

## Attorneys predict outcome of Washington Redskins' trademark spat

The U.S. Supreme Court's decision over federal registration of "The Slants" trademark has attorneys speculating over the future of the Washington Redskins football team's trademarks, which were deemed unregistrable in *Pro-Football Inc. v. Blackhorse et al.*, 112 F. Supp. 3d 439 (E.D. Va. 2015). Pro-Football Inc., the holder of many "Redskins" marks, filed a certiorari petition in April 2016. The Supreme Court rejected the petition in October. *Pro-Football Inc. v. Blackhorse*, No. 15-1311, cert. denied, 137 S. Ct. 44 (Oct. 3, 2016).

The justices opted instead to use *Lee v. Tam*, No. 15-1293, cert. granted, 137 S. Ct. 30 (Sept. 29, 2016), to address the constitutionality of the disparagement clause in Section 2(a) of the Lanham Act, 15 U.S.C.A. § 1052(a).

These attorneys were not involved in either dispute.



**Gregory C. Chinlund,**  
*Marshall, Gerstein & Borun, Chicago*

Whether or not there will be a rush to register disparaging marks with the PTO remains to be seen. An uptick may be expected but probably from those otherwise would-be applicants seeking to bring social issues to light (like Slants founder Simon Tam) or simply as a means to protect a controversial (intentional or not) commercial identity.



**Luke DeMarte, Michael Best, Chicago**

For years, the PTO inconsistently invoked the disparagement clause of the Lanham Act to deny registration to marks which were considered disparaging. This decision will free the PTO from its impossible burden and bring some consistency to the examination process. In pop culture terms, everyone will remember this as the case that paved the way for the Redskins to keep their trademark registrations.



**Lauren Emerson, Baker Botts LLP, New York**

Today's decision, while not surprising, is momentous, as any decision striking a long-standing legislative provision based on freedom of speech would be. I have little doubt that in the weeks and months to come, we will see many new filings that will be more challenging to celebrate than Simon Tam's hard-won victory.



**Marsha Gentner, Dykema, Washington**

What I'm interested in seeing is whether and how cases with marks that would not have been registered in the past will fare now in the courts. I'm thinking of cases involving infringement of a mark that includes a swastika, or depicts the prophet Mohammed (or Jesus Christ) in otherwise lewd marks, or the Kathy Griffin example of the president's severed head.



**Erin Hennessy, Bracewell LLP, New York**

The *Tam* decision is certainly good news for the Washington Redskins. Left open for reinterpretation are the "scandalous" and "immoral" bars to registration under Section 2(a) of the Lanham Act. Following the reasoning of Justice Alito, one could surmise that these sections similarly violate the First Amendment's free speech clause.



**Jonathan Hudis, Quarles & Brady, Washington**

The court's decision in *Tam* will likely have a profound impact on matters that are currently on appeal wherein the PTO refused or canceled trademark registrations for violating the disparagement clause, most notably, the Washington Redskins' case. Given the court's holding, many otherwise offending marks — whether based upon political, religious or other beliefs or sensibilities of the American public — will likely be allowed to register with the PTO going forward.



**Christopher K. Larus, Robins Kaplan LLP, Minneapolis**

The decision has an immediate impact on closely watched efforts to cancel the federal trademark registrations for the NFL's Washington Redskins. With this decision, those long-standing registrations will stay in place. The net result is that the Trademark Office will likely soon be faced with a host of offensive and profane trademark applications, as applicants intend to take advantage of this change in long-standing trademark law. The Trademark Official Gazette may soon require a parental advisory on the cover.



**Jonathan Moskin, Foley & Lardner, New York**

As a practical matter, the decision clears the way not only for the Redskins to maintain ownership of their marks (regardless of whether Native Americans find them offensive), but also clears the way for registration of trademarks demeaning of the prophet Muhammad or Islam in general, openly racist and misogynistic slogans, and the like.



**Andrew Price, Venable LLP, Washington**

The Redskins should consider changing their score-celebrating song from "Hail to the Redskins" to "Hail to The Slants." As the Redskins cheer and The Slants take a bow, most organizations will go about their business as usual, however, and continue to self-select brands that are most likely to appeal to everyone. It is the marketplace, not the Trademark Office, that decides whether brands really win or lose.



**David L. Rein, Erickson Kernell IP, Golden, Colorado**

This decision is an enormous boost to Dan Snyder and the Redskins. But, the greater question is whether there are now any restraints to rein in marketing departments that are likely working overtime now to come up with even more jarring brand names to compete in our Kardashian, attention-getting society. It will be interesting to see if the government responds with a new approach to trademark law or leaves it to the wild west of market forces.



**Mark Sommers, Finnegan, Washington**

The new arbiter over all things disparaging is the court of public opinion, where merchants seeking to exploit the source-identifying function of disparaging words must balance such use against the inherent potential and risk of commercial alienation, blowback and public outrage. The "Redskins" mark will again appear on federal register.



**Monica Riva Talley, Sterne, Kessler, Goldstein & Fox, Washington**

While the decision is headline-grabbing news for the Redskins and the previously obscure band The Slants, it likely won't impact the branding practices for most entities. A review of the TTAB database reveals that only a very small number of trademark applications are refused on appeal on the grounds that they are disparaging. It will be interesting to see whether new brands deliberately created to disparage certain groups of individuals have any legs in today's charged political and social climate.