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FIRST AMENDMENT, TRADEMARKS, AND "THE SLANTS": OUR JOURNEY TO THE SUPREME COURT

SIMON TAM[1]

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I. INTRODUCTION

Contrary to public opinion or the free advice given by the Internet, I read the "comments section." I do not block or unfriend people I disagree with on social media, I actively engage with them. It is not out of curiosity, naiveté, or hope that I will find a source of deep insight on complex issues – I do it because I believe it is important to connect with others who hold opposing beliefs.

This is the bedrock principle of a free democracy. Protecting free speech, especially speech that we find repulsive, is essential for protecting the most vulnerable communities. Laws affecting civil liberties should not be written around those who abuse those rights, but they should instead open a path for those with the fewest resources. Whether it is trademark law or protests, the price of any abridgement of free speech is paid for by the backs of the underprivileged.

Take the case that I fought before the Supreme Court, *Matal v.*

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[1] Simon Tam is the founder and bassist of The Slants, an Asian American Rock Band.

Tam.[2] Eight years ago, I applied to register the trademark for my dance/rock band, The Slants.[3] The problem was, our band happens to be all-Asian American ethnicities and has distinctly political messages, something that the United States Patent and Trademark Office (USPTO) believed was a major problem.

Relying on questionable evidence, we were told that the term, "slant," is disparaging to persons of Asian descent and therefore unable to be registered.[4] Of course, they did not have a problem with it before – they have received applications on the term "slant" hundreds times, with dozens of registrations issued.[5] Ours was the only application in all of United States history to be denied a registration due to section 2(a) of the Lanham Act, a provision of law that prevents marks deemed to be "scandalous, immoral, and disparaging" from being registered.[6] According to the Examining Attorney, the reason why our application was flagged for a section 2(a) refusal was because "it is uncontested that applicant is a founding member of a band...composed of members of Asian descent...thus, the association."[7] In other words, if we had been comprised of any other ethnicity, our mark would not be considered disparaging. In the name of protecting us against racism, the USPTO denied us rights based on race. We were engaging in a process of self-empowerment called re-appropriation, where we own/change meaning of harmful terms to reduce their sting. I started the band with as a deliberate way to challenge racial stereotypes. Our name, The Slants, actually refers to our collected perspective as people of color.

II. THE BAND'S ORIGIN

From as far back as I could remember, I wanted to create music.

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2 *See* In re Tam, 808 F.3d 1321 (Fed. Cir. 2015), *cert granted*, 137 S. Ct. 30 (2016). The Supreme Court heard oral arguments on January 18, 2017. For audio transcripts and a timeline of filings, *see Matal v. Tam*, SCOTUSBLOG: SUPREME COURT OF THE UNITED STATES BLOG, October 2016 Term (Jan. 18, 2017) http://www.scotusblog.com/case-files/cases/lee-v-tam/.

3 U.S. Trademark Application Serial No. 77952263 (filed Mar. 05, 2010).

4 U.S. Trademark Application Serial No. 77952263 (filed Mar. 05, 2010) (see prosecution history).

5 *See, e.g.*, SLANT, Registration No. 4418371; SLANT, Registration No. 4123704; SLANT, Registration No. 3967129; SLANT, Registration No. 3894536; SLANT, Registration No. 3437230.

6 15 U.S.C. §1052(a) (2016).

7 U.S. Trademark Application Serial No. 85,472,044 (filed Nov. 14, 2011) (*See* Office Action dated June 20, 2012).

My parents have these home videos of me when I was just a kid: I would grab my dad's acoustic guitar, jump on the coffee table, and pretend to play a show for the family in the middle of the living room. Instead of playing cops and robbers as children, I would round up my sister and my cousins to create a fake band. I remember spreading out newspapers and magazines all over the ground to create our "stage," then using whatever noise making devices we had at our disposal to create our "music": the piano, using buckets for drums, our voices screaming at the top of our lungs. I am sure my parents loved it.

At the age of 10, things got serious: I got an electric bass and started taking lessons. I loved it and dedicated endless hours to learning the instrument. Sometimes, I would fall asleep with it in my hands while lying in bed. I wanted to change the world, I wanted to rock out.

During those same years, I wanted to do something for those hurting. I used to beg my parents for change so that I could give it the homeless waiting at intersections. I would use all of my school breaks to volunteer with organizations that would help underserved communities. In other words, when I was not working toward a world where I was on stage sharing my music, I was working toward one with less suffering.

