

A Trademark Defense of the Disparagement Bar

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The Supreme Court will soon hear argument over whether Congress may forbid registering trademarks that consist of “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.”¹ The disparagement bar is the basis for the 2014 ruling by the Trademark Trial and Appeal Board (TTAB) that ordered the cancellation of trademark registrations belonging to the Washington NFL team because the term “redskin” disparages Native Americans.² Late last year, however, the Federal Circuit ruled en banc that the disparagement bar is unconstitutional on First Amendment grounds in *In re Tam*.³

In re Tam sets the stage for Supreme Court review by considering a variety of doctrines designed to accommodate First Amendment interests to other values. The Federal Circuit’s treatment of the disparagement bar boiled down in large part to the question of whether the bar serves a viewpoint-neutral pur-

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1. 15 U.S.C. § 1052(a) (emphasis added).
 2. *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080, 2014 WL 2757516 (T.T.A.B. 2014), *aff’d* *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015). More precisely, the Board concluded that a “substantial composite” of the Native American population found the term offensive at the time of the registrations. *Id.* at *29. Native American activists had long sought the cancellations. *See, e.g., Pro Football, Inc. v. Harjo*, 565 F.3d 880, 882 (D.C. Cir. 2009) (outlining and concluding the course of earlier litigation, which arose from a petition first filed in 1992). The Eastern District of Virginia upheld the TTAB’s decision, and the case is now on appeal to the Fourth Circuit. *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015).
 3. *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015) (en banc), *cert. granted sub nom., Lee v. Tam*, No. 15-1293, 2016 WL 1587871, at *1 (U.S. Sept. 29, 2016).

pose beyond disapproval of the message embodied by disparaging marks. The majority saw no such purpose.⁴ In contrast, one dissent argued that the bar promotes commerce by targeting stigmatizing insults that disrupt the marketplace.⁵

Fair enough, but commerce promotion is a broad goal. Promoting that general end by specifically targeting stigmatizing insults might support an inference that the disparagement bar actually exists to promote anti-discrimination policies external to trademark law. That view corresponds with the majority's treatment of the disparagement bar as having little to do with trademark policy.⁶ *In re Tam* therefore looks like a clash between fundamental principles of free expression and anti-discrimination in which trademark doctrine sits on the sideline—a framing that makes it all the more difficult for the bar to survive First Amendment scrutiny. The provision looks suspect because it seems an interloper unrelated to its surrounding body of law, potentially undermining its claim of viewpoint neutrality.

This Essay challenges that framing. Its purpose is not to argue the constitutionality of the bar, nor is it to set forth a particular First Amendment framework for approaching the question.⁷ My more modest aim is to give trademark doctrine its due. The disparagement bar implicates more mundane issues of trademark policy that deserve fuller consideration than offered by *In re Tam*. Whatever the ability of First Amendment doctrine to accommodate the application of external anti-discrimination policies to questions of trademark eligibility,⁸ the disparagement bar also reflects principles *internal* to trademark law. More specifically, the bar enforces the traditional trademark policy that insists that would-be trademarks adequately perform the trademark function. Trademark law does not care about the views embodied by candidate trademarks, but it does require that they do a good job of serving as source identifiers. Disparaging marks are just one of several categories of potential marks that fail this test. Understanding the disparagement bar in the larger context of trade-

4. *Id.* at 1335.

5. *Id.* at 1379-80 (Lourie, J., dissenting).

6. *Id.* at 1338 (arguing that “it is always a mark’s expressive character, *not its ability to serve as a source identifier*, that is the basis for the disparagement exclusion from registration”) (emphasis added).

7. See, e.g., Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, 91 NOTRE DAME L. REV. (forthcoming 2016), http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2745016 [<http://perma.cc/W8PS-HK43>]; Ned Snow, *Free Speech & Disparaging Trademarks*, 57 B.C. L. REV. (forthcoming Nov. 2016), http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2753864 [<http://perma.cc/QT96-UC5C>].

