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## U.S. Supreme Court Surveys: 2016 Term. *Matal v. Tam*: Free Speech Meets "Disparaging" Trademarks in the Supreme Court

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# ***Matal v. Tam*: Free Speech Meets “Disparaging” Trademarks in the Supreme Court**

Niki Kuckes\*

## INTRODUCTION

In *Matal v. Tam*,<sup>1</sup> which was decided at the end of the Supreme Court’s 2016 term, the Court relied on the Free Speech Clause of the First Amendment<sup>2</sup> to strike down part of Section 2(a) of the Lanham Act.<sup>3</sup> This longstanding provision of federal trademark law had allowed the government to refuse registration to trademarks found to “disparage” persons or groups.<sup>4</sup> The collision between trademark law and Free Speech presented in *Matal v. Tam* turned out to pose surprisingly challenging legal issues.<sup>5</sup> While all eight Justices participating agreed that the provision was unconstitutional,<sup>6</sup> there was less consensus on why it was

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1. 137 S. Ct. 1744 (2017).

2. U.S. CONST. amend. I, § 2.

3. Lanham Act § 2(a), 15 U.S.C. § 1052(a) (2012).

4. Federal trademark law (known as the Lanham Act) provided in relevant part as follows:

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 or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute . . . .

*Id.*

5. See *Tam*, 137 S. Ct. at 1751.

6. Justice Gorsuch took no part in the decision of the case. *Id.* at 1750.

unconstitutional, and no consensus as to the proper level of scrutiny for assessing such a challenge.<sup>7</sup> As this Survey reflects, where matters touch on “commercial speech,”<sup>8</sup> there are serious open issues in First Amendment doctrine that the Court failed to resolve in *Matal v. Tam*.<sup>9</sup>

The case began when Simon Tam, the leader of an Asian-American rock band, sought to register “The Slants” as a trademark for his band.<sup>10</sup> In choosing the band name “The Slants”—a term understood by many as a derogatory reference to Asian-Americans—Tam consciously intended to “reclaim” an ethnic slur as a source of ethnic pride.<sup>11</sup> After considering the evidence relating to linguistic uses of the term “slants,” and its derogatory use in relation to Asian-Americans, the United States Patent and Trademark Office (USPTO) concluded that the term “The Slants” was “disparaging” to a substantial part of the Asian-American community and refused to register it.<sup>12</sup>

Tam appealed to the Federal Circuit, challenging both the agency’s conclusion that his mark was “disparaging,” and the constitutionality of the Lanham Act provision allowing the agency to reject “disparaging” trademarks.<sup>13</sup> In a striking turn of events,

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7. Compare *id.* at 1767 (Kennedy, J., concurring) (arguing that the case should be considered under a “heightened scrutiny” standard), and *id.* at 1769 (Thomas, J., concurring) (arguing that the case should be resolved under the “strict scrutiny” test), with *id.* at 1764 (Alito, J.) (plurality opinion) (concluding that the Court need not resolve the dispute as to whether the case should be resolved under the intermediate scrutiny test for commercial speech or under a different test).

8. See *id.* at 1767 (Kennedy, J., concurring); *id.* at 1769 (Thomas, J., concurring); *id.* at 1764 (Alito, J.) (plurality opinion).

9. See *Tam*, 137 S. Ct. 1744.

10. *Id.* at 1751 (Alito, J.) (majority opinion).

11. See *In re Tam (Tam En Banc Decision)*, 808 F.3d 1321, 1331 (Fed. Cir. 2015), *as corrected* (Feb. 11, 2016); see also *Tam*, 137 S. Ct. at 1754 (Mr. Tam named his band The Slants “to ‘reclaim’ and ‘take ownership’ of stereotypes about people of Asian ethnicity.”).

12. *In re Tam*, 108 U.S.P.Q.2d (BNA) 1305, 1310 (T.T.A.B. 2013) (finding “The Slants” mark to be disqualified from registration under Section 2(a) because “a substantial composite of the referenced group find the term objectionable.”).

13. See *In re Tam (Tam Panel Decision)*, 785 F.3d 567, 569 (Fed. Cir. 2015) (“Mr. Tam argues that the Board erred in finding the mark THE SLANTS disparaging under § 2(a) of the Lanham Act and therefore unregistrable. Mr. Tam also challenges the constitutionality of § 2(a).”), *reh’g en banc granted, opinion vacated*, 600 F. App’x 775 (Fed. Cir.), and *reh’g en banc*, 808 F.3d 1321

the Federal Circuit sitting *en banc* used the case as the occasion to issue a major constitutional decision. In *In re Tam*, the court invalidated the disparagement provision of federal trademark law, which had been in place since 1946, and had been used for decades to reject trademark registrations.<sup>14</sup> In so doing, the Federal Circuit reversed its own established precedent that Section 2(a)'s bar on "disparaging" trademarks did not violate the First Amendment.<sup>15</sup>

Beyond overturning its dated precedent, a majority of the Federal Circuit articulated a new, dual-standard approach to free speech challenges in the commercial context: It held that the courts should review the government's action strictly when it is directed at the "expressive character" of a trademark, but more leniently when it is directed at the "commercial-speech function of the mark."<sup>16</sup> While traditional free speech doctrine begins by focusing on the character of the speech in order to decide on a framework for review,<sup>17</sup> the Federal Circuit shifted to an emphasis on the focus of the government rule.<sup>18</sup> The decision generated a total of five opinions, including the majority, concurring, and dissenting

(Fed. Cir.), *as corrected* (Feb. 11, 2016), *cert. granted sub nom.*, *Lee v. Tam*, 137 S. Ct. 30 (2016), *and aff'd sub nom.*, *Matal v. Tam*, 137 S. Ct. 1744 (2017).

14. See *Tam En Banc Decision*, 808 F.3d at 1358 ("We hold that the disparagement provision of § 2(a) is unconstitutional because it violates the First Amendment.").

15. See *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) (holding that "[n]o conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant's First Amendment rights would not be abridged by the refusal to register his mark [under Section 2(a)]."); see also *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012) (following *In re McGinley's* holding); see also *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003) (holding that the mark was unable to be registered under section 2(a) because it contained "scandalous matter"); *In re Mavety Media Grp.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994) (quoting *In re McGinley*, 660 F.2d at 484).

16. See *Tam En Banc Decision*, 808 F.3d at 1338 ("The disparagement provision must be assessed under First Amendment standards applicable to what it targets, which is not the commercial-speech function of the mark . . . . This is not a government regulation aimed at the commercial component of speech.").

17. See, e.g., *Riley v. Nat'l Fed'n of the Blind of N. Carolina, Inc.*, 487 U.S. 781, 787 (1988) ("We began our analysis by categorizing the type of speech at issue.").

18. For the reasons discussed below, this analysis represents an intriguing shift in the focus of the judicial analysis, but the particular formulation adopted by the Federal Circuit is problematic. See *infra* Section IV.A.

opinions, each offering different First Amendment theories.<sup>19</sup>

When the Supreme Court agreed to hear the case, the appeal generated an intense flurry of interest, resulting in a stack of *amicus curiae* briefs on all sides of the issue from public interest groups, bar organizations, civil rights groups, law professors, and professional football organizations.<sup>20</sup> Between the federal government's defense of the law, Tam's defense of the ruling below, and the views expressed by the numerous *amici*, there were a bewildering variety of proposals as to how the Court should approach the First Amendment free speech issue.

It is perhaps not surprising that the case generated split decisions in the Supreme Court, just as it had in the Federal Circuit.<sup>21</sup> There was complete agreement within the Court that the "disparagement" provision of Section 2(a) was unconstitutional under the First Amendment.<sup>22</sup> All members of the Court also agreed on a well-established bedrock free speech principle: "Speech may not be banned on the ground that it expresses ideas that offend."<sup>23</sup> Simply because Mr. Tam's mark is offensive to other

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19. See *Matal v. Tam*, 137 S. Ct. 1744, 1754–55 (2017) (Alito, J.) (majority opinion) (summarizing the "assortment of theories" expressed in the opinions generated in the *en banc* Federal Circuit decision).

20. *Matal v. Tam Docket*, SUP. CT. OF THE U.S. (Sep. 25, 2017), <https://www.supremecourt.gov/search.aspx?filename=/docketfiles/15-1293.htm> (listing amicus briefs filed). As this list hints, the outcome of the case was of direct interest to the Washington Redskins professional football team, whose team name was being challenged on the same legal grounds. See *infra* Section II.

21. Justice Alito wrote an opinion announcing the judgment of the Court and an opinion of the Court as to Parts I, II, and III-A of his opinion. *Tam*, 137 S. Ct. 1744. Justice Kennedy wrote an opinion, concurring only in Parts I, II, and III-A of the Alito opinion and concurring in the judgment. *Id.* at 1767 (Kennedy, J., concurring). Justice Thomas wrote an opinion, concurring in all parts of the Alito opinion except for Part II and concurring in the judgment. *Id.* at 1769 (Thomas, J., concurring).

22. *Id.* at 1765 (plurality opinion) (deciding that "[f]or these reasons, we hold that the disparagement clause violates the Free Speech Clause of the First Amendment. The judgment of the Federal Circuit is affirmed."); see also *id.* at 1750 (majority opinion) (laying out the voting tally, which shows that all Justices participating concurred in the Supreme Court's judgment).

23. *Id.* at 1751 (Alito, J.) (announcing the judgment of the Court and an opinion of the Court as to Parts I, II, and III-A); see also *id.* at 1765 (Kennedy, J., concurring) ("[I]t is a fundamental principle of the First Amendment that the government may not punish or suppress speech based on disapproval of the ideas or perspectives the speech conveys.").

Asian-Americans does not provide a constitutionally justifiable reason for the government to burden his speech by denying him the legal status afforded to registered trademarks.<sup>24</sup> Beyond that, however, there was little common ground in the Justices' reasoning. The split opinions in *Matal v. Tam* sowed further confusion on the issue of what degree of constitutional free speech protection should be afforded to "commercial speech," and indeed, what even constitutes "commercial speech" in this context.<sup>25</sup>

The discussion of these interesting constitutional questions proceeds below as follows: Part I lays the groundwork by explaining the significance of trademark registration and the benefits that a trademark owner derives from registration (and that are denied when registration is refused); Part II lays out the Supreme Court opinions in *Matal v. Tam* and explains the areas of constitutional agreement; Part III outlines the areas of constitutional dispute in *Matal v. Tam*, and parses the splintered decisions the case produced; and finally, Part IV analyzes which approach to the free speech issues presented is the most coherent way to approach the First Amendment in this context.

#### I. TRADEMARK REGISTRATION AND THE LEGAL BENEFITS THAT FOLLOW

Because the federal trademark registration scheme embodied in the Lanham Act<sup>26</sup> is not a matter of common knowledge, a few basic points about trademarks are essential in order to understand the free speech issues addressed in *Matal v. Tam*.<sup>27</sup> Three points, in particular, are important here: *First*, it is true that trademark rights are not created by federal law, and that a mark may be used by the owner whether or not it is federally registered, but at the same time, the significance of this "right" should not be understated;<sup>28</sup> *Second*, federal registration requirements are not demanding, and successful federal registration of a trademark vastly expands the legal rights held by the owner of the mark both

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24. *Id.* at 1763 (Alito, J.) (plurality opinion) (quoting *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 55–56 (1988)).

25. *See id.*; *id.* at 1765 (Kennedy, J., concurring).

26. Lanham Act § 1, 15 U.S.C. § 1051 (2012).

27. *See* 137 S. Ct. at 1757 (Alito, J.) (majority opinion).

28. *See infra* Section I.A.

substantively and procedurally;<sup>29</sup> and *Third*, the “disparagement” provision at issue here is a small part of a broader federal regulatory program designed to protect rights in the commercial sphere and prevent unfair trade practices.<sup>30</sup> These points are little understood by those who do not practice trademark law, but highly relevant when turning to the proper interpretation of the First Amendment as applied to Mr. Tam’s trademark dispute.

*A. The “Right” to Use a Trademark Without Federal Registration*

A trademark—such as “The Slants” for Mr. Tam’s band—is defined as “any word, symbol, name or other device . . . used by a person . . . to identify and distinguish [a trademark owner’s goods] . . . from those manufactured or sold by others.”<sup>31</sup> Such a mark provides a powerful way for a seller to promote and distinguish his or her products or services in the commercial marketplace.<sup>32</sup>

A consumer need only look around to see the power of branding and the value of trademarks. From McDonald’s golden arches, to Apple’s distinctive white apple silhouette, to Nike’s “Just Do It,” there is no question that product trademarks, logos, and slogans are instantly recognizable to consumers—and thereby highly valuable to companies. While the definition of a “trademark”<sup>33</sup> comes from the Lanham Act, trademarks are not created by federal law. A trademark owner’s right to claim a particular mark to identify his goods or services was recognized at common law long before the federal Lanham Act created a national trademark registry in 1946.<sup>34</sup>

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29. *See infra* Section I.B.

