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## When Trademark Law Met Constitutional Law: How a Commercial Speech Theory Can Save the Lanham Act

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# WHEN TRADEMARK LAW MET CONSTITUTIONAL LAW: HOW A COMMERCIAL SPEECH THEORY CAN SAVE THE LANHAM ACT

**Abstract:** On June 19, 2017, the Supreme Court sent shockwaves through the bedrock of trademark law with its decision in *Matal v. Tam*. Justice Alito’s majority opinion declared the disparagement clause of the Lanham Act unconstitutional due to viewpoint discrimination. Two years later, on June 24, 2019, in *Iancu v. Brunetti*, the Court continued to shake the foundation of trademark law by declaring the immoral and scandalous clause of the Lanham Act unconstitutional due to viewpoint discrimination. Both the *Tam* and the *Brunetti* Courts, however, provided no enlightenment for practitioners regarding whether trademarks are commercial speech. By failing to answer this crucial question, the Court left open the issue of available limits on the government’s restrictions on speech, or if there are even limits at all. This Note argues that the law should treat trademarks as commercial speech. The *Central Hudson* test for intermediate scrutiny is appropriate for identifying a compelling government interest that is related to trademark restrictions at issue. Otherwise, a strict scrutiny analysis of trademarks jeopardizes a vast majority of the United States’ signature trademark act: the Lanham Act.

## INTRODUCTION

Trademarks define our commerce system, and with the recent Supreme Court cases *Matal v. Tam* and *Iancu v. Brunetti*, trademarks are defining the scope of government restrictions on free speech.<sup>1</sup> Trademarks indicate to consumers the source of a good or service.<sup>2</sup> Federal registration of a trademark with the United States Patent and Trademark Office (USPTO) provides a mark owner with the exclusive right to use the trademark throughout the United States.<sup>3</sup> In 1946, Congress enacted the Lanham Act to provide guidelines for

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<sup>1</sup> PETER S. MENELL, MARK A. LEMLEY & ROBERT P. MERGES, COPYRIGHTS, TRADEMARKS AND STATE IP PROTECTIONS 861 (2018); see *Iancu v. Brunetti*, 139 S. Ct. 2294, 2302 (2019) (addressing the constitutionality of speech restrictions against immoral and scandalous marks on trademark registration); *Matal v. Tam*, 137 S. Ct. 1744, 1764 (2017) (*Tam III*) (addressing the constitutionality of speech restrictions against disparaging marks on trademark registration).

<sup>2</sup> U.S. PATENT & TRADEMARK OFFICE, U.S. DEP’T OF COMMERCE, PROTECTING YOUR TRADEMARK: ENHANCING YOUR RIGHTS THROUGH FEDERAL REGISTRATION 2 (2018), <https://www.uspto.gov/sites/default/files/documents/BasicFacts.pdf> [<https://perma.cc/G335-UMS4>].

<sup>3</sup> *Id.* at 11.

trademark registration.<sup>4</sup> Although recent Supreme Court cases have altered the scope of the Lanham Act, this signature trademark act, as written, prohibits registration of offensive trademarks, confusing trademarks, trademarks that are immoral or scandalous, and trademarks that are geographically misdescriptive.<sup>5</sup> Through this Act, the USPTO registers over 240,000 trademarks a year, and most of these trademarks will never make headlines.<sup>6</sup> But when controversial trademarks capture the attention of the public and the courts, the ensuing cases have changed the face of trademark law.<sup>7</sup>

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<sup>4</sup> Trademark Act of 1946 (Lanham Act), Pub. L. No. 79-489, 60 Stat. 427 (codified as amended in scattered sections of 15 U.S.C.); Jordan Lewis, *The Future of Disparagement: How Trademark Law Suppresses Freedom of Speech* 4 (Apr. 9, 2017) (unpublished student note) (Southern University Law Center), [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2949497](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2949497) [<https://perma.cc/4KGX-Z2N9>]. Our federal government and judiciary system does not take lightly the restriction of expression inherent to any exclusive right to use a phrase and, consequently, has created a robust framework of governing law. See Ross A. Dannenberg & Heather R. Smith-Carra, *Balancing Free Speech and Trademark Rights*, BANNER & WITCOFF, Spring/Summer 2017, at 6, <https://bannerwitcoff.com/wp-content/uploads/2017/07/Balancing-Free-Speech-and-Trademark-Rights.pdf> [<https://perma.cc/E8F5-FRLR>] (noting the tension between First Amendment rights and trademark laws and the creation of the fair use doctrine, which allows third parties to use a registered mark if certain threshold requirements, like a lack of misleading customers, are met); U.S. PATENT & TRADEMARK OFFICE, *supra* note 2, at 3 (identifying threshold requirements for trademark registration, including the small likelihood of confusion with other marks and the strength of the mark's connection to the product or service). To promote the free flow of commerce, the government does not grant every trademark application. U.S. PATENT & TRADEMARK OFFICE, *supra* note 2, at 3; see Peter C. Christensen & Teresa C. Tucker, *The "Use in Commerce" Requirement for Trademark Registration After Larry Harmon Pictures*, 32 IDEA 327, 327 (1992) (describing the connection of the Commerce Clause to Congress's power to regulate trademark). Our modern trademark system, founded from the enactment of the Lanham Act of 1946, and in place for over half a century, allows the government to restrict the registration of certain trademarks. Christensen & Tucker, *supra*, at 327.

<sup>5</sup> 15 U.S.C. § 1052 (2012); see *Brunetti*, 139 S. Ct. at 2302 (holding that speech restrictions on trademark registration for immoral and scandalous marks are unconstitutional); *Tam III*, 137 S. Ct. at 1764 (holding that speech restrictions on trademark registration for disparaging marks are unconstitutional).

<sup>6</sup> See U.S. PATENT & TRADEMARK OFFICE, U.S. DEP'T OF COMMERCE, CITIZEN CENTRIC REPORT 2018, at 2 (2018) (detailing the registration of hundreds of thousands of trademarks). In 2018, the U.S. Patent and Trademark Office (USPTO) registered 273,808 trademarks. *Id.* This was an increase from the 242,709 registered trademarks in fiscal year 2017. *Id.*; U.S. PATENT & TRADEMARK OFFICE, U.S. DEP'T OF COMMERCE, CITIZEN CENTRIC REPORT 2017, at 2 (2017).

<sup>7</sup> See *In re Tam*, 808 F.3d 1321, 1342 n.7 (Fed. Cir. 2015) (*Tam II*), *aff'd*, 137 S. Ct. 1744 (focusing on inconsistency in the USPTO's registration of disparaging trademarks); *In re Steven Hershey*, 6 U.S.P.Q.2d 1470, 1472 (T.T.A.B. 1988) (reversing the USPTO's initial denial of trademark for the "BIG PECKER BRAND" on immoral and scandalous grounds); Fred Barbash, *Warning: This Article on Trademarks May Include Language Deemed "Scandalous, Immoral or Disparaging,"* WASH. POST (Sept. 30, 2016), <https://www.washingtonpost.com/news/morning-mix/wp/2016/09/30/the-idiotic-history-of-deeming-trademarks-scandalous-immoral-or-disparaging/> [<https://perma.cc/NZX6-LH7N>] (describing the sensationalism of several trademarks out of the thousands that are registered by the USPTO). In 1988, in the "BIG PECKER BRAND" case, the USPTO initially denied the trademark, finding "pecker" to be synonymous for "penis" and thus rendering it as vulgar. *In re Steven Hershey*, 6 U.S.P.Q.2d at 1470. On appeal to the Trademark Trial and Appeal Board (TTAB), the trademark applicant successfully convinced the Board that it intended "pecker" to refer to a bird, citing the bird imagery on the t-shirt tied to the trademark use. *Id.* at 1472. More recently, in 2011, the

In 2015, the U.S. District Court for the Eastern District of Virginia cancelled the long-standing trademark of the Washington Redskins, a team in the National Football League (NFL).<sup>8</sup> Plaintiffs challenged the trademark under the federal prohibition on disparaging or offensive marks.<sup>9</sup> The federal district court held that the Redskins' trademark offended and disparaged Native Americans, and, as such, the mark was not entitled to federal trademark protections.<sup>10</sup> The Washington Redskins appealed the decision, which was stayed pending resolution of another case challenging the disparaging clause as a free speech violation: *Matal v. Tam*, a case which the Supreme Court would hear in 2017.<sup>11</sup> In *Tam*, an Asian-American rock band appealed the denial of its trademark application for its band name, "THE SLANTS."<sup>12</sup> Despite the band's desire to reclaim the derogatory term "slants," the USPTO denied registration because it found the term was nonetheless offensive to Asians.<sup>13</sup> On appeal in

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USPTO denied registration of the trademark "HAVE YOU HEARD SATAN IS A REPUBLICAN" due to the phrase's disparagement of the Republican party. *Tam II*, 808 F.3d at 1342 n.7. In 2013, however, the USPTO did not find a similar trademark, "THE DEVIL IS A DEMOCRAT," to disparage the Democratic party. *Id.* The inevitable appearance of arbitrariness in the USPTO's reviewing of immoral, scandalous, or disparaging trademarks led the Supreme Court in 2017 to address the unconstitutionality of prohibitions against disparaging trademarks. *See Tam III*, 137 S. Ct. at 1765 (granting certiorari to resolve whether the disparagement clause in § 2(a) of the Lanham Act is unconstitutional under the First Amendment). Following the Court's decision on disparagement prohibitions, the Court in 2019 granted certiorari to resolve the constitutionality of prohibitions against immoral and scandalous trademarks. *See Iancu v. Brunetti*, 139 S. Ct. 782 (2019) (granting certiorari to address whether the immoral or scandalous clauses of § 2(a) of the Lanham Act are unconstitutional under the First Amendment). The Court held the immoral and scandalous clause was unconstitutional because it improperly restricted First Amendment rights. *Brunetti*, 139 S. Ct. at 2302.

<sup>8</sup> *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 490 (E.D. Va. 2015). The football franchise first used the team name "Redskins" in 1933. *Id.* at 448. By 1967, the USPTO registered the trademark, renewing it most recently in 2015. *Id.* Although the Washington Redskins is not the only potentially offensive national sports team name, teams nationwide have trended toward shifting their names to less offensive ones. Mark Conrad, *Matal v. Tam—A Victory for the Slants, a Touchdown for the Redskins, but an Ambiguous Journey for the First Amendment and Trademark Law*, 36 CARDOZO ARTS & ENT. L.J. 83, 105–06 (2018). Like the Redskins trademark, the Cleveland Indians baseball team and the Chicago Blackhawks hockey team are unlikely to alter their team names despite requests to do so. *Id.* at 125 n.250. In the wake of criticism, however, many collegiate teams renamed themselves, including Stanford University, which changed its mascot from an Indian to a Cardinal and St. John's University, which altered its team name from "Redman" to "Red Storm." *List of Schools That Changed Native American Nicknames*, USA TODAY (Sept. 24, 2013), <https://www.usatoday.com/story/sports/2013/09/12/native-american-mascot-changes-ncaa/2804337/> [<https://perma.cc/9P4M-8U3K>].

<sup>9</sup> 15 U.S.C. § 1052(a) (2012); *Pro-Football, Inc.*, 112 F. Supp. 3d at 490.

<sup>10</sup> *Pro-Football, Inc.*, 112 F. Supp. 3d at 472.

<sup>11</sup> 137 S. Ct. at 1765; Conrad, *supra* note 8, at 112.

<sup>12</sup> *Tam III*, 137 S. Ct. at 1747; *see infra* notes 161–177 (explaining that the band first appealed the examiner's denial of its trademark appeal to the TTAB, and then to the Federal Circuit; after an *en banc* ruling, the government appealed the decision to the Supreme Court).

<sup>13</sup> *Tam III*, 137 S. Ct. at 1747.

2017, the Supreme Court reversed the decision of the USPTO and ruled that the prohibition against disparaging trademarks was unconstitutional.<sup>14</sup>

With one decision, the Supreme Court in *Tam* threw into doubt longstanding precedent on the constitutionality of key portions in the Lanham Act.<sup>15</sup> Although the boundaries of government restrictions on speech are still evolving before the Court, Justice Alito's majority opinion in *Tam* suggested what speech is constitutionally permissible for the government to restrict.<sup>16</sup> In a unanimous opinion, the Court held that the provision of the Lanham Act that prohibited registering any disparaging trademarks was an unconstitutional restriction of speech.<sup>17</sup> The provision at issue was the disparagement clause that required a trademark examiner to refuse federal registration of a trademark if the trademark at issue offends a "substantial composite of the referenced group."<sup>18</sup> In *Tam*, the Court found the disparagement clause to be a content-based restriction that allowed trademark examiners to engage in unconstitutional viewpoint discrimination.<sup>19</sup> Viewpoint-based restrictions are restrictions, imposed by a state actor, which offend the First Amendment by allowing some views and prohibiting other disfavored views.<sup>20</sup> This is in contrast to content-neutral restrictions that regulate all related speech based on "time, place, and manner," rather than on content.<sup>21</sup> In *Tam*, the Court limited its viewpoint discrimination analysis to the disparagement clause.<sup>22</sup> Yet § 2(a) of the Lanham Act, the section that contains the disparagement clause, also contains a prohibi-

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<sup>14</sup> *Id.* at 1765.

<sup>15</sup> *See id.* (modifying longstanding precedent on the constitutionality of the Lanham Act and holding, by a unanimous court, that the disparagement clause of the Act violates the Constitution); *Matal v. Tam*, 131 HARV. L. REV. 243, 243 (2017) (describing the "New *Lochner*" era of commercial speech deregulation that followed the decision in *Tam III*).

<sup>16</sup> *See* KENT GREENFIELD, CORPORATIONS ARE PEOPLE TOO (AND THEY SHOULD ACT LIKE IT) 167–70 (2018) (outlining the current state of available government restrictions on corporations); *see, e.g., Brunetti*, 139 S. Ct. at 2302 (holding trademark restrictions against immoral and scandalous marks unconstitutional); *Tam III*, 137 S. Ct. at 1764 (holding trademark restrictions against disparaging marks unconstitutional).

<sup>17</sup> *Tam III*, 137 S. Ct. at 1765; *see* 15 U.S.C. § 1052 (prohibiting registration of disparaging marks); *infra* notes 157–189 and accompanying text (detailing the facts and evolution of *Tam III* to the Supreme Court).

<sup>18</sup> *Tam III*, 137 S. Ct. at 1754; *see* U.S. PATENT & TRADEMARK OFFICE, U.S. DEP'T OF COMMERCE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1203.03(b)(i) (2014) [hereinafter TRADEMARK MANUAL] (using the substantial composite test first formulated in *In re McGinley*, 660 F.2d 481, 483 (C.C.P.A. 1981)).

<sup>19</sup> *Tam III*, 137 S. Ct. at 1751.

<sup>20</sup> *Id.*

<sup>21</sup> *Rosenberger v. Rector of the Univ. of Va.*, 515 U.S. 819, 829 (1995); Conrad, *supra* note 8, at 101 n.97; Timothy T. Hsieh, *The Hybrid Trademark and Free Speech Right Forged from Matal v. Tam*, 7 NYU J. INTELL. PROP. & ENT. L. 1, 16–17 (2018).

<sup>22</sup> *Tam III*, 137 S. Ct. at 1753.

tion on registering trademarks that are of an immoral or scandalous nature.<sup>23</sup> The Court left the constitutionality of the immoral and scandalous clause untouched in the *Tam* decision, leaving the issue open for a future case.<sup>24</sup>

The *Tam* Court also refrained from defining the level of scrutiny that trademark restrictions must withstand.<sup>25</sup> Scrutiny analysis aids the Court in

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<sup>23</sup> 15 U.S.C. § 1052(a). Although the text of the clause refers to immoral *or* scandalous marks, the USPTO and case law refer to the two terms as a “single category.” Thus, for purposes of this Note, the terms will be referred to as the immoral *and* scandalous clauses. Brief of Petitioner at 6, *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019) (No. 18-302), 2019 WL 913833, at \*6; *In re McGinley*, 660 F.2d at 484 n.6.

