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**NOTE: PRO-FOOTBALL, INC. V. BLACKHORSE AND THE  
FIRST AMENDMENT: DOES CLASSIFYING TRADEMARKS  
AS GOVERNMENT SPEECH UNDERMINE FREE SPEECH  
PROTECTIONS?**

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## I. INTRODUCTION

The Washington Redskins garner a great deal of media attention.<sup>1</sup> On one hand this is not unexpected; they are the third most valuable franchise in the National Football League with an approximate worth of \$2.85 billion.<sup>2</sup> They play in a stadium that holds 85,000 spectators.<sup>3</sup> Over the course of the team's history, they have won three Super Bowls.<sup>4</sup> Numerous Redskins are enshrined in the Pro Football Hall of Fame.<sup>5</sup> All of these combine to indicate that this attention comes from its existence as a storied franchise in a nation obsessed with football.

However, this attention, more often than not, is now focused on the name of the team alone.<sup>6</sup> The controversy over whether the team's name, the "Redskins", offends Native Americans has attracted comments from all over the globe, from the President of the United States down to every-day citizens.<sup>7</sup> And this debate has not been confined to merely the popular press,<sup>8</sup> legal commentators have also weighed in on both sides of the argument.<sup>9</sup> While this controversy has often been very spirited, the Redskins have refused to change the name

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<sup>1</sup> See generally Michael Martinez, *A slur or term of 'honor'? Controversy heightens about Washington Redskins*, CNN (Oct. 12, 2013, 4:11 PM), <http://www.cnn.com/2013/10/12/us/redskins-controversy/>.

<sup>2</sup> Mike Ozanian, *The Most Valuable Teams In The NFL*, FORBES (Sept. 14, 2015, 9:51 AM), <http://www.forbes.com/sites/mikeozanian/2015/09/14/the-most-valuable-teams-in-the-nfl/#5dc64f86326f>.

<sup>3</sup> Dan Steinberg & Scott Allen, *Redskins remove seats from FedEx Field for third time in five seasons*, WASHINGTON POST (June 1, 2015), [https://www.washingtonpost.com/sports/redskins/for-third-time-in-six-years-redskins-remove-seats-from-fedex-field/2015/06/01/555299d6-088a-11e5-a7ad-b430fc1d3f5c\\_story.html](https://www.washingtonpost.com/sports/redskins/for-third-time-in-six-years-redskins-remove-seats-from-fedex-field/2015/06/01/555299d6-088a-11e5-a7ad-b430fc1d3f5c_story.html).

<sup>4</sup> *History- Super Bowl*, WASHINGTON REDSKINS, <http://www.redskins.com/team/history/super-bowl.html> (last visited Jan. 31, 2016).

<sup>5</sup> *History- Hall of Fame*, WASHINGTON REDSKINS, <http://www.redskins.com/team/history/hall-of-fame.html> (last visited Jan. 31, 2016) (naming the 26 former player, coaches and administrators inducted into the Hall of Fame).

<sup>6</sup> See Martinez, *supra* note 1.

<sup>7</sup> David Jackson, *Obama again urges Redskins name change*, USA TODAY (Nov. 6, 2015, 7:11AM), <http://www.usatoday.com/story/theoval/2015/11/06/obama-washington-redskins-adidas-tribal-nations-conference/75281088/>.

<sup>8</sup> See Jeffrey Lefstin, Note, *Does the First Amendment Bar Cancellation of REDSKINS?*, 52 STAN. L. REV. 665, 665 (2000).

<sup>9</sup> Compare Michelle B. Lee, *Section 2(A) of The Lanham Act as a Restriction on Sports Team Names: Has Political Correctness Gone Too Far?*, 4 SPORTS LAW. J. 65, 65, 80 (1997) (arguing in favor of the team name being protected by the First Amendment), with Hammad Rasul, Comment, *Fourth and Long: The Time is Now for the "Washington Redskins" to Punt the Name*, 14 U. MD. L.J. RACE RELIG. GENDER & CLASS 338, 355 (2014) (arguing against the use of the name Redskins).

of the team.<sup>10</sup>

Because of this staunch refusal, the debate has been pushed further into the public sphere.<sup>11</sup> Starting in 1992, several Native Americans have challenged the Redskins trademark in court hoping that cancellation of their marks would force the team to change its name.<sup>12</sup> After several setbacks for the Native American litigants, in June 2014 the United States Patent and Trademark Office's Trademark Trial and Appeal Board held that the Redskins trademark was abusive under Section 2(a) of the Lanham Act and thus vacated the mark.<sup>13</sup>

This action was affirmed in July 2015 by Judge Gerald Lee of the Eastern District of Virginia.<sup>14</sup> The court upheld this decision on numerous grounds, including that the trademark program, operated by the United States Patent Office, constitutes government speech and thus is exempt from the First Amendment protections the Redskins allege their trademark carries.<sup>15</sup>

This decision becomes questionable when viewed in light of *In re Tam*, a recent decision of the Court of Appeals for the Federal Circuit, finding Section 2(a) unconstitutional as a violation of the First Amendment.<sup>16</sup> The analysis in *Tam*, when applied to the *Blackhorse* decision, demonstrates the significant problems that underlie the district court's decision.<sup>17</sup> It is unclear if trademarks are government speech in the first place. Even if they are, the degree to which Section 2(a) allows the federal government to engage in unconstitutional content-based regulations and viewpoint discrimination in the arena of speech is troubling. The federal government could avoid this situation entirely if it decides to refuse to enforce 2(a) in a way that discriminates against mark holders who, like the Redskins, utilize controversial marks.

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<sup>10</sup> Maya Rhodan, *Redskins Owner Says He Won't Change Team Name*, TIME (Oct. 9, 2013), <http://nation.time.com/2013/10/09/redskins-owner-says-he-wont-change-team-name/>.

<sup>11</sup> See generally Lefstin, *supra* note 8 (discussing the issue of the Redskins name in light of the First Amendment).

<sup>12</sup> *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d (BNA) 1080, 1083–84 (T.T.A.B. 2014).

<sup>13</sup> *Id.* at 1082–83.

<sup>14</sup> *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 447–48 (E.D. Va. 2015).

<sup>15</sup> *Id.*

<sup>16</sup> See *In re Tam*, 808 F.3d 1321, 1328 (Fed. Cir. 2015)

<sup>17</sup> See *id.*

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## II. BACKGROUND ON TRADEMARK LAW

Before the *Blackhorse* decision can be addressed, some background information on the trademark system gives clarity to the district court's decision.<sup>18</sup> The United States Constitution explicitly gives Congress the power to create a system for issuing copyrights and patents.<sup>19</sup> The Trademark Act of 1946, also known as the Lanham Act, laid down the basis of the modern trademark system.<sup>20</sup> This Act was designed to clear up the confusing and uneven nature of trademarks across the United States stemming from the Federal Trademark Act of 1905.<sup>21</sup> The 1905 Act made trademarks a state question governed by common law, which resulted in vastly different rulings across the country when it came to trademarks.<sup>22</sup>

The Lanham Act greatly streamlined much of the process of issuing trademarks.<sup>23</sup> Many of these changes were focused on the incontestability of registered marks.<sup>24</sup> However, the section most relevant to the *Blackhorse* decision is Section 2(a) of the act, codified at 15 U.S.C. § 1052.<sup>25</sup> In particular, this section allows the government to refuse to register a trademark that, “[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter 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.”<sup>26</sup> This language is very broad, but it is designed to prevent the trademarks program from being abused to disparage individuals or groups of people.<sup>27</sup> Of particular importance for the Redskins mark is the “disparage” language, which has been the basis of the various challenges launched against the name.<sup>28</sup>

The enforcement of this section, along with the entirety of the trademark process, comes under the auspices of the United States

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<sup>18</sup> See generally *Park 'n Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 193–94 (1985) (providing some brief background information on trademarks and the Lanham Act).

