omitted) (quoting *Ohralik v. Ohio State Bar Ass’n*, 436 U.S. 447, 455–56 (1978))).

<sup>53</sup> *See* *Bates v. State Bar of Ariz.*, 433 U.S. 350, 383 (1977).



commercial speech because they indicate the source of the good for sale.<sup>54</sup> By indicating the source of a good, trademarks aid consumers in making their purchasing decisions. Hence, the commercial-speech framework arguably should govern a speech analysis of the anti-disparagement criterion.

The third framework is the limited-public forum. Courts apply this framework when evaluating restrictions on speech that occur within a forum that the government has created for limited purposes.<sup>55</sup> For instance, this framework applies where government funds a student organization or a publication; the organization or the publications are considered a metaphysical forum.<sup>56</sup> Arguably, the trademark system functions as a metaphysical forum that Congress created for limited commercial purposes.<sup>57</sup> Congress

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<sup>54</sup> See *In re Tam*, 808 F.3d at 1376–82 (Reyna, J., dissenting) (“Trademarks are commercial speech.”); see also Victor Brundley, *The First Amendment and Commercial Speech*, 53 B.C. L. Rev. 1153, 1155–56 (2012) (explaining that commercial speech includes speech that “does no more than . . . simply identify the putative seller’s products”). For the sake of brevity, throughout the Article, the “goods” that are referenced represent both goods and services. See 15 U.S.C. §§ 1052, 1053 (2012) (providing protection to both goods and services).

<sup>55</sup> See *Rosenberger*, 515 U.S. at 829 (“The necessities of confining a forum to the limited and legitimate purposes for which it was created may justify the State in reserving it for certain groups or for the discussion of certain topics.”).

<sup>56</sup> *Christian Legal Soc’y v. Martinez*, 561 U.S. 661, 679–80 (2010) (student organization); *Rosenberger*, 515 U.S. at 829–31 (recognizing university funding for student publications as “a forum more in a metaphysical than in a spatial or geographic sense”).

<sup>57</sup> In *Christian Legal Society*, a student organization, the Christian Legal Society (“CLS”) sought to exclude students from its organization based on homosexual conduct or religious beliefs. 561 U.S. at 672. Because of these exclusions, Hastings Law School refused to give CLS official recognition as a student organization, which made CLS ineligible for a variety of privileges (e.g., funding and facility use). *Id.* at 672–73. At issue, then, was whether the First Amendment precluded Hastings from denying the benefit of official recognition as a student organization. *Id.* at 678–80. In deciding this question, the Court applied a limited-public-forum analysis. *Id.* One reason for the Court’s application of limited-public forum was that the benefit was a subsidy rather than a prohibition. *Id.* at 682. In the Court’s words:

[T]his case fits comfortably within the limited-public-forum category, for CLS, in seeking what is effectively a state subsidy, faces only indirect pressure to modify its membership policies; CLS may exclude any person for any reason if it forgoes the benefits of official recognition. . . . In diverse contexts, our decisions have distinguished between policies that require action and those that withhold benefits. Application of the less restrictive limited-public-forum analysis better accounts for the fact that Hastings, through its [student organization] program, is dangling the carrot of subsidy, not wielding the stick of prohibition.

*Id.* at 682–83 (citations and quotations omitted). Because CLS could still exist as an organization, even if it did not comply with the law school’s condition, the pressure to comply with the condition was indirect. See *id.* Denying the benefit was less severe than compelling compliance, and for that reason, the less restrictive analysis of limited-public forum was appropriate. See *id.*

Analogously, even if a markholder is denied registration, the markholder can still use a disparaging mark as a trademark; the markholder simply cannot receive the rights that derive from registration. See *In re Tam*, 808 F.3d at 1374–75 (Lourie, J., dissenting) (observing that even if a

creates the metaphysical forum of property rights for markholders to bring about marketplace efficiency and to promote the collective wellbeing of the marketplace.<sup>58</sup> Hence, the limited-public-forum framework is also arguable.

Having provided a brief description of three exceptional free-speech frameworks that are potentially applicable to the disparagement criterion, this Part contends that other areas of trademark law also imply that the anti-disparagement criterion should be analyzed under one of these frameworks. In making this argument, Section B observes that the reasoning of the majority implies inconsistent frameworks for evaluating similar trademark provisions.<sup>59</sup> Section C argues that, in contravention to the majority's analysis, established trademark doctrines imply that the framework should not employ strict scrutiny.<sup>60</sup>

### *B. Inconsistent Frameworks for Similar Trademark Provisions*

The majority in *Tam* concluded that the anti-disparagement criterion should not be evaluated under any of the three exceptional free-speech frameworks.<sup>61</sup> It reached this conclusion based on the premise that the source-identification function of a mark is distinct from an expressive element of a mark.<sup>62</sup> With respect to the source-identification function of a mark, the majority recognized that a mark serves to identify the source of a good, indicating who is producing and selling the good.<sup>63</sup> That ability to serve as a source identifier, the majority explained, is not an expressive element of a mark; nevertheless, a mark may contain an expressive element, such as a disparaging opinion.<sup>64</sup> In the majority's words:

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markholder cannot register a mark, “[t]he markholder may still generally use the mark as it wishes; without federal registration, it simply lacks access to certain federal statutory enforcement mechanisms for excluding others from confusingly similar uses of the mark”).

<sup>58</sup> See *infra* notes 164–216 and accompanying text (discussing the purposes of trademark law).

<sup>59</sup> See *infra* notes 61–132 and accompanying text.

<sup>60</sup> See *infra* notes 135–163 and accompanying text.

<sup>61</sup> *In re Tam*, 808 F.3d at 1338 (rejecting commercial-speech framework by noting that “[t]he disparagement provision must be assessed under First Amendment standards applicable to what it targets, which is not the commercial-speech function of the mark”); *id.* at 1351–53 (rejecting government-subsidy framework reasoning that “[t]rademark registration is not a subsidy”); *id.* at 1353 n.12 (dismissing public-forum analysis).

<sup>62</sup> *Id.* at 1338.

<sup>63</sup> *Id.* (“[T]rademarks identify the source of a product or service, and therefore play a role in the ‘dissemination of information as to who is producing and selling what product, for what reason, and at what price.’” (quoting *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 765 (1976))).

<sup>64</sup> *Id.* (“This case exemplifies how marks often have an expressive aspect over and above their commercial-speech aspect.”).

[C]ritically, it is always a mark's expressive character, not its ability to serve as a source identifier, that is the basis for the disparagement exclusion from registration. The disparagement provision must be assessed under First Amendment standards applicable to what it targets, which is not the commercial-speech function of the mark.<sup>65</sup>

The majority thereby drew a distinction between the element of a mark that serves as a source identifier and the element of a mark that has expressive character (i.e., a disparaging opinion).<sup>66</sup>

This distinction between source identification and expression is the linchpin of the majority's analysis. The majority reasoned that because any expressive element in a mark is distinct from the mark's source-identification element, an expressive element does not concern the commercial purpose of the mark, and thereby, an expressive element requires greater speech protection than does the source-identification element.<sup>67</sup> Stated differently, the majority believed that a speech restriction that targets the expressive element of a mark must be analyzed under the normal free-speech framework, in contrast to a speech restriction that targets the source-identification element of a mark, which would be analyzed under an exceptional framework.<sup>68</sup> Therefore, because the anti-disparagement criterion targets an expressive element of a mark—i.e., a disparaging opinion—the majority held that the criterion should not be analyzed under any of the exceptional frameworks.<sup>69</sup>

### 1. Source Identification as an Expressive Element

The majority appears correct that there are two elements in a disparaging mark: the source-identification element and the disparagement element. Yet the majority erroneously assumed that only the disparagement element is expressive. That assumption is entirely incorrect. Source identification is just as expressive as disparagement, if not more so. For purposes of free speech, *source* identification is *self*-identification, and self-identification is highly expressive.<sup>70</sup> That is to say, a trademark represents the means through which the producer or seller of a good chooses to identify itself as

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<sup>65</sup> *Id.*

<sup>66</sup> *Id.*

<sup>67</sup> *See id.*

<sup>68</sup> *See id.*

<sup>69</sup> *See id.* at 1339.

<sup>70</sup> *See, e.g.,* Hurley v. Irish-Am. Gay, Lesbian, & Bisexual Grp. of Bos., 515 U.S. 557, 559, 572–73 (1995) (striking down application of statute that would have required a parade organized by private citizens to include a message that the private organizers did not want to convey).

the source of the good.<sup>71</sup> For instance, J. Willard Marriott has chosen to identify his sponsorship of the hotel chain by using his last name.<sup>72</sup> He is communicating that the same quality and reputation that consumers may know to be true about him is also true for the business of which he is the source. He is expressing the identity and source of the hotel chain by expressing the meaning and significance of his own name. It thus seems indisputable that expressing an identity includes an expressive element. Indeed, as a practical matter, *who* is speaking can be just as important as *what* is being said. Source identification is an expressive element of a mark.

Not only does the source-identification function of a mark represent an expressive element of a mark, it represents an expressive element with great value as speech. Self-identification is necessary for determining one's own identity.<sup>73</sup> At its core, identifying oneself is part of the process for defining

<sup>71</sup> See 15 U.S.C. § 1127 (2012) (“The term ‘trademark’ includes any word, name, symbol, or device, or any combination thereof—(1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”); J. THOMAS MCCARTHY, 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3:6 (4th ed., 2016) (“Trademarks answer the question: ‘who are you?’”).

<sup>72</sup> See MARRIOTT, Registration No. 0899900.

<sup>73</sup> An example of the constitutional theme of protecting a person's ability to choose its identity is apparent in *NAACP v. Alabama*, in which the State of Alabama had attempted to subpoena membership records of the NAACP after the State alleged that the NAACP had not met statutory requirements for doing business in the state. 357 U.S. 449, 451–52 (1958). The Court considered the effects of requiring the NAACP to turn over its membership lists:

[W]e think it apparent that compelled disclosure of [the NAACP]'s Alabama membership is likely to affect adversely the ability of [the NAACP] and its members to pursue their collective effort to foster beliefs which they admittedly have the right to advocate, in that it may induce members to withdraw from [the NAACP] and dissuade others from joining it because of fear of exposure of their beliefs shown through their associations and of the consequences of this exposure.

*Id.* at 462–63. The State was threatening the NAACP in a way that would interfere with membership in the NAACP, such that it would be unable to determine its identity. *See id.*

The theme of being able to determine one's own identity is also apparent in *Griswold v. Connecticut*, in which the Court considered a Connecticut law that prohibited means for preventing contraception. 381 U.S. 479, 482 (1965). In striking down the law, the Court suggested a theme of protecting an individual's right to make choices for oneself, which define who the individual is:

The association of people is not mentioned in the Constitution nor in the Bill of Rights. The right to educate a child in a school of the parents' choice—whether public or private or parochial—is also not mentioned. Nor is the right to study any particular subject or any foreign language. Yet the First Amendment has been construed to include certain of those rights.

*Id.*; see also *Moore v. City of E. Cleveland*, 431 U.S. 494, 499 (1977) (“This Court has long recognized that freedom of personal choice in matters of marriage and family life is one of the liber-

oneself. And the constitutional importance of self-identity cannot be doubted.<sup>74</sup> So, although expression of identification does represent an important commercial function in trademark law, that same expression also represents an important constitutional value.<sup>75</sup> It is valuable speech. Hence, to recognize only the commercial value of source identification is to ignore the speech value of self-identification.

This conclusion—that source identification contains an expressive element of a mark—is so simple and obvious that it can be easy to miss. Judge Dyk’s concurrence is illustrative: although he criticized most of the majority’s application of speech law, he ultimately concurred with the majority’s judgment on the grounds that the mark at issue constituted core-protected speech.<sup>76</sup> The mark at issue was THE SLANTS, which its proponent, Mr. Tam, chose as a name for his rock band.<sup>77</sup> Mr. Tam explained the reason that his rock band chose THE SLANTS as follows: “We want to take on these stereotypes that people have about us, like the slanted eyes, and own them. We’re very proud of being Asian—we’re not going to hide that fact.”<sup>78</sup> This reason led Judge Dyk to characterize the mark as having “indisputably expressive character,” and that expressive character led Judge Dyk to believe that the government could not withhold trademark protection.<sup>79</sup> Tellingly, the expressive character of THE SLANTS that Judge Dyk found so compelling did not derive from its disparaging opinion.<sup>80</sup> Rather, the expressive character on which Judge Dyk relied derived from Mr. Tam’s choice of how to identify his group: THE SLANTS conveys a deep social meaning of Mr. Tam’s pride in being Asian, to the point that he calls his band a racial slur to challenge the negative connotation.<sup>81</sup> Hence, Mr. Tam is not using THE SLANTS as an attempt to disparage Asians (even though the mark is disparaging to them); rather, Mr. Tam is using THE SLANTS to express an opinion about his own identity as the source of the band.<sup>82</sup> Mr.

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ties protected by the Due Process Clause of the Fourteenth Amendment.” (quoting *Cleveland Bd. of Educ. v. Laflour*, 414 U.S. 632, 639–40 (1974)).

<sup>74</sup> See *Lawrence v. Texas*, 539 U.S. 558, 562 (2003) (“Liberty presumes an autonomy of self that includes freedom of thought, belief, *expression*, and certain intimate conduct.”) (emphasis added).

<sup>75</sup> See *supra* notes 73–74 and accompanying text.

<sup>76</sup> *In re Tam*, 808 F.3d at 1373–75 (Dyk, J., concurring) (quoting *In re Simon Shiao Tam*, 108 U.S.P.Q.2d 1305, 2013 WL 5498164 (T.T.A.B. 2013)).

<sup>77</sup> *Id.* at 1327–28 (majority opinion).

<sup>78</sup> *Id.* at 1373 (Dyk, J., concurring).

<sup>79</sup> *Id.*

<sup>80</sup> See *id.*

<sup>81</sup> See *id.*

<sup>82</sup> See *id.*

Tam uses THE SLANTS to express source identification—a choice of how to identify oneself as the source of a good.

The REDSKINS mark further exemplifies the principle that the source-identification element of a mark is highly expressive. The owner of the Redskins organization, Daniel Snyder, does not intend to disparage Native Americans by using REDSKINS as a mark—even if Native Americans perceive the mark to be disparaging.<sup>83</sup> Instead, Snyder is attempting to compare his team to warriors who were Native Americans.<sup>84</sup> For Snyder, REDSKINS captures this meaning. He expresses REDSKINS to convey this meaning as the source of the team.<sup>85</sup> When consumers refer to his team, he wants them to think of the team that is like Native American warriors as the identification of the source.<sup>86</sup> Source identification is thus a highly expressive element of the REDSKINS mark.

Despite these examples, one might still argue that any expressiveness in a mark is distinct from its source-identification function. The argument would be that any meaning expressed through the mark is in addition to, and thereby distinct from, the mark's function as a referent for the markholder. The meaning that a mark may express seems separate from its ability to distinguish itself from other brands, so arguably the function of distinguishing oneself from others is non-expressive. This argument suggests that the *Tam* majority was correct to treat the source-identification element of a mark separately from the expressive element.

An example illustrates this counterargument. Consider the marks KODAK for cameras and JUST DO IT for shoes.<sup>87</sup> The KODAK mark is a made-up, fanciful word that provides a basis for consumers to distinguish the Eastman Kodak Company from other camera manufacturers.<sup>88</sup> It would thereby seem that KODAK could just as easily be a random number to enable consumers to distinguish it. KODAK does not seem to have meaning; it seemingly serves only to refer consumers to the source of the camera. By

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<sup>83</sup> See Daniel Snyder, *Letter from Washington Redskins Owner Dan Snyder to Fans*, WASH. POST (Oct. 9, 2013), [https://www.washingtonpost.com/local/letterfrom-washington-redskins-owner-dan-snyder-to-fans/2013/10/09/e7670ba0-30fe-11e3-8627-c5d7de0a046b\\_story.html](https://www.washingtonpost.com/local/letterfrom-washington-redskins-owner-dan-snyder-to-fans/2013/10/09/e7670ba0-30fe-11e3-8627-c5d7de0a046b_story.html) [https://perma.cc/786Z-TPPM].

