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Federal Circuit Decides Sua Sponte To Consider En Banc Whether The Bar On Registration Of Disparaging Trademarks Violates The First Amendment

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In 2010 and 2011, Mr. Tam sought to register the trademark "THE SLANTS" for performances of his Asian-American dance rock band, The Slants. Pursuant to 15 U.S.C. § 1052(a), the examining attorney refused to register Mr. Tam's mark because it was disparaging to people of Asian descent. The Trademark Trial and Appeal Board (TTAB) affirmed and Mr. Tam appealed to the Federal Circuit, arguing that the term "slants" has many meanings and was not disparaging. Mr. Tam also argued that the statute is unconstitutional under, inter alia, the First Amendment, because it conditions a benefit (trademark registration) on relinquishment of speech. The Federal Circuit applied its two-part test from *In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014), and found substantial evidence, based largely on Mr. Tam's own submissions, that the term "slants" in this case likely referred to people of Asian descent, and the mark is disparaging to a substantial composite of people of Asian descent. The court rejected Mr. Tam's First Amendment challenge based on the court's precedent stemming from *In re McGinley*, 660 F.2d 481 (CCPA 1981). Bound by its precedent, the panel affirmed the TTAB's refusal to register Mr. Tam's mark. Judge Moore, the author of the panel opinion, also authored "additional views," further analyzing the First Amendment issue and questioning the continuing propriety of *McGinley*.

One week after the panel opinion, the full court ordered the case to be heard en banc. The court requested that the parties file new briefs addressing a single question: whether the bar on registration of disparaging marks in 15 U.S.C. § 1052(a) violates the First Amendment. The Federal Circuit will entertain amicus briefs, and will likely hear oral argument later this year or early next year.

In re Tam, No. 2014-1203 (Fed. Cir. Apr. 27, 2015) (per curiam Order).

Categories

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