8. *In re Tam*, 808 F.3d at 1364 (Dyk, J., concurring in part and dissenting in part) (“Thus the purpose of the statute is to protect underrepresented groups in our society from being bombarded with demeaning messages in commercial advertising.”).

mark law may therefore offer a basis for defending its constitutionality against First Amendment challenge.

I. *IN RE TAM*'S FIRST AMENDMENT CHALLENGE TO THE DISPARAGEMENT BAR

Although trademarks do not need registration for protection, the Lanham Act offers a range of benefits to registered marks.⁹ It also provides various grounds for refusing registration. Section 2(a) contains one such exclusion—a bar on the registration of trademarks consisting of disparaging matter¹⁰—which was the basis of the ordered cancellation of trademark registrations belonging to the Washington Redskins.¹¹ The team has challenged the cancellation by arguing, among other things, that the disparagement bar violates the First Amendment.¹²

The Federal Circuit accepted this argument in *In re Tam*. Simon Shiao Tam attempted to register THE SLANTS as a mark for an Asian-American dance-rock band. The examining attorney refused, concluding that the term is likely to disparage “persons of Asian descent,” and the TTAB affirmed.¹³ For his part, Tam argued that, as an Asian-American, his use of the term was a form of appropriation and commentary.¹⁴ He challenged the PTO’s refusal to register the mark as a First Amendment violation. By a 9-3 vote, the Federal Circuit, sitting en banc, agreed and declared the disparagement bar facially unconstitutional.

The majority opinion sees the disparagement bar as a form of content and viewpoint discrimination.¹⁵ In its account, the viewpoint discrimination is not

9. Registration provides, among other things, nationwide priority of use, a presumption of validity, and the ability to achieve incontestable status, after which the mark becomes immune to certain challenges to its validity. 15 U.S.C. §§ 1057, 1065, 1115.

10. *Id.* at § 1052(a).

11. *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 451 (E.D. Va. 2015).

12. The challenge is thus far unsuccessful. *Id.* at 454-64. An appeal to the Fourth Circuit is pending (Dkt. No. 15-1874).

13. *In re Tam*, 808 F.3d 1321, 1331-32 (Fed. Cir. 2015). Before the Federal Circuit elected to hear the question of the disparagement bar’s constitutionality, a panel of the court concluded that substantial evidence supported the PTO’s conclusion that a substantial composite of those referenced by the term would find it disparaging. *Id.* at 1332.

14. *Id.*

15. *Id.* at 1335 (“And § 2(a) does more than discriminate on the basis of topic. It also discriminates on the basis of message conveyed[.]”).

a byproduct of some other policy; it is the very point.¹⁶ This characterization makes the disparagement bar's fate seem overdetermined. The opinion runs through other First Amendment arguments and doctrines, concluding that the bar cannot be justified as a form of government speech or subsidy¹⁷ and that it should not be judged under the commercial speech doctrine.¹⁸ But the conclusion that the bar's purpose is viewpoint discrimination is woven throughout.¹⁹

Judge Reyna's dissent takes issue with the view that the bar is meant to suppress speech, defending it as a content-neutral effort to regulate the secondary effects of harmful speech.²⁰ In his account, the point of the bar lies in the Lanham Act's goal of promoting "the orderly flow of commerce."²¹ Stigmatizing language in the form of disparaging trademarks compromises this goal because an insult based on "race, gender, religion, or other demographic identity, tends to disrupt commercial activity and to undermine the stability of the marketplace in much the same manner as discriminatory conduct."²²

The problem with the stigma rationale is that it risks reinforcing the perception that the disparagement bar is a form of viewpoint discrimination. Simply describing the provision's purpose as one of promoting "commerce" is too general to shift the focus of judges—like those in the *Tam* majority—already inclined to see viewpoint discrimination in the operation of the disparagement bar.²³ For one thing, expressive harm, though real, might appear to have less of an impact on market participation than the discriminatory conduct—for example, discrimination in places of public accommodation—that has traditionally been the focus of governmental remedial efforts. Judge Reyna's dissent implicitly raises this issue, as he notes that the disruption

16. *Id.* at 1336 ("[T]he government enacted and continues to defend § 2(a) 'because of disagreement with the message [disparaging marks] convey [.]'" (quoting *Sorrell v. IMS Health, Inc.*, 564 U.S. 552, 566 (2011)) (alteration in original)).