<sup>24</sup> *Tam III*, 137 S. Ct. at 1753. The *Tam III* decision only explicitly discussed the disparagement clause of § 2(a) of the Lanham Act. *Id.* Section 2(a), however, also prohibits registration of “immoral” and “scandalous” marks; lower courts have held these prohibitions unconstitutional using the same rationale as the Supreme Court in *Tam III*. *Brunetti*, 139 S. Ct. at 2302; *Tam III*, 137 S. Ct. at 1753; *see In re Brunetti*, 877 F.3d 1330, 1357 (Fed. Cir. 2017) (holding the immoral and scandalous clause of the Lanham Act unconstitutional for similar viewpoint discrimination reasons after examiner denied applicant’s “FUCTION” clothing trademark on immoral and scandalous grounds), *cert. granted*, 139 S. Ct. 782 (2019). The Supreme Court granted certiorari to *In re Brunetti* on January 6, 2019, after an unopposed petition by the government asked the Court to consider whether the immoral and scandalous clauses of the Lanham Act are facially invalid under the First Amendment. 139 S. Ct. at 782; Petition for Writ of Certiorari at 1, *Brunetti*, 139 S. Ct. 2294 (2019) (No. 18-302), 2018 WL 4331883. The plaintiff-respondent, Brunetti, asked the Court to additionally consider whether the clauses are void for vagueness and thus unconstitutional because of free speech and due process concerns. Dennis Crouch, *What the Fu\*\*—Supreme Court Agrees to Hear Brunetti Trademark Dispute*, PATENTLYO BLOG (Jan. 6, 2019), <https://patentlyo.com/patent/2019/01/supreme-brunetti-trademark.html> [<https://perma.cc/N7EL-JWQ2>]. Importantly, neither the government nor Brunetti asked the Court to consider whether trademarks are commercial speech. *See id.* (noting that the parties asked the Court only to answer whether the immoral and scandalous clauses are facially invalid or void for vagueness). The Court only considered whether the immoral and scandalous clauses are facially invalid. *Brunetti*, 139 S. Ct. at 2298. Given the Court’s reluctance to address the commercial speech question in *Tam III*, it is unsurprising that the Court did not raise the issue *sua sponte*. *See Tam III*, 137 S. Ct. at 1749 (declining to answer the question of whether trademarks are commercial speech); *infra* notes 251–287 and accompanying text (arguing a commercial speech theory of trademarks would provide a uniform and predictive analysis for deciding such issues). Writing for the Court, Justice Elena Kagan held the First Amendment concerns at issue in *Brunetti* are reminiscent of those in *Tam III*. *Brunetti*, 139 S. Ct. at 2298–99. She reasoned that, like the disparaging clause in *Tam* that the Court found unconstitutional based on viewpoint discrimination, the disputed clause in *Brunetti* was also unconstitutional due to viewpoint discrimination. *Id.* at 2299. Justice Samuel A. Alito, Jr., who wrote the majority in *Tam III*, concurred in the judgment in *Brunetti*. *Id.* at 2303 (Alito, J., concurring). He alluded to the nuances in his stance on viewpoint discrimination by suggesting that Congress could restrict vulgar statements by creating a narrower statute. *Id.* Justice Sonia Sotomayor prioritized a savings interpretation of the statute to avoid striking the clause in its entirety. *Id.* at 2311 (Sotomayor, J., concurring in part, dissenting in part). She sought to uphold the scandalous piece of the clause as it reaches “obscenity, vulgarity, and profanity,” which have been viewed by prior decisions as outside the reach of First Amendment protections. *Id.* at 2308. Following Justice Sotomayor’s reasoning, Chief Justice John G. Roberts, Jr. similarly concurred in part by striking the immoral part of the Lanham Act and dissented in part by finding the scandalous part of the clause to be constitutional. *Id.* (Roberts, C.J., concurring in part, dissenting in part). Also, concurring in part and dissenting in part, Justice Stephen G. Breyer was the only justice to mention “commercial speech.” *Id.* at 2304–05 (Breyer, J., concurring in part, dissenting in part). Nonetheless, he too declined to provide a concrete answer on the nature of trademarks as commercial speech. *Id.*

determining the constitutionality of speech restrictions—strict scrutiny is the highest level of scrutiny and, consequently, the lowest level of deference a court may afford to the government’s justification for its speech restriction.<sup>26</sup> When a speech restriction like a trademark prohibition faces strict scrutiny, the government must prove first that it has a “compelling interest” in implementing its restriction, and second that the restriction is narrowly tailored to meet that interest.<sup>27</sup> The lowest level of scrutiny is rational basis review, requiring the government only to have a “legitimate interest” for its restriction.<sup>28</sup> The next level is intermediate scrutiny, which requires the government to prove it has a “substantial interest” in its regulation, and that the regulation is narrowly tailored to that interest.<sup>29</sup> Commercial speech—speech that implicates a business transaction—is subject to intermediate scrutiny, and such speech requires the government to assert a substantial interest directly related to its restriction.<sup>30</sup> In contrast, non-commercial speech, which includes both individual speech and everything outside the realm of commercial speech, is subject to the higher burden of a strict scrutiny analysis.<sup>31</sup> Despite the scrutiny distinction between commercial and non-commercial speech, the Court remained silent on what level of scrutiny to afford the disparagement clause.<sup>32</sup>

Although the decision in *Tam* illuminated the intersection of trademark law and First Amendment rights, the holding left practitioners in the dark on whether the “immoral” and “scandalous” provisions of § 2(a) of the Lanham

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<sup>25</sup> *Tam III*, 137 S. Ct. at 1749. This Note considers in depth the analysis of the *Tam* decision, as its progeny—the *Brunetti* decision—builds on the analysis *Tam* laid out. See *Brunetti*, 139 S. Ct. at 2297 (citing to *Tam* and finding the immoral and scandalous clause of the Lanham Act unconstitutional based on viewpoint discrimination). This is due to the fact that the *Brunetti* Court used the same reasoning of the *Tam* court to find the disparagement clause unconstitutional. *Id.* Notably, the *Tam* decision explicitly refrains from addressing whether trademarks are commercial speech, whereas the *Brunetti* opinion does not mention “commercial speech” at all. Compare *Tam III*, 137 S. Ct. at 1764 (explicitly declining to “resolve the dispute” over whether trademarks are commercial speech), with *Brunetti*, 139 S. Ct. at 2302 (making no mention of “commercial speech” in the Court’s opinion).

<sup>26</sup> GREENFIELD, *supra* note 16, at 137.

<sup>27</sup> *Id.* A restriction on speech is narrowly tailored when it limits speech no more than is necessary to serve the government’s compelling interest. *Frisby v. Schultz*, 487 U.S. 474, 485 (1988).

<sup>28</sup> GREENFIELD, *supra* note 16, at 137.

<sup>29</sup> *Id.*

<sup>30</sup> *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 562–64 (1980).

<sup>31</sup> *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 68 (1983). Although there is no explicit statutorily defined or judge-made distinction between commercial and non-commercial speech, the Court attempted to create a test to categorize whether speech is commercial or not. *Id.* at 66; Jennifer L. Pomeranz & Sabrina Adler, *Defining Commercial Speech in the Context of Food Marketing*, 2015 J.L. MED. & ETHICS, 40, 41. The test asks whether the speech is meant to be an advertisement, whether the focus of the speech is advertising a specific product, and if the speaker has an economic motivation in the speech. *Bolger*, 463 U.S. at 65–67.

<sup>32</sup> See *Tam III*, 137 S. Ct. at 1749 (refraining from considering whether trademarks are commercial speech).

Act are constitutional, and whether trademarks are commercial speech.<sup>33</sup> If trademarks are not commercial speech, then the government will likely fail to meet the high burden required to survive strict scrutiny analysis for trademark restrictions, leading to further dismantling of the Lanham Act.<sup>34</sup> A commercial speech analysis of trademarks will preserve the modern trademark system that protects against dilution and tarnishment of marks, which are arguably content-based restrictions that would only be upheld as constitutional under an intermediate scrutiny analysis.<sup>35</sup> Because commercial speech receives intermediate scrutiny, some content-based restrictions receive intermediate rather than strict scrutiny.<sup>36</sup>

The *Tam* decision only addressed the binary distinction between content-based and content-neutral speech and unfortunately failed to address how commercial speech intersects with that binary.<sup>37</sup> Thus, the extent to which the government can restrict trademark registration based on the mark's content and the future of the Lanham Act remain open questions.<sup>38</sup> This Note argues that

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<sup>33</sup> See *id.* (leaving open the question of whether trademarks are commercial speech). Compare Conrad, *supra* note 8, at 141–42 (arguing that the Court should abandon the artificial distinction between commercial and non-commercial speech altogether), with Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, 92 NOTRE DAME L. REV. 381, 382 (2016) (addressing the importance of maintaining a distinction between commercial and non-commercial speech).

<sup>34</sup> See Trademark Dilution Revision Act, Pub. L. No. 106-312, § 2, 120 Stat. 1730, 1730–32 (2006) (updating the cause of action for dilution first articulated in the Federal Dilution Act, Pub. L. No. 104-98, 109 Stat. 985, 985–87 (1995) (codified at 15 U.S.C. §§ 1125(c), 1127), which allows a registered trademark owner to preserve the distinctiveness and reputation of the mark's brand through litigation); *Tam III*, 137 S. Ct. at 1749 (declining to specify that trademarks are commercial speech); *infra* notes 251–287 (discussing how, under a strict scrutiny analysis, the immoral and scandalous clauses would likely be found unconstitutional and the Federal Dilution Act, which complements the Lanham Act, would also be found unconstitutional).

<sup>35</sup> See Trademark Dilution Revision Act § 2 (revising causes of action for dilution and tarnishment from Federal Dilution Act, Pub. L. No. 104-98, 109 Stat. 985, 985–87 (1995) (codified at 15 U.S.C. §§ 1125(c), 1127)); *Tam III*, 137 S. Ct. at 1749 (refraining from establishing whether trademarks are commercial speech); Lynda J. Oswald, *Tarnishment and Blurring Under the Federal Trademark Dilution Act of 1995*, 36 AM. BUS. L.J. 255, 263–64 (1999) (defining dilution by blurring and dilution by tarnishment); *infra* notes 251–287 (detailing how an intermediate scrutiny analysis preserves trademark restrictions on speech). Dilution by blurring provides a cause of action when a mark potentially loses its uniqueness in the marketplace. Oswald, *supra*, at 263–64. Dilution by tarnishment, on the other hand, provides a cause of action when a mark owner's reputation is potentially damaged. *Id.*

<sup>36</sup> GREENFIELD, *supra* note 16, at 137; see *Tam III*, 137 S. Ct. at 1749 (hinting that a content-based restriction could be constitutional under an intermediate scrutiny analysis, but that the disparagement clause at issue was unconstitutional due to viewpoint discrimination).

<sup>37</sup> See *Tam III*, 137 S. Ct. at 1749 (failing to engage in a commercial speech analysis and focusing instead on the content-based analysis).

<sup>38</sup> See *id.* (ruling narrowly on the disparagement clause and refraining from interpreting its effects on other clauses within § 2(a) of the Lanham Act); *supra* note 19 and accompanying text (analyzing the implications of the Court granting certiorari in *In re Brunetti*, 877 F.3d 1330 (Fed. Cir. 2017), *cert.*



trademarks are a form of commercial speech and should receive intermediate scrutiny.<sup>39</sup> Failing to define trademarks as commercial speech could endanger large parts of the Lanham Act.<sup>40</sup> This consequence only happens under a strict scrutiny analysis.<sup>41</sup> But under intermediate scrutiny, the government may regulate registration of trademarks so long as there is a substantial government interest that is narrowly tailored to the regulation.<sup>42</sup> The substantial government interest in trademark regulation is in ensuring the free flow of commerce.<sup>43</sup>

Part I of this Note begins by describing the history of trademark law and the previous standards for evaluating the disparagement clause.<sup>44</sup> Part I further explains the distinctions between commercial versus non-commercial speech and content-based versus content-neutral restrictions.<sup>45</sup> Finally, Part I summarizes the key takeaways from *Tam* including its multiple concurrences and its holdings at the lower court levels.<sup>46</sup> Part II of this Note discusses the fate of the immoral and scandalous clause of the Lanham Act and the likely effects that would result if the remaining clauses were declared unconstitutional.<sup>47</sup> Part III

*granted*, 139 S. Ct. 782, and reasoning the immoral and scandalous clauses of the Lanham Act are unconstitutional on the same viewpoint discrimination grounds as in *Tam III*, 137 S. Ct. at 1749).

<sup>39</sup> See *infra* notes 251–287 and accompanying text (detailing how an intermediate scrutiny analysis will preserve trademark restrictions in the Lanham Act).

<sup>40</sup> See *infra* notes 251–273 and accompanying text (describing how under a strict scrutiny analysis, rather than an intermediate scrutiny analysis, parts of the Lanham Act that include the immoral and scandalous clauses and registration restrictions based on dilution would be held unconstitutional).

<sup>41</sup> See *infra* notes 251–287 and accompanying text (reasoning that a strict scrutiny analysis will have widespread effects on the constitutionality of dilution law). Moreover, a strict scrutiny analysis would place a higher burden on the government to identify a substantial government interest, thus leading to greater government regulation of advertising restrictions. See *infra* notes 251–287 and accompanying text.

<sup>42</sup> John V. Tait, Note, *Trademark Regulations and the Commercial Speech Doctrine: Focusing on the Regulatory Objective to Classify Speech for First Amendment Analysis*, 67 *FORDHAML. REV.* 897, 911 n.122 (1998).

<sup>43</sup> 15 U.S.C. § 1127 (2012) (acknowledging that the intent of the Lanham Act is to “regulate commerce”); Brief of Petitioner at 8, *Lee v. Tam*, 137 S. Ct. 30 (2016) (No. 15-1293), 2016 WL 6678795 (identifying the government’s asserted interest in regulating the flow of commerce). Michelle K. Lee was the Under Secretary of Commerce for Intellectual Property and Director of the USPTO until June 2017 when Joseph Matal was named Interim Director of the USPTO. See *Joseph Matal*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/about-us/executive-biographies/joseph-matal> [<https://perma.cc/L32M-QBB7>]; *Michelle K. Lee*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/about-us/executive-biographies/michelle-k-lee> [<https://perma.cc/L4VU-CS6W>].

<sup>44</sup> See *infra* notes 57–114 and accompanying text (summarizing the state of the Lanham Act prior to the Court’s decision in *Tam III*).

<sup>45</sup> See *infra* notes 115–153 and accompanying text (discussing the distinction between commercial and non-commercial speech for First Amendment protection analysis).

<sup>46</sup> See *infra* notes 154–189 and accompanying text (describing the evolution of *Tam* up to and including the decision by the Court in *Tam III*).

<sup>47</sup> See *infra* notes 190–250 and accompanying text (describing the arguments for and against trademarks’ characterization as commercial speech and the potential effects on other aspects of the Lanham Act based on that characterization).

proposes an answer to the dodged question in *Tam* on the commercial speech status of trademarks—that trademarks are in fact commercial speech.<sup>48</sup>

### I. HOW THE DISPARAGEMENT CLAUSE RESTRICTED TRADEMARK REGISTRATION, AND THE IMPACT OF ITS EVENTUAL DISMANTLING ON FREE SPEECH LAW

The Lanham Act first codified trademark statutory law in 1946, and it has remained largely unchanged since its most recent amendment in 2006.<sup>49</sup> But recently, the Supreme Court called into question key statutory restrictions on trademarks, raising greater doubts about the legitimacy of the government’s ability to regulate trademarks at all.<sup>50</sup> When the Court in *Matal v. Tam* held that the disparagement clause was facially unconstitutional, it opened the flood-

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<sup>48</sup> See *infra* notes 251–287 and accompanying text (arguing that trademarks are commercial speech because of the widespread impacts that would likely occur if trademarks did not receive an intermediate scrutiny analysis).

<sup>49</sup> See Trademark Dilution Revision Act § 2 (updating the Lanham Act, specifically modifying the requirement to prove dilution to be likelihood of dilution rather than evidence of actual dilution). Before *Tam III*, the last case to consider the constitutionality of the Lanham Act’s registration requirements was *In re McGinley*, 660 F.2d 481, 484–85 (C.C.P.A. 1981); see Lisa P. Ramsey, *A Free Speech Right to Trademark Protection?*, 106 TRADEMARK REP. 797, 817 (2016) (arguing that like its holding in *In re McGinley*, the Court should uphold the constitutionality of § 2(a) of the Lanham Act). The U.S. Court of Customs and Patent Appeals, which is the predecessor to the U.S. Court of Appeals for the Federal Circuit, heard *In re McGinley* in 1981. Federal Courts Improvement Act, Pub. L. No. 97-164, § 122, 96 Stat. 25, 36 (1982); 660 F.2d at 482. *In re McGinley* concerned a trademark application for a mark used in a newsletter covering interpersonal relationships. 660 F.2d at 482. The mark was a photograph of a naked couple hugging and kissing. *Id.* The photograph also depicted the male’s exposed genitalia. *Id.* The USPTO declined to register the mark because of its immoral and scandalous nature. *Id.* On appeal, the U.S. Court of Customs and Patent Appeals denied the trademark applicant’s claim that § 2(a) of the Lanham Act was an infringement on his free speech rights. *Id.* at 484. The court held that § 2(a) of the Lanham Act, prohibiting immoral and scandalous marks, was constitutional. *Id.* The court reasoned that denial of a trademark application did not suppress speech because the applicant could still use the mark freely, albeit without the federal government’s promise of exclusive use. *Id.* The court further stated that the scandalous clause was not void for vagueness because the clause provided sufficient notice to applicants that the USPTO would not approve marks that are immoral and scandalous. *Id.* at 485.

<sup>50</sup> See Hsieh, *supra* note 21, at 3 (justifying the new “hybrid Free Speech trademark right” due to the balancing concerns between the First Amendment and intellectual property rights). One scholar celebrated the ruling in *Tam III* because removal of content-based restrictions on trademarks brought trademark law into alignment with the rest of intellectual property law, as there are virtually no bars on registration based on the content of any copyright or patent. *Id.* For example, copyright law allows protection for any work in a fixed medium so long as it meets threshold originality requirements. 17 U.S.C. § 103 (2012); Hsieh, *supra* note 21, at 3. In patent law, the only major content restriction is a rarely enforced and arguably obsolete restriction on atomic weapon patents. Hsieh, *supra* note 21, at 3. The scholar argued that, as demonstrated by copyright and patent law, embracing the full potential of First Amendment protections does not hinder intellectual property development and can even encourage its progress. *Id.* at 24. For instance, removing content-based restrictions on offensive trademarks empowers historically underrepresented groups, like the Asian-American rock group “THE SLANTS” in *Tam III*, to reclaim derogatory language. *Id.* The scholar further argued that First Amendment concerns outweigh any governmental need for trademark restrictions. *Id.*

gates for further Lanham Act challenges.<sup>51</sup> If tasked with determining whether the Lanham Act's registration requirements are intolerable restrictions on speech, the Court will likely be forced to decide the level of scrutiny that trademark regulations must withstand.<sup>52</sup>

This Part explains why the *Tam* decision impacts larger free speech case law and how the looming questions left by *Tam* might affect the analysis of future First Amendment rights cases.<sup>53</sup> Section A highlights how courts previously interpreted the disparagement clause of the Lanham Act as a constitutionally valid measure to restrict registration of offensive and derogatory trademarks.<sup>54</sup> Section B explains the modern commercial speech and content-neutral theories that enlighten the boundaries of free speech that the government may regulate.<sup>55</sup> Section C discusses the evolution of *Tam* from the lower courts to the Supreme Court, and the open question of whether trademarks are commercial speech.<sup>56</sup>

### A. *The Lanham Act's Restriction on Registering Derogatory and Offensive Trademarks*

Trademarks prevent consumer confusion by granting mark owners exclusive use of registered symbols, words, and phrases that represent the products and services they sell.<sup>57</sup> This allows customers to distinguish between different goods and services, especially in crowded marketplaces.<sup>58</sup> Accordingly, in 1870, in an effort to regulate the marketplace at the federal level, Congress enacted the first comprehensive trademark registration act.<sup>59</sup> By 1876, however, in evaluating a series of three consolidated cases that would later become known as the *Trade-Mark Cases*—*United States v. Steffens*, *United States v.*

<sup>51</sup> 137 S. Ct. at 1749; see *In re Brunetti*, 877 F.3d at 1357 (challenging the aspect of the content-based restrictions of the immoral and scandalous clauses that *Tam III* did not discuss).

<sup>52</sup> See *infra* notes 251–259 and accompanying text (arguing that if the Court does not determine whether trademarks receive intermediate scrutiny, then other aspects of the Lanham Act, such as protections against dilution, likely will be held unconstitutional).

<sup>53</sup> See *infra* notes 57–189 and accompanying text (providing context for the question created by the Court's decision in *Tam III*).

