

A Look At Constitutional Challenges To Redskins Decision

Law360, New York (September 10, 2014, 10:23 AM ET) --

After decades of relative obscurity, Section 2(a) of the Lanham Act — which prohibits federal registration of scandalous and disparaging trademarks — was brought to the forefront in the Redskins trademark dispute, a lengthy saga that involves more than 20 years of litigation and highly emotionally and politically charged public debate. The dispute culminated when the U.S. Patent and Trademark Office canceled federal registration for several “Redskins” trademarks as disparaging to Native Americans in *Blackhorse v. Pro-Football Inc.*

Although the *Blackhorse* decision has garnered much fanfare, Pro-Football’s constitutional challenges to that decision and Section 2(a) on appeal have received relatively little attention. This article summarizes these challenges and analyzes their merits.



Section 2(a)’s Prohibition Against Scandalous and Disparaging Marks

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To register a mark with the PTO, a trademark owner must demonstrate that it has used or intends to use the mark in commerce, and that the mark serves as a reliable indicator of the owner’s goods or services. But Section 2(a) of the Lanham Act imposes an additional limitation that is different in kind, barring registration of a mark that “[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”

Section 2(a) raises several challenging issues. First, the terms “immoral,” “deceptive,” “scandalous,” “disparage,” “contempt,” and “disrepute” are not defined in the Lanham Act. Courts and the PTO have therefore struggled for many years to give concrete meaning to these terms. The PTO itself has stated that “the guidelines for determining whether a mark is scandalous or disparaging are somewhat vague” and necessarily “highly subjective.”[1]

Second, it is unclear whether Congress possesses the authority to legislate public welfare and morals through the Lanham Act, and there is a paucity of legislative history of Section 2(a) to shed light on its purpose. Some courts have speculated that Congress enacted the statute, not “as an attempt to legislate morality,” but rather, to ensure “that such marks do not occupy the time, services, and use of funds of the federal government.”[2] But the PTO now operates entirely on trademark registration fees, not taxpayer dollars. While some believe that Congress intended to “avoid having unsavory marks dignified by registration by the federal government,”[3] it is well established that federal registration of a mark does not imply that the government has placed its imprimatur on that mark.[4]

Notably, analogous statutes do not exist in the patent and copyright laws. Although the PTO has adopted a policy to reject design patent applications that “could be deemed offensive to any race, religion, sex, ethnic group, or nationality,”[5] no such policy exists with respect to utility patents. The Copyright Office does “not examine a work or authorship to determine whether it contains material that might be considered obscene.”[6]

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The Blackhorse Saga

Procedural Background

The “Redskins” trademarks were first registered in 1967 for use in connection with the professional football team in Washington, D.C. In 1992, seven individuals of Native American descent filed a petition with the PTO to cancel the marks under Section 2(a) on the basis that they are disparaging to Native Americans. The PTO granted the petition, but the D.C. district court reversed on remand from an appeal to the D.C. Circuit, finding that the evidence did not establish a disparagement claim and that the petition was barred by laches.

In 2006, six new petitioners initiated the Blackhorse cancellation proceeding based on Section 2(a). The case proceeded to trial in 2010, and on June 18, 2014, the PTO ruled 2-1 that the marks were in fact disparaging and canceled their registrations. On Aug. 14, Pro-Football appealed that decision, filing a declaratory judgment action in the Eastern District of Virginia.

Pro-Football’s Constitutional Challenges to Section 2(a)

Pro-Football asserts several constitutional challenges to Section 2(a) on appeal.

1. Restriction on Speech (First Amendment)

First, Pro-Football argues that Section 2(a), both on its face and as applied, constitutes an impermissible content-based restriction on speech. Courts agree that a trademark is a form of commercial speech entitled to some, albeit limited, First Amendment protection.^[7] But the threshold issue in determining whether Section 2(a) is unconstitutional is whether it does, in fact, restrain speech.

