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THE FINAL STAND FOR OPPOSITION TO THE WASHINGTON REDSKINS' TRADEMARKS

I. INTRODUCTION

The ability to register a trademark on the Principal Register has been greatly changed by the Supreme Court's ruling in *Matal v. Tam* in 2017. In that case, the Supreme Court held that Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), violated the First Amendment's Free Speech Clause.¹ More specifically, the Court stated that the Disparaging Clause, which provides that a mark is not eligible for federal registration if it "[c]onsists of or comprises . . . matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute,"² fosters a form of viewpoint discrimination in violation of the First Amendment.³ While many saw this decision and instantly assumed that the Washington Redskins would now overcome the ongoing legal battle they have been involved in with regards to six marks relating to the word 'redskin,' it is significant to evaluate how, if at all, those attempting to oppose the Redskins trademarks will be able to bring a claim.

This comment analyzes how the Supreme Court came to its decision in *Matal v. Tam* and focuses on whether those seeking to cancel registered mark will have standing to do so. In addition, it will look at how the *Tam* decision played a role in eliminating the scandalous or immoral clause, a potential footing for those opposed to the Redskins trademark registrations, where a federal circuit court concluded that Section 2(a)'s bar on "registering immoral or scandalous marks is an unconstitutional restriction of free speech."⁴

II. DISCUSSION

¹ *Matal v. Tam*, 137 S.Ct. 1744, 1744 (2017).

² 15 U.S.C. § 1052(a)

³ *Matal v. Tam*, 137 S.Ct. at 1750.

⁴ *In re Brunetti*, 877 F.3d 1330, 1335 (2017).

A. The disparagement clause.

Prior to the decisions discussed below, under Section 2(a) of the Lanham Act:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it-

- (a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute⁵

B. Two-part test used by the USPTO.

When a mark is submitted for registration on the Principal Register, there is a two-step test used by PTO agents to determine if a mark is disparaging. The agent first considers “the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services.”⁶ “If that meaning is found to refer to identifiable persons, institutions, beliefs, or national symbols,” the agent proceeds to the second step, analyzing “whether that meaning may be disparaging to a substantial composite of the referenced group.”⁷ Once the agent finds that a “substantial composite . . . of the referenced group would find the proposed mark to be disparaging in the context of contemporary attitudes,” a *prima facie* case of disparagement is established and the burden shifts to the applicant to prove that the mark is not disparaging.⁸ Depending on the facts of the case, a proposed mark may be: “(1) an innocuous term that in the context of the goods or services is disparaging, . . . (2) a disparaging term that may have a nondisparaging meaning in a specific context, . . . or (3) a disparaging term that has

⁵ 15 U.S.C. § 1052(a)

⁶ Trademark Manual of Examining Procedure § 1203.03(b)(i) (Apr. 2017), p. 1200-50, <http://tmep.uspto.gov>.

⁷ *Ibid.*

⁸ *Ibid.*; *Matal v. Tam*, 137 S.Ct. at 1754.

no nondisparaging meanings in any context, and remains disparaging despite the applicant's goods or services, actual use or intent . . .”⁹ It is interesting to note, and important in the case of *Tam*, that “[t]he fact that an applicant may be a member of that group or has good intentions underlying its use of a term does not obviate the fact that a substantial composite of the referenced group would find the term objectionable.”¹⁰

C. The Washington Redskins' marks and procedural posture.

The Washington Redskins have been fighting for the registration of six previously registered marks since they were first challenged in 1992.¹¹ Over the past twenty-plus years, the Redskins have been a party to two separate cases. The first, *Pro Football, Inc. v. Harjo*, involved a group of Native Americans petitioning to the Trademark Trial and Appeal Board (TTAB) to cancel six of the registered marks owned by the Washington Redskins.¹² Similarly, the second case, *Blackhorse v. Pro-Football, Inc.*, originated when another group of Native Americans petitioned to the TTAB to cancel the same marks owned by the Washington Redskins.¹³

i. *Pro Football, Inc. v. Harjo*

In 1992, Suzan Harjo and six other Native Americans filed a petition with the TTAB seeking to cancel six trademarks registered and owned by the Washington Redskins.¹⁴ They argued that the registered marks were disparaging to members of their ethnic group, therefore barring registration under the Lanham Act, Section 2, 15 U.S.C. Section 1052(a).¹⁵ In response, Pro-Football argued that its long-standing use of the name, in addition to the petitioners' delay in

⁹ *In re Tam*, 108 U.S.P.Q.2d 1305, 4 (T.T.A.B. 2013).