17. *See id.* at 1345-48 (rejecting the government's speech argument); *id.* at 1348-55 (rejecting the government's subsidy program argument).

18. *Id.* at 1337-39. To the extent that the commercial speech doctrine applied, the majority concluded that the viewpoint discriminatory purpose of section 2(a) disqualified it from passing muster under the *Central Hudson* intermediate scrutiny test. *Id.* at 1355-57.

19. *See, e.g., id.* at 1339, 1348, 1351-52, 1354.

20. *Id.* at 1378 (Reyna, J., dissenting).

21. *Id.* at 1379.

22. *Id.*; *cf. id.* at 1367 (Dyk, J., concurring in part and dissenting in part) ("While in the trademark context the dissemination of the disparaging material is not limited to the disparaged group, the disparaged group is nonetheless targeted in the sense that it is singled out for ridicule."). For a similar defense of the disparagement bar, which describes disparaging messages as being "low quality information" and therefore contrary to the interest in marketplace efficiency, see Snow, *supra* note 7, at 132-33.

23. *See In re Tam*, 808 F.3d at 1339-1341.

caused by “discriminatory *conduct*” is well recognized and documented by the history supporting passage of the Civil Rights Act.²⁴ But there is not similar legislative history supporting the disparagement bar on this basis. The “conduct” in question seems bound in expression.

Moreover, the danger to commerce posed by insulting language is not a traditional trademark concern. The argument as stated by Judge Reyna does not address the ability of disparaging terms to function as marks. Rather, the problem and means of resolution (via a refusal to promote “low-value” speech)²⁵ both lie outside ordinary trademark discourse. To be sure, not all judges will see a problem. One might connect this conception of the disparagement bar with, say, the prohibition against trademarking generic terms as both “promoting commerce.” But this kinship exists only at a high level of generality. It is therefore unsurprising that the majority did not follow along, either as a matter of pattern-recognition—what “looks like” the ordinary operation of trademark law²⁶—or out of concern that the argument could countenance more overt forms of viewpoint discrimination.²⁷

It may therefore be true that disparaging marks disrupt commerce, but the mechanism identified by Judge Reyna nonetheless reinforces the perception that the stakes are not the ordinary functioning of trademark law, but rather trademark law’s ability to be put to the external goal of combating discrimina-

24. *Id.* at 1380 (Reyna, J., dissenting).

25. *Id.*

26. Judges inclined to see trademark law as a discrete doctrine may be reluctant to make this leap. See Michael Grynberg, *The Judicial Role in Trademark Law*, 52 B.C. L. REV. 1283, 1308-18 (2011). The pattern recognition problem looms large for proffered justifications of the disparagement bar that address non-trademark goals. Stephen Baird identifies, for example, interference with public “health and welfare” as a justification for the bar, but forthrightly acknowledges that “the Lanham Act cannot fairly be considered public health and welfare legislation.” Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661, 791 n.564 (1993); see also *id.* at 733-34 (discussing TTAB justification of the disparagement bar as protecting privacy rights and noting the difficulty of that approach in light of the wording of section 2(a)).

27. Likewise, Professor Snow’s argument, see Snow, *supra* note 7, seems to invite more adventuresome forms of discrimination. He agrees, for example, that marks that promote prostitution could be barred not because the activity is illegal, but simply if one thinks, subject to the weak check of rational basis review, that the practice does not “promote the collective marketplace.” Snow, *supra* note 7, at 141. But conceptions of what promotes the collective marketplace are deeply contested. The goal is stated at such a high level of generality as to allow trademark law to be put to virtually any end. Perhaps it should be, but it is unsurprising that judges might balk at the invitation given the potential to use the standard as a pretext for viewpoint discrimination. Cf. Tushnet, *supra* note 7, at 16 (“Denying Washington’s football team any trademark rights in any symbol so long as it also used the team name would be a penalty for the exercise of First Amendment rights.”).