<sup>19</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>20</sup> *Park 'n Fly*, 469 U.S. at 193.

<sup>21</sup> *Id.*

<sup>22</sup> *Id.*

<sup>23</sup> See *id.* at 193–94.

<sup>24</sup> *Id.* at 193.

<sup>25</sup> 15 U.S.C. § 1052 (2012).

<sup>26</sup> *Id.* § 1052(a).

<sup>27</sup> See *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215, 1217 (T.T.A.B. 2010).

<sup>28</sup> *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d (BNA) 1080, 1083–84, 1087 (T.T.A.B. 2014).

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Patent and Trademark Office.<sup>29</sup> The Trademark Trial and Appeal Board (“TTAB”) enforces the Lanham Act and its prohibitions by rendering decisions when trademarks are contested.<sup>30</sup> An interested party may challenge a trademark by filing a claim with the TTAB, which will adjudicate the issue in dispute.<sup>31</sup> The TTAB was the first body to examine the issue of the Redskins trademark.<sup>32</sup>

### III. RELEVANT CONSTITUTIONAL DOCTRINES

To understand the controversy over the Redskins’ trademarks, one must be familiar with the principles of content and viewpoint discrimination as well as government speech. These doctrines carry a great deal of importance when discussing the Redskins’ marks as they will determine whether the trademark program’s restrictions on disparaging marks are invalidated by the First Amendment and thus whether the district court’s decision was correct.<sup>33</sup>

#### A. Viewpoint discrimination and content neutrality

First Amendment jurisprudence contains two underlying principles concerning government restrictions on speech; the government must avoid viewpoint discrimination and be content neutral to survive judicial scrutiny.<sup>34</sup> Viewpoint discrimination and restrictions aimed at the content of speech are considered to be among the most insidious violations of the First Amendment by the government.<sup>35</sup>

In general, the exceptions to First Amendment protections are very limited.<sup>36</sup> Only a few types of speech are denied protection under

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<sup>29</sup> See generally *Trademark FAQs*, U.S. PATENT & TRADEMARK OFF., <http://www.uspto.gov/learning-and-resources/trademark-faqs> (last modified Aug. 5, 2016) (answering frequently asked questions concerning trademarks and the United States Patent and Trademark Office).

<sup>30</sup> See generally *Trademark and Trial Appeal Board*, U.S. PATENT & TRADEMARK OFF., <http://www.uspto.gov/about-us/organizational-offices/trademark-trial-and-appeal-board> (last modified July 17, 2015) (describing the functions of the Trademark Trial and Appeal Board).

<sup>31</sup> *How can I oppose a mark listed in the TMOG?*, in *Trademark FAQs*, U.S. PATENT & TRADEMARK OFF., <http://www.uspto.gov/learning-and-resources/trademark-faqs> (last modified Aug. 5, 2016).

<sup>32</sup> See *Blackhorse*, 111 U.S.P.Q.2d (BNA) at 1083–84.

<sup>33</sup> See *In re Tam*, 808 F.3d 1321, 1334–35 (Fed. Cir. 2015).

<sup>34</sup> *Id.*

<sup>35</sup> *Id.*

<sup>36</sup> *R.A.V. v. City of St. Paul*, 505 U.S. 377, 382–83 (1992).

the First Amendment.<sup>37</sup> Among the limits on speech that are strictly abhorred, are restrictions by the government based on the content of speech that the government dislikes.<sup>38</sup> Indeed, the Supreme Court has held “[c]ontent-based regulations are presumptively invalid.”<sup>39</sup> A government restriction based on the content of the speech “may be justified only if the government proves that they are narrowly tailored to serve compelling state interests.”<sup>40</sup> This phrase is the essence of strict scrutiny, which applies when there is any government action that seeks to limit speech based on its content.<sup>41</sup> If this rigorous standard cannot be met, the restriction is void under the First Amendment.<sup>42</sup>

In addition to restrictions based on the content of speech, equally disfavored are restrictions based upon the substantive viewpoint of the speaker.<sup>43</sup> Indeed, they have been held to be an “egregious form of content discrimination.”<sup>44</sup> This concern comes about as discrimination based on the viewpoint of an idea may result in that idea being driven from the public sphere or “from the marketplace” as it has been elucidated by the Supreme Court.<sup>45</sup> Because of the risks of using government power in this way, any such regulation receives heightened scrutiny from the judiciary.<sup>46</sup> Indeed the concern is so high about dangers of discriminating based upon the viewpoint of the speaker that regulations that merely burden speech based on the speaker’s viewpoint still receive heightened scrutiny.<sup>47</sup> This comes about because these burdens are seen to be very similar to a total ban on speech.<sup>48</sup> Even financial burdens on speech stemming from content or viewpoint discrimination can require this level of scrutiny.<sup>49</sup>

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<sup>37</sup> *Id.*

<sup>38</sup> *Id.* at 382.

<sup>39</sup> *Id.*

<sup>40</sup> *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2226 (2015).

<sup>41</sup> *In re Tam*, 808 F.3d 1321, 1334 (Fed. Cir. 2015).

<sup>42</sup> *Id.*

<sup>43</sup> *Id.* at 1334–35.

<sup>44</sup> *Rosenberger v. Rector & Visitors of the Univ. of Va.*, 515 U.S. 819, 829 (1995).

<sup>45</sup> *Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd.*, 502 U.S. 105, 116 (1991).

<sup>46</sup> *Sorrell v. IMS Health, Inc.*, 131 S. Ct. 2653, 2664 (2011).

<sup>47</sup> *United States v. Playboy Entm't Grp., Inc.*, 529 U.S. 803, 812 (2000);

*Rosenberger*, 515 U.S. at 828.

<sup>48</sup> *Sorrell*, 131 S. Ct. at 2664; *Playboy Entm't Grp.*, 529 U.S. at 812.

<sup>49</sup> *Rosenberger*, 515 U.S. at 828.

## B. Government Speech

The doctrine of government speech is important to the question of the Redskins' trademarks as it has been raised as a defense by both the federal government in the *Tam* decision and the private parties who initiated the *Blackhorse* challenge.<sup>50</sup> If applicable, it would allow the *Blackhorse* decision to stand.<sup>51</sup> In general, the doctrine of government speech means that the government can choose what it will say to the people of the United States.<sup>52</sup> Furthermore, it can choose specific viewpoints it wants to express at the expense of other views without being subject to First Amendment scrutiny.<sup>53</sup> The government is thus not bound by this limitation in regards to its own speech and can freely choose, like an individual, what views it would like to express and what views it would not like to express, without having to face potential lawsuits.<sup>54</sup> This approach is as much grounded in a practical concern about the government being able to function without sending mixed messages to its citizens as it is about communicating the federal government's ideological preferences.<sup>55</sup>

The Supreme Court has not shied away from invoking this principle when it has felt it was necessary.<sup>56</sup> Objects such as license plates and the placement of private monuments on public land have been found to be government speech that the government can freely choose to regulate without conflicting with the First Amendment.<sup>57</sup> While not broadly applicable, it is a well-established doctrine in American constitutional jurisprudence that allows for a limited but impactful exception to the First Amendment.<sup>58</sup>

## IV. ORIGIN OF THE REDSKINS CASES

The long history of litigation concerning the Redskins trademark began in 1992 when Susan Shown Harjo and six other Native Americans filed a petition with the TTAB seeking the cancellation of

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<sup>50</sup> *In re Tam*, 808 F.3d 1321, 1345 (Fed. Cir. 2015); *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 457 (E.D. Va. 2015).