30. *See infra* Section I.C.

31. Lanham Act § 45.

32. While “trademarks” refer to marks used in connection with the sale of goods, the Act also allows for registration of other types of marks for products and services, including service marks, collective marks, and certification marks. *See id.* In the text above and below, all of these are collectively referred to as “trademarks.”

33. *Id.*

34. *See Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017) (“Trademarks and their precursors have ancient origins, and trademarks were protected at common law and in equity at the time of the founding of our country.” (citations omitted)); *see also, e.g.*, 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:8 (4th ed. 2015).

This history is significant here for two reasons: *first*, it underscores the nature of a trademark as the owner's private speech; and *second*, it follows that a trademark owner can use a trademark whether or not it is registered. The latter principle—that trademark owners still have the “right” to use their trademark even if registration is denied—was the basis for the original Federal Circuit holding that the agency's power to refuse registration to “disparaging” trademarks did not implicate any free speech rights.<sup>35</sup> In *In re McGinley*, the Federal Circuit reasoned that, because rejecting a trademark from registration, “does not affect [the owner's] right to use it,” there could be no possible abridgement of the owner's First Amendment rights.<sup>36</sup> While the government raised the same rationale here, this point was rightly rejected by both the Federal Circuit and the Supreme Court as an unduly limited view of free speech rights.<sup>37</sup> Modern Supreme Court doctrine recognizes that a burden on speech can violate the First Amendment as much as an outright ban.<sup>38</sup>

Moreover, while a trademark owner has an ostensible legal right to use a mark even without registration, the value of this “right” should not be overstated. As the Federal Circuit has emphasized, it is “widely recognized that federal trademark registration bestows *truly* significant and financially valuable benefits upon markholders”—benefits unavailable if federal registration is denied.<sup>39</sup> No competent trademark attorney would advise a client that it makes no difference whether or not the client's trademark is federally registered.<sup>40</sup>

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35. See *Tam Panel Decision*, 785 F.3d 567, 571–72 (Fed. Cir. 2015).

36. 660 F.2d 481, 484 (C.C.P.A. 1981) (“With respect to appellant's First Amendment rights, it is clear that the PTO's refusal to register appellant's mark does not affect his right to use it . . . [n]o conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant's First Amendment rights would not be abridged by the refusal to register his mark.” (citation omitted)).

37. See *Tam*, 137 S. Ct. at 1753; *Tam En Banc Decision*, 808 F.3d at 1339 (rejecting the government's argument that Section 2(a) “does not implicate the First Amendment because it does not prohibit any speech”).

38. See, e.g., *Tam En Banc Decision*, 808 F.3d at 1340 (noting that “[l]awmakers may no more silence unwanted speech by burdening its utterance than by censoring its content” (citation omitted)).

39. See *id.* (citation omitted).

40. See Lee Ann W. Lockridge, *Abolishing State Trademark Registrations*, 29 CARDOZO ARTS & ENT. L.J. 597, 605 (2011) (“[T]he incentives

*B. The Benefits Afforded by Federal Registration*

Federal requirements for registering a trademark are not onerous.<sup>41</sup> To qualify for federal registration, the owner must be seeking to register a trademark that is capable of “distinguishing” the goods or services from those offered by others in the same market (and not already in use for that purpose by another trademark owner).<sup>42</sup> The owner of the mark must also show, or be prepared to show, that the trademark is being used “in commerce” in connection with particular goods or services.<sup>43</sup>

If a trademark used to identify goods or services meets the test for “distinctiveness,” and is actually used in commerce by the trademark owner in selling the relevant goods or services, the trademark owner is presumptively entitled to federal registration of the trademark—and the agency has only limited grounds on which it may deny registration, including the “disparagement” provision at issue in *Matal v. Tam*.<sup>44</sup> The trademark “The Slants” for a rock band would thus have qualified for federal registration but for the agency’s finding that it was “disparaging” to other

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to pursue federal registration . . . are now so significant as to make federal registration indispensable for any owner making an informed decision about its trademark rights. A federal registration is the only rational choice . . .”).

41. See Lanham Act § 1, 15 U.S.C. § 1051 (2012) (setting out requirements for trademarks registrable on the principal register). The Lanham Act actually establishes two national trademark registries. First, the “Principal Register” is for registering trademarks that are being “used in commerce” or as to which the applicant has a “bona fide” intent to use in commerce within the near future. See *id.* §§ 1(a)(1), (b)(1). Second, the “Supplemental Register” is for registering trademarks that are “capable of distinguishing the applicant’s goods or services” but not yet registrable on the Principal Register. See *id.* § 23(a). Because trademarks on the Supplemental Register do not yet get the full protections of trademark law, and because the Supplemental Register is not otherwise important for purposes of *Tam*, the discussion will address only registration in the context of the Principal Register.

42. See *id.* § 2 (“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration” except on specified and limited grounds.)

43. See *id.* § 1(a)(1) (“The owner of a trademark used in commerce may request registration of its trademark on the principal register . . .”).

44. See *id.* § 2 (stating that “[n]o 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” subject to an express exception).

members of the Asian-American community.<sup>45</sup>

Successful registration of a trademark dramatically expands the trademark owner's rights, both as a substantive matter and as a procedural matter.<sup>46</sup> The Supreme Court has emphasized, in its trademark decisions, that the "Lanham Act confers important legal rights and benefits on trademark owners who register their marks."<sup>47</sup> This emphasis is important for First Amendment purposes because free speech rights can be infringed in many ways, including through the denial of benefits.

Most importantly, federally registering a trademark expands the *substantive* legal rights held by the trademark owner.<sup>48</sup> In the absence of federal registration, if a trademark owner has any common law rights, they are "limited to the territory in which the mark is known and recognized" by consumers.<sup>49</sup> In passing the Lanham Act, Congress consciously set about to expand upon common law protection by giving the owner of a federally registered trademark the right to exclusive *nationwide* use of that mark.<sup>50</sup> This statutory right to nationwide use of a federally registered trademark excludes only those limited geographic areas, if any, in which another person's use of the same mark for the same product precedes federal registration.<sup>51</sup> Federal registration of a mark

45. See *Tam En Banc Decision*, 808 F.3d 1321, 1329 (Fed. Cir. 2015) ("Under the Lanham Act, the PTO must register source-identifying trademarks unless the mark falls into one of several categories of marks precluded from registration.").

46. See MCCARTHY, *supra* note 34, at §§ 19:9, :11 ("Registration of a mark on the federal Principal Register confers a number of procedural and substantive legal advantages over reliance on common law rights . . . [r]egistration on the Principal Register should be attempted if it is at all possible.").

47. *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1300 (2015) (internal quotations omitted).

48. See, e.g., *Tam En Banc Decision*, 808 F.3d at 1345 ("Federal trademark registration brings with it valuable substantive and procedural rights unavailable in the absence of registration.").

49. See 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 26:2 (5th ed. 2017).

50. See *Tam En Banc Decision*, 808 F.3d at 1328.

51. See *id.* at 1328; *Burger King of Fla., Inc. v. Hoots*, 403 F.2d 904, 908 ("Congress expanded the common law, however, by granting an exclusive right in commerce to federal registrants in areas where there has been no offsetting use of the mark."); see also Lanham Act §§ 22, 33, 15 U.S.C. §§ 1072, 1115 (2012).

grants mark-holders a critical substantive right, not available outside of the Lanham Act, by expanding the geographic scope of the owner's exclusive rights to use the trademark.<sup>52</sup>

A number of procedural benefits also follow from federal registration of a mark. A federally registered mark is “presumed to be valid” in any federal trademark litigation.<sup>53</sup> “[T]he mark becomes incontestable (with certain exceptions) after five years of consecutive post-registration use . . . .”<sup>54</sup> The holder of a registered mark “may sue in federal court to enforce his trademark,”<sup>55</sup> and “may recover treble damages if he can show infringement was willful.”<sup>56</sup> The owner of a registered mark “may also obtain the assistance of U.S. Customs and Border Protection in restricting importation of infringing or counterfeit goods,”<sup>57</sup> and qualifies “for a simplified process for obtaining recognition and protection of his mark in countries that have signed the Paris Convention . . . .”<sup>58</sup> “Lastly, registration operates as a complete defense to state or common law claims of trademark dilution.”<sup>59</sup>

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52. See *Tam En Banc Decision*, 808 F.3d at 1328. Oddly, this key substantive benefit from federal registration is not mentioned in any of the Supreme Court opinions in *Tam*. See *Matal v. Tam*, 137 S. Ct. 1744 (2017).

53. *Tam En Banc Decision*, 808 F.3d at 1328–29 (citing Lanham Act § 7(b)).

54. *Id.* at 1329 (citing Lanham Act § 15); see also *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1310 (2015) (“Incontestability is a powerful protection.”).

55. *Tam En Banc Decision*, 808 F.3d at 1329 (citing Lanham Act § 39).

56. *Id.* (citing Lanham Act § 35).

57. *Id.* (citing Lanham Act § 42).

58. *Id.* (citing Lanham Act § 62; Paris Convention for the Protection of Industrial Property, art. 6 *quinquies*, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305).

59. *Id.* (citing Lanham Act § 43(c)(6)). Moreover, so long as Section 2(a) stands, the value of state law protections for an unregistrable mark such as “The Slants” should not be overstated. It is true that state trademark rights co-exist with the Lanham Act, and can provide a separate source of legal protection for trademarks generally. But the Federal Circuit has observed that “[w]hether a user of an unregistrable, disparaging mark has any enforceable common law rights is at best unclear.” *Id.* at 1344. The Federal Circuit has emphasized, similarly, that most states have adopted trademark registration statutes modelled on the Lanham Act, including its bar on registration of “disparaging” trademarks. See *id.* at 1343–44 (noting that the Model State Trademark Act, which includes a disparagement provision based on the Lanham Act’s Section 2(a), has been adopted by “virtually all states”). The Federal Circuit also raised questions as to whether the Lanham Act’s federal cause of action for unregistered marks could be utilized by a trademark holder

As this makes clear, the benefits that flow from federal trademark registration are invaluable. Conversely, as recognized by the Federal Circuit, “[d]enial of these benefits creates a serious disincentive to adopt a mark which the government may deem offensive or disparaging.”<sup>60</sup> These realities about trademark law underscore the wisdom of the Federal Circuit in rejecting the view that Section 2(a) does not implicate any free speech rights because the trademark owner can still use the trademark.<sup>61</sup> The benefits attendant to federal registration are extremely valuable, and, as the Supreme Court recognized, the denial of these benefits to an otherwise qualifying trademark creates a burden on speech sufficient to support a free-speech claim.<sup>62</sup>

*C. The Trademark Registry is a Regulation of Commerce*

The final point about trademark registration, which can be obscured by focusing too narrowly on Section 2(a)’s “disparagement” clause, is that this provision is a small part of a larger federal regulatory program designed to regulate the use of marks in the commercial marketplace.<sup>63</sup> In deciding how to characterize trademarks—and whether they should be treated as commercial speech—it is important to understand this broader context.

Congress had two purposes in creating a federal registry for trademarks in the Lanham Act. First, the Act was intended to “protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get.”<sup>64</sup> Second, the Lanham Act was enacted to ensure that a trademark owner

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whose mark was rejected from registration because it “disparaged” a particular ethnic group. *See id.* at 1344–45 n.11.

60. *Id.* at 1341.

61. *Id.* at 1345.

62. *See Matal v. Tam*, 137 S. Ct. 1744, 1753 (2017) (noting that federal registration “confers important legal rights and benefits on trademark owners who register their marks”).

63. *See, e.g., Tam Panel Decision*, 785 F.3d 567, 581 (Fed. Cir. 2015) (explaining that “the trademark registration scheme is a prototypical example of a regulatory regime”).

64. *Tam En Banc Decision*, 808 F.3d at 1328 (quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 782 n.15 (1992) (quoting S. REP. NO. 791333, at 3 (1946))).

“can protect his ‘investment from . . . misappropriation by pirates and cheats.”<sup>65</sup>

As the legislative history makes clear, both statutory goals behind the Lanham Act’s trademark registration scheme were market-oriented, with one goal focused on supporting consumer choice, and the other on protecting trademark owners’ investments.<sup>66</sup> This dual focus is not surprising, given that the Lanham Act was enacted under the congressional authority granted by the Commerce Clause,<sup>67</sup> and was consciously intended to help protect the “free flow of commerce.”<sup>68</sup>

This point is important for free speech purposes because it ties directly to the debate in *Matal v. Tam* over free speech rights in the context of commercial speech. While Simon Tam expressed a wish to make a political statement with his choice of “The Slants” as his band name,<sup>69</sup> the registration of that name as a trademark has a different function.