<sup>84</sup> *Id.* (“Washington Redskins is more than a name we have called our football team for over eight decades. It is a symbol of everything we stand for: strength, courage, pride, and respect—the same values we know guide Native Americans and which are embedded throughout their rich history as the original Americans.”).

<sup>85</sup> *See id.*

<sup>86</sup> *See id.*

<sup>87</sup> *See* KODAK, Registration No. 0389813; JUST DO IT, Registration No. 1875307.

<sup>88</sup> *See* Union Nat'l Bank of Tex., Laredo, Tex. v. Union Nat'l Bank of Tex., Austin, Tex., 909 F.2d 839, 845 (5th Cir. 1990) (“Fanciful terms are most often coined words such as ‘Xerox’ or ‘Kodak.’”).

contrast, the JUST DO IT mark expresses the message of accomplishing a task immediately, while at the same time referring consumers to the source of the good, which is Nike, Inc. The meaning of accomplishing a task immediately in JUST DO IT seems distinct from the function of identifying source. It thus seems possible to separate out any expressive meaning in a mark from the source-identification function of a mark. Whereas JUST DO IT has such expressive meaning, KODAK does not. This example, then, might be used to argue that if expression is present in a mark, the expression is distinguishable from its source-identification function.

This counterargument fails to recognize the meaning that is inherent in the source-identification function of every mark. In identifying the source of a good, a mark does more than merely refer consumers to that source. The mark expresses the way that the markholder desires for consumers to conceive of the source.<sup>89</sup> Consider KODAK. In addition to referring consumers to the camera manufacturer, KODAK provides a particular combination of letters as an expression for conceiving the identity of that manufacturer. The KODAK mark enables consumers to conceive of the source in a distinct way.<sup>90</sup> Would consumers think of the camera manufacturer in the same way if the mark were *400075HQU345YX* instead of KODAK? The former is long and difficult to articulate; the latter is short, incisive, and easy to say. Although both marks could serve to refer consumers to the

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<sup>89</sup> According to the philosopher Gottlob Frege, a name has both a sense and a reference. See Gottlob Frege, *On Sense and Meaning* (1892), reprinted in COLLECTED PAPERS ON MATHEMATICS, LOGIC, AND PHILOSOPHY 157, 160 (Brian McGuinness ed., Max Black trans., 1984). The reference of a name is the actual person to which the name refers. See *id.* The sense of a name is the way in which that name enables someone to conceive of the person. See *id.* Consider the statements: (1) John believes that Samuel Clemens wrote a book; and (2) Jill believes that Mark Twain wrote the same book. From these statements, is it true that Jill believes that Samuel Clemens wrote the book? Clearly not. Jill believes that the same person wrote the book that John believes wrote the book, but that is not the same as saying that Jill believes Samuel Clemens wrote the book. See GOTTLÖB FREGE, STANFORD ENCYCLOPEDIA OF PHILOSOPHY (Edward N. Zalta ed., 2016), <http://plato.stanford.edu/entries/frege/> [<https://perma.cc/PMT6-ABS6>] (reciting similar example). Although Samuel Clemens and Mark Twain refer to the same person (that is, they have the same reference), the two different names communicate distinct senses. The distinct senses between Samuel Clemens and Mark Twain communicate different ways for a person to think of the same person. Hence, a name carries a distinct sense, a means for conceiving of the object to which it refers. The same is true for trademarks. See Tom W. Bell, *Virtual Trade Dress: A Very Real Problem*, 56 MD. L. REV. 384, 412 n.164 (1997) (applying Frege's sense and reference dichotomy to trademark law). The trademark has both a reference, which is the source of the good to which the mark refers, and a sense, which is the way in which the mark enables the consumer to conceive of the source. Cf. Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 648–49 (2004) (“The trademark, then, is not an irreducible, indivisible *thing*, but rather a set of relations, specifically, of semiotic *relations of reference*. It is more wave than particle. Its relational nature creates a host of conceptual problems . . .”).

<sup>90</sup> See Frege, *supra* note 89, at 159–61.

camera manufacturer, the KODAK mark is better able to communicate a means for consumers to conceive of and express the manufacturer. Thus, KODAK represents the camera manufacturer's expressive choice for how consumers should conceive of the source of particular cameras. There is expression inherent in the source-identification role of a trademark, independent of the referent function.<sup>91</sup>

Thus, every mark—even marks that have no meaning independent of the mark—represents an expressive choice for how consumers should conceive of the source.<sup>92</sup> A mark does more than merely refer a consumer to a particular source; it communicates a way to conceive of the source.<sup>93</sup> That communication constitutes expression within the source-identification element of a mark.

In addition to communicating a way to conceive of the source, the source-identification element of a mark often serves to communicate meaning about the source. One such meaning is brand quality. Markholders may communicate brand quality as part of their identity.<sup>94</sup> Simply put, consumers associate quality (or lack thereof) with a mark.<sup>95</sup> Contrast the differences in quality that consumers might associate between KIA and LAMBORGHINI for automobiles, WALMART and SONY for electronics, or K-

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<sup>91</sup> KODAK is distinct from any other symbol, and its creator, George Eastman, chose it to communicate to consumers how to think of the camera manufacturer. To illustrate: Would consumers think of the camera manufacturer in the same way if its mark were AX£U135988 instead of KODAK? No. Although either KODAK or AX£U135988 could serve as a reference for the source of the cameras, Eastman chose a mark that allows consumers a straightforward method of conceiving of the camera's source. Indeed, the KODAK mark in particular demonstrates the expressive choice of its creator; Eastman specifically sought a mark that was short, that started and ended with the letter K (because K was a "strong incisive sort of letter"), and that was incapable of being misspelled "to an extent that [would] destroy its identity." Eastman stated his reasoning for using this fanciful word that he invented as his mark:

A trademark should be short [and] vigorous . . . incapable of being misspelled to an extent that will destroy its identity . . . [I]t must mean nothing . . . . The letter "K" had been a favorite with me—it seemed a strong incisive sort of letter. Therefore, the word I wanted had to start with "K." Then it became a question of trying out a great number of combinations of letters that made words starting and ending with "K." The word "Kodak" is the result . . . . It became the distinctive word for our products.

*The Story Behind . . . Kodak Trademark*, KIPLINGER MAG., Apr. 1962, at 40.

<sup>92</sup> See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995) (recognizing that trademark protection extends to symbols that are "capable of carrying meaning").

<sup>93</sup> See *supra* note 91 and accompanying text.

<sup>94</sup> See MCCARTHY, *supra* note 71, § 3:10 ("[T]he source theory has been broadened to include not only manufacturing source but also the source of standards of quality of goods bearing the mark: '[A] mark primarily functions to indicate a single quality control source of the goods or services.'" (quoting *In re Abcor Dev. Corp.*, 588 F.2d 811, 814 n.15 (C.C.P.A. 1978))).

<sup>95</sup> See *id.*



MART and TARGET for a department store. Distinct meanings that relate to the quality of goods and their source are inherent in these marks. Markholders communicate such meanings as part of their identity; the meanings develop as markholders gain a specific reputation about their quality of goods. Marks thereby represent expressions of identity to which meanings of quality (or lack thereof) may attach.<sup>96</sup> Thus, meanings that relate to the quality of goods inhere in the identification of source.

The meaning that a mark may communicate about its source is not limited to brand quality. A markholder may choose to communicate an additional meaning about the source as part of its source identification. Consider again the mark JUST DO IT. This mark reflects a choice to express the source's identity with a meaning that is already established in language. JUST DO IT conveys the meaning of accomplishing a task immediately as part of its identification of source. Nike, Inc. adopts that meaning as part of its identity. Notably, the JUST DO IT mark refers to the same source as the NIKE mark, yet each mark communicates a different meaning about that same source. The JUST DO IT mark communicates a meaning of accomplishing a task immediately, whereas the NIKE mark communicates a meaning of the Greek goddess of victory.<sup>97</sup> To the extent that consumers recognize those meanings when they observe the mark, those meanings become part of the source's identity. Through the respective marks, consumers recognize that the source is seeking to be known as those meanings. In sum, JUST DO IT expresses its source with the following meanings: a distinct way to conceive of the source; the quality of the brand; and accomplishing a task immediately. These meanings follow from Nike, Inc.'s choice of how to express itself as the source of shoes. They are part of the source-identification function of the JUST DO IT mark.

This is not to say, however, that a source cannot use a mark to express a meaning in addition to its identification. For example, the mark AN INCONVENIENT TRUTH for Al Gore's movie certainly comments on a social issue, so consumers likely perceive it to be a proposition beyond mere source identification. Perhaps Al Gore intends to communicate through this mark that people are ignoring an important truth (i.e., global warming). The mark clearly communicates a political message. Nevertheless, the political

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<sup>96</sup> See *Qualitex Co.*, 514 U.S. at 164 (“[Trademark] law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product. The law thereby encourages the production of quality products . . . . It is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word, or sign—that permits it to serve these basic purposes.” (quotation omitted)).

<sup>97</sup> See NIKE, Registration No. 0978952; *Nike*, 2 A SUPPLEMENT TO THE OXFORD ENGLISH DICTIONARY 1207 (1976) (defining *Nike* to mean the goddess of victory in Greek mythology).

meaning of AN INCONVENIENT TRUTH is also part of the identification of source. The political meaning serves to identify the source, just like any other meaning would. Hence, AN INCONVENIENT TRUTH tells consumers that the source includes the political meaning, and at the same time, it advocates that political meaning for its own sake. So although the source-identification element is distinct from the political element (or as it may be, a disparaging element), the same meaning is present in both elements.

This conclusion that an expressive element is part of the source-identification function of a mark is further evident in a fundamental doctrine of trademark law. To be eligible for trademark registration, a mark's meaning must be distinct from the meaning of the good.<sup>98</sup> Stated differently, for a mark to properly identify its source, the mark must convey a message different than the characteristics or attributes of the good.<sup>99</sup> The word FRUIT, for instance, cannot serve as the mark for apples. Simply put, trademark law requires marks to express a message distinct from the goods to which they are attached.<sup>100</sup> This fundamental doctrine implies that marks must communicate a message that expresses identity as distinct from a message that is the meaning of the good itself. Thus, the requirement of distinctiveness implies a requirement that a mark communicate a certain meaning or, in other words, that a mark be expressive.

The upshot is that the majority's premise that the source-identification element of a mark is not expressive is simply incorrect.<sup>101</sup> The fact that the disparagement element contains expression does not imply that the source-identification element does not. Source identification is entirely expressive. Source identification represents a choice regarding which content should represent the source. Source identification is tantamount to self-identification.

## 2. Content Discrimination in the Distinctiveness Criterion

This conclusion that the source-identification function of a mark represents an expressive element raises implications in speech law. The conclusion suggests constitutional concern over content-based restrictions that target the source-identification function of a mark.<sup>102</sup> That is, criteria that define trademark eligibility seem constitutionally suspect where the criteria

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<sup>98</sup> See 15 U.S.C. § 1052(e)–(f) (2012); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9–11 (2d Cir. 1976) (explaining the distinctiveness criterion for protection).

<sup>99</sup> See Bell, *supra* note 89, at 412.

<sup>100</sup> See MCCARTHY, *supra* note 71, § 11:4.

<sup>101</sup> See *In re Tam*, 808 F.3d at 1338.

<sup>102</sup> See, e.g., *Brown*, 564 U.S. at 790–91 (“[A]s a general matter, . . . government has no power to restrict expression because of its message, its ideas, its subject matter, or its content.” (quoting *Ashcroft*, 535 U.S. at 573)).

turn on the content of source-identifying elements in a mark.<sup>103</sup> In the absence of an exceptional free-speech framework, any content-based criteria that affect a source's ability to express its identity would seem unconstitutional on their face.<sup>104</sup>

The Lanham Act includes several content-based criteria for protection, including the criterion that a mark must be distinctive.<sup>105</sup> A brief explanation of the distinctiveness criterion may be helpful here: to gain trademark protection, a mark must have a meaning that is sufficiently distinct from the meaning of the good to which it is attached.<sup>106</sup> For instance, the word APPLE cannot serve as a trademark for selling apples because the meaning of APPLE is not distinct from the meaning of the good (apples).<sup>107</sup> On the other hand, APPLE can serve as a mark for computers because in that context, the meaning of APPLE is distinct from the meaning of the good (computers).<sup>108</sup> Furthermore, marks that merely describe a good are not sufficiently distinct to be eligible for trademark registration, unless a markholder can show that consumers understand the descriptive mark to be indicating source as opposed to describing the good. This understanding is called secondary meaning.<sup>109</sup> In many instances, secondary meaning can be difficult

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<sup>103</sup> See *Simon & Schuster, Inc.*, 502 U.S. at 118 (“If there is a bedrock principle underlying the First Amendment, it is that the Government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.” (quoting *Eichman*, 496 U.S. at 319)).

<sup>104</sup> See *Reed*, 135 S. Ct. at 2227 (“Government regulation of speech is content based if a law applies to particular speech because of the topic discussed or the idea or message expressed. This commonsense meaning of the phrase ‘content based’ requires a court to consider whether a regulation of speech ‘on its face’ draws distinctions based on the message a speaker conveys.” (citations omitted)); *Brown*, 564 U.S. at 790 (noting limited exceptions to prohibition of content discrimination).

<sup>105</sup> See 15 U.S.C. § 1052 (2012) (stating criteria for trademark registration).

<sup>106</sup> See *id.* § 1052(e)–(f); J. THOMAS MCCARTHY, 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:2. (4th ed. 2016).

<sup>107</sup> The apple mark for selling apples is an example of a generic term that can never receive trademark protection. See *Abercrombie*, 537 F.2d at 9 (explaining classification of generic marks).

<sup>108</sup> See *Champions Golf Club, Inc. v. The Champions Golf Club, Inc.*, 78 F.3d 1111, 1117 (6th Cir. 1996) (describing *Apple computer* as an example of an arbitrary mark that receives strong trademark protection).

<sup>109</sup> See 15 U.S.C. § 1052(f) (allowing for registration of a mark that has become distinctive through use in commerce); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211 (2000) (“[A] mark has acquired distinctiveness, even if it is not inherently distinctive, if it has developed secondary meaning, which occurs when, in the minds of the public, the primary significance of a mark is to identify the source of the product rather than the product itself.” (quotations omitted)); *Abercrombie*, 537 F.2d at 9–10 (explaining the requirement of secondary meaning for descriptive marks).

to show.<sup>110</sup> The relevant point, though, is that to determine the distinctiveness of a mark, and thereby its eligibility for trademark protection, the PTO must examine a mark's content as that content relates to the particular good to which it is attached. The criterion of distinctiveness thereby directly affects the source-identifying function of a mark, which as discussed above, constitutes an expressive element of a mark.

Consider a simple example that illustrates the content-based discrimination that the distinctiveness criterion imposes on the self-identification element of speech. In *In re Major League Umpires*, three major league umpires chose the term MAJOR LEAGUE UMPIRE as a mark for sports clothing and equipment.<sup>111</sup> The PTO denied trademark registration for the mark on the grounds that it lacked distinctiveness: the mark described who the providers of the goods were, which was held to be descriptive of the good, insufficiently distinct for trademark registration.<sup>112</sup> Hence, the umpires' choice to express their occupation as an identification of source resulted in their ineligibility for the benefits of trademark registration.<sup>113</sup> To gain those benefits, the umpires needed to identify themselves differently. The case thus illustrates that the distinctiveness criterion enables government to influence the content of the expressive element of source identification.<sup>114</sup>

Another mark that illustrates the content-based restriction of the distinctiveness criterion is THE SLANTS.<sup>115</sup> Recall that Mr. Tam chose THE SLANTS as the mark for his rock band in order to describe the fact that its members were of Asian heritage.<sup>116</sup> The mark arguably describes the rock

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<sup>110</sup> See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 775 (1992) (recognizing the difficulty of establishing secondary meaning for a small business starting a new product in a limited area).

<sup>111</sup> See *In re Major League Umpires*, 60 U.S.P.Q.2d 1059, 2001 WL 777067 (T.T.A.B. 2001).

<sup>112</sup> *Id.* at 1061. The Trademark Trial and Appeal Board noted in its decision that the umpires had procedurally waived any claim to secondary meaning. See *id.*

<sup>113</sup> See *id.* at 1062.

