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Tam Through the Lens of Brunetti: THE SLANTS, FUCT

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Note from the Author & Editors:

This Essay addresses a concerning issue that has recently arisen in trademark law—the use of offensive language, including racial slurs, as trademarks. Discussing and using offensive language in any professional setting, including academic scholarship, is challenging and fraught with controversy. During oral argument in *Iancu v. Brunetti*, one of the cases discussed in this piece, Justice Gorsuch pleaded: “I don’t want to go through the examples. I really don’t want to do that.”⁺

The unfortunate reality, as this Essay discusses, is that highly offensive racial slurs and other terms *can* potentially be registered as trademarks after *Brunetti* and *Matal v. Tam*. To depict this “new reality” and to provide a visualization of the ramifications of these cases, we are choosing to include certain racial slurs and visuals, unaltered, as examples of the types of words and images that could now appear as trademarks. For one particular racial epithet, however, we choose to alter its presentation, using asterisks to replace certain internal letters therein.

It is not our intention to cause harm to any readers, or to be insensitive in our choice to use offensive and hurtful terms, whether altered or unaltered. We made our decisions after several careful and thorough discussions within the *Emory Law Journal* staff and with the greater Emory Law School community. We understand that the use of the racial slurs below will be distressing to some readers, and we respect that readers may want to avoid reading this Essay because of the presence of such material.

⁺ Transcript of Oral Argument at 21, *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019) (No. 18-302).

ESSAY

**TAM THROUGH THE LENS OF *BRUNETTI*:
THE SLANTS, FUCT***Ilhyung Lee**

Is there now a constitutional right to register a racial epithet as a trademark?¹ In *Matal v. Tam*, the Supreme Court unanimously struck down a provision of the Lanham Act that prohibits the registration of a trademark that “may disparage ... persons”² as violative of the Free Speech clause of the First Amendment.³ Two plurality opinions emerged (signed on by four members each), but all eight Justices⁴ agreed that the statute impermissibly allows for viewpoint discrimination.⁵ The Court’s ruling thus required the Patent and Trademark Office (PTO) to grant registration of “THE SLANTS” to an Asian American band, which adopted the derogatory term for persons of Asian descent purportedly to “reclaim” and “take ownership” of the stereotype.⁶

Since the issue of the constitutionality of the disparagement clause was joined in *Tam*’s prior proceedings before the Court of Appeals for the Federal

* Edward W. Hinton Professor of Law & Director, Center for the Study of Dispute Resolution, University of Missouri. I thank Gary Myers for his comments and suggestions on a previous version of this Essay.

¹ A trademark is used in connection with “goods,” and a service mark for “services.” Lanham Act, 15 U.S.C. § 1127 (2012) (defining “trademark” and “service mark”). Unless the context dictates otherwise, I refer to “trademark” or “mark” to include both trademarks and service marks.

² 15 U.S.C. § 1052(a) (2012).

³ *Matal v. Tam*, 137 S. Ct. 1744, 1763 (2017) (plurality opinion of Alito, J., joined by Roberts, C.J., Thomas & Breyer, JJ.); *id.* at 1765 (plurality opinion of Kennedy, J., joined by Ginsburg, Sotomayor & Kagan, JJ.).

⁴ When the case reached the Court, Justice Gorsuch had not yet assumed the vacant seat at Justice Antonin M. Scalia’s death.

⁵ *Tam*, 137 S. Ct. at 1763 (plurality opinion of Alito, J., joined by Roberts, C.J., Thomas & Breyer, JJ.); *id.* at 1765 (plurality opinion of Kennedy, J., joined by Ginsburg, Sotomayor & Kagan, JJ.).

⁶ *Id.* at 1754 (quoting *In re Tam*, 808 F.3d 1321, 1331 (Fed. Cir. 2015) (en banc)).

Circuit,⁷ there have been applications to register marks containing racial epithets.⁸ Some have a filing date of June 19, 2017,⁹ the date of the Supreme

⁷ *In re Tam*, 785 F.3d 567, 573 (Fed. Cir.), *vacated and reh'g en banc granted*, 600 F. App'x 775 (Fed. Cir.) (en banc) (per curiam), *and vacated and remanded*, 808 F.3d 1321 (Fed. Cir. 2015) (en banc).

⁸ Examples, from the trademark search function on the PTO's Internet site, <https://www.uspto.gov/trademarks-application-process/search-trademark-database>:

Application to Register CHINK, U.S. PAT. AND TRADEMARK OFFICE, <https://www.uspto.gov/trademarks-application-process/search-trademark-database> (follow "Search our trademark database (TESS)" hyperlink; select "Basic Word Mark Search (New User)"; then search for "CHINK" and select the word mark "CHINK" with Serial Number 87499767 (evidencing an abandoned application to register the word mark "CHINK" for "on-line retail store services featuring clothing, posters, pillows, mugs, tote bags, and mobile electronics cases and covers"));

Application to Register JAP, U.S. PAT. AND TRADEMARK OFFICE, <https://www.uspto.gov/trademarks-application-process/search-trademark-database> (follow "Search our trademark database (TESS)" hyperlink; select "Basic Word Mark Search (New User)"; then search for "JAP" and select the word mark "JAP" with Serial Number 86840326 (evidencing an abandoned application to register the word mark "JAP" for "Bed blankets; Bed canopies; Bed covers; Bed linen;" and other goods and services));

