

“CATCHY PHRASES THAT CONVEY A MESSAGE”: THE DANGER OF *TAM*’S COPYMARK CREEP AND TRADEMARK LAW’S NEW FIRST AMENDMENT ANALYSIS

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In 2017, the Supreme Court decided Matal v. Tam, in which an Asian-American band called The Slants challenged the Patent and Trademark Office’s refusal to register the mark based on its disparaging nature. In a First-Amendment-focused opinion, the Supreme Court positioned trademarks as important expressive speech that must be protected as such. In so doing, the Supreme Court distorted the important foundations of trademark protection that had distinguished it from copyrights, putting the two on effectively equal footing.

The Supreme Court’s decision makes fully explicit an ongoing blurring of the lines between copyright and trademark, as virtually all speech has come to be understood as essentially commercial, rendering commercial speech therefore also expressive by default. Copyright holders have sought to treat their copyrights more like trademarks, wishing to expand them indefinitely to protect their status as the source of particular creative franchises. Meanwhile, as the Supreme Court’s decision in Tam illustrates, trademark holders have sought to treat their trademarks more like copyrights, proposing artistic expression rather than commercial transactions.

This Article contrasts the analysis of Tam with previous disparaging trademark cases, highlighting how Tam shifts trademark analysis from its traditional considerations of commerce and marketplace into a discussion of traditional copyright considerations of expressive creativity and artistic viewpoints. This Article argues that Tam’s treatment of trademarks, carried to its natural conclusion, could have the result of hollowing out many trademark law ideals, such as protecting consumers from deception, encouraging effective and efficient marketplace competition, and defending public discourse from commercial ownership. This Article concludes that there is value in maintaining the separation of trade-

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marks and copyrights and remembering their separate foundational values, in order to protect all speech from now seemingly inevitable commodification.

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INTRODUCTION

In the 1990s, a class of Native Americans challenged the trademark registrations for REDSKINS, the Washington, D.C. football team, based on a section of the trademark statute that prohibited disparaging trademarks.¹ The case got tangled in a number of procedural thickets,² but eventually resulted in a ruling that focused closely on the unique nature and benefits of the trademark registration scheme.³

Last year, the Supreme Court decided a similar case, *Matal v. Tam*, in which an Asian-American band called The Slants challenged the Trademark Office's refusal to register the mark based on its disparaging nature.⁴ The Supreme Court's ruling ignored the unique nature and benefits of trademark registration in favor of a First Amendment-focused opinion that equated trademarks with expressive speech.

The Supreme Court's decision in *Tam* reflects the extent to which commercial speech has come to be viewed as creative speech. The lines that we previously used to divide copyright and trademark into separate doctrines have been gradually breaking down. In a previous article, *The Copymark Creep*, I examined this phenomenon from the point of view of copyright law, detailing

¹ Pro-Football, Inc. v. Blackhorse, 62 F. Supp. 3d 498, 500 (E.D. Va. 2014).

² See e.g., *id.* at 500–01.

³ See *id.* at 508–09.

⁴ See *Matal v. Tam*, 137 S. Ct. 1744, 1754 (2017).

how various copyright holders have begun to treat their copyrights like trademarks.⁵

Tam indicates that the copymark creep is happening from the other side, too: various trademark holders have begun to treat their trademarks as operating more like copyrights, and the Supreme Court in *Tam* has stamped approval on this approach. This conflation of the two doctrines threatens to undercut the purpose of both and leave us with the effectiveness of neither.

This Article begins by discussing the analytical structure of disparaging trademark cases prior to *Tam*, with a particular focus on the REDSKINS litigations. This Article then contrasts the analysis of *Tam*, highlighting how *Tam* shifts trademark analysis from its traditional considerations of commerce and marketplace confusion into a discussion of traditional copyright considerations of expressive creativity and political viewpoints. Thereafter, the Article examines the implications of this shift and the impact it could have on many other traditional trademark law doctrines, arguing that *Tam*'s analytical underpinnings, carried to their natural conclusions, have the result of hollowing out many traditional trademark law ideals, such as protecting consumers from deception and encouraging effective marketplace competition. It has the additional critical effect of making vulnerable the robust exchange of ideas that it purports to protect. This Article concludes that trademark law as a body of law separate from copyright law serves important consumer-protection functions that should not be gutted in the name of protecting creative expression, when copyright law exists to do just that.

I. TRADEMARKS AND THEIR EXPRESSIVENESS

A trademark is “any word, name, symbol, or device, or any combination thereof . . . [used] to identify and distinguish . . . goods . . . from those manufactured or sold by others and to indicate the source of the goods”⁶ Congress enacted the first federal trademark system in 1870.⁷ However, in 1879 the Supreme Court declared it unconstitutional, warning Congress that its power to regulate trademarks stemmed from the Constitution’s Commerce Clause and thus any statute had to be positioned within that clause’s auspices.⁸ There was a series of challenges to this idea, asserting that in fact trademarks should be lumped in with copyrights under the Constitution’s Copyright Clause.⁹ However, even the parties arguing the case themselves seemed dubious of the equiva-

⁵ Stacey M. Lantagne, *The Copymark Creep: How the Normative Standards of Fan Communities Can Rescue Copyright*, 32 GA. ST. U. L. REV. 459, 462 (2016).

⁶ 15 U.S.C. § 1127 (2018).

⁷ 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 5:3 (5th ed. 2019).

⁸ *Id.*

⁹ *See id.*

lency of trademarks and copyrights,¹⁰ and the Supreme Court unequivocally and unanimously rejected the idea, however, drawing a line around trademarks as symbols of commercial usage rather than the vehicles of creative expression for which copyright was designed:

If we should endeavor to classify [trademarks] under the head of writings of authors, the objections are . . . strong. In this, . . . originality is required. And while the word *writings* may be liberally construed, as it has been, to include original designs for engravings, prints, &c., it is only such as are *original*, and are founded in the creative powers of the mind. The writings which are to be protected are *the fruits of intellectual labor*, embodied in the form of books, prints, engravings, and the like. The trade-mark may be, and generally is, the adoption of something already in existence as the distinctive symbol of the party using it. At common law the exclusive right to it grows out of its *use*, and not its mere adoption. By the act of Congress this exclusive right attaches upon registration. But in neither case does it depend upon novelty, invention, discovery, or any work of the brain. It requires no fancy or imagination, no genius, no laborious thought. It is simply founded on priority of appropriation.¹¹

From this initial foundation that trademarks concerned commerce, Congress put together legislation that eventually became the Lanham Act, the federal statute that governs distinctive symbols being used in commerce to identify goods and services.¹² This regulation of trademarks is explicitly marketplace-focused: trademarks do not exist until they are being used in commerce,¹³ cease to exist once they cease being used in commerce,¹⁴ and are defined in scope by how they are being used in commerce.¹⁵ This can be contrasted with copyrights, which protect all original works of expression fixed in a tangible medium, regardless of their use in commerce or not.¹⁶

Although separate from copyrighted works, the fact that trademarks are defined as being symbols means that they necessarily communicate an idea in the same way that expressive copyrights do. Indeed, the Supreme Court's definition of the proper range of possibilities that can serve as trademarks explicitly defines them as "anything at all that is capable of carrying meaning."¹⁷ Howev-

¹⁰ See Zvi S. Rosen, *In Search of the Trade-Mark Cases: The Nascent Treaty Power and the Turbulent Origins of Federal Trademark Law*, 83 ST. JOHN'S L. REV. 827, 860–61 (2009) (citations omitted) ("[T]he Intellectual Property Clause of the Constitution was already roundly rejected by the legal community as a rationale for trademark legislation. The Attorney General recognized this, and . . . it was not argued seriously. . . . The brief of Coudert Brothers on behalf of the Kunkelmann & Co. against Wittemann did not even mention the Intellectual Property Clause, effectively dismissing it out of hand. Rather, like the Mumm Brief, it argued for the Commerce Clause . . .").

¹¹ *In re Trade-Mark Cases*, 100 U.S. 82, 94 (1879).

¹² 15 U.S.C. § 1051 (2018).

¹³ See 2 MCCARTHY, *supra* note 7, § 16:8.

¹⁴ See 3 MCCARTHY, *supra* note 7, § 17:4.

¹⁵ See 4 MCCARTHY, *supra* note 7, § 24:6.

¹⁶ See 17 U.S.C. § 301 (2018) (noting that works are protected even when they are not published to the public).

¹⁷ *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 162 (1995).

er, the meaning the Court was referring to was the marketplace-based meaning of trademarks: “[C]ustomers may come to treat a particular color on a product or its packaging . . . as signifying a brand. And, if so, that color would have come to identify and distinguish the goods—*i.e.*, ‘to indicate’ their ‘source’”¹⁸ When trademarks carried meanings that went beyond their marketplace meanings, courts treated them carefully, concerned about using trademark law to award ownership of expression.

For instance, in the case of descriptive word marks, the statute and its application by courts confines trademark ownership to a showing of secondary meaning.¹⁹ This secondary meaning is the trademark meaning of the descriptive term,²⁰ and the trademark holder’s ownership rights are limited to that secondary meaning.²¹ The word still exists in its primary meaning for all to use.²² Those who choose descriptive marks choose them at their own peril, as courts do not hesitate to limit the scope of their protection to maintain the words’ expressive meaning for use by others.²³

Likewise, in cases where the parties were suing over a use in question that was not commercial, but instead artistic or creative, then courts recognized that such speech was not a true trademark dispute and instead implicated First Amendment concerns not ordinarily raised in the trademark context.²⁴ This was necessitated by the fact that the mark in question had been taken *out* of the marketplace, and so had ceased functioning as a mark and instead gained expressive qualities.²⁵ In these situations, courts were generally careful *not* to use trademark protection to stifle expression.²⁶

¹⁸ *Id.* at 163; *see also* S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm., 483 U.S. 522, 534 (1987).

¹⁹ *See* 2 MCCARTHY, *supra* note 7, § 11:25.

²⁰ *See id.* § 15:1 (“[I]f a designation is not *used* as a mark to identify and distinguish source, it cannot possibly achieve a secondary meaning.”).

²¹ *See id.* § 15:6.

²² *See id.* § 15:1 (“The original ‘primary meaning’ . . . does not disappear, but continues”).