<sup>114</sup> Interestingly, the Lanham Act denies trademark protection to surnames even where, as in most instances, there is no relationship between the meaning of a surname and the good. See 15 U.S.C. § 1052(e) (denying protection for marks that are "primarily merely a surname"). For instance, the meaning of *Ford* has nothing to do with automobiles, except as an indicator of source. Therefore, the justification for the content-based exclusion of surnames cannot be to promote consumer recognition of source. See *Peaceable Planet, Inc. v. Ty, Inc.*, 362 F.3d 986, 988–89 (7th Cir. 2004) (recognizing that the reason for not extending protection to surnames is not because of problems with distinctiveness).

<sup>115</sup> See *In re Tam*, 808 F.3d at 1373 (Dyk, J., concurring) (considering reason for trademark applicant's use of the term *The Slants*).

<sup>116</sup> See *id.* (quoting Mr. Tam as saying, "We want to take on these stereotypes that people have about us, like the slanted eyes, and own them. We're very proud of being Asian—we're not going to hide that fact").

band in the same way that MAJOR LEAGUE UMPIRE described the sellers of the sports clothing and equipment discussed in the paragraph above.<sup>117</sup> It would seem, then, that the PTO could possibly have denied trademark registration to Mr. Tam on the grounds that THE SLANTS lacks distinctiveness, independent of its apparent disparaging opinion.<sup>118</sup> In that hypothetical scenario, the distinctiveness criterion would target Mr. Tam's expressive choice to identify his band as THE SLANTS.<sup>119</sup> The PTO would have denied him his expressive choice to use a mark that indicated his Asian heritage as his identification of source.

Of course, that scenario is only hypothetical, but it illustrates an important point. If the PTO had denied trademark registration on the grounds that THE SLANTS lacks distinctiveness (rather than on disparagement grounds), would Mr. Tam nevertheless be entitled to trademark registration because, in the words of Judge Dyk, THE SLANTS has an "indisputably expressive character"?<sup>120</sup> Would the First Amendment compel trademark registration because the source-identifying element is highly expressive? Clearly not.<sup>121</sup> Otherwise the distinctiveness criterion would be unconstitutional, which simply cannot be true. The distinctiveness criterion is so well established and engrained in American jurisprudence that its constitutionality appears indisputable.<sup>122</sup> Indeed, without the distinctiveness criterion, consumers would face difficulties in recognizing brands, and markholders could monopolize crucial words for an industry.<sup>123</sup> Without the content-based criterion of distinctiveness, trademark law would lead to great inefficiencies in the commercial marketplace.<sup>124</sup> It is thus axiomatic that the requirement

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<sup>117</sup> Compare *id.* (describing that THE SLANTS was a mere descriptor for the band members), with *In re Major League Umpires*, 60 U.S.P.Q.2d at 1060–62 (noting that MAJOR LEAGUE UMPIRE describes the provider of the goods or services and is also merely descriptive of those goods and services).

<sup>118</sup> This possibility is based on the assumption that Mr. Tam could not have shown secondary meaning. See 15 U.S.C. § 1052 (e)–(f) (2012).

<sup>119</sup> See *In re Tam*, 808 F.3d at 1373 (Dyk, J., concurring) ("Mr. Tam's choice of mark reflects a clear desire to editorialize on cultural and political subjects. Mr. Tam chose THE SLANTS at least in part to reclaim the negative racial stereotype it embodies . . .").

<sup>120</sup> See *id.*

<sup>121</sup> In addition to calling into question the distinctiveness criterion, the majority's reasoning calls into question a well-established provision of the Lanham Act that precludes registration of government symbols. See 15 U.S.C. § 1052(b). This government-symbol criterion represents an ostensible content-based criterion that targets core protected speech. See *Texas v. Johnson*, 491 U.S. 397, 417–20 (1989) (recognizing destruction of the flag as protected political speech).

<sup>122</sup> See, e.g., *Wal-Mart Stores, Inc.*, 529 U.S. at 211 (recognizing distinctiveness requirement); *Qualitex Co.*, 514 U.S. at 162 (same); *Two Pesos, Inc.*, 505 U.S. at 769 (same).

<sup>123</sup> See MCCARTHY, *supra* note 106, § 12:2

<sup>124</sup> See *id.*

for distinctiveness is constitutional. A refusal to register THE SLANTS based on failure of distinctiveness could not violate the First Amendment.

The only way, though, that the distinctiveness criterion could be constitutional is if it is analyzed under one of the exceptional free-speech frameworks discussed above.<sup>125</sup> That is, only if trademark registration were evaluated within the framework of commercial speech, government subsidy, or limited-public forum could the content-based restriction requiring distinctiveness be constitutional.<sup>126</sup> Because the distinctiveness criterion must be constitutional, one of these frameworks must apply. The fact that the distinctiveness criterion targets an expressive element of a mark (source identification) cannot preclude its analysis under one of these exceptional frameworks. The distinctiveness criterion targets the expressive element of source identification, yet that criterion must still be analyzed under one of the exceptional frameworks.<sup>127</sup>

This conclusion is relevant to the anti-disparagement criterion. Recall that the majority refused to analyze the anti-disparagement criterion under any of the exceptional frameworks for the reason that the criterion targeted an expressive element of a mark (i.e., disparagement).<sup>128</sup> That reason is incon-

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<sup>125</sup> See *supra* notes 34–38 and accompanying text (reciting high standard of strict scrutiny). One might argue that an exceptional framework is not necessary to find the distinctiveness criterion constitutional because that criterion could satisfy the demanding standards of strict scrutiny. This argument is not likely to succeed. As stated above, strict scrutiny requires that the content-based restriction be narrowly tailored in order to serve a compelling government interest. See *Reed*, 135 S. Ct. at 2226. Here, the government interest underlying the distinctiveness criterion does not seem compelling. The interest is to promote marketplace efficiency. See *supra* notes 122–124 and accompanying text (discussing purpose of trademark law with respect to a mark's function of distinguishing between goods). Perhaps on its face, efficiency in the marketplace does seem important. Yet the efficiency that results from the distinctiveness criterion appears only marginally greater, if at all greater, than the efficiency that results from the common-law torts of passing off or unfair competition. In other words, market efficiency that follows from consumers accurately identifying goods and services would exist without the distinctiveness criterion in trademark law; some degree of efficiency would exist under those common-law torts, neither of which requires distinctiveness. See generally RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 1–4 (AM. LAW INST. 1993) (omitting a distinctiveness criterion for passing off or unfair competition). So for instance, if a manufacturer copied the name of its competitor, the manufacturer would be liable under the common-law tort of passing off. See *id.* § 4. The tort of passing off alleviates consumer confusion without requiring a distinctive mark. See *id.* As a result, the government interest for requiring marks to be distinctive, in view of the doctrines of unfair competition and passing off, does not seem compelling.

<sup>126</sup> See *supra* notes 70–128 and accompanying text (setting forth arguments for applying one of three exceptional free-speech frameworks in the analysis of the anti-disparagement criterion of trademark).

<sup>127</sup> See *supra* notes 70–121 and accompanying text (concluding that the source-identification function of a mark involves an expressive element of the mark and that the distinctiveness criterion targets that expressive element).

<sup>128</sup> *In re Tam*, 808 F.3d at 1338.

sistent with analyzing the distinctiveness criterion under an exceptional free-speech framework because, as discussed above, the distinctiveness criterion also targets an expressive element. The fact that the anti-disparagement criterion targets an expressive element of a mark should not preclude that criterion from being analyzed under an exceptional free-speech framework.

Thus, the majority was simply incorrect to hold that expressive elements of a mark should not be evaluated under any of the exceptional free-speech frameworks. Although the majority is correct that the anti-disparagement criterion targets an expressive element (disparagement), the distinctiveness criterion also targets an expressive element (self-identification).<sup>129</sup> Indeed, as between the disparaging expression and self-identification expression, the latter seems worthier of speech protection than does the former.<sup>130</sup> That is, the speech value of self-identification expression appears much greater than the speech value of disparaging expression: self-identification reflects a constitutional theme of defining one's own identity, whereas disparagement seems akin to hate speech.<sup>131</sup> So as between self-identifying speech and disparaging speech, the former suggests greater speech value, and thereby a greater need for protection from government interference. Hence, if the self-identification element of a mark must be subject to one of the exceptional frameworks that extends less protection for speech, certainly the disparagement element would also be subject to that less speech-protective framework.

To be clear, this Article does not argue that the expressive nature of the source-identification element implies that the anti-disparagement criterion does not violate the First Amendment. Instead, this Article observes that the same framework that applies in evaluating the distinctiveness criterion should apply to the anti-disparagement criterion.<sup>132</sup> The fact that the anti-

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<sup>129</sup> See *supra* notes 102–121 and accompanying text.

<sup>130</sup> Cf. *In re Tam*, 808 F.3d at 1367 (Dyk, J., concurring and dissenting) (“[N]either counsel at oral argument nor the majority in its opinion has identified any First Amendment value served by disparaging speech in the commercial context.”).

<sup>131</sup> According to Federal Circuit precedent, “a mark may disparage when it dishonors by comparison with what is inferior, slights, deprecates, degrades, or affects or injures by unjust comparison.” *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014) (quotations omitted). Hate speech refers to “speech attacks based on race, ethnicity, religion, and sexual orientation or preference.” RODNEY A. SMOLLA, I SMOLLA & NIMMER ON FREEDOM OF SPEECH § 12:2 (2016).

<sup>132</sup> One might argue that the two criteria are so distinct in kind and in goal that an exceptional framework should apply to one but not the other. This argument, however, stems from the fact that one criterion targets content that is distinct from the content that the other criterion targets. The constitutionality of that distinction in content plays out in the free-speech analysis of the governing framework. Specifically, if the targeted content indicates that a criterion is outside the purpose of trademark, then that criterion would fail an analysis under the applicable framework. Hence, the analyses of the two criteria—under the exceptional framework that governs both criteria—will demonstrate whether either criterion is unconstitutional. The point is that the same framework

disparagement criterion must be evaluated under an exceptional framework does not imply that that criterion is constitutional. An analysis under that framework is still necessary, which follows in Part II.<sup>133</sup>

### C. *Strict Scrutiny and Content Restrictions in Trademark*

Section B has concluded that the anti-disparagement criterion must be analyzed under one of the three exceptional free-speech frameworks: government subsidy, limited public forum, or commercial speech.<sup>134</sup> Traditionally, these frameworks do not employ a strict-scrutiny standard for reviewing content discrimination, and that fact has enabled government to exercise limited content discrimination under any of these frameworks.<sup>135</sup> The standard of review for the commercial-speech framework, however, has in recent years seemed to shift away from this less stringent standard.<sup>136</sup> In 2011, the Supreme Court decided its most recent commercial-speech case, *Sorrell v. IMS Health, Inc.* There the Court indicated that content-based restrictions of commercial speech must be analyzed under “heightened judicial scrutiny.”<sup>137</sup> It is thought that this “heightened judicial scrutiny” amounts to the more demanding standard of strict scrutiny, which would require the government to demonstrate a compelling, rather than a mere substantial, interest to justify its

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governs both criteria—as disparate as the criteria may seem—because they both target expressive content.

<sup>133</sup> See *infra* notes 214–257 and accompanying text.

<sup>134</sup> See *supra* notes 61–131 and accompanying text.

<sup>135</sup> Compare *Reed*, 135 S. Ct. at 2226–28 (applying strict scrutiny to content-based regulation, and emphasizing that “[c]ontent-based laws—those that target speech based on its communicative content—are presumptively unconstitutional and may be justified only if the government proves that they are narrowly tailored to serve *compelling* state interests”) (emphasis added), with *Rosenberger*, 515 U.S. at 829 (“The necessities of confining a forum to the limited and legitimate purposes for which it was created may justify the State in reserving it for certain groups or for the discussion of certain topics.”), *Regan v. Taxation with Representation of Wash.*, 461 U.S. 540, 549 (1983) (“We have held in several contexts that a legislature’s decision not to subsidize the exercise of a fundamental right does not infringe the right, and thus is not subject to strict scrutiny.”), and *Cent. Hudson*, 447 U.S. at 564 (“The State must assert a *substantial* interest to be achieved by restrictions on *commercial* speech.” (emphasis added)).

<sup>136</sup> See *Sorrell v. IMS Health, Inc.*, 564 U.S. 552, 557 (2011) (subjecting commercial speech to “heightened judicial scrutiny”).

<sup>137</sup> *Id.* The *Sorrell* Court struck down a Vermont statute that restricted the sale, disclosure, and use of pharmacy records relating to individual doctors’ prescribing practices. *Id.*



content-based restriction.<sup>138</sup> *Sorrell* thus seems to erase the less stringent standard that the Court has usually accorded commercial speech.<sup>139</sup>

In view of *Sorrell*, the *Tam* majority applied a strict-scrutiny standard in its evaluation of the anti-disparagement criterion, disregarding the argument that because marks are commercial speech, strict scrutiny should not apply.<sup>140</sup> The majority reasoned:

“Commercial speech is no exception” to the need for heightened scrutiny of content-based impositions seeking to curtail the communication of particular information or messages. *Sorrell*, 131 S. Ct. at 2664. . . . Strict scrutiny must apply to a government regulation that is directed at the expressive component of speech. That the speech is used in commerce or has a commercial component should not change the inquiry when the government regulation is entirely directed to the expressive component of the speech.<sup>141</sup>

The majority thus relied on *Sorrell* to apply strict scrutiny, reasoning that strict scrutiny is appropriate because the anti-disparagement criterion targets an expressive element.<sup>142</sup>

This application of *Sorrell* to the trademark context cannot be correct. Interpreting *Sorrell* as imposing strict scrutiny for government regulation that targets an expressive element of a mark would call into question all content-based restrictions that trademark law imposes on speech.<sup>143</sup> At its core, trademarks function through content discrimination. Trademark law precludes speakers from repeating the specific content that a markholder has registered.<sup>144</sup> That is to say, by definition, a trademark monopoly means that the government is prohibiting private speakers from expressing content

<sup>138</sup> See, e.g., Rodney A. Smolla, *Off-Label Drug Advertising and the First Amendment*, 50 WAKE FOREST L. REV. 81, 99 (2015) (“In *Sorrell*, the Court seemed sorely tempted to apply the full measure of strict scrutiny traditionally triggered by laws that engage in content-based and viewpoint-based discrimination.”).

<sup>139</sup> *Reed*, 135 S. Ct. at 2235 (Breyer, J., concurring) (citing to *Sorrell* for the proposition that “the Court has applied the heightened ‘strict scrutiny’ standard even in cases where the less stringent ‘commercial speech’ standard was appropriate”).

<sup>140</sup> See *In re Tam*, 808 F.3d at 1338 (relying on *Sorrell* for its application of the heightened standard of strict scrutiny).

<sup>141</sup> *Id.* (quoting *Sorrell*, 564 U.S. at 566).

<sup>142</sup> See *id.*

<sup>143</sup> See Tushnet, *supra* note 1, at \*22 (“[I]f subjected to strict or even intermediate scrutiny, other parts of the registration system would also perform as poorly as disparagement.”).

<sup>144</sup> See Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 193–94 (noting trademark restrictions on second speakers); Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 219 (1998) (recognizing commercial speech of potential infringers of mark that trademark law restricts).

that identifies themselves.<sup>145</sup> Recall that self-identification reflects an important speech value.<sup>146</sup> Hence, trademark law restricts speakers from expressing their own identification on the basis that a markholder has already spoken that identification.<sup>147</sup> An infringer, then, is merely a second speaker of content, and trademark law functions by restricting the content of that second speaker.

A simple example illustrates the point. Consider the trademark on BEN CARSON FOR PRESIDENT 2016.<sup>148</sup> Suppose that a certain supporter of Ben Carson is not the markholder, but would like to sell yard signs that express support for him by using that message. Trademark law restricts this.<sup>149</sup> As a second speaker of a registered trademark, the supporter faces injunctive and monetary penalties that preclude expressing support of Ben Carson through the use of that mark.<sup>150</sup>

What justifies trademark's content-based restrictions of second speakers? The fact that the speech came second in time makes no difference under the First Amendment. As a general principle, second speakers enjoy as much constitutional right to articulate expression as do first speakers.<sup>151</sup> If someone yells "Hillary for President!" on Monday, his or her neighbor has as much right to yell it on Tuesday. Hence, without some sort of exception to the doctrine against content discrimination, a law that penalizes speakers

<sup>145</sup> See Denicola, *supra* note 144, at 193–94; Lemley & Volokh, *supra* note 144, at 219.