Application to Register JAPAROLL, U.S. PAT. AND TRADEMARK OFFICE, <https://www.uspto.gov/trademarks-application-process/search-trademark-database> (follow "Search our trademark database (TESS)" hyperlink; select "Basic Word Mark Search (New User)"; then search for "JAPAROLL" and select the word mark "JAPAROLL" with Serial Number 87509375 (evidencing an approved application to register the word mark "JAPAROLL" for "Sushi"));

Application to Register JAPS, U.S. PAT. AND TRADEMARK OFFICE, <https://www.uspto.gov/trademarks-application-process/search-trademark-database> (follow "Search our trademark database (TESS)" hyperlink; select "Basic Word Mark Search (New User)"; then search for "JAPS" and select the word mark "JAPS" with Serial Number 87348142 (evidencing an approved application to register the word mark "JAPS" for "Alarm monitoring systems; Audio-receivers and video-receivers"));

Application to Register MR. CHINK, U.S. PAT. AND TRADEMARK OFFICE, <https://www.uspto.gov/trademarks-application-process/search-trademark-database> (follow "Search our trademark database (TESS)" hyperlink; select "Basic Word Mark Search (New User)"; then search for "MR. CHINK" and select the word mark "MR. CHINK" with Serial Number 87819515 (evidencing an abandoned application to register the word mark "MR. CHINK" for "Basketball related sporting goods and equipment"))).

⁹ Examples, from the trademark search function on the PTO's internet site, <https://www.uspto.gov/trademarks-application-process/search-trademark-database>, follow. Note: In the citations below, each mark that contains asterisks within is, in the search query, fully spelled out:

Application to Register N***A, U.S. PAT. AND TRADEMARK OFFICE, <https://www.uspto.gov/trademarks-application-process/search-trademark-database> (follow "Search our trademark database (TESS)" hyperlink; select "Basic Word Mark Search (New User)"; then search for "N***A" and select the word mark "N***A" with Serial Number 87496454 (evidencing a pending application to register the word mark "N***A" for "Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms" and other goods);

Application to Register N***A, U.S. PAT. AND TRADEMARK OFFICE, <https://www.uspto.gov/>

Court's decision. *Tam* took "racial slurs ... off the table,"¹⁰ and the PTO began approving them.¹¹ But not all racial slurs are created equal. For a time post-*Tam*, the agency held in abeyance applications that incorporated "the single-most offensive racial slur,"¹² given the then pending *Iancu v. Brunetti*.¹³ In *Brunetti*, the agency had denied registration of "FUCT," for a clothing line, under a related provision of the Act that bars registration of "immoral ... or scandalous matter."¹⁴ And there was the possibility that some racial epithets might be deemed "scandalous" and thus banned from registration.¹⁵ But it was not to be. Evoking *Tam*, Justice Kagan announced for a majority of the Court in *Brunetti*, "We hold that [the immoral or scandalous] provision infringes the First Amendment for the same reason: It too disfavors certain ideas."¹⁶ The Chief Justice and Justices Breyer and Sotomayor filed separate opinions, each concurring with the majority regarding "immoral" marks but dissenting with respect to "scandalous" terms.¹⁷

My difficulty with *Tam* is its pronouncement of a fundamental right to register a racial epithet as a mark under the federal trademark system. Not a

trademarks-application-process/search-trademark-database (follow "Search our trademark database (TESS)" hyperlink; select "Basic Word Mark Search (New User)"; then search for "N***A" and select the word mark "N***A" with Serial Number 87496567 (evidencing an abandoned application to register the word mark "N***A" for "Retail store services featuring clothing, books, music and general merchandise");

Application to Register N***R PLEASE, U.S. PAT. AND TRADEMARK OFFICE, <https://www.uspto.gov/trademarks-application-process/search-trademark-database> (follow "Search our trademark database (TESS)" hyperlink; select "Basic Word Mark Search (New User)"; then search for "N***R PLEASE" and select the word mark "N***R PLEASE" with Serial Number 87495357 (evidencing an abandoned application to register the word mark "N***R PLEASE" for "Shirts").

These and other applications are also noted in Sonia K. Katyal, *Brands Behaving Badly*, 109 TRADEMARK REP. 819, 825 (2019).

¹⁰ Transcript of Oral Argument at 23, *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019) (No. 18-302).

¹¹ *See id.* at 46.

¹² *Id.* at 61.

¹³ 139 S. Ct. 2294 (2019).

¹⁴ 15 U.S.C. § 1052(a) (2012). As the Court noted, "Both a PTO examining attorney and the PTO's Trademark Trial and Appeal Board decided that *Brunetti*'s mark flunked that test." *Brunetti*, 139 S. Ct. at 2298.

¹⁵ *See* Transcript of Oral Argument at 61, *Brunetti*, 139 S. Ct. 2294 (No. 18-302).

¹⁶ *Brunetti*, 139 S. Ct. at 2297.

