

THE
NATIONAL LAW REVIEW

Bring on the Bad Word Brands? What Supreme Court's Decision in *Matal v. Tam* Means for Trademark Owners

Monday, July 3, 2017

The Supreme Court's June 19, 2017 decision in the *Matal v. Tam* case has been burning-up the news wires all week. The decision struck down a 70-year-old ban on federally registering disparaging trademarks, finding that the disparagement clause of Section 2(a) of the Trademark Act violates the First Amendment principal against banning speech that expresses ideas that offend. The decision was joined by all 8 participating justices. The case was heralded as not just a win for the Asian-American dance-rock band The Slants, but also for the Washington Redskins whose trademark registrations were challenged based on the same disparagement clause.

The USPTO was quick to act, issuing Examination Guide No. 1-17 on June 26, providing a framework for how the PTO will examine applications following the Supreme Court's decision. Opportunistic brand owners were also quick to act; *World Trademark Review* reports that at least 11 trademark applications for marks that could possibly be deemed disparaging were filed the day of the ruling.

In light of *Tam*, two other provisions of Section 2(a) -- those that preclude registration of immoral and scandalous marks -- also seem likely to fall, as both could be interpreted as banning speech likely to offend. In fact, the constitutionality of the scandalousness provision of 2(a) is currently pending before the Federal Circuit (*In re Brunetti*), and it seems likely the Fed. Cir. will move forward with *Brunetti* in the aftermath of *Tam*.

What does *Tam* mean to brand owners? It seems unlikely that the ability to now federally register offending marks will herald a seismic shift in branding strategies. The ability to use a trademark was never at issue in *Tam*, simply the ability to protect a mark by federal registration. Similarly, the public's appetite for offensive brands will likely also not be enhanced by the new ability to obtain federal registration for such source indicia. Just as it is unlikely that the Court's decision in *Tam* will persuade my son's middle school principal that a T-shirt bearing the phrase HOMEWORK.SUCKS (INTA swag courtesy of the folks at dotSucks) is appropriate classroom attire. As always, the strength of a brand goes not to its novelty, but to its long-term ability to communicate the positive attributes of the associated products and services to consumers.

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