<sup>51</sup> *See Blackhorse*, 112 F. Supp. 3d at 464.

<sup>52</sup> *Rosenberger*, 515 U.S. at 833.

<sup>53</sup> *Rust v. Sullivan*, 500 U.S. 173, 194 (1991).

<sup>54</sup> *Johanns v. Livestock Mktg. Ass'n*, 544 U.S. 550, 553 (2005).

<sup>55</sup> *See Pleasant Grove City v. Summum*, 555 U.S. 460, 468 (2009).

<sup>56</sup> *See Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2253 (2015); *Summum*, 555 U.S. at 464.

<sup>57</sup> *Walker*, 135 S. Ct. at 2253; *Summum*, 555 U.S. at 464.

<sup>58</sup> *See Walker*, 135 S. Ct. at 2245–46.

the Redskins' trademarks.<sup>59</sup> Their petition cited Section 2(a) of the Lanham Act, alleging that the mark itself brought "contempt, ridicule, and disrepute" on Native Americans and was disparaging as well.<sup>60</sup> This filing was followed by an extended period of litigation that ultimately culminated in the TTAB cancelling the mark based upon the disparagement it brought upon Native Americans.<sup>61</sup>

This decision was appealed to the District Court for the District of Columbia.<sup>62</sup> The district court ultimately reversed on two grounds.<sup>63</sup> The court first found that there was a lack of substantial evidence to support the contention that the marks were disparaging.<sup>64</sup> The district court also held that the plaintiffs had delayed in bringing their claims and thus were barred by the doctrine of laches.<sup>65</sup> The Circuit Court for the District of Columbia remanded for a determination of whether one of the plaintiffs was still barred by laches.<sup>66</sup> The district court again held that this plaintiff was barred by laches, which was affirmed on appeal.<sup>67</sup>

### A. Current Redskins litigation

As the initial litigation played out in the federal courts, Amanda Blackhorse and four other Native Americans filed a separate petition in 2006 with the TTAB to cancel the Redskins mark on the grounds that it disparages Native Americans in contravention of Section 2(a) of the Lanham Act.<sup>68</sup> On June 18, 2014, the TTAB granted their petition and cancelled the Redskins' marks on the basis that they were disparaging to Native Americans.<sup>69</sup> The Redskins then sought reversal of this decision in the District Court for the Eastern District of Virginia, a proceeding in which they would receive a *de novo* review of the TTAB's decision.<sup>70</sup>

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<sup>59</sup> Blackhorse v. Pro-Football, Inc., 111 U.S.P.Q.2d (BNA) 1080, 1083–84 (T.T.A.B. 2014).

<sup>60</sup> *Id.*

<sup>61</sup> Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d (BNA) 1705, 1743 (T.T.A.B. 1999).

<sup>62</sup> Pro-Football, Inc. v. Harjo, 284 F. Supp. 2d 96, 99 (D.D.C. 2003).

<sup>63</sup> *Id.* at 145.

<sup>64</sup> *Id.* at 135–36.

<sup>65</sup> *Id.* at 144.

<sup>66</sup> Pro-Football, Inc. v. Harjo, 415 F.3d 44, 46 (D.C. Cir. 2005).

<sup>67</sup> Pro Football, Inc. v. Harjo, 565 F.3d 880, 881 (D.C. Cir. 2009).

<sup>68</sup> Pro-Football, Inc. v. Blackhorse, 112 F. Supp. 3d 439, 450–51 (E.D. Va. 2015).

<sup>69</sup> Blackhorse v. Pro-Football, Inc., 111 U.S.P.Q.2d (BNA) 1080, 1082–83 (T.T.A.B. 2014).

<sup>70</sup> 15 U.S.C. § 1071(b) (2012); *Blackhorse*, 112 F. Supp. 3d at 451.

**B. *Pro-Football v. Blackhorse* in District Court**

After reviewing the submissions by the parties, the district court granted Blackhorse's motion for summary judgment under Federal Rule of Civil Procedure 56.<sup>71</sup> To begin, the court made a strong distinction between trademark registration and trademarks in of themselves.<sup>72</sup> It wrote about how the cancelling of a trademark merely removes federal recognition of the mark and does not force an individual or a corporation to stop using the mark itself.<sup>73</sup>

The court then held that the Redskins allegations, that Section 2(a) constitutes an infringement on the Redskins' First Amendment rights, failed for two reasons.<sup>74</sup> First, Section 2(a) did not violate the First Amendment.<sup>75</sup> Second, given the decision of the Supreme Court in *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*, the trademark program constitutes government speech that is exempt from First Amendment scrutiny.<sup>76</sup> First, the court distinguished the cases that the Redskins cited when alleging the trademark program violated their First Amendment rights.<sup>77</sup> Courts confronted with this same issue have previously held that denying the registration of a trademark would not constitute a violation of the First Amendment.<sup>78</sup> Additionally, the district court held that cancelling the trademark does not drive the Redskins speech from the marketplace because they may continue to use the mark, just without the protections of the federal trademark program.<sup>79</sup>

The court devoted a great deal of time to explaining its reasoning for the second and perhaps more controversial ground for upholding the TTAB's decision: that the trademark program constitutes government speech and thus is exempt from First Amendment scrutiny.<sup>80</sup> Blackhorse and the federal government both advocated for this approach.<sup>81</sup> In coming to this decision, the court relied heavily upon the recent Supreme Court decision in *Walker*.<sup>82</sup>

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<sup>71</sup> Blackhorse, 112 F. Supp. 3d at 447–48, 451.

<sup>72</sup> *Id.* at 453–54.

<sup>73</sup> *See id.*

<sup>74</sup> *Id.* at 455–57.

<sup>75</sup> *Id.*

<sup>76</sup> *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015); *Blackhorse*, 112 F. Supp. 3d at 457–59.

<sup>77</sup> *Blackhorse*, 112 F. Supp. 3d at 455–56.

<sup>78</sup> *Test Masters Educ. Serv. v. Singh*, 428 F.3d 559, 578 n.9 (8th Cir. 2005); *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981).

<sup>79</sup> *See Blackhorse*, 112 F. Supp. 3d at 457.

<sup>80</sup> *Id.* at 457–59.

<sup>81</sup> *Id.* at 457.

<sup>82</sup> *Id.* at 458–59.