¹⁷ *Id.* at 2303 (Roberts, C.J., concurring in part and dissenting in part); *id.* at 2304 (Breyer, J., concurring in part and dissenting in part); *id.* at 2308-09 (Sotomayor, J., concurring in part and dissenting in part).

single member of the Court could advance a theory to uphold the agency's decision to refuse registration. Perhaps the available options that would have exempted the case from the jaws of the Free Speech mandates were not inviting. That is, per the *Tam* text: A trademark is not government speech,¹⁸ a government subsidy,¹⁹ or a government program.²⁰ And even if a trademark were deemed to be commercial speech, which would trigger a less heightened review under *Central Hudson Gas & Electric Corp. v. Public Service Commission*,²¹ four members of the Court stated that *Tam* could not satisfy even the lesser standard.²²

My own view is that since the Government provides a federal trademark system that grants significant benefits to registrants,²³ those who wish to avail themselves of such benefits must play by the rules that the Government sets. In short, there is Government involvement,²⁴ and *federal* registration means something. I also think that the Government does or should have an interest in not registering marks with certain content. These points carried little weight in the ultimate decision in *Tam*. They do appear, however, in the separate opinions in *Brunetti*. For example, Justice Sotomayor noted Government involvement in the promotion of marks,²⁵ and also wrote that “the Government has an interest in not promoting certain kinds of speech,

¹⁸ *Matal v. Tam*, 137 S. Ct. 1744, 1760 (2017) (8-0).

¹⁹ *Id.* at 1760–61 (plurality opinion of Alito, J., joined by Roberts, C.J., Thomas & Breyer, JJ.).

²⁰ *Id.* at 1763.

²¹ 447 U.S. 557 (1980).

²² *Tam*, 137 S. Ct. at 1763–64 (plurality opinion of Alito, J., joined by Roberts, C.J., Thomas & Breyer, JJ.) (citing *Cent. Hudson*, 447 U.S. 557).

²³ *See id.* at 1753. As the Court elaborated in *Tam*:

Registration on the principal register (1) “serves as ‘constructive notice of the registrant’s claim of ownership’ of the mark,” (2) “is ‘prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate,’” and (3) can make a mark “‘incontestable’” [“]once a mark has been registered for five years[.]” Registration also enables the trademark holder “to stop the importation into the United States of articles bearing an infringing mark.”

Id. (citations omitted) (quoting *B&B Hardware, Inc. v. Hargis Indus.*, 135 S. Ct. 1293, 1317 (2015)).

²⁴ *See* Brief of Law Professors as Amici Curiae in Support of the Petitioner at 25, *Tam*, 137 S. Ct. 1744 (No. 15-1293), 2016 WL 6833413; Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, 92 NOTRE DAME L. REV. 381, 393 (2016).

²⁵ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2317 (2019) (Sotomayor, J., concurring in part and dissenting in part) (citing 15 U.S.C. §§ 1062, 1124 (2012)); Brief for United States at 35, *Brunetti*, 139 S. Ct. 2294 (18-302).

whether because such speech could be perceived as suggesting governmental favoritism or simply because the Government does not wish to involve itself with that kind of speech.”²⁶ Similarly, Justice Breyer urged that “[t]he Government ... has an interest in seeking to disincentivize the use of [some] words in commerce by denying the benefit of trademark registration.”²⁷ As discussed herein, I ask whether these rationalizations noted in the *Brunetti* dissents indicate some sense of buyer’s (majority) regret in *Tam* or belated recognition of *Tam*’s consequences.

I readily acknowledge the copyright conundrum. Does not the Government also allow registration of racial slurs in books, songs, and films, among others, all of which have federal copyright registration? The answer is that there is an inherent difference between copyright and trademark. Whereas “[c]opyright protects the expression in a work[,] ... trademark is about protecting a source link rather than a work in itself.”²⁸ Moreover, Congressional authority to provide copyright protection is explicitly provided in the Constitution.²⁹ In contrast, its authority to enact legislation regulating trademarks is based on the Commerce Clause.³⁰ Yet the copyright/trademark distinction was insufficient to sway the Court in *Tam*, as the Justices focused on the expressive content of trademarks, and the First Amendment reigned supreme.³¹

For free speech advocates who prefer few to no restrictions on expression, *Tam* was a case with “favorable facts.”³² In the hierarchy of

²⁶ *Id.* at 2317 (first citing *Ysursa v. Pocatello Educ. Ass’n*, 555 U.S. 353, 359–60 (2009); then citing *Cornelius v. NAACP Legal Def. & Educ. Fund, Inc.* 473 U.S. 788, 809 (1985)).

²⁷ *Id.* at 2307 (Breyer, J., concurring in part and dissenting in part) (citing *Brandenburg v. Ohio*, 395 U.S. 444, 447 (1969) (per curiam)).

²⁸ Tushnet, *supra* note 24, at 422.

²⁹ U.S. CONST. art. I, § 8, cl. 8 (“The Congress shall have Power ... [t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries ...”).

³⁰ *See* Lanham Act, 15 U.S.C. § 1127 (2012) (“The intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.”).

³¹ *Tam*, 137 S. Ct. at 1760.