tion.²⁸ Many academic defenses of the disparagement bar sound similar notes.²⁹ The challenge is fitting the effort into one of the many nuanced nooks and crannies of modern First Amendment doctrine.³⁰

Although vindicating equal protection ideals is a far more pressing concern than the operation of the Lanham Act, casting the issue in these terms invites judicial skepticism by seeming to bring free expression and anti-discrimination policies into conflict.³¹ Analogous perceived collisions between the two interests have favored free expression.³²

This Essay takes no position on how best to frame the First Amendment analysis of the disparagement bar’s constitutionality. But the debate as joined in *Tam* makes relevant the question of whether the bar serves a trademark purpose. The majority’s refusal to accept the conception of trademark law forwarded by Judge Reyna illustrates how treating the concerns of the disparagement bar as exogenous to trademark law may start the debate from behind. A better course might therefore be to focus on neither commerce nor discrimination, but rather on the purposes of trademark law—and the means by which trademark doctrine traditionally implements them—at a lower level of generality.

II. TRADEMARK LAW AND THE VALUE OF “EMPTY VESSELS”

Given the views of the *Tam* majority, the disparagement bar would be on firmer constitutional ground if it can be shown to reflect viewpoint-neutral trademark principles, even as it simultaneously promotes anti-discrimination policies. *Tam* rejects this possibility, arguing that “it is always a mark’s expressive character, *not its ability to serve as a source identifier*, that is the basis for the disparagement exclusion from registration.”³³

28. This problem persists even if one invokes more general goals of promoting “public policy,” see RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 32 cmt. c (1995); cf. Jeffrey Lefstin, Note, *Does the First Amendment Bar Cancellation of REDSKINS?*, 52 STAN. L. REV. 665, 686 (2000) (footnote omitted) (observing that the public welfare rationale is identical to one calling for the “eradication of offensive speech”).

29. Jasmine Abdel-khalik, *Disparaging Trademarks: Who Matters*, 20 MICH. J. RACE & L. 287, 319 (2015); Baird, *supra* note 26, at 714; Christine Haight Farley, *Stabilizing Morality in Trademark Law*, 63 AM. U. L. REV. 1019, 1025-26 (2014).

30. See, e.g., Tushnet, *supra* note 7.

31. *Tam*, 808 F.3d at 1366 (Dyk, J., concurring in part and dissenting in part) (“To be sure, the Court has held that commercial advertising cannot be restricted just because the product or service may be offensive to some members of the audience.”).

32. Sonia K. Katyal, *Trademark Intersectionality*, 57 U.C.L.A. L. REV. 1601, 1659-62, 1667-68 (2010) (discussing examples).

33. *Tam*, 808 F.3d at 1338 (emphasis added); cf. Abdel-khalik, *supra* note 29, at 294 (“Neither of [the scandalous and disparaging] prohibitions, on their face, relate to concerns of unfair

Not so—or at least, not entirely so. However much the bar promotes anti-discrimination ideals, it also aligns with trademark law’s other exclusions from protection and registration. These exclusions lack any connection to anti-discrimination goals, and, for the most part, have no overt expressive component (which is not to say that they lack any such component).³⁴ The bar reflects a policy that promotes effective trademarks by favoring, to a large, albeit imperfect, extent, signifiers that are initially irrelevant to the market context in which they will be deployed.³⁵ Such marks are better able to serve as receptacles of source-identifying meaning and, in turn, to be a shorthand for other information about the product or service in question. By contrast, trademark law disfavors and often excludes would-be marks that bring market-relevant information to the table.

competition. Instead, they appear to have some sort of moral or public order justification.”); Baird, *supra* note 26, at 796 (“The Lanham Act was designed with two purposes in mind: (1) to prevent confusion and deception in the market place; and (2) to protect trademark owners from counterfeiters. Section 2(a) advances neither purpose, but instead, probably subverts both.”); Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous Or Immoral*, 101 TRADEMARK REP. 1476, 1487 (2011) (“The ban on scandalous and immoral registrations does not fit within the fundamental goals of trademark law. Such marks do not by their nature deceive consumers or harm competitors, and could serve as source identifiers and acquire good will.”).