²³ *See e.g.*, KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111, 122 (2004) (“The common law’s tolerance of a certain degree of confusion on the part of consumers followed from the very fact that in cases like this one an originally descriptive term was selected to be used as a mark, not to mention the undesirability of allowing anyone to obtain a complete monopoly on use of a descriptive term simply by grabbing it first.”).

²⁴ *See* Taubman Co. v. Webfeats, 319 F.3d 770, 778 (6th Cir. 2003); Stewart Surfboards, Inc. v. Disney Book Grp., LLC, No. CV 10-2982 GAF (SSx), 2011 WL 12877019, at *3 (C.D. Cal. May 11, 2011) (“Trademark law traditionally applies to commercial uses of marks.”). The many cases applying the Second Circuit’s *Rogers* test also attest to the different treatments of trademark use versus expressive use. *See id.*

²⁵ *See e.g.*, Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 900 (9th Cir. 2002).

²⁶ *See* Radiane Found., Inc. v. NAACP, 786 F.3d 316, 325 (4th Cir. 2015) (“Trademark protections exist neither to allow companies to protect themselves from criticism nor to ‘control language.’”); *Taubman*, 319 F.3d at 778 (“Mishkoff has a First Amendment right to express his opinion about Taubman, and as long as his speech is not commercially misleading, the Lanham Act cannot be summoned to prevent it.”).

II. TRADITIONAL DISPARAGEMENT ANALYSES

If one's theory of trademarks is as marketplace tools (as twentieth-century jurisprudence held trademarks to be, relying on nineteenth-century precedent) rather than as modes of creative expression, then it makes sense that statutes would seek to regulate marketplace concerns rather than First Amendment concerns. Section 2(a) of the Trademark Act was just such a marketplace regulation. It prohibited the registration of trademarks that were "immoral, deceptive, or scandalous . . . [or] 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"²⁷ In determining disparagement specifically, the Patent and Trademark Office (the PTO) examined "the meaning of the matter in question, as it appears in the marks and as those marks are used in connection with the goods and services identified in the registrations," and whether "the meaning of the marks . . . may disparage."²⁸ The relevant impact to measure was that of the allegedly disparaged group,²⁹ of which a "substantial composite" must have considered the mark as used disparaging.³⁰ In judging the disparaging nature of the mark, courts looked to dictionary evidence; "scholarly, literary, and media references;" and timely statements made by members of the group themselves.³¹

The case *In re Geller*³² gave the Federal Circuit an opportunity to apply this test, using trademark precedent to describe the analysis as:

- (1) what is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and
- (2) if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.³³

The court then used this test to analyze the proposed mark "STOP THE ISLAMISATION OF AMERICA" to use for the service of "[p]roviding information regarding understanding and preventing terrorism."³⁴ The court concluded that the word "Islamisation" had a religious meaning against the applicant's objection that it was entirely political.³⁵ Whether the meaning was

²⁷ 15 U.S.C. § 1052(a) (2018).

²⁸ *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080, 2014 WL 2757516, at *4 (T.T.A.B. June 18, 2014) (citations omitted).

²⁹ *See id.* (citations omitted).

³⁰ *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014) (citations omitted).

³¹ *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 472 (E.D. Va. 2015), *vacated*, 709 F. App'x 182 (4th Cir. 2018).

³² *In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014).

³³ *Id.* at 1358 (quoting *In Re Lebanese Arak Corp.*, 94 U.S.P.Q.2d. 1215, 1217 (T.T.A.B. 2010)).

³⁴ *Id.* at 1357.

³⁵ *See id.* at 1359–60.

political or religious, however, both meanings referred to people of the Islamic faith.³⁶ In the context in which it was being used, coupled with the word “stop,” the court found the mark to be disparaging of American Muslims.³⁷

The Federal Circuit’s analysis was typical of the disparagement analysis regularly used to block registration of marks like KHORAN,³⁸ HEEB,³⁹ and SQUAW⁴⁰. However, marks like JAP,⁴¹ MOONIES,⁴² and BUDDHA BEACHWEAR⁴³ had been allowed. Nevertheless, while individual decisions under the statute had sometimes been perplexing,⁴⁴ the statute persisted for over seventy years.⁴⁵

Courts had traditionally upheld as constitutional the PTO’s refusals to register marks partly because the Lanham Act’s regulatory focus on commercial speech set it in a less protected First Amendment arena.⁴⁶ Courts were also supportive of the statute because, it was often argued, the refusal of registration did not affect the ability to use the mark.⁴⁷ Trademark rights are not established by registration, only by use.⁴⁸ There are many benefits to registration, including clarity of rights, aid in some circumstances in proving *prima facie* cases, assistance at the border by U.S. Customs, and access to statutes protecting against

³⁶ *See id.* at 1361.

³⁷ *See id.* at 1361–62.

³⁸ *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 2010 WL 766488, at *1, *3 (T.T.A.B. Mar. 4, 2010).

³⁹ *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071, 2008 WL 5065114, at *1 (T.T.A.B. Nov. 26, 2008).

⁴⁰ *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264, 2006 WL 1546500, at *2, *23 (T.T.A.B. June 2, 2006).

⁴¹ *See Japanese Am. Citizens League v. Takada*, 171 U.S.P.Q. 109, 1971 WL 16634, at *1 (N.Y. Spec. Term 1971).

⁴² *In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d 1653, 1990 WL 354546, at *1–2 (T.T.A.B. July 17, 1990).

⁴³ *In re Hines*, 32 U.S.P.Q.2d 1376, 1994 WL 587037, at *1–2 (T.T.A.B. Sept. 23, 1994).

⁴⁴ *See Matal v. Tam*, 137 S. Ct. 1744, 1756–57 (2017); Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, 92 NOTRE DAME L. REV. 381, 413–14 (2016) [hereinafter Tushnet, *First Amendment*].

⁴⁵ *See* Mark Conrad, *Matal v. Tam—A Victory for The Slants, a Touchdown for the Redskins, but an Ambiguous Journey for the First Amendment and Trademark Law*, 36 CARDOZO ARTS & ENT. L.J. 83, 96, 96 n.65–66 (2018).

⁴⁶ *See Taubman Co. v. Webfeats*, 319 F.3d 770, 774 (6th Cir. 2003).

⁴⁷ *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012), *abrogated by In re Tam*, 808 F.3d 1321, 1330 n.1, 1333 (Fed. Cir. 2015); *see also Ritchie v. Simpson*, 170 F.3d 1092, 1099 (Fed. Cir. 1999); *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981), *overruled by In re Tam*, 808 F.3d 1321, 1330 n.1 (Fed. Cir. 2015); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 203, 203 n.3 (2d Cir. 1979); Michael Grynberg, *A Trademark Defense of the Disparagement Bar*, 126 YALE L.J. F. 178, 180 (2016); Niki Kuckes, *Matal v. Tam: Free Speech Meets “Disparaging” Trademarks in the Supreme Court*, 23 ROGER WILLIAMS U.L. REV. 122, 126 (2018).

⁴⁸ *In re Int’l Flavors & Fragrances Inc.*, 183 F.3d 1361, 1366 (Fed. Cir. 1999); Kuckes, *supra* note 47, at 127–28.

counterfeiting.⁴⁹ However, because registration does not create any rights, and because trademark holders can vindicate their marks in court regardless of registration, courts often espoused that a lack of registration had no meaningful, harmful effect on the trademark holder's speech.⁵⁰ Unregistered marks, after all, could be protected in court with "essentially the same protection as those that are registered."⁵¹ Therefore, courts seemed more comfortable with enforcing the disparagement statute, secure in their ability to assure the mark holders that they could still use and protect the mark.⁵²

A. *The REDSKINS Saga*

The Washington Redskins football team chose its name in 1933 and registered its first trademark with the PTO in 1967.⁵³ Controversies had dogged the name since at least the 1970s, with people accurately pointing out that it served as a racial slur.⁵⁴ When a class of Native Americans challenged REDSKINS as disparaging, there was a lengthy debate about issues of laches and the relevant time period under which disparagement should be judged.⁵⁵ But eventually, relying on considerable evidence of the disparaging nature of the term "redskin," the Trademark Trial and Appeal Board (the TTAB) decided to cancel the REDSKINS mark—twice.⁵⁶ Pro-Football, Inc., the owner of the football team, appealed the TTAB's decision, alleging, among other things, that the disparagement statute was unconstitutional.⁵⁷

⁴⁹ *Georator Corp. v. United States*, 485 F.2d 283, 285 (4th Cir. 1973) (citing 15 U.S.C. § 1051), *abrogated on other grounds by* *NCNB Corp. v. United States*, 684 F.2d 285, 294 (4th Cir. 1982); Tushnet, *First Amendment*, *supra* note 44, at 394.

⁵⁰ *In re Boulevard Entm't*, 334 F.3d 1336, 1343 (Fed. Cir. 2003); *In re McGinley*, 660 F.2d at 484.

⁵¹ *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 921 (6th Cir. 2003).

⁵² In an analysis blocking registration of a mark under the related scandalous section, the Federal Circuit noted,

Nothing in this decision precludes [the mark holder] from continuing to sell her merchandise under the mark at issue, or from seeking trademark protection for some other, otherwise registrable element of her product's design, dress, or labeling. If [the mark holder] is correct that the mark at issue 'bring[s] [nothing] more than perhaps a smile to the face of the prospective purchaser,' . . . then the market will no doubt reward her ingenuity[, regardless of the mark's registration status].

In re Fox, 702 F.3d 633, 639 (Fed. Cir. 2012), *abrogated by* *In re Tam*, 808 F.3d 1321, 1330 n.1, 1333 (Fed. Cir. 2015).

⁵³ *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 448 (E.D. Va. 2015), *vacated*, 709 F. App'x 182 (4th Cir. 2018).

⁵⁴ *Id.* at 450.

⁵⁵ *Id.* at 448, 450.

⁵⁶ *Id.* at 450–51.

⁵⁷ See Pro-Football, Inc.'s Memorandum of Law in Further Support of its Motion for Summary Judgment, and in Opposition to Defendants' and the United States' Motions for Summary Judgment, on Constitutional Claims III-VI at 5, 37, *Pro-Football, Inc. v. Blackhorse*, No. 1:14-cv-1043-GBL-IDD, 2015 WL 4126449 (E.D. Va. Apr. 3, 2015).