<sup>146</sup> See *supra* notes 74–86 and accompanying text.

<sup>147</sup> Cf. Alex Kozinski, Judge, United States Court of Appeals for the Ninth Circuit, Boal Memorial Lecture: Trademarks Unplugged (Sept. 16, 1993), in 68 N.Y.U. L. REV. 960, 972–73 (1993) (“[T]rademarks play a significant role in our public discourse. They often provide some of our most vivid metaphors, as well as the most compelling imagery in political campaigns. Some ideas—‘it’s the Rolls Royce of its class,’ for example—are difficult to express any other way . . . . Where trademarks come to carry so much communicative freight, allowing the trademark holder to restrict their use implicates our collective interest in free and open communication.”).

<sup>148</sup> BEN CARSON FOR PRESIDENT 2016, Registration No. 4890768.

<sup>149</sup> See 15 U.S.C. § 1114 (2012) (imposing civil liability for using a mark in commerce in a way that would cause confusion).

<sup>150</sup> See *id.* §§ 1116–1117 (setting forth injunctive and monetary relief for trademark violation).

<sup>151</sup> The equal protection of speech that occurs either first or second in time is apparent in the prior-restraint doctrine of the First Amendment. Supreme Court jurisprudence places a constitutionally “heavy presumption” against any sort of prior restraint. See *Org. for a Better Austin v. Keefe*, 402 U.S. 415, 419 (1971). Prior restraints often arise as a result of speech that has already occurred. The party seeking to silence a speaker does not want the speech content repeated. See, e.g., *id.* at 417 (reciting facts regarding group’s initial distribution of pamphlets critical of commercial enterprise and subsequent injunction entered to silence continued distribution).

for expressing certain content because someone else had already expressed it seems unconstitutional on its face.<sup>152</sup>

Of course, government's restriction of second-speaker speech through trademark law is not unconstitutional. The presence of that fundamental restriction for more than two centuries is sufficient to infer its constitutionality.<sup>153</sup> Trademark's restriction of second-speaker speech must pass whatever free-speech test that it is subject to.<sup>154</sup> Nevertheless, that fundamental restriction cannot pass a strict-scrutiny analysis.<sup>155</sup> Strict scrutiny requires that a content-based restriction be narrowly tailored to serve a compelling government interest.<sup>156</sup> It is highly unlikely that the promotion of efficiency in the commercial marketplace would rise to the level of a compelling government interest.<sup>157</sup> Efficiency might amount to a substantial government interest but certainly not compelling.

Trademark's restriction on second speakers must therefore be analyzed within an exceptional free-speech framework—one that recognizes a less-exacting standard than strict scrutiny. Tellingly, the restriction could not be justified under either the subsidy or public-forum frameworks: those frameworks apply only in the context of government bestowing benefits that influence speakers' choice of content *ex-ante*, whereas trademark's second-speaker restrictions impose penalties *ex-post*.<sup>158</sup> The only exceptional free-

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<sup>152</sup> Cf. *Eldred v. Ashcroft*, 537 U.S. 186, 218–19 (2003) (explaining the constitutional exception for copyright law, which restricts second-speaker speech, such that strict scrutiny does not apply in examining provisions of the Copyright Act).

<sup>153</sup> In England, the first reported trademark case arose in 1742. *Blanchard v. Hill*, (1742) 26 Eng. Rep. 692; 2 Atk. 484, 485 (Ch.); see FRANK I. SCHECHTER, *THE HISTORICAL FOUNDATIONS OF THE LAW RELATING TO TRADE-MARKS* 122–45 (1925) (reciting the genesis of modern trademark law); Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1852–55 (2007) (outlining the history of trademark law).

<sup>154</sup> But see *In re Tam*, 808 F.3d at 1374 (Lourie, J., dissenting) (observing that the PTO has denied trademark registration based on the offensiveness of a mark's content for more than a century and this fact did not stop the majority from striking down the anti-disparagement criterion).

<sup>155</sup> Cf. Tushnet, *supra* note 1, at \*32 (“Overall, it seems unlikely that any but functionality and the specifically deception-related provisions of § 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>156</sup> See *Reed*, 135 S. Ct. at 2226–27 (explaining the strict scrutiny test as requiring the government to prove that the content-based restriction is “narrowly tailored to serve compelling state interests”).

<sup>157</sup> See generally Daniel A. Farber, *The Categorical Approach to Protecting Speech in American Constitutional Law*, 84 IND. L.J. 917, 919 (2009) (noting that a compelling government interest “must be exceptionally strong and very clearly implicated before it can outweigh the speech interest” and contrasting the compelling government interest to economic regulations).

<sup>158</sup> See *Martinez*, 561 U.S. at 682–83 (describing how limited-public forum affects speech by providing a subsidy for content yet to be expressed rather than a penalty for past speech); *Finley*, 524 U.S. at 589 (describing the government subsidy effect on speaker's choice of content).

speech framework that could apply to the second-speaker restriction is the commercial-speech framework, but only if that framework applies as originally articulated, without imposing strict scrutiny.<sup>159</sup> For the trademark context, as distinct from the medical-records context in *Sorrell*, the commercial-speech framework must apply intermediate scrutiny to analyze the content-based restriction, requiring merely a substantial government interest.<sup>160</sup>

Perhaps one might argue that the less speech-protective standard of review that applies in the context of restricting second speakers should not necessarily be imputed to the framework that applies to the anti-disparagement criterion. After all, prohibiting potential infringers from copying another's mark hardly seems the same as denying someone a trademark because it is disparaging. Punishing a second speaker is very different from denying a benefit to a first speaker. The difference, however, favors the argument that the less speech-protective standard should apply in evaluating the anti-disparagement criterion. Compare the consequences of violating the content-based restrictions: if second speakers repeat another's mark, government imposes a penalty for their speech content through an injunction and damages, whereas if first speakers choose certain content as their mark, government refrains from giving them a benefit in the form of trademark rights.<sup>161</sup> Despite the fact that second speakers face harsher consequences for speaking content, a *less* speech-protective standard governs (i.e., not strict scrutiny).<sup>162</sup> So if a less speech-protective standard applies in the situation where speakers are facing harsh consequences, the argument is stronger to apply that same less-speech-protective standard in the situation where speakers face mild consequences.<sup>163</sup> Put simply, if intermediate scrutiny applies where penalties for speech are at stake, then certainly intermediate scrutiny would apply where mere incentives for speech are at stake.

Thus, any examination of whether the anti-disparagement criterion violates free speech must occur within one of the exceptional free-speech frameworks. That framework must not apply a strict-scrutiny standard.

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<sup>159</sup> See *Cent. Hudson*, 447 U.S. at 564–66.

<sup>160</sup> See *id.* at 564 (“The State must assert a substantial interest to be achieved by restrictions on commercial speech.”).

<sup>161</sup> Compare 15 U.S.C. § 1114 (2012) (setting forth injunctive and monetary relief for infringement), with *id.* § 1052 (setting forth conditions for rejecting trademark registration).

<sup>162</sup> See Denicola, *supra* note 144, at 193–94 (observing that trademark's restrictions of second speakers are analyzed under the commercial-speech framework).

<sup>163</sup> Cf. *Martinez*, 561 U.S. at 683 (“Application of the less restrictive limited-public-forum analysis better accounts for the fact that [the state actor], through its [student organization] program, is dangling the carrot of subsidy, not wielding the stick of prohibition.”).

## II. DISPARAGEMENT AND THE PURPOSE OF TRADEMARK LAW

Given that the anti-disparagement criterion should be analyzed under one of the free-speech exceptional frameworks, the issue of substance becomes whether the anti-disparagement criterion supports the purpose of trademark law. Under any of the three frameworks, this inquiry is crucial to determining whether the criterion is constitutional. In the subsidy framework, government can employ content-based criteria only if the criteria support the purpose of the subsidy program.<sup>164</sup> In the limited-public-forum framework, government can employ content-based criteria for use of the forum only if the criteria support the purpose of the forum.<sup>165</sup> Thus, under the frameworks of government subsidies or limited-public forums, the central question is whether the disparagement criterion supports the purpose of trademark law. Under the commercial-speech framework, the speech analysis raises a similar question. The government can employ content-based restrictions on commercial speech only if the government acts because of a purpose or interest that is substantial and through means that are substantially related to that purpose.<sup>166</sup> Hence, the relevant question in the commercial-speech framework is whether the anti-disparagement criterion is substantially related to the purpose of trademark. Therefore, in any of the three frameworks, the dispositive inquiry is whether the disparagement criterion supports, or directly relates to, the purpose of trademark law.

In order to analyze whether the anti-disparagement criterion supports the purpose of trademark law, it is necessary to understand the scope of the purpose. If the scope of trademark's purpose is narrow, the anti-disparagement criterion is less likely to support it, whereas if the scope of the purpose is broad, the criterion is more likely to support it. Thus, defining the purpose of trademark law is crucial to resolving whether the anti-disparagement cri-

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<sup>164</sup> See *Agency for Int'l Dev. v. All. for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2328 (2013) (“[T]he relevant distinction that has emerged from our cases is between conditions that define the limits of the government spending program—those that specify the activities Congress wants to subsidize—and conditions that seek to leverage funding to regulate speech outside the contours of the program itself.”).

<sup>165</sup> See *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995) (“The necessities of confining a forum to the limited and legitimate purposes for which it was created may justify the State in reserving it for certain groups or for the discussion of certain topics.”).

<sup>166</sup> See *Milavetz, Gallop & Milavetz, P.A. v. United States*, 559 U.S. 229, 249 (2010) (interpreting intermediate scrutiny in commercial-speech context to mean that the content-based restriction “must directly advance a substantial governmental interest and be no more extensive than is necessary to serve that interest” (quotation omitted)); *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 564–66 (1980) (requiring government restriction of commercial speech to directly advance the state interest involved).

terion is constitutional.<sup>167</sup> The inquiry into whether the anti-disparagement criterion supports the purpose of trademark law must first examine what that purpose is.<sup>168</sup> Hence, the two sections below examine the purposes of trademark law and whether the anti-disparagement criterion supports those purposes.<sup>169</sup>

### A. Information Quality and Marketplace Efficiency

Improving the quality of information in the marketplace is often cited as a reason for trademark law. More precisely, improving the quality of information for consumers is a reason for trademark's provision of exclusive rights and for trademark's bar against deceptive marks.<sup>170</sup> Exclusivity en-

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<sup>167</sup> None of the opinions in the Federal Circuit's *Tam* decision give much thought to the scope of the purpose of trademark law. The majority opinion states that "[t]he purpose of the Lanham Act is to . . . prevent customer confusion, and protect the goodwill of markholders." *In re Tam*, 808 F.3d 1321, 1354 (Fed. Cir. 2015), *cert. granted*, 2016 WL 1587871 (U.S. Sept. 29, 2016) (No. 15-1293). Although trademark law does serve these purposes, the majority failed to consider whether other purposes are present in trademark law. *See id.* Similarly, the majority did not consider whether a broader purpose that encompasses these two specific purposes might underlie the Lanham Act. *See id.* The dissent of Judge Reyna provides an example of such a broader purpose, i.e., "to promote the orderly flow of commerce." *Id.* at 1378 (Reyna, J., dissenting). Like the majority, however, Judge Reyna does not provide analysis to support this conclusion. *See id.* Neither the majority nor Judge Reyna provide support for their respective definitions of trademark's purpose. Purpose, as indicated above, is the linchpin of the constitutional issue.

<sup>168</sup> Statements of purpose in the Lanham Act are not much help in defining the purpose of that Act. The Act claims a seemingly broad purpose in its statement: "The intent of this chapter is to regulate commerce within the control of Congress." 15 U.S.C. § 1127 (2012). Yet "to regulate commerce" is merely a re-statement of Congress's power under the Commerce Clause, which means that the Lanham Act defines its purpose as exercising its power. It makes no sense to say that the purpose of exercising a power is to exercise a power. Indeed, such a purposeless power suggests that its arbitrary and capricious exercise would be permissible. This cannot be, for as a constitutional matter, there are some purposes for which Congress cannot exercise its power. Congress may not exercise its power to circumvent constitutional rights of its citizens. *See Agency for Int'l Dev.*, 133 S. Ct. at 2328 ("Government may not deny a benefit to a person on a basis that infringes his constitutionally protected freedom of speech even if he has no entitlement to that benefit." (quoting *Rumsfeld v. Forum for Acad. & Inst. Rights*, 547 U.S. 47, 59 (2006))); *Elrod v. Burns*, 427 U.S. 347, 361 (1976) ("The denial of a public benefit may not be used by the government for the purpose of creating an incentive enabling it to achieve what it may not command directly."). Hence, the Lanham Act's purported purpose does not assist in understanding its actual purpose.

<sup>169</sup> *See infra* notes 170–215 and accompanying text.

<sup>170</sup> *See Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 147 (2d Cir. 2003) ("The purpose for which trademark law accords merchants the exclusive right to the use of a name or symbol in their area or commerce is *identification*, so that the merchants can establish goodwill for their goods based on past satisfactory performance, and the consuming public can rely on a mark as a guarantee that the goods or services so marked come from the merchant who has been found to be satisfactory in the past."); McKenna, *supra* note 153, at 1844 ("It would be difficult to overstate the level of consensus among commentators that the goal of trademark law is—and always has

tures that only one mark is present in any given area of commerce, which in turn prevents consumer confusion, enabling consumers to easily identify the producer of a good.<sup>171</sup> The bar against deception reduces the likelihood that consumers will rely on inaccurate information in deciding to purchase a good.<sup>172</sup> Thus, trademark's exclusivity and its bar against deception yield better quality information for consumers.

This purpose of better information for consumers, however, is not the sole purpose of trademark law. Trademark law does not promote better information for the sake of better information.<sup>173</sup> Given that Congress's

been—to improve the quality of information in the marketplace and thereby reduce consumer search costs.”).

<sup>171</sup> See MCCARTHY, *supra* note 71, § 2:2 (observing that trademark “serves to protect . . . consumers from deception and confusion”).

<sup>172</sup> See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 782 n.15 (1992) (Stevens, J., concurring) (quoting a Senate report articulating that one of the purposes of trademark is “protect[ing] the public so it may be confident that, in purchasing a product bearing a particular trademark which it favorably knows, it will get the product which it asks for and wants to get”); McKenna, *supra* note 153, at 1844 (“By preserving the integrity of these symbols, trademark law benefits consumers . . . by protecting them from being deceived into buying products they do not want . . .”).

<sup>173</sup> If the sole end of trademark were better information, then knowledge would be the focus of trademark. Knowledge, however, is the focus of copyright, not trademark. Compare U.S. CONST. art. I, § 8, cl. 8 (stating the copyright power as a power “[t]o promote the Progress of Science and useful Arts”), with *id.* cl. 3 (stating the commerce power as a power “[t]o regulate Commerce”); see also *Golan v. Holder*, 132 S. Ct. 873, 888 (2012) (“The ‘Progress of Science,’ petitioners acknowledge, refers broadly to the creation and spread of knowledge and learning.” (quotation omitted)).

The constitutional distinction between trademark and copyright was set forth in 1879 in *In re Trade-Mark Cases*, in which the Supreme Court declared that, if Congress possessed any power to regulate trademark, that power must arise under the Commerce Clause. 100 U.S. 82, 94 (1879) (striking down the original 1870 Trademark Act as insufficiently tied to interstate or foreign commerce). The Court contrasted trademark with the copyright power arising under the Intellectual Property Clause. Despite this constitutional distinction, the *Tam* majority appeared greatly uncomfortable with any implication its holding might create in copyright law. See 808 F.3d at 1354. The majority explained its discomfort as follows:

In many ways, trademark registration resembles copyright registration. Under the logic of the government’s approach, it follows that the government could refuse to register copyrights without the oversight of the First Amendment . . . This idea—that the government can control speech by denying the benefits of copyright registration to disfavored speech—is anathema to the First Amendment.