34. Defenses of the constitutionality of the disparagement bar point to other exclusions contained in Section 2 of the Lanham Act (e.g., the prohibition of deceptive marks, the check on geographic marks, etc.) as undermining the Federal Circuit’s analysis. 15 U.S.C. § 1052 (a), (e), (f) (2012). One view is that any choice of a mark is inherently expressive, and any exclusion raises the same First Amendment issues as does the disparagement bar. Snow, *supra* note 7, at 18. Another is to note that trademark law, being about language, contains many restrictions based on the content of marks. See, e.g., Tushnet, *supra* note 7, at 2 (“Section 2 is almost nothing but content based.”).

These defenses of the disparagement bar would tie its fate to other exclusions. See Tushnet, *supra* note 7, at 3 (noting the difficulty of distinguishing the bar from other exclusions “once the harsh logic of the First Amendment applies”). The move is to make the other exclusions look like the disparagement bar. On this logic, if the courts strike the disparagement bar, consistency demands that they strike other, currently non-controversial, restrictions as well (or descend into unprincipled “ad hoc-ism”). See *id.* at 43. To oversimplify, when it comes to trademark exclusions, everything is content-based.

This Essay agrees that the disparagement bar is less remarkable than *In re Tam* makes it seem, but approaches the claim in the opposite direction by arguing that the disparagement bar actually looks like the other exclusions. Like those exclusions, the disparagement bar may be justified on the basis of regulating source information. To oversimplify, when it comes to trademark exclusions, everything is about source identification.

35. What follows is not an argument that this was the intent of drafters of Section 2(a). Evidence of congressional intent regarding the provision’s purpose is limited. See Abdel-khalik, *supra* note 29, at 298-301.

This tendency is rooted in the function of trademarks. Trademarks exist to identify and distinguish goods.³⁶ Trademarks generate a range of benefits by doing so. They prevent fraud. They lower search costs. They encourage investments in quality by ensuring that consumers know whom to credit for making superior products. They embody the goodwill trademark owners build up with consumers and permit that value to be captured. They enable sellers to efficiently convey information about their products (by advertising attributes about them), and they enable others to do the same (by word of mouth, consumer reviews, or the like). And as cultural objects, they often become part of everyday language. In other words, once a trademark's source-identifying function is established, the mark becomes an efficient vehicle for a range of other meanings.³⁷ But these benefits flow from the mark's ability to be source-identifying.

Trademark law has a lot to say about which marks are up to the task.³⁸ It sees some marks—for example, arbitrary marks like APPLE computer or fanciful marks like KODAK film—as being inherently open to new trademark meanings. Those classes of marks are assumed to perform a source-identifying function. Not so with other classes of marks. Descriptive marks, such as TASTY hamburgers, require secondary meaning for protection. Consumers must actually see them as performing a source-identifying function; trademark meaning cannot be taken on faith. Generic marks that describe product categories, like APPLE apples, cannot be protected under any circumstances. Suggestive marks, which suggest product attributes but do not explicitly claim them, sit in between these two classes. They may be inherently distinctive, but they are sometimes treated by courts as being “weaker” than arbitrary or fanciful marks, limiting their scope in infringement litigation.³⁹

One characteristic of this familiar spectrum of distinctiveness is that the more irrelevant a word is to the product in question, the more favorable trade-

36. 15 U.S.C. § 1127 (2012) (defining a trademark as used “to identify and distinguish” goods from “those manufactured or sold by others and to indicate the source of the goods”); *id.* (defining a service mark as used “to identify and distinguish” services “from the services of others and to indicate the source of the services”). This Essay uses “trademarks” to mean both trademarks and service marks.

37. See Michael Grynberg, *Thick Marks, Thin Marks*, 67 CASE W. L. REV. ____ (2016) (forthcoming), 9-16, [http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2705082_\[http://perma.cc/QLT3-686U\]](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2705082_[http://perma.cc/QLT3-686U]).