To be eligible for federal registration, a trademark must be a brand name, and not simply a political statement.<sup>70</sup> A message on a bumper sticker would not, for example, be a “trademark” that could be registered.<sup>71</sup> Instead, the trademark would have to be the

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65. *Id.* (quoting *Two Pesos, Inc.*, 505 U.S. at 782 n.15 (quoting S. REP. NO. 791333, at 3 (1946))); *see also* *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 854–56 n.14 (1982) (“By applying a trademark to goods produced by one other than the trademark’s owner, the infringer deprives the owner of the goodwill which he spent energy, time, and money to obtain . . . [a]t the same time, the infringer deprives consumers of their ability to distinguish among the goods of competing manufacturers.”).

66. *See, e.g.*, *Park’n Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) (“The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.”).

67. *See, e.g.*, *Tam En Banc Decision*, 808 F.3d at 1354 (emphasizing that “the Lanham Act derives from the Commerce Clause”).

68. *Matal v. Tam*, 137 S. Ct. 1744, 1752 (2017).

69. *See, e.g.*, *Tam En Banc Decision*, 808 F.3d at 1328 (“Mr. Simon Shiao Tam named his band THE SLANTS to make a statement about racial and cultural issues in this country.”). Interestingly, in the administrative proceeding before the USPTO, Mr. Tam denied any intent to express a political view, and took the position that “the mark does not refer to people of Asian descent.” *Tam Panel Decision*, 785 F.3d 567, 570 (Fed. Cir. 2015).

70. *See, e.g.*, *In re Thomas J. Hulting d/b/a No More RINOs! Enterprises*, 107 U.S.P.Q.2d (BNA) 1175, 1177 (T.T.A.B. 2013).

71. *Id.* (concluding that the trademark registration should be refused where applicant’s proposed “No More RINOs!” mark on t-shirts and bumper

*brand name* under which a particular line of bumper stickers is sold. Mr. Tam may have had politics in mind when choosing his band name, but federal trademark registration would not be available at all if he were simply seeking to make a political statement.

In short, while there is a political component to the band's name, Mr. Tam did not bring suit here objecting to the denial of a permit for his band to play in a public park because of their message, or raising another traditional free speech issue.<sup>72</sup> Instead, this case involved his wish to register "The Slants" as a federal trademark for his band.<sup>73</sup> This presents more complex constitutional questions, not because it makes Section 2(a) any more appropriate as a government regulation, but because the issue arises in the context of a broad federal trademark scheme designed to regulate commercial activity.

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With these basic trademark principles in mind, a better understanding of the Supreme Court's decision in *Matal v. Tam* should be possible. We turn, first, to the areas in which the Court agreed on the application of free speech principles.

## II. AREAS OF CONSTITUTIONAL AGREEMENT IN *MATAL V. TAM*

With the Federal Circuit's change of constitutional course in *In re Tam*,<sup>74</sup> the stage was set for the Supreme Court to decide whether to take up the issue. The Federal Circuit's ruling striking down Section 2(a)'s disparagement clause on free speech grounds created a circuit split, if a technical one, with the Fifth Circuit.<sup>75</sup>

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stickers, signifying "No Republicans In Name Only," "conveys a political slogan devoid of sourceidentifying [sic] significance and therefore fails to function as a trademark.").

<sup>72</sup> See *Tam*, 137 S. Ct. at 1751.

<sup>73</sup> *Id.*

<sup>74</sup> *Tam En Banc Decision*, 808 F.3d 1321, 1357–58 (Fed. Cir. 2015).

<sup>75</sup> See *Test Masters Educ. Servs., Inc. v. Singh*, 428 F.3d 559, 578 n.9 (5th Cir. 2005) (rejecting the trademark applicant's argument "that prohibiting him from registering a mark with the PTO violates his first amendment rights" (citing *In re Mavety Media Grp.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994)). This is more of a "technical" split because the Fifth Circuit's decision did not contain any significant discussion of the First Amendment issue, but simply followed the earlier Federal Circuit position in *In re McGinley* on the constitutionality

Moreover, another case involving the same issue was proceeding through the federal court system at the same time as “The Slants” litigation, this one involving the trademarked team name of the Washington Redskins professional football team.<sup>76</sup> The Washington Redskins had faced a number of legal challenges seeking to cancel their trademark registration for the “Redskins.”<sup>77</sup> After successfully defeating such challenges over a two-decade period, the Redskins suffered a serious legal setback in 2014, when the USPTO cancelled the trademark registration for the Redskins team name on the ground that it was “disparaging” to Native Americans.<sup>78</sup> The team appealed to the federal district court.<sup>79</sup> In another legal setback for the team, the federal district judge first ruled that “Section 2(a) . . . does not implicate the First Amendment”<sup>80</sup> and, second, affirmed the agency’s finding that the team name was disparaging.<sup>81</sup> The Redskins case was on appeal to the Fourth Circuit at the very time that the *Matal v. Tam* case arrived at the Supreme Court.<sup>82</sup>

Adding to the likelihood of convincing the Supreme Court to take the case, the *Matal v. Tam* case presented alluring and interesting issues that implicated free speech, civil rights, and trademark law.<sup>83</sup> The particular type of “disparagement” in the

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of the “disparagement” clause. See 660 F.2d 481, 484 (C.C.P.A. 1981).

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

77. See, e.g., *id.*; *Pro-Football, Inc. v. Blackhorse*, 62 F. Supp. 3d 498 (E.D. Va. 2014); *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d (BNA) 1080 (T.T.A.B. 2014); *Pro-Football, Inc. v. Harjo*, 565 F.3d 880 (D.C. Cir. 2009) (cert. denied); *Pro-Football, Inc. v. Harjo*, 415 F.3d 44 (D.C. Cir. 2005); *Pro-Football, Inc. v. Harjo*, 567 F. Supp. 2d 46 (D.D.C. 2008); *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96 (D.D.C. 2003).

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

79. *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015), *reversed and remanded by Pro-Football, Inc. v. Blackhorse*, 709 Fed. App’x 182 (4th Cir. 2018) (mem) .

80. *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. at 448.

81. *Id.* at 490 (affirming the agency’s cancellation of the Redskins trademark as “disparaging” to Native Americans).

82. In fact, the Redskins lawyers took the unusual step of seeking certiorari in the Supreme Court *before* the Fourth Circuit had ruled, but were rebuffed by the Court. *Matal v. Tam*, 137 S. Ct. 1744 (2017); *Pro-Football, Inc. v. Blackhorse*, 137 S. Ct. 44 (2016).

83. See *Tam*, 137 S. Ct. at 1751.

*Matal v. Tam* case<sup>84</sup>—disparagement based on animosity to racial groups—excited public debate, and the basic legal questions presented were both interesting and challenging. Does the federal government really have to register trademarks that may contain vile racial epithets? Do such trademarks even enjoy free speech protection? And if they do, are there government interests that justify denying registration to such marks? Civil rights groups could not imagine that the government had to register such offensive trademarks. Constitutional scholars, on the other hand, perceived the case as a clear free speech issue.

The Supreme Court granted certiorari, and, as noted, numerous *amici* filed supporting and opposing briefs. By the time the Court issued its opinion in June of 2017, the many pages of ink spilled by the parties and *amici* in trying to illuminate the Supreme Court far exceeded the relatively short and splintered opinions issued by the voting Justices. The common ground among these opinions is explored more fully below. The points of constitutional dispute are specifically explored in Part III.

*A. The Court's Unanimous Judgment: Section 2(a) Infringes Free Speech*

*Matal v. Tam* generated three separate opinions, authored, respectively, by Justice Alito,<sup>85</sup> Justice Kennedy,<sup>86</sup> and Justice Thomas.<sup>87</sup> While disagreeing on core aspects of the First Amendment rationale, all participating Justices agreed on a bottom-line judgment: “[T]he disparagement clause violates the Free Speech Clause of the First Amendment.”<sup>88</sup> Justice Alito

84. *Id.* at 1753–57.

85. *See id.* at 1751. Justice Alito’s opinion was joined in its entirety by Chief Justice Roberts and Justice Breyer. *Id.* Justice Thomas joined all of Justice Alito’s opinion, except Part II, which addressed an issue of statutory interpretation that he believed had not been preserved for appeal. *Id.* at 1769 (Thomas, J., concurring). Parts III-B, III-C, and IV of Justice Alito’s opinion generated, at most, only four votes, and therefore, represent a plurality opinion. *See id.* at 1751.

86. *See id.* at 1765 (Kennedy, J., concurring). Justices Ginsburg, Sotomayor, and Kagan joined Justice Kennedy’s concurring opinion. *Id.*

87. *See id.* at 1769 (Thomas, J., concurring).

88. *Id.* at 1765 (Alito, J.) (plurality opinion) (holding that the “disparagement clause violates the Free Speech Clause of the First Amendment”).

commanded unanimity in stating the judgment of the Court. Holistically, the Court concluded that the Free Speech Clause does not permit the government to refuse registration to “disparaging” trademarks.<sup>89</sup>

But while all of the Justices agreed as to *how* the case should come out, there was much less agreement as to *why* it should come out that way, though there were some areas of common ground. Justice Alito’s basic description of the facts and summary of the benefits of trademark registration were joined by all Justices.<sup>90</sup> Likewise, all except Justice Thomas joined Justice Alito’s statutory analysis that the term “disparag[ing] to . . . ‘persons’” was correctly read, as a matter of statutory interpretation, to authorize the agency to refuse registration to trademarks disparaging to racial and ethnic groups.<sup>91</sup>

Parsing the different opinions in *Matal v. Tam*, three other basic areas of common ground emerge with respect to free speech. The Justices agreed, in sum, that: *first*, Section 2(a)’s disparagement clause is a viewpoint-based restriction on speech;<sup>92</sup> *second*, viewpoint-based government burdens on speech presumptively violate the First Amendment;<sup>93</sup> and *third*, Section 2(a) cannot be saved by classifying registered trademarks as government speech—which is not subject to viewpoint discrimination restrictions—since trademarks are clearly private.<sup>94</sup>

#### B. Section 2(a) is a Viewpoint-Based Restriction on Speech

All of the Justices agreed, as noted, that the provision of Section 2(a), which allowed the government to refuse registration of a trademark that “disparages” particular persons or groups,

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89. See *id.* at 1751 (Alito, J.) (majority opinion); see also *id.* at 1765 (Kennedy, J., concurring); *id.* at 1769 (Thomas, J., concurring).

90. See *id.* at 1751–55 (Alito, J.) (majority opinion) (laying out the basic framework of trademark law and the sequence of events in the case).

91. See *id.* at 1755–57 (rejecting the argument by Tam that the term “persons” in Section 2(a) means only “natural and juristic” persons and does not extend to racial or ethnic groups). Justice Thomas did not reach this issue on the grounds that it was not preserved for appeal. See *supra* note 85.

92. See *infra* Section II.B.

93. See *infra* Section II.C.

94. See *infra* Section II.D.

constitutes viewpoint discrimination—a government restriction that seeks to suppress speech because of its message.<sup>95</sup>

The government had argued that the statute did not discriminate based on viewpoint because it treated all “disparaging” trademarks equally—that is, it applied “equally to marks that damn Democrats and Republicans, capitalists and socialists.”<sup>96</sup> The Court rightfully rejected this.<sup>97</sup> As Justice Alito observed, “[g]iving offense is a viewpoint.”<sup>98</sup> Indeed, the agency’s record of unequal implementation of Section 2(a) provides ample proof of this.<sup>99</sup>

In this case, for example, the agency refused to register “The Slants” because the agency found the mark “disparaging” to persons of Asian descent.<sup>100</sup> Yet the agency had granted trademark registration to marks laudatory of the cultural qualities of Asians, including such marks as “Asian Efficiency” and “Celebrasians.”<sup>101</sup> In the same vein, the agency rejected registration for the trademark “Stop the Islamisation of America” while allowing registration for the culturally positive trademarks “Think Islam” and “New Islam Cool.”<sup>102</sup> It has likewise denied registration to the derogatory trademark “Heeb” but allowed registration for “Jewishstar.”<sup>103</sup>

Allowing trademarks that praise a group, but not those that disparage the same group, clearly constitutes viewpoint discrimination. A compelling example was provided by Justice Kennedy’s observation that, under the government’s logic, “a law would be viewpoint neutral even if it provided that public officials could be praised but not condemned.”<sup>104</sup> Such provisions strike at the heart of the free speech guarantee.

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95. See *Tam*, 137 S. Ct. at 1763 (Alito, J.) (plurality opinion).

96. *Id.*; see also *id.* at 1766 (Kennedy, J., concurring) (“To prohibit all sides from criticizing their opponents makes a law more viewpoint based, not less so.”).

97. See *id.* at 1763 (Alito, J.) (plurality opinion).

98. *Id.* at 1763.

99. See *id.* at 1756–57 (Alito, J.) (majority opinion).

100. *Id.* at 1754.