<sup>54</sup> See *infra* notes 57–114 and accompanying text (discussing the prior state of the disparagement clause before the Court's decision in *Tam III*).

<sup>55</sup> See *infra* notes 115–153 and accompanying text (detailing the prevailing theories describing the distinction between commercial and non-commercial speech).

<sup>56</sup> See *infra* notes 154–189 and accompanying text (explaining the history of the *Tam* decision and opinions throughout the case's procedural history).

<sup>57</sup> Russ VerSteeg, *Historical Perspectives & Reflections on "Matal v. Tam" and the Future of Offensive Trademarks*, 25 J. INTEL. PROP. L. 109, 134 (2017); Tait, *supra* note 42, at 901 (correlating innovation and growth during the industrial revolution of the late 1800s with the need for a unified trademark system).

<sup>58</sup> VerSteeg, *supra* note 57, at 134.

<sup>59</sup> An Act to Revise, Consolidate, and Amend the Statutes Relating to Patents and Copyrights, §§ 77–84, 16 Stat. 198, 210–12 (1870). Under the Act, the first user of a mark has exclusive rights to the mark over any subsequent users of the mark. *Id.* at 211.

*Wittman*, and *United States v. Johnson*—the Supreme Court ruled that Congress’s first attempt at uniform trademark law was unconstitutional because the act at issue did not limit that the applied-for trademarks be used in commerce.<sup>60</sup> Such a limitation was necessary in any trademark legislation because Congress’s sole power to regulate trademarks comes from the Commerce Clause in the Constitution.<sup>61</sup> The Commerce Clause allows Congress to regulate activity that both directly and indirectly affects interstate commerce, and the heart of trademark is commerce.<sup>62</sup>

The Lanham Act codifies modern federal trademark law.<sup>63</sup> Representative Fritz G. Lanham of the U.S. House of Representatives first proposed the Act in 1938.<sup>64</sup> In 1946, after much tinkering and rewriting, Congress passed the Lanham Act, creating federal trademark registration requirements.<sup>65</sup> To obtain federal registration, an applicant must first file with the USPTO.<sup>66</sup> The Act requires that the mark be used “in commerce” to be eligible for trademark protection by the government.<sup>67</sup> Applications for trademarks must meet three basic

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<sup>60</sup> See *Trade-Mark Cases*, 100 U.S. 82, 91–92, 99 (1879) (consolidating three cases in an appeal to determine whether Congress had any constitutional authority to regulate trademarks and if so where that power rested in the Constitution); Christiansen & Tucker, *supra* note 4, at 329.

<sup>61</sup> *Trade-Mark Cases*, 100 U.S. at 96–97. Congress derives its authority to regulate patents and copyrights from Article I, § 8, cl. 8 of the Constitution; because this clause excludes trademarks, Congress instead uses the Commerce Clause to regulate trademarks. Christiansen & Tucker, *supra* note 4, at 329 n.18.

<sup>62</sup> Christiansen & Tucker, *supra* note 4, at 329–30. The scope of the Commerce Clause is broad. See *Wickard v. Filburn*, 317 U.S. 111, 124 (1942) (holding that the individual intrastate activity of a wheat farmer can substantially affect interstate commerce). Cases emerging from the Civil Rights era shed light on the broad scope of Congress’s power under the Commerce Clause. Christiansen & Tucker, *supra* note 4, at 328. In a unanimous decision in *Katzenbach v. McClung*, the Supreme Court found that the Civil Rights Act of 1964 soundly prohibited a local restaurant, Ollie’s BBQ, from discriminating against African Americans because of their race. 379 U.S. 294, 305 (1964). Even though the restaurant allegedly served no out of state customers, its procurement of produce from out of state brought its conduct within the scope of the Commerce Clause. *Id.* at 294, 296. Decided the same day as *Katzenbach*, in another unanimous decision, the Court in *Heart of Atlanta Motel v. United States* held that public accommodation restrictions prohibiting racial discrimination also applied to private motels that serviced out-of-state residents. *Katzenbach*, 379 U.S. at 294; *Heart of Atlanta Motel v. United States*, 379 U.S. 241, 261 (1964).

<sup>63</sup> Rebecca Tushnet, *Trademark Law as Commercial Speech Regulation*, 58 S.C. L. REV. 737, 755–56 (2007); Beverly Pattishall, *The Lanham Trademark Act at Fifty—Some History and Comment*, 86 TRADEMARK REP. 442, 442 (1996).

<sup>64</sup> Pattishall, *supra* note 63, at 442.

<sup>65</sup> *Id.* Federal registration provides better protections than those afforded by traditional common law. Tait, *supra* note 42, at 905. For example, if the mark owner registers the mark with the USPTO and is a party to a trademark infringement action, there is a *prima facie* presumption that the owner has an exclusive right to use the mark. *Id.* After five years, the owner can file for a declaration of incontestability, meaning there is a presumption that the mark itself is valid. 15 U.S.C. § 1115 (2012); Tait, *supra* note 42, at 905.

<sup>66</sup> 15 U.S.C. § 1051 (2012).

<sup>67</sup> Christiansen & Tucker, *supra* note 4, at 329–30. Initially, the Supreme Court instituted a three-part test to determine whether the mark owner can use the Lanham Act’s protections. *Steele v. Bulova*

statutory requirements: (1) they must be filed by the owner; (2) they must identify the type of entity (whether an individual or corporation) applying for the trademark and the owner's citizenship status; and (3) they must establish actual or intended use of the trademark in commerce.<sup>68</sup> The mark must also not be "merely descriptive," and it must be distinct such that the product or service is tied to the mark in the eyes of the consumer.<sup>69</sup> If a trademark meets the above requirements, the USPTO will register the mark unless it falls within one of several restrictions enumerated in § 2(a) of the Act.<sup>70</sup> For example, one of § 2(a)'s provisions restricts registration of trademarks if the mark is immoral, scandalous, or disparaging.<sup>71</sup> Other prohibitions on trademark registration include whether the trademark is likely to cause confusion with another mark, is merely descriptive and not distinctive, or is primarily geographically deceptively misdescriptive.<sup>72</sup>

Although the mark owner retains common law trademark protections even if the USPTO does not approve a trademark, those protections are limited in scope.<sup>73</sup> Our country allows common law protections for the first use of a trademark within a geographic area.<sup>74</sup> Common law use protections only remain as long as the owner of the mark continues to use it deliberately and does

Watch Co., 344 U.S. 280, 283, 286 (1952). The test is satisfied if (1) the trademark is used "in commerce"; (2) the defendant is a U.S. Citizen; and (3) there is no conflict with foreign law. *Id.* Due to the unique jurisdiction questions that the Internet presents, other circuits have eased the requirements of the test to encompass otherwise valid marks that did not meet all prongs of the test. Rami S. Yanni & Robert Zelnick, *The Evolving Law on Application of U.S. Trademark Laws Beyond U.S. Borders*, MCDERMOTT WILL & EMERY (June 2, 2006), <http://www.mondaq.com/unitedstates/x/40184/Trademark/The+Evolving+Law+on+Application+of+US+Trademark+Laws+Beyond+US+Borders> [https://perma.cc/BDE2-GS45].

<sup>68</sup> 15 U.S.C. § 1051.

<sup>69</sup> *Id.* § 1052; U.S. PATENT & TRADEMARK OFFICE, *supra* note 2, at 7.

<sup>70</sup> *See* 15 U.S.C. § 1052(a) (prohibiting registration based on certain characteristics, including where the mark is immoral, deceptively, or scandalous).

<sup>71</sup> *Id.*

<sup>72</sup> § 1052(d)–(e). Whether marks are confusingly similar may be determined based on similarity of sound, appearance, and meaning. U.S. PATENT & TRADEMARK OFFICE, *supra* note 2, at 4. For example, as described in the USPTO's pamphlet, the marks "T Markey" and "Tee Marquee" are phonetically pronounced the same, but they are spelled differently. *Id.* One example of a merely descriptive mark that would likely be denied a trademark application would be "BICYCLE." *Id.* at 8. The trademark is too generic to provide any indication of the source of the product. *Id.* Further, an example of a geographically deceptively misdescriptive trademark is one for wine that identifies a country of origin that is not the source of the wine in question. 15 U.S.C. § 1052(a). Whereas champagne refers to a specific region in France, a California vineyard could not name its wine "Napa Champagne" because it would lead consumers to think that the wine came from France when in fact it did not. *See* Frank J. Prial, *Wine Talk*, N.Y. TIMES, Aug. 30, 1995, at C4 (detailing the sources of different grape varieties and regions for wine); *The Difference Between Sparkling Wine and Champagne*, WINE COUNTRY (July 6, 2015), <https://www.winecountry.com/blog/sparkling-wine-vs-champagne/> [https://perma.cc/AEH4-CNU5] (explaining that champagne only comes from the Champagne region in France).

<sup>73</sup> Conrad, *supra* note 8, at 126.

<sup>74</sup> *Id.*

not abandon it, whereas federally registered trademarks are valid for ten years.<sup>75</sup> Common law use trademark owners cannot protect themselves against infringement unless they notify the public of their common law trademark with the symbol “TM.”<sup>76</sup> An unregistered trademark user may still enforce exclusive use of the trademark using infringement or unfair competition claims, but only if the public had actual notice of the mark’s ownership.<sup>77</sup> Arguably the greatest advantage of registering a trademark with the USPTO is that registration confers constructive notice nationwide because the trademark is on a federal register searchable by anyone.<sup>78</sup> In addition, other countries are more likely to recognize registered trademarks as opposed to common law use marks.<sup>79</sup> This is because most countries recognize trademarks under a first-to-file system rather than American common law’s first-to-use system.<sup>80</sup> For example, in 1993, basketball star Michael Jordan began using the trademark “JORDAN” for his popular Air Jordan sneakers.<sup>81</sup> Although Jordan registered the English spelling iteration of “JORDAN” with the USPTO, Jordan had only common

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<sup>75</sup> U.S. PATENT & TRADEMARK OFFICE, *supra* note 2, at 29.

<sup>76</sup> *Id.* at 11.

<sup>77</sup> See Mark P. McKenna, *The Implications of Blackhorse v. Pro-Football, Inc.*, PATENTLYO BLOG (June 19, 2014), <https://patentlyo.com/patent/2014/06/implications-blackhorse-football.html> [<https://perma.cc/YJ4E-HSVM>] (describing available remedies for unfair competition, prior to the *Tam III* decision, for the Washington Redskins following the TTAB’s cancellation of its “Redskins” trademarks due to its disparaging content). While *Tam III* moved through the court system, the Washington Redskins’ appeal of the TTAB’s cancellation of its trademark was stayed. *Pro-Football, Inc. v. Blackhorse*, 709 Fed. App’x 182, 183 (4th Cir. 2018) (appealing *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015)). This meant that as the appeal was stayed, the Washington Redskins had only common law use protections until the reinstatement of their trademarks. *Id.* Following the decision in *Tam III*, the Redskins’ trademarks were reinstated. *Id.*

<sup>78</sup> *Tam II*, 808 F.3d at 1341; see U.S. PATENT & TRADEMARK OFFICE, *supra* note 2, at 9 (detailing the free trademark search system TESS, Trademark Electronic Search System, that contains all federally registered trademarks).

<sup>79</sup> Conrad, *supra* note 8, at 126; Ramsey, *supra* note 49, at 803. Although most countries do not recognize common law trademark like the United States does, other nations like Saudi Arabia and the United Kingdom have trademark law provisions that echo the immoral, scandalous, and disparaging clauses in § 2(a) of the Lanham Act. Ramsey, *supra* note 49, at 814 (prohibiting registration of trademarks in Saudi Arabia of “[a]ny expression, sign or drawing inconsistent with public order or public morality” and in the United Kingdom of marks “contrary to public policy or to accepted principles of morality”). Further, trademark provisions in China and South Korea more closely mirror the disparagement clause in the Lanham Act. See *id.* (singling out an offensive trademark in China that “discriminate[s] against any nationality” and in South Korea that “falsely indicates a connection with a state, race, ethnic group, public organization, religion or famous deceased person, or which slanders, insults or is likely to defame them”).

<sup>80</sup> Conrad, *supra* note 8, at 126; Charles R. B. Macedo, *First-to-File: Is American Adoption of the International Standard in Patent Law Worth the Price?*, 18 AIPLA Q. J. 193, 202 (1990).

<sup>81</sup> Michele Ferrante, *Strategies to Avoid Risks Related to Trademark Squatting in China*, 107 TRADEMARK REP. 726, 740 (2017); Gwynn Guilford, *A Chinese Sportswear Company Has Trademarked Michael Jordan’s Sons’ Names*, QUARTZ (Apr. 29, 2013), <https://qz.com/79234/michael-jordan-versus-qiaodan-sports/> [<https://perma.cc/A45P-P9UN>].

law trademark protections for translations of the Jordan name.<sup>82</sup> Capitalizing on the vulnerability of Jordan's common law trademark protections, in 2000, a Chinese company registered the trademark "QIAODAN," which translates to Jordan using Chinese characters.<sup>83</sup> Unlike the United States, China is a first-to-file trademark system and Jordan did not file the mark first.<sup>84</sup> As a result, Jordan spent years in expensive litigation to cancel the Chinese company's "QIAODAN" trademark.<sup>85</sup> Although typically Chinese courts prioritize registration, common law use had associated the Chinese translation of Jordan's surname with the celebrity of Michael Jordan.<sup>86</sup> Jordan ultimately succeeded in cancelling the registration of his surname in 2016.<sup>87</sup> Despite this delayed victory, years spent on litigation could have been easily avoided by federally registering common translations of the Jordan surname with the USPTO.<sup>88</sup> As is evident by Jordan's struggle, federal registration of trademarks provides superior government protections for enforcement against trademark infringement.<sup>89</sup>

The Lanham Act provides the vehicle for bestowing trademark protections.<sup>90</sup> Section 2(a) of the Act prohibits registration of trademarks if they are disparaging.<sup>91</sup> Although the Lanham Act does not explicitly define when a trademark is disparaging, prior to the *Tam* decision, courts adopted the interpretation of the Trademark Trial and Appeal Board (TTAB).<sup>92</sup> The TTAB ap-

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<sup>82</sup> See U.S. PATENT & TRADEMARK OFFICE, *supra* note 2, at 1; Ferrante, *supra* note 81, at 741 (inferring that Jordan has common law use protections to translations of his name).

<sup>83</sup> Ferrante, *supra* note 81, at 727, 741; Guilford, *supra* note 81. The Chinese company engaged in the common, albeit notorious, practice of trademark squatting. Ferrante, *supra* note 81, at 741. Trademark squatting occurs when someone purposefully secures trademark translations of other brand names to capitalize on that market share by holding the mark hostage for money or attempting to mislead consumers about the true source of goods or services. *Id.* at 727.

<sup>84</sup> Conrad, *supra* note 8, at 126; Ferrante, *supra* note 81, at 744–45.

<sup>85</sup> See Ferrante, *supra* note 81, at 741–42 (describing Jordan's lawsuit in 2012 to invalidate Qiaodan Sports' mark registration that obtained a partially favorable ruling in 2016). Jordan's litigation success was limited, however, because the Chinese court only cancelled the trademark application of the translation of Jordan's surname into Chinese characters, not Pinyin characters. *Id.* at 742. Pinyin is the system for translating Chinese characters into the Latin alphabet. ZHAOCHEN GUO ET AL., NAT'L INST. OF STANDARDS & TECH., ENGLISH AND CROSS-LINGUAL ENTITY LINKING 5 (2012), <https://tac.nist.gov/publications/2012/participant.papers/ualbertain.proceedings.pdf> [<https://perma.cc/MX7Y-AXB4>].

<sup>86</sup> Ferrante, *supra* note 81, at 741–42.

<sup>87</sup> *Id.*

<sup>88</sup> *Id.* at 745.

<sup>89</sup> Conrad, *supra* note 8, at 126; Ferrante, *supra* note 81, at 745.

<sup>90</sup> Pattishall, *supra* note 63, at 442.

<sup>91</sup> 15 U.S.C. § 1052(a).

<sup>92</sup> Conrad, *supra* note 8, at 111; see TRADEMARK MANUAL, *supra* note 18, § 1203.03(b)(i) (determining whether a mark is immoral and scandalous based on if a "substantial composite of the referenced group" would be offended). The TTAB is an administrative body within the USPTO that adjudicates issues stemming from the registration of an applicant's trademark, including appeals, oppositions, and cancellations. *About the Trademark Trial and Appeal Board*, U.S. PATENT & TRADEMARK

plied a two-part test to determine if a mark is disparaging by first determining the likely meaning of the mark and then identifying whether a “substantial composite” of the group implicated by the mark would find it disparaging.<sup>93</sup>

The TTAB and federal courts, prior to the ruling in *Tam*, did not take into account the intent of the applicant, such as whether the applicant intended to reclaim a derogatory word, rather than use it to disparage.<sup>94</sup> The courts only considered the examiner’s determination of whether a “substantial composite” of the group implicated by the derogatory or offensive word would consider the trademark to be derogative.<sup>95</sup> The “substantial composite” did not have to even be a majority of group members.<sup>96</sup> The government justified its re-

OFFICE, <https://www.uspto.gov/trademark/laws-regulations/trademark-trial-and-appeal-board> [<https://perma.cc/V2MH-R3L9>].

<sup>93</sup> TRADEMARK MANUAL, *supra* note 18, § 1203.03(b)(i). The USPTO test for determining whether a mark is disparaging first asks the examiner to consider the “likely meaning” of the mark and then to consider whether a “substantial composite of the referenced group” would find the mark disparaging. *Id.* There is no clear definition of what constitutes a “substantial composite.” *See id.* (omitting explicit definition of substantial composite and stating that it does not have to constitute a majority of members in the referenced group). Even though the USPTO adopted a two-part test to determine whether a clause qualified as disparaging, this test produced varying results in practice. *See Tam II*, 808 F.3d at 1342 n.7 (detailing the USPTO’s rejection of the trademark “HAVE YOU HEARD SATAN IS A REPUBLICAN” but approval of “THE DEVIL IS A DEMOCRAT,” which arguably is also offensive to a substantial composite of people, namely Democrats); Conrad, *supra* note 8, at 124 (describing the granting of a trademark for “WE RUB YOU”—a play on words pronounced with Korean accents—which debatably is offensive to a substantial composite of Koreans).