Interestingly enough, I did not see the connection between the two until much later.

When I first moved to Portland, Oregon as a musician in February of 2004, I left nearly everything and everyone behind, including the family and culture that I grew up with. So, I started buying VHS tapes of movies from Hong Kong on eBay because I so missed hearing my language and seeing my culture.

Two months after I moved, the movie Kill Bill was released on DVD. I bought it on the day it was released since I missed it in the theaters. As I was watching, there was a very distinct and iconic scene: a woman named Oren Ishii, who has an incredible entrance when she walks in with her gang of Crazy 88's, the yakuza gang that she led.

Now, for most people, this was just another iconic walking scene from Quentin Tarantino. They might remember the distinct music (which ended up being used over and over again in other works), some might have even saw a parallel to a similar scene in Reservoir Dogs. But for me, it was something much different. In fact, I remember pausing the disc because it was such a powerful epiphany. For me, it was the first time that I had ever seen an American produced major film that depicted Asians as cool, confident, and sexy. Imagine

growing up your entire life and never having anything in mainstream culture that reflects your identity in that kind of light.

Then, I started thinking about my own art, and how the void existed there as well. The music industry, the gatekeepers for art that I had lived and breathed since my very first memories, did not allow people that looked like me in. Despite having over 17 million Asian Americans in the country, we had almost no representation in the billboard charts, in music magazines, and on MTV. In that moment, I believed things would have to change. That night, in the middle of the film, was when an idea for an Asian American band was born.

We were called "The Slants," a name that was based on our perspective, or slant, on life as people of color, geeks, and musicians. It was also reappropriating a stereotype that people often hold about Asians, that we all have slanted eyes.

When I first started, the idea was not to be a socio-political project. It was more about inclusion and sharing some of our culture. However, almost immediately after the band became public (on Myspace, no less), I started getting messages from Asian American youth, thanking us for existing and for giving them a reason to be proud of their heritage. I started realizing that we had more of a responsibility – and that whether we liked it or not, our band soon would be judged simply because of our race.

News articles were written talking about how we were turning stereotypes upside-down.[8] But not everyone agreed: the music editor of a local paper wrote a review slamming us for our ethnicity, writing "OMG. I get it. The Slants are Asian . . . what's so impressive about a bunch of Asian kids who play keyboards?"[9]

Once, we received an offer from a major record label who was interested in signing us but wanted us to replace our singer with someone who was white because they said "Asian doesn't sell."

When booking tours, several venues have said: "Your music is great, but who would want to see an Asian band?"

Slowly, we began integrating more of our social justice ideas into our work. We could not sit on the sidelines while seeing all of these

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8 *See, e.g.*, April Baer, *The Slants: Trading in Stereotypes*, NPR MUSIC (June 11, 2008, 1:22 PM), http://www.npr.org/templates/story/story.php?storyId=90278746.

9 Ezra Ace Caraeff, *Up & Coming: The Slants, Lickity, Gejius*, PORTLAND MERCURY (Jan. 31, 2008) https://www.portlandmercury.com/music/up--coming/Content?oid=532663.

injustices. So, we got deeply involved with Asian American advocacy organizations, raised money for important causes, and helped lead discussions on race and identity across North America.

While the USPTO had been accusing us of racism for nearly a decade, other areas of the government had been working with us to create better policy and develop culturally competent outreach to the Asian American community. This included the Department of Defense, federal prisons, and even the White House Initiative on Asian Americans and Pacific Islanders (WHIAAPI), who lauded us as champions of the Asian community. One of the latest efforts with the government included creating a compilation album to fight oppression that included notable figures such as Barack and Michelle Obama, George Takei, and Jeremy Lin. Ironically, the song that they included from our band was "From the Heart," which was composed as an open letter to the USPTO.[10] It was released by the WHIAAPI one month before we appeared before the Supreme Court for oral arguments.

III. REAPPROPRIATION AND TRADEMARK REGISTRATION

Reappropriation, or the cultural process by which a group reclaims terms or artifacts that were previously used in a disparaging way towards that group, is an effective way to create social change, especially in the arts. It has a rich history steeped in oppressed communities who have used it as a way to address larger issues – sometimes through irony, other times through taking on formerly stigmatizing labels as badges of pride. Like other issues of identity politics, it is extremely complex, nuanced, and shifts power from dominant groups into the marginalized, who finally get a word on the appropriateness of terms and ideas. However, it is something that has baffled the USPTO, which has led to incredible inconsistent and subjective decisions. That is why they have been all over the place with terms like "*queer*," "*bitch*," "*Jesus freak*," and any other kind of identifier that could be used in a positive or negative way.