*Id.* If the government could withhold trademark based on content, the government could withhold copyright based on content, and that latter outcome, the majority concluded, “is anathema to the First Amendment.” *Id.*

The majority’s logic is flawed. The Constitution requires Congress to legislate trademark consistent with the Commerce Clause, not the Copyright Clause. Congress’s power under the Commerce Clause is distinct from its power under the Copyright Clause. Compare U.S. CONST. art. I, § 8, cl. 8., with *id.* cl. 3. The constitutional rules that govern trademark do not imply the same set of rules for

trademark power arises under the Commerce Clause, trademark must promote better information for reasons relating to commerce.<sup>174</sup> Enabling better information is therefore a mere means for a broader commercial purpose: marketplace efficiency.<sup>175</sup> Specifically, better information for consumers fosters a reputation for producers.<sup>176</sup> Producers gain a reputation for the quality of their goods because trademark enables consumers to identify and distinguish producers and their goods.<sup>177</sup> This fosters investment in quality goods by producers.<sup>178</sup> Moreover, better information lowers search costs for consumers to identify the producer of a good and to identify actual attributes of the good itself.<sup>179</sup> Lower search costs facilitate commercial transac-

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copyright. Hence, the fact that content discrimination is permissible in trademark does not imply as a constitutional matter that content discrimination is permissible in copyright.

On the merits of the majority's argument, authority suggests that Congress could indeed exercise content-based discrimination under the Copyright Clause. Tellingly, the majority provides no basis for its assertion that content discrimination in copyright law is "anathema to the First Amendment." *Id.* at 1354. Indeed, the majority's attempt to foreclose content discrimination in trademark does not detract from the authority suggesting the constitutionality of content discrimination in copyright. In particular, the language of the Copyright Clause itself suggests a power of content discrimination: the Copyright Clause grants Congress the power "[t]o promote the Progress of Science" through implementing a copyright system. U.S. CONST. art. I, § 8, cl. 8. A power to promote progress in science suggests a power to determine which content to copyright—that which promotes progress. That discussion, however, is for another day. *See* Ned Snow, *Discrimination in the Copyright Clause*, 67 ALA. L. REV. 583, 585–633 (2016) (arguing that the Copyright Clause gives Congress a power to discriminate in extending copyright based on content); Snow, *supra* note 44, at 1523 (arguing that content-based copyright denial does not violate the First Amendment); Tushnet, *supra* note 1, at \*41 ("[T]he government could indeed withdraw or refuse to grant copyright protection to categories of works without violating the First Amendment."). And that is the important point here. The discussion of content discrimination under the Copyright Clause has no bearing on the discussion of whether Congress may exercise content discrimination under the Commerce Clause. Nor does the answer to the Commerce Clause question imply that Congress does or does not have the same authority under the Copyright Clause. They are two separate clauses with two separate analyses.

<sup>174</sup> *See Trade-Mark Cases*, 100 U.S. at 92–94.

<sup>175</sup> *See* William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, 78 TRADEMARK REP. 267, 267 (1988) ("The overall conclusion is that trademark law . . . can best be explained on the hypothesis that the law is trying to promote economic efficiency.").

<sup>176</sup> *See* MCCARTHY, *supra* note 71, § 2.4.

<sup>177</sup> *See id.*

<sup>178</sup> *See* *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995) ("[Trademark] law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product.").

<sup>179</sup> *Id.* at 163–64. ("In principle, trademark law, by preventing others from copying a source-identifying mark, reduces the customer's costs of shopping and making purchasing decisions, for it quickly and easily assures a potential customer that this item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past." (quotation omitted)).



tions. Thus, better information for consumers serves the broader purpose of marketplace efficiency.<sup>180</sup>

Given the purpose of marketplace efficiency, the question becomes whether the anti-disparagement criterion supports this purpose. At first glance, it would seem not. As the majority notes, “the disparagement prescription has never been alleged to prevent consumer confusion or deception.”<sup>181</sup> Furthermore, disparaging marks do not prevent a producer from gaining a reputation and indeed such marks may foster a specific sort of reputation. Hence, at first glance, the anti-disparagement criterion does not seem to promote better information nor does it seem to promote market efficiency.<sup>182</sup>

On reflection, however, disparaging marks do appear to disrupt commercial transactions. Judge Reyna argued in dissent: “Commercial speech that insults groups of people, particularly based on their race, gender, religion, or other demographic identity, tends to disrupt commercial activity and to undermine the stability of the marketplace in much the same manner as discriminatory conduct.”<sup>183</sup> This argument makes sense. Disparaging marks may drive consumers away from commercial transactions and not because of the reputation of a good, but rather, because of disagreement with the message within the disparaging opinion.<sup>184</sup> In many instances, the disparaging opinion may have nothing to do with the good itself.<sup>185</sup> Indeed, given that marks that are more distinctive receive stronger trademark protection, the distinctiveness criterion encourages any disparaging opinion *not*

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<sup>180</sup> See Landes & Posner, *supra* note 175, at 267. Professors Mark Lemley and Stacey Dogan explain the broader purposes of trademark as follows:

While the reduction of consumer search costs and the encouragement of goodwill investment represent critical intermediate objectives of the trademark system, neither of these goals is an end in itself. The law reduces consumer search costs in order to facilitate the functioning of a competitive marketplace. Informed consumers will make better-informed purchases, which will increase their overall utility and push producers to develop better quality products. Trademark law, then, aims to promote more competitive markets by improving the quality of information in those markets.

Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L.J. 461, 467 (2005).

<sup>181</sup> See *In re Tam*, 808 F.3d at 1354.

<sup>182</sup> See *id.*

<sup>183</sup> See *id.* at 1379 (Reyna, J., dissenting).

<sup>184</sup> See *id.* at 1380.

<sup>185</sup> For instance, the mark, HAVE YOU HEARD SATAN IS A REPUBLICAN, which was attached to clothing goods, was denied protection as a disparaging mark. See *id.* at 1359 (O'Malley, J., concurring); HAVE YOU HEARD SATAN IS A REPUBLICAN, Serial No. 85077647 (filed July 2, 2010).

to describe characteristics of the good.<sup>186</sup> Hence, where a consumer takes offense at the disparaging opinion, that offense likely is not related to the good itself. The offense is due to an opinion that is often irrelevant to the market transaction. Some consumers of football games, for instance, may refrain from attending Redskins games because they disagree with the disparaging proposition of the REDSKINS mark—not because they fail to enjoy football or because of the quality of the Redskins organization. Simply put, disparaging opinions may interfere with efficient transactions.

One might argue, however, that some disparaging marks actually promote efficient transactions. Some disparaging marks describe their goods, and some simply appeal to consumers independent of their goods. If disparaging marks describe goods that are themselves disparaging or otherwise offensive, then likely the disparaging opinion in that mark would not likely interfere with the potential consumer's purchase of the good. That is to say, a potential consumer who would be interested in purchasing a disparaging good would not be offended by the disparaging opinion of the mark. For instance, if REDSKINS were the title of a book that disparaged Native Americans, any potential consumer who would not be offended by the content of the book would also not be offended by the content of the REDSKINS title.<sup>187</sup> Similarly, some disparaging marks appeal to consumers, regardless of whether they describe the good. In the football context, some football fans prefer REDSKINS as the mark for their football team.<sup>188</sup> In such situations, the disparaging mark does not seem to interfere with market transactions, and indeed, the disparaging mark seems to promote those transactions.<sup>189</sup>

This argument is unconvincing. The fact that some consumers may not be offended by either the mark or the good (such that the consumers thereby enter the transaction) does not change the fact that some consumers are offended by the mark (and thereby do *not* enter the transaction). It would seem that consumers who are not offended by the mark would still enter the transaction for the good even without the disparaging mark. Regardless of whether the football team is known by the disparaging REDSKINS mark or the non-disparaging INDIANS mark, consumers purchase football tickets. That said, arguably some consumers enter transactions only if the disparaging mark is present. The question, then, is simple: do more consumers refrain from entering transactions because of the *presence* of a disparaging

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<sup>186</sup> See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

<sup>187</sup> The mark may also opine about the use of the disparaging term, arguing against that use. *E.g.*, C. RICHARD KING, REDSKINS: INSULT & BRAND (2016).

<sup>188</sup> See Snyder, *supra* note 83.

<sup>189</sup> See *id.*

mark rather than because of the *absence* of the disparaging mark? On balance, it would seem that more refrain because of the mark's presence than because of the mark's absence. Admittedly, the truthfulness of this proposition may never be known; however, the proposition does seem reasonable.<sup>190</sup> Therefore, the fact that disparaging marks may interfere with marketplace transactions appears sufficient to conclude that Congress has a reasonable basis for believing that denying trademark protection for such marks will promote a more efficient marketplace.

One might also argue that the anti-disparagement criterion does not directly promote efficient transactions. Arguably, the bar that precludes disparaging marks only indirectly promotes commercial efficiency. As an indirect means for promoting the government interest, the restriction arguably seems more extensive than necessary.<sup>191</sup>

This argument is also unconvincing. Other means that trademark law employs to promote commercial efficiency are at least as indirect as the anti-disparagement criterion. Specifically, trademark's requirement of distinctiveness only indirectly results in markholders realizing an efficient return on their investment in the quality of goods offered to consumers.<sup>192</sup> Distinctiveness enables consumers to recognize a trademark as communicating the source of a good, which then may effectuate a reputation for a markholder; upon gaining a reputation, a markholder can realize a return on his or her investment in producing quality goods only as consumers make subsequent purchases based on that reputation.<sup>193</sup> Hence, the purported efficiency—

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<sup>190</sup> Even assuming that more consumers refrain from entering transactions because the disparaging mark is not present, the result of precluding registration for disparaging marks still appears to promote efficiency in the marketplace. Consumers refraining from entering a transaction owing to the absence of a mark arise in two situations. First, some consumers enter the transaction only because they agree with the mark's disparaging proposition. In that situation, the disparaging proposition is more attractive than the quality of the good itself; without the disparaging proposition, they simply won't purchase the good. This situation would lead to the market price failing to reflect consumer demand for the actual good, and consequently, the price for the good would be inaccurate.

Second, some consumers enter the transaction only because the disparaging mark conveys information about the good itself. In that situation, the disparaging proposition describes the good (e.g., REDSKINS as a title of a book that disparages Native Americans). This situation would lead to the mark failing to efficiently indicate brand; consumers are less likely to understand marks that describe a good as indicating source. See *Abercrombie*, 537 F.2d at 9. Hence, disparaging marks that describe their goods are inefficient indicators of source.

<sup>191</sup> See *Milavetz, Gallop & Milavetz, P.A.*, 559 U.S. at 249 (explaining that a content-based restriction in the commercial speech context must "be no more extensive than is necessary to serve that interest" (quotation omitted)).

<sup>192</sup> See *Qualitex Co.*, 514 U.S. at 163–64 (explaining the indirect benefits of trademark rights).

<sup>193</sup> See *id.*

markholders realizing a return on their investment in producing quality goods—is merely an indirect result of the distinctiveness criterion.<sup>194</sup>

In response, one might argue that the distinctiveness criterion also serves a more direct means for promoting marketplace efficiency. Distinctiveness directly prevents potential confusion by consumers over the source of a good, and confusion would hinder commercial transactions.<sup>195</sup> So one effect of the distinctiveness criterion—preventing possible consumer confusion—does directly support the purpose of trademark. Yet the anti-disparagement criterion is no different. It directly prevents possible consumer offense that would hinder commercial transactions.<sup>196</sup> The fact that the anti-disparagement criterion does not target confusion over source does not suggest that the criterion is not directly facilitating commercial transactions. Indeed, it is well established that a criterion for trademark protection need not address source confusion to further commercial transactions. Consider the anti-deception criterion.<sup>197</sup> Trademark’s bar against deceptive marks does not further source identification.<sup>198</sup> Rather, the anti-deception criterion furthers *good* identification: consumers can better identify the goods that they purchase if the mark does not deceive consumers as to properties of that good.<sup>199</sup> Hence, the anti-deception criterion directly furthers commercial transactions without promoting source identification, as does the anti-disparagement criterion.

In sum, the majority’s conclusion that the anti-disparagement criterion does not support the purpose of trademark ignores the premise that preventing consumer confusion and deception serve a broader purpose—promoting marketplace efficiency.<sup>200</sup> Trademark promotes efficiency by facilitating means for providing consumers with quality information about commercial transactions. Quality information includes not only accurate information about the producer and the good, but also non-offensive information that would other-

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<sup>194</sup> Cf. *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 434 (1993) (“[A] regulation limiting commercial speech can, in fact, be more extensive than is necessary to serve the government’s interest as long as it is not unreasonably so.”).

<sup>195</sup> See *Qualitex Co.*, 514 U.S. at 163–64.

<sup>196</sup> See *supra* notes 183–190 and accompanying text (explaining how the anti-disparagement criterion’s prevention of consumer offense furthers commercial transactions).

<sup>197</sup> See 15 U.S.C. § 1052(a) (2012).

<sup>198</sup> A mark is deceptive only if it misdescribes the good, not the source. See *In re Budge Mfg. Co.*, 857 F.2d 773, 775 (Fed. Cir. 1988) (explaining the test for determining deceptiveness of a mark). Deceptive marks can indicate source in the same way that an arbitrary mark does, given that arbitrary marks do not describe the good but are nonetheless associated with the source. See *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 791 (5th Cir. 1983). Hence, a meaning that does not describe the good does not imply that a mark cannot identify source.

<sup>199</sup> See McKenna, *supra* note 153, at 1844.

<sup>200</sup> See *supra* notes 170–180 and accompanying text.

wise interfere with the commercial transaction. In this way, the anti-disparagement criterion supports the purpose of trademark law.

### *B. Markholder Goodwill and the Collective Marketplace*

Another purpose of trademark law is to protect markholders' goodwill.<sup>201</sup> Consumers associate the mark with the reputation that a markholder has established for its goods, thereby creating goodwill toward the markholder.<sup>202</sup> At first blush, this purpose may not seem relevant to whether the anti-disparagement criterion supports the purpose of trademark. Prohibiting a markholder from choosing a disparaging mark does not seem relevant to protecting the markholder's goodwill. Protecting goodwill, however, is relevant to the anti-disparagement criterion because goodwill protection serves a broader purpose. Protecting goodwill encourages markholders to invest in their products and marks, and with this greater investment, the marketplace realizes the collective benefit of a healthier, more robust forum for commercial transactions.<sup>203</sup> Consequently, the purpose of protecting markholders' goodwill appears to serve a broader purpose of promoting the collective marketplace.<sup>204</sup>

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<sup>201</sup> See *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 854 n.14 (1982) ("Such blatant trademark infringement inhibits competition and subverts both goals of the Lanham Act. By applying a trademark to goods produced by one other than the trademark's owner, the infringer deprives the owner of the goodwill which he spent energy, time, and money to obtain. At the same time, the infringer deprives consumers of their ability to distinguish among the goods of competing manufacturers." (citations omitted)); MCCARTHY, *supra* note 71, § 2:1.

<sup>202</sup> See *Qualitex Co.*, 514 U.S. at 164 ("[Trademark] law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product. The law thereby encourages the production of quality products, and simultaneously discourages those who hope to sell inferior products by capitalizing on a consumer's inability quickly to evaluate the quality of an item offered for sale." (quotation omitted) (citations omitted)).

<sup>203</sup> See *id.*; *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) ("National protection of trademarks is desirable, Congress concluded, because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation.").

The purpose of protecting markholders is particularly apparent in the doctrine of dilution. Trademark restricts second speakers from using a mark in a way that is likely to dilute the mark. See 15 U.S.C. § 1125(c) (2012). Dilution constitutes any use that could lessen the capacity of a famous mark to distinguish its good. See *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 420–21 (2003). Importantly, dilution may occur even if consumer confusion is not present. See *id.* at 429. For instance, if someone sells pianos and names his store Kodak, he has diluted Kodak's mark even though consumers would not likely believe that the camera manufacturer is the source of the piano store. See H.R. REP. NO. 104-374, at 3 (1995). Hence, the purpose of the dilution doctrine is to benefit markholders rather than consumers. See Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1698 (1999) (observing the fundamental shift in trademark protection from benefiting consumers to benefiting famous markholders).

<sup>204</sup> See *Dogan & Lemley, supra* note 180, at 467 (recognizing broader purpose of promoting competitive markets as underlying trademark's encouragement of markholder goodwill).