<sup>94</sup> *See Tam III*, 137 S. Ct. at 1751 (noting the band sought to reclaim the derogatory expression through its band name); Tushnet, *supra* note 33, at 37 n.110 (noting the substantial composite test focuses on content instead of the intent of the speaker); VerSteege, *supra* note 57, at 116 n.28 (noting the unusual nature of trademark applicants reclaiming phrases because most “disparaging” trademark applications stemmed from groups that wanted to trademark derogatory words for oppressive purposes). “Reclaiming” is the act of altering the narrative of an offensive slur from a source of hardship to a source of pride. Todd Anten, *Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of Slurs into Section 2(A) of the Lanham Act*, 106 COLUM. L. REV. 388, 414 (2006). Both textual and visual slurs can be reclaimed. *Id.* at 413 n.169. For example, during World War II, Nazis labeled those who identified as LGBTQ+ with a pink triangle. *Id.* In the years since, this former symbol for hate has transformed into a symbol for LGBTQ+ pride. *Id.*

<sup>95</sup> Hsieh, *supra* note 21, at 6; *see* TRADEMARK MANUAL, *supra* note 18, § 1203.03(b)(i) (failing to articulate a definition of what constitutes a “substantial composite”); Tushnet, *supra* note 33, at 37 n.110 (noting that the substantial composite test focuses on the content instead of the speaker’s intent). The substantial composite need not be a majority. Hsieh, *supra* note 21, at 6. Simon Tam, the trademark applicant in *Tam I* and *Tam III*, criticized the dissonance between the substantial composite and majority because it produced unfair and ironic results. *See* Simon Tam, Opinion, *The Slants on the Power of Repurposing a Slur*, N.Y. TIMES (June 23, 2017), <https://www.nytimes.com/2017/06/23/opinion/the-power-of-repurposing-a-slur.html?r=1> [<https://perma.cc/L37R-3FLE>] (describing the “thousands of pages” of evidence and surveys that he presented to the USPTO detailing that over 90% of Asian Americans approved of “The Slants” band name which, ironically, the USPTO found disparaging to Asian Americans).

<sup>96</sup> TRADEMARK MANUAL, *supra* note 18, § 1203.03(b)(i); Hsieh, *supra* note 21, at 6. There are no clear lines for what constitutes a substantial composite and the ultimate determination is made at the examiner’s discretion. TRADEMARK MANUAL, *supra* note 18, § 1203.03(b)(i); Hsieh, *supra* note 21, at 6.



striction on disparaging trademarks because it sought to regulate offensive speech and prevent disruptions of commerce that would be caused by such disparaging marks.<sup>97</sup> In 1964, in *Katzenbach v. McClung*, the Court articulated what is now a long-standing principle that discriminatory speech disrupts interstate commerce.<sup>98</sup> Further, research studies indicate that marginalized groups experience negative psychological and sociological effects when a society uses derogatory and offensive imagery.<sup>99</sup> Although trademarks prevent consumer confusion in the marketplace, the disparaging nature of some marks can detrimentally affect commerce, undercutting the benefits of protecting trademarks.<sup>100</sup> Yet trademarks are undoubtedly speech protected by the First Amendment, begging the question of how much the government can restrict registering them.<sup>101</sup>

Free speech and trademark restriction intersect in more than just the disparaging/offensive clause.<sup>102</sup> Although there is limited case law on the intersection of trademark law and free speech rights, case precedent indicates Congress can regulate which trademarks it registers.<sup>103</sup> Measures Congress can regulate include marks that are likely to cause confusion and those that are likely to dilute or tarnish the reputation of other established marks.<sup>104</sup> In *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Committee*, decided by the Supreme Court in 1987, the San Francisco Arts & Athletics, Inc. (SFAA) wanted to host and organize the “Gay Olympic Games.”<sup>105</sup> The U.S. Olympic Committee (USOC) sought to enjoin the SFAA from using the term “Olympics” in its sport-

<sup>97</sup> *Tam III*, 137 S. Ct. at 1764 (citing *Tam II*, 808 F. 3d at 1379–81 (Reyna, J., dissenting)).

<sup>98</sup> 379 U.S. 294, 300 (1964); see *In re McGinley*, 660 F.2d at 486 (noting Congress’s intention to deny federal benefits to scandalous marks because of the public’s distaste for such immoral and scandalous marks).

<sup>99</sup> Stephanie A. Fryberg et al., *Of Warrior Chiefs and Indian Princesses: The Psychological Consequences of American Indian Mascots*, 30 BASIC & APPLIED SOC. PSYCHOL. 208, 215–16 (2008); see Conrad, *supra* note 8, at 124 (noting that the disparagement clause can prevent the registration of offensive trademarks by the over one hundred white power bands in the country that have names like “JEW SLAUGHTER” and “DEFINITE HATE”).

<sup>100</sup> *Tam II*, 808 F. 3d at 1379–81 (Reyna, J., dissenting); VerSteeg, *supra* note 55, at 134.

<sup>101</sup> See *Tam III*, 137 S. Ct. at 1764 (citing *Tam II*, 808 F. 3d at 1379–81 (Reyna, J., dissenting)) (discussing the extent of available speech restrictions as limited to those that can overcome the burden of intermediate scrutiny and assuming that trademarks are speech because the debate is over what kind of speech trademarks are).

<sup>102</sup> See *infra* notes 103–114 (discussing the impact of trademark restrictions on dilution law).

<sup>103</sup> See Tushnet, *supra* note 63, at 748 (describing the history of *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522 (1987)). *S.F. Arts & Athletics, Inc.* presented the first openly homosexual-related question before the Court since 1967. JOYCE MURDOCH & DEB PRICE, *COURTING JUSTICE: GAY MEN AND LESBIANS V. THE SUPREME COURT* 375–76 (2001). National and worldwide sporting events have a troubled history regarding inclusivity towards LGBTQ+ identifying people. Eric Anderson, *Masculinities and Sexualities in Sport and Physical Cultures: Three Decades of Evolving Research*, 58 J. HOMOSEXUALITY 565, 565 (2011).

<sup>104</sup> 15 U.S.C. § 1052(d) (2012); *id.* § 1125.

<sup>105</sup> 483 U.S. at 527; Tushnet, *supra* note 63, at 748.

ing event, as “OLYMPICS” was the USOC’s registered trademark.<sup>106</sup> Ultimately, the Court rejected the SFAA’s First Amendment argument that the U.S. Olympic Committee could not monopolize the use of the term “Olympic,” holding that the Lanham Act allowed the government to regulate confusing commercial speech that likely could deceive or mislead consumers.<sup>107</sup>

Congress can also regulate speech for trademarks that are likely to dilute the reputation of other registered marks.<sup>108</sup> A particular form of dilution that heavily implicates free speech rights is dilution by tarnishment, wherein a famous mark is tarnished by association with a similar, unflattering mark, typically because the tarnishing mark is sexual, obscene, or reflects illegal activity.<sup>109</sup> In 1995, Congress added to trademark protections by enacting the Dilu-

<sup>106</sup> *S.F. Arts & Athletics, Inc.*, 483 U.S. at 527; Murdoch & Price, *supra* note 103, at 364, 366. The San Francisco Arts & Athletics Inc. (SFAA) argued that the U.S. Olympic Committee only brought this suit against SFAA for homophobic reasons. Murdoch & Price, *supra* note 103, at 369. At the time of the suit, the “Olympics” mark was in use in other contexts, including the use of “Special Olympics” for a popular athletic competition for those with developmental disabilities. *Id.*

<sup>107</sup> *S.F. Arts & Athletics, Inc.*, 483 U.S. at 531–35; Tushnet, *supra* note 63, at 746. Actual deception is not required to invalidate a trademark because USPTO’s limited resources prevent the office from performing a comprehensive study of every single mark and, moreover, doing so would be administratively inefficient. Tushnet, *supra* note 33, at 751 n.80. There has been some criticism of *S.F. Arts & Athletics, Inc.*, largely because people do not believe that it is the government’s responsibility to protect the public from confusing marks. *Id.* at 748. Instead, the critics opt for a pure laissez-faire form in the marketplace. *Id.* Additionally, there has been discussion of whether marks may be commercial in nature sometimes and purely expressive at other times. *See id.* (discussing how the Court’s disregard for First Amendment jurisprudence in favor of trademark law fails to address the issue of when trademarks are partially useful and partially misleading). In 2002, in *Mattel, Inc. v. MCA Records, Inc.*, the U.S. Court of Appeals for the Ninth Circuit noted that deceptive speech should fall outside of First Amendment protections entirely because it qualifies as fraud. 296 F.3d 894, 905 (9th Cir. 2002). Conversely, in *Kasky v. Nike, Inc.*, a dissenting opinion from the Supreme Court of California suggested that there should be no available restrictions for commercial speech that is not merely deceptive because such speech does not cause any actionable harm to consumers. 45 P.3d 243, 280 (Cal. 2002) (Brown, J., dissenting). There, the dissent refused to characterize consumers’ disappointment in their purchase as a recognized harm that the government could protect under a First Amendment analysis. *Id.* The dissent further argued that restrictions on commercial speech may suffocate the marketplace by continuing to advance an arbitrary distinction between commercial and non-commercial speech. *Id.* at 269. As a result, expressive speech that warrants First Amendment protection could be restricted. *Id.* Some U.S. Courts of Appeals, such as the Second Circuit, hold that intent to deceive is not required for trademark suits. Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CALIF. L. REV. 1581, 1582 (2006). In contrast, First Amendment analysis of speech often looks to speaker intent to determine if such speech was done recklessly, negligently, or with the knowledge of falsity. *Id.*; Martin H. Redish, *First Amendment in the Marketplace: Commercial Speech and the Values of Free Expression*, 39 GEO. WASH. L. REV. 429, 434 (1971).

<sup>108</sup> Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, § 3, 109 Stat. 985, 985–86 (1996); Ramsey, *supra* note 49, at 834.

<sup>109</sup> Jesse A. Hofrichter, *Tool of the Trademark: Brand Criticism and Free Speech Problems with the Trademark Dilution Revision Act of 2006*, 28 CARDOZO L. REV. 1923, 1924–25 (2007); Lynda J. Oswald, *Tarnishment and Blurring Under the Federal Trademark Dilution Act of 1995*, 36 AM. BUS. L.J. 255, 263–64 (1999). Dilution, unlike trademark infringement, does not require a likelihood of confusion. Tushnet, *supra* note 63, at 738. The other dilution cause of action, dilution by blurring,

tion Act to protect against dilution by both blurring and tarnishment.<sup>110</sup> Then, in 2006, Congress clarified legislation around dilution with the Trademark Dilution Revision Act by establishing that only likelihood of dilution is needed for a claim, rather than evidence of actual dilution.<sup>111</sup> After the passage of this Act, in 2010, in *V Secret Catalogue, Inc. v. Moseley*, the U.S. Court of Appeals for the Sixth Circuit affirmed the U.S. District Court for the Western District of Kentucky's permanent injunction against the use of the store name "Victor's Little Secret" for selling adult toys.<sup>112</sup> The Sixth Circuit further held that because of the sexual nature of the association, the use of "Victor's Little Secret" had a high likelihood of tarnishing the positive goodwill connected to the "VICTORIA'S SECRET" mark of the famous lingerie brand.<sup>113</sup> In light of the speech issues raised in *Tam*, the regulations protecting against disparaging and offensive marks, as well as dilution by tarnishment, raise the question of the breadth of the government's power to enforce these restrictions.<sup>114</sup>

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occurs when a trademark owner suffers harm because his or her trademark loses its distinctiveness. Oswald, *supra* note 109, at 262–63. Sometimes courts conflate the two types of dilution or find that a diluting mark implicates both. *Id.* at 276. For example, in *Ringling Brothers v. Celozzi-Ettelson Chevrolet, Inc.*, the Federal Circuit discussed the issue of dilution by blurring. 855 F.2d 480, 485 (7th Cir. 1988). The court affirmed the District Court's holding that enjoined a used car dealership from using the tagline, "The Greatest Used Car Show on Earth" because it blurred the Ringling Bros.'s mark, "The Greatest Show on Earth." *Id.* Even though the court found there was no likelihood of confusion between the circus and the used car dealership, the court concluded Congress had the ability to regulate the use of the Ringling Bros.'s registered trademark because overuse of the mark would make it lose its unique features in the marketplace. *Ringling Bros.*, 855 F.2d at 482–83. Thus, the court restricted Chevrolet's use of the notable tagline. *Id.* at 485.

<sup>110</sup> Federal Trademark Dilution Act § 3; Ramsey, *supra* note 49, at 802, 804 (writing that the Lanham Act already included protections against dilution and that the Federal Dilution Act just added to this).

<sup>111</sup> Trademark Dilution Revision Act § 2 (overturning the holding in *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 433 (2003) (*Moseley I*) that held actual dilution is required under the Lanham Act).

<sup>112</sup> 605 F.3d 382, 387–90 (6th Cir. 2010) (*Moseley II*). Congress passed the Trademark Dilution Revision Act to overrule the first iteration of this case that went up to the Supreme Court in 2003. *Moseley I*, 537 U.S. at 433. There, the Supreme Court ruled that, under the federal law in effect at the time, actual evidence of dilution was required to prove tarnishment. *Moseley I*, 537 U.S. at 433. After the ruling, Congress passed the Trademark Dilution Revision Act, "expressly intended to overrule" the Court's earlier decision in *Moseley I*. 537 U.S. at 433; *Moseley II*, 605 F.3d at 385. After the U.S. District Court for the Western District of Kentucky granted an injunction in favor of Victoria's Secret, in 2010, Victor and Cathy Moseley changed the name of their shop from "Victor's Little Secret" to "Cathy's Little Secret." *Moseley II*, 605 F.3d at 384. The couple appealed to the U.S. Court of Appeals for the Sixth Circuit to lift the injunction, but there the court held that even though the stores competed in different markets, a negative association existed and thus tarnished the mark of "VICTORIA'S SECRET." *Id.* at 390.

<sup>113</sup> *Moseley II*, 605 F.3d at 390.

<sup>114</sup> See, e.g., *Tam III*, 137 S. Ct. at 1764 (citing *Tam II*, 808 F.3d at 1379–81 (Reyna, J., dissenting)) (discussing the extent of available speech restrictions as limited to those that can overcome the burden of intermediate scrutiny); *infra* notes 251–287 (arguing that likely under a viewpoint discrimination analysis, rather than first characterizing the trademark speech at issue as commercial speech and constitutional, the Court will instead hold that dilution laws are also unconstitutional).

*B. Using Commercial Speech and Content-Neutral Theories to Determine the Boundaries of Speech the Government May Regulate*

When the Supreme Court conducts constitutional review of a law, the Court first determines the appropriate level of scrutiny by which to review the statute.<sup>115</sup> The Court uses tiers of scrutiny in its standard of review ranging from strict scrutiny to intermediate scrutiny to rational basis review.<sup>116</sup> For a law to withstand strict scrutiny, the government has the burden to identify a compelling government interest in implementing the regulation, and further that the regulation was narrowly tailored to achieve those ends.<sup>117</sup> Under intermediate scrutiny review, the government only needs to identify a substantial government interest for its regulation that is no broader than necessary to serve that interest.<sup>118</sup> Lastly, withstanding rational basis review requires only a legitimate government interest that is rationally related to the purposes of the regulation.<sup>119</sup> Under the First Amendment, noncommercial speech is subject to the highest level of scrutiny, strict scrutiny.<sup>120</sup> Commercial speech, on the other hand, is subject to intermediate scrutiny.<sup>121</sup>

The delineation between commercial and noncommercial speech is rooted in the basic theory of why speech is regulated in the first place.<sup>122</sup> Constitutional law scholars have identified three primary theories of free speech explaining the government's need to regulate speech: (1) the marketplace theory of ideas, (2) human autonomy and self-fulfillment, and (3) democratic governance.<sup>123</sup> A marketplace theory of ideas envisions regulations similar to the eco-

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<sup>115</sup> Tushnet, *supra* note 63, at 737; *see* Tait, *supra* note 42, at 909 (explaining that a commercial speech analysis is primary to exploring a content-based versus content-neutral analysis).

<sup>116</sup> GREENFIELD, *supra* note 16, at 137.

<sup>117</sup> *Id.*

<sup>118</sup> *Id.*

<sup>119</sup> *Id.*

<sup>120</sup> *Id.*

<sup>121</sup> *Id.*

<sup>122</sup> *Id.* at 105.

<sup>123</sup> *Id.* Although a thorough examination of First Amendment jurisprudence is beyond the scope of this Note, the following is a brief history of the differences between the competing free speech theories that, when taken together, can identify the boundaries of government regulation. *See id.* The marketplace theory of ideas, widely credited to Justices Oliver Wendell Holmes, Jr. and Louis Brandeis, envisions the purpose of free speech as the search for the ultimate truth. *Id.* at 105–06. Although a pure marketplace of ideas theory visualizes no regulations or restrictions on speech, Holmes and Brandeis endeavored to determine when restrictions were appropriate. *Id.* Under this theory, both speech and counter-speech are allowed in the marketplace. *Id.* at 106–07. This allows consumers to be informed on all perspectives and, over time, to choose the speech they favor. *Id.* According to this ideal, the long arc of history favors truthful speech because untruthful speech will be disfavored in the marketplace of ideas. *Id.* at 109. Applying the marketplace of ideas to trademarks would mean that untruthful and disparaging marks eventually would not be profitable and thus would see a diminished use in the marketplace. *See id.* (describing how the marketplace of ideas theory focuses on the effect of speech in the marketplace over time).

conomic marketplace to prevent monopolies on ideas.<sup>124</sup> In contrast, the human autonomy and self-fulfillment theory proposes that the government should only regulate speech central to the development and expression of one's identity.<sup>125</sup> The final theory of democratic governance suggests that only political speech that advances civic discourse should enjoy the highest level of protection.<sup>126</sup>

These theories help identify the boundaries of regulations that the government should impose on speech and the burdens the government must meet to justify those regulations.<sup>127</sup> Given the substantial imperfections of the autonomy and democratic governance theories, the marketplace of ideas is the prevailing theory of speech.<sup>128</sup> A pure marketplace of ideas theory does not visualize any hierarchy of speech, meaning it does not distinguish speech protections based on the speaker, disregarding, for example, whether such a speaker is an individual or a corporation.<sup>129</sup> A more nuanced view of this theo-

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The marketplace theory of ideas is an effects-oriented approach to protect speech. *Id.* at 106–07, 115. Similarly, the human autonomy and self-fulfillment theories are also effects-oriented. *Id.* Whereas the marketplace theory of ideas is based upon society finding the ultimate truth by maximizing speech, the human autonomy and self-fulfillment theory is focused on individual speakers developing their identities to their greatest capacities. *Id.* The human autonomy and self-fulfillment theory protects speech that is intertwined with self-expression, such as artistic and literary works. *Id.* at 115. Critics argue this theory provides no guidance on when speech should be regulated, or if there should even be any such regulation at all. *Id.* at 116. According to the critics, if speech is supposed to serve the purpose of allowing an individual to express themselves, then any expression—no matter how violent—is an expression of individual identity. *Id.* To that end, the human autonomy and self-fulfillment theory is more like a normative value than a theory. See *id.* at 105 (noting that “[n]o one thinks all speech should be protected”). Practically all scholars agree that under any free speech theory, perjury, defamation, conspiracy, fraud, and threats should not be protected. *Id.* at 105. The human autonomy theory is also criticized for failing to provide a test for determining available restrictions when one person's speech infringes on another's autonomy—for example, hate speech. *Id.* at 117.