The district court upheld the ruling of the TTAB, relying on the sizable amount of precedent limiting the expressiveness of trademarks to marketplace considerations.⁵⁸ Refusal to register a trademark, the court concluded, as courts had concluded before, did not infringe upon speech.⁵⁹ The issue here, as the court was careful to emphasize, was not the trademark itself but its *registration*:

As a threshold matter, throughout the pleadings the parties conflated the legal principles surrounding trademarks with those surrounding trademark *registration*. . . . [T]he Court is . . . compelled to highlight what is at issue in this case—trademark registration, not the trademarks themselves. It is the registrations of the Redskins Marks that were scheduled for cancellation by the TTAB’s decision, not the trademarks. In fact, the TTAB itself pointed out that it is only empowered to cancel the statutory *registration* of the marks under Section 2(a); it cannot cancel the trademarks themselves. . . . Thus, regardless of this Court’s ruling, [the football team] can still use the Redskins Marks in commerce.⁶⁰

Even with the cancellation of the registration, the Washington football team could continue to use its REDSKINS trademark *and* continue to protect it in court.⁶¹ The cancellation, therefore, in the court’s view, had no effect on the ability of the Pro-Football Team to use and vindicate its chosen speech in the marketplace. The use of the mark, whether registered or not, gives it enforceability, and the Lanham Act specifically provides for the protection of unregistered marks by courts.⁶² Registration of a mark is therefore not required, so those wishing to use disparaging marks, like the Washington football team, could continue to do so and continue to be protected in that choice.⁶³

The court focused closely on the harm from the cancellation of the *registration*, which it found was markedly different from a denial of *use*, which was not the situation here.⁶⁴ “[T]he cancellations do not burden, restrict, or prohibit [the football team’s] ability to use the marks. . . . An owner’s ability to use the unregistered mark is unaffected.”⁶⁵

The only speech implicated by *registration* was the publication of the mark in the Principal Register, the database the government maintains of all of its registered trademarks.⁶⁶ The Principal Register, the court found, is informational speech, informing the public of which trademarks the government is protecting.⁶⁷ This made it, in the court’s view, *government* speech:⁶⁸ the Washington

⁵⁸ See *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 455, 490 (E.D. Va. 2015), *vacated*, 709 F. App’x 182 (4th Cir. 2018).

⁵⁹ *Id.* at 455.

⁶⁰ *Id.* at 453.

⁶¹ See 5 MCCARTHY, *supra* note 7, § 27:14.

⁶² *Pro-Football, Inc.*, 112 F. Supp. 3d at 454.

⁶³ *Id.* at 464.

⁶⁴ *Id.* at 453.

⁶⁵ *Id.* at 455–56.

⁶⁶ *Id.* at 457.

⁶⁷ See *id.*

⁶⁸ *Id.*

football team could do whatever it wanted with its trademark; in forcing registration, the only thing the football team would gain, in the court's view, was forcing the *government* to speak about the mark by putting it on the Principal Register.⁶⁹ The denial of registration, in contrast to a denial of use of a trademark, which was not at issue here, simply was not a matter of denial of free speech.⁷⁰

Therefore, this court focused on government speech. The registration communicated government approval of the trademark,⁷¹ the public closely associated registration with the government,⁷² and the government exercised editorial control over what appears in the Principal Register by approving or denying registration.⁷³ The registration of the trademark, the court found, was “a declaration by the federal government” of approval of the mark.⁷⁴ The government was also the *literal* speaker, because the government publishes the Principal Register.⁷⁵

The court did find that the government is not required to *defend* any of the trademarks on the Principal Register.⁷⁶ If someone takes issue with one of them, the court noted, it is the private party that defends it in court.⁷⁷ This, the court admitted, weighed in favor of the trademark registration being private speech rather than government speech.⁷⁸ But this understates the government's role in litigation of federally registered trademarks. While the government might not be in court filing papers, the registration does serve as *prima facie* evidence of the validity of the trademark.⁷⁹ Therefore, the very first step of any trademark litigation—proving that there is a valid mark—is handled by the government registration. Moreover, the government's initial examination of trademarks is meant, *inter alia*, to protect existing registrations from confusing marks, so that the government is expending resources in protecting the marks on the Principal Register from ever having to vindicate their rights in litigation.⁸⁰ The government, therefore, *does* play a meaningful role in defense of trademarks.⁸¹

⁶⁹ *Id.* at 459.

⁷⁰ *Id.* at 457.

⁷¹ *Id.* at 458.

⁷² *Id.* at 458–59.

⁷³ *Id.* at 459.

⁷⁴ *Id.* at 461.

⁷⁵ *Id.*

⁷⁶ *See id.*

⁷⁷ *Id.*

⁷⁸ *Id.* at 462.

⁷⁹ 6 MCCARTHY, *supra* note 7, § 32:138.

⁸⁰ *See In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981) (noting that there is “direct government protection of the mark in that the PTO searches its records and refuses registrations to others of conflicting marks.”), *overruled by In re Tam*, 808 F.3d 1321, 1330 n.1 (Fed. Cir. 2015) (noting that there is “direct government protection of the mark in that the PTO searches its records and refuses registrations to others of conflicting marks”); Drew Jurgensen, *When All You Have is a Hammer, Everything Looks Like a Nail: In re Tam and the Federal*

The trademark registration program was created by Congress, and when Congress creates programs, it can create that program’s limits.⁸² Previous courts found that Congress was seeking to avoid “occupy[ing] the time, services, and use of funds of the federal government” with enforcing certain types of marks.⁸³

The *Pro-Football* court concluded with a correct statement of trademark law: “Courts do not create trademarks”⁸⁴ The court was careful to note that its holding would have no effect on either the football team’s use of the mark or its fans’ use of the mark.⁸⁵ Rather, the future of the REDSKINS mark was entirely “a business judgment beyond the purview of this Court’s jurisdiction.”⁸⁶

III. TAM

Simon Tam sought to register the mark THE SLANTS to identify his band.⁸⁷ While “slant” is a racist slur against Asian Americans,⁸⁸ Tam, an Asian American himself, chose the name in order to “reclaim” the slur.⁸⁹ The PTO, however, refused to register the mark based on its disparaging nature.⁹⁰ Tam appealed,⁹¹ and possibly because he was a more sympathetic mark holder than a professional football team using the racist slur of another group, his case moved speedily through the courts and resulted in a Supreme Court decision.

The stance of the SLANTS and REDSKINS cases were not the same. In the REDSKINS case, the marks were already registered, and an outside group of Native Americans was petitioning to cancel them.⁹² In the SLANTS case, Tam was being blocked from registering his mark by the Trademark Office, with no outside group involved.⁹³ However, their similarities are more important: in both cases, the purported mark holder was deprived of federal registration based on the disparaging nature of the proposed mark. The decisions analyzing these two similar cases could not be more different, though. The

Circuit’s Conflation of Federal Trademark Registration and the First Amendment, 98 J. PAT. & TRADEMARK OFF. SOC’Y 512, 523 (2016).

⁸¹ See *In re Fox*, 702 F.3d 633, 640 (Fed. Cir. 2012) (finding that registration allowed trademark holders “to call upon the resources of the federal government in order to enforce that mark.”).

⁸² See *Pro-Football, Inc.*, 112 F. Supp. 3d at 462.

⁸³ *In re McGinley*, 660 F.2d at 486.

⁸⁴ *Pro-Football, Inc.*, 112 F. Supp. 3d at 490.

⁸⁵ *Id.*

⁸⁶ *Id.*

⁸⁷ *Matal v. Tam*, 137 S. Ct. 1744, 1754 (2017).

⁸⁸ *Id.* at 1751.

⁸⁹ *Id.* at 1751, 1754; see also *id.* at 1767 (Kennedy, J., concurring in part and concurring in judgment).

⁹⁰ *Id.* at 1754.

⁹¹ *Id.*

⁹² See *supra* Section II.A.

⁹³ See *Matal*, 137 S. Ct. at 1754.

REDSKINS case, relying on decades of trademark law, was careful to focus on the commercial aspects of trademarks. The *Tam* court swept those decades away with a different characterization of trademarks: rather than being about distinguishing goods in the marketplace—which the Court acknowledged was the definition of a trademark⁹⁴—the Court asserted that “trademark had expanded far beyond phrases that do no more than identify a good or service.”⁹⁵ The Court basically introduced an entirely new definition of trademark: “catchy phrases that convey a message.”⁹⁶ This is a definition that sounds suspiciously like something we would previously have called protected by copyright.

A. *What Tam Says*

The REDSKINS case focused entirely on *trademark registration* as the harm, emphasizing repeatedly that the football team could continue to use the mark in commerce.⁹⁷ In this way, the REDSKINS case was explicitly not about expression; the football team was still free to express itself in its mark.

The REDSKINS case never mentioned copyright, never addressed viewpoint discrimination, and emphasized the public interest in not having the government invest resources into registering disparaging marks.⁹⁸

Tam, on the other hand, did exactly the opposite. *Tam* immediately began by pronouncing trademarks to be a form of expression. While it paid lip service to the original understanding of the purpose of trademarks⁹⁹ and also acknowledged that registration did not affect the use or protection of marks in the marketplace,¹⁰⁰ it continued to focus its decision on its proclamation that trademarks were really “catchy phrases.”¹⁰¹

The Court therefore disagreed with the REDSKINS court: this was not a case about government speech¹⁰² or government-subsidized speech,¹⁰³ but about private speech.¹⁰⁴ The Court viewed the disparaging statute as viewpoint discrimination, not because it was elevating any particular viewpoint, but be-

⁹⁴ See *id.* at 1751 (quoting *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S.Ct. 1293, 1299 (2015)) (“The principle underlying trademark protection is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan’s goods from those of others.”).

⁹⁵ *Id.* at 1752.

⁹⁶ *Id.*

⁹⁷ See *supra* Section II.A.

⁹⁸ See *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 489 (E.D. Va. 2015), *vacated*, 709 F. App’x 182 (4th Cir. 2018).

⁹⁹ See *Matal*, 137 S. Ct. at 1752 (quoting *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 531 (1987)) (“[T]rademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation.”).

¹⁰⁰ See *id.* (citing 3 MCCARTHY, *supra* note 7, § 19:8).

¹⁰¹ *Id.*

¹⁰² See *id.* at 1760.