¹⁰ Trademark Manual of Examining Procedure § 1203.03(b)(i), p. 1200-50.

¹¹ *Harjo v. Pro Football, Inc.*, 30 USPQ2d 1828, 1833 (T.T.A.B. 1994).

¹² *Id.*

¹³ *Id.* at 3

¹⁴ *Pro-Football Inc. v. Harjo*, 565 F.3d 880, 882 (2009).

¹⁵ *See id.* at 881-882

bringing the case, entitled it to assert the defense of laches, where there is a “(1) lack of diligence by the party against whom the defense is asserted, and (2) prejudice to the party asserting the defense”¹⁶ The TTAB eventually decided that the defense of laches was inappropriate and held that the marks were in fact disparaging and ordered the registrations cancelled.¹⁷

The Redskins then appealed to the TTAB’s decision to the United States District Court for the District of Columbia and filed a motion for summary judgment.¹⁸ The District Court granted the motion and reversed the TTAB because (1) the TTAB’s findings of disparagement were not supported by substantial evidence and (2) the doctrine of laches should have applied because of the twenty-five year delay between registration and petition for cancellation.¹⁹ In response to the District Court’s decision, the petitioners appealed. The United States Court of Appeals for the District of Columbia Circuit held that the District Court applied the wrong standard in analyzing laches as to one of the defendants, Mateo Ramero, because he was only one years old at the time of the first registration.²⁰

The Court of Appeals remanded the case back down to the District Court, which found that the laches did in fact bar the claim because, according to the court, the seven-year, nine-month “Romero Delay Period” demonstrated a lack of diligence on Romero’s part.²¹ In addition, the District Court opted not to make a decision on whether there was substantial evidence that the marks were disparaging. Once again, the petitioners appealed back up to the Court of Appeals. Because the lower court only made a decision on remand in regards to the laches defense, the Court of Appeals restricted its review to only that question.²² Ultimately, the Court

¹⁶ *Id.* at 882.

¹⁷ *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1743 (T.T.A.B. 1999).

¹⁸ *Blackhorse v. Pro Football Inc.*, 111 U.S.P.Q.2d 1080, 2 (T.T.A.B. 2014).

¹⁹ *Pro-Football, Inc. v. Harjo*, 284 F. Supp.2d 96, 96 (D.D.C. 2003).

²⁰ *Pro-Football, Inc. v. Harjo*, 415 F.3d 44, 49-50 (D.C. Cir. 2005).

²¹ *Pro-Football, Inc. v. Harjo*, 567 F. Supp.2d 46, 53-56 (D.D.C. 2008).

²² *Harjo*, 565 F.3d at 882 (D.C. Cir. 2009).

of Appeals affirmed the lower court's holding, without answering whether the marks registered by the Washington Redskins were in fact disparaging.²³

ii. *Blackhorse v. Pro-Football, Inc.*

After the *Harjo* hearings, the question still remained whether the marks registered by the Washington Redskins with the USPTO were disparaging to Native Americans. The prior courts were able to avoid answering the question by only focusing on Pro-Football, Inc.'s equitable defense of laches. In response to the pending *Harjo* case, five Native Americans brought a cancellation proceeding to the TTAB seeking to cancel the Redskins' multiple registrations issued between 1967 and 1990.²⁴ Regarding the laches defense, the TTAB concluded that it "does not apply to a disparagement claim where the disparagement pertains to a group of which the individual plaintiff or plaintiffs simply compromise one or more members."²⁵ The TTAB reasoned that it was difficult to justify the balancing of equities, the type of claim laches falls under, where a registrant's financial interest is weighed against human dignity.²⁶ This was an important finding because it was the greatest roadblock to cancellation in the *Harjo* cases. In the end, the TTAB ordered the cancelling of all six registered marks because they consisted of matter that "may disparage" Native Americans and bring them into contempt or disrepute.²⁷