This broader purpose suggests that the anti-disparagement criterion is permissible. In certain instances, protecting the goodwill of a particular markholder might contravene the very purpose for that protection. In those instances, protecting the goodwill of those markholders is contrary to the broader purpose of trademark law. That is, if a markholder hinders the collective marketplace, then promoting goodwill for that markholder would be contrary to the very purpose for promoting goodwill in the first place. For example, suppose that the use of expletives as marks yields a negative effect for the collective marketplace. Assuming there is evidence that supports this supposition, would it make sense to extend trademark protection for expletives?<sup>205</sup> Likely not. Protecting goodwill of such a mark and its markholder would contravene the very purpose for protecting goodwill in the first place—to promote the collective marketplace. Encouraging such marks would inhibit the purpose of trademark. Therefore, the reason that trademark protects the goodwill of a markholder (i.e., to promote the collective marketplace) suggests that Congress may deny protection for certain categories of marks where those categories would undermine the broader purpose.

This interpretation of the purpose of trademark law draws support from a provision in the Lanham Act distinct from the anti-disparagement provision. In addition to the anti-disparagement provision, the Lanham Act has a provision that designates a content-based category as falling outside of protection.<sup>206</sup> Section 2(b) of the Lanham Act bars trademark protection for any mark that “[c]onsists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.”<sup>207</sup> By designating that government symbols are ineligible for trademark registration, section 2(b) represents a content-based bar for trademark protection.<sup>208</sup> Notably, the expression of government symbols receives a high degree of speech protection as political speech.<sup>209</sup> Why does the Lanham Act deny protection for such content? Certainly the denial is not for reasons of market efficiency.<sup>210</sup> Nor

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<sup>205</sup> Another example might be marks that promote prostitution. If evidence supports the view that such marks harm the collective marketplace—perhaps causing negative externalities—arguably Congress could deny those marks trademark protection. Nevertheless, a denial of marks that promote prostitution would still be subject to a viewpoint-discrimination challenge. *See infra* notes 217–262 and accompanying text.

<sup>206</sup> *See* 15 U.S.C. § 1052(b) (2012).

<sup>207</sup> *Id.*

<sup>208</sup> *See id.* Tellingly, the majority did not suggest that its holding invalidated the § 2(b) content-based bar. *See In re Tam*, 808 F.3d at 1321–58.

<sup>209</sup> *See Texas v. Johnson*, 491 U.S. 397, 417–20 (1989) (recognizing destruction of flags as protected political speech).

<sup>210</sup> Government symbols could serve as distinctive marks such that consumers could better identify source. This is especially true where the source is a government actor. Nevertheless, even

does the denial seem to directly promote commerce.<sup>211</sup> Rather, the denial reflects Congress's judgment that this content should not be the subject of a commercial transaction.<sup>212</sup> Stated differently, Congress has judged that the effect of protecting these marks would be undesirable for collective society.<sup>213</sup>

This government-symbol bar is further notable because the apparent undesirable effect of extending trademark to those symbols does not appear to be with respect to marketplace participants, but instead, the undesirable effect appears to be with respect to collective society. The commercial marketplace does not seem better off by denying government symbols. Indeed, the commercial marketplace would seem better off by allowing the symbols to be protected; trademarking government symbols would enable consumers to more easily identify source, especially where the source of a good is a government entity. On the other hand, the effects on collective society of trademarking government symbols would apparently be undesirable. As Professor McCarthy explains, the reason for the government-symbol bar is that such symbols should "not be sullied or debased by use as symbols in business and trade."<sup>214</sup> Thus, the government-symbol bar is a clear example of Congress choosing to refrain from protecting goodwill of particular markholders to further a social purpose that is broader than promoting the commercial marketplace. Precisely because trademark law governs the commercial marketplace, Congress has chosen to deny trademark protection for this category of content. Simply put, Congress is divorcing this content from the commercial marketplace for the greater good of societal interests.<sup>215</sup>

The upshot of this discussion is that the purpose of promoting the collective marketplace through protecting the goodwill of markholders includes the ability to refrain from protecting that goodwill for marks that would be detrimental to the marketplace, or for that matter, that would be detrimental to collective society generally. Like the government-symbol bar, the anti-disparagement criterion represents an attempt by Congress to keep

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where the source is a government actor, the Lanham Act precludes registration of the government symbol as a mark. *See In re City of Houston*, 731 F.3d 1326, 1331 (Fed. Cir. 2013) (denying trademark protection for a government symbol used by city of Houston).

<sup>211</sup> *Cf.* Tushnet, *supra* note 1, at \*28 (observing that the government-symbol bar does not exist to prevent confusion).

<sup>212</sup> *See* J. THOMAS MCCARTHY, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 19:78 (4th ed. 2016) (explaining that the purpose of the § 2(b) bar against government symbols is so that those symbols will "not be sullied or debased by use as symbols in business and trade").

<sup>213</sup> *See id.*

<sup>214</sup> *Id.*

<sup>215</sup> To borrow language from the majority, it is "a mark's expressive character, not its ability to serve as a source identifier, that is the basis for the [government-symbol] exclusion from registration." *See In re Tam*, 808 F.3d at 1338.

certain content out of the commercial marketplace. As discussed in the section above, there is good reason for this attempt: the anti-disparagement criterion discourages marks that are likely to disrupt marketplace transactions.<sup>216</sup> Furthermore, such marks may cause negative effects on collective society. Yet regardless of those broader implications, the anti-disparagement criterion denies goodwill for a category of marks that appear to hinder the collective marketplace, and that is sufficient to find that the criterion supports the purpose of trademark law.

### III. VIEWPOINT DISCRIMINATION

In *In re Tam*, the majority concluded that the anti-disparagement criterion is viewpoint discriminatory.<sup>217</sup> If true, this conclusion would dispose of any argument that the anti-disparagement criterion is constitutional. Although subject-matter content discrimination may be permissible in some situations, viewpoint discrimination never is.<sup>218</sup> So even if the anti-disparagement criterion must be analyzed under an exceptional free-speech framework, and even if that criterion supports the purpose of trademark law, the criterion would violate the First Amendment if it were viewpoint discriminatory.<sup>219</sup> This Part therefore examines whether the criterion is viewpoint discriminatory.<sup>220</sup>

In reaching its conclusion that the anti-disparagement criterion is viewpoint discriminatory, the majority employed two rationales.<sup>221</sup> First, the government offers protection to viewpoints that are opposite of disparaging viewpoints.<sup>222</sup> Second, the meaning of disparagement depends on the viewpoint of a private group.<sup>223</sup> As discussed in the two sections below, these rationales are inconsistent with existing trademark doctrines.<sup>224</sup>

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<sup>216</sup> See *supra* notes 183–200 and accompanying text.

<sup>217</sup> See *In re Tam*, 808 F.3d 1321, 1335 (Fed. Cir. 2015), *cert. granted*, 2016 WL 1587871 (U.S. Sept. 29, 2016) (No. 15-1293).

<sup>218</sup> See *R.A.V. v. City of St. Paul*, 505 U.S. 377, 387–88, 391 (1992).

<sup>219</sup> See *Sorrell v. IMS Health, Inc.*, 564 U.S. 552, 570 (2011) (noting that viewpoint discrimination is not permissible in the commercial-speech framework); *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 588 (1998) (commenting that viewpoint discrimination is not permissible in the government-subsidy framework); *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995) (precluding viewpoint discrimination in the context of the limited-public forum).

<sup>220</sup> See *infra* notes 225–262 and accompanying text.

<sup>221</sup> *In re Tam*, 808 F.3d at 1336–37.

<sup>222</sup> *Id.*

<sup>223</sup> *Id.* at 1337.

<sup>224</sup> See *infra* notes 225–262 and accompanying text.



### A. Marks That Disparage and Marks That Praise

The majority concluded that the anti-disparagement criterion “is viewpoint discriminatory on its face.”<sup>225</sup> It reasoned that the “PTO rejects marks under [the anti-disparagement criterion] when it finds the marks refer to a group in a negative way, but it permits the registration of marks that refer to a group in a positive, non-disparaging manner.”<sup>226</sup> The majority’s reasoning is thus simple: rejecting one type of proposition (propositions that disparage), without rejecting the contrary type of proposition (propositions that praise), is viewpoint discriminatory.<sup>227</sup> In effect, the majority reasoned that the disparity in treatment between categories of views indicates viewpoint discrimination.<sup>228</sup>

This reasoning suggests that another provision of the Lanham Act is viewpoint discriminatory, namely, the provision that denies trademark protection for marks that are deceptive—i.e., the anti-deception criterion.<sup>229</sup> Both disparaging and deceptive marks make propositions that the Lanham Act rejects: disparaging marks make propositions that dishonor a group,<sup>230</sup> deceptive marks make propositions that are deceitful about a good.<sup>231</sup> Because the opposite types of propositions receive protection (i.e., marks that praise a group and marks that are truthful about a good), then the disparity in treatment of views for both disparaging and deceptive marks indicates—under the majority’s reasoning—that viewpoint discrimination is present. That is, if viewpoint discrimination follows from the mere fact that the Lanham Act denies protection for a general type of proposition, then under that reasoning, it would seem that the Lanham Act’s anti-deception criterion would be viewpoint discriminatory.

One might argue that because deception concerns a portrayal of facts whereas disparagement concerns a speaker’s opinion, deception does not reflect a viewpoint whereas disparagement does. This argument has strength. Consider, for instance, a football franchise that represents its team by using the mark, THE NATIVE AMERICANS, when in fact, the team is not comprised of Native American players. This mark seems deceptive be-

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<sup>225</sup> *In re Tam*, 808 F.3d at 1336–37.

<sup>226</sup> *Id.* at 1336.

<sup>227</sup> *See id.* at 1336–37.

<sup>228</sup> *See id.*

<sup>229</sup> *See* 15 U.S.C. § 1052(a) (2012).

<sup>230</sup> *See In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014) (“[A] mark may disparage when it dishonors by comparison with what is inferior, slights, deprecates, degrades, or affects or injures by unjust comparison.” (quotations omitted)).

<sup>231</sup> *See In re Phillips-Van Heusen Corp.*, 63 U.S.P.Q.2d 1047, 2002 WL 523343 (T.T.A.B. 2002) (requiring that a deceptive mark misdescribes a good).

cause there are no Native Americans on the team despite its mark. Yet the mark does not seem viewpoint discriminatory because there does not appear to be any subjectivity in determining the accuracy of the proposition in the mark. The proposition seems objectively false. On the other hand, REDSKINS as a disparaging mark for a football team reflects a subjective believe that Native Americans are an inferior race.<sup>232</sup> The subjective opinion inherent in the disparaging mark arguably suggests that disparagement reflects viewpoints more so than objectively verifiable statements of fact. Whereas deceptive marks seem to turn on objective states of affairs, disparaging marks seem to turn on subjective viewpoints. Hence, it may be argued that prohibiting deceptiveness does not amount to a prohibition of viewpoints in contrast to prohibiting disparagement.

This subjective-objective basis for distinguishing between viewpoint and subject-matter discrimination suggests some unusual consequences outside of trademark law. If subjective beliefs receive greater speech protection as viewpoints, and objectively verifiable beliefs receive lesser speech protection as subject-matter content, then hate speech would seem more worthy of speech protection than would Darwin's theory of evolution or a belief that Democrats raise taxes more than Republicans. This cannot be.<sup>233</sup> First Amendment jurisprudence well recognizes a hierarchy of protection, and hate speech is not at the top of the list.<sup>234</sup> This Article limits its discussion, however, to the internal consistency of trademark law, leaving the abstract discussion about the difference between viewpoint and subject-matter discrimination to the speech theorists.

Trademark law indicates that the subjective-objective basis for distinguishing between the anti-deception and the anti-disparagement criteria is flawed. In particular, the trademark test for determining whether a mark is deceptive suggests a high degree of subjectivity in the analysis. Three elements must be present for a mark to be deceptive: (1) the mark must misdescribe the good; (2) consumers must believe the misdescription to be an accurate statement about the goods; and (3) that misdescription must materially

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<sup>232</sup> See *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080, 2014 WL 2757516 (T.T.A.B. 2014), *aff'd sub nom*, *Pro-Football, Inc. v. Blackhorse* 112 F. Supp. 3d 439, 486 (E.D.V.A. 2015), *appeal filed*, No. 15-1874 (4th Cir. Aug. 6, 2015) (concluding that REDSKINS disparages a substantial portion of Native Americans).

<sup>233</sup> Cf. *Rosenberger*, 515 U.S. at 822–23, 831, 846 (holding unconstitutional a state university's exclusion of funding for student papers that manifest belief about "an ultimate reality"); *Simon & Schuster, Inc. v. N.Y. State Crime Victims Bd.*, 502 U.S. 105, 123 (1991) (holding unconstitutional a state law that penalized authors for narrating their past crimes).

<sup>234</sup> See *R.A.V.*, 505 U.S. at 422–23 (Stevens, J., concurring) ("Our First Amendment decisions have created a rough hierarchy in the constitutional protection of speech. Core political speech occupies the highest, most protected position.").

affect the purchasing decision of the relevant consumer pool.<sup>235</sup> With respect to the first prong, it is not always clear whether a mark is misdescribing a good. For instance, does the mark CU misdescribe a dietary supplement?<sup>236</sup> The Trademark Trial and Appeal Board held CU to be misdescriptive because the supplement contained no copper.<sup>237</sup> Consider also BREATHASURE for a breath freshener. Does the lack of scientific evidence proving that the breath freshener actually produces fresh breath mean that BREATHASURE reflects a false claim? One court believed so.<sup>238</sup> These examples illustrate that the question of whether a mark misdescribes a good—whether a statement is in fact false—may invite subjective opinion.<sup>239</sup>

As already mentioned, the second and third prongs of the test for deception are that consumers must believe the misdescription to be an accurate statement about the goods and that the misdescription must materially affect their purchasing decisions. In assessing the subjectivity of these inquiries, it is relevant that the PTO does not always examine actual consumer beliefs: the PTO may consider the plausibility and likelihood of such beliefs, publicly available information, and “common sense.”<sup>240</sup> Mere opinions concerning the beliefs of the relevant consumer pool (as well as concerning which members of the public comprise the relevant consumer pool) invite subjectivity into the inquiries. Consider HOLEPROOF as a mark for socks that could, in fact, develop holes.<sup>241</sup> Would consumers believe the claim in the mark? One court held that they would not.<sup>242</sup> Similarly, the Trademark Trial and Appeal Board held that consumers would never believe the claim in the mark GEORGE WASHINGTON ATE HERE for a restau-

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<sup>235</sup> See *In re Budge Mfg. Co.*, 857 F.2d 773, 775 (Fed. Cir. 1988) (setting forth three-part test for determining deceptiveness of mark).

<sup>236</sup> See *In re E5 LLC*, 103 U.S.P.Q.2d (BNA) 1578, 1584 (T.T.A.B. 2012) (holding the term CU to be misdescriptive of a dietary supplement).

<sup>237</sup> See *id.*

<sup>238</sup> See *Warner-Lambert Co. v. Breathasure, Inc.*, 204 F.3d 87, 97 (3d Cir. 2000).

<sup>239</sup> See Rebecca Tushnet, *It Depends on What the Meaning of “False” Is: Falsity and Misleadingness in Commercial Speech Doctrine*, 41 LOY. L.A. L. REV. 227, 233–38 (2007) (reciting examples of cases where falsity in advertising claim is not always clear).

<sup>240</sup> See *Glendale Int’l Corp. v. USPTO*, 374 F. Supp. 2d 479, 486 (E.D. Va. 2005) (commenting that “the PTO must rely, as it did here, on sources of publicly-available information likely to reflect such perceptions and, of course, common sense” in making a determination relating to deceptiveness of a mark); *Humanetics Corp. v. Neways, Inc.*, 2004 WL 763935, at \*7–9 (T.T.A.B. Mar. 31, 2004); Tushnet, *supra* note 239, at 236.

<sup>241</sup> See *Holeproof Hosiery Co. v. Wallach Bros.*, 172 F. 859, 860 (2d Cir. 1909).