³² Mark Conrad, *Matal v. Tam – A Victory for the Slants, A Touchdown for the Redskins, but an*

racial epithets, *slants* is not the most offensive or hideous. It is a term that has multiple definitions, most of which are not racially disparaging.³³ Perhaps a case with more challenging facts would have been “THE CHINKS,” because although the term too has a non-racial alternative meaning³⁴ (as seen in the phrase “chink in the armor”), its use in the contemporary setting is controversial and generally discouraged, given its close identification as a racial slur.³⁵

Would the Court in *Tam* have reached the same result, or with the same ease or unanimity, if the mark in question were the more unambiguous “THE GOOKS”? *Webster’s* defines the term as “a native belonging usu[ally] to a brown or yellow race—usu[ally] used disparagingly.”³⁶ Wikipedia describes it as “a derogatory term for certain people of East and Southeast Asian descent. The slur is frequently directed toward foreigners, especially people of Filipino, Korean, or Vietnamese descent.”³⁷ Perhaps the band in *Tam* could have more vividly expressed its mission of re-appropriating a much-hated slur with an eye-catching “ME, GOOK,”³⁸ or the more collectivist and community-minded “WE, GOOKS.”

In all events, the Court in *Tam* was well aware of the racial trope in the mark at hand. Justice Kennedy’s opinion, joined by three others, specifically acknowledged “The Slants” as “a racial epithet.”³⁹ More importantly, the Court had notice of the consequences of a decision to allow registration. The

Ambiguous Journey for the First Amendment and Trademark Law, 36 CARDOZO ARTS & ENT. L.J. 83, 123 (2018).

³³ See WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY OF THE ENGLISH LANGUAGE UNABRIDGED 2137 (2002). *Webster’s* does include “slant-eye” as an entry and defines it: “a person with slanting eyes; *esp.* one of Mongoloid ancestry—usu. taken to be offensive.” *Id.*

³⁴ *Id.* at 391 (defining “chink” as, among others, “an opening, space, break, or hole typically of greater length than width ...”).

³⁵ *Id.* (“CHINESE—usu. taken to be offensive[.]”); see *Chink in One’s Armor*, WIKIPEDIA, https://en.wikipedia.org/wiki/Chink_in_one%27s_armor (last visited Nov. 2, 2019) (discussing etymology and controversy of phrase).

³⁶ WEBSTER’S, *supra* note 33, at 979.

³⁷ *Gook*, WIKIPEDIA, <https://en.wikipedia.org/wiki/Gook> (last visited Nov. 2, 2019) (footnote and citation omitted). “It was originally predominantly used by the U.S. military during wartime, especially during the Korean War, and more so during the Vietnam War.” *Id.* (footnotes and citations omitted).

³⁸ This is the purported transliteration of the Korean 미국, meaning “America.” NAVER ENGLISH DICTIONARY, <https://endic.naver.com/search.nhn?sLn=en&isOnlyViewEE=N&query=%EB%8C%9C> (last visited Nov. 2, 2019).

³⁹ *Matal v. Tam*, 137 S. Ct. 1744, 1766 (2017) (Kennedy, J., concurring in part and concurring in judgment).

Government explicitly argued that it should not be required to register “the vilest racial epithets.”⁴⁰ This lead in the parade-of-horrables was not enough to sway the Court. Per Justice Alito (with three others), quoting Justice Oliver Wendell Holmes: “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.’”⁴¹

Another consequence of the free expression result in *Tam* is that the motivation or purpose of the trademark registrant is not relevant. *Tam* does not distinguish between the applicant who desires to “reclaim” or “own” a stereotype toward an empowering mission, or one who wishes to assert racial superiority and spew hate.⁴² That is, after all, the essence of a rule that prohibits discrimination on the basis of content or viewpoint. Thus, presumably, a party would be able to register “GOOKS FOR DUKES” (for, say, consulting services relating to admission at elite universities), while another may register “NUKES FOR GOOKS” (for association services supporting an entirely different purpose).

The Lanham Act contemplates a very broad category of what may qualify as a trademark—“any word, name, symbol, or device, or any combination thereof.”⁴³ In addition to words (e.g., “THE SLANTS”), slogans (e.g., “JUST DO IT”), logos (e.g., McDonald’s golden arches), and, though relatively rare, even a color (by itself, and not as part of a combination),⁴⁴ and a sound⁴⁵ may also serve as a mark. Given the result in *Tam*, one wonders if a sound identified with racial connotations or stereotypes could receive trademark registration. Take the “Asian jingle,” or per Wikipedia, the “Oriental riff.”⁴⁶ It is a sequence of musical notes⁴⁷ comprising a melody

⁴⁰ Transcript of Oral Argument at 50, *Tam*, 137 S. Ct. 1744 (No. 15-1293).

⁴¹ *Tam*, 137 S. Ct. at 1764 (quoting *United States v. Schwimmer*, 279 U. S. 644, 655 (1929) (Holmes, J., dissenting)).

⁴² As Professor Katyal has stated, “Just as [the Court] empowered individuals like ... *Tam* to reclaim and reappropriate historically derogatory terms, it also now extends protection to the most entrepreneurial of haters, too.” Katyal, *supra* note 9, at 824.