38. See, e.g., *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (“The cases . . . identify four different categories of terms with respect to trademark protection. Arrayed in an ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these classes are (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful.”).

39. See, e.g., *Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 148 (2d Cir. 2003).

mark treatment it receives. On one end, arbitrary and fanciful marks have no meaning in relation to the referenced product; they are, relatively speaking, empty vessels.⁴⁰ But as one moves down the spectrum to words that have contextual meaning in connection to the product, trademark protection either weakens, in the case of suggestive marks; becomes harder to obtain, as with descriptive marks; or is refused altogether, as with generic marks.

To be sure, this is partly a judgment about the needs of competitors—ensuring that they are able to accurately describe their own products.⁴¹ But it also reflects an evaluation of the ability of certain words to function as marks. Judge Leval has argued, for example, that because food sellers have a competitive interest in using the word “delicious” to describe their goods, “[c]onsumers who see the word *delicious* used on two or more different food products are less likely to draw the inference that they must all come from the same producer.”⁴²

Similar considerations apply to non-word marks. Product design (as opposed to packaging) cannot be protected absent secondary meaning. This rule is generally seen as supporting the functionality doctrine, which excludes functional matter from protection in part to preserve market competition. Too easy protection for product design raises the risk of meritless claims that threaten the competition that the functionality doctrine promotes.⁴³

But the product design rule also promotes trademark quality. Like generic or descriptive marks, a product’s design brings non-trademark meanings—in this case, information about its attributes—to the table. In announcing the product design rule, the Supreme Court asserted that such attribute information interferes with the ability of the design to serve a trademark function.

[W]e think consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs—such as a cocktail shaker shaped like a penguin—is intended not to identify the source, but to render the product itself more useful or more appealing.⁴⁴

40. In semiotic terms, the spectrum of distinctiveness favors marks that are “unmotivated” by the good or service. Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLAL. REV. 621, 670 (2004) (“The more motivated the signifier, the less intrinsically distinctive of source it is.”).

41. See, e.g., *Virgin*, 335 F.3d at 147.

42. *Id.* at 148.

43. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 213-14 (2000).

44. *Id.* at 213.

In this, product design is quite unlike an inherently distinctive word mark or eye-catching product packaging. To the extent an arbitrary word mark, for example, embodies market-relevant information beyond source, the information flows from the use as a source identifier, as when a trademarked product earns a good reputation. Because the resulting positive associations depend on the trademark use, and not on inherent qualities of the trademarked word, the source meaning of an inherently distinctive word mark will always predominate over other meanings.⁴⁵ When non-source meanings loom larger, trademark doctrine is less sure that will be the case and accordingly withholds protection.⁴⁶

III. ANOTHER VIEW OF THE DISPARAGEMENT BAR

The preceding discussion signals a way to harmonize the disparagement bar with the rest of trademark law. The bar is one of several manifestations of a viewpoint-neutral principle: to be protected, a mark should be good at identifying and distinguishing a good or service. Disparaging marks comprise just one of several classes of marks that do a bad job of performing this source-identifying function.

A. *Pre-Filled Vessels*

Although they do not necessarily bring the same kind of market-relevant information as, say, a generic term,⁴⁷ disparaging marks share the characteristic of being infused with non-source meaning. Unlike arbitrary or fanciful marks, disparaging marks fail the irrelevance test because they embody meanings that interfere with their ability to perform a source-identifying function. In context, they are not the empty vessels that trademark law idealizes because consumers perceive a disparaging message. Just as APPLE lacks trademark significance when applied to the fruit instead of computers, and penguin-shaped cocktail shakers denote a product more than its source, slurs leave less room for trademark meanings than do the comparatively neutral terms that trademark law

45. *Id.* at 212 (“Although the words and packaging can serve subsidiary functions . . . their predominant function remains source identification.”).

46. Non-source, but relevant, meanings also include inaccurate information that may mislead consumers, as reflected by other exclusions within Section 2(a).