The third prevailing theory on free speech is democratic governance, also known as the public debate and self-governance theory. *Id.* at 123. This theory advocates that the purpose of speech is to further democratic discussions of politics and civic issues. *Id.* at 123–24. Leading scholar Alexander Meiklejohn advanced this theory using a town hall metaphor. *Id.* at 124. At a town hall, people speak in turn and use an equal allocation of time in order to mitigate the fear of certain voices drowning out others. See *id.* (positing that everyone speaks in turn at a town hall meeting because unlimited chatter would prevent productivity). Despite receiving support from the Supreme Court, the main criticism of the democratic governance theory is that, if political speech is protected for the purposes of promoting democracy, non-political speech like literary and artistic works fails to be protected. *Brown v. Entm't Merchants Ass'n*, 564 U.S. 786, 790 (2011) (“The Free Speech Clause exists principally to protect discourse on public matters.”); GREENFIELD, *supra* note 16, at 125.

<sup>124</sup> GREENFIELD, *supra* note 16, at 113.

<sup>125</sup> *Id.* at 115.

<sup>126</sup> *Id.* at 124.

<sup>127</sup> *Id.* at 105.

<sup>128</sup> *Id.* at 108.

<sup>129</sup> *Id.* at 112 (arguing the Supreme Court failed to use a nuanced view of the marketplace theory in *Citizens United v. FEC*, 558 U.S. 310, 365 (2010)). *Citizens United* involved an injunction request to prevent the Federal Election Commission (FEC) from enforcing its regulation to limit the amount of corporate and individual campaign financing for a film with a negative slant on then-Senator Hillary Clinton's bid for the presidency. 558 U.S. at 319–20. *Citizens United*, the organization promoting

ry illustrates that, like the analogy of the economic marketplace, the government may regulate speech to correct market defects, such as untruthful or fraudulent speech that prevents informed consumer choice in the marketplace.<sup>130</sup>

From this nuanced marketplace of ideas theory emerged a distinction between commercial speech and non-commercial speech.<sup>131</sup> The common law has not identified concrete boundaries for when speech is commercial versus non-commercial.<sup>132</sup> The primary distinction between the two is that commercial speech relates to a business transaction, whereas non-commercial speech does not.<sup>133</sup> Any restriction on non-commercial speech, including individual speech, is subject to strict scrutiny.<sup>134</sup> Thus, to uphold a restriction on non-commercial speech, the government has the burden of identifying its compel-

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and distributing the film, argued that the FEC's campaign finance regulation violated its First Amendment rights because campaign funding is an expression of speech and thus cannot be limited. *Id.* at 336–37. In a five-to-four decision, the Court held that corporate campaign funding should not receive fewer protections than individuals—thus, campaign funding should not be limited based on the speaker. *Id.* at 365. Differing from *Citizens United*'s position, the Court held that FEC disclosure requirements on campaign funding were constitutional due to the government interest in informing the public. *Id.* at 371.

<sup>130</sup> GREENFIELD, *supra* note 16, at 106–07, 113. The Court could have decided *Citizens United* a different way and upheld *Austin v. Michigan Chamber of Commerce*, 494 U.S. 652 (1990). GREENFIELD, *supra* note 16, at 113. In *Austin*, the Court upheld a Michigan state law prohibiting corporations from using treasury finances for independent expenditures to political campaigns. 494 U.S. at 668–69. Nonetheless, in *Citizens United*, the Court, without any nuance, extended its holding in *Buckley v. Valeo*, 424 U.S. 1 (1976), by holding that a cap on expenditures for individuals to political campaigns violated free speech and thus was unconstitutional. GREENFIELD, *supra* note 16, at 123.

<sup>131</sup> Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, 425 U.S. 748, 770 (1976). In *Virginia State Board of Pharmacy*, the Supreme Court identified for the first time that commercial speech deserves protection after pharmacists successfully challenged a Virginia state law that prohibited the advertisement of prescription drug prices. *Id.* at 749–50, 770. The Court noted that its ruling did not mean that there should be an absence of any regulation on such speech. *Id.* at 770. Prior to this ruling, it was not clear whether commercial speech enjoyed any First Amendment protections. *Id.* at 755. Since this holding, subsequent decisions have held that the government may regulate truthful commercial speech if it is deceptive or misleading to maintain a free flow of commerce. Tushnet, *supra* note 33, at 739–40.

<sup>132</sup> See Conrad, *supra* note 8, at 142 (arguing the distinction between commercial and non-commercial should be abolished); see also Tushnet, *supra* note 33, at 382 (describing the importance of long-standing precedent for identifying commercial versus non-commercial speech and that without this distinction trademark law as a whole begins to fall apart). But see *Cent. Hudson*, 447 U.S. at 562–64 (creating a test to determine the difference between commercial and non-commercial speech but failing to clarify the boundaries of such speech). The case law has defined commercial speech as speech that proposes a commercial transaction. *Bolger*, 463 U.S. at 66–68; *Conn. Bar Ass'n v. United States*, 620 F.3d 81, 93–94 (2d Cir. 2010) (limiting commercial speech to speech that “does no more” than propose a commercial transaction); *Semco, Inc. v. Amcast, Inc.*, 52 F.3d 108, 112 (6th Cir. 1995) (expanding the scope of commercial speech beyond speech that “does no more” than propose a commercial transaction).

<sup>133</sup> *Cent. Hudson*, 447 U.S. at 563.

<sup>134</sup> Ned Snow, *Denying Trademark for Scandalous Speech*, 51 U.C. DAVIS L. REV. 2331, 2361 (2018).

ling interest and proving that its regulation was narrowly tailored to achieve those ends.<sup>135</sup>

In contrast, commercial speech need not withstand the same strict scrutiny as non-commercial speech.<sup>136</sup> Although the Supreme Court declared in 1976, in *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council*, that commercial speech warranted First Amendment protection, it was not until four years later, in *Central Hudson Gas & Electric Corp. v. Public Service Commission*, that the Court developed a test for determining the constitutionality of commercial speech restrictions.<sup>137</sup> In *Central Hudson*, the Court held that commercial speech is subject to intermediate scrutiny.<sup>138</sup> Although the majority did not expressly hold that commercial speech is subject to intermediate scrutiny, the concurrence identified the majority's holding as instituting an intermediate scrutiny test for commercial speech and the Court subsequently agreed in later cases.<sup>139</sup>

The first point of inquiry in assessing commercial speech is whether the speech relates to lawful activity and is not deceptive.<sup>140</sup> After this threshold test, the Court conducts a three-pronged analysis: asking (1) whether the government has a substantial interest; (2) whether the restriction is directly and materially related to that interest; and (3) whether the regulation is no more restrictive than reasonably necessary to achieve such interest.<sup>141</sup> If these questions are answered affirmatively, then the speech will survive constitutional analysis.<sup>142</sup> Given the more lax standard of review, as a general principle, a commercial speech regulation is more likely to be found constitutional than a non-commercial speech regulation.<sup>143</sup>

Although *Virginia State Board of Pharmacy* and its progeny describe Congress's ability to regulate such commercial speech, that power is not absolute.<sup>144</sup> The degree to which Congress must justify its regulation depends on

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<sup>135</sup> GREENFIELD, *supra* note 16, at 137.

<sup>136</sup> VerSteeg, *supra* note 57, at 121.

<sup>137</sup> *Cent. Hudson*, 447 U.S. at 564; *Va. State Bd. of Pharmacy*, 425 U.S. at 770. In *Central Hudson*, the Court held the New York law that prohibited public utilities from promoting electricity use violated commercial speech concerns under the First Amendment. 447 U.S. at 571.

<sup>138</sup> *Cent. Hudson*, 447 U.S. at 563.

<sup>139</sup> See *Sorrell v. IMS Health Inc.*, 564 U.S. 552 (2011) (referring to the intermediate scrutiny test for commercial speech established in *Cent. Hudson*, 447 U.S. at 563); *Fla. Bar v. Went for It, Inc.*, 515 U.S. 618, 623–24 (1995) (same); *Cent. Hudson*, 447 U.S. at 573 (Blackmun, J., concurring) (characterizing the majority's analysis of commercial speech as "intermediate scrutiny").

<sup>140</sup> *Cent. Hudson*, 447 U.S. at 564 (majority opinion).

<sup>141</sup> *Id.*; GREENFIELD, *supra* note 16, at 137.

<sup>142</sup> *Cent. Hudson*, 447 U.S. at 564; GREENFIELD, *supra* note 16, at 137.

<sup>143</sup> GREENFIELD, *supra* note 16, at 137; see VerSteeg, *supra* note 57, at 121 (detailing the "more rigorous" standard of strict scrutiny compared to the less rigorous intermediate scrutiny).

<sup>144</sup> See *Cent. Hudson*, 447 U.S. at 564 (limiting Congress's power to regulate commercial speech based on a four-part test); *Va. State Bd. of Pharmacy*, 425 U.S. at 778–79 (restricting Congress's power over commercial speech because commercial speech is not wholly outside the ambit of First

whether the regulation is content-based or content-neutral, although where to draw the line is not always clear.<sup>145</sup> Broadly speaking, content-based restrictions are those that regulate the subject matter of the speech at issue.<sup>146</sup> In contrast, content-neutral restrictions do not regulate the subject matter of the speech; rather, they regulate the circumstances of the production of speech.<sup>147</sup> Content-based regulations receive strict scrutiny review.<sup>148</sup> Although Congress may regulate speech harmful to children, Congress must narrowly tailor any such regulation while also being careful not to engage in viewpoint discrimination, for example, by banning certain words that would reveal viewpoints that it finds objectionable.<sup>149</sup> In contrast, content-neutral restrictions do not implicate the content of speech, and thus such regulations only require intermediate scrutiny.<sup>150</sup> Content-neutral restrictions on both commercial and non-commercial speech are subject to more lenient intermediate scrutiny.<sup>151</sup> Content-based restrictions on commercial speech are not always subject to strict scrutiny analysis; because of the compelling government interest in regulating the commercial nature of the speech, the Court can choose to view a content-based commercial speech restriction under the intermediate scrutiny lens that it affords commercial speech.<sup>152</sup> Thus, the Court in *Tam* may have differently determined the constitutionality of the disparagement clause's restriction on trademark speech if the Court had first categorized the type of speech that was implicated.<sup>153</sup>

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Amendment protection); *see, e.g.*, Robert C. Post, *Viewpoint Discrimination and Commercial Speech*, 2007 YALE L. SCH. LEGAL SCHOLARSHIP REPOSITORY 169, 171–72, [https://digitalcommons.law.yale.edu/cgi/viewcontent.cgi?article=5649&context=fss\\_papers](https://digitalcommons.law.yale.edu/cgi/viewcontent.cgi?article=5649&context=fss_papers) [<https://perma.cc/W85T-6WXL>] (detailing the necessity of common-place regulations such as legal malpractice that are arguably viewpoint discrimination-based because such regulations prohibit unprofessional conduct); Tait, *supra* note 42, at 913–15 (reasoning that, in cases where the government seeks to prohibit viewership by children, the regulation must be substantially related to address the concern for children, while not unduly suppressing adult access to such information).

<sup>145</sup> Leslie Gielow Jacobs, *Clarifying the Content-Based/Content Neutral and Content/Viewpoint Determinations*, 34 MCGEORGE L. REV. 595, 619 (2003).

<sup>146</sup> *Id.* at 608 n.98.

<sup>147</sup> *Id.* at 598.

<sup>148</sup> *Id.*; *see Tam III*, 137 S. Ct. at 1763 (finding viewpoint discrimination after applying strict scrutiny analysis for content-based restriction).

<sup>149</sup> Tait, *supra* note 42, at 915.

<sup>150</sup> Jacobs, *supra* note 145, at 915. The line between content-neutral and content-based is not a clear boundary. *Id.* The simplistic distinction between the two is that content-neutral regulations restrict speech without regard to the expression at issue, whereas content-based restrictions prohibit speech based on the expression at issue. *Id.*

<sup>151</sup> *Id.*

<sup>152</sup> *Tam II*, 808 F.3d at 1377.

<sup>153</sup> *See Tam III*, 137 S. Ct. at 1763–64 (shortcutting the commercial speech analysis inquiry and addressing the constitutionality of the disparagement clause based on viewpoint discrimination).



*C. The Evolution of Matal v. Tam and the Court's Dodged Question of Whether Trademarks Are Commercial Speech*

In the recent Supreme Court case *Matal v. Tam*, the Court left open the question of whether trademarks constitute commercial speech.<sup>154</sup> Instead the Court decided the case on alternative grounds by finding that the disparagement clause of § 2(a) of the Lanham Act is unconstitutional because it unlawfully allows the government to engage in viewpoint discrimination.<sup>155</sup> Still, the facts of the case and the open question left by the Court provide a fertile ground for discussion on the implications of *Tam*'s holding and the future of cases at the intersection of trademark and constitutional law.<sup>156</sup>

The journey of *Tam* to the Supreme Court began when Simon Tam applied to register the trademark for his band name, "The Slants," in 2011.<sup>157</sup> The Slants were a rock band comprised of Asian Americans, including Tam.<sup>158</sup> The band pursued registration for its name because record labels are generally reluctant to sign a group that does not have a trademarked name to mitigate any future suits against trademark infringement by another party.<sup>159</sup> Tam said the band's name was a reclamation of the group members' marginalized histories, as well as an allusion to the band's "slant" on social justice issues emphasizing their Asian-American identities.<sup>160</sup> Despite Tam's reclamation argument, the USPTO rejected its application under the disparagement clause of the Lanham Act.<sup>161</sup> The examiner reasoned that the band's name was disparaging because it implicated the stereotype of many Asians' and Asian Americans' "slanty" eyes.<sup>162</sup> Tam subsequently appealed the decision of the USPTO to the

<sup>154</sup> *Id.*; see *supra* note 33 and accompanying text (detailing the scholarly debate on the crippling fate of the Lanham Act should more portions of it be held unconstitutional under strict scrutiny).

<sup>155</sup> *Tam III*, 137 S. Ct. at 1763–64.

<sup>156</sup> See *supra* note 33 and accompanying text (discussing *In re Brunetti*, which holds that the immoral and scandalous clauses of the Lanham Act are unconstitutional). For example, one scholar discusses whether the *Tam III* decision implicates the scandalous clause of the Lanham Act and concludes that the scandalous clause is likely constitutional. Snow, *supra* note 134, at 2364. He argues that viewpoint discrimination concerns would not affect the scandalous clause because it is not so much the viewpoint of the offense that is of principal concern, but rather the visibility of vulgarity and explicit trademarks in commerce. *Id.* at 2368. Notably, he refrains from using a strict scrutiny framework and instead favors using a limited public framework. See *id.* at 2364 (arguing this theory's superiority over a commercial speech framework because of trademarks' applicability to a limited public forum where the government creates areas to regulate private speech). A limited public forum is a government-created space for the expression of speech where the government is authorized to create reasonable restrictions on what kinds of speech receive the benefits of using the forum. *Id.*

<sup>157</sup> THE SLANTS, Registration No. 5,332,283.

<sup>158</sup> *Tam III*, 137 S. Ct. at 1751.

<sup>159</sup> Hsieh, *supra* note 21, at 5.

<sup>160</sup> *Tam III*, 137 S. Ct. at 1751, 1764.

<sup>161</sup> 15 U.S.C. § 1052(a); *Tam III*, 137 S. Ct. at 1751, 1764.

<sup>162</sup> *Tam III*, 137 S. Ct. at 1754.

TTAB.<sup>163</sup> The TTAB affirmed the USPTO's decision on the same grounds and Tam appealed to the U.S. Court of Appeals for the Federal Circuit.<sup>164</sup>

The Federal Circuit had a differing view of the disparagement clause from the USPTO and the TTAB, paving the way for the Supreme Court's analysis.<sup>165</sup> A three-judge panel initially affirmed the TTAB, holding that Tam's band name was disparaging.<sup>166</sup> The panel further held that the disparagement clause was not an unconstitutional restriction because Tam was not totally barred from using the mark, as it was still valid under common law.<sup>167</sup> Despite this, Judge Kimberly A. Moore wrote separately from her opinion, calling into question the constitutionality of the disparagement clause.<sup>168</sup> This led the Federal Circuit to reconsider the case.<sup>169</sup>

In the subsequent *en banc* ruling, the Federal Circuit reversed the holding of the TTAB and declared the disparagement clause unconstitutional because it imposed the government's viewpoint on the permissibility of speech.<sup>170</sup> This time penning the majority opinion, Judge Moore reasoned that, regardless of whether strict scrutiny or intermediate scrutiny applied, the disparagement clause was unconstitutional because the government had put forth no legitimate interest to support its restriction.<sup>171</sup> Although the majority opinion implied that trademarks contain both commercial and non-commercial elements, it did not explicitly address whether trademarks are commercial speech.<sup>172</sup> In contrast, Judge Jimmie V. Reyna, dissenting, explicitly argued that "[t]rademarks are commercial speech," requiring the court to analyze under the intermediate scrutiny test established in *Central Hudson*.<sup>173</sup> Judge Reyna further argued that the government had a legitimate interest in protecting commerce from disruptions caused by disparaging trademarks, making the disparagement clause of the Lanham Act constitutional.<sup>174</sup>

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<sup>163</sup> *Id.*; *In re Tam*, 108 U.S.P.Q.2d (BNA) 1305, 1306 (T.T.A.B. 2013).

<sup>164</sup> *Tam III*, 137 S. Ct. at 1754; *Tam II*, 808 F.3d at 1357–58; *In re Tam*, 108 U.S.P.Q.2d at 1312–13.

<sup>165</sup> *Tam III*, 137 S. Ct. at 1754; *Tam II*, 808 F.3d at 1357–58.