⁴³ 15 U.S.C. § 1127 (2012) (defining “trademark” and “service mark”).

⁴⁴ See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 161, 162, 166 (1995).

⁴⁵ See 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:104 (5th ed. 2019) (providing examples of sounds that have received registration, including, among several others, “NBC chimes,” “MGM lion’s roar,” and “Yahoo yodel”).

⁴⁶ *Oriental Riff*, WIKIPEDIA, https://en.wikipedia.org/wiki/Oriental_riff (last visited Nov. 2, 2019).

⁴⁷ For the less acquainted, an audio of the melody is readily available on the Internet. See *File*:

“that has often been used in Western culture as a trope or stereotype of orientalism to represent the idea of Mainland China, Japan, Korea, Taiwan or a generic East Asian theme.”⁴⁸ Could this trope be a registered trademark?

Whereas “THE SLANTS” in *Tam* was a word mark incorporating a disparaging term for persons of Asian descent—apparently referring to their eye shape—the following offers a visual depiction of the term:

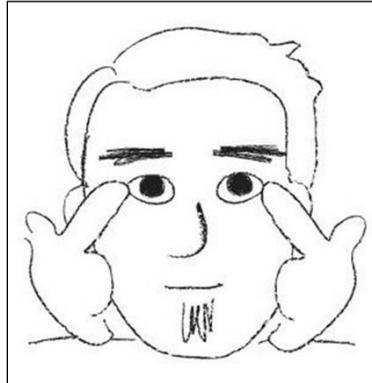


Fig. 1

Or consider this less ambiguous graphic:



Fig. 2

Asian Riff Accurate.mid, WIKIPEDIA, https://en.wikipedia.org/wiki/File:Asian_Riff_Accurate.mid (last visited Nov. 2, 2019).

⁴⁸ *Oriental Riff*, *supra* note 46.

In the post-*Tam* era, the question is whether Fig. 1 or 2 may qualify as constitutionally protected expression in a registrable trademark. The question is not beyond the pale. Note the following exchange between Justice Kennedy and counsel for the Asian American band at oral argument in *Tam*:

JUSTICE KENNEDY: Suppose we had this hypothetical case. The facts are largely parallel to these, other than the band are non-Asians, they use makeup to exaggerate slanted eyes, and they make fun of Asians. Could the government, under a properly-drawn statute, decline to register that as a trademark in your view?

MR. CONNELL: They could not.

JUSTICE KENNEDY: The First Amendment protects absolutely outrageous speech insofar as trademarks are concerned.

MR. CONNELL: That is correct.

JUSTICE KENNEDY: I think you have to take that position.

MR. CONNELL: Well, we take that position....⁴⁹

A depiction of Fig. 1 received national attention during the 2017 World Series between the Houston Astros and the Los Angeles Dodgers. In the third game, Houston batter Yuli Gurriel hit a home run off Dodgers' pitcher Yu Darvish. "After Gurriel returned to the dugout, he was captured on camera smiling and then raising his hands as if to stretch the sides of his eyes. It seemed to be a clear, and pointedly insensitive, reference to Darvish, who is from Japan."⁵⁰ Gurriel's gesture, like many trademarks, expressed a viewpoint, to wit (as Gurriel explained after the game): *Teammates, maybe Darvish thought that I was Japanese too and that's why he gave me a good pitch to hit.*⁵¹

⁴⁹ Transcript of Oral Argument at 27–28, *Matal v. Tam*, 137 S. Ct. 1744 (2017) (No. 15-1293).

⁵⁰ David Waldstein, *Astros' Yuli Gurriel Escapes World Series Ban, but Will Miss 5 Games in 2018*, N.Y. TIMES (Oct. 28, 2017), <https://www.nytimes.com/2017/10/28/sports/baseball/yuli-gurriel-apologizes-racist-yu-darvish.html>. Gurriel also "mouth[ed] the word 'chinito,' which translates to something along the lines of 'little Chinese boy.'" Dylan Hernandez, *Some Look Askew at Yuli Gurriel's Dugout Squint*, L.A. TIMES (Oct. 28, 2017), <https://www.latimes.com/sports/la-sp-dodgers-hernandez-20171027-story.html>. A condensed video of the incident is readily available on the Internet. G4MarchMadnessHD, *Yuli Gurriel Mocks Yu Darvish After Home Run - Astros vs Dodgers WS Gm3*, YOUTUBE (Oct. 28, 2017), <https://www.youtube.com/watch?v=0aPEEWPAyA4>.

⁵¹ See Waldstein, *supra* note 50.