The Federal Circuit has repeatedly rejected the argument that refusal of registration qualifies as an unconstitutional restraint. In its 1981 *In re McGinley* decision, the Federal Circuit’s predecessor court upheld the PTO’s refusal to register as scandalous a photograph of a nude man and woman kissing and embracing in connection with newsletters devoted to social and interpersonal relationship topics. In so holding, the court determined that “the PTO’s refusal to register [a] mark does not affect [the] right to use it,” and therefore “[n]o conduct is proscribed, and no tangible form of expression is suppressed.”^[8] The Federal Circuit has since reiterated this view, which the Fifth Circuit has also adopted.^[9]

But *McGinley* has drawn sharp criticism as having been “cursorily decided.”^[10] *McGinley* itself acknowledges that Section 2(a) allows the PTO to deny “the benefits provided by the Lanham Act which enhance the value of a mark,”^[11] and the U.S. Supreme Court’s “unconstitutional conditions” doctrine holds that the government “may not deny a benefit to a person on a basis that infringes his constitutionally protected interests — especially, his interest in freedom of speech.”^[12] In other words, government action that does not restrict speech but that nevertheless conditions a benefit on the forfeiture of speech, could implicate the First Amendment.

If the district court does find that Section 2(a) qualifies as a restraint on speech, the next question the court will need to address is how much First Amendment protection to afford Pro-Football’s trademarks and which standard of review to apply. To qualify for protection, commercial speech must concern lawful activity and not be misleading; both of these limitations appear to be satisfied in *Blackhorse*. But regulation of protectable commercial speech is nevertheless permissible if (1) the governmental interest in restricting the speech is substantial, (2) the regulation directly advances the governmental interest asserted, and (3) the regulation is not more extensive than is necessary to serve that interest.

To date, no court has engaged in a robust First Amendment analysis of Section 2(a) under this framework. But some commentators believe that Section 2(a) would fail such an analysis in light of the ill-defined government interests at stake, as discussed above.[13] A First Amendment challenge today is likely bolstered by recent Supreme Court jurisprudence employing more exacting scrutiny for statutes regulating commercial speech.[14]

2. *Void for Vagueness and Due Process (First and Fifth Amendments)*

Pro-Football also argues that Section 2(a) is unconstitutionally vague, and therefore operates to deprive trademark owners of property without due process of law.

In *McGinley*, the applicant similarly argued that the term “scandalous” is unconstitutionally vague as used in Section 2(a). The court acknowledged that the statutory right to registration “cannot be denied without compliance with the Fifth Amendment due process requirement,” but nevertheless found that the provision “is sufficiently precise to enable the PTO and the courts to apply the law fairly and to notify a would-be registrant that the mark he adopts will not be granted a federal registration.”[15] The Federal Circuit has since re-affirmed that holding.[16]

But *Blackhorse* involves a constitutional challenge to a different clause of Section 2(a) — i.e., its proscription against “disparaging” marks — which no court has previously considered. At least one commentator has concluded that the disparagement clause of Section 2(a) is unconstitutional because its scope is unclear given the multitude of definitions and standards applied by courts and the PTO, which allow the provision to be arbitrarily and inconsistently enforced.[17]

3. *Unconstitutional Taking (Fifth Amendment)*

Finally, Pro-Football argues that the PTO’s cancellation of its long-held trademarks qualifies as an unconstitutional taking under the Fifth Amendment. No court has addressed this type of challenge, but its viability is questionable given that Pro-Football does not have a preexisting statutory property right in disparaging marks, and its common law rights remain unaffected. As noted by the Federal Circuit, “[t]he Takings Clause prohibits the government from taking private property for public use without just compensation. It contains no requirement that the government give property to individuals.”[18] Some commentators nevertheless argue that Section 2(a) operates as a regulatory taking under Supreme Court precedent.[19]

Stay Tuned for Developments in the Law

The *Blackhorse* district court will likely not be the first court to address the constitutionality of Section 2(a)’s disparagement provision. The Federal Circuit will soon hear oral argument in *In re Tam*, in which the PTO refused registration to “The Slants” for live musical performances by a band, finding that the mark is disparaging to those of Asian descent. The applicant invokes many of the arguments summarized here, and the Federal Circuit could take the opportunity to revisit *McGinley* and provide a more robust analysis with regard to these arguments.