In *Walker*, the Supreme Court held that the Texas Department of Motor Vehicles could reject a request from the Sons of Confederate Veterans to create a specialty license plate on which a Confederate flag would be displayed.<sup>83</sup> The Court came to this decision by way of a three part test.<sup>84</sup> First they found that license plates have long been used to convey information by the state in the form of identification information that is present on the license plate.<sup>85</sup> Second, they found that the public would “closely identify” license plates with the state.<sup>86</sup> And finally, they held that Texas maintains direct control over the license plate program.<sup>87</sup> All of these factors weighed in favor of finding that the program constitutes government speech.<sup>88</sup> The court, as in previous cases concerning government speech, was concerned about the effects of not allowing a state to choose how it conveyed itself with its own speech.<sup>89</sup>

In *Blackhorse*, the district court applied the test used in *Walker* and found it controlling on its decision.<sup>90</sup> First, the court found that if the government allows a trademark to be registered, then it necessarily approves of the trademark and the information it conveys.<sup>91</sup> Second, the public would closely associate the trademark program with the federal government because the government runs and operates the program.<sup>92</sup> Finally, the editorial control exercised by the Patent Office demonstrates that the federal government has direct control over the trademark program.<sup>93</sup> Because the court found these three factors to be present, by direct implication the trademark program constitutes government speech.<sup>94</sup>

After finding the trademark program to be government speech, the district court discussed why the government was entitled to control the speech content of its own programs.<sup>95</sup> It particularly focused its analysis using *Rust v. Sullivan*, a 1991 case in which the Supreme Court held that the federal government did not violate the First

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<sup>83</sup> *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2243–44 (2015).

<sup>84</sup> *Id.* at 2248–50.

<sup>85</sup> *Id.* at 2248.

<sup>86</sup> *Id.*

<sup>87</sup> *Id.* at 2249.

<sup>88</sup> *Id.*

<sup>89</sup> *Id.*; see also *Pleasant Grove City v. Sumnum*, 555 U.S. 460, 464 (2009).

<sup>90</sup> *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 458–59 (E.D. Va. 2015).

<sup>91</sup> *Id.* at 458.

<sup>92</sup> *Id.* at 458–59.

<sup>93</sup> *Id.* at 459.

<sup>94</sup> *Id.*

<sup>95</sup> See *id.* at 462–64.

Amendment by restricting federal funding to grantees of a federal program for certain services.<sup>96</sup> The Court specifically held that forcing the government to exhibit every possible viewpoint of a citizen would send conflicting messages to the public.<sup>97</sup> Thus the federal government had the ability to define the outer limits of the program, which would include the message it conveyed.<sup>98</sup>

In *Blackhorse*, the district court embraced the approach of *Rust*, holding that the reasoning in *Rust* applied to the trademark program's refusal to register disparaging trademarks.<sup>99</sup> The court made this analogy because the trademark program is one created wholly by Congress, and thus it is not unreasonable for Congress to delineate the limits of what is acceptable under the program.<sup>100</sup> Because of this similarity, the reasoning of *Rust* would be equally applicable to the trademark program.<sup>101</sup>

The court also rejected several other grounds advanced by the Redskins, including a Fifth Amendment claim, that the cancellation of their trademark should be reversed.<sup>102</sup> The district court concluded its decision by reviewing and affirming the evidence that TTAB found indicated that the name "Redskins" was disparaging for purposes of the Lanham Act.<sup>103</sup> Thus the district court affirmed the decision of TTAB.<sup>104</sup> The Redskins appealed the district court's decision to the Fourth Circuit Court of Appeals.<sup>105</sup>

### C. *In re Tam* and a shift in the Lanham Act

The case against the Redskins would seem to be straightforward given existing precedent and the holdings of the district court. However, in the months following the district court's decision, the landscape of Section 2(a) changed rapidly when the disparagement clause was held unconstitutional as a violation of the First Amendment.<sup>106</sup> This shift in the law came from the efforts of a

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<sup>96</sup> *Rust v. Sullivan*, 500 U.S. 173, 194, 203 (1991).

<sup>97</sup> *Id.* at 194.

<sup>98</sup> *Id.*

<sup>99</sup> *Blackhorse*, 112 F. Supp. 3d at 462–64.

<sup>100</sup> *See id.* at 463–64.

<sup>101</sup> *Id.* at 464.

<sup>102</sup> *See id.* at 464–67.

<sup>103</sup> *See id.* at 467–88 (reviewing evidence submitted to TTAB and district court on question of whether Redskins is a disparaging term).

<sup>104</sup> *Id.* at 489–90.

<sup>105</sup> Brief for Appellant, *Pro-Football, Inc. v. Blackhorse*, No. 15-1874 (4th Cir. Oct. 30, 2015).

<sup>106</sup> *See In re Tam*, 808 F.3d 1321, 1328 (Fed. Cir. 2015).

musician to obtain a trademark for a band name.<sup>107</sup>

Simon Tam is the “front man” for The Slants.<sup>108</sup> The Slants are an Asian-American band whose music is aimed at furthering the debate over race and politics in the United States.<sup>109</sup> They aim to accomplish this, through not only their music, but also through the name of the band itself, which reflects a long-time slur against Asians and Asian Americans.<sup>110</sup>

Mr. Tam attempted to get a trademark registered for the band name, but he was rejected by the Patent Office because the TTAB found the name to be disparaging to persons of Asian descent.<sup>111</sup> Mr. Tam then filed suit in federal court in an attempt to overturn this decision.<sup>112</sup> Among his arguments was that Section 2(a) was unconstitutional as a limitation on the First Amendment.<sup>113</sup> A divided panel of the Circuit Court for the Federal Circuit found that a mark for “The Slants” would be disparaging to Asians and thus upheld the denial of registration.<sup>114</sup> The Federal Circuit then granted *en banc* rehearing of the case and issued its decision on December 22, 2015.<sup>115</sup>

This decision broadly impacts federal copyright law as it concerns Section 2(a).<sup>116</sup> The Federal Circuit held that the provision of 2(a) banning the registration of “disparaging” marks was unconstitutional as it directly violates the First Amendment.<sup>117</sup> The court stated numerous reasons for this holding.<sup>118</sup> There were two reasons most relevant to the question of whether the restrictions violated the First Amendment.<sup>119</sup> First, the restrictions implemented by Section 2(a) are neither viewpoint nor content neutral restrictions on speech.<sup>120</sup> Second, the federal trademark program does not constitute government speech.<sup>121</sup>

The *en banc* court held that in regards to content and viewpoint

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<sup>107</sup> See *id.* at 1331.

<sup>108</sup> *Id.*

<sup>109</sup> *Id.*

<sup>110</sup> *Id.*

<sup>111</sup> *Id.* at 1331–32.

<sup>112</sup> *Id.* at 1332.

<sup>113</sup> *Id.*

<sup>114</sup> *In re Tam*, 785 F.3d 567, 570–71 (Fed. Cir. 2015), *rev'd en banc*, 808 F.3d 1321 (Fed. Cir. 2015).

<sup>115</sup> *In re Tam*, 808 F.3d at 1321, 1334; *In re Tam*, 600 F. App'x 775, 775–76 (Fed. Cir. 2015).

<sup>116</sup> See *Tam*, 808 F.3d at 1328.

<sup>117</sup> *Id.*

<sup>118</sup> *Id.* at 1339.

<sup>119</sup> *Id.* at 1337, 1339.

<sup>120</sup> *Id.* at 1337.