101. *Tam En Banc Decision*, 808 F.3d 1321, 1336 (Fed. Cir. 2015).

102. *Id.* at 1336–37.

103. *Id.*

104. *Tam*, 137 S. Ct. at 1766 (Kennedy, J., concurring).

*C. Viewpoint-Based Restrictions on Speech Violate the First Amendment*

All of the Justices agreed, as well, that viewpoint discrimination is a particularly pernicious type of government regulation of speech that is presumptively unconstitutional under the Free Speech Clause.<sup>105</sup> The opinions of both Justice Alito and Justice Kennedy are on unshakable constitutional ground in these conclusions.<sup>106</sup> The Supreme Court has repeatedly held that when the government targets not subject matter, but the “particular views taken by speakers on a subject, the violation of the First Amendment is all the more blatant.”<sup>107</sup>

Justice Alito’s opinion is replete with emphatic statements to this effect.<sup>108</sup> It is, he says, a “bedrock First Amendment principle” that speech “may not be banned on the ground that it expresses ideas that offend.”<sup>109</sup> The Supreme Court, he notes, has said “time and again that ‘the public expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers.’”<sup>110</sup> Likewise, the “First Amendment forbids the government to regulate speech in ways that favor some viewpoints or ideas at the expense of others.”<sup>111</sup>

The plurality opinion of Justice Kennedy makes the same point in terms that are only slightly more qualified.<sup>112</sup> With narrow exceptions, he notes, it is a “fundamental principle” of the First Amendment that “the government may not punish or suppress speech based on disapproval of the ideas or perspectives the speech conveys.”<sup>113</sup> Viewpoint-based discrimination is “a form of speech

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105. *Id.*

106. *See id.* at 1763, 1766 (Alito, J.) (plurality opinion).

107. *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995).

108. *See Tam*, 137 S. Ct. at 1751, 1757 (Alito, J.) (majority opinion); *id.* at 1763 (Alito, J.) (plurality opinion).

109. *Id.* at 1751 (Alito, J.) (majority opinion).

110. *Id.* at 1763 (Alito, J.) (plurality opinion) (quoting *Street v. New York*, 394 U.S. 576, 592 (1969)).

111. *Id.* at 1757 (Alito, J.) (majority opinion) (quoting *Lamb’s Chapel v. Ctr. Moriches Union Free Sch. Dist.*, 508 U.S. 384, 394 (1993)).

112. *See id.* at 1765–66 (Kennedy, J., concurring).

113. *Id.* at 1765 (citing *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515

suppression so potent that it must be subject to rigorous constitutional scrutiny.”<sup>114</sup> A law that is found to discriminate based on viewpoint is an “egregious” form of content discrimination that is “presumptively unconstitutional.”<sup>115</sup>

The Justices agreed, as well, that it is of no constitutional significance that, under Section 2(a), registration is denied not because the *government* disapproves of the message expressed by the trademark, but because *other citizens* are offended.<sup>116</sup> As Justice Kennedy emphasized, “[t]he Government may not insulate a law from charges of viewpoint discrimination by tying censorship to the reaction of the speaker’s audience.”<sup>117</sup> Rather, the government engages in unlawful suppression of speech when it allows the opposition of other citizens to be used as a justification for banning or burdening speech. The government could not, for example, deny a permit for a parade by unpopular speakers on the ground that the parade will create a safety hazard by drawing crowds hostile to the speakers’ message.<sup>118</sup> The Court’s precedents, in Justice Kennedy’s words, have “long prohibited the government from justifying a First Amendment burden by pointing to the offensiveness of the speech to be suppressed.”<sup>119</sup>

That the Justices would agree on these points is scarcely surprising, given that viewpoint-based government restrictions on speech go to the heart of the First Amendment’s basic purpose. It is a constitutional fundamental that the First Amendment “was fashioned to assure unfettered interchange of ideas” in public

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U.S. 819, 828–29 (1995)).

114. *Id.*

115. *Id.* (quoting *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2230 (2015)).

116. *Id.* at 1763 (Alito, J.) (plurality opinion) (emphasizing that the government may not prohibit “the public expression of ideas . . . merely because the ideas are themselves offensive to some of their hearers” (quoting *Street v. New York*, 394 U.S. 576, 592 (1969))).

117. *Id.* at 1766 (Kennedy, J., concurring); *see also id.* at 1767 (“[A] speech burden based on audience reactions is simply government hostility and intervention in a different guise.”).

118. *See, e.g., Forsyth Cty., Ga. v. Nationalist Movement*, 505 U.S. 123, 134–35 (1992) (finding parade regulations that conditioned permit fees on anticipated crowds a content-based restriction on speech: “Speech cannot be financially burdened, any more than it can be punished or banned, simply because it might offend a hostile mob.”).

119. *Tam*, 137 S. Ct. at 1767 (Kennedy, J., concurring).

debate.<sup>120</sup> That guarantee is gravely threatened whenever the government is allowed to censor or discourage the expression of particular viewpoints in that debate.<sup>121</sup>

*D. Trademarks are Private Speech, Not Government Speech*

Finally, all of the Justices also agreed that the key circumstance in which viewpoint discrimination is permissible is not present here—where the speech at issue constitutes government or government-sponsored speech instead of speech by a private citizen.<sup>122</sup> It is well-established that “[t]he Free Speech Clause . . . does not regulate government speech.”<sup>123</sup> First Amendment law recognizes, sensibly, that when the government itself speaks, it may selectively choose its message without running afoul of the constitutional bar on viewpoint discrimination.<sup>124</sup>

The government may, and should, engage in speech that expresses a specific viewpoint. Indeed, this is essential to governing. Justice Alito gave a simple example: When the government, in World War II, produced and distributed millions of posters to support the war effort by urging citizens to enlist, buy war bonds, and save scarce resources, “the First Amendment did not demand that the Government balance the message” by producing posters urging citizens *not* to enlist and *not* to support the war effort.<sup>125</sup> More broadly, the government necessarily endorses a particular viewpoint whenever it launches a policy initiative, proposes a regulation, submits legislation to Congress, issues an Executive order, or takes any of the many actions involved in the process of governing.<sup>126</sup>

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120. *Legal Servs. Corp. v. Velazquez*, 531 U.S. 533, 548 (2001) (quoting *New York Times Co. v. Sullivan*, 376 U.S. 254, 269 (1964)).

121. *See, e.g., Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995) (noting that government discrimination against speech based on the “opinion or perspective of the speaker” is a “more blatant” and “egregious form of content discrimination”); *see also Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2230 (2015) (to same effect).

122. *Tam*, 137 S. Ct. at 1765 (Kennedy, J. concurring); *id.* at 1769 (Thomas, J., concurring); *id.* at 1758, 1760 (Alito, J.) (majority opinion).

123. *Id.* at 1757 (Alito, J.) (majority opinion) (quoting *Pleasant Grove City v. Summum*, 555 U.S. 460, 467 (2009)).

124. *Id.*

125. *Id.* at 1758.

126. *See, e.g., id.* at 1757 (“When a government entity embarks on a course

At times, in a case that ostensibly implicates private speech, one side will argue that the message of a private speaker should instead be treated as government speech because the government has adopted or endorsed that message. The determinative constitutional question then becomes whether to classify the expression at issue as government speech or private speech. By labelling a particular mode of expression as government speech, the Supreme Court has at times been able to sidestep addressing the merits of a Free Speech challenge.<sup>127</sup> But these “government speech” cases are challenging to summarize, and tend to present idiosyncratic fact patterns.

It is established, for example, that the government may adopt or endorse private speech to express its own message.<sup>128</sup> The government may also speak by “recruiting others to communicate a message on its behalf.”<sup>129</sup> In such instances, the speech will be treated as the government’s own statement. The Supreme Court has emphasized, in this regard, that the government “is entitled to say what it wishes” when it uses private speakers to transmit specific information pertaining to a government program.<sup>130</sup>

The Court has shown some inclination in recent years to expand its “government speech” doctrine,<sup>131</sup> and the rationale has

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of action, it necessarily takes a particular viewpoint and rejects others.”); *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2246 (2015) (“[A]s a general matter, when the government speaks it is entitled to promote a program, to espouse a policy, or to take a position.”).

127. See, e.g., *Johanns v. Livestock Mktg. Ass’n*, 544 U.S. 550, 553 (2005) (concluding that, in constitutional challenge to government-funded advertising for the beef industry, “the dispositive question is whether the generic advertising at issue is the Government’s own speech and therefore is exempt from First Amendment scrutiny”).

128. See, e.g., *Pleasant Grove City, Utah v. Summum*, 555 U.S. 460, 472 (2009) (holding that when the City accepted donated monuments to erect in a public park, it was engaged in government speech and did not create a public forum open to other private monuments).

129. See *Tam*, 137 S. Ct. at 1768 (Kennedy, J., concurring) (discussing case law).

130. See *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 833 (1995) (describing the Court’s holding in *Rust v. Sullivan*, 500 U.S. 173, 184–87 (1991), which upheld the constitutionality of a provision that banned groups receiving federal funding for a family planning program from discussing abortion with their clients in the program).

131. Compare *Johanns*, 544 U.S. at 562 (treating as government speech a generic advertising campaign promoting the beef industry financed under a federal program), with *United States v. United Foods, Inc.*, 533 U.S. 405, 409–

been increasingly invoked by litigants in free speech challenges.<sup>132</sup> At the same time, all voting Justices in *Matal v. Tam* recognized the danger of applying the Court's "government speech" precedents too broadly.<sup>133</sup>

The question here, in essence, was whether registering trademarks in an official federal registry gives such trademarks the imprimatur of government approval, so as to turn them into a type of "government speech."<sup>134</sup> The Justices unanimously answered this question "no."<sup>135</sup> Applying the "government speech" precedents in the trademark context, the Court concluded that merely registering a private trademark does not turn that mark into "government speech."<sup>136</sup> As Justice Alito emphasized, the government does not endorse the message of any given trademark by placing it on the federal trademark register.<sup>137</sup>

This is clearly correct. Registration simply acts as notice to the public that the trademark has met certain legal requirements as a source-identifier for the trademark owner's goods or services and is owned by a particular company. The USPTO, the government agency charged with the trademark registration process, has expressly stated that the issuance of a trademark registration "is not a government imprimatur."<sup>138</sup>

The "government speech" precedent most heavily relied upon by the government here was the Supreme Court's recent decision in *Walker v. Texas Division, Sons of Confederate Veterans*,<sup>139</sup>

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17 (2001) (treating as private speech a generic advertising campaign promoting the mushroom industry financed under a similar government program).

132. *Tam*, 137 S. Ct. at 1757 (Alito, J.) (majority opinion).

133. *Id.* at 1758 ("[W]e must exercise great caution before extending our government-speech precedents."); *id.* at 1768 (Kennedy, J., concurring) (emphasizing that the government-speech exception is "narrow, to prevent the government from claiming that every government program is exempt from the First Amendment").

134. *Id.* at 1757 (Alito, J.) (majority opinion).

135. *Id.* at 1759; *id.* at 1765 (Kennedy, J., concurring); *id.* at 1769 (Thomas, J., concurring).

136. *Id.* at 1758–60 (Alito, J.) (majority opinion).

137. *See id.* at 1758 (noting that the trademark examiner "does not inquire whether any viewpoint conveyed by a mark is consistent with Government policy").

138. *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1220 n.3 (T.T.A.B. 1993); *see also Tam*, 137 S. Ct. at 1759 ("The PTO has made it clear that registration does not constitute approval of a mark.").

139. *Tam*, 137 S. Ct. at 1760.

upholding a Texas law that allows the State broad discretion as to when to issue “specialty license plates” that include a private group’s message in addition to the usual contents of the license plate, such as the plate number and State.<sup>140</sup> The law gave Texas officials broad power to grant or deny private petitions proposing specialty license plates, including the power to reject a petition if the proposed design “might be offensive to any member of the public.”<sup>141</sup>

Notwithstanding the inclusion of a private group’s message, the Supreme Court held in *Walker* that the specialty license plates were government speech.<sup>142</sup> The private designs accepted by the State were placed on “government-mandated, government-controlled, and government-issued” vehicle identification plates and were “meant to convey and have the effect of conveying a government message.”<sup>143</sup> Because the Court found that the case involved government speech, Texas could properly decide to endorse some groups’ messages and to decline to endorse other messages that could be “offensive.”<sup>144</sup>

The Court in *Matal v. Tam* had little difficulty distinguishing the *Walker* precedent.<sup>145</sup> Justice Alito found it “far-fetched” in the context of the federal trademark registration scheme to “suggest that the content of a registered mark is government speech.”<sup>146</sup> If a registered trademark is government speech, he observed, one would be forced to conclude that the federal government is “babbling prodigiously and incoherently,” saying “many unseemly things,” expressing “contradictory views,” and “unashamedly

140. *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2244–45 (2015) (regarding Texas’s rejection of a proposed license plate design that would have included the confederate flag and the words “Sons of Confederate Veterans” and providing other examples of approved specialty license plates including: the Florida Gators sports team’s logo and the statement “The Gator Nation,” and the Rotary International logo and the words, “SERVICE ABOVE SELF”).