47. Disparaging marks may, however, bring market-relevant information, as demonstrated by Tam’s motivation for selecting his mark. To the extent that Tam’s message requires use of the slur, other bands that wish to promote similar messages would have a similar need.

traditionally favors. To be sure, this is not a *necessary* choice, but trademark doctrine might rationally determine that their emotional impact overwhelms their ability to identify based on a judgment that consumers “are aware of the reality that, almost invariably,” slurs are “intended not to identify the source,” but to provoke or insult.⁴⁸ Requiring insulted consumers to then determine whether a disparaging term conveys a source-identifying meaning beyond insult (or parody, commentary, or some combination) may not serve trademark goals.

Seen this way, the bar to registering disparaging marks looks less like viewpoint discrimination and more of a piece with trademark doctrine’s general approach of promoting marks whose content is irrelevant to the market in question.⁴⁹ Arbitrary and fanciful marks receive their status by having no connection to the denoted product at all. As relatively empty vessels, they are more easily filled with meaning by the trademark holder. This sort of neutrality is impossible for disparaging marks. Their tendency to excite emotion makes their content relevant to at least some consumers and thus suspect. These judgments about consumer reactions may be incorrect, but empirically ungrounded best guesses about consumer impact infuse trademark law. They are hardly restricted to disparaging marks.⁵⁰

B. *Secondary Meaning and Non-Discrimination*

The tendency of disparaging marks to interfere with source meanings will, perforce, be strongest among members of the disparaged group. This makes sensible the practice of using the perceptions of the referenced group to define disparagement. Trademark law’s use of a group-specific inquiry is not particular to disparaging marks. Most broadly, of course, the multifactor likelihood-of-confusion test considers the attributes of potential consumers of the goods at issue. More analogously to the disparagement bar, the doctrine of foreign equivalents prevents registration applicants from circumventing registration restrictions by substituting words from foreign languages with equivalent

48. Cf. *Wal-Mart*, 529 U.S. at 213 (making an analogous argument with respect to product designs).

49. A similar claim could be made to defend the bar to registering scandalous marks.

50. See, e.g., Thomas R. Lee, Eric D. DeRosia & Glenn L. Christensen, *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 ARIZ. ST. L.J. 1033 (2009); Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507 (2008).

meanings.⁵¹ It does so notwithstanding the fact that many Americans are monolingual and would not recognize non-English terms.

The power of disparaging marks for the referenced group also answers the question of why registration with secondary meaning is unavailable. For a significant subset of the consuming public, secondary meaning may be impossible: the disparaging meanings will dominate source identification.

Although this argument arises from trademark law, it is also consistent with the anti-discrimination view of the disparagement bar, as the bar enables members of the affected group to have equal access to source-identifying marks as members of the general consuming public. But because the argument focuses on the operation of trademark law, it does not suffer from the same generality problem discussed above.⁵² The benefit in question—the availability of source-identifying marks—is the *specific* benefit trademark law provides to serve the more general goal of promoting commerce.

C. Expressive Failure

Disparaging marks may still seem uniquely expressive, increasing suspicion of the bar. But the irrelevance principle also excludes other marks that double as expressive speech because the expression interferes with source identification. Consider the attempt to register I CAN'T BREATHE. The phrase became famous after the death of Eric Garner during his arrest by New York City police officers on suspicion of selling untaxed cigarettes. Garner was placed in a chokehold and brought to the ground. While down, he repeatedly said, “I can’t breathe,” lost consciousness, and died from head and chest compression. The police officers were not indicted, leading to nationwide protests in which the phrase “I can’t breathe” figured prominently. Many famous athletes, including LeBron James, Kevin Garnett, and Kobe Bryant, wore t-shirts with the phrase, further increasing public attention.⁵³

In December 2014, a trademark registration application was filed for I CAN'T BREATHE for use in “[c]lothing, namely hoodies, t-shirts for men,

