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CHOOSING THE RIGHT NAME:

How the U.S. Supreme Court Changed Trademark Law in 2017

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1 REGISTERING A TRADEMARK BECAME EASIER

Prior to the June 2017 U.S. Supreme Court decision in Matal v. Tam (2017), trademark examiners were able to deny applications that they deemed disparaging. The U.S. Supreme Court said the disparagement clause of the 1946 Lanham Act, **prohibiting the registration of trademarks that are likely to disparage people or groups**, was unconstitutional as it violates the Free Speech Clause First Amendment. Had the government prevailed on its arguments about the nature of trademarks there was speculation that the government could have **restricted other forms of intellectual property**, notably copyright. Shifting norms in society also allowed for the standard of disparagement to change.

While it may not be advisable to create "offensive" trademarks to a "substantial composite" of a group, the end result of Matal v. Tam (2017) is that **the government cannot scrutinize trademarks or take them away based on subjective norms and tastes** (p. 1754).

2 $ TRADEMARK MAY NOT CONSTITUTE COMMERCIAL SPEECH:

The U.S. Supreme Court did not directly embrace the idea that trademarks are not commercial speech, but it did discuss the application of the commercial speech doctrine to trademarks. Justice Alito's opinion recognized that there is a view that organizational brands, i.e. trademarks, **stand for something more than organizational identification**.

Although U.S. Supreme Court dicta is not a precise indicator of future decisions, the majority opinion in Matal v. Tam (2017) suggests the court may agree that brands and organizational identities go beyond merely commercial purposes. **This is important news for PR practitioners**, who have for over a decade speculated whether their speech was commercial or not.

3 PUBLIC OPINION STILL MATTERS

Even though restrictions have been loosened for trademark applicants, the rules of public opinion still matter. **Choosing a potentially offensive trademark still runs the risk of alienating publics at an organization's expense.**

The removal of subjective barriers to trademark applications **give organizations greater freedom**, and provide those who wish to make a provocative statement the freedom to do so. The result is that **there will no longer be trademarks that are rejected because of disparagement concerns**. However, the viability of those marks will be determined by the court of public opinion, not by a court of law.

For the full study, please visit **http://bit.ly/2uOrteC**