The problem is that the gesture also has a patently offensive meaning, at least to some.⁵² The day after the gesture-filled game, Major League Baseball Commissioner Rob Manfred declared:

There is complete unanimity—me, my office, both owners, both clubs and the [Major League Baseball Players Association]—that there is no place in our game for the behavior or any behavior like the behavior we witnessed last night. There is no excuse or explanation that makes that type of behavior acceptable.⁵³

The Commissioner suspended Gurriel for five games without pay, though the suspension would not take effect until the beginning of the following regular season.⁵⁴ Compare the Commissioner’s decision with the policy of the U.S. Equal Employment Opportunity Commission relating to discrimination or harassment at the workplace:

Ethnic slurs and other verbal or physical conduct because of nationality are illegal if they are severe or pervasive and create an intimidating, hostile or offensive working environment, interfere with work performance, or negatively affect job opportunities. Examples of potentially unlawful conduct include insults, taunting, or ethnic epithets, such as making fun of a person’s foreign accent or comments like, “Go back to where you came from,” whether made by supervisors or by co-workers.⁵⁵

All of this leaves a most perplexing state of affairs. There is no place for certain gestures in America’s national pastime (per the Commissioner’s office), and such acts in the workplace violate federal law (per the EEOC). Yet, under *Tam*, such a gesture packaged as a trademark may have a place in the rolls of the Principal Register, as a matter of Free Speech. To build on an observation from Judge Jimmie V. Reyna, who, dissenting from the en banc Court of Appeals for the Federal Circuit decision in *Tam*, in turn borrowed from Justice John Paul Stevens: “[F]ew of us would march our sons and daughters off to war to preserve the citizen’s right” to register a racial epithet

⁵² But others might question whether it is offensive, given the context. *See, e.g.*, Hernandez, *supra* note 50.

⁵³ *Commissioner Manfred Pregame Interview*, MLB (Oct. 28, 2017), <https://www.mlb.com/news/commissioner-manfred-pregame-interview-c259953862>.

⁵⁴ *Id.* Gurriel was also required to undergo sensitivity training during the offseason. *Id.* He apologized for his actions. Hernandez, *supra* note 50.

⁵⁵ U.S. EQUAL EMPLOYMENT OPPORTUNITY COMMISSION, *Immigrants’ Employment Rights Under Federal Anti-Discrimination Laws*, <https://www.eeoc.gov/eeoc/publications/immigrants-facts.cfm> (referring to “Harassment Based on National Origin”).

as a trademark, which, if mimicked in person at the workplace, would result in a suspension.⁵⁶

As noted, in *Tam*, a unanimous Court ruled that a racial slur could not be denied registration under the “disparagement clause” of the Lanham Act; in *Brunetti*, a divided Court struck down the “immoral ... or scandalous” provision of the Act, to allow registration of “the equivalent of the past participle form of the ... paradigmatic profane word in our culture.”⁵⁷ I see in *Brunetti* signs of second thoughts from some Justices regarding the reach of *Tam* and its consequences. Or at a minimum, the reasons advanced in *Brunetti* for not allowing the registration of “FUCT” and similar terms could have been advanced with equal vigor in *Tam* in relation to racial slurs, but they were not.

The first indication came from Justice Breyer, who at oral argument raised a question about racial slurs, an issue already decided by *Tam* two terms before: “I’ve looked into [it] a little, and there are certain [racial slurs] that have exactly the same physiological effect on a person ... as the word we’re using here [fuct], and there is a physiological effect.”⁵⁸ He continued, “[I]t’s stored in a different place in the brain. It leads to retention of the word. There are lots of physiological effect[s] with very few words. It’s not too hard ... to think of a racial slur that has exactly the same effect.”⁵⁹ Justice Breyer elaborated on this point in his separate opinion in *Brunetti*, in which his discussion of “highly vulgar or obscene speech” returned to racial epithets:

[S]cientific evidence suggests that certain highly vulgar words have a physiological and emotional impact that makes them different in kind from most other words. These vulgar words originate in a different part of our brains than most other words. And these types of swear words tend to attract more attention and are harder to forget than other words. Notably, that has remained true even as the list of offensive swear words has changed over time: In the last few centuries, the list has evolved away from words of religious disrespect and toward words that are sexually explicit or that crudely describe bodily functions. And

⁵⁶ *In re Tam*, 808 F.3d 1321, 1381 (Fed. Cir. 2017) (en banc) (Reyna, J., dissenting) (first citing *Young v. American Mini Theatres, Inc.*, 427 U.S. 50, 70 (1976) (Stevens, J.); then citing *McCann v. Anthony*, 21 Mo. App. 83, 91–92 (1886)).

⁵⁷ Transcript of Oral Argument at 8, *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019) (No. 18-302).

⁵⁸ *Id.* at 23–24.

⁵⁹ *Id.* at 24.

the list of swear words may be evolving yet again, perhaps in the direction of including *race-based epithets*.

These attention-grabbing words, though financially valuable to some businesses that seek to attract interest in their products, threaten to distract consumers and disrupt commerce. And they may lead to the creation of public spaces that many will find repellant, perhaps on occasion creating the risk of verbal altercations or even physical confrontations. (Just think about how you might react if you saw someone wearing a t-shirt or using a product emblazoned with an *odious racial epithet*.)⁶⁰

Recall that Justice Breyer joined the plurality opinion in *Tam* (along with Justice Alito, the Chief Justice, and Justice Thomas) that proclaimed that “[s]peech that demeans on the basis of race [or] ethnicity . . . is *hateful*,” but protected.⁶¹ One wonders about the change in Justice Breyer’s direction. On the matter of the physiological impact of a racial slur on a person, at the *Brunetti* stage, it was too little, too late.