On appeal from the TTAB's decision, the district court was faced with two issues. The first issue was "whether the Court should grant [Pro-Football, Inc.'s] Motion for Summary Judgment on Constitutional Claims and deny the cross-motions for summary judgment filed by [defendants]."²⁸ The second issue for the court is "whether the Court should grant PFI's Cross—

²³ See *id.* at 886.

²⁴ *Pro-Football Inc. v. Blackhorse*, 112 F. Supp.3d 439, 450-451 (2015).

²⁵ *Blackhorse*, 111 U.S.P.Q.2d at 31.

²⁶ *Id.*

²⁷ See *Id.* at 34.

²⁸ *Blackhorse*, 112 F. Supp.3d at 447.

Motion for Summary Judgment on Claims I [declaration of non-disparagement], II [declaration of non-contempt or disrepute], and VII [Blackhorse's petition barred by doctrine of laches], and deny Blackhorse Defendants' Motion for Summary Judgment on Counts I, II, and VII of Complaint."²⁹

In regards to the first issue, the court denied Pro-Football, Inc.'s Motion for Summary Judgment on both First and Fifth Amendment claims.³⁰ The court believed that the it did not implicate the First Amendment because it viewed the trademark registration program as government speech, which is exempt from First Amendment scrutiny.³¹ This paper will later discuss how the Supreme Court differed on this issue in *Tam*. Likewise, the court also denied Pro-Football, Inc.'s Motion for Summary Judgment in regards to Claims I, II, and VII.³² To come to this conclusion, the court looked at "(1) dictionary evidence; (2) literary, scholarly, and media references; and (3) statements of individuals and groups in the referenced group show that the Redskins Marks consisted of matter that 'may disparage' a substantial composite of Native Americans during the relevant time period."³³

Pro-Football, Inc. appealed the lower court's decision and the Court of Appeals decided to wait until after the Supreme Court decided on the *Tam* case to hear the appeal. Upon hearing the *Tam* decision, the Court of Appeals vacated holding and remanded the case back down to the lower court.³⁴

D. *Matal v. Tam*.

²⁹ *Id.* at 447,451.

³⁰ *Id.* at 452.

³¹ *Id.*

³² *Id.* at 452-453.

³³ *Id.* at 453.

³⁴ *Pro-Football, Inc. v. Blackhorse*, 709 Fed.Appx. 182, 184 (2018).

This two-part test was used when Simon Tam attempted to register his band's name, "THE SLANTS," on the Principal Register.³⁵ Tam chose this name in order to "reclaim" the term and lessen its demeaning force as an offensive name for people of Asian descent.³⁶ Registration was refused by the PTO under Section 2(a) of the Lanham Act, 15. U.S.C. § 1052(a), on the grounds that Tam's mark "consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs, or national symbols under Trademark Act Section 2(a)."³⁷ In accordance with the two-part test, the examining attorney contended that "THE SLANTS is a highly disparaging reference to people of Asian descent, that it retains this meaning when used in connection with applicant's services, and that a substantial composite of the referenced group finds it to be disparaging."³⁸ In addition, the examining agent also attached dictionary definitions, printouts from the applicant's webpage, and printouts of articles which report that individuals representing Asian groups or even individuals in their own capacity have found the word, and even specifically the mark, to be disparaging.³⁹ Tam then challenged the denial of registration and requested reconsideration, exhausting all his options through the administrative appeals process before filing suit in federal court.⁴⁰

At the Trademark Trial and Appeal Board, Tam rebutted the examining attorney's contentions by asserting other dictionary definitions for the word "slant" and citing four registrations of the term "SLANT" for other services.⁴¹ Tam ultimately concluded that the refusal was based on who Tam is, an Asian-American, and that if he were not then the mark

³⁵ *Matal v. Tam*, 137 S.Ct. at 1747.