Numerous briefs that have appeared before the Court of Appeals for the Federal Circuit and Supreme Court have illustrated the array of decisions around section 2(a). The Trademark Office has denied MADONNA for wine in one application,[11] but approved it for

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10 The Slants, *From the Heart*, THE BAND WHO MUST NOT BE NAMED (2017).

11 *In re* Riverbank Canning Co., 95 F.2d 327 (C.C.P.A. 1938).

another.[12] They found QUEER GEAR registerable for clothing,[13] but denied CLEARLY QUEER[14] for the same type of product. Arguably, the most contentious case is Professional Football's mark, THE WASHINGTON REDSKINS.[15] Yet while the USPTO claimed that REDSKIN is an inherent racial slur, they registered a new trademark for ALL NATURAL MY DADZ NUTZ CARMELIZED JUMBO REDSKINS in 2010.[16]

The government and those who support their position claim that applicants can always appeal decisions on section 2(a) violations that they believe to be wrong.[17] Yet, the government will not reveal the dark truth behind this kind of claim: no one has ever been completely successful in an appeal, no matter how much evidence they have submitted.

The closest case to successfully appeal a 2(a) denial was San Francisco's lesbian biker social justice group, Dykes on Bikes.[18] After years of battling with hundreds of pages of evidence, they were granted their trademark registration for DYKES ON BIKES.[19] Yet two years later, the USPTO rejected Dykes on Bikes' new application to register its logo on the basis of having the word "dyke," setting their work back twelve years.[20]

One of the major problems is that the USPTO provides an impossible, vague standard to meet. The USPTO uses a two-part test of its own invention to determine whether a mark is disparaging, which

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12 MADONNA, Registration No. 3,545,635.

13 QUEER GEAR, Registration No. 1,828,351.

14 U.S. Trademark Application Serial No. 76,132,003 (filed Sept. 19, 2000).

15 WASHINGTON REDSKINS, Registration No. 0,978,824; REDSKINS, Registration No. 1,085,092; THE REDSKINS, Registration No. 0,836,122; THE REDSKINS, Registration No. 0,987,127; U.S. Trademark Application Serial No. 74,300,713 (filed Aug. 3, 1992); U.S. Trademark Application Serial No. 75,042,056 (filed Jan. 11, 1996) (abandoned); U.S. Trademark Application Serial No. 75,042,104 (filed Jan. 11, 1996) (abandoned); U.S. Trademark Application Serial No. 75,042,057 (filed Jan. 11, 1996) (abandoned); U.S. Trademark Application Serial No. 76,228,476 (filed Mar. 22, 2001); U.S. Trademark Application Serial No. 76,385,985 (filed Mar. 21, 2002) (abandoned).

16 ALL NATURAL MY DADZ NUTZ CARMELIZED JUMBO REDSKINS, Registration No. 3,792,438.

17 15 U.S.C. §1062(b); 37 C.F.R. §2.62(a).

18 DYKES ON BIKES, https://www.dykesonbikes.org (last visited April 18, 2018).

19 DYKES ON BIKES, Registration No. 3,323,803.

20 DYKES ON BIKES, Registration No. 5,389,061.

has several major problems. First, the USPTO does not actually define what constitutes "scandalous, immoral, or disparaging." Determination of what meets that definition is based on the subjective sensibilities of each individual Examining Attorney, which is why DYKES ON BIKES and other cases may receive two different responses with the same exact phrase. Second, the USPTO states that a mark can only be rejected under a section 2(a) refusal if it is considered to be disparaging by a "substantial composite of the referenced group."[21] However, they do not define what constitutes a "substantial composite" – the only example on record is found in *Harjo v. Pro-Football, Inc.*,[22] where they argued that 36.6 percent of a population was not considered a substantial composite in that context.