Moreover, the Chief Justice and Justices Breyer and Sotomayor, dissenting from the Court’s decision allowing registration of “FUCT,” all advanced the Government’s interest in not associating itself with, promoting, or lending its ancillary support to marks that are vulgar or obscene.⁶² It is a fair question to ask whether the Government may have a similar interest regarding the trademark registration of hateful racial epithets.

Then there is the separate concurring opinion from Justice Alito, the author of the Opinion of the Court in *Tam*. There, it was he who, rejecting the analogy between trademarks that involve disparagement of race (among others) with discriminatory conduct, wrote in one entirely unnecessary passage that the disparagement clause “is not an antidiscrimination clause; it is a happy-talk clause.”⁶³ In *Brunetti*, although Justice Alito joined the

⁶⁰ *Brunetti*, 139 S. Ct. at 2307 (Breyer, J., concurring in part and dissenting in part) (emphasis added) (citations omitted).

⁶¹ *Tam*, 137 S. Ct. at 1764 (emphasis added) (quoting *United States v. Schwimmer*, 279 U.S. 644, 655 (1929) (Holmes, J., dissenting)).

⁶² *Brunetti*, 139 S. Ct. at 2303 (Roberts, C.J., concurring in part and dissenting in part); *id.* at 2307 (Breyer, J., concurring in part and dissenting in part); *id.* at 2317 (Sotomayor, J., concurring in part and dissenting in part). The Chief Justice and Justice Sotomayor also added “profane” speech to the list. *Id.* at 2303 (Roberts, C.J., concurring in part and dissenting in part); *id.* at 2317 (Sotomayor, J., concurring in part and dissenting in part).

⁶³ *Tam*, 137 S. Ct. at 1765.

majority's decision, he wrote separately, contemplating a different result under a more narrowly written statute:

Our decision does not prevent Congress from adopting a more carefully focused statute that precludes the registration of marks containing vulgar *terms that play no real part in the expression of ideas*. The particular mark in question in this case could be denied registration under such a statute. *The term suggested by that mark is not needed to express any idea* and, in fact, as commonly used today, *generally signifies nothing except emotion and a severely limited vocabulary*. The registration of such marks serves only to further *coarsen our popular culture*.⁶⁴

To be clear, Justice Alito was referring to vulgar terms, not racial epithets. Nevertheless, the passage invites questions. What part does a term like *gooks* or the image in Fig. 2 play in the “expression of ideas”? *Some* part, to be sure, but any more than *fuct*? Is the racial slur or image “needed to express any idea,” or instead, does its use signify little “except emotion and a severely limited vocabulary”?⁶⁵ And why the concern about “further coarsen[ing] our popular culture” if such marks are allowed registration? If Justice Alito’s opinion in *Tam* was one to thwart the forces of “political correctness,”⁶⁶ his concurrence in *Brunetti* seems to have evened the tally.

To Justice Alito’s point, Congress may indeed make law, in the aftermath of *Brunetti*, with narrower and more explicit language to prohibit the registration of, say, “obscene, vulgar, or profane matter.”⁶⁷ And the Court, divided in *Brunetti*, would have to reconvene to determine to what extent vulgar or profane content in a trademark is protected by the First Amendment.⁶⁸ Put another way, if “FUCT” can survive the “immoral ... or scandalous” prohibition, could “FUCK’D” prevail under an “obscene,

⁶⁴ *Brunetti*, 139 S. Ct. at 2303 (Alito, J., concurring) (emphasis added).

⁶⁵ How much of Free Speech protections would be lost by not allowing registration of “GOOKS GO BACK TO WHERE YOU CAME FROM,” while allowing “ASIANS GO BACK TO WHERE YOU CAME FROM”?

⁶⁶ Clay Calvert, *Beyond Trademarks and Offense: Tam and the Justices’ Evolution on Free Speech*, 2017 CATO SUP. CT. REV. 25, 34, 54.

⁶⁷ The phrasing—obscene, vulgar, profane (or with variations of the root terms and varying conjunctions)—appears in rote delivery in the separate opinions of the dissenters. *Brunetti*, 139 S. Ct. at 2303–04 (Roberts, C.J., concurring in part and dissenting in part) (appearing four times); *id.* at 2308, 2311, 2312–14, 2317–18 (Sotomayor, J., concurring in part and dissenting in part) (appearing eleven times). Justice Breyer opted for “highly vulgar or obscene.” *Id.* at 2304, 2306–07 (appearing seven times).

⁶⁸ Obscene matter appears already decided. *See* *Miller v. California*, 413 U.S. 15, 24–26 (1973), *cited in Brunetti*, 139 S. Ct. at 2311 (Sotomayor, J., concurring part and dissenting in part).

vulgar, or profane” clause? With respect to racial epithets, however, selected passages suggesting second thoughts in the *Brunetti* dissents notwithstanding and barring a constitutional amendment, *Tam* is the law of the land. Thus, the consumer may see “WE, GOOKS®,” though possibly not “WE, GOOKS, FUCK’D.”