³⁶ *Id.*

³⁷ E.A. Br. p. 3.

³⁸ *In re Tam*, 108 U.S.P.Q.2d at 1.

³⁹ *See id.*

⁴⁰ *Id.*

⁴¹ *Id.* at 3.

would have been registered.⁴² The Appeal Board refuted this stance, stating “[n]either the ethnic identity of Applicant, the extent to which he associates in his use in the mark with other Asians, the degree to which he makes use of his own cultural heritage, or his identity in any sense at all should be of relevance concerning registration of THE SLANTS”⁴³ When analyzing the facts before them, the TTAB used the same two-part test discussed above. First, it concluded the likely meaning of the term. Second, having determined the likely meaning of the term, the TTAB then looked at whether the mark is disparaging to a substantial composite of the referenced group.⁴⁴ Upon doing so, the TTAB affirmed the PTO’s decision to refuse registration under Section 2(a).⁴⁵ The TTAB made sure to emphasize that “this decision only pertains to applicant’s right to register the term and ‘it is clear that the PTO’s refusal to register [applicant’s] mark does not affect [his] right to use it. No conduct is proscribed, and no tangible form of expression is suppressed.’”⁴⁶ In the eyes of the TTAB, this case was “solely about whether the applicant ‘may call upon the resources of the federal government’ to obtain federal registration of the mark on the Principal Register in order to assist applicant in enforcing the mark.”⁴⁷

Once Tam brought the case to federal court, the en banc Federal Circuit ultimately found the disparagement clause to be facially unconstitutional under the First Amendment’s Free Speech Clause.⁴⁸ The Supreme Court then granted certiorari and later affirmed the decision of the lower court.⁴⁹ The Supreme Court made a couple important conclusions in deciding the case. First, it found that trademarks are private, not government speech.⁵⁰ This is critical to the

⁴² *Id.* at 4.

⁴³ App. Br. p. 19.

⁴⁴ *In re Tam*, 108 U.S.P.Q.2d at 7.

⁴⁵ *Id.* at 8.

⁴⁶ *Id.*

⁴⁷ *Id.*

⁴⁸ *In re Tam*, 808 F.3d 1321, 1357 (2015).

⁴⁹ *Matal v. Tam*, 137 S.Ct. at 1747.

⁵⁰ *Id.* at 1748.

government's argument because it does not have the authority to suppress private speech under the First Amendment. Had the Court decided that trademarks were government speech, the Free Speech Clause would not apply because it does not regulate government speech.⁵¹ "The government is not required to maintain viewpoint neutrality on its own speech."⁵² The Court exercised great caution in extending its government speech precedent because it did not want to give the government the ability, by passing off private speech as government speech simply by "approving" it, to silence the expression of disfavored opinions.⁵³

In addition, the Court denied the government's argument that the case should be governed by the Court's subsidized-speech cases.⁵⁴ The Court illustrated how the federal registration of trademarks is nothing like these other programs, which all involved cash subsidies or their equivalent.⁵⁵ The PTO does not pay money to parties, rather it charges them fees to submit an application and sustain registration.

One area that was left unanswered by the Court was whether trademarks are commercial speech, and as such, subject to the relaxed scrutiny outlined in *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n of N.Y.*⁵⁶ Under *Central Hudson*, a restriction of speech must have "a substantial interest" that is "narrowly drawn."⁵⁷ The government argued that trademarks were strictly commercial speech, noting that the "central purposes of trademarks are commercial and that federal law regulates trademarks to promote fair and orderly interstate commerce."⁵⁸ Tam, on the other hand, argued that many trademarks also have an expressive component in

⁵¹ *Id.*

⁵² *Id.*

⁵³ *Id.*

⁵⁴ *Id.* at 1749.

⁵⁵ *Id.*

⁵⁶ *Id.* at 1763-64

⁵⁷ *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n of N.Y.*, 447 U.S. 557, 564-65.