IV. WHY WE CHOSE TO CONTINUE THE FIGHT

The Slants' trademark case actually has origins in a complex, yet little known history of two different applications. The first application was submitted in 2010 and received a section 2(a) refusal.[23] The USPTO cited sources such as UrbanDictionary.com, Asian-jokes.com, and used a photograph of Miley Cyrus pulling her eyes back in a "slant-eye" gesture to support this denial, yet they did not cite a single Asian American who found the term to be disparaging.[24] When we first appealed, we used traditional methods to do so: by using evidence to prove that the mark was not disparaging. Thus, we submitted legal declarations from prominent Asian American activists and organization leaders, dozens of articles about The Slants written by Asian American media, and multiple examples of the term "slant" being used in a self-referential, self-empowering manner by Asian Americans.[25]

Our request for reconsideration was swiftly denied, again, with wiki-sources cited.[26] The USPTO's Examining Attorney also found

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21 *See generally* TMEP § 1203 (Apr. 2017).

22 Pro-Football, Inc. v. Harjo, 284 F. Supp. 2d 96, 133 n.32 (explaining that 36.6 percent of Native Americans did not constitute a substantial composite).

23 U.S. Trademark Application Serial No. 77,952,263 (filed Mar. 5, 2010). *See* Office Action dated June 11, 2010.

24 *Id.*

25 U.S. Trademark Application Serial No. 77,952,263 (filed Mar. 5, 2010). *See* Response to Office Action dated December 3, 2010.

26 U.S. Trademark Application Serial No. 77,952,263 (filed Mar. 5, 2010). *See* Reconsideration Letter dated July 7, 2011.

two anonymous message board posts of users who said they did not like the band name and a blog that suggested that a concert planned for The Slants at the Asian American Youth Leadership Conference (AAYLC) in 2009 was cancelled due to controversy over the name.[27]

Faced with rising legal costs (including the numerous fees required by the USPTO for every correspondence and appeal),[28] I wanted to give up entirely. A trademark registration is so significant for a musical act; I thought it might be best to change the name. However, our attorney disagreed. He offered to do the work pro bono, because he believed in the principle behind The Slants. So, we continued by gathering vast support from diverse communities across the country.

First, we received linguistics and dictionary expertise from Dr. Ron Butters, the same expert who worked on the DYKES ON BIKES appeal.[29] Second, we received help from an independent team of professors who designed a survey.[30] Third, we received a legal declaration from the AAYLC which corrected the record: the concert by the band was cancelled due to logistical reasons – in fact, not a single formal complaint was received about the band (we headlined and I spoke as a keynote multiple times in subsequent years).[31] We also submitted additional legal declarations, examples of The Slants' work with Asian American organizations in dozens of U.S states, and addressed every legal concern of the USPTO.[32] All of these experts donated their time to our case. Their services would have cost nearly two hundred thousand dollars.

Despite these efforts, we lost. The USPTO swiftly dismissed the survey, ignored the linguistics report (and instead cited multiple out-

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27 *Id.*

28 *See generally,* USPTO Fee Schedule, https://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule#Trademark%20Fees.

29 U.S. Trademark Application Serial No. 77,952,263 (filed Mar. 5, 2010). *See* Paper Corresponding Incoming, Expert Report of Ronald Butters, PhD., dated June 16, 2011.

30 U.S. Trademark Application Serial No. 77,952,263 (filed Mar. 5, 2010). *See* Paper Corresponding Incoming, Expert Report of Charlton McIlwain, PhD., & Stephen Caliendo, PhD., dated June 16, 2011.

31 U.S. Trademark Application Serial No. 77,952,263 (filed Mar. 5, 2010). *See* Paper Corresponding Incoming, Second Declaration of Rev. Joseph Santos-Lyons, dated June 16, 2011.

32 U.S. Trademark Application Serial No. 77,952,263 (filed Mar. 5, 2010). *See* Paper Corresponding Incoming, dated June 16, 2011.

of-print dictionaries from the 1930s), and discredited the legal declaration submitted by the committee of the AAYLC. They did not believe The Slants performed, despite receiving copies of the official program and photographs of the concert.[33] No matter how much we submitted from the Asian American community that refuted the USPTO's position, our efforts were found to be laudable, "but not persuasive" (to use their words).[34] Like every other application rejected based upon a section 2(a) violation, we were unsuccessful in our appeal.

Eventually, we started working with a new attorney who abandoned the application and started a new one, beginning the process once more but with a different evidentiary record.[35] The new attorney, Ronald Coleman, suggested that we file an "ethnic neutral" application. He believed that our initial rejection was linked to the relatively obscure racial slur because our initial application contained Asian imagery. But because SLANT is an inherently neutral word that has been registered hundreds of times, the association might not be made if that imagery was absent.