<sup>166</sup> *In re Tam*, 785 F.3d 567, 571–72 (Fed. Cir. 2015) (*Tam I*), overruled by *In re Tam*, 108 U.S.P.Q.2d (BNA) 1305 (T.T.A.B. 2013); Conrad, *supra* note 8, at 99.

<sup>167</sup> *Tam I*, 785 F.3d at 571–72.

<sup>168</sup> *Id.* at 573 (Moore, J., additional views).

<sup>169</sup> *Tam II*, 808 F.3d at 1357–58; see Conrad, *supra* note 8, at 101 (providing a detailed summary of the journey of the *Tam* case through the court system).

<sup>170</sup> *Tam II*, 808 F.3d at 1357–58.

<sup>171</sup> *Id.* at 1357. Since the government put forth no legitimate interest, the regulation could not even satisfy intermediate scrutiny. *Id.*

<sup>172</sup> Conrad, *supra* note 8, at 102; see *Tam II*, 808 F.3d at 1328 (finding that under both a commercial speech analysis and a non-commercial speech analysis, the disparagement clause is unconstitutional).

<sup>173</sup> *Tam II*, 808 F.3d at 1376 (Reyna, J., dissenting).

<sup>174</sup> *Id.*

Following the Federal Circuit's ruling, the government appealed to the Supreme Court, which unanimously affirmed the Federal Circuit's decision.<sup>175</sup> In its petition for certiorari, the government asked the Court to consider, first, whether trademarks constitute government speech and therefore bypass any First Amendment concerns; second, whether trademarks represent a government subsidy; and third, whether trademarks are commercial speech.<sup>176</sup>

The Court chose to extensively address the first and second issues but only cursorily answer the third.<sup>177</sup> Similar to the lower court, Justice Samuel A. Alito, Jr., who penned the majority opinion, reasoned that, regardless of whether strict scrutiny or intermediate scrutiny applied, the disparagement clause could survive neither.<sup>178</sup> The Court held that the disparagement clause was not narrowly drawn enough for any governmental interest to be substantially related to the restriction at issue, and it therefore could not survive even intermediate scrutiny.<sup>179</sup> Moreover, the disparagement clause permitted viewpoint discrimination, and viewpoint discrimination must survive strict scrutiny to be permissible.<sup>180</sup> This is because the breadth of the disparagement clause allows the government to engage in unconstitutional viewpoint discrimination when deciding which trademarks to register.<sup>181</sup> As the viewpoint discrimination issue was dispositive, the Court declined to address whether trademarks constitute commercial speech.<sup>182</sup> The Court ultimately acknowledged that, due to a lack of a uniform

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<sup>175</sup> *Tam III*, 137 S. Ct. at 1744. Only eight justices participated in the decision, because Justice Gorsuch was not seated at the time. *Id.*

<sup>176</sup> *Id.* at 1757.

<sup>177</sup> *Id.* at 1764; see Conrad, *supra* note 8, at 113 (acknowledging that a lot of time at oral argument was spent on the government speech issue that was already rejected at the lower court level). It is likely that the government chose to still argue trademarks constitute government speech because of this argument's success in the Washington Redskins case, which the court had stayed pending the appeal of *Tam I*. See *Pro-Football, Inc.*, 112 F. Supp. 3d at 452 (finding for the government's claim that trademarks constituted government speech). In *Tam III*, the government tried to argue that trademarks are government speech because the government registers them and provides benefits to the owners of such federally registered marks. 137 S. Ct. at 1757. The Supreme Court rejected the government's argument, reasoning that (1) trademarks are created by individuals and not the government, and (2) registration of a trademark does not represent approval by the government. *Id.* at 1758. Further, the majority rejected the government's previously unraised argument that trademarks are a government subsidy because applicants received minimal benefits in connection with the application fee structure. *Id.* at 1761–62. Justice Clarence Thomas, in his concurrence, thought that the majority should not have addressed the issue, because the parties had not raised the issue in earlier proceedings. *Id.* at 1769 (Thomas, J., concurring). Still, the Court addressed the merits of the argument by holding that trademarks are not government speech. *Id.* at 1763 (majority opinion).

<sup>178</sup> *Tam III*, 137 S. Ct. at 1763–64.

<sup>179</sup> *Id.*

<sup>180</sup> *Id.*; see Jacobs, *supra* note 145, at 596–97 (discussing the complicated jurisprudence on the intersection of the viewpoint discrimination and content-neutral doctrines).

<sup>181</sup> *Tam III*, 137 S. Ct. at 1763–65.

<sup>182</sup> *Id.* at 1764.

standard for identifying a disparaging mark, the clause was unconstitutional under a *Central Hudson* analysis.<sup>183</sup>

The *Tam* concurrences addressed commercial speech concerns related to trademarks in more detail, although both concurring Justices declined to address the essential question of whether trademarks are commercial speech.<sup>184</sup> In Justice Anthony M. Kennedy's concurrence, he argued that viewpoint discrimination was per se unconstitutional because the government could only regulate specific forms of speech, such as fraud, conspiracy, threats, defamation, and perjury.<sup>185</sup> The government's restriction on prohibiting offensive and derogatory trademark content did not fit into any of those categories.<sup>186</sup> Justice Kennedy reasoned that, regardless of whether trademarks were commercial speech, if the regulation implicated viewpoint discrimination, it would be per se unconstitutional.<sup>187</sup> Justice Clarence Thomas went even further in his concurrence, advocating for eliminating the tiered free speech analysis from *Central Hudson* and instead analyzing all commercial speech under a strict scrutiny lens.<sup>188</sup> The Court's majority opinion ultimately struck down the disparagement clause and left open the question of the status of the remaining § 2(a) requirements restricting immoral and scandalous trademarks.<sup>189</sup>

## II. HOW COURTS VIEW THE INTERSECTION OF TRADEMARKS AND COMMERCIAL SPEECH

Trademarks have an inextricable connection to commerce.<sup>190</sup> But despite this connection, there is no dispute that some trademarks contain some non-commercial elements.<sup>191</sup> As the band in the *Tam* decision articulated, they

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<sup>183</sup> See *id.* at 1763–64 n.17 (concluding that an open question remains as to whether the *Central Hudson* test is appropriate for addressing free speech concerns for commercial speech). *But see id.* at 1768 (Kennedy, J., concurring) (dismissing the *Central Hudson* test when such speech like that at issue in *Tam III* is political in nature); *id.* at 1769 (Thomas, J., concurring) (desiring to completely eliminate the *Central Hudson* test).

<sup>184</sup> *Tam III*, 137 S. Ct. at 1765–69; Conrad, *supra* note 8, at 119.

<sup>185</sup> *Tam III*, 137 S. Ct. at 1765 (Kennedy, J., concurring).

<sup>186</sup> *Id.*

<sup>187</sup> *Id.* at 1767.

<sup>188</sup> *Id.* at 1769 (Thomas, J., concurring). Thomas's concurrence in *Tam III* is not the first time he criticized *Central Hudson* and proposed eliminating the test it established. See *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 518 (1996) (Thomas, J., concurring).

<sup>189</sup> See *Tam III*, 137 S. Ct. at 1749 (addressing narrowly § 2(a) of the Lanham Act pertaining to the disparagement clause and refraining from implicating the immoral and scandalous clauses); *infra* note 254 (discussing the Supreme Court's 2019 case *Brunetti* where the question presented asks whether the immoral and scandalous clauses are unconstitutional).

<sup>190</sup> See 15 U.S.C. § 1051 (2012) (enacting legislation pursuant to Congress's commerce power under Art. 1, § 8, cl. 3 of the Constitution); *Trade-Mark Cases*, 100 U.S. 82, 96–97 (1879).

<sup>191</sup> See *Matal v. Tam*, 137 S. Ct. 1744, 1754 (2017) (*Tam III*) (describing the arguments that commercial speech can contain both commercial and non-commercial elements); *In re Tam*, 808 F.3d 1321, 1377 (Fed. Cir. 2015) (*Tam II*) (Reyna, J., dissenting) (same).

sought to use their trademark, “The Slants,” as a form of political and social activism.<sup>192</sup> The Court has struggled over the years with balancing the interpretation of these commercial and non-commercial speech elements in trademark registrations.<sup>193</sup> As a result, there is confusion among courts over the appropriate interpretation of the intersection between trademarks and commercial speech.<sup>194</sup> This Part addresses this jurisprudential discrepancy.<sup>195</sup> Section A of this Part discusses the interpretation of trademarks as commercial speech.<sup>196</sup> Section B analyzes the argument for dismissing the distinction between commercial and non-commercial speech and instead viewing trademarks under a strict scrutiny lens.<sup>197</sup>

### A. The Case for Trademarks as Commercial Speech

Prior to the Court’s decision in *Tam*, the *Central Hudson Gas & Electric Corp. v. Public Service Commission of New York* test had largely controlled the regulation of trademarks.<sup>198</sup> The *Central Hudson* test guides the constitution-

<sup>192</sup> *Tam III*, 137 S. Ct. at 1754.

<sup>193</sup> *See id.* at 1769 (Thomas, J., concurring) (arguing that where there are commercial and non-commercial speech elements the distinction should cease to exist and all speech should be viewed under the same strict scrutiny analysis); *Tam II*, 808 F.3d at 1376 (Reyna, J., dissenting) (advocating that when there are commercial and non-commercial speech elements, the commercial elements are the overriding concerns for the characterization of trademarks as commercial speech); *Bad Frog Brewery v. N.Y. State Liquor Auth.*, 134 F.3d 87, 96 (2d Cir. 1998) (holding that the non-commercial speech elements of a trade name do not outweigh the characterization of the trade name as commercial speech).

<sup>194</sup> *See Tam III*, 137 S. Ct. at 1754 (failing to address whether trademarks are commercial speech); *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 517 (1996) (Scalia, J., concurring) (hinting at eliminating the intermediate scrutiny standard for commercial speech and replacing it with a strict scrutiny standard); *Bad Frog Brewery*, 134 F.3d at 96 (recognizing that commercial speech includes trade names).

<sup>195</sup> *See infra* notes 198–250 and accompanying text (discussing the arguments in favor of trademarks as commercial speech and arguments in favor of trademarks as non-commercial speech).

<sup>196</sup> *See infra* notes 198–226 and accompanying text (presenting the case for trademarks as commercial speech).

<sup>197</sup> *See infra* notes 227–250 and accompanying text (demonstrating the case for trademarks as non-commercial speech). An analysis of the “hybrid” approach, which would require the U.S. Patent and Trademark Office (USPTO) to make determinations of where trademarks are sometimes commercial speech and are sometimes not is beyond the scope of this Note. Further, it is likely beyond the scope of the USPTO’s resources to determine the extent of whether a given trademark is commercial or non-commercial because of the finite resources of the office. *See Tushnet, supra* note 63, at 751 n.80. (discussing the USPTO’s scarce resources). No trademark is purely non-commercial because of its inherent connection to commerce. *See* 15 U.S.C. § 1051 (requiring that the mark be used “in commerce” to obtain trademark registration).

<sup>198</sup> *See Tam III*, 137 S. Ct. at 1749 (addressing the *Central Hudson* test but then refraining from engaging in meaningful discussion of the inquiry); *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 562–64 (1980) (providing the test); Jennifer E. Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 CARDOZO L. REV. 105, 153 (2005) (indicating the Court’s use of the *Central Hudson* test for commercial speech regulations, such as trademark restrictions). Even though there has been criticism of the *Central Hudson* test, the Su-

ality of commercial speech by reasoning that commercial speech is easier to regulate because its distribution is more “easily verifiable” and “durable” than non-commercial speech, thus withstanding more regulation.<sup>199</sup> It is still an unanswered question as to which of these analyses applies to trademarks.<sup>200</sup> Several majority opinions in the U.S. Courts of Appeals have explicitly characterized trademarks as commercial speech.<sup>201</sup> For example, in 1997 in *Bad Frog Brewery, Inc. v. New York State Liquor Authority*, the U.S. Court of Appeals for the Second Circuit classified a beer label with a cartoon frog making a vulgar gesture as commercial speech.<sup>202</sup>

Some courts have also viewed trademarks that convey product information as commercial speech.<sup>203</sup> The Supreme Court has previously implied that trademarks are always commercial speech by rationalizing that the purpose of a trademark is to “propos[e] a commercial transaction.”<sup>204</sup> In 1983, the Court in *Bolger v. Youngs Drug Products Corp.* recognized that, even though commercial and public interest elements of speech are often intertwined, the overriding speech elements that are commercial necessitate that the speech should receive intermediate scrutiny.<sup>205</sup> To determine whether speech is com-

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preme Court has not explicitly overruled it. See *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 554–55 (2001) (admitting in the majority opinion that several members of the Court express doubts about the applicability of *Central Hudson*).

<sup>199</sup> *Cent. Hudson*, 447 U.S. at 561, 568; *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council*, 425 U.S. 748, 771 n.24 (1976). Historically, commercial speech received no First Amendment protection. *Valentine v. Chrestensen*, 316 U.S. 52, 54 (1942). It was not until *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council* that commercial speech began to receive First Amendment protections. 425 U.S. at 770.

<sup>200</sup> See *infra* notes 201–250 and accompanying text (demonstrating the different characterizations of trademarks as commercial or non-commercial speech).

<sup>201</sup> See, e.g., *Bad Frog Brewery*, 134 F.3d at 101 (characterizing the cartoon on the label of a beer bottle as a form of commercial speech); *Sambo’s Rests., Inc. v. City of Ann Arbor*, 663 F.2d 686, 694 (6th Cir. 1981) (classifying Sambo’s trademark for its restaurant name as commercial speech because it identified the quality and reputation of the establishment to consumers).

<sup>202</sup> *Bad Frog Brewery*, 134 F.3d at 101. Even under the analysis of intermediate scrutiny, the regulation at issue did not meet the government’s burden to identify a compelling interest that was reasonably tailored to that interest. *Id.* at 98–100. The interest of protecting kids was not directly advanced by the regulation because the beer bottle label was primarily distributed in establishments where children did not have access to the material. *Id.* at 100. This is an example of how the government’s power to regulate is not absolute even when trademarks are classified as commercial speech. See *id.* (describing an instance where a regulation was invalid under a commercial speech analysis).

<sup>203</sup> See *Friedman v. Rogers*, 440 U.S. 1, 7, 13 (1979) (acknowledging that the trademark for the Texas Optometry Board conveyed useful product information about the composition of its members, but holding that the government may prohibit trademarks that are deceptive even if the product information contained in them is truthful).

<sup>204</sup> See *Cent. Hudson*, 447 U.S. at 562 (asserting that the genus of commercial speech proposes a commercial transaction); *Friedman*, 440 U.S. at 11 (characterizing trade names in connection with a particular business as “a form of commercial speech and nothing more”).

<sup>205</sup> 463 U.S. 60, 67 (1983); see *Cent. Hudson*, 447 U.S. at 562, n.5 (acknowledging that speech cannot transform outside the commercial speech realm simply by adding a political element to it);

mercial, the Court developed the three-factor *Bolger* test, which considers whether (1) the speech constitutes advertising; (2) the speech refers to a specific product; and (3) the speaker has an economic motivation.<sup>206</sup> Although not all factors are required for speech to be considered commercial, and no factor is necessarily more determinative than the others, trademarks arguably answer all the *Bolger* factors' questions in the affirmative.<sup>207</sup>

In the *Matal v. Tam* decision at the Federal Circuit level, Judge Reyna dissented after analyzing the case law and its characterization of trademarks as commercial speech.<sup>208</sup> He used the *Bolger* framework and argued that, despite Tam's band name containing political and non-commercial elements, the overall speech, when taken as a whole, was commercial.<sup>209</sup> According to Judge Reyna, trademarks satisfy the first factor of the *Bolger* test because marks like "THE SLANTS" advertise the source of the product.<sup>210</sup> The mark also refers to a specific product—in the *Tam* case, Tam's band, "THE SLANTS."<sup>211</sup> Lastly, due to the tie-in of federal registration of trademarks with interstate commerce, Tam has an economic motivation for his speech.<sup>212</sup> Because federal registration provides trademarks with exclusive use rights, trademark law allows the trademark owner to prevent infringement and profit off speech.<sup>213</sup> As trademarks satisfy all three factors of the *Bolger* test, Judge Reyna concluded that trademarks are commercial speech.<sup>214</sup>

In addition, Judge Reyna focused on the purpose of the Lanham Act as a whole in promoting "the orderly flow of commerce."<sup>215</sup> This, he reasoned, aligns with the purpose of the disparagement clause.<sup>216</sup> Drawing back on the historic Civil Rights cases, like *Katzenbach v. McClung*, Judge Reyna argued

*Bigelow v. Virginia*, 421 U.S. 809, 826 (1975) (recognizing that public messages concerning issues of public importance can also be commercial in nature).

<sup>206</sup> *Bolger*, 463 U.S. at 67 (recognizing that speech must be taken as a whole); Pomeranz & Adler, *supra* note 31, at 41.

<sup>207</sup> *See Bolger*, 463 U.S. at 67 (describing the factors that commercial speech (1) is related to advertising, (2) is about a specific product, and (3) has economic motivation); Pomeranz & Adler, *supra* note 31, at 41 (characterizing the factors listed in *Bolger* as a test created by the Court); *infra* notes 208–214 and accompanying text (detailing how trademarks meet each factor of the *Bolger* test).

<sup>208</sup> *Tam II*, 808 F.3d at 1376 (Reyna, J., dissenting).

<sup>209</sup> *See id.* (focusing on the importance of the speech taken together as a whole that is central to the *Bolger* analysis).

<sup>210</sup> *Id.* at 1377.

<sup>211</sup> *Id.*

<sup>212</sup> *Id.*

<sup>213</sup> *Id.* at 1377, 1381.

<sup>214</sup> *Id.* at 1378.

<sup>215</sup> *Id.* at 1376; *see* 15 U.S.C. § 1125 (2012) (regulating trademarks and promoting the orderly flow of commerce).

