

How does the US approach offensive trade mark registrations?

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IP analysis: The US Supreme Court has ruled that the US Government's ban on offensive trade mark registrations violates the First Amendment. Simon Malynicz QC, specialist intellectual property barrister at Three New Square, comments on what lessons can be learned from this case for IP practitioners and considers the potential difference in approach for UK and EU trade mark applications.

Original news

Matal (Interim Director, United States Patent and Trade mark Office) v Tam, No 15–129319

What is the background to this case?

Simon Tam, the lead singer of an Asian-American rock group called 'The Slants', chose that name in order to attempt to 'reclaim' it. He claimed he wanted to drain it of a denigrating force as a derogatory term for Asian persons. The band had released a number of albums with names such as 'The Yellow Album' and 'Slanted Eyes, Slanted Hearts'.

Tam sought registration of the trade mark 'The Slants' in the US as a US mark. The United States Patent and Trademark Office (USPTO) denied the application to register under a provision of the Lanham Act, which prohibited the registration of a trade mark that might disparage or bring into contempt or disrepute any persons, living or dead. It should be noted that this case is not about Mr Tam's ability to use the 'The Slants' name but rather whether he should be given the right to own a trade mark in that name which would stop others using it. A registered trade mark gives an imprimatur of respectability and confers a state granted monopoly.

What was the outcome?

Tam contested the refusal of his trade mark registration. His administrative appeal failed under a specific US provision which prevented trade marks being registered that 'disparage'. His first appeal to an en banc Federal Circuit found the disparagement clause unconstitutional under the First Amendment's free speech clause. A final appeal to the US Supreme Court has now also been unanimously dismissed, which found that the proposed trade mark did disparage a racial or ethnic group. However it went on to rule that the 'disparagement' provision was unconstitutional contrary to the First Amendment which prevents any abridgement of free speech. At its heart this was a free speech case, focused on issues such as 'viewpoint discrimination' and whether the proposed trade mark should be classified as government, private or commercial speech (on which there is ample prior US case law).

What are the implications for brand owners in the US?

There have been numerous ongoing proceedings concerning the Washington Redskins NFL team which have generated much controversy. It might now be decided that they can have a trade mark registration for 'Redskins' which could be derogatory to those of Native American heritage. Similarly, the Cleveland Indians baseball team have a mascot and logo called Chief Wahoo, which is a red faced child-like caricature of a Native American. They have scaled back use of that, but may decide to make more use of it.

Though some brand owners may be legally on stronger ground, I think these cases will be dealt with by lobbying and increased diversity awareness rather than by bringing trade mark actions. Eventually I would expect some brand owners to cease using controversial marks because brands do not like to attract this sort of controversy. For example, the US basketball team the Washington Wizards willingly changed their name from The Washington Bullets because of high homicide rates in Washington DC and the name's violent overtones.

Are there equivalent provisions for UK trade mark registrations?

UK domestic law derives from the Trade Marks [Directive \(EU\) 2015/2436](#). EU trade marks are also valid and enforceable in the UK where they have been granted by the EU trade marks office (EUIPO) in Alicante. Article 4(1)(f) of the Trade Marks Directive prevents registration if a proposed trade mark is:

- contrary to public policy, or
- accepted principles of morality

There is a similar provision in [Article 7.1\(f\)](#) of Regulation (EU) 2017/1001 on the EU trade mark. The UK intellectual property office (UKIPO) has dealt with a few cases such as:

- Tiny Penis (initially registered with EUIPO but registration now expired)
- Jesus (registered in stylised form only under registration number: EU011274503), and
- FCUK (a series of marks registered)

In the UK, 'mere distaste' is sought to be balanced against 'significant offence'. This means that simple distaste is not enough to refuse registration but significant offence to a group would be.

Mr Dennis Woodman made an application for a declaration that the French Connection-owned registration of FCUK was invalid as it caused offence. In his judgement as an appointed person in O-137-06, Mr Richard Arnold QC (before he was appointed to the bench) considered the significance of the Article 10 free speech provisions in the European Convention on Human Rights (ECHR). However this analysis was not to the same depth as the *Slants* judgment where there is very well developed reasoning. He also considered that it needed justifiably to cause outrage to an identified section of the public.

What about EUIPO trade mark registrations?

The EUIPO has allowed the registration of 'Screw You' as a trade mark. While it considered that freedom of expression is relevant and that businesses might be unwilling to invest in marks if they were unprotectable, it said that signs which severely offend should be refused registration. This makes sense.

On the other hand, the EU General Court has given its judgment in *PAKI Logistics v OHIM* [2011] EUECJ [T-526/09](#) on the contested application by German company Paki Logistics GmbH to register 'Paki' as a trade mark. The UK government intervened to argue that this term was offensive to an ethnic group in this country. Here there was no sense of reclamation or re-appropriation by Pakistanis of the term because the applicant was a German company applying in respect of crates and transportation services. The proposed EU trade mark has to be considered in the UK also and it would have offended a large section of the UK public. Registration was refused on absolute grounds because it was contrary to public policy or accepted principles of morality.

Is this judgment likely to have any impact on the registrability of offensive trade mark registrations under UK law?

Yes. At present the cases are already taking account of free speech but only to a limited degree—see the *FCUK* and *Screw You* cases referred to earlier. I would expect the free speech argument to become more important. Under EU law, there are free speech provisions in the EU Charter and under our own domestic law, there is the [Human Rights Act 1998](#), which takes account of the free speech provisions in the ECHR. Judges have been fairly permissive of these sorts of marks anyway so this will give them a further excuse to be even more permissive. However the argument that a government is somehow giving its blessing to offensive terms is becoming less important. Perhaps this is a recognition that a trade mark is in truth a private law right rather than some sort of government warrant.

Interviewed by David Bowden.

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