In a twist of fate, the USPTO assigned the same Examining Attorney as our first application. He swiftly denied the second application, essentially copying and pasting the previous rejection into the current one.[36] We thought we could appeal based on violations of procedural and evidentiary issues. After all, the evidence for rejection predated the current application by several years (no fresh search was conducted, despite a rigid process requiring one to be done as outlined by the Trademark Examining Procedures Manual).[37]

We appealed, asking why the Examining Attorney would apply the racial slur as a likely meaning instead of any other possible definition. They responded, "Here, the evidence is uncontested that applicant is a founding member of a band (The Slants) that is self-described as being composed of members of Asian descent ... Thus, the association of the term SLANTS with those of Asian descent is

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33 U.S. Trademark Application Serial No. 77,952.263 (filed Mar 5, 2010). *See* Reconsideration Letter, dated July 7, 2011.

34 U.S. Trademark Application Serial No. 77,952.263 (filed Mar 5, 2010). *See* Reconsideration Letter, dated July 7, 2011 (stating "applicant's analysis and arguments are not persuasive nor do they shed new light on the issues.").

35 THE SLANTS, Registration No. 5332283.

36 THE SLANTS, Registration No. 5332283, *See* Office Action Outgoing, dated Jan. 6, 2012.

37 TMEP §704.01 (Apr. 2017).

evidenced by how the applicant uses the mark – as the name of an all Asian-American band."[38]

The problem is that one can change almost every other aspect of their business: the logos used, font type, imagery, etc. but we can never change the most critical part of the rejection, our race. In other words, if an applicant of any other race applied, this would not have been an issue because the "context" would not be present. In the name of protecting Asian Americans against racism, the USPTO was denying rights based on Asian American identity.

I believed this to be an inherent flaw in the legal system and saw that error repeated over and over again to people based on their race, religion, sexuality, and gender. For example, the Asian American activist and businessman behind CHINK PROUD[39] was denied a registration based upon a section 2(a) refusal on the premise that "chink" is an inherent racial slur – yet, multiple registrations for CHINK exist and are held by non-Asians.[40] In fact, nearly every possible derogatory term for Asian Americans is registered now. To me, this was an injustice and one that would be worth the effort to address.

This of course, put us on an even longer legal journey, which eventually landed before the United States Supreme Court.

V. AN INEQUITABLE PROCESS AND THE SLANTS ON PROFESSIONAL FOOTBALL

Despite receiving most of the work on my case in-kind, I was still responsible for court fees, appellate printing, and other expenses. I have spent tens of thousands of dollars and almost a decade of my life in legal limbo. If the expert services were not donated, the costs would be unbearable. Faced with a section 2(a) refusal, most applicants simply give up or shut down their business. Even if I did prevail, I would not be reimbursed for the legal fees expended, nor would I regain the time lost that could have been spent developing my business.

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38 THE SLANTS, Registration No. 5332283, *See* Office Action Outgoing, dated June 20, 2012.

39 U.S. Trademark Application Serial No. 85,967,142 (filed June 21, 2013) (dead).

40 *See e.g.*, DURA-CHINK, Registration No. 5226720; PERMA-CHINK, Registration No. 1663436; U.S. Trademark Application Serial No. 87499767 (filed June 21, 2017).

Is this the kind of legal process that we want for marketplace regulation?

True equity is not achieved by protecting sweeping government actions that negatively affect some communities more than others. This outdated trademark law affects some groups more than others. It is used primarily against communities of color, women, and the LGBTQ, especially those who engage in reappropriation. As a result, these groups who are often silenced by majority institutions are unduly burdened with expensive fees and an endless appeal process that does not actually result in justice. Most of us do not have established football teams with endless resources to fight in court – many of us have given up or had to change the name of our businesses, nonprofit organizations, and logo… a prime example of the abridgement of free speech.

This is why I have become more comfortable with the notion of my case inadvertently helping groups whose intentions are not as pure. Of course, I am talking about Professional Football's infamous trademark for the Washington Redskins.

It is no secret that I believe Dan Snyder, the owner of the Washington Redskins, to be wrong. I have spoken publicly about it and have written extensively in order to disassociate myself with his racially inappropriate team name.[41] However, we should not be so obsessed with punishing villainous characters that we allow marginalized groups to be disproportionately burdened. This is why my personal views on the trademark process have evolved.