<sup>216</sup> *Tam II*, 808 F.3d at 1376 (Reyna, J., dissenting); *see* 15 U.S.C. § 1052(a) (noting the disparagement clause prevents the registration of marks that denigrate a substantial composite of the referenced group).

that disparagement and discrimination against minorities in particular interrupts the free flow of commerce, thus interrupting interstate commerce that Congress has the power to regulate.<sup>217</sup> The power to regulate interstate commerce is a substantial government interest satisfying the first prong of intermediate scrutiny, begging only the question of whether the trademark regulation is narrowly drawn.<sup>218</sup> Judge Reyna questioned that if the power to regulate commerce did not satisfy a substantial government interest, then the government would have no power to register trademarks at all, as trademark registration inherently involves prohibiting speech that is infringing on registered marks.<sup>219</sup>

Judge Reyna also advanced the position that the Lanham Act's restriction on disparaging speech was content-neutral, not content-based.<sup>220</sup> A restriction that facially may appear content-based may still meet content-neutral requirements if the purpose of the regulation is not to suppress speech, but to prevent the harmful secondary effects of the speech that can be mitigated by regulating the speech's time, place, or manner.<sup>221</sup> This is known as the secondary effects doctrine.<sup>222</sup> The secondary effects doctrine has been advanced in cases affirming the constitutionality of bans against the content of expression, including

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<sup>217</sup> *Tam II*, 808 F.3d at 1379 (Reyna, J., dissenting); see *Katzenbach v. McClung*, 379 U.S. 294, 299–300 (1964) (describing how discriminatory actions, even absent conduct, can cause disruptions in the marketplace that are a prime government concern); *supra* note 62 (providing background information on the Civil Rights cases affecting interstate commerce).

<sup>218</sup> *Tam II*, 808 F.3d at 1378 (Reyna, J., dissenting).

<sup>219</sup> *Id.*

<sup>220</sup> See *id.* (“[T]he government has never stated that the purpose of § 2(a) is to suppress speech. Only the Majority has advanced this rationale . . .”).

<sup>221</sup> *Id.*

<sup>222</sup> *Id.* at 1378–79. The secondary effects doctrine was first adopted to regulate adult entertainment in zoning plans. *Young v. Am. Mini Theatres, Inc.*, 427 U.S. 50, 71 n.34 (1976). In *Young v. American Mini Theatres, Inc.*, the Court upheld Detroit's zoning ordinance that restricted the development of an adult entertainment movie business near certain residential areas. *Id.* at 72–73. The Court held that the ordinance was not intended to suppress the offensive speech, but rather to combat the “secondary effect” of neighborhood deterioration and increased crime rates that accompany movie theaters displaying adult entertainment. *Young*, 427 U.S. at 71 n.34. In 1986, in *City of Renton v. Playtime Theaters, Inc.*, the Court reiterated the secondary effects. 475 U.S. 41, 47, 50 (1986). Similar to *Young*, at issue in *City of Renton* was another zoning ordinance that facially appeared to be content-based; the Court, however, upheld the constitutionality of the ordinance restricting adult business in certain areas because of the secondary effects of adult businesses in places like churches, parks, and schools. *City of Renton*, 475 U.S. at 46; *Young*, 427 U.S. at 71. Then, in 1991, Justice David Souter's concurrence in *Barnes v. GlenTheatre, Inc.* claimed that the scope of the secondary effects doctrine extended beyond zoning ordinances to include a state law that regulated nude expression in strip clubs. 501 U.S. 560, 584 (1991) (Souter, J., concurring). In 2000, in *City of Erie v. Pap's A.M.*, the Court articulated the rationale of Justice Souter's concurrence in *Barnes* by extending the secondary effects doctrine to uphold a ban on fully-nude dancing. See *City of Erie v. Pap's A.M.*, 529 U.S. 277, 297 (2000) (noting the Court's adoption of Justice Souter's rationale despite Justice Souter's disavowal of his *Barnes* concurrence with his part concurrence and part dissent in *City of Erie*).



upholding a ban on fully nude dancing.<sup>223</sup> In *City of Erie v. Pap's A.M.*, decided by the Supreme Court in 2000, the regulation at issue restricted certain types of expression; the overriding purpose of the regulation, however, was promoting the secondary effects of public health, safety, and welfare.<sup>224</sup> Even if the regulation implicates content, the Court views such speech as content-neutral when the primary purpose is to address the secondary effects of such speech.<sup>225</sup> In line with Judge Reyna's view, the International Trademark Association, a global organization to promote and understand trademark law, also advocates for trademarks as commercial speech because of the intrinsic nature of trademarks, in that they help consumers identify the source of products and services in the marketplace.<sup>226</sup>

### B. The Case for Trademarks as Non-Commercial Speech

Although the Supreme Court has yet to explicitly overrule the *Central Hudson* test, several justices have expressed doubt as to the continued relevance of the distinction between commercial and non-commercial speech.<sup>227</sup> In its place, these justices seem to favor a heightened scrutiny for commercial speech, equal to a strict scrutiny standard like that of non-commercial speech.<sup>228</sup> For

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<sup>223</sup> See *City of Erie*, 529 U.S. at 283, 297 (upholding a city law prohibiting persons from knowingly or intentionally appearing nude in public).

<sup>224</sup> *Id.* at 279. An adult business featuring erotic dancing challenged the city ordinance for violating freedom of expression under the First Amendment. *Id.* at 282–83. The Supreme Court of Pennsylvania held that the city's restriction was content-based and that it failed to meet the higher burden of strict scrutiny. *Id.* at 286. The Supreme Court instead focused on the secondary effects doctrine and emphasized that the minimal restriction furthered the government interest of public health and safety. *Id.* at 282.

<sup>225</sup> *Id.* at 282–83. The Court found it increasingly important to address the issue of the applicability of the secondary effects doctrine despite the club owner's argument that the issue was moot. See *id.* at 287 (denying the erotic club owner's motion to dismiss the case based on the corporation ceasing operations at the location at issue and granting certiorari due to the club's continued incorporation in the state).

<sup>226</sup> Brief for the International Trademark Association as Amicus Curiae Supporting Respondent at 1, 14, *Lee v. Tam*, 137 S. Ct. 30 (2016) (No. 15-1293); see *Tam II*, 808 F.3d at 1378–79 (Reyna, J., dissenting) (arguing trademarks meet all the requirements for commercial speech protections).

<sup>227</sup> See *Lorillard Tobacco Co.*, 533 U.S. at 554–55 (acknowledging that some members of the Court question the continued use of the *Central Hudson* test); see, e.g., *Greater New Orleans Broadcasting Ass'n, Inc. v. United States*, 527 U.S. 173, 197 (1999) (Thomas, J., concurring) (advocating for the dismissal of the *Central* test in an injunctive relief request case involving gambling advertisements); *44 Liquormart, Inc.*, 517 U.S. at 512 (Stevens, Kennedy, Ginsburg, JJ., joint opinion) (finding the application of the *Central Hudson* test to be incompatible with justifying a total ban on certain types of commercial speech); *44 Liquormart, Inc.*, 517 U.S. at 517 (Scalia, J., concurring) (questioning the continued use of the *Central Hudson* test).

<sup>228</sup> See *Tam III*, 137 S. Ct. at 1769 (Thomas, J., concurring) (desiring to eliminate completely the *Central Hudson* test); *Greater New Orleans Broadcasting Ass'n, Inc.*, 527 U.S. at 197 (Thomas, J., concurring) (favoring heightened scrutiny because any asserted government interest in restricting advertisements for gambling is per se illegitimate); *44 Liquormart, Inc.*, 517 U.S. at 517 (Scalia, J.,

example, in the 1996 Supreme Court case, *44 Liquormart, Inc. v. Rhode Island*, which did not have a majority, the concurrences suggest an end to the commercial speech doctrine.<sup>229</sup> Even Justice John Paul Stevens's plurality opinion argued that while the commercial speech doctrine is necessary for protecting consumers against misleading and deceptive information, absent deception, the Court should not depart from the heightened strict scrutiny standard of the First Amendment enjoyed by individuals.<sup>230</sup> In a separate concurrence, Justice Antonin Scalia supported Justice Thomas's proposition to toss out any distinction between commercial and non-commercial speech altogether.<sup>231</sup> Justice Scalia, a well-known textualist, found no view outside of public policy to support the current distinction between commercial and non-commercial speech.<sup>232</sup> Justice Thomas, in his concurrence in *Tam*, again reiterated his desire to subject all speech regulations, commercial or otherwise, to a strict scrutiny analysis.<sup>233</sup> Further, in other cases, judges argued that the appropriate regulation for offensive or disparaging trademarks was not censorship from government regulation, but rather free range in the marketplace.<sup>234</sup> Consumer demand would determine the success of a so-called "offensive" trademark, with

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concurring) (hinting at the need for the elimination of the *Central Hudson* test in favor of heightened scrutiny).

<sup>229</sup> See 517 U.S. at 517 (Scalia, J., concurring) (hinting at replacing the intermediate scrutiny standard for commercial speech with a strict scrutiny standard); *id.* at 518 (Thomas, J., concurring) (arguing there is no justification for any distinction between commercial and non-commercial speech). In *44 Liquormart Inc. v. Rhode Island*, the Court held unconstitutional a Rhode Island state ban on the display of alcohol prices outside an establishment selling liquor. *Id.* at 489–90, 516. The Court emphasized that such a ban infringes on a seller's freedom of speech under the First Amendment. *Id.* at 516. The state of Rhode Island failed to establish how its restriction furthered the government purpose of protecting consumers against commercial harms. *Id.* at 502. Given this lack of evidence from the state, the Court prioritized the public interest in consumer information in the marketplace. *Id.* at 497, 516.

<sup>230</sup> *Id.* at 501.

<sup>231</sup> *Id.* at 517 (Scalia, J., concurring).

<sup>232</sup> *Id.*; Ralph A. Rossum, *The Textualist Jurisprudence of Justice Scalia*, 28 PERSPS. ON POL. SCI. 5, 5 (1999).

<sup>233</sup> See *Tam III*, 137 S. Ct. at 1769 (Thomas, J., concurring) (repeating his desire to eliminate the distinction between commercial and non-commercial speech that he articulated in *44 Liquormart*, 517 U.S. at 518 (Thomas, J., concurring)).

<sup>234</sup> See, e.g., *Bad Frog Brewery*, 134 F.3d at 101 (allowing vulgar speech to be disseminated in the marketplace). In *Bad Frog Brewery v. New York State Liquor Authority*, the U.S. Court of Appeals for the Second Circuit held that New York's state ban on the use of a beer label with a cartoon frog "giving the [middle] finger" was not a commercial speech restriction tailored enough to further the government's interest in preserving children from vulgarity. *Id.* The Second Circuit emphasized that beer labels are often used in bars where children are more likely to be supervised by their parents. *Id.* at 102. The Second Circuit further reiterated the importance of public information for consumers in the marketplace when there is no overriding government interest in a regulation—the principle that was reinvigorated in *44 Liquormart*. *Id.* at 96, 101; see *44 Liquormart Inc.*, 517 U.S. at 503–04 (emphasizing the importance of consumer information and choice in the marketplace).

the end result that undesirable trademarks would not be profitable and would be abandoned.<sup>235</sup>

The majority opinion in *Tam* contained discussion suggesting that the commercial speech restrictions at issue should be subject to strict scrutiny because of the content-based nature of the disparagement clause.<sup>236</sup> The Court in *Tam* never explicitly referred to the trademark at issue as commercial speech.<sup>237</sup> The Court declined answering that question because it first determined that the regulation at issue was content-based, rather than content-neutral.<sup>238</sup> Content-based restrictions that impart viewpoint discrimination are unconstitutional.<sup>239</sup> As a general rule, the government is prohibited from favoring certain speech over other types of speech.<sup>240</sup> The Court's focus on its content-based determination over the analysis of commercial speech suggests that the distinction between non-commercial and commercial speech is irrelevant.<sup>241</sup>

Further, contrary to Judge Reyna's analysis, trademarks may not pass the *Bolger* test.<sup>242</sup> Trademarks can be registered for both for-profit and non-profit

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<sup>235</sup> See, e.g., Andrew Romano, *Pancakes and Pickaninnies: The Saga of 'Sambo's,' the 'Racist' Restaurant Chain America Once Loved*, DAILY BEAST (June 30, 2014), <https://www.thedailybeast.com/pancakes-and-pickaninnies-the-saga-of-sambos-the-racist-restaurant-chain-america-once-loved> [<https://perma.cc/27A2-324D>] (providing an example of consumer demand dictating the profitability of a mark). The dining chain Sambo's Restaurant heavily associated itself with the story of the black servant, "Little Black Sambo," by decorating the interior of the restaurant with images from the story. *Id.* Following outcry from leaders in the black community, growth of the allegedly racist restaurant chain stalled, which forced the company to close several of its locations. *Id.*

<sup>236</sup> See *Tam III*, 137 S. Ct. at 1749 (suggesting that a content-based inquiry determination should occur prior to a commercial speech analysis).

<sup>237</sup> See *id.* (dodging the question of whether trademarks are commercial speech).

<sup>238</sup> *Id.* The Court engaged in a viewpoint discrimination analysis that applies to heightened content-based restrictions rather than content-neutral restrictions. See Jacobs, *supra* note 145, at 596–98 (detailing the application of content-based, content-neutral, and viewpoint discrimination analyses for free speech).

<sup>239</sup> *Tam III*, 137 S. Ct. at 1749; Jacobs, *supra* note 145, at 599.

<sup>240</sup> See *Tam III*, 137 S. Ct. at 1749 (emphasizing the unconstitutionality of viewpoint discrimination); *Texas v. Johnson*, 491 U.S. 397, 414 (1989) (reiterating the established principle that the government may not regulate speech it finds offensive); *Street v. New York*, 394 U.S. 576, 592 (1969) (same). There is one narrow exception where the government may favor certain types of speech if such speech is classified as government speech, meaning the speaker of the speech is the government. See *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2246 (2015) (stopping the First Amendment inquiry and refraining from engaging in a viewpoint discrimination analysis because the specialty license plates at issue, which displayed Confederate flags, were characterized as government speech).

<sup>241</sup> See *Tam III*, 137 S. Ct. at 1749 (holding the disparagement clause is unconstitutional by first assessing the content-based nature of the restriction rather than first assessing whether trademarks are commercial or non-commercial speech); *id.* at 1769 (Thomas, J., concurring) (continuing to advocate for the elimination of the arbitrary distinction between commercial and non-commercial speech that Thomas first articulated in *44 Liquormart*, 517 U.S. at 518 (Thomas, J., concurring)).

<sup>242</sup> See *Tam II*, 808 F.3d at 1379–81 (Reyna, J., dissenting) (arguing that trademarks meet all the factors of the *Bolger* test for determining whether speech is commercial); Pomeranz & Adler, *supra* note 31, at 40–41 (characterizing the Court's decision in *Bolger* as a three-part test for determining

entities, limiting the economic motivation for the trademark at issue.<sup>243</sup> This would cut against the third factor of the *Bolger* test for determining whether the speech at issue is commercial.<sup>244</sup> For instance, the non-profit group People for the Ethical Treatment of Animals registered their trademark name—PETA.<sup>245</sup> This trademark, like many other non-profits' registered marks, is used in commerce, but not for economic gain.<sup>246</sup> Since PETA's trademark is arguably used for non-commercial reasons, the argument follows that the trademark is not commercial speech.<sup>247</sup> Alternatively, the example suggests that the line between commercial and non-commercial speech has become so blurred that it fails to be a bright line distinction in First Amendment jurisprudence.<sup>248</sup> If, as Justice Thomas's concurrence suggests, the line between commercial and non-commercial speech is irreversibly blurred, then speech can only be subjected to a single tier of scrutiny.<sup>249</sup> By necessity, all speech regulations must inevitably be reviewed under strict scrutiny, and this includes restrictions on registering trademarks.<sup>250</sup>

### III. WHY TRADEMARKS SHOULD BE CONSIDERED COMMERCIAL SPEECH AND THE FUTURE OF DILUTION IN THE LANHAM ACT

If the fate of the commercial speech doctrine follows Justice Thomas's concurrence in *Matal v. Tam*, then all trademark law would have to meet the burden of strict scrutiny analysis, and vast pieces of the Lanham Act would begin to break apart.<sup>251</sup> A great deal of prohibitions in the Lanham Act are ar-

whether speech is commercial); *infra* notes 243–248 and accompanying text (countering that trademarks can be registered for non-profits which arguably do not have an economic motivation component).

<sup>243</sup> See 15 U.S.C. § 1051 (indicating that “use in commerce” is not synonymous with profit because there is no prohibition on non-profits registering for trademarks); *Bolger*, 463 U.S. at 69 (articulating the economic motivation requirement for a commercial speech characterization).

<sup>244</sup> See *Bolger*, 463 U.S. at 69 (describing the third factor as the economic motivation of the speaker); Pomeranz & Adler, *supra* note 31, at 40–41 (dissecting the *Bolger* decision into a separate factor analysis).

<sup>245</sup> PETA, Registration No. 2941086; Tait, *supra* note 42, at 932.

<sup>246</sup> Tait, *supra* note 42, at 932; see NORML, Registration No. 0997137 (registering word mark for educational services on marijuana); NRA, Registration No. 1885345 (registering word mark for gun advocacy).

<sup>247</sup> See Tait, *supra* note 42, at 932 (arguing that non-commercial speech elements override any of the commercial elements of the trademark).

<sup>248</sup> See *id.* (advocating for removal of the commercial and non-commercial speech distinction).

<sup>249</sup> See GREENFIELD, *supra* note 16, at 137 (defining strict scrutiny as the level of judicial review accorded to non-commercial speech).

<sup>250</sup> See *Tam III*, 137 S. Ct. at 1769 (Thomas, J., concurring) (advocating for the elimination of intermediate scrutiny analysis of trademark regulations); GREENFIELD, *supra* note 16, at 137 (detailing the importance of protecting speech interests).

<sup>251</sup> See 15 U.S.C. § 1052 (2012) (defining the prohibition on misdescriptive marks); *id.* § 1125 (defining the restriction on marks that dilute registered marks); *Matal v. Tam*, 137 S. Ct. 1744, 1769 (2017) (*Tam III*) (Thomas, J., concurring) (arguing for a strict scrutiny analysis for trademarks); *In re Tam*, 808 F.3d 1321, 1379–81 (Fed. Cir. 2015) (*Tam II*) (Reyna, J., dissenting) (criticizing the adop-

guably content-neutral and not content-based, but the Court found in *Tam* that the disparagement clause was content-based, and thus unconstitutional, because it allowed examiners to engage in viewpoint discrimination.<sup>252</sup> In *Tam*, the disparagement clause was content-based, yet the Supreme Court bypassed any analysis of whether the disparagement clause was to serve the purpose of mitigating any secondary effects.<sup>253</sup> The immoral and scandalous clause faced the same problem before the Court in *Iancu v. Brunetti*.<sup>254</sup> The Court's affirmative holding impacts not just federal law but state law as well, as more than forty states also prohibit registration of scandalous or immoral trademarks.<sup>255</sup> By arguing that the bar on misdescription is not narrowly tailored enough to survive strict scrutiny because it prohibits some truthful—albeit potentially misleading—speech, an entity could likely successfully argue that the bar on misdescription is arbitrary, and therefore unconstitutional.<sup>256</sup> Alternatively, an

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tion of strict scrutiny analysis for trademark restrictions and favoring intermediate scrutiny analysis for commercial speech).