141. *Id.*

142. *Id.* at 2246.

143. *Id.* at 2250.

144. *See id.* at 2246 (emphasizing that “as a general matter, when the government speaks it is entitled to promote a program, to espouse a policy, or to take a position”).

145. *Matal v. Tam*, 137 S. Ct. 1744, 1760 (2017).

146. *Id.* at 1759 (“None of our government speech cases even remotely supports the idea that registered trademarks are government speech.”).

endorsing a vast array of commercial products and services.”<sup>147</sup> As Justice Alito bluntly summed up, “[t]rademarks are private, not government, speech.”<sup>148</sup>

Looking to the federal trademark scheme, this was clearly the only defensible conclusion.<sup>149</sup> When the government accepts Nike’s trademarked slogan for trademark registration, the government is obviously not trying to adopt that slogan and tell American citizens to “Just do it.”<sup>150</sup> Instead, federal registration simply serves as nationwide notice to the public and competing businesses that Nike—a private company—has properly staked out that slogan as a mark for sales of its own commercial line of sports products.<sup>151</sup>

In short, the Court recognized in *Matal v. Tam* that a trademark is private speech before it is registered, and the fact that it has been included in a government database does not change that conclusion.<sup>152</sup> Under the government’s proposed rationale, Justice Alito emphasized, any copyrighted book or article would be stripped of constitutional free speech protections whenever its author took steps to protect his copyright by federally registering the work.<sup>153</sup> Moreover, there are a plethora of government registration schemes.<sup>154</sup> Thus, to hold that a program for governmental

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147. *Id.* at 1758.

148. *Id.* at 1760.

149. *See* 15 U.S.C. § 1051 (2002).

150. *Tam*, 137 S. Ct. at 1759 (posing the question, “if trademarks represent government speech, what does the Government have in mind when it advises Americans to ‘make.believe’ (Sony), ‘Think different’ (Apple), ‘Just do it’ (Nike), or ‘Have it your way’ (Burger King)? Was the Government warning about a coming disaster when it registered the mark ‘EndTime Ministries?’” (footnotes omitted)).

151. *Tam En Banc Decision*, 808 F.3d 1321, 1346–47 (Fed. Cir. 2015) (noting that “the PTO routinely registers marks that no one can say the government endorses, [such as] RADICALLY FOLLOWING CHRIST IN MISSION TOGETHER, . . . THINK ISLAM, . . . GANJA UNIVERSITY, . . . CAPITALISM SUCKS DONKEY BALLS, . . . TAKE YO PANTIES OFF, . . . and MURDER 4 HIRE . . .” (citations omitted)).

152. *Tam*, 137 S. Ct. at 1760 (“Trademarks are private, not government, speech.”).

153. *See id.* at 1760 (“If federal registration makes a trademark government speech and thus eliminates all First Amendment protection, would the registration of the copyright for a book produce a similar transformation?”).

154. *See id.* at 1761 (“Trademark registration is not the only government registration scheme. For example, the Federal Government registers copyrights and patents. State governments and their subdivisions register the

registration turns a private party's speech into government speech would give the government, Justice Alito emphasized, sweeping powers to "silence or muffle the expression of disfavored viewpoints."<sup>155</sup>

While it may resonate emotionally to argue that the government should not have to accept offensive and racially derogatory trademarks and slogans for federal registration, the Court was correct in its conclusion that the government is not "speaking" or endorsing the messages expressed by offensive trademarks merely by accepting those trademarks for registration.<sup>156</sup>

From the discussion above, it might seem that the Court was in broad agreement as to the constitutional free speech issue presented by *Matal v. Tam*, but the remainder of the opinions belie this impression. When it came to the final step of the free speech analysis—scrutinizing the reasons offered by the government to support the speech restriction—the Court lost their consensus.<sup>157</sup>

### III. AREAS OF CONSTITUTIONAL DISPUTE IN *MATAL V. TAM*

Oddly, although all voting Justices found that Section 2(a)'s "disparagement" provision violated the Free Speech Clause, the Court could not agree on the proper constitutional analysis. While all Justices agreed that the law was a viewpoint-based restriction on private speech, the Justices could not reach agreement on another free speech issue: should the restriction on trademarks at issue here be analyzed as a government regulation of commercial speech? Or as a government burden on core political speech?<sup>158</sup> The answer to this question dictates how much deference the court will give to the governmental restriction on speech.

The parties were in pointed disagreement as to the proper level

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title to real property and security interests; they issue driver's licenses, motor vehicle registrations, and hunting, fishing, and boating licenses or permits.").

155. *Id.* at 1758.

156. *Id.* at 1760 ("Holding that the registration of a trademark converts the mark into government speech would constitute a huge and dangerous extension of the government-speech doctrine.").

157. *Id.* at 1760–61, 1763, 1766.

158. *See id.* at 1763–64 (Alito, J.) (plurality opinion) (noting that "we must confront a dispute between the parties on the question whether trademarks are commercial speech and are thus subject to the relaxed scrutiny outlined in *Central Hudson Gas & Elec. Corp.*" (citation omitted)).

of scrutiny.<sup>159</sup> The government took the position that “all trademarks are commercial speech,” arguing for a deferential standard of review.<sup>160</sup> Conversely, Mr. Tam took the position that “many, if not all, trademarks have an expressive component,” arguing that stricter scrutiny of the government’s action was required.<sup>161</sup> *Matal v. Tam* did not prove to be a useful vehicle for reaching a thoughtful resolution of this issue.

Ultimately, four Justices concluded that “we need not resolve” this dispute, because the restriction at issue fails even under the more lenient standard of review for restrictions on commercial speech.<sup>162</sup> But four Justices insisted, to the contrary, that even if trademarks are commercial speech, “the viewpoint based discrimination at issue here necessarily invokes heightened scrutiny.”<sup>163</sup> In failing to reach any common ground on the appropriate degree of scrutiny, *Matal v. Tam* highlights a key area of dispute under the First Amendment: the extent to which commercial speech should enjoy free speech protection, and under what constitutional test such challenges should be decided. In this sense, *Matal v. Tam* lies at the cusp of a fundamental but difficult constitutional dispute that has been brewing for some time. While the contours of free speech law applied to traditional, “core” political speech are relatively well-settled, the Supreme Court’s more recent extension of free speech rights to commercial speech has created confusion over the proper scope of this more controversial doctrine, as explained further below.

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159. *Id.*

160. *Id.* at 1764.

161. *Id.*

162. *Id.*; see also *id.* at 1769 (Thomas, J., concurring) (noting that he is joining this aspect of Justice Alito’s opinion because “it correctly concludes that the disparagement clause . . . is unconstitutional even under the less stringent test announced in *Central Hudson Gas & Elec. Corp.*” (citations omitted)).

163. *Id.* at 1767 (Kennedy, J., concurring). Interestingly, while joining Justice Alito’s decision, Justice Thomas also noted his belief that “when the government seeks to restrict truthful speech in order to suppress the ideas it conveys, strict scrutiny is appropriate, whether or not the speech in question may be characterized as ‘commercial.’” See *id.* at 1768 (Thomas, J., concurring) (quoting *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 572 (2001) (Thomas, J., concurring)). Arguably, therefore, a majority of Justices agreed that “strict scrutiny” should be applied here.

A. *The (Relatively) Clear Contours of Traditional Free Speech Doctrine*

The traditional arena of free speech cases—marches, public protests, political speeches, and the like—had led to a relatively clear and stable understanding of free speech principles among the courts, one that resonated with the courts’ inherent sense of the fundamental purposes of the Free Speech clause.<sup>164</sup>

Consider, for example, the long-established rules on speech in a traditional public forum (a street, park, or the like). Where the government imposes content-based restrictions on speech in a traditional public forum—for example, if the government were to announce that a public park open for private displays generally will be closed to private religious displays—the courts will apply “strict scrutiny.”<sup>165</sup> This means that the courts will uphold such a content-based restriction only if it is “necessary to serve a compelling state interest” and “narrowly drawn to achieve that end” (a notoriously difficult standard to meet).<sup>166</sup> Such actions are closely reviewed because the government is prohibited from censoring particular topics for public debate.

If the government goes further and bars speech based on viewpoint—for example, if the government ban on displays in the private park, posited above, did not extend to all religious displays, but only to displays promoting atheism—the review is further heightened. In the example above, a sign condemning atheists would be permitted, but a sign advocating for atheism would not. This constitutes viewpoint discrimination. When the government imposes a viewpoint-based restriction on private speech, it is treated as an “egregious” form of content-based regulation of

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164. See, e.g., *Carey v. Brown*, 447 U.S. 455, 467 (1980) (noting that public-issue picketing is “an exercise of . . . basic constitutional rights in their most pristine and classic form” and “has always rested on the highest rung of the hierarchy of First Amendment values” (citations omitted)).

165. See, e.g., *Capitol Square Review & Advisory Bd. v. Pinette*, 515 U.S. 753, 761 (1995) (emphasizing that “strict standards” apply when the government seeks to regulate expressive content in a traditional public forum).

166. *Widmar v. Vincent*, 454 U.S. 263, 270 (1981); see also, e.g., *Capitol Square Review & Advisory Bd.*, 515 U.S. at 761 (noting similarly that the government may regulate expressive content in a traditional public forum “only if such a restriction is necessary, and narrowly drawn, to serve a compelling state interest”).

speech, and is reviewed even more strictly.<sup>167</sup> Government restrictions based on the viewpoint expressed by a private speaker are presumptively unconstitutional.<sup>168</sup>

On the other hand, even in a traditional public forum such as a park, the government is well within its rights to enact reasonable content-neutral time, place, and manner restrictions.<sup>169</sup> Such rules command deference, and will be upheld so long as they are truly “content-neutral,” are “narrowly tailored to serve a significant governmental interest,” and “leave open ample alternative channels for communication of the information.”<sup>170</sup>

In these traditional free speech cases, the courts had also developed an orderly set of free speech principles for assessing speech-related regulations in forums that were not traditionally used for speech, but had been set aside by the government for that purpose (“limited public forums”) and on government property more generally (“nonpublic forums”).<sup>171</sup> This relatively stable set of traditional free speech rules was unsettled by a legal movement that decisively emerged around 1980, the year in which the Supreme Court first established a general free speech test applicable to attempts to limit commercial speech, the *Central Hudson Gas* test.<sup>172</sup> The introduction of free speech protections for commercial speech threw a wrench in the works of this relatively orderly and clear system of constitutional free speech analysis.

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167. See, e.g., *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995) (“Viewpoint discrimination is . . . an egregious form of content discrimination.”).

168. See, e.g., *id.* at 829 (“The government must abstain from regulating speech when the specific motivating ideology or the opinion or perspective of the speaker is the rationale for the restriction.”).

169. See, e.g., *Capitol Square Review & Advisory Bd.*, 515 U.S. at 761 (noting that the government may impose reasonable, content-neutral, time, place, and manner restrictions on speech in traditional public forum).

170. *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989).

171. See, e.g., *Perry Educ. Ass’n v. Perry Local Educators’ Ass’n*, 460 U.S. 37, 45–46 (1983) (describing the rules applicable to different types of forums).

172. See *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 566 (1980).

*B. The Slow Development of Commercial Free Speech Rights*

For many years, commercial speech was considered to lie “outside the ambit of the First Amendment,”<sup>173</sup> and thus not entitled to any constitutional protection under the Free Speech clause. It was not until the mid-1970’s that the Supreme Court held that the First Amendment protected the dissemination of truthful and non-misleading commercial messages about lawful products and services.<sup>174</sup> And, as noted, it was not until 1980 that the Supreme Court established a specific constitutional doctrine for assessing the free speech rights for commercial speech.<sup>175</sup>

In the *Central Hudson Gas* case,<sup>176</sup> the Supreme Court articulated its “commercial speech” doctrine. The State of New York had sought to bar any promotional advertising by an electric utility, and the Supreme Court invalidated this bar on free speech grounds.<sup>177</sup> Recognizing that there is a “commonsense’ distinction between speech proposing a commercial transaction, which occurs in an area traditionally subject to government regulation,” and other types of speech,<sup>178</sup> the Court held that the Constitution protects commercial speech but “accords a lesser protection to commercial speech than to other constitutionally guaranteed expression.”<sup>179</sup> The Court went on to lay out a four-part test for determining the constitutionality of restrictions on commercial speech that still governs this area of doctrine today.<sup>180</sup>

173. *Tam Panel Decision*, 785 F.3d 567, 574–75 (Fed. Cir. 2015).

174. See generally Alex Kozinski & Stuart Banner, *The Anti-History and Pre-History of Commercial Speech*, 71 TEX. L. REV. 747, 754–55 (1993); see 44 *Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 496 (1996) (describing the evolution of commercial speech doctrine).