<sup>121</sup> *Id.* at 1339.

neutrality of the speech, the federal government was clearly regulating the language based on what the mark represents as well as the view that the mark was expounding upon.<sup>122</sup> Because strict scrutiny applied to the trademark program, the government's arguments failed as there was no exceedingly persuasive justification for these limitations.<sup>123</sup> According to the court, the trademark program discriminates based on the content of the speech, particularly to stifle specific viewpoints and opinions the government opposes.<sup>124</sup> In their eyes, this constituted a clear First Amendment violation.<sup>125</sup>

In addition to discussing the content and viewpoint neutrality of the trademark program and Section 2(a), the *Tam* court also addressed the government's contention that the trademark program constitutes government speech that is exempt from First Amendment scrutiny.<sup>126</sup> After holding that the use of a trademark constitutes a private action rather than government speech, the court addressed *Walker*.<sup>127</sup> In their discussion of *Walker*, they found the trademark program to be clearly distinguishable from the license plate program that the Supreme Court found to be governmental speech.<sup>128</sup> The fact that the marks registered under the program are not created by the government, owned by the government, or used to convey some sort of information or message from the government weighs against a finding that the trademark program constitutes government speech.<sup>129</sup> The court found particularly instructive the fact that the government regularly registers marks that would clearly endorse viewpoints that the government does not or could not take.<sup>130</sup> This combined to render the trademark program subject to traditional First Amendment scrutiny.<sup>131</sup>

## V. ANALYSIS

After having reviewed this precedent, the issue of how it applies to the *Blackhorse* decision becomes of paramount importance. The first point of analysis must focus on whether the trademark program amounts to viewpoint discrimination followed by whether the

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<sup>122</sup> *Id.* at 1336–37.

<sup>123</sup> *See id.* at 1334, 1337.

<sup>124</sup> *Id.* at 1337.

<sup>125</sup> *Id.*

<sup>126</sup> *Id.* at 1339.

<sup>127</sup> *Id.* at 1346–47.

<sup>128</sup> *Id.*

<sup>129</sup> *See id.*

<sup>130</sup> *Id.*

<sup>131</sup> *See id.* at 1348.

trademarks at issue are government speech.<sup>132</sup> If trademarks are not covered by government speech, then the federal government's cancellation of the Redskins' marks violates the First Amendment.<sup>133</sup> It is here in this analysis that the recent *Tam* decision will be most illustrative.

### A. Content and Viewpoint Discrimination in the Trademark Program

The first issue that must be discussed is whether the trademark program even engages in content and viewpoint discrimination.<sup>134</sup> If it does not, then there is no real issue to be litigated. When the facts are examined for the trademark program, and the Redskins trademark decision in particular, it is very clear that viewpoint discrimination does occur. First, the mere act of deciding whether a statement is "disparaging" necessitates a subjective judgment call. The word "disparaging" can have a great number of different meanings and the degree to which a statement or action can be disparaging necessarily differs between individuals.<sup>135</sup>

In *Blackhorse*, the court clearly engaged in weighing whether the statements were disparaging.<sup>136</sup> To do this, it looked at various affidavits and the statements of experts to determine if the TTAB's decision was supported by the requisite evidence.<sup>137</sup> After reviewing this material, along with a litany of references to the word "redskin" in literature, the district court held that there was evidence to support the TTAB's findings.<sup>138</sup> Thus, it upheld the TTAB's decision.<sup>139</sup>

However, these simple acts that the TTAB and the district court engage in when deciding whether to cancel a trademark's registration based on disparaging language results in both content and viewpoint discrimination. First, looking at a trademark and deciding whether it is disparaging requires an explicit examination of the content of the speech.<sup>140</sup> The whole thrust of the TTAB's decision-making process

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<sup>132</sup> See *id.* at 1339–40, 1345.

<sup>133</sup> See *id.* at 1328.

<sup>134</sup> See *id.* at 1339–40.

<sup>135</sup> *Disparage*, MERRIAM-WEBSTER, <http://www.merriam-webster.com/dictionary/disparage> (last visited Feb. 25, 2016).

<sup>136</sup> See *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 467–89 (E.D. Va. 2015) (reviewing evidence put forward by Blackhorse alleging "redskins" is a disparaging term).

<sup>137</sup> See *id.*

<sup>138</sup> *Id.* at 489.

<sup>139</sup> *Id.* at 490.

<sup>140</sup> *Id.* at 472.

is to look at the trademark itself and determine whether it is disparaging.<sup>141</sup> A government body simply cannot engage in this type of decision-making process without looking at the content of the mark itself and what message this mark expresses.<sup>142</sup> Whenever TTAB determines whether the mark is disparaging, they cannot accomplish this goal without a consideration of what the speech is actually saying. Thus, being non-neutral in targeting its prohibition on disparaging speech is central to the statute and thus clearly not content neutral.

In addition to this lack of content neutrality, the regulations imposed by the Section 2(a) also explicitly require the government to engage in unconstitutional viewpoint discrimination when it calls on the Patent Office to refuse to register disparaging marks. By affirming that it will not sanction marks that are disparaging, the government clearly states a preference for non-disparaging speech.<sup>143</sup> The implication of taking this position is that the government explicitly favors the views of the individual or entity with, as the government sees it, a non-disparaging mark over those with one that they define as carrying a disparaging connotation.<sup>144</sup> The former will receive the protections that the federal trademark program can provide, but the latter will not receive those same protections.<sup>145</sup>

While cancellation is not a ban on continued use of a mark, these holders will lack many of the statutory protections that are available to a registered trademark.<sup>146</sup> This stark difference arises only because of the difference in message conveyed by each mark. The fact that this distinction required by statute constitutes viewpoint discrimination is very clear.

## **B. Trademarks are not covered by the doctrine of government speech**

Now the issue of whether the trademark program as applied in *Blackhorse* constitutes government speech must be examined. Due to the degree of content and viewpoint discrimination that occurs in the trademark process, only the government speech doctrine can save the

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<sup>141</sup> See *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1742–48 (T.T.A.B. 1999).

<sup>142</sup> *Id.* at 1710.

<sup>143</sup> *Id.*

<sup>144</sup> *Id.*

<sup>145</sup> See Justin G. Blankenship, *The Cancellation of Redskins as a Disparaging Trademark: Is Federal Trademark Law an Appropriate Solution for Words That Offend?*, 72 U. COLO. L. REV. 415, 420 (2001).

<sup>146</sup> See *Park 'n Fly v. Dollar Park & Fly*, 469 U.S. 189, 193 (1985).

program from these constitutional infirmities.<sup>147</sup> The *Blackhorse* court unequivocally held that the federal trademark program does constitute government speech.<sup>148</sup> It particularly focused on the test used in the *Walker* decision to support this holding.<sup>149</sup> However, applying this test in light of *Tam* raises questions about the district court's decision concerning the applicability of government speech.

First, the district court held that, given the *Walker* test, the trademark program communicates a message from the government that the government approves of the registration by the fact that it has granted the registration in the first place.<sup>150</sup> This rationale does not stand for several reasons. First, a trademark merely communicates that a mark has met the requirements set out by the Patent Office to qualify as a mark.<sup>151</sup> This does not convey a message as would be understood by the general populace. As the *Tam* court pointed out, a mark only sends the message that a mark has been registered.<sup>152</sup> It says nothing about the government endorsing the product itself.<sup>153</sup> It does not convey a political or social message, like putting up a monument on government property or a license plate would.<sup>154</sup> Merely, it speaks to the fact of the mark's registration and compliance with statutory requirements.<sup>155</sup> Thus, it is doubtful that the average person would believe that the government is directly conveying a message when they see a trademark next to a good or symbol.<sup>156</sup> Indeed, as the *Tam* court pointed out, it is hard to believe that most individuals, when they see a mark on a product like Coca-Cola, would believe that the government is directly endorsing the product through the granting of a mark.<sup>157</sup> The Federal Circuit additionally pointed out that the government has rejected the notion that the registration of a mark is the government endorsing the mark.<sup>158</sup>

This argument is directly applicable to the Redskins controversy. It is difficult to see how the presence of a trademark on the Redskins'

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<sup>147</sup> See *In re Tam*, 808 F.3d 1321, 1345 (Fed. Cir. 2015).