⁵⁸ *Matal v. Tam*, 137 S.Ct. at 1764.

addition to its commercial one.⁵⁹ In *Tam*, this would be illustrated as the name “The Slants” identifies the band and also expresses a view about social issues.⁶⁰ The Court did not resolve this dispute between the parties because it concluded that the disparagement clause would not survive even *Central Hudson* review.⁶¹

When the Court analyzed whether the disparaging clause would withstand *Central Hudson* review, it pointed out the two “claimed” interests that the clause serves.⁶² The first is that the government has an interest in preventing speech expressing ideas that offend.⁶³ The second interest asserted is protecting the orderly flow of commerce.⁶⁴ The first interest is one that touches the heart of the First Amendment. The Court stated that, “Speech that demeans on the basis of race, ethnicity, gender, religion, age, disability, or any other similar ground is hateful; but the proudest boast of our free speech jurisprudence is that we protect the freedom to express ‘the thought we hate.’”⁶⁵ As for the second interest, the Court acknowledged the belief that commerce is disrupted by trademarks that “involve[e] disparagement of . . . ethnicity”⁶⁶ Such trademarks are analogized to discriminatory conduct, which has been recognized to have an adverse effect on commerce.⁶⁷ The Court in *Tam* simply settled this debate by asserting that “the disparaging clause is not ‘narrowly drawn’ to drive out trademarks that support invidious discrimination.”⁶⁸ Because the disparaging clause extends to *any person, group, or institution*, it is not an anti-discrimination clause; rather, it is a happy-talk clause that goes much further than is

⁵⁹ *Id.*

⁶⁰ *Id.*

⁶¹ *Id.*

⁶² *Id.*

⁶³ *Id.*

⁶⁴ *Id.*

⁶⁵ *Id.* (citing *United States v. Schwimmer*, 279 U.S. 644, 645 (1929) (Holmes, J., dissenting)).

⁶⁶ *In re Tam*, 808 F.3d at 1380-81 (opinion of Reyna, J.).

⁶⁷ See *ibid.*; Brief for Native American Organizations as *Amici Curiae* 18-20.

⁶⁸ *Matal v. Tam*, 137 S.Ct. at 1764-65.

necessary to serve the interest asserted.⁶⁹ The Court made sure to note just how broad the disparaging clause is by illustrating that it protects every person living or dead as well as every institution.⁷⁰ Even further, the Court worried how if affixing the commercial label permits the suppression of any speech that may lead to political or social “volatility,” free speech would be endangered.⁷¹

It becomes clear that the sheer scope of the Disparaging Clause played an important role in its demise. Had it been focused on *only* the race or nationality of people, rather than its much broader scope, the clause could have forced the Supreme Court to take a stance on whether trademarks are strictly commercial speech or in fact, as Tam argued, commercial in addition to having an expressive component. The Court could potentially of held that the Disparaging Clause satisfied the *Central Hudson* review, forcing the Court’s hand to make a decision on the component(s) of a trademark.

For all the reasons listed, the Supreme Court held that Section 2(a) of the Lanham Act, 15 U.S.C § 1052(a), violated the First Amendment’s Free Speech Clause because since the disparaging clause is not narrowly drawn, it was a form of viewpoint discrimination.⁷² This was a huge win for free speech advocates and could have a number of immediate results. First, the USPTO will likely see an influx of trademark applications related to these controversial marks. Second, this will disrupt the status quo of the USPTO, which has followed this guidance for over one hundred years. Lastly, it could see backlash from both the public and Congress for actively allowing these type of marks to gain the benefits of federal registration offered by the USPTO.

⁶⁹ *Id.* at 1765.

⁷⁰ *Id.*

⁷¹ *Id.*

⁷² *See id.*

E. *In re Brunetti* has eliminated another footing for those opposed to the registration of offensive marks, such as the “REDSKINS.”