¹⁰³ *Id.* at 1761.

¹⁰⁴ *Id.* at 1760.

cause disparagement itself was a viewpoint.¹⁰⁵ For this reason, the disparagement clause was doomed.¹⁰⁶ Simultaneously, however, much as trademarks both do and do not have a message depending on the section of the opinion,¹⁰⁷ the disparagement statute discriminated on the basis of viewpoint and also did not discriminate *enough* on the basis of viewpoint.¹⁰⁸ Apparently if, instead of carefully attempting to prohibit all trademarks of a certain type, the trademark statute had instead prioritized the viewpoints it agreed with, it might have had a better chance of surviving the Court’s review.¹⁰⁹

B. *How Tam Is Wrong*

Tam, a case theoretically all about trademark law, mentions preventing confusion in the marketplace—one of the goals of trademark law¹¹⁰—twice, in passing, in the entire case.¹¹¹ Ordinarily, that purpose is kept at the forefront of trademark analyses.¹¹² Instead, the Supreme Court’s entire analysis is unmoored from trademark law’s traditional underpinnings.¹¹³

Once trademarks are about expression and not the marketplace, then any regulation of them becomes highly suspect. The Supreme Court expressed fear that the disparagement clause “could silence or muffle the *expression* of disfavored viewpoints.”¹¹⁴ But the point of trademarks should not be about expression. Those viewpoints can be widely expressed everywhere. The point of the trademark is the *marketplace*.

¹⁰⁵ See *id.* at 1763.

¹⁰⁶ *Id.*

¹⁰⁷ Compare *id.* at 1752, with *id.* at 1760.

¹⁰⁸ See *id.* at 1764–65.

¹⁰⁹ Justice Thomas’s concurrence argued that he would have applied strict scrutiny whether the speech was commercial or not, arguing that the government cannot restrict “truthful speech.” *Id.* at 1769 (Thomas, J., concurring in part and concurring in the judgment). This adds another layer of complication. While trademark law has an understanding of misleading and deceptive trademarks, and also an understanding of truthful speech in the realm of advertising, it’s unclear what a “truthful” trademark is. Is Apple a truthful trademark? Is Nike? SLANTS might be truthful as applied to a band composed of Asian Americans but REDSKINS applied to a football team with no Native Americans arguably is not. Justice Thomas’s argument further betrays the harmful misunderstanding of trademarks that mere classification of “speech” is doing in the analysis.

¹¹⁰ See *e.g.*, Conrad, *supra* note 45, at 90; Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 410 (1990).

¹¹¹ *Matal*, 137 S. Ct. at 1753.

¹¹² See *e.g.*, *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 319 (4th Cir. 2015); *Stewart Surfboards, Inc. v. Disney Book Grp., LLC*, No. CV 10-2982 GAF (SSx), 2011 WL 12877019, at *1–2, *6 (C.D. Cal. May 11, 2011).

¹¹³ See Tushnet, *First Amendment*, *supra* note 44, at 411 (worrying, prior to the *Matal* opinion, that “the Supreme Court’s condemnation of content-based regulation . . . has now become detached from the underlying justifications that one might reasonably give for worrying about content-based regulation.”).

¹¹⁴ *Matal*, 137 S. Ct. at 1758 (emphasis added).

Because the Court was focused on viewpoint, its entire characterization of the trademark registration process appeared skewed and incorrect. “[A]n examiner does not inquire whether any viewpoint conveyed by a mark is consistent with Government policy or whether any such viewpoint is consistent with that expressed by other marks already on the principal register,”¹¹⁵ stated the Court. But trademarks aren’t about expressing viewpoints, so it only makes sense that trademark examiners are not keeping track of their viewpoints. Indeed, with most trademarks it would be difficult to discern any viewpoint at all to keep track of, other than the viewpoint of marketplace distinction. Examiners *do* inquire whether the mark is consistent with government policy on many grounds (including deceptiveness, genericism, and descriptiveness) and make sure the mark is consistent with other marks already on the principal register in terms of not causing marketplace confusion.¹¹⁶ The fact that this is the focus of the trademark registration process is unsurprising, since that is the focus of trademarks, rather than expressiveness.

The Court also understated the government’s oversight of registered trademarks, implying that, once a trademark is registered, the government has nothing more to do with the trademark.¹¹⁷ The Court noted that there are circumstances where the mark might be removed but used the passive voice to define those circumstances (“the registration expires”).¹¹⁸ The truth, however, is that registrations do not spontaneously expire. Rather, they expire because the government requires periodic confirmation of use and cancels registrations that do not provide it with those confirmations.¹¹⁹ So, in fact, the PTO *is* authorized to remove marks from the registry, and indeed actively polices them for that purpose.¹²⁰

The Court’s characterization of trademarks as forms of expression also skewed the Court’s interpretation of the government speech question. The Court found that the government was not speaking when the government registered trademarks, because instead of viewing that government speech as being about the marks as marketplace tools, the Court cast that speech as being about the marks’ expressive messages:

For example, 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’?¹²¹

¹¹⁵ *Id.*

¹¹⁶ See Tushnet, *First Amendment*, *supra* note 44, at 389–90.

¹¹⁷ *Matal*, 137 S. Ct. at 1758.

¹¹⁸ *Id.*

¹¹⁹ See 3 MCCARTHY, *supra* note 7, § 19:135.

¹²⁰ *Id.*

¹²¹ *Matal*, 137 S. Ct. at 1759.

But, again, this is an odd way to view trademarks. Trademarks are not about directing people to do things (unless that thing is to buy their products). The Court could just as well have asked what the Government had in mind when it advised people to Apple or Nike. Apple and Nike are both trademarks,¹²² doing what trademarks are supposed to do in identifying products, and the absurdity of trying to convert those words into expressive phrases illustrates the wrong footing of the Court’s decision. The Court claimed that “[c]ompanies spend huge amounts to create and publicize trademarks that convey a message.”¹²³ But what those companies spend huge amounts to do is to link their marks with their goods and services. The message the companies are conveying is source identifying in nature. That’s what a trademark *is*.¹²⁴

This is an error the Court made again and again throughout the opinion. The Court asked, “[i]s it conceivable that commerce would be disrupted by a trademark saying: ‘James Buchanan was a disastrous president’ or ‘Slavery is an evil institution’?”¹²⁵ Maybe not, but again, those seem much less like trademarks used to sell goods and much more like slices of political debate.¹²⁶ It is unclear in what way consumers might view those as source-identifying statements,¹²⁷ primarily because the Supreme Court’s analysis has divorced trademarks from their definitional foundation of being used to identify a good or service.

Even if there are some expressive elements to some trademarks, trademark *registration*, which was at issue here, is a commercial decision.¹²⁸ The Court

¹²² Indeed, the protection of slogans itself represents an expansion of trademark law. See Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367, 373–74 (1999). The Supreme Court’s examples could themselves be considered questionable trademarks by some criteria.

¹²³ *Matal*, 137 S. Ct. at 1760.

¹²⁴ See *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 319, 321 (4th Cir. 2015) (“Trademarks designate the source or affiliation of goods and services in order to provide consumers with information *about those goods and services*, allowing mark holders to build and benefit from the reputation of their brands.”) (emphasis added); *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 922 (6th Cir. 2003); Grynberg, *supra* note 47, at 185; Ned Snow, *Free Speech & Disparaging Trademarks*, 57 B.C. L. REV. 1639, 1653 (2016); Tushnet, *First Amendment*, *supra* note 44, at 395.

¹²⁵ *Matal*, 137 S. Ct. at 1765.

¹²⁶ *Radiance Found.*, 786 F.3d at 327; Grynberg, *supra* note 47, at 190; Kuckes, *supra* note 47, at 133.

¹²⁷ See *Radiance Found.*, 786 F.3d at 329; *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.* 134 F.3d 749, 753 (6th Cir. 1998) (“[I]n order to be protected as a valid trademark, a designation must create ‘a separate and distinct commercial impression, which . . . performs the trademark function of identifying the source of the merchandise *to the customers.*’”) (emphasis added) (quoting *In re Chem. Dynamics, Inc.* 839 F.2d 1569, 1571 (Fed. Cir. 1988)); Grynberg, *supra* note 47, at 190.

¹²⁸ Jurgensen, *supra* note 80, at 514.

acknowledged that trademarks are established via use and not registration,¹²⁹ but then found that registration affected use because without registration the mark holder would lose, (1) the ability to stop imports into the country, (2) the *prima facie* validity that could be asserted in court, (3) the “constructive notice” served by being on the government’s searchable list of trademarks, (4) and the ability to become “incontestable.”¹³⁰ While *Tam* accurately listed the effects of registration, it provided the impression that these benefits are more advantageous than they really are. One commentator characterized registration as the “T.S.A. Pre-Check” of trademarks:¹³¹ a nice, valuable, and encouraged bonus, but not necessarily disastrous to be without. While it is unmistakably valuable to be *prima facie* valid, it is not necessarily saving time or resources in litigation: “[N]o plaintiff’s attorney will introduce the registration as the sole evidence of rights in the mark.”¹³² The “constructive notice” provision is helpful, but in the age of the internet such notice can be easily supplied by a simple Google search. Moreover, incontestability sounds like a wonderful thing to achieve, except for the fact that “incontestable” trademarks can actually be contested on many grounds.¹³³ Finally, the ability to block importation is unmistakably valuable but also controversial.¹³⁴

At any rate, *Tam*, a case theoretically about trademark registration, is mostly unconcerned with the ins and outs of trademark registration. *Tam*, at heart, is a decision that imagines itself as defending the marketplace of ideas through the First Amendment (even if those ideas are each owned by a single source). *Tam* itself acknowledged, though, that a marketplace flooded with ideas does not need trademark registration to protect it: “The commercial market is well stocked with merchandise that disparages prominent figures and groups.”¹³⁵ By the Court’s own admission, a lack of trademark registration does not appear to be blocking these viewpoints from the marketplace.¹³⁶ Given that observation, *Tam* stands out even more starkly.

¹²⁹ *Matal*, 137 S. Ct. at 1751–52 (“[F]ederal law does not create trademarks.”) (quoting *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299 (2015)).

¹³⁰ *Id.* at 1753.