51. U.S. PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1209.03(g) (Apr. 2016) [hereinafter TMEP].

52. See *supra* notes 20-25 and accompanying text.

53. Scott Cacciola, *At Nets’ Game, a Plan for a Simple Statement Is Carried Out to a T: LeBron James, Jay-Z and More Made ‘I Can’t Breathe’ T-Shirts Happen in the N.B.A.*, N.Y. TIMES (Dec. 9, 2014), <http://www.nytimes.com/2014/12/10/sports/basketball/i-cant-breathe-tshirts-in-the-nba-how-jayz-lebron-james-and-others-made-them-happen.html> [http://perma.cc/ZP4Q-Z8VL].

women, boys, girls and infants.”⁵⁴ The application was abandoned after the PTO identified various reasons for rejecting it.⁵⁵

The obvious expressive power of “I can’t breathe” was part of the problem.⁵⁶ The issue was not its political content (either its use by protestors or the potential appropriation effect of the phrase for commercial purposes) but its ability to function as a source identifier. The phrase “does not function as a trademark or service mark to indicate the source of applicant’s goods and to identify and distinguish them from others” because the informational content of a slogan may overwhelm its ability to identify source. “The more commonly a term or slogan is used in everyday speech, the less likely the public will use it to identify only one source and the less likely the term or slogan will be recognized by purchasers as a trademark or service mark.”⁵⁷ So, too, with I CAN’T BREATHE, which consumers identify with the message “that the wearer supports the ideas and messages conveyed by rallies and organizations dedicated to protesting violence.”⁵⁸

The fate of I CAN’T BREATHE reflects standard practice at the PTO under the *Trademark Manual of Examining Procedure*.⁵⁹ Like the bar for disparaging terms, the refusal to register informational marks ignores secondary meaning.⁶⁰ And, as with disparaging terms, the exclusion potentially captures marks that may also convey First Amendment-protected expression.⁶¹

54. U.S. Trademark Application Serial No. 86479784 (filed Dec. 13, 2014), <http://tsdr.uspto.gov/documentviewer?caseId=sn86479784&docId=APP20141217062024> [http://perma.cc/VJG7-F7RW].

55. U.S. PATENT & TRADEMARK OFFICE, Office Action (Official Letter) About Applicant’s Trademark Application (Mar. 4, 2015), <http://tsdr.uspto.gov/documentviewer?caseId=sn86479784&docId=OOA20150304094857> [http://perma.cc/88L9-GWUC] (refusing the trademark for including matter which may falsely suggest a connection with Eric Garner and for merely conveying an informative, social, political, religious, or similar kind of message and failing to function as a trademark).

56. The Office also noted the possibility that the association of the phrase with Eric Garner might lead to a false perception of a connection between the registrant’s products and Garner or his estate. *Id.*

57. *Id.*

58. *Id.*

59. TMEP, *supra* note 51, § 1202.04 (“Slogans and other terms that are merely informational in nature, or common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry, are not registrable.”).

60. *Id.*

61. *Id.* (providing examples of rejected matter, including ONCE A MARINE ALWAYS A MARINE and THINK GREEN).

CONCLUSION

One concern over *In re Tam*'s final outcome is the effect on the rest of trademark law. If exacting First Amendment scrutiny applies and the disparagement bar is deemed unconstitutional, much that is taken for granted in trademark law may suddenly be called into doubt. What would be left?⁶² Defenders of the disparagement bar should be alert to the inverse issue. If the disparagement bar is constitutional under the First Amendment, what else might be? This question worries judges to whom the bar looks like viewpoint discrimination that is divorced from the ordinary operation of trademark law. Harmonizing the bar with the rest of trademark law might assuage that concern.

Some of the efforts to date are problematic because they justify too much. The argument that the bar fits trademark's purposes by promoting commerce operates at too high a level of generality to provide comfort to the skeptical judge; conclusory appeals to commerce promotion could be used to justify any number of policies.

Examining the bar at a lower level of trademark generality makes clear that tying its fate to resolving a perceived conflict between interests of free expression and equality is incorrect. The disparagement bar is just one of many manifestations of the viewpoint-neutral principle that would-be trademarks should be effective source identifiers. The disparagement bar embodies this principle in a form that also serves important anti-discrimination aims, but it remains consistent with the larger body of trademark doctrine.

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62. See *supra* note 34.