<sup>148</sup> *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 464 (E.D. Va. 2015).

<sup>149</sup> *Id.* at 458–59.

<sup>150</sup> *Id.* at 458.

<sup>151</sup> See *Tam*, 808 F.3d at 1346.

<sup>152</sup> *Id.*

<sup>153</sup> See *id.* at 1345.

<sup>154</sup> *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2253 (2015).

<sup>155</sup> *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1219–20 n.3 (T.T.A.B. 1993).

<sup>156</sup> See *Tam*, 808 F.3d at 1347; Lefstin, *supra* note 8, at 684.

<sup>157</sup> *Tam*, 808 F.3d at 1345.

<sup>158</sup> *Id.* at 1347; see also *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d at 1219–20 n.3 (1993).

logos would be believed to be a direct government endorsement of the Redskins'. An even greater assumption to make is that the government therefore endorses any connotations that the word "redskins" may have beyond football. However involved in daily life the federal government may be, it is unclear that a large portion of the population would look at a trademark on a sports logo and assume that this was an endorsement of the content of the mark from the government to its people.<sup>159</sup> It is unlikely that Redskins fans would take the presence of a ® mark on their team's logo and merchandise as a sign the federal government morally approved of the team's use of a Native American imagery.

Additionally, by holding that the granting of a trademark conveys a message that the government approves of the mark, the district court only strengthens the argument that the trademark program facilitates viewpoint discrimination. If the government can say that it favors one mark over another and is using the trademark program to advance this goal, thereby penalizing a message it does not like by denying it the protections of the trademark program, the government is clearly indicating that it is discriminating based on the viewpoint of the speaker.<sup>160</sup> When it favors certain speakers over others in this way, the government indicates its preference for certain ideological positions and states that it ultimately makes a decision about the speech based on the views it expresses, a clearly impermissible approach.<sup>161</sup>

Secondly, the district court held that the general public closely associates the ® mark with the government's trademark program and thus under *Walker* it would be a program closely associated with the federal government and thus fall under the doctrine of government speech.<sup>162</sup> This reasoning fails as it mistakenly compares the license plates at issue in *Walker*, which represent longstanding government creations, to trademarks, which are almost entirely private creations and associated by the public as such.<sup>163</sup>

The *Tam* court pointed out that license plates are clearly understood to be conveying identifying information from the government that private entities do not issue or even have the power to issue in the first place.<sup>164</sup> According to the *Tam* court, it is clear that

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<sup>159</sup> Lefstin, *supra* note 8, at 684.

<sup>160</sup> Lefstin, *supra* note 8, at 684.

<sup>161</sup> See *R.A.V. v. St. Paul*, 505 U.S. 377, 382 (1992).

<sup>162</sup> *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 458–59 (E.D. Va.

2015).

<sup>163</sup> See *Tam*, 808 F.3d at 1346.

<sup>164</sup> See *id.*

the public would associate license plates with a government entity of some sort.<sup>165</sup> However, that court was not persuaded that an individual looking at trademarks associated with private individuals would believe that registered trademarks would also be an extension of the government.<sup>166</sup> Finally, the *Tam* court rejected the argument that because a ® mark was attached to a good the private trademark was therefore transformed into government speech.<sup>167</sup>

The same argument is just as applicable to the issue in *Blackhorse*. It may be true in general that some portion of the population is aware that trademarks originate from the government, but it is difficult to extrapolate from this fact that the trademark program itself is closely associated with the government. When a Redskins fan sees the ® mark next to the team name, it is highly unlikely that a connection is made between the mark and the government.<sup>168</sup> This is a function of the setting and size of the mark itself.<sup>169</sup> First, a ® mark is quite small when compared to the overall size of the mark. This would make sense as a ® mark is merely conveying that the mark is on the federal registry to serve as a warning to those who might want to infringe on the mark.<sup>170</sup> The mark holder wants the public to look at and think about the mark itself rather than the legal formality of its registration.<sup>171</sup> Secondly, the ® is on the periphery of the mark rather than being located front and center. This again makes sense when the purpose of a trademark, to convey a message to the public from a private entity, is considered.<sup>172</sup>

The setting and size of the ® mark additionally matters in the context of the Redskins' marks. When an individual sees a Redskins logo, the most likely assumption is that the individual does not even pay attention to the ® mark at all rather than link the mark with the government. Even if they do make such a connection, it stretches credulity to believe that these fans would then assume that the federal government, by virtue of a ® mark, actually control and own the

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<sup>165</sup> *Id.*

<sup>166</sup> *Id.*

<sup>167</sup> *Id.* at 1347.

<sup>168</sup> *Id.*; Lefstin, *supra* note 8, at 684.

<sup>169</sup> See *Tam*, 808 F.3d at 1346 (explaining that the government does not size and format the mark; therefore, there is no basis for finding that consumers would associate a private trademark with the government).

<sup>170</sup> See *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1220 n.3 (T.T.A.B. 1993).

<sup>171</sup> See, e.g., *Tam*, 808 F.3d at 1327, 1332 (noting a connection between the expressive power of trademarks and Mr. Tam's use of the name "The Slants" for his band to make a statement about racial and cultural issues).

<sup>172</sup> *Id.* at 1347.

Redskins logo. At a minimum, it is unclear that the trademark program would be closely associated, if not directly disassociated, in the minds of the public with the federal government.<sup>173</sup>

Finally, on the third *Walker* issue the district court held that because the government holds editorial control over the trademark program, it has the “direct control” that the *Walker* decision stated was an element of determining whether a program is government speech.<sup>174</sup> This holding is flawed as it mistakenly construes trademarks, objects utilized almost entirely by private entities, with those like license plates that are the exclusive domain of the government.<sup>175</sup> The inherently private nature of a trademark weighs heavily against finding that the federal government exercises the “direct control” needed to make the marks government speech.<sup>176</sup> Trademarks are almost always placed on goods or logos that are issued by private individuals or businesses.<sup>177</sup> The government does not insinuate itself into the process of creating trademarks.<sup>178</sup> Individuals conceive, design, and complete the mark before it ever is examined by a government official.<sup>179</sup>

There is nowhere near the level of government input that is present in the creation of license plates. With a license plate, an individual has a limited choice of what designs and backgrounds they can have on their plate.<sup>180</sup> The number on the plate is assigned unless one makes an additional payment for a specialty plate, whose contents are also subject to limits as *Walker* demonstrated.<sup>181</sup> This is almost the complete opposite of the trademark process in which private individuals and entities can design their marks as they please. While this difference is not necessarily fatal to the claim that trademarks are government speech, it clearly demonstrates that trademarks are almost exclusively placed on objects that convey information from private entities rather than the government.<sup>182</sup>

The voluntariness of obtaining a trademark also cuts against the notion that the government exercises any form of substantive control

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<sup>173</sup> *See id.*

<sup>174</sup> *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 45859 (E.D. Va. 2015).

<sup>175</sup> *See Tam*, 808 F.3d at 1346.

<sup>176</sup> *Id.*; *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2249 (2015).

<sup>177</sup> *Walker*, 135 S. Ct. at 1345.

<sup>178</sup> *Id.* at 1346.

<sup>179</sup> *Id.*

<sup>180</sup> *Id.*

<sup>181</sup> *See id.* at 2252.