In the past, I agreed with the argument made in Asian Americans Advancing Justice's amicus brief, that a section 2(a) refusal should exist but there needs to be a requirement to allow for a culturally competent processes, especially for activists who want to reappropriate formerly stigmatizing labels.[42] It is what many legal experts often advise when defending the position of the USPTO, simply appeal with

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41 Simon Tam, *The Difference Between "The Redskins" Case and Ours*, THE SLANTS WEBSITE, NEWS (April 26, 2016), http://www.theslants.com/the-difference-between-the-redskins-case-and-ours/; Simon Tam, *Free Speech or to Be Free of Speech?*, HUFF. POST BLOG (July 31, 2015, 10:58 AM), http://www.huffingtonpost.com/simon-young/free-speech-or-to-be-free_b_7907774.html (updated July 31, 2016); Simon Tam, *Misleading Headlines About Slants/Redskins "Alliance,"* THE SLANTS WEBSITE, NEWS (Sept. 19, 2016), http://www.theslants.com/misleading-headlines-about-slantsredskins-alliance/.

42 Brief for Asian Am. Advancing Just. et al., as Amici Curiae Supporting Neither Party, Matal v. Tam, 137 S. Ct. 30 (2016) (No. 15-1293).

more information about our intent.

However, this information was already provided in the first application. Despite providing independent national surveys, an expert report from a leading linguistics expert, legal declarations from Asian American social justice and community leaders, over twenty examples of positive press coverage from Asian American newspapers and magazines, and over a dozen examples of other Asian Americans using "Slant" in a positive, self-empowering manner, USPTO dismissed the evidence. It is not an equitable process - despite receiving evidence specifically from the API community, including an Oregon governor appointed board of Asian American leaders - the Trademark Office ignored that context.

Asking already burdened and under-resourced communities to appeal using a long, expensive process that does not allow the complexities of identity politics to be navigated properly is regressive and inequitable in nature. When one considers the effect on the marginalized, this places an undue burden on the applicant by an effort, which has never produced a positive result at the TTAB level.[43] There is no recompense for expenses acquired for this endeavor – and if the USPTO incorrectly interprets a reappropriated phrase by the community and denies their rejection, this further limits the choices for already marginalized communities. Given the nature of reappropriation, this kind of provision would be primarily targeting and affecting communities of color, LGBTQ, and other groups who are primarily engaged in small businesses, nonprofit organizations, or artists, like The Slants.

As Todd Anten wrote in his Columbia Law Review article,

> Examiners' denials of these applications, though appealable, cost applicants money, time, and most importantly, the power to construct their own identities. Despite the government's intention to protect groups from disparagement, the targets 'may suffer in the long run because have surrendered the power to confront, survive, and transform these negative representations of themselves.'[44]

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[43] Megan Carpenter, *NSFW: An Empirical Study of Scandalous Trademarks*, 33 CARDOZO ARTS & ENT. L. J. 321, 326 (2016).

[44] Todd Anten, *Self-Disparaging Trademarks and Social Change: Factoring*

Sometimes, the reasons for targeting unpopular opinions may not be entirely cleared or identities are used against the applicants. For example, the USPTO has admitted that "slant" is not an inherent racial slur – yet, in our case, they insinuate that the "context" of a racial slur is provided when the mark is used by Asian Americans.[45] If this were a non-Asian band, it may have not been denied. Similarly, the marks MARRIAGE IS FOR FAGS,[46] NATURALLY INTELLIGENT GOD GIFTED AFRICANS (N.I.G.G.A),[47] and HEEB,[48] and were all denied despite the appropriate intent, context, and evidence that they were community members using reappropriation for their movements.

The USPTO provides more leniency for content that may be considered scandalous, immoral, or disparaging, but not when that usage is from minority groups. For example, numerous Japanese Americans have been denied state trademark registrations for the Japanese word for luck, "Fuku," because examiners claim it looks too much like an obscenity (grounds similar to 2(a)).[49] However, they see no issues with the clothing company "French Connection United Kingdom (F.C.U.K)," whose brand is dependent on remarkable similarity with the same word.[50] Additionally, from our investigation of the 756 applications for the term "redneck," the USPTO has never denied an application based on a 2(a) refusal, despite it widely being

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the Reappropriation of Slurs into Section 2(a) of the Lanham Act, 106 COLUM. L. REV. 388, 394 (2006). *See also* Megan M. Carpenter & Mary Garner, *NSFW: An Empirical Study of Scandalous Trademarks* (Tex. A&M Univ. Sch. of L. & Legal Stud., Working Paper No. 16-12), https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2715104 (noting that Trademark Office's 2(a) disproportionately impacts individuals and small businesses).