<sup>242</sup> *Id.* (“No one surely could be misled into the belief that holes will not appear in complainant’s socks if they are worn long enough, and it is difficult to conceive that any one could be fatuous enough to suppose that by the use of such a word he could deceive people by inducing a belief that the goods to which it was applied would never wear out.”).

rant.<sup>243</sup> By contrast, one court held that consumers would believe that the mark TITANIUM for recreational vehicles indicates that the vehicles were in fact made of Titanium, as contrasted with consumer beliefs about the marks SILVER or GOLD for other vehicles.<sup>244</sup> Consider CAFETERIA as a mark for a sit-down restaurant. The Trademark Trial and Appeal Board held that the misdescription in CAFETERIA would affect consumers' purchasing decision for the restaurant's services.<sup>245</sup> Thus, reasonable minds might differ as to whether consumers would believe a claim in a mark and whether that belief would affect consumers' purchasing decisions.

A further example may help illustrate the subjective nature of determining deception. Consider the above example referring to THE NATIVE AMERICANS as a mark for a football franchise. The mark would be deceptive in the trademark context only if that mark misdescribes the team (what if at its inception four players on the team actually were Native American?);<sup>246</sup> only if consumers would understand the mark to be describing the team (might consumers believe that NATIVE AMERICANS represents a mere comparison to the team?); and only if consumers would refrain from purchasing football tickets upon learning that the team has no Native American players (if tickets sell out, does that suggest that consumers do not refrain?). The seemingly objective inquiry into deception may well call for subjective opinion. Thus, the anti-disparagement criterion does not appear to call for subjective opinion any more than the anti-deception criterion.

One might further argue, however, that deceptive speech is unprotected by the First Amendment, so even if the anti-deception criterion is viewpoint discriminatory, the viewpoint discrimination does not violate the First Amendment. That argument, however, is not correct. Although it is true that deceptive speech is not protected in the commercial-speech context, deceptive speech does receive some protection outside that context.<sup>247</sup> That fact is

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<sup>243</sup> *In re George Washington Ate Here, Inc.*, 167 U.S.P.Q. 702, 1970 WL 9634 (T.T.A.B. 1970); see also *In re One Minute Washer Co.*, 95 F.2d 517 (C.C.P.A. 1938) (holding that consumers would never believe that a washing machine could wash clothes in one minute—as opposed to the machine's actual time of seven minutes—based on the mark, ONE MINUTE).

<sup>244</sup> See *Glendale Int'l Corp.*, 374 F. Supp. 2d at 484–87.

<sup>245</sup> See *In re ALP of South Beach Inc.*, 79 U.S.P.Q.2d 1009, 2006 WL 936984 (T.T.A.B. 2006).

<sup>246</sup> See Snyder, *supra* note 83 (“On that inaugural Redskins team, four players and our Head Coach were Native Americans.”).

<sup>247</sup> See *Bates v. State Bar of Ariz.*, 433 U.S. 350, 383 (1977) (“[T]he leeway for untruthful or misleading expression that has been allowed in other contexts has little force in the commercial arena.”); see also, e.g., *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 271–73 (1964) (recognizing the inherent constitutional need to protect false statements on the grounds that “[t]hat erroneous statement is inevitable in free debate, and that it must be protected if the freedoms of expression

important because where speech is protected in one context, switching contexts does not justify viewpoint discrimination of that speech.<sup>248</sup> The anti-deception criterion does not represent justifiable viewpoint discrimination.

Because the majority's reason for concluding that the anti-disparagement criterion is viewpoint discriminatory suggests that the anti-deception criterion is also viewpoint discriminatory, the majority's reasoning is suspect.

### B. Viewpoints of the Referenced Group

The *Tam* majority further reasoned that the disparagement criterion is not viewpoint neutral because the criterion depends on a viewpoint of a substantial composite of the referenced group.<sup>249</sup> The criterion cannot be viewpoint neutral, the majority argued, if denial of trademark registration turns solely on the viewpoint of a group.<sup>250</sup> The majority stated: "The government's argument also fails because denial of registration under [the anti-disparagement criterion] turns on the referenced group's perception of a mark."<sup>251</sup> The majority thus reasoned that one group's perception of the mark implies that the government denies protection based on a viewpoint.<sup>252</sup>

This reasoning does not make sense in the context of trademark law. Once again, the reasoning of the majority calls into question the fundamental provision in the Lanham Act that bars protection for deceptive marks.<sup>253</sup> As stated above, in determining whether a mark is deceptive, the PTO must determine whether a misdescriptive mark affects the purchasing decisions of a relevant consumer group.<sup>254</sup> Unsurprisingly, in making this distinction, the PTO must consider perceptions of the consumer group to determine whether the misdescription affects purchasing decisions.<sup>255</sup> A mark's eligibility under the anti-deception criterion depends on a group's viewpoint of a

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are to have the 'breathing space' that they need to survive" (quotations omitted) (citations omitted)).

<sup>248</sup> See *R.A.V.*, 505 U.S. at 387–88, 391. Notably, switching contexts can justify subject-matter content discrimination. See *id.* In the commercial-speech framework, only general classes of content may be proscribed (and only for good reason), not viewpoints of otherwise protected expression. See *id.* Hence, the fact that deceptive speech is protected in some contexts but not protected in the commercial-speech context implies that deceptiveness represents a general category of content—not a viewpoint. See *id.*

<sup>249</sup> See *In re Tam*, 808 F.3d at 1337.

<sup>250</sup> *Id.*

<sup>251</sup> *Id.*

<sup>252</sup> See *id.*

<sup>253</sup> See 15 U.S.C. § 1052(a) (2012).

<sup>254</sup> See *In re Budge Mfg. Co.*, 857 F.2d at 775.

<sup>255</sup> See, e.g., *In re Phillips-Van Heusen Corp.*, 63 U.S.P.Q.2d at 1048.

proposition.<sup>256</sup> If the misdescription matters to the group, just like if the disparagement matters to the group, trademark is denied.<sup>257</sup> So under the majority's reasoning, the anti-deception criterion would be viewpoint discriminatory and thereby unconstitutional.

The same can be said of marks that require secondary meaning for trademark protection. Secondary meaning requires the PTO to assess whether a select group of the public—consumers of the good in question—perceives a mark as describing the source of the good rather than describing an attribute about the good itself.<sup>258</sup> That is, to acquire distinctiveness necessary for trademark protection of descriptive marks,<sup>259</sup> the PTO must determine whether consumers of that good perceive the mark to be indicating a brand as opposed to describing an attribute of the good.<sup>260</sup> Secondary meaning turns entirely on the viewpoint of the relevant consumer pool.<sup>261</sup> Therefore, under the majority's rationale—that viewpoint discrimination occurs where a criterion depends on a group's viewpoint—the Lanham Act's requirement that descriptive marks must have secondary meaning would be viewpoint-discriminatory content discrimination.<sup>262</sup>

In sum, the reasoning that the majority employs to conclude that the anti-disparagement criterion is viewpoint discriminatory calls into question fundamental doctrines in trademark law. Its reasoning suggests that the Lanham Act's exclusion of deceptive marks and the Act's requirement of secondary meaning both constitute viewpoint-discriminatory rules. The very suggestion of such a conclusion calls into doubt the majority's reasoning.

#### IV. VAGUENESS

The *Tam* majority cited uncertainty in the application of the anti-disparagement criterion as a reason supporting its conclusion of unconstitutionality.<sup>263</sup> No one can say with any degree of certainty what is considered

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<sup>256</sup> See, e.g., *id.* at 1053–54 (finding that purchasers and prospective consumers are likely to believe that SUPER SILK describes fabric as comprising silk material).

<sup>257</sup> See *id.*

<sup>258</sup> See *PaperCutter, Inc. v. Fay's Drug Co.*, 900 F.2d 558, 564–65 (2d Cir. 1990).

<sup>259</sup> Other content-based categories of marks, such as marks that are primarily a surname or primarily geographically descriptive, also require secondary meaning. See 15 U.S.C. § 1052(e)–(f) (2012).

<sup>260</sup> See *PaperCutter*, 900 F.2d at 564–65.

<sup>261</sup> See, e.g., *King-Size, Inc. v. Frank's King Size Clothes, Inc.*, 547 F. Supp. 1138, 1158 (S.D. Tex. 1982) (denying trademark protection for lack of secondary meaning on the grounds that the proponent's evidence did not address the proper pool of consumers).

<sup>262</sup> See *In re Tam*, 808 F.3d at 1337.

<sup>263</sup> See *In re Tam*, 808 F.3d 1321, 1341–42 (Fed. Cir. 2015), *cert. granted*, 2016 WL 1587871 (U.S. Sept. 29, 2016) (No. 15-1293).

disparaging to a particular group of persons, especially when views and usages may change over time.<sup>264</sup> The anti-disparagement criterion is therefore unpredictable in its application.<sup>265</sup> Arguably, then, the criterion is vague<sup>266</sup> and overbroad.<sup>267</sup> The majority explained:

The uncertainty as to what *might be deemed* disparaging is not only evident on its face, given the subjective-reaction element and shifting usages in different parts of society. It is confirmed by the record of PTO grants and denials over the years, from which the public would have a hard time drawing much reliable guidance

<sup>264</sup> See *id.*

<sup>265</sup> See *id.*

<sup>266</sup> The Supreme Court has explained the vagueness doctrine as follows:

[T]he void for vagueness doctrine addresses at least two connected but discrete due process concerns: first, that regulated parties should know what is required of them so they may act accordingly; second, precision and guidance are necessary so that those enforcing the law do not act in an arbitrary or discriminatory way. When speech is involved, rigorous adherence to those requirements is necessary to ensure that ambiguity does not chill protected speech.

FCC v. Fox Television Stations, Inc., 132 S. Ct. 2307, 2317 (2012) (citations omitted).

<sup>267</sup> See *In re Tam*, 808 F.3d at 1358 (O'Malley, J., concurring) (arguing that the anti-disparagement criterion is unconstitutional on vagueness grounds). The Supreme Court has explained the overbreadth doctrine as follows:

[S]tatutes attempting to restrict or burden the exercise of First Amendment rights must be narrowly drawn and represent a considered legislative judgment that a particular mode of expression has to give way to other compelling needs of society. As a corollary, the Court has altered its traditional rules of standing to permit—in the First Amendment area—attacks on overly broad statutes with no requirement that the person making the attack demonstrate that his own conduct could not be regulated by a statute drawn with the requisite narrow specificity. Litigants, therefore, are permitted to challenge a statute not because their own rights of free expression are violated, but because of a judicial prediction or assumption that the statute's very existence may cause others not before the court to refrain from constitutionally protected speech or expression.

Broadrick v. Oklahoma, 413 U.S. 601, 611–12 (1973) (quotations omitted) (citations omitted).

The majority's choice not to apply the exceptional free-speech frameworks of commercial speech or government subsidies in its evaluation of the anti-disparagement criterion is necessary for the majority's overbreadth argument. The overbreadth doctrine does not apply to commercial speech. See *Vill. of Hoffman Estates v. Flipside, Hoffman Estates, Inc.*, 455 U.S. 489, 496–97 (1982) (“[T]he overbreadth doctrine does not apply to commercial speech.”); *Ohralik v. Ohio State Bar Ass’n*, 436 U.S. 447, 462 n.20 (1978) (“Commercial speech is not as likely to be deterred as noncommercial speech, and therefore does not require the added protection afforded by the overbreadth approach.”). Likewise for speech affected by government subsidies, the Court has observed “[i]n the context of selective subsidies, it is not always feasible for Congress to legislate with clarity.” *Nat’l Endowment for the Arts v. Finley*, 524 U.S. 569, 589 (1998).

. . . . [T]he uncertainty here . . . contributes significantly to the chilling effect on speech.<sup>268</sup>

For Judges O'Malley and Wallach, who concurred with the majority, the uncertainty of its application was even more of a constitutional problem.<sup>269</sup> Judge O'Malley described the anti-disparagement criterion as "so vague that I would find it to be unconstitutional, whether or not it could survive Appellant's First Amendment challenge."<sup>270</sup>

The judges' discomfort with the uncertainty surrounding the anti-disparagement criterion is understandable. Uncertainty with respect to the anti-disparagement criterion's application is clearly problematic. The uncertainty in that doctrine, however, is no more of a problem than the uncertainty that exists in applying several other doctrines in trademark law.<sup>271</sup> If uncertainty in application of rules that affect trademark rights to expression were sufficient to find the rule unconstitutional, trademark law could not exist.<sup>272</sup> Simply put, uncertainty must exist in view of the nature of the task that trademark undertakes, namely, the task of assigning property rights to speech based on contextual meaning. Indeed, it is well established that determining whether a mark qualifies for trademark protection often requires subjective judgment calls over which reasonable minds disagree.<sup>273</sup>

As support for the claim that trademark is fraught with uncertainty, this section describes other instances of uncertainty surrounding the question of

<sup>268</sup> *In re Tam*, 808 F.3d at 1341–42.

<sup>269</sup> *See id.* at 1358–63 (O'Malley, J., concurring).

<sup>270</sup> *Id.* at 1358.

<sup>271</sup> The Supreme Court has rejected the argument that a criterion for trademark protection which yields uncertainty in application should not receive protection. In 1995, in *Qualitex Co. v. Jacobson Products Co.*, the Court rejected the argument as follows:

[Respondent] says that, if the law permits the use of color as a trademark, it will produce uncertainty and unresolvable court disputes about what shades of a color a competitor may lawfully use. Because lighting (morning sun, twilight mist) will affect perceptions of protected color, competitors and courts will suffer from "shade confusion" as they try to decide whether use of a similar color on a similar product does, or does not, confuse customers and thereby infringe a trademark. [Respondent] adds that the "shade confusion" problem is "more difficult" and "far different from" the "determination of the similarity of words or symbols."

We do not believe, however, that color, in this respect, is special. Courts traditionally decide quite difficult questions about whether two words or phrases or symbols are sufficiently similar, in context, to confuse buyers.

514 U.S. 159, 167 (1995).

<sup>272</sup> *See Tushnet, supra* note 1, at \*33 (recognizing inconsistencies in application of the anti-disparagement criterion but arguing that "vagueness is also a huge problem with the rest of the bars, which can be equally unpredictable").

<sup>273</sup> *See infra* notes 274–299 and accompanying text (providing other examples in trademark law of uncertainty surrounding eligibility for trademark registration).



trademark eligibility. One obvious instance is the application of doctrine that distinguishes between categories of marks.<sup>274</sup> The distinctions between mark categories determine whether a mark may receive trademark protection automatically, may receive it only with an evidentiary showing that establishes secondary meaning, or may never receive protection.<sup>275</sup> These categories were originally set forth by Judge Henry Friendly of the Second Circuit, who noted the uncertainty inherent in distinguishing between the categories:

The lines of demarcation, however, are not always bright. Moreover, the difficulties are compounded because a term that is in one category for a particular product may be in quite a different one for another, because a term may shift from one category to another in light of differences in usage through time, because a term may have one meaning to one group of users and a different one to others, and because the same term may be put to different uses with respect to a single product.<sup>276</sup>

Consider the distinction between two categories of marks: suggestive and descriptive.<sup>277</sup> Under the Lanham Act, marks that *suggest* a characteristic of the good automatically receive trademark protection; marks that merely *describe* a characteristic of the good do not.<sup>278</sup> In theory, a suggestive mark requires a mental inference to understand that the mark is suggesting an attribute of the good, whereas a descriptive mark immediately conveys an attribute of the good.<sup>279</sup> In practice, the application of the theory yields unpredictable outcomes; the line between suggestive and descriptive marks seems illusory.<sup>280</sup> For instance, is the mark COZY-WARM ENERGY SAVERS descriptive or suggestive for pajamas? The Second Circuit held it to be descriptive.<sup>281</sup> Or what about ACTION SLACKS for slacks designed for

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<sup>274</sup> See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

<sup>275</sup> See *id.*

<sup>276</sup> *Id.*

<sup>277</sup> See *id.*

<sup>278</sup> Descriptive marks may receive protection if its proponent can demonstrate secondary meaning. See *id.*

<sup>279</sup> See *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790–91 (5th Cir. 1983).

<sup>280</sup> See *Thompson Med. Co. v. Pfizer Inc.*, 753 F.2d 208, 213 (2d Cir. 1985) (recognizing the lack of a clean boundary line between descriptive and suggestive marks).