¹³¹ Sarah Jeong, *Should We Be Able to Reclaim a Racist Insult—as a Registered Trademark?*, N.Y. TIMES (Jan. 17, 2017), <https://www.nytimes.com/2017/01/17/magazine/should-we-be-able-to-reclaim-a-racist-insult-as-a-registered-trademark.html> [<https://perma.cc/4Y2U-9CBW>].

¹³² 6 MCCARTHY, *supra* note 7, § 32:154, at 32-379, n.3 (“No one to my knowledge has relied in a court action upon his registration to prove his right to the trademark. Nor is anyone likely to do so.” (quoting Leslie D. Taggart, *The Trial of a Trademark Case Before and After the Lanham Act*, 62 TRADEMARK REP. 103, 105 (1972))).

¹³³ *See id.* § 32:147.

¹³⁴ *See id.* § 29:44.

¹³⁵ *Matal*, 137 S. Ct. at 1765.

¹³⁶ Subsequent cases have continued to advance this confusing contradiction. A lack of trademark registration both simultaneously chills speech and does nothing to chill speech. *See In re Brunetti*, 877 F.3d 1330, 1348, 1353 (Fed. Cir. 2017).

IV. WHY TAM IS DANGEROUS

Tam's sweeping proclamations treating trademarks as important expressive speech ignored decades of defining trademarks as *not* expressive speech. Previous courts had acknowledged the "communicative" value of trademarks as "symbols through which the public identifies the team and its players,"¹³⁷ linking the expressiveness of marks with their place in the consumer marketplace. "If it is true that we live by symbols, it is no less true that we purchase goods by them," proclaimed the Supreme Court in an early trademark decision.¹³⁸

As has been noted, courts had previously found that "no tangible form of expression [was] suppressed" by lack of trademark registration.¹³⁹ Rather, because the public (as well as the trademark holder) could continue to discuss a trademark, regardless of its registration status, free speech was not implicated.¹⁴⁰ The expressive value of the trademark seemed to be understood to belong to the *consumers* who needed to be able to utilize it in a crowded marketplace.

Trademarks are properly understood as tools by which marketplace competition is streamlined and maximized; *copyrights* are expressive speech. Copyrights concern "original works of authorship."¹⁴¹ Trademarks, on the other hand, are defined as "any word, name, [or] symbol . . . used . . . to identify and distinguish his or her goods . . ."¹⁴² They are defined by their role in the marketplace and, indeed, unlike copyrights, which exist as soon as an original work is fixed in a tangible medium of expression,¹⁴³ are developed only by and through consistent use in commerce.¹⁴⁴ For this reason, under the disparagement statute, the Trademark Office did not judge the objective disparaging nature of the word at issue but rather its meaning as "used in connection with the goods and services identified in the registrations."¹⁴⁵ Trademarks are generally understood in the context of their "secondary" marketplace meaning linked to

¹³⁷ See *Pro-Football, Inc. v. Blackhorse*, 62 F. Supp. 3d 498, 500 (E.D. Va. 2014).

¹³⁸ *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942).

¹³⁹ *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981).

¹⁴⁰ See *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 455 (E.D. Va. 2015), *vacated*, 709 F. App'x 182 (4th Cir. 2018).

¹⁴¹ 17 U.S.C. § 102 (2018).

¹⁴² 15 U.S.C. § 1127 (2018); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (quoting 15 U.S.C. § 1127 (2018)).

¹⁴³ See, e.g., *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 125 (D. D.C. 2003) (quoting *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1739, 1999 WL 375907, at *36 (T.T.A.B. 1999)).

¹⁴⁴ See, e.g., *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918) ("[T]he right to a particular mark grows out of its use . . ."); 2 MCCARTHY, *supra* note 7, § 16:1.

¹⁴⁵ *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981), *abrogated by In re Tam*, 808 F.3d 1321 (F. Cir. 2015); see also *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080, 2014 WL 2757516, at *4 (T.T.A.B. 2014) (citations omitted); *In re Blvd. Entm't*, 334 F.3d 1336, 1340 (Fed. Cir. 2003) citing *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981).

goods or services.¹⁴⁶ Even where secondary meaning was not required to protect the trademark, trademarks “provide[] a powerful way for a seller to promote and distinguish his or her products or services in the commercial marketplace.”¹⁴⁷ Indeed, commentators have argued that where a term is too expressive it might not be able to effectively serve as a trademark.¹⁴⁸

Trademarks were therefore defined by their role in the marketplace, rather than as tools of expression. Courts had considered the Lanham Act constitutional based on its regulation of this important *commercial* speech.¹⁴⁹ Expressive speech, more robustly protected by the First Amendment, occurred when trademarks were *not* being used in their trademark sense. Courts were able to draw a delineation in that way.¹⁵⁰ Courts had generally been careful to apply the Lanham Act to *marketplace* interactions while leaving expressive occurrences unregulated.¹⁵¹ When a trademark had elements of both in its use, the courts developed an entirely separate test for balancing the goals of the trademark laws and the First Amendment.¹⁵² In doing so, courts used the purpose of trademark law as preventing marketplace confusion to guide the limits of trademark statutes.¹⁵³

The Supreme Court, however, throughout *Tam*, rather than using trademark law’s purpose or examining whether the mark was being used commercially or expressively, insisted repeatedly that marks were simultaneously both commercial and expressive. This effectively eliminates the idea that marks could ever be regulated as commercial speech. In this way, *Tam* destabilizes decades of trademark jurisprudence beyond just the disparagement statute.

Tam was fixated on the government’s inability to regulate copyrights in the way that it was regulating trademarks, as if they were equivalent and interchangeable species of intellectual property.¹⁵⁴ The answer, of course, is that a ruling on a trademark is not identical to a ruling on a copyright because they are two very distinct pieces of intellectual property. Trademarks and copyrights do not have the same definitions,¹⁵⁵ requirements,¹⁵⁶ registration process,¹⁵⁷ re-

¹⁴⁶ *Friedman v. Rogers*, 440 U.S. 1, 12 (1979); *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 327 (4th Cir. 2015); Steven Wilf, *Who Authors Trademarks?*, 17 *CARDOZO ARTS & ENT. L.J.* 1, 33 (1999).

¹⁴⁷ Kuckes, *supra* note 47, at 127.

¹⁴⁸ See Grynberg, *supra* note 47, at 179; Wilf, *supra* note 146, at 37.

¹⁴⁹ *Taubman Co. v. Webfeats*, 319 F.3d 770, 774 (6th Cir. 2003).

¹⁵⁰ See *id.*; *Stewart Surfboards, Inc. v. Disney Book Grp., LLC*, No. CV 10-2982 GAF (SSx), 2011 WL 12877019, at *3 (C.D. Cal. May 11, 2011).

¹⁵¹ See, e.g., *Taubman*, 319 F.3d at 776–78; Tushnet, *First Amendment*, *supra* note 44, at 385.

¹⁵² See *Stewart Surfboards*, 2011 WL 12877019, at *3.

¹⁵³ *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 321–22 (4th Cir. 2015) (“The Lanham Act and First Amendment may be in tension at times, but they are not in conflict so long as the Act hews faithfully to the purposes for which it was enacted.”)(citations omitted).

¹⁵⁴ See *Matal v. Tam*, 137 S. Ct. 1744, 1760 (2017).

¹⁵⁵ See 1 MCCARTHY, *supra* note 7, § 6:3.

¹⁵⁶ See *id.*

newal process,¹⁵⁸ terms of enforcement,¹⁵⁹ rights of enforcement,¹⁶⁰ constitutional justification,¹⁶¹ statutory schemes,¹⁶² common law precedent,¹⁶³ or traditional policy goals.¹⁶⁴ The only way a difference in legal treatment between copyrights and trademarks is problematic is if trademarks and copyrights are the same thing.

If the Court’s view of trademarks was that they are expressive, it makes sense that the Court seemed determined to equate them with copyrights: that is, in fact, exactly what that statement means. The Court explicitly acknowledged as much when it expressed that there is no reason to treat trademarks and copyrights differently if both doctrines revolve around expressive speech.¹⁶⁵ The Court equated the registration of trademarks and copyrights because it was treating them identically.¹⁶⁶ The Court kept requiring the government to explain why it did not monitor disparaging copyrights, unpersuaded by the fact that the reason for this is that copyright and trademarks serve two different functions in society.¹⁶⁷ This equating of copyrights and trademarks has continued, unsurprisingly, in the cases applying *Tam*.¹⁶⁸

This is especially confusing given the Court’s recent ruling in *Dastar*,¹⁶⁹ which seemed to acknowledge that trademarks and copyrights serve different functions that should be kept separated. There, the Court was “‘careful to caution against misuse or over-extension’ of trademark and related protections.”¹⁷⁰ Here, the Court seems less concerned.

It seems that what has happened here is the Court has succumbed to the copymark creep that has been happening between these two doctrines over the course of the past few decades. Much as copyright holders have persistently tried to use trademark law to expand beyond the limits of copyright protection, seeking “permanent copyrights” in trademark’s indefinite term and attempting

¹⁵⁷ *See id.* § 6:13.

¹⁵⁸ *See id.*

¹⁵⁹ *See id.*

¹⁶⁰ *See id.* § 6:14.

¹⁶¹ *See id.* § 6:2.

¹⁶² *See id.* § 6:13.

¹⁶³ *See id.*

¹⁶⁴ *See id.* § 6:3.

¹⁶⁵ *See Matal v. Tam*, 137 S. Ct. 1744, 1760 (2017) (“[t]he Government attempts to distinguish copyright on the ground that it is ‘the engine of free expression,’ . . . but as this case illustrates, trademarks often have an expressive content”) (citations omitted) (quoting *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003)).

¹⁶⁶ *Id.*

¹⁶⁷ *Matal*, 137 S. Ct. at 1760.

¹⁶⁸ *See In re Brunetti*, 877 F.3d 1330, 1357 (Fed. Cir. 2017) (“[n]o doubt many works registered with the Copyright Office offend a substantial composite of the general public. There are words and images that we do not wish to be confronted with, not as art, nor in the marketplace.”).

¹⁶⁹ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003).