45 U.S. Trademark Application Serial No. 85,472,044 (filed Nov. 14, 2011). *See* Office Action Outgoing, dated June 20, 2012 ("Thus, the association of the term SLANTS with those of Asian descent is evidenced by how the applicant uses the mark – as the name of an all Asian-American band.").

46 U.S. Trademark Application Serial No. 77,477,549 (filed May 19, 2008) (dead).

47 U.S. Trademark Application Serial No. 75,002,364 (filed Oct. 6, 1995) (dead).

48 HEEB, Registration No. 2858011.

49 *See Fuku Denied Trademark: State Says West Palm Beach Japanese Restaurant's Name is 'Immoral,'* HUFF. POST (May 9, 2012), https://www.huffingtonpost.com/2012/04/30/fuku-restaurant-west-palm-beach_n_1464286.html

50 FCUK, Registration No. 4,167,152.

seen as a disparaging term.

Furthermore, this also assumes that the USPTO examining attorneys are culturally competent and have been thoroughly trained in recognizing social justice movements, contemporary uses of reappropriated language, the intent of the applicant, and even obscure harmful interpretations of otherwise neutral phrases.

With my trademark case, I have spent almost a quarter of my life fighting the government all the way to the Supreme Court simply because they did not think it was appropriate for an Asian American band to use the term "slant."

VI. THE BIGGER PICTURE ON ASSUMPTIONS AND TRADEMARKS

Artists do not begin their careers thinking about how to dismantle laws that they are not even aware of, and I am certainly not the exception. When I first started the band, the intention was to take on stereotypes about Asian Americans, inject pride into our ethnic heritages, and increase our community's visibility in the entertainment industry.

But what I have come to see is that assumptions can be efficacious. The USPTO assumed that our name was inherently a racial slur and that the Asian American community would feel disparaged by it. When our community loudly expressed otherwise, officials assumed that approving our name would set a precedent that would create more paperwork and open the door for other controversial trademark applications. What if, instead, they treated us as applicants of any other race, as people, instead of ideologies? What if our government's laws reflected the capacity for people, entire communities, and words and identities to change?

Through this process, I have come to understand that laws are designed to maintain the status quo. But shifts in language and identity politics require that bureaucracies move beyond simple cultural competency and instead navigate inconvenient and unknown waters.

We are fighting for more than a band name: we are fighting for the right of self-determination for all minorities. Things like this are the subtle indignities that people of color have to face every day: slights that do not seem big enough to make a fuss over, yet continually remind us that challenges to the norm (read: white, homogenous culture) are not welcome.

The USPTO can say it does not have enough resources to do

research on every application that comes in,[51] or that it has to wait for a massive shift in popular culture over sentiments toward a particular word, phrase, or image.[52] However, this subjective application of the law brings a chilling effect to free expression, especially on the part of individuals who wish to convey irony, neutralize slurs, convey artistic or political ideals, or engage in parody.

The role of the government should not include deciding what a group can define themselves as; that right should belong to the community itself. You can see, example after example, that the dominant group is not only inconsistent, but completely off base when it comes to the sentiment of people who have been marginalized for centuries.

It is undeniable that a person's quality of life, their opportunities, and their rights may hinge on their identity. If we are a country that believes in freedom of speech for each person, then we should embrace the expressions and protections of personal identity for each person.

VII. THE SUPREME COURT DECISION

On June 19, 2017, The Supreme Court of the United States unanimously ruled in our favor, striking down the disparagement provision of Section 2(a) of the Lanham Act.[53] Justice Samuel Alito wrote:

> Preventing speech expressing ideas that offend ... strikes at the heart of the First Amendment[54] ... speech that demeans on the basis of race, ethnicity, gender, religion, age, disability, or any other similar ground is hateful; but the proudest boast of our free speech jurisprudence is that we protect the freedom to express 'the thought that we hate.'

Justice Anthony Kennedy, representing the other four justices focused on a different aspect of the decision, "A law found to

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51 *In re* Budge Mfg. Co, 857 F.2d at 775 (1988).