<sup>182</sup> *Tam*, 808 F.3d at 1346.

over the trademark program. Firstly, obtaining a trademark is purely a voluntary act.<sup>183</sup> One can utilize a mark without registering it with the Patent Office.<sup>184</sup> Products that have been registered and are entitled to a ® mark do not need to place the mark on their products for the protections of the trademark program to apply to their goods.<sup>185</sup> Registration merely increases the legal protections the mark receives.<sup>186</sup> However, every car must have a license plate, which can only be issued by a government entity.<sup>187</sup> Indeed, there can be penalties for refusing to display a plate.<sup>188</sup> The coercive nature of this requirement is far different from that of the trademark program. Because only a government entity can issue a license plate, anytime an individual sees a plate, it would be natural for them to see the government projecting a statement to the public.<sup>189</sup> Thus the government's need to control what content is projected on a license plate clearly differentiates it from the entirely voluntary world of trademarks.

The placement of monuments on government land, as in *Summum*, carries many of the same concerns of license plates regarding the message being conveyed by the government.<sup>190</sup> The federal government has control over what occurs on its property, including what it places on this property.<sup>191</sup> Thus it has the authority to make choices about what messages it wants to convey with what it places on its property.<sup>192</sup>

While both may come under the auspices of the federal government, the degree of control over every facet of an object, such as public lands or license plates, completely differentiates it from trademarks, where the government plays no role in the creation or

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<sup>183</sup> See *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 454 (E.D. Va. 2015).

<sup>184</sup> *Ritchie v. Simpson*, 170 F.3d 1092, 1099 (Fed. Cir. 1999).

<sup>185</sup> 15 U.S.C. § 1111 (2012).

<sup>186</sup> See *Park 'n Fly v. Dollar Park & Fly*, 469 U.S. 189, 193 (1985).

<sup>187</sup> *E.g.*, FLA. STAT. § 316.605 (2015); MO. REV. STAT. § 301.030 (2015).

<sup>188</sup> *E.g.*, FLA. STAT. § 320.07(3) (2015); MO. REV. STAT. § 301.440 (2015).

<sup>189</sup> See *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2248 (2015).

<sup>190</sup> See *Pleasant Grove City v. Summum*, 555 U.S. 460, 470 (2009) (“A monument, by definition, is a structure that is designed as a means of expression. When a government entity arranges for the construction of a monument, it does so because it wishes to convey some thought or instill some feeling in those who see the structure.”).

<sup>191</sup> See *id.* at 471 (“We think it is fair to say that throughout our Nation's history, the general government practice with respect to donated monuments has been one of selective receptivity.”).

<sup>192</sup> *Id.* at 471–72.

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execution of the mark beyond approving it for the Principal Register.<sup>193</sup>

To further this point, the government has explicitly stated that registration does not mean that the government endorses the mark or what it says.<sup>194</sup> This statement cuts strongly against any claim that the federal government is exercising any form of editorial control. How can the federal government possibly speak, while simultaneously refusing to endorse its message? This contradiction is one that cannot be resolved or easily dismissed.

By stating that it refuses to endorse the message of any mark, the government squarely refutes any claim that it is exercising almost any editorial control at all in the trademark program.<sup>195</sup> If the governmental control is present, it arises merely out of determining whether the formalities of the program registration have been met, rather than the actual editing of the substantive content of any trademark.<sup>196</sup>

For example, the government does not edit or format a mark during the registration process.<sup>197</sup> This may seem to be parsing the statute very narrowly, but this distinction is important in differentiating the nature of the editorial control. If the level of control is not to the extent that *Walker* discusses, then it is difficult to argue that the government speech doctrine is applicable. Thus the admission of how the government does not endorse the content of trademarks further argues against the notion of editorial control on the scale contemplated by *Walker* being present in the trademark program.

A final point is that if the federal government does indeed exercise the editorial control that it argues that it has in the trademark program, then the government would clearly be engaging in viewpoint discrimination. By editing the content of the trademark in refusing to register those with views the government finds objectionable, the government is intentionally targeting and barring speech based on the views that it expresses.<sup>198</sup> This would be viewpoint discrimination even if the doctrine of government speech protected the federal government from constitutional challenges on this subject.

## VI. THE PROTECTION OF FREE SPEECH OUTWEIGHS THE

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<sup>193</sup> *In re Tam*, 808 F.3d 1321, 1346–47 (Fed. Cir. 2015).

<sup>194</sup> *Id.* at 1347; *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1219–20 n.3 (T.T.A.B. 1993).

<sup>195</sup> *See Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) at 1219–20 n.3.

<sup>196</sup> *Id.*

<sup>197</sup> *See Tam*, 808 F.3d at 1346.

<sup>198</sup> *Id.* at 1347.

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**CONCERNS ABOUT DISPARAGEMENT IN TRADEMARKS**

Given the analysis in *Tam* and the facts present in *Blackhorse*, it is difficult to see how the federal trademark program constitutes government speech free from First Amendment scrutiny. Even if the program does fall under the government speech doctrine, the degree to which this program engages in viewpoint discrimination, which would be blatantly unconstitutional in any other circumstance, should give the government pause.<sup>199</sup> Because of this discrimination, the federal government should refuse to enforce trademark registration in a way that would further this discrimination.

To begin, the government's concern about disparaging trademarks is not insubstantial. Words, in contrast to the old saying, can indeed injure an individual to a great extent.<sup>200</sup> No one likes having to confront words or speech that they feel is a direct insult or attack upon their beliefs, their origins, or their heritage. Thus, it is clear that there is no ill-intent behind the prohibitions of Section 2(a) on disparaging trademarks. It does appear that this language was included to protect the feelings of Americans rather than to insidiously clamp down on speech that the government finds objectionable.

However, when it comes to the enforcement of this statutory language, the results can be far from these intentions. Refusing to register trademarks such as those held by the Redskins may lead to good press, but it simultaneously denies a legitimate business of the substantial protections that the trademark program offers, as well as costing the business great amounts of money in legal costs.<sup>201</sup> There is certainly a penalty to the Redskins for taking a politically incorrect viewpoint.<sup>202</sup> Whether the Redskins deserve to be penalized for this is up for debate, but both sides must clearly recognize that the inability to register a trademark has negative effects in the real world.<sup>203</sup>

But the most compelling factor here is the presence of viewpoint discrimination in the federal trademark program when there is a weighing of whether a term is disparaging and then penalizing an entity from taking a position that is contrary to the government's view. It is difficult to argue that the government does not engage in

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<sup>199</sup> See *Rosenberger v. Rector*, 515 U.S. 819, 829 (1995).

<sup>200</sup> *Sticks and stones may break my bones, (but words can never hurt me)*, CAMBRIDGE DICTIONARIES ONLINE, <http://dictionary.cambridge.org/us/dictionary/english/sticks-and-stones-may-break-my-bones-but-words-can-never-hurt-me> (last visited Feb. 17, 2016).

<sup>201</sup> See *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 489–90 (E.D. Va. 2015).

<sup>202</sup> See Blankenship, *supra* note 145 at 421–22.

<sup>203</sup> *Id.*

viewpoint discrimination when it tells the Redskins that they cannot have the protection of a federal trademark based on what their trademark says or connotes. The government is telling the Redskins that it does not like its use of a particular word, even if the Redskins find it to be appropriate. The implication of this impasse is that if the Redskins changed their name to something the government deemed less offensive, then they would again have the protection of the trademark program. An action such as this would clearly be targeted at the content of the Redskins' speech and the viewpoint that they want to represent.