¹⁷⁰ *Id.* at 34 (citations omitted).

to equate copyright infringement inquiries of substantial similarity with trademark's consumer confusion tests,¹⁷¹ trademark holders have simultaneously sought the expansiveness of *their* rights with the more robust First Amendment protection placed around copyrighted works. This has led to a situation where the lines between copyright and trademark have become so blurred as to become indistinguishable. The Supreme Court in *Tam* had an opportunity to redefine the line and instead embraced its fuzziness. In fact, the Supreme Court even obscured the fuzziness it was introducing, insisting that the decision it was making presented “no difficult question,”¹⁷² even though it could not cobble together a majority of support for all parts of its underlying reasoning.¹⁷³

This is dangerous because the doctrines of trademark and copyright are both important and work in tandem to provide the best of both worlds: a vibrant creative culture and a clear competitive marketplace. Conflating the two risks losing this multi-layered richness in favor of the primacy of one over the other—or, even worse, ensuring the creative culture and the competitive marketplace are simply one and the same. *Tam* especially seems to provide the Supreme Court's blessing to making trademarks look more like copyrights—which has troubling implications in a number of ways.

A. Consumer Protection

Trademark, unlike copyright, was traditionally about *consumer protection*.¹⁷⁴ This makes it market focused and regulated and hence a very different doctrine from copyright law. The limits on trademark registration spring from Congressional concern about particular consumer issues,¹⁷⁵ but the Court in *Tam* was dismissive of consumer protection being used to justify the Trademark Office's regulations. The argument that the disparagement statute had been intended to protect consumers in the marketplace was met with disdain by the Court when it collided with the First Amendment; the First Amendment won the battle handily.¹⁷⁶ In a world where trademarks' consumer protective functions are secondary to the First Amendment, where does that leave the Lanham Act's other consumer protective regulations?

Tam, carried to its conclusion, states that anything preventing trademark registration could be a First Amendment infringement—and the Trademark Office has multiple regulations that in the wake of *Tam* look like at least content-based restrictions on speech.¹⁷⁷ “Trademark registration is in its entirety about

¹⁷¹ See Lantagne, *supra* note 5, at 462, 467, 496.

¹⁷² *Matal*, 137 S. Ct. at 1760–61.

¹⁷³ See Conrad, *supra* note 45, at 89; Kuckes, *supra* note 47, at 122–23.

¹⁷⁴ 1 MCCARTHY, *supra* note 7, § 2:24.

¹⁷⁵ See *supra* Part III.

¹⁷⁶ See *Matal*, 137 S. Ct. at 1764.

¹⁷⁷ See Snow, *supra* note 124, at 1641, 1662 (“At its core, trademarks function through content discrimination.”).

regulating speech”¹⁷⁸ As Rebecca Tushnet has argued, “disparagement can’t coherently be distinguished from a number of the other bars to registration once the harsh logic of the First Amendment applies.”¹⁷⁹

For instance, several trademark regulations refuse the registration of marks that are deceptive.¹⁸⁰ This protects consumers from a variety of misleading marks that would complicate buying decisions. It does not seem viable, however, to treat trademarks as commercial speech for some purposes and expressive speech for others,¹⁸¹ especially not when the Supreme Court in *Tam* seems to support a default of treating trademarks as expressive, full stop. What justification is there to protect consumers from deception if doing so would stifle the trademark holder’s ability to speak?¹⁸² Deceptiveness would seem to be as much a viewpoint as disparagement.¹⁸³ Indeed, arguably REDSKINS is a deceptive mark, as the football team is not known for its Native American players. Could the mark be cancelled as deceptive, rather than disparaging?

At any rate, while subsequent analyses have seemed careful to leave plenty of room for the Lanham Act to continue to regulate misleading or deceptive marks,¹⁸⁴ it is unclear if *Tam*’s analysis should at least require a re-examination of the PTO’s standards.¹⁸⁵ After all, the PTO’s standards for analyzing deceptiveness do not depend on any kind of objective deceptiveness so much as they depend on consumer belief about the viewpoint that mark is conveying.¹⁸⁶ This test looking at consumer perception is similar to the test for disparagement and would seem to be questionable for its reliance on consumer viewpoint to settle the question. On the other hand, it would be impossible to ask the PTO to judge deceptiveness outside of the context of consumer viewpoint, given that trademarks are about *marketplace* messages. Does that leave the PTO’s regulation of deceptiveness questionable altogether?

One assumes that the traditional prohibitions against fraud or other false speech could be applied,¹⁸⁷ but this would require strict showings that might be difficult to establish,¹⁸⁸ especially for a consumer. Finally, it is simply not clear from the Court’s ruling in *Tam* how to distinguish deceptiveness from disparaging marks. The *Tam* Court’s understanding of viewpoint discrimination was ex-

¹⁷⁸ Tushnet, *First Amendment*, *supra* note 44, at 395.

¹⁷⁹ *Id.* at 383.

¹⁸⁰ *See id.* at 407; Rebecca Tushnet, *Trademark Law as Commercial Speech Regulation*, 58 S.C. L. REV. 737, 750 (2007) [hereinafter Tushnet, *Trademark Law*].

¹⁸¹ *See* Snow, *supra* note 124, at 1659.

¹⁸² *See* Conrad, *supra* note 45, at 133; Snow, *supra* note 124, at 1642.

¹⁸³ *See* Snow, *supra* note 124, at 1678; Tushnet, *First Amendment*, *supra* note 44, at 420.

¹⁸⁴ *See In re Brunetti*, 877 F.3d 1330, 1350 (Fed. Cir. 2017).

¹⁸⁵ *See* Tushnet, *First Amendment*, *supra* note 44, at 412; Tushnet, *Trademark Law*, *supra* note 180, at 739.

¹⁸⁶ *See* Snow, *supra* note 124, at 1679; Tushnet, *First Amendment*, *supra* note 44, at 396.

¹⁸⁷ *See* *Matal v. Tam*, 137 S. Ct. 1744, 1765 (2017) (Kennedy, J., concurring in part and concurring in the judgment).

¹⁸⁸ *See* Tushnet, *Trademark Law*, *supra* note 180, at 739, 748.

tremely broad on the one hand and extremely narrow on the other.¹⁸⁹ Where does the viewpoint of “deceiving people” fall on this spectrum, in the vacuum of *Tam* that is not concerned with confusion? Moreover, the concurrence casually stated that misleading trademarks and other consumer protection measures will survive this ruling, singling the disparagement clause out as being *more* about speech than other provisions of the trademark statute.¹⁹⁰ But there is little explanation for *how* that distinguishing should happen in practice.

Nor is the idea that *Tam* has called into question other aspects of the Lanham Act far-fetched, as the statute’s prohibition on immoral and scandalous marks has already been declared unconstitutional based on *Tam*’s First Amendment analysis.¹⁹¹ The government’s main argument in the case at issue was, again, dependent on trademarks not being considered expressive speech.¹⁹² However, given *Tam*’s reasoning, that argument was a non-starter.¹⁹³ The court echoed the definition of trademarks that emphasized their expressiveness: “[T]rademarks exist to convey messages throughout commerce.”¹⁹⁴ This is a true statement, but the content of those messages was always understood to be *about* the commercial transaction, rather than untethered from the goods or services the trademarks identify.¹⁹⁵

The sweeping language of *Tam* likewise could have implications for descriptive marks.¹⁹⁶ Trademark law limits the registration of descriptive marks, restricting protection to only those situations where the marks have gained a secondary meaning.¹⁹⁷ The reason for this is that we have traditionally worried that such marks convey not entirely source-identifying information but rather other information about the good or service, which must be available to use by others in the marketplace.¹⁹⁸ However, the *Tam* Court undercuts that justification by failing to resolve the dispute on that particular point. *Tam* and his *amici* argued that some “trademarks do not simply identify the source of a product or service but go on to say something more, either about the product or service or some broader issue,”¹⁹⁹ and the Court agreed that that was the case here and then explicitly dodged resolving the issue.²⁰⁰ In this way, the Court left open the question that trademarks that “say something” about a product or service might be entitled to greater protection—exactly what descriptive trademarks

¹⁸⁹ See *Matal*, 137 S. Ct. at 1765.

¹⁹⁰ See *id.* at 1768 (Kennedy, J., concurring in part and concurring in the judgment).

¹⁹¹ See *In re Brunetti*, 877 F.3d 1330, 1335 (Fed. Cir. 2017).

¹⁹² *Id.* at 1342.

¹⁹³ See *id.* at 1344.

¹⁹⁴ *Id.* at 1347.

¹⁹⁵ See Lunney, *supra* note 122, at 394; Snow, *supra* note 124, at 1657.

¹⁹⁶ See *id.* at 1641; Tushnet, *First Amendment*, *supra* note 44, at 410.

¹⁹⁷ See Grynberg, *supra* note 47, at 186; Snow, *supra* note 124, at 1656; Tushnet, *First Amendment*, *supra* note 44, at 381.

¹⁹⁸ See 2 MCCARTHY, *supra* note 7, § 11:18.

¹⁹⁹ *Matal v. Tam*, 137 S. Ct. 1744, 1764 (2017).

²⁰⁰ *Id.* (“We need not resolve this debate.”).

might be classed as.²⁰¹ Indeed, arguably SLANTS itself could have been termed descriptive of the members of the Asian American band it is identifying,²⁰² far more so than REDSKINS is descriptive of the football team. Could SLANTS—a trademark imbued with so much expressive value by the Court—be cancelled as descriptive? Or would that be too much of an infringement of Tam’s free speech?

Brunetti applied helpful limiting language to *Tam*’s analysis, discussing the provisions of the Lanham Act, at least in passing, with their purpose in terms of consumer protection.²⁰³ But, continuing the trend set in *Tam*, that portion of the analysis was cursory and tangential, with the greater part of the focus being on the expressive speech of trademarks rather than the statute’s consumer protection goals.²⁰⁴ Moreover, *Brunetti* continued the tendency to make broad, generalized statements about trademark law: “[T]he government does not have a substantial interest in promoting certain trademarks over others,”²⁰⁵ the court proclaimed, even though it seemed like even the court thought that the government *does* have a substantial interest in promoting *non-deceptive* trademarks.²⁰⁶ But such a broad, declarative statement makes it sound like that is not true, after all.