But the *Blackhorse* Virginia district court is bound by Fourth Circuit, not Federal Circuit, law, and the Fourth Circuit has not yet ruled on these issues. Thus, the *Blackhorse* court could choose to depart from *McGinley*, regardless of how *Tam* is decided, which could give rise to a circuit split that may provoke Supreme Court review.

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[1] *In re Over Our Heads Inc.*, 16 U.S.P.Q.2d 1653 (T.T.A.B. 1990).

[2] *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981).

[3] See Ron Phillips, *A Case for Scandal and Immorality: Proposing Thin Protection of Controversial Trademarks*, 17 U. Balt. Intell. Prop. L.J. 55, 58 (2008).

[4] See *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1220 n.3 (T.T.A.B. 1993).

[5] MPEP § 1504.01(e) (9th ed. Mar. 2014); see also *id.* § 608.

[6] Copyright Office, *Compendium of U.S. Copyright Office Practices* § 315 (3d ed. public drft 2014).

[7] See *S.F. Arts & Athletics Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 540 (1987); *Friedman v. Rogers*, 440 U.S. 1, 10 n.9 (1979); *Ritchie v. Simpson*, 170 F.3d 1092, 1103–04 (Fed. Cir. 1999) (Newman, J., dissenting).

[8] *McGinley*, 660 F.2d at 484.

[9] See *In re Mavety Media*, 33 F.3d 1367, 1374 (Fed. Cir. 1994) (relying on *McGinley* to reject constitutional arguments); *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003) (same); *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012) (“Because a refusal to register a mark has no bearing on the applicant’s ability to use the mark, we have held that [Section 2(a)] does not implicate the First Amendment”); see also *Test Masters Educ. Servs., Inc. v. Singh*, 428 F.3d 559, 578 n.9 (5th Cir. 2005) (“We join our sister circuit in rejecting Singh’s argument that prohibiting him from registering a mark with the PTO violates his first amendment rights.”).

[10] *Pro-Football Inc. v. Harjo*, (D.D.C. Dec. 11, 2000); see also *Ritchie*, 170 F.3d at 1103 (criticizing majority’s reliance on *McGinley*).

[11] *McGinley*, 660 F.2d at 486 n.12.

[12] *Perry v. Sindermann*, 408 U.S. 593, 597 (1972).

[13] See, e.g., Jeffrey Lefstin, *Note, Does the First Amendment Bar Cancellation of Redskins?*, 52 *Stan. L. Rev.* 665 (2000).

[14] See *Sorrell v. IMS Health Inc.*, 131 S. Ct. 2653 (2011) (striking down state law that restricted marketing of pharmaceuticals to doctors based on prescription information gathered by data miners).

[15] *McGinley*, 660 F.2d at 484.

[16] See *Mavety Media*, 33 F.3d at 1374.

[17] See Robert H. Wright, *Today's Scandal Can Be Tomorrow's Vogue: Why Section 2(A) of the Lanham Act Is Unconstitutionally Void for Vagueness*, 48 *How. L.J.* 659, 676–84 (2005).

[18] *Georgalis v. U.S. Patent & Trademark Office*, 296 F. App'x 14, 16 (Fed. Cir. 2008) (per curiam) (citation and internal quotation marks omitted).

[19] See, e.g., Michelle B. Lee, *Section 2(A) of the Lanham Act As a Restriction on Sports Team Names: Has Political Correctness Gone Too Far*, 4 *Sports Law J.* 65, 77–80 (1997).

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