<sup>281</sup> *20th Century Wear, Inc. v. Sanmark-Stardust Inc.*, 747 F.2d 81, 88 (2d Cir. 1984). The Second Circuit's reasoning in this case well illustrates the utter uncertainty involved in assessing whether a mark is descriptive or suggestive:

Had this suit been brought before the energy crisis, we might well have concluded that the mark was suggestive. But by the time of the alleged infringement, "Cozy Warm ENERGY-SAVERS" fell on the descriptive rather than the suggestive side of

movement? The Trademark Board held it to be suggestive.<sup>282</sup> Or WEEK-AT-A-GLANCE for a weekly appointment book? The court held it to be suggestive.<sup>283</sup>

Judge Learned Hand has observed the principle for distinguishing between suggestive and descriptive marks as follows: “It is quite impossible to get any rule out of the cases beyond this: That the validity of the mark ends where suggestion ends and description begins.”<sup>284</sup> Other federal circuits have recognized the uncertainty surrounding the distinction between suggestive and descriptive marks.<sup>285</sup> For instance, the Federal Circuit has stated:

In the complex world of etymology, connotation, syntax, and meaning, a term may possess elements of suggestiveness and descriptiveness at the same time. No clean boundaries separate these legal categories. Rather, a term may slide along the continuum be-

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a shifting line and as such was not entitled to protection absent proof of secondary meaning . . . . Numerous clothing businesses and hundreds, if not thousands, of other businesses as a result of the energy crisis began using “energy saving” and “cozy warm” to describe or extol the virtues of their products. In the wake of this common usage, the public was so well educated to the concept of something “cozy warm” as an “energy saver” that consumers did not have to engage in any sort of multistage reasoning process to link the term to the virtues of any number of products, including but not limited to flannel pajamas and nightgowns.

*Id.*

<sup>282</sup> *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 U.S.P.Q.2d 1464, 1993 WL 444262 (T.T.A.B. 1993).

<sup>283</sup> *Cullman Ventures, Inc. v. Columbian Art Works, Inc.*, 717 F. Supp. 96, 120 (S.D.N.Y. 1989) (“[T]he trademark Week-At-A-Glance does not describe the format, contrary to the assertion of [Defendant]. As the testimony established, a weekly appointment book can have one week on each page, one week spread over two pages, or a shorter period of time such as five or four days spread over two pages.”).

<sup>284</sup> *Franklin Knitting Mills v. Fashionit Sweater Mills*, 297 F. 247, 248 (S.D.N.Y. 1923), *aff’d*, 4 F.2d 1018 (2d Cir. 1925) (per curiam).

<sup>285</sup> The Second Circuit has recognized the amorphous distinction between suggestive and descriptive marks:

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. Moreover, the determination whether a mark is descriptive or suggestive cannot be made in a vacuum; it is necessary to surmise the mental processes of those in the marketplace at whom the mark is directed.

*Thompson Med. Co.*, 753 F.2d at 213 (quotations omitted) (citations omitted); *see also Zatarains, Inc.*, 698 F.2d at 790 (“These categories, like the tones in a spectrum, tend to blur at the edges and merge together. The labels are more advisory than definitional, more like guidelines than pigeonholes.”); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979) (“Whether Slickcraft is suggestive or descriptive is a close question. The line separating the two is uncertain; extrapolating the line from precedent would be impossible . . . . [T]he distinction between descriptive and suggestive marks may be inarticulable . . . .” (citations omitted)).

tween suggestiveness and descriptiveness depending on usage, context, and other factors that affect the relevant public's perception of the term.<sup>286</sup>

Hence, courts and the PTO are ill equipped to distinguish between suggestive and descriptive marks, and as a consequence, the application of the standard yields great uncertainty.

This is only the beginning. The PTO must distinguish between marks that are arbitrary (arbitrary marks have a meaning that bears no relationship to the meaning of the good),<sup>287</sup> deceptive (deceptive marks inaccurately describe a good, consumers believe the misdescription, and the misdescription affects the purchasing decision),<sup>288</sup> and deceptively misdescriptive (deceptively misdescriptive marks inaccurately describe a good, and consumers believe the misdescription, but the misdescription does not affect the purchasing decision).<sup>289</sup> Arbitrary marks automatically receive protection; deceptive marks never receive protection; and deceptively misdescriptive marks receive protection only by showing secondary meaning.<sup>290</sup> For instance, if a shoe manufacturer uses the mark, MAGNETIC, to sell a line of tennis shoes that are not in fact magnetic, the PTO must decide whether the mark is arbitrary, deceptive, or deceptively misdescriptive. If the PTO believes that consumers would not understand that MAGNETIC proposes that the shoe is in fact magnetic, then the mark would receive strong protection as an arbitrary mark. If the PTO believes that consumers would understand that MAGNETIC proposes that the shoe is in fact magnetic and further believes that this understanding would affect consumers' purchasing decision, the term is deceptive, thereby ineligible for trademark protection. If the PTO believes that consumers would understand that MAGNETIC proposes that the shoe is in fact magnetic but that the misdescription would not affect consumers' purchasing decisions, the term is deceptively misdescriptive and is therefore eligible for trademark protection upon a showing of secondary meaning. Which type of mark is MAGNETIC for shoe sales? Reasonable

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<sup>286</sup> *In re Nett Designs, Inc.*, 236 F.3d 1339, 1341 (Fed. Cir. 2001).

<sup>287</sup> *See Zatarains*, 698 F.2d at 791 (explaining that arbitrary marks "bear no relationship to the products or services to which they are applied").

<sup>288</sup> *See In re Budge Mfg. Co.*, 857 F.2d 773, 775 (Fed. Cir. 1988) (holding that for a good to be deceptive, it must misdescribe the good, prospective buyers must be "likely to believe" the misdescription, and the misdescription must be "likely to affect" the buyer's decision to purchase the good).

<sup>289</sup> *See id.*; *In re Nantucket, Inc.*, 677 F.2d 95, 104–05 (C.C.P.A. 1982) (explaining that "if the public would perceive a misdescriptive use of a geographic name as a descriptive use, the claimed mark is deceptively misdescriptive and unregistrable without secondary meaning").

<sup>290</sup> *See In re Nantucket, Inc.*, 677 F.2d at 104–05.

minds may disagree. The shoe producer would thereby face uncertainty as to whether its mark is eligible for protection.

Many more examples of uncertainty could be cited. Consider the following inquiries that raise uncertainty in determining whether a trademark applicant will receive rights: (1) the inquiry into whether a mark is descriptive or generic;<sup>291</sup> (2) the inquiry into whether trade dress constitutes product packaging or product design;<sup>292</sup> (3) the inquiry into whether a once-distinctive mark has become generic;<sup>293</sup> (4) the inquiry into whether a mark has gained secondary meaning;<sup>294</sup> (5) the inquiry into whether a geographic

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<sup>291</sup> If a mark describes the good itself, rather than a characteristic of a good, the mark is generic, incapable of ever receiving trademark protection. See *Abercrombie*, 537 F.2d at 9–11. Yet if a mark describes a characteristic of the good, the mark is merely descriptive, capable of receiving trademark protection upon a showing of secondary meaning. For example, is the word *Cola* descriptive of the beverage product, or alternatively, is *Cola* generic so as to describe a class of products? See *Dixi-Cola Labs., Inc. v. Coca-Cola Co.*, 117 F.2d 352, 359 (4th Cir. 1941) (“[T]he word ‘cola’ does not today indicate the plaintiff’s product [Coca-Cola] but a class of drinks to which the goods of the defendants and many other competitors belong.”). Courts must distinguish between descriptive or generic, which the Second Circuit has called a “chimerical line.” *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.”).

<sup>292</sup> See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 215 (2000) (“There will indeed be some hard cases at the margin: a classic glass Coca-Cola bottle, for instance, may constitute *packaging* for those consumers who drink the Coke and then discard the bottle, but may constitute *the product itself* for those consumers who are bottle collectors, or part of the product itself for those consumers who buy Coke in the classic glass bottle, rather than a can, because they think it more stylish to drink from the former.” (emphasis added)).

<sup>293</sup> Meanings change over time as the public changes its use of words: what was once a distinctive fanciful term that designated a brand of good may become a generic term over time. See *Bayer Co. v. United Drug Co.*, 272 F. 505, 511 (S.D.N.Y. 1921) (holding that fanciful mark Aspirin has become generic and thereby lost trademark protection). The word cellophane once communicated brand, but it quickly became generic through public usage. See *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 80 (2d Cir. 1936). What about Teflon? Has Teflon become a generic term for non-stick pans? According to one court, Teflon has not become generic. See *E.I. DuPont de Nemours & Co. v. Yoshida Int’l, Inc.*, 393 F. Supp. 502, 528 (E.D.N.Y. 1975). Reasonable minds might disagree. What about Band-Aid, Xerox, and Lego? Needless to say, the protection that trademark offers for a mark can be very fluid, and thereby uncertain.

<sup>294</sup> To show secondary meaning, a proponent must demonstrate that a mark has come to signify source in the minds of consumers. See *Wal-Mart Stores, Inc.*, 529 U.S. at 211 (“[I]n the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.” (quotation omitted)). Given that the inquiry requires demonstration of minds of consumers, that inquiry raises uncertainty, especially given the multiplicity of sources that the PTO may weigh in making this determination. As the Ninth Circuit has noted, “[s]econdary meaning can be established in many ways, including (but not limited to) direct consumer testimony; survey evidence; exclusivity, manner, and length of use of a mark; amount and manner of advertising; amount of sales and number of customers; established place in the market; and proof of intentional copying by the defendant.” *Filipino Yellow Pages, Inc. v. Asian Journal Publ’ns, Inc.*, 198 F.3d 1143, 1151 (9th Cir. 1999).

term is used in a non-descriptive, arbitrary sense,<sup>295</sup> (6) the inquiry into whether a personal name requires secondary meaning;<sup>296</sup> and (7) the inquiry into whether trade dress is functional.<sup>297</sup> Each of these inquiries requires an examination of content to conclude whether an applicant will receive protection. Each introduces great uncertainty. Consequently, a potential markholder may avoid content that would raise one of these inquiries.<sup>298</sup> A potential markholder cannot express her identity using content that would raise any of these inquiries if she desires the security of knowing that she will receive the benefits of a registered trademark. Under the majority's reasoning, such uncertainty represents a chilling of speech to be avoided.<sup>299</sup> Under well-established doctrine and trademark law precedent, the chilling is entirely constitutional.

The upshot of this discussion is that uncertainty in determining markholder rights is part and parcel with the trademark system. The fact that the anti-disparagement criterion yields uncertainty in application is consistent with other content-based trademark doctrines that determine the rights of markholders. If the anti-disparagement criterion is unconstitutional because of its uncertainty in application, so is the rest of trademark law.

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<sup>295</sup> In *In re Fred Gretsch Co.*, the Trademark Examiner refused to register *Nashville* as a mark for a guitar and amplifier on the grounds that the goods did not derive from the city Nashville. 159 U.S.P.Q. 60, 1968 WL 8164 (T.T.A.B. 1968). The mark, the Examiner held, would be deceptively misdescriptive, which would require a showing of secondary meaning. *Id.* On appeal, the Trademark Board reversed, holding Nashville to be a suggestive term that called to mind a country style of music played on the guitar. *Id.*

<sup>296</sup> See *Peaceable Planet, Inc. v. Ty, Inc.*, 362 F.3d 986, 988–92 (7th Cir. 2004) (concluding that markholder did not need to show secondary meaning for registration of the name Niles, despite trademark law's requirement that secondary meaning must be shown for personal names).

<sup>297</sup> See *Qualitex Co.*, 514 U.S. at 165 (“[I]n general terms, a product feature is functional, and cannot serve as a trademark, if it is essential to the use or purpose of the article or if it affects the cost or quality of the article, that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.” (quotation omitted)).

<sup>298</sup> These inquiries concern only the acquisition of rights. There is of course additional uncertainty surrounding the enforcement of rights, which would also raise speech concerns under the majority's reasoning. Second speakers of marks have a First Amendment right to express the mark in a way that is not infringing. Yet the question of infringement is anything but clear. To say the least, the eight-factor test for infringement raises subjective considerations. See *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (articulating test to determine infringement as consideration of “the strength of his make, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and the reciprocal of defendant's good faith in adopting its own mark, the quality of defendant's product, and the sophistication of the buyers”). Second speakers' protected speech may therefore be chilled by the uncertainty surrounding infringement.

<sup>299</sup> See *In re Tam*, 808 F.3d at 1341–42.

## CONCLUSION

In *In re Tam*, the majority set out to prove that the anti-disparagement criterion was unconstitutional. Its proof failed on four grounds. First, the majority failed to analyze the criterion under an exceptional free-speech framework that would have enabled greater discretion for the government to exercise content-based discrimination. This failure was based on an incorrect premise, i.e., that the disparaging element of a mark is expressive, whereas the source-identifying element of a mark is not. The premise is simply not true. By identifying the source of a mark, the markholder is expressing the way in which consumers should conceive of the source as well as any additional meaning that consumers should associate about the source. Hence, the majority was incorrect to distinguish a disparaging element from a source-identifying element on the basis of expressiveness. Both elements are expressive. Accordingly, any content-based criterion that targets either element of a mark—disparagement or source-identification—must be analyzed under the same free-speech framework. The distinctiveness criterion targets the source-identification element, and the only way for the distinctiveness criterion to be constitutional is for it to be analyzed under an exceptional free-speech framework. Therefore, the anti-disparagement criterion must also be analyzed under an exceptional free-speech framework.

Related to the issue of framework, the majority was incorrect to analyze the anti-disparagement criterion under a strict-scrutiny standard of review. The same standard of review must apply to both the anti-disparagement criterion and any government restrictions on expressions of self-identification, for both the criterion and any such restriction target speech protected by the First Amendment. Yet applying a strict-scrutiny standard to restrictions on expressions of self-identification would erase trademark law altogether. Trademark law inherently restricts speakers from identifying themselves by expressing a mark that someone else has already registered. Indeed, trademark law amounts to content-based restrictions of self-identification. Hence, for trademark law to be able to perform its content-discriminatory function, trademark law must be analyzed under a standard of review that is less stringent than strict scrutiny. That would include the anti-disparagement criterion.

Second, the majority failed to recognize that the anti-disparagement criterion supports the purpose of trademark law. This failure was based on an incorrect premise, namely, that the purposes of trademark law are limited to prevention of consumer confusion and preserving markholder goodwill. Those purposes are not the end of trademark law. They are means for achieving broader purposes, which includes promoting the collective mar-

ketplace and its efficient operation. The anti-disparagement criterion supports these broader purposes. Specifically, the criterion fosters consumer confidence in commercial transactions, such that consumers will not refrain from entering transactions simply because they disagree with a disparaging opinion. Likewise, the criterion discourages markholder goodwill for goods that could be detrimental to the marketplace or society generally.

Third, the majority failed to recognize that the anti-disparagement criterion is viewpoint neutral. The reasoning that the majority employed to reach its conclusion implies that trademark's anti-deception criterion is viewpoint discriminatory. Like the anti-disparagement criterion, the anti-deception criterion targets only one type of viewpoint—those that are deceptive—and it calls for a high level of subjectivity in its application. Moreover, like the anti-disparagement criterion, the anti-deception criterion relies on viewpoints of a group. Hence, to the extent that the anti-disparagement criterion is viewpoint discriminatory, the anti-deception criterion must also be, and that is absurd.

Fourth, the majority relied on the fact that uncertainty surrounds the application of the anti-disparagement criterion. Yet trademark law is fraught with uncertainty. Any of its standards for determining eligibility require subjective judgment over which reasonable minds often disagree. The anti-disparagement criterion is no different.

Thus, the context of trademark law exposes serious flaws in the majority's reasoning. Those flaws indicate a fundamental misunderstanding of trademark law, and for that matter, speech law as well. But more than that, the flaws suggest a much bigger problem. In addition to creating inconsistencies in trademark law, the majority has overturned a century of practice and decades of precedent. Simply put, neither reason, practice, nor precedent supports the majority. Indeed, the whole picture begins to look very different from a court undertaking its duty to protect free speech. It begins to look like a court imposing its view that Congress should not make laws reflecting moral judgment.<sup>300</sup> It begins to look viewpoint discriminatory.

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<sup>300</sup> See *id.* at 1338 (criticizing the anti-disparagement criterion on the grounds that its application requires “moral judgments”).