175. See *Central Hudson Gas*, 447 U.S. at 566.

176. *Id.*

177. *Id.* at 558–59, 570.

178. *Id.* at 562.

179. *Id.* at 563.

180. *Id.* at 566 (“In commercial speech cases, then, a four-part analysis has developed. At the outset, we must determine whether the expression is protected by the First Amendment. For commercial speech to come within that provision, it at least must concern lawful activity and not be misleading. Next, we ask whether the asserted governmental interest is substantial. If both inquiries yield positive answers, we must determine whether the regulation directly advances the governmental interest asserted, and whether it is not more extensive than is necessary to serve that interest.”).

The *Central Hudson Gas* formula,<sup>181</sup> which has been applied in cases too numerous to list, has come to be known as the “intermediate scrutiny” test for commercial speech. In applying “intermediate scrutiny,” the courts emphasize that while commercial speech enjoys certain constitutional protections, the leeway for government regulation remains greater in the areas of commercial speech than for other forms of expression.<sup>182</sup> For example, content-based limitations on commercial speech, which would be subject to “strict scrutiny” review in other contexts,<sup>183</sup> may be often permissible when the government is regulating commercial speech.

A government regulation applicable to commercial speech could properly, for example, explicitly target only advertising that markets banking services (a content-based limitation of commercial speech) yet still pass muster under the First Amendment.<sup>184</sup> By contrast, a government regulation that excluded from a traditional public forum any political speech discussing banking would quickly invoke strict scrutiny.<sup>185</sup>

The development of commercial speech doctrine threw a wrench in the works, to begin with, because the proponents of the right depart quite significantly from what the courts have thought of as the “core” of free speech. The traditional free speech plaintiff that comes to mind is a political protestor, not a wealthy corporation.

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<sup>181.</sup> *Id.*

<sup>182.</sup> *See, e.g., Ohralik v. Ohio State Bar Ass’n*, 436 U.S. 447, 456 (1978) (noting that the Court has “afforded commercial speech a limited measure of protection, commensurate with its subordinate position in the scale of First Amendment values, while allowing modes of regulation that might be impermissible in the realm of noncommercial expression.”).

<sup>183.</sup> *See, e.g., United States v. Playboy Entm’t Grp., Inc.*, 529 U.S. 803, 813 (2000) (noting that a content-based speech restriction “can stand only if it satisfies strict scrutiny”).

<sup>184.</sup> *See, e.g., Sorrell v. IMS Health Inc.*, 564 U.S. 552, 579 (2011) (noting that “a State may choose to regulate price advertising in one industry but not in others, because the risk of fraud . . . is in its view greater there.” (citation omitted)).

<sup>185.</sup> *See, e.g., Ohralik*, 436 U.S. at 456 (noting that the Court has “afforded commercial speech a limited measure of protection, commensurate with its subordinate position in the scale of First Amendment values, while allowing modes of regulation that might be impermissible in the realm of noncommercial expression.”).

Even more important, if free speech rights are extended to encompass commercial speech, there are many regulatory schemes that touch on speech but have never been thought of as raising any First Amendment issues that must now be considered. Recognizing free speech protections for “commercial” speech runs head on into the power of Congress to “regulate commerce,” a power that supports the enactment of numerous federal regulatory schemes.<sup>186</sup> Many of these directly or indirectly regulate speech activities.

The challenge is how to recognize appropriate speech rights in the commercial arena without compromising the federal government’s ability to regulate commerce and state governments’ ability to protect public health, safety and welfare. Read too broadly, commercial free speech rights will hamper the government’s ability to engage in regulation in the public interest and encourage legal challenges by regulated industries whenever a regulatory regime threatens to affect speech activities (as is virtually always the case, given the breadth with which “speech” is defined).

It is also notoriously difficult to distinguish “commercial speech” from non-commercial speech. The relatively narrow definition used by the Supreme Court in some of its initial cases defined commercial speech cases as speech “that proposes a commercial transaction.”<sup>187</sup> In the *Central Hudson Gas* case, however, the Court more broadly referred to commercial speech as “expression related solely to the economic interests of the speaker and its audience.”<sup>188</sup> Moreover, even within the narrower category of speech “proposing a commercial transaction,” such speech often includes *both* commercial and expressive components.<sup>189</sup> How should the courts, for example, evaluate a government ban on the distribution of pamphlets by commercial companies that operates to bar the distribution of pamphlets that *both* advertise a particular

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186. U.S. CONST. art. 1, § 8, cl. 3.

187. See, e.g., *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 421 (1993) (explaining that the Court’s early commercial speech cases stand for the proposition that “even speech that does no more than propose a commercial transaction is protected by the First Amendment” (citations omitted)); see also, e.g., *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976).

188. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 561 (1980).

189. *Id.* at 561–62.

company's prophylactics *and* inform the public of the hazards of sexually-transmitted disease? Should this be treated as a restriction on commercial speech or on core political speech?

The debate has tended to devolve into extended debates—as here—on which standard of “scrutiny” should be applied, and which type of speech is at issue, commercial speech or “core” speech. While this may seem technical, the level of scrutiny can be determinative in a First Amendment challenge. There is a common saying—“strict in theory, fatal in fact”—that many argue is an apt description of the “strict scrutiny” standard.<sup>190</sup>

Few government actions reviewed under “strict scrutiny” can provide a justification sufficient to support the restriction on speech. Conversely, the “intermediate scrutiny” test gives far more respect to and leeway for government action in a particular regulatory sphere. In simple terms, while strict scrutiny looks with suspicion on the government's actions, intermediate scrutiny gives the government the benefit of the doubt. Which standard of scrutiny to apply to commercial speech in different settings is a matter of hot debate in the Supreme Court's recent decisions.<sup>191</sup>

### C. *Symptoms of the Commercial Speech Debate in Matal v. Tam*

This simmering debate over commercial speech explains the doctrinal disputes that led the Court in *Matal v. Tam* to splinter over the final step that was needed to reach a unanimous rationale (and not simply a unanimous judgment), on the free speech issue presented<sup>192</sup>—the proper level of scrutiny here.

When Justice Alito turned to the issue, he framed the “debate” between the parties as “whether trademarks are commercial speech” and thus, subject to the “relaxed scrutiny” outlined in

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190. See, e.g., *Adarand Constructors, Inc. v. Peña*, 515 U.S. 200, 237 (1995) (making reference to the notion that “strict scrutiny is ‘strict in theory, but fatal in fact’” while seeking to dispel it).

191. See, e.g., *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 579 (2011) (dispute between majority and dissent over whether strict scrutiny, intermediate scrutiny, or rational basis scrutiny applies in free speech challenge to state law barring the disclosure of physician's drug prescribing data for “marketing” purposes).

192. *Matal v. Tam*, 137 S. Ct. 1744, 1763–64 (2017) (Alito, J.) (plurality opinion).

*Central Hudson Gas*.<sup>193</sup> Without delving into the merits of the parties' arguments, he simply noted that "we need not resolve this debate" because the disparagement clause "cannot withstand even *Central Hudson* review."<sup>194</sup> Justice Alito was joined in this conclusion by three other Justices (Chief Justice Roberts, Justice Breyer, and Justice Thomas).<sup>195</sup>

Justice Kennedy fundamentally disagreed that the legal issue was open.<sup>196</sup> Instead, he insisted, the Court has *already* decided this very issue.<sup>197</sup> According to Justice Kennedy, joined by Justices Ginsburg, Kagan, and Sotomayor, the Supreme Court held two years ago, in *Sorrell v. IMS Health, Inc.*, that "commercial speech is no exception" to the principle that the First Amendment "requires heightened scrutiny whenever the government creates a regulation of speech because of disagreement with the message it conveys."<sup>198</sup> Meanwhile, in the third opinion in *Matal v. Tam*, Justice Thomas joined that part of Justice Alito's opinion, concluding that the Court "need not resolve the debate," *and* expressed separately his agreement with Justice Kennedy on the merits.<sup>199</sup> He

"continue[d]" to adhere to his view that that strict scrutiny is required "when[ever] the government seeks to restrict truthful speech in order to suppress the ideas it conveys," whether or not the speech could be seen as "commercial."<sup>200</sup> (It is possible that Justice Thomas simply did not agree with that part of Justice Kennedy's opinion that insisted that this issue had already been resolved by the Supreme Court's *Sorrell* case.)

And as for the *Sorrell*<sup>201</sup> case? That case can easily be read for both propositions, since it is highly equivocal on whether or not it resolved the issue of viewpoint discrimination directed at

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193. *Id.* at 1763. If his statement that "we need not resolve" this dispute was not noncommittal enough, Justice Alito also expressly emphasizes that his opinion "leave[s] open the question whether *Central Hudson* provides the appropriate test for deciding free speech challenges to provisions of the Lanham Act." *Id.* at 1764 n.17.

194. *Id.* at 1764.

195. *Id.* at 1751 (Alito, J.) (majority opinion).

196. *Id.* at 1767 (Kennedy, J., concurring).

197. *Id.*

198. *Id.* (quoting *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566 (2011)).

199. *Id.* at 1769 (Thomas, J., concurring).

200. *Id.*

201. *Sorrell*, 564 U.S. at 552.

commercial speech.<sup>202</sup> In *Sorrell*, the Supreme Court considered a complex state law directed to “data mining” in the pharmaceutical industry that barred pharmacies from selling information about physicians’ patterns of prescribing drugs, without their consent, for marketing purposes.<sup>203</sup> While the law barred data sharing with for-profit drug companies, it included an exception that allowed data sharing with private and academic researchers.<sup>204</sup>

The Court held that that law on its face was both “content-based” (directed at marketing) and “speaker-based” (directed at drug companies).<sup>205</sup> It also held that, “in practice,” the law was viewpoint-based, since the drug companies barred from getting the information were all seeking it in order to convince the targeted doctors to buy their branded drugs.<sup>206</sup>

In one part of the *Sorrell* opinion, the Court did state, as Justice Kennedy invokes, that because the law is “designed to impose a specific, content-based burden on protected expression,” it “follows that heightened judicial scrutiny is warranted.”<sup>207</sup> In the same discussion, the Court also said that “[t]he First Amendment requires heightened scrutiny whenever the government creates ‘a regulation of speech because of disagreement with the message it conveys,’”<sup>208</sup> and that “[c]ommercial speech is no exception.”<sup>209</sup> The Court concluded this discussion by stating that the Vermont law at issue “imposes a speaker- and content-based burden on protected expression, and that circumstance is sufficient to justify application of heightened scrutiny.”<sup>210</sup>

Confusingly, however, this discussion was immediately followed by the Court’s statement in *Sorrell* that there was “no need

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202. *See id.* at 571.

203. *Id.* at 558–59.

204. *Id.* at 559–60.

205. *Id.* at 563–64.

206. *Id.* at 578–79. By contrast, the law did not bar public interest groups who wish to contradict the drug companies’ messages from getting the information. *See id.* at 564 (noting that it “appears that Vermont could supply academic organizations with prescriber-identifying information to use in countering the messages of brand-name pharmaceutical manufacturers and in promoting the prescription of generic drugs.”).

207. *Id.* at 565.

208. *Id.* at 566 (quoting *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1981)).

209. *Id.*

210. *Id.* at 571.

to determine” whether the speech affected by the law is commercial, since the “outcome is the same” whether strict or intermediate scrutiny is applied.<sup>211</sup> The Court went on to apply the commercial speech test under *Central Hudson Gas*, before concluding that the law failed intermediate scrutiny.<sup>212</sup>

In addition, while the Court mentioned that the law was “in practice” viewpoint-based, its express holdings appear to be limited to the aspects of the law that were content- and speaker-based.<sup>213</sup> Thus, this case has been interpreted as leaving *open* the viewpoint-discrimination issue for which Justice Kennedy cited it.<sup>214</sup> While it is not surprising that the Justices could not agree on the significance of the *Sorrell* decision, it is notable that Justice Alito’s decision does not even respond to Justice Kennedy’s point.<sup>215</sup>

In short, because the Justices in *Matal v. Tam* were unable to agree on the proper treatment of commercial speech in this context—or to settle on a single standard of scrutiny—the case produced no single opinion for the Court laying out a clear constitutional rationale.<sup>216</sup>

#### IV. THE MOST COHERENT APPROACH TO FREE SPEECH IN THIS SETTING

This legal background, described above, explains why a case involving a little-known band and an obscure provision of trademark law should generate so much interest among *amici* from the Chamber of Commerce, to Pro-Football, to the ACLU. Yet, ultimately, the Supreme Court did not advance the ongoing debate over commercial speech in any meaningful way in its decision in

211. *Id.* (noting that the “State argues that a different analysis applies here because, assuming § 4631(d) burdens speech at all, it at most burdens only commercial speech. As in previous cases, however, the outcome is the same whether a special commercial speech inquiry or a stricter form of judicial scrutiny is applied.”).