Following the Supreme Court’s decision in *Matal v. Tam*, there was yet another important case waiting to decide what should be registrable content with the PTO. The Federal Circuit, in *In re Brunetti*, decided to wait until after *Tam* to decide whether the immoral or scandalous provision in Section 2(a) is an unconstitutional restriction on free speech. In light of the *Tam* decision, it appeared likely that this provision, like the disparaging clause, would be found unconstitutional. This is despite the fact that the two provisions are different. The immoral or scandalous provision does not raise the First Amendment free speech flag like the disparaging clause. This is because

(1) the marks at issue are smutty, vulgar or worse and not intended to send any larger expressive message; (2) registration is not perceived as economically necessary for these mark owners; (3) when there are serious free speech issues they can be ameliorated on a case-by-case basis by careful or limiting application of the statutory tests; and (4) this provision provides a desirable civilizing effect on what could be registered as marks⁷³

Section 2(a) of the Lanham Act states that the USPTO may refuse to register marks that “[c]onsist of or comprise immoral, deceptive, or scandalous matter . . .” otherwise known as the immoral or scandalous provision.⁷⁴ To determine whether a mark should be disallowed under Section 2(a), the USPTO asks whether a “substantial composite of the general public” would find the mark scandalous, defined as “shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable . . . giving offense to the conscience or moral feelings; . . . or

⁷³ Hugh Hansen, *Symposium: Most important free speech case in many years*, SCOTUSblog (Jun. 22, 2017), <http://www.scotusblog.com/2017/06/symposium-important-free-speech-case-many-years/>.

⁷⁴ *Brunetti*, 877 F.3d at 1335-36.

calling out for condemnation.”⁷⁵ Alternatively, the USPTO may prove that a mark is scandalous by “establishing that a mark is ‘vulgar.’”⁷⁶ Vulgar marks are “lacking in taste, indelicate, [and] morally crude”⁷⁷ In order to determine what qualifies as scandalous, the PTO looks at whether the mark is scandalous “in light of contemporary attitudes” and “in the context of the marketplace as applied to only the goods described in the application.”⁷⁸

Now understanding the way the PTO approached this scandalous provision, it is clear that those opposed to the Washington Redskin’s marks could succeed on these grounds in more than one way. First, the Redskin’s marks could be “offensive” and therefore scandalous. It is likely that the contemporary attitudes towards the term “redskins” has not changed much over time and if it has, it would only be a growing sense that it is a very offensive term. Numerous dictionaries even list the term “redskin” as offensive.⁷⁹ Alternatively, a court could also find that the various Redskin’s marks are because they are in fact “lacking in taste, indelicate, [and] morally crude”⁸⁰ Either one of these likely would have satisfied the scandalous test, in turn disallowing the registration of these marks. Instead, this is no longer an option because the Court of Appeals of the Federal Circuit held that the scandalous provision in Section 2(a) of the Lanham Act unconstitutional.⁸¹

Prior to hearing the case, the court requested additional briefing from both parties in light of the decision in *In re Tam*.⁸² The government, in its response, stated that “‘given the breadth of the Court’s *Tam* decision and in view of the totality of the Court’s reasoning,’ there is not

⁷⁵ *Id.* at 1336 (citing *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012)) (quoting *In re Media Grp. Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994)).

⁷⁶ *Id.* at 1336.

⁷⁷ See *In re McGinley*, 660 F.2d 481, 486 (CCPA 1981) (quoting *In re Runsdorf*, 171 U.S.P.Q. 443, 443-44 (1971)).

⁷⁸ See *Mavety*, 33 F.3d at 1371).

⁷⁹ See *Blackhorse*, 111 U.S.P.Q.2d at 13.

⁸⁰ *Brunetti*, 877 F.3d at 1336.

⁸¹ *Id.* at 1357.

⁸² *Id.* at 1340.

reasonable basis for treating immoral or scandalous marks differently than disparaging marks.”⁸³ This statement was made in the time that the *Brunetti* court was waiting for the Supreme Court’s decision to either affirm or reverse the lower court’s decision.