I confess that to this point, I have discussed hypothetical marks in the context of registrability, mostly in the abstract. Under U.S. law, trademark rights require *use*;⁶⁹ indeed, the very definition of trademark under the Act requires a designation that is “*used* by a person, or ... [that] a person has a bona fide intention to *use* in commerce.”⁷⁰ As a practical matter, the question is whether anyone would actually adopt and use “WE, GOOKS” or Fig. 2 to sell his wares. Professor Timothy T. Hsieh doubts that *Tam* will lead to a substantial increase in offensive marks, “due to goodwill concerns and common business sense.”⁷¹ Given the significant resources that a business venture demands, owners are not likely to engage in any action to insult the consuming public. In this vein, Justice Kennedy in *Tam* evoked “Justice Holmes’ reference to the ‘free trade in ideas’ and the ‘power of ... thought to get itself accepted in the competition of the market[.]’ In the realm of trademarks, the metaphorical marketplace of ideas becomes a tangible, powerful reality.”⁷² Put another way, the market will decide whether an offensive idea or trademark can remain, survive, and prevail.⁷³ In the

⁶⁹ See MCCARTHY, *supra* note 45, § 16:18.

⁷⁰ Lanham Act, 15 U.S.C. § 1127 (2012) (emphasis added) (defining “trademark” and “service mark”).

⁷¹ Timothy T. Hsieh, *The Hybrid Trademark and Free Speech Forged from Matal v. Tam*, 7 N.Y.U. J. INTEL. PROP. & ENT. L. 1, 19 (2018).

⁷² *Matal v. Tam*, 137 S. Ct. 1744, 1767–68 (2017) (quoting *Abrams v. United States*, 250 U. S. 616, 630 (1919) (Holmes, J., dissenting)).

⁷³ An interesting case study is “YELLOW FEVER” for a pan-Asian restaurant. The owner wished to select a “memorable” name. Alex Horton, *Whole Foods Is Slammed over Yellow Fever Restaurant. The Owner Says It’s Not Racist.*, WASH. POST (Apr. 29, 2018), <https://www.washingtonpost.com/news/business/wp/2018/04/28/a-yellow-fever-restaurant-opened-in-a-whole-foods-there-are-two-problems-with-that-critics-say/?noredirect=on>. Like “slants,” “yellow fever” is capable of multiple meanings, one of which is “a common reference to a term associated with a white man’s sexual fascination with Asian women.” *Id.* The owner’s selection of the term for the restaurant should remind of the band’s motivation in *Tam*: “[R]ather than narrowly associating it with a deadly disease or with perpetuating racial stereotypes, we choose to embrace the term and reinterpret it positively for ourselves.” *Id.* But there was also a “national outcry ... with many criticizing the name’s racist undertones.” *Id.* The restaurant eventually closed all three of its locations, with the owner explaining, “[A]t the end of the day if you can’t make money you won’t survive.” *Yellow Fever Restaurant Closing After Culturally Insensitivity Charge*, ASAMNEWS (June 2, 2019), <https://asamnews.com/2019/06/02/yellow-fever-restaurant-closing-after-culturally-insensitivity-charge/>.

trademark context, Professor Rebecca Tushnet acknowledges the argument that consumers will refuse to buy goods or services with truly offensive marks and that the offensive sellers will go out of business.⁷⁴ “But that argument,” she counters, “does not deal with disparaging marks that target only subsets of the population; a market can segment so that racists, or even people who just do not care about harm to the target group, can support the trademark owner.”⁷⁵

In my own classes in trademarks, when discussing the registrability of a hypothetical mark, I often refer to, as a default good or service, a bar examination preparation service and related materials. Putting aside whatever motivation one may have for selecting a mark with a racial connotation for this endeavor, I do not imagine that “WE, GOOKS” or Fig. 2 would do well in the highly competitive bar exam preparation market. I would rather not know how successful Fig. 1 would be as a mark for, say, baseball instruction services. But what about the “Asian jingle” or “Oriental riff,” used for Chinese food delivery, or a travel agency catering to tourists going to Asia? Even if a mark is insensitive or offensive to some, the business owner is mainly interested in all things to drive profit. If consumers readily identify the melody as a source indicator of the commercial service, that is the very hallmark of a trademark,⁷⁶ not to mention a successful one in the marketplace, political correctness be damned.

There may well be entrepreneurial parties who use and register a trademark containing a racial connotation to market their goods and services, with or without a desire to advance a social or political message.⁷⁷ Some will be accepted in the marketplace, while others are not, per Holmes. There will also be those who use a mark containing words and images *that we hate*, in order to advance a hateful cause with a less than altruistic viewpoint. Trademarks with racial epithets may perpetuate stereotypes, alienate members of American society along racial lines at a time of heightened divisiveness, and perhaps even have a physiological impact on some persons.

⁷⁴ Tushnet, *supra* note 24, at 388 n.25.

⁷⁵ *Id.*

⁷⁶ See *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 755 (6th Cir. 1998).

⁷⁷ For a discussion of the categories of parties likely to register offensive or disparaging marks post-*Tam*, see Gary Myers, *Trademarks & the First Amendment After Matal v. Tam*, 26 J. INTELL. PROP. L. 67, 95 (2019).

All of the above marks may appear in public—online, on billboards, buses, and possibly t-shirts, though probably not in the workplace or schools.

And all of these trademarks will appear in commerce with the government approved “®.” That is the trouble with *Tam*.