52 *See* Gibbons, *supra* note 14, at 208 ("Depending on the examining attorney's choice of dictionaries, the current denotations of the questioned mark may not be adequately addressed. Some dictionaries are slower in recognizing new meanings given to existing words").

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

54 Id. at 1749.

discriminate based on viewpoint is an 'egregious form of content discrimination,' which is 'presumptively unconstitutional.'"[55]

A law that can be directed against speech found offensive to some portion of the public can be turned against minority and dissenting views to the detriment of all. The First Amendment does not entrust that power to the government's benevolence. Instead, our reliance must be on the substantial safeguards of free and open discussion in a democratic society.[56]

This decision has put to rest any question about the constitutionality of the disparagement clause as well as the legal efforts to cancel the trademark registrations held by Professional Football. With the *In re Brunetti* case, the Federal Circuit has followed suit with the "scandalous" and "immoral" provisions.

Some believe that the Pandora's Box or floodgate for hate speech has been opened and that the market will be inundated with disparaging trademark registrations.[57] However, I believe that is a fear-based, slippery slope argument. There are several reasons to consider why this will be an unlikely scenario.

First, in order to obtain a trademark registration, an applicant has to have a legitimate good or service in connection with that mark or a bona fide intent to use the mark.[58] The novelty of applying for a trademark registration isn't worth the cost or effort for those who simply wish to be unseemly. Trademark Office rejections for lack of intent to use remains constitutional and that practice will continue regardless of the marks applied for.

Second, an application requires a name and address on the registration.[59] Few would like to be remembered for their opprobrium brought on through the perpetuation or use of scandalous, immoral, or disparaging terms. As Ron Coleman writes,

> [t]rademark law does not give you ways to 'own' clever — or asinine — phrases or slogans. Merely plastering a meme or rallying cry on some garbagio 'goods'

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55 Id. at 1766 (*quoting* Rosenberg v. Rector & Visitors of Univ. of Va., 515 U.S. 819 (1995).

56 Id. at 1769.

57 Matthew Nelles, *Did the Supreme Court open the floodgate to offensive trademarks?*, THE HILL (June 20, 2017), http://thehill.com/blogs/pundits-blog/the-judiciary/338570-did-the-supreme-court-open-the-floodgate-to-offensive.

58 *See generally*, TMEP §§ 900, 1100 (Apr. 2017).

59 *See generally,* TMEP §800 (Apr. 2017).

> doesn't make a catchphrase, or even the name of a real provider of goods or a service, a trademark for garbagio goods either ... most of these would-be horror registrations are at best garbagio-goods specials. Very few people are prepared to build businesses around disgusting trademarks. Doing so is not what we call 'good business'.[60]

One of the consequences of this decision was the choice by the Justice Department to drop their case to cancel the trademark registrations owned by Professional Football.[61] While this may be disheartening to those who would like to see the Washington football team change their name, it does not mean the Change the Mascot[62] campaign will end. Rather, they will adopt other strategies to pursue the effort.

It's important to recognize that the effort of getting the football team to change their name would never have been resolved in court. What was at stake was not the right to keep the name, only their trademark registrations. While it is arguable that cancellation of those marks would result in lost revenues, thus compelling the team to change their name, the ultimate strategy would still depend on market forces. Similarly, the best way to prevent any proliferation of distasteful trademark registrations will be through the market itself rather than the desks of individual examining attorneys at the Trademark Office who apply an arbitrary and inconsistent process.

The moral compass of our society should not be dependent on nor measured by which trademarks are registered any more than which works of art are granted copyright protection. The Supreme Court decision did not change this fact. Rather, they followed what has been court jurisprudence for the past fifty years in guaranteeing the right of expression and individual liberty. In doing so, they eliminated a nefarious process that was not only discriminating based on viewpoint, but also targeting the identities of marginalized groups in the process. And, people from all political persuasions can argue what about this

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60 Ron Coleman, *Après Tam, le déluge? Nah.*, Likelihood of Confusion (March. 7, 2018, 9:23 PM), http://www.likelihoodofconfusion.com/apres-tam-deluge-disparagement/.

61 Harjo v. Pro-Football, Inc., 558 U.S. 1025 (2009).

62 ONEIDA INDIAN NATION, Changethemascot.org (last visited Apr. 2018), (Change the Mascot is a national campaign to end the use of the racial slur "redskins" as the mascot and name of the NFL team in Washington, D.C.).

means for years to come, shaping our laws to make them more just, which is the beautiful reality that is free speech.