Trademark regulations also prevent the registration of marks that are “primarily merely a surname. . . .”²⁰⁷ Traditionally, this was to make sure that no one person (or, more likely, corporation) could own a name without having developed a secondary meaning to justify that ownership.²⁰⁸ The fear was owning a name could prevent all others with that name from using it.²⁰⁹ However, *Tam* has flipped that concern around: if a surname mark is expressive, what is the justification for other people preventing you from registering it?²¹⁰

Trademark law also does not allow anyone to own a “generic” term, leaving that to the public for general use.²¹¹ But, again, is there any justification for refusing to allow people the “expression” of owning particular terms?²¹² There must be—but unfortunately *Tam*’s ruling leaves it to future courts to delineate a line in *Tam*’s fuzziness.

²⁰¹ See Kuckes, *supra* note 47, at 160; Tushnet, *Trademark Law*, *supra* note 180, at 749.

²⁰² See Snow, *supra* note 124, at 1657–58.

²⁰³ See *In re Brunetti*, 877 F.3d 1330, 1349 (Fed. Cir. 2017).

²⁰⁴ See *id.*

²⁰⁵ *Id.* at 1351.

²⁰⁶ See *id.* at 1350.

²⁰⁷ 15 U.S.C. § 1052(e)(4) (2018).

²⁰⁸ See Wilf, *supra* note 146, at 37.

²⁰⁹ *Id.* at 38.

²¹⁰ See *id.* at 36–37 (noting that this regulation is based on content).

²¹¹ See, e.g., *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 186 (1896); Dreyfuss, *supra* note 110, at 403; Grynberg, *supra* note 47, at 186; see also Tushnet, *First Amendment*, *supra* note 44, at 424.

²¹² See Tushnet, *First Amendment*, *supra* note 44, at 399; Wilf, *supra* note 146, at 40.

B. Dilution Issues

Commentators have had many issues with dilution law over the years.²¹³ Dilution is an extremely expansive area of the law that has sometimes been thought to be in danger of swallowing all of trademark law whole.²¹⁴ However, trademark holders have generally believed that dilution law is a necessary protection.²¹⁵

Dilution law might be unconstitutional under *Tam*'s standards. Dilution law prohibits anyone from "tarnishing" a famous trademark, but "tarnishment" seems like a form of viewpoint discrimination equal to "disparagement." Tarnishment occurs when a "trademark is . . . portrayed in an unwholesome or unsavory context likely to evoke unflattering thoughts about the owner's product."²¹⁶ The only speech targeted is that which harms reputation, while that which provokes flattering thoughts can avoid a tarnishment label.²¹⁷ Indeed, because dilution law is often as separated from the traditional confusion-avoiding goals as *Tam* itself,²¹⁸ *Tam* seems tailor-made to be applied to dilution. If trademark law cannot regulate disparagement, why should it be able to regulate tarnishment? Trademark holders may have gained a major victory in *Tam*, but they may not be pleased with the result as applied to dilution law.

C. Destroying Public Debate and Conversation

The most alarming thing *Tam* does, is in fact what *Tam* claimed it was striving not to do, potentially destroy public debate and conversation. *Tam* weighed the public interest as belonging to the commercial entities holding trademarks, rather than, as other courts had, to the public consumers engaging with the marketplace.²¹⁹ In this way, *Tam* provides the trademark owner with rights without adequate regard for the social cost exacted in exchange.²²⁰ *Tam* has elevated all trademarks to the "special circumstance" of a "broader public interest" than solely marketplace considerations that the Court had previously discussed.²²¹

²¹³ See, e.g., Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1698 (1999); Jeremy N. Sheff, *Veblen Brands*, 96 MINN. L. REV. 769, 777 (2012).

²¹⁴ See Lemley, *supra* note 213, at 1699.

²¹⁵ See, e.g., Dreyfuss, *supra* note 110, at 403; Lemley, *supra* note 213, at 1699.

²¹⁶ *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 43 (2d Cir. 1994).

²¹⁷ See *Matal v. Tam*, 137 S. Ct. 1744, 1765–66 (2017) (Kennedy, J., concurring in part and concurring in the judgment).

²¹⁸ See 15 U.S.C. § 1125(c)(1) (2018); *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 329 (4th Cir. 2015).

²¹⁹ See *Pro-Football, Inc. v. Blackhorse* 112 F. Supp. 3d 439, 489 (E.D. Va. 2015), *vacated*, 709 F. App'x 182 (4th Cir. 2018) (finding that the public had an interest in being free of registered disparaging marks).

²²⁰ See Lemley, *supra* note 213, at 1697 (discussing this trend in trademark jurisprudence).

²²¹ *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 537 (1987).

Tam, in so casually dismissing the very definition of a trademark as identifying a source of a good in commerce, seems to eliminate much of the teeth behind the idea of commercial speech.²²² If trademarks, the quintessential marketplace communication, are expressive, after all, there is probably nothing that any entity can do that is not expressive. And this is explicitly the opposite of the First Amendment problem that scholars used to worry would result from trademark law.

For most of trademark jurisprudence, courts worried that granting trademarks over expressive speech would threaten free speech: “But when a trademark owner asserts a right to control how we express ourselves . . . [,] the full weight of the public’s interest in free expression” had to be taken into account.²²³ Courts, instead of defining trademarks as conveying the trademark holder’s expression, were actually concerned when a trademark had “a meaning beyond its source-identifying function.”²²⁴ Granting ownership over those trademarks, it was thought, threatened the ability of *any other person* to express those expressive ideas, and that seemed like a limitation and destruction of public debate.²²⁵ “[W]hen symbols take on a set of non-source-identifying meanings in popular culture, it is argued that the public has an interest in accessing and even modifying those meanings in cultural discourse, irrespective of the interests of the mark owner.”²²⁶ After all, “[o]ur language and our culture are impoverished when we cannot use the most familiar words to discuss—or make fun of, or criticize—the products and companies that are the basis of our economy.”²²⁷

In this way, it was a First Amendment violation to permit any one entity to own expressive speech and exclude others from using that speech.²²⁸ “The risk of impinging on protected speech is much greater when trademarks serve not to identify goods but rather to obstruct the conveyance of ideas, criticism, comparison, and social commentary.”²²⁹ In such a situation, the trademark is not identifying the source; rather, the trademark is identifying the message “that the [user] supports the ideas and messages conveyed by” the expressive mark.²³⁰

The First Amendment, it has long been understood, exists to “guarantee[] . . . the liberty to discuss publicly and truthfully all matters of public concern

²²² See Conrad, *supra* note 45, at 146; Kuckes, *supra* note 47, at 126.

²²³ *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002); see also Dreyfuss, *supra* note 110, at 409–10.

²²⁴ *MCA Records*, 296 F.3d at 900.

²²⁵ See *id.*; *Girl Scouts of the U.S. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 808 F. Supp. 1112, 1118–19 (S.D.N.Y. 1992).

²²⁶ Sheff, *supra* note 213, at 815.

²²⁷ Lemley, *supra* note 213, at 1696.

²²⁸ *Mattel, Inc., v. Walking Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003); Tushnet, *First Amendment*, *supra* note 44, at 423.

²²⁹ *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 322 (4th Cir. 2015).

²³⁰ Grynberg, *supra* note 47, at 190.

without previous restraint . . . ,”²³¹ with a “profound national commitment to the principle that debate on public issues should be uninhibited, robust, and wide-open”²³² In supporting the idea that people must be permitted to own *expressive* speech, the Supreme Court jeopardizes that very lack of restraint on public issues. In classifying trademarks as expressive, the Supreme Court has turned public debate into a regulated commercial marketplace, “restrict[ing] the speech of some elements of our society in order to enhance the relative voice of others”²³³ This is an act that in itself the Court has found to be “wholly foreign to the First Amendment.”²³⁴ Here, it is the very result the Court, in the name of the First Amendment, has welcomed.

In *Tam*, the Supreme Court has invited a trademark regime where, in fact, trademark holders can stifle public debate by registering a multitude of expressive trademarks. *Tam* assumes that, to the extent trademarks have a message to convey, that message is that of the trademark holder,²³⁵ whereas other commentators in other contexts have argued that *consumers* convey a message with the trademarked goods and services that they purchase.²³⁶ As one commentator noted in the context of post-sale confusion trademark infringement cases, the entity was “selling others the means to express a message . . . but [was] not expressing such a message” itself.²³⁷ The consumer’s First Amendment right in expression is nowhere to be found in the *Tam* opinion.

Instead, *Tam* allows entities to trademark the most disparaging things people can say about them—mainly, to be able to use trademark protections to sue people who say those disparaging things about them.²³⁸ While trademark protection is limited to the goods and services on which those marks are used, there have already been some attempts to use trademarks on services described as “[p]roviding information,”²³⁹ which sounds suspiciously close to just possessing a trademark on discussion. Even if such trademarks are rejected by the Trademark Office as being commercially inappropriate (and assuming the courts will agree that the Trademark Office is permitted to deprive the speaker of these trademark rights), the ongoing expansiveness of trademark rights has allowed for at least the impression that capturing the cultural conversation on goods that matter to public debate, such as hats and t-shirts, is not only straightforward but encouraged and, indeed, the “right” way to do things. For instance,

²³¹ *Thornhill v. Alabama*, 310 U.S. 88, 101 (1940).

²³² *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 270 (1964) (citation omitted).

²³³ Sheff, *supra* note 213, at 775 (quoting *Buckley v. Valeo*, 424 U.S. 1, 48–49 (1976)).

²³⁴ *Id.*

²³⁵ See *supra* Part III and Section III.A.

²³⁶ See *Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches, Inc.*, 221 F.2d 464, 466 (2d Cir. 1955); Sheff, *supra* note 213, at 804, 807;

²³⁷ Sheff, *supra* note 213, at 809.

²³⁸ See Lemley, *supra* note 213, at 1696 (noting, years prior to *Tam*, that allowing the registration of trademarks that were not source-identifying was allowing the holder “to lock up the use of the . . . phrase”).

²³⁹ *In re Geller*, 751 F.3d 1355, 1357 (Fed. Cir. 2014).

the person who was seeking to register THE PISS TAPE IS REAL on a variety of merchandise was explicitly inspired by *Tam* to use his trademark to attack the President²⁴⁰—which does not sound like much of a marketplace use at all. The application has since been abandoned, but the perception lingers in the wake of *Tam* that trademarks are supposed to be used to tie up political speech.