<sup>252</sup> 137 S. Ct. at 1758; see 15 U.S.C. § 1052 (describing prohibitions on trademarks that are identical to each other, merely descriptive, or geographically deceptively misdescriptive to combat the likelihood of confusion).

<sup>253</sup> See *Tam III*, 137 S. Ct. at 1749 (refraining from engaging in commercial speech analysis of trademarks).

<sup>254</sup> 15 U.S.C. § 1052; see *supra* note 24 (granting certiorari to *In re Brunetti* to address whether the immoral and scandalous clause is facially unconstitutional under the First Amendment). If the Court becomes comfortable acknowledging that trademarks are commercial speech, it could set a precedent for identifying other forms of commercial speech, such as corporate spending on campaign finance. See *Tam III*, 137 S. Ct. at 1749 (addressing the Court's reluctance to engage in a commercial speech analysis); *Citizens United v. FEC*, 558 U.S. 310, 340, 371 (2010) (refraining from distinguishing between corporate speech and commercial speech). This could potentially set the stage for altering the precedent in *Citizens United v. FEC*, which is criticized by a majority of Americans. See 558 U.S. at 371 (eschewing any commercial speech distinction and instead holding the federal ban capping campaign finance expenditures by corporations violated the First Amendment); GREENFIELD, *supra* note 16, at xi–xii (describing *Citizens United* as one of the most despised Supreme Court decisions); Greg Stohr, *Bloomberg Poll: Americans Want Supreme Court to Turn Off Political Spending Spigot*, BLOOMBERG (Sept. 28, 2015), <https://www.bloomberg.com/news/articles/2015-09-28/bloomberg-poll-americans-want-supreme-court-to-turn-off-political-spending-spigot> [https://perma.cc/R2Z6-UM3Y] (demonstrating that 78% of Americans believe the holding in *Citizens United* should be overturned). In *Citizens United*, the Supreme Court found that political speech from anyone, including corporations, was subject to strict scrutiny, and thus the government could not implement regulations restricting campaign spending based on the speaker. 558 U.S. at 340.

<sup>255</sup> See Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*, 101 TRADEMARK REP. 1476, 1477 n.3 (2011) (detailing that forty-seven states have statutes that prohibit registration of immoral, scandalous, or disparaging marks); Kimberly A. Pace, *The Washington Redskins Case and the Doctrine of Disparagement: How Politically Correct Must a Trademark Be?*, 22 PEPPERDINE L. REV. 7, 23 n.100 (1994) (describing that forty-six states have these restrictions); Theodore H. Davis, Jr., *Registration of Scandalous, Immoral, and Disparaging Matter Under Section 2(a) of the Lanham Act: Can One Man's Vulgarity Be Another's Registered Trademark?*, 54 OHIO STATE L.J. 331, 333 n.9 (1993) (detailing forty-four states that have these regulations).

<sup>256</sup> 15 U.S.C. § 1052; see *Tam II*, 808 F.3d at 1379 (Reyna, J., dissenting) (postulating that a strict scrutiny analysis would be unsatisfactory for the continuation of trademark regulations).

entity could also argue that the restriction is content-based because the regulation favors speech that will not mislead customers.<sup>257</sup> It is undisputed that the regulation at issue is content-based, but such a determination does not automatically mean strict scrutiny should apply; and, further, if it were to apply, it would be a very high burden to meet.<sup>258</sup> As Judge Reyna warned in his dissent for the U.S. Court of Appeals for the Federal Circuit, if the government's justification for the disparagement clause—to encourage the free flow of commerce—does not meet intermediate scrutiny, then it is difficult to imagine what type of restriction on trademark registration that permits USPTO discretion will be allowed.<sup>259</sup>

Moreover, under a strict scrutiny analysis for trademark regulation, it becomes increasingly difficult to justify dilution as a recognized cause of action.<sup>260</sup> Dilution laws allow the federal government to regulate truthful and non-misleading speech because the proliferation of the speech at issue in the marketplace tarnishes or blurs the distinctiveness of the trademark, therefore “diluting” it.<sup>261</sup> In passing the Federal Dilution Act, Congress forbade tarnishment by favoring registered marks and disfavoring the free expression of individuals.<sup>262</sup>

Tarnishment laws allow the government to favor certain types of speech over others by permitting the government to decline registering a mark that is potentially satirical or sexual but not obscene.<sup>263</sup> Such marks would otherwise be protected by the First Amendment but, because of tarnishment laws, the government is allowed to favor the unblemished reputation of the famous mark.<sup>264</sup> Under the scope of the *Tam* decision and, in particular, Justice Thomas's concurrence, it is likely that dilution laws will also be held unconstitutional

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<sup>257</sup> 15 U.S.C. § 1052; see *Tam II*, 808 F.3d at 1380 (Reyna, J., dissenting) (arguing that if the government's substantial interest is not the flow of commerce then it is difficult to imagine what interest would meet this high burden).

<sup>258</sup> See Brief of Petitioner, *supra* note 23, at 12 (conceding that the trademark restrictions in § 2(a) of the Lanham Act are content-based); GREENFIELD, *supra* note 16, at 137 (indicating strict scrutiny is the highest level of judicial review).

<sup>259</sup> *Tam II*, 808 F.3d at 1379 (Reyna, J., dissenting).

<sup>260</sup> See Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, § 3, 109 Stat. 985, 985–86 (1996); (creating a cause of action for dilution by blurring and dilution by tarnishment); Ramsey, *supra* note 49, at 837–38 (describing dilution laws as outside of the trademark infringement framework because dilution occurs when the trademark is not false or could conceivably be fraud).

<sup>261</sup> Oswald, *supra* note 109, at 262–64; Ramsey, *supra* note 49, at 817.

<sup>262</sup> See Federal Trademark Dilution Act § 3 (protecting the reputation of registered marks that are famous).

<sup>263</sup> See *id.* (refraining from creating an exception for satirical or sexual marks).

<sup>264</sup> See *id.* (allowing the government to restrict registration of marks that negatively affect the reputation of a famous registered mark); *Miller v. California*, 413 U.S. 15, 18–20 (1973) (recognizing that obscene speech is outside the ambit of First Amendment protections).

for being “content-based restrictions.”<sup>265</sup> This is despite the fact that the government’s purpose in dilution law regulation is to correct the secondary effects of overusing terms in the marketplace and reputational effects on established brands.<sup>266</sup> The government’s goal of regulating the orderly flow of commerce is in line with the general aim of trademark law to serve the dual purposes of helping consumers identify products and services and incentivizing companies to build their brand name reputation.<sup>267</sup>

Further, a commercial speech analysis is appropriate even when the mark owner is a non-profit, arguably without economic motivation, because there is a distinction between “registering” a trademark and the “use” of a trademark.<sup>268</sup> Although the “use” of a trademark by a non-profit may contain predominantly non-commercial aspects, the “registration” of a trademark has overwhelming commercial aspects because federal trademark registration only exists within the ambit of the Constitution’s Commerce Clause.<sup>269</sup> Because registering a trademark confers national protections, a mark owner seeks these protections for exclusive use so that no one else can use the mark in commerce and profit from it.<sup>270</sup> In addition, registering a trademark has many commercial benefits, including, among others, the greater ability to obtain exclusive use rights in foreign countries and to prevent others from using your trademark for misleading and dilutive purposes.<sup>271</sup> Moreover, freedom to obtain an exclusive use

<sup>265</sup> See *Tam III*, 137 S. Ct. at 1769 (Thomas, J., concurring) (arguing for a heightened strict scrutiny standard). This arguably suggests that even when an alleged surface-level content-based restriction is at play, the government’s interest in improving the free flow of commerce and information to consumers is not a substantial government interest. See *id.*

<sup>266</sup> See Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, § 2, 120 Stat. 1730, 1730–32 (2006) (redefining the causes of action for dilution to only need likelihood of dilution rather than evidence of actual dilution); *City of Erie v. Pap’s A.M.*, 529 U.S. 277, 282–83 (2000) (highlighting the governmental interest in regulating the secondary effects of speech).

<sup>267</sup> See Trademark Dilution Revision Act of 2006 § 2 (reiterating the purpose of the dilution act to promote the flow of commerce and protect brand reputation); *Tam II*, 808 F.3d at 1380 (Reyna, J., dissenting) (identifying the government’s interest in regulating the orderly flow of commerce); Fox Rothschild LLP, *Slanting Toward the End of the Commercial Speech Doctrine*, ABOVE THE FOLD (June 22, 2017), <https://advertisinglaw.foxrothschild.com/2017/06/slanting-toward-end-commercial-speech-doctrine/> [<https://perma.cc/NK3L-Y95V>] (emphasizing that dilution laws encourage brand reputation building and the importance of the Lanham Act in standardizing the trademark system to help identify goods).

<sup>268</sup> See Alexandra Martinez, *The Act of Registering a Trademark: Commercial Speech, Non-Commercial Speech, or a Combination of Both?*, at 20–21 (2017) (unpublished student note, J.D. Candidate U.C. Hastings) (on file with the International Trademark Association), <https://www.inta.org/Academics/Pages/LadasMemorialAward.aspx> [<https://perma.cc/35TR-FMZS>] (arguing the registration of trademarks is a purely commercial activity because of the exclusive rights of use benefits offered to the mark owner).

<sup>269</sup> U.S. CONST. Art. I, § 8, cl. 8; Trade-Mark Cases, 100 U.S. 82, 96–99 (1879); Martinez, *supra* note 268, at 20–21.

<sup>270</sup> See *Tam II*, 808 F.3d at 1377, 1381 (Reyna, J., dissenting) (emphasizing a mark owner’s economic motivation to obtain federal trademark protection).

<sup>271</sup> 15 U.S.C. § 1125; U.S. PATENT & TRADEMARK OFFICE, *supra* note 2, at 3.

right in foreign countries is also freedom from someone else's competing mark.<sup>272</sup> These commercial aspects meet the standard set forth in *Bolger v. Youngs Drug Products Corporation* and warrant an intermediate scrutiny analysis of commercial speech.<sup>273</sup>

Should trademarks be subject to a strict scrutiny analysis, the implications would extend beyond trademark law.<sup>274</sup> If the Court continues to reject the impact of secondary effects in determining whether a restriction is content-based or content-neutral, while also rejecting a commercial speech analysis, it could implicate a much larger subset of government regulation.<sup>275</sup> For instance, the Federal Trade Commission (FTC) implemented regulation requiring celebrities and spokespersons to indicate when their content is an advertisement.<sup>276</sup> The FTC's goal was to prevent consumers from being misled by sponsored testimonials.<sup>277</sup> With the blurring of the distinction between commercial and non-commercial speech that some justices propose, advertisers and companies could argue that the FTC's regulation is content-based because it restricts their free expression of sponsored content.<sup>278</sup>

In Justice Stevens's plurality opinion in *44 Liquormart, Inc. v. Rhode Island*, he argued that even when a regulation is intended to prevent deception, it likely passes strict scrutiny.<sup>279</sup> This burden of strict scrutiny, however, is still a higher burden than necessary for the government, which has limited resources and needs a method for protecting against secondary effects of some speech.<sup>280</sup> The regulation is necessary and, moreover, what has been assumed to be in the

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<sup>272</sup> 15 U.S.C. § 1125; U.S. PATENT & TRADEMARK OFFICE, *supra* note 2, at 3.

<sup>273</sup> See 463 U.S. 60, 62 (1983) (identifying the standard for commercial speech based on the advertising content, product reference, and the motivation of the seller); GREENFIELD, *supra* note 16, at 137 (identifying the distinction between intermediate and strict scrutiny); Pomeranz & Adler, *supra* note 31, at 41 (characterizing the decision in *Bolger* as establishing a test for commercial speech). Trademarks meet the requirements set forth in *Bolger*: (1) trademarks advertise the source of a good or product; (2) trademarks indicate the source of a good or service; and (3) trademark applicants, as required by law to register a trademark, use their trademarks in commerce, so they have an economic motivation. See 463 U.S. at 62; U.S. PATENT & TRADEMARK OFFICE, *supra* note 2, at 2–3.

<sup>274</sup> Fox Rothschild LLP, *supra* note 267.

<sup>275</sup> *Id.*; see *Tam III*, 137 S. Ct. at 1767 (failing to consider any of the government's arguments for the purpose of the disparagement to prevent disruptive activities to commerce).

<sup>276</sup> 16 C.F.R. § 255 (2019).

<sup>277</sup> *Id.*; Fox Rothschild LLP, *supra* note 267.

<sup>278</sup> Fox Rothschild LLP, *supra* note 267; see *Tam III*, 137 S. Ct. at 1749 (suggesting that a content-based restriction would defeat any argument over commercial speech because the justices would choose to narrowly decide the issue rather than determine whether a commercial speech analysis is appropriate).

<sup>279</sup> 517 U.S. 484, 500 (1996).

<sup>280</sup> Fox Rothschild LLP, *supra* note 267; see *City of Erie*, 529 U.S. at 282–83 (emphasizing the constitutionality of a restriction that addresses the secondary effects of speech because it is in the government's interest to promote public health and safety).



purview of government authority should not suddenly be held to the incredibly high burden of strict scrutiny.<sup>281</sup>

In a similar vein, city laws that restrict both ride-sharing services and room-sharing companies from advertising in their city boundaries could be found unconstitutional for favoring certain speech.<sup>282</sup> Ride-sharing services may argue that the city favors speech against their business and is restricting their freedom of expression.<sup>283</sup> Further, in Massachusetts, where recreational marijuana is legal, restrictions on cannabis advertising may be declared invalid and unconstitutional because the government would be suppressing speech with expressive marijuana content.<sup>284</sup> This would be so despite the fact that the state has an interest in promoting public safety, health, and welfare.<sup>285</sup>

A commercial speech analysis would save the Lanham Act by reducing the burden on the government to prove that ostensibly content-neutral and secondary effects regulations do not suppress speech.<sup>286</sup> In so doing, a commercial

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<sup>281</sup> See *Fox Rothschild LLP*, *supra* note 267 (indicating the potential widespread effects due to the Court's continued resistance to characterize trademarks as needing to meet intermediate rather than strict scrutiny analysis). There is a difference between regulating commercial speech and regulating freedom of expression. See *City of Erie*, 529 U.S. at 282–83 (allowing content-based regulation to mitigate secondary effects of public health and safety). The speaker and the speaker's motivation are important for a commercial speech analysis. See *Bolger*, 463 U.S. at 67. Without such a distinction between speakers, regulations on trademarks will meet the same criticisms of the autonomy and self-fulfillment theory because there will be an unlimited amount of trademark regulation that will succumb to First Amendment expression. See *supra* note 123 (criticizing the autonomy and self-fulfillment theory for its lack of any boundary in what speech is regulated).

<sup>282</sup> See *Tam III*, 137 S. Ct. at 1765 (holding the disparagement clause unconstitutional for allowing examiners to engage in viewpoint discrimination); *Fox Rothschild LLP*, *supra* note 267 (connecting the holding in *Tam III* to consequences in other industries); *New York Defeats Taxi Owners, Lenders in Lawsuit Over Rules, Uber*, CNBC (Mar. 31, 2017), <https://www.cnbc.com/2017/03/31/new-york-defeats-taxi-owners-lenders-in-lawsuit-over-rules-uber.html> [<https://perma.cc/DG3C-68AA>] (describing a lawsuit by drivers over the alleged “burdensome regulations” imposed by New York City legislators including the high cost of medallions to enter the taxi and limousine service industry).

<sup>283</sup> See *Tam III*, 137 S. Ct. at 1765 (finding the viewpoint discrimination analysis to determine the constitutionality of the speech regulation); *Fox Rothschild LLP*, *supra* note 267 (detailing potential arguments by the taxi industry based on viewpoint discrimination); see, e.g., *44 Liquormart, Inc.*, 517 U.S. at 489 (granting certiorari on the question presented by alcohol establishments regarding the constitutionality of a state law restricting advertisement of their business).

<sup>284</sup> See *Tam III*, 137 S. Ct. at 1765 (preventing the government from favoring speech that it does not find offensive); *Fox Rothschild LLP*, *supra* note 267 (emphasizing the consequences of the Court's use of a viewpoint discrimination analysis without first engaging in a commercial speech analysis); 935 MASS. CODE REGS. 500.105 (2019) (restricting marijuana advertisements to adults and prohibiting content catered toward minors).

<sup>285</sup> See *Tam III*, 137 S. Ct. at 1765 (failing to be persuaded by the government's interest in preventing the secondary disruptive effects on the free flow of commerce in the presence of disparaging materials).

<sup>286</sup> See *In re Brunetti*, 877 F.3d 1330, 1357 (Fed. Cir. 2017) (rejecting the government's interest proposed to satisfy a strict scrutiny analysis for the immoral and scandalous clause of the Lanham Act).

speech analysis of trademarks would preserve the government's ability to regulate the public's interests.<sup>287</sup>

### CONCLUSION

Trademarks are commercial speech. The *Central Hudson* test should be the standard for reviewing trademark restrictions. Otherwise, aspects of the Lanham Act when held to a strict scrutiny standard are in jeopardy, creating a slippery slope to erode the usefulness of the Lanham Act altogether. Taken to its logical conclusion, the *Tam* Court suggests that if trademarks are not commercial speech, trademarks would have the same free speech rights as individuals. Although some speech is inherently not protected, such as fraud and defamation, the rest of trademark regulation would have to meet the high burden of strict scrutiny analysis. With case-by-case challenges to pieces of the Lanham Act on the horizon, the USPTO would lose its power to control trademark registration. Leaving the government with very little room to correct market defects, trademark law falls apart. Trademark law is necessary for the free flow of commerce. Trademarks allow us to make intelligent decisions when purchasing goods based on the source of the good and the reputation attached to the mark. Without trademarks, there are fewer incentives for individuals and entities to build their brand name reputations. This leads to less of an incentive to innovate. If trademarks are not viewed as commercial speech through an intermediate scrutiny lens, then it is likely inevitable that trademark registration as we know it today will cease to exist. Without trademarks, there would be a domino effect of negative reactions, leading to chaos in the marketplace.

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<sup>287</sup> See *Tam II*, 808 F.3d at 1376 (Reyna, J., dissenting) (arguing that the government has a substantial interest in regulating the free flow of commerce to protect against secondary effects of speech).