Under other circumstances, the federal government would completely lack the ability to force the Redskins to change their name.<sup>204</sup> If Congress passed a law saying that they could no longer use the name, the Redskins would without question be able to halt this action through the courts.<sup>205</sup> However, given the *Blackhorse* decision, the federal government would be able to accomplish this same result through the federal trademark program and seek protection under the government speech doctrine.<sup>206</sup> The letter of the law would be upheld but perhaps not its spirit.

Even if the government speech doctrine applies, the Patent Office can still allow the registration of the Redskins' trademarks. Federal agencies have long been imbued with a great deal of discretion when enforcing government regulations.<sup>207</sup> Very often this discretion can allow for an agency to fully implement the spirit of the law rather than just its words.<sup>208</sup> Here, the concern is that the Patent Office may have an end-run around First Amendment protections, which has the potential to injure the free speech rights of many private individuals.<sup>209</sup> However, the government does not have to use this loophole and can decide to allow the registration of marks that many may find disparaging.<sup>210</sup> This would serve as a message that the federal government takes the protections of the First Amendment seriously and will not allow a doctrine such as government speech to condone behavior that would be unconstitutional elsewhere, to continue occurring in the world of trademarks.

The argument that this approach may bring disrepute on the government is not persuasive given the marks that have previously

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<sup>204</sup> See *Wooley v. Maynard*, 430 U.S. 705, 715 (1977).

<sup>205</sup> See *Rosenberger v. Rector*, 515 U.S. 819, 829 (1995).

<sup>206</sup> See *Blackhorse*, 112 F. Supp. 3d at 454–55.

<sup>207</sup> See *Heckler v. Chaney*, 470 U.S. 821, 837–38 (1985).

<sup>208</sup> *Id.* at 838–39.

<sup>209</sup> See *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2255–56 (2015) (Alito, J., dissenting).

<sup>210</sup> See *In re Tam*, 808 F.3d 1321, 1346–47 (Fed. Cir. 2015).

been registered. Marks such as Ganja University, Take Yo Panties Off, and Murder 4 Hire have all been given the protection of the federal trademark program that will be denied to the Redskins if the *Blackhorse* decision is upheld.<sup>211</sup> There may be many who find those three, or any other of the litany of similar marks, just as offensive as some individuals find the name Redskins. American democracy is strong enough to tolerate a name such as the Redskins if it can allow marks such as these.

This is not to say that the Redskins must keep their name as some sort of constitutional protest. They are free to change it at any time. In fact, the whole public debate surrounding the name should continue as it raises issues—the treatment of Native Americans—that deserve public scrutiny and debate. If the Redskins ultimately decide based on public opinion (or, more likely, the dollars of their fans) that they should change their name, then nothing should stop them.<sup>212</sup> It may be difficult for some to adopt this approach, but the free market is a powerful driver of change, a lesson companies who have discriminated against other groups have quickly learned.<sup>213</sup> By no means should the president or any other official be stopped from speaking their opinion on this issue, even if it may criticize the Redskins.<sup>214</sup> The government simply should not use its power to punish to act upon these criticisms.<sup>215</sup>

## VII. CONCLUSION

The debate over the Washington Redskins' trademarks has raised great passions from people on both sides of the issue. Whatever these feelings, none could have predicted the long and winding path that the legal challenges to the name have taken. For over two decades there has been uncertainty over the ultimate fate of the name.<sup>216</sup> This

<sup>211</sup> *Id.*

<sup>212</sup> It must be noted in the spirit of full disclosure that the author of this note is a fan of the Redskins' rival, the New York Giants.

<sup>213</sup> See, e.g., Jon Healey, *The Backlash Against the Backlash Against Indiana's New Religious Freedom Law*, L.A. TIMES (Apr. 2, 2015, 5:00, PM), <http://www.latimes.com/opinion/opinion-la/la-ol-indiana-religious-freedom-boycotts-and-intolerance-20150402-story.html>.

<sup>214</sup> Jackson, *supra* note 7.

<sup>215</sup> See Blankenship, *supra* note 145, at 439 (benefits that a holder of a trademark stands to lose include incontestability for five years, prima facie evidence of ownership, and the ability to halt the importation of non-approved goods bearing the mark).

<sup>216</sup> Lakshmi Gandhi, *Are You Ready for Some Controversy? The History of 'Redskin'*, NPR CODE SWITCH (Sept. 9, 2013, 10:46 AM), [http://www.npr.org/sections/codeswitch/2013/09/09/220654611/are-you-ready-for-](http://www.npr.org/sections/codeswitch/2013/09/09/220654611/are-you-ready-for-continued...)

situation has benefitted neither the Redskins nor those challenging in good faith a name that they find offensive. There must be some sort of finality to this question.

The reasoning of *In re Tam* may provide some needed clarity to the legal aspects of this debate. While its holding is so far confined to a hypothetical until the Supreme Court accepts or rejects certiorari, its analysis gives a clear and realistic view of how Section 2(a) operates. Moreover, *In re Tam* fully acknowledges the extent of the content and viewpoint discrimination that the language of the statute contemplates and why this discrimination cannot stand in light of established precedent.

However, even greater is the overall question of how deeply the federal government should weigh into this debate. No one denies the feelings and views of Native Americans and others who are concerned about the connotations that the word “redskins” raises.<sup>217</sup> For a variety of reasons, there is an argument to be made that the team should not keep the name.<sup>218</sup> But whether the government should use its powers to deny the Redskins the protection a trademark provides, when so many other marks that could be deemed offensive receive these protections, raises profound and necessary questions about whether the trademark program should be used to shape this debate.

Freedom of speech is among the greatest gifts the Constitution has bestowed upon the United States. It is one of the most basic building blocks of not only our society, but of any free society in the world.<sup>219</sup> As an idea, it transcends the offense that one individual may take to the words of another. Thus, it is perhaps wise for the federal government to refuse to engage in picking which speech it likes and allow the American people, through their dollars and voices, to ultimately decide how the question of the Redskins is resolved.<sup>220</sup>

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some-controversy-the-history-of-redskin.

<sup>217</sup> Baxter Holmes, *A ‘Redskin’ Is the Scalped Head of a Native American, Sold, Like a Pelt, for Cash*, *ESQUIRE* (June 17, 2014), <http://www.esquire.com/news-politics/news/a29445/true-redskins-meaning/>.

<sup>218</sup> Christopher L. Gasper, *Redskins Name Needs to be Changed*, *BOS. GLOBE* (Aug. 5, 2014), <https://www.bostonglobe.com/sports/football/2014/08/04/washington-redskins-name-needs-changed/xookx46DbYsW4xUNz8ANII/story.html>.

<sup>219</sup> See Steven Pinker, *Why Free Speech is Fundamental*, *BOS. GLOBE* (Jan. 27, 2015), <https://www.bostonglobe.com/opinion/2015/01/26/why-free-speech-fundamental/aaAWVYFscrhFCC4ye9FVjN/story.html>.

<sup>220</sup> After this article was written and in the editorial process, the United States Supreme Court accepted certiorari of the government’s appeal from the Federal Circuit’s decision. See David Greenwald, *The Slants’ trademark case heading to the Supreme Court*, *OREGONLIVE* (Sep. 29, 2016), [http://www.oregonlive.com/music/index.ssf/2016/09/the\\_slants\\_trademark\\_case\\_sup](http://www.oregonlive.com/music/index.ssf/2016/09/the_slants_trademark_case_sup)