212. *Id.* at 572–79.

213. *See id.* at 588 (Kennedy, J., dissenting) (interpreting the majority opinion to say “that we must give *content-based* restrictions that burden speech ‘heightened’ scrutiny” and that “[c]ommercial speech is noexception”).

214. *See, e.g., Tam Panel Decision*, 785 F.3d 567, 582 (Fed. Cir. 2015) (Moore, J., writing specially) (citing *Sorrell* in noting that “[a]lthough the Supreme Court has yet to decide whether strict scrutiny attaches to restrictions on commercial speech that are viewpoint discriminatory, there is reason to believe it is an issue worth considering.”).

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

216. *See id.*

*Matal v. Tam*.<sup>217</sup>

Stepping back to consider the different opinions in the *Matal v. Tam* case from a bird's-eye view, however, it is puzzling as to why all of the Justices could not agree on a single opinion for the Court as a whole. They all agreed on the outcome. They agreed as well on what might seem to an outsider as the central free speech principle in this case (viewpoint discrimination by the government is not allowed by the free speech clause). Why the ongoing disagreements about commercial speech doctrine would have prevented a full Court opinion in this *particular* case is unclear. The opinions—issued on one of the last days of the Term—seem cursory.

This raises a legitimate question: Was the Supreme Court so focused on its ongoing dispute about commercial speech rights that it missed the opportunity to reach common ground on a more basic, but fundamental, aspect of First Amendment law? Or was it, perhaps, waiting for Justice Gorsuch to join the debate in order to issue a fuller opinion on the commercial speech issue?

Whatever the reason, this was arguably a missed opportunity. The Court rightly rejected the Federal Circuit's proposed constitutional framework. However, this case might well have presented an opportunity to bring the Court together in a meaningful and helpful way on the narrow viewpoint-discrimination question posed in *Matal v. Tam*, a point explored further below.

#### A. *Rejecting the “Expressive Character” Test was a Valuable Contribution*

The Court was right, first of all, to reject the proposed framework articulated by the Federal Circuit's *en banc* decision.<sup>218</sup> If nothing else, the *Matal v. Tam* decision is valuable in that it displaces a free speech theory in the commercial speech context that could have engendered yet more confusion.<sup>219</sup>

The Federal Circuit *en banc* held that even within a single regulatory scheme, a government regulation that targets the “expressive component” of commercial speech should be judged

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217. See *id.* at 1764, 1767 (Alito, J.) (plurality opinion).

218. *Tam En Banc Decision*, 808 F.3d 1321, 1355 (Fed. Cir. 2015).

219. *Id.* at 1338.

strictly, while one that regulates the “commercial component” of the same speech should get more deference.<sup>220</sup> Noting that trademarks have both commercial and expressive aspects, the Federal Circuit proposed that the standard of scrutiny in a given case should be based, not on the character of the speech generally, but on “which aspect of the speech is targeted by the measure being reviewed.”<sup>221</sup> Because section 2(a)’s disparagement clause is “entirely directed to the expressive component of the speech,” the court held, strict scrutiny should apply.<sup>222</sup>

The Federal Circuit’s theory attempts to bring clarity to commercial speech doctrine by proposing that the courts start with the details of the regulation at issue, rather than by characterizing the type of speech being regulated.<sup>223</sup> It is true that the *Central Hudson Gas* test<sup>224</sup> is a blunt instrument that is not sufficiently nuanced for considering the wide variety of free speech issues that can arise in the regulatory context. At the same time, the “expressive character” test offered by the Federal Circuit in its *en banc* decision in *In re Tam*<sup>225</sup> would have been a dangerous precedent.

To begin with, the Federal Circuit’s conclusion that section 2(a) “targets speech that is of ‘public concern’”<sup>226</sup> appears to have been heavily influenced by its factual finding that Simon Tam “named his band THE SLANTS to make a statement about racial and cultural issues in this country.”<sup>227</sup> This factual finding should not play any decisive role in dictating the level of constitutional scrutiny.

Simply as a factual matter, at times in the litigation, Mr. Tam

220. *Id.*; *see also id.* (“The disparagement provision must be assessed under First Amendment standards applicable to what it targets, which is not the commercial-speech function of the mark.”).

221. *Id.* at 1339.

222. *Id.* at 1338, 1339; *see also id.* (noting that the court is not addressing “a government regulation aimed at the commercial component of speech”); *id.* (“[s]trict scrutiny must apply to a government regulation that is directed at the expressive component of speech.”).

223. *Id.* at 1339.

224. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 563–64 (1980).

225. *Tam En Banc Decision*, 808 F.3d at 1338.

226. *Id.* at 1339.

227. *Id.* at 1327–28; *see, e.g., id.* at 1338 (“With his band name, Mr. Tam makes a statement about racial and ethnic identity.”).

denied any political motivation in picking “The Slants” as a name (and indeed, denied that it was a racial slur at all), whether genuinely or for strategic reasons.<sup>228</sup> But even if he had always insisted that he was politically motivated, the level of constitutional protection for speech cannot possibly turn on how a speaker chooses to characterize his own speech. Under this rationale, fast food restaurants could gain enhanced free speech protections simply by announcing that they are seeking to send a “political message” by urging consumers to buy their new bacon cheeseburgers.<sup>229</sup> The emphasis on Tam’s “political message” throughout this litigation is an appealing detail for free speech purposes but ultimately proves to be a red herring.

More fundamentally, the concept that regulations can be neatly divided into two categories, those that target either a “commercial component” or an “expressive component” of commercial speech, is flawed. Most advertising, by its nature, is both highly expressive and commercially motivated. The same is true of trademarks. As Justice Alito emphasized in *Matal v. Tam*, “the line between commercial and non-commercial speech is not always clear.”<sup>230</sup> Justice Kennedy observed, in the same vein, that trademarks “make up part of the expression of everyday life, as with the names of entertainment groups, broadcast networks, designer clothing, newspapers, automobiles, candy bars, toys, and so on.”<sup>231</sup> It is illusory to think that it is possible to separate the “expressive” from the “commercial” aspects of the speech in the manner that the Federal Circuit’s analysis suggests.<sup>232</sup>

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228. In the administrative proceeding before the USPTO, Mr. Tam denied any intent to express a political view, and took the position that “the mark does not refer to people of Asian descent.” *Tam Panel Decision*, 785 F.3d 567, 570 (Fed. Cir. 2015).

229. It is also notable that the outcome here would have been the same had Tam denied that the mark was intended to be disparaging rather than embraced the name as a racial slur, since the Court had ample evidence in the record that the trademark was seen as disparaging by *other* Asian-Americans, which is the relevant test under this particular statutory provision. *See, e.g., Tam En Banc Decision*, 808 F.3d at 1332 (noting that the USPTO disqualified “The Slants” mark because it “found that the mark is disparaging to a substantial component of people of Asian descent”).

230. *Matal v. Tam*, 137 S. Ct. 1744, 1765 (2017) (Alito, J.) (plurality opinion).

231. *Id.* at 1768 (Kennedy, J., concurring).

232. *Tam En Banc Decision*, 808 F.3d at 1339.

As important, this expressive aspect of trademark is at the heart of the trademark registration review in every instance, not simply when considering section 2(a)'s "disparagement" clause. A trademark cannot be registered at all unless it is sufficiently "distinctive," that is, capable of "distinguishing" the goods or services from those offered by others in the same market.<sup>233</sup> This requires that the agency look closely, in each case, at the message a trademark is expressing. To place a particular mark on the so-called "spectrum of distinctiveness," as the agency does every day, requires one to consider whether the expressive aspects of this mark, as used for this product, are sufficiently distinctive to evoke the product's source in the eye of the consumer simply from seeing the mark (for example, consider the expressive quality of Tiffany blue packaging).<sup>234</sup>

Thus, while a generic term like "Milk" would clearly not be sufficiently distinctive to be acceptable as a trademark for dairy products,<sup>235</sup> a trademark like "Smooth and Creamy" might well be. In deciding whether to grant federal registration for the latter mark, the agency would necessarily have to look to and assess the mark's "expressive" capacity as a trademark for dairy products.

Outside of the trademark area, many, many regulatory schemes similarly, directly or obliquely touch on the "expressive component" of particular speech as it may be relevant for the purpose of that particular regulatory scheme, from the federal securities laws to food and drug laws. As the Supreme Court has emphasized, "[b]y definition commercial speech is linked inextricably to commercial activity . . . ."<sup>236</sup> Laws regulating

233. See Lanham Act, 15 U.S.C. § 1052 (2012) ("No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration" except on specified and limited grounds.).

234. See, e.g., *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (explaining that trademarks "are often classified in categories of generally increasing distinctiveness; following the classic formulation set out by Judge Friendly, they may be (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful."); see also, e.g., *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163 (1995) ("[O]ver time, customers may come to treat a particular color on a product . . . as signifying a brand. And, if so, that color would have come to identify and distinguish the goods.").

235. See 15 U.S.C. § 1052(e) (trademarks will not be registered if they are "merely descriptive" of the products).

236. *Friedman v. Rogers*, 440 U.S. 1, 10 n.9 (1979) (internal quotations omitted) (emphasizing that "the State does not lose its power to regulate

commercial activity routinely require that advertising, labelling, disclosures, or other speech-related commercial activities either include or omit particular information in order to protect the consumer. Because such provisions are an essential and proper part of regulating commerce, the Supreme Court has expressly held that for commercial speech, the First Amendment allows “modes of regulation . . . that might be impermissible in the realm of noncommercial expression.”<sup>237</sup>

In short, the proposed test offered by the Federal Circuit— that whenever a regulation is focused on the “expressive component” of commercial speech, the court should apply strict scrutiny<sup>238</sup>—is seriously overbroad. The problem here was not that the agency considered the “expressive character” of Mr. Tam’s mark; the agency routinely and properly considers the messages expressed by trademarks in making registration determinations. Rather, the problem is that section 2(a)’s “disparagement” provision allows the government to reject otherwise qualifying trademarks based on their *viewpoint*.<sup>239</sup> It is this flaw that should and must be the focus of any free speech test in this context.

*B. The Free Speech Analysis That Should Have Worked for the Full Court*

Focusing on the issue of viewpoint discrimination, there is a great deal of common ground among the opinions in *Matal v. Tam*, even though there is no single opinion for the Court as a whole.<sup>240</sup> This suggests another path that could, potentially, have unified the Supreme Court.

The dispute between the two plurality opinions—one authored by Justice Alito and one by Justice Kennedy—reflects, as noted, an ongoing dispute within the Supreme Court over the proper

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commercial activity deemed harmful to the public whenever speech is a component of that activity” (internal quotations omitted).

237. See, e.g., *id.* at 11 n.9 (internal citation omitted) (emphasizing that when dealing with restrictions on commercial speech, we “frame our decisions narrowly” (internal citation omitted)).

238. *Tam En Banc Decision*, 808 F.3d 1321, 1338 (Fed. Cir. 2015).

239. *Id.* at 1339.

240. *Matal v. Tam*, 137 S. Ct. 1744, 1757 (2017); *id.* at 1765 (Kennedy, J., concurring).

application of its commercial speech cases.<sup>241</sup> This is a debate that threads through many recent Supreme Court decisions. The Justices could not reach an agreement because they were narrowly focused on a dispute over “intermediate scrutiny” versus “strict scrutiny,” an important and unsettled issue in First Amendment law generally in the commercial speech context.

Reaching agreement on the proper level of scrutiny is extremely difficult because Justices are, understandably, wary in making any statement about the impact that the particular wording could have in the many different commercial and political environments in which free speech issues are now raised.

In this case, however, the narrow focus in both plurality opinions on the dispute over the proper level of scrutiny obscured the important areas of common ground in *Matal v. Tam*.<sup>242</sup> As a result, the decision produced no new or useful statement about First Amendment law.

One wonders whether the Court could have reached consensus by stepping back from the “standard of scrutiny” debate and, instead, embracing the chance to agree on an important common principle that all shared. In particular, the Court would have been on sound constitutional ground in holding—flatly but narrowly—that in those rare cases in which a government rule is, by its terms, a clear and explicit “viewpoint-based” restriction on the content of private speech, the statute is unconstitutional on its face.

Instead, Justice Alito noted that the Federal Circuit Court reasoned that “even if” the commercial speech “intermediate scrutiny” test applied, section 2(a) would fail, while Justice Kennedy insisted that “strict scrutiny” must apply.<sup>243</sup> Justice Thomas agreed with *both* Justice Alito and Justice Kennedy that “strict scrutiny” must apply and that the law failed even the “intermediate scrutiny” test.<sup>244</sup> This was a missed opportunity to come together on a basic constitutional principle that is important, non-controversial, and unrelated to the proper level of scrutiny.