In this way, the *Tam* ruling could allow disparaging viewpoints to be driven from the marketplace far more effectively than refusal of trademark registrations ever did, because it explicitly allows for people to own particular disparaging statements to the exclusion of other people using those statements.²⁴¹ Indeed, some people expressed the view that they had already applied to register disparaging marks solely to keep other people from doing so.²⁴² The general public seemed to take that as the lesson from *Tam*: “[T]hey desire[] to trademark the word to prevent others from using it negatively.”²⁴³ Their understanding seems to be that the Supreme Court has given the go-ahead to control political debate using trademark law—and, to be honest, as has been discussed, it is hard to quarrel with that reading of the Supreme Court’s opinion.²⁴⁴

Theoretically, there is a commercial boundary around the reach of trademark law that would allow cultural conversation to still occur, but *Tam*’s sweeping statements and the realities of twenty-first century litigiousness mean that plenty of purely expressive speech can be chilled by ownership.²⁴⁵ Moreover, the expansion of many trademarks into merchandising increases the likelihood that ownership of expressive trademarks will control the public’s own expression of messages,²⁴⁶ since merchandising by its very definition detaches the

²⁴⁰ See Sarah Jeong, *A Supreme Court Ruling Has Opened the Floodgates to a Stream of Gross Trademarks*, THE VERGE (July 25, 2017), <https://www.theverge.com/2017/7/25/16020666/us-trademark-law-disparaging-the-piss-tape-is-real> [<https://perma.cc/LCN4-2URR>].

²⁴¹ See, e.g., *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 321 (4th Cir. 2015) (“Trademark infringement laws limit the ability of others to use trademarks or their colorable imitations in commerce . . .”).

²⁴² See Tim Lince, *Numerous ‘Offensive’ Trademark Applications Filed Following Tam Ruling; Applicants Reveal Commercial Hopes and Exploitation Fears*, WORLD TRADEMARK REV. (June 26, 2017), <https://www.worldtrademarkreview.com/portfolio-management/numerous-offensive-trademark-applications-filed-following-tam-ruling> [<https://perma.cc/JF22MJ9Q>].

²⁴³ Abbey White, *People are Filing Trademark Applications to ‘Own’ the Swastika and the N-Word*, VOX (July 31, 2017), <https://www.vox.com/identities/2017/7/31/16068972/trademarking-n-word-swastika-slants-supreme-court> [<https://perma.cc/PAZ6-H9JC>].

²⁴⁴ Perhaps the most fitting indication of the confusion embodied in the Court’s *Tam* ruling is the correction at the end of the *Vox* article: “An earlier version of this story’s headline used the word copyright instead of trademark.” *Id.* People have been confused about trademarks and copyrights for a while now; *Tam* certainly did not help.

²⁴⁵ See, e.g., *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) (refusing to let a party use a mark in its movie because the party could get its point across in other ways); Lemley, *supra* note 213, at 1696, 1711–12.

²⁴⁶ See, e.g., *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d 1635, 1988 WL 252489, at *7 (T.T.A.B. Mar. 30, 1988) (finding that there was a likelihood of confusion between two marks when they were both going to be used on t-shirts); see also Conrad, *supra* note 45, at

trademark from its source-identifying purpose and views it as an engine of expression.²⁴⁷ If a mark holder gains the right to put its expressive phrase on a t-shirt, can that mark holder then force everyone who agrees with its view to buy t-shirts expressing that view exclusively from the mark holder?²⁴⁸ After all, most people buying a t-shirt with a phrase emblazoned on it are doing it not for source-identification purposes but to convey their own view.²⁴⁹

The REDSKINS decision was careful to point out that a refusal of registration would not drive the speech from the marketplace; *Tam*, by contrast, does exactly that, placing the speech in the mouth of one speaker and infringing on the rights of all other speakers to make a similar expression. Naturally, this danger can happen whenever one registers a trademark.²⁵⁰ “[A] trademark right allows its owner to suppress other *uses*.”²⁵¹ However, the PTO’s guidelines were carefully constructed in light of the purposes of trademark law, to guarantee that trademarks were used to identify sources of goods and not to convey expression.²⁵² If the expansion of trademark law had already raised concerns that trademark holders have “too much control over what others may say, directly or indirectly, about their marks,”²⁵³ *Tam* has exacerbated the problem.

Tam acknowledged that there are millions of registered trademarks.²⁵⁴ In fact, all of the most common words are also trademarks.²⁵⁵ Expanding protection over all of them as important expressive speech rather than as commercial speech can have significant repercussions to free speech—in the stifling sense rather than freeing sense.²⁵⁶ After all, in the wake of *Tam*, all we really know is that Simon Tam owns a right to a particular racial slur and can use that right to prevent others from using that slur. Indeed, given the prevalence of preliminary injunctions in trademark cases, he could even prevent others’ uses of that ex-

126–27 (discussing a hypothetical where shirts that read “Down with the NFL’s Redskins” might cause likelihood of confusion); Lemley, *supra* note 213, at 1705.

²⁴⁷ Lemley, *supra* note 213, at 1708.

²⁴⁸ And there is an indication that at least some applications in the wake of the *Tam* ruling seem to seek merely to stick a phrase on a t-shirt. See Lince, *supra* note 242.

²⁴⁹ See Grynberg, *supra* note 47, at 190.

²⁵⁰ See Conrad, *supra* note 45, at 97; Snow, *supra* note 124, at 1663; Tushnet, *Trademark Law*, *supra* note 180, at 749.

²⁵¹ Tushnet, *First Amendment*, *supra* note 44, at 386; see also Lemley, *supra* note 213, at 1696 (“Important political and social commentary and works of art may be suppressed entirely.”).

²⁵² See 15 U.S.C. § 1127 (2018).

²⁵³ Dreyfuss, *supra* note 110, at 398; Sheff, *supra* note 213, at 815.

²⁵⁴ See *Matal v. Tam*, 137 S. Ct. 1744, 1752 (2017).

²⁵⁵ John Perritano, *Nearly Every English Word is Trademarked*, HOW STUFF WORKS (Feb. 26, 2018), <https://people.howstuffworks.com/almost-every-word-is-now-trademarked.html>.

²⁵⁶ See, e.g., *Girl Scouts of the U.S. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 808 F. Supp. 1112, 1118 (S.D.N.Y. 1992) (“Commentators have noted that courts frequently over-protect trademarks at the expense of First Amendment interests.”); Conrad, *supra* note 45, at 97 (“[I]t can be argued that intellectual property rights are inherently restrictive on free speech . . .”).

pressive term without any discussion of the usual First Amendment concerns about prior restraint.²⁵⁷ On the whole, maybe the Supreme Court has achieved a secret goal of limiting disparaging speech by granting ownership of it to limited entities.

CONCLUSION

Tam is dangerous because the Court’s analysis missed the point: trademarks are not expressive speech. In fact, when trademarks become expressive, we should as a society be worried. Instead, the *Tam* Court exalted trademarks’ expressive nature. Instead of urging those with expressive interests to go to copyright law for their protections, the *Tam* Court decided to prioritize the viewpoint of whoever rushes to the PTO first, over the viewpoints of literally everyone else in society. *Tam* leaves the door open for a large variety of expressive speech to be owned by one particular entity who controls the public discussion about a topic.

There were ways to decide *Tam* without making such a sweeping proclamation on trademarks’ expressiveness. After all, in previous trademark decisions courts had mostly been able to avoid the thicket of the First Amendment. It is curious that *Tam* ignored so many of the cogent technical problems with the disparagement statute. The statute often seemed vague,²⁵⁸ which could have doomed it. Arguably, the PTO did not even follow its own precedent in rejecting the mark, since there was a convincing argument to be heard that SLANTS, acting as it did as a reclamation of the slur in connection with an Asian American band, was not disparaging *as applied to its goods and services*—which was the theoretical PTO standard for disparaging marks. In addition, the Court could have wrestled more with the marketplace justification for the disparagement clause, focusing on trademarks’ traditional definition to overturn the clause as not advancing consumer protection, while maintaining the bedrock that the Lanham Act’s focus was on commercial speech, not expressive speech.²⁵⁹ The Kennedy Concurrence comes closest to this sort of analysis, although it is brief and cursory.²⁶⁰ Finally, “[e]ven pure commercial speech is entitled to significant First Amendment protection.”²⁶¹ The *Tam* Court did not need to convert trademarks into expressions to reach a holding that the disparagement clause was unconstitutional.

²⁵⁷ See *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979).

²⁵⁸ See Conrad, *supra* note 45, at 144; Tushnet, *First Amendment*, *supra* note 44, at 413.

²⁵⁹ See *Taubman Co. v. Webfeats*, 319 F.3d 770, 774 (6th Cir. 2003); Kuckes, *supra* note 47, at 165; Tushnet, *First Amendment*, *supra* note 44, at 387–88.

²⁶⁰ See *Matal*, 137 S. Ct. at 1768 (Kennedy, J., concurring in part and concurring in the judgment) (“Whether a mark is disparaging bears no plausible relation to that goal [of facilitating source identification].”). Many of these analyses are mentioned more fully in *Brunetti*, although they are necessarily subordinate to the Supreme Court’s broader rulings.

²⁶¹ *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 925 (6th Cir. 2003).

Instead of any of these other options, *Tam* chose to focus on a First-Amendment analysis of trademarks being expressive rather than a commercial analysis. In one way, maybe this was not at all surprising. Mark Lemley has already noted that “courts have not been sufficiently sensitive to legitimate free speech concerns in cases where trademark owners seek to restrict noncompetitive uses of the trademark.”²⁶² *Tam*, in continuing in this line, seems to endorse the copymark creep that has been happening over the last few decades, conflating the two doctrines together as a foregone conclusion. Ordinarily, one would have said that if one cannot get a trademark, then one ought to try to get a copyright.²⁶³ And maybe one might not be able to get a copyright, either, but if that is the case then it is because we made a decision that no one should be able to own the particular expression at issue. Instead, *Tam* has converted trademark law into an expansion of copyright and thus intellectual property ownership. What does it mean for all of us when the protection of speech is translated to the right to own that speech?

Tam is a dangerous precedent and should serve as an illustration of the possibly unintended consequences that will continue to result when we blur trademark and copyright indiscriminately. Doing so endangers the viability and effectiveness of both intellectual property regimes—and, ironically, of the very robust First Amendment-protected discourse *Tam* purported to protect.

²⁶² Lemley, *supra* note 213, at 1697.

²⁶³ *Id.*