

October 1, 2016

**U.S. Supreme Court to Review
Trademark Registration Case**

The Washington “Redskins” ongoing legal battle over registration of their trademark caused what is perhaps the biggest debate about trademark law in history, at least since 19th century apothecary Lydia E. Pinkham became the first woman, other than Queen Victoria, to use a portrait of herself on products. For those who are offended by trademarks like the Washington “Redskins,” Congress heard your concerns over a century ago and enshrined your values into what is now Section 2(a) of the Lanham Act authorizing the U.S. Patent and Trademark Office (USPTO) to reject registration of “disparaging,” “immoral,” or “scandalous” trademarks. New Mexico’s Trademark Act also prohibits the registration of such trademarks. Such provisions were intended as a bastion of decency in commerce.

For the past century, courts addressing First Amendment challenges to the constitutionality of Section 2(a) upheld it because the USPTO’s refusal to register an applicant’s mark does not affect the applicant’s right to use it. Trademark rights arise not from federal law, but from the use of a mark in commerce in connection with particular goods and services. Consequently, First Amendment rights were held not abridged by a refusal to register a trademark because a trademark can still be used without a registration.

A band called “The Slants,” whose trademark registration was refused as “disparaging,” challenged Section 2(a). The court tasked with appeals from the USPTO, the United States Court of Appeals for the Federal Circuit, held the disparagement provision of Section 2(a) unconstitutional because trademarks are a form of expressive speech protected by the First Amendment, reversing the century of precedent to the contrary. Consequently, the band’s trademark could not be refused registration on the grounds that it was “disparaging.” According to the Court, federal registration is so important, that its denial “on the basis of the government’s disapproval of the message . . . violates the guarantees of the First Amendment.” Federal trademark registration “bestows *truly* significant and financially valuable benefits upon markholders,” and “the loss of these rights, standing alone, is enough for us to conclude that § 2(a) has a chilling effect on speech.”

On September 29th, the U.S. Supreme Court announced it will review the case. We at Peacock Myers take this opportunity to remind you of the importance of registering your trademark. While a trademark can be used without a registration, think twice about whether doing so is right for you. And if your trademark is “disparaging,” “immoral,” or “scandalous,” keep an eye on the Supreme Court this term to see if you may be able to register it.

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