Indeed, the voting Justices all recognized that the level of scrutiny is irrelevant here because section 2(a) fails constitutional

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241. *Id.* at 1765, 1768 (Kennedy, J., concurring).

242. *Id.* at 1765; *id.* at 1763–64 (Alito, J., plurality opinion).

243. *Id.* at 1754 (Alito, J.) (majority opinion); *id.* at 1765 (Kennedy, J., concurring).

244. *Id.* at 1769 (Thomas, J., concurring).

scrutiny under any test.<sup>245</sup> But that insight was not embodied into a clear statement of law joined by the Court as a whole. Instead, the opinions devolved into another variation of the ongoing debate about standards of scrutiny. But the truth here—as evidenced by the unanimous outcome—that Section 2(a)’s “disparagement” provision was patently unconstitutional on its face. Why not declare as much?

While flat rules are rarely appropriate, a flat rule prohibiting the government from engaging in clear and explicit viewpoint-based discrimination against private speech is sustainable here because there is no valid ground on which the government can censor particular private viewpoints. To provide a valid basis for suppressing speech, the government’s reason must be “viewpoint-neutral.”<sup>246</sup> Where a law censors a particular private viewpoint, as a logical matter, it cannot be justified without explaining *why* the government believes that viewpoint should be censored.

The proposed holding here would be narrow. Rules that restrict speech that incites violence or poses an immediate danger to public safety or welfare (such as yelling “fire” in a crowded theater) are already excluded from free speech protections.<sup>247</sup> First Amendment doctrine has also eliminated from free speech challenges certain valid regulatory restrictions that might arguably be seen as “viewpoint-based,” such as those prohibiting deceptive or misleading speech. Such speech enjoys no free speech rights and may be freely banned or regulated by the government without implicating First Amendment concerns.<sup>248</sup> Only truthful, non-misleading commercial speech gets protection under the Free

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245. *Id.* at 1767 (Kennedy, J., concurring); *id.* at 1769 (Thomas, J., concurring); *id.* at 1763 (Alito, J.) (plurality opinion).

246. *Cf.* *Renton v. Playtime Theatres, Inc.*, 475 U.S. 41, 48 (1986) (explaining that “content-neutral” speech regulations are “those that are *justified* without reference to the content of the regulated speech” (internal quotations omitted)).

247. *See, e.g.*, *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 340–41 (1974) (defamation under certain circumstances is not protected by the First Amendment); *Roth v. United States*, 354 U.S. 476, 485 (1957) (obscenity is not protected by the First Amendment); *Chaplinsky v. New Hampshire*, 315 U.S. 568, 571–72 (1942) (“fighting words” are not protected by the First Amendment).

248. *See, e.g.*, *Bd. of Trs. of the State Univ. of N.Y. v. Fox*, 492 U.S. 469, 475 (1989) (“For commercial speech to come within [the First Amendment], it at least must concern lawful activity and not be misleading.” (citation omitted)).

Speech clause.

Whether a particular government rule is properly understood to be an explicit viewpoint-based restriction on otherwise lawful private speech may, of course, require statutory interpretation.<sup>249</sup> But once a rule is properly characterized as such, which should be a very narrow category of rules, any rationale offered by the government cannot possibly be viewpoint-neutral, since it will by definition argue that private expression of the particular viewpoint poses alleged public hazards.

Consider, for example, a traffic rule that generally allowed private citizens to display bumper stickers on their cars, but barred those bumper stickers that advocate for abortion rights. Such a rule would be patently unconstitutional. Such a law could not, for example, be constitutionally validated by government concerns that abortion-rights messages will distract or arouse anger in other motorists and thereby cause a traffic hazard. Banning a message because it is offensive to others is simply another form of unconstitutional viewpoint-based discrimination.<sup>250</sup> Surely, the Court would not have to agree on the proper level of scrutiny to declare such a law flatly unconstitutional.

The same principle holds true in the commercial speech context. Consider a government regulation regulating advertising by lawyers that generally allowed truthful, non-misleading ads, but prohibited lawyer ads that criticize judges. A regulation that permits lawyers to publish ads that praise judges, but not ads that criticize judges, would be an explicitly viewpoint-based restriction. Is there any valid government rationale that could justify such a law?<sup>251</sup>

249. See, e.g., *Matal*, 137 S. Ct. 1744.

250. See, e.g., *Snyder v. Phelps*, 562 U.S. 443, 458 (2011) (noting that otherwise lawful speech “cannot be restricted simply because it is upsetting or arouses contempt”); *Forsyth Cty. v. Nationalist Movement*, 505 U.S. 123, 134 (1992) (“Listeners’ reaction to speech is not a content-neutral basis for regulation.” (citation omitted)); cf. *Tam En Banc Decision*, 808 F.3d 1321, 1336 (Fed. Cir. 2015) (“The legal significance of viewpoint discrimination is the same whether the government disapproves of the message or claims that some part of the populace will disapprove of the message.”).

251. By contrast, a regulation that applied only to advertising by lawyers—a speaker-based and perhaps content-based regulation—could legitimately be adopted as part of a comprehensive scheme regulating the legal profession, since this restriction only makes sense in the context of the particular regulatory scheme.

The *Matal v. Tam* case itself provides a prime example of the government's near-impossible task of articulating a valid government interest to support a restriction on speech that is, on its face, viewpoint-based.<sup>252</sup> In the Supreme Court, the government advanced two interests in support of Section 2(a)'s disparagement clause: its interest in rejecting trademarks that contain "demeaning messages"; and its interest in ensuring the "orderly flow of commerce."<sup>253</sup> As it turns out, however, both were simply thinly-veiled versions of the government's view that trademarks like "The Slants" are just too offensive to qualify for the benefits of trademark registration.<sup>254</sup>

Consider, for example, the government argument in the Supreme Court that it has a valid interest in preventing underrepresented groups from being "bombarded with demeaning messages in commercial advertising."<sup>255</sup> A variation of this rationale was also offered in the Federal Circuit, where the government advanced its interest in preventing the registration of "vile racial epithets and images" and in "dissociating itself from speech that it finds odious."<sup>256</sup> As Justice Alito observed, however, "no matter how the point is phrased, its unmistakable thrust is this: The Government has an interest in preventing speech expressing ideas that offend."<sup>257</sup> And this, he argued, "strikes at the heart of the First Amendment."<sup>258</sup>

Nor did the government's alternative rationale—that allowing disparaging trademarks interrupts the "orderly flow of commerce"<sup>259</sup>—fare better. The government posited in its Supreme Court argument that commerce is "disrupted" by trademarks that

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252. *Tam*, 137 S. Ct. at 1761–63 (Alito, J.) (plurality opinion).

253. *Id.* at 1764.

254. *Id.* at 1766 (Kennedy, J., concurring).

255. *Id.* at 1764 (Alito, J.) (plurality opinion).

256. *Tam En Banc Decision*, 808 F.3d 1321, 1356 (Fed. Cir. 2015) (summarizing the government's arguments in its briefs that it should be entitled to refuse registration to trademarks that include "the most vile racial epithets and images," that incorporate "racial slurs," that use "religious insults, ethnic caricatures, misogynistic images, or any other disparaging terms or logos," or that generally use speech that the government "finds odious." (citations omitted)).

257. *Tam*, 137 S. Ct. at 1764 (Alito, J.) (plurality opinion).

258. *Id.*; see also *Tam En Banc Decision*, 808 F.3d at 1336 (noting that the government is "underscoring its hostility to these messages").

259. *Tam*, 137 S. Ct. at 1764.

“involv[e] disparagement of race, gender, ethnicity, national origin, religion, sexual orientation, and similar demographic classification.”<sup>260</sup> The government’s theory, apparently, was that when the content of commercial speech “may lead to political or social ‘volatility,’” such speech may properly be suppressed.<sup>261</sup> Like the first rationale, however, this justification expressly relies on the alleged harms to commerce that flow from the *disparaging message* expressed by the specific marks that are banned. This is not a viewpoint-neutral rationale.<sup>262</sup>

Had there been any neutral rationale the government could have found to support this rule, it certainly would have been offered here. Instead, the government focused its fire on trying to argue that the First Amendment did not apply at all.<sup>263</sup>

In sum, rather than leaving the constitutional analysis at the final threshold, the Court as a whole should have been able to agree and clearly state, as a Court, that where, as here, there is an explicit, clear “viewpoint-based” burden on otherwise lawful private speech, the law is unconstitutional on its face and there is no need to debate the standard of scrutiny. The Court should have held that in those very rare circumstances in which the government has adopted an explicit, clear viewpoint-based restriction on private speech, that law is unconstitutional, period.

#### CONCLUSION

The *Matal v. Tam* case presented constitutional free speech issues that were, at one level, very easy.<sup>264</sup> By empowering the federal government to refuse registration to trademarks it found “disparaging” to racial or ethnic groups, Section 2(a) embodied a restriction on speech that was patently unconstitutional.<sup>265</sup>

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260. *Id.* (citation omitted).

261. *Id.* at 1765.

262. *Cf. Tam En Banc Decision*, 808 F.3d at 1357 (“All of the government’s proffered interests boil down to permitting the government to burden speech it finds offensive.”).

263. *See id.* at 1336 (“From its enactment in 1946 through its defense of the statute today, the government has argued that the prohibited marks ought not to be registered because of the messages the marks convey. When the government discriminates against speech because it disapproves of the message conveyed by the speech, it discriminates on the basis of viewpoint.”).

264. *Tam*, 137 S. Ct. at 1757 (Alito, J.) (majority opinion).

265. *Id.*

Trademarks like “The Slants,” which are derogatory to Asian-Americans, were denied registration, while trademarks complimentary of Asians, like “Asian Efficiency,” were registered. There is no question that such patent and explicit government viewpoint-discrimination violates the First Amendment’s Free Speech Clause, and the Court so agreed. Nor did any of the Justices buy into the government’s argument that registering trademarks turns them from private speech into “government speech.”<sup>266</sup>

At another level, however, the legal issues in *Matal v. Tam* proved impossible for the voting members of the Supreme Court to agree upon.<sup>267</sup> Though they were all clear that Section 2(a) was unconstitutional, the voting Justices could not agree on a single opinion for the Court as a whole.<sup>268</sup> Instead, the splintered decisions devolved into disagreements about the complex and very difficult issue of commercial free speech cases, and the correct level of scrutiny. This dispute persisted even though all Justices agreed that Section 2(a)’s disparagement clause could not be justified under any level of scrutiny.<sup>269</sup>

This was a missed opportunity. As this case shows, there are rare circumstances in which a law on its face violates the Free Speech Clause. The Court missed an opportunity to make a clear statement of this narrow but fundamental point of law. However, the debate is far from over.

Even in this very narrow area of trademark law, there are other aspects of Section 2(a) that are vulnerable to a very similar free speech challenge. In particular, Section 2(a) also allows the government to refuse to register trademarks that are “immoral” or “scandalous.”<sup>270</sup> The Federal Circuit *en banc* in the *Tam* case predicted that the outcome of this case might well doom those other aspects of Section 2(a) as well.<sup>271</sup> They were right. Expect further

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266. *Id.* at 1760.

267. *See id.* at 1751 (Alito, J.) (majority opinion); *id.* at 1765 (Alito, J.) (plurality opinion).

268. *See id.* at 1751 (Alito, J.) (majority opinion).

269. *Id.* at 1764 (Alito, J.) (plurality opinion).

270. *See supra* text accompanying note 4 (quoting the text of Section 2(a) in full).

271. *See Tam En Banc Decision*, 808 F.3d at 1330 n.1 (“We limit our holding in this case to the constitutionality of the § 2(a) disparagement provision. Recognizing, however, that other portions of § 2 may likewise constitute government regulation of expression based on message, such as the

litigation. The debate is not yet over.<sup>272</sup>

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exclusions of immoral *or* scandalous marks, we leave to future panels the consideration of the § 2 provisions other than the disparagement provision at issue here.” (emphasis added)).

<sup>272</sup> Since the *Tam* decision was issued by the Supreme Court, the Federal Circuit has already applied that precedent to find the Trademark Act’s bar on registering “immoral” or “scandalous” trademarks to be unconstitutional under the Free Speech Clause. *See In Re Brunetti*, 877 F.3d 1330 (Fed. Cir. 2017). In *Brunetti*, the Federal Circuit espoused the same constitutional theory that Judge Moore had originated in the *Tam en banc* decision—that strict scrutiny should apply whenever the government regulates the “expressive” aspects of commercial speech. *See id.* at 1349 (“Section 2(a) regulates the expressive components of speech, not the commercial components of speech, and as such it should be subject to strict scrutiny.”). This constitutional theory, however, was not endorsed or adopted in any of the Supreme Court’s decisions in *Matal v. Tam*. The Supreme Court’s failure to agree on a common legal rationale in *Matal v. Tam* has, clearly, left open key issues concerning the proper approach to free speech rights in the arena of commercial speech.