Following the *Tam* decision, the court once again requested additional briefing from both parties regarding the Supreme Court’s decision.⁸⁴ Here, the government contended that “the Supreme Court’s decision in *Tam* did not resolve the constitutionality of Section 2(a)’s bar on registering immoral or scandalous marks” because unlike how the disparagement clause constituted viewpoint discrimination, the immoral or scandalous provision was viewpoint neutral.⁸⁵ The court in *Brunetti* decided not to resolve this distinction because it held that the immoral or scandalous provision “impermissibly discriminates based on *content*” in violation of the First Amendment.⁸⁶ Surprisingly, though, the court did decide whether the mark at issue, “FUCT,” was vulgar. The court looked at both the dictionary definitions of “fuct” as well as how the use of the mark in the marketplace corroborates the link between the mark and the word “f*ck.”⁸⁷ While deciding that the mark was in fact vulgar appeared to be a win for those opposed to the registration of scandalous marks, the court would later deliver a devastating blow.

In further explaining the *Brunetti* court’s decision to find content-based discrimination, the court stated that the government restricts speech based on content when “a law applies to particular speech because of the topic discussed or the idea or message expressed”⁸⁸ and are presumptively invalid.⁸⁹ Similar to the decision in *Tam* regarding viewpoint discrimination, the court here held that in order for the government to overcome content-based discrimination, it

⁸³ *Id.* (quoting Gov’t Letter Br. 2, *In re Brunetti*, No.15–1109, Docket No. 52 (Fed. Cir. Jan. 21, 2016).

⁸⁴ *Id.* at 1341

⁸⁵ *Id.*

⁸⁶ *Id.* (emphasis added).

⁸⁷ *Id.* at 1338.

⁸⁸ *Id.* at 1341-42 (quoting *Reed v. Town of Gilbert*, 135 S.Ct. 2218, 2227 (2015)).

⁸⁹ *Id.* at 1342.

would have to survive strict scrutiny, which the immoral or scandalous provision does not.⁹⁰ The court then went as far as to say that the immoral or scandalous provision would not even survive intermediate scrutiny under *Central Hudson*.⁹¹

In analyzing Section 2(a) of the Lanham Act's immoral or scandalous provision under the *Central Hudson*'s intermediate scrutiny review, the court highlighted the two-prong test. First, the court must confirm the speech "concern lawful activity and not be misleading."⁹² *Central Hudson*'s second prong of the test requires a substantial government interest.⁹³ In response to the first prong, the court held that Section 2(a)'s provision barring immoral or scandalous marks, like the disparagement clause, does not address "misleading, deceptive, or unlawful marks."⁹⁴ Instead, the provision is concerned with whether the mark is "offensive, scandalous, or vulgar to a substantial composite of the general public."⁹⁵ In regards to the second prong, the court stated that it was not met because the only interest related to the immoral or scandalous provision "that [the court] can discern from the government's briefing is its interest in 'protecting public order and morality.'"⁹⁶ Contrary to the government's arguments, the court held that the government did not have a substantial interest in promoting certain trademarks over others or protecting the public from "off-putting" marks.⁹⁷

III. CONCLUSION

In light of both *Matal v. Tam* and *In re Brunetti*, the possibility for Blackhorse to prevail on remand against the Washington Redskins' has critically decreased. Section 2(a) of the

⁹⁰ *Id.*

⁹¹ *Id.* at 1350.

⁹² *Id.* (quoting *Central Hudson*, 447 U.S. at 566).

⁹³ *Id.* at 1350.

⁹⁴ *Id.*

⁹⁵ *Id.*

⁹⁶ *Id.* (quoting Gov't Letter Br. 15 & n.6, *In re Brunetti*, No. 15-1109, Docket No. 60 (Fed. Cir. July 20, 2017)).

⁹⁷ *Id.* at 1351.

Lanham Act's purpose is to establish the type of marks that are unable to be registered on the principal register. After these cases, marks that disparage or are immoral or scandalous are now appropriate for trademark registration. Without being able to point to these provisions in Section 2(a), those opposed to the Redskins' marks, and any other offensive or disparaging marks for that matter, have no basis to make a claim or have standing in a court of law. Upon remand, it is highly likely that the district court will hold that the Washington Redskins' marks will remain registered on the principal register.